

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 IPR2015-01485

Patent 7,397,363

**PETITIONER COXCOM LLC'S REQUEST FOR REHEARING UNDER 37
C.F.R. § 42.71 ON THE DECISION NOT TO INSTITUTE
INTER PARTES REVIEW**

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), Petitioner CoxCom hereby requests rehearing of the Board’s decision denying institution of IPR2015-01485 (Paper 10, entered December 28, 2015; “Decision”) concerning U.S. Patent No. 7,397,363.¹ The Decision found that “the Petition was not filed timely within the statutory period of 35 U.S.C. § 315(b).” Paper 10 at 2.

Rehearing is warranted because the Decision misapplied 35 U.S.C. § 315(b) (“Section 315(b”). Specifically, the Decision overlooked a recent Federal Circuit case stating that a petition is **not** time-barred unless it is time-barred as to *all* petitioners or real parties in interest. *Click-To-Call Technologies, LP v. Oracle Corporation, et al.*, No. 15-1242, 622 Fed. Appx. 907 (Fed. Cir. Nov. 12, 2015). The Decision overlooked *Click-To-Call* when it held that “[t]he presence of CoxCom, LLC . . . does not remove the statutory bar.” Paper 10 at 15. Under *Click-to-Call*, the Petition could not possibly be time-barred because CoxCom was served with a complaint alleging infringement of the ‘363 patent less than one year before the filing date of the Petition. Therefore, the Petition was timely filed and should be considered on the merits.

¹ Abbreviations used in this motion are consistent with the abbreviations used in the Petition and the Decision.

For this reason, Petitioner CoxCom respectfully requests the Board vacate its decision denying the Petition, consider the merits of the Petition, and institute trial.

II. ARGUMENT

A. Standard of Review

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). An abuse of discretion “occurs when a court misunderstands or misapplies the relevant law or makes clearly erroneous findings of fact.” *Renda Marine, Inc. v. U.S.*, 509 F.3d 1372, 1379 (Fed. Cir. 2007). Petitioner CoxCom respectfully submits that this standard is met.

B. Section § 315(b) and the *Click-to-Call Decision*

Section 315(b) provides that a petition is untimely only “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.” 35 U.S.C. § 315(b). *Click-To-Call* interprets this section and is critical to any analysis of whether a petition filed by multiple petitioners is time-barred.

In *Click-To-Call*, the Federal Circuit stated that “the § 315(b) time bar does not impact the Board’s authority to invalidate a patent claim—it only bars particular petitioners from challenging the claim.” *Click-To-Call Technologies, LP v. Oracle Corporation, et al.*, No. 15-1242, 622 Fed. Appx. 907-908 (Fed. Cir.

Nov. 12, 2015) (citing *Achates Reference Publishing, Inc. v. Apple Inc.*, No. 14-1767, 2015 U.S. App. LEXIS 17183 (Fed. Cir. Sept. 30, 2015)). The Court made clear that “[t]he Board may still invalidate a claim challenged in a time barred petition via a properly-filed petition from another petitioner.” *Id.*

The Court pointed out that, when evaluating whether a petition is time-barred under § 315(b), the focus is on the petitioners, not the real-parties-in-interest. The threshold question is whether **each** individual Petitioner is time-barred. This analysis is consistent with the plain language of Section 315(b), which focuses on the date upon which “**the** petitioner” is served with a complaint—not “any petitioner” or “a petitioner.”

C. The Petition Is Proper And CoxCom Is Not Time-Barred Under Section 315(b) And Click-to-Call

Under a proper application of § 315(b) the Petition is proper because CoxCom is not time-barred. An evaluation of **each** Petitioner reveals that Petitioners Terremark North America, LLC, Verizon Business Network Services, Inc., Verizon Services, Corp., and Time Warner Cable Inc. are time-barred because the Petition was accorded a filing date of June 24, 2015, more than one year after those Petitioners were served with the complaint. However, CoxCom is not time-barred because, unlike the other Petitioners, it was served with the complaint on August 18, 2014, **less than** one year before the Petition was filed. Paper 6 at 9. Thus, the Petition was filed within CoxCom’s one year window under Section

315(b). Since CoxCom was not time-barred as of the filing date accorded to the Petition, the Board should have evaluated the Petition on the merits. *Click-to-Call* makes this clear.

The Decision is contrary to *Click-to-Call* because it concluded that the Petition was time-barred as to all Petitioners rather than just some Petitioners. As pointed out in *Click-To-Call*, “the § 315(b) time bar does not impact the Board’s authority to invalidate a patent claim—it only bars particular petitioners from challenging the claim.” *See Click-To-Call Technologies, LP*, No. 15-1242, 622 Fed. Appx. 907-908 (Fed. Cir. Nov. 12, 2015). As explained above, CoxCom is not a time-barred petitioner under § 315(b) and the Board should consider the merits of the petition in making its institution decision. *Id.* at 907-908 (“[t]he Board may still invalidate a claim challenged in a time barred petition via a properly-filed petition from another petitioner.”); *see also Achatos Reference Publishing, Inc. v. Apple Inc.*, 803 F.3d 652, 657 (Fed. Cir. Sept. 30, 2015)(“This means that an otherwise time-barred party may nonetheless participate in an *inter partes* review proceeding if another party files a proper petition.”). The presence of other time-barred petitioners is of no consequence because CoxCom could have filed an identical petition, leaving off all of the other Petitioners, one day or even one month later and such petition would have unquestionably been considered a proper petition under § 315(b). *Achatos Reference Publishing, Inc.*, 803 F.3d at

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