

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUANTIFICARE, INC.,
Petitioner,

v.

THE PROCTOR & GAMBLE COMPANY,
Patent Owner.

Case IPR2017-02113
Patent 6,571,003 B1

Before GEORGIANNA W. BRADEN, BARBARA A. PARVIS, and
JEFFREY A. STEPHENS, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

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

I. INTRODUCTION

QuantifiCare, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–4, 8, 9, 11, 12, 14, 15, 30, and 32–41 (the “challenged claims”) of U.S. Patent No. 6,571,003 B1 (“the ’003 patent,” Ex. 1001). Paper 1 (“Pet.”). Patent Owner, the Proctor & Gamble Company, filed a Preliminary Response. Paper 5. In our Decision Denying Institution of *Inter Partes* Review (“Decision”) (Paper 11), we determined that the information presented in the Petition and accompanying evidence did not establish a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one challenged claim of the ’003 patent. Accordingly, we denied the Petition and did not institute an *inter partes* review of the ’003 patent.

Petitioner now requests rehearing of our decision not to institute trial on the challenged claims of the ’003 patent. Paper 12 (“Rehearing Request” or “Reh’g Req.”). For the following reasons, we deny Petitioner’s Rehearing Request.

II. STANDARD OF REVIEW

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. 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.

When reconsidering a decision on institution, we review the decision for an

abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

III. ANALYSIS

A. *Whether the Board misapprehended Petitioner's contentions based on Lobo (Ex. 1006)*

Petitioner contends the Board misapprehended or overlooked Lobo's disclosure (Ex. 1006) and erroneously concluded that Lobo does not teach "electronically determining a sub-image of the first digital image of the face of the person based on the first plurality of landmarks" (hereinafter, the "electronically determining step"), as recited in claim 30. Reh'g Req. 3–4. Petitioner contends certain of the Board's findings relating to Lobo are erroneous, as demonstrated by the declaration of Dr. Niels Lobo ("Lobo Declaration," submitted as Ex. 1043) submitted with the Rehearing Request, and based on evidence previously of record. *Id.* at 4.

We have considered Petitioner's arguments in the Rehearing Request, and have reconsidered Petitioner's arguments as to Lobo that were presented in the Petition. We are not persuaded that we misapprehended or overlooked Lobo's disclosure in determining Petitioner did not establish a reasonable likelihood of prevailing on its contention that claims 30 and 32–37 are

unpatentable under 35 U.S.C. § 103(a) over Lobo, alone or in combination with Pelfini.

The only evidence presented in the Petition to support the contention that Lobo teaches the electronically determining step of claim 30 is Figure 13 and column 23, lines 54–57, of Lobo, as well as a sentence comparing Lobo’s Figure 13 to Figure 7 of the ’003 patent. *See* Pet. 57–58.¹ The portion of Lobo’s column 23 relied on by Petitioner provides: “FIG. 13 shows a wrinkle geography map with the regions that are to be searched for facial wrinkles, after the eyes, nose, mouth, chin and sides of the face have been located.” Petitioner equates one of the “regions” in Lobo’s Figure 13 with the claimed “sub-image,” but neither Figure 13 nor the statement at column 23 of Lobo indicates that the region is “electronically determin[ed]” as claimed.

Petitioner argues Lobo, including its title, abstract, disclosure, and claims 8 through 13, focuses on automation. *Reh’g* Req. 5. “What is more,” argues Petitioner, “Lobo’s intended method would be impossible if manual steps (or visual supervision) were required, as ‘significant applications such as, but not limited to, serving the need of the blind’ are disclosed.” *Id.* at 6. (quoting Ex. 1006, col. 2, ll. 33–34). Despite these general teachings, as we found in the Decision, “Lobo specifically states that ‘human visual inspection’ is used with the wrinkle geography map [of Figure 13] to choose a bounding region for a grid used to analyze wrinkles within the grid.”

¹ We interpret Petitioner’s reference to “page 23” of Lobo, rather than column 23, to be a typographical error given the text quoted in the Petition. Pet. 57.

