

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONE WORLD TECHNOLOGIES, INC.,
d/b/a TECHTRONIC INDUSTRIES POWER EQUIPMENT,
Petitioner,

v.

THE CHAMBERLAIN GROUP, INC.,
Patent Owner.

Case IPR2017-00126
Patent 7,161,319 B2

Before JONI Y. CHANG, JUSTIN T. ARBES, and JOHN F. HORVATH,
Administrative Patent Judges.

HORVATH, *Administrative Patent Judge.*

DECISION

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

I. INTRODUCTION

On October 15, 2018, we entered a Final Written Decision determining that One World Technologies, Inc. (“Petitioner”) had shown, by a preponderance of evidence, that claims 1–4, 7, 9–12, and 15 of U.S. Patent No. 7,161,319 B2 (Ex. 1001, “the ’319 patent”) are unpatentable, but had failed to show that claims 8 and 16 are unpatentable. Paper 54¹ (“Final Dec.”). On November 14, 2018, The Chamberlain Group (“Patent Owner”) filed a Request for Rehearing, asking us to reconsider our finding that claims 1–4, 7, 9–12, and 15 are unpatentable. Paper 60 (“Reh’g Req.”).² For the reasons discussed below, Patent Owner’s Request for Rehearing is *denied*.

II. ANALYSIS

A party requesting rehearing “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) (emphasis added). The burden of showing a decision should be modified on a request for rehearing lies with the party challenging the decision. *Id.*

Patent Owner argues we misapprehended or overlooked the following points in determining Petitioner had shown the unpatentability of claims 1–

¹ A public version of this sealed Final Written Decision was filed on October 24, 2018, as Paper 56.

² Prior to a decision on Patent Owner’s Request for Rehearing, both parties filed a notice of appeal from the Final Written Decision. Papers 62, 64. The parties subsequently moved to dismiss their appeals. On February 19, 2019, the U.S. Court of Appeals for the Federal Circuit granted the parties’ motion to dismiss the appeals, and remanded the case to the Board for decisions on the parties’ rehearing requests. The Federal Circuit’s Order issued as a mandate to the Board on the same day.

4, 7, 9–12, and 15 of the '319 patent: (1) the grounds of unpatentability raised in the Petition; and (2) the ability to rely on Applicant Admitted Prior Art (“AAPA”) in *inter partes* reviews. Reh’g Req. 1–2. We disagree for the reasons discussed below.

A. Procedural History

Given Patent Owner’s argument that we have misapprehended the grounds raised in the Petition, we provide the following procedural history of this case. In its Petition for review of the '319 patent, Petitioner requested we “find claims 1–4, 7, 8, 9–12, 15, and 16 unpatentable under § 103 as obvious over *Doppelt* in view of the *Admitted Art* and *Jacobs and/or Gilbert*.” Paper 1 (“Pet.”), 3 (additional emphasis added).

In its Preliminary Response to the Petition, Patent Owner characterized the Petition as challenging the patentability of claims 1–4, 7, 8, 9–12, 15, and 16 (“the challenged claims”) as “obvious over *Doppelt* in view of *Jacobs*, ‘*Admitted Art*,’ **and** *Gilbert*.” Paper 6, 14 (citing Pet. 38) (emphasis added). Despite this characterization, Patent Owner argued the Petition should be denied because in challenging claim 1, Petitioner “contends that all but two of the recited features are disclosed by two or more of the references,” and “cites to *Jacobs and/or Gilbert* without identifying deficiencies in *Doppelt* for which these references are applied.” *Id.* at 17, 19 (emphasis added). As a result, Patent Owner argued Petitioner’s failure to identify clearly how each claim limitation is allegedly taught by the cited art “prejudices Patent Owner and . . . leaves Patent Owner without a clear understanding of the ground being advanced.” *Id.* at 23.

