

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*.

ARPIN, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Johnson Controls, Inc. (“Petitioner”) filed a Petition (Paper 3, “Pet.”) on December 27, 2013, requesting an *inter partes* review of claims 22–28 of U.S. Patent No. 7,062,831 B2 (Ex. 1001, “the ’831 patent”). Pursuant to 35 U.S.C. § 314, we instituted this trial on June 23, 2014, as to claims 22–28. Paper 9. After institution, Wildcat Licensing WI, LLC (“Patent Owner”) filed a Patent Owner Response (Paper 21, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner Response (Paper 27, “Reply”). Oral argument was held on March 2, 2015, and a transcript (Paper 44, “Tr.”) has been entered into the record.

We were persuaded that Petitioner demonstrated by a preponderance of the evidence that claims 22–28 of the ’831 patent are unpatentable under 35 U.S.C. § 103(a), and entered a Final Written Decision (Paper 45, “Final Dec.”) pursuant to 35 U.S.C. § 318(a) determining claims 22–28 of the ’831 patent were unpatentable. Pursuant to 37 C.F.R. § 42.71(d), Patent Owner filed a Request for Rehearing (Paper 46, “Reh’g Req.”), seeking reconsideration of our Final Written Decision. For the reasons set forth below, Patent Owner’s Request for Rehearing is *denied*.

II. DISCUSSION

1. *Standard for Reconsideration*

37 C.F.R. § 42.71(d) provides that:

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. *The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.*

(emphasis added). When reconsidering a Final Written Decision, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). Thus, a request for rehearing is not an opportunity merely to disagree with the panel’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence.

2. Overview

Patent Owner asserts six bases for its Request for Rehearing. First, Patent Owner argues that we overlooked its argument about the effect of the prosecution history of the ’831 patent on the construction of various claim terms. Reh’g Req. 1–9. Second, Patent Owner argues that we overlooked that Petitioner’s declarant admitted that Patent Owner’s construction of the term “predetermined” was correct. *Id.* at 9–10. Third, Patent Owner argues that we overlooked Patent Owner’s argument regarding consideration of an unclaimed embodiment in the claim construction. *Id.* at 10–11. Fourth, Patent Owner argues that we misapprehended the term “comprising” as a basis for broadening the interpretation of the challenged claims. *Id.* at 11–13. Fifth, Patent Owner argues that we misapprehended the testimony of Patent Owner’s declarant, which does not support our adopted claim construction. *Id.* at 13–14. Sixth, Patent Owner argues that we overlooked Patent Owner’s arguments about an irreconcilable difference in testimony between the parties’ declarants. *Id.* at 14–15. For the reasons set forth below, we are not persuaded by Patent Owner’s arguments.

3. Prosecution History Disavowal

With regard to its first basis, Patent Owner argues that we overlooked its argument about the effect of the prosecution history of the ’831 patent on the construction of various claim terms. *Id.* at 1–9. In particular, Patent Owner argues that Applicants made a clear disavowal of the scope of claim 22 during the

prosecution of that claim and that we failed to address this disavowal in our Final Written Decision. *Id.* at 1–2. This is not correct.

In its Patent Owner Response, Patent Owner argued that

Independent claim 1, as filed . . . covered . . . any sequence of fastening, including a ***user-selected*** sequence of fastening or ***a predetermined sequence*** of fastening . . . dependent claims 7 and 11, which required . . . ***a predetermined sequence program***, were indicated to recite allowable subject matter. *Id.* at 10. . . New claim 46 narrowed the required sequence of fastening to include ***only*** “a predetermined sequence of fastening,” intentionally excluding the user[-]selected fastening sequences that Petitioner alleges are covered by claimed invention. *Id.* at 14.

