

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FITBIT, INC.,  
Petitioner,

v.

ALIPHCOM, INC. D/B/A JAWBONE,  
Patent Owner.

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Case IPR2016-00607  
Patent 8,529,811 B2

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Before CHRISTOPHER L. CRUMBLEY, JON B. TORNQUIST, and  
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71(d)*

Petitioner Fitbit, Inc. requests rehearing of our Decision instituting an *inter partes* review trial of claims 16–26 of U.S. Patent No. 8,529,811 B2 (Ex. 1001), but denying institution of trial as to claims 1–15. Paper 16,

“Req. Reh’g.” In its Petition, Fitbit asserted several grounds of unpatentability challenging claims 1–15, each based on the combination of the Anderson<sup>1</sup> reference with other prior art. Our Decision reviewed Fitbit’s contentions regarding Anderson, found that the record did not support Fitbit’s interpretation of the reference, and as a result determined that Fitbit had not established a reasonable likelihood that claims 1–15 were unpatentable. Paper 14 (“Dec.”) 19–25.

In its Request, Fitbit contends that our Decision overlooked several portions of the disclosure of Anderson, as well as the testimony of Fitbit’s expert witness, Dr. Darran Cairns. Fitbit asks that we grant rehearing and institute trial as to claims 1–15. Req. Reh’g 4.

For the reasons that follow, the request is *denied*.

#### STANDARD OF REVIEW

When rehearing a decision on a petition to institute an *inter partes* review trial, the Board “will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “An abuse of discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors.” *Lacavera v. Dudas*, 441 F.3d 1380, 1383 (Fed. Cir. 2006) (quoting *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005)). The party requesting rehearing has the burden of showing the decision should be modified, and “[t]he request must

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<sup>1</sup> U.S. Patent Publication No. 2009/0047797 A1 (Feb. 19, 2009) (Ex. 1004).

specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

### ANALYSIS

Fitbit argues that, in declining to institute an *inter partes* review trial as to claims 1–15, we overlooked three aspects of the record that support its interpretation of Anderson. First, Fitbit contends we overlooked Figure 7h of Anderson. Req. Reh’g 4–9. Second, Fitbit argues that we failed to take into account the entirety of paragraph 44 of Anderson, and overlooked language supporting Fitbit’s position. *Id.* at 9–11. Finally, Fitbit contends that we overlooked the testimony of Dr. Darran Cairns (Ex. 1002) as to what a person of ordinary skill in the art would have understood from the disclosure of Anderson. Req. Reh’g 11–12. We disagree on all three counts.

Before addressing Fitbit’s contentions, we summarize the relevant facts. In our Decision, we found that Anderson did not support Fitbit’s contention that Anderson discloses a “second inner molding that covers all or substantially all of the first inner molding,” as required by claim 1. Dec. 22. Specifically, we disagreed with Fitbit’s analysis that the “filler material 44” of Anderson (alleged to be the second inner molding of claim 1) covers all or substantially all of the tamper resistant coating 43 (alleged to be the first inner molding). *Id.* Our conclusion was supported, in part, by Figure 6b of Anderson, reproduced below:

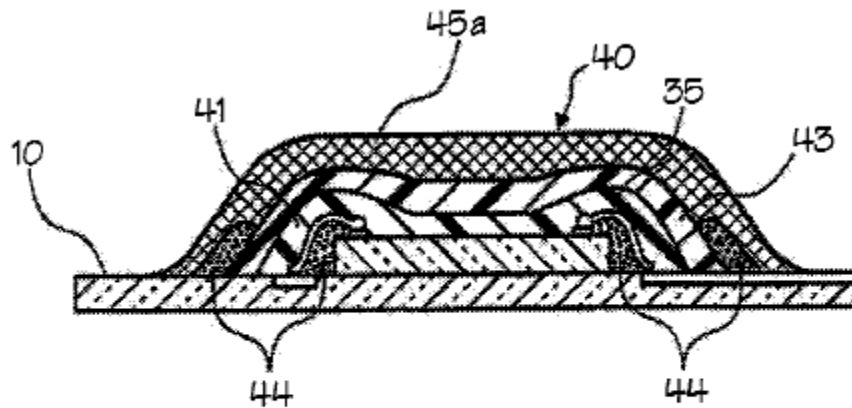


Fig. 6b  
(SIDE VIEW)

