

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner

v.

SUMMIT 6 LLC,
Patent Owner

Case IPR2015-00806
Patent No. 7,765,482

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
STAY *EX PARTE* REEXAMINATION 90/012,987**

US2008-762265-2

I. Introduction

The Board should deny Summit 6's Motion to Stay *Ex Parte* Reexamination No. 90/012,987 (the "reexam"). Affirming the rejections of the claims at issue in the reexam may substantially simplify the issues in this proceeding. Thus allowing the reexam to proceed may conserve the resources of the Board and the parties.

The reexam was filed by a third party more than two years ago and long before Petitioner filed its Petition for *inter partes* review ("IPR"). During that time the Examiner has issued a final rejection, the Patent Owner has appealed, and the Board has scheduled an oral argument in early November. The Board will hear oral argument in the reexam before Patent Owner even files its Response in the IPR, and, in all likelihood, the Board will issue a final decision in the reexam before Petitioner files its Reply. If the Board confirms the Examiner's finding that the claims are invalid, the scope of this proceeding will be narrowed substantially. Thus, allowing the reexam to continue may conserve resources of both the Board and the parties by simplifying the issues in this IPR.

II. Statement of Undisputed Facts

The reexam was filed on September 10, 2013. The Examiner issued a Final Office Action on May 21, 2014 articulating three grounds of rejection: (1) claims 38, 40, 44-46, and 49 rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,930,709 ("Creamer"), (2) claims 38, 40, 44-46, and 49 rejected under

35 U.S.C. §102(e) as anticipated by U.S Patent No. 6,038,295 (“Mattes”), and (3) claim 46 rejected under 35 U.S.C. § 103 as obvious over Mattes in view of Creamer. (Ex. 2040) Patent Owner appealed the Examiner’s decision to the Board on September 22, 2014. (Ex. 2041) The Board scheduled oral argument for November 10, 2015. (Ex. 2043)

The petition for *inter partes* review was filed almost 18 months after the reexam. (Paper 1) In this proceeding the Board instituted review of claims 12, 13, 16, 18, 19, 21-25, 35-37, 38, 40, 44-46, and 49 for two grounds of obviousness under 35 U.S.C. § 103: (1) the combination of Creamer in view of U.S. Patent No. 6,223,190 (“Aihara”), and (2) the combination of U.S. Patent No. 6,018,774 (“Mayle”) in view of U.S. Patent No. 6,035,323 (“Narayen”). (Paper 19) Unless the parties amend the schedule, Patent Owner’s Response and/or Amendment will be due on November 25, 2015, more than two weeks *after* the oral argument in the reexam. (Paper 20) Oral argument (if requested) in this proceeding is set for May 4, 2016, almost six months *after* the oral argument in the reexam. (Paper 20)

III. Summary of Argument

The Board generally “will not stay a reexamination proceeding because, in the absence of good cause, the reexamination proceeding ‘will be conducted with special dispatch.’” *Chicago Mercantile Exch., Inc. v. 5th Mkt., Inc.*, CBM2014-00114, Paper 20 at 3 (Jan. 9, 2015) (citing 35 U.S.C. § 305). The Board is not

required to stay a reexamination simply because a concurrent proceeding involves the “same patent, a number of the same claims, and some overlap in the prior art” because 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a) use permissive, rather than mandatory language, in authorizing the Board to enter any appropriate order to manage multiple proceedings. *Id.*

When determining whether to stay a pending reexamination, the Board commonly weighs the following factors: (1) whether the claims are the same; (2) whether the grounds of rejection are based on the same or similar prior art; (3) whether the proceedings could lead to duplication of effort or inconsistent results; and (4) whether the requesters in the proceedings are the same. *CBS Interactive v. Helferich Patent Licensing*, IPR2013-00033, Paper 15 at 2 (Nov. 6, 2012).

Patent Owner improperly considered the facts at issue here and failed to give proper weight to the advanced stage of the reexam. Indeed, Patent Owner simply ignored the fourth factor of the analysis, relegating it to a footnote. As detailed below, when properly considered each of these four factors is either neutral or strongly favors denying Patent Owner’s Motion to Stay.

IV. Whether the Claims are the Same

The claims currently rejected in the reexam are a small subset of the claims under review in this proceeding. However, due to the late stage of the reexam, this factor militates against a stay. If the Board affirms the Examiner’s finding that

claims 38, 40, 44-46, and 49 are anticipated, and Patent Owner does not appeal to the Federal Circuit, the Board will not have to determine whether those claims are also obvious in this proceeding. This will narrow this proceeding.

Further, given the usual speed of the reexam appeal process, it is likely that the Board will issue a decision in the reexam before it issues a decision here. Of the 51 pending *ex parte* reexamination appeals before the Board, none has been pending before the Board for more than 14 months.¹ Assuming the Board maintains this trend, a final decision on the reexam can be expected later this year or early next year, before the conclusion of briefing in this proceeding and well before a final decision in this proceeding. Accordingly, this factor weights in favor of allowing the reexam to continue.

V. Whether the Grounds of Rejection are Based on the Same or Similar Prior Art

This factor weighs against a stay. The prior art issues raised in the two proceedings are different. The reexam raises anticipation rejections over Creamer and Mattes, and an obviousness rejection of one claim in view of Creamer and Mattes. In contrast, every claim in this proceeding is challenged under obviousness in view of two different combinations: (1) Creamer and Aihara; and

¹ See August 2015 P.T.A.B. Data (last visited Sept. 26, 2015)

<http://www.uspto.gov/dashboards/patenttrialandappealboard/main.dashxml>

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.