

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PEDDINGHAUS CORPORATION,
Petitioner,

v.

FICEP CORPORATION,
Patent Owner.

IPR2020-01707
Patent 7,974,719 B2

Before MELISSA A. HAAPALA, *Vice Chief Administrative Patent Judge*,
and JAMESON LEE and NORMAN H. BEAMER, *Administrative Patent Judges*.

Opinion for the Board filed by LEE, *Administrative Patent Judge*.

Opinion Dissenting filed by BEAMER, *Administrative Patent Judge*.

LEE, *Administrative Patent Judge*.

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

I. INTRODUCTION

On June 10, 2021, Petitioner filed a Request for Rehearing (Paper 16, “Reh’g Req.”) under 37 C.F.R. § 42.71(d) to seek modification of the Board’s Decision Denying Institution of *Inter Partes* Review (Paper 15, “Decision” or “Dec.”) of claims 1–14 of U.S. Patent No. 7,974,719 B2 (“the ’719 patent”). The Request is *denied*.

II. STANDARD OF REVIEW

When rehearing a decision on institution, we do not review the merits of the decision *de novo*, but instead review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). 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 judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The party requesting rehearing has the burden to show that the decision should be modified. 37 C.F.R. § 42.71(d). Additionally, the 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 in a motion, an opposition, or a reply.” *Id.*

III. ANALYSIS

Petitioner disputes our denial of institution for two reasons. First, Petitioner argues that we mistakenly relied on Hashimoto’s “order list” to conclude that Hashimoto failed to disclose the claim limitation of “identifying a plurality of *intersection* . . . parameters” (emphasis added). Reh’g Req. 2–3. Second, Petitioner asserts that we incorrectly concluded that Hashimoto’s “fastening holes” can be both “connecting” and “non-connecting” holes. *Id.* We disagree with both assertions.

A. *Hashimoto Fails to Disclose identifying intersection parameters*

Petitioner argues that:

As to the first error, the Majority stated that “Petitioner’s reliance on Hashimoto’s totaling module and order list is inadequate” to disclose the “*identifying*” limitation because “the information in the order list as shown in Figure 19 ... pertains to all holes including non-connecting holes.” Decision, 29. But the Petition did not point to Hashimoto’s order list as disclosing this limitation. Instead, as the Petition explained, the “*identifying*” step is completed in Hashimoto **before** the member totaling operations are finished and **before** any order list is prepared . . . The Petition references the order list depicted in Figure 19 as merely providing a summary of the information (the “total”) that was previously identified and extracted by the member totaling module.

Reh’g Req. 7–8. Although Petitioner avers that the “*identifying*” of *intersection* parameters, or connecting holes, is completed in Hashimoto by the member totaling module before any order list is prepared, the order list is pertinent evidence for that assertion and there is nothing inappropriate in discussing that evidence. We recognize no other evidence which was identified by the Petitioner in the Petition, and Petitioner points to no such other evidence that we overlooked. Indeed, Petitioner states: “The Petition references the order list depicted in Figure 19 as merely *providing a summary of the information (the ‘total’)* that was previously identified and extracted by the member totaling module.” *Id.* at 8 (emphasis added).

As we stated in our Decision, Petitioner points to no description or disclosure in Hashimoto that its member totaling module recognizes the difference between a connecting hole, or intersection parameter, from a non-connecting hole. Dec. 27. Hashimoto’s member totaling module “automatically totals, by cross section or length, the information including the shape, length, quantity, hole shape and the hole position (design drawing

information) of all the light gauge sheet steel used for the steel house existing in the CAD system” and “[b]ased on this total, an order list (steel member order list) is prepared (FIG. 19).” Ex. 1005 ¶ 101. Nowhere in this exhaustive list of hole information, however, is mentioned any data that identifies the difference between a connecting hole, or intersection parameter, and a non-connecting hole. Further, Petitioner’s statement on page 8 of the Rehearing Request that “hole shape” and “hole position” constitute intersection parameters is not persuasive because, from this information, it is unknown how the hole is intended to be used. Moreover, the order list of Figure 19 – which “merely shows the number of holes and the die numbers and positions of where those holes are formed”¹ – is the only indicated output of the member totaling module.

