

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ATHENA AUTOMATION LTD.,
Petitioner,

v.

HUSKY INJECTION MOLDING SYSTEMS LTD.,
Patent Owner.

Case IPR2013-00290
Patent 7,670,536 B2

Before JENNIFER S. BISK, MICHAEL J. FITZPATRICK, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

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

SUMMARY

Petitioner, Athena Automation Ltd., requests rehearing of the Board's Final Written Decision (Paper 45, "Final Decision" or "Dec."). Paper 46 ("Req. Reh'g"). Specifically, Petitioner seeks rehearing of our finding that Petitioner had failed to meet its burden of proving that claims 1–7, 12, and 17–20 of U.S. Patent No. 7,670,536 ("the '536 patent") are anticipated by Glaesener (Ex. 1002), incorporating Choi (Ex. 1003) by reference. Req. Reh'g 1.

We grant Petitioner's requests insofar as we have reconsidered our finding, but for the reasons discussed below, we are still persuaded that Petitioner has not met its burden of proving the challenged claims are anticipated as asserted in the Petition (Paper 3, "Pet.").

DISCUSSION

The requirements for a request for rehearing are set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The 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.

The Petition, in this case, asserts that claims 1–7, 12, and 17–20 are anticipated by Glaesener and Choi, which can be considered together as a single prior art reference because "Glaesener expressly incorporates Choi by reference." Pet. 32 (citing Ex. 1002 ¶¶ 35 ("The tie-bar nuts can be secured to the rear wall 16

by any appropriate mechanism, such as the pineapple and toothed-ring mechanism described in [Choi].”), 49 (“All cross-referenced patents and application referred to in this specification are hereby incorporated by reference.”)). Patent Owner did not address this issue in its Patent Owner Response. Paper 24 (addressing only the issue of assignor estoppel).

In instituting trial, we were persuaded that Petitioner had shown a reasonable likelihood that Athena would prevail on this proposed ground, stating that “the broad language used in Glaesener incorporates the Choi specification by reference.” Paper 18, 15. In our Final Decision, however, we did not make a final determination regarding what, if any, portions of Choi are incorporated by Glaesener. Dec. 30. Instead, we found that even when considered as one reference, we were not persuaded that Petitioner had met its burden to show that the combination of Glaesener and Choi teach all the recited claim limitations in the same form and order as listed in the claim. *Id.* We based this decision on the lack of explanation or evidence describing: (1) how the elements of Choi, relied upon by Petitioner, secure the tie-bar nuts of Glaesener to rear wall 16 of Glaesener’s platen and (2) what part of Choi is included in the term “pineapple and toothed-ring mechanism.”

Petitioner contends that this decision: (1) overlooks the argument and evidence cited at pages 26–28 of the Petition, where Petitioner “explains in detail how the lock depicted in Choi Figure 3A (that is, the ‘pineapple and toothed-ring mechanism’) . . . operates as part of a platen such as the one in Glaesener”; (2) misapprehends the reference in Glaesener to “tie-bar nuts”; and (3) overlooks

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fundamental legal principles that govern anticipation and incorporation by reference. Req. Reh’g 1–3.

Incorporation by Reference

We begin with Petitioner’s third contention—that we overlooked fundamental legal principles that govern anticipation and incorporation by reference. Req. Reh’g 11–15. Petitioner asserts that failing to decide the issue of incorporation by reference was erroneous because if Glaesener incorporated Choi in its entirety, “the reference to ‘the pineapple and toothed-ring mechanism’ becomes irrelevant.” Req. Reh’g 12-13. Although we are not persuaded that such a determination is required, if it were, we are not persuaded that Petitioner has shown sufficiently that Glaesener incorporates by reference Choi in its entirety. Moreover, we are not persuaded that Petitioner has shown sufficiently that Glaesener incorporates the relied upon portions of Choi.

“Material not explicitly contained in the single, prior art document may still be considered for purposes of anticipation if that material is incorporated by reference into the document.” *Adv. Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). Whether and to what extent a document incorporates material by reference is determined based on, “whether one reasonably skilled in the art would understand [the document] as describing with sufficient particularity the material to be incorporated.” *Harari v. Lee*, 656 F.3d 1331, 1334 (Fed. Cir. 2011) (citing *Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378–79 (Fed. Cir. 2007)).

In the Decision to Institute, we were persuaded that “the broad language used in Glaesener incorporates the Choi specification by reference.” Paper 18, 15 (citing *Harari*, 656 F.3d at 1334–35 (Fed. Cir. 2011)). The Federal Circuit found that the application at issue in *Harari* incorporated by reference another application disclosure because it used “the broad and unequivocal language: ‘The disclosures of the two applications are hereby incorporate[d] by reference.’” The patent at issue in *Harari* also had a second incorporation statement more specifically referring to “relevant portions of the disclosures.” *Harari*, 656 F.3d at 1335. Citing expert testimony, the Court found that the relied upon disclosure of the reference was included in the “relevant portions,” and therefore, incorporated by reference. *Id.* at 1336–37.