Decision 18 (citing Ex. 1006, col. 24, ll. 34–36). Petitioner’s Rehearing Request does not address persuasively this finding or attempt to explain sufficiently how this express teaching in Lobo is consistent with Petitioner’s contention that all steps in Lobo must be “automatic” or “electronically” performed.

Petitioner’s Rehearing Request reproduces two sentences from the Decision, including a reference to Lobo’s teaching of “human visual inspection,” and states that “[e]ach of these sentences of the Board are confirmed in writing as being erroneous by Dr. Niels Lobo himself (see attached Lobo Declaration).” Reh’g Req. 4. Petitioner’s Rehearing Request does not cite to or explain the significance of any particular paragraph of the Lobo Declaration. We have, however, reviewed the Lobo Declaration and do not find therein sufficient explanation of the Lobo patent’s reference to “human visual inspection” that persuades us the regions shown in Figure 13 of Lobo are determined electronically.

The Lobo Declaration primarily consists of reproductions of Patent Owner’s Preliminary Response and the Decision, followed by conclusory assertions that the reproduced statements are erroneous. The Lobo Declaration does not cite specific portions of Lobo that support the declarant’s statements, other than a single reference to the “specification, the figures, the description, and even the title” of the reference. Ex. 1043 ¶ 8. The Lobo Declaration provides that “Lobo doesn’t specifically state that ‘human visual inspection’ is used with the wrinkle geography map to choose a bounding region for a grid used to analyze wrinkles within the grid,” but provides no other alternative explanation for Lobo’s teachings at column 24, lines 34–36. Ex. 1043 ¶ 7(f). Thus, we afford the Lobo Declaration little

weight.² In addition, the Lobo Declaration and its substance are not part of the Petition, and the Board could not have misapprehended or overlooked arguments that were not in the Petition. *See* 37 C.F.R. § 42.71(d) (“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 a motion, an opposition, or a reply.”).

We note that, contrary to Petitioner’s assertions, Reh’g Req. 5, the finding regarding Lobo’s Figure 13 does not rely on Patent Owner’s assertions regarding manual zoom or obtaining multiple images, *see* Prelim. Resp. 25. Rather, the Decision indicates that we relied on Lobo’s reference to “human visual inspection” in agreeing with Patent Owner that the wrinkle map in Figure 13 of Lobo appears to be a generic illustration that guides the operator performing wrinkle analysis on the image. *See* Decision 18. Again, Petitioner has not offered an alternative explanation of Lobo’s reference to “human visual inspection” that persuades us that, for a particular image, the regions shown in Figure 13 for wrinkle analysis are determined electronically.

Petitioner’s Rehearing Request invites us to view side-by-side Lobo’s Figures 3, 10(l), and 13, and argues “the wrinkle geography map of Fig. 13 used to define sub-regions to analyze wrinkles is exactly super[-]imposable to the automatically detected anatomical landmarks in the experiment of FIG. 10(l), which in turn correspond to the landmarks defined in the head template of FIG. 3.” Reh’g Req. 7. At the outset, we determine that

² We have considered the Lobo Declaration without deciding specifically whether it was submitted appropriately with Petitioner’s Rehearing Request.

Petitioner's citation in the Petition to Lobo's "figures" generally is insufficient to invite such a comparison. *Id.* (quoting Pet. 22). Thus, we did not overlook or misapprehend this argument, as it was not presented in the Petition. In addition, the shape and similarities of these images indicating they may be super-imposable does not address meaningfully whether the regions shown in the wrinkle map of Figure 13 are determined electronically for any given image.

Petitioner's Rehearing Request also argues that Lobo's suggestion of automatically zooming-in teaches electronically determining a sub-image. Reh'g Req. 7–8. This argument was not included in the Petition's analysis of claim 30 at pages 56–59. We could not have misapprehended or overlooked an argument not presented in the Petition, and, thus, the Rehearing Request does not indicate any error in the Decision on this basis.

