

From: [Kattula, Amy](#)
To: [Kattula, Amy](#)
Subject: FW: IPR2019-01612 // USPN 7,589,642 // CARES Act Extension of Time Request (Joinder)
Date: Tuesday, May 5, 2020 12:37:53 PM
Attachments: [image001.png](#)

From: Pleune, Ben <Ben.Pleune@alston.com>
Sent: Monday, May 4, 2020 10:54 AM
To: Trials <Trials@USPTO.GOV>; Jon Wright <JWRIGHT@sternekessler.com>
Cc: Lestin Kenton <LKENTON@sternekessler.com>; Daniel Block <DBLOCK@sternekessler.com>; Timothy L. Tang <TTang@sternekessler.com>; Joel Greenberg <jgreenberg@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Koppelman, Ryan <Ryan.Koppelman@alston.com>; Davison, Tom <Tom.Davison@alston.com>; Abe, James <James.Abe@alston.com>; Bean, Caleb <Caleb.Bean@alston.com>; Neilson, Derek <Derek.Neilson@alston.com>; Tsui, Nick <Nick.Tsui@alston.com>
Subject: RE: IPR2019-01612 // USPN 7,589,642 // CARES Act Extension of Time Request (Joinder)

Dear Board,

Having considered the issues in more depth, and pursuant to the Board's email on May 1, Patent Owner opposes Petitioner's request for extension of time to move for joinder under 37 CFR § 42.122(b). While Patent Owner is sympathetic to the difficulties caused by COVID-19, Federal Circuit law remains that the IPR joinder provision 35 U.S.C. § 315(c) does not permit a petitioner to join its own previously instituted IPR and does not permit new claims or grounds to be added to an instituted IPR. *Facebook, Inc. v. Windy City Innovations, LLC*, 953 F.3d 1313, 1322 (Fed. Cir., Mar. 18, 2020). Petitioner is incorrect that the Supreme Court's decision in *Thryv, Inc. v. Click-to-Call Technologies, LP* "constructively abrogates the Federal Circuit's decision in *Facebook, Inc. v. Windy City Innovations, LLC*." Furthermore, Patent Owner does not believe that the criteria for Section I.(1)(b) are met or that Petitioner's request satisfies Section I.(3) of the CARES Act at least because Petitioner has not identified any situation that prevented or interfered with its ability to file an IPR that included all of the claims of the '642 patent or to file a timely motion for joinder.

In *Thryv, Inc. v. Click-to-Call Technologies, LP*, the Supreme Court held that "[t]o understand how far beyond §314(a) the bar on judicial review extends, we look to the statute and *Cuozzo*; for the reasons stated above, they establish that §314(d) bars challenges resting on §315(b)." 2020 U.S. LEXIS 2406, at *19-20 (2020). Thus, the Supreme Court's opinion in *Thryv* was limited to denials of institution and the time bar under §315(b). This does not extend to, nor does it have any relation to, the rules for joinder to an *already instituted* IPR under §315(c), which was the subject of the Federal Circuit's opinion in *Facebook, Inc. v. Windy City Innovations, LLC*. 953 F.3d at 1322 ("The clear and unambiguous text of § 315(c) does not authorize same-party joinder, and does not authorize the joinder of new issues."). Thus, there is simply no point to an extension of time to file a request that is expressly prohibited by controlling Federal Circuit law.

Nevertheless, even if *Thryv* did abrogate the Federal Circuit's controlling law, Patent Owner still does not agree that an extension of time is warranted. Petitioner has not provided any specific

explanation as to why COVID-19 prevented it from performing its work or who was “personally affected by the COVID-19 outbreak,” such that timely filing was not possible. CARES Act I.(1).(b). Rather, it appears that the real reason for Petitioner’s request is not related to COVID-19, but rather is directly responsive to litigation pending before the ITC. As Petitioner states in its email, “On April 16, Patent Owner filed an ITC complaint” and since then Petitioner “has not yet completed its petition or completed gathering supporting evidence it needs to support new grounds covering the 6 claims asserted in the ITC, but not currently challenged in the pending IPR2019-01612 on the ‘642 patent.” This is not an adequate reason for extension of time. A quick review of the facts and timeline demonstrates that Petitioner had every opportunity to challenge any claims of the ‘642 patent that it desired, and indeed Petitioner did not rely on the District Court infringement allegations but performed its own analysis of the claims and deliberately chose to challenge only a subset of those claims.

