

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONE WORLD TECHNOLOGIES, INC. d/b/a TECHTRONIC INDUSTRIES
POWER EQUIPMENT,
Petitioner,

v.

THE CHAMBERLAIN GROUP, INC.,
Patent Owner.

Case IPR2017-01546
Patent 7,224,275 B2

Before JONI Y. CHANG, JUSTIN T. ARBES, and
JON M. JURGOVAN, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, OneWorld Technologies, Inc. d/b/a Techtronic Industries Power Equipment, filed a Petition requesting an *inter partes* review of claims 1, 4–6, 9–11, 14, 15, 21, 22, and 24–28 of U.S. Patent No. 7,224,275 B2 (Ex. 1001, “the ’275 patent”). Paper 2 (“Pet.”). Patent Owner, The Chamberlain Group, Inc., filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Pursuant to our authorization, Petitioner filed a Reply and Patent Owner filed a Sur-Reply. See Papers 7–9.

Upon consideration of the Petition, Preliminary Response, Reply, and Sur-Reply, we exercise our discretion to deny institution of trial on this Petition under 35 U.S.C. § 314(a). Therefore, we do not institute an *inter partes* review as to the challenged claims of the ’275 patent.

A. Related Matters

Petitioner indicates the ’275 patent is asserted against Petitioner in *Chamberlain Group, Inc. v. Techtronic Industries Co.*, No. 16-cv-06097 (N.D. Ill. filed June 10, 2016). Pet. 1. Petitioner also identifies other patents that Patent Owner is presently asserting against Petitioner in various proceedings: U.S. Patent No. 7,635,966 B2 is involved in *Chamberlain Group, Inc. v. Techtronic Industries Co.*, No. 16-cv-06097 (N.D. Ill. filed June 10, 2016), and U.S. Patent Nos. 7,339,336 B2, 7,161,319 B2, and 7,196,611 B2 are involved in *Chamberlain Group, Inc. v. Techtronic Industries Co.*, No. 16-cv-06094 (N.D. Ill. filed June 10, 2016) and *Certain Access Control Systems and Components Thereof*, ITC Investigation No. 337-TA-1016 (instituted Aug. 3, 2016). Pet. 1–2. Petitioner previously filed other petitions seeking *inter partes* review of claims of the ’275 patent (Cases IPR2016-01772 (claims 1–6, 9–12, and 14–23) (institution denied) and IPR2016-01774 (claims 24–31) (institution denied)).

Petitioner also has filed petitions against the following patents: U.S. Patent No. 6,998,977 B2 (Cases IPR2017-01132 (trial instituted) and IPR2016-01137 (trial instituted)); U.S. Patent No. 7,635,966 B2 (Cases IPR2016-01846 (institution denied), IPR2017-01040 (institution denied), and IPR2017-01042 (institution denied)); U.S. Patent No. 7,171,319 B2 (Case IPR2017-00126 (trial instituted)); U.S. Patent No. 7,196,611 B2 (Cases IPR2017-00073 (trial instituted) and IPR2017-00214 (trial instituted)); and U.S. Patent No. 7,339,336 B2 (Case IPR2017-00432 (institution denied)).

B. Illustrative Claim

Of the challenged claims, claims 1, 14, and 24 are independent. Claim 1 is illustrative:

1. A movable barrier operator comprising:
 - a controller having a plurality of potential operational status conditions defined, at least in part, by a plurality of operating states;
 - a movable barrier interface that is operably coupled to the controller;
 - a wireless status condition data transmitter that is operably coupled to the controller, wherein the wireless status condition data transmitter transmits a status condition signal that:
 - corresponds to a present operational status condition defined, at least in part, by at least two operating states from the plurality of operating states; and
 - comprises an identifier that is at least relatively unique to the movable barrier operator, such that the status condition signal substantially uniquely identifies the movable barrier operator.

Ex. 1001, 8:5–21.

C. Prior Art Relied Upon

Petitioner relies upon the following prior art reference:

Kikuya JP 2001-349141A Dec. 21, 2001

Ex. 1003 (Japanese version); Ex. 1004 (certified English translation).

D. Asserted Grounds of Unpatentability

Petitioner asserts the following ground of unpatentability:

Challenged Claims	Basis	Reference
1, 4–6, 9–11, 14, 15, 21, 22, and 24–28	§ 102(b) ¹	Kikuya

Pet. 1–3.

II. ANALYSIS

35 U.S.C. § 314(a) provides as follows:

§ 314. Institution of inter partes review

(a). Threshold.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

This section grants the Board discretion to deny institution of a later-filed petition based on various factors, as set forth in *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016–01357, slip op. 15–19 (PTAB September 6,

¹ Because the claims at issue have an effective filing date prior to March 16, 2013, the effective date of the applicable provisions of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), we apply the pre-AIA version of 35 U.S.C. § 102 in this Decision.

2017) (Paper 19) (“*General Plastic*”) (Section II.B.4.i designated as precedential²) (citing *NVIDIA Corp. v. Samsung Elec. Co.*, IPR2016-00134, slip op. 6–7 (PTAB May 4, 2016) (Paper 9)). The non-exhaustive factors are as follows:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

We address each of these factors in turn, but note that not all the factors need to weigh against institution for us to exercise our discretion under § 314(a).

² Section II.B.4.i of *General Plastic* was designated precedential on October 18, 2017. The decision previously had been designated informative on September 18, 2017.

