

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MUNCHKIN, INC.,  
Petitioner,

v.

SKIP HOP, INC.,  
Patent Owner.

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Case IPR2016-00536  
Patent 9,060,653 B2

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Before MICHAEL R. ZECHER, BRIAN J. McNAMARA, and  
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review  
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

## I. INTRODUCTION

Munchkin, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 12–21 of U.S. Patent No. 9,060,653 B2 (“the ’653 patent,” Ex. 1002). Skip Hop, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a).

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

After considering the Petition, the Preliminary Response, and associated evidence, we conclude that Petitioner has demonstrated a reasonable likelihood of prevailing in showing the unpatentability of all challenged claims. Thus, we institute an *inter partes* review as to claims 12–21 of the ’653 patent.

### A. Related Matters

Petitioner and Patent Owner indicate that the ’653 patent is asserted in *Skip Hop, Inc. v. Munchkin Inc.*, No. 2:15-cv-06339-SJO-AGR (C.D. Cal.). See Pet. 3; Paper 9, 1. Patent Owner additionally notes that U.S. Patent Application No. 14/734,406, which claims priority to the ’653 patent, is pending and may be affected by a decision in this proceeding. Paper 9, 1.

### B. The ’653 Patent

The ’653 patent is directed to bath spout covers, an example of which is depicted in Figure 1, reproduced below:

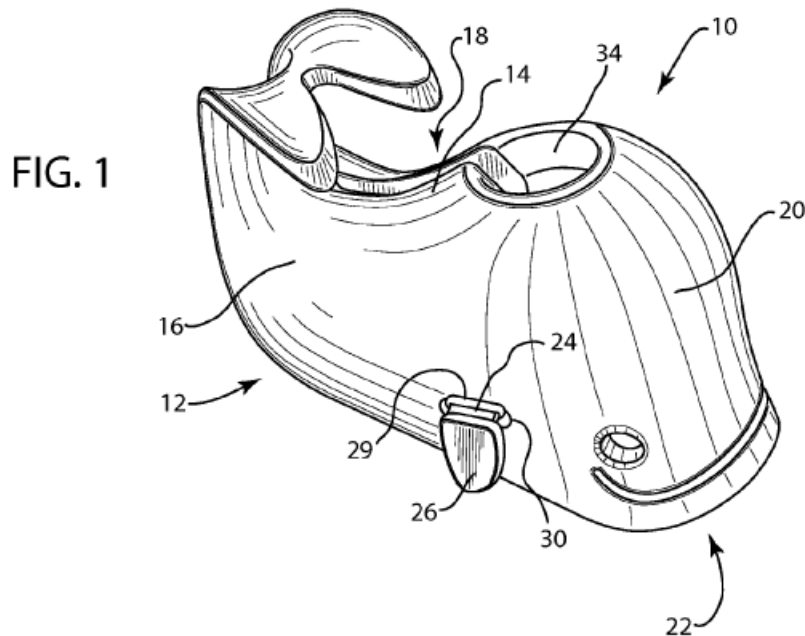


Figure 1 depicts “a perspective view of an exemplary bath spout cover.” Ex. 1002, 2:64–65, 3:23–24. With reference to Figure 1, the ’653 patent explains:

[B]ath spout cover 10 is provided that comprises a body structure 12 having an upper portion 14, two opposing side portions 16,18, and a front portion 20; a receiving area defined by the upper portion 14, the two opposing side portions 16,18, and the front portion 20; a strap 24 spanning the two opposing side portions 16,18; and, at least one aperture 30 defined by one of the side portions 16 of the body structure 12 for receiving an end 26 of the strap 24.

*Id.* at 3:25–33.

### *C. Illustrative Claims*

Among the challenged claims, claims 12 and 15 are independent claims. Claims 13 and 14 depend directly or indirectly from independent claim 12, and claims 16–21 depend directly or indirectly from claim 15.

Claims 12 and 15 are illustrative of all the challenged claims and are reproduced below:

12. A bath spout cover, comprising:

a body structure having an upper portion, two opposing side portions, and a front portion;

a receiving area defined between the upper portion, the two opposing side portions, and the front portion, the upper portion defines an elongated void extending along substantially an entire length of the upper portion;

a strap operably connected to the two opposing side portions, said strap for securing the bath spout cover to a bath spout; 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, 7:5–17.

15. A bath spout cover, comprising:

a body structure with an exterior facing surface, the body structure having an upper portion, two opposing side portions, and a front portion;

a receiving area defined between the upper portion, the two opposing side portions, and the front portion;

at least one aperture through one of the side portions, and

a strap spanning the two opposing side portions and traversing the at least one<sup>1</sup> aperture, 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

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<sup>1</sup> On February 23, 2016, Patent Owner filed a Request for Issuance of Certificate of Correction to add the word “one” to claim 15, as well as to amend language in dependent claim 17. On June 21, 2016, the Office issued a Certificate of Correction.

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.

*Id.* at 7:25–8:12.

#### *D. References*

Petitioner relies upon the following references:

Morris	US 3,910,634	Oct. 7, 1975	Ex. 1008
Lerner	US 4,709,429	Dec. 1, 1987	Ex. 1006
Lister	US 5,599,063	Feb. 4, 1997	Ex. 1007
Thorne	US 2007/0130688 A1	June 14, 2007	Ex. 1005
Daniels	US 2007/0175531 A1	Aug. 2, 2007	Ex. 1009

#### *E. Asserted Grounds of Unpatentability*

Petitioner challenges claims 12–21 of the '653 patent based on the asserted grounds of unpatentability set forth in the table below. Pet. 1–2, 11–37.

