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Paper No. 37
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMERSON ELECTRIC CO.,
Petitioner,

v.

IP CO., LLC,
Patent Owner.

Case IPR2017-00252
Patent 8,000,314 B2

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

WHITE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Emerson Electric Co. ("Petitioner") filed a Petition (Paper 2, "Pet.") seeking to institute an *inter partes* review of claims 1, 4, 10, 11, and 15–19 of U.S. Patent No. 8,000,314 B2 (Ex. 1001, "the '314 patent") pursuant to 35 U.S.C. §§ 311–319. IP Co., LLC ("Patent Owner") filed a Preliminary Response. Paper 6. Based on our review of these submissions and associated evidence, we instituted *inter partes* review of claims 1 and 4 of the '314 patent. Paper 7 ("Dec."). Subsequently, the Supreme Court held that under 35 U.S.C. § 314 the Board may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1352–53 (2018). The parties filed a Joint Motion to Limit the Petition, and by that motion the parties sought to limit this proceeding to the claims and grounds upon which *inter partes* review initially had been instituted. Paper 35. We granted the Joint Motion (Paper 36) and thereby permitted the parties to limit this proceeding to the following claims and grounds:

References	Claim Challenged
Jubin[1] and Fifer[2]	1

[1] John Jubin & Janet D. Tornow, *The DARPA Packet Radio Network Protocols*, Proceedings of the IEEE, Vol. 75, No. 1, Jan. 1987 (Ex. 1003, "Jubin").

[2] William C. Fifer & Frederick J. Bruno, "The Low-Cost Packet Radio," Proceedings of the IEEE, Vol. 75, No. 1, January 1987 (Ex. 1004, "Fifer").

References	Claim Challenged
Jubin, Fifer, APA,[3] and Cerf[4]	4
Kahn,[5] Burchfiel,[6] Schwartz, and Cerf	4

Id. at 2–3.

Patent Owner filed a Patent Owner's Response (Paper 14, "PO Resp."), and Petitioner filed a Reply (Paper 25, "Reply"). An oral hearing was held on February 5, 2018. Paper 33 ("Tr.").

We have jurisdiction under 35 U.S.C. § 318(a). For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that claims 1 and 4 of the '314 patent are unpatentable.

B. Related Proceedings

We have been informed that *SIPCO, LLC, v. Emerson Electric Co.*, No. 6:15-cv-00907-JRG-KNM (E.D. Tex.), which has been transferred to the Northern District of Georgia and consolidated with Civil Action No. 1:15-cv-0319-AT (N.D. Ga.), may be impacted by this proceeding. Paper 3, Paper 23. In addition, the '314 patent was the subject of an *inter partes* review involving the same parties. *Emerson Electric Co., v. IPCO, LLC*,

[3] Petitioner relies upon the disclosures found in column 7, lines 33 through 37 of the '314 patent as Admitted Prior Art ("APA"). *See* Pet. 26.

[4] Vinton G. Cerf & Peter T. Kirstein, *Issues in Packet-Network Interconnection*, Proceedings of the IEEE, Vol. 66, No. 11, Nov. 1978 (Ex. 1008, "Cerf").

[5] Robert E. Kahn, *Advances in Packet Radio Network Protocols*, Proceedings of the IEEE, Vol. 66, No. 11, Nov. 1978 (Ex. 1006, "Kahn").

[6] J. Burchfiel et al., *Functions and structure of a packet radio station*, National Computer Conference presented paper, 1975 (Ex. 1007, "Burchfiel").

Case IPR2015-01901, slip op. at 32 (PTAB Mar. 8, 2017) (Paper 28) (holding claims 10 and 12–19 to be unpatentable). The final written decision in that proceeding is under appeal. IPR2015-01901, Paper 29. In addition, Petitioner has filed a number of other petitions for *inter partes* review directed to related patents. Papers 23, 24.

C. The '314 Patent

The '314 patent describes a digital computer network. Ex. 1001, 1:13–15. This network is depicted in Figure 1, which is reproduced below.

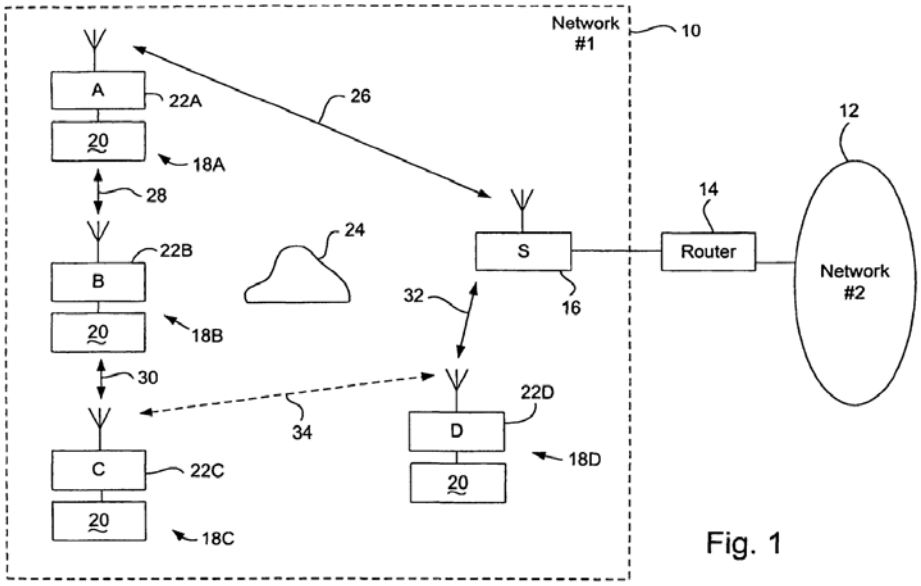

Fig. 1

Figure 1 shows wireless network 10 that is in communication with second network 12. *Id.* at 7:18–22. Wireless network 10 includes one or more servers 16 that may act as a gateway between the two networks. *Id.* at 7:42–46. Servers include a digital controller that "maintains a map of the links of the first network and provides a map to the first network clients on request." *Id.* at 5:53–55. The network also includes any number of clients 18. *Id.* at 7:64–67. Servers implement processes for receiving and transmitting data packets from the clients. *Id.* at 5:6–9. Clients implement processes for receiving and transmitting data packets to and from the server and other

clients. *Id.* at 5:9–11. "Preferably, the client process of each of the clients initiates, selects, and maintains a radio transmission path ('link') to the server . . . [and] also constantly searches for improved paths to the server." *Id.* at 5:11–15, 5:19–21.

D. Instituted Claims

We instituted *inter partes* review of claims 1 and 4, which are reproduced below.

1. A wireless network system comprising:

a first node including a first node controller and a first node radio modem, said first node controller implementing a first node process that includes controlling said first node radio modem, said first node process including receiving and transmitting data packets via said first node radio modem;

a plurality of second nodes each including a second node controller and a second node radio modem, said second node controller implementing a second node process that includes controlling of said second node radio modem, said second node process including receiving and transmitting data packets via said second node radio modem, wherein said second node process of each of said second nodes includes selecting a radio transmission path to said first node that is direct or through at least one of the remainder of said plurality of second nodes; and

wherein said selected path to said first node utilizes the least number of other second nodes, such that said transmission path from each of said second nodes to said first node is optimized and the first node controller implements changes to upgrade the selected transmission path in response to a request from at least one of said second nodes.

Ex. 1001, 22:56–23:13.

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