

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RADWARE INC.,
Petitioner,

v.

F5 NETWORKS, INC.,
Patent Owner.

Case IPR2017-00653
Patent 7,472,413 B1

Case IPR2017-00654
Patent 7,472,413 B1

Before KRISTEN L. DROESCH, TRENTON A. WARD, and DAVID C.
McKONE, *Administrative Patent Judges*.

WARD, *Administrative Patent Judge*.

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

IPR2017-00653; Patent 7,472,413 B1
IPR2017-00654; Patent 7,472,413 B1

A conference call was held on May 18, 2017, and attended by respective counsel for the parties. The conference was scheduled to discuss Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response to respond to Patent Owner's argument that Petitioner failed to properly identify all real parties-in-interest, namely Petitioner's parent company, Radware, Ltd. *See* IPR2017-00653, Patent Owner's Preliminary Response, Paper 7, 2–10; IPR2017-00654, Patent Owner's Preliminary Response, Paper 7, 3–10. During the conference, Petitioner alternatively requested conditional permission to amend its mandatory notice to include an additional real party-in-interest, Radware, Ltd. Petitioner stated during the conference that if the Board were to determine that the easiest disposition of this issue is to simply add Radware, Ltd. as a “potential” real party-in-interest, Petitioner requests the ability to add Radware, Ltd., conditioned upon the Board entering an Order or otherwise ensuring that such an update would not require a new filing date be given to the Petition.

Patent Owner opposes Petitioner's request to file a reply to Patent Owner's Preliminary Response. Patent Owner argued during the conference, as it did in its Preliminary Response, that a correction to Petitioner's named real parties-in-interest is required, and that such a correction would require a new filing date under 37 C.F.R. § 42.106(b) and would bar Petitioner under 35 U.S.C. § 315(b). *See* IPR2017-00653, Patent Owner's Preliminary Response, Paper 7, 9; IPR2017-00654, Patent Owner's Preliminary Response, Paper 7, 10.

The Board reminded Petitioner during the conference that it is under a continuing obligation to properly “[i]dentify each real party-in-interest.” 37 C.F.R. § 42.8(b). Specifically, Petitioner must file an updated mandatory notice “within 21 days of a change of the information listed in paragraph (b) of this section stated in an earlier paper.” *Id.* at § 42.8(a)(3). The Board is not in a

IPR2017-00653; Patent 7,472,413 B1

IPR2017-00654; Patent 7,472,413 B1

position to determine on behalf of Petitioner, which parties should be named. Furthermore, the Board cannot advise Petitioner prior to an update as to whether the addition of a new real party-in-interest would require a new filing date for the Petition. Thus, Petitioner's request for the conditional ability to add Radware, Ltd. as a "potential" real party-in-interest is denied. If an update to Petitioner's mandatory notice is required, Petitioner is reminded that it has a duty to provide such an update in compliance with 37 C.F.R. § 42.8. Upon the filing of such an updated mandatory notice, the parties may request a conference call with the Board to discuss steps going forward.

After considering the respective positions of the parties, we find that good cause exists to grant Petitioner's request to file a limited Reply to the Preliminary Response. *See* 37 C.F.R. § 42.108(c). Specifically, to the extent the Preliminary Response contains alleged factual inaccuracies relating to the real party-in-interest issue, Petitioner could not have been expected to anticipate and address those alleged inaccuracies in the Petition. Petitioner, therefore, is authorized to file a 3-page reply on or before June 2, 2017. The scope of the reply is limited to addressing any alleged factual inaccuracies in the portion of the Preliminary Response that relates to the real party-in-interest issue.

Accordingly, Petitioner's request for authorization to conditionally update its mandatory notice is *denied* and Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response is *granted*.

IPR2017-00653; Patent 7,472,413 B1
IPR2017-00654; Patent 7,472,413 B1

ORDER

Accordingly, it is hereby

ORDERED that Petitioner may file a Reply to Patent Owner's Preliminary Response in each matter, IPR2017-00653, Paper 7; IPR2017-00654, Paper 7, limited to addressing only the real party-in-interest issue;

FURTHER ORDERED that each Reply shall be limited to three pages and be filed on or before June 2, 2017; and

FURTHER ORDERED Petitioner's request for authorization to conditionally update its mandatory notice is *denied*.

PETITIONER:

Fabio E. Marino
Barrington Dyer
MCDERMOTT WILL & EMERY LLP
fmarino@mwe.com
bdyer@mwe.com

PATENT OWNER:

Christina J. McCullough
Ramsey M. Al-Salam
PERKINS COIE LLP
cmccullough@perkinscoie.com
ralsalam@perkinscoie.com