

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIRST QUALITY BABY PRODUCTS, LLC,
Petitioner,

v.

KIMBERLY-CLARK WORLDWIDE, INC.,
Patent Owner.

Case IPR2014-01021
Patent 8,747,379 B2

Before HYUN J. JUNG, J. JOHN LEE, and CHRISTOPHER G. PAULRAJ,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

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

INTRODUCTION

On June 23, 2014, First Quality Baby Products, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–24 of U.S. Patent No. 8,747,379 B2 (Ex. 1001, “the ’379 patent”). Kimberly-Clark Worldwide, Inc. (“Patent Owner”) timely filed a Preliminary Response (Paper 6). An *inter partes* review of all challenged claims was instituted on December 15, 2014. Paper 9 (“Inst. Dec.”). After institution, Patent Owner filed a Patent Owner’s Corrected Response (Paper 14, “PO Resp.”), and Petitioner filed a Petitioner’s Reply (Paper 19, “Pet. Reply” (redacted public version); Paper 20 (filed under seal)).¹ Patent Owner also filed a Motion for Observations Regarding Cross-Examination (Paper 35), and Petitioner filed a Response to Patent Owner’s Motion for Observations (Paper 44). An oral hearing was held on August 11, 2015. Paper 51 (“Tr.”).²

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. As discussed below, Petitioner has shown by a preponderance of the evidence that claims 1–24 of the ’379 patent are unpatentable.

A. *Related Proceedings*

The parties identify several matters related to this proceeding: (1) a district court case in the Eastern District of Wisconsin (Case No. 1:14-cv-

¹ This decision cites to the public versions of all cited documents unless otherwise specified.

² A combined oral hearing was held for this case as well as related *inter partes* reviews IPR2014-01023 and IPR2014-01024. Although the parties at times referred to specific claims at issue in only one of these cases, many of the substantive issues also are present in all three cases and, as such, the parties’ statements at the oral hearing are applied to each of the related cases as appropriate.

01466-WCG), in which Patent Owner has asserted the '379 patent against Petitioner; (2) an *inter partes* reexamination (Reexamination Control No. 95/001,228) filed by Petitioner addressing claims 1–10 of the '379 patent, as well 77 additional claims added during the reexamination; (3) *First Quality Baby Prods., Inc. v. Kimberly-Clark Worldwide, Inc.*, Case IPR2014-01023 (PTAB), filed by Petitioner on June 23, 2014, and instituted on December 15, 2014, in which Petitioner challenges claims 33–54 of the '379 patent; and (4) *First Quality Baby Prods., Inc. v. Kimberly-Clark Worldwide, Inc.*, Case IPR2014-01024 (PTAB), filed by Petitioner on June 23, 2014, and instituted on December 15, 2014, in which Petitioner challenges claims 25–32 of the '379 patent. Paper 54, 1; Paper 56, 2–3.

Petitioner also identifies a district court case filed by Patent Owner in the Eastern District of Wisconsin (Case No. 09-cv-0916-WCG), consolidated with another case in the same district (Case No. 10-cv-1118), in which claims of a related patent, U.S. Patent No. 6,849,067, were asserted against Petitioner. Paper 56, 1–2.

B. The '379 Patent

The '379 patent relates to disposable absorbent training pants. Ex. 1001, 1:17–20. The training pants include a fastening system whereby the training pants can be fastened together, unfastened, and then refastened. *Id.* at 1:65–2:2, 2:37–39. The fastening components are disposed along the sides of the training pants, and the side panels may incorporate elastomeric material for enhanced fit and comfort. *Id.* at 2:2–8. The fastening components disposed on the back side panels releasably engage mating fastening components on the front side panels. *Id.* at 2:29–33.

C. Challenged Claims

Petitioner challenges claims 1–24 of the '379 patent. Claim 1, set forth below, is the only independent claim challenged by Petitioner, and is illustrative of the challenged claims.

