

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EVERSTAR MERCHANDISE CO., LTD.,
Petitioner,

v.

WILLIS ELECTRIC CO., LTD.,
Patent Owner.

IPR2019-01484
Patent 9,671,097 B2

Before DEBRA K. STEPHENS, STACEY G. WHITE, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

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

I. INTRODUCTION

Everstar Merchandise Co., Ltd. (“Petitioner”) filed a petition for *inter partes* review (Paper 1 (“Pet.”)) challenging claims 1–30 (the “challenged claims”) of US Patent 9,671,097 B2 (Ex. 1001 (“the ’097 Patent”)). Willis Electric Co., Ltd. (“Patent Owner”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). On February 20, 2020, we issued a Decision denying institution of *inter partes* review. Paper 7 (“Decision” or “Dec.”).

Petitioner filed a Request for Rehearing of our Decision. Paper 8 (“Rehearing Request” or “Req. Reh’g”).

On June 30, 2020, we issued a Decision Denying Petitioner’s Request for Rehearing. Paper 9 (“Rehearing Denial”). Subsequently, Petitioner contacted the Board by email seeking authorization to file a renewed request for rehearing of our Rehearing Denial, specifically seeking clarification for a single narrow issue on page 6 of the Rehearing Denial relating to our discussion of Figure 5 of the ’097 patent. Ex. 3002. After considering Petitioner’s email, we recognized that clarification of our discussion of Figure 5 on page 6 of our Rehearing Denial is not necessary, as it would not change the outcome of our Rehearing Denial. Specifically, we note that our discussion of Figure 5 on page 6 of the Rehearing Denial relates to a *new argument, improperly raised* for the first time in Petitioner’s Rehearing Request. See Rehearing Denial 3. Accordingly, it was not the basis for our decision to deny Petitioner’s Rehearing Request. Nevertheless, we issue this Corrected Decision Denying Petitioner’s Rehearing Request to clarify our discussion of Figure 5 on page 6 and to address Petitioner’s assertion that our Rehearing Denial “overlooks or misapprehends critical portions of the

'097 Patent, and further reconsideration and clarification of the record is necessary.” Ex. 3002.¹

For the reasons that follow, Petitioner’s Rehearing Request is *denied*.

II. STANDARD OF REVIEW

The party challenging a decision in a request for rehearing bears the burden of showing the decision should be modified. 37 C.F.R. § 42.71(d) (2019). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” 37 C.F.R. § 42.71(d). When rehearing a decision on a petition, the decision will be reviewed for an abuse of discretion. 37 C.F.R. § 42.71(c).

III. DISCUSSION

Petitioner contends that we “overlooked critical portions of the ’097 Patent and its prosecution history, thereby adopting the Patent Owner’s narrow claim construction, and improperly resolved factual disputes in favor of the Patent Owner.” Req. Reh’g 1.

1. Construction of “disposed at a central portion”

Independent claims 1 and 9 recite a wire having a plurality of conductor strands and require that “one or more of the plurality of conductor strands is disposed at a central portion of the wire.” In our Decision, we construed this phrase to require one or more of the plurality of conductor strands to be positioned in the wire so as to occupy at least the center of the

¹ Other than the addition of this paragraph, and changes made to the paragraph below bridging pages 6–7, which addresses Figure 5 in the context of written description support, this Corrected Decision is identical to our Rehearing Denial.

wire. Dec. 10–11. In its Rehearing Request, Petitioner argues we overlooked a contradiction between our construction and the '097 patent specification, claims, and prosecution history. Req. Reh'g 2–8. For the reasons set forth below, we disagree.

We first note that Petitioner presents new evidence for the first time in the Request for Rehearing. Pursuant to 37 C.F.R. § 42.104(b)(3), a petition must set forth how the challenged claims are to be construed. In this proceeding, the Petition contains one paragraph addressing claim construction. Pet. 7. In the paragraph, Petitioner states a claim should be “accorded its ‘ordinary and customary meaning . . . as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent’” and, in a single sentence within that paragraph, indicates that “no terms require a specific construction.” Pet. 7. Petitioner thus had the opportunity to present its claim construction arguments and supporting evidence in its Petition, and chose not to do so. By way of contrast, in the Request for Rehearing, Petitioner allocates seven pages to the construction of the term “disposed at a central portion.” Req. Reh'g. 2–8. Petitioner is attempting to use the Request for Rehearing as an opportunity to reply to our Decision and present new arguments and evidence on claim construction. A request for rehearing, however, is not an opportunity merely to disagree with the Board's assessment of the arguments or weighing of the evidence, or for Petitioner to present new arguments or evidence.

Nevertheless, we disagree with Petitioner's contention that our construction is inconsistent with the '097 patent specification. Req. Reh'g 4–5. Petitioner directs us to Figure 5 of the '097 patent, and provides an annotated version of Figure 5, which is reproduced below. Req. Reh'g 4.

