

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLIR SYSTEMS, INC. and FLIR MARITIME US, INC.
(f/k/a RAYMARINE, INC.),
Petitioners,

v.

GARMIN CORPORATION,
Patent Owner.

Case IPR2018-01490
Patent 6,459,987 B1

Before BARRY L. GROSSMAN, JAMES J. MAYBERRY, and
ERIC C. JESCHKE, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

DECISION

Dismissing Petition Based on Petitioners' Unopposed Motion
35 U.S.C. § 315(b) and 37 C.F.R. § 42.71(a)

INTRODUCTION

On July 31, 2018, FLIR Systems, Inc. and FLIR Maritime US, Inc. (f/k/a Raymarine, Inc.) (collectively, “Petitioners”) filed a Petition to institute an *inter partes* review of claims 7–16 of U.S. Patent No. 6,459,987 B1 (“the ’987 patent”). Paper 1. Garmin Corporation (“Patent Owner”) has not yet filed a Patent Owner’s Preliminary Response¹ and the Board has not instituted *inter partes* review in this proceeding.

On October 5, 2018, with the Board’s prior authorization (Ex. 3001, 1), Petitioners filed an “Unopposed Motion to Dismiss IPR Under 35 U.S.C. § 315(b).” Paper 6 (the “Motion” or “Mot.”); *see also* Ex. 3001, 2 (“Patent Owner has indicated that it does not oppose this motion.”). Upon consideration of the arguments presented and for the reasons below, we *grant* the Motion and *dismiss* the Petition.

DISCUSSION

In two separate complaints, Patent Owner accused at least one of Petitioners of infringing the ’987 patent. Mot. 1. The earlier complaint, filed in the United States District Court for the District of Kansas, was served on December 14, 2016. *Id.*; *see also* Summons in a Civil Action, *Garmin Switzerland GmbH v. FLIR Maritime US, Inc.*, No. 2:16-cv-02806-JWL-JPO (D. Kan. Dec. 19, 2016), ECF No. 4. The complaint in the Kansas Action was voluntarily dismissed without prejudice. Ex. 1008. The later

¹ Any Patent Owner’s Preliminary Response filed would not be due until November 23, 2018. Further, under our rules, filing a Preliminary Response is optional. *See* 37 C.F.R. § 42.107 (“The patent owner *may* file a preliminary response to the petition.” (emphasis added)).

complaint, filed in the United States District Court for the District of Oregon, was served on August 1, 2017. Mot. 1; *see also* Summons in a Civil Action, *Garmin Switzerland GmbH v. FLIR Systems, Inc.*, No. 3:17-cv-01147-SB (D. Or. Aug. 9, 2017), ECF No. 26.

The Board may not institute an *inter partes* review based on a petition “filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement.” 35 U.S.C. § 315(b). In the Petition here, Petitioners discussed the complaints in the Kansas and Oregon Actions, and asserted that the Petition was *not* time-barred based on service of the complaint in the Kansas Action under the Board’s precedential decision in *Oracle Corp. v. Click-to-Call Techs. LP*, IPR2013-00312, Paper 26 (PTAB Oct. 30, 2013) (precedential as to § III.A). *See* Paper 1, 1–2. In that decision, the Board held that a voluntary dismissal without prejudice “nullifies the effect of the service of the complaint and, as a consequence, does not bar [a petitioner] from pursuing an *inter partes* review.” *Oracle Corp.*, Paper 26, at 17.

A few weeks after the filing of the Petition in this proceeding, the Federal Circuit issued a decision in *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018) (en banc in part). The en banc Federal Circuit held that the time bar under 35 U.S.C. § 315(b) “applies to bar institution when an IPR petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice.” *Click-to-Call*, 899 F.3d at 1328 n.3. Based on the timings of the filings in that case, the Federal Circuit determined that the petition was time-barred under § 315(b). *Id.* at 1325. Given the time bar,

the Federal Circuit determined that the Board had “lacked jurisdiction to institute the IPR proceedings,” then the Federal Circuit vacated the final written decision and remanded to the Board with instructions to dismiss. *Id.*

We agree with Petitioners that, under the Federal Circuit’s decision in *Click-to-Call*, because the date of service of the complaint in the Kansas Action (December 14, 2016) is more than one year before the filing date of the Petition in this proceeding (July 31, 2018), the Petition is time-barred under § 315(b). *See* Mot. 3.

Accordingly, we grant the Motion and dismiss the Petition. *See Click-to-Call*, 899 F.3d at 1325; *see also* 37 C.F.R. § 42.71(a) (“The Board may take up petitions or motions for decisions in any order, may grant, deny, or *dismiss any petition* or motion, and may enter any appropriate order.” (emphasis added)).

ORDER

Accordingly, it is hereby:

ORDERED that Petitioners’ Unopposed Motion to Dismiss under 35 U.S.C. § 315(b) is *granted*; and

FURTHER ORDERED that the Petition is *dismissed*.

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