

No. \_\_\_\_\_

IN THE

**Supreme Court of the United States**

DEX MEDIA, INC.,

*Petitioner,*

v.

CLICK-TO-CALL TECHNOLOGIES, LP,

AND

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR  
INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED  
STATES PATENT AND TRADEMARK OFFICE,

*Respondents.*

**On Petition for a Writ of Certiorari to the United  
States Court of Appeals for the Federal Circuit**

**PETITION FOR A WRIT OF CERTIORARI**

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## QUESTIONS PRESENTED

The America Invents Act created “inter partes review” (“IPR”), an agency procedure for challenging a patent before the Patent Trial and Appeal Board (“PTAB”). The statute has two provisions relevant here, each of which was interpreted by a divided Federal Circuit sitting *en banc*. First, 35 U.S.C. § 315(b) provides that “[a]n 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 ... is served with a complaint alleging infringement of the patent.” Second, § 314(d) provides that “[t]he determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.”

In a recent case, the *en banc* Federal Circuit held (with four dissenters) that, notwithstanding § 314(d), a PTAB decision to institute an IPR after finding that the § 315(b) time bar did not apply was appealable. The panel applied that ruling in this case. Then, the *en banc* Federal Circuit, again divided (with two dissenters), held in this case that service of a patent infringement complaint that is later dismissed without prejudice triggers the § 315(b) time bar.

The questions presented are:

1. Whether 35 U.S.C. § 314(d) permits appeal of the PTAB’s decision to institute an inter partes review upon finding that § 315(b)’s time bar did not apply.
2. Whether 35 U.S.C. § 315(b) bars institution of an inter partes review when the previously served patent infringement complaint, filed more than one year before the IPR petition, had been dismissed without prejudice.

### **PARTIES TO THE PROCEEDINGS**

YellowPages.com, LLC, and Ingenio, Inc., were appellees below. YellowPages.com, LLC, and Ingenio, LLC, were petitioners before the Patent Trial and Appeal Board (“PTAB”). Ingenio, Inc., was renamed Ingenio, LLC, and then was merged into YellowPages.com, LLC; YellowPages.com, LLC, was then merged into petitioner Dex Media, Inc.

Respondent Click-to-Call Technologies, LP, was an appellant below and a respondent before the PTAB.

Respondent Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, was an intervenor in the Court of Appeals.

Oracle Corporation and Oracle OTC Subsidiary LLC were initially appellees below and were petitioners before the PTAB. While the appeal was pending, the Federal Circuit granted their unopposed motion to withdraw from further participation in the appeal, upon their settlement of the case. Pursuant to Rule 12.6, petitioner believes that Oracle Corporation and Oracle OTC Subsidiary LLC have no interest in the outcome of this petition.

**RULE 29.6 DISCLOSURE STATEMENT**

Petitioner Dex Media, Inc., is wholly owned by Dex Media Holdings, Inc. Dex Media Holdings, Inc., has no parent corporations and no publicly held company owns 10% or more of its stock.

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## **PETITION FOR A WRIT OF CERTIORARI**

Petitioner respectfully requests a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

### **OPINIONS BELOW**

The November 12, 2015, opinion of the United States Court of Appeals for the Federal Circuit, initially dismissing the appeal for lack of jurisdiction, is unpublished but reported at 622 F. App'x 907 and is reprinted in the Appendix to the Petition ("App.") at App. 1a–5a. The November 17, 2016, opinion of the Federal Circuit, again dismissing the appeal for lack of jurisdiction, is unpublished but available at 2016 WL 6803054 and is reprinted at App. 6a–28a. The January 19, 2018, order of the Federal Circuit, granting rehearing, is unpublished but reported at 710 F. App'x 447 and is reprinted at App. 29a–32a. The August 16, 2018, opinion of the Federal Circuit is published at 899 F.3d 1321 and is reprinted at App. 33a–106a.

The final written decision of the Patent Trial and Appeal Board ("PTAB") is reprinted at App. 107a–138a. The PTAB's decision to institute inter partes review is reprinted at App. 144a–176a, and its denial of rehearing of that decision is reprinted at App. 139a–143a.

### **JURISDICTION**

The judgment of the United States Court of Appeals for the Federal Circuit was entered on August 16, 2018. App. 33a. No petition for rehearing was filed. On November 7, 2018, the Chief Justice granted petitioner an extension of time to file this petition until December 14, 2018. No. 18A485. On November

20, 2018, the Chief Justice granted a further extension until January 11, 2019. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

### **STATUTORY PROVISIONS INVOLVED**

35 U.S.C. § 314 provides, in relevant part:

(a) Threshold.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

...

(d) No Appeal.—The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

35 U.S.C. § 315(b) provides, in relevant part:

(b) Patent Owner's Action.—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.

### **STATEMENT OF THE CASE**

#### **A. The America Invents Act**

In 2011, Congress enacted the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284 (2011). With the AIA, Congress intended to

provide a “quick and cost effective alternative[ ] to litigation” and to “improve patent quality and restore confidence in the presumption of validity that comes with issued patents in court.” H.R. Rep. No. 112-98, pt. 1, at 45, 48 (2011). The AIA replaced the former system of inter partes reexamination with a new adjudicatory proceeding called inter partes review (“IPR”). *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2137 (2016). IPR is “a second look at an earlier administrative grant of a patent.” *Id.* at 2144. The AIA created, within the Patent and Trademark Office (“PTO”), the Patent Trial and Appeal Board (“PTAB” or “Board”), which “conducts the proceedings, reaches a conclusion, and sets forth its reasons.” *Id.*

The AIA established a two-step process for IPR proceedings. *First*, “[a]ny person other than the patent owner can file a petition for inter partes review.” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1371 (2018); *see* 35 U.S.C. § 311(a). The AIA requires the petition to identify “the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” *Id.* § 312(a)(3). The patentee then has “the right to file a preliminary response to the petition” containing “reasons why no inter partes review should be instituted based upon the failure of the petition to meet any requirement of this chapter.” *Id.* § 313.

The PTAB, acting on behalf of the Director of the PTO, *see* 37 C.F.R. § 42.4(a), determines whether to “institute” an IPR. *See* 35 U.S.C. § 314(a). The PTAB may institute an IPR if it concludes that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims

challenged in the petition.” *Id.* “The decision whether to institute inter partes review is committed to the Director’s discretion.” *Oil States*, 138 S. Ct. at 1371. The AIA, however, imposes a limitation on such discretion if there had been prior litigation in court over the patent:

“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.”

35 U.S.C. § 315(b).

*Second*, if the PTAB institutes an IPR, the Board conducts a trial to determine if any of the challenged patent claims should be cancelled. *See Oil States*, 138 S. Ct. at 1371–72. The trial process includes “many of the usual trappings of litigation,” as “[t]he parties conduct discovery and join issue in briefing and at an oral hearing.” *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018). The PTAB must “issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added” by amendment. 35 U.S.C. § 318(a).

Any party “who is dissatisfied with the final written decision of the Patent Trial and Appeal Board ... may appeal the Board’s decision” to the Federal Circuit. *Id.* § 141(c); *see also id.* § 319. But Congress limited the ability of the patent owner to appeal the PTAB’s decision to institute an IPR in the first place: “The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.” *Id.* § 314(d).



## **B. The Patent Infringement Cases**

In 2001, Inforocket.Com, Inc.—which had been granted an exclusive license by the inventor—sued Keen, Inc., for infringement of U.S. Patent No. 5,818,836 (the “836 Patent”). Shortly thereafter, Keen sued Inforocket on patents of its own. App. 36a. In 2003, Keen acquired Inforocket and, as part of the merger, the parties voluntarily dismissed both actions—including the litigation involving the ’836 Patent—without prejudice. Keen then changed its name to Ingenio, Inc. *Id.*

Respondent Click-to-Call Technologies, LP (“CTC”), acquired the ’836 Patent in 2011 and, in May 2012, filed complaints asserting infringement of that patent against multiple parties in the Western District of Texas. App. 37a. One of those actions accused AT&T, Inc., Ingenio, Inc., and YellowPages.com, LLC, of infringing the ’836 Patent. *Id.* The litigation was stayed pending resolution of the IPR proceedings described below. *Id.*

Before and during these proceedings, Ingenio, Inc., underwent a series of mergers, sales, and name changes. The upshot is that Ingenio, Inc., was ultimately merged into YellowPages.com, LLC, which in turn was merged into Dex Media, Inc., which is now the petitioner in this case.

## **C. The IPR Proceedings Before The PTAB**

On May 28, 2013, Ingenio, LLC (one of the interim entities in Ingenio’s corporate history), YellowPages.com, Oracle Corp., and Oracle OTC Subsidiary LLC filed a single IPR petition challenging the ’836 Patent on grounds of anticipation and obviousness. App. 37a–38a. In response, CTC

contended that the IPR was time-barred under 35 U.S.C. § 315(b) because Ingenio had been served with a complaint alleging infringement of the '836 Patent in 2001, in the form of the lawsuit against Keen. App. 38a–39a.

After supplemental briefing, the Board rejected CTC's time-bar challenge, finding that the 2001 complaint against Keen did not bar Ingenio's IPR petition. App. 161a. Specifically, the Board noted that "[t]he Federal Circuit consistently has interpreted the effect of [voluntary dismissals without prejudice] as leaving the parties as though the action had never been brought." *Id.* at 161a–162a. Therefore, the PTAB reasoned, "the dismissal of the infringement suit brought by Inforocket against Keen—now Ingenio, LLC—nullifies the effect of the service of the complaint and, as a consequence, does not bar Ingenio, LLC or any of the other Petitioners from pursuing an *inter partes* review of the '836 patent."<sup>1</sup> *Id.* at 162a. The PTAB then concluded that "there is a reasonable likelihood" that the petitioners could show that 13 identified claims of the '836 Patent were unpatentable, and it therefore instituted *inter partes* review as to those claims. *Id.* at 173a–174a.

CTC requested rehearing on the time-bar issue. The PTAB denied rehearing, concluding that it did not abuse its discretion in its prior determination that

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<sup>1</sup> The PTAB had asked for supplemental briefing on two additional issues: whether § 315(b)'s time bar applied on a petitioner-by-petitioner basis (such that, even if the statute barred Ingenio's petition, the other petitioners could still prosecute the IPR), and whether—in light of the reexamination of the patent in 2004—the same patent was at issue in both the previous infringement action and this IPR petition. App. 162a.

§ 315(b) did not bar the IPR proceeding. App. 139a–143a.

On October 28, 2014, the PTAB issued a Final Written Decision. App. 107a–138a. The PTAB held that 13 specified claims were either anticipated or obvious and therefore were unpatentable. *Id.* at 138a.

#### **D. The Federal Circuit Appeals**

CTC appealed the PTAB’s decision, only “seek[ing] review of the Board’s initial decision to institute IPR.” App. 2a. That appeal followed a circuitous path.

1. Initially, on November 12, 2015, the Federal Circuit dismissed CTC’s appeal for lack of appellate jurisdiction under 35 U.S.C. § 314(d). The court relied (App. 2a–5a) on its then-recent decision in *Achates Reference Publishing, Inc. v. Apple Inc.*, 803 F.3d 652 (Fed. Cir. 2015), which held that “35 U.S.C. § 314(d) prohibits this court from reviewing the Board’s determination to initiate IPR proceedings based on its assessment of the time-bar of § 315(b).” 803 F.3d at 658.

CTC then filed a petition for a writ of certiorari with this Court. On June 27, 2016, this Court granted the petition, vacated the judgment, and remanded for further consideration in light of *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016). *See* 136 S. Ct. 2508 (2016).

On remand, and after supplemental briefing on the impact of *Cuozzo*, the Federal Circuit again dismissed the appeal on November 17, 2016. The court relied on its then-recent decision in *Wi-Fi One, LLC v. Broadcom Corp.*, 837 F.3d 1329 (Fed. Cir. 2016). As explained by the court in this case, the *Wi-Fi One* panel held that “*Cuozzo* did not overrule our previous

decision in *Achates* and that later panels of the court remain bound by *Achates*.” App. 9a.

2. CTC then filed a petition for *en banc* rehearing, arguing that *Achates* and *Wi-Fi One* should be overruled. Less than a month later, the Federal Circuit granted rehearing *en banc* in the *Wi-Fi One* case. Indicating the importance of the question whether § 315(b) time-bar determinations are appealable, twelve *amicus* briefs were filed in the *Wi-Fi One en banc* case, all but two asking the court to permit appeals of time-bar determinations.

On January 8, 2018, the Federal Circuit issued a sharply divided *en banc* decision in *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018) (*en banc*). The *en banc* court expressly overruled *Achates* and held that time-bar determinations under § 315(b) are appealable. Judge Reyna, writing for the *en banc* majority, relied on “the ‘strong presumption’ favoring judicial review of administrative actions, including the Director’s IPR institution decisions.” *Id.* at 1371. The majority found “no clear and convincing indication in the specific statutory language in the AIA, the specific legislative history of the AIA, or the statutory scheme as a whole that demonstrates Congress’s intent to bar judicial review of § 315(b) time-bar determinations.” *Id.* at 1372. Further, the majority concluded that “[t]he time-bar determination ... is not akin to either the non-initiation or preliminary-only merits determinations for which unreviewability is common in the law.” *Id.* at 1373. Moreover, the majority opined that unreviewability is “limited to the Director’s determinations closely related to the preliminary patentability determination or the exercise of discretion not to

institute,” and “[w]hether a petition has complied with § 315(b) is not such a determination.” *Id.*

Judge O’Malley concurred and wrote a separate opinion. In her view, § 314(d)’s “bar on appellate review” is limited to decisions regarding “the substantive adequacy of a timely filed petition.” *Id.* at 1376 (O’Malley, J., concurring). Because “the time bar has nothing to do with the substantive adequacy of the petition,” she opined, the prohibition of appellate review is inapplicable. *Id.*

Judge Hughes, joined by Judges Lourie, Bryson, and Dyk, dissented. The dissenters contended that the majority opinion “not only contradicts the statutory language, but is also contrary to the Supreme Court’s construction of that language in *Cuozzo*.” *Id.* at 1377 (Hughes, J., dissenting). “Congress’s intent to prohibit judicial review of the Board’s IPR institution decision is clear and unmistakable,” the dissent explained. *Id.* at 1378. “The statute *calls out* a specific agency determination, and expressly *prohibits* courts from reviewing that decision.” *Id.* (emphasis in the original). Moreover, the dissenters pointed out that, under *Cuozzo*, § 314(d) applies to “‘questions that are closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.’” *Id.* at 1378 (quoting *Cuozzo*, 136 S. Ct. at 2141). As they explained, “timeliness under § 315(b) is plainly a question ‘closely tied’ to the Director’s decision to institute. Indeed, it is a specific requirement for ‘institution.’” *Id.*

3. On January 19, 2018, the Federal Circuit issued an order construing CTC’s petition for rehearing *en banc* as petition for panel rehearing, and granted it. It

vacated its prior dismissal of the appeal in light of the *en banc* decision in *Wi-Fi One*, and ordered supplemental briefing on the Board’s compliance with § 315(b). App. 30a–31a

4. Upon rehearing, the Federal Circuit issued an *en banc* ruling—over two dissenting votes—which held that the time bar of § 315(b) was triggered by service of *any* complaint, even if that complaint was later dismissed without prejudice.<sup>2</sup> App. 43a n.3.

In an opinion by Judge O’Malley, the majority held that the statute was clear and unambiguous. Quoting dictionary definitions of “serve” and “complaint,” the majority concluded that “the plain meaning of the phrase ‘served with a complaint’ is ‘presented with a complaint’ or ‘delivered a complaint’ in a manner prescribed by law.” App. 47a–48a. “The statute does not contain any exceptions or exemptions for complaints served in civil actions that are subsequently dismissed, with or without prejudice.” *Id.* at 47a. Thus, the majority held that the § 315(b) time bar is triggered whenever a party is officially served with a complaint, “irrespective of subsequent events.” *Id.* The majority dismissed the Federal Circuit’s precedent treating complaints dismissed without prejudice as though they had never been brought; “[a] voluntary dismissal without prejudice only leaves the dismissed action without legal effect for *some* purposes,” and the majority found this principle inapplicable to § 315(b). *Id.* at 59a (emphasis

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<sup>2</sup> The panel (but not the *en banc* court) also rejected petitioners’ two additional arguments (*see* note 1, *supra*) that the IPR was properly instituted. App. 60a–71a. Petitioner does not seek review of those issues, and they are not addressed here.

in the original). Accordingly, the court vacated the PTAB's final written decision and remanded with instructions for the Board to dismiss the IPR. *Id.* at 73a.

Judge Taranto concurred. Because he found that “the background law on the nullification effect of a voluntary, without-prejudice dismissal is a mixed bag,” he saw “no basis ... for overriding the plain meaning of § 315(b).” App. 86a.

Judge Dyk, joined by Judge Lourie, dissented. The dissenters explained that “the meaning of ‘service of a complaint’ is not on its face unambiguous,” because “[i]n closely comparable circumstances, the Supreme Court has held that it is necessary to look beyond the language, to the context and purpose of the statute.” App. 94a. Further, the dissenters found “a well-established background principle” that “voluntary dismissals without prejudice ... restor[e] the parties to the situation that existed before the case had ever been brought.” *Id.* at 95a. This rule, they noted, applies “in the closely comparable situation where a complaint dismissed without prejudice is held not to toll the statute of limitations, absent some evidence of a contrary legislative intent.” *Id.* at 98a. The dissenters noted that the majority was able to find only two narrow exceptions to this rule: a dismissal without prejudice does not bar an award of costs as a sanction for a frivolous lawsuit, nor does it eliminate the controversy established by the original filing for purposes of determining declaratory judgment jurisdiction. *Id.* at 99a. The dissenters went on to note that neither of these exceptions implicated the *legal effect* of the dismissed filing. *Id.*

The dissenters opined that there was no clear legislative intent to deviate from the normal treatment of complaints dismissed without prejudice. App. 103a. Additionally, they believed that dismissals without prejudice would not implicate the purpose of the time-bar statute, which is to prevent the filing of IPRs once the district court action had already consumed the time and attention of the court and the parties. *Id.* at 103a–105a. Finally, the dissenters raised concerns regarding potential abuses and manipulation by patentee plaintiffs. App. 105a–106a.

### **REASONS FOR GRANTING THE PETITION**

This case involves two important questions under the AIA: whether § 314(d) permits an appeal of the PTAB’s time-bar determination under § 315(b), and whether a prior patent infringement complaint that was dismissed without prejudice triggers the one-year time bar in § 315(b). The Federal Circuit recognized the importance of both questions by resolving them *en banc*. And the *en banc* Federal Circuit was divided on both questions. This Court has repeatedly granted review in patent cases in light of similar divisions in the Federal Circuit. *See, e.g., SAS Inst.*, 138 S. Ct. at 1354; *Cuozzo*, 136 S. Ct. at 2139; *Commil USA, LLC v. Cisco Sys., Inc.*, 135 S. Ct. 1920, 1925 (2015); *Highmark Inc. v. Allcare Health Mgmt. Sys., Inc.*, 134 S. Ct. 1744, 1748 (2014). This case, moreover, is an ideal vehicle for addressing both questions. The Court should therefore grant this petition.



**I. THIS COURT SHOULD REVIEW THE FEDERAL CIRCUIT'S *EN BANC* DECISION THAT IT HAS JURISDICTION TO REVIEW THE PTAB'S INSTITUTION DECISION TO THE EXTENT OF THE SECTION 315(b) TIME-BAR HOLDING.**

**A. The Federal Circuit, In Applying The Majority *En Banc* Opinion From *Wi-Fi One*, Contravened *Cuozzo* And The Plain Text Of The AIA.**

As the *Wi-Fi One en banc* dissent indicated, the *en banc* majority's "narrow reading" of § 314(d) "not only contradicts the statutory language, but is also contrary to the Supreme Court's construction of that language in *Cuozzo*." 878 F.3d at 1377 (Hughes, J., dissenting).

1. The plain language of § 314(d), read in the context of the statute as a whole, refutes the Federal Circuit's holding. As Judge Hughes explained in his *Wi-Fi One* dissent, the presumption that Congress intends judicial review of administrative action "is not insurmountable." *Id.* at 1378. In the AIA, "Congress's intent to prohibit judicial review of the Board's IPR institution is clear and unmistakable. ... The statute *calls out* a specific agency determination, and expressly *prohibits* courts from reviewing that decision." *Id.* (emphasis in the original). Indeed, not only did Congress direct that "[t]he determination ... whether to institute an inter partes review ... shall be final and nonappealable," 35 U.S.C. § 314(d), but Congress affirmatively authorized judicial review only of "the *final written decision* ... under section 318(a)." *Id.* § 141(c) (emphasis added). Read together, Congress's intent to bar review of any determinations

made as part of the decision whether to institute is crystal clear. As Judge Hughes' dissent indicated, § 314(d)'s "language is absolute and provides no exceptions." *Wi-Fi One*, 878 F.3d at 1380.

Further, § 314(d) bars appeals of a "determination ... whether to institute an inter partes review under this section." That very "determination" is what the Federal Circuit allowed CTC to appeal. Section 314(a) provides that the institution decision turns on "the information presented in the petition filed under section 311 and any response filed under section 313." Section 313 expressly allows the patent owner to argue "the failure of the petition to meet any requirement of *this chapter*." CTC raised its argument about the § 315(b) time bar in its preliminary response filed pursuant to § 313. The PTAB adjudicated that argument in its initial decision made "under this section [§ 314]." In other words, the § 314 institution decision is made on the basis of, *inter alia*, the patent owner's response, which the statute expressly says can raise arguments available under that chapter of the Patent Act, which includes § 315(b).

2. In addition to running roughshod over the statute's plain language, the *Wi-Fi One en banc* majority also "sidestep[ped] ... binding precedent"—namely, this Court's decision in *Cuozzo*. 878 F.3d at 1379 (Hughes, J., dissenting).

In *Cuozzo*, the patent owner contended that the PTAB had erred in instituting the IPR because the petition had not (as required by the AIA) identified "with particularity" all of the claims on which the Board ultimately instituted review. This Court held that the institution decision was not reviewable on

appeal. “For one thing,” this Court explained, “that is what § 314(d) says.” 136 S. Ct. at 2139. “For another,” the Court continued, the patent owner presented only “an ordinary dispute about the application of certain relevant patent statutes concerning the Patent Office’s decision to institute inter partes review.” *Id.* As Congress intended the AIA to promote patent quality, *id.*, the Court opined: “We doubt that Congress would have granted the Patent Office this authority ... if it had thought that the agency’s final decision could be unwound after some minor statutory technicality related to its preliminary decision to institute inter partes review,” *id.* at 2140.

The Court explained that its holding “applies where the grounds for attacking the decision to institute inter partes review consist of questions that are closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.” *Id.* at 2141. The Court declined to address “the precise effect of § 314(d) on appeals that implicate constitutional questions, that depend on less closely related statutes, or that present other questions of interpretation that reach, in terms of scope and impact, well beyond ‘this section.’” *Id.* The Court also recognized a narrow exception allowing review when “there is a due process problem” or the PTAB “act[ed] outside of its statutory limits,” noting that “[s]uch ‘shenanigans’ may properly be reviewable.” *Id.* at 2141–42.

The § 315(b) time-bar question is “closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.” *Id.* at 2141. Section 315(b) *precisely* addresses the initiation question; it directs when “[a]n

inter partes review *may not be instituted*.” Indeed, the provision has nothing to do with substantive patentability, only with whether the IPR “may not be instituted.” As Judge Hughes emphasized, § 315(b) “is a specific requirement for ‘institution.’” *Wi-Fi One*, 878 F.3d at 1378 (dissenting opinion).

If this Court’s intention in *Cuozzo* remained in doubt, it would be resolved by Justice Alito’s dissent in that case. While he disagreed with the result, he acknowledged the implication of the Court’s holding for the § 315(b) time bar: “the petition’s timeliness, no less than the particularity of its allegations, is ‘closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate ... review,’ and the Court says that such questions are unreviewable.” *Cuozzo*, 136 S. Ct. at 2155 (Alito, J., dissenting) (ellipsis in the original). The Court never questioned the accuracy of Justice Alito’s reading of the majority opinion.

In short, *Cuozzo* recognized a narrow exception to the non-appealability of institution decisions in the event of the Board’s “shenanigans.” The *en banc* Federal Circuit used this narrow exception to undercut Congress’s policy determination that institution decisions cannot be appealed.

**B. The Federal Circuit’s *Wi-Fi One En Banc* Holding Undermines A Critical Element Of The Statutory Scheme.**

Congress added the IPR procedure to the patent laws in order to provide a “quick and cost effective alternative[ ] to litigation” and to “improve patent quality and restore confidence in the presumption of validity that comes with issued patents in court.” H.R.

Rep. No. 112-98, pt. 1, at 45, 48 (2011). Congress specifically intended IPRs to result in faster adjudication than either patent litigation in federal court or the previous mechanism of inter partes reexamination. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (an AIA co-sponsor explaining that Congress intended IPRs to “substantially accelerate the resolution of inter partes cases”).

Several provisions of the AIA work together to ensure the efficiency and speed of the IPR process. At the outset, Congress heightened the standard to initiate the administrative proceeding from that applicable in reexaminations. While a “substantial new question of patentability affecting any claim” was sufficient to trigger a reexamination, *see Oil States*, 138 S. Ct. at 1371, the AIA allows institution of an IPR only when “there is a reasonable likelihood that the petitioner would prevail” as to at least one claim, *see* 35 U.S.C. § 314(a). Second, the AIA imposes a strict time limit on the IPR process. *Id.* §§ 316(a)(11), 318(a) (one-year time limit that can be extended up to six months for good cause). And while a party dissatisfied with the PTAB’s decision can appeal to the Federal Circuit, it *cannot* appeal the Board’s decision to institute the IPR in the first place. *Id.* § 314(d). After the parties expended considerable effort and expense to litigate the IPR, Congress did not want “the agency’s final decision [to] be unwound under some minor statutory technicality related to its preliminary decision to institute inter partes review.” *Cuozzo*, 136 S. Ct. at 2140.

The Federal Circuit’s *Wi-Fi One en banc* decision undermines the final described mechanism through

which Congress intended to ensure the efficiency of the IPR process. Directly contrary to Congress’s intent, as this Court recognized in *Cuozzo*, *Wi-Fi One* allows appeal of the preliminary decision to institute the IPR—and the prospect that the Federal Circuit, after a year or more of litigation, will undo an express finding that one or more claims in a patent are unpatentable. “Vacating the Board’s invalidity decision on the basis of threshold questions like timeliness or real parties in interest will squander the time and resources spent adjudicating the actual merits of the petition.” *Wi-Fi One*, 878 F.3d at 1382 (Hughes, J., dissenting). Not only is this result inefficient, but it harms the public interest by permitting the patent owner to continue to enforce an invalid patent, at least until costly and time-consuming litigation in federal court concludes. See *Lear, Inc. v. Adkins*, 395 U.S. 653, 674 (1969); *Pope Mfg. Co. v. Gormully*, 144 U.S. 224, 234 (1892). This is an outcome that Congress intended to prevent. See 157 Cong. Rec. S5409 (daily ed. Sept. 8, 2011) (statement of Sen. Schumer) (Congress intended IPRs to “ensure that the poor-quality patents can be weeded out through administrative review rather than costly litigation”).

And make no mistake: the *Wi-Fi One* decision will open a Pandora’s box of appellate litigation over tangential issues decided at the initiation stage. The PTAB addresses *many* time-bar issues during the institution decision.<sup>3</sup> It may be relatively easy for the

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<sup>3</sup> See, e.g., *Cree, Inc. v. Document Security Sys., Inc.*, No. IPR2018-01223, 2018 WL 6016827 (PTAB Nov. 16, 2018); *FLIR Sys., Inc. v. Garmin Corp.*, No. IPR2018-01490, 2018 WL 5276319 (PTAB Oct. 22, 2018); *Infiltrator Water Techs., LLC v.*

PTAB to determine whether a particular party was previously served with a specific patent infringement complaint. But not so regarding whether that party is a “real party in interest” or is a “privy of the [IPR] petitioner.” 35 U.S.C. § 315(b). Those determinations are intensely factual, often requiring discovery and, naturally, often involving discovery disputes.<sup>4</sup> See *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018) (“Determining whether a non-party is a ‘real party in interest’ demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.”); *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1319 (Fed. Cir. 2018) (explaining the “non-exhaustive list of

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*Presby Patent Trust*, No. IPR2018-00224, 2018 WL 4773425 (PTAB Oct. 1, 2018); *Intel Corp. v. Alacritech, Inc.*, No. IPR2018-00234, 2018 WL 2740385 (PTAB June 5, 2018); *Mobile Tech, Inc. v. Sennco Sols., Inc.*, No. IPR2017-02199, 2018 WL 1891466 (PTAB Apr. 10, 2018); *Semiconductor Components Indus., LLC v. Power Integrations, Inc.*, No. IPR2016-01592, 2018 WL 813000 (PTAB Feb. 8, 2018); *Watson Labs., Inc. v. United Therapeutics Corp.*, No. IPR2017-01622, 2018 WL 396243 (PTAB Jan. 11, 2018); *Amneal Pharm., LLC v. Endo Pharm. Inc.*, No. IPR2014-00360, 2018 WL 446628 (PTAB Jan. 10, 2018).

<sup>4</sup> For recent examples of PTAB decisions addressing complex privity or real-party-in-interest determinations, see, e.g., *Unified Patents Inc. v. Bradium Techs. LLC*, No. IPR2018-00952, 2018 WL 6721788, at \*3–6 (PTAB Dec. 20, 2018); *Merck Sharp & Dohme Corp. v. GlaxoSmithKine Biologicals SA*, No. IPR2018-01236, 2018 WL 6707892, at \*4–5 (PTAB Dec. 18, 2018); *Unified Patents, Inc. v. Realtime Adaptive Streaming, LLC*, No. IPR2018-00883, 2018 WL 6504233, at \*6–8 (PTAB Oct. 11, 2018); *Intel Corp. v. Alacritech, Inc.*, No. IPR2018-00226, 2018 WL 2735469, at \*7–8 (PTAB June 5, 2018).

considerations” relevant to privity, including “(1) an agreement to be bound; (2) pre-existing substantive legal relationships between the person to be bound and a party to the judgment ...; (3) adequate representation by someone with the same interests who was a party ...; (4) assumption of control over the litigation in which the judgment was rendered; (5) where the nonparty to an earlier litigation acts as a proxy for the named party to relitigate the same issues; and (6) a special statutory scheme expressly foreclosing successive litigation by nonlitigants”). Instead of beginning and ending those disputes at the PTAB, they will now become fodder for Federal Circuit appeals.

The *Wi-Fi One* case itself illustrates these points. After the *en banc* court allowed review of the time-bar question, it remanded the case to the panel. The panel became mired in a factually and legally complex issue relating to privity. See *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1335–41 (Fed. Cir. 2018). The privity question in *Wi-Fi One* was complicated enough that it occasioned a lengthy dissent by Judge Reyna, see *id.* at 1346–54, and a petition for certiorari with this Court, see *Wi-Fi One, LLC v. Broadcom Corp.*, No. 18-599 (denied Jan. 7, 2019); see also *WesternGeco*, 889 F.3d at 1320–22 (addressing a privity question). Moreover, one of the patent owner’s principal appellate arguments was that the PTAB improperly denied it discovery that, it contended, would demonstrate the existence of privity. *Wi-Fi One*, 887 F.3d at 1338–40. Congress hardly intended for the Federal Circuit—and potentially this Court—to wade into those questions; rather, as it expressly stated in § 314(d), it meant for the PTAB’s determinations to be the end of the line.



Further, the meaning of “real party in interest” and “privity” in § 315(b) is just the start of the collateral issues that the Federal Circuit, and potentially this Court, will be required to resolve on appeal. Others include the declaratory-judgment bar in 35 U.S.C. § 315(a)(1), the petitioner-estoppel provision in § 315(e)(1), and the provisions of § 325(d) applicable when an IPR and post-grant review involving the same patent are pending simultaneously. Appeals on such questions are precisely what Congress intended to avoid—but which the Federal Circuit now allows.

**II. THIS COURT SHOULD REVIEW THE FEDERAL CIRCUIT’S *EN BANC* DECISION THAT A PATENT INFRINGEMENT ACTION THAT WAS DISMISSED WITHOUT PREJUDICE TRIGGERS THE SECTION 315(b) TIME BAR.**

**A. The *En Banc* Federal Circuit Erred In Holding That Section 315(b) Applies To A Patent Infringement Complaint That Was Dismissed Without Prejudice.**

The *en banc* Federal Circuit also erred in holding that the service of a complaint that was dismissed without prejudice can trigger the § 315(b) time bar. The law on dismissals without prejudice is well settled: “[A]s numerous federal courts have made clear, a voluntary dismissal without prejudice under Rule 41(a) leaves the situation as if the action had never been filed.” 9 Charles Alan Wright, *et al.*, Federal Practice and Procedure § 2367, at 559–65 (3d ed. 1998); *see, e.g., Odle v. Flores*, 705 F. App’x 283, 291 (5th Cir. 2017); *Biomedical Patent Mgmt. Corp. v. Calif. Dep’t of Health Servs.*, 505 F.3d 1328, 1334 (Fed.

Cir. 2007); *City of S. Pasadena v. Mineta*, 284 F.3d 1154, 1157 (9th Cir. 2002); *Smith v. Dowden*, 47 F.3d 940, 943 (8th Cir. 1995). As Judge Dyk explained, “[t]his rule has been applied in the closely comparable situation where a complaint dismissed without prejudice is held not to toll the statute of limitations, absent some evidence of a contrary legislative intent.” App. 98a (Dyk, J., dissenting). Section 315(b) “must be read in light of that background legal principle.” *Id.* at 100a.

Application of this principle to § 315(b) makes complete sense. The purpose of that provision was to ensure that IPR proceedings do not interfere in long-pending patent litigation in federal court regarding the same patent. App. 105a (Dyk, J., dissenting). If a patent case has been litigated for more than one year, it is quite likely that the parties and the court have expended considerable efforts and resources in the case. *Id.* Congress made the sensible judgment that, though IPRs generally are faster and cheaper than litigation in federal court, they would not serve the purpose of efficiency once the court proceedings had been pending for a long period of time. But that assuredly is not the case with complaints dismissed without prejudice, for in that situation there are *no ongoing court proceedings* with which the IPR could interfere.

