

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG SDI CO., LTD., SAMSUNG SDI AMERICA, INC.,
SAMSUNG ELECTRONICS CO., LTD.,
and SAMSUNG ELECTRONICS AMERICA, INC.
Petitioner,

v.

UBE INDUSTRIES, INC.,
Patent Owner.

Case IPR2017-02115
Patent 6,033,809

Before RAE LYNN P. GUEST, JO-ANNE M. KOKOSKI, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

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

I. INTRODUCTION

Samsung SDI Co., Ltd., Samsung SDI America, Inc., Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed a Request for Rehearing (Paper 9, “Request” or “Req. Reh’g”) of our Decision (Paper 8, “Decision” or “Dec.”) denying institution of an *inter partes* review of claims 2–8, 10–12, 14, 15, and 17–24 of U.S. Patent No. 6,033,809 as amended by Reexamination Certificate No. 6,033,809 C1 (“the ’809 patent,” Ex. 1001). In our Decision, we determined that the information presented in the Petition raised the same or substantially the same prior art or arguments as those previously presented to and considered by the Office, and we exercised our discretion pursuant to 35 U.S.C. § 325(d) not to institute an *inter partes* review of the ’809 patent on the grounds raised by Petitioner in this case. Dec. 18–20. In particular, we determined that Petitioner relies on substantially the same disclosures in Simon-161,¹ Simon-93,² and Shishikura³ in substantially the same manner as the Examiner considered Yamahira⁴ in the *ex parte* reexamination. *Id.* at 12–17.

¹ French Patent App. Pub. No. 2 719 161, published Oct. 27, 1995 (Ex. 1004). Our references to “Simon-161” are to the English translation of the original reference.

² *Electrochemical study of the passivating layer on lithium intercalated carbon electrodes in non-aqueous solvents*, 43 J. Power Sources 65 (1993) (Ex. 1005).

³ Japanese Patent App. Pub. No. 62-100948, published May 11, 1987 (Ex. 1006).

⁴ Japanese Patent App. Pub. No. H10-050342, published February 20, 1998. Ex. 1010, 244–263 (English translation). The cited page numbers in Ex. 1010 refer to the numbers added by Petitioner in the bottom-right corner of the page.

In its Request, Petitioner contends that the Board misapprehended or overlooked evidence showing that “Simon-161 cures a critical deficiency of Yamahira that the Examiner cited as a reason for patentability.” Req. Reh’g 3–4. Petitioner argues that “Yamahira only discloses (i) working examples having propane sultone in combination with a linear carbonate, but no cyclic carbonate, and (ii) comparative examples having a cyclic carbonate and a linear carbonate, but no sultone.” *Id.* Petitioner argues that, in contrast, “the working examples of Simon-161 disclose the combination of (1) a cyclic carbonate, (2) a linear carbonate, and (3) a small amount of additive, which may be propane sultone, in a single embodiment.” *Id.* at 3. We have reviewed Petitioner’s Request and carefully considered Petitioner’s arguments. For the reasons discussed below, we deny Petitioner’s Request for Rehearing.

II. ANALYSIS

When rehearing a decision on a petition, the Board will 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 the law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004) (citing *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000)). The request must identify, with specificity, all matters that the requesting party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, opposition, or reply. 37 C.F.R. § 42.71(d). Additionally, Petitioner, as the party challenging the Decision, has the burden of showing it should be modified. *Id.*

In the Request, Petitioner argues that “the difference between Simon-161 and Yamahira is material and non-cumulative because the disclosure of Simon-161 cures the deficiency that led to the allowance of the claims.” Req. Reh’g 5. Specifically, Petitioner argues that the Examiner recognized that “Yamahira does not explicitly teach an electrolyte dissolved in a non-aqueous solvent composition *comprising linear and cyclic carbonates as main components at the same time as a sultone derivative.*” *Id.* (citing Ex. 1010, 181 (emphasis added by Petitioner)). *Id.* Petitioner argues that “Simon-161 cures this deficiency because the inventive examples (i.e., Examples 2 and 4) *explicitly teach a solvent composition comprising linear and cyclic carbonates as main components at the same time as an additive.*” *Id.* at 6 (citing Pet. 29–30). Petitioner argues that Simon-161 teaches that the additive may be propane sultone. *Id.* (citing Pet. 32).

Petitioner further argues the Examiner withdrew the rejection of the claims based on Yamahira because the Examiner stated:

To arrive at the non-aqueous electrolytes of claims 2 and 10 from the teachings of Yamahira, a skilled artisan would have had to partially replace propane sultone in the inventive examples of Yamahira with ethylene carbonate. It would have been extraordinary for a skilled artisan to replace the superior solvent, propane sultone, in the inventive examples of Yamahira with the inferior solvent, ethylene carbonate.

