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Paper 16
Entered: February 3, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROBERT BOSCH LLC and DAIMLER AG,
Petitioner,

v.

ORBITAL AUSTRALIA PTY LTD,
Patent Owner.

Case IPR2015-01258 (Patent 5,655,365)
Case IPR2015-01259 (Patent 5,655,365)[1]

Before KEN B. BARRETT, HYUN J. JUNG, and
JEREMY M. PLENZLER, *Administrative Patent Judges.*

BARRETT, *Administrative Patent Judge.*

DECISION
Denying Patent Owner's Requests for Rehearing
37 C.F.R. § 42.71

[1] The parties are not authorized to use a joint caption.

I. INTRODUCTION

On January 13, 2016, Orbital Australia Pty Ltd f/k/a/ Orbital Engine Company (Australia) Pty. Ltd. ("Patent Owner") filed, in IPR2015-01258, a Request for Rehearing (Paper 13) of our Decision (Paper 11, "Dec.") and, in IPR2015-01259, a Request for Rehearing (Paper 11) of our Decision (Paper 9) granting *inter partes* review of U.S. Patent No. 5,655,365 (Ex. 1001 in both cases, "the '365 patent"). Our Decisions granted *inter partes* review of some of Petitioner's challenges to claims 1, 2, 5, 9, 10, 12–14, and 18. The two Requests for Rehearing (collectively, "Request" or "Req. Reh'g") are substantively similar. Unless otherwise indicated, citations herein are to the papers filed in IPR2015-01258.

Patent Owner's Request alleges that the Board misapprehended or overlooked certain matters set forth in Patent Owner's Preliminary Response (Paper 10), and "requests that the Board reconsider its decision with regard to claim construction, as well as deny the Petition with respect to all instituted grounds." Req. Reh'g 1–2. Specifically, Patent Owner's Request alleges that our Decision is based on a misapprehension of Patent Owner's proposed claim construction regarding the "fuelling rate" (Req. Reh'g 3–6), that the Board construes "while said ignition is so retarded" erroneously (*id.* at 6–12), that the Board overlooked Patent Owner's claim construction arguments regarding Petitioner's previous statements concerning the '365 patent (*id.* at 12–13), and that the Decision to instituite a trial is based on an erroneous claim construction "and a misapprehension of or a failure to consider Patent Owner's arguments (*id.* at 14–15).

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in the record. *Id.* When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). With this in mind, we address the arguments presented by Patent Owner in turn.

III. ANALYSIS

Patent Owner argues that "[t]he Decision's claim construction analysis misapprehends Patent Owner's arguments with respect to the meaning of 'fuelling rate' (and thus, 'increasing the fuelling rate')." Req. Reh'g 3.

In the Decisions, we stated:

> Patent Owner impliedly argues that fueling rate refers to quantity per unit-time (i.e. milligrams per second) and that that rate must be increased during each cycle. *See* Prelim. Resp. 28–29. However, claim 1 refers to "fuelling rate" as the quantity of fuel injected in a cylinder during a single cycle not the change in the quantity injected within a given cycle. *See* Ex. 1001, col. 2, ll. 3–4 ("the fuelling rate (measured in mg/cylinder/cycle)"). The language of independent claim 1

> defines the fueling rate level relative to that "when the engine is operating normally." Ex. 1001, col. 6, ll. 11–14.

Dec. 9. In the Requests, Patent Owner clarifies that it is not arguing that "fuelling rate" refers to quanity per unit-time. Req. Reh'g 3. Rather, Patent Owner maintains that its proposed construction of the term "fuelling rate" is consistent with the Board's preliminary construction for that term and is "confirmed in the Decision." *See id.* at 3–4 ("the term 'fuelling rate' is used in the challenged claims and defined by the '365 Patent to refer to the *total* quantity of fuel injected into a cylinder during a given cycle of the engine (i.e., 'measured in mg/cylinder/cycle'), as confirmed in the Decision.") Where Patent Owner's position concerning "fuelling rate" was "confirmed in the Decision," we are not persuaded that any misapprehension in that regard resulted in an abuse of discretion in our decisions to institute *inter partes* reviews.

