

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.  
Petitioner

v.

SUMMIT 6 LLC  
Patent Owner

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CASE: IPR2015-00806  
Patent No. 7,765,482

Title: Web-Based Media Submission Tool

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**MOTION TO STAY *EX PARTE* REEXAMINATION  
90/012,987 UNDER 35 U.S.C. § 315(d)**

## **I. Statement of Relief Requested**

Patent Owner Summit 6 LLC (“Summit 6”) requests that the Board stay *ex parte* Reexamination Control No. 90/012,987 of U.S. Patent No. 7,765,482 (“the ’482 Patent”) (“the ’482 Reexamination”) pending resolution of this *inter partes* review of the ’482 Patent. The Board authorized this motion by email correspondence on September 22, 2015.

All claims at issue in the ’482 Reexamination are under review in this proceeding, and similar prior art references are being relied upon in the disposition of both proceedings. Therefore, Summit 6 moves to stay the pending ’482 Reexamination to avoid duplicative effort and inconsistent findings.

## **II. Procedural History**

On February 23, 2011, Summit 6 filed a Complaint against Samsung, RIM, Facebook, and others for infringing the ’482 Patent. Before trial, RIM and Facebook executed a license agreement with Patent Owner covering U.S. Pat. No. 6,895,557 and the ’482 Patent. (Ex. 2001; Ex. 2002.) Samsung went to trial for infringing the ’482 patent and lost.

After a week-long trial, the jury found claims 40, 44–46, and 49 of the ’482 Patent valid over Mattes, among other prior art, and further found that Samsung infringed those claims. (Ex. 2003.) The jury awarded Summit 6 \$15M as

compensation for Samsung's infringement. (*Id.*) The Federal Circuit recently affirmed the jury's validity, infringement, and damage findings. *See Summit 6, LLC v. Samsung Electronics Co., Ltd.*, Nos. 2013-1648, 1651, 2015 WL 5515331 (Fed. Cir. Sept. 21, 2015).

After losing in the district court, Samsung collaterally attacked the '482 Patent. On September 10, 2013, Samsung filed a request for *ex parte* reexamination of claims 38, 40, 44–46 and 49 of the '482 Patent. (Ex. 2036.) The Office granted Samsung's request<sup>1</sup> (Ex. 2039, Decision Ordering Reexamination) and rejected claims 38, 40, 44–46 and 49 of the '482 patent in view of Creamer and Mattes (Ex. 2040, Final Office Action.) Summit 6 has filed its Appeal Brief (Ex. 2041) challenging the Examiner's claim construction and each ground of rejection, including Creamer, and the Examiner has filed its Answer to Summit 6's Appeal Brief, (Ex. 2042). A hearing before the Board addressing the '482 Reexamination is scheduled for November 10, 2015. (Ex. 2043, Notice of Hearing.)

Since the beginning of this year, Summit 6 has been defending the '482 Patent in five different *inter partes* review proceedings brought by five different

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<sup>1</sup> Petitioner filed the Creamer reference as Exhibit No. 1004. Mattes is concurrently filed herewith as Exhibit 2037.

parties. First, on February 4, 2015, Twitter, Inc. and Apple, Inc., filed four Petitions for *inter partes* review of the '482 Patent. See IPR2015-00685, IPR2015-00686, IPR2015-00687, IPR2015-00688. On February 25, 2015, Petitioners Google Inc., HTC Corp, and HTC America, Inc. filed an additional Petition for *inter partes* review of the '482 Patent. See IPR2015-00806, Paper 1.<sup>2</sup> The Board instituted a trial in IPR2015-00806 on September 9, 2015, reviewing claims 12, 13, 16, 18, 19, 21–25, 35–38, 40–42, 44–46, and 49 of the '482 Patent. (Paper 19.)

### III. The '482 Reexamination Must Be Stayed

Where the claims and prior art overlap between a reexamination proceeding and an *inter partes* review, the Board has routinely stayed the reexamination proceeding to avoid duplicative effort and inconsistent findings. “[I]f another

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<sup>2</sup> Summit 6 has since entered settlement agreements with Twitter, Inc., Apple, Inc., HTC Corp., HTC America, Inc. LG Electronics USA, Inc., LG Electronics MobileComm USA, Inc., LG Electronics, Inc., and Motorola Mobility LLC, terminating IPR2015-00685–88 and the underlying civil case. See IPR2015-00685, Paper 17; IPR2015-00686, Paper 17; IPR2015-00687, Paper 17; IPR2015-00688, Paper 17; IPR2015-00806, Paper 11 and *Summit 6, LLC v. HTC Corp.*, No. 7:14-cv-00014-O (N.D. Tex. June 17, 2015) (Dkt. 289), attached hereto as Ex. 2038. Google, Inc. remains as Petitioner in IPR2015-00806.

proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the post grant review or other proceeding or matter may proceed, including providing for the stay, transfer, consolidation, or termination of any such matter or proceeding.” 35 U.S.C. § 325(d); *see also* 37 C.F.R. §§ 42.222(a), 42.3(a). *See, e.g., Samsung Elecs. Co. Ltd. v. Fractus, S.A.*, IPR2014-00008, Paper 14 (Nov. 12, 2013) (staying pending reexaminations for judicial economy).

The Board must issue its final written decision within a statutorily prescribed period. 35 U.S.C. § 316(a)(11) (final determination must be made within one-year from institution); *see also* 37 C.F.R. § 42.100(c). But because there is no time limit for the Board to decide an appeal in an *ex parte* reexamination proceeding, any final written decision with respect to the patentability of the challenged claims will likely simplify the issues in the reexamination, regardless of the stage of the proceedings. *See Samsung*, IPR2014-00008, Paper 14 at 4 (granting motion to stay *inter partes* reexamination appeals set for hearing before the Board); *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 11 at 2 (Dec. 21, 2012); *The Scotts Co. LLC v. Encap, LLC*, IPR2013-00110, Paper 10 at 3 (May 13, 2013).

When determining whether to stay a pending reexamination, the Board commonly weighs the following factors: (1) whether the claims are the same; (2)

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