

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONE WORLD TECHNOLOGIES, INC.
D/B/A TECHTRONIC INDUSTRIES POWER EQUIPMENT,
Petitioner

v.

THE CHAMBERLAIN GROUP, INC.
Patent Owner

Case No. IPR2017-00126
Patent No. 7,161,319

PATENT OWNER'S REQUEST FOR REHEARING

I. Introduction and Statement of Relief Requested

Patent Owner hereby requests rehearing under 37 CFR § 42.71(d), in response to the Final Written Decision (“Decision”) in proceeding IPR2017-00126.

In the Decision, the Board found that Applicant Admitted Prior Art (“AAPA”) “can be used to challenge claims in an *inter partes* review,” and that “Petitioner’s use of AAPA in its asserted ground in this proceeding was proper.” Decision, 41. These findings are based on misapprehension of the statutory and regulatory requirements for *inter partes* review, and are inconsistent with several cases in which panels of the Patent Trial and Appeal Board denied petitions for relying on ineligible AAPA in the same manner as Petitioner. *See* Pap. 6, 5-14; Pap. 11, 41-54¹; 35 U.S.C. § 311(b); C.F.R. § 42.104(b)(4); Decision, 35-41. For

¹ *Citing Kingbright Electronics Co. Ltd., et al. v. Cree, Inc.*, IPR2015-00741, Pap. 8, 5 (PTAB August 20, 2015)(“*Kingbright I*”); *Kingbright Electronics Co. Ltd., et al. v. Cree, Inc.*, IPR2015-00746, Pap. 8, 6 (PTAB August 20, 2015)(“*Kingbright II*”); *Kingbright Electronics Co. Ltd., et al. v. Cree, Inc.*, IPR2015-00743, Pap. 8, 6 (PTAB September 9, 2015)(“*Kingbright III*”); *Kingbright Electronics Co. Ltd., et al. v. Cree, Inc.*, IPR2015-00744, Pap. 8, 5-6 (PTAB September 9, 2015)(“*Kingbright IV*”); *LG Electronics, Inc. v. Core Wireless Licensing S.A.R.L.*, IPR2015-01987, Pap. 7, 18 (PTAB March 24, 2016).

this reason, Patent Owner requests rehearing.

In the Decision, the Board also found that “the Petition challenges the patentability of the challenged claims as obvious over ... Doppelt, AAPA, and Jacobs.” Pap. 56, 20, 89. This finding is based on misapprehension of the ground of rejection set forth in the Petition, and oversight of the Supreme Court’s guidance in *SAS Institute Inc. v. Iancu* that it is “the petitioner’s petition, not the Director’s discretion, [that] is supposed to guide the life of the litigation.” *SAS Institute Inc. v. Iancu*, 6-7. See Pap. 1, ii, 3, 38, 52, 59, 65; Ex. 3003; Pap. 39, 4; Pap. 45, 21, FN 3 (citing Pap. 6, 1, 21-31); Pap. 53, 31-34; *SAS Institute Inc. v. Iancu*, 584 U.S. ___, 6-8 (2018). For this additional reason, Patent Owner requests rehearing.

II. The Decision Misapprehended Federal Circuit Jurisprudence On Use Of AAPA In Reexamination, Misapprehended Regulations Adopted By The Director, And Misapprehended The Statutory Framework Of 35 U.S.C. § 311(b)

35 U.S.C. § 311(b) provides that “[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and *only on the basis of prior art consisting of patents or printed publications*” (emphasis added). The ground over which claims 1–4, 7, 9–12, and 15 of the ’319 patent were found to be unpatentable relies on the combination of two references, Doppelt and Jacobs, with “AAPA” attributed to portions of the ’319 patent’s background section. Pap. 56,

20, 89; Pap. 8, 3 (citing Pap. 1, 10), 22; Ex. 1001, 1:21-23, 1:41-43.

As set forth in Patent Owner response, however, the use-based “AAPA” relied on by Petitioner is not “prior art consisting of patents or printed publications” and, thus, is ineligible for *inter partes* review. Pap. 11, 41-54. Specifically, the AAPA included in Petitioner’s singular Ground 1 is not patent or printed publication prior art. Indeed, the ’319 patent’s background section is devoid of any mention of a patent or a printed publication. ’319 patent, 1:14-2:9. The ’319 patent at 1:21-23, for example, indicates that “[i]t has been known to *use*” (emphasis added) either of pyroelectric infrared detectors or passive infrared detectors for a particular purpose, but does not indicate in any way that such “use” was patented or published. In fact, Petitioner never even attempted to argue that the cited AAPA relates to a prior art patent or printed publication, and instead emphasized in its writing that the “Admitted Art” relates to a known “use” of infrared detectors. Petition, 10.

With this background, the Decision incorrectly concluded that the AAPA relied on by Petitioner is eligible for IPR. For the reasons discussed below, the incorrect conclusion stems from misapprehension of Federal Circuit jurisprudence on use of AAPA in reexamination proceedings, misapprehension of regulations adopted by the Director, and misapprehension of the statutory framework of 35 U.S.C. § 311(b).

A. The Decision Misapprehended Federal Circuit Jurisprudence On Use Of AAPA In Reexamination

The Decision contends that “the Federal Circuit has found, as we do above, that ‘prior art consisting of patents or publications’ includes AAPA.” Pap. 56, 38.

To reach this conclusion, the Decision cites two, different Federal Circuit cases:

(1) *In re NTP, Inc.*, 654 F.3d 1268 (“*NTP 1*”) and (2) *In re NTP, Inc.*, 654 F.3d 1279 (“*NTP 2*”).² *Id.* Specifically, the Decision cites *NTP 1* for the rule that pre-AIA reexamination “must be based *only* on ‘prior art consisting of patents or printed publications’” and cites *NTP 2* for affirmance of a reexamination ground involving AAPA. *Id.* (emphasis in original). However, *NTP 1* never mentions AAPA and *NTP 2* never mentions the rule limiting pre-AIA reexamination to prior art consisting of patents or printed publications. *See generally NTP 1* and *NTP 2*.

The Decision cannot piece together two, separate Federal Circuit decisions to reach a holding that is present in neither.

Without doubt, neither *NTP 1* nor *NTP 2* found “that ‘prior art consisting of patents or printed publications’ includes AAPA,” as contended. Pap. 56, 38.

Indeed, neither of the *NTP* cases cited by the Decision endorsed a ground involving AAPA, against an argument that AAPA was ineligible for use in a

² Both *NTP 1* and *NTP 2* were first raised by the Board in the Decision.

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