

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHUMS, INC., and CROAKIES, INC.,
Petitioner,

v.

CABLZ, INC.,
Patent Owner.

Case IPR2014-01240
Patent 8,366,268 B2

Before JOSIAH C. COCKS, JEREMY M. PLENZLER, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. *Background*

Chums, Inc. and Croakies, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–17 of U.S. Patent No. 8,366,268 B2 (Ex. 1001, “the ’268 patent”) pursuant to 35 U.S.C. §§ 311–319. Cablz, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Based on these submissions, we instituted trial as to claims 1–17 of the ’268 patent. Paper 10 (“Dec.”).

After institution, Patent Owner filed a Response (Paper 20, “PO Resp.”)¹ and Petitioner filed a Reply (Paper 26, “Reply”).² In addition, the parties rely upon fact and expert testimony. Petitioner proffered the Declaration of Steven C. Visser (Ex. 1007, “Visser Declaration”) with the Petition. Patent Owner proffered the Declaration of Fred P. Smith (Ex. 2079, “Smith Declaration”) with its Response. Patent Owner relies also on a declaration of Beirne Chisolm (Exhibit 2080, “Chisolm Declaration”). An oral hearing for this case was held on September 2, 2015. A transcript of the argument is entered in the record. Paper 42 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). We conclude for the reasons that follow that Petitioner has shown by a preponderance of the evidence that claims 1–17 of the ’268 patent are unpatentable.

B. *Related Matters*

The parties indicate that the ’268 patent is the subject of the following district court proceedings: *Cablz, Inc. v. Chums, Inc.*, 2:14-cv-

¹ We refer to Patent Owner’s Unredacted Response (Exhibit 2078).

² We refer to Petitioner’s Unredacted Reply (Exhibit 1038).

00091-SLB (N.D. Ala.) and *Cablz, Inc. v. Croakies, Inc.*, 2:14-cv-00126-SGC (N.D. Ala.). Pet. 1; Paper 5, 1.

C. The '268 Patent (Ex. 1001)

The '268 patent, titled “Eye Wear Retention Device,” issued on February 5, 2013. The '268 patent describes an eyewear retention device having two temple retainers connected by a resilient member, such that when the temple retainers are attached to a pair of eyeglasses and the eyeglasses are worn over the ears of a wearer, the resilient member extends rearward from the head of the wearer and is suspended off the neck of the wearer. Ex. 1001, Abstract. An embodiment of the device is depicted in Figure 4 as follows:

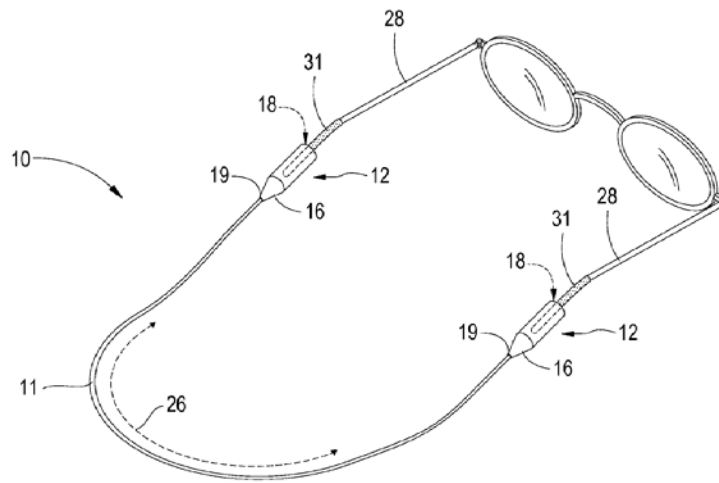


FIG. 4

Figure 4 shows a perspective view of the device placed upon the end portions of the temples of a typical pair of eyeglasses. *Id.* at 2:35–36. As described in the specification, “the resiliency of the cabling 11 in combination with the secure structure of retention tubing 12, with its inherent resiliency, creates an internal resilience within cabling 11 such that

the cable maintains an elevated arc position above a wearer's rear neck and lower head area.” *Id.* at 3:66–4:3.

D. Illustrative Claim

Claim 1 of the '268 patent is reproduced below:

1. An eyewear retention device comprising two temple retainers connected by a resilient cable, such that when the temple retainers are attached to a pair of eyeglasses and the eyeglasses are worn over the ears of a wearer, the cable extends rearward from the head of the wearer and is suspended off the neck of the wearer.

Ex. 1001, 4:36–41.

E. The Prior Art

Petitioner relies on the following prior art:

1. Bill Monroe, *Outdoor folks don't use trendy glasses-holders*, The Oregonian, E4 (July 4, 1991) (“Monroe”) (Ex. 1002);
2. U.S. Patent No. 6,941,619 B2, issued September 13, 2005 (“Mackay”) (Ex. 1003);
3. U.S. Publication No. 2007/0046889 A1, published March 1, 2007 (“Miller”) (Ex. 1004); and
4. U.S. Patent No. 6,764,177 B1, issued July 20, 2004 (“Chisolm”) (Ex. 1005).

F. Instituted Grounds

References	Basis	Claims Instituted
Monroe and Mackay	§ 103	1, 3–9, and 11–17
Monroe, Mackay, and Miller	§ 103	1–17
Chisolm and Monroe	§ 103	1, 3–9, and 11–17
Chisolm, Monroe, and Miller	§ 103	1–17

II. ANALYSIS

A. Claim Construction

The Board interprets claims in an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1277–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 84 U.S.L.W. 3218 (U.S. Jan. 15, 2016) (No. 15-446) (“We conclude that Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA.”). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning in view of the specification, as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Claim terms generally are given their ordinary and customary meaning, unless it appears from the specification or the file history that they were used differently by the inventor, in a clear, deliberate, and precise manner. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). There is a presumption that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

In instituting trial, we expressly construed three claim terms: “resilient,” “cable,” and “temple retainer.” Dec. 5–7. Patent Owner, in its Response, proposes alternate constructions for these three terms. PO Resp. 3–5. Petitioner agrees with the Board’s claim interpretations set forth in the Institution Decision. Reply 1.