1. A training pant for use in training a child to use the toilet, comprising:

an absorbent chassis defining a longitudinal axis, a transverse axis, an overall length dimension parallel to the longitudinal axis, front and back waist edges parallel to the transverse axis, opposite side edges extending between the front and back waist edges, a front waist region contiguous with the front waist edge, a back waist region contiguous with the back waist edge, and a crotch region which extends between and interconnects the front and back waist regions, the absorbent chassis comprising:

a composite structure having opposite linear side edges generally parallel to the longitudinal axis and opposite linear end edges generally parallel to the transverse axis, the composite structure comprising:

- (a) a liquid permeable bodyside liner;
- (b) a liquid impermeable outer cover bonded to the bodyside liner, the outer cover comprising a liquid impermeable inner layer and a nonwoven outer layer;
- (c) an outer cover graphic disposed on the outer cover;
- (d) an absorbent assembly comprising hydrophilic fibers disposed between the bodyside liner and the outer cover; and
- (e) leg elastic members longitudinally aligned along the side edges of the composite structure;

first and second front side panels bonded to the composite structure in the front waist region, each front side panel having a distal edge, an interior portion between the distal edge and the composite structure, a waist end edge generally parallel to the transverse axis and disposed

toward a longitudinal end of the training pant, and a leg end edge extending from the respective side edge of the composite structure to the distal edge and disposed toward the longitudinal center of the training pant, the front side panels having an average length dimension that is about 20 percent or greater of the overall length dimension of the absorbent chassis;

- first and second back side panels bonded to the composite structure in the back waist region and longitudinally spaced from the first and second front side panels, each back side panel having a distal edge, an interior portion between the distal edge and the composite structure, a waist end edge generally parallel to the transverse axis and disposed toward a longitudinal end of the training pant, and a leg end edge extending from the respective side edge of the composite structure to the distal edge and disposed toward the longitudinal center of the training pant, the back side panels having an average length dimension that is about 20 percent or greater of the overall length dimension of the absorbent chassis, an elastomeric material disposed between nonwoven facing layers in at least the interior portion of each back side panel to render each back side panel elastomeric in a direction generally parallel to the transverse axis; and
- a fastening system for releasably securing the absorbent chassis in a pant-like configuration having a waist opening and a pair of leg openings, the fastening system comprising first and second fastening components adapted to releasably engage first and second mating fastening components, the first and second fastening components being disposed on the respective first and second back side panels adjacent the distal edges, the first and second mating fastening components being disposed on the respective first and second front side panels adjacent the distal edges, the fastening components and the mating fastening components each comprising mechanical fasteners, and engagement of the fastening components and mating fastening components defines refastenable seams that cover about 80 to 100

percent of a distance between the waist opening and the leg openings.

D. Instituted Grounds of Unpatentability

This *inter partes* review was instituted on the following alleged grounds of unpatentability:

Claims	Prior Art	Basis
1–10, 12, 13, 15–17, and 19–23	Brandon ³ and Anderson ⁴	§ 103(a)
11, 14, 18, and 24	Brandon, Anderson, and Long ⁵	§ 103(a)

ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are construed according to their broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.100(b); *see In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015). Only those terms in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

During trial, the parties disputed the claim constructions of the terms “prefastened” and “non-stretchable,” which we address below. No other claim terms require express construction to resolve the issues raised in this *inter partes* review.

1. prefastened

³ PCT Publication No. WO 97/24094, published July 10, 1997 (Ex. 1002). The page numbers cited herein refer to the page numbers added by Petitioner for this exhibit, not the page numbers in the original document.

⁴ U.S. Patent No. 5,062,839, issued Nov. 5, 1991 (Ex. 1006).

⁵ U.S. Patent No. 5,624,429, issued Apr. 29, 1997 (Ex. 1007).

Claim 16 recites, “wherein the training pant is prefastened to provide a pant-like product for the user.” Patent Owner argues this phrase should be construed as “a training pant having side panels with mating fastening components thereon in which the fastening components are fastened or otherwise connected during manufacture and prior to sale such that the user is provided with a pant-like product.” PO Resp. 19, 27, 45. In support of this position, Patent Owner relies solely on the testimony of its declarant, G.A.M. (Tony) Butterworth. *Id.* (citing Ex. 2006 ¶¶ 48, 101). Petitioner argues Patent Owner’s proposed construction is overly narrow and contends “prefastened” only requires that the training pant be fastened prior to being put on a child rather than during manufacturing. Pet. Reply 19–20.

As Petitioner asserts, the intrinsic evidence does not support the construction advanced by Patent Owner. The ’379 patent explains that the claimed training pants “can further include releasable side bonds . . . for improved reliability of maintaining the pant in a prefastened condition particularly when it is being pulled on or off over the hips of the wearer.” Ex. 1001, 20:1–4. In addition, the specification states: “The absorbent articles are desirably pre-fastened to provide a pant-like product for the user. The product can then be pulled on like a conventional training pant” *Id.* at 5:31–34. The specification does not describe any manufacturing process for prefastening training pants. Mr. Butterworth’s testimony is based solely on claim language indicating that the recited fastening components and mating fastening components are the elements that are prefastened. Ex. 2006 ¶ 48. His conclusion, however, is not supported by that claim language, which does not reference manufacturing or a timeframe prior to sale. *See* Ex. 1014, 99:13–16, 102:25–103:9 (Mr. Butterworth indicating at his deposition that the ’379 patent does not discuss a

manufacturing process for prefasting the claimed training pant, or when the training pants are prefasted).⁶

Based on the record presented, the broadest reasonable interpretation of “prefasted” in light of the specification requires that the claimed training pant be fastened prior to wear, but does not require fastening during manufacturing or prior to sale.

