

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASSA ABLOY GLOBAL SOLUTIONS, INC., HID GLOBAL CORP.,
Petitioner,

v.

URBAN INTEL INC,
Patent Owner.

IPR2023-00815 (Patent 9,373,205 B2)
IPR2023-00816 (Patent 10,657,747 B2)
IPR2023-00817 (Patent 11,373,474 B2)¹

Before KARL D. EASTHOM, BARBARA A. BENOIT, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENNETT, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are the same in each of the identified proceedings. The parties must obtain prior authorization to use this heading style. We cite to IPR2023-00817 for brevity.

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On October 17, 2023, Petitioner contacted the Board via email (Ex. 3002) requesting a call to seek guidance with respect to Patent Owner's arguments that Petitioner contends amount to an improper motion for sanctions.

In its email, Petitioner asserts that Patent Owner has improperly requested a sanction against Petitioner in the form of denial of institution for abuse of process. Ex. 3002. Because of the nature of the wrongdoing alleged (including allegations of professional misconduct and criminal extortion), Petitioner argues that Patent Owner's purported sanction request should have been brought as a separate motion under 37 C.F.R.

§ 42.11(d)(2), which requires authorization to file from the Board under 37 C.F.R. § 42.20, and further requires service of any proposed motion at least 21 days prior to seeking authorization to file. *Id.* Indicating that in a parallel district court case, Petitioner had served two legal opinions "directly rebutting Patent Owner's allegations of violations of professional rules and extortion," Petitioner requests that "[s]hould the Board entertain Patent Owner's motion for sanctions, Petitioner[] request[s] that it be able to submit those two legal opinions here." *Id.*

In response, Patent Owner states that it has not requested sanctions, but instead requests discretionary denial for abuse of the IPR process. *Id.*

Having reviewed the Parties' filings in each proceeding, including the Petition, Preliminary Response, Reply and Sur-reply briefs, Patent Owner presents the abuse of the IPR process allegations under *Fintiv* factor #6 and

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“the Board’s general discretionary powers.”² *See, e.g.*, Prelim. Resp. at 7–14 (presenting abuse of process arguments under the heading “***FINTIV FACTOR #6 (MERITS AND OTHER CIRCUMSTANCES)***”); *id.* at 14 (requesting “that the Petition be dismissed under the Board’s general discretionary powers”). Although Patent Owner mentions “a sanction” in its Sur-reply (Paper 10, 5), Patent Owner maintains that it only requests discretionary denial, not a sanction (Ex. 3002 (“[O]ur Sur-Reply does not request sanctions, it requests discretionary denial.”)). Accordingly, we consider Patent Owner’s abuse of the IPR process arguments to be arguments in support of discretionary denial, and to the extent abuse of the IPR process is a proper and valid consideration, we will address these arguments in our forthcoming decisions on institution.³

Petitioner’s request to submit evidence was conditioned on “the Board entertain[ing] Patent Owner’s motion for sanctions.” We do not consider Patent Owner’s abuse of the IPR process arguments as motions for sanctions in these proceedings. We, therefore, deny Petitioner’s request to submit evidence or otherwise respond to Patent Owner’s Sur-replies at this time.

ORDER

It is so ORDERED.

² *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (setting out and applying six factors for discretionary denial) (designated precedential on May 5, 2020) (“*Fintiv*”).

³ We acknowledge but do not decide here whether abuse of the IPR process is a valid consideration for discretionary denial.

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