

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FELLOWES, INC.
Petitioner

v.

SPECULATIVE PRODUCT DESIGN, LLC
Patent Owner

Case IPR2013-00197
Patent 8,204,561

Before SCOTT R. BOALICK, *Acting Vice Chief Administrative Patent Judge*,
LORA M. GREEN and BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. BACKGROUND

Fellowes, Inc. (“Fellowes”) filed a petition (“Pet.”) requesting *inter partes* review of claims 1-16 of U.S. Patent No. 8,204,561 (“the ’561 patent”; Ex. 1001) on March 20, 2013 (Paper 1), and an amended petition on April 2, 2013 (Paper 8).¹ Patent Owner, Speculative Product Design, LLC (“Speck”) filed a preliminary patent owner response (“Prelim. Resp.”) on June 25, 2013 (Paper 15). We have jurisdiction under 35 U.S.C. §§ 6(b) and 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which states:

THRESHOLD. -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Inter partes review is instituted only if the petition supporting the ground demonstrates “that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable.” 37 C.F.R. § 42.108(c).

We conclude that Fellowes has shown that there is a reasonable likelihood that it will prevail with respect to at least one of the challenged claims. We grant the petition as to claims 1-16 of the ’561 patent.

¹ All further references to the petition are to the amended petition (Paper 8).

A. Related Proceedings

Fellowes indicates that the '561 patent is the subject of an International Trade Commission ("ITC") investigation brought by Speck, captioned *In the Matter of Certain Cases for Portable Electronic Devices*, Investigation No.: 337-TA-867/861 (consolidated). Pet. 1. Fellowes indicates that Speck filed a related complaint in the U.S. District Court for the Northern District of California (Case No. 3:12-cv-04998-EMC) concurrent with that investigation, against Fellowes and Body Glove International, LLC. The litigation was stayed pending the outcome of the ITC investigation. *Id.*

Fellowes further indicates that the '561 patent is involved in additional litigation, in which it is not a party, and is thus unaware of the status of that litigation (*id.* at 1-2).

B. The '561 Patent

The '561 patent is drawn to a protective case for mobile electronic devices. '561 patent, col. 1, ll. 17-19.

The disclosure of the '561 patent states that the case provides an improvement over existing cases by combining a hard case with an elastomeric case while being a single part. *Id.* at col. 1, ll. 59-62. The interior elastomeric portion provides shock protection to the device, as well as ensuring that the case fits snugly on the device. *Id.* at col. 2, ll. 9-12. The hard protective exterior shell, which mimics the finish of the mobile electronic device, has a low coefficient of friction, allowing the device to be slipped easily into and out of a pocket. *Id.* at col. 1, l. 65-col. 2, l. 7.

The exterior hard shell of the case wraps around the electronic device, but in order to allow it to be mounted on the device, the corners of the hard shell are cut

open. *Id.* at col. 2, ll. 18-22. The elastomeric material fills in the gaps created in the hard shell, creating a one-piece case that wraps around the electronic device. *Id.* at col. 2, ll. 25-34.

C. Representative Claim

Fellowes challenges claims 1-16 of the '561 patent. Claim 1 is the only independent claim, and reads as follows:

1. A one-piece case for enclosing a personal electronic case comprising:

a flexible inner layer co-molded with an exterior hard layer and permanently affixed together to form a co-molded one-piece assembly;

wherein the co-molded one-piece assembly is sufficiently flexible to accept insertion of the personal electronic device and sufficiently rigid to securely retain the inserted electronic device, wherein:

the flexible inner layer includes a bottom surface, side surfaces joined to the bottom surface and extending upward therefrom, and a fitted cavity configured to accept and retain the inserted personal electronic device such that the bottom surface covers at least a portion of a bottom surface of the inserted personal electronic device and the side surfaces cover at least a portion of a side surface of the inserted personal electronic device;

the exterior hard layer includes a bottom surface and side surfaces sized and shaped to substantially cover an exterior of the bottom and side surfaces of the flexible inner layer and a cut away portion that is permanently filled with a portion of the co-molded flexible inner layer.

