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Paper No. 26
Entered: September 26, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOSO NORTH AMERICA, INC. and MOSO INTERNATIONAL B.V.,
Petitioners,

v.

DASSO INTERNATIONAL, INC.,
Patent Owner.

IPR2019-00184
Patent 8,709,578 B2

Before MICHELLE N. ANKENBRAND, *Acting Vice Chief Administrative Patent Judge*, WESLEY B. DERRICK and JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

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

I. INTRODUCTION

Moso North America, Inc. and Moso International B.V. (collectively, "Petitioner") filed a Petition (Paper 18, "Pet.") to institute an *inter partes* review of claims 1–15 of U.S. Patent No. 8,709,578 B2 ("the '578 patent"). Dasso International, Inc., ("Patent Owner") filed a Preliminary Response. Paper 22 ("Prelim. Resp."). Having considered the Petition, the Preliminary Response, and the evidence of record, and applying the standard set forth in 35 U.S.C. § 314(a), which requires that Petitioner demonstrates a reasonable likelihood that it would prevail with respect to at least one challenged claim, we did not institute an *inter partes* review. Paper 23 ("Decision" or "Dec.").

Petitioner filed a Request for Rehearing (Paper 24, "Req."), requesting reconsideration of the Decision denying institution of an *inter partes* review.[1] Petitioner contends that we misapprehended or overlooked its arguments regarding the construction of the "slots limitation" (*id*. at 2–6), Li's disclosure of the "slots limitation" (*id*. at 7–11), and Fujiwara's disclosure of the "slots limitation" (*id*. at 11–13).

We have considered Petitioner's Request for Rehearing, and, for the reasons set forth below, Petitioner's Request is *denied*.

II. STANDARD OF REVIEW

When rehearing a decision on institution, we do not review the merits of the decision *de novo*, but instead review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a "decision was based on an erroneous conclusion of law or clearly erroneous

[1] We excused Petitioner's failure to timely file its Request for Rehearing by the original deadline of June 12, 2019, and extended the date for filing to June 26, 2019. Paper 25.

factual findings, or . . . a clear error of judgment." *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The party requesting rehearing has the burden of showing the decision should be modified, and "[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked." 37 C.F.R. § 42.71(d).

III. DISCUSSION

Claim Construction

Petitioner takes issue with our "determin[ation] that the plain meaning of the phrase 'slots penetrating through [a] bamboo strip' requires an extant bamboo strip, namely, one with slots in it." Req. 2 (citing Dec. 8). Petitioner contends that we "overlooked the clear language of the '578 Patent, . . . [stating] 'each bamboo strip may be broken into a plurality of smaller bamboo strips connected with each other'" (*id*. (citing Ex. 1001, 2:57–59)), and misapprehended or overlooked Petitioner's arguments in support of their proposed construction, particularly in "[m]ixing up the words 'in' and 'through'" (*id*. at 4). Petitioner further contends that we ignored portions of the claim phrase (*id*. at 2–3), as well as "context information and the specification of the material(s)" (*id*. at 3–5 (emphasis omitted)), and that we failed to consider evidence from the prosecution history as it should properly be understood (*id*. at 5–6).

We did not overlook the cited language of the '578 patent "[stating] 'each bamboo strip may be broken into a plurality of smaller bamboo strips connected with each other,'" as Petitioner contends, but directly addressed the cited language and Petitioner's contention that its position was consistent, before "determin[ing] that the plain meaning of the phrase 'slots

penetrating through [a] bamboo strip' requires an extant bamboo strip, namely, one with slots in it." Dec. 7–8 (citing Pet. 10, 18; Ex. 1001, 2:57–58; Ex. 1003 ¶ 47). As we explained, we declined "to further construe the term 'slot' or the phrase 'plurality of slots . . . strip,'" because it was not necessary to do so in reaching our decision. *Id*. at 8.

Petitioner's further argument that we misapprehended or overlooked its claim construction argument because we failed to construe "through" in the phrase "slots penetrating through [a] bamboo strip" is misplaced. Req. 2–4. We fully considered the issues raised before determining both that the plain meaning of the phrase, which we determined was its proper meaning, "requires an extant bamboo strip . . . with slots in it" and that it was unnecessary to determine whether the slots extend completely through the bamboo strip. Dec. 8.

Petitioner's further arguments grounded on "context information and the specification of the material(s)" (Req. 3–5 (emphasis omitted)) and the prosecution history, as Petitioner contends it should be understood (*id*. at 5–6), similarly fail to establish any matter misapprehended or overlooked. Although Petitioner now sets forth arguments grounded on the context in which the term "through" is used, including the materials used, as supporting a particular depth of a slot (*id*. at 3, 5), Petitioner fails to identify where it raised any such argument in the Petition (*see generally id*.). Arguments raised for the first time in a Request for Rehearing do not identify any matter that we misapprehended or overlooked in denying institution because those arguments were not before us. *See* 37 C.F.R. § 42.71(d). Moreover, as discussed in the Decision, we considered the '578 patent's disclosure and the prosecution history, but determined that it was unnecessary for purposes of

the Decision to determine whether the slots extend completely through the bamboo strip. Dec. 7–8. Nothing in Petitioner's Request for Rehearing convinces us to the contrary.

Li's Disclosure

As to "Li disclos[ing] bamboo strips formed with a plurality of slots," Petitioner contends that we "misapprehended [its] arguments explaining how a person of ordinary skill in the art at the time of the invention . . . would have understood Li to disclose the features of claims 1 and 8." Req. 7. Petitioner contends that our Decision was grounded on its "argument [being] based on the 'bare assumption that the rolling process in Li would provide the same structure as disclosed in the '578 patent.'" *Id*. (citing Dec. 15). Petitioner then sets forth particular arguments it contends were misapprehended or overlooked. *Id*. at 7–9. Petitioner further contends that our "apparent reliance on the Patent Owner's translation of Li (Sun)" "led [us] to misapprehend the legitimacy of Petitioner's arguments." *Id*. at 9–10.

Petitioner's characterization of our Decision disregards our consideration of Petitioner's translation of Li's disclosure. In the Decision, we recognized Petitioner's argument was grounded on its translation of Li's disclosure, with Mr. Böck's testimony offered to support what Petitioner contended a person of ordinary skill in the art would have understood Li to disclose. Dec. 13–16 (citing Exs. 1003 and 1004).

Petitioner argues, again, that "the presence of gaps in Li's bamboo strip does meet the limitations of 'slots penetrating through said bamboo strip substantially in a direction of thickness defined by said bamboo strip.'"

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