

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELANESE INTERNATIONAL CORPORATION,
Petitioner,

v.

DAICEL CORPORATION,
Patent Owner.

Case IPR2017-00165
Patent 9,073,843 B2

Before SHERIDAN K. SNEDDEN, ZHENYU YANG, and
TINA E. HULSE, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

An *inter partes* review was instituted in the above referenced case. Paper 7 (“Decision”). Daicel Corporation (“Patent Owner”) requested rehearing of our Decision. Paper 10 (“Request”). In its Request, Patent Owner contends that the Board should reconsider its decision to institute on the ground of anticipation of challenged claims 1–4, 6–10, and 12 by Patt. Request 1.

Pursuant to our authorization, Celanese International Corporation (“Petitioner”) filed an opposition. Paper 15.

For the reasons set forth below, Patent Owner’s request for rehearing is denied.

II. STANDARD OF REVIEW

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision [i]s based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co., Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). “The burden of showing that a decision should be modified lies with the party challenging the decision.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In its request for rehearing, the dissatisfied party must (1) “specifically identify all matters the party believes the Board misapprehended or overlooked” and (2) identify the place “where each matter was previously addressed.” 37 C.F.R. § 42.71(d); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768.

III. ANALYSIS

In its Request, Patent Owner contends that we presented a “new theory” of anticipation that was not argued in the Petition. Request 2. Specifically, Patent Owner argues as follows:

In [its Decision], the Board agreed that “Patt does not expressly state that rhodium was used as a catalyst in the disclosed working examples.” [Dec. 8]. The Board then stated that “the skilled artisan would reasonably infer one would use rhodium as a catalyst.” *Id.* (emphasis added). [Patent Owner] respectfully requests that the Board reconsider its Decision because it appears that the Board has misapprehended or overlooked certain matters, which would otherwise cause the Board to decline to institute *Inter Partes* Review on the ground that Claims 1–4, 6–10, and 12 of the ’843 Patent are anticipated under 35 U.S.C. § 102(b) by Patt. Specifically, the Board provided an alternative theory in the [Decision] that the skilled artisan would reasonably infer one would use rhodium as a catalyst. This alternative theory was not argued by [Petitioner] in the Petition and it is submitted there is not enough evidence in the Petition for [Petitioner], under this theory, to meet the standard of “a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable.” 37 C.F.R. § 42.108(c).

Id. at 3–4 (emphasis omitted).

We are not persuaded by Patent Owner that our Decision is based on an anticipation ground not asserted in the Petition. Rather, our Decision was based on the information advanced by the parties, namely, the information presented in the Petition (Paper 1) and Preliminary Response (Paper 6). Our analysis of that information necessarily relies on Patent Owner’s own submissions, and we explained in our Decision why Patent Owner’s arguments failed to persuade us from instituting an *inter partes* review. To the extent our explanation differs from the information found in the Petition,

Patent Owner has been provided timely and adequate notice of the “matters of fact and law asserted” and will have an opportunity to submit facts and argument in its response to the petition. *See, e.g., Genzyme Therapeutic Prod. Ltd. P’ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1365–66 (Fed. Cir. 2016).

We have considered Patent Owner’s remaining positions set forth in the Request and are not persuaded at this time to change the conclusions set forth in our Decision. Patent Owner does not direct us to any evidence that we may have misapprehended or overlooked when reaching our conclusions. Rather, Patent Owner continues to advocate its position and expresses disagreement with our Decision, but does not persuade us that we misapprehended or overlooked any matter at this stage of the proceeding. As noted in our Decision, we have not made a final determination as to the patentability of any challenged claim or the construction of any claim term. Dec. 13. Patent Owner may present its arguments in its response to the petition and we will fully consider those arguments in view of the complete record when rendering our final written decision.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s request for rehearing is *denied*.

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Patent 9,073,843 B2

PETITIONER:

Justin Krieger
jkrieger@kilpatricktownsend.com

PATENT OWNER:

Gerald Murphy
gmm@bskb.com

Eugene Perez
etp@bskb.com

Marc Weiner
msw@bskb.com

Lynde Herzbach
lynde.herzbach@bskb.com

Michael T. Smith
michael.t.smith@bskb.com