
**United States Court of Appeals
for the Federal Circuit**

POLYGROUP LIMITED MCO,

Appellant,

– v. –

WILLIS ELECTRIC COMPANY, LTD.,

Appellee.

*Appeals from the United States Patent and Trademark Office, Patent
Trial and Appeal Board in Nos. IPR2016-00800, IPR2016-01609,
IPR2016-01610, IPR2016-00801, IPR2016-01611, IPR2016-01612*

**APPELLANT’S RESPONSE IN OPPOSITION TO
APPELLEE’S COMBINED PETITION FOR PANEL
REHEARING OR REHEARING *EN BANC***

DOUGLAS D. SALYERS
PUJA P. LEA
TROUTMAN PEPPER HAMILTON
SANDERS LLP
600 Peachtree Street, Suite 3000
Atlanta, GA 30308
(404) 885-3000
doug.salyers@troutman.com
puja.lea@troutman.com

ROBERT A. ANGLE
CHRISTOPHER J. FORSTNER
TROUTMAN PEPPER HAMILTON
SANDERS LLP
1001 Haxall Point Road
Richmond, VA 23219
(804) 697-1874
robert.angle@troutman.com
chris.forstner@troutman.com

Counsel for Appellant

CERTIFICATE OF INTEREST

Pursuant to Fed. Cir. R. 47.4, counsel for Appellant Polygroup Limited

MCO certifies the following:

1. The full name of the party represented by me is:

Polygroup Limited MCO

2. The name of the Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:

Polygroup Macau Ltd.

Polygroup Ltd. (MCO)

Polygroup Servs. N.A. Inc.

ProServices LLC

Polygroup China Limited

PG Mexico RE I Ltd.

PG Mexico RE II Ltd.

PG Mexico RE III Ltd.

PG Mexico RE IV Ltd.

Polygroup Propiedades de Mexico S. de R.L. de C.V.

Polygroup Distribuidora de Latino America S de R.L. de C.V.

Polygroup Mexico Ltd.

Polygroup Indus. Mexico Sade CV

Polygroup Juarez Ltd.

Polygroup Greater China Ltd.

Polyfilm Co. Ltd.

Dougguan Polyfilm Plastic Prods. Co. Ltd.

Nixan Int'l Ltd.

Nixan (Heyuan) Co. Ltd.

Polypaper Ltd.

Polypaper (Heyuan) Co. Ltd.

Crownwell Corp. Ltd.

Crownwell (Heyuan) Co. Ltd.

Glenealy Enter. Ltd.

Glenealy Plastic Prods. Co. Ltd.

Murray Corp. Ltd.
Murray Plastic Crafts (Longnan) Co. Ltd.
Polytree (HK) Co. Ltd.
Dongguan Polytree Plastic Prods. Co. Ltd.
Morrison Corp. Ltd.
PG Indus. (Guangxi) Ltd.
PG Plastics Prods. (Guangxi) Co. Ltd.
Great Century Corp. Ltd.,
Polygroup Trading (Shenzhen) Co. Ltd.
Cindex Holdings Ltd.
Keymax Corp. Ltd.
Poly Growth Ltd.
Stardawn Holdings Ltd.
Cosmic Walker Ltd.
Soho Spring Ltd.
Polygroup Mgmt. Servs. Ltd.
Polygroup Asia Pac. Ltd. (trading as Polygroup Ltd.)
Polygroup Latam Sales I Ltd.
Polygroup Latam Sales I Ltd. (formerly Carnoustie Holdings Ltd.)
Polygroup Latam Sales II Ltd. (formerly Turnberry Holdings Ltd.)
Polygroup Latam Sales II Ltd.
Polygroup Trading Ltd.

