

PTAB Axes Caterpillar Road Milling Patent Tied To ITC Probe

By **Dani Kass**

Law360 (December 16, 2019, 5:42 PM EST) -- The Patent Trial and Appeal Board has invalidated several claims of a Caterpillar Inc. milling machine patent following a challenge by a German company that was barred from importing infringing products into the U.S.

The board said Friday that 17 claims from Caterpillar Paving Products Inc.'s patent are obvious over several combinations of prior art raised by a U.S. subsidiary of Germany's Wirtgen, which makes road construction equipment. The patent covers milling equipment used to treat road surfaces.

The ruling comes only a few months after the U.S. International Trade Commission blocked Wirtgen from importing certain road construction machines that infringe one of the now-invalidated patent claims. The ITC issued a limited exclusion order and cease and desist order in June.

The PTAB had previously addressed the intersection of the two cases, saying in January that the pending ITC investigation wasn't enough to foreclose inter partes review. In particular, the board noted that it has the ability to invalidate patents, which the commission cannot do.

The board is reviewing a second Wirtgen challenge to the same Caterpillar patent, but it has yet to publish a decision.

An attorney for Wirtgen declined to comment Monday. Counsel for Caterpillar didn't immediately respond to a request for comment.

Administrative Patent Judges Lynne H. Browne, James J. Mayberry and Richard H. Marschall sat on the panel for the Patent Trial and Appeal Board.

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

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

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

The case is Wirtgen America Inc. et al. v. Caterpillar Paving Products Inc., case number IPR2018-0120, before the Patent Trial and Appeal Board.

--Additional reporting by Tiffany Hu. Editing by Peter Rozovsky.

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