

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC.,  
Petitioner,

v.

CHRIMAR SYSTEMS, INC.,  
Patent Owner.

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Case IPR2018-01508  
Patent 8,155,012 B2

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**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION  
FOR *INTER PARTES* REVIEW UNDER 37 C.F.R. § 42.107**

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<b>Exhibit No.</b>	<b>Description</b>
2001	Petitioner's Complaint challenging the validity of '012 patent claims
2002	Order Temporarily Staying Case
2003	Notice of Voluntary Dismissal

## **I. Introduction**

Pursuant to 37 C.F.R. § 42.107, Patent Owner, Chrimar Systems, Inc. (“Chrimar”), submits the following Preliminary Response (“Preliminary Response”) to the Petition for *Inter Partes* Review of U.S. Patent No. 8,155,012 B2 (“the ‘012 Patent”).

Patent Owner respectfully asks the Patent Trial and Appeal Board (“the Board”) deny the Petition on every ground alleged by the Petitioner.

## **II. The Statute, 35 U.S.C. § 315(a)(1), Bars Petitioner’s IPR Request**

Per 35 U.S.C. § 315(a)(1): “An 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 present proceeding, the Petitioner filed a civil action challenging the validity of a claim ‘012 Patent in 2014, long before the date (August 3, 2018) on which it filed the petition for review. (Ex. 2001, ¶¶4-5, 60-65.) As a matter of law, therefore, “inter partes review may not be instituted.” 35 U.S.C. § 315(a)(1).

Petitioner contends that § 315(a)(1) does not apply, despite its plain language, because Petitioner “voluntarily dismissed the March 2015 [*sic*] action.” (Pet. at 8.) But, as the Federal Circuit has made clear in two recent cases, voluntary dismissal of a civil action does not toll a § 315 bar date. *Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.*, 905 F.3d 1311, 1314-15 (Fed.

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