D. Prior Art Relied Upon

Fellowes relies upon the following prior art references (Pet. 8):

Bau, US 2010/0096284 A1, published April 22, 2010 (Ex. 1004).

Bodkin et al. ("Bodkin"), US 2007/0225031 A1, published September 27, 2007 (Ex. 1006).

Jeremy Horwitz, SwitchEasy Capsule Rebel for iPhone 3G, iLounge (July 31, 2008), <http://www.ilounge.com/index.php/reviews/entry/switcheasy-capsule-rebel-for-iphone-3g/> (“Horwitz-SwitchEasy”) (Ex. 1009).

Jeremy Horwitz, Incipio Silicrylic Case for iPhone, iLounge (July 31, 2007), <http://www.ilounge.com/index.php/reviews/entry/incipio-silicrylic-case-for-iphone/> (“Horwitz-Incipro”) (Ex. 1010)

E. The Asserted Challenges

Fellowes challenges the patentability of claims of the '561 patent on the following grounds (Pet. 9).

Reference(s)	Basis	Claims challenged
Bodkin	§ 102(b)	1-16
Bodkin	§ 103	6 and 9
Bodkin and the Admitted Prior Art	§ 103	1-16
Bau and Bodkin	§ 103	1-16
Bodkin and Bau	§ 103	1-16
Bodkin and Horwitz-SwitchEasy	§ 103	1-16
Bodkin and Horwitz-Incipro	§ 103	1-16

II. ANALYSIS

A. *Claim Interpretation*

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under the broadest reasonable construction

standard, claim terms are given their ordinary and customary meaning 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).

B. Obviousness over the combination of Bodkin and Bau or the combination of Bodkin and Horowitz-Incipro

Fellowes contends that claims 1-16 are rendered obvious under 35 U.S.C. § 103 by the combination of Bodkin and Bau or the combination of Bodkin and Horowitz-Incipro. As the issues are the same for both challenges, we will address them together.

Fellowes asserts that Bau discloses a case for a personal electronic device that has a flexible inner layer and hard outer layer, wherein the hard outer layer has cutout areas. Pet. 13-14. Specifically, Bau discloses a protective case for handheld electronic devices. Bau, ¶ 7. The protective case includes a glove of softer material that substantially covers and grips the entire back of the device, and also wraps over the edges of the device. *Id.* at ¶ 8. A separate frame piece, made of a hard material, is attached over the glove piece, and extends over a large portion of the glove piece, “creating a robust interlocking hybrid structure.” *Id.* Bau further discloses that portions of the exterior hard case may grip the glove and device at the corners “to strategically protect the more vulnerable edges and corners of the device.” *Id.* ¶ 40.

Horwitz-Incipro describes a protective case for the Apple iPhone made by Incipio Technologies. Ex. 1010-1. The Incipio case combines a hard plastic back shell with a soft silicone rubber case. *Id.* When the iPhone is placed into the into the soft rubber case, the rubber sufficiently expands to lock safely into the clear plastic shell. *Id.* at 1010-2. Fellowes contends that “cut outs formed in the hard

shell allow the case to flex to facilitate its positioning around the phone and silicone layer, to retain the phone and silicone layer therein.” Pet. 16.

Each of Bau and Incipio teaches a two-piece case having an inner layer that is sufficiently flexible to accept insertion of the personal electronic device, and an exterior hard layer that includes a bottom surface and side surface that are shaped and sized to cover substantially an exterior of the bottom and side surfaces of the flexible inner layer. The outer layer also includes cutaway portions that are filled in by the flexible inner layer. What is not taught by either Bau or Incipio is a one-piece case, wherein the flexible inner layer is co-molded with the hard outer layer.

