

In The
United States Court of Appeals
For The Federal Circuit

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.

**APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK
OFFICE, PATENT TRIAL AND APPEAL BOARD IN IPR2013-00312.**

SUPPLEMENTAL BRIEF OF APPELLANT

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CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 47.4(a)(1) and Federal Rule of Appellate Procedure 36.1, counsel for Appellant Click-To-Call Technologies LP certifies the following:

1. The full name of every party represented by me is:

Click-To-Call Technologies LP

2. The name of the real party in interest represented by me is:

Click-To-Call Technologies LP

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:

None

4. The names of all law firms and the partners or associates that appeared for the party now represented by me in the trial court or agency, or are expected to appear in this Court, are:

Law Office of Peter J. Ayers, PLLC: Peter Ayers

Lee & Hayes, PLLC: Peter Ayers and Reid Johnson (no longer with the firm)

Yudell Isidore Ng Russell, PLLC (now known as Yudell Isidore, PLLC):

Craig Yudell, Eustace Isidore

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47. 4(a)(5) and 47.5(b).

1. *Click to Call Technologies LP v. Oracle Corporation, Oracle OTC Subsidiary LLC, Dell Inc., Carnival Cruise Lines, The Hartford 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. 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 No. 1:12-cv-00465-SS, filed on May 29, 2012.

Dated: Feb. 5, 2018

/s/ Peter Ayers
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I. INTRODUCTION

This case is now back before this panel for the third time. In the previous two go-rounds, the panel dismissed Appellant Click-to-Call LP's appeal because it raised a challenge to the Director's decision to institute an *inter partes* review despite being time-barred under 35 U.S.C. §315(b). In *Wi-Fi One, LLC v. Broadcom Corp.*, this Court decided that such challenges were indeed reviewable on appeal from a final written decision of the Board. In light of that decision, Click-to-Call asked the Court to vacate its prior dismissal and reinstate Click-to-Call's appeal.

On January 19, 2018, the panel granted Click-to-Call's request. In that same order, the panel authorized the parties to 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 brief," i.e., March 9, 2015. Click-to-Call submits this brief pursuant to that order.

As detailed below, Click-to-Call's arguments only have grown stronger over time. Decisions from the Supreme Court, this Court, district courts and even the Board demonstrate that this IPR should not have been instituted because "the petitioner, real party in interest, or privy of the petitioner [was] served with a complaint alleging infringement of the patent" more than a year before filing its petition. 35 U.S.C. §315(b). Those decisions further reinforce Click-to-Call's

argument that the district court’s dismissal without prejudice of the underlying infringement action—as part of a global settlement involving Petitioner Ingenio—did not toll the §315(b) limitations period.

These intervening decisions further confirm that the Board misapplied two inapposite decisions out of this Court—one addressing the impact of a dismissal of an appeal in a Veteran’s case (*Graves v. Principi*, 294 F.3d 1350 (Fed. Cir. 2002)) and another considering the effect of a dismissal in a Board of Contract Appeals case, both holding that the statutes of limitations continue to run notwithstanding dismissals without prejudice of the earlier cases. *See Bonneville Associates, Limited Partnership v. Baram*, 165 F.3d 1360 (Fed. Cir. 1999). From these two inapt decisions, the Board inferred a categorical legal rule that a dismissal without prejudice in a district court case “un-rang” §315(b)’s notice bell and effectively tolled the time-bar to this IPR. That rule not only turns those decisions on their head—turning a “no toll” rule into a tolling one—but it ignores many recent decisions holding that service has legal consequences irrespective of whether the case is dismissed with or without prejudice, e.g., indirect infringement and willfulness. As a result, the Board’s “rule” must be reversed.

Several recent cases also make clear that this Court owes no deference to the PTO on the effect of a dismissal without prejudice on §315(b). Those cases reveal a growing apprehension over *Chevron* deference to agency interpretations, both at

the Supreme Court and this one. Such apprehension is particularly warranted in this case because the PTO's dismissal without prejudice "rule" is: (1) contrary to the plain language of the statute; (2) embodied in a decision of the Board that was not subject to notice and comment; (3) outside of the agency's area of expertise; and (4) contrary to its own regulations. This issue should be decided by an Article III court, not an Article I board.

