

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACCO BRANDS CORPORATION and
ACCO BRANDS USA LLC,
Petitioner,

v.

THINK PRODUCTS, INC.,
Patent Owner.

Case IPR2015-01167
Patent 8,717,758 B2

Before RICHARD E. RICE, SCOTT A. DANIELS, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

ACCO Brands Corporation and ACCO Brands USA LLC (collectively, “Petitioner”) filed a Corrected Petition (Paper 4, “Pet.”) requesting an *inter partes* review of claims 1–7, 9–14, and 16 of US 8,717,758 B2, issued May 6, 2014 (Ex. 1001, “the ’758 Patent”). Think Products, Inc. (“Patent Owner”) filed a Patent Owner Preliminary Response. Paper 12 (“Prelim. Resp.”). Petitioner supported the Petition with a declaration from Ryan White (Ex. 1021).

We instituted a trial as to all of the challenged claims, on the following grounds:

Reference(s)	Basis	Claims Challenged
ClickSafe product video demonstrating the ClickSafe Keyed Laptop Lock (Exs. 1013 and 1014, ¹ “ClickSafe video”)	§ 102(a)	1–7, 9–13, and 16
ClickSafe video and US 6,360,405 B1 (Ex. 1008, “McDaid”)	§ 103(a)	14
McDaid and US 5,829,280 (Ex. 1009, “Chen”)	§ 103(a)	1–7, 9–14, and 16

Paper 13 (“Inst. Dec.”), 18–19, 23, 24.

After institution of the trial, Think Products, Inc. (“Patent Owner”) filed a Patent Owner Response (Paper 15, “PO Resp.”), to which Petitioner filed a Reply (Paper 20, “Pet. Reply”). Patent Owner supported the Patent Owner Response with a declaration from Robert Mahaffey (Ex. 1505), and

¹ Exhibit 1013 is a copy of the ClickSafe video; Ex. 1014 depicts still frames from the ClickSafe video, with annotations. Ex. 1015 ¶¶ 10, 11.

Petitioner supported the Reply with a supplemental declaration from Mr. White (Ex. 1024).

The parties each filed a Motion to Exclude (Papers 23, 26), an Opposition to the Motion of the other party (Papers 30, 31), and a Reply to the other party's Opposition (Papers 34, 35). Patent Owner also filed a Motion for Observation on Cross Examination of Mr. White (Paper 27), to which Petitioner filed a Response (Paper 32). Patent Owner did not move to amend any claim of the '758 Patent.

We heard oral argument on June 29, 2016. A transcript of the argument has been entered in the record (Paper 39, "Tr.").

We have jurisdiction under 35 U.S.C. § 6(b). The evidentiary standard is a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons explained below, we conclude that Petitioner has demonstrated by a preponderance of evidence that claims 1–7, 9–14, and 16 of the '758 Patent are unpatentable. We deny the parties' respective Motions to Exclude.

B. Related Matters

Petitioner identifies a federal district court case involving the '758 Patent (*Think Products, Inc. v. ACCO Brands Corp.*, Case No. 2:14-cv-06659 (E.D.N.Y.)). Pet. 1. Petitioner also identifies an *inter partes* review (Case IPR2015-01168) of U.S. Patent No. 8,837,144 B1,² which

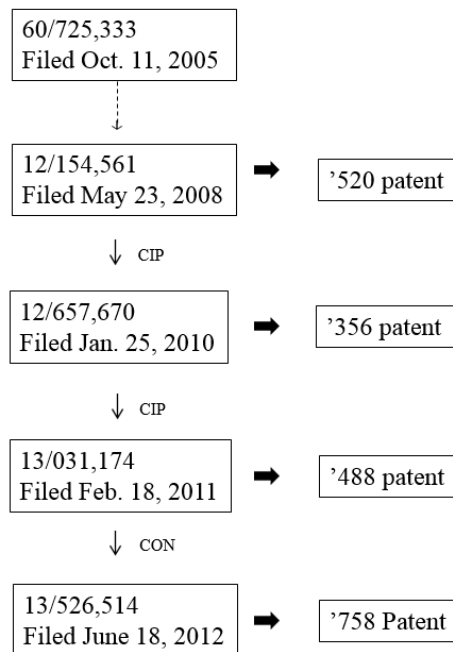
² Allen, US 8,837,144 B1, issued Sept. 16, 2014 ("the '144 Patent"). Ex. 1003.

issued from a continuation of the application that matured into the '758 Patent. *Id.*

C. The '758 Patent

The '758 Patent, titled “Locking Assembly for Electronic Tablet and Other Devices,” issued from U.S. Patent Application No. 13/526,514, filed May 5, 2014 (“the '514 Patent Application”). Ex. 1001, (21), (22), (63), (65). The '514 Patent Application is a continuation of U.S. Patent Application No. 13/031,174, filed February 18, 2011, now U.S. Patent No. 8,223,488 B2 (“the '488 Patent Application” and “the '488 Patent,” respectively). *Id.* at (63). The '488 Patent Application is a continuation-in-part of U.S. Patent Application No. 12/657,670, filed January 25, 2010, now U.S. Patent No. 8,139,356 (“the '356 Patent Application” and “the '356 Patent,” respectively). *Id.* And the '356 Patent Application is a continuation-in-part of U.S. Application No. 12/154,561, filed May 23, 2008, now Patent No. 7,724,520 (“the '520 Patent Application” and “the '520 Patent,” respectively). *Id.* The chain of priority further includes the benefit of a number of U.S. provisional applications, the earliest of which, application No. 60/725,333, (“the '333 provisional application”), was filed October 11, 2005. *Id.* at (60).

The flowchart below illustrates the pertinent relationships in graphic form:



The '758 Patent discloses a method for securing a portable electronic device to a substantially immovable object utilizing a locking assembly. *Id.* at 4:60–67. The locking assembly includes “a security rod or spike formed with an anchoring end separated axially by a protruding end, a locking device with an internal locking mechanism and a cable permanently attached to the locking device at one end.” *Id.* at 4:63–67. The method involves the steps of

securely fixing the anchoring end of the *security rod or spike* to the portable electronic device upon or through the housing, attaching an other end of the cable to the substantially immovable object and inserting the protruding end of *the 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*.

Id. at 4:67–5:7. Accordingly, the anchoring end of the security rod anchors the security rod to the housing of the portable electronic device, leaving the protruding end of the, now captive, security rod available for insertion into

the locking device. *Id.*; *see also id.* at 1:22–25 (“The locking assembly also includes means for securing the locking device and, therefore, *the captive security rod and portable electronic device to which the captive security rod is anchored*, to a substantially non-movable object.” (emphasis added)); *id.* at 6:20–22 (“said captive security rod is *fixedly inserted* through a surface of said [] housing” (emphasis added)).

