

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PHILIP MORRIS PRODUCTS, S.A.,  
Petitioner,

v.

RAI STRATEGIC HOLDINGS, INC.,  
Patent Owner.

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IPR2020-01094  
Patent 9,930,915 B2

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Before JEFFREY W. ABRAHAM, ELIZABETH M. ROESEL, and  
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

DECISION  
Denying Patent Owner's Request for Rehearing  
*37 C.F.R. § 42.71(d)*

## I. INTRODUCTION

RAI Strategic Holdings, Inc. (“RAI” or “Patent Owner”) timely filed a request for rehearing (Paper 30, “Request” or “Reh’g Req.”) of our Final Written Decision (Paper 29, “Decision” or “Dec.”) determining that claims 1–5 (“the challenged claims”) of U.S. Patent No. 9,930,915 B2 (Ex. 1001, “the ’915 Patent”) are unpatentable as obvious based on Collins<sup>1</sup> alone or in combination with Brooks.<sup>2</sup> The Decision addresses Patent Owner’s arguments, as presented in a Patent Owner Response (Paper 12, “PO Resp.”) and Patent Owner Sur-reply (Paper 20, “PO Sur-reply”).

## II. STANDARD OF REVIEW

The standard applicable to a request for rehearing of a Board decision is provided in Rule 42.71(d), which states in pertinent part:

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.

37 C.F.R. § 42.71(d) (2021). A request for rehearing is not an opportunity to present new arguments or evidence or merely to disagree with the panel’s assessment of the arguments or weighing of the evidence.

## III. ANALYSIS

### *A. The Board Did Not Overlook Patent Owner’s Arguments Relying on the Prosecution History of the ’915 Patent*

Patent Owner asserts that we failed to address Patent Owner’s argument that Petitioner’s Collins-led ground is merely a rehash of the

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<sup>1</sup> Ex. 1007, US 5,505,214, issued April 9, 1996 (“Collins”).

<sup>2</sup> Ex. 1006, US 4,947,874, issued August 14, 1990 (“Brooks”).

Counts-594<sup>3</sup> reference overcome during prosecution. Reh’g Req. 1, 4 (citing PO Resp. 63–64). We disagree.

Although the Decision does not cite the prosecution history of the ’915 Patent (Ex. 1002) or Counts-594 (Ex. 1011), that does not mean we overlooked Patent Owner’s argument. In the Request, as in the Patent Owner Response, Patent Owner argues that “Collins’ snap-fit connection is essentially the same as the Counts-594 reference overcome during prosecution.” Reh’g Req. 5; PO Resp. 64. The Decision explains why the snap fit connection does not distinguish Collins from claim 1 of the ’915 Patent. Dec. 36–37. That discussion fully addresses Patent Owner’s “snap-fit connection” argument, without the need to expressly mention Counts-594 or the prosecution history.

Patent Owner has not asserted, either during trial or in its Request, that a snap fit connection was relied upon to distinguish the prior art from the claim during prosecution. In fact, the Patent Owner Response provided a different explanation for why the claim was allowed over Counts-594: “The Office found that in Counts-594, pins 104 are not ‘located on the projection,’ as claimed, because they ‘extend past a bottom outer surface of the assembly that includes the projection’ and ‘are received in corresponding sockets (or receptacles) external to the projection.’” PO Resp. 41 (citing Ex. 1002, 305). Because the snap fit connection was not a distinction relied upon during prosecution, there was no need for us to discuss this alleged similarity between Collins and Counts-594 when addressing Patent Owner’s argument opposing Petitioner’s Collins-led ground.

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<sup>3</sup> Ex. 1011, US 5,388,594, issued February 14, 1995 (“Counts-594”).

