

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHIMANO INC.,
Petitioner,

v.

GLOBERIDE, INC.,
Patent Owner.

Case IPR2015-00273
Patent 8,382,022 B2

Before JOSIAH C. COCKS, WILLIAM V. SAINDON, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. BACKGROUND

Petitioner, Shimano Inc. (“Shimano”), filed a corrected petition (Paper 7, “Pet.”) requesting an *inter partes* review of claims 1–12 (the “challenged claims”) of U.S. Patent No. 8,382,022 B2 (Ex. 1001, “the ’022 patent”). Shimano supported the Petition with a declaration from Scott L. Springer,

PhD (Ex. 1003). Patent Owner, Globeride, Inc. (“Globeride”), timely filed a Preliminary Response. Paper 10 (“Prelim. Resp.”). On June 18, 2015, based on the record before us at the time, we instituted an *inter partes* review of claims 1, 2, 6–9, and 12 (Paper 14, “Institution Decision” or “Dec.”), on the ground that those claims were unpatentable under 35 U.S.C. § 103 because they were obvious in light of the combination of the following three prior art references: Japanese Patent Publication No. JP2009-131212, (“JP212”) (Ex. 1004); Japanese Patent Publication No. JPH11-276042 (“JP042”) (Ex. 1007); and Japanese Patent Publication No. JP2002-354974 (“JP974”) (Ex. 1005).

After we instituted this review, Globeride filed a Patent Owner Response in opposition to the Petition (Paper 22, “Resp.”) that was supported by declarations from Grace King (Ex. 2042), Kimberly Cameron, PhD (Ex. 2043), and Terry Pederson (Ex. 2049). Shimano filed a Reply in support of the Petition (Paper 27, “Reply”). We heard oral argument on February 9, 2016. A transcript of the hearing is entered as Paper 39 (“Tr.”).

We entered our Final Written Decision on June 16, 2016 (Paper 40 “Final Written Decision” or “Final Dec.”), in which we concluded that claims 1, 2, 6–9, and 12 were unpatentable. Final Dec. 31. More specifically, we determined that Shimano had demonstrated by a preponderance of evidence that the combination of JP212 and JP042 rendered claims 1 and 6–8 unpatentable as obvious and the combination of JP212, JP042, and JP974 rendered claims 2, 9, and 12 unpatentable as obvious. *Id.*

Globeride timely filed a Request for Rehearing in which it asks that we reconsider and withdraw our Final Written Decision as it relates to all

claims found unpatentable. Paper 41 (“Reh’g Req.” or “Request for Rehearing”). For the reasons that follow, we deny Globberide’s Request for Rehearing.

B. STANDARD FOR RECONSIDERATION

The party filing a request for rehearing of a final written decision has the burden of showing a decision should be modified, and the 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 in its papers. 37 C.F.R. § 42.71(d). Therefore, Globberide bears the burden of establishing that we misapprehended or overlooked the matters that it requests that we review.

II. ANALYSIS

Globberide argues that we: (1) misapprehended its argument against obviousness in light of “controlling legal authority” and overlooked supporting expert testimony relating to impermissibly substantial “hindsight reconstruction” of features taught by the prior art to conclude that the claims covered obvious subject matter (Reh’g Req. 2–11); and (2) overlooked evidence that differences in the functionality of seal 104 of JP212 and seal 125 of JP042 that weigh against our finding that the claims covered obvious subject matter (*id.* at 11–13). We address each argument below.

A. ALLEGED HINDSIGHT RECONSTRUCTION

At the oral hearing, Globberide cited two cases, which it asserts to stand for the proposition that “when a proposed combination of prior art elements requires substantial reconstruction and redesign of those elements, then it would not be obvious to one of ordinary skill in the art to make that combination.” *Id.* at 3 (citing *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959);

