

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEYER PRODUCTS, LLC,
Petitioner,

v.

DOUGLAS DYNAMICS, L.L.C.,
Patent Owner.

Case IPR2015-01247
Patent 6,928,757 B2

Before MICHAEL W. KIM, JAMES A. TARTAL, and
JAMES A. WORTH, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Meyer Products LLC ("Petitioner"), filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1, 4–7, and 18 of U.S. Patent 6,928,757 ("the '757 patent," Ex. 1001) based on seven asserted grounds of unpatentability. Patent Owner, Douglas Dynamics, L.L.C. ("Patent Owner"), filed a Preliminary Response (Paper 5, "Prelim. Resp.").

On December 19, 2015, we instituted an *inter partes* review of all claims against which unpatentability was asserted, but only on certain of the grounds. Paper 8 (“Decision”).

On December 28, 2015, Petitioner filed a Request for Rehearing Under 37 C.F.R. § 42.71(d) (Paper 10, “Rehearing Request” or “Request”), seeking reconsideration of the denial of institution of certain grounds of unpatentability asserted in the Petition. For the reasons stated below, Petitioner’s Rehearing Request is denied.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. BACKGROUND

Petitioner requested an *inter partes* review on the following grounds:

References	Basis	Claims challenged
Pruss ¹	§ 102	1, 4–7, and 18

¹ Pruss, U.S. Patent No. 2,139,625, iss. Dec. 6, 1938 (Ex. 1002).

References	Basis	Claims challenged
Keeler ²	§ 102	6 and 18
Pruss and Kost ³	§ 103	1, 4–7, and 18
Pruss and Watson ⁴	§ 103	1, 4–7, and 18
Coates ⁵ and Hetrick ⁶	§ 103	1, 4–7, and 18
Coates and Kost	§ 103	1, 4–7, and 18
Coates and Watson	§ 103	1, 4–7, and 18

As set forth in the Decision, and for the reasons stated therein, we instituted a review as to the following grounds asserted in the Petition:

References	Basis	Claims challenged
Pruss	§ 102	18
Keeler	§ 102	18
Coates and Hetrick	§ 103	1, 4–7, and 18

² Keeler, U.S. Patent No. 2,242,472, iss. May 20, 1941 (Ex. 1003).

³ Kost, U.S. Patent No. 6,354,024 B1, iss. Mar. 12, 2002 (Ex. 1004).

⁴ Watson, U.S. Patent No. 5,125,174, iss. June 30, 1992 (Ex. 1006).

⁵ Coates, U.S. Patent No. 3,605,906, iss. Sept. 20, 1971 (Ex. 1005).

⁶ Hetrick, U.S. Patent No. 4,236,329, iss. Dec. 2, 1980 (Ex. 1007).

IV. REHEARING REQUEST

Petitioner contends that in the Decision we misapprehended or overlooked the following matters:

- (a) the construction of the claim term “A-frame” and anticipation by Pruss of claims 1 and 4–7 based thereon;
- (b) obviousness based on the combination of Pruss and Kost;
- (c) obviousness based on the combination of Pruss and Watson;
- (d) obviousness based on the combination of Coates and Kost; and
- (e) obviousness based on the combination of Coates and Watson.

Request 2–14. We address each contention below.

A. The construction of the claim term “A-frame” and anticipation of claims 1 and 4–7 by Pruss

Petitioner argues that, in construing “A-frame” as “a frame with a back bar and a pair of side bars arranged in a triangular or ‘A’ configuration,” the Board misapprehended or overlooked the fact that the Specification of the ’757 patent does not define the term “A-frame,” that the Specification states that the patent is “limited . . . by the scope of the following claims and their equivalents,” and that the Specification also uses the term “frame” without the prefix “A-” or uses the term preceded by “mount,” “lift,” or “A-”. Request 3–6. Petitioner argues that this misapprehension causes the Board’s construction to be divorced from the Specification and the record evidence. Request 6 (*Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015)).

As an initial matter, we note that Petitioner only cited to two portions of the Specification in the Petition in supporting its construction of “A-frame”: Ex. 1001, 4:62–64, 8:36–40. Pet. 8–9. Accordingly, we restrict

ourselves to reconsideration of only this portion of the Specification. And upon reconsideration, we determine that the Board did not misapprehend or overlook the aforementioned cited portions of the Specification in construing “A-frame”; instead, the Board considered those portions expressly, but came to a different conclusion.