The *en banc* majority held that the AIA was so clear that the PTO’s interpretation of § 315(b) was entitled to no deference under *Chevron* step one. But as Judge Dyk indicated in dissent, “the meaning of ‘service of a complaint’ is not on its face unambiguous,” because “[i]n closely comparable circumstances, the Supreme Court has held that it is

necessary to look beyond the language, to the context and purpose of the statute.” App. 94a (Dyk, J., dissenting). Specifically, he explained (*id.*) that this Court, in *Kasten v. Saint-Gobain Performance Plastics Corp.*, 563 U.S. 1 (2011), found the phrase “filed any complaint” sufficiently unclear that “the text, taken alone, cannot provide a conclusive answer to our interpretative question.” *Id.* at 11.

The *en banc* Federal Circuit erred in not following *Kasten* and “look[ing] further.” *Id.* The court’s duty is “to construe statutes, not isolated provisions.” *King v. Burwell*, 135 S. Ct. 2480, 2489 (2015) (quoting *Graham Cty. Soil & Water Conservation Dist. v. United States ex rel. Wilson*, 559 U.S. 280, 290 (2010)). In its statutory interpretation, the Federal Circuit relied principally on unhelpful and self-evident dictionary definitions of “complaint” and “serve.” App. 47a–48a. Instead of its wooden focus on these words in isolation, the court should have examined the broader statutory context in which those words appeared and background legal principles against which Congress legislates. See *Astoria Fed. Sav. & Loan Ass’n v. Solimino*, 501 U.S. 104, 108 (1991). “[A] reviewing court should not confine itself to examining a particular statutory provision in isolation. The meaning—or ambiguity—of certain words or phrases may only become evident when placed in context.” *FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 132 (2000). Judge Dyk, having properly interpreted § 315(b) in context, correctly determined that the provision does not apply to complaints dismissed without prejudice.

**B. Whether A Patent Infringement Action  
That Was Dismissed Without Prejudice  
Triggers The Section 315(b) Time Bar Is  
An Important Question.**

In addition to being wrong, the Federal Circuit’s decision that a complaint that was dismissed without prejudice can trigger the § 315(b) time bar will lead to nonsensical results and increased (and unnecessary) litigation.

To begin with, the Federal Circuit’s decision will require application of the time bar when doing so makes no sense. For example, in *Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.*, 905 F.3d 1311 (Fed. Cir. 2018), the Federal Circuit, applying the decision below, held that the PTAB “exceeded its authority and contravened § 315(b)’s time bar” because it instituted review notwithstanding the fact that the petitioner was served with a patent infringement complaint more than one year before it filed the IPR. *Id.* at 1313. That complaint, however, had been dismissed without prejudice because the district court lacked personal jurisdiction over the IPR petitioner. *See Bennett Regulator Guards, Inc. v. MRC Global Inc.*, No. 4:12CV1040, 2013 WL 3365193 (N.D. Ohio July 3, 2013). The Federal Circuit contended that “[j]ust as the statute includes no exception for a voluntarily dismissed complaint, it includes no exception for an involuntarily dismissed complaint.” *Bennett Regulator*, 905 F.3d at 1315.<sup>5</sup> But the court

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<sup>5</sup> *See also, e.g., Infiltrator Water Techs.*, 2018 WL 4773425, at \*2–4 (dismissing IPR because a prior patent infringement complaint was dismissed without prejudice based on lack of personal jurisdiction).

never justified the illogic of attaching such draconian consequences to the filing of a complaint when the court lacked “coercive power” over the defendant. *Bristol-Myers Squibb Co. v. Superior Court of Cal.*, 137 S. Ct. 1773, 1779 (2017). It should be obvious that when a defendant is sued in a court that lacks personal jurisdiction over it, no consequences should attach to the “ineffectual” service of the complaint. *Shaffer v. Heitner*, 433 U.S. 186, 197 (1977).

The same problem arises with other dismissals without prejudice. For example, patent infringement actions have been dismissed without prejudice for lack of standing, because the plaintiff did not even own the asserted patents when the complaint was filed. *See, e.g., Hamilton Beach Brands, Inc. v. f'real Foods, LLC*, 908 F.3d 1328, 1336–37 (Fed. Cir. 2018). Although the Federal Circuit did not reach the § 315(b) issue in *Hamilton Beach*, because the IPR respondent did not cross-appeal that issue, applying the time bar would be both unfair and make no sense. And despite the *Hamilton Beach* panel’s protestations that a dismissal without prejudice based on lack of standing was “not present, or considered, in *Click-to-Call*,” *id.* at 1337, in fact the *en banc* ruling was quite clear: *any* complaint that was served triggers the § 315(b) bar, “*irrespective of subsequent events.*” App. 47a.

The *en banc* decision below will also spur unnecessary litigation. It frequently occurs, after service of a patent-infringement lawsuit in federal court, that the parties either stand down from the litigation or enter into an inexpensive, partial settlement. These outcomes occur because the parties ultimately realize that the current dispute is of a limited nature and therefore is not worth the

significant expense of patent litigation, and they are unsure if they will be at odds over the patent in the future. In such cases, the plaintiff will typically dismiss without prejudice the pending case, often giving a very limited release, in exchange for a small or even nominal sum. In this way, the parties defer litigation until such time—if ever—as they recognize that there is a dispute to which it is worth devoting significant resources.<sup>6</sup>

Suppose, for example, that Patent Owner sues XYZ Corp., alleging that the latter's product Widget One infringes Patent Owner's patent. It turns out that XYZ Corp. sold hardly any of Widget One and had stopped selling it before service of the complaint. Patent Owner therefore agrees to dismiss the complaint without prejudice, and the parties walk away—and agree to disagree on the patent issues—without incurring substantial litigation expenses. Several years later, XYZ Corp. develops a new product, Widget Two—one not even contemplated when Patent Owner sued it previously—and Patent Owner again sues it alleging infringement of the same patent. Under the *en banc* decision below, the § 315(b) time bar would prevent XYZ Corp. from filing an IPR. Knowing that this is possible, after the decision below companies in the position of XYZ Corp., who know that they might (but might not) develop future products that are potentially infringing, will be much less willing to accept a dismissal without prejudice if

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<sup>6</sup> See Kris Olson, *Decision Alters Strategic Calculus in Patent Cases*, Mass. Lawyers Weekly, Aug. 27, 2018; Ryan Davis, *Fed. Cir. Time-Bar Case Puts Pressure on Patent Defendants* (Aug. 22, 2018), Law360, <https://www.law360.com/articles/1075841/fed-circ-time-bar-case-puts-pressure-on-patent-defendants>.

it will bar them from filing a future IPR petition. Instead, they may well feel compelled to participate in expensive, protracted litigation to preserve their future business options. *See* note 6, *supra*.

Finally, as Judge Dyk explained, the *en banc* decision will allow patent owners “to manipulate the filing of infringement actions in order to bar a future IPR challenge.” App. 105a (dissenting opinion). As he indicated, “patent owners would have an incentive to file suits alleging infringement and subsequently voluntarily dismiss these suits without prejudice after service of a complaint.” *Id.* “Such action would effectively begin the one year clock for the accused infringer to file an IPR....” *Id.* As Judge Dyk concluded, “Congress could not have intended to provide a mechanism for such manipulation.” *Id.* at 106a.

Judge Taranto discounted the possibility of such “manipulative abuse” because he found no evidence of such strategic behavior by patent owners. App. 88a–91a (concurring opinion). But this response overlooks the fact that, before the decision below, the PTAB had long held that a complaint dismissed without prejudice did *not* trigger the one-year time bar. *See Apple Inc. v. Rensselaer Polytechnic Inst.*, No. IPR2014-00319, 2014 WL 2735064, at \*3 (PTAB June 12, 2014) (citing earlier Board precedent). It was only *after* the *en banc* decision below that such strategic behavior became viable. The fact that Judge Taranto did not see such behavior before the decision below, therefore, is neither surprising nor relevant.

**III. THIS CASE IS AN IDEAL VEHICLE TO  
RESOLVE THE TWO ISSUES THAT  
DIVIDED THE *EN BANC* FEDERAL  
CIRCUIT.**

This case presents an ideal opportunity to address whether § 314(d) permits the appeal of § 315(b) time-bar determinations and, if so, whether a complaint that was dismissed without prejudice triggers the time bar.<sup>7</sup> Both issues were squarely presented below. Both were addressed by the Federal Circuit. Both were sufficiently important to the patent laws to warrant *en banc* review by that court. Both were sufficiently difficult that the *en banc* Federal Circuit divided over them, with the dissenters writing lengthy published dissents. Moreover, CTC's appeal to the Federal Circuit raised *only* the § 315(b) time bar; it did not challenge the merits of the PTAB's finding that 13 claims of the patent were invalid. Thus, no proceedings on remand, to either the Federal Circuit or PTAB, will be necessary after this Court's review; this Court's decision would be dispositive of the case. And, as a result of the *en banc* decision below, a patent found by the expert agency to be invalid—based on holdings that CTC did not even bother to appeal—remains enforceable.

Finally, the methodological inconsistency between the *en banc* decision in *Wi-Fi One* and the *en banc* decision below cries out for this Court's review. In

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<sup>7</sup> The Court denied the patent owner's petition for certiorari in the *Wi-Fi One* case, but the petition did not raise the appealability issue as a question presented (understandably, since the petitioner prevailed on that issue below). See Petition at i, *Wi-Fi One LLC v. Broadcom Corp.*, No. 18-599 (denied Jan. 7, 2019).



*Wi-Fi One*, the court overrode the plain language of the patent statute in an atextual holding, supposedly in service of a background legal principle. In stark contrast, the court in the decision below woodenly applied a strict literal reading of the patent statute, ignoring an applicable background legal principle. Both approaches to adjoining provisions of the very same law cannot be correct.

Because of the importance of both questions, and because this petition is an ideal vehicle for addressing them, review is warranted.

### CONCLUSION

For the foregoing reasons, the Court should grant the petition.

Respectfully submitted.

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## **APPENDIX**

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**APPENDIX A — OPINION OF THE UNITED  
STATES COURT OF APPEALS FOR THE  
FEDERAL CIRCUIT, FILED NOVEMBER 12, 2015**

UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

2015-1242

CLICK-TO-CALL TECHNOLOGIES, LP,

*Appellant,*

v.

ORACLE CORPORATION, ORACLE OTC  
SUBSIDIARY, LLC, INGENIO, INC.,  
YELLOWPAGES.COM, LLC,

*Appellees.*

Appeal from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in No. IPR2013-  
00312.

November 12, 2015, Decided

Before O'MALLEY, TARANTO, *Circuit Judges*,  
and STARK, *District Judge*.\*

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\* The Honorable Leonard P. Stark, Chief District Judge,  
United States District Court for the District of Delaware, sitting  
by designation.

*Appendix A*

PER CURIAM.

Appellant Click-to-Call Technologies, LP (“CTC”) appeals from the final written decision of the Patent Trial and Appeal Board (“the Board”) on patentability in an inter partes review (“IPR”) proceeding. *Oracle Corp. v. Click-to-Call Techs. LP*, No. IPR2013-00312, 2014 Pat. App. LEXIS 8333, (P.T.A.B. Oct. 28, 2014). In its appeal, CTC seeks review of the Board’s initial decision to institute IPR. Specifically, CTC argues that the IPR proceedings should have been barred by 35 U.S.C. § 315(b), which provides that an “inter parties review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b).

While this appeal was pending, we issued a decision in *Achates Reference Publishing, Inc. v. Apple Inc.*, No. 14-1767, 803 F.3d 652, 2015 U.S. App. LEXIS 17183 (Fed. Cir. Sept. 30, 2015), dismissing the patent owner’s appeals for lack of jurisdiction on grounds that the Board’s decisions to institute IPRs were “final and nonappealable under 35 U.S.C. § 314(d).” *Id.* at \*2. There, as here, the patent owner argued that the Board should not have instituted IPRs because the petitions were time-barred under § 315(b). We explained that § 314(d) barred review of the Board’s decision to institute because, among other things, “the § 315(b) time bar does not impact the Board’s authority to invalidate a patent claim—it only bars particular petitioners from challenging the claim.” *Id.* at \*13. “The Board may still invalidate a claim challenged in a time-

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barred petition via a properly-filed petition from another petitioner.” *Id.* We concluded that § 314(d) “prohibits this court from reviewing the Board’s determination to initiate IPR proceedings based on its assessment of the time-bar of § 315(b), even if such assessment is reconsidered during the merits phase of proceedings and restated as part of the Board’s final written decision.” *Id.* at \*16.

Prior to argument in this case, Oracle Corporation and Oracle OTC Subsidiary LLC (collectively, “Oracle”) submitted a Rule 28(j) letter to the court arguing that *Achates* mandates dismissal of CTC’s IPR appeal for lack of appellate jurisdiction. According to Oracle, because CTC makes the same jurisdictional arguments we rejected in *Achates*, we should likewise dismiss this appeal for lack of jurisdiction.

CTC responds that: (1) this court has “recognized a party’s ability to obtain judicial review when the Board violates a clear statutory mandate”; and (2) it petitioned for mandamus relief under 28 U.S.C. § 1651, which also permits review. Resp. to Rule 28(j) Citation of Suppl. Authority at 1-2, *Click-to-Call Techs., LP v. Oracle, Corp.*, No. 15-1242 (Fed. Cir. Oct. 19, 2015), ECF No. 64. As explained below, we conclude that dismissal is warranted.<sup>1</sup>

First, CTC is correct that courts have recognized “an implicit and narrow exception” to statutory bars on judicial

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1. Given the parties’ Rule 28(j) submissions, we sua sponte removed this case from the November 2015 argument calendar and decided to treat it as submitted on the briefs filed, including the parties’ supplemental submissions.

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review for “claims that the agency exceeded the scope of its delegated authority or violated a clear statutory mandate.” *Achates*, 803 F.3d 652, 2015 U.S. App. LEXIS 17183 at \*16 (citations and quotation marks omitted). As we explained in *Achates*, however, “statutory interpretation disputes fall outside this exception for *ultra vires* agency action, and [o]nly the egregious error melds the agency’s decision into justiciability.” *Id.* at \*16-17 (citations and quotation marks omitted). As noted, this appeal—like *Achates*—involves a § 315(b) challenge to an IPR institution decision. Because CTC’s challenge amounts to a “statutory interpretation dispute,” dismissal is appropriate. *See id.* (concluding that “the Board’s institution decision does not violate a clear statutory mandate”).

Second, although CTC claims that it has petitioned for mandamus relief, there is no mandamus petition pending before us. There are three conditions that must be met before a writ of mandamus can issue: (1) the petitioner must “have no other adequate means to attain” the desired relief; (2) the petitioner must demonstrate a “clear and indisputable” right to the writ; and (3) the court “must be satisfied that the writ is appropriate under the circumstances.” *Cheney v. United States Dist. Court*, 542 U.S. 367, 380-81, 124 S. Ct. 2576, 159 L. Ed. 2d 459 (2004) (internal citations and quotation marks omitted). In its reply brief, CTC argues in the alternative that it “has a clear and indisputable right to issuance of a writ of mandamus because the Board ignored the plain language of § 315(b) by exercising jurisdiction over this case.” Appellant Reply Br. 11. We conclude that CTC’s cursory allegations in the alternative are insufficient to permit the court to meaningfully consider the issue at this time.

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For the foregoing reasons, we dismiss CTC's appeal for lack of jurisdiction.

**DISMISSED**

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**APPENDIX B — OPINION OF THE UNITED  
STATES COURT OF APPEALS FOR THE  
FEDERAL CIRCUIT, FILED NOVEMBER 17, 2016**

UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

2015-1242

CLICK-TO-CALL TECHNOLOGIES, LP,

*Appellant,*

v.

ORACLE CORPORATION, ORACLE OTC  
SUBSIDIARY, LLC, INGENIO, INC.,  
YELLOWPAGES.COM, LLC,

*Appellees.*

November 17, 2016, Decided

Appeal from the United States Patent and  
Trademark Office, Patent Trial and Appeal Board  
in No. IPR2013-00312.

Before O'MALLEY and TARANTO, *Circuit Judges*,  
and STARK, *District Judge*.\*

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\* The Honorable Leonard P. Stark, Chief District Judge,  
United States District Court for the District of Delaware, sitting  
by designation.



*Appendix B*

Opinion for the court filed PER CURIAM.

Concurring opinion filed by *Circuit Judge* O'MALLEY.

Concurring opinion filed by *Circuit Judge* TARANTO.

PER CURIAM.

This case returns to us from the Supreme Court, which granted certiorari, vacated our previous judgment, and remanded for further consideration in light of *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131, 195 L. Ed. 2d 423 (2016). Because we are bound by intervening precedent from this court to do so, we reinstate our earlier judgment and dismiss the appeal filed by Click-to-Call Technologies (“CTC”) in this matter.

On November 25, 2014, CTC appealed from a final written decision of the Patent Trial and Appeal Board (“the Board”) on patentability in an inter partes review (“IPR”) proceeding. *See Oracle Corp. v. Click-to-Call Techs., LP*, No. IPR2013-00312, 2014 Pat. App. LEXIS 8333 (P.T.A.B. Oct. 28, 2014). Specifically, CTC argued that the IPR proceedings should have been barred by 35 U.S.C. § 315(b), which provides that 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 . . . is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). Prior to the Supreme Court’s decision in *Cuozzo*, we dismissed CTC’s appeal for lack of jurisdiction. *Click-To-Call Techs., LP v. Oracle Corp.*, 622 F. App’x 907 (Fed. Cir. 2015). We

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did so in light of this court’s previous decision in *Achates Reference Publishing, Inc. v. Apple Inc.*, 803 F.3d 652 (Fed. Cir. 2015), where we held that a party cannot challenge the Board’s decision to institute an IPR proceeding under § 315(b) because 35 U.S.C. § 314(d) “prohibits this court from reviewing the Board’s determination to initiate IPR proceedings based on its assessment of the time-bar of § 315(b), even if such assessment is reconsidered during the merits phase of proceedings and restated as part of the Board’s final written decision.” *Click-To-Call*, 622 F. App’x at 908 (quoting *Achates*, 803 F.3d at 658).

After the Supreme Court granted CTC’s petition for certiorari, vacated our decision, and remanded the case, we ordered supplemental briefing to address the impact of *Cuozzo* on the continuing viability of our decision in *Achates* and, hence, in this matter. In its supplemental brief, CTC argues that *Cuozzo* requires this court to reconsider our holding in *Achates*. CTC asserts that *Cuozzo* limits § 314(d) to challenges that are “closely related” to the Board’s substantive patentability determination under § 314(a). According to CTC, the Supreme Court implicitly overruled our holding in *Achates* because the time bar under § 315(b) is not closely related to the Board’s decision to institute under § 314(a). *Cf. Wi-Fi One, LLC v. Broadcom Corp.*, No. 15-1944, 837 F.3d 1329, 2016 U.S. App. LEXIS 16942, at \*26 (Fed. Cir. Sept. 16, 2016) (Reyna, J., concurring) (“The time-bar question is not a ‘mine-run’ claim, and it is not a mere technicality related only to a preliminary decision concerning the sufficiency of the grounds that are pleaded in the petition.”). CTC also argues that § 315(b) provides an independent jurisdictional limitation

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on the Board that goes beyond the scope of § 314(d). *Cf. id.* (“[T]he time bar deprives the Board of jurisdiction to consider whether to institute a review . . .”).

Oracle Corp. (“Oracle”) and the United States Patent and Trademark Office (“PTO”) both argue that the Supreme Court’s analysis in *Cuozzo* not only did not overrule *Achates*, but supports our holding in *Achates*. They argue that the Supreme Court’s determination that § 314(d) precludes review of an institution decision where the grounds for attacking the decision to institute are questions closely tied to those statutes authorizing the PTO to act mandates application of § 314(d) to a timebar challenge brought under § 315(b). Oracle points to Justice Alito’s separate opinion in *Cuozzo*, concurring in part and dissenting in part, as support for its view of the majority’s reasoning. In that opinion, Justice Alito complains that “the petition’s timeliness, no less than the particularity of its allegations, is closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate . . . review, and the Court says that such questions are unreviewable.” *Cuozzo*, 136 S. Ct. at 2155 (Alito, J., concurring in part and dissenting in part) (internal quotations omitted).

After the parties submitted supplemental briefing in this case, we issued our decision in *Wi-Fi One*, which directly considers whether *Achates* remains good law after *Cuozzo*. In *Wi-Fi One*, a majority of the panel determined that the Supreme Court’s decision in *Cuozzo* did not overrule our previous decision in *Achates* and that later panels of the court remain bound by *Achates*. *See Wi-Fi*

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*One*, 837 F.3d 1329, 2016 U.S. App. LEXIS 16942, at \*9-12. The majority concluded, moreover, that “[n]othing in *Cuozzo* casts doubt” on the interpretation of the statute we relied upon in *Achates*. 837 F.3d 1329 at \*11.<sup>1</sup>

In deciding this case, we are bound by this court’s precedent in *Wi-Fi One* and, hence, in *Achates*. We therefore once more dismiss CTC’s appeal for lack of jurisdiction. Because we are bound by the holdings of *Wi-Fi One* and *Achates* as to the scope of § 314(d), we do not address the parties’ arguments as to whether any error by the PTO in its institution decision is harmless based on the presence of other parties to whom the § 315(b) time bar would not apply.

**DISMISSED**

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1. As noted above, Judge Reyna dissented from that aspect of the court’s decision.

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O'MALLEY, *Circuit Judge*, concurring.

As explained in the court's opinion, our previous holding in *Achates Reference Publishing, Inc. v. Apple Inc.*, 803 F.3d 652 (Fed. Cir. 2015), determined that a party cannot challenge the Board's decision to institute an IPR proceeding under § 315(b) because of the bar on judicial review of institution decisions in § 314(d). Since the Supreme Court's decision in *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131, 195 L. Ed. 2d 423 (2016), this court has reaffirmed that *Achates* remains good law. *Wi-Fi One, LLC v. Broadcom Corp.*, No. 15-1944, 837 F.3d 1329, 2016 U.S. App. LEXIS 16942 (Fed. Cir. Sept. 16, 2016). Because we are bound by the court's previous decisions in *Achates* and *Wi-Fi One*, I agree with the court's dismissal of Click-to-Call's ("CTC") challenge under § 315(b). I write separately, however, to note that I believe the Supreme Court's language in *Cuozzo* leaves room for us to question our reasoning in *Achates* and to suggest that we do so en banc.

In explaining the scope of its opinion in *Cuozzo*, the Supreme Court clarified that, "contrary to the dissent's suggestion, we do not categorically preclude review of a final decision where a petition fails to give 'sufficient notice' such that there is a due process problem with the entire proceeding, nor does our interpretation enable the agency to act outside its statutory limits . . . ." *Cuozzo*, 136 S. Ct. at 2141. The Supreme Court then provided the specific example of the Board addressing a claim's definiteness under § 112 during an IPR proceeding despite Congress only authorizing the Board to consider challenges under

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§§ 102-03. *Id.* at 2141-42. We could apply the same reasoning to the Board’s institution of an IPR proceeding contrary to the direct statutory command that “[a]n 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 . . . is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b) (emphasis added). As the Supreme Court noted in its opinion, “[s]uch ‘shenanigans’ may be properly reviewable in the context of § 319 and under the Administrative Procedure Act, which enables reviewing courts to ‘set aside agency action’ that is . . . ‘in excess of statutory jurisdiction.’” *Cuozzo*, 136 S. Ct. at 2142 (quoting 5 U.S.C. § 706(2)(A)-(D)).

The Supreme Court also stated that its “conclusion that courts may not revisit this initial determination gives effect to th[e] statutory command” of § 314(d). *Cuozzo*, 136 S. Ct. at 2141. To the extent the Supreme Court sought in *Cuozzo* to give effect to the statutory commands of Congress, permitting review of challenges brought under § 315(b) similarly would give effect to the statutory command that IPR proceedings “may not be instituted” when a petitioner files an untimely petition. *See* 35 U.S.C. § 315(b). It would also give effect to the statutory command that reviewing courts shall “set aside agency action” that is “in excess of statutory jurisdiction, authority, or limitations, or short of statutory right.” *See* 5 U.S.C. § 706(2)(C).

This reasoning and the plain language of the statute contradict a key underpinning of our reasoning in *Achates*. In *Achates*, we stated that “the § 315(b) time bar does not

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impact the Board’s authority to invalidate a patent claim—it only bars particular petitioners from challenging the claim.” 803 F.3d at 657. Although § 315(b) does not prevent another petitioner that is not time-barred from bringing a later challenge to the patent, the statute, as written, does not address who may bring a petition; Congress did not address the statute to petitioners or the identity of petitioners. Instead, the statute is addressed to the PTO and provides that “[a]n inter partes review *may not be instituted* if the petition requesting the proceeding” is time-barred under the requirements of the statute. 35 U.S.C. § 315(b) (emphasis added). As we explained in *Intellectual Ventures II LLC v. JPMorgan Chase & Co.*, 781 F.3d 1372 (Fed. Cir. 2015), in the context of assessing when we may exercise jurisdiction over an appeal from institution decisions regarding covered business method patents (“CBMs”), Congress consistently differentiated between petitions to institute and the act of institution in the AIA. *Id.* at 1376. The former is what a party seeking to challenge a patent in a CBM proceeding, a derivation proceeding, a post-grant proceeding, or an IPR does—and of which the PTO reviews the sufficiency—and the latter is what the Director of the PTO is authorized to do. *Id.* Because only the Director or her delegees may “institute” a proceeding, § 315(b)’s bar on institution is necessarily directed to the PTO, not those filing a petition to institute. *See id.*

If the PTO exceeds its statutory authority by instituting an IPR proceeding under circumstances contrary to the language of § 315(b), then our court, sitting in its proper role as an appellate court, should review

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those determinations as *Cuozzo* suggests. *See Cuozzo*, 136 S. Ct. at 2141-42; 5 U.S.C. § 706(2)(C). Indeed, the court should address such actions in order to give effect to the limitations on the PTO’s statutory authority to institute proceedings expressly set forth in § 315(b). *See Cuozzo*, 136 S. Ct. at 2141.

The PTO’s own regulations support this reading of § 315(b); they clearly consider the possibility that the Board might mistakenly take actions in excess of its statutory jurisdiction. For example, Part 42 of Title 37 in the Code of Federal Regulations “governs proceedings before the Patent Trial and Appeal Board.” 37 C.F.R. § 42.1(a) (2016). In addressing “Jurisdiction” for these proceedings, Part 42 expressly requires that “[a] petition to institute a trial must be filed with the Board consistent with any time period required by statute.” *Id.* § 42.3(b); *see also id.* § 42.2 (identifying IPR proceedings as falling within the definition of “trial”). A straightforward reading of these regulations indicates that the PTO believed at the time it issued those regulations that it would not have statutory jurisdiction or authority to institute proceedings—including IPRs—in response to petitions to institute filed outside the time limit set by statute for such filings. As *Cuozzo* indicated, such a decision would be reviewable under the Administrative Procedure Act. *Cuozzo*, 136 S. Ct. at 2142; *see also* 5 U.S.C. § 706(2)(C).

The policy underlying the Supreme Court’s reasoning in *Cuozzo* also indicates that courts should review institution decisions when the petition is not timely filed under § 315(b). In *Cuozzo*, the Supreme Court acknowledged the “strong presumption” in favor of



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judicial review when interpreting statutes. 136 S. Ct. at 2140 (citing *Mach Mining, LLC v. EEOC*, 135 S. Ct. 1645, 1650, 191 L. Ed. 2d 607 (2015)). The Supreme Court explained that Congress can only overcome this presumption through “clear and convincing indications” that are “drawn from specific language, specific legislative history, and inferences of intent drawn from the statutory scheme as a whole.” *Id.* (internal quotation marks omitted) (quoting *Block v. Cmty. Nutrition Inst.*, 467 U.S. 340, 349-50, 104 S. Ct. 2450, 81 L. Ed. 2d 270 (1984)). The Supreme Court determined that Congress provided clear and convincing evidence in § 314(d) that it intended to bar review of *certain* institution decisions. The Supreme Court then held that Cuozzo’s challenge under § 312 is barred by the scope of § 314(d) because “Cuozzo’s claim that Garmin’s petition was not pleaded ‘with particularity’ under § 312 is little more than a challenge to the Patent Office’s conclusion, under § 314(a), that the ‘information presented in the petition’ warranted review.” *Id.* at 2142.

This reasoning does not translate to the text of § 315(b), however. Neither the challenge in *Wi-Fi One, LLC v. Broadcom Corp.*, No. 15-1944, 837 F.3d 1329, 2016 U.S. App. LEXIS 16942 (Fed. Cir. Sept. 16, 2016), nor the challenge here relates to whether the information presented in the petition warrants review; they instead challenge the fundamental statutory basis on which Congress has authorized the Director to institute an IPR proceeding. *See* 35 U.S.C. § 315(b) (“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 . . . is served with a complaint alleging infringement of the patent.” (emphasis added)).

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The “strong presumption” in favor of judicial review encourages the review of such questions.

To be clear, the Supreme Court in *Cuozzo* did not expressly state whether the scope of § 314(d) applies to the time bar of § 315(b). And I agree with my colleagues in *Wi-Fi One* that *Cuozzo* did not overrule *Achates*. But the Supreme Court explicitly left open the possibility that the AIA might allow for challenges to certain Board decisions to institute an IPR proceeding. *Cuozzo*, 136 S. Ct. at 2141-42. Although the Supreme Court did not decide the effect of § 314(d) on the precise challenge at issue here, it referred to potentially viable constitutional challenges and challenges based on decisions which exceed the PTO’s statutory authority. *Id.* Indeed, as noted above, the Supreme Court rejected the dissent’s view of the scope of the majority opinion—where Justice Alito expressed concern that timeliness challenges would become unreviewable under the majority’s reasoning—and explained that the Court’s holding “do[es] not categorically preclude review of a final decision” in at least some circumstances. *Id.* at 2141.

For these reasons, like Judge Taranto, I believe that this court, sitting en banc in an appropriate case, should reconsider *Achates*. I suggest we collectively assess whether our reasoning in *Achates* comports with the precise language in the statutory provision it analyzes and should remain the law by which we are governed. Because this court’s precedent in *Wi-Fi One* and *Achates* remain binding law on this panel at this time, I concur in the judgment we enter today.

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TARANTO, *Circuit Judge*, concurring.

In this case, a panel of the Patent Trial and Appeal Board, acting as delegee of the Director of the Patent and Trademark Office under 37 C.F.R. §§ 42.4, 42.108, instituted an inter partes review (IPR) under 35 U.S.C. ch. 31, at the behest of Oracle, of certain claims of Click-to-Call's U.S. Patent No. 5,818,836. In instituting the review, the Board concluded that institution was not barred by 35 U.S.C. § 315(b), which prohibits institution if more than a year has elapsed since certain infringement complaints involving the patent at issue were served. In Click-to-Call's appeal of a final written decision cancelling certain claims of the '836 patent, the reviewability of the Board's § 315(b) determination is now back before us on remand from the Supreme Court. *Click-to-Call Techs., LP v. Oracle Corp.*, 136 S. Ct. 2508, 195 L. Ed. 2d 837 (2016).

Under binding precedent of this court, we may not review that determination. In *Achates Reference Publishing, Inc. v. Apple Inc.*, 803 F.3d 652, 658 (Fed. Cir. 2015), this court held that 35 U.S.C. § 314(d) precludes judicial review, even in an appeal of a final written decision cancelling patent claims in an IPR, of the PTO's determination that institution of the IPR comports with the one-year rule of § 315(b). *Achates* remains binding. Whatever effect the Supreme Court's decision in *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131, 195 L. Ed. 2d 423 (2016), would have on a fresh analysis of the *Achates* issue, a high standard must be met in order for one panel to conclude that an earlier, otherwise-binding panel decision has been superseded by an intervening

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Supreme Court decision. As this court held in *Wi-Fi One, LLC v. Broadcom Corp.*, 837 F.3d 1329 (Fed. Cir. 2016), the decision in *Cuozzo* does not meet that standard for the *Achates* issue.

The en banc court, however, would not be bound by *Achates* and could consider the issue afresh in light of *Cuozzo*. It appears to me that en banc consideration is warranted. I elaborate on my current thinking to complement Judge O'Malley's analysis in her concurrence.

The specific issue is whether, in a patent owner's appeal of a final written decision cancelling some claims of its patent, § 314(d) prohibits this court from reviewing the PTO's determination that the petition satisfies § 315(b)'s timeliness rule.<sup>1</sup> The reviewability provision, § 314(d), states: "The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable." The timeliness provision, § 315(b), states: "An inter partes review may not be

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1. We may consider the issue of § 314(d)'s meaning solely as to Board decisions to institute, putting aside Board decisions *not* to institute. In *Cuozzo*, as an important part of its rationale for reading § 314(d) to bar review even after a final written decision, the Supreme Court declared: "[T]he agency's decision to *deny* a petition is a matter committed to the Patent Office's discretion. See [5 U.S.C.] § 701(a)(2); 35 U.S.C. § 314(a) (no mandate to institute review)." 136 S. Ct. at 2140 (emphasis added). As to *noninstitution* decisions, the Court explained, § 314(d) "would seem superfluous." *Id.* Under that reasoning, § 314(d) need not be invoked to conclude that a denial of a petition is unreviewable; the provision's interpretation seems to matter only as to decisions *to* institute.

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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.”

As *Cuozzo* confirms, the question of reviewability must be answered against the background of an important default rule providing for judicial review of agencies’ affirmative exercises of power concretely harming the person seeking review. 136 S. Ct. at 2140. Under that rule, a high standard of clarity must be met before a court may conclude that Congress has barred judicial review of determinations underlying such agency exercises of power even after the agency action has become final. *Mach Mining, LLC v. Equal Emp’t Opportunity Comm’n*, 135 S. Ct. 1645, 1651, 191 L. Ed. 2d 607 (2015); *Bowen v. Mich. Acad. of Family Physicians*, 476 U.S. 667, 670-72, 106 S. Ct. 2133, 90 L. Ed. 2d 623 (1986). Where that standard is not met, the background reviewability rule supplies the rule of decision, confirming reviewability. And like other important structural background rules, such as those concerning extraterritoriality and sovereign immunity, the rule of decision favoring reviewability (where a clear contrary showing is not made) should apply in determining the *scope* of any statutory provision asserted to create an exception, not just in determining whether the provision is an exception at all. See *Morrison v. Nat’l Austl. Bank Ltd.*, 561 U.S. 247, 265, 130 S. Ct. 2869, 177 L. Ed. 2d 535 (2010) (extra-territoriality); *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 455-56, 127 S. Ct. 1746, 167 L. Ed. 2d 737 (2007) (extraterritoriality); *Sossamon v. Texas*, 563 U.S. 277, 285, 131 S. Ct. 1651, 179 L. Ed. 2d 700 (2011) (sovereign

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immunity); *Lane v. Pena*, 518 U.S. 187, 192, 116 S. Ct. 2092, 135 L. Ed. 2d 486 (1996) (sovereign immunity); *Pennhurst State Sch. & Hosp. v. Halderman*, 465 U.S. 89, 99, 104 S. Ct. 900, 79 L. Ed. 2d 67 (1984) (sovereign immunity).

