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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROSE NORTH AMERICA, INC.,
and
BROSE FAHRZEUGTEILE GMBH & CO. KG, HALLSTADT
Petitioner,

v.

UUSI, LLC,
Patent Owner.

Case IPR2014-00416 and IPR2014-00417
Patent 8,217,612 and 7,579,802

Held: April 30, 2015

BEFORE: GLENN J. PERRY, HYUN J. JUNG, and JASON J. CHUNG, Administrative Patent Judges.

The above-entitled matter came on for hearing on Thursday, April 30, 2015, commencing at 10:00 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

APPEARANCES:

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P R O C E E D I N G S

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JUDGE PERRY: We are convened for oral argument in cases IPR2014-00416 and 00417. Petitioner, Brose, versus Patent Owner, UUSI. These two IPRs are being argued together because they raise common issues and have overlapping prior art. Each side has 90 minutes per the trial order. Petitioner has the burden of proof, of course, to establish the unpatentability of the challenged claims and will argue first. Petitioner may reserve rebuttal time. And before your presentation, please identify yourself for the record. And if anyone wants a five-minute break between arguments since we are going three hours this morning, feel free to raise your hand and say so and we'll take a break between arguments.

So with that, petitioner, when you are ready.

MR. LEAVELL: Thank you, Your Honor. I have got hard copies of the slides.

JUDGE PERRY: Thanks. Appreciate it.

MR. LEAVELL: Good morning, Your Honor. Craig Leavell on behalf of the petitioners and along with me is Elizabeth Cutri. And I've given you the slides. We are going to go through them in order, but I will be skipping some of the slides for the most part.

JUDGE PERRY: Would you like to reserve any time for rebuttal?

MR. LEAVELL: Yes, Your Honor. Thank you. Twenty minutes.

So I would like to begin by talking about the '802 patent which is the 417 IPR. And on slide 9 here, this slide summarizes the grounds that were instituted that were raised by Brose against the '802 patent. So the claims across the top row and the various grounds along the first column.

But today's argument can be focused on a subset of those grounds and claim combinations. First of all, ground 6 and 7 petitioner, Brose, relied on Zuckerman only for the principle that it was obvious or would have been well known in the art to rewrite or rethink Itoh's equation in terms that are mathematically identical. Because patent owner doesn't contest that obviousness of that principle, ground 6 and 7 are essentially, largely overlap prior grounds. So we won't focus on ground 6 or 7 today.

Also, UUSI, the patent owner, does not separately argue dependent claims 8 or 9. So I think we all agree that dependent claims 8 or 9 will rise or fall with independent claim 7. So I won't discuss claims 8 or 9 today either.

Now, on slide 7 here, these are the grounds raised against claim 1 of the '802 patent. And claim 1 of the '802 patent is unpatentable for three reasons. First of all, it's anticipated by the Itoh reference. Ground 1 is obvious over Itoh. Ground 2 is anticipated by Itoh. And ground 5 is obvious over the combination of Itoh and Kinzl.

Now UUSI briefly raises some arguments about the motivation to combine Itoh and Kinzl with respect to ground 5 and very briefly raises some enablement issues, and we'll address those at the end of the presentation.

But in terms of distinctions, differences between the require part and claim 1 of the '802, patent owner identifies only one. And that difference only exists under patent owner's proposed construction. So really the key issue on the patentability of claim 1 of the '802 patent is a claim construction issue and it's whether or not claim 1 is limited to a particular type of sensor. Patent owner argues it's limited to a current amplitude sensor. Whereas, petitioners argue that the plain and ordinary meaning should apply and any type of sensor would fall within the scope of claim 1.

The disputed phrase is found --

JUDGE PERRY: Let me interrupt you. We are using the Philips standard for construction because we are dealing with an expired patent?

MR. LEAVELL: Correct, Your Honor.

JUDGE PERRY: So the spec is relevant?

MR. LEAVELL: Yes, the parties agree on that. The disputed limitation is found in limitation A of claim 1. And it's a sensor for measuring a parameter of a motor coupled to a motor-driven element. For example, the window or the sunroof is the motor-driven element that varies in response to a resistance to motion. For example, if the window or sunroof panel encounters an obstacle,

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