Specifically, as set forth in the Decision, the fact that other shapes may be referred to in the Specification does not broaden the “A” shape of the “A-frame,” as recited in claims 1 and 4–7. The Decision notes Patent Owner’s suggestion that other claims, not at issue, might still allow for use of the invention with another shape for the frame. Decision 7. Petitioner argues that these other claims do not refer to an “A-frame.” Request 6. We agree. This argument is misplaced, however, as the lack of specificity of shape for the corresponding frame in the other claims is fully consistent with the notion that these other frames use a non-A-frame shape. Therefore, we are not persuaded that the Decision misapprehended or overlooked any arguments with respect to the asserted ground of anticipation by Pruss.

B. Obviousness based on the combination of Pruss and Kost

Petitioner argues that the panel misapprehended or overlooked a passage based on certain alternatives which was presented in the Petition. Request 7–10. Specifically, Petitioner asserted that if Pruss does not anticipate claims 1, 4–7, and 18, then, in the alternative it would have been obvious over Pruss in combination with Kost, and more specifically, Pruss and the A-frame **and/or** the mounting frame of Kost. Request 8 (discussing Pet. 25–26).

Petitioner asserts that the Decision refers to a substitution of both the A-frame and the mounting frame (i.e., substituting both structures from Kost

for those of Pruss), and that the panel overlooked the possibility of substituting only the A-frame (from Kost for that of Pruss). Request 7–9. Petitioner further argues that the Petition intended for Kost only to remedy any deficiency in Pruss, and because the panel found Pruss to be lacking in an A-frame, the Petition was arguing for Kost to supply the A-frame, but not necessarily to substitute the mounting frame. *Id.* at 8–9.⁷

We disagree that the Board misapprehended or overlooked Petitioner’s assertion. To the contrary, in the panel’s analysis of this exact assertion, the Decision cites the Board rules which require specificity on the part of the Petition, 37 C.F.R. §§ 42.104(b)(4), (b)(5), and states explicitly that neither the Petition nor the Declarant explained sufficiently why a person of ordinary skill would have selected certain structures and not others. Decision 18–20. To the extent that the Petition and the Request for Rehearing reiterate their reliance on the principle of design choice, we are

⁷ The Petition states:

In the event, however, that it is determined:

(1) that Pruss does not disclose the claimed “A-frame” (because, for example, the Pruss frame is arguably not shaped precisely like the letter “A;” note, however, that DDI explicitly disclaims this limited interpretation; and/or,

(2) that Pruss does not disclose the claimed capability of “one assembly” or “single assembly” attachment and detachment (because, for example, the Pruss vehicle is arguably not “driven onto” the Pruss snowplow assembly), this section addresses alternative arguments that invalidate claims 1, 4–7 and 18 of the ‘757 patent as being obvious over Pruss in combination with US Patent No. 6,354,024 to Kost (“Kost”) or in combination with US Patent No. 5,125,174 to Watson (“Watson”).

Pet. 25–26 (internal footnotes omitted).

again unpersuaded that the Petition provides sufficient reasoning for the selection of certain structures, but not others. *See* Decision 18, 20 (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)).

C. Obviousness based on the combination of Pruss and Watson

Petitioner’s arguments with respect to the asserted ground based on Pruss and Watson are similar to those argued with respect to the ground based on the combination of Pruss and Kost. *Compare* Request 10–12, with *id.* at 7–9. We are not persuaded that the Decision misapprehended or overlooked any arguments in the Petition for similar reasons as for the asserted combination of Pruss and Kost.

