

Paper No. _____
Filed: January 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WINTEK CORPORATION
Petitioner

v.

TPK TOUCH SOLUTIONS INC.
Patent Owner

Case IPR2013-00567
Case IPR2013-00568
Patent 8,217,902

**Joint Motion to Stay *Ex Parte* Reexamination
of U.S. Patent No. 8,217,902**

I. Brief Statement of Relief Requested

In response to the Board’s order issued on January 9, 2014, Petitioner Wintek Corp. (“Wintek” or “Petitioner”) and Patent Owner TPK Touch Solutions Inc. (“TPK” or “Patent Owner”) jointly request the Board to stay the *ex parte* reexamination (control no. 90/012,869) of U.S. Patent No. 8,217,902 (“the ’902 patent”) pending resolution of this *inter partes* review of the ’902 patent.

II. Statement of Material Facts

A. Litigation

1. TPK asserted the ’902 patent against Wintek in a patent infringement litigation filed on May 15, 2013 in the Northern District of California (case no. 3:13-cv-2218).

B. *Ex Parte* Reexamination Control No. 90/012,869

2. On May 17, 2013, a request for *ex parte* reexamination of claims 1-68 of the ’902 patent was filed, which was assigned control no. 90/012,869 (“the ’869 reexamination”). The request proposed 18 grounds of rejection based on the following six references: Japanese Published Patent Application No. 60-75927 (“*Fujitsu*”); U.S. Patent No. 6,137,427 (“*Binstead*”); Japanese Published Patent Application No. 61-84729 (“*Honeywell*”); Published UK Patent Application GB 2 168 816 A (“*Lambert*”); U.S. Patent Application

Publication No. 2005/0030048 (“*Bolender*”); and U.S. Patent No. 5,374,787 (“*Miller*”).

3. On June 20, 2013, the Office found that the prior art identified in the reexamination request raises substantial new questions of patentability of claims 1-68 of the ’902 patent and ordered *ex parte* reexamination.
4. On November 15, 2013, the Office issued an office action, rejecting claims 1-68 based on the 18 grounds of rejection proposed in the request.
5. On January 6, 2014, TPK filed a response to the Office Action. In its response, TPK added 7 new independent claims 69-75. The ’869 reexamination remains pending before the Office.

C. IPR2013-00567 and IPR2013-00568

6. On September 4, 2013, Wintek filed two petitions for *inter partes* review (“IPR”) of claims 1-68 of the ’902 patent. These petitions were assigned case nos. IPR2013-00567 (“the 567 Petition”) and IPR 2013-00568 (“the 568 Petition”). The 567 and 568 Petitions collectively present a total of 18 grounds that challenge the patentability of claims 1-68 of the ’902 patent. The IPR petitions also rely on substantially the same prior art identified in the ’869 reexamination, namely *Fujitsu*, *Binstead*, *Honeywell*, *Lambert*, *Bolender*, and *Miller*, and one additional reference, U.S. Patent Application Publication No. 2007/0229469 (“*Seguine*”). In particular, the 567 Petition

involves nine grounds based on two primary prior art references *Binstead* and *Lambert*, along with various combinations of those references with *Honeywell*, *Bolender*, *Miller*, and *Seguine*. The 568 Petition involves nine grounds based on two primary prior art references *Fujitsu* and *Honeywell*, along with various combinations of those references with *Binstead*, *Miller*, *Seguine*, and *Bolender*.

7. TPK filed preliminary responses in the IPR2013-00567 and IPR2013-00568 proceedings on December 11, 2013. The Board has not yet decided whether to institute trial in these two IPR proceedings.

III. Full Statement of the Reasons for Stay

Under 35 U.S.C. § 315(d), “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.” 35 U.S.C. § 315(d); *see also* 37 C.F.R. §§ 42.122(a), 42.3(a). In determining whether to grant a stay of a pending reexamination proceeding, the Board considers several factors including: (1) whether claim amendments in one proceeding could interfere with another proceeding; (2) whether the proceedings include common issues, such that conducting the proceedings concurrently would result in an inefficient use of Office resources or produce inconsistent results; and

(3) whether an IPR proceeding could result in a decision on the merits before a final decision in a reexamination, simplifying the issues remaining in the reexamination proceeding. *See, e.g., Goertek, Inc. v. Knowles Elecs., LLC*, IPR2013-00614, Paper 11 at 3 (Nov. 13, 2013).¹ The issues involved with respect to the IPR2013-00567 and IPR2013-00568 proceedings and the '869 reexamination warrant granting a stay of the '869 reexamination.

First, claim amendments made in the '869 reexamination could interfere with the conduct of the IPR2013-00567 and IPR2013-00568 proceedings. Indeed, TPK added seven new independent claims in its response to the first Office Action in the '869 reexamination, demonstrating the potential for amendments in that proceeding. The new claims include some limitations that track those of issued claims 1-68 of the '902 patent. These and/or any other claim amendments introduced in the '869 reexamination could interfere with the IPR2013-00567 and

¹ *See also Samsung Elecs. Co. Ltd. v. Fractus, S.A.*, IPR2014-00008, Paper 14 at 4 (Nov. 12, 2013); *Google, Inc. v. Grandeye, Ltd.*, IPR2013-00548, Paper 7 at 2 (Sept. 30, 2013); *Lumondi Inc. v. Lennon Image Techs. LLC*, IPR2013-00432, Paper 7 at 2 (Aug. 6, 2013); *CB Distributors, Inc. v. Ruyan Investments (Hldgs.) Ltd.*, IPR2013-00387, Paper 6 at 2 (July 24, 2013); *The Scotts Co., LLC v. Encap, LLC*, IPR2013-00110, Paper 10 at 2-3 (May 13, 2013).

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