Req. Reh’g 7 (quoting Ex. 1010, 5). Petitioner argues that this reasoning does not distinguish the claims of the ’809 patent “from Simon-161 because a skilled artisan would not ‘have had to partially replace propane sultone in the inventive examples of [Simon-161] with ethylene carbonate’” because “[t]he inventive examples of Simon-161 already include the combination of a linear carbonate, a cyclic carbonate, and an additive” such as propane

sultone. *Id.* Therefore, according to Petitioner, “the Board’s conclusion that Simon-161 and Simon-93 are ‘substantially similar and cumulative of’ Yamahira is based on a misapprehension of the difference between the references.” *Id.* at 8.

Petitioner directs us to pages 28–32 of the Petition as support for its arguments. Req. Reh’g 3–13. At pages 28–31, the Petition argues that Simon-161 teaches “the non-aqueous solvent contains, as main components, a cyclic carbonate and a linear carbonate” limitation of claim 1. Pet. 28–31. In particular, the Petition at pages 28–31 includes arguments that compare the cyclic and linear carbonates identified in the ’809 patent with those used in the examples of Simon-161, and describes the components used in Examples 1–4 of Simon-161. *Id.* At page 32, the Petition argues that Simon-161 discloses using propane sultone as an additive, and that Simon-93 discloses the amount of propane sultone to use, such that the combination of Simon-161 and Simon-93 discloses the “0.1 to 4% by weight, based upon the total weight of the non-aqueous solvent, of a sultone derivative” limitation of claim 1. *Id.* at 31–32.

We are not persuaded that these pages of the Petition establish that Simon-161 discloses the combination of a cyclic carbonate, a linear carbonate, and an additive such as propane sultone in a single embodiment, which Petitioner characterizes as the significant distinction between Simon-161 and Yamahira. Req. Reh’g 1; *see also id.* at 3–4 (citing pages 29–32 of the Petition as demonstrating that Simon-161 discloses the three elements in a single embodiment). On the contrary, as we stated in the Decision, the cited disclosures in Simon-161 demonstrate that Simon-161

describes an electrolyte solution that comprises a mixture of at least two organic solvents wherein the additive in the first

embodiment is “of the same type as at least one of the said solvents and is composed of at least one unsaturated bond” such as vinylene carbonate and its derivatives, and the additive in the second embodiment is, among others, butane sultone or propane sultone.

Dec. 14 (citing Ex. 1004, 2:19–3:3, 3:21–4:6). Simon-161 does not teach that the electrolyte solution in the second embodiment contains a cyclic and a linear carbonate, such that the second embodiment discloses propane sultone added to a solution containing a cyclic carbonate and a linear carbonate as Petitioner contends.

Petitioner’s arguments in the Request include an analysis of non-exclusive factors set out in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (informative) that the Board should consider when evaluating whether to exercise its discretion to deny institution pursuant to § 325(d). Req. Reh’g 2–13. These factors are presented and analyzed for the first time in the Request, and, consequently, Petitioner’s arguments with respect thereto could not have been overlooked or misapprehended by the Board.⁵

In any event, we identified and considered these factors in the Decision (Dec. 7–8), concluded that the disclosures in Simon-161 and Simon-93 are substantially similar to, and cumulative of, the disclosures in Yamahira the Examiner considered during the *ex parte* reexamination, and further concluded that the manner in which Petitioner relies on Simon-161

⁵ Petitioner did not seek leave to file a reply to Patent Owner’s Preliminary Response in order to address Patent Owner’s argument that the Petition should be denied pursuant to 35 U.S.C. § 325(d). *See* 37 C.F.R. § 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.”).

and Simon-93 has substantial overlap with the Examiner's rejection during reexamination (*id.* at 18–19). Petitioner's arguments in the Request do not persuade us of error in these conclusions. Rather, Petitioner's arguments endeavor to distinguish the Examiner's prior consideration of Yamahira to provide a reason why we should readjudicate substantially the same prior art. We decline to alter our decision to exercise our discretion to deny institution based on these new arguments. Moreover, to the extent that Petitioner is arguing that the exercise of our discretion to deny institution is in error because the disclosures in Yamahira and Simon-161 are not identical, that argument is unavailing. Because, under 35 U.S.C. § 325(d), we have discretion to reject a petition if “the same or *substantially the same* prior art or arguments were presented to the Office,” Petitioner has not established that we abused our discretion in denying the Petition because substantially the same prior art or arguments were previously before the Office. *See* 35 U.S.C. § 325(d) (emphasis added).

III. CONCLUSION

We have reviewed all of the arguments in Petitioner's Request and find them to be without merit. For the reasons given above, we conclude that Petitioner has not met its burden of showing an abuse of discretion, or that we misapprehended or overlooked any of Petitioner's arguments or evidence, in exercising our discretion under 35 U.S.C. § 325(d) to deny institution of review of the '809 patent.

IV. ORDER

In consideration of the foregoing, it is hereby
ORDERED that Petitioner's Request for Rehearing is *denied*.

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