

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CRYE PRECISION LLC,
Petitioner,

v.

FIRSTSPEAR, LLC,
Patent Owner.

IPR2019-01152 (Patent 9,974,379 B2)
IPR2019-01153 (Patent 9,565,922 B2)

Before KEN B. BARRETT, KRISTEN L. DROESCH, and
ROBERT L. KINDER, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

ORDER
Denying Petitioner's Motion Under Rule 42.5(c)(3)
37 C.F.R. § 42.5

INTRODUCTION

On April 10, 2020, Petitioner Crye Precision LLC contacted the Board via email concerning the filing of Petitioner's Requests for Rehearing ("Requests") of the decisions dated November 22, 2019, denying institution in the above-captioned cases. That email states, in pertinent part:

Yesterday (April 9, 2020), Petitioner became aware that its requests for rehearing in IPR Nos. 2019-01152 and -01153 do not appear in the respective dockets for these cases. Petitioner filed these requests between 7:04pm on December 20, 2019, when staff for lead counsel first accessed the PTAB E2E filing system, and 7:12pm ET the same day, when Petitioner served Patent Owner with the filed documents (service email attached). Copies of the PTAB receipts for these filings are attached. A copy of the service email to opposing counsel is also attached.

Petitioner requests that the Board update the online dockets to reflect Petitioner's filing of requests for rehearing in IPR Nos. 2019-01152 and -01153 on December 20, 2019. Petitioner further requests that the Board expedite ruling on these motions given their December filing dates.

Counsel for Petitioner has conferred with counsel for Patent Owner and, despite being furnished with the attached PTAB receipts and having been served with the requests contemporaneously with their filing, Patent Owner opposes this request as it "does not view the motions as having been filed."

On April 16, 2020, Judges Barrett, Droesch, and Kinder held a conference call with counsel for Petitioner and Patent Owner. After the conference call, we entered an order authorizing Petitioner to file a motion under 37 C.F.R. § 42.5 regarding the submission of its Requests for Rehearing, and authorizing Patent Owner to file an opposition. Paper 9¹.

¹ Unless otherwise indicated, citations are to papers filed in IPR2019-01152.

Subsequently, Petitioner filed its paper, captioned as “Petitioner’s Motion Under 42.5(c)(3),” Paper 10 (Mot.), and Patent Owner filed its opposition, Paper 11 (Opp.).

Upon consideration of the arguments presented and for the reasons discussed below, we deny Petitioner’s motion.

BACKGROUND

On November 22, 2019, we denied institution of *inter partes* reviews in the above-captioned cases. Paper 8.

On December 20, 2019, the Board’s docketing system, PTAB E2E, generated a document titled “Motion Filed Notice,” with that title followed by the statement “THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST.” Ex. 1019. Near the bottom of the notice is the phrase: “The motion and related document(s), if any, have been filed.” *Id.* The notice does not contain a list of documents. *Id.*²

Petitioner’s counsel testifies that he received the system-generated notices and that:

I recall reviewing those filing receipts, noting that the phrase “Motion Filed” appeared in their subject lines and that they further reflected that “The motion and related document(s), if any, have been filed.” I noted that the requests stated “THERE

² Petitioner selected “motion,” rather than “request for rehearing,” as the filing type when attempting to file the paper. *See* Ex. 1019 (“Motion Filed Notice”); *cf.* PTAB E2E External User Guide for Rehearing Requests (July 7, 2016), page 1, *available at* <https://www.uspto.gov/sites/default/files/documents/8%20Rehearing.pdf> (“To initiate a Rehearing Request, Go to ‘AIA Review Actions’ menu and select ‘File a Rehearing Request.’”); Ex. 2002 (a Document Filing Notice from another case involving the parties and containing a “Document(s) List” identifying Document No. 16 as “Request for Reconsideration”). This may have contributed to the issue now before us.

WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST,” but I believed this statement reflected the fact that each request was unaccompanied by any other documents other than the request.

