

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARGET CORPORATION,
Petitioner,

v.

DESTINATION MATERNITY CORPORATION,
Patent Owner.

Case IPR2013-00532
Patent RE43,531 E

Before JENNIFER S. BISK, MICHAEL J. FITZPATRICK, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, Target Corporation, filed a Corrected Petition for an *inter partes* review of claims 1, 2, 5, 6, 10, 11, and 15–17 of U.S. Patent No. RE43,531 E (“the ’531 patent”). Paper 4 (“Pet.”). Patent Owner, Destination Maternity Corporation, filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 7 (“Prelim. Resp.”). In a February 19, 2014, Decision, we granted the Petition and instituted trial on the challenged claims as follows:

claims 1, 2, 5, 10, and 17 as anticipated by JCP fold-over panel jeans¹;
claims 6 and 11 as obvious over the JCP fold-over panel jeans and JCP
maternity bootcut jeans²; and
claims 15 and 16 as obvious over the JCP fold-over panel jeans and
Stangle.³

Paper 10 (“Dec. on Pet.”), 23.

After institution, Patent Owner filed a Patent Owner Response (Paper 24, “PO Resp.”), and Petitioner filed a Reply (Paper 41, “Pet. Reply”).⁴ Also, both parties filed motions to exclude, and Patent Owner filed observations on the cross-

¹ Ex. 1002 is an excerpt from JC Penney’s *ontrend Maternity, Fall/Winter Catalog* (2005) (the “JCP catalog”). Page 2 of the exhibit (JCP catalog page 15) depicts “fold-over panel jeans,” hereafter, the “JCP fold-over panel jeans.”

² Page 3 of Ex. 1002 (JCP catalog page 19) depicts “maternity bootcut jeans,” hereafter, the “JCP maternity bootcut jeans.”

³ U.S. Patent Application Publication US 2004/0049834 A1 (Mar. 18, 2004). Ex. 1005.

⁴ The Patent Owner Response and several other papers and exhibits filed by the parties were filed under seal. A public version (with redactions) of each sealed document is available on PRPS.

examination of Vincent Thomas, who executed a declaration in support of Petitioner's Reply.

An oral hearing was held on October 7, 2014.⁵

As discussed below, Petitioner has shown by a preponderance of the evidence that claims 1, 2, 5, 6, 10, 11, and 15–17 of the '531 patent are unpatentable.

A. Related Proceedings

Patent Owner asserted the '531 patent against Petitioner in a pending lawsuit titled: *Destination Maternity Corp. v. Target Corp.*, Case No. 2:12-cv-05680-AB (E.D. Pa.). Pet. 1; Paper 6, 2. Petitioner filed two additional petitions for *inter partes* reviews of the '531 patent. IPR2013-00533 (filed Aug. 27, 2013); IPR2014-00509 (filed Mar. 14, 2014). Also, Petitioner filed three petitions for *inter partes* reviews of related U.S. Patent No. RE43,563 E. See IPR2013-00530; IPR2013-00531; IPR2014-00508.

B. The '531 Patent

The '531 patent relates to a garment worn during different stages of pregnancy and different stages of postpartum body changes. Ex. 1018, 1:10–12. A stated “purpose of the invention is to provide a garment that adapts to cover and fit a growing abdomen during pregnancy, wherein the garment stays up when worn.” *Id.* at 1:42–44. Figure 1 of the '531 patent is reproduced below.

⁵ A transcript of the oral hearing is included in the record. Paper 72 (“Tr.”).

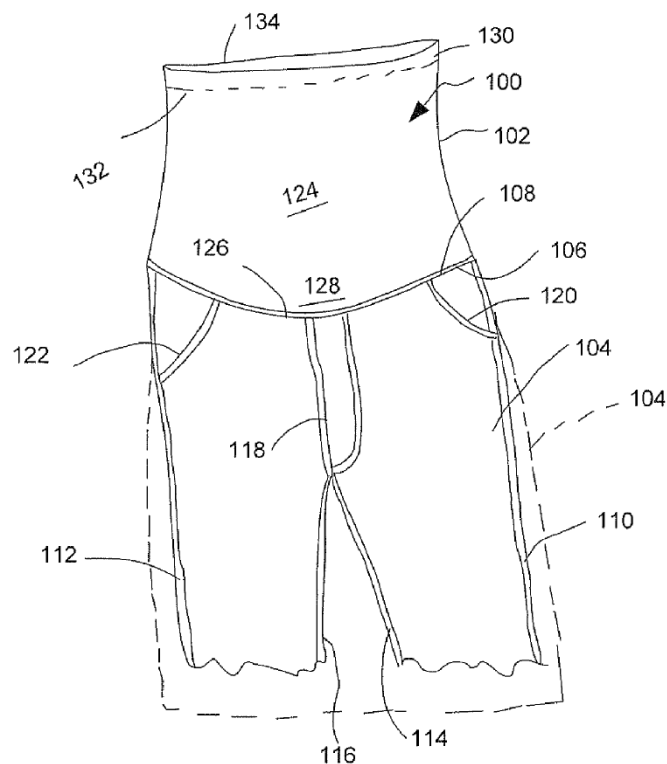


FIG. 1

Figure 1 illustrates a front view of garment 100 in accordance with the claimed invention of the '531 patent. Ex. 1018, 2:7–8, 2:26–27. The garment has upper portion 102 and lower portion 104 that are joined to one another proximate the waistline at first torso encircling circumference 126. *Id.* at 2:27–31, 2:66–3:4. In the embodiment of Figure 1, the garment lower portion comprises trousers, but other lower portions are contemplated, such as a skirt, which is indicated by phantom lines. *Id.* at 2:31–34.