3. Parent corporations and publicly held companies that own 10% or more of the stock in the party:

None.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this Court (and who have not or will not enter an appearance in this case) are:

Troutman Pepper Hamilton Sanders LLP (formerly Troutman Sanders LLP): Ryan A. Schneider, Dabney Carr, Laura Anne Kuykendall, Lindsay Mitchell Henner, Alexis N. Simpson (formerly of Troutman Sanders LLP), Anup M. Shah (formerly of Troutman Sanders LLP), Lauren R. Ulrich (formerly of Troutman Sanders LLP), Paul E. McGowan (formerly of

Troutman Sanders LLP), Benjamin C. Wiles (formerly of
Troutman Sanders LLP)
Merchant & Gould P.C.: Paige Stradley, Tom Leach, Rachel C.
Hughey, Rachel Zimmerman Scobie
Polygroup Limited MCO: Eric Szweda
Sterne, Kessler, Goldstein & Fox PLLC: Jason D. Eisenberg

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal:

- *Willis Electric Co. Ltd. v. Polygroup Ltd. (MCO) et al.*, No. 15cv3443 (D. Minn.)

6. Organizational Victims and Bankruptcy Cases: None/Not applicable

Dated: March 18, 2022

/s/ Douglas D. Salyers

Douglas D. Salyers

*Attorney for Appellant Polygroup Limited
MCO*

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ARGUMENT

I. Introduction and Statement of Case

Willis has sought Panel Rehearing based on four arguments. While Polygroup agrees that the mandate should be changed to remove claim 17 of the '186 patent, which Polygroup did not appeal, none of the other three arguments reflect a “point[] of law or fact overlooked or misapprehended by the court.” Fed. Cir. R. 40(a)(5); Fed. R. App. P. 40(a)(2).

First, Willis contends the Majority “misunderstood the specification in broadening the plain claim language.” This argument grossly misrepresents the Majority decision as it did not misunderstand the numerous descriptions in the specification of multistep assembly for the generic tree parts in the claimed “modular lighted artificial tree” nor did it use the specification to broaden the claim language. The Majority properly read the plain claim language, in light of the specification, to not require “single step” assembly. Willis’s renewed argument relying on disclosed, but unclaimed features, like “fixed connectors,” and “coaxial” contact sets, was neither overlooked nor misapprehended, as it was rejected as a blatant attempt to improperly narrow the claim based on the specification disclosures not included in the claims.

Second, Willis contends the Majority should have remanded the case because Willis had raised arguments about how Miller “fundamentally differs from the

claims” and there was “objective evidence of nonobviousness.” This Court’s first decision (*Polygroup Ltd. MCO v. Willis Elec. Co.*, 759 F. App’x 934 (Fed. Cir. 2019)) (“*Polygroup I*”) and the Board’s remand decision both rejected Willis’s argument that Miller allegedly lacked “joined branches” and “affixed light strings.” Similarly, the Board’s remand decision for claims 1, 3, 4, 6, 8, and 9 in the ’186 patent found Miller alone rendered those claims unpatentable, which “effectively amount[s] to an anticipation challenge labeled as obviousness” such that the Willis objective evidence “did not outweigh Petitioner’s case obviousness for claims 1, 3, 4, 6, 8, and 9.” Willis did not appeal that holding, and for the appealed claims its brief never explained why a different weight would apply for the identical Miller alone “anticipation challenge labeled as obviousness.” Polygroup Reply Brief (“Polygroup Reply”), Doc. No. 22, at 22-23.

Third, Willis contends both the Board’s remand decision and the Majority “overlooked the previous mandate” for all but 6 of the appealed claims. This argument grossly misrepresents what the Board and the Majority did, as both relied solely on Miller alone. Moreover, this new argument is procedurally improper as Willis never contended before that the Board’s remand decision relied on secondary references – because it did not.¹ Willis has offered no explanation for its frivolous

¹ Except for claim 7 of the ’186 patent, which the Majority has remanded for a Miller alone assessment.

mandate contention. *See* Fed. Cir. R. 35(a)(2) (“A petition for rehearing or rehearing *en banc* that does not meet the standards of Federal Rule of Appellate Procedure 35(a) may be deemed frivolous and sanctions may be imposed.”).

Finally, Willis correctly notes that Polygroup did not appeal claim 17 of the ’186 patent. Polygroup agrees that the mandate should be corrected to remove that claim.

Willis has also petitioned for Rehearing *En Banc* contending “the Majority’s decision is contrary to precedent.” The Majority decision is nonprecedential, making it “rarely appropriate” for *en banc* consideration (Practice Notes to Fed. R. App. P. 35 (“A petition for rehearing *en banc* is rarely appropriate if the appeal was the subject of a nonprecedential opinion by the panel of judges that heard it”)). Moreover, the Majority decision is not contrary to any of the precedential decisions Willis cites.

