

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

GOLD CHARM LIMITED,
Patent Owner.

Case IPR2015-01491
Patent 6,734,927 B2

Before MICHAEL R. ZECHER, BRYAN F. MOORE, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

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

I. INTRODUCTION

Funai Electric Co., Ltd., Samsung Display Co., Ltd., and Toshiba Corporation (collectively, “Petitioner”) filed a Request for Rehearing (Paper 17, “Req. Reh’g”), requesting rehearing of our determination not to institute *inter partes* review of claims 1–3 and 5–8 of U.S. Patent No. 6,734,927 B2 (“the ’927 patent,” Ex. 1001) under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,680,183 to Sasuga (Ex. 1007). For the reasons that follow, Petitioner’s Request for Rehearing is *denied*.

II. BACKGROUND

In its Petition (Paper 1, “Pet.”), Petitioner challenged the patentability of claims 1–10 of the ’927 patent on the following four grounds:

Reference(s)	Basis	Claims Challenged
Sasuga	35 U.S.C. § 102	1–3 and 5–8
Muramatsu ¹	35 U.S.C. § 102	7, 9, and 10
Hideaki ²	35 U.S.C. § 102	7 and 9
Sasuga alone, or considered together with Muramatsu and Ueda ³	35 U.S.C. § 103	1–10

Pet. 6–7. In an institution decision entered on December 28, 2015, we concluded that Petitioner established a reasonable likelihood that it would prevail in challenging the patentability of claims 7 and 9 of the ’927 patent as anticipated by each of Muramatsu and Hideaki, and we instituted *inter partes* review based on those references. Paper 15, 20–31 (“Dec. on Inst.”).

¹ U.S. Patent No. 5,703,665 (Ex. 1008).

² Japanese Laid-Open Patent Application No. H09-096800 (Ex. 1010 (certified English-language translation provided by Petitioner)).

³ U.S. Patent No. 5,739,887 (Ex. 1011).

Because Petitioner’s asserted ground based on anticipation by Sasuga raised substantially the same issues, based on the same prior art that the Office already considered and rejected during the original prosecution of the ’927 patent, we exercised our discretion under 35 U.S.C. § 325(d) to deny review based on that ground. *Id.* at 17–20. Petitioner now argues that we “overlooked or misapprehended an important point presented in the Petition regarding the construction of the terms ‘stepped protrusion’ and ‘stepped draw’ resulting in the erroneous conclusion that the Grounds based on Sasuga were the same as those already considered during prosecution.” Req. Reh’g 1 (footnote omitted). In particular, Petitioner contends, “the Board rejected the Examiner’s construction of those terms—that is, it rejected the basis for withdrawing the Examiner’s rejection based on Sasuga,” and “[t]hus, the Board’s conclusion that the ground is the same as already considered and rejected during the original prosecution of the ’927 patent is internally inconsistent with its claim construction and, as such, is not a proper basis for applying discretion under 35 U.S.C. § 325(d).” *Id.* at 1–2.

III. DISCUSSION

When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision [i]s 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). “The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). A request for rehearing is not an opportunity merely to disagree with the

panel’s assessment of the arguments or weighing of the evidence, or to present new arguments or 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 our analysis or conclusion is not a proper basis for rehearing.

We acknowledged in our institution decision that, during original prosecution of the application that issued as the ’927 patent, the Examiner rejected precursors to the claims that eventually issued as challenged claims 1 and 7 of the ’927 patent; the Applicant filed an Amendment in which it amended the pending claims, added the claims that issued as challenged dependent claims 2–6 and 8–10, and raised several arguments in traversal of that rejection, including, *inter alia*, that “[t]he stepped protrusion (draw) may have a shape (not hooked shaped, as in Sasuga)”; and the Examiner then issued a Notice of Allowance. Dec. on Inst. 13, 17–18 (citing Ex. 1005, 43–44 (Office Action mailed Aug. 11, 2003, at 2–3); *id.* at 28–30, 33–35 (Amendment dated Nov. 12, 2003, at 2–4, 7–9); Ex. 1006 (Notice of Allowance dated Dec. 24, 2003)).

Whereas Petitioner contends that “[t]he Examiner accepted Applicant’s argument regarding construction of the terms ‘stepped protrusion’ and ‘stepped draw,’ which limited the terms to ‘non-hook shaped’ parts” (Req. Reh’g 1), we disagree. The “shape” argument was only one of several arguments made by the Applicant in connection with its Amendment dated November 12, 2003, and Petitioner provides no persuasive evidence that the Examiner “accepted” that specific argument. Indeed, as quoted in our institution decision (Dec. on Inst. 18–19), the

Examiner included in the Notice of Allowance entered on December 24, 2003, the following statement of reasons for allowance:

3. The prior arts [sic] of record do not anticipate or render obvious to one skilled in the art a liquid crystal display comprising various elements as claimed, more specifically one of the upper and lower frame including a stepped protrusion (draw) for fixing one of the liquid crystal display and the intermediate frame.