The garment upper portion includes belly panel 124 that is expansible or stretchable to cover and fit over the abdomen during different stages of pregnancy. *Id.* at 2:59–63. The belly panel includes top perimeter hem 130, which forms

second torso encircling circumference 134. Bottom portion 128 of the belly panel projects downward in the front. *Id.* at 2:63–66. Upper perimeter 108 of the garment lower portion correspondingly recedes downward in the front. *Id.* at 2:66–3:4. Thus, the belly panel extends, partially at least, under the abdomen of the wearer before meeting and joining the garment lower portion. *Id.* at 3:6–10.

C. Illustrative Claim

Of the challenged claims, claim 1 is the sole independent claim. It is illustrative and reproduced as follows:

1. A garment, comprising:
 - a garment upper portion having a belly panel that is expansible to cover and fit over a growing abdomen during different stages of pregnancy;
 - a garment lower portion having a first torso encircling circumference that recedes downward to make way for expansion of the belly panel; and
 - the garment upper portion having a second torso encircling circumference defining an upper edge of the belly panel that encircles a wearer's torso just beneath the wearer's breast area configured to hold the garment up and in place about the torso in a position of a location of maximum girth of the abdomen thereby substantially covering the wearer's entire pregnant abdomen during all stages of pregnancy.

II. ANALYSIS

A. Claim Construction

“A claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.”

37 C.F.R. § 42.100(b). That construction must be consistent with the specification,

and the claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.” (internal quotation marks omitted)).

We address below the limitations at issue in this proceeding.

1. Claim 1: “just beneath the wearer’s breast area”

Claim 1 recites “the garment upper portion having a second torso encircling circumference defining an upper edge of the belly panel that encircles a wearer’s torso *just beneath the wearer’s breast area*” (emphasis added). Patent Owner argues that “just beneath the wearer’s breast area” means “beneath the location of the breasts by a very small margin.” PO Resp. 5 (citing Ex. 2017 ¶¶ 13–22).⁶ In particular, Dr. Brookstein notes that a dictionary definition for the word “just” is “by a very small margin.” Ex. 2017 ¶ 21 (citing Ex. 2023, 679).⁷ Thus, Patent Owner implicitly proposes that “breast area” be construed as “the location of the breasts” and, thus, not inclusive of any surrounding area.⁸

⁶ Exhibit 2017 is a declaration by David Brookstein, Sc.D, on behalf of Patent Owner.

⁷ Exhibit 2023 is *Merriam-Webster’s Collegiate Dictionary*, 11th Edition (2007).

⁸ At oral argument, counsel for Patent Owner ultimately equated “location of the breasts” with “breasts.” Tr. 48:1–8.

With respect to the word “just,” Patent Owner’s proposed construction merely substitutes one term for approximation in lieu of another. The proposed substitution does not provide any additional clarity to the meaning of the limitation. In fact, during oral argument, counsel for Patent Owner could not define what a very small margin would be.

JUDGE WEATHERLY: And, so, even if we were to agree with you, how do we tell whether the very small margin limitation has been met by the prior art?

MR. POLLACK: Right. So, the way we tell that is, if it’s just beneath by a very small margin, in other words, in that kind of empire line area, in the pregnant -- in the pregnant woman, then it meets the claim. If it’s not, then it doesn’t meet the claim. I mean, this is quite similar to many factual issues which are given to --

JUDGE WEATHERLY: I think you’ve just told me that I will know whether it’s very small by whether it’s very small. So, help me understand really what you’re saying.

MR. POLLACK: Right. The Federal Circuit has always allowed terms of degree, okay? Terms like just, about, and you can ask, well, how do you know whether something’s about? And the answer is, we give that to a jury, at least in a litigation, and we ask the jury, well, is it about? That’s something that’s well accepted.

Here you’re the fact finder. If you’re given a piece of prior art, you would have to look at it and say, as the fact finder, do I think this is just beneath or is it too far below? I’m going to show you their prior art, I think it’s way too far below, I don’t think it’s going to be a close issue.

JUDGE WEATHERLY: Okay.

MR. POLLACK: But yes, that is a factual question for you, it’s not a question that’s a matter of law. That’s the other part of the analysis, it’s not claim construction, but the other part of the analysis.

