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EXAMINER

DOERRLER, WILLIAM CHARLES

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

November 16, 2022

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90014950
PATENT NO. : 6601821
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



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(For Patent Owner)

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(For Third Party Requester)

In re Tyler
U.S. Patent No.: 6,601,821
Ex Parte Reexamination Proceeding
Control No. 90/014,950
Filed: January 26, 2022

:
:
: **DECISION ON PETITION TO**
: **VACATE REEXAMINATION**
: **ORDER**

This decision addresses patent owner’s March 29, 2022 petition entitled “Patent Owner’s Petition Under 37 C.F.R. §1.181(a) to Vacate the Reexamination Order.” This decision also addresses requester’s April 18, 2022 paper entitled “Third-Party Requester’s Opposition to Patent Owner’s Petition Under 37 C.F.R. §1.181(a) to Vacate the Reexamination Order.”

Patent owner’s March 29, 2022 petition, requester’s April 18, 2022 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

PERTINENT BACKGROUND

On August 5, 2003, U.S. Patent No. 6,601,821 (the ‘821 patent) issued to inventor Jeffrey A. Tyler with claims 1-22. The ‘821 patent is assigned to G.W. Lisk Company Inc. (Lisk or patent owner).

On July 15, 2016, Lisk filed an action for infringement of the ‘821 patent against GITS Manufacturing Company (GITS or requester) in the U.S. District Court for the Western District of New York.¹ On July 20, 2017, the district court ordered transfer of the action to the U.S. District Court for the Southern District of Iowa.² The action (the Litigation) was stayed from March 2018 until April 2021, and remains pending today.

On August 31, 2017, GITS filed two petitions for *inter partes* review (IPR) of the ‘821 patent, in which it identified itself as “Power-Packer North America, Inc., *d/b/a* GITS Manufacturing Co.” The first petition challenged claims 1-11, and was assigned case number IPR2017-02034 (the ‘2034 IPR). The

¹ This action was captioned *G.W. Lisk Company, Inc. v. GITS Manufacturing Co.*, No. 6:16-cv-6493 (W.D. New York).
² The transfer order is Docket Entry No. 14 dated July 20, 2017 for case No. 6:16-cv-6493. After transfer, the action was assigned No. 4:17-cv-273 (S.D. Iowa) and was captioned *G.W. Lisk Company, Inc. v. Power-Packer North America, Inc., d/b/a GITS Manufacturing Co.*

second petition challenged claims 12-22, and was assigned case number IPR2017-02035 (the ‘2035 IPR). The Patent Trial and Appeal Board (PTAB) granted institution, and review proceeded on multiple grounds of invalidity, all of which were based on three references referred to as Eggers, Martin, and Oleksiewicz.³

On March 18, 2019, the PTAB issued final written decisions in both IPRs, holding claims 1-5, 12, 13, 16-18 and 20-22 unpatentable, and finding that GITS did not meet its burden of showing that claims 6-11, 14, 15 and 19 were unpatentable. *See, e.g.*, the final written decisions in *Power-Packer North America, Inc., d/b/a GITS Manufacturing Co. v. G.W. Lisk Co., Inc.*, IPR2017-02034, Paper No. 31 (PTAB Mar. 18, 2019) (the ‘2034 PTAB Decision), and *Power-Packer North America, Inc., d/b/a GITS Manufacturing Co. v. G.W. Lisk Co., Inc.*, IPR2017-02035, Paper No. 29 (PTAB Mar. 18, 2019) (the ‘2035 PTAB Decision).

In the ‘2034 IPR, patent owner filed a request for rehearing on April 17, 2019, which was subsequently denied on October 30, 2019.⁴ GITS appealed both PTAB decisions to the United States Court of Appeals for the Federal Circuit, and patent owner subsequently cross-appealed. The Federal Circuit affirmed the ‘2034 and ‘2035 PTAB Decisions on April 13, 2021.⁵ On November 15, 2021, the Office issued and published in the Official Gazette an *Inter Partes* Review Certificate (2494th) in the ‘821 patent, reflecting the results of the IPRs as affirmed by the Federal Circuit, and stating that claims 1-5, 12, 13, 16-18 and 20-22 were cancelled.