Finally, while Click-to-Call originally suggested that remand was the preferred course under the *Chenery* doctrine, three years of intervening decisions out of the Supreme Court, this Court and the Board now counsel in favor of a complete reversal. Appellees' alternative arguments are inconsistent with the plain language of the AIA and belied by the undisputed facts in this case. Contrary to Appellees' argument, the issuance of a reexamination certificate does not reset the §315(b) time clock under the plain language of the statute. Appellees also filed one petition identifying themselves consistently as one "Petitioner" (A341-406), consistent with Board practice and policy. As a result, they must fall together. Finally, it is undisputed that the petition identifies a time-barred party as a real party in interest. (A345.) Having conceded that the single petition was filed on behalf of a time-barred party, the petition is barred by §315(b) and the Board is without "Jurisdiction," i.e., authority to institute an IPR. Accordingly, Click-to-Call urges this Court to reverse the Board's decision and render a judgment in its favor.

II. RECENT DECISIONS CONFIRM THAT THE PTO IS NOT ENTITLED TO DEFERENCE IN THIS CASE

Before addressing the merits of the Board’s decision, it is important to identify the prism through which that decision should be viewed. Several recent cases have addressed whether and to what extent courts should defer to an agency’s interpretation. *See, e.g., Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131 (2016); *Aqua Prods. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (*en banc*). These cases only reinforce Click-to-Call’s argument that the PTO is not entitled to deference in this case.

A. Recent Decisions Stress the Primacy of The Statutory Text

In *Cuozzo*, the Supreme Court addressed the issue of whether the PTO exceeded its authority by promulgating a rule adopting the “broadest reasonable interpretation” during *inter partes* review proceedings. The Court reaffirmed that the starting point in the analysis is the text of the statute. “Where the statute is clear, the agency must follow the statute.” 136 S. Ct. at 2142; *see also Kingdomware Techs., Inc. v. United States*, 136 S. Ct. 1969, 1979 (2016) (same); *Esquivel-Quintana v. Sessions*, 137 S. Ct. 1562, 1572 (2017); *Archuleta v. Hopper*, 786 F.3d 1340, 1346-1347 (Fed. Cir. 2015). Only if the statutory scheme “leaves a ‘gap’ or is ‘ambiguous’” may a court look to the agency to fill that void. *Cuozzo, supra*. The Supreme Court found such a “gap” in the AIA that Congress permitted the PTO to

fill by regulation pursuant to its rule-making power under § 316(a)(4). *Cuozzo*, 136 S. Ct. at 2142.

As Click-to-Call explained in its opening brief, the text of § 315(b) is clear—service of a complaint for infringement triggers the one-year statutory bar. There is nothing ambiguous about the word “service.” There is also no “gap” in the statute to fill. In *Cuozzo*, the statute was silent on the appropriate claim construction standard and there were two (BRI and *Phillips*) from which to choose. There is no analog to service; there is only one form of service under the Federal Rules. *See* Fed. R. Civ. P. 4(c). There is also no factual dispute that service was properly effectuated in this case. That should be the end of the discussion. *See Aqua Prods.*, 872 F.3d at 1315 (*en banc*) (when “the intent of Congress is clear ... that [should be] the end of the matter.” (quoting *Chevron U.S.A. Inc. v. NRDC*, 467 U.S. 837, 862 (1984))).

B. Recent Decisions Rely on Regulation Over Adjudication

Even assuming *arguendo* that there was an ambiguity or a gap for the PTO to fill, no deference is due the Board’s decision in this case. “A majority of [Federal Circuit] judges agree; where a statute delegates to the Director the authority to prescribe regulations adopting standards, only notice and comment rulemaking by regulation will be given *Chevron* deference.” *Aqua Prods.*, 872 F.3d at 1332 (Moore, J., dissenting). Even though the AIA granted the PTO authority to

“prescribe regulations ... establishing and governing *inter partes* review under this chapter and the relationship of such review to other proceedings under this title,” 35 U.S.C. § 316(a)(4), the PTO did not promulgate a rule on the effect of a dismissal without prejudice on the § 315(b) time bar. Instead, the PTO chose to adopt this “rule” for the first time in a panel institution decision, which it later made “precedential” *sua sponte* pursuant to its internal “Standard Operating Procedure 2.” See <https://www.uspto.gov/patents-application-process/appealing-patent-decisions/decisions-and-opinions/precedential> (“Oracle Corp. v. Click-to-Call Techs, LP”). This decision was never circulated for consideration or comment by the relevant public (other than the parties) before being made precedential. Because the Board’s decision is not based on a rule, no deference is due the Board’s “precedential” decision. *Aqua Prods. v. Matal*, 872 F.3d at 1332.¹

