

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMINEX INTERNATIONAL CO., LTD.,
Petitioner,

v.

SIGNIFY HOLDINGS B.V.,
Patent Owner.

IPR2024-00101
Patent 10,299,336 B2

Before CHRISTOPHER M. KAISER, KEVIN C. TROCK, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

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

INTRODUCTION

Luminex International Co., Ltd. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–20 in U.S. Patent No. 10,299,336 B2 (Exhibit 1001, “the ’336 patent”) under 35 U.S.C. §§ 311–319. Paper 1. Signify Holdings B.V. (“Patent Owner”) filed a Preliminary Response. Paper 6. Further, after receiving Board authorization to address certain issues, Petitioner filed a Preliminary Reply, and Patent Owner filed a Preliminary Sur-reply. *See* Paper 7 (Order); Paper 8 (Preliminary Reply); Paper 9 (Preliminary Sur-reply).

BACKGROUND

On May 9, 2024, the panel issued a decision denying institution based on § 315(b) because the panel determined that Menard, Inc. (“Menard”) is a real party in interest in this proceeding and Petitioner filed the Petition more than one year after the date on which Menard was served with a complaint alleging infringement of the ’336 patent. *See* Paper 10, 35–42; 35 U.S.C. § 315(b) (2018).

On June 6, 2024, Petitioner requested Director review of the panel’s decision denying institution. *See* Paper 11. Among other things, Petitioner asserted that the panel erred in determining that Menard is a real party in interest in this proceeding. *See id.* at 4–15.

On August 20, 2024, the Director granted Petitioner’s request and vacated the panel’s decision denying institution. Paper 12, 6. Among other things, the Director determined that Menard is not a real party in interest in this proceeding. *Id.* at 5. Further, the Director remanded the case to the panel and instructed the panel “to determine whether the Petition presents a reasonable likelihood of prevailing with respect to at least one of the

challenged claims under 35 U.S.C. § 314(a), and to determine whether to institute *inter partes* review accordingly.” *Id.* at 5–6.

ORDER

Accordingly, it is

ORDERED that a decision on institution will issue as soon as possible and, in any event, no later than October 20, 2024; and

FURTHER ORDERED that additional briefing by any party is not necessary or authorized.

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