

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZYXEL COMMUNICATIONS CORPORATION,
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,
Patent Owner.

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

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

¹ 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 August 10, 2021, with counsel for the parties. Counsel for Petitioner requested the call seeking authorization to file a reply to the preliminary response filed in each of IPR2021-00734, IPR2021-00739, and IPR2021-00741.

Counsel for Petitioner requests authorization to file a reply in each proceeding to address *Fintiv* factor 2 and Patent Owner's Preliminary Response argument that Petitioner improperly filed its Petition "as an *in rem* proceeding." See, e.g., IPR2021-00734, Paper 12 at 4. More specifically, counsel for Petitioner states that the proceeding in *UNM Rainforest Innovations v. ZyXEL Communications Corporation*, No. 6:20-cv-00522-ADA (W.D.Tex.) ("related district court proceeding") has been stayed and, therefore, good cause exists to address *Fintiv* factor 2 in light of this material development. Counsel for Petitioner also states that there is good cause to allow Petitioner to file a reply because Patent Owner's arguments that Petitioner filed its Petition as an *in rem* proceeding could not have been foreseen. According to Petitioner, the patent at issue was listed in the caption of each Petition because Petitioner was aware of an ownership dispute regarding the patents at issue. Counsel for Petitioner requests a four-page reply.

Patent Owner opposes Petitioner's request. Counsel for Patent Owner asserts that a mandatory notice should be sufficient to address the stay of the related district court proceeding. Counsel for Patent Owner further asserts that because Petitioner introduced the issue by listing the patent at issue in the caption of each Petition, Patent Owner's *in rem* proceeding arguments

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were foreseeable. Counsel for Patent Owner requested a sur-reply, should the Board authorize Petitioner to file a reply.

After considering the parties' contentions made during the conference call, we conclude that good cause exists for authorizing Petitioner to file a reply in each IPR to address *Fintiv* factor 2 in view of the stay in the related district court proceeding and to address Patent Owner's argument that Petitioner filed each Petition improperly as an *in rem* proceeding. Accordingly, Petitioner is authorized to file, no later than August 17, 2021, a four (4) page reply to the Preliminary Response limited to the aforementioned issues. Patent Owner is authorized to file, no later than August 24, 2021, a four (4) page sur-reply.

ORDER

Accordingly, it is: ORDERED that Petitioner's request for authorization to file a reply to the Preliminary Response in each of IPR2021-00734, IPR2021-00739, and IPR2021-00741 is *granted*;

FURTHER ORDERED that Petitioner's reply is limited to four (4) pages and shall be filed no later than August 17, 2021;

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply to Petitioner's reply in each of IPR2021-00734, IPR2021-00739, and IPR2021-00741; and

FURTHER ORDERED that Patent Owner's sur-reply is limited to four (4) pages and shall be filed no later than August 24, 2021.

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