Ex. 1017 ¶ 4. Petitioner sent via email to Patent Owner’s counsel copies of the Requests. *Id.*, ¶ 5 (citing Ex. 1021). Petitioner’s counsel further states: “As of that time [on December 20, 2019], I believed all of Petitioner’s obligations for properly filing the Rehearing Requests had been completed.” *Id.* According to Petitioner, “on April 9, 2020, [its counsel] became aware that its Requests were not reflected in the E2E docket . . . [and Counsel] investigated further and took immediate remedial action.” Mot. 2 (citing Ex. 1017 ¶¶ 7–8). That action includes the email, quoted above, that “informed the Board of the issue and requested that the docket be updated to reflect the filings,” and that culminated in the filing of the present motion. *Id.*

DISCUSSION

Petitioner seeks relief in the form of “authorization to accept the filing of a Request for Rehearing [in each of the two captioned cases] . . . pursuant to 37 C.F.R. § 42.5(c)(3).” Mot. 1. The applicable rules provide, in pertinent part: “Any request [for rehearing] must be filed . . . [w]ithin 30 days of the entry of . . . a decision not to institute a trial,” 37 C.F.R. § 42.71(d)(2), and “[a] late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice,” 37 C.F.R. § 42.5(c)(3). Thus, the “late action” at issue is the prospective filing of the Requests for Rehearing.

Notwithstanding that it is undisputed that the Requests were not in the Board’s filing system at the expiration of the 30 days allowed for the filing

of the Requests and are not now filed as papers in the Board's system,³ Petitioner argues that the documents have been filed and that the filing was done timely. *See, e.g.*, Mot. 1 (“[O]n December 20, 2019, Petitioner timely filed its Requests.”); *id.* at 2 (“Crye . . . filed the Requests in a timely manner.”); *supra* (quoted email stating, “Petitioner requests that the Board update the online dockets to reflect Petitioner’s filing of requests for rehearing.”); *cf. id.* at 1 (Petitioner omitting the word “late” in seeking “authorization to accept the filing.”). Where Petitioner seeks relief under a rule pertaining to the late filing of a document and, yet, Petitioner contends that there is no such late filing, respecting Petitioner’s role as the master of its own case would result in the motion properly being denied as seeking unnecessary relief.

Nonetheless, we, like Patent Owner (Opp. 1), proceed with the understanding that Petitioner asks us to excuse the late filing of the Rehearing Requests. As indicated by the language of the rule, a late filing will be excused either “on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice,” 37 C.F.R. § 42.5(c)(3).

Good Cause

Petitioner argues:

Good cause exists because Crye (1) filed the Requests in a timely manner . . . ; (2) served Patentee’s counsel with the Requests . . . ; (3) reviewed the filing receipts and reasonably

³ We acknowledge that the Requests sought to be filed pursuant to the present motion have been placed in the record by Petitioner as exhibits to that motion. Mot. 1 (citing Exs. 1027, 1028).

concluded that its filing was successfully completed . . . ; and (4) was unaware of any potential filing error until April 9, 2020. Mot. 2 (citing Ex. 1017 ¶¶ 1–5; Ex. 1018 ¶¶ 1–6; Ex. 1021). Petitioner further argues that, “[a]fter the Requests were filed, [its counsel] reviewed the filing receipts and service email, and reasonably concluded that Crye’s filings were completed successfully.” *Id.* at 3 (citing Ex. 1017 ¶ 4). Petitioner’s asserts that it was reasonable to believe that the warning “THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST” “merely reflected the fact that no supporting documents/exhibits were filed along with the motion.” *Id.* (citing Ex. 1017 ¶¶ 4, 9). Petitioner argues that it “had no reason to believe a filing error occurred” and that it “was not notified of any errors.” *Id.* at 4–5 (citing several, purportedly “similarly situated cases”⁴). Petitioner argues that it “took immediate remedial action” in April and when it “learned of a potential filing error.” *Id.* at 5. Thus, argues Petitioner, good cause exists to accept the filings. *Id.*

We do not find Petitioner’s arguments persuasive. The Requests are not in the record as papers and were not “filed . . . in a timely manner,” as Petitioner insists. Mot. 2. This argument is internally contradictory in that it posits that there is good cause to accept a late filing because the Request was timely filed.

We also are not persuaded by Petitioner’s assertions that it was reasonable to conclude that the filing was successfully completed, that it was unaware until April of any potential filing error made in December, that it

⁴ Patent Owner states, “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.” Opp. 3–4

“had no reason to believe a filing error occurred,” and that it “was not notified of any errors.” *Id.* at 2, 4–5. Petitioner does not assert that there is a lack of familiarity with the filing system that might give rise to good cause but, rather, states that its counsel and his paralegal have successfully completed hundreds of filing with the Board. Mot. 2–3; *see* Opp. 4–5 (Patent Owner arguing that Petitioner “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.”).

