

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACCO BRANDS CORPORATION	:	
and ACCO BRANDS USA LLC,	:	
	:	<i>Inter Partes Review</i>
<i>Petitioners,</i>	:	
	:	Proceedings No. IPR2015-01167
v.	:	
	:	U.S. Patent No. 8,717,758
THINK PRODUCTS, INC.,	:	
	:	
<i>Patent Owner.</i>	:	

**PATENT OWNER THINK PRODUCTS, INC.'S
PRELIMINARY STATEMENT, PURSUANT TO 37 C.F.R. §42.107**

Patent Owner, Think Products, Inc. ("Think Products"), hereby respectfully files this *Preliminary Statement* in reply to the *Petition for Inter Partes Review*, filed May 6, 2015, by ACCO Brands Corporation and ACCO Brands USA LLC (collectively "ACCO"), setting forth the reasons why no *Inter Partes Review* should be instituted and the *Petition* (or Request) filed by ACCO denied.

I. ACCO's Proposed Combinations of McDaid *et al.*, Taken in View of Secondly-Applied Prior Art Fails to Render As Obvious Claims 1-7, 9-14 and 16

ACCO's *Petition* (Section III. at 2-3) asserts the following combinations of prior art alleged to render Claims 1-7, 9-14 and 16 of U.S. Patent No. 8,717,758 as obvious and

therefore invalid:

1. Claims 1-7, 9-14 and 16 are obvious, pursuant to 35 U.S.C. §103, over McDaid *et al.*, U.S. Patent No. 6,360,405, taken in view of Chen, U.S. Patent No. 5,829,280;

2. Claims 1-7, 9-14 and 16 are obvious, pursuant to 35 U.S.C. §103, over McDaid *et al.*, U.S. Patent No. 6,360,405, taken in view of Cheng, U.S. Patent No. 5,447,045; and,

3. Claims 1-7, 9-14 and 16 are obvious, pursuant to 35 U.S.C. §103, over McDaid *et al.*, U.S. Patent No. 6,360,405, taken in view of Lee, U.S. Patent No. 7,073,358.

It is ACCO's contention (*Petition* at 38-39) that the primarily-applied reference of McDaid *et al.* discloses all claim limitations recited in Claims 1-7, 9-14 and 16 "except the activation of the locking mechanism by insertion of the captive security rod [and that] McDaid discloses a locking assembly activated by a key." More particularly, ACCO asserts McDaid teaches the claimed invention, but for activation of the locking head (104) in McDaid by insertion of a captive security rod, or anchor (20), and that each of the applied secondary prior art citations, namely, Chen, Cheng and Lee, each disclose cable lock assemblies that teach activation of their respective locking mechanisms by insertion of a captive security rod, thereby teaching the limitation absent from McDaid. ACCO essentially concludes that combining (or substituting) each of the "activation"-type locking mechanisms of the secondarily-applied references with McDaid would yield that recited in Claim 1-7, 9-14 and 16, thereby rendering the enumerated claims of Think

Products' patent obvious. While ACCO's obviousness argument has simplicity, it is technically and legally incorrect.

A. McDaid et al. "Teaches Against" the Proposed Combination with Chen

ACCO (*Petition* at 45-46) secondarily seeks to apply Chen for its disclosure (at Col. 5, lines 49-57) reciting a "locking device" in which "the user can manually insert the locking head **64** of the cable **60** into the head hole **12** in the main body **10** [so that] the locking head **64** is locked into the locking device" and the user does not need to "use the key of the locking device" to actuate the lock. According to ACCO, this teaching in Chen discloses the limitation of actuating the lock via insertion of a captive security rod, which ACCO admits to be absent from McDaid, and when Chen is combined with McDaid as ACCO proposes, supposedly renders obvious Claims 1-7, 9-14 and 16.

McDaid *et al.* discloses a security anchor/tether assemblage for portable articles, which expressly teaches (at Col. 6, lines 20-28) that the locking head (104) should not be rotatable relative to the anchor (20), which may be analogized to a captive security rod. McDaid explains that rotation as between the locking head (104) and the anchor (20) should be prevented to avoid "stresses on the relatively small anchor **20** caused by moving the portable article **10** while the tether **102** remains attached to the stationary fixture **6**" (*see*, McDaid *et al.* at Col. 6, lines 22-28) and suggests the external member skirt (64) with a series of valleys (66) and peaks (68) for preventing undesirable rotation.

