

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DONGHEE AMERICA, INC. AND DONGHEE ALABAMA, LLC,
Petitioner,

v.

PLASTIC OMNIUM ADVANCED INNOVATION AND RESEARCH,
Patent Owner.

Case IPR2017-01654
Patent 9,079,490 B2

Before MITCHELL G. WEATHERLY, CHRISTOPHER M. KAISER, and
ROBERT L. KINDER, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

DECISION

Instituting *Inter Partes* Review

35 U.S.C. § 314, 37 C.F.R. §§ 42.4, 42.108

I. INTRODUCTION

A. BACKGROUND

Donghee America, Inc. and Donghee Alabama, LLC (collectively “Petitioner”) filed a petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1, 2, 7–9, and 12–14 of U.S. Patent No. 9,079,490 B2 (Ex. 1001, “the ’490 patent”). 35 U.S.C. § 311. Plastic Omnium Advanced

Innovation and Research (“Patent Owner”) timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. Based on our review of the record, we conclude that Petitioner is reasonably likely to prevail with respect to at least one of the challenged claims.

Petitioner contends that the challenged claims are unpatentable under 35 U.S.C. §§ 102, 103 based on the following grounds (Pet. 16–45):

References	Basis	Claim(s)
U.S. Patent Pub. No. 2008/0006625 A1 (Ex. 1003, “Borchert”)	§ 102(e)	1, 2, 8, and 12–14
Borchert	§ 103	7
Borchert and U.S. Patent 6,866,812 B2 (Ex. 1004, “Van Schaftingen”)	§ 103	7
Borchert and U.S. Patent 8,122,604 B2 (Ex. 1005, “Jannot”)	§ 103	2
Borchert and U.S. Patent 6,699,413 B2 (Ex. 1006, “Kachnic”)	§ 103	9

For the reasons described below, we institute an *inter partes* review of all challenged claims on all asserted grounds of unpatentability.

B. RELATED PROCEEDINGS

The parties have identified as a related proceeding the co-pending district court proceeding of *Plastic Omnium Advanced Innovation and*

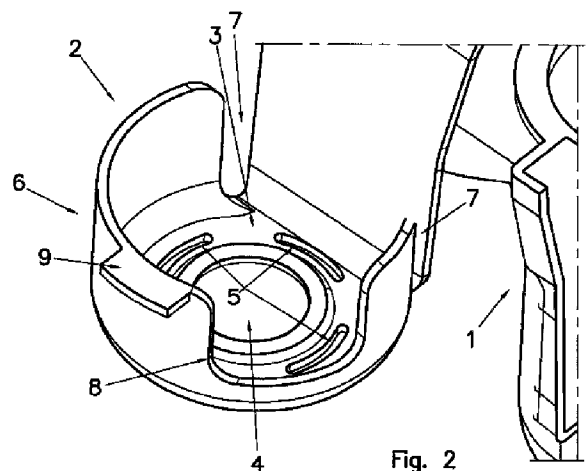
Research v. Donghee America, Inc. et al., Civil Action No. 16-cv-00187-LPS-CJB (D. Del.). Pet. 2; Paper 3, 1.

C. THE '490 PATENT

The '490 patent is directed to “a method for fastening an accessory to a wall of a plastic fuel tank.” Ex. 1001, 1:16–17. More specifically, the '490 patent is directed to a process for snap-riveting accessories to the wall of a plastic fuel tank during molding of the tank. *Id.* at 1:60–2:5. Snap-riveting involves forcing molten plastic from the tank wall through an orifice in the accessory and allowing the protruding plastic to solidify to form the head of a rivet. *Id.* at 3:40–47. The '490 patent describes snap-riveting as a “common technique in the field of metallurgy,” *id.* at 3:43, that has been used in the prior art to fasten accessories to plastic fuel tanks, *id.* at 1:35–41. The Specification further describes “an improved geometry of the snap-riveting zone that makes it possible to ensure [self-centering] of the accessory with respect to the tool which will carry out the snap-riveting and that makes it possible to obtain a better distribution of the stress during this process.” *Id.* at 1:60–65. In particular, the snap-riveting orifice is surrounded by a concave relief. *Id.* at 3:61–62.