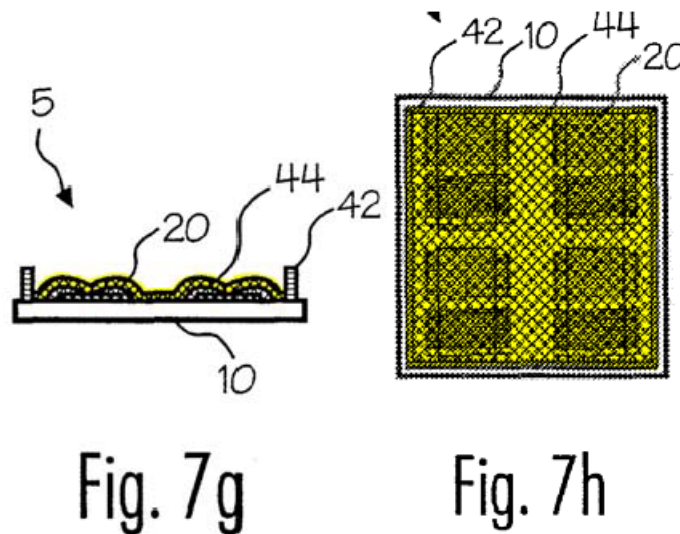
Figure 6b of Anderson depicts substrate 10 with die (not numbered) having electrical connectors 35, covered by intermediate primer coating layer 41, tamper resistant coating 43, encapsulant material 45a, and filler material 44.

We noted that “[a]s evidenced by Figure 6b, filler material [44] adjoins a small portion of the bottom of the die and tamper resistant coating 43, the alleged first inner molding. This is not ‘covering all or substantially all’ of the tamper resistant coating, as required by claim 1.” *Id.* at 22–23. We noted that Figure 7 of Anderson—relied on by Fitbit—did not convince us otherwise. *Id.* at 23. Our Decision focused on Figure 7g, but did not specifically mention Figure 7h, which is a top-down view of Figure 7g. *Id.* We also noted that paragraph 44 of Anderson discloses that the filler material “reside[s] in the gaps and/or air pockets previously located in [tamper resistant coating] 43 coated circuit,” further supporting our interpretation of Anderson’s disclosure. *Id.* at 22. We concluded that “the filler material is poured over the underlying layer of tamper resistant

coating, but flows down and around the layer to fill any gaps between it and the circuit below.” *Id.*

A. *The Board Did Not Overlook Figure 7h of Anderson*

Fitbit’s Request first notes that its Petition presented highlighted copies of Figures 7g and 7h, reproduced below, to illustrate its argument regarding Anderson:



Figures 7g and 7h depict two views (profile and top-down, respectively) of a step in the formation of the apparatus shown in Figure 6b, with highlighting of the top layer of the apparatus added by Fitbit.

Fitbit argues that “the Decision did not address Figure 7h . . . in which item 44 is identified by the same cross-hatching” as in Figure 7g, and contends that the figure “plainly depicts item 44 covering all of the underlying tamper resistant coating, not merely the underlying spaces identified in the Decision.” Req. Reh’g 7. According to Fitbit, we overlooked Figure 7h.

We disagree. In rendering a decision, the Board is not required to “address every argument raised by a party or explain every possible reason supporting its conclusion.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1322 (Fed. Cir. 2016). For this reason alone, Fitbit’s presumption that we overlooked Figure 7h, merely because we did not specifically address it in the Decision, lacks merit. Nevertheless, we address Figure 7h below.

In our Decision, we compared Figures 7g and 7c of Anderson, and concluded that Fitbit’s highlighting of the outer layer of Figure 7g was in error. Dec. 23–24. Figure 7h merely depicts another view of Figure 7g, and does not alter our conclusion that the layer highlighted by Fitbit is in fact tamper resistant coating 43, despite it not being numbered in Figures 7g or 7h. Fitbit argues that the cross-hatching added to Figure 7h is a “layer labeled as item 44” and “covers all of the previously deposited tamper resistant coating 43 in Figure 7d.” Req. Reh’g 7 n.1. We disagree, for the same reasons we disagreed with Fitbit’s interpretation of Figure 7g. The cross-hatching of Figure 7h may be a draftsman’s error, or could signify that filler material 44 now resides under previously-deposited layer 43. What is clear from the Figures, however, is that no upper layer has been added between Figures 7c (where layer 43 is deposited) and 7g. Figure 7h does not change this fact.

Nor does Figure 7h alter the disclosure of Figure 6b, which is the clearest depiction of the embodiment relied on in the Petition. We note that Fitbit’s Request is silent as to Figure 6b, which shows the end result of the method depicted in Figure 7. Whatever the disclosure of Figure 7h may be,

it does not alter the unambiguous disclosure of Figure 6b, which shows that filler material 44 does not “cover all or substantially all” of tamper resistant coating 43. Figure 7h does not convince us that we abused our discretion in declining to institute trial as to claims 1–15.

*B. The Board Did Not Overlook Paragraph 44 of Anderson*

Fitbit also contends that while our Decision “emphasized a sentence from Anderson’s paragraph 44,” it also “overlooked language from this same paragraph indicating that (consistent with the disclosure of Figure 7h) the filler material coating *also* covers all or substantially all of the surface of the tamper resistant coating.” Req. Reh’g 9. Again, the fact that our Decision focused on one aspect of paragraph 44 does not imply that we overlooked the entirety of the paragraph, or the entirety of Anderson, for that matter. Nevertheless, we address these additional disclosures below.

