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Paper 19
Date: February 3, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

MICHIGAN MOTOR TECHNOLOGIES LLC,
Patent Owner.

IPR2020-00455
Patent 7,116,081 B2

Before NEIL T. POWELL, BARBARA A. PARVIS, and SCOTT B. HOWARD, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On July 30, 2020, we instituted trial as to claims 1–20 ("the challenged claims") of U.S. Patent No. 7,116,081 B2 (Ex. 1001, "the '081 patent"). Paper 10 ("Decision on Institution" or "Inst. Dec."). After institution, Patent Owner, Michigan Motor Technologies LLC, filed a Motion to Amend. Paper 16 ("Motion" or "Mot."). In the Motion, Patent Owner proposes substitute claims 21, 22, and 23 for challenged claims 1, 10, and 17 of the '081 patent. Mot. 1–2; *see also id.* at 1 (stating that the Motion is "contingent on the outcome of this trial"). Petitioner, Volkswagen Group of America, Inc., filed an Opposition to the Motion. Paper 18 ("Opposition" or "Opp.").

In the Motion, Patent Owner requests that we provide Preliminary Guidance concerning the Motion in accordance with the Board's pilot program regarding motion to amend practice and procedures. Mot. 1; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) ("Notice"). We have considered Patent Owner's Motion and Petitioner's Opposition.

In this Preliminary Guidance, we provide information indicating our preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in a post-grant review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claim is unpatentable. *See* 35 U.S.C. § 316(d); 37 C.F.R.

§ 42.121; *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential); *see also* Notice, 84 Fed. Reg. at 9,497 ("The preliminary guidance . . . provides preliminary, non binding guidance from the Board to the parties about the [motion to amend].").

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We have considered, however, our Decision on Institution in determining whether the amendments "respond to a ground of unpatentability involved in the trial." *Lectrosonics*, Paper 15 at 5. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See* Notice, 84 Fed. Reg. at 9,500.

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
Yes. Patent Owner proposes no more than one substitute claim for each of challenged claims 1, 10, and 17 of the '081 patent. Mot. 1–2. Petitioner does not argue otherwise. *See generally* Opp.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))
Yes. Patent Owner responds to the grounds of unpatentability at pages 22–23 of the Motion, asserting that proposed substitute claims 21, 22, and 23 add features to distinguish the claims over the prior art asserted in the instituted grounds. Petitioner does not argue otherwise. *See generally* Opp.

3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))
No. Proposed substitute claims 21, 22, and 23 include all of the language of corresponding original claims 1, 10, and 17, as well as additional narrowing limitations. *See* Mot. 24–25 (Claims App.). Petitioner does not argue otherwise. *See generally* Opp.

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))
No. On this record, it appears that Patent Owner has identified adequate written description support for proposed substitute claims 21, 22, and 23 in the original disclosure of U.S. Application No. 10/427,828, filed May 1, 2003 ("the '828 application"). *See* Mot. 3–21.

Proposed substitute claim 21 recites, in relevant part, "wherein said at least one rotor speed limit includes at least a first rotor speed limit that is set to limit generation of excess heat by the alternator before the alternator temperature exceeds the temperature limit." *Id.* at 24 (Claims App.). Proposed substitute claims 22 and 23 recite similar limitations. *Id.* at 25. Patent Owner asserts that there is written description support for these limitations in paragraphs 8, 9, 14–16, and 20–33 of the '828 application. *Id.* at 11–13, 17, 21 (citing Ex. 1002, 8–16 (¶¶ 8, 9, 14–16, 20–33)). Petitioner does not argue otherwise. *See generally* Opp.

The Specification of the '828 application describes, in relevant part, that "a first rotor speed limit may be set to limit generation of excess heat production by the alternator before the alternator temperature exceeds the maximum temperature limit 116." Ex. 1002, 15 (¶ 29). Accordingly, at this stage in the proceeding, based on the current record, it appears that Patent Owner has identified adequate written description support for the new limitation in proposed substitute claims 21, 22, and 23 such that the amendment does not add new subject matter.

B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record,[1] it appears that Petitioner (or the record) has shown a reasonable likelihood that proposed substitute claims 21, 22, and 23 are unpatentable.

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?
Yes. For purposes of this Preliminary Guidance and based on the current record, Petitioner (or the record) appears to have shown a reasonable likelihood that (1) proposed substitute claims 21 and 22 would have been obvious over Yamashita (Ex. 1005), and (2) proposed

[1] We express no view on the patentability of original claims 1–20 in this Preliminary Guidance. Instead, we focus on limitations of proposed substitute claims 21, 22, and 23 in Patent Owner's Motion to Amend.

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