

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HULU, LLC,
Petitioner,

v.

PIRANHA MEDIA DISTRIBUTION, LLC,
Patent Owner.

IPR2024-01252
Patent 11,463,768 B2

Before KARL D. EASTHOM and AARON W. MOORE,
Administrative Patent Judges.

EASTHOM, *Administrative Patent Judge.*

ORDER
Granting Motion to Stay *Ex Parte* Reexamination of
U.S. Patent No. 11,463,768 B2
35 U.S.C. § 42.5

I. INTRODUCTION

Hulu, LLC, Petitioner, filed a Petition (Paper 1, “Pet.”) on August 8, 2024, requesting an *inter partes* review of claims 1–3, 5–12, 14–21, 23–25, 27–29, and 31–33 (the “challenged claims”) of U.S. Patent No. 11,463,768 B2 (Ex. 1001, the “’768 patent”). Pet. 8. Piranha Media Distribution, LLC, Patent Owner, filed a Preliminary Response (Paper 6, “Prelim. Resp.”). On March 4, 2025, the Board instituted *inter partes* review as to all challenged claims of the ’768 patent. *See* Paper 15 (“Inst. Dec.”)

Between the filing of the Petition and the Institution Decision, on October 11, 2024, a third party filed a Request for *Ex Parte* Reexamination of claims 1, 10, 19, and 27 of the ’768 patent. Ex. 2009 (“Reexamination Request”). In addition, on December 13, 2024, the Office granted the Reexamination Request in Reexamination Control No. 90/019,699 (the “’699 Reexamination Proceeding” or “EPR”).

With our permission, Patent Owner filed an unopposed motion to stay the ’699 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 good cause exists to stay the ’699 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). “[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) (“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.

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 claims 1, 10, 19, and 27 of the ’768 patent challenged in the present IPR are also at issue in the EPR, which challenges claims 1, 10, 19, and 27 of the ’768 patent. Mot. 2. Also, the remaining claims in the IPR “depend directly or indirectly from” the claims in the EPR.

Accordingly, we determine 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 in both the IPR and the EPR, “the primary reference is Wu.” Mot. 3. We agree.

Accordingly, we determine that factor 2 favors a stay.

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

Patent Owner argues that “[w]ith overlapping art and claims, duplication risk is very high.” Mot. 4. We agree that there is a significant risk of duplication of Office proceedings.

Accordingly, we determine that factor 3 favors a stay.

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

Patent Owner argues that “[t]he IPR and EPR risk inconsistent results,” because “[b]oth may . . . rule on the scope of the same claims (and of Wu)” in determining whether “the same claims [are] obvious.” Mot. 4.

We agree that the IPR and EPR at least risk inconsistent results as to what Wu fairly teaches and the scope of the claims.

Accordingly, we determine 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 acknowledges that the ’768 patent expired so that the claims cannot be amended. We agree.

Accordingly, we determine that factor 5 is neutral or does not favor a stay.

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

Patent Owner argues that “[t]he IPR [final written] decision is due March 4, 2026,” but the “EPR was ordered December 13, and has no set deadlines or number of actions.” Mot. 5. Patent Owner argues that the Board determined under similar circumstances that these factors favor a stay. *Id.* (citing *Lab. Corp. of Am. Holdings v. Ravgen, Inc.*, IPR2021-00902, Paper 24, 9–10 (PTAB Feb. 1, 2022) (“*Ravgen*”)).

We agree, to a certain extent. The EPR here is “still at an early stage with no office action yet entered,” as it was in *Ravgen*. *Raygen* at 9. On the other hand, in *Ravgen*, the IPRs at issue were “somewhat further advanced because Patent Owner Responses have been filed in the respective cases, and the parties have been conducting discovery.” *Id.*

Accordingly, we determine that factors 6 and 7 are at worst neutral.

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 “[t]his IPR may simplify or moot the EPR issues, which has overlapping claims and art.” We agree. In addition, because the ’768 patent expired, this likely simplifies issues by precluding further amendments.

Accordingly, we determine that factor 8 favors 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 ’699 Reexamination Proceeding pending resolution of IPR2024-01252. *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 No. 90/019,699 is *granted*;

FURTHER ORDERED that Reexamination Control No. 90/019,699 is stayed, pending the termination or completion of IPR2024-01252;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/019,699 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. 90/019,699.

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