

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT PACKARD ENTERPRISE COMPANY and CISCO
SYSTEMS, INC.,
Petitioner,

v.

COBBLESTONE WIRELESS, LLC,
Patent Owner.

IPR2024-00707
Patent 7,924,802 B2

Before KARL D. EASTHOM, NORMAN H. BEAMER, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

ORDER
Granting Motion to Stay *Ex Parte* Reexamination of
U.S. Patent No. 7,924,802
35 U.S.C. § 42.5

I. INTRODUCTION

Hewlett Packard Enterprise Company and Cisco Systems, Inc. (“Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting an *inter partes* review of claims 1–9 (the “challenged claims”) of U.S. Patent No. 7,924,802 B2 (Ex. 1001, “the ’802 patent”). Cobblestone Wireless, LLC (“Patent Owner”) filed a Preliminary Response (Paper 7). With our permission, Petitioner filed a Preliminary Reply (Paper 11), and Patent Owner filed a Preliminary Sur-reply (Paper 12). On September 24, 2024, we instituted *inter partes* review as to all challenged claims of the ’802 patent. *See* Paper 17 (“Inst. Dec.”).

On March 26, 2024, one week after the Petition was filed, a third party (Unified Patents, LLC) filed a Request for *Ex Parte* reexamination of claims 1–15 and 17–23 of the ’802 patent. Ex. 2009 (“Reexamination Request”). On June 13, 2024, this request was granted in Reexamination Control No. 90/019,458 (“the ’458 Reexamination Proceeding”). Ex. 2010.

With our permission, Patent Owner filed an unopposed motion to stay the ’458 Reexamination Proceeding. Paper 22 (“Mot.”). Patent Owner represents that Petitioner does not oppose the Motion. *Id.* at 1. For the reasons discussed below, we find that it is appropriate to stay the ’458 Reexamination proceeding pending resolution of the present *inter partes* review proceeding.

II. ANALYSIS

The Board has the authority to enter an order staying a reexamination proceeding where there has been a showing of good cause. 37 C.F.R. § 42.122(a); *see also* 35 U.S.C. § 315(d); 37 C.F.R. § 42.3(a). Indeed, “the 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) (“Notice”). The Notice outlines factors the Board considers in AIA trials in deciding whether to stay a parallel reexamination involving the same patent. Notice, 16,657. We analyze each of those factors below.

A. Factor 1: Whether the claims challenged in the IPR are the same or depend directly or indirectly from claims at issue in the reexamination

We agree with Patent Owner that all of the claims of the ’802 patent challenged in the present IPR (claims 1–9) are also at issue in the parallel Reexamination Proceeding, which challenges claims 1–15 and 17–23 of the ’802 patent. Mot. 2, 6. As Patent Owner points out, the Board has previously determined that a stay is warranted where the reexamination proceeding involves claims challenged by the IPR but also includes additional claims not at issue in the IPR. Mot. 6–7; *Mueller Sys., LLC v. Rein Tech, Inc.*, IPR2020-00098, Paper 13, 4 (PTAB May 15, 2020) (Even where the reexamination challenges more claims than the IPR, “[g]iven the partial overlap between the challenged claims in this IPR proceeding and the claims at issue in the parallel reexamination proceeding, the first factor favors staying the reexamination proceeding.”); *Toshiba Memory Corp. v. Anza Tech., Inc.*, IPR2018-01597, Paper 38, 3 (PTAB July 10, 2019) (staying reexamination involving a single overlapping claim as well as additional, non-overlapping claims); *Pfizer Inc. v. Hoffman-La Roche Inc.*, IPR2018-01219, Paper 13, 2–3 (PTAB Dec. 18, 2018) (staying parallel reexamination where only a single claim overlapped with IPR); *Netnut Ltd v. Bright Data Ltd.*, IPR2021-01492, Paper 14, 3 (PTAB Apr. 7, 2022) (“All

claims challenged in this proceeding, with the exception of claim 23, are subject to reexamination in the '875 Reexamination Proceeding. . . . This factor favors a stay.”).

We agree with Patent Owner’s arguments, and find that factor 1 favors a stay.

B. Factor 2: Whether the same grounds of unpatentability or the same prior art are at issue in both the IPR and the reexamination.

Patent Owner argues that factor 2 favors a stay because both the IPR and the Reexamination Proceeding “involve Shearer references with substantially identical disclosures.” Mot. 7. Specifically, Patent Owner argues that the IPR Petition “argues that the Shearer Patent Application Publication alone renders claims 1–4 and 9 of the '802 patent obvious” while “[t]he Non-Final Office Action in the Reexamination Proceeding asserts that claims 1–4 are anticipated by the Shearer Patent and claims 5–9 are rendered obvious by the Shearer Patent in view of secondary references.” *Id.* (citing Ex. 2011, Non-Final Office Action at 4, 21, 30, 32). According to Patent Owner, “the Shearer Patent in the Reexamination Proceeding is the patent that issued from the same application that published as the Shearer Patent Application Publication at issue in the IPR,” and the two references have substantially identical disclosures. *Id.* at 7–8 (citing Ex. 2006; Ex. 2013).