Within that framework, the Supreme Court in *Cuozzo* made two things clear, while leaving others less clear. The first clear ruling is that § 314(d) bars review of certain institution determinations even after the Board has rendered a final written decision cancelling patent claims. The provision does not bar only interlocutory review, which, the Court explained, would already be rendered unavailable by the Administrative Procedure Act, 5 U.S.C. § 704. *See* 136 S. Ct. at 2140. The second clear ruling is that the specific PTO determination involved in the *Cuozzo* case is within the § 314(d) bar. The PTO’s determination in *Cuozzo* was that the petition seeking institution of an IPR complied with § 312(a)(3), which imposes a pleading requirement—that the petition must identify, “in writing and with particularity, each claim challenged, [and] the grounds on which the challenge to each claim is based.” 35 U.S.C. § 312(a)(3). Beyond that, however, the Court in *Cuozzo* left the scope of § 314(d)’s bar less than clear.

It is notable, to begin with, that the Court pointedly avoided embracing the simplest and most review-barring reading of § 314(d)—namely, that it prohibits judicial review of *any* determination to institute an IPR. Instead, in ruling that § 314(d) bars review of a § 312(a)(3) determination, the Court both emphasized the particular PTO determination before it and gave various indications that any unreviewability conclusion depends

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on what particular PTO determination is at issue. 136 S. Ct. at 2139 (referring to “this kind of legal question and little more”); *id.* at 2140 (referring to “minor statutory technicality”); *id.* at 2141 (distinguishing “questions that are closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review” from “constitutional questions,” “other less closely related statutes,” and “questions of interpretation that reach, in terms of scope and impact, well beyond” § 314); *id.* at 2141-42 (not barring review of an agency’s decision “to act outside its statutory limits by, for example, canceling a patent claim for ‘indefiniteness under § 112’ in inter partes review”); *id.* at 2142 (concluding that “§ 314(d) bars Cuozzo’s efforts to attack the Patent Office’s determination to institute inter partes review *in this case*” (emphasis added))).

Such issue dependence has a foundation in the language of § 314(d), which refers to a “determination . . . whether to institute an IPR *under this section*” (emphasis added). As a textual matter, those words clearly encompass the “reasonable likelihood” determination specified in § 314(a), but they leave unclear to what extent they reach determinations of compliance with other statutory provisions bearing on institution. The interpretive task demands a wider focus, beyond the words of § 314(d) alone, as the Court’s analysis in *Cuozzo* itself shows. *See Cuozzo*, 136 S. Ct. at 2141 (relying on “[t]he text of the ‘No Appeal’ provision, along with its place in the overall statutory scheme, its role alongside the Administrative Procedure Act, the prior interpretation of similar patent statutes, and Congress’ purpose in crafting inter partes review”).

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When the focus is widened to view the IPR regime as a whole, and how it compares to other aspects of the patent statute, one of the features that stands out is this: A statutorily proper petitioner—one entitled to file the petition when filed—is an essential statutory requirement for the PTO to conduct an IPR. As part of an evident balancing of interests (private as well as institutional), Congress imposed this proper-petitioner requirement to limit the extent to which it was authorizing pursuit, through *this* mechanism, of “one important congressional objective, namely, giving the Patent Office significant power to revisit and revise earlier patent grants.” *Cuozzo*, 136 S. Ct. at 2139-40.

Thus, whereas the PTO may unilaterally institute an ex parte reexamination, it may not unilaterally institute an IPR. *Compare* 35 U.S.C. § 303(a) (providing, for reexaminations, that “[o]n his own initiative, and at any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 or 302”), *with* 35 U.S.C. § 314(a) (providing, for IPRs, that “[t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition”). In this fundamental way, Congress confined this particular avenue for PTO reconsideration of issued patents to properly oppositional proceedings. *See, e.g., In re Magnum*



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*Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016); *Genzyme Therapeutic Prods. Ltd. P'ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1367 (Fed. Cir. 2016). And the opposition may not come from just anyone for an IPR. In § 315(b), Congress barred institution when the petition is filed by someone who has waited too long (based on earlier litigation).

This seemingly fundamental structural aspect of the IPR scheme is reflected in PTO regulations. Those regulations treat compliance with the timing rule for IPRs as a matter of Board “jurisdiction.” 37 C.F.R. § 42.3(b) (in section headed “Jurisdiction,” providing that “[a] petition to institute a trial must be filed with the Board consistent with any time period required by statute”); *see also* 37 C.F.R. § 42.104(a) (discussing “standing” of an IPR petitioner).<sup>2</sup> The “jurisdiction” label, while a troublesome one in many contexts, here relates to an Administrative Procedure Act principle that the Court in *Cuozzo* invoked in stating that, at least sometimes and maybe generally,

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2. The jurisdictional character of the § 315(b) timing requirement is not altered by the possibility, as at least one panel of the Board has concluded, that a petitioner may correct its identification of a real party in interest, required by § 312(a)(2), without losing its filing date. *Elekta, Inc. v. Varian Medical Sys. Inc.*, IPR2015-01401, 2015 Pat. App. Filings LEXIS 12841, 2015 WL 9898990, at \*4, \*6 (PTAB Dec. 31, 2015). In the federal courts, jurisdictional facts remain jurisdictional even though a plaintiff may correct a defective *pleading* of such facts, with relation back to the time of initial filing, if the newly pleaded facts were true at the time of initial filing. *See* 28 U.S.C. § 1653; *Newman-Green, Inc. v. Alfonzo-Larrain*, 490 U.S. 826, 830-31, 109 S. Ct. 2218, 104 L. Ed. 2d 893 (1989).

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§ 314(d) does *not* bar review to determine if agency action is “in excess of statutory jurisdiction.” 136 S. Ct. at 2142 (quoting 5 U.S.C. § 706(2)(C)). Notably, while the PTO by regulation treats the timing requirement at issue here as a matter of “jurisdiction,” *Cuozzo* confirms that the pleading requirement, § 312(a)(3), at issue in that case cannot be characterized as “jurisdictional.”

The “jurisdiction” language of *Cuozzo* is not the only basis for distinguishing the § 315(b) timing issue from the § 312(a)(3) particularity issue addressed in *Cuozzo*. The two issues differ with respect to other, related aspects of *Cuozzo*’s reasoning as well:

First, the requirement of a statutorily proper petitioner, including its timing aspect, is unrelated to the substance of the allegations of unpatentability. The interpretive issues for § 315(b), unlike those for § 312(a)(3)’s pleading rule, are wholly distinct from the patentability issues decided in assessing under § 314(a) whether the substantive challenges are likely meritorious. A § 315(d) challenge, unlike a § 312(a)(3) challenge, is not “little more than a challenge to the Patent Office’s conclusion, under § 314(a), that the ‘information presented in the petition’ warranted review.” *Cuozzo*, 136 S. Ct. at 2142. A § 315(b) determination is not like “the kind of initial determination at issue [in *Cuozzo*]—that there is a ‘reasonable likelihood’ that the claims are unpatentable on the grounds asserted.” *Id.* at 2140.

Second, the § 315(b) timing determination is unlike various preliminary determinations that “in other

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contexts, [the Court has] held to be unreviewable,” *id.*—determinations focused on the substance of the allegations that will be at issue in the proceeding once initiated. The Court in *Cuozzo* pointed to the unreviewability of a grand jury’s finding of probable cause. *Id.* (citing *Kaley v. United States*, 134 S. Ct. 1090, 1097-98, 188 L. Ed. 2d 46 (2014)). Another example, not cited in *Cuozzo*, is the denial of summary judgment, which is also a preliminary determination focused on the merits of the case and which is generally unreviewable after a final judgment. *See Ortiz v. Jordan*, 562 U.S. 180, 183-84, 131 S. Ct. 884, 178 L. Ed. 2d 703 (2011); *Switz. Cheese Ass’n, Inc. v. E. Horne’s Market, Inc.*, 385 U.S. 23, 25, 87 S. Ct. 193, 17 L. Ed. 2d 23 (1966); *Function Media, L.L.C. v. Google Inc.*, 708 F.3d 1310, 1322 (Fed. Cir. 2013). In those situations, the merits in dispute at the summary judgment and grand jury stages will be finally and more fully resolved during subsequent proceedings, whose results will be subject to review as part of the final judgment; and at that point, the earlier, thresh-old assessments—*e.g.*, whether there was probable cause presented to the grand jury or whether there was a genuine issue of material fact—are no longer pertinent. Much the same can be said, in the IPR context, of a determination of whether the challenged claims are likely unpatentable and whether related pleading requirements are satisfied. By contrast, under *Achates*, the Board’s timeliness decision, which is akin to a decision on standing, will never be reviewed, even though it is not effectively mooted by the final decision.

Third, for the same reason, the § 315(b) determination is unlike the determinations made unreviewable by

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the statutory provisions on which § 314(d) was based, namely, § 303(c) for ex parte reexamination and old § 312(c) for inter partes reexamination. *See Cuozzo*, 136 S. Ct. at 2140 (noting § 314(d)’s relationship to § 303(c) and old § 312(c)). What those provisions barred was review of determinations interwoven with the substance of the patentability issue. *See* 35 U.S.C. § 303(c) (“A determination by the Director pursuant to subsection (a) of this section that no substantial new question has been raised will be final and nonappealable.”); 35 U.S.C. § 312(c) (2011). The § 315(b) determination is different.

Fourth, as noted *supra*, the proper-party requirement is a clear structural limit (even a “jurisdictional” limit) on the authorization the PTO received from Congress to cancel bad patent claims through this scheme. In that respect it is akin to the provision limiting IPRs to only (certain) § 102 and § 103 challenges—which is a limit *Cuozzo* indicates remains enforceable by judicial review, *Cuozzo*, 136 S. Ct. at 2141-42. And it is not a “minor statutory technicality” (like § 312(a)(3)’s “pleading” rule) that Congress could not have expected to curtail the PTO’s use of IPRs to correct bad patents. *Id.* at 2140.

The foregoing considerations are only part of the inquiry into how *Cuozzo* applies to the § 315(b) timeliness requirement. *Cuozzo* also uses language that, at least when taken alone, can be read as pointing toward broad unreviewability conclusions. *Id.* at 2139 (“[T]he legal dispute at issue is an ordinary dispute about the application of certain relevant patent statutes concerning the Patent Office’s decision to institute inter partes review.”); *id.* at

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2141 (“[O]ur interpretation applies where the grounds for attacking the decision to institute inter partes review consist of questions that are closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate inter partes review.”); *id.* at 2142 (“[W]here a patent holder grounds its claim in a statute closely related to that decision to institute inter partes review, § 314(d) bars judicial review.”). The proper reach of that language, however, is itself unclear.

Some of that language contains terms that on their face are limiting and call for further inquiry to identify their limits: “*certain* relevant patent statutes”; “closely related to *that* decision,” referring to the just-mentioned decision of § 314(a) that the claims are likely unpatentable. *Id.* at 2139, 2142 (emphases added). And even the broadest statement—“our interpretation applies . . .”—cannot be read in isolation from *Cuozzo*’s preservation of judicial review to prevent the PTO from acting “in excess of statutory jurisdiction” by, *e.g.*, enforcing certain statutory constraints on IPRs, such as § 311(b)’s restriction of IPRs to certain grounds under § 102 and § 103. *Id.* at 2141-42. After all, § 311(b)’s limitation of IPRs to certain prior-art bases is certainly a “statute[ ] related to the Patent Office’s decision to initiate inter partes review.” *Id.* at 2141. Yet *Cuozzo* confirms the judicial enforceability of that limitation.

It is not self-evident what to make of the mix of language in *Cuozzo* for purposes of determining the reviewability of PTO rulings on grounds, such as timeliness under § 315(b), other than the one before the

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Court in *Cuozzo*. The Supreme Court could easily have written its opinion more broadly. Instead, it took evident pains to speak in terms that left a good deal open. And then, rather than conclude that *Cuozzo* so clearly implies unreviewability of § 315(b) determinations that the Court should simply deny the petition for certiorari in the present case, the Court granted certiorari, vacated our judgment finding unreviewability, and remanded the case for further consideration. *Click-to-Call Techs.*, 136 S. Ct. at 2508.

I have set out some reasons for concluding that the background rule of reviewability should govern as to the timing requirement of § 315(b) because there is no clear enough basis for concluding otherwise. There may be additional reasons. For example, it might be relevant that the § 315(b) determination, which may depend on real-party-in-interest and privity relationships, is not always made definitively at the institution stage: discovery into pertinent facts and definitive resolution of the issue may occur after institution (which is not true for “*likely* success” or, seemingly, § 312(a)(3) pleading determinations). On the other hand, perhaps a full analysis would ultimately establish the required clear case for overcoming the default rule of reviewability even as to the § 315(b) issue.

The § 315(b) issue is a recurring one. Moreover, the principle of presumed judicial review for agency action that harms private persons is an important one. At present, it appears to me that *Achates* is incorrect and that en banc review is warranted.

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**APPENDIX C — ORDER OF THE UNITED  
STATES COURT OF APPEALS FOR THE  
FEDERAL CIRCUIT, FILED JANUARY 19, 2018**

UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

2015-1242

CLICK-TO-CALL TECHNOLOGIES, LP,

*Appellant,*

v.

ORACLE CORPORATION, ORACLE OTC  
SUBSIDIARY, LLC, INGENIO, INC.,  
YELLOWPAGES.COM, LLC,

*Appellees,*

JOSEPH MATAL, PERFORMING THE  
FUNCTIONS AND DUTIES OF THE  
UNDER SECRETARY OF COMMERCE FOR  
INTELLECTUAL PROPERTY AND DIRECTOR,  
U.S. PATENT AND TRADEMARK OFFICE,

*Intervenor.*

January 19, 2018, Decided

Appeal from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in No. IPR2013-  
00312.

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**ON PETITION FOR PANEL REHEARING**

Before O'MALLEY and TARANTO, *Circuit Judges*, and  
STARK, *District Judge*\*.

PER CURIAM.

**ORDER**

Appellant Click-to-Call Technologies, LP (“CTC”) filed a petition for rehearing en banc, in which it seeks two forms of relief. First, it asks the court to vacate the panel’s November 17, 2016 opinion dismissing CTC’s appeal for lack of jurisdiction. *See Click-to-Call Techs., LP v. Oracle Corp.*, No. 2015-1242, 2016 U.S. App. LEXIS 20592, 2016 WL 6803054 (Fed. Cir. Nov. 17, 2016). Second, CTC asks the court to rehear its appeal, which centers on CTC’s contention that the Patent Trial and Appeal Board (“the Board”) erred in determining that inter partes review proceeding IPR2013-00312 was not barred by 35 U.S.C. § 315(b). The petition therefore requests relief that can be granted by the panel that heard the appeal. *See Fed. Cir. R. 35 Practice Notes*.

The panel determines that rehearing of CTC’s appeal is warranted in light of this court’s en banc opinion in *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 2018 WL 313065 (Fed. Cir. Jan. 8, 2018) (en banc). Upon consideration thereof,

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\* The Honorable Leonard P. Stark, Chief District Judge, United States District Court for the District of Delaware, sitting by designation.



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IT IS ORDERED THAT:

(1) The petition for rehearing en banc filed by Appellant is construed as a petition for panel rehearing, which the panel grants.

(2) The court's opinion in *Click-to-Call Technologies, LP v. Oracle Corp.*, No. 2015-1242, 2016 U.S. App. LEXIS 20592, 2016 WL 6803054 (Fed. Cir. Nov. 17, 2016) is vacated, and the appeal is reinstated.

(3) Appellant, Appellees Oracle Corporation, Oracle OTC Subsidiary, LLC, Ingenio, Inc., and Yellowpages.com, LLC (together, "Appellees"), and Intervenor the Director of the United States Patent and Trademark Office ("Intervenor"), may file supplemental briefs, which shall be limited to addressing the merits of the Board's compliance with § 315(b) in this case, and shall further be limited to addressing developments that have occurred after the date on which Appellant filed its opening appeal brief.

(4) All supplemental briefs shall be electronically filed in the ECF system, and six paper copies of each brief shall be filed with the court. Two paper copies of all filings shall be served on counsel for all other parties. Briefs shall adhere to the type-volume limitations set forth in Federal Rule of Appellate Procedure 32 and Federal Circuit Rule 32, with the exception that no brief may contain more than 7,000 words.

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(5) Appellant's supplemental brief must be filed by Monday, February 5, 2018. Appellees' joint supplemental brief must be filed by Wednesday, February 21, 2018. Intervenor's supplemental brief must be filed by Monday, March 5, 2018. No other briefs shall be filed.

(6) The appeal will be heard on the basis of the parties' appeal briefs, the supplemental briefs ordered herein, and, if necessary, oral argument.

FOR THE COURT

January 19, 2018  
Date

/s/Peter R. Marksteiner  
Peter R. Marksteiner  
Clerk of Court

**APPENDIX D — OPINION OF THE UNITED  
STATES COURT OF APPEALS FOR THE  
FEDERAL CIRCUIT, FILED AUGUST 16, 2018**

UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

2015-1242

CLICK-TO-CALL TECHNOLOGIES, LP,

*Appellant,*

v.

INGENIO, INC., YELLOWPAGES.COM, LLC,

*Appellees,*

ANDREI IANCU, UNDER SECRETARY OF  
COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE,

*Intervenor.*

Appeal from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in No. IPR2013-  
00312.

August 16, 2018, Decided

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Before O'MALLEY and TARANTO, *Circuit Judges*, and  
STARK, *Chief District Judge*\*.

Opinion for the court filed by *Circuit Judge* O'MALLEY,  
in which TARANTO, *Circuit Judge*, and STARK,  
*Chief District Judge*, join.

Footnote 3 of the opinion is joined by PROST, *Chief  
Judge*, NEWMAN, MOORE, O'MALLEY, REYNA, WALLACH,  
TARANTO, CHEN, HUGHES, and STOLL, *Circuit Judges*.

Opinion concurring in footnote 3 of the opinion  
filed by *Circuit Judge* TARANTO.

Opinion dissenting from footnote 3 of the opinion  
filed by *Circuit Judge* DYK, in which *Circuit Judge*  
LOURIE joins.

O'MALLEY, *Circuit Judge*.

This long-marooned case returns to us after a voyage alongside two others interpreting the scope of 35 U.S.C. § 314(d)'s "No Appeal" provision and its applicability to time-bar determinations under 35 U.S.C. § 315(b): *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131, 195 L. Ed. 2d 423 (2016), and *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018) (*en banc*). Because we have held *en banc* "that the time-bar determinations under § 315(b) are appealable," *Wi-Fi One*, 878 F.3d at 1367, we address

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\* The Honorable Leonard P. Stark, Chief District Judge, United States District Court for the District of Delaware, sitting by designation.

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for the first time the merits of Appellant Click-to-Call Technologies, LP's ("CTC") contention that the Patent Trial and Appeal Board ("Board") erred in determining that an *inter partes* review ("IPR") petition challenging claims of CTC's patent was not time-barred under § 315(b).

We conclude that the Board committed legal error in rendering its § 315(b) determination, and reject the proposed, alternative grounds for affirmance. Because the subject petition was time-barred, the Board lacked jurisdiction to institute the IPR proceedings. Accordingly, we vacate the Board's Final Written Decision in *Oracle Corp. v. Click-to-Call Techs., LP*, No. IPR2013-00312, 2014 Pat. App. LEXIS 8333 (P.T.A.B. Oct. 28, 2014), Paper No. 52 (*Final Written Decision*), and remand with instructions to dismiss IPR2013-00312.

**I. BACKGROUND****A. The District Court Actions**

On June 8, 2001, Inforocket.Com, Inc. ("Inforocket"), the exclusive licensee of U.S. Patent No. 5,818,836 ("the '836 patent"), filed a civil action in the United States District Court for the Southern District of New York. Compl., *Inforocket.Com, Inc. v. Keen, Inc.*, CA No. 1:01-cv-05130-LAP (S.D.N.Y.), ECF No. 1 (*Inforocket Action*). Inforocket served a complaint asserting infringement of the '836 patent on defendant Keen, Inc. ("Keen") on September 14, 2001. Affidavit of Service, *Inforocket Action*, ECF No. 4.

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Shortly thereafter, Keen brought its own infringement suit against Inforocket based on U.S. Patent No. 6,223,165, which proceeded before the same district judge as the *Inforocket Action*. See generally *Keen, Inc. v. InfoRocket.com, Inc.*, CA No. 1:01-cv-8226-LAP, 2002 U.S. Dist. LEXIS 13640 (S.D.N.Y.) (*Keen Action*). In the *Keen Action*, the district court granted Inforocket's motion for summary judgment of noninfringement and entered judgment in favor of Inforocket in July 2002. See Order Granting Inforocket's Mot. for Summ. J., *Keen Action*, ECF No. 47; Judgment, *Keen Action*, ECF No. 48. Keen filed a Notice of Appeal to this court on August 23, 2002. Notice of Appeal, *Keen Action*, ECF No. 49.

In 2003, while its appeal was pending, Keen acquired Inforocket as its wholly-owned subsidiary. Thereafter, subject to the terms of the merger, Inforocket and Keen stipulated to a voluntary dismissal of both suits "without prejudice," and the district court dismissed both actions on the same day—March 21, 2003. See Stipulation and Order of Dismissal, *Inforocket Action*; Stipulation and Order of Dismissal, *Keen Action*.<sup>1</sup> Later in 2003, Keen changed its name to Ingenio, Inc. ("Ingenio").

On April 20, 2004, Ingenio requested *ex parte* reexamination of claims 1-21 of the '836 patent. The Director of the Patent & Trademark Office ("Director") granted Ingenio's request, and issued an *ex parte*

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1. The appeal in the *Keen Action* was also dismissed by agreement of the parties on March 19, 2003, under Fed. R. App. P. 42(b). *Keen, Inc. v. Inforocket.Com, Inc.*, 60 F. App'x 809 (Fed. Cir. 2003).

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reexamination certificate on December 30, 2008. Several claims were cancelled, others were determined to be patentable as amended, and new claims 22-30 were added.

Meanwhile, in late 2007, non-party AT&T announced its plan to acquire Ingenio and integrate Ingenio and YellowPages.com, also owned by AT&T. In January 2008, Ingenio was acquired by a subsidiary of AT&T Inc. and its name was changed to Ingenio, LLC (also “Ingenio”). In April 2012, AT&T sold its interest in YellowPages.com and Ingenio.

CTC subsequently acquired the ’836 patent, and, on May 29, 2012, asserted patent infringement claims against multiple parties in the United States District Court for the Western District of Texas. Compl., *Click-to-Call Techs. LP v. AT&T, Inc.*, No. 1:12-cv-00465-LY (W.D. Tex.), ECF No. 1 (*AT&T Action*); Compl., *Click-to-Call Techs. LP v. Oracle Corp.*, No. 1:12-cv-00468-LY (W.D. Tex.), ECF No. 1 (*Oracle Action*). Among the defendants named in the *AT&T Action* was Ingenio, which subsequently changed its name to YP Interactive LLC (“YP Interactive”). Both the *AT&T Action* and the *Oracle Action* are currently stayed.

**B. The IPR Proceedings**

On May 28, 2013, Ingenio, together with Oracle Corp., Oracle OTC Subsidiary LLC, and YellowPages.com LLC (together, “Petitioners” or “Appellees”),<sup>2</sup> filed a

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2. As we discuss in Section II(D)(2), *infra*, Petitioners identified themselves as a singular “Petitioner” in their IPR

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single IPR petition challenging claims of the '836 patent on anticipation and obviousness grounds. CTC filed its Preliminary Response on August 30, 2013, contending, among other things, that § 315(b) statutorily barred institution of IPR proceedings, and that Ingenio lacked standing under 37 C.F.R. § 42.101(b). In its Preliminary Response, CTC presented evidence that Ingenio was served with a complaint alleging infringement of the '836 patent in 2001.

The Board held a conference call with counsel for CTC and Petitioners in September 2013, in part to discuss CTC's § 315(b) argument. The Board then issued an order pursuant to 37 C.F.R. § 42.5 in which it requested additional briefing addressing the terms of the dismissal of the *Inforocket Action*. Both parties submitted additional briefing in compliance with the Board's request.

The Board issued its Institution Decision on October 30, 2013. With respect to the § 315(b) issue, the Board

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petition. For simplicity, we refer to the collective as "Petitioners" in this Opinion. We use this convention even though Oracle Corp. and Oracle OTC Subsidiary LLC filed an unopposed motion to withdraw from further participation in this appeal on June 14, 2018, after settling their disputes with CTC. *See* Mot. to Withdraw, No. 15-1242 (Fed. Cir. June 14, 2018), ECF No. 121. These entities noted that their "motion does not affect the participation of the non-Oracle Appellees, YellowPages.com LLC and YP Interactive LLC, in this appeal." *Id.* at 1. As neither the other Petitioners' participation in this appeal nor the outcome of this case would be affected by granting the Oracle entities' requested relief, we granted their motion. *See* Order Granting Mot. to Withdraw, No. 15-1242 (Fed. Cir. July 24, 2018), ECF No. 123.



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acknowledged that Ingenio was served with a complaint alleging infringement of the '836 patent on June 8, 2001 and found CTC's timeline of events "helpful in determining whether Ingenio, LLC is barred from filing an *inter partes* review of the '836 patent." J.A. 287. The Board then recited the language of § 315(b), and stated that the "statute requires that the service date of the complaint be more than one year before the petition was filed—in this case more than one year before May 28, 2013." J.A. 288.

Notwithstanding the above, the Board concluded that CTC "has not established that service of the complaint in the [*Inforocket Action*] bars Ingenio, LLC from pursuing an *inter partes* review for the '836 patent" because that infringement suit was "dismissed voluntarily without prejudice on March 21, 2003, pursuant to a joint stipulation under Fed. R. Civ. P. 41(a)." J.A. 288-89. The Board wrote that "[t]he Federal Circuit consistently has interpreted the effect of such dismissals as leaving the parties as though the action had never been brought," citing this court's decisions in *Graves v. Principi*, 294 F.3d 1350 (Fed. Cir. 2002), and *Bonneville Associates, Ltd. Partnership v. Barram*, 165 F.3d 1360 (Fed. Cir. 1999). J.A. 289. The Board also relied on Wright & Miller's Federal Practice and Procedure treatise for the proposition that, "as numerous federal courts have made clear, a voluntary dismissal without prejudice under Rule 41(a) leaves the situation as if the action never had been filed." J.A. 289 (quoting 9 Wright, Miller, Kane, and Marcus, Federal Prac. & Proc. Civ. § 2367 (3d ed.)). The Board concluded by determining that "the dismissal of the infringement suit brought by Inforocket against Keen—now Ingenio,

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LLC—nullifies the effect of the service of the complaint and, as a consequence, does not bar Ingenio, LLC or any of the other Petitioners from pursuing an *inter partes* review of the '836 patent.” J.A. 289. In light of this determination, the Board did not address the following two contingent questions: (1) whether the patent at issue in the *Inforocket Action* is the same patent at issue in the IPR due to amendments made in the interim; and (2) whether § 315(b)’s time bar should be determined on a “petitioner-by-petitioner” basis. J.A. 289-90.

CTC requested rehearing of this § 315(b) determination, but the Board denied its request. CTC filed its Patent Owner Response on January 16, 2014, addressing the merits of Petitioners’ unpatentability arguments and again requesting dismissal of the petition because the Board lacked statutory authority to review the '836 patent under § 315(b), and because Petitioners lacked standing under 37 C.F.R. § 42.101(b).

The Board issued its Final Written Decision on October 28, 2014, reaffirming its conclusion that Petitioners were not barred from filing an IPR petition by stating that, “because [the *Inforocket Action*] was dismissed without prejudice, Federal Circuit precedent interprets such a dismissal as leaving the parties in the same legal position as if the underlying complaint had never been served.” *Final Written Decision*, 2014 Pat. App. LEXIS 8333 at \*13, at \*7. The Board also determined that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 either were anticipated by or would have been obvious in view of certain prior art references. 2014 Pat. App. LEXIS

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8333, at \*14. Those merits determinations are not at issue in this appeal.

**C. The History of this Appeal**

CTC filed its Notice of Appeal on November 25, 2014, and briefing commenced shortly thereafter. In April 2015, the Director intervened solely to address the § 315(b) time bar issue. *See* Intervenor Docketing Statement, No. 15-1242 (Fed. Cir. Apr. 1, 2015), ECF No. 28.

On October 12, 2015, counsel for Appellees submitted a Rule 28(j) letter informing the court of our decision in *Achates Reference Publishing, Inc. v. Apple Inc.*, 803 F.3d 652 (Fed. Cir. 2015), arguing that *Achates* mandates dismissal of the appeal for lack of appellate jurisdiction. Rule 28(j) Citation of Suppl. Authority, No. 15-1242 (Fed. Cir. Oct. 12, 2015), ECF No. 64. In light of *Achates*, this panel subsequently waived oral argument, and, on November 12, 2015, issued an order dismissing CTC's appeal for lack of jurisdiction. *Click-to-Call Techs., LP v. Oracle Corp.*, 622 F. App'x 907 (Fed. Cir. 2015) (per curiam) (*Click-to-Call I*).

CTC petitioned for writ of certiorari, and, on June 27, 2016, the Supreme Court granted the petition, vacated this court's judgment in *Click-to-Call I*, and remanded for further consideration in light of its opinion in *Cuozzo. Click-to-Call Techs., LP v. Oracle Corp.*, 136 S. Ct. 2508, 195 L. Ed. 2d 837 (2016). We directed the parties to file supplemental briefs and the parties complied with our directive.

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On September 21, 2016, counsel for Appellees filed a second letter regarding supplemental authority, this time informing the court of our decision in *Wi-Fi One, LLC v. Broadcom Corp.*, 837 F.3d 1329 (Fed. Cir. 2016). Rule 28(j) Citation of Suppl. Authority, No. 15-1242 (Fed. Cir. Sept. 21, 2016), ECF No. 83. In this letter, Appellees argued that, because *Wi-Fi One* confirmed that *Achates* remained good law, CTC's appeal should again be dismissed for lack of appellate jurisdiction. We agreed with Appellees that we were bound by our precedents in *Wi-Fi One* and *Achates*, and on November 17, 2016, dismissed CTC's appeal for a second time. *Click-to-Call Techs., LP v. Oracle Corp.*, No. 15-1242, 2016 U.S. App. LEXIS 20592, 2016 WL 6803054 (Fed. Cir. Nov. 17, 2016) (*Click-to-Call II*).

On December 5, 2016, CTC filed a petition for *en banc* rehearing, principally arguing that *Achates* and *Wi-Fi One* should be overruled. Pet. for Reh'g *En Banc*, No. 15-1242 (Fed. Cir. Dec. 5, 2016), ECF No. 91. Less than one month later, CTC's wish was partially granted when this court agreed to consider *en banc* whether it should overrule *Achates* and hold that judicial review is available for a patent owner to challenge the Director's determination that the petitioner satisfied the timeliness requirement of 35 U.S.C. § 315(b). Order, *Wi-Fi One, LLC v. Broadcom Corp.*, 851 F.3d 1241 (Fed. Cir. 2017) (*en banc*), ECF No. 67. The panel in this case subsequently held CTC's petition for rehearing in abeyance pending the outcome of *Wi-Fi One*.

On January 8, 2018, we issued our *en banc* decision in *Wi-Fi One*, expressly overruling *Achates* and holding that time-bar determinations under § 315(b) are appealable.

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878 F.3d at 1367. We subsequently granted CTC’s petition for rehearing *en banc*, which we construed as a petition for panel rehearing, and authorized supplemental briefing regarding the merits of the Board’s compliance with § 315(b). Order, No. 15-1242 (Fed. Cir. Jan. 19, 2018), ECF No. 99. CTC, Petitioners, and the Director, as Intervenor, all filed supplemental briefs in February and March of this year.

We have jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

## II. DISCUSSION

### A. Section 315(b) and Voluntary Dismissals Without Prejudice

The principal question on appeal is whether the Board erred in interpreting the phrase “served with a complaint alleging infringement of [a] patent” recited in § 315(b) such that the voluntary dismissal without prejudice of the civil action in which the complaint was served “does not trigger” the bar. *Final Written Decision*, 2014 Pat. App. LEXIS 8333 at \*13. We hold that it did.<sup>3</sup>

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3. The *en banc* court formed of PROST, *Chief Judge*, NEWMAN, LOURIE, DYK, MOORE, O’MALLEY, REYNA, WALLACH, TARANTO, CHEN, HUGHES, and STOLL, *Circuit Judges*, considered whether 35 U.S.C. § 315(b)’s time bar applies to bar institution when an IPR petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice. The *en banc* court holds that § 315(b)’s time bar applies in such a scenario.

*Appendix D***1. Legal Standards**

We review the Board’s statutory interpretation pursuant to *Chevron, U.S.A., Inc. v. NRDC*, 467 U.S. 837, 104 S. Ct. 2778, 81 L. Ed. 2d 694 (1984), *Auer v. Robbins*, 519 U.S. 452, 117 S. Ct. 905, 137 L. Ed. 2d 79 (1997), and *United States v. Mead Corp.*, 533 U.S. 218, 229-30, 121 S. Ct. 2164, 150 L. Ed. 2d 292 (2001). *Chevron* requires that a court reviewing an agency’s construction of a statute it administers first discern “whether Congress has directly spoken to the precise question at issue.” 467 U.S. at 842. If the answer is yes, the inquiry ends, and the reviewing court must give effect to Congress’s unambiguous intent. *Id.* at 842-43. If the answer is no, the court must consider “whether the agency’s answer [to the precise question at issue] is based on a permissible construction of the statute.” *Id.* at 843. The agency’s “interpretation governs in the absence of unambiguous statutory language to the contrary or unreasonable resolution of language that is ambiguous.” *United States v. Eurodif S.A.*, 555 U.S. 305, 316, 129 S. Ct. 878, 172 L. Ed. 2d 679 (2009) (citing *Mead*, 533 U.S. at 229-30).

