

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMERSON ELECTRIC CO.,
Petitioner,

v.

IP CO., LLC,
Patent Owner.

Case IPR2016-01602
Patent 6,249,516 B1

Before THOMAS L. GIANNETTI, BRYAN F. MOORE, and
TREVOR M. JEFFERSON, Administrative Patent Judges.

GIANNETTI, Administrative Patent Judge.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Emerson Electric Co. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) seeking *inter partes* review of claims 1, 2, 4, 5, 10, 11, 13, and 14 of U.S. Patent No. 6,249,516 B1 (Ex. 1001, “the ’516 patent”). IP CO., LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we granted Petitioner’s request and instituted an *inter partes* review on all challenged claims. Paper 10 (“Institution Dec.”).

Following institution, Patent Owner filed a Response to the Petition (Paper 19, “PO Resp.”) and Petitioner filed a Reply (Paper 21, “Pet. Reply”). In addition, Patent Owner filed a motion for observations on the cross-examination of Petitioner’s expert, Mr. Geier, and Petitioner filed a response. Papers 23, 26. In addition, a final oral hearing was held on November 13, 2017. A transcript of that hearing has been entered in the record. Paper 32 (“Hr’g Tr.”).

For the reasons discussed below, Petitioner has shown by a preponderance of the evidence that all challenged claims of the ’516 patent are unpatentable.

A. *Related Proceedings*

The parties advise us that Patent Owner has asserted the ’516 patent against Petitioner in *SIPCO, LLC v. Emerson Electric Co.*, No. 6:15-cv-00907 (E.D. Tex.), which has been transferred to the Northern District of Georgia, Case No. 1:16cv2690. Pet. 3–4; Paper 4. The parties have identified another *inter partes* review challenging the ’516 patent, IPR2014-

00147, which has been terminated, and several involving related patents. *Id.* In addition, the '516 patent has been reexamined. *See* Ex. 1001, 58–60 (Ex Parte Reexamination Certificate US 6,249,516 C1).

B. The '516 Patent (Ex. 1001)

The '516 patent is titled “Wireless Network Gateway and Method for Providing Same.” Figure 1 of the '516 patent is reproduced here:

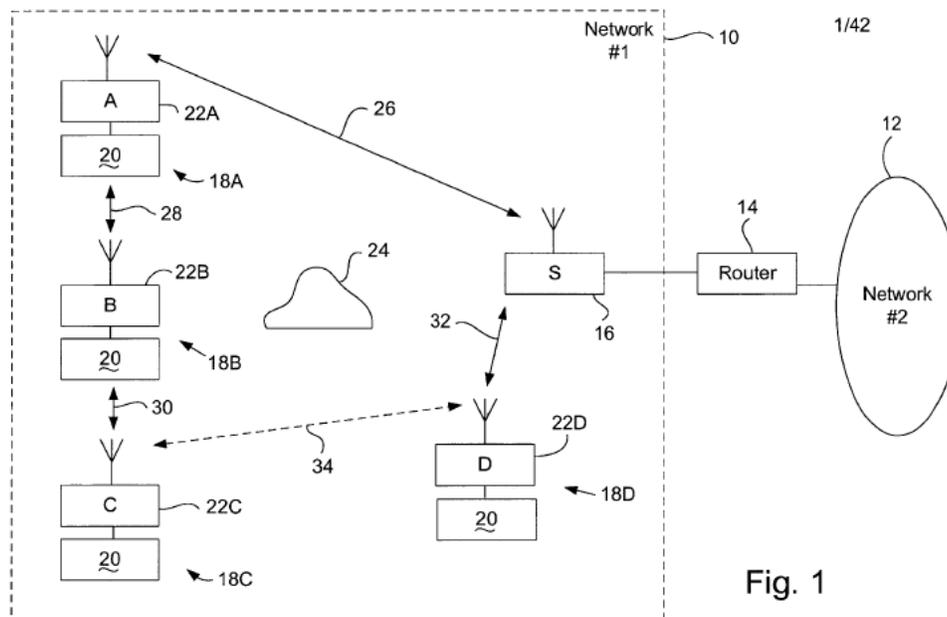


Fig. 1

Figure 1 illustrates a first wireless network 10 in communication with second wireless network 12 via router 14. Ex. 1001, col. 7, ll. 37–40. Server 16 acts as a gateway between the two networks. *Id.* col. 7, ll. 62–66. Clients 18 each include a client machine 20 (a digital processor) and radio modem 22. *Id.* col. 8, ll. 17–19.

In operation, a client of the wireless network has either a direct (1 hop) or an indirect (2 or more hops) path to a server of the wireless network system. *Id.* col 4, l. 66–col. 5, l. 11. The patent describes an optimization

process which minimizes the number of hops from the clients to the servers, on the theory that the fewer the number of hops, the better the performance of the network. *Id.* col. 5, ll. 11–16.

The server includes a radio modem capable of communicating with the first wireless network, a network interface capable of communicating with the second network (a wired TCP/IP network such as the Internet), and a digital controller coupled to the radio modem and to the network interface. Ex. 1001, col. 5, ll. 54–61. The digital controller maintains a map of the links of the first network and provides that map to first network clients on request. *Id.* col. 5, l. 8–col. 6, l. 2. By maintaining a map of the first network links, the server is able properly to address packets received from either the first network or the second network to the appropriate client of the first network, and allows the clients of the network to maintain and upgrade their data communication paths to the server. *Id.* col. 6, ll. 2–7.

C. Illustrative Claims

Of the challenged claims, claims 1 (directed to an apparatus) and 10 (directed to a method) are independent.

Claim 1 reads as follows:

1. A server providing a gateway between two networks, where at least one of the two networks is a wireless network, said server comprising:

a radio modem capable of communicating with a first network that operates, at least in part, by wireless communication;

a network interface capable of communicating with a second network; and

a digital controller coupled to said radio modem and to said network interface, said digital controller communicating with said first network via said radio modem and communicating with said second network via said network interface, said digital controller passing data packets received from said first network that are destined for said second network to said second network, and passing data packets received from said second network that are destined for said first network to said first network, said digital controller maintaining a map of data packet transmission paths of a plurality of clients of said first network, where a transmission path of a client of said first network to said server can be through one or more of other clients of said first network;

wherein said digital controller changes the transmission paths of clients to optimize the transmission paths including changing the transmission path from the client to the gateway so that the path to the gateway is chosen from the group consisting essentially of the path to the gateway through the least possible number of additional clients, the path to the gateway through the most robust additional clients, the path to the gateway through the clients with the least amount of traffic, and the path to the gateway through the fastest clients.

Challenged claims 2, 4, and 5 depend from claim 1.

Claim 10 was modified in *ex parte* reexamination.¹ Claim 10, as modified, reads as follows:

10. A method providing a gateway between a wireless network and a second network comprising:

receiving a data packet from a client of said wireless network, converting said data packet to a proper format for said second network, and sending said data packet to said second network; and

receiving a data packet from said second network, adding a header to said packet including a reverse link and a data

¹ See Reexamination Certificate US 6,249,516 C1 (Ex. 1001, 58–60).

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