

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WAVETAMER GYROS, LLC,
Petitioner,

v.

SEAKEEPER, INC.,
Patent Owner.

Cases IPR2017-01931 and IPR2017-01996¹
Patents 8,117,930 B2 and 7,546,782 B2

Before LORA M. GREEN, MICHAEL W. KIM, and PATRICK R. SCANLON,
Administrative Patent Judges.

GREEN, *Administrative Patent Judge.*

DECLARATION OF DAVID E. BENNETT

¹ This paper addresses issues that are the same in the identified cases. The word-for-word identical paper is filed in each proceeding identified in the heading. References to exhibits refer to Exhibits in IPR2017-01931.

DECLARATION OF DAVID E. BENNETT

Declarant states:

1. I, David E. Bennett, am a registered patent attorney and have practiced exclusively in the field of intellectual property law for more than 30 years. I am lead counsel in this proceeding.
2. Our firm opened a matter involving the investigation of U.S. Patent Nos. 8,117,930 (the '930 patent, Exhibit 1001) and 7,546,782 (the '782 patent, Exhibit 1042) on or about August 13, 2015, but I was not involved until about December 15, 2016. At that time Larry Coats, a member of our firm, asked me to review an invalidity analysis regarding the '930 and '782 patents prepared by Brandee N. Woolard, an associate in our firm. I was provided printed copies of numerous references including U.S. Patent No. 6,973,847 (the Adams patent, Exhibit 1006), German Patent DE 19909491 A1 (Jäger, Exhibit 1010), and Statutory Registration H312 (Parker, Exhibit 1017). The Adams patent discloses the basic elements of a gyroscopic boat stabilizer, while the Jäger and Parker references disclose the use of interleaved fins to dissipate heat from a rotating heat generating component. Adams and Jäger were eventually used in the asserted grounds for challenge. Parker was not.
3. The Adams patent was filed on June 4, 2003 by the Patent Owner in this case and has the same inventors as the '930 and '782 patent. The application

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that lead to the grant of the Adams patent was published on December 9, 2004 as U.S. Publication No. 2004/0244513 (the Adams publication, Exhibit 1043), which is more than one year prior to the filing date of the '930 and '782 patents. The Adams publication is prior art under 35 U.S.C. §102(b). The specification and drawings of the Adams publication are nearly identical to the Adams patent cited in the petitions. While the Adams patent is technically not prior art, the subject matter disclosed in the Adams patent is prior art

4. During my initial review in mid-December 2016, I recognized that the application for the Adams patent was published on December 9, 2004, which is more than one year prior to the filing date that the '930 and '782 patents, and that the Adams publication was available as prior art under 35 U.S.C. §102(b). Because I already had a printed copy of the Adams patent, I proceeded with my initial review using the printed copy of the Adams patent and reported back to Mr. Coats who was advising our client. At that time, I expected that the Adams publication would be used as prior art to show the basic elements of a boat stabilizer if any post issuance proceedings were instituted.

5. I did not do any further work on the matter until mid-January 2017. Mr. Coats requested that I conduct a patent search and provide further assistance with the analysis of the '930 and '782 patents. On February 6, 2017, Ms. Woolard and I conducted a patent search in the United States Patent Office focusing on the

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use of interleaved fins for cooling bearings and other rotating components. We were not concerned at this time with prior art in the field of boat stabilizers because we expected to use Adams publication in any invalidity challenges to show the basic elements of a boat stabilizer. Our attention was focused on finding prior art related to interleaved fins that could be combined with the Adams publication to make strong invalidity arguments. During this subsequent search, we identified more than 30 references related to bearing cooling and interleaved fins that required further analysis. The patent to Bimshas (Exhibit 1012) cited in the petitions was among the references identified in this search.

6. Following the patent search, Mr. Coats asked me to prepare petitions for *inter partes* review for the '930 and '782 patents. I began to draft the petitions and prepare the claim charts in late February 2017, approximately ten (10) weeks after my initial evaluation in December 2016. In preparing the petitions, I referred to the references that I had previously printed and annotated, including the Adams patent. I did not spend time thinking about the prior art status of Adams. In my mind, I knew that the subject matter disclosed by the Adams patent was prior art. My attention instead was focused on developing the legal theories for invalidity, understanding the scientific principles of heat transfer, working with the expert witness to conduct simulations to support our invalidity arguments, and drafting the petitions. One area requiring a lot of attention was developing arguments

regarding the functional limitations in claims 2 and 13 of the '782 patent that the heat transfer between the interleaved fins be "primarily by gaseous conduction." I spent more than 150 hours on these issues. With my attention fixated on these issues, I overlooked the need to substitute the Adams publication for the Adams patent and mistakenly cited the Adams patent rather than the Adams publication in the petitions.

7. I was unaware of the mistake in the petitions until I received Patent Owner's Preliminary Response on November 17, 2017 and have acted expeditiously to correct the mistake. Although Patent Owner was provided drafts of the petitions prior to filing, Patent Owner elected not to point out the mistake before the petitions were filed. We contacted counsel for Patent Owner on November 20, 2017, and requested his consent to file a motion to terminate the current proceeding so that a corrected petition could be subsequently filed, or to file a second petition along with motion for joinder. On November 21, 2017, I received an email from counsel for Patent Owner indicating that Patent Owner opposed our proposals. On November 27, 2017, after the Thanksgiving holiday, I had a telephone conference with counsel for Patent Owner during which he reaffirmed Patent Owner's opposition to Petitioner's proposals.

8. Petitioner has a strong case for invalidity based on the Adams publication. The Adams publication discloses the basic structure of the claimed

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