

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TERREMARK NORTH AMERICA LLC, VERIZON BUSINESS
NETWORK SERVICES INC., VERIZON SERVICES CORP., TIME
WARNER CABLE INC., ICONROL NETWORKS, INC., and
COXCOM, LLC
Petitioner,

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC,
Patent Owner.

Case IPR2015-01484
Patent 7,277,010 B2

Before HOWARD B. BLANKENSHIP, STACEY G. WHITE, and
JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, Terremark North America LLC, Verizon Business Network Services Inc., Verizon Services Corp., Time Warner Cable Inc., Icontrol Networks, Inc., and Coxcom, LLC, filed a Petition¹ requesting an *inter partes* review of claims 139, 157, 158, 169–171, 193, 194, 196–198, 201, 202, 211, 213, 215, 217, 219, 222–225, 227, 228, and 234–236 of U.S. Patent No. 7,277,010 B2 (Ex. 1001, “the ’010 patent”). Paper 2 (“Pet.”). Patent Owner, Joao Control & Monitoring Systems, LLC, filed a Preliminary Response. Paper 12 (“Prelim. Resp.”). In addition, on August 5, 2015, Petitioner filed a Motion to Recognize June 23, 2015 as the filing date. Paper 8 (“Motion”). On August 19, 2015, in response to Petitioner’s Motion, Patent Owner filed Patent Owner’s Opposition to Motions to Recognize June 23 as the filing date. Paper 11 (“Opposition”). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . 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 determine that the Petition was not filed timely within the statutory period of 35 U.S.C. § 315(b). We, thus, deny *inter partes* review of the ’010 patent.

¹ Petitioner was assigned two case numbers when filing for *inter partes* review: (1) IPR2015-01480; and (2) IPR2015-01484. Paper 8, 2–6. Because Petitioner is moving to recognize June 23, 2015 as the filing date in IPR2015-01484, rather than IPR2015-01480, we refer to IPR2015-01484 as the “Petition.”

Related Matters

Petitioner indicates that the '010 patent has been asserted in the following proceedings: (1) *Joao v. LifeShield, Inc.*, No. 2-15-cv-02772 (E.D. Pa.); (2) *Joao v. Slomin's Inc.*, No. 2-14-cv-02598 (E.D.N.Y.); (3) *Joao v. Time Warner Cable, Inc.*, No. 1-14-cv-00524 (D. Del.); (4) *Joao v. Cox Communications, Inc.*, No. 1-14-cv-00520 (D. Del.); (5) *Joao v. Verizon Communications, Inc.*, No. 1-14-cv-00525 (D. Del.); (6) *Alarm.com Inc. v. Joao*, No. 1-14-cv-00284 (D. Del.); (7) *Joao v. Protect America, Inc.*, No. 1-14-cv-00134 (W.D. Tex.); (8) *Joao v. FrontPoint Security Solutions LLC*, No. 1-13-cv-01760 (D. Del.); (9) *Joao v. Lowe's Cos., Inc.*, No. 5-13-cv-00056 (W.D.N.C.); (10) *Joao v. Vivint Inc.*, No. 1-13-cv-00508 (D. Del.); (11) *Joao v. American Traffic Solutions, Inc.*, 1-13-cv-00243 (E.D. Mich.); (12) *Joao v. City of Yonkers*, No. 1-12-cv-07734 (S.D.N.Y.); (13) *Joao v. Digital Playground, Inc.*, No. 1-12-cv-06781 (S.D.N.Y.); (14) *Joao v. Liquid Cash, LLC*, No. 1-12-cv-06315 (S.D.N.Y.); (15) *Joao v. Xanboo, Inc.*, No. 2-12-cv-03698 (C.D. Cal.); (16) *Joao v. Smartvue Corp.*, No. 1-12-cv-03641 (C.D. Cal.); (17) *Joao v. Digital Playground Inc.*, No. 2-12-cv-00417 (C.D. Cal.); (18) *Joao v. Ahava Inc.*, No. 2-11-cv-09638 (C.D. Cal.); (19) *Joao v. GSMC Inc.*, No. 2-11-cv-09636 (C.D. Cal.); (20) *Joao v. GSMC Inc.*, 2-11-cv-08697 (C.D. Cal.); (21) *Joao v. Webcamnow.com Inc.*, No. 2-11-cv-08257 (C.D. Cal.); and (22) *Joao of Texas v. Playboy Enterprises, Inc.*, No. 6-09-cv-00499 (E.D. Tex.). Pet. 3–4; Paper 6.

