

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DONNER TECHNOLOGY, LLC,
Petitioner,

v.

PRO STAGE GEAR, LLC,
Patent Owner.

Case IPR2018-00707
Patent 6,459,023 C1

Before KEVIN C. TROCK, JOHN A. HUDALLA, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing
of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On September 25, 2019, Petitioner, Donner Technology, LLC ("Petitioner"), filed a request for rehearing (Paper 50, "Req. Reh'g") of our Final Written Decision (Paper 49, "Final Dec."), in which we held that, *inter alia*, Petitioner had not shown by a preponderance of the evidence that

claims 5, 7, 8, 18, 20, and 21 of U.S. Patent No. 6,459,023 C1 (Ex. 1001, “the ’023 patent”) are unpatentable. Final Dec. 51–52, 66, 68–77. For the reasons explained below, Petitioner’s request for rehearing is *denied*.

II. ANALYSIS

The party requesting rehearing has the burden of showing the decision should be modified, which includes specifically identifying all matters the party believes we 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).

A. *Petitioner’s Unpatentability Contentions for Claims 5 and 18*

In our Final Written Decision, we determined that Petitioner had not shown by a preponderance of the evidence that (1) the subject matter of claim 18 would have been obvious over the combination of Boss SCC-700C -700F Sound Control Center Owner’s Manual (Ex. 1006, “SCC-700”) and U.S. Patent No. 3,585,893 (Ex. 1012, “Arseneault”); and (2) the subject matter of claim 5 would have been obvious over the combination of SCC-700, Arseneault, and U.S. Patent No. 6,215,055 B1 (Ex. 1013, “Saravis”). Final Dec. 51–52, 66. In particular, we found that “Petitioner provide[d] no evidence or explanation as to how its proposed combination teaches a frame base that ‘support[s] the frame *above* the surface.’” *Id.* at 52 (second alteration and emphasis in original).

In its Request for Rehearing, Petitioner argues we “overlooked substantial evidence, as Petitioner[’s] analysis for the additional limitation in Claims 5 and 18 is expressly supported by its analysis for Claim 1.” Req. Reh’g 5. Petitioner cites its analysis relative to claim 1 that SCC-700’s

cross-members A–D constitute a “frame” and that an ordinarily skilled artisan would have known “to use a frame base, such as the higher back wall 38 taught by Arseneault, to lift up and support the cross member D or frame of the SCC-700 effects board.” *Id.* at 5–6 (citing Paper 2 (“Pet.”), 51–53, 55–56; Ex. 1012, 1:60–67, 1:72–75, 4:43–46, Figs. 1, 3; Ex. 1015 ¶¶ 46–50, 55–57).

We are not persuaded by Petitioner’s arguments. Petitioner’s analysis of the “above the surface” limitation was framed by its statement in the Petition that claims 5 and 18 are invalid “under 35 U.S.C. § 112, second paragraph, because the ’023 Patent provides no support for the frame . . . being supported *above* the **effect mounting surface**.” Pet. 55 n.8 (italics in original; bolding emphasis added), 69 n.10 (referring to footnote 8); *see also* Final Dec. 51 n.12 (quoting same). Thus, Petitioner associated the “surface” in the recitation “above the surface” with the “effect mounting surface” recited in base claims 2 and 15. Despite this association, Petitioner’s obviousness analysis made no attempt to show that Arseneault’s higher backwall (i.e., the “frame base,” *see* Pet. 51–53, 55–56) supports SCC-700’s cross members A–D (i.e., the “frame,” *see id.* at 50) *above* the units board of SCC-700 (i.e., the “effects mounting surface,” *see* Pet. 46–47).¹ Rather, Petitioner addressed only the “frame base supporting the frame” and “allowing the cable to pass beneath the frame” limitations of claims 5 and 18. *See* Pet. 54–55, 69–70. Thus, we determined that Petitioner’s analysis “[id] not establish that Arseneault teaches ‘a frame base supporting the

¹ As we acknowledged, Petitioner’s analysis for claim 18 builds upon its anticipation analysis for claim 15 and its analysis for the recited “frame” in claim 1. *See* Final Dec. 51–52.

frame *above* the surface’ commensurate with the language of claim 18.”
Final Dec. 52; *see also id.* at 66 (same determination for claim 5).

Petitioner further argues that, “[w]hen the higher backwall 38 or frame base of Arseneault is attached to cross member D or frame of the SCC-700 effects board to lift the frame up to allow wires to pass beneath the frame, the frame is supported ‘above the surface.’” Req. Reh’g 6–7. Notably, however, Petitioner has not previously explained its contentions about alleged support “above the surface” in this manner. Thus, we could not have misapprehended or overlooked Petitioner’s new explanation. Nor is it apparent how Arseneault’s higher backwall “lift[ing] up and support[ing]” the frame of SCC-700—which occurs below SCC-700’s units board—could teach support “above the surface,” as discussed above. Because Petitioner’s analysis failed to address the “above the surface” limitation, we found that Petitioner did not carry its burden of proving unpatentability.