As we noted in our Decision, Petitioner itself notes that there are different types of ultimate usages for holes, some relating to connecting two component parts, which are for that reason intersect parameters, and some do not. Dec. 27 (citing Pet. 39–40). We discern no error in our determination that the member totaling module totals hole information, which is not specifically related to intersections, and thus does not identify any intersection parameter. Petitioner newly asserts that a skilled artisan would be able to deduce whether a hole is a connecting one based on die number, position and member type of each hole. Reh’g Req. 9 n.1. Even if so, that identification is not performed by the member totaling module of Hashimoto. Also, Petitioner does not point to where such an argument, with supporting evidence, was made in the Petition.

¹ Petitioner’s footnote 2 on page 10 is also unpersuasive because it engages in speculation of what a human operator would do, and also has no support in Hashimoto itself.

Petitioner further asserts that locating fastening holes in a CAD drawing, as Hashimoto does, requires searching for intersections between components and finding holes that connect them (just as a human operator would have done). *Id.* at 10 n.2. First, the argument was not set forth in the Petition. Second, the argument is not supported by any cited evidence. Third, the argument is speculative on how a human would perform a particular task, and in suggesting that a machine would perform the task in the same way. Fourth, the argument assumes that a “fastening hole” is necessarily a connecting hole, which we have determined not to be the case in the context of Hashimoto. Dec. 27 n.4.

Petitioner fails to show error in our determination that it “has not sufficiently shown that Hashimoto’s member totaling module identifies a plurality of intersection parameters which define in part the intersection of two components.”² See Dec. 29.

B. *“Fastening holes” include both connecting and non-connecting holes*
Petitioner asserts:

As the Dissent correctly points out, the “holes” described in Hashimoto’s first embodiment are only ever referred to as “fastening holes,” and non-connecting holes such as “wiring holes” are only described in the second embodiment...The Majority responded that “as noted by Petitioner (Pet. 40), Hashimoto itself discloses that ‘fastening holes include wiring holes formed in the stud.’...But the only support for that claim in the Petition—paragraph 156 of Hashimoto—is a description of Hashimoto’s second embodiment...The Majority itself held that the Petition’s reliance on both the first and second

² Petitioner’s arguments on pages 9–10 of the Rehearing Request that the *specification* of the ’719 patent is silent on “identifying” intersection parameters is of no moment because the only relevant inquiry is whether Petitioner shows sufficiently that Hashimoto discloses the *claimed* limitation.

embodiments was improper...Under that reasoning, the Petition's description of Hashimoto's second embodiment cannot be relied on to broaden the scope of the "fastening holes" described in the first embodiment in connection with Hashimoto's order list. Relying only on disclosures in Hashimoto's first embodiment, the "hole information" described in the order list relates solely to "connecting holes."

Reh'g Req. 10–11. Petitioner's arguments are unpersuasive.

There is no disclosure or evidence in Hashimoto that the definition or meaning of "fastening holes" changes from the first to second embodiment.³ For example, in the Background section of Hashimoto, "fastening holes" are defined generally as holes formed "in the light gauge shape steel for the fastening tools." Ex. 1005 ¶ 4. The same Background paragraph provides examples of "fastening tools *such as* a tapping screw and a one-side rivet." *Id.* (Emphasis added). Thus, this definition does not strictly limit fastening holes to connecting holes, since it does not foreclose the likely possibility of fastening tools including wires or wiring.

Moreover, a "machine for forming the fastening holes" is also disclosed in the Background, the same "non-stationary fastening hole forming machine 5" discussed in Figures 20-21 of the second embodiment. *Id.* ¶ 5. Thus, when "*fastening holes for passing the electrical wiring*" (emphasis added) are disclosed in the discussion of Figures 20-21 in Hashimoto's paragraph 154, there is no evidence suggesting that a different type of "fastening hole" other than what has been generally described in the Background is being mentioned. *Id.* ¶ 154. The same applies for the

³ The statement made in footnote 3 on pages 11–12 of the Rehearing Request that the only holes in Figure 18 are joints only establishes that the holes in Figure 18 may be connecting holes, not all "fastening holes" in Hashimoto.

disclosure that “fastening hole information includ[es]...[where] the wiring holes [are] formed in the stud” in paragraph 156 and how character c in Figure 23 “designates a hole for electrical wiring *or a fastening hole* for mounting the stud on the structural face plate” (emphasis added) in paragraph 157. *Id.* ¶¶ 156–157. Thus, it is a much more reasonable reading that in all embodiments of Hashimoto, the definition of “fastening holes” includes both connecting holes and non-connecting holes – such as those for wiring.