Patent Owner also relies on the '531 patent's description of Figure 1A as specification support for its construction, pointing out that it "states that 'the garment upper portion 102 has a belly panel 124 to provide an abdomen covering area [that is] expansible . . . to cover and fit over a growing abdomen during different stages of pregnancy.'" PO Resp. 6–7 (quoting Ex. 1018, 2:59–63). But, the quoted statement is describing another, separate limitation of claim 1, namely: "a garment upper portion having a belly panel that is expansible to cover and fit over a growing abdomen during different stages of pregnancy." Indeed, the relied-upon support from the specification tracks the latter limitation almost word-for-word. To the extent Patent Owner is arguing that the limitations are superfluous to one another, we disagree. *See Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1106, 1115 (Fed. Cir. 2002) (proposed construction that rendered a portion of the claim language meaningless held improper).

Moreover, the '531 patent further describes the location of the upper edge of the belly panel in Figure 1A in a manner that undermines Patent Owner's argument, stating:

In FIG. 1A, the belly panel 124 extends *at least somewhat above the maximum girth of the abdomen*, even during a later stage of pregnancy, such that the belly panel 124 positions the torso encircling circumference 134 *at least somewhat above the location of maximum girth* to resist slipping down over the abdomen.

Ex. 1018, 3:36–41 (emphasis added). Outside of claim 1, which was amended to recite "just beneath the wearer's breast area" (*see* PO Resp. 5), the '531 patent never mentions breast area (or breasts) at all, let alone as a frame of reference for locating the upper edge of the belly panel. Instead, the '531 patent describes the

location of the upper edge as “at least at least somewhat above the location of maximum girth to resist slipping down over the abdomen.” Ex. 1018, 3:39–41. The specification does not support Patent Owner’s construction of “just beneath the wearer’s breast area.”

Patent Owner argues that the cross-examination of Petitioner’s witness, Frances Harder, supports construing “breast area” to mean the location of the breasts. PO Resp. 9. During cross-examination, Ms. Harder testified that the meaning of “breast area” would depend on the context, including how the word “area” is used. Ex. 2018, 17:8–21. Counsel for Patent Owner then solicited her testimony based on a context *different* from the ’531 patent. He asked Ms. Harder “when you’re working with clothing to cover the breast area, what’s your understanding of breast area in that context?” Ex. 2018, 17:24–25. Covering the breast area is not a concern of the ’531 patent. Indeed, none of the garments claimed in the ’531 patent requires covering the breast area. Rather, the ’531 patent is concerned with a garment being able to “resist slipping down over the abdomen.” Ex. 1018, 3:40–41. Nowhere does the ’531 patent state that the upper edge of a belly panel must be just beneath the breasts in order to facilitate such resistance. We do not find the cross-examination of Ms. Harder supports Patent Owner’s construction of “breast area.”

Patent Owner also relies on unrelated patents to support its construction of “breast area,” *see* PO Resp. 11–14, but that reliance is misplaced for the same reason. The patents, U.S. Patent Nos. 6,669,064 (Ex. 2030); 5,034,999 (Ex. 2031); and 7,089,597 (Ex. 2032), use the term “breast area” in connection with garments intended to cover breasts. *See* PO Resp. 11–14; Ex. 2017 ¶¶ 19–20.

We give the term “breast area” its ordinary and customary meaning, as read in light of the specification. In doing so, we give meaning to both words and not merely to “breast” to the exclusion of “area.” *See Cardiac Pacemakers*, 296 F.3d at 1115. The term “breast area” generally connotes a broader a meaning than “breast” alone. Furthermore, in light of the specification, which does not describe or depict the upper belly panel extending to just beneath a wearer’s breasts, and in light of the fact that wearers will have different body types, including with respect to abdominal and breast size and shape, we determine that “breast area” is a term of approximation.

In conclusion, the term “just beneath the wearer’s breast area” is given its plain and ordinary meaning. Neither party has offered a construction that provides additional clarity. Also, a garment may satisfy claim 1 for one wearer but not another because of differences in the wearers’ body types, the existence of which the Specification acknowledges. Ex. 1018, 3:17–21.

2. Claims 2 and 17: “different body types”

Claim 2 recites “the second torso encircling circumference is adjustable in girth in conformance with different body types.” Claim 17 recites “the second torso encircling circumference comprises stretchable fabric to adjust the girth in conformance with different body types.” Patent Owner does not propose constructions for the limitations recited in these claims, but its patentability arguments advance an implicit construction of “different body types” that requires an unspecified amount of difference between said body types. *See* PO Resp. 39 (“Petitioner does not show that [the prior art panel] would stretch enough to

conform to different body types. . . . [T]he mere fact that something can expand does not equate to expanding to a degree needed to conform to different body types as required by Claims 2 and 17.”).

The specification does not define different body types. The broadest reasonable construction of “different body types” means: two or more body types that are not identical.