Figure 2 of the '490 patent, reproduced right, illustrates accessory 1 having tab 2 with central orifice 4 through which molten plastic flows to form a snap rivet connecting accessory 1 to the wall of the tank. The Specification states:

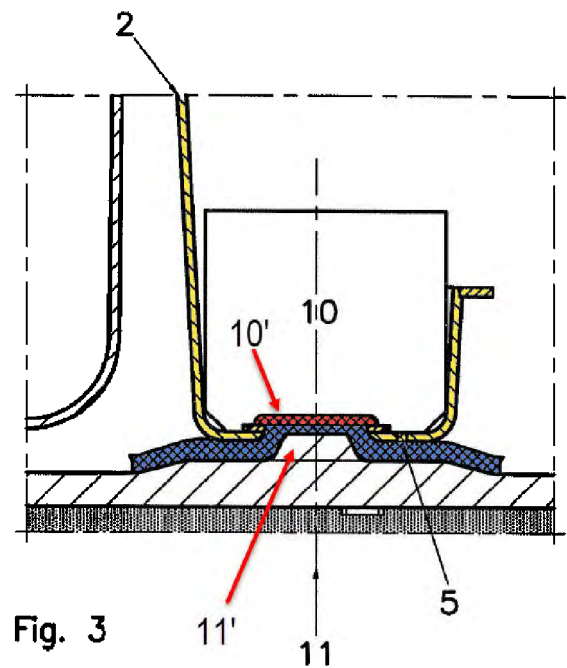
In FIG. 2, the geometry of the fastening tabs (2) of the accessory (1) appears more clearly: the curved end (3) of these tabs is provided



with a central orifice (4) and with several slots (5) positioned over a circumference surrounding this orifice (4). This curved end (3) is extended by a cylindrical wall (6) in the shape of a cup provided with two recesses (7) that confer a certain mobility to the end of the tab—necessary for accompanying the shrinkage of the material during cooling of the tank—and a wider window (8) that allows visual inspection of the snap-rivet once the accessory is fastened to the wall of a tank.

Id. at 7:1–11.

The annotated and colorized pertinent portion of Figure 3 of the '490 patent, reproduced right, depicts a cross section of tab 2 (colorized yellow) with the head of a snap rivet above orifice 5 and within concave portion 10' of tool 10 (colorized red), which is formed of plastic used to form the wall of the tank (colorized blue). The reproduced portion of Figure 3 also illustrates the lower portion of snap rivet being formed between mould 11 with excrescence 11', tool 10 and tab 2.



Claims 1 and 12, which are the only independent claims among the challenged claims, recite:

1. A method for fastening an accessory to a wall of a plastic fuel tank, comprising:
 - [a] fastening by snap-riveting using a tool, at the same time as said tank is manufactured by moulding with a mould, the accessory including at least one orifice through which the snap-riveting is carried out by material of the tank protruding from the orifice and being deformed to mould the rivet,

- [b] wherein the snap-riveting orifice is at least partially surrounded by a concave relief that protrudes towards an inside of the tank into which a convex relief of the tool presses in order to force the material through the orifice, the convex relief of the tool comprising a counterform to mould an upper part of the rivet.

Id. at 7:26–40 (with Petitioner’s enumerations for clarity added in brackets).

12. A method for fastening an accessory to a wall of a plastic fuel tank, comprising:

- [a] fastening by snap-riveting using a tool, at the same time as said tank is manufactured by moulding with a mould, the accessory including at least one orifice through which the snap-riveting is carried out by material of the tank protruding from the orifice and being deformed to mould the rivet,
- [b] wherein the snap-riveting orifice extends through a base portion of a concave relief formed in the accessory,
- [c] wherein the concave relief is formed by the base portion and a wall portion that protrudes away from the base portion towards an inside of the tank,
- [d] wherein an area of the base portion surrounds the orifice and faces towards the inside of the tank,
- [e] wherein the wall portion at least partially surrounds the area of the base portion that surrounds the orifice such that the wall portion is spaced apart from the orifice by the area of the base portion that surrounds the orifice, and
- [f] wherein a convex relief of the tool presses into the concave relief in order to force the material through the orifice, the convex relief of the tool comprising a counterform to mould an upper part of the rivet, which upper part contacts the area of the base portion that surrounds the orifice.

Id. at 8:22–47 (with Petitioner’s enumerations for clarity added in brackets).

