

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

A.C. DISPENSING EQUIPMENT INC.,
Petitioner,

v.

PRINCE CASTLE LLC,
Patent Owner.

Case IPR2014-00511
Patent 8,534,497 B2

Before LINDA M. GAUDETTE, DONNA M. PRAISS, and
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

PRAISS, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner filed a Request for Rehearing (Paper 12, “Req. Reh’g”) of the Decision mailed August 11, 2014 (Paper 10, “Dec.”), which instituted *inter partes* review of claims 1-12 of U.S. Patent No. 8,534,497 B2 (Ex. 1001, “the ’497 patent”). In its request, Petitioner seeks reconsideration of our decision not to institute *inter partes* review with respect to grounds 5-9 based on Wang (Ex. 1003) and Ring (Ex. 1004). Req. Reh’g 1. The Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

In determining whether to institute an *inter partes* review of a patent, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b). When rehearing a decision on a petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing an abuse of discretion, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

III. ANALYSIS

In the Decision, we denied Petitioner’s challenges based on the combination of Wang and Ring because the Corrected Petition (Paper 4, “Pet.”) did not identify evidence of record to show the prior art combination discloses the claim limitation “user-specified volume of liquid” or “user-

requested volume of liquid.” Dec. 15. Petitioner asserts that this finding should be reconsidered and reversed because (1) the claim limitation is the same as a “desired acquisition volume V” recited in Wang and mentioned in the Petition, (2) the claim limitation was addressed in the Miltzer Declaration (Ex. 1007), (3) the claim limitation is met by a predetermined amount of liquid in Wang, and (4) the evidence submitted by Petitioner was not considered in the Decision. Req. Reh’g 1-2. Petitioner also argues that the Board abused its discretion in denying the Petition with respect to grounds 5-9 because the overlooked claim limitation is “commonplace.” *Id.* at 7-8.

The Corrected Petition

In support of the assertion that “a ‘desired acquisition volume V’ as set forth in the Petition is a ‘user-specified’ or ‘user-requested volume’” (*id.* at 1), Petitioner restates the following from the Petition:

The apparatus is now ready for “dispensing a user-specified volume of liquid” as recited in claim 1. The apparatus applies the stored polynomial expression to the height of liquid to determine the period of time for keeping the valve open to dispense a liquid volume V. (Ex. 1003, p. 8, 1.26-32)

Req. Reh’g 2 (quoting Pet. 40). Petitioner explains that “[v]olume V is specifically defined at the citation in Wang as ‘the desired acquisition volume.’” *Id.* (citing Ex. 1003, p.8, 1.29). Petitioner further reasons in the Request for Rehearing that “whether the volume is specified [as recited in challenged claims 1 and 11], requested [as recited in challenged claim 11] or desired [as quoted from Wang], in all cases the user is getting the wanted

volume of liquid because the claimed dispensing method is being performed.” *Id.*

Petitioner also refers to the claim charts for independent claims 1 and 11 to show that Wang is cited for the “user-specified volume” claim limitations. Req. Reh’g 2-3. The claim chart for independent claim 1 is said to cite Wang page 8, lines 29-31, for teaching an apparatus “designed to ‘precisely control the opening time of the valve to be T, thereby completing the quantitative acquisition of the liquid.’” *Id.* at 2 (citing Pet. 51).

Petitioner explains in the Request for Rehearing that “[s]etting the variable V satisfies the requirement for specifying or requesting the volume V.” *Id.* The claim chart for independent claim 11 is said to show that the claimed “user-requested volume” corresponds to Wang’s “desired acquisition volume V” because “[a] user operating the Wang apparatus to dispense a volume V of liquid necessarily ‘requests’ a volume V.” *Id.* at 3 (citing Pet. 58).

We did not abuse our discretion in determining Petitioner did not present evidence establishing that the combination of Wang and Ring teaches the required user-specified volume. None of the passages in the Corrected Petition and claim charts that Petitioner cites in its Request for Rehearing clearly correlates a teaching in Wang, either “a predetermined amount of liquid” or “a desired acquisition volume,” to the required “user-specified volume” of independent claims 1 and 11. *Cf.* Pet. 2-3, 51, 58. Indeed, the Request for Rehearing has to connect the dots in three different documents to explain that its obviousness argument over the combination of

Wang and Ring encompasses the “user-specified volume” limitation required by the claims. The Request for Rehearing skips over the fact that no citation to Wang appears after the statement on page 40 of the Petition describing the Wang apparatus being ready for “dispensing a user-specified volume”. The Request for Rehearing directs us to the Wang citation on page 40 of the Petition after a statement concerning Wang’s polynomial expression, not the claimed user-requested volume. The Request for Rehearing quotes “the desired acquisition volume” from line 29 on page 8 of Wang (Req. Reh’g 2), however, this portion of Wang that is said to correspond to the required user-specified volume of claims 1 and 11 is not quoted and attributed to page 8 of Wang in the Corrected Petition or claim chart. *See* Pet. 40, 51-59.

