

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JOHNSON CONTROLS, INC.,

Petitioner,

v.

WILDCAT LICENSING WI, LLC,

Patent Owner.

Case IPR2014-00305

Patent 7,062,831 B2

Before JAMES B. ARPIN, CARL M. DEFRANCO, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing

37 C.F.R. § 42.71

I. INTRODUCTION

Patent Owner, Wildcat Licensing WI, LLC, requests reconsideration of our Decision (Paper 9, “Dec.”) instituting *inter partes* review of claims 22–28 (“the challenged claims”) of Patent No. US 7,062,831 B2 (Ex. 1001; “the ’831 patent”). Paper 13 (“Req. Reh’g”). For the reasons discussed below, we deny the request for rehearing.

II. DISCUSSION

When rehearing a decision on petition, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). 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). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” 37 C.F.R. § 42.71(d).

The contention at the heart of Patent Owner’s request for rehearing is that we overlooked controlling case law and arguments made by Patent Owner by adopting a claim construction that encompasses a “fasten it wrong and fix it later” system, which Patent Owner asserts “was affirmatively given up during prosecution.” Req. Reh’g 1. Specifically, Patent Owner asserts that our application of the transitional phrase, “comprising,” in the challenged claims overlooks, and is inconsistent with, the intrinsic evidence; that we overlooked Patent Owner’s arguments concerning how Gass fails to teach the “predetermined sequence” and the “sequence output” features of the challenged claims; and that we overlooked Patent Owner’s arguments

concerning the “monitoring torque” feature of the challenged claims. *Id.* at 1-2 (citing *In re Suitco Surface, Inc.* 603 F.3d 1255, 1260 (Fed. Cir. 2010)).

We did not overlook Patent Owner’s arguments; we considered them, but were not persuaded by them. For instance, Patent Owner argues that

the only reason the challenged claims were allowed to issue was because they were expressly limited only to read on, for example, a “fasten it right the first time” system such as the Figure 4 embodiment when taken in combination with the disclosure provided by the originally filed claims and the predetermined sequence program embodiment mentioned at col. 7, lines 50-57.

Id. at 4 (citation omitted). In our decision to institute *inter partes* review, we addressed these arguments, but found them unpersuasive. *See* Dec. 7–16 (addressing claim construction). We stated that, as Patent Owner admitted, Figure 4 of the ’831 patent and its description “is an express teaching that it is possible to incorrectly rundown fasteners in the fastening locations 52a-52c.” *Id.* at 13. We also stated that the originally-filed claims and the ordinary meaning of the claim term “providing” “does not limit or negate the express teaching of a ‘fasten it wrong and fix it later’ system, as set forth in Figure 4 and as described in the ’831 patent.” *Id.* at 13–14. Finally, as we noted in the decision on institution and as Patent Owner expressly acknowledges, the Specification of the ’831 patent uses the permissive “may” when referring to the electronic controller as including the predetermined sequence program embodiment. *Req. Reh’g.* 4; *Dec.* 5.

To the extent that Patent Owner argues that it “affirmatively gave up” the ability to have a claim with the scope to cover a “fasten it wrong and fix it later” system (*see Req. Reh’g* 1, 4), that argument does not appear to have

been made in Patent Owner's Preliminary Response.¹ A request for rehearing is not an opportunity to present new arguments or evidence that could have been presented and developed in the petition. *See* 37 C.F.R. § 41.104(b)(4) (stating "[t]he petition must specify where each element of a challenged claim is found in the prior art patents or printed publications relied upon"). We could not have overlooked or misapprehended arguments or evidence not presented and developed by Patent Owner in the first instance.

In any event, we are not persuaded that the prosecution history of the '831 patent shows that Patent Owner affirmatively relinquished claim scope that would encompass a "fasten it wrong and fix it later" system. We did consider the Examiner's statement for allowance (*see* Ex. 1007, 3–4; Prelim. Resp. 12–14) and the general statement in the Specification of the '831 patent concerning the goal of providing "a more reliable and more fool-proof way to conduct fastening operations" (*see* Ex. 1001, col 2., ll. 44-45, Abstract; Prelim. Resp. 6, 23), along with Figure 4 and its description, the meaning of the claim term "providing," and the predetermined sequence program embodiment. Dec. 22. We are unpersuaded on this record, however, that Patent Owner affirmatively surrendered claim scope that would encompass a "fasten it wrong and fix it later" system or method.

Our decision that additional fastening operations between the first and second fastening operations are not excluded because claim 22 uses the transitional term "comprising" is not inconsistent with controlling precedent

¹ Patent Owner also makes another argument that was not made in its Preliminary Response. *See* Req. Reh'g 8 (arguing Patent Owner's proffered constructions for a "fasten it right the first time" system giving effect to the transition phrase, "comprising.>").

because we do not agree that the prosecution history of the '831 patent “compels the conclusion that the claims be construed to only cover a ‘fasten it right the first time’ system” or method. Req. Reh’g 7-8 (citing *Suitco Surface*, 603 F.3d at 1260). We have construed the claims consistently with the Specification of the '831 patent. *Suitco Surface*, 603 F.3d at 1260.

Finally, Patent Owner asserts that we overlooked arguments that Gass fails to disclose both the “predetermined sequence” and the “sequence output” elements. Req. Reh’g 2, 8. We did consider these arguments of Patent Owner. In our decision on institution, we stated:

Patent Owner does not argue specific limitations of claims 22 and 24–25 that Gass fails to disclose. Instead, Patent Owner argues that Gass fails to describe the “monitoring torque” limitation of claims 26–28 because Gass does not ensure that a predetermined sequence is followed for successive, single fastening locations.

Dec. 18 (internal citations omitted). We did not overlook Patent Owner’s arguments concerning the Gass reference; we simply were not persuaded by those arguments. *See* Req. Reh’g 8–12.²

III.CONCLUSION

For the foregoing reasons, we did not abuse our discretion when determining that Petitioner demonstrated a reasonable likelihood of prevailing on their assertion that claims 22–28 of the '831 patent are unpatentable. Accordingly, Patent Owner’s request for rehearing is *denied*.

² Because we did not institute *inter partes* review on any ground based on the Wilhelm reference, we need not address Patent Owner’s argument as to this reference. *See* Req. Reh’g 13.

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