

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BESTWAY (USA), INC.,
Petitioner,

v.

INTEX MARKETING LTD.,
Patent Owner.

Case PGR2017-00003
Patent 9,254,240 B2

Before KEN B. BARRETT, FRANCES L. IPPOLITO, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Bestway (USA), Inc. (“Petitioner”) requests rehearing of the Board’s decision (Paper 9, “Institution Decision”), entered May 11, 2017, authorizing institution of a post-grant review of U.S. Patent No. 9,254,240 B2 (“the ’240 patent,” Ex. 1001). Paper 12 (“Reh’g Req.”). Specifically, Petitioner requests rehearing of our decision not to institute post-grant review of Petitioner’s “Ground 2,” the alleged obviousness of claims 18–22 and 30 over Peterson, Fireman, and Guan ’797. Reh’g Req. 1 (citing Institution Decision, 19–20). For the reasons that follow, the request is *denied*.

II. DISCUSSION

The applicable standard for granting a request for rehearing is abuse of discretion. The requirements are set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. 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.

Petitioner, referring to its Ground 2, argues that the Board “overlooked that the Petition provided a detailed explanation as to how claims 18-22 were unpatentable over the combination of Peterson and Fireman, *without Guan*.” Reh’g Req. 2 (citing Pet. 46–58). Petitioner also asserts that the Board overlooked specific arguments directed the reason to combine all three of these references’ teachings to render obvious claim 30. *Id.* at 4–5.

A. Guan as Unnecessary

Under 37 C.F.R. § 42.204(b), a petitioner is required to identify precisely in the petition the specific ground on which the claims are challenged. In the petition in this case, Petitioner asserted three grounds of unpatentability (Pet. 24):

Reference[s]	Basis	Claim(s)
Peterson and Fireman	§ 103	1–7, 17
Peterson, Fireman, and Guan ’797	§ 103	18–22, 30
Peterson, Fireman, Guan ’797, and Wang ’615	§ 103	19–22

Notably, the first ground was based only on Peterson and Fireman and did not challenge claims 18–22 and 30. Ground 2 challenging those claims, added Guan ’797 to the combination of Peterson and Fireman. Petitioner’s heading identified the challenge as: “Ground 2: Claims 18-22 and 30 are invalid as obvious over Peterson in view of Fireman and in further view of Guan 797.” *Id.* at 45 (bolding omitted). In articulating the ground and after asserting that the combination of Peterson and Fireman taught every feature of the underlying independent claims, Petitioner argued “[Dependent] Claims 18-22 and 30 are also invalid over Peterson in view of Fireman and in further view of Guan 797 for the reasons stated below.” *Id.*

In declining to institute a post-grant review as to Ground 2, we indicated our agreement with Patent Owner’s assertion that the articulated ground is confusing, stating:

As Patent Owner notes (Prelim. Resp. 61), Petitioner apparently replaces Peterson [with Guan ’797] as the primary reference in the middle of articulating its position concerning claim 18 (*see* Pet. 48). Thus, it is not clear whether Petitioner is proposing a

three-reference combination for Ground 2 or multiple two-reference combinations.

Institution Decision 19–20. We also declined to institute on this ground because Petitioner’s reasoning to combine the three references was deficient. *Id.* at 20.

Petitioner argues that the Board overlooked that Guan is unnecessary to the analysis of Ground 2 as to claims 19–22 (but not as to claim 30). Reh’g Req. 2 (heading); *see id.* at 4 (“the Petition indicates that *Guan* is not required”). In its Request, Petitioner maintains its position that that same ground including Guan is appropriate as applied to claim 30 and that Guan is necessary to the ground. *Id.* at 4–5.

Petitioner now asks that we reconsider our decision denying institution of Ground 2 by treating the ground as applied to claims 18–22 as if it were based solely on Peterson and Fireman and without Guan. *Id.* at 4. Petitioner did not identify specifically as a ground that which it now asks us authorize institution. We decline to reframe Petitioner’s second ground, as it applies to claims 18–22, by omitting Guan.

B. The Rationale for Combining the References as to Claim 30

As mentioned, Petitioner maintains that the portion of Ground 2 directed to dependent claim 30 was properly framed as including Guan. Reh’g Req. 4–5. Petitioner argues that the Board, in its Institution Decision, “appears to have focused solely on a general discussion of motivation to combine *Guan* with the other references at pages 45-46 of the Petition, and appears to have overlooked arguments specific to the particular features of claim 30 on pages 59-60 of the Petition.” *Id.* (citing Institution Decision 19–

20). While we did not address specifically Petitioner’s arguments regarding claim 30, we did consider those arguments and did not overlook them.

As we stated in the Institution Decision, Petitioner’s articulation of Ground 2 is confusing. Institution Decision 19. Petitioner now implies that we should have discerned that Ground 2 actually is two separate grounds, a two-reference ground (Peterson and Fireman) for claims 18–22 and either a separate three-reference ground or a different two-reference ground (Guan ’797 and Fireman) for claim 30. Reh’g Req. 2, 4.

In what Petitioner calls “a general discussion of motivation to combine *Guan*” in the Petition (Reh’g Req. 4), Petitioner argued “Peterson and Guan 797 are virtually interchangeable in that each reference teaches various *design choices* that would have been obvious for one of ordinary skill in the art to combine.” Pet. 45 (emphasis added). Petitioner also asserted that the combination would have been obvious “for the reasons stated above” and referred to its reasons why one would combine Peterson and Fireman. See Institution Decision 20 (citing Pet. 46). Later, in specifically addressing claim 30, Petitioner asserted that Peterson did not “explicitly disclose” the floor being comprised of spaced apart layers—thus implying that Peterson implicitly disclosed such—and argued, *inter alia*, that it would have been an obvious *design choice* to use a multi-layer floor of Guan ’797. Pet. 59. In the same ground, Petitioner relied or currently relies upon: 1) reasons to combine only Fireman and Peterson (the “reasons stated above”), 2) on the interchangeability of Fireman and Guan, 3) the omission of Guan from the ground for some claims, and 4) either, for claim 30, the interchangeability of Fireman and Guan or the additive effect of Guan. We maintain our position that Ground 2 is confusing and that it is not clear

whether Petitioner is asserting, for the single ground, a two-reference combination with Guan as the primary reference or a two-reference combination omitting Guan or three-reference combination with Peterson as the primary reference. This is enough for us to conclude that Petitioner failed to establish that it is more likely than not that it would prevail in its challenge of Ground 2. We decline Petitioner's invitation to parse Ground 2 into multiple grounds.

III. ORDER

Accordingly, it is:

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

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