

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BERK-TEK LLC
Petitioner

v.

BELDEN TECHNOLOGIES INC.
Patent Owner

Case IPR2013-00057
Patent 6,074,503

Before JAMESON LEE, STEPHEN C. SIU, and JOSIAH C. COCKS,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

DECISION
ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

Introduction

Berk-Tek filed a request for rehearing of the Board's decision ("Decision"), dated April 16, 2013, which instituted *inter partes* review of claims 1-6 of Belden's Patent 6,074,503. Berk-Tek contends:

(1) that the Board should have instituted review on claims 1 and 2 as either anticipated by or obvious over '485;

(2) that the Board should have instituted review on claim 5 as anticipated by '582 and on claim 6 as obvious over '582; and

(3) that the Board should have instituted review on claims 1-6 on all of Berk-Tek's alleged obviousness grounds based in whole or in part on JP '307.

The request for rehearing is *denied*.

Discussion

Per 37 C.F.R. § 42.71(c), when rehearing a decision on petition, a panel will review the decision for an abuse of discretion. In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matter the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

That means the Board could not have misapprehended or overlooked a matter not specifically addressed by the petitioner, and it is not an abuse of discretion not to have considered specific arguments and presentation submitted by the petitioner for the first time in its request for rehearing.

Issue (1)

With respect to Issue (1) identified above, Berk-Tek submits six pages of new analysis, not identifying where such analysis was made in its petition, urging

that guide plate 56 through which both the core and optical fibers pass through separate slots does prevent twisting of the core, notwithstanding rotation of the guide plate 56 and everything passing through it. The new analysis includes extensive computational analysis of the angular velocity of multiple rotating parts.

A request for rehearing is not an opportunity to submit new analysis, after the Decision has noted the deficiencies in the petitioner's original analysis. As the petitioner, Berk-Tek bears the burden of proof that it is entitled to the relief requested in its petition. 37 C.F.R. § 42.20(c). That burden is to be met by the petition itself, not in combination with new analysis in a rehearing request. Furthermore, Berk-Tek's new analysis is not commensurate in scope with claims 1 and 2. Claim 1, on which claim 2 depends, recites simply "prevents twisting motion of the core," not "prevents twisting motion of the core relative to the plurality of transmission media." (Emphasis added.)

Berk-Tek has shown no abuse of discretion with respect to Issue (1).

Issue 2

Issue (2) identified above concerns whether Figure 2 of '582 illustrates twisted pairs forced into contact with surface features of core 30. Berk-Tek's petition contains little, if any discussion, in that regard, and cites only to column 4, lines 15-25, of '582. The cited text indicates only that each of element 23, containing a plurality of twisted pairs 25, is individually "stranded together," and then bound by an identification tape. The Board did not find that each unit 23 is unjacketed, as Berk-Tek contends in the rehearing request. Rather, the petition did not explain what "individually stranded" conveys to one with ordinary skill about each unit 23 and did not contain any discussion on whether units 23 are jacketed.

Even assuming that each unit 23 is not jacketed, it remains true that the petition has not shown that the plurality of twisted pairs 25 bundled within each

unit 23 are forced into contact with surface features of core 30. The petition identified nothing which keeps twisted pairs 25 within each bundle 23 fixed in their relative positions with respect to each other, over time, or keeps the same twisted pair consistently in contact with the core at any one time. It would be difficult to identify, prospectively, any particular twisted pair as being in contact with the core at any particular time. What is on the outer periphery of unit 23 at one moment may not stay on the outer periphery at the next moment. The petition lacks analysis for that aspect of the issue.

Berk-Tek has shown no abuse of discretion with respect to Issue (2).

Issue 3

For each of Berk-Tek's alleged grounds of obviousness directed to claims 1-6, based on JP '307, the Board determined in the Decision that they are redundant in light of the obviousness grounds relying on JP '910 as the primary reference, on the basis of which the Board is instituting review of claims 1-6. In the rehearing request, Berk-Tek states (Rhg. Req. 13:7-12):

As best understood, the Board believes that there is a substantial likelihood that claims 1-6 are obvious over JP '910 (alone or in combination with other references) and the Board equally believes that there is a substantial likelihood that claims 1-6 are obvious over JP '307 (alone or in combination with other references). To simplify the trial, the Board has removed the argument using the JP '307 reference as the primary reference as redundant.

Berk-Tek reads too much into the Board's designating certain grounds as redundant. No opinion was expressed on the merits of those grounds. The meaning of "redundant grounds" is explained in an expanded panel decision titled "ORDER (REDUNDANT GROUNDS)" and dated October 25, 2012, in CBM2012-00003, accessible via PRPS – Patent Review Processing System. The meaning is based solely on the explanations in the petition. If the petitioner makes

no meaningful distinction between certain grounds, the Board may exercise discretion by acting on one or more grounds and regard the others as redundant.

While Berk-Tek cannot possibly anticipate all arguments patent owner Belden may present in its response, that argument misdirects the proper focus. It is not unreasonable for Berk-Tek, who desires to allege multiple grounds of unpatentability, to articulate what Berk-Tek “itself” sees as meaningful distinctions between the grounds. Under the statutory scheme Congress has provided for conducting *inter partes* review under the Leahy-Smith America Invents Act, Pub. L. 112-29, ch. 31, 125 Stat. 299 (2011), allowing multiple grounds without meaningful distinction by the petitioner is contrary to the legislative intent.

For instance, 35 U.S.C. § 316(b) provides that in prescribing regulations under that section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter. A final decision in an *inter partes* review is required to be issued not later than 1 year after the date on which the Director notices the institution of a review, except that the 1-year period may be extended, for good cause, by no more than six months. *See* 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c). In that context, 37 C.F.R. § 42.108(b) provides: “At any time prior to institution of *inter partes* review, the Board may deny some or all grounds for unpatentability for some or all of the challenged claims.” Note also that Part 42, Title 37, Code of Federal Regulations, are construed to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b).

Berk-Tek has shown no abuse of discretion with respect to Issue 3.

Conclusion

Berk-Tek’s request for rehearing is *denied*.

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Patent 6,074,503

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