

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CLEARONE, INC.,
Petitioner,

v.

SHURE ACQUISITION HOLDINGS, INC.,
Patent Owner.

IPR2019-00683
Patent 9,565,493 B2

Before MICHAEL R. ZECHER, JON M. JURGOVAN, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

JURGOVAN, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of Final Written Decision of
Inter Partes Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

A. Background

A Final Written Decision (Paper 91) in this *inter partes* review was entered on August 14, 2020. In the Final Written Decision, the panel determined that Petitioner, ClearOne, Inc., had shown by preponderance of the evidence unpatentability of claims 1–5, 7–33 and 35–40 of the challenged patent, U.S. Patent No. 9,656,493 B2 (Ex. 1001, the “’493 Patent”). Paper 91, 2. However, the panel determined that Petitioner had not demonstrated unpatentability of claims 6 and 34. *Id.* In addition, the panel granted a Revised Contingent Motion to Amend (Paper 57) filed on March 13, 2020 by Patent Owner, Shure Acquisition Holdings, Inc., as to proposed substitute claims 57–67 only. Paper 91, 2. These claims recite, *inter alia*, limitations including a “sound-permeable screen [that] covers from view the plurality of microphones” and “side rails that secure the front face of the housing to a second face of the housing.” Paper 57, Appendix A (Claim Listing), 5–9.

On August 24, 2020, Petitioner filed a Request for Rehearing (Paper 92) (“Req. Reh’g”) of the Final Written Decision, seeking rehearing and reversal of the determination that proposed substitute claims 57–67 are patentable. Req. Reh’g 1. Petitioner contends two references not of record in the proceeding—(1) U.S. Patent Application Pub. No. 2009/0173570 A1 (“Levit”); and (2) U.S. Patent Application Pub. No. 2009/0173030 A1 (“Gulbrandsen”)—respectively teach the claimed “sound-permeable screen” and “side rails” recited in proposed substitute claims 57–67. Req. Reh’g 1. According to Petitioner, the “sound-permeable screen” and “side rails”

limitations were “key limitations that were the focus of intense dispute in this trial.” *Id.*

Petitioner contends Levit and Gulbrandsen came to its attention when Patent Owner filed a petition for post-grant review, PGR2020-00079, Paper 1 (July 28, 2020), against Petitioner’s patent roughly three weeks before the panel entered the Final Written Decision in this proceeding. Req. Reh’g 1. Petitioner contends Patent Owner was aware of the materiality of these references to the proposed substitute claims in this proceeding and failed to comply with its duty of disclosure when it filed its Revised Motion to Amend on March 13, 2020. Req. Reh’g 1, 4. For this reason, Petitioner seeks rehearing and reversal of the determination that proposed substitute claims 57–67 are patentable. *Id.* at 1.

Petitioner also sought authorization to file a motion for sanctions against Patent Owner for failing to disclose Levit and Gulbrandsen, which Judges Zecher and Jurgovan denied by Order (Paper 95) dated November 2, 2020. In that Order, the judges concluded that Petitioner’s allegations regarding a violation of the duty of disclosure were insufficient. *Id.* at 4–9.

With this background, we now consider whether rehearing is warranted to reconsider patentability of proposed substitute claims 57–67 in view of Levit and Gulbrandsen.

B. Standard for Reconsideration

The party challenging a Board decision has the burden of showing the decision should be modified, and the request for rehearing must specifically identify all matters the party believes the Board misapprehended or overlooked and the place where each matter was previously addressed in its papers. 37 C.F.R. § 42.71(d).

II. ANALYSIS

A. *No Basis for Rehearing Shown*

In its Request for Rehearing, Petitioner does not allege that the Board misapprehended or overlooked any matter in rendering the Final Written Decision. *See generally* Req. Reh’g. This is because the references that Petitioner asks us to consider, Levit and Gulbrandsen, were never mentioned in this proceeding until the Request for Rehearing. Petitioner had the opportunity to unearth and bring the references forward against proposed substitute claims 57–67 in Petitioner’s Opposition to Patent Owner’s Revised Motion to Amend (Paper 68) filed April 23, 2020, but the Opposition does not mention them. It would be impossible for us to misapprehend or overlook information that was never brought to our attention before rendering the Final Written Decision. Thus, based on the standard for rehearing set forth in Rule 42.71(d), Petitioner does not establish a basis for rehearing.

