

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 IPR2014-01260
Patent 7,258,884 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 12, “Mot.”), Hamilton Beach Brands, Inc. (“Petitioner”) requests rehearing and reconsideration of our decision denying institution of an *inter partes* review (Paper 11, “Dec.”) of claims 1–53 of U.S. Patent No. 7,258,884 B2 (Ex. 1001, “the ’884 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 Denying Institution*

We determined that Petitioner had not established a reasonable likelihood of prevailing on its assertions that claims 1–53 of the ’884 patent are 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. 9, 11.

Specifically, for the challenge that claims 1–15, 42, 45, 48, and 51 would have been rendered obvious by Liu, Sylvan, and Luedtke, the Petition

presumes that the preamble of claim 1 is limiting. Dec. 6 (citing Paper 4 (“Pet.”) 23). Petitioner’s stated rationale for combining Liu, Sylvan, and Luedtke, however, did not address directly the preamble, and thus, we inferred that Petitioner was relying on “relevant hospitality regulations.” *Id.* at 7 (citing Pet. 21–22). We determined that Petitioner’s argument, regarding the “relevant hospitality regulations,” was not explained adequately, and that citations to a Declaration by Kurt J. Krause (Ex. 1007, “Krause Declaration”) and a Declaration by Alexander H. Slocum (Ex. 1009, “Slocum Declaration”) represented an improper incorporation by reference of argument into the Petition. *Id.* (citing Pet. 23). We also determined that this circumvented page limits that apply to petitions. *Id.* (citing 37 C.F.R. § 42.24(a)).

We also determined that the citations to the declarations did not support Petitioner’s argument and that the corrected petition differed from the originally filed petition for these particular contentions. Dec. 8–9 (citing Paper 1, 22; Pet. 23). We further concluded that Petitioner’s challenge of claims 16–41, 43, 44, 46, 47, 49, 50, 52, and 53 as unpatentable over Liu, Sylvan, and Luedtke and claims 1–53 as unpatentable over Bixby, Sylvan, and Luedtke had similar deficiencies. Dec. 9–11.

II. DISCUSSION

In its motion, Petitioner contends that “arguments regarding common knowledge of providing an in-room beverage service to a lodging establishment, supported by expert declaratory evidence” were not considered and “whether the modifications were ‘obvious to try’ in view of ordinary skill and common sense” should have been considered. Mot. 3.

Petitioner first argues that the Petition articulates how supplying in-room beverage service to a lodging establishment is obvious. Mot. 3. Petitioner argues that “the preamble regarding the setting in which the method is practice is ‘superfluous’ to the purported invention set forth in the body of the claims.” Mot. 3–4. Petitioner, however, does not point to where that argument was made in the Petition. We determined, instead, that the Petition presumes that the preamble is limiting. Dec. 6; Pet. 23 (claim chart stating for the preamble of claim 1 that, “Liu in view of relevant hospitality industry regulations teaches the limitations”).

For independent claim 1, Petitioner refers us to the rationales and claim charts to argue that “it would have been obvious to supply to the rooms of the ‘lodging establishment’ with disposable brew baskets and filter packs in view of the cited art and hospitality practices identified by the cited Krause Declaration.” Mot. 4–5 (citing Pet. 22–25, 40–44). The cited portions of the Petition assert that it would have been obvious to supply a hotel room with the brew basket and filter pack of Liu or Bixby “because these actions are inherent to an in-room beverage service.” Pet. 22. The Petition cites to paragraphs 50–53 of the Krause Declaration and paragraphs 46 and 66 of the Slocum Declaration. Pet. 22, 41. The Petition indicates, and we agree, that Liu or Bixby combined with Sylvan and Luedtke does not teach expressly limitations related to rooms of a lodging establishment. See Dec. 6 (quoting Ex. 1002, 1:59–60 (“It is to be understood that beverage maker 8 is preferably designed for use in vehicles.”)). Neither the portions of the Petition now referred to by Petitioner, nor the declarations, show sufficiently that the missing descriptive matter is necessarily present in Liu,

Bixby, Sylvan, or Luedtke or, therefore, support the contention that “these actions are inherent to an in-room beverage service.”

