

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY
Petitioner,

v.

VERSATA DEVELOPMENT GROUP, INC.
Patent Owner.

Case IPR2017-00144; Patent 7,200,582 B1
Case IPR2017-00146; Patent 5,825,651
Case IPR2017-00147; Patent 7,464,064 B1
Case IPR2017-00148; Patent 6,405,308 B1
Case IPR2017-00149; Patent 6,675,294 B1
Case IPR2017-00150; Patent 7,882,057 B1
Case IPR2017-00151; Patent 7,882,057 B1¹

Before KEVIN F. TURNER, JAMES B. ARPIN, and
WILLIAM M. FINK, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

¹ This Decision applies to each of the captioned cases. Because the same arguments and dispositive issues are present in each case, we exercise our discretion to issue one Decision to be entered in each case. The parties are not authorized to use such a multiple case caption.

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A. INTRODUCTION

Ford Motor Company (“Petitioner”) filed Requests for Rehearing (*e.g.*, IPR2017-00146, Paper 8, “Req.”)² of our decisions (*e.g.*, IPR2017-00146, Paper 7, “Dec.”) in each of the captioned cases, which denied institution of *inter partes* review of the challenged claims of each of the patents at issue (*e.g.*, U.S. Patent No. 5,825,651 (IPR2017-00146, Ex. 1101, “the ’651 patent”)). Petitioner argues that (1) we misapplied the binding precedent of the U.S. Court of Appeals for the Federal Circuit (“the Federal Circuit”) and the Patent Trial and Appeal Board (“the PTAB”) by refusing to hold that the dismissal “without prejudice” of the *Versata* action has no legal effect under 35 U.S.C. § 315(b) and must be treated as if the action had never been filed, and (2) we misapplied the law in holding that there is a “continuous chain of assertion” exception to the precedential rule that a complaint dismissed “without prejudice” has no legal effect under 35 U.S.C. § 315(b). Req. 1.

We have considered Petitioner’s Requests for Rehearing, and, for the reasons set forth below, Petitioner’s Requests are *denied*.

² Because each of the Requests for Rehearing presents substantially identical arguments, we refer herein to the arguments and evidence cited in the Request for Rehearing in IPR2017-00146 and to the papers and exhibits filed in that case. However, these citations correspond to substantially similar portions of corresponding papers and exhibits filed in the other captioned cases.

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B. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify, with specificity, all matters that the moving party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

C. DISCUSSION

1. Failure to Follow Binding Precedent

Petitioner argues that we misapplied binding precedent to the undisputed facts. In particular, Petitioner argues that “the Federal Circuit has held that the **effect** of a dismissal without prejudice is that it leaves the parties as if the underlying complaint had never been filed.” Req. 1 (citing *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)). Further, Petitioner argues that “[t]he PTAB has recognized, quoted, and adopted this law as precedent, reiterating that the **effect** of a dismissal without prejudice is to leave the parties as if the case had never been filed.” *Id.* at 1–2 (citing *Oracle Corp. v. Click-To-Call Tech’s LP*, IPR2013-00312, slip op. at 17 (Oct. 30, 2013) (Paper 26) (“The Federal Circuit consistently has interpreted the effect of such dismissals [without prejudice] as leaving the parties as though the action had never been brought.”) (precedential as to quoted

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section) (citations omitted)).

Petitioner acknowledges that “[a]n exception [to these precedential decisions] arises in cases consolidated under Rule 42 because the defendant remains answerable to the original complaint.” *Id.* at 2. Nevertheless, Petitioner argues that this exception is not applicable here.

