

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEXCOWIN GLOBAL, INC.,
Petitioner,

v.

ARIBEX, INC.,
Patent Owner.

Case IPR2016-00440
Patent 7,224,769 C1

Before JONI Y. CHANG, BRIAN J. McNAMARA, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

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

INTRODUCTION

Dexcowin Global, Inc. (“Petitioner”) filed a Request for Rehearing (Paper 14, “Req. Reh’g”) of our Decision (Paper 13, “Dec.”) denying *inter partes* review of all grounds raised in the Petition (Paper 7, “Pet.”), which challenged claims 6, 10, 14, 17, 34, 36, 37, 39–53, and 55–64 of U.S. Patent No. 7,224,769 C1 (“the ’769 patent”), which issued from reexamination pursuant to Reexamination Request No. 90/012,436.

For the reasons explained below, Petitioner’s Request for Rehearing¹ is *denied*.

STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” The party requesting rehearing has the burden of showing that the decision from which rehearing is sought 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). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); and *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

¹ To the extent that Patent Owner questions whether Petitioner’s Request for Rehearing was timely filed, we exercise our discretion to accept the delay, if any, and, for efficiency, consider Petitioner’s Request for Rehearing on the merits pursuant to 37 C.F.R. § 42.5(c)(3).

ANALYSIS

Petitioner asserted claims 6, 10, 45–48, 50–53, 55–59, and 62–64 would have been obvious based on (1) Yu in view of Kobayashi and Schulze-Ganzlin and (2) Kobayashi in view of Yu and Grodzins. *See* Pet. 17–29. In our Decision Denying Institution, we explained why the Petition did not establish a reasonable likelihood Petitioner would prevail on its unpatentability challenges. Dec. 16–23. On rehearing, Petitioner argues our “Decision rested on false, erroneous assumptions of fact and/or law, which apparently caused the Board to reach a legally erroneous conclusion.” Req. Reh’g 1. We disagree.

A. Yu in View of Kobayashi and Schulze-Ganzlin

Petitioner contends that our “Decision denying the Petition was grounded on two conclusions reached by the Board: (i) failure to show that the X-ray device of Yu was ‘used in dentistry’ and (ii) failure of Petitioner’s expert, Professor Hamby to provide ‘additional persuasive explanation.’” Req. Reh’g 1–2.

With respect to the first point, Petitioner argues that our “Decision’s requirement that Yu’s device . . . be ‘used in dentistry’ is contrary to the express terms in the ‘769 patent claims.” Req. Reh’g 4. In our Decision, we did not introduce a requirement that the device of Yu be used in dentistry, as alleged on rehearing by Petitioner. Rather, as we pointed out in our Decision, Petitioner’s contention of obviousness is premised on what would have been done in the field of dentistry. *See* Dec. 17 (citing Pet. 22–23). In particular, Petitioner’s contention of obviousness in the Petition as to the modification of Yu in view of Kobayashi was:

Each of claims 6, 10, 45- 48, 50-53, 55-59, 62, 63 and 64 of the '769 patent would have been obvious at least as of March 21, 2005, from the teachings of [Yu] in view of [Kobayashi]. All of the elements and limitations of claims 6, 10, 45- 48, 50-53, 55-59, 62, 63 and 64 of the '769 patent are found in the portable X-ray device described and taught in the [Yu] reference, *except* for the limitation that the detecting means is structurally unattached to the housing. However, as described and shown above, the [Kobayashi] reference teaches a portable X-ray device that does have detecting means, each of which is unattached to the housing. Specifically, one of its normal intended uses is in the field of dentistry for taking X-ray images of teeth and recording those images on film, or a channel plate and then displaying the images in real-time on a CRT. In such applications neither the film nor the channel plate is attached to the X-ray device. Combining teachings of the [Yu] reference with teachings of the [Kobayashi] reference according to then known methods would have yielded predictable results as related to the field of technology of the '769 patent. Specifically, it would have been obvious to a person of ordinary skill in this field to have modified the [Yu] portable X-ray device to have used a film or a channel plate that was structurally unattached to the housing, as taught by [Kobayashi]. See, Hamby Decl, 1006, at ¶¶ 40-42.

Pet. 22–23.

Thus, Petitioner's purported reason that a person of ordinary skill in the art would have modified the device of Yu to have a structurally unattached detecting means is that, in dental applications, it is known to have a structurally unattached detecting means. Absent some evidence that the device of Yu is used in dentistry, the record does not support Petitioner's assertion that such a modification would have been made to the device of Yu by a person of ordinary skill in the art. See Dec. 17–18.