According to Patent Owner, the '010 patent also is the subject of four *ex parte* reexaminations, Reexamination Control Nos.: (1) 90/013,303; (2) 90/013,301; (3) 90/013,302; and (4) 90/013,300. Paper 6, 5–6.

Petitioner concurrently filed petitions requesting an *inter partes* review of the following U.S. Patent Nos.: (1) 6,549,130 (Case IPR2015-01509); (2) 6,542,077 B2 (Case IPR2015-01466); (3) 6,587,046 (Case IPR2015-01477); (4) 6,549,130 (Case IPR2015-01486); (5) 6,542,076 (Case IPR2015-01478); (6) 6,542,076 (Case IPR2015-01508); (7) 7,397,363 (Case IPR2015-01482); and (8) 7,397,363 (Case IPR2015-01485). *Id.* at 4–5.

II. ANALYSIS

Because at least one of the petitioning parties was served with a complaint on June 23, 2014 (Exs. 2002–2005), the statutory bar date for IPR2015-01484 is June 23, 2015. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). Petitioner, however, was accorded a filing date of June 24, 2015. Paper 3. Petitioner filed, served, and paid the fee for IPR2015-01484 on June 24, 2015, which is one day after the statutory bar date. Motion 2–6 (citing Ex. 1008 ¶¶ 1–13; Ex. 1009 ¶¶ 1–12).

Petitioner contends that it is not barred or estopped from requesting an *inter partes* review of the '010 patent, thus, satisfying the requirements of § 315(b) for the following three reasons: (1) Petitioner uploaded timely a petition that was assigned case number IPR2015-01480, served timely the IPR2015-01480 petition and supporting documents; (2) the Board has the authority, as demonstrated in past decisions, to recognize the filing date for this *inter partes* review as June 23, 2015; and (3) there is no injustice to Patent Owner because immediate remedial measures were taken right away by Petitioner. Motion 2–11 (citing Ex. 1008 ¶¶ 1–13; Ex. 1009 ¶¶ 1–12).

We disagree that Petitioner is not barred or estopped from requesting an *inter partes* review. We address Petitioner's arguments in turn.

A. *Petitioner's Arguments Pertaining to Timely Filing IPR2015-01480 are Misplaced*

Petitions for *inter partes* review must be filed within one year after Petitioner was served with a complaint alleging infringement. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). Moreover, a petition is only accorded a filing date once: (1) a petition has been filed; (2) payment has been made; and (3) the complete petition is served on the patent owner. 35 U.S.C. § 312(a); 37 C.F.R. § 42.106(a). The Board has discretion to waive non-statutory requirements per 37 C.F.R. § 42.5(b). In addition, our rules permit a party to file a motion to correct a "clerical or typographical mistake." 37 C.F.R. § 42.104(c). The burden of proof rests with the moving party, which is, in this case, Petitioner. 37 C.F.R. § 42.20(c); Motion 2.

It is undisputed that at least two of the petitioning parties were served with a complaint alleging infringement of the '010 patent on June 23, 2014. Ex. 2001 ¶¶ 1–4; Exs. 2002–2005. On June 23, 2015, Petitioner failed to comply with the statutory requirements of 35 U.S.C. § 312(a) by not paying the required fee and failing to meet the requirements of 37 C.F.R. § 42.106(a) by not filing and serving the Petition and its supporting evidence. Motion 2–6 (citing Ex. 1008 ¶¶ 1–13; Ex. 1009 ¶¶ 1–12). On June 24, 2015, one day after the one year statutory deadline, Petitioner completed filing of the Petitions at issue. *Id.* at 5–6 (citing Ex. 1008 ¶¶ 1–13; Ex. 1009 ¶¶ 1–12).

