

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL PLASTIC INDUSTRIAL CO., LTD.,
Petitioner

v.

CANON INC.,
Patent Owner

Case IPR2015-01954
Patent 8,909,094 B2

Before JAMESON LEE, THOMAS L. GIANNETTI, and HUNG H. BUI,
Administrative Patent Judges.

BUI, *Administrative Patent Judge.*

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

INTRODUCTION

General Plastic Industrial Co., Ltd. (“Petitioner”) filed a Request for Rehearing pursuant to 37 C.F.R. § 42.71(d) of the Board’s Decision (Paper 9, “Dec.”) declining to institute trial in this proceeding. Paper 10 (“Req. Reh’g.”). The Rehearing Request seeks rehearing of the Board’s Decision with respect to: (1) claims 1, 8, 9, 11, 17, 18, 29, and 38 of U.S. Patent No. 8,909,094 B2 (“the ’094 patent”) under 35 U.S.C. § 102(b) as anticipated by Matsuoka (Ex. 1006) and (2) claims 1, 7–9, 11, 16–18, 29 and 38 of the ’094 patent under 35 U.S.C. §103(a) as rendered obvious over Matsuoka (Ex. 1006). *See* Req. Reh’g 1.

In particular, Petitioner argues the Board: (1) “misapprehended or overlooked Federal Circuit caselaw that would allow the element-by-element anticipation analysis to be conducted on the multi-part composite structure formed when the toner cartridge 30 is engaged within Matsuoka’s copier” in the context of anticipation; and (2) “misapprehended or overlooked the structure and operation of the multi-part composite structure formed by disengaging the rotary power transmitting member 44 from the copier’s turning gear 47, and removing it along with, and still attached to, the toner cartridge 30” in the context of obviousness. *Id.* at 1–15.

We have reviewed Petitioner’s request for rehearing and carefully considered Petitioner’s arguments and cited authorities. However, we are not persuaded that the Board misapprehended or overlooked Petitioner’s arguments presented with respect to the patentability of claims 1, 7–9, 11, 16–18, 29 and 38 of the ’094 patent or the cited authorities.

DISCUSSION

First, Petitioner asserts the Board erred because we “inferentially construed independent claims 1, 11, 29, and 38 of the ’094 patent to require that the recited sealing member must be of a one-piece or inseparable construction.” *Id.* at 2 (citing Dec. 19). According to Petitioner, (1) “[t]he plain meaning of the challenged claims does not require the sealing member to be of one-piece or inseparable construction” (*id.*); (2) the ’094 patent specification describes the sealing member as being manufactured through an injection molding or assembled from a plurality of separate parts (*id.* at 2–3 (citing Ex. 1001, 13:49–53)); and (3) the doctrine of claim differentiation precludes a construction of the challenged claims that requires the sealing portion and the coupling portion to be integrally molded, which would result in a one-piece sealing member (*id.* at 5).

Contrary to Petitioner’s assertion, we did not inferentially construe the challenged claims “to require that the recited sealing member must be of a one-piece or inseparable construction.” *See* Req. Reh’g 2–5. As explained in the Decision, we found that Matsuoka’s toner cartridge 30 contains only (1) container main body 31 provided with opening 312, and (2) fixed cover 32 including opening/closing cover 33. Dec. 19 (citing Ex. 1006, 7:22–30, Fig. 4(d)). Matsuoka’s toner cartridge 30 does not include rotary power transmitting member 44, which is a fixed part of Matsuoka’s copier’s developing agent replenishing apparatus 40 and is merely engageable “on a detachable basis” only when Matsuoka’s toner cartridge 30 is inserted into Matsuoka’s copier’s developing agent replenishing apparatus 40. *Id.* at 19

(citing Ex. 1005, Fig. 6, 7:53–8:7).

Because rotary power transmitting member 44 is part of Matsuoka’s copier’s developing agent replenishing apparatus 40, we were not sufficiently persuaded that Matsuoka’s “integrally combined fixed cover 32 and rotary power transmitting member 44” can be said to meet the “sealing member” recited in the challenged claims as a part of the “toner supply container.” *Id.* at 20.

Second, Petitioner asserts:

That is, the Board overlooked that so-called “part time” anticipation is legally sufficient to invalidate a product claim. See *Alza Corp. v. Mylan Labs., Inc.*, 388 F. Supp.2d 717, 735 (N.D. W.V. 2005), *aff’d on other grounds*, 464 F.3d 1286, 1289 (Fed. Cir. 2006); *Hazani v. U.S. Int’l Trade Comm’n*, 126 F.3d 1473, 1477 (Fed. Cir. 1997); see also *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003) (part-time anticipation of method claim).

Req. Reh’g 5–6. Petitioner further relies on *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) for the legal proposition that “[a] reference may be from an entirely different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims.” *Id.* at 7.

We are uncertain as to what Petitioner regards as “‘part-time’ anticipation” or the relevancy of *In re Schreiber*. The alleged principle of “‘part time’ anticipation” is not articulated clearly either in the Petition or the Rehearing Request. We have reviewed each of the above-cited cases,

including *In re Schreiber*, and find nothing that would aid the Petitioner. For instance, none of these cases stands for the proposition: If element A gets attached to element B at some times during use of element A, element B can be regarded as a component of element A. Thus, the fact that Matsuoka’s toner cartridge 30, at some time during its use, is attached to rotary power transmitting member 44 of the copier provides no justification to regard member 44 of the copier as a component of Matsuoka’s toner cartridge 30.

Third, Petitioner asserts the Board erred because we declined to adopt Petitioner’s proffered claim construction of the phrase “the opening [of container body] becoming unsealed by relative movement of the sealing member and the container body away from one another” recited in the challenged claims. Req. Reh’g 9–13 (citing Dec. 20–22). However, the Petitioner’s proffered construction is predicated upon the so-called “part-time” anticipation doctrine as discussed above.

Lastly, Petitioner asserts the Board “misapprehended Petitioner’s obviousness argument to be limited to combining Matsuoka’s fixed cover 32 and rotary power transmitting member 44 as a single-piece construction.” Req. Reh’g 13–15 (citing Dec. 23–26). According to Petitioner, “a person of ordinary skill would have recognized that the toner cartridge 30 can be withdrawn from the copier with the rotary power transmitting member 44 still attached to the fixed cover 32” and “this composite structure satisfies all of the limitations” of the challenged claims. *Id.* at 14 (citing Pet. 57; Ex. 1007 at ¶¶ 62–63, 72–73). However, we did not misapprehend or overlook

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