

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRESIDIO COMPONENTS, INC.,
Petitioner,

v.

AVX CORPORATION,
Patent Owner.

Case IPR2015-01332
Patent 6,144,547

Before MITCHELL G. WEATHERLY, MATTHEW R. CLEMENTS, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

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

I. INTRODUCTION

Presidio Components, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–18 (“the challenged claims”) of U.S. Patent No. 6,144,547 (Ex. 1001, “the ’547 patent”). Paper 1 (“Pet.”). AVX Corporation (“Patent Owner”) filed a Preliminary Response. Paper 14 (“Prelim. Resp.”). Pursuant to 35 U.S.C. § 314, we instituted *inter partes* review with respect to claims 1–5 and 7–12 of the ’547 patent, but denied institution of *inter partes* review with respect to claims 6 and 13–18 of the ’547 patent. Paper 15 (“Dec.”), 41.

Pursuant to 37 C.F.R. § 42.71(d), Patent Owner filed a Request for Rehearing (Paper 17, “Req.”) seeking reconsideration of our determination that certain language in claim 1 constitutes a limiting preamble. Claim 1 recites, in relevant part:

1. A thin film capacitor device for mounting to a surface, said capacitor device comprising *a device body having small dimensions in length, width and height, and having substantially L-shaped terminations located thereon with portions of said terminations extending over a bottom surface of said device body and negligibly over a top surface of said device body*, said device body including:

Ex. 1001, cl. 1 (emphasis added). In our Decision, we referred to the italicized claim language as part of the preamble, and interpreted it as reciting claim limitations. Dec. 22. Patent Owner argues that “that the Board erred or overlooked the law concerning the structure of a claim and the delineation of a claim’s preamble” and, “[a]s a result, the Board reached an erroneous conclusion of law that essentially the entire first paragraph of claim 1 constitutes a preamble, even if limiting.” Req. 2. For the reasons set forth below, Petitioner’s Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). With this in mind, we address the arguments presented by Patent Owner.

III. ANALYSIS

Patent Owner argues that we “reached an erroneous conclusion of law when it concluded that the preamble of independent claim 1 encompasses essentially the entire first paragraph of the claim.” Req. 3. Patent Owner repeats the argument from its Preliminary Response that the use of the term “comprising” followed by recitation of structural elements suggests that only the claim language preceding “comprising” is the preamble. *Id.* at 4 (citing MPEP § 608.01(m) and *DePuy Orthopaedics, Inc. v. Androphy*, 53 USPQ2d 1941, 1954 n.3 (N.D. Ill. 2000)).

We considered these arguments presented in the Preliminary

Response, but we were not persuaded. *See* Dec. 21–22. Patent Owner’s reliance on a footnote in *DePuy Orthopaedics* is not persuasive because the method claim at issue there is not written in the same way as the device claim at issue here. Patent Owner’s arguments in this regard amount to a mere disagreement with our analysis or conclusion. But mere disagreement with our analysis or conclusion is not a sufficient basis for rehearing. It is not an abuse of discretion to provide analysis or conclusion with which Patent Owner disagrees.

Moreover, Patent Owner does not identify any way in which the scope of this proceeding would change substantively if we granted the Request for Rehearing. Whether we construe the language as a limiting preamble, as we have done (Dec. 21–22), or as part of the body of the claim, the prior art must disclose, teach, or suggest the elements recited in order for the claim to be found unpatentable.

For all of the foregoing reasons, we are not persuaded that our interpretation of the italicized language of claim 1 as reciting claim limitations was an abuse of discretion.

IV. ORDER

For the reasons given, it is

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

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