

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DUKANE CORPORATION,
Petitioner,

v.

HERRMANN ULTRASCHALLTECHNIK GMBH & CO., KG,
Patent Owner.

Case IPR2016-00066
Patent 8,702,883 B2

Before GRACE KARAFFA OBERMANN, BRIAN P. MURPHY, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

ANKENBRAND, *Administrative Patent Judge*.

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

On May 13, 2016, Petitioner filed a Request for Rehearing (Paper 10, “Rehearing Request” or “Reh’g Req.”) of the portion of our Decision denying institution of an *inter partes* review (Paper 8, “Institution Decision” or “Dec.”) of claims 4, 5, and 7–9 of U.S. Patent No. 8,702,883 B2 (Ex. 1001, “the ’883 patent”). The asserted grounds on which we denied institution are listed in the following table:

Reference(s)	Basis	Claim(s) Challenged
Klinstein ’158 ¹	§ 102(b)	6, 8
Klinstein ’158 and iQ Manual ²	§ 103	9
Klinstein ’816 ³	§ 103	4, 5
DPC Manual ⁴	§ 102(b)	6–9

We deny the Rehearing Request for the reasons set forth below.

ANALYSIS

When considering a request for rehearing, the Board reviews its 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 the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

The challenged claims relate to methods for controlling an ultrasonic machining process, wherein, during each machining interval a welding variable is kept constant until a target variable reaches a predetermined

¹ U.S. Patent No. 7,819,158 B2, issued October 26, 2010 (Ex. 1002).

² Dukane iQ Series Ultrasonic Generator Power Supply ES User’s Manual (Ex. 1006).

³ U.S. Patent No. 8,052,816 B2, issued November 8, 2011 (Ex. 1004).

⁴ Dukane Dynamic Process Controller DPC™ IV Plus Generator User’s Manual (Ex. 1005).

value. Ex. 1001, 2:5–21, 3:39–41. Each of the welding variables can be the same, but the target variables are different. *Id.* at 2:41–42, 2:48–49, 4:18–21.

Regarding the asserted grounds that Klinstein ’158 anticipates claim 8 and the DPC Manual anticipates claims 6–9, we determined that Petitioner “fail[ed] to address the limitations reciting different target variables for the machining intervals,” which was “fatal to [those] unpatentability assertions.” Dec. 9–10. Likewise, we determined that Petitioner’s failure to address the additional “target variable[s] differ” limitation of claim 8 was fatal to the asserted ground that the subject matter of claim 9 (which depends from claim 8) would have been obvious over the combination of Klinstein ’158 and the iQManual. *Id.* at 10. Regarding Petitioner’s assertion that Klinstein ’158 anticipates claim 6, we determined that, although Petitioner addressed the “target variable[s] differ” limitation, Petitioner failed to explain adequately how the reference discloses that limitation. *Id.* at 12–13.

With respect to the asserted ground that the subject matter of claims 4 and 5 would have been obvious over Klinstein ’816, we determined that Petitioner did not provide “adequate reasoning based on rational underpinnings to persuade us, in the absence of hindsight, that one of ordinary skill would have modified the welding method of Klinstein ’816 to achieve the claimed subject matter [i.e., the specific features that claims 4 and 5 add to the subject matter of claim 1].” *Id.* at 16.

Petitioner asserts that our Institution Decision overlooked three points: (1) the explanation in the Petition that the Institution Decision cited as showing how claim 6 is anticipated by the prior art was directed to the “target variable[s] differ” limitation of claim 1, which is incorporated into all of the challenged claims; (2) the Petition and the Declaration of Leo

Klinstein (“Klinstein Declaration”) describe a clear link between the detection and selection steps of claims 4 and 5 and a particular teaching, preference, suggestion, or other reasoning derived from Klinstein ’816; and (3) the Certificate of Correction relied upon in the Institution Decision was filed improperly by Patent Owner and issued improperly by the Office. Reh’g Req. 2. We address each of those assertions below, beginning with the Certificate of Correction.

A. The Certificate of Correction

Petitioner contends we overlooked the fact that the Certificate of Correction relied upon in the Institution Decision was filed improperly by Patent Owner and issued improperly by the Office. *Id.* In particular, Petitioner contends that the Certificate of Correction is defective because it was filed by Patent Owner and issued by the Office “without due process because neither the Patent Owner nor the Office complied with 35 U.S.C. § 255 and 37 C.F.R. § 1.323.” *Id.* at 7. Petitioner also contends that Patent Owner engaged in misconduct by: (1) filing the request for a Certificate of Correction without filing the motion that is required under 37 C.F.R. § 1.323; (2) filing the request for a Certificate of Correction without including the proper “showing” required under 35 U.S.C. § 255; (3) filing the request for a Certificate of Correction instead of a reissue application; (4) falsely asserting in the Preliminary Response that the ’883 patent contained an error that “‘ha[d] been corrected by certificate of correction (Ex. 2001)[;]’” and (5) filing an incomplete and misleading exhibit that “omits the first page of the alleged ‘certificate of correction,’ which is the page showing that it was only a ‘request’ for a certificate of correction.” *Id.* at 10–11 (quoting Prelim. Resp. 2). Finally, Petitioner contends that the Office improperly issued the Certificate of Correction because Patent

Owner's correction is a mistake that affects claim scope, which must be corrected by reissue. *Id.* at 8–9, 11 (quoting MPEP § 1481).