Chen, in stark contrast to McDaid *et al.*, states it is an "objective of the present invention to provide a cable locking device . . . which allows the two ends of the cable to

be freely rotatable when the cable is in locked state, allowing the user to easily and conveniently handle the locking device.” (See, Chen at Col. 1, line 66 – Col. 2, line 3)

McDaid *et al.* expressly states that rotation should be avoided to prevent unwanted “stresses on the relatively small anchor” (Col. 6, lines 20-28), while Chen deems it beneficial to have the two ends of the cable locking device to be “freely rotatable when the cable is in locked state” (Col. 1, line 66-Col. 2, line 3). Chen thereby advocates doing precisely that which McDaid *et al.* strongly urges be avoided. See, e.g., *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)(“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”); citing *In re Caldwell*, 319 F.2d 254, 256 (C.C.P.A. 1963) (reference teaches away if it leaves the impression that the product would not have the property sought by the applicant).

Notwithstanding the impropriety of the combination of McDaid *et al.*, taken in view of Chen, as explained, the skilled artisan would not have looked to Chen to modify McDaid *et al.*, because assuming, *arguendo*, that the locking bar, or locking head (64), in Chen was capable of being “inserted” into the locking head of McDaid *et al.* (*i.e.*, the locking head of Chen would be compatible with structure of McDaid *et al.*, as best illustrated in FIG. 8) and could, in theory, effect a locking, McDaid *et al.* would not be operable as disclosed.

More particularly, McDaid *et al.* discloses that inside the housing (122) is a cup (126) that fits closely over the knob (60) when the tether (102) is engaged with the anchor

(20). Cup (126) has a plurality of apertures (138) into which fit ball bearings (140). In the inside surface (142) of the housing (122), and aligned with the apertures (138) are grooves (144), as illustrated in FIG. 9, wherein each groove (144) ramps circumferentially into the inner surface (142) to a wall (148). In the unlocked position, the ball bearings (140) reside within the deeper section (150) of the grooves (144) at wall (148). As the cup (126) is rotated to a locked state (via cylinder (128)), the groove bottom (152) pushes the ball bearing (140) securely into the annular groove (62) of the knob (60) and the cylinder (128) rotates within the barrel (130). The cylinder (128) includes a keyway (156) into which a key (158) is inserted, where rotating the key (158) also causes the cylinder (128) to rotate between the locked state and unlocked state. (*See, McDaid et al.* at Col. 7, lines 31-41.)

Consequently, the locking operation disclosed in McDaid *et al.* is described as a two-step procedure:

1. The locking head (104) is installed on the anchor (20) by inserting the key (158) into the keyway (156) and rotating the cylinder (128) until the ball bearings (140) can retract into the cup apertures (138); and,
2. Then the locking head (104) is placed on the anchor (20) and the key (158) is rotated back to the closed position, securing the ball bearings (140) in the knob annular groove (62). The tether (102) is removed by the reverse operation.

Where a proposed modification or combination of the prior art would change the principle of operation of the prior art apparatus being modified, then the teachings of the

references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (C.C.P.A. 1959). This is particularly pertinent when it comes to the analysis of independent Claim 1, which requires a locking device with a locking mechanism, wherein the locking device is configured with an opening to receive the locking end of the captive security rod to activate the locking mechanism, where the activation causes the locking mechanism to securely grasp the locking end and thereby lock the security rod and portable electronic device to the locking device.

