

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PUNGKUK EDM WIRE MANUFACTURING COMPANY,
Petitioner,

v.

SEONG, KI CHUL,
Patent Owner.

Case IPR2016-00763
Patent 6,306,523 B1

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

DECISION
Denial of Request for Rehearing
37 C.F.R. § 42.71

INTRODUCTION

Pungkuk EDM Wire Manufacturing Company (“Petitioner”) filed a Corrected Petition (Paper 4, “Pet.”) requesting *inter partes* review of claims 1–18 of U.S. Patent No. 6,306,523 B1 (Ex. 1001, “the ’523 patent”). Seong, Ki Chul¹ (“Patent Owner”) filed a Corrected Preliminary Response (Paper 13, “Prelim. Resp.”). We instituted *inter partes* review on one ground, to determine whether claims 1–4, 6, 9–11, and 14–18 of the ’523 patent are anticipated by Mukherjee. Paper 14 (“Decision” or “Dec.”). We denied institution of review as to several other grounds after concluding that Petitioner failed to show a reasonable likelihood of prevailing as to those grounds. *Id.*

Petitioner filed a request for rehearing of our Decision, arguing that we erred by refusing to institute review to determine whether claims 1–4, 6, and 14–18 are anticipated by Takano. Paper 17 (“Req.”).

We will grant a request for rehearing of a petition decision if the requesting party demonstrates “an abuse of discretion” in the decision. 37 C.F.R. § 42.71(c). However, we will grant a request for rehearing only if it also “specifically identif[ies] . . . the place where each matter [that we misapprehended or overlooked] was previously addressed.” *Id.* § 42.71(d). After considering the Request for Rehearing, the Decision, and the evidence currently of record, we determine that Petitioner has not demonstrated an abuse of discretion. Accordingly, we deny the Request for Rehearing.

¹ Patent Owner also spells this name as “Sung, Ki Chul,” Prelim. Resp. 1, or “Ki Chul Song,” Paper 8, 3.

ANALYSIS

Petitioner argues that we misapprehended or overlooked Petitioner's arguments in support of the asserted anticipation of claims 1–4, 6, and 14–18 by Takano. Req. 1. In refusing to institute on this ground, we concluded that Petitioner had not shown sufficiently that Takano anticipates claims 1–4, 6, and 14–18 because Petitioner's argument required combining disclosures from multiple embodiments disclosed in Takano. Dec. 18. Petitioner now presents two arguments that this determination was an abuse of discretion. Req. 5–8.

1. Sufficiency of Comparative Example 2

Petitioner argues that a combination of Takano's Inventive Example 1 and Comparative Example 2 is not necessary, because Comparative Example 2 by itself anticipates the challenged claims. Req. 4–6. This argument was not previously presented in the Petition, which argued instead that some limitations of the challenged claims were disclosed by Takano Inventive Example 1, and others were disclosed by Takano Comparative Example 2. Pet. 28–34. Accordingly, we decline to consider this argument on a Request for Rehearing. 37 C.F.R. § 42.71(d).

2. Use of Takano Figures 1 and 2

Petitioner also argues that the Petition should be understood as arguing that all limitations of the challenged claims are disclosed by Comparative Example 2 of Takano, because the Petition cites to Figures 1 and 2 of Takano, and “[t]he Board has not asserted that FIGS. 1 and 2 are . . . are inconsistent with Comparative Example 2.” Req. 7. This argument ignores the statement in Takano that Figures 1 and 2 “are diagrams illustrating examples of . . . an electrode wire for wire discharge machining

according to the present invention.” Ex. 1003, 8 (emphasis added). Comparative examples typically fall outside the scope of a claimed invention, and we have been directed to no evidence suggesting that Takano’s Figures 1 and 2 represent Takano’s comparative examples. Accordingly, we are not persuaded that we abused our discretion by failing to understand the Petition as arguing that Figures 1 and 2 of Takano depict Takano’s Comparative Example 2.

We are not persuaded that we abused our discretion in determining that Petitioner’s argument with respect to anticipation by Takano improperly combined disclosures from multiple embodiments in Takano. Accordingly, we deny the Request for Rehearing as to the refusal to institute *inter partes* review on the ground of anticipation by Takano.

CONCLUSION

Upon consideration of the Request for Rehearing, the Decision, and the evidence currently of record, we determine that Petitioner has not demonstrated an abuse of discretion in our Decision. Accordingly, we deny the Request for Rehearing.

ORDER

It is hereby

ORDERED that the Request for Rehearing is denied.

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