

PUBLIC VERSION

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Paper 56
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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 IPR2017-00126
Patent 7,161,319 B2

Before JONI Y. CHANG, JUSTIN T. ARBES, and JOHN F. HORVATH,
Administrative Patent Judges.

HORVATH, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

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I. INTRODUCTION

A. Background

One World Technologies, Inc. d/b/a Techtronic Industries Power Equipment (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–4, 7–12, 15, and 16 (“the challenged claims”) of U.S. Patent No. 7,161,319 B2 (Ex. 1001, “the ’319 patent”). The Chamberlain Group, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Upon consideration of the Petition and Preliminary Response, we instituted review to determine the patentability of all of the challenged claims but only a subset of the grounds raised in the Petition.¹ Paper 8 (“Dec. Inst.”).

Subsequent to institution, Patent Owner filed a Response (Paper 11, “PO Resp.”), and Petitioner filed a Reply (Paper 16, “Reply”). In its Response, Patent Owner did not present evidence or argument that the challenged claims were patentable due to secondary considerations of non-obviousness, despite having been cautioned that arguments not raised in the response will be deemed waived. *See* PO Resp.; *see also* Paper 9, 2–3.

Nearly four months after filing its Response, Patent Owner sought additional discovery of ten documents referenced in a discussion of copying as a secondary consideration of non-obviousness in a public version of an Initial Determination made in the International Trade Commission (“ITC”)

¹ We discuss in section II.D *infra*, Patent Owner’s argument that Petitioner raised only a single ground in the Petition.

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Investigation related to this proceeding.² Paper 18. We granted Patent Owner’s request, as well as Patent Owner’s requested method for apprising the Board of the significance of the discovered evidence. *See* Paper 20; Paper 27, 2–6. To that end, Patent Owner filed its ITC pre-hearing brief, suitably redacted so that only the discussion of copying was discernible, together with the documents cited in its ITC pre-hearing brief, suitably redacted so that only those portions actually cited in Patent Owner’s ITC pre-hearing brief were discernible. *See* Paper 29 (“PO ITC Brief”); Exs. 2017–2025. Petitioner similarly filed its ITC pre-hearing brief, and the evidence cited in that brief, subject to the same redaction requirements. *See* Ex. 1023, (“Pet. ITC Brief”); Exs. 1024–1031. An oral hearing was held on February 1, 2018, a portion of which was sealed, and confidential and public versions of the hearing transcript are included in the record.³ *See* Papers 32, 36 (“Tr.”).

Subsequent to the oral hearing, the Supreme Court issued its decision in *SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348 (2018). The Director interpreted the *SAS* decision to require *inter partes* reviews to be instituted on the basis of all claims challenged in a petition and all grounds raised in the petition. Accordingly, we conducted several conference calls with the parties, asking them to identify any previously non-instituted grounds, and whether they wished to include and brief any non-instituted grounds in this

² The ITC Investigation is identified in section I.B, *infra*.

³ We granted the parties’ joint motion to seal and entered a protective order that governs the treatment of confidential information in this proceeding. Paper 38; Ex. 3002.

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proceeding. *See* Paper 39, 3. In response to our inquiries, the parties identified the following as the only previously non-instituted ground they wished to add to the proceeding: “[w]hether claims 1–4, 7–12, 15 and 16 are rendered obvious by Doppelt, Applicant Admitted Prior Art, Jacobs, and Gilbert.” Ex. 3003. We, therefore, modified our Institution Decision to institute trial on this additional ground. *See* Paper 39, 5. Patent Owner filed a Supplemental Response limited to addressing this ground. Paper 45 (“PO Supp. Resp.”). Petitioner filed a Supplemental Reply to the Supplemental Response. Paper 47 (“Supp. Reply”). A supplemental oral hearing was held on August 7, 2018, and the hearing transcript is included in the record. *See* Paper 53 (“Supp. Tr.”).

We have jurisdiction under 35 U.S.C. § 6(b). This is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth below, we find Petitioner has shown by a preponderance of the evidence that claims 1–4, 7, 9–12, and 15 of the ’319 patent are unpatentable, but has failed to show by a preponderance of the evidence that claims 8 and 16 are unpatentable over the combination of Doppelt, AAPA, and Jacobs or over the combination of Doppelt, AAPA, Jacobs, and Gilbert.

B. Related Matters

Petitioner identifies the following as matters that could affect, or be affected by, a decision in this proceeding: *The Chamberlain Group, Inc. v. Techtronic Industries Co. Ltd. et al.*, Case No. 16-cv-06097 (N.D. Ill.); *The Chamberlain Group, Inc. v. Techtronic Industries Co. Ltd. et al.*, Case No. 16-cv-06094 (N.D. Ill.); and *In the Matter of Certain Access Control Systems and Components Thereof*, ITC Investigation No. 337-TA-1016 (the

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“ITC Investigation”). Pet. 1. Patent Owner identifies a subset of the same matters. Paper 4, 2.

In the related ITC Investigation, the Administrative Law Judge (“ALJ”) concluded in an Initial Determination that the challenged claims of the ’319 patent were not obvious over the combination of Doppelt and Jacobs or over the combination of Doppelt, Jacobs, and Gilbert. *See Ex. 2014, 171, 175.* The ITC affirmed the ALJ’s conclusions in a Commission Opinion. *See Ex. 3004, 1, 13 n.11.* Although we have considered the findings of fact and conclusions reached by the ITC in its Initial Determination, we are not bound by them. *See Nobel Biocare Servs. AG v. Instradent USA, Inc.*, 903 F.3d 1365, 1375 (Fed. Cir. 2018) (noting the Federal Circuit is not bound by its prior affirmance of an ITC decision when reviewing a final written decision of the Board because “[a]s the Board correctly observed, the evidentiary standard in its proceedings, preponderance of the evidence, is different from the higher standard applicable in ITC proceedings, clear and convincing evidence”). Here, in the instant Final Written Decision, we have made an independent determination of patentability of the challenged claims based on the parties’ contentions, the specific evidence presented in this proceeding, and the standards applicable to *inter partes* review proceedings.

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