Glaesener, indeed, contains similar language to the broad incorporation statement of *Harari*—“All cross-referenced patents and application referred to in this specification are hereby incorporated by reference.” Ex. 1002 ¶ 49. Similarly, Glaesener also includes a second statement referring to Choi, which states that “[t]he tie-bar nuts can be secured to the rear wall 16 by any appropriate mechanism, such as the pineapple and toothed-ring mechanism described in [Choi].” Ex. 1002 ¶ 35. In contrast to the facts in *Harari*, however, there is nothing in Glaesener that indicates that a person of ordinary skill would have understood what portions of Choi that Glaesener is referring to by referencing the “pineapple and toothed-ring mechanism.” In fact, the term is not used anywhere else in Glaesener and is not used at all in Choi. *See* Paper 44 (“Tr.”), 16:7–10 (Q: “So, the one time that Glaesener actually refers to Choi it talks about the pineapple

and tooth. But then I guess Choi doesn't actually use that particular term?" A: "Correct."). And Petitioner does not explain persuasively that a person of reasonable skill in the art would have understood this language as describing, with sufficient particularity, any specific portion of Choi. *See Adv. Display*, 212 F.3d at 1282–83 ("To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents.") (citing *In re Seversky*, 474 F.2d 671, 674 (CCPA 1973)).

Moreover, Petitioner points to no evidence, and only to attorney argument, supporting what a person of ordinary skill in the art would understand the term "pineapple and toothed-mechanism" to mean. *See* Ex. 1006 ¶¶ 25–30 (describing the disclosures of Glaesener and Choi without explanation or reference to the term "pineapple and toothed-ring mechanism"), ¶¶ 44–55 (describing finite element analysis of a combination of Glaesener and Choi); Ex. 1006 ¶¶ 22–26 (assuming, without explanation or reference to the term "pineapple and toothed-ring mechanism," that Glaesener incorporates Choi); *see also* Tr. 16:11–17:3 (Q: "Do we have any evidence on the record of an expert or any other evidence saying that a person of ordinary skill would know that this is what Glaesener was referring to[?]" A: "Well, let me just say that a picture is worth a thousand words. . . . [I]n context it's clear that what they're referring to, the pineapple lock mechanism, is –

a tooth mechanism i[n] Figure 3A in Choi.”).¹ The identification of where Choi describes a “pineapple and toothed-ring mechanism,” and the explanation of why Glaesener’s disclosure of such would be understood to be Figure 3A of Choi was not discussed in Petitioner’s proffered declaration. The argument of counsel cannot take the place of evidence lacking in the record. *Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997).

Finally, it is not clear, simply by looking at Glaesener and Choi, what portions of Choi are to be included in the “pineapple and toothed-lock mechanism.” Choi describes “[a] system and process for controlling mold activity of a molding machine,” including “a clamping device,” a mold platen with a movable mold half, a second platen with another mold half, “[a] device for monitoring and controlling the position of the clamping device and movable platen,” and “a mechanism for sustaining the clamp-up force at a prescribed level.” Ex. 1003, Abs. It is, therefore, not trivial, without evidence of how a person of ordinary skill in the art would understand the term, to determine exactly which portions of Choi are referred to in Glaesener’s incorporation statement. Thus, we are not persuaded that Glaesener’s language purportedly incorporating the entirety of Choi by reference is analogous to the language in *Harari*.

Petitioner has not pointed to a more analogous Federal Circuit holding. Although Petitioner cites to several cases allegedly supporting its assertion of express incorporation (Pet. 32; Paper 31, 9), none of these cases is analogous to the

¹As explained in our Decision Denying Petitioner’s Motion to File Supplemental Evidence (Paper 52), we are not persuaded that Patent Owner misled the Board in

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situation here. *See Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1345–48 (Fed. Cir. 2009) (holding that patent “identifies with specificity both what material is being incorporated by reference (foamable polymeric compositions suitable for golf ball cover layers) and where it may be found”); *Adv. Display*, 212 F.3d at 1282 (making no decision on incorporation by reference, but remanding for a new trial when the Court left the decision—a question of law—to the jury); *Ultradent Prods., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 1069 (Fed. Cir. 1997) (holding that a patent that states: “The commercial product PROXIGEL, described in U.S. Pat. No. 3,657,413 issued on Apr. 18, 1972 to M. W. Rosenthal, which patent is hereby incorporated herein by reference, is one attempt to overcome the problems of hydrogen peroxide by using urea peroxide in a slowly dispersable glycerol based solvent” followed by several paragraphs discussing the disclosure of that patent, incorporates by reference the entire contents of the referenced patent). None of these cases involve a general incorporation by reference statement followed by a more specific reference that does not clearly identify the disclosure to which it refers.

Because we are not persuaded that Petitioner has shown that Glaesener describes the material of Choi to be incorporated with sufficient particularity for a person of ordinary skill in the art, we are not persuaded that Petitioner met its burden of proving anticipation by a preponderance of the evidence. 35 U.S.C. § 316(e).

its Patent Owner Response or oral arguments.

Anticipation

As explained above, in the Final Written Decision, we determined that even if Glaesener incorporated by reference the entirety of Choi, we were still not persuaded that Petitioner met its burden to show that the various portions of Choi and Glaesener, upon which Petitioner relies, are combined in the same way as recited in the challenged claims. Dec. 30–31. Petitioner argues that this ultimate determination regarding anticipation was incorrect. Req. Reh’g at 11. Because we now determine that Petitioner has not shown sufficiently that Glaesener incorporates any portion of Choi for purposes of anticipation, we do not address Petitioner’s arguments on this issue or revisit Petitioner’s position regarding anticipation.

CONCLUSION

Petitioner’s Request for Rehearing is *granted* to the extent that we reconsider our finding that Petitioner failed to carry its burden in proving that claims 1–7, 12, and 17–20 of the ’536 patent are anticipated by Glaesener, incorporating Choi by reference, but *denied* in all other respects.

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