

No. 18-88

IN THE
Supreme Court of the United States

RICHARD GRAMM,

Petitioner,

v.

DEERE & COMPANY,

Respondent.

**On Petition for a Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit**

BRIEF IN OPPOSITION

Gary M. Ropski
(*Counsel of Record*)
Jeffrey M. Nichols
Laura A. Lydigsen
Joshua H. James
Jafon L. Fearson
BRINKS GILSON & LIONE
455 N. Cityfront Plaza Dr.
Chicago, IL 60611
(312) 321-4200
gropski@brinksgilson.com

August 17, 2018

Counsel for Respondent

QUESTION PRESENTED

Deere petitioned for two *inter partes* reviews (“IPRs”) of claims 1-34 of U.S. Patent No. 6,202,395 (the “395 patent”). The U.S. Patent & Trademark Office (“USPTO”) granted the petitions with respect to claims 1-11 and 27-34 and found these claims unpatentable. The Federal Circuit affirmed. Separately, Deere had requested *ex parte* reexamination of claims 12-26. The USPTO granted this request and found these claims unpatentable as well. Gramm now seeks remand of the IPRs to consider non-instituted claims 12-26 in view of this Court’s decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), even though these claims have already been held unpatentable in the separate reexamination proceeding and Deere (as Petitioner in the IPRs) does not seek remand to consider these claims in the IPRs. Gramm’s Petition to this Court, therefore, presents the following question:

Whether this Court should decline to grant *certiorari*, vacate, and remand the Federal Circuit’s affirmance of the USPTO’s final written decisions finding claims 1-11 and 27-34 of the ’395 patent unpatentable on the basis that the IPRs were not instituted regarding claims 12-26, when claims 12-26 have already been found unpatentable by the USPTO in a separate reexamination proceeding and Deere (as Petitioner in the IPRs) does not seek remand to address claims 12-26 in the IPRs.

RULE 29.6 STATEMENT

Respondent Deere & Company has no parent corporation, and no publicly held company owns 10% or more of its stock.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
RULE 29.6 STATEMENT	ii
TABLE OF CONTENTS.....	iii
TABLE OF AUTHORITIES	iv
INTRODUCTION	1
STATUTORY PROVISIONS AND REGULATIONS INVOLVED	3
COUNTER-STATEMENT OF THE CASE.....	4
I. <i>DISTRICT COURT LITIGATION</i>	4
II. <i>INTER PARTES REVIEWS</i>	4
III. <i>REEXAMINATION</i>	6
REASONS FOR DENYING THE PETITION	7
I. <i>LAWRENCE REQUIREMENT #1 IS NOT SATISFIED, BECAUSE THE DECISIONS BELOW DO NOT “REST UPON A PREMISE” OVERTURNED BY SAS</i>	8
II. <i>LAWRENCE REQUIREMENT #2 IS NOT SATISFIED, BECAUSE ANY REMAND WOULD NOT CHANGE “THE ULTIMATE OUTCOME OF THE LITIGATION”</i>	9
III. <i>LAWRENCE REQUIREMENT #3 IS NOT SATISFIED, BECAUSE “THE EQUITIES OF THE CASE” SUPPORT DEERE, NOT GRAMM</i>	13
CONCLUSION	14

