

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZYXEL COMMUNICATIONS CORPORATION,  
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,  
Patent Owner.

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IPR2021-00734 (Patent 8,265,096 B2)  
IPR2021-00739 (Patent 8,249,204 B2)  
IPR2021-00741 (Patent 8,565,326 B2)<sup>1</sup>

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Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

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<sup>1</sup> This Order addresses overlapping issues in the cases listed above. Therefore, we issue one Order to be filed in each case. The parties, however, are not authorized to use this style of filing

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Judges Droesch, Parvis, and Boudreau held a conference call on June 8, 2021, with counsel for the parties. Counsel for Patent Owner requested the call seeking authorization to file a sur-reply to Petitioner's Reply to Patent Owner's Opposition to the Motion for Joinder filed in each of IPR2021-00734, IPR2021-00739, and IPR2021-00741.

Counsel for Patent Owner requests authorization to file a sur-reply to the Motion for Joinder filed in each IPR to address certain Reply arguments that Patent Owner asserts are new. More specifically, counsel for Patent Owner asserts that it would like to address the ownership challenge raised by Petitioner based on Petitioner's listing of the challenged patent in the case caption for papers filed in each IPR. Counsel for Patent Owner also asserts that it would like the opportunity to respond to the case law cited by Petitioner in its Reply related to the timeliness of the Motion for Joinder.

Petitioner opposes Patent Owner's request. Counsel for Petitioner reaffirmed its representation from the Reply filed in each IPR that Petitioner does not raise an ownership issue to be decided by the Board. *See, e.g.*, IPR2021-00734, Paper 8, 1.<sup>2</sup> Counsel for Petitioner argues that each Petition filed in IPR2021-00734, IPR2021-00739, and IPR2021-00741 is substantively identical to the petition filed in each corresponding IPR to which joinder is sought. Counsel for Petitioner further argues that Petitioner's requested sur-reply would address the same issues that were raised in the Opposition filed in each IPR. Counsel for Petitioner asserts that

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<sup>2</sup> Identical statements are made in the Reply filed in each of IPR2021-00739 and IPR2021-00741.

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the Reply filed in each IPR included citations to *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11 at 8–9 (PTAB Feb. 26, 2020) and *Dell Inc. v. Neodron Ltd.*, IPR2020-00731, Paper 9 at 5 (PTAB July 31, 2020), neither of which is new or precedential. Petitioner asserts that Patent Owner had the opportunity to present case law to support its Opposition arguments that the Motion for Joinder filed in each IPR is untimely.

After considering the parties’ contentions made during the conference call, we conclude that good cause does not exist for authorizing Patent Owner’s request to file a sur-reply in each IPR to address an asserted ownership issue and the timeliness of the Motion for Joinder, issues already addressed in the Opposition filed in each IPR.

#### ORDER

Accordingly, it is:

ORDERED that Patent Owner’s request for authorization to file a sur-reply to the Motion for Joinder in each of IPR2021-00734, IPR2021-00739, and IPR2021-00741 is *denied*.

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