1. “*resilient*”

We construed the “resilient” portion of the term “resilient cable” to mean “having sufficient stiffness to maintain its shape and to return to its original form after being bent.” Dec. 6. Patent Owner states that the existing construction “improperly requires a resilient cable or member to *always* return to its original shape after *any* bending.” PO Resp. 3. Patent Owner proposes that we construe “resilient” to mean “having sufficient stiffness to maintain its shape and not easily exhibiting deflection memory, as one would find in a solid copper or aluminum wire of equal diameter.” *Id.* at 4. Petitioner disagrees, arguing the specification “does not limit the scope of the term ‘resilient’ to a comparison involving ‘a solid copper or aluminum wire of equal diameter.’” Reply 1. Petitioner also criticizes Patent Owner’s comparison to solid copper or aluminum wire of equal diameter, stating that it would be nonsensical in view of the specification’s uses of the term “resilient” in connection with other materials. *Id.* Patent Owner does not define “deflection memory” apart from describing it in the specification as a property of a particular type of wire. We decline to import specific examples from the specification into our interpretation of the claim terms. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). Accordingly, we maintain our construction of the term “resilient” as “having sufficient stiffness to maintain its shape and to return to its original form after being bent.”

2. “*cable*”

We construed the “cable” portion of the term “resilient cable” “in accordance with its ordinary and customary meaning consistent with the [s]pecification, as the term would be understood by one skilled in the art.”

Dec. 6. Patent Owner proposes that we construe “cable” to mean “a length of stranded line.” PO Resp. 4. In support of that proposed construction, Patent Owner contends that “a cable of all sizes is commonly understood by a person of ordinary skill to be this kind of wound structure – whether used on cranes, on weight machines, or in jewelry.” *Id.* at 4–5. Petitioner argues that cable should be interpreted broadly enough to include, *inter alia*, plastic monofilament line. Reply 3. Petitioner notes that Patent Owner’s reliance on extrinsic evidence to support its proposed interpretation “fails to discuss the manner in which this term is actually used in the very field of endeavor at hand.” *Id.* at 2. We do not find Patent Owner’s statement regarding the understanding of the term “cable” in other fields of endeavor to be persuasive, given that the ’268 patent is directed to eyewear. In that respect, we are not persuaded that the term “cable” in the context of eyewear implicitly requires a configuration viewed as “stranded.” Upon the complete record before us, we see no reason to alter our earlier construction of the term “cable.”

3. “*temple retainer*”

We construed the term “temple retainer” to mean “the components of an eyeglass retention device that are attached to the eyeglasses.” Dec. 7. In doing so, we noted that this construction was consistent with the cited disclosure in claim 1 of temple retainers that are “attached to a pair of eyeglasses.” Ex. 1001, 4:38.

Patent Owner proposes that we construe “temple retainer” to mean “the components of an eyeglass retention device that are slid onto and off the end of the eyeglass temple.” PO Resp. 4. Petitioner disagrees, arguing that “slid onto and off the end” language is entirely absent from the claims

as written and should not be imported into our construction. Reply 1–2. Neither party points us to any portion of the specification apart from the claims that defines “temple retainer.”

The language of claim 1, in discussing temple retainers, states: “such that when the temple retainers are attached to a pair of eyeglasses” Ex. 1001, 4:37–38. Similarly, dependent claim 8, independent claim 9, and dependent claim 17, disclose that “the temple retainers are attached to a pair of eyeglasses.” *Id.* at 4:60–61, 4:65–66, 6:11–12.

Dependent claims 4 and 12 narrow this limitation, stating that “each of said temple retainers comprises an opening for receiving the temple of a pair of eyeglasses.” *Id.* at 4:47–49, 5:9–11. Claims 6 and 14 also narrow this limitation, stating “wherein said temple retainer is retained on an eyeglass temple by a friction fit.” *Id.* at 4:54–55, 6:1–2.

Patent Owner’s urged interpretation hews more closely to the version claimed in narrowing, dependent claims 4, 6, 12, and 14. Patent Owner does not explain how adopting a narrower claim construction does not violate claim construction principles when viewed in light of the broader claims 1, 8, 9, and 17. Patent Owner provides no explanation why we should adopt a construction for “temple retainer” that would render these dependent claims superfluous. *See InterDigital Commc’ns, LLC v. Int’l Trade Comm’n*, 690 F.3d 1318, 1324–25 (Fed. Cir. 2012). This counsels against reading this limitation into the independent claims. Upon the complete record before us, we see no reason to alter our earlier construction of the term “temple retainer.”

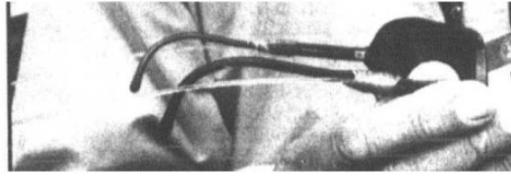
B. Asserted Grounds of Unpatentability under 35 U.S.C. § 103

Petitioner asserts that claims 1–17 are unpatentable under § 103 in view of certain combinations of the references. Pet. 34–59. In resolving the question of the obviousness of the claims, we consider the following underlying factual determinations: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; and (3) the level of skill in the art; and (4) secondary considerations of non-obviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)

1. Prior Art

a. Monroe (Ex. 1002)

Monroe, a newspaper article dated July 4, 1991, describes various eyewear retainers of the time. Ex. 1002, 1. The article states that the type of eyewear retainer that a user wears “around the back of his neck to hold his sunglasses on” has “only recently become popular among the wearers of glasses.” *Id.* at 3. One eyewear retainer, attributed to Mark Sosin, is described as a “retainer [that] never hangs up and never drapes around his neck.” *Id.* at 5. This retainer is made of a length of 300-pound test monofilament “so thick and stiff that the only knot it would take would be big enough to tie up a small ship.” *Id.* As shown in the photograph below, Mr. Sosin secures the retainer to the frame of the eyeglasses “by wrapping dental floss around it and finishes off the knot as if he were tying a fly.” *Id.*

