

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MITSUBISHI CABLE INDUSTRIES, LTD. and
MITSUBISHI CABLE AMERICA, INC.,
Petitioners,

v.

GOTO DENSHI CO., LTD.,
Patent Owner.

Case IPR2015-01108
Patent 7,238,888 B2

Before JAMESON LEE, JAMES B. ARPIN, and SCOTT C. MOORE,
Administrative Patent Judges.

MOORE, *Administrative Patent Judge.*

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

I. INTRODUCTION

Patent Owner, Goto Denshi Co., Ltd., filed a Request for Rehearing (Paper 21; “Req. Reh’g”) of the Board’s Final Written Decision (Paper 20; “Final Dec.”) determining claims 1–8 of U.S. Patent No. 7,238,888 (the “’888 Patent”) to be unpatentable.

Patent Owner points to two alleged defects in our Final Written Decision. First, Patent Owner argues that we misinterpreted the applied prior art references by determining that the terms “R” and “R-Part” refer to the radius of curvature of an arc. Req. Reh’g. 1. Patent Owner argues that the term “R Part” in those references refers to the “rounded” part of a wire, and not a radius. *Id.* at 1–2. Second, Patent Owner argues that we overlooked and/or misapprehended evidence that one skilled in the art would not have been motivated to combine the Sugita and MWS Wire references. *Id.* at 2. Patent Owner argues that, in our Final Written Decision, we improperly relied on hindsight in concluding that one of ordinary skill would have had reason to combine the teachings of Sugita and MWS Wire to achieve the apparatus recited in the challenged claims. *Id.* at 2–3.

For the reasons that follow, we *deny* Patent Owner’s Request for Rehearing.

II. ANALYSIS

A. *Legal Standard*

The applicable requirements for a request for rehearing are set forth in 37 C.F.R. § 42.71(d), which provides:

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, opposition, or a reply.

B. Patent Owner's "R Part" Argument

In our Final Written Decision, we determined that the terms "R" and "R part" in the Sugita and Harada references refer, respectively, to a radius, and to an arc-shaped corner having a radius R. Final Dec. 15, 20–21. In reaching these determinations, we credited Dr. Klopp's testimony that the term "R" in Sugita "must mean radius based on the Sugita disclosures." *Id.* (citing Ex. 1006 ¶¶ 95, 143–144). We similarly credited Dr. Klopp's testimony that the phrase "R parts of the corner portions" in Harada refers to arc-shaped corners with a radius R. *Id.* at 21 (citing Ex. 1006 ¶¶ 142–146). We also noted that Patent Owner, which chose not to submit testimony in support of its arguments, failed to offer any persuasive evidence that these terms would have been ambiguous to a person of ordinary skill in the art. Final Dec. 15, 21. We further noted that the '888 Patent itself uses the terms "R" and "radius" synonymously, and also uses the phrase "R part" to refer to an arc-shaped chamfer. *Id.* at 15 (citing Ex. 1001, 1:35–39, 4:26–30), 21.

Patent Owner now argues that the terms "R" and "R part" refer to "rounded," rather than a radius. Req. Reh'g. 5–6. But Patent Owner's Request for Rehearing does not identify where, in the Patent Owner Response, Patent Owner argued that "R" and "R part" just mean generally rounded, and are not associated with a specific radius. A rehearing request must identify "the place where each matter [that was allegedly misapprehended or overlooked] was previously addressed in a motion,

opposition, or reply.” 37 C.F.R. § 42.71(d). We have found no such argument made by the Patent Owner prior to issuance of the Final Written Decision, and Petitioner did not have opportunity to respond to this argument in its Reply. Patent Owner failed to raise timely this specific argument, even though our Scheduling Order makes clear that “any arguments for patentability not raised in the [Patent Owner] response will be deemed waived.” Paper 9, 3. We could not have misapprehended or overlooked a specific argument that Patent Owner did not make.

