Trials@uspto.gov
571-272-7822

Paper 27
Date: January 7, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUSKY INJECTION MOLDING SYSTEMS, LTD. and
HUSKY INJECTION MOLDING SYSTEMS, INC.,
Petitioner,

v.

PLASTIPAK PACKAGING, INC.,
Patent Owner.

IPR2020-00428 (Patent 8,857,637 B2)
IPR2020-00429 (Patent 9,033,168 B2)
IPR2020-00430 (Patent 9,139,326 B2)
IPR2020-00431 (Patent 9,403,310 B2)
IPR2020-00432 (Patent 9,522,759 B2)
IPR2020-00433 (Patent 9,850,019 B2)
IPR2020-00434 (Patent 9,738,409 B2)
IPR2020-00435 (Patent 10,023,345 B2)
IPR2020-00436 (Patent 10,266,299 B2)
IPR2020-00437 (Patent 10,214,311 B2)
IPR2020-00438 (Patent 10,214,312 B2)
IPR2020-00439 (Patent 10,457,437 B2)[1]

Before JOSIAH C. COCKS, MEREDITH C. PETRAVICK, and
ERIC C. JESCHKE, *Administrative Patent Judges.*

PETRAVICK, *Administrative Patent Judge.*

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[1] Petitioner filed identical Requests for Rehearing in each of IPR2020-00428 to IPR2020-00439. We, therefore, issue one Decision.

IPR2020-00428 (Patent 8,857,637) IPR2020-00429 (Patent 9,033,168)
IPR2020-00430 (Patent 9,139,326) IPR2020-00431 (Patent 9,403,310)
IPR2020-00432 (Patent 9,522,759) IPR2020-00433 (Patent 9,850,019)
IPR2020-00434 (Patent 9,738,409) IPR2020-00435 (Patent 10,023,345)
IPR2020-00436 (Patent 10,266,299) IPR2020-00437 (Patent 10,214,311)
IPR2020-00438 (Patent 10,214,312) IPR2020-00439 (Patent 10,457,437)

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

INTRODUCTION

Husky Injection Molding Systems, Ltd. and Husky Injection Molding Systems, Inc. (collectively "Petitioner") filed a Request for Rehearing (Paper 25[2], "Req. Reh'g") of the Institution Decision (Paper 24, "Inst. Dec."), which discretionarily denies institution under 35 U.S.C. § 325(d) because "the same or substantially the same prior art or arguments previously were presented to the Office." For the reasons discussed below, Petitioner's request for rehearing is *denied*.

STANDARD

A party requesting rehearing bears the burden of showing that a decision should be modified. 37 C.F.R. § 42.71(d). The party must identify all matters it believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* When rehearing a decision, we review the decision for an abuse of discretion. *See generally* 37 C.F.R. § 42.71 (b)–(d). An abuse of discretion occurs when a "decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of

[2] We cite to the paper numbers in IPR2020-00428.

judgment." *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted).

DISCUSSION

We have discretion to deny review when "the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d). In that respect, section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the Office. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential) ("*Advanced Bionics*").

In evaluating the parties' contentions concerning section 325(d), we applied the two-part framework set forth in *Advanced Bionics*. Inst. Dec. 8–20. The two-part framework is: (1) determining whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, determining whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics*, Paper 6 at 8. In applying the two-part framework, we considered several nonexclusive factors, including:

> (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was

> evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) ("*Becton, Dickinson*"). After review of factors (a), (b), and (d), we determined that the same or substantially the same art or arguments previously were presented to the Office, and addressed factors (c), (e), and (f) as to whether Petitioner demonstrated that the Office erred in a manner material to the patentability of the challenged claims. *See Advanced Bionics*, Paper 6 at 10.