3. *Claim 5: “an elastic fabric that is contractible elastically to cover an abdomen during different stages of postpartum body changes”*

Claim 5 recites “the garment upper portion comprises an elastic fabric that is contractible elastically to cover an abdomen during different stages of postpartum body changes.” Patent Owner does not propose a construction for this limitation, but its patentability arguments advance an implicit construction that claim 5 requires a specific, yet unspecified, minimum amount of contractibility. *See* PO Resp. 40 (arguing that the JCP fold-over panel jeans do not anticipate claim 5 because the JCP catalog does not disclose “the degree of expansion and contraction” the jeans provide). The ’531 patent, however, does not specify any minimum amount of contractibility and does not describe or identify any stages of postpartum body changes.⁹ The specification, in relevant part, merely states:

An embodiment of the abdomen covering area comprises an elastic fabric that is contractible elastically to cover an abdomen during different stages of post partum body changes.

⁹ If claim 5 were construed to require a specific threshold of contractibility, as Patent Owner implies, the claim would be indefinite for not particularly pointing out what that threshold is. 35 U.S.C. § 112 ¶ 2.

....

[T]he stretchable fabric is contractible elastically to cover a shrinking abdomen during different stages of post partum body changes.

See Ex. 1018, 1:64–67, 3:15–17.

The broadest reasonable construction of “during different stages of postpartum body changes” in light of the specification means: during *any* postpartum body change of *any* wearer. In other words, the limitation does not require the fabric to contract to cover postpartum body changes of every potential wearer or to cover all postpartum body changes of any wearer.

B. Claims 1, 2, 5, 10, and 17 are Anticipated by the JCP Fold-Over Panel Jeans

Petitioner asserts that claims 1, 2, 5, 10, and 17 are anticipated by the JCP fold-over panel jeans. Pet. 31–34. The JCP fold-over panel jeans appear on page 15 of the JCP catalog. Ex. 1002, 2. An excerpt of page 15 is reproduced below.

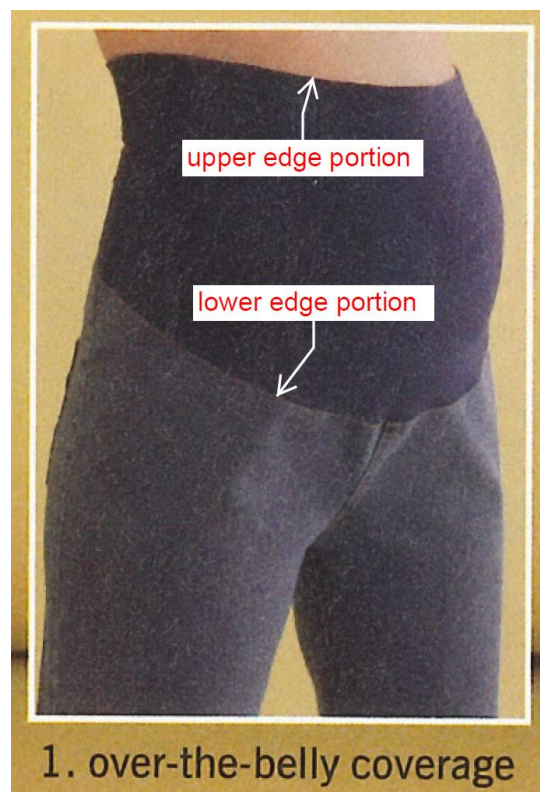


The photo excerpt depicts a series of inset photographs of the JCP fold-over panel jeans, and accompanying text. As seen, the garment has distinct upper and lower garment portions that are joined to one another proximate the waist. The lower portion consists of jeans. The upper portion is referred to as a “fold-over panel” that is designed to allow wear before, during, and after pregnancy, and during different stages of pregnancy. Ex. 1002, 2. The photographs show the garment in three configurations: panel unfolded, panel folded once, and panel folded twice. In the unfolded configuration, the panel substantially covers the

entire belly or abdomen of a pregnant model. The garment is said to “stretch for comfort.” *Id.*

1. Claim 1

The JCP fold-over panel jeans include a garment upper portion, consisting of the fold-over panel, and a garment lower portion, consisting of the jeans. The fold-over panel is “a belly panel” within the meaning of claim 1. It stretches and, thus, is “expansible to cover and fit over a growing abdomen during different stages of pregnancy,” as required by the claim. Ex. 1002, 2. The JCP fold-over panel jeans include features corresponding to the required first and second torso encircling circumferences, as shown in one of the photographs, which is reproduced again, in larger form and with annotations, below.



The photograph includes annotations indicating features corresponding to the first and second torso encircling circumferences required by claim 1.

Ex. 1002, 2. As shown, the jeans and the fold-over panel meet at what has been labeled a first torso encircling circumference. This first torso encircling circumference extends along the top of the jeans and recedes downward in the front and, thus, at least partially below the wearer's belly. *Id.* Consequently, the jeans have “a first torso encircling circumference that recedes downward to make way for expansion of the belly panel.”

Claim 1 recites “the garment upper portion having a second torso encircling circumference defining an upper edge of the belly panel that encircles a wearer's torso *just beneath the wearer's breast area* configured to hold the garment up and in place about the torso in a position of a location of maximum girth of the abdomen thereby substantially covering the wearer's entire pregnant abdomen during all stages of pregnancy” (emphasis added). In the annotated photograph of the JCP fold-over panel jeans, an upper edge of the fold-over panel has been labeled a second torso encircling circumference. Patent Owner argues that that the upper edge is not “just beneath the wearer's breast area” because the reference “does not show the model's breast area or even the top of the belly, and the surrounding text does not suggest that [the upper edge] is intended to reach that high.” PO Resp. 17 (citing Ex. 2017 ¶¶ 53–57). Patent Owner's arguments are not persuasive.

