

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Case: IPR2018-00388	§	Attorney Docket No.: OTI/0098
United States Patent No.: 9,079,464	§	
Inventors: Onello, et al.	§	Customer No.: 26290
Formerly Application No. 13/301,359	§	Petitioner: Olympia Tools
Issue Date: July 14, 2015	§	International, Inc.
Filing Date: November 21, 2011	§	
Former Group Art Unit: 3727	§	
Former Examiner: Lee D. Wilson	§	

For: PORTABLE WORK HOLDING DEVICE AND ASSEMBLY

MAIL STOP PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
Post Office Box 1450
Alexandria, Virginia 22313-1450

REQUEST FOR REHEARING

Petitioner Olympia Tools International, Inc. (“Petitioner”) herewith requests rehearing and reconsideration of the Patent Trial and Appeal Board’s (the “Board”) June 20, 2018 Decision Denying Institution of *Inter Partes* Review (the “Decision”). Specifically, Petitioner submits that the denial of Grounds 2 and 3 with respect to obviousness of claim 23 of U.S. Patent No. 9,079,484 does not account for the similarity between a fixed threaded spindle and rotating nut arrangement compared to a rotating threaded spindle and fixed nut arrangement. Therefore, the Board’s Decision is inconsistent with controlling case law and constitutes an abuse of discretion.

I. INTRODUCTION

The issues presented here are:

(1) whether an express “articulated reason” or “motivation to combine” is required to conclude that it is obvious to swap a rotatable nut and fixed threaded spindle with a rotatable threaded spindle and fixed nut, where either arrangement is well-known structure for moving the jaws of a work holding device, and

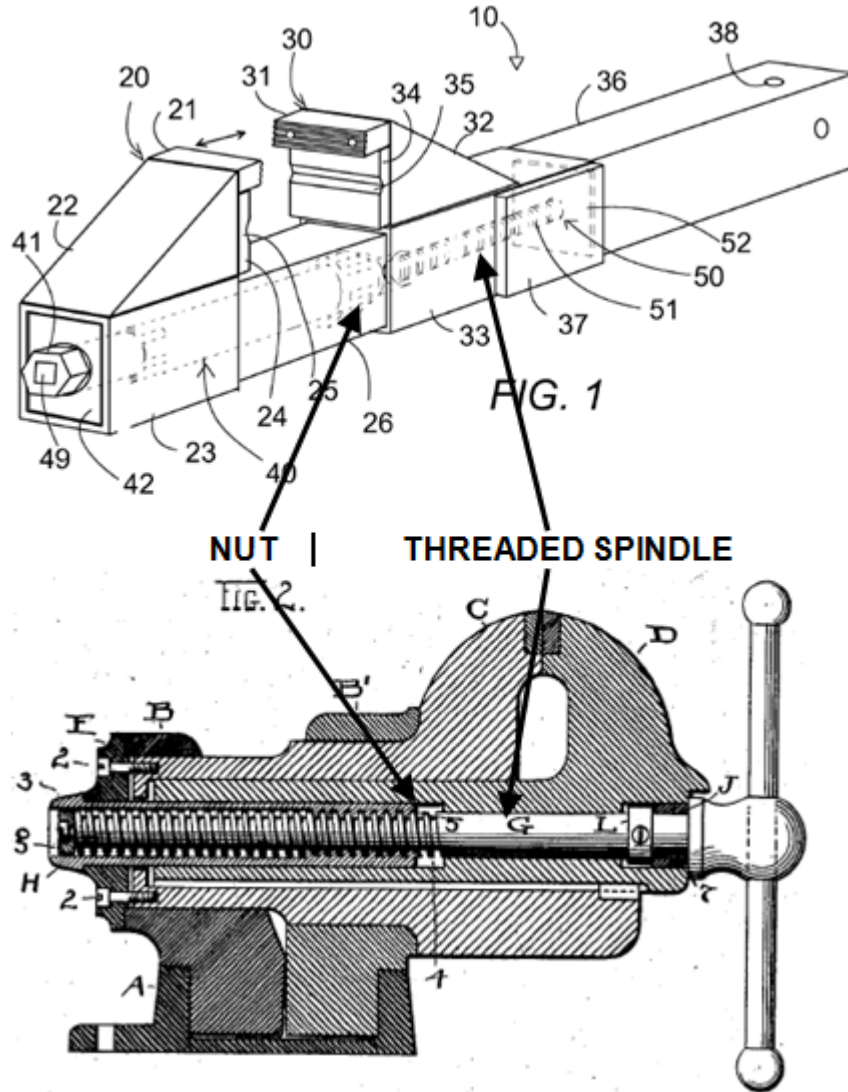
(2) whether obviousness requires some showing of how a prior art device would remain operable if modified with known structures performing known functions.

