

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SATCO PRODUCTS, INC.,
Petitioner,

v.

SEOUL SEMICONDUCTOR CO., LTD.,
Patent Owner.

IPR2020-00151
Patent 9,978,919 B2

Before ERICA A. FRANKLIN, JEFFREY W. ABRAHAM, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

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

I. INTRODUCTION

Satco Products, Inc. (“Petitioner”), filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–7 of US Patent No. 9,978,919 B2 (Ex. 1001, “the ’919 patent”). Seoul Semiconductor Co., Ltd. (“Patent Owner”), filed a Preliminary Response to the Petition (Paper 6, “Prelim. Resp.”).

On May 5, 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 6 (“Rehearing Request” or “Req. Reh’g”). 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. BACKGROUND

Claim 1 of the ’919 patent requires a light emitting device comprising, *inter alia*, a first lead and a second lead, wherein the first and second leads each comprise a bottom lead and a top lead disposed on the bottom lead. Ex. 1001, 11:24–12:2. Claim 1 further requires a separation region between the first and second leads, “wherein a first portion of the separation region positioned between the first top lead and the second top lead has a different shape than a second portion of the separation region positioned between the

first bottom lead and the second bottom lead.” Ex. 1001, 11:24–12:7 (referred to herein as the “different shape” limitation).

In the Petition, Petitioner stated that all terms of the ’919 patent, including the aforementioned “different shape” limitation, “have been given their ordinary and customary meaning in the Petition,” and indicated that no specific constructions were required. Pet. 12. Petitioner asserted that Wang¹ discloses a separation region between first and second lead frames wherein the upper portion of the separation region between the lead frames has a different shape than the bottom portion of the separation region. Pet. 42–44. Patent Owner argued Petitioner had shown only that Wang teaches portions of the separation region having different sizes, not different shapes. Prelim. Resp. 28–40.

In our Decision, we determined that Petitioner failed to demonstrate adequately that Wang discloses the different shape limitation. Dec. 17–19. In particular, we noted that the images from Wang Petitioner relied upon offered insufficient information to determine whether the separation region between first and second top leads has a different shape than the separation region between the first and second bottom leads. Dec. 17–19. For example, we stated that Petitioner never presented views comparing the top and bottom portions of the separation region to demonstrate adequately that the top and bottom portions have different shapes. Dec. 19.

IV. DISCUSSION

Petitioner contends that we misapprehended the evidence regarding the “different shape” limitation in the Petition, that Patent Owner

¹ US 2013/0270588 A1, published Oct. 17, 2013 (Ex. 1004).

mischaracterized the evidence and Petitioner's arguments, and that we abused our discretion by relying on Patent Owner's mischaracterizations. Req. Reh'g. 6. Petitioner also contends that we abused our discretion by failing to apply the plain meaning of "different shape." Req. Reh'g 11–12.

1. Whether the Board Misapprehended Petitioner's Evidence Regarding the "Different Shape" Limitation

Petitioner contends that the evidence presented in the Petition, Figures 8, 9, and 11 of Wang, show bottom, side, and top views, respectively, of Wang's separation region. Req. Reh'g 6–7. According to Petitioner, "the Decision reveals that the Board viewed FIGS. 8-9 and 11 individually and in isolation, and overlooked Petitioner's arguments or Wang[]'s figures as a whole." Req. Reh'g 10. Petitioner further contends that "[r]ecognizing and comparing the shapes of the top and bottom portions requires considering FIGS. 8-9 and 11 together, rather than in isolation. Because the Board appeared to only rely on FIG. 8, it misapprehended/overlooked Petitioner's arguments as a whole." Req. Reh'g 11.

We disagree with Petitioner. To begin, we did not rely only on Figure 8 in our Decision. To the contrary, we considered and expressly discussed Petitioner's reliance on Figures 8, 9, and 11 in our Decision, and addressed the deficiencies in Petitioner's showing based on what those figures depict. Dec. 13–14, 17–19. In particular, we noted that none of the figures provided sufficient information about the shape of a top portion of the separation region and the shape of the corresponding bottom portion of the same separation region necessary to determine whether Wang discloses the "different shape" limitation. Dec. 17–19. We explained that Petitioner bears the burden of demonstrating that Wang discloses two separation region

portions having different shapes, and had not presented evidence sufficient to satisfy that burden, because, *inter alia*,

For the “different shape” limitation . . . Petitioner does not compare . . . top views with any bottom views of “the second portion of the separation region positioned between the first bottom lead and the second bottom lead” of Wang’s lead frame assemblies to demonstrate that the first and second portions have different shapes.

