

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TERREMARK NORTH AMERICA LLC, VERIZON BUSINESS NETWORK
SERVICES INC., VERIZON SERVICES CORP., TIME WARNER CABLE
INC., ICONTROL NETWORKS, INC., AND COXCOM, LLC
Petitioners,

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC
Patent Owner

Case:

IPR2015-01482 (Pat. 7,397,363)

**PATENT OWNER'S OPPOSITION TO MOTION TO RECOGNIZE JUNE
23 FILING DATE OF PETITION**

LIST OF EXHIBITS

Exhibit No.	Description
2001	Declaration of René A. Vazquez
2002	Proof of Service indicating that Verizon Communications, Inc. was served with a Complaint alleging infringement of the '010 Patent on June 23, 2104 in the matter of <i>JCMS v. Terremark North America LLC</i> , C.A. No. 14-525-GMS (D. Del.)
2003	Terremark's Rule 7.1 Disclosure Statement in the matter of <i>JCMS v. Terremark North America LLC</i> , C.A. No. 14-525-GMS (D. Del.)
2004	Substitution of Terremark North America LLC in place of Verizon Communications Inc. in the matter of <i>JCMS v. Terremark North America LLC</i> , C.A. No. 14-525-GMS (D. Del.)
2005	Proof of Service indicating that Time Warner Inc. was served with a Complaint alleging infringement of the '010 Patent on June 23, 2104 in the matter of <i>JCMS v. Time Warner Cable, Inc.</i> , C.A. No. 14-524-GMS (D. Del.)
2006	USPS Tracking data for package containing service copies of IPR2015-01482, -01485 and -01486, indicating shipment on June 24, 2105
2007	FedEx Tracking data for package containing service copies of IPR2015-01466, -01477, -01478 and -01484, indicating shipment on June 24, 2105
2008	Email dated July 17, 2015 from Patent Owner's counsel R. Vazquez to Petitioners' counsel C. Holloway
2009	Email dated July 29, 2015 from Petitioners' counsel C. Holloway to Patent Owner's counsel R. Vazquez.
2010	Email dated July 31, 2015 from Petitioners' counsel C. Holloway to Patent Owner's counsel R. Vazquez.

I. Introduction

In order to be accorded a filing date of June 23, 2015, Petitioners needed to accomplish nine separate tasks for three separate petitions: 2015IPR-01482; -01485; and -01486.1 Petitioners were required to complete the electronic filing of each petition and all supporting exhibits; they needed to pay the required fees for each petition; and they needed to serve the petitions and supporting documents on Patent Owner at its correspondence address of record. 37 C.F.R. § 42.106. Petitioners not only failed to accomplish *any* of these tasks on June 23, 2015, they did not even attempt to accomplish eight of the nine tasks until June 24. In their motions, Petitioners effectively concede that these failures were not the result of a “clerical or typographical error,” but instead resulted from deliberate decisions made by Petitioners and their counsel. The Board has never accorded an earlier filing date where a petitioner failed to accomplish, much less even attempt, any of the requirements for according a filing date and should not do so now.

The motion concerning the -01482 Petition should be denied for a separate, independent reason. Petitioners uploaded and served an incorrect expert

1 Due to the common actors and issues involved, Patent Owner addresses facts for each of these three petitions below. Because the -01482 Petition involves aggravating facts, that petition is addressed separately.

declaration, rendering their filing on June 24 incomplete. In fact, Patent Owner was not provided with the correct declaration until July 29, 2015, more than five weeks after the filing date Petitioners seek by their motions. Because granting Petitioners' requested relief would severely prejudice Patent Owner's ability to prepare a response to this Petition, the motion should be denied on this independent ground.

II. Law

Petitions for *inter partes* review (IPR) may not be filed more than one year after Petitioners were served with a complaint alleging infringement. 35 U.S.C. § 315(b). The same one-year time bar is found in the USPTO's trial practice rules. 37 C.F.R. § 42.101(b).

Moreover, the Board's governing statute provides that a petition "may be considered only if ... the petition is accompanied by payment of the fee established by the Director under section 311." 35 U.S.C. § 312(a)(1). The same statute provides that an IPR petition may be considered only if "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." 35 U.S.C. § 312(a)(5). These statutory requirements cannot be waived by the Board. In addition, the Board's trial practice rules provide that a petition is only accorded a filing date once a petition has been filed, payment has been made, and

the complete petition is served on the patent owner. 37 CFR 42.106(a). The Board has discretion to excuse certain late actions “on a showing of good cause” or “in the interests of justice.” 37 C.F.R. 42.5(c)(3). The trial practice rules also include provisions for correcting a “clerical or typographical mistake”. 37 C.F.R. § 42.104(c). The burden of proving that such a correction is appropriate rests with Petitioners. 37 C.F.R. § 42.20(c).

III. Facts

In spite of well-known risks and in the face of clear warnings, Petitioners intentionally engaged in a deliberate course of conduct that should have, and properly did, result in their petitions being accorded a filing date of June 24, 2015 – one day after the statutory bar period. Now, by their motions, Petitioners seek to have this panel save them from the consequences flowing directly from their decisions.

Two of the filing Petitioners (Terremark and Time Warner) were served with complaints for infringement of the '363 and '130 Patents on June 23, 2014. (Vazquez Decl., ¶¶ 1-4, Exh. 2002-2005). Over the last year, the parties have engaged in extensive discovery in the District of Delaware. This discovery includes Initial Disclosures, interrogatories and requests for documents directed to each Defendant, production and review of more than 4,600 pages of “core

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