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Paper 29
Entered: March 1, 2017

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, JEREMY M. PLENZLER, and AMANDA F. WIEKER, *Administrative Patent Judges.*

BARRETT, *Administrative Patent Judge.*

ORDER
Denying Patent Owner's Requests for Rehearing
37 C.F.R. § 42.71(d)

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

I. INTRODUCTION

Patent Owner Orbital Australia Pty Ltd ("Patent Owner") filed, in IPR2015-01258, a Request for Rehearing (Paper 29, "Request" or "Req.") of our Final Written Decision (Paper 28, "Final Written Decision" or "Dec.") holding claims 1, 2, 5, 9, 10, 12–14, and 18 of U.S. Patent 5,655,365 (Ex. 1001, "the '365 patent") unpatentable. Patent Owner filed, in IPR2015-01259, a similar Request for Rehearing (Paper 27) of our Final Written Decision (Paper 26) also holding claims 1, 2, 5, 9, 10, 12–14, and 18 of the '365 patent unpatentable[2]. For the reasons that follow, Patent Owner's Requests are denied.

II. REHEARING STANDARD

In pertinent part, 37 C.F.R. § 42.71(d) states:

> The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

Thus, a request for rehearing is not an opportunity merely to disagree with the Board's assessment of the arguments or weighing of the evidence or to present new arguments or evidence.

III. DISCUSSION

Patent Owner argues:

> In approving the Petitioner's prosecution history arguments regarding the "while said ignition is so retarded . . ." phrase, the Board misapprehends that Petitioner's arguments are

[2] Unless otherwise indicated, citations herein to Papers and Exhibits are to those filed in IPR2015-01258.

> premised on Petitioner's proposed definition of "introduction" as "all fuel introduced into the at least one cylinder during a combustion cycle is controlled to occur BTDC [Before Top Dead Center]." *See* Reply at 2.

Req. 1. Patent Owner also argues that we contradictorily stated we do not reach Petitioner's argument regarding the claim term "maintained" in the "timing of the introduction of fuel" limitation while implicitly adopting Petitioner's proposed construction in this regard.

As noted in the Final Written Decision, "[t]he dispositive issue in this case is the proper construction of the limitation of claim 1 pertaining to when 'increasing the fuelling rate' occurs." Dec. 10. We further explained:

> The parties' dispute relates to timing of the *end* of the fuel injection and specifically whether the claims require that at least some fuel be added to the pertinent cylinder while the crankshaft is in a position ATDC [After Top Dead Center]. As discussed above, the parties do not dispute that the *start* of fuel injection must occur BTDC. *See supra* Section II(B)(1) (construing "the timing of the introduction of fuel . . . maintained at . . . BTDC").

Id. at 11. Because it was not necessary to the disposition of the case, we expressly stated: "[i]n construing this [timing of the introduction of fuel] phrase, we need not and do not reach Petitioner's argument that the claims require *all* fuel to be injected BTDC." *Id.* at 9–10 (citation omitted). In other words, we did not reach Petitioner's argument, offered in the alternative, that the claim required fuel introduction to end in the BTDC range.

During this proceeding, Patent Owner argued that the prosecution history supports its proposed construction, which would require injection to end in the ATDC range. *See* PO Resp. 32–39. Petitioner, in reply, argued that the prosecution history does not support Patent Owner's position. Reply

19–20. Those are the arguments we addressed in our discussion of the prosecution history. Dec. 18–20. Specifically, we stated:

> We agree with Petitioner's argument (Reply 19) that the prosecution history does not support Patent Owner's argument that claim 1 requires fuel injection to end ATDC . . .
> [and]
> [w]e find persuasive Petitioner's argument ([Reply 20]) that "at no point during prosecution did [Patent Owner] Orbital distinguish [the prior art to] *Morikawa* based on the requirement that the quantity of fuel injected into the cylinder during a given cycle must increase, and thus end, at ATDC."

Dec. 18, 19. In order to determine that the prosecution history did not support Patent Owner's position, we did not need to adopt, and we did not adopt, Petitioner's proposed construction concerning fuel introduction ending BTDC. *Contra* Req. 4, 5 (Patent Owner arguing that the Board adopted Petitioner's argument and that Petitioner's analysis is premised on Petitioner's definition of "introduction."). Accordingly, we are not persuaded by Patent Owner's assertion (Req. 1) that we misapprehended that Petitioner's prosecution history position purportedly was based on that claim construction argument.

