

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN LIOWN ELECTRONICS CO., LTD.,
Petitioner,

v.

DISNEY ENTERPRISES, INC.,
Patent Owner.

Case IPR2015-01656
Patent 8,070,319 B2

Before HOWARD B. BLANKENSHIP, TRENTON A. WARD, and
WILLIAM M. FINK, *Administrative Patent Judges*.

FINK, *Administrative Patent Judge*.

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

Petitioner, Shenzhen Liown Electronics Co., Ltd., timely filed a request for rehearing of our decision on institution of *inter partes* review. Paper 9 (“Request”). The Request seeks rehearing of our determination to deny institution of *inter partes* review of claims 17 and 18 of U.S. Patent No. 8,070,319 B2 (Ex. 1001, “the ’319 patent”) on the asserted ground of obviousness over (1) Schnuckle 455¹ (Ex. 1003) and Meeker² (Ex. 1004); and (2) Schnuckle ’455, Long³ (Ex. 1007), Hartsock⁴ (Ex. 1008), and Helmer (Ex. 1006)⁵. *Id.* at 1 (citing Paper 7 (“Decision”)). For the reasons given below, we deny the Request.

I. LEGAL STANDARDS

When rehearing a decision whether to institute *inter partes* review, we review the decision for an “abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing [the] decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). The request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in” the petition. *Id.*

¹ U.S. Patent No. 7,261,455 B2, issued Aug. 28, 2007 (Ex. 1003).

² U.S. Patent No. 782,156, issued Feb. 7, 1905 (Ex. 1004).

³ U.S. Patent No. 6,781,270 B2, issued Aug. 24, 2004 (Ex. 1007).

⁴ U.S. Patent No. 3,425,157, issued Feb. 4, 1969 (Ex. 1008).

⁵ U.S. Patent No. 817,772, issued Apr. 17, 1906 (Ex. 1006).

II. ANALYSIS

1. Claim Construction

In our Decision, we denied institution of *inter partes* review of claims 17 and 18 of the '319 patent. Claim 17 recites the term “support wire spanning across the housing and affixed to the housing sidewall” (“the ‘support wire limitation’”). Ex. 1001, 24:8–9. We agreed with Patent Owner that the broadest reasonable interpretation of this term, consistent with the Specification, requires 1) the support wire to run all the way across the housing, and 2) to be *fixedly attached* to the housing. Decision 17–18.

Petitioner contends we erred in adopting “Patent Owner’s non-BRI construction of the claim term ‘affixed,’” by construing the term to mean “fixedly attached.” Request 1, 3. Petitioner files new exhibits, Exs. 1016, 1017, and 1018, along with its Request, which provide excerpts from various dictionaries defining “affixed” to mean “attach physically,” “to attach in any way,” “to secure to something,” and “to fasten to something else,” and alleges these meanings are “far broader” than Patent Owner’s construction. *Id.* at 3 (quoting Ex. 1016, 20; Ex. 1017, 29; Ex. 1018, 26). We disagree.

A petition for *inter partes* review must identify, among other things, “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). Here, despite proposing constructions for two other terms, Pet. 10–12, Petitioner provided no construction for the term “affixed,” relying instead on the “ordinary and plain meaning in light of the specification . . . pursuant to the BRI standard,” *id.* at 12. Now, as part of its Request, Petitioner comes forward with new evidence and new arguments that the Decision misconstrued the construction of the term “affixed.” See Request 3–4. Consequently, Petitioner cannot contend we have overlooked or

misapprehended anything when it provided no testimony, documentary evidence, or analysis in its Petition that the term's plain and ordinary meaning in light of the Specification of the '319 patent would have been understood to include rotatable attachments.

By contrast, Patent Owner, relying on the Specification, argued that a person of ordinary skill in the art would have understood the term “affixed” to require the support wire to be “fixedly attached.” Prelim. Resp. 23–24 (citing Ex. 1001, 9:1–2, 3:36–37). In accepting Patent Owner's proposed construction for purposes of the Decision, we agreed. Decision 17–18. For example, we noted the Specification's description of the support wire being “mounted to the housing at opposite points.” *Id.* at 18 (citing Ex. 1001, 9:1–4). As Petitioner acknowledges, the '319 patent Specification also describes the support wire as “tethered” to the housing (Ex. 1001, 3:36–37). There is no evidence of record that a person of ordinary skill in the art would have understood such descriptions to include rotational attachments.⁶ Furthermore, in the Decision we noted the express recitation in Schnuckle '455 of a distinction between being “fixedly secured” and “rotatably secured.” Decision 19–20, 32 (citing Ex. 1003, 3:56–60 (“The ring shaped member 20 is connected to housing 32 by a pair of pins, 22 and 23, each pin 22, 23 being fixedly secured to the outer periphery of member 20 and rotatably secured to the inner wall of housing 32.”))). Accordingly, we

⁶ We are similarly unpersuaded by Petitioner's belated and unsupported argument that the prior art Schnuckle '455 patent's distinction between “rotatably secured” and “fixedly secured” indicates that the claim term “affixed” at issue here is entitled to broader scope. Request 5.

disagree with Petitioner's contention that the construction we adopted for purposes of our Decision was without basis and explanation. Request 6.

2. Obviousness

Based on the interpretation of the support wire limitation that we adopted in our Decision, which we do not alter here, we found the Petitioner and its declarant Dr. Delson did not sufficiently address how Schnuckle '455 would be modified by either Meeker (Ex. 1004) or Helmer (Ex. 1006) to obtain the recited support wire limitation.⁷ Decision 30–32, 34–35. We are not persuaded we erred in reaching this conclusion. *See* Decision 32, 35 (noting the mechanism of Schnuckle '455 is “rotatably secured” as opposed to “fixedly attached” as the term “affixed” requires).

Petitioner notes Dr. Delson's statement that substituting a stationary shaft (i.e., one that was fixedly attached) for a rotating shaft (i.e., as disclosed) would have been an easy alternative for a person of ordinary skill in the art, as evidence there is no need for the support wire to rotate. Request 10–11 n.4 (citing Ex. 1002 ¶ 31). Petitioner fails to direct us, however, to where in the Petition it set forth this alternative theory of obviousness. *See* 37 C.F.R. § 42.104(b)(4). Furthermore, we note that Petitioner's new theory based upon a previously uncited portion of the Dr. Delson's declaration is actually a citation to the background section of Dr. Delson's declaration on “Pivots and Bearings” and this testimony is not part of his opinions on obviousness over the combination of Schnuckle '455 and either Meeker or Helmer. *See* Ex. 1002 ¶¶ 125–132, 136–167.

⁷ We omit Hartsock and Long from this discussion as neither reference is alleged to contribute to the support wire limitation in the Schnuckle '455, Helmer, Hartsock, and Long combination. Petition 48–50.

Accordingly, Petitioner does not persuade us we misapprehended or overlooked anything in finding the combination of Schnuckle '455 and Meeker deficient.

III. CONCLUSION

Petitioner has not carried its burden of demonstrating that the Board's Decision misapprehended or overlooked any matters, such that it abused its discretion in denying institution. *See* 37 C.F.R. § 42.71(d). The Motion is DENIED.

IPR2015-01656
Patent 8,070,319 B2

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