

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GRIT ENERGY SOLUTIONS, LLC,
Petitioner,

v.

OREN TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2017-00768
Patent 8,585,341 B1

Before MITCHELL G. WEATHERLY, KEVIN W. CHERRY, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

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

I. INTRODUCTION

a. Background

Grit Energy Solutions, LLC (“Petitioner”), filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–7 of U.S. Patent No. 8,585,341 B1 (Ex. 1001, “the ’341 patent”) under two grounds (Grounds 1 and 2). Pet. 6. We issued a Decision to Institute an *inter partes* review of all challenged claims (claims 1–7) under both of these grounds. Paper 8, 29.

We entered our Final Written Decision on June 13, 2018, Paper 27 (“Final Written Decision” or “Final Dec.”), in which we concluded that Petitioner failed to establish by a preponderance of evidence that any of the challenged claims are unpatentable. Final Dec. 27. Petitioner filed a timely Request for Rehearing in which it asks that we modify the Final Written Decision to find all challenged claims unpatentable. Paper 28, 1 (“Reh’g Req.,” “Request,” or “Request for Rehearing”).

For the reasons that follow, we deny the Request for Rehearing.

b. Standard for Reconsideration

The party filing a request for rehearing of a final written decision has the burden of showing a decision should be modified, and the request for rehearing must specifically identify all matters the party believes the Board misapprehended or overlooked and the place where each matter was previously addressed in its papers. 37 C.F.R. § 42.71(d). Therefore, Petitioner bears the burden of establishing that we misapprehended or overlooked the matters that it requests that we review.

II. ANALYSIS

In its Request, Petitioner argues that the Board overlooked or misapprehended several items. *See* Reh’g Req. 1–2. We address each of these items separately, below.

a. The Board Overlooked Petitioner’s Section IX.A.5.(c) Position

As set forth in our Final Written Decision, we determined that Petitioner’s challenge was unpersuasive because, *inter alia*, Constantin does not teach, disclose, or suggest its orifice as being attached to its lower shutter blade and actuator. *See* Final Dec. 17–22; *see also id.* at 21 (“Petitioner has not shown that Constantin teaches, discloses, or suggests its orifice as being attached to its actuator, as Petitioner asserts”).

Petitioner argues that we overlooked the Petition’s “Section IX.A.5.(c) Position . . . [that] *does not require* that Constantin disclose a stud on upper shutter blade 9 and an orifice on lower shutter blade 8.” Reh’g Req. 1, 4 (emphasis added).

We disagree. To the contrary, we find that Petitioner’s “Section IX.A.5.(c) Position” relies on Constantin for disclosing a stud on upper shutter blade 9 and an orifice on lower shutter blade 8.

Petitioner’s “Section IX.A.5.(c) Position” is presented on a single page of the Petition and is titled “*Replacing the catch and projection of ES’s FIG. 10 with a stud and orifice like Constantin’s.*” Pet. 55 (citing Ex. 1015 ¶¶ 76, 98, 99) (emphasis added). We find nothing in the Section IX.A.5.(c) analysis (Pet. 55) or the cited testimony (Ex. 1015 ¶¶ 76, 98, 99) to support Petitioner’s argument that this position *does not* require that Constantin disclose an orifice on lower shutter blade, which itself is attached to the

actuator. *See* Reh’g Req. 1, 4. Instead, we find just the opposite. Although the Rehearing Request cites to Dr. Wooley’s testimony in paragraphs 98 and 99 (*see id.* at 2–5), the Rehearing Request fails to address Dr. Wooley’s testimony in paragraph 76, which Petitioner relies on in its “Section IX.A.5.(c) Position.” *See* Pet. 55 (citing in relevant part Ex. 1015 ¶ 76). In this paragraph, Dr. Wooley testifies that “it would have been obvious to modify Eng Soon to invert its receptacle and pin . . . as taught by Constantin below . . . [and that] *Constantin discloses a pin (stud 15) that extends from the lower side of a gate and a receptacle (orifice 16) on an actuator.*” Ex. 1015 ¶ 76 (emphasis added). Indeed, by entitling the section “*Replacing [Eng Soon’s] catch and projection . . . with a stud and orifice like Constantin’s*” and relying on Dr. Wooley’s testimony that “*Constantin discloses a . . . receptacle (orifice 16) on an actuator,*” Petitioner’s Rehearing Request argument contradicts the Petition and Dr. Wooley’s direct testimony. (emphasis added).