In our Institution Decision, we addressed Patent Owner’s concerns regarding the ambiguity in Petitioner’s challenging the claims as obvious over Doppelt, AAPA, Jacobs “*and/or*” Gilbert. Specifically, we found Petitioner’s analysis was not “so unclear that it has prejudiced Patent Owner by forcing Patent Owner to speculate as to the particular combination of references Petitioner has relied upon.” Paper 8 (“Dec. Inst.”), 19 (citing Pet. 38–44, 58). We did so because “Petitioner’s reliance on Gilbert is contingent on our explicitly construing the term *wall console* to not require an IR detector,” and because “Petitioner provides separate rationales for combining Doppelt, AAPA, and Jacobs, and for combining Doppelt, AAPA, Jacobs, and Gilbert.” *Id.* Although we instituted review based on the ground of obviousness over (1) Doppelt, AAPA, and Jacobs, we denied review on the additional grounds of obviousness over (2) Doppelt, AAPA, Jacobs, and Gilbert, and (3) Doppelt, AAPA, and Gilbert implied by Petitioner’s use of “*and/or*” in the grounds raised in the Petition. Dec. Inst. 20–21.

Subsequent to our Institution Decision, Patent Owner filed a Response to the Petition. *See* Paper 11 (“PO Resp”). In its Response, Patent Owner did not maintain its argument that the Petition raised an ambiguous ground, and did not argue that the only ground raised in the Petition was obviousness over Doppelt, AAPA, Jacobs, and Gilbert. *Id.* at 1–54. Additionally, the Supreme Court issued its decision in *SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348, 1354 (2018), holding that when *inter partes* review is instituted, “the Board *must* address *every* claim the petitioner has challenged.” In response to the SAS decision, the Director issued *Guidance on the impact of SAS on*

*AIA trial proceedings.*³ The *Guidance* indicated that when the Board institutes *inter partes* review, it will institute review of all challenged claims on “all challenges raised in the petition.” The *Guidance* further indicated that for pending trials not instituted on all grounds or challenges raised in the petition, “the panel *may* issue an order supplementing the institution decision to institute on all challenges.” *Id.* When this occurs, “the petitioner and patent owner shall meet and confer to discuss the need for additional briefing,” and “may agree to affirmatively waive additional briefing or schedule changes.” *Id.*

In view of SAS and the Director’s *Guidance*, we emailed the parties requesting their availability for a conference call to discuss “whether either party would like to present additional briefing on the patentability of the challenged claims based on the combinations of (1) Doppelt, AAPA, and Gilbert, and (2) Doppelt, AAPA, Jacobs and Gilbert.” Ex. 3006. During the subsequent call, we asked the parties to meet and confer to (a) identify any non-instituted grounds raised in the Petition and the claims that pertain to such grounds, (b) determine whether additional briefing was needed to address any such non-instituted grounds and claims, and (c) determine whether the parties agree on how to proceed with respect to non-instituted grounds, including by agreeing to withdraw such grounds. See Paper 39, 3. In response, the parties sent a joint email to the Board indicating “they had *reached agreement* that the only *non-instituted* ground in this proceeding was Petitioner’s challenge to the patentability of claims 1–4, 7–12, 15, and 16 under 35 U.S.C. § 103(a) as obvious over Doppelt, AAPA, Jacobs, and

³ Available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

Gilbert.” *Id.* at 4 (citing Ex. 3003) (emphases added). Consequently, we modified our Institution Decision to *include* review of claims 1–4, 7–12, 15, and 16 as obvious over Doppelt, AAPA, Jacobs, and Gilbert. *Id.* at 5. We also issued a Supplemental Scheduling Order granting the parties the opportunity to file supplemental briefing on this *additional* ground. Paper 42, 2–3.

Patent Owner filed a Supplemental Response to the Petition, arguing for the first time post-institution of trial that the grounds raised in the Petition were ambiguous, and arguing in a footnote that “[t]hese failings are fatal to the Petition, which as discussed in the Preliminary Response, proposed ‘only a single ground—namely obviousness over Doppelt in view of Jacobs, ‘Admitted Art,’ And Gilbert.’” Paper 45 (“PO Supp. Resp.”), 21 n.3.

