No. _____

In the Supreme Court of the United States

DEXMEDIA, INC., Applicant,

v.

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

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

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

Applicant DexMedia, Inc.,[1] respectfully requests that the time to file a petition for a writ of certiorari in this case be extended for 30 days, to and including December 14, 2018. The United States Court of Appeals for the Federal Circuit issued its opinion on August 16, 2018. (App. A, *infra*.) No petition for rehearing was filed. Without an extension of time, the petition would be due on November 14, 2018. Applicant files this application more than 10 days before that date. S. Ct. R. 13.5. This Court will have jurisdiction pursuant to 28 U.S.C. § 1254(1).

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

Background

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

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

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

infringement action against Keen triggered this § 315(b) bar, even though the complaint was subsequently dismissed without prejudice.

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

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

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

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

Reasons for Granting an Extension of Time

The time to file a petition for a writ of certiorari should be extended for 30 days for the following reasons:

1. Since the decision below was issued, Applicant has been considering whether to seek this Court's review, and only recently decided to petition for certiorari. Moreover, Applicant only recently involved the undersigned counsel of record to assist in this case. Additional time is necessary to study the record below and the legal issues in the case and to prepare a petition.

2. No prejudice would arise from the requested extension. The underlying IPR proceeding that is the subject of this appeal was filed by Applicant's predecessors, Ingenio and YellowPages.com. The Federal Circuit's decision requires that the PTAB dismiss this IPR proceeding. Respondent CTC will not be harmed, in the event that this Court denies the petition, if this PTAB dismissal of the IPR is delayed by 30 days.

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

Conclusion

For these reasons, the time to file a petition for a writ of certiorari should be extended 30 days to and including December 14, 2018.

Respectfully submitted,

/s/ *Adam H. Charnes*
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October 30, 2018

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PROOF OF SERVICE

I, Adam H. Charnes, a member of the Bar of this Court, hereby certify that all parties required by the Rules of this Court to be served have been served. On this 30th day of October, 2018, a copy of this Application for Extension of Time to File Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit was mailed by first-class mail, postage prepaid, to:

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APPENDIX
