

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AUTEL INTELLIGENT TECHNOLOGY CORP., LTD.,
Petitioner,

v.

ORANGE ELECTRONIC CO., LTD.,
Patent Owner.

IPR2021-01545
Patent 8,031,064 C3

Before NEIL T. POWELL, KEVIN C. TROCK, and AMBER L. HAGY,
Administrative Patent Judges.

POWELL, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. BACKGROUND

Autel Intelligent Technology Corp., Ltd. (“Petitioner”) filed a Petition for *inter partes* review of claims 16–19, 21, and 23–29 of U.S. Patent No. 8,031,064 C3 (Ex. 1001, “the ’064 patent”). Paper 1 (“Pet.”). Orange Electronic Co., Ltd. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

An *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). 35 U.S.C. § 325(d) also provides that, in determining whether to institute an *inter partes* review, the Director may take into account whether the same or substantially the same prior art or arguments were presented previously to the Office. Upon considering the evidence presented and the arguments made, we deny institution of an *inter partes* review for the reasons discussed below.

B. RELATED PROCEEDINGS

The parties note that the ’064 patent is involved in *Orange Electronic Co. Ltd. v. Autel Intelligent Technology Corp., Ltd.*, No. 2:21-cv-00240 (E.D. Tex.). Pet. 73; Paper 7, 2. Patent owner also identifies as a related matter *Autel US Inc. v. Orange Electronic Co. Ltd.*, Case No. 1:21-cv-1321 (E.D. Va. 2021). Paper 7, 2.

C. THE '064 PATENT

The '064 patent issued from U.S. Patent Application No. 12/283,979. Ex. 1001, 1, code (21).¹ The '064 patent was reexamined a first time in Reexamination No. 90/012,430. Ex. 1001, 9; Ex. 1003. The '064 patent was reexamined a second time in Reexamination No. 90/013,169. Ex. 1001, 11; Ex. 1004. The '064 patent was reexamined a third time in Reexamination No. 90/014,362 (the “Third Reexamination”). Ex. 1001, 14; Ex. 1005.

The '064 patent discusses “Tire Pressure Monitoring Systems (TPMSs).” Ex. 1001, 6, 1:13–18. These systems monitor tire air pressures to confirm normal pressure or identify abnormal pressure. *Id.* The '064 patent discusses such a system in connection with Figure 4. *Id.* at 6, 1:25–27, 2:29–30. Figure 4 is reproduced below.

¹ When citing Exhibit 1001, we first list a page number on which the cited material appears. In many instances, after the page number, we include more specific locating information, such as a code number or column and line numbers.

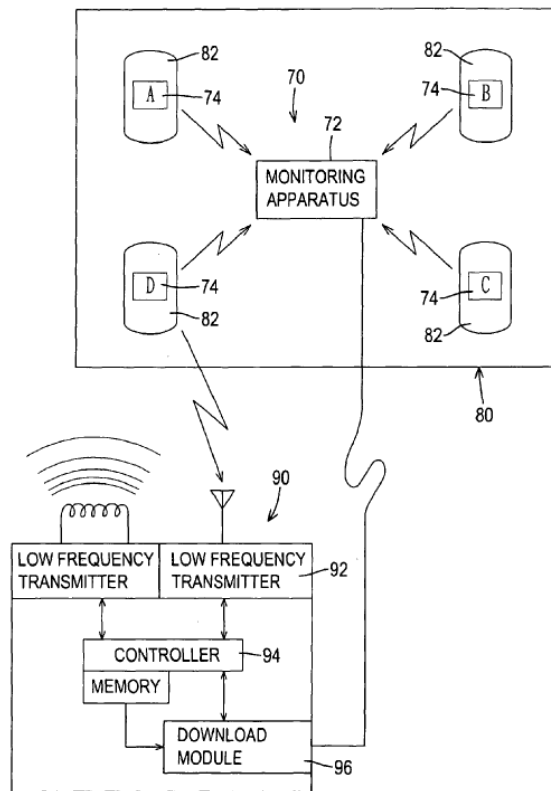


FIG.4

Figure 4 is a block diagram showing car (80) with tire pressure detecting system (70). *Id.* at 6, 1:25–30, 2:29–30.

Tire pressure detecting system (70) includes monitoring apparatus (72) and four tire pressure detectors (74). *Id.* at 6, 1:25–30. Each tire pressure detector (74) is mounted within one of four tires (80). *Id.* at 6, 1:28–30. Each tire pressure detector stores an “identification (ID).” *Id.* at 6, 1:32–34. Monitoring apparatus (72) “continuously receives wireless signals sent from the tire pressure detectors,” and “the wireless signal stream comprises the identification.” *Id.* at 6, 1:30–32. Monitoring apparatus (72) “recognizes the tire pressure detectors (74) by identifying the IDs in the received wireless signals.” *Id.* at 6, 1:37–39.

