

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3M COMPANY,
Petitioner,

v.

WESTECH AEROSOL CORPORATION,
Patent Owner.

Case IPR2018-00576
Patent 7,705,056 B1

Before JON B. TORNQUIST, JEFFREY W. ABRAHAM, and
AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

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

INTRODUCTION

3M Company (“Petitioner”) requests rehearing of our Final Written Decision (Paper 47, “Decision”) determining, in relevant part, that Petitioner had not demonstrated by a preponderance of the evidence that claims 3 and 4 of U.S. Patent No. 7,705,056 B1 (Ex. 1001, “the ’056 patent”) would have been unpatentable in view of certain references. Request for Rehearing 63–64 (Paper 48, “Rehearing Request” or “Request”). For the reasons set forth below, the Rehearing Request is *denied*.

STANDARD OF REVIEW

Pursuant to 37 C.F.R. § 42.71(d):

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. 37 C.F.R. § 42.71(c). An abuse of discretion exists where a “decision [i]s based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988).

ANALYSIS

Petitioner requests rehearing of the Board’s determination that claims 3 and 4 of the ’056 patent are not unpatentable over the combination of the

Carnahan Publication¹, Braud², and the knowledge of the ordinarily skilled artisan. Request 1. Petitioner submits that its challenge to claims 3 and 4 “relies on the Carnahan Publication’s express teaching of a canister pressure of 120 psi—a teaching the Board did not confront.” *Id.* In particular, Petitioner contends that

the Board “misapprehended or overlooked” (i) the evidence concerning canister pressures below 220 psi set forth in Ground 4 and its impact on the obviousness of claims 3 and 4; (ii) the deposition testimony of 3M’s expert, Dr. Prud’homme, and (iii) the testimony of Patent Owner’s expert, Dr. Wanat, who not only agrees that the Carnahan Publication discloses an embodiment with 120 psi, but that it teaches that canister pressures below 220 psi “could be used.”

Id. at 4.

A. Argument based on canister pressures below 200 psi

Petitioner contends that the Board misapprehended or overlooked the evidence concerning canister pressures below 220 psi. Request 4. Petitioner argues that the reason to modify the teachings of the Carnahan Publication and Braud differ from those advanced for the combination of Takashima and Braud. *Id.* at 5. Therefore, Petitioner contends the reasoning employed by the Board in concluding that Petitioner had not shown by a preponderance of the evidence that the combination of Takashima and Braud would have rendered claims 3 and 4 obvious, is inapplicable for the combination of the Carnahan Publication and Braud. *Id.* Rather, Petitioner asserts that the

¹ US 2002/0161056 A1, to David W. Carnahan, published October 31, 2002 (“Carnahan Publication”) (Ex. 1013).

² US 5,931,354, to John W. Braud, et al., issued August 3, 1999 (“Braud”) (Ex. 1004).

Carnahan Publication itself describes canister pressures of 120 and 300 psi and that the combination introduced Braud “to apply the known technique of utilizing a combination of a liquefied propellant and compressed gas [disclosed in Braud] to improve the system disclosed in the *Carnahan Publication*.” *Id.*

In our Decision, we found that Petitioner did not demonstrate by a preponderance of the evidence that the subject matter of claims 3 and 4 would have been obvious over the combined disclosures of the Carnahan Publication and Braud, because Petitioner’s arguments that “[i]t was within POSA knowledge to lower the 220–250 psi range disclosed in *Braud* to about 200 psi as part of routine optimization” (Pet. 34), lacked adequate support in the record. Decision 64. In particular, we determined that “Petitioner has offered no reason for the skilled artisan to depart from Braud’s express teachings to adopt a pressure lower than the *minimum* satisfactory amount” of 220 psi as part of “routine optimization.”³ *Id.* at 36.

We did not overlook the evidence concerning canister pressures below 220 psi set forth in the Carnahan Publication. In fact, we recognized that the Carnahan Publication describes a compressed inert gas with a final pressure of 120 psi. Decision 62. Nor did we overlook the impact of this evidence

³ We previously noted that “questions have been raised regarding the evidentiary support for the rationale applied by Petitioner to adjust certain *pressures*, concentrations, and percentages, *through ‘routine optimization’* to arrive at the claimed values. The parties should address these issues during the trial.” Paper 6, 36 (Institution Decision) (emphasis added) (internal citations omitted). Despite our invitation, Petitioner did not address our express concerns in its responsive briefing. *See generally* Petitioner’s Reply (Paper 26, “Pet. Reply”).

on the obviousness of claims 3 and 4, as Petitioner suggests. Request 4. To the contrary, we based our determination, in part, on Petitioner’s assertion that “[t]he *Carnahan Publication* explicitly discloses all the elements claimed in the ’056 Patent, *except* the following: (1) pressure ranges in Claims 3 and 4 . . . [and] (6) inclusion of hydrocarbon propellant within canister” in combination with a compressed gas. Pet. 46 (emphasis added); *see also* Ex. 1003 ¶ 96 (detailing Dr. Prud’homme’s testimony that the Carnahan publication fails, inter alia, to describe a canister pressurized to about 200 psi and about 160–200 psi). Petitioner also emphasized that “all the claims and examples in the *Carnahan Publication* are directed solely to the use of a compressed gas as a propellant—and not in combination with a hydrocarbon propellant.” Pet. 46. We acknowledged that the Carnahan Publication describes two separate canister pressures, i.e., 120 psi and 300 psi, but does not teach the full range of pressures between 120–300 psi⁴ or a dual propellant system including a hydrocarbon propellant and a compressed inert gas. *See generally* Decision 46–56; *see also* Ex. 1015, 6–7 (adding a dual-propellant system including a hydrocarbon propellant and compressed gas and a canister pressure range from 150–350 psi and 160–200 psi). In contrast, Braud describes the claimed dual propellant system but describes a minimum pressure of 220 psi. Decision 35–36; Ex. 1004, 9:24–25, 10:47–