II. ANALYSIS

A. CLAIM INTERPRETATION

“A claim in an unexpired patent that will not expire before a final written decision is issued shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (affirming that USPTO has statutory authority to construe claims according to Rule 42.100(b)). When applying that standard, we interpret the claim language as it would be understood by one of ordinary skill in the art in light of the specification. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning ‘is the meaning that the term would have to a person of ordinary skill in the art in question.’”). Only terms which are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Petitioner notes and accepts for purposes of its analysis that the Specification expressly defines the following three terms: “accessory,” “parison,” and “concave relief.” Pet. 12–14 (citing Ex. 1001, 3:11–21 (defining “accessory”), 4:63–5:2 (defining “parison”), 3:61–66 (defining “concave relief”)). When an inventor defines specific terms used to describe an invention, we will give effect to those definitions, as long as they are set out “with reasonable clarity, deliberateness, and precision,” “so as to give one of ordinary skill in the art notice of the change” in meaning. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Each of the cited express

definitions in the Specification indicate that the phrase is “understood to mean” along with a following definition. Ex. 1001, 3:11–21 (defining “accessory”), 4:63–5:2 (defining “parison”), 3:61–66 (defining “concave relief”). On the current record, we understand “understood to mean” to provide notice of a reasonably clear, deliberate, and precise definition of each claim term. For the purposes of this Decision, we interpret each claim term according to the definition set forth in the Specification.

1. convex relief

Petitioner proposes that “convex relief” means “a positive or outwardly projecting relief.” *Id.* at 14 (citing Ex. 1001, 6:4–8). The cited portion of the Specification refers to “convex relief” as an “excrescence,” Ex. 1001, 6:4–8, which is defined by Merriam Webster’s Collegiate Dictionary as “a projection or growth,” Ex. 1008. Patent Owner cites the same portion of the Specification and counters that “convex relief” needs no interpretation but means “projection” by its plain and ordinary meaning. Prelim. Resp. 14. For the purposes of this Decision, we interpret “convex relief” as commonly suggested by the parties to mean a “projection.”

2. counterform

Petitioner proposes that “counterform” means “a portion of the convex relief of the tool that is used to shape the upper part of the rivet.” Pet. 14–15 (citing Ex. 1001, 6:1–11). The Specification identifies the “counterform” as being “intended for moulding the upper part of the rivet (snap rivet).” Ex. 1001, 6:1–11. Patent Owner does not propose any interpretation of “counterform.” *See* Prelim. Resp. 13–15 (not commenting on meaning of “counterform”). For the purposes of this Decision, we interpret “counterform” as proposed by Petitioner.

B. CHALLENGES TO THE CLAIMS

Petitioner challenges the patentability of the challenged claims on the grounds that the claims are anticipated or obvious in light of one or more of the following references: Borchert, Van Schaftingen, Jannot, and Kachnic. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). “In addition, the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” *Paulsen*, 30 F.3d at 1478–79. Anticipation is a question of fact. *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015). “[A] reference can anticipate a claim even if it ‘d[oes] not expressly spell out’ all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would ‘at once envisage’ the claimed arrangement or combination.” *Id.* (citing *In re Petering*, 301 F.2d 676, 681 (CCPA 1962)).

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), reaffirmed the framework for determining obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The *KSR* Court summarized the four factual inquiries set forth in *Graham* that we apply in determining whether a claim is reasonably likely to be unpatentable as obvious under 35 U.S.C. § 103(a) as follows: (1) determining the scope and content of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art, and (4) considering objective evidence indicating obviousness

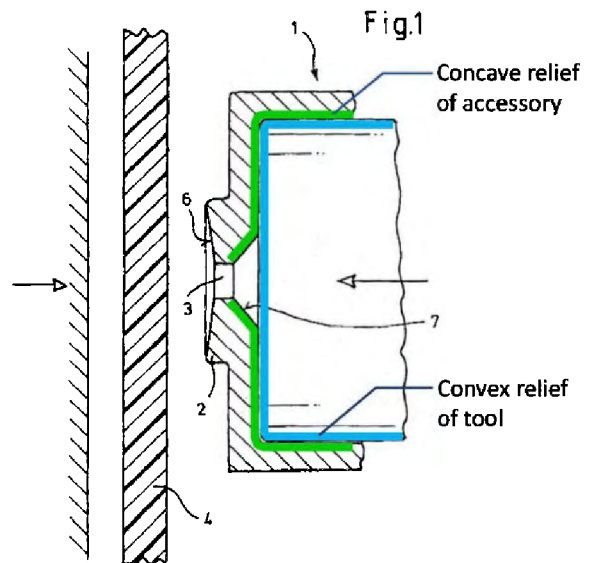
or nonobviousness. *KSR*, 550 U.S. at 406. With these standards in mind, we address each challenge below.

