

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

US CONEC LTD.,
Petitioner

v.

SENKO ADVANCED COMPONENTS, INC.,
Patent Owner

Case IPR2024-00122
Patent 11,061,190

**PETITIONER'S REQUEST FOR
REHEARING OF THE INSTITUTION DECISION**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	STANDARD OF REVIEW	8
III.	THE DECISION MISAPPREHENDED THE PETITION AND DECLARATION’S USE OF A LONGITUDINAL AXIS BLACK DOTTED LINE SHOWING ORIENTATION OF THE NAKAGAWA FIGURE AS BEING THE PETITIONER’S TEACHING FOR THE CLAIMED BOOT PASSAGEWAY.....	9
A.	Claim Element 1.3.3.	9
B.	Patent Owner and the Decision Misapprehend what Nakagawa teaches as the boot passageway and thus what Petitioner argues teaches the inner round surface defining a proximal end portion of the boot passageway.	10
C.	PO incorrectly argues the Petition relies on an intermediate portion of the passageway as including the inner round surface.	13
IV.	CONCLUSION	15

I. INTRODUCTION

In response to the Decision Denying Institution of *Inter Partes* Review of U.S. Patent No. 11,061,190 (“the ’190 patent”), entered June 5, 2024 (Paper 7, hereinafter “Decision”), and pursuant to 37 C.F.R. § 42.71(c) and (d), Petitioner US Conec Ltd. (Conec) respectfully requests that the Patent Trial and Appeals Board (PTAB) reconsider institution. With regard to claim element 1.3.3, the Decision grounded its conclusion in an erroneous and inadvertent misreading of the annotated figures and Declaration, and thus the Petition. This error shaped the Decision’s analysis of the prior art. Had the Decision properly considered how the prior art was applied to claim element 1.3.3, the Decision would have concluded that the Petition showed a reasonable likelihood of demonstrating unpatentability of at least one claim.

The Decision focused on claim element 1.3.3 as being dispositive, which recites:

- the rotatable boot assembly comprising a boot passageway extending from the distal end portion through the main body,
- the main body comprising an inner round surface extending along the longitudinal axis,
- the inner round surface defining a proximal end portion of the boot passageway.

Addressing the representative **Nakagawa** Ground, the Decision (at 16, annotated below) lays out the factual dispute between the parties' experts, and thus between the parties and the Office, stating:

Relying on the testimony of Mr. Pearson, **Patent Owner** argues that the “inner round surface” of Nakagawa relied on by Petitioner “defines an **intermediate portion** of a boot passageway, that is distal of the proximal end portion of the boot passageway.” Prelim. Resp. 57 (citing Ex. 2007 ¶ 120). ... As shown in Figure 2, the **highlighted yellow surface** relied on by **Petitioner** is recessed and does not define “a proximal end portion of the boot passageway” as recited in limitation 1.3.3. **Dr. Brennan identifies the “boot passageway” as extending the entire length of Nakagawa’s boot 40.** Ex. 1016 ¶ 164 (**annotation of Nakagawa Figure 4B identifying boot passageway with dotted blue line**). Dr. Brennan does not, however, identify an inner round surface that defines a proximal end of the boot passageway.

The Decision appears to inadvertently misread the annotated figures and Declaration, and thus the Petition, based on the description and labeling of Figures 4B and 2.

The Decision relied upon annotated Figure 4B (reproduced below).