Ironically, the PTO did promulgate a rule relating to time bars in general—and it cuts the other way. In 37 C.F.R. §42.3—entitled “Jurisdiction”—the PTO requires that “[a] petition to institute a trial must be filed with the Board consistent with any time period required by statute.” As Judge O’Malley correctly observed in *Wi-Fi One*, §315(b) is just such a statute. *Wi-Fi One, LLC v. Broadcom Corp.*, 2018

¹ The same is true under the PTO’s general rule-making authority, which likewise requires regulations not adjudications. See 35 U.S.C. §2(b)(2)(A) (“The Office ... may establish *regulations*, not inconsistent with the law, which ... shall govern the conduct of proceedings in the office.” (emphasis added)).

U.S. App. LEXIS 387, *20, 2018 WL 313065 (O'Malley, J concurring) (“A straightforward reading of these regulations indicates that the PTO believed, at least 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, regardless of the adequacy of those petitions.”).

The administrative history of this rule supports Judge O'Malley's reading that § 315(b) circumscribes the PTO's authority to act. The original version of Rule 42.3 gave the Board considerably more discretion. It simply required a petition be filed “in a timely manner,” leaving it to the Board to decide what was timely. *See* Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48612, 48627 (Aug. 14, 2012). In response to a public comment, however, the PTO changed “in a timely manner” to “consistent with any time period required by statute,” thereby constraining PTO discretion to act. *Id.* (Comment 11). Despite this clear PTO Rule on point, the Board's institution decision in this case did not even consider §42.3 in its analysis, let alone apply it. This is one more reason this Court should not defer to the PTO's decision in this case.

C. Recent Decisions Decline Deference When the Issue Does Not Implicate Agency Expertise

This Court's recent *Aqua Products* decision further strengthens Click-to-Call's argument that no deference is due the PTO on the effect of a dismissal without prejudice. In that case, the PTO argued that its decision to impose the burden of proof on the patent owner in a motion to amend was entitled to deference because it promulgated a rule imposing the burden on the movant. A majority disagreed. *Aqua Products*, 872 F.3d. at 1296.

One of the factors that the Court considered in its *Chevron* analysis was whether the issue in question is one "that implicate[s] the PTO's expertise." *Id.* at 1324. Because "the substantive burden of proof or persuasion, or the interplay between § 316(d) and § 316(e)—are not issues that implicate the PTO's expertise," this Court did not need to defer to the PTO's interpretation. *Id.* "After all, it is the prerogative of the judiciary 'to say what the law is.'" *Id.* (quoting *Marbury v. Madison*, 5 U.S. (1 Cranch) 137 (1803)); see also *Biogen MA, Inc. v. Japanese Found.*, 785 F.3d 648, 657 (Fed. Cir. 2015) ("the PTO's regulations interpreting the scope of the district court's subject matter jurisdiction would not be entitled to *Chevron* deference").

As in *Aqua Products*, the interplay between the Federal Rules of Civil Procedure and §315(b) in this case is not "one that implicate[s] the PTO's expertise." This is a pure legal issue and not one in the PTO's domain of expertise. While some

of the Federal Rules of Civil Procedure apply to PTO proceedings, Rule 41, upon which the Board relies, is not one of them. *See* 35 U.S.C. §24; *cf. Covidien LP v. University of Florida Res. Found. Inc.*, 2017 Pat. App. LEXIS 11531, *34 (P.T.A.B. Jan. 25, 2017). This Court is in a better relative position than the PTO to decide the present issue. Indeed, the Board relied solely on two of this Court’s decisions to tease out its tolling rule. Surely this Court is in a better position to opine on the relevance of those decisions on this case, if any, than the Board. As a result, no deference is due.

D. Recent Decisions Circumscribe “Existing Law” in the Analysis

The only reason the Board ignored the text of §315(b) and considered the dismissal without prejudice as dispositive of the statutory time bar was its invocation of the interpretative canon that Congress is presumed to legislate against a backdrop of “existing law.” The Board not only mischaracterizes the rule of law, but it misapplies this canon of construction in this case. Recent cases demonstrate that the Board erred by using this canon to thwart the plain meaning of the statute.

