

IN THE  
**Supreme Court of the United States**

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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**

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**SUPPLEMENTAL BRIEF OF THE RESPONDENT**

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## TABLE OF AUTHORITIES

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## SUPPLEMENTAL BRIEF

Pursuant to Supreme Court Rule 15.8, Respondent Deere & Company files this brief to apprise the Court of a development subsequent to the filing of Deere's Opposition brief.

1. On August 31, 2018, two weeks after Deere filed its Opposition brief, the Patent Trial and Appeal Board ("PTAB") of the U.S. Patent and Trademark Office ("USPTO") issued a Decision on Appeal reversing the patent examiner's rejection of claims 12-26 of U.S. Patent No. 6,202,395 ("the '395 Patent"). *See* Patent Board Decision, *Ex Parte* Reexamination of U.S. Patent No. 6,202,395, Control No. 90/013,868 (Aug. 31, 2018).

2. Deere's Opposition framed the question presented in this appeal as follows: "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." Resp't Opp'n at i.

3. Deere's arguments that none of the *Lawrence* requirements are met here remain valid notwithstanding the PTAB's decision. *See, e.g.*, Resp't

Opp'n at 2 (“[U]nder SAS, ‘it’s the petitioner [Deere, here] who gets to define the contours of the proceeding’ in an IPR . . . Deere does not seek remand of the IPRs to address claims 12-26.”); *id.* at 2 (“[E]ven 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 With claims 12-26 withdrawn, this Court’s SAS decision would not be applicable, because all of the challenged claims (claims 1-11 and 27-34) would have been instituted and held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.”); *id.* at 7 (“changes in the law are insufficient alone to justify GVR”); *id.* at 8 (“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.”); *id.* at 9-10 (“the USPTO’s non-institution of claims 12-26 in the IPRs has no bearing on the unpatentability of claims 1-11 and 27-34.”); *id.* at 11 (“the ultimate outcome would not be affected by estoppel.”); *id.* at 11 n.4 (“there was no prejudice to Gramm”); *id.* at 12 (“Deere’s decision not to seek remand of claims 12-26 should be credited over Gramm’s attempts to do the opposite.”); *id.* at 13 (“The equities support Deere, rather than Gramm.”).

4. Further, the PTAB’s reversal does not end the inquiry into the unpatentability of claims 12-26 during the reexamination. In its decision, the PTAB found that the particular articulation of the rationale for combining the prior art relied on by the Examiner in finding claims 12-26 obvious was not adequate. Patent Board Decision at 8. Claims 12-26 may again be rejected by the Examiner in the reexamination. USPTO rules reflect that post appeal, the

reexamination proceeding is now “up for immediate action by the examiner,” who may still “reopen prosecution . . . for the purpose of entering a new rejection . . . [i]f the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed . . . .” Manual of Patent Examining Procedure (“MPEP”) § 1214.04. Indeed, the PTAB’s August 31, 2018 decision acknowledged that “there may be other rational reasons for providing the biasing spring structure of Pearson in the device resulting from the combination of Lofquist, Chmielewski, and Cleveland . . . .” *See* Patent Board Decision at 8.

## CONCLUSION

The petition for a writ of *certiorari* should be denied, including Petitioner's request for a GVR.

September 20, 2018

Respectfully Submitted,

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