

NOTE: This order is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

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**ICN ACQUISITION, LLC,**  
*Appellant*

v.

**SECURENET TECHNOLOGIES, LLC,**  
*Appellee*

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2018-1369

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Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2016-00959.

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**ON MOTION**

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PER CURIAM.

**O R D E R**

ICN Acquisition, LLC, (“Appellant”) appeals from a final written decision of the Patent Trial and Appeal Board (“Board”) holding claims 1, 2, 6–10, 14–18, and 21–25 of U.S. Patent 7,855,635 unpatentable as obvious. *SecureNet Techs., LLC v. Icontrol Networks, Inc.*, No. IPR2016-00959, 2017 WL 4867006, Paper 25 (P.T.A.B. Oct. 27, 2017). Appellant has moved to vacate the Board’s

decision and remand with instructions to dismiss for lack of jurisdiction.

Appellant asserts that it filed a civil action in district court for infringement of the '635 patent more than a year before SecureNet Technologies, LLC, (“Appellee”) petitioned the Board for *inter partes* review of the same patent. As a result, Appellant contends that the Board did not have subject matter jurisdiction to institute an *inter partes* review under 35 U.S.C. § 315(b). See *Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1328 n.3 (Fed. Cir. 2018) (en banc) (holding that § 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”).

Appellee has informed the court that it does not oppose this motion. Accordingly, we grant Appellant’s motion to vacate the Board’s decision in No. IPR2016-00959 and remand to the Board with instructions to dismiss the case.

IT IS ORDERED THAT:

- (1) The oral argument in this case scheduled for February 8 is cancelled.
- (2) The Board’s decision in No. IPR2016-00959 is vacated.
- (3) This appeal is remanded to the Board with instructions to dismiss.

FOR THE COURT

January 16, 2019  
Date

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

ISSUED AS A MANDATE: January 16, 2019