The issues were previously addressed by Petitioner in connection with the obviousness of claim 23 in the Petition, including pages 12-15, 16-17, 18-19, 26, 48-51, and in Exhibit 1003, at paragraphs 189-200. By this Request, Petitioner seeks rehearing of Grounds 2 and 3, a finding that the Petition establishes a reasonable likelihood of prevailing at trial on at least the obviousness of claim 23, and institution of *Inter Partes* Review as requested in the Petition.

The issues arise from the Board’s assumption that, in the art of work holding devices, a fixed threaded spindle and rotating nut arrangement is somehow materially different than a rotating threaded spindle and fixed nut arrangement, even though both arrangements are essentially identical structures that perform the identical function of moving jaw pieces.

A brief review of the technology at issue is warranted. *Cornes* (Ex. 1006) teaches moving jaw pieces of a work holding device by rotating a nut relative to a threaded spindle. Ex. 1006, ¶ [0035]. A person of ordinary skill in the art would know that jaw pieces of a work holding device can also be moved rotating a

threaded spindle relative to a nut (Grounds 2). Ex. 1003, ¶¶ 190-92. *Long* and *Murray* each teach such a rotatable threaded spindle arrangement (Ground 3). Ex. 1007, lines 58-77; Ex. 1009, ¶ [0019]. Figure 1 of *Cornes* and Figure 2 of *Long* are reproduced below, with annotations indicating the respective structures of interest:



In each device, the nut and threaded spindle are rotated relative to one another to move the jaw pieces. These structures and functions are basic and well-known, notwithstanding the Patent Owner's attempt to confuse this technology. See, e.g., Patent Owner's Response, pp. 23-26, 30-31.

There is no dispute that each structural and functional limitation of claim 23 is taught in the prior art. The fact that *Cornes* uses a fixed threaded spindle instead of a rotatable threaded spindle does not render claim 23 valid, because a rotatable threaded spindle is within the knowledge of one of ordinary skill in the art, and is even expressly taught in the prior art of record. A simple substitution of one known element for another is obvious as a matter of law. Therefore, claim 23 is obvious as nothing more than the predictable use of prior art elements according to their established functions. In concluding otherwise, the Board follows certain mistakes of law that amount to an abuse of discretion.

II. LEGAL STANDARDS

A. Rehearing Standard of Review

A decision by the Board on whether to institute an *Inter Partes* review is reviewable on request for rehearing under the abuse of discretion standard. 37 C.F.R. § 42.71 (2015). An error of law is, by definition, an abuse of discretion. *Koon v. United States*, 518 U.S. 81, 100 (1996).

B. Obviousness Analysis Requires an “Expansive and Flexible Approach,” not “Rigid and Mandatory Formulas”

It is well understood that the Supreme Court overruled the strict requirement for some “teaching, suggestion or motivation” (“TSM”) test once used by the Federal Circuit. *See, generally, KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) The TSM may have provided a “helpful insight,” but “[h]elpful insights ... need not become rigid and mandatory formulas.” *Id.* at 418, 419. “Application of the [§ 103] bar must not be confined within a test or formulation too constrained to serve its purpose.” *Id.* at 427.

Rather, the obviousness inquiry instead requires “an expansive and flexible approach” rather than “[r]igid preventative rules that deny factfinders recourse to common sense.” *Id.* at 415, 421. Under *KSR*, “the legal determination of obviousness may include recourse to logic, judgment, and common sense.” *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1239 (Fed. Cir. 2010) (citing *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009)).

A claim is invalid if “the differences between the [claimed] subject matter ... and the prior art are such that the subject matter as a whole would have been obvious.” 35 U.S.C. § 103(a). “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR*, 550 U.S. at 417 (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)). That is, the obviousness inquiry requires consideration of “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 417.

However, some cases “may be more difficult” than the “simple substitution” of known elements in accordance with their known functions. *KSR*, 550 U.S. at 417. However, even in such cases, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418.

Regardless of how difficult the technology is—here, not very—“[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416; *See also Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344 (Fed. Cir. 2008) (finding secondary considerations did not overcome a strong case of prima facie case of obviousness in “a textbook case of when the asserted claims involve a combination

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