Reh’g Req. 1–2 (quoting PO Resp. 22–23 (emphasis in original)). Patent Owner argues that this represents a clear disavowal of a user-selected sequence of fastening in claim 462 “to focus on one of the important aspects of the present invention, namely the predetermined sequence program requiring a predetermined sequence fastening.” *Id.* at 2 (quoting Ex. 1006, 17); *see also* PO Resp. 21 (“[Claim 22] narrowed the required sequence of fastening to include ***only*** ‘a predetermined sequence of fastening,’ intentionally excluding the user-selected fastening sequences Petitioner alleges are covered by the claimed invention.”). Patent Owner further asserts that “[a]pplicant acquiesced in the examiner’s interpretation and, to obtain allowance of claim 22, maintained the disavowal of user-selected sequences by amendment in the parent application.” *Id.* at 2. Patent Owner argues that, as a result of this clear disavowal, “the predetermined sequence program of method claim 22 was referenced in the specification as ‘requiring a predetermined sequence of fastening among the fastening locations 52a–c,’ all of which are located in a single process site.” Reh’g Req. 2 (citing Ex. 1001, col. 7, ll. 47–50).

Patent Owner has not argued previously that a clear disavowal of claim scope was made in the prosecution history of the '831 patent. *See, e.g.*, PO Resp. 17–34. Instead, Patent Owner argued in the cited portion of its Patent Owner Response that our construction “read out” the term “predetermined” from the claims, but did not cite to any clear disavowal of claim scope. *See* PO Resp. 21–23. We considered Patent Owner’s argument concerning whether we “read out” the term “predetermined” from the claims in connection with our analysis of Petitioner’s proposed construction of the term “electronically comparing the sensed position of the fastening tool with a predetermined sequence of fastening among the first and second fastening locations” of claim 22 in our Final Written Decision. *See* Final Dec. 10–13.

Patent Owner further argues that the alleged clear disavowal of “a user-selected sequence of fastening” from claim 22 during prosecution necessarily alters the construction of additional terms in the claims. Reh’g Req. 2–6 (discussing “fastening location,” “predetermined sequence,” “fastening monitor,” and “sequence output”). With respect to these claim interpretation arguments, however, Patent Owner again fails to identify where each of these arguments was raised previously.¹ Moreover, with respect to the effect of any such disavowal on the interpretation of other claim terms, we could not have misapprehended or overlooked arguments that Patent Owner did not raise previously. Even if we addressed this new argument, as Patent Owner urges that we must under *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292 (Fed. Cir. 2015), it fails. Patent Owner asserts that its clear disavowal may be drawn from a comparison of claim 1 with

¹ New arguments may not be raised at an oral hearing. Patent Owner’s challenge during the oral hearing to Petitioner’s allegedly late submission of a dictionary definition of “location” does not make these arguments part of the record. Reh’g Req. 3–4 (citing Tr. 44:6–18).

claims 7 and 11 and the addition of claim 46, which became challenged claim 24 of the parent patent to the '831 patent, Patent No. US 6,763,573 B2 (Ex. 1001, “the '573 patent”), “to focus on one of the important aspects of the present invention, namely the predetermined sequence program requiring a predetermined sequence fastening.” Req. Reh’g 2 (quoting Ex. 1006, 17); PO Resp. 22–23. This, however, does not rise to the level of an unequivocal and unambiguous disavowal of claim scope to narrow the meaning of claim 22 of the '831 patent, as Patent Owner asserts. *See Biogen Idec, Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1094-95 (Fed. Cir. 2013).

Patent Owner also argues that governing case law requires that we consider the prosecution history. Patent Owner notes that, in *Microsoft Corp. v. Proxyconn, Inc.*, the Federal Circuit observed that the Board “should also consult the patent's prosecution history in proceedings in which the patent has been brought back to the agency for a second review.” 789 F.3d at 1298. In this regard, Patent Owner argues that we are bound by the Examiner’s claim construction resulting from Applicants’ disavowal of scope during prosecution. Reh’g Req. 7–8 (citing Tr. 55:17–18); *see* Tr. 55:13–24. As the prosecution history makes clear, Patent Owner proffered a new claim 46 during prosecution of the related '573 patent, “to focus on one of the important aspects of the present invention, namely the predetermined sequence program requiring a predetermined sequence fastening,” but not in response to any Examiner request (Ex. 1006, 17) unlike the situation in *Tempo Lighting, Inc. v. Tivoli, LLC*. *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973, 978 (Fed. Cir. 2014). Thus, we are not persuaded that Patent Owner has identified a claim construction resulting from the prosecution history that constitutes a “deal” between Applicants and the Examiner, binding on this panel. *See* Reh’g Req. 3 (“A *deal* was made to secure allowance of the claims by

