

Filed on behalf of: Robert Bosch LLC and Daimler AG

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Robert Bosch LLC and Daimler AG,
Petitioner

v.

Orbital Engine Company Pty Limited,
Patent Owner

Patent No. 5,655,365

DECLARATION OF DR. RON MATTHEWS

TABLE OF CONTENTS

I.	INTRODUCTION	4
II.	GUIDING LEGAL PRINCIPLES	4
	A. Person of Ordinary Skill in the Art	4
	B. Anticipation Invalidity	5
	C. Obviousness Invalidity	6
III.	BACKGROUND AND EXPERIENCE.....	7
IV.	MATERIALS REVIEWED	10
V.	OVERVIEW OF THE ‘365 PATENT	11
VI.	CLAIM CONSTRUCTION	15
VII.	ANTICIPATION AND OBVIOUSNESS COMBINATIONS.....	20
	A. <i>Bernhardt</i> Discloses All Elements of Claims 1, 2, 5, 10, 12, 13, and 18	20
	<u>Claim 1</u>	22
	<u>Claim 2</u>	27
	<u>Claim 5</u>	30
	<u>Claim 10</u>	31
	<u>Claim 12</u>	32
	<u>Claim 13</u>	34
	<u>Claim 18</u>	34
	B. Obviousness of Claim 9 over <i>Bernhardt</i> and <i>Onishi</i>	35
	C. Obviousness of Claim 14 over <i>Bernhardt</i> and <i>Griese</i>	40

D.	Obviousness of Claims 1, 2, 5, 10, 12-14, and 18 over <i>Eichler '791</i> and <i>Bernhardt</i>	43
	<u>Claim 1</u>	44
	<u>Claim 2</u>	49
	<u>Claim 5</u>	52
	<u>Claim 10</u>	53
	<u>Claim 12</u>	53
	<u>Claim 13</u>	54
	<u>Claim 14</u>	55
	<u>Claim 18</u>	55
E.	Obviousness of Claim 9 over <i>Eichler '791</i> , <i>Bernhardt</i> , and <i>Onishi</i>	56
F.	<i>Onishi</i> Discloses All Elements of Claims 1, 2, and 9	61
	<u>Claim 1</u>	63
	<u>Claim 2</u>	67
	<u>Claim 9</u>	68
G.	Obviousness of Claim 5 over <i>Onishi</i> and <i>Eichler '791</i>	71
H.	Obviousness of Claims 10, 13, 14, and 18 over <i>Onishi</i> and <i>Griese</i>	72
I.	Obviousness of Claim 12 over <i>Onishi</i> and <i>Bernhardt</i>	75
VIII.	SECONDARY CONSIDERATIONS OF OBVIOUSNESS	76
IX.	CONCLUSION.....	77

I, Dr. Ron Matthews, declare as follows:

I. INTRODUCTION

1. I have been retained by Robert Bosch GmbH. (“Bosch” or “Petitioner”) as an independent expert consultant in this proceeding before the United States Patent and Trademark Office. Although I am being compensated at my usual rate of \$500.00 per hour for the time I spend on this matter, no part of my compensation depends on the outcome of this proceeding, and I have no other interest in this proceeding.

2. I understand that this proceeding involves U.S. Patent No. 5,655,365 (“the ‘365 patent”) (Ex. 1001). I understand that the ‘365 patent is a National Stage entry of PCT/AU94/00028, which was filed on January 24, 1994. I have also been informed that the ‘365 patent claims priority to Australian Application No. PL6972, filed January 25, 1993.

3. I have been asked to consider whether certain references disclose or suggest certain features in the claims of the ‘365 patent. I have done so and set forth my opinions below:

II. GUIDING LEGAL PRINCIPLES

A. Person of Ordinary Skill in the Art

4. I am informed that a “person of ordinary skill in the art” (“POSITA”) refers to a hypothetical person who is presumed to have known the relevant art at

the time of the invention. Many factors may determine the level of ordinary skill in the art, including: (1) the type of problems encountered in the art, (2) prior art solutions to those problems, (3) the rapidity with which innovations are made, (4) the sophistication of the technology, and (5) the educational level of active workers in the field. I understand that a POSITA is a person of ordinary creativity, not an automaton, meaning that a POSITA may employ inferences and creative steps in their work. I am informed that the relevant timeframe is prior to January 25, 1993, which is the earliest priority filing date for the '365 patent, and the opinions below pertain to that timeframe.

5. A POSITA in the art for this patent would have at least an undergraduate degree in mechanical engineering or a similar technical field, and at least two (2) years of relevant work experience or equivalent advanced education in a field related to engine technology. Accordingly, I have used this definition in my analysis below.

6. In my opinion, under the definition provided above, I was at least a POSITA at the relevant time of the invention. In my opinion, I also supervised others who were a POSITA at the relevant time of the invention.

B. Anticipation Invalidity

7. I understand that a patent claim is “anticipated,” and, therefore, invalid, if a single prior art reference discloses (expressly or inherently) each and

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