

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUNAI ELECTRIC CO., LTD., and SAMSUNG DISPLAY CO., LTD.,
Petitioner,

v.

GOLD CHARM LTD.,
Patent Owner.

Case IPR2015-01448
Patent 5,995,176

Before KARL D. EASTHOM, BRYAN F. MOORE, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Samsung Display Co., Ltd. and Funai Electric Co., Ltd. (collectively, “Petitioner”) filed a Request for Rehearing (Paper 14, “Req. Reh’g”) of the Decision Denying Institution of *Inter Partes* Review (Paper 13, “Dec.”) of claims 1 and 3–6 of U.S. Patent No. 5,995,176 (Ex. 1001, “the ’176 patent”). In the Request for Rehearing, Petitioner argues that the Decision misapprehended or overlooked several matters in the Petition. For the reasons set forth below, the Request for Rehearing is *denied*.

II. ANALYSIS

When considering a request for rehearing, we review the Decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing that the Decision should be modified, and “[t]he request must specifically identify all matters the party believes [we] misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

Petitioner states that “[t]he Board incorrectly reasoned that by referencing Figure 36 and Figure 52, Petitioners were improperly relying upon a combination of distinct and separate embodiments. Decision at 8. This is clear error.” Req. Reh’g 4. Petitioner states further that “[t]he Board’s Decision appears to have overlooked the fact that there are identically numbered elements in Figures 36 and 52 (e.g., pixel electrodes 24, thin film transistor 34, data bus line 30). The use of the same reference character conveys the fact that they are the same element/part (i.e., those elements are identical).” *Id.* (citing 37 C.F.R. 1.84(p)(4); *Ex Parte Cook*, 51 O.G. 1620, 1622 (DECISIONS OF THE COMMISSIONER OF PATENTS,

April 12, 1890)). It is correct that the Decision declined to combine the embodiments represented by Figures 36 and 52 stating,

[a]s our reviewing court's predecessor stated, for anticipation, the prior art reference "must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972).

Dec. at 9–10.

Although Petitioner is also correct that, in Koike, a generic pixel electrode is referred to with the reference numeral 24, the Decision found that the pixel electrode in Figure 36 is single unitary electrode, as is shown clearly in Figure 36, and the pixel electrode in Figure 52 is a combination of two sub-pixel electrodes. Dec. 8–9. The Decision found that Petitioner had not shown sufficient evidence in the record that the unitary electrode embodiment would be combined with the two sub-pixel electrode embodiment. Thus, the Decision did not overlook or misapprehend Petitioner's arguments or evidence. We fully considered Petitioner's position and determined that the evidence on which Petitioner relied was not persuasive in establishing that Figures 36 and 52 could be combined. A request for rehearing is not an opportunity merely to disagree with the panel's assessment of the arguments or weighing of the evidence. It is not an abuse of discretion to have performed an analysis or reached a conclusion with which Petitioner disagrees, and mere disagreement with the Board's analysis or conclusion is not a proper basis for rehearing. We are not

persuaded that this determination was an abuse of our discretion. Thus, we are not persuaded by this argument.

Petitioner also argues that “[t]he Board also erred in determining that an ‘opening’ can be the point of novelty upon which the ‘176 patent claims are distinguished over Koike.” Petitioner further argues “Petitioners specifically pointed out that the ‘alleged “advance” addressed in the challenged claims is the provision of a plurality of non-floating conductive light shields aligned with the openings, where a voltage is applied to the conductive light shield layer(s)’, not the ‘opening’ itself.” Req. Reh’g 5 (citing Pet. 9). Thus, according to Petitioner, the Decision misapprehended the fact that the missing element, the opening, was part of the admitted prior art.

Nevertheless, in the obviousness ground based on Koike and Yamamoto, the Petition does not state that Koike could be combined with the admitted prior art in the patent as would be required to prove obviousness. Nor does the Petition state a rationale for combining Koike or Yamamoto with the admitted prior art in the patent as also would be required to prove obviousness. *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000). Further, in its anticipation ground, the Petition does not state that the “opening” was within the knowledge of one of ordinary skill such that it could be combined with the disclosure of Koike for the purpose of anticipation. An argument that a particular limitation in a claim is a “point of novelty” does not relieve the Petitioner from showing each element of the claim is in the prior art and that the elements would have been combined with each other by one of ordinary

skill. *See Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (holding that “unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102”). Thus, we are not persuaded by this argument.

Petitioner argues that the Board misapprehended its ground based on obviousness over Koike and Yamamoto “based on the same clearly erroneous finding it had made with respect to Ground 1 [i.e., Koike alone].” Req. Reh’g 6. For the reasons stated above with respect to Koike, we are not persuaded by this argument.

Finally, Petitioner argues that “as pointed out in the Petition, with support from the Credelle Declaration, to the extent the openings in Yamamoto are not consistent with the interpretation of the ‘176 patent, it would have been obvious to combine the opening of Koike with Yamamoto. Petition at 42 (citing Credelle (Exh. 1008) at ¶102).” Req. Reh’g 7. Petitioner further argues “[t]he Board [] discounted or failed to appreciate this contrary evidence because it had already incorrectly found the Koike reference did not teach an ‘opening’ in deciding Ground 1.” *Id.* For the reasons stated above, we are not persuaded by this argument.

Nevertheless, the above argument by Petitioner is also incorrect.¹ The Decision did not “discount[] or fail[] to appreciate this contrary evidence,” rather the Decision discussed combining the opening of Koike with Yamamoto and determined ultimately that Petitioner had not shown sufficiently a rationale for that combination. Dec. 15–17. A request for rehearing is not an opportunity merely to disagree with the panel’s assessment of the arguments or weighing of the evidence. It is not an abuse of discretion to have performed an analysis or reached a conclusion with which Petitioner disagrees, and mere disagreement with the Board’s analysis or conclusion is not a proper basis for rehearing. Thus, we are not persuaded by this argument.

III. CONCLUSION

The Request for Rehearing does not demonstrate that the Decision misapprehended or overlooked any matters raised in the Petition.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Request for Rehearing is *denied*.

¹ Page 42 of the Petition does not discuss the “opening” limitation, nor does the Petition cite to paragraph 102 of the Credelle declaration for the proposition that “it would have been obvious to combine the opening of Koike with Yamamoto.” Rather the Petition cites to paragraphs 97–106 for the general proposition that “Claim 1 is rendered obvious by Yamamoto take[n] together with Koike.” Pet. 42.

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