

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SATA GmbH & Co. KG,
Petitioner,

v.

ANEST IWATA CORPORATION,
Patent Owner.

Case IPR2015-01790
Patent 6,494,387 B1

Before JOSIAH C. COCKS, DEBORAH KATZ, and JENNIFER S. BISK,
Administrative Patent Judges.

BISK, *Administrative Patent Judge.*

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. §§ 314(a), 325(d), and 37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Petitioner, SATA GmbH & Co. KG, filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of all the claims, 15–22 (the “challenged claims”), of U.S. Patent 6,494,387 B1 (the “’387 patent”) (Ex. 1001). Patent Owner, Anest Iwata Corporation, filed a Preliminary Response (Paper 10, “Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Upon consideration of the Petition and the Preliminary Response, we deny institution under §§ 311(b) and 325(d).

B. Related Matters

Petitioner filed an earlier Petition challenging claims 1–22 of the ’387 patent in January 2013—IPR2013-00111 (“the Prior Petition”). We instituted an *inter partes* review of claims 1–14, but found that Petitioner had not shown a reasonable likelihood that claims 15–22 would have been unpatentable under any of the proposed grounds. IPR2013-00111, Paper 13 (“111 Inst. Dec.” or “Prior Institution Decision”). On May 20, 2014, in a Final Written Decision, we held claims 1–14 unpatentable. IPR2013-00111, Paper 44 (“111 Final Dec.”).

C. Asserted Grounds of Unpatentability

Petitioner challenges claims 15–22 as (1) anticipated by JP ’950¹ (Pet. 3); (2) “obvious over JP ’950 in view of the knowledge in the public domain, and/or in

¹ Japanese Published Patent Application No. JP 08-196-950 (“JP ’950”) (Ex. 1003) (English Translation Ex. 1004).

view of” Garlick,² Burns,³ Fritz,⁴ “and/or further in view of” Peeps,⁵ Kaneko,⁶ Schmon⁷ (*id.* at 4); and (3) “not new under 35 U.S.C. § 101 in view of cancelled and unpatentable claims 1–14 of the ’387 patent, which are in the public domain” (*id.*).

II. ANALYSIS

A. Not New Under 35 U.S.C. § 101

Petitioner requests that we institute an *inter partes* review based on the theory that claims 15–22 of the ’387 patent are “not new under 35 U.S.C. § 101 in view of cancelled and unpatentable claims 1–14 of the ’387 patent, which are in the public domain.” Pet. 4; *see also* Pet. 51–54.

We are not persuaded that this argument presents a proper basis for instituting an *inter partes* review. 35 U.S.C. § 311(b) states that “[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent *only on a ground that could be raised under section 102 or 103* and only on the basis of prior art consisting of patents or printed publications.” Petitioner does not explain how this theory, explicitly referring only to § 101, is a ground that could be raised under §§ 102 or 103 as required by § 311.

B. 35 U.S.C. § 325(d)

In determining whether to institute an *inter partes* review, we “may take into account whether, and reject the petition or request because, the same or

² U.S. Patent No. 5,540,385 (Ex. 1014) (“Garlick”).

³ U.S. Patent No. 5,456,414 (Ex. 1013) (“Burns”).

⁴ U.S. Patent No. 5,344,078 (Ex. 1012) (“Fritz”).

⁵ U.S. Patent No. 5,646,314 (Ex. 1009) (“Peeps”).

⁶ U.S. Patent No. 5,249,746 (Ex. 1011) (“Kaneko”).

⁷ U.S. Patent No. 5,088,648 (Ex. 1010) (“Schmon”).

substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

Patent Owner asks that we deny institution of a trial on all grounds raised in the Petition, citing § 325(d). Because we have determined, above, not to institute a trial based on Petitioner’s asserted § 101 ground, we address the remaining proposed grounds with respect to § 325(d) below.

1. Anticipation by JP ’950

Petitioner asserts that claims 15–22 would have been anticipated by JP ’950. Pet. 3, 30–42. In the Prior Institution Decision, we determined that Petitioner had not met its burden to show that JP ’950 inherently discloses “said discharge end of said tip portion of said paint nozzle projects from 0.3 mm to 0.8 mm from said front end of said central opening in said air cap” (“the nozzle projection limitation”). 111 Inst. Dec. 10–11. In this Petition, Petitioner repeats the arguments of the Prior Petition, including that the nozzle projection limitation is “inherently disclosed in JP ’950 to a person of ordinary skill in the art to which this claim pertains.” Pet. 38; *see also* Pet. 31–32. In contrast to the Prior Petition, to support this assertion, Petitioner provides testimony from two declarants, Dr. Ewald Schmon (Ex. 1021) and Mark E. Charpie (Ex. 1032). Petitioner also refers to other prior art references as alleged corroboration of the inherency of this limitation. *See* Pet. 32 (“This claim limitation read on the JP ’950 drawings and disclosure as understood by a person of ordinary skill in the art to which this invention pertains. EXHIBIT 1004 pages 1–14. USP5456414 EXHIBIT 1013, Page 5.”).

