

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HAMILTON BEACH BRANDS, INC.,
Petitioner,

v.

COURTESY PRODUCTS, LLC,
Patent Owner.

Case IPR2014-01257
Patent 7,311,037 B2

Before GRACE KARAFFA OBERMANN, HYUN J. JUNG, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

DECISION
Motion for Reconsideration
37 C.F.R. § 42.71(d)

I. INTRODUCTION

In a Motion for Reconsideration (Paper 16, “Mot.”), Hamilton Beach Brands, Inc. (“Petitioner”) requests rehearing and reconsideration of our decision denying institution of an *inter partes* review (Paper 14, “Dec.”) of claims 6, 7, 19, and 26, of U.S. Patent No. 7,311,037 B2 (Ex. 1001, “the ’037 patent”).

Petitioner does not seek rehearing of our decision to institute *inter partes* review of claims 1–5, 8–18, 20–25, and 27–29 of the ’037 patent.

The applicable standard for a request for rehearing of an institution decision is abuse of discretion. 37 C.F.R. § 42.71(c). The requirements are set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a 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.

For the reasons stated below, Petitioner’s motion is *denied*.

A. *Decision to Institute*

We determined that Petitioner had not established a reasonable likelihood of prevailing on its assertion that claims 6, 7, 19, and 26 of the ’037 patent as unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 6,164,191 to Liu, iss. Dec. 26, 2000 (Ex. 1002, “Liu”); U.S. Patent No. 5,840,189 to Sylvan, iss. Nov. 24, 1998 (Ex. 1003, “Sylvan”); and U.S. Patent No. 3,446,624 to Luedtke, iss. May 27, 1969 (Ex. 1004, “Luedtke”) or over U.S. Patent No. 3,620,155 to Bixby, iss. Nov. 16, 1971 (Ex. 1005,

“Bixby”); Sylvan; and Luedtke. Dec. 15–17, 18. Specifically, for claims 6 and 7, we agreed with Patent Owner that Petitioner did not provide an explanation of how Liu and “Van Damme” (Ex. 1021) would be combined. Dec. 15. For claim 19, we determined that the Petition failed to explain how the relied upon references and “relevant hospitality industry regulations” teach the limitations and how those references would be combined. Dec. 16. Further, we determined that the Petition improperly incorporated arguments by reference to a Declaration of Alexander H. Slocum (Ex. 1009, “Slocum Declaration”).

A petition must contain a “full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence.” 37 C.F.R. § 42.22(a)(2). The Slocum Declaration contains argument, not discussed adequately in the Petition, regarding where limitations are found in the references and why an ordinary artisan would have been led to combine the references to attain the subject matter of claim 26. Dec. 16–17. Under these circumstances, the Petition violates our rule that prohibits arguments made in a supporting document from being incorporated by reference into a petition. *See* 37 C.F.R. § 42.6(a)(3). We found the same deficiencies in the challenge based on Bixby, Sylvan, and Luedtke. Dec. 18.

II. DISCUSSION

For claims 6 and 7, Petitioner contends that the Petition identified where the prior art teaches the limitations of claims 6 and 7 and thus, “[a]s, the Petition explains, the Slocum Declaration is relevant to show that the claims of the ’037 Patent simply rearrange known elements to achieve

predictable results.” Mot. 13 (citing Paper 4 (“Pet.”) 21–22, 26). Petitioner also asserts that “the Board appears to require the Petition show an explicit motivation to combine.” Mot. 12. Petitioner contends that “the Board should have evaluated obviousness under the ‘obvious to try’ standard.” Mot. 13–14 (citing Pet. 10).

Petitioner cites a part of its Petition that is titled “Motivation to Combine Liu with Sylvan and Luedtke” and that provides several rationales for combining these particular references and no others. Pet. 21–23. Petitioner fails to identify a portion of the Petition that extends one or more of these rationales for combining Liu, Sylvan, and Luedtke to “Van Damme,” cited for claims 6 and 7. Petitioner also cites page 10 of its Petition, which describes *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) and argues that “the Examiner did not apply its principles . . . during the prosecution of the ’037 Patent.” Pet. 9–10. The cited portion of the Petition does not present an argument that claims 6 and 7 are unpatentable over Liu and “Van Damme.” The Petition does not discuss any rationale for combining Liu and Van Damme. Petitioner’s arguments for claims 6 and 7, therefore, do not persuade us to modify our Decision.

For claims 19 and 26, Petitioner argues that “the Board should have considered the arguments and evidence presented with respect to corresponding independent claim 1.” Mot. 4. Petitioner, however, does not direct us to a portion of its Petition that refers to or extends the arguments and evidence of claim 1 to argue the unpatentability of claims 19 and 26. A request for rehearing is not an opportunity to supplement an initial petition and make arguments a petitioner did not make before. *See* 37 C.F.R.

§ 42.104(b)(4) (a petition must identify “[h]ow the construed claim is unpatentable under the statutory grounds identified”).

