

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL TECHNOLOGIES, INC.,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

IPR2024-01494
Patent 11,968,909 B2

Before JUSTIN T. ARBES, SHEILA F. McSHANE, and
JOHN D. HAMANN, *Administrative Patent Judges*.

PER CURIAM.

ORDER

Denying Patent Owner's Motion to Terminate
Petitioner's Request for Reexamination
37 C.F.R. § 42.122(a)

I. BACKGROUND

Petitioner Western Digital Technologies, Inc., filed a Petition (Paper 1) requesting *inter partes* review (“IPR”) of claims 1–20 of U.S. Patent No. 11,968,909 B2 (Ex. 1017, “the ’909 patent”) pursuant to 35 U.S.C. § 311(a). Patent Owner Godo Kaisha IP Bridge 1 filed with the Office a statutory disclaimer of claims 1–4, 7, and 8 of the ’909 patent pursuant to 37 C.F.R. § 1.321(a). *See* Paper 7, 3 n.1, 38–39; Ex. 2018.

On April 30, 2025, the Board instituted an *inter partes* review as to the remaining challenged claims 5, 6, and 9–20 on all grounds of unpatentability asserted with respect to those claims in the Petition. Paper 9. Petitioner’s asserted grounds of unpatentability as to those claims involve three prior art references: Bowen, Nagahama, and Soukup. *Id.* at 6–7. The parties subsequently filed their Response, Reply, and Sur-Reply, and an oral hearing was conducted on January 23, 2026. *See* Papers 18, 24, 31, 52. The statutory deadline for the Board to issue a final written decision is April 30, 2026. *See* 35 U.S.C. § 318(a); 37 C.F.R. § 42.100(c).

On March 29, 2026, Petitioner filed a request for reexamination of claims 5, 6, and 9–20 of the ’909 patent, which the Office assigned Control No. 90/016,097. Ex. 1110. Petitioner’s request relies on two references not asserted in the grounds at issue in this proceeding: Kishi and Parkin. *Id.* at 6–11. The request includes a discussion of this proceeding. *Id.* at 14–15. The Office has not yet made a determination of whether to order reexamination. *See* 35 U.S.C. §§ 303, 304; 37 C.F.R. §§ 1.515, 1.525.

On March 31, 2026, Patent Owner requested authorization to file a motion to terminate the reexamination request. Ex. 3002. We authorized briefing on April 3, 2026. *Id.* Patent Owner then filed its Motion to Terminate (Paper 54, “Mot.”) on April 7, 2026, Petitioner filed its

Opposition (Paper 55, “Opp.”) on April 13, 2026, and Patent Owner filed its Reply (Paper 56, “Reply”) on April 16, 2026.

II. ANALYSIS

35 U.S.C. § 315(d) provides:

[D]uring the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

That authority is delegated to the Board under 37 C.F.R. § 42.122(a), which provides that “[w]here another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.”

Patent Owner argues that we should “terminate the reexamination (Control No. 90/016,097).” Mot. 1, 10. Patent Owner asserts that Control No. 90/016,097 qualifies as a “proceeding” or “matter” under the provisions above, but does not explain sufficiently why Control No. 90/016,097 is a proceeding or matter that may be terminated *at its current stage*. See Reply 1–2. Specifically, no reexamination has yet been ordered by the Office—only a request for reexamination has been filed. Because no reexamination currently exists, the relief sought by Patent Owner appears to be for Petitioner’s request for reexamination to be denied. See *id.* at 1 (citing MPEP § 2294 (an “[e]x parte reexamination proceeding[] may be concluded . . . by a denial of reexamination, or vacating the reexamination proceeding, or terminating the reexamination proceeding”)). In the normal

course, whether to grant or deny a reexamination request is decided by an examiner, not the Board. “Within three months following the filing of a request for reexamination under the provisions of section 302, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request,” and “[i]f . . . the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question.” 35 U.S.C. §§ 303(a), 304; *see* 37 C.F.R. §§ 1.515(a) (“an examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised”), 1.525(a).

Patent Owner in its Motion provides no basis for the Board to contravene that statutory language and terminate Petitioner’s reexamination request, prior to the Director making the required determination. *Cf.* MPEP § 2286.01 (“The existence of a PTAB Review Proceeding does not change the fact that any reexamination request must, by statute, be decided (a grant or a denial) within three months of its filing date.”).