1. First Factor: Whether the Petitions are Directed to the Same Claims

Concerning factor (1) in relation to the facts of this case, the Petition was filed on June 12, 2017, and challenges claims 1, 4–6, 9–11, 14, 15, 21, 22, and 24–28 of the '275 patent. Previously, on September 9, 2016, Petitioner filed a petition in Case IPR2016-01772 challenging claims 1–6, 9–12, and 14–23 and a petition in Case IPR2016-01774 challenging claims 24–31 of the '275 patent. Thus, all of the claims challenged in this Petition were challenged in the previous petitions. Consequently, this factor weighs against institution.

2. Second Factor: Whether Petitioner Knew or Should Have Known of the Newly Asserted Prior Art

Considering factor (2), Petitioner states that on January 25, 2017, the Court of Appeals for the Federal Circuit (“Federal Circuit”) vacated the claim construction of the District Court of the Northern District of Illinois (“District Court”), holding that the “controller” recited in the claims of the '275 patent may rely upon external sensors to obtain status conditions. Pet. 6. Petitioner states the Federal Circuit’s construction prompted Petitioner to engage a new search firm on February 23, 2017, which located the Kikuya reference and provided it to Petitioner on April 12, 2017. *Id.* at 7. Upon review, Petitioner states it identified the Kikuya reference as anticipatory prior art and filed the present Petition. *Id.*

The relevant question under factor (2), however, is whether Petitioner knew or should have known of the Kikuya reference at the time of filing its first two petitions (September 9, 2016). Petitioner does not provide any explanation as to why the reference could not have been found with a reasonably diligent search at the time of the earlier petitions. *See General Plastic* at 11 (“Petitioner . . . provided no explanation why it could not have found this new prior art earlier—prior to filing the first-filed petitions—through the exercise of reasonable

diligence.”), 19 (“the record is devoid of any explanation why Petitioner could not have found the newly asserted prior art in any earlier search(es) through the exercise of reasonable diligence”).

Furthermore, what bearing the Federal Circuit’s claim construction (or those of the Board or the District Court) had on whether the Kikuya reference reasonably could have been located earlier is not explained adequately in the Petition. In this regard, we note that Petitioner states that it requested the later patent search on February 23, 2017, which was shortly after receiving our decisions denying institution in Cases IPR2016-01772 and IPR2016-01774 on February 21, 2017. Petitioner makes no mention of how this factored into the decision to request the later patent search.

Moreover, Petitioner states that it requested the patent search that yielded the Kikuya reference on February 23, 2017, and the District Court adopted a “broader construction” in an order issued April 7, 2017. Pet. 7. Given this sequence of events, we do not see how the scope of the patent search could have taken into account a “broader” claim construction that did not exist when Petitioner requested the later patent search. We agree with Patent Owner that factor (2) weighs in favor of exercising our discretion to deny the Petition. See Prelim. Resp. 10–14.

In view of the foregoing, this factor weighs against institution.

3. Third Factor: Whether Information from Prior Proceedings was Available

As to factor (3), the preliminary responses in Cases IPR2016-01772 and IPR2016-01774 were filed on December 23, 2016 and December 27, 2016, respectively. As noted, our decisions denying institution were entered on February 21, 2017. Thus, Petitioner had received Patent Owner’s preliminary responses and our decisions on institution in Cases IPR2016-01772 and IPR2016-01774 before

filing the present Petition, and thus had the advantage of knowing what was in them in preparing the present Petition.

Consequently, this factor weighs against institution.

4. Fourth Factor: Elapsed Time

Concerning factor (4), Petitioner states that it received the Kikuya reference on April 12, 2017, and filed the Petition two months later on June 12, 2017. Pet. 7. Petitioner suggests time was needed to identify and review the Kikuya reference and prepare the Petition. *Id.* However, although a period of two months may be reasonable, Petitioner does not explain why two months was a reasonable time under the circumstances in which to file the Petition.

Accordingly, this factor neither weighs for or against institution.

5. Fifth Factor: Whether Petitioner Provides Adequate Explanation

Regarding factor (5), Petitioner states it conducted “a more than reasonably diligent prior art search in 2016 using a top prior art search firm.” *Id.* at 8. Petitioner also states that the ground asserted in this Petition “is not similar to any of the prior art relied upon in the earlier petitions, and the new art was not located despite a diligent search.” *Id.* at 10. However, these statements are conclusory, and do not provide sufficient detail to justify the nine months that elapsed between filing the petitions in Cases IPR2016-01772 and IPR2016-01774, and the present Petition, directed to the ’275 patent. Also, we are not persuaded that any changed claim construction was unexpected or surprising to Petitioner. *See General Plastic* at 11 (“the shift in Petitioner’s challenges was not the consequence of a position that Patent Owner surprisingly advanced or the Board surprisingly adopted”).

Other considerations that have a bearing on factor (5) were discussed previously (see particularly the discussion under factor (2)).

For these reasons, this factor weighs against institution.

6. Sixth and Seventh Factors: Board Resources and Final Determination

As to factors (6) and (7), analysis of “multiple, staggered petition filings” is, in general, “an inefficient use of the *inter partes* review process and the Board’s resources.” *General Plastic*, slip op 21. Board resources are more fairly expended on initial petitions rather than follow-on petitions. *See id.* at 10. In short, the finite resources of the Board weigh against institution in this case.

Conclusion

For the reasons discussed above, we determine a majority of the *General Plastic* factors weigh strongly against institution in this case. Accordingly, we exercise our discretion to deny institution under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a).

III. ORDER

For the foregoing reasons, it is

ORDERED that the Petition is denied as to all challenged claims of the ’275 patent.

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Patent 7,224,275 B2

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