As a starting point, to the extent that the effect of a dismissal without prejudice is embodied in a rule of law, it is properly characterized as a “no tolling” rule:

“The rule is therefore as we stated it: when a suit is dismissed without prejudice, the statute of limitations is deemed unaffected by the filing of the suit, so that if the statute of limitations has run the dismissal is effectively with prejudice.”

Elmore v. Henderson, 227 F.3d 1009, 1011 (7th Cir. 2000); *see also Williams v. Williams*, 2017 U.S. Dist. LEXIS 111379, *10 (E.D. Tex. 2017) (“As a result, the statute of limitations is not tolled when a plaintiff voluntarily dismisses under Fed. R. Civ. P. 41(a). (citing *Basco v. Am. Gen. Ins. Co.*, 43 F.3d 964, 965-66 (5th Cir. 1994)).

The correct reading of this “rule” is further supported by the explicit tolling provision found in 28 U.S.C. §1367, recently addressed by the Supreme Court in *Artis v. District of Columbia*, 583 U. S. ___, 2018 U.S. Lexis 762 (Jan. 22, 2018). As the Supreme Court explained, this statute reveals Congressional understanding that, absent such a tolling statute, the statute of limitations on the state law claims would run when a federal court dismissed state law claims on procedural grounds, i.e., without prejudice. *Id.* at *6-*8. This further reinforces Click-to-Call’s argument that the dismissal without prejudice rule is a “no tolling” rule and that a proper application of the interpretative canon is that service triggers the running of the 315(b) time-bar irrespective of the action later being dismissed without prejudice.

Both *Graves v. Principi*, 294 F.3d 1350 (Fed. Cir. 2002) and *Bonneville Associates, LP v. Barram*, 165 F.3d 1360 (Fed. Cir. 1999), relied on by the Board for its “never happened” rule, are properly seen as examples of the “no tolling” rule quoted above. In both *Graves* and *Bonneville*, the dismissal without prejudice of an earlier case did not toll the relevant limitations period, thereby barring the later

action. The problem with the Board’s reading of these two cases is that it effectively inverts the “no tolling rule” into a tolling rule. By deeming that the service “never happened,” the Board turning the “no tolling” rule of *Graves* and *Bonneville* on its head and effectively tolled the running of the §315(b) time-bar.

Even assuming *arguendo* the Board’s overly broad reading of the “existing law” was correct, this Court has made clear that the canon of construction that Congress is presumed to legislate against this backdrop should not be used to “impose additional conditions not present in the statute’s text.” *Return Mail, Inc. v. United States Postal Serv.*, 868 F.3d 1350, 1363 (Fed. Cir. 2017). In *Return Mail*, for example, the Court addressed the issue of whether “sued for infringement” in §18(a)(1)(B) of the AIA encompassed a suit against the government under 28 U.S.C. §1498(a), thereby giving the Post Office standing to file a CBM. The patent owner argued that “sued for infringement” only included actions under §271, and not those under §1498. 868 F.3d at 1362. The Court rejected that reading of the statute because it read additional words into the statute. “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 §1498 suits from the definition of ‘sued for infringement,’ but it did not do so.” *Id.* at 1363. The same could be said in this case. Congress could have explicitly limited §315(b) by adding “[‘unless dismissed

without prejudice’], but it did not do so.” *Id.* The Board should not be permitted to graft this additional limit into §315(b) by administrative fiat.

The *Graves* and *Bonneville* cases relied upon by the Board to allegedly inform Congress’ intent are also too attenuated from the AIA to serve as the proper legal backdrop. Usually this canon of construction relies on prior interpretations of the same statute or regulatory scheme to inform Congress’ intent. *See Gazelle v. Shulkin*, 868 F.3d 1006, 1011 (Fed. Cir. 2017) (“Thus, determining Congress’ intended methodology for calculating these disabilities requires us to examine the existing statutes and regulations.”); *see also Return Mail, supra* (looking at other sections of the Patent Statute for guidance). Congress should not be expected to draft the AIA based on its understanding of CVA and BCA decisions. This is simply a bridge too far.