II. Panel Rehearing is Unwarranted as the Majority Did Not Overlook Key Facts and Law.

A. The majority did not misunderstand the specification to broaden the plain claim language.

Willis argues that the Majority “misunderstood the specification in broadening the plain claim language,” which misrepresents what the Majority said about the specification and how the Majority construed the claim language.

The Majority held: “While the term ‘coupling’ is broad enough to mean mechanically connecting or electrically connecting or both, neither the claim language nor the specification requires such ‘coupling’ occur in a single step.” Willis Petition Addendum (“Addm”), Addm9. To support its construction for the “coupling” term the Majority noted “the specification discloses embodiments in which a series of mechanical connections are made when assembling the lighted artificial tree/trunk portions.” Addm9. The embodiments cited by the Majority confirmed both that the specification disclosed numerous assembly steps in which multiple mechanical connections were made between multiple tree portions at different times and that “electrical connections can precede mechanical connections,” all of which supported the Majority’s reading of the “coupling” term as not limited to a “single step” assembly process. Addm9-10. The Majority’s reading of the specification did not “conflate” the “manufacturing assembly steps” with “consumer assembly,” two concepts it never used, but its reading of the specification simply confirmed that the “coupling” claim term had not been limited by the specification to only “single step” assembly.

The Majority determined that the “broadest reasonable interpretation” of the appealed claims does not “require that the mechanical connection between the tree/trunk portions results in the electrical connection,” which specifically rejected the Board’s “single step” construction for the “wherein” clauses, and Willis’s

support of that construction in this appeal. Addm7, Addm9. *See* Oral Argument (Oct. 5, 2021), available: https://oralarguments.cafc.uscourts.gov/default.aspx?fl=21-1401_10052021.mp3, at 30:19-31:40 (during oral argument, Willis points to these particular “wherein” phrases as supporting its argument for a single step connection). As noted during oral argument, Willis could have drafted “single step” claims but did not, instead opting for language that seems “intentionally ambiguous,” as opposed to simply claiming a “simultaneous” connection. *See* Oral Argument at 32:15-33:22.

Instead of pointing to “law or fact overlooked or misapprehended by the court” (Fed. Cir. R. 40(a)(5)), the Willis Rehearing Petition relies on specification disclosures about connectors “secured/fixed at the ends of the trunk portions” and “coaxial” contact set. Willis Petition for Panel Rehearing or Rehearing En Banc (“Willis Petition”), Doc. No. 46, at 8 n. 3. Willis uses this specification language to once again try to improperly *narrow* the claims to require fixed or secured electrical connectors. Willis Response Brief (“Willis Response”), Doc. No. 20, at 35. As Polygroup already pointed out, in the claims at issue, the connectors are only claimed as “housed within” or “located within” the trunks. Polygroup Reply, Doc. No. 22, at 20.

The Majority did not use the specification to “broaden” its interpretation of the “coupling” term, but instead confirmed the “plain meaning” was consistent with

the specification and thus properly rejected Willis’s attempt to “narrow” the claim language to a single step. *See TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016) (“Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history.”).

B. Remand is not warranted as the Board has already rejected each of the alternative grounds for affirmance, which Willis did not appeal.

Willis rehearing petition suggests that a remand is required as there are alternative grounds for affirmance “about what Miller fails to teach” and about “secondary considerations of nonobviousness” – each of which have already been rejected by the Board for the unpatentable claims which Willis did not appeal.² The Board’s remand decision previously rejected Willis’s argument that Miller allegedly lacked “joined” branches and “affixed” light strings in the context of unpatentable claim 1 of the ’186 patent. Polygroup Reply, Doc. No. 22, at 21 (citing Appx12-13). Willis did not appeal the unpatentability of claim 1 and has not addressed why the Board’s analysis would not apply to the appealed claims. Similarly, the Board’s remand decision regarding claim 1 of the ’186 patent found that “Patent Owner

² Willis argues that it had no “right of cross-appeal from a decision in its favor” but offers no justification for why it did not appeal the Board’s decision against it finding claim 1 of the ’186 patent unpatentable.

acknowledges that Miller provides a rotationally independent electrical connection”. Polygroup Reply, Doc. No. 22, at 22 (citing Appx14).