Although the Request directs us to Mr. Clemens' testimony about the prosecution history and Counts-594 (Reh'g Req. 2–4 (citing and quoting Ex. 2015 ¶¶ 30–53)), that testimony was nowhere cited or discussed in the Patent Owner Response or the Patent Owner Sur-reply. When arguing that Collins does not disclose the claimed “projection” of the electrical energy source, neither Patent Owner nor Mr. Clemens discussed the prosecution history, apart from arguing that Collins' snap fit connection is similar to Counts-594. PO Resp. 58–68; PO Sur-reply 13–14; Ex. 2015 ¶¶ 121–33. We cannot have overlooked or misapprehended evidence or arguments that Patent Owner failed to properly present in the Patent Owner Response or Patent Owner Sur-reply.

Consideration of Mr. Clemens' testimony about the prosecution history and Counts-594 (Ex. 2015 ¶¶ 30–53) has no impact on our patentability analysis in any event. As discussed above, neither Patent Owner nor Mr. Clemens asserts that the alleged common feature—a snap fit connection between multiple parts of the electrical energy source—was relied upon to distinguish the claim during prosecution. Even if Collins and Counts-594 are similar, that is not evidence that weighs against Petitioner's ground of unpatentability when the alleged similarity fails to distinguish the claim.

Accordingly, Patent Owner has not shown that the Board overlooked Patent Owner's arguments relying on the prosecution history of the '915 Patent.

*B. The Board Did Not Misapprehend Patent Owner's Argument Concerning Collins' Heater Support Arms*

Patent Owner argues that we overlooked or misapprehended Patent Owner's argument that “Collins's heater support arms 161 do not disclose

the claimed ‘projection’ *regardless of whether an electrical energy source can be multiple separable parts.*” Reh’g Req. 7 (quoting PO Resp. 66). We disagree.

The Patent Owner Response presented the following argument: “But regardless of whether an electrical energy source can be multiple separable parts, the evidence shows that the POSA would not consider Collins’ heater support arms 161 to be a projection of the terminals 167, which form part of Petitioner’s alleged ‘electrical energy source.’” PO Resp. 66. Patent Owner repeated the same argument multiple times in the Response. *Id.* at 61 (stating “the POSA would never consider the arms 161 to be a projection of the terminals 167”); *id.* at 62 (discussing Dr. Deevi’s testimony that he would not characterize Collins’ heater support arms 161 as a projection of terminals 167, nor a projection of heater base 151); *id.* at 63 (twice stating that “the POSA would never consider the heater support arms 161 to be a projection of the terminals 167”); *id.* at 64 (asserting “Collins’ heater support arms 161 are not a projection of the heater base 151 with terminals 167”); *id.* at 65 (asserting “the heater support arms 161 are not a projection of the terminals 167 that allegedly form part of the ‘electrical energy source’”); *id.* at 66 (again referring to Dr. Deevi’s testimony that he would not characterize Collins’ heater support arms 161 as a projection of terminals 167, nor a projection of heater base 151).

The Decision addresses Patent Owner’s argument as follows:

Patent Owner argues that “the POSA would never consider the [heater support] arms 161 to be a projection of the terminals 167.” PO Resp. 61 (citing Ex. 2015 ¶ 126); *see also id.* at 63, 65 (same argument). That argument, however, does not undermine the persuasiveness of Petitioner’s showing because, as Patent Owner agrees, terminals 167 are *only part* of Collins’ electrical energy source. *Id.*; *see also* Pet. 55–56 (Collins’

electrical energy source includes all components of heater unit 150 except heaters 162 and base 151). In Collins, the electrical energy source includes heater support 155, and Patent Owner agrees that “the heater support arms 161 could possibly be projections of the heater support 155.” PO Resp. 61.

Dec. 37–38. Our Decision fully addresses Patent Owner’s argument, as it was presented in the Patent Owner Response.