Fellowes contends that Bodkin teaches a case for portable electronic uses formed from co-molding some of the components. Pet. 14. Fellowes emphasizes that, while Bodkin illustrates a clamshell case, Bodkin also “makes clear that the case could be a non-clamshell case.” *Id.* at 14-15.

Bodkin discloses a carrying case for a portable electronic device, and a process of producing the case by a co-molding process. Bodkin, ¶ 2. The co-molded material is produced by pouring a liquid plastic material into the mold, and then pouring a second liquid plastic material in the mold, wherein the second plastic material has physical characteristics different from the first. *Id.* at ¶ 11. According to Bodkin, co-molding “allows the part or panel being manufactured to easily incorporate different properties, colors, textures, shapes, or other characteristics, while allowing for efficient construction.” *Id.* at ¶ 56; *see also id.* at ¶¶ 57-61.

Bodkin further discloses that the case may have apertures at the corners, which allow the material to fit the curve of the corner of the portable electronic device. *Id.* at ¶ 9. Bodkin notes, however, that the apertures leave the corners

exposed or unprotected. *Id.* at ¶ 10. Thus, Bodkin also discloses that co-molding may be used to place protective structures at the corners. *Id.* at ¶ 74.

Finally, Bodkin teaches that “[o]ne skilled in the art will recognize the construction, materials, and methods can be applied to other cases for portable electronic devices, and need not be limited to the clamshell design shown in the figures.” *Id.* at ¶ 47.

According to Fellowes, it would have been obvious to combine Bau or Incipio with Bodkin because Bodkin teaches that the disclosure is not limited to clamshell phones, but may be used for other hand-held electronic devices. Pet. 20 and 24.

Based upon the present record, we agree. That is, based on the record before us, there is a reasonable likelihood that it would have been obvious to the ordinary artisan, in view of the combined teachings of Bodkin and Bau or Incipio, to make either the two-piece case of Bau or Incipio by co-molding as taught by Bodkin to produce a one-piece case, because Bodkin teaches that one can use co-molding to combine properties of materials in a case for a personal electronic device. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Speck contends that Fellowes is relying on improper hindsight in combining Bodkin with Bau or Incipio, because Bodkin is directed to a cover for a clamshell flip phone, which is a very different structure than that claimed by the ’561 patent. Prelim. Resp. 8. Speck argues that the statement in Bodkin that it can be applied to electronic devices other than a clamshell phone “is so open ended as to be meaningless.” *Id.* at 21. According to Speck, the devices of Bau and Incipio “must be formed as a two-piece construction,” and it is only the disclosure of the

'561 patent that provides a reason for combining the references. *Id.* at 22. Speck asserts that there is nothing in the references that would provide a reasonable expectation that combining the references would result in a “successful device.” *Id.* at 8-9. Speck further contends that there is no evidence in Bau that the ordinary artisan would have understood that the rubber glove and hard case of either Bau or Incipio could be connected to one another, such as by co-molding or use of an adhesive, before placing the case on the phone. *Id.* at 24.

We have considered Speck’s arguments, but based on the current record, determine that there is a reasonable likelihood that Fellowes will succeed in demonstrating the unpatentability of the challenged claims. Fellowes provides evidence, in the form of Bodkin, that the use of co-molding to combine two materials that have different properties was known to the ordinary artisan. We also are persuaded, based on the record before us, that Bodkin provides a reasonable expectation of success in co-molding the cases of Bau or Bodkin by disclosing that co-molding allows for the part being manufactured to incorporate easily different properties, colors, textures, shapes, or other characteristics, while still allowing for efficient construction. Bodkin, ¶ 56. Thus, contrary to Speck’s assertion that Fellowes’ challenge is based on improper hindsight, it appears to be based on a combination of known elements using known methods to achieve predictable results. *See KSR*, 550 U.S. at 398.