TABLE OF AUTHORITIES

Cases

<i>Argentum Pharms. LLC v. Research Corp. Tech., Inc.</i> , IPR2016-00204 (P.T.A.B. Sept. 19, 2016).....	10
<i>BASF Corp. v. Iancu</i> , No. 2017-1425, 2018 U.S. App. Lexis 20048 (Fed. Cir. July 17, 2018)	9
<i>Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.</i> , 402 U.S. 313 (1971)	10
<i>Fresenius USA, Inc. v. Baxter Int’l, Inc.</i> , 721 F.3d 1330 (Fed. Cir. 2013)	10
<i>Gramm v. Deere & Co.</i> , No. 2017-1252 (Fed. Cir. July 26, 2018).....	5, 9
<i>Kingston Tech. Co. v. Polaris Innovations Ltd.</i> , IPR2016-01622 (P.T.A.B. June 11, 2018)	13
<i>Lawrence v. Chater</i> , 516 U.S. 163 (1996)	passim
<i>One World Techs., Inc. v. Chamberlain Grp., Inc.</i> , IPR2017-01137 (P.T.A.B. May 17, 2018)	13
<i>Ooma, Inc. v. Deep Green Wireless LLC</i> , IPR2017- 01541 (P.T.A.B. May 29, 2018)	12-13
<i>PGS Geophysical AS v. Iancu</i> , 891 F.3d 1354 (Fed. Cir. 2018)	9, 11

<i>Polaris Indus. Inc. v. Arctic Cat, Inc.</i> , 724 F. App'x 948 (Fed. Cir. 2018)	12
<i>SAS Institute, Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018)	passim
<i>Shinseki v. Sanders</i> , 556 U.S. 396 (2009)	11
<i>Suntec Indus. Co. v. United States</i> , 857 F.3d 1363 (Fed. Cir. 2017)	11
<i>Teradata Operations, Inc. v. Realtime Data LLC</i> , IPR2017-00557 (P.T.A.B. June 25, 2018)	13
<i>Ulthera, Inc. v. DermaFocus LLC</i> , No. 2018-1542, 2018 U.S. App. Lexis 21627 (Fed. Cir. May 25, 2018).....	12
<i>Unified Patents Inc. v. Collision Avoidance Techs.</i> <i>Inc.</i> , IPR2017-01355 (P.T.A.B. May 29, 2018)	12

Statutes

35 U.S.C. § 103.....	6, 10
35 U.S.C. § 315.....	11
5 U.S.C. § 706.....	11

Other Authorities

MPEP § 2210.....	12
------------------	----

MPEP § 2254.....	6, 11
------------------	-------

Rules

Fed. Cir. R. 36	5
-----------------------	---

Sup. Ct. R. 29.6	ii
------------------------	----

Regulations

37 C.F.R. § 1.550.....	6, 11
------------------------	-------

37 C.F.R. § 42.71	14
-------------------------	----

Briefs

Br. Opp'n, <i>Apotex, Inc. v. Syntex (U.S.A.) LLC</i> , 552 U.S. 887 (2007) (No. 07-35), 2007 U.S. S. Ct. Briefs Lexis 2386	7
---	---

Br. Opp'n, <i>Apple, Inc. v. Ancora Techs., Inc.</i> , 135 S. Ct. 957 (2015) (No. 14-469), 2014 U.S. S. Ct. Briefs Lexis 4074	7
---	---

Mot. Recall Mandate, <i>Gramm v. Deere & Co.</i> , No. 2017-1252 (Fed. Cir. July 12, 2018), ECF No. 61	5, 8-9
--	--------

Opp'n Mot. Recall Mandate Ex. F, <i>Gramm v. Deere & Co.</i> , No. 2017-1252 (Fed. Cir. July 23, 2018), ECF No. 64-8	7, 10
---	-------

INTRODUCTION

Gramm requests that this Court grant *certiorari*, vacate, and remand (“GVR”) the Federal Circuit’s *per curiam* affirmance of the USPTO’s final written decisions in two IPRs finding claims 1-11 and 27-34 of the ’395 patent unpatentable, because the USPTO did not institute review of claims 12-26 in the IPRs. According to *Lawrence v. Chater*, this Court’s “GVR power should be exercised sparingly.” 516 U.S. 163, 173 (1996). As discussed below, the present circumstances do not justify this rare relief.