First, the reference does show the top of the belly, and it need not show the breasts, which are not elements of the claims. In fact, none of the figures of the '531 patent includes breasts. Figure 1A of the '531 patent is reproduced below.

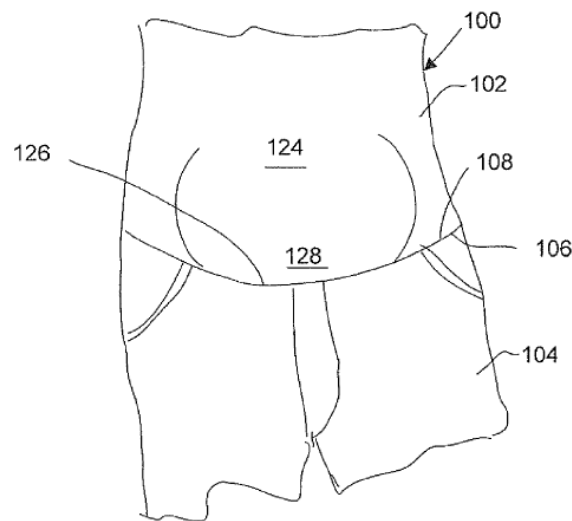


FIG. 1A

Figure 1A illustrates a garment having a body panel covering a growing abdomen. Ex. 1018, 2:9–10. The figure does not include any portion of a wearer's breasts. Yet, Patent Owner asserts that Figure 1A of the '531 patent "shows [] the panel . . . extended upward to the breasts." See PO Resp. 6. Patent Owner's characterization of Figure 1A undermines its criticism of the JCP catalog.

The skin of the particular model in the JCP catalog that is visible above the fold-over panel is part of her "breast area," within the broadest reasonable construction of that term. Also, the panel of the JCP fold-over panel jeans stretches. Thus, and although we find it is high enough as pictured to meet claim 1, it could be pulled even higher. In any event, claim 1 is directed to a garment, which is an apparatus; it is not directed to a method of wearing the garment. Consequently, the garment of claim 1 is not limited to how it fits on any particular wearer such as the model depicted in the JCP catalog. Indeed, the "wearer" that is

recited in claim 1 is not an element of the claim, and no particular body type is defined in the claim.¹⁰

Claim 1 also recites the garment upper portion as “substantially covering the wearer’s entire pregnant abdomen during all stages of pregnancy.” Patent Owner argues that the JCP fold-over panel jeans do not disclose this limitation. Much of its argument, however, is reiteration of its prior and unpersuasive argument that the panel of the JCP fold-over panel jeans does not extend to just beneath the wearer’s breast area. *See* PO Resp. 27, 28, 30–32.

Patent Owner additionally argues that this limitation is not met because the JCP fold-over panel jeans allegedly require the panel to be folded down during some stages of pregnancy in order to hold the jeans up, thereby exposing a large portion of the abdomen. PO Resp. 27–30. The JCP catalog does not state, however, that the jeans *must* be folded down to hold the jeans up during any stage of pregnancy. It states, rather, that the panel “can” be worn unfolded or “fold[ed] once for mid-rise comfort” or “twice for low-rise comfort and support.” Ex. 1002, 2.¹¹ It does not state that the jeans will fall down if the wearer does not opt for low- or mid-rise comfort and instead leaves the panel unfolded.

¹⁰ Wearers have different body types, including different heights and different breast sizes and shapes. The location of the bottom of a wearer’s breasts relative to, for example, her waist or hips varies among wearers.

¹¹ Patent Owner’s own Secret Fit Belly[®] products, which Patent Owner represents embodies claim 1 (PO Resp. 44), include a similar description. *See* Ex. 2022 ¶ 21 (“The panel is able to be folded so it can be worn as a lower-to-mid or full panel style, allowing the woman to wear throughout all stages of the pregnancy and postpartum body changes.”) (citing www.destinationmaternity.com/

The left-most inset photograph on page 15 of the JCP catalog shows the panel substantially covering the model's entire pregnant abdomen. Ex. 1002, 2. Full coverage is not required by the claim. Further, and again, the claim is not limited to a wearer of any particular height or body type. Thus, the fold-over panel would cover even more, and perhaps all, of another wearer's entire pregnant abdomen if that wearer were shorter and/or gained less abdominal girth during pregnancy than the model depicted in the JCP catalog.

Petitioner has shown by a preponderance of the evidence that claim 1 is anticipated by the JCP fold-over panel jeans.