The 758 Patent also discloses a locking assembly comprising a *captive security rod* and a *locking device*:

[T]he invention includes a locking assembly for securing a portable electronic device having at least one housing to a substantially immovable object. The locking assembly includes *a captive security rod* having a locking end and an anchoring end, wherein the anchoring end is passed through the at least one housing to anchor the captive security rod thereto and *a locking device* with a locking mechanism, wherein *the locking device is configured to receive the locking end of the captive security rod to activate the locking mechanism* and thereby lock the security rod and portable electronic device to the locking device.

Id. at 5:10–21 (emphases added). As described, the locking end of the captive security rod is received in the locking device to activate a locking mechanism of the locking device and thereby lock the security rod to the locking device. *Id.*

The ’758 Patent discloses several embodiments that involve securing a portable electronic device to a securing structure such as a table leg or a work surface upon which the portable electronic device is placed. *See, e.g., id.* at 6:33–36, 14:4–13.

Figures 28 and 29 of the '758 Patent are reproduced below:

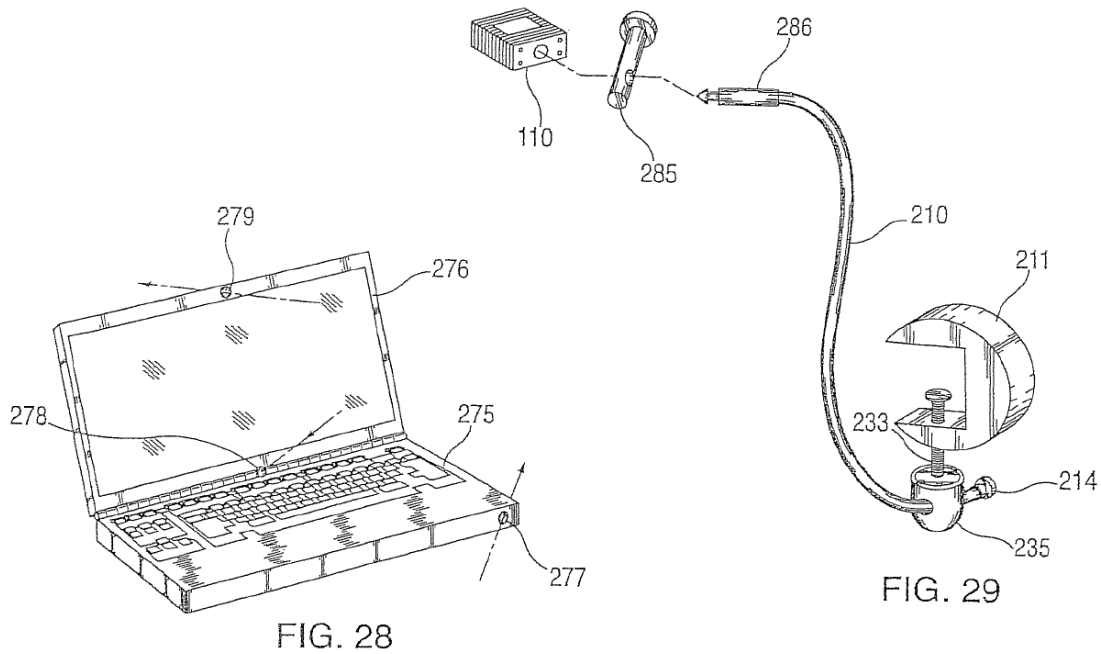


Figure 28 is a perspective view showing the possible locations of through-holes for use in securing a personal electronic device to a cable (hole 278 is at the hinge line, hole 279 is through the display housing, and hole 277 is diagonally through one of the front or rear corners of the base). *Id.* at 7:60–62, 13:52–57. Figure 29 is a perspective view of cable 210, locking rod or spike 285, ferrule 286, pin lock 285, and clamp 211. *Id.* at 8:10–12, 14:19–27. In use, locking rod or spike 285 is inserted in one of the three holes shown in Figure 28, and ferrule 286 is then inserted through the transverse hole³ of locking rod or spike 285 and locked with pin lock 110. *Id.* at 14:19–22. As shown in Figure 29, pin lock 110 receives the distal end of ferrule 286; pin lock 110 does not receive locking rod or spike 285.

³ The hole is shown (but not identified by a number) in Figure 29.

In another embodiment, “the *separate spike 285* is replaced by a *captive security rod 291* as shown in FIG. 30.” *Id.* at 14:28–29 (emphasis added). Figure 30 of the ’758 Patent is reproduced below:

