

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CERAMTEC GMBH,
Petitioner,

v.

CERAMEDIC LLC,
Patent Owner.

Case IPR2015-00398
Patent 6,066,584

Before GRACE KARAFFA OBERMANN, KRISTINA M. KALAN, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

CeramTec GMBH (“Petitioner”) filed a Request for Rehearing (Paper 38, “Request” or “Req.”) of our Final Written Decision (Paper 36, “Final Written Decision” or “Dec.”) holding that claims 1–5, 7, 11–13, 15–17, 19–21, 23, 30–38, 52, and 53 of U.S. Patent No. 6,066,584 (Ex. 1001, “the ’584 patent”) are unpatentable. For the reasons that follow, Petitioner’s Request for Rehearing is denied.

II. THE REQUEST FOR REHEARING

In pertinent part, 37 C.F.R. § 42.71(d) states:

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.

Thus, a request for rehearing is not an opportunity merely to disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence.

Petitioner seeks reconsideration based on the contention that the evidence of record “established beyond question” that claims 8–10 are obvious. Req. 1. Petitioner requests that the Board reverse this aspect of the Final Written Decision and find claims 8–10 unpatentable.

We have reviewed Petitioner’s Request and carefully considered all the arguments presented, including those not addressed specifically in this Decision. For the following reasons, we are not persuaded that the Board misapprehended or overlooked arguments or evidence with respect to the contentions asserted by Petitioner.

III. DISCUSSION

Petitioner argues that the Board should have held claims 8–10 unpatentable as obvious over the combination of Lin (Ex. 1002) and Yeh (Ex. 1004). Req. 1. Petitioner explains that “[w]hile Petitioner did not formally request a finding of unpatentability over this particular combination, the Board should have exercised its discretion to hold the claims unpatentable.” *Id.*

Petitioner requested review of claims 8–10 as obvious over Yeh alone. Paper 2 (“Petition” or “Pet.”) 5; Dec. 5. Petitioner did not request review of claims 8–10 on any other grounds. Pet. 4–6. Petitioner requested review of claims 7, 11, 13, 32, and 37 under 35 U.S.C. § 103(a) as unpatentable over the combination of Lin and Yeh. *Id.* at 4. Petitioner did not include claims 8–10 in this ground. *Id.*

We instituted *inter partes* review of claims 8–10 under 35 U.S.C. § 103(a) as allegedly unpatentable over Yeh. Paper 11, 19. We did not institute *inter partes* review of claims 8–10 on any other ground, and we specified that no other ground set forth in the Petition as to any challenged claim was authorized. *Id.*

Petitioner now argues that claims 8–10 would have been obvious over Lin and Yeh. Req. 2. Petitioner states that the “inescapable conclusion from the record” is that Petitioner has met its burden of establishing by a preponderance of the evidence that claims 8–10 would have been obvious. *Id.* Petitioner relies, *inter alia*, on Patent Owner’s alleged admission that the limitations of claims 8 and 9 are disclosed by Lin and Yeh (*id.* at 2–3); Patent Owner’s alleged lack of dispute that Yeh discloses the pH limitation

of claim 10 (*id.* at 3–4); and Patent Owner’s arguments that allegedly establish that pH was recognized as a result-effective variable (*id.* at 4–5).

At the very least, this argument fails because Petitioner does not point to the place where each matter was previously addressed in a motion, an opposition, or a reply. Indeed, Petitioner cannot, as this ground was not raised in the Petition, was not instituted in the Decision on Institution, was not addressed by Patent Owner, and was not raised in the Reply. Petitioner’s marshalling of alleged admissions by Patent Owner directed to related issues is not persuasive. Additionally, in its Request, Petitioner presents numerous arguments that were not raised earlier, in an effort to persuade us that we should decide in its favor. Req. 2–5. We need not determine whether these arguments would have been persuasive if previously presented, because they were not so presented. These arguments are, therefore, not timely in a request for rehearing pursuant to 37 C.F.R. § 42.71(d).

Moreover, we cannot, at this late stage in the proceeding, create out of whole cloth a new ground that Petitioner has not presented, and to which Patent Owner has not had a chance to respond. Our rules require us to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). If we were to grant a request for rehearing on a ground not even presented in the Petition, the due process and other ramifications of such an action would be extensive. In the present proceeding, Patent Owner would be prejudiced. Other proceedings before the Board would be imbued with uncertainty as to which grounds, claims, or combinations of art, instituted or not, should be the focus of the parties’ arguments. In sum, if we were to grant Petitioner’s request, we would be overreaching in exercising our discretion.

Petitioner also argues that the Board misapprehended the law regarding the scope of final written decisions. Req. 5. Petitioner states that “a final written decision in an IPR should not be limited only to the instituted grounds, but also should evaluate the record as a whole.” *Id.* at 6. Petitioner interprets 35 U.S.C. § 318(a) as standing for the proposition that the Board “shall issue a final written decision with respect to the patentability of any patent *claim* challenged by the petitioner,” rather than limiting the final written decision to the specific *grounds* identified in an IPR petition, although Petitioner cites no authority for this interpretation. *Id.*

We disagree that “when the record developed during trial establishes that claims are unpatentable on grounds not specifically called out in the petition, failure to hold such claims unpatentable places form over substance.” *Id.* at 7. Rather, we perceive that we do, in fact, have limited discretion in holding a challenged claim unpatentable on grounds not identified in a petition or instituted in a decision. Although we are aware of panels having instituted *inter partes* review on grounds not presented in a Petition, Petitioner has not made us aware of any final decision that has created grounds that were not part of the trial. We have been cautioned by our reviewing court that “‘an agency may not change theories in midstream without giving respondents reasonable notice of the change’ and ‘the opportunity to present argument under the new theory.’” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) (quoting *Rodale Press, Inc. v. FTC*, 407 F.2d 1252, 1256–57 (D.C. Cir. 1968)). Creation of a new ground in a final decision or in a request for rehearing would violate both of those cautions. Although Petitioner contends that the “Patent Owner has had ample notice and opportunity to be heard” (Req. 8), we disagree.

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