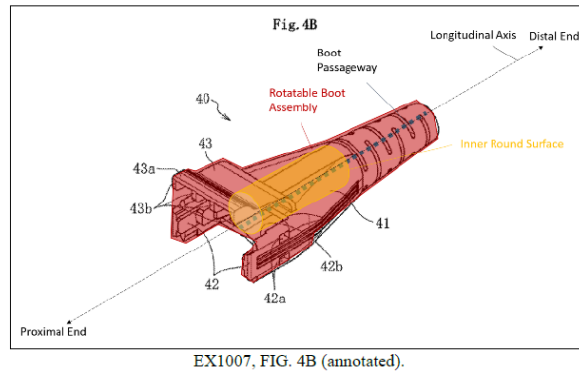
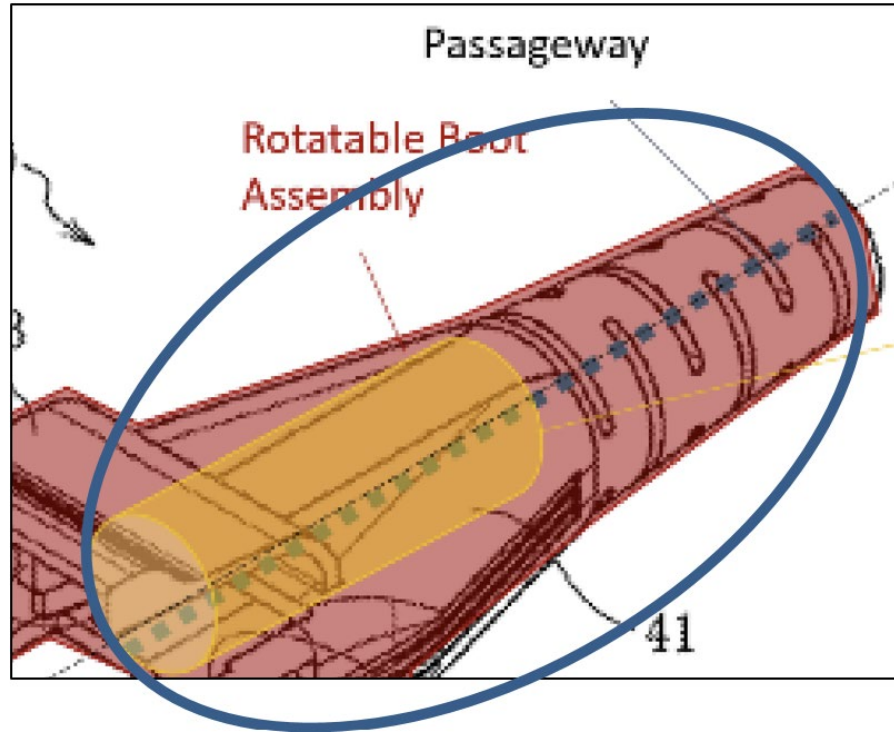


Figure 4B has at least three distinct labels that might be hard to see.

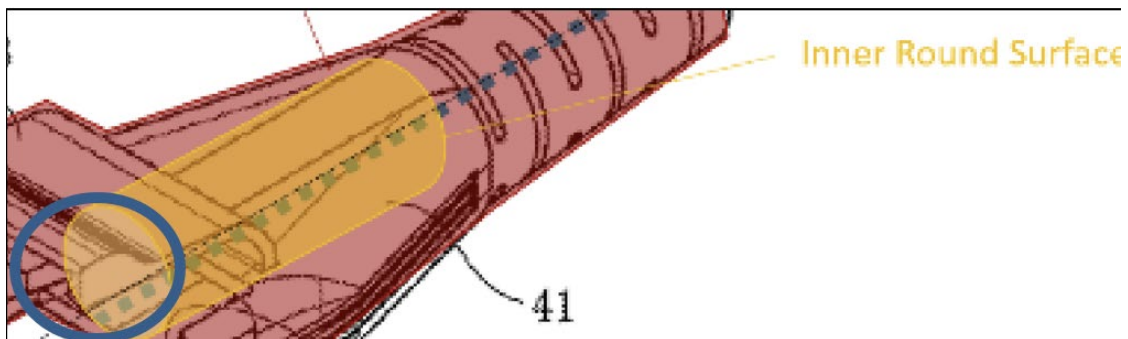
First, a longitudinal axis with small black dotted line from one end of the Figure to another end of the Figure—showing a distal and proximal end of the entire Figure itself, as an orientation for the reader.

Second, a boot passageway is labeled with larger blue dashes (as shown in the blown up version of annotated Figure 4B below). The Board acknowledges the larger blue dashes, but incorrectly alleges that Dr. Brennan identifies the larger blue dashes extend “the entire length of Nakagawa’s boot 40.” Decision, 16. Contrary to the Decision, the larger blue dashes are only a small portion of the longitudinal axis and boot 40—defining the length of the boot passageway as being an opening only running through a main body portion 41 of boot 40.