When a statute expressly grants an agency rulemaking authority and does not “unambiguously direct[ ]” the agency to adopt a particular rule, the agency may “enact rules that are reasonable in light of the text, nature, and purpose of the statute.” *Cuozzo*, 136 S. Ct. at 2142 (citing *Mead*, 533 U.S. at 229, and *Chevron*, 467 U.S. at 843). When the Director does adopt rules, “[w]e accept the [Director’s] interpretation of Patent and Trademark Office regulations unless that interpretation is plainly

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erroneous or inconsistent with the regulation.” *In re Sullivan*, 362 F.3d 1324, 1326 (Fed. Cir. 2004) (quoting *Eli Lilly Co. v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1266 (Fed. Cir. 2003) (citing *Auer*, 519 U.S. at 461-62, and *Bowles v. Seminole Rock & Sand Co.*, 325 U.S. 410, 414, 65 S. Ct. 1215, 89 L. Ed. 1700 (1945))) (internal quotations omitted).

Where an agency instead engages in “interpretive,” rather than “formal,” rulemaking, a lower level of deference might apply. *See Mead*, 533 U.S. at 230-31 (describing notice-and-comment as “significant . . . in pointing to *Chevron* authority”); *Reno v. Koray*, 515 U.S. 50, 61, 115 S. Ct. 2021, 132 L. Ed. 2d 46 (1995) (according “some deference” to an interpretive rule that “do[es] not require notice and comment” (citations omitted)). The Supreme Court has explained that “[t]he fair measure of deference to an agency administering its own statute has been understood to vary with circumstances, and courts have looked to the degree of the agency’s care, its consistency, formality, and relative expertness, and to the persuasiveness of the agency’s position.” *Mead*, 533 U.S. at 228 (footnotes omitted) (citing *Skidmore v. Swift & Co.*, 323 U.S. 134, 139-40, 65 S. Ct. 161, 89 L. Ed. 124 (1944)).

## 2. *Chevron* Step One

We begin our analysis of the Board’s interpretation of § 315(b) by construing the provision. “As in any case of statutory construction, our analysis begins with the language of the statute.” *Hughes Aircraft Co. v. Jacobson*, 525 U.S. 432, 438, 119 S. Ct. 755, 142 L. Ed. 2d 881 (1999)

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(internal quotation marks and citation omitted). “The first step ‘is to determine whether the language at issue has a plain and unambiguous meaning with regard to the particular dispute in the case.’” *Barnhart v. Sigmon Coal Co., Inc.*, 534 U.S. 438, 450, 122 S. Ct. 941, 151 L. Ed. 2d 908 (2002) (quoting *Robinson v. Shell Oil Co.*, 519 U.S. 337, 340, 117 S. Ct. 843, 136 L. Ed. 2d 808 (1997)). In doing so, we “must read the words ‘in their context and with a view to their place in the overall statutory scheme.’” *King v. Burwell*, \_\_\_ U.S. \_\_\_, 135 S. Ct. 2480, 2489, 192 L. Ed. 2d 483 (2015) (quoting *FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 133, 120 S. Ct. 1291, 146 L. Ed. 2d 121 (2000)). This is because statutory “[a]mbiguity is a creature not of definitional possibilities but of statutory context.” *Brown v. Gardner*, 513 U.S. 115, 118, 115 S. Ct. 552, 130 L. Ed. 2d 462 (1994). Importantly, we may not conclude that a statutory provision is ambiguous until we conclude that resort to all standard forms of statutory interpretation are incapable of resolving any apparent ambiguity which might appear on the face of the statute. *See Chevron*, 467 U.S. at 843 n.9. And, in discerning whether a statute is ambiguous, we must take care not to weigh competing policy goals, for “[i]t is Congress’s job to enact policy and it is th[e] [c]ourt’s job to follow the policy Congress has prescribed.” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1358, 200 L. Ed. 2d 695 (2018).

**a. Plain and Unambiguous Language**

We “[s]tart where the statute does.” *SAS*, 138 S. Ct. at 1355. Section 315(b), titled “Patent Owner’s Action,” provides that an IPR “may not be instituted if the petition requesting the proceeding is filed more than 1 year after



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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.” 35 U.S.C. § 315(b) (emphasis added). The statute does not contain any exceptions or exemptions for complaints served in civil actions that are subsequently dismissed, with or without prejudice. Nor does it contain any indication that the application of § 315(b) is subject to any subsequent act or ruling. Instead, the provision unambiguously precludes the Director from instituting an IPR if the petition seeking institution is filed more than one year after the petitioner, real party in interest, or privy of the petitioner “is served with a complaint” alleging patent infringement. Simply put, § 315(b)’s time bar is implicated once a party receives notice through official delivery of a complaint in a civil action, irrespective of subsequent events.

The “ordinary, contemporary, common meaning[s]” of the operative terms “served” and “complaint” support the understanding that it is wholly irrelevant to the § 315(b) inquiry whether the civil action in which the complaint was filed is later voluntarily dismissed without prejudice. Black’s Law Dictionary defines “serve” as “[t]o make legal delivery of (a notice or process)” or “[t]o present (a person) with a notice or process as required by law,” and defines “service” as “[t]he formal delivery of a writ, summons, or other legal process[.]” Black’s Law Dictionary 1491 (9th ed. 2009). It defines “complaint” as “[t]he initial pleading that starts a civil action and states the basis for the court’s jurisdiction, the basis for the plaintiff’s claim, and the demand for relief.” *Id.* at 323. These definitions confirm that the plain meaning of the phrase “served with a complaint” is “presented with a complaint” or “delivered a

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complaint” in a manner prescribed by law. Indeed, at least one Board decision has interpreted the phrase “served with a complaint” in precisely this manner: “the legally-charged text ‘served with a complaint’ is used ordinarily in connection with the official delivery of a complaint in a civil action.” *Amkor Tech., Inc. v. Tesser, Inc.*, No. IPR2013-00242, slip op. at 9 (P.T.A.B. Jan. 31, 2014), Paper No. 98.

This reading of § 315(b) is confirmed by our *en banc* decision in *Wi-Fi One*, in which we held that the provision sets forth a “condition precedent to the Director’s authority to act,” based on the “timely filing of a petition.” 878 F.3d at 1374. Indeed, we observed that, “if a petition is not filed within a year after a real party in interest, or privy of the petitioner is served with a complaint, it is time-barred by § 315(b), and the petition *cannot be rectified* and *in no event* can IPR be instituted.” *Id.* at 1374 n.9 (emphases added). This is so because § 315(b)’s time bar concerns “real-world facts that limit the agency’s authority to act under the IPR scheme,” reflecting Congress’s “balancing [of] various public interests.” *Id.* at 1374; *see id.* at 1377 (O’Malley, J., concurring) (explaining that “§ 315(b) codifies one of the ‘important procedural rights’ that Congress chose to afford patent owners in the IPR context” (quoting *Lindhahl v. Office of Pers. Mgmt.*, 470 U.S. 768, 791, 105 S. Ct. 1620, 84 L. Ed. 2d 674 (1985))). It is impossible to square *Wi-Fi One*’s “cannot be rectified” and “in no event” language with the possibility that subsequent events in the civil action might operate to “nullify” service of the complaint for the purpose of § 315(b)’s time bar.<sup>4</sup>

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4. Although the stipulations of dismissal in this case were jointly entered by the predecessors of both CTC and Ingenio,

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Moreover, adopting the Board’s preferred construction of the phrase “served with a complaint” in § 315(b) “would impose additional conditions not present in the statute’s text.” *Return Mail, Inc. v. U.S. Postal Serv.*, 868 F.3d 1350, 1363 (Fed. Cir. 2017) (citing *Norfolk Dredging Co. v. United States*, 375 F.3d 1106, 1111 (Fed. Cir. 2004), for its holding that courts must avoid “add[ing] conditions” to the applicability of a statute that do not appear in the provision’s text). Congress specifically addressed the effect of a dismissal of an IPR petitioner’s district court action in § 315(a)(2), but did not include any similar language in § 315(b). Congress also demonstrated that it knew how to provide an exception to the time bar by including a second sentence in the provision: “The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).” 35 U.S.C. § 315(b). Similarly, Congress could have chosen to include a variation of the phrase “unless the action in which the complaint was served was later dismissed without prejudice,” but it did not do so. We reject the Board’s effort to graft this additional language into § 315(b). *Cf. Return Mail*, 868 F.3d at 1363 (rejecting

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we acknowledge that plaintiffs in civil suits can seek dismissal without prejudice pursuant to Rule 41(a)(1) of the Federal Rules of Civil Procedure in certain circumstances without a court order and without any involvement by the defendant. This reality does not alter our conclusion that the subsequent dismissal of a civil action is irrelevant to whether a petitioner, real party in interest, or privy of the petitioner was previously “served with a complaint” within the meaning of § 315(b). To the extent the parties debate whether the Board’s interpretation of § 315(b) results in good policy, “who should win that debate isn’t our call to make.” *SAS*, 138 S. Ct. at 1358.

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appellant’s argument, in part, because “Congress could have easily specified the phrase ‘sued for infringement’ to require being sued for infringement under 35 U.S.C. § 271 or otherwise excluded [28 U.S.C.] § 1498 suits from the definition of ‘sued for infringement,’ but it did not do so”).

**b. Legislative History**

The legislative history of § 315(b) further supports the understanding that its time bar concerns only the date on which the complaint was formally served. For example, during the March 2011 Senate debates, Senator Kyl made clear that, under the version of § 315(b) then being considered, “if a party has been sued for infringement and wants to seek *inter partes* review, he *must do so* within 6 months of *when he was served* with the infringement complaint.” 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (emphases added). This unequivocal reference to the date on which an accused infringer was served suggests that Congress did not contemplate subsequent events “nullifying” § 315(b)’s time bar.

The legislative history also clarifies that Congress chose the date of service, as opposed to some other event, as the trigger for § 315(b)’s time bar because service of a complaint is the seminal notice-conferring event in a district court action. As the Supreme Court has explained, “the core function of service is to supply *notice* of the pendency of a legal action, in a manner and at a time that affords the defendant a fair opportunity to answer the complaint and present defenses and objections.”

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*Henderson v. United States*, 517 U.S. 654, 672, 116 S. Ct. 1638, 134 L. Ed. 2d 880 (1996) (emphasis added). During the September 2011 Senate debates, Senator Kyl offered the following justification for extending the previously contemplated six-month time bar to one year. He observed that companies, in particular those in the high-technology sector, “are often sued by [patentees] asserting multiple patents with large numbers of vague claims, making it difficult to determine in the first few months of the litigation which claims will be relevant and how those claims are alleged to read on the defendant’s products.” 157 Cong. Rec. S5429 (daily ed. Sept. 8, 2011) (statement of Sen. Kyl). Recognizing that “[c]urrent law imposes no deadline on seeking *inter partes* reexamination,” he reasoned that, “in light of the present bill’s enhanced estoppels, it is important that the section 315(b) deadline afford defendants a *reasonable opportunity to identify and understand* the patent claims that are relevant to the litigation.” *Id.* (emphasis added). Congress, in “balancing various public interests,” decided to use the “real-world fact[]” of when a petitioner, real party in interest, or privy of the petitioner was “served with a complaint” to trigger § 315(b). *Wi-Fi One*, 878 F.3d at 1374.

**c. Conclusion Regarding *Chevron* Step One**

“Because a statute’s text is Congress’s final expression of its intent, if the text answers the question, that is the end of the matter.” *Timex V.I., Inc. v. United States*, 157 F.3d 879, 882 (Fed. Cir. 1998) (citations omitted); *see also* *Cuozzo*, 136 S. Ct. at 2142 (“Where a statute is clear, the

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agency must follow the statute.”). Here, the text of § 315(b) clearly and unmistakably considers only the date on which the petitioner, its privy, or a real party in interest was properly served with a complaint. Because “the statutory language is unambiguous and ‘the statutory scheme is coherent and consistent,’” our inquiry ceases and we need not proceed to *Chevron*’s second step. *Barnhart*, 534 U.S. at 450 (quoting *Robinson*, 519 U.S. at 340). Simply put, there is no gap to fill or ambiguity to resolve: “[w]here a statute’s language carries a plain meaning, the duty of an administrative agency is to follow its commands as written, not to supplant those commands with others it may prefer.” *SAS*, 138 S. Ct. at 1355 (citing *Soc. Sec. Bd. v. Nierotko*, 327 U.S. 358, 369, 66 S. Ct. 637, 90 L. Ed. 718 (1946)).

## **2. The Board’s Contrary Reasoning Is Unpersuasive**

Notwithstanding the absence of any facial ambiguity in the phrase “served with a complaint,” the Board concluded that CTC “has not established that service of the complaint in the infringement suit brought by Inforocket against Keen bars Ingenio, LLC from pursuing an *inter partes* review for the ’836 patent.” JA. 288. To support this conclusion, the Board wrote that the “Federal Circuit consistently has interpreted the effect of such dismissals as leaving the parties as though the action had never been brought,” and cited this court’s decisions in *Graves*, 294 F.3d at 1356, and *Bonneville*, 165 F.3d at 1364, and a section of Wright and Miller’s Federal Practice and Procedure treatise. *Id.* The Board concluded

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that, “[a]ccordingly, the dismissal of the infringement suit brought by Inforocket against Keen—now Ingenio, LLC—*nullifies the effect of the service* of the complaint and, as a consequence, does not bar Ingenio, LLC or any of the other Petitioners from pursuing an *inter partes* review of the ’836 patent.” *Id.* (emphasis added).

The Board misunderstood that the text of § 315(b) is agnostic as to the “effect” of the service—i.e., what events transpired after the defendant was served. The provision only probes whether the petitioner, real party in interest, or privy of the petitioner *was* served with a complaint alleging patent infringement more than one year before the IPR petition was filed. We reject the Board’s interpretation of § 315(b) for this reason alone.

Even if the provision could fairly be read to consider the “effect” of service—which it cannot—the Board’s reliance on the cited authorities was erroneous.<sup>5</sup> We interpret the Board’s reasoning as presupposing that the phrase “served with a complaint” is a legal term of art with some latent ambiguity, necessitating the reliance on additional interpretive aids. Assuming *arguendo* that the phrase is ambiguous, none of the authorities on which the Board relied help resolve this ambiguity because they each concern fundamentally different contexts, and consequently shed no light on “whether *service* of a complaint can be nullified.” *Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*, 817 F.3d 1293, 1301 (Fed. Cir.

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5. We ignore for the purpose of this appeal whether the Board improperly placed the burden of demonstrating that the IPR petition was time-barred on CTC, the patent owner.

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2016) (recognizing that “we have held in other cases that dismissals without prejudice leave the parties as though the action had never been brought,” but questioning “whether *service* of a complaint can be nullified”).

Both *Bonneville* and *Graves* concern the dismissal of an appeal in a first proceeding and the extent to which that dismissal impacts the appellant’s ability to initiate a later proceeding. In the former, *Bonneville*, after receiving an adverse decision from a contracting officer, filed a notice of appeal with the General Services Administration Board of Contract Appeals, but thereafter “withdr[e]w” its notice of appeal pursuant to the Board’s rules to “pursue its appeal in the U.S. Claims Court.” *Bonneville*, 165 F.3d at 1362. Before the Board actually dismissed the appeal without prejudice—under the condition that the dismissal would transform into one with prejudice unless *Bonneville* reinstated its appeal in three years—*Bonneville* brought suit in the Claims Court. *Id.* The Claims Court, however, dismissed the suit, holding that *Bonneville*’s filing of the appeal to the Board constituted an election of remedies that barred *Bonneville* from subsequently invoking the court’s jurisdiction. *Id.*

We affirmed the Claims Court’s dismissal, *id.*, and ten days later, *Bonneville* sought to reinstate its appeal to the Board, arguing that it was complying with the three-year deadline set forth in the Board’s dismissal order, *id.* at 1363. But the Board “applied the same principle that the federal courts had applied in construing the similar provision governing voluntary dismissals without prejudice in Federal Rule of Civil Procedure 41(a), namely,



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that an appeal so dismissed ‘leaves the situation as if the suit had never been brought.’” *Id.* The Board therefore concluded that,

because Bonneville voluntarily caused its appeal to be dismissed without prejudice in order to pursue the appeal in another forum, Bonneville is placed in the same position as if the first appeal had never been filed. The second filing does not relate back to the date of the first filing. Moreover, as the second complaint filed on December 29, 1994 is a “new appeal” filed after the expiration of the CDA ninety-day time limit, it is untimely. We lack jurisdiction to hear this appeal.

*Id.*

We affirmed the Board’s dismissal, finding no plain error in the Board’s decision to treat Bonneville’s dismissal without prejudice the same way that federal courts would have treated it under Rule 41(a). *Id.* at 1364. We then disagreed with Bonneville’s criticism of the Board’s rule as a “legal fiction,” writing that its rule “merely states the *consequence* of a voluntary dismissal without prejudice, namely, that the appellant cannot thereafter resurrect the appeal after the statute of limitations on the cause of action has run.” *Id.* (emphasis added).

*Graves* likewise concerns an appellant’s effort to seek relief a second time beyond a limitations period. After *Graves* received an adverse decision from the

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Board of Veterans' Appeals, he, proceeding *pro se*, timely appealed to the U.S. Court of Appeals for Veterans Claims ("Veterans Court"). 294 F.3d at 1353. He thereafter retained counsel, who filed in the Veterans Court a document requesting dismissal without prejudice, but neither mentioning any rules of the Veterans Court nor indicating that Graves intended to seek reconsideration of the Board's decision. *Id.* The Veterans Court thereafter dismissed the appeal pursuant to Rule 42 of its Rules of Practice and Procedure. *Id.*

Graves then asked the Board to reconsider its initial decision, and after the Board denied this request, Graves appealed both the initial decision and the denial of his request for reconsideration to the Veterans Court. *Id.* The Veterans Court dismissed this appeal for lack of jurisdiction on the ground that it was untimely, pointing out that, pursuant to 38 U.S.C. § 7266(a), Graves was required to file his notice of appeal with the Veterans Court within 120 days of the date the Board mailed its initial decision to him. *Id.* Citing an earlier decision, the Veterans Court observed that, if Graves had filed a motion for reconsideration with the Board within the 120-day judicial appeal period, the finality of the initial Board decision "would have been abated" and a new 120-day period would have begun to run on the date that the Board mailed him a denial of his motion for reconsideration. *Id.*

We affirmed, writing that "[t]he most fundamental problem" facing Graves "is the fact that, as a matter of law, once his appeal was dismissed—for whatever purpose and whether with or without prejudice—it was as if the appeal

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had never been filed.” *Id.* at 1355-56. We noted that, in *Bonneville*, “the nullifying effect of a voluntary dismissal in accordance with Fed. R. Civ. P. 41(a)(1) was applied in the context of a General Services Administration Board of Contract Appeals dismissal,” and concluded that “the rule is equally applicable to voluntary dismissals under Rule 42 of the Veterans Court.” *Id.* at 1356. Thus, once Graves dismissed his initial appeal, “the Veterans Court no longer had jurisdiction over the action” and he “was barred from appealing” the Board’s decision because “he was in the same situation that he would have been in if he had never filed a notice of appeal.” *Id.*

These two cases are inapplicable to the issue presented in this appeal. Both concern whether an appellant’s filing of a notice of appeal and subsequent dismissal of that appeal “tolls” the jurisdictional deadline to appeal from the decision below. The cases, relying on the principle that “[t]he effect of a voluntary dismissal without prejudice pursuant to Rule 41(a) ‘is to *render the proceedings a nullity* and leave the parties as if the action had never been brought,’” *Bonneville*, 165 F.3d at 1364 (emphasis added) (quoting *Williams v. Clarke*, 82 F.3d 270, 273 (8th Cir. 1996)), answer this question in the negative. More broadly, the background legal principle in these cases is that a party’s voluntary dismissal of its action or appeal will not toll a statute of limitations, and, as a result, a subsequently filed action or appeal must still be brought within the original limitations period.

Here, by contrast, the appropriate question is whether the voluntary, without prejudice dismissal of a

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civil action in which a complaint had been served nullifies an administrative time bar that is triggered by service of that complaint. It does not. Yet the Board, without explanation, extended the background principle of *Graves* and *Bonneville* to conclude that such a dismissal “nullifies the effect of the service of the complaint.” It then relied on this erroneous conclusion to “un-ring” § 315(b)’s time bar. In effect, the Board relied on cases holding that the voluntary dismissal of an action or appeal does *not* toll a statute of limitations to conclude that the voluntary dismissal without prejudice of a civil action *does* indefinitely toll § 315(b) and permitted an otherwise untimely IPR to proceed, turning *Bonneville* and *Graves* on their head.

These cases do not delve into the meaning of the terms “serve” or “complaint,” nor do they hold that the voluntary, without prejudice dismissal of a civil action transforms the ordinary meaning of the phrase “served with a complaint” into something else. Although we “presume that ‘Congress intended to retain the substance of the common law’” when “a statute covers an issue previously governed by the common law,” *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 538, 133 S. Ct. 1351, 185 L. Ed. 2d 392 (2013) (quoting *Samantar v. Yousuf*, 560 U.S. 305, 320, n.13, 130 S. Ct. 2278, 176 L. Ed. 2d 1047 (2010)), where the statutory scheme is clear, we are not to “invent an atextual explanation for Congress’s drafting choices,” *SAS*, 138 S. Ct. at 1357.

Where, moreover, the proposed atextual explanation is the alleged existence of a “background legal principle,”

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that principle must both be firmly established and unequivocal before it can justify ignoring the plain text of the statute. The background legal principle on which Petitioners and the Director rely—that a “dismissal without prejudice leaves the parties in the same legal position as if the underlying complaint had never been filed,” for all purposes, Appellees Suppl. Br. 3—is anything but unequivocal. 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. Indeed, a voluntary dismissal without prejudice (1) may give rise to costs and fees under Rule 11, *see* Wright & Miller, Federal Prac. & Proc. Civ. §§ 1336, 2367; (2) forbids the filing of a subsequent action “based on or including the same claim” under Rule 41(a)(1)(B); and (3) may establish the necessary case or controversy for a later declaratory judgment action, *see Transweb, LLC v. 3M Innovative Props. Co.*, 812 F.3d 1295, 1300 (Fed. Cir. 2016) (“After 3M voluntarily dismissed [its] suit due to an apparent personal jurisdiction issue, TransWeb filed suit in New Jersey for declaratory judgment.”). The Director itself acknowledges that the filing of a patent infringement complaint, even if later voluntarily dismissed, can play a role in proving the defendant’s knowledge of the patent if charged with willful infringement. Intervenor’s Second Suppl. Br. 8. And counsel for Petitioners admitted at oral argument that § 315(b) “appears to be unique relative to the other cases cited in that it involves the act of service triggering a limitations period,” suggesting that there is no pertinent “background legal principle” that might alter our view of the plain and ordinary meaning of the

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phrase “served with a complaint.” Oral Arg. at 22:13-22:29, *available at* <http://oralarguments.cafc.uscourts.gov/default.aspx?fl=2015-1242.mp3>.<sup>6</sup>

For all of these reasons, we conclude that a defendant served with a complaint as part of a civil action that is voluntarily dismissed without prejudice remains “served” with the “complaint.” This remains true even if that action becomes a “nullity” for other purposes and even if such service becomes legally irrelevant in a subsequent court action.

**B. Petitioners’ Alternative Arguments**

Petitioners also argue that, even if the Board erred in concluding that the voluntary dismissal of the district court action rendered § 315(b) inapplicable because the dismissal “nullifie[d] the effect of the service,” the institution of the IPR proceeding was nevertheless proper for two independent reasons. Although CTC initially posited that subsidiary factual questions precluded us from deciding in the first instance the merits of Petitioners’ alternative arguments, Reply Br. 24, the parties (but not the Director) now agree that no further fact-finding is required. We

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6. The background legal principle on which the Director and Petitioners rely cannot be as absolute as they contend. We have little doubt that a contract clearly and unambiguously providing for a payment to be due upon service of a complaint would render such payment due, and remaining due, upon service of a complaint that is later dismissed without prejudice. A statutory bar that is clearly and unambiguously triggered by service of a complaint, such as § 315(b), is to the same effect.

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therefore address these arguments in turn. *See Killip v. Office of Pers. Mgmt.*, 991 F.2d 1564, 1568-69 (Fed. Cir. 1993) (recognizing, in the context of a Merit Systems Protection Board case, that we may “affirm the Board on grounds other than those relied upon in rendering its decision, when upholding the Board’s decision does not depend upon making a determination of fact not previously made by the Board”).

**1. The Impact of *Ex Parte* Reexamination**

Petitioners first contend that, because the claims of the ’836 patent were materially changed during a subsequent *ex parte* reexamination, neither they nor any other entity was served with a complaint alleging infringement of *this* patent more than one year before the IPR petition was filed. *See* Appellees Br. 8, 19-21. In particular, they claim that, “[b]ecause each claim of the reexamined patent substantively differs from the claims of the original patent, the reexamined ’836 patent should be treated as a new patent for purposes of § 315(b).” *Id.* at 21.

Petitioners are mistaken. “Unlike reissue, reexamination does not result in the surrender of the original patent and the issuance of a new patent.” *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1341-42 (Fed. Cir. 2012). Indeed, the relevant provision provides that a reexamination certificate “incorporat[es] *in the patent* any proposed amended or new claim determined to be patentable.” 35 U.S.C. § 307(a) (emphasis added). Petitioners’ reliance on 35 U.S.C. § 307(b) is unavailing. That provision simply means that any amended

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or new claim incorporated in a reexamined patent has the same effect as that specified in 35 U.S.C. § 252 for a reissued patent only with respect to so-called “intervening rights.” In other words, § 307(b) statutorily protects the ability of a “person or that person’s successors in business” to continue to use, offer for sale, or sell anything protected by the amended or new claims, provided such actions do not infringe a valid claim of the reexamined patent that was in the original patent. *Compare* 35 U.S.C. § 307(b), *with* 35 U.S.C. § 252. Congress could have included in any of 35 U.S.C. §§ 252, 307(b), or 315(b) language regarding the effect of reexamination on the deadline to file an IPR—it chose not to do so.

Petitioners’ emphasis on alleged differences in claim scope misunderstands that § 315(b) does not speak in terms of claims. Instead, the provision asks on what date the petitioner, real party in interest, or privy of the petitioner “is served with a complaint alleging infringement *of the patent*,” making clear that the timeliness analysis is to be made with reference to “the patent.” The Director agrees with this conclusion. *See* Intervenor Second Suppl. Br. 10 n.3.

Even if we were to hold that § 315(b) is ambiguous with respect to whether the term “the patent” includes reexamined patents having amended or new claims of “substantively differ[ent]” scope than the original claims, we would still reject Petitioners’ argument that the time bar does not apply here. We have held that, “in the absence of a clear showing that such a material difference in fact exists in a disputed patentable reexamination claim, it can



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be assumed that the reexamined claims will be a subset of the original claims and that no new cause of action will be created.” *Senju Pharm. Co., Ltd. v. Apotex Inc.*, 746 F.3d 1344, 1353 (Fed. Cir. 2014). We reached this holding after asking whether “it is possible that a reexamination could ever result in the issuance of new patent claims that were so materially different from the original patent claims as to create a new cause of action, but at the same time were sufficiently narrow so as not to violate the rule against reexamined claims being broader than the original claims.” *Id.* Petitioners did not make any showing in the IPR proceeding that the amended or new claims of the ’836 patent are “materially different” than the original claims, and we reject their unsupported effort to do so for the first time on appeal.

For these reasons, we reject Petitioners’ effort to deem the reexamined ’836 patent a “new patent” for § 315(b) purposes.

## **2. The Relevance of “Non-Barred” Petitioners**

Petitioners also submit that, even if § 315(b)’s time bar applies to YP Interactive, it would not apply to YellowPages.com, Oracle Corporation, or Oracle OTC Subsidiary LLC. According to Petitioners, because YellowPages.com was not in privity with YP Interactive or its predecessors “before at least 2008,” YellowPages.com never had any opportunity, as a privy or otherwise, to participate in the *Inforocket Action* or *Keen Action*, which were voluntarily dismissed years earlier. Appellees Br. 24.

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They also submit that the Oracle entities were not parties, real parties in interest, or privies of Ingenio with respect to these earlier proceedings. In Petitioners' view, these arguments are relevant because, if these entities *had* filed separate petitions, those petitions would not have been time barred under § 315(b). Moreover, they submit that, *had* YP Interactive filed a separate petition, the Director *could* have joined its petition with the hypothetical non-barred petitions pursuant to 35 U.S.C. § 315(c), rendering any error in the Board's § 315(b) determination vis-à-vis YP Interactive harmless.

We reject these efforts to separate YP Interactive from the other Petitioners to save the petition as to the latter. We need not scrutinize the legal relationships between YellowPages.com, Oracle Corporation, and Oracle OTC Subsidiary LLC, on the one hand, and Ingenio/YP Interactive, on the other, to address Petitioners' arguments. These four entities declared themselves as "the Petitioner" in their sole IPR petition, and certified that Ingenio (now YP Interactive) is a "real party in interest." J.A. 345. In these circumstances, under current law, Petitioners are properly treated as an undifferentiated unit that filed an untimely petition.

Section 315(b) and the implementing regulation both treat a petition as if there is a single petitioner for purposes of the one-year rule. Section 315(b) bars institution of an IPR where "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

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of the patent.” 35 U.S.C. § 315(b) (emphases added). The governing regulation, which largely parrots § 315(b), is to the same effect:

[a] person who is not the owner of a patent may file with the [Patent & Trademark Office] a *petition* to institute an [IPR] of the patent *unless* . . . [t]he *petition* requesting the proceeding is filed more than one year after the date on which the petitioner, the petitioner’s real party-in-interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent.

37 C.F.R. § 42.101(b) (emphases added). Both the statute and the regulation ask only two questions: (1) when was “the petition” filed; and (2) when was “the petitioner,” the petitioner’s real party in interest, or a privy of the petitioner served with a complaint? They do not differentiate between multiple petitioners.

We read section 315(b), as implemented by the existing regulation, to apply petition-by-petition, not petitioner-by-petitioner, with the collection of petitioners on a single petition treated as a unit indistinguishable from each member of that collection. This reading of the statutory and regulatory reference to the singular “the petitioner” for the one-year time bar is supported by the fact that, in the same statutory scheme, Congress expressly recognized the possibility of multiple petitioners and permitted separate treatment of them for different purposes. *See, e.g.*, 35 U.S.C. § 317(a) (addressing

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continuation of IPR as to some petitioners after dismissal of others). In concluding that this is the best reading of the statute and its parroting regulation, we are not deciding whether the statute is ambiguous and could permissibly be implemented through a different regulation providing for separate treatment of multiple petitioners in assessing timeliness under the one-year time bar—a distinct question that would arise if the Director newly adopted such a regulation. *See Nat’l Cable & Telecomms. Ass’n v. Brand X Internet Servs.*, 545 U.S. 967, 982-85, 125 S. Ct. 2688, 162 L. Ed. 2d 820 (2005) (holding that, where a court determines the “best reading” of a provision without finding an “unambiguous” meaning, the *Chevron* step one question is not answered, and an agency having *Chevron* authority may adopt a different statutory position and have it tested under the *Chevron* framework).<sup>7</sup>

Under the unitary-entity interpretation of section 315(b) and its implementing regulation, the petition at issue here was untimely. “The petitioner” (all four

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7. Were the Director or Board merely to interpret (rather than change) the current regulation to allow separate treatment of co-petitioners for § 315(b) purposes, that interpretation would not be owed deference in light of our interpretation of the existing regulation, given the statute-parroting nature of this regulation. *See Gonzales v. Oregon*, 546 U.S. 243, 257, 126 S. Ct. 904, 163 L. Ed. 2d 748 (2006) (ruling that “the existence of a parroting regulation does not change the fact that the question here is not the meaning of the regulation but the meaning of the statute,” and “[a]n agency does not acquire special authority to interpret its own words when, instead of using its expertise and experience to formulate a regulation, it has elected merely to paraphrase the statutory language”).

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petitioners considered collectively) filed the single petition more than one year after YP Interactive (operating under the name Keen), which is itself both “the petitioner” and a real party in interest, was served with a complaint alleging infringement of the ’836 patent. The Director was therefore barred from instituting this IPR based on this petition.

Because this IPR was not instituted properly, the final written decision was entered contrary to a statutory command and must be set aside. Petitioners cite nothing to support a conclusion that the error in instituting on this petition could be deemed harmless just because a different petition might have been filed that would have permitted institution of a different IPR to review the same patent claims. Indeed, that circumstance would often be the case, since any “person who is not the owner of a patent” may file a petition for an IPR. 35 U.S.C. § 311(a). Accordingly, what matters here is whether *this* petition provided a lawful basis upon which to institute this IPR. *Cf. SAS*, 138 S. Ct. at 1358 n.\* (explaining that the possible existence of a different path to the same agency result—there, partial institution—did not validate the path actually followed). Section 315(b), as implemented by the current regulation, is best understood to answer that question no.