Fitbit raises two disclosures in paragraph 44. First, Anderson states that after filler material 44 is deposited, the method “continues by applying shell coating 45a to coat circuit 5 overlying filler material 44.” Ex. 1004 ¶ 44. Fitbit argues that if our interpretation were correct, and filler material only resides under tamper resistant coating 43, any newly added layer (such as shell coating 45a) would not be “overlying” filler material 44. Req. Reh’g 10.

Second, Anderson discloses that applying outer shell coating 45a, “having a higher viscosity than filler material 44,” results in “a more rigid outer surface than could be achieved with filler material 44 alone.” Ex. 1004 ¶ 44. According to Fitbit, if filler material 44 “were merely under [tamper

resistant] coating [43], it would not form an ‘outer surface’ prior to the application of the outer shell 45a.” Req. Reh’g 11.

Neither of these disclosures, however, contradicts the clear statement in the same paragraph that “filler material 44 resides in the gaps and/or air pockets previously located in [tamper resistant coating] 43.” Ex. 1004 ¶ 44. This sentence is supported elsewhere in the specification, where Anderson describes the filler material as “having a low viscosity to saturate and fill spaces around” the tamper resistant coating, as well as a “wicking property to reach and fill gaps in the [tamper resistant coating] coated circuit.” *Id.* ¶ 39. The filler material “is preferably a very low viscosity, low stress epoxy material that: (i) flows easily and wicks up to fill gaps or spaces; and (ii) adheres to integrated circuit passivation materials.” *Id.* ¶ 41. Nowhere in paragraph 44 does Anderson disclose explicitly that the filler material 44 covers the entirety of tamper resistant coating 43; indeed, as noted above, this is directly contradicted by Figure 6b.

The sentences cited by Fitbit did not convince us otherwise when we reviewed the record when rendering our Decision. As to the first sentence, the statement that coating 45a “overlies” filler material 44 means that the coating is located over the filler material; it does not speak to whether there are intervening layers between them, or whether material 44 covers all or substantially all of layer 43. For example, Figure 6b shows layer 45 directly on top of *portions* of material 44 (and thus “overlying” it), but does not show material 44 covering all or substantially all of layer 43. Second, Anderson’s statement that coating 45a creates a “more rigid outer surface than could be achieved with filler material 44 alone” again does not require that filler



material 44 be the outer surface. Anderson is stating that the inclusion of outer layer 45a results in a more rigid outer surface than if the process were stopped at the deposition of filler material 44, where the outer surface would be tamper resistant coating 43 with its gaps or spaces filled with material 44. Neither of these sentences altered our understanding of Anderson, and do not convince us that we abused our discretion in declining to institute trial as to claims 1–15.

*C. The Board Did Not Overlook Dr. Cairns' Testimony*

Finally, Fitbit notes that while we credited and relied upon the testimony of its expert witness Dr. Cairns in other portions of the Decision, we did not do so when it came to his testimony on Anderson. Req. Reh'g 12. From this, Fitbit argues that we overlooked Dr. Cairns' testimony.

We did not. In reaching our Decision, we evaluated the entirety of Dr. Cairn's testimony, and as Fitbit notes, credited it in certain aspects. With respect to Anderson, however, Dr. Cairns' testimony is contrary to the disclosure of the reference, as detailed above. Dr. Cairns does not explain why filler material 44, in his opinion, “covers all or substantially all” of tamper resistant coating 43, other than one cell of his claim chart spanning pages 52–54 of his Declaration. Ex. 1002 ¶ 69. Notably, Dr. Cairns relies only on Figures 7g, 7h, and 6b, as well as the portions of paragraphs 39–41 of Anderson's written description, which we discussed above. *Id.* Dr. Cairns does not address paragraph 44 of Anderson.

Fitbit argues that “[a]t a minimum, Dr. Cairns' opinion raises a factual dispute that is best resolved on the merits during trial rather than at the institution stage.” Req. Reh'g 12. We disagree. Expert testimony does not

create a factual dispute requiring institution of trial, merely because it states something at odds with the clear disclosure of a prior art reference. This is especially the case here, where the expert's testimony is a conclusion about the disclosure of the reference, based only on citations to the reference and unaccompanied by any testimony regarding why a person of ordinary skill in the art would have interpreted the reference in the manner asserted. Dr. Cairns' testimony does not convince us that our decision not to institute trial on claims 1–15 was an abuse of discretion.

### CONCLUSION

For the foregoing reasons, our interpretation of the disclosure of Anderson—and in particular, the location of its filler material 44—was based on substantial evidence. Accordingly, our determination that the Petition, Preliminary Response, and accompanying evidence did not establish a reasonable likelihood of success as to claims 1–15 was not an abuse of discretion.

### ORDER

Accordingly, it is  
ORDERED that Fitbit's request for rehearing is *denied*.

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