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Patent Trial and Appeal Board
PRECEDENTIAL
Standard Operating Procedure 2
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Paper 11
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

CHRIMAR SYSTEMS, INC.,
Patent Owner.

Case IPR2018-01511
Patent 8,902,760 B2

Before KARL D. EASTHOM, GREGG I. ANDERSON, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes Review*
35 U.S.C. § 315(a)(1)

I. INTRODUCTION

Cisco Systems, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 73, 106, 112, 134, 142, 145, and 146 (“challenged claims”) of U.S. Patent No. 8,902,760 B2 (Ex. 1004, “the ’760 patent”). Chrimar Systems, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition. Also, as authorized, Petitioner filed a Reply (Paper 8, “Reply”) to the Preliminary Response, and Patent Owner filed a Sur-reply (Paper 9, “Sur-reply”) to the Reply.

An *inter partes* review “may not be instituted if, before the date on which the petition for such review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.” 35 U.S.C. § 315(a)(1). The information presented shows that Petitioner filed a civil action challenging the validity of a claim of the ’760 patent before the date on which the Petition was filed. Therefore, the Petition is denied, and no trial is instituted.

A. *Related Proceedings*

The parties indicate that the ’760 patent is the subject of several cases in the United States District Court for the Eastern District of Michigan, the United States District Court for the Eastern District of Texas, and the United States District Court for the Northern District of California. Pet. 1–5; Paper 5, 1–2. The parties also indicate that the ’760 patent was the subject of Reexamination No. 90/013,802, and the subject of petitions for *inter partes* review in IPR2016-00574, IPR2016-01399, IPR2016-01759, and IPR2017-00719. Pet. 2–3; Paper 5, 2.

B. *The '760 Patent*

The '760 patent relates to a system for managing, tracking, and identifying remotely located electronic equipment. Ex. 1004, 1:27–30. According to the '760 patent, one of the difficulties in managing a computerized office environment is keeping track of a company's electronic assets. *Id.* at 1:32–57. Previous systems for tracking electronic assets suffered from several deficiencies. *Id.* at 1:62–65. For example, previous systems could not determine the connection status or physical location of an asset and could only track assets that were powered-up. *Id.* at 1:65–2:2.

To address these deficiencies, the '760 patent describes a system for tracking an electronic asset. *Id.* at 2:3–6, 3:23–27. In one embodiment described in the '760 patent, the system includes a central module and a remote module. *Id.* at 3:27–30. The remote module attaches to the electronic asset and transmits a low frequency signal. *Id.* A receiver in the central module monitors the signal transmitted by the remote module and determines if the status or location of the electronic asset changes. *Id.* at 3:30–32, 3:34–40.

C. *Illustrative Claim*

Of the challenged claims, claims 73 and 146 are independent. Claim 73, as amended during reexamination, is reproduced below.

73. A BaseT Ethernet system comprising:

Ethernet cabling having at least first and second individual pairs of conductors used to carry BaseT Ethernet communication signals, the at least first and second individual pairs of conductors physically connect between a piece of BaseT Ethernet terminal equipment and a piece of central network equipment,

the piece of central network equipment is a BaseT Ethernet hub;

the piece of central network equipment having at least one DC supply,

the piece of BaseT Ethernet terminal equipment having at least one path to draw different magnitudes of current flow via the at least one DC supply through a loop formed over at least one of the conductors of the first pair of conductors and at least one of the conductors of the second pair of conductors,

the piece of central network equipment to detect at least two different magnitudes of current flow through the loop.

Ex. 1004, 21:37–52; Ex. 1035, 1:23–2:4.