1. Claims 1, 2, 8, and 12–14: Anticipation by Borchert

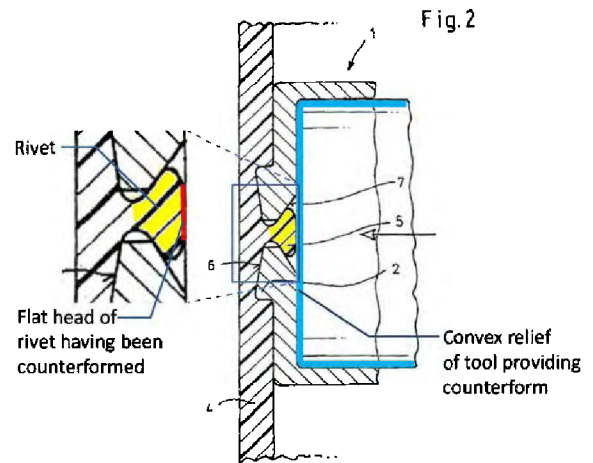
Petitioner contends that Borchert anticipates claims 1, 2, 8, and 12–14. Pet. 16–36. Petitioner identifies the manner in which Borchert describes each step of the claimed methods and cites portions of Borchert to support its contentions. *Id.* (citing Ex. 1003 ¶¶ 8, 10, 19, 26–28, 33, 37, Figures 1, 2, 4, 7, 12). Petitioner also supports its contentions with Dr. Kazmer’s testimony. *Id.* (citing Ex. 1007 ¶¶ 41–58, 70–73, 80–96). Dr. Kazmer testifies that an ordinarily skilled artisan would understand an unnumbered element shown in Borchert’s Figure 1 to constitute the “convex relief of the tool” that forces material through orifice to form the snap-rivet as required in independent claims 1 and 12. Ex. 1007 ¶¶ 52–54.

Dr. Kazmer provides a colorized and annotated version of Borchert’s Figure 1, which we reproduce at right, and Dr. Kazmer labels as Kazmer-4.

Borchert’s Figure 1 illustrates accessory 1 with foot element 2 through which orifice 3 extends. Ex. 1003 ¶ 28. Dr. Kazmer testifies as follows: “Borchert provides a concave relief surrounding the orifice that protrudes towards an inside of the tank (highlighted in green). As indicated in Kazmer-4, a POSITA would understand that Borchert provides a convex relief (i.e. excrescence at 6:4 of the ‘490 specification) of the tool highlighted in blue.” Ex. 1007 ¶ 52.



Dr. Kazmer provides a revised version of Borchert's Figure 2, which he labels Kazmer-5, and we reproduce at right. Dr. Kazmer testifies that Kazmer-5 supports his view of how an ordinarily skilled artisan would understand the unnumbered element in Figure 1 to be a convex relief of the tool including a counterform to mold the upper part of head 5. Ex. 1007 ¶ 53. Dr. Kazmer testifies:

