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Paper 27
Entered: April 20, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMERSON ELECTRIC CO.,
Petitioner,

v.

SIPCO, LLC,
Patent Owner.

Case IPR2016-00984
Patent 8,754,780 B2

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

ZADO, *Administrative Patent Judge*.

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

Pursuant to our July 27, 2016 Order (Paper 10), Sipco, LLC (“Patent Owner”) seeks our authorization to file a third Request for a Certificate of Correction and Petition to Accept an Unintentionally Delayed Priority Claim and for Expedited Consideration (collectively, “Third Request”) with respect to U.S. Patent No. 8,754,780 B2 (the “’780 patent”). On April 7, 2017, Patent Owner filed a response (Paper 26) to our March 30, 2017 order to show cause why we should grant its Third Request (Paper 24, “Order to Show Cause”). Petitioner opposes Patent Owner’s request, and seeks authorization to file a reply to Patent Owner’s response to our Order to Show Cause.

The application to which the ’780 patent claims priority, U.S. Application No. 13/173,499 (the “’499 application”) (Ex. 1026, 2–3) issued as a patent, U.S. Patent No. 8,212,667, several months prior to the filing of the application leading to the ’780 patent (Ex. 1030, 2–3). Accordingly, there is no co-pendency between the ’780 patent and the ’499 application.

On May 26, 2016, nearly one month after the filing date accorded to the petition in this proceeding, Patent Owner filed, with respect to the ’780 patent, both a Request for a Certificate of Correction (Ex. 1023, “Request”) and Petition to Accept an Unintentionally Delayed Priority Claim and for Expedited Consideration (Ex. 1022, Priority Claim Petition) (collectively, “First Request.”). In the First Request, Patent Owner sought to amend its claim of priority to an application that it alleges shares co-pendency with the application leading to the ’780 patent, U.S. Application 13/222,216. Ex. 1022, 2; Ex. 1023, 2. On November 14, 2016, the Petitions Branch granted Patent Owner’s request for expedited review of Patent Owner’s petition, but otherwise dismissed the petition for failure to comply

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with 35 U.S.C. § 120 and 37 C.F.R § 1.78(d)(2), which requires a reference be filed in an Application Data Sheet. Ex. 3001.

Pursuant to our July 27, 2016 Order (Paper 10), Patent Owner subsequently sought, and we granted, authorization to file a second Request for a Certificate of Correction and Petition to Accept an Unintentionally Delayed Priority Claim and for Expedited Consideration (collectively, “Second Request”). Paper 20, 3. On January 20, 2017, the Petitions Branch granted Patent Owner’s request for expedited review of Patent Owner’s petition, but dismissed Petitioner’s request for correction of the ’780 patent’s priority date for failure to “make a reference to the first (earliest) application and every intermediate application.” Ex. 3002, 2. The chain of priority in Patent Owner’s petition does not match the chain of priority in the reference to which Patent Owner seeks to claim priority. *Id.*

Patent Owner now seeks our authorization to file a third Request for a Certificate of Correction and Petition to Accept an Unintentionally Delayed Priority Claim and for Expedited Consideration with the Petitions Branch (collectively, “Third Request”). We ordered Patent Owner to show cause why we should authorize it to file a Third Request. Paper 24. Patent Owner’s response to our Order to Show Cause alleges that the mistakes in the Second Request are due to an inadvertent omission, but Patent Owner does not explain any particular circumstances that would justify its mistakes. Paper 26, 4. Also, Patent Owner’s repeated mistakes indicate deliberate indifference toward avoiding errors. Under the present circumstances, we exercise our jurisdiction pursuant to 37 C.F.R § 42.3, and deny Patent Owner’s request to file a Third Request. Because we deny Patent Owner’s

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Third Request, Petitioner's request to file a reply to Patent Owner's response to our Order to Show Cause is denied as moot.

Accordingly, it is:

ORDERED that Patent Owner's request to file a Request for a Certificate of Correction and Petition to Accept an Unintentionally Delayed Priority Claim and for Expedited Consideration is denied.

PETITIONER:

Don Jackson
djackson@dbjg.com

PATENT OWNER:

Gregory Gonsalves
gonsalves@gonsalveslawfirm.com