

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKON CORPORATION,
Petitioner,

v.

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

Case IPR2018-00688
Patent 6,463,163 B1

Before JEFFREY S. SMITH, DAVID C. McKONE, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION
PATENT OWNER'S REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner filed a Petition for *inter partes* review of claims 1–4, 6, 7, 9–11, 14–16, and 19 of U.S. Patent No. 6,463,163 B1 (Ex. 1001, “the ’163 patent”). Paper 2 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Patent Owner also filed a statutory disclaimer of claims 9–14. Ex. 2002. Pursuant to 35 U.S.C. § 314, in our Institution Decision (Paper 7, “Dec.”), we instituted this proceeding as to claims 1–4, 6, 7, 15, 16, and 19. Dec. 36.

In a Request for Rehearing (Paper 9, “Req.”), Patent Owner contends that we erred by (1) misapplying the law for the means plus function limitations, (2) failing to hold Petitioner to its burden of establishing a reasonable likelihood of unpatentability over Yow, (3) accepting Petitioner’s unsupported combination of Yow and Crowley, (4) failing to hold Petitioner to its burden of establishing a reasonable likelihood of unpatentability over Kosugi, and (5) improperly instituting trial on grounds relying on the Yow thesis. Req. 1–2. For the reasons below, we deny Patent Owner’s Request for Rehearing.

II. ANALYSIS

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated 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. *See Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The

burden of showing that the Decision should be modified is on Patent Owner, the party challenging the Decision. *See* 37 C.F.R. § 42.71(d). In addition, “[t]he 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.” *Id.*

Patent Owner contends that we misapplied the law for means plus function limitations because, according to Patent Owner, we did not address Patent Owner’s contention that Petitioner’s analysis did not show that the prior art structures are the same or equivalent to structures disclosed in the Specification for performing the functions recited in claims 15, 16, and 19. Req. 3–6. We did address Patent Owner’s contention in our Decision. Dec. 18. In our analysis of the means plus function limitations recited in claim 15, we stated that

The Petition identifies the structure in the Specification corresponding to the claimed “first filtering means” as a linear matched filter, and identifies the equivalent structure in Yow as a matched bandpass filter. Pet. 13–14, 27. The Petition identifies the structure in the Specification corresponding to the claimed “second filtering means” as a non-linear filter, and identifies the equivalent structure in Yow as a non-linear edge detector. Pet. 14, 27.

Id. Our Decision includes similar analyses for claims 16 and 19. *See* Dec. 19. Patent Owner does not persuade us that we misapprehended the law for means plus function limitations. Rather, Patent Owner simply disagrees with our Institution Decision on this issue. Mere disagreement with our conclusion is not a proper basis for rehearing.

Patent Owner contends that we failed to hold Petitioner to its burden of establishing a reasonable likelihood of unpatentability over Yow because, according to Patent Owner, we improperly relied on testimony from

Dr. Essa. Req. 7–9. In our Decision, we addressed this contention, but reached a different conclusion. *See* Dec. 14–15. Similarly, Patent Owner contends that we erred in accepting Petitioner’s unsupported combination of Yow and Crowley, because, according to Patent Owner, we improperly relied on testimony from Dr. Essa. Req. 9–10. We addressed Patent Owner’s contention in our Decision, but reached a different conclusion. *See* Dec. 21–22. Patent Owner also contends that we failed to hold Petitioner to its burden of establishing unpatentability over Kosugi, because, according to Patent Owner, we improperly relied on testimony from Dr. Essa. Req. 10–11. We addressed Patent Owner’s contention in our Decision, but reached a different conclusion. *See* Dec. 29–30. In each of these instances, mere disagreement with our conclusion is not a proper basis for rehearing.

Patent Owner contends that, because our Decision stated that Petitioner did not establish sufficiently that Yow Thesis was available as a printed publication, we should not have instituted trial on the grounds based on Yow Thesis. Req. 6–7 (citing Dec. 26). However, at this time, if the Board institutes a trial, the Board will institute on all challenges raised in the Petition. *See Guidance on the Impact of SAS on AIA Trial Proceedings*, April 26, 2018, available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

Accordingly, we deny Patent Owner’s Request for Rehearing.

III. CONCLUSION

Patent Owner has not shown that we misapprehended the law or overlooked its arguments. Accordingly, we decline to change our Decision.

IV. ORDER

For the reasons given:

Patent Owner's Request for Rehearing is denied.

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