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Paper 9
Entered: May 9, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORP.,
Petitioner,

v.

GE HYBRID TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2019-00015
Patent 8,409,052 B2

Before MICHAEL W. KIM, LYNNE H. BROWNE, and AMANDA F. WIEKER, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

Toyota Motor Corp. ("Petitioner"), on October 31, 2019, filed a Petition to institute *inter partes* review of claims 1–16 of U.S. Patent No. 8,409,052 B2 ("the '052 patent"). Paper 1 ("Pet."). GE Hybrid Technologies, LLC ("Patent Owner") filed a Preliminary Response to the Petition, on February 27, 2019. Paper 6 ("Prelim. Resp."). On March 28, 2019, we denied institution of *inter partes* review. Paper 7 ("Dec." or "Decision"). On April 17, 2019, Petitioner filed a Request for Rehearing. Paper 8 ("Req.").

II. PRINCIPLES OF LAW

> A party dissatisfied with a decision may file a single 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

Petitioner contends that "the Board overlooked evidence establishing Sugimoto's teaching of a 'vehicle control unit' with respect to each of the challenged independent claims." Req. 1 (emphasis omitted). Specifically, Petitioner asserts that the Board overlooked Petitioner's contention that Sugimoto's control device would have been used to control Sugimoto's switch to carry out Fassnacht's process, and that the Board overlooked this argument with respect to claims 1 and 5. Req. 4, 8.

We are not persuaded that we overlooked or misapprehended this argument as it pertains to claims 1 and 5. In our Decision, we focused specifically "on the Petition's showing with respect to the limitation requiring 'as the temperature of a battery module of the hybrid electric vehicle is below a first threshold temperature, *allowing a vehicle control unit* of the hybrid electric vehicle to turn on a first switch.'" Dec. 12 (citing Ex. 1001, 9:7–10). In considering whether the Petition adequately addressed this limitation, we explicitly considered Petitioner's evidence that Sugimoto discloses a control device 60 that controls a switch. Dec. 12–14. Upon such explicit consideration, we concluded that the Petition did not adequately explain how "the prior art discloses or suggests the limitation requiring 'as the temperature of a battery module of the hybrid electric vehicle is below a first threshold temperature, *allowing a vehicle control unit* of the hybrid electric vehicle to turn on a first switch.'" Dec. 14 (citing Ex. 1001, 9:7–10).

To reiterate, the Petition relies on Sugimoto to meet the limitations pertaining to a vehicle control unit. Pet. 20, 24; Ex. 1002 ¶ 55. The Petition and the Miller Declaration provide evidence that Sugimoto discloses control device 60, and that one skilled in the art would have considered Sugimoto's control device 60 to be a vehicle control unit, as required by each of claims 1 and 5. *Id.* The Petition and the Miller Declaration also provide evidence that Sugimoto's control device 60 controls a switch. Pet. 17–19; Ex. 1002 ¶ 50. Such evidence alone, however, does not provide sufficient reasoning, with adequate rational underpinnings, for modifying Fassnacht's process to include a vehicle control unit that is allowed to turn on a first switch when the vehicle is below a first threshold temperature. Rather, as we explained in our Decision, "[t]he allegations in the Petition rely on an assumption that

mere inclusion of a vehicle control unit as part of Fassnacht's method would result in the claimed method." Dec. 13 (citing Pet. 20, 22–24).

Further, even though we did not specifically cite paragraphs 52–53, 61–62, and 103–109 of the Miller Declaration in our Decision, we did not overlook or misapprehend them. These paragraphs provide detailed explanations of *how* Sugimoto's control device 60 could have been incorporated in to Fassnacht's vehicle, but these descriptions also start from the assumption that merely including Sugimoto's control unit 16 in Fassnacht's process would have resulted in the claimed method. Neither the Petition nor the Miller Declaration explain *why* one skilled in the art would modify Fassnacht's process to include the step of allowing the vehicle control unit to turn on a switch when such a step is unnecessary to Fassnact's process. *In re Giannelli*, 739 F.3d 1375, 1380 (Fed. Cir. 2014) ("[T]he mere *capability* of pulling the handles is not the inquiry that the Board should have made; it should have determined whether it would have been obvious to modify the prior art apparatus to arrive at the claimed rowing machine.").

IV. CONCLUSION

For the foregoing reasons, we are not persuaded by Petitioner's contentions.

IV. ORDER

Accordingly, Petitioner's Request is *denied*.

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