UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LOGIC TECHNOLOGY DEVELOPMENT, LLC
Petitioner
v.

FONTEM HOLDINGS 1 B.V.
Patent Owner

Case IPR2015-00098

Patent No. 8,375,957 B2

PETITIONER'S REQUEST FOR REHEARING

UNDER 37 CFR § 42.71

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. §§ 42.71 (c) and (d), and in response to the Decision Denying Institution of *Inter Partes* Review (Paper No. 8 dated May 11, 2015, the "Decision"), Petitioner Logic Technology Development, LLC ("Petitioner") requests rehearing and that trial be instituted.

II. STANDARD OF REVIEW

The standard of review is abuse of discretion. 37 C.F.R. § 42.71(c).

III. BRIEF IDENTIFICATION OF GROUNDS ON WHICH REHEARING IS REQUESTED

Petitioner respectfully seeks rehearing because the following bases of the "Analysis of Grounds of Unpatentability" in the Decision relied exclusively on Petition pages 21-23 but misapprehend or overlooked other portions of the Petition that do disclose the features of the claims:

A. The statement that the Petition failed to make out the following feature of the claims: "a separate housing for the battery assembly. An external screwthread electrode, located on one end of the battery assembly housing, mates with an internal screwthread electrode, located on one end of the atomizer assembly housing. Ex. 1001 (claims 1, 10, 23)." Citing Pet. 22-23 (Decision p. 9)

B. The statement that the Petition failed to establish a reason with a rational underpinning to "modify Hon to include a separate housing for the battery assembly. *See* Pet. 21-23" (Decision pp. 10-11)

C. The statement that the Petition failed properly to identify: "any disclosure in the prior art that would have led to the particular arrangement of elements specified in the claims, including a battery assembly housing having, on one end, an external screwthread electrode; and an atomizer assembly housing having, on one end, a mating internal screwthread electrode. *See* Pet. 21–23." (Decision p. 11)

IV. REHEARING SHOULD BE GRANTED BASED ON PORTIONS OF THE PETITION OVERLOOKED OR MISAPPREHENDED BY THE BOARD

According to 37 C.F.R. § 42.71(d), "[t]he burden of showing a decision should be modified lies with the party challenging the decision" and the "request must specifically identify all matters the party believes the Board misapprehended or overlooked." Petitioner respectfully requests a rehearing under 37 C.F.R. § 42.71(d) because the Board misapprehended or overlooked explanations in the Petition of the correspondence of claim elements to the prior art which satisfied the requirements under 37 C.F.R. § 42.22 to include a "detailed explanation of the significance of the evidence."

Specifically, all of the Board's reasons for denying institution of Inter Partes Review were based on statements in Pet. 21-23 and the portions of the Buckner Declaration, Ex. 1002, cited therein. Petitioner respectfully submits that the Board overlooked or misapprehended the other portions of the Petition not cited in the Decision which did disclose the claimed features.[1]

A. The Petition Did Disclose A Separate Housing For The Battery Assembly Using Screwthread Electrodes To Mate To The Atomizer Assembly

All of the obviousness combinations upon which Petitioner relied include at least combinations of China Patent CN 2719043 (Ex. 1003) (and English translation and its U.S. equivalent publication 2007/0267031 ("Hon '031") (Ex. 1005)) (hereinafter "Hon") and U.S. Patent No. 3,200,819 (Ex. 1007) ("Gilbert").

Addressing the first determination identified in § III., the Board relies on Pet. 21-23 for its statement that the Petition failed to make out the following feature of the claims: "a separate housing for the battery assembly. An external screwthread electrode, located on one end of the battery assembly housing, mates

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[1] It is notable that the Patent Owner's Preliminary Response (Paper No. 7) at pp. 22-25, when discussing the battery assembly, only discussed Pet. 21-23 and did not address other disclosures made in the Petition.

with an internal screwthread electrode, located on one end of the atomizer assembly housing." The Board did not identify any other portion of the Petition in support for its statement.

