

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MUNCHKIN, INC.
Petitioner

v.

SKIP HOP, INC.
Patent Owner

Case No. IPR2016-00536
Patent Number 9,060,653

**PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107**

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EXHIBIT LIST

Exhibit Number	Exhibit Description
Skip Hop 2001	USPTO File History for U.S. Patent No. 8,424,129
Skip Hop 2002	U.S. Patent No. 8,424,129

In accordance 37 C.F.R. § 42.107, Skip Hop, Inc. (“Skip Hop”) respectfully submits this Preliminary Response in opposition to the Petition for *Inter Partes* Review (Paper 1, the “Petition”) filed by Munchkin, Inc. (“Munchkin”) regarding claims 12 to 21 of U.S. Patent No. 9,060,653 (the “‘653 Patent”). Munchkin’s Petition should be denied in its entirety for the reasons set forth below.

I. INTRODUCTION

This Petition involves a flawed obviousness challenge. The Board should decline to institute *inter partes* review proceedings because each of the grounds in the Petition suffers from one or more of the following fatal defects:

First, Petitioner relies on two references – Thorne and Lerner – that were of record in the original prosecution of the ‘653 Patent and its parent application. Claims 12-21 of the ‘653 Patent were allowed over those two references.

Second, the allegedly anticipatory references and each combination of references upon which Petitioner relies for its obviousness analysis fail to teach or suggest at least one limitation of each of claims 12-21 in the ‘653 Patent.

Third, Petitioner relies on three other references, involving water spouts and child seats, that are directed to other fields of endeavor or are not reasonably pertinent to the particular problem which the ‘653 Patent solves, and thus are not analogous to the subject matter of Thorne, Lerner, or the ‘653 Patent.

Finally, even ignoring these shortcomings, Petitioner fails to articulate any reason or motivation with a rational underpinning to combine the cited references

In this Preliminary Response, pursuant to 37 C.F.R. § 42.107 and 35 U.S.C. § 313, Patent Owner addresses only the fundamental shortcomings of the petition under 35 U.S.C. §§ 312, 314(a) and 37 C.F.R. §§ 42.104, 42.108. Specifically, critical procedural and substantive deficiencies result in a failure to demonstrate, as to any of the challenged claims, a reasonable likelihood of success on the asserted grounds of invalidity. Accordingly, the Board should decline to institute *inter partes* review proceedings because each of the grounds in the Petition suffers from one or more of the following fatal defects:

Because of these clear threshold failures, the Petition should be denied and no *inter partes* review should be instituted under 35 U.S.C. § 314 and 37 C.F.R. § 42.108.¹

¹ If the Board nonetheless institutes trial on any of the challenged claims, Patent Owner will address in further detail in its 37 C.F.R. § 42.120 Response each of the numerous substantive errors and shortcomings that underlie each of Petitioner's arguments and its purported evidence.

II. THE ‘653 PATENT AND ITS PARENT APPLICATION.

The ‘653 Patent was a continuation of U.S. patent application Ser. No. 12/511,652 (the “Parent Application”). (*See* Ex. 1002-5, Related Applications.) During the prosecution of the ‘653 Patent’s parent application, the U.S.P.T.O. considered both U.S. Pat. Pub. 2007/0130,688 (“Thorne”) and U.S. Pat. No. 4,709,429 (“Lerner”). (*See* Ex. 2001.) The Parent Application ultimately issued on April 23, 2013 as U.S. Patent No. 8,424,129 (the “‘129 Patent”). (*See* Ex. 2002.) Petitioner concedes that Thorne was considered by the USPTO during the prosecution of the ‘653 Patent. But the Petition fails to disclose that the USPTO also considered **both** Thorne and Lerner during the prosecution of the Parent Application. The USPTO is thus presumed to have considered Thorne and Lerner during the prosecution of the ‘653 Patent because Thorne and Lerner were disclosed and of record during the prosecution of the Parent Application (the ‘129 Patent). The Petition simply ignores this inconvenient fact, and also ignores the fact that the USPTO allowed the claims in the ‘653 Patent **and** the ‘129 Patent over Thorne and Lerner.

The ‘653 Patent and its Parent Application both relate to a cover for a bath spout and a method of securing a bath spout cover to a bath spout. (*See* Ex. 1002, at 1:12-17.) Bath spout covers have been sold in the United States for decades. The purpose of a bath spout cover is to provide protection against injury in the

event an individual slips and falls while in a bathtub. Petitioner mischaracterizes the ‘653 Patent by alleging that it is directed only to the safety of children. In fact, and as clearly disclosed by the ‘653 Patent, the invention is directed to “protect individuals, including children, from personal injury.” (Ex. 1002, 1:22-23.)

Prior to the invention of the ‘653 Patent, bath spout covers were typically manufactured as solid or inflatable sleeves made of plastics such as poly-vinyl chloride. *Id.* at 1:31-40. These bath spout covers were difficult to remove or install, making them inconvenient for storage and drying after use. (*Id.* at 1:36-39.) Other designs produced bath spout covers that were relatively easily installed, but frequently fell off the bath spout, thereby failing to provide sufficient protection for individuals. (*Id.* at 1:40-43.)

Prior to the invention of the ‘653 Patent, there were no known techniques for dealing with the problematic properties of bath spout covers that made them inconvenient to use and also failed to provide a consistent and predictable level of protection against injury in a bathtub to *all* individuals – not just children. The ‘653 patent discloses and claims a solution to these problems. Specifically, the ‘653 Patent discloses a bath spout cover that:

(a) is easy and convenient to attach to, and remove from, baths spouts of any size by using straps that are connected to the opposing side portions of the bath spout cover, with at least one aperture on one of the side portions of the bath spout

cover designed to either receive the strap(s) or designed so that the strap(s) extend through the aperture(s) (*Id.* at 1:36-50; 7:5-17; 7:25-8:12);

(b) provides a consistent and predictable level of security against the bath spout cover falling off the bath spout by ensuring that the bath spout cover fits tightly against the bath spout, without sacrificing the ease and convenience of attaching, removing, or adjusting the bath spout cover (*Id.*);

(c) possesses an elongated void extending along substantially the entire length of the upper portion of the bath spout cover resulting in a bath spout cover that can is not only more flexible, thereby resulting in a bath spout cover that can be attached to any type of bath spout without regard to the shape and size of the bath spout, but can also accommodate any type of bath spout without regard to the location of the bath spout shower diverter (*Id.*); and

(d) can be built using elastomeric materials that provide a greater level of protection against injury and which can also possess anti-mold and anti-fungal properties. (*Id.*)

III. THE DEFICIENCIES IN PETITIONER’S CHALLENGE.

Petitioner devotes thirty-seven (37) disjointed pages in its Petition to allege that various claims of the ‘653 patent are rendered obvious by four different combinations of prior art: (1) U.S. Patent Application 2007/0130688 (“Thorne”) in view of U.S. Patent 4,709,429 (“Lerner”) and U.S. Patent Application

2007/0175531 (“Daniels”) (Ground 1 of the Petition); (2) Thorne in view of Lerner and U.S. Patent 5,599,063 (“Lister”) (Ground 2 of the Petition); (3) Thorne in view of Daniels (Ground 3 of the Petition); and (4) Thorne in view of Lister and U.S. Patent 3,910,634 (“Morris”) (Ground 4 of the Petition).

