

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AM GENERAL LLC,
Petitioner,

v.

UUSI, LLC,
Patent Owner.

Case IPR2016-01050
Patent 6,148,258

Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and
RICHARD E. RICE, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. OVERVIEW

AM General LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 9, 11, 12, 17, 18, and 29–31 of U.S. Patent No. 6,148,258 (Ex. 1001, “the ’258 patent”). Pet. 1. UUSI, LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”) to the Petition. Pursuant to our authorization (Ex. 1012), Petitioner filed a reply to Patent Owner’s Preliminary Response (Paper 10, “Reply”), and Patent Owner filed a Sur-Reply (Paper 11, “Sur-Reply”).

Upon consideration of the record to this point, for the reasons explained below, Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one of the challenged claims. We institute an *inter partes* review of claims 1, 11, 12, 17, 18, and 29–31 of the ’258 patent.

B. RELATED PROCEEDINGS

The parties indicate that the ’258 patent is at issue in the United States Court of Federal Claims (“CoFC”) under 28 U.S.C. § 1498, captioned *UUSI, LLC, et al. v. United States*, Case No. 1:12-cv-00216. Pet. 6; Paper 5, 2.¹

This Petition is part of a family of cases as indicated in the chart below.

¹ The pages of this Exhibit are not numbered; we consider the cover page to be page 1.

<i>inter partes</i> review No.	U.S. Patent No.	Application No.	Note
2016-01050	6,148,258 ("the '258 patent")	09/076,291	CIP of '369 patent
2016-01048	6,009,369 ("the '369 patent")	08/931,470	Continuation-in-part (CIP) of '456 patent
2016-01049	5,570,666 ("the '666 patent")	08/042,239	CIP of 08/042,239, now abandoned
2016-01051	5,729,456 ("the '456 patent")	08/508,063	CIP of '666 patent

See Prelim. Resp. 18–19; Pet. 11–12.

As shown above, the '258 patent is a continuation-in-part of the application that matured into the '369 patent, which is a continuation-in-part of the application that matured into the '456 patent, which is a continuation-in-part of the application that matured into the '666 patent, which is a continuation-in-part of application 08/042,239, now abandoned.

The '258 patent was filed on May 12, 1998. Ex. 1001, [22].

II. PRELIMINARY MATTERS

A. STATUTORY BAR UNDER 35 U.S.C. § 315(b)

Patent Owner argues that the Petition is barred under § 315(b) because it was filed more than 1 year after: (1) the United States Government (which Patent Owner contends is a privy of Petitioner) was served with a complaint in the U.S. Court of Federal Claims ("CoFC") alleging infringement of the

Case IPR2016-01050
Patent 6,148,258

'666 patent under 28 U.S.C. § 1498²; (2) Petitioner, as an interested party to the CoFC proceeding, was served with a Rule 14 Notice/Summons, together with a copy of the complaint; (3) the Government and Petitioner both were served with an amended complaint in the CoFC proceeding. Prelim. Resp. 1–18. For the sake of consistency, we rely upon our analysis of this issue in the institution decision of IPR2016-01049 and incorporate that analysis herein. There we determined that Petitioner does *not* lack standing under § 315(b). For the same reasons, we determine that Petitioner here also does not lack standing under § 315(b).

B. 35 U.S.C. § 325(d)

Patent Owner contends that the Board has denied institution, where, as here, the prior art was presented during prosecution. Prelim. Resp. 48 (citing *Ceramtec GmbH v. Ceramedic, LLC*, Case IPR2015-00424 (PTAB July 7, 2015) (Paper 9) and *Microboards Tech., LLC v. Stratasy, Inc.*, Case IPR2015-00287 (PTAB May 28, 2015) (Paper 13)).

Patent Owner's argument is unpersuasive. Patent Owner does not identify the statutory basis of the rejection (*i.e.*, § 102 or § 103) and does not identify or provide any portion of the relevant prosecution history. Further, the cases cited by Patent Owner are distinguishable. In each of the non-

² See *Zoltek Corp. v. United States*, 672 F.3d 1309, 1327–28 (Fed. Cir. 2012) (en banc) (holding that “28 U.S.C. § 1498(a) creates an independent cause of action for direct infringement by the Government or its contractors that is not dependent on 35 U.S.C. § 271(a)” and “[w]hen the United States is subject to suit under § 1498(a) for alleged infringement of a patent by a contractor acting by and for the United States, the contractor by law is rendered immune from individual liability for the alleged infringement”).

precedential cases cited by Patent Owner, the Board denied a ground of unpatentability, in part, because the Examiner had previously considered the same or substantially the same argument with regard to a rejection during prosecution based on the same prior art. *Ceramtec GmbH*, Paper 9, 12; *Microboards*, Paper 13, 7–12. Here, in contrast, the '258 patent was not subject to a rejection based on Auth. *See* Pet. 11–12, 16–17 (citing the applicable portions of the prosecution history (Ex. 1002) and contending that the '258 patent issued following a rejection under 35 U.S.C. § 112(2) and two amendments). Patent Owner has not shown that the same or substantially the same prior art or argument was previously considered, and accordingly we decline to exercise our discretion to deny any ground of unpatentability under 35 U.S.C. § 325(d).

III. THE CLAIMED SUBJECT MATTER

A. THE '258 PATENT

The '258 patent relates to improvements in control, performance, diagnostics, monitoring, adaptability, and compensation pertaining to glowplugs, starter motor actuation, and battery power application for diesel engine applications.³ Ex. 1001, 1:18–23. The invention is used in a self-propelled vehicle or other piece of equipment powered by an internal combustion engine. *Id.* at 1:26–29.

As background, the Specification describes that diesel engines have no spark plug or spark ignition. *Id.* at 1:44–45. Rather, ignition for diesel engines relies on adding various amounts of supplemental heat to the

³ The '258 patent presents this term both as a single word (“glowplug”) and as two words (“glow plug”). *See, e.g.*, Ex. 1001, 1:42, 6:17.

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