Petitioner further argues there is no requirement that the rational underpinning supporting the legal conclusion of obviousness be further supported by expert testimony. Reh'g Req. 8. Yet, according to Petitioner, the Board suggested such expert testimony was needed. *Id.* The Decision determined that several grounds, including those based on Lobo, were insufficient to show a reasonable likelihood of prevailing because they

rely on a combination of teachings from multiple prior art references or modification of a single reference, *without persuasive explanation, expert testimony, or other evidence* as to (1) how teachings from the references are combined or modified, (2) the reasons one of ordinary skill in the art would have combined or modified the teachings to arrive at the claimed invention, or (3) whether one of ordinary skill in the art would have been able to combine the teachings in the manner claimed.

Decision 14 (emphasis added). We did not determine that expert testimony was necessary. As to modifying Lobo to render the subject matter of claim 30 obvious, the Petition states that the electronically determining step was “obvious relative to what is disclosed in Lobo.” Pet. 57. No further explanation is provided in the Petition as to the specific modification proposed, the reasons one of ordinary skill in the art would have modified Lobo’s teachings, or whether one of ordinary skill in the art would have been able to make the necessary modification. Even in Petitioner’s Rehearing Request, Petitioner repeats that “[i]t would have been also obvious” to have combined teachings of certain references without any explanation as to the reasons for doing so. Reh’g Req. 10. Such assertions are insufficient to show a reasonable likelihood of prevailing on a challenge based on obviousness.

In view of the foregoing, we are not persuaded that the Decision Denying Institution misapprehended or overlooked relevant argument or evidence presented in the Petition, or that the Decision erred in determining that Petitioner did not establish a reasonable likelihood of prevailing on its contention that claims 30 and 32–37 are unpatentable under 35 U.S.C. § 103(a) over Lobo, alone or in combination with Pelfini.³

³ We have not considered Petitioner’s arguments regarding Lobo and claims other than claims 30 and 32–37, as these were the only claims asserted to be invalid based on Lobo with sufficient particularity to be considered as a separate ground.

B. Whether the Board misapprehended Petitioner's contentions based on Smith (Ex. 1009)

Petitioner argues “[t]he Board’s assertion that in Smith: ‘there is no indication in the above-recited paragraph of Smith that any parameter stored in the database relates to more than one pathological case’ is an abuse of discretion.” Reh’g Req. 11 (quoting Decision 12, which discusses Ex. 1009, 16). We are not persuaded by Petitioner’s position.

Petitioner emphasizes Smith’s disclosure (Ex. 1009) regarding “‘*known pathological cases*’” in the plural, and argues that “Smith’s proposed database includes data from more than a single pathological case.” Reh’g Req. 11–12 (quoting Pet. 32). We agree, but this portion of Petitioner’s argument is based on an apparent misunderstanding of our findings relating to Smith. As we further explained in our Decision, “even if a dermatologist reviewed several known cases (each with associated parameters) in order to diagnose the stage of the patient’s disease, Petitioner has not identified in Smith a ‘predetermined value’ associated with a group (or population) of known cases.” Decision 12. Thus, we recognized that Smith teaches a database that stores data relating to multiple pathological cases, but we determined that the paragraph at page 16, lines 18–21, of Smith does not indicate that any one piece of information in the database relates to more than one pathological case.

Petitioner argues that the Smith database “can and does store the same *type of parameter* for several pathological cases.” Reh’g Req. 12 (emphasis added). We find this is a reasonable inference based on Smith, and our Decision did not find otherwise. Claim 1, however, requires comparison with a “predetermined value” associated with a population of people, not

merely a group of cases with potentially different values for the same type of parameter. Thus, Petitioner's argument is not commensurate with the scope of claim 1 and does not persuade us of error in our Decision.

Petitioner's argument that "Smith's method clearly enables the computation of percentiles, which is the same method of comparing a given case to a population of people claimed in the '003 Patent," also is misplaced. Reh'g Req. 12. Providing the data necessary to perform a step is not the same as teaching performance of the step. Petitioner further argues in the Rehearing Request that one of ordinary skill in the art, "having ordinary curiosity and creativity, would have also been motivated to set predetermined values for effective 'exampl[ing]'" Reh'g Req. 12 (citing *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)).⁴ This conclusory argument is not developed sufficiently in the Petition to show a reasonable likelihood of prevailing on contentions of unpatentability based on Smith.⁵

