

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POLYGROUP LIMITED MCO,
Petitioner,

v.

WILLIS ELECTRIC CO., LTD,
Patent Owner.

IPR2016-01610 (Patent 8,454,186 B2)¹

Before WILLIAM V. SAINDON, JEREMY M. PLENZLER, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding on Remand
37 C.F.R. § 42.5

¹ The grounds raised in IPR2016-00800 and IPR2016-01609 are consolidated with IPR2016-01610.

This case is before us on remand from the Federal Circuit for a second time. *Polygroup Limited MCO v. Willis Electric Company, Ltd*, Cases 2021-1401, -1402 (Fed. Cir. Apr. 20, 2022) (“*Polygroup II*”); *see also Polygroup Limited MCO v. Willis Electric Company, Ltd*, Cases 2018-1745, -1746, -1747 (Fed. Cir. Mar. 28, 2019) (“*Polygroup I*”). A conference call was held on August 3, 2022 to discuss the procedure on remand. We listened to proposals from both parties. The following is our representation of the discussion² and our decision in light of that discussion.

Patent Owner argued that in *Polygroup II*, the Federal Circuit remanded to us solely the limited question of whether claim 7 of US Patent No. 8,454,186 (“the ’186 patent”) would have been obvious in view of Miller³ alone. Patent Owner directed us to the following statement of the Federal Circuit:

We note that Polygroup admitted that Miller does not teach every limitation in the claim. *See Oral Argument* at 5:35–54, https://oralarguments.cafc.uscourts.gov/default.aspx?fl=21-1401_10052021.mp3 (Oct. 5, 2021); Appx19. The Board may consider this statement on remand when it considers the unpatentability of claim 7 in view of Miller alone.

Polygroup II, slip op. at 8. Accordingly, Patent Owner proposed that Petitioner has admitted that Miller alone does not teach each limitation of claim 7; that no further briefing is necessary to resolve all issues on remand; and that PTAB can issue its decision on that issue based on the record as it stands.

² Neither party secured the services of a court reporter for the call.

³ US Patent No. 4,020,201, iss. Apr. 26, 1977 (Ex. 1007).

Petitioner agreed that the sole issue before us on remand is the question of whether claim 7 is obvious in view of Miller alone. Although Petitioner acknowledged its admission, Petitioner stated that obviousness inquiries must also consider the level of ordinary skill in the art, such that its admission is not dispositive. Petitioner also alleges that in a parallel district court proceeding, Patent Owner offered an argument on claim construction that would be relevant to this proceeding. Petitioner argued that, as a “matter of equity,” we should consider documents regarding those statements made in district court. Accordingly, Petitioner requests further briefing and admission of these documents.

Upon consideration of the parties’ arguments, we agree with the parties that the sole issue remanded to us is whether claim 7 of the ’186 patent is obvious in view of Miller alone.

With regard to Petitioner’s observation that even a Miller-alone ground must consider the level of ordinary skill in the art, we agree. However, Petitioner is limited to the ground as set forth in the Petition. *SAS Institute Inc. v Iancu*, 137 S. Ct. 1348, 1355–57 (2018) (stating that it is “petitioner’s *petition*” specifically that “define[s] the scope of the litigation all the way from institution through to conclusion”) (emphasis added). The Petition, evidence, and briefing relating the grounds are already part of the record. Thus, we have a complete record from which to decide this issue. Accordingly, we agree with Patent Owner that we can resolve the issue without further briefing. Petitioner’s request for further briefing regarding claim 7 is denied.

Lastly, we turn to Petitioner’s request for us to enter and consider statements allegedly made by Patent Owner in district court regarding claim construction. First, we note that “[a]ny person at any time” has the right to

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submit “statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent.” 35 U.S.C. § 301(a)(2). That said, our understanding of our Rules requires that Petitioner, as a party before PTAB, must consult with the panel as to the appropriate manner of filing. *See* 37 C.F.R. §§ 42.3(a) (“The Board may exercise exclusive jurisdiction within the Office over every involved . . . patent.”), 42.7(a) (“The Board may expunge any paper . . . while [a] patent is under the jurisdiction of the Board that is not authorized *under this part or in a Board order.*”) (emphasis added), 42.20(a–b) (“Relief . . . must be requested in the form of a motion.” “A motion will not be entered without Board authorization.”). Second, we note that claim construction is a necessary step to determining whether a claim is obvious. *See, e.g., Application of Neugebauer*, 330 F.2d 353, 356 (CCPA 1964) (“The claims as a whole must be analyzed . . . to see if the article *defined thereby* is distinguishable . . . over the prior art.”) (emphasis removed and emphasis added).

Accordingly, although we were not necessarily convinced by Petitioner during the call that the documents Petitioner wishes to submit are statements by Patent Owner in which they take a position on the scope of claim 7 germane to this proceeding, we will permit Petitioner to submit them in order for us to evaluate. Specifically, Petitioner may submit as exhibits the *Daubert* motion it mentioned during the call, as well as the documents containing expert statements that Petitioner indicated were submitted in support of that motion and cited therein.⁴ Petitioner is not authorized to file

⁴ If we have misunderstood which documents are encompassed by Petitioner’s request, it should contact the Board as soon as possible to

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any other evidence or submit any argument. It is a routine matter for us to evaluate the credibility of witnesses and to evaluate allegedly conflicting testimony and arguments. It is not apparent to us that it would be useful or cost-effective to have the parties brief us on the content of the documents and how they apply to this case. We will read the relevant parts of them ourselves, and we may request further briefing if we find otherwise. Accordingly, we deny Petitioner's request for briefing regarding the positions allegedly taken by Patent Owner in district court.

Notwithstanding, we will permit both parties to submit a paper containing citations to passages the party believes we should consider in view of the entry of any documents submitted pursuant to this Order. The citations must be to a paper or exhibit in this proceeding (to include the to-be-submitted documents discussed above), may use Bluebook-style citation signals (e.g., "*but see*," "*compare with*," etc.), and may quote and emphasize language within the cited passages, but may not include argument.

Petitioner may file the above-specified documents as exhibits, along with its paper containing citations, no later than two weeks and one calendar day after entry of this Order. Patent Owner may file its paper of citations no later than two weeks after Petitioner's submission to PTAB. No further papers are authorized at this time.

It is SO ORDERED.

request clarification, though this does not otherwise limit Petitioner's rights to a rehearing pursuant to 37 C.F.R. § 42.71 nor toll the deadline thereof.

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