Speck contends that Bau teaches away from the limitations of dependent claims 4, 6, 14, and 15. Prelim. Resp. 25. Those claims require that the hard outer shell be cut away at the corners. *Id.* According to Speck, Bau “explicitly teaches that the corners of its hard plastic case layer *should not be cut away.*” *Id.* Moreover, Speck asserts, Bodkin also would have led away from cutting away the

hard case at the corners, as Bodkin teaches the use of a material at the corners that would protect the device from impact. *Id.* at 27.

Under the proper legal standard, a reference will teach away when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of applicant's invention. "A statement that a particular combination is not a preferred embodiment does not teach away absent clear discouragement of that combination." *Syntex (USA) LLC v. Apotex, Inc.*, 407 F.3d 1371, 1380 (Fed. Cir. 2005) (citations deleted). Bodkin provides evidence that the advantages and disadvantages of having a protective material at the corners were known to the ordinary artisan. Moreover, Bodkin teaches adding a protective material to the corner by co-molding, and shows the ordinary artisan would have understood that by forming the case of Bau or Incipio by co-molding, even if the hard shell were not at the corners, the device still would be protected by the softer inner layer.

As to Incipio, Speck contends that the device is fixed within the hard case by the rubber expanding sufficiently to lock within the clear shell, and thus teaches "an entirely different way to fix a device within a case." Prelim. Resp. 30. As noted above, however, Bodkin provides evidence that the use of co-molding to provide for a part that combines different properties was known to the ordinary artisan. *See KSR*, 550 U.S. at 418 (noting that "a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.").

Fellowes, therefore, has demonstrated a reasonable likelihood that it will prevail in its challenge of claims 1-16 being rendered obvious by the combination of Bodkin and Bau or the combination of Bodkin and Horowitz-Incipio.

C. Anticipation by Bodkin

Fellowes contends that claims 1-16 are anticipated under 35 U.S.C. § 102(b) by Bodkin. Pet. 16. Fellowes asserts that Bodkin discloses a one-piece case that includes a flexible inner layer co-molded with an exterior hard layer, citing sheets of material 8 and 9. *Id.* (citing Ex. Bodkin, ¶¶ 8 and 70). As Fellowes acknowledges, however, Bodkin more precisely teaches that the inner sheet layer 9, which forms the inside of the pocket, is joined at the perimeter to the exterior sheet layer 8, which forms the outside of the pocket. *Id.* at 17 (citing Bodkin, ¶¶ 70 and 74). That is, there is insufficient evidence to persuade us that the inner sheet layer 9 is co-molded with exterior sheet layer 8.

We, thus, agree with Speck that Fellowes has not established a reasonable likelihood of proving that Bodkin anticipates independent claim 1 of the '561 patent, which requires a flexible inner layer that has been co-molded with an exterior hard layer. *See* Prelim. Resp. 11-14.

D. Other Challenges

As to the other challenges asserted by Fellowes, those asserted grounds are redundant in light of the determination that there is a reasonable likelihood that all of the challenged claims are unpatentable on the challenges as set forth above. Accordingly, we decline to institute *inter partes* review of the challenged claims based on grounds other than those set forth above.

In addition, at this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim.

III. CONCLUSION

For the forgoing reasons, we determine that, based on the petition, there is a reasonable likelihood that Fellowes will prevail on its challenge that claims 1-16 of the '561 patent are rendered obvious by the combination of Bodkin and Bau or Horowitz-Incipio.

IV. ORDER

It is therefore

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted for the following grounds of unpatentability:

Claims 1-16 are rendered obvious under 35 U.S.C. § 103 by the combination of Bodkin and Bau or Horowitz-Incipio.

FURTHER ORDERED that no other ground is authorized for *inter partes* review;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial commencing on the entry date of this decision; and

FURTHER ORDERED that an initial conference call with the Board is scheduled for **October 16, 2013, at 1:00pm (ET)**; the parties are directed to the *Office Trial Practice Guide*, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012), for guidance in preparing for the initial conference call, and should come prepared to discuss any proposed changes to the Scheduling Order entered herewith and any motions the parties anticipate filing during the trial.

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