⁴ In our Decision, we mistakenly used the word “ranges” when referring to the two pressure values disclosed in the Carnahan Publication. *See e.g.*, Decision 62. We disagree that the full range of pressures between 120 and 300 psi is taught by the Carnahan Publication—rather, it is clear from the context of our sentence that we consider the Carnahan Publication to teach two discrete data points. Ex. 1013 ¶¶ 62, 65.

49. We agreed with Petitioner that the preponderance of the evidence supported a conclusion of obviousness for claim 2 because a pressure of 300 psi, suggested by *both* the Carnahan Publication (Ex. 1013 ¶ 65) and Braud (Ex. 1004, 9:24–25, 10:47–49), falls squarely within the claimed range of 150–350 psi. Ex. 1001, 9:41–43. However, when examining claims 3 and 4—requiring “about 200 psi” and “about 160–200 psi” respectively (Ex. 1001, 9:44–48)—we determined that neither reference suggests a pressure of below 220 psi *for a dual propellant system*. Petitioner failed to present sufficient argument or identify evidence demonstrating that it would have been obvious to a person of ordinary skill in the art to use the lower pressures disclosed in the Carnahan Publication in a dual propellant system. For example, Petitioner did not argue that the combined system (per the teachings of Braud and the Carnahan Publication), that is, a dual propellant system, would maintain the same properties of the single-propellant system of Carnahan Publication. *See generally* Pet., Pet. Reply. As we explained in our Decision, Braud stresses a minimum of 220 psi is required for its dual-propellant system. Decision 34–36. Moreover, we determined that Petitioner’s explanations for departing from Braud’s pressures were insufficient (*Id.* at 35), noting Patent Owner’s arguments that “the optimum pressure in an aerosol system is dependent on many factors including viscosity, solvent type and mixture, propellant type and amount, the kind of compressed gas used, among other factors.” PO Resp. 39–40 (citing Ex. 2034 ¶¶ 157–158; Ex. 2021, 238:16–230:5). Thus, we cannot agree, as Petitioner suggests, that it would have been routine to optimize the pressure of a dual-propellant system *below* the pressure identified as *a minimum pressure* in the absence of a reason to do so.

In view of the foregoing, we are not persuaded we misapprehended or overlooked Petitioner's arguments and evidence with respect to the teachings of the Carnahan Publication as they relate to claims 3 and 4 of the '056 patent.

B. Argument based on the expert testimony of Drs. Prud'homme and Wanat

In the Request, Petitioner also argues that we misapprehended or overlooked the testimony of Drs. Prud'homme and Wanat that the Carnahan Publication discloses an embodiment with 120 psi and that canister pressures below 220 psi "could be used." Request 4.

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. See 37 C.F.R. § 42.71 (d) (emphasis added). A request for rehearing is not an opportunity to present new arguments or evidence.

Notably, Petitioner does not cite to its Petition in Sections B and C of the Request. See *generally* Request 6–11. The singular citation to Petitioner's Reply purports to explain that "the disclosed embodiments in the Carnahan Publication would have motivated a POSA to test pressures **below** 200 psi in the prior art combination of Ground 4." *Id.* at 7. However, that portion of Petitioner's Reply addresses Patent Owner's contention that the ordinarily skilled artisan would have been unlikely to optimize to achieve the present invention because the large number of variables would "blow up" into an unreasonable number of experiments (Pet. Reply. 23–24 (addressing arguments described in PO Resp. 40)) and *not why* a person of ordinary skill in the art would have had selected certain pressures in the

values claimed in the first instance. Petitioner’s remaining explanation that a person of ordinary skill in the art would have selected three pressure levels within the levels taught by the Carnahan Publication and Braud (Request 8–10) was not advanced in the briefing and is referenced only through citation to the expert reports. See Pet. Reply 23–24 (citing the supplemental testimony of Dr. Prud’homme); 37 C.F.R. § 42.6 (“Arguments must not be incorporated by reference from one document into another document.”). Petitioner’s argument on rehearing amounts to a contention that we overlooked Petitioner’s invitation to formulate arguments on their behalf, search the record for pertinent facts, and inject our own reasoning. That is not our role. See *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 particularly . . . the evidence that supports the grounds for the challenge to each claim”)); See *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”).

Therefore, we are not persuaded that we overlooked or misapprehended any evidence or arguments Petitioner presented in its briefing.

CONCLUSION

We conclude the outcome of this Decision on Rehearing:

Claims	35 U.S.C.	Basis	Granted	Denied
3 and 4	§ 103	Carnahan Publication and Braud		3 and 4
Overall Outcome				3 and 4

ORDER

Accordingly, it is:

ORDERED that Petitioner's Request for Rehearing is *denied*.

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