specifically amending them to only read on the ‘predetermined sequence program’ embodiment of the specification that requires a predetermined sequence of fastening among locations 52a–52c.”; emphasis added). Even if we were to accept Patent Owner’s arguments that a clear disavowal of claim scope exists in the prosecution history of the ’573 patent that is applicable to claim 22 of the ’831 patent, as the Federal Circuit observed, in such a situation, “the PTO is under no obligation to accept a claim construction proffered as a prosecution history disclaimer, which generally only binds the patent owner.” *Tempo Lighting*, 742 F.3d at 978. Therefore, we are not persuaded that our consideration of the prosecution history was contrary to governing precedent, as argued by Patent Owner, such that it amounted to an abuse of discretion.

4. Admitted Meaning of “Predetermined”

Patent Owner argues that we overlooked that Petitioner’s declarant admitted that Patent Owner’s construction of the term “predetermined” was correct. Reh’g Req. 9–10. Specifically, during the deposition of Petitioner’s declarant, Mr. Osentoski, Patent Owner referred to Figure 1 of the ’831 patent² and asked Mr. Osentoski, “Is the sequence of 52 A, B, and C, in memory before the operator picks up an adapter bush?,” to which Mr. Osentoski responded “If it is predetermined.” Ex. 2033, 76:25–77:4;³ see Reh’g Req. 9. From this testimony, Patent Owner concludes that “Petitioner’s expert thus conceded that ‘predetermined sequence’ requires that a single fastening sequence for fastening locations in a single process site be programmed into memory before the fastening tool is used, and that it cannot be merely a program that reacts to a user-selected fastening sequence.”

² In its Request for Rehearing, Patent Owner refers to Figure 1 of the ’573 patent, which is substantially the same as Figure 1 of the ’831 patent.

³ Patent Owner incorrectly cites to Ex. 2032 of IPR2014-00304, rather than Ex. 2033 of this proceeding.

Reh’g Req. 9. Patent Owner further asserts that this testimony is inconsistent with Petitioner’s assertion that Gass teaches the “predetermined sequence” and the “sequence output” claim elements. Paper 33, 2–3 (citing Reply 10–15).

Nevertheless, as Petitioner notes,

Mr. Osentoski testified that Gass teaches that its predetermined sequence is programmed “before the operator begins the process of assembly the bolts at the process sites.” Ex. 2033, 15:19–16:2. In response to essentially the same questions presented repeatedly by Wildcat’s counsel, Mr. Osentoski consistently testified that Gass teaches the “predetermined sequence” and “sequence output” claim elements. *E.g.*, *id.*, 19:12–20:5; 21:14–22:2; 27:10–17; 30:2–31:2; 44:2–23.

Paper 39, 4. Thus, we were not persuaded that Patent Owner’s characterization of Mr. Osentoski’s response to this question should be read to outweigh Mr. Osentoski’s repeated and otherwise consistent testimony on this point. Therefore, we are not persuaded that we misapprehended or overlooked a significant inconsistency in Mr. Osentoski’s testimony.

5. Unclaimed Embodiments of Figure 4

Patent Owner argues that we overlooked Patent Owner’s argument regarding consideration of an unclaimed embodiment in the claim construction. Reh’g Req. 10–11. Although Patent Owner notes where Petitioner and Patent Owner discuss the relevance of Figure 4 of the ’831 patent (*id.* at 10 (citing PO Resp. 11–12; Tr. 32:17–34:3; Pet. 8)), Patent Owner fails to identify where we allegedly misapprehended or overlooked Patent Owner’s or Petitioner’s arguments regarding this figure. Instead, Patent Owner merely asserts that Petitioner’s argument in its Petition “references the sequence related elements of the claims and is consistent with Patent Owner’s argument at pages 11–12 of its response that the Final Decision overlooks.” Reh’g Req. 11. Such unsupported assertions are insufficient

to persuade us that we have misapprehended or overlooked arguments presented by Patent Owner.

