

Patent No. 7,571,062
Case No. IPR2014-01409

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRO MOTION, INC.
Petitioner

v.
INVENSYS SYSTEMS, INC.
Patent Owner

Patent No. 7,571,062
Issue Date: August 4, 2009
Title: DIGITAL FLOWMETER

Case No. IPR2014-01409

PETITIONER'S MOTION FOR JOINDER
37 C.F.R. § 42.122(b)

I. RELIEF REQUESTED

Petitioner Micro Motion, Inc. hereby moves for joinder of IPR2014-01409 (petition filed today) with IPR2014-00393 (trial instituted on Aug. 4, 2014).

Moreover, to the extent the Board wishes to maintain synchronization of trial schedules among IPR2014-00390, IPR2014-00392, IPR2014-00393 beyond the one-year period under 35 U.S.C. § 316(a)(11), Petitioner Micro Motion further moves for joinder of IPR2014-01409 with IPR2014-00390 (trial instituted on Aug. 4, 2014) and IPR2014-00392 (trial instituted on Aug. 4, 2014).

II. AUTHORIZATION FOR THIS MOTION

Prior Board authorization is not required under the *Trial Practice Guide* for “motions filed with a petition.” 77 Fed. Reg. 48756, 48762 (Aug. 14, 2012).

Thus, when a “petition is accompanied by a request for joinder” under 37 C.F.R. § 42.122(b), prior Board authorization is not required. *See* IPR2014-00781 (Paper 5) (“[P]rior authorization for filing a motion for joinder—prior to one month after the institution date of any *inter partes* review for which joinder is requested—is not required.”).

III. STATEMENT OF MATERIAL FACTS

1. On January 31, 2014, Petitioner filed a petition (“First Petition”) for *inter partes* review of claims 1, 12, 13, 23-25, 29, 30, 36, 40, 43, and 45 of U.S.

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Patent No. 7,571,062 (“the ’062 patent”), which was assigned case number IPR2014-00393. The First Petition was accompanied by a single declaration of Dr. Michael D. Sidman.

2. Around the same time that Petitioner filed the First Petition in IPR2014-00393, Petitioner also filed petitions for *inter partes* review of U.S. Patent No. 6,754,594 (Case No. IPR2014-00390), filed on January 30, 2014, and U.S. Patent No. 8,000,906 (Case No. IPR2014-00392) filed on January 29, 2014.

3. On August 4, 2014, the Board entered a decision (“Decision”) in IPR2014-00393 instituting trial on claims 1, 29, 40, and 45. The Decision did not institute an *inter partes* review of dependent claims 12, 13, 23-25, 30, 36, and 43.

4. More specifically, the Decision in IPR2014-00393 instituted trial on claims 1, 29, 40, and 45 on the following grounds proposed in the First Petition:

- a. Claims 1, 29, 40, and 45 as anticipated by Romano¹ under 35 U.S.C. § 102;
- b. Claims 40 and 45 as obvious in view of Kalotay² under 35 U.S.C. § 103; and
- c. Claims 40 and 45 as anticipated by Miller³ under 35 U.S.C. § 102.

¹ U.S. Patent No. 4,934,196 (issued June 19, 1990) (“Romano”).

² U.S. Patent No. 5,009,109 (issued Apr. 23, 1991) (“Kalotay”).

5. Regarding Romano, the Decision found that the First Petition demonstrated a reasonable likelihood that Romano anticipates claims 1, 29, 40, and 45. But the Decision found that the First Petition did not demonstrate a reasonable likelihood that Romano discloses the additional element in claims 24 and 43 which requires a digital flowmeter having a control and measurement system that applies a negative gain to reduce motion of the conduit.

6. Regarding Kalotay, the Decision found that the First Petition demonstrated a reasonable likelihood that Kalotay alone renders obvious claims 40 and 45. But the Decision found that Kalotay's use of "analog" signal processing does not demonstrate a reasonable likelihood that claim 1 is obvious, because the flowmeter of claim 1 "use[s] digital processing to adjust a phase of the drive signal to compensate for a time delay associated with components connected between the sensor and the driver." For this same reason, claims 12, 23-25, 29, and 36 were found not to be obvious over Kalotay alone due to their dependency from claim 1.

7. Regarding Miller, the Decision found that the First Petition demonstrated a reasonable likelihood that Miller anticipates claims 40 and 45.

8. On August 4, 2014, the Board also instituted trial in IPR2014-00390 and IPR2014-00392.

³ U.S. Patent No. 4,679,947 (issued July 14, 1987) ("Miller").

9. On even date herewith, Petitioner filed a petition (“Second Petition”) for *inter partes* review (Case No. IPR2014-01409) challenging independent claim 1 and dependent claims 12, 23-25, 29, 36 (which depend from claim 1) and claim 43 (which depends from claim 40). The grounds of invalidity presented in the Second Petition are premised upon the same references (Kalotay and Romano) that were cited in the First Petition which the Board found to establish a reasonable likelihood of unpatentability of claims 1, 29, 40, and 45, but the arguments based on those references are different from those presented in the First Petition. The Second Petition was accompanied by a single declaration of Dr. Michael D. Sidman, who is the same expert who submitted a declaration in connection with the First Petition.

10. More particularly, the Second Petition presents a single ground of unpatentability: claims 1, 12, 23-25, 29, 36, and 43 are obvious under 35 U.S.C. § 103(a) over the combination of Kalotay and Romano. As further evidence of the level of skill in the art, the Second Petition cites Zolock,⁴ Hulsing,⁵ Astrom & Wittenmark⁶ to show specifically that the use of digital signal processing to

⁴ U.S. Patent No. 5,231,884.

⁵ U.S. Pat. No. 4,799,385.

⁶ “Computer Controlled Systems Theory and Design,” Astrom & Wittenmark, Prentice-Hall 1984.

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