Lawrence lists three requirements that must be satisfied before this Court will consider exercising its GVR power, none of which is met here. *Id.* at 167-68. First, Gramm cannot show that “intervening developments, or recent developments that [this Court has] reason to believe the court below did not fully consider, reveal a reasonable probability that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration.” *Id.* at 167. This Court’s *SAS* decision is tangential to any outcome determinative issue here. Claims 1-11 and 27-34 were instituted and held unpatentable by the USPTO, and the Federal Circuit affirmed this holding. *SAS* only addresses non-instituted claims. *See* 138 S. Ct. at 1360. It does not address instituted claims like claims 1-11 and 27-34. Thus, *SAS* does not impact any premise upon which the decisions below regarding claims 1-11 and 27-34 were based.

As for non-instituted claims 12-26, the Federal Circuit already had an opportunity to consider

whether its decision rested upon a premise that it would reject based on SAS, in response to Gramm's recent motion to recall the mandate and remand in view of SAS. The Federal Circuit denied the motion. There is no reason to believe that there would be any different result after GVR.

Second, Gramm cannot show "that such a redetermination may determine the ultimate outcome of the litigation." *Lawrence*, 516 U.S. at 167. Here, it would be an academic exercise to remand to consider the unpatentability of claims 12-26 in the IPRs, because these claims have already been held unpatentable in a separate patent reexamination proceeding at the USPTO. The bell of the patent reexamination proceeding cannot be unrung, even if the IPR proceedings are remanded. SAS does not impact patent reexamination proceedings.

Gramm further ignores that under SAS, "it's the petitioner [Deere, here] who gets to define the contours of the proceeding" in an IPR. 138 S. Ct. at 1355. Deere does not seek remand of the IPRs to address claims 12-26. Moreover, even if the IPRs were remanded, Deere could attempt to limit them by withdrawing claims 12-26 from the IPRs. With claims 12-26 withdrawn, this Court's SAS decision would not be applicable, because all of the challenged claims (claims 1-11 and 27-34) would have been instituted and held unpatentable.

Third, "the equities of the case" must be considered to determine "[w]hether a GVR order is ultimately appropriate." *Lawrence*, 516 U.S. at 167-68. Here, the equities support Deere, rather than Gramm. Claims 12-26 have already been found

unpatentable by the USPTO in the separate patent reexamination proceeding. Accordingly, it would not be a productive use of the resources of either Deere or the USPTO to address claims 12-26 again in the IPRs after a GVR. Also, Gramm has been content with the non-institution of claims 12-26 until now. Gramm should not be allowed to abandon his support for the non-institution of claims 12-26, especially given that the Federal Circuit's mandate has issued.

Gramm cannot satisfy a single *Lawrence* requirement, let alone all three. Gramm's petition for a writ of *certiorari* should be denied.

STATUTORY PROVISIONS AND REGULATIONS INVOLVED

In addition to the statutory provisions and regulations identified by Gramm, (*see* Dkt. 1 at 2-4), Deere identifies the following statutory provisions and regulations:

***37 C.F.R. § 1.550* — CONDUCT OF *EX PARTE* REEXAMINATION PROCEEDINGS**

(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:

(1) in accordance with § 1.510 or § 1.535; or

(2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.

37 C.F.R. § 42.71 — DECISION ON PETITIONS OR MOTIONS

(c) Petition decisions

A decision by the Board on whether to institute a trial is final and nonappealable. A party may request rehearing on a decision by the Board on whether to institute a trial pursuant to paragraph (d) of this section. When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.

COUNTER-STATEMENT OF THE CASE

I. DISTRICT COURT LITIGATION

Gramm filed a complaint for patent infringement against Deere on March 21, 2014 and an amended complaint on June 19, 2014. Gramm has asserted claims 1, 6-9, 12, 18, 20-22, 25, and 27 of the '395 patent. On September 12, 2016, the district court stayed the litigation in view of the USPTO's institution of two IPRs of the '395 patent. The district court litigation remains stayed.

II. INTER PARTES REVIEWS

Deere's IPR petitions, filed on March 20, 2015, requested review of claims 1-34 of the '395 patent. The USPTO instituted review with respect to claims 1-11 and 27-34 on September 23, 2015, and ultimately

found all of those claims unpatentable in two final written decisions issued on September 22, 2016.

