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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ROBERT BOSCH LLC and DAIMLER AG,
Petitioners,

v.

ORBITAL AUSTRALIA PTY LTD,
Patent Owner

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Case No. IPR2015-01259
U.S. Patent 5,655,365

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# PATENT OWNER'S REQUEST FOR REHEARING

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# PATENT OWNER'S REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 42.71(d), Orbital Australia Pty Ltd f/k/a/ Orbital Engine Company (Australia) Pty. Ltd. ("Patent Owner") hereby submits this Request for Rehearing in response to the Decision, Institution of *Inter Partes* Review dated December 30, 2015 (Paper No. 9, "Decision").

## I. INTRODUCTION

In the Decision, the Board grants review of claims 1, 2, 5, 9, 10, 12-14, and 18 of U.S. Patent No. 5,655,365 (the '365 Patent) on various grounds following the Decision's construction of independent claim 1's recitation of "while said ignition is so retarded, increasing the fuelling rate of said at least one cylinder to a level higher than that required when the engine is operating normally." *See* Paper 9 at 7-10. The Decision construes this phrase to mean "increasing the quantity of fuel delivered to a cylinder, while the cylinder is in an ignition-retarded condition, to a level higher than the quantity of fuel that would be delivered in a normal operating condition." *Id*. at 10.

In construing this phrase under the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*), the Board misapprehends and overlooks Patent Owner's arguments regarding the meaning of critical terms, overlooks the challenged claims' plain language, and places undue emphasis on the specification of the '365 Patent in a manner inconsistent with the plain language.

The Decision's improper claim construction results in an erroneous decision with respect to the grounds for which trial was instituted. Patent Owner respectfully requests that the Board reconsider its decision with regard to claim construction, as well as deny the Petition with respect to all instituted grounds.

## II. LEGAL STANDARDS

Under 37 C.F.R. § 42.71(d), "[a] party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board." "The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed." *Id*. "When rehearing a decision on petition, a panel will review the decision for an abuse of discretion." 37 C.F.R. § 42.71(c). "An abuse of discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors." *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000).

## III. ARGUMENT

Patent Owner respectfully submits that the Decision misapprehends and overlooks Patent Owner's arguments regarding the meaning of critical terms of the challenged claims, and additionally applies an erroneous legal standard in overlooking the challenged claims' plain language, while placing undue emphasis

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