NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

VOLTSTAR TECHNOLOGIES, INC.,
Appellant

v.

SUPERIOR COMMUNICATIONS, INC.,
Appellee

2018-2093

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2017-00067.

ON MOTION

Before DYK, REYNA, and TARANTO, *Circuit Judges.*

TARANTO, *Circuit Judge.*

ORDER

(Filed Nov. 6, 2018)

Voltstar Technologies, Inc. moves to vacate the final decision of the Patent Trial and Appeal Board and remand to the Board for it to dismiss the underlying

inter partes review (IPR) for lack of jurisdiction. Superior Communications, Inc. opposes the motion.

In February 2013, Superior appears to have been served with a complaint asserting that it infringed Voltstar's U.S. Patent No. 7,910,833. The district court dismissed the complaint without prejudice, following the parties' joint stipulation requesting such relief. In 2016, Superior filed a petition for IPR of the patent. The Board instituted review over Voltstar's objection that the petition was untimely under 35 U.S.C. § 315(b) because the IPR was filed more than one year after [Superior] was served with a complaint alleging infringement of the challenged patent.

In April 2018, the Board issued its final written decision in the case. *Superior Commc'ns, Inc. v. Voltstar Techs., Inc.*, IPR2017-00067, 2018 WL 1902040 (PTAB Apr. 20, 2018). It concluded that Superior had shown by a preponderance of the evidence that the challenged claims were unpatentable on obviousness grounds. And it again rejected Voltstar's contention that the petition was untimely, explaining that "the effect of a voluntary dismissal without prejudice is to render the prior action a nullity," and hence not subject to the § 315(b) time bar. *Id.* at *6.

We agree with Voltstar that, contrary to the Board's conclusion, these facts make § 315(b)'s time bar applicable, and hence "[a]n [IPR] may not be instituted." § 315(b). As we recently explained in in [sic] *Click-to-Call Technologies, LC v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018) (en Banc in part), nothing in § 315(b) makes relevant whether the February 2013

complaint was eventually dismissed voluntarily and without prejudice. All that matters, under its plain terms, is that the IPR is "filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent."

Superior asserts now there is no proof that it was served. However, the Board noted in its final written decision that "Petitioner d[id] not dispute that it was served with a complaint alleging infringement of the '833 patent more than one year prior to filing the Petition in the instant proceeding." *Superior*, 2018 WL 1902040 at *6. The court therefore deems it appropriate to terminate the appeal and remand to the Board with instructions to vacate the underlying *inter partes* review due to application of § 315(b).

Accordingly,

IT IS ORDERED THAT:

(1) The motion is granted. The appeal is terminated, and the IPR is remanded to the Board to vacate the underlying *inter partes* review.

(2) Each side shall bear its own costs.

FOR THE COURT

Nov. 6, 2018
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

ISSUED AS A MANDATE: November 6, 2018