

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner

v.

IXI IP, LLC
Patent Owner

Case IPR2016-01669
Patent 7,552,124

**PETITIONER'S MOTION TO
TERMINATE OR STAY CO-PENDING REEXAMINATION**

I. Precise Relief Requested

Petitioner Google Inc. (“Petitioner”) respectfully moves to terminate or stay the *ex parte* reexamination (Control No. 90/013,988, “Reexamination”) recently filed by Patent Owner IXI IP, LLC (“Patent Owner”).¹ By Patent Owner’s design, the request for reexamination (“Reexamination Request” or “Request”) presents a prior art analysis that is essentially identical to that presented by Petitioner in this proceeding (though it omits important evidence and explanations). The Request tacitly urges the examiner to interpret claims 6–10 of U.S. Patent No. 7,552,124 (“the ’124 patent”) in a manner inconsistent with the Institution Decision (Paper No. 9) and risks an interpretation of the prior art inconsistent with that of the Board. Thus, the Reexamination should be terminated or at the very least stayed until final resolution of this proceeding including any appeal.

II. Background

On March 8, 2017, the Board instituted *inter partes* review of claims 1–5 of the ’124 patent, but declined to institute review of claims 6–10. Paper No. 9 at 40. These latter claims were found to contain means-plus-function language governed by 35 U.S.C. § 112 ¶ 6 but not supported by sufficient corresponding structure in the specification. *Id.* at 7–9. The Board recognized that such claims are incapable

¹ The Board authorized Petitioner to file this five-page motion in a conference call with the parties on August 21, 2017.

of construction, precluding any prior art analysis. *Id.* at 9.

On July 17, 2017, Patent Owner filed its Reexamination Request. In the Request, attached as Exhibit 1015, Patent Owner acknowledges the indefiniteness issue that compelled the Board to decline to institute review of claims 6–10. Request at 2. However, Patent Owner nonetheless alleges that claims 6–10 “substantially track and correspond to the elements of instituted method claims 1–5,” and proceeds to present an analysis that corresponds to the one presented by Petitioner in this proceeding.² Request at 2, 10. The Reexamination Request also duplicates the analysis contained in a similar petition for *inter partes* review filed by other petitioners in IPR2017-00898 and seeks to add two new claims. On August 10, 2017, the central reexamination unit ordered reexamination of claims 6–10 of the ’124 patent.

III. Patent Owner’s Reexamination Should Be Terminated or Stayed

“Where 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.” 37 C.F.R. § 42.122. The Board

² Patent Owner omits many of the explanations about the prior art provided by Petitioner, Petitioner’s expert, and the Board. *See generally* Request.

thus has the authority to terminate or stay the Reexamination. *Id.*; *see also* 35 U.S.C. §§ 315(d), 325(d). That authority should be exercised here.³

A. The Reexamination Should Be Terminated to Avoid Inconsistency with the Institution Decision

Patent Owner's Reexamination Request seeks a result for claims 6–10 that is inconsistent with the Board's interpretation of these claims. Specifically, Patent Owner urges the examiner to determine whether the prior art at issue in this proceeding maps to claims 6–10. But this is exactly what the Board said *cannot* be done in the Institution Decision given the lack of sufficient corresponding structure in the '124 patent specification. Paper No. 9 at 7–9.

In a reexamination, just like in an *inter partes* review, an examiner is not permitted to consider issues relating to 35 U.S.C. § 112 for original claims. *See* 37 C.F.R. § 1.552; M.P.E.P. § 2258. Thus, given that the Reexamination Request has been granted by the central reexamination unit, the examiner is at this point in a position where any further analysis of claims 6–10 would be inconsistent with the Board's finding in the Institution Decision that these claims could not be interpreted. A stay of the reexamination would not alleviate this issue as the Board will not be revisiting claims 6–10.

³ If the Board finds the issues presented in this motion can instead be addressed through consolidation, Petitioner would not be opposed to such consolidation.

A reexamination is not supposed to be ordered where it seeks to call a Board decision into question. Specifically, a reexamination is only supposed to be ordered where it raises a “substantial *new* question of patentability.” 35 U.S.C. §§ 303, 304. The Reexamination here, failing to raise a *new* question of patentability, thus likely should not have been granted in the first place. *See* Order in Control No. 90/013,148 dated March 21, 2014 at 4 (“The analysis supplied in the current request . . . relies entirely upon the analysis presented . . . in IPR2013-00289. While the examiner agrees that [the analysis] presents a substantial question of patentability, the fact that the exact question is currently being considered by the PTAB means that the question cannot be considered new.”). In any event, the inconsistency the Reexamination calls for, which would subject the parties and the public to varying views on the scope of the claims, should compel termination.

B. In the Alternative, the Reexamination Should Be Stayed

The Reexamination should, at a minimum, be stayed. By Patent Owner’s own admission, the same prior art is being applied in the same way in both the present *inter partes* review and the Reexamination Request. Request at 10. Thus, any consideration of the prior art in the Reexamination runs the serious risk of creating inconsistencies with this proceeding. *See Sienna Biopharmaceuticals, Inc. v. William Marsh Rice University*, IPR2017-00046, Paper No. 10 at 3 (Apr. 24, 2017) (staying reexamination where it “may result in inconsistencies”). While

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