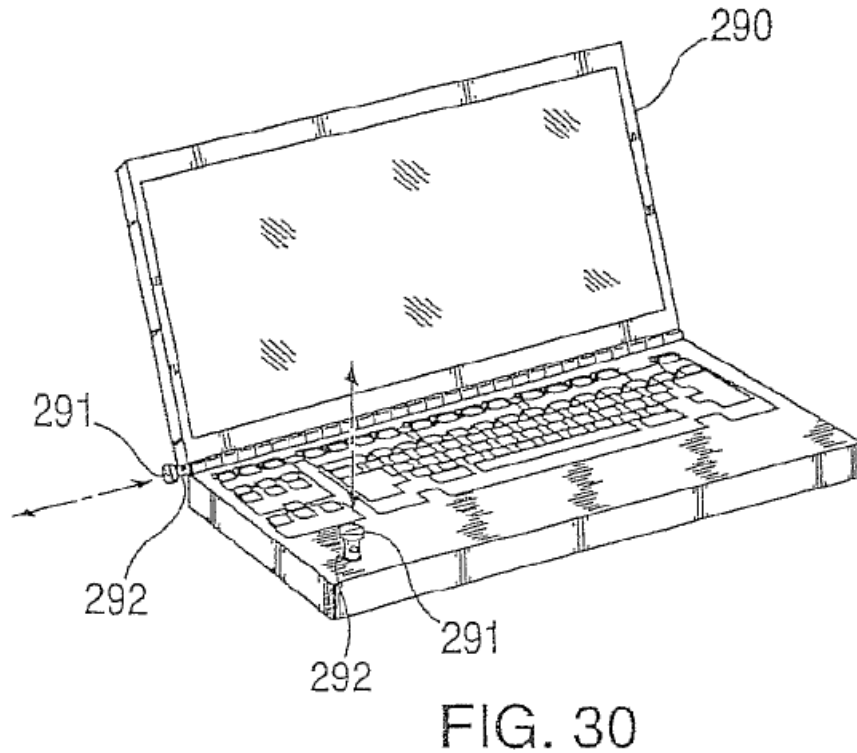
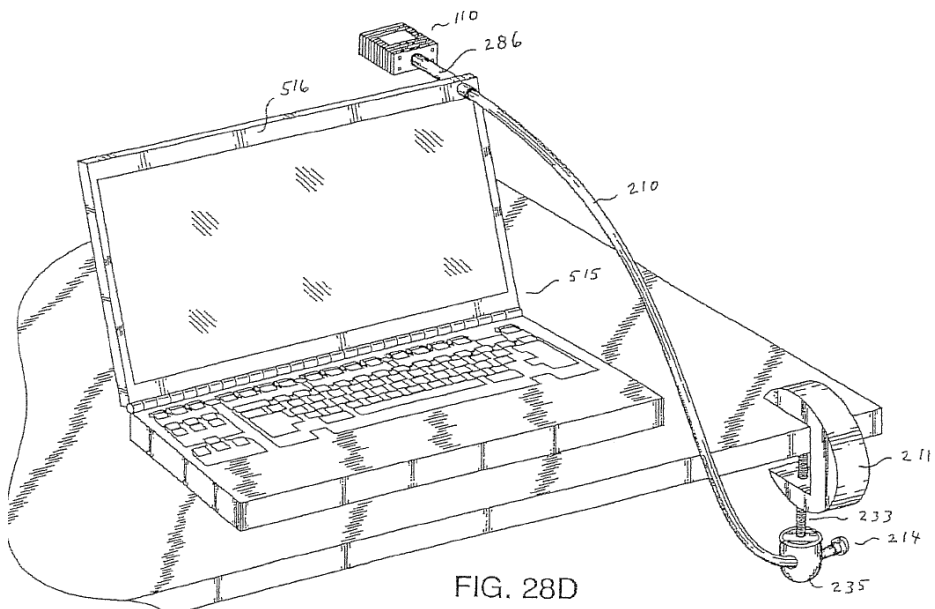
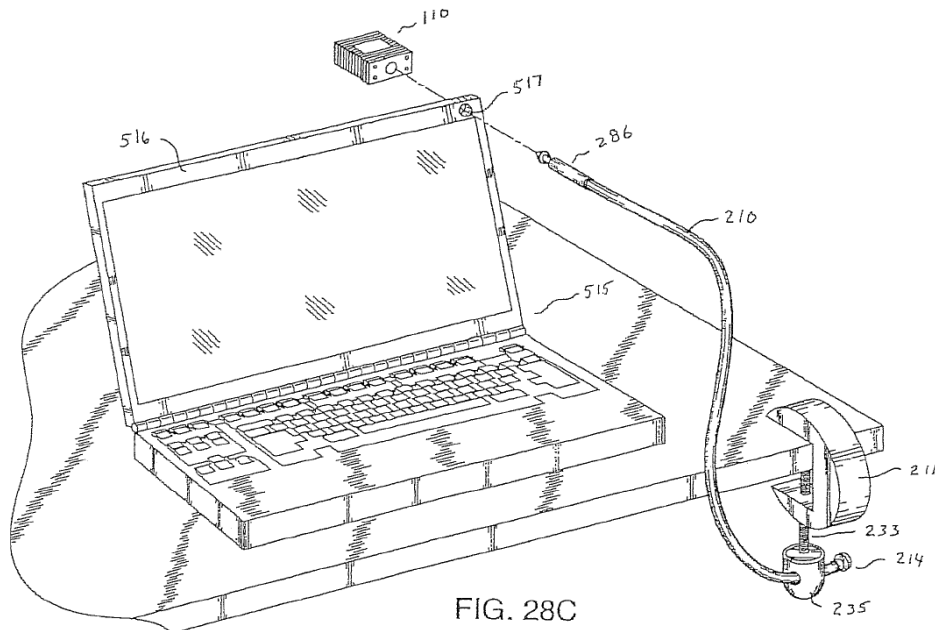


Figure 30 is a perspective view of a notebook computer with two captive security rods 291 for cable attachment. *Id.* at 8:13–14. “Rods 291 are stored in a recessed position with only a small knob protruding so that they may be easily grasped to unlock into the extended position to expose a transverse hole.” *Id.* at 14:33–36. In use, the captive security rod is extended to expose a transverse hole (shown in Figure 30), and “[f]errule 286 and lock 110 are then used in the same manner *as with the separate spike 285*.” *Id.* at 14:36–37 (emphasis added). Thus, in the embodiment depicted in Figure 30, pin lock 110 receives the distal end of ferrule 286; pin lock 110 does not receive captive security rod 291.

Figures 28C and 28D of the '758 Patent are reproduced below:



Figures 28C and 28D depict notebook computer 515 having security hole 517 in the upper right corner, and “illustrate how the apparatus of FIG. 29 (without spike 285) is used to secure computer 515.” *Id.* at 8:1–9,

14:4–13. As shown in the figures, “[f]errule 286 is passed through hole 517 and locked by pin lock 110.” *Id.* at 14:9–10.

D. Illustrative Claims

Claims 1 and 16 are independent. Claims 2–7, and 9–14 depend, directly or indirectly, from claim 1. Claim 1 is illustrative:

1. A locking assembly for securing a portable electronic device having at least one housing to a substantially immovable object, the locking assembly comprising:

a captive security rod having a locking end and an anchoring end, wherein the anchoring end is passed through the at least one housing to anchor the captive security rod thereto;

said captive security rod partially in said at least one housing and partially out of said at least one housing during and before locking use; and

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.

Id. at 19:18–34.

II. ANALYSIS

A. Level of Skill in the Art

Petitioner contends that a person of ordinary skill in the art (“POSA”) would have had at least an undergraduate degree in industrial design or mechanical engineering, and about two years of experience designing

locking devices for portable electronic equipment such as laptop computers, or equivalent experience. Pet. 3–4 (citing Ex. 1021 ¶¶ 13, 14). Patent Owner’s declarant, Mr. Mahaffey, agrees. Ex. 1505 ¶ 14. On this record, we determine that a POSA would have had at least an undergraduate degree in industrial design or mechanical engineering, and about two years of experience designing locking devices for portable electronic equipment such as laptop computers, or equivalent experience.

B. Claim Construction

In an *inter partes* review, the Board gives claim terms in an unexpired patent their broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under that standard, a claim term generally is given its ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). While our claim interpretation cannot be divorced from the specification and the record evidence, *see Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) (quoting *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011)), we must be careful not to import limitations from the specification that are not part of the claim language. *See SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

1. “*captive security rod*”

Claim 1 recites, *inter alia*,

a *captive security rod* having a locking end and an anchoring end, wherein the anchoring end is passed through the at least one housing to anchor the captive security rod thereto; said captive security rod partially in said at least one housing and partially out of said at least one housing during and before locking use

Ex. 1001, 19:21–27 (emphasis added). In our Institution Decision, we preliminarily determined that the broadest reasonable interpretation consistent with the Specification of the claim term “captive security rod” is a rod-shaped portion of a locking assembly, wherein the rod is anchored to the housing of a portable electronic device. Inst. Dec. 10. Petitioner agrees with our preliminary claim interpretation. Pet. Reply 2. Patent Owner proposes a different claim interpretation. PO Resp. 7–13.