As set forth in our decisions denying institution, the relevant facts regarding the timing of the related actions between Petitioner and Patent Owner are largely undisputed. *See* Dec. 2–3; Req. 3–4. Petitioner filed a first action (i.e., “the *Ford* action”) in the Eastern District of Michigan (“the Michigan court”) on February 19, 2015, seeking a declaratory judgment of non-infringement of three Versata patents, including patents challenged (e.g., the ’651 patent) in the captioned cases. Paper 2 (“Pet.”), vii; *see* Ex. 1129. In a later-filed Eastern District of Texas (“the Texas court”) case (i.e., “the *Versata* action”), filed on May 7, 2015, Patent Owner asserted infringement by Petitioner of patents challenged (e.g., the ’651 patent) in the captioned cases. Pet. vii; Ex. 2001. Petitioner requested an extension of time to file an answer and acknowledged the service date of the complaint in the *Versata* action as May 7, 2015. Paper 6 (“Prelim. Resp.”), 5; Ex. 2007 (“Unopposed Application for Extension of Time to Answer Complaint”). On October 14, 2015, the Michigan court denied Patent Owner’s motion to dismiss or alternatively transfer the *Ford* action to the Eastern District of Texas. Ex. 1132, 2; Pet. 2; Prelim. Resp. 5–6. On October 28, 2015 (i.e., one year before Petitioner filed the petitions for *inter partes* review in the captioned cases), Patent Owner answered Petitioner’s declaratory judgment

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complaint in Michigan and asserted challenged patents, including the '651 patent, by filing infringement counterclaims in the *Ford* action. Pet. 2; Ex. 1130 (“Defendant’s Answer . . . [and] Counterclaims”). On November 5, 2015, the Texas court “ordered the parties to file notice of any good faith reasons that [the Versata lawsuit] should not be dismissed, without prejudice, so that the issues *may [be] dealt with in the Michigan court.*” Pet. 2 (emphasis added; quoting Ex. 1132 (additional text added by Petitioner)). On December 3, 2015, noting that “neither party has provided arguments against dismissing the case,” the Texas court “ORDERED that this case is DISMISSED without prejudice to Plaintiff’s ability to assert its claims in the Michigan court.” Ex. 1134 (emphasis added); Pet. 2; see Ex. 1133, 1.

The doctrine of *stare decisis* or the binding effect of precedent requires a tribunal to recognize a rule of law (i.e., a precedential decision) in one case enunciated in an earlier case by that tribunal or by a higher tribunal, if the facts and issues involved in both cases are sufficiently similar.³ As Chief Justice Rehnquist explained:

[w]hile most often invoked to justify a court’s refusal to reconsider its own decisions, [*stare decisis*] applies *a fortiori* to enjoin lower courts to follow the decision of a higher court. This principle is so firmly established in our jurisprudence that no lower court would deliberately refuse to follow the decision of a higher court. *But cases come in all shapes and varieties, and it is not always clear whether a precedent applies to a situation in*

³ “[I]n the large, precedent consists in an official doing over again *under similar circumstances* what has been done by him or his predecessor before.” K.N. LLEWELLYN, THE BRAMBLE BUSH: ON OUR LAW AND ITS STUDY, 70 (8th prtg. 1985) (emphasis added).

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which some of the facts are different from those in the decided case. Here lower courts must necessarily make judgments as to how far beyond its particular facts the higher court precedent extends.

Hubbard v. U.S., 514 U.S. 695, 720 (1995) (emphasis added; Rehnquist, C.J., dissenting). Thus,

“[t]he doctrine of *stare decisis* rests on the underlying philosophy that any judicial statement, however broad, must be understood in its context, and as applying to the facts of the case. *It is not to be expanded to embrace, as well, a factual situation other than, different from, and contrary to, the facts of the case to which the language applies and is used.*”

U.S. v. R.J. Saunders & Co., 42 CCPA 128, 136 (1955) (emphasis added; quoting the Government’s brief with approval; not reported in the Federal Reporter); *see Deckers Corp. v. U.S.*, 752 F.3d 949, 962 (Fed. Cir. 2014) (quoting *Saunders*, 42 CCPA at 136, with approval).

In our decisions denying institution, we considered the factual situations presented in *Oracle*, *Bonneville*, and *Graves* and compared them to the factual situations presented in the instant proceedings. We determined that “[h]ere, unlike in *Oracle*, *Bonneville*, and *Graves*, the dismissal without prejudice was not pursuant to Rule 41(a), was not ‘voluntary,’ and, most importantly, did not leave the parties as though the action had never been brought.” Dec. 7; *see* Req. 4. Petitioner argues, however, that “it is irrelevant *why* a court dismissed the action if it was dismissed without prejudice.” Req. 5. We disagree because the doctrine of *stare decisis* demands that we consider the similarities in and differences between both the issues presented and the factual situations of the instant proceedings and

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those of the precedential decisions in order to determine whether the same results are required here.