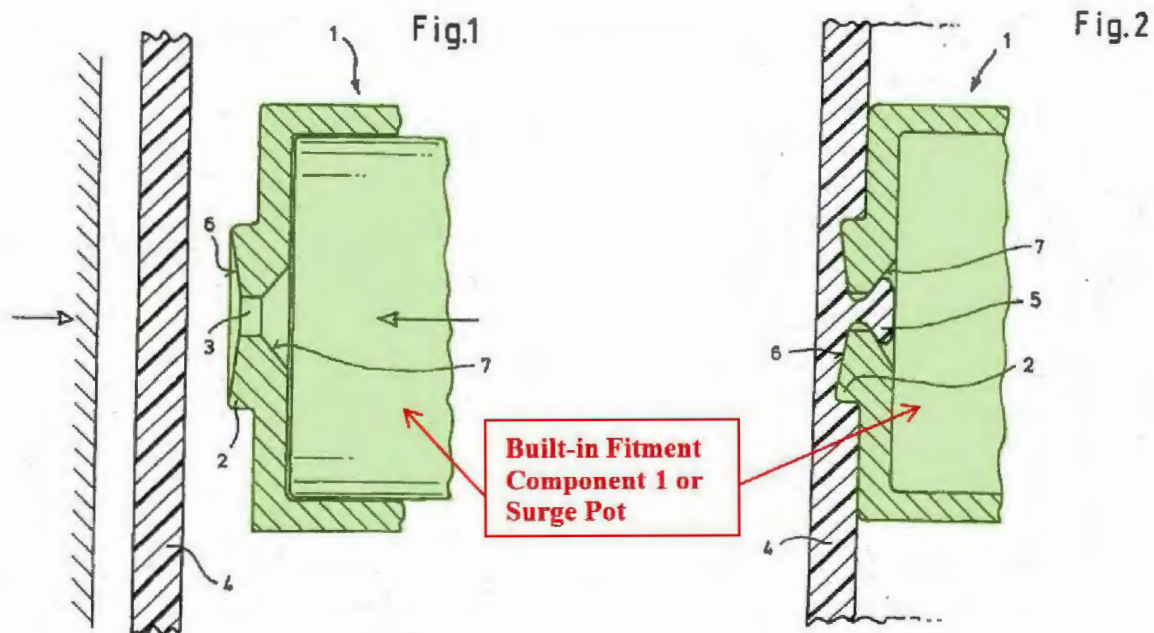


[Borchert's] FIG. 2, highlighted and enlarged . . . in [the] demonstrative Kazmer-5, illustrates how the rivet (colored yellow) is molded by the counterform of the convex relief tool (colored blue) to form a flat head (colored red) that is level with the interior surface of the accessory. As shown, the upper part of rivet head 5 is flat and level with the interior surface of the accessory because it has been formed by the tool pressed into the accessory. A POSITA would thus understand that the convex relief of the tool in Borchert comprises a counterform that molds the upper part of the rivet.

Id.

Patent Owner contends that Borchert fails to describe a “convex relief of the tool” as recited in independent claims 1 and 12. Prelim. Resp. 18–24. Patent Owner argues that “no tooling [is] depicted” in Borchert's Figure 1 and that “Petitioner's blue highlighting . . . is simply a part of the fitment component” 1. *Id.* at 20. Patent Owner relies upon testimony from Tim Osswald, Ph.D. to support its argument. *Id.* (citing Ex. 2001 ¶¶ 33–36). Dr. Osswald testifies that Borchert's Figures 1 and 2 merely illustrate fitment component 1 with the center of component 1 removed in Figure 2. Ex. 2001

¶ 40. Dr. Osswald provides his own colorized and annotated versions of Borchert's Figures 1 and 2, which we reproduce below.



Dr. Osswald's annotated and colorized versions of Borchert's Figures 1 and 2 illustrate his contention that the unnumbered element in Figure 1 (colored green), which is missing in Figure 2, is merely part of Borchert's component 1 (also colored green).

Id. Dr. Osswald further testifies that Borchert's Figures 4, 6, and 7 demonstrate that Borchert describes a tool as "component holders 12," which is a concave element that presses foot 2 into wall 4. *Id.* ¶¶ 33–36. Dr. Osswald also testifies that the blue highlighted element that Petitioner identifies as the claimed tool with a convex relief is "actually the fitment, or surge pot, itself." *Id.* ¶ 39.

The parties thus present a genuine issue of material fact on precisely what an ordinarily skilled artisan would understand the unnumbered element in Borchert's Figure 1 to be. In such circumstances, we must view the testimonial evidence "in the light most favorable to the petitioner solely for purposes of deciding whether to institute an *inter partes* review." 37 C.F.R.

§ 42.108(c). Accordingly, based on Dr. Kazmer's testimony we consider Petitioner to have established a reasonable likelihood that the unnumbered element in Borchert's Figure 1 is a tool with a convex relief as claimed.

At this stage of the proceeding, Patent Owner presents no other argument that Borchert fails to anticipate independent claims 1 and 12. Prelim. Resp. 15–24. Based on our review of the record and arguments currently before us, we also determine that Petitioner has demonstrated a reasonable likelihood of establishing that Borchert describes all other elements of independent claims 1 and 12 and, thus, anticipates those claims.

Petitioner also contends that Borchert anticipates dependent claims 2, 8, 13, and 14, all of which directly depend from claim 1. We exercise our discretion under 37 C.F.R. § 42.108 and also institute *inter partes* review of these claims for this challenge. By exercising our discretion in this regard, we seek to achieve a final resolution of the dispute between the parties at the Board. *See Intex Recreation Corp. v. Bestway Inflatables & Material Corp.*, Case No. IPR2016-00180, 2016 WL 8377184, at *3–5 (PTAB Jun. 6, 2016) (exercising discretion to institute on all challenged claims after determining reasonable likelihood that at least one claim is unpatentable). We note, however, that the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Accordingly, we institute an *inter partes* review to determine whether Borchert anticipates claims 1, 2, 8, and 12–14.

