

EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

EMERSON ELECTRIC CO., FISHER-ROSEMOUNT SYSTEMS, INC., and ROSEMOUNT INC.,

Plaintiffs,

v.

SIPCO, LLC, and IP CO, LLC (d/b/a INTUS IQ),

Defendants.

Civil Action
File No. 1:15-cv-00319-AT

**DEFENDANTS’ MEMORANDUM IN OPPOSITION TO PLAINTIFFS’
MOTION TO ENJOIN PROSECUTION OF THE TEXAS ACTION**

Declaratory Judgment Defendants SIPCO, LLC and IP CO, LLC (together “SIPCO” or “Defendants”) respectfully submit this response to Plaintiffs’ Motion to Enjoin Defendants from Prosecuting the Second-Filed Action (“Motion to Enjoin”) filed by Declaratory Judgment Plaintiffs Emerson Electric Co., Fisher-Rosemount Systems, Inc., and Rosemount, Inc. (collectively, “Emerson” or “Plaintiffs”) on February 17, 2016. (Dkt. 51.)¹

¹ All citations to the docket in the instant action, No. 1:15-cv-00319-AT, are indicated by the notation “Dkt.” Citations to papers from the first action filed by Emerson, No. 1:13-cv-02528-AT, and the action pending in Texas will be cited

SIPCO requests this Court to deny Emerson’s Motion to Enjoin because (1) this case—which has different parties, does not share a single patent in common with the case currently pending in the Eastern District of Texas (“Texas action”), and has markedly different infringement claims—is not a “first-filed action” and thus does not invoke application of the first-to-file rule; (2) even if this were a first-filed case, which it is not, the 28 U.S.C. § 1404(a) factors weigh heavily in favor of keeping the Texas action in Texas; (3) as a matter of equity, Emerson cannot use the first-to-file rule to deny SIPCO its choice of forum for asserting patent rights not at issue before this Court; and (4) Emerson has already asked the Texas court to consider the first-to-file issue, which has been fully briefed to that court, and that court should be allowed to rule.

I. THE PARTIES

As explained in their Counterclaims, SIPCO and IP CO are small research and development companies that share a common founder: T. David Petite. (Dkt. 10 ¶ 10; *see also* Declaration of T. David Petite, at ¶ 2 (hereinafter “Exh. L”).) Petite developed extensive wireless control and distribution technology applications through exhaustive research and development in the 1990s. (Dkt. 10 ¶ 11.) Petite’s research resulted in various software, firmware, hardware, and a

with reference to their ECF numbers, and the papers cited from both cases herein are attached as exhibits.

patent portfolio, all of which are owned by SIPCO today. (*Id.* ¶ 12.) Investors put tens of millions of dollars behind the development of Petite's inventions, and this led to, among other applications, smart-grid technology that was purchased by Landis + Gyr. (*Id.* ¶ 11.) Today, Landis + Gyr implements the technology developed by Petite in millions of devices worldwide. (*Id.* ¶ 11.) As a result, SIPCO's patents have been widely licensed, and their licensing remains a major focus of SIPCO's ongoing business activities. (*Id.* ¶ 14.)

In addition to his work developing wireless mesh technology, Petite has dedicated his time to furthering inventorship and the development of new technologies. (Exh. L ¶¶ 5-12.) Petite, a registered member of the Fond Du Lac Chippewa tribe and the son of a former Chief of the Red Cliff Chippewa tribe in Wisconsin, is a founder of the Native American Intellectual Property Enterprise Council, which is an organization that provides patenting, copyright, and trademark assistance to help foster invention and innovation in the Native American community. (*Id.* ¶¶ 3, 5.) Petite has volunteered his time with the USPTO working on projects directed toward developing Native American intellectual property and as a speaker at patent-examiner training; he has also volunteered for a number of organizations geared toward developing and protecting entrepreneurship and innovation. (*Id.* ¶¶ 6, 10, 11.) A native of Atlanta,

Petite was recognized by the Georgia State Senate for his innovations in wireless technology, job creation, and an “incredible career” in engineering and invention. (*Id.* ¶¶ 4, 8.) He also was invited to and attended President Barack Obama’s signing of the America Invents Act and has been recognized as an influential inventor by the USPTO—even having been added to the USPTO’s 2014 Inventor Collectible Card Series. (*Id.* ¶¶ 7, 12.)

Emerson Electric Co. and the BP group of entities, which are defendants in the Texas action, are both Fortune Global 500 companies.² Emerson made \$24.5 billion and BP made \$358.7 billion in revenues last fiscal year.³ Both are large companies with many subsidiaries and with bases of operations outside of Georgia, as discussed in greater detail below. In the Texas action, these companies, and their considerable resources, are both aligned against SIPCO.

II. FACTUAL BACKGROUND OF THIS DISPUTE

SIPCO and Emerson are not strangers. Emerson’s White-Rogers Division has been a licensee of SIPCO’s patent portfolio since 2011. (*See* Dkt. 10 ¶ 23.) However, other non-licensed Emerson divisions and entities, such as Fisher-Rosemount Systems, Inc. and Rosemount, Inc., have been using the technology

² *See* Fortune Global 500, <http://fortune.com/global500/>, (last visited March 4, 2016).

³ *Id.*

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