

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE SCOTTS COMPANY LLC
Petitioner

v.

ENCAP, LLC
Patent Owner

Case IPR2013-00110
Patent 6,209,259

Before MICHAEL P. TIERNEY, LORA M. GREEN, and RAMA G. ELLURU,
Administrative Patent Judges.

ELLURU, *Administrative Patent Judge.*

ORDER
(To Stay the Concurrent Reexamination)

This petition for *inter partes* review of U.S. Patent No. 6,209,259 (“the ’259 patent”) was accorded a filing date of January 10, 2013. A reexamination for the ’259 patent is also pending before the Office concurrently. (Reexamination Control No. 90/012,183.) Although the claims subject to reexamination include additional claims that are not the subject of the instant petition, all of the challenged claims are being reexamined. Further, some of Petitioner’s asserted grounds of unpatentability in the instant proceeding are based on the same prior art references that are the bases of the Examiner’s rejections in the reexamination. (Pet. 5-6, Ex. 1003 (“Roth”), Ex. 1004 (“Lowe”), and Ex. 1007 (“Matthews”), December 12, 2012, Reexam – Non-Final Action pp. 3, 10, 16.)

The Board will not ordinarily stay a reexamination because, in the absence of good cause, reexaminations are conducted with special dispatch. Conducting the reexamination concurrently with the instant proceeding, however, would duplicate efforts within the Office and could potentially result in inconsistencies between the proceedings. Notably, because all the challenged claims also are being reexamined, the Patent Owner could amend those claims, which could change the scope of the challenged claims while the Board is conducting its review. Further, because of the overlap between the asserted prior art references in this proceeding and the bases of the Examiner’s rejections, the patentability of all of the challenged claims could be determined in both the instant proceeding and the reexamination based on the same grounds of unpatentability.

The Board is required to determine whether to institute an *inter partes* review within 3 months after receiving a preliminary response from the Patent Owner, or the date on which such a response is due. *See* 35 U.S.C. § 314(b), as

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amended by the America Invents Act (AIA). The final determination of any review instituted will normally be issued no later than 1 year from institution. *See* 35 U.S.C. § 316(a)(1), as amended by the AIA, and 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 will likely simplify the issues in the reexamination.

Based upon the facts presented in the instant proceeding and in the reexamination, the Board exercises its discretion and orders to stay the reexamination 90/012,183, pending the termination or completion of the instant proceeding.

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