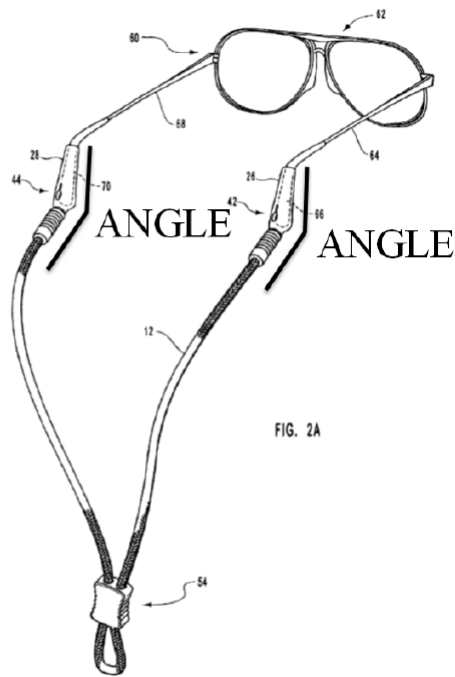


*Photograph from Monroe
(Ex. 1002 at 2.)*

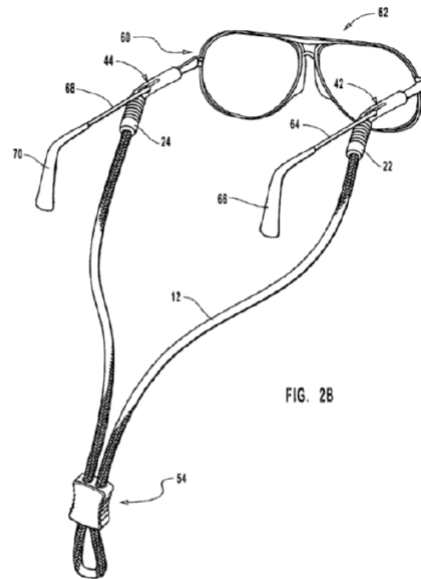
The portion of the photograph above shows Mr. Sosin using stout fishing line as a keeper for his sunglasses. Ex. 1002, 2; Pet. 36.

b. Mackay (Ex. 1003)

Mackay discloses an eyewear retention device having eyeglass retainers, or connectors, capable of selectively coupling to different portions of an eyeglass. Ex. 1003, Figs. 2A, 2B, 2:61–63. Mackay discloses that the connectors attach to a cord that may comprise a variety of materials. *Id.* at 5:36–45. Mackay’s Figures 2A and 2B as presented in the Petition are reproduced below:



*FIG. 2A of Mackay
(Ex. 1003 at 4, with annotations.)*



*FIG. 2B of Mackay
(Ex. 1003 at 5.)*

Pet. 26. Figures 2A and 2B (shown above) of Mackay are alternate views of an eyeglass retainer as disclosed in Mackay. Ex. 1003, 2:27–35; Pet. 26.

c. Chisolm (Ex. 1005)

Chisolm discloses two temple retainers attached to a “filament member.” Ex. 1005, Abstract. Figures 6, 8–10, and 12 of Chisolm illustrate the temple retainers of Chisolm and some of the possible manners in which they can be positioned. Pet. 28–29 (citing Figs. 6, 8–10, 12, 3:67–4:3). A version of Figure 12, as annotated by Petitioner, is reproduced below:

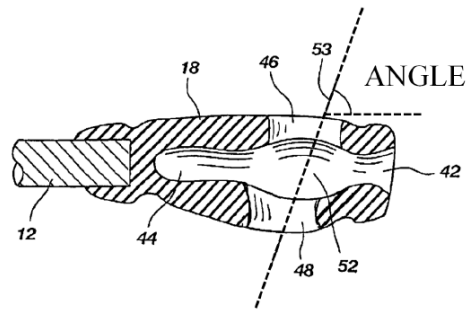


FIG. 12 of Chisolm (Ex. 1005 at 6, annotated.)

Pet. 29. Annotated Figure 12, reproduced above, is a view in cross section of an alternative embodiment of the gripping member of Chisolm where the transverse openings are not aligned. Ex. 1005, 3:7–9.

d. Miller (Ex. 1004)

Miller is titled “Eyewear with Weighted Flexible Temples” and is directed to “the field of eyewear and more specifically to adjustable and flexible temples used with eyeglasses.” Ex. 1004, (54), ¶ 2. Figure 9 of Miller as presented in the Petition is reproduced below:

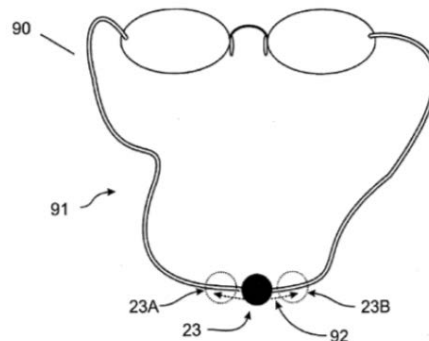


FIG. 9 of Miller (Ex. 1004 at 10.)

Pet. 32. Figure 9 is a user’s view of an eyewear assembly embodiment having a continuous flexible temple with a single sliding temple weight. Ex. 1004 ¶ 21. Miller provides that the flexible temple material can be

“clear monofilament polymer with or without cladding capable of photonic transmission” and also can be “of chain, cloth, woven string, flexible fiber, plastic, composite, wire, optical fiber, electrical conductor, cable, multi-clad cable, coaxial cable, rotable [sic] in longitudinal axis cable insert, metal, and tubing.” *Id.* ¶ 11.

2. *Instituted Grounds under § 103*

a. *Monroe and Mackay*

Petitioner challenges claims 1, 3–9, and 11–17 as unpatentable over Monroe and Mackay under 35 U.S.C. § 103(a). Pet. 35–41. Petitioner presents a claim chart identifying where the individual features of the challenged claims are alleged to be found in Monroe and Mackay. *Id.* at 37–41. Petitioner asserts that Monroe teaches all the elements of claim 1, with the exception of the two temple retainers, for which Petitioner relies on Mackay. *Id.* at 37. For independent claim 9, which differs from claim 1 only in that the term “resilient member” replaces “resilient cable,” Petitioner relies largely on its arguments for claim 1. *Id.* at 39. Petitioner argues that one of skill in the art would have “immediately recognized that a simple substitution of the eyewear retainers of Mackay for the attachment method employed in Monroe would have had various advantages.” *Id.* at 36 (citing Ex. 1007, 30–35).

b. *Monroe, Mackay and Miller*

Petitioner challenges claims 1–17 as unpatentable over Monroe, Mackay, and Miller under 35 U.S.C. § 103(a). Pet. 41–46. Petitioner’s claim chart, for the most part, refers to the claim chart for the Monroe and Mackay ground, *supra*, with the exception of elements in claims 1, 2, 9, and 10. *Id.* at 42–46. In its claim chart concerning the ground based on Monroe,

Mackay, and Miller, Petitioner relies on Miller to teach the “resilient cable” and “resilient member” of claims 1 and 9, respectively, and the “made from a metallic core coated in a smooth casing” limitation of claims 2 and 10. *Id.* at 42–45. Petitioner argues that “Miller establishes that it was known in the art of eyewear retaining devices to substitute an elongated piece of resilient plastic with a flexible metallic cable having a smooth casing” and that “such a direct substitution of known parts would have been obvious to one of ordinary skill in the art.” *Id.* at 41 (citing Ex. 1007, 30–32, 35–36).

