

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NISSAN NORTH AMERICA, INC.
Petitioner,

v.

NORMAN IP HOLDINGS, LLC,
Patent Owner.

Case IPR2014-00563
Patent 5,502,689

Before BRYAN F. MOORE, HYUN J. JUNG, and FRANCES L. IPPOLITO,
Administrative Patent Judges.

MOORE, *Administrative Patent Judge.*

ORDER
Denying Authorization for Motion to Stay
37 C.F.R. § 42.5

A conference call was held on September 11, 2014 and attended by the above-identified panel members and respective counsel for the parties. Patent Owner requested the conference call to discuss “scheduling.” On the call, Patent Owner sought to stay ex parte reexamination control no. 90/012,784, which involves the same patent at issue in this proceeding. We note that requests for relief by the Patent Trial and Appeal Board (“Board”) should be filed as motions. 37 C.F.R. § 42.20(a). Additionally, such motions generally require authorization by the Board before filing. 37 C.F.R. § 42.20(b). We will treat Patent Owner’s request as a request for authorization to file a motion to stay the reexamination.

On the call, Petitioner stated that the first it heard of this request to stay was on the call. Given the vague reference to “scheduling” in the email requesting a phone conference, we remind the parties that emails requesting phone conferences should describe the reason for the call in sufficient detail for the Panel and the opposing party to understand the issue to be raised on the call without arguing the issue in the email. In that way, the parties and the Panel can be adequately prepared for the call. Additionally, the parties should confer regarding any issue a party wishes to bring before the Panel prior to requesting a phone conference.

35 U.S.C. § 315(d), as amended by the America Invents Act, provides:

Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

See also 37 C.F.R. § 42.122(a). The Board will not ordinarily stay a reexamination because, in the absence of good cause, reexaminations are conducted with special dispatch. *See* 35 U.S.C § 305. The Board has considered the brief statements

made by the parties during the conference call and has reviewed the reexamination proceeding. We note that the reexamination is on appeal with the Board. Given the preliminary stage of the instant proceeding, in which the Board has not yet decided whether to institute an *inter partes* review, and the advanced stage of the reexamination, we deny Patent Owner's request for authorization to file a motion to stay the ex parte reexamination. Patent Owner may renew its request if an *inter partes* review is instituted in this proceeding.

Patent Owner also asked for clarification of an apparent typographical error in the Order Granting Motion to Withdraw counsel, entered on August 28, 2014, which referred to Patent Owner instead of Petitioner. We acknowledged the error and the Order will not be changed because, given the comments on the call, the parties are aware of how to proceed. Petitioner's counsel noted that he was unable to file papers as lead counsel in the "PRPS" system. We indicated that he should send an email to the Board Staff describing the problem.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request to file a motion to stay ex parte reexamination control no. 90/012,784 is denied.

IPR2014-00563
Patent 5,502,689

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