

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 IPR2018-00914
Patent 9,511,929 B2

Before ANDREI IANCU, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*,
DREW HIRSHFELD, *Commissioner for Patents*, and SCOTT R. BOALICK,
Acting Chief Administrative Patent Judge.

PER CURIAM.

REVISED ORDER¹

¹ The Order entered on November 30, 2018 is expunged and replaced by this Revised Order.

Proppant Express Investments, LLC, and Proppant Express Solutions, LLC (collectively, “Petitioner”) request rehearing of the Patent Trial and Appeal Board (“Board”) decision denying institution of *inter partes* review and denying Petitioner’s Motion for Joinder. Paper 22, 1 (citing Papers 1, 3, 21). Specifically, Petitioner argues that the Board misinterpreted 35 U.S.C. § 315(c). *Id.*

This case presents an issue for Precedential Opinion Panel (“POP”) review. Board decisions conflict on the proper interpretation of 35 U.S.C. § 315(c). *Compare, e.g., Target Corp. v. Destination Maternity Corp.*, Case IPR2014-00508 (Paper 28) (Feb. 12, 2015) (concluding that 35 U.S.C. § 315(c) permits a petitioner to be joined to a proceeding in which it is already a party), *with SkyHawke Techs., LLC v. L&H Concepts, LLC*, Case IPR2014-01485 (Paper 13) (Mar. 20, 2015) (reaching opposite conclusion). A POP review is appropriate to address the following questions:

1. Under 35 U.S.C. § 315(c) may a petitioner be joined to a proceeding in which it is already a party?
2. Does 35 U.S.C. § 315(c) permit joinder of new issues into an existing proceeding?
3. Does the existence of a time bar under 35 U.S.C. § 315(b), or any other relevant facts, have any impact on the first two questions?

Accordingly, a POP review of Petitioner’s request for rehearing of the Board’s decision denying institution of *inter partes* review and denying Petitioner’s Motion for Joinder to Case IPR2017-02103 is ordered. Standard Operating Procedure 2 (“SOP 2”),² 3-7; Paper 21.

² Available at <https://go.usa.gov/xPMqx>.

Petitioner and Oren Technologies, LLC (“Patent Owner”) are authorized to simultaneously submit additional briefing, limited to the issues above, of no more than fifteen (15) pages each, due on December 28, 2018. The parties are instructed to discuss whether an oral hearing is necessary within the additional briefing.

Additionally, any *amicus curiae* are authorized to submit a brief to trials@uspto.gov, limited to the issues identified above, of no more than fifteen (15) pages and due on December 28, 2018. The *amicus curiae* briefs will be entered into the record by the Board.

Petitioner and Patent Owner are further authorized to file simultaneous responses to Patent Owner’s and Petitioner’s additional briefing, respectively, of no more than ten (10) pages each, due on January 14, 2019. The parties also may respond to the *amicus curiae* briefing in their responses.

Accordingly, based on the foregoing and pursuant to SOP 2, it is:

ORDERED that Petitioner’s Request for Rehearing of the Board’s Decision Denying Petitioner’s Motion for Joinder and Petition is submitted for POP review;

FURTHER ORDERED that the POP members for this POP review are Andrei Iancu, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*, Drew Hirshfeld, *Commissioner for Patents*, and Scott R. Boalick, *Acting Chief Administrative Patent Judge*;

FURTHER ORDERED that the POP intends to address the questions identified above;

FURTHER ORDERED that Petitioner and Patent Owner are authorized to simultaneously submit additional briefing, limited to the issues identified above, of no more than fifteen (15) pages each, due on December 28, 2018;

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FURTHER ORDERED that any *amicus curiae* are authorized submit a brief to trials@uspto.gov, limited to the issues identified above, of no more than fifteen (15) pages, due on December 28, 2018;

FURTHER ORDERED that Petitioner and Patent Owner are authorized to file a response to Patent Owner's and Petitioner's additional briefing, respectively, and also to any *amicus curiae* briefs, of no more than ten (10) pages, due on January 14, 2019;

FURTHER ORDERED that Case IPR2017-02103 will continue on schedule and the original Board panel maintains authority over IPR2017-02103; and

FURTHER ORDERED that, unless otherwise delegated, the POP will maintain authority over all issues in this case.

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