

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VESTAS-AMERICAN WIND TECHNOLOGY, INC.
and VESTAS WIND SYSTEMS A/S,
Petitioner,

v.

GENERAL ELECTRIC CO.,
Patent Owner.

Case IPR2018-01563
Patent 6,921,985 B2

Before MICHAEL W. KIM, JEFFREY W. ABRAHAM, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

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

I. BACKGROUND

Vestas-American Wind Technology, Inc. and Vestas Wind Systems A/S (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 9–11, 15–18, 20–28, 46–63, and 65–69 of U.S. Patent No. 6,921,985 B2 (Ex. 1001, “the ’985 Patent”). Paper 2 (“Pet.”). General Electric Co. (“Patent Owner”) filed a Preliminary Response. Paper 10 (“Prelim. Resp.”). On February 26, 2019, we instituted an *inter partes* review on all claims and grounds set forth in the Petition. Paper 11 (“Dec.” or “Decision”). On March 12, 2019, Patent Owner filed a Request for Rehearing. Paper 15 (“Req.”).

II. PRINCIPLES OF LAW

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. 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.

37 C.F.R. § 42.71(d). “When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c).

III. ANALYSIS

Patent Owner’s ultimate assertion is straightforward. There are two proceedings involving the same patent, this one, and IPR2018-01029 (“the -01029 proceeding”). The petitions¹ in each proceeding, each filed by the same petitioner, set forth various obviousness challenges that each include

¹ The petition in the -01029 proceeding will be referred to as “-01029 Petition” and “-01029 Pet.”

the EON² reference. Patent Owner asserts that it made the same argument against both petitions: that Petitioner's use of EON was no different from that which Patent Owner overcame during reexamination (Req. 12), and thus the petitions should be denied under 35 U.S.C. § 325(d) based on the factors set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (informative) (Paper No. 8) (footnote omitted). Patent Owner takes issue with the fact that, in the -01029 proceeding, the Board denied institution on that basis, but did not here. In doing so, Patent Owner acknowledges that the Board did attempt to distinguish the proceedings, but asserts that the underlying bases for those distinctions are a result of misapprehending and overlooking at least a part of the record. Req. 7 (citing Dec. 14–15 fn. 8).

We will address all of Patent Owner's arguments in full. And at the outset, we acknowledge that we did misapprehend or overlook some aspects identified by Patent Owner. Ultimately, however, Patent Owner's assertions are unpersuasive, because while they certainly highlight the similarities between the two proceedings, they do not address adequately the differences. It is those differences that did, and once again, carry the day, even when we reweigh our previous determination in light of our acknowledged errors.

The foundational similarity identified by Patent Owner is that relevant portions of the two petitions concerning EON are identical. Req. 4–5, 12–13. That is unquestionably correct. We even note that the petitions' reliance

² E.ON NETZ GMBH, *Supplemental Network Connection Rules for Wind Energy Systems* (Dec. 1, 2001) (Ex. 1006).

on EON is for substantively the same claim limitation, i.e., the recited “uninterruptible power supply.” *Compare* Pet. 46–48; -01029 Pet. 28–29. The issue, however, are the portions of these petitions that *precede* those identified by Patent Owner. In the cited portion of -01029 Petition, the only other reference identified is Cousineau. -01029 Pet. 28–29. Neither petition relies on Cousineau for the “uninterruptible power supply.” Accordingly, in the -01029 Petition, we could come to no conclusion other than Petitioner was relying on EON alone for the “uninterruptible power supply.” And it was on that basis that we agreed with Patent Owner that the Office had already considered, and rejected, that position during reexamination. Req. 12.