Petitioner was assigned two case numbers when filing for *inter partes* review: (1) IPR2015-01480; and (2) IPR2015-01484. Motion 2–6.

Petitioner, first, uploaded a petition and supporting documents, and was assigned IPR2015-01480 by PRPS on June 23, 2015; Petitioner also served the petition and supporting documents for IPR2015-01480 on June 23, 2015. *Id.* at 2–3. Petitioner, however, was unable to pay the filing fee on June 23, 2015, for IPR2015-01480 because it included a hyphen in the deposit account number. *Id.* at 4–6. Petitioner, instead, had its backup counsel, Venable LLP, refile the Petition and supporting documents on June 24, 2015, which is one day after the statutory deadline, and was assigned IPR2015-01484 by PRPS; Petitioner’s backup counsel also paid the filing fee for IPR2015-01484 and served the IPR2015-01484 Petition and supporting documents on June 24, 2015. *Id.* at 5–6 (citing Ex. 1008 ¶¶ 10–11).

The burden of proof, as stated *supra*, rests with Petitioner. Petitioner alleges that the filings were timely because they were assigned the case number IPR2015-01480 by the Patent Review Processing System (“PRPS”). *Id.* at 2–3. Petitioner, however, did not move to recognize June 23, 2015 as the filing date of IPR2015-01480. Rather, Petitioner moved to recognize June 23, 2015 as the filing date of IPR2015-01484. *Id.* at 2–11. Petitioner’s arguments pertaining to timely filing the IPR2015-01480 petition and supporting documents, thus, are misplaced. We, therefore, decline to address whether Petitioner filed timely IPR2015-01480.

Petitioner also argues that it served timely, the petition and supporting documents in IPR2015-01480 on June 23, 2015. Motion 4–5. Petitioner

alleges the petition served in IPR2015-01480 had no substantive changes from the filed IPR2015-01484 Petition. Ex. 1008 ¶¶ 4–5, 12; Ex. 1009 ¶ 6. Moreover, Petitioner alleges the only differences noted between the petition served in IPR2015-01480 and the IPR2015-01484 Petition are a change in deposit account information in the Petition, a different cover sheet for the powers of attorneys, a different signature block in the Petition, different labels on the exhibits, and a different certificate of service. Ex. 1008 ¶ 12. Patent Owner, however, notes that Petitioner fails to acknowledge the myriad substantive changes between the petition served in IPR2015-01480 and the IPR2015-01484 Petition (the Board counts at least sixteen additional changes apart from the changes noted by Petitioner). Opposition 7–11. At this juncture, we decline to decide whether the documents served on June 23, 2015, are substantively different than the documents filed on June 24, 2015. Nevertheless, we remind Petitioner’s counsel of its responsibilities of candor and good faith under the United States Patent and Trademark Office Trial Practice Rules as set forth in 37 C.F.R. § 42.11.

Petitioner, furthermore, did not move to recognize June 23, 2015 as the service date of IPR2015-01480. Rather, Petitioner moved to recognize June 23, 2015 as the service date of IPR2015-01484. *Id.* at 2–11. Petitioner’s arguments pertaining to timely serving the IPR2015-01480 petition and supporting documents, thus, are misplaced. We, therefore, decline to address whether Petitioner served timely the petition and supporting documents in IPR2015-01480.

As stated *supra*, it is undisputed that on June 24, 2015, one day after the one year statutory deadline, Petitioner filed the Petition and supporting

documents, paid the filing fees, and served the Petition and supporting documents. Petitioner, thus, has not shown persuasively how filing and service in IPR2015-01480, in which Petitioner did not move to recognize June 23, 2015 as the filing date, justifies the relief requested.

