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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CBS INTERACTIVE INC., THE NEW YORK TIMES COMPANY, G4
MEDIA, LLC, BRAVO MEDIA LLC, and PHOENIX NEWSPAPERS, INC.
Petitioner,

v.

HELPERICH PATENT LICENSING, LLC
Patent Owner,

Case IPR2013-00033 (JYC)
Patent 7,155,241

November 6, 2012

Before SCOTT R. BOALICK, KEVIN F. TURNER, and, JONI Y. CHANG,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

ORDER
(To Stay the Concurrent Reexamination)

1 This petition for *inter partes* review of Patent 7,155,241 (“the ’241
2 patent”) was filed on October 25, 2012. A reexamination for ’241 patent is
3 also pending before the Office concurrently. (Reexam. 95/001,864.)
4 Although all of the claims being challenged in the instant proceeding are
5 different than those claims subject to reexamination, all of the independent

1 claims are being reexamined. Further, the Petitioners assert the same
2 grounds of challenge based on the same prior art in the instant proceeding as
3 some of those rejections adopted by the Examiner in the reexamination.
4 (Pet. 5; Exhibit 1002, March 12, 2012 Office Action 2-5.) We note that four
5 of the five Petitioners are also the third-party requesters who filed the
6 request for reexamination.

7 The Board will not ordinarily stay a reexamination because, in
8 absence of good cause, reexaminations are conducted with special dispatch.
9 Conducting the reexamination concurrently with the instant proceeding,
10 however, would duplicate efforts within the Office and could potentially
11 result in inconsistencies between the proceedings. Notably, since all of the
12 challenged claims are depended from the reexamination claims directly or
13 indirectly, the Patent Owner could amend the independent claims or other
14 claims in the reexamination which in turn could change the scope of the
15 challenged claims while the Board is conducting its review. Further, the
16 patentability of all of the independent claims would be determined in both
17 the instant proceeding and the reexamination based on the same grounds of
18 unpatentability.

19 In addition, the Board is required to determine whether to institute an
20 *inter partes* review within 3 months after receiving a preliminary response
21 from the Patent Owner, or the date on which such a response is due (*i.e.*,
22 January 29, 2013). *See* 35 U.S.C. § 314(b), as amended by the America
23 Invents Act (AIA). The final determination of any review instituted will
24 normally be issued no later than 1 year from institution. *See* 35 U.S.C.

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1 § 316(a)(11), as amended by AIA, and 37 C.F.R. § 42.100(c). Any Board
2 decision on whether to institute a review or final written decision with
3 respect to the patentability of the challenged claims will likely simplify the
4 issues in the reexamination.

5 Based upon the facts presented in the instant proceeding and in the
6 reexamination, the Board exercises its discretion and orders to stay the
7 reexamination 95/001,864, pending the termination or completion of the
8 instant proceeding.

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