

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FASTENERS FOR RETAIL, INC.,
Petitioner,

v.

RTC INDUSTRIES, INC.,
Patent Owner.

Case IPR2018-00741 (Patent 9,173,505)
Case IPR2018-00742 (Patent 9,149,132)
Case IPR2018-00743 (Patent 9,504,321)
Case IPR2018-00744 (Patent 9,635,957)¹

Before PATRICK R. SCANLON, MICHAEL L. WOODS, and
JASON W. MELVIN, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

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

¹ We issue one Order and enter it in each proceeding.

IPR2018-00741 (Patent 9,173,505)
IPR2018-00742 (Patent 9,149,132)
IPR2018-00743 (Patent 9,504,321)
IPR2018-00744 (Patent 9,635,957)

In its preliminary responses, RTC Industries, Inc. (“Patent Owner”) argued that Fasteners for Retail, Inc. (“Petitioner”) failed to name all real parties-in-interest (“RPI”), namely, Olympus Partners LP (“Olympus”). Paper 11, 28 (IPR2018-00741); Paper 11, 8 (IPR2018-00742); Paper 9, 32 (IPR2018-00743); Paper 11, 7 (IPR2018-00744). In an e-mail to the Board on June 28, 2018, Petitioner requested permission to file a reply to address the RPI issue.² A conference call was held between counsel for the parties and the Board on July 19, 2018, to discuss Petitioner’s request.

The statute governing *inter partes* review proceedings sets forth certain requirements for a petition for *inter partes* review, including that “the petition identif[y] all real parties in interest.” 35 U.S.C. § 312(a); *see also* 37 C.F.R. § 42.8(b)(1) (providing a requirement to identify real parties-in-interest in mandatory notices). “Whether a party who is not a named participant in a given proceeding nonetheless constitutes a ‘real party-in-interest’ . . . to that proceeding is a highly fact-dependent question” with no “bright line test,” and is assessed “on a case-by-case basis.” 77 Fed. Reg. at 48,759 (citing *Taylor v. Sturgell*, 553 U.S. 880, 893–95 (2008)).

During the conference call, Patent Owner indicated that it did not oppose allowing Petitioner to file a short reply to address the RPI issue. Patent Owner argued, however, that Petitioner should not be allowed to amend its mandatory notices to name other real parties-in-interest, because this practice would encourage gamesmanship. We are not persuaded by this

² In the same e-mail, Petitioner also requested permission to file motion for sanctions, which request we deny at this time.

IPR2018-00741 (Patent 9,173,505)
IPR2018-00742 (Patent 9,149,132)
IPR2018-00743 (Patent 9,504,321)
IPR2018-00744 (Patent 9,635,957)

argument. Our precedential decision in *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, slip op. at 5 (PTAB Mar. 4, 2016) (Paper 38), indicates that “a lapse in compliance with those requirements [under 35 U.S.C. § 312(a), including that all real parties in interest be identified] does not deprive the Board of jurisdiction over the proceeding, or preclude the Board from permitting such lapse to be rectified.” *See also Intel Corp. v. Alacritech, Inc.*, Case IPR2017-01392, slip op. at 23 (PTAB Nov. 30, 2017) (Paper 11) (noting that real parties in interest can be corrected); *Elekta, Inc. v. Varian Med. Sys., Inc.*, Case IPR2015-01401, slip op. at 6–10 (PTAB Dec. 31, 2015) (Paper 19) (holding that disclosing additional real parties in interest via an updated disclosure does not mandate a change in petition filing date).

Our policy is to “secure the just, speedy, and inexpensive resolution of every [*inter partes* review] proceeding.” 37 C.F.R. § 42.1. To that end, we grant Petitioner leave, if it wishes, to amend its mandatory notices to include other parties, including Olympus. Such amendment would not change the filing date accorded to the petitions in these proceedings. This Order does not decide the issue of whether Olympus is a real party in interest. That is, this Order shall not be construed as a finding that Olympus is a real party in interest in these proceedings. If Petitioner does not believe that Olympus is an unnamed real party in interest, in lieu of updating its mandatory notices, Petitioner may file a reply brief to address Patent Owner’s argument regarding the real party in interest issue (and only that issue).

For the reasons given, it is hereby:

IPR2018-00741 (Patent 9,173,505)
IPR2018-00742 (Patent 9,149,132)
IPR2018-00743 (Patent 9,504,321)
IPR2018-00744 (Patent 9,635,957)

ORDERED that within 7 days of the entry of this Order, Petitioner *may* amend its mandatory notices to name other parties, including Olympus, as a real party in interest in each of IPR2018-00741, IPR2018-00742, IPR2018-00743, and IPR2018-00744, and such updating of its mandatory notices will not result in a new filing date accorded to the petitions;

FURTHER ORDERED that in lieu of updating its mandatory notices, Petitioner *may* file a 7-page reply brief to address Patent Owner's RPI arguments in each of IPR2018-00741, IPR2018-00742, IPR2018-00743, and IPR2018-00744, if such briefs are filed within 7 days of the entry of this Order; and

FURTHER ORDERED that Patent Owner is not authorized, at this time, to file a sur reply in response to Petitioner's reply briefs, if filed.

IPR2018-00741 (Patent 9,173,505)
IPR2018-00742 (Patent 9,149,132)
IPR2018-00743 (Patent 9,504,321)
IPR2018-00744 (Patent 9,635,957)

PETITIONER:

Douglas H. Siegel
William B. Berndt
Ron N. Sklar
Honigman Miller Schwartz & Cohn LLP
dsiegel@honigman.com
wberndt@honigman.com
rsklar@honigman.com

PATENT OWNER:

Joseph J. Berghammer
Scott A. Burow
Bradley J. Van Pelt
Kevin C. Keenan
Eric A. Zelepugas
Banner & Witcoff, Ltd.
RTC-IPR@bannerwitcoff.com
jberghammer@bannerwitcoff.com
sburow@bannerwitcoff.com
bvanpelt@bannerwitcoff.com
kkeenana@bannerwitcoff.com
ezelepugas@bannerwitcoff.com