

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INFINERA CORPORATION,
Petitioner,

v.

ALEXANDER SOTO and WALTER SOTO,
Patent Owner.

IPR2023-00834 (Patent 9,887,795 B2)
IPR2023-00835 (Patent 10,263,723 B2)
IPR2023-00838 (Patent 10,771,181 B2)¹

Before THU A. DANG, PATRICK M. BOUCHER, GARTH D. BAER, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

¹ We issue a single order for all three proceedings. The panel for IPR2023-00834 consists of Judges Dang, Boucher, and Baer; the panel for each of IPR2023-00835 and IPR2023-00838 consists of Judges Boucher, Baer, and Szpondowski.

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On October 12, 2023, a consolidated conference call for these three proceedings was held with counsel for the parties to discuss Petitioner's request for authorization to file a Preliminary Reply in each proceeding. Petitioner's request relates to two issues, namely Patent Owner's argument in its Preliminary Responses that Petitioner may not have identified all real parties in interest and Patent Owner's characterization of the file history of U.S. Patent Appl. No. 12/512,968 (Ex. 2004), which is related to the patents at issue. *See* Paper 6, 24–25, 52–54.² Patent Owner opposes to the extent that Petitioner also seeks to file additional testimonial evidence addressing the related file history. During the call, we authorized Petitioner to file a Reply, and Patent Owner to file a Sur-reply, as set forth in the order below, limited to addressing these two issues. We denied authorization to file additional testimonial evidence addressing the related file history.

In its Petition, “Petitioner adopts the identical stipulation from *Sotera*,” but has not filed such a stipulation with the district court where related litigation is pending. *See* Paper 2, 64. Patent Owner contends that such a stipulation should not weigh in our analysis whether to exercise discretion to deny the Petition unless filed with the district court. Paper 6, 50–51. During the call, Patent Owner asked that we order Petitioner to file its stipulation with the district court. We decline to do so at this time, but we

² Citations are to IPR2023-00834. The other proceedings include similar arguments.

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note that the stipulation may be discounted if we lack sufficient confidence that the district court has the power to enforce it.

It is

ORDERED that Petitioner is authorized to file a Reply to Patent Owner's Preliminary Response, limited to seven pages, by October 20, 2023; and

FURTHER ORDERED that Patent Owner is authorized to file a Sur-reply to Patent Owner's Reply, limited to seven pages, by October 27, 2023.

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