

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FINISAR CORP.,
Petitioner,

v.

THOMAS SWAN & CO. LTD.,
Patent Owner.

Case IPR2014-00460
Patent 7,145,710 B2

Before SALLY C. MEDLEY, MICHELLE R. OSINSKI, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

OSINSKI, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Finisar Corp. (“Petitioner”) requests reconsideration of the Board’s Decision (Decision—Institution of *Inter Partes* Review, Paper 9) (hereinafter “Decision”) not to institute *inter partes* review of claims 3 and 10 on the ground of anticipation by US 2001/0050787 A1 (published Dec. 13, 2001) (“Crossland,” Ex. 1010).
Reh’g Req. 2. We have considered Petitioner’s request, but decline to modify the Decision to not institute *inter partes* review of claims 3 and 10 of U.S. Patent No. 7,145,710 B2 (Ex. 1001, “the ’710 patent”).

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 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); *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000). In its request for rehearing, the dissatisfied party must identify the matters believed to be misapprehended or overlooked by the Board and the place in the record where it previously addressed each matter it submits for review. 37 C.F.R. § 42.71(d). The challenging party bears the burden of showing that the decision should be modified. *Id.*

III. DISCUSSION

Petitioner argues that the Board misapprehended the construction of the claim term “resolving the respective generated holograms modulo 2π .” Reh’g

Req. 1, 2. Petitioner specifically points to the Board's statement that "Dr. Hall, however, points to thresholds in which δ_1 equals $-\pi/2$ and δ_2 equals $\pi/2$, not 2π ." Reh'g Req. 7 (citing Decision 34). Petitioner argues that this statement shows that the Board "mistakenly interpreted Dr. Hall's comment regarding the thresholds as relating to her conclusion that Crossland discloses 'resolving the generated holograms modulo 2π ,'" but that in actuality "[t]he discussion of thresholds relate to the quantization of the signal into its binary components, 0 and π and does not relate to resolving 'modulo 2π .'" Reh'g Req. 8.

Petitioner's challenge against the claimed step of "resolving the respective generated holograms modulo 2π " is thus based on its reproduction of ¶ 90 of Crossland and citation to ¶ 134 of the Declaration of Katherine Hall, Ph.D (Ex. 1003). Pet. 52-53. Paragraph 134 states in its entirety that:

A PHOSITA would have understood that Crossland '787 discloses the element "resolving the respective generated holograms modulo 2π ." Crossland '787 discloses a technique of displaying a hologram by using a FLC SLM to generate a binary phase hologram. Crossland '787 further discloses that the binary phase is selected from the phase only hologram by two thresholds, δ_1 and δ_2 , and also that a safe threshold that provides consistent results is $\delta_1 = -\pi/2$ and δ_2 equals $\pi/2$.

Ex. 1003 ¶ 134 (quoting Ex. 1001, 62:27; citing Ex. 1010 ¶ 90).

Petitioner has not explained adequately in its Petition how the claimed step of "resolving the respective generated holograms modulo 2π " is found expressly, implicitly, or inherently in Crossland. The Petition relied on the conclusory statement by Dr. Hall that one of skill in the art simply would have understood ¶ 90 of Crossland to disclose resolving the respective generated holograms modulo 2π (Ex. 1003 ¶ 134), but did not provide any accompanying explanation other than the reference to the thresholds, which Petitioner notes did not relate to resolving modulo 2π . Reh'g Req. 8. The Board's Decision was not based on an erroneous

conclusion of law relating to the construction of the claim term “resolving . . . modulo 2π ,” but rather on Petitioner’s failure to sufficiently demonstrate that claims 3 and 10 are unpatentable as anticipated by Crossland.

Petitioner also argues that the equation set forth in ¶ 90 of Crossland, i.e.,
$$H_{BPO} = \begin{cases} 0 & \delta_1 \leq \emptyset(u, v) \leq \delta_2 \\ \pi & \text{otherwise} \end{cases}$$
 “is more than sufficient to indicate to a person of ordinary skill in the art that the hologram disclosed by Crossland is resolved ‘modulo 2π .’” Reh’g Req. 9. Petitioner further explains that “[i]t is the rendered hologram, and not the thresholds, that have the binary values 0 and π which fall within a range of 0 to 2π , indicative of the fact that Crossland has a hologram resolved ‘modulo 2π .’” *Id.*; see also, e.g., *id.* at 10 (“[T]he Crossland hologram uses only the values of 0 and π , and does not include . . . values that are greater than or equal to 2π .”). While the Petition reproduces the equation set forth in ¶ 90 of Crossland (Pet. 53), the Petition includes only a conclusory statement that Crossland discloses resolving the respective generated holograms modulo 2π without any accompanying explanation of how the equation would be perceived by one of ordinary skill in the art. Pet. 52-53. While ¶ 134 of Exhibit 1003 (cited in the Petition) refers to generation of “a binary phase hologram,” it makes no mention of the values of the phase falling between 0 and 2π so as to explain Dr. Hall’s conclusory statement that one of ordinary skill in the art would understand Crossland to disclose the claimed step of resolving the generated holograms modulo 2π . The additional statements and explanation provided by Petitioner in its Request as to how Crossland’s equation demonstrates the claimed step of resolving modulo 2π were not previously presented in the Petition. We could not have overlooked or misapprehended explanations that were not presented in the Petition.

IV. CONCLUSION

For the reasons given, we determine that Petitioner has not carried its burden of demonstrating that the Board misapprehended or overlooked any matters requiring modification of the Decision. Based on the record before us at the time of entering the Decision, Petitioner did not explain adequately how Crossland discloses the claimed step of “resolving the respective generated holograms modulo 2π .”

V. ORDER

Accordingly, it is

ORDERED that Petitioner’s Request for Rehearing of the Decision that declined to institute *inter partes* review of claims 3 and 10 on the ground of anticipation by Crossland is *denied*.

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