B. The Proposed Combination of McDaid et al., Taken in View of Cheng, is Inapposite Because Cheng Fails to Disclose a “Captive Security Rod”

ACCO (*Petition* at 47-48) secondarily seeks to apply Cheng (at Col. 1, line 64 – Col. 12; FIGS. 1-3) for its disclosure of a padlock (21) that, according to ACCO, it would be known to those of ordinary skill in the art “that padlocks are generally locked by inserting the shackle of the lock into the locking mechanism without need of a key” and that the person of ordinary skill in the art would know “that an automatic lock mechanism such as the padlock disclosed in Cheng has an advantage over key-activated lock mechanisms [because such] automatic mechanisms are easier to use and more convenient tha[n] those requiring a key.” (*Petition* at 48) ACCO therefore concludes, in essence, that a segment of the “shackle” in Cheng is to be analogized to the “captive security rod” recited in the claims of Think Products’ patent, thereby disclosing the locking activation upon insertion which, when combined with McDaid *et al.*, would yield (and render obvious) Claims 1-7, 9-14 and 16 of U.S. Patent No. 8,717,758.

Responsive to ACCO's contention of obviousness based upon the application of *McDaid et al.*, taken in view of Cheng, while it is the case that independent Claims 1 and 16 of Think Products' patent (and all remaining claims via dependency) recite a "captive security rod" that activates the "locking mechanism" of a locking device upon insertion, the secondarily-applied reference of Cheng fails to disclose a "captive security rod." Instead, Cheng shows and describes a padlock (21) having a U-shaped shackle (211). ACCO evidently seeks to analogize only the immediate axial segment of the shackle relative to the insertion hole for the shackle (211) in the locking mechanism in Cheng to the "captive security rod" recited in Think Products' claims. To do so, ACCO must impermissibly "sever" or ignore roughly two-thirds of the shackle (211) in Cheng, selecting only that portion of one structural feature of Cheng, while discounting the larger portion of the shackle that fails to comport with its contention in support of obviousness. *See, In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986) ("It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.")

The "ordinary and customary meaning" of a "rod," *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) ("Generally speaking, we indulge a 'heavy presumption' that a claim term carries its ordinary and customary meaning."), is generally understood as being "a straight, slender stick of wood, metal, or other material," as recited in *The Random House Dictionary*, page 764 (published August 1990) ("Exhibit 1"). Independent method Claim 16 of Think Products' patent further provides that the captive security rod is "formed with an anchoring end separated axially

by a protruding end,” which is consistent with the understood and recognized definition of a “rod.” The shackle (211) in Cheng is not a “rod” and therefore not a “captive security rod.” The advantage of using a “captive security rod,” as recited in the claims of Think Products’ patent, as opposed to a shackle of the type illustrated in Cheng, is that upon “inserting the protruding end of the captive security rod into an opening in the locking device to actuate the internal locking mechanism and lock the locking device to the captive security rod” (independent method Claim 16), the orientation of the “captive security rod” vis-à-vis the “opening in the locking device” is not pertinent, since any orientation of the captive security rod relative to the “opening in the locking device” will suffice for activation of the locking mechanism upon insertion; the shackle of the padlock in Cheng must be oriented in only a single way relative the opening for the locking mechanism in the padlock (21) of Cheng to be operable for locking. It is further submitted that the captive security rod may be inserted using only a single hand of a user, as opposed to use of a padlock.

**C. The Request for an Inter Partes Review Based Upon
the Proposed Combination of McDaid et al., Taken in View of Lee, Must Be
Denied, Because the Effective Filing Date of Think Products’ Patent Antedates Lee**

The proposed combination of McDaid *et al.*, taken in view of Lee, U.S. Patent No. 7,073,358, cannot form the basis for instituting an *Inter Partes* Review because Lee, having a filing date of December 22, 2005, is subsequent to the effective filing date of U.S. Patent No. 8,717,758, which is at least as early as October 11, 2005, based upon the disclosure of U.S. Provisional Patent Application Serial No. 60/725,333 (“Exhibit 2”) with the subject matter of the foregoing provisional patent application being recited in

Think Products' subsequently filed nonprovisional patent applications for which continuing status has been claimed. The subject matter disclosed in U.S. Provisional Patent Application Serial No. 60/725,333, filed October 11, 2005, includes the following:

Page 3, lines 14-20:

“A pin lock secures the locking bar across the display screen portion of the notebook computer or other personal electronic device and into a hole in the locking base, thereby securing the notebook computer or other of personal electronic device in a locked position within the components the notebook computer or other personal electronic device lock.”

