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Paper 225
Entered: November 23, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POLYGROUP LIMITED (MCO),
Petitioner,

v.

WILLIS ELECTRIC CO., LTD.,
Patent Owner.

IPR2016-01610[1]
Patent 8,454,186 B2

Before WILLIAM V. SAINDON, JEREMY M. PLENZLER, and BARBARA A. PARVIS, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge.*

JUDGMENT
Final Written Decision on Remand
Determining Sole Remaining Claim Not Unpatentable
35 U.S.C. §§ 144, 318(a)

[1] The grounds raised in IPR2016-00800 and IPR2016-01609 are consolidated with IPR2016-01610.

I. INTRODUCTION

A. Background

The scope of this remand is limited to whether claim 7 is unpatentable in view of Miller.[2] This case began as a consolidation of Petitioner's challenges in three petitions, cumulatively directed to claims 1, 3, 4, 6–11, 15–22, 25, 26, and 28 of U.S. Patent No. 8,454,186 B2 (Ex. 1001, "the '186 patent").[3]

We issued a consolidated Final Written Decision on February 26, 2018 determining that Petitioner had not established unpatentability of any of the challenged claims of the '186 patent. Paper 187. In relevant part, a majority opinion held that Petitioner had not shown that independent claim 1 was obvious in view of a combination of Miller, Otto,[4] and Jumo.[5] *Id.* at 60–61; *see also id.* (finding the remaining challenged claims not unpatentable for similar reasons). The majority reasoned that Petitioner had not established, *inter alia*, sufficient rationale for the combination and, under the majority's claim construction, had not shown how each limitation was taught. *Id.* The dissent reasoned that the majority's claim construction of

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[2] U.S. Patent No. 4,020,201, issued Apr. 26, 1977 (Ex. 1007).
[3] As used in this and in prior decisions, "Petition I" or "Pet. I" refers to the petition originally filed in IPR2016-00800, now Paper 28. "Petition II" or "Pet. II" refers to the petition originally filed in IPR2016-01609, now Paper 34. "Petition III" or "Pet. III" refers to the petition originally filed in IPR2016-01610, Paper 2.
[4] German Utility Model Patent G 84 36 328.2, published Apr. 4, 1985 (English translated copy) (Ex. 1008).
[5] French Patent No. 1,215,214, issued Nov. 16, 1959 (English translated copy) (Ex. 1009). The inventor is not listed on the face of the patent and instead lists Société Nouvelle des Établissements Jumo.

claim 1 was too narrow, such that Petitioner had shown that Miller, without the other references, rendered the claim unpatentable. *Id.* at 65, 81.

On appeal, the U.S. Court of Appeals for the Federal Circuit agreed with the majority on the issue of insufficient rationale and agreed with the dissent on the issue of claim construction. *Polygroup Ltd. MCO v. Willis Elec. Co., Ltd*, 759 F. App'x 934, 936 (Fed. Cir. 2019) ("*Polygroup I*"). The Federal Circuit accordingly vacated our decision in part, remanding the case with the proper claim construction and an instruction that "the Board should consider whether Miller alone renders [the remanded] claims obvious." *Id.* at 943.

We issued a second Final Written Decision on Remand on October 8, 2020, determining that "Petitioner ha[d] established by a preponderance of the evidence that claims 1, 3, 4, 6, 8, and 9 of the '186 patent are unpatentable, but ha[d] failed to establish that claims 7, 10, 11, 16–22, 25, 26, and 28 of the '186 patent are unpatentable." Paper 211, 37–38. We held that Petitioner had shown claims 1, 3, 4, 6, 8, and 9 unpatentable under the remanded claim construction. *Id.* at 10–19. As to claims 10, 11, 16–22, 25, 26, and 28, after construing those claims, which we found to have different scope, we held that Petitioner had failed to show how Miller taught each limitation. *Id.* at 21–24. With respect to claim 7, which ultimately depends from claim 1 and is the subject of this decision, we noted that Petitioner's ground was obviousness in view of Miller and Lessner. *Id.* at 8. In particular, the original ground was Miller, Otto, Jumo, and Lessner (Pet. II 64–71), and as such, we interpreted the Federal Circuit's instructions regarding "Miller alone" to mean "Miller without the additional teachings from Otto and Jumo." Paper 211, 9 n.15; *see also id.* at 9 n.12. On that understanding, we determined that Petitioner had not established a reason to

combine Miller and Lessner's teachings and subsequently had not established the unpatentability of claim 7. *Id.* at 19–20.

