

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YAMAHA CORPORATION OF AMERICA
Petitioner

v.

BLACK HILLS MEDIA, LLC
Patent Owner

Case No. IPR2014-00766
U.S. Patent 8,214,873

**PATENT OWNER'S REQUEST FOR REHEARING ON THE
INSTITUTION DECISION PURSUANT TO 37 C.F.R. §42.71**

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<i>Histologics, LLC v. CDX Diagnostics, Inc., et al.</i> , IPR2014-00779, Paper 6 (PTAB, September 12, 2014)	<i>passim</i>
<i>Histologics, LLC v. CDX Diagnostics, Inc., et al.</i> , IPR2014-00779, Paper 9 (PTAB, October 16, 2014).....	2, 5, 6
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TABLE OF EXHIBITS

Exhibit Description (Previously Submitted)	Exhibit #
Declaration of Gareth Loy and Exhibits A - N thereto (previously filed in IPR2013-00598 (U.S. Patent 8,214,873) as Ex. 2011)	2001
Deposition Transcript of Dr. Bove dated 5/29/2014 (previously filed in IPR2013-00598 (U.S. Patent 8,214,873) as Ex. 2012)	2002

Pursuant to 37 C.F.R. § 42.71(d), Black Hills Media, LLC (“Patent Owner”)

hereby submits the following Request for Rehearing in response to the Decision, Institution of *Inter Partes* Review of U.S. Patent No. 8,214,873 (“Decision”) (Paper 7).

I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

In the Decision, the Board declined to deny the Petition under 35 U.S.C. § 315(b), stating:

Thus, neither Patent Owner’s original 2012 complaint nor its FAC were viable federal pleadings. Patent Owner finally filed a federal complaint properly alleging its standing to sue, on January 21, 2014. The instant petition was filed in May 2014. Accordingly, Patent Owner’s argument under § 315(b) fails.

(Decision at 9). It is respectfully submitted that the Board reached an erroneous conclusion of law when it failed to find that the September 19, 2012, First Amended Complaint involving the ‘873 patent did not become a nullity upon dismissal without prejudice because, to this day, Petitioner remains answerable to the district court for the allegations made in the original First Amended Complaint and pursuant to the schedule issued from the First Amended Complaint. As such, the parties were not left in the same legal position as if the First Amended Complaint had never been filed.

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