Petitioner has also submitted the Declaration of Michael C. Thuma (“Thuma Declaration”).¹ Thuma’s opinion is entitled to little, if any, weight because he asserts, without citation to any evidence, “that based on the simplicity of the product and the experience level required to use the product, one of ordinary skill in the art has at least the equivalent of: (a) 3 years of experience regarding the design and manufacture of plastic molded products and plumbing fixtures, including experience regarding the design and manufacture of child safety devices; or (b) a bachelor’s degree in mechanical engineering, industrial design, or a related field and two years of experience regarding the design and manufacture of child safety devices.” (Ex. 1011, at p. 5.)

Thuma does not explain why he assumes that the product is “simple” to design. Nor does Thuma explain if or how he has the experience that fits within his definition of one skilled in the art. The Thuma Declaration simply states that

¹ Moreover, while Thuma references a CV appended to his Declaration as Exhibit 1, (Ex. 1011, at p. 3), he failed to include any CV with his declaration.

he been “involved” with “clients in areas ranging from house wares, kitchen appliances, toys, child safety products, electronics, automotive, medical and industrial equipment” and that he has “experience in Product Development” without bothering to explain what he was involved in or what he means by “Product Development” and his experience in that undefined field. (*Id.* at 2.) In short, there is no evidence that establishes Thuma is an expert qualified to provide an opinion on the ‘653 Patent.

Unsurprisingly, Thuma’s Declaration does nothing more than parrot the contents of the Petition, but fails to provide any factual support for the basis for his conclusory opinions. Indeed, Thuma simply assumes, without explanation, that the references relied on by Petitioner to invalidate the ‘653 Patent are from the same field of endeavor. As a result, the opinions given by Thuma are reached purely by reconstruction of non-analogous references to reach the ‘653 Patent without any explanation as to how or why the non-analogous references would be combined to produce the claimed invention (*See* Ex. 1011.) Thuma’s opinion is thus entitled to little, if any, weight. *See Logic Tech. Dev., LLC v. Fontem Holdings I B.V.*, IPR2015-0098, Paper 8 at 9-10 (May 11, 2015) (denying institution where purported expert’s “naked agreement adds no probative weight”).

Petitioner suggests – erroneously – that the ‘653 Patent is only directed to safety for infants and small children, and that the claims do not further the art of

safety devices for infants and small children, and are obvious in view of the prior art references. (Petition, at 6.) Petitioner is simply incorrect. Other than conclusory statements that the prior art renders the ‘653 patent invalid for obviousness, the Petition and the Thuma Declaration fail to provide any factual support that the references relied on in the Petition are, in fact, directed to the same field of endeavor as the ‘653 Patent or are reasonably pertinent to the particular problem with which the ‘653 Patent solves.

The Petition also suffers from other fatal flaws. Petitioner misconstrues the history of the ‘653 Patent’s prosecution, misconstrues the actual teachings of the prior art Petitioner relies on to invalidate the ‘653 Patent, and combines non-analogous art in a hindsight-based reconstruction of the claimed invention of the ‘653 Patent. Indeed, Petitioner articulates no reasoning with a rational underpinning to make its proposed combinations at the time of the invention of the ‘653 Patent.

IV. LEGAL STANDARD FOR INSTITUTION OF INTER PARTES REVIEW.

To meet its burden to institute an *inter partes* review, Petitioner must make a showing that, as a factual and legal matter for each asserted ground, Petitioner has a reasonable likelihood of proving at least one challenged claim unpatentable. *See, e.g.*, 37 C.F.R. § 42.108(c); 35 U.S.C. § 314; 77 Fed. Reg. 48680, 48694 (Aug. 14, 2012). Because Petitioner failed to meet this burden, its Petition must be denied,

and no *inter partes* review should be instituted. Specifically, as presented in more detail below, the Board should deny institution because:

- Petitioner’s cited references – Thorne, Lerner, Daniels, Lister, and Morris – alone or in combination, fail to render obvious any challenged claims as a whole; and
- Petitioner’s asserted motivations to combine the prior art it relies upon are conclusory and unsupported.

For these reasons, as explained in more detail in the arguments below, the Petition fails to meet its threshold burden of showing a reasonable likelihood of success as to the sole asserted ground of obviousness. The very purpose of the 37 C.F.R. § 42.108 threshold is to avoid the empty, wasteful exercise Petitioner asks this Board to commence. Because the Petition on its face fails to show a reasonable likelihood of success, Petitioner’s request for a trial should be denied.

V. CLAIM CONSTRUCTION IS UNNECESSARY AND ADDS NOTHING FOR PURPOSES OF DECIDING WHETHER TO INSTITUTE INTER PARTES REVIEW.

Petitioner seeks to construe three terms: (1) “end of the strap”; (2) “opening adapted to fit over a bath spout shower diverter”; and (3) “elastomeric material”. Neither the Petition nor the Thuma Declaration, (Ex. 1011), explain why these terms need to be construed. Indeed, Petitioner provides no reason why its proposed constructions are necessary for understanding the challenged claims or

asserted prior art. *See Luminara Worldwide, LLC v. Shenzhen Liown Elecs. Co.*, IPR2015-01183, Paper 8 at 6-7 (Nov. 5, 2015) (finding construction unnecessary “because neither Petitioner, nor Petitioner’s expert, addresses how this construction would apply to the references”). Accordingly, Petitioner’s proposed construction is unnecessary, adds nothing of value to the words of the claim, and, for purposes of deciding whether to institute *inter partes* review, should be rejected.¹

VI. THE PETITION FAILS TO ADEQUATELY IDENTIFY HOW CLAIMS 12 TO 21 OF THE ‘653 PATENT ARE UNPATENTABLE.

The Petition fails to show, as required by 35 U.S.C. § 314 and 37 C.F.R. § 42.108, that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. Petitioner’s fatal shortcomings include its failure to show any of the following: (a) that there is any reason to second-guess the USPTO’s decision to allow claims 12 to 21 over Thorne and Lerner, which were considered during the prosecution of the ‘653 Patent; (b) that there was any reason to combine the disparate references teaching unrelated concepts that Petitioner proffers, other than impermissible hindsight; and (c) that the references combined actually render obvious any challenged claim. Each of these failures is a sufficient reason to deny the Petition.

