

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROLAND CORPORATION
Petitioner

v.

INMUSIC BRANDS, INC.
Patent Owner

Case IPR2018-00335
Patent 9,424,827

Before DEBRA K. STEPHENS, J. JOHN LEE, and KAMRAN JIVANI,
Administrative Patent Judges.

STEPHENS, *Administrative Patent Judge.*

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

I. INTRODUCTION

Roland Corporation and Roland US (“Petitioner”) timely filed a Request for Rehearing under 37 C.F.R. § 42.71(d) on August 1, 2018 (Paper 15 (“Req. for Reh’g”)). Petitioner’s Request for Rehearing seeks reconsideration of our Decision Denying Institution of *Inter Partes* Review (Paper 14, “Decision”) entered on July 2, 2018. Petitioner disagrees with the Decision with respect to Grounds 1, 5, and 2 and specifically:

Claim(s)	Basis	References
15	§ 102(a)(1)	Puschner
15, 17, and 18	§ 103	Puschner and Yoshino ’117
15–18	§ 102(a)(2)	Mishima

(Req. for Reh’g 1).

Petitioner asserts, “[t]he Board erred in finding that Petitioner has failed to make a sufficient showing that ‘an acoustic noise reducing cavity’ as recited in claim 15 is taught by Puschner (Ex. 1007) or by Mishima (Ex. 1009)” and “in finding that Petitioner did not identify where Yoshino ’117 (Ex. 1010) teaches or suggests the claimed ‘acoustic noise reducing cavity[.]’” (Req. for Reh’g 1). In particular, Petitioner contends the Board erred in concluding the Petitioner failed to establish a reasonable likelihood Petitioner would prevail in showing:

independent claim 15 is anticipated by Puschner;

independent claim 15 and dependent claims 17 and 18 are anticipated by Mishima; and

independent claim 15 and dependent claims 16–18 are obvious over

Puscher and Yoshino '117

(*id.* at 1–2).

For the reasons provided below, we *deny* Petitioner’s request.

II. ANALYSIS

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” (37 C.F.R. § 42.71(d)). The party challenging a decision bears the burden of showing the decision should be modified (*id.*).

A. *Alleged Anticipation by Puschner: claim 15*

“It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates” (*In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations and internal quotation marks omitted)).

“[A]nticipation by inherent disclosure is appropriate only when the [single prior art] reference discloses prior art that must necessarily include the unstated limitation.” *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 (Fed. Cir. 2002) (citation omitted). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Cont’l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (internal quotation marks and citations omitted). Rather, “[t]he inherent result must inevitably result from the disclosed steps....” *In re Montgomery*, 677 F.3d 1375, 1380 (Fed. Cir. 2012)

(*U.S. Water Services, Inc. v. Novozymes A/S*, 843 F. 3d 1345 (Fed. Circ. 2016)).

Petitioner contends the Board erred in concluding Petitioner has failed to make a sufficient showing that Puschner discloses the recited “acoustic noise reducing cavity” (Req. for Reh’g 2).

In the Petition, Petitioner sets forth:

Regarding claim 19, Puschner describes a cavity within Puschner’s drum rim 5. (Ex.1008, Fig. 2 and ¶[0017].) Regarding claims 1 and 15, Puschner’s cavity would have *inherent* noise reducing ability, in that the material of Puschner’s drum rim 5 and silicon cones 3 in the cavity *inherently* absorb and filter some acoustic vibration, and Puschner’s mesh drumhead 4 minimizes acoustic noise in the cavity,

(Pet. 8 (emphases added) (citing Ex.1002 ¶ 52).) Dr. Paradiso’s cited testimony is almost identical in statement and does not add any further supporting evidence or reasoning (Ex.1002 ¶ 52).

As noted in our Decision, Petitioner failed to persuade us that such features are *necessarily* present in Puschner’s structure (Dec. 19). Rather, Petitioner set forth a conclusory statement that the cavity would have inherent noise reducing ability and, specifically, that the material of Puschner’s drum rim 5 and silicon cones 3 in the cavity inherently absorb and filter some acoustic vibration (Pet. 8; Ex. 1002 ¶ 52). Petitioner did not provide any testimony or evidence in the Petition to show that the material of the drum rim and silicon cones *necessarily* results in an “acoustic noise reducing cavity” (see Dec. 19).

In the Request for Rehearing, Petitioner now provides additional discussion including pointing to discussion related to claims 3 and 4 to support their arguments that “mesh drum heads were known to a POSA [(person of ordinary skill in the art)] . . . to have strands of ductile fiber arranged in a lattice *to minimize the production of acoustic waves within the acoustic cavity*” (Req. for Reh’g 3 (citing Pet. 13; Ex. 1002 ¶ 57)). Indeed, Petitioner introduces additional arguments

and specifically, that “Puschner’s elastic silicone cones 3 must absorb some acoustic vibrations in the same manner in which the ’827 patent describes dampening material 311 as absorbing acoustic vibrations” (*id.* at 4). None of these arguments or support, however, were presented by Petitioner in the Petition with respect to claim 15. Indeed, Petitioner does not identify anything in the Petition or evidence cited therein on this issue that the Board misapprehended or overlooked.

B. *Alleged Obviousness over Puschner and Yoshino ’117: Claims 15, 17, and 18*

Petitioner contends the Board erred in concluding Petitioner has failed to make a sufficient showing that the combination of Puschner and Yoshino ’117 teaches the recited “acoustic noise reducing cavity” of claim 15 (Req. for Reh’g 2).