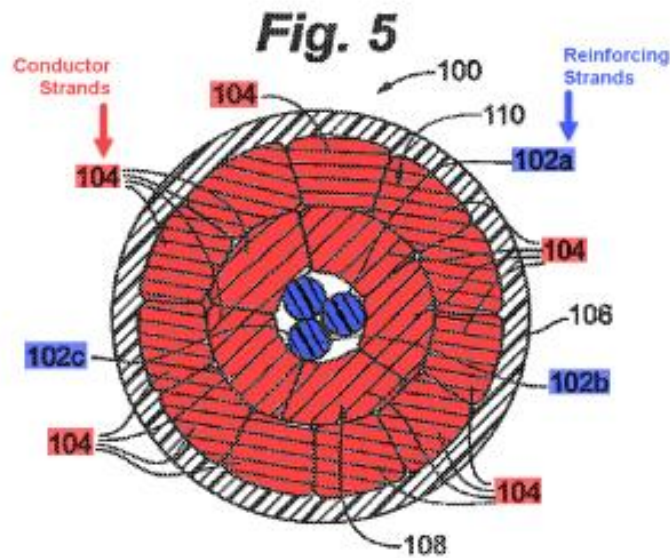


Figure 5 provides a cross-sectional view of wire 100 having three reinforcing strands 102a, 102b, and 102c, surrounded by conductor strands 104 forming conductor layers 108 and 110. Ex. 1001, 11:36–38, 14:52–62. Petitioner’s annotated Figure 5 highlights the conductor strands in red, and the reinforcing strands in blue. Req. Reh’g 4.

As Petitioner points out, the ’097 patent characterizes reinforcing strands 102a–c as “extend[ing] axially through the center portion of wire 10[0].” Ex. 1001, 14:59–60. Our construction of “disposed at a central portion,” which requires strands to be positioned in the wire so as to occupy at least the center of the wire, is consistent with both the description of strands 102a–c as extending through the center portion of the wire in the ’097 patent specification and the depiction of strands 102a–c in the center of wire 100 in Figure 5.

Petitioner appears to argue that because reinforcing strands 102a–c occupy a space that is larger than “simply the central axis of the wire,” any strands disposed inside the wire (*i.e.*, within the outer insulating layer of the

wire) are also “disposed at a central portion of the wire.” Req. Reh’g 5. Nothing in Figure 5 or the ’097 patent’s description of Figure 5, however, supports a construction of “disposed at a central portion” that means simply “disposed inside the wire.” To the contrary, Petitioner’s argument is undermined by the fact that the ’097 patent expressly refers to the reinforcing strands 102a–c as extending through the central portion, but does not use the same language to characterize the position of conducting strands 104.

Petitioner also argues that our construction is inconsistent with the ’097 patent claims because the claims recite “one or more” conductor strands disposed at a central portion of the wire, whereas our construction allegedly “eviscerates the ‘or more’ claim language.” Req. Reh’g 5–6. Additionally, Petitioner asserts that several claims “would lack adequate written description under the Board’s adopted construction, because the specification fails to provide any support for ‘more’ than one conductor ‘disposed at a central portion’ under the Board’s construction.” Req. Reh’g 6. Petitioner’s arguments are not persuasive because they ignore the fact that our construction explicitly refers to *one or more* of the plurality of conductor strands positioned in the wire so as to occupy at least the center of the wire. Dec. 10–11. Accordingly, our construction does not eviscerate the “or more” claim language.

Nor does our construction raise a “fatal Section 112 deficiency” for claims that require more than one conductor strand disposed at a central portion of the wire. Req. Reh’g 6. As discussed above, our construction is consistent with the wire depicted in Figure 5, which shows a configuration wherein one or more strands can be positioned in the wire so as to occupy at

least the center of the wire. This, in combination with Figure 6, which shows one or more conductor strands positioned in the wire so as to occupy at least the center of the wire, and the statement in the '097 patent that “[e]mbodiments of the invention are not intended to be limited to the specific patterns and structures depicted in FIGS. 3–6” provide written description support for claims requiring more than one conductor strand disposed at the central portion of the wire. Ex. 1001, 15:24–26.