¹ Patent Owner reserves the right to argue, if necessary, an appropriate construction for this term should the Board institute trial.

A. Thorne and Lerner Were Previously Considered by the USPTO during the Prosecution of the ‘653 Patent.

Petitioner relies on Thorne as its “primary reference” for obviousness.

Thorne is directed to an “impact resistant bathtub spout cover” with at least one attaching strap coupled to the body at a rearward end of the body, wherein the strap is adapted to be secured around the spout.” (Ex. 1005 at Abstract.) Petitioner acknowledges that Thorne was before the USPTO during prosecution of the ‘653 Patent. Left unstated by Petitioner is the undisputed fact that Thorne was considered by the examiner during prosecution of the ‘653 Patent, independent claims 12 and 15 were amended by Patent Owner in light of Thorne, and the examiner allowed claims 12 and 15, as amended, and their corresponding dependent claims, claims 13-14 and 16-21, over Thorne.

The Petition also fails to disclose to the Board that during the prosecution of the ‘653 Patent’s Parent Application, *Lerner* was also before the USPTO. (*See* Ex. 2001, at 56.) References considered by the USPTO during the prosecution of the Parent Application are presumed to have been considered by the USPTO during the prosecution of the ‘653 Patent. *See* Manual of Patent Examining Procedure (“MPEP”) § 609.02(II)(A)(2) (“The examiner will consider information which has been considered by the Office in a parent application...when examining: (A) a continuation application filed under 37 CFR 1.53(b)...”). Petitioner does not – and cannot – dispute the fact that Thorne and Lerner are presumed to have been

considered by the USPTO during the prosecution of the ‘653 Patent, and that the USPTO allowed claims 12-21 over Thorne and Lerner.

Notably, Thorne and Lerner, alone or combined, were not a bar to the patentability of the ‘653 Patent and its parent, the ‘129 Patent. 35 U.S.C. § 282. Here, Petitioner attempts to resurrect Thorne and Lerner as references against the ‘653 Patent by attempting to combine it with Daniels, Lister, and Morris. Those references are non-analogous art that bear no relation to subject matter in Thorne and Lerner. The Board should give deference to the USPTO’s prior consideration of Thorne and Lerner and deny all grounds in the Petition. 35 U.S.C. § 325(d).

B. The Art Cited By Petitioner Does Not Disclose All the Limitations in Claims 12-21 of the ‘653 Patent.

1. Lerner Does Not Disclose “an elongated void extending along substantially an entire length of the upper portion” as claimed in the ‘653 Patent (Grounds 1-2).

Petitioner concedes that Thorne does not disclose the following limitation in independent Claim 12: “an elongated void along substantially an entire length of the upper portion” of the bath spout cover. (Petition, at 12.) Petitioner relies on Lerner for the proposition that it “teaches that the void 34 should be elongated such that it extends along *substantially* an entire length of the upper portion in order to allow the spout cover to be used with bath spouts having shower control knobs in different positions along their length.” (*Id.* (emphasis added).) There is nothing in Lerner that supports Petitioner’s proposition.

a. Petitioner Mischaracterizes What Lerner Teaches.

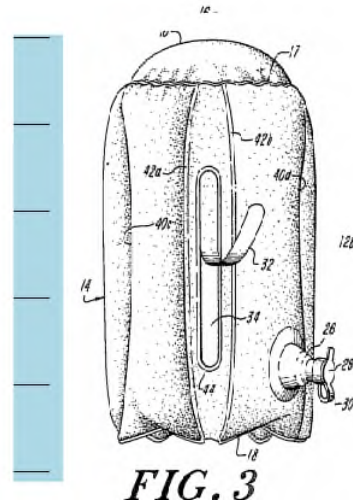
Petitioner mischaracterizes Lerner in an attempt to manufacture an *ex post facto* combination of non-analogous art to reach the '653 Patent. Thuma simply parrots this mischaracterization by stating that “Thorne in combination with Lerner meets the limitation ‘the upper portion defines an elongated void extending along substantially an entire length of the upper portion’.” (Ex. 1011, at 21.) Yet, there is *nothing* in Lerner which indicates an “elongated void” extends along “substantially an entire length of the upper portion”. Instead, Lerner teaches that:

The cover body is preferably provided with a removable, tear-out strip 32 which can be removed to define an opening 34 for access to a shower control knob 36. In cases where the shower control knob is not located on the bathtub spout 22, the tear-out strip 32 can be left in place. The opening 34 is elongated to permit use with bathtub spouts having shower control knobs 36 in different positions along their length.

(Ex. 1006, 2:55-62.) Notably, neither Petitioner nor Thuma cite to any other evidence explaining how Lerner teaches “that the void 34 should be elongated such that it extends long substantially an entire length of the upper portion” of the bath spout cover. (Petition, at 12.)

b. Lerner Does Not Disclose an “an elongated void extending along substantially an entire length of the upper portion”.

Indeed, Figure 3 from Lerner further establishes that Lerner only discloses an “opening” that is simply “elongated”. Contrary to Petitioner’s claim, Lerner does *not* disclose a void or opening which “extend[s] along substantially an entire length of the upper portion.”¹



“Substantially” is synonymous with the terms “nearly”, “to a great extent”, “considerably” or “almost”. *Deering Precision Instruments, L.L.C. v. Vector Distrib. Sys.*, 347 F.3d 1314, 1323 (Fed. Cir. 2003). In order for the opening in Lerner to meet the claim limitation in the ‘653 Patent of “elongated void” that “extend[s] along substantially an entire length of the upper portion”, the opening must run “nearly” or “almost” the entire length of the upper portion of the bath spout cover. While the opening in Lerner may run along the some of the cover’s upper length, it does not – and cannot – by simply running along a part of the

¹ The ruler next to figure 3 does not appear in Lerner. It has been juxtaposed to Figure 3 in order to provide perspective to the viewer.

upper length, meet the claim limitation in the ‘653 Patent that the void that “extend[s] along substantially an entire length of the upper portion.”¹

2. Daniels Does Not Disclose a strap having a dimension larger than a dimension of the aperture (Ground 3).

Claim 15 in the ‘653 Patent claims in part:

an *end portion of the strap having a dimension larger than a dimension of the aperture*, said end portion extending through said aperture and extending along the exterior facing surface of the body wherein part of the *end portion abuts the exterior facing surface of the body structure*, thereby holding the strap in place, said strap for securing the bath spout cover to a bath spout.

(Ex. 1002, at 8:5-12.)

¹ Skip Hop recognizes that the drawings in Lerner are not necessarily to scale since there is no disclosure in Lerner that they are, in fact, drawn to scale. Nevertheless, Petitioner has taken the position that the opening in Lerner runs substantially along the length of the upper portion and relies on the drawings in Lerner to support its position. Nothing in Lerner teaches that the opening runs substantially along the length of the upper portion. The drawings in Lerner simply confirm that fact and do not support Petitioner’s position.

