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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DORCO COMPANY, LTD.,
Petitioner,

v.

THE GILLETTE COMPANY, LLC,
Patent Owner.

Case IPR2017-00500
Patent 6,684,513 B1

Before BART A. GERSTENBLITH, ZHENYU YANG, and ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

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

Dorco Company, Ltd. ("Petitioner") filed a Request for Rehearing (Paper 8, "Reh'g Req.") of our Decision dated June 21, 2017 (Paper 7, "Dec.") denying institution of *inter partes* review of the challenged claims of U.S. Patent No. 6,684,513 B1 ("the '513 patent").

Our Decision declined to institute an *inter partes* review pursuant to our discretion under 35 U.S.C. § 325(d) and 37 C.F.R. § 42.108. The Petition asserted two grounds of unpatentability: Ground 1 asserted obviousness of all challenged claims based on Lane (Ex. 1003) and Goel (Ex. 1004), and Ground 2 asserted obviousness of a subset of the challenged claims based on Lane and Admitted Prior Art ("APA"). Pet. 6. Hahn (Ex. 1005) was relied upon by the Examiner to reject Applicants' claims during prosecution and was asserted by Petitioner as an example of APA. Pet. 12–13, 18. Although institution was denied as to both grounds of unpatentability asserted in the Petition, Petitioner seeks rehearing only as to Ground 1. Reh'g Req. 1.

In the Request for Rehearing, Petitioner argues that the Board misapprehended and overlooked evidence showing that Goel provides unique reasons to combine it with Lane. Reh'g Req. 2. Petitioner argues that the Board misapprehended and overlooked "important differences" between the materials disclosed by Goel and Hahn and that Goel provides a person of ordinary skill in the art ("POSA") "an even more compelling reason to combine" Goel with Lane than does either APA or Hahn. *Id.* at 1–2.

I. 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 request must identify, specifically, all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, opposition, or reply. *See* 37 C.F.R. § 42.71(d).

II. DISCUSSION

In our Decision, we found that "the Petition presents 'the same or substantially the same prior art or arguments' as were previously presented to the Office during prosecution of the '513 patent." Dec. 15 (quoting 35 U.S.C. § 325(d)). More specifically, the Decision found:

> Petitioner's Grounds I and II present essentially the same question of patentability as was previously considered by the Examiner: whether it would have been obvious to provide a chromium-containing overcoat layer (as disclosed in Lane) between a hard coating layer of amorphous carbon-containing material (as disclosed in Hahn, Goel, and APA) and a friction-reducing PTFE outer layer (as disclosed in Lane, Hahn, Goel, and APA). *Compare* Pet. 34–35, 54–55 (Petitioner's contention that it would have been obvious to use a chromium adhesion promoting layer between a diamond-like hard coating and a PTFE layer), *with* Ex. 1002, 61, 85 (Examiner's contention that it would have been obvious to provide a layer of chromium coating between a hard coating of amorphous DLC and a PTFE layer "to aid in facilitating a hard and durable shaving edge for the razor blade").

Id. The Request does not challenge this finding. Instead, Petitioner argues that the combination of Goel and Lane was not previously before the Patent Office and is not substantially the same as the Hahn and Lane combination that was discussed during prosecution. Reh'g Req. 3, 5. Petitioner argues

that diamond-like nanocomposite (DLN), as disclosed in Goel, differs from diamond-like carbon (DLC), as disclosed in Hahn. *Id.* at 1–2, 5, 7, 9. According to Petitioner, Goel's DLN is refractory and can be doped, while Hahn discloses non-refractory DLC and is silent on doping. *Id.* at 7–9. Petitioner argues that the refractory and doping properties of DLN provide "two unique reasons" to combine Goel with Lane that are inapplicable to Hahn. *Id.* at 7. Petitioner further argues that the difference between refractory and non-refractory materials was "the primary basis on which Patent Owner disputed a motivation to combine" Hahn and Lane during prosecution and that the properties of Goel's DLN "directly address" the lack of motivation discussed during prosecution. *Id.* at 7–8.

Petitioner's arguments do not persuade us to grant rehearing for two reasons: First, Petitioner's arguments could not have been misapprehended or overlooked because they were not raised in the Petition; and second, even if Petitioner's rehearing arguments had been raised in the Petition, they do not persuade us that we abused our discretion in denying institution.

Points Assertedly Misapprehended or Overlooked

Petitioner directs us to pages 2–3, 6–7, 14–15, 24–25, and 29–32 of the Petition as support for its arguments regarding differences between Goel and Hahn, motivation to combine Goel and Lane, and the prosecution history of the '513 patent. Reh'g Req. 5–10. The cited portions of the Petition did not, however, compare Goel and Hahn as references to be combined with Lane, nor assert that the combination of Goel and Lane overcomes Patent Owner's prosecution history arguments regarding Hahn and Lane, as argued in the Request.

At pages 2–3, the Petition argued that Lane provides a motivation to replace refractory hard coating materials with modern hard coating materials, that one such replacement material is Goel's DLN, which can be doped and can be refractory, and that another such replacement material is APA's DLC, which is generally non-refractory. Pet. 2–3. At pages 2–3, the Petition did not compare DLN and DLC, nor assert that Goel's DLN would be a better or more compelling substitute for Lane's refractory hard coating materials than Hahn's DLC.

At pages 6–7, the Petition argues:

> Goel's DLN and the APA's DLC hard coating materials . . . are both amorphous, diamond-like, carbon containing materials, but there are differences in their chemical properties that ***Patent Owner may argue*** to be of relevance to some of the Challenged Claims or to motivation to combine. For example, Goel's DLN can be refractory and can be doped with other elements such as chromium, while the APA's DLC is generally non-refractory.

