

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKON CORPORATION,
Petitioner,

v.

CARL ZEISS AG AND ASML NETHERLANDS B.V.,
Patent Owner.

Case IPR2018-00686
Patent 9,728,574 B2

Before GRACE KARAFFA OBERMANN, BRYAN F. MOORE, and
AMBER L. HAGY, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

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

I. BACKGROUND

Nikon Corporation (“Petitioner”) requests *inter partes* review of claims 1–5,¹ 7–10, 16, 24, and 30–33 of U.S. Patent No. 9,728,574 B2 (“the ’574 patent,” Ex. 1001) pursuant to 35 U.S.C. §§ 311 *et seq.* Paper 2 (“Pet.”). Petitioner relies on the testimony of Dr. Stuart Kleinfelder. Ex. 1011. Carl Zeiss AG and ASML Netherlands B.V. (“Patent Owner”) filed a preliminary response. Paper 6 (“Prelim. Resp.”). Upon consideration of the Petition and Preliminary Response, we concluded the information presented did not show there is not a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–5, 7–10, 16, 24, and 30–33 of the ’574 patent. Paper 7, 2 (“Institution Decision,” “Inst. Dec.”).

On October 26, 2018, Petitioner filed a Request for Rehearing (Paper 8 (“Reh’g Req.”)) of our Institution Decision, requesting reconsideration of our decision denying institution of *inter partes* review of claims 1–5, 7–10, 16, 24, and 30–33 of the ’574 patent. Petitioner argues that the “Board misapprehended matters relating to Grounds 1 and 2.” Reh’g Req. 1.

We have considered Petitioner’s Request for Rehearing, and, for the reasons set forth below, Petitioner’s Request is *denied*.

II. STANDARD OF REVIEW

37 C.F.R. § 42.71(d) provides that:

A party dissatisfied with a decision may file a 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*

¹ The Petition, in an apparent typographic error, omits claim 5 from its listing of challenged claims on page 1.

identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

(Emphasis added.) See Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was 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. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted).

III. DISCUSSION

A. 35 U.S.C. § 325(d)

In the Institution Decision, we denied institution of Ground 1 based on our discretion under 35 U.S.C. § 325(d). Inst. Dec. 17. Specifically, we determined that the Kaifu reference relied on by Petitioner was considered during prosecution. *Id.* Petitioner asserts that we misapprehended or overlooked its arguments regarding why its contentions as to Kaifu were not considered by the Examiner.

[S]ubstantial discrepancies between the treatment of Kaifu and Kaifu ‘003 in the file histories of the grandparent application and the ‘574 application suggest that FIGs. 19A and 19B of Kaifu were forgotten [sic] or misapplied by the Examiner during the prosecution of the ‘574 patent . . . [Claims that were] rejected and canceled [over Kaifu ‘003 in the grandparent] were very similar in scope to the challenged claims, and yet during the prosecution of the ‘574 patent, the Examiner apparently forgot that the allegedly missing limitations of the challenged claims were previously found to be disclosed in FIGs. 8a/b of Kaifu ‘003 in the grandparent application.

Reh’g Req. 2–3. Petitioner goes on to state that

very similar limitations to the so-called distinguishing features of the '574 patent claims [18–20] were rejected in the grandparent application over figures identical to FIGs. 19A/B of Kaifu and yet inexplicably the next communication in response to applicant's arguments in the '574 patent prosecution history was a notice of allowance. The most apparent conclusion is that, as stated by the Applicant on multiple occasions in the prosecution history of the '574 patent, the Examiner relied solely upon FIG. 1 from Kaifu and forgot about FIGs. 19A/B of Kaifu.

Reh'g Req. 7–8. In other words, Petitioner repeats its contention that the Examiner relied only on Figure 1 of Kaifu and, as support, states that claims similar to the challenged claims were cancelled/rejected over the related Kaifu '003 reference in the grandparent application.

To the extent Petitioner is suggesting we did not consider that some claims were cancelled while others were allowed over Kaifu '003 in the grandparent, we state here that we did consider that fact when evaluating the arguments to reach the Institution Decision. *See* Inst. Dec. 11 (citing Ex. 1007 (file history of grandparent application), 453–454 (rejection of claim 18–20), 493 (indicating claims 18–20 were cancelled)). Nevertheless, the fact that some claims were cancelled in the grandparent over Kaifu '003 while others were allowed did not persuade us that the Examiner of the '574 patent overlooked FIGs. 19A/B of Kaifu. Thus, we considered these arguments by Petitioner. Inst. Dec. 14, 17 (“[W]e find it is at least unclear whether the Examiner limited his examination to Figure 1 and did not consider Figures 19A/B . . . we are not convinced the Examiner failed to consider Figures 19A/B of Kaifu.”).

