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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOGEE LIGHTING HOLDINGS, LLC,
Petitioner,

v.

AUTRONIC PLASTICS, INC. D/B/A
CLEAR-VU LIGHTING,
Patent Owner.

Case IPR2020-01024
Patent 10,190,760 B2

Before KEVIN F. TURNER, JEFFREY S. SMITH, and
AARON W. MOORE, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing on Institution
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On December 15, 2020, Patent Owner filed a Request for Rehearing (Paper 13, "Req. Reh'g.") of our Decision Granting Institution of *Inter Partes* Review of U.S. Patent No. 10,190,760 ("the '760 patent")[1] entered December 1, 2020 (Paper 11, "Decision"). Petitioner requested authorization to file an Opposition to the Request for Rehearing in an email to the Board sent on December 17, 2020. Petitioner's request was granted in an email from the Board sent on December 21, 2020, and Petitioner filed the Opposition on December 30, 2020 (Paper 15, "Opp.").

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

The burdens and requirements of a request for rehearing are stated in 37 C.F.R. § 42.71(d):

> (d) Rehearing. . . . 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.

For the reason discussed below, Patent Owner's Request for Rehearing is DENIED.

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[1] The '760 patent is a continuation of U.S. Patent 9,909,748 ("the '748 patent"), which is the subject of IPR2020-01023.

II. ANALYSIS

A. *Consideration of Patent Owner's Construction*

Patent Owner contends that the Decision improperly construed the preambles of claims 1, 5, and 22, and that Petitioner cannot reasonably prevail under what Patent Owner contends is the correct construction. Req. Reh'g. 1; *see id.* at 8, 12. Patent Owner contends that the entire preamble in each of claims 1, 5, and 22 should be entitled to patentable weight, and that "high voltage power source" should be construed as "electrical power source from which train engines draw power." *Id.* at 2, 11. However, in our Decision, we determined that, even under Patent Owner's narrow reading of the claims, Petitioner has demonstrated a reasonable likelihood that the challenged claims would have been obvious in view of the prior art. Decision 22; *see id.* at 21–30. Patent Owner does not show that the Decision overlooked or misapprehended any pertinent matter in determining that even under Patent Owner's narrow construction, Petitioner has demonstrated a reasonable likelihood that the challenged claims would have been obvious over the prior art. We deny rehearing on this basis.

B. *Consideration of the Catalina and Bio-Rad Decisions*

Patent Owner contends that the Decision improperly applied the holding of *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801 (Fed. Cir. 2002), and instead should have applied the holding from *Bio-Rad Labs., Inc. v. 10X Genomics Inc.*, 967 F.3d 1353 (Fed. Cir. 2020), to the preambles of challenged claims 1, 5, and 22. Req. Reh'g. 2–5. According to Patent Owner, the preambles are limiting in their entirety, because they, like the claim in *Bio-Rad*, (a) recite a structural feature of the invention rather than an intended use, (b) cannot be separated into two separate portions, and (c) the portion of the preamble that provides antecedent basis

for the body is intertwined with the remainder of the preamble. *Id.* at 2. According to Patent Owner, not giving patentable weight to "for use in a public transportation facility" causes the claims to recite "[a]n LED light fixture having a high voltage power source." *Id.* at 4–5. The Decision could not have overlooked or misapprehended this argument because Patent Owner did not present this argument in the Preliminary Response. We deny rehearing on this basis.

Moreover, Patent Owner's argument is not persuasive because the preambles of claims 1, 5, and 22 are not like the preamble in the claim in *Bio-Rad.* Here, unlike *Bio-Rad*, the preamble recitation of "for use" in the preamble term "for use in a public transportation facility" expresses an intended use. *See* Opp. 8. Further, in *Bio-Rad*, the preamble recited a "method for conducting a reaction in plugs in a microfluidic system," where the terms "a reaction" and "a microfluidic system" were recited in the body of the claim, and were intertwined with other preamble terms such as "conducting." *Bio-Rad,* 967 F.3d at 1371. Here, the body of each independent claim does not recite "public transportation facility." *See* Opp. 7.