GITS deposited a request for *ex parte* reexamination of the ‘821 patent (request) with the Office on January 26, 2022, challenging claims 6-11, 14, 15 and 19. The request was assigned control no. 90/014,950 (the ‘950 reexamination proceeding), and was accorded a filing date of January 26, 2022. The request proposed multiple grounds of invalidity, based on four references described in section IV.B, and was accompanied by the “Declaration of Joseph F. Edell” (the Edell declaration), describing the electronic prior art searches the declarant performed in support of requester’s arguments addressing 35 U.S.C. 315(e)(1) estoppel.⁶ The Office determined that the request raised substantial new questions of patentability (SNQs) warranting reexamination, and accordingly ordered reexamination on February 24, 2022.

On March 29, 2022, patent owner filed the instant petition entitled “Patent Owner’s Petition Under 37 C.F.R. §1.181(a) to Vacate the Reexamination Order” (petition), requesting that the Director exercise supervisory authority to vacate the Office’s reexamination order, because it alleges that GITS was estopped by 35 U.S.C. 315(e)(1) from requesting or maintaining the reexamination proceeding. Patent owner’s petition was accompanied by the “Declaration of Expert Prior-Art Searcher Eugene Lhymn” (the Lhymn declaration), describing prior art searches a skilled searcher would have conducted. This petition was opposed by requester in a paper filed April 18, 2022 entitled “Third-Party Requester’s

³ German Published Examined Application No. 1268494 to Eggers; U.S. Patent No. 4,201,116 to Martin; and U.S. Patent No. 6,006,732 to Oleksiewicz.

⁴ While the request for rehearing was pending, GITS filed an appeal to the Federal Circuit from the ‘2034 IPR, and patent owner filed a cross-appeal shortly thereafter. The court dismissed these appeals as premature in view of patent owner’s then-pending request for rehearing. *See Power-Packer North America, Inc., dba GITS Manufacturing Co. v. G.W. Lisk Company, Inc.*, Order in Appeal Nos. 2019-1900 and 2019-1964 (Fed. Cir. July 18, 2019) (non-precedential).

⁵ *See Power-Packer North America, Inc., dba GITS Manufacturing Co. v. G.W. Lisk Company, Inc.*, Appeal Nos. 2020-1250 and 2020-1323 (Fed. Cir. April 13, 2021) (non-precedential affirmance under Fed. Cir. Rule 36) for the ‘2034 IPR, and *Power-Packer North America, Inc., dba GITS Manufacturing Co. v. G.W. Lisk Company, Inc.*, Appeal Nos. 2019-1902 and 2019-1965 (Fed. Cir. April 13, 2021) (non-precedential affirmance under Fed. Cir. Rule 36) for the ‘2035 IPR.

⁶ *See* request, pages 15, 17, 19 and 21 (referencing the search results described in Ex. 35).

Opposition to Patent Owner's Petition Under 37 C.F.R. §1.181(a) to Vacate the Reexamination Order" (opposition).

STATUS OF THE CLAIMS

The '821 patent issued with claims 1-22. As described above, claims 1-5, 12, 13, 16-18 and 20-22 were successfully challenged in *inter partes* review proceedings and subsequently cancelled. Original claims 6-11, 14, 15 and 19 were previously challenged in *inter partes* review proceedings, but the challenges were not successful, and these claims were not cancelled. In the '950 reexamination proceeding, reexamination of claims 6-11, 14, 15 and 19 was requested, and subsequently ordered.

DECISION

The estoppel provisions of 35 U.S.C. 315(e)(1) provide:

PROCEEDINGS BEFORE THE OFFICE.—The petitioner in an *inter partes* review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review.

