

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

3D SURFACES, LLC,
Patent Owner.

IPR2022-01590
Patent RE42,534 E

Before JEFFREY S. SMITH, GEORGE R. HOSKINS, and
ROBERT L. KINDER, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

Petitioner, Intel Corporation, filed this Petition for *inter partes* review of claims 10–20 of U.S. Reissue Patent No. RE42,534 E (Ex. 1001, “the ’534 patent”). Paper 2 (“Pet.”). Petitioner filed a second Petition challenging claims 10–20 of the ’534 patent in IPR2022-01591. Petitioner also filed a Notice, ranking the two petitions filed against the ’534 patent. Paper 1 (“Notice”). Patent Owner, 3D Surfaces, LLC, filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Patent Owner also filed a “Response to Petitioner’s Ranking of Multiple Petitions.” Paper 8.

“[Section] 314(a) invests the Director with discretion on the question whether to institute review.” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1356 (2018) (discussing 35 U.S.C. § 314(a)). “[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016). “[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). For the reasons discussed below, we *do not* institute an *inter partes* review of any of the challenged claims of the ’534 patent on the grounds asserted in the Petition.

A. Real Parties-in-Interest

Petitioner identifies itself (i.e., Intel Corporation), as well as Dell Technologies Inc. and Dell Inc., as real parties-in-interest for Petitioner. Pet. 83. Patent Owner identifies itself (i.e., 3D Surfaces, LLC) as the real party-in-interest for Patent Owner. Paper 4 (Patent Owner Mandatory Notice), 1.

B. Related Matters

Patent Owner represents that the ’534 patent is at issue in *3D Surfaces, LLC v. Dell Technologies Inc., et al*, Case No. 1-22-cv-00854

(W.D. Tex.). Paper 4, 1. Patent Owner represents that the case was previously identified as Case No. 6-21-cv-01107, which is the case Petitioner identified. Paper 4, 1; Pet. 83–84.

Petitioner represents that it is challenging the '534 patent in IPR2022-01591. Pet. 84. Patent Owner identifies that same case, as well as *Dell Techs. Inc. et al. v. 3D Surfaces, LLC*, IPR2023-00005, and *Dell Techs. Inc. et al. v. 3D Surfaces, LLC*, IPR2023-00006, also involving the '534 patent. Paper 4, 1.

II. ANALYSIS

The Board's November 2019 Consolidated Trial Practice Guide¹ ("TPG") advises that "one petition should be sufficient to challenge the claims of a patent in most situations" but also "recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references." TPG 59. The TPG also provides that a petitioner filing concurrent petitions challenging claims of the same patent should file a paper (1) ranking the petitions in the order in which the petitioner wishes the Board to consider the petitions' merits and (2) explaining the differences between the petitions, among other things. TPG 59–60.

Here, Petitioner's Notice states that "the challenged claims of the '534 patent are not entitled to priority benefit of at least the '501 patent," and that "the earliest effective filing date for the challenged claims is no earlier than May 12, 2003." Notice 3. Petitioner further contends that Patent Owner is

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

claiming a July 2000 effective filing date for the challenged claims in a co-pending district court litigation filed by Patent Owner. *Id.* at 2. Therefore, according to Petitioner, a “priority dispute between the parties justifies two petitions.” *Id.* at 3.

In response, Patent Owner states that “Petitioner’s only justification for having two petitions is a potential priority dispute.” Paper 8, 1. Patent Owner further states “[i]f the Board declines to institute the -1590 IPR petition under § 314(a), Patent Owner will not challenge the prior art status of the 501-Pub² in the -1591 IPR.” *Id.* at 2.

Patent Owner’s stipulation moots Petitioner’s concern regarding the ’534 patent’s effective filing date. Petitioner has not otherwise shown exceptional circumstances that would warrant institution on two petitions. *See* Notice 4 (arguing the two Petitions present only a reduced burden on Patent Owner). Thus, we do not institute an *inter partes* review in this proceeding, IPR2022-01590, for the reasons set forth above. *See* 35 U.S.C. § 314(a).

III. CONCLUSION

We do not institute an *inter partes* review in this proceeding.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 10–20 of the ’534 patent is *not* instituted.

² U.S. Patent Appl. Publ. No. 2002/0033821 A1, published March 21, 2002.

IPR2022-01590
Patent RE42,534 E

FOR PETITIONER:

Lori A. Gordon
Antoine McNamara
PERKINS COIE LLP
gordon-ptab@perkinscoie.com
mcnamara-ptab@perkinscoie.com

FOR PATENT OWNER:

Jason Fitzsimmons
Michael D. Specht
Richard M. Bemben
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C
jfitzsimmons-PTAB@sternekessler.com
mspecht-PTAB@sternekessler.com
rbemben-PTAB@sternekessler.com

David L. Alberti
KRAMER DAY ALBERTI LIM TONKOVICH & BELLOLI LLP
dalberti@kramerday.com

Jerry D. Tice
BUNSOW DE MORY LLP
jtice@bdiplaw.com