B. Grounds Raised in the Petition

Patent Owner argues that we misapprehended the grounds raised in the Petition by finding Petitioner had challenged the patentability of claims 1–4, 7–12, 15, and 16 as obvious over Doppelt, AAPA, and Jacobs. Reh’g Req. 9–15. Patent Owner sets forth numerous arguments to explain how we allegedly misapprehended the grounds raised in the Petition. *Id.* Before addressing the merits of these arguments, we note the following findings made in our Final Written Decision:

1. Patent Owner did not argue in its Response to the Petition that the Petition did not raise obviousness over Doppelt, AAPA, and Jacobs. Final Dec. 17. Therefore, Patent Owner waived that argument. *Id.* at 18; *see also* Paper 9, 2–3 (“The patent owner is

cautioned that any arguments for patentability not raised in the response will be deemed waived.”).

2. The parties agreed via email that the only non-instituted ground in our Institution Decision was obviousness over Doppelt, AAPA, Jacobs, and Gilbert. Final Dec. 17–18; Ex. 3003. That email was sent by Mr. Bregman (counsel for Petitioner) and had a joint signature line that included Mr. Bregman and Mr. Monaldo (counsel for Patent Owner). Final Dec. 17 n.7. Mr. Monaldo was copied on the email, and, in a subsequent call with the parties, did not object to the inclusion of his name on the joint signature line or argue that the email misrepresented the parties’ agreement or was in any way misleading. *Id.*
3. Patent Owner’s argument in its Supplemental Response to the Petition that the only ground raised in the Petition was obviousness over Doppelt, AAPA, Jacobs, and Gilbert was improper because it incorporated by reference an argument made in Patent Owner’s Preliminary Response, and our rules prohibit the incorporation of arguments by reference. *Id.* at 18–19 (citing 37 C.F.R. § 42.6(a)(3)).
4. The Petition supports the separate grounds of obviousness over (1) Doppelt, AAPA, and Jacobs, and (2) Doppelt, AAPA, Jacobs, and Gilbert because the Petition provides separate rationales for combining the references in each of these grounds, and because the Petition relies on Gilbert in a purely conditional manner that depends on our construction of the term “wall console.” *Id.* at 19–20.

5. Ignoring the ground of obviousness over Doppelt, AAPA, and Jacobs raised in the Petition would require us to ignore the substantive analysis provided for this ground in the Petition. *Id.* It would also require us to rewrite Petitioner’s challenge of obviousness over Doppelt, AAPA, Jacobs “*and/or*” Gilbert to a challenge of obviousness over Doppelt, AAPA, Jacobs “*and*” Gilbert. *Id.* Doing so would be contrary to the Supreme Court’s SAS instruction that “Congress chose to structure a process in which it’s the petitioner . . . who gets to define the contours of the proceeding.” *Id.*

In its Request for Rehearing, Patent Owner does not allege that any of these findings were erroneous. *See* Reh’g Req. 9–15. Nor does Patent Owner explain how we misapprehended any matter in the Final Written Decision by identifying, for each of the arguments raised in the Request for Rehearing, “the place where each matter was previously addressed in a motion, an opposition, or a reply” as required by our rules. 37 C.F.R. § 42.71(d). A request for rehearing is not an opportunity to present new arguments or evidence. For this reason alone, Patent Owner has failed to establish that we misapprehended the grounds raised in the Petition. Moreover, Patent Owner’s arguments are unavailing for the reasons that follow.

Patent Owner’s first argument for how we allegedly misapprehended the grounds raised in the Petition is that a literal reading of the ground raised—obviousness over *Doppelt* in view of the *Admitted Art* and *Jacobs* and/or *Gilbert*—would require institution on three grounds: obviousness over (1) Doppelt, Jacobs, and AAPA; (2) Doppelt, Jacobs, AAPA, and

Gilbert; and (3) Doppelt, AAPA, and Gilbert. Reh’g Req. 11–12. Patent Owner does not identify where this argument was previously presented in a motion, opposition, or reply as required by our rules. Instead, Patent Owner cites to our Order modifying the Institution Decision (Paper 39). *Id.* Thus, Patent Owner’s argument is unpersuasive for this reason alone. We cannot have misunderstood an argument Patent Owner did not previously make.

