

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FELLOWES, INC.,

Petitioner,

v.

TREEFROG DEVELOPMENTS, INC.,

Patent Owner.

IPR2020-00869

Patent 8,531,834 B2

Before GRACE KARAFFA OBERMANN, GEORGIANNA W. BRADEN,
and KEVIN C. TROCK, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review

35 U.S.C. § 314

I. INTRODUCTION

Fellowes, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of Claim 28 of U.S. Patent No. 8,531,834 B2 (Ex. 1001, “the ’834 Patent”). Treefrog Developments, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 10 (“Prelim. Resp.”). With Board preauthorization (Paper 14; Ex. 3001), Petitioner filed a Reply (Paper 12) and Patent Owner filed a Sur-reply (Paper 13) limited to addressing claim preclusion arguments raised in the Preliminary Response.

II. DISCUSSION

A. Petitioner Advances an Incorrect Construction of Claim 28

Claim 28 is the only challenged claim. Pet. 1. Petitioner bears “the burden from the onset to show with particularity why” Claim 28 “is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). As part of that burden, Petitioner must identify “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). For reasons that follow, we find that Petitioner advances an incorrect construction of Claim 28 and, therefore, is not reasonably likely to prevail at trial in showing that the claim is unpatentable. 35 U.S.C. § 314(a) (articulating the threshold showing required to support institution of an *inter partes* review).

Claim 28 is directed to a protective encasement for a mobile computing device that has a multi-touch display. Ex. 1001, 116:18–44. The protective encasement includes “a top member” having (1) “a frame defining an outer perimeter of the top member” and “having an inside edge defining an inner perimeter to frame the multi-touch display”; and (2) “a protrusion that extends down from an inner surface of the top member inside of the perimeter of the frame, the protrusion having a first latching mechanism.”

Id. The protective encasement also includes “a bottom member” having “a channel formed between” the outer and inner walls of that member. *Id.*

Petitioner advances a construction for the protrusion limitation that subverts the plain words of Claim 28. Pet. 15–18. That construction is based on the argument that Figure 4n from the ’834 patent “shows an embodiment with a protrusion 30 *like that claimed*,” which “forms a portion of the outer perimeter of the” top member of the protective encasement. *Id.* at 15 (emphasis added). We reproduce Figure 4n below.

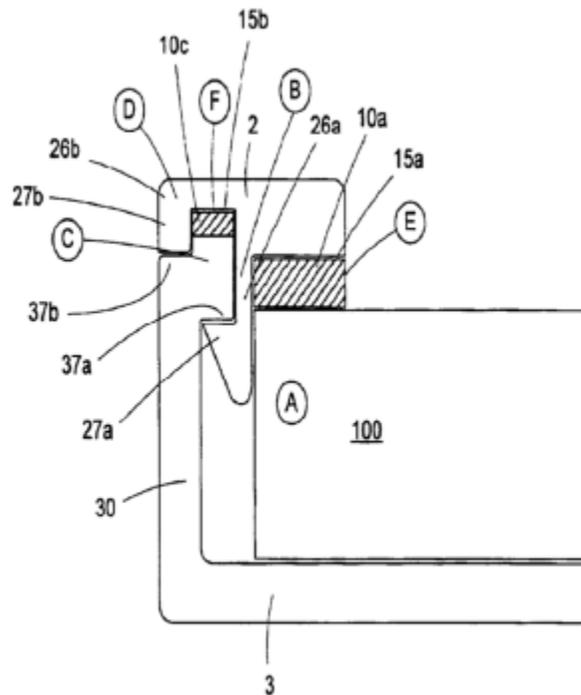


FIGURE 4n

Pet. 15. Figure 4n is a perspective view of a clasp mechanism of a protective housing, including a cross-sectional view of the clasp mechanism. Ex. 1001, 21:22–24. In contrast to Petitioner’s argument, Figure 4n illustrates, among other features, “the bottom perimeter portion 30 of the bottom member 3” (*id.* at 28:29–30) and “top member 2,” which

includes “channel 10c” (*id.* at 47:43, 47:60). The figure also illustrates the placement of “electronic device 100.”

Petitioner, without explanation, renames “bottom perimeter portion 30” as “protrusion 30.” Pet. 15–16 (bridging sentence). Next, Petitioner observes, “protrusion 30 is depicted in Figure 4n as being part of the bottom member, and channel 10c is part of the top member.” *Id.* at 16. But Claim 28 specifies “a protrusion” that is part of the “top member” and “a channel” that is part of the “bottom member.” Ex. 1001, 116:29–30, 116:33–40.

