

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EPIC GAMES, INC.,
Petitioner,

v.

INGENIOSHARE, LLC,
Patent Owner.

IPR2022-00202 (Patent 10,142,810 B2)
IPR2022-00291 (Patent 10,708,727 B2)
IPR2022-00294 (Patent 10,492,038 B2)
IPR2022-00295 (Patent 10,492,038 B2)¹

Before SALLY C. MEDLEY, JONI Y. CHANG,
PATRICK M. BOUCHER, and STEVEN M. AMUNDSON,
*Administrative Patent Judges.*²

PER CURIAM.

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

¹ We exercise our discretion to issue one Order for all four proceedings. The proceedings have not been consolidated, and the parties are not permitted to use this caption.

² This is not an expanded panel. A three-judge panel is assigned to each proceeding.

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On November 15, 2021, Epic Games, Inc. (“Petitioner”) filed a Petition (Paper 2) in IPR2022-00202 requesting an *inter partes* review of claims 1–20 in U.S. Patent No. 10,142,810 B2 (“the ’810 patent”). On February 28, 2022, IngenioShare, LLC (“Patent Owner”) filed a Preliminary Response (Paper 6).

On December 7, 2021, Petitioner filed a Petition (Paper 1) in IPR2022-00291 requesting an *inter partes* review of claims 1–9 and 15–17 in U.S. Patent No. 10,708,727 B2 (“the ’727 patent”). On March 18, 2022, Patent Owner filed a Preliminary Response (Paper 7).

On December 7, 2021, Petitioner filed a Petition (Paper 1) in IPR2022-00294 requesting an *inter partes* review of claims 7–12, 22–24, and 33–67 in U.S. Patent No. 10,492,038 B2 (“the ’038 patent”). On March 13, 2022, Patent Owner filed a Preliminary Response (Paper 10).

On December 7, 2021, Petitioner filed a Petition (Paper 1) in IPR2022-00295 requesting an *inter partes* review of claims 7–12, 22–24, and 33–67 in the ’038 patent. On March 13, 2022, Patent Owner filed a Preliminary Response (Paper 8).

In each Preliminary Response, Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 314(a) to deny institution in light of a related civil action where Patent Owner has asserted the ’810, ’727, and ’038 patents against Petitioner, i.e., *IngenioShare, LLC v. Epic Games, Inc.*, No. 6:21-cv-00663-ADA (W.D. Tex. filed June 25, 2021) (“the Texas case”).

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On March 18, 2022, the district court in the Texas case granted Petitioner's motion to dismiss for improper venue, thus ending that case. Ex. 3001, 9.

On March 29, 2022, Petitioner's counsel emailed the Board to request authorization to file a preliminary reply in each proceeding to address discretionary denial under § 314(a), e.g., to "provide an updated status on the parallel district court litigation." Ex. 3002. Petitioner's counsel reports that "Patent Owner has indicated it does not object to this request provided Petitioner does not object to Patent Owner filing sur-replies" and that "Petitioner does not object." *Id.*

Under the circumstances here, we believe that further briefing will assist us in deciding whether to exercise our discretion under § 314(a) to deny institution.

ORDER

Accordingly, it is

ORDERED that no later than five business days after the date of this order, Petitioner may in each proceeding file a Preliminary Reply no longer than four pages that addresses discretionary denial under § 314(a);

FURTHER ORDERED that no later than five business days after Petitioner files a Preliminary Reply, Patent Owner may in each proceeding file a Preliminary Sur-reply no longer than four pages that responds to the Preliminary Reply; and

IPR2022-00202 (Patent 10,142,810 B2)
IPR2022-00291 (Patent 10,708,727 B2)
IPR2022-00294 (Patent 10,492,038 B2)
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FURTHER ORDERED that Petitioner may not file any new evidence with a Preliminary Reply and Patent Owner may not file any new evidence with a Preliminary Sur-reply.

IPR2022-00202 (Patent 10,142,810 B2)
IPR2022-00291 (Patent 10,708,727 B2)
IPR2022-00294 (Patent 10,492,038 B2)
IPR2022-00295 (Patent 10,492,038 B2)

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