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Paper 14
Entered: December 18, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BILLY GOAT INDUSTRIES, INC.,
Petitioner,

v.

SCHILLER GROUNDS CARE, INC.,
Patent Owner.

Case IPR2014-00742
Patent 8,469,113 B2

Before BARRY L. GROSSMAN, MITCHELL G. WEATHERLY, and
JAMES A. TARTAL, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION
ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

Billy Goat Industries, Inc. (“Petitioner”) timely filed a Request for Panel Rehearing (Paper 11, “Req. Reh’g.”) requesting rehearing of our decision (Paper 8, “Decision”) instituting *inter partes* review of claims 1, 5, 6, and 10 of U.S. Patent No. 8,469,113 B2 (Ex. 1002, “the ’113 patent”). For the reasons stated below, we deny Petitioner’s request.

II. DISCUSSION

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The burdens and requirements of a request for rehearing are stated in 37 C.F.R. § 42.71(d):

(d) Rehearing. . . . The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

In its Petition, Petitioner sought *inter partes* review of claims 1, 5, 6, and 10 of the ’113 patent as under 35 U.S.C. § 103(a) first as obvious over Hamilton¹ and Groundsman² and second as obvious over BlueBird Manual³ and Hamilton. Decision 4. We instituted *inter partes* review of claims 1, 5, 6, and 10 as obvious over BlueBird Manual and Hamilton. We did not institute *inter partes* review based on Hamilton and Groundsman. *Id.* at 2, 31–32.

¹ GB 2 410 284 A, Ex. 1004.

² Pedestrian Operated Turf Cutter Model TC300 Parts Manual, Ex. 1005.

³ Parts Manual Model: SC550A/968999351, Manual No. 539 11 32-31 REV.01, Ex. 1006.

Petitioner requests reconsideration of our decision not to institute *inter partes* review based on Hamilton and Groundsman because, in Petitioner's view, our Decision adopted inconsistent positions regarding the phrase "secured to a [first/second] side of the enclosure" (referred to as the "secured to" phrase). Req. Reh'g. 2–4. Based on Petitioner's asserted construction, Petitioner requests that we reconsider the denial of *inter partes* review based on Hamilton and Groundsman. *Id.* at 1. Petitioner also asserts that we overlooked Exhibits 1008 and 1009 in the context of our claim construction. *Id.* at 4–5.

Claim Interpretation

The claim phrase at issue is "a first plate secured to a first side of the enclosure and a second plate secured to a second side of the enclosure," which is in independent claim 1 (the "secured to" phrase). Petitioner argued that the "secured to" phrase should be construed "*to require direct contact (i.e., no spacing)*, and specifically to mean 'fixed to a [first/second] side of the enclosure *without being spaced apart* from the [first/second] side of the enclosure'." Pet. 5 (emphasis added). Patent Owner took a different position and asserted that this phrase "should be given [its] plain and ordinary meaning." Decision 6, *citing* Prelim. Resp. 6.

The following disclosure from the Specification of the '113 patent describes the relationship of the parts recited in the "secured to" phrase:

The first and second plates 40, 42 are secured, and preferably bolted, to respective first and second sides 20a, 20b of the gear casting housing 20. However, it will be understood by those skilled in the art that the plates 40, 42 may be attached to the gear casting housing 20 by any appropriate alternative means, such as by welding, and

that the positions of the first and second plates 40, 42 may be inverted.

Ex. 1002, col. 6, ll. 34–40.

Petitioner cited the quoted disclosure from the Specification (Pet. 5), and also relied on the prosecution history for Petitioner’s proposed interpretation of the “secured to” phrase (*id.*).

In our Decision, we discussed in detail the construction of the “secured to” phrase (Dec. 5–8). We addressed specifically Petitioner’s argument that, based upon the prosecution history of the ’113 patent, the phrase “secured to” should be construed “to require direct contact (i.e., no spacing), and specifically to mean ‘fixed to a [first/second] side of the enclosure without being spaced apart from the [first/second] side of the enclosure.’” Decision 5, *citing* Pet. 5. We determined that, contrary to Petitioner’s argument, the statements from the prosecution history relied on by Petitioner and the Specification of the ’113 patent do not establish or suggest that the applicant disavowed or limited any scope of the phrase “secured to,” as asserted by Petitioner. Decision 8. Accordingly, we declined to limit the “secured to” phrase as proposed by Petitioner. We also determined that no further construction of this term was necessary for purposes of our Decision. Decision 8.