Petitioner contends that that “Daniels teaches that an end portion of a strap can have a dimension larger than a dimension of the aperture, such that the end portion extends through the aperture and extends along the exterior facing surface of the body structure and holds the strap in place.” (Petition, at 25-26.) The Thuma Declaration repeats this statement verbatim. (*See* Ex. 1011, at 36.) Even a cursory reading of Daniels reveals that does not disclose the limitations in the ‘653 Patent.

a. Contrary to Petitioner’s Claim, Daniels Does Not Disclose “a strap having a dimension larger than a dimension of the aperture”.

Petitioner once again engages in mischaracterization of the art in a misguided attempt to manufacture an *ex post facto* combination of non-analogous art to reach the ‘653 Patent. There is ***nothing*** in Daniels which discloses “an end portion of the strap having a dimension larger than a dimension of the aperture”. (Ex. 1002, 8:5-7.) In fact, Daniels is silent on how the straps attach to the water spout.

There are a multitude of methods which could be utilized in order to attach the straps to the water spout in Daniels. To name a few, the straps could be attached to the water spout by: (1) fusing the straps to the water spout with a glue or epoxy; (2) using a threaded bolt and nut; or (3) using cotter pins. What is clear is that the method by which the straps are attached to the water spout in Daniels is

undisclosed, and it is pellucidly clear that Daniels does not claim an “end portion of the strap having a dimension larger than a dimension of the aperture” as the method to secure the water spout to a bathroom sink.

In addition, Daniels does not claim a strap “wherein part of the end portion [of the strap] abuts the exterior facing surface of the body structure, thereby holding the strap in place.” (Ex. 1002, 8:9-12.) Other than Petitioner’s conclusory statement that Daniels does disclose such a strap – and Thuma’s opinion that parrots this claim verbatim – Petitioner does not provide any evidence in support of its allegation. The reason why is clear: no such evidence exists to support Petitioner’s allegation that Daniels claims a strap “wherein part of the end portion [of the strap] abuts the exterior facing surface of the body structure, thereby holding the strap in place.” (*Id.*)

a. Contrary to Petitioner’s Claim, Daniels Does Not Disclose an “end portion of the strap which abuts the exterior facing surface of the body structure”.

Petitioner’s allegation that Daniels discloses a strap wherein part of the end portion abuts the exterior facing surface of the body structure to hold the strap in place is also unsupported. Indeed, that allegation is contradicted by the illustrations in Daniels, which clearly show that the straps either (a) do *not* abut the exterior facing surface of the water spout; (b)

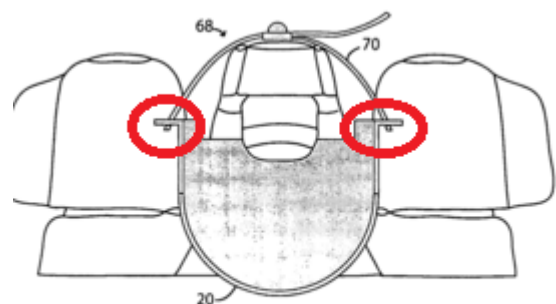


FIG. 5b

FRONT VIEW - FAUCET EXTENDER WITH FLANGE ATTACHED TO TWO HANDLE FAUCET

to the extent the straps abut the surface of the water spout, those straps abut the *interior* surface of the water spout; or (c) to the extent the portions of the straps lie adjacent to the exterior portions of the water spout, they are not connected in such a way as to “hold the strap in place”.

As Fig. 5b in Daniels, (Ex. 1009-6), which is relied on by Thuma in his Declaration, (*see* Ex. 1011, at 36), on the right, shows, the straps in Daniels, which have been annotated in red by Patent Owner, do not abut the exterior facing surface of the water spout.¹ Figure 5b simply shows a strap extending through the aperture, but not along any exterior surface.

Moreover, as Fig. 4b from Daniels, (Ex. 1009-5), illustrates, the strap extends from the exterior surface to the interior surface. Thus, it does not meet the claim limitation in claim 15 of the ‘653 Patent, which requires that the end portion of the strap abut the exterior portion of the bath spout cover.

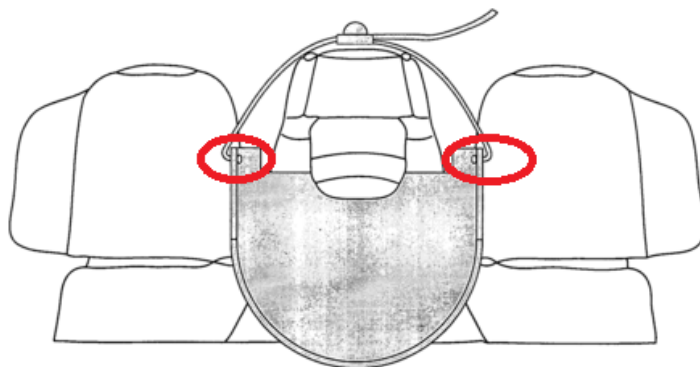


FIG. 4b

FRONT VIEW - FAUCET EXTENDER ATTACHED TO TWO HANDLE FAUCET

¹ The annotations in red shown in Figs. 5b, 4b, and 4a have been inserted by Patent Owner.

Finally, Daniels does not teach that the straps are connected in a manner designed to hold the straps in place once the strap is extended through the exterior facing surface such that

the strap abuts the exterior

facing surface. Instead,

Daniels discloses in Fig.

4a, (Ex. 1009-5), that the

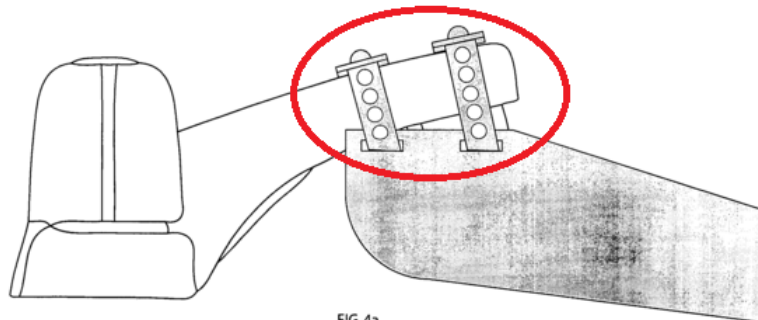
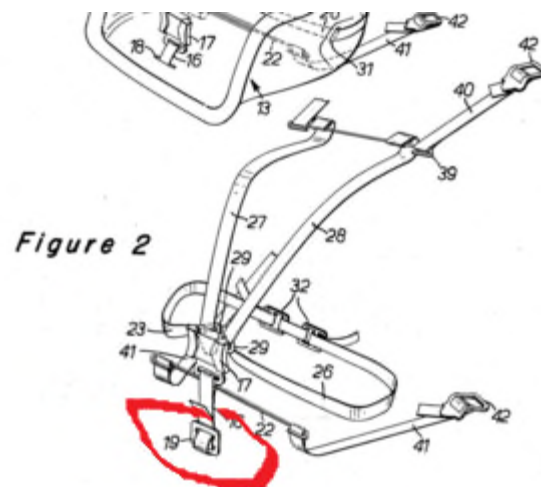


FIG. 4a
SIDE VIEW - FAUCET EXTENDER ATTACHED TO TWO HANDLE FAUCET

straps are connected by a buckle, snap, or some other mechanism. It follows then that the straps are not held in place by virtue of the end portions of the straps extending through the aperture such that it abuts the exterior facing surface of the body structure. To the contrary, the straps in Fig. 4b in Daniels, could be pulled back through the aperture.