Moreover, if Petitioner intended for its “Section IX.A.5.(c) Position” to not rely on Constantin for disclosing an orifice attached to the lower shutter blade/actuator, Petitioner should have explained as much in its original Petition. Otherwise, the Petition lacks the particularity and specificity required by 35 U.S.C. § 312(a)(3) and 37 C.F.R. § 42.104(b).

Accordingly, Petitioner’s argument that we overlooked its “Section IX.A.5.(c) Position” is unavailing.

b. The Board Erred in its Analysis

Under this heading, Petitioner presents several arguments, including that we misapprehended and overlooked arguments and evidence: (1) “to

conclude that a POSITA would interpret Constantin's claim 5 as limited by the legally non-limiting reference numerals included in parentheses in that claim"; and (2) "supporting Petitioner's position that transposing [Eng Soon's] pin and receptacle, as disclosed by Constantin, would have been obvious." Reh'g Req. 1–2. We address each of Petitioner's arguments separately, below.

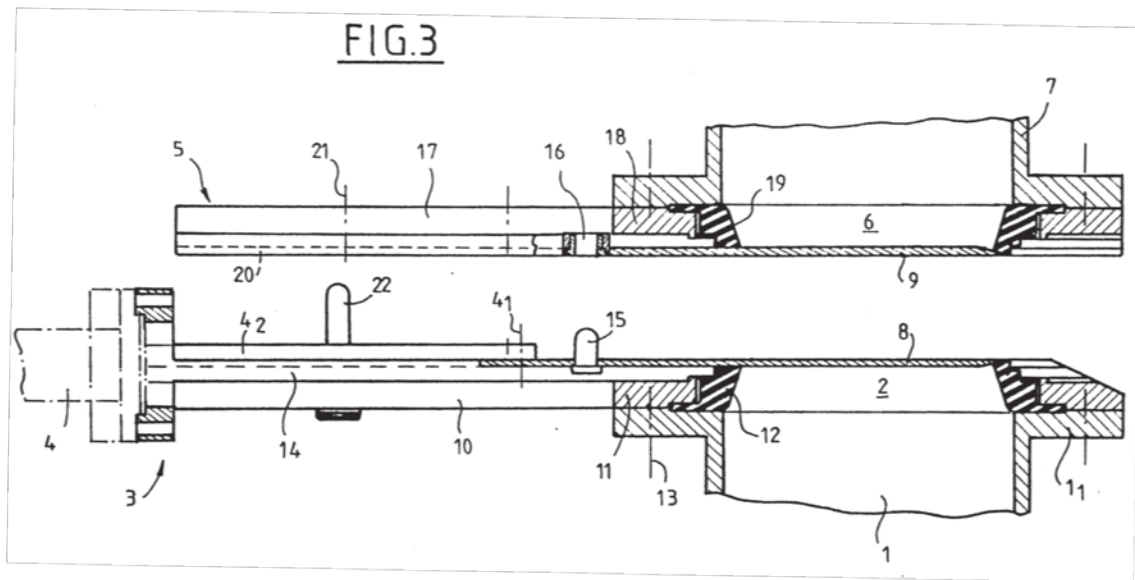
i. Constantin's Claim 5

In the Petition, Petitioner asserted that "Constantin's claim 5 discloses orifice 16 attached to the actuator device." Pet. 49. Claim 5 recites:

5) Device according to any one of the preceding claims, characterized in that the means for mechanical connection of the shutters are constituted by at least one stud (15) provided on one of the shutter blades (8) that lodges in a corresponding orifice (16) of the blade of the other shutter.

Ex. 1004, 7.

Upon reviewing Constantin in its entirety, including claim 5, and the parties' competing testimony, we disagreed with Petitioner, credited the testimony of Patent Owner's expert (Mr. Smith), and found that Constantin *does not* disclose its orifice 16 attached to actuator device 4. *See* Final Dec. 17–21 (citing in relevant part Ex. 2040 ¶¶ 65–66, 68). Rather, we found that Constantin discloses one embodiment, in which its stud 15 is attached to lower shutter blade 8 and actuator 4 (*see id.*), illustrated in Constantin's Figure 3, reproduced below:



As shown above in Constantin's Figure 3, and as also consistently described by claim 5, actuator 4 is connected to lower shutter blade 8 and stud 15, whereas upper shutter blade 9 is attached to orifice 16. Ex. 1004, 5.