EX1007, FIG. 4B, further annotated for this Rehearing.

Third, the inner round surface section is highlighted in orange and defines a proximal end of the boot passageway.



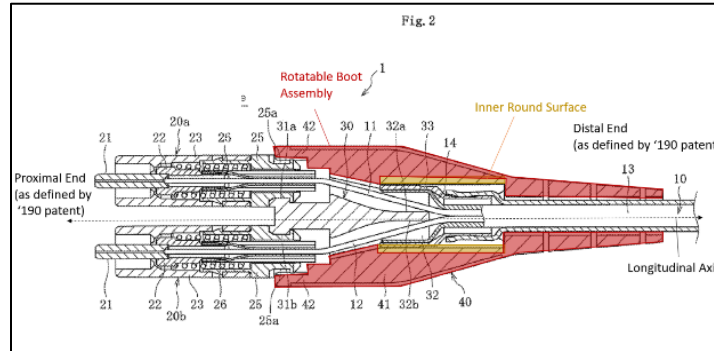
EX1007, FIG. 4B, further annotated for this Rehearing.

This circle (above) shows where the larger blue dashes of the boot passageway end, and that corresponds to the inner round surface defining a proximal end portion of the boot passageway.

Contrary to Patent Owner's assertions and the Decision, Dr. Brennan's Declaration at ¶164 never states the entire black dashed longitudinal axis orientation line is the boot passageway. Nor does it state the entire portion of the black dashed longitudinal axis that is coextensive with boot 40 is the boot passageway. Rather, the Declaration expressly states "I believe a POSITA would have understood that **the tubular main body portion corresponds to the recited boot passageway** as shown in Figure 4B of Nakagawa, reproduced below, because the boot should have a passageway to accommodate an optical fiber." EX1016, ¶164 (annotated). And the Declaration expressly states and shows that the dotted black line is merely an orientation tool to show the distal and proximal end of *the longitudinal axis* or the entire Figure orientation, not the distal and proximal end of the claimed *boot passageway*. See EX1016, ¶¶155, 164, 166 (citing EX1007, FIG. 2).

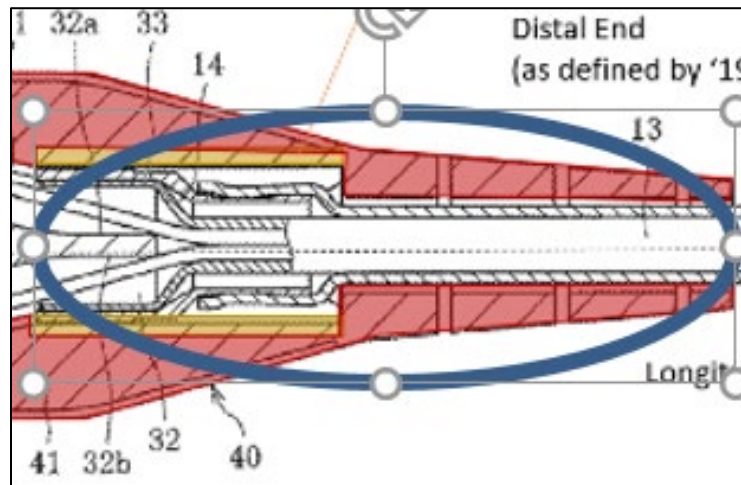
The Decision's misapprehending or overlooking how the Petition and Declaration mapped the longitudinal axis line, the boot passageway and the inner round surface, leads the Decision to incorrectly give credence to Patent Owner's incorrect argument that the Petition's use of Nakagawa allegedly "defines an **intermediate portion** of a boot passageway, that is distal of the proximal end portion of the boot passageway" (Prelim. Resp. 57 (citing EX2007, ¶120)). And this incorrect argument leads the Decision to incorrectly find that Nakagawa does

not teach “the inner round surface defining a proximal end portion of the boot passageway.” This incorrect finding partially relied upon annotated Figure 2.



EX1007, FIG. 2 (excerpt, annotated).

The Petition’s discussion of the boot passageway in Figure 4B equates to the boot passageway within the circle in Figure 2 shown below.