We also note that our Institution Decision expressly identified and considered all three grounds Patent Owner enumerates in its Request for Rehearing as grounds raised in the proceeding. *See* Dec. Inst. 20–21. Nonetheless, we instituted trial on only the first ground, denying institution on the second and third grounds. *Id.* We confirmed this understanding of the grounds raised in the Petition in our post-SAS email to the parties by expressly identifying the second and third grounds as grounds that had been raised but denied in our Institution Decision. *See* Ex. 3006 (inviting the parties to a conference call to discuss “whether either party would like to present additional briefing on the patentability of the challenged claims based on the combinations of (1) Doppelt, AAPA, and Gilbert, and (2) Doppelt, AAPA, Jacobs, and Gilbert”). Thus, throughout this proceeding, we have consistently recognized the three grounds Patent Owner identifies as logically resulting from Petitioner’s challenge to the patentability of the claims as obvious over Doppelt, AAPA, Jacobs “*and/or*” Gilbert.

Although we subsequently modified our Institution Decision to only include Petitioner’s challenge of obviousness over Doppelt, AAPA, Jacobs, and Gilbert, we did so “based on the *parties’* agreement that the only non-instituted ground was the challenge to the patentability of claims 1–4, 7–12,

15, and 16 under 35 U.S.C. § 103(a) as obvious over Doppelt, AAPA, Jacobs, and Gilbert.” Paper 39, 5 (emphasis added); *see also* Ex. 3003. That is, we modified our Institution Decision to *include the additional ground* of obviousness over Doppelt, AAPA, Jacobs, and Gilbert as the only *previously non-instituted ground* raised in the Petition based on the joint agreement of Patent Owner and Petitioner that this was the only previously non-instituted ground. *See* Ex. 3003.

Patent Owner next argues that Petitioner “put to rest any notion that the ‘and/or’ included in the Petition’s [ground] was intended to express multiple grounds” when Mr. Bregman (counsel for Petitioner) emailed the Board confirming that “the singular non-instituted ground in this proceeding was ‘1. Whether claims 1–4, 7–12, 15, and 16 are rendered obvious by Doppelt, Applicant Admitted Prior Art, Jacobs, and Gilbert.’” Reh’g Req. 12 (quoting Ex. 3003). Patent Owner further argues that because the email did not identify the ground of obviousness over Doppelt, AAPA, and Gilbert, “Petitioner has confirmed that the [ground raised], including the ‘and/or’ that logically would have resulted in a combination including Doppelt, AAPA, and Gilbert, **was a mistake**.” *Id.* at 13.

Once again, Patent Owner does not identify where this argument was previously presented in a motion, opposition, or reply as required by our rules. *Id.* at 12–13. Instead, Patent Owner cites to the parties’ joint email to the Board identifying Doppelt, AAPA, Jacobs, and Gilbert as the only previously non-instituted ground, and our Order modifying the Institution Decision (Paper 39). *Id.* Thus, the argument is unpersuasive for this reason alone. We cannot have misunderstood an argument Patent Owner did not previously make.

Moreover, Patent Owner's argument is contradicted by finding 2 above. See Final Dec. 17; Ex. 3003, 1. Specifically, to bring our Institution Decision in compliance with SAS and the Director's *Guidance*, we requested both Patent Owner and Petitioner to discuss whether either party would like to present additional briefing on the previously non-instituted grounds of (1) Doppelt, AAPA, and Gilbert, and (2) Doppelt, AAPA, Jacobs, and Gilbert. Ex. 3006. During the conference call, conducted on April 30, 2018, we requested both Patent Owner and Petitioner to "(1) identify any non-instituted grounds raised in the Petition and the claims that pertain to such grounds, (2) determine whether additional briefing was needed to address any such non-instituted grounds and claims, and (3) determine whether the parties agree on how to proceed with respect to such non-instituted grounds, including by agreeing to withdraw such grounds." Paper 39, 3.

In response to our request, Patent Owner and Petitioner jointly submitted an email ("Written Agreement") sent by Mr. Bregman (counsel for Petitioner) on which all of the attorneys representing Patent Owner were copied. See Ex. 3003, 1 (copying Messrs. Karl Renner, Jeremy Monaldo, Jack Wilson, and Josh Griswold). The body of that email expressly states that "[t]he *Parties agree* the *non-instituted* ground in this proceeding is as follows: 1. Whether claims 1–4, 7–12, 15, and 16 are rendered obvious by Doppelt, Applicant Admitted Prior Art, Jacobs, and Gilbert." *Id.* (emphasis added). Moreover, the email includes the *joint signature line* "Regards, Dion Bregman (Petitioner) and Jeremy Monaldo (Patent Owner)." *Id.* Thus, this Written Agreement clearly indicates to the Board that both Patent Owner and Petitioner *agreed* that there was only one previously *non-*

instituted ground in this proceeding—obviousness over Doppelt, AAPA, Jacobs, and Gilbert.

