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Paper 13
Date: July 7, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TACTION TECHNOLOGY, INC.,
Patent Owner.

IPR2022-00057 (Patent 10,659,885 B2)
IPR2022-00058 (Patent 10,820,117 B2)
IPR2022-00059 (Patent 10,659,885 B2)[1]

Before JUSTIN T. ARBES, SCOTT B. HOWARD, and SCOTT RAEVSKY, *Administrative Patent Judges.*

HOWARD, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Requests on Rehearing of Decisions
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

[1] This Order addresses issues that are the same in each of these proceedings. We issue one Order to be entered in each proceeding. The parties are not authorized to use this style caption unless later permitted.

INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 1–19 of U.S. Patent No. 10,659,885 B2 (Ex. 1001, "the '885 patent"). Paper 1 ("Pet.").[2] Taction Technology, Inc. ("Patent Owner") filed a Preliminary Response. Paper 10 ("Prelim. Resp."). We issued a Decision Denying Institution of *Inter Partes* Review. Paper 13 ("Inst. Dec."). Petitioner filed a timely Request for Rehearing Pursuant to 37 C.F.R. § 42.71(d). Paper 14 ("Req. Reh'g"). For the reasons set forth below, Petitioner's Request for Rehearing is *denied*.

ANALYSIS

A. Legal Standard

When rehearing a decision on institution, the Board "review[s] the decision for an abuse of discretion." 37 C.F.R. § 42.71(c) (2021). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if substantial evidence does not support a factual finding, or if an unreasonable judgment is made in weighing relevant factors. *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).

Also, 37 C.F.R. § 42.71(d) sets forth, in relevant part that:

> A party dissatisfied with a decision may file a single 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

[2] For expediency, we cite to papers in IPR2022-00057. Similar papers were filed in IPR2022-00058 and IPR2022-00059. Any differences between the proceedings are immaterial for the issues raised in the Requests for Rehearing.

> 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, a reply, or a sur-reply.

B. Petitioner Improperly Presents a New Argument on Rehearing

In our Institution Decision, we relied on *E.I. DuPont*'s[3] burden shifting presumption to determine that Petitioner did not sufficiently show that the prior art taught a limitation recited in the independent claims. Inst. Dec. 18–23. Specifically, we found that the prior art Petitioner relied on in its obviousness argument taught a range that overlapped with the range claimed in the '885 patent, which created a rebuttable presumption of obviousness. *Id.* at 18 (citing *E.I. DuPont*, 904 F.3d at 1006). However, we determined that Patent Owner presented sufficient evidence of criticality in the '885 patent to overcome that presumption. *Id.* at 19–21 (citing *E.I. DuPont*, 904 F.3d at 1006, 1008; *Genentech, Inc. v. Hospira, Inc.*, 946 F.3d 1333, 1341–42 (Fed. Cir. 2020)). Accordingly, we determined that Petitioner had not shown a reasonable likelihood of prevailing in showing that the challenged claims are unpatentable as obvious over the combination of prior art. *Id.* 21–23.

In its Rehearing Request, Petitioner argues that we erroneously applied *E.I. DuPont*. Req. Reh'g 6–11. Specifically, Petitioner argues that "*DuPont's* burden shifting on evidence relating to the criticality of a claimed range only applies where the prior art encompasses a *broader range* than the narrow range in the claims, *i.e.*, the claims recite a species of the prior art's genus." *Id.* at 3. According to Petitioner, however, it does not apply "in the

[3] *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1006 (Fed. Cir. 2018).

scenario presented in the Petition where the prior art falls *fully within* the claimed range." *Id.*; *see also id.* at 6 ("[I]n the inverse *DuPont* scenario where the prior art falls entirely within the claimed range, *the DuPont framework does not apply*."), 7 ("While *DuPont* permits a patent owner to rebut a presumption that the prior art genus renders obvious a claimed species, there is no such presumption to rebut when the prior art teaches a species of a claimed genus."). Instead of *E.I. DuPont*'s rebuttable presumption, Petitioner argues that "*there is no such presumption* to rebut when the prior art teaches a species of a claimed genus. Instead, the range is deemed anticipated by the prior art's species." *Id.* at 7 (emphasis added).

But that argument was not presented in the Petition. *See* Pet. To the contrary, Petitioner explicitly requested that we apply *E.I. DuPont*'s rebuttable presumption: "Indeed, the Federal Circuit has found that an overlap in ranges creates a presumption of obviousness. *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1006 (Fed. Cir. 2018)." Pet. 44; *see also id.* at 79 ("Indeed, the Federal Circuit has found that an overlap in ranges creates a presumption of obviousness. *E.I. DuPont*, 904 F.3d at 1006."). A request for rehearing is not an opportunity to merely disagree with the Board's assessment of the arguments or to present new arguments. Having argued in the Petition that *E.I. DuPont* applies, Petitioner cannot present the opposite argument on rehearing. Accordingly, we do not consider this new argument on rehearing.

CONCLUSION

For the above reasons, Petitioner has not persuaded us that we misapprehended or overlooked any fact or argument that demonstrates we should modify our Institution Decision. Therefore, we deny Petitioner's

Request for Rehearing of the Decision Denying Institution in each proceeding.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Request for Rehearing of the Decision Denying Institution in each of the instant proceedings is *denied*.

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