2. Claims 2 and 17

Claims 2 and 17 depend from claim 1. Claim 2 recites "the second torso encircling circumference [at upper edge of belly panel] is adjustable in girth in conformance with different body types." Similarly, claim 17 recites "the second torso encircling circumference comprises stretchable fabric to adjust the girth in conformance with different body types." The JCP fold-over panel jeans meet these limitations, as the garment is made of "[c]otton/polyester/spandex" and described and illustrated as stretchable. Ex. 1002, 2.

Patent Owner argues that Petitioner has not proven that the panel of the JCP fold-over panel jeans stretches or expands *enough* to conform to different body types. PO Resp. 39. But, claims 2 and 17 do not require any quantified amount of stretching or expansion, and the term "different body types" includes any two or

maternity/secret-fit-belly.asp).

more body types that are not identical. It is the ability to stretch, which the prior art panel indisputably possesses, that the '531 patent describes as enabling conformance with different body types. *See* Ex. 1018, 3:30–33 (“An embodiment of the garment upper portion 102 comprises stretchable fabric to adjust the girth of the second torso encircling circumference 134 in conformance with different body types.”), 3:47–48 (“The tubular structure is adaptable to cover and fit different body types by being elastically expansible and contractible.”).

Petitioner has shown by a preponderance of the evidence that claims 2 and 17 are anticipated by the JCP fold-over panel jeans.

3. Claim 5

Claim 5 depends from claim 1 and recites “the garment upper portion comprises an elastic fabric that is contractible elastically to cover an abdomen during different stages of postpartum body changes.” Patent Owner argues that the panel of the JCP fold-over panel jeans is not described explicitly as being contractible. PO Resp. 40. We are not persuaded by this argument. Expansion and contraction are reciprocal movements. The JCP fold-over panel jeans “stretch for comfort.” Ex. 1002, 2. Thus, they necessarily contract as well.

Patent Owner also argues that the JCP catalog does not disclose the degree of contractibility of the panel of the JCP fold-over panel jeans. PO Resp. 40. But, claim 5 does not require any specific amount of contractibility. Instead, the contractibility is recited by claim 5 in terms of covering an abdomen during any postpartum body change of any wearer having any body type.

The specification also does not disclose any specific amount of contractibility. Instead, it merely links the limitation of claim 5 to the use of “stretchable fabric,” of which the panel of the JCP fold-over panel jeans indisputably is made. *See* Ex. 1018, 1:64–67 (“An embodiment of the abdomen covering area comprises an elastic fabric that is contractible elastically to cover an abdomen during different stages of post partum body changes.”), 3:15–17 (“[T]he stretchable fabric is contractible elastically to cover a shrinking abdomen during different stages of post partum body changes.”). The second excerpt we quote from the ’531 patent, at column 3, lines 15 to 17, refers to the embodiment of Figure 1A. The JCP fold-over panel jeans include a comparably elastic belly panel, and we find that it possesses enough elasticity to satisfy the limitation added by claim 5.

Petitioner has shown by a preponderance of the evidence that claim 5 is anticipated by the JCP fold-over panel jeans.

4. Claim 10

Claim 10 depends from claim 1 and recites “the garment upper portion is foldable toward the garment lower portion to comprise a folded band on the garment lower portion.” The panel of the JCP fold-over panel jeans is described and illustrated as foldable, including so as to form a folded band. Ex. 1002, 2. Although the folded bands shown in the photographs of page 15 of the JCP catalog do not appear to overlay any portion of the jeans, the claim does not require actual folding. It is enough that the fold-over panel be “foldable” in such a manner. We

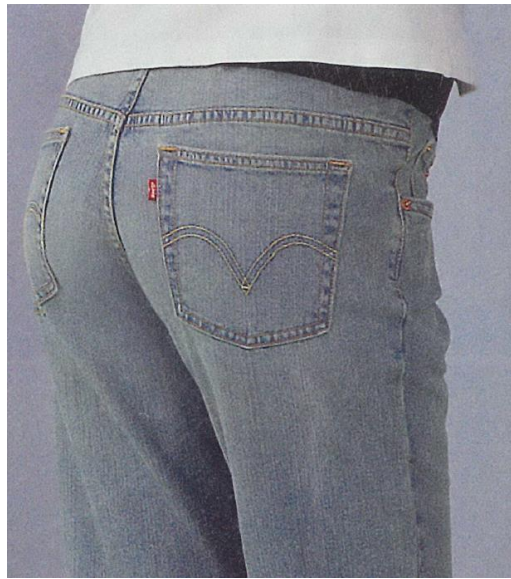
find that the panel is foldable in numerous configurations, including one in which a folded band overlays a top portion of the jeans.

Petitioner has shown by a preponderance of the evidence that claim 10 is anticipated by the JCP fold-over panel jeans.

C. Claims 6 and 11 Would Have Been Obvious Over the JCP Fold-Over Panel Jeans and JCP Maternity Bootcut Jeans

Claims 6 and 11 depend from claim 1. Claim 6 recites “the garment lower portion has a partial waistband extending from side seams of the garment lower portion and extending across a back side of the garment lower portion where the partial waistband widens above a wearer’s pelvis.” Similarly, claim 11 recites “the garment lower portion has a partial waistband extending from side seams of the garment lower portion wherein the partial waistband tapers toward the side seams and widens above a wearer’s pelvis across a back side of the garment lower portion.”

