

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GN HEARING A/S,
Petitioner,

v.

OTICON A/S,
Patent Owner.

Case IPR2017-01927
Patent 8,494,204 B2

Before NEIL T. POWELL, FRANCES L. IPPOLITO, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

ORDER

*Denying Patent Owner's Request for Rehearing of the
Final Written Decision (Paper 40)*

I. INTRODUCTION

On February 21, 2019, we entered our Final Written Decision in this *inter partes* review. Paper 40 (“FWD”). On March 25, 2019, Patent Owner’s Request for Rehearing of Claims 2 and 7 under 37 C.F.R. § 42.71(d) (2) was filed. Paper 41 (“Request”). In the Request, Patent Owner contends that we “misapprehended the Petitioner’s failure to carry its burden of proof and incorrectly applied a combination of embodiments in Dodge that had not been previously asserted, lacked any underlying analysis under the *Graham* factors, and was not supported by the record.” Request 1. Patent Owner requests that we “revisit the arguments offered by both Petitioner and Patent Owner, as well as the statements in the Institution Decision, and conclude that Petitioner has not proven that claims 2 and 7 are unpatentable.” *Id.* For the following reasons, we deny the Request.

II. STANDARD OF REVIEW

The applicable standard for a request for rehearing of a Final Written Decision is set forth in 37 C.F.R. § 42.71(d), which provides that a 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 a motion, an opposition, or a reply.” The party challenging a decision bears the burden of showing the decision should be modified. *Id.*

III. ANALYSIS

A. Background

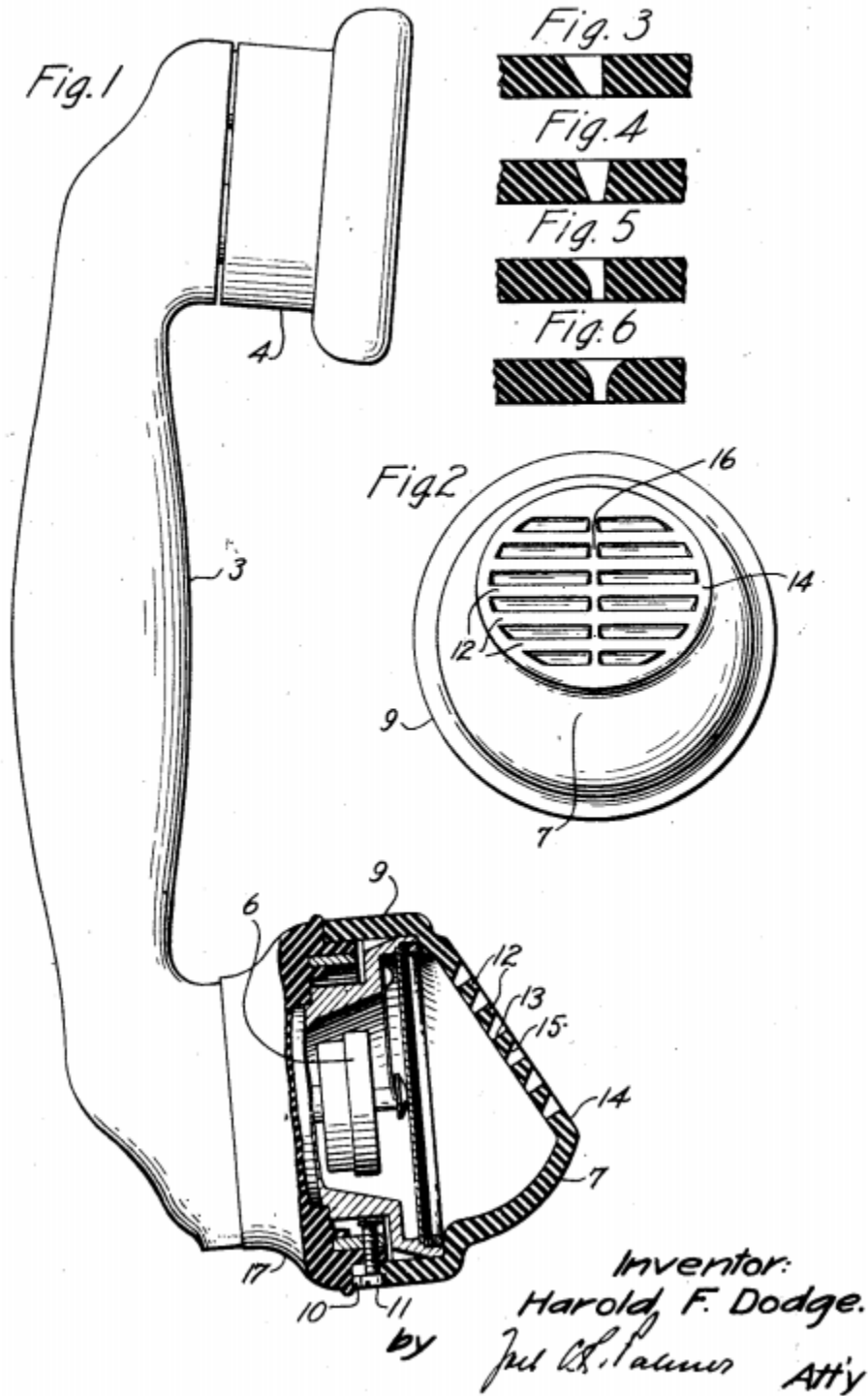
Claims 2 and 7 recite, “the edge has a cross-sectional angle of less than ninety degrees.” Ex. 1001, 5:23–25 (claim 2), 6:15–18 (claim 7). Dodge (Ex. 1005) contains a single page of drawings, reproduced below.

