

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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STRIDE RITE CHILDREN'S GROUP, LLC,  
Petitioner,

v.

SHOES BY FIREBUG LLC,  
Patent Owner.

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Case IPR2017-01810  
Patent 9,301,574 B2

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Before BARBARA A. BENOIT, MATTHEW R. CLEMENTS, and  
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

ORDER

Stay of Reissue Application No. 15/944,288  
*35 U.S.C. §315(d); 37 C.F.R. §§ 42.3(a), 42.122(a)*

## I. INTRODUCTION

This is a decision on Patent Owner's Motion to Stay Proceedings in Pending Reissue Application (Paper 16) ("Motion").<sup>1</sup> Patent Owner has filed reissue application 15/944,288 ("the '288 reissue application") for U.S. Patent No. 9,301,574 B2 (Ex. 1001, "the '574 patent"), the subject of this *inter partes* review. Petitioner did not file a response to the Motion. *See* 37 C.F.R. § 42.25(a)(1) (setting the default filing time for an opposition to a motion as one month). For the reasons discussed below, the Board exercises its discretion to stay examination of the '288 reissue application.

## II. ANALYSIS

The Director has authority to stay a reissue proceeding pursuant to 35 U.S.C. § 315(d), which provides:

(d) **MULTIPLE PROCEEDINGS.**— Notwithstanding sections 135(a), 251, and 252, and chapter 30, during 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.

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<sup>1</sup> Our rules require Board authorization for entry of a motion. 37 C.F.R. § 42.20(b). Patent Owner did not seek or obtain authorization to file the present Motion. In the future, a party wishing to file a motion must request a teleconference with the Board by email (trials@uspto.gov) in order to request authorization to file the motion. In any request for a conference call with the Board, the requesting party shall: (a) certify that it has conferred with the other party in an effort to resolve the dispute; (b) identify with specificity the issues for which agreement has not been reached; (c) identify the precise relief to be sought; and (d) propose specific dates and times at which both parties are available for the conference call. *See* Paper 11, 2. In the interest of efficiency, we will consider the Motion. However, any future motions filed without authorization in violation of our rules will be stricken.

Further, pursuant to 37 C.F.R. § 42.122(a), the Board may enter an order to effect a stay:

(a) *Multiple Proceedings*. Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.

*See also* 37 C.F.R. § 42.3 (providing the Board authority to exercise exclusive jurisdiction within the Office over an involved application and patent during the proceeding).

A stay may be warranted to avoid duplicating efforts in the Office, to avoid potentially inconsistent results, or to simplify the issues in a reissue application. *See Hewlett-Packard Co. v. MCM Portfolio LLC*, Case IPR2013-00217, slip op. at 2–3 (PTAB May 10, 2013) (Paper 8). Here all three reasons support staying prosecution of the '288 reissue application.

The claims pending in the '288 reissue application include claims 1–10 for which we have instituted trial in this proceeding. Motion 2; Paper 10, 42–43. The reissue claims have not been examined, and no Office action has been entered. Conducting examination of the '288 reissue application concurrently with this proceeding would needlessly duplicate efforts within the Office and could potentially result in inconsistencies between the two proceedings. Also, any final written decision in this *inter partes* review with respect to the patentability of the challenged claims may simplify the issues in the '288 reissue application.

Based on these facts, the Board exercises its discretion to stay examination of the '288 reissue application pending termination or completion of the instant proceeding.

### III. ORDER

It is

ORDERED that examination of reissue application 15/944,288, filed April 3, 2018, is stayed pursuant to 37 C.F.R. §§ 42.3(a) and 42.122(a) pending the termination or completion of IPR2017-01810; and

FURTHER ORDERED that all due dates in reissue application 15/944,288 are tolled.

IPR2017-01810  
Patent 9,301,574 B2

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