

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMERSON ELECTRIC CO.,
Petitioner,

v.

SIPCO, LLC,
Patent Owner.

Case IPR2015-01973
Patent 8,013,732

PETITIONER'S RESPONSE TO OBSERVATIONS

Petitioner has the following responses to each of Patent Owner's observations on the September 8, 2016 cross-examination testimony of Dr. Stephen Heppe (Paper 17).¹

Response to Observation 1: The testimony cited by Patent Owner is about the meaning of the word "function," not the more specific term "function code."

¹ In each of its observations, Patent Owner fails to follow the form for observations set forth in the Office Patent Trial Practice Guide: "In exhibit __, on page __ of __, lines __, the witness testified __. ***This testimony is relevant to the __ on page __ of __. The testimony is relevant because __.***" 77 Fed. Reg. 48768 (emphasis added). In particular, each of Patent Owner's observations lacks at least one of these explanations of relevance and therefore fails to particular identify the reasons why the cited testimony is relevant to arguments in the proceeding. Accordingly, each of Patent Owner's observations should be expunged or not considered on the basis that Petitioner is unable to respond fully to Patent Owner's observations. Furthermore, none of Petitioner's responses herein should be construed as an admission or acknowledgement how Patent Owner's observations are relevant to any opinion or argument in this proceeding. Petitioner also objects to each of the observations because Patent Owner's statement of relevance exceeds the limitations set forth in the Trial Practice Guide.

Patent Owner did not advise the Board of all relevant testimony. Dr. Heppe testified that *part* of the meaning of the term “function” to those in the relevant art would include a code for an action or a type of data. Dr. Heppe also specifically testified that he had not attempted to fully construe the term “function” in light of the pertinent intrinsic evidence, and would not do so in the middle of the deposition. Ex. 2009, pp. 10:22-12:11; 12:21-16:2. The testimony cited by Patent Owner is not relevant to the issues in this proceeding because, contrary to Patent Owner’s implication, Dr. Heppe testified and explained that Burchfiel discloses the claimed “function code.” Ex. 2009, pp. 22:11-24:12; 39:15-42:14.

Response to Observation 2: The testimony cited by Patent Owner is about the meaning of the word “code,” not the more specific term “function code.”

Patent Owner did not advise the Board of all relevant testimony. Dr. Heppe testified that *part* of the meaning of the term “code” to those in the relevant art would include a software code, an access code, personal identification number, pseudo-random noise code, command code, op code, frequency hopping code, and other codes. Dr. Heppe also specifically testified that he had not attempted to fully construe the term “code” in light of the pertinent intrinsic evidence, and would not do so in the middle of the deposition. Ex. 2009, pp. 16:4-17:11; 19:6-21:5. The testimony cited by Patent Owner is not relevant to the issues in this proceeding because, contrary to Patent Owner’s implication, Dr. Heppe testified and explained

that Burchfiel discloses the claimed “function code.” Ex. 2009, pp. 22:11-24:12; 39:15-42:14.

Response to Observation 3: The testimony cited by Patent Owner is directed to whether any prior art reference relied upon by Petitioner discloses codes that are “unique” to a particular device and no other device. Contrary to Patent Owner’s incomplete citation, Dr. Heppe testified that Burchfiel, for example, disclosed codes that are unique to a single packet radio and no other. Ex. 2009, pp. 34:3-35:9. Dr. Heppe also testified that the cited prior art discloses function codes that are unique to a transceiver. Ex. 2009, pp. 36:10-39:13.

Response to Observation 4: The testimony cited by Patent Owner is directed to whether the Admitted Prior Art teaches a function code that is unique to a transceiver. This testimony is not relevant to any issue in this proceeding because Petitioner did not rely on the Admitted Prior Art for disclosure of a function code that is unique to a transceiver. Instead, Burchfiel and Kahn teach or suggest that claim feature. Petition, p. 49-50; Ex. 2009, pp. 36:10-39:13; 46:5-47:22.

Response to Observation 5: The testimony cited by Patent Owner is directed to whether Figure 3D of the ‘732 patent is part of the Admitted Prior Art. From this limited testimony, Patent Owner extrapolates to conclude that Dr. Heppe does not understand what constitutes the Admitted Prior Art. Patent Owner did not

advise the Board of all relevant testimony. Dr. Heppe testified that he did not undertake to determine whether Figure 3D, or parts of Figure 3D, were part of the Admitted Prior Art. Ex. 2009, 53:18-57:20. The testimony cited by Patent Owner is not relevant to any issue in this proceeding because Dr. Heppe relied upon other aspects of the '732 patent specification as disclosure of the relevant Admitted Prior Art.

Response to Observation 6: The testimony cited by Patent Owner is whether Exhibit 1009 describes aspects of a wireless communication protocol or a wired communication protocol. Although Dr. Heppe testified that he believed that the exhibit describes aspects of a wired communication protocol, that does not render the teachings of Exhibit 1009 irrelevant to the patentability of Patent Owner's challenged claims. Exhibit 1009 (coupled with Exhibit 1010) teach that it was known by those of skill in the art that communication data packets could include function codes based on, or in response to, data sensed by a sensor. Dr. Heppe never testified that the teachings of Exhibit 1009 could not be used in a wireless communications network/device as recited in the challenged claims.

Response to Observation 7: The testimony cited by Patent Owner is whether Exhibit 1010 describes aspects of a wireless communication protocol or a wired communication protocol. First, the cited testimony only states that Dr. Heppe does not read Exhibit 1010 as disclosing a network of wireless devices.

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