In the example of Figure 4, replacing a failed tire pressure detector (74) with a new tire pressure detector (74) involves using setting

Figure 1 shows a tire pressure detector that includes identification rewritable tire pressure detector (10) and setting apparatus (20). *Id.* at 6, 2:34–37.

Identification rewriteable tire pressure detector (10) “has a micro-processing module (12), a sensing module (14), a transmitting module (16), a power module (18) and a receiving interface (19, 19A).” *Id.* at 6, 2:38–42. Micro-processing module (12) includes memory unit (122), which may store an identification. *Id.* at 6, 2:43–48.

Setting apparatus (20) includes “a control module (21), a receiving module (23), a setting output module (25), an input module (27), and a power source (29).” *Id.* at 7, 3:29–34. “[S]etting apparatus (20) communicates with the identification rewriteable tire pressure detector (10) and tire pressure detectors that are generally using a same range of frequencies.” *Id.* at 7, 3:29–32. Setting apparatus 20 can read an identification from a failed tire pressure detector. *Id.* at 6, 2:9–10. “[R]eceiving module (23) . . . receives the RF signal from the identification rewriteable tire pressure detector (10) or the tire pressure detectors that are capable of sending the RF signals.” *Id.* at 6, 3:35–38.

Setting apparatus (20) can send the identification to identification rewritable tire pressure detector (10). *Id.* at 6, 2:9–12. In particular,

[t]he setting output module (25) is controlled by the control module (21) to send the external signal to the receiving interface (19, 19A). Wherein, the external signal is generated by the control module (21) and may comprise the external identification that is identical to preset identification in the RF signal received from the receiving module (23).

Id. at 7, 3:43–48. Receiving interface (19, 19A) provides the identification to micro-processing module (12), which “receives and memorizes the external identification into the memory unit (122).” *Id.* at 7, 3:6–14.

In connection with Figure 3, the '064 patent describes “a tire pressure detector identification copying method.” *Id.* at 7, 4:7–8. Figure 3 is reproduced below.

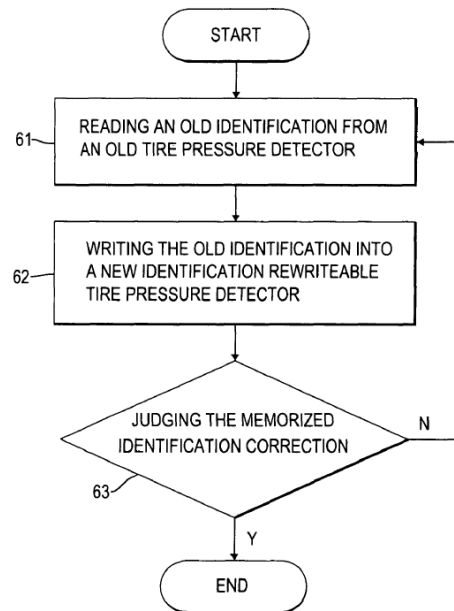


FIG.3

Figure 3 “is a flow chart of a tire pressure detector identification copying method in accordance with the present invention.” *Id.* at 6, 2:26–28.

The method begins with step (61), which involves “reading an old identification from an old tire pressure detector.” *Id.* at 7, 4:14–15. In this step, “a serviceman may use the setting apparatus (20) to receive the RF signal wirelessly from any old tire pressure detector.” *Id.* at 7, 4:14–17.

Step (62) involves “writing the old identification into a new identification rewriteable tire pressure detector.” *Id.* at 7, 4:23–24. “[A]fter the external identification of the old tire pressure detector is acquired, the serviceman may rewrite the external identification into a new identification rewritable tire pressure detector.” *Id.* at 7, 4:24–28.

Step (63) involves “judging the memorized identification correction.”

Id. at 7, 4:32–33. The ’064 patent explains that

after the external identification of the old tire pressure detector has been memorized in the new identification rewriteable tire pressure detector, the serviceman may use the setting apparatus (20) to receive wireless signals from the new identification rewriteable tire pressure detector. The setting apparatus (20) judges the consistence of the identifications acquired from the old tire pressure detector and the new identification rewriteable tire pressure. When the identification is not consistence, the setting apparatus performs the step of writing the old identification into a new identification rewriteable tire pressure detector (62) again.

Id. at 7, 4:34–44.

