

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELEBRANDS CORP.,
Petitioner,

v.

TINNUS ENTERPRISES, LLC,
Patent Owner.

Case PGR2015-00018
Patent 9,051,066 B1

Before PHILLIP J. KAUFFMAN, RICHARD E. RICE, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

RICE, *Administrative Patent Judge*.

ORDER

*Denying Authorization to File a Motion to Suspend
Prosecution of Co-Pending Related Patent Applications
37 C.F.R. §§ 42.3(a), 42.20(b)*

A conference call was held on Wednesday, August 24, 2016, among Robert T. Maldonado and Tonia A. Sayour, representing Petitioner; Gareth T. Galster and Melissa S. Hockersmith, representing Patent Owner; and Judges Kauffman and

Goodson. Judge Rice was not available for the call, but has reviewed the transcript (Ex. 1037).

During the call, Petitioner requested authorization to file a motion to suspend prosecution of four pending patent applications (14/678,878, 14/713,146, 14/929,787, and 14/976,055). Patent Owner opposed Petitioner's request.

Petitioner asserts that the applications are continuations of and patentably indistinct from U.S. Patent No. 9,051,066 B1, which is the subject of this post-grant review proceeding. According to Petitioner, the Board has authority to suspend prosecution of the applications under 37 C.F.R. § 42.3(a) and 37 C.F.R. § 1.103(e). Petitioner also relies on a decision of the USPTO Office of Patent Legal Administration to suspend prosecution of a reissue application until the conclusion of a reexamination proceeding involving the same patent. *See In re Look*, Reexamination Control No. 90/007,009 (mailed Nov. 12, 2008).¹

We deny Petitioner's request for authorization to file a motion to suspend prosecution of the co-pending applications. Under 37 C.F.R. § 42.3(a), "[t]he Board may exercise exclusive jurisdiction within the Office over *every involved application and patent* during the proceeding, as the Board may order" (emphasis added). Petitioner has not persuaded us that any of the co-pending patent applications meets the "every involved application and patent" requirement, which triggers our authority under § 42.3(a).

We are not persuaded, moreover, that the provisions of 37 C.F.R. § 1.103(e), providing that "[t]he Office will notify applicant if the Office suspends action by the Office on an application on its own initiative," are applicable to this post-grant

¹ In the transcript from the call, the parties refer to this Decision as *Wyeth*, which is the entity to whom the Decision was mailed. *See, e.g.*, Ex. 1037, 11, 14.

review proceeding. Petitioner has not shown that Part 42 of Title 37, which governs trial proceedings before the Board, incorporates § 1.103(e). *See* 37 C.F.R. § 42.1(a) (providing that “[s]ections 1.4, 1.7, 1.14, 1.16, 1.22, 1.23, 1.25, 1.26, 1.32, 1.34, and 1.36 of this chapter also apply to proceedings before the Board, as do other sections of part 1 of this chapter that are incorporated by reference into this part”). During the call, moreover, Petitioner was unable to cite any Board decision granting a request to suspend prosecution of a related application (Ex. 1037, 11), while Patent Owner cited several Board decisions denying such requests (*id.* at 13–14 (citing *EMC Corp. v. Personal Web Technologies, LLC.*, Case IPR2013-00083, slip op. at 3 (PTAB March 19, 2013) (Paper 12); *Apotex Inc. v. Wyeth LLC*, Case IPR2014-00115, slip op. at 5–6 (PTAB May 29, 2014) (Paper 19); *Chums, Inc. v. Cablz, Inc.*, Case IPR2014-01240, slip op. at 2 (PTAB May 8, 2015) (Paper 22))).

For the foregoing reasons, it is

ORDERED that Petitioner’s request for authorization to file a motion to suspend prosecution of the four co-pending, related patent applications is denied.

PGR2015-00018
Patent 9,051,066 B1

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