References	Basis	Claims Challenged
Thorne, Lerner, and Daniels	§ 103(a)	12–14
Thorne, Lerner, and Lister	§ 103(a)	12–14
Thorne and Daniels	§ 103(a)	15–21
Thorne, Lister, and Morris	§ 103(a)	15–21

## II. CLAIM CONSTRUCTION

Although Petitioner identifies three terms or phrases for construction (“end of the strap,” “opening adapted to fit over a bath spout shower diverter,” and “elastomeric material”), Petitioner does not propose constructions for these terms or phrases. Pet. 4–6. Rather, Petitioner argues these terms or phrases do or do not encompass certain features or attributes. *See id.* Patent Owner argues Petitioner’s proposed constructions are

unnecessary, and Patent Owner does not propose to construe any other terms of the challenged claims. Prelim. Resp. 9–10.

Based on the evidence of record, and for purposes of this Decision, we determine that express constructions for these or any other terms or phrases of the challenged claims are not necessary at this time.

### III. ANALYSIS

#### A. 35 U.S.C. § 325(d)

Patent Owner argues that the Petition should be denied under 35 U.S.C. § 325(d) because Thorne, which is relied upon for all unpatentability challenges in this Petition, was considered during prosecution. Prelim. Resp. 11–12. Patent Owner also argues Lerner was considered during the prosecution of U.S. Patent No. 8,424,129 B2 (“the ’129 patent,” Ex. 2002), to whose application the ’653 patent claims priority (Ex. 1002, (63)), and, therefore, Lerner is “presumed to have been considered by the [U.S. Patent and Trademark Office (“USPTO”)] during the prosecution of the ’653 Patent.” Prelim. Resp. 11 (citing Manual of Patent Examining Procedure (“MPEP”) § 609.02(II)(A)(2); Ex. 2001, 56<sup>2</sup>).

We are not persuaded that the Petition should be denied under 35 U.S.C. § 325(d). Although Thorne was of record during the prosecution of the ’653 patent, Patent Owner has not directed us to anywhere in the record showing that the Examiner considered a challenge to the claims in the same or substantially the same manner presented in the Petition. That is, the

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<sup>2</sup> The relevance of the cited page of the prosecution history of the ’129 Patent, which is a Response to an election of species requirement and does not mention Lerner, is unclear.

evidence of record does not show the Examiner considered Thorne in combination with Lerner, Lister, or Daniels during prosecution of the '653 patent. Consequently, we decline to exercise our discretion to deny the Petition under 35 U.S.C. § 325(d) because “the same or substantially the same prior art or arguments” were presented previously to the USPTO.

*B. Principles of Law*

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter 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. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). 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 ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

*C. Level of Ordinary Skill in the Art*

Petitioner relies on the Declaration of Mr. Michael C. Thuma (Ex. 1011, hereinafter, the “Thuma Declaration”) to support its unpatentability challenges. Patent Owner argues that Mr. Thuma does not cite any evidence in support of his testimony regarding the level of skill in the art, and that he does not “explain if or how he has the experience that fits within his definition of one skilled in the art.” Prelim. Resp. 6. Patent Owner notes that Mr. Thuma refers to, but does not include, a curriculum vitae (“CV”) with his declaration. As such, Patent Owner asserts “there is no evidence

that establishes Thuma is an expert qualified to provide an opinion on the ‘653 Patent.” Prelim. Resp. 7.

Although the record before us does not include Mr. Thuma’s CV, Mr. Thuma provides unrebutted testimony that he has some experience in the relevant art. *See* Ex. 1011 § III. Thus, there is at least some evidence supporting his qualifications to opine with respect to the subject matter at issue. Furthermore, although Patent Owner takes issue with Petitioner’s asserted level of skill in the art (Prelim. Resp. 6–7), Patent Owner does not put forth its own assertion of the level of skill in the art. On the record before us, we determine that the prior art of record in this proceeding is indicative of the level of skill in the art and that Petitioner’s and Mr. Thuma’s asserted level of skill is consistent with that of the prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); Pet. 9–10; Ex. 1011 § VI.A.

*D. Unpatentability of Claims 12–14 Based on  
Thorne, Lerner, and Daniels*

Petitioner contends claims 12–14 would have been obvious over the combination of Thorne, Lerner, and Daniels. Pet. 1, 11–17. Petitioner explains how the cited prior art references allegedly teach the claimed subject matter and relies upon the Thuma Declaration to support its positions. Pet. 11–17.



*1. Petitioner's Contentions with Respect to Thorne*

Thorne is directed to bath spout covers. *See* Ex. 1005, Abstract, ¶ 3. Figures 6 and 7 of Thorne are reproduced below:

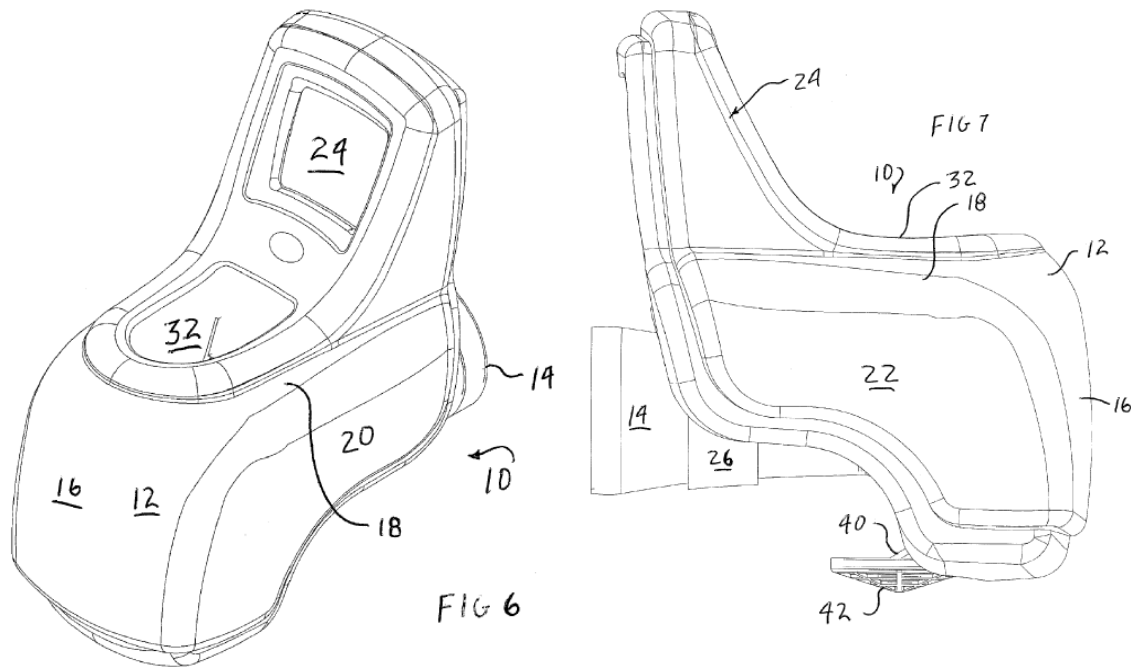


Figure 6 “is a perspective top view of a bath spout cover,” and Figure 7 “is a side elevation view of the bath spout cover of” Figure 6. Ex. 1005 ¶¶ 24–25.

Petitioner contends Thorne discloses a bath spout cover having “a body structure having an upper portion, two opposing side portions, and a front portion,” as well as “a receiving area defined between the upper portion, the two opposing side portions, and the front portion,” as recited in claim 12. Pet. 11. In particular, Petitioner argues Thorne’s bath spout cover 10 has body structure 12 with an upper portion 18, opposing side portions 20 and 22, and front portion 16. Pet. 11 (citing Ex. 1005, Fig. 6, ¶ 34; Ex. 1003, 18–25, 35). Citing Thorne’s disclosure that “body 12 is essentially a three sided, open bottom cover around the spout 14,” Petitioner argues Thorne discloses the bath spout cover has “a receiving area defined

between the upper portion, the two opposing side portions, and the front portion,” as recited in claim 12. Pet. 11–12 (citing Ex. 1005 ¶ 35, Fig. 2; Ex. 1003, 18–25).

Petitioner also argues Thorne teaches elongated void 32 in upper portion 18. Pet. 12 (citing Ex. 1005, Figs. 1, 6; Ex. 1003, 18–25). Thorne discloses bath spout cover 10 “includes a diverter valve access opening 32 in the top member 18 adapted to allow access to and operation of a diverter valve 34 of the spout 14 when the spout cover 10 is installed.” Ex. 1005 ¶ 39.

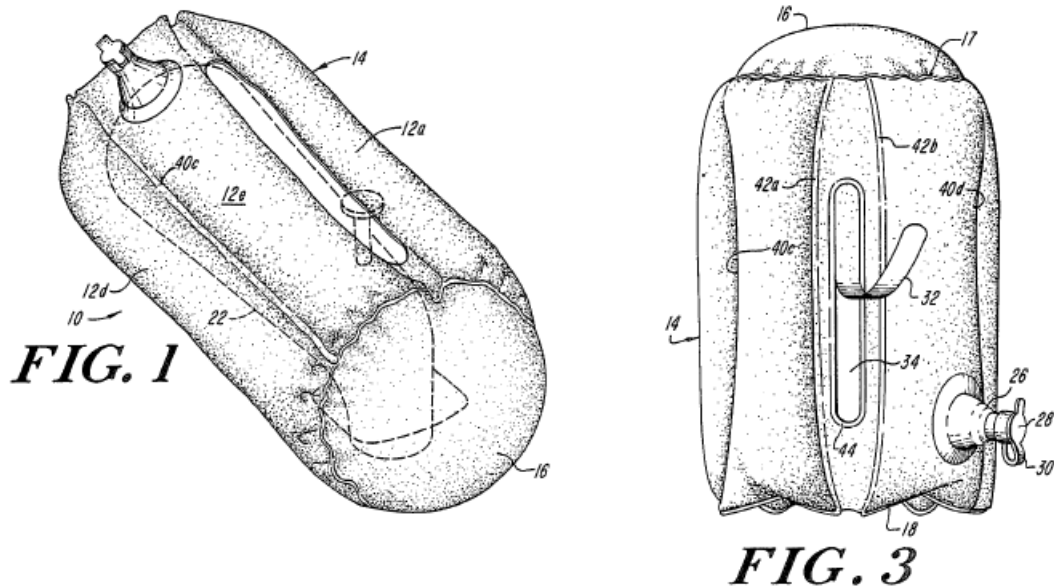
Petitioner contends Thorne discloses strap 26 is connected to side portions 20 and 22 and secures bath spout cover 10 to a bath spout, thereby disclosing “a strap operably connected to the two opposing side portions, said strap for securing the bath spout cover to a bath spout,” as recited in claim 12. Pet. 13 (citing Ex. 1005, Figs. 2, 4, ¶¶ 37, 40).

Next we turn to Petitioner’s contentions with respect to Lerner and Daniels, on which Petitioner relies for allegedly teaching certain claimed features Petitioner argues are not explicitly taught by Thorne.

