

ITC Case Won't Stop PTAB From Reviewing Caterpillar Patent

By **Tiffany Hu**

Law360 (January 10, 2019, 4:14 PM EST) -- The Patent Trial and Appeal Board has agreed to review a Caterpillar Inc. patent covering a milling machine despite the equipment maker's contentions the review would be a waste of resources in light of a case at the U.S. International Trade Commission, with members noting that unlike the board, the commission cannot invalidate patents.

While the ITC's parallel investigation into whether road construction equipment imported by German machinery manufacturer Wirtgen infringed on Caterpillar's patents may "inform" the PTAB's decision, this does not mean the board's review would be duplicative or a waste of resources, it said in separate opinions Tuesday.

Despite Caterpillar's contentions that Wirtgen had made almost the exact same invalidity arguments in a parallel case at the ITC that is on track to wrap up before inter partes review will finish, the PTAB was unmoved, pointing out the differences between both forums.

"The ITC does not have the authority to invalidate a patent and ITC decisions do not necessarily pertain to the issues raised in an inter partes review petition because of the difference in evidentiary standards and burdens," the board wrote.

Wirtgen and its U.S. subsidiary had petitioned in June for inter partes review of the Caterpillar patent for milling equipment, which is used to treat road surfaces, saying that the patented invention would have been obvious at the time over several different combinations of prior art.

In one petition, Wirtgen alleged that a person with ordinary skill in the art would have been motivated to use a previous patent known as Gutman, in view of a European patent office publication known as Bitelli, to modify a work machine to be able to move in and out of the cut that the machine created. This combination, along with other proposed combinations that included additional prior art, would render the challenged claims obvious, Wirtgen said.

In the second petition, the German manufacturer said that an ordinarily skilled person would have been motivated to combine the actuators disclosed in a previous patent known as Ulrich with the machine taught in a manual known as Volpe, along with the aforementioned Bitelli and other prior art, to arrive at the challenged claims of Caterpillar's patent.

The PTAB found that Wirtgen had convincingly shown that the claims of the patent at issue would likely

be found invalid as obvious over the various combinations proposed in the petitions, disagreeing with Caterpillar that the German manufacturer's petitions failed to adequately address the differences between the patented invention and prior art and to show "an adequate motivation to combine the features of the prior art to yield the claimed invention."

An attorney for Wirtgen declined to comment. Counsel for Caterpillar did not immediately respond to a request for comment Thursday.

The patent at issue is U.S. Patent Number 7,140,693 B2.

Caterpillar is represented by Joshua L. Goldberg, Christine E. Lehman and Luke J. McCammon of Finnegan Henderson Farabow Garrett & Dunner LLP.

Wirtgen is represented by Ralph W. Powers III, Donald R. Banowitz, Daniel E. Yonan, Graham C. Phero and Stephen A. Merrill of Sterne Kessler Goldstein & Fox PLLC, and Ryan D. Levy, John F. Triggs, William E. Sekyi and Seth R. Ogden of Patterson Intellectual Property Law PC.

The cases are Wirtgen America Inc. et al. v. Caterpillar Paving Products Inc., case numbers IPR2018-01201 and IPR2018-01202, before the Patent Trial and Appeal Board.

--Additional reporting by Steven Trader. Editing by Jack Karp.