

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOMBARDIER RECREATIONAL PRODUCTS, INC.,
Petitioner,

v.

MHL CUSTOM, INC.,
Patent Owner.

IPR2024-00085¹ (Patent 9,586,659 B2)
IPR2024-00086² (Patent 9,359,044 B2)³

Before BART A. GERSTENBLITH, KEVIN W. CHERRY, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

PER CURIAM.

ORDER

Adjusting One-Year Pendency Due to Joinder
35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c)

¹ Bombardier Recreational Products Inc. (“BRP”), who filed a petition in IPR2024- 01107, is joined as petitioner (*see* Paper 29), and Foil Boarding Company, Inc. (“Foil Boarding”), was terminated as petitioner (*see* Paper 32).

² BRP, who filed a petition in IPR2024-01108, is joined as petitioner (*see* IPR2024-00086, Paper 29 (PTAB Jan. 15, 2025)), and Foil Boarding was terminated as petitioner (*see* IPR2024-00086, Paper 32 (PTAB Jan. 23, 2025)).

³ The Board is entering the same Order in all captioned cases. The parties are not authorized to use this caption.

IPR2024-00085 (Patent 9,586,659 B2)

IPR2024-00086 (Patent 9,359,044 B2)

On May 28, 2024, we instituted an *inter partes* review of claims 1, 2, 4, 5, 7–11, 13, and 15 of U.S. Patent No. 9,586,659 B2 (the ’659 patent), based on a petition filed by Foil Boarding in IPR2024-00085 (Paper 12). On January 15, 2025, we joined BRP, who filed a petition in IPR2024-01107, as petitioner in the proceeding (Paper 29). On January 23, 2025, we terminated Petitioner Foil Boarding based on settlement (Paper 32).

On May 28, 2024, we instituted an *inter partes* review of claims 1, 2, 5–8, 10–15, 17, 18, 20, and 21 of U.S. Patent No. 9,359,044 B2 (“the ’044 patent”), based on a petition filed by Foil Boarding in IPR2024-00086 (Paper 12). On January 15, 2025, we joined BRP, who filed a petition in IPR2024-01108, as petitioners in the proceeding (Paper 29). On January 23, 2025, we terminated Petitioner Foil Boarding based on settlement (Paper 32).

Pursuant to 35 U.S.C. § 316(a)(11), “the final determination in an inter partes review [shall] be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director . . . may adjust the time periods in this paragraph in the case of joinder under section 315(c).” The Director has delegated the authority to adjust the one-year period to the Board. *See* 37 C.F.R. § 42.100(c). In particular, 37 C.F.R. § 42.100(c) provides that “[a]n *inter partes* review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be . . . adjusted by the Board in the case of joinder.”

In accordance with 37 C.F.R. § 42.100(c), we adjust the time of pendency before the Board in the present proceedings, which involve joinder, to permit the Board to consider and determine the pending issues.

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In addition, we note that the timing of the termination and joinder means that BRP will be required to file the Petitioner's Reply and, given the short notice, needs additional time to prepare the Reply and for the hearing. The Board shall issue Final Written Decisions in these proceedings no later than August 29, 2025.

In consideration of the foregoing, it is hereby:

ORDERED that the time of pendency in these proceedings, which involve joinder, is adjusted beyond one year after institution; and

FURTHER ORDERED that, should final written decisions be issued in these proceedings, they shall be issued no later than August 29, 2025.

IPR2024-00085 (Patent 9,586,659 B2)

IPR2024-00086 (Patent 9,359,044 B2)

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