Moreover, assuming that Patent Owner did not waive the generally “rounded” argument, the new argument still is unpersuasive even without a response from Petitioner. As discussed above, Dr. Klopp testified that a skilled artisan would have understood that the terms “R” and “R part” in Sugita and Harada necessarily refer, respectively, to a radius, and to an arc-shaped chamfer having a radius R. See Paper 19, 35:8–23. Patent Owner’s Request for Rehearing does not cite any expert testimony indicating that “R” and “R part” mean only generally “rounded” to one with ordinary skill in the art, and are not associated with a specific radius. Instead, Patent Owner relies on attorney argument. See Req. Reh’g 4–6. Argument of counsel, however, cannot take the place of evidence lacking in the record. *Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997); *Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977); *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Patent Owner also misconstrues Dr. Klopp’s testimony that certain of his calculations are “independent of whether the corners are rounded or linear.” See Rep. Reh’g 6–7. As is apparent from Dr. Klopp’s Declaration, this testimony describes a specific calculation that Dr. Klopp performed in

order to determine that Harada's wire satisfies the dimensions required by claim 1. Ex. 1006 ¶¶ 136, 138. Claim 1 does not require an arc-shaped chamfer having a given radius, and this testimony has no relevance to this separate issue of whether Harada discloses such arc-shaped chamfers. See Ex. 1006 ¶¶ 140–146.

C. Patent Owner's Obviousness Argument

Patent Owner asserts that our Final Written Decision improperly raises a new ground of unpatentability by asserting that “we have found that MWS Wire by itself discloses all the limitations of claims 1–8.” Req. Reh'g 7 (quoting Final Dec. 25). But, as is apparent from our Final Written Decision, this reference to MWS Wire is a typographical error; the quoted text refers to Sugita, not MWS Wire.¹

Patent Owner argues that we erred in finding that a skilled artisan would have had reason to combine the teachings of Sugita and MWS Wire. In our Final Written Decision, we found as follows:

Here, Petitioner has pointed to both interrelated teachings and market demands that would have motivated a person of ordinary skill to combine the teachings of Sugita and MWS Wire. Sugita discloses a die capable of drawing a wire into a deformed wire. Ex. 1002, Abstract. Petitioner has offered testimony from Dr. Klopp that Sugita and MWS Wire both relate to the same field of technology (i.e., wires that are intended “for use in a coil”) and describe similar types of wires (i.e., “square shaped wire[s] with arc-shaped corners”). Ex. 1006 ¶¶ 205–207. Petitioner also has offered testimony that a person of ordinary skill in the art would have realized that Sugita's die could be used to manufacture wires having the dimensions described in MWS

¹ A separate erratum paper correcting this typographical error is entered concurrently with this decision.

Wire. Pet. 52–53; Ex. 1006 ¶¶ 205–208. *In addition, Petitioner has offered evidence that market demand would have motivated a person of ordinary skill in the art to use Sugita’s die to manufacture wires having the specific dimensions set forth in MWS Wire because MWS Wire teaches that these dimensions result in wires that provide “more power in less space” when used to form coils. See Pet. 52–53; Ex. 1006 ¶ 206; Ex. 1011, 1. We credit Dr. Klopp’s testimony and find, on this record, that Petitioner has articulated reasoning having a rational underpinning to support the legal conclusion of obviousness. [KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007)].*

Final Dec. 26–27 (emphasis added). Patent Owner now argues that the wires disclosed in MWS Wire would not have delivered more power in less space. Req. Reh’g 8. But Patent Owner once again fails to identify where in the papers it previously raised this argument, as required by our rules. See 37 C.F.R. § 42.71(d). Patent Owner did not make this argument in its Patent Owner Response, and, thus, has waived it. Paper 9, 3. We could not have overlooked or misapprehended an argument that Patent Owner failed to raise in the papers. ²

III. CONCLUSION

Having considered the evidence and arguments presented by Patent Owner in its Request for Rehearing, and in light of the erratum being issued concurrently with this decision, we determine Patent Owner has not

² Patent Owner also argues that we relied on improper hindsight in our Final Written Decision. See Reh’g Req. 2–3. This argument is conclusory and does not identify, and is not based on, evidence or argument presented during the proceeding that we allegedly either overlooked or misapprehended. Hence, this argument is not the proper subject for a Request for Rehearing.

identified any matter that we misapprehended or overlooked in rendering our Final Written Decision. Accordingly, Patent Owner's Request for Rehearing is *denied*.

IV. ORDER

For the foregoing reasons, it is ORDERED that Patent Owner's Request for Rehearing is *denied*.

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