3. Morris Does Not Disclose “an end portion of the strap having a dimension larger than a dimension of the aperture” (Ground 4).

The same issues that beset Grounds 1 to 3 of the Petition also beset Ground 4. Morris discloses that “[t]he end of the crotch strap on the underside of the seat can be threaded through a friction buckle



19 which is too large to be threaded through the slot.” (Ex. 1008, 2:9-12.)

Petitioner fails to mention that the “end of the crotch strap” in Morris is “threaded” through a friction buckle. It is not the “end of the crotch strap” that is “too large to be pulled through the slot” as Petitioner would have the Board believe. The friction buckle is an entirely separate piece – one that is not claimed or disclosed in the ‘653 Patent – that is “too large to be pulled through the slot”, which has been circled in red in the image above. Accordingly Morris cannot reach claims 15-21 of the ‘653 Patent.

C. Daniels, Lister, and Morris are Non-Analogous Art.

“A reference qualifies as prior art for an obviousness determination under § 103 only when it is analogous to the claimed invention.” *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011). Prior art is analogous if it is “from the same field of endeavor, regardless of the problem addressed,” or is “reasonably pertinent to the particular problem with which the inventor is involved.” *Id.* “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *Id.* “If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection.” *Id.*

In *Klein*, the Federal Circuit reversed the Board's obviousness determination because the Patent Office erred in finding five prior art references were analogous to the claimed invention for a container having a movable divider to mix ratios of sugar and water to make nectar. In particular, three pieces of prior art were directed to devices for separating—not mixing—non-liquid items. And two pieces of prior art for mixing blood plasma would not have been considered by one of skill in the art in trying to mix sugar and water. *In re Klein*, 547 F.3d at 1350-52.

Petitioner cites to Daniels, Lister and Morris as analogous art, but Petitioner fails to present a single reason *why* they are analogous to the '653 Patent and simply *assumes* that because those references are generally directed to the subject matter of child safety, they must be analogous to the '653 Patent. The Thuma Declaration is no better, as it simply parrots the arguments made in the Petition without any providing any additional evidence to support Petitioner's assumption that Daniels, Lister, and Morris are analogous art. The Petition is thus defective on that basis alone. Nevertheless, even a cursory review of Daniels, Lister, and Morris reveals that those references are not analogous because they are not from the same field of endeavor and are not reasonably pertinent to the particular problem with which the '653 Patent solves.

The '653 Patent relates to “a cover for a bath spout and a method of securing a bath spout cover to a bath spout” in order to “protect individuals, including

children, from personal injury” when using the bathtub. Petitioner agrees that the ‘653 Patent’s field of disclosure relates to bathtub safety. (*See* Petition, at 1.) Thus, it is undisputed that the ‘653 Patent is directed to bathtub safety, and specifically directed to prevent injury in the event an individual using the bathtub slips and falls onto the bath spout.

1. Daniels is directed to controlling the flow of water through a water spout.

In contrast, Daniels is directed to water spout extenders for use in a *sink* with a faucet. (*See* Ex. 1009.) The purpose of the apparatus claimed in Daniels is not safety. It does not, like the invention claimed in the ‘653 Patent, seek to create a bath spout cover that is easy and convenient for an adult to install, adjust, and remove, yet is also constructed so as to impede a child from easily removing it. Rather, the objective claimed in Daniels is to direct the flow of water delivered to the sink through a water spout in order to simplify “the use of sinks by small children and the disabled.” (Ex. 1009-8, at [0005].) Notably, the bath spout cover claimed in the ‘653 Patent does not direct the flow of water from a bath spout, nor does it claim to limit its use to a particular demographic. Thus, Daniels is directed to a different field of endeavor – re-directing the flow of water – and solves a different problem – giving a child or disabled person easy and convenient access to a sink by extending the range of the water by use of a water spout.

The function of Daniels differs such that it would not be considered by a person of ordinary skill in the art of the ‘653 Patent. The straps and the slots disclosed in Daniels functions so that “straps extend[] **over** the spout” and where the straps are located proximate to a “distal end” of the spout (Ex. 1009-8, at [0020] and [0021].) The location of the slots and the straps in Daniels function to prevent the spout from detaching as a result of water pressure created by the water flowing from the faucet to the spout, and the location of the straps and slots take advantage of the force of the water pressure exerted on the spout to create a more stable connection between the spout and the faucet. The straps and the apertures in the ‘653 Patent, on the other hand, functions by securing the straps **under** the bath spout. (*See, e.g.*, Ex. 1002, at 2:4-6.)

The bath spout cover in the ‘653 Patent has no need to use the force of the water pressure created by water flowing from the bath spout because the bath spout cover does not interact in any way with the actual flow of water. There is no rational reason to attach the straps **over** the bath spout cover – essentially inverting the bath spout cover – when the point of the invention is to cover the bath spout so as to protect against injury. In other words, creating a secure connection to the bath spout by taking advantage of the water pressure is not an intended function of the ‘653 Patent.

Petitioner has made *no showing* that the water spout in Daniels is in the same field of endeavor (e.g., similar structure and function) as the ‘653 Patent, or that one of ordinary skill in the art of the ‘653 Patent would have considered the subject the subject matter of Daniels to be reasonably pertinent to the particular problem being addressed in the ‘653 Patent. Accordingly, Petitioner has not shown Daniels to be prior art under 35 U.S.C. § 103.

2. Lister and Morris are directed to infant cradles and seats.

Lister is directed to “a cradling surface for supporting an infant at a user selected angle for the purpose of bathing, feeding, sleeping and seating.” (Ex. 1007, at 1:5-8.) Morris is similarly directed to securing a child to an infant car seat. (Ex. 1008.) Both Lister and Morris are also directed to a different field of endeavor – cradling or securing an infant nor child – and solves yet another different problem – securing an infant or child to a cradling surface or to an infant car seat.

