No. 18A485

In the Supreme Court of the United States

DEXMEDIA, INC., Applicant,

v.

CLICK-TO-CALL TECHNOLOGIES, INC., AND ANDREI IANCU, DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, Respondents.

SECOND APPLICATION FOR EXTENSION OF TIME TO FILE A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

To the Honorable John G. Roberts, Jr., Chief Justice and Circuit Justice for the Federal Circuit:

Applicant DexMedia, Inc.,[1] respectfully requests that the time to file a petition for a writ of certiorari in this case be extended for an additional 28 days, to and including January 11, 2019. The United States Court of Appeals for the Federal Circuit issued its opinion on August 16, 2018. (App. A.[2]) No petition for rehearing was filed. The petition was initially due on November 14, 2018, but on November 7, 2018, your Honor granted petitioner's first application to extend the due date by 30 days to December 14, 2018. Applicant files this application more than 10 days

[1] The initial parties to the appeal below were Ingenio, Inc., and YellowPages.com, LLC. Subsequently, Ingenio, Inc., was merged into YellowPages.com, LLC, and then YellowPages.com, LLC, was merged into Applicant DexMedia, Inc. No publicly held company owns 10 percent or more of DexMedia, Inc.

[2] The cited appendices are attached to applicant's initial application for an extension of time.

before December 14, 2018. S. Ct. R. 13.5. This Court will have jurisdiction pursuant to 28 U.S.C. § 1254(1).

Background

A. In 2001, the named inventor of U.S. Patent No. 5,818,836 (the "Patent") granted Inforocket.com, Inc., an exclusive license to the Patent. Shortly thereafter, Inforocket filed an action against Keen, Inc. asserting infringement of the Patent, and then Keen replied by filing its own patent suit against Inforocket. In 2003, Inforocket and Keen merged and, accordingly, they dismissed each of the two lawsuits without prejudice.

During the time of the litigation and ultimate merger between Inforocket and Keen, Applicant DexMedia, Inc., had no relationship with either company. Subsequently, however, through a series of intermediate name changes and corporate transactions, Keen became Ingenio, Inc., which later became an affiliate of YellowPages.com, LLC. Subsequently, Ingenio merged into YellowPages.com, which in turn merged into Applicant DexMedia, Inc.

B. In May 2012, respondent Click-to-Call Technologies LP ("CTC") filed an action for infringement of the Patent against Ingenio and YellowPages.com (and others). Less than a year later, in May 2013, those entities filed a petition for inter partes review ("IPR") in the United States Patent and Trademark Office, challenging 17 claims of the Patent. CTC sought dismissal of the IPR based on 35 U.S.C. § 315(b), which provides: "An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which

the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent." CTC contended that InfoRocket's infringement action against Keen triggered this § 315(b) bar, even though the complaint was subsequently dismissed without prejudice.

The Patent Trial and Appeal Board ("PTAB") instituted an IPR notwithstanding § 315(b). The PTAB reasoned that "[t]he Federal Circuit consistently has interpreted the effect of … dismissals [without prejudice] as leaving the parties as though the action had never been brought." (App. A, at 6.) After the administrative trial, the PTAB's final written decision invalidated 13 claims of the Patent. (*Id.* at 7–8.)

The case then underwent a somewhat complicated appellate process, the details of which are not germane for purposes of this application. (*Id.* at 8–9.) The Federal Circuit ultimately made two rulings that will be challenged in Applicant's forthcoming petition.

First, the Federal Circuit initially dismissed the appeal for lack of jurisdiction under 35 U.S.C. § 314(d), which provides: "The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable." After dismissal of the appeal in this case, the Federal Circuit issued a divided *en banc* decision in *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018), which held—over four dissenting votes—that the PTAB's § 315(b) determinations were appealable under *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016). The panel in this case, on the basis of *Wi-Fi One*, then

granted rehearing, vacated the prior dismissal of the appeal, and ordered supplemental briefing. (App. B.)

Second, on rehearing, the Federal Circuit, again ruling *en banc*, held—over two dissenting votes—that a complaint that was dismissed without prejudice would still trigger the time bar in § 315(b). (App. A, at 10 n.3.) The Federal Circuit majority declined to follow precedent from that court—and the other circuits—holding that a dismissal without prejudice of a complaint leaves the parties as if no action had ever been filed. (*Id.* at 53–65 (Dyk, J., dissenting).) The court therefore vacated the PTAB's final written decision invalidating the patent and remanded with instructions to dismiss the IPR.

Reasons for Granting an Extension of Time

The time to file a petition for a writ of certiorari should be extended for an additional 28 days for the following reasons:

1. Since being retained, the undersigned counsel of record has worked diligently to prepare the petition in this case. Nonetheless, the petition will raise two complex issues that have divided the Federal Circuit sitting *en banc*, so additional time is necessary to study the record below and the legal issues in the case and to prepare a petition. Moreover, counsel has had time-sensitive filings in other cases during this period, including in multiple appellate courts and a federal district court.

2. No prejudice would arise from the requested extension. The underlying IPR proceeding that is the subject of this appeal was filed by Applicant's

predecessors, Ingenio and YellowPages.com. The Federal Circuit's decision requires that the PTAB dismiss this IPR proceeding. Respondent CTC will not be harmed, in the event that this Court denies the petition, if this PTAB dismissal of the IPR is further delayed.

3. There is a reasonable prospect that this Court will grant the petition. The Federal Circuit below made two legal determinations: (1) that a PTAB decision to institute an IPR based on the determination that the § 315(b) time bar did not apply is appealable after a final decision, notwithstanding the text of § 314(d) and this Court's decision in *Cuozzo*; and (2) that a complaint for infringement filed more than one year before the filing of the IPR triggers the §315(b) time bar, even if the complaint was dismissed without prejudice. The Federal Circuit made both of these determinations *en banc*, and the court was divided as to both: 9–4 and 10–2, respectively. In light of the practical importance of both issues and the division within the Federal Circuit, it is certainly possible that this Court will grant the petition.

Conclusion

For these reasons, the time to file a petition for a writ of certiorari should be extended an additional 28 days to and including January 11, 2019.

Respectfully submitted,

/s/ *Adam H. Charnes*

ADAM H. CHARNES
Counsel of Record
KILPATRICK TOWNSEND & STOCKTON LLP
2001 Ross Avenue
Suite 4400
Dallas, TX 75201
(214) 922-7106
acharnes@kilpatricktownsend.com

Counsel for Applicant DexMedia, Inc.

November 19, 2018