

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL PLASTIC INDUSTRIAL CO., LTD.,
Petitioner,

v.

CANON KABUSHIKI KAISHA,
Patent Owner.

Case IPR2016-01357 (Patent 9,046,820 B1)¹
Case IPR2016-01358 (Patent 9,046,820 B1)
Case IPR2016-01359 (Patent 8,909,094 B2)
Case IPR2016-01360 (Patent 8,909,094 B2)
Case IPR2016-01361 (Patent 8,909,094 B2)

Before DAVID P. RUSCHKE, *Chief Administrative Patent Judge*,
SCOTT R. BOALICK, *Deputy Chief Administrative Patent Judge*, and
JAMESON LEE, MICHAEL R. ZECHER, THOMAS L. GIANNETTI,
JENNIFER S. BISK, and SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Requests for Rehearing
37 C.F.R. § 42.71(d)

¹ These proceedings have not been joined or consolidated. Rather, because of the presence of common issues and the involvement of the same parties, we enter one Decision on Rehearing for these identified proceedings.

IPR2016-01357 (Patent 9,046,820 B1)
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IPR2016-01361 (Patent 8,909,094 B2)

I. INTRODUCTION

General Plastic Industrial Co., Ltd., (hereafter “Petitioner”) filed respective Requests for Rehearing of each of the Decisions Denying Institution of *inter partes* review in the following five related proceedings: (1) IPR2016-01357; (2) IPR2016-01358; (3) IPR2016-01359; (4) IPR2016-01360; and (5) IPR2016-01361.² In each Request for Rehearing, Petitioner contends that the corresponding Decision Denying Institution should be withdrawn, and *inter partes* review should be instituted. Also, in each Request for Rehearing, Petitioner requests that the panel on rehearing be expanded.

For purposes of this Decision on Rehearing, we treat the Request for Rehearing in IPR2016-01357 as representative, and specifically discuss the circumstances of that request. This discussion, however, equally applies to all the Requests for Rehearing. For ease of reference, unless otherwise indicated, all citations are to filings in IPR2016-01357, including the Request for Rehearing (“Req. Reh’g”) and the Decision Denying Institution (“Dec.”). Where appropriate, we add specific discussions pertaining to the other proceedings.

To summarize, and as discussed further below, Petitioner filed a first set of petitions seeking *inter partes* review of U.S. Patent No. 9,046,820 B1 (“the ’820 patent”) and U.S. Patent No. 8,909,094 B2 (“the ’094 patent”). For each petition, institution of a trial was denied based upon the merits. Nine months after the filing

² The Decisions Denying Institution are listed as follows: IPR2016-01357 (Paper 16); IPR2016-01358 (Paper 12); IPR2016-01359 (Paper 12); IPR2016-01360 (Paper 12); and IPR2016-01361 (Paper 12). The Requests for Rehearing are listed as follows: IPR2016-01357 (Paper 17); IPR2016-01358 (Paper 13); IPR2016-01359 (Paper 13); IPR2016-01360 (Paper 13); and IPR2016-01361 (Paper 13).

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of the first set of petitions, Petitioner filed follow-on petitions against the same patents. For each of those follow-on petitions, we exercised our discretion not to institute pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a).

Petitioner alleges that trials should have been instituted on the follow-on petitions because a petitioner is not limited to filing just one petition per challenged patent under either 35 U.S.C. § 311 or § 314. Req. Reh’g 5. Petitioner also argues that we should not have relied on § 314(a), which, according to Petitioner, does not apply to the later petitions, and that we should have performed our analysis under 35 U.S.C. § 325(d). *Id.* at 5–7, 13–14. Furthermore, Petitioner alleges that in our analysis, we misapplied the factors set forth in the Board’s *NVIDIA*³ decision. Specifically, Petitioner contends that: (1) the factor of the limited one-year time period for issuing a final written decision should be afforded additional, if not dispositive, weight in light of the legislative history; (2) we abused our discretion by requiring that the prior art “should have been known” at the time the initial petitions were filed; and (3) we erred in considering potential prejudice to Patent Owner because the *NVIDIA* decision does not list such a factor. *Id.* at 6–13. Petitioner also requests that an expanded panel be designated. *Id.* at 14–15.

For the reasons that follow, we *deny* Petitioner’s Requests for Rehearing.

³ *NVIDIA Corp. v. Samsung Elec. Co.*, Case IPR2016-00134 (PTAB May 4, 2016) (Paper 9) (hereinafter, “*NVIDIA*”).

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II. DISCUSSION

A. *Requests for an Expanded Panel*

Our governing statutes and regulations do not permit parties to request, or panels to authorize, an expanded panel. *See generally* 35 U.S.C. § 6; 37 C.F.R. §§ 41.1–42.412; *see also AOL Inc. v. Coho Licensing LLC*, Case IPR2014-00771, slip op. at 2 (PTAB Mar. 24, 2015) (Paper 12) (“[P]arties are not permitted to request, and panels do not authorize, panel expansion.”). Our standard operating procedures, however, provide the Chief Judge with discretion to expand a panel to include more than three judges. PTAB SOP 1, 1–3 (§§ II, III) (Rev. 14); *see id.* at 1 (introductory language explaining that the Director has delegated to the Chief Judge the authority to designate panels under 35 U.S.C. § 6); *see also In re Alappat*, 33 F.3d 1526, 1532 (Fed. Cir. 1994) (providing that Congress “expressly granted the Commissioner the authority to designate expanded Board panels made up of more than three Board members.”). The Chief Judge may consider panel expansions upon a “suggestion” from a judge, panel, or party in a post-grant review. *Id.* at 3–4; *see also Apple Inc. v. Rensselaer Polytechnic Inst.*, Case IPR2014-00319, slip op. at 2 n.1 (PTAB Dec. 12, 2014) (Paper 20) (expanded panel) (per curiam).

The standard operating procedure exemplifies some of the reasons for which the Chief Judge may expand a panel. PTAB SOP 1, 3 (§ III.A). For example, an expanded panel may be appropriate when “[t]he proceeding or AIA Review involves an issue of exceptional importance.” *Id.* (§ III.A.1).

In these cases, the Chief Judge has considered whether expansion is warranted, and has decided to expand the panel due to the exceptional nature of the

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issues presented.⁴ As we discuss further below, follow-on petitions have been at issue in multiple cases before the Board. The Chief Judge has determined that an expanded panel is warranted to provide a discussion of factors that are considered in the exercise of the Board's discretion under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a).

B. Requests for Rehearing

A party requesting rehearing has the burden to show a decision should be modified by specifically identifying all matters the party believes were misapprehended or overlooked, and the place where each matter was addressed previously in a motion, opposition, or a reply. 37 C.F.R. § 42.71(d). When rehearing a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise 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. United States*, 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).

We present background on the cases below, and then address the arguments made by Petitioner in the Requests for Rehearing.

⁴ As provided for in the standard operating procedure, and considering the commonality of issues considered here, the Judges on the initial panels in all the cases at issue have been designated as part of the expanded panel, and the Chief Judge and Deputy Chief Judge have been added to the panel. PTAB SOP 1, 4 (§ III.E).

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