

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAINTEQ, LLC,
Petitioner,

v.

ORTHOCISION, INC.,
Patent Owner.

IPR2023-00451
Patent 11,083,511 B2

Before: ZHENYU YANG, JAMES A. WORTH, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

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

Petitioner has filed two petitions seeking *inter partes* review of the same claims of the same patent. See IPR2023-00451, Paper 1 (“451 Petition”); IPR2023-00477, Paper 1 (“477 Petition”) (both challenging claims 1–23 of the ’511 patent). Petitioner ranks the 451 Petition ahead of the 477 Petition. IPR2023-00451, Paper 3, 2 (“Ranking”). Nevertheless, in the event institution is granted on the 451 Petition, Petitioner argues that institution of a second trial proceeding on the 477 Petition is necessary because a statement made by Patent Owner’s exclusive licensee in a related proceeding suggests Patent Owner may challenge the status of one of the references asserted in the 451 Petition, i.e., Lins (Ex. 1011). See *id.* (quoting licensee’s assertion in Ex. 1018 that “the ’511 Patent issued on August 8, 2021 from an application having an effective filing date of Ma[r]ch 15, 2013”). Patent Owner did not file a preliminary response to either petition.

“Based on the Board’s experience, one petition should be sufficient to challenge the claims of a patent in most situations.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) 59, *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=> (“TPG”). However, the Board recognizes that more than one petition may be necessary “when there is a dispute about priority date requiring arguments under multiple prior art references.” *Id.*

On the current record, it is unclear whether there is a dispute as to the status of Lins as prior art to the challenged claims. The statement from Ex. 1018 that Petitioner cites in its Ranking paper was apparently made by Patent Owner’s licensee and does not clearly take a position as to whether the challenged claims are entitled to the benefit of the earlier filing date. For

this reason, we ask Patent Owner to file a response to Petitioner's Ranking, indicating whether it disputes Petitioner's argument that Lins qualifies as prior art to the challenged claims. *See* 451 Petition, 16 (arguing that the "Grandparent" to the '511 patent does not disclose "a working channel with tangs" as recited in the challenged claims and therefore those claims are not entitled to the benefit of the Grandparent's filing date). We also note that Patent Owner may rebut Petitioner's argument that a second petition, i.e., the 477 Petition, is necessary by stipulating in its response that Lins qualifies as prior art. *See* TPG 61 (explaining that "the patent owner may seek to avoid additional petitions by proffering a stipulation that . . . certain references qualify as prior art"). The panel will consider Patent Owner's response in determining whether to exercise discretion under 35 U.S.C. 314(a) to deny institution of Petitioner's lower ranked petition in the event the 451 Petition is instituted. *Id.*

Accordingly, it is:

ORDERED that Patent Owner may file a response to Petitioner's Ranking (IPR2023-00451, Paper 3) of no more than 5 pages. Patent Owner's response is due by June 19, 2023. If Patent Owner does not file a response by that date, the panel will assume that there is a dispute as to whether Lin qualifies as prior art to the challenged claims.

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