According to Patent Owner, the term “captive security rod” includes a rod or spike that, upon insertion through a hole of a locking device, is locked within the hole:

[T]he proper construction of the “captive security rod” claim term includes, but is not necessarily limited to, a rod or spike **285** that may include a ferrule **286** so that, upon insertion through a hole of a locking mechanism, the rod, spike or anchor is locked, via, *e.g.*, a pin lock **110** or another type of locking device, within the hole sufficient for barring unintended removal of the spike or rod from the hole.

Id. at 13 (citing Ex. 1505 ¶¶ 25–29). Patent Owner also argues that a “captive security rod” can be a rod, ferrule, or spike that is passed through a hole and becomes “captive” in the hole when a locking device is attached to its distal end:

A captive security rod can be a rod, ferrule or spike that is passed through a hole (unidirectionally), but could have freedom

to slide back-and-forth as well as rotate. This rod becomes “captive” when a locking device (such as a lockhead) is attached to the far distal end. Once attached to a locking device, the rod is now captive in the hole and prevents the device to which the locking assembly has been applied, from being removed. The locking assembly, *i.e.*, the captive security rod, the locking device or head and device to be secured, are now captive. With the locking device applied to the security rod, the security rod itself may still rotate and slide, but it is retained or “captive.”

Id. at 8 (quoting Ex. 1055 ¶ 20). Relying on the embodiments depicted in Figures 28C and 28D of the ’758 Patent, discussed in Section I.C above, Patent Owner asserts that ferrule 286 is a captive security rod:

The ’758 Patent disclosure provides that ferrule 286 is the captive security rod to lock notebook computer 500 in place once the lock is operated as shown in Fig. 28D; the ferrule 286 is now a captive security rod in the housing of the computer, as can be seen from Figs. 28C and 28D.

Id. at 9 (citing Ex. 1505 ¶ 23).

To the extent Patent Owner argues that the term “captive security rod” requires a rod, spike, or ferrule that, upon insertion through a hole of a locking mechanism, is “locked” or “captive” in the hole of the locking mechanism, we disagree. As described in the Specification, the term “captive security rod” refers to a rod that is anchored to a portable electronic device and used with a cable and a lock to secure the portable electronic device to another member, such as a table leg. Ex. 1001, 14:28–37, Fig. 30. In the embodiment depicted in Figure 30 of the ’758 Patent, discussed above, captive security rod 291 is not inserted through a hole of a locking device or locked in a hole of a locking device. Accordingly, Patent Owner’s argument is inconsistent with the description of captive security rod 291 in the Specification.

Patent Owner's proposed claim construction is also inconsistent with the argument that Patent Owner made to distinguish over the Murray⁴ prior art reference during prosecution of the '758 Patent. *See* Pet. 16–17; Pet. Reply 13–14; Tr. 29:12–24; Ex. 1002, 942 (distinguishing over Murray on the basis that “Murray’s rectangular T- shaped locking member 124 is stored out of the housing 137 during non-use and between deployments”). Patent Owner’s prosecution argument indicates that “captive” in the term “captive security rod” does not refer to the manner of attachment of the captive security rod to a locking mechanism, but rather to the manner of attachment of the captive security rod in the housing of the portable electronic device. *See id.*

This focus on the attachment of the captive security rod to the portable electronic device is further underscored in the Specification, which states that “[t]he locking assembly also includes means for securing the locking device and, therefore, *the captive security rod and portable electronic device to which the captive security rod is anchored*, to a substantially non-movable object.” Ex. 1001:5:22–25 (emphasis added). Thus, in one embodiment,

[t]he portable electronic device comprises a first housing, a second housing and a hinge, wherein said hinge separates and allows said first housing to be closed upon said second housing after the security rod is anchored to either the first or the second housing. The second housing is a keyboard part and *said captive security rod is fixedly inserted through a surface of said second housing.*”

Id. at 6:16–22 (emphasis added).

⁴ US 5,502,989, issued Apr. 2, 1996. (Ex. 1019).

We determine that the broadest reasonable interpretation consistent with the Specification of the claim term “captive security rod” is a rod-shaped portion of a locking assembly, wherein the rod-shaped portion is anchored to a portable electronic device.

2. *“means for securing the locking device . . .
to a substantially non-movable object”*

In our Institution Decision, we preliminarily determined that the broadest reasonable interpretation consistent with the Specification of “means for securing the locking device . . . to a substantially non-movable object” requires a lanyard, or a cable with or without a clamp. Inst. Dec. 12. As neither party proposes any change to our interpretation, and our review of the evidence does not indicate that any change is necessary, we maintain that interpretation.

C. Asserted Anticipation by the ClickSafe Video

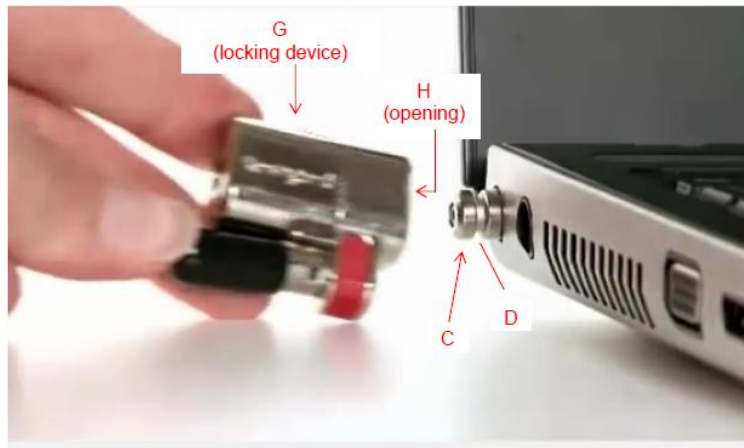
Anticipation requires all features of a claim to be disclosed within a single reference. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008) (holding that, for anticipation, “a single prior art reference must expressly or inherently disclose each claim limitation”). In this case, Petitioner contends that claims 1–7, 9–13, and 16 of the ’758 Patent are anticipated by the ClickSafe video (Ex. 1013). *See* Pet. 3, 51–56. Patent Owner challenges the prior art status of the ClickSafe video, but does not challenge Petitioner’s assertion that the video discloses all limitations of the challenged claims. PO Resp. 5–15; *see* Pet. Reply 1, 17. For the reasons discussed below, we determine that Petitioner has established, by a preponderance of the evidence, anticipation of the challenged claims by the ClickSafe video.

1. Overview of the ClickSafe Video

As evidence of the ClickSafe video and its publication, Petitioner relies on the Declaration of Robert Humphrey (Ex. 1015). Pet. 32 (citing Ex. 1015 ¶¶ 4–8; Exs. 1016–1018). Mr. Humphrey states that he has been employed by Kensington, which is part of ACCO Brands Corporation, since 1994. Ex. 1015 ¶ 1. Mr. Humphrey further states that, from 2009 to 2011, he held the title of “Director – Security Products, Global Business for Kensington,” and that his responsibilities during that period of time included working with development and operational teams to launch Kensington’s ClickSafe line of computer lock products. *Id.* ¶ 2.

