

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL TECHNOLOGIES INC. and DELL INC.,
Petitioner,

v.

3D SURFACES, LLC,
Patent Owner.

IPR2023-00003
Patent 7,245,299 B2

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

HOSKINS, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Dell Technologies Inc. and Dell Inc. (collectively, “Petitioner”) have filed a Petition (Paper 5) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of U.S. Patent No. 7,245,299 B2 (Ex. 1001, “the ’299 patent”), claims 1, 2, 9–11, 17, and 18. Petitioner also filed a second petition against the ’299 patent in IPR2023-00004, and an Explanation (Paper 4, “Exp.”) for filing two petitions, ranking the present Petition behind the other petition.

3D Surfaces, LLC (“Patent Owner”) filed a Preliminary Response (Paper 10) opposing institution of review. Patent Owner also filed a Response (Paper 11, “Resp.”) to Petitioner’s Explanation concerning the two petitions.

“[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 ’299 patent claims on the grounds asserted in the Petition.

II. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies itself (i.e., Dell Technologies Inc. and Dell Inc.), as well as Intel Corporation, as real parties-in-interest for Petitioner. *See*

Pet. 84. Patent Owner identifies itself (i.e., 3D Surfaces, LLC) as the real party-in-interest for Patent Owner. *See* Paper 6, 1.

B. Related Proceedings

The parties identify one district court litigation involving the '299 patent: *3D Surfaces, LLC v. Dell Techs. Inc., et al.*, Case No. 1:22-cv-00854 (W.D. Tex.) (“the District Court Litigation”). *See* Pet. 84; Paper 6, 1 (explaining that the District Court Litigation was previously Case No. 6:21-cv-01107, the case number Petitioner identifies).

The parties further identify three other IPR proceedings challenging the '299 patent: IPR2022-01588; IPR2022-01589; and IPR2023-00004. *See* Pet. 84; Paper 6, 1.

III. ANALYSIS

The Board’s November 2019 Consolidated Trial Practice Guide¹ (“CTPG”) 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.” CTPG 59. The CTPG 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

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

(2) explaining the differences between the petitions, among other things.
See id. at 59–60.

Here, Petitioner’s Explanation states “the challenged claims of the ’299 patent are not entitled to priority benefit of at least the ’501 patent^[2],” and that “the earliest effective filing date for the challenged claims is no earlier than May 12, 2003.” Exp. 3. Petitioner further contends Patent Owner is claiming a July 2000 effective filing date for the challenged claims in the District Court Litigation. *Id.* Therefore, according to Petitioner, a “priority dispute between the parties justifies two petitions.” *Id.* at 3–4.

In response, Patent Owner states “Petitioner’s only justification for having two petitions is a potential priority dispute.” Resp. 1. Patent Owner further states “[i]f the Board declines to institute [the present proceeding IPR2023-00003] under § 314(a), Patent Owner will not challenge the prior art status of the 501-Pub^[3] in [IPR2023-00004].” *Id.* at 2.

Patent Owner’s stipulation moots Petitioner’s concern regarding the ’299 patent’s effective filing date. Petitioner has not otherwise shown exceptional circumstances that would warrant institution on two petitions. *See* Exp. 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, IPR2023-00003, for the reasons set forth above. *See* 35 U.S.C. § 314(a).

² U.S. Pat. No. 6,563,501 B2 to Adrian Sfarti (Exhibit 1014).

³ U.S. Pat. App. Pub. No. 2002/0033821 A1 to Adrian Sfarti (IPR2023-00004, Exhibit 1009).

IV. CONCLUSION

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

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of the '299 patent is *not* instituted in this proceeding.

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