

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE GILLETTE COMPANY,
Petitioner,

v.

SHAVELOGIC, INC.,
Patent Owner.

Case IPR2016-00699
Patent 8,789,282 B2

Before LORA M. GREEN, KEN B. BARRETT, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

RICHARD H. MARSCHALL, *Administrative Patent Judge*.

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

The Gillette Company (“Petitioner”) filed a Request for Rehearing (Paper 15, “Reh’g Req.”) of our Decision denying institution of *inter partes* review (Paper 14, “Decision” or “Dec.”) of claims 1–6 of U.S. Patent No. 8,789,282 B2 (Ex. 1001, “the ’282 patent”). We deny Petitioner’s Request for Rehearing for the reasons set forth below.

STANDARD OF REVIEW

When reconsidering a decision on institution, the Board reviews 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.” 37 C.F.R. § 42.71(d). In its request for rehearing, the dissatisfied party must “specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” *Id.* We address Petitioner’s arguments with these principles in mind.

ANALYSIS

Claim Construction

Petitioner first argues that we did not properly construe “longitudinal axis of inertia,” a limitation found in claim 1, the only independent claim. In our Decision, we noted that Petitioner argued “longitudinal axis of inertia” did not have a defined meaning to one of ordinary skill in the art, and that Figure 7E of the ’282 patent discloses the longitudinal axis of inertia. Dec. 6. We agreed that Figure 7E discloses the limitation, and that the figure, for purposes of the Decision, was controlling on the meaning of the term given the absence of any textual description of the term in the specification and the parties’ reliance on Figure 7E. *Id.* at 8. We concluded that because Figure 7E discloses the longitudinal axis of inertia passing through the center of mass of the handle, and specifically labels the center of mass in the figure, that “at a minimum” the limitation “requires a

longitudinal axis that passes through the center of mass of the handle.” *Id.* at 9. Based on that construction, we agreed with Shavelogic, Inc. (“Patent Owner”) that Petitioner failed to establish that the prior art discloses the limitation, and we denied institution. *Id.* at 11–13.

Petitioner argues that our construction improperly narrows “longitudinal axis of inertia” because it reads a limitation from Figure 7E into the claims. Reh’g Req. 3–4. Petitioner argues that depicting the longitudinal axis of inertia passing through the center of mass in Figure 7E “should not be deemed critical enough to import its requirement into the claims.” *Id.* at 4. Petitioner asserts that without more, the specification does not amount to a “disclaimer” of claim scope that justifies our construction. *Id.* at 5–6.

Petitioner’s further arguments in support of its construction in the Request for Rehearing could have been made, but were not, in the Petition. Despite relying almost exclusively on Figure 7E for its construction, which shows the longitudinal axis of inertia passing through the center of mass of the handle, the Petition never addresses the center of mass or explains why the limitation should not be construed to require an axis passing through the center of mass. Pet. 10. Petitioner addresses the issue for the first time in the Request for Rehearing. We cannot misapprehend or overlook arguments never made in the Petition.

Moreover, we are not convinced that we would have reached a different conclusion had Petitioner presented these arguments in the Petition. Petitioner seems to presume that “longitudinal axis of inertia” has a known broad, ordinary meaning, and that we improperly relied on Figure 7E to find a “disclaimer” of that broad scope. Reh’g Req. 5–6. Petitioner acknowledges in the Petition, however, that the limitation “did not have a defined meaning to a person of ordinary skill in the art at the time of the alleged invention.” Pet. 10. Petitioner also acknowledges

that the text of the written description did not define the term. Reh’g Req. 5 (“With no clear definition or disclaimer in the specification . . .”). Instead, the specification refers to Figure 7E when describing the term. Ex. 1001, 3:61–62 (“FIG. 7E is a diagram illustrating how the longitudinal axis of inertia of the handle is measured.”). We are, therefore, left with the depiction of the longitudinal axis of inertia in Figure 7E as the best guide to the scope of the limitation. We relied on that figure to determine the scope of the limitation, not to find a disclaimer of claim scope from some undefined, broader meaning. As explained in our Decision, because the words of the limitation standing alone did not have a defined meaning in the art, and the only depiction of the “longitudinal axis of inertia” in the specification appears as a line passing through the center of mass of the handle in Figure 7E, the broadest reasonable construction of the limitation must, at a minimum, require a longitudinal axis that passes through the center of mass of the handle. *See* Dec. 9.

