

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NAVICO, INC.,
Petitioner,

v.

GARMIN SWITZERLAND GmbH,
Patent Owner.

Patent No. 7,268,703 B1

Issued: September 11, 2007

Filed: September 18, 2003

Inventors: Darrin W. Kabel, Steven J. Myers

Title: METHODS, SYSTEMS, AND DEVICES FOR CARTOGRAPHIC
ALERTS

Inter Partes Review No. IPR2017-02051

**MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 and 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2017-00946**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Navico, Inc. (“Petitioner”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 7,268,703 (“the Navico Petition”) filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *FLIR Systems, Inc. and FLIR Maritime US, Inc. (f/k/a Raymarine, Inc.) v. Garmin Switzerland GmbH*, IPR2017-00946 (“the FLIR IPR”), which the Patent Trial and Appeal Board (the “Board”) instituted on August 10, 2017. Petitioner’s request for joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b) as it submitted no later than one month after the August 10, 2017 institution date of the FLIR IPR. The Navico Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the FLIR IPR. In addition, Petitioner is willing to streamline discovery and briefing. Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the FLIR IPR while efficiently resolving the question of the ’703 Patent’s validity in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. Garmin Switzerland GmbH and Garmin Corp. (collectively “Garmin” or “Patent Owner”) filed civil actions against Navico, Inc., Case No. 2:16-cv-02706, in the U.S. District Court for the District of Kansas, on October 17, 2016, FLIR Maritime

U.S., Inc. (f/k/a Raymarine, Inc.), Case No. 2:16-cv-02806, in the U.S. District Court for the District of Kansas, on December 12, 2016, and FLIR Systems, Inc. and FLIR Maritime US, Inc. (f/k/a Raymarine, Inc.) (collectively “FLIR”), Case No. 3:17-cv-01147, in the U.S. District Court for the District of Oregon, on July 24, 2017.

2. On February 17, 2017, FLIR filed a petition for *inter partes* review (IPR2017-00946) requesting cancellation of claims 1-7, 12-23, 25-29, and 41-45 of the '703 Patent.

3. On August 10, 2017, the Board instituted FLIR's petition for *inter partes* review on all proposed grounds, finding that a reasonable likelihood existed that FLIR's petition for *inter partes* review would prevail in showing unpatentability of claims 1-7, 12-23, 25-29, and 41-45 of the '703 Patent. *See* IPR2017-00946, Decision Instituting IPR Review, Paper No. 7 at 33-34.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any

new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corporation v. Softview LLC*, IPR2013- 00004, Paper 15 at 4 (April 24, 2013).

B. Petitioner’s Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the August 10, 2017 institution decision of the FLIR IPR. *See* 37 C.F.R. § 42.122(b). Further, the one-year bar set forth in 37 C.F.R. § 42.101(b) does not apply to the Navico Petition because this Motion for Joinder is filed concurrently with the Navico Petition. 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the Navico Petition does not present any new grounds of unpatentability; rather it is substantively identical to the FLIR Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an “understudy” role. *See* IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, paper 11 at 6; (granting IPR where petitioners requested an “understudy” role); *see also* IPR2015-01353, Motion for Joinder, paper 4 at 5-7. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

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