Gramm appealed the USPTO's decisions to the Federal Circuit, which consolidated them for briefing and argument and issued a summary affirmance without opinion, pursuant to Fed. Cir. R. 36, on February 13, 2018. Gramm petitioned for rehearing *en banc*, which was denied *per curiam* on April 17, 2018. The Federal Circuit's mandate issued on April 24, 2018 at 9:09 AM ET, the same day (but shortly before) this Court's decision in *SAS*.

In *SAS*, this Court established that the Petitioner is the “master of its complaint” in IPR proceedings. 138 S. Ct. at 1355. As such, it is “the petitioner’s contentions [that] define the scope of the litigation all the way from institution through to conclusion” – not the USPTO’s discretion. *Id.* at 1357. *SAS* did not hold that remand of a partially instituted proceeding is necessary after a mandate has already been issued, nor has the Federal Circuit remanded a case post-mandate in view of *SAS*.

Gramm filed a Motion to Recall the Mandate, which requested the same relief that Gramm now seeks with his petition for a writ of *certiorari*. See Mot. Recall Mandate, *Gramm v. Deere & Co.*, No. 2017-1252 (Fed. Cir. July 12, 2018), ECF No. 61. The Federal Circuit denied *per curiam* Gramm’s motion on July 26, 2018. *Gramm v. Deere & Co.*, No. 2017-1252 (Fed. Cir. July 26, 2018).

III. REEXAMINATION

After the USPTO's final written decisions were issued in the IPRs, and well more than a year before the SAS decision and the Federal Circuit's mandate ever issued, on November 30, 2016, Deere filed a request for *ex parte* reexamination of claims 12-26 of the '395 patent. Per USPTO rules, Deere has not had any further involvement in the reexamination since the reexamination was ordered. 37 C.F.R. § 1.550(g) ("The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered."); Manual of Patent Examining Procedure ("MPEP") § 2254 ("Once *ex parte* reexamination is ordered pursuant to 35 U.S.C. 304 and the times for submitting any responses to the order have expired, no further active participation by a third party reexamination requester is allowed . . .").

During the reexamination proceedings, the USPTO has held claims 12-26 unpatentable under 35 U.S.C. § 103, including in:

- a first office action on May 11, 2017;
- a final office action on September 12, 2017;
- an after-final advisory action on November 24, 2017; and
- the examiner's answer to Gramm's appeal brief on April 6, 2018.¹

¹ The reexamination is fully briefed on appeal. A decision is expected by early 2019.

See Opp’n Mot. Recall Mandate Ex. F, *Gramm v. Deere & Co.*, No. 2017-1252 (Fed. Cir. July 23, 2018), ECF No. 64-8.

REASONS FOR DENYING THE PETITION

Contrary to Gramm’s arguments, changes in the law are insufficient alone to justify GVR. *See, e.g.*, Br. Opp’n, *Apple, Inc. v. Ancora Techs., Inc.*, 135 S. Ct. 957 (2015) (No. 14-469), 2014 U.S. S. Ct. Briefs Lexis 4074 (denying GVR despite change in patent invalidity law); Br. Opp’n, *Apotex, Inc. v. Syntex (U.S.A.) LLC*, 552 U.S. 887 (2007) (No. 07-35), 2007 U.S. S. Ct. Briefs Lexis 2386 (denying GVR despite change in patent obviousness law). Rather, this Court’s “GVR power should be exercised sparingly . . . Respect for lower courts, the public interest in finality of judgments, and concern about [this Court’s] expanding certiorari docket all counsel against undisciplined GVR’ing.” *Lawrence*, 516 U.S. at 173-74. According to *Lawrence*, this rare relief should only be considered when all three of the following requirements are satisfied:

Where [1] intervening developments, or recent developments that [this Court has] reason to believe the court below did not fully consider, reveal a reasonable probability that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration, and [2] where it appears that such a redetermination may determine the ultimate outcome of the litigation, a GVR order is . . . potentially appropriate. [3] Whether a GVR order is ultimately

appropriate depends further on the equities of the case

Id. at 167-68. None of these requirements is satisfied here, as further discussed below.