Page 19 of the JCP catalog describes and shows the JCP maternity bootcut jeans. Ex. 1002, 3. An excerpt of page 19 is reproduced below.



The excerpt depicts a photograph of a portion of the JCP maternity bootcut jeans. The JCP catalog states that the garment includes “an all-around elastic belly panel that can be folded up or down depending on your stage of pregnancy.”

Ex. 1002, 3. In the photograph, however, the all-around belly panel (shown in black or dark blue) is concealed partially by a white shirt, as Petitioner concedes. Pet. 34–35. Thus, and despite its name, it is not clear whether it meets claim 1’s requirement of “substantially covering the wearer’s entire pregnant abdomen.” Consequently, Petitioner relies on the JCP fold-over panel jeans for teaching the limitations of claim 1, and on the JCP maternity bootcut jeans for teaching the partial waistband limitations required by dependent claims 6 and 11. Pet. 36–37.

The JCP maternity bootcut jeans have such a partial waistband (the uppermost denim and rear portion of the jeans). The partial waistband is widest in a central part of the back side of the garment and tapers toward the side seams.

Petitioner provides reasoning with rational underpinning for substituting the jeans portion of the JCP fold-over panel jeans with the jeans portion from the JCP

maternity bootcut jeans, thereby resulting in the subject matter of claims 6 and 11. Pet. 35–36. In particular, and relying on the declaration testimony of Ms. Harder, Petitioner points out that both products are jeans having attached belly panels, which could be swapped easily with one another through routine modification. *Id.* at 35. Ms. Harder testified that swapping panels would have been an obvious design choice to a person of ordinary skill in the art, and that it was desired by customers. Ex. 1011 ¶ 25. The swapping of the panels and jeans does no more than yield predictable results. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”). Further, the description itself of the JCP maternity bootcut jeans, which states that the garment “features an all-around elastic belly panel,” suggests to a person having ordinary skill in the art that a panel such as that from the JCP fold-over panel jeans could be used.

Patent Owner does not argue that the JCP maternity bootcut jeans fail to disclose the limitations added by claims 6 and 11. Patent Owner also does not challenge Petitioner’s reasoning for combining the references.

Rather, Patent Owner argues the patentability of claims 6 and 11 for the following two reasons. First, Patent Owner argues that they are patentable because the JCP fold-over panel jeans do not anticipate base claim 1. PO Resp. 35–37. That argument is not persuasive because claim 1, in fact, is anticipated by the JCP fold-over panel jeans. Second, Patent Owner argues that objective indicia, or secondary considerations, prove the claims are not obvious. PO Resp. 42–50; *see also Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (“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. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.”). In particular, Patent Owner states that “[t]he success of the patented Secret Fit Belly[®] styles, which practice all of the instituted claims of the Patents-in-Suit including the claims challenged for obviousness, is evidenced in the attached commercial success report.” PO Resp. 44 (citing Ex. 2022 ¶¶ 31–37; Ex. 2017, Exhibit 2).¹² This is not an argument. It is an invitation to scour Patent Owner’s evidence.

Also, Patent Owner’s reference to “the attached commercial success report” is not clear. Nothing is “attached” to Patent Owner’s Response (nor should anything be attached). The first citation is to Exhibit 2022, which is entitled “Declaration by Philip Green Regarding Commercial Success” and may very well be the document to which Patent Owner intended to refer as the “attached commercial success report.” However, Patent Owner also cites to Exhibit 2 of Exhibit 2017, which is “a report that [another Patent Owner witness, Dr. Brookstein,] prepared showing that Secret Fit Belly[®] products practice the claimed invention.” Ex. 2017 ¶ 11.

We have reviewed both of the cited sources, and we are not persuaded by the purported evidence of commercial success of the inventions of claims 6 and 11.

Patent Owner asserts that the Secret Fit Belly[®] products embody each of claims 1, 2, 5, 6, 10, 11, and 15–17. PO Resp. 44. Patent Owner does not,

¹² Exhibit 2022 is a declaration by Patent Owner’s witness Philip Green.

however, link the alleged commercial success of those products to the inventions of claims 6 and 11, as opposed to the invention of claim 1, for example, which is anticipated by the JCP fold-over panel jeans. *See J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997) (“asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art”).

In fact, Patent Owner’s witness, Mr. Green, concedes that the commercial success of Patent Owner’s products has nothing to do with the unique characteristics of claims 6 and 11, which add limitations directed exclusively to features of the garment lower portion. Mr. Green states that “the commercial success of the Secret Fit Belly bottoms is due primarily to the . . . patented features” earlier referenced in his declaration. Ex. 2022 ¶ 38. Nowhere in his declaration, however, does Mr. Green reference any patented features unique to claim 6 or 11. In fact, Mr. Green states that the “Secret Fit Belly bottoms are available in various sizes, cuts, and colors, including jeans, trousers, capris, skirts, and shorts. [Patent Owner]’s Secret Fit Belly bottoms are similar in style to all other bottoms offerings: *generally the only difference is the expandable panel that is the subject of the patents at issue in this matter.*” Ex. 2022 ¶ 20 (emphasis added).