2. *Claim 7: Obviousness in View of Borchert Alone*

Claim 7 depends from claim 1 and further recites: “wherein the tank is blow-moulded from a parison that is made up of two separate parts

obtained by extruding a single parison that is cut over an entire length along two diametrically opposed lines.” Ex. 1001, 8:5–8.

Petitioner contends that Borchert describes blow-molding a tank from a parison that is divided into two parts. Pet. 36–37 (citing Ex. 1003 ¶ 3). Petitioner concedes that Borchert does not expressly describe cutting a parison “along two diametrically opposed lines” as recited in claim 7. *Id.* at 37. However, Petitioner contends that an ordinarily skilled artisan would consider doing so to have been obvious. *Id.* (citing Ex. 1007 ¶ 65). Dr. Kazmer testifies that an ordinarily skilled artisan would have considered it obvious to divide Borchert’s parison into two parts with equal width because Borchert’s mold halves 9a and 9b are shown as being the same width. Ex. 1007 ¶ 65.

Other than its argument that Borchert fails to describe the “convex relief of the tool” recited in claim 1, Patent Owner does not respond to Petitioner’s contentions at this stage of the proceeding. Based on our review of the record and arguments currently before us, we determine that Petitioner has demonstrated a reasonable likelihood of establishing that Borchert renders claim 7 unpatentable as obvious. Accordingly, we institute an *inter partes* review based on this challenge to claim 7.

3. *Claim 7: Obviousness in View of Borchert and Van Schaftingen*

Petitioner recognizes that Borchert does not expressly describe the limitations introduced in claim 7, and relies upon Van Schaftingen as expressly describing “extruding a single parison that is cut over an entire length along two diametrically opposed lines.” Pet. 37–38 (citing Ex. 1004, 3:15–23). Dr. Kazmer testifies that an ordinarily skilled artisan would have been motivated to use Borchert’s process as modified by Van Schaftingen to

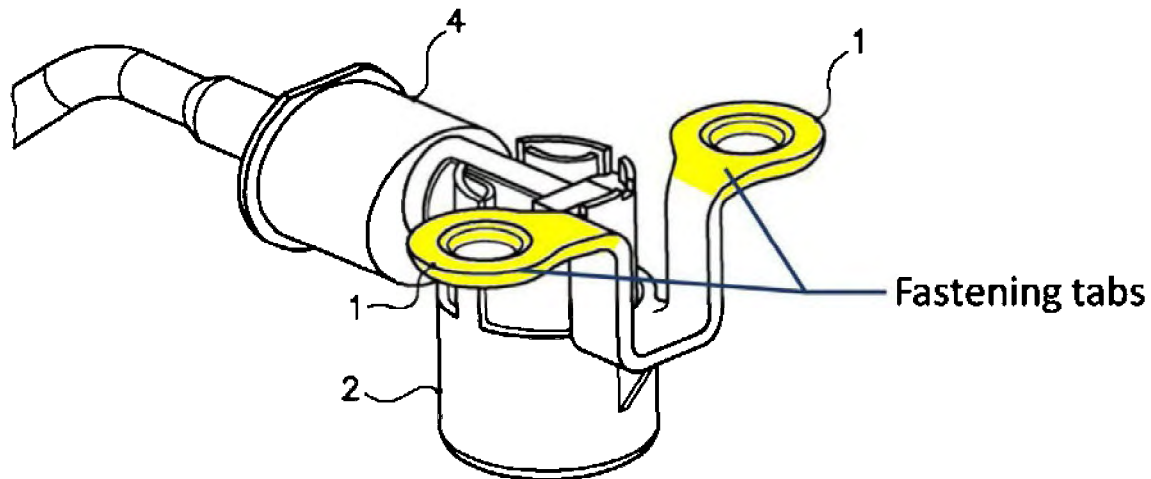
obtain sheets of equal width for use in Borchert's equal-width mold halves 9a and 9b and because Van Schaftingen describes its diametrically opposed cuts as being "very particularly preferred." *Id.* at 38 (citing Ex. 1007 ¶ 68).

Other than its argument that Borchert fails to describe the "convex relief of the tool" recited in claim 1, Patent Owner does not respond to Petitioner's contentions at this stage of the proceeding. Based on our review of the record and arguments currently before us, we determine that Petitioner has demonstrated a reasonable likelihood of establishing that the combination of Borchert and Van Schaftingen renders claim 7 unpatentable as obvious. Accordingly, we institute an *inter partes* review based on this challenge to claim 7.