I. *LAWRENCE REQUIREMENT #1 IS NOT SATISFIED, BECAUSE THE DECISIONS BELOW DO NOT “REST UPON A PREMISE” OVERTURNED BY SAS*

Gramm has not satisfied *Lawrence* requirement #1, because there is no “reasonable probability that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration.” *See id.* at 167. Claims 1-11 and 27-34 of the ’395 patent have already been instituted and held unpatentable by the USPTO in two final written decisions, and the Federal Circuit already affirmed these holdings. Gramm does not challenge the Federal Circuit’s affirmance regarding these claims or otherwise address the merits of the adverse judgments against Gramm regarding them. Moreover, SAS does not apply to such claims, because they were instituted and resolved. Thus, neither the USPTO’s nor the Federal Circuit’s decisions as to the invalidity of claims 1-11 and 27-34 “rest[] upon a premise” overturned by SAS. *See id.*

With respect to non-instituted claims 12-26, the Federal Circuit already had an opportunity to consider whether its decision rested upon a premise that it would reject based on SAS, in response to Gramm’s recent motion to recall the mandate and remand in view of SAS. *See Mot. Recall Mandate, Gramm*, No.

2017-1252. Gramm’s motion to the Federal Circuit raised the same arguments raised here. *See id.* The Federal *denied* the motion. *Gramm*, No. 2017-1252 (Fed. Cir. July 26, 2018). There is no reason to believe that there would be any different result after GVR.²

II. *LAWRENCE REQUIREMENT #2 IS NOT SATISFIED, BECAUSE ANY REMAND WOULD NOT CHANGE “THE ULTIMATE OUTCOME OF THE LITIGATION”*

Gramm also cannot satisfy *Lawrence* requirement #2, because remand here would not change the “ultimate outcome of the litigation.” *See* 516 U.S. at 167. Gramm does not suggest that a remand would affect the Federal Circuit’s ultimate holding that claims 1-11 and 27-34 are unpatentable. Indeed, he cannot; the USPTO’s non-institution of

² Federal Circuit remands have not been routine as Gramm claims. (*See* Dkt. 1 at 8.) The Federal Circuit has *denied* remand in at least two other appeals involving partial institution of IPRs. *E.g., BASF Corp. v. Iancu*, No. 2017-1425, 2018 U.S. App. Lexis 20048, at *12 (Fed. Cir. July 17, 2018); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1363 (Fed. Cir. 2018).

Further, the Federal Circuit decisions cited by Gramm where the court remanded under *SAS* are not applicable here, because none involved a case where the mandate had already issued. (*See* Dkt. 1 at 11.) As such, remand in those pending appeals did not involve considerations of “[r]espect for lower courts, the public interest in finality of judgments, and concern about [the Supreme Court’s] expanding certiorari docket [which] all counsel against undisciplined GVR’ing.” *See Lawrence*, 516 U.S. at 168, 174.

claims 12-26 in the IPRs has no bearing on the unpatentability of claims 1-11 and 27-34.

Likewise, it would be an academic exercise to remand for the USPTO to consider the unpatentability of claims 12-26 in the IPRs. Those claims have already been held unpatentable as obvious under 35 U.S.C. § 103 in a separate patent reexamination proceeding at the USPTO.³ See Opp’n Mot. Recall Mandate Ex. F, *Gramm*, No. 2017-1252. A holding of invalidity in one proceeding applies to all proceedings. See *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 350 (1971) (holding that an invalidity determination in one proceeding applies in all proceedings); see also *Fresenius USA, Inc. v. Baxter Int’l, Inc.*, 721 F.3d 1330, 1340 (Fed. Cir. 2013) (“[W]hen a claim is cancelled, the patentee loses any cause of action based on that claim,

