

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC
and MERCEDES-BENZ USA, LLC,
Petitioner,

v.

STRAGENT, LLC,
Patent Owner.

IPR2021-00425
Patent 10,002,036 B2

Before STACEY G. WHITE, DANIEL J. GALLIGAN, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner filed a Request for Rehearing (Paper 15, “Request” or “Reh’g Req.”) under 37 C.F.R. § 42.71(d) to seek modification of the Board’s Decision Denying Institution of its Petition for *inter partes* review (IPR). Paper 14 (“Decision” or “Dec.”).¹

The Request is denied.

II. STANDARD OF REVIEW

On rehearing, the Board reviews a decision on institution 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 factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The party requesting rehearing has the burden to show that the decision should be modified. 37 C.F.R. § 42.71(d). The request for rehearing “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

Petitioner argues that the Board should grant rehearing because (1) the Board misapprehended or overlooked evidence that the Examiner did not consider the prior art or previous IPRs and (2) the Decision conflicts with Board precedent. Reh’g Req. 4–13. We disagree. Our reasoning follows.

¹ Petitioner also requested Precedential Opinion Panel Review of the Board’s decision. Ex. 3002. The Precedential Opinion Panel denied the request. Paper 17 (Order Denying Precedential Opinion Panel Review).

A. The Examiner's Consideration of the Prior Art and Previous IPRs

Petitioner argues that the Board's "denial of institution was based on the incorrect conclusion 'that there was a greater degree of consideration and evaluation of *OSEK* than in cases where the record is silent about a reference listed on an IDS.'" Reh'g Req. 4 (quoting Dec. 13–14). Petitioner, though, does not identify what the Board misapprehended or overlooked. Rather, Petitioner merely presents additional argument about why it disagrees with the Board's decision. *See id.* at 4–6.

For example, Petitioner argues that the written summaries of the interviews between the Examiner and Applicant affirmatively state that no prior art was discussed. *Id.* at 5 (citing Ex. 1002, 36). But the Board never stated that prior art was discussed in an interview or relied upon that fact in the Decision. *See Dec.* Rather, the Decision explained that the Applicant submitted the references in an IDS² before meeting with the Examiner in the interviews. *Id.* at 12–13. Those interviews "led to the complete replacement of the then pending claim set." *Id.* at 14 (citing Ex. 1002, 48–50; Ex. 2003, 44). According to the Decision, because the IDS was submitted before the interviews, the Examiner was aware of the references when the claim amendments were proposed and discussed. *See id.* Thus, the Board did not overlook or misapprehend the written summaries of the interviews.

Petitioner also argues that "there is no evidence that the '705 [(U.S. Patent 8,209,705)] and '843 [(U.S. Patent 8,566,843)] IPR petitions, institution decisions, or final written decisions were considered during prosecution." Reh'g Req. 5. Petitioner argues that "they could not have been, as they were never cited in a properly submitted IDS for the Examiner to

² Information Disclosure Statement

review and sign-off.” *Id.* In Petitioner’s view, “the Examiner was deprived of the Board’s reasoning in interpreting OSEK and Staiger and could not ‘be aware of and evaluate the teachings of all information material to patentability.’” *Id.* at 6; *see also id.* at 7–8 (arguing that Applicant did not explain how the references were relevant or inform the Examiner of the IPR’s importance). We disagree.

The Board considered the prosecution history to evaluate *Becton, Dickinson* factor (c). Dec. 13. That factor determines the focus of factors (e) and (f) concerning the Examiner’s error. *Advanced Bionics*, Paper 6 at 10–11. For example, the Decision explained,

On the same day that the ’110 application was filed, the Applicant submitted an IDS citing 22 references from the OSEK/VDX specification. Ex. 1002, 48–50. On an IDS cover letter, the Applicant identified the IPR proceedings involving the ’705 and ’843 patents. *Id.* at 182–183. The IDS cover letter explained that the references in the IPRs, which included the OSEK references, were submitted to the Examiner. *Id.*

Dec. 13. Considering this prosecution history, the Board determined that the OSEK prior-art reference is the focus of factors (e) and (f). *Id.* at 14.