D. Obviousness based on the combination of Coates and Kost

In denying the ground of obviousness based on Coates and Kost, the Decision states that the Petition does not adequately explain (1) the selection of structures in the asserted combination and (2) the rationale for the combination. Decision 26.⁸

With respect to the selection of structures in the asserted combination, the Request responds by referring back to the following statement in the Petition as having been misapprehended or overlooked by the Board: “It would have been obvious to a person of skill in the art at the time to modify Coates to use the ‘driven onto’ mounting device of Kost (one could, for

⁸ The Decision states that the Petition did not adequately explain the reasoning for the proposed combination for similar reasons as for the grounds based on the combination of Pruss with Kost or Watson. Decision 25–26. As above, the Decision refers to a lack of specificity in the combination and reasoning therefor, referring to 37 C.F.R. § 42.104(b)(4), § 42.104(b)(5); *KSR Int’l Co.*, 550 U.S. at 418. *See* Decision 18.

example, adjust plates 38 and 38' to be attachable to Kost's mount housing 500) in order to simplify attachment and detachment of the snowplow assembly to the vehicle." Pet. 45 (*cited in* Request 13). We are unpersuaded that this portion was misapprehended or overlooked.

"The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon." 37 C.F.R. § 42.104(b)(4). As applied here, the Petition must have specified which prior art structures are being relied on in the asserted ground such that "said lift frame, trunnion, A-frame and motion generating device all being attachable to and detachable from a vehicle as one assembly," as recited by claim 1 and similarly required by claims 4–7 and 18. The Petition did not.

As an initial matter, the claim charts included in the Petition refer to both Coates and Kost for the lift frame, the A-frame, the plow blade, and the motion generating device. Pet. 47–58.⁹ In this regard, the Petition does not specify whether it is contemplated that structures of Kost would also have been retained, other than mount housing 500.

To the extent that the Request focuses on the above passage from the argument of the Petition, i.e., to connect plates 38, 38' of Coates to mount housing 500 of Kost, the asserted ground still covers many permutations. We note that the Petition does not specify whether Coates' lift frame would still have been attached to the vehicle bumper or to frame member 16 with attachments 18, 19 as in Coates (Ex. 1005, Fig. 1, 2:31–39), or whether Petitioner is asserting that the only point of attachment for Coates'

⁹ The only recited element for which the claim charts solely rely on Coates is the trunnion of Coates, which is a structure that connects the plow blade of Coates to the other structures. *Id.* at 49, 56–57.

snowplow assembly would have been a direct connection between Coates' plate 38, 38' for purposes of attachment and detachment as a "single assembly." Further, the Petition does not explain whether it was contemplated that a person of ordinary skill would have retained stand 850 of Kost in order to facilitate attachment (Ex. 1004, Fig. 13, 21:23–25; *see also id.* at 15:16–31), and whether it was contemplated that additional structures of Kost would also have been substituted as well. Thus, we determined that the Petition failed to show a reasonable likelihood of prevailing on the ground because of the lack of specificity, and, even when considered anew, we are unpersuaded that such a determination was in error. *See* 37 C.F.R. § 42.104(b)(4).

With respect to the rationale for the asserted combination, the Request argues that the Board misapprehended or overlooked the following three rationales set forth in the Petition: "(a) in order to simplify attachment and detachment of the assembly; (b) eliminate the required step of connecting/disconnecting the chain between the lift frame and plow blade; and (c) to reduce the amount of extra weight carried by the vehicle when the plow is not installed." Request 13. Petitioner's arguments are misplaced, however, as the concern expressed by the Decision was not a lack of rationale for the use of a simple attachment, but rather that the Petition did not adequately articulate a rationale for the substitution of certain parts but not others. Decision 26. In sum, even after considering the above anew, we remain unpersuaded that the Petition adequately explains the aforementioned modification with sufficient particularity. *See* 37 C.F.R. § 42.104(b)(5).

E. Obviousness based on the combination of Coates and Watson

Petitioner argues for the asserted ground of obviousness over Coates and Watson based on similar assertions for that of obviousness over Coates and Kost. Request 12–14. Specifically, Petitioner argues that a person of ordinary skill in the art would have adjusted plates 38, 38' of Coates to attach to mounting frame 16 of Watson. *Id.* at 13 (citing Pet. 46). For similar reasons as for the asserted ground based on Coates and Kost, we are not persuaded that the Decision misapprehended or overlooked any arguments in the Petition with respect to the ground of unpatentability based on Coates and Watson.

V. CONCLUSION

We are not persuaded that the Decision overlooked or misapprehended any arguments presented in the Petition. Petitioner has not shown an erroneous conclusion of law, clearly erroneous factual findings, or a clear error of judgment in the Decision to show an abuse of discretion.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Request for Rehearing is *denied*.

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