

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT PACKARD ENTERPRISE CO.,
Petitioner,

v.

CHROMAR SYSTEMS, INC.,
Patent Owner.

Case IPR2019-00032
Patent 8,155,012 B2

Before KARL D. EASTHOM, ROBERT J. WEINSCHENK, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

LANEY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Hewlett Packard Enterprise Co. (“Petitioner”) requests rehearing of our decision (Paper 11, “Decision” or Dec.) denying institution of *inter partes* review of claims 1, 5, 6, 10, 13, 16, 22, 25, 26, 29, 30, 67, 73, 80, 88, 106, 108, 114, 121, 129, and 147 of U.S. Patent No. 8,155,012 B2 (Ex. 1003, “the ’012 patent”). Paper 12 (“Request” or “Req.”).¹ For the following reasons, we deny the Request.

II. DISCUSSION

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

In our Decision, we concluded that 35 U.S.C. § 315(a)(1) barred institution of an *inter partes* review because Petitioner previously filed a declaratory judgment action challenging the validity of claims in the ’012 patent, notwithstanding Petitioner’s voluntary dismissal without prejudice of that declaratory judgment action. Dec. 5–8. We explained that our conclusion was compelled by the Federal Circuit’s analysis in *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018) (en banc as to footnote 3). Dec. 6–8.

In its Request, Petitioner contends that we misapplied *Click-to-Call*, because we misapprehended the meaning “filed a civil action” in 35 U.S.C.

¹ Petitioner also requested review by the Precedential Opinion Panel (“POP”). Req. 6. The POP denied the request for review, and the original panel maintains authority over the submitted rehearing request. Paper 14, 2.

§ 315(a)(1). Req. 2–6. According to Petitioner, *Click-to-Call* applies only to the time bar in 35 U.S.C. § 315(b), and not to the time bar in § 315(a)(1). *Id.* at 4–6. Petitioner urges us to reconsider our interpretation of § 315(a)(1) and to conclude that it does not bar institution of an *inter partes* review in this case. *Id.*

On August 29, 2019, after Petitioner filed its Request, the Board designated as precedential a 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 *Cisco*, the Board relied on *Click-to-Call* in holding 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 this case, which involves the same issue of statutory interpretation. Petitioner does not argue, and we do not discern, that the facts in this case are distinguishable from *Cisco*. We, therefore, determine that pursuant to the ruling in *Cisco*, § 315(a)(1) bars institution of an *inter partes* review of the '012 patent 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

In consideration of the foregoing, it is hereby

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

IPR2019-00032
Patent 8,155,012 B2

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