Again, Petitioner provides no evidence in its Petition or in the Thuma Declaration why or how cradling surfaces and infant car seats, and methods for securing children to those apparatuses are in same field of endeavor as the ‘653 Patent, or that one of ordinary skill in the art of the ‘653 Patent would have considered the subject the subject matter of Lister and Morris to be reasonably pertinent to the particular problem being addressed in the ‘653 Patent.

Accordingly, Petitioner has not shown Lister and Morris to be prior art under 35 U.S.C. § 103.

D. There is No Reasonable Likelihood Petitioner Would Prevail on Its Contention that One of Ordinary Skill in the Art Would Have Been Motivated to Combine the Asserted References.

“Obviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination.” *Unigene Labs, Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather than assembling a collection of snippets cut from the art and cobbled together with the benefit of Patent Owner’s ‘653 Patent as a template, Petitioner must provide “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007); *Unigene*, 655 F.3d at 1360-61. In other words, “some kind of motivation must be shown from some source . . . [to] understand why a person of ordinary skill would have thought of either combining two or more references or modifying one to achieve the patented method.” *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008) (quotation omitted).

Obviousness can only be found if there is some reason or motivation to make such a combination or modification that is not based on hindsight gleaned from the invention itself. *See, e.g., Comaper Corp. v. Antec, Inc.*, 596 F.3d 1343,

1352 (Fed. Cir. 2010) (“Determining obviousness requires considering whether two or more pieces of prior art could be combined, or a single piece of prior art could be modified, to produce the claimed invention. This analysis typically invokes the familiar teaching-suggestion-motivation (‘TSM’) test, asking whether a person having ordinary skill in the art would have found some teaching, suggestion, or motivation to combine or modify the prior art references.”) (rev’d on other grounds) (internal citations omitted); *see also Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1368 (Fed. Cir. 2012) (“While the Supreme Court made clear that a mechanical application of the teaching-suggestion-motivation test, requiring an explicit teaching in the prior art, is inappropriate, we must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.”) (internal quotation marks and citation omitted). Importantly, a “proper analysis under 35 U.S.C. § 103 requires not only that all of the elements of the claimed invention are taught or suggested by the prior art, but also: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed device; and (2) whether the prior art also would have revealed that in so making, those of ordinary skill would have a reasonable expectation of success.” *Intri-Plex Techs, Inc. v. Saint-Gobain Performance Plastics Rencol Ltd.*, IPR2014-00309, Paper 83, at 41-42

(PTAB 2014) (*citing Par Pharma, Inc. v. TWI Pharma, Inc.*, 773 F.3d 1186, 1197 (Fed. Cir. 2014)).

“Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (U.S. 2007) (*quoting Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).) Petitioner’s submission fails to provide the Board with the basic evidence necessary to institute an *inter partes* review.

1. The Petition and the Thuma Declaration Are Replete With Conclusory Statements That Fail to Articulate Any Reason or Motivation to Combine the Cited References and Is Instead a Hindsight Reconstruction Gleaned from the ‘653 Patent Itself.

Petitioner contends that claims 12-21 of the ‘653 patent are rendered obvious by four different combinations of prior art: (1) Thorne in view of Lerner and Daniels (Ground 1 of the Petition); (2) Thorne in view of Lerner and Lister; (3) Thorne in view of Daniels (Ground 3 of the Petition); and (4) Thorne in view of Lister and Morris (Ground 4 of the Petition).

Petitioner's alleged motivation to combine the cited references boils down to the bare, unsupported assertion that Lister, Daniels and Morris relate to same field of invention as the '653 Patent. This theory directly contradicts the disclosures of each reference, which address entirely different technical problems. Conclusory statements that a person of ordinary skill in the art would have been aware of these devices and their methods for securing children and would incorporate those teachings are not sufficient to support a claim of obviousness. *See K/S HIMPP v. Hear-Wear Techs., LLC*, 2013-1549, slip op. at 6-7 (Fed. Cir. May 27, 2014).

Here, Thuma merely repeats the assertions in the Petition without identifying any supporting evidence or explaining how a person of ordinary skill would have been motivated to view these references together. *See ActiveVideo Networks, Inc. v. Verizon Comm., Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012) (dismissing expert testimony that "failed to explain how specific references could be combined, which combination(s) of elements in specific references would yield a predictable result, or how any specific combination would operate or read on the asserted claims" and further dismissing expert testimony that generically recites a desire for more efficient and cheaper systems that had more features for customers); *Logic Tech.*, IPR2015-0098, Paper 8, at 9-10 (denying institution where expert's "naked agreement adds no probative weight"); *SAS Inst., Inc. v. Complementsoft, LLC*, IPR2013-00581, Paper 17, at 3-4 (PTAB Feb. 25, 2014) (observing that the PTAB

“is not required to take every statement by a petitioner’s expert as established fact” and “is required to assess the persuasiveness of the testimony in light of other factual evidence in the record, e.g., the explicit wording of the prior art and the scope of the claimed invention”; and finding the petitioner’s expert testimony unpersuasive).

Thuma does not explain why one of ordinary skill in the art would have combined elements from specific references in the way the claim invention does. *See ActiveVideo*, 694 F.3d at 1328 (rejecting expert testimony that “fails to explain why a person of ordinary skill in the art would have combined elements from specific references in the way the claimed invention does”) (citing *KSR*, 550 U.S. at 418). For these reasons, the Thuma Declaration and its conclusory assertions fail to provide even the basic § 103 analysis required by *Graham v. John Deere Co.*, 383 U.S. 1 (1966), and fail to establish any basis for combining the art. These unsupported attorney arguments (whether made by Petitioner or cloaked in a parroted form from Thuma) should not be given any probative weight. *See Kinetic Techs., Inc. v. Skyworks Solutions, Inc.*, IPR2014-00529, Paper 8 at 15-16 (Sept. 23, 2014) (denying institution where “Petitioner’s arguments do not provide the required articulated reasoning with rational underpinning”).