Petitioners’ additional reliance on §§ 315(c) and 317(a) in an effort to save this petition as to some petitioners does not persuade. Petitioners’ § 315(c) theory would seem to be that the petition may be viewed as having been filed solely by the Oracle and YellowPages.com petitioners and merely joined by YP Interactive, so that the timeliness

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determination could disregard YP Interactive. Petitioners' § 317(a) theory would seem to be that YP Interactive might be dropped from the IPR, leaving only the other petitioners, as to which the Board may continue. As already noted, however, the availability of a path not taken does not validate the path actually taken. *SAS*, 138 S. Ct. at 1358 n.\*. Although § 315(b) provides that its time bar “shall not apply to a request for joinder under subsection (c),” it is undisputed that no such “request for joinder” was made in this case. Indeed, the regulation governing joinder requires that “[a]ny request for joinder *must* be filed . . . no later than one month after the institution date of any [IPR] for which joinder is requested.” 37 C.F.R. § 42.122(b) (emphasis added). This one-month deadline, which the Director imposed by regulation after notice and comment, *Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, 77 Fed. Reg. 48,680-01, 48,681, 2012 WL 3276880 (Aug. 14, 2012), has long since passed.<sup>8</sup>

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8. We recognize that a number of Board panels have constrained joinder in apparent recognition of a tension between §§ 315(b) and (c). Where an otherwise time-barred petitioner seeks to join an IPR under § 315(c), Board panels consistently have granted such requests only under limiting conditions, such as (1) that the party seeking joinder “maintain a secondary role in the proceeding,” *Pfizer, Inc. v. Biogen, Inc.*, No. IPR2017-01115, 2017 WL 3081981 (P.T.A.B. July 18, 2017), Paper No. 13; or (2) that they appear in the IPR proceeding and attend depositions and oral hearing, but not file papers, engage in discovery, or participate in any deposition or oral hearing, *Ion Geophysical Corp. v. WesternGeco LLC*, No. IPR2015-00565, 2015 WL 1906173, at \*4 (P.T.A.B. Apr. 23, 2015), Paper No. 14. There was no such limitation on YP Interactive’s participation in this IPR.

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Similarly, while § 317(a) permits the termination of IPR proceedings that have been instituted “with respect to any petitioner”—and even permits the Office to “proceed to a final written decision” where “no petitioner remains in the *inter partes* review”—such termination can only occur “upon the joint request of the petitioner and the patent owner unless the Office has decided the merits of the proceeding before the request for termination is filed.” No joint request for termination was made in this case. The fact that Congress afforded petitioners the opportunity to settle with patent owners after institution does not address the predicate question of whether the IPR was properly instituted in the first place.

Further support for our reading of § 315(b) is found in decisions of the Board’s own panels. In *Terremark North America LLC v. Joao Control & Monitoring Systems, LLC*, No. IPR2015-01482, 2015 Pat. App. LEXIS 12695 (P.T.A.B. Dec. 28, 2015), Paper No. 10, the panel confronted a situation involving multiple petitioners seeking institution of an IPR, in which some but not all of the petitioners were time-barred. In that case, CoxCom was the only petitioner that was not served with a complaint more than one year before the IPR petition was filed. 2015 Pat. App. LEXIS 12695, at \*19. The petitioners argued that, because CoxCom was not time-barred, § 315(b) should not apply to the jointly filed IPR petition. *Id.* The Board rejected this argument based on the reasoning set forth in an earlier decision, *PNC Bank, N.A. v. Maxim Integrated Products, Inc.*, No. CBM2014-00041, 2014 WL 2536982, at \*2 (P.T.A.B. June 3, 2014), Paper No. 19, in which the Board denied institution of CBM review where PNC Bank was “both a petitioner . . . and a real party in

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interest,” and previously filed a civil action challenging the validity of claims of the challenged patent. *Id.* at \*2. This set of facts resulted in institution being barred under § 325(a)(1), notwithstanding that other named petitioners were not barred by this provision. *Id.* The Board held that, as a result, “§ 325(a)(1) precludes institution of a review in this proceeding,” notwithstanding that other named petitioners were not barred by this provision. *Id.*

Notably, the Board also considered, but rejected, the petitioners’ argument that § 325(a)(1) would not bar institution if PNC were to “forswear all further control and participation in this case” or have adverse judgment entered against it, permitting the other petitioners to proceed without its involvement.<sup>9</sup> *Id.* The Board reasoned that, because “PNC has already exerted substantial control over the case” and because “granting PNC’s request for adverse judgment would not obviate the control that PNC has already exerted in this proceeding by its filing of the Petition,” ruling upon PNC’s motion for judgment “would not alter [its] conclusion that § 325(a)(1) precludes institution of a CBM review as requested in the Petition.” *Id.*<sup>10</sup>

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9. 37 C.F.R. § 42.73(b) provides that “[a] party may request judgment against itself at any time during a proceeding.”

10. At oral argument, counsel for the Director was unable to articulate why the fact that *PNC* involved CBM review, rather than an IPR, was relevant, given that the applicable statutes are similarly worded. *See* Oral Arg. at 33:45-33:55. Nor did counsel for the Director or for Petitioners explain why additional fact-finding (or remand) would be necessary on the issue of Ingenio/YP Interactive’s control over or active involvement in this IPR proceeding.



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Turning back to *Terremark*, the Board there wrote that the non-CoxCom petitioners, like PNC, “already have exerted substantial control over the case by participating in filing the Petition, appointing counsel, etc.,” and therefore “[t]he presence of CoxCom . . . does not remove the statutory bar.” 2015 Pat. App. LEXIS 12695, at \*21. Here, too, “removing” Ingenio/YP Interactive from the IPR would not alter the fact that it has participated for several years in this proceeding in violation of § 315(b). Appellees’ unsupported assertion that there is nothing about the relationship between these parties that indicates control over the other joint petitioners by Ingenio/YP Interactive does not change our view. Where the parties choose to be joint petitioners in a single petition, the petition must—under current law—be assessed in light of that choice.

In conclusion, to the extent Petitioners rely on §§ 315(b), 315(c), and 317(a) to argue that the Board’s institution of IPR proceedings in this case was “harmless,” we have made clear that “[t]he timely filing of a petition under § 315(b) is a condition precedent to the Director’s authority to act”—indeed, it “sets limits on the Director’s statutory authority to institute.” *Wi-Fi One*, 878 F.3d at 1374. There is nothing “harmless” about the institution of this IPR in excess of statutory authority and contrary to “the law’s demands.” *SAS*, 138 S. Ct. at 1359.

Finally, we conclude that a remand for consideration of this multi-petitioner issue is not warranted. Neither Petitioners nor CTC seek a remand for further Board proceedings. That fact is significant not only because of the IPR regime’s general policy of expedition, *see* 35 U.S.C.

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§§ 314(b), 316(a)(11), but also because the IPR regime creates “a party-directed, adversarial process” rather than an “agency-led, inquisitorial process,” *SAS*, 138 S. Ct. at 1355. After all, “it’s the petitioner, not the Director, who gets to define the contours of the proceeding.” *Id.*

Only the Director suggests a remand on this issue. But the Director identifies no material facts requiring further development on remand. And, the Director has not explained exactly what the Board might wish to, or be able to, consider on remand. The issue in this case thus raises only a legal question, and under current law, including the current regulation, the answer to the legal question is already determined in this opinion. The Board must follow the governing regulations, *see, e.g., Crediford v. Shulkin*, 877 F.3d 1040, 1047 (Fed. Cir. 2017), and it must follow our binding interpretation where, because the regulation merely parrots the statute, deference is not owed even to the Director’s interpretation of the regulation, much less to a Board panel’s interpretation, *see supra* n.6 (quoting *Gonzales v. Oregon*). *See In re Lovin*, 652 F.3d 1349, 1353-54 (Fed. Cir. 2011) (discussing *Brand X* and agency’s duty to follow judicial interpretation of regulations generally, but deferring to intervening change of regulation). It is conceivable that the Director might promulgate a new regulation during remand—though the Director has not even taken a position on this issue, much less suggested that a regulation is on the horizon, and there would be a question about retroactive application of any such changed regulation. *See Bowen v. Georgetown Univ. Hosp.*, 488 U.S. 204, 208-09, 109 S. Ct. 468, 102 L. Ed. 2d 493 (1988). We know of no authority or sound basis to support a

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remand to allow for a possible intervening change of law, especially in the context of a statute prizing expedition. We therefore vacate the Board's *Final Written Decision* and remand so the Board can dismiss this IPR proceeding. We leave Petitioners to litigate the merits of the '836 patent in the long-stayed district court case, where there will be no estoppel bar to such litigation, as CTC has expressly conceded.

**III. CONCLUSION**

For the foregoing reasons, we vacate the Board's *Final Written Decision* and remand for the Board to dismiss IPR2013-00312.

**VACATED AND REMANDED****COSTS**

Costs to Click-to-Call Technologies, LP.

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TARANTO, *Circuit Judge*, concurring.

I join the panel’s opinion in full. Here I add a few thoughts on why I am unpersuaded by the key rationales set forth in the dissent from the court’s *en banc* holding.

The *en banc* issue is governed by statutory language that, as the panel opinion explains, is plain in its meaning. In September 2001, Ingenio (then called Keen) was served with a complaint asserting that it infringed the ’836 patent, and there is no dispute about the content of the complaint or the propriety of service. In 2013, Ingenio filed a petition for an *inter partes* review (IPR)—far more than one year after the 2001 service. With respect to the *en banc* issue, those facts make § 315(b)’s time bar applicable by its plain terms. Nothing in that language makes relevant whether the 2001 complaint was eventually dismissed voluntarily without prejudice; the fact that service occurred does not change when the complaint (or action) is later dismissed, whether voluntarily or otherwise, and whether with or without prejudice to the right to file another action on the same claims. No other provision of the statute calls for a different conclusion. Indeed, whereas Congress in § 315(a)(2)(C) specifically addressed the effect of a voluntary dismissal of an IPR petitioner’s own district court complaint challenging a patent, Congress left § 315(b) unmodified by any language addressed to dismissals of patentees’ complaints.

This is not a case where the scope of a word or phrase in the statute, considered alone and in context, “may be open to competing interpretations” as in *Kasten v. Saint-*

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*Gobain Performance Plastics Corp.*, 563 U.S. 1, 7, 131 S. Ct. 1325, 179 L. Ed. 2d 379 (2011), and *Dolan v. U.S. Postal Service*, 546 U.S. 481, 486, 126 S. Ct. 1252, 163 L. Ed. 2d 1079 (2006). In *Kasten*, the Court addressed a genuine textual issue about whether the phrase “filed any complaint” in 29 U.S.C. § 215(a)(3) encompasses an oral complaint or instead requires a writing. 563 U.S. at 7. In *Dolan*, the Court addressed a genuine textual issue about whether the phrase “negligent transmission” of the mail, when read in the context of the statute, encompassed what might be the last act of the transmission—a negligent placement of a package on a porch. 546 U.S. at 486.

Numerous authorities state that statutory language as plain in its meaning as to an issue as is § 315(b), when read alone and in context, is controlling on that issue, subject to very narrow exceptions. *See, e.g., SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1357, 200 L. Ed. 2d 695 (2018) (“We need not and will not invent an atextual explanation for Congress’s drafting choices when the statute’s own terms supply an answer. *See United States v. Ron Pair Enterprises, Inc.*, 489 U.S. 235, 240-41, 109 S. Ct. 1026, 103 L. Ed. 2d 290 (1989) ([A]s long as the statutory scheme is coherent and consistent, there generally is no need for a court to inquire beyond the plain language of the statute’).” (alteration in original) (unofficial reporter citations omitted)); *Cyan, Inc. v. Beaver Cty. Employees Ret. Fund*, 138 S. Ct. 1061, 1072, 200 L. Ed. 2d 332 (2018) (“Even assuming clear text can ever give way to purpose, [the Director] would need some monster arguments on this score to create doubts about [§ 315(b)’s] meaning.”); *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct.

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1002, 1010, 197 L. Ed. 2d 354 (2017); *Sebelius v. Cloer*, 569 U.S. 369, 381, 133 S. Ct. 1886, 185 L. Ed. 2d 1003 (2013) (“when [a] statute’s language is plain, the sole function of the courts—at least where the disposition required by the text is not absurd—is to enforce it according to its terms”) (alteration in original) (internal quotation marks omitted); *Gross v. FBL Fin. Servs., Inc.*, 557 U.S. 167, 175, 129 S. Ct. 2343, 174 L. Ed. 2d 119 (2009); *Barnhart v. Sigmon Coal Co.*, 534 U.S. 438, 450, 122 S. Ct. 941, 151 L. Ed. 2d 908 (2002); *Board of Governors of Fed. Reserve Sys. v. Dimension Fin. Corp.*, 474 U.S. 361, 368, 106 S. Ct. 681, 88 L. Ed. 2d 691 (1986).

I see no basis strong enough to justify the proposed contrary-to-text result urged by the Director—that § 315(b) becomes inapplicable when the complaint whose service would otherwise bar the IPR was dismissed voluntarily without prejudice under Rule 41(a) of the Federal Rules of Civil Procedure. Respecting § 315(b)’s plain meaning leaves the statutory scheme “coherent and consistent,” *Barnhart*, 534 U.S. at 450; *Ron Pair Enters.*, 489 U.S. at 240, and without “absurd” results, *Sebelius*, 569 U.S. at 381. I therefore agree that the Director’s position must be rejected and the task of making any advisable adjustments left to Congress.

**I**

The principal rationale offered to support the Director’s position is that a background rule of law exists that Congress must have intended to modify § 315(b)’s plain meaning. The asserted “rule” is that “[t]he effect of

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a voluntary dismissal without prejudice pursuant to Rule 41(a) is to render the proceedings a nullity and leave the parties as if the action had never been brought.” *Bonneville Assocs., Ltd. P’ship v. Barram*, 165 F.3d 1360, 1364 (Fed. Cir. 1999) (*Bonneville II*) (alteration in original) (internal quotation marks omitted). This court has also stated the point in terms seemingly applicable even to an *involuntary* dismissal without prejudice. *Graves v. Principi*, 294 F.3d 1350, 1356-57 (Fed. Cir. 2002) (“[A]s a matter of law, once his appeal was dismissed—for whatever purpose and whether with or without prejudice—it was as if the appeal had never been filed. . . . The dismissal of an action without prejudice leaves the parties as though the action had never been brought.”). The Director invokes those formulations as providing a “solidly grounded rule” of civil procedure, *Greenlaw v. United States*, 554 U.S. 237, 250, 128 S. Ct. 2559, 171 L. Ed. 2d 399 (2008), that Congress must have understood would override the contrary plain meaning of § 315(b) by nullifying the time-bar effect of service of a complaint if that complaint is later voluntarily dismissed without prejudice.

But this court has already observed that the cases articulating an “as if never brought” principle do not “address § 315(b) or whether *service* of a complaint can be nullified.” *Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.*, 817 F.3d 1293, 1301 (Fed. Cir. 2016). And even aside from the distinction between nullifying the effect of a complaint’s service and nullifying the effect of a complaint’s filing, the case law invoked by the Director (and the dissent) does not justify overriding the plain meaning of the § 315(b) bar.

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The fundamental problem with the Director’s position is that it takes judicial language used as explanation in particular contexts and mistakenly treats the language as establishing a rule sweeping enough to apply to the § 315(b) context. That is a mistake here because the federal courts do not *always* treat a voluntary, without-prejudice dismissal as leaving the dismissed action without legal effect. Only for some purposes does a voluntary, without-prejudice dismissal leave the dismissed action without legal effect, as if it had never been brought; for other purposes, the dismissed action continues to have legal effect. And the legal effect at issue for § 315(b)—triggering the start of a clock for filing an action—has never been in the first category. The Director has noted that he knows of no case holding that a voluntary, without-prejudice dismissal of a complaint nullifies the statutory effect of the filing of that complaint (or, here, of its service) of starting a clock on initiating another proceeding. Oral Arg. at 30:08-31:20. We cannot soundly infer a nontextual exception to § 315(b)’s plain-meaning application based on a nullification principle that has not been applied, and certainly is not established, in the clock-starting situation present here.

**A**

Some of this court’s and other courts’ cases deny certain legal effects to the filing of a complaint later voluntarily dismissed without prejudice. One such effect concerns what is needed to *satisfy* (or toll) a time limit on initiating an action or appeal. The rationale is simple. A particular case or appeal must *itself* be initiated within a prescribed time. A filing that initiated an earlier case or



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appeal, if voluntarily dismissed without prejudice, does not meet, or toll the running of the clock for meeting, the time limit for filing the document that initiates the later (even substantively identical) case.

This court so held in *Bonneville II*, a government-contract dispute in which Bonneville timely appealed to the General Services Administration Board of Contract Appeals; voluntarily dismissed that appeal to pursue relief in the Claims Court instead; was denied a forum for lack of jurisdiction there (as this court held in *Bonneville Assocs. v. United States*, 43 F.3d 649, 655 (Fed. Cir. 1994) (*Bonneville I*)); and then returned to the Board by filing a new appeal. This court in *Bonneville II* held that the new appeal was untimely because the earlier Board appeal did not count to meet the applicable time limit for an appeal to the Board. 165 F.3d at 1363-65. In the same vein, we held in *Graves* that the time limit for appealing to the Veterans Court, 38 U.S.C. § 7266(a), had to be met by the notice of appeal initiating that appeal, and could not be met by an earlier, voluntarily dismissed notice of appeal from the same Board of Veterans' Appeals decision. 294 F.3d at 1355-56. Other circuits' decisions are to the same effect in not allowing the satisfaction, or tolling, of a limitations period by an earlier filing that is voluntarily dismissed without prejudice.<sup>1</sup>

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1. See, e.g., *Jorge v. Rumsfeld*, 404 F.3d 556, 563 (1st Cir. 2005) (“[A] prescriptive period is not tolled by filing a complaint that is subsequently dismissed without prejudice.”); *Garfield v. J.C. Nichols Real Estate*, 57 F.3d 662, 666 (8th Cir. 1995) (“A dismissal without prejudice does not toll a statute of limitations.”); *Beck v. Caterpillar Inc.*, 50 F.3d 405, 407-08 (7th Cir. 1995) (holding that

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But the § 315(b) *en banc* issue does not involve the legal effect of the type at issue in the cases just described. A legal effect of that type would be at issue if an IPR petitioner filed a petition within the one-year period, voluntarily dismissed the petition without prejudice,

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the statute of limitations was not tolled and continued to run when plaintiff voluntarily dismissed his first suit under Rule 41(a)); *Simons v. Sw. Petro-Chem, Inc.*, 28 F.3d 1029, 1030 (10th Cir. 1994) (holding that the plaintiff’s Title VII claim was not timely filed because her earlier case that was voluntarily dismissed without prejudice under Rule 41(a)(2) did not toll the statutory limitations period); *Robinson v. Willow Glen Acad.*, 895 F.2d 1168, 1169 (7th Cir. 1990) (holding that a tolling provision under Wisconsin state law that was tied to the “commencement of an action” did not apply if that action was then voluntarily dismissed under Rule 41(a)(2)); *Davis v. Smith’s Transfer, Inc.*, 841 F.2d 139, 140 (6th Cir. 1988) (per curiam) (no tolling of statute of limitations based on earlier suit dismissed under Rule 41(a)); *Dupree v. Jefferson*, 666 F.2d 606, 610-11, 215 U.S. App. D.C. 43 (D.C. Cir. 1981) (taking note of the “rule” “that a statute of limitations is not tolled during pendency of an action voluntarily dismissed without prejudice”); *Curtis v. United Transp. Union*, 648 F.2d 492, 495 (8th Cir. 1981) (stating “the rule that the entry of a voluntary dismissal without prejudice leaves the action as if suit had never been brought for purposes of the statute of limitations”); *Humphreys v. United States*, 272 F.2d 411, 412 (9th Cir. 1959) (holding that a voluntary dismissal under Rule 41(a)(2) does not toll the statute of limitations under the Federal Tort Claims Act).

*See also Willard v. Wood*, 164 U.S. 502, 523, 17 S. Ct. 176, 41 L. Ed. 531 (1896) (noting “[t]he general rule in respect of limitations . . . that if . . . [an] action abates or is dismissed, and, during the pendency of the action, the limitation runs, the remedy is barred”); 8 Moore’s Fed. Prac. Civ. § 41.33(6)(d) (2018); 9 Charles A. Wright & Arthur R. Miller, Fed. Prac. & Proc. Civ. § 2367 (3d ed. 2018).

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then filed another IPR petition outside the period: the earlier (timely) petition would be disregarded in assessing the timeliness of the later petition. Here, there were no successive IPR petitions, and the issue is not whether a voluntarily dismissed filing could be treated as satisfying the one-year rule.

Rather, the issue is whether the 2001 service of a complaint asserting that Ingenio infringed the '836 patent should be treated as losing its clock-*starting* legal effect for filing an IPR before the Board, just because the properly served complaint was later voluntarily dismissed without prejudice. None of the just-cited cases involved that legal effect. Indeed, while those cases insist on *enforcing* a time limit on initiating legal proceedings for the same or similar claims brought by the same party in (usually) the same forum, the Director's position here would have the opposite effect of nullifying a time limit—and doing so based on the filing of different claims (invalidity, not infringement) by a different party (accused infringer, not patent owner) in a different forum (Board, not district court). In multiple ways, then, the main line of authority invoking the “as if never brought” rationale does not apply to the circumstances addressed by § 315(b).

The clock-starting effect that is at issue here is also different from certain other legal effects that are denied to a complaint once it has been voluntarily dismissed without prejudice. Notably, once a complaint has been voluntarily dismissed without prejudice, most further action in the very case initiated by that complaint is

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neither required nor permitted.<sup>2</sup> Relatedly, as indicated by the “without prejudice” language, invocation of issue or claim preclusion is generally not available based on the

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2. See, e.g., *In re Matthews*, 395 F.3d 477, 480 (4th Cir. 2005) (“[A]fter an action is voluntarily dismissed, the court lacks authority to conduct further proceedings on the merits.”); *Williams v. Clarke*, 82 F.3d 270, 272-73 (8th Cir. 1996) (holding that voluntary dismissal under Rule 41(a)(1) applies to habeas corpus petitions filed under 28 U.S.C. § 2254 and strips the appellate court of jurisdiction over the action); *Norman v. Arkansas Dep’t of Educ.*, 79 F.3d 748, 751 (8th Cir. 1996) (holding that after the district court dismissed the case without prejudice, it “lacked jurisdiction to take any further action in it, including dismissing the case with prejudice”); *Smith v. Dowden*, 47 F.3d 940, 943 (8th Cir. 1995) (holding that the voluntary dismissal of a claim in the bankruptcy court under Fed. R. Bankr. P. 3006 strips the bankruptcy court of its equitable jurisdiction and restores the dismissed party’s jury-trial right); *LeCompte v. Mr. Chip, Inc.*, 528 F.2d 601, 603 (5th Cir. 1976) (explaining that a plaintiff generally cannot appeal a voluntary dismissal without prejudice under Rule 41(a)(2), but may appeal if the order has the effect of being a dismissal with prejudice).

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action that was voluntarily dismissed without prejudice.<sup>3</sup> Those legal effects are not what is at stake here.

**B**

As just set forth, although a voluntary, without-prejudice dismissal has been held to eliminate some legal effects of a dismissed action, the clock-starting effect of § 315(b) is not among them. Nor does the law recognize a universal nullification rule that such a dismissal eliminates all legal effects of a dismissed action. To the contrary, in various circumstances, such a dismissed action has

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3. See, e.g., *Harvey Specialty & Supply, Inc. v. Anson Flowline Equip. Inc.*, 434 F.3d 320, 324 (5th Cir. 2005) (holding that a voluntary dismissal under Rule 41(a)(1) does not result in a final judgment that could support collateral estoppel or the relitigation exception under the Anti-Injunction Act); *AVX Corp. v. Cabot Corp.*, 424 F.3d 28, 32-34 (1st Cir. 2005) (holding that claim preclusion did not apply to claims that had been voluntarily dismissed under Rule 41(a)(1)(ii) by joint stipulation of the parties); *In re Corey*, 892 F.2d 829, 835 (9th Cir. 1989) (holding that a voluntary dismissal without prejudice “has no res judicata effect”); *In re Piper Aircraft Distrib. Sys. Antitrust Litig.*, 551 F.2d 213, 219-20 (8th Cir. 1977) (holding that the district court erred by giving preclusive effect to the denial of class action status under Rule 23(c) in another case that had been subsequently dismissed without prejudice pursuant to Rule 41(a)(1)(i), because there was no “valid and final judgment” necessary for “collateral estoppel”). Cf. *Navellier v. Sletten*, 262 F.3d 923, 938 (9th Cir. 2001) (finding no abuse of discretion in district court’s voluntary dismissal of claims under Rule 41(a)(2) and holding that the court did not have to inform the jury that the dismissed claims might later be refiled).

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continuing legal effects, *i.e.*, is *not* treated as if it had never been brought.

For example, Rule 41 itself makes clear that a first voluntary dismissal has an effect in forbidding a without-prejudice dismissal of a second action “based on or including the same claim.” Fed. R. Civ. P. 41(a)(1)(B). Rule 41 adds that a first such dismissal may give rise to a court-imposed requirement that the costs of the first action be paid as a precondition to litigation of a second action based on or including the same claim against the same defendant. Fed. R. Civ. P. 41(d). And a voluntary, without-prejudice dismissal may give rise to costs and fees under Rule 11. *See* Wright & Miller, §§ 1336, 2367.

Continuing effects are also evident in sources outside the Federal Rules of Civil Procedure. For example, as the Director appears to acknowledge, the filing of a patent infringement complaint, even if later voluntarily dismissed, can play a role, even a definitive role, in proving the defendant’s knowledge of the patent if the defendant is later charged with willful infringement. Intervenor’s Second Supp. Br. 8 (“[D]ismissing a complaint without prejudice could have ongoing legal consequences because, for example, the notice turns a defendant’s unwitting actions into intentional ones.”); *see also* Fed. R. Evid. 201(b)(2) (allowing judicial notice of facts from “sources whose accuracy cannot reasonably be questioned”). And as the panel opinion notes, the filing of such a complaint, though later voluntarily dismissed, has formed the basis for declaratory judgment jurisdiction where the initial defendant later brings a validity challenge: the initial

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action by the patentee may establish the necessary case or controversy for the later action. *See TransWeb, LLC v. 3M Innovative Props. Co.*, 812 F.3d 1295, 1300 (Fed. Cir. 2016).

Another continuing effect is evident in the context of 28 U.S.C. § 1500. The Supreme Court in *Keene v. United States* addressed the § 1500 bar on the Court of Federal Claims's jurisdiction over a case when, at the time of its filing, a sufficiently related action is pending in another court, and the Court held that the bar continues to apply even after the other court action has been voluntarily dismissed without prejudice. 508 U.S. 200, 203, 207-09, 113 S. Ct. 2035, 124 L. Ed. 2d 118 (1993); *see* Brief for the United States, *Keene Corp. v. United States*, No. 92-166, 1993 WL 290106, at \*3 (filed Jan. 25, 1993). The other court action, though voluntarily dismissed without prejudice, is not treated in that context as if it had never been brought.

Similarly, in *Flowers v. Secretary of the Department of Health and Human Services*, which involved a Vaccine Act provision barring certain benefits if a plaintiff had certain related actions pending, this court held that the bar applied even after the other actions were voluntarily dismissed without prejudice. 49 F.3d 1558, 1560-62 (Fed. Cir. 1995). The earlier actions were not treated as if never brought. And in *Bonneville I*, this court held that the Claims Court lacked jurisdiction over Bonneville's claim because Bonneville had initially brought an appeal to the Board and had therefore elected that forum—even though Bonneville had later obtained a voluntary, without-prejudice dismissal of its Board appeal. 43 F.3d at 651,

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653-55. The earlier action, though it had been voluntarily dismissed without prejudice, blocked the Claims Court case—the opposite of being treated as if it had never been brought.

**C**

In short, the background law on the nullification effect of a voluntary, without-prejudice dismissal is a mixed bag, and it does not state a near-monolithic rule with only aberrational exceptions. Some effects are nullified, some not. More particularly, it is anything but established—in fact, the Director has acknowledged the absence of any authority holding—that such a dismissal nullifies the legal effect at issue here: a clock-starting effect prescribed by statute. In these circumstances, I conclude, there is no basis in the asserted background law for overriding the plain meaning of § 315(b).

**II**

When the Director moves beyond his argument about background law, he presents nothing to indicate a clear congressional intent contrary to the plain meaning. Legislative history indications of congressional policy at most establish that § 315(b) is generally based on an assessment of the period suitable for a formally accused infringer (or privies or real parties in interest) to shape any IPR petition after formally receiving notice of a patentee's charges of infringement, with the patentee and district courts thereafter given repose against IPR petitions filed by that accused infringer (or privies or



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real parties in interest). *See* 157 Cong. Rec. S5429 (daily ed. Sept. 8, 2011) (statement of Sen. Kyl) (stating that the “section 315(b) deadline afford[s] defendants a reasonable opportunity to identify and understand the patent claims that are relevant to the litigation”); H.R. Rep. No. 112-98, at 48 (2011), *reprinted in* 2011 U.S.C.C.A.N. 67, 78 (expressing concern about use of IPR proceedings as a “tool[] for harassment” by “repeated litigation and administrative attacks”). Those policies do nothing to undermine the plain meaning of the text: a bright-line rule of one year from service is a sensible prescription for serving those purposes.<sup>4</sup>

The dissent suggests that, when an action is voluntarily dismissed without prejudice, “the accused infringer is led to think that the controversy has dissipated” and “the notice function of the filing is effectively eliminated.” Dissent at 11. Those suggestions, even if accepted on their own terms, do not establish the kind of incoherence or absurdity that would support adoption of an exception for voluntary dismissals without prejudice. Congress can

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4. Several legislators opposed § 315(b) in the House bill for exactly that reason, explaining that § 315(b)’s bright-line “12-month deadline” is not “tied to substantive progress in patent litigation, such as the entry of an order by the district court construing the relevant patent claims,” and arguing that a strict 12-month deadline is “arbitrary” as it “does not account for the complexity of many patent cases that can encompass dozens of patents and defendants and hundreds of separate patent claims.” H.R. Rep. No. 112-98, at 164-65. A proposed amendment offered by one of those legislators to tie the deadline to entry of a claim construction order failed. *Id.* at 58.

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sensibly choose a bright-line rule based on underlying notice concerns. In any event, the suggestions are, I think, weak on their own terms. The point of a dismissal “without prejudice” is to preserve, rather than eliminate, the ability of the plaintiff to sue the defendant again on the same claim. No defendant, if not given something more, such as a covenant not to sue, can reasonably understand a without-prejudice dismissal to give repose as to future assertion of that very patent; no defendant in that situation is entitled “to think that the controversy has dissipated.” Indeed, as already noted, the bringing of an infringement suit, even if later voluntarily dismissed, can play a role, even a decisive role, in establishing the case or controversy needed for the once-accused infringer to bring an action for a declaratory judgment.

The dissent and the Director (in the *Luminara* case to which the dissent refers) suggest another reason that the statutory purpose requires an exception to § 315(b) for service of a complaint that is later voluntarily dismissed without prejudice. Specifically, they suggest a possibility of manipulative abuse if § 315(b) is applied in accordance with its terms, without such an exception. Dissent at 12; Oral Arg. at 19:45-20:22, *Luminara Worldwide, LLC v. Iancu*, Nos. 17-1629, -1631, -1633 (Fed Cir. Apr. 5, 2018). The scenario of abuse is this: A patent owner could sue many possible infringers, serve them with complaints, and then quickly and unilaterally dismiss all of those cases under Rule 41(a)(1)(A)(i), which applies before the filing of an answer or motion for summary judgment. Such a unilateral dismissal would start the one-year IPR clock for all such defendants under § 315(b), were there

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no exception. After the year had elapsed without any of those defendants filing an IPR challenge, the patent owner could again sue any of them on the same patent, without fear of an IPR initiation by any of them (or their privies or real parties in interest), though others could file IPR challenges.

This hypothesized scenario cannot support the suggested inference that Congress, to avoid such abuse, must have silently prescribed an exception to § 315(b) for voluntary dismissals without prejudice. Notably, the scenario is purely hypothetical, as far as we know. We have been pointed to no evidence that any patent owners have behaved in the way posited.

“[T]he Court rarely invokes [an absurd results] test to override unambiguous legislation.” *Barnhart v. Sigmon Coal Co., Inc.*, 534 U.S. 438, 459, 122 S. Ct. 941, 151 L. Ed. 2d 908 (2002). The stringency of this test for overcoming plain meaning reflects a strong deference to the legislature as the institution for identifying and curing defects in laws. *See SAS*, 138 S. Ct. at 1358 (“whatever its virtues or vices, Congress’s prescribed policy here is clear”); Antonin Scalia & Bryan A. Garner, *Reading Law: The Interpretation of Legal Texts* 237-39 (2012) (explaining that “error-correction for absurdity can be a slippery slope” and that the absurdity doctrine should accordingly be narrow). I do not think that the merely hypothetical possibility of the abuse posited here makes the bright-line rule in § 315(b) absurd or incoherent. *Cf. Silva-Hernandez v. U.S. Bureau of Citizenship & Immigration Servs.*, 701 F.3d 356, 363-64 (11th Cir. 2012)

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(ruling that hypothetical scenarios did not show absurdity sufficient to reject a provision's plain meaning).

That is especially so because there are reasons to doubt the likely significance of the hypothesized scenario even beyond the fact that it has not yet shown up in reality. The scenario posits that the initially sued defendants, although already sued once on the patent, would decide to rely on the belief that they are substantially unlikely to be sued on it again—a premise that is dubious given that the initial dismissal was specifically without prejudice to the patentee's right to file again, there has been no covenant not to sue, and the posited legal stratagem for avoiding IPRs is apparent. Without such (doubtful) reliance, it is plausible that one or more of the defendants would initiate IPR challenges to the patent at issue within the one-year period, defeating the posited scheme of the patentee. The assumptions of legal ignorance, naiveté, or uniform fingers-crossed risk assessment seem strained.

The posited scenario also requires downplaying evident risks to the patentee of implementing the scheme. By suing many defendants in the first place, the patentee would be expanding the pool of persons objectively threatened by the patent, which would seem to increase the likelihood of an early IPR challenge and to lower the cost of an IPR for any individual defendant if the defendants file jointly. That risk to the patentee further diminishes the likelihood of the abuse scenario. So does the risk that the patentee would face sanctions—in the initial litigation or later litigation—for acting as posited in the scenario. *See Chambers v. NASCO, Inc.*, 501 U.S. 32, 46-47, 111 S.

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Ct. 2123, 115 L. Ed. 2d 27 (1991) (explaining that inherent power “extends to a full range of litigation abuses”); *Roadway Express, Inc. v. Piper*, 447 U.S. 752, 766, 100 S. Ct. 2455, 65 L. Ed. 2d 488 (1980) (discussing power to sanction the “willful[] abuse [of] judicial processes”); *Willy v. Coastal Corp.*, 503 U.S. 131, 136-37, 112 S. Ct. 1076, 117 L. Ed. 2d 280 (1992) (discussing sanction power even where court lacked jurisdiction); *Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384, 395-96, 110 S. Ct. 2447, 110 L. Ed. 2d 359 (1990) (post-dismissal sanction power); *Winslow v. Hunter (In re Winslow)*, 17 F.3d 314, 315 (10th Cir. 1994) (per curiam) (discussing sanctions for “a pattern of litigation activity which is manifestly abusive”) (quoting *Johnson v. Cowley*, 872 F.2d 342, 344 (10th Cir. 1989)).