Petitioner also argues that, if we “maintain[] that there is no evidence in the record that the combination of the SCC-700 manual and Arseneault discloses a frame base that supports the frame above the surface, then Petitioner cannot reasonably discern the underlying reasons for the Board’s Decision.” Req. Reh’g 7. Petitioner also notes that our analysis was “limited to . . . three statements.” *Id.* at 7–8 (quoting Final Dec. 49, 52). We do not agree that our Decision fails to state the basis for our determination. Specifically, we indicated that our determination about claims 5 and 18 is based on a failure of proof. Final Dec. 51–52, 66. As further explained above, Petitioner failed to show that the asserted prior art combinations teach a frame base supporting the frame “above the surface.”

Petitioner also argues that, “if the Board has relied upon a particular construction of the phrase ‘*above the surface*,’ then the Board’s construction cannot be reasonably discerned.” Req. Reh’g 8. If that were the case, Petitioner contends we “must articulate and explain [our] construction for the purposes of judicial review.” *Id.* at 9. Yet Petitioner failed to explain in the Petition how the cited references teach the “above the surface” limitations of claims 5 and 18 under *any* construction of these limitations, including the one implied in footnote 8 of the Petition. *See* Pet. 55 n.8, 69 n.10. Petitioner did not specify any dispute regarding the meaning of the term “the surface” and neither did Patent Owner. *See, e.g., id.* at 8–9 (no terms proposed by Petitioner for construction), 55 (Petitioner’s analysis for claim 18 referring to earlier analysis relative to the “effect mounting surface”); Paper 26, 34–41, 43 (no arguments in Patent Owner’s Response based on an interpretation of “the surface”); Paper 34, 16–17 (Petitioner in its Reply referring to arguments in the Petition for “above the surface”). As such, we did not expressly construe “above the surface.” *See, e.g., Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

In addition, Petitioner purports to construe “above the surface” for the first time. *See* Req. Reh’g 2, 7 (stating that the plain and ordinary meaning of “above the surface” is “above the ground” or “above the area to provide spacing for cables to run underneath the frame”). Petitioner could have, but did not, put forth such constructions in its Petition. *See* 37 C.F.R.

§ 42.104(b). Thus, to the extent Petitioner attempts to clarify the plain and ordinary meaning of “above the surface” in the Request for Rehearing (see Req. Reh’g 7), Petitioner’s arguments come too late. And Petitioner never previously attempted to associate the recited “surface” with “the ground” or “the area to provide spacing for cables to run underneath the frame.”

Contrary to Petitioner’s new constructions, and as explained above, Petitioner previously associated the recited “surface” with “the effect mounting surface.” See Pet. 55 n.8 (“the ’023 Patent provides no support for the frame in Claim 15 being supported *above* the **effect mounting surface** in Claim 18” (bold emphasis added)), 69 n.10 (referring to footnote 8).

For these reasons, we did not misapprehend or overlook Petitioner’s arguments related to the “above the surface” limitations of claims 5 and 18.

B. Petitioner’s Unpatentability Contentions for Claims 7, 8, 20, and 21

In our Final Written Decision, we determined that Petitioner had not shown by a preponderance of the evidence that (1) the subject matter of claims 7 and 20 would have been obvious over the combination of U.S. Patent No. Des. 339,612 (Ex. 1014, “Carter”) and Saravis; and (2) the subject matter of claims 8 and 21 would have been obvious over the combination of Carter, Saravis, and Arseneault. Final Dec. 68–77. In particular, we found that Petitioner had not established that the prior art teaches the limitation “rigidly connecting the end members and cross members.” *Id.* at 76.

Petitioner argues that we misconstrued the “rigidly connecting” limitation and failed to apply its plain and ordinary meaning under the broadest reasonable interpretation standard. Req. Reh’g 9–11. Petitioner

cites portions of the hearing transcript and a footnote in the Final Written Decision as evidence that we “operated under . . . [a] misapprehension” that “rigidly connecting” requires “a direct mechanical connection of cross members to end members.” *Id.* at 9–10 (citing Paper 48, 16:21–24, 20:22–24; Final Dec. 72 n.14²). Correspondingly, Petitioner contends we set aside “the proper construction,” which is “one in which a direct mechanical connection of end members and cross members is not required.” *Id.* at 10. Petitioner contends the language of the claims does not state that “the connection must be a direct mechanical connection—i.e., a weld, fastener, rivet, etc. directly between the end members and cross members—or that any specific type of connection must be used to practice the claimed method.” *Id.* at 11. Petitioner further argues that the “rigidly connecting” language is not limited to the examples disclosed in the specification of the ’023 patent, namely, welding, screws, and bolts. *Id.* at 11–12 (citing Ex. 1001, 4:22–25).

