UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT PACKARD ENTERPRISE COMPANY,
Petitioner,

v.

CHRIMAR SYSTEMS, INC.,
Patent Owner.

U.S. Patent No. 8,902,760

Case No.: IPR2019-00033

PATENT OWNER'S SUR-REPLY TO ITS PRELIMINARY RESPONSE TO PETITION FOR *INTER PARTES* REVIEW UNDER 37 C.F.R. § 42.107

Table of Authorities

Cases

Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.,
905 F.3d 1311 (Fed. Cir. 2018) 1, 2, 3

Cisco Systems, Inc. v. Chrimar System, Inc.,
Case IPR 2018-01508 (January 31, 2019).....1

Cisco Systems, Inc. v. Chrimar System, Inc.,
Case IPR 2018-01511 (January 31, 2019).....1

Cisco Systems, Inc. v. Chrimar System, Inc.,
Case IPR 2018-01514 (February 4, 2019).....1

Click-to-Call Techs., LP v. Ingenio, Inc.,
899 F.3d 1321 (Fed. Cir. 2018) 1, 2, 3

Noven Pharms., Inc. v. Novartis AG,
IPR2014-00549, Paper 10 (PTAB Oct. 14, 2014).....2

Statutes

35 U.S.C. §315.....1, 2

List of Exhibits

Exhibit No.	Description
2001	Petitioner's Complaint challenging the validity of '760 patent claims
2002	Order Temporarily Staying Case
2003	Notice of Voluntary Dismissal

Ignoring the plain language of the statute and the Federal Circuit's directives in *Click-to-Call* and *Bennett Regulator*, Hewlett-Packard Company ("HP") asserts that Congress intended the filing of a civil action ***not*** bar institution of an IPR under the same set of facts where serving a complaint ***would do so***. HP cites no authority for that distinction. Under 35 U.S.C. §315(a), if a party files a civil action for a declaratory judgment of patent invalidity, the Board may not institute an IPR, period.

The PTAB already decided in related Petitions by HP that under these circumstances: "§315(a)(1) bars institution of an inter partes review even though Petitioner voluntarily dismissed its earlier civil action challenging the validity of the '760 patent without prejudice." *Cisco Systems, Inc. v. Chrimar System, Inc.*, Case IPR 2018-01511, Paper 11 (January 31, 2019); *See also*, *Cisco Systems, Inc. v. Chrimar System, Inc.*, Case IPR 2018-01514, Paper 10 (February 4, 2019); *Cisco Systems, Inc. v. Chrimar System, Inc.*, Case IPR 2018-01508, Paper 11 (January 31, 2019).

HP's effort to distinguish "civil action" from "complaint" to avoid the Federal Circuit directives is unavailing. The two go hand-in-hand, as Fed. R. Civ. P. 3 make clear: "A civil action is commenced by filing a complaint with the court." The PTAB has also confirmed that no distinction exists: "When the statute [§315(a)(1)] refers to ***filing a civil action***, it refers to ***filing a complaint*** with a court to commence a civil action." *Noven Pharms., Inc. v. Novartis AG*, IPR2014-00549, Paper 10, at 6-7

(PTAB Oct. 14, 2014).

HP does not deny that its filing of the declaratory judgment complaint triggered the bar of §315(a)(1)—*i.e.*, it does not deny that the bar would be in effect had HP not later dismissed the complaint. HP contends that subsequent events can eliminate the bar, a contention the Federal Circuit expressly rejected in *Bennett Regulator*: "We recently held that serving a complaint alleging infringement—***an act unchanged by the complaint's subsequent success or failure***—unambiguously implicates §315(b)'s time bar." *Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.*, 905 F.3d 1311, 1314-15 (Fed. Cir. 2018), citing *Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1329–32 (Fed. Cir. 2018). More pointedly, the Federal Circuit held, "The statute endorses ***no exceptions*** for dismissed complaints . . . . ." *Id.* at 1315. Section 315(a)(1) states, without exceptions, "[a]n *inter partes* review ***may not be instituted*** if, ***before the date on which the petition for such a review is filed, the petitioner*** or real party in interest ***filed a civil action*** challenging the validity of a claim of the patent." Unquestionably, *Bennett Regulator's* holding applies equally to §315(a)(1) because filing a civil action — "an act unchanged by the complaint's subsequent success or failure" — unambiguously implicates §315(a)'s time bar. *Bennett Regulator*, 905 F.3d at 1314-15. In golf vernacular, the statute does not allow HP to take a Mulligan.

Section 315(a)(1) is ***more*** stringent—not less—than §315(b) because, under

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