The Majority also did not erroneously fail to consider secondary considerations. The Board’s remand decision for claims 1, 3, 4, 6, 8, and 9 in the ’186 patent found Miller alone rendered those claims unpatentable, which “effectively amount[s] to an anticipation challenge labeled as obviousness.” Appx21. Although Willis misleadingly quotes the Board’s *original* finding as to secondary considerations, Willis ignores the Board’s explicit *remand* finding that Willis’s objective evidence “does not outweigh Petitioner’s case of obviousness for claims 1, 3, 4, 6, 8, and 9” of the ’186 patent, which were not appealed. Appx21. On remand, the Board explicitly differentiated its original findings in noting that “the analysis weighing secondary considerations evidence relative to the challenge in the Original Decision” was based on “requiring a combination of teachings.” Appx21. The appealed claims are based on the identical Miller alone “anticipation challenge labeled as obviousness,” which the Board found to present “a much stronger case of obviousness.” Polygroup Reply, Doc. No. 22, at 22-23. *See Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008) (“[S]econdary considerations are not an element of a claim of anticipation.”).

Willis has never explained why the Majority would analyze the claims on appeal differently than the Board’s analysis for claims 1, 3, 4, 6, 8, and 9 of the ’186

patent. The Majority’s “new construction” according to Willis, simply construed the relevant language of the independent claims on appeal to be in line with the comparable language of claim 1 of the ’186 patent, as construed by the Board. *Compare* the Board’s analysis of claim 1 of the ’186 patent, Appx14 (“...the claim permits that mechanical connection to be independent of the electrical connection.”), with the Majority’s determination regarding claims 10 and 28 of the ’186 patent and claims 1 and 7 of the ’187 patent, Addm10 (“Thus, under the broadest reasonable interpretation, we construe claim 10 of the ’186 patent to permit the mechanical and electrical connections to be made independently.”).

Willis argues that the Majority erred in finding Claim 20 unpatentable, alleging that the Majority erred by “implicitly determin[ing] on its own that Miller teaches the electrical connection *following after* this aligning step.” Willis Petition, Doc. No. 46, at 14 (emphasis added). The Majority did no such thing and appropriately concluded that Claim 20 “does not require a mechanical connection to result in an electrical connection.” Addm10. As explained by the Majority, “[t]he ‘aligning’ step forms the first mechanical connection, while the ‘receiving’ step forms both the second mechanical connection between the trunk portions and the electrical connection between the trunk wiring assemblies.” Addm10-11. Willis introduces an error, not the Majority, by interpreting the Majority’s language to require the electrical connection (of the receiving step) “following after” the aligning

step. The Majority simply noted that claim 20 requires two separate mechanical connections, but did not comment on the order in which the “aligning” and “receiving” steps occur. Polygroup Reply, Doc. No. 22, at 13-14.

C. The previous mandate did not preclude review of some claims on appeal.

Willis contends both the Board and the Majority “overlooked [] the previous mandate” for “claims 17, 18, 19, 22, 26, and 28 of the ’186 patent and claims 1-15 of the ’187 patent.”³ However, both the Board and the Majority relied solely on Miller alone. Specifically, after concluding that Polygroup’s challenges to the independent claims (claims 10, 20, and 28 of the ’186 patent and claims 1 and 7 of the ’187 patent) “based on Miller alone fail” (Appx23-25), the Board concluded that “[t]he deficiency in the challenge” to the independent claims “results in the failure of Petitioner’s challenges to [the] dependent claims as well.” Appx24-25.

Willis never contended before that the Board’s remand decision relied on secondary references. It does not. The Board based its decision regarding the dependent claims on Miller alone (except for claim 7 of the ’186 patent) as acknowledged by Willis. Willis Response, Doc. No. 20, at 20 (“The Board determined that the independent claims at issue here and all the claims that depend from them—*i.e.*, claims 10, 11, 16-22, 25, 26, and 28 of the ’186 patent and claims

³ Willis includes the full range of claims of the ’187 patent, however, claims 4, 10, and 13 of the ’187 patent are not at issue in this appeal.