c. Chisolm and Monroe

Petitioner challenges claims 1, 3–9, and 11–17 as unpatentable over Chisolm and Monroe under 35 U.S.C. § 103(a). Pet. 46–52. Petitioner asserts that Chisolm discloses two temple retainers attached to a “filament member.” *Id.* at 27–28 (citing Ex. 1005, Abstract). Petitioner further asserts that Chisolm discloses an eyewear retention device comprising two temple retainers, and relies on Monroe to disclose the remaining elements of claim 1. Pet. 48. For independent claim 9, which differs from claim 1 only in that the term “resilient member” replaces “resilient cable,” Petitioner relies largely on its arguments for claim 1. *Id.* at 50–51. According to Petitioner, Figures 6, 8–10, and 12 of Chisolm illustrate the temple retainers of Chisolm and some of the possible manners in which they can be positioned. *Id.* at 28–29. Petitioner further argues that one of ordinary skill in the art would have found it obvious to combine the teachings of Chisolm with those of Monroe, and specifically “would have been prompted to consider using the piece of monofilament disclosed in Monroe with Chisolm’s devices based on Chisolm’s suggestion that the ‘filament material . . . may be made of any suitable material, including

metals, fabrics, woven or non-woven cord, plastics or elastomers.” Pet. 47 (citing Ex. 1007, 30–32, 36–38).

d. Chisolm, Monroe, and Miller

Petitioner challenges claims 1–17 as unpatentable over Chisolm, Monroe, and Miller under 35 U.S.C. § 103(a). Pet. 52–53. For support, Petitioner refers to its claim charts and arguments in Sections VI.C, VI.D.2, and VI.D.3 of the Petition. *Id.* Petitioner argues that it would have been obvious to simply substitute any of the materials disclosed or suggested in Miller for the monofilament of Monroe. *Id.* at 52 (citing Ex. 1007, 30–32, 38).

3. Analysis

We have reviewed the Petition, the Patent Owner’s Response, and Petitioner’s Reply, as well as the relevant evidence discussed in those papers. Patent Owner’s responses to Petitioner’s arguments are focused on several categories not specific to any particular ground, namely: (a) the prior art does not teach all elements of the claimed invention; (b) even if all elements were in the prior art, there was no reason to combine them; (c) adding the resilient cable/member to an eyewear retainer was not a “simple substitution”; and (d) objective evidence. We address these arguments in turn.

a. Whether the prior art teaches all elements of the claimed invention

Patent Owner argues that (1) the cited art fails to teach any *connection* between a resilient cable/member and two temple retainers; (2) no connection is disclosed in Monroe, so the prior art fails to teach that the cable extends rearward from the head of the wearer; (3) Monroe is only

plastic, and Miller does not disclose the materials for its Figure 9 embodiment, and thus the prior art fails to teach the cable/member made of a “metallic core coated in a smooth casing” of claims 2 and 10; (4) Mackay and Chisolm fail to teach the “said back portion being connected to said cable [resilient member]” of claims 5 and 13; (5) Mackay and Chisolm do not teach the “angle” of claims 7 and 15; and (6) Monroe does not teach the “arc suspended substantially in the air” element of claims 8 and 17. PO Resp. 20–22.

Petitioner responds: (1), (2), Patent Owner’s understanding of “connection” is inconsistent with its plain and ordinary meaning, and under the broadest reasonable interpretation of the term, Monroe discloses a connection between a resilient cable/member and two temple retainers; (3) Miller’s disclosure explicitly lists options for its flexible temple element, and one of ordinary skill in the art would consider all these materials; (5) Mackay describes its connectors 18, 20 as being “angled,” and Chisolm expressly states that the temple retainers are angled; and (6) it would have been obvious to one of ordinary skill in the art to bend the monofilament of Monroe into a natural arc shape. Reply 3–6, 15–16; Tr. 14:16–15:15 (discussing connection). Petitioner refers to its arguments in the “simple substitution” section for further support. Reply 4.

Petitioner has argued in its Petition, as supported by its claim charts, that all the limitations of the claims are found in the prior art references. Patent Owner bases its first two arguments on a lack of “connection,” a term which we have not been asked to construe, and which does not appear in the claims. Rather, the claims and the Abstract discuss “temple retainers *connected* by a resilient cable” or “member.” Ex. 1001, Abstract. We are

persuaded by Petitioner's claim charts and arguments that the combination of references teaches "temple retainers connected by a resilient cable" or "member." Pet. 35–37 (citing Ex. 1003, Abstract; Ex. 1002, 5 ¶ 4), 46–48 (citing Ex. 1005, Abstract; Ex. 1002, 5 ¶ 4). Specifically, the test monofilament of Monroe, combined with the retainers taught in Mackay and Chisolm, respectively, results in an eyewear retention device having two temple retainers connected by a resilient cable. The specification does not discuss the term "connected," much less give it a meaning beyond its ordinary and customary one. We are not persuaded that a narrow reading of the term is warranted given the lack of discussion in the specification and the general nature of the claims. We understand that Monroe's resilient cable/member must in some way be connected or attached to the eyeglasses in order to function. Indeed, there can be no credible argument to the contrary. We do not perceive a shortcoming in the Monroe reference in this regard. Moreover, we understand that Petitioner also relies on references other than Monroe for the temple retainer element of the claims.

Regarding the limitations of claims 2 and 10, we are persuaded by Petitioner's claim charts and arguments that Miller discloses materials including a cable/member made from a metallic cord coated in a smooth casing. Pet. 42–43 (citing Ex. 1004, Figs. 5, 9, ¶¶ 11, 24, 32). For example, we are persuaded that Miller teaches a cable/member made from a metallic core coated in a smooth casing because it specifically discusses that, in the field of eyewear, it was well known to use a variety of materials, including, for example, coaxial cable, to encircle a wearer's head. Ex. 1004 ¶ 11.

Regarding the limitations of claims 5 and 13, we are persuaded by Petitioner's claim charts and arguments that Mackay and Chisolm teach the

“said back portion being connected to said cable/resilient member.” Pet. 38 (citing Ex. 1003, 2:64–67), 49 (citing Ex. 1005, 3:45–48, Fig. 6). Patent Owner’s argument that “the connection in those references is not with a resilient cable/member” goes more to the “simple substitution” arguments, and also overlooks Petitioner’s reliance on other references to disclose the cable/member element. Petitioner relies on Mackay and Chisolm for the specific temple retainer features recited in claims 5 and 13, and proposes combining these teachings with those of Monroe and/or Miller regarding the specific type of cable/member recited (i.e., “a resilient cable”).