In the Petition, Petitioner asserted the following:

As discussed above, Puschner anticipated an acoustic noise reducing cavity, in that Puschner describes a drum rim 5 that defines a cavity. It was well known to a POSA . . . to have employed an acoustic noise reducing cavity in an electronic drum, to reduce acoustic noise of impacts as taught, for example, by Yoshino ’117. It would have been obvious to a POSA . . . to have included a noise reducing cavity as taught by Yoshino ’117 as the cavity for Puschner’s drum rim 5. Motivation would have included a desire to reduce acoustic sound that would otherwise negatively affect the electronic sound produced from the electrical signal generated by the transducer, as taught by Yoshino ’117

(Pet. 19–20 (*citing* Ex.1002 ¶ 74.)).

In the Request for Rehearing, Petitioner points to their discussion of claim 2 (Req. for Reh’g 9 (*citing* Pet. 22)) and other discussion in the Petition regarding Yoshino ’117 relating to different limitations (Req. for Reh’g 10–12).

As set forth above, we were not persuaded by Petitioner’s arguments that Puschner anticipated an acoustic noise reducing cavity. Moreover, as we stated in our Decision, Petitioner did not “identify where Yoshino ’117, directed to an ‘electronic percussion instrument and vibration *detection* apparatus,’ teaches or suggests the claimed ‘acoustic noise *reducing* cavity’” (Dec. 21). Petitioner provided no cites to Yoshino ’117 to support its assertion that Yoshino ’117 teaches “an acoustic noise reducing cavity in an electronic drum” in either the Petition or the Declaration of Dr. Paradiso with respect to this asserted ground (Pet. 19–20; Ex. 1002 ¶ 74). We also determined Petitioner had not proffered persuasive argument as to why an ordinarily skilled artisan would have found it obvious to combined the teachings (Dec. 21). Rather, Petitioner merely proffered the conclusory statement that “it would have been obvious” because of “a desire to reduce acoustic sound . . .” (Pet. 19–20) — i.e., it would have been obvious to have the recited feature. Moreover, we determined Petitioner had not “explained how the teachings of Puschner’s and Yoshino ’117’s different structures would have been combined to teach the invention,” as recited in claim 15 (Dec. 21).

Petitioner has not identified any matter that the Board misapprehended or overlooked, or identified where each matter was previously addressed, in the relevant portions of the Petition or cited evidence. Petitioner did not fully address how the references taught the limitation or the reasons for combining the teachings.

C. *Alleged Anticipation by Mishima: Claims 15–18*

Petitioner contends “[t]he Board erred in finding that Petitioner failed to make a sufficient showing that Mishima teaches ‘an acoustic noise reducing cavity,’ as recited in claims 15 and dependent claims 17 and 18 (Req. for Reh’g 6). According to Petitioner, the Petition explained how Mishima teaches the acoustic noise reducing cavity (*id.* (*citing* Pet. 28)). In the Petition, Petitioner set forth

Mishima describes a cavity defined by the “hollow cylindrical drum shell 50.” (Ex.1009, 11:59-60; Figs. 2-3.) Regarding claims 1 and 15, Mishima’s cavity would have had some *inherent* noise reducing ability, in that the material of the drum shell 50 and the resilient member 135 *inherently* absorb and filter some acoustic vibration and, thus, *inherently* provided some noise reducing capabilities. Just as the dampening material 711 is used to prevent acoustic waves in the ‘827 patent (Ex.1001, 10:48-50), Mishima’s resilient member 135 would do the same. Also, Mishima’s use of a mesh material 56 for the head 12 teaches to minimize acoustic noise in the cavity. (Ex.1002, ¶ 92.)

(Pet. 28 (emphases added)).

The first cited portion of Mishima describes “[t]he percussion detecting apparatus **10** has a hollow cylindrical drum shell 50” (Ex. 1009, 11:59–60). Neither Figure 2 nor 3 of Mishima provides any description as to material or characteristics of the elements. The second cited portion of Mishima describes, “FIG.16B is a fragmentary enlarged perspective view showing an intermediate portion of a percussion surface part of the percussion detecting apparatus” (*id.* at 10:48–50). Again, this cited portion fails to describe the material or characteristics of the elements. Petitioner further cites to Dr. Paradiso’s testimony, which is almost identical to that set forth in the Petition (*compare* Ex. 1002 ¶ 92 with Pet. 28).

As set forth in our Decision, we found “Petitioner has not shown the structure of Mishima’s drum would *necessarily* create an acoustic noise reducing cavity. Indeed, Petitioner proffers no evidence or argument to support its assertion that this feature is inherent aside from the conclusory assertion that it is” (Dec. 26).

In the Request for Rehearing, Petitioner now provides additional explanation and figures to support their assertion that Mishima discloses the recited “acoustic noise reducing cavity” (*see* Req. for Reh’g 6–8). Petitioner, however, has not

identified any matter the Board misapprehended or overlooked, or identified where each matter was previously addressed, in the Petition or cited evidence.

III. CONCLUSION

For the forgoing reasons, Petitioner has not shown that the Board misapprehended or overlooked arguments or evidence in concluding that Petitioner had not shown the relied upon references disclosed or taught the recited “acoustic noise reducing cavity.” For the same reasons as discussed in the Decision, Petitioner’s Request for Rehearing similarly is not persuasive as to Petitioner’s position on the inherency or obviousness of recited features. The Board cannot misapprehend or overlook arguments that Petitioner did not make in the Petition. Petitioner’s arguments regarding this limitation fails to identify what we misapprehended or overlooked as required by 37 C.F.R. § 42.71(d). Thus, Petitioner has not carried its burden of demonstrating that the Board’s Decision should be modified (*see* 37 C.F.R. § 42.71(d)).

IV. ORDER

It is hereby ORDERED that Petitioner’s request for rehearing is *denied*.

Case IPR2018-00335

Patent 9,424,827

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