

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

IMMERSION CORPORATION,  
Patent Owner.

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Case IPR2016-01777  
Patent 8,749,507 B2

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Before MICHAEL R. ZECHER, BRYAN F. MOORE, and MINN CHUNG,  
*Administrative Patent Judges.*

CHUNG, *Administrative Patent Judge.*

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

## I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Request for Rehearing (Paper 8, “Req. Reh’g”) of the Decision (Paper 7, “Dec.”), in which, based on the information presented in the Petition (Paper 1, “Pet.”), we denied institution of an *inter partes* review of claims 1–5, 9–12, and 14–17 of U.S. Patent No. 8,749,507 B2 (Ex. 1001, “the ’507 patent”). Petitioner contends that our Decision misapprehended the meaning of a key limitation and the disclosure of the asserted prior art. Req. Reh’g 1. For the reasons stated below, Petitioner’s Request for Rehearing is *denied*.

## II. STANDARD OF REVIEW

“The burden of showing a decision should be modified lies with the party challenging the decision,” and the challenging party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed” in a paper of record. 37 C.F.R. § 42.71(d). Because Petitioner seeks rehearing of our Decision denying the Petition, it must show an abuse of discretion. *See* 37 C.F.R. § 42.71(c) (“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.”). An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988).

## III. ANALYSIS

Petitioner contends that the Decision misconstrued the limitation we identified as the “determining a press limitation” (Dec. 11), i.e., the

limitation reciting “determining a press if: the pressure is greater than a pressure threshold, the change in pressure is greater than a change in pressure threshold, and a first interval has elapsed.” Req. Reh’g 2–3. Petitioner argues that we “found that ‘the first two conditions [recited in the “determining a press limitation”] must be maintained for the duration of the first interval.’” *Id.* (citing Dec. 5, 14–15). Petitioner asserts that our “*interpretation* [of the “determining a press limitation”] . . . is not supported by the specification, and improperly excludes from the scope of the claims” the embodiments purported described in the Specification. *Id.* at 4–6 (emphasis added). Petitioner further argues that our “*interpretation* would constitute an improper importation” of the features of exemplary embodiments into the claims. *Id.* at 6–7 (emphasis added).

Petitioner mischaracterizes our Decision. We did *not* expressly construe the “determining a press limitation” or *interpreted* the limitation to require the first two conditions recited in the limitation be maintained for the duration of a first interval. *See* Dec. 7–8. Rather, we found that, as illustrated in Figure 3 of the ’507 patent, “the meaning of the ‘first interval has elapsed’ condition as an integral part of the ‘determining a press limitation’ *may* be very different from its meaning in isolation.” *Id.* at 14–15 (emphasis added). We determined, based on the plain language of the claim limitation and the disclosure in the Specification, that the “determining a press limitation” recites a single concept of determining a press when all three conditions recited in the limitation are satisfied. *Id.* at 11–12. We found, therefore, a proper obviousness analysis must address the “determining a press limitation” as an integral whole, including the meaning

of the “first interval has elapsed” condition as a part of the “determining a press limitation,” and show how a reference or a combination of references teaches or renders the limitation as a whole obvious. *Id.* at 12, 14–15 (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007)). We found that the Petition did not present such an analysis. *Id.* at 12, 15.

Petitioner does not argue that it was erroneous for us to require such an analysis. Instead, Petitioner argues that, because the claims use the open-ended transitional phrase “comprising,” the broadest reasonable interpretation of the “determining a press limitation” “requires only that there be at least one scenario in which the satisfaction of [the three recited conditions] . . . results in a determination of a press.” Req. Reh’g 8–10. Petitioner, however, does not identify where in the Petition this argument was presented. Petitioner’s argument appears to be a new argument presented for the first time in its Request for Rehearing to address the deficiencies in the Petition that were identified in our Decision.

It was Petitioner’s affirmative duty to explain how the challenged claims should be construed and how, as so construed, they are unpatentable. *See* 37 C.F.R. § 42.104(b)(3)–(4). Hence, had Petitioner intended to argue, based on the open-ended transitional phrase “comprising” used in the claims, an interpretation of the “determining a press limitation” that differs from the meaning indicated by the plain language of the claim limitation or the disclosure in the Specification, such an analysis should have been made explicit in the Petition. A rehearing request is not a supplemental petition. Nor is it an opportunity to present new arguments or evidence that could have been presented and developed in the first instance in the Petition.

Simply put, we could not have misapprehended or overlooked arguments or evidence that were not presented or developed in the Petition.

In support of its claim construction argument, Petitioner submits an Administrative Law Judge's order on claim construction from the related U.S. International Trade Commission proceeding, which was not evidence of record at the time of our Decision. Req. Reh'g 7 (citing Ex. 1010, 59). In general, new evidence is not allowed in a Request for Rehearing, absent showing of good cause. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Petitioner does not explain why there is good cause to admit Exhibit 1010 with its Request for Rehearing. Nonetheless, even when we consider Exhibit 1010, it would not change the outcome of the Petitioner's Request for Rehearing because we could not have misapprehended or overlooked evidence that was not presented or developed in the Petition.

Petitioner argues that, based on Petitioner's claim construction presented in the Request for Rehearing, Toda teaches the "determining a press limitation." Req. Reh'g 10–13. Petitioner's unpatentability arguments are unpersuasive because they are predicated, at least in part, upon Petitioner's claim construction arguments that were not presented or developed in the Petition. In addition, Petitioner again mischaracterizes our Decision. For instance, with respect to the "first interval has elapsed" limitation, Petitioner contends that our Decision "*found* that [Toda teaches] 'if the time interval of 30 milliseconds elapses, . . . a press . . . is eventually determined.'" *Id.* at 12 (emphasis added) (citing Dec. 14). The cited paragraph of the Decision, however, states as follows:

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