6. “*Comprising*” as a Basis for Broadening

Patent Owner argues that we misapprehended the term “comprising” as a basis for broadening the interpretation of the challenged claims. *Id.* at 11–13. In the Final Written Decision, we noted that

We agree with Petitioner that the broadest reasonable interpretation of “fastening location” is not limited to a single opening, but may encompass a position or site where fastening occurs when assigned its ordinary meaning. *See* Ex. 1041, 3. *Having to make such a distinction between a single opening and a fastening site with more than one opening is negated, however, by the open transitional phrase, [“comprising,”] in claim 22.* Because claim 22 uses the open transitional phrase “comprising,” additional fastening operations between the first and second fastening operations are not excluded, as long as the predetermined sequence between the first and second locations is maintained. *See CIAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007) (“In the patent claim context, the term ‘comprising’ is well understood to mean ‘including but not limited to.’”); Ex. 1001, 12:13–16 (contemplating a “plurality” of fastening locations, but [“at least”] first and second fastening locations).

Final Dec. 8 (emphasis added). This interpretation does not change the order of the recited operations, but acknowledges that other operations may be encompassed within the scope of the challenged claims. Thus, we have not abused our discretion by misapplying governing precedent. In addition, Patent Owner fails to identify where it made these arguments previously in its Patent Owner Response. Because Patent Owner has not raised these arguments in its Patent Owner Response, we could not have misapprehended or overlooked an argument that Patent Owner did not raise previously.

7. *Misunderstanding Dr. Brinson's Testimony*

Patent Owner argues that we misapprehended the testimony of Patent Owner's declarant, Dr. Brinson, which does not support our adopted claim construction. Reh'g Req. 13–14. In particular, Patent Owner argues that “Dr. Brinson describes a single article having two predetermined sequences covered by the ['831] patent. (Ex. [2009 ¶ 53].) One is a1, a2, a3 and the other is b1, b2, b3. (*Id.*)” Reh'g Req. 13.⁴ Patent Owner argues that this description of fastening locations a1, a2, a3 is substantially identical to fastening locations 52a–52c that are depicted in Figure 1 of the '831 patent. *Id.* Thus, Patent Owner argues that Dr. Brinson only testified to the enforcement of the order within each predetermined sequence, *e.g.*, a1, a2, a3 or b1, b2, b3, and not at different locations or involving intervening “operations.” *Id.* at 13–14.

In our Final Written Decision, however, we noted that

Dr. Brinson confirms that intervening fastening operations between the first and second fastening locations are contemplated in claim 22 of the '831 patent. Dr. Brinson states

[i]t is important to note that the '831 patent does not describe a 'predetermined sequence' with regard to fastening any one or all of the fasteners in one set (in another predetermined sequence). Rather, only the order within each predetermined sequence is enforced. Therefore, in this example [with two predetermined sequences, (a1, a2, a3) and (b1, b2, b3)], an operator could follow the predetermined sequence of fastening location in either of the following two orders: 1. (a1, a[2], a3, b1,b2, b3) or 2. (a1, b1, a2, b2, a3, b3).

Final Dec. 8–9 (quoting Ex. 2009 ¶ 53; emphasis added). Thus, as Dr. Brinson testified, the fastening steps from the predetermined sequence b1, b2, b3 may

⁴ In its Request for Rehearing, Patent Owner refers to Figure 1 of the '573 patent, which is substantially the same as Figure 1 of the '831 patent. Patent Owner also incorrectly cites to Ex. 2008 of IPR2014-00304, rather than Ex. 2009 of this proceeding.

