

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOSHIBA MEMORY CORPORATION  
Petitioner

v.

ANZA TECHNOLOGY, INC.  
Patent Owner

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Case IPR2018-01597  
Patent 6,354,479 B1

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Before MICHELLE N. ANKENBRAND, *Acting Vice Chief Administrative Patent Judge*; GEORGE C. BEST; and CHRISTOPHER L. CRUMBLY, *Administrative Patent Judges*.

BEST, *Administrative Patent Judge*.

DECISION

Granting Motion to Stay Reexamination 90/014,288  
*35 U.S.C. § 315(d)*

## I. INTRODUCTION

US Patent No. 6,354,479 B1 issued on March 12, 2002. Ex. 1001. The '479 patent is assigned to Anza Technology, Inc. Paper 4, 2. On September 7, 2018, Toshiba Memory Corporation (“TMC”) filed a Petition requesting an inter partes review of the '479 patent. Paper 1; *see also* Paper 3 (Notice of Accorded Filing Date). TMC’s Petition alleges that claims 37 and 39 of the '479 patent are unpatentable. Paper 1, 1. On March 12, 2019, we instituted this IPR. Paper 12.

On April 16, 2019, a third party requested reexamination of claims 1, 2, 19, 23, 37, 38, and 46–51 of the '479 patent. Paper 37, 2; *see also* Ex. 3004 (Request for Ex Parte Reexamination, Reexamination No. 90/014,288 (April 16, 2019)). On May 24, 2019, the reexamination request was granted and assigned control number 90/014,288. Ex. 3005 (Order Granting Ex Parte Reexamination, Reexamination No. 90/014,288 (May 24, 2019)). Of particular note, the petitioner’s request for reexamination of claim 37 was granted, in addition to the other identified claims. *Id.* at 2.

On June 24, 2019, Anza requested permission to file a motion seeking a stay of the '288 Reexam. Ex. 3003. On June 27, 2019, TMC indicated that it did not oppose Anza’s motion to stay the '288 Reexam provided that the stay, if granted, would not impact the schedule in this IPR. *Id.* On June 28, 2019, we authorized filing of Anza’s motion and requested that Anza address the considerations regarding requests for stays of reexamination the Office recently identified. *Id.* (citing Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding (April 2019), 84 Fed. Reg. 16,654, 16,656–

57 (April 22, 2019) (“Notice”). Anza filed its motion later that day. Paper 37 (“Mot.”).

## II. DISCUSSION

During the pendency of an IPR, the Director may stay a reexamination of the patent that is the subject of the IPR. 35 U.S.C. § 315(d). The Director has authorized the Board to enter an order affecting a stay of a parallel reexamination of a patent that is the subject of an IPR. 37 C.F.R. §§ 42.3(a), 42.122(a).

To obtain a stay of a reexamination, the party seeking the stay must show good cause. *See Fox Factory, Inc. v. SRAM, LLC*, Case IPR2017-01440, slip op. 3 (PTAB June 4, 2018) (Paper 32). In deciding whether good cause exists, we may consider a number of factors, including:

- (1) whether the claims challenged in the IPR are the same as or depend directly or indirectly from claims at issue in the reexamination;
- (2) whether the same grounds of unpatentability or the same prior art are at issue in both the IPR and the reexamination;
- (3) whether simultaneous conduct of the reexamination and IPR will duplicate efforts within the Office;
- (4) whether the reexamination and could result in the inconsistent results with the IPR;
- (5) whether amending the claim scope in one proceeding would affect claim scope in the other;
- (6) the respective timelines and stages of each proceeding;
- (7) the statutory deadlines of the reexamination and IPR; and
- (8) whether a decision in the IPR would likely simplify issues presented in the reexamination or render it moot.

*See Notice*, 84 Fed. Reg. at 16,657 (collecting cases).

We have considered Anza's motion in light of the considerations identified above. In this case, the IPR and the '288 Reexam only have a single claim—claim 37—in common. Mot. 4. The prior art cited in grounds of unpatentability advanced for claim 37 in this IPR and in the '288 Reexam substantially overlap. *Id.* at 5–7. The simultaneous conduct of this IPR and the '288 Reexam, therefore, likely would result in wasteful duplication of effort within the Office and create the risk of inconsistent factual determinations and legal conclusions, at least as to claim 37. Moreover, the '288 Reexam is at an earlier stage than this IPR. A first Office Action has yet to issue in the '288 Reexam; in this IPR, Anza has filed the Patent Owner's response to TMC's Petition. Thus, we determine that staying the '288 Reexam would serve the interests of economy and avoidance of potentially conflicting determinations.

### III. ORDER

For the foregoing reasons, it is ORDERED that Reexamination No. 90/014,288 is stayed until completion of this proceeding.

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Patent 6,354,479 B1

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