

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC COMPANY,
Petitioner,

v.

UNITED TECHNOLOGIES CORPORATION,
Patent Owner.

Case IPR2018-01442
Patent 9,695,751 B2

Before HYUN J. JUNG, SCOTT A. DANIELS, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(b)

In an Order dated September 23, 2019, we authorized Patent Owner to file a motion to submit supplemental evidence and Petitioner to file an opposition. Paper 30.

Patent Owner timely filed their Motion (Paper 31, “Mot.”), and Petitioner timely filed their Opposition. (Paper 32, “Opp.”).

Patent Owner’s Argument

Patent Owner desires to enter in this proceeding, along with its forthcoming Sur-Reply to Petitioner’s Reply (Paper 28), four patents, apparently assigned to Petitioner, GE, which Patent Owner wishes to offer in response to Petitioner’s arguments that one of ordinary skill in the art understands the meaning of the term “stage,” as including *both* a row of stationary vanes as well as a row of rotating blades, to be indisputable. Mot. 1. Patent Owner argues that these patents are relevant evidence that “stage,” as recited in the claims of the ’751 patent, does not necessarily mean both a row of rotating blades *and* a row of non-rotating vanes to a person of ordinary skill in the art. *Id.* at 1–2. It is Patent Owner’s specific contention that the four patents “contradict GE’s contention that its definition of the term ‘stage’ is indisputable, thus showing that a POSITA would not necessarily have understood Knip to ‘specifically disclose[] that its HPT consists of two complete stages.’” *Id.* at 5.

Patent Owner argues that the four patents it “now seeks to submit could not reasonably have been obtained earlier,” because the Petition did not specifically show where or how Knip’s volumetric diagrams or disclosure revealed the claimed aspect of “an inlet of *a first turbine vane*,” as recited in claim 1. *Id.* at 2. Also, Patent Owner argues that these four patents are timely submitted as rebuttal to Petitioner’s interpretation that a

turbine “stage” includes both a row of stationary vanes and a row of rotating fan blades, which Patent Owner contends was raised for the first time in Petitioner’s Reply. *Id.* at 3. Patent Owner argues that this information is submitted to rebut Petitioner’s argument in its Reply and thus is in the interests of justice and further that these patents are not prejudicial to Petitioner as they are part of a standard sur-reply and offered simply in response to the Reply. *Id.*

Petitioner’s Argument

Petitioner opposes submission of the four additional patents because its “position in the Reply concerning the term ‘stage’ was not new,” and that Patent Owner “was on notice since the Petition of GE’s position on the common and ordinary meaning of ‘stage,’ and how that meaning relates to a POSITA’s interpretation of Knip’s disclosure.” Opp. 1. Petitioner also points out that in his deposition prior to submission of Patent Owner’s Response, Petitioner’s declarant Dr. Attia, explained that a person of ordinary skill in the art “would understand that the inlet of the HPT would coincide with the leading edge of the first stator in the first stage of the . . . HPT.” *Id.* at 2 (citing Ex. 2016, 184–185). Further, Petitioner argues that this supplemental information is untimely because Patent Owner should have known to submit these additional references along with previously submitted references in its Patent Owner Response rebutting Petitioner’s, and Dr. Attia’s, position that a “stage” is understood by those of ordinary skill in the art to typically include a row of vanes and a row of rotating blades. *Id.* (citing Ex. 2021, Abst.).

Analysis

To submit evidence more than one month after the institution of an *inter partes* review, 37 C.F.R. § 42.123(b) requires the motion show why the information reasonably could not have been obtained earlier and that consideration of the supplemental information would be in the interests of justice. As the moving party, Patent Owner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

On this record and in the particular circumstances of this proceeding, we determine that Patent Owner has met its burden to show why the supplemental information reasonably could not have been obtained earlier and that consideration of the supplemental information would be in the interests of justice. *See* 37 C.F.R. § 42.123(b).

We appreciate Petitioner’s argument that Dr. Attia has been consistent in stating that a person of ordinary skill in the art would understand a “stage” to include both a row of stationary vanes (or stators), and a row of rotating airfoils.¹ *Compare, e.g.,* Ex. 1003 ¶¶ 69, *with* Ex. 2016, 184–185. Patent Owner has, however, made a persuasive argument that the Petition itself did not expressly articulate that such an understanding would have led a person of ordinary skill in the art to understand that Knip’s volumetric diagram would have included a typical “stage” with both a row of stationary vanes defining an inlet, followed by a row of rotating airfoils, and therefore disclosed to a person of ordinary skill in the art, “an inlet of a *first turbine vane*,” as recited in claim 1. *See* Mot. 1–2 (Patent Owner argues that “the Petition’s mapping of Knip to limitation [1.5] does not once mention the

¹ Dr. Attia explains that the terms “vanes” and “stators” are understood by those of ordinary skill in the art to be synonymous. Ex. 2016, 185:8–20.

word ‘vane,’ much less that Knip’s use of the term ‘stage’ **indisputably** means that Knip’s HPT includes an ‘inlet of a first turbine vane.’”). The Board has consistently maintained that it is Petitioner’s responsibility to explain *in the Petition* the specific evidence that supports its arguments. *See* 37 C.F.R. § 42.22(a)(2).

Patent Owner should have been aware, and probably was to some extent aware, by at least the completion of Dr. Attia’s deposition testimony, that Petitioner’s position was that one of ordinary skill in the art would have understood the beginning, or inlet, of the diagrammatic HPT turbine depiction to include and be defined by a row of stator blades. However, we are persuaded that this issue was developing. *See* Ex. 2016, 184–185. We find Petitioner’s complete argument as to what a person of ordinary skill in the art would have understood from Knip, was not yet entirely manifest prior to Petitioner’s Reply.

It is true that Patent Owner, in developing its own argument that Knip does not disclose a HPT with “an inlet of a first turbine vane,” as recited in claim 1, presupposes Petitioner’s not-yet-manifest argument. *See* PO Resp. 20–22 (Patent Owner argues that “[t]he Petition merely parrots the claim language . . . [i]t neither identifies a ‘first turbine vane’ in Knip nor alleges inherency.”). Patent Owner argues in its Response that “not all high pressure turbine designs necessarily include an inlet vane.” PO Resp. 22 (citing Ex. 2015 ¶¶ 70; Ex. 2017, Abst., ¶¶ 2; Ex. 2018 ¶¶ 1–2, 49–50; Ex. 2019 ¶¶ 19–20, 32, 45; Ex. 2021, Abst., 1:38–47, 4:38–63). For example, Patent Owner points to U.S. Patent Appl’n. No. 12/190,174 disclosing a turbine design that “eliminates the need for row one turbine vanes and thus eliminates the leading and trailing edges, and the associated

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