Pet. 6–7 (emphasis added). Here, Petitioner anticipated that ***Patent Owner*** may rely upon differences between DLN and DLC to oppose the Petition. There was no suggestion that Petitioner relied upon these differences as support for any of Petitioner's arguments.

At pages 14–15, the Petition discussed the prosecution history of the '513 patent, arguing that the language in Lane that criticizes refractory materials was never cited curing prosecution and provides a motivation to combine Lane and Hahn. Pet. 14–15. Goel was not discussed expressly at pages 14–15 of the Petition. *Cf.* Reh'g Req. 14.

At pages 24–25, the Petition asserted that Goel discloses DLN as an improvement over DLC, that Goel's DLN is both refractory and amorphous, and that Goel teaches that dopants may be added to DLN. Pet. 24–25. This

portion of the Petition did not compare DLN and DLC as substitutes for Lane's refractory hard coating materials, nor assert that Goel's DLN provides a more compelling reason to make a substitution than does Hahn's DLC.

At pages 29–32, the Petition argued that the DLN hard coating of Goel is compatible with Lane, thus providing further reasons to combine Lane with Goel, in addition to Lane's criticism of refractory materials. Pet. 29–32. As reasons to combine Goel and Lane, the Petition relied on Goel's disclosure of adding dopants to DLN to obtain desirable properties and the assertion that Goel and Lane both teach refractory materials. *Id.* at 30, 31. The Petition did not, however, argue that these points differentiate the combination of Goel and Lane, as asserted in Ground 1, from the combination of Hahn and Lane, as asserted in Ground 2 and considered by the Examiner during prosecution. In fact, the Petition argued that DLN, as disclosed in Goel, and DLC, as disclosed in Hahn and APA, are both suitable replacements for Lane's "obsolete" refractory hard coating materials (*id.* at 28) and made no argument that Goel's DLN would have been a better or more compelling substitute than Hahn's DLC. For example, neither the Petition, nor the Watts declaration asserted that the refractory or thermal stability property of Goel's DLN provides any benefit or advantage for a razer blade coating. *Cf.* Reh'g Req. 8 (arguing that these properties of Goel's DLN "directly address" Patent Owner's prosecution argument regarding a lack of motivation to combine).

Accordingly, we are not persuaded by Petitioner's argument that "[t]he Petition explains how Goel provides reasons to combine it with Lane that were not applicable to Hahn." Reh'g Req. 10 (citing Pet. 2, 31–32).

That argument was not presented in the Petition and consequently could not have been misapprehended or overlooked by the Board. We also did not misapprehend or overlook Dr. Watts' opinions regarding a motivation to combine Goel and Lane. *Cf.* Reh'g Req. 11–12 (citing and quoting Ex. 1007 ¶¶ 105, 106). Dr. Watts' opinions were addressed expressly in the Decision. Dec. 19–20 (discussing Ex. 1007 ¶¶ 98–111).

No Abuse of Discretion

Even if Petitioner's rehearing arguments had been raised in the Petition, they do not persuade us that we abused our discretion in denying institution. More specifically, Petitioner's rehearing arguments do not persuade us that it was an abuse of discretion to find that Petitioner's Ground 1 presents essentially the same question of patentability as was previously presented to the Office during prosecution. Dec. 15. Petitioner contends that there would have been more compelling reasons for a POSA to combine Goel and Lane than there would have been to combine Hahn and Lane. Reh'g Req. 1–2, 7–11, 13. Even if we accept Petitioner's contention, it does not change our analysis of whether the Petition presented the same or substantially the same prior art or arguments as were previously presented to the Office.

Petitioner's rehearing arguments are premised on the mistaken assertion that the differences between Lane's refractory materials and Hahn's non-refractory materials were the primary focus of Applicants' arguments to the Examiner during prosecution. Reh'g Req. 3, 6–8. As demonstrated by our summary of the prosecution history (Dec. 5–10), however, this was only one of several arguments made by Applicants during prosecution. As stated in the Decision, Applicants argued that it was

unexpected that "a material that is softer than the hard coating, namely the chromium layer, would provide wear resistance and/or additional strength to the hard coating." Dec. 7 (quoting Ex. 1002, 51–52). Applicants also argued that there is "no motivation to combine, as Hahn teaches directly bonding the PTFE to the hard coating, thus teaching away from any use of an intermediate layer as in Lane." *Id.* at 9 (quoting Ex. 1002, 80).

Even if Goel provided more compelling reasons to substitute its DLN material for Lane's refractory hard coating material than Hahn provided with respect to its DLC material, as Petitioner asserts, that does not change the substantial similarity between Petitioner's Ground 1 and the question of patentability previously presented to the Office. As articulated in the Decision, that question is "whether it would have been obvious to provide a chromium-containing overcoat layer (as disclosed in Lane) between a hard coating layer of amorphous carbon-containing material (as disclosed in Hahn, Goel, and APA) and a friction-reducing PTFE outer layer (as disclosed in Lane, Hahn, Goel, and APA)." Dec. 15. This question of patentability assumes that Goel's DLN material would have been substituted for Lane's refractory material. But that is not the end of the obviousness inquiry. Petitioner's proposed substitution does not answer whether a POSA would have used an intermediate chromium-containing overcoat layer, as taught by Lane, or would have coated PTFE directly on the DLN, as taught by Goel. Thus, Petitioner's argument that we erred in evaluating evidence of substitutability of Goel's DLN do not convince us of an abuse of discretion in our finding that Petitioner's Ground 1 presents substantially the same issue of patentability as presented to the Office during prosecution.

Accordingly, Petitioner's Request does not persuade us that we abused our discretion in denying institution.

III. CONCLUSION

Accordingly, it is hereby ORDERED that Petitioner's request for rehearing is *denied*.

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