When submitting a request for *ex parte* reexamination, a third party requester must also submit a certification that “the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request.”⁷ 37 CFR 1.510(b)(6).⁸

Here, when requester deposited its request for reexamination of claims 6-11, 14, 15 and 19 of the '821 patent with the Office, requester included the following certification statement on page (iii) of the request: “[p]ursuant to 37 C.F.R. § 1.510(b)(6), Requester hereby certifies that the statutory estoppel provisions of 35 U.S.C. § 315(e)(1) and 35 U.S.C. § 325(e)(1) don't prohibit Requester from filing this *ex parte* patent reexamination request.” The request also included a lengthy discussion about why requester believed it was not estopped from filing the request. *See, e.g.*, request at pages 9-23.

A certification under Rule 1.510(b)(6) is either proper or improper, *i.e.*, if any part of the certification is improper, then the entire certification is improper. If the certification is improper, the Office will vacate the entire proceeding. The Office analyzes whether a certification is improper due to estoppel under 35 U.S.C. 315(e)(1) by determining the following four elements, which are found in the language of the statute itself:

1. Whether the third party requester of the *ex parte* reexamination proceeding was a petitioner in the *inter partes* review, or was a real party in interest or a privy of the petitioner;

⁷ The estoppel provisions of 35 U.S.C. 325(e)(1) are virtually identical to those of 35 U.S.C. 315(e)(1), except for being based on prior post-grant review proceedings, instead of prior *inter partes* review proceedings. Because no post-grant proceedings have been instituted for the '821 patent, the estoppel provisions of 35 U.S.C. 325(e)(1) are not relevant to this decision.

⁸ The regulations governing *ex parte* reexamination do not require a requester to identify itself upon the filing of a request for reexamination. For this reason, one of the purposes of the requirement for a certification is to permit the requester, *i.e.*, the real party in interest, to file its request anonymously. “The certification requirement of 37 CFR 1.50(b)(6), coupled with a party's 37 CFR 11.18 certification obligations when transacting business before the Office, are considered sufficient to ensure compliance with the *inter partes* review and post grant statutory estoppel requirements.” MPEP 2214. Thus, to permit a requester to file a request anonymously, the Office generally relies on requester's certification under 37 CFR 1.510(b)(6), coupled with a party's 37 CFR 11.18 certification obligations.

2. Whether the claim(s) of the patent under *inter partes* review are also requested to be reexamined in the *ex parte* reexamination proceeding;
3. Whether the *inter partes* review has resulted in a final written decision pursuant to 35 U.S.C. 318(a); and
4. Whether the ground(s) raised in the *ex parte* reexamination proceeding are the same grounds(s) that were raised or reasonably could have been raised by the requester during the *inter partes* review.

In the present case, review of the record shows that all elements have been satisfied, for the reasons set forth below. Accordingly, requester's certification is improper, and the requester is estopped under 35 U.S.C. 315(e)(1) from requesting reexamination of claims 6-11, 14, 15 and 19 of the '821 patent on the grounds raised in the request.

I. THE RECORD SUFFICIENTLY SHOWS THAT ELEMENT 1 IS SATISFIED

To satisfy element 1, the record must sufficiently show that the third party requester of the *ex parte* reexamination proceeding was a petitioner in the *inter partes* review, or was a real party in interest or a privy of the petitioner.

The record shows that GITS was the petitioner in the '2034 and '2035 IPR proceedings. In those proceedings, the petitioner was identified as "Power-Packer North America, Inc., *d/b/a* GITS Manufacturing Co." *See, e.g.*, the '2034 and '2035 PTAB Decisions at 1-2.⁹ The record also shows that the third party requester of the present reexamination proceeding is GITS, and that it is the same GITS that was the petitioner in the '2034 and '2035 IPR proceedings. *See, e.g.*, the identification of GITS as the requester at page (i) of the request, and the discussion of requester's involvement in the prior IPR proceedings at pages 8-23 of the request.¹⁰

Accordingly, the record shows that element 1 has been satisfied.