Page 20, lines 16-21:

“Figure 28 is a perspective view showing the possible locations of through-holes for use of an alternate protrusion spike embodiment security feature used with a cable;

“Figure 29 is a perspective view of the spike with a cable attached ferrule, pin lock, and secure cable clamp used to secure a notebook computer;

“Figure 30 is a schematic perspective view of a notebook computer with captive security rods for cable attachment;”

Page 32, lines 3-28:

“For example, in Figure 28, a notebook computer or other personal electronic device with base 275 and display 276 is shown. One of the

three through-holes is required for this embodiment. Hole 278 is at the hinge line, while hole 279 is through the display housing; hole 277 is diagonally through one of the front or rear corners of the base.

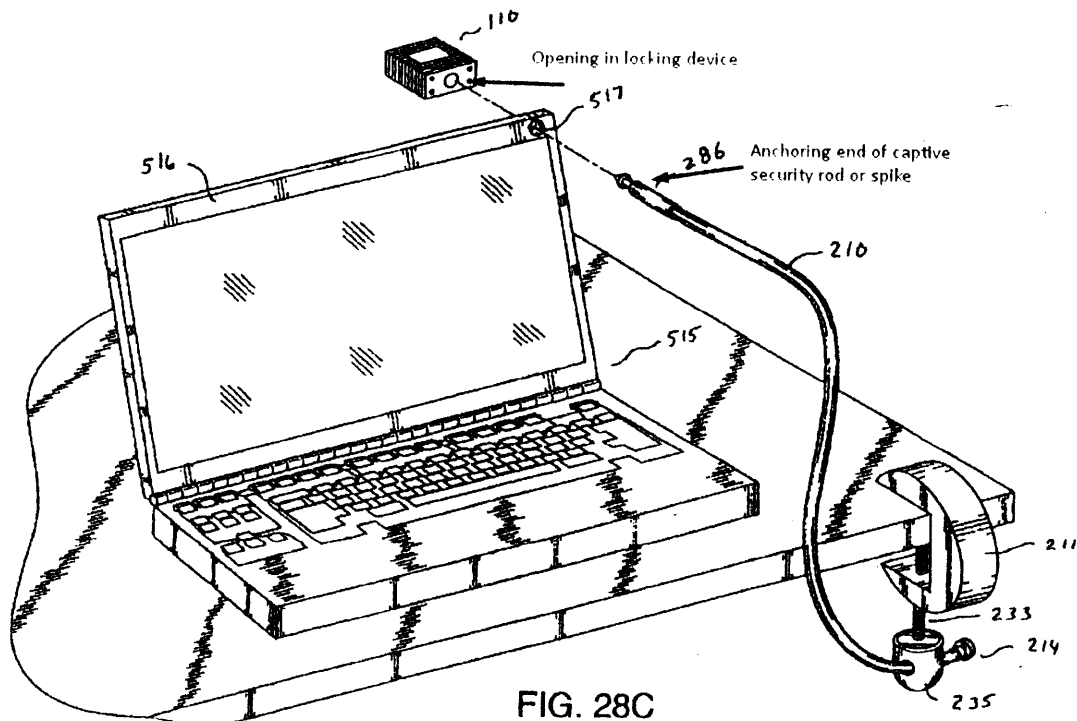
“Figure 29 shows locking rod or spike 285 which is inserted in any of the three hole locations discussed. Ferrule 286 with a groove near its distal end is then inserted through the transverse hole of spike 285 and locked with pin lock 110. Ferrule 286 is securely attached to cable 210 which had been passed through knob 235 after clamp 211 had been tightened at the edge of a table or desk top. In this manner, the illustrated notebook computer or other personal electronic device is secured via a secure cable.”

