

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NAVICO, INC.,
Petitioner,

v.

GARMIN SWITZERLAND GmbH,
Patent Owner.

Case IPR2017-02051
Patent 7,268,703 B1

Before JUSTIN T. ARBES, THOMAS L. GIANNETTI, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

On August 10, 2017, we instituted an *inter partes* review of claims 1–7, 12–23, 25–29, and 41–45 of U.S. Patent No. 7,268,703 B1 (Ex. 1001, “the ’703 patent”). *FLIR Sys., Inc. v. Garmin Switzerland GmbH*, Case IPR2017-00946 (PTAB Aug. 10, 2017) (Paper 7) (“the FLIR IPR”). Trial in that matter is pending on the following grounds of unpatentability:

1. Whether claims 1, 7, 12, 19, 27, and 28 are unpatentable under 35 U.S.C. § 102(b) as anticipated by de Jong;¹ and
2. Whether claims 2–6, 13–18, 20–23, 25, 26, 29, and 41–45 are unpatentable under 35 U.S.C. § 103(a) as unpatentable over de Jong and Tetley.²

An additional Petition has now been filed with the Board seeking joinder with the FLIR IPR. Specifically, in IPR2017-02051, Navico, Inc. (“Navico”) filed a Petition requesting *inter partes* review of claims 1–7, 12–23, 25–29, and 41–45 of the ’703 patent. Paper 1. Concurrently with its Petition, Navico filed a Motion for Joinder (Paper 3), seeking joinder with the FLIR IPR. The owner of the ’703 patent, Garmin Switzerland GmbH (“Garmin”), filed an Opposition to Petitioner’s Motion for Joinder. Paper 7. Navico did not file a reply brief in support of the Motion for Joinder and Garmin did not file a Preliminary Response.

¹ W.J. de Jong, *Automated Route Planning – A Network-Based Route Planning Solution for Marine Navigation*, University of Nottingham (December 2001) (Ex. 1005, “de Jong”).

² Tetley *et al.*, *ELECTRONIC NAVIGATION SYSTEMS* (3d ed. Butterworth-Heinemann 2001) (Ex. 1006, “Tetley”).

The instant Petition asserts the same grounds of unpatentability as those on which trial was instituted in the FLIR IPR. *Compare* IPR2017-00946, Paper 7, *with* Paper 1.

As a threshold matter, we determine that the Motion for Joinder was timely. Our Rules provide that a request for joinder must be filed “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). The Motion was filed on September 7, 2017, more than one month after the August 10, 2017 institution date of the FLIR IPR, and is thus timely.

For the reasons explained below, we grant the Motion.

II. THE PETITION WARRANTS INSTITUTION

The controlling statute regarding joinder of a party to an *inter partes* review is 35 U.S.C. § 315(c), which reads as follows:

(c) JOINDER.--If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

The statute makes clear that joinder of a party to an instituted *inter partes* review is within the Board’s³ discretion. That discretion may only be exercised, however, if the party seeking joinder “files a petition . . . that the Director . . . determines warrants the institution of an *inter partes* review.”

³ By regulation, the Director’s discretion has been delegated to the Board. 37 C.F.R. § 42.4(a).

35 U.S.C. § 315(c). As a threshold issue, therefore, we must first determine whether the instant Petition warrants institution of an *inter partes* review.

The grounds of unpatentability asserted in the instant Petition are identical to those instituted in the FLIR IPR. Navico states that its Petition includes the same grounds and arguments as those in the FLIR IPR, and notes that it relies on the same declarant, Michael S. Braasch, Ph.D., as FLIR does. Paper 3, 4 (“The Navico Petition is substantively identical to the FLIR Petition, containing only minor differences related to formalities of a different party filing the petition, and noting Petitioner Navico’s current agreement with the Board on claim construction.”); *compare* Ex. 1003 with IPR2017-00946, Ex. 1003. Garmin did not file a Preliminary Response arguing the merits of the asserted grounds of unpatentability.

We previously determined, upon consideration of the Petition and Garmin’s Preliminary Response in the FLIR IPR, that the record in that proceeding established a reasonable likelihood that FLIR would prevail with respect to claims 1–7, 12–23, 25–29, and 41–45. IPR2017-00946, Paper 7, 33. Given the identical grounds and evidence presented in the present proceeding, we likewise determine that the instant Petition warrants institution on all presented grounds. We rely on, and hereby incorporate by reference, the reasoning set forth in our Decision on Institution in the FLIR IPR. *See id.* at 6–33.

III. DISCRETION TO GRANT JOINDER

Having determined that the instant Petition warrants institution, we must determine whether to exercise our discretion to join Navico as a party to the FLIR IPR. As the moving party, Navico bears the burden of showing that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for

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joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability; (3) explain what impact (if any) joinder would have on the trial schedule; and (4) address specifically how briefing and discovery may be simplified. *See* Paper 3, 2–3; *Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00495, slip op. at 3 (PTAB Sept. 16, 2013) (Paper 13); *Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative).

As discussed above, the instant Petition asserts the same grounds of unpatentability as those instituted in the FLIR IPR and does not present any argument beyond those already at issue in the FLIR IPR. Furthermore, if joinder is granted, Navico proposes to take an “understudy” role in the joined proceeding so long as FLIR remains an active party, and will consolidate filings and discovery. Paper 3, 6–8. Specifically, Navico states that

(a) *all* filings by [Petitioner] in the joined proceeding be consolidated with [the filings of the petitioner in the FLIR IPR], unless a filing solely concerns issues that do not involve [the petitioner in the FLIR IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [FLIR IPR], or introduce any argument or discovery not already introduced by [the petitioner in the FLIR IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the FLIR IPR] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross examination or redirect time beyond that permitted for [the petitioner in the FLIR IPR] alone under either []37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the FLIR IPR].

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