1-3, 5-9, 11, 12, 14 and 15 of the '187 patent—are thus not obvious over Miller alone.”). This is confirmed by the Majority’s remand of only claim 7, which the Majority determined exceeded the scope of the mandate. Addm7-8. Contrary to Willis’s assertion that claim 7 should not be remanded, the Majority had to remand claim 7 for the Board to render a substantive decision on Miller alone, which (according to Willis and the Majority) it had already done for the other appealed dependent claims. In contrast, for all the other appealed claims, the mandate was not exceeded, as the Board made a substantive decision based on Miller alone, giving this Court jurisdiction to review that substantive decision.

Willis did not make any separate arguments regarding the appealed dependent claims in its briefing and confirmed as much during oral argument. When asked whether the dependent claims were not at issue “or those rise and fall with the independent claims?” counsel for Willis stated that “except for dependent claim 7 of the '186 patent, the dependent claims that are on appeal rise and fall, we would submit, with the independent claims.” Oral Argument at 25:08-30; Addm11. *See SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1319 (Fed. Cir. 2006) (holding that an issue was “waived for failure to brief it on appeal”).

Willis has offered no explanation for its contention that the Majority “violates the law of the case” when the “mandate in *Polygroup I* remanded to the Board the question of whether, under a proper construction, the challenged claims are

unpatentable in view of Miller alone” (Addm8), the Board’s remand decision was based solely on Miller alone (except for remanded claim 7), and the Majority’s decision was based on Miller alone.

D. The Panel Decision should remove claim 17 of the ’186 patent from its mandate as Polygroup did not appeal that claim.

Willis is correct that Polygroup did not appeal claim 17 of the ’186 patent because Miller did not have the “interference fit” required by that claim. Polygroup agrees that the mandate should remove claim 17.

III. Rehearing *En Banc* is Unwarranted as This Nonprecedential Decision Is Not Contrary to Precedent

This is neither a precedent-setting nor a precedent-violating decision. Willis does not explain how the Court’s nonprecedential opinion is contrary to any Federal Circuit case. “An en banc hearing or rehearing is *not favored and ordinarily will not be ordered...*” Fed. R. App. P. 35(a) (emphasis added). “A petition for rehearing en banc is *rarely appropriate* if the appeal was the subject of a nonprecedential opinion by the panel of judges that heard it.” Practice Notes to Fed. Cir. R. 35 (emphasis added). The Federal Circuit’s Internal Operating Procedures (“IOP”) state that “[a]mong the reasons for en banc action are: (a) Necessity of securing or maintaining uniformity of decisions; (b) Involvement of a question of exceptional importance; (c) Necessity of overruling a prior holding of this or a predecessor court expressed in an opinion having precedential status; or (d) The initiation, continuation, or

resolution of a conflict with another circuit.” Fed. Cir. IOP #13(2); Fed. R. App. P. 35(b). Willis does not meet any of these standards.

The Majority’s decision is not precedent-violating, as Willis’s series of “cf.” cites are to precedential decisions to which the Majority decision is not contrary. It is the fact patterns of those cases that are different from the Majority’s decision here, not the legal standards applied.

***D’Agostino v. MasterCard Int’l, Inc.*, 844 F.3d 945, 949 (Fed. Cir. 2016):** Willis cites *D’Agostino* for the proposition that the Majority “impermissibly relied on the specification to broaden the plain claim language.” Willis Petition, Doc. No. 46, at 18. As explained above, the Majority does no such thing. The Majority properly interpreted the claim language under the broadest reasonable interpretation standard. *See Owens Corning v. Fast Felt Corp.*, 873 F.3d 896, 901 (Fed. Cir. 2017) (“In an *inter partes* review proceeding, the Board is to give a claim ‘its broadest reasonable construction in light of the specification of the patent in which it appears.’”).

***Fed. Power Comm’n v. Idaho Power Co.*, 344 U.S. 17, 20 (1952), and *Gonzales v. Thomas*, 547 U.S. 183, 187 (2006):** Willis claims in its Rule 35(b)(2) certification that the Majority’s decision is contrary to these two cases, with minimal elaboration on exactly how. The “ordinary remand rule” that Willis unclearly attempts to invoke with the *Gonzales* case states that “a court of appeals should

remand a case to an agency for decision of a matter that statutes place primarily in agency hands.” *INS v. Ventura*, 537 U.S. 12, 16 (2002) (like *Gonzales*, applying remand rule in immigration context to remand proceedings where the appellate court, not the agency, addressed an issue in the “first instance”).