Petitioner would have us apply the words “without prejudice” to talismanic effect, by which the consequence of the service of an infringement complaint that occurred more than one year prior to the filing of a petition is magically erased from every case in which those words appear and the bar of Section 315(b) disappears. This is simply not how precedent is applied. Rather, as we noted in our decisions denying institution, the Board consistently has looked to the underlying facts to determine what effect should be given to a dismissal without prejudice. Dec. 10–11; *see Apple, Inc. v. Rensselaer Polytechnic Inst.*, Case IPR2014-00319, slip op. 6–7 (PTAB June 12, 2014) (Paper 12) (“*Apple I*”), *reh’g denied* (Paper 14) (“*Apple II*”)⁴ (collectively, “*Apple*”); *Gordon Howard Assocs., Inc. v. Lunareye, Inc.*, Case IPR2014-01213, slip op. at 13–15 (PTAB Feb. 3, 2015) (Paper 11) (“*Lunareye*”); *Nautique Boats Co. v. Malibu Boats, LLC*, Case IPR2014-01045, slip op. at 10 (PTAB Nov. 26, 2014) (Paper 13); *Histologics, LLC v. CDx Diagnostics, Inc.*, Case IPR2014-00779, slip op. at 5 (PTAB Sept. 12, 2014) (Paper 6); *eBay, Inc. v. Adv. Auctions LLC*, Case IPR2014-00806, slip op. at 6–8 (PTAB Sept. 25, 2014) (Paper 14). The Board, however, has not made the decisions in any of these cases precedential. Therefore, although we considered the reasoning of the

⁴ Dec. 11 (citing *Apple II*, slip op. at 3 (denying request for rehearing; “[W]hether or not the dismissal could occur under Fed. R. Civ. P. 42 would not change the result of the Decision.”)).

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various panels in reaching their decisions, we are bound only by the Board decision in *Oracle* and then only to the extent that we find the issues and facts involved in *Oracle* and in the instant proceedings are sufficiently similar. In our decisions denying institution, we specifically found that “[b]ecause the circumstances here align with *Apple* and differ in critical respects from *Oracle* and related cases, we determine the exception [to the Section 315(b) for dismissals without prejudice] is not applicable.” Dec. 5.

In particular, Petitioner relies on the Board’s decision in *Atlanta Gas Light v. Bennet Regulator Guards, Inc.*, to argue that it is somehow improper to consider the *effect* of the dismissal in determining whether it removes the Section 315(b) bar to a petitioner’s petition. Req. 7–8. Nevertheless, the panel in *Atlanta Gas* carefully considered the factual context of the dismissal when determining that the dismissal by the Ohio court resulted in the lifting of the Section 315(b) bar. *Atlanta Gas*, Case IPR2015-00826, slip op. at 14 (PTAB Sept. 1, 2015) (Paper 12). As the panel went on to explain:

[t]he narrow preclusion associated with personal jurisdiction in Ohio does not justify treating the dismissal without prejudice in the Ohio lawsuit any differently than other dismissals without prejudice. See [*Lunareye*], slip op. at 12. *The impact of the “litigation events” identified by Patent Owner are similarly limited and also do not justify different treatment.*

Id. (emphasis added). Thus, the panel in *Atlanta Gas* only found the Section 315(b) bar lifted after it had considered the dismissal “without prejudice” in the context of the relevant facts.

Further, the panel in *Atlanta Gas* explained that “the Federal Circuit’s statement is understood properly as referring to the restored ability of parties

