

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP-ON INC.,
Petitioner,

v.

MILWAUKEE ELECTRIC TOOL CORPORATION,
Patent Owner.

Case IPR2015-01244
Patent 7,999,510 B2

Before GRACE KARAFFA OBERMANN, PATRICK R. SCANLON, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

On December 16, 2015, Petitioner filed a request for rehearing (Paper 11, “Rehearing Req.”) of our decision (Paper 9, “Dec.”) instituting an *inter partes* review of claims 1–6 and 8–19 of U.S. Patent No. 7,999,510 B2 (Ex. 1005, “the ’510 patent”). We instituted trial solely on the ground of obviousness over Fohr,¹ Sato,² and Hallaj.³ Petitioner argues that we erred by declining to set for trial also a separate ground based on anticipation of claims 1–19 by Johnson.⁴ Rehearing Req. 1.

Our decision was based on the information presented in the Petition (Paper 2, “Pet.”) and Preliminary Response (Paper 8, “Resp.”). Dec. 15. We *deny* the request because it does not direct us to argument or evidence of record that establishes an error justifying a modification of our decision.

ANALYSIS

We review our decision for an abuse of discretion. 37 C.F.R. § 42.71(c). Petitioner bears the burden of showing that the decision should be modified, by specifically identifying all matters Petitioner “believes the Board misapprehended or overlooked.” *Id.* at § 42.71(d). The central argument presented in the rehearing request is that the Board misapprehended or overlooked the broadest reasonable interpretation of the average discharge current limitation, which appears in each of the independent claims of the ’510 patent. Ex. 1005, claims 1, 9, 10, 12, 14–16,

¹ European Patent Publication No. EP 1 266 725 A1, published Dec. 18, 2002 (certified English translation) (“Fohr”) (Ex. 1014).

² Japanese Publication No. JP 2002-110254 A, published April 12, 2002 (certified English translation) (“Sato”) (Ex. 1011).

³ U.S. Patent No. 6,468,689 B1, issued Oct. 22, 2002 (“Hallaj”) (Ex. 1015).

⁴ U.S. Publication No. 2004/0257038 A1, published Dec. 23, 2004 (“Johnson”) (Ex. 1016).

and 18. Claim 1 is illustrative, and we highlight the average discharge current limitation below:

1. A battery pack for powering a hand held power tool,
the battery pack comprising:

a housing connectable to and supportable by the hand held
power tool; and

a plurality of battery cells supported by the housing, *the
battery cells being capable of producing an average discharge
current greater than or equal to approximately 20 amps*, the
battery cells having a lithium-based chemistry, the battery cells
having a combined nominal voltage of at least approximately 18
volts.

Ex. 1005, 12:2–11 (emphasis added).

Under the broadest reasonable interpretation, claims are given their ordinary and customary meaning, as would be understood by a person of ordinary skill in the art in the context of the entire disclosure of the patent. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Each argument presented in the request for rehearing depends upon a contention that the broadest reasonable interpretation of the average discharge current limitation includes “currents approaching infinity.” Rehearing Req. 10. We did not overlook or misapprehend that contention. Dec. 13 (treating Petitioner’s view that claim 1 recites “an open-ended average battery pack discharge current range from 20 amps up to infinity”) (quoting Pet. 20). We considered and rejected it based on the information presented. *Id.* at 13–16.

Our reviewing court has instructed us not to “construe claims during IPR so broadly that [our] constructions are *unreasonable* under general claim construction principles.” *Microsoft Corp. v. Proxconn, Inc.*, 789 F.3d

1292, 1298 (Fed. Cir. 2015) (emphasis in original). “[T]he protocol of giving claims their broadest reasonable interpretation . . . does not include giving claims a legally incorrect interpretation.” *Id* (citations omitted). In that regard, “claims should always be read in light of the specification and teachings in the underlying patent.” *Id.* (citation omitted).

The specification of the ’510 patent “describes battery pack configurations that ‘can supply power to various power tools, such as a driver drill, a circular saw, and the like . . . having high discharge currents,’ including a battery pack that ‘can supply an average discharge current that is equal to or greater than approximately 20 [amps].” Dec. 14 (quoting Ex. 1005, 10:19–31 (internal numbering omitted)). In the Petition, we were not directed to evidence adequate to show that a skilled artisan would have understood the discharge amp limitation to embrace “currents approaching infinity.” Rehearing Req. 10; *see* 37 C.F.R. § 42.104(b)(5) (a petition must “identify specific portions of the evidence that support the challenge”).

In the single paragraph devoted to the construction of the discharge current limitation, the Petition states that, “under the broadest-reasonable-interpretation standard, a person of ordinary skill may find that the [average discharge current limitation] is satisfied by battery cells capable of producing an average battery pack discharge current greater than or reasonably close to 20 amps when used with a hand held power tool for some application over a time period consistent with the intended use of the tool.” Pet. 16–17. On this record, a construction of claim 1 that includes “currents approaching infinity,” while broad, is not reasonable in light of the specification. Rehearing Req. 10.

For reasons set forth in our decision, the average discharge current limitation of claim 1 is not analogous to the claim limitation at issue in the *Magsil* case, where for factual reasons specific to that case, a limitation was expressly construed by a district court to include “resistance changes beyond 120% and up to infinity.” Dec. 13–15 (citing *Magsil Corp. v. Hitachi Global Storage Tech., Inc.*, 687 F.3d 1377, 1381 (Fed. Cir. 2012) (citation to district court decision omitted); see Rehearing Req. 4–6 (reasserting arguments based on the *Magsil* decision). As explained in our decision, by contrast, “we have not construed claim 1 to cover a discharge current ‘up to infinity.’” Dec. 14 (quoting Pet. 20). Even under the broadest reasonable interpretation, the Board’s construction “cannot be divorced from the specification and the record evidence,” *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed.Cir.2011), and “must be consistent with the one that those skilled in the art would reach,” *In re Cortright*, 165 F.3d 1353, 1358 (Fed.Cir.1999).

We have considered Petitioner’s remaining arguments and find them to be without merit. For example, Petitioner continues to pursue an “undue experimentation” argument (Rehearing Req. 6–8) based on the contention that the average discharge current limitation includes “currents approaching infinity.” Rehearing Req. 10. As we observed in our decision, however, Petitioner’s argument and evidence of undue experimentation is not keyed to “the properly-construed claims of the ’510 patent.” Dec. 14 (citing Pet. 19–22 (presenting undue experimentation argument in the context of Petitioner’s unreasonably broad interpretation of the average discharge current limitation)).

Petitioner’s request for rehearing does not persuade us of error justifying a modification of the decision. Accordingly, we *deny* that request.

CONCLUSION

We *deny* Petitioner's request for rehearing.

ORDER

It is

ORDERED that Petitioner's request for rehearing is *denied*.

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