

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELEBRANDS CORP.,
Petitioner,

v.

TINNUS ENTERPRISES, LLC,
Patent Owner.

Case PGR2017-00024
Patent 9,533,779 B2

Before MICHAEL W. KIM, FRANCES L. IPPOLITO, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

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

I. INTRODUCTION

Telebrands Corp. (“Petitioner”) filed a Request for Rehearing (“Rehearing Request” or “Request”) of our Decision Denying Institution (“Decision” or “Dec.,” Paper 15), which denied institution of a post-grant review. Paper 16 (“Req. Reh’g”). For the reasons given below, we *deny* the Rehearing Request.

II. LEGAL STANDARD

When rehearing a decision whether to institute post-grant review, we review the decision for an “abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing [the] decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). 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” the briefing. *Id.*

III. ANALYSIS

Petitioner argues that rehearing should be granted for three primary reasons. We address each of the three arguments in turn.

First, Petitioner asserts that, in exercising our discretion under 35 U.S.C. § 325(d) to deny institution of a post-grant review, we overlooked or misapprehended Dr. Kamrin’s detailed testimony, which Petitioner argues was not before the Examiner. Req. Reh’g 2–3, 6. Petitioner adds that our Decision failed to consider Dr. Kamrin’s testimony that mechanical actuation is not required to release Donaldson’s balloon. *Id.* at 6–7. According to Petitioner, this is because a person of ordinary skill in the art, “looking at Donaldson’s figures, alone, would understand the balloon

detaches due to a force exerted on the balloon **before** the balloon breaks.” *Id.* at 7 (citing Ex. 1020 ¶ 88). Additionally, Petitioner contends that “there is no indication that the Examiner considered the teaching in Donaldson’s figures, alone, and the corresponding inherency argument, as explained by Dr. Kamrin, during prosecution of the ’779 patent.” *Id.* at 8.

In our Decision Denying Institution, we reviewed and considered Dr. Kamrin’s testimony and Petitioner’s arguments presented in the Petition, but, ultimately, determined that the testimony and Petitioner’s arguments, as a whole, did not meaningfully distinguish the record from that present before the Examiner during prosecution. Dec. 8–14. As stated in the Decision, we considered Dr. Kamrin’s testimony, including his testimony regarding Donaldson’s disclosure (e.g., Figures 2–5). Dec. 12–13. Moreover, in our Decision, we discussed at length the Examiner’s review of the prior art of record, including Donaldson, during the prosecution of the ’779 patent. Dec. 10–14. In doing so, we explained that the Examiner considered the same exact issue, presented in the Petition, of whether the prior art references of record in prosecution (including Donaldson) expressly or inherently disclosed the “elastic ring” recited in the challenged claims. *Id.* at 12 (citing Ex. 1008, 87–88); *see* Ex. 1008, 87 (“Because it is not true that all elastic bands have the same elastic force as an inherent property, it cannot be presumed that all elastic bands would function the same way.”). More specifically, we noted that the Examiner reviewed and considered the Donaldson reference, and determined that “[n]one of the prior art teaches the subject matter” of the claimed “elastic ring.” Dec. 11; Ex. 1008, 87.

Petitioner does not dispute that the Examiner reviewed Donaldson, or contend that the Examiner reviewed Donaldson without looking at the

figures in Donaldson. *See, generally* Req. Reh’g. Indeed, Petitioner has not directed us to anything in the record that suggests, as Petitioner proposes, the Examiner failed in his review to consider adequately or comprehend Donaldson’s figures or written description. As such, we are not persuaded that we misapprehended or overlooked this purported difference between Dr. Kamrin’s testimony and the prosecution history, because the prosecution record reflects, as we determined in our Decision, that Dr. Kamrin and the Examiner reviewed the same reference and considered essentially the same or substantially the same issue of whether Donaldson expressly, or inherently, discloses the claimed elastic ring. *See* Ex. 1020 ¶ 88; Ex. 1008, 87.

Second, Petitioner argues that we should not have relied on the Examiner’s consideration of Petitions from PGR2016-00030 and PGR2016-00031, because those post-grant reviews involve different functional requirements for the elastic fastener than those at issue in the ’779 patent. Req. Reh’g. at 8–9. Petitioner further asserts that the Board previously did not exercise discretion under § 325(d) on the basis that the claim limitations in PGR2015-00018 were different, and that the “same result should follow here.” *Id.* at 9. To start, we disagree with Petitioner that our Decision not to exercise § 325(d) discretion in one case is binding on all other related cases. Most prominently, the specific record in the instant case differs from that in PGR2016-00030 and PGR2016-00031. For example, the ’779 patent had not issued when the Petitions in PGR2016-00030 and PGR2016-00031 were filed, thus, the Examiner had the opportunity to review those Petitions in the context of his consideration of Donaldson and the other prior art references of record during the prosecution of the ’779 patent. *See* Ex. 1008, 24–26.

Further, our Decision does not rely solely on the Examiner's review of the Petitions in PGR2016-00030 or PGR2016-00031, but takes into account the particular facts before us, including Dr. Kamrin's testimony and the Examiner's consideration of Donaldson, and our own review of the obviousness arguments based on Saggio and Donaldson presented in the Petitions for PGR2016-00030 and PGR2016-00031. Dec. 8–13; Ex. 1008, 87; *see* PGR2016-00031, Paper 2, 65–66. As such, we are not persuaded that we misapprehended or overlooked any differences (e.g., difference in claim language) between the instant case and PGRs2016-00030 and -00031.

Third, Petitioner argues that denying institution “would not promote patent quality . . . where three PGRs have been instituted based on the same or substantially the same prior art combinations for claims that are patentably indistinct.” Req. Reh’g. 12. Petitioner adds that “[e]ach related patent includes claims that are nearly identical to one another, so Petitioner has had no choice but to file serial petitions for post grant review.” *Id.*

Petitioner's arguments are not persuasive. Although Petitioner argues that the claims are “patently indistinct” or “nearly identical to one another,” Petitioner also acknowledges that the claims at issue in the various post-grant reviews recite different functional limitations. *Id.* at 8–9. Moreover, as we discussed previously, the record for the instant proceeding (PGR2017-00024) differs from that in, at least, PGR2016-00030 and PGR2016-00031. For example, as noted in our Decision, the record indicates that the Examiner expressly considered the art and arguments presented in the Petitions of PGR2016-00030 and PGR2016-00031 during prosecution of the '779 patent. Dec. 11. Thus, on these facts, we are not persuaded that our previous § 325(d) determinations in related proceedings must necessarily be

binding here, and, further, do not agree that we erred in accounting for the specific prosecution history of the '779 patent, and the particular record for this proceeding, in determining whether to exercise our discretion under § 325(d) here.

IV. CONCLUSION

Petitioner has not carried its burden of demonstrating that the Board misapprehended or overlooked any matters in the Decision Denying Institution. 37 C.F.R. § 42.71(d). Accordingly, the Request is *denied*.

V. ORDER

In consideration of the foregoing, it is hereby:

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

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