Finally, and in any event, the hypothetical abuse scenario cannot support adoption of the particular judicial modification of § 315(b)’s plain terms proposed by the Director—which is a gross mismatch for the abuse scenario. The suggested exception to § 315(b) would go far beyond dismissals under Rule 41(a)(1)(A)(i), which are the only ones the plaintiff can effectuate unilaterally. The suggested exception would also cover voluntary, without-prejudice dismissals under Rule 41(a)(1)(A)(ii)—which are within the control of the defendant (later petitioner)—and under Rule 41(a)(2)—which are within the control of the court. Unilateral manipulation is not possible under those provisions: for all of those dismissals, the defendant and the court have power to protect against the posited abuse. (The present case involved a non-unilateral dismissal.) There is no basis for inferring, or adopting, a nontextual exception that extends far beyond a very limited scenario of merely hypothetical potential abuse.

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In sum, I think that the statutory issue in this case falls within the principle that “where the language of an enactment is clear, and construction according to its terms does not lead to absurd or impracticable consequences, the words employed are to be taken as the final expression of the meaning intended.” *United States v. Mo. Pac. R.R. Co.*, 278 U.S. 269, 278, 49 S. Ct. 133, 73 L. Ed. 322 (1929). If there turns out to be a problem in the statute’s application according to its plain meaning, it is up to Congress to address the problem.

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DYK, *Circuit Judge*, joined by LOURIE, *Circuit Judge*, dissenting.

The *en banc* issue in this case is whether the time bar of 35 U.S.C. § 315(b) applies when a petitioner is served with a complaint more than one year before the petition for *inter partes* review (“IPR”), but the complaint is dismissed without prejudice. *En banc* consideration was occasioned by the fact that two different panels reached opposite conclusions on this issue in this case and in *Luminara Worldwide, LLC, v. Matal*, No. 17-1629 (Fed. Cir. filed Feb. 13, 2018). The *en banc* court now agrees with the *Click-to-Call* panel and holds that section 315(b) applies, even when the earlier complaint was dismissed without prejudice.<sup>1</sup> In our view, the use of traditional tools of statutory construction leads to a conclusion opposite to the *en banc* court.

Section 315(b) provides that “*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 . . . is served with a complaint alleging infringement of the patent.” In our view, the Board’s interpretation of the statute was correct, and section 315(b)’s time-bar should not apply when the underlying suit has been voluntarily dismissed without prejudice. We reach this conclusion for three reasons.

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1. Contrary to the panel opinion (Panel Op. 14), this issue was not addressed, much less resolved, in the *en banc Wi-Fi* opinion. See *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018) (*en banc*).

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First, the panel opinion relies on the language of section 315(b) as being unambiguous, because, on its face, it does not exclude voluntary dismissals without prejudice. But, the meaning of “service of a complaint” is not on its face unambiguous. In closely comparable circumstances, the Supreme Court has held that it is necessary to look beyond the language, to the context and purpose of the statute. *Kasten v. Saint-Gobain Performance Plastics Corp.*, involved language in the Fair Labor and Standards Act (the “Act”). 563 U.S. 1, 7, 131 S. Ct. 1325, 179 L. Ed. 2d 379 (2011). The Act’s anti-retaliation section prevented employers from “discharg[ing] or in any other manner discriminat[ing] against any employee because such employee has *filed any complaint* . . . under or related to [the Act].” 29 U.S.C. § 215(a)(3) (emphasis added). The issue was whether an oral complaint fit within the language “filed any complaint.” *Kasten*, 563 U.S. at 7. The Court concluded “the text, taken alone, cannot provide a conclusive answer to our interpretive question . . . . We must look further.” *Id.* at 11. The Court examined how the words had been used by “legislators, administrators, and judges,” *id.* at 8, and reviewed “contemporaneous judicial usage,” *id.* at 9. These sources helped the Court conclude that oral complaints should qualify, because “considering the provision in conjunction with the purpose and context [led the Court] to conclude that only one interpretation is permissible.” *Id.* at 7.

This situation is similar. In this context, the concept of service and filing seem to be equivalent. Section 315(b)’s phrase, “served with a complaint,” is almost the same as the phrase “filed any complaint” at issue in *Kasten*.



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In *Kasten*, the issue was whether the complaint could include written and oral complaints, whereas the issue here is whether the complaint could include a complaint later voluntarily dismissed without prejudice. Both are situations where “[t]he definition of words in isolation,” is not “necessarily controlling,” or even clear in terms of ordinary meaning. *Dolan v. United States Postal Serv.*, 546 U.S. 481, 486, 126 S. Ct. 1252, 163 L. Ed. 2d 1079 (2006). Rather, “[i]nterpretation of [the] word or phrase depends upon reading the whole statutory text, considering the purpose and context of the statute, and consulting any precedents or authorities that inform the analysis.” *Id.*; see also *FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 132, 120 S. Ct. 1291, 146 L. Ed. 2d 121 (2000) (“In determining whether Congress has specifically addressed the question at issue, a reviewing court should not confine itself to examining a particular statutory provision in isolation. The meaning—or ambiguity—of certain words or phrases may only become evident when placed in context.”).

Second, a well-established background principle supports the PTO’s reading of the statute. Courts have typically treated voluntary dismissals without prejudice as restoring the parties to the situation that existed before the case had ever been brought. In *Bonneville Assocs. v. Barram*, 165 F.3d 1360, 1362-64 (Fed. Cir. 1999), an appeal to the General Services Administration Board of Contract Appeals had been voluntarily dismissed, and the question was whether the requirement of timely filing had been satisfied by the dismissed appeal. This made it necessary to “determine the effect of the voluntary dismissal of

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Bonneville’s appeal without prejudice.” *Id.* at 1364. Our court recognized that “[t]he rule in the federal courts is that ‘[t]he effect of a voluntary dismissal without prejudice pursuant to Rule 41(a) ‘is to render the proceedings a nullity and leave the parties as if the action had never been brought.’”” *Id.* (second alteration in original) (quoting *Williams v. Clarke*, 82 F.3d 270, 273 (8th Cir. 1996)). Thus, dismissal “leaves the situation as if the suit had never been brought.” *Id.* at 1363.

Similarly, in *Graves v. Principi*, 294 F.3d 1350, 1355-56 (Fed. Cir. 2002), we held that filing an appeal in Veterans Court did not toll the 120-day period for appeals from the decision of the Board of Veteran’s Appeals, when the appeal was voluntarily dismissed without prejudice. We held that “as a matter of law, once [the veteran’s] appeal was dismissed . . . it was as if the appeal had never been filed.” *Id.* We explained that the

dismissal of his initial appeal meant that Mr. Graves was barred from appealing the January 18, 1998 decision of the Board . . . because, in light of the dismissal, he was in the same situation that he would have been in if he had never filed a notice of appeal, and by June 18, 1998, the date of the dismissal, the 120-day period under section 7266(a) for filing a notice of appeal had passed.

*Id.* at 1356. We reiterated that “[t]he dismissal of an action without prejudice leaves the parties as though the action had never been brought.” *Id.*

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Other circuits have likewise treated dismissals without prejudice as restoring the parties to the exact situation as if the original complaint had never been filed. *See, e.g., Norman v. Ark. Dep't of Educ.*, 79 F.3d 748, 751 (8th Cir. 1996) (“[T]he ‘effect of a voluntary dismissal without prejudice is to render the proceedings a nullity and leave the parties as if the action had never been brought.’” (quoting *In re Piper Aircraft Distrib. Sys. Antitrust Litig.*, 551 F.2d 213, 219 (8th Cir. 1997))).<sup>2</sup> The understanding that dismissal without prejudice renders the original filing a “nullity” and restores the parties to the situation that would have prevailed if the original complaint had never been filed is supported by the leading federal practice treatise. *See* 9 CHARLES ALAN WRIGHT & ARTHUR R. MILLER, *FEDERAL PRAC. AND PROC.* § 2367 (3d. ed. 2018) (“[A]s numerous federal courts have made clear,

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2. *See also Harvey Specialty & Supply, Inc. v. Anson Flowline Equip. Inc.*, 434 F.3d 320, 324 (5th Cir. 2005) (“The effect of [a Rule 41(a)(1)] dismissal is to put the plaintiff in a legal position as if he had never brought the first suit.” (alteration in original) (quoting *LeCompte v. Mr. Chip, Inc.*, 528 F.2d 601, 603 (5th Cir. 1976))); *Navellier v. Sletten*, 262 F.3d 923, 938 (9th Cir. 2001) (“A dismissal without prejudice . . . leaves the parties where they would have stood had the lawsuit never been brought.” (citing *In re Corey*, 892 F.2d 829, 835 (9th Cir.1989))); *Beck v. Caterpillar, Inc.*, 50 F.3d 405, 407 (7th Cir. 1995) (“While [plaintiff’s] first lawsuit was filed within the limitations period, that suit was voluntarily dismissed . . . and is treated as if it had never been filed.”); *Simons v. Southwest Petro-Chem, Inc.*, 28 F.3d 1029, 1030-31 (10th Cir. 1994); *Humphreys v. United States*, 272 F.2d 411, 412 (9th Cir. 1959) (“[A] suit dismissed without prejudice pursuant to Rule 41(a)(2) leaves the situation the same as if the suit had never been brought in the first place.”).

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a voluntary dismissal without prejudice . . . leaves the situation as if the action never had been filed.”).

This rule has been applied in the closely comparable situation where a complaint dismissed without prejudice is held not to toll the statute of limitations, absent some evidence of a contrary legislative intent. *See Willard v. Wood*, 164 U.S. 502, 523, 17 S. Ct. 176, 41 L. Ed. 531 (1896) (“The general rule in respect of limitations must also be borne in mind, that if a plaintiff mistakes his remedy, in the absence of any statutory provision saving his rights, or where, from any cause, a plaintiff becomes nonsuit, or the action abates or is dismissed, and, during the pendency of the action, the limitation runs, the remedy is barred.”); *Jorge v. Rumsfeld*, 404 F.3d 556, 563 (1st Cir. 2005) (“[A] prescriptive period is not tolled by filing a complaint that is subsequently dismissed without prejudice.”); *Garfield v. J.C. Nichols Real Estate*, 57 F.3d 662, 666 (8th Cir. 1995) (“A dismissal without prejudice does not toll a statute of limitation.”); *Robinson v. Willow Glen Acad.*, 895 F.2d 1168, 1169 (7th Cir. 1990) (holding that a tolling provision triggered by the “commencement of an action” did not apply where a complaint was filed but was later voluntarily dismissed); *Davis v. Smith’s Transfer, Inc.*, 841 F.2d 139, 140 (6th Cir. 1988) (per curiam) (“The initial filing of plaintiff’s suit within the six-month time period is simply not the effective filing date of plaintiff’s suit because it was later dismissed by the plaintiff under Fed. R. Civ. P. 41(a). A suit, so dismissed, does not toll nor effect in any way the continuous running of the applicable statutory time period.”); *Dupree v. Jefferson*, 666 F.2d 606, 611, 215 U.S. App. D.C. 43 (D.C. Cir. 1981) (“We conclude,

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then, that the rule against tolling . . . applies with equal force to nonprejudicial dismissals, be they voluntary or involuntary.”); *Curtis v. United Transp. Union*, 648 F.2d 492, 495 (8th Cir. 1981) (“It is our view that Rule 54(b) does not provide an exception in this case to the rule that the entry of a voluntary dismissal without prejudice leaves the action as if suit had never been brought for purposes of the statute of limitations.”); *Bomer v. Ribicoff*, 304 F.2d 427, 429 (6th Cir. 1962) (“In the absence of a statute to the contrary a party cannot deduct from the period of the statute of limitations the time during which the action so dismissed was pending.”).

The panel opinion suggests that this treatment of dismissals without prejudice is not a uniform rule and that “for many . . . purposes, the dismissed action continues to have legal effect.” Panel Op. 23. This is not correct. The panel indicates only two such claimed instances: (1) where a dismissal without prejudice does not bar an award of costs as a sanction for a frivolous filing, *see, e.g., Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384, 395-96, 110 S. Ct. 2447, 110 L. Ed. 2d 359 (1990), and (2) where the filing is relied on to establish a controversy between the parties for assessing declaratory judgment jurisdiction, *see TransWeb, LLC v. 3M Innovative Props. Co.*, 812 F.3d 1295, 1300 (Fed. Cir. 2016). But neither of these is a situation where the issue is the legal effect of the earlier filing, and the question is whether the original filing triggers a legal obligation, such as the start of a time period. In that situation, the cases are uniform that, absent contrary intent, the earlier dismissed filing (or in this case service) has no legal effect.

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We ruled in *Abbott Laboratories v. TorPharm, Inc.*, 503 F.3d 1372, 1379 (Fed. Cir. 2007), that “[w]e assume Congress’s familiarity with general principles of law when enacting a statute.” In other words, “Congress is presumed to legislate against the backdrop of existing law.” *Morgan v. Principi*, 327 F.3d 1357, 1361 (Fed. Cir. 2003); accord *Cannon v. Univ. of Chi.*, 441 U.S. 677, 698-99, 99 S. Ct. 1946, 60 L. Ed. 2d 560 (1979). This widespread treatment of voluntary dismissals without prejudice provided the background for the enactment of section 315(b), and section 315(b) must be read in light of that background legal principle, so that the one year time-bar is not triggered if the underlying infringement action is voluntarily dismissed without prejudice.

The importance of assessing the statutory language in the light of background principles is confirmed by *Keene Corp. v. United States*, 508 U.S. 200, 113 S. Ct. 2035, 124 L. Ed. 2d 118 (1993). There the statute provided that “the Court of Federal Claims ‘shall not have jurisdiction’ over a claim, ‘for or in respect to which’ the plaintiff ‘has [a suit or process] pending’ in any other court.” *Id.* at 207 (alteration in original) (quoting 28 U.S.C. § 1500). The question was whether dismissal without prejudice of the previously filed action eliminated the jurisdictional bar. *Id.* at 202-05. The Supreme Court held that it did not. *Id.* at 209, 217. The Supreme Court did not primarily rely on the language of the statute to resolve the question, but looked instead to another applicable background principle—in that case the principle that jurisdiction is to be determined at the time the action (there the Claims Court action) was filed. *Id.* at 205-07. “In applying the jurisdictional bar here

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by looking to the facts existing when Keene filed each of its complaints, the Court of Federal Claims followed the longstanding principle that “the jurisdiction of the Court depends upon the state of things at the time of the action brought.” *Keene*, 508 U.S. at 207 (quoting *Mollan v. Torrance*, 22 U.S. 537, 9 Wheat. 537, 539, 6 L. Ed. 154 (1824) (Marshall, C.J.)). In light of that principle, the Court held that the pendency of the district court action, at the time the Claims Court action was filed, was a bar. *Id.* at 209. So here, the background principle is that the dismissal of an action without prejudice leaves the parties as though the action had never been brought.

Third, typically where there is an intention to depart from the normal treatment of voluntary dismissals without prejudice, the statute or the rule says so explicitly, there is a clear legislative decision to depart from the usual rule, or, as in *Keene*, there is a conflicting background principle. For example, Rule 41 itself states that we should depart from the normal rule when “the plaintiff previously dismissed any federal- or state-court action based on or including the same claim, [in which case] a notice of dismissal operates as an adjudication on the merits.” Fed. R. Civ. P. 41(a)(1)(B). Similarly, in *Flowers v. Secretary of the Department of Health & Human Services*, 49 F.3d 1558, 1560-61 (Fed. Cir. 1995), we found that the Vaccine Act banned claimants from seeking related benefits “[i]f a plaintiff has pending a civil action for damages for a vaccine-related injury or death,” 42 U.S.C. § 300aa-11(a)(5), even if that action was subsequently voluntarily dismissed without prejudice. Congress originally provided in the act that the co-pending bar would not apply if the

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plaintiff “withdraw[s] the action.” *Flowers*, 49 F.3d at 1560 (quoting Pub. L. No. 99-660, tit. III, § 2111(a)(5), 100 Stat. 3755, 3759 (codified at 42 U.S.C. § 300aa-11(a)(5) (1988))). Congress, however, specifically repealed the exception. We concluded that the usual rule concerning voluntary dismissals without prejudice did not apply, because Congress specifically manifested contrary intent by removing the provision. *Id.* at 1561.

Likewise, in *Jenkins v. Village of Maywood*, 506 F.3d 622 (7th Cir. 2007), the Seventh Circuit recognized that the statute of limitations for a § 1983 claim could be tolled by the filing of a suit, later voluntarily dismissed without prejudice, because the Illinois statute governing the statute of limitations

provides that if an action is voluntarily dismissed by the plaintiff, “then, whether or not the time limitation for bringing such action expires during the pendency of such action, the plaintiff . . . may commence a new action within one year or within the remaining period of limitation, whichever is greater . . . after the action is voluntarily dismissed by the plaintiff[.]”

*Id.* at 624 (alterations in original) (quoting 735 ILL. COMP. STAT. ANN. 5/13-217).<sup>3</sup>

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3. Both the panel opinion and Judge Taranto’s concurring opinion rely on section 315(a)(2)(C) as supporting the *en banc* holding showing that Congress made a deliberate choice not to refer to voluntary dismissals. Panel Op. 15; Concurring Op. 2. Section 315(a)(2)(C) simply provides that when an IPR has



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The fact is that Congress did not include any language in section 315(b) addressing voluntary dismissals without prejudice and here, contrary to the panel opinion, there is no legislative history supporting an opposing interpretation, suggesting that Congress intended to follow the usual rule, that such dismissals render the complaint a nullity.<sup>4</sup>

Finally, the purpose of the statute, as reflected in the legislative history, supports reading section 315(b)'s time bar as being inapplicable to voluntary dismissals without prejudice. One purpose of the statute was to require that the IPR petitioner file the IPR promptly after receiving notice of the patentee's claims through the filing of the infringement action. The panel opinion notes that Senator Kyl explained that the "315(b) deadline afford[s] defendants a reasonable opportunity to identify and understand the patent claims that are relevant to the litigation." 157 Cong. Rec. S5429 (daily ed. Sept. 8, 2011) (statement of Sen. Kyl).

While the panel opinion argues that the notice function supports their interpretation, in fact, the notice function would not be vindicated if the underlying complaint were voluntarily dismissed without prejudice. When an

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been instituted a later filed court action must be stayed until the court action is "dismissed." It is difficult to see how this can be read as congressional rejection in section 315(b) of the usual rule concerning the consequences of a voluntary dismissal.

4. Nor is this like *Keene*, discussed above, in which another background principle is predominant.

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action is filed, and then later voluntarily dismissed, the accused infringer is led to think that the controversy has dissipated. In other words, the notice function of the filing is effectively eliminated by the dismissal without prejudice.

As discussed earlier, in the comparable situation involving statutes of limitations, while the original filing provides notice to the defendant,<sup>5</sup> that notice is nullified by a voluntary dismissal without prejudice, and the original filing does not toll the statute of limitations. *See, e.g., Willard*, 164 U.S. at 523. Here, as in the limitations context, the underlying purpose of section 315(b) is not served by filing a complaint that is voluntarily dismissed without prejudice.

The statute was designed to give the petitioner a full year after receiving notice of the filing of the action to file the IPR, so that the potential petitioner could be fully aware of the claims and products at issue in the infringement litigation. The one year time-bar was intended to go into effect only after the defendant knows “which claims will be relevant and how those claims are alleged to read on the defendant’s products.” 157 Cong. Rec. S5429 (daily ed. 2011) (statement of Sen. Kyl). Despite the assertions to the contrary (Panel Op. 15-17), this purpose is thwarted by an early voluntary dismissal without prejudice. In that situation, the defendant is unlikely to have received the

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5. *See Crown, Cork & Seal Co. v. Parker*, 462 U.S. 345, 352, 103 S. Ct. 2392, 76 L. Ed. 2d 628 (1983) (“Limitations periods are intended to put defendants on notice of adverse claims and to prevent plaintiffs from sleeping on their rights . . .”).

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contemplated information, and that information will be of limited value, as the defendant has been led to believe that the underlying infringement action will no longer continue.

So too, one of the purposes of section 315(b) in setting a one year time period was to bar the filing of an IPR when, typically, the district court action would have already consumed the time and attention of the court and parties. We have pointed out that in the *inter partes* review context, the “legislative history confirms . . . ‘Congress’s desire to enhance the role of the PTO and limit the burden of litigation on courts and parties.’” *Murata Mach. USA, Ltd. v. Daifuku Co.*, 830 F.3d 1357, 1362 (Fed. Cir. 2016) (quoting *NFC Tech. LLC v. HTC Am., Inc.*, 2015 U.S. Dist. LEXIS 29573, 2015 WL 1069111, at \*5 (E.D. Tex. 2015)) (discussing AIA legislative history). However, the situations that result in a voluntary dismissal without prejudice do not implicate these concerns. This is because voluntary dismissals usually come early in the case, typically before the answer is filed or by agreement from both parties.

Finally, the purposes of section 315(b) will be defeated if the patentee plaintiff is allowed to manipulate the filing of infringement actions in order to bar a future IPR challenge. Indeed, if dismissals without prejudice did not nullify the underlying complaint, patent owners would have an incentive to file suits alleging infringement and subsequently voluntarily dismiss these suits without prejudice after service of a complaint. Such actions would effectively begin the one year clock for the accused infringer to file an IPR, even when there was no longer an

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underlying infringement action. Congress could not have intended to provide a mechanism for such manipulation.

Thus, we conclude that, contrary to the *en banc* holding, the section 315(b) time-bar should not apply when the underlying complaint alleging infringement has been voluntarily dismissed without prejudice.

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**APPENDIX E — DECISION OF THE UNITED  
STATES PATENT AND TRADEMARK OFFICE,  
PATENT TRIAL AND APPEAL BOARD,  
FILED OCTOBER 28, 2014**

Trials@uspto.gov  
571-272-7822

Paper 52  
Entered: October 28, 2014

UNITED STATES PATENT  
AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL  
AND APPEAL BOARD

Case IPR2013-00312  
Patent 5,818,836

ORACLE CORPORATION, ORACLE OTC  
SUBSIDIARY LLC, YP INTERACTIVE LLC,  
AND YELLOWPAGES.COM LLC,

*Petitioners,*

v.

CLICK-TO-CALL TECHNOLOGIES LP,

*Patent Owner.*

Before MICHAEL R. ZECHER, THOMAS L.  
GIANNETTI, and TRENTON A. WARD, *Administrative  
Patent Judges.*

ZECHER, *Administrative Patent Judge.*

*Appendix E***FINAL WRITTEN DECISION**  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73***I. BACKGROUND**

Oracle Corporation, Oracle OTC Subsidiary LLC, YP Interactive LLC,<sup>1</sup> and Yellowpages.com LLC (collectively, “Oracle”) filed a Petition requesting an *inter partes* review of claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22–24, and 26–30 of U.S. Patent No. 5,818,836 (Ex. 1001, “the ’836 patent”). Paper 1 (“Pet.”). Click-to-Call Technologies LP (“CTC”) timely filed a Preliminary Response. Paper 14 (“Prelim. Resp.”). Taking into account the information presented in Oracle’s Petition, as well as the arguments presented in CTC’s Preliminary Response, the Board determined that the information presented in the Petition demonstrated only that there was a reasonable likelihood that Oracle would prevail in challenging claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 as unpatentable under 35 U.S.C. §§ 102(e) and 103(a). Pursuant to 35 U.S.C. § 314, the Board instituted this proceeding on October 30, 2013, only as to these claims of the ’836 patent. Paper 26 (“Dec.”).

During this proceeding, CTC timely filed a Patent Owner Response (Paper 41, “PO Resp.”), and Oracle timely filed a Reply to the Patent Owner Response (Paper 43, “Pet. Reply”). An oral hearing was held on June 26, 2014. Paper 51 (“Tr.”).

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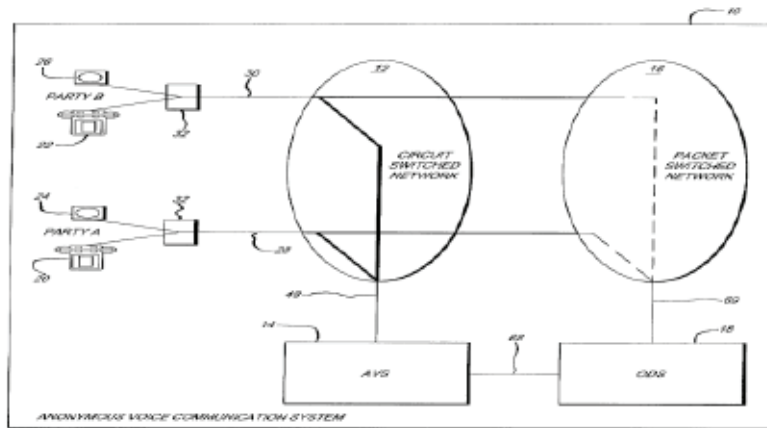
1. During trial, Petitioners filed an updated mandatory notice indicating that Ingenio LLC, one of the original Petitioners in this proceeding, changed its name to YP Interactive LLC. Paper 49, 1; Ex. 1026.

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We have jurisdiction under 35 U.S.C. § 6(c). This decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent. For the reasons discussed below, Oracle has demonstrated by a preponderance of the evidence that these claims are unpatentable.

#### A. The '836 Patent

The '836 patent generally relates to a method and system for establishing anonymous telephone communications. Ex. 1001, 1:8–9. Figure 1 of the '836 patent, reproduced below, illustrates an anonymous voice communication system. *Id.* at 4:35, 54–56.



As shown in Figure 1 of the '836 patent, anonymous voice communication system 10 uses circuit switched network ("CSN") 12 and anonymous voice system ("AVS") 14 to establish an anonymous voice communication

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between party A and party B. Ex. 1001, 4:56–59. In another embodiment, system 10 uses packet switched network (“PSN”) 16 and on-line data system (“ODS”) 18 to initiate an anonymous voice communication between party A and party B. *Id.* at 4:59–63.

The ’836 patent discloses that each party has telephone station 20 or 22 associated therewith that is connected to CSN 12. Ex. 1001, 4:64–65. Telephone stations 20 and 22 may be ordinary telephones, integrated services digital network telephones, or any device that can terminate an access line, play an audio signal, and transmit a received audio signal. *Id.* at 5:24–27. System 10 uses CSN 12 to establish a voice connection between telephone stations 20 and 22, as well as AVS 14. *Id.* at 4:65–67.

The ’836 patent further discloses that each party has data terminal 24 or 26 associated therewith that is connected to ODS 18 via CDS 12 and PSN 16. Ex. 1001, 5:5–8. Data terminals 24 and 26 may be a personal computer with the ability to process and store data, display information, accept input via a keyboard, microphone, or writing tablet, and communicate with other devices via a serial port, modem, or local area network. *Id.* at 5:28–32. Each party may use its respective data terminals 24 or 26 to exchange messages through ODS 18 to request an anonymous voice connection, which, in turn, causes ODS 18 to generate a command that prompts AVS 14 to establish a telephone connection between the parties. *Id.* at 5:8–13.

The ’836 patent discloses at least three different methods of creating an anonymous voice communication



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using system 10 illustrated in Figure 1: (1) standalone; (2) on-line; and (3) single party initiated. Ex. 1001, 9:45–47. With respect to the on-line method of establishing an anonymous voice communication, the parties initiate an anonymous voice call using ODS 18. *Id.* at 16:54–55. Each party may use its data terminal 24 or 26 to log on to ODS 18. *Id.* at 16:55–57. The parties may contact each other via ODS 18 using public chat, private chat, electronic mail, or newsgroups. Ex. 1001, 16:57–59. The parties can communicate via ODS 18 without revealing their identity to each other, i.e., they are identified by screen names, handles, or subscriber identifications, which only the operator of ODS 18 can translate into the subscriber's identification. *Id.* at 16:59–64. According to the '836 patent, either party A or party B may initiate an anonymous voice communication using the on-line method. *Id.* at 16:65.

**B. Illustrative Claim**

Of the challenged claims, claims 1 and 12 are independent claims. Claims 2, 8, 22, 23, and 26 directly or indirectly depend from independent claim 1, and claims 13, 15, 16, 19, 29, and 30 directly or indirectly depend from independent claim 12. Independent claim 1 is illustrative of the '836 patent and is reproduced below:

1. A method for creating a voice connection over a circuit switched network between a first party and a second party using an on-line data service to initiate the connection, comprising the steps of:

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a) establishing an electronic communication between the first party and the second party through the on-line data service between the first party and the second party, wherein the first party is anonymous to the second party prior to establishing a first electronic communication between the first party and the second party, wherein the establishing includes providing over the Internet, to a data terminal of the first party coupled to the Internet, information publicly accessible over the Internet, wherein the information publically accessible over the Internet is suitable for presentation within a graphical user interface of the data terminal of the first party, wherein the information publicly accessible over the Internet includes:

- (1) first information characterizing a second party,
- (2) second information representing a communication from the second party, and
- (3) third information specifying a user-selectable element for display within the graphical user interface of the data terminal of the first party, wherein the user-selectable element is visually associated, within the graphical user interface of the

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data terminal of the first party, with the first information and the second information, when the first information, second information and user-selectable element are presented within the graphical user interface of the data terminal of the first party; and

(b) following the establishment of an electronic communication between the first party and the second party through the on-line data service between the first party and the second party, and in response to receiving an indication of selection of the user-selectable element displayed within the graphical user interface of the data terminal of the first party, performing the steps of:

(1) requesting a voice communication between the first party and the second party through the on-line data service;

(2) transmitting a message from the on-line data service to a voice system requesting the voice connection between said first party and said second party;

(3) establishing a first telephone call for the first party;

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(4) establishing a second telephone call for the second party; and

(5) connecting said first telephone call with said second telephone call.

Ex. 2001,<sup>2</sup> 1:26–2:8 (brackets and emphases omitted).

C. Related Proceedings

Both parties indicate that the '836 patent was asserted in the following civil actions, each of which was filed in the United States District Court for the Western District of Texas: (1) *Click to Call Technologies LP v. Oracle Corporation*, No. 1:12-cv-00468-SS, filed on May 29, 2012; (2) *Click to Call Technologies LP v. eHarmony, Inc.*, No. 1:12-cv-00469-SS, filed on May 30, 2012; and (3) *Click to Call Technologies LP v. AT&T, Inc.*, No. 1:12-cv-00465-SS, filed on May 29, 2012. Pet. 1–2; Paper 7, 2–3.

D. Prior Art Relied Upon

Oracle relies upon the following prior art references:

Dezonne US 5,991,394 Nov. 23, 1999 Ex. 1002  
(effectively filed Apr. 21, 1995)

DALE DOUGHERTY & RICHARD KOMAN, *THE MOSAIC HANDBOOK FOR MICROSOFT WINDOWS* 17–39 (1994) (Ex. 1004) (“Mosaic Handbook”).

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2. This citation is to Ex Parte Reexamination Certificate No. US 5,818,836 C1, which issued on December 30, 2008.

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## E. Instituted Grounds of Unpatentability

We instituted this proceeding based on the asserted grounds of unpatentability set forth in the table below.

Challenged Claims	Basis	Reference(s) <sup>3</sup>
1, 2, 12, 13, 19, 22, 23, 26, 29, and 30	§ 102(e)	Dezonno
1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30	§ 103(a)	Dezonno
22 and 29	§ 103(a)	Dezonno and Mosaic Handbook

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3. For the grounds of unpatentability based solely on Dezonno, although Oracle includes dependent claims 18 and 24 in the statement of the grounds of unpatentability (Pet. 21), Oracle nonetheless does not include dependent claims 18 and 24 in the corresponding analysis (*see id.* at 21–31). Conversely, although Oracle omits dependent claims 22 and 29 in the statement of the grounds of unpatentability (*id.* at 21), Oracle nonetheless includes dependent claims 22 and 29 in the corresponding analysis (*id.* at 29, 31). We will treat the incorrect statement of the grounds of unpatentability as a typographical error and presume Oracle intended to assert that claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated under 35 U.S.C. § 102(e) by Dezonno, whereas claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable under 35 U.S.C. § 103(a) over Dezonno.

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## II. ANALYSIS

*A. Claim Construction*

In an *inter partes* review, we construe a claim by applying the broadest reasonable interpretation in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012).

## 1. Claim Terms or Phrases Construed by Oracle

In its Petition, Oracle provides claim constructions for a number of claim terms or phrases recited in the '836 patent. Pet. 8–11 (citing Ex. 1009; Ex. 1010). CTC does not propose alternative claim constructions for these claim terms or phrases in either its Preliminary Response or Patent Owner Response. We adopted the claim constructions proposed by Oracle in our Decision to Institute (Dec. 10–13) and we discern no reason to alter those claim constructions for this Final Written Decision. For convenience, the claims constructions proposed by Oracle are reproduced in the table below.

Claim(s)	Claim Term or Phrase	Claim Construction
1 and 12	“party”	A person or group participating in an action.
1 and 12	“anonymous”	Identity is not revealed.
1 and 12	“voice system”	A system that can connect voice calls.

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<b>Claim(s)</b>	<b>Claim Term or Phrase</b>	<b>Claim Construction</b>
1 and 12	“data terminal”	A computing device capable of sending and/or receiving data.
1	“on-line data service”	A service provided by an online data system, such as electronic mail, chat, newsgroups, or access to information.
12	“on-line data system”	A computing device or distributed computing system with storage and communications capability that provides services online, such as electronic mail, chat, newsgroups, or access to information.
1 and 12	“information publicly accessible”	Information that is widely available and subject to minimal constraints, such as subscription, registration, or ability to access the on-line data service or system.

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<b>Claim(s)</b>	<b>Claim Term or Phrase</b>	<b>Claim Construction</b>
1	“establishing [or establishment of] an electronic communication between the first party and the second party”	Transferring information electronically from one party to another party.
1 and 12	“second information representing a communication from the second party”	Information representing information transferred from the second party.
1	“requesting a voice communication between the first party and the second party through the on-line data service”	Requesting a voice communication using the online data service.
12	“connect command”	A command that directs the voice system to connect a first telephone call with a second telephone call.



