

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

McCLINTON ENERGY GROUP, LLC
Petitioner

v.

MAGNUM OIL TOOLS INTERNATIONAL, Ltd.
Patent Owner

Inter Partes Review No. IPR2013-00231
Patent No. 8,079,413

**PATENT OWNER'S REQUEST FOR REHEARING
UNDER 37 C.F.R. § 42.71(d)**

TABLE OF CONTENTS

1.0 INTRODUCTION	1
2.0 LEGAL STANDARDS	1
3.0 ARGUMENTS	2
3.1 The Final Written Decision is clearly unreasonable because Patent Owner had no opportunity to address the underlying facts the Decision is based on	3
3.2 The Final Written Decision depends upon facts that are not within the record	5
3.3 The Final Written Decision is based on clearly erroneous fact findings because it misapprehended or overlooked the missing claim limitation of an insert adapted to receive or engage a setting tool that enters the first end of the body, as required in Claims 1-16.....	7
3.4 The Final Written Decision is not supported by "substantial evidence"	11
4.0 CONCLUSION	12

TABLE OF AUTHORITIES

CASES

Eli Lilly & Co. v. Board of Regents of the University of Washington, 334 F.3d 1264
 (Fed. Cir. 2003) 2

In re Kronig, 539 F.2d 1300 (C.C.P.A. 1976) 3

In re Leithem, 661 F.3d 1316 (Fed. Cir. 2011)..... 3

In re Moore, 444 F.2d 572 (C.C.P.A. 1971)..... 3

In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001) 6

K/S Himpp v. Hear-Wear Technologies, LLC, 751 F.3d 1362 (Fed. Cir. 2014) 6

KSR International Co. v. Teleflex Inc., 550 U.S. 398 (2007) 4

PerfectWeb Technologies, Inc. v. InfoUSA, Inc., 587 F.3d 1324 (Fed. Cir. 2009) .. 7

Primera Technology, Inc. v. Automatic Manufacturing Systems, Inc.,
 IPR2013-00196, Paper No. 52 (August 29, 2014) 7

Stevens v. Tamai, 366 F.3d 1325 (Fed. Cir. 2004) 2

REGULATIONS

37 C.F.R. § 42.71(c) 1

37 C.F.R. § 42.71(d)..... 1

...

Pursuant to 37 C.F.R. § 42.71(d), Patent Owner Magnum Oil Tools International, Ltd. ("Patent Owner") hereby submits the following Request for Rehearing in response to the Final Written Decision dated September 2, 2014.

1.0 Introduction

On September 23, 2013, the Board instituted trial on claims 1-20 of the '413 Patent based on a combination of *Lehr*, *Cockrell*, *Kristiansen*, *Slup*, *Streich*, and *McKeachnie*. *Decision on Petition*, Paper No. 16. On September 2, 2014, the Board issued a Final Written Decision finding claims 1-20 unpatentable over the asserted prior art.

Patent Owner respectfully requests a rehearing on the Board's Final Written Decision because (i) the Board failed to allow Patent Owner an opportunity to respond to arguments not of record, (ii) the Final Written Decision depends upon evidence that does not exist in the record before the Board, (iii) the Board misapprehended or overlooked at least one limitation missing from the asserted prior art that is required in claims 1-16, and (iv) the Board's factual findings are not supported by substantial evidence.

2.0 Legal Standards

Review of a final decision is for an abuse of discretion. 37 C.F.R. § 42.71(c). "An abuse of discretion occurs where the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law;

(3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision." *Stevens v. Tamai*, 366 F.3d 1325, 1329 (Fed. Cir. 2004) (quoting *Eli Lilly & Co. v. Board of Regents of the University of Washington*, 334 F.3d 1264, 1266-67 (Fed. Cir. 2003)).

3.0 Arguments

The Final Written Decision is unreasonable because it denied the Patent Owner an opportunity to respond to arguments not of record.

The Decision also rests on clearly erroneous fact findings because it relied on a record that contains no evidence to support its conclusion that "the simple substitution of shearable threads, as taught by Cockrell (Ex. 1005, 5:43-47, 54-60), for the retaining pins 31 that secure the deformable release device 30, as taught by Lehr (Ex. 1007 ¶ 44), would [] yield a predictable result."

The Decision also misapprehended or overlooked at least the claim limitation that the insert must be adapted to receive a setting tool ***that enters the body through the first end thereof***, that is required in claims 1-16.

Finally, the Board's Decision involves a record that contains no evidence on which the Board could rationally base its decision and thus is not supported by substantial evidence, as required by the Federal Circuit.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.