

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FCA US LLC,
Petitioner,

v.

JACOBS VEHICLE SYSTEMS, INC.,
Patent Owner.

Case IPR2015-01230
Patent No. 6,474,277 B1

Before MEREDITH C. PETRAVICK, BENJAMIN D. M. WOOD, and
RICHARD E. RICE, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

ORDER
Dismissing the Petition
37 C.F.R. §§ 42.5(a), 42.72

INTRODUCTION

On June 25, 2015, Petitioner filed a Motion to Terminate the Petition for *Inter Partes* Review of U.S. Patent No. 6,474,277 B1 without Prejudice. Paper 7 (“Mot.”). Patent Owner filed an Opposition to Petitioner’s Motion on July 2, 2015. Paper 9 (“Opp.”). The Board authorized the filing of the Motion and Opposition in an Order mailed June 19, 2015. Paper 6.

Petitioner filed the Petition in this proceeding on May 20, 2015. Paper 1 (“the first Petition”). The first Petition challenges claim 36 of U.S. Patent No. 6,474,277 B1 (Ex. 1001, “the ’277 patent”) as being anticipated by European Patent Application No. 0317364 A1 (Ex. 1003). Paper 1, 7–8. On June 10, 2015, Petitioner filed another Petition challenging claim 36 of the ’277 patent as being anticipated by the same prior art. IPR2015-01370, Paper 2 (“the second Petition”). Neither the first Petition nor the second Petition is time barred pursuant to 35 U.S.C. § 315(a)(1).

According to Petitioner, the second Petition explicitly addresses a claim limitation that was only implicitly addressed in the first Petition because of an inadvertent clerical error in preparing the claim chart. Mot. 1–2. Petitioner contends that all of the features of the missing limitation and supporting citations to the prior art were included in the first Petition’s discussion of other claim limitations. *Id.* at 2.

Petitioner requests termination of this proceeding under 35 U.S.C. § 315(d). *Id.* at 4. According to Petitioner, termination is appropriate because it would remove a “redundant” Petition and correct the alleged clerical error in an efficient manner with little burden on the Board or Patent Owner. *Id.* at 3–4. Petitioner argues that terminating this proceeding would not prejudice the Patent Owner because Petitioner’s request was made very early in the proceeding. *Id.* at 4.

Patent Owner opposes Petitioner’s Motion because “allowing the Petitioner to substitute revised arguments in a subsequent and substantially identical petition is prejudicial to the proper administration of proceedings before this Board and to the Patent Owner.” Opp. 1. According to Patent Owner, 35 U.S.C. § 315(d) requires that the second Petition, and not the first

Petition, be dismissed. *Id.* at 1–2. Patent Owner also argues, in seeming contradiction to its first argument that the petitions are “substantially identical,” that making an argument explicit instead of implicit is a substantive error, not a clerical error, and that Petitioner is attempting to better its arguments in the Petition. *Id.* at 2–3. Patent Owner further argues that it is prejudiced by Petitioner’s failure to follow our Rules and by having to defend against multiple “repetitive” petitions. Opp. 4–5.

DISCUSSION

35 U.S.C. § 315(d) states: “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.” 37 C.F.R. § 42.71(a) states that “[t]he Board may take up petitions . . . in any order, [and] may . . . dismiss any petition.” See 37 C.F.R. § 42.5(a), 37 C.F.R. § 42.72.

Upon consideration of Petitioner’s Motion and Patent Owner’s Opposition, Petitioner’s Motion is granted. This proceeding is in an early stage. Patent Owner has not filed a preliminary response, and we have not considered the merits of the Petition. The proceeding in IPR2015-01370 is also in an early stage, Patent Owner has yet to file a preliminary response, and we have not considered the merits of the second Petition.

The first and second Petitions challenge the same claim based on the same prior art and are substantially the same. Terminating this proceeding at

this stage increases the efficiency of the Board and the parties, because the Board and the parties no longer have to proceed with proceedings that are “repetitive” (Opp. 3–4) or “redundant” (Mot. 3–4).

Accordingly, it is:

ORDERED that Petitioner’s Motion to Terminate is *granted*; and

FURTHER ORDERED that the Petition in this proceeding is *dismissed*.

IPR2015-01230
Patent 6,474,277 B1

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