

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GAME SHOW NETWORK, LLC and WORLDWINNER.COM, INC.
Petitioners

v.

JOHN H. STEPHENSON
Patent Owner

Case IPR2013-00289
Patent 6,174,237

Before SALLY C. MEDLEY, KEVIN F. TURNER, and
BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

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

By Order entered February 18, 2014 (Paper 24), the Board authorized
Petitioner to file a motion to terminate, or alternatively stay, *ex parte*
reexamination no. 90/013,148, which Patent Owner had requested to amend the

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claims at issue in this proceeding. Ex. 1009 at 2. Petitioner filed its motion on February 21, 2014. Paper 27. Patent Owner filed an opposition to the motion on March 5, 2014 (Paper 29), and Petitioner replied in support of the motion on March 12, 2014 (Paper 30).

In their motion Petitioner asserts, first, that Patent Owner's pursuit of the amendments in the *ex parte* reexamination is inconsistent with Congress' intent that *inter partes* review ("IPR") be an effective substitute for litigation. Mot. 2. Petitioner argues that in passing the America Invents Act ("AIA"), Congress intended that the parties' entire patentability dispute, including the patentability of substitute claims, be resolved in a single IPR. *Id.* at 1. According to Petitioner, permitting Patent Owner's "end-run around" the IPR would cause "duplicated USPTO effort and inefficiency" and the possibility of "inconsistent analyses" between the Board and the Central Reexamination Unit ("CRU"), because they would be applying the same prior art to "nearly identical claims and patentability issues." *Id.* at 4. Petitioner further asserts that if the CRU finds the substitute claims to be patentable, Petitioner would likely file a second IPR, which could have been avoided if Patent Owner had pursued the substitute claims in this proceeding. *Id.*

Second, Petitioner argues that Patent Owner's pursuit of substitute claims in the *ex parte* reexamination is inconsistent with the Panel's guidance. *Id.* at 3. According to Petitioner, "the Panel indicated that a 'complete remodeling of [] claim structure according to a different strategy' may be pursued in *ex parte* reexamination, [but] this IPR is the proper proceeding for minor claim

amendments,” such as those sought by Patent Owner. *Id.*

Although Petitioner styled their motion as one to “terminate, or to alternatively stay” the *ex parte* reexamination, Petitioner urges us to terminate the *ex parte* reexamination to stop Patent Owner’s “end-run of the IPR process.” *Id.* at 5.

Patent Owner opposes Petitioner’s motion. Patent Owner argues, *inter alia*, that amending its claims in an *ex parte* reexamination is consistent with the Board’s guidance; that it would be greatly prejudiced if its *ex parte* reexamination is terminated given that the deadline for moving to amend in this IPR has passed; and that any action now is premature given that its request has not yet been acted upon. Opp. 1-5. Petitioner’s reply in support of its motion largely repeats arguments made in the motion. Reply 1-2.

We deny Petitioner’s motion. First, we are not persuaded that permitting the *ex parte* reexamination to go forward would be contrary to Congressional intent. Petitioner has not pointed us to any express statement in the AIA that prohibits a patent owner from requesting an *ex parte* reexamination to amend claims at issue in a concurrent IPR. That the AIA permits Patent Owner to amend claims in an IPR¹ does not, by itself, prohibit Patent Owner from amending its claims by other means. Moreover, the AIA contemplates the possibility of concurrent proceedings, as it gives the Director discretion to determine how the concurrent matters may proceed.

Second, we agree with Patent Owner that its pursuit of amendments in an *ex*

¹ 35 U.S.C. § 316(d).

parte reexamination is not inconsistent with our guidance in this proceeding. In response to an inquiry whether Patent Owner may file a request for reexamination or reissue of the involved patent, we “directed [the parties’] attention to prior Board decisions which suggest that a Patent Owner may pursue new claims in another type of proceeding before the Office during the trial.” Paper 21 at 2. We quoted one prior Board decision as explaining:

If a patent owner desires a complete remodeling of its claim structure according to a different strategy, it may do so in another type of proceeding before the Office. For instance, a patent owner may file a request for *ex parte* reexamination, relying on the Board’s conclusion of a petitioner’s having shown reasonably likelihood of success on certain grounds of unpatentability as raising a substantial new question of unpatentability.

Id. (quoting *Idle Free Sys., Inc. v. Bergstrom, Inc.*, IPR2013-00027, Paper 26 (June 11, 2013)). To say that a Patent Owner may request an *ex parte* reexamination to obtain “a complete remodeling of its claim structure” does not mean, as Petitioner contends, that any other form of amendment to claims challenged in an IPR must be obtained within the IPR.²

² We decline the parties’ invitation to decide whether the proposed amendments represent a “complete remodeling” of Patent Owner’s claim structure, as Patent Owner contends, or whether they are “minor,” as Petitioner contends. We note, however, that Patent Owner’s right to amend the challenged claims in an *ex parte* reexamination is not unlimited. Our rules preclude patent owner from taking action inconsistent with an adverse judgment in this IPR, including obtaining a claim that is not “patentability distinct” from a claim that is canceled in this proceeding. 37 C.F.R. § 42.73(d)(3)(i). We take no position on whether Patent Owner’s amended claims presented in its reexamination request are patentably distinct from the original claims.

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Finally, Petitioner's concern about duplication of effort and inefficient use of Board resources is premature, as the Director has not yet acted on Patent Owner's request. Based on the facts of this proceeding, however, we would want to be apprised of any action taken in the reexamination proceeding. Accordingly, we direct Patent Owner to notify the Board, as soon as possible, whenever the status of the *ex parte* reexamination changes.

In consideration of the above, it is

ORDERED that Petitioner's motion to terminate, or to alternatively stay, *ex parte* reexamination no. 90/013,148 is DENIED; and it is

FURTHER ORDERED that Patent Owner shall, when there is something to report, file with the Board a status update of the reexamination proceeding.

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PETITIONER:

Brenton R. Babcock
Ted M. Cannon
Knobbe Martens Olson & Bear, LLP
Brent.babcock@knobbe.com
Ted.cannon@knobbe.com
boxgsn@knobbe.com
2BRB@knobbe.com
2tmc@knobbe.com

PATENT OWNER:

Daniel W. McDonald
Thomas Leach
Robert A Kalinsky
Merchant & Gould, P.C.
dmcDonald@merchantgould.com
stephensonIPR@merchantgould.com
tleach@merchantgould.com
rkalinsky@merchantgould.com