

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WIRTGEN AMERICA, INC. and WIRTGEN GMBH,
Petitioner,

v.

CATERPILLAR PAVING PRODUCTS INC.,
Patent Owner

Case IPR2018-01201
Patent 7,140,693 B2

Before LYNNE H. BROWNE, JAMES J. MAYBERRY, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing
of Final Written Decision

35 U.S.C. § 42.71

I. INTRODUCTION

Wirtgen America, Inc. and Wirtgen GmbH (“Petitioner”), on June 7, 2018, filed a Petition to institute *inter partes* review of claims 1–3, 5, 6, 15–19, 24–28, and 38 of U.S. Patent No. 7,140,693 B2 (“the ’693 patent”). Paper 2 (“Pet.”). We issued a Decision to Institute an *inter partes* review (Paper 13, “Dec.”) of all challenged claims (1–3, 5, 6, 15–19, 24–28, and 38) under all grounds. After institution of trial, Caterpillar Paving Products, Inc. (“Patent Owner”) filed a Patent Owner Response (Paper 18, “PO Resp.”), to which Petitioner replied (Paper 22, “Pet. Reply”), and to which Patent Owner filed a Sur-Reply (Paper 23, “PO Sur-Reply”). We heard oral arguments September 16, 2019. On December 13, 2019, we issued a Final Written Decision (Paper 32, “Final Dec.”) determining all challenged claims (1–3, 5, 6, 15–19, 24–28, and 38) unpatentable. On January 13, 2020, Patent Owner filed a Rehearing Request of our Final Written Decision (Paper 33, “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

A. *Arthrex*

Patent Owner contends that the Institution Decision and the Final Written Decision should be vacated in light of *Arthrex, Inc. v. Simth & Nephew, Inc.* 941 F.3d 1320, 1327 (Fed. Cir. 2019). Req. 2. Specifically, Patent Owner asserts that “[i]n this case, the APJs did not institute trials as “subordinate officers” as contemplated in *Ethicon [Endo-Surgery, Inc. v. Covidien LP]*, 812 F.3d [1023,] 1031–33 [(Fed. Cir 2016)], but as independent principal officers that the Director could not ‘review, vacate, or correct.’” *Id.* at 3 (citing *Arthrex*, 941 F.3d at 1335). Thus, according to Patent Owner, “the Director violated 35 U.S.C. § 314 and due process of law by delegating institution authority for Wirtgen’s petition to the Board.” *Id.* Patent Owner asserts further that “[a]s a result, both the FWD and Institution Decision should be vacated.” *Id.* at 3–4.

In support of this contention, Patent Owner argues that “the *Arthrex* court did not analyze the implications of its holding that APJs were ‘principal officers’ on the Director’s delegation of his institution authority to the Board under 37 C.F.R. § 42.4(a).” Req. 3, n.1. In *Caterpillar Paving Products, Inc. v. Wirtgen America, Inc.*, however, the court considered this issue and held that “Caterpillar has not demonstrated that *Arthrex* compels a remand.” *Caterpillar Paving Products, Inc. v. Wirtgen America, Inc.*, Mot. Dec. No. 2020-1261 (Fed. Cir. May 6, 2020). Specifically, the court stated that “[u]nlike in prior cases in which this court has recently vacated and remanded, *Arthrex* issued before the Board’s final written decision in this case.” *Id.* The court rejected Caterpillar’s argument “that even if the panel members became constitutional immediately prior to issuing the final written

decision, that ‘does not cure a year’s worth of constitutional violations influencing the Board’s thinking and conclusions,’” finding instead that “[t]he court in *Arthrex* considered and rejected that argument, expressly limiting its holding ‘to those cases where final written decisions were issued.’” *Id.* (citing *Arthrex*, 953 F.3d at 1340; *Arthrex, Inc. v. Smith & Nephew, Inc.*, 953 F.3d 760, 764 (Fed. Cir. 2020)).

For this reason, we do not grant Patent Owner’s request to vacate the Institution Decision and Final Written Decision in this proceeding.

B. Whether the Board Improperly Found the Challenged Claims Unpatentable

1. Whether the Board Misapprehend the Obviousness Analysis for Ground 1

a. Whether the Board Misapprehended Patent Owner’s arguments regarding the term “Retracted Position”

Patent Owner contends that “[t]he FWD incorrectly found that Ground 1 rendered obvious the claimed retracted position.” Req. 7. In support of this contention, Patent Owner asserts that “[w]hile the FWD found that one of ordinary skill in the art would have integrated Ulrich’s swinging actuator into the Volpe Manual Machine’s design, it failed to properly consider the effects of such a combination.” *Id.* at 8 (citing PO Resp. 17–18). Specifically, Patent Owner asserts that we did not consider that “if one were to connect Ulrich’s actuator to the Volpe Manual machine, it would directly impede the ability of the swing arm, the lifting column, the wheel, and the clevis to swing within the machine’s frame.” *Id.* (citing Ex. 2007 ¶ 67; Patent Owner Response at 23–24).