Also, consistent with this understanding, the claim charts assert that “Liu in view of relevant hospitality industry regulations teaches the limitations.” Pet. 23; *see also id.* at 25 (stating “Liu in view of Sylvan and further in view of relevant hospitality industry regulations teaches this limitation” and “Liu in view of Luedtke and further in view of relevant hospitality industry regulations teaches this limitation”). However, as described in our Decision, we found no explanation of these citations in the Petition; those citations thus represent improper incorporations by reference of arguments made in the declarations that circumvented page limits that apply to petitions. Dec. 6–7. Petitioner’s rehearing arguments for claim 1, thus, do not persuade us to modify our Decision.

For independent claims 16 and 29, Petitioner asserts that the bodies of these claims describe providing a beverage system; that the “lodging establishment” in the preambles adds nothing; and, thus, the claim charts identify all of the structure in the claimed systems. Mot. 5–6 (citing Pet. 28–30, 33–34, 47–48, 50–51). The cited pages of the Petition are the claim charts for claims 16 and 29, but these pages do include these arguments. Also, claims 16 and 29 each recite a method, but neither includes an express step of providing a beverage system. Moreover, the cited portions of the claim charts argue that Liu or Bixby in view of relevant hospitality industry regulations teach the limitations. A request for rehearing is not an opportunity to supplement a petition or make new arguments. *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’s rehearing arguments for claims 16 and 29 do not persuade us to modify our Decision.

Petitioner also asserts that the Petition cites a “Hotel Interactive article” (Ex. 1011) and thus provides sufficient arguments that it was well known to provide in-room beverage service to a lodging establishment. Mot. 6–8 (citing Pet. 2, 6, 9, 15–16, 22, 41). The cited pages of the Petition discuss (1) arguments regarding the “Hotel Interactive article” made during the prosecution of the application that issued as the ’884 patent, (2) the specification of the ’884 patent, and (3) rationales for combining Liu, Sylvan, and Luedtke or Bixby, Sylvan, and Luedtke. There is no indication on these pages that the “Hotel Interactive article” or the specification of the ’884 patent represented references applied in the challenge of claims 1–53 as unpatentable over Liu, Sylvan, and Luedtke or Bixby, Sylvan, and Luedtke. Petitioner also does not identify where, in the challenges based on Liu, Sylvan, and Luedtke or Bixby, Sylvan, and Luedtke, the “Hotel Interactive article” or the specification of the ’884 patent was cited. Petitioner’s arguments, made for the first time in its request for rehearing, do not persuade us to modify our Decision. *See* 37 C.F.R. § 42.104(b)(4).

Petitioner also asserts that the Krause Declaration and Slocum Declaration support the argument that the claimed method steps of the ’884 patent would have been obvious. Mot. 8–10 (citing Pet. 2, 6, 9, 15–16, 22; Ex. 1007 ¶ 53); *see also id.* at 11–12 (presenting similar arguments for the challenge of claims 16–41, 43, 44, 46, 47, 49, 50, 52, 53). Petitioner points to the same pages of the Petition cited for its arguments discussed above. As explained above, these pages of the Petition do not provide

arguments that either Liu, Sylvan, and Luedtke or Bixby, Sylvan, and Luedtke would have rendered obvious claims 1–53.

Petitioner contends that “the Petition makes clear that Hamilton Beach is relying on common knowledge to supply this limitation.” Mot. 13 (citing Pet. 2, 6, 9). Pages 2, 6, and 9 describe arguments made in the prosecution history of the ’884 patent. These pages do not provide an indication that Petitioner was asserting common knowledge for any limitation in its challenge of claims 1–53 as unpatentable over Liu, Sylvan, and Luedtke or Bixby, Sylvan, and Luedtke. This argument, made for the first time in the request for rehearing, thus, does not persuade us to modify our Decision.

Petitioner asserts that arguments in the claim charts of the originally filed Petition were changed in accordance with Board instructions that states 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. 14 (citing Paper 3), 15. 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.

After considering the cited portions of the Petition, we determine 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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