

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 7,765,482 B2

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Before HOWARD B. BLANKENSHIP, GEORGIANNA W. BRADEN, and  
KERRY BEGLEY, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

DECISION

Granting Motion to Stay *Ex Parte* Reexamination Control No. 90/012,987  
*35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a)*

Summit 6 LLC (“Patent Owner”) filed a Motion to Stay *Ex Parte* Reexamination Control No. 90/012,987 (“the Reexamination”), a proceeding pending before the Board that involves the patent at issue in this proceeding, U.S. Patent No. 7,765,482 B2 (“the ’482 patent”). Paper 22 (“Mot.”).

Google Inc. (“Petitioner”) filed an Opposition to Patent Owner’s Motion. Paper 24 (“Opp.”). For the reasons given below, we grant the Motion.

### BACKGROUND

In this proceeding, on September 9, 2015, we instituted *inter partes* review of claims 12, 13, 16, 18, 19, 21–25, 35–38, 40–42, 44–46, and 49 of the ’482 patent on two grounds of unpatentability asserted by Petitioner, obviousness in view of: (1) Creamer<sup>1</sup> and Aihara,<sup>2</sup> and (2) Mayle<sup>3</sup> and Narayan.<sup>4</sup> Paper 19 (“Inst. Dec.”).

The Reexamination was initiated by a third-party request for *ex parte* reexamination of claims 38, 40, 44–46, and 49 of the ’482 patent. Ex. 2036. The Office granted the request on November 6, 2013, Ex. 2039, and issued a Final Office Action on May 21, 2014, finding the claims unpatentable based on three grounds of rejection: (1) claims 38, 40, 44–46, and 49 as anticipated by Creamer, (2) claims 38, 40, 44–46, and 49 as anticipated by Mattes,<sup>5</sup> and (3) claim 46 as obvious over Creamer and Mattes, Ex. 2040. Patent Owner appealed to the Board. Ex. 2041. On September 18, 2015, the Board scheduled the appeal for hearing on November 10, 2015. Ex. 2043.

### ANALYSIS

Under 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a), the Board, “during the pendency of an *inter partes* review,” may provide for the “stay, transfer, consolidation, or termination” of any other proceeding or matter before the Office that involves the same patent. 35 U.S.C. § 315(d);

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<sup>1</sup> U.S. Patent No. 6,930,709 B1 (issued Aug. 16, 2005) (Ex. 1004).

<sup>2</sup> U.S. Patent No. 6,223,190 B1 (issued Apr. 24, 2001) (Ex. 1005).

<sup>3</sup> U.S. Patent No. 6,018,774 (issued Jan. 25, 2000) (Ex. 1006).

<sup>4</sup> U.S. Patent No. 6,035,323 (issued Mar. 7, 2000) (Ex. 1007).

<sup>5</sup> U.S. Patent No. 6,038,295 (issued Mar. 14, 2000).

37 C.F.R. § 42.122(a). Here, the '482 patent is at issue in both this *inter partes* review proceeding and the Reexamination pending before the Board. Accordingly, the conditions of 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a) are met, and we must determine whether to exercise our discretion to stay the Reexamination.

We agree with Patent Owner that the circumstances of this proceeding and the Reexamination warrant a stay. First, the claims of the '482 patent at issue in this proceeding and the Reexamination are overlapping. All six claims at issue in the Reexamination, claims 38, 40, 44–46, and 49, also are the subject of this proceeding. *See* Inst. Dec. 33; Ex. 2040, 3–4.

Second, this proceeding and the Reexamination involve overlapping asserted prior art and issues. In each proceeding, Creamer is asserted as a prior art reference that allegedly renders unpatentable claims 38, 40, 44–46, and 49 of the '482 patent—this proceeding includes a ground challenging these claims as obvious over Creamer and Aihara, Inst. Dec. 33, while in the Reexamination, these claims stand rejected as anticipated by Creamer and claim 46 also is rejected as obvious over Creamer and Mattes, Ex. 2040, 3–4. Petitioner attempts to downplay the impact of this overlap, arguing that Creamer is the only common prior art reference and it is “used differently in the two proceedings— in an anticipation rejection in the [R]eexam[ination] and in an obviousness [ground]” in this proceeding. *Opp.* 4–5. This argument overlooks that the Reexamination involves an obviousness rejection of claim 46 based on Creamer. *See* Ex. 2041, 2. More importantly, Creamer plays a key role in both proceedings and its inclusion in each proceeding results in a significant overlap in the issues to be resolved. In the Reexamination, the Board must address whether Creamer discloses each

limitation of claims 38, 40, 44–46, and 49 of the '482 patent, as well as whether Creamer teaches or suggests the limitations of claim 46. In this proceeding, we must address whether Creamer teaches or suggests the same limitations. The similarity in the issues to be resolved leads to similar disputed issues in each proceeding. For example, in this proceeding, Patent Owner disputes Petitioner's assertion that Creamer teaches or suggests "pre-processing parameters controlling said client device in a placement of said digital content into a specified form in preparation for publication," as recited in claim 38 of the '482 patent. *See* Inst. Dec. 16–18, Prelim. Resp. 31–35. In the appeal of the Reexamination, Patent Owner contests the Examiner's construction of this limitation and argues that Creamer does not disclose the limitation under the proper construction. Ex. 2041, 3–17.

Given the significant overlap in the Reexamination and this proceeding, allowing the Reexamination to proceed concurrently would result in duplicative efforts within the Office, particularly within the Board, and would be an inefficient use of Office and Board resources. In addition, allowing these overlapping proceedings to proceed simultaneously could result in inconsistencies between the proceedings.

Petitioner's arguments opposing a stay of the Reexamination are not persuasive. Petitioner argues that a decision by the Board in the Reexamination likely would issue before any final decision in this proceeding, and that if the Board affirms the rejections in the Reexamination and Patent Owner does not appeal to the Federal Circuit, the issues in this proceeding may be "substantially simplif[ied]," thereby "conserv[ing] resources of both the Board and the parties." Opp. 1, 3–4, 6. In addition, Petitioner asserts that a stay of the Reexamination would "prejudic[e]"

Petitioner by “forc[ing Petitioner] to expend time and resources to continue challenging claims” that could be decided in the Reexamination. *Id.* at 8.

Petitioner’s arguments are based on speculation regarding a potential minor reduction in the issues to be addressed and decided in this proceeding if a specific hypothetical factual scenario plays out in the Reexamination, i.e., the Board affirms the rejection of claims 38, 40, 44–46, and 49, the Board’s decision issues before any final decision in this proceeding, and Patent Owner does not appeal the Board’s decision. Even in this narrow hypothetical scenario, no Board resources would be conserved, despite Petitioner’s suggestion to the contrary. The Board would have addressed in the Reexamination the patentability of claims 38, 40, 44–46, and 49 of the ’482 patent, including whether these claims are anticipated by Creamer and whether claim 46 would have been obvious over Creamer and Mattes. Then, in this proceeding, the Board still would have to address whether Creamer and Aihara, in addition to Mayle and Narayen, render obvious the other fifteen claims at issue in this case.

Moreover, we are not persuaded that a stay of the Reexamination would prejudice Petitioner. With a stay, Petitioner must address the ’482 patent claims that it chose to, and continues to choose to, challenge in this proceeding. Petitioner has no role or involvement in the Reexamination. To the extent that a stay of the Reexamination eliminates the possibility that a subset of the claims challenged in this proceeding could be resolved in the Reexamination, this impact on Petitioner does not outweigh the compelling factors weighing in favor of a stay—preventing proceedings involving the same patent as well as overlapping claims and prior art from being considered simultaneously by the Board.

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