

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 IPR2015-01663
Patent 5,818,194

Before BENJAMIN D. M. WOOD, JAMES A. TARTAL, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

Petitioner requests rehearing of our Decision (Paper 8, “Institution Decision” or “Dec.”) denying institution of an *inter partes* review of U.S.

Patent No. 5,818,194 (Ex. 1001, “the ’194 patent”). Paper 9 (“Req. Reh’g”). 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.* Petitioner contends that (1) “the Board erred by finding that ‘Petitioner has not demonstrated sufficiently that Collins [U.S. Patent No. 3,911,677 (Ex. 1005)] is analogous art’; and (2) “the Board misapprehended or overlooked Collins’ disclosure of a variable speed motor.” Req. Reh’g 1, 2. For purposes of its Request for Rehearing, Petitioner accepts the Board’s construction of “variable speed motor,” recited in independent claims 1, 21, and 39, as “a motor that can be controlled to produce a range of speeds rather than one or more fixed or preset speeds.” *Id.* at 1; Dec. 6–8.

It is sufficient to decide the Request for Rehearing by addressing the Petition’s challenge of independent claims 1, 21, and 39 as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 4,946,096 (“Ballard”) and Collins.¹ The Petition contends:

Ballard discloses the (1) variable speed motor, (2) reference input and (3) power inputs, elements recited in independent claims 1, 21 and 39. Even though Ballard fails to teach the recited multiplexing unit and a reference source, it would have been

¹ The Request for Rehearing does not contend that the Board erred in its conclusion that the Petition failed to establish a reasonable likelihood of prevailing on the challenges based on U.S. Patent No. 4,815,524 (“Dempsey”) and Collins.

obvious to a [person having ordinary skill in the art] to combine Ballard with Collins, which teaches (4) a multiplexing unit and (5) a reference source. Furthermore, the device of Ballard discloses the same inputs as a [permanent split capacitor] motor in a heating, ventilation, and air-conditioning system. Finally, Collins teaches a reference source that produces digital signals as reference signals.

Pet. 17–18. First, in the Institution Decision, we determined that “the multiple-speed motor described by Ballard is not a ‘variable speed motor,’ as we have construed the term,” a determination that Petitioner does not contest in its Request for Rehearing. *See* Dec. 12. Instead, Petitioner now contends that “[i]n the claim charts, Petitioner specifically pointed to Collins’ variable speed motor and electronic variable speed drive for the claim limitations reciting a ‘variable speed motor.’” Req. Reh’g 14.

Although Petitioner is correct that the Petition’s claim charts identify both Ballard and Collins as disclosing a variable speed motor, Petitioner provides insufficient reasoning in the Petition that explains how a combination of Ballard and Collins is to be effected by relying on Collins’s purported disclosure of a variable speed motor—an omission that is especially pertinent in light of the Petition’s express and otherwise exclusive reliance on Ballard for the “variable speed motor.” *See, e.g.*, Pet. 26 (“A [person having ordinary skill in the art] would have been motivated to, and have found it obvious to, apply the improvement of Collins’ digital switches to Ballard’s variable speed motor.”) For example, Petitioner identifies no argument in the Petition that involves substitution of Ballard’s multiple fixed speed motor with the motor disclosed by Collins. To the extent that the

Request for Rehearing now implies such a substitution, it represents a shift in position from that taken in the Petition.

Second, in the Institution Decision, we concluded that “Petitioner has not demonstrated sufficiently that Collins is analogous art, as necessary for a reference to qualify as prior art for an obviousness determination under 35 U.S.C. § 103(a).” Dec. 13. In reaching that conclusion, we stated that

Petitioner has not shown that controlling various stages of an injection molding machine [as described in Collins] is within the same field of endeavor as the ’194 patent, which is concerned with HVAC systems and “an improved variable speed control . . . designed to be connected to the standard power terminals used for a permanent split capacitor (PSC) motor.”

Id. (citing Ex. 1001, col. 1, ll. 9–10).

Petitioner directs our attention to the Federal Circuit’s exposition of the test for analogous art in *In re Bigio*, 381 F.3d 1320 (Fed. Cir. 2004):

“Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference is still reasonably pertinent to the particular problem with which the inventor is involved.”

Req. Reh’g 3–4 (citing *Bigio* at 1325). Petitioner contends that we “misapplied the ‘same field of endeavor’ test by ignoring the claimed invention as actually recited in independent claims 1, 21 and 39 of the ’194 patent, and by focusing on ‘the problem addressed by the inventor’ which is to be considered only during the second test.” *Id.* at 4. Specifically, Petitioner contends that the “field of endeavor” is correctly identified as

“variable speed motors” because “[n]one of the claims 1, 21, and 39 recite an HVAC system, much less using the recited variable speed motor as a drop-in replacement for a PSC motor in an HVAC system.” *Id.* at 5.

Petitioner’s characterization of the field of endeavor is too broad because it divorces that characterization from the context provided by the patent’s disclosure. Petitioner’s characterization insufficiently accounts for the Federal Circuit’s reminder in *Bigio* that “the Board *must* consider the ‘circumstances’ of the application—the *full disclosure*—and weigh those circumstances from the vantage point of the common sense likely to be exerted by one of ordinary skill in the art in assessing the scope of the endeavor.” *Bigio* at 1326 (emphases added).

We conclude that Petitioner has not identified adequately any matter that we misapprehended or overlooked.

In consideration of the foregoing, it is hereby:

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

IPR2015-01663
Patent 5,818,194

PETITIONER:

Steven F. Meyer
Joseph A. Farco
Howard Lim
LOCKE LORD LLP
ptopatentcommunication@lockelord.com
jfarco@lockelord.com
hlim@lockelord.com

PATENT OWNER:

Scott R. Brown
Matthew B. Walters
HOVEY WILLIAMS LLP
sbrown@hoveywilliams.com
mwalters@hoveywilliams.com