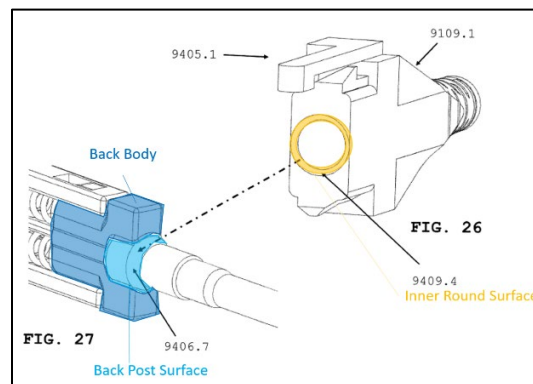


EX1007, FIG. 2 (excerpt, further annotated for this Rehearing).

Thus, the Decision’s position that the proximal end of the yellow inner round surface is the intermediate portion is based on the misreading of Figure 2. Rather, the yellow inner round surface is not an **intermediate portion** of the boot

passageway, but rather “the inner round surface defining a proximal end portion of the boot passageway.” EX1001, claim 1; EX1016, ¶166.

Further, the boot passageway being equal to the length of the entire boot 40 is inconsistent, and thus unreasonable, in view of the '190 Patent. The '190 patent shows the space under operation lever 43 (recited elongated arm) is not part of the boot passageway due to the open/unenclosed nature of that space. '190 patent Figure 26 shows an alignment key 9405.1 extending from an upper side of a boot 9109.1. But an inner circular surface 9409.4, which allegedly defines the boot passageway, is recessed from alignment key 9405.1. Therefore, the Patent Owner (PO) and the Board’s allegations are inconsistent with the '190 patent.



EX1001, FIGs. 26 and 27 (annotated).

Once this misunderstanding is rectified, the Board should reverse the Decision and institute trial, during which Petitioner will also show that Veatch’s Grounds are also correct.

II. STANDARD OF REVIEW

A party dissatisfied with a decision may file a request for rehearing. 37 C.F.R. § 42.71(d). The request must specifically identify all matters the party believes the decision misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. *Id.* The Board reviews previous decisions for an abuse of discretion. 37 C.F.R. § 42.71(c).

“An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 39 at 2–3 (P.T.A.B. Feb. 14, 2014) (*citing Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005)).

III. THE DECISION MISAPPREHENDED THE PETITION AND DECLARATION'S USE OF A LONGITUDINAL AXIS BLACK DOTTED LINE SHOWING ORIENTATION OF THE NAKAGAWA FIGURE AS BEING THE PETITIONER'S TEACHING FOR THE CLAIMED BOOT PASSAGEWAY.

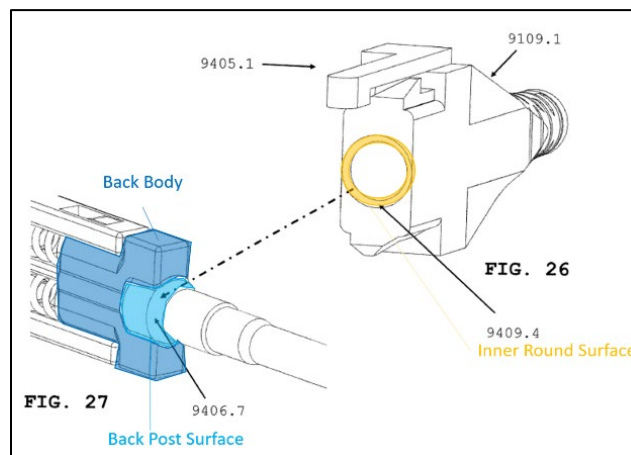
Again, as the Nakagawa issues demonstrate the Decision misapprehended or overlooked the facts of this case, Petitioner requests reversal and Institution on all Grounds based on this error alone.

A. Claim Element 1.3.3.

Claim element 1.3.3 recites:

- the rotatable boot assembly comprising a boot passageway extending from the distal end portion through the main body,
- the main body comprising an inner round surface extending along the longitudinal axis,
- the inner round surface defining a proximal end portion of the boot passageway.