We do not agree that we overlooked or misapprehended this argument. Rather, we addressed this argument on pages 21–22 of Final

Written Decision. The fact that Patent Owner disagrees with our resolution of this issue is not grounds for rehearing.

b. Whether the Board Overlooked Patent Owner's Arguments Regarding the Second Actuator

Patent Owner contends that “[t]he Final Written Decision overlooked that the combination of the Volpe Manual and Ulrich (Ground 1) cannot render obvious the ‘second actuator’ limitation found in each of the asserted claims.” Req. 10 (citing PO Sur-Reply 12–16; PO Resp. 32–37). In support of this contention, Patent Owner asserts that “Caterpillar’s expert explained that the vertical movement of Volpe’s lifting column would be a substantial problem for Petitioner’s proposed implementation of Ulrich’s rotational actuator into the Volpe machine.” *Id.* at 10–11 (citing PO Resp. 36; Ex. 2007 ¶ 88). Patent Owner asserts further that “[i]n light of this testimony, the Board should reverse its finding that any claims of the ’693 patent are unpatentable based on Ground 1 of the Petition.” *Id.* at 11.

Patent Owner’s contention does not identify any argument or evidence that we overlooked. Indeed, we did not overlook this argument. *See* Final Dec. 23. The fact that Patent Owner disagrees with our decision is not grounds for rehearing.

2. Whether the Board Misapprehended or Overlooked Patent Owner's Arguments or Evidence Regarding Ground 2

Patent Owner contends that “[t]o the extent the Board agrees that Ground 1 fails to render the claims obvious, Ground 2 similarly must be reversed.” Req. 12. As discussed above, Patent Owner fails to identify any argument or evidence that we misapprehended or overlooked regarding Ground 1. As Patent Owner’s contention relies solely on its contentions

regarding Ground 1, Patent Owner's contention does not raise grounds for rehearing for the reasons discussed in Section II.B.1 above.

3. *Whether the Board Misapprehended or Overlooked Patent Owner's Argument or Evidence Regarding Ground 3*
a. *Whether the Board Misapprehended or Overlooked Patent Owner's Arguments Regarding Ground 1*

Patent Owner contends that "Ground 3 does not address the deficiencies in Ground 1, as it addresses only further dependent claims." Req. 12 (citing PO Resp. 45). Thus, according to Patent Owner, "Ground 3 should also be reversed if the Board agrees that Ground 1 is deficient." *Id.* Like, Patent Owner's contention in Section II.B.2 above, Patent Owner's contention relies solely on its contentions regarding Ground 1. Accordingly, Patent Owner's contention does not raise grounds for rehearing for the reasons discussed above in Section II.B.1.

b. *Whether the Board Misapprehended the Teachings of Busley*

Patent Owner contends that "[t]he Board misapprehended the teachings of Busley in invalidating the claims. Req. 12. According to Patent Owner, "[t]he Board's rejection of Caterpillar's argument relied on a misreading of a portion of Busley and a failure to recognize improper hindsight bias." *Id.* In support of this contention, Patent Owner asserts that "Wirtgen's analysis largely amounts to matching components by comparing Busley to the preferred embodiment of the '693 patent." Req. 14. Patent Owner asserts further that "it is impermissible hindsight to use the preferred embodiment of the patent as a roadmap to identify prior art." *Id.* (citing *InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1351–52 (Fed. Cir. 2014); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004)). Thus, Patent Owner submits that "the FWD incorrectly found that one of

ordinary skill in the art would have used an isolated subset of Busley's steering system, premised in part on its misreading that a discussion of prior art applies to Busley's system." Req. 13 (citing Final Dec. 31).

In our Final Written Decision, we discuss Busley at length. Final Dec. 31–33. In support of this challenge, Petitioner provides reasons in support of the proposed combination that rely on Busley itself and the testimony of Dr. Arnold. *See* Pet. 60–66. Although we did not expressly adopt Petitioner's reasoning in support of the proposed combination, our discussion of Petitioner's challenge and analysis of that challenge implicitly adopts this reasoning. *See id.* To the extent that we did not make clear that we adopted Petitioner's reasoning in our Final Written Decision, we do so now.

Further, we do not agree that Petitioner's challenge was based on *improper* hindsight. Impermissible hindsight is inferred when the specific understanding or principle within the knowledge of one of ordinary skill in the art that would motivate one (with no knowledge of the claimed invention) to make the proposed combination has not been explained. *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998). As discussed in our Final Written Decision, based on Petitioner's arguments (i.e. reasoning) and the underlying evidence, we determined that Petitioner had sufficiently demonstrated that the claims at issue in Ground 3 were met by the combined teachings of Volpe, Ulrich, and Busley, and that Petitioner articulated a reason, with rational underpinnings, for combining the teachings of Busley with Volpe and Ulrich. *See* Final Dec. 31–33.

For these reasons, Patent Owner does not raise grounds for rehearing.

4. Whether the Board Misapprehended or Overlooked Patent Owner's Arguments or Evidence Regarding Ground 4

Patent Owner contends that “[t]o the extent that the Board agrees that Ground 1 fails to render the claims obvious, Ground 4 similarly must be reversed.” Req. 15. As discussed above in Section II.B.1. Patent Owner’s disagreement with our decision is not grounds for rehearing. Thus, it is not grounds for rehearing for Ground 4 either.

IV. CONCLUSION

For the foregoing reasons, we are not persuaded by Patent Owner’s contentions.

IV. ORDER

Accordingly, it is:

ORDERED that the Patent Owner’s Rehearing Request is denied.

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