

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC., CANON U.S.A., INC.,
CANON FINANCIAL SERVICES, INC., FUJIFILM CORPORATION,
FUJIFILM HOLDINGS AMERICA CORPORATION,
FUJIFILM NORTH AMERICA CORPORATION, JVC KENWOOD
CORPORATION, JVCKENWOOD USA CORPORATION,
NIKON CORPORATION, NIKON INC., OLYMPUS CORPORATION,
OLYMPUS AMERICA INC., PANASONIC CORPORATION,
PANASONIC CORPORATION OF NORTH AMERICA,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2016-01223
Patent 8,504,746 B2

Before JONI Y. CHANG, JENNIFER S. BISK, and MIRIAM L. QUINN,
Administrative Patent Judges.

BISK, *Administrative Patent Judge.*

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

INTRODUCTION

Petitioner, listed above, filed a Request for Rehearing (Paper 11, “Request” or “Reh’g Req.”) of our decision denying institution of *inter partes* review (Paper 10, “Institution Decision” or “Inst. Dec.”). The Request contends that we misapprehended Petitioner’s position regarding disclosure of the claimed “analog signal acquisition channel.” Reh’g Req.

“When rehearing a decision on petition, a panel will review 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[,]” which party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

We grant Petitioner’s request insofar as we have reconsidered our analysis of whether Petitioner has shown that the prior art discloses the claimed “analog acquisition channel,” but we decline to modify our previous decision.

ANALYSIS

A. Background

In the Institution Decision, we found that the Petition did not show sufficiently that McNeill discloses or would have made obvious an “analog signal acquisition channel” as required by all the challenged claims. Inst. Dec. 10–13. In particular, we stated that

According to Petitioner, “[i]t is implicit and inherent for a scanner to have an analog signal acquisition channel for receiving a signal from analog source.” [Pet. 35.] Petitioner goes on to assert that a typical scanner, as of the priority date,

would produce a digital representation of an image and transmit that image “to an interface device (e.g. McNeill’s target computer) across a peripheral device communications channel, such as a SCSI bus or a parallel bus conforming to the IEEE 1284 standard.” *Id.* (citing Ex. 1306 ¶ 98). Nothing in this analysis, however, explains how the communications channel is an *analog* data acquisition channel. Nor does Petitioner point to anything else in McNeill that it is relying on for disclosure of such an analog data acquisition channel. *Id.*

Dec. 10–11.

Based on this language in the Institution Decision, Petitioner asserts that “the Board mistakenly believed that the Petition relied on the ‘communications channel’ connecting the scanner and the target computer of the McNeill prior art as the ‘analog signal acquisition channel.’” Reh’g Req. 1, 3. According to Petitioner, the Petition instead relied on “McNeill’s disclosure of a scanner that produces analog signals (via its CCD sensor), and transmits the analog signals to the analog-digital converter in the scanner, [which] necessarily also discloses an analog signal acquisition channel.” *Id.* at 5. Petitioner also contends that its reading of McNeill is confirmed by a decision instituting an *inter partes* review in a different proceeding challenging US Patent No. 8,966,144 B2 (“the ’144 patent”), which is related to the ’746 patent. *Id.* (citing Case No. IPR2016-01225, Paper 10, 25–26). Petitioner concludes that “[t]he Board, thus, should institute *inter partes* review of the ’746 patent for reasons similar to those presented for the ’144 patent.” *Id.* at 5–6.

We have considered Petitioner’s arguments, but do not agree that this proceeding should be instituted.

B. “analog signal acquisition channel”

Petitioner asserts that although McNeill does not expressly disclose the claimed “analog signal acquisition channel,” such an element is *inherently* disclosed by McNeill’s scanner. Reh’g Req. 3–5. Because McNeill’s scanner produces analog signals and then transmits those signals to an analog-to-digital converter, Petitioner asserts the scanner must “necessarily” include a channel connecting the analog sensor. *Id.* at 5 (citing Ex. 1306 ¶ 98). However, Petitioner’s evidence does not adequately support a finding of inherency.

Petitioner relies on expert testimony to support its assertion of inherency. First, Petitioner’s expert states that “[i]t is implicit and inherent for a scanner to have an analog signal acquisition channel for receiving a signal from analog source.” Reh’g Req. 4 (quoting Ex. 1306 ¶ 98). This sentence is exactly, word for word, the same as the sentence in the Petition it is relied upon to support. Pet. 35. Repetition of this legal conclusion in a declaration signed by a technical expert adds nothing to Petitioner’s attorney argument. It is not persuasive evidence. Second, both the Petition and the expert state that “[a] typical scanner at the priority date of the ’746 patent had a CCD and analog to digital circuitry to produce a digital representation of an image.” Pet. 35; Ex. 1306 ¶ 98. This statement does not adequately support a finding that the scanner discussed in *McNeill* necessarily discloses an analog signal acquisition channel. “Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981). This evidence goes only to a *typical* scanner, not all

scanners. Petitioner has not directed us to any other evidence supporting a finding of inherency.

And as noted in our Institution Decision (Inst. Dec. 11), the Petition does not address why a person of ordinary skill in the art would find the addition of an analog signal acquisition channel obvious based on McNeill's disclosure. The closest Petitioner gets to addressing this issue is in a statement that says "[a]dding an analog sensor to the 'exemplary system' of McNeill is inherent, but if it is not, a POSITA would find it obvious to do so." Pet. 35. This vague and conclusory statement, part of a section of the brief which does not even reference the term "analog signal acquisition channel," is insufficient to show that Petitioner is reasonably likely to prevail in showing that a limitation of the claim, not expressly disclosed in the reference, would have been obvious.

C. IPR2016-01225

We also do not agree with Petitioner's assertion that the institution of a review in IPR2016-01225 leads to a conclusion that we should institute *inter partes* review in this case. Petitioner does not address the differences in the claims between the '144 patent (challenged in IPR2016-01225) and the '746 patent, but those differences are significant. Most importantly, the '144 patent claims do not recite "an analog signal acquisition channel." Thus, whether such an element is disclosed by McNeill is not an issue in that case.

Accordingly, it is

ORDERED that Petitioner's Request for Rehearing is *granted* insofar as we have reconsidered our analysis of whether Petitioner has shown that

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the prior art discloses the claimed “analog acquisition channel,” but we decline to modify our previous decision not to institute trial in this proceeding.

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