³ It is not uncommon to challenge a patent’s claims through multiple procedures, such as a challenge in an IPR and a separate challenge in a patent reexamination proceeding. See, e.g., *Argentum Pharms. LLC v. Research Corp. Tech., Inc.*, IPR2016-00204, slip op. at 2-4 (P.T.A.B. Sept. 19, 2016) (declining to consolidate IPR and reexamination proceedings concerning the same patent where proceedings “address[ed] different issues . . . as well as different combinations of primary references,” and acknowledging that “different statutes . . . different rules and statutory deadlines” create “an inherent tension in attempting to unify proceedings that . . . are intended to be distinct in type from one another.”). This Court’s *SAS* decision addresses non-instituted claims in an IPR, and does not apply to patent reexamination proceedings, which involve a different statute. 138 S. Ct. at 1360.

and any pending litigation in which the claims are asserted becomes moot.”).⁴

Contrary to Gramm’s arguments, the ultimate outcome would not be affected by estoppel. (See Dkt. 1 at 13-15.) Estoppel only applies to claims in an IPR that are the subject of “a final written decision.” 35 U.S.C. § 315(e)(1).⁵ No final written decision has been issued with respect to claims 12-26. Thus, no estoppel applied to Deere when it requested the reexamination on November 30, 2016. Also, given the *ex parte* nature of the reexamination, Deere has not been involved in the reexamination proceeding since 2016 and will not be involved going forward. See 37 C.F.R. § 1.550(g); MPEP § 2254. Even if Deere were later estopped under 35 U.S.C. § 315(e)(1) from “request[ing] or maintain[ing] a proceeding before the [USPTO]”

⁴ Gramm argues that SAS cites to 5 U.S.C. § 706 when characterizing partial institution as *ultra vires*. (Dkt. 1 at 11.) However, “errors under that provision are generally subject to a traditional harmless-error analysis, with challengers of the agency action having the burden of showing prejudice.” *PGS*, 891 F.3d at 1362 (citing *Shinseki v. Sanders*, 556 U.S. 396, 406, 409 (2009) and *Suntec Indus. Co. v. United States*, 857 F.3d 1363, 1368 (Fed. Cir. 2017)). Here, there was no prejudice to Gramm for the reasons discussed herein.

⁵ Gramm also mentions estoppel that may apply in the district court based on 35 U.S.C. § 315(e)(2). (Dkt. 1 at 14.) Estoppel there, however, would be limited to those grounds that were “raised or reasonably could have [been] raised during that [IPR].” 35 U.S.C. § 315(e)(2). Other invalidity grounds, including grounds based on indefiniteness, lack of written description, and prior art that could not have been raised in the IPRs, could be raised in the district court.

regarding claims 12-26, that estoppel *would not impact* the reexamination. The USPTO will maintain the reexamination without Deere’s involvement. *See, e.g.,* MPEP § 2210 (“After the request for reexamination . . . is received in the [USPTO], no abandonment, withdrawal, or striking of the request is possible, regardless of who requests the same.”).

Notably, Deere does not seek remand of claims 12-26 in the IPRs, because these claims are already being addressed in the separate patent reexamination proceeding, as discussed above. According to SAS, “it’s the petitioner [Deere, here] who gets to define the contours of the proceeding” in an IPR, and “the petitioner’s contentions . . . define the scope of the litigation.”⁶ 138 S. Ct. at 1355, 1357. Thus, Deere’s decision not to seek remand of claims 12-26 should be credited over Gramm’s attempts to do the opposite.

Moreover, even if the IPRs were remanded to address claims 12-26, Deere could attempt to withdraw these claims from the proceedings.⁷ If

⁶ The *Polaris* Federal Circuit decision cited by Gramm and suggesting that a patent owner has an interest in defining the scope of the litigation is both non-precedential and ignores the reasoning of SAS. *See Polaris Indus. Inc. v. Arctic Cat, Inc.*, 724 F. App’x 948, 949 (Fed. Cir. 2018). The *Ulthera* remand order, on the other hand, emphasized that the petitioner requested remand. *Ulthera, Inc. v. DermaFocus LLC*, No. 2018-1542, 2018 U.S. App. Lexis 21627, at *3-4 (Fed. Cir. May 25, 2018) (non-precedential).