Regarding the “angle” limitation of claims 7 and 15, we are persuaded by Petitioner’s argument and claim charts that Mackay and Chisolm each teach this limitation. Pet. 38 (citing Ex. 1003, Fig. 2A), 49–50 (citing Ex. 1005, Fig. 12, 3:66–4:3). Patent Owner’s arguments to the contrary focus on alternate embodiments in an attempt to highlight inconsistencies in the references. We are persuaded that Mackay teaches this limitation because it specifically discusses and depicts connectors 18, 20 as being “angled.” Ex. 1003, 4:25–29, Figs. 1–3B. We are also persuaded that Chisolm teaches this limitation because it specifically discusses and depicts that the temple retainers are angled. Ex. 1005, Figs. 8–10, 12, 4:48–55. We are not persuaded that the arguments made by Patent Owner appropriately account for these explicit disclosures of Mackay and Chisolm.

Finally, regarding the “arc suspended substantially in the air” limitation of claims 8 and 17, we find Petitioner’s arguments persuasive that Monroe teaches this element. Pet. 38–39 (citing Ex. 1002, 2, 5; Ex. 1007, ¶ 40). We take into consideration Patent Owner’s argument that the picture of Monroe is cropped, and thus neither the picture nor the text show this

limitation. However, we are persuaded by description in the reference itself, which states that Sosin “bends a length of 300-pound test filament,” and Petitioner’s argument that the ordinarily skilled artisan would have formed the filament into an arc to “merely allow the bent monofilament to assume a natural arc shape when bent” rather than crimp it as suggested by Patent Owner. Ex. 1002, 5; Reply 6.

b. Reasons to combine the prior art

i. Teaching away

Patent Owner argues that the prior art references teach away from each other: (1) Monroe teaches against attaching 300 pound test monofilament to a flexible temple retainer; (2) the slider in Mackay and Chisolm teaches away from using a resilient member; (3) “Monroe’s flexible temple retainers with readily bendable accordion-like ends teach away from keeping the resilient member of Monroe off the neck;”³ (4) Mackay and Chisolm secure glasses to the face by tightening the cord against the neck, teaching away from Monroe’s purpose of staying off the neck; (5) Mackay teaches against using a normalizing angle that would lift the cable/resilient member up; and (6) Miller teaches away from using the resilient member of Monroe because Miller requires a flexible temple element. PO Resp. 23–24.

Petitioner responds: (1) Patent Owner does not explain how Monroe affirmatively dissuades one of skill in the art from using monofilament line with flexible temple retainers; (2), (4) Mackay discloses an embodiment

³ Although the first mention of “Monroe” in Petitioner’s third argument appears to be a typographical error, because Patent Owner does not elsewhere discuss Monroe’s flexible temple retainers, we do not speculate as to what Patent Owner may have intended to argue, and do not discuss it separately.

without a slider, and the slider of Chisolm is optional; (5) the teachings of Mackay upon which Patent Owner relies are optional; and (6) Miller merely illustrates the variety of materials that could be used as interchangeable replacements for monofilament line. Reply 7–11.

A reference is available for all that it teaches to a person of ordinary skill in the art. *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (“the fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered”) (quoting *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976)). “The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). “We will not read into a reference a teaching away . . . where no such language exists.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1364 (Fed. Cir. 2006). None of Patent Owner’s examples of purported “teaching away” criticize, discredit, or otherwise discourage the solution claimed. Patent Owner presents a one- or two-sentence statement to support each asserted “teaching away” ground, but fails to provide a persuasive analysis of why the references affirmatively teach away in the manner asserted by Patent Owner. We are persuaded, rather, by Petitioner’s more detailed responses explaining why the prior art references do not “teach away” in the manner alleged by Patent Owner. *See* Reply 7–11.

ii. “*Being in the way*”

Patent Owner defines the “being in the way” problem as “a problem caused by prior art retainers—the burden of the retention cord on the neck and its being in the way of and getting ensnared in the wearer’s garments.” PO Resp. 2. Patent Owner argues that actual, highly skilled artisans employed by Petitioner had not recognized “being in the way” as a problem to be solved. *Id.* at 24. Rather, Patent Owner argues, “only by the use of improper hindsight could a factfinder find that a *hypothetical* person of ordinary skill would have taken a path that multiple *actual* persons of ordinary skill never took, even with the prior art right in front of them.” *Id.* at 29.

Petitioner replies that the “being in the way” problem had been solved in the prior art, by Mark Sosin. Reply 12–13 (citing Ex. 1002, 5). Petitioner criticizes as irrelevant Patent Owner’s focus on whether individuals at Chums and Croakies solved the problem. *Id.* at 12. Petitioner also argues that it could not “develop *every* device that would be obvious,” but rather waited until there was an apparent market. *Id.* at 13–14.

We are persuaded that Mr. Sosin’s device, disclosed in the Monroe reference, solved the “being in the way” problem. Mr. Sosin stated “I don’t like light line that falls on my neck in the heat.” Ex. 1002, 5. In his development, the retainer “never hangs up and never drapes around his neck. Indeed, it sticks straight out behind his head at all times the glasses are worn.” *Id.* Patent Owner argues that Mr. Sosin was not one of ordinary skill in the art. Tr. 55:18–19. Patent Owner relies on *KSR* to argue that the invention would have to have been made by a skilled designer of eyewear retainers as of 2007–08. PO Resp. 24 (citing *KSR Int’l Co. v. Teleflex Inc.*,

550 U.S. 398, 424 (2007)). However, we are not directed to any case law disqualifying one of purportedly less than ordinary skill in the art from inventing relevant prior art. We are not persuaded that Mr. Sosin, because he was not employed at Chums or Croakies during the time period Patent Owner discusses, is ineligible to solve the problem of “being in the way.” Nor are we persuaded that it matters whether or not the individual or individuals that solved the problem were employed at Chums or Croakies. Thus, we are not persuaded that the “being in the way” problem had not been solved prior to Patent Owner’s invention.

iii. Recognition of the problem required for invention

Patent Owner argues that persons of ordinary skill in the art had not recognized the “being in the way” problem solved by the ’268 patent. PO Resp. 30. Mr. Sosin, according to Patent Owner and “all the experts’ definitions,” was not a person of ordinary skill. *Id.* (no citation provided). Patent Owner relies on *Leo Pharmaceutical Products Ltd. v. Rea*, 726 F.3d 1346 (Fed. Cir. 2013) to support its argument that the ’268 patent recognized and solved “a problem that the prior art did not recognize and a problem that was not solved” for a long period of time. PO Resp. 29–30 (citing *Leo*, 726 F.3d at 1353).