II. THE RECORD SUFFICIENTLY SHOWS THAT ELEMENT 2 IS SATISFIED

To satisfy element 2, the record must sufficiently show that the claims of the patent under *inter partes* review are also requested to be reexamined in the *ex parte* reexamination proceeding.

⁹ *See also* Memorandum filed in the Litigation on October 19, 2017 (Petition Exhibit J), which states at page 3 that "GITS filed two petitions for *inter partes* review of the '821 patent on August 31, 2017 (Inter Partes Reexamination Nos. IPR2017-02034 and 02035...)", and Stipulation filed in the Litigation on February 22, 2022 (Petition Exhibit H), which states at paragraph 1 that "[i]n 2014, the corporate name of Gits Manufacturing Company was changed to Power Packer North America, Inc." and that, as a result, "'Gits Manufacturing Company' became a brand name of Power Packer North America, Inc."

¹⁰ The very first sentence of the request states "Dear Commissioner: Pursuant to 35 U.S.C. 302 and 37 C.F.R. 1.510, the undersigned, on behalf of GITS Manufacturing Company (the "Requester") requests *ex parte* reexamination of claims 6-11, 14, 15, and 19 (the "Challenged Claims") of U.S. Patent No. 6,601,821 ("the '821 Patent," Exhibit 1), issued on August 5, 2003." Request at page (i). The request discusses requester's involvement in the prior IPR proceedings in section II.D. of the request, *e.g.*, at page 8 when it states that "[i]n IPR2017-02034, the Board found that Requester GITS Manufacturing had shown..." and "[i]n IPR2017-02035, the Board found that Requester had shown..." Furthermore, section II.E. of the request repeatedly mentions requester's involvement in the prior IPR proceedings, for example, "in IPR2017-02034, -02035, Requester argued ...", "[i]n IPR2017-02034, -02035, Requester filed IPR petitions ..." and "[i]n preparing its petitions in the prior IPRs, Requester determined...", and also mentions that requester did not learn of the Heywood reference cited in the request until "four years after the Requester filed the petitions in IPR2017-02034, -02035." Request at pages 9, 11 and 16.

The record shows that claims 6-11, 14, 15 and 19 of the '821 patent are requested to be reexamined in the present reexamination proceeding. The record also shows that claims 6-11 of the '821 patent were under review in the '2034 IPR proceeding, and that claims 14, 15 and 19 of the '821 patent were under review in the '2035 IPR proceeding. *See, e.g.*, '2034 PTAB Decision at 2-4 and 68 (for claims 6-11) and '2035 PTAB Decision at 2-4 and 69 (for claims 14, 15 and 19).

Accordingly, the record shows that element 2 has been satisfied.

III. THE RECORD SUFFICIENTLY SHOWS THAT ELEMENT 3 IS SATISFIED

To satisfy element 3, the record must sufficiently show that the *inter partes* review has resulted in a final written decision pursuant to 35 U.S.C. 318(a). Estoppel under 35 U.S.C. 315(e)(1) applies on a claim-by-claim basis, and there is no estoppel with respect to a claim as to which no final written decision results. *Credit Acceptance v. Westlake Servs.*, 859 F.3d 1044, 1052-53 (Fed. Cir. 2017).

The record shows that claims 6-11, 14, 15 and 19 of the '821 patent are requested to be reexamined in the present reexamination proceeding.

The record also shows that claims 6-11, 14, 15 and 19 were the subject of final written decisions under 35 U.S.C. 318(a), in which the PTAB found that petitioner GITS failed to demonstrate, by a preponderance of the evidence, that claims 6-11, 14, 15 and 19 were unpatentable. *See, e.g.*, '2034 PTAB Decision at 2-4 and 68 (for claims 6-11) and '2035 PTAB Decision at 2-4 and 69 (for claims 14, 15 and 19). For this reason, the record shows that the '2034 and '2035 IPR proceedings have resulted in final written decisions pursuant to 35 U.S.C. 318(a) with respect to claims 6-11, 14, 15 and 19 of the '821 patent.

