Trials@uspto.gov
571-272-7822

Paper No. 71
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EBAY INC., ALIBABA.COM HONG KONG LTD., AND BOOKING.COM B.V.,

Petitioner,

v.

GLOBAL EQUITY MANAGEMENT (SA) PTY. LTD.,

Patent Owner.

Case IPR2016-01828 (Patent 6,690,400 B1)
Case IPR2016-01829 (Patent 7,356,677 B1)[1]

Before KARL D. EASTHOM, MATTHEW R. CLEMENTS, and KEVIN C. TROCK, *Administrative Patent Judges.*

TROCK, *Administrative Patent Judge*

DECISION
Patent Owner's Request for Extension of Time to Appeal
37 C.F.R. § 90.3 (c)(1)(i)

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

[1] This Decision and Order applies to the two listed cases. The parties are not authorized to use this heading style.

Request to File Renewed Motions to Terminate

On September 21, 2018, we held a conference call with counsel for the parties, wherein Patent Owner's counsel requested permission to file renewed motions to terminate these proceedings based on the recent Federal Circuit opinion in *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018). For the reasons stated below, we deny Patent Owner's request.

Earlier in these proceedings, on September 18, 2017, Patent Owner filed motions to terminate, arguing,

> [o]n July 22, 2016, Amazon filed an action in the Eastern District of VA seeking a declaratory judgment of invalidity of U.S. Patent Numbers 6,690,400 ("the '400 patent") and 7,356,677 ("the '677 patent"). . . . Amazon filed the Virginia action, at least in part, on behalf of Expedia, and TripAdvisor LLC and even declared itself to be the "real part[y] in interest" with regard to lawsuits filed in Texas against the Amazon IPR customers for infringement of the '400 and '677 patents.

Paper 31, 1 (IPR2016-01828); Paper 30, 1 (IPR2016-01829).

Pursuant to 35 U.S.C. § 315(a)(1) "[a]n *inter partes* review may not be instituted if, before the date on which the petition for such a review is filed, *the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent*." (emphasis added). On January 18, 2018, we denied Patent Owner's motions to terminate, stating,

> Patent Owner's evidence does not show that Expedia, Booking.com, or TripAdvisor previously 'filed a civil action challenging the validity of a claim of the patent.' Under the unambiguous language of the statute, being an RPI in the Virginia action, as Patent Owner asserts, does not trigger the preclusive effect of 35 U.S.C. § 315(a)(1).

Paper 58, 5–6 (IPR2016-01828); Paper 57, 5–6 (IPR2016-01829). [2]

During the conference call, counsel for Patent Owner was unable to explain how the evidence of record, even after taking into consideration the Federal Circuit's opinion in *Applications in Internet Time*, established that Expedia, Booking.com, or TripAdvisor previously "filed a civil action challenging the validity of a claim of the patent," as required to invoke 35 U.S.C. § 315(a)(1). Without an explanation as to how the evidence would establish that Expedia, Booking.com, or TripAdvisor *filed* the civil action in Virginia, Patent Owner's renewed motion to terminate would be futile. Accordingly, we decline to grant Patent Owner's request to file renewed motions to terminate these proceedings.

Request for Extension of Time to Appeal

We issued our Final Decisions in these proceedings on April 17, 2018 (Paper 64, IPR2016-01828), and April 18, 2018 (Paper 63, IPR2016-01829). We issued our decisions on Patent Owner's Request for Rehearing on October 12, 2018 (Paper 69, IPR2016-01828), and October 15, 2018 (Paper 66, IPR2016-01829).

On December 4, 2018, Patent Owner filed, without authorization, a Request for an Extension of Time to Appeal under 37 C.F.R. § 90.3 (c)(1)(i).

[2] As the party seeking relief, Patent Owner bears the burden of persuasion on the motions to terminate. Petitioner, however, bears the burden of persuasion on the real party in interest issue. Petitioner met its burden on the real party in interest issue, but Patent Owner did not meet its burden on the motions to terminate. *See* Paper 58, 5–6 (IPR2016-01828); Paper 57, 5–6 (IPR2016-01829).

Paper 70 (IPR2016-01828); Paper 67 (IPR2016-01829).[3] Patent Owner requests an additional 30 days to appeal our Final Decisions to the Federal Circuit for two reasons. First, Patent Owner argues, if an appeal of the Final Decisions is filed, it is unclear the Board would retain jurisdiction to rule on the pending request for authorization to file renewed motions to terminate. Paper 70, 2; Paper 67, 2. Second, Patent Owner argues, if a motion to terminate the proceedings was authorized and granted, appeal would be unnecessary. *Id.* Because we deny *instanter* Patent Owner's request to file renewed motions to terminate these proceedings, Patent Owner's reasons for requesting additional time to appeal our Final Decisions to the Federal Circuit are moot. Patent Owner's Requests for an Extension of Time to Appeal are, therefore, denied as moot.

ORDER

Accordingly, it is

ORDERED that Patent Owner's request for authorization to file renewed motions to terminate is denied; and

FURTHER ORDERED that Patent Owner's Requests for an Extension of Time to Appeal (IPR2016-01828, Paper 70; IPR2016-01829, Paper 67) are denied as moot.

[3] Patent Owner's requests were not pre-authorized and, therefore, should be expunged as papers filed without authorization. Nevertheless, we address the merits.

IPR2016-01828; Patent 6,690,400
IPR2016-01829; Patent 7,356,677

PETITIONERS:

Benjamin Weed
Jackson Ho
K&L GATES LLP
benjamin.weed.ptab@klgates.com
jackson.ho@klgates.com

Todd Siegel
Andrew Mason
KLARQUIST SPARKMAN, LLP
todd.siegel@klarquist.com
andrew.mason@klarquist.com

Brett Watkins
Lance Yang
QUINN EMANUEL URQUHART & SULLIVAN, LLP
brettwatkins@quinnemanuel.com
lanceyang@quinnemanuel.com

PATENT OWNER:

Mark Cantor
Richard J. Cantor
Isaac T. Slutsky
BROOKS KUSHMAN P.C.
mcantor@brookskushman.com
rjcantor@brookskushman.com
islutsky@brookskushman.com