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Paper 17
Date: September 3, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

GRAPHITE CHARGING COMPANY LLC,
Patent Owner.

IPR2024-00388
Patent 8,291,243 B2

Before KEN B. BARRETT, MATTHEW S. MEYERS, and JOHN R. KENNY, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On July 19, 2024, Petitioner sent an email to the Board requesting authorization for leave to file a motion to stay Reexamination Control No. 90/019,303 during pendency of the above-captioned case. Ex. 3001. That reexamination involves the same patent challenged here. We denied the request without prejudice, indicating that the request was premature because the Board had not yet made a determination whether to institute an *inter partes* review. *Id.* We subsequently instituted a review of the challenged patent and, on August 27, 2024, Petitioner, via email, renewed its request for authorization to file a motion to stay the reexamination. Petitioner states that Patent Owner opposes.

We authorize Petitioner to file the requested motion and Patent Owner to file an opposition.

The Board may enter an order staying a reexamination proceeding during the pendency of an *inter partes* review. 37 C.F.R. § 42.122(a); *see also* 35 U.S.C. § 315(d); 37 C.F.R. § 42.3(a). "[T]he Board ordinarily will stay a [reexamination] where good cause exists." *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*, 84 Fed. Reg. 16654, 16,656 (Apr. 22, 2019). "Good cause for staying a case may exist if, for example, an on-going [IPR] proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in [the reexamination]." *Id.* Other factors the Board may consider when deciding whether to stay a reexamination, include:

- Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings;
- Whether the concurrent parallel Office proceeding will duplicate efforts within the Office;

- 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);
- Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding;
- The respective timeline and stage of each proceeding;
- The statutory deadlines of the respective proceedings;
- Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

Id. at 16,657.

The parties' briefs should address these factors.

It is:

ORDERED that Petitioner is authorized to file a motion to stay Reexamination Control No. 90/019,303;

FURTHER ORDERED that the motion shall not to exceed ten (10) pages and shall be filed within seven business days after the issuance of this order;

FURTHER ORDERED that Patent Owner may file an opposition, not to exceed ten (10) pages, within seven business days after the filing of the motion; and

FURTHER ORDERED that no further briefing is authorized at this time.

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