## *2. Petitioner’s Contentions with Respect to Lerner*

Claim 12 recites that “the upper portion defines an elongated void extending along substantially an entire length of the upper portion.” Petitioner states “Thorne’s elongated void arguably does not extend along *substantially an entire length* of the upper portion.” Pet. 12. Petitioner cites Lerner for teaching such a void. Pet. 12.

Like Thorne, Lerner is also directed to bath spout covers. *See* Ex. 1006, Abstract, 1:5–10. Figures 1 and 3 of Lerner are reproduced below:



Figures 1 and 3 are a perspective view and a top view, respectively, of a bath spout cover according to Lerner. Ex. 1006, 2:10–16. Petitioner argues Lerner discloses void 34 “extends along substantially an entire length of the upper portion” of a bath spout cover. Pet. 12 (citing Ex. 1006, 1:5–20, 1:44–47, 2:55–57, 2:60–62, 4:7–17, Figs. 1, 3).

Petitioner contends a person of ordinary skill in the art at the relevant time would have modified the bath spout cover of Thorne such that the void would extend along substantially an entire length of the upper portion “to obtain the same benefit taught by Lerner—i.e., to allow the spout cover to be used with bath spouts having diverter valves in different positions along their length.” Pet. 12–13 (citing Ex. 1011 § VIII.B.1). Petitioner contends such a modification would have been a combination of known elements to yield a predictable result—namely, “a more-universal spout cover that could be used with more spouts.” Pet. 13 (citing Ex. 1011 § VIII.B.1).

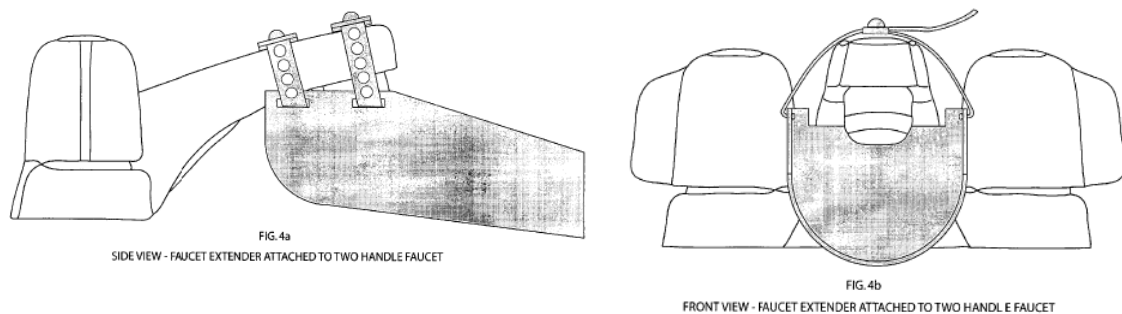
Patent Owner argues Petitioner's proposed modification of Thorne based on the teachings of Lerner fails because Lerner does not disclose a void "extending along substantially an entire length of the upper portion." Prelim. Resp. 12–15, 30. Patent Owner also argues that "[i]t would be impossible to modify the Thorne device in order to incorporate" such an elongated void because Thorne discloses temperature display 24 as part of the upper portion, and removing the temperature display to incorporate such a void "would eviscerate the intent of the device disclosed in Thorne." Prelim. Resp. 31. As such, Patent Owner argues Petitioner has not provided reasoning with rational underpinning to modify Thorne to incorporate an elongated void, as claimed. Prelim. Resp. 31–32.

Patent Owner's argument that the proposed modification of Thorne "would be impossible" is premised on its assertion that the temperature display "is a part of the upper portion of the bath spout cover." Prelim. Resp. 31. However, claim 12 does not prohibit the inclusion of additional components in the claimed "bath spout cover." Therefore, claim 12 does not preclude a bath spout cover, which has an upper portion with an elongated void, from also having a further component "located on the distal portion of the device" and "extend[ing] upward," as Patent Owner characterizes the temperature display of Thorne. *See* Prelim. Resp. 31. With respect to Patent Owner's argument regarding the disclosure of Lerner, we find Petitioner's contention that it would have been obvious to modify Thorne in view of the teachings of Lerner to arrive at "an elongated void extending along substantially an entire length of the upper portion" to be sufficiently supported by evidence in the record and persuasive at this stage of the proceeding.

### *3. Petitioner's Contentions with Respect to Daniels*

Claim 12 further recites “at least one aperture defined by one of the side portions of the body structure, said aperture for receiving an end of the strap.” As explained above, Petitioner relies on Thorne for disclosing a strap used to attach the bath spout cover to a bath spout, but Petitioner states that “Thorne does not disclose exactly how the strap 26 is coupled to the body 12.” Pet. 14. Petitioner cites Daniels for teaching an aperture for receiving a strap. Pet. 14–15.

Daniels is directed to water spout or faucet extenders for sinks. *See* Ex. 1009, Abstract, ¶ 14. Figures 4a and 4b of Daniels are reproduced below:



Figures 4a and 4b are side and front views, respectively, of a water spout extender for use with a double handle faucet. Ex. 1009 ¶ 31.

Petitioner contends that, at the relevant time, a person of ordinary skill in the art would look to other devices with straps, such as the device of Daniels, for teachings of how straps attach, and “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.” Pet. 14 (citing Ex. 1011 § VIII.B.1). Petitioner contends that modifying the bath spout cover of Thorne to include an

aperture through which a strap can pass would have been a combination of known elements to yield a predictable result. *Id.*

Patent Owner asserts “Petitioner fails to present a single reason *why* [Daniels is] analogous to the ‘653 Patent,” and Patent Owner contends Daniels is non-analogous art and, therefore, cannot be relied upon to demonstrate obviousness of the claimed subject matter. Prelim. Resp. 20–24.