Petitioner implicitly admits that it did not look at the dockets in the Board’s filing system for approximately four months, and simply assumed that the documents were there. Even if there was ambiguity in the warning—“THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST”—that, nonetheless, constitutes a warning and placed Petitioner on notice that there was a potential filing error. *See Rust-Oleum Corp, et al. v. Stuart, et al.*, IPR2017-02158, Paper 35 at 4–5 (PTAB July 23, 2019) (no finding of good cause because the movants, receiving the same warning, “have not explained why they did not take immediate action after receiving that email to determine whether the Request for Rehearing was actually filed,” and “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.”).

Petitioner’s interpretation of that warning as an indication that the filing was successful is unreasonable, as is Petitioner’s almost four month delay in reviewing the file in the PTAB’s electronic filing system to determine whether the papers were present. *See Nuna Baby Essentials, Inc.*

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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.”); *Conmed Corp. 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 during this proceeding and, if necessary, notifying the Board of a mistake, inconsistency, or error in a timely manner.”); *see also* PTAB E2E External User Guide for Rehearing Requests (July 7, 2016), pages 4–6, *available at* <https://www.uspto.gov/sites/default/files/documents/8%20Rehearing.pdf> (instructing users, after clicking “submit,” to “Go back to ‘My Docket’ and select the ‘Rehearing’ to see the request for rehearing document filed in the case” and “Click on the ‘View Documents’ button to see the request for rehearing filed and click on the ‘Download’ button to see the pdf document.”).

As mentioned, Petitioner argues that good cause exists because it served the Requests on Patent Owner. Mot. 2. Petitioner makes the related argument that Patent Owner has suffered no “legitimate prejudice” because service of the Requests occurred “immediately after they were filed.” *Id.* at 6. We do not find that any notice to, or lack of prejudice to, Patent Owner offsets Petitioner’s failure to act for almost four months after being presented with the warning that no documents were submitted with its attempted filing. *Cf. Nuna Baby Essentials*, IPR2018-01683, Paper 11 at 6 (“We agree that Patent Owner did not suffer substantial prejudice in this instance. Nonetheless, lack of prejudice does not demonstrate good cause

for excusing a late filing, particularly when opportunity has been provided already to correct the error or mistake.”).

Petitioner has not shown good cause to excuse the late filing of the Requests for Rehearing.

Interests of Justice

Petitioner argues that the interests of justice are served by granting the motion because “the PTAB did not notify Petitioner of a deficient filing.” Mot. 5–6. We do not find that argument persuasive as each of the notices stated “THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST.” That constitutes notification to Petitioner⁵ and, thus, we need not reach the implied argument that there is further obligation on the Board in that regard.

Petitioner Crye also argues that “[i]t would be inequitable to deny Crye’s Requests on these facts, particularly given that . . . Crye immediately took remedial action upon discovering that its filings were not correctly received.” Mot. 6. This argument ignores the almost four-month delay prior to discovering that the Requests were not in the respective files. Patent Owner argues in opposition that “[t]he interests of justice do not require the

⁵ See *ZTE (USA) Inc. v. Fundamental Innovation Sys. Int’l LLC*, IPR2018-00274, Paper 23, 2–3 (Nov. 15, 2018), which is cited as support by *Petitioner* (Mot. 5), and states that “[the petitioner in that case] received notice from PTAB E2E that no documents were attached to its filing,” specifically “an email notice from the PTAB E2E filing system dated September 28, 2018 captioned ‘Rehearing Request Filed Notice’ and stating that ‘THERE WERE NO DOCUMENTS SUBMITTED WITH THIS REQUEST.’” The petitioner in that case “contend[ed] that its ‘counsel subsequently received a telephone message from the Board indicating that the filing was missing an attachment.’” *Id.* at 2. That message was a second notice to the petitioner.

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Board to fix a problem that was created by Petitioner's own failure to monitor and timely address the errors." Opp. 6 (citing *Nuna Baby Essentials*, IPR2018-01683, Paper 11 at 8 ("We agree with Patent Owner that this issue is of Petitioner's own making. . . . [W]e do not believe that it would be in the interests of justice to excuse Petitioner for the late filing based on the facts presented.")). We do not find that it would be inequitable to deny the motion, as Petitioner urges, where Petitioner delayed almost four months before taking the purportedly prompt action.

Petitioner has not offered any persuasive reason why consideration on the merits of Petitioner's Requests for Rehearing of the denials of institution would be in the interests of justice.

ORDER

For the foregoing reasons, it is

ORDERED that "Petitioner's Motion Under [37 C.F.R. §] 42.5(c)(3)," is *denied*.

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