B. The Board's Prior Decisions are Distinguishable

Petitioner cites a number of non-precedential Board decisions to support its arguments. These cases, however, are distinguishable because none of them addressed the combination of a failure to file, serve, and pay the required fee as set out in our Rules and governing statute.

In *ABB Inc. v. Roy-G-Biv Corp.*, Case IPR2013-00063 (PTAB Jan. 16, 2013) (Paper 21), the Board addressed a Motion to Correct Petition. The petitioner in *ABB* served timely the petition, and paid timely the filing fee. The petitioner in *ABB* failed to timely file the correct exhibits. The Board, however, granted the motion based on a finding that although the petitioner filed the wrong exhibits, the petitioner served timely the correct exhibits on the patent owner. *ABB*, slip op. at 2, 5–11.

As for *Apple Inc. v. Whitserve, LLC*, Case IPR2014-00268 (PTAB Feb. 5, 2014) (Paper 16), the Board addressed a Motion to Correct Filing Date of Petition. The petitioner in *Apple* served timely the petition, paid timely the filing fee, uploaded timely the petition and supporting documents, and emailed timely the petition. The petitioner in *Apple*, however, was accorded a filing date one day after the statutory deadline. The Board, however, granted the motion based on a finding that PRPS indicated that

petitioner had filed timely the petition and exhibits, served timely the petition and exhibits, and paid timely the filing fee. *Apple*, slip op. at 2–8.

Regarding *Pacific Market Int’l, LLC v. Ignite USA, LLC*, Case IPR2014-00561 (PTAB May 12, 2015) (Paper 40), the Board addressed a Motion to Deem the Filing of Petitioner’s Reply as Timely. The petitioner in *Pacific* served timely the petition, paid timely the filing fee, and filed timely the petition and supporting documents. The petitioner in *Pacific*, however, filed untimely the petitioner’s reply. The Board, however, granted the motion based on a finding that the patent owner would not oppose the motion. *Pacific*, slip op. at 2–5.

In *Standard Innovation Corp. v. Lelo, Inc.*, Case IPR2014-00148 (PTAB Sept. 15, 2014) (Paper 19), the Board addressed a Motion to Deem the Filing of the Patent Owner Response as Timely. The patent owner in *Standard* filed untimely the patent owner response. The Board, however, granted the motion based on a finding that the filing deadline of the patent owner response was not a statutory deadline; rather, it is an intermediate deadline that may be altered by agreement. *Standard*, slip op. at 2–3.

As for *ConMed Corp. v. Bonutti Skeletal Innovations LLC*, Case IPR2013-00624 (PTAB Mar. 14, 2014) (Paper 22), the Board addressed a Motion to Correct Filing Date. The petitioner in *ConMed* paid timely the filing fee, and served timely the petition on the patent owner. The petitioner in *ConMed* filed the petition and supporting documents, but because the petitioner failed to click “Submit” when filing those documents, the proceeding was accorded a filing date after the statutory bar. The petitioner in *ConMed* did not hit the submit button until several days after the statutory

bar date when it refiled exhibits with the corrected labels. The Board, however, granted the motion primarily because all three filing requirements were met; in particular, the documents were uploaded and filed timely but for an omission to click a “Submit” button, fees were paid timely, and the documents were served timely. *ConMed*, slip op. at 2–6.

Regarding *2Wire, Inc. v. TQ Delta, LLC*, Case IPR2015-00239 (PTAB Jan. 15, 2015) (Paper 10), the Board addressed a Motion to Correct Filing Date. In *2Wire*, counsel pressed the “submit” button after midnight. The Board, however, granted the motion because all three filing requirements were met; in particular, the documents were uploaded timely, fees were paid timely, and the documents were served timely. *2Wire*, slip op. at 4–8.

In *Oracle Corp. v. Maz Encryption Techs. LLC*, Case IPR2014-00472 (PTAB May 1, 2014) (Paper 9), the Board addressed a Motion to Recognize March 1, 2014 as Filing Date. The petitioner in *Oracle* paid timely the filing fee, and served timely the petition on the patent owner. The petitioner in *Oracle* was unable to timely file the petition because PRPS was malfunctioning. The Board, however, granted the motion because its “internal investigation confirm[ed] that PRPS access . . . was indeed compromised.” *Oracle*, slip op. at 2.

