

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMONDI INC.
D/B/A LUMINOX WATCH COMPANY
Petitioner

v.

LENNON IMAGE TECHNOLOGIES LLC
Patent Owner

Case IPR2013-00432 (JTA)
Patent 6,624,843 B2

Before DENISE M. POTHIER, JUSTIN T. ARBES, and
TRENTON A. WARD, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

ORDER
Staying Concurrent *Ex Parte* Reexamination
37 C.F.R. § 42.122(a)

The Petition for *inter partes* review of Patent 6,624,843 B2 (the “’843 patent”) in the above proceeding was filed on July 10, 2013. The Petition challenges claims 1-7 and 14-19 of the ’843 patent.

A request for *ex parte* reexamination of claims 1-7, 14-17, and 19 of the '843 patent (Reexamination Control No. 90/012,669) was filed by Spryos J. Lazaris of Lazaris IP, Inc. on September 15, 2012 and granted on October 25, 2012. The reexamination is currently pending. On January 16, 2013, the Office issued a Non-Final Office Action rejecting claims 1, 2, 4-7, 14, 16, 17, and 19. Patent Owner submitted a response on March 18, 2013.

35 U.S.C. § 315(d), as amended by the America Invents Act, provides:

Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

See also 37 C.F.R. § 42.122(a). The Board will not ordinarily stay a reexamination because, in the absence of good cause, reexaminations are conducted with special dispatch. *See* 35 U.S.C § 305. Conducting the reexamination of the '843 patent concurrently with the instant proceeding, however, would duplicate efforts within the Office and could potentially result in inconsistencies between the proceedings. Claims 1-7, 14-17, and 19 are being challenged in both the reexamination and the instant proceeding. Thus, Patent Owner could amend the claims in the reexamination and change the scope of the challenged claims while the Board is conducting an *inter partes* review (should a review be instituted). In addition, the Board is required to determine whether to institute an *inter partes* review within three months after receiving a preliminary response from Patent Owner, or the date on which such a response is due. 35 U.S.C.

§ 314(b). The final determination of any review instituted will normally be issued no later than one year from institution. 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c). Any Board decision on whether to institute a review or final written decision with respect to the patentability of the challenged claims also may simplify the issues in the reexamination (e.g., claim interpretation).

Further, while we recognize that the challenge in the instant proceeding is based on different prior art than that presented in the reexamination and was filed by a different party, these facts do not weigh in favor of concurrent Office proceedings given the fact that claims 1-7, 14-17, and 19 of the '843 patent are being challenged in both proceedings. The possibility exists that if the proceedings are conducted concurrently, the claims could be amended during the reexamination at the same time the Board is conducting its review.

Based upon the facts presented in the instant proceeding and in the reexamination, the Board exercises its discretion under 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a) to stay the reexamination.

In consideration of the foregoing, it is hereby:

ORDERED that Reexamination Control No. 90/012,669 is stayed pending the termination or completion of the instant proceeding.

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Patent 6,624,843 B2

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