- On September 18, 2018, Patent Owner served a District Court complaint for patent infringement on Petitioner, including the 642 patent.
- On December 24, 2018, Patent Owner served infringement contentions in the District Court litigation, asserting, in relevant part, claims 1-6, 19, and 22-25 of the ‘642 patent.
- On March 14, 2019, the District Court granted Petitioner’s request that Patent Owner select a subset its list of asserted claims. However, the Court specifically stated that the selection was without prejudice (No. 8:18-cv-0158, Dkt. No. 64 at 7 (“UEI may ask the Court for leave to reassert unselected claims”); 3 (“UEI will have the opportunity to add additional claims upon showing that they present unique issues”)).
- On May 23, 2019, Patent Owner selected a subset the asserted claims of the ‘642 patent to claims 3, 6, 23, and 25 (No. 8:18-cv-0158, Dkt. No. 84 at 1).
- On September 18, 2019, Petitioner filed a petition for this *inter partes* review, challenging claims 1-4, 6, 8-9, and 22-25. Petitioner did not limit the challenged claims to those asserted in the District Court or to those left after claim selection. Petitioner deliberately selected a subset of claims that included those never asserted in the District Court (claims 8-9) and some that were already dropped in litigation (claims 1-2, 4-5, 22-24).
- On April 1, 2020, the Board instituted IPR of claims 1-4, 6, 8-9, and 22-25.
- On April 16, 2020, Patent Owner filed an ITC complaint against Petitioner, asserting claims 1-7, 12, 14, 19-20 and 22-25 of the ‘642 patent.
- On April 30, 2020 (1 day before the deadline), Petitioner emailed the Board (and Patent Owner for the first time) requesting a 30 day extension to address claims asserted in the ITC case but not challenged in the IPR.

As seen from the timeline above and facts therein, Petitioner had every opportunity to challenge any claim of the ‘642 patent and indeed took the full year after service to perform its own independent

analysis and ultimately selected claims regardless of whether they were asserted in litigation. Now, in light of pending ITC litigation, Petitioner seeks a “do over” on its claim selection and appears to use COVID-19 as a vehicle to facilitate its litigation strategy. This is not a sufficient reason for an extension to file a motion that will significantly derail the current IPR. Petitioner admits that it “has not yet completed its petition or completed gathering supporting evidence it needs to support new grounds.” Thus, it is clear that new grounds and new issues will be introduced, briefings will be significantly more complicated, and maintaining the existing schedule on the instituted IPR will be impossible. Patent Owner will be significantly prejudiced if it has to operate on an accelerated schedule, under the same COVID-19 conditions as Petitioner, but for no reason other than Petitioner waited over one year and seven months to challenge additional claims in the patent.

Alternatively, Petitioner argues that the abrogation of *Windy City* also warrants an extension request. First, as explained earlier, *Thryv* does not abrogate *Windy City*. Second, any such abrogation does not fall under the provisions of the CARES Act. And third, Petitioner cites to no authority that changes in the law warrant an extension of IPR deadlines.

For at least the reasons detailed above, Patent Owner opposes Petitioner request to file a motion for the extension of time.

Sincerely,
Ben Pleune

[S. Benjamin Pleune](mailto:ben.pleune@alston.com)
Alston & Bird
704.444.1098
ben.pleune@alston.com

From: Trials <Trials@USPTO.GOV>
Sent: Friday, May 1, 2020 11:01 AM
To: Pleune, Ben <Ben.Pleune@alston.com>; Jon Wright <JWRIGHT@sternekessler.com>; Trials <Trials@USPTO.GOV>
Cc: Lestin Kenton <LKENTON@sternekessler.com>; Daniel Block <DBLOCK@sternekessler.com>; Timothy L. Tang <TTang@sternekessler.com>; Joel Greenberg <jgreenberg@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Koppelman, Ryan <Ryan.Koppelman@alston.com>; Davison, Tom <Tom.Davison@alston.com>; Abe, James <James.Abe@alston.com>; Bean, Caleb <Caleb.Bean@alston.com>; Neilson, Derek <Derek.Neilson@alston.com>; Tsui, Nick <Nick.Tsui@alston.com>
Subject: RE: IPR2019-01612 // USPN 7,589,642 // CARES Act Extension of Time Request (Joinder)

EXTERNAL SENDER – Proceed with caution

Counsel,

The current deadline under 37 C.F.R. § 42.122(b) is tolled until May 5 so that Patent Owner may provide its position on Petitioner's request for an extension under the CARES Act. Patent Owner should provide its position by email to the Board no later than May 4. We note that the Office's Notice provides for "Situations Not Covered Above" in Section I(3) of the Notice, which may apply if the criteria for Section I(1)(b) are not met.