The ground asserted here by Petitioner raises JP ’950, the same prior art as was previously presented by Petitioner in the Prior Petition. Petitioner does not indicate persuasively how its arguments differ in any material respect from those

arguments in the Prior Petition. We note that Petitioner does not refer to any particular portion of these declarations, but instead almost exclusively cites to the declarations—each of which is more than 30 pages—in their entirety. *See, e.g.*, Pet. 20–22, 39–40, 44. While this is a violation of 37 C.F.R. § 42.6(a)(3), it also fails to direct us to the portions of the declarations that support Petitioner’s argument. Without such direction, it is difficult to give the testimony any weight. Moreover, we do not discern that the wholesale citation to the entirety of the declarations here amounts to the identification “with particularity” of “the evidence that supports the grounds for the challenge to each claim.” *See* 35 U.S.C. § 312(a)(3). In this case, merely bolstering previously-made arguments that we found lacking, generally accompanied with non-specific evidence, does not change the argument sufficiently for us to consider the argument not “substantially the same” for the purposes of § 325(d).⁸

We note, in addition, that Petitioner does not indicate that the additional testimony and references were unavailable when the Prior Petition was filed. Though, Petitioner is not barred from providing additional information in a later petition, we are more likely to exercise our discretion under § 325(d) where a petitioner uses repeated petitions to in an attempt to build a sufficient challenge incrementally.

2. Obviousness over JP ’950

Petitioner asserts that claims 15–22 would have been “known and/or obvious from JP ’950 in view of prior art or in public domain and/or knowledge of a person

⁸ We take no position on whether it is improper to use prior decisions of the Board as a “roadmap” for crafting subsequent petitions challenging a patent. Instead, we simply address the issue of whether this Petition advances “substantially the same” arguments as the Prior Petition.

of ordinary skill in the art under 35 U.S.C. § 103.” Pet. 42; *see also* 42–51. In the Prior Institution Decision, we determined that Petitioner had

not provided sufficient reasoning or facts on which to base a conclusion that a person of ordinary skill in the art would have found it obvious in light of JP ’950’s disclosure . . . to include the physical dimension of the downstream projection of the guide walls recited by claim 15.

111 Inst. Dec. 12. In this Petition, Petitioner repeats the arguments of the Prior Petition, including that a person of ordinary skill in the art would know, looking at the drawings of JP ’950, the amount of projection of the tip portion—and by implication, would find obvious the nozzle projection limitation. Pet. 44. In contrast to the Prior Petition, to support this assertion, Petitioner provides testimony from two declarants. Petitioner also refers to other prior art references as corroboration for the declarants’ testimony. *See* Pet. 44 (“Corroboration by Ransburg patents 5344078 EXHIBIT 1012 and 5456414 EXHIBIT 1013.”); Pet. 50 (“[C]laims 15–22 of the ’387 are unpatentable under 35 U.S.C. § 103 as obvious in view of the prior art, particularly JP ’950 in view of USP5456414 EXHIBIT 1013 showing forward projection of 0.508 mm. and in view of what is in the public domain Dr. Schmon Declaration EXHIBIT 1021.”). Again, Petitioner fails to cite to the specific testimony within the declarations, and also fails to provide a detailed discussion of how the cited prior art references corroborate this testimony.

The ground asserted here by Petitioner raises JP ’950, the same prior art as was presented previously by Petitioner in the Prior Petition. Petitioner relies on JP ’950 for essentially the same disclosure for which it was cited in the Prior Petition. The various secondary references were not cited in the Prior Petition. However, despite headings that imply the contrary, the Petition does not appear to raise any obviousness grounds explicitly combining JP ’950 with any of these secondary

references, but instead simply refers to the secondary references generally as evidence of the background knowledge of a person of ordinary skill. Merely providing additional evidence, without citation to specific parts and without explanation of how it is relevant, does not cure the deficiencies of the Prior Petition.

For example, in this Petition, Petitioner provides only one claim chart for obviousness of claim 15. Pet. 42–44. In this claim chart, only JP '950 is cited for each claim limitation except the nozzle projection limitation. *Id.* Moreover, when the secondary references, Fritz, Burns, and Garlick, are mentioned, it appears to be solely for the purpose of corroborating the knowledge of the person of ordinary skill in the art, but no further explanation or citation is provided. *Id.* at 44. Finally, Petitioner does not explain why a person of ordinary skill in the art would look to the teachings of any of the secondary references. The prior art and arguments in this ground, therefore, do not differ materially from those previously presented in the Prior Petition, and we consider them to be substantially the same.

3. Conclusion

We have considered the totality of the facts before us, including: (1) the same petitioner has presented substantially the same challenges in an earlier petition; (2) this Petition seeks to remedy deficiencies that have been identified by the Board in a prior decision denying institution; (3) the Petition's supposed remedy—wholesale citation to the entirety of newly proffered evidence—does not amount to the identification “with particularity” of “the evidence that supports the grounds for the challenge to each claim” as required by 35 U.S.C. § 312(a)(3); (4) the previous IPR proceeding has progressed to a point that there is no efficiency to be gained by addressing these similar challenges at this time; and (5) Petitioner has not asserted that it has been served with a complaint alleging

infringement—therefore, is unlikely to be subject to a one-year statutory bar under 35 U.S.C. § 315(b), which would prohibit Petitioner from re-filing a petition based on materially different art or arguments. Considering the totality of these circumstances, we determine that the facts weigh in favor of denying institution pursuant to 35 U.S.C. §§ 314 and 325.

III. ORDER

Accordingly, it is

ORDERED that Petitioner's request for an *inter partes* review of claims 15–22 of the '387 patent is *denied*.

IPR2015-01790
Patent 6,494,387

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