The Request for Rehearing asserts that our analysis and determination regarding the construction of the “secured to” phrase, and our “refus[al]” to adopt Petitioner’s proposed construction, resulted in “inconsistencies.” Req. Reh’g. 3. The asserted inconsistency is that we did not adopt a specific definition that either requires “direct contact” or allows “spacing” between first and second plates 40, 42 when they are “secured to” first and second

sides, respectively, of enclosure 20. *Id.* Petitioner's request for rehearing assumes that the phrase must be interpreted to allow either direct contact or spacing. This assumption is not correct. The broadest reasonable interpretation of the "secured to" phrase requires only that the plates are secured to the enclosure. Whether the plates are in direct contact or indirect contact with the housing, or whether the plates are spaced from the housing, is irrelevant to the construction of the "secured to" phrase. Thus, we are not persuaded that there is any inconsistency, that we abused our discretion, or that we overlooked or misapprehended any matter in our interpretation of the "secured to" phrase.

Broadest Reasonable Construction

Petitioner asserts that our determination on claim construction violated the requirements of 37 C.F.R. § 100(b), stating that "[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears." Req. Reh'g. 2, n. 1. Our Decision stated the general principles on which our claim construction was based. Decision 4. The general principles we stated are that:

(1) a claim is "given its broadest reasonable construction in light of the specification of the patent in which it appears" (*id.*, *citing* the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764, 48,766 (Aug. 14, 2012) (Claim Construction).); and

(2) "words of the claim will be given their plain and ordinary meaning, unless the plain meaning is inconsistent with the specification. (*id.*, *citing* *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).
Thus, we stated, and followed, the requirements of 37 C.F.R. § 100(b).

Petitioner cites “*Facebook, Inc. v. Pragmatus AV, LLC*, --- Fed.Appx. ---, 2014 WL 4454956 at *4 (Fed. Cir. 2014)” (Req. Reh’g. 2) asserting that this case is “more on point” than *In re Zletz* cited in our Decision. *Facebook* is a nonprecedential decision. *See Facebook, Inc. v. Pragmatus AV, LLC*, Nos. 2013-1350, 1351, slip op. at 1 (Fed. Cir. Sep. 11, 2014) (“NOTE: This disposition is nonprecedential.”) Federal Circuit Rule 32.1 states: “An opinion or order which is designated as nonprecedential is one determined by the panel issuing it as not adding significantly to the body of law.” Federal Circuit Rules, Rule 32.1 (2011).

Consistent with its designation as nonprecedential, *Facebook* does not cite, distinguish, modify, or overrule the precedential *Zletz* decision. In the context of reviewing a decision in an *inter partes* reexamination, the court in *Facebook* restated the basic rule we followed, which is that when the Board reviews a claim in an unexpired patent it “construes the claim under the broadest reasonable interpretation consistent with the specification.” We are not persuaded that the nonprecedential *Facebook* decision is “more on point” (Req. Reh’g 2) to our Decision than the authority we cited, and on which we relied. Nor are we persuaded that *Facebook* establishes that we abused our discretion, or overlooked or misapprehended anything in the Petition.

Exhibits 1008 and 1009

Petitioner asserts that we overlooked its references to Exhibits 1008 and 1009 in our claim construction analysis. Req. Reh’g. 4–5. Petitioner states correctly that it referred to Exhibits 1008 and 1009 on pages 5 and 6 of its Petition.

In this proceeding, Patent Owner did not propose a specific claim construction for the “secured to” phrase. Patent Owner proposed that the challenged claims in general, and the “secured to” claim phrase in particular, should be given their “plain and ordinary” meaning. Decision 5–6, *citing* Prelim. Resp. 6. We noted, however, that in discussing the “secured to” phrase Petitioner referred to “patent owner’s construction.” *Id.* at 28, n. 4, *citing* Pet. 15.

Because Patent Owner did not propose a specific claim construction in this proceeding, we stated that we understood Petitioner’s reference to “patent owner’s construction” to be a reference to Petitioner’s view that Patent Owner inherently adopted a claim construction in asserting infringement against one of Petitioner’s products. Decision 28, n. 4. In that context, we stated in footnote 4 that “Petitioner has not pointed us to any evidence of a proposed construction [of the “secured to” phrase] that Patent Owner may have asserted.” *Id.* We also stated that we were aware that Petitioner has submitted Exhibits 1008–1011 in this proceeding, which are letters between Counsels for the parties relating to an infringement allegation. *Id.* We then over-broadly stated that “Petitioner has not cited to these exhibits in the Petition.” This statement was not accurate, to the extent Petitioner has cited to the exhibits in the Petition, but the statement was intended to refer more precisely to the fact that Petitioner had not cited to any specific “patent owner’s construction” in these exhibits to establish what Petitioner referred to as “patent owner’s construction” (Pet. 15) of the “secured to” phrase.

