Paper No. 8
Filed February 5, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMUNICATIONS TEST DESIGN, INC.,

Petitioner

v.

CONTEC, LLC,

Patent Owner

Case: IPR2019-01670
U.S. Patent No. 8,209,732

PATENT OWNER CONTEC, LLC'S SURREPLY IN SUPPORT OF ITS PRELIMINARY RESPONSE

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I. INTRODUCTION

In its Reply, CTDI never discusses the text of § 311(a) and its effect on the jurisdictional time bar under § 315(b). Instead, CTDI mistakenly contends that the Board has already decided the issue and misconstrues Contec's statutory interpretation in an attempt to discredit it. CTDI fails to meet its burden to show that its Petition is timely. Accordingly, CTDI's Petition should be denied as time-barred.

II. CTDI'S PETITION IS UNTIMELY

A. The Board Has Never Considered Whether Section 311(a) Renders the Grace Period Under Section 21 Inapplicable to IPR Petitions.

As Contec explained, the plain text of § 311(a) establishes that a petitioner cannot rely on § 21 to file an IPR petition outside the one-year, jurisdictional deadline under § 315(b). *See* Prelim. Response at 4-8. CTDI cites three prior Board decisions in support of its claim that § 21(b) should apply to § 315(b). As shown below, none of these decisions considered the language of § 311(a).

1. The *Samsung* Decision Did Not Consider § 311(a).

Contec addressed the *Samsung* panel decision at length in its Preliminary Response. *See* Prelim. Resp. at 4-5, 8. CTDI's arguments in reply miss the mark.

First, Contec does not contend that the *Samsung* decision was decided on an incomplete record. The *Samsung* panel's statement that it was "not persuaded on the current record" that § 21(b) should not apply "in this situation," *Samsung*, Paper No. 10 at 17, indicates that the decision was limited to the specific facts and arguments

in that case, and should not be considered as providing guidance for other cases, which is consistent with the decision's non-precedential status. Further, Contec points to the *Samsung* panel's belief that "nothing in the Patent Act suggests that the filing of [IPR] petitions is exempt from the provisions of § 21(b)" not to suggest that § 311(a) was not in the record. (The Patent Act is the law, not part of the evidentiary record.) Rather, the *Samsung* panel made this blanket statement without anyone directing attention to the language of § 311(a) or explaining its importance. Had the *Samsung* panel considered § 311(a), it would have decided the matter differently.

Second, CTDI is incorrect to claim that Contec's reliance on § 311(a) "repackages" the argument considered in *Samsung*. In *Samsung*, the patent owner made a basic statutory construction argument that § 21 provides a general rule that is in conflict with, and must yield to, the specific jurisdictional limitation in § 315(b). *Samsung* at 14, 18. This argument simply compares § 21 and § 315(b) without considering any other provisions in the statutory framework governing IPRs. Contec, by contrast, demonstrated that the language of § 311(a) limits who may petition for IPR by reference to the provisions of "this chapter" (Chapter 31), which includes the jurisdictional time bar of § 315(b), but not the grace period of § 21. No such argument was made or considered in *Samsung*.

Third, CTDI claims that Contec cites no support for its argument, when Contec in fact cited two *en banc* decisions from the Federal Circuit, both of which

concerned the same § 315(b) at issue here. *See* Prelim. Resp. at 7-8 (citing *Wi-Fi One* and *Click-to-Call*).[1] CTDI, on the other hand, resorts to citing unhelpful cases involving different statutory frameworks and language.[2]

2. The *Google* Decision Did Not Consider § 311(a) and Should be Dismissed as Non-Persuasive.

In *Google*, the patent owner did not provide any substantive arguments to support its claim that the IPR petition was untimely. *Google*, Paper No. 9 at 10 n.7. Instead, the patent owner attempted to incorporate by reference the arguments and authorities raised in the IPR2018-01468 Samsung proceeding. *Id.* The *Google* panel ruled that "[s]uch incorporation by reference is not permitted, and we do not consider arguments so made." *Id.* (citing 37 C.F.R. § 42.6(a)(3)).

The *Google* panel went on to apply the reasoning from *Samsung* and declined to dismiss the petition as time barred under § 315(b). *Id.* at 10-11. The panel did not

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[1] *Click-to-Call* was considered by the *Samsung* panel in connection with a different argument. *See Samsung* at 18.

[2] *See AFGE v. Gates*, 486 F.3d 1316, 1324 (2007) (interpreting provisions in Chapter 99 of Title 5 relating to the Department of Defense that expressly referred to provisions in Chapter 71); *Crawford Family Farm P'ship v. TransCanada Keystone Pipeline, L.P.*, 409 S.W.3d 908, 916 (Tex. App. 2013) (interpreting state natural resources statute that "merely state[d], in a descriptive manner, that a common carrier under this section is one that is subject to the provisions of the chapter," not that such a common carrier is subject to all provisions of the chapter).

consider the language of § 311(a). *Id.* at 9-11. As a result, the *Google* panel, like the *Samsung* panel, incorrectly believed that "nothing in Title 35 pertaining to [IPR] suggests that its provisions are exempt from the effect of § 21(b)." *Id.* at 10-11.

3. The *ELM* Decision is Inapposite.

In *ELM*, the statutory filing deadline fell on December 24, 2015, which was a Thursday. *ELM*, Paper No. 11 at 4-5. Two days before the deadline, the USPTO experienced a major power outage that required the shutdown of many systems. Given the circumstances, the USPTO announced that it was considering December 22-24 a "Federal holiday" under § 21. The petitioner relied on § 21 to file its IPR petition on Monday, December 28, the next succeeding business day after December 24, because December 25 was a Federal holiday. *Id.*

The patent owner argued that the petition was untimely because the USPTO did not have the authority to treat December 22-24 as a Federal holiday. *Id.* at 5. The patent owner did not contend or suggest that § 21 was inapplicable to IPR petitions or the one-year time bar of § 315(b). *See ELM*, Paper No. 8, Patent Owner Prelim. Resp., at 6-10 (arguing that "Federal holidays are declared by Congress in 5 U.S.C. § 6103, not by the PTO. The PTO has no authority to act contrary to statute."). Thus, after rejecting the patent owner's lack of authority argument, the *ELM* panel simply assumed without discussion that § 21 was applicable and found that the petition was timely under § 315(b). *ELM*, Paper No. 11 at 5.

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