D. ILLUSTRATIVE CLAIM

Of the challenged claims, claims 16, 18, 23, and 26–28 are independent.² Claim 16 is illustrative and is reproduced below with certain reformatting:³

16. A tire pressure detecting system, comprising:
- [16A] an identification rewritable tire pressure detector comprising:
 - [16B] a micro-processing module having a rewritable memory unit to record an identification;
 - [16C] a sensing module electrically connected to the micro-processing module and having a pressure-detecting unit to detect a tire pressure and send a detection result to the micro-processing module;
 - [16D] a transmitting module controlled by the micro-processing module to transmit a radio frequency (RF) signal, wherein the RF signal comprises the detection

² Claims 16–29 were added as part of two *ex parte* reexamination certificates dated December 12, 2014, and May 15, 2020. Ex. 1001.

³ We have numbered the claim limitations with the same numbers used by the Petition to identify claim 16’s limitations.

result and the identification of the identification rewritable tire pressure detector;

[16E] a power module electronically connected to the micro-processing module to supply power to the identification rewriteable tire pressure detector; and

[16F] an interface arranged to receive an external signal and send the external signal to the micro-processing module, wherein the external signal comprises an external identification to be written into the rewriteable memory unit or to be used to overwrite a preset identification in the rewriteable memory unit; and

[16G] a portable setting apparatus arranged to communicate with the identification rewriteable tire pressure detector, comprising:

[16H] a control module;

[16I] an input module connected to the control module to enable an operator to manually input an identification to be written into the identification rewriteable tire pressure detector:

[16J] a receiving module connected to the control module to receive the RF signal from the identification rewriteable tire pressure detector or a tire pressure detector and to send the RF signal to the control module;

[16K] a setting output module controlled by the control module to send the external signal to the interface of the identification rewriteable tire pressure detector, wherein the external signal is generated by the control module and comprises the identification that is provided by the input module or provided by the RF signal received from the receiving module; and

[16L] a power source connected to the control module to supply power to the setting apparatus;

[16M] wherein the setting apparatus is configured to:

obtain an update identification to be written into a new identification rewriteable tire pressure detector either by (1) receiving the RF signal from an old tire pressure detector by the receiving module, retrieving an old identification of the old tire pressure detector from the RF signal, and using the old identification as the update identification, or by (2) receiving a manual input of the

identification from the input module, and using the identification as the update identification;

[16N] store the update identification in the setting apparatus;

[16O] generate the external signal comprising the update identification as the external identification, and send the external signal to the new identification rewriteable tire pressure detector such that the new identification rewriteable tire pressure detector records the update identification in the rewritable memory unit or overwrites the preset identification in the rewritable memory unit by the update identification; and

[16P] verify the update identification newly recorded in the rewritable memory unit of the new identification rewriteable tire pressure detector, wherein the verifying step comprises:

[16Q] receiving, by the setting apparatus, a wireless signal from the new identification rewriteable tire pressure detector, wherein the wireless signal comprises the update identification newly recorded in the rewritable memory unit; and

[16R] judging by the setting apparatus, consistency of the update identification newly recorded in the rewritable memory unit and the old identification of the old tire pressure detector.

Ex. 1001, 15, 1:26–2:36.

E. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner challenges the patentability of claims 16-19, 21, and 23-29 of the '064 patent on the following grounds (Pet. 10):

Claims Challenged	35 U.S.C. §	Reference(s)
16, 18, 21, 23, 24, 26–29	103(a) ⁴	Nihei, ⁵ Nantz, ⁶ Toyofuku ⁷
17, 19, 25	103(a)	Nihei, Nantz, Toyofuku, Lemense ⁸
17, 19, 25	103(a)	Nihei, Nantz, Toyofuku, Itou ⁹

In support of its unpatentability contentions, Petitioner also relies on the Declaration of Nader Bagherzadeh, Ph.D. Ex. 1006.

II. ANALYSIS

A. DISCRETION TO DENY UNDER 35 U.S.C. § 325(d)

1. *Authority*

35 U.S.C. § 325(d) states, in relevant part: “In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously

⁴ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the '064 patent has an effective filing date prior to the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of § 103.

⁵ US Patent Application Publication No. 2007/0055411 A1, published Mar. 8, 2007 (Ex. 1007).

⁶ US Patent Application Publication No. 2006/0208864 A1, published Sept. 21, 2006 (Ex. 1008).

⁷ US Patent No. 6,920,785 B2, issued July 26, 2005 (Ex. 1009).

⁸ US Patent No. 6,941,801 B2, issued Sept. 13, 2005 (Ex. 1010).

