

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIELDPIECE INSTRUMENTS, INC.
Petitioner,

v.

TWIN RIVERS ENGINEERING, INC.
Patent Owner.

Case IPR2017-00362
Patent 7,022,993

Before JENNIFER S. BISK, MATTHEW R. CLEMENTS, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

ULLAGADDI, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Fieldpiece Instruments, Inc. (“Petitioner”) filed a Rehearing Request (Paper 15, “Reh’g Req.”) of our Decision Denying Institution (Paper 14, “Dec.”). Petitioner requests that we reconsider our decision to deny institution of *inter partes* review with respect to claims 2, 3, 6, 7, and 9 (“the challenged claims”) and our determination that Petitioner had not demonstrated a reasonable likelihood of prevailing in showing that the challenged claims of U.S. Patent No. 7,022,993 (Ex. 1001, “the ’993 patent”) would have been obvious over various combinations of Wong, Wallack, Sibley, Bley, Horiba, Johnson Controls, Moyer, McFadden, Liebermann, Blades, Kobayashi, and Craft. For the reasons set forth below, the request 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.” An abuse of discretion occurs when a “decision was 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.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The burdens and requirements of a request for rehearing are stated in 37 C.F.R. § 42.71(d):

(d) *Rehearing.* . . . The burden of showing a decision should be modified lies with the party challenging the decision. The request 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.

III. ANALYSIS

A. *Whether We Overlooked Prior Art Teachings of “the leak detector detect[ing] if a leak exists in the single pressurized gas source without introducing or mixing a secondary tracer within the leak detector” as recited in independent claims 2 and 9 and as similarly recited in independent claims 6 and 7*

Petitioner argues that the prior art, and in particular, Wong, teaches “the leak detector detect[ing] if a leak exists in the single pressurized gas source without introducing or mixing a secondary tracer within the leak detector” as recited in independent claims 2 and 9 and as similarly recited in independent claims 6 and 7 (“the negative limitation”). Reh’g. Req. 5–13. In the Petition, the argument regarding this limitation consists solely of the following:

Additionally, none of the above-cited prior art teaches the negative limitation of detecting a leak by “introducing or mixing a secondary tracer within the leak detector.” *See generally* EX1004 (Wong); EX1005 (Wallack); EX1006 (Sibley); EX1008 (Horiba); EX1009 (Johnson Controls).

Pet. 44 (for claims 2 and 9); *see also id.* at 58 (substantially similar argument for claim 6), 68 (for claim 7, referring to argument for claim 6). In its Rehearing Request, Petitioner cites numerous portions of the Laub Declaration in support of its contention. Reh’g. Req. 5, 6, 8–10, 12, 13 (citing Ex. 1003, 29, 30, 32–34, 36, 49, 50, 73, 74). None of these portions of the Laub Declaration were cited in the Petition in connection with the negative limitation. In fact, as noted in our Decision, Petitioner did not cite to the Laub Declaration at all in connection with the negative limitation. *See* Dec. 14 n.2. The Rehearing Request “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). As

Petitioner did not cite to the Laub Declaration at all in connection with the negative limitation in its Petition, we could not have “misapprehended or overlooked” this evidence in connection with that limitation.

Moreover, the portions of the Petition cited in the Rehearing Request relate only to overviews of the references. *See* Reh’g. Req. 5–13 (citing Pet. 13, 14, 21, 22, 26, 29, 33, 34, 46, 47). In our Decision, we stated that the burden of persuasion remains on a petitioner in *inter partes* review proceedings. *See* Dec. 13 (citing *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (Fed. Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”)). Petitioner does not meet its burden because none of these overviews *explain* why the ordinarily skilled artisan would have understood the references to teach or suggest the negative limitation. Similarly, even having considered the portions of the Laub Declaration first cited in the Request for Rehearing, we still are not persuaded Petitioner explains sufficiently why the negative limitation is taught or suggested by the references.

In support of its argument that Wong teaches the negative limitation, Petitioner asserts that we misapprehended Wong because our “Decision mistakes ‘chamber 104 that is to be tested’ . . . for ‘the gas sample chamber 108’ of the Wong detector.” Reh’g. Req. 1 (internal citations omitted). Petitioner further asserts that the Examiner found, during reexamination of the ’993 patent, that Wong “anticipate[s], or render[s] obvious, a limitation of detecting leaks in a single pressurized gas source (i.e., a chamber 104) pressurized with the test gas (col. 3, lines 52-55) which may be carbon dioxide, without the introduction of a secondary tracer gas (i.e., a carbon dioxide leak, a known refrigerant gas, may be detected directly without the use of any additional secondary tracer gas to detected [sic] it).” *Id.* at 7–8 (emphasis omitted). Like the citations to the Laub

Declaration, none of these assertions were originally presented in the Petition so we could not have misapprehended or overlooked them.

