

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BEDRA, INC., BERKENHOFF GMBH,  
and POWERWAY GROUP CO. LTD.,  
Petitioner,

v.

SEONG, KI CHUL,  
Patent Owner.

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Case IPR2018-00666  
Patent 6,306,523 B1

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Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and  
CHRISTOPHER M. KAISER, *Administrative Patent Judges.*

KALAN, *Administrative Patent Judge.*

DECISION

Denying Request for Rehearing  
*37 C.F.R. § 42.71(d)*

## INTRODUCTION

Berkenhoff GmbH, Bedra, Inc., and Powerway Group Co., Ltd. (collectively, “Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–18 of U.S. Patent No. 6,306,523 B1 (Ex. 1001, “the ’523 patent”). Seong, Ki Chul<sup>1</sup> (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). Petitioner did not request authorization to file a reply to the Preliminary Response. We denied the Petition and did not institute *inter partes* review. Paper 8 (“Dec.” or “Institution Decision”). Petitioner now requests rehearing of our decision denying the Petition. Paper 9 (“Req.”).

“The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). We “review [our] decision for an abuse of discretion.” *Id.* § 42.71(c). In addition, we may not consider an argument made in a request for rehearing unless the request “specifically identif[ies] . . . the place where [that argument] was previously addressed in a motion, an opposition, or a reply.” *Id.* § 42.71(d).

After considering the Request for Rehearing, we determine that Petitioner has not demonstrated that we abused our discretion in denying institution. Accordingly, we deny the Request for Rehearing.

## ANALYSIS

Petitioner argues that we misapprehended the evidence presented regarding the proper interpretation of Figure 2a2 of a Korean application to which the challenged patent claims priority. Req. 7–15 (citing Ex. 1013,

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<sup>1</sup> Various spelled “Sung, Ki Chul” and “Ki Chul Song.” Prelim. Resp. 1; Paper 5, 3.

Fig. 2a2). Specifically, Petitioner argues that, contrary to our finding in the Institution Decision, Figure 2a2 of the Korean application does not disclose the “cracks through a coating layer and an alloy layer” that are recited in the challenged claims. *Id.* at 7–14. In addition, Petitioner argues that, even if it could be argued that Figure 2a2 does disclose such cracks, there is, at minimum, a genuine question of material fact that should be resolved in Petitioner’s favor. *Id.* at 14–15 (citing 37 C.F.R. § 42.108(b)).

Petitioner has not previously addressed, in its trial arguments, any of the arguments it raises in its Rehearing Request. Although the Preliminary Response discusses Figure 2a2 extensively, Prelim. Resp. 3, 23–27, the Petition only cites Figure 2a2 in passing, without discussing it at all. Pet. 19. Even Petitioner’s declarant, Dr. Tomalin, only cites Figure 2a2 twice in his entire declaration, and in neither of those places does he discuss Figure 2a2 in any detail.<sup>2</sup> Ex. 1004 ¶¶ 51–52. Petitioner could have requested authorization to file a reply to respond to Patent Owner’s arguments about Figure 2a2 in the Preliminary Response but did not do so. Because Petitioner has not previously raised any of its arguments, we are not permitted to consider its arguments now.<sup>3</sup> 37 C.F.R. § 42.71(d).

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<sup>2</sup> Even if Dr. Tomalin did discuss Figure 2a2 more extensively in his declaration, Petitioner could not rely on discussion that appeared there but not in the Petition. 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated from one document into another document.”).

<sup>3</sup> We do not mean to suggest that there are never any circumstances under which a party may raise an argument for the first time in a rehearing request. For example, waiver of the requirements of 37 C.F.R. § 42.71(d) may be appropriate when a party shows good cause for such a waiver. Here, however, Petitioner does not argue, much less persuade us, that waiver of those requirements is warranted. Req. 1–15 (posing new arguments

Ignoring the violation of § 42.71(d) and considering Petitioner's new arguments, we still are not persuaded that those arguments show that we abused our discretion in determining that the Korean application disclosed cracks in the alloy layer and the coating layer. Even if Petitioner is correct that Figure 2a2 shows no cracks or does not show cracks clearly enough, our Institution Decision cited other evidence that Petitioner does not dispute.

First, as Petitioner admits, the Korean application discloses that its "coating layer" has cracks "uniformly formed" within it. Pet. 19 (citing Ex. 1013, 6–7). Petitioner interprets this disclosure of cracks in the "coating layer" as limited to the outermost layer of the Korean application's wire, rather than also in any underlying alloy layer. *Id.* But, as Petitioner admits, the "coating layer" described in the Korean application is not merely the outermost layer, but is instead made up of "three parts": "beta brass, a mixed portion of beta and gamma brass, and zinc on the surface." *Id.* at 18–19. If cracks are "uniformly formed" within the "coating layer," then they are present in all three of these parts, including the "beta brass" and "mixed . . . beta and gamma brass" layers, each of which is an alloy. *See* Dec. 8.

Second, the alloy layer immediately underlying the zinc layer in the Korean application is made up of a mixture of beta brass and gamma brass. As Dr. Tomalin admits, gamma brass "crack[s] under cold drawing," and beta brass may crack. Ex. 1004 ¶ 29 (citing Ex. 1007 ¶¶ 7, 8, 12, 18). The drawing process disclosed in the Korean application is cold drawing, as Dr. Tomalin admits. Ex. 1004 ¶ 55; Ex. 1013, 7. Thus, the likely result of carrying out the drawing process of the Korean application on the wire

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regarding Figure 2a2 but not arguing that the failure to make these arguments previously should be excused).

disclosed in the Korean application is that the layer made up of a combination of beta and gamma brass will crack.

Given the evidence that the uppermost alloy layer of the Korean application is likely to crack when drawn, and given that the wire of the Korean application has cracks uniformly throughout its zinc and alloy layers, even if we were to accept that Figure 2a2 of the Korean application does not adequately show cracks in the alloy layer and the coating layer, we are not persuaded that it was an abuse of discretion for us to determine that the Korean application disclosed such cracks.

We also are not persuaded by Petitioner's argument that there is a genuine issue of material fact due to the competing testimony of the parties' declarants. Req. 14–15. As discussed above and in our Institution Decision, we do not find support in the evidentiary record for Dr. Tomalin's opinions. Despite testifying both that the "coating layer" of the Korean application includes "beta brass," "beta/gamma brass," and "zinc" layers, and that the "coating layer" contains uniform cracks, Dr. Tomalin also testifies that the cracks described in the Korean application are limited to the outermost zinc layer. Ex. 1004 ¶¶ 51–52, 56. This testimony is internally inconsistent, so it cannot create a genuine dispute of material fact.

Thus, we are not permitted to consider any of the arguments Petitioner makes in its Request for Rehearing. 37 C.F.R. § 42.71(d). Even ignoring that problem and considering those arguments, we are not persuaded that we abused our discretion in deciding not to institute *inter partes* review.

## CONCLUSION

Upon consideration of the Request for Rehearing, the Petition, the Preliminary Response, and the evidence before us, we determine that

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