UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CRYE PRECISION LLC,
PETITIONER

v.

FIRSTSPEAR, LLC,
PATENT OWNER

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Case No. IPR2019-01152 (Patent 9,974,379 B2)
Case No. IPR2019-01153 (Patent 9,565,922 B2)

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PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION UNDER 37 CFR § 42.5(c)(3)

LIST OF EXHIBITS

Exhibit 2001	File History of U.S. patent application 14/237,468
Exhibit 2002	Copies of PTAB E2E email notifications in IPR2019-01169 and -01170 sent on December 16, 2019

I. INTRODUCTION

Petitioner did not file its rehearing requests by the December 20, 2019 due date and ignored explicit warnings from the Board's electronic filing system that no documents had been filed on that date. Petitioner failed at its obligation to check the Board's electronic database until April 9, 2020, nearly four months later, when Petitioner allegedly discovered that the rehearing requests were not filed. Petitioner's purported misinterpretation of the December 20, 2019 electronic filing notice is unreasonable as Petitioner's counsel is aware the notices provide a list of filed documents, which lists the primary brief or motion in addition to any exhibits.

As other Board decisions show, under these facts there is no "good cause" or "interests of justice" for the Board to excuse Petitioner's late filing of a rehearing request challenging the Board's decision denying institution. 37 CFR §42.5(c)(3).

II. PETITIONER HAS SHOWN NO GOOD CAUSE TO EXCUSE THE NEARLY FOUR-MONTH LATE ACTION

On December 20, 2019, the Board's e-filing system (E2E) emailed Petitioner's lead and back-up counsel a notification warning in all capitals letters that "THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST." Ex. 1019 and 1020. Despite this accentuated warning from the E2E system, Petitioner's lead counsel acknowledges there was no review of the rehearing requests on the E2E system until nearly four months later on April 9, 2020 when Petitioner's counsel was informed that the rehearing requests "were not reflected in

the PTAB's E2E docket." Ex. 1017 at ¶7. Petitioner's lead counsel tries to excuse this delay due to a mistaken belief that the E2E notice merely indicated no other documents, such as exhibits, were filed with the rehearing request.[1] *Id*. at ¶4.

Even assuming Petitioner had a good faith belief that the rehearing requests were filed, that belief would not satisfy good cause in light of Petitioner's failure to timely review filings. Moreover, Petitioner's belief that the E2E notification it received indicated a properly filed rehearing request is unreasonable given Petitioner's counsel's familiarity with the format of E2E notifications.

A. There Is No Good Cause Where Petitioner Failed to Review Filing

Board panels have found there is no good cause to excuse a late filing when a party fails in its obligation to timely review its filings. *See e.g.*, *Nuna Baby Essentials, Inc. v. Britax Child Safety, Inc.*, IPR2018-01683, Paper 11 at 6 (PTAB Dec. 18, 2018) ("Though Petitioner may have had a good faith belief on the day of filing, this belief must be reconciled with the obligation of counsel to review the filing and the file."); *see also Conmed Corp., et al. v. Bonutti Skeletal Innov. LLC*, IPR2013-00624, Paper 18 at 8 (PTAB Feb. 21, 2014) ("At the very least, the responsibilities of Petitioner's counsel include reviewing documents uploaded

[1] Petitioner did not submit a declaration from its back-up counsel likewise attesting to misinterpreting the E2E email. Absent that testimony, the Board should discount Petitioner's allegation it misinterpreted the E2E email.

during this proceeding and, if necessary, notifying the Board of a mistake, inconsistency, or error *in a timely manner*.") (emphasis added)

The failure to timely review filings is even more problematic when a party received notice of the defect. A Board panel faced with a failure to "take immediate action" in response to the same E2E notification at issue here found no good cause:

> In this regard, we note that the email generated by the PTAB E2E system and sent to counsel of record on May 8, 2019 clearly stated "THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST." Ex. 3001. Patent Owners have not explained why they did not take immediate action after receiving that email to determine whether the Request for Rehearing was actually filed. Indeed, Patent Owners remained silent for over three weeks until the Board initiated contact with the parties *sua sponte* to inquire about whether Patent Owners intended to file a Request for Rehearing. Thus, we do not find that Patent Owners have shown good cause to excuse the late filing.

Rust-Oleum Corp, et al. v. Stuart, et al., IPR2017-02158, Paper 35 at 8 (PTAB July 23, 2019) (footnote omitted); *see also Nuna Baby* at 7 ("good faith belief must be further reconciled with the fact that the Board informed Petitioner of the error.").