The Majority’s decision to reverse, rather than remand, the appealed claims (other than claim 7) is well-supported by Federal Circuit precedent and not contrary to the cases cited by Willis as the Board has already made findings that can be considered by this Court. *See Owens Corning v. Fast Felt Corp.*, 873 F.3d 896, 901-02 (Fed. Cir. 2017) (“In these circumstances, where only one answer is supported by substantial evidence and there is neither a request nor an apparent reason to grant a second record-making opportunity, reversal is warranted.”). As discussed above, Willis’s arguments for alternative affirmance were already rejected by the Board and this Court.

***Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1339 (Fed. Cir. 2016):** Willis cites *Nike* in arguing that the Majority “decided that the claims on appeal were obvious without considering evidence of secondary considerations, or having any fact-finder do so in considering obviousness of claims as newly construed over Miller.” Willis Petition, Doc. No. 46, at 19. In *Nike*, the Federal Circuit remanded the Board’s decision as there was no evidence that the Board weighed and rejected evidence of secondary considerations. *Nike*, 812 F.3d at 1340. Here, as explained above, the

Board considered secondary considerations on remand with regard to its analysis of claims 1, 3, 4, 6, 8, and 9 (Appx21), finding that such evidence did not outweigh the case for obviousness as reliance on Miller alone “presents a much stronger case of obviousness” “effectively amount[ing] to an anticipation challenge labeled as obviousness.” Appx21 n. 16. The Majority rejected the Board’s erroneous constructions of the appealed claims, instead aligning them with claim 1 of the ’186 patent. Addm9-10. Willis did not appeal the Board’s analysis regarding claim 1, did not offer any explanation for why the Board would have made a different decision for the claims on appeal, and did not explain why the Majority would have disturbed the Board’s findings regarding secondary considerations. Polygroup Reply, Doc. No. 22, at 22-23.

***Engel Indus. v. Lockformer Co.*, 166 F.3d 1379, 1383 (Fed. Cir. 1999)**: This case is cited by Willis for its unexplained assertion that the Majority “ignored the law of the case in violation of its own interpretation of the court’s prior mandate.” Willis Petition, Doc. No. 46, at 19. The Majority cited *Engel* in support of its determination that the Board’s consideration of Lessner was outside the scope of this Court’s mandate in *Polygroup I*. While both piggybacking on, and at the same time rejecting, the Majority’s determination regarding claim 7, Willis argues for the first time that the Board’s remand decision was based on consideration of references other than Miller. As explained above, this is in direct contradiction to Willis’s

previous admissions in both its briefing to this Court and at oral argument, and should be rejected. *Cf.* Willis Response, Doc. No. 20, at 19; Oral Argument at 25:08-30. *See* Fed. Cir. R. 35(a)(2) (“A petition for rehearing or rehearing *en banc* that does not meet the standards of Federal Rule of Appellate Procedure 35(a) may be deemed frivolous and sanctions may be imposed.”).

Dated: March 18, 2022

/s/ Douglas D. Salyers

Douglas D. Salyers

Puja P. Lea

TROUTMAN PEPPER HAMILTON

SANDERS LLP

600 Peachtree Street NE, Suite 3000

Atlanta, GA 30308

Telephone: 404.885.3000

doug.salyers@troutman.com

puja.lea@troutman.com

Robert A. Angle

Christopher J. Forstner

TROUTMAN PEPPER HAMILTON

SANDERS LLP

Troutman Pepper Building

1001 Haxall Point

P.O. Box 1122 (23218-1122)

Richmond, Virginia 23219

Telephone: 804.697.1200

robert.angle@troutman.com

chris.forstner@troutman.com

*Attorneys for Appellant Polygroup
Limited MCO*

**CERTIFICATE OF COMPLIANCE
WITH TYPE-VOLUME LIMITATIONS**

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because the filing has been prepared using a proportionally-spaced typeface and includes 3,370 words.

March 18, 2022

/s/ Douglas D. Salyers

Douglas D. Salyers

TROUTMAN PEPPER HAMILTON

SANDERS LLP

Attorneys for Appellant Polygroup Limited

MCO