

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROPPANT EXPRESS INVESTMENTS, LLC,
PROPPANT EXPRESS SOLUTIONS, LLC,
Petitioner,

v.

OREN TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2017-02103
Patent 9,511,929 B2

Before MITCHELL G. WEATHERLY, KEVIN W. CHERRY, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

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

In its preliminary response, Oren Technologies, LLC (“Patent Owner”) argues that Proppant Express Investments, LLC, and Proppant Express Solutions, LLC, (collectively, “Petitioner”) failed to name all real parties in interest, namely, Liberty Oilfield Services, LLC (“Liberty”). Paper 7, 13–33.

The statute governing *inter partes* review proceedings sets forth certain requirements for a petition for *inter partes* review, including that “the petition identifies 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.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (citing *Taylor v. Sturgell*, 553 U.S. 880, 893–95 (2008)).

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); *see also 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 notice to include Liberty. This amendment will not change the filing date accorded to the petition in this proceeding. This Order does not decide the issue of whether Liberty is a real party in interest. That is, this Order shall not be construed as a finding that Liberty is a real party in interest in this proceeding. If Petitioner does not believe that Liberty is an unnamed real party in interest, in lieu of updating its mandatory notice, 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:

ORDERED that within 5 days of the entry of this Order, Petitioner *may* amend its mandatory notice to name Liberty as a real party in interest, and updating its mandatory notice will not result in a new filing date accorded to the petition;

FURTHER ORDERED that in lieu of updating its mandatory notice, Petitioner *may* file a 10-page reply brief to address only Patent Owner’s real party in interest arguments, if such brief is filed within 10 days of the entry of this Order; and

FURTHER ORDERED that Patent Owner may not file a sur reply in response to Petitioner’s reply brief, if filed.

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