

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GN RESOUND A/S,
Petitioner,

v.

OTICON A/S,
Patent Owner.

Case IPR2015-00103
Patent 8,300,863 B2

Before NEIL T. POWELL and FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

GN Resound A/S (“Petitioner”) filed a Request for Rehearing (Paper 12, “Rehearing Request” or “Req.”) of the Decision to Institute dated April 29, 2015 (Paper 10, “Decision” or “Dec.”). Petitioner requests reconsideration of the Decision’s denial of challenges to claims 6–8 and 14 of U.S. Patent No. 8,300,863 B2 (“the ’863 patent) asserted in the Petition. Specifically, Petitioner seeks reconsideration of our decision to deny institution of *inter partes* review of claims 6–8 and 14 of Oticon A/S’s (“Patent Owner”) U.S. Patent No. 8,300,863 B2 (Ex. 1001, “the ’863 patent”) on the following grounds:

1. Claims 6–8 and 14 as obvious under 35 U.S.C. § 103(a) over Meskens¹ and Yoshino ’289²;
2. Claims 6, 7, and 14 as obvious under 35 U.S.C. § 103(a) over Halstead³ and Yoshino ’289; and
3. Claim 8 as obvious under 35 U.S.C. 103(a) over Halstead, Yoshino ’289, and Meskens.

Req. 2.

For the reasons set forth below, the request for rehearing is *denied*.

II. ANALYSIS

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion may be determined if a decision is based on an erroneous

¹ U.S. Patent Publication No. 2008/0304686 A1, published Dec. 11, 2008 (Ex. 1004, “Meskens”).

² U.S. Patent Publication No. 2005/0245289 A1, published Nov. 3, 2005 (Ex. 1006, “Yoshino ’289”).

³ U.S. Patent No. 2,535,063, issued Dec. 26, 1950 (Ex. 1010, “Halstead”).

interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The request must identify, with specificity, all matters that the moving party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

A. Alleged Misapprehension or Oversight Relating to the Combination Meskens and Yoshino ’289

In its Request for Rehearing, Petitioner argues that our Decision misapprehended and overlooked the Petition’s discussion of Meskens’s outer body 171 as disclosing a “shield element” recited in claim 6. Req. 5. Petitioner argues that the Petition “clearly identifies the ‘outer body 171’ of Meskens as the electrically conducting element (which is the shield element, either in whole or in part) several times in its analysis of claim 6. (See Petition at 20-22; analysis of claims [6c], [6d], [6e], and [6f].)” *Id.* Referring to the claim chart on pages 20–22 of the Petition, Petitioner asserts that

with respect to the latter half of element [6f] in particular, the quoted language of Meskens matches the ‘863 claim language, which further shows that the outer body 171 of Meskens is the shield element:

Claim 6	Meskens (Ex. 1004) ¶ 41
wherein said coupling element comprises	...the twin-axial connector 170 of FIG. 3B comprises
two wires for transmitting said signal to said output transducer	two electrically conductive receptacles 173,
and a shield element for shielding said wires	in addition to a conductive outer body 171.

A review of the figure referenced in the Petition, FIG. 3B of Meskens (excerpt shown below), clearly shows that outer body 171, which is conductive and operates as the antenna (Petition at 20-21), shields the two electrically conductive receptacles 173.

Req. 7. Additionally, Petitioner argues in its Request for Rehearing that the claim chart on page 22 of the Petition shows that the secondary reference, Yoshino '289, explicitly identifies a shield element. Req. 9.

Petitioner's arguments are not persuasive. Initially, we note that the claim chart provided on page 7 of the Request for Rehearing is not in the Petition. Rather, the relevant sections of pages 21–22 of the Petition are as follows:

