

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.

COXCOM, LLC,
Petitioner,

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC,
Patent Owner.

Case IPR2015-01509 Case IPR2015-01611 Case IPR2015-01760¹
Patent 6,549,130 B1

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.

Case IPR2015-01509 Case IPR2015-01611 Case IPR2015-01760
Patent 6,549,130 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. 90/013,301
35 U.S.C. § 315(d) and 37 C.F.R. §§ 42.3, 42.122(a)

On January 6, 2016, *inter partes* review of U.S. Patent No. 6,549,130 B1 (“the ‘130 patent”) was instituted as to claims 26, 29, 30, 33, 42, 43, 48, 60, and 68. IPR2015-01509, Paper 10. On January 28, 2016, a second *inter partes* review was instituted as to claims 26, 31, 38, 42, 43, 48, 60, 63, 64, 73, 74, 85, 91, 92, 138, 139, and 143 of the ‘130 patent. IPR2015-01611, Paper 7. On February 17, 2016, a third *inter partes* review was instituted as to claims 1, 8, 10, 12, 17, 98, 119, 124, 145, and 149 of the ‘130 patent. IPR2015-01760, Paper 8. Claim 48, which is at issue in two of the three IPRs, is the subject of *Ex Parte* Reexamination No. 90/013,301 (“301 Reexam”). Currently in the reexamination, claim 48 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). 301 Reexam May 22, 2015 Final Rejection 4–12 (“Final Rejection”).² In addition, currently in the reexamination, claim 48 stands rejected as anticipated by Pagliaroli (U.S. Patent No. 5,276,728). Final Rejection 12–17. Pagliaroli also is asserted to be anticipatory prior art to claim 48 in IPR2015-01509. 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 two of the IPRs. *See* IPR2015-01509, Paper 10 at 8–10; IPR2015-01611, Paper 7 at 5–7; 301 Br. 18–29, 31–33. Thus, due to the substantial overlap between the IPRs and the Reexamination we *sua sponte* stay the 301 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

² This Final Rejection has been appealed to this Board. An appeal brief was filed November 21, 2015 (“301 Br.”), and the Examiner’s Answer was filed January 20, 2016.

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 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, the '130 patent is challenged in three IPRs and claim 48 of the '130 patent is challenged in two of those IPRs. Further, one of those IPRs is challenging claim 48 based on the same art at issue in the 301 Reexam. Thus, there is significant overlap between the IPRs and the 301 Reexam and therefore, claim 48 of the '130 patent is subject to a patentability determination in multiple proceedings before the Office. That scenario merits staying the 301 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 90/013,301, 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 90/013,301, 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 90/013,301 will be restarted upon lifting of the stay.

Case IPR2015-01509 Case IPR2015-01611 Case IPR2015-01760
Patent 6,549,130 B1

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