Petitioner respectfully submits that the Board overlooked or misapprehended that, at Pet. 29-30 and 35-38, the Petition did identify prior art disclosing a separate housing for the battery assembly that uses a screwthread electrode at one end to mate to the atomizer assembly. Specifically, at Pet. 29, Petitioner explains that Gilbert discloses an electric socket using a screwthread electrode: "Within the inner ring 29 is a threaded electric socket 30 and forwardly thereof a battery cavity 31 for detachably receiving a battery 32 having an inner contact 33 and an outer contact 34 with a contact strip 35 between the inner contact 33 and the socket 30. (2:41-45)." At Pet. 29-30, Petitioner included the annotated drawing below, and explained that: "Gilbert discloses a **primary screwthread electrode** in the form of the threaded electric socket 30, which is **on the first end of the battery housing**. . . The structure disclosed in Gilbert allows two separate housings to be electrically connected via screwthread electrodes without using any wires that could be twisted when the two housings are screwed together." (emphasis added)

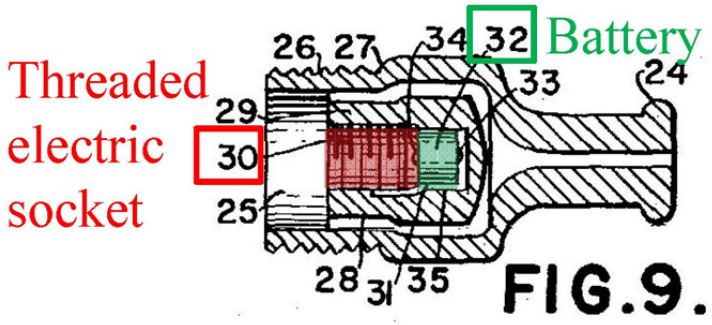


FIG.9.

At Pet. 28-29, Petitioner explained the reasons to combine Hon and Gilbert.

At Pet. 35-38, Petitioner further explained that Gilbert discloses separate battery assembly and atomizer assembly housings and included the following annotated drawing of Gilbert at Pet. 36:

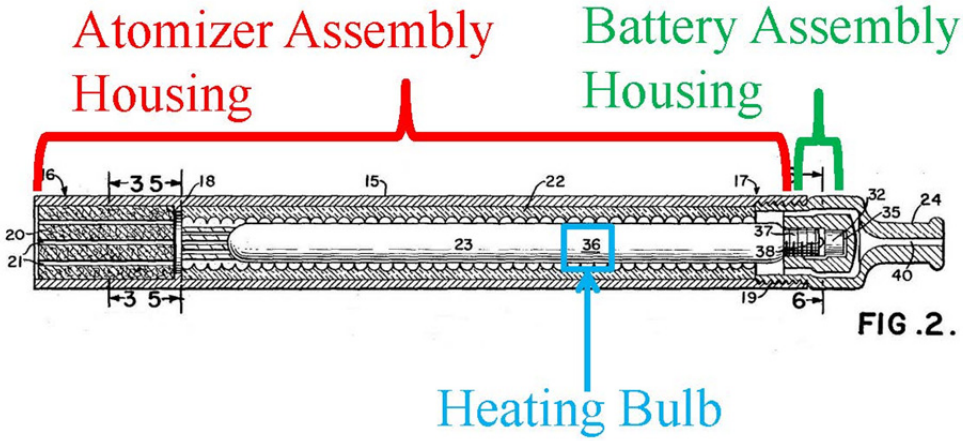


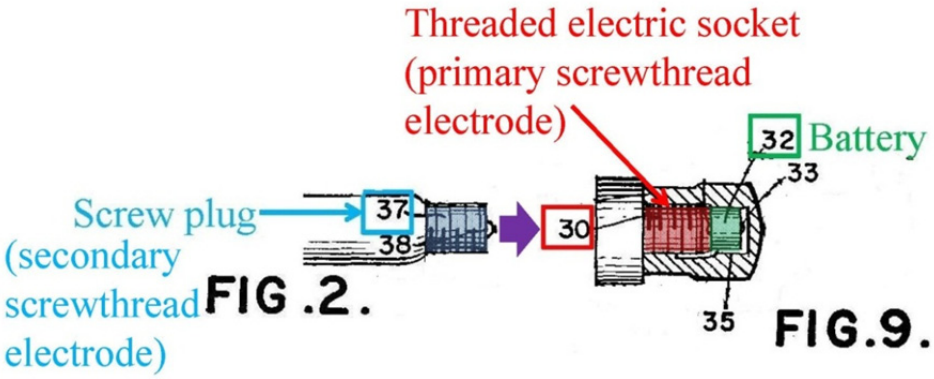
FIG .2.