We are also not persuaded by Petitioner’s argument that our construction is inconsistent with the prosecution history of the '097 patent. Req. Reh’g 7–8. Petitioner argues that in rejecting the claims in view of Johnson,² the Examiner considered wires 12 in Johnson to be conductor strands and found conductor strands 12 to be “disposed at a central portion of the wire” even though they do not occupy the central axis of the wire. Req. Reh’g 7–8 (citing Ex. 1002, 65). Petitioner’s argument, however, overlooks that the applicant understood the Examiner to consider both wires 12 and 12a of Johnson to be conductor strands. Ex. 1002, 49 (stating that “the Office Action cites elements 12 (and 12a) as disclosing conductor strands”). Petitioner does not direct us to any portion of Johnson that differentiates wires 12 and 12a based on their composition. Instead, Johnson appears to differentiate the wires based solely on their location in wire 10. *See, e.g.*, Ex. 2006, 5:22–27. As shown in Figure 1 of Johnson (reproduced on page 8 of the Rehearing Request), conductor strand 12a is disposed at the central portion of the wire. Ex. 2006, Fig. 1; Req. Reh’g 8.

² US 6,559,385 B1, issued May 6, 2003 (Ex. 2006).

For all of the foregoing reasons, we are not persuaded that our construction of “disposed at a central portion” contradicts the ’097 patent specification, claims, and prosecution history.

2. Construction of “plurality of reinforcing strands”

Petitioner contends that we overlooked that our adopted claim construction of “plurality of reinforcing strands” contradicts the ’097 patent specification. Req. Reh’g 10–12. In our Decision, however, we never expressly construed this term. Instead, we noted that the ’097 patent addresses the possibility that yarn, which itself comprises multiple strands, can be used to form a single reinforcing strand. Dec. 34–35. We did not, as Petitioner contends, determine that “twisted strands must only be one reinforcing strand.” Req. Reh’g 10–11. To the contrary, as Petitioner itself points out, we expressly noted that the ’097 patent distinguishes between embodiments having a single reinforcing strand and those having multiple reinforcing strands. Req. Reh’g 10; Dec. 35.

In view of this, we are not persuaded by Petitioner’s argument that we adopted a claim construction of “plurality of reinforcing strands” that contradicts the ’097 patent’s specification, which in turn “led to a clearly erroneous Institution Decision with respect to claims 16–22.” Req. Reh’g 12.

3. Alleged Failure to Resolve Factual Disputes in Favor of Petitioner

Petitioner contends that in our Decision, we “improperly resolved an important and contested issue of material fact regarding construction of the ’097 Patent’s claims.” Req. Reh’g 13. According to Petitioner, the record contains conflicting testimony from the parties’ declarants regarding how the claim terms should be construed. Req. Reh’g 13–14. Petitioner contends

that, pursuant to 37 C.F.R. § 42.108(c), we should resolve this dispute of material fact in favor of Petitioner, and, therefore, “resolve the claim construction issue regarding the disputed term ‘one or more of the plurality of conductor strands is disposed at a central portion of the wire’ in favor of Petitioner.” Req. Reh’g 15.

We are not persuaded by Petitioner’s argument that a genuine dispute of material fact exists with regard to the parties’ proposed construction of “disposed at a central portion.” Petitioner acknowledges that its declarant, Dr. Fantone, testified that none of the claim terms required a specific construction and that the claim terms “would be understood by one of ordinary skill in the art.” Req. Reh’g 13–14 (citing Ex. 1009 ¶ 22). As Petitioner points out, Dr. Brown, Patent Owner’s declarant, did not offer any “statement of disagreement with Petitioner’s position that the terms should be afforded their ordinary and customary meaning.” Req. Reh’g 14. As a result, there is no “conflicting” testimony from the declarants on this point.

Nor is there any conflicting testimony from the declarants regarding the ordinary and customary meaning of “disposed at a central portion.” Although Dr. Fantone testified generally that a person of ordinary skill in the art would understand what “disposed at a central portion” means, Dr. Fantone never explained what that understanding would be. Thus, there is no dispute of material fact on this record regarding the plain and ordinary meaning of the claim term.

Accordingly, we are not persuaded by Petitioner’s argument that we should “resolve the claim construction issue regarding the disputed term ‘one or more of the plurality of conductor strands is disposed at a central portion of the wire’ in favor of Petitioner.” Req. Reh’g 15.

IV. CONCLUSION

For all of the foregoing reasons, Petitioner has not demonstrated that we abused our discretion in not instituting *inter partes* review of claims 1–30 of the '097 patent.

V. ORDER

For the reasons given, it is:

ORDERED that Petitioner's Request for Rehearing is denied.

IPR2019-01484
Patent 9,671,097 B2

FOR PETITIONER:

Barry J. Herman
Preston H. Heard
WOMBLE BOND DICKINSON (US) LLP
barry.herman@wbd-us.com
preston.heard@wbd-us.com

FOR PATENT OWNER:

John P. Fonder
Doug J. Christensen
CHRISTENSEN, FONDER, DARDI & HERBERT, PLLC
fonder@cfpatlaw.com
christensen@cfpatlaw.com

Timothy E. Bianchi
SCHWEGMAN LUNDBERG & WOESSNER, P.A.
tbianchi@slwip.com