On appeal, the Federal Circuit held we misunderstood the scope of the "Miller alone" aspect of the remand when we analyzed Miller in combination with Lessner for claim 7. *Polygroup Limited MCO v. Willis Electric Company, Ltd*, 2022 WL 1183332, *3–4 (Fed. Cir. Apr. 20, 2022) ("*Polygroup II*"). A majority of the Federal Circuit panel also held that our claim construction as to claims 10, 11, 16, 18–22, 25, 26, and 28 was too narrow. *Id.* at *4–5. As a result, claim 7 was remanded to us and claims 10, 11, 16, 18–22, 25, 26, and 28 were held unpatentable. *Id.* at *1, 4–5.

We then held a post-remand conference call pursuant to the Board's Standard Operating Procedure 9.[6] Paper 222. The parties agreed the sole issue for us to decide is whether claim 7 is obvious in view of Miller. *Id.* at 3. Neither party argued for further substantive briefing regarding claim 7, although Petitioner requested briefing on statements it alleges Patent Owner made in a parallel district court proceeding regarding the claim construction of the term "detachabl[e]." *See id.* We found that we had "a complete record from which to decide th[e] issue" of claim 7. *Id.* We allowed Petitioner to file the statements made by Patent Owner but did not allow briefing on the matter. *Id.* at 3–5. Reviewing the record as it stands, for the reasons set forth in our discussion below, we determine that Petitioner has not shown by a preponderance of the evidence that claim 7 is unpatentable over Miller.

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[6] *Available at* https://www.uspto.gov/sites/default/files/documents/sop_9_%20procedure_for_decisions_remanded_from_the_federal_circuit.pdf.

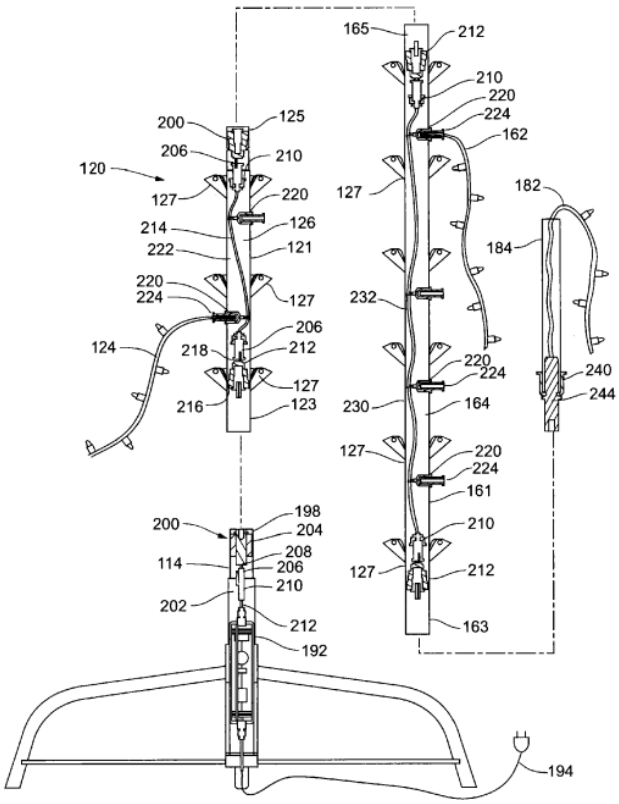
B. Related Matters

The parties have engaged in myriad actions against each other. There are a number of district court lawsuits, PTAB proceedings, reexamination proceedings, and copending applications related to this proceeding. The most recent listing provided to us can be found in Paper 214 (Patent Owner's Mandatory Notices, filed June 13, 2022).

C. The '186 Patent

The '186 patent is directed to a modular artificial tree (e.g., a Christmas tree) with electrical connectors in the trunk. Ex. 1001, codes (54), (57). An electrical connection runs up the trunk of the tree to provide a source of electricity for light strings draped over the branches. *See id.* at Figs. 2–4. Figure 4 of the '186 patent is reproduced below.

Fig. 4



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