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Paper No. 10
Entered: November 22, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STINGRAY DIGITAL GROUP, INC.
Petitioner,

v.

MUSIC CHOICE,
Patent Owner.

Case IPR2017-01193
Patent 9,357,245 B1

Before MITCHELL G. WEATHERLY, GREGG I. ANDERSON, and JOHN F. HORVATH, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

INTRODUCTION

On April 5, 2017, Stingray Digital Group, Inc., ("Stingray" or "Petitioner") filed a first petition ("IPR2017-01193") to institute *inter partes* review of claims 1–9, 12–14, 16, and 17 of U.S. Patent No. 9,357,245 B1 ("the '245 patent"), arguing the claims are unpatentable as anticipated by publication WO 00/19662 to Mackintosh. On October 13, 2017, we instituted *inter partes* review of claims 1–9, 12–14, 16, and 17 of the '245 patent in IPR2017-01193.

On October 23, 2017, Petitioner filed a second petition ("IPR2018-00114") to institute *inter partes* review of claims 1–10 and 12–17 of the '245 patent, arguing claims 1–9, 12–14, 16, and 17 are unpatentable as anticipated by Mackintosh, and claims 10 and 15 are unpatentable as obvious over Mackintosh. On the same date, Petitioner filed a motion for joinder, seeking to join IPR2017-01193 and IPR2018-00114.

On October 24, 2017, Music Choice ("Patent Owner") filed a disclaimer under 35 U.S.C. § 253(a) of claims 1–9, 12–14, 16, and 17 of the '245 patent, all of the claims challenged in IPR2017-01193, and requested adverse judgment in that proceeding.

On October 25, 2017, Stingray requested a conference call with the Board to discuss IPR2018-00114 and its accompanying motion for joinder, Music Choice's disclaimer of claims 1–9, 12–14, 16, and 17 of the '245 patent, and Music Choice's request for adverse judgment in IPR2017-01193.

On October 31, 2017, the Board conducted a conference call with the parties. Stingray was represented by Heath Briggs and Joshua Raskin, and Music Choice was represented by Brian Rosenbloom and Martin Zoltick.

DISCUSSION

Stingray argues the petition and accompanying motion for joinder in IPR2018-00114 should be granted prior to granting Music Choice's request for adverse judgment in IPR2017-01193 because the petition and motion for joinder were timely filed prior to the request for adverse judgment. Stingray further argues it would be an inefficient use of judicial resources to deny the petition and motion for joinder in IPR2018-00114 because the validity of claims 10 and 15 of the '245 patent remains an issue pending before the U.S. District Court for the Eastern District of Texas.

Music Choice argues the petition and motion for joinder in IPR2018-00114 should not be treated as a stay to its request for adverse judgment in IPR2017-01193. Music Choice further argues granting its request for adverse judgment would promote the just, speedy, and inexpensive resolution of IPR2017-01193 because no claims would remain pending in that proceeding, and the proceeding could be terminated.

The Board cannot decide the merits of Stingray's petition and motion for joinder in IPR2018-00114 before receiving Music Choice's preliminary response in that proceeding, or the expiration of the time for filing such a response. *See* 35 U.S.C. § 315(c). Until then, the Board may stay any action in IPR2017-01193. *Id.* § 315(d). The Board may also change the default times in IPR2018-00114 for filing any preliminary response to the petition, any opposition to the motion for joinder, and any reply to the opposition to the motion for joinder. *See* 35 U.S.C. §§ 313, 316(a)(4); *see also* 37 C.F.R. § 42.5(c).

Accordingly, we vacate the current scheduling order in IPR2017-01193, and have ordered the parties to adhere to alternatives to the default

filing times in IPR2018-00114. The Board has not yet decided how to proceed on the merits in IPR2017-01193 and IPR2018-00114.

ORDER

It is:

ORDERED that the scheduling order issued on October 10, 2017 in IPR2017-01193 (Paper 7) is *vacated*.

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