Assuming *arguendo* that Petitioner's arguments have merit, they are raised for the first time in the Rehearing Request, despite the fact that we provided Petitioner an opportunity to file a reply to address issues raised by the Certificate of Correction. On March 30, 2016, we issued an Order determining the proper course of conduct in this proceeding, pursuant to our authority under 37 C.F.R. § 42.5. Paper 7. Specifically, we determined that Patent Owner failed to seek authorization before filing its request for a Certificate of Correction. *Id.* at 3. Because the Office already had issued the Certificate of Correction, we ordered Patent Owner to file a copy of the document as an exhibit in this proceeding. *Id.* To cure any resulting prejudice, we authorized Petitioner to file a reply brief explaining how the references cited in the Petition disclose the corrected claim limitations. *Id.* Petitioner did not avail itself of this opportunity. Nor did Petitioner attempt to contact the Board or raise any of the above-detailed arguments at any time prior to our Institution Decision. We could not have misapprehended or overlooked information that was not presented previously on the record. *Cf. Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1388 (Fed. Cir. 1989) (“Prescience is not a required characteristic of the board[,]” as “the board need not divine all possible afterthoughts of counsel that might be asserted for the first time on appeal.”). On this record, we are not persuaded that our analysis of the corrected claims in the Institution Decision represents an abuse of discretion.

B. The “Target Variable[s] Differ” Limitation of Claims 6–9

Petitioner asserts that we overlooked the fact that its explanation as to how claim 1 is anticipated by the prior art when the word “value” is replaced

by the word “variable” applies to all of the challenged claims, as they depend from, and incorporate the subject matter of, claim 1. Reh’g Req. 3. Specifically, Petitioner contends that the Institution Decision acknowledges that, for claim 6, the Petition “includes a discussion of the limitation “wherein the first and the second target variable[s] differ” as recited in claim 1,” but then erroneously fails to apply the same conclusion to claims 4, 5, and 7–9. *Id.* at 3 (citing Dec. 8).

Petitioner’s arguments in this regard mischaracterize our Institution Decision. In the Institution Decision, we acknowledged that the phrase “wherein the first and second target variable[s] differ” appears in corrected claim 1, and also is part of claims 4–9 by virtue of their dependency from claim 1. Dec. 8 n.6. We further noted that Petitioner’s analysis of the ground that Klinstein ’158 anticipates claim 6 includes a discussion of the “target variable[s] differ” limitation. *Id.* at 8 n.7. We did not, as Petitioner argues, acknowledge that the Petition includes a discussion of the “target variable[s] differ” limitation as to all asserted grounds of unpatentability. For example, with respect to Petitioner’s challenge to claims 6–9 as anticipated by the DPC Manual, we explained that Petitioner identified the same variable (distance) as corresponding to the first, second, and fifth target variables disclosed in the DPC Manual, but that Petitioner focused only on whether the target *values* of the target variable differ. *Id.* at 9. We explained that Petitioner failed to address how use of the same target variable (distance) disclosed in the DPC Manual could satisfy the “target variable[s] differ” limitation in claims 6–9. *Id.* at 9–10. Further, we declined to institute trial on claim 8 as to all asserted grounds because the Petition failed to address the additional limitation of that claim, namely, a third machining interval that adjoins the second machining interval, wherein

the target variables for the second and third machining intervals differ. *Id.* at 8–9. Accordingly, we are not persuaded we misunderstood or overlooked that Petitioner’s explanation how the prior art anticipates claim 1 when the word “value” is replaced by the word “variable” applied to all challenged claims.

Petitioner also asserts that the Petition explains sufficiently why claim 1 is anticipated by each of Klinstein ’158, Klinstein ’816, and the DPC Manual. Reh’g Req. 3–5.

We note that the Institution Decision did not fault Petitioner for failing to explain how Klinstein ’816 discloses the “target variable[s] differ” limitation or any limitation of claim 1. Rather, we instituted trial on the ground that Klinstein ’816 anticipates claim 6 based, in part, on Petitioner’s showing that Klinstein ’816 discloses every limitation of claim 1. Dec. 15.⁵

Nor did we fault Petitioner for failing to address the “target variable[s] differ limitation” in its analysis of the ground that Klinstein ’158 anticipates claim 6. Dec. 12–13. Indeed, we pointed out that Petitioner argued Klinstein ’158 discloses “the use of other target variables to ‘control the welding process’” and cited a portion of Klinstein ’158 for support. *Id.* at 12 (citing Pet. 28). Ultimately, we determined that Petitioner was not reasonably likely to prevail on the asserted ground, because Petitioner failed to explain adequately how the cited passage of Klinstein ’158 “teaches that the target variables are different for two adjoining machining intervals.” *Id.* at 13.

