

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INCORPORATED,
Petitioner,

v.

JOHN D'AGOSTINO,
Patent Owner.

Case IPR2014-00543
Patent 8,036,988

Before SALLY C. MEDLEY, KARL D. EASTHOM, and
KALYAN K. DESHPANDE, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION
Motion to Stay Reexamination Proceeding
35 U.S.C. § 315(d)

Motion to Stay Ex Parte Reexamination Proceeding 90/012,517

The Board held an initial conference call with Petitioner and Patent Owner on September 17, 2014. Petitioner requested authorization to file a motion to stay Ex Parte Reexamination Proceeding 90/012,517 (“the Reexamination”), because a Notice of Intent to Issue a Reexam Certificate (“NIRC”) was mailed on September 12, 2014 that allegedly is inconsistent with our Decision to Institute. Paper 10, 1. We authorized Petitioner to file a motion to stay. Petitioner filed a motion to stay the Reexamination (“Mot.”) on September 22, 2014. *See* Paper 11. Patent Owner filed an opposition (“Opp.”). *See* Paper 13.

Pursuant to 35 U.S.C. § 315(d):

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.

See also 37 C.F.R. § 42.122(a) (“Board may . . . enter any appropriate order regarding . . . stay, transfer, consolidation, or termination”). The Board ordinarily will not stay a reexamination because, in the absence of good cause, reexaminations are conducted with special dispatch. *See* 35 U.S.C § 305.

Petitioner argues a stay is necessary to “prevent inconsistency, confusion and the appearance that the PTO and/or this board has sanctioned two different diametrically opposed decisions.” Mot. 2. Petitioner specifically argues that “because adversarial proceedings are more likely to reach the correct result . . . the Reexamination should be stayed pending final resolution of the *inter partes*

review.” *Id.* at 2-3. Patent Owner contends that a stay is against the Board’s policy because the results of the Reexamination are known and public. Opp. 2-3.

We agree with Patent Owner. The Reexamination resulted in the issuance of a NIRC and, therefore, the Examiner’s decision is known and public. Staying the reexamination proceeding would not undue what already has been done. *See Toshiba Corporation v. Intellectual Ventures II LLC*, Case IPR2014-00317, Paper 10, 3 (PTAB May 6, 2014). Accordingly, we are not persuaded by Petitioner’s argument.

Petitioner further argues that the CRU Examiner “appears to not have had the benefit of this Board’s thorough Decision.” Mot. 1-2. However, our Decision to Institute *inter partes* review was available to the CRU Examiner on the mailing date of September 4, 2014. *See* Paper 8. The NIRC was mailed on September 12, 2014. Paper 10, 2. Therefore, we are not persuaded that the CRU Examiner did not have the benefit of our Decision to Institute *inter partes* review in concluding to issue the NIRC, because our Decision was available for eight days before the CRU Examiner issued the NIRC. In any event, Petitioner has not shown that granting a stay of the reexamination proceeding means necessarily that the CRU Examiner will make changes based on the Decision to Institute. Petitioner additionally contends that the Reexamination should be stayed because (1) the CRU’s conclusion is incorrect and (2) Patent Owner’s position with regards to the motion to stay has been inconsistent. Mot. 3-5. Petitioner has not shown, however, how these arguments are relevant to our determination of whether to stay the Reexamination. Accordingly, we are not persuaded by Petitioner to stay the

Case IPR2014-00543
Patent 8,036,988

Reexamination.

Order

It is

ORDERED Petitioner's motion to stay Ex Parte Reexamination Proceeding
90/012,517 is *denied*;

PETITIONER:

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