E. This Court Should Rule Without Deference to the PTO.

For the foregoing reasons, this Court should interpret the §315(b) time-bar in this case without deference to the PTO’s views. *See Return Mail*, 868 F.3d at 1360 (“Accordingly, where, as here, the parties’ arguments raise a purely legal question of statutory interpretation, we apply *de novo* review.”). The text of the statute is clear—service triggers the bar. There is no gap to fill or ambiguity to resolve. Even if there were, the PTO has not promulgated a rule on point. The only rule even implicated by this case states that the Board lacks “[j]urisdiction” over it, as

confirmed by the public notice and comments. The Board’s “precedential” decision is not controlling or even persuasive because it mischaracterizes the rule of law, not based on any regulation issued by the Director, interprets existing law not implicating PTO expertise, and imposes “additional conditions not present in the statute.” Consequently, this Court need not and should not afford the Board any deference on the proper interpretation of § 315(b) in this case.

III. RECENT DECISIONS CONFIRM THAT § 315(B) IS NOT TOLLED BY A DISMISSAL WITHOUT PREJUDICE

The Board in this case engaged in a legal fiction. *See State Bank of India v. Chalasani (In re Chalasani)*, 92 F.3d 1300, 1303 (2d Cir. 1996) (“A legal fiction assumes as fact, for purposes of justice, that which does not exist. *Black’s Law Dictionary* 751 (rev. 4th ed. 1968).”). It assumed that service “never occurred”—even though it did in fact occur—because the underlying infringement case was resolved between the parties and dismissed without prejudice. As with all legal fictions, this one has its limits, as demonstrated by several recent cases. *See id.* (condemning long-standing legal fiction because it “effectively nullified one of the principal purposes” of the statutory scheme); *see also Martin Marietta Corp. v. Gould, Inc.*, 70 F.3d 768, 771 (4th Cir. 1995).

Contrary to the Board’s assumption in this case, the act of service may have on-going legal consequences irrespective of whether the case is dismissed without prejudice. For example, recent cases have held that service of a complaint starts the

clock running on notice for indirect infringement. *See Rhodes Pharm. L.P. v. Indivior, Inc.*, 2018 U.S. Dist. LEXIS 2622, *17, 2018 WL 326405 (“The issue of intent has repeatedly arisen in the context where the allegedly infringing defendant had no knowledge of the patent prior to the initiation of litigation, but was afforded notice of the patent-at-issue through service of the complaint.”); *Intellicheck Mobilisa, Inc. v. Honeywell Int’l, Inc.*, 2017 U.S. Dist. LEXIS 193618, *36, 2017 WL 5634131 (W.D. Wa.) (“The knowledge gleaned from notice of suit or service of the complaint satisfies the knowledge requirements of *Global-Tech.*”); *Memory Integrity, LLC v. Intel Corp.*, 2015 U.S. Dist. LEXIS 90417, *4 (D. Or.) (“Service of the complaint provides the defendant with notice of the patent’s existence, and knowledge of the patent as of the date of service is sufficient.”); *Simplivity Corp. v. Springpath, Inc.*, 2016 U.S. Dist. LEXIS 155017, *22, 2016 WL 5388951 (D. Ma.) (“the court sees no reason why service of the complaint could not support liability for allegedly infringing activity post-dating the service of the Complaint in September 2015.”). Likewise, following the Supreme Court’s decision in *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, some courts have found service sufficient to trigger willful infringement liability. *See, e.g., DermaFocus LLC v. Ulthera, Inc.*, 201 F. Supp. 3d 465, 473, 2016 U.S. Dist. LEXIS 106484, *17 (D. Del.).

While none of these cases involved an earlier dismissal with prejudice, that is of no moment given the courts’ underlying rationale. Under the courts’ reasoning

in those cases, service put the defendant on notice and started the legal damages period running. *See, e.g., Intellicheck Mobilisa, supra.* Whether the plaintiff subsequently dismissed the complaint voluntarily on procedural grounds, *e.g.*, improper venue or personal jurisdiction, would not eliminate the defendant's knowledge of and potential liability for its post-service infringement. Accordingly, it is simply untrue that a dismissal without prejudice eliminates all potential legal consequences of service, as the Board held in this case.