2. Ground 1: The Combination of Thorne in View of Lerner and Daniels Does Not Render Claims 12-14 Obvious.

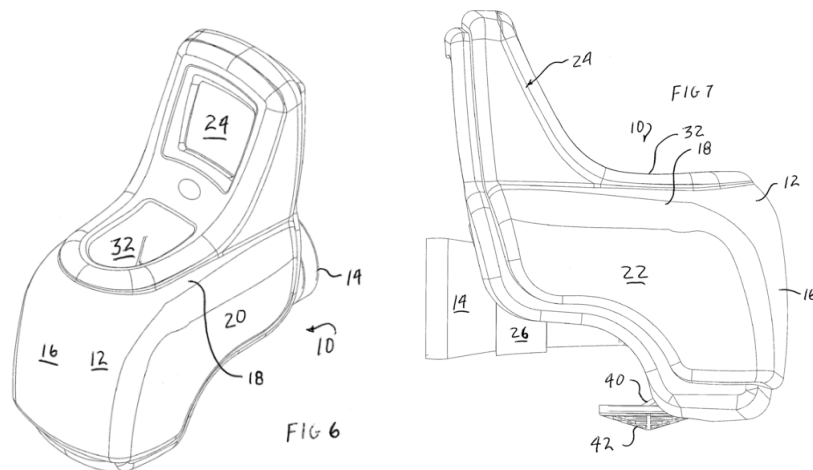
In Ground 1, Petitioner Contends that claim 12 and dependent claims 13-14 are obvious over Thorne in view of Lerner and Daniels. Claim 12 of the ‘653 Patent requires in part “an elongated void along substantially an entire length of the upper portion” of the bath spout cover and “at least one aperture defined by one of the side portions of the body structure, said aperture for receiving an end of the strap.” (Ex. 1002, 7:10-17.) Even if Daniels qualifies as analogous art – which it does not – Ground 1 fails because the combination of Thorne, Lerner, and Daniels does not disclose all required claim limitations in independent claim 12.

Specifically, none of the references cited by Petitioner contain the limitation recited in claim 12 that there be “an elongated void extending along substantially along an entire length of the upper portion.” (*Id.*, 7:11-12.) Accordingly, the combination of Thorne, Lerner, and Daniels also fails to teach or suggest all of the limitations of dependent claims 13 and 14 (which depend from claim 12).

Therefore, Petitioner has failed to demonstrate a reasonable likelihood that Thorne in view of Lerner and Daniels renders claims 12-14 obvious. Because Petition has failed to establish a *prima facie* case of obviousness, the Board should deny the entirety of Ground 1 of the Petition.

a. Petitioner Fails to Articulate Any Rationale For Combining the Teachings of Thorne With Lerner.

Petitioner’s purported motivation to combine the teachings in Lerner with Thorne are not borne out by the engineering limitations disclosed in Thorne. It would be impossible to modify the Thorne device in order to incorporate a “elongated void” ” that “extend[s] along substantially an entire length of the upper portion”, (Ex. 1002, 7:10-11), of the device because the Thorne device has a temperature display located on the distal portion of the device. The temperature display (24) extends upward and is a part of the upper portion of the bath spout cover, as borne out by Figures 6 and 7 of Thorne:



(See Ex. 1005-6 and -7.)

Even if one were to re-engineer Thorne to incorporate an “elongated void” that “extend[s] along substantially an entire length of the upper portion” of the device, doing so would eviscerate the intent of the device disclosed in Thorne,

which includes the ability of the device to monitor and display the temperature of the water coming out of the bath faucet.

Petitioner does not address any of the inherent engineering challenges posed by their incorporation of the elongated void disclosed in Lerner into Thorne. Petitioner simply ignores these challenges and glibly assumes that their proposed combination would be accomplished by a person skilled in the art. Thuma is no better. He also provides no facts or evidence that addresses the engineering challenges posed by incorporating the elongated void taught in Lerner into Thorne. Petitioner has provided *no* reasoning with a rational underpinning to combine the references. Accordingly, the Petition should be denied.

b. Petitioner Fails to Articulate Any Rationale For Combining the Teachings of Daniels With Thorne and Lerner.

Petitioner further relies on the combination of Daniels with Thorne and Lerner to assert that the '653 Patent is obvious. But as established above, Daniels is non-analogous art, and thus is not prior art under 35 U.S.C. § 103. Even if Daniels were treated as analogous art, it is clear that Daniels fails to reach the limitations in the '653 Patent.

Petitioner's sole rationale for combining Thorne with Daniels is that one of ordinary skill in the art would recognize that "passing an end of a strap through an aperture in a side portion (as in Daniels) would be a satisfactory, low-cost method

of attaching a strap that is equally applicable to Thorne.” (Petition at 14.) This rationale must fail.

While Petitioner purports to identify motivations to combine the asserted references, Petitioner does not actually present specific bases or articulated reasons to combine Thorne, Daniels, and Lerner. Instead, Petitioner uses isolated snippets from each reference to suggest that they were all in the same field of “child safety devices”, improperly relying on the ‘653 Patent as the roadmap for this hindsight-based combination. Importantly, Petitioner fails to explain why one of skill in the art applicable to the ‘653 Patent would, in the first place, be aware of water spout extenders, and would further be motivated to, and have found it obvious, to apply the aperture and strap in Daniels to Thorne. Nor does Petitioner provide any evidence that applying the strap in Daniels to Thorne would be “a low-cost method of attaching a strap” or that it is, *in fact*, a low-cost method that would have motivated one with skill in the art to combine the strap disclosed in Daniels to Thorne.

Petitioner provides an annotation of Fig. 6 from Thorne with a small circle to show where an aperture and strap from Daniels could be incorporated into Thorne. (See Petition, at 15.) Petitioner has drawn a small red circle to



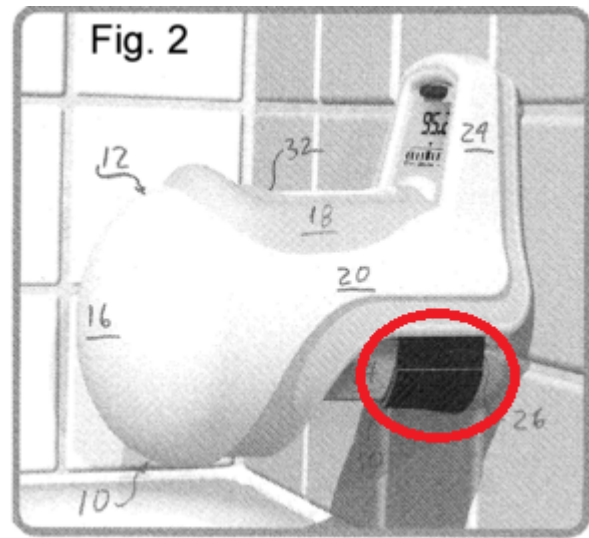
Thorne annotated FIG. 6.

demonstrate that Thorne could incorporate an aperture such the one disclosed in Daniels. Based on this purported ability to incorporate the aperture disclosed in Daniels into Thorne, Petitioner concludes that a strap similar to the one disclosed in Daniels could also be incorporated into Thorne. In other words, Petitioner purports to have rendered the '653 Patent invalid as obvious with the mere stroke of a pen.

But patents are not invalidated merely on the ability to draw a circle on an image. Petitioner's annotation of Figure 6 from Thorne is not only facile, it fails to take into account the fact that Thorne cannot accept an aperture and strap such as the one disclosed in Daniels because Thorne discloses "a temperature display 24 which will receive a temperature signal from a sensor (not shown) in the water stream of the spout (14) to quickly and easily display water temperature to the operator." (Ex. 1005, par. 36.) Notably, Petitioner fails to explain *how* such a an aperture and strap would be incorporated into Thorne.