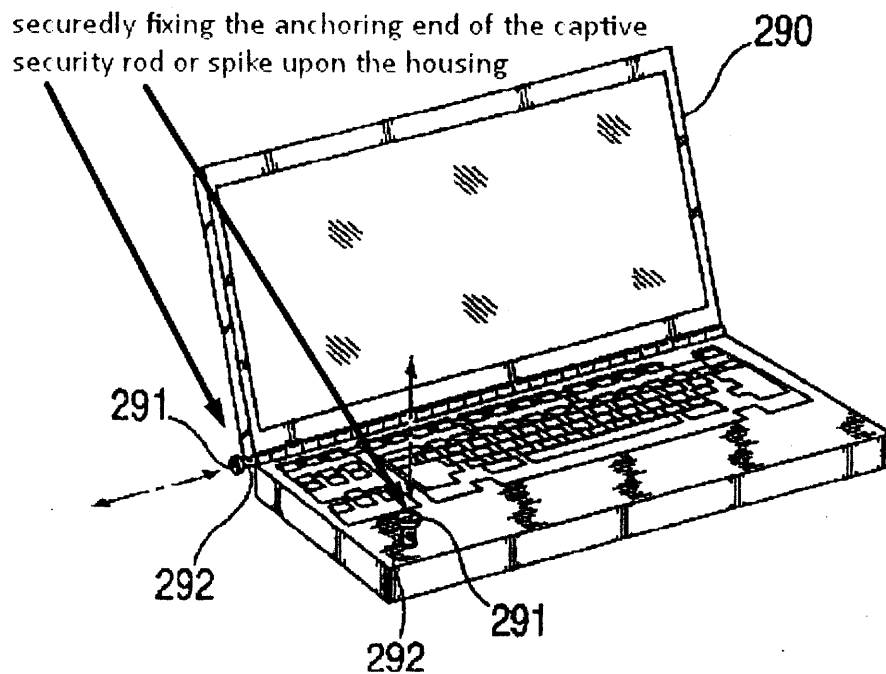
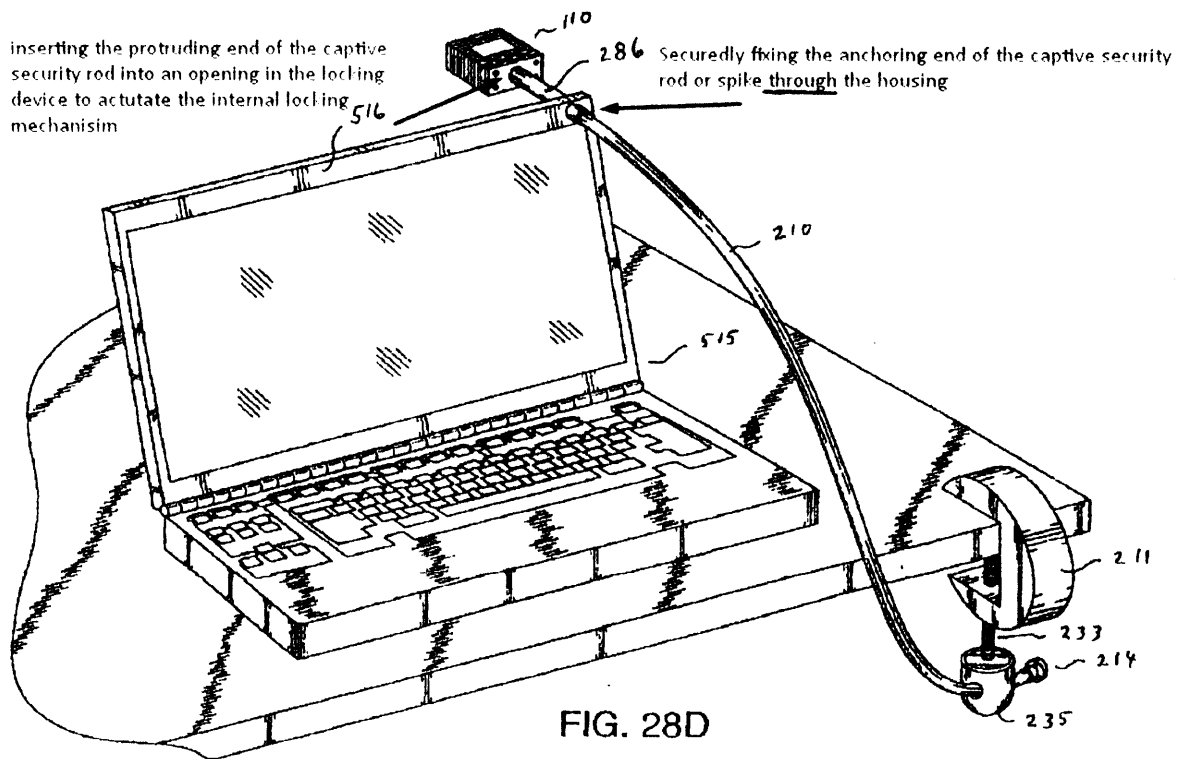
“In a variation of this embodiment, the separate spike 285 is replaced by a captive security rod 291 as shown in Figure 30. Note that rod 291 may be attached either to one end of the hinge or alternatively to the top surface of the base of computer or other personal electronic device 290 at any convenient location where space permits. Rods 291 are stored in a recessed position with only a small knob protruding so that they may be easily grasped to unlock into the extended position to expose a transverse hole. Ferrule 286 and lock 110 are then used in the same manner as with the separate spike 285.”