Plas-Pak Indus., Inc. v. Sulzer Mixpac AG, APPEAL 2013-007786, 2014 WL 203101, at *6 (PTAB Jan. 17, 2014), *aff'd*, *Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 Fed.Appx. 755 (Fed. Cir. Jan. 27, 2015)). Globberide does not analyze, now or during the trial, either case in any detail or demonstrate how, if at all, either case parallels the facts of the case before us. Instead, Globberide asserts that the “essential take-away from these two cases is that there is a point at which the amount of modification and redesign required to make a particular combination of known elements is so substantial that the combination is not obvious.” *Id.* Yet, Globberide fails to establish precisely what “amount of modification and redesign” is the “point” at which a combination of known elements is not obvious. Instead, Globberide recounts its prior argument that the testimony it elicited from Dr. Springer in which he described how a skilled artisan would have known to modify seal 104 of JP212 in view of the description of magnetic seal 125 of JP042 to arrive at the invention of the claims at issue. *Id.* at 3–9 (citing Ex. 2050, 117:10–20, 137:1–16, 146:22–147:1, 155:11–21, 157:24–158:4, 159:8–23, 178:12–180:4, 186:2–17, 188:9–23).

We did not overlook or misapprehend Globberide’s argument and evidence. Rather, we found it, and continue to find it, to be unpersuasive. Both experts agree that a person of ordinary skill in the art at the time of the invention “would have held a bachelor’s degree in mechanical engineering or a closely related discipline, and one to two years of practical, academic, or industrial experience in studying, designing, or building mechanical gears, including, for example, those in fishing reels.” Ex. 1003 ¶ 14; Ex. 2043 ¶ 35. The testimony of Dr. Springer cited by Globberide, although detailed and extensive, demonstrates that such an ordinarily skilled artisan

easily would have been able to modify a seal 104 of JP212 in light of JP042's teaching that magnetic seals were superior to conventional seals to arrive at the invention of claims 1, 2, 6–9, and 12. *See, e.g.*, Ex. 2050, 122:18–21 (describing seal replaced in JP212 as a “simple device”), 157:19–23 (describing modifications as “slight”), 159:12–16 (describing modifications as “inexpensive and simple”), 173:8–174:1 (describing changes as “in a mechanical engineer’s toolbox” and commenting that “there is nothing particularly special about mounting this seal in this reel.”).

Based on our review of Dr. Springer’s testimony, we determine it establishes the ease with which an ordinarily skilled artisan could have incorporated specific structures taught in either JP042 (the magnetic seal) or JP974 (a cap-shaped cover body) into the specific spinning reel described in JP212. It is not surprising that for a mechanical device as complex as a fishing reel, numerous minor adjustments within the level of ordinary skill would be required to accomplish such incorporation. Nevertheless, our review of that detailed testimony reveals that none of the changes was beyond the skill level of a mechanical engineer with two years of practical experience designing fishing reels.

B. ALLEGED DIFFERENCES IN THE FUNCTIONALITY OF SEAL 104 OF JP212 AND SEAL 125 OF JP042

Globeride argues that we overlooked the different functions of JP212’s seal 104 as compared to JP042’s seal 125 when determining whether the claims were obvious. Reh’g Req. 11–13. More specifically, Globeride contends that we overlooked that

the function of seal 125 of JP042, which is disposed on the spool side of the rotor in JP042, is to seal the bearing 135 and the axial gap between the pinion shaft and spool shaft. **In contrast**, the function of seal 104 of JP212 is to seal the one way clutch, a

component which is located not only within the front portion of the reel body, outside of both the pinion shaft and spool shaft, but also on the handle side (rather than the spool side) of the rotor.

Id. at 11–12. Globetide argues “the seals do not serve the same function and are therefore not interchangeable.” *Id.* at 12; PO Resp. 45–46. Globetide cites no evidence to support its argument that the two seals performed functions that were materially different. Rather, Globetide contends that an “inference of nonobviousness is especially strong where the prior art’s teachings undermine the very reason being proffered as to why a person of ordinary skill would have combined the known elements.” *Id.* at 12–13 (citing *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1326 (Fed. Cir. 2009)). Globetide offers no analysis of *Depuy* or explanation for why the quoted sentence from that decision demands a conclusion of non-obviousness.

Seal 104 of JP212 and seal 125 of JP042 both operate to seal a shaft that rotates within a housing. We do not see how it is material that one seal is located on the “spool side” and the other is located on the “handle side” of the rotor, nor does Globetide point us to evidence in the record that we overlooked on this point. Both seals prevent intrusion of water along the axis of the shaft. Globetide’s argument was and remains unpersuasive.

III. ORDER

For the reasons given, it is

ORDERED that Globetide’s Request for Rehearing is *denied*.

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