

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT PACKARD ENTERPRISE COMPANY,
Petitioner,

v.

CHRIMAR SYSTEMS, INC.,
Patent Owner.

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

Case No.: IPR2019-00033

**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 7
Certificate of Service 8
Certificate of Compliance Pursuant to 37 C.F.R. § 42.24 9

Table of Authorities

Cases

Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.,
905 F.3d 1311 (Fed. Cir. 2018) 1, 4, 5

Click-To-Call Techs., LP v. Ingenio, Inc.,
899 F.3d 1321 (Fed. Cir. 2018) 2, 3, 5, 6

Noven Pharms., Inc. v. Novartis AG,
IPR2014-00549, Paper 10 (PTAB Oct. 14, 2014).....4

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

Statutes

35 U.S.C. § 315 1, 2, 3, 4, 6

List of Exhibits

Exhibit No.	Description
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 of the ‘760 Patent in 2014, long before the date (August 3, 2018) on which it filed the petition for review. (Ex. 2001, ¶¶ 7, 9, 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 [its DJ actions] without prejudice.” (Pet. at 9.) 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); *Click-To-*

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