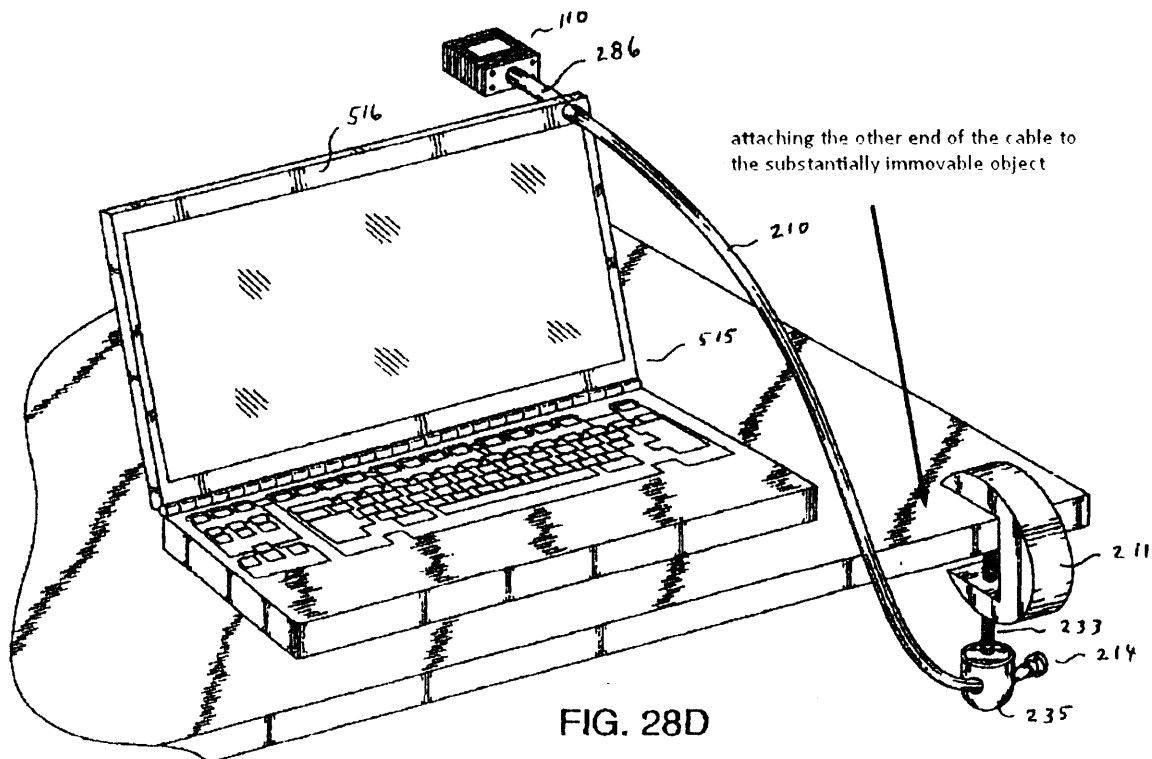
That which is disclosed (above) by U.S. Provisional Patent Application Serial No. 60/725,333 is illustrated by FIGS. 28 – 30 of the provisional patent application, which

