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Paper No. 18
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRW AUTOMOTIVE US LLC,
Petitioner,

v.

MAGNA ELECTRONICS INC.,
Patent Owner.

Case IPR2014-00257
Patent 8,203,440 B2

Before JUSTIN T. ARBES, BART A. GERSTENBLITH, and FRANCES L. IPPOLITO, *Administrative Patent Judges.*

GERSTENBLITH, *Administrative Patent Judge.*

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

TRW Automotive US LLC filed a Request for Rehearing (Paper 17, "Req. Reh'g") of the Decision Denying Institution ("Paper 16, Decision"), dated June 26, 2014. The Decision denied institution of *inter partes* review

of all claims challenged in the Petition (Paper 1, "Pet."), namely claims 1, 2, 5–14, 16–21, 24, 26, 27, and 29–31 of U.S. Patent No. 8,203,440 B2 ("the '440 patent"). Decision 12. Petitioner requests reconsideration of the denial of institution and contends we abused our discretion in denying institution of *inter parties* review of claims 1, 2, 5–14, 16–21, 24, 26, 27, and 29–31. For the reasons stated below, Petitioner's request is denied.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), "[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion." An abuse of discretion occurs when a "decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment." *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. DISCUSSION

Petitioner contends that the Decision is improperly premised upon the assumption that Yanagawa is a necessary reference and incorrectly concludes that Petitioner failed to articulate a reason as to why one of ordinary skill in the art would have combined Yanagawa with the other references relied upon. Req. Reh'g 2.

A. Petitioner's Reliance Upon Yanagawa

1. Ground 1: Combination of Bottesch, Borcherts, Yanagawa, and Vellacott

Petitioner first asserts that it relied upon Yanagawa "[f]or the most part, . . . to illustrate the general state of the art" and that it was not

"essential." Req. Reh'g 2–3. Petitioner contends that the non-essential nature of Yanagawa was reflected in Petitioner's "treatment of claim 1" where Petitioner argued that "[a]ll elements of claim 1 are disclosed by Bottesch **alone** or in combination with other applied references . . . ." *Id.* at 3 (quoting Pet. 14) (emphasis added by Petitioner).

We disagree that the Petition clearly presented Yanagawa as an alternative, non-essential reference. First, the Petition recites "Ground 1" in at least three different ways. Pet. 3 (listing the first "Bas[is] For Rejection" as "obvious over a combination of Bottesch (1004) in view of Borcherts (1005), Yanagawa (1006), and Vellacott (1007)"); *id.* at 11 ("Claim[s] . . . are each . . . obvious over Bottesch . . . in view of Borcherts, . . . Yanagawa . . ., and Vellacott."); *id.* at 14 ("Bottesch alone or in combination with the other applied references . . . ."). In the first two recitations of "Ground 1," including most notably the identification of the ground itself (Pet. 3), there is no indication that Yanagawa is relied upon as an alternative reference. Second, the Petition fails to state that Yanagawa was cited to "illustrate the general state of the art" as Petitioner now contends. Rather, the Petition cites to Yanagawa as allegedly disclosing several elements of claim 1. *E.g.*, Pet. 16, 18, 19, 20, 22, 23.[1] Third, none of these instances clearly indicates that Yanagawa is a non-essential reference.

It is incumbent upon Petitioner to identify, in the Petition, the specific reference or combination of references it relies upon for its challenge, and to

[1] Although we specifically refer to the citations of Yanagawa as applied to claim 1, the Petition's discussion of independent claims 12, 20, and 26 relies upon the analysis presented for claim 1 and, thus, similarly relies upon Yanagawa without clearly indicating that it was an alternative, non-essential reference. *See* Pet. 30–34 (addressing claim 12); *id.* at 37–42 (addressing claim 20); *id.* at 42–46 (addressing claim 26).

explain what specific teachings of what references are relied upon and how they are combined. *See* 37 C.F.R. §§ 42.104(b)(2), 42.104(b)(4). If Petitioner sought to raise a ground based solely upon Bottesch, Petitioner must do so clearly and identify it as such. Petitioner's identification of "Ground 1" did not do so; rather, it identified a combination of four references, one of which was Yanagawa.

2. Ground 2: Combination of Bottesch, Borcherts, Yanagawa, Vellacott, and Venturello

Petitioner asserts that the Petition did not mention Yanagawa with respect to claims 16 and 29, and, thus, the "Decision's rationale . . . does not apply to these claims." Req. Reh'g 5. Claims 16 and 29 depend from claims 12 and 26, respectively, and thus the reasons discussed with respect to claims 12 and 26 also apply to claims 16 and 29.

B. Rationale to Combine Yanagawa

Petitioner reiterates several quotations from the references cited and asserts that "[t]he references themselves teach to look to other vehicular vision art for interchangeable components, including features disclosed in Yanagawa. The cited prior art sufficiently suggest a motive to combine features of the references." Req. Reh'g 8. Petitioner, however, did not argue in the Petition that any particular reference provided a specific reason as to why one of ordinary skill in the art would combine any of the specific teachings of Yanagawa with one or more of the teachings of the other references. That each reference may be in the field of "vehicular vision" is insufficient, in and of itself, to provide a reason with rationale underpinning as to why one of ordinary skill in the art would have sought to combine specific teachings of such references. *See* Decision 10–12.

C. Dr. Miller's Declaration

Petitioner contends that Dr. Miller's Declaration (Ex. 1010) "specifically addressed his rationale for combining references" and that his "unrebutted testimony" is "sufficient to make [Petitioner's] *prima facie* case of obviousness." Req. Reh'g 8–11.

We disagree. First, we did not overlook the testimony of Dr. Miller cited by Petitioner in the Petition; rather, we addressed Dr. Miller's statements in our Decision and found them insufficient. Decision 10–11. Thus, Petitioner's contention is merely a disagreement with our decision, which is not a sufficient basis on which to request rehearing.

Second, each quotation from Dr. Miller's Declaration appears in a claim chart in the same row as the last element of each claim. For example, Dr. Miller's chart discussing claim 1 addresses the final element of claim 1 by referring to citations from three different references—Bottesch, Borcherts, and Yanagawa—and then states "[a]ny of the above listed references would be combinable to utilize and substitute the known and disclosed elements in the additional references." Ex. 1010 ¶ 18. Thus, Dr. Miller's statement appears to apply to this final element of claim 1 and there is no indication that it was intended to apply to any other element of claim 1.

Third, even if Dr. Miller's statement were intended to apply to each element of claim 1 and the numerous citations from the four references relied upon for each element of the claim, such a catch-all, conclusory statement that any of the above listed references would be combinable with the other references is insufficient to clearly articulate a reason with a rationale underpinning as to *why* one of ordinary skill in the art would have

combined any *particular* teaching of any one of the references with another reference. In other words, it lacks specificity.[2]

IV. ORDER

Accordingly, it is hereby ORDERED that Petitioner's request for rehearing is *denied*.

[2] Dr. Miller's statements with respect to independent claims 12, 20, and 26 are even less specific. *See* Ex. 1010 ¶ 32 ("It would be obvious to utilize known elements within the art in the same manner and for the same purpose."); *id.* at ¶ 42 ("Claim 20 is merely utilizing known elements in the same manner as they are taught in the prior art."); *id.* at ¶ 46 ("Claim 26 is merely utilizing known elements in the same manner and for the same purpose as taught in the art.").

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