

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DITEC SOLUTIONS, LLC,
Petitioner,

v.

WOBLLEWORKS, INC.,
Patent Owner.

Case IPR2018-01414
Patent 9,731,444 B2

Before GEORGIANNA W. BRADEN, KRISTINA M. KALAN and
SHELDON M. McGEE, *Administrative Patent Judges*.

McGEE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Ditech Solutions, LLC (“Petitioner”) filed a Request for Rehearing (Paper 13, “Request” or “Req.”) of our Decision Denying Institution of *Inter Partes* Review (Paper 12, “Decision” or “Dec.”) of U.S. Patent No. 9,731,444 B2 (Ex. 1001, “the ’444 patent”). For the reasons that follow, Patent Owner’s Request for Rehearing is denied.

II. THE REQUEST FOR REHEARING

In pertinent part, 37 C.F.R. § 42.71(d) states:

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.

Thus, a request for rehearing is not an opportunity merely to disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence.

Petitioner requests rehearing to address its allegation that the Decision misapprehends or overlooks the proper construction of the term “three-dimensional (3D) drawing device.” Req. 2–7. We have reviewed Petitioner’s Request and carefully considered the arguments presented. For the following reasons, we are not persuaded that the Board misapprehended or overlooked any matter that requires granting of Petitioner’s Request.

III. DISCUSSION

Petitioner asserts that, in our Decision, we applied the wrong claim construction to the “three-dimensional (3D) drawing device” limitation recited in the preamble of independent claims 1 and 13 of the ’444 patent.

Req. 2–7. Namely, Petitioner avers that our construction of this limitation to mean “a device that will ‘immediately produce a freestanding 3D drawing or structure in a single, vertical stroke’” was erroneous because it “was both rejected by the Examiner and abandoned during prosecution of the continuation application.” Dec. 5–11; Req. 2–6. We disagree.

Petitioner’s argument first presumes that the claim construction adopted in our Decision was solely based on the prosecution history of the ’444 patent. See Req. 2 (noting how our “construction is premised upon arguments made by Patent Owner during the prosecution of the ’444 patent”); see also *id.* at 3–5 (asserting the Examiner rejected Patent Owner’s construction by making certain statements in the Notice of Allowance and that Patent Owner abandoned this construction in a subsequently filed continuation application). Our Decision makes clear, however, that it was not. Dec. 5–11, 14–15. In the Decision, the prosecution history of the ’444 patent was just one of the three tools we used to construe the “three-dimensional (3D) drawing device” limitation. We also used the body of the claim (*id.* at 8) and the ’444 patent Specification (*id.* at 8–9) to determine that the disputed limitation – recited in the preamble – is limiting and to determine its broadest reasonable construction considering the totality of the intrinsic evidence before us. *Id.* Indeed, our Decision indicates “[t]he construction that Patent Owner argued for during prosecution is *consistent with the use of this phrase throughout the Specification.*” *Id.* at 10 (emphasis added); see also *id.* at 11 (noting how our construction is “consistent with Patent Owner’s proposed construction during prosecution, *which is supported by the Specification.*” (emphasis added)). By solely focusing on our partial reliance on the ’444 patent’s prosecution history,

Petitioner fails to address the totality of the record (e.g., the Specification) that informed our ultimate construction of the disputed limitation. Such incomplete arguments do not persuasively show that we misapprehended or overlooked any evidence in arriving at our claim construction.

Next, we observe that Petitioner’s whole line of argument in its Request appears to be rooted in its dissatisfaction with our denial of an opportunity to present these claim construction arguments in a Reply to the Patent Owner’s Preliminary Response. Paper 11 (“Conduct of the Proceeding Order,” or “Order”). As our Order made clear (*id.* at 3–5), Petitioner failed to show good cause to present these claim construction arguments in a Reply because it was, or should have been, aware of the relevant events in the prosecution histories of the ’444 patent and the continuation application 15/638,266 (“the ’266 application”) at the time the Petition was filed.¹ Instead of presenting the totality of its claim construction arguments in its Petition, however, Petitioner elected to assert that “because the hand welding extruder disclosed by Di Miceli can deposit lines of thermoplastic from the nozzle of its handheld device, its structure is capable of functioning as a 3D drawing device.” Pet. 18–19. Patent Owner, however, argued for a narrower construction of the term “three-dimensional (3D) drawing device” in its Preliminary Response – a construction that was identical to the construction argued for during prosecution of the ’444 patent. Prelim. Resp. 16–21; Ex. 1002, 317–322. Namely, Patent Owner argued the limitation excluded devices that merely deposit lines of material