Petitioner avers that “a person having ordinary skill in the art would immediately envision the same configuration in which the protrusion 30 were part of the top member and channel 10c were part of the bottom member.” Pet. 16 (citing Ex. 1010 ¶ 23 (Dr. Garris’s declaration testimony)). That view is not supported adequately by the record. Petitioner directs us to Dr. Garris’s declaration, which repeats conclusory statements set forth in the Petition, and identifies disclosures that in no way suggest element 30 is a protrusion within the meaning of Claim 28. Ex. 1010 ¶ 23 (citing Ex. 1001, 3:66–4:3, 4:31–40, 6:30–42, 8:31–37); *see* Pet. 15 (advancing those same disclosures).

We discern in Petitioner’s argument an attempt to elevate extrinsic evidence (namely, Dr. Garris’s opinion testimony) over the express language of Claim 28, which unequivocally specifies “a protrusion that extends down from an inner surface of the top member inside of the outer perimeter of” a “frame” (which also is part of the top member) having “an inside edge defining an inner perimeter to frame the multi-touch display.” Ex. 1001, 116:23–26, 116: 29–31. Petitioner does not explain why an ordinarily skilled artisan would focus on relocating “the bottom perimeter portion 30 of the

bottom member 3” (*id.* at 28:29–30) without relocating the entirety of bottom member 3. Pet. 14–18. In practical effect, Petitioner asks us to accept that bottom member 3 and top member 2 would have been recognized as interchangeable. *Id.* But swapping one for the other would render inaccessible the multi-touch display located on the top-facing surface of electronic device 100. *See* Ex. 1001, Fig. 4n, 116:23, 116:26 (electronic device 100 includes a “multi-touch display” and the “top member” includes “a frame” that permits access to that display).

We are directed to no evidence that an ordinarily skilled artisan would have had a reason to insert electronic device 100 face down into the encasement, with the multi-touch display oriented toward bottom member 3, rendering the display inaccessible to a user. On this record, we agree with Patent Owner that Petitioner seeks “to redraft the express limitations of” Claim 28 (Prelim. Resp. 17) by redefining the “top member” and “bottom member” as interchangeable, even though the words of the claim define those members as having different orientations and distinctly different features. Ex. 1001, 116:18–44.

Consequently, we find Petitioner does not show sufficiently that Figure 4n illustrates “a protrusion that extends down from an inner surface of the top member inside of the outer perimeter of the frame” as specified in Claim 28. *Id.* at 116:29–31. Quite the opposite, Figure 4n depicts element 30 as forming the “outer perimeter” of bottom member 3. Pet. 18 (Petitioner’s own annotated version of Figure 4n). We agree with Patent Owner that the protrusion limitation of Claim 28 cannot reasonably be construed to embrace “the outer wall, i.e. peripheral portion 30” of Figure 4n, or be read so broadly as to consider element 30 in Figure 4n a protrusion that extends

down from a top member. Prelim. Resp. 17. In reality, element 30 extends up (not down) from the bottom (not top) member in Figure 4n. *Id.* Petitioner advances a construction that renders meaningless express terms in Claim 28 (including the terms “top member” and “bottom member”). *Id.*

In reaching our decision, we take account of Patent Owner’s admission that, to overcome a prior art rejection during patent prosecution and secure issuance of Claim 28, Patent Owner disclaimed all embodiments in which the protrusion can “form a part of the outer perimeter of the top member, and can also provide the first latching mechanism.” *Id.* at 18 (citing Ex. 1002, 680–681, 686 (relevant portions of the prosecution history)). The challenge stated in the Petition is based on a construction that impermissibly recaptures such an embodiment. *See* Pet. 14–18 (Petitioner’s proposed claim construction), 40–41 (claim chart), 47–48 (arguing that the “protrusion” specified in Claim 28 “can form part of the ‘outer perimeter’” of the top member and can “itself” serve as “the ‘first latching mechanism’”). Accordingly, we *deny* the Petition and decline to institute review.

B. Other Arguments

The above issue is dispositive. We do not reach any other arguments, including those pertaining to claim preclusion or discretionary denial under 35 U.S.C. § 325(d). Prelim. Resp. 32–36, 69–79.

III. CONCLUSION

For the above reasons, we *deny* the Petition and do not institute an *inter partes* review. 35 U.S.C. § 315(a)(1).

IV. ORDER

It is

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

PETITIONER:

Bryan P. Collins

Patrick A. Doody

William P. Atkins

Henry Fildes

PILLSBURY WINTHROP SHAW PITTMAN LLP

bryan.collins@pillsburylaw.com

patrick.doody@pillsburylaw.com

william.atkins@pillsburylaw.com

henry.fildes@pillsburylaw.com

PATENT OWNER:

Andrew J. Lagatta

MERCHANT & GOULD P.C.

alagatta@merchantgould.com