We do not agree with Petitioner’s arguments. In the Petition, Petitioner stated “[t]he end and cross members of Carter are rigidly connected or joined, as Carter illustrates them being held together using screws or rivets.” Pet. 74 (citing Ex. 1014, Fig. 5; Ex. 1015 ¶ 86). We fairly interpreted this to mean that Petitioner relied on a direct connection of end members and cross members by screws or rivets. Petitioner never argued or explained that its analysis for the “rigidly connecting” limitation was based on an indirect connection of end members and cross members. The panel engaged Petitioner’s counsel about this at the oral hearing (*see, e.g.,*

² Petitioner mistakenly refers to the footnote number as 8, but the quotation makes clear that Petitioner intended to cite footnote 14.

Paper 48, 16:2–22:20), at which time Petitioner explained its interpretation with particularity for the first time. But Petitioner’s explanation was untimely, as we indicated in footnote 14 of the Final Written Decision. *See* Final Dec. 72 n.14.

Petitioner further argues that, “[f]rom the outset,” it has contended that “a person of ordinary skill in the art would find no movement possible between the end members and cross members disclosed in Carter because they are rigidly connected or joined.” Req. Reh’g 12 (citing Pet. 74). Petitioner contends we overlooked evidence supporting this contention, including a mention that “the end and cross members [of Carter] are rigidly connected, held together using screws, rivets, or some similar fastener” and a citation to Carter’s Figures 1 and 4. *Id.* at 12 (citing Pet. 34). Petitioner additionally cites its references in the Reply to Mr. Stratton’s Supplemental Declaration. Req. Reh’g 14–15 (citing Paper 34, 23; Ex. 1051 ¶¶ 22–23). Petitioner contends that Mr. Stratton found that Carter’s cross members and the end members are rigidly connected and do not pivot “based on mechanical fasteners in Carter.” *Id.* (citing Paper 34, 23; Ex. 1051 ¶¶ 22–23).

We do not agree with Petitioner’s arguments. In our Final Written Decision, we considered Petitioner’s assertions that Carter’s cross members and the end members are rigidly connected or joined based on mechanical fasteners depicted for other connections in Carter. *See* Final Dec. 70, 72. We also considered Petitioner’s own annotated versions of Figures 1 and 4 (*see id.* at 69 (reproducing Petitioner’s annotated drawings)) and Mr. Stratton’s testimony from his Supplemental Declaration. *See id.* at 72 (citing Ex. 1051 ¶¶ 20–23, 26), 74–75 (citing and discussing same). Thus,

contrary to Petitioner’s arguments, we did not overlook Petitioner’s evidence in reaching our conclusion that Petitioner did “not persuasively show a rigid connection between the end members and cross members of Carter.” *Id.* at 75. Importantly, as discussed in the Final Written Decision (*id.* at 74–75), Petitioner’s evidence focuses on an alleged rigid connection between Carter’s foot pedals and cross members, not the recited “end members and cross members.” See Ex. 1015 ¶ 86 (Mr. Stratton testifying that “*the foot pedals* appear to be secured to the support board of Carter using rivets, screws, or some similar type of fastener”) (emphasis added); Ex. 1051 ¶ 23 (Mr. Stratton testifying that “Figure 5 of Carter shows screw and nut fasteners holding *the foot pedal* down to the cross members”) (emphasis added). Thus we did not overlook or misapprehend Petitioner’s posited evidence.³

At the oral hearing and in the Request for Rehearing, Petitioner has attempted to extrapolate this evidence into further alleged rigid connections in Carter’s foot pedal controller. Specifically, at oral argument, Petitioner referenced a “center linkage” in Carter and argued that the cross members and end members are “rigidly connected together based off of the center member which joins them together.” Paper 48, 20:10–21:2. Likewise, Petitioner argues in the Request for Rehearing that we “misapprehended the

³ We also considered Petitioner’s argument from its Reply that an ordinarily skilled artisan “could have easily made a rigid connection between the cross members and end-members using the same fasteners that are disclosed in Carter.” Final Dec. 72 (citing Paper 34, 24; Ex. 1051 ¶ 26). We were not persuaded by this rationale because Petitioner did not provide a reason why an ordinarily skilled artisan would have made such a connection. See *id.* at 75. Petitioner does not contest this determination in its Request for Rehearing.