In short, either Patent Owner’s present argument, or Patent Owner’s Written Agreement, misrepresents Patent Owner’s position on the grounds raised in the proceeding, including the previously non-instituted grounds. *See* 37 C.F.R. § 42.12. Furthermore, if the Written Agreement was not Patent Owner’s actual position on the previously non-instituted grounds, Patent Owner failed to comply with both our request to identify previously non-instituted grounds and our Order modifying our Institution Decision to *include* previously non-instituted grounds. Ex. 3006; Paper 39, 3 (“Emphasizing the need to resolve these issues prior to the May 4, 2018 statutory deadline for issuing a Final Written Decision, we asked the parties to jointly report back to us by the close of business on May 1, 2018.”). Patent Owner had multiple opportunities to respond to our request to identify the previously non-instituted grounds or to correct its Written Agreement identifying the previously non-instituted grounds, such as by notifying us during the conference call on April 30, 2018 or the follow-up conference call on May 2, 2018, or by timely filing a request for rehearing of the Order modifying the Institution Decision.⁴ Patent Owner did not do so, and a request for rehearing of the Final Written Decision is not an opportunity for Patent Owner to present late argument or to retract the joint representation made by Patent Owner and Petitioner in the Written Agreement that the *only*

⁴ Patent Owner had an opportunity to file a request for rehearing our Order modifying the Institution Decision under 37 C.F.R. § 42.71(d) within 14 days of the entry of the Order. Patent Owner did not file a timely request for rehearing the Order.

previously non-instituted ground was obviousness over Doppelt, AAPA, Jacobs, and Gilbert.

Finally, Patent Owner argues “the Petition’s discussion of the Doppelt/Jacobs/Admitted Art/Gilbert ground makes it abundantly clear that Petitioner’s original contentions, as set forth in the Petition itself, included only that singular non-instituted ground, and no other.” Reh’g Req. 13 (emphasis omitted). Patent Owner argues that this is so because the Petition’s discussion of claim limitations “to which Gilbert was mapped concludes with an assertion that the ‘Doppelt/Jacobs/Gilbert’ system discloses the feature.” *Id.* Patent Owner further argues that “the Petition nowhere provides a mapping in which Doppelt is modified based on admitted art and Jacobs, without Gilbert.” *Id.* at 14. Once again, Patent Owner does not identify where these arguments were previously presented in a motion, opposition, or reply as required by our rules. Instead, Patent Owner cites to the Petition itself. *Id.* at 13–14. Thus, Patent Owner’s argument is unpersuasive for this reason alone. We cannot have misunderstood an argument Patent Owner did not previously make.

Moreover, Patent Owner’s arguments are contradicted by findings 3–4. *See* Final Dec. 18–20. Specifically, the only argument Patent Owner ever made post-institution that the only ground raised in the Petition was obviousness over Doppelt, AAPA, Jacobs, and Gilbert was made in Patent Owner’s Supplemental Response, which incorporated the argument by reference from Patent Owner’s Preliminary Response. *See* PO Supp. Resp. 21. Our rules prohibit incorporating arguments by reference. *See* Final Dec. 18–19 (citing 37 C.F.R. § 42.6(a)(3)). Patent Owner does not dispute this or allege that this was error. Nor does Patent Owner dispute or allege error in

our finding 4 that the Petition supports consideration of the ground of obviousness based on Doppelt, AAPA, and Jacobs because it gives a separate rationale for combining these references, and relies on Gilbert in a purely conditional manner that depends on our construction of the term “wall console.” *Id.* at 19–20. For example, the Petition states a skilled artisan “would have recognized that the combined system (of *Doppelt*, *Jacobs*, and *Admitted Art*) using the[] well-known components [described in the Petition] would benefit users with increased programmability and control over their garage door system.” Pet. 42–43 (quoted in Final Dec. 19–20).

