

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RUIZ FOOD PRODUCTS, INC.,

Petitioner,

v.

MACROPOINT LLC,

Patent Owner.

Case IPR2017-02018
U.S. Patent No. 9,429,659

MOTION TO DISMISS

UPDATED LIST OF EXHIBITS

<u>Exhibit No.</u>	<u>Description</u>
2001	Expert Declaration of David Hilliard Williams
2002	David Hilliard Williams CV
2003	“What are the differences in the technical specifications in the 1988 automatic onboard recording device (AOBRD) Rule (49 CFR 395.15) and the Electronic Logging Device (ELD) rule?”, https://www.fmcsa.dot.gov/faq/what-are-differences-specs-1988-aobrd-rule-and-eld-rule
2004	“ELD MANDATE: UPDATES, VIOLATION INFORMATION AND DEVICE INTRODUCTION PRICING & REVIEWS DRIVERS NEED TO KNOW,” https://unitedworldtransportation.com/eld-mandate-updates-violation-information-device-introduction-pricing-reviews-drivers-need-know/
2005	“Automatic On-Board Recording Devices (AOBRDs) Hand-Held, Commercial Vehicle Safety Alliance, June 6, 2012, http://www.ct.gov/dmv/lib/dmv/cv_bulletins/2012-05-automatic-on-board-recording-devices-aobrds-hand-held-created-06-06-12.pdf
2006	“Small Hardware Device Provides GPS Fleet Tracking Capabilities,” Fleet Financials, October 14, 2010, https://www.fleetfinancials.com/72619/small-hardware-device-provides-gps-fleet-tracking-capabilities
2007	“A Look at the Geotab GO Device: Past, Present, and Future,” Malene Johansen & Vincent Zhu, June 22, 2015, https://www.geotab.com/blog/geotab-go-device-past-present-future/
2008	“Announcing Geotab GO5 Premium Vehicle Tracking Device,” April 5, 2011, https://www.geotab.com/press-release/u-blox/
2009	“FMCSA Implementation of MAP-21,” Federal Motor Carrier Safety Administration, September 28, 2012, https://www.fmcsa.dot.gov/sites/fmcsa.dot.gov/files/docs/FMCSA%20Implementation%20of%20MAP-21-%20Overview-Agenda-Qs%209-28-12.pdf

<u>Exhibit No.</u>	<u>Description</u>
2010	“The Future of Electronic On-board Recording Devices in the U.S.,” Michael Goldberg, July 3, 2011, https://www.frg-law.com/blog/the-future-of-electronic-on-board-recording-devices-in-the-u-s/
2011	Declaration of Kyle B Fleming, Esq.
2012	Kyle B. Fleming CV
2013	Complaint filed in <i>FourKites, Inc. v MacroPoint, LLC</i> , Case No. 1:16-cv-02703-CAB (N.D. Ohio)

Petitioner lacks standing and is barred from bringing and maintaining this proceeding under 35 U.S.C. § 315(a)(1) because a Real Party In Interest, FourKites, Inc., filed an action challenging the validity of the claims of the '659 Patent prior to the filing of the petition. Board precedent had previously held that a prior action is not a bar under § 315 if it is voluntarily dismissed without prejudice before the Petition is filed. However, a recent Federal Circuit decision *en banc* reversed this PTAB precedent and held that a prior civil action, even if voluntarily dismissed without prejudice, triggers the standing bars of § 315.

Accordingly, Petitioner lacks standing and the Board lacks jurisdiction, and therefore this proceeding must be dismissed.

I. BACKGROUND

Petitioner Ruiz Food Products, Inc. filed the instant Petition on August 31, 2017. Paper 2 (“Petition”). Petitioner identified FourKites, Inc. as an additional Real Party In Interest. *Id.* at 3-4.

Petitioner further disclosed that the '659 Patent was the subject of prior, related proceedings, including an action for declaratory judgment of invalidity filed by FourKites on November 4, 2016, *FourKites, Inc. v MacroPoint, LLC*, Case No. 1:16-cv-02703-CAB (N.D. Ohio). *Id.* A copy of the Complaint from this action is submitted as Ex. 2013. Count II challenged the validity of all claims of the '659 Patent, and specifically alleged:

58. The claims of the '659 patent are invalid for failure to comply with the requirements of patentability specified in Title 35 of the United States Code, including but not limited to 35 U.S.C. §§ 101, 102, 103, 112, 116 and/or 120, and/or based on other judicially-created bases for invalidation.

Ex. 2013 at 16.

Despite this previously filed declaratory judgment action challenging the validity of the '659 Patent, Petitioner argued that it was not barred from filing the Petition under Board precedent because the earlier action had been voluntarily dismissed prior to the filing of the Petition:

As such, the dismissal without prejudice of the declaratory judgment “nullifies the effect of the service of the complaint and, as a consequence, does not bar” Petitioner from pursuing this IPR under 35 U.S.C. § 315(a)(1). *Oracle Corp. et al. v Click-to-Call Tech. LP*, IPR 2013-00312, Paper #26 at 17 (PTAB Oct. 30, 2013) (Precedential).

Petition at 7.

On August 16, 2018, the Federal Circuit *en banc* vacated the Board's precedent on this issue and remanded IPR2013-00312 for dismissal, holding that the Board “committed legal error” in concluding that the petition was not time-barred by a prior, voluntarily dismissed action. *Click-to-Call Tech, LP. v. Ingenio, Inc.*, —F. 3d—, Case No. 20-1242 (Fed. Cir. August 16, 2018) (*en banc*). Notably, the order vacated by the Federal Circuit is the same authority upon which Petitioner relied as supporting its claim that it was not barred from pursuing a

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