D. Evidence of Record

Petitioner submits the following references and declaration (Pet. 11):

Reference or Declaration	Exhibit No.
Declaration of George Zimmerman (“Zimmerman Declaration”)	Ex. 1001
The Institute of Electrical and Electronics Engineers, Inc., IEEE Standard 802.3u-1995 (1995) (“IEEE 802.3-1995”)	Ex. 1021
The Institute of Electrical and Electronics Engineers, Inc., IEEE Standard 802.3-1993 (1993) (“IEEE 802.3-1993”)	Ex. 1022
Bloch et al., U.S. Patent No. 4,173,714 (issued Nov. 6, 1979) (“Bloch”)	Ex. 1025
Nelson, U.S. Patent No. 4,823,070 (issued Apr. 18, 1989) (“Nelson”)	Ex. 1026
Bulan et al., U.S. Patent No. 5,089,927 (issued Feb. 18, 1992) (“Bulan”)	Ex. 1027
Hunter et al., PCT Publication No. WO 96/23377 (published Aug. 1, 1996) (“Hunter”)	Ex. 1033
Peguiron, Swiss Patent No. CH 643 095 A5 (issued May 15, 1984) (“Peguiron”)	Ex. 1034

E. Asserted Grounds of Unpatentability

Petitioner asserts that the challenged claims are unpatentable on the following grounds (Pet. 11):

Claim(s)	Basis	References
73, 106, 112, 134, 142, and 145	35 U.S.C. § 103	Hunter and Bulan
146	35 U.S.C. § 103	Hunter, Bulan, and Nelson
146	35 U.S.C. § 103	Bloch, IEEE 802.3-1993, IEEE 802.3-1995, and Peguiron

II. ANALYSIS

An *inter partes* review “may not be instituted if, before the date on which the petition for such review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.” 35 U.S.C. § 315(a)(1). Petitioner previously filed a civil action challenging the validity of a claim of the ’760 patent. Pet. 7; Prelim. Resp. 1; Ex. 2001 ¶¶ 3, 4, 76–81. Petitioner argues, though, that § 315(a)(1) does not bar institution of an *inter partes* review because Petitioner voluntarily dismissed its previous civil action without prejudice. Pet. 7 (citing *Emerson Elec. Co. v. SIPCO, LLC*, Case IPR2015-01579, slip op. at 2–3 (PTAB Jan. 14, 2016) (Paper 7)).¹

Section 315(a)(1), titled “Inter Partes Review Barred by Civil Action,” bars institution of an *inter partes* review when a petitioner filed a civil action challenging the validity of a claim of a patent before the date on

¹ In *Emerson*, a panel of the Board held in a non-precedential decision that the § 315(a)(1) bar does not apply when a petitioner dismissed its previous civil action without prejudice because “[f]ederal courts treat a civil action that is dismissed without prejudice as ‘something that de jure never existed.’” *Emerson*, Case IPR2015-01579, slip op. at 2–3 (Paper 7). Subsequently, in *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321, 1328 n.3 (Fed. Cir. 2018) (en banc), the Federal Circuit held that the § 315(b) time bar applies even when a previous civil action was dismissed voluntarily without prejudice. This Decision addresses the § 315(a)(1) bar in light of the Federal Circuit’s discussion of the § 315(b) time bar.

which that petitioner filed a petition requesting an *inter partes* review of that patent. 35 U.S.C. § 315(a)(1). Section 315(a)(1) does not include an exception for a civil action that was dismissed without prejudice. *Id.*; see *Click-to-Call*, 899 F.3d at 1330. And Congress demonstrated that it knew how to provide an exception to a statutory bar by including an exception to the § 315(b) time bar for a joinder request. 35 U.S.C. § 315(b); see *Click-to-Call*, 899 F.3d at 1331. Thus, Congress could have included an exception to the § 315(a)(1) bar for a civil action that was dismissed without prejudice, but did not. 35 U.S.C. § 315(a)(1); see *Click-to-Call*, 899 F.3d at 1331.

Further, the ordinary meanings of the terms “file” and “civil action” show that the phrase “filed a civil action” in § 315(a)(1) applies to a civil action that was dismissed without prejudice. Black’s Law Dictionary defines “file” as “[t]o commence a lawsuit,” and defines “civil action” as “[a]n action brought to enforce, redress, or protect a private or civil right; a noncriminal litigation.” BLACK’S LAW DICTIONARY (10th ed. 2014). These definitions indicate that the § 315(a)(1) bar is implicated once a party commences a noncriminal litigation, irrespective of subsequent events. *Id.*; see *Click-to-Call*, 899 F.3d at 1330.