effect of the ‘Screw/Nut’ connections between the foot pedals and the cross members in Figure 5 of Carter.” Req. Reh’g 14. According to Petitioner, “Mr. Stratton’s statement that the foot pedals and cross members are arranged ‘without an ability to pivot’ is compelling evidence to support the finding that the cross members do not move at all (i.e., there is a rigid connection with respect to the end members).” *Id.* at 14–15 (quoting Ex. 1051 ¶ 23). Petitioner also cites slide 34 of its hearing demonstratives and contends it includes an “explicit identification of the fasteners in Figure 1 of Carter using red circles [that] is wholly consistent with the evidence set forth and cited in the Petition.” *Id.* at 13 (citing Ex. 1052, 34).

In the Final Written Decision, we considered testimony from Mr. Stratton’s Supplemental Declaration and found it unpersuasive. In particular, we considered Mr. Stratton’s testimony that an ordinarily skilled artisan “would have understood from a review of Carter, alone, that the cross members and end members of Carter . . . are rigidly connected . . . based on the numerous fasteners shown in Figures 1-7 of Carter and the manner in which many of the members in Carter are interconnected with mechanical interferences between them.” *See* Final Dec. 74 (quoting Ex. 1051 ¶ 22). We did not credit this testimony, however, because Mr. Stratton’s explanation does not support his premise. *See id.* at 74–75. In particular, Mr. Stratton cited a rigid connection between the foot pedals and the cross members (*see* Ex. 1051 ¶ 23), but this does not substantiate other rigid connections, such as a rigid connection between the end members and cross members of Carter. *See* Final Dec. 74–75. For example, even though the foot pedals are rigidly connected to the cross members, the cross members may still pivot with respect to the end members. The same reasoning applies

to Petitioner's mention in the Request for Rehearing of Mr. Stratton's testimony about a non-pivoting foot pedal connection (Req. Reh'g 14–15 (quoting Ex. 1051 ¶ 23)), which is just another way of describing a rigid connection between the foot pedal and the cross member.

We also determined that certain arguments presented at the oral hearing had not been presented previously in Petitioner's papers. Final Dec. 72 n.14. The oral hearing is limited to "argument on an issue raised in a paper" and is not a vehicle for introducing new argument or evidence to the proceeding. 37 C.F.R. § 42.70(a); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) ("No new evidence or arguments may be presented at the oral argument."). As such, Petitioner's oral argument and hearing demonstratives were not acceptable vehicles for explaining Petitioner's arguments in the first instance. And, to the extent Petitioner argues that these new arguments were somehow consistent with its Petition (*see* Req. Reh'g 13), Petitioner never identified these arguments with particularity in its Petition, as it was required to do. *See* 35 U.S.C. § 312(a)(3) (requiring Petitioner to "identif[y], in writing and with particularity, . . . the grounds on which the challenge to each claim is based" in the Petition); *see also* Paper 48, 20:10–21:11 (Petitioner's counsel referring to a version of an annotated diagram in demonstrative slide 34 (Ex. 1052, 34) that did not appear in previous papers).

For these reasons, we did not misapprehend or overlook Petitioner's arguments related to the "rigidly connecting" limitations of claims 7, 8, 20, and 21.

III. CONCLUSION

For the reasons above, we conclude that Petitioner has not met its burden of showing that we misapprehended or overlooked any of Petitioner's arguments in making our determination that claims 5, 7, 8, 18, 20, and 21 are not unpatentable.

IV. ORDER

Accordingly, it is

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

In summary:

Outcome of Decision on Rehearing:

Claims	35 U.S.C §	Basis	Denied	Granted
18	103(a)	SCC-700, Arseneault	18	
5	103(a)	SCC-700, Arseneault, Saravis	5	
7, 20	103(a)	Carter, Saravis	7, 20	
8, 21	103(a)	Carter, Saravis, Arseneault	8, 21	
Overall Outcome			5, 7, 8, 18, 20, 21	

Final Outcome of Final Written Decision after Rehearing:

Claims	35 U.S.C. §	Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
14, 15	102(b)	SCC-700	14, 15	
1, 18, 19	103(a)	SCC-700, Arseneault	1, 19	18
2, 16, 17	103(a)	SCC-700, Saravis	2, 16, 17	
3–6	103(a)	SCC-700, Arseneault, Saravis	3, 4, 6	5
7, 20	103(a)	Carter, Saravis		7, 20
8, 21	103(a)	Carter, Saravis, Arseneault		8, 21
Overall Outcome			1–4, 6, 14–17, 19	5, 7, 8, 18, 20, 21

IPR2018-00707
Patent 6,459,023 C1

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