

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG INNOTEK CO., LTD.,
Petitioner,

v.

LEXINGTON LUMINANCE LLC,
Patent Owner.

Case IPR2017-00052
Patent 6,936,851 B2

Before JUSTIN T. ARBES, MIRIAM L. QUINN, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

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

I. INTRODUCTION

On May 1, 2017, LG Innotek Co., Ltd. (“Petitioner”) filed a Request for Rehearing (Paper 8, “Req. Reh’g”) of our Decision (Paper 7, “Dec.”) denying institution of *inter partes* review of claims 1–4 and 15–18 of U.S. Patent No. 6,936,851 B2 (Ex. 1001, “the ’851 Patent”) challenged in the Petition (Paper 2, “Pet.”). In particular, Petitioner requests a partial rehearing of our decision not to institute *inter partes* review for claims 1, 2, 4 and 15–18 as unpatentable over (1) Tadatomo¹ and (2) claim 4 as unpatentable over Tadatomo in view of Krames.² Req. Reh’g 3. Petitioner does not seek a rehearing of our decision not to institute *inter partes* review based on Petitioner’s asserted ground of unpatentability over Niki.³ *Id.*

For the reasons that follow, Petitioner’s request for rehearing is denied.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” The party requesting rehearing has the burden of showing that the decision from which rehearing is sought should be modified and “[t]he request must specifically identify all matters the party believes the Board misapprehended or

¹ PCT Publication No. WO 02/075821 (published Sept. 26, 2002) (Ex. 1007, 53–102, “Tadatomo”). Petitioner provides an English language translation of Tadatomo. Ex. 1007, 1–52 (“Petition Translation”).

² U.S. Patent No. 5,779,924 (issued July 14, 1998) (Ex. 1017, “Krames”).

³ U.S. Patent No. 6,870,191 B2 (filed July 24, 2002, issued March 22, 2005) (Ex. 1008, “Niki”).

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).

III. ANALYSIS

Independent claim 1 of the ’851 Patent recites a “textured district defined on the surface of said substrate comprising a plurality of etched trenches having a *sloped etching profile . . . without a prescribed angle of inclination.*” Ex. 1001, Reexamination Certificate, 1:28–30 (emphasis added). Independent claim 15 recites substantially the same limitation. *Id.* at 2:23–25. Based on the Specification and constructions in various infringement actions asserting the ’851 Patent, we interpreted the phrase “a sloped etching profile . . . without a prescribed angle of inclination” to mean “sloped etched sides without a specified angle of inclination.” Dec. 8–10. We determined that Petitioner’s argument that Tadamoto Figure 3(c) teaches a sinusoidal sloped etching profile was inconsistent with the entirety of the Petition Translation, which describes Figure 3(c) as having inclines or a triangular shape. *Id.* at 19–20. Consequently, we determined that Petitioner failed to establish a reasonable likelihood of prevailing on its assertions that claims 1, 2, 4, and 15–18 are unpatentable over Tadamoto, and that claim 4 is unpatentable over Tadamoto and Krames. *Id.* at 19–22.

Petitioner makes three arguments. First, Petitioner argues that the description in paragraph 67 of the Petition Translation is “unambiguous, and it is supported by the declaration of a professional translator, sworn under penalty of perjury.” Req. Reh’g 6–8. Petitioner further argues that the Petition Translation is the only translation in the record that complies with the Board’s rules regarding translations and Petitioner’s declarant, W.R. Bottoms, Ph.D., provides the only testimony “on how a [person having

ordinary skill in the art] would perceive this passage.” *Id.* According to Petitioner, we erred in substituting our “judgment for that of either the translator in offering the translation of [the relied upon] portion of Tadatomo, or Dr. Bottoms in opining on how a [person having ordinary skill in the art] would perceive this passage” and that, at a minimum, “the Petition has offered sufficient proof to establish a genuine issue of material fact as to Tadatomo’s disclosure of the claimed substrate surface shape, and, in doing so, compels institution, to enable testing of evidence-in-question.” *Id.* at 6–7 (citing 37 C.F.R. § 42.108(c)).

We are not persuaded that we misapprehended or overlooked the evidence regarding Tadatomo. Although Patent Owner argued that the Petition Translation was biased, we expressly declined to consider that issue. Dec. 20 n.11 (“Because the Petition Translation does not persuade us that Tadatomo teaches ‘a plurality of etched trenches having a sloped etching profile . . . without a prescribed angle of inclination,’ ***we need not address Patent Owner’s contentions that the Petition Translation is biased and the Reexamination Translation is accurate.***” (emphasis added)). Nor did we substitute our judgment for that of Dr. Bottoms and his understanding of the teaching of paragraph 67 of the Petitioner Translation. Instead, the Decision was based on Dr. Bottoms’ and Petitioner’s failure to address the Petition Translation’s other sections that describe Figure 3 as having inclined surfaces or planes, and triangular waves. Dec. 19–20. Stated differently, we assumed that the Petition Translation of paragraph 67 was accurate; however, the arguments and evidence presented in the Petition failed to provide sufficient reasoning and evidence to support Petitioner’s contention that Tadatomo, as a whole, teaches a plurality of etched trenches having a

sloped etching profile “without a prescribed angle of inclination” as recited in claims 1 and 15.