4. *Claim 2: Obviousness in View of Borchert and Jannot*

Claim 2 depends from claim 1 and further recites: "wherein the snap-riveting orifice is made in a fastening tab moulded as one part with the accessory or attached thereto." Ex. 1001, 7:41–43.

Petitioner contends that Borchert describes the "fastening tab" of claim 2 in connection with its argument that Borchert anticipates claim 2. Pet. 23–25 (equating portions of Borchert's foot 2 with the claimed "fastening tab"). Petitioner alternatively argues that the combination of Borchert and Jannot renders claim 2 unpatentable as obvious. Pet. 39–41. Petitioner contends that Jannot expressly describes a snap-riveting process in which the accessory includes a "fastening tab (i.e. an excrescence on its overall envelope) moulded as one part with the accessory or attached thereto." (Emphasis omitted). Jannot's accessory 2 with fastening tabs 1 (colorized yellow) are illustrated in Petitioner's annotated version of Jannot's Figure 5, reproduced below.



Petitioner’s annotated version of Jannot’s Figure 1 is a perspective view of Jannot’s accessory 2 with flexible tabs 1.

Dr. Kazmer testifies that an ordinarily skilled artisan “would have been motivated to combine Borchert with the flexible fastening tab disclosed in Jannot at least to achieve the benefits disclosed in Jannot at 4:58–62 to ‘compensate for the post-moulding shrinkage which, in the case of HDPE tanks, is about 3%.’” Ex. 1007 ¶ 61.

Other than its argument that Borchert fails to describe the “convex relief of the tool” recited in claim 1, Patent Owner does not respond to Petitioner’s contentions at this stage of the proceeding. Based on our review of the record and arguments currently before us, we determine that Petitioner has demonstrated a reasonable likelihood of establishing that the combination of Borchert and Jannot renders claim 2 unpatentable as obvious. Accordingly, we institute an *inter partes* review based on this challenge to claim 2.

5. Claim 9: Obviousness in View of Borchert and Kachnic

Claim 9 depends from claim 8, which depends from claim 1. Claim 8 recites: “The method according to claim 1, wherein the moulding is carried out using a mould comprising two cavities and a core which at least partly

incorporates the snap-riveting tool, and wherein the accessory is fastened to an inner wall of the tank.” Ex. 1001, 8:9–13. Claim 9 adds: “wherein the core is equipped with a camera allowing visual control of the snap-riveting quality.” *Id.* at 8:14–16.

Petitioner contends that Borchert describes all limitations of claim 8, but fails to describe the requirement introduced in claim 9 that “the core is equipped with a camera allowing visual control of the snap-riveting quality.” Pet. 41. For this requirement, Petitioner relies upon Kachnic’s suggestion of using a camera in a blow molding process to allow visual control of the quality of molded parts. *Id.* at 41–45 (citing Ex. 1006, 1:30–35, 3:57–61, 8:5–25, 8:30–42, 8:46–57, 10:58–61). Petitioner recognizes that “Kachnic does not specifically disclose attaching the camera to a core, when combining Kachnic’s in-mold vision sensor with Borchert’s extrusion blow molding process, the obvious place to locate the camera would be on the core.” *Id.* at 44 (citing Ex. 1006, 8:9–14, 8:30–36; Ex. 1007 ¶¶ 78, 79).

Other than its argument that Borchert fails to describe the “convex relief of the tool” recited in claim 1, Patent Owner does not respond to Petitioner’s contentions at this stage of the proceeding. Based on our review of the record and arguments currently before us, we determine that Petitioner has demonstrated a reasonable likelihood of establishing that the combination of Borchert and Kachnic renders claim 9 unpatentable as obvious. Accordingly, we institute an *inter partes* review based on this challenge to claim 9.

C. SECTION 325(D)

In determining whether to institute *inter partes* review, we may “deny some or all grounds for unpatentability for some or all of the challenged

claims.” 37 C.F.R. § 42.108(b); *see* 35 U.S.C. § 314(a). Our discretionary determination of whether to institute review is, in part, guided by 35 U.S.C. § 325(d), which states, in relevant part:

MULTIPLE PROCEEDINGS — . . . In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, 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).