⁹ US Patent No. 7,079,033 B2, issued July 18, 2006 (Ex. 1011).

were presented to the Office.” The Board uses a two-part framework for evaluating arguments under § 325(d):

(1) 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 first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). “[T]he *Becton, Dickinson* factors provide useful insight into how to apply the framework under 35 U.S.C. § 325(d).” *Id.* at 9 (footnote omitted). The non-exclusive *Becton, Dickinson* factors are:

(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 § III.C.5, first paragraph). *Becton, Dickinson* factors (a), (b), and (d) relate to the first part of the *Advanced Bionics* framework (whether the same or substantially the same art or arguments previously were presented to the Office), and *Becton, Dickinson* factors (c), (e), and (f) relate to the second part of that framework (previous Office error). *Advanced Bionics*, IPR2019-01469, Paper 6 at 9–11.

2. Discussion

The parties dispute whether we should exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d). Pet. 71–72; Prelim. Resp. 19–31. The dispute focuses on the Third Reexamination.

a) The Third Reexamination

The reexamination request for the Third Reexamination asserted substantial new questions of patentability of claims 16–25 based on four combinations of prior art. *E.g.*, Ex. 1005, 18–19. The reexamination request asserted that “[c]laims 16-25 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Taguchi in view of Nantz and Toyofuku.” *Id.* at 18. The reexamination request also asserted that “[c]laims 17, 19, and 25 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Taguchi, Nantz, and Toyofuku in further view of Itou.” *Id.* at 19. The reexamination request further argued that “[c]laims 16-25 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Taguchi in view of Lemense and Toyofuku.” *Id.* The reexamination request also argued that “[c]laims 16-25 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Taguchi in

view of Lemense and Toyofuku.” *Id.* The Examiner found that a substantial new question of patentability had been raised for claims 16–25. *Id.* at 1365.

In the subsequent Office Action, the Examiner rejected claims 16–22, 24, and 25. *Id.* at 1376–97. The Examiner rejected claims 16–22, 24, and 25 as obvious over Taguchi, Toyofuku, and Nantz. *Id.* at 1376.

Additionally, the Examiner rejected claims 17, 19, and 25 “under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Itou.” *Id.* at 1397.

The Examiner deemed claim 23 allowable. *Id.* at 1399. The Examiner explained that

The following is a statement of reasons for the indication of allowable subject matter:

The Examiner notes that claim 23 recites the following:

The method as claimed in claim 22, wherein the verifying step comprises:

receiving, by the setting apparatus, a wireless signal from the new identification re writeable tire pressure detector, wherein the wireless signal comprises the update identification newly recorded in the rewritable memory unit;

judging, by the setting apparatus, consistency of the update identification newly recorded in the rewritable memory unit and the old identification of the old tire pressure detector; and

if the update identification newly recorded in the rewritable memory unit is not consistent with the old identification of the old tire pressure detector, performing the generating step again.

As set forth above, claim 16 recites both an identification rewritable tire pressure detector and a portable setting apparatus. Claim 23 recites judging, by the setting apparatus, consistency of the update identification newly recorded in the rewritable memory unit and the old identification of the old tire pressure detector.

The examiner notes that Toyofuki discloses:

“When the outputting the data to the external input signal controller 23 is finished, the dedicated writing device 4 outputs a signal for turning the signal A to the low level, whereby the external input signal controller 23 confirms a completion of the input, and outputs the imported self-identification code as the R part of the signal B to the dedicated writing device 4 for a verification. The dedicated writing device 4 automatically verify the signal, and if the verification is O.K, a sign of the completion of writing is displayed on the data display 42.” at 5:58-67

The teachings associated with Toyofuku shows that the controller 23 confirms completion of the input and outputs [sic] a signal to the writing device 4 for a verification. Although the dedicated writing device 4 verifies the signal (which is based upon completion of inputting the data), the teachings do not show that the writing device judges the consistency of the update identification dnwly [sic] record in the rewritable memory unit and the old identification of the old tire pressure detector”, rather it just verifies completion of the input of data.

Id. at 1399–1400.

In response, Patent Owner amended claim 23 into independent form. *Id.* at 1433–34, 1441. Additionally, Patent Owner amended independent claims 16 and 18 to include some of the same limitations recited in claim 23, including the limitation “judging, by the setting apparatus, consistency of the update identification newly recorded in the rewritable memory unit and the old identification of the old tire pressure detector” (hereinafter, the “judging consistency limitation.”). *Id.* at 1428–32. Based on the inclusion of the judging consistency limitation, Patent Owner argued that independent claims 16, 18, and 23 were allowable. *Id.* at 1441–42.

Patent Owner also added new claims 26–29, including independent claims 26–28 and dependent claim 29. *Id.* at 1434–40, 1442–53. Patent

Owner argued that each of independent claims 26–28 included certain limitations that distinguished them from the disclosures of the cited prior art. *Id.* at 1442–1453. Regarding claim 29, Patent Owner explained that “new claim 29 has been added to depend upon allowable claim 23.” *Id.* at 1442.