“intervene” between the fastening steps from the predetermined sequence a1, a2, a3. Further, we note that, contrary to Patent Owner’s argument, Dr. Brinson does not limit the discussion in paragraph 53 of her declaration to Figure 1 (*i.e.*, fastening locations 52a–52c), and instead, Dr. Brinson describes a “more complex example” for understanding the fastening locations, as well as “[a]n additional example of how an operator could follow these sequences [] by fastening in order (a1, b1, a2, b2, a3 b3).” Ex. 2009 ¶ 53. Thus, we were not persuaded that Dr. Brinson’s testimony should be understood as narrowly as proposed by Patent Owner. Therefore, we are not persuaded that, on this point, we have misapprehended or overlooked arguments or evidence presented by Patent Owner.

8. Irreconcilable Difference

Patent Owner argues that we overlooked Patent Owner’s arguments about an irreconcilable difference in testimony between the parties’ declarants. Reh’g Req. 14–15. In particular, Patent Owner states that “Petitioner’s expert testified that a signal from a socket tray in paragraph 6, lines 6–9 of Gass (Ex. 1012) *is not provided* as an input to its program.” *Id.* at 14 (emphasis added; citing Ex. 2033, 47:13–18); *see* Paper 33, 2. This, however, mischaracterizes Mr. Osentoski’s testimony.

Turning to the page of Mr. Osentoski’s deposition testimony cited by Patent Owner, we note the following exchange between Patent Owner’s counsel and Mr. Osentoski:

Q. What does it mean “to be indicated optically on the crib”?

A. Where do you see this at?

Q. In about the middle of Paragraph 6.

A. What is the start of the sentence?

Q. An operator.

A. An operator. Okay. What was the question then?

Q. What does it mean “to be indicated optically on the crib”?

A. *It is not entirely really clear what that means.*

Q. Do you have any understanding of what that means?

A. *Within the context of this paragraph it is not entirely clear what that means.*

Q. Isn't it just an input into the predetermined sequence program from the adapter bush?

A. *It doesn't say that.*

Ex. 2033, 47:3–22 (emphases added). Further, after reviewing Mr. Osentoski's other testimony cited here by Patent Owner, we remain unpersuaded that this quoted testimony contradicts Mr. Osentoski's later testimony during his deposition. *See* Paper 33, 2 (citing Ex. 2033, 78:9–79:6, 81:5–12); *see also* Ex. 2033, 81:21–25 (Q. If Gass doesn't recognize what adapter bush is used, then how does it handle that situation? A. Oh, jeez. There is a correct sequence. . . ."). Further, after reviewing Dr. Brinson's testimony cited here by Patent Owner (*see* Paper 33, 2 (citing Ex. 1040, 236:15–237:14; Ex. 2009 ¶ 94)), we remain unpersuaded that Dr. Brinson's testimony is irreconcilable with Mr. Osentoski's testimony. In her declaration, Dr. Brinson states that, "[b]ecause Gass does not describe a predetermined (i.e., preloaded) sequence, Gass does not describe the 'predetermined sequence program' element." Ex. 2009 ¶ 91. Nevertheless, during her deposition testimony, Dr. Brinson states that, although she did not create one for her declaration, she was able to create a memory table for Gass and describe a predetermined process for Gass, albeit an allegedly different process from that disclosed in the Specification for the '831 patent. *See* Ex. 1040, 237:15–243:1; *see also* Paper 39, 3 ("Mr. Osentoski testified extensively that Gass's second aspect discloses a predetermined sequence and disables the fastening tool if that predetermined sequence is not followed. *E.g.*, Ex. 2033, 14:9–19:11; 20:6–20:16; 80:5–85:4."). Thus, we are not persuaded that the testimony of Dr. Brinson and Mr. Osentoski are irreconcilably different, that we should credit Dr. Brinson's

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testimony over that of Mr. Osentoski, or that we misapprehended or overlooked any such difference in our Final Written Decision. See Final Dec. 22–26.

III. ORDER

For the reasons given, it is

ORDERED that Patent Owner’s Request for Rehearing is *denied*.

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