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Paper 11
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIXOLON CO., LTD.,
Petitioner,

v.

SHINHEUNG PRECISION CO., LTD.,
Patent Owner.

Case IPR2016-01068
Patent 6,629,666 B2

Before KEN B. BARRETT, BARRY L. GROSSMAN, and AMANDA F. WIEKER, *Administrative Patent Judges.*

WIEKER, *Administrative Patent Judge.*

DECISION
Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner, Bixolon Co., Ltd., filed a Request for Rehearing (Paper 10, "Req. Reh'g") of the Decision (Paper 8, "Dec.") denying institution of an *inter partes* review of any of challenged claims 1–18 of U.S. Patent No. 6,629,666 B2 (Ex. 1001, "the '666 patent"). Req. Reh'g 1. Petitioner argues that the Decision relies upon unsupported factual findings regarding the Hosomi reference, is contrary to prevailing law, and misapprehends or overlooks the Sato reference. *Id.* at 1–2. The Request for Rehearing is denied.

II. STANDARD OF REVIEW

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs if the decision is based on an erroneous 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. *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). Further, a request for rehearing must identify specifically all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d).

III. ANALYSIS

Petitioner argues that the Board erred in finding "that it is *impossible* for Hosomi's optical detector and bolt 25 and hole 72 to exist together." *See* Req. Reh'g 1, 3. This argument misstates the Decision's findings. The Decision does not state that it is impossible for these structures to be used together. *See* Dec. 12–15. Indeed, the Decision states explicitly, "it may be

feasible" for these structures to be used together. *Id.* at 14. The Board found, however, that the structure Petitioner relies upon to satisfy the claimed "position adjusting means"—bolt 25 and hole 72—"appears mutually exclusive to Hosomi's 'means for optically detecting.'" *Id.* at 12. The Board found that the Petition, and the cited expert testimony of Mr. Charles Curley (Ex. 1006), failed to explain persuasively whether it would have been obvious to a person of ordinary skill in the art to utilize Hosomi's "means for optically detecting" with the disclosed and relied-upon structure of Hosomi's contact-based detector 24, including bolt 25 and hole 72, because those structures appear mutually exclusive to each other. Dec. 13–14. Petitioner's Request for Rehearing does not inform us of error in that regard. It is Petitioner's burden, not the Board's obligation, to demonstrate how the claims are unpatentable over the prior art of record. *See* 37 C.F.R. § 104(b)(4); *Hopkins Mfg. Corp. v. Cequent Performance Prods., Inc.*, IPR2015-00609, Paper 9, 12 (PTAB Aug. 14, 2015) ("While it might be possible for us to arrive at an articulable ground by sifting through Petitioners' identifications of grounds, the claim charts, the references, and the numerous cited paragraphs of the expert declaration . . . we decline to do so."). On the facts of this case, Petitioner's vague statements about how Hosomi's structure may be modified (e.g., to replace contact-based detecting element 64 with an optical detector), without addressing the impact of that modification on other related structures (e.g., limit switch 67, actuating lever 63, supporting frame 62, hole 72/bolt 25), does not satisfy this burden. *See, e.g., Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00003, Paper No. 8, 10 (PTAB Oct. 25, 2012) ("[W]e will address only the basis, rationale, and reasoning put forth by the Petitioner in the petition, and

resolve all vagueness and ambiguity in Petitioner's arguments against the Petitioner.").

Petitioner argues that Hosomi's "paper end detector 24 comprises detecting element 64 to detect the end of the recording paper." Req. Reh'g 3–4. Petitioner and Mr. Curley state that an optical detector can replace contact-based detecting element 64. *Id.* at 5 (citing Ex. 1006 ¶¶ 86, 102).[1] Therefore, according to Petitioner, paper end detector 24 may use "means for optically detecting as an alternative for *using* the limit switch [67 of detector 24], not as a replacement of the paper end detector 24 in its entirety." *Id.* at 3.

As stated in the Decision, however, the Petition fails to explain cogently whether it would have been obvious to use Hosomi's means for optically detecting with the existing structure of Hosomi's contact-based detector 24. *See* Dec. 14. Petitioner contends that an optical detector simply would be substituted for Hosomi's contact-based detecting element 64. *See* Req. Reh'g 5. However, this does not account for Petitioner's admission that optical detection is "an alternative to . . . *using* the *limit switch*." *Id.* (second emphasis added). For example, the Petition fails to explain whether it would have been obvious to a person of ordinary skill in the art to utilize an optical detector in place of contact-based detecting element 64 but to nonetheless retain other portions of Hosomi's contact-based detector 24 (e.g., actuating lever 63, supporting frame 62) that are not utilized with optical detection, but instead actuate the limit switch that is not being used.

[1] We do not consider statements made by Mr. Curley in conjunction with a separate proceeding because those statements are not in evidence in this proceeding. *See* Req. Reh'g 5–6 (citing Ex. 1011 in IPR2017-00086); 37 C.F.R. § 42.6(a)(3).

See, e.g., Pet. 18–20, 29–32; Ex. 1002, 6:32–56, 7:2–13, 8:40–45, 9:14–21. Indeed, if optical detection is "an alternative for *using* the limit switch," as Petitioner contends (Req. Reh'g 3), unused limit switch 67, its actuating lever 63, and its supporting frame 62 appear unnecessary to the modified detector. The Petition does not address whether it would have been obvious to remove or retain these structures, and has not shown reasonably that they would remain when Hosomi's detector is modified to include means for optically detecting. Without more, an optical detector appears mutually exclusive to the structures used to actuate the limit switch, e.g., lever 63 and frame 62, with bolt 25 and hole 72.

The challenged claims also recite "position adjusting means," which Petitioner contends to be Hosomi's bolt 25 and hole 72. Pet. 19; Req. Reh'g 4. According to Petitioner, these structures are "separate from the structure for providing detection . . . and complementary" such that a person of ordinary skill in the art "understands that the disclosed bolt 25/hole 72 structure to adjust the location of the detection is applicable to either the contact-based or optical-based detection." Req. Reh'g 6–7. Although we understand that height adjustment may be desirable regardless of the manner of detection, we are unpersuaded by Petitioner's argument. *Id.* at 8. The Petition has not shown reasonably that height adjustment would be achieved with bolt 25 and hole 72 when optical detection is utilized. Bolt 25 and hole 72 are integrated with actuating lever 63 and supporting frame 62 of contact-based detector 24, wherein lever 63 rotates about frame 62 to actuate limit switch 67. Ex. 1002, 6:44–45, 7:8–9, 7:14–25, 8:18–34. Accordingly, those structures are not "separate from the structure for providing detection," as argued. As discussed above, the Petition fails to address whether it would

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