Petitioner’s attempt to connect the dots in its Request for Rehearing in order to flesh out its obviousness argument over the combination of Wang and Ring, as well as Petitioner’s admission that an allegedly commonplace limitation was overlooked, indicates the Corrected Petition did not make the necessary showing that Petitioner has a reasonable likelihood of prevailing on the obviousness grounds based on Wang in combination of Ring. A request for rehearing is not an opportunity to present new arguments or evidence that could have been presented in the petition. 37 C.F.R. § 42.104(b)(5). “The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.” *Id.* Petitioner should not expect the Board to search the record and piece together the evidence necessary to

support Petitioner's arguments. *Cf.*, *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999) ("A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.").

Accordingly, we will not consider arguments that were not made in the Corrected Petition.

The Miltzer Declaration

Petitioner quotes from paragraphs 30 and 32 of the Miltzer Declaration which conclude that Wang describes determining or calculating an open valve time "to dispense a user-specified volume of liquid." Req. Reh'g 3. Petitioner argues in the Request for Rehearing that these statements in the Miltzer Declaration "clearly equated the desired acquisition volume V [of Wang] with the user-specified volume [of claims 1 and 11]." *Id.* at 4. Petitioner does not state in the Request for Rehearing where in the Petition these sections of the Miltzer Declaration were relied upon to support Petitioner's obviousness argument over the combination of Wang and Ring. A review of pages 38 through 59 of the Corrected Petition indicates that paragraphs 30 and 32 of the Miltzer Declaration are not cited in support of grounds 5-9. *See* Pet. 38-59.

The practice of citing the Declaration to support conclusory statements that are not otherwise supported in the Petition amounts to incorporation by reference. It is improper to incorporate by reference arguments from one document into another document. 37 C.F.R. § 42.6(a)(3). One purpose of the prohibition against incorporation by reference is to eliminate abuses that arise from incorporation. Rules of

Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,617 (Aug. 14, 2012); *see also DeSilva*, 181 F.3d at 866-67 (Incorporation “by reference amounts to a self-help increase in the length of the [] brief[,]” and “is a pointless imposition on the court’s time.”).

Accordingly, we will not consider arguments that are not made in the Corrected Petition nor will we consider arguments incorporated by reference to the belatedly cited paragraphs of the Militzer Declaration.

The Wang Reference

Petitioner argues that “the Board refers to Wang as dispensing a predetermined amount of liquid” and concludes “that is perfectly consistent with the invention claimed in the ’497 patent.” Req. Reh’g 4. However, Petitioner concedes it did not rely on the dispensing of predetermined amounts of liquid in its Corrected Petition. *Id.* Petitioner also argues that “[t]he mechanics of programming or specifying the volume V is not an element of the method claims of the ’497 patent.” *Id.* The support for this argument comes from a claim construction analysis in an unrelated proceeding. *Id.* at 4-5. Petitioner did not argue a claim construction for “user-specified volume” in the Corrected Petition.

Again, we will not consider arguments that are not made in the Corrected Petition.

The Decision

Petitioner argues that “the Decision fails to confront the fact that Wang allows a user to obtain a desired acquisition volume corresponding to

the user-specified or user-requested volume.” *Id.* at 5. Petitioner points to the unsupported statement, quoted *supra* from page 40 of the Corrected Petition, that “[t]he apparatus is now ready for ‘dispensing a user-specified volume of liquid’ as recited in claim 1” (*id.*), and to the claim charts in the Corrected Petition as its showing that a desired acquisition volume corresponds to the claimed user-specified or user-requested volume (*id.* at 6).

For the reasons discussed above, we will not consider arguments that are not made in the Corrected Petition nor will we play archeologist with the Wang reference and the Miltzer Declaration to determine what the Petitioner meant to argue in support of grounds 5 through 9. Petitioner now argues that the “desired acquisition volume” described on page 8 of Wang, but not quoted or explained on page 40 of the Corrected Petition, is the claimed “user-specified volume” that paragraphs 30 and 32 of the Miltzer Declaration concludes is taught by Wang, but is not cited in support of grounds 5 through 9. Because Petitioner did not make these arguments in the Corrected Petition, Petitioner has not shown that we abused our discretion by not instituting an inter partes review of the ’497 patent on grounds 5 through 9.

IV. ORDER

Accordingly, it is hereby ORDERED that Petitioner’s Request for Rehearing is *denied*.

IPR2014-00511
Patent 8,534,497 B2

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