

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC COMPANY
Petitioner,

v.

UNITED TECHNOLOGIES CORPORATION,
Patent Owner.

Case IPR2016-01289
Patent 7,060,360 B2
Technology Center 3900

Record of Oral Hearing
Held: September 18, 2017

Before GRACE K. OBERMANN, CHRISTOPHER M. KAISER, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

Case IPR2016 01289
Patent 7,060,360 B2

APPEARANCES:

ON BEHALF OF PETITIONER:

ANISH DESAI, ESQUIRE
Weil, Gotshal, and Manges, LLP
767 Fifth Avenue
New York, New York 10153
(212) 310-8730

ON BEHALF OF PATENT OWNER:

LAUREN A. DEGNAN, ESQUIRE
W. KARL RENNER, ESQUIRE
Fish and Richardson, PC
The McPherson Building
901 15th Street Northwest
Suite 700
Washington, D.C. 20005
(202) 626-6392

The above-entitled matter came on for hearing on Monday, September 18, 2017, commencing at 1:00 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

PROCEEDINGS

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JUDGE OBERMANN: Please be seated.

JUDGE OBERMANN: Great, there we are. This is a final hearing in IPR2016-01289, General Electric Company versus United Technologies Corporation. The patent at issue is 7,060,360. I'm Judge Obermann, and to the right, we have Judge Michelle Ankenbrand. Appearing remotely from Denver today we have on the screen Judge Christopher Kaiser. I'd like to start with appearances. Who do we have appearing for Petitioner today?

MR. DESAI: Anish Desai, on behalf of Petitioner.

JUDGE OBERMANN: Hello, Mr. Desai, will both of you be delivering argument or just one of you?

MR. DESAI: Just me.

JUDGE OBERMANN: Okay. Thank you, and who do we have for Patent Owner?

MR. RENNER: Karl Renner, Your Honor.

JUDGE OBERMANN: Hello, Mr. Renner.

MS. DEGNAN: Lauren Degnan.

JUDGE OBERMANN: Hello, Lauren, nice to see you today.

MR. RENNER: Also representatives from Batton Whitney, Your Honor, are with us, Troy Prince and Janice Jabioo.

JUDGE OBERMANN: Okay. Welcome, thank you. And Mr. Renner, will you be delivering argument or will both of you?

MR. RENNER: Ms. Degnan will, thank you.

1 JUDGE OBERMANN: Thank you very much. Okay. Because we
2 have -- especially because we have Judge Kaiser appearing remotely I'll ask
3 that when you refer to a demonstrative, please refer to the slide number. We
4 did receive your transmissions last week so we have them available to us on
5 the computer. But it would be very helpful though for the transcript and also
6 for Judge Kaiser if you could refer to the slide before you begin speaking.
7 Each party will have 45 minutes of total time to present arguments.
8 Petitioner bears the burden of proof and will go first, and may reserve
9 rebuttal time if you'd like. Patent Owner will then go and you can use your
10 entire 45 minutes and after that Petitioner will use any rebuttal time that's
11 been reserved. I'm going to use the clock on the wall to time you all. And
12 we received no objections to the demonstrative exhibits, so both sides agree
13 to use them all, thank you very much for that. Mr. Desai, I'm going to start
14 the clock and when you're ready to begin you may. First I need to know,
15 would you like to reserve any time for rebuttal?

16 MR. DESAI: I think I'll reserve about ten minutes.

17 JUDGE OBERMANN: Ten minutes?

18 MR. DESAI: Yes.

19 JUDGE OBERMANN: So, I'm going to set the clock for 35 minutes,
20 and I'll start it when you begin speaking.

21 MR. DESAI: Good afternoon, Your Honors. The '360 patent is
22 directed to an article that comprises a silicon-based substrate, a bond layer
23 comprising of a refractory metal disilicide/silicon eutectic, and an
24 environmental barrier there selected from an alkaline earth aluminosilicate
25 based on barium and strontium, which has been referred to in the briefs as
26 BSAS or yttrium silicate. Petitioner believes that it has shown by a

1 preponderance of the evidence in its briefs that this combination of layers
2 would have been obvious to a person of ordinary skill in the art as of the
3 May 2013 filing date of the '360 patent. As set forth in our briefs, the '360
4 claims are directed to the application of a known technique using an
5 environmental barrier layer, which I'll use shortly, an EBL, to a known
6 article which is the refractory metal disilicide material disclosed in the
7 Terentieva reference to yield a predictable result, which is protection of
8 silicon containing materials in the Terentieva article from water vapor
9 attack.

10 Before I walk through some of the undisputed evidence and
11 motivation to combine and reasonable expectation of success, in this
12 particular case the overview of the prosecution history as well as the prior art
13 that the examiner didn't consider will really show us how narrow the issue is
14 before the Board today.

15 So, I'll start with slide 2 here, and what I have here is the first -- in the
16 top left corner is the original claim and what that covered was a silicon
17 substrate and a bond layer. The bond layer comprising an alloy refractory
18 metal disilicide/silicon eutectic. That claim was found to be anticipated by
19 the Terentieva reference, this is in the file history. After the office action
20 finding anticipation, Patent Owner did not contest that anticipation, and
21 instead amended claim 1. Claim 1 was amended to require an additional
22 layer, a barrier layer, between the substrate -- sorry, the barrier layer above
23 the bond layer, and that's shown on the right. Figure at the bottom, the
24 bottom right, and again, this claim was deemed anticipated by the Terentieva
25 reference. And again, Patent Owner did not contest this anticipation finding.

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