Accordingly, Petitioner does not persuade us that we overlooked or misapprehended any matter, or sufficiently show that not instituting an *inter partes* review of claims 1–14 of the ’719 patent was an abuse of discretion.

IV. ORDER

For the reasons given, it is:

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

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BEAMER, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority's denial of Petitioner's
Request for Rehearing.

As a threshold matter, I adhere to my claim construction conclusions set forth in previous dissent, to the effect that "identifying" intersection parameters refers to the process of locating information about intersections, such as the positions and shapes of the holes for the bolts that fasten structural components together. Dissent 12, 16. As stated in the dissent, there is no support for the majority's narrow construction, that would construe "identifying" as requiring "a distinct recognition of that specific information is required in the sense that mere locating a broad class of information does

not locate a specific subclass of that information,” and that “the locating must be sufficient to specifically distinguish that which is located from the rest of the information.” *Id.* at 11 (quoting Dec. 14). Specifically, in comparing the claims to Hashimoto, the “identifying” step of claim 1 does not require some sort of specific differentiation between “wiring hole” parameters and connection hole parameters, for example. *Id.* at 26–27.

However, in the Request for Rehearing, Petitioner does not challenge the majority’s interpretation of “identifying” in claim 1. Rather, Petitioner first argues that the Majority mistakenly relied on Hashimoto’s “order list” to conclude that Hashimoto fails to disclose identifying “intersection parameters,” whereas the actual identification occurs at a different, earlier stage of the process, at which point “the claimed ‘*identifying*’ step [is met] even under the Majority’s construction of that term.” Reh’g Req. 2.

I agree with the majority that this argument is unpersuasive (given the assumption that the majority’s construction of “identification” is correct). In circumstances where the Hashimoto system is processing a design that includes both bolt holes and wiring holes, there is no disclosure that the system identifies what a particular hole is used for, whether on an order list or during an earlier stage of the process.

Petitioner further argues that, for the first embodiment of Hashimoto, there are no wiring holes in the design — only connecting holes. Reh’g Req. 2. Therefore, “the order list in the first embodiment would identify *only* ‘connecting holes,’ even under the Board’s construction of the ‘*identifying*’ term.” *Id.* at 3. Petitioner is correct. The only type of holes disclosed in the first embodiment of Hashimoto are connecting holes — *i.e.*, holes to accommodate screws, bolts or rivets used to connect components together. Ex. 1006, Figs. 16, 19, ¶¶ 4, 30, 76, 78, 86, 99, 101. Therefore,

the order list of the first embodiment of Hashimoto unequivocally identifies the connection hole information, and thus identifies the intersection parameters as claimed. Ex. 1006, Fig. 19, ¶¶ 101, 138. The majority points out that, in the context of the second embodiment, wiring holes are referred to as fastening holes. *See* Ex. 1006, ¶¶ 154, 156, 157. But, as set forth in the previous dissent (Dissent 23–27), the first embodiment of Hashimoto, standing alone, anticipates claim 1, and therefore it is irrelevant that the second embodiment includes wiring holes.

Accordingly, I would grant Petitioner’s Request for Rehearing.

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FOR PETITIONER:

Scott M. Border
Jason P. Greenhut
Stephanie P. Koh
SIDLEY AUSTIN LLP
sborder@sidley.com
jgreenhut@sidley.com
skoh@sidley.com

FOR PATENT OWNER:

Matthew B. Lowrie
James C. De Vellis
FOLEY & LARDNER LLP
mlowrie@foley.com
jdevellis@foley.com