For the reasons discussed above, Patent Owner has failed to demonstrate that we misapprehended the grounds raised in the Petition.

C. Availability of AAPA in Inter Partes Reviews

Patent Owner argues our Final Written Decision “incorrectly concluded that the AAPA relied on by Petitioner is eligible for” *inter partes* review. Reh’g Req. 3. Patent Owner argues this “incorrect conclusion stems from misapprehension of Federal Circuit jurisprudence on use of AAPA in reexamination proceedings, misapprehension of regulations adopted by the Director, and misapprehension of the statutory framework of 35 U.S.C. § 311(b).” *Id.*

Before addressing the merits of Patent Owner’s arguments, we note the following findings of fact and conclusions of law made in our Final Written Decision:

6. The Federal Circuit, and its predecessor, the Court of Customs and Patent Appeals, have long held that admissions in a patent may be considered prior art for any purpose, including as evidence of obviousness under 35 U.S.C. § 103. Final Dec. 37 (quoting *In re*

Nomiya, 509 F.2d 566, 570–71 (CCPA 1975); citing *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988)).

7. Patent Owner admitted, in the “Background of the Invention” section of the ’319 patent, that it was known to use infrared detectors in garage door operators to detect the presence of people. *Id.* at 35.
8. This admission, made in Patent Owner’s own patent, is the evidence cited by Petitioner to prove the prior existence and use of infrared detectors in garage door operators. *Id.* at 37, 45–46.
9. This admission is quite literally *prior art consisting of patents* because the admission itself is prior art, and the evidence proving the admission consists of Patent Owner’s own patent. *Id.*

Patent Owner does not dispute any of these findings of fact or conclusions of law, or argue that they are erroneous or that we misapprehended them. *See* Reh’g Req. 2–9. For this reason alone, Patent Owner has failed to show that we erred in concluding that AAPA is eligible for use in *inter partes* reviews.

Nonetheless, Patent Owner argues that we allegedly misapprehended the use of AAPA in *inter partes* reviews because we misapprehended a pair of Federal Circuit cases concerning pre-AIA⁵ reexamination proceedings in concluding that the phrase “*prior art consisting of patents or printed publications*” in 35 U.S.C. § 311(b) can include AAPA. *Id.* at 4–5. Patent Owner argues the first case, referred to as *NTP1*,⁶ does not mention AAPA,

⁵ Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”).

⁶ *In re NTP, Inc.*, 654 F.3d 1268 (Fed Cir. 2011).

and the second case, referred to as *NTP2*,⁷ does not mention limiting the evidence that can be used in pre-AIA reexamination proceedings to *prior art consisting of patents or printed publications*. *Id.* at 4. Patent Owner argues because neither *NTP* case “endorsed a ground involving AAPA, against an argument that AAPA was ineligible for use in a reexamination proceeding,” the Federal Circuit “did not (and could not) find that AAPA was eligible under the pre-AIA reexamination statute, must less create precedent for future cases.” *Id.* at 4–5 (citing *Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1581 (Fed. Cir. 1991)).

As discussed above, our conclusion that AAPA is eligible for use in *inter partes* review proceedings did not rely on the *NTP* cases. Instead, it relied on findings 6–9 above, namely, that AAPA is an admission in a patent, and that an admission is *prior art* that can be used as evidence of obviousness. Final Dec. 35, 37 (quoting *Nomiya*, 509 F.2d at 570–71). Thus, AAPA is prior art (per *Nomiya*) consisting of a patent (the ’319 patent), and is eligible for use in *inter partes* reviews. *Id.* at 36–37. Patent Owner does not dispute these findings.

