

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROAD OCEAN TECHNOLOGIES, LLC,
Petitioner,

v.

NIDEC MOTOR CORPORATION,
Patent Owner.

Case IPR2015-01617
Patent 7,990,092 B2

Before JAMES A. TARTAL, PATRICK M. BOUCHER, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Trial in this proceeding was instituted based on a challenge of claims 7–13 of U.S. Patent No. 7,990,092 B2 (Ex. 1001, “the ’092 patent”) as anticipated under 35 U.S.C. § 102(b) by U.S. Patent Publ. No. 2007/0205732 A1 (Ex. 1007, “Beifus”). Paper 10, 22. On December 31, 2016, we issued a Final Written Decision, holding that Petitioner failed to show, by a preponderance of the evidence, that Beifus anticipates those claims. Paper 31 (“Decision” or “Dec.”). On January 20, 2017, Petitioner filed a Request for Rehearing, contending that “[t]he Board made procedural and legal errors in not considering Beifus’ Figure 5 and Figure 6 to be separate embodiments,” and “[a]lternatively, the Board erred by not considering Petitioner’s reliance upon *Kennametal*, under which claims 7–13 are anticipated by Beifus.” Paper 32 (“Req. Reh’g”), 4.

On rehearing, the burden of showing that the Decision should be modified lies with Petitioner, the party challenging the Decision. 37 C.F.R. § 42.71(d). “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.” *Id.*

II. BEIFUS EMBODIMENTS

In contending that we erred by not considering Figures 5 and 6 of Beifus to disclose distinct embodiments, Petitioner contends that “because the Board instituted an IPR based on Figure 6 of Beifus . . . , the burden of

production shifted to Patent Owner to produce evidence that Beifus does not actually anticipate because, for example, Figures 5 and 6 of Beifus are purportedly the same embodiment or that the embodiment of Figure 6 is not enabled.” Req. Reh’g, 7–8 (citing Paper 10, 14–17; *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1379–80 (Fed. Cir. 2015)). At the outset, such a position on the allocation of burdens to the parties is untenable because it has been expressly rejected by the Federal Circuit. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1376–77 (Fed. Cir. 2016) (“[I]t is inappropriate to shift the burden to the patentee after institution to prove that the patent is patentable. Instead, the petitioner continues to bear the burden of proving unpatentability after institution, and must do so by a preponderance of the evidence at trial. And, the Board has an obligation to assess the question anew after trial based on the totality of the record.”) (citations and footnote omitted); *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (“[T]he Board is not bound by any findings made in its Institution Decision. At that point, the Board is considering the matter preliminarily without the benefit of a full record. The Board is free to change its view of the merits after further development of the record, and *should do so* if convinced its initial inclinations were wrong.”).

In its Request for Rehearing, Petitioner reiterates several arguments that we considered and addressed in evaluating its position that Figures 5 and 6 are directed to distinct embodiments—or, at least, that Figure 6 is capable of being considered in isolation from Figure 5 to reach the

interpretation Petitioner advocates, i.e. that Beifus discloses emulation of a replaced induction motor's operation "by storing the replaced induction motor's speed-torque curve . . . into the [electrically commutated motor]'s memory." Req. Reh'g, 5 (citing Paper 24, 6–7). First, Petitioner contends that use of the plural word "methods" in the title and specification, as well as incidental references to "one method," "a specific embodiment," and "various specific embodiments," are inconsistent with our reading of Beifus. *Id.* at 6–7. We specifically addressed that argument in our Decision, including the supporting testimony of Petitioner's expert, Michael D. Sidman, Ph.D., whose testimony we found "insufficient[ly] unequivocal . . . for us to credit it on that point." Dec. 17–18. Petitioner's assertion that the "only way that Beifus discloses multiple methods of emulating an induction motor, or various specific embodiments, is if Figures 5 and 6 are different embodiments," Req. Reh'g 7 (emphasis added), is belied by the different "options" for the induction motor breakdown speed shown in Figure 6 itself. *See* Ex. 1007, Figure 6, ¶ 35.¹

