

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT-PACKARD COMPANY,
Petitioner,

v.

MCM PORTFOLIO LLC.
Patent Owner.

Case IPR2013-00217 (JYC)
Patent 7,162,549

Before SCOTT R. BOALICK, KARL D. EASTHOM, and JONI Y. CHANG,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

ORDER
Staying Concurrent Examination of Reissue Application
37 C.F.R. § 42.122(a)

On May 9, 2013, a telephone conference call was held between respective counsel for the parties and Judges Boalick, Easthom, and Chang. During the conference call, counsel for Petitioner requested that the examination of the reissue application, U.S. Application No. 12/351,691 (“the ’691 reissue application”) be stayed. Patent Owner did not oppose the request. For reasons discussed below, Petitioner’s request to stay the concurrent examination of the ’691 reissue application is *granted*.

Section 315(d) of title 35 of United States Code, as amended by the America Invents Act (AIA), provides:

Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

The petition for *inter partes* review of Patent 7,162,549 (“the ’549 patent”) was filed on March 27, 2013. The petition challenges the patentability of claims 7, 11, 19, and 21 of the ’549 patent. The co-pending ’691 reissue application also involves the ’549 patent.

Conducting the examination of the ’691 reissue application concurrently with the instant proceeding would duplicate efforts within the Office and could potentially result in inconsistencies between the proceedings. Notably, the patentability of claims 7, 11, 19, and 21 of the ’549 patent is being determined in both proceedings. A notice of appeal was filed on May 1, 2013 in the ’691 reissue application. The Board was informed by the parties that while the challenged claims are not rejected by the Examiner in the ’691 reissue application, some of the prior art references relied upon in the *inter partes* review petition have not been

considered by the Examiner. If the prosecution is reopened, Patent Owner could amend the claims in the reissue application and change the scope of the challenged claims while the Board is conducting its review (should a review be instituted).

In addition, staying the examination of the '691 reissue application would not impact any statutory time period for the Examining Corps, as the prosecution is closed and the time period for filing an appeal brief is a regulatory time period (*see* 37 C.F.R. § 41.37(a)).

Moreover, the Board is required to determine whether to institute an *inter partes* review within three months after receiving a preliminary response from Patent Owner, or the date on which such a response is due. *See* 35 U.S.C. § 314(b), as amended by the AIA. The final determination of any review instituted will normally be issued no later than one year from institution. *See* 35 U.S.C. § 316(a)(11), as amended by the AIA; 37 C.F.R. § 42.100(c). Any Board decision on whether to institute a review or final written decision with respect to the patentability of the challenged claims may simplify the issues in the reissue application as well.

Based upon the facts presented in the instant proceeding and in the '691 reissue application, the Board exercises its discretion under 35 U.S.C. § 315(d), as amended by the AIA, and 37 C.F.R. § 42.122(a), and orders that examination of the '691 reissue application be stayed pending the termination or completion of the instant proceeding.

Case IPR2013-00217
Patent 7,162,549

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