With respect to the second point raised by Petitioner regarding the testimony of Dr. Hamby, our Decision states: "[T]he Hamby Declaration provides no *additional* persuasive explanation supporting Petitioner's

argument. Rather, on this point, the Hamby Declaration and Petitioner's arguments appear to be identical." Dec. 17 (emphasis added). Petitioner characterizes this as an "additional ground for denial." Req. Reh'g 16. It is not. Rather, it is a statement that we had considered Dr. Hamby's testimony and that it provided no explanation in addition to that in the Petition for the proposed modification of Yu.

With respect to Schulze-Ganzlin, Petitioner argues on rehearing:

While the Decision faults the Hamby Declaration testimony description of Schulze-Ganzlin (Decision at 19) and faults the Montrose Declaration because it "does not even mention the device of Yu" (*Id.*), the Decision overlooked the fact that these Declarations pointed to portable X-ray devices that were already well known in the field of the patented invention and that Yu had previously been explained in regard to combining its teachings with Kobayashi's teachings.

Req. Reh'g 18–19. We disagree that we overlooked evidence in this regard. Rather, we considered the evidence cited by Petitioner (Ex. 1009 ¶ 35; Ex. 1006 ¶ 43), and we explained in our Decision why this evidence does not support Petitioner's obviousness contentions. *See* Dec. 18–20.

On rehearing, Petitioner argues that we "overlooked two other Supreme Court *KSR* holdings, which when considering the Yu reference, would have yielded a decision favorable to Petitioner." Req. Reh'g 6 (citing *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007)). We disagree that we overlooked any argument that was presented in the Petition. To the extent Petitioner on rehearing presents new rationales for its obviousness contentions, a request for rehearing is not an opportunity to supplement the Petition or submit new arguments that were not made in the Petition after the Decision has noted the deficiencies in the Petitioner's original analysis. *See* 37 C.F.R. § 42.71(d).

Even considering Petitioner's new arguments on rehearing, we remain unpersuaded by Petitioner's contentions. For example, Petitioner contends:

[A]ny person of ordinary skill in the field of the invention who is familiar with the structurally unattached detector of Kobayashi would have had, as the law presumes per *KSR*, ordinary creativity and ability sufficient to have modified the medical diagnostic X-ray apparatus of Yu to include a detecting means, such as a film or channel plate, that was structurally unattached to the housing.

Req. Reh'g 13–14. However, elsewhere, Petitioner argues that “Yu's focus was on digitization processing technology that displays x-ray results on a larger LCD screen, has improved resolution accuracy, can store and process the captured images, and uses a changeable battery.” Req. Reh'g 14. The record is devoid of evidence explaining how the device of Yu would work with film as the detecting means, such that it could still display the x-rays from the film on the LCD that is integrated into the housing, which would be separate from the film in Petitioner's proposed combination.

Petitioner also argues that “the finite number of predictable solutions to the problem associated with having an attached detecting means on a portable X-ray device is very small: the number is ‘1’ – the predictable solution to modify the device to replace the attached detecting means with an unattached detecting means.” Req. Reh'g 8. However, Petitioner does not identify any problem in Yu with having an attached detecting means. Furthermore, as explained immediately above, the record evidence does not show how Yu's device would display x-ray images, which would be taken on separate film in Petitioner's modified system, on the LCD integrated into the housing of the device.

On rehearing, Petitioner further argues:

The Decision acknowledged that all of the elements of claims 6, 10, 45-48, 50-53, 55-59, and 62-64 are expressly disclosed by the combination of Yu and Kobayashi. Yu discloses all of the elements and limitations found in all of claims except the limitation requiring the detecting means to be “unattached”, and, regarding dependent claim 64, the limitation locating the detecting means so that the x-rays pass through the teeth of the patient and impinge on the detecting means.

Req. Reh’g 9. However, Petitioner does not cite any portion of our Decision acknowledging that all elements of 18 separate claims are disclosed by Yu and Kobayashi. Our Decision made no such findings.

Indeed, the Petition did not provide an element-by-element analysis of each of these claims, as required by the Board’s rules, which specify that a petition must include “[a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence” and “where each element of [each challenged] claim is found in the prior art patents or printed publications relied upon [and] the relevance of the evidence to the challenge raised.” 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4), (5). Rather, Petitioner asserted that 18 claims “are directed to a portable X-ray device, a hand-held X-ray device and a method for analysis that generally recite basic structural features of the X-ray device and that are in common to these claims.” Pet. 16. Petitioner provided a bullet point list of alleged common structures, reproduced claim 6 as “illustrative,” and described features in the prior art references. See Pet. 16–18.