Petitioner responds that Mr. Sosin did in fact recognize and solve the “being in the way” problem, relying on its earlier arguments. Reply 14. Patent Owner does not explain persuasively, or provide support for, why Mr. Sosin’s invention does not constitute “prior art” that both recognized and solved the problem. As discussed above, and for the reasons provided above, Mr. Sosin recognized and solved the problem at issue.

iv. *Failure of artisans to combine strong evidence of no reason to combine*

Patent Owner cites case law in support of its proposition that failure of Petitioner to combine the references is strong evidence that there was no reason to combine the references. PO Resp. 30–31 (citing *Rosemount Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540 (Fed. Cir. 1984), *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1099 (Fed. Cir. 1985)). Specifically, Patent Owner argues: “What Petitioners knew – and did nothing about – is strong evidence that the prior art combinations cited do not make the invention claimed in the ’268 Patent obvious.” *Id.* at 31.

Petitioner replies that the “actual highly skilled artisans” never attempted to manufacture an off-the-neck retainer, and thus never failed. Reply 15. Petitioner argues that the problem had already been solved by Sosin, and that Petitioner “merely waited until there was an apparent market for off-the-neck retainers.” *Id.*

We are not persuaded that the cases cited by Patent Owner are on point to the situation at hand. Patent Owner’s sale of its products evidenced that a market in fact existed for a retainer that is suspended off the neck of the wearer. Petitioner’s later entry into that market is not necessarily evidence that Petitioner had been trying and failing to make such a retainer. Unlike the cases cited, Petitioner had not tried and failed repeatedly to make such a product, or expended millions doing so. Thus, we do not view Petitioner’s later entry into the market as evidence that there was no reason to combine the references before us.

v. *Age of the cited references*

Patent Owner argues that the age of the cited references shows lack of a reason to combine. PO Resp. 31. Specifically, Patent Owner argues that Monroe was at least 16 years old as of the '268 patent's priority date. *Id.* at 32. Petitioner replies that the age of the cited references is only one of many factors to consider in an obviousness analysis. Reply 15–16. Petitioner also argues that in the present case, “the alleged invention *is* simply a combination of prior art elements, and the prior art not only recognized the problem—it also solved the problem.” *Id.* at 16.

We do not see the age of the cited references, here, as an issue that merits a conclusion of non-obviousness. The “person of ordinary skill is a hypothetical person who is presumed to be aware of all the pertinent prior art.” *Custom Accessories, Inc. v. Jeffrey–Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986). That there may be a temporal gap between Monroe and the priority date of the '268 patent does not mean that a skilled artisan would not have been aware of, and appreciated, the teachings of Monroe. Patent Owner presents no additional reasons in this section of its arguments that Monroe's age renders Monroe irrelevant or that it should disqualify Monroe as a reference.

vi. *Expert testimony*

Patent Owner argues that the Visser Declaration is insufficient and vague to support a conclusion of obviousness. PO Resp. 32–35. Patent Owner takes issue with Mr. Visser's statements that the invention is “simple” and that only “simple substitution” is required. *Id.* at 34. In sum, Patent Owner argues, Petitioner's evidence “is a string of unsupported conclusions that does not outweigh the substantial evidence cited herein that

Petitioners themselves failed to make, see the need for, or even identify the problem solved by such a product – until they saw it on the market.” *Id.* at 35.

Petitioner responds that Mr. Visser’s testimony is sound, and that Patent Owner “generally takes Visser’s quotes out of context, misconstrues them, or uses them in straw man arguments.” Reply 16.

We are not persuaded that the Visser Declaration is insufficient and vague based on Patent Owner’s assertions alone. We also note that Patent Owner elected not to depose Mr. Visser, and so we have no further testimony to elucidate any purported shortcomings in his declaration testimony. It is within our discretion to assign the appropriate weight to be accorded to the information in the Visser Declaration. The Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine and assign appropriate weight to evidence presented. *Gnosis S.P.A. v. S. Ala. Med. Sci. Found.*, IPR2013-00118, slip op. at 43 (PTAB June 20, 2014) (Paper 64). Accordingly, we evaluate Mr. Visser’s testimony along with the remainder of the evidence before us to reach our conclusions.

4. Simple Substitution

Patent Owner alleges that a number of factors enable temple retainers to keep the cable/member off the neck or collar, and that making this happen is not a simple, trivial, or obvious task. PO Resp. 35–36. Patent Owner cites to a variety of evidence indicating that Petitioner’s attempts to do so were fraught with problems. *Id.* at 37–39.

Petitioner replies that Patent Owner’s contentions are inapposite, in that the “existence of two allegedly non-obvious connection configurations for a resilient cable does not imply that all connection configurations for a

resilient cable must be non-obvious.” Reply 17. Petitioner cites to evidence that its product was achieved with minimal experimentation and as a matter of simple substitution. *Id.* at 17–18 (citing Ex. 1028, 3–5, discussing Petitioner’s process of coming up with its own off-the-neck eyewear). Petitioner points out that the claims recite no removability requirement, which Patent Owner highlighted as a problem with Petitioner’s product. *Id.* at 18.

Patent Owner’s arguments and evidence that the steps that would need to be taken to achieve the “off the neck” position would be very complicated is contradictory to Petitioner’s arguments and evidence. The evidence illustrates that Petitioner only required minimal experimentation, and one set of trials by Sterling McMurrin, a Chums employee, to achieve an off-the-neck retainer. Reply 17–18 (citing Ex. 1028, 3–5). The language of the claims, which generally requires two temple retainers connected by a resilient cable such that the cable is suspended off the neck of the wearer, does not impose many additional requirements on the configuration of the claimed invention. Petitioner’s demonstration that it could be done, and in fact was done, with minimal effort undermines Patent Owner’s argument that it was more than a “simple substitution.” We note as well that Patent Owner elected not to depose Mr. McMurrin, and so did not question him regarding his assertions in his declaration that the substitution was one reasonably characterized as simple.

5. Objective Evidence of Non-Obviousness

Patent Owner argues that Petitioner has failed to present a *prima facie* case of obviousness, but nevertheless, presents “substantial evidence of not just one, but three separate secondary considerations: copying, commercial

success, and industry praise.” PO Resp. 41. Petitioner argues that, here, “the strong *prima facie* case of obviousness trumps any secondary considerations that could otherwise weigh in favor of non-obviousness.” Reply 19. We, thus, consider this evidence (sometimes referred to as objective evidence or indicia) along with the contentions of the parties in reaching our final determination as to the obviousness of claims 1–17.