Patent Owner relies on (1) a notice of proposed rulemaking from the Office, *Revision to Rules of Practice Before the Patent Trial and Appeal Board*, 90 Fed. Reg. 48,335 (Oct. 17, 2025) (“Proposed Rules”), and (2) a single prior case where the Board exercised its authority under 37 C.F.R. § 42.122(a) to terminate a set of reexaminations that had been ordered, *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, IPR2014-01093, Paper 81 (PTAB May 24, 2016) (“*Ariosa*”). Mot. 1–9. Neither is persuasive.

First, Patent Owner relies heavily on statements in the Proposed Rules to make various policy arguments regarding the availability of Office resources, prejudice, and gamesmanship. *See* Mot. 1, 3–9; Reply 3–5.

As Patent Owner acknowledges, however, the Proposed Rules are “not in effect.” Mot. 1; Reply 4; *see Apple Inc. v. Squires*, 166 F.4th 1349, 1356 (Fed. Cir. 2026) (“As to the notice of proposed rulemaking, the agency action is just a proposal. It has no current effect, and it cannot be reliably predicted what, if any, effect it will come to have.”). The notice merely “proposes” changes to the rules of practice for IPRs and seeks comments from the public. *See* Proposed Rules, 90 Fed. Reg. at 48,335, 48,341. Those comments are reviewed as part of the rulemaking process, and may affect what is promulgated. Therefore, Patent Owner’s contention that the Proposed Rules “would prohibit” Petitioner’s reexamination request is speculative.¹ Mot. 1. We also note that the Proposed Rules, if implemented as in the notice, only would amend 37 C.F.R. § 42.108 to specify that “[i]nter partes review shall not be instituted or maintained” in certain circumstances; they do not set forth conditions under which a request for reexamination would be denied or a reexamination terminated under 37 C.F.R. § 42.122(a). *See* Proposed Rules, 90 Fed. Reg. at 48,341.

¹ Patent Owner calls the Proposed Rules “guidance” for the Board to follow. Mot. 3–4; Reply 4. But again, the notice of proposed rulemaking “is just a proposal,” and “it cannot be reliably predicted what, if any, effect it will come to have.” *Apple*, 166 F.4th at 1356. Thus, we disagree that *proposed* rulemaking by the Office qualifies as such guidance. *See* 37 C.F.R. § 43.6 (“[A]ll decisions of the Board are expected to comport with all applicable statutes, regulations, binding case law, and written Office policy and guidance applicable to Board proceedings.”); Patent Trial and Appeal Board Standard Operating Procedure 4, at 4, *available at* https://www.uspto.gov/sites/default/files/documents/ptab_sop_4-2023-oct.pdf (the Board is required to “apply pertinent statutes, regulations, binding case law, and written guidance issued by the Director or the Director’s delegate that is applicable to PTAB proceedings”).

Second, Patent Owner does not cite any prior case in which the Board terminated an as-yet-unordered *ex parte* reexamination under 37 C.F.R. § 42.122(a), relying solely on *Ariosa*, which is distinguishable on its facts. *See* Mot. 2. The petitioner in that case filed two IPR petitions, one of which was instituted and resulted in a final written decision and the other was denied. *Ariosa*, Paper 81 at 2–3. Prior to the final written decision, the petitioner filed three requests for *ex parte* reexamination raising many of the same prior art references asserted in the IPR petitions. *Id.* at 4–6. The Office determined that each request raised a substantial new question of patentability and ordered reexamination. *Id.* The patent owner moved to terminate the reexaminations as duplicative of prior art and arguments raised in the IPR petitions. *Id.* at 6, 9–10, 13–14. The Board granted the motion, basing its decision in part on the fact that, although “the prior art disclosures relied upon [were] somewhat different,” the Board had previously “addressed Fan, Straus, and Shuber in the instant proceeding and in [the denied IPR].” *Id.* at 13–14 (noting that the petitioner had “raised patentability over the work of Straus” in both IPRs and the Board substantively considered Fan in the instituted IPR and Shuber in the denied IPR).

