

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXOCAD GMBH AND EXOCAD AMERICA, INC.,
Petitioner,

v.

3SHAPE A/S,
Patent Owner.

Case IPR2018-00785
Patent 9,336,336 B2

Before SALLY C. MEDLEY, IRVIN E. BRANCH, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

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

I. INTRODUCTION

On March 13, 2018, exocad GmbH and exocad America, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–30 of U.S. Patent No. 9,336,336 B2 (“the ’336 patent”). On July 8, 2018, 3Shape A/S (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). In our Decision dated October 3, 2018, (Paper 8, “Decision” or “Dec.”), we declined to institute *inter partes* review because we were not persuaded that “Petitioner has shown that the challenged claims should be reviewed in view of the same or substantially the same prior art or arguments having been previously presented to the Office.” Dec. 21 (citing 35 U.S.C. § 325(d)). On November 2, 2018, Petitioner filed a Request for Rehearing (Paper 9, “Request” or “Req.”). We have considered Petitioner’s Request for Rehearing, and, for the reasons set forth below, Petitioner’s Request is *denied*.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” A request for rehearing is not an opportunity merely to disagree with the panel’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence. “The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). Further, “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

III. ANALYSIS

In determining whether to institute *inter partes* review, a petition may be denied unless we determine that the information presented in the petition and any response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Our discretionary determination of whether to institute review is guided by 35 U.S.C. § 325(d), which states, in relevant part “[i]n determining whether to institute or order a proceeding . . . the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

In the Request, Petitioner argues that, “[i]n declining to institute a trial, under 35 U.S.C. § 325(d), the Decision (Paper 8) relies on the premise that the Examiner already considered Applicants’ argument.” Req. 1, 5–7. This is inaccurate. In our Decision, we determined that “the Office already considered Malfliet extensively during the prosecution of the challenged claims.” Dec. 12. Importantly, we determined that “Petitioner has not articulated sufficient reasoning for us to question the Examiner’s previous consideration of Malfliet.”¹ *Id.* We accordingly “decline[d] to consider grounds based upon Malfliet again.” *Id.* Our Decision, therefore, was not premised solely on whether the Examiner had already considered *Applicants’ arguments*, as Petitioner argues, but rather was based on Petitioner’s failure to explain sufficiently on the preliminary record why we

¹ International Publication Number WO 2008/128700 A1 to Malfliet et al., published October 30, 2008 (Ex. 1006, “Malfliet”)

should institute an *inter partes* review when, as Petitioner did not dispute, the Examiner had considered Malfliet during prosecution. *Id.* at 9–10 (citing Ex. 1004, 834–835). Indeed, in the Petition, Petitioner acknowledged that, “[d]uring prosecution, the Examiner rejected all claims based on Malfliet.” Pet. 3 (citing Ex. 1004 at 825–834).

Moreover, in reviewing the prosecution history of the ’336 patent, we considered Petitioner’s arguments that Patent Owner may have misrepresented or mischaracterized Malfliet’s teachings during prosecution. Decision 12; *see* Req. 7–9. The prosecution history does not indicate that the Examiner relied on Patent Owner’s potentially inaccurate statements in making the findings about the teachings of Malfliet. Ex. 1004 at 825–834.

Petitioner disagrees with our assessment of the prosecution history and asserts that “as a practical matter, even where an Examiner has reviewed a reference in its entirety and made general statements about having done so, it is unrealistic to assume that the Examiner considered every line of a prior art reference with an eye toward every claim limitation.” Req. 6. In this regard, Petitioner seeks to have us disregard the explicit statements made by the Examiner. We decline to do so, especially because Petitioner has not explained persuasively why in the particular circumstances here we must ignore or question the Examiner’s express statements that he has reviewed and considered Malfliet in its entirety.

Additionally, Petitioner raises the *Becton* factors for the first time in the Request and then only discusses factors (d) and (e). Req. 4–5 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. 17–18 (PTAB Dec. 15, 2017) (Paper 8) (Informative) (“the *Becton*

factors”²); *cf.* Pet. 67. Petitioner contends “the challenge based on anticipation by Malfliet . . . should not have been rejected based on § 325(d) because at least two of the factors . . . – (d) and (e) – weigh strongly against such a rejection.” In contrast, the whole of Petitioner’s arguments regarding section 325(d) in the Petition are provided below:

The Examiner never considered “substantially the same . . . arguments” under § 325(d), because the Examiner did not consider the portion of Malfliet addressing use of a 2D face image, as discussed above, nor obviousness based on Malfliet combined with any other references. *See, e.g., Chimei Innolux Corp. v. Semiconductor Energy Lab. Co.*, IPR2013-00068, Paper 7, at 8 (Apr. 24, 2013) (instituting IPR was not improper where the Examiner had considered the two prior art references but did not consider substantially the same argument presented in the IPR). The Examiner did not consider Kopelman, even though its parent application was cited during prosecution, and neither Wiedmann nor Sachdeva were disclosed or considered during prosecution.

Pet. 67.

² The *Becton* factors are the following:

(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton at 17–18.

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