

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELANESE INTERNATIONAL CORPORATION,
Petitioner,

v.

DAICEL CORPORATION,
Patent Owner.

Case IPR2017-00166
Patent 9,006,483 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” or “Dec.”). 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 1–3, 5, 6, 10, 11 and 13 of Miura (Ex. 1006). Request 1.

Pursuant to our authorization, Celanese International Corporation (“Petitioner”) filed a response. 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 misapprehended the teachings of Miura. Request 1. Specifically, Patent Owner argues as follows:

Miura does not disclose all features of at least independent claim 1 of the '483 patent including the recited methyl acetate at a concentration of 0.5 to 9% by weight. Because of this misapprehension, the Board incorrectly concluded that Miura anticipates claims 1–3, 5, 6, 10, 11 and 13 of the '483 patent. As a result, the Board should reverse its decision for Ground 3 of anticipation by Miura.

Id.

We are not persuaded. Miura discloses as follows:

The concentration of the carboxylic acid ester may be about 0.1 to 20% by weight, preferably 0.5 to 15% by weight, and more preferably about 0.5 to 6% by weight (e.g., about 2 to 6% by weight).

Ex. 1006, 5:50–55. Methyl acetate is a carboxylic acid ester disclosed in Miura. Ex. 1002 ¶¶ 79–80. The disclosed claimed range of, for example, 2 to 6% by weight falls within the range of 0.5 to 9% by weight recited in the challenged claims. Patent Owner fails to address the above-noted teaching of Miura in its Request, but rather focuses on the use of 9.8% methyl acetate in a specific embodiment disclosed in Miura. Request 4–5. However, the disclosure in Miura of a range narrower than what is claimed is pertinent to the anticipation analysis, and is distinct from a factual situation requiring analysis of “the criticality of a claimed range to the claimed invention in order to avoid anticipation by a prior art reference disclosing a broader, overlapping range.” *Ineos USA LLC v. Berry Plastics Corp.*, 783 F.3d 865, 870

(Fed. Cir. 2015). Patent Owner directs us to no persuasive authority suggesting that “an erroneous interpretation of law of anticipation has been applied to institute on Ground 3.” Request 5.

Patent Owner further argues that “it was error for the Decision to conclude that substantial evidence supports the factual finding that Miura anticipate all of the elements of claim 1.” We disagree. In our Decision, we determined that Petitioner has shown that there is a reasonable likelihood that it would prevail in showing that Miura anticipates claims 1–3, 5, 6, 10, 11, and 13 of the ’483 patent. Dec. 14. As noted in our Decision, however, we have not made a final determination as to the patentability of any challenged claim. Dec. 15. 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 9,006,483 B2

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