Subsequent to these amendments and arguments, the Examiner issued a Notice of Intent to Issue Ex Parte Reexamination Certificate (“NIRC”). Addressing claims 16–19, 21, and 23–25, the NIRC included the following “statement of reasons for patentability and/or confirmation of the claims found patentable”:

The examiner notes that previous claim 23 recited “judging, by the setting apparatus, consistency of the update identification newly record3ed [sic] in the rewritable memory unit and the old identification of the old tire pressure detector.”

The examiner notes that Toyofuki discloses:

“When the outputting the data to the external input signal controller 23 is finished, the dedicated writing device 4 outputs a signal for turning the signal A to the low level, whereby the external input signal controller 23 confirms a completion of the input, and outputs the imported self-identification code as the R part of the signal B to the dedicated writing device 4 for a verification. The dedicated writing device 4 automatically verity the signal, and if the verification is O.K, a sign of the completion of writing is displayed on the data display 42.” at 5:58-67

The Examiner determines that the teachings associated with Toyofuku show that the controller 23 confirms completion of the input and outputs a signal to the writing device 4 for a verification. Although the dedicated writing device 4 verifies the signal (which is based upon completion of inputting the data), [sic] The teachings do not s[h]ow that the writing device judges the consistency of the update [identification] newly recorded in the rewritable memory unit and the old identification of the old tire pressure detector, rather it just verifies completion of the input of data.

Id. at 1495–96.

Addressing independent claims 26–28, the Examiner discussed Patent Owner’s arguments, concluding that “upon review of all of the arguments presented by the Patent Owner, the examiner finds the argument persuasive.” *Id.* at 1493–95.

b) Petitioner’s § 325(d) Arguments

Petitioner argues that we should not deny under § 325(d) “because the Office has not considered the prior art grounds forming the basis of this Petition. Petitioner’s primary reference (Nihei) was not cited during prosecution, nor was it cited in any of the prior *ex parte* reexaminations.” Pet. 71. Focusing on Nihei’s disclosure and Dr. Bagherzadeh’s testimony, Petitioner argues that “[t]he fact that certain secondary references were cited during prosecution provides no basis for denying institution.” *Id.* at 71–72. Petitioner contends that Nihei discloses the judging consistency limitation, as well as most of the other elements of the challenged claims. *Id.* at 71. Additionally, Petitioner discounts the degree to which Nantz, Lemense, and Toyofuku previously were substantively considered by the Office. *Id.* at 72. Petitioner further argues that “to the extent the Office has considered the references cited herein, the Office materially erred by allowing the claims.” *Id.*

c) Patent Owner’s § 325(d) Arguments

Patent Owner argues that “[t]he Office’s previous findings with respect to the same or substantially same art and arguments presented by the Petition are equally applicable here.” Prelim. Resp. 2. Patent Owner argues that “the Petition, which was filed by the same counsel who filed the [Third Reexamination], relies on the same teachings of the art and the same

arguments previously considered by the Office in relation to the very features of the Challenged Claims that were added during reexamination to obtain allowance.” *Id.* at 1.

Addressing part one of *Advanced Bionics*, Patent Owner starts with *Becton, Dickinson* factors (a) and (b). *Id.* at 21–24. Patent Owner argues that Petitioner cites prior art that is the same as or cumulative to the prior art cited during the third reexamination. *Id.* at 21. Patent Owner explains that it distinguished the challenged claims from four of the five prior art references cited in the Petition. *Id.* Patent Owner elaborates that “the Petition’s grounds essentially mirror those of the reexamination request, but for the replacement of Taguchi (Ex-2001) with Nihei (Ex-1007).” *Id.*

Patent Owner further contends that Nihei is cumulative to the art cited during the Third Reexamination. *Id.* at 22–23. Indeed, Patent Owner argues, “the Petition admits that Nihei is cumulative of Toyofuku as relates to the consistency judgment claim feature.” *Id.* at 23. In support of this, Patent Owner cites the Petition’s statement that “[b]oth Nihei and Toyofuku disclose that, after the new identification is written in the memory of a tire pressure detector, the tire pressure detector sends back a signal verifying that the new identification has been successfully stored in memory.” Pet. 23; Prelim. Resp. 23. Similarly, Patent Owner argues that “Nihei is substantially the same as Taguchi and is relied on in the same manner—and for a teaching of the same claim features—as the prior art during the [Third Reexamination].” Prelim. Resp. 22. Patent Owner also argues that Nihei does not disclose the limitations that distinguished claims 26–28 from Taguchi and the other references cited during the Third Reexamination. *Id.* at 23–24.

