

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PACIFIC SURF DESIGNS, INC.,
Petitioner,

v.

Patent Owner of U.S. Patent 6,491,589.

Case IPR2016-01674
Patent 6,491,589

Before PHILLIP J. KAUFFMAN, WILLIAM V. SAINDON, and
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

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

Counsel for FlowRider Surf, LTD., contacted the Board via email on September 26, 2016. Ex. 3001. Counsel requests that we expunge Papers 4 and 5. Counsel filed two sets of a Power of Attorney pursuant to 37 C.F.R. § 42.10(b) and a Mandatory Notice pursuant to 37 C.F.R. § 42.8. Papers 4 and 5 are the first set, and name “Surf Waves, Ltd.” as Patent Owner. Papers 6 and 8 are the second set, which state that “Surf Park PTE. LTD.” is a Patent Owner. In the email, counsel for FlowRider Surf asserts that “the de facto Patent Owner is Whitewater West Industries, Ltd. . . . through its wholly-owned subsidiary, FLOWRIDER SURF, LTD.”

We generally do not grant relief other than that requested in the form of a motion, which requires authorization before filing. 37 C.F.R. § 42.20. FlowRider Surf did not request such authorization. Even treating the email from counsel as a request for authorization to file a motion, we deny the request because counsel has provided no basis to justify expunging the record. We note that a party is obligated to file updated mandatory notices whenever information changes. 37 C.F.R. § 42.8(a)(3).

We further note that the governing statutes and our rules provide for filings only on behalf of the Patent Owner. *See* 35 U.S.C. §§ 313, 316; 37 C.F.R. §§ 42.8, 42.107, 42.120. In this case, it does not appear that the patent owner of record, Surf Park PTE. LTD., has filed a Power of Attorney or Mandatory Notice. According to counsel’s email, FlowRider Surf, Ltd., is entitled to act at the Patent Owner. For us to proceed on such a basis, FlowRider Surf must file evidence of the license agreement granting it all substantial rights to U.S. Patent No. 6,491,589. Such evidence would support FlowRider Surf acting as patent owner. *See Motorola Mobility LLC v. Patent of Michael Arnouse*, No. IPR2013-00010 (Paper 27), 2013 WL

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5970127 at *3 (PTAB April 5, 2013) (applying Federal Circuit standing analysis to determine who “has the right to participate in proceedings at the Office”); *Prima Tek II, L.L.C. v. A-Roo Co.*, 222 F.3d 1372, 1377 (Fed. Cir. 2000) (holding that, with a transfer of “all substantial rights under the patent, the assignee may be deemed the effective ‘patentee’ under 35 U.S.C. § 281”); *see also NXP Semiconductors USA Inc. v. Inside Secure*, No. IPR2016-00684 (Paper 10), 2016 WL 5404197, at n.1 (PTAB Sept. 8, 2016) (treating the exclusive licensee as patent owner and noting that the license had provided evidence supporting that it held all substantial rights in the patent). If FlowRider Surf does not file evidence supporting that it holds all substantial rights to the ’589 patent, the true patent owner must file the required papers to represent its interest in in this proceeding (a Power of Attorney and Mandatory Notice). The true patent owner of the ’589 patent is required to file its Mandatory Notices under 37 C.F.R. § 42.8 within 21 days of the service date of the petition.

If additional clarification is needed, the parties should request a teleconference with the Board.

Accordingly, it is:

ORDERED that the request for authorization to file a motion is denied.

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PETITIONER:

Charanjit Brahma
TROUTMAN SANDERS LLP
charanjit.brahma@troutmansanders.com

PATENT OWNER:

Barry Schindler
Lennie Bersh
Erik Squier Squier
GREENBERG TRAURIG, LLP
schindlerb@gtlaw.com
bershl@gtlaw.com
squiere@gtlaw.com