

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GNOSIS S.p.A., GNOSIS BIORESEARCH S.A. and GNOSIS U.S.A., INC.  
Petitioners

v.

MERCK & CIE  
Patent Owner,

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Case IPR2013-00117  
Patent 6,011,040

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Before MICHAEL P. TIERNEY, JACQUELINE WRIGHT BONILLA, and  
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

**ORDER**  
**(To Stay Concurrent Reexamination)**

A petition for *inter partes* review of Patent 6,011,040 (“the ‘040 patent”) was filed on January 23, 2013. The petition challenges claims 1-3, 5, 6, 8, 9, 11-15 and 20-22 of the ‘040 patent. Previously, a request for *ex parte* reexamination (90/011,935) directed to the ‘040 patent was filed by a third party on October 4, 2011. Claims 1-22 of the ‘040 patent, and newly added dependent claims 23-63, are subject to the reexamination, which is currently pending.

Reexamination of all claims challenged in this proceeding has been ordered in 90/011,935. Thus, there is an overlap between the claims in the reexamination and the claims in this proceeding, should a trial be instituted. Moreover, there is overlap in the prior art in that two references, Wood '472 and Ubbink et al., are common to both proceedings.

The Board will not stay a reexamination in the absence of good cause. Conducting the above-identified reexamination concurrently with the instant proceeding, however, would duplicate efforts within the Office and could potentially result in inconsistencies among the proceedings. For instance, amendment of the claims in the reexamination proceeding could change the scope of the claims challenged in this proceeding while the Board is conducting its review.

The Board is required to determine whether to institute an *inter parties* review within three months after receiving a preliminary response from the Patent Owner, or the last date on which such a response is due (i.e., April 23, 2013). *See* 35 U.S.C. § 314(b). 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)(11). Any Board decision on whether to institute a review or a final written decision with respect to the patentability of the challenged claims will likely simplify the issues in the reexamination.

Based upon the foregoing considerations and the record presented in the instant proceeding and in the reexamination, the Board exercises its discretion and hereby orders a stay in reexamination 90/011,935.

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In consideration of the foregoing, it is, therefore,  
**ORDERED** that all proceedings in reexamination 90/011,935 are stayed  
until completion of this proceeding.

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