Trials@uspto.gov
571.272.7822

Paper No. 18
Entered: August 26, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SCENTAIR TECHNOLOGIES, INC.
Petitioner

v.

PROLITEC, INC.
Patent Owner

Case IPR2013-00180
Patent 7,930,068

Before JAMESON LEE, MICHAEL J. FITZPATRICK, and CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges.*

FITZPATRICK, *Administrative Patent Judge.*

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

BACKGROUND

Petitioner, ScentAir Technologies, Inc., requests rehearing (Paper 16, "Req. Reh'g") of our Decision instituting *inter partes* review of claims 1, 3-5, 9-13, 15, 22-24, 26, 28, and 33 of Patent No. 7,930,068 (Paper 13, "Dec.").

In the Decision, the Board ordered a trial on the following two grounds of unpatentability asserted in the Petition (Paper 1):

> Claims 1, 3-5, 9-13, 15, 22-24, 26, 28, and 33 as obvious over Le Pesant; and
>
> Claims 1, 3-5, 9-13, 15, 22-24, 26, 28, and 33 as obvious over Le Pesant and Privas.

The Board denied all other grounds in the Petition as redundant in light of the grounds on which the Board instituted review. Dec. 17. ScentAir requests rehearing of the denial of a trial based on those other grounds. Req. Reh'g 1. "Specifically, ScentAir requests that the Board instead authorize, at least conditionally, the grounds the Board found 'redundant.'" *Id*.

For the reasons stated below, the request is denied.

ANALYSIS

When rehearing a decision on petition, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing an abuse of discretion. 37 C.F.R. § 42.71(d).

ScentAir does not identify, let alone demonstrate, any purported abuse of discretion. Instead, ScentAir merely states that "it believes the Board

may have overlooked *potential* prejudice to ScentAir." Req. Reh'g 2 (emphasis added). In particular, ScentAir states:

> ScentAir will be effectively foreclosed from relying on the references deemed redundant in an *inter partes* review proceeding with respect to distinctions advanced by Prolitec — for example, through amendments or substitute claims — despite the existence of those distinctions in references deemed redundant, and thus, not applied.

Req. Reh'g 2.

ScentAir, however, is not foreclosed from relying on references it relied on in the non-instituted grounds to account for new claim limitations that Prolitec may seek to add. Although the Board denied certain grounds as redundant in the decision instituting *inter partes* review, the Board did not state that the references involved in those grounds may not be relied upon to address distinctions advanced by Prolitec in a motion to amend or substitute claims.[1]

That ScentAir ultimately may not prevail in challenging the patentability of claims 1, 3-5, 9-13, 15, 22-24, 26, 28, and 33 on at least one of the grounds instituted does not mean it was an abuse of discretion not to have instituted trial on additional grounds.

To avoid a determination that a requested ground of review is redundant of another requested ground, a petitioner must articulate a meaningful distinction in terms of relative strengths and weaknesses with respect to application of the prior art reference disclosures to one or more

[1] Guidance on motions to amend is provided in the *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012) and recent Board decisions, including *Idle Free Sys., Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, Paper 26 (June 11, 2013) (expanded panel).

claim limitations. *See, e.g.*, *Liberty Mutual Ins. Co. v. Progressive Casualty Inc. Co.*, CBM2012-00003, Paper 7 at 2-12. Distinctions based on how Prolitec may amend the claims are speculative and should not be the basis of our decision to institute.

Pursuant to 35 U.S.C. § 316(b), rules for *inter partes* review were promulgated taking into account their effect 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." The Board's rules provide that they are to be "construed to secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). As a result, in determining whether to institute an *inter partes* review of a patent, the Board may "deny some or all grounds for unpatentability for some or all of the challenged claims." 37 C.F.R. § 42.108(b).

ScentAir has not demonstrated an abuse of discretion in instituting an *inter partes* review of claims 1, 3-5, 9-13, 15, 22-24, 26, 28, and 33 on two, but not all, of the grounds for review sought by the Petition.

ORDER

In consideration of the foregoing, it is hereby:

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

For PETITIONER:

Walter Renner
Kevin Greene
Fish & Richardson, P.C.
axf@fr.com
apsi@fr.com

For PATENT OWNER:

Jennifer L. Gregor
James D. Peterson
Nicholas A. Kees
GODFREY & KAHN, S.C.
jgregor@gklaw.com
jpeterson@gklaw.com
nkees@gklaw.com