Accordingly, the record shows that element 3 has been satisfied.

IV. THE RECORD SUFFICIENTLY SHOWS THAT ELEMENT 4 IS SATISFIED

To satisfy element 4, the record must sufficiently show that the ground(s) raised in the reexamination proceeding are the same grounds(s) that were raised or reasonably could have been raised by the requester during the prior *inter partes* review.

The record shows that all grounds raised by the requester against claims 6-11, 14, 15 and 19 were not previously raised in the prior *inter partes* reviews. Therefore, the decision turns on whether the grounds reasonably could have been raised by the requester during the prior *inter partes* reviews.

A. "Reasonably Could Have Raised"¹¹

As an initial matter, the issue of what prior art reasonably could have been raised need not be further addressed if the record provides evidence, for example, that a reference was known to the requester at a time when it could have been raised in the *inter partes* review. The issue of what prior art reasonably could have been raised in an earlier *inter partes* review, however, is not limited to the actual knowledge of the requester. The legislative history of the America Invents Act (AIA) defines "reasonably could have raised" as "prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover."¹² In view of the number of commercial databases available to the public,

¹¹ *See also* "Decision *Sua Sponte* Vacating *Ex Parte* Reexamination Request Filing Date and Dismissing Petition as Moot," issued September 10, 2020 in 90/014,535, pages 14-16, for a discussion of Office policy.

¹² *See* 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

most patents and printed publications, particularly U.S. patents and U.S. patent application publications, may, in general, be expected to be discovered by a skilled searcher conducting a diligent search.

Moreover, a skilled searcher conducting a diligent search in preparation for a PTAB trial is assumed to conduct a more robust search than an examiner's search or an attorney's pre-examination search. Such a search would likely be informed by the specific claims that the party is attempting to invalidate. It would not be unreasonable to consult an expert in the relevant field for search assistance in order to prepare for a PTAB trial.¹³

A requester may, however, provide evidence that a skilled searcher conducting a diligent search reasonably could not have been expected to discover the reference. The legislative history of the AIA distinguishes the meaning of the language "reasonably could have raised" from an interpretation which would have required a "scorched-earth search".¹⁴

The present bill also softens the could-have-raised estoppel that is applied by *inter partes* review against subsequent civil litigation by adding the modifier "reasonably." It is possible that courts would have read this limitation into current law's estoppel. Current law, however, is also amenable to the interpretation that litigants are estopped from raising any issue that it would have been physically possible to raise in the *inter partes* reexamination, even if only a scorched-earth search around the world would have uncovered the prior art in question. Adding the modifier "reasonably" ensures that the could-have-raised estoppel extends only to that prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover.

The requester may show, for example, that a reference is an "obscure text[] unlikely to be discovered upon a reasonably diligent search of the relevant prior art." See *Praxair Distribution, Inc. et al. v. INO Therapeutics, LLC*, IPR2016-00781, Paper No. 10 (PTAB August 25, 2016), page 9.

B. Evaluation of the Prior Art

The field of endeavor of the '950 reexamination proceeding is emission control systems for internal combustion engines and, in particular, exhaust gas recirculating valves, which regulate exhaust flow rates in exhaust gas recirculating systems.¹⁵ The requester relies on the following prior art references, which are all from this field of endeavor and contain overlapping teachings:¹⁶

- French Published Patent Application No. 2,508,565 to Weigle published December 31, 1982 (**Weigle**).
- INTERNAL COMBUSTION ENGINE FUNDAMENTALS by Heywood published in 1988 (**Heywood**).
- "Camless Engine", Society for Automotive Engineers Technical Paper 960581 to Schechter and Levin published in 1996 (**Schechter**).