Petitioner also asserts we overlooked the fact that some of Patent Owner's arguments regarding § 325(d) were limited to independent claims 9 and 24 and did not encompass claims 1 and 30. Reh'g Req. 9. Specifically,

Petitioner notes that a limitation allegedly similar to the “currently being scanned” limitation considered in the grandparent application is found only in claims 9 and 24 not claims 1 and 30. *Id.* at 8–9.

We considered this fact. In its Preliminary Response, Patent Owner offers two separate rationales for the application of § 325(d) under different headings—one general argument and one argument specific to claims 9 and 24.² We considered both arguments in the Institution Decision. *See* Inst. Dec. 12 (considering general arguments discussed at Prelim. Resp. 42–47); *id.* at 15 (considering arguments specific to claim 9 discussed at Prelim. Resp. 50–52). In sum, we applied a multiple factor test considering all the claims and all the arguments including the fact that the art presented by Petitioner was before the Examiner throughout the prosecution of the ’574 patent, its parent, and its grandparent, and we decided to use our discretion to reject Ground 1 of the Petition. Inst. Dec. 10–17.

For the reasons above, Petitioner’s arguments regarding Kaifu on rehearing are simply expanding or reiterating arguments already made in the Petition. A request for rehearing is not merely the opportunity for the requester to reargue positions, elaborate on previous positions, or to disagree with the analysis or conclusions of the panel. *See Nestlé Purina Petcare Co. v. Oil-Dri Corp. of Amer.*, Case IPR2015–00737, slip op. at 8 (PTAB Feb. 9, 2017) (Paper 39) (“Merely disagreeing with our analysis or conclusions does not serve as a proper basis for a request for rehearing.”). Instead, the

² “V. GROUND 1 IS DEFICIENT BECAUSE KAIFU IS THE SAME PRIOR ART PREVIOUSLY CONSIDERED BY THE OFFICE” (Prelim. Resp. 42–47) and “VI. C. The Office has already found that Kaifu’s Figs. 19A/B fail to disclose or suggest ‘selectively electrically coupling’ as independent claims 9 and 24 recite” (*id.* at 52–54).

requester must identify previously-presented arguments and/or evidence that the panel overlooked or misapprehended. Petitioner fails to do so here, and thus has failed to demonstrate evidence of abuse of discretion by the panel.

For the reasons above, Petitioner's Request for Rehearing fails to show that we overlooked any arguments.

B. Claim 2 - "one or more signals"

In the Decision, we found that the earliest priority date for the '574 patent is January 31, 2006 (the filing date of the grandparent application), and the Yamashita reference, relied on in Ground 2, was published December 13, 2012, after that priority date. Specifically, we found that "since the parent and grandparent undisputedly disclosed the use of one select signal, claim 2 [reciting 'one or more signals'] can be supported by a description even without a reference to 'more signals.'" Inst. Dec. 28. Petitioner argues that we misapprehended the law in making that finding. Reh'g. Req. 9–10 (quoting *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008) ("The written description requirement is not a question of whether one skilled in the art *might* be able to construct the patentee's device from the teachings of the disclosure. . . . Rather, it is a question whether the application necessarily discloses that particular device.")).

In particular, Petitioner asserts we cited cases that used the wrong standard, i.e. the standard for anticipation and infringement rather than the standard for written description. *Id.* at 4. Our Decision did not, however, turn on principles of anticipation or infringement but rather on the scope of the phrase "one or more signals." See Inst. Dec. 28 (finding that disclosure

of a single select signal supports a claim to “one or more select signals” because the latter phrase reads on a single select signal).

Nevertheless, for clarity, we restate here and apply the standard for written description. To satisfy the written description requirement of 35 U.S.C. § 112 ¶ 1, the specification must “clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (internal brackets omitted) (en banc) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). Thus, the specification must reasonably convey to those skilled in the art that the inventor possessed, at the time of filing, the subject matter that he or she has claimed. *Id.* “[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.* Whether a specification complies with the written description requirement is a question of fact. *Id.* at 1351, 1355. Entitlement to a filing date extends only to subject matter that is disclosed, not to that which is obvious. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571–72 (Fed. Cir. 1997).