As for *E*Trade Financial Corp. v. Droplets, Inc.*, Case IPR2015-00470 (PTAB Apr. 20, 2015) (Paper 17), the Board addressed a Motion to Change the Filing Date. In *E*Trade*, the petitioner received a notice from PRPS that the system was “currently down” when the petitioner attempted to file the petition. Moreover, in *E*Trade*, a Board employee, acting with the

authority of the Board, instructed the petitioner to email its petition and supporting documents as an attachment. The petitioner in *E*Trade* paid timely the filing fee, and served timely the petition on the patent owner. The petitioner in *E*Trade* refiled the petition and supporting documents when PRPS functioned properly. The Board granted the motion because all three filing requirements were met; in particular, the documents were emailed timely, fees were paid timely, and the documents were served timely. *E*Trade*, slip op. at 3–4.

Regarding *Micron Tech., Inc. v. e.Digital Corp.*, Case IPR2015-00519 (PTAB Mar. 24, 2015) (Paper 14), the Board addressed a Motion to Deny a Petition a Filing Date based on Improper Service. The petitioner in *Micron* filed timely the petition, and paid timely the filing fee. In addition, in *Micron*, the petitioner served a copy of the petition and supporting documents on the patent owner’s litigation counsel via email more than two weeks prior to expiration of the statutory bar date, and email correspondence between the parties indicated that the patent owner’s litigation counsel was in receipt of the documents prior to the statutory bar date. The petitioner in *Micron* failed to timely serve the patent owner at the correspondence address of record. The Board, however, denied the patent owner’s motion because the patent owner, through its litigation counsel, actually received the petition prior to the one year statutory bar date. *Micron*, slip op. at 4–6.

In *Schott Gemtron Corp. v. SSW Holding Co. Inc.*, Case IPR2014-00367 (PTAB Sept. 22, 2014) (Paper 30), the Board addressed a Motion to Correct Filing Date. The petitioner in *Schott* served timely the petition, and paid timely the filing fee. In *Schott*, the petitioner filed timely an incorrect

exhibit. The Board, however, granted the motion because the petitioner served timely the petition and supporting documents, which the patent owner acknowledged during a conference call. *Schott*, slip op. at 2–4.

As for *Syntroleum Corp. v. Neste Oil OYJ*, Case IPR2013-00178 (PTAB July 22, 2013) (Paper 21), the Board addressed a Motion to Correct Petition. The petitioner in *Syntroleum* paid timely the filing fee. In *Syntroleum*, the petitioner filed timely and served timely the petition, but filed an incorrect reference and served the same incorrect reference. The petitioner in *Syntroleum* intended to file a published European application, but instead, the petitioner filed inadvertently and served inadvertently a patent that issued from the publication. The Board, however, granted the motion because both the petitioner’s original petition and declaration cited the published European application. *Syntroleum*, slip op. at 2–6.

Thus, as described above, all of these cases are distinguishable from the facts currently before us. Petitioner has not directed us to any case where the petitioning party failed to file, serve, and pay the required fee by the statutory bar date.

C. Petitioner’s Arguments Pertaining to Injustice to Patent Owner is Misplaced

Petitioner contends there is no injustice to Patent Owner because immediate remedial measures were taken right away by Petitioner. Motion 9. Petitioner’s argument, however, is misplaced because the standard for permitting a late filing is not dependent solely on whether there was injustice to Patent Owner.

We, therefore, decline to grant the relief requested.

III. CONCLUSION

For the foregoing reasons, the Petition falls outside the one-year time bar set forth in 35 U.S.C. § 315(b). We, thus, deny *inter partes* review of the '010 patent.

IV. ORDER

For the foregoing reasons, it is
ORDERED that the Petition is *denied* as to all challenged claims and no trial is instituted.

IPR2015-01484
Patent 7,277,010 B2

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