

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SURE-FIRE ELECTRICAL CORPORATION,
Petitioner,

v.

YONGJIANG YIN and SHENZHEN EL LIGHTING CO. LTD.,
Patent Owner.

Case IPR2014-01448
Patent 7,671,279 B2

Before DEBRA K. STEPHENS, JENNIFER S. BISK, and PETER P.
CHEN, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
FINAL WRITTEN DECISION
37 C.F.R. § 42.71 (d)

I. INTRODUCTION

A. Background

Sure-Fire Electrical Corp. (“Petitioner”)¹, filed an *Inter Partes*
Review Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims

¹ Along with Petitioner, Best Buy Stores, L.P. and BestBuy.com (collectively “Best Buy”), filed the Petition for *Inter Partes* Review. Paper 1. On May 1, 2015, Patent Owner and Best Buy jointly filed a motion to

1 and 7 (the “challenged claims”) of U.S. Patent 7,671,279 B2 (Exhibit 1001, “the ’279 Patent”). Petitioner, Best Buy Stores, L.P., and BestBuy.com relied on the following references: US 6,957,001 B2 (iss. Oct. 18, 2005) (“He”) (Ex. 1004); US 3,942,859 (iss. Mar. 9, 1976) (“Korodi”) (Ex. 1005); and Anton Gustafsson and Magnus Gyllenswärd, *The Power-Aware Cord: Energy Awareness through Ambient Information Display*, CHI 2005, 1423–26 (Apr. 2–7, 2005) (“Gustafsson”) (Ex. 1003). Yongjiang Yin and Shenzhen El Lighting Co. Ltd. (collectively “Patent Owner”), filed a Patent Owner’s preliminary response thereto (Paper 10, “Prelim. Resp.”).

On March 4, 2015, we instituted an *Inter Partes* review of claims 1 and 7 based upon Petitioner’s assertion that claims 1 and 7 are unpatentable under 35 U.S.C. § 103(a), for obviousness over Gustafsson and He (Paper 13 (“Inst. Dec.”)).

In response to Petitioner’s Request for Rehearing under 37 C.F.R. § 42.71(d) filed March 18, 2015 (Paper 15) (“Req. for Reh’g”), we modified our *Inter Partes* review based on Petitioner’s assertion that claims 1 and 7 are unpatentable under 35 U.S.C. § 103(a), for obviousness over He and Korodi (Paper 25 (“Dec. on Req. for Reh’g”)).

Accordingly, we instituted trial for both challenged claims, claims 1 and 7, on the grounds of unpatentability below.

Claims	Basis	References
Claims 1 and 7	§ 103(a)	Gustafsson and He

terminate proceedings between them (Paper 21). We granted that termination (Paper 24); thus, Best Buy is no longer a party to this review.

Claims	Basis	References
Claims 1 and 7	§ 103(a)	He and Korodi

After institution of trial, Patent Owner filed a Patent Owner's Response (Paper 27 ("PO Resp.)) and Petitioner filed a Reply to the Patent Owner's Response (Paper 38 ("Pet. Reply")).

An oral hearing was held on January 11, 2016, a transcript of which has been entered into the record (Paper 54 ("Tr.")).

B. Summary of the Final Decision

On February 22, 2016, we issued a Final Written Decision (Paper 56) pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, concluding Petitioner had shown by a preponderance of the evidence that the challenged claims are unpatentable. Specifically, we determined Petitioner had established by a preponderance of the evidence claims 1 and 7 are unpatentable under 35 U.S.C. § 103(a) over He and Korodi (Final Dec. 11–25). In light of our determination that Petitioner had established by a preponderance of the evidence that claims 1 and 7 of the '279 Patent are unpatentable under 35 U.S.C. § 103(a) as obvious over He and Korodi, we took no position on whether the same claims are also obvious over the combination of the teachings and suggestions of Gustafsson and He (*id.* at 25).

