

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 IPR2017-00946¹
Patent No. 7,268,703 B1

**JOINT MOTION BY PETITIONER NAVICO, INC. AND PATENT
OWNER TO TERMINATE PETITIONER NAVICO, INC. PURSUANT TO
35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

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

LEGAL02/34732009v1

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Navico Inc. (“Navico”) and Patent Owner Garmin Switzerland GmbH (“Garmin”) jointly request termination of the *inter partes* review of U.S. Patent No. 7,268,703, Case No. IPR2017-00946 with respect to Petitioner, Navico, Inc. Navico was joined as a party to IPR2017-00946 pursuant to the Board’s Decision (Paper 8) in IPR2017-02051. Patent Owner acknowledges that the IPR will continue with respect to Petitioner FLIR Systems, Inc. and FLIR Maritime US, Inc. On February 14, 2018, the Board authorized the parties to file this Joint Request.

I. Termination of Case No. IPR2017-00946 With Respect to Petitioner Navico, Inc. Would Be Appropriate.

Termination of Case No. IPR2017-00946 with respect to the Petitioner Navico, Inc. by the PTAB is appropriate. The parties have executed a settlement agreement that resolves all of their disputes concerning U.S. Patent No. 7,268,703—expressly including the present IPR. This case is at a sufficiently early stage of the trial, and no motions or petitions are outstanding in this case, other than Patent Owner’s Motion to Amend (Paper 15). Further, the parties entered into a Confidential Settlement and Patent License Agreement (the “Agreement,” attached hereto as Exhibit 2006). The Agreement requires both parties to terminate all disputes, including *Inter Partes* Review

Proceeding No. 2017-00946 and *Garmin Switzerland GmbH, et al. v. Navico, Inc., et al.*, Case No. 2:16-cv-2706 (D. Kan.). Therefore, termination of this IPR with respect to Petitioner Navico, Inc. is appropriate because (i) the IPR is at a sufficiently early stage of the trial, (ii) the parties have settled their disputes, (iii) Patent Owner has agreed to dismiss the related litigation, and (iv) the parties to this IPR agree that this *inter partes* review should be terminated with respect to Petitioner Navico, Inc.

As set forth in 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the Agreement between Navico and Garmin has been made in writing, and a true and correct copy is being filed with the Patent Office as Exhibit 2006 to this Joint Motion. The parties represent that there are no collateral agreements, understandings, or other agreements between the parties made in connection with, or in contemplation of, the termination of the present proceeding, and that Ex. 2006 represents a true and accurate copy of the agreement between the parties that resolves this proceeding. As stated in 35 U.S.C. § 317(a), because Navico and Garmin request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach as to Petitioner Navico. Further, a joint request to treat the Agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is filed concurrently herewith.

Therefore, Navico and Garmin respectfully request termination of the *inter partes* review of U.S. Patent No. 7,268,703, Case No. IPR2017-00946 with respect to Petitioner Navico, Inc.

February 16, 2018

Respectfully Submitted,

By: /s/ Heath J. Brigg

Heath J. Brigg (Reg. No. 54,919)
William M. Fisher (Reg. No. 63,255)
GREENBERG TRAUIG, LLP
1200 17th Street, Suite 2400
Denver, CO 80202
Telephone: (303) 572-6500
Facsimile: (303) 572-6540
Navico-IPRs@gtlaw.com

Joshua L. Raskin (Reg. No. 40,135)
GREENBERG TRAUIG, LLP
MetLife Building
200 Park Avenue
New York, NY 10166
Telephone: (212) 801-6930
Navico-IPRs@gtlaw.com

Attorneys for Petitioner Navico, Inc.

By /s/ Jennifer C. Bailey

Jennifer C. Bailey, Reg. No. 52,583
Adam P. Seitz, Reg. No. 52,206
ERISE IP, P.A
6201 College Boulevard, Suite 300
Overland Park, Kansas 66211
Telephone: (913) 777-5600
Facsimile: (913) 777-5601
Jennifer.Bailey@eriseip.com
Adam.Seitz@eriseip.com
PTAB@eriseip.com

Attorneys for Patent Owner

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.