

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.*

DECISION

Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On October 15, 2018, we entered a Final Written Decision determining that One World Technologies, Inc. (“Petitioner”) had shown, by a preponderance of evidence, that claims 1–4, 7, 9–12, and 15 of U.S. Patent No. 7,161,319 B2 (Ex. 1001, “the ’319 patent”) are unpatentable, but had failed to show that claims 8 and 16 are unpatentable. Paper 54¹ (“Final Dec.”). On November 14, 2018, The Chamberlain Group (“Patent Owner”) filed a Request for Rehearing, asking us to reconsider our finding that claims 1–4, 7, 9–12, and 15 are unpatentable. Paper 60 (“Reh’g Req.”).² For the reasons discussed below, Patent Owner’s Request for Rehearing is *denied*.

II. ANALYSIS

A party requesting rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and *the place where each matter was previously addressed in a motion, an opposition, or a reply.*” 37 C.F.R. § 42.71(d) (emphasis added). The burden of showing a decision should be modified on a request for rehearing lies with the party challenging the decision. *Id.*

Patent Owner argues we misapprehended or overlooked the following points in determining Petitioner had shown the unpatentability of claims 1–

¹ A public version of this sealed Final Written Decision was filed on October 24, 2018, as Paper 56.

² Prior to a decision on Patent Owner’s Request for Rehearing, both parties filed a notice of appeal from the Final Written Decision. Papers 62, 64. The parties subsequently moved to dismiss their appeals. On February 19, 2019, the U.S. Court of Appeals for the Federal Circuit granted the parties’ motion to dismiss the appeals, and remanded the case to the Board for decisions on the parties’ rehearing requests. The Federal Circuit’s Order issued as a mandate to the Board on the same day.

4, 7, 9–12, and 15 of the '319 patent: (1) the grounds of unpatentability raised in the Petition; and (2) the ability to rely on Applicant Admitted Prior Art (“AAPA”) in *inter partes* reviews. Reh’g Req. 1–2. We disagree for the reasons discussed below.

A. *Procedural History*

Given Patent Owner’s argument that we have misapprehended the grounds raised in the Petition, we provide the following procedural history of this case. In its Petition for review of the '319 patent, Petitioner requested we “find claims 1–4, 7, 8, 9–12, 15, and 16 unpatentable under § 103 as obvious over *Doppelt* in view of the *Admitted Art* and *Jacobs and/or Gilbert*.” Paper 1 (“Pet.”), 3 (additional emphasis added).

In its Preliminary Response to the Petition, Patent Owner characterized the Petition as challenging the patentability of claims 1–4, 7, 8, 9–12, 15, and 16 (“the challenged claims”) as “obvious over *Doppelt* in view of *Jacobs*, ‘*Admitted Art*,’ **and** *Gilbert*.” Paper 6, 14 (citing Pet. 38) (emphasis added). Despite this characterization, Patent Owner argued the Petition should be denied because in challenging claim 1, Petitioner “contends that all but two of the recited features are disclosed by two or more of the references,” and “cites to *Jacobs and/or Gilbert* without identifying deficiencies in *Doppelt* for which these references are applied.” *Id.* at 17, 19 (emphasis added). As a result, Patent Owner argued Petitioner’s failure to identify clearly how each claim limitation is allegedly taught by the cited art “prejudices Patent Owner and . . . leaves Patent Owner without a clear understanding of the ground being advanced.” *Id.* at 23.

In our Institution Decision, we addressed Patent Owner’s concerns regarding the ambiguity in Petitioner’s challenging the claims as obvious over Doppelt, AAPA, Jacobs “*and/or*” Gilbert. Specifically, we found Petitioner’s analysis was not “so unclear that it has prejudiced Patent Owner by forcing Patent Owner to speculate as to the particular combination of references Petitioner has relied upon.” Paper 8 (“Dec. Inst.”), 19 (citing Pet. 38–44, 58). We did so because “Petitioner’s reliance on Gilbert is contingent on our explicitly construing the term *wall console* to not require an IR detector,” and because “Petitioner provides separate rationales for combining Doppelt, AAPA, and Jacobs, and for combining Doppelt, AAPA, Jacobs, and Gilbert.” *Id.* Although we instituted review based on the ground of obviousness over (1) Doppelt, AAPA, and Jacobs, we denied review on the additional grounds of obviousness over (2) Doppelt, AAPA, Jacobs, and Gilbert, and (3) Doppelt, AAPA, and Gilbert implied by Petitioner’s use of “*and/or*” in the grounds raised in the Petition. Dec. Inst. 20–21.

Subsequent to our Institution Decision, Patent Owner filed a Response to the Petition. *See* Paper 11 (“PO Resp”). In its Response, Patent Owner did not maintain its argument that the Petition raised an ambiguous ground, and did not argue that the only ground raised in the Petition was obviousness over Doppelt, AAPA, Jacobs, and Gilbert. *Id.* at 1–54. Additionally, the Supreme Court issued its decision in *SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348, 1354 (2018), holding that when *inter partes* review is instituted, “the Board *must* address *every* claim the petitioner has challenged.” In response to the SAS decision, the Director issued *Guidance on the impact of SAS on*

*AIA trial proceedings.*³ The *Guidance* indicated that when the Board institutes *inter partes* review, it will institute review of all challenged claims on “all challenges raised in the petition.” The *Guidance* further indicated that for pending trials not instituted on all grounds or challenges raised in the petition, “the panel *may* issue an order supplementing the institution decision to institute on all challenges.” *Id.* When this occurs, “the petitioner and patent owner shall meet and confer to discuss the need for additional briefing,” and “may agree to affirmatively waive additional briefing or schedule changes.” *Id.*

In view of *SAS* and the Director’s *Guidance*, we emailed the parties requesting their availability for a conference call to discuss “whether either party would like to present additional briefing on the patentability of the challenged claims based on the combinations of (1) Doppelt, AAPA, and Gilbert, and (2) Doppelt, AAPA, Jacobs and Gilbert.” Ex. 3006. During the subsequent call, we asked the parties to meet and confer to (a) identify any non-instituted grounds raised in the Petition and the claims that pertain to such grounds, (b) determine whether additional briefing was needed to address any such non-instituted grounds and claims, and (c) determine whether the parties agree on how to proceed with respect to non-instituted grounds, including by agreeing to withdraw such grounds. *See* Paper 39, 3. In response, the parties sent a joint email to the Board indicating “they had *reached agreement* that the only *non-instituted* ground in this proceeding was Petitioner’s challenge to the patentability of claims 1–4, 7–12, 15, and 16 under 35 U.S.C. § 103(a) as obvious over Doppelt, AAPA, Jacobs, and

³ Available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

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