¹ Exhibits 1002 and 1022, the file histories of the ’444 patent and ’266 application, respectively, are Petitioner’s own Exhibits. Ex. 1023 ¶¶ 2–3 (Declaration of Attorney Lance Wyatt).

in layers over time. Prelim. Resp. 19, 20; Ex. 1002, 320. Our Decision found this construction to be consistent with the '444 patent Specification. Dec. 10 (citing Ex. 1001, [57], 1:51–63; 2:1–10; 3:63–4:1, and 8:13–19). Because the prosecution histories of the '444 patent and the '266 application were available to Petitioner at the time the Petition was filed, we discern no merit in Petitioner's argument that it "had no reason to expect Patent Owner[] would offer" this construction in its Preliminary Response. Req. 5.

Thus, Petitioner's Request raises new arguments that could have been raised in its Petition. Specifically, the prosecution histories of both the '444 patent and the '266 application provided ample notice to Petitioner of Patent Owner's previous claim construction positions. Petitioner could have presented a countervailing claim construction argument in its Petition, but instead raises new arguments here in its Request. These new arguments fail the standard set forth in Rule 42.71(d) at the outset because the Board cannot overlook or misapprehend an argument that was not before it. Nevertheless, we determine that even if these arguments were timely made in the Petition or in a Board-authorized Reply, they do not persuade us that the claim construction for the phrase "three-dimensional (3D) drawing device" as set forth in our Decision was erroneous. Dec. 11.

As set forth *supra*, our claim construction of the phrase "three-dimensional (3D) drawing device" was not based solely on the '444 patent's prosecution history. Dec. 5–11, 14–15. Even if it was, we do not agree that Petitioner's arguments (Req. 3–5) regarding the prosecution history compel a different construction. In its Request, Petitioner contends that the Examiner rejected Patent Owner's construction in the '444 patent's Notice of Allowance by stating that Young's cake decorator extruder is "a three-

dimensional (3D) drawing device.” Req. 4 (citing Ex. 1002, 344).

Petitioner then asserts that Patent Owner abandoned this construction in a subsequently-filed continuation application after “[l]ikely acknowledging the Patent Office’s rejection of its proposed construction” of the disputed term. *Id.*

Petitioner is correct that the Examiner characterized Young’s “hand-held cake decorator extruder” as “a three-dimensional (3D) drawing device” in the ’444 patent’s Notice of Allowance. Req. 4; Ex. 1002, 344. When viewed in context, however, we do not share Petitioner’s view that the Examiner’s mere characterization of Young’s extruder as a three-dimensional (3D) drawing device, on its own, rises to the level of a “rejection” of Patent Owner’s arguments distinguishing 3D drawing devices from devices that deposit material in layers over time. Ex. 1002, 317–322.² In fact, the Examiner provides no discussion whatsoever regarding the “three-dimensional” aspect of Young’s device in the Notice of Allowance, but rather focuses on Young’s internal actuators, motor, and gear train. *Id.* at 344. Thus, the Examiner’s isolated statement that Young’s device is a three-dimensional (3D) drawing device, without more, is not enough to

² We disagree with Petitioner’s contention (Req. 5) that Patent Owner’s statements made during prosecution were not sufficiently “clear and unmistakable” to invoke the doctrine of prosecution disclaimer. *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1325–26 (Fed. Cir. 2003); see also *Spectrum Int’l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1378–79 (Fed. Cir. 1998) (explaining how “explicit statements made by a patent applicant during prosecution to distinguish a claimed invention over prior art may serve to narrow the scope of a claim” because “[b]y distinguishing the claimed invention over the prior art, an applicant is indicating what the claims do not cover.”).

persuade us that the Examiner was unequivocally rejecting Patent Owner's construction of "a three-dimensional (3D) drawing device."

