

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,

v.

NIAZI LICENSING CORPORATION,
Patent Owner.

Case IPR2018-01495
Patent 6,638,268 B2

Before JAMES A. TARTAL, GEORGE R. HOSKINS, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

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

I. INTRODUCTION

Medtronic, Inc. (“Petitioner”) has filed a Petition (Paper 1, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 15 and 27 of U.S. Patent No. 6,638,268 B2 (“the ’268 patent”). Niazi Licensing Corporation (“Patent Owner”) has filed a Preliminary Response (Paper 6, “Prelim. Resp.”). For the reasons provided below, we determine the Petition is time-barred pursuant to 35 U.S.C. § 315(b). Accordingly, we do not institute review in this proceeding.

II. STATEMENT OF LAW

“An *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b).

On August 16, 2018, in *Click-to-Call Technologies, LP v. Ingenio, Inc.*, 899 F.3d 1321, 1328–36 (Fed. Cir. 2018) (en banc in relevant part), the court held the time bar of § 315(b) “applies to bar institution when an IPR petitioner was served with a complaint for patent infringement more than one year before filing its petition, but the district court action in which the petitioner was so served was voluntarily dismissed without prejudice.” *Id.* at 1328 n.3. That holding applies to both voluntary, and involuntary, dismissals without prejudice. *Bennett Regulator Guards, Inc. v. Atlanta Gas Light Co.*, 905 F.3d 1311, 1314–15 (Fed. Cir. 2018).

Prior to the Federal Circuit’s holding in *Click-to-Call v. Ingenio*, the Board had routinely held the time bar of § 315(b) does not apply to complaints that are dismissed without prejudice. This is exemplified by the

Board’s decision initially instituting review in the proceeding that eventually led to the Federal Circuit’s *Click-to-Call v. Ingenio* decision, and which the Board had designated as precedential in that specific regard. *See Oracle Corp. v. Click-to-Call Technologies LP*, IPR2013-00312, Paper 26 (PTAB Oct. 30, 2013) (designated precedential as to Section III.A). Petitioner cites the Board’s *Oracle v. Click-to-Call* decision in support of contending that the dismissal of a patent infringement complaint without prejudice “nullifies the effect of service of the complaint” under § 315(b). Pet. 4 n.2. However, the Federal Circuit’s *Click-to-Call v. Ingenio* decision conclusively establishes that the Board’s prior application of § 315(b), as exemplified by the Board’s *Oracle v. Click-to-Call* decision, was not correct in this regard. *See Click-to-Call v. Ingenio*, 899 F.3d at 1332–36 (specifically addressing the Board’s *Oracle v. Click-to-Call* decision).

III. FACTUAL BACKGROUND

On April 13, 2017, Imran Niazi filed a complaint against Petitioner asserting infringement of the ’268 patent, in the United States District Court for the Western District of Wisconsin, captioned *Niazi v. Medtronic, Inc.*, Case No. 3:17-cv-00283. *See* Pet. 2–3; Prelim. Resp. 1; Ex. 2001 (hereafter “the Complaint”).

On April 24, 2017, the Complaint was served on Petitioner. *See* Prelim. Resp. 1, 3; Ex. 2002 (“Proof of Service” executed by Jim Sutcliffe). While the Preliminary Response suggests service was made on April 17 (*see* Prelim. Resp. 1, 3), the evidence indicates service was made on April 24 (*see* Exhibit 2002, 2). This difference is not material to the conclusion we reach below.

On November 7, 2017, the Complaint was dismissed without prejudice. *See* Pet. 2–3, 4 n.2; Prelim. Resp. 2; Ex. 2005 (District Court Order granting Motion to Dismiss for improper venue, without prejudice to refile a complaint in a district where venue is proper).

On August 1, 2018, the present Petition was filed. *See* Paper 3 (“Notice of Filing Date Accorded to Petition”).

IV. ANALYSIS

Pursuant to 35 U.S.C. § 315(b), Petitioner was required to file any Petition(s) challenging the ’268 patent within one year of April 24, 2017, the date the Complaint was served on Petitioner. The present Petition was filed on August 1, 2018, more than one year after April 24, 2017. Therefore, the Petition was not timely filed under § 315(b).

V. RELATED PROCEEDINGS

Petitioner has also filed two earlier petitions challenging the ’268 patent, in IPR2018-00609 and IPR2018-00610, both challenging claims 1, 10, 11–14, 18, 19, and 23–26, whereas the present Petition challenges claims 15 and 27. Those two earlier petitions were both filed on February 12, 2018. *See* IPR2018-00609, Paper 3; IPR2018-00610, Paper 3. That filing date is within one year of April 24, 2017, so the two earlier petitions were timely filed under § 315(b).

VI. CONCLUSION

For the above reasons, we determine the Petition is time-barred pursuant to 35 U.S.C. § 315(b), so we do not institute review in this proceeding.

VII. ORDER

In consideration of the foregoing, it is hereby:
ORDERED that the Petition is denied.

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