The instant proceeding is different from *Ariosa* because no reexamination of the ’909 patent has been ordered. *See Ariosa*, Paper 81 at 12 n.13 (finding that the motion to terminate was not “premature” because “reexamination has been ordered”). And there is no overlap of issues. The asserted grounds of unpatentability in this proceeding are based on Bowen, Nagahama, and Soukup, whereas Petitioner’s reexamination request relies on Kishi and Parkin. *See* Paper 9, 6–7; Ex. 1110, 6–11, 15–38. There are

no claim interpretation issues argued by the parties in this proceeding or the reexamination request. *See* Paper 1, 15; Paper 9, 10; Paper 18; Ex. 1110, 5–6. Thus, there is no apparent possibility of duplicative work or inconsistent findings between this proceeding and any reexamination based on Petitioner’s request. Indeed, this proceeding is now complete—all briefing has been filed, and the only thing remaining is for the Board to issue its final written decision.

Numerous other cases have denied requests similar to the one Patent Owner makes here. For example, in *Toyota Motor Corp. v. Am. Vehicular Sciences LLC*, IPR2013-00419, Paper 57 at 2–3 (PTAB Dec. 12, 2014), the patent owner sought, approximately one month prior to the one-year statutory deadline, authorization to file a motion to terminate a reexamination request filed by the petitioner. The Board denied authorization because “nothing from any potential reexamination proceeding to be ordered on the basis of [the p]etitioner’s request for ex parte reexamination possibly can affect the final written decision in this proceeding” and because “no reexamination proceeding has been ordered.”² *Id.* Similarly, nothing from any potential reexamination of the ’909 patent can affect our decision in this proceeding and no reexamination has been ordered. *See also Emerson Elec. Co. v. SIPCO, LLC*, IPR2017-00359, Paper 62 at 6–7 & n.5, 17–18 (PTAB Mar. 21, 2019) (finding that a motion to terminate was not “premature” because reexamination had been ordered

² We note that while the Board denied the patent owner’s request as premature, the patent owner ultimately was able to obtain its requested relief (i.e., termination under 35 U.S.C. § 315(d)) by filing a petition to the Director under 37 C.F.R. §§ 1.181 and 1.182, *after* reexamination had been ordered. *See Ex Parte* Reexamination Control No. 90/020,077, Decision on Petition mailed May 31, 2016.

and denying the motion in part because, unlike *Ariosa*, “[t]he prior art disclosures relied upon are significantly different between the instant proceeding and the [ordered] reexaminations”); *Game Show Network, LLC v. Stephenson*, IPR2013-00289, Paper 31 at 3–5 (PTAB Mar. 21, 2014) (denying a petitioner’s motion to terminate a reexamination request filed by the patent owner, finding that the petitioner’s “concern about duplication of effort and inefficient use of Board resources is premature, as the Director has not yet acted on” the reexamination request).³

Patent Owner makes two final requests for relief in its Motion. Patent Owner requests that we “order Petitioner to not file another reexam challenging the ’909 [p]atent before the [final written decision] issues.” Mot. 1, 10. Patent Owner does not cite any basis for the Board to issue such an order, and we are aware of none. *See* 35 U.S.C. § 302 (“Any person at any time may file a request for reexamination by the Office of any claim of a patent . . .”). Nor does Patent Owner explain why such relief would be appropriate pursuant to our authority under 37 C.F.R. § 42.12. Patent Owner also requests that, if the Motion is denied, we “defer issuing” the final

³ Patent Owner also cites *PacifiCorp v. Birchtech Corp.*, IPR2025-00687, Paper 40 (Squires Jan. 12, 2026) (precedential) (“*PacifiCorp*”). Mot. 4; Reply 4. That decision vacated Board decisions granting institution of two parallel petitions where the petitions each challenged the same claims under different priority dates, and remanded to the Board to institute at most one petition challenging each patent. *PacifiCorp*, Paper 40 at 2–4 (quoting the Trial Practice Guide’s explanation that “one [IPR] petition should be sufficient to challenge the claims of a patent in most situations” and “multiple [IPR] petitions by a petitioner are not necessary in the vast majority of cases”). *PacifiCorp* is inapplicable, as the issue here is not whether to institute an IPR when a petitioner files parallel petitions, but rather whether, during the course of an instituted IPR, to terminate a different proceeding before a different part of the Office.

written decision in this proceeding until it can seek Director Review.

Mot. 10; Reply 5; *see* 37 C.F.R. § 42.100(c) (“The [one-year statutory deadline] can be extended by up to six months for good cause by the Chief Administrative Patent Judge . . .”). But there is no good cause shown in light of our above discussion. Also, Patent Owner does not explain why it would be unable to seek such review after issuance of the final written decision pursuant to 37 C.F.R. § 42.75.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s Motion to Terminate is *denied*.

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