Petitioner argues that the term “civil action” in § 315(a)(1) requires substantive litigation, i.e., “the pendency of a litigation **where the petitioner actually had a bite at the apple.**” Reply 4–6. Petitioner’s argument is not persuasive. Petitioner addresses the term “civil action” apart from the complete phrase “filed a civil action” in § 315(a)(1). As discussed, the ordinary meaning of the phrase “filed a civil action” only requires that a party commenced a noncriminal litigation, not that the party engaged in any substantive litigation. BLACK’S LAW DICTIONARY (10th ed. 2014).

Petitioner argues that the legislative history indicates that “the clear purpose of [§ 315(a)(1)] is *coordination* of IPR with litigation, and more specifically to prevent a challenger from getting two bites at the invalidity apple, one in a district court ‘civil action’ and a second before the Board.”

Reply 5–6. Petitioner, therefore, contends that the legislative history shows that § 315(a)(1) requires a petitioner to substantively litigate a civil action.

Id. at 6. Petitioner’s argument is not persuasive. The portion of the legislative history cited by Petitioner states that

[t]he 2009 Minority Report also recommended that the bill restrict serial administrative challenges to patents and require coordination of these proceedings with litigation. . . . The present bill does coordinate inter partes and post-grant review with litigation, barring use of these proceedings if the challenger *seeks a declaratory judgment that a patent is invalid*, and setting a time limit for seeking inter partes review if the petitioner or related parties is sued for infringement of the patent.

157 Cong. Rec. S1041 (daily ed. Mar. 1, 2011) (statement of Sen. Kyl) (emphasis added). Thus, the comments relied on by Petitioner indicate that § 315(a)(1) only requires a petitioner to “seek[]” a declaratory judgment, not to substantively litigate the civil action.² *Id.*

Petitioner argues that § 315(a)(1) uses the term “filed,” and that “it is well-settled that the voluntary dismissal of a complaint without prejudice nullifies the act of *filing*.” Reply 6. Petitioner’s argument is not persuasive. “A voluntary dismissal without prejudice only leaves the dismissed action without legal effect for *some* purposes; for many other purposes, the

² Also, the Supreme Court has cautioned against relying on the comments of one Member of Congress. *Garcia v. United States*, 469 U.S. 70, 76 (1984).

dismissed action continues to have legal effect.” *Click-to-Call*, 899 F.3d at 1335. Because the background legal principle relied on by Petitioner is “anything but equivocal,” it does not “transform[] the ordinary meaning of the phrase [‘filed a civil action’] into something else.” *Id.*

Petitioner argues that the purpose of a dismissal without prejudice “is to preserve, rather than eliminate, the ability of the plaintiff to sue the defendant again on the same claim.” Reply 6–7. Petitioner contends that “although *Click-To-Call* found that this anti-preclusion principle had no application to § 315(b), which is essentially a statute of limitations, it is certainly applicable to § 315(a)(1), which is a preclusion statute.” *Id.* at 7. Petitioner’s argument is not persuasive. Petitioner does not explain specifically why its characterization of § 315(a)(1) as “a preclusion statute” warrants a departure from the ordinary meaning of the statutory language discussed above. *See id.* at 6–7. Further, this Decision does not hold that § 315(a)(1) bars Petitioner from filing another civil action challenging the validity of a claim of the ’760 patent.

For these reasons, § 315(a)(1) bars institution of an *inter partes* review even though Petitioner voluntarily dismissed its earlier civil action challenging the validity of a claim of the ’760 patent without prejudice.

III. CONCLUSION

The information presented shows that Petitioner filed a civil action challenging the validity of a claim of the ’760 patent before the date on which Petitioner filed the Petition. Therefore, the Petition is denied under § 315(a)(1).

IV. ORDER

In consideration of the foregoing, it is hereby
ORDERED that the Petition is denied, and no trial is instituted.

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