

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BEDRA, INC., BERKENHOFF GMBH, and
POWERWAY GROUP CO. LTD.,
Petitioner,

v.

SEONG, KI CHUL,
Patent Owner.

Case IPR2018-00668
Patent 6,492,036 B2

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

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

I. INTRODUCTION

Bedra, Inc., Berkenhoff GmbH, and Powerway Group Co., Ltd. (collectively, “Petitioner”) filed a Request for Rehearing (Paper 9, “Request” or “Req.”) of our Decision (Paper 8, “Decision” or “Dec.”) denying institution of an *inter partes* review of claims 2, 5, 7, 8, and 10 of U.S. Patent No. 6,492,036 B2 (Ex. 1003, “the ’036 patent”). Paper 2 (“Pet.”). In our Decision, we determined that the information presented in the Petition did not establish that claims 2, 5, 7, 8, and 10 are not entitled to the June 30, 1997 priority date of the Korean Application. Dec. 8–11.

In its Request, Petitioner contends that the Board: (1) misapprehended the disclosure in Figure 2a2 of the Korean Application; (2) overlooked the Declaration of Dr. Dandridge Tomalin (“the Tomalin Declaration,” Ex. 1004); and (3) did not resolve genuine issues of material fact in the light most favorable to Petitioner. Req. 1–2. 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

A request for rehearing must identify specifically all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a 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.*

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 law, if a factual finding is not supported by substantial

evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004) (citing *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000)).

Petitioner argues that we “misunderstood the disclosure of Fig. 2a2 of the Korean Application and overlooked certain facts of record” when we determined that the Petitioner did not establish that the ’036 patent is not entitled to the priority date of the Korean Application. Req. 7. Specifically, Petitioner argues that Figure 2a2 does not describe “cracks . . . in the alloy layer and the coating layer” as required by all of the challenged claims. *Id.* at 7–14. Petitioner also argues that whether the Korean Application discloses cracks in the alloy layer and the coating layer with reasonable clarity to a person having ordinary skill in the art is a question of fact on which the experts are split, and, therefore, should be resolved in Petitioner’s favor. *Id.* at 14–15.

Petitioner, however, does not point us to where these arguments were made in the Petition. Petitioner’s argument only includes one citation to the Petition, where Petitioner points to figures included in the ’036 patent (Figs. 2 and 3a–3b) that are not found in the Korean Application. Req. 12 (citing Pet. 19). The Petition’s sole reference to Figure 2a2 of the Korean Application is made in a parenthetical reference, without any discussion or explanation. Pet. 20. And although the Tomalin Declaration includes two references to Figure 2a2, it too is devoid of any discussion of its significance.¹ Ex. 1004 ¶¶ 51–52. Per 37 C.F.R. § 42.71(d), Petitioner must

¹ Even if the Tomalin Declaration did more extensively discuss Figure 2a2, Petitioner could not rely on discussion that appears in the declaration but not in the Petition. 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated from one document into another document.”).

point out where the matter was previously addressed in its Petition. We could not have overlooked argument or evidence that was not presented in the Petition. A request for rehearing is not an opportunity to supplement a petition.

Even considering Petitioner's improperly-presented new arguments, we are not persuaded that we abused our discretion in determining that the Korean Application adequately describes cracks in the alloy layer and the coating layer as required by the challenged claims. Dec. 9–11. Assuming *arguendo* that Petitioner is correct that Figure 2a2 does not show such cracks, our Decision is supported by other evidence of record that Petitioner does not dispute.

For example, in response to Petitioner's argument that the Korean Application “*only* describes cracks within the ‘coating layer’ and *not* within any ‘alloy layer,’” (Pet. 20), we stated that the Korean Application “describes the ‘coating layer’ as comprising two sub-layers, one of which is the outer zinc coating layer of the ’036 patent and the other of which is the inner copper-zinc alloy layer of the ’036 patent.” Dec. 9–10 (quoting Ex. 1013, 7; citing Ex. 1013, Fig. 3; Ex. 1003, Fig. 3b). Based on this disclosure, we concluded that “the Korean Application’s description of cracks in the ‘coating layer’ does not necessarily mean that those cracks are confined to the outer zinc layer and fail to reach the inner alloy layer.” *Id.* at 10.

Our Decision further noted that “[t]he evidence of record shows that both the outer zinc layer and the underlying alloy layer would crack when subjected to the process of the Korean Application.” Dec. 10. In that regard, we explained that

the outermost portion of the alloy layer is made of a copper-zinc alloy with “a weight ratio of 45:55.” Ex. 1013, 7. According to Dr. Tomalin, this is “a mixed portion of beta/gamma brass.” Ex. 1004 ¶ 51. Dr. Tomalin further explains that gamma-phase brass “crack[s] under cold drawing” and beta-phase brass “may not crack.” *Id.* ¶ 29 (citing Ex. 1007 ¶¶ 7, 8, 12, 18). The Korean Application also describes cooling the coated wire before drawing it, which is cold drawing. Ex. 1013, 7 (“the hot-dip zinc coated intermediate wire rod is cooled in the air then drawn to a thin wire having a required diameter”). Thus, the Korean Application describes subjecting the wire to a process that will cause some of the outermost portion of the alloy layer to crack and that may cause the remainder of that portion of the alloy layer to crack. The most likely result of this is the creation of cracks in the alloy layer (and the coating layer).

Id. at 10–11. Petitioner does not dispute these findings in the Request.

Given the evidence that the alloy and coating layers described in the Korean Application are likely to crack when drawn, even if we were to accept that Figure 2a2 of the Korean Application does not adequately show cracks in the alloy and coating layers, we are not persuaded that it was an abuse of discretion for us to determine that the Korean Application disclosed such cracks.

We are also not persuaded by Petitioner’s argument that “there is a disagreement between the competing expert opinions about the disclosure of Fig. 2a2 to a [person having ordinary skill in the art]” which, at the institution stage, “should be resolved in favor of Petitioners.” Req. 14–15 (citing 37 C.F.R. § 42.108(b)). As set forth above, our determination that the “cracks . . . in the alloy layer and the coating layer” limitation of the challenged claims does not lack written description support in the Korean Application is supported by undisputed evidence of record other than

Figure 2a2 of the Korean Application. Resolving any dispute between the experts regarding the disclosure of Figure 2a2 in Petitioner's favor does not change that determination.

III. CONCLUSION

Petitioner has not carried its burden of demonstrating that our Decision misapprehended or overlooked any matters, or that the Board abused its discretion.

IV. ORDER

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

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