With respect to Yu, Petitioner did not cite the written description of Yu to provide support for any of its assertions that the numbered components in Figure 1 of Yu are actually what Petitioner alleged they are, nor did Petitioner provide sufficient explanation as to why these components

teach the limitations recited in the claims. *See* Pet. 17. For example, Petitioner asserted, without explanation, that “[t]he [Yu] X-ray device detecting means is an X-ray image intensifier 6.” Pet. 17. As noted in the discussion of claim construction in our Decision, Petitioner did not propose a construction for “detecting means,” as required by our Rules. *See* Dec. 9. Nor did Petitioner cite to disclosure within Yu to show that component 6 in Figure 1 of Yu is a detecting means within the meaning of the ’769 Patent. *See* Pet. 17. Furthermore, although Petitioner alleged that the battery in battery box 11 teaches the claimed “internal power source,” Petitioner did not identify what component in Yu teaches the claimed “integrated power system” that contains the “internal power source.” Pet. 17.

Thus, the Petition itself did not sufficiently address the 18 separate claims Petitioner identifies. *See* Req. Reh’g 9. Contrary to Petitioner’s assertion, our Decision does *not* “acknowledge[] that all of the elements of claims 6, 10, 45-48, 50-53, 55-59, and 62-64 are expressly disclosed by the combination of Yu and Kobayashi.” *See* Req. Reh’g 9.

B. Kobayashi in View of Yu and Grodzins

Petitioner further contends that we “misapprehended the structure and functions described and shown in Kobayashi, and thus reached a factually incorrect conclusion.” Req. Reh’g 20. In particular, Petitioner contends we misapprehended the “imaging apparatus” mentioned in Kobayashi:

Contrary to the Decision’s assertion, the “imaging apparatus” identified in Kobayashi is not a display means that displays X-ray images. Rather, the “imaging apparatus” is a detecting means such as a “channel plate” which captures images of the tooth. Kobayashi, Ex. 1015, ¶15. The “imaging apparatus” and the

detecting means as described in Kobayashi are not distinct parts

Req. Reh’g 20.

Our Decision denying institution did not rely on the “imaging apparatus” and the “detecting means” being distinct parts. Rather, the relevant distinction in Kobayashi is between the x-ray generating device and the imaging side of the x-ray system. See Dec. 22 (“[T]he imaging apparatus of Kobayashi is for obtaining and viewing x-ray images. Kobayashi discloses a cathode-ray tube (‘CRT’) as an example of a display device for viewing x-ray images (Ex. 1015 ¶ 2), but this display device is on the imaging side of Kobayashi’s x-ray system along with the x-ray detector, such as the channel plate.”). Kobayashi itself only uses the term “imaging apparatus” twice, and it does not depict this apparatus in the drawings. See Ex. 1015 ¶¶ 2, 10. Rather, the drawings in Kobayashi are directed to the x-ray generating device. See Ex. 1015 ¶¶ 16–17, Figs. 1–6.

Kobayashi discloses:

[F]or the case in which, in real time, for example, the state of the root of a tooth is observed with a *cathode-ray tube*, etc., or images are remotely transmitted, this method is inappropriate. Therefore, for such a demand, although an X-ray tube bulb which irradiates X-rays needs to be placed in the oral cavity and an *X-ray imaging apparatus needs to be disposed outside thereof*, it is very difficult to insert the X-ray tube bulb into the oral cavity while ensuring electric safety without patients suffering pain.

Ex. 1015 ¶ 2 (emphases added). This passage suggests that Kobayashi uses the term “imaging apparatus” broadly to describe the part of the x-ray system that is not the x-ray generating device that is the focus of

Kobayashi.² However, even if the term “imaging apparatus” narrowly describes only a “detecting means,” Kobayashi discloses that the “imaging apparatus”/“detecting means” is on the imaging side of the x-ray system and our reasoning for denying Petitioner’s proposed modification still applies. *See* Dec. 22–23.