Our discretion under § 325(d) involves a balance between several competing interests. *See Neil Ziegman, N.P.Z., Inc. v. Stephens*, Case IPR2015-01860, slip op. at 12–13 (PTAB Feb. 24, 2016) (Paper 11) (“While petitioners may have sound reasons for raising art or arguments similar to those previously considered by the Office, the Board weighs petitioners’ desires to be heard against the interests of patent owners, who seek to avoid harassment and enjoy quiet title to their rights.”) (citing H.R. Rep. No. 112-98, pt. 1, at 48 (2011)). “On the one hand, there are the interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously.” *Fox Factory, Inc. v. SRAM, LLC*, Case IPR2016-01876, slip op. 7 (PTAB Apr. 3, 2017) (Paper 8). “On the other hand, there are the interests of giving petitioners the opportunity to be heard and correcting any errors by the Office in allowing a patent—in the case of an inter partes review—over prior art patents and printed publications.” *Id.*

Patent Owner contends that the Office fully considered Borchert during examination of the application leading to the issuance of the ’490 patent. Prelim. Resp. 17. More specifically, Patent Owner contends

that the Examiner “relied extensively on Borchert’s Figure 1” and determined that “Borchert discloses the claimed invention except a convex relief of the tool.” *Id.* at 17–18 (quoting Ex. 1002, 45 and citing Ex. 1002, 7–8, 45–46) (emphasis omitted). Based on this prior review of Borchert, Patent Owner argues that we should exercise discretion under 35 U.S.C. § 325(d) and not institute *inter partes* review of any challenged claim. *Id.* Patent Owner further argues that because “there is no credible reason to suggest that the examiner could have overlooked anything in that figure,” we should deny the Petition in all respects. *Id.* at 18.

Petitioner contends that the Examiner based his rejection of claims “on elements of Borchert’s structure that did not read on those claims.” Pet. 9–10. Petitioner points out that the Examiner first identified Borchert’s contact surface 6 of accessory 1 as the “concave relief” of the accessory and head 5 as the convex relief of the tool. *Id.* at 10 (citing Ex. 1002, 7–8). After argument from the Applicants, the Examiner identified undercut portion 7 as the concave relief and concluded that Borchert did not describe a convex relief of the tool. *Id.* at 11 (citing Ex. 1002, 45).

The same prior art, Borchert, was considered and applied by the Examiner in rejecting broader versions of the claims at issue as anticipated. Nevertheless, we decline to exercise discretion to deny the Petition because Petitioner’s argument for unpatentability based on Borchert substantially differs from the Examiner’s approach. More specifically, we determine that the Examiner never identified or analyzed the unnumbered element shown in Borchert’s Figure 1 upon which Petitioner now relies as constituting the convex relief of the tool. Thus, we are presented with distinct arguments that do not overlap with the arguments made during examination.

The evidence presented by Petitioner also differs from that which the Examiner considered. We consider Dr. Kazmer's testimony to be probative on the issue of how an ordinarily skilled artisan would view the unnumbered element of Borchert that the Examiner did not discuss. Dr. Kazmer's testimony, along with the distinct arguments made by Petitioner, present additional evidence and facts that warrant reconsideration of the same prior art.

For the reasons expressed in Part II.B.1 above, we determine that a trial is warranted to determine whether Petitioner's evidence demonstrates by a preponderance of evidence that Borchert describes the claimed convex relief of the tool along with all other elements of the claims. Accordingly, we do not exercise discretion to deny *inter partes* review under 35 U.S.C. § 325(d).

III. CONCLUSION

For the reasons expressed above, we determine that Petitioner has demonstrated a reasonable likelihood of showing that the challenged claims are unpatentable on all alleged grounds of unpatentability. This Decision does not reflect a final determination on the patentability of any claim or any factual or legal issue related to such patentability.

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review is instituted of claims 1, 2, 7–9, and 12–14 of the '490 patent with respect to the following grounds of unpatentability:

- (1) Borchert anticipates claims 1, 2, 4, and 7 under 35 U.S.C. § 102(b);

- (2) Borchert in view of the background knowledge of an ordinarily skilled artisan renders claim 7 unpatentable under 35 U.S.C. § 103;
- (3) the combination of Borchert and Van Schaftingen renders claim 7 unpatentable under 35 U.S.C. § 103;
- (4) the combination of Borchert and Jannot renders claim 2 unpatentable under 35 U.S.C. § 103; and
- (5) the combination of Borchert and Kachnic renders claim 9 unpatentable under 35 U.S.C. § 103; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '490 patent is instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the institution of a trial.

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Patent 9,079,490 B2

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