Here, however, the Petition expressly references each of Rosch, McDowall, and Kasper. Pet. 46; *see also* Pet. 26–28 (discussion of Rosch, McDowall, and Kasper incorporated at Petition 36-37). And in doing so, the Petition expressly refers back to other portions where Rosch, McDowall, and Kasper are relied on explicitly for the “uninterruptible power supply.” *See, e.g.*, Pet. 42 (“POSAs would have applied the teachings of Nielsen and the widespread knowledge of uninterruptible power supplies (as taught, for example, in Rosch, McDowall, and/or Kasper) . . .”). Accordingly, when this portion of the Petition is read as a whole, while we agree that the use of EON *alone* is similar, the instant Petition uses EON *in conjunction with Rosch, McDowall, and Kasper*, which we determined was sufficiently different to warrant a different outcome; in essence, that EON served as the

rationale to add the “uninterruptible power supply” of Rosch, McDowall, and Kasper to Fedderson.³

Patent Owner argues that this difference is illusory for two reasons. First, Patent Owner asserts that the -01029 Petition also references Rosch, McDowall, and Kaspar in connection with the “uninterruptible power supply.” Req. 6–7. That is also unquestionably correct. The issue, however, is that in the -01029 Petition, none of the grounds relied on McDowall and Kaspar. *See generally* -01029 Pet. As acknowledged by Patent Owner, they were only referenced in the -01029 Petition as a part of the “Technology Introduction” for “Use of Uninterruptible Power Supplies in the Prior Art.” -01029 Pet. 9–11. By contrast, here, each of McDowall and Kaspar are expressly relied on in multiple grounds of unpatentability. *See generally* Pet.

For Rosch, Patent Owner asserts, and we agree, that it was included in certain grounds of unpatentability in the -01029 Petition. Req. 7, 9–10; *see, e.g.*, -01029 Petition 44–52. Patent Owner does not identify, however, where the arguments involving Rosch from the -01029 Petition were made in this proceeding. We could not have misapprehended or overlooked an argument that was not made. Moreover, a comparison of the relevant portions indicate that the petitions use EON in a different manner. *Compare* Pet. 47; -01029 Pet. 50. It follows, then, that the two Rosch/EON combinations are also different.

³ Patent Owner disagrees with this assessment. Req. 8, 13. Disagreement, however, does not inform us of how anything in the record was misapprehended or overlooked in arriving at our determination.

Second, Patent Owner asserts that both petitions use EON for more than a rationale-to-modify. Req. 9–11. We agree. Indeed, it is on this basis that we denied institution in the -01029 proceeding; that Petitioner’s reliance on EON for the recited “uninterruptible power supply” itself was a position already considered and rejected by the Office. We would even go so far as to agree with Patent Owner that Petitioner, here, probably intended to rely on EON again for both the limitation itself, as well as the rationale-to-modify. Where we part with Patent Owner, however, is their position that Petitioner’s reliance on EON must be evaluated on an all-or-nothing basis; that if EON is insufficient for a limitation, it is also insufficient for a rationale-to-modify. We disagree, because those are separate and severable inquiries, and for the rationale-to-modify aspect, we are persuaded that Petitioner’s analysis was sufficient, at least for the purposes of institution.

Patent Owner makes several other substantive and procedural assertions. They are largely subsumed within the above inquiries.

Patent Owner asserts that the Board did not adequately address all of the *Becton, Dickinson* factors. Req. 11–14. Specifically, Patent Owner asserts that Board improperly dismissed many of them by merely stating that “Patent Owner makes similar assertions when discussing several of the *Becton, Dickinson* factors.” Req. 12 (citing Dec. 14). For example, Patent Owner asserts the following:

For example, the DI does not address the factor that considers “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” *Becton, Dickinson*, 17–18, factor “(c).” The POPR provided citations to evidence supporting GE’s position that “the Office’s prior consideration of EON and Cousineau, along with other wind turbine art, outweighs the fact that not all

of the references may have been considered [and] that this factor weighs against institution.” POPR, 22–23. This is the same conclusion, supported by the same evidence, that the panel reached in its thorough *Becton, Dickinson* analysis in -01029. DI in -01029, 13–14. However, in the present case, the DI overlooks this same evidence, which was cited in the POPR.