Based on Mr. Humphrey’s testimony, we find that (i) “Kensington developed a ClickSafe website to promote the ClickSafe line of computer lock products,” (ii) “[t]his website contained a link to a ClickSafe product video (Exhibit 1013) demonstrating the use and functionality of the ClickSafe® Keyed Laptop Lock,” and (iii) “the ClickSafe website was continuously available to the public from the launch date [October 12, 2010] until at least September 3, 2011.” *Id.* ¶¶ 3, 4.

Two still frames from the ClickSafe video, including annotations added by Petitioner, are reproduced below.



Kensington ClickSafe Keyed Laptop Lock



Kensington ClickSafe Keyed Laptop Lock

See Pet. 32–33; Ex. 1014, 11–12; Ex. 1015 ¶ 10. Petitioner asserts, and we agree, that the still frames from the ClickSafe video reproduced above disclose a locking assembly comprising locking device G with opening H and captive security rod C with locking end D, as annotated by Petitioner. Pet. 33. We also find, based on Mr. White’s testimony, that the ClickSafe video discloses that locking end D of the captive security rod C is received in opening H of locking device G to activate a locking mechanism and to lock the captive security rod and the portable electronic device (to which the captive security rod is attached) to the locking device. Ex. 1021 ¶ 95.

Another still frame from the ClickSafe video, also including annotations added by Petitioner, is reproduced below.



See Pet. 33; Ex. 1014, 9. Petitioner asserts, and we agree, that the still frame from the ClickSafe video reproduced above discloses that the locking assembly includes a cable for securing the locking device to substantially immovable object F, as annotated by Petitioner. Pet. 37.

2. Dispute over Effective Filing Date

Petitioner contends that the earliest-possible effective filing date of claims 1–7, 9–14, and 16 of the '758 Patent is February 18, 2011, the filing date of the '488 Patent Application, because the earlier-filed patent applications to which the '758 Patent claims priority do not provide written description support for the claimed subject matter. Pet. 11–19 (citing Ex. 1021 ¶¶ 44–62); see *supra* Section I.C; 35 U.S.C. § 120; *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997) (holding that “to gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement”). Petitioner argues,

for example, that the embodiment depicted in Figures 28B–C of the earlier-filed patents “does not involve any captive security rod that is installed in a housing of the laptop or that extends out of the housing, or any locking device that receives a locking end of a captive security rod.” Pet.

15. According to Petitioner, ferrule 286 “extends freely through hole 517 in the housing,” and “is not depicted or described as being fixed, installed, or captive in the housing.” *Id.* (citing Ex. 1021 ¶ 55). With respect to the embodiment depicted in Figure 29, Petitioner argues that “spike 285 is inserted through a hole in a laptop housing, but is not inserted into the opening of a locking mechanism.” *Id.* at 16 (citing Ex. 1021 ¶ 57).

Patent Owner disagrees (PO Resp. 2–15), and argues in the Patent Owner Response that the challenged claims are entitled to an effective filing date at least as early as May 23, 2008, based on the ’520 Patent Application and the embodiments depicted in Figures 28, 29, and 28A–D⁵ of the ’520 Patent (Ex. 1504), including the description at column 15, line 22 through column 16, line 3 (PO Resp. 14).⁶ Patent Owner contends that spike 285 and ferrule 286 in those embodiments are captive security rods (*see id.* at 12 (citing Ex. 1505 ¶¶ 25–29)), but does not address Petitioner’s arguments with respect to other claim requirements—for example, the requirement for a captive security rod that is “captive partially in said at least

⁵ Patent Owner actually cites Figures “29A–D” of the ’520 Patent on page 14 of the Patent Owner Response. This is an obvious clerical error. *See* Pet. Reply 16.

⁶ Figures 28, 29, and 28A–D of the ’520 Patent correspond to Figures 28, 29, and 28A–D of the ’758 Patent.

one housing after installation and partially out of said at least one housing during and before locking use after installation” (claim 1).

We agree with, and adopt, Petitioner’s argument that the earliest-possible effective filing date of the challenged claims is February 28, 2011. For the reasons discussed below, we are not persuaded that the ’520 Patent Application provides written description support for any of independent claims 1 and 16.

Claim 1 requires two pertinent features: (1) a captive security rod having a locking end and an anchoring end, wherein the anchoring end is passed through the at least one housing of a portable electronic device to anchor the captive security rod thereto; and (2) a locking device with a locking mechanism, wherein the locking device is configured to receive the captive security rod to activate the locking mechanism.

The first feature is not encompassed by ferrule 286 because ferrule 286 is not a captive security rod, as it lacks a rod-shaped portion anchored to a portable electronic device. At the oral hearing, Patent Owner argued that Figures 28C and 28D show that, ferrule 286 “is fixed in the housing. And once it is locked, once the lock is activated by that end of the captive security rod, the captive security rod is anchored to the device.” Tr. 53:17–20. Patent Owner’s argument is not commensurate with the scope of claim 1, which expressly requires that the locking device “receive the locking end of the captive security rod . . . thereby lock[ing] the security rod and portable electronic device to the locking device.” Rather, in the embodiments on which Patent Owner relies, ferrule 286 passes *freely* through either hole 517 in the housing or the transverse hole in spike 285 and is not fixed to the portable electronic device. Because, in Figures 28C and 28D, ferrule 286 is

not “captive” (i.e., anchored to a portable electronic device) until *after* it has been inserted into an opening in lock 110 to activate the locking mechanism, the locking device does not receive the locking end of a captive security rod,” as required by the claim.

The first feature also requires that the captive security rod have both a locking end and an anchoring end, where the anchoring end is “passed through the at least one housing of a portable electronic device to anchor the captive security rod thereto.” As shown in Figures 28C and 28D, one end of ferrule 286 is locked to lock 110, and the opposite end of ferrule 286 is attached to cable 210. We are not persuaded that the opposite end of ferrule 286 is “passed through the housing of the portable electronic device to anchor the [ferrule] thereto,” as required by claim 1.

Further, if we assume that spike 285 is a captive security rod, the ’520 Patent Application still does not disclose the second feature, i.e., a locking device with a locking mechanism, wherein the locking device is configured to receive spike 285 (the asserted captive security rod) to activate the locking mechanism. Pin lock 110 is configured to receive ferrule 286, but not spike 285.

Claim 16 recites “a method for securing a portable electronic device having a horsing [sic, housing] to a substantially immovable object utilizing a locking assembly, the locking assembly comprising a captive security rod or spike formed with *an anchoring end separated axially by a protruding end*, said captive security rod being captive partially in said at least one housing and partially out of said at least one housing during and before locking use; a locking device with an internal locking mechanism and a cable permanently attached to the locking device at one end” (emphasis

added). The method pertinently requires “*securely fixing the anchoring end* of the captive security rod or spike to the portable electronic device in the housing upon or through the housing” and “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” (emphases added). As shown in Figures 28C and 28D, one end of ferrule 286 is locked to lock 110, and the opposite end of ferrule 286 is attached to cable 210. We are not persuaded that the opposite end of ferrule 286 is “securely fix[ed] . . . upon or through the housing” of the portable electronic device as the claim requires. Rather, as discussed above, ferrule 286 is passed freely through hole 517 in the housing (or the transverse hole in spike 285 as depicted in Figure 29).