Secondary considerations may include any of the following: long-felt but unsolved needs, failure of others, unexpected results, commercial success, copying, licensing, and praise. *Graham*, 383 U.S. at 17. We note that it is not sufficient that a product or its use merely be within the scope of a claim in order for secondary evidence of non-obviousness tied to that product to be given substantial weight. There must also be a causal relationship, termed a “nexus,” between the evidence and the claimed invention. *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1376 (Fed. Cir. 2005). A nexus is required in order to establish that the evidence relied upon traces its basis to a novel element in the claim, not to something in the prior art. *Institut Pasteur & Universite Pierre et Marie Curie v. Focarino*, 738 F.3d 1337, 1347 (Fed. Cir. 2013).

Objective evidence that results from something that is not “both claimed and *novel* in the claim,” lacks a nexus to the merits of the invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011). All types of objective evidence of non-obviousness must be shown to have such a nexus. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995) (nexus generally); *see also Rambus Inc. v. Rea*, 731 F.3d 1248, 1256 (Fed. Cir. 2013) (long-felt need); *Wm. Wrigley Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d 1356, 1364

(Fed. Cir. 2012) (copying); *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996) (commercial success).

a. Copying

Patent Owner asserts that Petitioner copied Patent Owner's invention. PO Resp. 41–44. Copying, as objective evidence of non-obviousness, requires evidence of effort to replicate a specific product. *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010); *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004).

Patent Owner argues, first, that Chums developed its Orbiter product by copying Patent Owner's product. PO Resp. 42. Specifically, Patent Owner states that “when Chums developed the Orbiter, Chums had in its possession physical specimens of the Cablz twisted wire cable product, and Chums made a deliberate effort to copy the off-the-neck aspect of the Cablz product including its twisted steel wire.” *Id.* (citing Ex. 2054 at 14–15). In the opinion of Patent Owner's expert, Chums copied the '268 patent when producing the Orbiter. *Id.* at 43 (citing Ex. 2071 ¶ 54). Patent Owner argues, next, that Croakies had attempted to negotiate, unsuccessfully, a license for the parent of the '268 patent. *Id.* at 44. According to Patent Owner, Croakies then worked on its own retainer (the ARC), which “has a wire cable that stays off the neck like a Cablz product.” *Id.*

Petitioner argues, first, that Patent Owner's products have a specific configuration (slidable end beads and grommets that prevent the beads from sliding off the cable), and that Petitioner's products have a different connection configuration. Reply 19. Petitioner also argues that it was not possible to copy the '268 patent, which issued in 2013, given that Chums and Croakies began selling their off-the-neck retainers in 2009 and 2010,

respectively. *Id.* at 19–20. Petitioner further argues that it was Patent Owner, in fact, that copied Mark Sosin’s cable product that did not touch the wearer’s head or shoulders. *Id.* at 20 (citing Mr. Sosin’s reaction to the Cablz product as “gee, they copied what I’ve been doing for 50 years.” Ex. 1033, 192).

We are not persuaded that Petitioner’s product is a copy of Patent Owner’s product. Petitioner’s product uses a different configuration than Patent Owner’s product, and Petitioner obtained its own patent on that product. Moreover, given the timing of the ’268 patent, Petitioner could not have had access to “the patented product” in 2007–08; Petitioner may have had access to a product covered by a different Patent Owner patent (the ’867 patent). Additionally, Petitioner may have had access to Patent Owner’s products, but given that the concept of the off-the-neck retainer was known in the prior art, it is not definitive which references Petitioner looked at in designing its own product. In sum, Patent Owner has not provided sufficient evidence that Petitioner had access to “the patented product” or copied the patented technology. We are not persuaded by Patent Owner’s assertion that Petitioner copied the patented invention.

b. Commercial Success

Evidence of commercial success “is only significant if there is a nexus between the claimed invention and the commercial success.” *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1311–12 (Fed. Cir. 2006). To establish a proper nexus between a claimed invention and the commercial success of a product, a patent owner must offer proof that the sales were a direct result of the unique characteristics of the claimed invention, and not a result of economic and commercial factors unrelated to the quality of the patented

subject matter. *In re Applied Materials, Inc.*, 692 F.3d 1289, 1299–1300 (Fed. Cir. 2012). If the feature that created the commercial success was known in the prior art, the success is not pertinent to the issue of obviousness. *Galderma Labs., L.P. v. Tolmar, Inc.*, 737 F.3d 731, 740 (Fed. Cir. 2013).

Patent Owner argues that there is a “compelling argument that Cablz’s (and Chums’) commercial success is particularly demonstrative of nonobviousness.” PO Resp. 46. Patent Owner asserts Chums has enjoyed substantial commercial success with its Orbiter products “embodying the ’268 patent.” *Id.* at 44–45. Patent Owner provides evidence that, starting from nothing, it has grown quickly, and has posted sales figures in the millions of dollars in recent years. *Id.* at 48. Patent Owner argues that it “has both made a prima facie showing of a nexus and proven substantially that its commercial success is directly linked to the patented features of its products.” *Id.* at 50.

Petitioner argues that if “commercial success is due to an element in the prior art, no nexus exists.” Reply 21 (citing *Tokai Corp. v. Easton Enter., Inc.*, 632 F.3d 1358, 1369 (Fed. Cir. 2011)). Petitioner takes issue with Patent Owner’s newly created “objective” evidence of commercial success as attributable to “features embodied in the ’268 Patent,” stating that “none of Patent Owner’s testimony evidence identifies any unique features that are not in the prior art.” *Id.* at 23.

We are not persuaded by Patent Owner’s commercial success evidence. As a threshold matter, Patent Owner has not established a nexus between its commercial product and any novel features of its claimed off-the-neck product. Petitioner has demonstrated that the rearward-from-the-

head and the off-the-neck features were present in the prior art. Patent Owner's assertions that these features drove Patent Owner's increased sales do not demonstrate a nexus between any commercial success and the claimed invention of the '268 patent.

Even if Patent Owner had established a nexus between its claimed invention and its product, however, its commercial success argument would not be persuasive. Patent Owner has not provided evidence of the market share held by its product to back up its claim of commercial success. *See* PO Resp. 48–49. Patent Owner states: “The eyewear retainer market is small and dominated by three or four companies, two of which are the Petitioners in this case. Ex. [2080] ¶ 13–18. There is no publically available market information on the eyewear retainer market. *Id.* ¶17; *see also* Ex. 2058 at 8–9.” PO Resp. 46 n.1. According to the Federal Circuit, “the more probative evidence of commercial success relates to whether the sales represent ‘a substantial quantity in th[e] market.’” *Applied Materials*, 692 F.3d at 1300 (quoting *Huang*, 100 F.3d at 140). Patent Owner offers no evidence of the size of the market to which to compare its sales. Accordingly, we are not persuaded that Patent Owner's alleged objective indicia of commercial success shows non-obviousness.

c. Industry Recognition

Patent Owner argues that industry recognition of its product supports its argument of nonobviousness. Patent Owner states that its eyewear retainer won Best of Show in 2009 for the Apparel Category in the American Sportfishing Association trade show, out of approximately fifty entries in the Apparel category. PO Resp. 56, 58. Patent Owner also provides proof of industry recognition in trade journals, namely, Fishing

Tackle Retailer and Outdoor USA Magazine. *Id.* at 59. Petitioner argues that, in the case of the Best of Show award, the voting was not indicative of non-obviousness of the claims of the '268 patent. Reply 24.