As the Federal Circuit has explained,

[t]wo separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

*In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). “A reference is reasonably pertinent if . . . 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.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

We find Petitioner has provided sufficient evidence, at this stage of the proceeding, to show that Daniels is at least reasonably pertinent to the problem of attaching straps to a device, a particular problem with which the ‘653 patent is concerned. For example, Petitioner cites the testimony of Mr. Thuma that a person of ordinary skill in the art would look to other devices with straps to see how straps may be attached to a spout cover. *See* Pet. 14 (citing Ex. 1011 § VIII.B.1). Mr. Thuma provides un rebutted testimony that a person of ordinary skill in the art “would recognize that using a strap that passes through an aperture in a sidewall as described by Daniels would be a suitable and cost effective method of attaching a strap, and would be

appropriate with the bath spout cover of Thorne.” Ex. 1011 § VIII.B.1. Therefore, on the record before us, we find Petitioner has demonstrated that the disclosure in Daniels of using straps passing through an aperture in a sidewall to attach the water spout extender to a water spout or faucet “logically would have commended itself to an inventor’s attention in considering” the problem of attaching straps to a bath spout cover. *See Clay*, 966 F.2d at 659.

Patent Owner also contends Petitioner has not provided reasoning with rational underpinning to modify Thorne to incorporate an aperture for a strap, as claimed. Prelim. Resp. 32–35. Patent Owner argues Petitioner does not provide evidence in support of its assertions that the strap attachment technique of Daniels is a low-cost method, and that such an aperture could even be incorporated into Thorne given the placement of the temperature gauge display and sensor. Prelim. Resp. 34–35. We disagree. Petitioner has proffered the testimony of Mr. Thuma in support of its assertion of obviousness. Mr. Thuma testifies that Daniels’ strap attachment technique would have been a “suitable and cost effective” method applicable to the bath spout cover of Thorne, and he provides testimony showing where the aperture would be included in the modified bath spout of Thorne. Ex. 1011 § VIII.B.1. Mr. Thuma’s testimony is unrebutted at this stage of the proceeding and is evidence that supports Petitioner’s contention of obviousness. On the current record, we are persuaded Petitioner has provided sufficient articulated reasoning with rational underpinning, supported by evidence in the record, to justify its contention of obviousness. *See Pet.* 14–15.

#### *4. Claim 12 Conclusion*

The record before us demonstrates a reasonable likelihood that Petitioner would prevail on its assertion that claim 12 would have been unpatentable over the combination of Thorne, Lerner, and Daniels. *See* Pet. 11–15.

#### *5. Dependent Claims 13 and 14*

At this stage in the proceeding, Patent Owner does not address separately Petitioner’s explanations and supporting evidence with respect to dependent claims 13 and 14. *See generally* Prelim. Resp. 12–25, 30–35. Based on our review of Petitioner’s explanations and supporting evidence, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertions that dependent claims 13 and 14 would have been unpatentable over the combination of Thorne, Lerner, and Daniels. *See* Pet. 16–17.

#### *E. Unpatentability of Claims 12–14 Based on Thorne, Lerner, and Lister*

Petitioner also contends claims 12–14 would have been obvious over the combination of Thorne, Lerner, and Lister. Pet. 2, 17–22. In this ground of unpatentability, Petitioner relies on its contentions with respect to Thorne and Lerner, discussed above, and relies on Lister, rather than Daniels, for teaching an aperture for receiving a strap. Pet. 17–22. Because we find Petitioner’s contentions with respect to Thorne and Lerner persuasive at this stage, as discussed above, we focus our discussion on Petitioner’s contentions as to Lister and its rationale to combine the references.



*1. Petitioner's Contentions with Respect to Lister*

Petitioner cites Lister for teaching “at least one aperture defined by one of the side portions of the body structure, said aperture for receiving an end of the strap,” as recited in claim 12. Pet. 18–20.

Lister is directed to a seat-like device used for supporting an infant for bathing, feeding, sleeping, and sitting. Ex. 1007, Abstract, 1:6–8, Fig. 1.

Figure 1 of Lister is reproduced below:

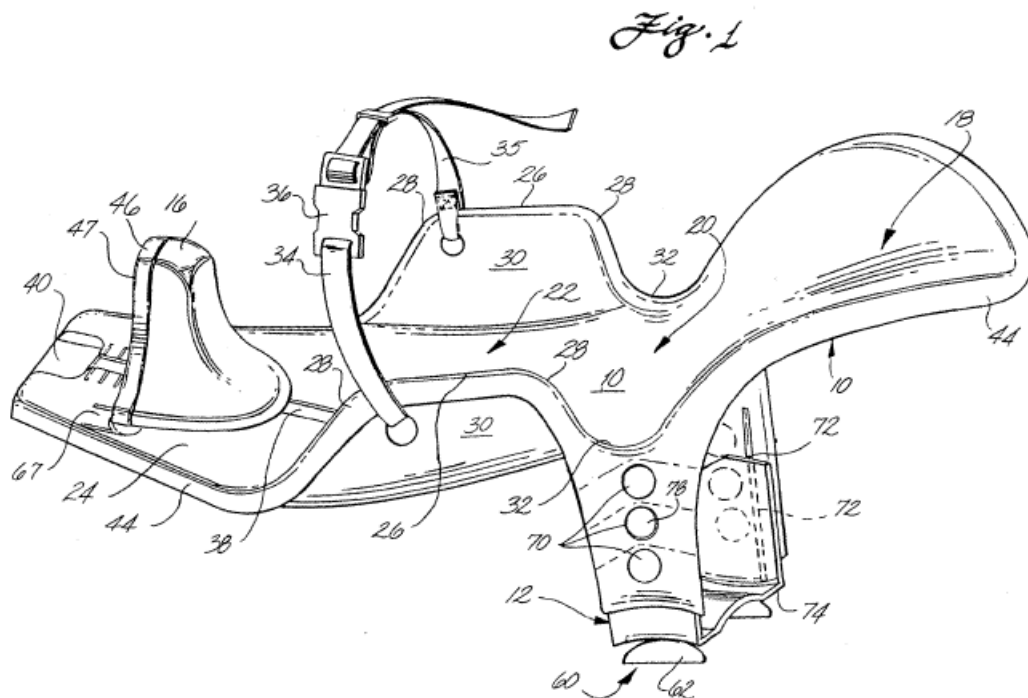


Figure 1 is a view of the seat-like device showing straps 34 and 35 passing through openings on surfaces 30 on either side of the device. Ex. 1007, 2:7, 2:27–3:4.

Petitioner contends that, at the relevant time, a person of ordinary skill in the art would look to other devices with straps, such as the device of Lister, for teachings of how straps attach, and “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.” Pet. 18–19 (citing Ex. 1011 § VIII.A.1). Petitioner contends that modifying the bath spout cover of Thorne to include an aperture through which a strap can pass would have been a combination of known elements to yield a predictable result. *Id.*

As with Daniels, Patent Owner asserts Lister is non-analogous art. Prelim. Resp. 20–22, 24–25. We find Petitioner has provided sufficient evidence, at this stage of the proceeding, to show that Lister is at least reasonably pertinent to the problem of attaching straps to a device, a particular problem with which the ’653 patent is concerned. For example, Petitioner cites the testimony of Mr. Thuma that a person of ordinary skill in the art would look to other devices with straps to see how straps may be attached to a spout cover. *See* Pet. 18–19 (citing Ex. 1011 § VIII.A.1). Mr. Thuma provides unrebutted testimony that a person of ordinary skill in the art “would recognize that using a strap that passes through an aperture in a sidewall as described by Lister would be a suitable and cost effective method of attaching a strap, and would be appropriate with the bath spout cover of Thorne.” Ex. 1011 § VIII.A.1. Therefore, on the record before us, we find Petitioner has demonstrated that the disclosure in Lister of using straps passing through an aperture in a sidewall to support an infant in a seat-like device “logically would have commended itself to an inventor’s attention in considering” the problem of attaching straps to a bath spout cover. *See Clay*, 966 F.2d at 659.

Similar to its argument with respect to Daniels, Patent Owner also contends Petitioner has not provided reasoning with rational underpinning to modify Thorne to incorporate an aperture for a strap, as taught by Lister, and

has not provided evidence in support of its assertion that the strap attachment technique of Lister is a low-cost method. Prelim. Resp. 36. We disagree. Petitioner has proffered the testimony of Mr. Thuma in support of its assertion of obviousness. Mr. Thuma testifies that Lister's strap attachment technique would have been a "suitable and cost effective" method applicable to the bath spout cover of Thorne. Ex. 1011 § VIII.A.1. Mr. Thuma's testimony is unrebutted at this stage of the proceeding and is evidence that supports Petitioner's contention of obviousness. On the current record, we are persuaded Petitioner has provided sufficient articulated reasoning with rational underpinning, supported by evidence in the record, to justify its contention of obviousness. *See* Pet. 18–20.

## *2. Claim 12 Conclusion*

The record before us demonstrates a reasonable likelihood that Petitioner would prevail on its assertion that claim 12 would have been unpatentable over the combination of Thorne, Lerner, and Lister. *See* Pet. 17–20.

## *3. Dependent Claims 13 and 14*

At this stage in the proceeding, Patent Owner does not address separately Petitioner's explanations and supporting evidence with respect to dependent claims 13 and 14. *See generally* Prelim. Resp. 12–25, 36. Based on our review of Petitioner's explanations and supporting evidence, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertions that dependent claims 13 and 14 would have been unpatentable over the combination of Thorne, Lerner, and Lister. *See* Pet. 20–22.

*F. Unpatentability of Claims 15–21 Based on  
Thorne, Lister, and Morris*

Petitioner contends claims 15–21 would have been obvious over the combination of Thorne, Lister, and Morris. Pet. 2, 30–37. Petitioner explains how the cited prior art references allegedly teach the claimed subject matter and relies upon the Thuma Declaration to support its positions. Pet. 30–37.

*1. Petitioner’s Contentions with Respect to Thorne and Lister*

Petitioner relies on Thorne for teaching a “bath spout cover” having “a body structure with an exterior facing surface, the body structure having an upper portion, two opposing side portions, and a front portion,” as well as “a receiving area defined between the upper portion, the two opposing side portions, and the front portion.” Pet. 22–23, 30. Petitioner’s contentions with respect to these limitations are similar to its contentions with respect to similar recitations in claim 12, and, therefore, we refer to our discussion of Thorne with respect to claim 12 above.

Petitioner also contends Thorne teaches “a strap spanning the two opposing side portions,” and further teaches that the strap is “for securing the bath spout cover to a bath spout,” as recited in claim 15. Pet. 30–31, 34 (citing Ex. 1005, Figs. 2, 4, ¶¶ 37, 40). Similar to its contention with respect to claim 12, Petitioner states that “Thorne does not disclose exactly how the strap 26 is coupled to the body 12.” Pet. 31. Petitioner cites Lister for teaching “at least one aperture through one of the side portions, and a strap spanning the two opposing side portions and traversing the at least one aperture,” as recited in claim 15. Pet. 31–33. Petitioner’s contentions with respect to these limitations are similar to its contentions with respect to

similar recitations in claim 12, and, therefore, we refer to our discussion of Lister with respect to claim 12 above.

