

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CISCO SYSTEMS, INC.,  
Petitioner,

v.

CHRIMAR SYSTEMS, INC.  
Patent Owner.

---

U.S. Patent No. 8,902,760

Case No.: IPR2018-01511

---

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

**Table of Contents**

Table of Authorities ..... ii  
List of Exhibits ..... iii  
I. Introduction.....1  
II. The Statute, 35 U.S.C. § 315(a)(1), Bars Petitioner’s IPR Request.....1  
III. Conclusion .....5

**Table of Authorities**

**Cases**

*Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.*,  
905 F.3d 1311 (Fed. Cir. 2018) .....2, 3

*Bonneville Associates, Ltd. Partner-ship v. Barram*,  
165 F.3d 1360 (Fed. Cir. 1999) .....4

*Click-To-Call Techs., LP v. Ingenio, Inc.*,  
899 F.3d 1321 (Fed. Cir. 2018) ..... 2, 3, 4

*Emerson Electric No. v. Sipco, LLC*,  
IPR2015-01579, Paper 7 .....4

*Graves v. Principi*,  
294 F.3d 1350 (Fed. Cir. 2002) .....4

*SAS Inst., Inc. v. Iancu*,  
138 S. Ct. 1348 (2018).....3

**Statutes**

35 U.S.C. § 315 ..... 1, 2, 3, 4

**List of Exhibits**

<b>Exhibit No.</b>	<b>Description</b>
2001	Petitioner's Complaint challenging the validity of '760 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. 8,902,760 (“the ‘760 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 ‘760 Patent in 2015, long before the date (August 3, 2018) on which it filed the petition for review. (Ex. 2001, ¶¶3-4, 76-81.) 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 action.” (Pet. at 7.) 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. Cir. 2018);

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.