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Paper 24
Date: June 6, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NISSAN NORTH AMERICA, INC.,
Petitioner,

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC,
Patent Owner.

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC,
Patent Owner.

Case IPR2015-01508 Case IPR2015-01610[1]
Patent 6,542,076 B1

Before HOWARD B. BLANKENSHIP, STACEY G. WHITE, JASON J. CHUNG and BETH Z. SHAW, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge.*

ORDER
Staying Ex Parte Reexamination No. 90/013,302
35 U.S.C. § 315(d) and 37 C.F.R. §§ 42.3, 42.122(a)

[1] This Decision addresses the same issues in the above-identified cases. Therefore, we exercise our discretion to issue one Decision to be entered in each of the identified cases. The parties are not authorized to use this style of case caption.

On January 28, 2016, *inter partes* review of U.S. Patent No. 6,542,076 B1 ("the '076 patent") was instituted as to claims 3, 20, 65, 73, 93, 103, 104, 108 and 205. IPR2015-01508, Paper 10. On February 1, 2016, a second *inter partes* review was instituted as to claims 3, 18, 65, 67, 68, 70, 73, 91, 103, 116, 119, 120, and 205 of the '076 patent. IPR2015-01610, Paper 7. Claim 3, which is at issue in both IPRs, is the subject of *Ex Parte* Reexamination No. 90/013,302 ("302 Reexam"). Currently in the reexamination, claim 3 stands rejected as anticipated by Ramono (U.S. Patent No. 5,070,320), or, alternatively, anticipated by Ryoichi (U.S. Patent No. 5,113,427). 302 Reexam May 22, 2015 Final Rejection 15–23 ("Final Rejection").[2] In addition, currently in the reexamination claim 3 stands rejected as anticipated by Pagliaroli (U.S. Patent No. 5,276,728). Final Rejection 24–28. Ryoichi and Pagliaroli also are asserted to be anticipatory prior art to claim 3 in IPR2015-01610 and IPR2015-01508 respectively. In addition, there is a claim construction argument advanced in the reexamination in regards to the term "control device" that is substantially similar to an argument advanced in the IPRs. *See* IPR2015-01610, Paper 7 at 6–9, 19–22; IPR2015-01508, Paper 10 at 5–11; 302 Br. 6–11, 18–32, 34–35. Thus, due to the substantial overlap between the IPRs and the Reexamination we *sua sponte* stay the 302 Reexam under 35 U.S.C. § 315(d) and pursuant to 37 C.F.R. §§ 42.3(a), 42.122(a).

Section 315(d) provides for the "stay, transfer, consolidation, or termination" of another matter or proceeding before the Office involving the same patent. 35 U.S.C. § 315(d); *see* 37 C.F.R. § 42.122(a). Our Rules specify that the Board may exercise exclusive jurisdiction over a patent involved in a proceeding

[2] This Final Rejection has been appealed to this Board. An appeal brief was filed November 21, 2015 ("302 Br."), and the Examiner's Answer was filed January 20, 2016.

before the Board. 37 C.F.R. §§ 42.3(a). Thus, the Board the board is authorized to stay a matter, such as the instant Reexamination, if that matter involves the same patent. Here, claim 3 of the '076 patent is challenged in two IPRs and a reexamination proceeding and these challenged overlap as to the claim construction arguments advanced and the prior art asserted. Thus, claim 3 of the '076 patent is subject to a patentability determination in multiple proceedings before the Office. That scenario merits staying the 302 Reexam. Indeed, such a stay is practical as it would conserve Office resources by reducing the possibility of duplicative, or unnecessary, efforts. That action also would lessen the potential for inconsistent results.

ORDER

Accordingly, it is

ORDERED that pursuant to our authority arising under 35 U.S.C. § 315(d), and 37 C.F.R. §§ 42.3(a), 42.122(a), Reexamination 90/013,302, is hereby stayed pending the termination or completion of these *inter partes* review proceedings;

FURTHER ORDERED that this stay tolls all time periods for filing further papers in Reexamination 90/013,302, and no further papers shall be filed in that proceeding while this stay remains in place; and

FURTHER ORDERED that all time periods in Reexamination 90/013,302 will be restarted upon lifting of the stay.

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