Furthermore, on rehearing, Petitioner provides the following rationale to modify the device of Kobayashi to include an LCD display means:

To a person of ordinary skill in the art who is familiar with X-ray technology, and faced with a problem of how could the operator of the portable X-ray device be provided with means or capability to understand the detected x-rays, the disclosures of Yu and Grodzins would have provided common sense answers. Each disclose, in the same field of endeavor, LCD display means and imaging features that are particularly suited for this purpose. The uncontested evidence shows that Kobayashi could have been and would have been modified to have an image display integrated into the housing of a portable X-ray device.

Req. Reh’g 23–24.

Thus, Petitioner’s rationale on rehearing to modify Kobayashi is based on the premise that, in Kobayashi, there is “a problem of how could the operator of the portable X-ray device be provided with means or capability to understand the detected x-rays.” Req. Reh’g 23. In its Petition, however, Petitioner characterized the disclosure of Kobayashi as follows:

The [Kobayashi] X-ray device is placed in the oral cavity of the patient and then an X-ray image of the tooth is taken by the

² Although Kobayashi describes a cathode ray tube as a viewing device, consistent with its ordinary meaning, Petitioner suggests a cathode ray tube is a detecting means. Pet. 19 (“Either a cathode ray tube (CRT), for real-time images, or a film for photography, can be used to detect and capture the X-ray image of the tooth. In either scenario, the CRT and the film are structurally unattached to the housing of the [Kobayashi] device.”).

device. Either a cathode ray tube (CRT), for real-time images, or a film for photography, can be used to detect and capture the X-ray image of the tooth. In either scenario, the CRT and the film are structurally unattached to the housing of the [Kobayashi] device.

Pet. 19 (citing Ex. 1006 ¶¶ 30–35; Ex. 1009 ¶¶ 24–33). Petitioner also stated:

During operation “X-rays are output from target 17, allowing a transmission image of the root of the tooth, etc. [,] in dental medical treatment to be easily observed or photographed.” Exh. 1015, at [0015]; Hamby Decl. Exh. 1006, at ¶ 33. Thus, the JP ‘098 device provides an X-ray output such that images of dental roots can be easily observed, and it has a current load sufficient for radiographic imaging.

Pet. 21 (brackets in original).

Therefore, according to the Petition, Kobayashi already provided the operator with the “means or capability to understand the detected x-rays.” As such, the record before us does not show that the problem that allegedly would have motivated a person of ordinary skill in the art to make Petitioner’s proposed modification even existed in Kobayashi.

Furthermore, Petitioner has not directed us to, nor do we find, any mention of using an LCD as a display in Grodzins. Rather, Grodzins teaches the use of a “display” without specifying the type. Ex. 1018, 3:36–37 (“display 52 such as a video monitor”); 3:48–49 (“base unit 56 may contain display 52 for displaying an image of target 36 posterior to wall 40”). Thus, Petitioner’s assertions that Grodzins discloses “LCD display means” is not supported by the record. *See* Req. Reh’g 23.

On rehearing, Petitioner still further argues:

[N]o evidence or other indication of record states, teaches, implies or shows that the ‘769 patent’s combination of a housing

containing an X-ray source; an integrated power system; *an internal power source that can be removed from the housing*; an LCD display means integrated into the housing; and detecting means structurally unattached to the housing—leads to an unpredictable result or that this combination performs any new function vis-à-vis the Kobayashi, Yu, and Grodzin devices, when combined as per Professor Hamby’s testimony.

Req. Reh’g 24 (emphases added).

However, Kobayashi itself teaches sealing the battery inside a “synthetic resin” for patient safety. Prelim. Resp. 45–46 (citing Ex. 1015 ¶¶ 11, 12, Fig. 4). Kobayashi teaches:

Note that the important thing here is that because there is no external connection wire in this portable X-ray generating apparatus 30, in addition to a wiring connection in itself also being impossible, *battery 31 cannot be replaced while being sealed thereinside*. This only takes the safety of the human body into consideration, with charging of battery 31 for repetitive use of battery 31 carried out, as illustrated in FIG. 5, by transformer coupling

Ex. 1015 ¶ 12 (emphasis added). Thus, Kobayashi not only teaches a battery sealed inside a resin, but it also teaches how to charge the battery wirelessly because it cannot be removed. As such, contrary to Petitioner’s argument on rehearing, there is evidence in the record undermining Petitioner’s proposed modification of Kobayashi to have a removable battery.

CONCLUSION

Petitioner has not carried its burden of demonstrating we misapprehended or overlooked any matters raised in the Petition such that we abused our discretion in denying institution. 37 C.F.R. § 42.71(d).

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

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