Regards,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571)272-7822

From: Pleune, Ben <Ben.Pleune@alston.com>
Sent: Thursday, April 30, 2020 4:29 PM
To: Jon Wright <JWRIGHT@sternekessler.com>; Trials <Trials@USPTO.GOV>
Cc: Lestin Kenton <LKENTON@sternekessler.com>; Daniel Block <DBLOCK@sternekessler.com>; Timothy L. Tang <TTang@sternekessler.com>; Joel Greenberg <jgreenberg@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Koppelman, Ryan <Ryan.Koppelman@alston.com>; Davison, Tom <Tom.Davison@alston.com>; Abe, James <James.Abe@alston.com>; Bean, Caleb <Caleb.Bean@alston.com>; Neilson, Derek <Derek.Neilson@alston.com>; Tsui, Nick <Nick.Tsui@alston.com>
Subject: RE: IPR2019-01612 // USPN 7,589,642 // CARES Act Extension of Time Request (Joinder)

Dear Board:

As Petitioner indicates in its email to the Board, Patent Owner was not previously made aware of this request and therefore has not been afforded an opportunity to consider these issues and provide its position. Based on a very preliminary review, it does not appear that Petitioner's request for a 30-day extension to file a motion for joinder is contemplated by provision 1(b) of the CARE Act Notice.

But Patent Owner is further considering all of the issues raised in Petitioner's correspondence and intends to provide a complete response, including its position on the request for an extension.

Sincerely,
Ben Pleune

[S. Benjamin Pleune](mailto:ben.pleune@alston.com)
Alston & Bird
704.444.1098
ben.pleune@alston.com

From: Jon Wright <JWRIGHT@sternekessler.com>
Sent: Thursday, April 30, 2020 3:38 PM

To: trials@uspto.gov

Cc: Jon Wright <JWRIGHT@sternekessler.com>; Lestin Kenton <LKENTON@sternekessler.com>; Daniel Block <DBLOCK@sternekessler.com>; Timothy L. Tang <TTang@sternekessler.com>; Joel Greenberg <jgreenberg@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Pleune, Ben <Ben.Pleune@alston.com>; Koppelman, Ryan <Ryan.Koppelman@alston.com>; Davison, Tom <Tom.Davison@alston.com>; Abe, James <James.Abe@alston.com>; Bean, Caleb <Caleb.Bean@alston.com>; Neilson, Derek <Derek.Neilson@alston.com>; Tsui, Nick <Nick.Tsui@alston.com>

Subject: RE: IPR2019-01612 // USPN 7,589,642 // CARES Act Extension of Time Request (Joinder)

EXTERNAL SENDER – Proceed with caution

RE: Extension of time under CARES Act to move for joinder under 37 CFR Sec. 42.122(b) in **IPR2019-01612** involving USPN 7,589,642 to Mui *et al.*

Dear Board:

Petitioner seeks an extension of **30-days** in which to file a motion for joinder in IPR2019-01612 under 37 CFR Sec. 42.122(b). The extension is sought under the USPTO's Notice of Waiver of Patent-Related Timing Deadlines under the CARES Act (the CARE Act Notice), Provision (1)(b) or "PTAB Situations Not Covered Above," and for other reasons as set forth below. The facts below constitute good cause for the requested extension:

1. *On April 1, 2020*, the Board instituted trial in IPR2019-01612. Thus, under 37 C.F.R. § 42.122(b), any request for joinder must be filed as a motion no later than one month after the institution date, i.e., **May 1, 2020**,
2. *On April 16*, Patent Owner filed an ITC complaint under 19 U.S.C. Sec. 1337 against Petitioner asserting (among others) 4 claims not previously asserted in the parallel district court proceeding, plus 2 claims that were originally asserted but then dropped by Patent Owner when it reduced the number of asserted claims. The pending IPR on the '642 patent does not challenge these 6 claims, two of which are independent claims. Petitioner is now past the one-year statutory bar set forth in Sec. 315(b).
3. *On April 20*, in *Thryv, Inc. v. Click-to-Call Technologies, LP* the Supreme Court held that the Federal Circuit lacks appellate jurisdiction to review issues that are "closely tied to the application and interpretation of statutes related to" the institution decision. In *Thryv*, the issue was the one-year time bar under Sec. 315(b). The Supreme Court's decision in *Thryv* thus constructively abrogates the Federal Circuit's decision in *Facebook, Inc. v. Windy City Innovations, LLC.*, where the Federal Circuit vacated the portion of the Board's precedential decision in *Proppant Express* allowing a party to join itself in an IPR proceeding outside of the one-year time-bar of Sec. 315(b). Since the Federal Circuit was not permitted to review the issue it decided in *Windy City*, the PTAB is not bound to follow *Windy City*, and the Board's precedential decision in *Proppant Express* should continue to control whether joinder is available to petitioners outside the one-year bar. These facts constitute a recent and material change in the law related to joinder.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.