

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY,
Petitioner,

v.

SIGNAL IP, INC.,
Patent Owner.

Cases IPR2015-00860 and IPR2015-00861¹
Patent 6,775,601 B2

Before JOSIAH C. COCKS, MITCHELL G. WEATHERLY, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

ORDER

Staying *Ex Parte* Re-examination Control No. 90/013,385
37 C.F.R. § 42.122(a)

¹ This Order addresses matters pertaining to each of the identified processing. We, therefore, exercise our discretion to issue one Order to be filed in each of IPR2015-00860 and IPR2015-00861. The parties are not authorized to use this style heading for any subsequent papers.

1. Introduction

On September 21, 2015, a conference call was held with counsel for the respective parties and Judges Cocks, Weatherly, and Boudreau. Petitioner, Ford Motor Company (“Ford”), was represented by Frank Angileri. Patent Owner, Signal IP, Inc. (“Signal IP”), was represented by Tarek Fahmi. Ford had requested the call to discuss the possibility of staying *ex parte* re-examination control no. 90/013,385 (“the ’385 reexamination”), which also involves U.S. Patent 6,775,601, pending the panel’s consideration of Ford’s prior request for authorization to move to consolidate the ’385 reexamination with one of IPR2015-00860 or IPR2015-00861.²

2. Discussion

During the call Ford requested that the ’385 reexamination be stayed so as to provide the panel appropriate time to consider whether to consolidate the ’385 reexamination with either of IPR2015-00860 and IPR2015-00861. Signal IP indicated that it objected to a stay of the ’385 reexamination as the proceeding is at a final stage, and the Examiner in charge of the reexamination proceeding likely soon will issue a Reexamination Certificate. Signal IP urged that staying the reexamination may interfere with the issuance of the Certificate.

The Director has authority to stay a reexamination proceeding pursuant to 35 U.S.C. § 315(d), which states:

(d) MULTIPLE PROCEEDINGS.—Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter

² We have authorized Ford to file a motion in each of IPR2015-00860 and IPR2015-00861 seeking to consolidate those proceedings with the ’385 reexamination. Paper 10. The motions are due by October 1, 2015. We also have authorized Signal IP to file oppositions to the motions, which are due no later than 14 days after Ford files its motions. *Id.*

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.

35 U.S.C. § 315(d). Rule 42.122(a) empowers the Board to enter an order to effect such a stay as follows:

(a) *Multiple Proceedings*. Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.

37 C.F.R. § 42.122(a); *see also* 37 C.F.R. § 42.3(a) (permitting the Board to exercise exclusive jurisdiction within the Office over an involved patent during the proceeding).

Accordingly, we may stay the '385 reexamination proceeding, which also involves the '601 patent underlying each of IPR2015-00860 and IPR2015-00861. We are mindful that the '385 reexamination is in its final stages; however, that circumstance weighs in favor of our staying the reexamination proceeding, rather than as a factor cutting against such action. Indeed, our consideration of whether to consolidate the '385 reexamination with one of the involved *inter partes* review proceedings may be rendered moot should a Reexamination Certificate issue in the '385 reexamination before we are in a position to consider the merits of such consolidation. In that regard, there potentially would be no reexamination proceeding available for consolidation with IPR2015-00860 or IPR2015-00861, even if we conclude that consolidation is, or would have been, an appropriate action.

Based on the circumstances present here, we think it prudent to stay temporarily the '385 reexamination, pending consideration of the parties'

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upcoming submissions of briefs in connection with the consolidation issue. To that end, we conclude that such a stay provides the panel ample opportunity to consider appropriately the question of whether to consolidate the '385 reexamination with one of the instant *inter partes* review proceedings. This stay tolls all time periods for filing further papers in reexamination control no. 90/013,385 including the filing of a notice of appeal, and no further papers shall be filed in reexamination control no. 90/013,385 while this stay remains in place. All time periods in reexamination control no. 90/013,385 will be restarted upon lifting of the stay.

3. Order

Accordingly, it is

ORDERED that *ex parte* reexamination control no. 90/013,385 is stayed pending the resolution of the panel's consideration whether to consolidate that reexamination proceeding with IPR2015-00860 or IPR2015-00861; and

FURTHER ORDERED that the panel will readdress the stay of reexamination control no. 90/013,385 upon resolution of the consolidation question.

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