

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORNING OPTICAL COMMUNICATIONS RF LLC,
CORNING INC., and CORNING OPTICAL COMMUNICATIONS LLC,
Petitioner,

v.

PPC BROADBAND, INC.,
Patent Owner.

Case IPR2015-01952
Patent 8,647,136 B2

Before JOSIAH C. COCKS, TRENTON A. WARD, and
WILLIAM M. FINK, *Administrative Patent Judges*.

FINK, *Administrative Patent Judge*.

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

Petitioner, Corning Optical Communications RF LLC, Corning Incorporated, and Corning Optical Communications LLC, timely filed a request for rehearing of our decision denying institution of *inter partes* review. Paper 17 (“Req. Reh’g”). The Request for Rehearing seeks rehearing of our determination not to institute *inter partes* review of claims of claims 27, 30, and 34–38 of U.S. Patent No. 8,647,136 B2 (Ex. 1001, “the ’136 patent”) on the asserted ground of obviousness under 35 U.S.C. § 103(a) over Matthews,¹ Tatsuzuki,² Burris,³ and Bence.⁴ Req. Reh’g 2 (citing Paper 16 (“Decision”)). For the reasons given below, we deny the Request for Rehearing.

I. LEGAL STANDARDS

When rehearing a decision whether to institute *inter partes* review, we review the decision for an “abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing [the] decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). 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” the petition. *Id.*

II. ANALYSIS

Petitioner contends we abused our discretion in our determination that “Petitioner had not shown a reasonable likelihood that it is obvious to

¹ U.S. Patent Application Publication No. 2006/0110977, published May 25, 2006 (Ex. 1002) (“Matthews”)

² Japanese Publication No. 2002-15823 (Ex. 1017) (“Tatsuzuki”) (English Translation at Ex. 1003).

³ U.S. Patent No. 5,975,951, issued November 2, 1999 (Ex. 1004) (“Burris”)

⁴ U.S. Patent No. 7,114,990, issued October 3, 2006 (Ex. 1005) (“Bence”)

combine Matthews, Tatsuzuki, Burris and Bence as presented in the Petition.” Req. Reh’g 2. According to Petitioner:

Five PTAB panels have already concluded that it is obvious to combine the asserted references as presented by Petitioner to sandwich the continuity member of Tatsuzuki between the nut and body of Matthews, as taught by Bence. These five PTAB panels issued Final Written Decisions cancelling all challenged claims of related patents based on this combination. Exs. 1023, 1024, 1026-1028. . . . The Federal Circuit affirmed the PTAB’s determination that one-third of the challenged claims are obvious over this combination. *PPC Broadband, Inc. v. Corning Optical Commc’ns RF, LLC*, 815 F.3d 734, 747 (Fed. Cir. 2016). It is demonstratively unreasonable and an abuse of discretion for this Panel to assert that Petitioner has not shown a reasonable likelihood that it is obvious to combine the references as presented, when this combination has been determined to be obvious by five PTAB panels, as affirmed by the Federal Circuit.

Req. Reh’g. 2–3 (footnote omitted).

We are not persuaded by this argument. As an initial matter, Petitioner directs us to no authority for the broad proposition that the Board should institute *inter partes* review of claims of a patent based on the Board’s determination with respect to the unpatentability of a claims of related patent, simply because the challenge is based on the same combination of prior art references. To the contrary, although relying on the Federal Circuit’s affirmance-in-part in *PPC Broadband*, Petitioner omits the fact that the Federal Circuit vacated the Board’s decision regarding most of the claims on appeal, based on the same combination. 815 F.3d at 737; *see also In re Brimonidine Patent Litigation*, 643 F.3d 1366, 1370 (Fed. Cir. 2011) (affirming finding of obviousness as to one patent, but finding burden not satisfied with respect to “related patents”). Moreover, even if these prior

Board decisions had not been vacated-in-part, Petitioner did not provide an explanation as to how the proposed obvious arrangement of prior art in related cases (*see, e.g.*, Ex. 1027, 27), is relevant in the context of the different claims at issue or the somewhat different proposed arrangement of the prior art here. *See* Req. Reh’g. 4–5 (citing Paper 2 (Pet.) 22–23).

We have considered Petitioner’s specific arguments that we overlooked several reasons for combining the references in the proposed way (i.e., creating a new gap in Matthews). Request 6–8 (citing Pet. 20, 54–56). We have also considered Petitioner’s argument that we overlooked explanation and testimony in assessing whether the combination addressed claimed features, in particular, the requirement that the continuous metallic electrical ground pathway is maintained while the forward facing surface of the nut is “spaced away” from the rearward facing surface of the post. Req. Reh’g. 8–13 (citing, e.g., Pet. 48–50). We disagree.

It is Petitioner’s burden to establish the reasonable likelihood of unpatentability of one or more claims in the challenged patent. 37 C.F.R. § 42.108(c); 35 U.S.C. § 312(a)(3) (requiring the petition to identify with particularity each claim challenged and the grounds on which the challenged claim is based). We considered Petitioner’s evidence and arguments, but, for the reasons stated in the Decision, we found that Petitioner and its declarant did not address sufficiently why it would have been obvious to a person of ordinary skill in the art to create the specific modification to Matthews (including creating a new gap), based on Tatsuzuki, Bence, and Burris, or how that modification fully addresses the claim limitations

(including maintaining the ground pathway while “spaced away”).⁵ We are not persuaded that we overlooked or misapprehended anything in making this determination.

Petitioner argues that “[i]t is an abuse of discretion to give greater weight to attorney argument than unrebutted expert testimony,” as Petitioner contends we did. Req. Reh’g.13. To be sure, we considered Patent Owner’s arguments raised in its Preliminary Response, as our rules require. *See* 37 C.F.R. § 42.108(c) (“The Board’s decision will take into account a patent owner preliminary response where such a response is filed.”). However, the absence of rebuttal testimony does mean the proffered testimony is free of evaluation by the Board, which must assess its persuasiveness in light of the evidence and scope of the claimed invention. *See Dominion Dealer Sol’ns, LLC v. AutoAlert, Inc.*, Case IPR2013-00220, slip op. at 2 (PTAB Oct. 10, 2013) (Paper 13). Here, for example, we considered Patent Owner’s argument that the spring in Tatsuzuki might be crushed—an argument supported by the text of Tatsuzuki (*see* Ex. 1003 ¶ 17)—in assessing how the proposed combination would satisfy the limitation requiring the ground pathway to be maintained while spaced away, which we found to be unclear.

⁵ In this regard, we did not erroneously *require* “a modified version of Figure 8 [of Matthews] that illustrates the second nut-to-post position, requiring N_F and P_R to be spaced away,” as suggested by Petitioner. Request 11 (quoting Decision 21 (bracketed text added by Petitioner)). This partial quote of our Decision is unhelpful because it omits from the quote: “*nor does Petitioner sufficiently explain* how the second nut-to-post position is obtained while maintaining continuity between post and nut.” Decision 21 (emphasis added). It was not an error to require an illustration *or sufficient explanation* in support of the obviousness argument. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2006) (requiring articulated reasoning).

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