

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MAHLE FILTER SYSTEMS NORTH AMERICA, INC.,  
Petitioner,

v.

INGEVITY SOUTH CAROLINA, LLC,  
Patent Owner.

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Case IPR2019-00960  
Patent RE38,844 E

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Before DONNA M. PRAISS, CHRISTOPHER L. CRUMBLEY, and  
JON B. TORNQUIST, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
and Denying Motion for Joinder  
*35 U.S.C. §§ 314(a), 315(c)*

Mahle Filter Systems North America, Inc. filed a Petition requesting an *inter partes* review of claims 1–8, 11, 12, 14–16, 18–21, 24, 25, 27–29, 31–33, 36, 37, 39–41, 43–45, 48, 49, and 51–53 of U.S. Patent No. RE38,844 E (Ex. 1001, “the ’844 patent”). Paper 1. Mahle also filed a Motion for Joinder seeking to join this proceeding with an *inter partes* review filed by BASF Corporation challenging the ’844 patent, case number IPR2019-00202 (“the 202 IPR”). Paper 3. Ingevity South Carolina, LLC, identified as a real party in interest to the ’844 patent (Paper 5, 1)<sup>1</sup>, filed a Preliminary Response to the Petition. Paper 8. Ingevity also filed an Opposition to the Motion for Joinder. Paper 7.

According to Mahle, the Petition in this case is “intentionally identical” to the Petition filed by BASF in the 202 IPR, and both seek to challenge the same claims of the ’844 patent on the same grounds. Paper 3, 1. Both Petitions are supported by the same evidence, including the testimony of the same expert. *Id.* Mahle presents no reason why our decision whether to institute trial in the 202 IPR should not be controlling in this proceeding.

On May 13, 2019, we determined that the Petition in the 202 IPR had not demonstrated a reasonable likelihood that at least 1 claim of the ’844 patent is unpatentable, and thus denied institution of an *inter partes* review trial. *See* IPR2019-00202, Paper 10. BASF requested rehearing of that Decision (IPR 2019-00202, Paper 11), and in a Decision entered today we deny rehearing. IPR2019-00202, Paper 13. For the same reasons stated in

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<sup>1</sup> Ingevity’s Mandatory Notices also list Ingevity Corporation as a real party in interest, but only Ingevity South Carolina, LLC is named as a party in this proceeding. Paper 5, 1.

our Decision Denying Institution and Decision Denying Rehearing, we conclude that the record in this proceeding, which is identical to that found in the 202 IPR, is insufficient to establish a reasonable likelihood that at least 1 claim of the '844 patent is unpatentable. Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition and Preliminary Response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Thus, we decline to institute an *inter partes* review.

Under 35 U.S.C. § 315(c), if an *inter partes* review has been instituted, the Director may join as a party to that *inter partes* review any person who files a petition that the Director<sup>2</sup> “determines warrants the institution of an inter partes review.” At least two preconditions of this provision have not been met: first, we did not institute an *inter partes* review in the 202 IPR, and second, we do not determine that the Petition in this proceeding warrants institution. The Motion for Joinder is, therefore, denied.

#### ORDER

For the reasons given, it is:

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted; and

FURTHER ORDERED that the Motion for Joinder is *denied*.

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<sup>2</sup> The responsibility for determining whether to institute an *inter partes* review has been delegated to the Board. See 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”).

IPR2019-00960  
Patent RE38,844 E

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