

Case IPR2016-01252
U.S. Patent No. 8,155,298 B2

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRIGHT HOUSE NETWORKS, LLC,
WIDOPENWEST FINANCE, LLC,
KNOLOGY OF FLORIDA, INC.,
BIRCH COMMUNICATIONS, INC.,
Petitioners

v.

FOCAL IP, LLC,
Patent Owner

Case IPR2016-01252
Patent No. 8,155,298

Before JAMILAH SULTAN, *Trial Paralegal*.

PETITIONER'S UNOPPOSED MOTION TO DISMISS PETITION FOR
INTER PARTES REVIEW

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Bright House Networks, LLC; WideOpenWest Finance, LLC; Knology of Florida, Inc.; Birch Communications, Inc. (collectively “Petitioners”) move the Board for an order dismissing the IPR2016-01252 petition for *inter partes* review of U.S. Patent No. 8,155,298. Petitioners sought authorization to file the present motion by email on September 26, 2016. Authorization was provided on September 27, 2016. This motion is being filed within the five business day deadline dictated in the email authorizing the filing of this motion. Counsel for Petitioner conferred with counsel for Patent Owner. Patent Owner does not oppose the relief sought by this Motion.

I. BACKGROUND

Petitioners filed the petition in this matter on June 23, 2016. Paper 1. On July 6, 2016, the Board issued a notice according the petition a filing date of June 23, 2016. Paper 6. Right after filing the petition, Petitioners determined that the incorrect entity name was used in the real party-in-interest identification section. In particular, Petitioners listed “Data Connection Ltd. d/b/a Metaswitch Networks” rather than “Metaswitch Networks Ltd.” Petitioners filed an additional petition for *inter partes* review raising identical grounds and support but correcting the entity name the following day. That petition is the petition in Case No. IPR2016-01263, which has been accorded a filing date of June 24, 2016. As a result, there are

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currently two pending petitions challenging the validity of the same claims of the '298 patent based on the same arguments and support, filed by the same Petitioners.

II. ARGUMENT

Good cause exists for granting Petitioners' request to withdraw the petition in this case. The Board has the authority to grant Petitioners' motion under at least 37 C.F.R. §§ 42.5(a) and 42.71(a).

As an initial matter, the Patent Owner does not oppose this motion. Additionally, IPR2016-01252 is in its early phases, with no preliminary patent owner response on file and no decision on the merits regarding institution reached by the Board. The Board has dismissed early-stage IPRs, like the present IPR, in several other cases. *See e.g., Ericsson Inc. and Telefonaktiebolaget LM Ericsson v. Adaptix, Inc.*, IPR2016-00619, Paper 8 at p. 3 (PTAB May 4, 2016); *Apple Inc. v. Telefonaktiebolaget LM Ericsson*, IPR2016-00109, Paper 7 at p. 2 (PTAB Jan. 29, 2016); *Celltrion, Inc. v. Cenetech, Inc.*, IPR2015-01733, Paper 12 at p. 2 (PTAB Oct. 6, 2015) (granting unopposed motion to dismiss petition); *Under Armour, Inc. v. Adidas AG*, IPR2015-01531, Paper 8 at p. 2 (PTAB Sept. 21, 2015) (granting unopposed motion to dismiss petition).

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Given the early stages of this IPR, dismissal will ensure that both the Board's and the parties' resources are not unnecessarily taxed while advancing the Patent Office's policy of "secur[ing] the just, speedy, and inexpensive resolution" to the above-captioned IPR. *See* 37 C.F.R. § 42.1(b). For example, dismissal will mean that the Board will not need to expend resources considering the merits, preparing and issuing an institution decision, and proceeding through trial and a final written decision for IPR2016-01252. For the Patent Owner, the requested dismissal will eliminate the need to prepare duplicative responses and manage deadlines in two otherwise identical proceedings. As such, it would be proper for the Board to dismiss the pending Petition "at this early juncture, to promote efficiency and minimize unnecessary costs." *Ericsson Inc.*, IPR2016-00619, Paper 8 at p. 3. While the Board's and the Patent Owner's resources will be spared by the requested dismissal, the requested dismissal will still cause no harm to the public interest because the same challenges to the same claims will be addressed in IPR2016-01263.

If the Board should grant Petitioners' Motion to Dismiss the Petition in the above-captioned IPR, Petitioners additionally request a refund of the post-institution fee paid by Petitioners with the June 23, 2016 petition. As required by 37 C.F.R § 42.15(a), Petitioners paid a total of \$23,000 in fees, which included a

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\$9,000 *inter partes* review request fee and a \$14,000 post-institution fee. Because this IPR is in the preliminary-proceeding stage and no institution decision has been rendered, should the Board terminate the IPR, Petitioners would be entitled to a refund of the \$14,000 post-institution fee. *See, e.g.*, 78 Fed. Reg. 13, 4233-34 (January 18, 2013) (noting that “if the review is not instituted at all, the portion of the fee covering the trial would be returned”). Accordingly, Petitioners request a refund of the post-institution fee in the amount of \$14,000.

III. CONCLUSION

For the foregoing reasons, Petitioners request that the Board dismiss the petition in IPR2016-01252, terminate proceedings on that petition (noting that the decision on the motion does not constitute a final written decision under 35 U.S.C. § 318(a)), and grant a refund of the post-institution fee paid with that petition.

October 4, 2016

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