Patent Owner argues:

> the only way that the Board could have concluded that the prosecution history is somehow inconsistent with PO's construction (i.e., that there is only one "third option") is by first assuming the conclusion that "introduction" refers to the total duration of fuel injection as proposed by Petitioner, which the Board refused to do.

Req. 5. Patent Owner, thus, impliedly argues that we found the prosecution history to be inconsistent with Patent Owner's proposed construction. We, however, simply found unpersuasive Patent Owner's argument that the

prosecution history supported Patent Owner's proposed reading of the claim language. In that regard, we stated:

> Patent Owner also discusses amendments to claim 1 made during prosecution and compares various engine states through a document listing several "[c]onditions" (the "conditions document"). PO Resp. 33–39 (citing, *inter alia*, the conditions document, Ex. 2008). Patent Owner's arguments are not persuasive as the analysis is circular in that it is premised on the correctness of Patent Owner's construction and relies heavily on the conditions document, which, apparently, was created by Patent Owner's counsel as a deposition exhibit.

Dec. 20 (citations omitted). Patent Owner's disagreement with our determination that the argument was unpersuasive is not a proper basis for reconsideration. We did not, as Patent Owner argues (Req. 7), misapprehend Patent Owner's arguments regarding the prosecution history. Similarly, Patent Owner's related argument that we "improperly weighed a key part of intrinsic evidence" (*id.*) is a statement of disagreement with our decision, not an indication that we misapprehended or overlooked an argument, and is not a persuasive argument that a finding fails to be supported by substantial evidence or that the decision "represents an unreasonable judgment in weighing the intrinsic evidence" (*see id.* at 1–2).

Patent Owner asserts that the decision contains a finding that there was "only one 'third option'" in addition to the two situations depicted in Figure 4 of the Morikawa reference. Req. 5. Based on this assertion, Patent Owner argues we overlooked the possibility of the "green box" depiction on page 6 of the Request. *Id.* at 5–6. That "green box"—which appears to contain a modified version of Morikawa's Figure 4 with a lengthy injection period superimposed on the original figure—was not presented earlier and is not, as might be implied by Patent Owner's citation, the same as the

depiction of "Condition 3B" found on page 36 of Patent Owner's Response. To the extent this "green box" depiction constitutes new argument, it is inappropriate for a request for reconsideration and we will not consider it in the first instance now. As discussed above, we were not persuaded by Patent Owner's arguments based on "the conditions document."

Patent Owner's "red box" depiction (Req. 6) is a mischaracterization of the Final Written Decision, again based upon the erroneous assertion that we adopted Petitioner's proposed claim construction regarding the end of fuel introduction[3].

Patent Owner requests that we "expressly construe the term 'introduction'" and offers a proposed construction. Req. 8. In that regard, we stated in the Final Written Decision, under the heading "*the timing of the introduction of fuel*," the following: "As we did in the Decision on Institution, we, for purposes of this Final Decision, agree with the parties that claim 1 requires that the start of the injection of fuel begins at BTDC." Dec. 9 (footnote omitted). In light of this, Patent Owner does not persuade us that the Decision lacks an explicit construction or that there is a need to change or rephrase our construction concerning the timing of the introduction of fuel.

Lastly, Patent Owner:

> requests rehearing of the Decision's determination that Petitioner demonstrated by a preponderance of evidence that the challenged claims were unpatentable on every instituted ground as the

[3] Our discussion of a third option, and particularly our use of the word "introduction," quotes from *Applicant's* use of the term "introduction" in a claim amendment during prosecution and is based on *Applicant's* statements related thereto. *See* Dec. 19 (citing Ex. 1008, 83, 107 (claim amendment and response to office action)).

> determination was based on an erroneous claim construction for "while said ignition is so retarded . . ." and a misapprehension of or a failure to consider Patent Owner's arguments.

Req. 8. For the reasons set forth above, we are not persuaded that we applied an erroneous claim construction or misapprehended or failed to consider Patent Owner's arguments, and we, therefore, decline to reconsider the determination regarding unpatentability.

IV. ORDER

Accordingly, it is

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

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