Trials@uspto.gov
571–272–7822

Paper 16
Date: September 11, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT PACKARD ENTERPRISE CO.
Petitioner

v.

CHRIMAR SYSTEMS, INC.
Patent Owner

Case IPR2019-00033
Patent 8,902,760 B2

Before KARL D. EASTHOM, GREGG I. ANDERSON, and ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request on Rehearing of
Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Hewlett Packard Enterprise Co. ("Petitioner") filed a Request for Rehearing (Paper 13, "Req. Reh'g") of the Decision Denying Institution of *Inter Partes* Review (Paper 11, "Decision" or "Dec.") of claims 73, 106, 112, 134, 142, 145, and 146 ("the challenged claims") of U.S. Patent No. 8,902,760 B2 (Ex. 1004, "the '760 patent"). In the Request for Rehearing, Petitioner argues that we misapprehended 1) the impact of Petitioner's voluntary dismissal of its civil action challenging the validity of a claim of the '760 patent; and 2) the applicability of the Federal Circuit's decision in *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018) (en banc). Req. Reh'g 1. For the reasons set forth below, the Request for Rehearing is denied.

II. ANALYSIS

When considering a request for rehearing, the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing that the decision should be modified, and "[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked." 37 C.F.R. § 42.71(d)

In the Decision, we denied the Petition (Paper 2, "Pet.") under 35 U.S.C. § 315(a)(1), because Petitioner filed a civil action challenging the validity of a claim of the '760 patent before the date on which the Petition was filed. Dec. 2. We determined that § 315(a)(1) bars institution of an *inter partes* review even though Petitioner voluntarily dismissed its earlier civil action without prejudice. *Id.* at 8.

Petitioner argues that we "misapprehend[ed] the impact of a party's voluntary dismissal of a civil action" because "federal courts deem a civil

action dismissed without prejudice as 'something that *de jure* never existed.'" Req. Reh'g 3. Petitioner's argument is not persuasive. As the Federal Circuit explained in *Click-to-Call*, "[a] voluntary dismissal without prejudice only leaves the dismissed action without legal effect for *some* purposes; for many other purposes, the dismissed action continues to have legal effect." Dec. 7 (quoting *Click-to-Call*, 899 F.3d at 1335). Thus, we interpreted § 315(a)(1) based on the ordinary meaning of its language, rather than based on a background legal principle that is "anything but equivocal." Dec. 6–7 (quoting *Click-to-Call*, 899 F.3d at 1335).

Petitioner argues that we "misapprehended the applicability of *Click-to-Call*, however, because *Click-to-Call* dealt specifically with § 315(b) and its holding should not be extended to apply to § 315(a)(1)." Req. Reh'g 4. Specifically, Petitioner contends that § 315(b) focuses on the service of a complaint, which cannot be undone by a voluntary dismissal, whereas § 315(a)(1) focuses on the filing a civil action, which is nullified by a voluntary dismissal. *Id.* at 5–6. Petitioner's argument is not persuasive. We did not simply say that *Click-to-Call*'s holding extends to § 315(a)(1). Rather, just as *Click-to-Call* addressed the ordinary meaning of the phrase "served with a complaint" in § 315(b), we addressed the ordinary meaning of the phrase "filed a civil action" in § 315(a)(1). Dec. 6–7. We determined that the ordinary meaning of the phrase "filed a civil action" indicates that the § 315(a)(1) bar is implicated once a party commences a noncriminal litigation, irrespective of a subsequent dismissal without prejudice. *Id.*

Moreover, the Board's recently designated precedential decision in *Cisco Systems, Inc. v. Chrimar Systems, Inc.*, IPR2018-01511, Paper 11 at 8 (PTAB Jan. 31, 2019) (precedential), holds that § 315(a)(1) bars institution

of an *inter partes* review even when the petitioner voluntarily dismissed without prejudice its earlier civil action challenging the validity of a claim of the patent.

III. CONCLUSION

The Request for Rehearing does not demonstrate that the Decision misapprehended or overlooked any matters.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Request for Rehearing is *denied.*

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FOR PETITIONER:

Hersh H. Mehta
Brent A. Hawkins
Maria E. Doukas
MORGAN, LEWIS & BOCKIUS LLP
hersh.mehta@morganlewis.com
brent.hawkins@morganlewis.com
maria.doukas@morganlewis.com

FOR PATENT OWNER:

Frank A. Angileri
Thomas A. Lewry
Marc Lorelli
Christopher C. Smith
BROOKS KUSHMAN P.C.
fangileri@brookskushman.com
tlewry@brookskushman.com
mlorelli@brookskushman.com
csmith@brookskushman.com