¹³ Looking at the relevant data from the time period when the '2034 and '2035 IPR proceedings were filed, the AIPLA 2017 Economic Survey at I-162 states that the mean estimated cost of filing a post-grant proceeding through filing the petition for review is \$124,000. This estimate includes expert fees, but does not include PTAB filing fees and prior art searching. In 2017, the petition fee for filing an IPR challenging up to 20 claims was \$9,000. Given these costs, it is expected a petitioner would be motivated to conduct a diligent search, including contacting experts in the relevant field for recommendations on prior art and/or to determine the state of the art.

¹⁴ 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

¹⁵ The '821 patent at 1:15-35.

¹⁶ See request, pages 38, 133, 174, and 294.

- PCT Publication WO 91/03630 to Rose published on March 21, 1991 (**Rose**).

Based on the above references, the requester proposed the following grounds of rejection of claims 6-11, 14, 15, and 19 of the '821 patent:

1. Claims 6-11, 14, 16, and 19 are rendered obvious by Weigle alone or in view of Heywood.
2. Claims 6-11, 14, 15, and 19 are rendered obvious by Weigle, alone or in view of Heywood, and further in view of Schechter.
3. Claims 6-11, 14, 16, and 18 are rendered obvious by Rose, alone or in view of Weigle and Heywood.
4. Claims 6-11, 14, 15, and 19 are rendered obvious by Rose, alone or in view of Weigle and Schechter.

The Office has determined that each of the grounds reasonably could have been raised by the requester in the previous *inter partes* reviews. As set forth *infra*, the record as a whole demonstrates that the request relies on prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover. All of these references are widely accessible and in the same technical field.¹⁷ Weigle and Rose are patent documents that are available in a number of commercial databases, Heywood is described as a seminal textbook in the field, and Schechter is available in a publicly accessible database of technical papers in the art.¹⁸

1. Weigle and Rose

The record shows that the Weigle (a French patent) and the Rose (a PCT application) references reasonably could have been raised by requester during the '2034 and '2035 IPRs.

Both Weigle and Rose are available in commercial databases. In view of the number of commercial databases available to the public, most patents and printed publications may, in general, be expected to be discovered by a skilled searcher conducting a diligent search. Although the requester asserts that Weigle and Rose were not uncovered during a search of commercial databases,¹⁹ the patent owner's Lhymn declaration indicates that Weigle and Rose are available in commonly used and publicly available patent search sites, such as Patbase, and were publicly accessible during the relevant time period.²⁰ Although Weigle is in French, translations of foreign language patents, such as Weigle, are present in publicly available databases such as Patbase.²¹ The record does not show that Weigle or Rose are obscure documents that are unlikely to be discovered upon a reasonably diligent search of the relevant prior art at the time of filing the '2034 and '2035 IPRs.

2. Heywood

The record shows that the Heywood reference (a printed publication) reasonably could have been raised by requester during the '2034 and '2035 IPRs.

¹⁷ See request, pages 38, 133, 174, and 294.

¹⁸ See request at page 18.

¹⁹ See opposition, pages 13-16. See request, pages 14-16 and 20-22.

²⁰ See Lhymn declaration, pages 14-15 (describing the time period leading up to the filing of the August 31, 2017 IPRs).

²¹ See Lhymn declaration, pages 6-7.

It is uncontested that the Heywood reference is a seminal textbook and is a preeminent source in the field of internal combustion engines.²² The Heywood reference is “recognized in the Massachusetts Institute of Technology’s news publication as a ‘seminal book’ by ‘one of the world’s most preeminent experts on internal combustion engines’” and is “publicly available.”²³ In fact, the requester states that “those in the field use Heywood to train POSITAs and as a reference regarding the fundamentals of internal combustion engines.”²⁴ Because of Heywood’s prominence, it is expected that a skilled searcher conducting a diligent search reasonably could have been expected to discover Heywood.