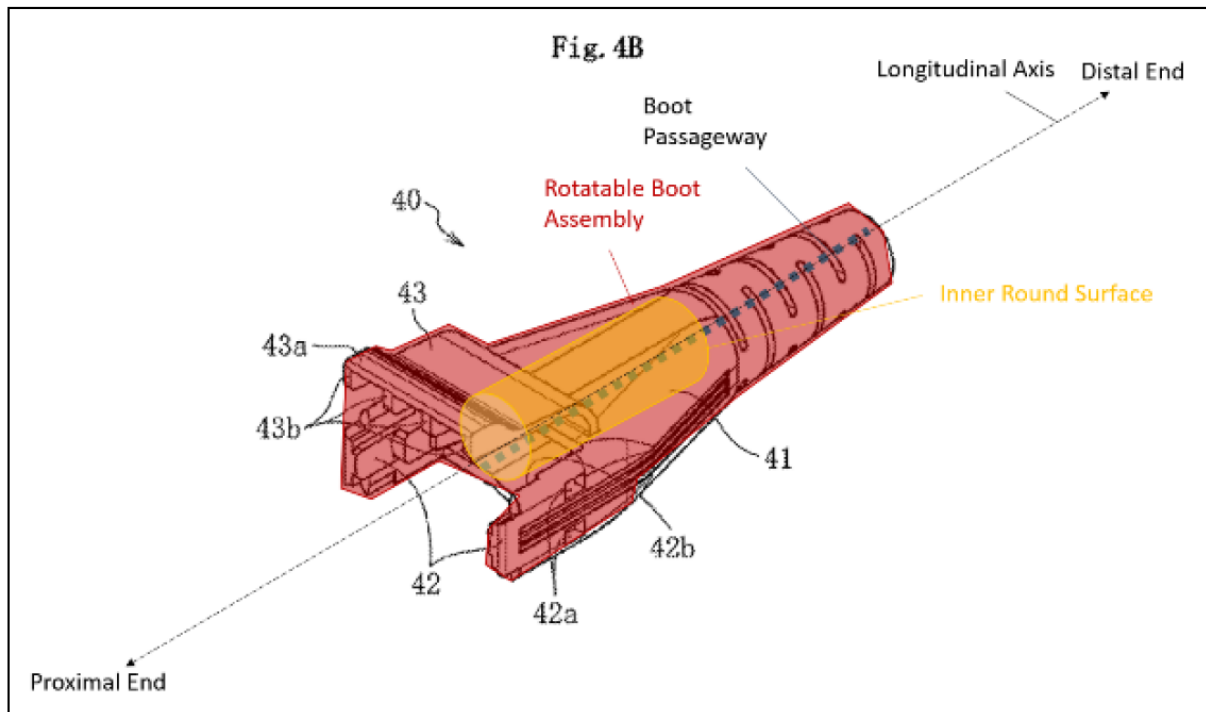
Element 1.3.3 appears to be shown in the '190 Patent Figures 26 and 27.



EX1001, FIGS. 26 and 27 (annotated).

B. Patent Owner and the Decision Misapprehend what Nakagawa teaches as the boot passageway and thus what Petitioner argues teaches the inner round surface defining a proximal end portion of the boot passageway.