⁴ We note that Petitioner's arguments in the Petition and Rehearing Request repeatedly rely on Smith's alleged use of the term "exampl[ing]," but Petitioner misquotes Smith, which uses the term "enabl[ing]," not "exampl[ing]." *Compare* Ex. 1009, 16:20–21 (referring to "reference bitmaps and parameters relating to known pathological cases, for *enabl[ing]* the dermatologist to accurately diagnose the stage of disease" (emphasis added)), *with, e.g.*, Pet. 32 (misquoting the same passage as "*relat[ing] to known pathological cases, for exampl[ing] the dermatologist to accurately diagnose*"). The Decision was based on the actual text of Smith, but we note that use of the term "exampl[ing]" would not have altered the conclusions reached in the Decision.

⁵ The Petition asserts that the teaching of "'a population of people' comparison step . . . is inherent" in Smith (page 12, lines 12–22) because "[d]ermatologists and health professionals are motivated to make threshold or parameter adjustments by their experience with a 'population of people,' namely, their patients." Pet. 32. The unpatentability analysis of claim 1

In view of the foregoing, we are not persuaded that the Decision Denying Institution misapprehended or overlooked relevant argument or evidence presented in the Petition, or that the Decision erred in determining that Petitioner did not establish a reasonable likelihood of prevailing on its contention that claims 1–4, 8, 9, 11, 12, 14, and 38–41 are unpatentable under 35 U.S.C. § 103(a) over Smith.

C. Whether the Board misapprehended Petitioner’s contentions based on Pelfini (Ex. 1005) and Cunliffe (Ex. 1003)

Petitioner argues “[t]he Board misapprehended or overlooked relevant portions of the Petition in finding that: ‘Petitioner does not explain how the black-and-white method of Pelfini could be adapted to provide the nuanced, qualitative measures that are the goal of Cunliffe.’” Reh’g Req. 13 (quoting Decision 18). Petitioner contends “[t]he Petition proposed applying the statistical analysis of Cunliffe to the numerical severity determined by Pelfini, not the reverse – that Pelfini be adapted to automatize the 4-grades evaluation of Cunliffe.” *Id.* (citing Pet. 53).

The extent of analysis in the Petition specific to the unpatentability of claim 1 based on Cunliffe (Ex. 1003) and Pelfini (Ex. 1005), which we treat as representative for purposes of the Rehearing Request on this ground, is the contention that:

Pelfini can be combined with Cunliffe to use the computer analysis method proposed in Pelfini to “electronically analyze” acne skin defects from a “digital image”, instead of using the four visual grades method of Cunliffe. Cunliffe in view of Pelfini therefore teaches all the steps of claim 1 in the ‘003 patent, a

does not rely on this assertion, and instead argues the comparison step is taught in Smith’s paragraph at page 16, lines 18–21, discussed above.

decade prior to '003 patent filing, including the acquisition and use of a digital image and electronic analysis.

Pet. 53–54. As an initial matter, as we explained in the Decision, this contention lacks sufficient “explanation, expert testimony, or other evidence” regarding:

- (1) how teachings from the references are combined or modified,
- (2) the reasons one of ordinary skill in the art would have combined or modified the teachings to arrive at the claimed invention, or
- (3) whether one of ordinary skill in the art would have been able to combine the teachings in the manner claimed.

Decision 14. The Rehearing Request does not point to any additional explanation or analysis in the Petition that we misapprehended or overlooked.

In addition, the Decision more specifically addressed the proposed combination of prior art teachings as we understood it based on Petitioner’s argument. Based on the context of the contentions as to Cunliffe and Pelfini, we understood the Petition to be relying primarily on Cunliffe for the steps of claim 1, but modified to be performed electronically like the method in Pelfini. Pet. 48–49, 53–54. In particular, the Petition correlates the steps of claim 1 with teachings in Cunliffe, but asserts that in Cunliffe the analysis “is likely performed de visu by dermatologists, although nothing is preventing to perform [the claimed] step ‘electronically’ using a ‘digital image.’” Pet. 48–49. As to the combination of Cunliffe and Pelfini, there is no limitation-by-limitation analysis showing in particular which limitations of claim 1 are found in each reference. See Pet. 53–54. Therefore, we understood “us[ing] the computer analysis method proposed in Pelfini to ‘electronically analyze’ acne skin defects from a ‘digital image’, instead of

using the four visual grades method of Cunliffe,” Pet. 53, to mean using a computer to analyze the acne rather than perform visual inspection as taught by Cunliffe. The Petition, however, lacked sufficient explanation as to how Pelfini’s computer analysis method could be adapted to provide the results sought in Cunliffe. See Decision 17–18.