Petitioner argues that the claim term “one or more select signals” is an alternative recitation, with the alternatives being one signal and more signals. Reh’g Req. 9. We disagree.

The claim scope relevant for a written description requirement is the scope “as construed” by the court. *See Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 994 (Fed. Cir. 1999). Claim 2 recites “wherein the transferring is performed in response to one or more select signals.” Petitioner asserts that the claim language was amended, in prosecution, from

reciting “comprising coupling the first sensing node to the second sensing node in response to a select signal,” and there was no support in the written description of the parent and grandparent applications for the added “more select signals.” Pet. 21 (citing Ex. 1003, 112, 148). Nevertheless, the Examiner allowed the claim as a continuation not a continuation-in-part. *See generally*, Ex. 1001. Apparently, neither the Applicant nor the Examiner found that this claim language required an update to the Specification. We agree with the Examiner.

We determine that because the open ended term “comprising” was used in the original claim reciting “a” signal, the recitation of “a” signal and “one or more” signals would have the same scope. An indefinite article, such as “a,” in patent parlance encompasses “one or more” when used, as here, in open-ended claims containing the transitional phrase “comprising.” *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000). “Unless the claim is specific as to the number of elements, the article ‘a’ receives a singular interpretation only in rare circumstances when the patentee evinces a clear intent to so limit the article.” *Id.* Thus, the claim as amended, which removes the open ended preface “comprising” and changes the modifier of “select signals” from “a” to “one or more,” does not change the scope of the claim in that respect. It merely is a different phrasing.

Thus, as we stated in the Institution Decision, any description of a system with one signal would necessarily support a claim to one or more signals. Inst. Dec. 28. Additionally, the claim, as amended, does not suggest there is choice between alternatives that would meet this claim. For example, the claim does not require a choice between a first type of signal

and a second type of signal. The claim recites “one” signal, which can be optionally accompanied (“or”) by “more” signals.

In arguing the claim does include alternative recitations, Petitioner relies on *Tech. Licensing Corp. v. Videotek Inc.*, 545 F.3d 1316, 1322 (Fed. Cir. 2008) (“*Tech*”). Reh’g Req. 11. In *Tech*, a limitation of the claim in a CIP application recited “coupling said video type signal through a capacitor or other circuit.” *Id.* at 1322. Our reviewing court found that, although coupling said video type signal through “a capacitor” was disclosed in the parent application, support for the “other circuit” language was added in the child patent. *Id.* at 1333. As a result, the court affirmed the trial court’s holding that the parent application did not show the inventor was in possession of the invention as of the filing date of the parent application. *Id.* at 1334.

As an initial matter, in *Tech*, the inventor acknowledged that the “other circuit” was new matter and added description in the child patent to support the “other circuit.” *Id.* at 1333 (“[A]lthough [the inventor] found support for the capacitor in the original written description, the only support that the inventor acknowledged for the “other circuit” was the new matter added in 1995.”). Here, other than the claims, there was no new description added to the specification regarding “more signals.” See Pet. 21.

We determine that *Tech* is distinguishable from the present matter because the claim in *Tech* recited two distinct alternatives—a capacitor or “other circuit,” i.e., not a capacitor. The court in *Tech* determined that disclosure of only one alternative (the capacitor) in the parent application did not support a claim reciting the additional alternative (other circuit) added in the child application. *Tech*, 545 F.3d at 1334. The conclusion that

disclosure of a system using a capacitor would not provide written description support to the recitation of an “other circuit” follows from the simple fact that the claim itself distinguishes the “other circuit” from a capacitor by reciting them as distinct alternatives.

Here, there are no distinct alternatives recited. The claim simply allows that, in addition to the one signal, you may have others. Thus, the single signal disclosed does provide written description support for one or more signals as claimed because a single signal meets the literal claim recitation of “one or more.” The patentee is not required to describe in the specification every conceivable embodiment of his invention. *See Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001). As noted above, the claim does not require a first type of signal or a second type of signal, as would make the claim analogous to that considered in *Tech*. The claim recites simply “one or more.”

For the reasons above, Petitioner’s Request for Rehearing fails to show that we misapprehended the law in reaching the result. Rather, the Petitioner’s arguments in the Request for Rehearing appear to be premised on construing the claim in way that we did not accept in the Institution Decision and do not accept on Rehearing.

C. Conclusion

The requester must identify previously-presented arguments and/or evidence that the panel overlooked or misapprehended. Petitioner fails to do so here, and thus has failed to show an abuse of discretion in our Decision.

IV. ORDER

Accordingly, it is hereby:

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

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