

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN, INC., SENSEONICS HOLDINGS, INC., and ASCENSIA
DIABETES CARE HOLDINGS AG,
Petitioners,

v.

CELLSPINSOFT, INC.,
Patent Owner.

IPR2025-00104
Patent 8,904,030 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

We previously instituted review of claims 1, 2, 4–7, and 9–18 of U.S. Patent 8,904,030 (the “’030 patent”) in IPR2024-00770 (“770 IPR”). 770 IPR, Paper 8. After the petition in the 770 IPR was filed, a third-party Requester filed a Request for *Ex Parte* Reexamination of claims 1, 2, 4–7, and 9–18 of the ’030 patent, which was granted in Reexamination Control No. 90/019,499 (the “499 Reexamination”). *See* Ex. 3001. We issued an order staying the 499 Reexamination pending resolution of the 770 IPR. 770 IPR, Paper 13. The present proceeding, challenging the same claims on the same grounds, was subsequently joined with the 770 IPR. 770 IPR, Paper 17.

On March 30, 2026, the Director reversed institution of the 770 IPR. 770 IPR, Paper 41, 7. Concurrently, the Board was ordered to determine whether this proceeding should be instituted on its own. *Id.* Having made that determination, we again instituted review in IPR2025-00104 on April 15, 2026. Paper 18. For the reasons discussed below, we determine that there is good cause to continue to stay the 499 Reexamination pending resolution of *inter partes* review.

II. ANALYSIS

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”). 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 proceeding are involved in the 499 Reexamination. *See* Ex. 3001, 10. 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 proceeding and the 499 Reexamination are both based on alleged obviousness, but involve different prior art. *Compare* Paper 1, 1 *with* Ex. 3001, 20. 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 proceeding are also at issue in the 499 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 proceeding are also at issue in the 499 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 are at issue in both proceedings, an amendment of those claims in the 499 Reexamination could affect the claim scope here. This favors a stay.

F. The respective timeline and stage of each proceeding

In the 499 Reexamination, the Examiner granted the request for reexamination on July 25, 2024, but that proceeding was stayed before the Examiner had issued an office action. The 770 IPR proceeded and a substantially complete trial record was developed. Patent Owner and Petitioners in the present proceeding have agreed to proceed on the record developed in the 770 IPR, with one supplemental brief authorized per side. *See* Paper 19 (conduct of proceeding order dated April 15, 2026). Moreover, the oral hearing is set for June 30, 2026. *Id.* Accordingly, the present *inter partes* review is substantially further along than the 499 Reexamination. This favors a stay.

G. The statutory deadlines of the respective 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 499 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 their current stages and the statutory deadline for this proceeding, this factor favors a stay.

III. CONCLUSION

In view of these factors, almost all of which favor a stay, we find good cause for staying the 499 Reexamination pending resolution of this proceeding. *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. 90/019,499 is stayed pending the termination or completion of IPR2025-00104;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/019,499 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. 90/019,499.

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