Just as in *Nuna Baby* and *Rust-Oleum*, Petitioner here did not fulfil its obligation to timely review its filings. Indeed, Petitioner acknowledges it did not review its alleged December 20, 2019 filing **for nearly four months** when Petitioner discovered on April 9, 2020 that the rehearing requests "were not reflected in the PTAB's E2E docket." Ex. 1017 at ¶7. Notably, of the Board cases cited by Petitioner

finding good cause to excuse a late filing the longest delay between the missed filing and request for relief was less than three weeks. *Expedia, Inc. v. IBM Corp*., IPR2018-01743, Paper 9 at 2 (April 29, 2019) (delay of 8 days); *Magellan Midstream Partners L.P. v. Sunoco Partners Mktg. & Terminals L.P.*, IPR2019-00024, Paper 15 at 2 (May 3, 2019) (delay of 3 days); *T-Mobile, Inc. v. Barkan Wireless Access Techs., L.P*., IPR2017-01099, Paper 43 at 2 (Nov. 20, 2018) (delay of 18 days); *Valeo N. Am., Inc. v. Schaeffler Techs. AG*, IPR2016-00502, Paper 46 at 2 (Aug 7, 2017) (delay of 7 days); *H&S Mfg. Co., Inc. v. Oxbo Int'l Corp*., IPR2016-00926, Paper 8 at 2 (Dec. 7, 2016) (delay of 14 days).

The Board has previously cautioned, "even a cursory review of the file would have alerted counsel for Petitioner" of the filing error. *Nuna Baby* at 6. Had Petitioner performed a "cursory review" of E2E on or shortly after December 20, 2019, it would have discovered then that the rehearing requests were not filed. Petitioner failed to timely review its filings and cannot now complain nearly four months later that good cause excuses its failure.

B. Petitioner's Misinterpretation of the E2E Notification Is Unreasonable

Petitioner alleges that its counsel believed the E2E notification that "THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST" "merely reflected the fact that no supporting documents/exhibits were filed along with the motion." PO Motion at 3 (citing Ex. 1017 at ¶¶4 and 9). Yet, Petitioner's lead

counsel states they have been involved in over 70 PTAB proceedings (Ex. 1017 at ¶1) and thus should be well aware that E2E notifications of party filings include a bolded section entitled "**Document(s) List**" which expressly sets out all documents filed, including the principal brief/motions as well as any exhibits.

Indeed, in two related IPR proceedings,[2] Petitioner's counsel received E2E notifications for properly filed rehearing requests four days prior to receiving the allegedly misinterpreted E2E notification in the instant proceedings. Ex 2002. As seen below, the filed "**Document(s) List**" in the notifications is readily apparent.

The following document(s) has/have been filed.

Document(s) List

No.	Document No.	Document Type	Document Name	Filing Party	Availability
1	16	Other	Request for Reconsideration	Petitioner	Available for everyone.

Id. at 1and 2 (emailed to the instant Petitioner's lead and back-up counsel).

Rather than providing a filed "**Document(s) List,**" the E2E notification in the instant proceedings stated "NO DOCUMENTS SUBMITTED." Ex. 1019 and 1020. Given Petitioner's lead counsel's experience with PTAB filings, and particularly in light of the electronic filing notice received in the related IPRs, it is not reasonable

[2] These two related IPR proceedings, IPR2019-1169 and -1170, are particularly relevant here since Petitioner attributes the discovery of its error in this case to the issuance of the Board's rehearing decisions in those two IPRs. Ex. 1017 at ¶6.

that Petitioner believed the E2E notifications it received in the instant proceedings indicated the rehearing requests had been filed.

III. INTERESTS OF JUSTICE DO NOT EXCUSE A LATE FILING

As in other cases where the Board has refused to find that the interests of justice excuse a late filing, here the "issue is of Petitioner's own making." *Nuna Baby* at 8. The interests of justice do not require the Board to fix a problem that was created by Petitioner's own failure to monitor and timely address the errors.

In addition, the underlying issue here relates to reconsideration of the Board's decision denying institution. The Board has "complete discretion to decide not to institute review." *Saint Regis Mohawk Tribe v. Mylan Pharms. Inc*., 896 F.3d 1322, 1327 (Fed. Cir. 2018); *Nuna Baby* at 8 ("no automatic right to petition for an *inter partes* review"). Petitioner does not attempt to explain why the interests of justice require allowing a late filing to reconsider a discretionary decision.

Here, there is no pending litigation or appeals involving the patents at issue that would benefit from a more complete record. *Cf. Rust-Oleum* at 5. Moreover, unlike final written decisions, institution denials do not involve estoppel under §315(e). Petitioner merely seeks to take advantage of its error by extending these already terminated IPRs and unfairly prolonging questions of the patents' validity to further its business interests against a competitor. Those are not the interests 37 CFR §42.5(c)(3) seek to protect.

Dated: May 5, 2020

Respectfully submitted,

/James P. Murphy/
James P. Murphy, Reg. No. 55,474
Margaux A. Savee, Reg. No. 62,940
POLSINELLI PC
1000 Louisiana, Fifty-Third Floor
Houston, Texas 77002

Attorneys for Patent Owner

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION UNDER 37 CFR § 42.5(C)(3)** have been served via Electronic Mail on May 5, 2020 upon the following:

Heath J. Briggs
BriggsH@gtlaw.com

Barry J. Schindler
SchindlerB@gtlaw.com

Stephen Ullmer
UllmerS@gtlaw.com

crye-iprs@gtlaw.com

/Sonia Ramirez/
Sonia Ramirez
POLSINELLI PC
1000 Louisiana, Sixty-Fourth Floor
Houston, Texas 77002
Tele: (713) 374-1600
Fax: (713) 374-1601