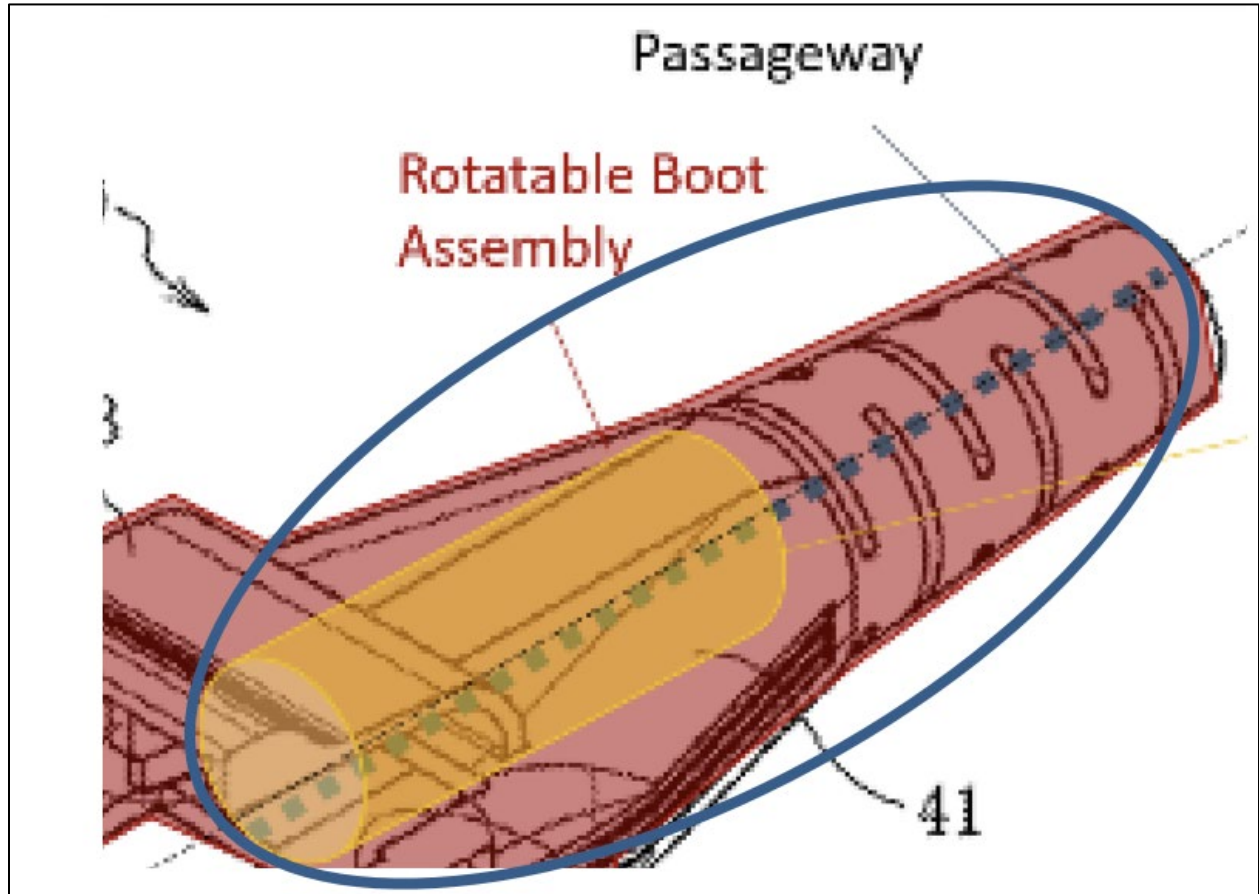
The Petition maps element 1.3.3 to Nakagawa in annotated Figure 4B.



EX1007, FIG. 4B (annotated).

Nakagawa states boot 40 consists of three different components. EX1017, ¶56 (“boot 40 integrally includes, **a tubular main body portion 41** which narrows toward **the proximal end** side, **a pair of fixing portions 42** which extend from both ends in the width direction of a leading end portion of the main body portion 41, and **an operation lever 43** which is provided in a top surface of the main body portion 41” (emphasis added)).

Petitioner, relying on Nakagawa's teaching, shows that the tubular main body portion 41 includes the claimed boot passageway annotated as large blue dashes. The large blue dashes only extend from a distal end portion of **boot 40** (upper right Figure 4B) through the main body of **the boot 40**.



EX1007, FIG. 4B, further annotated for this Rehearing.