In its Request, Petitioner argues that we misapprehended claim 5 by construing its parenthetical reference numerals as limiting (Reh'g Req. 5) and that a "POSITA should be not be free [sic] to interpret a disclosure in a manner that contravenes' the established practice reflected in [French law and the MPEP]" (*id.* at 6 (citing Pet. Reply 15)).

Petitioner's argument misses the point; *even if* we assume that under French patent law and U.S. Patent Law claim 5 is interpreted as Petitioner proposes, and that the reference numerals within the parentheticals are not limiting, Petitioner's argument conflates claim 5's *interpretation* with what claim 5 *discloses*. In other words, simply because claim 5 may be interpreted broadly to cover a wide array of embodiments, this is not to say that claim 5 itself *discloses* that same wide array of embodiments.

For example, imagine a hypothetical claim that recites in its entirety, "A cycle comprising a wheel." Under U.S. Patent Law, a proper

interpretation of the claim might cover a unicycle, a bicycle, and a tricycle. Although this hypothetical claim might be interpreted broadly to cover tricycles, the claim itself does not *disclose* a tricycle, as Petitioner would have us believe. *See also* Paper 26, 13:4–14:11 (discussing the same during oral argument).

Accordingly, Petitioner’s argument that we misapprehended the language of claim 5 is not persuasive.

ii. *Constantin’s Page 3 and Dr. Wooley’s Paragraph 94*

Petitioner also argues that we “overlooked and [did] not address Dr. Wooley’s explanation in paragraph 94 . . . that the *second* paragraph on Constantin page 3 supports Petitioner’s reading of claim 5.” Reh’g Req. 8. Petitioner asserts that we “discussed with specificity *only* the *third* paragraph on Constantin page 3, which Petitioner never relied on.” *Id.* at 8–9 (citing Final Dec. 20–21).

We disagree. To the contrary, we considered the second paragraph of Constantin’s page 3 as well as paragraph 94 of Dr. Wooley’s declaration. In particular, our Final Written Decision explicitly recites the first three paragraphs of Constantin’s page 3 (Final Dec. 20), and we found that “*there is nothing in this description to support Petitioner’s argument that Constantin’s claim 5 describes or suggests a receptacle (for engaging a stud on the opposite shutter blade) attached to the actuator device*” (*id.* at 20–21) (emphasis added). Although the second paragraph states that “the shutters are provided with means ensuring their mechanical connection when the orifices [2, 6] are placed facing each other,” there is *no mention* of orifice 16 or actuator 4, let alone any disclosure that orifice 16 is attached to actuator 4.

See Ex. 1004, 3. We also cited Dr. Wooley’s paragraph 94 in our Final Written Decision (Final Dec. 21) and weighed it against Mr. Smith’s competing testimony (*id.* (citing Ex. 2040 ¶¶ 65–66, 68)) before ultimately crediting Mr. Smith’s testimony over Dr. Wooley’s (*id.*). In particular, after weighing the evidence, including the second paragraph of page 3 of Constantin and paragraph 94 of Dr. Wooley’s testimony (*see id.* at 20–21), we found that “Petitioner has not shown that Constantin teaches, discloses, or suggests its orifice as being attached to its actuator” (*id.* at 21).

Accordingly, Petitioner’s argument that we overlooked Dr. Wooley’s testimony at paragraph 94 of his declaration and the second paragraph on Constantin’s page 3 is unavailing.

iii. Transposing Eng Soon’s Pin and Receptacle

Petitioner argues that the Petition sets forth two rationales (the “First Rationale” and the “Second Rationale”) as to why it would have been obvious to swap the positions of Eng Soon’s pin and receptacle as allegedly disclosed by Constantin:

(1) ES’s pin and receptacle perform the same function to achieve the same result, regardless of their position, a POSITA would have been able to make the swap, and the modification would have yielded a predictable result (Pet. at paragraph beginning “First” and spanning pages 53–54, and referred to below as the “First Rationale”); and

(2) ES’s receptacle is more complicated than its pin, and placing the receptacle on the actuator of the support structure would reduce the costs of the supply containers.

Reh’g Req. 11 (citations omitted). Petitioner argues that “the Board indicated its *only issue* with the First Rationale was that it depended on

Constantin for disclosing a receptacle attached to an actuator.” *Id.* at 12 (citing Final Dec. 22–23) (emphasis added).