In our Final Written Decision, we rely on the pre-AIA reexamination statute (35 U.S.C. §§ 301, 302 (1980)), and the *NTP* cases as persuasive authority that supports our conclusion that AAPA can be used to challenge claims in *inter partes* reviews. Indeed, the *NTP* cases can only be considered persuasive authority because they involved *ex parte* reexaminations rather than *inter partes* reviews. Patent Owner does not dispute our finding that the pre-AIA reexamination statute, like the *inter*

⁷ *In re NTP, Inc.*, 654 F.3d 1279 (Fed. Cir. 2011).

partes review statute, limits the evidence that can be used to challenge claims of an issued patent to “*prior art consisting of patents or printed publications.*” See Final Dec. 37–38 (citing 35 U.S.C. § 301 (1980); *NTP1* at 1275). Patent Owner also does not dispute that in *NTP2*, the Federal Circuit affirmed the rejection of claims in a pre-AIA reexamination based in part on AAPA; specifically finding the AAPA provided “substantial evidence [that] supports the Board’s finding” that the re-examined claims were unpatentable. *Id.* at 38 (citing *NTP2* at 1304). Thus, as we explained in our Final Written Decision, the Federal Circuit in *NTP2* did in fact find that AAPA can be used in pre-AIA *ex parte* reexaminations, despite the evidentiary limitation that claims in such proceedings can only be challenged based on *prior art consisting of patents or printed publications.* *Id.* Although *NTP2* is not precedential authority on that point for the reasons identified in Patent Owner’s Request for Rehearing, it is nonetheless persuasive authority that supports our conclusion that AAPA is prior art consisting of patents under 35 U.S.C. § 311(b). *Id.* at 37–38.

Patent Owner next argues that we misapprehended the rules and regulations for conducting *inter partes* reviews adopted by the Director. Reh’g Req. 5–7. Specifically, Patent Owner argues that our finding that Rule 42.104 must be read as a whole, and that Rule 42.104(b)(4) cannot be read in isolation to contradict the related statutory and regulatory provisions for *inter partes* review, was erroneous because “nothing about Rule 42.104(b)(4) contradicts Rule 42.104(b)(2) or the statute.” Reh’g Req. 6. Rather, Patent Owner argues, “Rule 42.104(b)(4) informs the statutory text and clarifies that, when the statute mentions ‘prior art consisting of patents,’

it is referring to ‘prior art patents.’” *Id.* We are not persuaded by Patent Owner’s arguments.

Rule 42.104 sets forth the requirements for a petition for *inter partes* review, and states the petition must “set forth . . . [t]he specific statutory grounds under 35 U.S.C. 102 or 103 on which [a] challenge to [a] claim is based and the *patents or printed publications* relied upon for each ground.” 37 C.F.R. § 42.104(b)(2) (emphasis added). This language is consistent with the statutory language limiting the scope of *inter partes* reviews to those based “only on a ground that could be raised under section 102 or 103 and only on the basis of *prior art consisting of patents or printed publications.*” 35 U.S.C. § 311(b) (emphasis added). We see no basis to read the statute, which is clear on its face, to limit the evidence that is available in *inter partes* reviews to “prior art consisting of [*prior art*] patents or printed publications,” as Patent Owner contends, by inserting the term *prior art* into the statutory language. *See Lamie v. U.S. Trustee*, 540 U.S. 526, 538 (2004) (refusing to read the word “attorney” into a bankruptcy statute because “[t]here is a basic difference between filling a gap left by Congress’ silence and rewriting rules that Congress has affirmatively and specifically enacted”).

Rule 42.104 also requires the petition to set forth how a “construed claim is unpatentable under the *statutory grounds identified in paragraph (b)(2) of this section.* The petition must specify where each element of the claim is found in the *prior art patents or printed publications* relied upon.” 37 C.F.R. § 42.104(b)(4) (emphases added). As we noted in our Final Written Decision, Rule 42.104 must be read as a whole. *See* Final Dec. 39–40. Thus, section (b)(4) must be read consistently with section (b)(2) to

which it expressly refers. *Id.*; see also *Phipps v. Dep't of Health and Human Services*, 767 F.2d 895, 897 (Fed. Cir. 1985) (reading different sections of employment regulations to effect “the true meaning and intent of the regulations *read as a whole*”) (emphasis added). Section (b)(4) must also be read consistently with the statutory language of 35 U.S.C. § 311(b). See *Manhattan Gen. Equip. Co. v. Comm’r of Internal Revenue*, 297 U.S. 129, 134 (1936) (finding a regulation that “create[s] a rule out of harmony with [a] statute, is a mere nullity”). Read as a whole, and consistently with 35 U.S.C. § 311(b), Rule 42.104 allows a petitioner to challenge claims based on *prior art consisting of patents or printed publications*, i.e., based on *prior art* that consists of *patents or printed publications*. See Final Dec. 39–40.