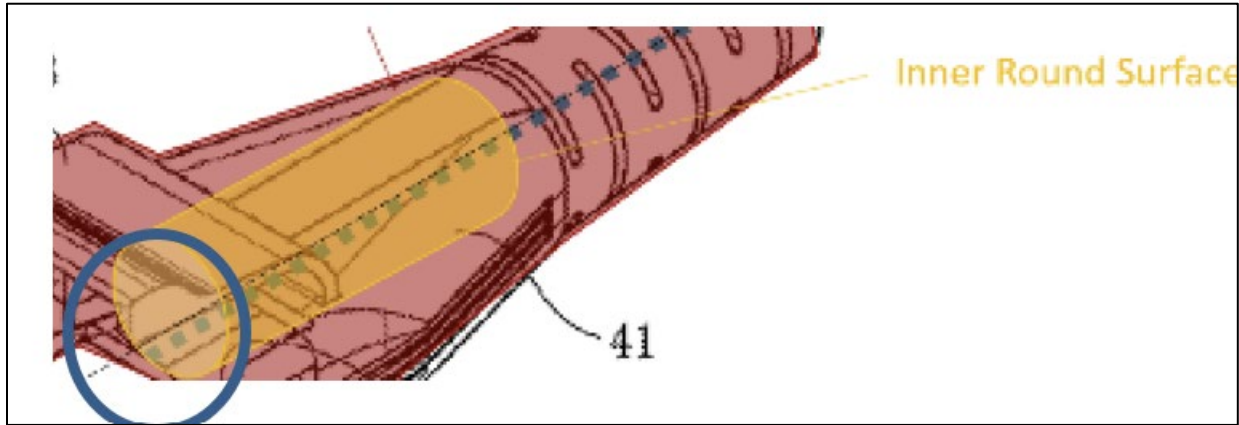
The Decision appears to misapprehend that only the larger blue dashes are equated to the claimed boot passageway and not the entire longitudinal axis (annotated by smaller black dashes), or even the entire portion of the longitudinal axis that is coextensive with the entire structure of boot 40. For example, the

Decision states “Dr. Brennan identifies the ‘boot passageway’ as extending **the entire length of Nakagawa’s boot 40**. Ex. 1016 ¶ 164 (annotation of Nakagawa Figure 4B identifying boot passageway with dotted blue line).” Dec., 16 (emphasis added). Rather, the larger blue dashes are only extending partially through boot 40, not the entire length of the boot 40. EX1016, ¶164.

The Petition states “Further, a POSITA would also have understood this inner round surface to *extend along* the longitudinal axis as represented in Figure 4B above.” Pet., 40 (emphasis added). So the black dotted line is a longitudinal axis along which the inner round surface extends. Dr. Brennan at ¶164 affirms that same meaning behind using the black dotted line – a longitudinal axis showing distal and proximal orientations of the Figure 4B. Nowhere does Petitioner or Dr. Brennan ever hint or provide evidence supporting the Decision’s erroneous statement that “Dr. Brennan identifies the ‘boot passageway’ as extending **the entire length of Nakagawa’s boot 40**.” Dec., 16 (emphasis added). Not would they based on the above-noted disclosure in ¶56 of Nakagawa.

When reading Nakagawa, the Petition, and the Declaration correctly, the Petition shows that the last aspect of the claim is also met: “the inner round surface defining a proximal end portion of the boot passageway.” Specifically, as highlighted by the circle below, where the larger blue dashes of the boot passageway end corresponds to the inner round surface defining a proximal end

portion (lower left portion of Figure 4B reproduced below) of the boot passageway—which is what is required by the claims.

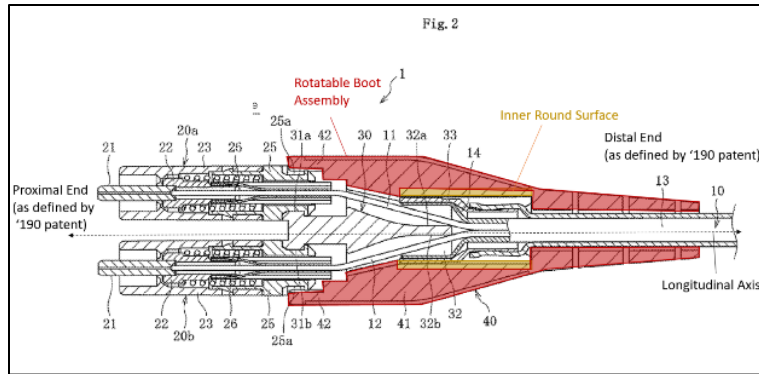


EX1007, FIG. 4B, further annotated for this Rehearing.

Based at least on this misapprehension or overlooking of the evidence, the Board should reverse the Decision and institute the proceeding on all Grounds.

C. PO incorrectly argues the Petition relies on an intermediate portion of the passageway as including the inner round surface.

