

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TERREMARK NORTH AMERICA LLC, VERIZON BUSINESS  
NETWORK SERVICES INC., VERIZON SERVICES CORP.,  
TIME WARNER CABLE INC., ICONCONTROL NETWORKS, INC. and  
COXCOM, LLC,  
Petitioner,

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC,  
Patent Owner.

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Case IPR2015-01478  
Patent 6,542,076 B1

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Before HOWARD B. BLANKENSHIP, STACEY G. WHITE, and  
JASON J. CHUNG, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

DECISION  
Denial of Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. INTRODUCTION

### A. Background

Terremark North America LLC (“Terremark”); Verizon Communications, Inc.,<sup>1</sup> Verizon Services Corp., Time Warner Cable Inc. (“Time Warner”), iControl Networks, Inc., and CoxCom, LLC (collectively “Petitioner”) filed a Petition (Paper 1, “Pet.”) seeking to institute an *inter partes* review of claims 31, 40, 48, 143, 177, 183, 185, 188, 206, 216, and 217 of U.S. Patent No. 6,542,076 B1 (Ex. 1001, “the ’076 patent”) pursuant to 35 U.S.C. §§ 311–319. Joao Control & Monitoring Systems, LLC, (“Patent Owner”) filed a Preliminary Response. (Paper 9, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable

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<sup>1</sup> The Petition lists Verizon Communications, Inc. as a petitioning party (Pet. 2) and the caption of the Petition does not list Verizon Communications, Inc.; instead it lists Verizon Business Network Services Inc. as a petitioning party. Petitioner identifies “Verizon Communications Inc., Verizon Corporate Resources Group LLC and Verizon Data Services LLC as a real party-in-interest for the IPR requested by this Petition solely to the extent that Patent Owner contends that these separate legal entities should be named a real party-in-interest in the requested IPR.” Pet. 2. It is, however, Petitioner’s obligation to identify all real parties-in-interest. 35 U.S.C. § 312(a). As such, we take Petitioner’s statement as an admission that these entities are real parties-in-interest. Petitioner notes that Verizon Communications Inc. has more than 500 affiliated entities and states that “each of these entities agrees to be estopped under the provisions of 35 U.S.C. §§ 315 and/or 325 as a result of any final written decision in the requested IPR to the same extent that the Petitioners are estopped.” *Id.* On this record, we construe any mismatch between the named Verizon entities to be a typographical error.

likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Petitioner contends the challenged claims are unpatentable under 35 U.S.C. §§ 102 and 103 on the following specific grounds (Pet. 20–53):

Reference(s)	Basis	Claim(s) Challenged
Busak <sup>2</sup>	§ 102 <sup>3</sup>	31, 48, 143, 177, 183, 185, 188, 206, 216, and 217
Busak and French <sup>4</sup>	§ 103	40

For reasons discussed below, we do not institute *inter partes* review of the '076 patent.

#### *B. Related Proceedings*

Petitioner informs us that the '076 patent is at issue in twenty-six lawsuits pending in courts around the country. Pet. 3–4. In addition, *ex*

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<sup>2</sup> U.S. Patent No. 5,461,372, issued Oct. 24, 1995, filed Jan. 19, 1993 (“Busak”) (Ex. 1005).

<sup>3</sup> Petitioner argues that the claims at issue are entitled to a priority date of no earlier than July 18, 1996. Pet. 16–20. Petitioner then argues Busak would be prior art under 35 U.S.C. § 102(b) and cites a February 4, 1992 issuance date. *Id.* at 20–21. Busak, however, issued October 24, 1995 and thus, on this record would be prior art under 35 U.S.C. § 102(a) if we were to agree with Petitioner’s arguments regarding the priority date of the challenged claims. We, however, decline to decide that issue because, on the current record, it appears that Busak’s January 19, 1993 filing date makes it available as prior art under 35 U.S.C. § 102(e). The other asserted prior art reference, French, qualifies as prior art under 35 U.S.C. § 102(b) under either date.

<sup>4</sup> U.S. Patent No. 5,061,916, issued Oct. 29, 1991 (“French”) (Ex. 1006).

*parte* reexamination No. 90/013,302 was filed with respect to the '076 patent and is pending. *Id.* at 3.

*C. Statutory Bar*

Patent Owner asserts that the Petition must be denied as untimely. Prelim. Resp. 11–19. A statutory time bar regarding the institution of an *inter partes* review is set forth in 35 U.S.C. § 315(b), which provides as follows:

PATENT OWNER'S ACTION.—An *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 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. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

On June 23, 2014, two of the petitioning parties, Verizon Communications and Time Warner, were served with complaints alleging infringement of the '076 patent. Prelim. Resp. 12; Ex. 2001 ¶¶ 2, 4. By stipulation of the parties, Terremark, another of the petitioning parties, was substituted in place of Verizon Communications. Ex. 2001 ¶ 3, Ex. 2004. Thus, under the statute, Petitioner must have filed its Petition by June 23, 2015. The filing date accorded to the Petition is June 23, 2015. Notice of Filing Date Accorded (Paper 3).

Patent Owner alleges that this filing date is improper because Petitioner did not effect service until June 24, 2015. Prelim. Resp. 13. In support of this assertion, Patent Owner provides a printout of tracking information that shows acceptance of the package containing the service copy of the Petition by Federal Express on June 24, 2015. Ex. 2007. In

addition, Patent Owner argues that that Petitioner's electronic transmission of the Petition and supporting documents did not constitute proper service. Prelim. Resp. 16–18. According to Patent Owner, Petitioner “[sent an email] to Patent Owner’s litigation counsel at 11:55 pm on June 23, 2015” and this email contained links to an electronic file share site which had links to the Petition and supporting evidence. *Id.* at 16; Ex. 2009. Patent Owner argues that there is no evidence that the Petition and supporting evidence actually were available June 23, 2015. Prelim. Resp. 16–17. Patent Owner also asserts that its litigation counsel was not representing Patent Owner in any matters before the USPTO and that it had not consented to email service. *Id.*

Patent Owner cites 35 U.S.C. § 312(a) that states “[a] petition filed under section 311 may be considered only if— . . . (5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.” *See* Prelim. Resp. 15. The statute, however, does not require that the documents be served on the Patent Owner, nor does it specify when the Patent Owner must receive these documents. The statute, instead, requires that the Petitioner “provide[]” copies to the Patent Owner. Patent Owner was provided with, and did receive, copies of the documents in question. We, therefore, decline to deny this Petition for failure to meet the requirements of 35 U.S.C. § 312.

In addition, the facts of this case are similar to *Micron Tech., Inc. v. e.Digital Corp.*, Case IPR2015-00519 (PTAB Mar. 24, 2015) (Paper 14), in which the Board addressed a Motion to Deny a Petition a Filing Date based on Improper Service. The petitioner in *Micron* filed timely the petition, and

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