Claim 6	Meskens (Ex. 1004) in view of Yoshino '289 (Ex. 1006)
	[0038] The outer body 171 is configured to operate as, or function as, as part of an electromagnetic antenna for transmitting or receiving signals.
[6e] a wireless interface for receiving and/or sending data through said antenna,	Meskens describes a wireless interface for receiving and/or sending data through said antenna. [0039] RF transceiver 120 is connected to the outer body 171.
[6f] wherein said electrically conducting element is operatively coupled to said wireless interface and functions as at least a part of said antenna by wirelessly receiving or transmitting RF signals, and wherein said coupling element comprises two wires for transmitting said signal to said output transducer and a shield element for shielding said wires, wherein said electrically conducting element comprises said shield element, and	Meskens describes the electrically conducting element operatively coupled to said wireless interface and functioning as at least a part of said antenna by wirelessly receiving or transmitting RF signals. [0038] In certain embodiments, outer body 171 operates as an open-ended wire, a monopole, sub, helix or helical wound coil, meander or dipole electromagnetic antenna. [0039] RF transceiver 120 is connected to the outer body 171. [0048] The lead 430 is naturally preferred object for use as radiating/receiving element and lends itself as an extension of antenna 170. Meskens describes the coupling element comprising two wires for transmitting said signal to said output transducer and a shield element for shielding said wires, wherein said electrically conducting element comprises said shield element. [0041] As shown, the twin-axial connector 170 of FIG. 3B comprises two electrically conductive receptacles 173, in addition to a conductive outer body 171. Hence, the receptacles 173, which are electrically shielded from each other, constitute a jack for transmitting and/or receiving electrical

Inter Partes Review of U.S. Patent No. 8,300,863

Claim 6	Meskens (Ex. 1004) in view of Yoshino '289 (Ex. 1006)
	signals, such as audio signals, to and from an auxiliary device 440 attached thereto. [0051] Lead 430 may conduct low-band electrical signals (e.g. audio signals) from BTE prosthetic device 100 to the auxiliary device 440 or vice versa. <i>See also Fig. 6B, "optional wire": [0038] and</i>

Pet. 21–22. Moreover, in the Decision to Institute, we acknowledged that the claim chart on pages 21–22 of the Petition refers to Meskens’s twin-axial connector 170, outer body 171, receptacles 173, lead 430, and the “optional wire” shown in Figure 6B. Dec. 14–16. However, the claim chart *presented in the Petition* (shown above) does not “clearly” or otherwise identify which of these Meskens component(s) allegedly teaches or suggests the recited “shield element.” The Petition does not explain, as Petitioner argues now in its Request for Rehearing, that a review of Meskens Figure 3B “clearly shows that outer body 171, which is conductive and operates as the antenna (Petition at 20-21), shields the two electrically conductive receptacles 173.” *See e.g.*, Pet. 21–22; Req. 9. Thus, we could not have overlooked or misapprehended these arguments that were not presented in the Petition.

Additionally, Petitioner argues that it relies on the explicit disclosure in Yoshino ’289 for the recited “shield element.” Req. 8–9. Although we agree with Petitioner that the quoted passages from Yoshino ’289 are present in the claim chart on page 22 of the Petition, we are not persuaded that bare citations and quotes provide a sufficiently detailed explanation of how the asserted references teach or suggest the claimed limitations. Essentially, Petitioner requires the Board to search through the cited portions of both Meskens and Yoshino ’289 to map prior art disclosure with claim elements. It is a requirement of a Petition to align the evidence and arguments with the various limitations of the challenged claims. *See* 37 C.F.R. § 42.22(a)(2) (the “petition . . . must include . . . [a] full statement of the reasons for the relief requested, including *a detailed explanation of the significance of the evidence*” (emphasis added)). Petitioner should not expect us to infer or create arguments from the record. Accordingly, we are not persuaded on

this basis that we erred in determining that the Petition was deficient.

Petitioner further argues that our Decision failed to consider Petitioner's arguments for claims 7 and 14, which depend from independent claim 6. Req. 9–11. Petitioner's arguments are unpersuasive. Our determination that Petitioner did not meet the threshold requirements for institution of *inter partes* review of claim 6, under 35 U.S.C. § 103, based on Meskens and Yoshino '289, applied with equal force to claims 7, 8, and 14, which depend from claim 6 and require the limitations recited in claim 6. *See* Dec. 14.

