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Paper 14
Entered: February 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OMRON OILFIELD & MARINE, INC.
Petitioner

v.

MD/TOTCO, A DIVISION OF VARCO, L.P.
Patent Owner

Case IPR2013-00265
Patent 5,474,142

Before THOMAS L. GIANNETTI, BRYAN F. MOORE, and MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

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

SUMMARY

Omron Oilfield & Marine, Inc. (Petitioner) requests rehearing of the Board's Decision (Paper 11) not to institute an *inter partes* review of U.S. Patent 5,474,142 (Ex. 1001) (the "'142 patent"). Paper 12 ("Rehearing Req.").[1] Petitioner does not seek rehearing of the Board's decision not to institute trial on anticipation. The rehearing request is limited to the Board's decision not to institute trial on obviousness. Rehearing Req. 1. For the reasons that follow, Petitioner's request for rehearing is denied.

DISCUSSION

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

> A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request 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, opposition, or a reply.

Petitioner argues that the Decision misapprehends: (1) alleged inadmissibility of Patent Owner's evidence of secondary considerations; (2) Petitioner's inability to rebut Patent Owner's evidence of secondary considerations; (3) the sufficiency of Patent Owner's evidence of secondary considerations; and (4) the strength of Petitioner's prior art. Rehearing Req. 1-3. The arguments are unpersuasive.

[1] Patent Owner filed a response to the Petitioner's request for rehearing. Paper 13. This paper was not authorized by the Board and, thus, will not be considered and will be expunged.

"In determining whether to institute or order a proceeding under . . . chapter 31 [Inter Partes Review], the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d). We concluded that the combinations of references cited in the Petition were not substantially different from the references before the Office in a prior *ex parte* reexamination in which the patentability of the challenged claims was confirmed. The Examiner there relied on evidence of commercial success in allowing the claims. *See* Ex. 1020 (Office Action in Reexamination Control No. 90/010,615). Based on this determination, the Board determined that Petitioner had not shown a reasonable likelihood of prevailing, especially in light of the strong evidence of secondary considerations of non-obviousness that were not addressed in the Petition. Decision 12-16. In other words, we concluded that the Petition presented the same, or substantially the same, prior art and arguments to the Office as those overcome in the reexamination. *See* 35 U.S.C. § 325(d); Decision 12-13 ("We have reviewed the examiner's findings and the supporting evidence, and we agree that the patent owner's evidence of secondary considerations is persuasive.").

We note that, in its Petition, Petitioner acknowledged its awareness that Patent Owner presented evidence of secondary considerations in the reexamination. Pet. 10. Petitioner had the opportunity to address this evidence, but failed to do so in its Petition. Rather, Petitioner argued simply that "[t]he Patent Owner's evidence of secondary considerations will be unable to overcome the strong showing of obviousness set forth in this Petition." Pet. 10. We determined otherwise and, therefore, denied the Petition. Decision 16.

As to the obviousness challenge based on the combination of Lindstad and Crake, Petitioner argues specifically that the board "misapprehended Lindstad as

disclosing a mere drilling fluid pressure sensor." Rehearing Req. 11-12. Thus, Petitioner argues, the Board did not appreciate the strength of this combination for the purpose of overcoming a showing of secondary considerations of non-obviousness. *Id.* The Board considered all the relevant teachings in Lindstad, and not simply the fluid pressure sensor. Specifically, the Board acknowledged that Lindstad teaches "a blasthole drilling system that automatically regulates the downward drive of the drill string . . . ." Decision 9. The Board made an evaluation of whether Petitioner had demonstrated a reasonable likelihood of prevailing on obviousness, and determined that it did not. Decision 10-12. The Board determined that the record was similar to that presented in the reexamination, which the Office determined did not overcome the showing of secondary conditions of obviousness. Decision 16. Therefore, we are not persuaded by Petitioner's argument regarding Lindstad.[2]

In the end, Petitioner chose not to present in its Petition the arguments presented in its rehearing request (Rehearing Req. 5-10) addressing the evidence supporting the finding of secondary considerations in the reexamination. Petitioner also did not distinguish the combinations of references presented in the Petition from the references cited in the reexamination. Accordingly, we did not misapprehend or overlook Petitioner's arguments because they were not previously presented. A request for rehearing is not an opportunity to submit new arguments. For the above reasons, we are not persuaded by Petitioner's new arguments regarding the merits or admissibility of the evidence of secondary considerations.

[2] As to the remaining challenges, based on Lindstad and Brooks, Warren and Brooks, Le Compte and Crake, and Miller and Crake, Petitioner simply reargues the points made in its Petition, without explaining how the Board misapprehended those arguments. Therefore, we are not persuaded by Petitioner's arguments regarding these challenges.

ORDER

Accordingly, it is

ORDERED that Petitioner's Request for Rehearing is DENIED; and

FURTHER ORDERED that the paper filed by Patent Owner on January 2, 2014 (Paper 13) is dismissed as unauthorized and expunged from the record of the instant proceeding.

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