¹ We do not disagree with Petitioner's general contention that "a prior art reference's disclosure of a non-anticipatory embodiment does not negate the invalidating effect under 35 U.S.C. §102 of any other anticipatory alternative embodiments." Req. Reh'g 8–9 (citing *Celeritas Techs., Ltd. v. Rockwell Intern. Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998); *Upsher-Smith Labs., Inc. v. Pamlab, L.L.C.*, 412 F.3d 1319, 1322–23 (Fed. Cir. 2005); Paper 30, 15:10–16:2). Rather, we disagree that Petitioner has carried its burden of showing that Beifus discloses any anticipatory embodiment.

Second, Petitioner relies heavily on the disclosure of paragraph 11 of Beifus, which is a summary identification of Figure 6 in the “BRIEF DESCRIPTION OF THE DRAWINGS” section, and which states: “FIG. 6 is a chart illustrating an induction motor speed-torque curve that is programmed into a memory of an [electrically commutated motor].” *See* Req. Reh’g 9–11. The Final Written Decision expressed our agreement with Patent Owner that the paragraph “is ambiguous, and insufficient to support a conclusion of anticipation.” Dec. 12. Although Petitioner again draws attention to the evidence it provided to support its interpretation of the paragraph as requiring storage of the torque values themselves, we do not now reach a different conclusion. *See* Req. Reh’g 10–11.

Specifically, Petitioner relies on testimony by Dr. Sidman that we considered and weighed in the context of the full disclosure of Beifus, including the less ambiguous statements that appear in paragraph 36. *See* Ex. 1010 ¶ 49. Petitioner also relies on U.S. Patent No. 5,791,332 (Ex. 1011, “Thompson”), which it contends “show[s] that a speed-torque curve for an HVAC motor is representative of torque values stored in a table in the memory of the motor.” Paper 24, 17. Petitioner reasons that, in light of Thompson’s disclosure, one of skill in the art “would have understood that speed-torque curves, such as those depicted in Figures 5 and 6 of Thompson, graphically represent motor torque values from lookup tables or torque tables stored in the memory of the motor, such as a furnace motor.” Paper 6, 23 (citing Ex. 1010 ¶ 67).

But Petitioner has not advocated for, and we did not institute *inter partes* review on, an obviousness ground combining the teachings of Beifus and Thompson that Patent Owner might otherwise have responded to. Although we considered Petitioner's argument, we are limited to evaluating the anticipation ground asserted by Petitioner, which does not apply Thompson for the limited purposes recognized for multiple-reference anticipation analyses. Petitioner does not cite Thompson to prove that Beifus contains an enabled disclosure, *see In re Samour*, 571 F.2d 559 (CCPA 1978); to explain the meaning of a term used, *see In re Baxter Travenol Labs.*, 952 F.2d 388 (Fed. Cir. 1991); or to show that storage of the torque values is inherent, *see Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). Indeed, Petitioner's acknowledgment that Beifus at least includes "on the fly" calculations of new torque demand values is inconsistent with an inherency argument. *See* Req. Reh'g 5; *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (inherency established by making clear that missing descriptive matter is "necessarily present" in the thing described in the reference).

Third, Petitioner contends that "the Board overlooked that Beifus and the '092 patent (in its entirety) both disclose the storage of the torque values in the same level of detail." Req. Reh'g 11. Petitioner's argument again relies on Beifus's ambiguous paragraph 11 ("FIG. 6 is a chart illustrating an induction motor speed-torque curve that is programmed into a memory of an ECM"), comparing it with the '092 patent's express disclosure that

“[i]nstead of adjusting the torque as described above, the motor controller 18 could store a plurality of different torque or speed tables and select one of the torque/speed tables based on an input provided by the torque adjustment mechanism” (Ex. 1001, col. 16, ll. 63–66 (emphasis added)). Req. Reh’g 11. Unlike paragraph 11 of Beifus, the ’092 patent is unambiguous that “a plurality of different torque or speed tables” is “store[d].” Ex. 1001, col. 16, ll. 63–66. We therefore disagree that the ’092 patent and Beifus are equivalently inexplicit on this point.

