

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIRRUS DESIGN CORPORATION,
Petitioner,

v.

HOYT AUGUSTUS FLEMING,
Patent Owner.

Case IPR2019-01566
Patent RE47,474 E

Before JOSIAH C. COCKS, SCOTT C. MOORE, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

ORDER
Denying Petitioner's Motion to Stay
35 U.S.C. §315(d); 37 C.F.R. §§ 42.3, 122

1. Introduction

On February 21, 2020, Petitioner, Cirrus Design Corporation, filed a “Motion to Stay Pending Reissue Proceedings,” (Paper 25, “Motion” or “Mot.”) and on March 2, 2020, Patent Owner, Hoyt Augustus Fleming, filed an Opposition (Paper 28, “Opp.”) to Petitioner’s Motion.¹ For the reasons set forth below, we deny the Motion.

2. Discussion

In its Motion, Petitioner moves to stay examination of Application Nos. 16/422,357 and 16/422,440 that Petitioner characterizes as “Pending Reissues” of Patent RE474,474 E (the “’474 patent”). According to Petitioner, those “Pending Reissues” “involve” the ’474 patent and the Board has the authority to stay them. *See* Mot. 3–8. Petitioner also generally argues that not granting the Motion “will result in duplicative efforts and risk inconsistent results,” but that granting the Motion “will simplify the issues before the Examiner” in connection with the examination of the above-noted reissue applications. *Id.* at 8–10. Petitioner further contends that it would face prejudice if the Motion is not granted. *Id.* at 10.

For its part, Patent Owner contends that the noted reissue applications are not themselves reissues of the ’474 patent, and instead constitute continuation applications of the reissue application that issued as the ’474 patent. Opp. 2–3.² Patent Owner also contends that the Continuation Reissue Applications are not the “involved” application or patent (or

¹ Both filings were previously authorized by the panel. Paper 23.

² Patent Owner refers to the pertinent applications as the “Continuation Reissue Applications.” *Id.* at 2. Hereinafter, we do the same.

“involving the patent”) within the meaning of the term “involved” or “involving” as appears in each of 35 U.S.C. § 315(d) and 37 C.F.R. §§ 42.3, 42.122. *Id.* at 3–4. Patent Owner further notes that the term “involved” is expressly defined in 37 C.F.R. § 42.2 as meaning “an application, patent, or claim that is the subject of the proceeding.” *Id.* at 4. Patent Owner, thus, is of the view that the Continuation Reissue Applications are not the involved patent of this *inter partes* review proceeding, namely the ’474 patent. Patent Owner further contends that the Board lacks jurisdiction to stay the Continuation Reissue Applications, and in support of that contention directs our attention to various other panel orders or decisions that Patent Owner contends are analogous to the situation here, and which did not result in requested stays. *Id.* at 4–6. Patent Owner additionally contends that factors laid out in Paper 15 of *CBS Interactive v. Helerich Patent Licensing, LLC* (IPR2013-00033) that were considered in whether to grant a stay of a parallel proceeding involving the same patent before a Board proceeding “Militate Against a Stay.” *Id.* at 7–9. Lastly, Patent Owner contends that it would be prejudiced if the Motion is granted. *Id.* at 9–10.

Having considered the respective positions of the parties, we conclude that granting Petitioner’s motion is not warranted. Section 315(d) of 35 U.S.C. is clear on its face that the Board may take action in another proceeding, such as a stay, where that proceeding involves “the patent” that is the subject of the *inter partes* review. Section 42.2 of 37 C.F.R. also is clear in its definition of “involved” as meaning “an application, patent or claims that is the subject of a proceeding.” And, the rules directed to the Board’s action to take jurisdiction (37 C.F.R. § 42.3) or take other action in a proceeding, such as a stay (37 C.F.R. § 42.122), are unambiguous in their

reference to an involved application or patent. Petitioner simply does not explain why we should consider that the Continuation Reissue Applications, which are not the '474 patent that is the subject of this *inter partes* review proceeding, nevertheless, “involve” the '474 patent. Mot. 6.

Moreover, the circumstances here are not new or distinct from those that have been contemplated before by other Board panels. For instance, in *EMC Corporation and VMware, Inc. v. Personal Web Technologies, LLC*, IPR2013-00083, Paper 12 (PTAB Mar. 21, 2013), a petitioner requested a stay in prosecution of continuing applications characterized as related to patents that were involved in several *inter partes* reviews. The panel declined the request noting that the petitioner there “fail[ed] to recognize that an *inter partes* review merely involves a review of **the involved patent**, rather than a family of patents.” *EMC Corporation* at 2 (citing 35 U.S.C. 311(b) (“A petitioner in an *inter partes* review may request to cancel as unpatentable 1 or more claims of **a patent**.” (Emphasis added))). Similar requests in other proceedings were also denied by panels. *See Apotex, Inc. v. Wyeth LLC*, IPR2014-00115, Paper 19, 5–6 (May 29, 2014 PTAB) (“[W]hile the Board may stay a reexamination proceeding pursuant [to] 35 U.S.C. in the situation where the involved patent is the subject of [a] reexamination proceeding, there is nothing in the statute that extends that authority to allow the Board to take jurisdiction over related applications.”); *see also Chums, Inc. v. Cablz, Inc.*, IPR2014-01240, Paper 22, 2 (May 8, 2015 PTAB) (“Although the Board may stay a reexamination proceeding when the involved patent is subject to reexamination, the Board does not have the authority under 35 U.S.C. § 315(d) to stay prosecution of related patent applications.”) The assessment of the Board’s authority arising under

§ 315(d) in prior proceedings pertaining to similar stay requests does not favor granting Petitioner's Motion here.

Finally, Petitioner provides little detail as to the nature of any prejudice it allegedly faces if its Motion is denied. Petitioner also does not articulate credibly why "duplicative efforts" or "inconsistent results" are likely to arise should the Motion be denied. *See* Mot. 8. On the other hand, Patent Owner provides credible examples of prejudice that it would face if the Continuation Reissue Applications were to be stayed, namely that a stay (1) would delay co-pending litigation in the District Court of the District of Minnesota, and (2) would prevent the Office from meeting its obligation to Patent Owner to take up the reissue applications as special. *Id.* at 9–10. Petitioner does not reasonably justify or support its assertion that potential prejudice faced by Patent Owner "is far outweighed by the prejudice to the Petitioner" should the Motion be denied. *Id.* at 10.

We have considered Petitioner's Motion but conclude that, on the record before us, granting the Motion is not appropriate. Accordingly, we do not do so.

3. Order

It is

ORDERED that "Petitioner's Motion to Stay Pending Reissue Proceedings" (Paper 25) is *denied*.

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