Additionally, the record shows that the Heywood reference is obtainable through citation searching of the ‘821 patent and relevant prior art.²⁵ Citation searching is a standard search method²⁶ and is not, as requester asserts, unreasonable in a diligent search.²⁷ Although the requester asserts that it would be unreasonable to have to go the USPTO to access its library and review the whole file wrapper to obtain a copy of Heywood,²⁸ this assertion is not persuasive, because Heywood can be obtained from many sources, including libraries or from sources on the Internet. The record does not show that Heywood is an obscure document that is unlikely to be discovered upon a reasonably diligent search of the relevant prior art at the time of filing the ‘2034 and ‘2035 IPRs.

3. Schechter

The record shows that the Schechter reference (a non-patent literature publication) reasonably could have been raised by requester during the ‘2034 and ‘2035 IPRs.

In view of the number of commercial databases available to the public, most patents and printed publications may, in general, be expected to be discovered by a skilled searcher conducting a diligent search. Schechter was published by a well-known and established publisher who maintained a searchable database of its publications. Requester does not dispute that Schechter was publicly available in the Society of Automotive Engineer (SAE) databases (i.e., SAE International website and SAE Mobilus website) or that these databases were searchable (SAE International by a “Topic” filter and SAE Mobilus by search operators and keywords).²⁹ Requester states that SAE “was an established publisher that was well known to those interested in the fields of hydraulic and pneumatic devices.”³⁰ Moreover, other parties have searched the SAE databases to find relevant technical papers in the field in preparation for a reexamination.³¹ A skilled searcher, conducting a diligent search, would likely search this database for relevant articles, despite the subscription fee that was required at the time of filing the ‘2034 and ‘2035 IPRs,³² considering that it is a well-known resource of prior art in the relevant field. The record does not show that Schechter is an obscure text that is unlikely to be discovered upon a reasonably diligent search of the relevant prior art at the time of filing the ‘2034 and ‘2035 IPRs.

²² See petition, page 24.

²³ See petition, page 24.

²⁴ See request, page 31.

²⁵ See Lhymn declaration, page 12-13.

²⁶ See Lhymn declaration, pages 7 and 20.

²⁷ See opposition, pages 15-16.

²⁸ See opposition, pages 16-17.

²⁹ See request, pages 18-19.

³⁰ See request, page 35.

³¹ See Request for *ex parte* reexamination of U.S. Patent 7,925,4163, in reexamination 90/019010, filed May 23, 2021, pages 32-34.

³² See Lhymn declaration, page 6. Moreover, Mr. Edell did search the SAE website and SAE Mobilus website, indicating that one would search these databases. See Edell declaration, page 4.

C. The Prior Art Reasonably Could Have Been Raised

In light of the evaluation in section IV above, it is apparent that a “scorched-earth search” would not have been required to uncover the prior art applied in the grounds in the request. The weight of the relevant declarations submitted with the request and the petition also support this finding. On balance, the Office finds the facts set forth in the patent owner’s expert searcher’s declaration (*i.e.*, the Lhymn declaration) persuasive. The Lhymn declaration explained in detail how a prior art search, in preparation for a PTAB trial, would be conducted. Other than Heywood, which requester asserts was uncovered via discovery in the related litigation,³³ the requester fails to describe the actual searches that were used to uncover the remaining references relied on in the request. The requester’s attorney’s declaration (*i.e.*, the Edell declaration) is not persuasive, because it describes searches the attorney conducted about a week before the request was filed,³⁴ not the actual searches that uncovered the references relied on in the request. Additionally, the search described in the Edell declaration is not indicative of a diligent search in preparation for a PTAB trial, but rather a search on the level of a pre-examination search. Even assuming *arguendo* that the exact references were not found in the search results obtained by the search described in the Edell declaration, there was no assertion in the Edell declaration that references containing equivalent teachings were not found in the search results. Because the record sufficiently shows that all the prior art raised in the present request for reexamination of claims 6-11, 14, 15, and 19 of the ‘821 patent reasonably could have been raised by the requester in the ‘2034 and ‘2035 IPRs, the record shows that element 4 has been satisfied.