April 3, 1928.

1,664,852

H. F. DODGE
TRANSMITTER MOUTHPIECE

Filed Dec. 30, 1922



Dodge's drawings depict a "transmitter mouthpiece" in which "the mouthpiece is in the form of a shell having a plane face provided with a plurality of elongated slots or openings tapered inwardly." Ex. 1005, Title, 1:13–16. Figure 3 is an "enlarged section showing the shape of the openings in their preferred form" and Figures 4, 5, and 6 "show modifications in the shape of the openings." *Id.* at 1:25–29.

In both the Preliminary Response and the Response, the Patent Owner contended, "[t]here is no disclosure or suggestion in Dodge of an edge with a cross-sectional angle of less than ninety degrees."¹ Paper 6, 20; Paper 10, 31. We considered Patent Owner's contentions, reviewed the relevant evidence (Dodge), and determined that Patent Owner's contentions were inaccurate.² Accordingly, in the Institution Decision, we included copies of

¹ In direct contradiction of its earlier contentions, in its Request, Patent Owner acknowledges, "Dodge's Figures 3 and 4 show the bottom of the opening has at least one side with an angle of less than ninety degrees." Request 6. Prior to the Request, Patent Owner failed to acknowledge that Dodge discloses the limitation recited in claims 2 and 7 or to present any arguments or evidence showing how or why Dodge's Figures 3 and 4 did not teach or suggest the limitations in claims 2 and 7.

² In its Response, Patent Owner criticized Petitioner because "it picks and chooses certain quotes and figures while ignoring the entirety of the Dodge disclosure" and argues "[a]ny cited reference used for a rejection under 35 U.S.C. § 103 must be considered in its entirety" and "[t]he entire disclosure of Dodge must be considered." Paper 10 (Response), 44 (citing *W.L. Gore & Assocs. v Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). In accordance with Patent Owner's argument, we considered Dodge in its entirety. With regard to claims 2 and 7, Patent Owner failed to consider the entire disclosure of Dodge including ignoring explicit teachings that were contrary to the arguments made. Patent Owner has a duty to ensure that its "denials of factual contentions are warranted on the evidence." 37 C.F.R. § 11.18(b)(2)(iv); *see also* 37 C.F.R. §42.11(a)

Figures 3 and 4 and stated, “Figures 3 and 4 of Dodge depict inner edges of slits which have less than a ninety degree angle.” Paper 7, 26. In the FWD, we included a copy of Dodge’s sheet of drawings (reproduced above) and stated, “[i]n Figures 3 and 4, the left edges clearly have a cross-sectional angle of less than ninety degrees.” FWD 35.

After the Institution Decision, in the Patent Owner’s Response, Patent Owner did not specifically address Figures 3 and 4 of Dodge. *See generally* Paper 10. In the Reply, Petitioner included copies of Figures 3 and 4 and argued, “Patent Owner completely ignores Figures 3 and 4 in its arguments here. This is despite the Patent Owner arguing elsewhere in the [Response] that Dodge’s Figure 3 is the preferred embodiment of Dodge.” Paper 14, 25 (citations omitted). At its request, Patent Owner was granted leave to file a Sur-Reply. Paper 15, 2. Patent Owner’s entire discussion regarding Figures 3 and 4 in the Sur-Reply was as follows:

Petitioner claims the POR ignores Dodge's Figures 3 and 4. Reply, 25. However, Figures 3 and 4 were never cited in the Petition. Pet., 48-52. The Institution Decision cited Dodge's Figures 3 and 4 in comparison to Figures 5 and 6 relied on in the Petition. ID [Paper 7], 26. The Institution Decision stated that Figures 3 and 4 of Dodge depict inner edges of slits that have less than a ninety degree angle (but do not have an outer surface having a smooth curvature toward the slit). *Id.*

Paper 21, 23. Despite being given the opportunity to present arguments and evidence that Figures 3 and 4 did not teach the limitation in claims 2 and 7, Patent Owner did not.