Moreover, Petitioner's argument that Patent Owner "[l]ikely acknowledg[ed] the Patent Office's rejection of its proposed construction . . . [and subsequently] abandoned this construction" is, at best, speculative. Req. 4. To the extent that Patent Owner would have even understood the Examiner's lone statement in the Notice of Allowance regarding Young as a "rejection of its proposed construction" (Req. 4), Petitioner has not provided sufficient evidence that Patent Owner actually abandoned its construction during the prosecution of the '266 application. For support, Petitioner avers that "Patent Owner did not even challenge the Examiner's determination that Di Miceli discloses a three-dimensional (3D) drawing device" after Di Miceli was relied on in a rejection,³ and thus "abandoned its prior construction." Req. 4–5; Ex. 1022, 171–185. This allegation, without more, is insufficient to establish that Patent Owner abandoned its construction of the disputed limitation. Here, Petitioner does not address the full relevant prosecution history of the '266 application, namely, the Examiner interview conducted April 3, 2018 where "potential paths forward" were discussed. Ex. 1022, 188. Based on the Examiner interview, Patent Owner submitted claim amendments to portions of independent claims 1 and 13 not concerning the preamble containing the disputed limitation. Ex. 1022, 190, 192. Significantly, in its Response, Patent Owner indicated that it "respectfully *disagrees* with" the rejections based on Di Miceli, that it offers claim amendments "*solely* to expedite

³ Non-Final Official Action dated January 10, 2018.

prosecution,” and that it makes the claim amendments “[w]ithout conceding the correctness of the rejection” of independent claims 1 and 13. *Id.* at 196, 198 (emphases added). After the claim amendments were entered by the Examiner, a Notice of Allowance in the ’266 application was issued approximately one month later.⁴ Thus, it appears that, based on the April 3, 2018 Examiner interview, the May 10, 2018 claim amendments, and quick allowance thereafter, there was no apparent need for Patent Owner to address the Examiner’s finding regarding Di Miceli’s alleged disclosure of a three-dimensional (3D) drawing device beyond noting that it did not agree with or concede the correctness of the Examiner’s rejection. Ex. 1022, 171–185.

Under these circumstances, Petitioner fails to persuade us that Patent Owner, in the ’266 application, abandoned the construction relied upon during prosecution of the ’444 patent. As such, we cannot agree with Petitioner that it “had no reason to expect Patent Owner[] would offer” the same construction for the preamble in its Preliminary Response as argued for during prosecution of the ’444 patent. Petitioner’s assertion that the Examiner rejected Patent Owner’s construction, resulting in Patent Owner’s abandonment of it, is devoid of evidentiary support, particularly because Patent Owner neither agreed with nor conceded the correctness of the rejections in the ’266 application based on Di Miceli. Ex. 1022, 196, 198.

⁴ The Notice of Allowance for the ’266 application was not included in the file history provided by Petitioner. *See generally* Ex. 1022. Rather, the file history appears to have been obtained on May 21, 2018 – approximately one month before the mail date of the Notice of Allowance (i.e., June 15, 2018). Ex. 1023 ¶ 2.

For these reasons, we are not persuaded that we misapprehended or overlooked any matters in rendering our Decision. Furthermore, even if Petitioner would have advanced these claim construction arguments in the Petition or a Board-authorized Reply to the Patent Owner Preliminary Response, they would have been unpersuasive for the aforementioned reasons.

IV. CONCLUSION

We have reviewed and considered the arguments in Petitioner's Request and conclude that Petitioner has not carried its burden of demonstrating that the Board misapprehended or overlooked any matters in rendering the Decision Denying Institution of *Inter Partes* Review. 37 C.F.R. § 42.71(d).

The Request is *denied*.

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FOR PETITIONER:

P. Weston Musselman, Jr.
musselman@fr.com

Lance E. Wyatt, Jr.
wyatt@fr.com

FOR PATENT OWNER:

Christopher Bright
christopher.bright@morganlewis.com

Nathan Smith
nathan.smith@morganlewis.com

Hersh H. Mehta
hersh.mehta@morganlewis.com