With respect to spike 285, we note that the anchoring end of the “captive security rod or spike” recited in the preamble of claim 16 is “securedly fix[ed] . . . to the portable electronic device” in the first method step. The subsequent step of “inserting the protruding end of the *captive, security rod* into an opening the locking device,” however, suggests that the spike is converted to a captive security rod by securedly fixing it to the housing of the portable electronic device.⁷ The ’520 Patent Application does not indicate that spike 285 is securedly fixed to the housing via an anchoring end. Nor does the ’520 Patent Application disclose inserting a protruding

⁷ Consistent with this view, the ’758 Patent recites the steps of “*securedly fixing the anchoring end of the security rod or spike to the portable electronic device* upon or through the housing . . . [and] inserting the protruding end of the 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.*” Ex. 1001, 4:60–5:9.

end of spike 285 into an opening in lock 110 to actuate the internal locking mechanism, as required by claim 16.

In summary, the embodiments depicted in Figures 28, 29, and 28A–D of the ’520 Patent Application, on which Patent Owner relies, do not provide written description support for independent claims 1 and 16 of the ’758 Patent. As for the challenged dependent claims, Patent Owner relies on its arguments with respect to the independent claims. PO Resp. 5–15. Accordingly, we determine that the ’520 Patent Application also does not provide written description support for the challenged dependent claims.

3. Anticipation Analysis

Petitioner contends that the ClickSafe video is a printed publication that was made publicly available at the URL <http://clickittokeepit.com> beginning October 12, 2010, and that the video is prior art to the ’758 Patent under 35 U.S.C. § 102(a). Pet. 51–52 (citing *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981); Manual of Patent Examining Procedure (“MPEP”) § 2128 (9th ed. 2014)). We agree. As discussed in Section II.C.2 above, Patent Owner has not persuaded us that the challenged claims are entitled to the benefit of the earlier filing date of the ’520 Patent Application.

Petitioner asserts that the ClickSafe video discloses all limitations of each of claims 1–7, 9–13, and 16 of the ’758 Patent. Pet. 51–57; Ex. 1021 ¶¶ 91–107, 112, 132–136. Petitioner provides a detailed analysis explaining where the ClickSafe video discloses all limitations of the challenged claims, arranged in the manner required by the claims. Pet. 51–56. We agree with, and adopt, Petitioner’s analysis. On this record, and for the reasons advanced by Petitioner, we determine that Petitioner has shown, by a

preponderance of the evidence, that challenged claims 1–7, 9–13, and 16 are unpatentable as anticipated by the ClickSafe video.

D. Asserted Obviousness

A claim is unpatentable for obviousness “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a).⁸ A patent claim composed of several elements, however, is not proved obvious merely by demonstrating that each of its elements was known, independently, in the prior art. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). In analyzing the obviousness of a combination of prior art elements, it can be important to identify a reason that would have prompted one of skill in the art to combine the elements in the way the claimed invention does. *Id.* A precise teaching directed to the specific subject matter of a challenged claim is not necessary to establish obviousness. *Id.* Rather, “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 420. The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of non-obviousness, i.e.,

⁸ Pub. L. No. 112-29, effective March 16, 2013, amended § 103. Because the earliest-possible effective filing date of the challenged claims is prior to March 16, 2013, we have quoted the pre-amendment version of § 103.

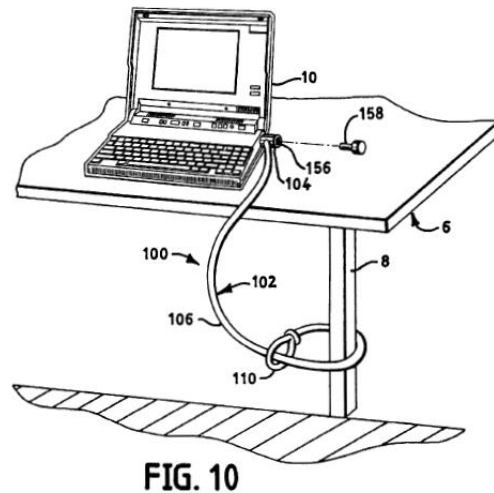
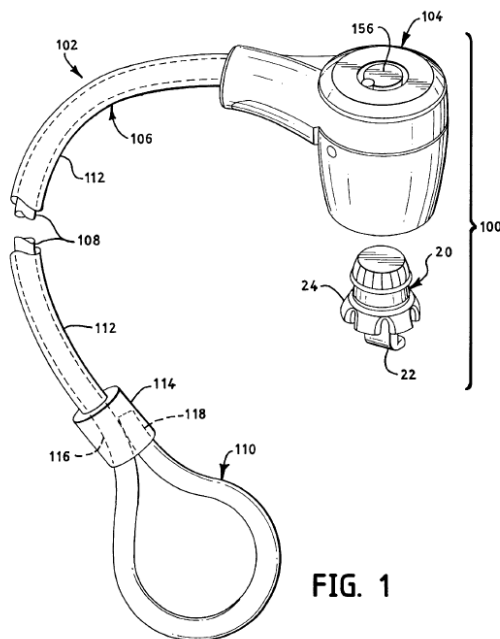
secondary considerations, when in evidence. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In this case, Petitioner contends that claim 14 would have been obvious over ClickSafe video and McDaid and that claims 1–7, 9–14, and 16 would have been obvious over McDaid and Chen. *See* Pet. 2–3.

1. Claim 14 as Obvious over the ClickSafe Video and McDaid

a. Overview of McDaid

McDaid discloses an anchor/tether assembly for use with the security slot found on many portable electronic devices. Ex. 1008, 1:57–59. Figures 1 and 10 of McDaid are reproduced below.



As shown in Figure 1, anchor/tether assembly 100 comprises anchor device 20 and tether 102 with locking head 104. *Id.* at 3:17–27, 5:40–42. In operation, as illustrated in Figure 10, anchor device 20 is secured to portable article 10 through a security slot; tether 102 is attached to stationary

fixture 6; and locking head 104 is installed on anchor 20 by inserting and turning key 158 in keyway 156 of locking head 104. *Id.* at 7:17–39.

b. Analysis

Claim 14 recites: “The locking assembly as set forth in claim 1, wherein the locking device is a pin lock.” Ex. 1001, 20:30–31. Petitioner relies on the ClickSafe video for the limitations of claim 1, from which claim 14 depends, and relies on McDaid, and the knowledge of a POSA, for the additional pin lock limitation of claim 12. Pet. 58. Citing Mr. White’s Declaration, Petitioner contends that a POSA would have recognized that the lock mechanism depicted in Figure 1 of McDaid is “a tubular key type pin lock” (*id.* at 27), and that a POSA would have known to substitute McDaid’s pin lock for the disk lock depicted in the ClickSafe video, as a lower-cost alternative to the “relatively more expensive disk lock” (*id.* at 58, citing Ex. 1021 ¶ 145). Patent Owner disputes the prior art status of the ClickSafe video, as discussed above in Section II.C, but otherwise does not oppose Petitioner’s assertion that claim 14 would have been obvious over McDaid and Chen.