⁷ *See Unified Patents Inc. v. Collision Avoidance Techs. Inc.*, IPR2017-01355 (P.T.A.B. May 29, 2018) (granting motion to withdraw claims newly instituted in view of SAS); *see also Ooma*,

claims 12-26 were withdrawn from the IPRs, this Court's SAS decision would not affect the ultimate outcome. All of the challenged claims (claims 1-11 and 27-34) would have been instituted and held unpatentable. And even if claims 12-26 were not withdrawn after a remand (and the patent reexamination proceeding was ignored), history shows that the USPTO has held claims unpatentable in an IPR even after the USPTO initially denied institution of those claims. *See Kingston Tech. Co. v. Polaris Innovations Ltd.*, IPR2016-01622, slip op. at 10-14 (P.T.A.B. June 11, 2018) (instituting claim after SAS that the USPTO previously did not institute, and holding that newly instituted claim unpatentable); *see also Teradata Operations, Inc. v. Realtime Data LLC*, IPR2017-00557, slip op. at 2, 49-54 (P.T.A.B. June 25, 2018) (instituting ground after SAS that the USPTO previously did not institute, and finding claims unpatentable based on that ground). There is no reason to expect a different outcome here.

III. LAWRENCE REQUIREMENT #3 IS NOT SATISFIED, BECAUSE "THE EQUITIES OF THE CASE" SUPPORT DEERE, NOT GRAMM

The equities support Deere, rather than Gramm. Claims 12-26 have already been found unpatentable by the USPTO in the separate patent reexamination proceeding. Accordingly, it would not

Inc. v. Deep Green Wireless LLC, IPR2017-01541 (P.T.A.B. May 29, 2018) (granting motion to withdraw grounds newly instituted in view of SAS); *One World Techs., Inc. v. Chamberlain Grp., Inc.*, IPR2017-01137 (P.T.A.B. May 17, 2018) (same).

be a productive use of the resources of either Deere or the USPTO to address claims 12-26 again in the IPRs after a GVR. “[T]he delay and further cost entailed in a remand are not justified by the potential benefits of further consideration by the lower court” *Lawrence*, 516 U.S. at 168. As a result, “a GVR order is inappropriate.” *Id.*

Additionally, the equities do not favor Gramm’s efforts to change his strategy regarding claims 12-26. When claims 12-26 were not instituted in the IPRs, Gramm was perfectly content with the institution decisions – they shielded those claims from *inter partes* review. Gramm never sought reconsideration of the institution decisions during the IPRs. 37 C.F.R. § 42.71(c) (“A party may request rehearing on a decision by the Board on whether to institute a trial”). Gramm only seeks remand regarding claims 12-26 now, because the USPTO found these claims unpatentable in the separate reexamination proceeding. Because Deere has pursued the IPRs to their natural end and obtained a mandate from the Federal Circuit, it would be inequitable to allow Gramm to change his strategy with respect to claims 12-26 and reopen the IPRs to address claims that Deere opted to pursue through the reexamination.

CONCLUSION

The petition for a writ of *certiorari* does not present an issue worthy of this Court’s discretionary review. It should be denied, including Petitioner’s request for a GVR.

August 17, 2018

Respectfully Submitted,

Gary M. Ropski (*Counsel of
Record*)

Jeffry M. Nichols

Laura A. Lydigsen

Joshua H. James

Jafon L. Fearson

BRINKS GILSON & LIONE

455 N. Cityfront Plaza Dr.

Chicago, IL 60611

(312) 321-4200

gropski@brinksgilson.com

*Counsel for Respondent Deere
& Company*