As to the "increasing" portion of the claim phrase "increasing the fuelling rate," Patent Owner, in the Preliminary Response and the Request, does not adequately explain its claim construction position. We understand Patent Owner's position to be that there must be some introduction of fuel to the cylinder when the crankshaft is in a position after top dead center. However, it remains unclear what, if anything, Patent Owner contends is required by the "increasing" aspect of the limitation because Patent Owner does not adequately explain how that feature relates to the "operating normally" aspect of that same limitaton. It is not clear, for example, whether Patent Owner's position is that the total fuel introduced in a given cycle must be more than when operating normally, that the amount of fuel in a cylinder must increase during a particular portion of a single cycle but the total fuel introduced during the cycle need not be more than when operating

normally,[2] a combination of these, or something else altogether. We could not have misapprehended or overlooked something not explained adequately in the Preliminary Response. In order to avoid any further allegations of misapprehension and to narrow the issues, we strongly suggest the parties meet and confer regarding the meaning of the pertinent claim phrase—"while said ignition is so retarded, increasing the fuelling rate of said at least one cylinder to a level higher than that required when the engine is operating normally"—and stipulate to the aspects that are not in dispute.

Patent Owner next argues that the Board's preliminary construction of the phrase "while said ignition is so retarded" is erroneous. Req. Reh'g 6–12. Patent Owner does not direct our attention to an argument or evidence that was overlooked or misapprehended for this particular phrase, but instead reargues its construction from its Preliminary Response in discussing the Decision's analysis. *See id.* Mere disagreement with the Board's analysis or conclusion is not a proper basis for rehearing. It is not an abuse of discretion to have made an analysis or conclusion with which a party disagrees. Patent Owner's arguments regarding the constructions of the claim terms can be submitted in its patent owner response, but are not appropriate subject matter for a request on rehearing.

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[2] *See, e.g.*, Prelim. Resp. 28 ("the step of *increasing fuel* occurs 'while said ignition is so retarded'") (emphasis added); Req. Reh'g 5 ("the <u>*total*</u> quantity of fuel injected into the cylinder during that cycle (i.e., "fuelling rate" in mg/cylinder/cycle) nonetheless *increases* at each and every time point due to the continuous *addition* of fuel."); *id.* ("Thus, a person of ordinary skill in the art would understand that the 'fuelling rate' is not 'increasing' within the meaning of the '365 Patent only when fuel injection into the cylinder has completed during a given cycle.").

Next, Patent Owner argues that we overlooked arguments and evidence "regarding the Bosch-Petitioner's prior recognition that the '365 Patent discloses that the timing of increasing the fuelling rate is described with reference to crankangle." Req. Reh'g 12. The contention is misplaced. The Board did not overlook Patent Owner's argument and evidence. Rather, the argument and evidence were unpersuasive. The subject argument is that—during the prosecution of another patent ("the Bosch Patent")—the parent corporation of one of the Petitioners made a statement characterizing the disclosure in the specification of the '365 patent, and that that statement is consistent with Patent Owner's claim construction position. Prelim. Resp. 15–16 (quoting Ex. 2002, 160); *id.* at 15 n.3; *see* Req. Reh'g 12–13. Patent Owner further argues, "Bosch cannot have it both ways" and "Bosch should be held to their representations to the U.S. Patent and Trademark Office." Prelim. Resp. 16. Thus, Patent Owner's argument is based on extrinsic evidence—the prosecution history of another patent—and possibly on a theory of estoppel. Having considered the arguments and the cited portion of the evidence, we did not find them persuasive and determined that the evidence contributed little, if anything, to the proper preliminary claim construction.

Lastly, Patent Owner argues that the Board's "determination [that Petitioner demonstrated a reasonable likelihood of prevailing] was based on an erroneous claim construction and a misapprehension of or a failure to consider Patent Owner's arguments." Req. Reh'g 14. Specifically, Patent Owner quotes from our Decision where we indicated that we were not persuaded by Patent Owner's argument that claim 1 requires that fuel injection occur after top dead center. *Id.* (quoting Dec. 11–12). In so

indicating, we quoted Patent Owner's argument leaving no doubt that we considered the particular argument. *Id.* Patent Owner does not allege that we misapprehended this argument that claim 1 requires fuel injection to occur after top dead center. Thus, Patent Owner merely disagrees with our analysis and conclusion, and does not persuade us of an abuse of discretion. Again, Patent Owner's arguments regarding the constructions of the claim terms can be submitted by in its patent owner response.

IV. ORDER

For the reasons given, it is

ORDERED that Patent Owner's Request is *denied*.

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