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to pursue courses of action available to them before the action had been brought.” Req. 7–8 (quoting *Atlanta Gas*, slip op. at 13). Unlike *Atlanta Gas* and the other cases cited by Petitioner, we are persuaded that, after the dismissal of the *Versata* action, the parties in the instant proceedings did not enjoy the restored ability to pursue courses of action available to them before the *Versata* action had been brought. The *Ford* action would remain the *first* action filed, so that a new action by Patent Owner filed in the U.S. District Court for the Eastern District of Texas would remain subject to the Eleventh Circuit’s first-to-file rule. See *Merrill Lynch, Pierce, Fenner & Smith, Inc. v. Haydu*, 675 F.2d 1169, 1174 (11th Cir. 1982) (“*In the absence of compelling circumstances*, the court initially seized of a controversy should be the one to decide the case.” (Emphasis added.)). Further, although the U.S. District Court for the Eastern District of Texas had asked the parties to provide any “good faith reasons” for maintaining the *Versata* action, Patent Owner responded that it did not oppose dismissal, and Petitioner chose not to respond. Dec. 7–8. Thus, on this record, we understand that either party could have argued to retain the *Versata* action, but that, after the dismissal, the parties no longer enjoyed the ability to bring this action in the U.S. District Court for the Eastern District of Texas.

Finally, Petitioner argues that our reliance on the involuntary nature of the dismissal was improper. Req. 9–10. In particular, Petitioner notes that the dismissals, without prejudice, for lack of personal jurisdiction in *Graves*, as well as *Atlanta Gas* and *LunarEye*, also were involuntary – at least with respect to the plaintiff. See *id.* at 9. Petitioner however misunderstands our

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use of the word “involuntary.” Unlike those cases, the U.S. District Court for the Eastern District of Texas determined to dismiss the *Versata* action absent compelling arguments by the parties to the contrary. *See* Dec. 7–8 (citing Ex. 2011, 3:16–21 (“[O]ne of the issues that’s going to come up is this first-to-file rule.”), 11:5–8 (“I’m also faced with the practical problem of in the Fifth Circuit under the first-to-file rule, I’m supposed to give deference to [Eastern District of Michigan] Judge Leitman and what he decides.”)). Thus, unlike a dismissal pursuant to Fed. R. Civ. P. 41(a), such as the dismissals in *Oracle* and *Bonneville*, neither Petitioner nor Patent Owner *requested* the dismissal (Dec. 5–6)⁵; and the dismissal of the *Versata* action was “involuntary” to the extent that the court acted in the absence of requests from either party. *See* Fed. R. Civ. P. 41(a)(2) (stating that “an action may be dismissed *at the plaintiff’s request* only by court order, on terms the court considers proper” (emphasis added))

For these reasons, we were persuaded that, because the facts of the instant proceedings, namely, that the dismissal “was not pursuant to Rule 41(a), was not ‘voluntary,’ and, most importantly, did not leave the parties as though the action had never been brought,” are *not* sufficiently similar to the facts present in the precedential decisions, we are not bound to find that

⁵ As we noted in our decisions denying institution, in holding that the dismissal put the appellant in the position in which it would have been, had it never filed a notice of appeal, the Federal Circuit in *Graves* compared those circumstances with the voluntary dismissal in *Bonneville*, in which the “nullifying effect of a voluntary dismissal in accordance with Fed. R. Civ. P. 41(a)(1) was applied.” Dec. 6 (quoting *Graves*, 294 F.3d at 1356).

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the dismissal of the *Versata* action “without prejudice” necessarily lifted the Section 315(b) bar.

2. Creation of “Continuous Chain of Assertion” Exception

Petitioner further argues that we misapplied the law in holding that there is a “continuous chain of assertion” exception to the precedential rule that a complaint dismissed without prejudice has no legal effect under 35 U.S.C. § 315(b). Req. 1. Petitioner, however, misunderstands our decisions.

First, Petitioner argues that we improperly focused on the patents, rather than on the actions filed. *Id.* at 10–11 (“the Board in the instant IPR looked not at the *Versata* **action**, but incorrectly at a specific infringement allegation in that action, and asserted that the **allegation** (not the action) was asserted continuously.” (Petitioner’s emphases)). Specifically, Petitioner argues that:

The Board did not address the undisputed fact that the *Versata* action did not continue in Michigan. *Versata* asserted 16 patents in the *Versata* action, but only 8 patents in Michigan. (Ex. 1130; *see also* IPR2017-00150, Ex. 1323.) Also, the *Versata* parties in the Texas action are different than the *Versata* parties in the Michigan action. (*Id.*)

Req. 11. As an initial matter, Section 315(b) requires us to look at both the action, as well as the asserted patent (i.e., “a complaint alleging infringement of the patent”). Petitioner does not contend, for example, that challenged patents (e.g., the ’651 patent) were not asserted in “a complaint alleging infringement” in the *Versata* action. Regardless, we disagree with Petitioner’s characterization of the Board’s decisions.

