

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JACKEL INTERNATIONAL LIMITED and
MAYBORN USA, INC.,
Petitioners,

v.

ADMAR INTERNATIONAL, INC.,
Patent Owner.

Case IPR2015-00979
Patent 8,695,841 B2

Before MICHAEL W. KIM, HYUN J. JUNG, and NEIL T. POWELL,
Administrative Patent Judges.

JUNG, *Administrative Patent Judge.*

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Jackel International Limited and Mayborn USA, Inc. (“Petitioners”) request rehearing of our decision instituting an *inter partes* review (Paper 7, “Dec.”) of claims 1, 2–5, 7–9, 12, and 14 of U.S. Patent No. 8,695,841 B2 (Ex. 1001, “the ’841 patent”). Paper 9 (“Reh’g Req.”). In particular, Petitioners request rehearing of our determination not to institute review of dependent claims 6 and 13. Reh’g Req. 1.

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, Petitioners’ request is *denied*.

II. DISCUSSION

We instituted *inter partes* review of claims 1, 2, 5, 7–9, 12, and 14 as unpatentable over Raymond¹ and Mutti² and claims 3, 4, 10, and 11 as unpatentable over Raymond, Mutti, and Belanger³. Dec. 22. We did not institute review of claims 6 and 13 as unpatentable over Raymond and Mutti

¹ U.S. Patent No. 5,747,083 to Raymond, issued May 5, 1998 (Ex. 1003).

² FR 1,191,181 to Mutti, issued October 16, 1959 (Ex. 1004).

³ U.S. Patent No. 5,079,013 to Belanger, issued January 7, 1992 (Ex. 1005).

and claims 1–14 as unpatentable over Mutti, Kano⁴, and Suffa⁵. *Id.* at 17, 20–21. Petitioners request rehearing of the part of our Decision regarding claims 6 and 13. Reh’g Req. 1.

Petitioners contend that the Board misapprehended arguments regarding “cap” and “valve holder” for claims 6 and 13. Reh’g Req. 1–5 (citing Pet. 17–19, 28). Petitioners explain that the Petition asserted clamping ring 27, body 16, nipple pieces 15, and upper membrane 7 combined are the required “cap” of claim 1. *Id.* at 2–4 (discussing Pet. 17–19). Petitioners also explain that the Petition asserted clamping ring 27 meets the “valve holder” of dependent claims 6 and 13 “because the cap in Raymond is much more than clamping ring 27” and clamping ring 27 “is separable from the other parts of the claimed ‘cap.’” *Id.* at 5 (discussing Pet. 28). Petitioners further argue that the claims, specification, and case law do not require the recited valve holder and cap to be separate structures. *Id.* at 6–7, 12–13 (citing Ex. 1001, 6:38–41; Ex. 1013; Dec. 16).

Pages 17–19 of the Petition provide an argument that clamping ring 27 is part of the cap of claims 1 and 8 and page 28 contains an argument that clamping ring 27 discloses the valve holder of claims 6 and 13. However, after considering the arguments presented in the Petition and the Preliminary Response, we determined that “the claims require a separate cap and valve holder.” Dec. 16. The Petition did not propose an interpretation of “cap,” “valve holder,” or some other relevant claim term to support a contrary determination. *See* Pet. 12–14; Dec. 6–10. Petitioners, therefore,

⁴ U.S. Patent No. 4,785,978 to Kano, issued November 22, 1988 (Ex. 1006).

⁵ DE 195 10 007 to Suffa, published October 5, 1995 (Ex. 1007).

do not persuade us to modify our decision regarding the challenge of claims 6 and 13 as unpatentable over Raymond and Mutti.

Petitioners also assert that Patent Owner’s position regarding the term “valve holder” in the present proceeding and the related district court case are inconsistent. Reh’g Req. 8–12. Petitioners note that Patent Owner should be prevented from advocating such inconsistent positions under the doctrine of judicial estoppel, and that Petitioner could not have made these assertions earlier because judicial estoppel did not apply to Patent Owner concerning these positions until the district court’s claim construction order was issued, which occurred after the filing of the Petition. *Id.* at 8, n.3. As an initial matter, this argument is misplaced because, by its own terms, it does not demonstrate an abuse of discretion or a misapprehended or overlooked matter in the Petition or Preliminary Response, because judicial estoppel was not raised in any of those papers. Moreover, even when we consider Patent Owner’s allegedly inconsistent statements, we are unpersuaded that it materially affects the substantive analysis in the Decision, which was guided by Patent Owner assertions, but nevertheless based on evidence.

Petitioners further assert that the challenge of claims 6 and 13 based on Mutti, Kano, and Suffa was also misapprehended and should have been instituted. Reh’g Req. 2, 14–15. Petitioners acknowledge that they rely on Figure 6 for claim 1 and rely on Figures 1–5, which depict another embodiment, for claim 6 which depends from claim 1. *Id.* Petitioners, however, argue that the “motivation to combine the teachings of Mutti in one embodiment with the teachings of Mutti in another embodiment is entirely obvious—it’s the same reference.” *Id.* at 15.

Petitioners do not identify where the asserted motivation was presented in their Petition. *See* 37 C.F.R. § 42.71(d). Even if the Petition included this particular motivation, it does not address the deficiency identified in the Decision. Citing to two embodiments in the same reference does not explain “how and why stop ring 23 of Figure 1 . . . , which holds membrane 22 in position . . . , would be combined with outer part 14b of Figure 6 . . . , which includes inner part/body 14a . . . that also holds membrane 22 in place In other words, inner part/body 14a, which is an integral part of outer part 14b, already holds membrane 22 in place.”

Dec. 21. The Petition does not explain why one of ordinary skill in the art would be motivated to add stop ring 23 of Figure 1 to outer part 14b of Figure 6, when Mutti teaches each can hold a membrane in place. In particular, the Petition does not explain why both would be required when Mutti teaches that one is adequate. Without such an explanation in the Petition, we are not persuaded to modify our Decision regarding claims 6 and 13 as rendered obvious by Mutti, Kano, and Suffa.

III. CONCLUSION

For the reasons discussed above, Petitioners’ Request for Rehearing is *denied*.

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