Paper No.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLIR SYSTEMS, INC.,
FLIR MARITIME US, INC. (F/K/A RAYMARINE, INC.), and
NAVICO, INC.,

Petitioners,

v.

GARMIN SWITZERLAND GmbH,

Patent Owner.

Case IPR2017-00946

Patent 7,268,703 B1[1]

PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO AMEND UNDER 37 C.F.R. § 42.121

[1] Navico, Inc. was joined as a party to this proceeding via a Motion for Joinder in IPR2017-02051.

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TABLE OF ABBREVIATIONS

703 patent	U.S. Patent No. 7,268,703 B1
Petition	FLIR Systems, Inc. and FLIR Maritime US, Inc.'s Petition for *Inter Partes* Review filed February 17, 2017
POR	Garmin's Patent Owner Response, filed November 15, 2017
MTA	Garmin's Motion to Amend Under 37 C.F.R. § 42.121, filed November 15, 2017
De Jong	Ex. 1005: W.J. de Jong, *Automated Route Planning – A Network-Based Route Planning Solution for Marine Navigation*, University of Nottingham (December 2001)
Tetley	Ex. 1006: Tetley et al., *Electronic Navigation Systems*, 3d. Ed. (Butterworth-Heinemann 2001) (excerpts)
POSITA	"Person of Ordinary Skill in the Art"
Emphasis	All emphasis added unless otherwise stated

I. INTRODUCTION

Recognizing the issues it faces with respect to the issued claims, Garmin has contingently moved to amend ("MTA") the independent claims of the 703 patent. As explained herein, Garmin's proposed amendments do nothing to correct the fatal deficiencies in the existing claims, and thus its motion should be denied.

Garmin contends that the proposed claims are patentable because they now explicitly require: (1) a "marine navigational device," coupled with Garmin's proposed construction of "navigation" (the "process of planning a course and *directing a craft or vehicle along the course* from one place to another"); and (2) *both* "routing" and "re-routing" steps. Garmin alleges that these limitations are missing from the prior art.

As explained herein, that is demonstrably not the case, as the proposed claims are plainly obvious under 35 U.S.C. § 103 based on the unchallenged prior art of record, de Jong (Ex. 1005) and Tetley (Ex. 1006). First, marine navigational devices that both planned a course *and* "directed a craft along the course" are ubiquitous in the prior art. Tetley discloses numerous examples, including Garmin's own GPSMap 215/225 product. The manual for that product (Ex. 1033) explicitly discloses a "marine navigational device" as Garmin construes it. Garmin did not in its MTA bring its manuals to the Board's attention, and failed to address the teachings in Tetley. Second, Garmin's attempt to break the "marine route

calculation algorithm" into distinct "routing" and "re-routing" steps is futile, because there can be no doubt that de Jong discloses precisely that same combination of steps. *See* pp. 14-16, *infra*.

Garmin's MTA also fails because the proposed claims violate 35 U.S.C. § 112, ¶¶ 1, 2. The claims are indefinite because they require "navigating the user," which is a nonsensical limitation in the field of vehicle navigation science. *Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 781 (Fed. Cir. 2010). And the claims do not comply with the written description requirement because Garmin failed to show written description support for the "entire proposed substitute claim" as it was required to do. Doc. 14 at 4.

II. BACKGROUND OF THE 703 PATENT AND PRIOR ART

Garmin's representation that the proposed amendments "distinguish the current invention, as claimed, from the art cited in the present IPR and art known to Patent Owner," MTA at 3, is demonstrably false.

The 703 patent file history shows that the claims were allowed only after Garmin added the limitation that required the "marine route calculation algorithm" to identify "one or more non-user selected waypoints." Ex. 1002.257-.281. It was solely this limitation – non-user selected waypoints – that convinced the Examiner to allow the challenged claims. Ex.-1002.011-12. In fact, Garmin told a district court that non-user selected waypoints was a "critical[]" limitation in the claims.

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