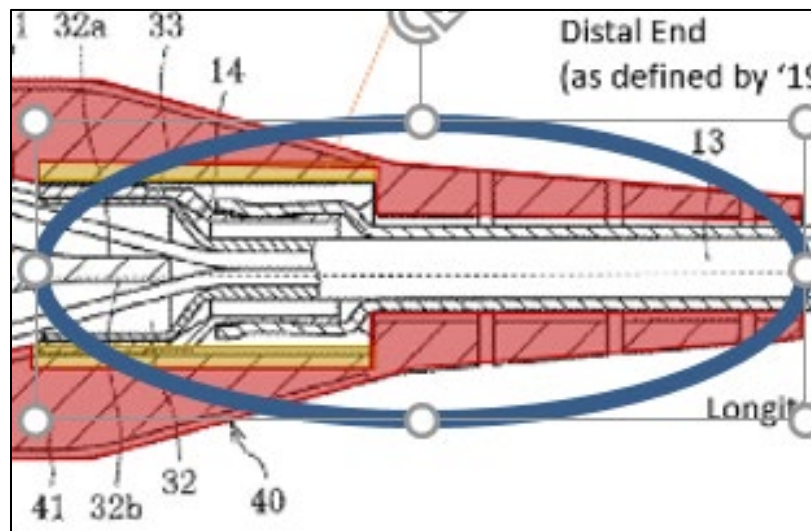
The Decision states: “Relying on the testimony of Mr. Pearson, Patent Owner argues that the ‘inner round surface’ of Nakagawa relied on by Petitioner ‘defines an intermediate portion of a boot passageway, that is distal of the proximal end portion of the boot passageway.’” Prelim. Resp. 57 (citing EX2007, ¶120).” Dec., 16. Both the Decision and PO point to Figure 2 and Petitioner’s annotations.



EX1007, FIG. 2 (excerpt, annotated).

PO's misidentification of what Nakagawa Figure 2 shows appears to have misguided the Decision. For example, there appears to be a misunderstanding of what the Petition identifies as Nakagawa's boot assembly versus boot passageway versus longitudinal axis of the entire figure or entire boot 40.

The Petition shows the boot passageway is the portion within the circle of Figure 2 shown below, which is consistent with the Petition use of Figure 4B.



EX1007, FIG. 2, further annotated for this Rehearing.

When considering this circled area being the entirety of the boot passageway, then the yellow inner round surface is not an intermediate portion of the boot passageway, but rather “the inner round surface defin[ing] a proximal end portion of the boot passageway.” EX1016, ¶166. At best, what PO calls the intermediate portion may be of boot 40, but it is not an intermediate portion of the defined passageway running through the boot.

Based at least on this misapprehension or overlooking of the evidence, the Board should reverse the Decision and institute the proceeding on all Grounds.

IV. CONCLUSION

The Decision overlooked and misapprehended the claim language, the Petition, the Declaration, and the Patent Owner allegations. This drove the Decision’s conclusion that the Petition failed to show that Nakagawa (or Veatch) taught claim element 1.3.3.

US Conec Ltd. respectfully requests that the Board reconsider the Decision and institute trial on all challenged claims and Grounds.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason D. Eisenberg/

Jason D. Eisenberg (Reg. No. 43,447)

Lestin L. Kenton (Reg. No. 72,314)

Masayuki Iino (Reg. No. 80,729)

Counsel for Petitioner US Conec Ltd.

Date: July 5, 2024

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned **PETITIONER'S REQUEST FOR REHEARING OF INSTITUTION DECISION** was served on July 5, 2024, in its entirety on:

Kurt F. James (Lead Counsel)
John R. Schroeder (Back-up Counsel)
David S. Kim (Back-up Counsel)
Jonathan G. Pollmann (Back-up Counsel)
Steven Levitt (Back-up Counsel)
STINSON LLP
kurt.james@stinson.com
john.schroeder@stinson.com
david.kim@stinson.com
jonathan.pollmann@stinson.com
steven.levitt@stinson.com

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason D. Eisenberg/

Jason D. Eisenberg
Registration No. 43,447
Counsel for Petitioner US Conec Ltd.

Date: July 5, 2024

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600