III. RELIANCE ON *KENNAMETAL*

Petitioner implies that our determination not to “consider Petitioner’s reliance in its Reply on the reasoning of *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376 (Fed. Cir. 2015)” gave improper effect to an objection raised by Patent Owner during Petitioner’s redirect examination of Dr. Sidman. See Req. Reh’g 12–13 (“Patent Owner Nidec waived all its evidentiary objections to the redirect testimony of Dr. Sidman by not filing a motion to exclude” (citing 37 C.F.R. § 42.64(c))). This implication misconstrues the reasoning provided in the Final Written Decision. Rather, we determined that Petitioner’s reliance on *Kennametal* was improper because it was an argument not raised in the initial Petition. Dec. 18. Regardless of whether Patent Owner made an objection, and regardless of whether Patent Owner filed a motion to exclude based on such an objection, we are not absolved of our duty to guard against the improper presentation

of shifting arguments that may unfairly disadvantage an opposing party. 37 C.F.R. § 42.23(b) (“A reply may *only* respond to arguments raised in the corresponding opposition, patent owner preliminary response, or patent owner response.”) (emphasis added); *CBS Interactive, Inc. v. Helferich Pat. Lic., LLC*, Case IPR2013-00033, slip op. at 3 (PTAB Aug. 9, 2013) (Paper 79) (“Should there be improper arguments or evidence presented with a reply, the Board, exercising its discretion, may exclude the reply and related evidence in their entirety, or alternatively, decline to consider the improper arguments and/or related evidence.”). We recognize that Patent Owner addressed *Kennametal* in its Patent Owner Response, and, as a broadly general proposition, raising an argument in a Response may, without more, entitle a Petitioner to reply to it. But the specific circumstances in this case are not that simple.

In particular, we disagree with Petitioner’s assertion that its “reliance on *Kennametal* does not present a new issue, a new legal theory or a new argument.” Req. Reh’g 13. And we disagree that Patent Owner “opened the door” to a *Kennametal*-based argument either through its argument that Beifus teaches “on the fly” torque calculations rather than storage of torque values or through addressing *Kennametal* in its Response. *See id.* at 14–15. Despite not having addressed *Kennametal* in its Petition, Petitioner used the conspicuous language of *Kennametal* in its redirect examination of Dr. Sidman. *See* Dec. 19 (citing Paper 20, 21). Patent Owner was justified in taking prophylactic steps to address what appeared to be an attempt to lay

the groundwork for a new argument based on *Kennametal* through that redirect examination. *See id.* 18–19. Accordingly, we are not persuaded that we misapprehended or overlooked any matter related to Petitioner’s *Kennametal* argument.

Nevertheless, we take this opportunity to observe that application of the reasoning in *Kennametal* does not alter the fundamental requirement that “[a] prior art reference can only anticipate a claim if it discloses all the claimed limitations ‘arranged or combined in the same way as in the claim.’” *Kennametal* at 1381 (quoting *Wm. Wrigley Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d 1356, 1361 (Fed. Cir. 2012)). “Without [the prior art] expressly (or inherently) disclosing all of the limitations of the asserted claims, the rest of *Kennametal*’s teaching must be tempered with the reality that anticipation cannot be based on . . . multiple layers of supposition . . . to construct [a] theory of anticipation and still meet the requirement that the claimed limitation be immediately apparent.” *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 2016 WL 1437655 at *9 (D. Del. Apr. 11, 2016). Ultimately, Petitioner’s arguments rely on a characterization of Beifus’s teachings that we reject for the reasons explained in the Final Written Decision and above.

IV. ORDER

It is

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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