Second, Petitioner argues that only paragraph 67, cited by Petitioner and Dr. Bottoms, refers to Figure 3(c) while the sections cited in the Decision refer to Figure 3 generally or Figure 3(b). Req. Reh’g 8–9. Petitioner also argues that the sections of the Petition Translation cited in the Decision as being inconsistent with Petitioner’s arguments were not cited by Petitioner or Dr. Bottoms and, to the extent they are inconsistent, they “would not negate the fact that the clear language of the text of [paragraph 67] says that the surface features can have a ‘sinusoidal shape.’” *Id.* at 10–11.

That argument is not persuasive. As we found in the Decision, “Figure 3 is generically described as being ‘a schematic diagram illustrating a method for processing the texturing, having *inclined surfaces*, in the surface of the crystal substrate.’” Dec. 19 (quoting Ex. 1007, ¶ 45). Accordingly, the text describing Figure 3 generically describes each of the steps depicted in Figure 3, including Figure 3(c).

As for the description of Figure 3(b), we stated that “Figure 3(c) differs from Figure 3(b) in that it shows crystal layer 2 grown on layer 1. *See* Ex. 1007 ¶ 106. However, the relevant layer 1 is identical in both figures.” Dec. 20 n.10. Petitioner has not argued that this statement is incorrect. We properly considered the description of Figure 3(b) in assessing Petitioner’s arguments regarding Tadatomo.

Additionally, we did not err by focusing on the entire Petition Translation as opposed to the single sentence cited by Petitioner. As our reviewing Court has held, “a prior patent must be considered *in its entirety*,

i.e., as a whole, including portions that would lead away from the invention in suit.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 (Fed. Cir. 1987) (emphasis added); *see also In re Applied Materials, Inc.*, 692 F.3d 1289, 1298 (Fed. Cir. 2012) (“A reference must be considered for everything that it teaches, not simply the described invention or a preferred embodiment.”); *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965) (cited with approval in *Bausch & Lomb, Inc., Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986)) (“It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.”). The cases cited by Petitioner do not suggest looking only at some of the description of the prior art and ignoring those portions that further explain the embodiment being relied upon; to the contrary, consistent with *Panduit*, those cases also require a reference to be considered for **all** that it teaches, not just what one part teaches. *See Geo. M. Martin Co. v. Alliance Machine Sys. Int’l LLC*, 618 F.3d 1294, 1302–1303 (Fed. Cir. 2010) (“Even if a reference discloses an inoperative device, it is prior art **for all that it teaches.**” (emphasis added) (quoting *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989))); *In re Heck*, 699 F.2d 1331, 1332–33 (Fed. Cir. 1983) (“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, **relevant for all they contain.**” (emphasis added) (quoting *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968))). Accordingly, we did not err in considering the entirety of the Petition

Translation to determine what Tadatomo teaches, and not the single sentence relied on by Petitioner in isolation.

Third, Petitioner identifies other sections of the Petition Translation and Reexamination Translation⁴ that Petitioner contends supports its position that the surface of Tadatomo Figure 3(c) is sinusoidal. Req. Reh’g 11–13 (citing Petition Translation ¶¶ 28, 83, claim 5; Ex. 2003, 5:15–17, 14:23–26, 34:17–18).

We are not persuaded. We could not have misapprehended or overlooked something not cited in the initial Petition. Petitioner addressed the “without a prescribed angle of inclination” limitation at pages 18–22 of the Petition and paragraphs 15–26 of Dr. Bottoms’ declaration (Ex. 1003), neither of which cite the additional sections of the Petition Translation or the Reexamination Translation. Instead, Dr. Bottoms and the Petition focus on Figure 3(c) and the description at paragraph 67 of the Petition Translation.⁵ A request for rehearing is not an opportunity to supplement the initial Petition and rely on evidence not discussed in an initial petition, as we cannot have misapprehended or overlooked evidence not cited in the Petition. *See* 37 C.F.R. § 42.104(b)(4) (a petition must identify “[h]ow the construed claim is unpatentable under the statutory grounds identified” and “where each element of the claim is found in the prior art patents or printed publications relied upon”), 42.22(a)(2) (a petition must include a “full statement of the reasons for the relief requested, including a detailed

⁴ Ex. 2003.

⁵ The Petition and Dr. Bottoms also discuss Patent Owner’s infringement positions in district court litigation, which is not relevant to the instant Request for Rehearing.

explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent”).

IV. CONCLUSION

Petitioner has not carried its burden of demonstrating we misapprehended or overlooked any matters in our Decision denying institution of *inter partes* review of claims 1, 2, 4, and 15–18. *See* 37 C.F.R. § 42.71(d).

For the foregoing reasons, Petitioner’s Request for Rehearing is *denied*.

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