Further, the claim term "high voltage power source" is not intertwined with the claim term "for use in a public transportation facility," because the "high voltage power source" is structurally complete by itself. Here, as in *Catalina*, "deletion of the disputed phrase ["for use in a public transportation facility"] from the preamble of Claim 1 does not affect the structural definition or operation of the [claimed apparatus] itself." *Catalina,* 289 F.3d at 810; *accord* Opp. 8. In particular, the location or supply of the high voltage power source does not affect the structural definition or operation of the claimed "first power input adapted to be connected to the first standard

power source and the second power input adapted to be connected to the high voltage power source," nor any other limitation recited in the body of the claim of the LED light fixture itself.

Also here, as in *Catalina*, "the specification, in its entirety, does not make the location of the [high voltage power source] an additional structure for the claimed [high voltage power source]." *Id.*; *see* Decision at 9–11; *accord* Opp. 3–4. Patent Owner does not show that the Decision overlooked or misapprehended *Catalina* or *Bio-Rad*. We deny rehearing on this basis.

C. *Consideration of the Specification*

Patent Owner contends that our Decision overlooked or misapprehended that the Specification shows that Patent Owner properly construes "high voltage power source," by way of reference to "for use in a public transportation facility," as "electrical power source from which train engines draw power." *See* Req. Reh'g. 5–8 (citing *Poly-Am., L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303, 1310 (Fed. Cir. 2004)); *see id.* at 11–12. To support this contention, Patent Owner cites to portions of the Specification that were not cited in the Preliminary Response. *Id.* at 6–7. The Decision could not have overlooked or misapprehended this argument because Patent Owner did not present this argument in the Preliminary Response. We deny rehearing on this basis.

Here, unlike in *Poly Am*, neither the title, nor the abstract, nor the claims, use Patent Owner's proposed construction of "electrical power source from which train engines draw power." Further, the newly cited portions of the Specification do not mention Patent Owner's proposed construction of "electrical power source from which train engines draw power," except for the citation to Ex. 1002, 5:36–39. The next sentence, which was cited on page 11 of the Decision, states that the high voltage

"source 34 can be 450V-1000V direct current or commonly about 600 V." Ex. 1002, 5:39–40. Thus, the Specification describes the high voltage power source in terms of what the "source," not the third rail, "can be," which is the opposite of limiting the high voltage power source to the third rail located in a public transportation facility. *See id.* Further, Patent Owner acknowledges that "the specification includes some other examples of power sources that the LED fixture can be configured to accommodate." Req. Reh'g 10.

The Federal Circuit has held that "it is improper to read limitations from a preferred embodiment described in the specification – even if it is the only embodiment – into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited." *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1327 (Fed. Cir. 2012); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc) ("[C]laims may embrace different subject matter than is illustrated in the specific embodiments in the specification."). The Specification indicates that the patentee intended to include sources in addition to the third rail located in a public transportation facility from which train engines draw power as the high voltage power source. *See* Decision 11. Patent Owner does not show that we overlooked or misapprehended that the Specification indicates that the patentee intended the high voltage power source to include sources other than the third rail power source from which train engines draw power. We deny rehearing on this basis.

D. *Consideration of the Prosecution History*

Patent Owner contends that our Decision overlooks or misapprehends the contention that the Examiner treated the preambles as limiting during prosecution, because (a) the Examiner found that the preambles are admitted

prior art during prosecution of the parent '748 patent, and (b) the Examiner searched for prior art related to public transportation to the claims of the parent '748 patent. Req. Reh'g. 7–8. We could not have overlooked or misapprehended these contentions, because Patent Owner did not raise these contention in the Preliminary Response. We deny rehearing on this basis.

During prosecution of the parent '748 patent, the Examiner did not construe the entire preamble as limiting, but rather, simply stated that "the subject matter of the preamble is the prior art work of another." Ex. 1005, 87. Contrary to Patent Owner's contention, this statement does not indicate whether the Examiner gave patentable weight to the term "for use in a public transportation facility." However, the Examiner, in the reasons for allowance for both the '748 patent and the '760 patent, addressed the claimed power sources, but remained silent about the term "for use in a public transportation facility," which indicates that the Examiner did give patentable weight to the claimed power sources, but did not give patentable weight to the term "for use in a public transportation facility." *Id.* at 12; Ex. 1006, 12–13.

