

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONE WORLD TECHNOLOGIES, INC.,
d/b/a TECHTRONIC INDUSTRIES POWER EQUIPMENT,
Petitioner,

v.

CHERVON (HK) LIMITED,
Patent Owner.

PGR2020-00061
Patent 10,524,420 B2

Before LINDA E. HORNER, JAMES J. MAYBERRY, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of Decision Denying Institution
of Post-Grant Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

One World Technologies, Inc., d/b/a Techtronic Industries Power Equipment (“Petitioner”) filed a Petition requesting a post-grant review of claims 1–15 of U.S. Patent No. 10,524,420 B2 (“the ’420 patent”). Paper 1 (“Pet.”). Chervon (HK) Limited (“Patent Owner”) filed a Preliminary Response. Paper 11 (“Prelim. Resp.”).

On December 7, 2020, we denied institution (Paper 16, “Dec.”) because Petitioner failed to show that the ’420 patent is eligible for post-grant review. Dec. 2, 10–18.

Petitioner filed a Request for Rehearing (Paper 17, “Req. Reh’g”) seeking reconsideration of our eligibility analysis and of our decision to deny institution. Petitioner also filed Exhibit 1025 with the Request for Rehearing. For the reasons stated below, we *deny* the Request for Rehearing and expunge Exhibit 1025.

II. NEW EVIDENCE

Petitioner filed Exhibit 1025 with its Request for Rehearing. Req. Reh’g 15 n.4. This exhibit was not of record at the time the Decision Denying Institution was entered. *See id.* (Petitioner acknowledging that “Exhibit 1025 is being added to the record of this proceeding concurrently with this Request for Rehearing; Ex. 1025 was originally ‘Reserved.’”). Petitioner did not request a conference call with the Board prior to submitting Exhibit 1025, nor did Petitioner explain in the Request for Rehearing why this exhibit should be admitted. Thus, Petitioner has not established good cause to admit Exhibit 1025. *See Huawei Device Co. v. Optis Cellular Tech., LLC.*, IPR2018-00816, Paper 19 at 3–4 (PTAB Jan. 8, 2019) (expunging exhibits filed with a request for rehearing when the

petitioner failed to establish good cause for admitting the exhibits)¹; *see also* Consolidated Trial Practice Guide 90 (Nov. 2019)² (“Absent a showing of ‘good cause’ prior to filing the request for rehearing or in the request for rehearing itself, new evidence will not be admitted.”).

Because Petitioner has not established good cause to admit Exhibit 1025, we expunge the exhibit from the record.

III. ANALYSIS

When reconsidering a decision on institution, we review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c) (2019). An abuse of discretion occurs if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The party requesting rehearing has the burden of showing the decision should be modified, which includes specifically identifying all matters the party believes were misapprehended or overlooked. *See* 37 C.F.R. § 42.71(d).

In our Decision Denying Institution, we found that Petitioner failed to meet its burden to show that the ’420 patent is eligible for post-grant review. *See* AIA § 3(n)(1)(B) (making the AIA applicable to a patent that claims priority under 35 U.S.C. § 120, 121, or 365(c) to any patent or application

¹ The Office designated *Huawei* precedential on April 5, 2019, well over a year before our Decision and Petitioner’s Request for Rehearing in this case. Petitioner should have been aware of this Board precedent and addressed it if it wished to submit new evidence.

² Available at <https://www.upsto.gov/TrialPracticeGuideConsolidated>.

that contains or contained at any time a claim having an effective filing date on or after March 16, 2013); 37 C.F.R. § 42.204(a) (requiring a petitioner to certify that the patent for which review is sought is available for post-grant review); *Mylan Pharms. Inc. v. Yeda Res. & Dev. Co.*, PGR2016-00010, Paper 9 at 10 (PTAB Aug. 15, 2016) (holding that the ultimate burden of persuasion remains with a petitioner to demonstrate that the challenged patent is eligible for post-grant review).