Req. 12. Essentially, Patent Owner disagrees that the assertions are similar, and also disagree with the manner in which the Board seemingly dismissed that assertion with the sentence identified above. The disagreement is noted. As indicated in the Decision, however, which has since been supplemented by the analysis set forth above, the Board expressly addressed this argument and supporting evidence in substance, if perhaps not in a format where such analysis can be overtly identified.

Patent Owner may be arguing that a failure to set out a comprehensive analysis for each *Becton, Dickinson* factor separately in our Decision led the Board to underweigh those factors collectively. While we disagree with that premise, in an abundance of caution, the panel has re-read every argument for every factor, reconsidered each piece of supporting evidence, and reweighed them collectively. Prelim. Resp. 18–25 (citing Pet. 22–23, 47–48; Ex. 1002, 102, 104; Ex. 1003 ¶¶ 152–153; Ex. 2001, 6–7; Ex. 2002, 42–44). Our conclusion and analysis remains unchanged.

Finally, Patent Owner asserts the following:

Moreover, the observations that the -01029 petition “relied on Feddersen and EON alone in the exact manner that was considered already in the ’580 Reexamination” and that that was the “basis that we denied the -01029 Petition under 35 U.S.C. § 325(d)” is factually incorrect when (i) Feddersen was not included in *any ground* presented in the -01029 petition and (ii) the Board’s entire *Becton, Dickinson* analysis in the -01029 DI focused on the nature and usage of EON. *See e.g.*, -01029 Petition, 16 (reciting its Statutory Grounds of Challenge, none of

which include Feddersen); -01029 DI, 12 (finding that “[a]lthough Petitioner relies on different references for a wind turbine, we do not consider such differences material because the different primary references do not appear to have affected how EON is used to modify the wind turbines.”)

Req. 7–8. As technical matter, Patent Owner is unquestionably correct; the -01029 Petition does not include Feddersen for any ground. As a substantive matter, however, this works against Patent Owner. As noted by Patent Owner, in the -01029 proceeding, there were no material differences in the wind turbine components of Cousineau, which was relied on in the -01029 Petition, and Feddersen, which was overcome during reexamination. Indeed, it is for this exact reason that, as noted by Patent Owner, our *Becton, Dickinson* analysis in the -01029 proceeding focused substantively on EON alone. Nevertheless, to correct our error, we modify footnote 8 of our Decision to read as follows: “By contrast, for this claim limitation, the -01029 Petition did not include any of Rosch, McDowell, or Kasper, and instead relied on EON alone in the exact manner that was considered already in the ’580 Reexamination.” The outcome, however, is unchanged.

VI. EXPANDED PANEL REQUEST

Patent Owner requests an expanded panel for the following reasons:

In the present case, GE respectfully suggests that an expanded panel is appropriate to secure and maintain uniformity of the Board’s decisions where the same panel has taken inconsistent positions with respect to the same reference (EON), used in the same manner, to challenge the same patent (the ’985 patent), in cases IPR2018-01029 and IPR2018-01563, involving the same parties. The panel came to its conclusion in the DI -01029 following a reasoned and complete *Becton, Dickinson* analysis, then reaffirmed that conclusion in the -01029 Rehearing

Decision, recognizing the reliance on the same art and the same or substantially the same argument that was presented previously to the office. The consistent conclusion of exercising the Board's discretion under 35 U.S.C. § 325(d) to deny institution of an inter partes review is also appropriate here.

Req. 14–15. The Chief Judge has considered Patent Owner's request for an expanded panel, but has determined that an expanded panel is not warranted.

V. ORDER

Patent Owner's request is *denied*.

IPR2018-01563
Patent 6,921,985 B2

For PETITIONER:

Michael Fleming
Gary Frischling
Amy Proctor
IRELL & MANELLA LLP
mfleming@irell.com
gfrischling@irell.com
aproctor@irell.com

For PATENT OWNER:

Monica Grewal
Scott Bertulli
WILMER CUTLER PICKERING HALE AND DORR LLP
monica.grewal@wilmerhale.com
scott.bertulli@wilmerhale.com