Patent Owner also argues that “the Petition in the IPR and the Non-Final Office Action in the reexamination rely on almost identical disclosures from the two Shearer references.” Mot. 8. For example, Patent Owner argues that, for claim element 1[a] in the '802 patent, Petitioner relies on a graphic from the Shearer Patent Publication that “allegedly demonstrates a type of down-shifting,” while the Examiner in the Non-Final Office action

“pointed to the same type of alleged downshifting for the same claim element 1[a].” *Id.* at 8–9 (citing Ex. 1003 ¶ 421; Ex. 2001, Non-Final Office Action, 7. According to Patent Owner, this reasoning “relied on the Examiner in rejecting claim 1 in the Non-Final Office Action” is “materially similar to the reasoning stated by the Board in addressing this same disclosure in the IPR institution decision.” *Id.* at 9 (citing Inst. Dec. 43).

We agree with Patent Owner that the Petition in this IPR and the Examiner in the ’458 Reexamination Proceeding include similar reasoning and similar disclosures in the Shearer references with respect to claim element 1[a]. In light of these similarities, we find that factor 2 favors a stay.

C. Factor 3: Whether concurrent parallel Office proceeding will duplicate efforts within the Office.

Patent Owner argues that “[b]ecause this IPR and the reexamination include substantially identical art and overlapping claims, the risk of duplication of efforts is very high.” Mot. 10. We agree that there is a significant risk of duplication of Office proceedings, and find that factor 3 favors a stay.

D. Factor 4: Whether the reexamination could result in inconsistent results between proceedings.

Patent Owner argues that factor 4 favors a stay “because, due to the same claims being challenged in both proceedings based on substantially identical Shearer references, there is a potential for inconsistent results.” Mot. 11. For example, Patent Owner asserts, without a stay the Board and the Examiner in the Reexamination Proceeding could reach inconsistent results concerning the scope of the overlapping claims, the scope of the nearly-identical Shearer references, and the question of whether these

similar references disclose or render obvious the same claims of the '802 patent. *Id.* We agree, and find that factor 4 favors a stay.

E. Factor 5: Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding.

Patent Owner argues that factor 5 “favors a stay because granting a stay will alleviate the risk that amendments or new claims may be presented in the reexamination that will have an effect in the IPR.” Mot. 12. Patent Owner also argues that “[t]he Board has found that this factor favors a stay of a concurrent parallel reexamination when the patent owner can amend claims in the reexamination.” *Id.* (citing *BMW of N. Am., LLC v. Foras Techs. Ltd.*, IPR2023-01373, Paper 15, 5 (PTAB Jun. 21, 2024); *Celltrion, Inc. v. Regeneron Pharms., Inc.*, IPR2023-00462, Paper 17, 4 (PTAB, Sep. 8, 2023)). We agree, and find that factor 5 favors a stay.

F. Factors 6 and 7: The respective timelines, stages, and statutory deadlines of the respective proceedings.

Patent Owner argues that, “[a]lthough each proceeding is at a relatively early stage—the Board granted institution for IPR in September of this year and the Examiner issued a Non-Final Office Action in October—the Board is expected to reach a final decision for the IPR within a year of institution (*i.e.* by September 24, 2025).” Mot. 13. Patent Owner contrasts this with the Reexamination Proceeding, which has “no set deadline” for conclusion and “may have an indefinite number of office actions.” *Id.* Patent Owner argues that, “[w]here the Board has granted institution in the IPR and the Office has issued a first office action, the Board has found that factors 6 and 7 favor a stay.” *Id.* (citing *Hope Med. Enters., Inc. v. Oregon Health & Sci. Univ.*, IPR2022-00123, Paper 11, 7 (PTAB May 9, 2022)). We agree, and find that factors 6 and 7 favor a stay.

G. Factor 8: Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

Patent Owner argues that factor 8 favors a stay because “a decision in this IPR has the potential to simplify or moot the issues in the Reexamination.” Mot. 13–14. We agree that a determination in this IPR that one or more claims are unpatentable over the Shearer Patent Application Publication has the potential to simplify the issues in the Reexamination Proceeding concerning whether that claim or claims are unpatentable over comparable disclosures in the Shearer patent. Consequently, we find that factor 8 supports a stay.

III. CONCLUSION

After considering all the factors, for the foregoing reasons, we find that Patent Owner has shown good cause for staying the ’458 Reexamination Proceeding pending resolution of the ’707 IPR. *See* Notice 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.”).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s Unopposed Motion to Stay *Ex Parte* Reexamination Control Number 90/019,458 is granted;

FURTHER ORDERED that Reexamination Control No. 90/019,458 is stayed, pending the termination or completion of IPR2024-00707;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/019,458 are tolled for the duration of the

stay, and no further papers shall be filed in the reexamination while this stay remains in place, without authorization; and

FURTHER ORDERED that, when the stay is lifted, a paper will be sent resetting time periods for responding to any outstanding papers in Reexamination Control No. 90/019,458.

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