Petitioner’s basis for arguing in the Petition that the ’420 patent is eligible for post-grant review was that the ’627 patent³, to which the ’420 patent claims priority, allegedly contains at least one claim having an effective filing date on or after March 16, 2013. Pet. 10–11. Specifically, Petitioner asserts that the parent ’627 patent claims subject matter, i.e., a “gripping member” and a “handle,” disclosed only in the later CN040 priority application⁴ filed after March 16, 2013. *Id.* at 11 (citing Ex. 1023, claim 1). Petitioner asserts that the earlier CN914 priority application⁵ does not disclose this claimed subject matter. *Id.* at 13. Petitioner bore the burden on this issue.

We found, “Petitioner’s evidence in support of its assertion that “[t]he earlier [CN914] application does not disclose a “gripping member” and “handle”” is inadequate.” Dec. 16. Specifically, we faulted Petitioner’s logic in attempting to show that the earlier CN914 application does not disclose these claimed features by showing that the later CN040 application

³ U.S. Pat. 9,888,627 B2 (Ex. 1023, “the ’627 patent”).

⁴ Chinese priority application CN 2012 20602040U (“CN040”), filed May 3, 2013.

⁵ Chinese priority application CN 2012 10387914 (“CN914”), filed October 14, 2012.

does disclose them. *Id.* at 16–17 (“[T]he depiction of what appears to be a substantially cylindrical gripping member and an elongated handle in the later CN040 application does not exclude these features also from being disclosed in the earlier CN914 application.”). We also noted that Patent Owner demonstrated the earlier CN914 application “appears to show similar-looking features as the substantially cylindrical gripping member and the elongated handle identified by Petitioner in the figures of the later CN040 application.” *Id.* at 17. We faulted Petitioner for failing “to address the drawings presented in the earlier CN914 application or establish sufficiently that the claim features of the parent ’627 patent are not disclosed therein.” *Id.*

Petitioner argues that the Board’s Decision “seemingly admonishes Petitioner for not submitting affirmative evidence to prove a negative – that the CN914 application fails to disclose what is claimed in claims 1-5 and 6-10 of the ’627 patent.” Req. Reh’g 6. Petitioner argues, “The Decision does not explain what additional evidence this Board expected, but Petitioner concedes it ‘d[id] not refer to any specific support’ in the earlier CN914 application because that is the point – the CN914 application does not disclose what is claimed.” *Id.*

Petitioner’s objection to being expected to prove a negative is unpersuasive. Petitioner provides substantive analysis of the figures in the CN914 application in this Request for Rehearing and points out alleged “material differences” between the figures in the CN914 and CN040 applications. Req. Reh’g 12–15 (emphasis omitted). This is exactly the type of analysis and argument that could have been supportive of Petitioner’s

position had it been presented to the Board in the Petition.⁶ Petitioner did not provide any such analysis in its Petition. Rather, the Petition simply asserted that the CN914 application does not disclose the claimed features without any supporting discussion and analysis of what is shown, or not shown, in the figures of the CN914 application. Pet. 13. Further, as noted in our Decision, Petitioner also failed to provide us with an English language translation of either the CN040 application or the CN914 application. Dec. 14–15. Petitioner’s belated analysis presented for the first time in the Request for Rehearing highlights the lack of analysis in the Petition.

Petitioner also argues that the Board’s Decision “rel[ies] impermissibly on what is disclosed only in the later CN040 application” to conclude that the earlier CN914 application provides written description support for the claimed “handle.” Req. Reh’g 6. This argument misapprehends the Board’s Decision. The Decision turned on whether *Petitioner had met its burden* to show that the ’420 patent is eligible for post-grant review by showing that the “handle” claimed in the ’627 patent was not disclosed in the CN914 application. The Decision found Petitioner’s showing inadequate. Dec. 16–17.

Further, to the extent that the Board considered Patent Owner’s arguments comparing the figures of the CN914 and CN040 applications, the Board did not adopt Patent Owner’s assertion that “Figure 3 of [the] CN914

⁶ Petitioner also did not seek leave to file a reply to the Patent Owner Preliminary Response to address Patent Owner’s argument that the figures of the CN914 application provide adequate support for the claimed features. 37 C.F.R. § 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.”).

