

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 IPR2015-01585 Case IPR2015-01613¹
Patent 5,917,405

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. 90/013,300
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 29, 2016, *inter partes* review of U.S. Patent No. 5,917,405 (“the ‘405 patent”) was instituted as to claims 1, 2, 3, 11, 16, and 17. IPR2015-01585, Paper 11. On February 1, 2016, a second *inter partes* review was instituted as to claims 1, 2, 3, 7, 8, 11, 12, 14, 16, 17, 19, and 20 of the ‘405 patent. IPR2015-01613, Paper 7. Claim 1, which is at issue in both IPRs, is the subject of *Ex Parte* Reexamination No. 90/013,300 (“300 Reexam”). Currently in the reexamination, claim 1 stands rejected as anticipated by Ramono (U.S. Patent No. 5,070,320), Kniffin (U.S. Patent No. 6,072,402), Ryoichi (U.S. Patent No. 5,113,427), and Pagliaroli (U.S. Patent No. 5,276,728). 300 Reexam May 22, 2015 Final Rejection 4–16.² Pagliaroli also is asserted to be anticipatory prior art to claim 1 in IPR2015-01585. Kniffin and Ryoichi are asserted to anticipate claim 1 in IPR2015-01613. In addition, there is a claim construction argument advanced in the reexamination in regards to the “control device” terms that is substantially similar to an argument advanced in the IPRs. *See* IPR2015-01585, Paper 11 at 9–13; IPR2015-01613, Paper 7 at 4–8; 300 Br. 5–28. Thus, due to the substantial overlap between the IPRs and the Reexamination we *sua sponte* stay the 300 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 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

² This Final Rejection has been appealed to this Board. An appeal brief was filed November 21, 2015 (“300 Br.”), and the Examiner’s Answer was filed January 20, 2016.

patent. Here, claim 1 of the '405 patent is challenged in two IPRs. Further those IPRs include challenges to claim 1 based on the same art at issue in the 300 Reexam and similar claim construction arguments. Thus, there is significant overlap between the IPRs and the 300 Reexam and therefore, claim 1 of the '405 patent is subject to a patentability determination in multiple proceedings before the Office. That scenario merits staying the 300 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 90/013,300, 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 90/013,300, 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 90/013,300 will be restarted upon lifting of the stay.

Case IPR2015-01585 Case IPR2015-01613
Patent 5,917,405

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