IV. THE COURT SHOULD REVERSE AND RENDER

As mentioned above, Click-to-Call suggested in its opening briefs that the *Chenery* doctrine counseled in favor of vacating and remanding for the Board to consider Petitioner's alternative grounds in the first instance. Reply Br. at 24-27 (citing *SEC v. Chenery*, 318 U.S. 80 (1943)). That was three years ago. During that time, numerous cases out of this Court and the Board have brought further clarity to the issues. Whatever prudential advantages could be gained by allowing the Board to weigh in on Appellees' alternative arguments are now outweighed by the prejudice to Click-to-Call by further delay. As such, Click-to-Call respectfully asks this Court to dispatch Appellees' alternative grounds and enter judgment in Appellant's favor, as originally requested. *See* Appellant's Docketing Statement, Doc. 15 ("Relief sought on appeal: Reversal"). Fortunately, the Court may do so based on the plain language of the statute and the undisputed facts in this case.

A. Reexamination Does Not Reset The § 315(b) Time Bar.

In the original briefing on the merits, Click-to-Call explained why the plain language of the statute precludes Petitioner's argument that reexamination tolls the §315(b) time bar. Reply Br. at 22-24. The fundamental problem with Petitioner's argument is that "[u]nlike 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)). The Board agrees with Click-to-Call. See *BioDelivery Sciences Int'l, Inc. v. MonoSol Rx, LLC*, IPR2013-00315, Paper 31 at 3 (P.T.A.B. Nov. 13, 2013). That is still the law. Cf. *Target Training International, Ltd. v. Extended Disc North America, Inc.*, 645 Fed. Appx. 1018, 1025, 2016 U.S. App. LEXIS 7292 (Fed. Cir. 1996) (unpub.) (district court did not err in dismissing a case as moot following a reexamination). While Congress could have distinguished between original claims and newly added claims in §315(b) in the AIA, as it did in §252, it did not do so. Instead, §315(b) is analyzed on a patent-by-patent basis.

B. Oracle and Yellowpages.com are Also Barred by § 315(b).

Oracle and Yellowpages.com argue in the alternative that even if YP Interactive is barred by §315(b), that the bar should not apply to them because they are separate, multiple petitioners and could have filed separate petitions. (Response

Br. at 24, 26). Even if the Court indulges Appellees multiple “petitioners” fiction, they all fall together at the Board.

The Board has made clear that if the petition fails §315(b) as to one party it fails as to all. *See Terremark N.A. LLC, et al. v. Joao Control & Monitoring, LLC*, 2015 Pat. App. LEXIS 12695, *18-19 (P.T.A.B. Dec. 28, 2015). The Board’s decision in *PNC Bank, N.A. et al. v. Maxim Integrated Products, Inc.*, CBM2014-00041 (P.T.A.B. June 3, 2014) (Paper 19), relied on by the Board in *Terremark*, is instructive. *PNC* involved the statutory bar against a covered business method review (“CBM”) under 35 U.S.C. §325(a)(1). In that case, “[i]n an attempt to eliminate the statutory bar against PNC, PNC moved for entry of an adverse judgment against it in the CBM proceeding and contended that the other petitioners could proceed with the petition without further involvement from PNC.” *Terremark*, 2015 Pat. App. LEXIS 12695, *20-21. The Board rejected this maneuver and denied institution because “granting PNC’s request for adverse judgment would not obviate the control that PNC already had exerted” by filing the petition. *Id.* at *21 (citing *PNC*, slip op. at 4). The same is true in this case: the four filing parties filed a single petition, labeled themselves as “Petitioner,” and referred to themselves throughout as a singular “Petitioner.” Appellee’s could have filed separate petitions and then later been joined but they chose not to do so. *See* 35 U.S.C. 315(c). By filing their petition for IPR as one Petitioner, they must be treated as such.