Petitioner mischaracterizes our Final Written Decision, in which we found that “for at least the following *two reasons*, we disagree[d] with Petitioner’s argument that transposing Eng Soon’s pin and receptacle would have been a simple substitution to achieve predictable results.” Final Dec. 22 (citations omitted) (emphasis added). In other words, *even if* we found that Constantin discloses an orifice or receptacle attached to its actuator—which we do not—we *also* found that transposing Eng Soon’s pin and receptacle as proposed by Petitioner would result in a *more expensive system*, and we disagreed with Petitioner’s assertion that modifying Eng Soon would have been a mere simple substitution. *See* Final Dec. 24 (“we agree with Mr. Smith that a POSITA would not modify Eng Soon to ‘reduce cost,’ as Petitioner proposes . . . , when doing so would increase the overall cost of the mobile containers”) (citing Ex. 2040 ¶ 76).

Moreover, *even if* we treat Petitioner’s First Rationale as separate from its Second Rationale—thereby ignoring the Second Rationale when considering the First Rationale—when considered alone, Petitioner’s First Rationale fails to explain adequately why a POSITA would have transposed Eng Soon’s pin and receptacle. *See* Pet. 53–54. It is not enough to state that “[Eng Soon’s] pin and receptacle perform the same function to achieve the same result, regardless of their position, [and that] a POSITA would have been able to make the swap.” Reh’g Req. 11; *see also* Pet. 53–54 (“A POSITA reading Constantin would understand that there is no functional difference between these configurations”). In other words, it is not enough to argue that a POSITA *could* modify Eng Soon in a manner that meets the

claims, without adequately explaining *why* a POSITA *would* make the modifications. *See Personal Web Techs. LLC v. Apple, Inc.*, 848 F.3d 987, 993–94 (Fed. Cir. 2017) (finding that a skilled artisan would have understood that prior art could be combined insufficient; “it does not imply a motivation to pick out those two references and combine them to arrive at the claimed invention”). Indeed, we found that the proposed modification would result in a more expensive system. *See* Final Dec. 24.

Accordingly, Petitioner’s argument that we misapprehended or overlooked its First Rationale is not persuasive.

c. The Board Overlooked Petitioner’s G1Constantin-Based Challenges

Petitioner argues that we “overlooked and did not address any of Petitioner’s G1Constantin-based challenges, in contravention . . . of the Board’s policy.” Reh’g Req. 13–15 (citing in relevant part *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018)). Petitioner argues that its “G1Constantin-based challenges” were “explained in footnote 5 on page 20 of the Petition.” *Id.* at 13. Footnote 5 of the Petition provides:

The combination of ES + Constantin is presented as one ground because while *ES can be characterized as a primary reference and Constantin a secondary reference in some aspects of the analysis below, and vice-versa in other aspects, such a primary-secondary distinction does not give rise to separate grounds. See IPR2014-00351, Paper 21 at 2 (P.T.A.B. July 22, 2014) and decisions cited therein. Should the Board disagree, G1ES and G1Constantin (described below) are two grounds, and Ground 2 two grounds (G1ES + Olson; and G1Constantin + Olson), for a total of four grounds.*

Pet. 20, n.5 (emphasis added).

As explained in our Final Written Decision, we instituted review “of all challenged claims (claims 1–7) under all grounds, namely, Grounds 1 and 2.” Final Dec. 2. Indeed, the Petition sets forth only two grounds; Ground 1 challenging claims 1–3 and 5, and Ground 2 challenging claims 4, 6, and 7. Pet. 6 (Statutory Grounds of Challenge). In our Final Written Decision, we determined that Petitioner failed to meet its burden that any of the challenged claims are unpatentable. Final Dec. 2–3. In particular, we found that Constantin does not disclose an orifice attached to an actuator and concluded that a POSITA would not have modified Eng Soon as Petitioner proposed. *See id.* at 17–25. We find nothing in Petitioner’s “G1Constantin-based challenges” that cures these fatal defects.

Moreover, Petitioner’s statement in footnote 5 that certain “aspects” of Eng Soon and Constantin can somehow be “vice-versa” swapped with other “aspects” fails to rise to the specificity and particularity required under 35 U.S.C § 312(a)(3) and 37 C.F.R. § 42.104(b). The function of the Board is not to comb through the cited art in order to determine the strongest combination of references to meet the claims, thereby overcoming whatever deficiencies may exist in the Petition. *See generally LG Elecs., Inc. v. Rosetta-Wireless Corp.*, Case IPR2016-01516 (PTAB Apr. 3, 2017) (Paper 25).

Accordingly, Petitioner’s argument that we overlooked certain grounds in the Petition is unavailing.

III. ORDER

For the reasons given, it is

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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