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<b>Claim(s)</b>	<b>Claim Term or Phrase</b>	<b>Claim Construction</b>
1 and 12	“indication [or indicative] of selection of the user-selectable element”	Information indicating that the user-selectable element was selected.
12	“on-line data system that is coupled to the data terminal of each party”	A computing device or distributed computing system with storage and communications capability that provides services online, such as electronic mail, chat, newsgroup, or access to information, and is coupled to the data terminal of each party.
1	“on-line data service between the first and the second party”	A service provided by an online data system, such as electronic mail, chat, newsgroup, or access to information.

2. “First Information” and “Second Information”  
(Claims 1 and 12)

In its Petition, Oracle contends that the claim terms “first information” and “second information” recited in independent claims 1 and 12 are not entitled to patentable weight because each claim term amounts to nonfunctional

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descriptive material that has no functional relationship to any substrate or other portions of the claims. Pet. 60. In its Preliminary Response, CTC contends that the “first information” and “second information” recited in independent claim 1 are entitled to patentable weight because they have a direct functional relationship to the claimed “establishing” step (a), as well as the claimed “performing” steps (b)(1)–(5). Prelim. Resp. 21–23. Similarly, CTC contends that “first information” and “second information” recited in independent claim 12 are entitled to patentable weight because they have a direct functional relationship to “the provision of the information publicly accessible,” which is structured through the claimed visual association of a user-selectable element with the first and second information. *Id.* at 23.

In the Decision to Institute, we determined that, because the claim terms “first information” and the “second information” have a functional relationship with other claimed features recited in independent claims 1 and 12, these claim terms limit the claimed invention functionally and, as a result, are entitled to patentable weight. Dec. 13–14. During trial, neither Oracle nor CTC dispute our determination in that regard. We discern no reason to alter our claim construction of these claim terms for this Final Written Decision.

B. YP Interactive LLC Is Not Barred Under  
35 U.S.C § 315(b) From Pursuing an Inter  
Partes Review of the ’836 Patent

In the Decision to Institute, as well as a subsequent Decision on CTC’s Request for Rehearing (Paper 40), we

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determined that one of the original Petitioners—namely, Ingenio LLC, which has since changed its name to YP Interactive LLC—is not barred from pursuing an *inter partes* review under 35 U.S.C. § 315(b). Dec. 15–18; Paper 40, 3–5. In its Patent Owner Response, CTC renews its argument that we erroneously interpreted § 315(b) because the legislative history associated with this statute dictates that the plain meaning of “served with a complaint alleging infringement of [a] patent” is conclusive and, therefore, our analysis of the issue in both the Decision to Institute and the Decision on CTC’s Request for Rehearing erred in looking beyond the statutory language. PO Resp. 53–56. In its Reply, Oracle reiterates the position we took in both the Decision to Institute and the Decision on CTC’s Request for Rehearing that there is no statutory bar against YP Interactive LLC because a voluntarily dismissal of a complaint without prejudice does not trigger a bar under § 315(b). Pet. Reply 15.

As stated in the Decision to Institute and the Decision on CTC’s Request for Rehearing, both the Federal Rules of Civil Procedure and Federal Circuit precedent treat a dismissal without prejudice as something that, *de jure*, never existed. Dec. 16–17; Paper 40, 4. It is undisputed that the patent infringement suit filed by Inforocket against Keen—now YP Interactive LLC—on June 8, 2001, was dismissed without prejudice on March 21, 2003. Ex. 1019, 1; Ex. 1017, 4; Ex. 1018, 8. We have determined that, because this patent infringement suit was dismissed without prejudice, Federal Circuit precedent interprets such a dismissal as leaving the parties in the same legal position as if the underlying complaint had never been

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served. *See Graves v. Principi*, 294 F.3d 1350, 1356 (Fed. Cir. 2002); *Bonneville Assoc., Ltd. P'ship v. Baram*, 165 F.3d 1360, 1364 (Fed. Cir. 1999). Accord 9 WRIGHT, MILLER, KANE, and MARCUS, FEDERAL PRAC. & PROC. CIV. § 2367 (3d. ed.). As a consequence, YP Interactive LLC is not barred from pursuing an *inter partes* review of the '836 patent under § 315(b).

C. Grounds of Unpatentability Based,  
in Whole or in Part, on Dezonno

In its Petition, Oracle presents the following grounds of unpatentability: (1) claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated under 35 U.S.C. § 102(e) by Dezonno; (2) claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable under 35 U.S.C. § 103(a) over Dezonno; and (3) claims 22 and 29 are unpatentable under 35 U.S.C. § 103(a) over the combination of Dezonno and Mosaic Handbook. Pet. 15–33. In support of these asserted grounds of unpatentability, Oracle relies upon claim charts to explain how Dezonno, either standing alone or in combination with Mosaic Handbook, discloses the claimed subject matter recited in each of these claims. *Id.* Oracle also presents the Declaration of Dr. Robert L. Stevenson (Ex. 1007 ¶¶ 11–17) to support its positions. *Id.*

In its Patent Owner Response, CTC does not challenge the contentions and supporting evidence presented by Oracle in its Petition, but instead attempts to antedate Dezonno. In particular, CTC contends that the invention embodied in these claims (“the claimed invention”) was conceived prior to the earliest effective filing date of

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Dezonno—namely, April 21, 1995 (Ex. 1002, at [63]). PO Resp. 1–2. CTC further contends that the claimed invention was constructively reduced to practice on August 9, 1995, the filing date of the patent application that led to the '836 patent, as well as actually reduced to practice on August 15, 1995, the day before the ONE BBSCON conference. *Id.* at 2–3. According to CTC, the ONE BBSCON conference was a major industry conference where Mr. Stephen C. DuVal, the named inventor of the '836 patent (Ex. 1001, at [76]), planned to announce his purported invention. PO Resp. 1. In addition, CTC asserts that Mr. DuVal continually exercised reasonable diligence from April 20, 1995, through August 9, 1995 (“the critical period”). *Id.* at 5–8. As a consequence, CTC argues that Dezonno does not qualify as prior art under 35 U.S.C. § 102(e). *Id.* at 8

We begin our analysis with the principles of law that generally apply to antedating a reference, followed by a brief discussion of the parties contentions regarding conception, and then we turn to the parties contentions regarding whether there is sufficient evidence on this record to provide independent corroboration of Mr. DuVal’s testimony that he continually exercised reasonable diligence during the entire critical period.

### 1. Principles of Law

An inventor may antedate a reference if he was the first to conceive of a patentable invention, and then connects the conception of his invention with its reduction to practice by reasonable diligence on his part, such that

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conception and diligence are substantially one continuous act. *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996). An inventor's testimony, standing alone, is insufficient to prove conception and diligence, as some form of corroboration is required. *Mahurkar*, 79 F.3d at 1577; *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993). A rule of reason applies to determine whether the inventor's testimony has been corroborated. *Price*, 988 F.2d at 1194.

During the period in which reasonable diligence must be shown, there must be continuous exercise of reasonable diligence. *In re McIntosh*, 230 F.2d 615, 619 (CCPA 1956); *see also Burns v. Curtis*, 172 F.2d 588, 591 (CCPA 1949) (referring to "reasonably continuous activity"). A party alleging diligence must account for the entire critical period. *Griffith v. Kanamuru*, 816 F.2d 624, 626 (Fed. Cir. 1987); *Gould v. Schawlow*, 363 F.2d 908, 919 (CCPA 1966). Even a short period of unexplained inactivity is sufficient to defeat a claim of diligence. *Morway v. Bondi*, 203 F.2d 742, 749 (CCPA 1953); *Ireland v. Smith*, 97 F.2d 95, 99–100 (CCPA 1938). In *In re Mulder*, 716 F.2d 1542, 1542–46 (Fed. Cir. 1983), for example, the Federal Circuit affirmed a determination of lack of reasonable diligence, where the evidence of record was lacking for a two-day critical period. Likewise, in *Rieser v. Williams*, 255 F.2d 419, 424 (CCPA 1958), there was no showing of diligence where no activity was shown during the first thirteen days of the critical period.

A party alleging diligence must provide corroboration with evidence that is specific both as to facts and dates.

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*Gould*, 363 F.2d at 920; *Kendall v. Searles*, 173 F.2d 986, 993 (CCPA 1949). The rule of reason does not dispense with the need for corroboration of diligence that is specific as to dates and facts. *Gould*, 363 F.2d at 920; *Kendall*, 173 F.2d at 993; *see also Coleman v. Dines*, 754 F.2d 353, 360 (Fed. Cir. 1985) (“The rule of reason . . . does not dispense with the requirement for some evidence of independent corroboration.”).

## 2. Conception

In its Patent Owner Response, CTC contends that the following documents collectively demonstrate that Mr. DuVal conceived of the claimed invention of the ’836 patent before the earliest effective filing date of Dezonno—namely, April 21, 1995: (1) the October 1994 invention disclosure document filed with the Office (Ex. 2017, Attachment A); (2) the February 1995 PrivTel<sup>4</sup> Business Plan produced by Mr. DuVal at the request of Mr. Brian Forrest (Ex. 2017, Attachment C); (3) the March 1995 invention disclosure document filed with the Office (Ex. 2017, Attachment B); and (4) the March 1995 letter Mr. DuVal sent to the law firm of Blakely, Sokoloff, Taylor, and Zafman LLP instructing them to prepare and file a patent application (Ex. 2017, Attachment O). PO Resp. 10–36. CTC further contends that these documents independently corroborate Mr. DuVal’s testimony that he conceived of the claimed invention of the ’836 patent prior to April 21, 1995. *Id.*

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4. Mr. DuVal testifies that he formed PrivTel on December 12, 1994, to demonstrate, produce, commercialize, and sell his claimed inventions. Ex. 2017 ¶ 7(C).

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In its Reply, Oracle contends that CTC has not established that Mr. DuVal conceived of the claimed invention of the '836 patent before April 21, 1995, because CTC does not demonstrate that distributing client software over the Internet, as required by independent claims 1 and 12, was either inherent or obvious in light of the March 1995 invention disclosure document. Pet. Reply 14. Oracle further argues that independent claims 1 and 12 both require that the claimed user-selectable element, first information, and second information must be displayed at the same time. *Id.* at 15. Oracle asserts that, because the claimed user-selectable element is part of the client software, it is displayed when the software begins to run, i.e., before display of the claimed second information. *Id.*

Even if we were to agree with CTC that there is sufficient evidence to corroborate Mr. DuVal's testimony that he conceived of the claimed invention of the '836 patent prior to April 21, 1995, as we will discuss below, CTC does not provide sufficient evidence to corroborate Mr. DuVal's testimony that there was a continuous exercise of reasonable diligence during the entire critical period. Consequently, we need not reach and, therefore, do not address conception.

### 3. Diligence

To demonstrate diligence during the entire critical period, CTC relies upon the declarations of the following individuals: (1) Mr. DuVal (Ex. 2017); (2) Mr. Forrest (Ex. 2019); (3) Mr. Ben Yorks (Ex. 2021), a former partner at



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Blakely, Sokoloff, Taylor, and Zafman LLP who was hired by Mr. DuVal to draft and file the patent application that led to the '836 patent; (4) Mr. Bob Shinn (Ex. 2022), the former president and owner of SofTel, Inc. ("SofTel"); (5) Mr. Simon Clement (Ex. 2023), the former president of ProDesign, Inc. ("ProDesign"); and (6) Mr. Doug Martin (Ex. 2025), the former Chief Technology Officer and co-owner of Interactive Communication Services ("ICS"). PO Resp. 36–48. Of particular importance is the testimony of Mr. Yorks regarding his preparation in drafting and filing the patent application that led to the '836 patent, as well as the testimony of Mr. Shinn, Mr. Clement, and Mr. Martin, each of whom represents one of the three software developers—namely, SofTel, ProDesign, and ICS—hired by Mr. DuVal to implement the claimed invention. *Id.* at 39–40. In its Reply, Oracle contends that CTC does not provide sufficient evidence to corroborate Mr. DuVal's testimony that he was reasonably diligent during the entire critical period with respect to both constructively reducing the claimed invention to practice and actually reducing the claimed invention to practice. Pet. Reply. 5–13.

In our analysis below, we will explain how the aforementioned supporting evidence, taken as a whole, does not support CTC's contention that there was a continuous exercise of reasonable diligence during the entire critical period. In particular, we will address how this evidence does not demonstrate that Mr. DuVal was diligent with respect to constructive reduction to practice, and then turn to how this evidence does not demonstrate that he was diligent with respect to actual reduction to practice.

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a. CTC Does Not Demonstrate a Continuous  
Exercise of Reasonable Diligence With Respect  
to Constructive Reduction to Practice

As we explained previously, Mr. DuVal constructively reduced the claimed invention to practice when he filed the patent application that led to the '836 patent on August 9, 1995. The earliest effective filing date of Dezonno is April 21, 1995. Ex. 1002, at [63]. To show diligence with respect to constructive reduction to practice during the entire critical period, CTC primarily relies upon the testimony of Mr. DuVal and Mr. Yorks.

Mr. DuVal testifies that, after Mr. Yorks prepared an initial draft of the patent application that led to the '836 patent just prior to April 21, 1995, until at least May 2, 1995, he personally reviewed and revised the initial draft between May 2, 1995, and May 9, 1995. Ex. 2017 ¶ 8(D) (1)–(2); *see also* Ex. 2024 ¶ 7 (William W. Schaal, a current partner at Blakely, Sokoloff, Taylor, and Zafman LLP, testifies that, at the direction of Mr. DuVal, he obtained an advisor letter and a draft patent application that was sent from his law firm to Mr. DuVal on May 2, 1995.). Mr. DuVal then testifies that “[f]rom at least May 9, 1995 until July 17, 1995, Mr. Yorks and I continued to make progress on the preparation of my patent application.” Ex. 2017 ¶ 8(D) (3). Mr. Yorks’s testimony regarding the preparation and review of the initial draft of the patent application that led to the '836 patent is consistent with the timeline provided by Mr. DuVal. *Compare* Ex. 2021 ¶ 6 (H)–(J), *with* Ex. 2017 ¶ 8(D)(1)–(3).

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The testimony offered by Mr. DuVal and Mr. Yorks concerning the preparation and review of the draft patent application, however, is not specific as to facts and dates for the entire critical period during which diligence is required. *See Gould*, 363 F.2d at 920; *Kendall*, 173 F.2d at 993. Mr. DuVal and Mr. Yorks do not provide sufficient evidence to corroborate the work actually performed on the draft patent application that led to the '836 patent between May 9, 1995, and July 17, 1995. Given the absence of specific details concerning the work that was done on the draft patent application, the testimony from Mr. DuVal and Mr. Yorks amounts to mere pleadings and is insufficient to establish diligence with respect to constructive reduction to practice during this time period. *See In re Harry*, 333 F.2d 920, 923 (CCPA 1964) (Statements that are unsupported by evidence or a showing of facts essentially amount to mere pleadings.). Moreover, during oral argument, counsel for CTC conceded that, if we were to focus exclusively on the activities either Mr. DuVal or Mr. Yorks engaged in to constructively reduce the claimed invention to practice, that, by itself, would be insufficient to establish diligence during the entire critical period. Tr. 35:17–36:9.

Based on the record before us, the testimony from Mr. DuVal and Mr. Yorks regarding constructive reduction to practice is not specific as to facts and dates for at least the time period between May 9, 1995, and July 17, 1995, and, as result, does not establish that Mr. DuVal was diligent during the entire critical period.

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b. CTC Does Not Demonstrate a Continuous  
Exercise of Reasonable Diligence With Respect  
to Actual Reduction to Practice

As we explained previously, CTC contends that Mr. DuVal actually reduced the claimed invention to practice on August 15, 1995, the day before the ONE BBSCON conference was scheduled to begin in Tampa, Florida. The earliest effective filing date of Dezonno is April 21, 1995. Ex. 1002, at [63]. To show diligence during the entire critical period leading to this actual reduction to practice, CTC primarily relies upon the testimony of Mr. DuVal, as well as the testimony of Mr. Shinn, Mr. Clement, and Mr. Martin, regarding the work performed by the three software developers hired by Mr. DuVal to implement the claimed invention.

Mr. DuVal testifies that “[f]rom at least prior to April 21, 1995 until at least August 20, 1995, I was working full-time, approximately twelve hours a day, seven days a week, to execute on my company’s business plan, and particularly to meet my Diligence Goals.” Ex. 2017 ¶ 8(C). This testimony from Mr. DuVal regarding the work he performed to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required. *See Gould*, 363 F.2d at 920; *Kendall*, 173 F.2d at 993. Once again, Mr. DuVal’s statement amounts to a mere conclusion and lacks sufficient detail to establish diligence with respect to actual reduction to practice during the entire critical period. *See Harry*, 333 F.2d at 923.

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With respect to the three software developers hired by Mr. DuVal to implement the claimed invention, Mr. DuVal testifies that “[a]t a minimum, each . . . [of] ICS, SofTel and ProDesign, committed at least one full-time engineer to PrivTel’s development efforts to complete a working prototype of [the claimed invention] . . . in time for [the] ONE BBSCON [conference] on August 16–20, 1995.” Ex. 2017 ¶ 8(F) (citing Ex. 2022 ¶¶ 11–18; Ex. 2023 ¶ 18; Ex. 2025 ¶ 10). CTC, however, does not provide sufficient evidence to corroborate the testimony of Mr. DuVal regarding the work performed by the engineers employed by SofTel, ProDesign, and ICS to implement the claimed invention.

For instance, CTC does not provide test results, billing records, or other documentary evidence indicating that these engineers engaged in a continuous exercise of reasonable diligence during the entire critical period to implement the claimed invention. Absent such corroborating evidence, we are left to speculate whether the work performed by these engineers took several weeks or just a couple of days to complete. Even if we were to assume that the work took several weeks to complete, we cannot assess whether there are any diligence gaps during the critical period without sufficient evidence establishing what activities took place on particular dates. Conversely, if we were to assume that the work performed by these engineers only took a few days to complete, then there necessarily would be one or more large gaps in diligence during the critical period that are unaccounted for. Put simply, without sufficient evidence to substantiate details of the work performed by the engineers employed by

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SofTel, ProDesign, and ICS to implement the claimed invention, CTC has failed to corroborate Mr. DuVal's testimony that these engineers performed reasonably continuous activities to reduce the claimed invention to practice.

In its Patent Owner Response, CTC focuses on certain activities performed by each software developer to implement the claimed invention and the respective payments made by PrivTel to each software developer for their services. PO Resp. 41–47. The analysis that follows focuses on the activities of each software developer and the corresponding payments received from PrivTel, particularly during the time period between May 15, 1995, and June 15, 1995.

i. ICS

Mr. DuVal testifies that he worked with ICS to develop a software development services agreement to build the claimed invention, which, in turn, was executed on or around May 15, 1995. Ex. 2017 ¶ 8(J)(2). Mr. DuVal further testifies that PrivTel made an initial payment of \$2,000 to ICS on May 15, 1995, after which ICS worked diligently to design the claimed invention, including the system architecture, communication protocols, and overall system design work. Ex. 2017 ¶ 8(J)(3). After ICS completed its design of the claimed invention, Mr. DuVal testified that PrivTel made another payment of \$6,400 to ICS on July 1, 1995. *Id.* Mr. Martin's testimony regarding the design of the claimed invention by ICS and corresponding payments for its services is consistent with the timeline provided

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by Mr. DuVal. *Compare* Ex. 2025 ¶ 10–15, *with* Ex. 2017 ¶ 8(J)(2)–(3).

In its Reply, Oracle contends that neither Mr. DuVal nor Mr. Martin identify the tasks or activities performed by ICS on a particular date between May 15, 1995, and July 1, 1995, nor do they provide documentary evidence that provides such information. Pet. Reply 9. Oracle further argues that there is no evidence of record indicating that ICS actually created a design of the claimed invention during this period, nor that ProDesign and SofTel waited for, or even subsequently used, the design allegedly created by ICS. *Id.* at 11.

The testimony that CTC relies upon to explain the activities performed by ICS to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required, particularly during the time period between May 15, 1995, and July 1, 1995. First, Mr. DuVal does not indicate that he has personal knowledge about the work performed by ICS during this time period. Therefore, his testimony is entitled to little weight. Second, Mr. Martin does not indicate whether it took ICS several weeks or just a few days to complete the design of the claimed invention. Third, CTC does not provide evidence that the design of the claimed invention allegedly created by ICS during this time period actually exists. Nor does CTC indicate that this alleged design was necessary for ProDesign and SofTel to complete the work they were hired to perform to implement the claimed invention. *See e.g.*, Ex. 2023, Attachment A; Ex. 2022, Attachment C. Absent

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underlying evidence to support the testimony from Mr. DuVal and Mr. Martin that ICS worked diligently to implement the claimed invention between May 15, 1995, and July 1, 1995, we are not persuaded that ICS performed reasonably continuous activities to reduce the claimed invention to practice during this time period.

*ii. ProDesign*

Mr. DuVal testifies that on June 15, 1995, PrivTel paid ProDesign \$5,000 to begin its first design phase of the claimed invention. Ex. 2017 ¶ 8(N)(4). Mr. Clement, however, testifies that ProDesign did not enter into a contract with PrivTel to develop software for the claimed invention until June 26, 1995. Ex. 2023 ¶ 4. Mr. Clement further testifies that, “[e]ven before the contract was signed, [he] began working diligently on the software for [the claimed invention] because of the relatively short amount of time before Mr. DuVal planned to demonstrated [the claimed invention] at the upcoming ONE BBSCON conference in August.” *Id.* ¶ 11.

In its Reply, Oracle contends that Mr. Clements never corroborates that ProDesign actually performed work on the claimed invention between May 15, 1995, and June 15, 1995. Pet. Reply 8. Oracle also asserts that, in light of Mr. DuVal’s testimony, ProDesign began its work to implement the claimed invention no earlier than June 15, 1995, because that was the date PrivTel made its initial payment of \$5,000 to ProDesign. *Id.*



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The testimony that CTC relies upon to explain the activities performed by ProDesign to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required, particularly during the time period between May 15, 1995, and June 15, 1995. Although Mr. Clements testifies that he began working diligently on the software for the claimed invention prior to entering into a contract with PrivTel on June 26, 1995, he does not explain adequately the activities he performed on particular dates. Even if we were to assume that Mr. Clements began working diligently to implement the software for the claimed invention on June 15, 1995, the date PrivTel made its initial payment of \$5,000 to ProDesign, the time period between May 15, 1995, and June 15, 1995, still remains unaccounted for. Without some evidence that explains, in detail, the work performed by Mr. Clements on the software of the claimed invention between May 15, 1995, and June 15, 1995, we are not persuaded that ProDesign performed reasonably continuous activities to reduce the claimed invention to practice during this time period.

## iii. SofTel

CTC indicates that, because SofTel was hired to develop a control system for the claimed invention that depends on some other subsystems, presumably developed by ICS and ProDesign, SofTel did not begin its work in earnest until July 1, 1995. PO Resp. 45 (citing Ex. 2017 ¶ 8(L)(1); Ex. 2022 ¶¶ 7–16). This is consistent with Mr. DuVal's testimony that PrivTel paid SofTel \$3,000 on July 1, 1995, to begin designing the control system of the claimed invention. Ex. 2017 ¶ 8(L)(3).

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In its Reply, Oracle contends that CTC admits in its Patent Owner Response that SofTel did not begin working to implement the claimed invention until July 1, 1995, and its admission in that regard is consistent with the testimony proffered by Mr. DuVal. Pet. Reply 8 (citing Ex. 2017 ¶ 8(L)(1)–(3)).

The testimony that CTC relies upon to explain the activities performed by SofTel to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required, particularly during the time period between May 15, 1995, and July 1, 1995. Indeed, Mr. DuVal's testimony that SofTel was awaiting the overall system architecture designed by ICS before it began its work in earnest on July 1, 1995 (Ex. 2017 ¶ 8(L)(1); *see* Tr. 28:4–29:12) constitutes persuasive evidence that SofTel did not perform reasonably continuous activities to reduce the claimed invention to practice between May 15, 1995, and July 1, 1995.

Based on the record before us, the testimony from Mr. DuVal regarding actual reduction to practice, as well as the testimony of Mr. Shinn, Mr. Clement, and Mr. Martin regarding the work performed by the three software developers hired by Mr. DuVal to implement the claimed invention, is not sufficiently specific as to facts and dates for at least the time period between May 15, 1995, and June 15, 1995, to demonstrate that Mr. DuVal was diligent during the entire critical period.

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## 4. Summary

Applying the rule of reason, the evidence relied upon by CTC to corroborate Mr. DuVal's testimony does not demonstrate a continuous exercise of reasonable diligence during the entire critical period with respect to either constructive reduction to practice or actual reduction to practice, particularly during the time period between May 15, 1995, and June 15, 1995. As a result, CTC has not antedated Dezonno, which, in turn, qualifies as prior art to the '836 patent under 35 U.S.C. § 102(e).

Upon reviewing the unchallenged contentions and supporting evidence presented by Oracle in its Petition for the grounds of unpatentability based, in whole or in part, on Dezonno (Pet. 15–33; Ex. 1007 ¶¶ 11–17), we are persuaded that Oracle presents sufficient evidence to support a finding that Dezonno, either standing alone or in combination with Mosaic Handbook, discloses the claimed subject matter recited in claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30. We also are persuaded that Oracle provides an articulated reason with a rational underpinning to combine the teachings of Dezonno and Mosaic Handbook. Pet. 32–33; Ex. 1007 ¶ 17. Therefore, based on the record before us, we conclude that Oracle has demonstrated by a preponderance of the evidence that: (1) claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated by Dezonno; (2) claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are obvious over Dezonno; and (3) claims 22 and 29 are obvious over the combination of Dezonno and Mosaic Handbook.

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## III. CONCLUSION

Oracle has demonstrated by a preponderance of the evidence that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent are unpatentable based on the grounds of unpatentability set forth in the table below.

Challenged Claims	Basis	Reference(s)
1, 2, 12, 13, 19, 22, 23, 26, 29, and 30	§ 102(e)	Dezonno
1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30	§ 103(a)	Dezonno
22 and 29	§ 103(a)	Dezonno and Mosaic Handbook

## IV. ORDER

In consideration of the foregoing, it is ORDERED that Oracle has shown by a preponderance of the evidence that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent are unpatentable; and

FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of our decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

**APPENDIX F — DECISION OF THE UNITED  
STATES PATENT AND TRADEMARK OFFICE,  
FILED DECEMBER 18, 2013**

Trials@uspto.gov  
571-272-7822

Paper 40  
Entered: December 18, 2013

UNITED STATES PATENT  
AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL  
AND APPEAL BOARD

ORACLE CORPORATION, ORACLE OTC  
SUBSIDIARY LLC, INGENIO LLC, and  
YELLOWPAGES.COM LLC

*Petitioners*

v.

CLICK-TO-CALL TECHNOLOGIES LP

*Patent Owner*

Case IPR2013-00312  
U.S. Patent No. 5,818,836

Before MICHAEL R. ZECHER, THOMAS L.  
GIANNETTI, and TRENTON A. WARD, *Administrative  
Patent Judges.*

ZECHER, *Administrative Patent Judge.*

*Appendix F***DECISION**

## Patent Owner's Request for Rehearing

*37 C.F.R. § 42.71***I. INTRODUCTION**

Click-to-Call Technologies LP (“Patent Owner”) requests rehearing (Paper 37, “Reh’g Req.”) on the Board’s decision to institute (Paper 26, “Dec.”) an *inter partes* review of claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of U.S. Patent No. 5,818,836 (“the ’836 patent”). In its preliminary response (Paper 14, “Prelim. Resp.”), Patent Owner contends that the petition is barred under 35 U.S.C. § 315(b) as a result of service of a complaint alleging infringement of the ’836 patent on a predecessor of Ingenio LLC—one of the Petitioners—more than a year before the petition was filed on May 28, 2013. Prelim. Resp. 3-9. In the decision to institute, the Board determined that Petitioners—namely Ingenio LLC—are not barred from pursuing an *inter partes* review under § 315(b). Dec. 15-18.

In its request for rehearing, Patent Owner contends that the Board erroneously interpreted § 315(b) because: (1) the legislative history associated with § 315(b) dictates that the plain meaning of “served with a complaint alleging infringement of a patent” is conclusive, and, therefore, the Board’s analysis of the issue erred in looking beyond the statutory language; (2) the Board erred in looking to the Federal Rules of Civil Procedure to interpret the statute because the language of § 315(b) is unambiguous and there is no legislative history that contradicts its plain meaning; (3) voluntary dismissal of a complaint for

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patent infringement does not affect the running of the “one year” time period under § 315(b); and (4) the holdings of the Federal Circuit in *Graves* and *Bonneville* relied upon by the Board are inapposite to the Board’s determination that the dismissal of an action without prejudice leaves the parties as though the underlying complaint had never been served. Reh’g Req. 2-13. For the reasons set forth below, Patent Owner’s request for rehearing is denied.

**II. ANALYSIS**

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000). The request for rehearing must specifically identify all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 427.71(d). Given the similarities that exist between the issues that Patent Owner raises in its request for rehearing, we group the issues into two subsets and address them in turn.

With respect to the first and second issues set forth above, Patent Owner’s contentions are predicated on the notion that there is nothing ambiguous about the statutory language of § 315(b) (Reh’g Req. 3-8), which provides:

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An inter partes review may not be instituted if the petition requesting the proceeding is filed more than one 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*.

Emphasis added. However, Patent Owner does not provide us with a credible reason why we should not look to both the Federal Rules of Civil Procedure and Federal Circuit precedent when interpreting the statutory language of § 315(b). *See, e.g., Macauto U.S.A. v. BOS GmbH & Kg*, Paper 18, IPR2012-00004, slip op. at 14-16 (PTAB 2013 Jan. 24, 2013); *Ariosa Diagnostics v. Isis Innovation Ltd.*, Paper 20, IPR2012-00022, slip op. at 4-8 (PTAB Feb. 12, 2013).

With respect to the third and fourth issues set forth above, we maintain our initial position that both the Federal Rules of Civil Procedure and Federal Circuit precedent treat a dismissal without prejudice as something that, *de jure*, never existed. Dec. 16-17. It is undisputed that the patent infringement suit filed by Inforocket against Keen—now Ingenio LLC—on June 8, 2001, was dismissed without prejudice on March 21, 2003. Ex. 1019; Ex. 1017 at 4; Ex. 1018 at 8. We have determined that, because that patent infringement suit was dismissed without prejudice, Federal Circuit precedent interprets such a dismissal as leaving the parties in the same legal position as if the underlying complaint had never been served. *See Graves v. Principi*, 294 F.3d 1350, 1356 (Fed. Cir. 2002); *Bonneville Assoc., Ltd. Partnership v. Baram*, 165 F.3d



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1360, 1364 (Fed. Cir. 1999); *accord* 9 Wright, Miller, Kane, and Marcus, Federal Prac. & Proc. Civ. § 2367 (3d. ed.).

Patent Owner’s argument that the holdings of the Federal Circuit in *Graves* and *Bonneville* are inapposite to the Board’s determination is not persuasive. Reh’g Req. 9-12. Patent Owner does not reconcile how the dismissal of an action without prejudice leaves the parties in the same legal position as if the action had “never been filed,” which Patent Owner readily admits is the correct holding in the Federal Circuit’s *Graves* decision (*id.* at 10-11), yet somehow would not affect the running of the “one year” time period under § 315(b). Nor does Patent Owner explain adequately why the holdings of the Federal Circuit in *Graves* and *Bonneville* should not apply to a petition for *inter partes* review. In addition, Patent Owner does not direct us to Federal Circuit or other precedent that supports its argument.

### III. CONCLUSION

For the foregoing reasons, the Board did not abuse its discretion when determining that Petitioners—namely Ingenio LLC—are not barred from pursuing an *inter partes* review under 35 U.S.C. § 315(b). Accordingly, Patent Owner’s request for rehearing is denied.

**APPENDIX G — DECISION OF THE UNITED  
STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL  
BOARD, FILED OCTOBER 30, 2013**

Trials@uspto.gov  
571-272-7822

Paper 26  
Entered: October 30, 2013

UNITED STATES PATENT  
AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL  
AND APPEAL BOARD

Case IPR2013-00312  
US Patent No. 5,818,836

ORACLE CORPORATION, ORACLE OTC  
SUBSIDIARY LLC, INGENIO LLC,  
AND YELLOWPAGES.COM LLC,

*Petitioners,*

v.

CLICK-TO-CALL TECHNOLOGIES LP,

*Patent Owner.*

Before MICHAEL R. ZECHER, THOMAS L.  
GIANNETTI, and TRENTON A. WARD, *Administrative  
Patent Judges.*

ZECHER, *Administrative Patent Judge.*

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**DECISION**

Institution of Inter Partes Review  
37 C.F.R. § 42.108

**I. INTRODUCTION**

Oracle Corporation, Oracle OTC Subsidiary LLC, Ingenio, LLC, and Yellowpages.com LLC (“Petitioners”) filed a petition (“Pet.”) requesting *inter partes* review of claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, and 26-30 of U.S. Patent No. 5,818,836 (“the ’836 patent”). Paper 1. Click-to-Call Technologies LP (“Patent Owner”) filed a preliminary response (“Prelim. Resp.”). Paper 14. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

THRESHOLD—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

For the reasons set forth below, we conclude that the information presented in the petition establishes that there is a reasonable likelihood that Petitioners will prevail in challenging claims 1, 2, 8, 12, 13, 15, 16,

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19, 22, 23, 26, 29, and 30 as unpatentable. However, we conclude that the information presented in the petition does not establish that there is a reasonable likelihood that Petitioners will prevail in challenging claims 18, 24, 27, and 28 as unpatentable. Pursuant to 35 U.S.C. § 314, we hereby authorize an *inter partes* review to be instituted only as to claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent.

**A. Related Matters**

Petitioners indicate that the '836 patent was asserted in the following civil actions, each of which was filed in the U.S. District Court for the Western District of Texas: (1) *Click to Call Technologies LP v. Oracle Corporation, Oracle OTC Subsidiary LLC, Dell Inc.; Carnival Cruise Lines; The Harford Financial Services Group, Inc.; BMO Harris Bank N.A.; Allstate Insurance Company; Esurance Insurance Services, Inc.; HSBC Finance Corporation; and Macy's Inc.*, Civil Action No. 1:12-cv-00468-SS, filed on May 29, 2012; (2) *Click to Call Technologies LP v. eHarmony, Inc.*, Civil Action No. 1:12-cv-00469-SS, filed on May 30, 2012; and (3) *Click to Call Technologies LP v. AT&T, Inc.; YP Holdings LLC; Ingenio, Inc.; Yellowpages.com LLC; Ether, a division of Ingenio, Inc.; and Ingenio, Inc., doing business as Keen*, Civil Action 1:12-cv-00465-SS, filed on May 29, 2012. Pet. 1-2.