drawing figures are substantially the same as FIGS. 28, 28A, 28B, 28C and 29 of U.S. Patent No. 8,717,758 and, with respect to FIG. 30, this drawing figure in the issued patent is identical to that shown in the foregoing provisional application. FIGS. 28A-D and 29 of U.S. Patent No. 8,717,758, and the text referencing these drawing figures at, *e.g.*, Col. 14, lines 14-22, provides, in part, that “ferrule **286** can also be used to lock notebook computer **500** in place” and that “[f]errule **286** with a groove near its distal end is then inserted through the transverse hole of spike **285** and located with pin lock **110**.”

FIGS. 28C, 28D and 30 of Think Products’ patent (with FIG. 30 being identical to this FIG. 30 of the provisional patent application) is annotated on the following pages:







“The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Yorkey v. Diab*, 605 F.3d 1297, 1303 (Fed. Cir. 2010), *quoting In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983). With virtually the same disclosure (including many of the same drawing figures), as pertinent, it is submitted to be evident that the named inventor of the subject matter now claimed in U.S. Patent No. 8,717,758 “had possession” of the subject matter claimed at least as early as the filing of U.S. Provisional Patent Application Serial No. 60/725,333 on October 11, 2005. As such, Lee, U.S. Patent No. 7,073,358, is not citable as “prior art” against the claims of U.S. Patent No. 8,717,758, and the proposed combination of McDaid *et al.*, taken in view of Lee, cannot support granting ACCO’s request for institution of an *Inter Partes* Review. See, generally *Comark Communications, Inc. v.*

Harris Corp., 156 F.3d 1182, 1186 (Fed. Cir. 1998) (cautioning against the limitation of the claimed invention to preferred or specific embodiments or examples); *Transmatic, Inc. v. Gulton Industries, Inc.*, 53 F.3d 1270, 1277 (Fed. Cir. 1995) (“[A] patent claim is not necessarily limited to a preferred embodiment disclosed in the patent.”); *SRI Int’l, Inc. v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 *n. 14* (Fed. Cir. 1985) (en banc) (“That a specification describes only one embodiment does not require that each claim be limited to that one embodiment.”)

Notwithstanding, the self-locking cable lock of Lee would not be technically relevant to that claimed in Think Products’ patent, inasmuch as Lee does not activate a locking member into which a stationary protruding rod (23), or movable protruding rods (33), are inserted, *i.e.*, there is no locking mechanism taught as being in the desired appliance that is activated upon insertion through keyhole (91). As such, the artisan of ordinary skill would not have reasonably considered Lee for utilizing either a stationary moving rod, or a plurality of movable protruding, extending out of an external sleeve (20) as a substitute for the anchor (20) in McDaid *et al.*, which has been analogized to a captive security rod.

II. The Request for an *Inter Partes* Review Based Upon the Proposed Application of the “ClickSafe Video” As “Prior Art” Against Think Products’ Patent Claims Must Be Denied, Because the Effective Filing Date of Think Products’ Patent Antedates the Alleged “Publication” of the “ClickSafe Video” (Exhibit 1013)

ACCO alleges in its *Petition* (at 32-38; 51-58) that:

1. Claims 1-7, 9-13 and 16 are anticipated by the “ClickSafe Video” as either publicly known and therefore citable as prior art under 35 U.S.C. §102(a) and/or as

constituting a “printed publication” and therefore citable as prior art under 35 U.S.C. §102(b) (pre-AIA) based upon an alleged publication date of October 12, 2010; and,

2. Claim 14 is obvious, pursuant to 35 U.S.C. §103, over the ClickSafe Video, taken in view of McDaid *et al.*

Without effecting waiver of the right to challenge the alleged “publication” of the ClickSafe Video should an *Inter Partes* Review be instituted, assuming, *arguendo*, for the purpose of this Preliminary Statement that the ClickSafe Video constitutes a “printed publication” under 35 U.S.C. §102(b), or that the content of the ClickSafe Video was otherwise publicly known and would therefore qualify as prior art under 35 U.S.C. §102(a), and that the “publication” date is, as alleged to be, October 12, 2010, this date of publication is significantly subsequent to the effective filing date of U.S. Patent No. 8,717,758 and, consequently, the proposed anticipation and obviousness rejections that seek to apply the ClickSafe Video cannot properly serve as the basis for granting ACCO’s request for instituting an *Inter Partes* Review.

