

## CASE STUDY



### Emerson Process Management Co.

#### ST. LOUIS, MOOVERVIEW

In 2015 Automation Middleware Solutions Inc. brought a patent infringement suit in the Eastern District of Texas against multiple leading competitors in the plant process control area. The plaintiff sought damages in the hundreds of millions. The patents had been litigated previously in the Eastern District of Texas against other competitors and had been the subject of prior unsuccessful reexamination and IPR attacks. In short, the plaintiff was operating from a strong position of confidence.

#### Challenges

The plaintiff asserted five patents, each of which were a half-inch thick and each sounding very techy with claims directed to complicated plant process control systems and software. The patent claims used broad, vague language (e.g., “module for...”) giving rise to challenging non-infringement positions. Despite having been the subject of prior USPTO invalidation attempts, one co-defendant filed new IPRs with new art, but those attempts failed. Other defendants focused on patent marking issues to knock down damages. Our team, however, spotted these highly technical-sounding claims for what they were: claims that were dressed up in the argot of invention, but when boiled down, were nothing more than results-oriented claiming. When we raised the prospect of an *Alice* motion, every other co-defendant expressed serious skepticism about how *Alice* could be used to invalidate claims that were so grounded in computer systems and high-tech plant processing equipment.

#### Service

Intellectual Property Litigation

#### Legal Team

Kara R. Fussner  
Rudy Telscher

## Solution

We decided to pursue a 12(b)(6) motion under *Alice* in the Eastern District of Texas. We believed the motion had a chance, but we also believed that by strategically filing one, it would force the plaintiff to better spell out the boundaries of the vague claims to improve potential non-infringement positions. The client approved this aggressive strategy. We then performed substantial technical research to create a record showing that all aspects of the claims were conventional plant-processing activity. The only aspect of the claims that might have been “significantly more” under Step 2 of *Alice* had to do with translating high-level plant process control commands from the application program level to motion-control devices in the plant. A year and a half into the case—and following a lengthy oral argument for the motion—the district court judge ultimately agreed with our position and invalidated all asserted patent claims.

The plaintiff appealed the decision, stressing the technical nature of its claims and correlating its alleged invention to cases like *Enfish* and *Bascom*. The plaintiff argued that the district court, following our lead, incorrectly boiled the claims down to an abstract concept of translation. In contrast, we included many cites to the patent where the specification conceded that most aspects of the plant-processing environment were conventional. We carefully boiled down the “translation” component of the technology to an unspecified method that had only been vaguely claimed.

## Result

The three-judge appellate panel determined that the district court correctly ruled in 2017 that certain claims in four AMS patents were invalid because they claimed nothing more than an abstract idea, delivering a complete defense victory

to our clients and its co-defendants. Our client avoided the potential for a nine-figure jury verdict in the Eastern District of Texas—or even an eight-figure settlement—because we were unwilling to be fooled by the impossibly thick, technical-sounding patents, and saw more where co-defendants did not.