

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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REACTIVE SURFACES LTD., LLP,  
Petitioner,

v.

TOYOTA MOTOR CORPORATION,  
Patent Owner.

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Case IPR2016-01462  
Patent 8,324,295 B2

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Before CHRISTOPHER M. KAISER, JEFFREY W. ABRAHAM, and  
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION  
Request for Rehearing  
*37 C.F.R. § 42.71(d)*

## INTRODUCTION

Reactive Surfaces Ltd., LLP (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–27 of U.S. Patent No. 8,324,295 B2 (Ex. 1001, “the ’295 patent”). Toyota Motor Corporation (“Patent Owner”) filed a Preliminary Response (Paper 10, “Prelim. Resp.”). On February 9, 2017, we instituted trial to determine whether claims 1–9, 13–20, and 22–27 are unpatentable as obvious. Paper 14 (“Dec.”); *see* Paper 16 (correcting list of claims on which trial was instituted). We did not institute trial on claims 10–12 or 21, because we determined that Petitioner did not demonstrate “a reasonable likelihood that the petitioner would prevail with respect to” those claims, as required by 35 U.S.C. § 314(a). Dec. 18–19, 23–24. Petitioner now requests rehearing of our decision not to institute trial on claims 10–12 and 21. Paper 21 (“Request”).

We will grant a request for rehearing of a petition decision if the requesting party demonstrates “an abuse of discretion” in the decision. 37 C.F.R. § 42.71(c). However, we will grant a request for rehearing only if that party also “specifically identif[ies] . . . the place where each matter [that we misapprehended or overlooked] was previously addressed.” *Id.* § 42.71(d). After considering Petitioner’s request for rehearing, our decision, and the evidence currently of record, we determine that Petitioner has not demonstrated an abuse of discretion. Accordingly, we deny the request for rehearing.

## ANALYSIS

Claims 10–12 and 21 of the ’295 patent each recite a limitation requiring the presence of a UV absorber chosen from the following Markush group: “C7-9 ester of [3-2hbenzotriazol-2-yl)-5-(1,1-dimethylethyl)-4-

hydroxyphenyl)]-propionic acid; 2-(2H-benzotriazol-2-yl)-4,6-ditertpentylphenol; 2-(1-methyl-1-phenylethyl)-4-(1,1,3,3-tetramethylbutyl)-6-(benzotriazol-2-yl)phenol; methyl 3-[3-(benzotriazol-2-yl)-5-tert-butyl-4-hydroxyphenyl]propanoate; or 2-(4-Benzoyl-3-hydroxyphenoxy)ethyl acrylate.” Ex. 1001, 24:3–10, 24:46–53. Petitioner argued in the Petition that these claims were obvious over the combination of McDaniel ’853 and Fritzsche in part because (1) Fritzsche teaches the use of a commercial product called Tinuvin 384, (2) Tinuvin 384 has “the same active chemical composition as” Tinuvin 384-2, and (3) an unspecified one of the members of the Markush group recited in claims 10–12 and 21 is Tinuvin 384-2. Pet. 59–61. We found Petitioner’s arguments insufficient to show a reasonable likelihood that Petitioner would prevail in showing that the prior art teaches or suggests the use of one of the members of the Markush group. Dec. 18–19. Although we agreed that Petitioner had directed us to sufficient record evidence to support its arguments that Fritzsche taught the use of Tinuvin 384 and that Tinuvin 384-2 was one of the members of the Markush group, we determined that Petitioner had not “identif[ied] sufficient record evidence to support its argument that Tinuvin 384 and Tinuvin 384-2 have the same active chemical composition.” *Id.*

Petitioner now argues that we “overlooked evidence sufficiently identified in the Petition supporting [Petitioner’s] argument that Tinuvin 384 and Tinuvin 384-2 have the same active chemical composition and that . . . this would have been known to a person of ordinary skill in the art.” Request 8–9. Specifically, Petitioner argues that we overlooked a citation in the Petition to evidence that establishes the chemical structure of Tinuvin 384 and that we failed to compare this established chemical structure to the

chemical structure of Tinuvin 384-2. *Id.* at 6–8 (citing Pet. 51; Ex. 1010, 79:13–14).

We are not persuaded that we overlooked this evidence. Instead, Petitioner did not bear its burden to direct us to this evidence. Petitioner presented the relevant discussion of the asserted unpatentability of claims 10–12 and 21 on pages 59–61 of the Petition. On these pages, Petitioner offered no support by citing Exhibit 1010, or any other record evidence, for its argument that “[a] POSITA will recognize that TINUVIN® 384 is well known to have the same active chemical composition as TINUVIN® 384-2.” Pet. 60. Petitioner argues now that, despite such failure to offer any support in the vicinity of its statement, the Board should have realized that Petitioner offered support for the statement nine pages earlier, on page 51 of the Petition. This argument fails to recognize Petitioner’s burden to “specify where each element of the claim is found in the prior art patents or printed publications relied upon [to show unpatentability].” 37 C.F.R.

§ 42.104(b)(4). It is Petitioner’s job, not the Board’s, to explain why the prior art renders the challenged claims unpatentable. Accordingly, the mere fact that the Petition made an argument and also offered some evidentiary support for that argument is, in the absence of any connection drawn in the Petition between the argument and the support, irrelevant to the question of whether the Board abused its discretion by overlooking the support.

In any event, the “support” to which Petitioner now directs us is a string citation to 16 separate portions of Fritzsche, presented as support for the generic statement that Fritzsche “teaches . . . polymer resin, a surfactant, a non-aqueous organic solvent, a sterically hindered amine, and a UV absorber and a crosslinker to produce a curable material composition.” Pet.

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51 (citing Ex. 1010, 77:27–28, 78:5–6, 77:34, 78:11, 77:30, 79:6, 78:13, 79:5, 77:29, 78:8, 29:18–19, 30:19–20, 31:1–3, 77:29, 78:8, 79:13–14).

Petitioner fails to explain why the Board should have recognized from the generic statement—which does not mention Tinuvin 384 or Tinuvin 384-2—that one of the 16 portions of the citation string might be relevant to the question of whether the two Tinuvin products have the same active chemical composition. When the Petition fails to explain the significance of certain record evidence, the Board does not abuse its discretion by failing to recognize the significance of that same evidence.

### CONCLUSION

Upon consideration of Petitioner’s request for rehearing, our decision, and the evidence currently of record, we determine that Petitioner has not demonstrated an abuse of discretion in our decision. Accordingly, we deny the request for rehearing.

### ORDER

It is hereby

ORDERED that the request for rehearing is denied.

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