

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MINIATURE PRECISION COMPONENTS, INC.,

Petitioner,

v.

EAGLE INDUSTRIES, INC.,

Patent Owner.

IPR 2017-01403
Patent 8,205,592 B2

Record of Oral Hearing
Held: September 7, 2018

Before MICHAEL W. KIM, JAMES A. WORTH, and RICHARD H.
MARSCHALL, *Administrative Patent Judges.*

IPR 2017-01403
Patent 8,205,592 B2

APPEARANCES:

ON BEHALF OF THE PETITIONER:

JOHN S. ARTZ, ESQUIRE
BRYAN J. SCHOMER, ESQUIRE
Dickinson Wright
International Square
1825 Eye Street, N.W.
Suite 900
Washington, D.C. 20006

BEHALF OF THE PATENT OWNER:

JAKOB KOERING, ESQUIRE
Miller Canfield Paddock Stone
225 W. Washington Street
Suite 2600
Chicago, IL 60606

The above-entitled matter came on for hearing on Friday, September 7, 2018, commencing at 10 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Julie Souza, Notary Public.

P R O C E E D I N G S

1 - - - - -

2 JUDGE MARSCHALL: Good morning. We're here to discuss the
3 matter in IPR 2017-01403 between Petitioner Miniature Precision
4 Components, Inc., and Patent Owner Eagle Industries, Inc., and this is
5 reviewing patent No. 8,205,592. I'm Judge Marschall. With me is Judge
6 Kim and Judge Worth. Let's start with appearances beginning with the
7 Petitioner.

8 MR. ARTZ: Yes. Good morning, Your Honor. John Artz on behalf
9 of Petitioner.

10 MR. SCHOMER: Good morning. Bryan Schomer on behalf of
11 Petitioner.

12 JUDGE MARSCHALL: Patent Owner.

13 MR. KOERING: Good morning, Your Honor. Jakob Koering on
14 behalf of the Patent Owner.

15 JUDGE MARSCHALL: Well thank you and welcome. Each party
16 will have 30 minutes of total argument time. Petitioner can reserve time for
17 rebuttal and Petitioner you can begin when ready and please let me know if
18 you want to reserve some time for rebuttal.

19 MR. ARTZ: Yes. We would like to reserve five minutes for rebuttal.
20 As a preliminary question before we begin, we have an issue that had been
21 raised with respect to demonstrative exhibits and new samples that had been
22 brought today. Is that something you'd like to address now or would you
23 like me to address it during the argument, or I guess what's your preference
24 of how we should deal with that issue.

1 JUDGE MARSCHALL: I would address it during the argument or
2 your rebuttal. I don't want you getting up and objecting in the middle of
3 Patent Owner's presentation so handle it how you wish.

4 MR. ARTZ: Okay. Thank you. So, good morning. There's four
5 issues that we're going to be addressing today. First, we're going to address
6 the actual invention of the '592 patent as informed by the intrinsic evidence
7 the patent and file history. What you're going to later hear from Patent
8 Owner is an attempt to rewrite the alleged invention of the 592 patent
9 because of the prior art that's been found, but if you listen carefully to their
10 story you're not going to hear any citations to intrinsic evidence. What
11 you're going to hear is solely attorney argument and expert testimony,
12 extrinsic evidence, that's it.

13 Second, we're going to discuss what are the grounds that have been
14 instituted. They've waived many issues. What's left for this Board to
15 decide?

16 Third, we're going to address those grounds and the two claim
17 construction issues that exist and why the remaining claims are unpatentable,
18 and then fourth we're going to address their new arguments and new
19 evidence that shouldn't be considered, and a request to exclude same.

20 So let's talk briefly. What is the invention of the 592 patent? Let's
21 start with the title. The title itself says it's a noise abatement cover. What is
22 that? That's an engine cover that goes within an engine compartment of a
23 vehicle to help reduce noise of the engine.

24 So what does the abstract say about it? The abstract says it's an
25 engine cover that provides noise abatement, just like the title says, but also

1 has a high quality outer surface which is important in the automotive
2 industry. They deal with class A surfaces, exterior surfaces. There's
3 requirements that OEMs have for surfaces that are going to be exposed.

4 The background of the 592 patent is also instructive as to what the
5 invention of the 592 patent is. It goes through and identifies the prior covers
6 that existed that were in the art at that time and what the problems were that
7 were with them. Prior engine covers consisted primarily of multiple
8 components. One component addressed the sound absorption aspect or
9 benefit that was trying to be achieved and the second addressed the exterior
10 or aesthetics. One was typically comprised of foam, the sound absorption
11 and the aesthetics was addressed by a separate plastic piece that had to be
12 assembled together, two separate pieces to form a single engine cover.

13 Another example that's provided in the background is a one piece
14 engine cover, Carcoustics Mini Cooper engine cover. It does have a one
15 piece engine cover with a texture on it, as their expert testified, but it was
16 made of a high density polyurethane foam so it didn't provide the required
17 sound absorption, so it had inferior sound absorption. The 592 spec thus
18 describes that the invention is an integral one piece engine cover that
19 provides both noise abatement and proper aesthetics in a single part. The
20 spec goes on to differentiate its unitary construction compared to the
21 multiple components that were required with prior engine covers to yield
22 both noise abatement and aesthetics.

23 The Applicant during prosecution history similarly emphasized the
24 desire to provide in a single engine cover both a medium density
25 polyurethane core which provided the sound absorption and a textured outer

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.