At Pet. 35, Petitioner explained that: "Gilbert discloses a **primary screwthread electrode** used for connecting the **battery assembly**: 'a threaded electric socket 30 and forwardly thereof a battery cavity 31 for detachably receiving a battery 32.'" (emphasis added)

Although the independent claims refer to "primary" and "secondary" (Claims 1, 10) or "first" and "second" (Claim 23) screwthread electrodes,

dependent Claims 3 and 14 use the phrases "**internal**" and "**external**" screwthread electrodes. At Pet. 46-48, Petitioner explained why Gilbert discloses internal and external screwthread electrodes: "Gilbert's **'external' screwthread electrode** is the threaded electric socket 30, which is external to the screw plug 37; it is the primary screwthread electrode. Gilbert's **'internal' screwthread electrode** is the screw plug 37, which is internal to the threaded electric socket 30; it is the secondary screwthread electrode. Ex. 1002 at ¶ 130." (emphasis added)

Petitioner also included the following annotated drawing at Pet. 47:



Accordingly, Petitioner did make out the following features of the claims which were overlooked or misapprehended by the Board: "a separate housing for the battery assembly. An external screwthread[2] electrode, located on one end of the

[2] Although not addressed in the Decision, Patent Owner's position at Patent Owner's Preliminary Response (Paper No. 7) at pp. 30-31 that Gilbert does not disclose a screwthread electrode because "socket 30 is not 'formed from a

battery assembly housing, mates with an internal screwthread electrode, located on one end of the atomizer assembly housing."

B. The Petition Did Disclose A Rational Underpinning To Modify Hon To Include A Separate Housing For The Battery Assembly

Addressing the second determination identified in § III., the Board relies on Pet. 21-23 for its statement that "Dr. Buckner's agreement with [the Examiner's statement] without providing any objective support, is insufficient to establish that it would have been obvious to modify Hon to include a separate housing for the battery assembly." Decision p. 10.

Petitioner respectfully submits that the Board overlooked or misapprehended that Petitioner did provide objective support and explained at Pet. 29 several

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conductor for passing electricity'" is incorrect. As Gilbert discloses, "Within the inner ring is a **threaded electric socket 30** . . . with **a contact strip 35 between the inner contact and the socket 30** . . . When the bulb 36 is assembled to the socket 30 its tip end 38 will engage the inner battery contact 33 and complete the circuit through the filament of the bulb 36 **by the contact strip 35**." Gilbert at 2:41-3:2 (emphasis added). As shown in Fig. 9, the contact strip 35 contacts socket 30 to conduct electricity and Gilbert explicitly describes 30 as a "threaded **electric socket**."

reasons to combine Hon with the separate housing of the battery assembly of Gilbert:

> That is, the combination uses a known technique of having a device separable at the battery/atomizer junction to improve a device and the results are predictable. Using separable battery and atomizer assemblies to allow a battery to be recharged would enhance commercial opportunities and make the product more desirable by reducing the need to replace the entire device when the battery is depleted. The structure disclosed in Gilbert allows two separate housings to be electrically connected via screwthread electrodes without using any wires that could be twisted when the two housings are screwed together. Using separable battery and atomizer assemblies to allow a battery to be recharged would enhance commercial opportunities and make the product more desirable by reducing the need to replace the entire device when the battery is depleted.
>
> Citing Buckner Declaration, Ex. 1002 at ¶ 90.

Thus, the reasons for separate housings include at least providing two structures that could be connected without twisting wires when the housings are screwed together and reducing the need to replace the entire device when the

battery is depleted. Further, at Ex. 1002 ¶ 73, Dr. Buckner explained that the combination of Hon and Gilbert would "allow the battery assembly to be disconnected from the rest of the device to allow recharging of a rechargeable battery **in the battery assembly housing**." Hon did not disclose a rechargeable battery that could conveniently be recharged **in the battery assembly housing**.