III. The Offered “Expert” Testimony in Support of ACCO’s Petition for an *Inter Partes* Review Should Be Stricken/Disregarded As Unnecessary and Because ACCO’s Expert is Not the “Hypothetical” Person of Ordinary Skill

“An expert’s opinion on the ultimate legal conclusion is neither required nor indeed ‘evidence’ at all.” *Nutrition 21 v. United States*, 930 F.2d 867, 871 *n.* 2 (Fed. Cir. 1991), *citing Avia Group Int’l, Inc. v. L.A. Gear Calif., Inc.*, 853 F.2d 1557, 1564 (“an expert’s opinion on the legal conclusion of obviousness is neither necessary nor controlling”); *Soverain Software LLC v. Newegg Inc.*, 705 F.3d 1333, 1341 (Fed. Cir. 2013)

(concerning obviousness determination: “precedent does not require ‘expert’ opinions on matters of law”).

Furthermore, “[t]he issue of obviousness is determined entirely with reference to a *hypothetical* ‘person having ordinary skill in the art.’ It is only that hypothetical person who is presumed to be aware of all the pertinent prior art.” Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 454 (Fed. Cir. 1985) (emphasis in original). Ryan White, offered as an expert by ACCO (Exhibit 1021), it is safely presumed, is an actual person, not a “hypothetical” one. As such, the “relevant inquiry” is what a “hypothetical ordinarily skilled artisan” would understand from the prior art references; not what Ryan White might think or understand. See, Amazon. com, Inc. v. Barnesandnoble. com, Inc., 239 F.3d 1343, 1364 (Fed. Cir. 2001) (“Whatever Dr. Lockwood did or did not *personally* realize at the time based on his actual knowledge is irrelevant. The relevant inquiry is what a hypothetical ordinarily skilled artisan would have gleaned from the cited references at the time that the patent application leading to the '411 patent was filed.” (emphasis in original)).

The parties, their patent attorneys and the members of the Patent Trial and Appeal Board are all submitted to be quite capable of comprehending the prior art references cited by ACCO in this proceeding. The testimony of ACCO’s retained expert on the issue of obvious – an “actual” person, not the required “hypothetical” one – is neither required nor evidence in the rendition of an obviousness determination and, consequently, the offered expert testimony of Ryan White has no proper place in this proceeding and should be stricken or otherwise disregarded as not relevant.

IV. Conclusion

Accordingly, Patent Owner Think Products, Inc. respectfully requests that the *Petition for Inter Partes Review*, filed May 6, 2015, by ACCO Brands Corporation and ACCO Brands USA LLC (collectively "ACCO"), be denied and no *Inter Partes Review* of U.S. Patent No. 8,717,758 instituted.

Respectfully submitted,

THINK PRODUCTS, INC.

Dated: August 6, 2015

By 

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Enc.: Exhibits 1 & 2; Certificate of Service

CERTIFICATE OF SERVICE

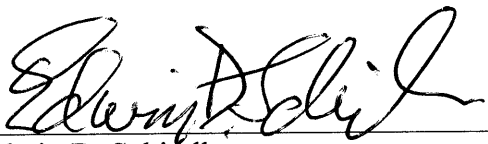
I, EDWIN D. SCHINDLER, hereby certify that I served a true and complete copy (including all exhibits) of *PATENT OWNER THINK PRODUCTS, INC.'S PRELIMINARY STATEMENT, PURSUANT TO 37 C.F.R. §42.107*, on the following counsel for Petitioners/Requesters ACCO Brands Corporation and ACCO Brands USA LLC. via e-mail (as the parties have so agreed):

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on August 6, 2015.

A handwritten signature in black ink, appearing to read 'Edwin D. Schindler', written over a horizontal line.

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Attorney for Patent Owner

Think Products, Inc.