

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

IXI MOBILE (R&D) LTD.,
Patent Owner.

Case IPR2016-01669
Patent 7,552,124 B2

Before BRYAN F. MOORE, TREVOR M. JEFFERSON, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER

Staying Reexamination Control No. 90/013,988

37 C.F.R. §§ 42.5, 42.122(a)

INTRODUCTION

A conference call in the instant proceedings was held on August 21, 2017, pertaining to, inter alia, a request to file a motion to terminate or stay an *ex parte* reexamination of the '124 patent filed by Patent Owner on July 17, 2017 (Reexamination Control No. 90/013,793, “the Reexam”). *See* Ex. 1015 (Request for Reexamination). We authorized Petitioner to file the motion to terminate or stay the Reexam, and we authorized Patent Owner to file an opposition. The parties have filed their briefs. Papers 15 (Petitioner’s Motion to Termination or Stay Co-Pending Reexamination, “Mot.”), 17 (Patent Owner’s Opposition to Petitioner’s Motion to Termination or Stay Co-Pending Reexamination, “Mot. Resp.”).

With respect to the Reexam, we have considered the parties’ respective positions in the briefing. Reexaminations must be conducted with special dispatch under 35 U.S.C § 305, but we have discretion to terminate or stay a reexamination involving a patent challenged in an *inter partes* review under 37 C.F.R. § 42.122(a); *see also* 35 U.S.C. § 315(d) (granting Director discretion to terminate or stay such a reexamination).

Given the particular facts of these proceedings, we are persuaded that exercise of that discretion to stay but not terminate the Reexam is appropriate under the circumstances.

BACKGROUND

Petitioner asserted in Case IPR2016-01669 that claims 1–10 were unpatentable over the combination of either Maes and Preston or Pazandak, White, and Manson. We instituted as to claims 1–5 of the '124 patent on the

following asserted grounds: claims 1–5 under 35 U.S.C. § 103(a) as being unpatentable in view of Maes and Preston; and claims 1–5 under 35 U.S.C. § 103(a) as being unpatentable in view of Pazandak, White, and Manson. Paper 42 (Inst. Dec.), 40. As to claims 6–10, we determined “Petitioner [had] not shown sufficiently that the Specification discloses an algorithm [as required by § 112] for the function of parsing a keyword or any other structure to enable us to determine if the asserted prior art teaches such structure.” *Id.* at 9. Thus, we denied institution as to those claims. *Id.*

In the Reexam, Patent Owner asserts that the references in IPR2016-01669 and IPR2017-00898¹ raise substantial new questions of patentability as to claims 6–10. Ex. 1015, 15–43². Patent Owner also adds new claims 11–71 and asserts those are patentable over the references asserted in IPR2016-01669 and IPR2017-00898. Ex. 1015, 43–66. Despite the large number of claims the new independent claims 11 and 12, from which the rest of the claims depend, contain many similar limitations to claims 6–10. *See* Ex. 1015, 63–66; Ex. 3002; Mot. 5.

¹ Ittycheriah is cited with respect to the “means for parsing the high-level code” limitation, and Ittycheriah is incorporated by reference into Maes. Ex. 1015, 27–28.

² We cite to the page numbers added to the exhibit not the internal page numbers of the Request for Reexamination document.

ANALYSIS

Rexam Will Be Stayed

Petitioner asserts that the Reexam “should, at a minimum, be stayed” to avoid inconsistencies between the Reexam and the instant proceeding.

Mot. 4. Patent Owner asserts the Reexam should not be stayed. Mot.

Resp. 1. Patent Owner distinguishes Board decisions that stay reexamination in favor of IPRs by asserting “no such risk of ‘duplicative’ efforts or ‘inconsistencies’ exists in the present case because the claims that served as the basis for reexam are not involved in the IPR.” *Id.* at 3.

Nevertheless, there is significant overlap between this IPR and the Reexam, such that permitting the reexamination to proceed in parallel could duplicate efforts within the Office and potentially result in inconsistencies between the proceedings.

As noted above, Petitioner asserted that claims 1–10 of the ’124 patent are unpatentable under 35 U.S.C. § 103(a) based on various prior art references. The Office has ordered reexamination of claims 6–10 based on the same prior art references. *See* Ex. 3001, 6–11, 13. Although the Board did not institute as to claims 6–10, those claims are essentially means plus function versions of claims 1–5 and contain very similar limitations. *See* generally, Ex. 1001. Thus, consideration of claims 6–10 based on the same references as the current IPR will raise issues in the Reexam similar to those being explored in the current IPR.

Patent Owner cites to *Idle Free* for the proposition that a reexamination is the proper way for a Patent Owner to amend claims even

when it asserts the same grounds as an IPR. Mot. Resp. 2–3 (citation omitted). However, *Idle Free* was concerned with “a complete remodeling of [Patent Owner’s] claim structure according to a different strategy,” which is not the case here. *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, slip op. at 6 (PTAB June 11, 2013) (Paper 26). Here, Patent Owner simply adds two new claims in the Reexam.

The Reexam has been initiated, but the Office has not yet issued a Notice of Intent to Issue Ex Parte Reexamination Certificate. Ex. 3001. Patent Owner asserts the “Board ordinarily will not stay a reexamination because, in the absence of good cause, reexaminations are conducted with special dispatch.” Mot. Resp. 2 (quoting *IBG, LLC et al. v. Trading Tech. Int’l, Inc.*, Case CBM2015-00179, slip op. at 3 (PTAB May 2, 2016) (Paper 52) (citing 35 U.S.C. § 305)). Having two proceedings at the Office involving many very similar claim limitations and the same prior art taking place at the same time is inconsistent with the Board’s rules designed to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *see also* 37 C.F.R. § 42.122(a).

Rexam Will Not Be Terminated at This Time

Petitioner argues that the Reexam should be terminated because, as explained above, the examiner cannot resolve the issues relating to 35 U.S.C. § 112 with claims 6–10 and thus, “the examiner is at this point in a position where any further analysis of claims 6–10 would be inconsistent with the Board’s finding in the Institution Decision that these claims could not be interpreted.” Mot. 3. Patent Owner argues that

termination of the '124 Patent Reexam would unduly prejudice IXI by putting claims that are not involved in the instant IPR in a permanent state of limbo and would, in fact, reward Petitioner for failing to meet its IPR burden at institution by essentially treating the Board's preliminary decision of non-institution with respect to certain claims as a final determination that the non-instituted claims are unpatentable.

Mot. Resp. 5. Because the Reexam involves different claims than those remaining at issue in this IPR, we determine that termination of the Reexam is not called for at this time. This decision not to terminate the Reexam may be revisited at a later date.

CONCLUSION

Based on the particular facts of the instant proceeding and the Reexam, we determine that the fairest and most efficient course of action is to stay the Reexam until the instant proceeding is terminated or completed.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Reexamination Control No. 90/013,988 is stayed pending the termination or completion of Case IPR2016-01669; and

FURTHER ORDERED that this stay tolls all time periods for filing further papers in Reexamination Control No. 90/013,988, and no further papers shall be filed in the reexamination while this stay remains in place.

IPR2016-01669
Patent 7,552,124 B2

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