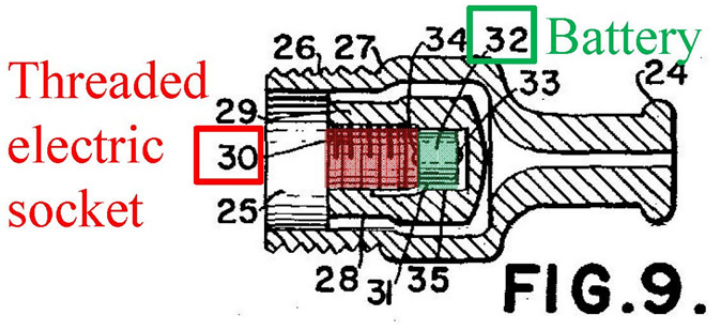
Accordingly, Petitioner did establish at Pet. 29 and Ex. 1002 at ¶¶ 90, 73 reasons with rational underpinnings overlooked or misapprehended by the Board to modify Hon to include a separate battery assembly housing.

C. The Petition Did Disclose Prior Art Leading To The Particular Arrangement Of Elements Specified In The Claims, Including A Battery Assembly Housing Having, On One End, An External Screwthread Electrode; And An Atomizer Assembly Housing Having, On One End, A Mating Internal Screwthread Electrode

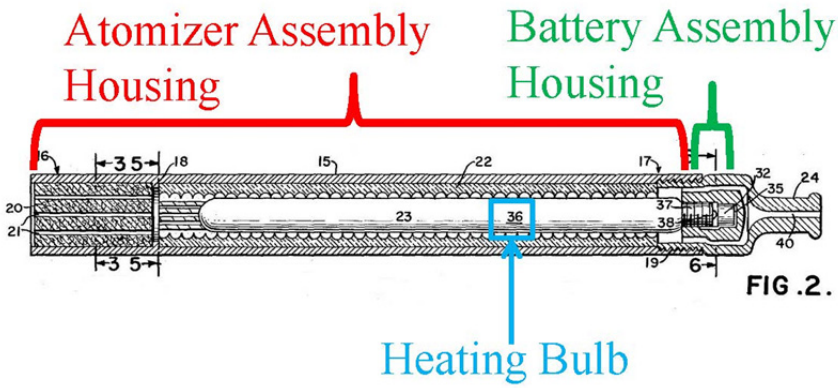
Addressing the third determination identified in § III. above, the Board relies on Pet. 21-23 for its statement that the Petition failed to identify: "any disclosure in the prior art that would have led to the particular arrangement of elements specified in the claims, including a battery assembly housing having, on one end, an external screwthread electrode; and an atomizer assembly housing having, on one end, a mating internal screwthread electrode."

Petitioner respectfully submits that, as discussed in § IV.A. above, the Board

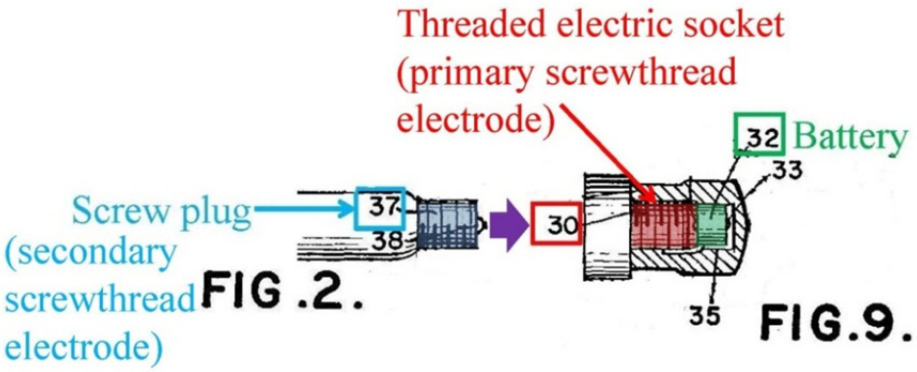
overlooked or misapprehended Petitioner's explanation at Pet. 29-30 that: "Gilbert discloses a primary screwthread electrode in the form of the threaded electric socket 30, which is on the first end of the battery housing."