## 2. *Petitioner's Contentions with Respect to Morris*

Claim 15 further recites:

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.

Petitioner states that the strap in Lister does not have “the claimed end portion.” Pet. 33. Petitioner cites Morris for teaching an enlarged end portion of a strap abutting a surface to hold the strap in place. Pet. 34.

Morris is directed to a child safety seat for use in a motor vehicle. Ex. 1008, Abstract, 1:2–6. Figures 1 and 2 of Morris are reproduced below:

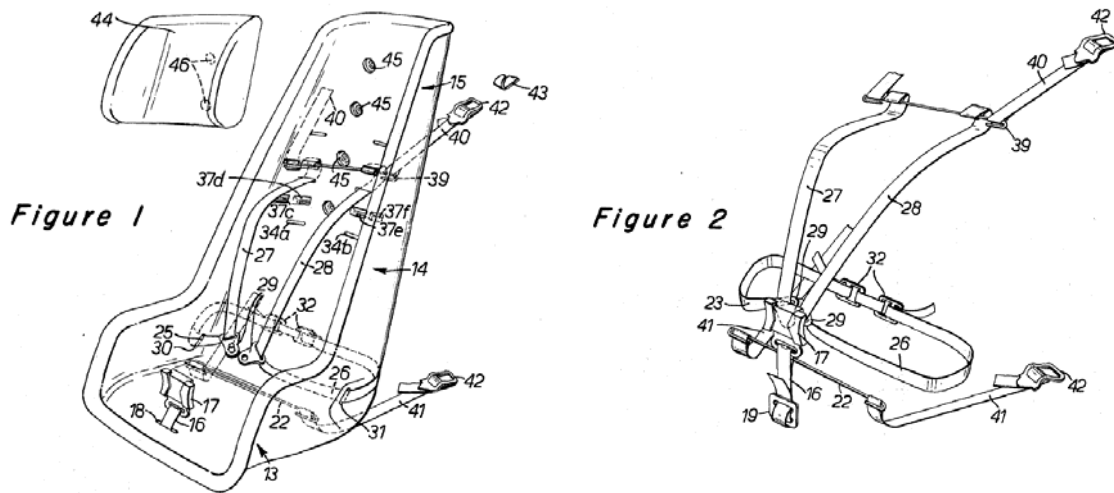


Figure 1 “is a front perspective view of the child’s seat showing a body harness in the released state and mounting straps for mounting the seat in a vehicle,” and Figure 2 “is a spatial view of the harness and mounting straps.” Ex. 1008, 1:35–40. Morris discloses that “[t]he end of the crotch strap [16]

on the underside of the seat can be threaded through a friction buckle 19 which is too large to be pulled through the slot.” Ex. 1008, 2:9–12.

Petitioner contends that, at the relevant time, a person of ordinary skill in the art would look to other devices with straps, such as the device of Morris, for teachings of how straps attach, and “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.” Pet. 34 (citing Ex. 1008, 2:4–23; Ex. 1011 § IX.A.1). Petitioner contends that using the strap end portion of Morris in the combination of Thorne and Lister would have been a combination of known elements to yield a predictable result. *Id.* at 33–34.

Patent Owner argues that “[i]t is not the ‘end of the crotch strap’ that is ‘too large to be pulled through the slot’” but, rather, friction buckle 19, which “is an entirely separate piece.” Prelim. Resp. 20. Therefore, according to Patent Owner, Morris does not disclose “an end portion of the strap having a dimension larger than a dimension of the aperture,” as recited in claim 15. Prelim. Resp. 19–20. We disagree. Morris discloses “crotch strap 16 designed to extend downwardly from a quick release buckle 17 located near the abdomen of the seat occupant, the crotch strap passing freely through a laterally extending horizontal slot 18 in the bottom of the seat shell.” Ex. 1008, 2:5–9. Figure 1 depicts that the width (a dimension) of the strap is larger than the narrowest dimension of slot 18. Therefore, on the current record, we are persuaded Morris discloses “an end portion of the strap having a dimension larger than a dimension of the aperture,” as recited in claim 15.

As to Patent Owner's contention that friction buckle 19, which is separate from the strap, is what holds the strap in place (Prelim. Resp. 20), we do not interpret claim 15 to prohibit the inclusion of additional components, such as a buckle. On the record before us, we are persuaded by Petitioner's explanation that

using the enlarged end portion of Morris in the Thorne/Lister combination would result in the enlarged end portion extending through the aperture from Lister and along the exterior facing surface of the Thorne body 12, with the enlarged end abutting the exterior facing surface of the Thorne body 12 to hold the strap in place.

Pet. 34 (citing Ex. 1011 § IX.A.1).

