

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE BURTON CORPORATION,
Petitioner,

v.

SMITH SPORT OPTICS, INC. and KOROYD SARL,
Patent Owner.

IPR2022-00354
Patent 10,736,373 B2

Before LYNNE H. BROWNE, SCOTT A. DANIELS, and
NEIL T. POWELL, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of Decision
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(c), (d)

I. INTRODUCTION

The Burton Corporation (“Petitioner”) filed a Request for Rehearing (Paper 10, “Request” or “Req.”) of our Decision (Paper 9, “Decision Denying Institution” or “Dec.”) not to institute an *inter partes* review of claims 1–5, 7, 12, 13, and 15–17 (the “challenged claims”) of U.S. Patent No. 10,736,373 B2 (Ex. 1001). For the reasons that follow, Petitioner’s Request is *denied*.

II. STANDARD OF REVIEW

On request for rehearing, “[t]he burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). “The request must 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, reply, or a sur-reply.” *Id.* When rehearing a decision on a petition, we review the decision for abuse of discretion. 37 C.F.R. § 42.71(c). It is not an abuse of discretion to have performed an analysis or reached a conclusion with which a party disagrees. An abuse of discretion occurs if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004).

III. DISCUSSION

In our Decision Denying Institution, we determined that Petitioner did not demonstrate a reasonable likelihood of success in establishing

unpatentability of the challenged claims as obvious over Muskovitz and Sajic. Dec. 9, 34. Specifically, we determined that “Petitioner does not show sufficiently that it would have been obvious to omit outer layers [of sealing material] from Sajic’s energy absorbing tubes and insert them in the recess of Muskovitz’s liner” as proposed by Petitioner. *Id.* at 31. In reaching that determination, we found that Sajic discloses providing a sealing material to prevent foam from entering the tubes’ open ends, “without qualification” as to when such prevention would be necessary. *Id.* at 31–33 (citing Ex. 1006 ¶¶ 114–117, 122). That is, we found that Sajic discloses providing the sealing material regardless of whether the energy absorbing tubes are positioned in the foam spacing member during its formation or inserted after formation of the spacing member. *Id.* We rejected Mr. Copeland’s opinion that Sajic only uses sealing material to prevent foam from entering the tubes during formation of the helmet. *Id.* at 32 (citing Ex. 1003 ¶ 116).

Petitioner contends we overlooked that “Dr. Bonin neither supported the Board’s understanding of Sajic nor refuted Mr. Copeland’s testimony,” and that we misapprehended Sajic’s disclosure. Req. 4. Specifically, Petitioner argues that Dr. Bonin does not refute Mr. Copeland’s opinion that Sajic’s sealing material is only necessary when the energy absorbing tubes are encapsulated during formation of the helmet. *Id.* at 4, 6. In the same vein, Petitioner argues that Dr. Bonin does not refute Petitioner’s obviousness rationale for omitting the sealing material in the proposed Muskovitz-Sajic combination—that ““there is no need to prevent foam from entering the EAT-Insert-Member’ when inserted in Muskovitz’s *formed*

foam liner.” *Id.* at 5–6 (quoting Ex. 1003 ¶ 116), 8, 10. According to Petitioner, Dr. Bonin stops short of opining that Sajic’s sealing material would be needed to prevent foam from entering energy absorbing tubes inserted after formation of the helmet. *Id.* at 4, 6.

We are not persuaded that we overlooked Dr. Bonin’s testimony or misapprehended Sajic’s disclosure. As an initial matter, to the extent that Petitioner argues refuting testimony by Dr. Bonin was required for us reach our conclusion, we disagree. A patent owner has no obligation to rebut the petitioner’s contentions or to submit an expert declaration rebutting the petitioner’s expert testimony. *See* 37 C.F.R. §§ 42.107(a) (“The patent owner *may* file a preliminary response to the petition.” (emphasis added)); 42.108(c) (“The Board’s decision will take into account a patent owner preliminary response *where such a response is filed, including any testimonial evidence.*” (emphasis added)). And the Board is not required to accept every statement made by a petitioner’s expert in the absence of opposing expert testimony. *FanDuel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1344 (Fed. Cir. 2020). Instead, “it is the Board’s duty to independently assess the strength of a petitioner’s argument and evidence.” *Id.*, *see also id.* at 1342 (“We . . . reject FanDuel’s suggestion that the patent owner’s failure to put forth rebuttal evidence regarding the substance of the references’ disclosures in any way limited the Board’s ability to decide for itself what the references would teach or suggest to a person of skill in the art.”); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015) (“No rule requires . . . an expert guiding the Board as to how it should read prior art. . . . Board members, because of expertise, may more often find it

easier to understand and soundly explain the teachings and suggestions of the prior art without expert assistance.”).

Indeed, we mainly relied on the express disclosure of Sajic, rather than Dr. Bonin’s testimony, in reaching our conclusion that the evidence before us did not support Petitioner’s reasons to deviate from Sajic’s usage of sealing material on the energy absorbing tubes. *See* Dec. 31–33. Even if we were to accept Petitioner’s characterizations of Dr. Bonin’s testimony, what Dr. Bonin *does not* say does not change our view of what Sajic *does* say—that the energy absorbing tube “inserts 120, 122, 124 may be positioned during forming of the spacing member 110 or inserted afterwards,” and that “[a] sealing material . . . is provided at both . . . discontinuous surfaces” of the energy absorbing tube insert in either case, to “prevent[] the foam material from entering the open ends of the tubes.” Ex. 1006 ¶¶ 116, 122.