(“Parties and individuals involved in the proceeding have a duty of candor and good faith to the Office during the course of a proceeding.”).

Thus, Patent Owner was aware that Dodge's Figures 3 and 4 were being relied upon as teaching or suggesting the limitation stated in claims 2 and 7. Nonetheless, Patent Owner never substantively addressed whether Figures 3 and 4 of Dodge taught or suggested the limitation of claims 2 and 7. We did, however, address Patent Owner's argument that "[t]here is no disclosure or suggestion in Dodge of an edge with a cross-sectional angle of less than ninety degrees" (Paper 6 (Preliminary Response), 20; Paper 10 (Response), 31) but found it was contradicted by Dodge. FWD 35–36. We did not misapprehend or overlook Patent Owner's argument or evidence to the contrary, because Patent Owner never presented any such argument or evidence. Accordingly, we found Dodge taught the limitation of claims 2 and 7 and affirm that factual finding is correct.

B. Patent Owner's Arguments

1. The Board Improperly Relied on a Combination of the Embodiments of Dodge

Patent Owner's Request is based on an argument that was never presented earlier in this proceeding—the Board improperly relied on a combination of the embodiments of Dodge. Request 2 ("The Board misapprehended the disclosure of various embodiments in Dodge and overlooked the complete lack of a motivation for the new combination of Dodge's various embodiments."), 4–5 ("The Board misapprehended the disclosure of Dodge and overlooked the lack of support in the record for a combination of multiple embodiments in Dodge's figures."), 6 ("There is no embodiment in Dodge that includes ***both*** a smooth, gradual curve on the first surface ***and*** an edge with a cross-sectional angle of less than ninety

degrees.”), 12 (“The record is devoid of any support for an alleged combination of Dodge’s various embodiments.”).

In its Request, Patent Owner fails to show that the Board misapprehended or overlooked these arguments earlier in the course of this proceeding. *See generally* Request. To the contrary and as noted above, Patent Owner failed to address the teachings of Figures 3 and 4 of Dodge and failed to address the combination of the teachings of the embodiments shown in those figures with the other teachings and embodiments in Dodge. Instead, Patent Owner ignored Figures 3 and 4 of Dodge in its Response to the Petition (*see* Paper 10, 29–34) and never contended it was improper to rely on Figures 3, 4, 5, and 6 of Dodge for teaching the elements of claims 2 and 7, as Petitioner did in its Reply (*see* Paper 14, 24–26) and the Board did in its Institution Decision (*see* Paper 7, 25–27). Patent Owner had notice that Figures 3 and 4 (and Figures 5 and 6) of Dodge were being relied upon and cited against claims 2 and 7 and, as also noted above, was given an opportunity file a Sur-Reply. In its Sur-Reply, Patent Owner acknowledged that Figures 3, 4, 5, and 6 of Dodge were being relied upon and cited against claims 2 and 7, but failed to provide any argument as to why Figures 3, 4, 5, and 6 of Dodge when considered together did not teach or suggest all the limitations relating to the claimed slit configuration. Paper 21, 23. At this stage of these proceedings, it is too late for Patent Owner to introduce and rely on new arguments.

2. Petitioner Failed to Meet Its Burden of Proof as to Claims 2 and 7

Patent Owner argues, “Petitioner offered no evidence that the cited references disclose or suggest all the elements of claims 2 and 7.”

Request 2. This is not accurate. Patent Owner may disagree with the merits

of Petitioner's showing with regard to claims 2 and 7, but Petitioner offered evidence that the cited references disclose or suggest all the elements of claims 2 and 7. *See* Paper 1 (Petition) 18–24, 29 (identification of where each element of independent claims 1 and 3 and dependent claims 2 and 7 is found in Saltykov and Dodge).

C. Summary

For all the foregoing reasons, we deny Patent Owner's Request for Rehearing of the FWD.

ORDER

Accordingly, it is:

ORDERED that Patent Owner's Request for Rehearing of Claims 2 and 7 under 37 C.F.R. § 42.71(d) (2), Paper 41, is denied.

IPR2017-01927
Patent 8,494,204 B2

PETITIONER:

Scott McKeown
Scott.mckeown@ropesgray.com

James L. Davis, Jr.
James.l.davis@ropesgray.com

PATENT OWNER:

Richard Anderson
dra@bskb.com

Eugene Perez
etp@bskb.com

Lynde Herzbach
Lynde.herzbach@bskb.com