V. THE ESTOPPEL PROVISIONS OF 35 U.S.C. 315(e)(1) APPLY

The record sufficiently shows that the estoppel provisions of 35 U.S.C. 315(e)(1) apply with respect to claims 6-11, 14, 15 and 19 of the ‘821 patent, and with respect to grounds based on the Weigle, Heywood, and Rose references, alone or in combination. Furthermore, the record sufficiently shows that it is more likely than not that the estoppel provisions of § 315(e)(1) apply with respect to grounds relying on the Schechter reference. Each individual reference raised by the present request was not known to the requester at the time of filing the ‘2034 and ‘2035 IPR petitions;³⁵ however, as determined in this decision, any combination of these references reasonably could have been raised in the ‘2034 and ‘2035 IPRs.

VI. REQUESTER’S CERTIFICATION PURSUANT TO 37 CFR 1.510(b)(6) IS IMPROPER

37 CFR 1.510(b)(6) requires the requester to submit, with its request, a certification that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request. A certification under 37 CFR 1.510(b)(6) is either proper or improper. If any part of the certification is improper, then the entire certification is improper. As demonstrated above, the request puts forth grounds that the petitioner reasonably could have raised during the *inter partes* reviews. Therefore, requester’s certification pursuant to 37 CFR 1.510(b)(6), which was submitted with its request for *ex parte* reexamination in the present reexamination proceeding, is improper.

³³ See request, page 16.

³⁴ See Edell declaration, page 3, paragraph 19.

³⁵ See Edell declaration, page 3, paragraph 13. See also, request, page 11.

VII. THE REEXAMINATION PROCEEDING IS TERMINATED

As set forth above, the record shows that the estoppel provisions of 35 U.S.C. 315(e)(1) apply to claims 6-11, 14, 15 and 19 of the '821 patent under the particular facts and circumstances in this instance; therefore, the '950 reexamination proceeding is hereby **terminated**.

The order granting reexamination mailed on February 24, 2022, and other communications issued by the Office in the '950 reexamination proceeding, are hereby **vacated**.

The deposited request papers, previously issued Office communications, and any other papers deposited by the parties in the present reexamination proceeding, were scanned into the electronic Image File Wrapper (IFW) to create a record. Because the '950 reexamination proceeding is terminated, **all papers**, including the request papers, previously issued Office communications, and any other papers deposited by the parties in the present reexamination proceeding, **will be expunged** by marking the papers "closed" and "non-public," and will not constitute part of the public record.

The present decision will, however, **remain open to the public**, to provide a record of the action being taken.

CONCLUSION

1. Patent owner's March 29, 2022 petition under 37 CFR 1.181(a) requesting that the Office vacate the reexamination order of February 24, 2022 is **granted**.
2. Requester's certification pursuant to 37 CFR 1.510(b)(6) is improper. The estoppel provisions of 35 U.S.C. 315(e)(1) apply to claims 6-11, 14, 15 and 19 of the '821 patent. As a result, the present reexamination proceeding is hereby **terminated**.
3. The order granting reexamination mailed on February 24, 2022 is **vacated**.
4. All other papers of record which were issued by the Office in the '950 reexamination proceeding, as a whole, are **vacated**.
5. **All papers**, including the request papers, previously issued Office communications including the February 24, 2022 order granting reexamination, and all other papers deposited by the parties in the present reexamination proceeding, **will be expunged** by marking the papers "closed" and "non-public," and will not constitute part of the public record.
6. The present decision **will remain open to the public** to provide a record of the action being taken.
7. Inquiries concerning this decision should be directed to Andrea Grossman, Patent Examination Policy Advisor, Office of Patent Legal Administration, at (571) 270-3314.

/Pinchus M. Laufer/

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