

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOBILEYE GLOBAL, INC.,
Petitioner,

v.

FACET TECHNOLOGY CORP.,
Patent Owner.

IPR2024-01111
Patent 9,671,328 B2

Before KEVIN F. TURNER, ROBERT J. SILVERMAN, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

ORDER
Staying *Ex Parte* Reexamination
37 C.F.R. § 42.5

I. INTRODUCTION

On August 1, 2024, Mobileye Global, Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–22 of U.S. Patent No. 9,671,328 B2 (Ex. 1001, “the ’328 patent”). Paper 1 (“Pet.”). Facet Technology Corp (“Patent Owner”) filed a Preliminary Response. Paper 6. With our authorization, the parties also filed additional preliminary briefs. On March 5, 2025, we instituted *inter partes* review as to all challenged claims of the ’328 patent. Paper 14 (“Inst. Dec.”).

The parties informed us that the ’328 patent is the subject of *ex parte* reexamination 90/019,546 (“the ’546 Reexamination Proceeding” or “the reexamination”), which was requested by a third party. *See* Pet. 75; Paper 5, 4. On March 6, 2025, we directed the parties to meet and confer regarding whether they agreed that the reexamination proceeding should be stayed. Ex. 3002. The parties replied by joint email on March 11, 2025, indicating that they agreed that the reexamination should be stayed. *Id.*

For the reasons discussed below, we determine that there is good cause to stay the ’546 Reexamination Proceeding.

II. DISCUSSION

The Board has authority to stay a reexamination involving a patent challenged in 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. 16,654, 16,656 (Apr. 22, 2019) (“Notice”). “Good cause for staying a case may exist if, for example, an

ongoing [*inter partes* review] proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in [the reexamination].” *Id.* The Board may consider a motion to stay a reexamination proceeding or may impose a stay *sua sponte*. *Id.* at 16,657. When deciding whether to order a stay, the Board may consider factors including:

- 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;
- 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; [and]
- Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

Id. We address each of these factors below.

A. Challenged Claims

The reexamination involves claims 1–4 and 8–13. *See* Order Granting Request for *Ex Parte* Reexamination (July 15, 2024), 2 (indicating that

claims 1–4, 8–13, and 17–19 will be reexamined); Final Office Action (Jan. 31, 2025), 2 (recognizing that claims 17–19 were disclaimed and are no longer subject to reexamination). Each of the claims subject to reexamination is involved in this *inter partes* review proceeding. *See* Inst. Dec. 38 (instituting *inter partes* review of claims 1–16).

Thus, the facts underlying this factor weigh in favor of a stay.

B. Grounds of Unpatentability

The two proceedings raise different grounds of unpatentability. *See* Inst. Dec. 8–9 (identifying asserted references); Final Office Action (Jan. 31, 2025), 2–3 (identifying cited references).

Thus, the facts underlying this factor weigh against a stay.

C. Duplication of Efforts

This *inter partes* review was instituted on March 5, 2025, and the parties have not yet filed any post-institution briefs on the merits. This proceeding is subject to a statutory deadline that requires a final decision by March 5, 2026, unless the Chief Administrative Patent Judge extends it (up to six months) for good cause. *See* 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c). Such extensions are rarely granted.

A final Office Action was issued in the reexamination on January 31, 2025. Final Office Action (Jan. 31, 2025). A response to the final Office Action is initially due by March 31, 2025, but may be extended for sufficient cause. *Id.* at 19–20. Although a reexamination proceeds with “special dispatch” (35 U.S.C. § 305), there are no statutory deadlines.

In both proceedings, the Office has invested some resources, but work remains (including, potentially, the consideration of an appeal of the final Office Action issued in the reexamination). The *inter partes* review is subject to a statutory deadline, where the reexamination has no such deadline. Moreover, because each of the claims subject to reexamination is involved in this *inter partes* review proceeding, allowing both to proceed concurrently would duplicate efforts.

Thus, the facts underlying this factor weigh in favor of a stay.

D. Potential for Inconsistent Results

As noted above, the two proceedings raise different grounds of unpatentability, so there is little potential for inconsistent results in considering the specific challenges presented in each proceeding.

Thus, the facts underlying this factor weigh against a stay.

E. Potential Claim Amendments

The '328 patent has expired, and therefore its claims cannot be amended in the reexamination. *See* Order Granting Request for *Ex Parte* Reexamination (July 15, 2024), 3 (citing 37 C.F.R. § 1.530(j)). Patent Owner also is not permitted to amend the claims of the '328 patent in this proceeding because the '328 patent has expired. Accordingly, there is no risk of a claim amendment in one proceeding affecting claim scope in another proceeding.

Thus, the facts underlying this factor weigh against a stay.

F. Timelines and Stages of the Proceedings

This proceeding 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 deadline is March 5, 2026.

The reexamination is required to be conducted with “special dispatch,” but is not subject to a specific deadline. 35 U.S.C. § 305. Although a final Office Action was issued in the reexamination, Patent Owner has yet to respond (for example, by filing an appeal).

Thus, the facts underlying this factor weigh in favor of a stay.

G. Statutory Deadlines

As noted above, this proceeding is subject to a statutory deadline that, absent a good cause extension, requires a final decision be issued by March 5, 2026.

The reexamination is not subject to a specific deadline.

Thus, the facts underlying this factor weigh in favor of a stay.

H. Simplifying the Issues

Allowing the reexamination proceeding to continue would result in a decision addressing only some of the claims subject to this *inter partes* review. A Final Decision in this *inter partes* review, however, would address all of the claims subject to the reexamination proceeding and, therefore, could potentially simplify or render moot the reexamination proceeding.

Thus, the facts underlying this factor weigh in favor of a stay.

III. CONCLUSION

For the foregoing reasons, and given the parties' agreement that the reexamination should be stayed, we find good cause for staying the '546 Reexamination Proceeding pending resolution of this *inter partes* review. *See* Notice, 84 Fed. Reg. at 16,656 ("Good cause for staying a case may exist if, for example, an ongoing [*inter partes* review] proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in [the reexamination].").

IV. ORDER

Accordingly, it is:

ORDERED that Reexamination Control No. 90/019,546 is stayed pending the termination or completion of IPR2024-01111;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/019,546 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 the time periods for responding to any outstanding papers in Reexamination Control No. 90/019,546.

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