As with commercial success, evidence of industry praise is only relevant when it is directed to the merits of the invention claimed. *See Ormco Corp.*, 463 F.3d at 1311–12. As discussed by Petitioner's evidence, it is unclear that the voting criteria for the Best in Show award required that the voters consider the merits of the claimed invention. The four criteria cited by Patent Owner — innovation, execution, workmanship, and practicality — constitute a wide range of possible considerations for the voter that extend beyond simply merits of the claimed invention. PO Resp. 57.

Regarding the trade journal evidence, we are not persuaded that the two brief mentions in Fishing Tackle Retailer and Outdoor USA Magazine cited by Patent Owner constitute industry praise. *See Bayer Healthcare Pharms., Inc. v. Watson Pharms., Inc.*, 713 F.3d 1369, 1377 (Fed. Cir. 2013) (finding that brief discussions of Patent Owner's product in journal articles "fall well short of demonstrating true industry praise").

d. Conclusion

Accordingly, on balance, we determine that Petitioner's strong evidence of obviousness of claims 1–17 outweighs the evidence of secondary considerations of nonobviousness submitted by Patent Owner. We determine that Petitioner has established by a preponderance of evidence that claims 1–17 are unpatentable under the asserted grounds.

III. MOTIONS TO SEAL

A. *Petitioner's Motions to Seal*

Petitioner filed several exhibits (Exhibits 1017, 1019, 1021, 1024 (now expunged), 1028, 1030–1031 (now expunged), 1034, and 1035) and its Unredacted Reply (Ex. 1038) under seal. Petitioner filed three Motions to Seal (Paper 17, Paper 27, Paper 40). Paper 17 moves to seal Exhibits 1017, 1019, and 1021. Paper 27 moves to seal Exhibits 1024, 1030, 1031, and 1034. Paper 40 moves to seal Exhibits 1028, 1034, 1035, and 1038. The Motions to Seal refer to a Stipulated Protective Order filed by Patent Owner on November 17, 2014. Ex. 2062.

The *Office Patent Trial Practice Guide* states the following concerning protective orders:

(a) *Purpose*. This document provides guidance on the procedures for filing of motions to seal and the entry of protective orders in proceedings before the Board. The protective order governs the protection of confidential information contained in documents, discovery, or testimony adduced, exchanged, or filed with the Board. *The parties are encouraged to agree on the entry of a stipulated protective order*. Absent such agreement, the default standing protective order will be automatically entered.

Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48769 (Aug. 14, 2012) (App'x B (emphasis added)). The document submitted by Patent Owner is titled “Stipulated Protective Order” and Petitioner acknowledges its filing. Papers 17, 40. We thus enter the Stipulated Protective Order submitted as Exhibit 2062.

We have reviewed the exhibits at issue and agree with Petitioner that they contain trade secret or other confidential information. Given the sensitive nature of this information, and noting the fact that the Motions to

Seal were unopposed, we agree with Petitioner that good cause has been shown to seal the information. For the reasons discussed above, the Motions to Seal (Paper 17 and Paper 40) are granted. Because the papers to which it is directed have been expunged, the Motion to Seal (Paper 27) is dismissed as moot.

B. Patent Owner's Motions to Seal

Patent Owner filed nearly every Exhibit (Exhibits 2001–2022, 2025–2042, 2053–2058, 2061, 2066–2071, 2073–2081) under seal. Exhibits 2070, 2071, and 2081 have been expunged. Patent Owner also filed Motions to Seal (Paper 7, Paper 34) and Stipulated Protective Order (Ex. 2062). Paper 7 moves to seal Exhibits 2001–2022, 2025–2042, 2053–2058, and 2061. Paper 34 moves to seal Exhibits 2066–2069 and 2073–2080.⁴ As noted above, the Stipulated Protective Order (Ex. 2062) is entered.

We have reviewed the exhibits at issue and agree with Patent Owner that they contain trade secret or confidential information. Given the sensitive nature of this information, and noting the fact that the Motions to Seal were unopposed, we agree with Patent Owner that good cause has been shown to seal the information. For the reasons discussed above, Patent Owner's Motions to Seal are granted.

C. Confidential Information

However, we note that confidential information subject to a protective order ordinarily becomes public 45 days after final judgment in a trial,

⁴ Paper 34 also moves to seal Exhibit 2072, which was not filed under seal. Patent Owner also misidentifies Exhibit 2072 as an email in its Motion to Seal. Paper 34. Thus, we do not consider this Motion to Seal to cover Exhibit 2072.

unless a motion to expunge is granted. 37 C.F.R. § 42.56; *Office Patent Trial Practice Guide*, 77 Fed. Reg. at 48761. In view of the foregoing, the confidential documents filed in the instant proceeding will remain under seal, at least until the time period for filing a notice of appeal has expired or, if an appeal is taken, the appeal process has concluded. The record for the instant proceeding will be preserved in its entirety, and the confidential documents will not be expunged or made public, pending appeal.

Notwithstanding 37 C.F.R. § 42.56 and the *Office Patent Trial Practice Guide*, neither a motion to expunge confidential documents nor a motion to maintain these documents under seal is necessary or authorized at this time. *See* 37 C.F.R. § 42.5(b). Should the parties seek to file a motion to expunge, they must contact the Board first to discuss the documents they seek to expunge.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that claims 1–17 of U.S. Patent No. 8,366,268 B2 are unpatentable;

FURTHER ORDERED that Petitioner’s Motions to Seal are granted;

FURTHER ORDERED that Patent Owner’s Motions to Seal are granted; and

FURTHER ORDERED that this is a Final Decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

FOR PETITIONER:

Daniel C. Higgs
Andrew D. Maslow
Kevin B. Laurence
dan.higgs@stoel.com
andy@andymaslow.com
kevin.laurence@renaissanceiplaw.com

FOR PATENT OWNER:

Joseph Bird
Paul Sykes
jbird@babco.com
psykes@babco.com