To the extent Petitioner instead intended to propose “applying the statistical analysis of Cunliffe to the numerical severity determined by Pelfini,” Reh’g Req. 13, the Petition fails to state as much,⁶ fails to map the remaining limitations of claim 1 to teachings in Pelfini, and fails to discuss the reasons why one of skill in the art would have combined the particular teachings of the two references in the manner proposed. “In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Furthermore, Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Thus, Petitioner must explain how the proposed combinations of prior art would have

⁶ Petitioner’s Rehearing Request states that “[t]he Petition further explains that a [Person of Skill in the Art] would have applied long-existing (i.e. decades) regular statistical analysis methods to any of the electronically determined skin defects severity, as the ones obtained by Pelfini,” but provides no citation to the Petition. Reh’g Req. 13. Regardless, such a statement would not resolve all the deficiencies in the asserted ground of unpatentability, as discussed herein and in our Decision.

rendered the challenged claims unpatentable. The Board is not obligated to sort through the evidence or provide missing evidence to piece together a challenge to a claim based on skeletal arguments provided in the Petition.

In view of the foregoing, we are not persuaded that the Decision Denying Institution misapprehended or overlooked relevant argument or evidence presented in the Petition, or that the Decision erred in determining that Petitioner did not establish a reasonable likelihood of prevailing on its contention that claims 1–4, 8, 9, 11, 12, 14, 15, 30, and 32–41 are unpatentable under 35 U.S.C. § 103(a) over Cunliffe and Pelfini.

D. Whether the Board misapprehended Petitioner’s contentions based on Nachbar (Ex. 1002) and Aitken (Ex. 1004)

Petitioner contends we misapprehended the asserted combination of Nachbar (Ex. 1002) and Aitken (Ex. 1004). Reh’g Req. 14. Petitioner argues:

The Petition asserts applying the same type of statistical analysis as in Nachbar to the defects severities computed in Aitken, in order to provide statistical data representative to populations and compare individual defects to these. (Petition p.[45]: “*the comparing with a population of people (step [35.2]) is expressed in Nachbar, and Aitken teaches use of computer image analysis (step [35.1])*”).

Reh’g Req. 14–15. On this basis, Petitioner argues we “misapprehended or overlooked the Petition in finding that: ‘Aitken . . . is not asserted to teach use of a computer or algorithms specific to determining the ‘ABCD’ parameter taught in Nachbar.’” *Id.* at 14 (quoting Decision 15).

Again, Petitioner overstates the arguments presented in the Petition. The only citation of support for Petitioner’s argument in the Rehearing Request relates to the asserted obviousness of claim 35 as obvious over

Nachbar and Aitken, and this statement asserts that one claimed step is taught in Nachbar and another is taught in Aitken. *See* Pet. 45. As we explained in the Decision, however, “the obviousness of a particular claim depends on the reasons one of ordinary skill would have modified particular teachings of the prior art to achieve the claimed invention and whether there would have been a reasonable expectation of success in doing so.” Decision 15. The Petition lacks specific reasoning and evidence as to how one of skill in the art would have combined teachings from Nachbar and Aitken and the reasons for doing so. Petitioner’s more specific explanation in the Rehearing Request as to which teachings from Nachbar and Aitken would have been combined and potential reasons for doing so, *see* Reh’g Req. 14–15, does not persuade us that the Decision misapprehended or overlooked anything presented in the Petition regarding this asserted ground of unpatentability.

IV. CONCLUSION

Upon consideration of Petitioner’s Rehearing Request, the Decision, and the evidence of record as of the date of the Decision, we determine that Petitioner has not demonstrated an abuse of discretion in the Decision. Accordingly, we deny the request for rehearing.

V. ORDER

Accordingly, it is

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

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