**B. The Invention of the '836 Patent (Ex. 1001)**

The invention of the '836 patent generally relates to a method and system for establishing anonymous telephone

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communications. Ex. 1001, 1:8-9. Figure 1 of the '836 patent illustrates an anonymous voice communication system 10. Ex. 1001, 4:35, 54-56. Figure 1 is reproduced below:

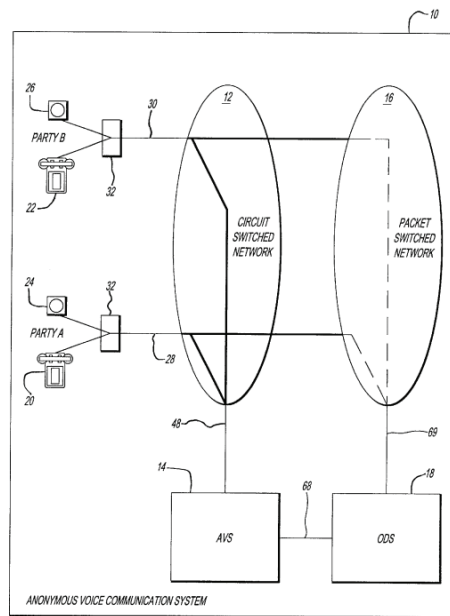


FIG. 1

Figure 1 of the '836 patent indicates that system 10 uses a circuit switched network ("CSN") 12 and an anonymous voice system ("AVS") 14 to establish anonymous voice communication between party A and party B. Ex. 1001, 4:56-59. In another embodiment, system 10 uses a packet switched network ("PSN") 16 and an on-line data system ("ODS") 18 to initiate an anonymous voice communication between party A and party B. Ex. 1001, 4:59-63.

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The '836 patent discloses that each party has a telephone station 20, 22 associated therewith that is connected to CSN 12. Ex. 1001, 4:64-65. Telephone stations 20, 22 may be ordinary telephones, integrated services digital network telephones, or any device that can terminate an access line, play an audio signal, and transmit a received audio signal. Ex. 1001, 5:24-27. System 10 uses CSN 12 to establish a voice connection between the respective telephone stations 20, 22 of each party and AVS 14. Ex. 1001, 4:65-67.

The '836 patent further discloses that each party may have a data terminal 24, 26 associated therewith that is connected to ODS 18 via CDS 12 and PSN 16. Ex. 1001, 5:5-8. The data terminals may be a personal computer with the ability to process and store data, display information, accept input via a keyboard, microphone, or writing tablet, and communicate with other devices via a serial port, modem, or local area network. Ex. 1001, 5:28-32. Each party may use its respective data terminals 24, 26 to exchange messages through ODS 18 to request an anonymous voice connection, which, in turn, causes ODS 18 to generate a command that prompts AVS 14 to establish a telephone connection between the parties. Ex. 1001, 5:8-13.

The '836 patent discloses at least three different methods of creating anonymous voice communication using system 10 illustrated in Figure 1: (1) standalone; (2) on-line; and (3) single party initiated. Ex. 1001, 9:45-47. With respect to the on-line method of establishing an anonymous voice communication, the parties initiate an anonymous voice call using ODS 18. Ex. 1001, 16:54-55.

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Both parties use their data terminals 24, 26 to log on to ODS 18. Ex. 1001, 16:55-57. The parties may contact each other via ODS 18 using public chat, private chat, electronic mail, or newsgroups. Ex. 1001, 16:57-59. The parties can communicate via ODS 18 without revealing their identity to each other, i.e., they are identified by screen names, handles, or subscriber identifications, which only the operator of ODS 18 can translate into the subscriber's identification. Ex. 1001, 16:59-64. According to the '836 patent, either party A or party B may initiate an anonymous voice communication using the on-line method. Ex. 1001, 16:65.

**C. Illustrative Claim**

Claims 1 and 12 are independent claims. Claims 2, 8, 22-24, 26, and 27 directly or indirectly depend from independent claim 1, and claims 13, 15, 16, 18, 19, and 28-30 directly or indirectly depend from independent claim 12. Independent claim 1 is illustrative of the invention of the '836 patent and is reproduced below:

1. A method for creating a voice connection over a circuit switched network between a first party and a second party using an on-line data service to initiate the connection, comprising the steps of:
  - a) establishing an electronic communication between the first party and the second party through the on-line data service between the first party and the second party, wherein

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the first party is anonymous to the second party prior to establishing a first electronic communication between the first party and the second party, wherein the establishing includes providing over the Internet, to a data terminal of the first party coupled to the Internet, information publicly accessible over the Internet, wherein the information public[ly] accessible over the Internet is suitable for presentation within a graphical user interface of the data terminal of the first party, wherein the information publicly accessible over the Internet includes:

- (1) first information characterizing a second party,
- (2) second information representing a communication from the second party, and
- (3) third information specifying a user-selectable element for display within the graphical user interface of the data terminal of the first party, wherein the user-selectable element is visually associated, within the graphical user interface of the data terminal of the first party, with the first information and the second information, when the first information, second information and



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user-selectable element are presented within the graphical user interface of the data terminal of the first party; and

(b) following the establishment of an electronic communication between the first party and the second party through the on-line data service between the first party and the second party, and in response to receiving an indication of selection of the user-selectable element displayed within the graphical user interface of the data terminal of the first party, performing the steps of:

(1) requesting a voice communication between the first party and the second party through the on-line data service;

(2) transmitting a message from the on-line data service to a voice system requesting the voice connection between said first party and said second party;

(3) establishing a first telephone call for the first party;

(4) establishing a second telephone call for the second party; and

(5) connecting said first telephone call with said second telephone call.

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Ex. 1001—Ex parte Reexamination Certificate, 1:26-2:8 (brackets and emphasis omitted).

**D. Prior Art Relied Upon**

Petitioners rely upon the following prior art references:

Dezonno	US 5,991,394	Nov. 23, 1999 Ex. 1002 (effectively filed Apr. 21, 1995)
Dozier	US 5,870,552	Feb. 9, 1999 Ex. 1003 (filed Mar. 28, 1995)
Freeman	US 5,428,608	June 27, 1995 Ex. 1005 (filed Dec. 30, 1993)
Blinken	US 4,796,293	Jan. 3, 1989 Ex. 1016 (filed Dec. 18, 1987)

DALE DOUGHERTY & RICHARD KOMAN, THE MOSAIC HANDBOOK FOR MICROSOFT WINDOWS 17-39 (1994) (Ex. 1004) (“Mosaic Handbook”).

Peter H. Lewis, “*Attention Shoppers: Internet Is Open*,” N.Y. Times, Aug. 12, 1994 (Ex. 1006) (“Attention Shoppers”).

CYBERSPACE FIRST STEPS 177-79, 273-301 (Michael Benedikt ed., 1992) (Ex. 1012) (“Cyberspace”).

ED KROL, THE WHOLE INTERNET USER’S GUIDE & CATALOG 259, 322 (1992) (Ex. 1013) (“Whole Internet”).

*Appendix G***E. Alleged Grounds of Unpatentability**

Petitioners challenge claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, and 26-30 of the '836 patent based on the alleged grounds of unpatentability set forth in the table below.

Reference(s)	Basis	Claims Challenged
Dezonno	§102(e)	1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 <sup>1</sup>
Dezonno	§103(a)	1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 <sup>2</sup>
Dezonno and Mosaic Handbook	§103(a)	22 and 29
Freeman and Attention Shoppers	§103(a)	1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, and 26-30
Freeman, Attention Shoppers, and Blinken	§103(a)	8, 15, and 16

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1. While Petitioners include dependent claims 18 and 24 in the statement of the ground of unpatentability (Pet. 21), Petitioners nonetheless do not include dependent claims 18 and 24 in the corresponding analysis (*see id.* at 21-31). Conversely, while Petitioners omit dependent claims 22 and 29 in the statement of the ground of unpatentability (*id.* at 21), Petitioners nonetheless include dependent claims 22 and 29 in the corresponding analysis (*id.* at 31). We will treat the incorrect statement of the ground of unpatentability as a typographical error and presume Petitioners intended to assert that claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated under 35 U.S.C. § 102(e) by Dezonno.

2. *See supra* n. 1.

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Freeman, Cyberspace, and Whole Internet	§103(a)	1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, 26, 29, and 30
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**II. CLAIM CONSTRUCTION**

Consistent with the statute and legislative history of the Leahy-Smith America Invents Act, Pub. L. 112-29, 125 Stat. 284, 329 (2011), the Board construes claims by applying the broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.100(b); *see also* Office Patent Trial Practice Guide, 77 *Fed. Reg.* 48756, 48766 (Aug. 14, 2012). There is a “heavy presumption” that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

**A. Claim Terms or Phrases**

Petitioners propose claim constructions for a number of claim terms or phrases recited in the ’836 patent that are not disputed by the Patent Owner. Pet. 8-11 (citing to Ex. 1009; Ex. 1010). The claim constructions proposed by the Petitioners are set forth in the table below.

Claim(s)	Claim Terms or Phrases	Petitioners’ Proposed Claim Construction
1 and 12	“party”	A person or group participating in an action.

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1 and 12	“anonymous”	Identity is not revealed.
1 and 12	“voice system”	A system that can connect voice calls.
1 and 12	“data terminal”	A computing device capable of sending and/or receiving data.
1	“on-line data service”	A service provided by an on-line data system, such as electronic mail, chat, newsgroups, or access to information.
12	“on-line data system”	A computing device or distributed computing system with storage and communications capability that provides services on-line, such as electronic mail, chat, newsgroups, or access to information.
1 and 12	“information publicly accessible”	Information that is widely available and subject to minimal constraints, such as subscription, registration, or ability to access the on-line data service or system.

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1	“establishing [or establishment of] an electronic communication between the first party and the second party”	Transferring information electronically from one party to another party.
1 and 12	“second information representing a communication from the second party”	Information representing information transferred from the second party.
1	“requesting a voice communication between the first party and the second party through the on-line data service”	Requesting a voice communication using the on-line data service.
12	“connect command”	A command that directs the voice system to connect a first telephone call with a second telephone call.
1 and 12	“indication [or indicative] of selection of the user-selectable element”	Information indicating that the user-selectable element was selected.

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12	“on-line data system that is coupled to the data terminal of each party”	A computing device or distributed computing system with storage and communications capability that provides services on-line, such as electronic mail, chat, newsgroup, or access to information, and is coupled to the data terminal of each party.
1	“on-line data service between the first and the second party”	A service provided by an on-line data system, such as electronic mail, chat, newsgroup, or access to information.

Based on our review of the specification of the '836 patent, we determine that the claim constructions proposed by Petitioners for the aforementioned claim terms or phrases are consistent with their ordinary and customary meaning, as would be understood by one with ordinary skill in the art, and that there is nothing in the specification of the '836 patent to suggest that any other claim constructions are appropriate.

**B. “First information” and “second information” (Claims 1 and 12)**

Petitioners contend that the claim terms “first information” and “second information” recited in

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independent claims 1 and 12 are not entitled to patentable weight because each such claim term amounts to non-functional descriptive material that has no functional relationship to any substrate or other portions of the claims. Pet. 60. In response, Patent Owner contends that the “first information” and “second information” recited in independent claim 1 are entitled to patentable weight because they have a direct functional relationship to the “establishing” step (a), as well as the “performing” steps (b)(1)-(5), all of which are recited in independent claim 1. Prelim. Resp. 21-23. Similarly, Patent Owner contends that “first information” and “second information” recited in independent claim 12 are entitled to patentable weight because they have a direct functional relationship to “the provision of the information publicly accessible,” which is structured through the visual association of a user-selectable element with the first and second information recited in independent claim 12. *Id.* at 23.

Contrary to Petitioners’ argument, the claim terms “first information” and “second information” further limit the claimed invention functionally. With respect to independent claim 1, the claim terms “first information” and “second information” are related functionally to “the establishment of an electronic communication between the first party and the second party.” That is, “the establishment of an electronic communication between the first party and the second party” cannot occur until the “first information” and “second information” are associated visually with “the user-selectable element.” Moreover, the “performing” steps (b)(1)-(5) that establish a “voice communication between the first party and the second party” cannot occur until after “the establishment



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of an electronic communication between the first party and the second party.”

With respect to independent claim 12, the claim terms “first information” and “second information” are related functionally to “the on-line data system . . . generat[ing] a connect command.” That is, “the on-line data system” cannot “generate[] a connect command” until the “first information” and “second information” are associated visually with “the user-selectable element.” Moreover, the “voice system” cannot “connect[] a first telephone call of the first party with a second telephone call of the second party” until “the on-line data system generates a connect command.” Given the functional relationship that the “first information” and the “second information” have with other claimed features recited in independent claims 1 and 12, these claim terms limit the claimed invention functionally and, as a result, are entitled to patentable weight.

### **III. ANALYSIS**

#### **A. Statutory Bar Pursuant to 35 U.S.C. § 315(b)**

Patent Owner contends that one of the Petitioners—namely Ingenio, LLC—was served with a complaint alleging infringement of the ’836 patent in a civil action filed in the U.S. District Court for the Southern District of New York on June 8, 2001. Prelim. Resp. 3-4, 7. Patent Owner argues that service of the complaint in that infringement suit occurred more than one year before the petition in this proceeding was filed on May 28, 2013. *Id.* Therefore, Patent Owner argues that the petition in

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this proceeding should be denied because Ingenio, LLC is barred from pursuing an *inter partes* review for the '836 patent pursuant to 35 U.S.C. § 315(b). *Id.*

The following timeline was provided by Patent Owner and is helpful in determining whether Ingenio, LLC is barred from filing an *inter partes* review of the '836 patent: (1) in 2001, the inventor of the '836 patent—Stephen C. DuVal—granted an exclusive license to Inforocket; (2) on June 8, 2001, Inforocket sued Keen for infringement of the '836 patent (Ex. 2002; Ex. 2003); (3) in early 2003, Keen acquired Inforocket as its wholly-owned subsidiary and, thereafter, Inforocket dismissed the infringement suit against Keen; (4) later in 2003, Keen changed its name to Ingenio, Inc. (Ex. 2004 at §§ 3.13, 3.15; Ex. 2005; and Ex. 2006, n. 29); (5) on May 29, 2012, Click-to-Call Technologies LP asserted the '836 patent against multiple parties, including Ingenio, LLC (Ex. 2007); (6) in the infringement suit filed on May 29, 2012, Ingenio admitted that the correct name of Ingenio, Inc. is actually Ingenio, LLC (*see* Ex. 2007 at 4). Prelim. Resp. 4-7. Petitioners have admitted that the timeline provided by Patent Owner is, in fact, correct. Paper 16 at 2-3.

In additional briefing requested by the Board, both Petitioners and Patent Owner provided more factual evidence regarding the dismissal of the infringement suit between Inforocket and Keen that occurred in early 2003. Petitioners indicate that Inforocket dismissed its infringement suit against Keen without prejudice on March 21, 2003. Paper 17 at 2 (citing to Ex. 1019). Patent Owner also acknowledges that Inforocket and

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Keen voluntarily agreed to dismiss the infringement suit without prejudice. Paper 20 at 1 (citing to Ex. 1017 at 4; Ex. 1018 at 8).

We begin our analysis by noting that whether Petitioners are barred from pursuing an *inter partes* review pursuant to 35 U.S.C. § 315(b) is a threshold issue. 35 U.S.C. § 315(b) provides that:

An inter partes review may not be instituted if the petition requesting the proceeding is filed more than one 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.

The statute requires that the service date of the complaint be more than one year before the petition was filed—in this case more than one year before May 28, 2013. Patent Owner has not established that service of the complaint in the infringement suit brought by Inforocket against Keen bars Ingenio, LLC from pursuing an *inter partes* review for the '836 patent.

With respect to the requirement of service, we note that the infringement suit brought by Inforocket against Keen—now Ingenio, LLC—was dismissed voluntarily without prejudice on March 21, 2003, pursuant to a joint stipulation under Fed. R. Civ. P. 41(a). Ex. 1019; *see also* Ex. 1017 at 4; Ex. 1018 at 8. The Federal Circuit consistently has interpreted the effect of such dismissals as leaving the parties as though the action had never been

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brought. *Graves v. Principi*, 294 F.3d 1350, 1356 (Fed. Cir. 2002) (“The dismissal of an action without prejudice leaves the parties as though the action had never been brought”); *Bonneville Assoc., Ltd. Partnership v. Baram*, 165 F.3d 1360, 1364 (Fed. Cir. 1999) (“The rule in the federal courts is that ‘[t]he effect of a voluntary dismissal without prejudice pursuant to Rule 41(a) is to render the proceedings a nullity and leave the parties as if the action had never been brought.’”) (citations and internal quotes omitted). *Accord* 9 WRIGHT, MILLER, KANE, and MARCUS, FEDERAL PRAC. & PROC. CIV. § 2367 (3d. ed.) (“[A]s numerous federal courts have made clear, a voluntary dismissal without prejudice under Rule 41(a) leaves the situation as if the action never had been filed.”) (footnote omitted). Accordingly, the dismissal of the infringement suit brought by Inforocket against Keen—now Ingenio, LLC—nullifies the effect of the service of the complaint and, as a consequence, does not bar Ingenio, LLC or any of the other Petitioners from pursuing an *inter partes* review of the ’836 patent.

In the additional briefing requested by the Board, Petitioners and Patent Owner also raised the following issues: (1) whether a statutory bar pursuant to 35 U.S.C. § 315(b) should be determined on a “petitioner-by-petitioner” basis; and (2) whether the patent at issue in the infringement suit brought by Inforocket against Keen is the same patent at issue in this proceeding. Paper 17 at 4-6; Paper 20 at 3-5. The current situation does not require us to assess the merits of these issues because, as we discussed above, neither Ingenio, LLC nor any of the other Petitioners is barred from pursuing an *inter partes* review of the ’836 patent.

*Appendix G***B. 35 U.S.C. § 103(a) Grounds of Unpatentability  
Based in Whole or in Part on Dezonno**

Petitioners contend that: (1) claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated under 35 U.S.C. § 102(e) by Dezonno; (2) claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable under 35 U.S.C. § 103(a) over Dezonno; and (3) claims 22 and 29 are unpatentable under 35 U.S.C. § 103(a) over the combination of Dezonno and Mosaic Handbook. Pet. 15-33. In particular, Petitioners rely upon claim charts to explain how Dezonno, either standing alone or in combination with Mosaic Handbook, allegedly describes the claimed subject matter, as well as the Declaration of Robert L. Stevenson (Ex. 1007) to support its positions. *Id.* We are persuaded by Petitioners' claim charts and supporting evidence.

We begin our analysis with a general discussion of Dezonno, the argument presented by Patent Owner that is directed to whether Dezonno qualifies as prior art to the '836 patent, and then we turn to the position taken by Petitioners with respect to the date of conception of the invention of the '836 patent.

**1. Dezonno (Ex. 1002)**

Dezonno was filed on February 5, 1998, but claims priority to U.S. Patent Application No. 08/426,533, filed on April 21, 1995. Dezonno generally relates to establishing voice communications between a computer user and an agent of a business via a computer network, such as the Internet. Ex. 1002, 1:8-13. The computer user transmits

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a call request over the computer network to a telephone switching system associated with the business agent. Ex. 1002, 1:13-16. In response to the call request, the telephone switching system calls the computer user and connects the business agent to the computer user when the computer user answers the call. Ex. 1002, 1:16-19.

Figure 2 of Dezonno illustrates an exemplary home page that is used for advertisement purposes by a business on the Internet. Ex. 1002, 3:15-16, 64-65. Figure 2 is reproduced below:

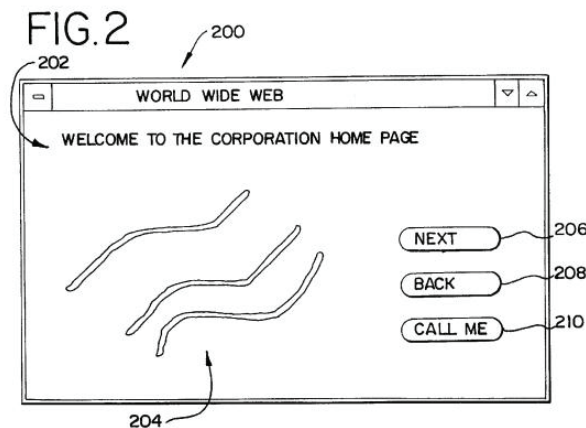


Figure 2 of Dezonno indicates that business home page 200 includes a text portion 202 describing a product or service. Ex. 1002, 3:67-4:2. The “next” and “back” buttons 206, 208 transfer a computer user 102 (illustrated in Figure 1) to the next home page or the previous home page, respectively. Ex. 1002, 4:2-4. If the computer user 102 wants to establish voice communications with the business to order a product or to ask a question, the

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computer user 102 selects the “call me” button 210. Ex. 1002, 4:7-10.

After selecting the “call me” button 210, the computer user 102 is transferred to a return call screen 300. Ex. 1002, 4:10-11. Figure 3 of Dezonno illustrates an exemplary return call screen 300 used by the computer user 102 to request a return call from the business. Ex. 1002, 3:17-18. Figure 3 is reproduced below:

**FIG. 3**

Figure 3 of Dezonno indicates that the computer user 102 enters his/her name 302, telephone number to call 304, and a time to call 306, 308 in their respective fields. Ex. 1002, 4:11-13, 17-22. Alternatively, the name and telephone number of the computer user 102 may be kept on file and automatically entered in the appropriate fields. Ex. 1002, 4:13-16. After filling in the requested information, the computer user 102 selects the “next” button 310, which, in turn, sends a call request to the telephone switching system 112 (illustrated in Figure 1).

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Ex. 1002, 4:22-24. In one embodiment, Dezonno discloses that the communication system simultaneously transmits information to an agent 104 (illustrated in Figure 1) while connecting the agent 104 with the computer user 102. Ex. 1002, 5:43-46.

**2. Patent Owner's Contentions**

Patent Owner contends that Dezonno does not qualify as prior art under 35 U.S.C. § 102(e) because the invention of the '836 patent was conceived prior to the effective filing date of Dezonno, i.e., April 21, 1995. Prelim. Resp. 11. Patent Owner directs our attention to the invention disclosure document (Ex. 1008) filed on October 18, 1994, as well as two additional invention disclosure documents (Ex. 2010, Ex. 2011) filed on March 8, 1995, and May 10, 1995, respectively. *Id.* at 12-13. Patent Owner argues that the invention disclosure document (Ex. 1008) filed October 18, 1994, in combination with the invention disclosure document (Ex. 2010) filed on March 8, 1995, corroborates conception of the invention of the '836 patent prior to April 21, 1995, and, as a result, disqualifies Dezonno as prior art. *Id.* at 13-14 (citing to Ex. 2010, pp. 102, 115).

**3. Petitioners' Contentions**

Petitioners take the position that the '836 patent is not entitled to claim priority to a date of invention that is earlier than the filing date of Dezonno's parent patent application—U.S. Patent Application No. 08/426,533, filed on April 21, 1995. Pet. 17-18. In particular, Petitioners contend that while Patent Owner filed an invention



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disclosure document (Ex. 1008) on October 18, 1994, which allegedly establishes a date of conception for the claimed invention prior to the effective filing date of Dezonno, i.e., April 21, 1995, that invention disclosure document does not disclose requesting voice communication or generating a connect command in response to receiving an indication of selection of any user-selectable element, as is required by independent claims 1 and 12. *Id.* at 18-20. Therefore, Petitioners argue that the invention disclosure document (Ex. 1008) cannot provide corroboration for a date of conception for independent claims 1 and 12 of the '836 patent as of October 18, 1994. *Id.* at 20.

#### 4. Analysis

Even assuming that Patent Owner can establish conception of the invention of the '836 patent prior to the effective filing date of Dezonno, i.e., April 21, 1995, Patent Owner has not presented sufficient or credible evidence to establish diligence in reduction to practice from April 20, 1995, to the filing date of the '836 patent, i.e., August 9, 1995. To establish diligence, a patent applicant must be specific as to date and facts. *Kendall v. Searles*, 173 F.2d 986, 993 (CCPA 1949). Moreover, a patent applicant must provide such dates and facts for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919 (CCPA 1966).

While Patent Owner indicates its intent is to submit a declaration pursuant to 37 C.F.R. § 1.131(a) that establishes diligence during the entire critical period, i.e., April 20, 1995 through August 9, 1995 (Prelim. Resp. 11-12), such

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a declaration is not before us. Given the absence in the record of adequate supporting evidence, we are unable at this stage to conclude that Patent Owner will be able to establish diligence for the entire critical period during which diligence is required. Therefore, on this record, we are not persuaded by Patent Owner's argument that Dezonno does not qualify as prior art to the claims of the '836 patent.

In addition, the claim charts and supporting evidence presented by Petitioners to explain how Dezonno, either standing alone or in combination with Mosaic Handbook, describes the claimed subject matter recited in claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 have merit and are otherwise unrebutted. Based on the record before us, Petitioners have demonstrated a reasonable likelihood of prevailing on their assertion that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable based in whole or in part on Dezonno.

**C. 35 U.S.C. § 103(a) Grounds of Unpatentability  
Based in Part on Freeman**

Petitioners contend that: (1) claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, and 26-30 are unpatentable under 35 U.S.C. § 103(a) over the combination of Freeman and Attention Shoppers; (2) claims 8, 15, and 16 are unpatentable under 35 U.S.C. § 103(a) over the combination of Freeman, Attention Shoppers, and Blinken; and (3) claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, 26, 29, and 30 are unpatentable under 35 U.S.C. § 103(a) over the combination of Freeman, Cyberspace, and Whole Internet. Pet. 33-60. In particular,

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Petitioners rely upon claim charts to explain how the combination of prior art references allegedly teaches the claimed subject matter, as well as the Declaration of Mr. Stevenson (Ex. 1007) to support their positions. *Id.* We have considered Petitioners' analysis and supporting evidence, as well as Patent Owner's arguments, but are not persuaded that Freeman teaches the following claim limitations: (1) "establishing a first telephone call for the first party," "establishing a second telephone call for the second party," and "connecting said first telephone call with said second telephone call," as recited in independent claim 1; and (2) "[the] voice system . . . connects a first telephone call of the first party with a second telephone call of the second party in response to the connect command," as recited in independent claim 12.

We begin our analysis with a general discussion of Freeman, the positions taken by Petitioners with respect to how Freeman allegedly teaches the aforementioned claim limitations recited in independent claims 1 and 12, and then we turn to the arguments presented by Patent Owner that are directed towards whether Freeman teaches those claim limitations.

**1. Freeman**

Freeman generally relates to providing simultaneous voice and data ("SVD") communications using an SVD modem. Ex. 1005, 1:6-8. Figure 6 of Freeman illustrates a process by which a user, who is using a data channel to engage in an application, automatically adds voice communication over a voice channel with the person best

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suited to help him/her. Ex. 1005, 4:58-64, 12:52-59. Figure 6 is reproduced below:

**FIG. 6**

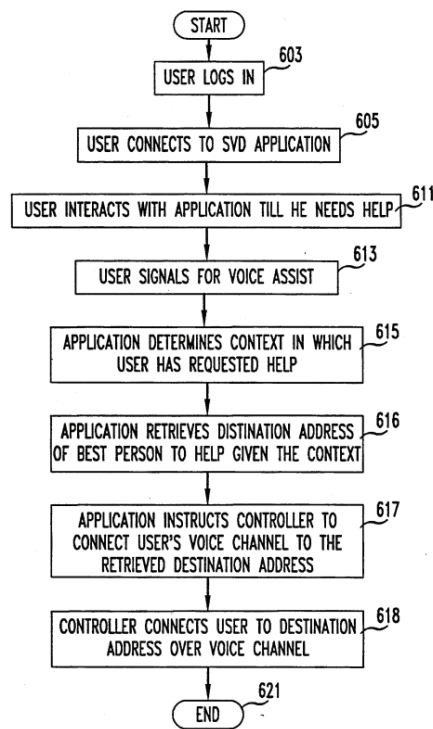


Figure 6 of Freeman indicates that the process begins in step 601, where a user of the application initiates a call to an SVD modem in one of the SVD modem pools. Ex. 1005, 12:60-63. At step 603, the user logs in. Ex. 1005, 12:63-64. At step 605, the user selects a particular application and connects thereto over a data channel. Ex. 1005, 12:64-66. At step 611, the user communicates and interacts with

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the selected application via the data channel until the user encounters something in the application for which he or she needs help. Ex. 1005, 13:1-4. At step 613, the user requests help through the application by signaling for voice assistance. Ex. 1005, 13:11-13.

At step 615, the application recognizes the help command and determines the context in which the help was sought, i.e., the activity of the application in which the user currently is engaged. Ex. 1005, 13:18-21. Given the context of the request, the application then retrieves the destination address, e.g., telephone number, of the person best suited to help the user. Ex. 1005, 13:24-27. At step 617, the application instructs the controller associated with the SVD modem pool through which the requesting user is connected to establish a voice connection with the retrieved destination address through a CSN. Ex. 1005, 13:35-40. At step 619, the user is connected to the destination address over a voice channel and alerted to the existence of the voice connection. Ex. 1005, 13:45-48. At step 621, the process ends. Ex. 1005, 13:48-49.

## **2. Petitioners' Contentions**

Petitioners take the position that Freeman's disclosure of retrieving the telephone number for the person best suited to help the user, and instructing an adjunct controller to establish a voice connection with that telephone number, amounts to "establishing a first telephone call for the first party," as recited in independent claim 1. Pet. 40 (citing to Ex. 1005, 13:29-40). In addition, Petitioners take the position that Freeman's disclosure of connecting

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the user to the retrieved telephone number over a voice channel constitutes both “establishing a second telephone call for the second party” and “connecting said first telephone call with said second telephone call,” as recited in independent claim 1. *Id.* (citing to Ex. 1005, 13:45-47). Petitioners explain that because “the user’s voice channel is connected to a telephone, it is clear that a call is placed to the user’s telephone and that this call is connected to the phone call to the identified representative in order to allow the user to talk to the identified representative.” *Id.* Petitioners rely upon the same position to support their assertion that Freeman teaches “[the] voice system . . . connects a first telephone call of the first party with a second telephone call of the second party in response to the connect command,” as recited in independent claim 12. Pet. 44 (“*See* the evidence and information cited from claim limitations 1.f-1.j[.]”).

### **3. Patent Owner’s Contentions**

In response, Patent Owner contends that a single telephone call is made from the user to the telephone number of the person best suited to help the user. Pet. 18. In other words, Patent Owner argues that, because two separate and distinct telephone calls are not established, Freeman does not connect a first telephone call with a second telephone call, as required by independent claim 1. *Id.* at 18-19. Patent Owner relies upon essentially the same arguments presented against the disputed claim limitations recited in independent claim 1 to rebut Petitioners’ position that Freeman teaches “[the] voice system . . . connects a first telephone call of the first

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party with a second telephone call of the second party in response to the connect command,” as recited in independent claim 12. *Id.* at 19-20.

#### 4. Analysis

As discussed above, Freeman discloses that, depending on the context of the user’s request, the application retrieves the telephone number of a person best suited to help the user. Ex. 1005, 13:24-27. Next, Freeman indicates that the application instructs the adjunct controller to establish a voice connection with the retrieved telephone number through a CSN. Ex. 1005, 13:35-40. After a voice connection is established between the user and the retrieved telephone number, Freeman discloses that the user is alerted to the existence of the voice connection. Ex. 1005, 13:45-48.

Based on these cited disclosures, we agree with Patent Owner that Freeman establishes a single voice connection, i.e., telephone call, between the user and the person best suited to help the user. There is no indication that Freeman’s SVD system establishes a first telephone call with the user, establishes a second telephone call with the person best suited to help the user, and then bridges the connection between the first and second telephone calls. As such, we are not persuaded that Petitioners have presented sufficient evidence to support a finding that Freeman teaches the following claim limitations: (1) “establishing a first telephone call for the first party,” “establishing a second telephone call for the second party,” and “connecting said first telephone call with said second

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telephone call,” as recited in independent claim 1; and (2) “[the] voice system . . . connects a first telephone call of the first party with a second telephone call of the second party in response to the connect command,” as recited in independent claim 12.

Based on the record before us, Petitioners have not demonstrated a reasonable likelihood of prevailing on their assertion that independent claims 1 and 12 are unpatentable based in part on Freeman. Claims 2, 8, 22-24, 26, and 27 directly or indirectly depend from independent claim 1, and claims 13, 15, 16, 18, 19, and 28-30 directly or indirectly depend from independent claim 12. For the same reasons discussed above with respect to independent claims 1 and 12, Petitioners have not demonstrated a reasonable likelihood of prevailing on their assertion that dependent claims 2, 8, 13, 15, 16, 18, 19, 22-24, and 26-30 are unpatentable based in part on Freeman.

#### IV. CONCLUSIONS

For the foregoing reasons, we conclude that the information presented in the petition establishes that there is a reasonable likelihood that Petitioners would prevail in showing that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable. However, we conclude that the information presented in the petition does not establish that there is a reasonable likelihood that Petitioners will prevail in challenging claims 18, 24, 27, and 28 as unpatentable.



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**V. ORDER**

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted only as to claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent for the following grounds of unpatentability:

A. Claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 as anticipated under 35 U.S.C. § 102(e) by Dezonno;

B. Claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 as unpatentable under 35 U.S.C. § 103(a) over Dezonno; and

C. Claims 22 and 29 as unpatentable under 35 U.S.C. § 103(a) over the combination of Dezonno and Mosaic Handbook;

FURTHER ORDERED that no other grounds of unpatentability are authorized for the *inter partes* review as to claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial. The trial will commence on the entry date of this decision; and

FURTHER ORDERED that an initial conference call with the Board is scheduled for 2PM on November 14,

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2013. The parties are directed to the Office Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012) for guidance in preparing for the initial conference call, and should come prepared to discuss any proposed changes to the Scheduling Order entered herewith and any motions the parties anticipate filing during the trial.