Petitioner argues that “the Board should have considered the declaratory evidence of hospitality industry practice, as well as the explanation of the significance of that evidence in the Petition, which were directed to the added limitations of claims 19 and 26.” Mot. 4 (citing Pet. 21–23). Petitioner quotes pages 22–23 of the Petition as providing an argument for claim 19. Mot. 5–6.

Petitioner cites a part of its Petition that is titled “Motivation to Combine Liu with Sylvan and Luedtke” and provides several rationales for combining these particular references but not “relevant hospitality industry regulations.” Pet. 21–23. Petitioner fails to explain how the Petition extends one or more of these rationales for combining Liu, Sylvan, and Luedtke to the “relevant hospitality industry regulations,” cited for claim 19. With respect to the Slocum Declaration, the cited portion of the Petition explains neither the significance of paragraph 91, which is cited for claim 19; nor the significance of paragraph 98, which is cited for claim 26. Pet. 21–23 (citing Ex. 1009 ¶¶ 42–50), 29 (citing Ex. 1009 ¶ 91), 30–31 (citing Ex. 1009 ¶ 98). Petitioner’s arguments, thus, do not persuade us to modify our determination that the Petition fails to explain adequately how the asserted references render obvious the subject matter of claims 19 and 26.

Petitioner argues that the cited hospitality industry regulations provide explicit reasons for claim 19. Mot. 6–7 (citing Pet. 29). However, the Petition states that, for claim 19, “Liu in view of Sylvan and Luedtke, and further in view of relevant hospitality industry regulations, disclose this limitation.” Pet. 29. Petitioner does not explain how such a conclusory

statement in the Petition conveys that “relevant hospitality industry regulations” provide a reason for combining the references. It does not indicate what “relevant hospitality industry regulations” teach or how those teachings provide a rationale for combining the other references. We could not have misapprehended or overlooked an argument that was not made in the Petition.

Petitioner asserts that the Petition is in compliance with Board instructions that state a “mere citation to an expert declaration (e.g., ‘See Ex. 1015 ¶ 29’) in a claim chart is permissible, but anything more than a mere citation is improper.” Mot. 7 (citing Paper 3). Petitioner is correct that a mere citation to an expert declaration is permissible in a claim chart, but a mere citation without an explanation elsewhere in the petition, as to the importance of that citation, can be deemed an attempt to bypass page limits for petitions.

Petitioner argues that it did not improperly incorporate paragraph 91 of the Slocum Declaration by reference because that paragraph is consistent with the arguments presented in the Petition and presents evidence of what a person of ordinary skill in the art would have considered in achieving the limitation of claim 9. Mot. 8. However, that argument does not point us to where in the Petition the significance of this part of the Slocum Declaration was explained. Petitioner does not point us to any argument in the Petition that describes “relevant hospitality industry regulations” in the manner of the Slocum Declaration. Therefore, we are not persuaded that we misapprehended or overlooked an argument in the Petition.

Petitioner further argues that “applying ‘common sense’ to the obviousness analysis” would achieve the limitations of claims 19 and 26.

Mot. 9–10 (citing Pet. 10–11). Pages 10–11 of the Petition describe what the Examiner failed to do during the prosecution of the '037 Patent but does explain how the cited references rendered obvious the subject matter of claims 19 and 26. Under these circumstances, Petitioner's "mere recitation of the words 'common sense' without any support adds nothing to the obviousness equation." *Mintz v. Dietz & Watson*, 679 F.3d 1372, 1377 (Fed. Cir. 2012).

Petitioner also argues, for claims 19 and 26, that the significance of the Slocum Declaration was explained as providing evidence that elements of the '037 patent were known and their combination yields predictable results. Mot. 6, 11 (citing Pet. 21–22). Pages 21–23 of the Petition, however, explain the significance of paragraphs 42–50 of the Slocum Declaration, but not paragraph 91, which is cited for claim 19, or paragraph 98, which is cited for claim 26. We are not persuaded by this argument that we misapprehended or overlooked a matter in the Petition.

Petitioner argues that the Slocum Declaration presents evidence of what a person of ordinary skill in the art would have considered in achieving the limitation of claim 26. Mot. 10. Petitioner further argues that the Petition identifies where limitations of claim 26 are and the Board should have considered "obvious as a matter of common sense" in its analysis. Mot. 10–11 (citing Pet. 23–24). Petitioner cites its arguments for claim 1, but Petitioner does not identify where the Petition itself explains the references teach the additional limitations of claim 26, or how the combined teachings of the references render obvious the subject matter of claim 26. Therefore, we are not persuaded that we misapprehended or overlooked an argument in the Petition for claim 26.

After considering the cited portions of the Petition, Petitioner has not shown that the Board misapprehended or overlooked a matter addressed in the Petition, and therefore, has not carried its burden of demonstrating an abuse of discretion in the Board's decision.

III. ORDER

In consideration of the foregoing, it is hereby ORDERED that Petitioner's Motion for Reconsideration is *denied*.

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