

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RINGCENTRAL, INC.,
Petitioner,

v.

ESTECH SYSTEMS, INC.,
Patent Owner.

IPR2021-00573 (Patent 6,067,349)
IPR2021-00574 (Patent 8,391,298 B2)¹

Before THOMAS L. GIANNETTI, JENNIFER MEYER CHAGNON, and
CHARLES J. BOUDREAU, Administrative Patent Judges.

GIANNETTI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5

¹ The parties are not authorized to use this caption.

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I. INTRODUCTION

In each of these proceedings, Patent Owner has identified parallel infringement litigations pending in the Eastern District and Western District of Texas involving the patents being challenged by Petitioner, and asked the Board to exercise its discretion to deny institution under *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). As Patent Owner’s requests are substantively identical in the two proceedings, unless otherwise specified, in this Order our citations will refer to IPR2021-00573. However, our discussion and Order apply to both proceedings.

II. DISCUSSION

Patent Owner contends “two parallel litigations will be decided by a jury before any final written decision (‘FWD’) would issue on the Petition—the first *thirteen months* before any FWD and the second *five months* before any FWD.” Paper 8 (“Prelim. Resp.”), 1. Patent Owner continues: “Trial in the related . . . Western District of Texas . . . [litigation] involving . . . the ’349 patent is scheduled for April 11, 2022, approximately *five months* before the statutory date for a FWD in this proceeding.” *Id.* at 2–3. Still further, “[a] second litigation in the Eastern District of Texas . . . involving the ’349 patent is scheduled for trial on August 2, 2021 – *thirteen months* before the statutory date for a FWD in this proceeding.” *Id.* at 3.

In support of these assertions, Patent Owner relies on (1) a docket control order in the Eastern District of Texas litigation (Ex. 2001), showing that jury selection in that litigation was to have occurred on August 2, 2021

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(now past), and (2) an agreed scheduling order in the Western District of Texas litigation (Ex. 2002) setting jury selection and trial for April 11, 2022.

These scheduling documents were filed with Patent Owner's Preliminary Response, on July 8, 2021. Since that date, neither party has provided the Board with updated scheduling information on those parallel litigations.

In order to evaluate Patent Owner's request for denial of the petitions under *Fintiv*, the Board needs up-to-date scheduling information on the parallel litigations relied on by Patent Owner. In addition, the Board needs further clarification on the extent of overlap between the prior art relied upon on in the parallel litigations in the Eastern and Western District of Texas and in these proceedings.

III. ORDER

In view of the foregoing, it is

ORDERED that by September 10, 2021, Patent Owner will file a status report on the schedules in the the parallel Eastern and Western District of Texas litigations relied on by Patent Owner in its request for denial of the petitions based on *Fintiv*;

FURTHER ORDERED that this report will include any changes to the schedules set forth in Exhibits 2001 and 2002, and especially the status of the trial scheduled for August 2, 2021, in the parallel Eastern District of Texas litigation;

FURTHER ORDERED that Patent Owner has a continuing duty to advise the Board promptly of any changes to the trial dates or the pre-trial schedules in the parallel Eastern and Western District of Texas litigations; and

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FURTHER ORDERED that by September 10, 2021, Petitioner and Patent Owner will file a joint statement on the extent to which the prior art cited in the petitions in these proceedings will be relied upon in the trials scheduled in the parallel Eastern and Western District of Texas litigations.

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