Petitioner next argues that our construction contradicts statements made by Patent Owner in the prosecution history. Reh’g Req. 7–10. According to Petitioner, we “overlooked statements made by Patent Owner” that allegedly show that Patent Owner described the limitation in a manner consistent with Petitioner’s construction. *Id.* at 7. We could not have “overlooked” those statements, as alleged by Petitioner, because Petitioner never presented those statements for our consideration in the Petition. None of the substantive analysis provided at pages 8–9 of the Rehearing Request appears in the Petition. *See id.* at 8–9. Petitioner points to isolated instances where it cited to specific pages in the prosecution history, but those citations are with reference to a block quote of claim 1 and the

Examiner's reasons for allowance. *Compare* Reh'g Req. at 7–8, *with* Pet. 8–9.¹ Petitioner's Request for Rehearing relies on a statement by Patent Owner made at page 75 of the prosecution history, but the Petition never cited to that page in the prosecution history. Reh'g Req. 7–9. Petitioner asserts that page 75 was “identified in the Petition by pin cite to page 65, which is the first page of the amendment to the claims,” but page 65 was not cited in the Petition. *Id.* at 9. Even if Petitioner cited page 75 directly in the cites following the quote of claim 1 or the reasons for allowance, without any explanation that citation would not sufficiently apprise us of Petitioner's arguments based on that excerpt from the prosecution history. We are not obligated to review the record in search of arguments not included in the Petition that may support Petitioner's position—it is Petitioner's obligation to explain its arguments in the Petition and explain the relevance of the evidence cited therein. *See* 37 C.F.R. § 42.104(b)(5) (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”); *see also* 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”).

Finally, Petitioner argues that the Board's construction only provides a single reference point—the center of mass—to define the longitudinal axis. Reh'g Req. 10–13. According to Petitioner, the construction “is fatally flawed because it defines the axis with only a single reference and nothing else, which would allow the axis to extend in any direction.” *Id.* at 11. Petitioner misreads our Decision.

¹ The Petition cites to pages 24–25, 51, 69, 96, and 171 after the block quote of claim 1, apparently to reference the amendments made to claim 1. Pet. 7–8. The Petition cites to pages 25–26 of the prosecution history when quoting the Examiner's reasons for allowance. Pet. 8–9.

Our conclusion as to the claim construction did not purport to construe the entire phrase “longitudinal axis of inertia of the handle” and only concluded that, “at a minimum,” the phrase requires a longitudinal axis that passes through the center of mass of the handle. Dec. 9. We did not suggest that the center of mass alone defined the axis, or further define the scope of “longitudinal axis of inertia.” Our limited construction was sufficient to address the issues raised by the Petition because Petitioner did not adequately establish that the prior art disclosed the limitation, so construed.

Ohtsubo

Petitioner also argues that Ohtsubo discloses the “10 to 20 degrees with respect to a longitudinal axis of inertia of the handle” limitation even under our construction. Reh’g Req. 13–15. Petitioner asserts that it preserved this argument by arguing in the Petition that “the center line of the gripping section of the handle as shown in Fig. 1(a) of Ohtsubo et al. is nearly identical to the ‘longitudinal axis of inertia of the handle’ shown in Fig. 7E of the ’282 patent.” *Id.* at 14 (quoting Pet. 19–20). We disagree. Arguing that the line shown in Ohtsubo “is nearly identical” to the line shown in Figure 7E does not indicate that Petitioner was using the Board’s construction, or Patent Owner’s, as a premise for the argument. Nor does the assertion identify the center of mass in Ohtsubo’s handle or argue that the line shown in Ohtsubo passes through the center of mass. Importantly, Petitioner only set forth one construction for the limitation in the Petition, and its arguments regarding the prior art relied on that construction. Pet. 10, 23–24. Nowhere does Petitioner assert, until now, that even under a narrower construction requiring a longitudinal axis of inertia passing through the center of mass of the handle as shown in Figure 7E, that Ohtsubo satisfies the limitation.

Based on the foregoing, we could not have overlooked Petitioner's argument that Ohtsubo discloses a longitudinal axis passing through the center of mass of the handle because Petitioner never made that argument in the Petition.

CONCLUSION

We have considered Petitioner's request for rehearing, but are not persuaded that we abused our discretion, or misapprehended or overlooked the arguments and evidence presented by Petitioner, in declining to institute an *inter partes* review.

ORDER

Accordingly, it is

ORDERED that Petitioner's request for rehearing of the Decision denying institution of an *inter partes* review of claim 1–6 of the '282 patent is *denied*.

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