

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MOTIVEPOWER, INC.,  
Petitioner,

v.

CUTSFORTH, INC.,  
Patent Owner.

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Case IPR2013-00274  
Patent 7,990,018 B2

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Before TRENTON A. WARD, MIRIAM L. QUINN, and CARL M. DeFRANCO,  
*Administrative Patent Judges.*

WARD, *Administrative Patent Judge.*

FINAL WRITTEN DECISION ON REMAND  
35 U.S.C. § 144 and 37 C.F.R. § 42.5(a)

## I. INTRODUCTION

### A. Background

MotivePower, Inc., Petitioner, filed a Petition to institute an *inter partes* review of all the claims 1–24 (the “challenged claims”) of U.S. Patent No. 7,990,018 B2 (Ex. 1001, “the ’018 patent”) pursuant to 35 U.S.C. §§ 311–19. Paper 1 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). The Board granted the Petition and instituted trial for all asserted claims. Paper 7 (“Dec.”). Although Petitioner proposed nine grounds of unpatentability, we instituted trial on only the following ground: Claims 1–24 would have been obvious in view of in view of Bissett,<sup>1</sup> Kartman,<sup>2</sup> and Ohmstedt.<sup>3</sup> Dec. 25.

During trial, Cutsforth, Inc., Patent Owner, filed a Patent Owner Response (“PO Resp.”) addressing the grounds involved in trial and relying on the Declaration of Dr. Thomas A. Keim (Ex. 2019). Paper 12. Petitioner filed a Reply to Patent Owner’s Response. Paper 21 (“Pet. Reply”). An oral hearing was held on September 16, 2014, and a transcript of the hearing is included in the record. Paper 30 (“Tr.”).

On October 30, 2014, the Board issued a Final Written Decision in accordance with 37 C.F.R. § 42.73. Paper 31 (“Final Dec.”). The Board concluded that Petitioner had established, by a preponderance of the evidence, that claims 1–24 of the ’018 patent would have been obvious over Bissett, Kartman, and Ohmstedt. Final Dec. 32. Patent Owner appealed the decision to the United

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<sup>1</sup> U.S. Patent No. 3,432,708 (Ex. 1005) (“Bissett”).

<sup>2</sup> U.S. Patent No. 5,043,619 (Ex. 1004) (“Kartman”).

<sup>3</sup> U.S. Patent No. 3,864,803 (Ex. 1003) (“Ohmstedt”).

States Court of Appeals for the Federal Circuit. Paper 35.

On January 22, 2016, the Federal Circuit issued a decision vacating and remanding the case to the Board. *Cutsforth, Inc. v. MotivePower, Inc.*, 636 F. App'x 575, 578 (Fed. Cir. 2016) (unpublished) (nonprecedential) (entered herein as Paper 38). The Federal Circuit held “that the Board’s Final Written Decision does not provide enough explanation to support its finding of obviousness.” *Id.* “When the Board determines that modifications and combinations of the prior art render a claimed invention obvious, the Board must fully explain why a person of ordinary skill in the art would find such changes obvious.” *Id.* at 578–79. As a result, the Federal Circuit vacated the Board’s determinations that claims 1–24 of the '018 patent were not patentable and remanded the case to the Board “for proceedings appropriate to the administrative process.” *Id.* at 579 (citing *In re Sang-Su Lee*, 277 F.3d 1338, 1346 (Fed. Cir. 2002)). On February 29, 2016, the Federal Circuit issued a formal mandate, returning the case to the Board. Paper 39.

On March 29, 2016, the Board held a conference with the parties to discuss Patent Owner’s request to submit additional briefing in light of the remand and to discuss the Petitioner’s opposition to such additional briefing. Paper 37, 2. During the conference, Patent Owner indicated that it was seeking additional briefing because the “record is without adequate briefing as to whether one of skill would have made the changes that are contemplated as they relate to a spring that was at issue and relating to claim 5.” Ex. 2064, Transcript of March 29, 2016 conference call, 6:15–18. Patent Owner stated that “a remand typically . . . deserves briefing on the point of the remand to make sure the record is full and there could be a fulsome review of the issues that are thought by the Appellate Court to . . . need[] further review.” *Id.* at 7:20–25. Patent Owner further argued that additional briefing was needed because the record was “devoid of arguments . . . from either

side on this issue”; thus, Patent Owner requested “briefing without evidentiary submission by either party, a page limited briefing of simultaneous submission.” *Id.* at 8:9–11, 11:12–14.<sup>4</sup>

We granted Patent Owner’s request to file additional briefing. Paper 37, 3. More particularly, we authorized additional briefing limited to the issue raised by Patent Owner, namely, the design choice issue with respect to claim 5 of the ’018 patent. *Id.* In accordance with the Board’s Order, both Petitioner and Patent Owner filed their briefs on April 15, 2016. *See* Paper 40 (“Petitioner Remand Br.”) and Paper 41 (“PO Remand Br.”). Subsequently, Patent Owner requested authorization to file a Reply Brief to address arguments presented in Petitioner’s Remand Brief. The Board granted the request and authorized both parties to file a reply brief. Accordingly, the parties filed reply briefs on April 29, 2016. *See* Paper 42 (“PO Remand Reply”) and Paper 43 (“Pet. Remand Reply”).

For the reasons that follow, we determine that Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–4, 6–7, and 9–24 of the ’018 patent would have been obvious over Bissett, Kartman, and Ohmstedt. Additionally, we determine that the Petitioner has failed to establish that claims 5 and 8 of the ’018 patent are unpatentable.

#### *B. Related Proceedings*

Petitioner indicates that the ’018 patent is currently the subject of a co-pending federal district court case, *Cutsforth, Inc. v. MotivePower, Inc.*, No. 0:12-cv-01200-SRN-JSM (D. Minn.). Pet. 2; Paper 5, 2. In addition, patents related to

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<sup>4</sup> We note that neither party requested authorization to submit new evidence after the remand.

the '018 patent, as listed below, have been the subject of *inter partes* review as follows:

U.S. Patent No.	<i>Inter Partes</i> Proceeding
7,122,935 B2	IPR2013-00267
7,141,906 B2	IPR2013-00268 <sup>5</sup>
7,417,354 B2	IPR2013-00270
8,179,014 B2	IPR2013-00272

### *C. The '018 Patent*

The '018 patent generally relates to a brush holder assembly for use in electrical devices and slip ring assemblies. Ex. 1001, 1:25–27. In particular, the patent describes that a brush is used in an electrical device to pass electrical current from a stationary contact to a moving contact surface, and vice versa. *Id.* at 1:31–33. The brush is typically in contact with a moving surface; thus, the surface of the brush wears down, reducing the quality of the electrical contact. *Id.* at 1:42–62. The '018 patent describes that when the brush is so worn that it requires replacement, the moving contact surface may need to be halted, which may be

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<sup>5</sup> On April 6, 2016, the Federal Circuit issued a decision reversing the Board's decision in IPR2013-00268 because "the Board erred in construing the claim terms 'projection extending from' and 'brush catch coupled to the beam.'" *Cutsforth, Inc. v. Motivepower, Inc.*, 643 F. App'x 1008, 1009 (Fed. Cir. 2016). As neither of these claim terms is at issue here, the Federal Circuit's decision has no effect on this proceeding.

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