

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMC Corporation and VMware, Inc.
Petitioner,

v.

Personal Web Technologies, LLC.
Patent Owner.

Cases IPR2013-00083 (Patent 6,415,280)
IPR2013-00084 (Patent 7,945,544)
IPR2013-00086 (Patent 7,949,662)
IPR2013-00087 (Patent 8,001,096)¹

Before KEVIN F. TURNER, JONI Y. CHANG, and MICHAEL R. ZECHER,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

DECISION
EMC Motion to Take Jurisdiction of Applications
37 C.F.R. § 42.3(a)

¹ This decision addresses an issue that is identical in all four cases. Therefore, we exercise discretion to issue one opinion to be filed in each of the four cases. The parties, however, are not authorized to use this style heading in any subsequent papers.

IPR2013-00083, Patent 6,415,280
IPR2013-00084, Patent 7,945,544

IPR2013-00086, Patent 7,949,662
IPR2013-00087, Patent 8,001,096

For each above-identified proceeding, EMC Corporation and VMware, Inc. (“EMC”) filed a petition under 35 U.S.C. § 311 to institute an *inter partes* review of a patent. The following are the involved patents in these proceedings before the Board: Patent 6,415,280, Patent 7,945,544, Patent 7,949,662, and Patent 8,001,096. EMC’s petitions include a request that the Board take jurisdiction over, and suspend prosecution of, all related continuing applications including applications 13/091,380, 13/102,237, 13/109,208, 13/351,433, and 13/352,169. (Paper 6, “Pet.” 1-2, Ex. 1008.²) We treat the request as a motion.³ For the reasons *infra*, the motion is DENIED.

In support of its request, EMC argues that the continuing applications may be used as a basis to present patentably indistinct claims which would be inconsistent with 37 C.F.R. § 42.73(d)(3)(i), and circumvent 37 C.F.R. § 42.121(a)(3), which merely permits the patent owner to propose a reasonable number of substitute claims in a motion to amend claims. (Pet. 1.) We are not persuaded by EMC’s arguments because EMC fails to recognize that an *inter partes* review merely involves a review of **the involved patent**, rather than a family of patents and applications. *See e.g.*, 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.)

² For the purpose of clarity and expediency, IPR2013-00083 is representative and all citations are to IPR2013-00083 unless otherwise noted.

³ A party requesting relief ordinarily must seek Board authorization to file a motion. 37 C.F.R. § 42.20. Here, we exercise our discretion to treat EMC’s request as a motion. 37 C.F.R. §§ 42.1(b) and 42.5(b). This decision makes no determinations on the other issues raised in the petitions.

IPR2013-00083, Patent 6,415,280
IPR2013-00084, Patent 7,945,544

IPR2013-00086, Patent 7,949,662
IPR2013-00087, Patent 8,001,096

Pursuant to 35 U.S.C. § 315(d), the Board may stay a reexamination proceeding, but only in the situation where **the involved patent** is subject to the reexamination. However, nothing in 35 U.S.C. § 315(d) provides the Board the authority to take jurisdiction over related continuing applications.

EMC's concern that the patent owner may circumvent the result of an *inter partes* review by presenting patentably indistinct claims in other applications is misplaced. Each application pending before the Office has been assigned to a designated deciding official. More importantly, the Director has delegated his or her authority under 35 U.S.C. § 131 ("The Director shall cause an examination to be made of the application . . . ") to the Examining Corp. For each related continuing application, the designated patent examiner is the deciding official who has jurisdiction over that application. The examiner may suspend the application pending the outcomes of these *inter partes* review proceedings if the examiner determines such an action is appropriate.

For the foregoing reasons, it is

ORDERED that EMC's request for the Board to exercise exclusive jurisdiction over all related continuing applications and to suspend prosecution of those applications is DENIED; and

FURTHER ORDERED that a copy of this decision be entered in the administrative records of applications 13/091,380, 13/102,237, 13/109,208, 13/351,433, and 13/352,169.

IPR2013-00083, Patent 6,415,280
IPR2013-00084, Patent 7,945,544

IPR2013-00086, Patent 7,949,662
IPR2013-00087, Patent 8,001,096

PETITIONER:

Peter M. Dichiara, Esq.

David L. Cavanaugh, Esq.

WILMER CUTLER PICKERING HALE & DORR LLP

peter.dichiara@wilmerhale.com

daidcavanaugh@wilmerhale.com

PATENT OWNER:

Joseph A. Rhoa, Esq.

Updeep. S. Gill, Esq.

NIXON & VANDERHYE P.C.

jar@nixonvan.com

usg@nixonvan.com