Turning to *Becton, Dickinson* factor (d), Patent Owner argues the “[t]he Third Reexamination addresses substantially the same arguments and issues presented by Petitioner here.” *Id.* at 24. In support of this, Patent Owner argues that the limitations that distinguished the challenged claims over the prior art cited in the Third Reexamination are addressed with the same or substantially the same disclosures cited in the Petition. *Id.* at 24–27. Patent Owner notes that the Petition addresses the judging consistency limitation by arguing that “[b]oth Nihei and Toyofuku disclose that, after the new identification is written in the memory of a tire pressure detector, the tire pressure detector sends back a signal verifying that the new identification has been successfully stored in memory.” Pet. 23; Prelim. Resp. 25. Patent Owner argues that the Examiner in the Third Reexamination rejected the position that Toyofuku’s discussion of verification discloses the judging consistency limitation. Prelim. Resp. 25–26. And Patent Owner contends that “Nihei discloses no more than Toyofuku, and the arguments presented by Petitioner were previously considered by the Office and resolved in Patent Owner’s favor.” *Id.* at 25.

Regarding part two of *Advanced Bionics*, Patent Owner first addresses *Becton, Dickinson* factor (c). *Id.* at 28–29. Patent Owner argues that the Examiner in the Third Reexamination addressed substantively four of the five prior art references city by the Petition. *Id.* at 28. Patent Owner argues that the same references cited in the Third Reexamination are cited in the Petition as allegedly disclosing the limitations that the Examiner found missing from the prior art. Additionally, Patent Owner reiterates its position that Nihei is cumulative of the art cited during the Third Reexamination. *Id.*

28–29. Patent Owner also argues that Petitioner “false[ly] alleg[es]” the Examiner did not address Nantz substantially. *Id.* at 29.

Turning to *Becton, Dickinson* factors (e) and (f), Patent Owner argues that Petitioner does not even attempt to “articulat[e] error in the Office’s previous examinations.” *Id.* at 30. Patent Owner contends that Petitioner does not identify any errors that “justify reconsideration of the Office’s conclusions.” *Id.* Instead, Patent Owner argues, the Petition addresses the limitations that secured allowance of the challenged claims based on the same prior art the Examiner already considered. *Id.*

d) Analysis

(1) Part One of Advanced Bionics

Weighing the parties’ arguments and evidence, we find Patent Owner’s more persuasive. Petitioner does not show that the prior art cited in the Petition differs in any specific, substantial way from the prior art cited by Petitioner’s counsel in the Third Reexamination.

For example, we find unavailing Petitioner’s assertion that “Nihei was not previously considered and discloses the vast majority of the elements analyzed herein, including the ‘judging. . .consistency’ limitation previously relied upon for the allowance of the challenged claims.” Pet. 71. Petitioner does not persuade us that Nihei discloses the judging consistency limitation any more so than the portions of Toyofuku that the Examiner found fail to disclose the limitation. As purportedly disclosing the judging consistency limitation, Petitioner cites Nihei’s paragraphs 45 and 66. Pet. 43. In paragraph 45, Nihei discloses that

The received signal contains an ID which was input and set at the setting device. The received signal is supplied to the MP 32, the ID contained in the signal supplied to the MP 32 is extracted.

Then, this ID is stored and held as a new ID of the transmitter 16a in the memory 34. Upon completion of the storing and holding, at the MP 32, a signal of information to the effect that the new ID has been stored and held in the memory 34 is generated, and returned from the transmitter circuit 36 to the setting device.

Ex. 1007 ¶ 45. In paragraph 66, Nihei similarly discloses that

After the reproduced signal containing the ID has been supplied to the MP 32, the ID is extracted from this signal at the MP 32, and this ID is set as a new ID assigned to the transmitter 16a to be stored and held in the memory 34. Upon completion of the storing and holding, the MP 32 generates a signal of information to the effect that the new ID has been stored and held in the memory 34, and the signal is returned from the transmitter circuit 36 to the setting device 60 by a radio wave of, e.g., 315 MHz.

Id. ¶ 66. These passages, including their express disclosures of sending the setting device a signal “to the effect that the new ID has been stored and held in the memory 34,” facially do not disclose the judging consistency limitation any more so than the portion of Toyofuku that the Examiner found lacking.

Apparently recognizing that the cited passages do not expressly disclose the judging consistency limitation, Petitioner and Dr. Bagherzadeh contend that a person of ordinary skill in the art would understand the cited passages of Nihei as disclosing “a typical feedback signal that provides verification that the tire pressure detector successfully received the update identification and ‘stored and held’ the new identification in memory.”

