

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZURN INDUSTRIES, LLC,
Petitioner,

v.

SIOUX CHIEF MFG. CO., INC.,
Patent Owner.

Case IPR2018-00975
Patent 8,347,906 B1

Before RAE LYNN P. GUEST, TINA E. HULSE, and
AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

Zurn Industries, LLC (“Petitioner”) filed a Petition requesting *inter partes* review of claims 14–29 of U.S. Patent No. 8,347,906 B1 (Ex. 1001, “the ’906 patent”). Paper 1 (“Pet.”). Sioux Chief Mfg. Co., Inc. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). An *inter partes* review may be instituted only upon a showing that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). After considering the Petition, Preliminary Response, Petitioner’s Reply to the Patent Owner’s Preliminary Response (Paper 7, “Reply”), Patent Owner’s Sur Reply to Petitioner’s Reply (Paper 8, “Surreply”) and the evidence of record, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim challenged in the Petition. Accordingly, we institute an *inter partes* review.

On April 24, 2018, the Supreme Court held that a final written decision under 35 U.S.C. § 318(a) must decide the patentability of all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1360 (2018); *see Adidas AG v. Nike, Inc.*, 894 F.3d 1256, 1258 (Fed. Cir. 2018) (remanding for consideration of all challenged claims and asserted grounds set forth in the petition); *see also* USPTO, *Guidance on the impact of SAS on AIA trial proceedings* (Apr. 26, 2018), <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial> (“the PTAB will institute as to all claims or none [and] if the

PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.”). Accordingly, we institute *inter partes* review on all of the challenged claims and based on all of the grounds identified in the Petition.

The following findings of fact and conclusions of law are not final, but are made for the purpose of determining whether Petitioner meets the threshold for initiating review. Any final decision shall be based on the full trial record, including any response timely filed by Patent Owner. Arguments not raised by Patent Owner in a timely filed response may be deemed waived, even if they were presented in the Preliminary Response.

A. *Related Proceedings*

The Petitioner identifies a concurrently filed petition for *inter partes* review, IPR2018-00973, as a related proceeding, in addition to a district court litigation styled *Sioux Chief Mfg. Co., Inc. v. Zurn Indus., LLC and Rexnord Corporation*, Case No. 1:18-cv-00163 (D. Del.). Pet. 1.

B. *The '906 Patent (Ex. 1001)*

The '906 patent is titled “Floor Drain Installation System.” Ex. 1001, 1:1. The '906 patent describes a floor drain installation system and methods for “installing inlet or outlet type utility fixtures such as drains or cleanouts.” *Id.* at 2:25–26. The installation system includes an adapter attached to conduit (or piping) and a coring sleeve. *Id.* at 2:26–28. The coring sleeve is configured to receive a plug or cover to seal the coring sleeve during a concrete pour. *Id.* at 2:29–51 (describing a plug or cap), 14:37–40 (describing a “circular or disc shaped cover”). The plug and cover are sized to cover the bowl cavity of the coring sleeve and extend generally flush with

an upper edge of the bowl. *Id.* at 16:3–7 (claim 1), 17:8–15 (claim 10), 17:55–59 (claim 14), 18:55–60 (claim 21), 19:36–40 (claim 25), and 20:34–39 (claim 29). The coring sleeve is threaded and further configured to receive a utility fixture, such as a drain head, which may be raised or lowered so that the fixture is flush with the finished concrete slab. *Id.* 2:46–51. By way of example, Figures 1 and 2 of the '906 patent are reproduced below.