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In discussing the significance of the *Versata* and *Ford* actions, our focus clearly was on the actions as well. Dec. 11–12. In particular, we noted that

in resolving the forum dispute in favor of the Michigan court, *the respective courts treated the cases as if they were a single proceeding at least in terms of ability to assert claims and recognition of timing*. Consequently, we agree that the relevant factor in determining whether the earlier complaint in the *Versata* action is operative for purposes of § 315(b) is the continuous assertion of the patent against Ford, not whether the case was formally consolidated.

Id. at 12; *see also* Ex. 1131 (instructing the parties to provide good faith reasons why the *Versata* action should not be dismissed, “so that the issues may [be] dealt with in the Michigan court”). Further, regarding Petitioner’s arguments concerning the relative numbers of patents raised in the *Versata* action as compared to the *Ford* action and the allegedly differing “*Versata* parties” in Texas and Michigan, Petitioner did not raise these arguments during the Preliminary Proceedings, and we cannot have overlooked or misapprehended arguments not raised.

Second, Petitioner argues that the Board’s decisions in *Histologics*, *Apple*, and *eBay*, which we cite as analogous, are readily distinguishable from the instant proceedings. Req. 11–12 (citing Dec. 11–12). In particular, Petitioner argues that, “[i]n each instance, an action was consolidated such that the alleged infringer ***remained answerable to the original complaint.***” *Id.* at 11. However, we specifically acknowledged that the *Versata* and *Ford* actions had not been consolidated:

We are *not* persuaded the outcome here should turn on whether

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the cases were consolidated under Rule 42(a). *See Apple II*, slip op. at 3 (denying request for rehearing; “[W]hether or not the dismissal could occur under Fed. R. Civ. P. 42 would not change the result of the Decision.”).

Dec. 11 (emphasis added). Instead, we found that the effect of the rulings by the Michigan and Texas courts was to maintain continuous actions between the parties. A fact different from those present in the precedential decisions cited by Petitioner. Both courts stated as much; the Texas court in its decision dismissing the *Versata* action and the Michigan court in its decision to adopt the schedule that would have been in effect in the Texas court. *See* Ex. 1134 (The Texas court dismissed the *Versata* action “without prejudice to [Versata’s] *ability to assert its claims in the Michigan court.*” (Emphasis added.)); Ex. 2010, 40:8–10 (“Why isn’t it fair for Versata to say Ford wanted it here, we were concerned about timing, at least try to keep it like the Eastern District of Texas would?”).

We understand that Petitioner would weigh the relevant facts differently than we do. Nevertheless,

[a] request for rehearing is not an opportunity merely to disagree with the panel’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence. It is not an abuse of discretion to have performed an analysis or reached a conclusion with which Petitioner disagrees, and mere disagreement with the Board’s analysis or conclusion is not a proper basis for rehearing.

Sophos, Inc. v. Finjan, Inc., Case IPR2015-01022, slip op. at 3–4 (PTAB Jan. 28, 2016) (Paper 9).

Contrary to Petitioner’s contention, we do not create a further exception to the precedential exception created by *Oracle* in view of

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Bonneville and *Graves*, but, instead, merely find that the facts of the instant proceedings are sufficiently different from those present in the precedential decisions that we are not bound to *expand* the exception to Section 315(b) that they created regarding the effects of a dismissal “without prejudice” to the facts of the instant proceedings. Therefore, as stated in the decisions denying institution, we maintain that “the circumstances here do not warrant a departure from the statutory language of § 315(b) in favor of extending the exception for voluntary dismissals without prejudice to a case where the dismissal without prejudice was *not* voluntary and did *not* leave the parties in the position they were in had the action never been filed.” Dec. 12.

IV. ORDER

Accordingly, it is hereby:

ORDERED that Petitioner’s Requests for Rehearing in IPR2017-00144 and IPR2017-00146 through IPR2017-00151 are *denied*.

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