Petitioner asserts that the Board “should waive any unmet requirements of that rule . . . to prevent a manifest injustice.” Req. Reh’g 2. Petitioner further asserts that the Board has authority to withdraw the Final Written Decision. *Id.* at 8. As explained below, Petitioner has not shown a manifest injustice or otherwise established that the Board’s determination that proposed substitute claims 57–67 are patentable should be reconsidered.

First, Petitioner’s delay in raising Levit and Gulbrandsen contravenes the notion that manifest justice requires consideration of the references in this proceeding. Petitioner admits awareness of Levit and Gulbrandsen roughly three weeks before the Final Written Decision, and yet mentioned nothing about them. *See* Req. Reh’g 1. It was only after Petitioner received

the Final Written Decision and understood it to state that the “sound-permeable screen” and “side rails” limitations were important to patentability of proposed substitute claims 57–67 that Petitioner brought these references forward. *See id.* In effect, Petitioner asks us for another opportunity to challenge the proposed substitute claims after a decision has been rendered, based on a tenuous tie to the rehearing requirement. As Petitioner fails to demonstrate the Board misapprehended or overlooked any matter in rendering our Final Written Decision, Petitioner has not met its burden to bring these references into this proceeding.

Second, even accepting Petitioner’s characterizations of Levit and Gulbrandsen, Petitioner has not shown that there is a “manifest injustice” (Req. Reh’g 2) or that the result would be any different if these references were considered in this proceeding. Specifically, Petitioner has not shown that Levit’s “sound-permeable screen” is materially different from the screen disclosed in Graham (Ex. 1011) or the Graham patent (Ex. 1040), both of which Petitioner relied on in the Opposition (Paper 68, 9–11). Petitioner likewise fails to show how Gulbrandsen’s “side rails” are any different than similar structures in Graham (Ex. 1011), the Graham patent (Ex. 1040), Kulicke (Ex. 1122), Zelbacher (Ex. 1123), Oberbroeckling (Ex. 1124), Stewart (Ex. 1126), aluminum Pomona boxes, hobby boxes for PCBs, return air filter grilles for drop ceilings, and Sawa’s main casing, all of which Petitioner relied on in its Opposition (Paper 68, 11–12). In other words, based on Petitioner’s characterizations, Levit and Gulbrandsen appear to be cumulative of reference teachings already cited in Petitioner’s Opposition. Petitioner also does not show how the proposed combinations would be different from the combinations already considered by the Opposition. Nor

does Petitioner show that Graham or the Graham patent combined with Levit and/or Gulbrandsen yields two housing faces secured together with “side rails.” *See* Paper 91, 114–115 (concluding proposed substitute claims 57–67 patentable over various combinations of prior art references failing to disclose the “side rails” limitations).

Petitioner thus has not shown that reconsideration of the determination of patentability of proposed substitute claims 57–67 is warranted.

B. No Good Cause Shown to Introduce New Evidence

Petitioner appears to seek introduction of Levit and Gulbrandsen into the record for this proceeding after the Final Written Decision. *See, e.g.*, Req. Reh’g 1 (citing PGR2020-00079, Exs. 1016, 1018), 8–14 (arguing that Levit and Gulbrandsen disclose the “sound-permeable screen” and “side rails” limitations of proposed substitute claims 57–67). Specifically, Petitioner asserts that each of these references “can be submitted as supplemental information per 37 C.F.R. § 42.123(B), whose requirements are clearly met, if the Board would like.” *Id.* at 1.

New evidence is not permitted in a request for rehearing without a showing of good cause. *See Huawei Device Co., Ltd. v. Optis Cellular Technology, LLC*, IPR2018-00816, Paper 19 (PTAB January 8, 2019) (precedential). In this case, Petitioner appears to attempt to show good cause, though not expressly stating so, through the allegation that Patent Owner violated its duty of disclosure. Req. Reh’g 1–2. In the Order (Paper 95), the Board found Petitioner’s allegation insufficient, and did not permit briefing on a motion for sanctions for violating the duty of disclosure. Because Petitioner presents no other basis for good cause, the Board

declines to admit the new evidence of Levit and Gulbrandsen into this proceeding.

III. CONCLUSION

For the reasons expressed above, the Board determines that Petitioner has failed to demonstrate that we misapprehended or overlooked any matter in rendering our Final Written Decision. Accordingly, we decline to change our Final Written Decision and, thus, deny Petitioner's Request for Rehearing.

IV. ORDER

For the reasons given, it is

ORDERED Petitioner's Request for Rehearing of the Final Written Decision is *denied*.

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