Petitioner further contends Patent Owner’s argument that “[u]se of the honeycomb core of the Sajic Application without the ‘sealing material’ would, over time, allow for penetration of the ends of the honeycomb core into the foam liner of Muskovitz” (Prelim. Resp. 32 (citing Ex. 2002, 70)) is “attorney argument unsupported by Dr. Bonin [that] should have been accorded no weight to the extent the Board relied on it.” Req. 7–8; *see id.* at 10. Notwithstanding Petitioner’s own reference to Sajic’s energy absorbing tube inserts as “honeycomb inserts” (Pet. 10), Petitioner argues that Sajic’s arrays of circular tubes with separate but abutting walls are not “honeycombs” with shared side-walls and cannot be conflated with such. Req. 7–8. Petitioner’s arguments are unavailing because, as discussed

above, our conclusion was predominantly guided by Sajic's disclosure, rather than Patent Owner's argument and evidence regarding penetration of honeycombs into foam. *See* Dec. 31–33.

Petitioner contends that we misapprehended Dr. Bonin's testimony "[i]n finding that Dr. Bonin's testimony was consistent with the Board's understanding that 'Sajic includes its sealing material for more than just keeping foam out of the energy absorbing tubes during formation of the helmet.'" Req. 8. Petitioner mischaracterizes "the Board's understanding." *Id.* We stated that "[o]ur understanding of *Sajic* [that Sajic discloses using the sealing material to prevent foam from penetrating the energy absorbing tubes at any time] is consistent with *Dr. Bonin's testimony* that Sajic includes its sealing material for more than just keeping foam out of the energy absorbing tubes during formation of the helmet." Dec. 33 (emphases added) (citing Ex. 2001 ¶ 93). Again, we relied primarily on Sajic's disclosure, not Dr. Bonin's testimony, in determining that Petitioner failed to sufficiently show it would have been obvious to omit the sealing material. Dec. 31–33. We found Sajic's disclosure to be clear and noted that it was consistent with Dr. Bonin's testimony. *Id.* at 33. Petitioner argues that Dr. Bonin's testimony regarding benefits of sealing the tubes' ends is not credible (Req. 8–9), but even if we were to assume Dr. Bonin's testimony is not credible (which we do not), that does not change our determination based on Sajic's disclosure.

Petitioner contends Patent Owner's arguments regarding "intended function" and "predictable result" are "replete with mischaracterizations of the Petition, the prior art and the evidence, and misleading citations," and

that we misapprehended Patent Owner’s arguments and evidence and the law “[t]o the extent the Board relied on these arguments.” Req. 14; *see id.* at 9–14 (citing Prelim. Resp. 36). Petitioner argues that “the Board does not explain how the omission of sealing material impacts ‘Petitioner’s allegations regarding intended functions, predictability, and benefits.’”

Id. at 10. In the Decision, we stated that “Petitioner’s allegations regarding intended functions, predictability, and benefits do not show sufficiently that a person of ordinary skill in the art would have deviated from Sajic’s disclosure of constructing its inserts with outer layers of sealing material over the energy absorbing tubes’ ends.” Dec. 33. Our point was that Petitioner’s arguments—that using Sajic’s inserts in Muskovitz would have achieved the intended function and predictable result of improved impact absorption—still did not persuade us that one of ordinary skill would have found it obvious to omit the sealing material from Sajic’s inserts, to provide the claimed element of “the shock absorbing insert comprises an array of energy absorbing cells, each having respective open first longitudinal ends and open second longitudinal ends.” Without accounting for each claim limitation, Petitioner’s arguments of intended function and predictability are unavailing.

Finally, Petitioner contends that we misapprehended the law by requiring the Petition to demonstrate the absence of more desirable combinations to improve the impact absorption performance of Muskovitz’s helmet. Req. 14–15. In our Decision, we noted that “Petitioner does not address whether the alleged benefit of avoiding the ventilation cutout of Muskovitz’s insert member 26 [to improve impact absorption] would have

provided an advantage outweighing Sajic's disclosed benefit of keeping foam out of the energy absorbing tubes with sealing material." Dec. 34. Petitioner argues that the law does not require for a particular combination to be the preferred or the most desirable combination described in the prior art in order to provide motivation. Req. 14–15. That is correct. However, to the extent that it was unclear, our Decision did not impose such a requirement, nor did it rest entirely on our observation that Petitioner did not "persuasively weigh Sajic's disclosed benefit of keeping foam out of the energy absorbing tubes against the alleged benefits of Petitioner's proposed modifications." Dec. 34. Petitioner's argument does not alter our determination that Petitioner has not made a sufficient showing of obviousness.

IV. CONCLUSION

We have considered the arguments in Petitioner's Request for Rehearing and conclude that Petitioner has not carried its burden of demonstrating that the Board abused its discretion or misapprehended or overlooked any matters in the Decision Denying Institution. 37 C.F.R. § 42.71(c), (d).

V. ORDER

In consideration of the foregoing, it is
ORDERED that Petitioner's Request for Rehearing is *denied*.

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