

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DUPLO U.S.A. CORPORATION,
Petitioner,

v.

MGI DIGITAL TECHNOLOGY S.A.,
Patent Owner.

IPR2023-00935 (Patent 8,506,031 B2)
IPR2023-00936 (Patent 8,783,806 B2)¹

Before KRISTINA M. KALAN, CHRISTOPHER M. KAISER, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

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

¹ This Order applies to each of the above-captioned proceedings, and we exercise our discretion to issue one Order to be filed in each proceeding. The proceedings have not been consolidated, and the parties are not authorized to use this style heading in any subsequent papers.

On October 30, 2023, Petitioner emailed the Board requesting permission to file stipulations that it had served on Patent Owner in each of the above-captioned proceedings. Ex. 3001. Petitioner states that because the stipulations are “*Sotera* stipulations,” it does not believe briefing is necessary. *Id.* Petitioner also reports that Patent Owner (1) opposes the filing and (2) asserts that the stipulations² are ambiguous. *Id.* Petitioner does not state whether or not Patent Owner seeks briefing on the stipulations, but states to the extent Patent Owner seeks briefing, Petitioner requests a commensurate brief. *Id.* Patent Owner has not responded to Petitioner’s email to the board and has not asked for further briefing.

Under 35 U.S.C. § 314(a), the Director has discretion to deny institution of an *inter partes* review. *See* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). The Director has set forth guidance on when the Board will exercise its discretion to deny institution in view of a parallel district court litigation, including consideration of stipulations made in the parallel district court proceeding. *See* “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Director Guidance Memo³”).

In *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 at 4 (PTAB Sept. 7, 2022) (precedential), the Director stated it is appropriate for a petitioner to offer a stipulation prior to institution for the Board’s

² Although Petitioner’s email states the “petitions are ambiguous,” we understand Petitioner to have intended to state that the “stipulations are ambiguous.” *See* Ex. 3001.

³ Available at [interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf \(uspto.gov\)](https://www.uspto.gov/patent/interim-procedure-for-discretionary-denials-in-aia-post-grant-proceedings-with-parallel-district-court-litigation-memo-20220621.pdf)

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consideration whether or not to exercise the Board's discretion to deny institution in view of the parallel district court litigation.

We have discretion to permit filing a stipulation at this stage, prior to institution. We authorize Petitioner to file its stipulation as an exhibit in each of the above-captioned cases. No briefing on the stipulations is authorized.

ORDER

It is, therefore,

ORDERED that Petitioner may file its stipulation as an exhibit in each of the above-captioned cases within one week of the entry of this Order.

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