C. Summary of the Request of Rehearing

Petitioner has filed a Request for Rehearing (Paper 58, Req. Reh'g FD) of the Final Decision, asserting that despite our determination that claims 1 and 7 are unpatentable, the Board should make an additional determination that these same claims, claims 1 and 7 of the '279 patent, are also unpatentable under 35 U.S.C. § 103 (a) as obvious over Gustafsson and

He (Req. Reh’g FD 1). According to Petitioner, “the Board overlooked or misapprehended the potential ramifications of a decision to appeal the FWD” (*id.*). Specifically, Petitioner contends “if the Federal Circuit reverses (which it should not) the Board’s FWD on the Second Ground of unpatentability, the Board would need to issue a final decision on the First Ground of unpatentability on remand” (*id.*).

Petitioner, therefore, requests, in the “interests of justice and efficiency,” that we issue a final decision on the grounds that claims 1 and 7 are unpatentable under 35 U.S.C. § 103(a) as obvious over Gustafsson and He (First Ground) (Req. Reh’g FD, 4). Petitioner also contends PTO regulations do not permit the Board to render a final decision as to some grounds for unpatentability on which review was instituted, but instead “suggest that the Board must render a final decision as to **all** grounds” (*id.* (citing 37 C.F.R. § 42.73(a)). We have reconsidered our Final Decision in light of Petitioner’s assertions, but decline to modify that decision.

II. STANDARD OF REVIEW

The party requesting rehearing has the burden of showing that the decision should be modified, and “[t]he 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.” 37 C.F.R. § 42.71(d).

III. ANALYSIS

35 U.S.C. § 318 states “[i]f an inter partes review is instituted and not dismissed . . . , the Patent Trial and Appeal Board shall issue a final written

decision with respect to the patentability of any patent claim challenged by the petitioner.” 37 C.F.R. § 42.73(a) states “[a] judgment, except in the case of a termination, disposes of all *issues* that were, or by motion reasonably could have been, raised and decided” (emphasis added).

Neither the statute nor the rule requires the Board to decide all grounds presented; rather, a judgment is issued with respect to the patentability of any patent claim challenged and disposes of all issues raised. Here, we have issued a final written decision with respect to the patentability of claims 1 and 7 — the claims challenged by Petitioner. Specifically, we determined claims 1 and 7 of the ’279 patent are unpatentable. Entering a final decision that disposes of the issue of whether the challenged claims are unpatentable meets the requirements of both 35 U.S.C. § 318 and 37 C.F.R. § 42.73(a).

Petitioner would have the Board issue a final decision addressing whether the alternative combination (First Ground) also renders the challenged claims unpatentable, in the event “the Federal Circuit reverses the Board’s finding (which Petitioner asserts it should not), and needs to remand the case to the Board for a decision on the First Ground” (Req. Reh’g FD 4). Aside from this reason, Petitioner presents no additional reasoning as to why claims need two separate grounds to be found unpatentable. Although the scenario of reversal by the Court of Appeals for the Federal Circuit is possible, we are not persuaded rendering a decision that a claim is not patentable on one set of grounds as opposed to all asserted grounds, fails to serve the interests of justice and efficiency in determining whether a claim is unpatentable. Specifically, we determine overall efficiency is served and Board resources are conserved by addressing one

ground as opposed to all asserted grounds, when that one ground results in the *unpatentability of all challenged claims*. We appreciate the efficiencies gained in considering only one ground, may be offset with some inefficiency if the Court of Appeals for the Federal Circuit reverses and the additional ground(s) must be addressed on remand; however, nothing in the statute or rules precludes the Board from weighing those concerns and concluding the efficiency gained by addressing a single ground outweighs the potential inefficiency stemming from a possible remand. Therefore, we determine a proper course to ensure a just and speedy resolution, is met by determining the unpatentability of all claims at issue in the case, based on one asserted ground (*see* 37 C.F.R. § 42.1 (b) and 37 C.F.R. § 42.5 (a)).

IV. CONCLUSION

Having considered Petitioner's Request for Rehearing, we are not persuaded, for the reasons discussed, that Petitioner has shown that our Final Decision misapprehended or overlooked any point of law or fact advanced by Petitioner. Petitioner's request is granted only to the extent that we have considered Petitioner's arguments and reconsidered our Final Decision; however, we deny the request with respect to modifying our Final Decision.

V. ORDER

For the reasons given, it is hereby ORDERED that Petitioner's request for rehearing is *denied*.

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