Dec. 19.

As such, we did not misapprehend or overlook the evidence in the Petition or rely only on Figure 8. Rather, after considering Petitioner’s citation to and cursory discussion of Figures 8, 9, and 11 in the Petition, we determined Petitioner’s evidence suffered from deficiencies that prevented Petitioner from satisfying its burden of proof in the Petition.

Notably, in its Rehearing Request, Petitioner does not direct us to any actual comparison of the shapes of top and bottom portions of Wang’s separation region that we overlooked in the Petition. Instead, Petitioner presents new images and new arguments that these images represent the shape of the top and bottom portions of Wang’s separation regions, as derived from Figures 8, 9, and 11. Req. Reh’g 8–11. A request for rehearing, however, is not an opportunity to present new arguments or evidence. *See* 37 C.F.R. § 42.71(d).

For all of the foregoing reasons, we are not persuaded that we misapprehended or overlooked Petitioner’s evidence regarding the “different shape” limitation.

2. Whether the Board Abused its Discretion by Failing to Apply the Plain Meaning of “Different Shape”

Petitioner acknowledges that, in the Petition, it did not request an explicit claim construction for the term “different shape.” Req. Reh’g 11. And although Petitioner argued that the claim terms were given their plain and ordinary meaning in the ’919 patent, Petitioner never specifically addressed the plain and ordinary meaning of “different shape” in the Petition. *See* Pet. 12. Nevertheless, in the Rehearing Request, Petitioner contends that “the plain meaning [of ‘different shape’] was not applied in the Decision.” Req. Reh’g 11. According to Petitioner, we “narrowed the meaning of ‘different shape’ in view of Patent Owner’s arguments” in the Preliminary Response, and, in doing so, committed two legal errors. Req. Reh’g 11–12.

First, Petitioner contends that we “erred by determining that the use of a stepped structure is insufficient to show different shapes because the [Admitted Prior Art] figures disclose stepped structures.” Req. Reh’g 12 (citing Dec. 18). We disagree. We did not determine that all stepped structures are insufficient to show different shapes. Instead, we explained that Petitioner failed to show that Wang Figure 9 discloses the “different shape” limitation because that figure offers insufficient information to determine whether the top and bottom portions of Wang’s separation region have different shapes. Dec. 18.

Second, Petitioner contends that “it was legal error to distinguish Wang[] by implicitly importing aspects of a preferred embodiment of the ’919 patent,” and that “a proper analysis must compare Wang[] to the claim language itself, without importing unclaimed features of an exemplary embodiment.” Req. Reh’g 14.

Contrary to Petitioner's assertion, however, we explicitly compared Wang's figures to the claim language itself in our Decision. In doing so, we determined that Wang's figures provided insufficient information to determine whether Wang discloses the "different shape" limitation. Dec. 17–19. Our discussion of the figures in the '919 patent merely highlighted the deficiencies in Petitioner's reliance on the figures in Wang by providing an example of information that could be used to determine whether the top and bottom portions of the separation regions have different shapes. At no point did we import any specific features from the Specification into the "different shape" limitation or "require shapes similar to the 'exemplary embodiment' of FIG. 5A of the '919 patent." Req. Reh'g 4. Rather, we merely compared the type of information presented in the '919 patent with the type of information presented in Wang to reinforce our determination that Petitioner failed to direct us to evidence in Wang that would allow a person of ordinary skill in the art to determine that Wang discloses a separation region that has a different shape between the top leads and the bottom leads.

In view of the foregoing, we are not persuaded that we committed any legal errors, or that we narrowed the plain meaning of "different shape."

V. CONCLUSION

For all of the foregoing reasons, Petitioner has not demonstrated that we abused our discretion in declining to institute *inter partes* review of claims 1–7 of the '919 patent.

VI. ORDER

For the reasons given, it is:

ORDERED that Petitioner's Request for Rehearing is denied.

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