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**From:** Mehta, Hersh <hersh.mehta@morganlewis.com>  
**Sent:** Monday, April 29, 2019 2:57 PM  
**To:** Precedential\_Opinion\_Panel\_Request  
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tlewry@brookskushman.com; mlorelli@brookskushman.com;  
csmith@brookskushman.com; HPE-Chrimar-IPR; Hawkins, Brent A.; Doukas, Maria E.;  
Fowler, Karon N.  
**Subject:** IPR2019-00032, -00033: Request for Precedential Opinion Panel Review  
**Attachments:** 2019-04-29 [IPR2019-00032, 0012] Petitioner's Request for Rehearing.pdf; 2019-04-29  
[IPR2019-00033, 0013] Petitioner's Request for Rehearing.pdf

Dear Precedential Opinion Panel:

Petitioner in IPR2019-00032 and -00033 requests review by the Precedential Opinion Panel of the attached rehearing requests, filed today. Based on my professional judgment, I believe these cases require answers to the following precedent-setting questions of exceptional importance:

1. Does a Petitioner's filing of an action for declaratory judgment of invalidity that is voluntarily dismissed under Rule 41(a)(1)(A)(i) bar institution of *inter partes* review under 35 U.S.C. § 315(a)(1)?
2. Should the Federal Circuit's holding in *Click-To-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018), which only dealt with the interpretation of 35 U.S.C. § 315(b) and the language "served with a complaint," extend to the language "filed a civil action" in 35 U.S.C. § 315(a)(1)?

Petitioner notes that Ruiz Food Products Inc. and Avigilon Corp. recently filed similar requests regarding similar precedent-setting questions that also arose in their IPR proceedings. *See Ruiz Food Products Inc. v. MacroPoint LLC*, IPR2017-02016, IPR2016-02018; *Avigilon Corp. v. Canon Inc.*, IPR2018-01626. This confirms both the need to convene a Precedential Opinion Panel and the exceptional importance of the above-stated precedent-setting questions.

As the Precedential Opinion Panel may be convened to address issues of exceptional importance regarding statutes or issues of broad applicability to the Board, the issues presented in this case are proper for Precedential Opinion Panel review. (PTAB Standard Operating Procedure 2, Rev. 10 at Section II(A).) Indeed, as described in the accompanying Requests for Rehearing, at issue is the statutory interpretation of § 315(a)(1) in light of the Federal Circuit's decision in *Click-To-Call*. The impact of this interpretation has broad applicability in light of the numerous Board decisions applying *Click-To-Call* to § 315(a)(1) to deny institution. *See, e.g., Mylan Pharm. Inc. v. Horizon Pharma USA, Inc.*, IPR2017-01995 (P.T.A.B. Mar. 27, 2019); *Avigilon Corp. v. Canon Inc.*, IPR2018-01626 (P.T.A.B. Mar. 18, 2019); *Avigilon Corp. v. Canon Inc.*, IPR2018-01627 (P.T.A.B. Mar. 18, 2019).

Respectfully submitted,

/Hersh Mehta/  
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IPR2019-00033

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