

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLINOIS TOOL WORKS GLOBAL TIRE REPAIR INC.,
Petitioner,

v.

TEK GLOBAL S.R.L.,
Patent Owner.

Case IPR2016-01474
Patent 7,789,110 B2

Before BARRY L. GROSSMAN, KEVIN W. CHERRY, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Illinois Tool Works Global Tire Repair Inc. filed a Request for Rehearing (Paper 10, “Req. Reh’g”) of the Decision (Paper 9, “Dec.”) denying institution of an *inter partes* review of, *inter alia*, challenged claims 1–5, 23–27, and 29–31 of U.S. Patent No. 7,789,110 B2 (Ex. 1001, “the ’110 patent”).¹ Req. Reh’g 1. Petitioner argues that our Decision misapprehended the operation of Fogal’s three-way valve and wrongly concluded that the Petition failed to present a sufficient rationale for the proposed combination of Eriksen and Fogal. *Id.* at 4, 7. The Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs if the 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 P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). Further, 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).

III. ANALYSIS

Independent claim 1 recites “a three-way valve (81) input connected to said compressor assembly (2), and output connected to said container (3)

¹ Petitioner does not dispute our denial of an *inter partes* review with respect to challenged claims 11–15, 21, 22, or 28. *See, e.g.*, Req. Reh’g. 2; Dec. 1.

and to said additional hose (83) to direct a stream of compressed air selectively to said container (3) or to said additional hose (83).” See Ex. 1001, 5:56–61, 8:7–11 (reciting similar language in independent claim 26).² Our Decision concluded that the asserted prior art did not teach a three-way valve as claimed. Dec. 13–15. Specifically, we determined that “neither Eriksen nor Fogal teach a three-way valve that selectively directs a single stream of air to either of two outlets” because “each operative position of Fogal’s valve [124] includes a different inlet and only one outlet.” *Id.*

In the Request for Rehearing, Petitioner contends that we misapprehended the operation of Fogal’s valve 124. Req. Reh’g 4–6. Specifically, Petitioner argues that valve 124 satisfies our construction of “three-way valve”³ and, further, that it is irrelevant that the input to valve 124 varies between the valve’s two operative positions. *Id.* at 5–6 n.1. According to Petitioner, valve 124 “can selectively direct air from the tire to conduit 28 (in its first position) or from the air supply 26 to conduit 24 (in its second position).” *Id.* at 5.

We are unpersuaded by Petitioner’s argument. Although Petitioner is correct that the term “three-way valve,” as properly construed, “does not require that the input cannot vary depending on the operative condition,” (*id.* at 6 n.1), the express language of the remainder of claim 1 requires as much. Claim 1 explicitly recites “a three-way valve (81) *input connected to said compressor assembly (2)*, and output connected to said container (3) and to said additional hose (83) *to direct a stream of compressed air selectively to said container (3) or to said additional hose (83).*” See Ex. 1001, 5:56–61

² Although we discuss the language of claim 1 below, our analysis applies equally to claim 26.

³ “A valve having one input and two outputs.” Dec. 7.

(emphasis added). Therefore, the claim requires that the valve selectively direct compressed air from *a single recited input* (which is connected to compressor assembly 2) to either of *the two recited outlets* (which are connected to container 3 or additional hose 83). *Id.*; *see also* Pet. 27 (explaining that the valve of claimed tire repair kit “ha[s] an input line 80 for receiving air from the air compressor 2 and two output lines 83 and 82 for selectively directing compressed air to the container (via line 82) or, alternatively, directly to an inflatable article via an additional hose (line 83)”). Accordingly, claim 1 dictates that the input cannot vary; instead, the single input must direct a stream of compressed air selectively to one of two outlets.

The Petition does not demonstrate that Fogal’s valve 124 selectively directs compressed air from an input to one of two outlets, as claimed. Instead, as Petitioner admits, when directing compressed air from source 26, valve 124 directs air *only* to tire 13. Req. Reh’g 5; Ex. 1007, 13:3–6. In the valve’s alternate operative position, air is removed from tire 13 and passed through conduit 24, valve 124, and exhaust outlet 28, to deflate the tire. Req. Reh’g 5; Ex. 1007, 13:41–54. In this operative position, valve 124 does not direct compressed air from source 26 to any alternate outlet. Accordingly, we disagree with Petitioner that we misapprehended Fogal’s teachings.

Our Decision also determined that the Petition failed to present a sufficient rationale to modify Eriksen in view of Fogal. Dec. 15. In part, we were “unpersuaded that a person of ordinary skill in the art would have been motivated to modify Eriksen to ‘reduce the risk of sealant clogging the hose

in single hose tire repair kits’ . . . because the proposed modification merely alters the hose in which potential clogs may occur.” *Id.* at 15–16.

In the Request for Rehearing, Petitioner contends,

[the Board] misapprehend[ed] or overlook[ed] that in single hose systems, such as Eriksen, the clogging of its only hose results in the inability to use the tire repair kit for inflation (providing only air to the tire). By adding a second, dedicated air hose the clogging of the sealant hose does not affect the tire repair kit’s ability to function as an inflation device to provide compressed air to the tire via a dedicated air hose.

Req. Reh’g 7.

Petitioner’s argument is unavailing because Petitioner does not identify where the Petition presented this reasoning. *Id.* We could not have misapprehended or overlooked arguments that Petitioner did not present. Indeed, neither the relevant portion of the Petition nor the cited portion of the King Declaration explain that the provision of a “dedicated air hose” would allow the kit to be used for inflation, even if it could not be used for sealing, due to a clogged sealant hose. *Compare* Pet. 40 (stating only that the modification would “reduce the risk of sealant clogging the hose in single hose tire repair kits”), *with* Ex. 1005 ¶ 66 (same); *see also* Ex. 1014, 2:3–4 (acknowledging that sealant coagulates and hardens, but not discussing benefits of a dedicated air hose); Pet. 15–28 (discussing the state of the art and the ’110 patent, but not discussing the avoidance of clogs).

For all of the above reasons, Petitioner’s Request for Rehearing is *denied*.

Case IPR2016-01474

Patent 7,789,110 B2

PETITIONER:

Gregory Cordrey

JEFFER MANGELS BUTLER & MITCHELL, LLP

gcordrey@jmbm.com

PATENT OWNER:

Leo Lam

KEKER & VAN NEST LLP

llam@kvn.com