

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC AND ROBERT BOSCH LLC,
Petitioner,

v.

FORAS TECHNOLOGIES LTD.,
Patent Owner.

IPR2023-01373
Patent 7,502,958 B2

Before CARL W. WHITEHEAD JR., THOMAS L. GIANNETTI and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

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

I. INTRODUCTION

On September 8, 2023, BMW of North America, LLC and Robert Bosch LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–8 and 13–22 (“the challenged claims”) of U.S. Patent 7,502,958 B2, issued on March 10, 2009 (Ex. 1001, “the ’958 patent”). On March 20, 2024, we instituted *inter partes* review as to all challenged claims of the ’958 patent. *See* Paper 11.

On November 29, 2023, a request to reexamine claims 1–25 of the ’958 patent was granted in Reexamination Control No. 90/019,245 (“the ’245 Reexamination Proceeding”), based upon at least one of the references that are before us in this *inter partes* review. *See* Exs. 3001, 3002.

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 ’245 Reexamination Proceeding.

II. FACTURAL AND PROCEDUAL BACKGROUND

On November 29, 2023, in the ’245 Reexamination Proceeding, the Examiner granted a request for *ex parte* reexamination as to claims 1–25 of the ’958 patent. Ex. 3002. The request for reexamination and the Examiner’s determination of a substantial new question of patentability were based partially upon the Bigbee reference¹ relied upon in the Petition. *See* Pet. 1; Ex. 3002 at 10–13.

¹ Bigbee et al., US 2003/0126498 A1, published July 3, 2003.

In the '245 Reexamination Proceeding, on March 19, 2024, the Examiner issued an Office Action rejecting claims 1–25 of the '958 patent. Ex. 3003 at 4–55. The Examiner based several rejections on Bigbee alone, and on Bigbee in combination with other references. The Examiner rejected claims 1, 4–8 and 19–22 as anticipated by Bigbee. *See* Ex. 3003 at 4–13. The Examiner rejected claims 2, 3 and 13–18 as unpatentable over Bigbee and Safford.² *See* Ex. 3003 at 13–24. The Examiner also rejected claims 1–8 and 19–22 as unpatentable over Safford and Bigbee. *See* Ex. 3003 at 24–42. The Examiner rejected claims 9–12 as unpatentable over Safford, Cepulis and Bigbee. Ex. 3003 at 43–45.

In addition to the rejections based on Bigbee, the Examiner rejected claims 13–18 as unpatentable over Safford and Marisetty.³ *See* Ex. 3003 at 45–50. The Examiner rejected claims 23–25 as unpatentable over Safford, Cepulis and Marisetty. *See* Ex. 3003 at 51–55.

As noted, on March 20, 2024, we instituted *inter partes* review as to all the challenged claims of the '958 patent. Paper 11. We instituted trial on all grounds of the Petition, based on Bigbee and Nguyen.⁴ Paper 11.

On April 30, 2024, the Board scheduled a conference call with the parties. The stated purpose of the call was “to discuss whether to stay the pending *ex parte* reexamination.” Ex. 3004.

On May 3, 2024, prior to the scheduled conference date, the parties responded by email, stating that “the parties have conferred and do not oppose a stay of the *ex parte* reexamination of the '958 patent

² Safford, US 7,085,959 B2, issued August 1, 2006.

³ Marisetty et al., US 2003/0051190 A1, published March 13, 2003.

⁴ Nguyen et al., US 2004/0123201 A1, published June 24, 2004.

(Reexamination No. 90/019,245) pending resolution of this IPR proceeding.” Ex. 3004. Accordingly, the scheduled conference was cancelled.

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 (1–8 and 13–22) challenged in this proceeding are subject to reexamination in the ’245 Reexamination Proceeding. Ex. 3003. This factor favors a stay.

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

At least one of the references (Bigbee) before us in this *inter partes* review is also being considered by the CRU in the ’245 Reexamination Proceeding. Further, the Safford and Marisetty references, which are being considered by the Examiner in the ’245 Reexamination Proceeding, are relied upon by Petitioner in this *inter partes* review to show the state of the art. Pet. 2–12. This factor favors a stay.

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

Nearly all the same claims and all the prior art we are considering in this proceeding are also at issue in the '245 Reexamination Proceeding, therefore 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)

The '245 Reexamination Proceeding is considering the same claims and at least one of the same prior art references 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 '245 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. 3003. This factor favors a stay.

F. The respective timeline and stage of each proceeding

In the '245 Reexamination Proceeding, the Examiner has granted the request for reexamination and issued an Office action. Exs. 3002, 3003. In this proceeding, we entered a decision granting institution. Paper 11. 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 '245 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 '245 Reexamination Proceeding, which is also considering those claims and some of the same prior art. *Accord Avaya Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00071, Paper 8, 2 (PTAB Dec. 21, 2012). Conversely, the '245 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 '245 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. 3004. Moreover, the Board “may impose a stay *sua sponte*.” Notice Regarding Amendment Options, 84 Fed. Reg. at 16,657. Under these circumstances, we see no need for a motion or further briefing.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Reexamination Control No. 90/019,245 is stayed, pending the termination or completion of IPR2023-01373;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/019,245 are tolled for the duration of the stay, and no further papers shall be filed in the reexamination while this stay remains in place; and

FURTHER ORDERED that the Examiner will enter a paper restarting any time periods for filing further papers in Reexamination Control No. 90/019,245 when the stay is lifted.

IPR2023-01373
Patent 7,502,958 B2

For PETITIONER:

Lionel Lavenue
Kara Specht
Cory Bell
Matthew Berntsen
Misook Kim
Xirui Zhang
FINNEGAN, HENDERSON, FARABOW, GARRETT,
& DUNNER, LLP
lionel.lavenue@finnegan.com
kara.specht@finnegan.com
cory.bell@finnegan.com
matthew.berntsen@finnegan.com
misook.kim@finnegan.com
xirui.zhang@finnegan.com

For PATENT OWNER

Brett Cooper
BC LAW GROUP, P.C.
bcooper@bc-lawgroup.com

Robert Auchter
AUCHTER PLLC
robert@auchterlaw.com