We are not persuaded by Patent Owner's contention that the Examiner's search for public transportation facility shows that the Examiner gave patentable weight to this term. The Manuel of Patent Examining Procedure (MPEP) states that the Examiner's search should cover subject matter that is described in the Specification, in addition to covering subject matter that is claimed. MPEP § 904.03 ("It is not normally enough that references should be selected to meet only the terms of the claims alone . . . but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment."). Patent Owner does not show that the Decision overlooked or

misapprehended any pertinent matter in determining that the Examiner did not give patentable weight to the term "for use in a public transportation facility." We deny rehearing on this basis.

E. *The Decision's Construction of "High Voltage Power Source"*

Patent Owner contends that the Decision read the limitation "high voltage power source" out of the claims entirely in construing "high voltage power source" as encompassing at least a power source having a voltage of 450 to 1000 Volts. Req. Reh'g. 9. Patent Owner contends that because the claims separately recite "a high voltage power source" and "a voltage of 450 to 1000 Volts," the source should not be construed as a voltage magnitude, but rather, as the third rail power source of a public transportation facility. *Id.* at 9–10 (citing *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1557 (Fed. Cir. 1995)).

Patent Owner's contentions are inconsistent with the claims and the Specification. The claims do not separately recite "a high voltage power source" and "a voltage of 450 to 1000 Volts." Rather, claim 1 recites "a high voltage power source having a voltage of 450 to 1000 Volts." The Specification discloses that the high voltage power "source 34 can be 450-1000V direct current." Ex. 1002, 5:39–40. In reciting "a high voltage power source having a voltage of 450 to 1000 Volts," claim 1 expressly limits the "high voltage power source" to the disclosed embodiment of a "source [that] can be 450-1000V direct current," and excludes other embodiments of power sources having a voltage outside of this range.

Further, the Specification discloses that the "source," not the third rail, "can be 450-1000V," without describing a specific structure that provides the voltage. Ex. 1002, 5:39–40. Contrary to Patent Owner's contention, the Specification itself describes the high voltage power source in terms of what

the voltage provided by the source "can be," not what the structure of the source can be. *Id.* Thus, the Decision's construction of this term is consistent with its usage in the context of the Specification. *See Phillips*, 415 F.3d at 1315 (Fed. Cir. 2005) ("The words of patent claims have the meaning and scope with which they are used in the specification and the prosecution history. The best indicator of claim meaning is its usage in context.") (internal citations omitted). Patent Owner does not show that we overlooked or misapprehended the meaning of the claimed "high voltage power source having a voltage of 450-1000 Volts" as used in context of the Specification. We deny rehearing on this basis.

Patent Owner contends that its proposed construction does not read a limitation from a preferred embodiment into the claims, because, according to Patent Owner, the claimed "a public transportation facility having a high voltage power source" refers to the third rail that powers trains. Req. Reh'g. 10. However, the claims do not recite "a public transportation facility having a high voltage power source." Rather, the claims recite "for use in a public transportation facility," which expresses an intended use. Patent Owner's contention removes the expression of intended use from the claims. Patent Owner does not show that we overlooked or misapprehended the meaning of "for use in a public transportation facility" as claimed. We deny rehearing on this basis.

Patent Owner contends that the Decision incorrectly applied different constructions of "high voltage power source" to the claims of the '760 patent and the '748 patent, even though both patents use the term "high voltage power source" in the same fashion. Req. Reh'g. 10–11. We are not persuaded by Patent Owner's contention. Claim 7 of the '748 patent recites "a high voltage power source" without reciting a voltage range. In contrast,

claim 1 of the '760 patent expressly recites "a high voltage power source having a voltage of 450 to 1000 Volts." *See* Opp. 12. Patent Owner does not show that we misapprehended or overlooked differences in the limitations recited in the claims of the '478 and '760 patents. We deny rehearing on this basis.

III. CONCLUSION

The Request for Rehearing does not demonstrate that any matter raised in the Preliminary Response was overlooked or misapprehended.

IV. ORDER

Patent Owner's Request for Rehearing is DENIED.

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