

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CERAMTEC GMBH,
Petitioner,

v.

CERAMEDIC LLC,
Patent Owner.

IPR2015-00398
Patent 6,066,584

Before GRACE KARAFFA OBERMANN, KRISTINA M. KALAN, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

DECISION
Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Patent Owner CeraMedic LLC (“Patent Owner”) filed a Request for Rehearing (Paper 13, “Req.”). In rendering the Decision to Institute (Paper 11, “Dec.”), we instituted an *inter partes* review as to claims 1–5, 7–13, 15–17, 19–21, 23, 30–38, 52, and 53 of U.S. Patent No. 6,066,584 (Ex. 1001, “the ’584 patent”). In its Request for Rehearing, Patent Owner contends that the Board should reverse its Decision to Institute in part and deny institution of Grounds 4, 8, and 13. Req. 2.

For the reasons set forth below, Patent Owner’s request for rehearing is *denied*.

II. ANALYSIS

A request for rehearing must identify specifically all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d). The Board applies an abuse of discretion standard in reviewing institution decisions. 37 C.F.R. § 42.71(c).

In its Request for Rehearing, Patent Owner contends that (a) its Preliminary Response showed that the Board should have denied institution on the redundant grounds (Req. 4–6); (b) the Board’s Institution Decision overlooked Patent Owner’s redundancy arguments and Petitioner’s failure to carry its burden of proving that its grounds are not redundant (Req. 6–8); and (c) the Board abused its discretion in instituting trial on the redundant grounds (Req. 8–9). We disagree.

Our governing statute requires the Director of the Patent and Trademark Office to “prescribe regulations . . . setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a),”

and requires the Director to “consider the effect of any such regulation on . . . the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.” 35 U.S.C.

§ 316(a)(2), (b). In view of the considerations listed in 35 U.S.C. § 316(b), the Director prescribed 37 C.F.R. § 42.108, which provides the following instruction: (1) “the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim,” and (2) “the Board may deny some or all grounds of unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(a), (b).

The concept of redundancy is a tool used by the Board in determining whether to exercise its discretion to institute on or deny some or all grounds set forth in the Petition. The proper focus of a redundancy designation is on whether Petitioner articulates a meaningful distinction in terms of relative strengths and weaknesses with respect to the application of the prior art disclosures to one or more claim limitations. *Liberty Mutual Ins. Co. v. Progressive Casualty Inc. Co.*, Case CBM2012-00003 (Paper No. 7), at *2 (PTAB Oct. 25, 2012). The Board, however, has broad discretion as to whether to apply redundancy principles. The concept is not a tool that bestows on Patent Owner any substantive right to a denial of institution on allegedly redundant grounds.

Based on the analysis set forth in the Petition, we instituted trial on certain grounds based on the record before us at that time. As we noted in our Decision to Institute, “[a]part from Patent Owner’s claim construction arguments, which we have not adopted at this stage of the proceeding, the Preliminary Response does not address the substance of the prior art.”

Dec. 9. We analyzed the evidence and the arguments articulated by Petitioner for Grounds 4, 8, and 13, and found them to meet the standard required for institution of an *inter partes* review. It is a matter of discretion to proceed or not to proceed with any ground, and we exercised that discretion without abuse.

For the forgoing reasons, Patent Owner has not shown that the Board misapprehended or overlooked any matter in instituting trial in this proceeding.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request for rehearing is *denied*.

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