As discussed in § IV.A. above, at Pet. 35-38, Petitioner further explained that Gilbert discloses separate battery assembly and atomizer assembly housings and included the following annotated drawing of Gilbert at Pet. 36:



As discussed in § IV.A. above, at Pet. Pet. 46-48, Petitioner explained why the "internal" and "external" screwthread limitations of dependent claims 3 and 14 are present and included the following annotated drawing of Gilbert:



Once the separate housings and screwthreads of Gilbert are combined with Hon, then the particular arrangement of elements in the claims of the '957 Patent are disclosed, as Hon has nearly all of the other limitations the same arrangement as the '957 Patent, as disclosed at Pet. 6 and the rest of the Petition, and as shown in the included following annotated drawings of the '957 Patent and Hon at Pet. 6:

'957 Patent:

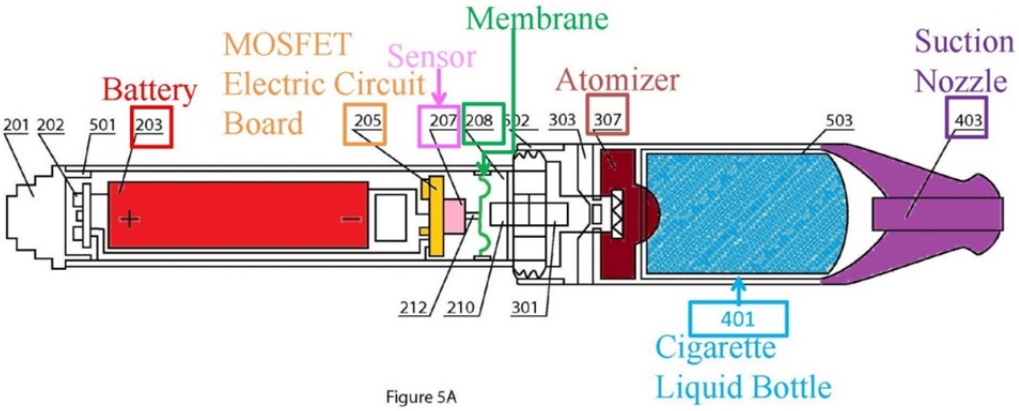


Figure 5A

Hon:

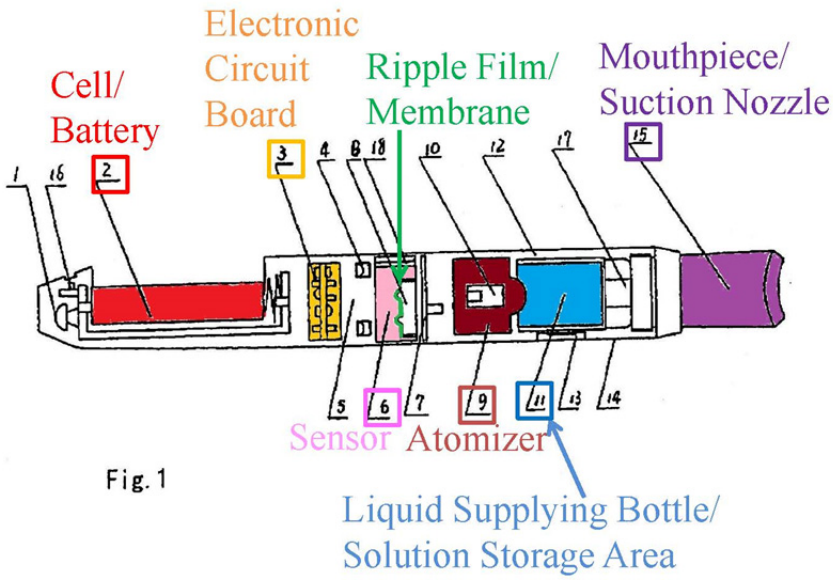


Fig. 1

Accordingly, Petitioner did disclose the limitations the Decision stated were missing.

V. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests rehearing concerning the issues identified above, and requests that trial be instituted.

Respectfully submitted,

June 10, 2015

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PETITIONER'S REQUEST FOR REHEARING UNDER 37 CFR § 42.71is being served on June 10, 2015 by causing the aforementioned document to be deposited in the United States Postal Service as Express Mail, Mailing Label No. EF 009647083 US, postage pre-paid in an envelope addressed to:

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A courtesy service copy has been served on June 10, 2015 by causing the aforementioned document to be deposited in the United States Postal Service as Express Mail, Mailing Label No. EF 009647097 US postage pre-paid in an envelope addressed to:

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