Exhibit 1008, cited by Petitioner in the Petition, is a letter from counsel for Patent Owner to Petitioner alleging that an “18 inch Hydro Sod

Cutter (Model # SC180H)” infringed the ’113 patent, and making certain demands to Petitioner. In the context of asserting the enforceable scope of the ’113 patent, this letter stated only that “the Sod Cutter infringes at least claim 1 of the ’113 patent.” Ex. 1008, p. 1. The letter does not assert any specific claim construction for the ’113 patent or the “secured to” phrase, and Petitioner did not point us to any specific claim construction by the Patent Owner in Exhibit 1008. Thus, Exhibit 1008 does not establish what Petitioner referred to as “patent owner’s construction” of the “secured to” phrase. We also note that claim interpretation in an infringement context in district court may be different from the broadest reasonable interpretation applied in an *inter partes* review. *In re Zletz*, 893 F.2d at 321-22.

Exhibit 1009 is a product brochure for the Sod Cutter Model #SC180H referred to in Exhibit 1008. Exhibit 1009 does not contain a claim interpretation by the Patent Owner. In the Petition, Petitioner refers to a drawing from Exhibit 1009 and, based on *Petitioner’s* characterization of this drawing, Petitioner argues that “patent owner contends” that the “secured to” phrase “does not require direct contact and that the patent owner insists that spacing from the [first/second] side of the enclosure is within the claim scope.” Pet. 5–6. The point of our comment in footnote 4 of the Decision was that *Petitioner’s* speculation, based on Exhibits 1008 and 1009, about *Patent Owner’s* claim interpretation in Patent Owner’s infringement allegation does not provide persuasive evidence of the proper claim interpretation in this *inter partes* review proceeding, or of Patent Owner’s claim construction in this proceeding.

Moreover, Petitioner’s argument based on Exhibits 1008 and 1009 is that “the patent owner’s expansive construction [in its infringement

allegation] is directly contrary to the prosecution history.” Pet. 6. Our Decision considered, and rejected, this argument. Decision 5–8. We stated that, contrary to the Petitioner’s argument, the prosecution history does not establish or suggest that the applicant disavowed or limited any scope of the “secured to” phrase. *Id.* at 8. Accordingly, we determined that there was no persuasive evidence that “the phrase ‘secured to’ in claim 1 requires direct contact without any spacing between the first and second plates and the enclosure.” *Id.* We are not persuaded that we misapprehended or overlooked any evidence or argument.

Re-argument Based on Hamilton and Groundsman and New Evidence

The majority of Petitioner’s Request for Rehearing is devoted to re-arguing that the challenged claims would have been obvious based on Hamilton and Groundsman. Req. Reh’g. 5–15. Petitioner argues that “[t]he failure to institute *inter partes* review based on Hamilton and Groundsman is an abuse of discretion based on a few erroneous conclusions.” *Id.* at 6. For example, Petitioner disagrees with our determination that Petitioner did not provide a persuasive explanation for the selective modification of the references. Req. Reh’g. 8, n. 4; *see also*, Decision 29–31 (Petitioner has not provided persuasive reasoning with some rational underpinning to support the legal conclusion of obviousness.) Petitioner points to evidence of its expert Declarant in support of its position, and also points to the fact that “[t]here is no evidence of record that one of ordinary skill in the art would not incorporate/omit elements as proposed.” Req. Reh’g. 8. The probative value of the Declarant’s opinion that a proposed modification would have been obvious is not enhanced by the fact that the record before us does not contain specific evidence that a person of ordinary skill would *not* make the

proposed modifications. Petitioner bears the burden of establishing a reasonable likelihood of unpatentability of one or more claims. 37 C.F.R. § 42.108(c).

A request for rehearing is not an opportunity to present new arguments or evidence that could have been presented and developed previously. *Mobotix Corp. v. E-Watch, Inc.*, Case IPR2013-00255, Paper 15, 4 (PTAB December 3, 2013) (“The Board could not have overlooked a detailed explanation or analysis not presented in the Petition. A rehearing request is not a supplemental petition.”) Petitioner presents colored drawings to explain what it refers to as the “nomenclature” it advocated in its Petition and by its Declarant. These colored drawings were not included in its Petition. Moreover, we fully considered and discussed in our Decision the expert declaration on which Petitioner relies. Decision 22–24.

Petitioner’s arguments do not persuade us that we overlooked or misapprehended any matter or abused our discretion in our determination based on Hamilton and Groundsman.

III. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that we abused our discretion in denying institution of an *inter partes* review of claims 1, 5, 6, and 10 of the ’113 patent. 37 C.F.R. § 42.71. The request for rehearing is *denied*.

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