Pet. 43; Ex. 1006 ¶ 101. Petitioner and Dr. Bagherzadeh elaborate that

it follows that a [person of ordinary skill in the art] also would understand that, in order to verify that the tire pressure detector received the update identification and correctly “stored and held” the new identification in memory, the setting apparatus would need to compare the newly recorded identification sent by the tire

pressure detector (transmitter 16a) in the feedback signal with the update identification initially sent by the setting apparatus to the tire pressure detector, and verify that the two identifications are consistent.

Pet. 43–44; Ex. 1006 ¶ 101. Petitioner and Dr. Bagherzadeh do not cite persuasive evidence for their characterization of Nihei. For example, when opining that Nihei “would need to compare” identifications, Dr. Bagherzadeh does not cite any objective support that would give his testimony persuasive weight. Ex. 1006 ¶ 101; 37 C.F.R. § 42.65(a). Accordingly, we find unavailing Petitioner’s argument that “the Patent Office has not had the benefit of considering the prior art in view of the supporting expert testimony of Dr. Bagherzadeh.” Pet. 71–72. Thus, Petitioner does not provide persuasive support for its suggestion, that in contrast to the prior art cited in the Third Reexamination, Nihei discloses the judging consistency limitation.

Additionally, Petitioner’s more general arguments fail to demonstrate any substantial difference between the prior art cited in the Petition and the prior art cited by Petitioner’s counsel in the Third Reexamination. For example, Petitioner’s argument that Nihei “discloses the vast majority of the elements analyzed herein” does not distinguish Nihei from the Third Reexamination’s cited prior art. Pet. 71. To the extent Nihei discloses most of the challenged claims’ elements, Petitioner does not identify any particular element of challenged claims 16–19, 21, and 23–29 disclosed by Nihei but missing from the prior art considered during the Third Reexamination. *See* Pet. 71–72. Failing to persuasively identify any specific, substantial difference between Nihei and the Third Reexamination’s prior art, Petitioner does not demonstrate a substantial

difference in the prior art merely by noting that the Examiner did not consider the secondary references of the Third Reexamination “in combination with Nihei.” Pet. 71.

On the whole, we find the Petition cites substantially the same art previously presented to the Office in the Third Reexamination. Patent Owner identifies extensive similarities between the art from the Third Reexamination and the art cited by the Petition. Prelim. Resp. 1, 21–24. Four out of the five references cited by the Petition are identical to the references considered in the Third Reexamination. *E.g.*, Pet. 9–10, 71–72; Ex. 1005, 18–19; Prelim. Resp. 21–22. Although Nihei was not considered during the Third Reexamination, Petitioner does not show any material difference between Nihei and the references cited in the Third Reexamination. To the contrary, we agree with Patent Owner that Petitioner’s unpersuasive arguments about the judging consistency limitation do not demonstrate that Nihei discloses this limitation any more so than Toyofuku. Prelim. Resp. 22–23. On the whole, we find Petitioner’s arguments about Nihei less persuasive than Patent Owner’s arguments that Nihei is cumulative to the art cited during the Third Reexamination. Prelim. Resp. 1, 8–18, 22–24. Thus, *Becton, Dickinson* factors (a) and (b) support Patent Owner’s position that substantially the same art was presented to the Office in the Third Reexamination.

Additionally, we find significant overlap between arguments made during the Third Reexamination and the manner in which Petitioner relies on the prior art cited in the Petition. In the Third Reexamination, Petitioner’s counsel cited Toyofuku as allegedly disclosing the judging consistency limitation. Ex. 1005, 58–9. Here, Petitioner also argues that a person of

ordinary skill in the art would have understood that Toyofuku discloses the judging consistency limitation. Pet. 44. Thus, *Becton, Dickinson* factor (d) also supports Patent Owner’s position that substantially the same art and arguments were presented to the Office in the Third Reexamination. Having determined that the Petition presents substantially the same art and arguments previously presented to the Office, we proceed to part two of the *Advanced Bionics* inquiry.

(2) *Part Two of Advanced Bionics*

Turning to part two of *Advanced Bionics*, Petitioner does not persuade us that the Office erred. For example, *Becton, Dickinson* factor (c) does not support Petitioner’s assertion that the Office erred. As noted above, Petitioner addresses the judging consistency limitation by citing Nihei and Toyofuku, arguing that a person of ordinary skill in the art would understand each reference discloses the limitation. Pet. 43–44. During the Third Reexamination, the Examiner evaluated the issue of whether Toyofuku discloses the judging consistency limitation, unequivocally finding that it does not. Ex. 1005, 1399–1400, 1493, 1495–96. Additionally, as explained above in Section II.A.2.d.(1), Petitioner does not demonstrate that Nihei discloses the judging consistency limitation any more so than Toyofuku.