Petitioner has shown by a preponderance of the evidence that claims 6 and 11 would have been obvious over the JCP fold-over panel jeans and JCP maternity bootcut jeans.

D. Claims 15 and 16 Would Have Been Obvious Over the JCP Fold-Over Panel Jeans and Stangle

Petitioner asserts that the subject matter of claims 15 and 16 would have been obvious over the JCP fold-over panel jeans and Stangle. Pet. 38–41. Claims 15 and 16 depend from claim 1. Claim 15 recites “an edge margin of the garment upper portion is folded over and knitted to an inside of the fabric to provide a perimeter hem stitch.” Similarly, claim 16 recites “an edge margin of the garment upper portion is folded over and *sewn or* knitted to an inside of the fabric to provide a perimeter hem stitch.” (Emphasis added to call out distinction with claim 15).

Stangle discloses “a garment that enables the wearing of clothing that is otherwise too small to be zipped, buttoned snapped or otherwise fastened, such as during pregnancy or with respect to an overweight wearer or other wearer whose body proportions have changed.” Ex. 1003 ¶ 7. The garment is described as a hollow, tubular sleeve that is worn around the waistline and over the unfastened fly of the clothing. *Id.* ¶ 29. As Petitioner points out, an upper portion (as well as a lower portion) of the tubular sleeve is folded over and can be attached to the inside surface of the sleeve by either stitching or by being woven integrally (i.e., knitted). Pet. 39 (citing Ex. 1003 ¶¶ 30–31).

Petitioner provides reasoning with rational underpinning for modifying the JCP fold-over panel jeans in view of the relied-upon teachings of Stangle, thereby resulting in the subject matter of claims 15 and 16. Pet. 40. In particular, Petitioner offers testimony from Ms. Harder that a person of ordinary skill in the art would have understood that the folded over and stitched or knitted hem taught

by Stangle could be employed on the upper edge of the belly panel of the JCP fold-over panel jeans, because both references relate to maternity clothing and because wearers desire comfortable maternity clothing with durable edges that stay on their bodies. Ex. 1011 ¶ 37. Further, the proposed modifications do no more than yield predictable results. *See KSR*, 550 U.S. at 416.

Patent Owner does not argue that Stangle fails to disclose the limitations added by claims 15 and 16. Patent Owner also does not challenge Petitioner's reasoning for combining the references.

Rather, Patent Owner argues the patentability of claims 15 and 16 for the following two reasons. First, Patent Owner argues that they are patentable because the JCP fold-over panel jeans do not anticipate base claim 1. PO Resp. 35–37. That argument is not persuasive because claim 1, in fact, is anticipated by the JCP fold-over panel jeans. Second, Patent Owner argues that secondary considerations prove the claims are not obvious. PO Resp. 42–50. That second argument also is not persuasive because Patent Owner does not link the alleged commercial success of its products to the inventions of claims 15 and 16, as opposed to the invention of claim 1, for example, which is anticipated by the JCP fold-over panel jeans. *See J.T. Eaton*, 106 F.3d at 1571 (“asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art”).

Petitioner has shown by a preponderance of the evidence that claims 15 and 16 would have been obvious over the JCP fold-over panel jeans and Stangle.

III. MOTIONS TO EXCLUDE

Petitioner moved to exclude certain evidence relied upon by Patent Owner to support its arguments for objective indicia of non-obviousness. Paper 42.

Resolution of Petitioner's motion is unnecessary to this final written Decision because, even considering the challenged evidence, Patent Owner's arguments that objective indicia demonstrate non-obviousness of claims 6, 11, 15, and 16 are not persuasive. Accordingly, we dismiss Petitioner's Motion to Exclude as moot.

Patent Owner moved to exclude Petitioner's Exhibits 1071, 1072, 1075–1077, 1080–1083, 1086–1092, 1110, 1116, and 2037.¹³ Paper 49. Resolution of Patent Owner's motion is unnecessary to this final written Decision because we do not rely on any of those exhibits in rendering our Decision. Accordingly, we dismiss Patent Owner's Motion to Exclude as moot.

IV. CONCLUSION

Petitioner has shown by a preponderance of the evidence that claims 1, 2, 5, 6, 10, 11, and 15–17 of the '531 patent are unpatentable.

¹³ Despite its number, we understand that Exhibit 2037 was filed in this proceeding by Petitioner. It appears that Petitioner numbered it "2037" because that is the number Patent Owner already had assigned to the same document when filing it as an exhibit being referenced in its motion to amend in IPR2013-00531.

V. ORDER

Accordingly, it is

ORDERED that claims 1, 2, 5, 6, 10, 11, and 15–17 of U.S. Patent No. RE43,531 E are held unpatentable;

FURTHER ORDERED that both parties' motions to exclude are dismissed; and

FURTHER ORDERED that, because this Decision is final, a party to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2013-00532
Patent RE43,531 E

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