

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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KOITO MANUFACTURING CO., LTD,  
Petitioner,

v.

ADAPTIVE HEADLAMP TECHNOLOGIES, INC.,  
Patent Owner.

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Case IPR2016-00079  
Patent 7,241,034 C1

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Before MICHAEL P. TIERNEY, RAMA G. ELLURU, and  
SCOTT C. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Petitioner has filed a Request for Rehearing (Paper 13; “Req. Reh’g”) of the Board’s Decision on Institution (Paper 11; “Dec.”) denying *inter partes* review of claims 33 and 34 of U.S. Patent No. 7,241,034 (Ex. 1001; “the ’034 Patent”). In the Decision, we determined that the information presented in the Petition does not demonstrate a reasonable likelihood that Petitioner would prevail with respect to claims 33 and 34. *See* Dec. 31–33; 35 U.S.C. § 312(a). In particular, we found that the Petition does not persuasively demonstrate “that Okuchi teaches or suggests a controller ‘programmed to be responsive to changes in a suspension height of the vehicle *that occur at frequencies lower than a suspension rebound frequency of the vehicle,*’ as recited in claims 33 and 34.” Dec. 32 (emphasis added).

As we noted in the Decision, the Petition does not identify any specific teaching or suggestion in Okuchi of the “frequencies lower than a suspension rebound frequency of the vehicle” limitation of claims 33 and 34 (the “suspension rebound frequency” limitation). *See* Dec. 32–33. Petitioner made a general argument that Okuchi performs “filtering . . . so as to remove high frequency components of a vibration”; but Petitioner never specifically addressed the suspension rebound frequency limitation. *See* Pet. 50–51. Similarly, Dr. Wilhelm testified in his Declaration that it would have been obvious to filter out “high frequency components of a vibration”; but, Dr. Wilhelm did not specifically address the suspension rebound frequency limitation. Ex. 1019, ¶¶ 95 (claim chart), 99; *see* Dec. 32–33.

## II. ANALYSIS

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides:

A party dissatisfied with a decision may file a single request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

Petitioner first argues that we abused our discretion by improperly construing claims 33 and 34 to require “filtering out ‘frequencies lower than a suspension rebound frequency of the vehicle.’” *See* Req. Reh’g 3–4. Petitioner’s assertion is incorrect. Our Decision did not construe the suspension rebound frequency claim limitation. *See* Dec. 7. Our discussions of “filtering” were references to Petitioner’s own arguments concerning claims 33 and 34. For example, when discussing claim 33, Petitioner argued that Okuchi’s system performs “*filtering* . . . so as to remove high frequency components of a vibration at the time of driving.” Pet. 49–50 (emphasis added). We noted in our Decision that “Petitioner . . . has not identified any teaching or suggestion in Okuchi of filtering out ‘frequencies lower than a suspension rebound frequency of the vehicle.’” Dec. 32. This statement does not construe claim 33 to require “filtering.” It merely points out that Petitioner’s “filtering” argument, even if true, does not address the suspension rebound frequency claim limitation. *See id.* Petitioner’s Rehearing Request also provides additional arguments and

citations to evidence to demonstrate that Okuchi allegedly teaches or suggests the suspension rebound frequency limitation of claims 33 and 34. *See* Req. Reh’g 5–6. We could not have “misapprehended or overlooked” these new arguments because Petitioner failed to include them in its Petition. 37 C.F.R. § 42.71(d).

Petitioner also argues that we abused our discretion by overlooking the following sentence in the Petition:

The reexamination examiners also found that Okuchi disclosed the limitations of claims 30, 33 and 34. *See, e.g.*, Office Action of June 29, 2012 (KOITO 1005 at 1092-1095).

Pet. 50; *see* Req. Reh’g 6. This argument is not persuasive. A petition for *inter partes* review “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). Arguments “must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3). Thus, to carry its burden, Petitioner was required to specify *in the Petition* where the suspension rebound frequency limitation of claims 33 and 34 is allegedly found in the prior art. Petitioner, however, failed to present any specific arguments concerning the suspension rebound frequency limitation. Petitioner also failed to provide any discussion concerning evidence or arguments it previously presented to the Office regarding the suspension rebound frequency limitation. Petitioner’s citation to the June 29, 2012 Office Action did not operate to incorporate by reference arguments or evidence from the prior proceeding, and thus did not cure this deficiency. 37 C.F.R. §§ 42.104(b)(4), 42.6(a)(3).

Petitioner additionally argues that we abused our discretion by “[f]ailing to give proper weight, in the context of the institution standard, to the opinion of the only expert, Dr. Wilhelm, that Claims 33 and 34 are obvious.” Req. Reh’g 3. This argument is not persuasive because, as Petitioner concedes, “Dr. Wilhelm did not expressly discuss the claim language of frequencies lower than ‘a suspension rebound frequency of the vehicle.’” *Id.* at 7. It was Petitioner’s burden, at the institution stage, to “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). Dr. Wilhelm’s declaration never directly addresses the suspension rebound frequency limitation. Accordingly, the cited portions of Dr. Wilhelm’s declaration do not satisfy Petitioner’s burden.

Petitioner’s final argument is that we abused our discretion by “[f]ailing to give weight to Patent Owner’s waiver of reliance on any limitations of dependent Claims 33 and 34 in opposing institution.” Req. Reh’g 3. This argument also is not persuasive. The burden was on Petitioner to demonstrate a reasonable likelihood of prevailing as to the challenged claims. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.108(c). To meet this burden, Petitioner was required to “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). We denied institution as to claims 33 and 34 because Petitioner failed to provide a sufficient explanation of where the suspension rebound frequency limitation is found in the cited prior art. Patent Owner was not required to file a preliminary response. *See* 37 C.F.R. § 42.107(a). Thus, Patent Owner’s failure to address the suspension rebound frequency limitation at the institution stage did not act as a waiver.

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