According to Petitioner, "[s]everal errors led the Board to make an unreasonable judgement in weighing the *Becton, Dickinson*[] factors underlying *Advanced Bionics'*[*s*] framework and thus abuse its discretion." Req. Reh'g. 1. We have considered all of Petitioner's allegations of error, but are not persuaded that we abused our discretion by denying institution pursuant to section 325(d). The alleged errors amount to no more than mere disagreement with our weighing of the *Becton, Dickinson* factors in the *Advanced Bionics's* framework. Mere disagreement is not a proper basis for rehearing.

For example, Petitioner contends that we misapprehended *Becton, Dickinson* factor (c) (the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection). Req. Reh'g. 3–6. Petitioner argues that we should have weighed this factor in favor of institution because the Office never applied asserted art Colloud[3] to reject a claim. *See id.* Petitioner's argument merely disagrees with our determination that the examiner sufficiently evaluated Colloud to weigh this factor in favor of denial. Inst. Dec. 16–18. As pointed out in the Institution Decision, the prosecution history contains a European search report, which sets forth an explanation, in English, of why the claims would have been obvious over Colloud. Inst. Dec. 16–17 (citing Ex. 2011). The examiner annotated an Information Disclosure Statement, which lists Colloud and the European search report, indicating that both had been considered. Inst. Dec. 17. Based on this, we determined that the examiner sufficiently evaluated Colloud during examination. Mere disagreement with our determination of sufficient evaluation is not a proper basis for rehearing.

Petitioner additionally contends, "the Decision did not address all of the Petition's grounds, including one ground that relied on a base reference indisputably not considered previously." Req. Reh'g. 3. Petitioner argues:

> The Petition's last ground argued the claims would have been obvious over a reference—the US Standard—not before the examiner. Colloud was relied on only for its teachings of how/why to lower a container's neck, not its specific neck

[3] French Patent FR 2,846,946 B1, published Mar. 4. 2005 (Ex. 1005) ("Colloud").

> heights. The Decision overlooked this new art and argument in its analysis.

Id. at 15.

Contrary to Petitioner's assertion, we did not overlook the ground that included The US Standard. The Petition's ground 8 alleges that claims 1–34 are unpatentable over The US Standard and Colloud. Paper 1, 72–75. The Institution Decision indicates that ground 8 "combines The US Standard with Colloud and relies mainly upon Colloud's teachings" and states "[a]s do the parties, we focus our analysis on Colloud." Inst. Dec. 10 n.10. As the Institution Decision points out, the Petition incorporates much of its analysis from the other grounds based on Colloud into the analysis of ground 8. *See* Paper 1, 72–75 (relying on "the reasons set forth above in the sections of the petition discussing each respective claim"). For example, Petitioner presents ground 8 as a four-page claim chart that states, "COLLOUD teaches all the limitations of claim 1. Section 10.6." *Id.* at 72. Thus, Petitioner does not persuade us that we overlooked ground 8, which included The US Standard.

Further, we note that Petitioner argued that discretionary denial was unwarranted under § 325(d) in its Reply to Patent Owner's Preliminary Response. *See e.g.*, Paper 17, 1–6. These arguments focused on Colloud and did not mention The US Standard. *See id.* We could not have abused our discretion by overlooking an argument that discretionary denial was unwarranted based on the inclusion of The US Standard, when Petitioner did not make such an argument in its Reply.

CONCLUSION

For the foregoing reasons, Petitioner's Request for Rehearing is *denied*.

ORDER

Accordingly, it is:

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

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PETITIONER:
Matthew Cutler (lead counsel)
Richard Musgrave
Glenn Forbis
Neil Ferraro
mcutler@hdp.com
rmusgrave@husky.ca
gforbis@hdp.com
NFerraro-PTAB@WolfGreenfield.com

PATENT OWNER:
W. Karl Renner (lead counsel)
Whitney A. Reichel
David L. Holt
Roberto J. Devoto
PTABInbound@fr.com
axf-ptab@fr.com
wreichel@fr.com
holt2@fr.com
devoto@fr.com