Even assuming we were to consider Petitioner's argument that Wong teaches the negative limitation, Petitioner apparently takes the position that the negative claim limitation "the leak detector detects if a leak exists in the single pressured gas source without introducing or mixing a secondary tracer within the leak detector" should be interpreted to mean that the leak detector detects if a leak exists *independently* of whether a secondary tracer gas is introduced or mixed within the detector. The claim limitation, however, is narrower than that as it excludes *any* detection that is made in the presence of a secondary tracer, irrespective of whether the secondary tracer forms the basis of the detection.

Wong discloses that "chamber 104 may be placed within a larger chamber so as to permit the chamber 104 to be surrounded by a chosen ambient gas other than air," and that, "[i]n another embodiment, shown in FIG. 3 a localized region on the surface of the chamber may be flooded by a chosen ambient gas that temporarily displaces the air that otherwise would be present." Ex. 1004, 2:57–62, Wong further notes that

[O]ne may chose the test gas and the ambient gas so that a strong absorption band of the test gas coincides in wavelength with a portion of the spectrum in which the ambient gas does not absorb. When such a choice has been made, the wavelength of the filter 122 is chosen to coincide with the absorption band of the test gas. Likewise, the radiation source 118 must produce some radiation at the absorption band of the test gas. Once these choices have been made, the detector is unresponsive to the ambient gas, but strongly responds to the test gas, *even when the test gas is mixed with the ambient gas.*

Id. at 4:22–32 (emphasis added). Because Wong teaches that detector 100 analyzes the mix of a test gas with an ambient gas (i.e., the recited "secondary

tracer”), we are not persuaded that Wong’s teaching of mixing is limited to chamber 104, as Petitioner contends.

We decline to review Moyer, Wallack, Horiba, Sibley, and Johnson Controls because Petitioner’s arguments and specific citations to the references were not presented initially in the Petition and are being presented for the first time in Petitioner’s Request for Rehearing. We could not have overlooked or misapprehended Petitioner’s argument that the negative limitation is taught by this prior art because it was not made, with sufficient specificity, in the Petition. Accordingly, we are not persuaded that we misapprehended or overlooked portions of any of Wong, Moyer, Wallack, Horiba, Sibley, and Johnson Controls that teach or suggest the negative limitation.

*B. Whether We Misapprehended Petitioner’s
Contention that Silence in the Prior Art May Disclose a
Negative Limitation as an Argument Regarding Written
Description*

Petitioner asserts that “despite any silence that may exist in the prior art a person of ordinary skill in the art would have nonetheless expected the limitation ‘without...a secondary tracer’ to have been known in the art.” Reh’g. Req. 2, 14. The Petition, however, does not mention the level of the ordinary skill in the art in connection with the negative limitation, let alone explain why the limitation would have been taught or suggested to one of ordinary skill in the art at the time of the invention.

Petitioner further asserts that our Decision “misapprehends the disclosure in the prior art and is based on authority regarding [the] *written description requirement* of a negative limitation – not the standard required to show disclosure of a negative limitation in the prior art.” *Id.* at 4 (emphasis added); *see also id.* at 13–14 (expanding upon argument). We clarify that we relied on the case law cited

in our Decision, not to indicate the minimum that a petitioner is required to show regarding a negative limitation, but simply to emphasize that the negative limitation inquiry is focused on what a person of ordinary skill in the art would understand the prior art to teach or suggest.

Petitioner does not disagree with this legal point. *See, e.g., id.* at 15 (“Petitioner contends that the prior art, when viewed from the perspective of a person of ordinary skill in the art, sufficiently discloses the negative limitation . . .”). Nonetheless, as noted above, Petitioner neither points out an express teaching nor provides any other explanation as to why the negative limitation would have been taught or suggested to one of ordinary skill in the art at the time of the invention. Based on our construction of the negative limitation and our reading of the prior art, we concluded that a person of ordinary skill would not have understood the prior art to disclose the negative limitation. And Petitioner did not provide any evidence to the contrary. *See, e.g.,* Pet. 44, 58, 68 (citing “generally” to prior art exhibits, but not citing to Laub Declaration). Thus, we are not persuaded that we erred in determining that Petitioner did not meet its burden to show a reasonable likelihood of prevailing on this issue.

IV. CONCLUSION

For the foregoing reasons, we could not have overlooked or misapprehended Petitioner’s arguments regarding teachings of the negative limitation in the prior art because they were not made, with sufficient specificity, in the Petition.

V. ORDER

In consideration of the foregoing, it is hereby:

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

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