

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,
ORACLE OTC SUBSIDIARY LLC,
INGENIO LLC, and
YELLOWPAGES.COM LLC
Petitioners

v.

CLICK-TO-CALL TECHNOLOGIES LP
Patent Owner

Case IPR2013-00312
U.S. Patent No. 5,818,836

Before MICHAEL R. ZECHER, THOMAS L. GIANNETTI, and
TRENTON A. WARD, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION
Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Click-to-Call Technologies LP (“Patent Owner”) requests rehearing (Paper 37, “Reh’g Req.”) on the Board’s decision to institute (Paper 26, “Dec.”) an *inter partes* review of claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of U.S. Patent No. 5,818,836 (“the ’836 patent”). In its preliminary response (Paper 14, “Prelim. Resp.”), Patent Owner contends that the petition is barred under 35 U.S.C. § 315(b) as a result of service of a complaint alleging infringement of the ’836 patent on a predecessor of Ingenio LLC—one of the Petitioners—more than a year before the petition was filed on May 28, 2013. Prelim. Resp. 3-9. In the decision to institute, the Board determined that Petitioners—namely Ingenio LLC—are not barred from pursuing an *inter partes* review under § 315(b). Dec. 15-18.

In its request for rehearing, Patent Owner contends that the Board erroneously interpreted § 315(b) because: (1) the legislative history associated with § 315(b) dictates that the plain meaning of “served with a complaint alleging infringement of a patent” is conclusive, and, therefore, the Board’s analysis of the issue erred in looking beyond the statutory language; (2) the Board erred in looking to the Federal Rules of Civil Procedure to interpret the statute because the language of § 315(b) is unambiguous and there is no legislative history that contradicts its plain meaning; (3) voluntary dismissal of a complaint for patent infringement does not affect the running of the “one year” time period under § 315(b); and (4) the holdings of the Federal Circuit in *Graves* and *Bonneville* relied upon by the Board are inapposite to the Board’s determination that the dismissal of an action without prejudice leaves the parties as though the underlying complaint had never been

served. Reh'g Req. 2-13. For the reasons set forth below, Patent Owner's request for rehearing is denied.

II. ANALYSIS

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000). The request for rehearing must specifically identify all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 427.71(d). Given the similarities that exist between the issues that Patent Owner raises in its request for rehearing, we group the issues into two subsets and address them in turn.

With respect to the first and second issues set forth above, Patent Owner's contentions are predicated on the notion that there is nothing ambiguous about the statutory language of § 315(b) (Reh'g Req. 3-8), which provides:

An inter partes review may not be instituted if the petition requesting the proceeding is filed more than one year after the date on which the petitioner, real party in interest, or privy of the petitioner *is served with a complaint alleging infringement of the patent.*

Emphasis added. However, Patent Owner does not provide us with a credible reason why we should not look to both the Federal Rules of Civil Procedure and Federal Circuit precedent when interpreting the statutory language of § 315(b).

See, e.g., Macauto U.S.A. v. BOS GmbH & Kg, Paper 18, IPR2012-00004, slip op. at 14-16 (PTAB 2013 Jan. 24, 2013); *Ariosa Diagnostics v. Isis Innovation Ltd.*, Paper 20, IPR2012-00022, slip op. at 4-8 (PTAB Feb. 12, 2013).

With respect to the third and fourth issues set forth above, we maintain our initial position that both the Federal Rules of Civil Procedure and Federal Circuit precedent treat a dismissal without prejudice as something that, *de jure*, never existed. Dec. 16-17. It is undisputed that the patent infringement suit filed by Inforocket against Keen—now Ingenio LLC—on June 8, 2001, was dismissed without prejudice on March 21, 2003. Ex. 1019; Ex. 1017 at 4; Ex. 1018 at 8. We have determined that, because that patent infringement suit was dismissed without prejudice, Federal Circuit precedent interprets such a dismissal as leaving the parties in the same legal position as if the underlying complaint had never been served. *See Graves v. Principi*, 294 F.3d 1350, 1356 (Fed. Cir. 2002); *Bonneville Assoc., Ltd. Partnership v. Baram*, 165 F.3d 1360, 1364 (Fed. Cir. 1999); accord 9 WRIGHT, MILLER, KANE, and MARCUS, FEDERAL PRAC. & PROC. CIV. § 2367 (3d. ed.).

Patent Owner’s argument that the holdings of the Federal Circuit in *Graves* and *Bonneville* are inapposite to the Board’s determination is not persuasive. Reh’g Req. 9-12. Patent Owner does not reconcile how the dismissal of an action without prejudice leaves the parties in the same legal position as if the action had “never been filed,” which Patent Owner readily admits is the correct holding in the Federal Circuit’s *Graves* decision (*id.* at 10-11), yet somehow would not affect the running of the “one year” time period under § 315(b). Nor does Patent Owner explain adequately why the holdings of the Federal Circuit in *Graves* and

Bonneville should not apply to a petition for *inter partes* review. In addition, Patent Owner does not direct us to Federal Circuit or other precedent that supports its argument.

III. CONCLUSION

For the foregoing reasons, the Board did not abuse its discretion when determining that Petitioners—namely Ingenio LLC—are not barred from pursuing an *inter partes* review under 35 U.S.C. § 315(b). Accordingly, Patent Owner’s request for rehearing is denied.

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