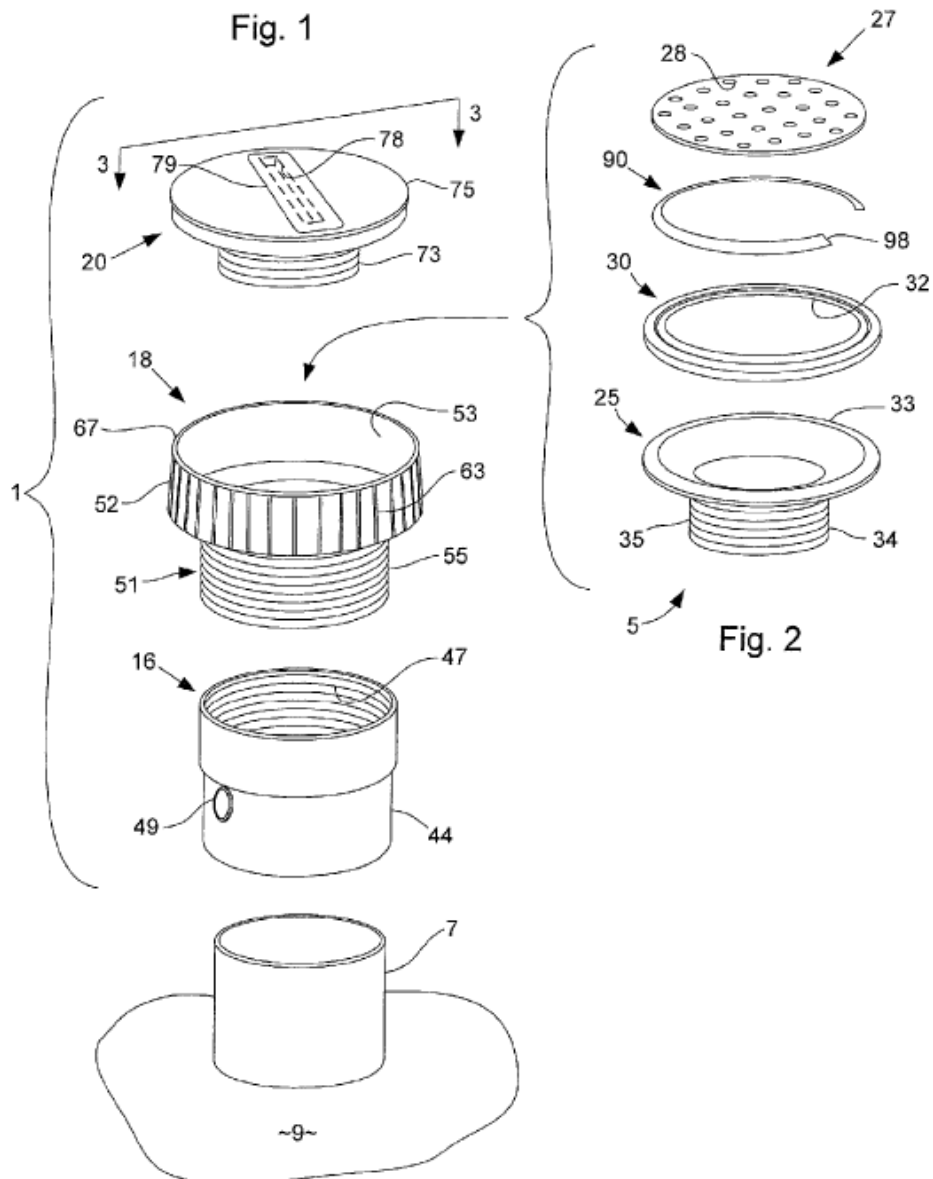


Figure 1 depicts an exploded illustration of the claimed utility access fixture installation system using the “plug” embodiment. As shown in Figure 1, the system includes an adapter 16 that may be attached to both the drain pipe 7 and the utility access fixture, including coring sleeve 18 and plug 20. *Id.* at 4:33–62. Figure 2 depicts an exploded illustration of a floor drain 5 that may be inserted into the coring sleeve to provide a utility access fixture that is flush with the finished floor. *Id.* at 4:41–66

C. Illustrative Claims

Claims 14, 21, 25, and 29 are the independent claims subject to the instant *inter partes* review. Claims 14 and 21 are illustrative of the claimed subject matter and are reproduced below:

14. A method of installing a utility access fixture on a conduit in a slab of poured material, the utility access fixture having an externally threaded cylindrical stem and a head projecting radially outward from an upper end of the stem, the method comprising the steps of:

a) connecting a coring sleeve to the conduit, the coring sleeve having a bowl formed at an upper end thereof and projecting radially outward from a lower, internally threaded coring sleeve stem, the bowl defining a bowl cavity;

b) installing a utility access fixture in the coring sleeve by threading the externally threaded stem of the utility access fixture into the internally threaded coring sleeve stem such that the head of the utility access fixture is received within the bowl cavity of the coring sleeve;

c) securing a cover over the utility access fixture, the cover sized such that an upper surface of the cover extends generally flush with an upper edge of the bowl and covers the bowl cavity;

d) pouring the poured material around said conduit;

e) finishing the poured material to a level generally flush with said upper surface of the cover to form the slab, the bowl

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