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Paper 13
Dated: November 5, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIKTOK INC.,
Petitioner,

v.

CELLSPINSOFT, INC.,
Patent Owner.

IPR2024-00759
Patent 8,862,757 B2

Before GREGG I. ANDERSON, CYNTHIA M. HARDMAN, and MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

ORDER
Sua Sponte Staying Concurrent *Ex Parte* Reexamination
35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a)

I. INTRODUCTION

On September 30, 2024, we instituted *inter partes* review in the above-referenced case, as to claims 1–26 of U.S. Patent 8,862,757 (the "'757 patent"). Paper 8; *see also* Paper 12 (denying rehearing request).

A third-party Requester filed a Request for *Ex Parte* Reexamination of claims 1–26 of the '757 patent, which was granted in Reexamination Control No. 90/019,488 (the "'488 Reexamination") on July 15, 2024. Ex. 3001.

The Board has authority to stay a reexamination involving a patent challenged in an *inter partes* review. *See* 35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a); *see also* 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") (noting that the Board "may impose a stay *sua sponte*"). For the reasons discussed below, we determine that there is good cause to stay the '488 Reexamination pending resolution of this *inter partes* review.

II. ANALYSIS

The Notice outlines factors the Board may consider in AIA trials in deciding whether to stay a parallel reexamination involving the same patent. *See* Notice, 84 Fed. Reg. at 16,657. We discuss each factor 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 challenged in this *inter partes* review are involved in the '488 Reexamination. *See* Ex. 3001, 5. This favors a stay.

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

The grounds of unpatentability in this *inter partes* review and the '488 Reexamination are both based on alleged obviousness, but the two proceedings involve different prior art. *Compare* Paper 8, 6–7, *with* Ex. 3001, 15–16. This weighs against a stay.

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

Because the same claims at issue in this *inter partes* review are also at issue in the '488 Reexamination, allowing both to proceed concurrently would duplicate efforts. This 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)

Because the same claims at issue in this *inter partes* review are also at issue in the '488 Reexamination, there is a possibility of inconsistent results. This favors a stay.

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

Because the same claims at issue in this *inter partes* review are also at issue in the '488 Reexamination and Patent Owner may amend the scope of the claims in either proceeding, this favors a stay.

F. The respective timeline and stage of each proceeding

In the '488 Reexamination, the Examiner granted the request for reexamination on July 15, 2024, but has not yet issued an office action. Ex. 3001. In this *inter partes* review, we entered a decision granting institution on September 30, 2024. Paper 8. 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 *inter partes* review is subject to a statutory deadline that requires a final decision within one year of institution, absent a good cause extension. 35 U.S.C. § 316(a)(11). The '488 Reexamination is required to be "conducted with special dispatch," but is not subject to a specific deadline. 35 U.S.C. § 305. 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

Because both proceedings involve the same claims, a decision in one proceeding could potentially simplify or render moot the other proceeding. However, considering the current stages of the proceedings and the statutory deadline for this proceeding, this factor favors a stay.

III. CONCLUSION

For the foregoing reasons, we find good cause for staying the '488 Reexamination pending resolution of this *inter partes* review. *See also* Notice, 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.").

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Reexamination Control No. 90/019,488 is stayed pending the termination or completion of IPR2024-00759;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/019,488 are tolled for the duration of the stay, and no further papers shall be filed without authorization in the reexamination while this stay remains in place; 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. 90/019,488.

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