Further, we are not persuaded that we misapprehended or overlooked any argument or evidence with respect to claims 7 and 14. To start, we are not persuaded by Petitioner's argument that the discussion on pages 22–24 of the Petition, specifically pertaining to the additional elements recited in claims 7 and 14, clarify the Petitioner's arguments for the “shield element” required in claim 6. Req. 9. Pages 22–24 do not state any such clarification or application of arguments for claims 7 or 14 to claim 6. Moreover, the Petition, unlike the Request for Rehearing, does not present the arguments that Meskens “clearly show[s] that a wireless interface (transceiver 120) is coupled to a *shield element (outer body 171)* via a high-pass filter (high pass filter 130),” Req. 10 (emphasis added), or “that a wireless interface (transceiver 120) is connected (see connections above) to a *shield element that is a conductive wire (outer body 171, lead 430, optional wire)*,” *id.* at 11 (emphasis added). For example, page 24 of the Petition does not state that “shield element” is outer body 171, lead 430, optional wire. In fact, there is no explanation of how the quoted/cited passages in the claim chart apply to the shield element recited in independent claim 6. Pet. 24.

B. Alleged Misapprehension or Oversight Relating to the Combination of Halstead and Yoshino '289 and Halstead, Yoshino '289, and Meskens

Petitioner also argues that we misapprehended and overlooked evidence that Halstead discloses a “shield element.” Req. 12. In its Request for Rehearing, Petitioner provides a color annotated version of the claim chart presented on page 39 of the Petition (reproduced below).

Claim [6f] (in part)	Halstead (Ex. 1010)
wherein said coupling element comprises two wires for transmitting said signal to said output transducer and a shield element for shielding said wires, wherein said electrically conducting element comprises said shield element	<p>Halstead describes the coupling element comprising two wires for transmitting said signal to said output transducer and a shield element for shielding said wires, wherein said electrically conducting element comprises said shield element.</p> <p>“The antenna 20 is combined with the transducer conducting lead wires 21 into a single flexible cable.” (3:57-59)</p> <p>“Audio frequency signal energy is applied to the conductors 21 of the earphone cord, which conductors are connected to the reproducing system of transducer 18, and the consequent sound waves are impressed upon the wearer's auditory nerves via the usual inter-aural acoustical path.” (6:39-45)</p> <p>“... a combination telephone cord and antenna, comprising a twin conductor extending to said earphone and conducting speech frequency currents thereto and therefrom, an antenna formed as a metallic cylinder surrounding and coaxial with the mean centre of said twin conductor....” (7:5-11)</p>

Id. Based on the annotated chart, Petitioner argues that the Petition explained sufficiently how Halstead discloses a shield element. *Id.* Presumably, Petitioner argues now, in its Request for Rehearing, that the text highlighted in green quoted from Halstead allegedly satisfies the “shield element” recited in claim 6. Nonetheless, these arguments are unpersuasive

because the annotated claim chart and, more specifically, the color-coded mapping of claim elements to the prior art disclosure were not presented in the Petition. Pet. 39–40.

Petitioner further contends that the Petition relies on Yoshino '289 for the shield element because “Yoshino '289’s shield element surrounds a cable in the same way that Halstead’s antenna surrounds its twin conductors (i.e., metallic and coaxial).” These arguments also are unpersuasive because we could not have overlooked or misapprehended arguments pertaining to Yoshino '289 that were not presented in the Petition. Pet. 39–40.

Finally, Petitioner argues the Board recognized Halstead’s lead wires were surrounded by shielding elements. Req. 13 (citing Dec. 26). Specifically, Petitioner cites to page 26 of the Decision to Institute, which contains a summary of the disclosure provided in Halstead. However, our summary does not make any finding or determination as to whether the disclosure in Halstead teaches or suggests any claim element of the challenged claims (including claim 6). Dec. 26. Further, we did not indicate in the summary of Halstead, and particularly page 26, whether any component surrounding lead wires 21 provide shielding. *Id.* Moreover, to the extent that the Decision to Institute “recognized” features in Halstead, we are not persuaded that this discussion in the Decision to Institute can remedy deficiencies in the Petition. It is the Petition, not the Decision to Institute, that must contain the evidence and arguments sufficient to satisfy Petitioner’s threshold burden under 35 U.S.C. § 314.

Accordingly, we are not persuaded that we abused our discretion on this basis. Thus, for the foregoing reasons, Petitioner has not shown that the Board abused its discretion in denying institution of *inter partes* review of

IPR2015-00103
Patent 8,300,863 B2

claims 6–8 and 14 based on Meskens, Yoshino '289, and Halstead.

IV. ORDER

Accordingly, it is hereby ORDERED that Petitioner's request for rehearing is *denied*.

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