Patent Owner cites to a number of prior Board decisions in support of its position that AAPA cannot be used to challenge claims in *inter partes* reviews. Reh’g Req. 7. We have previously considered and rejected this argument. As noted in both our Institution Decision and Final Written Decision, the Board decisions cited by Patent Owner are both non-precedential and distinguishable, and many other Board decisions have not only instituted trial based on AAPA, but have found claims to be unpatentable on that basis. See Dec. Inst. 8–9; Final Dec. 40–41. Patent Owner does not dispute these findings, or show that they are erroneous; it merely repeats an argument that has already been twice considered and twice rejected.

Finally, Patent Owner argues that we misapprehended the statutory framework of 35 U.S.C. § 311(b). Reh’g Req. 7–9. Specifically, repeating another argument we have already considered and rejected, Patent Owner argues that by allowing “statements of the patent owner” in the AIA

reexamination statute (35 U.S.C. § 301 (2011)), without similar inclusion in the *inter partes* review statute (35 U.S.C. § 311 (2011)), Congress expressed its intent to keep § 311(b) narrower. *Id.* at 8. Patent Owner does not identify how we erred in rejecting this argument in the Final Written Decision, as required by our rules. *See* Reh’g Req. 7–9. The argument is therefore unpersuasive for this reason alone.

Instead, Patent Owner attempts to bolster this previously presented and rejected argument by newly citing *Hamdan v. Rumsfeld*, 548 U.S. 557, 578 (2006), for the proposition that “a negative inference may be drawn from the exclusion of language from one statutory provision that is included in other provisions of the same statute,” and *Russello v. United States*, 464 U. S. 16, 23 (1983), for the proposition that “‘where Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.’” However, Patent Owner fails to mention, let alone address, the discussion in our Final Written Decision of the different evidentiary scopes expressed in 35 U.S.C. §§ 301 and 311. *See* Final Dec. 38–39. Patent Owner similarly fails to explain how our interpretation of those different evidentiary scopes was erroneous.

In particular, our Final Written Decision explains that Congress amended the pre-AIA reexamination statute to “allow reexaminations to be based on *both* ‘prior art consisting of patents or printed publications’ *and* ‘statements of the patent owner filed in a proceeding before [a Federal Court or] the Office in which the patent owner took a position on the scope of any claim.’” Final Dec. 38 (emphases added). Thus, rather than *limiting* the evidence that can be used in *inter partes* reviews, Congress’ amendment of

35 U.S.C. § 301 *broadens* the evidence that can be used in post-AIA reexamination proceedings to *include* statements made by the patent owner *in addition to* prior art consisting of patents or printed publications. *Id.* Thus, “the amendment allows the use of a patent owner statement made in an office action response, even when the prosecution history is not open to the public, and the office action response cannot be considered a ‘printed publication.’” *Id.* at 39. It also allows the use of patent owner statements made in District Court claim construction proceedings, even though those statements may not be printed publications.

Patent Owner does not dispute that we gave different interpretations to the evidence that can be used in post-AIA *ex parte* reexaminations under 35 U.S.C. § 301 and *inter partes* reviews under 35 U.S.C. § 311, or argue that our different interpretations failed to give meaningful effect to the different language used by Congress in the different statutes. Indeed, Patent Owner admits that “Congress amended 35 U.S.C. § 301 to *expand* the scope of information that may be cited in support of an *ex parte* reexamination to include ‘statements of the patent owner.’” Reh’g Req. 8–9. This is the exact point we raised in our Final Written Decision, which Patent Owner has not disputed or shown to be erroneous. *See* Final Dec. 38–39.

III. CONCLUSION

For the reasons discussed above, Patent Owner has failed to demonstrate that we misapprehended or overlooked any matters in the Final Written Decision as required by 37 C.F.R. § 42.71(d). Accordingly, we deny Patent Owner’s Request for Rehearing.

IV. ORDER

It is ORDERED that Patent Owner’s Request for Rehearing is *denied*.

IPR2017-00126
Patent 7,161,319 B2

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