Furthermore, we find unavailing Petitioner’s argument that “the record from the third *ex parte* reexamination establishes that the examiner never substantively addressed Nantz or Lemense.” Pet. 72. In the Third Reexamination, the Examiner substantively addressed Nantz extensively, citing Nantz as disclosing certain of the claims’ limitations, before ultimately finding the claims patentable. Ex. 1005, 1376, 1379–82, 1385–90, 1393–1397, 1493–1497. The Examiner also addressed Lemense’s

disclosure. *Id.* at 1363. Regarding Lemense, the reexamination request for the Third Reexamination relied on Lemense in much the same manner that the Petition relies on Lemense. *Compare* Ex. 1005, 10–11, 93–94, with Pet. 66–67; Prelim. Resp. Having considered the reexamination request, the Examiner addressed Lemense’s disclosure. Ex. 1005, 1363. Although the Examiner did not discuss Lemense as extensively as the Examiner discussed Nantz, we do not find that significant with respect to Petitioner’s § 325(d) arguments. The Petition does not cite Lemense as allegedly disclosing any part of the independent claims that the Examiner deemed patentable over Lemense and the other references cited during the Third Reexamination. *See* Pet. 25–66. Rather, the Petition cites Lemense only when addressing dependent claims 17, 19, and 25. *Id.* at 66–67.

Moreover, we disagree with Petitioner’s argument that the record lacks “any evidence of substantive consideration of Toyofuku for the elements for which it is cited herein.” *Id.* at 72. Petitioner cites column 5, lines 58–64 of Toyofuku to address the judging consistency limitation. Pet. 43–44. In the Third Reexamination, Petitioner’s counsel cited this exact disclosure of Toyofuku when addressing the same claim limitation. Ex. 1005, 58–59. The Examiner substantively addressed the relationship between the cited portion of Toyofuku and the judging consistency limitation, finding that Toyofuku fails to disclose the limitation. *Id.* at 1399–1400, 1493, 1495–96. The Examiner also substantively addressed the disclosures of Toyofuku with respect to certain other limitations. *E.g., id.* at 1377–81, 1384–98. Petitioner does not identify any specific limitation for which the Examiner did not substantively consider Toyofuku, much less explain persuasively why that supports its § 325(d) argument. Thus, the

record does not reflect any substantial deficiency in the extent to which the substance of the art presented by the Petition was evaluated previously.

Regarding *Becton, Dickinson* factors (e) and (f), we find that Petitioner has not pointed out sufficiently how the Examiner erred, and that the Petition does not contain additional evidence or facts that warrant reconsideration of the prior art or arguments. In conflict with the Examiner's finding, Petitioner and Dr. Bagherzadeh contend that "a [person of ordinary skill in the art] would understand that [Toyofuku's] verification would require judging whether the identification sent in the feedback signal from the tire pressure detector is consistent with the identification initially sent by the setting apparatus." Pet. 44; Ex. 1006 ¶ 102; Ex. 1005, 1399–1400, 1493, 1495–96. Based on this, Petitioner and Dr. Bagherzadeh further contend that

[t]hus, at a minimum, it would have been obvious to a [person of ordinary skill in the art] reading Nihei in view of Toyofuku that Nihei's feedback signal would include the identification stored in the detector memory so that Nihei's setting apparatus can judge whether this identification is consistent with the original identification that was sent "for a verification."

Pet. 44; Ex. 1006 ¶ 102.

Petitioner and Dr. Bagherzadeh do not provide persuasive evidence for their position that a person of ordinary skill in the art would understand Toyofuku contrary to the Examiner's finding. For example, when opining that Toyofuku's disclosure "would require" certain things, Dr. Bagherzadeh does not cite any objective support that would give his testimony persuasive weight. Thus, Petitioner does not demonstrate error in the Examiner's finding that Toyofuku does not disclose the judging consistency limitation. Ex. 1005, 1399–1400, 1493, 1495–96. Without a persuasive showing that

either Nihei or Toyofuku discloses the judging consistency limitation, Petitioner's conclusory argument that this limitation would have been obvious over the references also fails to demonstrate that the Office erred.

(3) *Conclusion Regarding § 325(d)*

For the foregoing reasons, weighing the parties' positions regarding § 325(d), we find Patent Owner's more persuasive.

III. CONCLUSION

For the foregoing reasons, we exercise our discretion under § 325(d) to deny institution of *inter partes* review.

IV. ORDER

For the reasons given, it is:

ORDERED that the Petition is *denied* as to all challenged claims of the '064 patent and no trial is instituted.

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