In an effort to show that we overlooked or misapprehended an argument in the Patent Owner Response, the Request revises the argument that was presented. Patent Owner asserts that “RAI and Mr. Clemens concluded that ‘[l]ike the plug, the heater support arms 161’ are not a projection of the alleged ‘electrical energy source’ in Collins.” Reh’g Req. 8 (quoting Ex. 2015 ¶ 130, citing PO Resp. 65). In contrast, Mr. Clemens actually testified: “Like the plug, the heater support arms 161 of Collins are not a projection *of the terminals 167*.” Ex. 2015 ¶ 130 (emphasis added). The Patent Owner Response similarly stated: “Likewise, in Petitioner’s Collins ground, the heater support arms 161 are not a projection *of the terminals 167* that allegedly form *part of* the ‘electrical energy source.’” PO Resp. 65 (citing Ex. 2015 ¶ 130) (emphasis added). The Request changes Patent Owner’s argument. Instead of arguing that heater support arms 161 are not a projection *of terminals 167* that form *part of* the “electrical energy source,” as in the Patent Owner Response, Patent Owner now argues that heater support arms 161 are not a projection of the “electrical energy source,” without mentioning terminals 167.

Similarly, Patent Owner asserts that it argued, “the heater support arms 161 are not a projection of any alleged electrical energy source but rather parts of Collins’s heater fixture.” Reh’g Req. 8 (citing PO Resp. 61–62). Again, Patent Owner changes the argument presented in the

Patent Owner Response and addressed in the Decision and abandons its position that heater support arms 161 are not a projection *of terminals 167* that form *part of* the “electrical energy source.” PO Resp. 66. The Request quotes Mr. Clemens as having testified that “heater support arms 161 are not a projection of the alleged electrical energy source because they are part of the . . . heater fixture.” Reh’g Req. 8 (quoting Ex. 2015 ¶ 126). In contrast to Patent Owner’s cropped quote, Mr. Clemens actually testified that “[t]he heater support arms 161 are not a projection of the alleged electrical energy source because they are part of the separate heater fixture *that snap fits to mate with the heater base 151 and terminals 167.*” Ex. 2015 ¶ 126 (emphasis added). Whereas the Request tries to suggest that we failed to address an argument separate from Patent Owner’s “snap fit connection” argument (Reh’g Req. 7), the quoted testimony does not show that Patent Owner presented any such separate argument. Mr. Clemens’ testimony attempts to distinguish Collins based on the snap fit connection between multiple separable components of the “electrical energy source.” Ex. 2015 ¶ 126. That argument that was fully addressed in the Decision. Dec. 36–37.

In the Patent Owner Response, as in the Request, Patent Owner illustrated its argument with an analogy to a wall plug. PO Resp. 64–65; Reh’g Req. 7–8. Although the Decision does not expressly mention Patent Owner’s wall plug analogy, we addressed the underlying argument with our findings that Collins’ heater support arms 161 are each a “projection extending outwardly” from the rest of the electrical energy source, including heater support 155, and that the claimed “electrical energy source” can be multiple separable parts. Dec. 36–37. Even if Collins’ heater base 151 with terminals 167 is analogous to a wall receptacle, and heater support 155 with heater support arms 161 is analogous to a plug that can be inserted into the

wall receptacle, that does not mean that Collins' heater support arms are not a "projection extending outwardly" from the rest of the electrical energy source. As explained in the Decision, an "electrical energy source" can be multiple separable parts, which in Collins includes heater support 155, heater support arms 161, and terminals 167. Dec. 36–37. Patent Owner does not dispute that heater support arms 161 are each a "projection extending outwardly" from heater support 155, which is part of the electrical energy source. Dec. 37; Ex. 1007, Fig. 10.

Accordingly, Patent Owner has not shown that the Board misapprehended or overlooked Patent Owner's arguments concerning Collins' heater support arms.

#### IV. CONCLUSION

For these reasons, Patent Owner does not persuade us that the Decision holding all challenged claims unpatentable should be modified.

#### V. ORDER

It is

ORDERED that Patent Owner's request for rehearing is *denied*.



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