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Paper 27
Entered: August 29, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PNY TECHNOLOGIES, INC.
Petitioner

v.

PHISON ELECTRONICS CORP.
Patent Owner

Case IPR2013-00472[1]
Patent 7,518,879

Before KEVIN F. TURNER, STEPHEN C. SIU, and
RAMA G. ELLURU, *Administrative Patent Judges.*

TURNER, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. §§ 42.71

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[1] Case IPR2014-00150 has been joined with this proceeding; Paper Numbers herein refer to documents in Case IPR2014-00150.

INTRODUCTION

Patent Owner Phison Electronics Corp. ("Phison") filed a Request for Rehearing (Paper 11, "Reh'g Req.") of the Decision on Institution (Paper 8, "Dec."), which instituted *inter partes* review of claims 1-21of Patent 7,518,879 (the '879 patent) in Case IPR2014-00150. Based on a joint motion for joinder (Paper 7), we joined Case IPR2014-00150 with Case IPR2013-00472 (Paper 9). In its request, Phison argues essentially that the Board improperly relied upon its own speculation as to how a referenced device operates and improperly asserted that the patentee acted as its own lexicographer. The request for rehearing is *denied.*

ANALYSIS

When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined 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. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); and *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000).

Phison argues that to establish obviousness, all claim limitations must be taught or suggested by the prior art, and that we committed clear legal error by relying instead upon speculation regarding how the device described in Elbaz might work. Reh'g Req. 2-3. Phison takes issue with our finding that "[c]ertainly when the module in Elbaz is introduced between the guiding means 515 or ribs, it

is fastened securely in a position between the sides of the adaptor. The ribs secure its lateral position, and hold it securely in place." Dec. 14. Phison says that the opposite is true, since the module is beneath the guiding means, and Fig. 10C of Elbaz shows that the module is not held from the side, having gaps on both sides. Reh'g Req. 4. We do not agree.

Claims 1 and 9 recite, in part, "wherein said PCBA is fixed by means of pressing of said plurality of concave props," and the "plurality of concave props protrude inward to fix said PCBA," respectively. As we provided in the Decision, we stated that Elbaz "discloses that the adaptor receives module 5 through guiding means 515 that may be ribs and work in concert with a locking means to maintain the module in the inserted position. Dec. 10, citing Elbaz ¶ [0060]. While Phison argues that "Elbaz is silent how the lateral position of the module is secured, or *even if* the position, lateral, vertical or otherwise, is secured" (Reh'g Req. 4), the above cited section of Elbaz shows that to be incorrect. The guiding means do "fix the PCBA," per claim 9, and any friction between the guiding means and the module would also act, through those ribs, to fasten the module securely in position, per claim 1.

It is not mere speculation to understand that insertion of a module in Elbaz through the guiding means would involve contact and friction, for that is one purpose of the guiding means. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 421 (2007). Experience with physical objects need not be jettisoned from an obviousness analysis, even if not expressly cited in a reference. Additionally, while Phison asserts that Fig. 10C of Elbaz shows gaps on the sides of the module

(Reh'g Req. 4-5), we disagree with Phison that the totality of the disclosure therein suggests that the module is not constrained into its inserted position. We also do not agree that one of ordinary skill in the art, in view of Elbaz's disclosure, would view Fig. 10C as suggesting that the module is not "fixed." As such, we cannot agree with Phison that our analysis in the Decision, in response to Phison's arguments in the Preliminary Response, is not supported by substantial evidence.

Phison also argues that our Decision failed to adhere to the correct legal standard for claim construction and improperly asserted that the patentee acted as its own lexicographer. Reh'g Req. 6-11. Phison also argues that because the '879 Patent provides no express intent to impart a novel meaning to the term "concave," we improperly indicated that patentee acted as its own lexicographer by applying the wrong legal standard. Reh'g Req. 7-8. We do not agree.

Phison acknowledges that"[t]he '879 Patent clearly shows a prop that is both concave and that has a *non-concave surface* propping the PCBA. In other words, the term 'concave' describes a different aspect of the props than their propping surface." Reh'g Req. 10 (emphasis added). As discussed above, claim 1 recites, in part, that the "PCBA is fixed by means of pressing of said plurality of concave props," such that the form recited in that claim requires that its "propping surface" is what exerts the pressure. Phison's position acknowledges that the "concave" aspect of the prop is merely a nonfunctional descriptive aspect of the prop. *See* M.P.E.P. § 2111.05.

While this does not imply that the "concave" aspect should be given no patentable weight, see, e.g., *In re Gulack,* 703 F.2d 1381, 1385 (Fed. Cir. 1983), it does run counter to Phison's assertion that "the '879 Patent shows and describes

the concave props in a manner comporting with the ordinary meaning of the term [concave]." Reh'g Req. 10. To refer to a prop as a concave prop when no *functional* part of the "prop" is concave would not comport with its plain, ordinary meaning.

> [T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997). We acknowledge that the Decision construed "concave" not according to its customary and ordinary meaning, but rather according to how it is used in the specification and claims of the '879 Patent. We adopted a portion of Phison's proposed interpretation of "concave" as "curving inwards," such that the claimed prop may not have *any* topology, like a cube, for example, and needs to have a curving aspect. Dec. 6. Additionally, as we discussed in the Decision, it would be improper to incorporate the method of making such props into a claim directed to an article of manufacture, i.e., a USB memory plug. Dec. 7. As such, we do not agree with Phison that our Decision failed to adhere to the correct legal standard for claim construction.

For the forgoing reasons, Phison has not shown that the Board abused its discretion in instituting the ground of claims 1-21 as unpatentable under 35 U.S.C. § 103 over combinations of Elbaz, Deng and Admitted Art.

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