4. The closest reference 5,680,183 (Sasuga) teaches an LCD including a shield case with conventional means, i.e., fixing pawls. Further, [other cited references] are related a [sic] liquid crystal display device that includes intermediate frame. However, all of the above references alone or in combination fail to teach or suggest the claimed stepped protrusion (draw) (shown in Figs. 4 and 5 of the instant application) for fixing (supporting) one of the liquid crystal display or the intermediate frame to one of the upper frame and the lower frame.

Ex. 1006, 6 (“Allowable Subject Matter”). Notably absent from the Examiner’s statement is any reference to the Applicant’s argument at page 9 of the Amendment dated November 12, 2003, that the stepped protrusion or draw “may have a shape (not hooked shaped)” (Ex. 1005, 35). Accordingly, we disagree with Petitioner’s premise that “[t]he Examiner accepted Applicant’s argument regarding construction of the terms ‘stepped protrusion’ and ‘stepped draw,’ which limited the terms to ‘non-hook shaped’ parts,” and “[b]ased on that construction, the Examiner withdrew the rejection based on Sasuga.” Req. Reh’g 1. Therefore, we are not persuaded by Petitioner’s arguments that the prior assertion of Sasuga was withdrawn based on a completely contrary claim construction and that we erred in concluding the grounds presented were the same as those considered during prosecution. *Id.* at 6–7.

Indeed, even if the Examiner had explicitly adopted the Applicant's construction, that would not necessarily compel a different result here. Section 325(d) provides, in relevant part, only that, "[i]n determining whether to institute or order a proceeding under . . . chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." Accordingly, our discretion under section 325(d) is not limited to cases in which we concur with or adopt a claim construction previously applied by the Office. Because we do not disagree with any explicit claim construction by the Examiner in this case, we need not decide here whether, or to what extent, consideration of prior claim construction should be considered in deciding whether or not a petition or request should be rejected under section 325(d).

Lastly, we are also not persuaded by Petitioner's argument titled "The Board's Decision Is Arbitrary And Capricious Because The Discretionary Standard Applied By Each Panel Is Not Consistent." Req. Reh'g 8 (boldface omitted); *see also id.* at 8–10. That other panels of this Board have on occasion, in non-precedential decisions premised on different facts than are presented here, chosen not to reject a petition or request where the same or substantially the prior art or arguments previously presented to the Office does not render our decision arbitrary and capricious. As explained in *Microsoft Corp. v. Parallel Networks Licensing, LLC*, Case IPR2015-00483 (PTAB July 15, 2015) (Paper 10) and quoted by Petitioner (*id.* at 9), section 325(d) "does not *require* any particular outcome." *Microsoft Corp.*, slip op. at 14–15.

For the foregoing reasons, Petitioner has not demonstrated that we abused our discretion by not instituting *inter partes* review of claims 1–3 and 5–8 of the '927 patent based on anticipation by Sasuga.

IV. ORDER

For the reasons given, it is ORDERED that Petitioner's Request for Rehearing is *denied*.

IPR2015-01491
Patent 6,734,927 B2

For PETITIONER:

Steven B. Kelber
Marc R. Labgold
Patrick Hoeffner
THE LAW OFFICES OF MARC R. LABGOLD, P.C.
skelber@labgoldlaw.com
mlabgold@labgoldlaw.com
phoeffner@labgoldlaw.com

Paul T. Meiklejohn
Clinton L. Conner
Adam Floyd
DORSEY & WHITNEY LLP
meiklejohn.paul@dorsey.com
conner.clint@dorsey.com
floyd.adam@dorsey.com

Jay I. Alexander
Andrea G. Reister
COVINGTON & BURLING LLP
jalexander@cov.com
areister@cov.com

For PATENT OWNER:

Aaron R. Ettelman
Jeffrey W. Gluck
John D. Simmons
Frederick A. Tecce
Clark A. Jablon
Dennis J. Butler
Stephen E. Murray
Ragi A.I. Elias
PANITCH SCHWARZE BELISARIO & NADEL LLP
aettelman@panitchlaw.com
jgluck@panitchlaw.com
jsimmons@panitchlaw.com

IPR2015-01491
Patent 6,734,927 B2

ftacce@panitchlaw.com
cjablon@panitchlaw.com
dbutler@panitchlaw.com
smurray@panitchlaw.com
relias@panitchlaw.com