

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 B2

Before LYNNE E. PETTIGREW, STACEY G. WHITE, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Background

Emerson Electric Co. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) seeking to institute an *inter partes* review of claims 13, 14, 16–21, and 23–35 of U.S. Patent No. 8,013,732 B2 (Ex. 1001, “the ’732 patent”). We instituted trial on all challenged claims. Paper 8, 25. We entered a Final Written Decision concluding that Petitioner has not demonstrated by a preponderance of the evidence the unpatentability of claims 13, 14, 16–21, and 23–35 of the ’732 patent. *Id.* at 13.

Petitioner appealed. Paper 26. The Federal Circuit vacated our Final Written Decision and remanded the proceeding “to address the seemingly opposite findings from IPR2016-00984.” *Emerson Elec. Co. v. SIPCO, LLC*, 745 F. App’x 369, 374 (Fed. Cir. 2018). In IPR2016-00984, we issued a final written decision regarding a related patent and came to a different conclusion regarding the issue of motivation to combine. *Emerson Elec. Co. v. SIPCO, LLC*, No. IPR2016-00984, 2017 WL 4862106 (PTAB. Oct. 25, 2017). On November 29, 2018, the Board and representatives of the parties held a conference call to discuss what briefing, if any, is needed to address the Federal Circuit’s remand. Ex. 1014 (“Tr.”).

Discussion

The Board’s Standard Operating Procedure 9 provides guidance regarding the procedure for handling cases remanded from the Federal Circuit. *See* PTAB SOP 9 (“Procedure for Decisions Remanded from the Federal Circuit for Further Proceedings”). Under SOP 9, “the panel shall consider procedures proposed by the parties,” but “ultimately will decide the procedures to be followed on remand.” *Id.* at 5 (App’x 2). SOP 9 further provides that “[t]he panel will consider the scope of the remand, as

determined from the reasoning and instructions provided by the Federal Circuit, as well as ‘the effect . . . on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings.’” *Id.* at 6 (App’x 2) (quoting 35 U.S.C. §§ 316(b), 326(b)). As to additional briefing, SOP 9 states that “the panel will take into account whether the parties already have had an adequate opportunity to address the issues raised by the remand.” *Id.* If additional briefing is allowed it “will normally be limited to the specific issues raised by the remand.” *Id.* (citing *Microsoft Corp. v. Proxyconn, Inc.*, Case No. IPR2012-00026 (Paper 77) (PTAB Sept. 1, 2015); *Dell Inc., v. Acceleron, LLC*, Case No. IPR2013-00440 (Paper 46) (PTAB May 26, 2016).

Additional Briefing

During the November 29, 2018 call, Petitioner requested leave to submit a five page brief, which would be followed by a five page response brief from the Patent Owner and a two page reply brief from the Petitioner. Tr. 6:5–8. Patent Owner contended that no additional briefing was necessary because all issues have been fully briefed. Upon review of the Federal Circuit’s Decision, we agree with Patent Owner. The Federal Circuit remanded this Decision because it determined that we “did not adequately explain and support [our] conclusion that Kahn would not have motivated one of ordinary skill in the art to combine the teachings of Kahn and the Admitted Prior Art for flexibility and rapid deployment.” *Emerson*, 745 F. App’x at 372. Thus, it is our task to review the existing record and issue a new decision with the required analysis. We determine that no

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additional briefing is necessary to fulfill that mandate from our reviewing court.

In consideration of the foregoing, it is hereby

ORDERED that no other papers are authorized and no new evidence shall be introduced.

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