Oracle and Yellowpages.com further argue in the alternative that even if YP Interactive is barred by §315(b), the bar should not apply to them because they were not in privity with Keen when the complaint was served. Response Br. at 22 (“Section 315(b) applies to privities only when privity exists within one year of the service of the relevant complaint”). This argument ignores §315(b)’s prohibition against an IPR being instituted based on a petition where any “real party in interest...[, was] served with a complaint alleging infringement of the patent” more than a year before filing their petition. 35 U.S.C. §315(b). If “the petition” is filed by and/or naming a time-barred RPI, the *inter partes* review must be denied. See *RPX Corp. v. VirnetX Inc.*, Case IPR2014-00171, slip op. at 6 (PTAB July 14, 2014) (Paper 57). In *RPX Corp. v. VirnetX Inc.*, for example, Apple who was time-barred under §315(b) engaged RPX to file an IPR petition on its behalf “[l]ess than one month” before the petition was filed. *Id.* The Board denied institution because Apple—as the RPI—was time barred under §315(b) even though the relationship with RPX occurred within the one-year grace period. The statute cannot be read any other way. See *ON Semiconductor Corp., et al. v. Power Integrations, Inc.*, 2017 Pat. App. LEXIS 11678, *19 (P.T.A.B. Sept. 22, 2017) (“the determination of the time bar is based on the relationship of the parties to an action up to the date of filing of a petition”). Otherwise, an admittedly time-barred party could participate in the

preparation and filing of the petition and still avoid §315(b) by not being named a petitioner to their time-barred petition.

In this case, “the petition” identifies four RPIs:

A. Mandatory Notices Under 37 C.F.R. §§ 42.8(b)(1)-(4)

1. Real Party-In-Interest

Oracle Corporation (“Oracle”), Oracle OTC Subsidiary LLC;

Yellowpages.Com LLC and **Ingenio, LLC** are the real parties-in-interest.

(A345 (emphasis added).) It is undisputed that Ingenio was served with a complaint for infringing the ’836 Patent more than one year before the petition in this case was filed. (A090-145, A301-302; A287-88.) Ingenio is time barred by §315(b). Because Ingenio is an admitted real party in interest, the petition for IPR by Oracle and Yellowpages.com is also barred by §315(b).

C. There was foul and there was harm.

Finally, Appellees argument that this Court should allow this case to proceed under a “harmless error” theory because a non-barred party could have filed a separate petition and the barred party could have joined under §315(c) reveals the weakness in their argument. Appellees Br. at 25. Although Appellees chose not to do so here, it is always possible for a non-barred party to file a petition for *inter partes* review to which a barred party could join; that is what the statute says. *See id.* That does not take away from the fact that Congress included §315(b) to

“prevent[] the serial harassment of patent holders” by the same entity, Meeting of H. Comm. on the Judiciary, Transcript of Markup of H.R. 1249, p. 72 (April 14, 2011) (statement of Judiciary Comm. Chair. Lamar Smith); *see also LG Elecs., Inc. v. Modis Tech. Ltd.*, 2015 Pat. App. LEXIS 10261, *10 (P.T.A.B. Sept. 17, 2015) (“The purpose of § 315(b) is to ensure that *inter partes* review is not used as a tool for harassment by repeated litigation and administrative attacks.” (internal quotation omitted)). This subsection acts as a fundamental limit on the Director’s authority to act, *Wi-Fi One*, 2018 U.S. App. LEXIS 387, *20, (O’Malley, J concurring), and derogations cannot be disregarded as “harmless”.

V. CONCLUSION

For the foregoing reasons, Click-to-Call respectfully requests that this Court reverse the Board’s Final Written Decision because the underlying petition was time barred by 35 U.S.C. §315 and the Board did not have jurisdiction or authority to conduct the proceeding, and render judgment in Click-to-Call’s favor.

Dated: February 5, 2018.

Respectfully submitted,

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CERTIFICATE OF FILING AND SERVICE

I certify that on February 5, 2018, I caused this Supplemental Brief of Appellant to be filed electronically with the Clerk of this Court using the CM/ECF filing system, which constitutes service upon all counsel of record pursuant to Fed. R. App. 25(c) and Fed. Cir. R. 25(e)(1). In addition, I certify that six paper copies of this brief shall be filed with the court and two paper copies served upon each counsel for all other parties, as required by the Court's Order granting Appellant's Petition for Panel Rehearing, Doc. 99 (Jan. 19, 2018).

By: /s/ Peter J. Ayers
Counsel for Appellant

CERTIFICATE OF COMPLIANCE

1. This brief complies with the 7,000 word type-volume limitation set forth in the Order granting Appellant's Petition for Panel Rehearing, Doc. 99 (Jan. 19, 2018) because this brief contains 4,835 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in 14pt Times New Roman.

Dated: February 5, 2018

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