

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVIGILON CORPORATION and AVIGILON USA CORPORATION,
Petitioner,

v.

CANON INC.,
Patent Owner.

Case IPR2018-01626
Patent 7,034,864 B2

Before LYNNE E. PETTIGREW, J. JOHN LEE, and SCOTT E. BAIN,
Administrative Patent Judges.

PETTIGREW, *Administrative Patent Judge.*

DECISION

Denying Petitioner's Request on Rehearing of
Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Avigilon Corporation and Avigilon USA Corporation (collectively, “Avigilon” or “Petitioner”) request rehearing of our decision (Paper 11, “Decision” or “Dec.”) denying institution of *inter partes* review of claims 1–25 of U.S. Patent No. 7,034,864 B2 (Ex. 1001, “the ’864 patent”). Paper 12 (“Request” or “Req.”).¹ For the reasons given below, we deny the Request.

II. DISCUSSION

The party challenging a decision in a request for rehearing bears the burden of showing the decision should be modified. 37 C.F.R. § 42.71(d). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” *Id.*

In the Decision, we determined that, pursuant to 35 U.S.C. § 315(a)(1), Avigilon’s filing of a declaratory judgment action in district court challenging the validity of a claim of the ’864 patent barred institution of an *inter partes* review in this case, even though the declaratory judgment action was dismissed without prejudice before Avigilon filed its Petition challenging claims of the ’864 patent. Dec. 11–12. Accordingly, we denied institution of an *inter partes* review of the ’864 patent based on Avigilon’s Petition. *Id.* at 12.

In its Request, Petitioner contends that we misapprehended our obligation to recognize the “well-understood common law meaning of ‘filed

¹ Petitioner also requested review by the Precedential Opinion Panel (“POP”). Req. 1, 15; see Paper 13. The POP denied the request for review, and the original panel maintains authority over the submitted rehearing request. Paper 14, 2.

a civil action” in 35 U.S.C. § 315(a)(1). Req. 7–8. According to Petitioner, this misapprehension led to a “misapplication” of *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018) (en banc as to footnote 3), which, in Petitioner’s view, applies only to the time bar in 35 U.S.C. § 315(b), and not to the time bar in § 315(a)(1). Req. 7–8. Petitioner urges us to reconsider our interpretation of § 315(a)(1) and conclude that it does not bar institution of an *inter partes* review in this case. *Id.* at 11.

On August 29, 2019, after Petitioner filed its Request, the Board designated as precedential the decision denying institution of *inter partes* review in *Cisco Systems, Inc. v. Chrimar Systems, Inc.*, IPR2018-01511, Paper 11 (PTAB Jan. 31, 2019) (precedential). In that decision, the Board addressed the § 315(a)(1) bar in light of the Federal Circuit’s discussion of the § 315(b) time bar in *Click-to-Call*. *See Cisco*, Paper 11 at 5 n.1. The Board held in *Cisco* that § 315(a)(1) barred institution of an *inter partes* review even though an earlier civil action challenging the validity of a claim of the patent at issue had been voluntarily dismissed without prejudice. *Id.* at 8.

Cisco is binding precedent in the present case, which involves the same issue of statutory interpretation applied to similar facts. *See* Patent Trial and Appeal Board Standard Operating Procedure 2 (rev. 10) § III.D. Thus, pursuant to the ruling in *Cisco*, § 315(a)(1) bars institution of an *inter partes* review of the ’864 patent based on the Petition in this case. Petitioner, therefore, has not shown that our Decision should be modified, and accordingly we *deny* Petitioner’s Request for Rehearing.

III. ORDER

Accordingly, it is:

ORDERED that Petitioner's Request for Rehearing is *denied*.

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