

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETNUT LTD,
Petitioner,

v.

BRIGHT DATA LTD.,
Patent Owner.

IPR2021-01492
Patent 10,257,319 B2

Before THOMAS L. GIANNETTI, SHEILA F. McSHANE, and
RUSSELL E. CASS, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER
Staying Concurrent *Ex Parte* Reexamination
37 C.F.R. § 42.122(a)

I. INTRODUCTION

On September 3, 2021, NetNut Ltd. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1, 2, 12, 14, 15, 17–19, and 21–29 (the “challenged claims”) of U.S. Patent No. 10,257,319

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B2 (Ex. 1001, “the ’319 patent”). On March 21, 2022, we instituted *inter partes* review as to all challenged claims of the ’319 patent. *See* Paper 12.

On November 12, 2021, a request to reexamine the challenged claims (with the exception of claim 23) was granted in Reexamination Control No. 90/014,875 (“the ’875 Reexamination Proceeding”), based on the same references that are before us in this *inter partes* review. *See* Ex. 3001.

The Board has authority to stay a reexamination involving a patent challenged in an *inter partes* review. 37 C.F.R. § 42.122(a) (2019); *see also* 35 U.S.C. § 315(d) (2012). For the reasons discussed below, we determine that there is good cause to stay the ’875 Reexamination Proceeding.

II. FACTUAL AND PROCEDURAL BACKGROUND

On November 12, 2021, in Reexamination Control No. 90/014,875, a request for *ex parte* reexamination was granted as to claims 1, 2, 12, 14, 15, 17–19, 21, 22, and 24–29 of the ’319 patent. Ex. 3001. The request for reexamination and the examiner’s determination of a substantial new question of patentability were based on the same Crowds, RFC 2616, Border, and MorphMix references cited the Petition. *See* Pet. 10; Ex. 3001.

On March 21, 2022, we instituted *inter partes* review as to all the challenged claims of the ’319 patent. Paper 12, 39. We instituted trial on all grounds of the Petition, which are based on Crowds, RFC 2616, Border, and MorphMix. *Id.* at 8.

On March 23, 2022, by email, the Board requested the parties to advise the Board if they would agree to stay the ’875 Reexamination Proceeding in light of the institution of this *inter partes* review. Ex. 3002. The parties responded that Patent Owner would agree to the stay, and that Petitioner “does not oppose or join.” Ex. 3003.

On March 25, 2022, the CRU (Central Reexamination Unit) issued an Office Action rejecting claims 1, 2, 12, 14, 15, 17–19, 21, 22, and 24–29 based on Crowds, RFC 2616, Border, and MorphMix. Ex. 3004.

III. ANALYSIS

Office guidance outlines factors the Board considers in AIA trials in deciding whether to stay a parallel reexamination involving the same patent. *See Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*, 84 Fed. Reg. 16,654, 16,657 (Apr. 22, 2019) (“Notice Regarding Amendment Options”). We discuss each of those factors below.

A. Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding

All claims challenged in this proceeding, with the exception of claim 23, are subject to reexamination in the ’875 Reexamination Proceeding. Ex. 3001. This factor favors a stay.

B. Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings

The same references are before us in this *inter partes* review as are being considered by the CRU in the ’875 Reexamination Proceeding. This factor favors a stay.

C. Whether the concurrent parallel Office proceeding will duplicate efforts within the Office

Because nearly all same claims and all the prior art we are considering in this proceeding are also at issue in the ’875 Reexamination Proceeding, allowing both to proceed concurrently would duplicate efforts. This factor favors a stay.

D. Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding)

With the exception of claim 23, the '875 Reexamination Proceeding is considering the same claims and all the same prior art as we are considering in this trial, which raises the possibility of inconsistent results. This factor favors a stay.

E. Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding

The claims in the '875 Reexamination Proceeding that are before us in this trial have been rejected, and Patent Owner may respond with an amendment that would affect their scope. Ex. 3004. This factor favors a stay.

F. The respective timeline and stage of each proceeding

In the '875 Reexamination Proceeding, the Examiner has granted the request for reexamination and issued an office action. Ex. 3001, 3004. In this proceeding, we recently entered a decision granting institution. Paper 12. Thus, in both proceedings, the Office has invested some resources, but a significant amount of work remains in each. This factor is neutral.

G. The statutory deadlines of the respective proceedings

This proceeding is subject to a statutory deadline that requires a final decision within one year of institution, absent a rare extension. 35 U.S.C. § 316(a)(11) (2012). The '875 Reexamination Proceeding is required to be “conducted with special dispatch,” but is not subject to a specific deadline. 35 U.S.C. § 305 (2012). This factor favors a stay.

H. Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot

A determination in this proceeding regarding the patentability of the challenged claims in view of the cited references would simplify the issues in the '875 Reexamination Proceeding, which is also considering those claims and the same prior art. *Accord Avaya Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00071, Paper 8, 2 (PTAB Dec. 21, 2012). Conversely, the '875 Reexamination Proceeding could simplify or render moot this proceeding if a reexamination certificate with amendments to the claims challenged here were to issue before a final decision in this proceeding. *See M&P Golf, LLC v. Max Out Golf, LLC*, IPR2016-00784, Paper 43 (PTAB Aug. 30, 2017) (entering judgment against Patent Owner as to original claims when Patent Owner amended each of those claims in a reexamination, and the reexamination certificate had issued). However, considering the current stages of the proceedings and the ordinary timeline for reexaminations, that eventuality is unlikely. This factor favors a stay.

IV. CONCLUSION

The facts here present good cause for entering a stay. The pertinent factors overwhelmingly weigh in favor of staying the '875 Reexamination Proceeding. *See Notice Regarding Amendment Options*, 84 Fed. Reg. at 16,656 (“Good cause for staying a case may exist if, for example, an ongoing AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in a parallel Office proceeding.”).

We also note that although neither party has filed a motion for a stay, neither party opposes a stay. *See Ex. 3003*. Moreover, the Board “may impose a stay *sua sponte*.” *Notice Regarding Amendment Options*, 84 Fed.

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