Notably, the Petition also focused on OSEK in its explanation of why the Examiner erred. *See* Pet. 103. For example, in evaluating *Becton, Dickinson* factors (e) and (f), Petitioner believed that, in a previous IPR, the Board already found that OSEK teaches or suggests the subject matter recited in the challenged claim. *Id.* at 103–104. As discussed in the Decision, the Board disagreed with this assertion because the challenged claims from the ’036 patent recite different subject matter than the claims challenged in the previous IPR. Dec. 14–17.

Thus, we are unpersuaded that the Board’s focus on OSEK in *Becton, Dickinson* factors (e) and (f) was erroneous or based on a misapprehension

of the record. *See* Reh’g Req. 4–6. Instead, the Decision is similar to the Petition in this regard. *See* Pet. 103–104.

B. Examiner Error

In Petitioner’s view, the Decision does not account for the terminal disclaimer filed during the prosecution of the ’036 patent, and this “risks allowing Patent Owner to make an end-run around the Board’s prior findings regarding substantially the same subject matter.” Reh’g Req. 8. Petitioner argues that a “terminal disclaimer is a strong clue that a patent examiner and, by concession, the applicant, thought the claims in the continuation lacked a patentable distinction over the parent.” *Id.* (quoting *SimpleAir, Inc. v. Google LLC*, 884 F.3d 1160, 1168 (Fed. Cir. 2018)).

Petitioner, though, omits the rest of the Federal Circuit’s reasoning about terminal disclaimers: “But as our precedent indicates, that strong clue does *not give rise* to a presumption that a patent subject to a terminal disclaimer is patentably indistinct from its parent patents.” *SimpleAir*, 884 F.3d at 1168 (emphasis added). Thus, we are unpersuaded that the terminal disclaimer alone shows that the claims are patentably indistinct from those challenged in a previous IPR. Even so, the Decision acknowledged Petitioner’s argument about the terminal disclaimer, but the Board did not find it persuasive because the Petition did not adequately address the differences between the claims challenged here and the claims from the previous IPR. Dec. 14–15. For this reason, Petitioner did not show that the Examiner erred under *Becton, Dickinson* factors (e) and (f). *Id.* at 14–17.

Although Petitioner argues that there was no evaluation of OSEK that could be the basis for such a showing in the Request for Rehearing (Reh’g Req. 10), the Petition explained that Examiner’s lack of analysis was the

error (Pet. 103–104). Petitioner’s Request for Rehearing essentially repeats much of this argument. *See* Reh’g Req. 7–11.

In the Decision, the Board disagreed with Petitioner’s analysis of whether the Examiner erred. Dec. 15. In particular, the Decision stated that “the Petition lacks a sufficient explanation of how OSEK teaches the ‘of the automotive electronic control unit’ limitation, which did not appear in the claims from the previous IPRs of related patents.” *Id.* For the same reasons, we are unpersuaded by similar arguments in the Request for Rehearing. *See* Reh’g Req. 7–11.

Petitioner disagrees that the claims are dissimilar and argues that “previous IPRs do expressly require an ‘electronic control unit,’ and as pointed out in the petition, the very same disclosure in the prior art that reads on the ECU likewise reads on the automotive ECU.” *Id.* at 2 (emphasis omitted). In its Rehearing Request, Petitioner argues that the Board focused on claim 1 in the Decision and overlooked “near-identical claims 50 and 51 of the ’843 patent” challenged in previous IPRs. *Id.* at 11. Petitioner points to claim 50’s recitation of “[a]n apparatus, comprising: an electronic control unit for,” and claim 51’s recitation of “[a]n apparatus, comprising: a control unit for.” *Id.*

But, unlike the challenged claim from the ’036 patent, claims 50 and 51 of the ’843 patent do not recite how or where the request is made. In particular, the challenged claim from the ’036 patent recites “instructions to . . . issue a storage resource request in connection with a storage resource *of the automotive electronic control unit.*” Ex. 1001, 12:45–48 (emphasis added).

