

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

INTRODUCTION

Petitioner, SATA GmbH & Co. KG, filed a Request for Rehearing (Paper 15, “Reh’g Req.”) of our Decision Denying Institution of *Inter Partes* Review (Paper 14, “Institution Decision” or “Inst. Dec.”). The Request seeks rehearing of our Decision with respect to not instituting trial on claims 15–22 of U.S. Patent No. 6,494,387 B1 (“the ’387 patent”) as anticipated by JP ’950¹ and unpatentable under 35 U.S.C. § 103(a) over JP ’950 “‘in view of the knowledge in the public domain, and/or in view of’ Garlick,² Burns,³ Fritz,⁴ ‘and/or further in view of’ Peeps,⁵ Kaneko,⁶ Schmon.⁷” Reh’g Req. 1–2.

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision[,]” which party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

For the reasons discussed below, Petitioner’s Request for Rehearing is *denied*.

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

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”).

ANALYSIS

Petitioner argues that for both grounds of unpatentability—anticipation and obviousness—we “ignore[] the fact that the Final Written Decision of IPR2013-00111 [cancelling claims 1–14 of the ’387 patent], as well of the bulk of the entire proceedings of the IPR2013-00111” are relied on by Petitioner to make its case in this proceeding. Req. Reh’g 4, *see also* 5–6, 7–9. In fact, Petitioner concedes that “the Final Written Decision in IPR2013-00111 is being used in both the anticipation and obviousness grounds set forth in the Petition.” Req. Reh’g 9.

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 the Final Written Decision of IPR2013-00111 or “the bulk of the entire proceedings” of that case qualify as either a patent or a printed publication under the statute. In particular, to qualify as a printed publication under § 102, a reference “must have been sufficiently accessible to the public interested in the art” at the time the patent application at issue was filed. *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009) (internal quotation marks omitted). The results of IPR2013-00111 were, by definition, not available until well after the ’387 patent issued.

We have considered, but are not persuaded by, Petitioner’s other arguments, including the “illogical” survival of allegedly broader claims 15–22, while narrower claims 1–14 are cancelled. Req. Reh’g 9–10. Although, where present, illogical results are unfortunate, *inter partes* reviews are adversarial proceedings and our rules have been set up to respect procedural fairness. “Within this structure . . . Congress assigned to the challenger the burden of persuasion in the

dispute[.] That burden, together with the procedural rules[.] impartially applied, means that, in some cases, a challenge can fail even if different evidence and arguments might have led to success.” *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015).

Moreover, as we noted in our Institution Decision, our determination to not institute trial was based, in-part, on inadequacies of the Petition in explaining suitably how the proffered evidence was applied to the proposed grounds. Pet. 5–7. In that respect, we were not satisfied that Petitioner had met its burden of showing a reasonable likelihood of success in showing the unpatentability of claims 15–22 in view of the record that was before us.

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), Petitioner’s Request for Rehearing is *denied*.

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