[application] is *nearly identical* to Figures 1 and 4 of [the] CN040 [application].” Req. Reh’g 7 (quoting Prelim. Resp. 13). Instead, the Board noted in its Decision that “the earlier CN914 application appears to show similar-looking features as the substantially cylindrical gripping member and the elongated handle identified by Petitioner in the figures of the later CN040 application.” Dec. 17. Petitioner’s argument that it was improper for the Board to rely on the figures of the CN040 application is unsuccessful, given that it was Petitioner who relied on the comparison of the CN040 application and the CN914 application to argue that the CN914 application lacks written description support for claims 1 and 6 of the ’627 patent. Pet. 11–12.

Petitioner identifies, for the first time in the Request for Rehearing, alleged “material differences” between the earlier figures of the CN914 application and the later figures of the CN040 application. Req. Reh’g 9–15 (emphasis omitted). First, Petitioner argues for the first time in its rehearing request that the CN914 application does not disclose the “proximity” limitation of the claims of the ’627 patent. *Id.* at 9–10 (arguing that the figures of the CN914 application do not depict “the claimed *proximity of the handle to the ‘gripping portion’* of an operating arm” (emphasis added)). Petitioner never identified this “proximity” limitation as the basis for post-grant review eligibility in the Petition. Second, Petitioner argues for the first time on rehearing, with reference to newly annotated figures from the CN914 and CN040 applications, that the two parallel lines shown on the front of the mower in the CN914 application depict “a flat exterior surface contiguous with the convex surface at the front of the mower” that is “in the manner of an adhesive protecting strip.” *Id.* at 10–13. Third, Petitioner

urges us, for the first time on rehearing and with reference to new evidence, to infer from the manner in which a “handle-like component” and a front handle were depicted in the CN914 application and in another patent owned by the Patent Owner, that the component depicted on the front of the mower in the CN914 application is not a “handle.” *Id.* at 14–15.

We could not have misapprehended or overlooked these arguments because they are new arguments presented for the first time in the Request for Rehearing. In its Petition, Petitioner argued that the CN040 application discloses “an operating arm” that “includes a substantially cylindrical gripping portion” and “an elongated handle positioned on a [front] end” of the main body, as recited in the claims of the ’627 patent. Pet. 11–12 (alteration in original) (referring to annotated Figures 1 and 4 of the CN040 application). As to the disclosure of the earlier CN914 application, Petitioner stated only that “[t]he earlier Chinese application does not disclose a ‘gripping member’ and ‘handle.’” *Id.* at 12. In its Preliminary Response, Patent Owner argued that “Petitioner’s conclusory and unsupported statement that [the] CN914 [application] fails to disclose a ‘substantially cylindrical gripping portion’ or an ‘elongated handle’ cannot, as a matter of law, satisfy Petitioner’s burden of establishing that the [’]420 patent is eligible for post[-]grant review.” Prelim. Resp. 12. Patent Owner also compared the figures from the CN914 and CN040 applications and argued that the figures from the CN914 application do disclose a “substantially cylindrical gripping portion” and an “elongated handle.” *Id.* at 12–13. After receiving notice that the disclosure shown in the figures of the CN914 application was in dispute, Petitioner could have contacted the Board to request authorization to file additional briefing on this issue.

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Petitioner did not do so. Because Petitioner did not attempt to bring this issue to the Board's attention prior to entering the Decision Denying Institution, we decline to consider its new arguments for the first time on rehearing. *See Huawei*, IPR2018-00816, Paper 19 at 8–9.

IV. CONCLUSION

For the reasons stated above, we conclude that we did not abuse our discretion in determining that Petitioner failed to meet its burden to show the '420 patent is eligible for post-grant review and for denying post-grant review. Therefore, we *deny* Petitioner's request to institute this proceeding.

V. ORDER

Accordingly, it is

ORDERED that Petitioner's Request for Rehearing is *denied*.

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