

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Mercedes-Benz USA, LLC,
Petitioner,

v.

Westport Fuel Systems Canada, Inc.
Patent Owner.

Case IPR2023-00351
Patent 6,575,138

**PETITIONERS PETITION RANKING AND EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS**

Petitioner submits this notice of ranking of their petitions for *inter partes* review of US6,575,138 (“’138”) filed in IPR2023-00293 and IPR2023-00351 and an explanation of the material differences between the petitions. (Ex.1001). See “TRIAL PRACTICE GUIDE UPDATE (July 2019)” at 26-28. Petitioner is filing two petitions each showing different ways that the basic concept of the ’138—*i.e.*, well-known fuel injection technology, including the well-known concept of using hydraulic fluid to transmit forces when actuating a fuel injection valve—was known in the prior art.

The first petition, IPR2023-00293, relies on Wirbeleit and Klügl as primary references. Wirbeleit and Klügl, along with secondary references Newcomb and/or Hayes, teach a system including a fuel-injector with a passive hydraulic link.

The second petition, IPR2023-00351, relies on Gottlieb as a primary reference. Gottlieb, along with the secondary reference of Gottlieb’s German foreign priority application, teaches a system including a fuel-injector with a passive hydraulic link.

Ordering of Petitions. Although Petitioner believes that its petitions are all meritorious and justified in light of the positions Patent Owner may take, at this stage, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Primary Reference(s)
A	IPR2023-00293 (Petition 1 of 2)	Wirbeleit and Klügl
B	IPR2023-00351 (Petition 2 of 2)	Gottlieb

Below are some of the material differences between the petitions:

(1) Differences between prior art in petitions:

Petition 1 (rank A) relies on Wirbeleit and Klügl as primary references.

Petition 1 differs from Petition 2 in that it relies on a combination of at least two references for each challenged claim. In particular, one of the two primary references, Klügl describes a “power transmission device” to “transmit the movement of a piezoelectric actuator” to open and close a fuel injector and describes, in detail, how force is transmitted from an actuator to a piston through incompressible hydraulic fluid. The other primary reference, Wirbeleit, relates to a larger concept, a fuel injection system, and describes the parts of that injection system, including a needle controlled by a piezo or magnetostrictive actuator. Wirbeleit employs a “hydraulic transmission element 22,” but states that this element is purposefully “not shown in detail,” and Klügl is used to provide that detail.

Petition 2 (rank B) relies on a single reference, Gottlieb, for the independent challenged claims and thus presents arguments that the majority of the challenged claims are anticipated under 35 U.S.C. § 102 not present in Petition 1. Gottlieb

discloses both the structural elements present in Wirbeleit and the transmission elements present in Klügl.

(2) Priority Date:

Petition 1 (rank A): Each reference relied on in Petition 1 is prior art under 35 U.S.C. § 102(b) regardless of whether the challenged claims are afforded a priority date of October 15, 1999 (the date of a provisional application to which the '138 claims priority) or March 9, 2000.¹

Petition 2 (rank B): The primary reference relied on in Petition 2, Gottlieb, U.S. Patent No. 6,530,273, was filed on November 24, 1999 and claims priority to DE19854506, filed November 25, 1998. Gottlieb is prior art under 35 U.S.C. § 102(e) because it was filed before the March 9, 2000 priority date to which Petitioners contend the challenged claims are entitled. Petition 2 contains argument and analysis of why the challenged claims are only entitled to a March 9, 2000 priority date, and thus presents argument and issues not present in Petition 1.

The following table summarizes these differences between the petitions, which are listed in order of Petitioner's ranking.

Petition	Primary Reference(s)	Invalidity Arguments	Priority Date
1	Wirbeleit, Klügl	35 U.S.C. § 103	Prior art for both October 15, 1999

¹ Petitioners contend that the challenged claims are entitled to a priority date of no earlier than March 9, 2000.

			and March 9, 2000 priority dates
2	Gottlieb	35 U.S.C. § 102, 103	Prior art for March 9, 2000 priority date

In view of the material differences shown above, the Board should consider both petitions and not exercise its discretion to deny institution in either IPR.

Dated: December 14, 2022

Respectfully submitted,

/s/ Celine J. Crowson

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