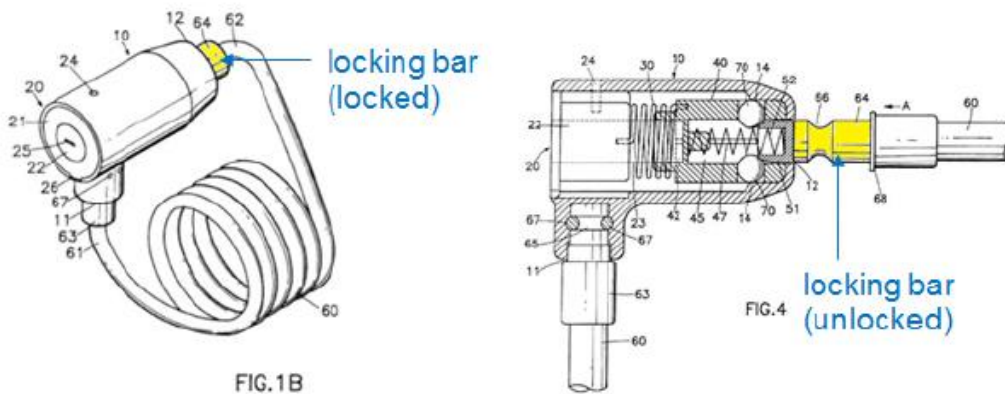
We agree with, and adopt, Petitioner’s argument that claim 14 would have been obvious over the ClickSafe video and McDaid. As discussed in Section II.C above, the ClickSafe video is prior art to the challenged claims. We determine, moreover, that McDaid discloses a pin lock, as Petitioner argues (*id.* at 27–28, citing Ex. 1021 ¶ 82), and that Petitioner has provided a sufficient rationale for combining the teachings of the ClickSafe video and McDaid to render obvious the subject matter of claim 14 (*id.* at 58, citing Ex. 1021 ¶¶ 143, 144). For these reasons, we determine that Petitioner has

shown, by a preponderance of the evidence, that claim 14 is unpatentable under 35 U.S.C. § 103(a) as obvious over the ClickSafe video and McDaid.

2. *Claims 1–7, 9–14, and 16 as Obvious over McDaid and Chen*

a. *Overview of Chen*

Figures 1B and 4 of Chen, as annotated by Petitioner, are reproduced below.



See Pet. 28–29. Figures 1B and 4 show external and internal views, respectively, of a cable lock assembly. With reference to these figures, Petitioner contends that “Chen discloses a cable lock assembly with a lock that is automatically locked (activated) when a locking bar (referred to as locking head 64) is inserted into the locking device (head hole 12 of main body 10).” *Id.* at 29. Thus,

[t]o fasten and lock the cable 60 to the locking device, the user can manually insert the locking head 64 of the cable 60 into the head hole 12 in the main body 10. By doing this, the locking head 64 is locked to the locking device. The user [does not need] to use the key of the locking device to turn the inner cylinder 22 and the locking mechanism 40 to the unlocked state in order to receive the locking head 64 as required when using a prior art locking device.

Id. at 29 (quoting Ex. 1009, 5:49–57; citing Ex. 1021 ¶ 84). In discussing the advantages of this design, Chen teaches that “the locking device of the invention allows the unfastened cable to be fastened and locked to the main body without having to use the key, allowing the cable locking device of the invention to be quickly put into use.” Ex. 1009, 7:40–44.

b. Dispute over McDaid’s Disclosure

The parties dispute whether McDaid’s locking head 104 permits rotation relative to anchor 20 upon activation of the lock. PO Resp. 16–17 (arguing that “locking device 104 disclosed by McDaid does not rotate (once locked) on the captive security rod or anchor 20, and in fact does not rotate in any of the disclosed embodiments” (citing Ex. 1505 ¶ 33)); Pet. Reply 19–20 (arguing that the embodiment depicted in Figure 2 of McDaid permits rotation (citing Ex. 1008, 6:15–22; Ex. 1024 ¶¶ 25–27)). The dispute centers on the following passage in McDaid, which we quoted in our Institution Decision:

The locking head 104 is composed of a number of components, including a housing 122, an eyelet 124, a cup 126, a cylinder 128, and a barrel 130. The housing 122 is the outer component of the locking head 104. The outer end has an opening 132 for receiving the anchor knob 60. *In one configuration, the opening 132 is round to mate with a round external member skirt 64. In another configuration, shown in FIGS. 8, the opening 132 is shaped with peaks 134 and valleys 136 to mate with the valleys 66 and peaks 68 of the external member skirt 64 of FIG. 4. With this configuration, the locking head 104 will not rotate relative to the anchor 20 when they are engaged.* By preventing such rotation, 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 are reduced. Since these stresses are transferred to the portable article 10, there is less

likelihood that inadvertent damage will be caused to the portable article 10.

Ex. 1008, 6:11–28 (emphasis added); Inst. Dec. 19. Patent Owner’s expert, Mr. Mahaffey, testifies that the embodiment depicted in Figures 4 and 8 is merely “a ‘fail safe,’ utilizing the ‘peaks and valleys’ present on the base of the captive rod or anchor 20 to *prevent* rotation.” Ex. 1505 ¶ 38.

Petitioner’s expert, Mr. White, disagrees with Mr. Mahaffey, and testifies that “the clear language in McDaid, supported by the figures, shows that rotation is prevented only in one embodiment.” Ex. 1024 ¶ 31.

Weighing the competing arguments of the parties and the conflicting testimony of the parties’ experts, we are persuaded that McDaid discloses that the embodiment depicted in Figure 2 permits rotation of locking head 104 relative to anchor 20 upon activation of the lock, and that the embodiment depicted in Figures 4 and 8 does not permit rotation of locking head 104 relative to anchor 20 upon activation of the lock. *See* Ex. 1008, 4:7–12, 6:11–28. Mr. Mahaffey’s testimony fails to explain adequately why a person of ordinary skill in the art would understand from McDaid’s disclosure either that the embodiment of Figure 2 does not permit rotation, or that the rotation-preventing structure in the embodiment of Figures 4 and 8 is merely a fail-safe mechanism. As Mr. White points out, “[t]here is no reference, express or implied, to a ‘fail safe’ embodiment in McDaid.” Ex. 1024 ¶ 31. Moreover, Mr. Mahaffey’s testimony fails to address the following passage in the “Summary of the Invention” section of McDaid that supports Mr. White’s analysis:

The locking head has a housing, eyelet, cup, cylinder, and barrel. The housing has an opening for receiving the anchor knob. *In one configuration, the opening is round to mate with a round external member skirt, which is the outer wall adjacent to*

the clamping surface. In another configuration, the opening is shaped with peaks and valleys to mate with the valleys and peaks of the external member skirt, so that the locking head cannot rotate relative to the anchor.

