

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

RENSSELAER POLYTECHNIC INSTITUTE and
DYNAMIC ADVANCES, LLC,
Patent Owner.

Case IPR2014-00319
Patent 7,177,798 B2

Before JOSIAH C. COCKS, JUSTIN T. ARBES, BRYAN F. MOORE,
MIRIAM L. QUINN, and KEVIN W. CHERRY,
Administrative Patent Judges.

PER CURIAM.

DECISION

On Petitioner's Notice of Basis for Request for Relief in the Form of a
Rehearing by an Enlarged Panel
37 C.F.R. §§ 42.5, 42.21(c)(1)

INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition for *inter partes* review of U.S. Patent No. 7,177,798 B2. Paper 1. A panel of the Board decided not to institute an *inter partes* review. Paper 12 (“Decision”). Petitioner requested rehearing of the decision not to institute review. Paper 13. The same panel denied rehearing. Paper 14 (“Rehearing Decision”). Petitioner has filed a Notice of Basis for Request for Relief, which requests a second rehearing by an expanded panel of the Rehearing Decision and the Decision not to institute *inter partes* review. Paper 19 (“Notice”), 1. At the direction of the Chief Judge, the panel has been expanded for the purpose of considering the arguments and request presented in the Notice.¹ For the reasons that follow, the expanded panel denies Petitioner’s most recent request.

DISCUSSION

Petitioner argues that the Decision and the Rehearing Decision conflict with “well-established law holding a dismissal of an action without prejudice pursuant to [Fed. R. Civ. P.] 41(a) renders the action a legal nullity, which at least twelve prior panels of the Board have found do not trigger the statutory bars in 35 U.S.C. § 315.” Notice 1. Petitioner also asserts that the decisions conflict with the plain meaning of § 315(b) by

¹ The members of the Board deciding an institution matter do not, under the Patent Statute, select themselves, and, similarly are not granted authority of their own accord to select other Board members to decide the matter — upon request of parties or otherwise. The designation of panel members is within the sole authority of the Director, which may be delegated. As indicated in the Board’s Standard Operating Procedures, the Chief Judge, on behalf of the Director, may act to expand a panel on a “suggestion” from a judge or panel. Accordingly, parties are not permitted to request, and panels do not authorize, panel expansion.

allowing an entity other than the patent owner to trigger the one-year period for filing a petition seeking *inter partes* review. *Id.* Petitioner contends that “[r]ehearing by an expanded panel is necessary to reconcile the panel’s decisions with the law and prior actions by the Board, and to bring certainty to the application of § 315(b).” *Id.* We find these arguments are unpersuasive.

In the Decision and Rehearing Decision, the panel determined that the Petition in this proceeding was untimely under § 315(b) based on the filing date of the first of two infringement actions brought against Petitioner, although the first action had been dismissed. Dec. 4–7; Rehearing Decision 2–7. The panel found that based on the particular facts of this case, the dismissal of the first action did not render the service of the first complaint a nullity, as Petitioner contended. Dec. 4–7; Rehearing Decision 2–7. Contrary to Petitioner’s contention that the panel’s decision is inconsistent with prior decisions, we find no conflict between the Decision and the Rehearing Decision in this case and prior decisions. As an expanded panel, we agree with the detailed explanation in the Rehearing Decision, which explains why the decision does not conflict with prior decisions, Federal Circuit precedent, or any principles of “federal jurisprudence,” as Petitioner contends. *See* Rehearing Decision. Indeed, we note that at least two other Board decisions reach similar conclusions to the Decision. *See eBay, Inc. v. Advanced Auctions LLC*, Case IPR2014-00806 (PTAB Sept. 25, 2014) (Paper 14); *Histologics, LLC v. CDX Diagnostics, Inc.*, Case IPR2014-00779, (PTAB Sept. 12, 2014) (Paper 6).

Petitioner also contends that the “panel’s decisions conflict with the plain meaning of § 315(b)” because “§ 315(b) can only be triggered by

service of a complaint from a party with standing to assert the patent.”
Notice 3. However, as the panel explained in the decision on Petitioner’s original rehearing request, this argument is untimely. Rehearing Decision 6–7. Petitioner provides no explanation why any good cause exists to consider this new argument, and we decline to do so.

Having fully considered Petitioner’s arguments, we determine that Petitioner’s Notice fails to show sufficient basis for a second request for rehearing under 37 C.F.R. § 42.21(c)(1).

ORDER

Accordingly, it is

ORDERED that Petitioner’s request for relief in the form of a second rehearing of the decision not to institute *inter partes* review is *denied*.

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Patent 7,177,798 B2

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