To the extent an aperture or strap could be incorporated into Thorne, it would need to take into account the temperature gauge display and sensor. Petitioner provides no evidence that an aperture that receives a strap could even be incorporated into Thorne, and simply states it as a given fact. Petitioner's reliance on such conclusory statements does not meet the standard to institute an *inter partes* review.

Indeed, as shown in Figure 2 from Thorne, (Ex. 1005-3), the inventors in Thorne did not disclose or claim an aperture through which a strap would be received. Instead, Thorne disclosed a “hook and loop type strap 26 coupled to the body 12



at a rearward end of the body as shown” (Ex. 1005-16, at [0037].) Presumably, the hook and loop type strap (which has been annotated with a red circle in the image above) was coupled to the inside of the bath spout cover’s body disclosed in Thorne in order to accommodate the electronic temperature display and sensor equipment.

Petitioner has failed to articulate a reasoning with a rational underpinning to combine the references. *St. Jude Med., Inc. v. Access Closure, Inc.*, 729 F.3d 1369, 1381 (Fed. Cir. 2013) (affirming nonobviousness and noting that “between [the prior art] and the claimed invention lies a logical chasm—a chasm not bridged by the prior art, common sense, or [defendant’s] statements that the claimed invention was obvious. Even under our ‘expansive and flexible’ obviousness analysis we must guard against ‘hindsight bias’ and ‘ex post reasoning.’” (internal citations omitted)). Accordingly, the Petition should be denied.

3. Ground 2: The Combination of Thorne in View of Lerner and Lister Does Not Render Claims 12-14 Obvious.

The reasoning in Section VI.C.1 apply in full to Petitioner's claim in Ground 2 that Lerner invalidates the '653 Patent. Moreover, Lister is non-analogous, and is not prior art under 35 U.S.C. § 103.

Petitioner's sole rationale for combining Thorne with Lister is that one of ordinary skill in the art would recognize that "passing an end of a strap through an aperture in a side portion (as in Lister) would be a satisfactory, low-cost method of attaching a strap that is equally applicable to Thorne." (Petition at 18.) This rationale must fail.

Petitioner fails to explain why one of skill in the art applicable to the '653 Patent would, in the first place, be aware of cradling surfaces, and would further be motivated to, and have found it obvious to apply the strap in Lister to Thorne. Nor does Petitioner provide any evidence that applying the strap in Lister to Thorne would be "a low-cost method of attaching a strap" or that it is, *in fact*, a low-cost method that would have motivated one with skill in the art to combine the strap disclosed in Daniels to Thorne. Those failures are fatal to Petitioner's claim. Accordingly, Ground 2 of the Petition should be denied.

4. Ground 3: The Combination of Thorne in View of Daniels Does Not Render Claims 15-21 Obvious.

The arguments set forth in Section VI.C.1 with respect to the combination of Thorne and Daniels applies in full to Ground 3. For the reasons set forth in Section VI.C.1, Ground 3 of the Petition should be denied.

5. Ground 4: The Combination of Thorne in View of Morris Does Not Render Claims 15-21 Obvious.

As established above, Morris is not prior art because it is non-analogous to Thorne or the '653 Patent. Morris also fails to disclose the claim limitations in the '653 Patent.

Petitioner's sole rationale for combining Thorne with Morris is that one of ordinary skill in the art would recognize that "using the Morris end portion 19 'which is too large to be pulled through the slot' would be a satisfactory, low-cost method of attaching a strap that is equally applicable to the Thorne/Lister combination." (Petition at 33.) Again, Petitioner's rationale must fail.

Petitioner fails to explain why one of skill in the art applicable to the '653 Patent would, in the first place, be aware of infant car seats, and would further be motivated to, and have found it obvious to apply the strap, including the friction buckle, in Morris to Thorne. Nor does Petitioner provide any evidence that applying the strap in Morris to Thorne would be "a low-cost method of attaching a strap" or that it is, *in fact*, a low-cost method that would have motivated one with

skill in the art to combine the strap disclosed in Morris to Thorne. Those failures are fatal to Petitioner's claim. Accordingly, Ground 4 of the Petition should be denied.

Petitioner has failed to demonstrate a reasonable likelihood that Thorne in view of Lerner and Daniels renders claims 15-21 obvious. Because Petition has failed to establish a *prima facie* case of obviousness, the Board should deny the entirety of Ground 1 of the Petition.

VII. CONCLUSION

It is clear even from this preliminary record that Petitioner's asserted challenges suffer from numerous deficiencies. In light of these deficiencies, the Petition fails to show that there is a reasonable likelihood that Petitioner will prevail in proving any challenged claim unpatentable. The Petition should, therefore, be denied. Pursuant to 35 U.S.C. § 314, no Inter Partes Review should be instituted.

Dated: the 29th day of April, 2016

Respectfully submitted,

SKIP HOP, INC.,

By Counsel:

/Stephen J. Weyer/

Stephen J. Weyer (Reg. No. 43,259)

STITES & HARBISON PLLC

1800 Diagonal Road

Suite 325

Alexandria, VA 22314-2840

Telephone: (703) 739-4900

Facsimile: (703) 739-9577

Email: sweyer@stites.com

Counsel for Skip Hop, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107 was served by filing this document through the Patent Review Processing System as well as providing a courtesy copy via e-mail to the following attorneys of record for the Petitioner listed below:

Lead Counsel:	A. Justin Poplin (Reg. No. 53,476) LATHROP & GAGE LLP IP Docketing, Inter Partes Review 2345 Grand Blvd., Suite 2400 Kansas City, MO 64108 Telephone: (913) 451-5130 Facsimile: (913) 451-0875 E-mail: JPoplin@LathropGage.com and patent@LathropGage.com
Back-up Counsel:	Robert Evora (Reg. No. 47,356) LATHROP & GAGE LLP IP Docketing, Inter Partes Review 2345 Grand Blvd., Suite 2400 Kansas City, MO 64108 Telephone: (913) 451-5130 Hissan Anis (Reg. No. 65,943) LATHROP & GAGE LLP IP Docketing, Inter Partes Review 2345 Grand Blvd., Suite 2400 Kansas City, MO 64108 Telephone: (913) 451-5130 Facsimile: (913) 451-0875

	Anna Quinn (Reg. No. 72,744) LATHROP & GAGE LLP IP Docketing, Inter Partes Review 2345 Grand Blvd., Suite 2400 Kansas City, MO 64108 Telephone: (913) 451-5153 Facsimile: (913) 451-0875
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Dated: April 29, 2016

Respectfully submitted,

By: /Stephen J. Weyer/
 Name: Stephen J. Weyer

STITES & HARBISON, PLLC