⁵ As explained above, and in more detail below, we declined to institute trial on the ground that the subject matter of claims 4 and 5 would have been obvious over Klinstein ’816 because Petitioner did not make a sufficient showing with respect to the features that those claims add to the subject matter of claim 1.

With respect to the DPC Manual, Petitioner argues we overlooked the following argument in the Petition regarding the disclosure of a dual pressure mode:

the DPC Manual describes a welding process having a first interval in which a force F1 produced by a pressure P1 was “kept constant until a ‘first target variable’ (e.g., ‘welding time T,’ ‘welding path s,’ ‘power P,’ or ‘energy E’) adopts a predetermined value,” and a second interval in which a force F2 produced by a pressure P2 was “kept constant until a ‘second target variable’ (e.g., ‘welding time T,’ ‘welding path s,’ ‘power P,’ or ‘energy E’) adopts a predetermined value.”

Reh’g Req. 5 (citing Pet. 43–53). Petitioner does not direct us to the particular page of the Petition on which it advanced that argument, but, rather, cites ten pages of analysis. After reviewing the cited pages, it appears that Petitioner made the argument in a claim chart to show how the DPC Manual discloses welding variables and target variables, not how the DPC Manual discloses the “target variable[s] differ” limitation. See Pet. 45–46. Indeed, Petitioner’s claim chart does not address the “target variable[s] differ” limitation. Like the Petition, the claim chart focuses on whether the target values of the target variable differ. *Id.* at 46.

In any event, Petitioner fails to explain how the identification of exemplary target variables set forth in the DPC Manual is an anticipating disclosure of different target variables for each machining interval. In fact, the analysis in the Petition contradicts Petitioner’s argument in this regard because, as explained previously, Petitioner identifies the same variable as corresponding to the first, second, and fifth target variables disclosed in the DPC Manual. Dec. 9 (citing Pet. 57). Petitioner further admits that the DPC Manual discloses “the ‘[c]ontrol parameters [i.e., target variables] for P2 are *the same* as those used for P1, however the limits set for the parameters are

specific to each pressure.’ Thus, the user-specified target values for the first and second control parameters may differ.” Pet. 52 (citing Ex. 1005, 81) (emphasis added). Consistent with that description, Figure 7-16 of the DPC Manual illustrates how to set the dual pressure control and depicts the same control parameter (i.e., target variable) for P2 and P1 (i.e., weld time). Ex. 1005, 82. Accordingly, we are not persuaded that we overlooked or misapprehended Petitioner’s arguments as to what each of Klinstein ’158, Klinstein ’816, and the DPC Manual discloses.

C. Denial of Review of Claims 4 and 5 as Obvious over Klinstein ’816

Claim 4 incorporates the content of claim 1 and adds the features of detecting a third target variable during the first machining interval and selecting the second target variable depending on the result of the detection. Ex. 1001, 4:52–55. Claim 5 depends from claim 4 and narrows the third target variable to welding time. *Id.* at 4:56–57. As to these claims, we determined that Petitioner’s argument, which was devoid of discussion and citations to Klinstein ’816, “fails to link the hypothetical detection and selection criteria [that a skilled artisan ‘could have’ used] to any particular teaching, preference, suggestion, or other reasoning derived from Klinstein ’816 and the level of skill in the art.” Dec. 16. We also determined that the Klinstein Declaration “adds no further detail; it merely mirrors the Petition.” *Id.*

Petitioner contends that the entire discussion on pages 31–41 of the Petition relates to the obviousness of claims 4 and 5 from the disclosure of Klinstein ’816. Reh’g Req. 6. As Petitioner concedes in the Rehearing Request, however, “[t]hose pages make it clear, in graphic detail including reproduction of drawings from the [Klinstein] ’816 patent, how *claim 1* is anticipated by the [Klinstein] ’816 patent.” *Id.* (emphasis added). In other

words, the analysis on pages 31–41 does not set forth how the additional features of claims 4 and 5 would have been obvious from the disclosure of Klinstein '816 and the level of skill in the art.

Petitioner also repeats in the Rehearing Request essentially the same argument that was raised in the Petition, purporting to establish the link between Petitioner's hypothetical detection criteria and the disclosure of Klinstein '816 we found missing from its argument and the Klinstein Declaration. *Compare* Reh'g Req. 6–7, *with* Pet. 42 and Ex. 1007 ¶ 55. Petitioner's argument is no more persuasive on the second telling. That is, Petitioner reargues a case it attempted to make out in the Petition, but fails to point out how we misunderstood its arguments or Mr. Klinstein's testimony. Accordingly, we are not persuaded we misapprehended or overlooked Petitioner's arguments with respect to the asserted ground that the subject matter of claims 4 and 5 would have been obvious over Klinstein '816.

CONCLUSION

Petitioner's request for rehearing is *denied*.

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