Those differences are important to the Decision: In the previous IPR, the Board rejected Patent Owner’s argument that the claim imposed a

requirement on “where or how the request and determination are made.” Ex. 1042, 36–37, *discussed in* Dec. 16. “By contrast, claim 1 challenged here requires that the requested resource is the automotive ECU’s, and the instructions are issued from the ECU’s processor.” Dec. 16. In view of these differences, we disagree with Petitioner that the previous decision’s findings about the ’843 patent show that the Examiner erred in issuing the ’036 patent, or that the Board erred in denying institution here. *See* Reh’g Req. 7–12.

As for how those differences relate to Petitioner’s analysis of *Becton, Dickinson* factors (e) and (f), the Decision stated that the Petition did not address how OSEK’s ECU issues a request for its own storage resource. Dec. 16 (citing Pet. 23). The Decision also pointed out that Petitioner did not provide another interpretation that would otherwise address the language “of the automotive electronic control unit.” *Id.* This deficiency was the basis for the Board’s conclusion that Petitioner failed to show that the Examiner erred. *Id.* at 16–17.

In its Rehearing Request, Petitioner disagrees that the Petition was deficient in this way and further argues that the Board “misapprehended or overlooked that *OSEK*’s Fig. 2 explicitly discloses a single ECU with two nodes (center ECU).” Reh’g Req. 13. In Petitioner’s view, the Board overlooked the Petition’s rationale that “*OSEK*’s ECU issues a request for its own storage resource.” *Id.* (emphasis omitted) (citing Pet. 22–25).

Pages 22 through 25 of the Petition, however, do not discuss a single ECU with two nodes. Rather, according to the Petition, *OSEK* teaches that “[e]ach node *in the network* has a ‘data buffer’ (i.e., a ‘storage resource’), and each node ‘is actively monitored by every other node *in the network*’ to determine whether *another node*, and consequently the storage resource, is

available.” Pet. 23 (emphasis added), *discussed in* Dec. 17. That is, the Petition relied on notifications between nodes in a network (*id.*), not between nodes in a single ECU (Reh’g Req. 13). Thus, Petitioner has not shown that the Board overlooked or misapprehended any argument for the recited subject matter based on a single ECU. *See id.* at 12–13.

For similar reasons, we disagree with Petitioner that the Board overlooked an argument concerning the *GetMessageResource* mechanism. Req. Reh’g. 13 (citing Pet. 22–25, 35). The Petition does not address how OSEK’s ECU issues a request for its own storage resource using the *GetMessageResource* or provide another interpretation that would otherwise adequately address the limitation “of the automotive electronic control unit.” *Id.*; *see* Dec. 16. Nor does the Petition sufficiently explain how *GetMessageResource*, which is “for avoiding conflicting access to a particular message object” (Ex. 1012, 28), relates to OSEK’s alleged disclosure of other limitations of claim 1 relating to the storage resource. Thus, Petitioner has not shown that the Board overlooked or misapprehended the Petition’s discussion of OSEK’s *GetMessageResource*.

IV. CONCLUSION

Petitioner has not shown that the Board overlooked or misapprehended any matter.

V. ORDER

It is ORDERED that Petitioner’s Request for Rehearing is *denied*.

IPR2021-00425
Patent 10,002,036 B2

FOR PETITIONER:

James Glass

QUINN EMANUEL URQUHART & SULLIVAN, LLP

jimglass@quinnemanuel.com

Lionel Lavenue

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP

Lionel.lavenue@finnegan.com

FOR PATENT OWNER:

George Gordon

ANDREW GORDON LAW FIRM, PLLC

andrew@agordonlawfirm.com