Id. at 2:30–37 (emphasis added); *see also* 1024 ¶ 33 (Mr. White testifying that the locking head includes ring 170, which is designed to permit rotation between the locking head and the anchor (citing Ex. 1008, 7:1–7)).

c. Analysis

Petitioner contends that challenged claims 1–7, 9–14, and 16 would have been obvious in view of McDaid and Chen. Pet. 38–47. Patent Owner disagrees. PO Resp. 15–22.

Petitioner asserts that McDaid discloses all limitations of the challenged claims, except that McDaid teaches activation of the locking mechanism using a key, rather than by insertion of the captive security rod as the claims require. Pet. 38–39 (citing Ex. 1021 ¶¶ 110, 116). With respect to the activation-by-insertion-of-the-captive-security-rod requirement, Petitioner relies on Chen’s disclosure of “a cable lock assembly in which the lock is automatically activated (without need of a key) when the locking bar (locking head 64) is inserted into the locking device (head hole 12 of main body 10).” *Id.* at 45–46 (citing Ex. 1009, 5:49–57; Ex. 1021 ¶¶ 114–116). As a reason to combine the teachings of McDaid and Chen to arrive at the subject matter of the challenged claims, Petitioner asserts that a POSA would have known that automatically activated lock mechanisms have advantages over key-activated lock mechanisms, and that Chen’s automatically activated lock mechanism was suitable for use in McDaid’s locking assembly:

Automatically-activated lock mechanisms, such as those disclosed in Chen, were well known in the art. A POSA would

have understood that the Chen lock mechanism was suitable for use in the McDaid locking assembly. In addition, as suggested in Chen and known in the art, an automatic lock mechanism has advantages over key-activated lock mechanisms in that such mechanisms may be locked without the use of a key.

Id. at 46 (citing Ex. 1021 ¶ 117).

Patent Owner argues that “McDaid prevents all rotation of the locking head 104 around the anchor or rod 20 . . . , thereby teaching away from any motivation for the person of ordinary skill in the art to consider Chen for seeking to modify McDaid.” PO Resp. 21 (citing Ex. 1505 ¶ 49). We have determined, however, as discussed above, that McDaid teaches two configurations, only one of which prevents rotation of locking head 104 around anchor 20. It is well established that “[t]he 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). Moreover, while McDaid teaches that the embodiment of Figures 4 and 8 reduces stress on the anchor and thus reduces the likelihood of damage to the portable article attached to the anchor (Ex. 1008, 6:22–28), that teaching at most expresses a general preference for that embodiment, and does not criticize, discredit or otherwise discourage permitting rotation of the locking head relative to the anchor. *See Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (“A reference does not teach away . . . if it merely expresses a general preference for an alternative invention but does not criticize, discredit, or otherwise discourage investigation into the invention claimed.”) (internal quotation marks omitted; citation omitted).

Patent Owner also asserts that “McDaid teaches the use of a radial locking mechanism for use in the apparatus taught therein, while Chen discloses the use of an axial locking mechanism, and expressly states that the apparatus therein ‘utilizes an axial locking mechanism instead of a radial locking mechanism’ as taught in the prior art.” PO Resp. 4–5. Patent Owner argues that “[a] person of ordinary skill in the art, considering the radial locking mechanism of McDaid, would not look to, or consider, Chen, which is an axial locking mechanism and expressly disparages the use of a radial locking mechanism, for modifying McDaid.” *Id.* at 20 (citing Ex. 1505 ¶¶ 47, 48). Patent Owner further argues that McDaid “teaches against any rotation,” while Chen “requires rotation.” *Id.* at 21.

Petitioner responds that “Chen itself provides an express motivation to substitute an axial lock mechanism for McDaid’s radial lock mechanism.” Pet. Reply 20–21 (citing Ex. 1009, 1:63–65; Ex. 1024 ¶¶ 34–37). We agree. As Petitioner argues, Chen teaches “*utiliz[ing] an axial locking mechanism instead of a radial locking mechanism* as in the prior art that allows the locking device to be more easily operable than the prior art.” *Id.* at 20–21 (citing Ex. 1009, 1:63–65). Further, as discussed above, we do not agree with Patent Owner’s argument that McDaid teaches against any rotation.

For these reasons, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 1–7, 9–14, and 16 are unpatentable under 35 U.S.C. § 103(a) as obvious over McDaid and Chen.

E. The Motions to Exclude

We have reviewed Patent Owner’s Motion to Exclude, Petitioner’s Opposition, and Patent Owner’s Reply. In its Motion, Patent Owner requests that we exclude Mr. White’s declarations (Exs. 1021 and 1024) and

portions of Petitioner’s Petition and Reply because “Mr. White did not author his written expert testimony.” Paper 26, 1. We are persuaded, however, that Mr. White provided input for his declarations in “‘working sessions’ with counsel.” Paper 31, 7 (citing Ex. 1507, 36:8–15). To the extent that Patent Owner seeks to exclude Mr. White’s testimony on claim construction, the Motion is moot because we did not consider or rely on that testimony in rendering this decision. *See* Paper 26, 5–9, 12–13. In its Reply, Patent Owner clarified that it is not seeking exclusion of Mr. White’s deposition, but rather is seeking “inferences against [Petitioner] in the multitude of instances its counsel coached Mr. White via improper objections.” Paper 35, 5. In this regard, the Motion addresses issues more appropriate to determining the weight ascribed to the evidence rather than the admissibility of the evidence. Irrespective of Patent Owner’s arguments regarding these issues, in rendering our Decision, we have determined and ascribed the appropriate weight to all proffered evidence and, when appropriate, commented upon the weight ascribed.

We also have reviewed Petitioner’s Motion to Exclude, Patent Owner’s Opposition, and Petitioner’s Reply. Petitioner requests that we exclude Exhibit 1507,⁹ entitled “Simplified Explanation of Findings Provided in the IPR.” Paper 23, 1. We deny Petitioner’s Motion as moot because we did not consider or rely on that exhibit or the corresponding testimony of Mr. Mahaffey or Mr. White in rendering this decision.

⁹ Exhibit 1507 was marked as Exhibit A during the deposition of Mr. Mahaffey and Exhibit 2007 during the second deposition of Mr. White. Paper 23, 1–2.

II. CONCLUSION

For the foregoing reasons, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 1–7, 9–14, and 16 of the '758 Patent are unpatentable.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–7, 9–14, and 16 of US 8,717,758 B2 are unpatentable.

This is a Final Written 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.

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