As with Daniels and Lister, Patent Owner also asserts Morris is non-analogous art. Prelim. Resp. 20–22, 24–25. We find Petitioner has provided sufficient evidence, at this stage, to show that Morris is at least reasonably pertinent to the problem of attaching straps to a device, a particular problem with which the '653 patent is concerned. For example, Petitioner cites the testimony of Mr. Thuma that a person of ordinary skill in the art would look to other devices with straps to see how straps may be attached to a spout cover, such as that disclosed in Thorne. *See* Pet. 33 (citing Ex. 1011 § IX.A.1). Mr. Thuma provides unrebutted testimony that a person of ordinary skill in the art “would recognize that using the Morris end portion which is ‘too large to be pulled through the slot’ would [] be a suitable and cost effective method of attaching a strap, and would be appropriate with the Thorne/Lister combination.” Ex. 1011 § IX.A.1. Therefore, on the record before us, we find Petitioner has demonstrated that the disclosure of Morris “logically would have commended itself to an inventor's attention in

considering” the problem of attaching straps to a bath spout cover. *See Clay*, 966 F.2d at 659.

Similar to its arguments with respect to Daniels and Lister noted above, Patent Owner also contends Petitioner has not provided reasoning with rational underpinning for relying on the teachings of Morris in combination with Thorne and Lister, and has not provided evidence in support of its assertion that the strap attachment technique of Morris is a low-cost method. Prelim. Resp. 37–38. We disagree. Petitioner has proffered the testimony of Mr. Thuma in support of its assertion of obviousness. Mr. Thuma testifies that Morris’s strap attachment technique would have been a “suitable and cost effective” method applicable to the combined teachings of Thorne and Lister. Ex. 1011 § IX.A.1. Mr. Thuma’s testimony is unrebutted at this stage of the proceedings and is evidence that supports Petitioner’s contention of obviousness. On the current record, we are persuaded Petitioner has provided sufficient articulated reasoning with rational underpinning, supported by evidence in the record, to justify its contention of obviousness. *See Pet.* 33–34.

### *3. Claim 15 Conclusion*

The record before us demonstrates a reasonable likelihood that Petitioner would prevail on its assertion that claim 15 would have been unpatentable over the combination of Thorne, Lister, and Morris. *See Pet.* 30–35.

### *4. Dependent Claims 16–21*

At this stage in the proceeding, Patent Owner does not address separately Petitioner’s explanations and supporting evidence with respect to dependent claims 16–21. *See generally* Prelim. Resp. 19–25, 37–38. Based



on our review of Petitioner’s explanations and supporting evidence, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertions that dependent claims 16–21 would have been unpatentable over the combination of Thorne, Lister, and Morris. *See* Pet. 34–37.

*G. Unpatentability of Claims 15–21 Based on  
Thorne and Daniels*

Petitioner contends independent claim 15 and dependent claims 16–21 would have been obvious over Thorne and Daniels. Pet. 2, 22–30. Claim 15 recites, *inter alia*,

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.

Petitioner relies on Figure 5b of Daniels to teach this limitation, and Petitioner provides the following annotated figure:

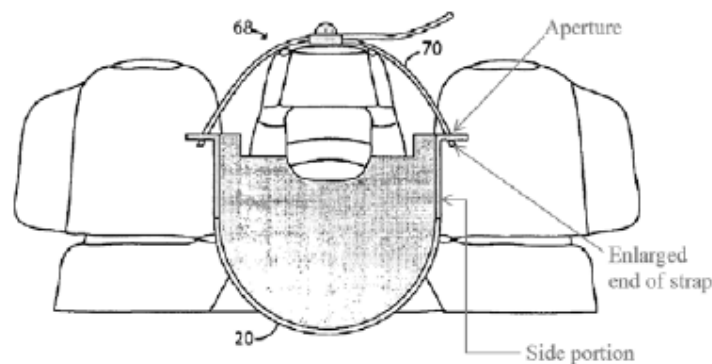


FIG. 5b  
**Annotated Daniels FIG. 5b**

Pet. 25–26. The figure reproduced above is an annotated version of Figure 5b of Daniels identifying an alleged “Enlarged end of strap.” Pet. 26.

Petitioner contends that it is the “enlarged end” of the strap that holds the strap in place. Pet. 26.

Figure 5b itself does not appear to show such an enlarged end. Petitioner argues that, in Daniels, “the strap supports the device 10 from the spout, which could not happen if the strap were allowed to separate from the device 10.” Pet. 26 n.18. However, as Patent Owner points out, there are other ways in which the strap could be attached to the water spout. *See* Prelim. Resp. 16. Petitioner’s declarant does not provide additional testimony to support Petitioner’s contention that the strap in Figure 5b is held in place by an enlarged end. *See* Ex. 1011 § IX.B.1 (pages 36–37) (reproducing same annotated Figure 5b).

We are not persuaded Petitioner has demonstrated Figure 5b of Daniels depicts an enlarged end of the strap holding the strap in place. Because Petitioner’s unpatentability challenge to claim 15 based on the combination of Thorne and Daniels relies on this alleged disclosure of Daniels, we determine the record before us does not establish a reasonable likelihood Petitioner would prevail in challenging claim 15, or dependent claims 16–21, as obvious over Thorne and Daniels.

#### IV. CONCLUSION

For the foregoing reasons, taking into account the arguments presented in the Preliminary Response, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in showing that claims 12–21 of the ’653 patent are unpatentable under 35 U.S.C. § 103(a). However, we have not made a final determination with respect to the patentability of these challenged claims.

## V. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 12–21 of the '653 patent on the following grounds:

- A. Claims 12–14 as unpatentable under U.S.C. § 103(a) over the combination of Thorne, Lerner, and Daniels;
- B. Claims 12–14 as unpatentable under U.S.C. § 103(a) over the combination of Thorne, Lerner, and Lister; and
- C. Claims 15–21 as unpatentable under U.S.C. § 103(a) over the combination of Thorne, Lister, and Morris;

FURTHER ORDERED that no grounds of unpatentability are authorized for this *inter partes* review other than those specifically identified above;

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

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Patent 9,060,653 B2

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