

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THERMALTAKE TECHNOLOGY CO., LTD. and
THERMALTAKE INC.,
Petitioner,

v.

LIAN LI INDUSTRIAL CO., LTD., and
CHEN, CHIEN-HAO,
Patent Owner.

IPR2024-01230
Patent 10,690,336 B1

Before MONICA S. ULLAGADDI, SHARON FENICK, and
ANDREAS BALTATZIS, *Administrative Patent Judges*.

BALTATZIS, *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 February 19, 2025, we instituted *inter partes* review in the above-referenced case, as to claims 1–5 (“the challenged claims”) of U.S. Patent No. 10,690,336 B1 (“the ’336 patent”). Paper 12.

A third-party requester, Axpertec, Inc., filed a Request for *Ex Parte* Reexamination (“EPR”) of claims 1–5 of the ’336 patent. Ex. 1020. The request was granted in Reexamination Control No. 90/019,565 on July 18, 2024. Ex. 1021. The EPR remains pending as of the institution date. *See* Ex. 3003; *see* Ex. 3004.

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”) (The Board may *sua sponte* impose a stay of a concurrent Office proceeding any time after institution of an AIA trial proceeding.). For the reasons discussed below, we determine that there is good cause to stay Reexamination Control No. 90/019,565 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

The claims challenged in the AIA proceeding (claims 1–5) are the same claims at issue in the EPR. *See* Ex. 1021, 6; Ex. 2001, 1. This factor favors a stay.

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

The same prior art, e.g., Lai, US 2017/0314777 A1 (Ex. 1012), and Tsuji, JP 2018041147 A (Ex. 1006), is at issue in this *inter partes* review and the EPR. *See* Paper 12, 6–7; Ex. 1021, 5; *see also* Paper 6 (“Prelim. Resp.”), 1 (“[T]he central reexamination unit issued an office action (‘the EPR Action’) rejecting all claims (1–5) of the ’336 patent based on the same primary references of Lai (US20170314777) and Tsuji (JP2018041147A; called Fujitsu in the EPR action) as used in this IPR.”). This factor favors 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 EPR, 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)

Because the same claims at issue in this *inter partes* review are also at issue in the EPR, there is a 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

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

F. The respective timeline and stage of each proceeding

In this *inter partes* review, we entered a decision granting institution on February 19, 2025. In our decision, we instituted trial; according to statute a final decision must issue by February 19, 2026. Patent Owner notifies the Board that the Office issued a Final Office Action in the EPR on February 4, 2025, rejecting all claims (including claims 1–5). Ex. 3003; *see also* Ex. 3004, 3. However, prosecution has not closed in the EPR and Patent Owner retains the ability to file an after-final amendment or appeal to the Board. Accordingly, significant work remains in each proceeding. 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 EPR 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 Reexamination Control No. 90/019,565 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. 90/019,565 is stayed pending the termination or completion of IPR2024-01230;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/019,565 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. 90/019,565.

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