

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 IPR2016-00764
Patent 6,492,036 B2

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

KOKOSKI, *Administrative Patent Judge*.

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

INTRODUCTION

On September 20, 2016, Pungkuk Wire Manufacturing Company (“Petitioner”) filed a Request for Rehearing (“Request” or “Req. Reh’g,” Paper 19) of our Decision (“Decision” or “Dec.,” Paper 16) instituting *inter partes* review of claims 1–10 of U.S. Patent No. 6,492,036 B2 (“the ’036 patent,” Ex. 1001). According to Petitioner, the Decision misapprehended and overlooked arguments and evidence demonstrating that the subject matter of claims 2, 5, 7, 8, and 10 is anticipated by Briffod,¹ and that the subject matter of claims 1–10 is anticipated by Takano.² Req. Reh’g 4–15.

Petitioner seeks reconsideration based on the following principal contentions: (a) the Board overlooked that Briffod discloses cracks in the alloy layer as required by claim 2 (Req. Reh’g 4–7); and (b) the Board misapprehended and/or overlooked Petitioner’s argument and evidence that Takano discloses all of the limitations of claims 1–10 (*id.* at 10–15).

We have reviewed Petitioner’s Request and carefully considered Petitioner’s arguments. Our decision on rehearing addresses the main arguments presented by Petitioner. We have, however, considered all of the arguments presented, including those not addressed specifically in this Decision. For the reasons discussed below, we deny Petitioner’s Request for Rehearing.

¹ Briffod, U.S. Patent No. 4,341,939, issued July 27, 1982.

² Takano, Japanese Patent App. Pub. No. S60-262930, published Dec. 26, 1985.

ANALYSIS

A request for rehearing must identify specifically all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d). Additionally, Petitioner, as the party challenging the Decision, has the burden of showing the decision should be modified. *Id.*

When rehearing a decision on a petition, the Board will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). 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.” *Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004) (citing *In re Gartside*, 200 F.3d 1305, 1315–16 (Fed. Cir. 2000)).

A. *Whether Briffod Discloses Cracks in the Alloy Layer*

Petitioner argues that the Board overlooked Petitioner’s arguments and evidence “establishing the presence of cracks in the alloy layer” in Briffod. Req. Reh’g 2. We are not persuaded by Petitioner’s argument.

Because Briffod film 2 is created “when copper from the core diffuses into the outer zinc layer as zinc from the outer layer diffuses into the core,” and “zinc diffuses faster into copper than copper into zinc” leaving “behind ‘voids’ in a part of the zinc layer that becomes the copper-zinc alloy,” Petitioner argues that “voids are necessarily present in the film 2 that corresponds to ‘the alloy layer’ of claim 2 of the ’036 patent.” Req. Reh’g 6. According to Petitioner, Briffod Figure 1b illustrates these “voids as small circles in the film 2,” confirming that voids are present on the surface and interior portions of film 2. *Id.*

As set forth in the Decision, we were not persuaded, based on the evidence presented, that Petitioner established sufficiently that Briffod discloses voids or cracks that are formed in the alloy layer. Dec. 19–20. Specifically, we stated that

Briffod describes the surface of thin film 3 as shown in Figure 1b (the claimed “coating layer,” according to Petitioner) as “very rough,” with “many holes of 1 to 2 μ which confirms the sponge-like structure suggested by the appearance of the surface.” [Ex. 1003, 4:8–15.] Briffod does not, however, describe the characteristics of film 2, which Petitioner contends is the “alloy layer” required by the claims. See Pet. 29 (quoting Ex. 1003, 2:55–56); *id.* at 30 (same). Petitioner does not provide any other evidence that shows sufficiently that Briffod discloses voids or cracks that are formed in the alloy layer.

Id. Therefore, we considered Petitioner’s arguments and evidence that cracks or voids are formed in Briffod film 2, and deemed it insufficiently persuasive. Moreover, with respect to Petitioner’s argument that Briffod Figure 1b “illustrates the Kirkendall voids as small circles in the film 2,” we note that Briffod describes Figure 1b as illustrating the Briffod invention “in a schematic manner” (Ex. 1003, 2:51–55), and does not explain what, if anything, the “small circles” drawn in film 2 signify. It is not an abuse of discretion to have made an analysis or conclusion with which a party disagrees.

As a result, we did not abuse our discretion in denying institution of *inter partes* review of claims 2, 5, 7, 8, and 10 on the asserted ground of unpatentability based on Briffod.

B. Whether Takano Anticipates Claims 1–10

Petitioner argues that we overlooked and misapprehended its arguments and evidence in determining that “Petitioner’s anticipation argument with respect to Takano requires combining disclosures” from Takano’s Example 1 and Comparative Example 2, which “is not a permissible way to argue anticipation.” Req. Reh’g 11 (quoting Dec. 23). We are not persuaded by Petitioner’s arguments.

First, Petitioner argues that “[r]eference to Example 1 is not required to show anticipation because Comparative Example 2, alone, shows all of the features of claims 1 and 6 of the ’036 patent.” Req. Reh’g 13. Petitioner does not point us to where this argument was made in the Petition; instead, Petitioner directs us to page 19 of the Petition, which is an overview of Takano. *Id.* at 12. In contrast, in the claim charts, which “show features of *Takano* that correspond to the claims of the ’036 patent,” Petitioner identifies Example 1 as disclosing some limitations of the claims, and Comparative Example 2 as disclosing others. *See, e.g.*, Pet. 33–34 (claim chart for claim 1). Per 37 C.F.R. § 42.71(d), Petitioner must point out where the matter was previously addressed in its Petition. We could not have overlooked argument or evidence that was not presented in the Petition. A request for rehearing is not an opportunity to supplement a petition.

Petitioner further argues that Takano Figures 1 and 2 “show the features of claim 1 for which Example 1 is cited.” Req. Reh’g 13. Petitioner argues that “[t]he Board has not suggested that FIGS. 1 and 2 are inconsistent with Comparative Example 2,” and, therefore, the Petition establishes that “FIGS. 1 and 2 of *Takano* also show that the embodiment of Comparative Example 2 generates an alloy layer between the brass center

and the zinc outer layer.” *Id.* at 14–15. Petitioner, however, ignores the statement in Takano that Figures 1 and 2 illustrate 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 Petitioner does not direct us to evidence suggesting that Takano Figures 1 and 2 represent Comparative Example 2. Additionally, although Petitioner does discuss Figures 1 and 2 in the Petition, Petitioner does not identify where in the Petition it made the argument that Figures 1 and 2 are “compatible” with Comparative Example 2.

As a result, we did not abuse our discretion in denying institution of *inter partes* review of claims 1–10 on the asserted ground of unpatentability based on Takano.

CONCLUSION

Petitioner has not carried its burden of demonstrating that our Decision misapprehended or overlooked any matters or that the Board abused its discretion. 37 C.F. R. § 42.71(d).

ORDER

In consideration of the foregoing, it is

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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