

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RUIZ FOOD PRODUCTS, INC.,
Petitioner,

v.

MACROPOINT LLC,
Patent Owner.

IPR2017-02016 (Patent 8,275,358 B1)
IPR2017-02018 (Patent 9,429,659 B1)

Before MEREDITH C. PETRAVICK, TREVOR M. JEFFERSON, and
NATHAN A. ENGELS, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

IPR2017-02016 (Patent 8,275,358 B1)

IPR2017-02018 (Patent 9,429,659 B1)

In a telephone conference between the parties and the Board on September 21, 2018, Patent Owner requested leave to file motions to dismiss these proceedings in light of *Click-to-Call Techs., LP v. Ingenio, Inc.*, No. 2015-01242 (Fed. Cir. Aug. 16, 2018) (en banc in relevant part) and relevant facts. Citing Petitioner’s identification of FourKites, Inc. as a real party in interest (IPR2017-02016 Paper 2, p. 3; IPR2017-02018, Paper 2, pp. 3–4) and a complaint for declaratory judgment of invalidity filed by FourKites, Inc., *FourKites, Inc. v. MacroPoint, LLC*, No. 1:16-cv-02703-CAB (N.D. Ohio), Patent Owner contends that the holding of *Click-to-Call* applies to the facts of these proceedings such that 35 U.S.C. § 315(a)(1) bars Petitioner from pursuing *inter partes* review of the challenged patents.

Section 315(a)(1) states that “[a]n *inter partes* review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.” In the Petition, Petitioner contends that FourKites, Inc.’s declaratory-judgment complaint does not bar *inter partes* review because the complaint was dismissed without prejudice and dismissal without prejudice nullifies the effect of the service of the complaint.

IPR2017-02016 Paper 2, 5–6 (citing *Oral Corp. et al. v. Click-to-Call Tech. LP*, IPR2013-00312, Paper 26, 17 (PTAB Oct. 30, 2013) (precedential)).

The Federal Circuit’s decision in *Click-to-Call* addressed the time bar of 35 U.S.C § 315(b) as it applies to service of a complaint for infringement that was subsequently dismissed without prejudice. In light of the Federal Circuit’s decision in *Click-to-Call*, additional briefing on whether the time bar of 35 U.S.C. § 315(a)(1) applies to these proceedings is warranted. *See* 37 C.F.R. § 42.104(a).

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It is:

ORDERED that Patent Owner is authorized to file a motion to dismiss limited to addressing the time bar of 35 U.S.C. § 315(a) and limited to 15 pages, no later than September 28, 2018;

FURTHER ORDERED that Petitioner is authorized to file an opposition to the motion to dismiss, limited to 15 pages, no later than October 10, 2018;

FURTHER ORDERED that Patent Owner is authorized to file a reply, limited to 5 pages, no later than October 17, 2018; and

FURTHER ORDERED that Patent Owner will file a transcript of the September 21, 2018 telephone conference as an exhibit in these proceedings.

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