

PTAB Revives Part Of Wirtgen Patent In Rare Rehearing

By **Tiffany Hu**

Law360 (July 12, 2019, 7:22 PM EDT) -- In a rare move, the Patent Trial and Appeal Board has granted Wirtgen America Inc.'s request for a rehearing after the board invalidated the machine manufacturer's patent on a road milling machine, reviving some of the claims the second time around.

In May, PTAB ruled that Wirtgen's U.S. Patent No. 7,828,309 were invalid as obvious over earlier U.S. and German patents. The '309 patent had been challenged in inter partes review by Illinois-based Caterpillar Inc. in October 2017 after Wirtgen accused it of selling road milling machines for concrete and asphalt pavement that infringed its patents.

Wirtgen said some of the claims the board had invalidated depended on those claims the board upheld, so those claims should also be patentable.

PTAB agreed on Thursday, issuing a revised decision that properly groups the disputed claims in the '309 patent, although the board was careful to note that Wirtgen was not contesting the patentability of those claims or any substantive error in its earlier decision.

"This is an editorial error of claim grouping, not a substantive analysis error," the board said.

Counsel for both parties did not immediately respond to requests for comment Friday.

The rival companies' patent fight began in 2017, when Wirtgen filed complaints against Caterpillar in Minnesota and Delaware federal courts and the U.S. International Trade Commission alleging infringement of several patents, including the '309 patent.

In April, the ITC found that Caterpillar was only able to show that one claim in the '309 patent was invalid as obvious over prior art combination, and failed to show "through clear and convincing evidence" that the other two claims in the patent were invalid.

Both the Minnesota and Delaware cases have been stayed pending the final results of the ITC investigation, according to court documents.

PTAB in May invalidated several claims in the '309 patent, rejecting Wirtgen's contention that the proposed combination of the two earlier patents — one covering a system of connected hydraulic cylinders, the other a road milling machine — were "fundamentally incompatible" such that an

ordinarily skilled person would not combine them to arrive at the challenged claims.

"Patent owner has not directed us to persuasive evidence that [the prior art is] 'incompatible,'" the May decision says. "Moreover, the obviousness inquiry does not ask 'whether the references could be physically combined but whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole.' [...] Neither our rules nor the applicable law require an instruction manual on how to physically incorporate or combine the disclosures of two references."

Thursday's decision revives six of the previously invalidated claims in the '309 patent.

The patent-in-suit is U.S. Patent No. 7,828,309.

Caterpillar is represented by Joshua L. Goldberg, James R. Barney, David K. Mroz and Jason Romrell of Finnegan Henderson Farabow Garrett & Dunner LLP.

Wirtgen is represented by Ralph W. Powers III, Jon E. Wright, Kyle E. Conklin, Stephen Merrill and Daniel E. Yonan of Sterne Kessler Goldstein & Fox PLLC, and Ryan D. Levy, John F. Triggs and Seth R. Ogden of Patterson Intellectual Property Law PC.

The case is Caterpillar Inc. v. Wirtgen America Inc., case number IPR2017-02185, before the Patent Trial and Appeal Board.

--Editing by Stephen Berg.