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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TERREMARK NORTH AMERICA LLC, VERIZON COMMUNICATIONS,
INC., VERIZON SERVICES CORP., TIME WARNER CABLE INC.,
ICONCONTROL NETWORKS, INC. AND COXCOM, LLC,
Petitioners

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC,
Patent Owner

INTER PARTES REVIEW NO: IPR2015-01485

**MOTION TO RECOGNIZE JUNE 23, 2015 AS FILING DATE OF PETITION
FOR *INTER PARTES* REVIEW OF U.S. PATENT NO.7,397,363**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. Statement of Precise Relief Requested

Pursuant to 37 C.F.R. § 42.104 and 37 C.F.R. § 42.5, Petitioners Terremark North America LLC, et al. respectfully request that the Patent Trial and Appeal Board (“the Board”) recognize Petitioners’ Petition for *Inter Partes* Review of U.S. Patent No. 7,397,363 and Exhibits as being filed on and assign a filing date of June 23, 2015, the date on which Petitioners, in the absence of technical issues, would have successfully transmitted the Petition and its exhibits to the Board. Pursuant to instructions from a PTAB paralegal on July 14, 2015, Petitioners informed Patent Owner of these facts and requested consent to obtain the earlier filing date. Patent Owner does not consent.

II. Statement of Facts Showing Good Cause for the Board to Authorize Filing of Petition for *Inter Partes* Review and Exhibits on June 23, 2015

On June 23, 2015, at approximately 10:45 PM Eastern Time, Natasha Robinson Kilpatrick Townsend’s lead and most experienced paralegal for IPR filings, having filed approximately 30 IPR petitions, logged into PRPS via the “Direct Link” available at: <https://ptabtrials.uspto.gov/> and attempted to upload documents.¹ Ex. 1 at ¶¶ 1-4. At that time, Ms. Robinson was provided with final

¹ A declaration from Natasha Robinson (“Robinson Decl.”) attesting to the circumstances surrounding the filing is submitted herewith as Ex. 1. Evidence in

versions of three petitions, exhibits, powers of attorneys, and payment means. *Id.* at ¶ 3-4, 9. While trying to upload the exhibits to the petitions, PRPS would timeout and freeze. *Id.* at ¶ 4. In all, it took approximately seven hours to fully upload the exhibits to the corresponding petitions. *Id.* at ¶ 9-11.

Each time a document was being uploaded, the system would display the icon for processing and after waiting a minute or more, the upload would stop, requiring Ms. Robinson to navigate back in the system to the page where Real Parties in Interest were identified. *Id.* at ¶ 4, 6-7. From this page, the petition would still be shown as loaded but the attempted exhibit would have to be resubmitted. *Id.* at ¶ 6. After repeated attempts and realizing the system was apparently malfunctioning, Ms. Robinson began taking screenshots to illustrate the “pending” status during the filing process. *Id.* at ¶ 5-7. Ms. Robinson continuously encountered the following timeouts, shown in this first screenshot taken at 11:50p.m. EST after about an hour of experiencing this issue. *Id.* at ¶ 5-7:

(continued...)

support of the declared facts are provided as Attachments A through B to the
Robinson Decl.

Motion Recognize June 23, 2015 filing date of *Inter Partes* Petition of U.S. Patent No. 7,397,363

ates Required Fields

edging	IPR2015-01482	Patent Number	7397363	No of Challenged Claims	11	Status	Pending	Accorded Filing Date
ner	Terremark North America LLC	Patent Owner	Technology Center	2600	Filing Date	Institution Date		

Petition Information

Party Information

[Petition Documents](#)

Payment Information

Payment

Other Information

Counsel Information

Related Matters

Review Petition

Review Petition

Upload Documents

File must be PDF (video exhibits may be MPEG). Each file cannot exceed 25 MB.

File:

Document List

Name	Type	Exhibit/Paper Number	File Name	Filing Date	Filing Party	Availability
1 Inter Partes Review	Petition		363 IPR.pdf		Petitioner	Public <input type="button" value="Download"/>

on: 6/23/15 11:50 PM

<< Back Save Next >>

The first Petition for IPR (i.e., IPR2015-01482) was indicated as “pending” by PRPS on June 23, 2015. From the time of logging in at approximately 10:45 EST, no document was changed in size or format. *Id.* at ¶ 4, 9. Ms. Robinson repeatedly tried to determine why the system was taking so long to receive each exhibit for the first petition and began to document the error at 11:50 p.m., realizing the first petition and exhibits would not be completely uploaded by midnight. The three petitions were done in a series order to avoid having to reload any previously submitted exhibits. *Id.* at ¶ 7. Thus, the second petition (i.e., IPR2015-01485) and third petition (i.e., IPR2015-01486) could not be filed until the first filing was completed. *Id.*

Late on the 23d and early on the 24th, Ms. Robinson sent various emails, attached to the Robinson Decl. as Attachment A, to Trials@uspto.gov and PTAB

Paralegal Althea Wilburn confirming the various attempts made to upload documents, confirmation of Petitioners' intention to continue to upload and file the documents even though PRPS continuously experienced timeouts, and a request to be awarded the filing date of June 23, 2015. *Id.* at ¶ 8. Further, in the early morning of June 24, 2015, Ms. Robinson reached out to PTAB paralegal Althea Wilburn to confirm receipt of the emails demonstrating the technical difficulties, the complete filing of the Petition which took until early morning to complete the various filings, and request further instructions as to what is necessary to recognize and be awarded the June 23, 2015 filing date of the Petition. *Id.* at ¶ 12.

Ms. Wilburn indicated that she had received Ms. Robinson's emails from the period when uploading was repeatedly failing and indicated that Petitioners would need to file a motion with PTAB outlining the facts and circumstances leading to the failed uploading because of the PRPS system. *Id.* at ¶ 12. Petitioners compiled the necessary information and emailed PTAB to request the appointment of a panel for the purposes of seeking to file a motion on June 25, 2015. *Id.* at Ex. 2.

III. PTAB Has the Authority In These Circumstances to Recognize the Filing Date for this *Inter Partes* Review as June 23, 2015.

The Board has used 37 C.F.R. § 42.104 and § 42.5 in similar and other circumstances involving submission using PRPS to afford a different filing date of *inter partes* review petitions from provisional dates under its discretion. The Board has noted that 37 C.F.R. § 42.104 "is remedial in nature and is therefore entitled to

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