2. *non-stretchable*

Claim 18 recites, “wherein the front side panels are non-stretchable.” Patent Owner argues that “non-stretchable” is not synonymous with “non-elastomeric” or “non-elastic.” PO Resp. 48–49. In support of its position, Patent Owner relies on the testimony of Mr. Butterworth, who testified:

The terms “nonstretchable” and “non-elastomeric” have different meanings. A non-elastomeric material includes a material that is capable of stretching (*i.e.*, elongating) but does not generally return to its original shape. A non-stretchable material, as recited in claim 18, is not capable of elongating. . . . [O]ne of ordinary skill in the art would appreciate the difference between a non-elastic material and a non-stretchable material. They are not the same thing. As mentioned above, a non-stretchable is not capable of elongating whereas a non-elastic material can elongate.

Ex. 2006 ¶¶ 110–11.

The parties appear to agree that an elastomeric/elastic⁷ material would have been understood by a person of ordinary skill to be a material that can

⁶ Mr. Butterworth’s deposition transcript also was filed in related cases IPR2014-01023 and IPR2014-01024. Although his testimony at times refers to specific claims at issue in only one of these cases, the parties do not dispute that his testimony is applicable across all three cases to the extent he addresses substantive issues present in all three cases.

⁷ Both parties use “elastomeric” and “elastic” interchangeably. Tr. 30:12–23; PO Resp. 48–49.

stretch, i.e., elongate, but which subsequently returns to its original shape. *See, e.g.*, PO Resp. 48; Tr. 30:12–23. Thus, non-elastomeric/non-elastic materials would have been understood to include materials that cannot elongate **as well as** materials that can elongate but do not subsequently return to their original shape. *See, e.g.*, PO Resp. 48; Tr. 30:12–31:14. The parties do not appear to dispute that “stretchable” materials are able to elongate, whereas “non-stretchable materials” cannot. *See, e.g.*, PO Resp. 48; Tr. 30:12–23. Thus, although the terms “non-stretchable” and “non-elastomeric” overlap, they are not synonymous. The parties do not identify any portion of the specification inconsistent with these interpretations.

Based on the evidence and arguments presented, the broadest reasonable interpretation of “non-stretchable” is “unable to elongate.” As noted above, some non-elastomeric/non-elastic materials also may be non-stretchable, but some are not. Further, claim 24 recites, “wherein the front side panels do not comprise elastic materials.” Based on the record before us, the broadest reasonable interpretation of “elastic materials” is “materials that can elongate and subsequently return to their original shape.”

B. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–10, 12, 13, 15–17, and 19–23 are unpatentable under § 103 in view of the combination of Brandon and Anderson. Pet. 16–35. With respect to claims 11, 14, 18, and 24, Petitioner asserts unpatentability under § 103 in view of the combination of Brandon, Anderson, and Long. *Id.* at 35–45.⁸ As discussed below, Petitioner has

⁸ Petitioner also asserted this ground against other claims, but trial was instituted on this ground only for claims 11, 14, 18, and 24. Inst. Dec. 9.

demonstrated by a preponderance of the evidence that all challenged claims are unpatentable on the grounds asserted.⁹

1. *Brandon*

Brandon is a published PCT patent application filed by Patent Owner, which relates to the manufacturing of disposable absorbent articles such as training pants. Ex. 1002, 1, 3. U.S. Patent No. 4,940,464 (Ex. 1110, “Van Gompel”) is incorporated into Brandon’s disclosure by reference. *Id.* at 7. Examples of the training pants disclosed in Brandon are shown in Figures 1, 2, and 2A, reproduced below:

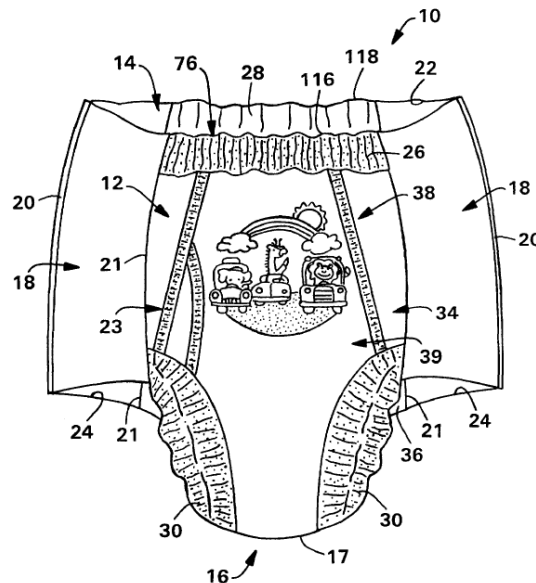


FIG. 1

⁹ Both parties agree that a person of ordinary skill in the art would have had two to four years of work experience in product design and testing of disposable absorbent articles, such as diapers and training pants. Pet. 15; PO Resp. 6. We adopt this characterization and apply it to our analysis.

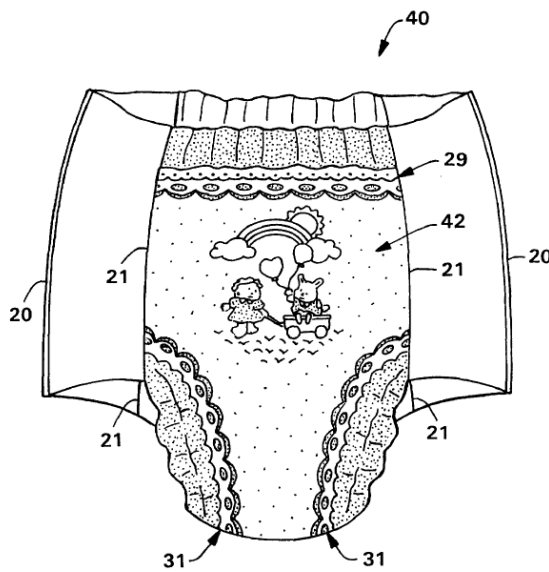


FIG. 2

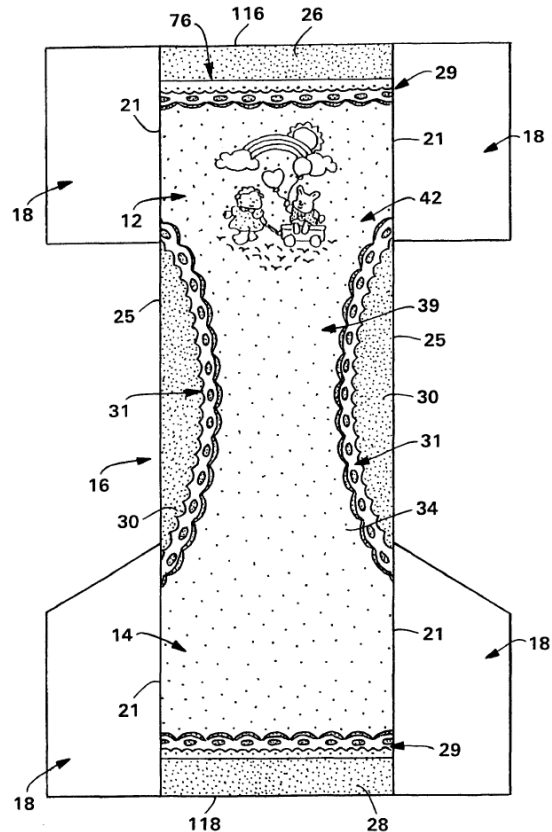


FIG. 2A

Figures 1 and 2 show front views of disposable absorbent articles (training pants 10 and 40) disclosed in Brandon. *Id.* at 5, 11–13. Figure 2A shows the same article shown in Figure 2 in a partially disassembled state. *Id.* at 5.

The depicted training pants include front panel 12, back panel 14, crotch panel 16 interconnecting the front and back panels, leg elastics 30, and elastic side panels 18 joined to front panel 12 and back panel 14. *Id.* at 11–12. Each elastic side panel 18 is made of two separate elastic portions, which may be joined together by ultrasonic bonding to form side seam 20. *Id.* at 11. An absorbent pad also may be included, positioned between a liquid impermeable outer cover and a liquid permeable liner. *Id.*

2. Anderson

Anderson relates to a disposable training panty. Ex. 1006, 2:47–51. An embodiment of the disclosed training panty is depicted in Figures 1 and 2, reproduced below:

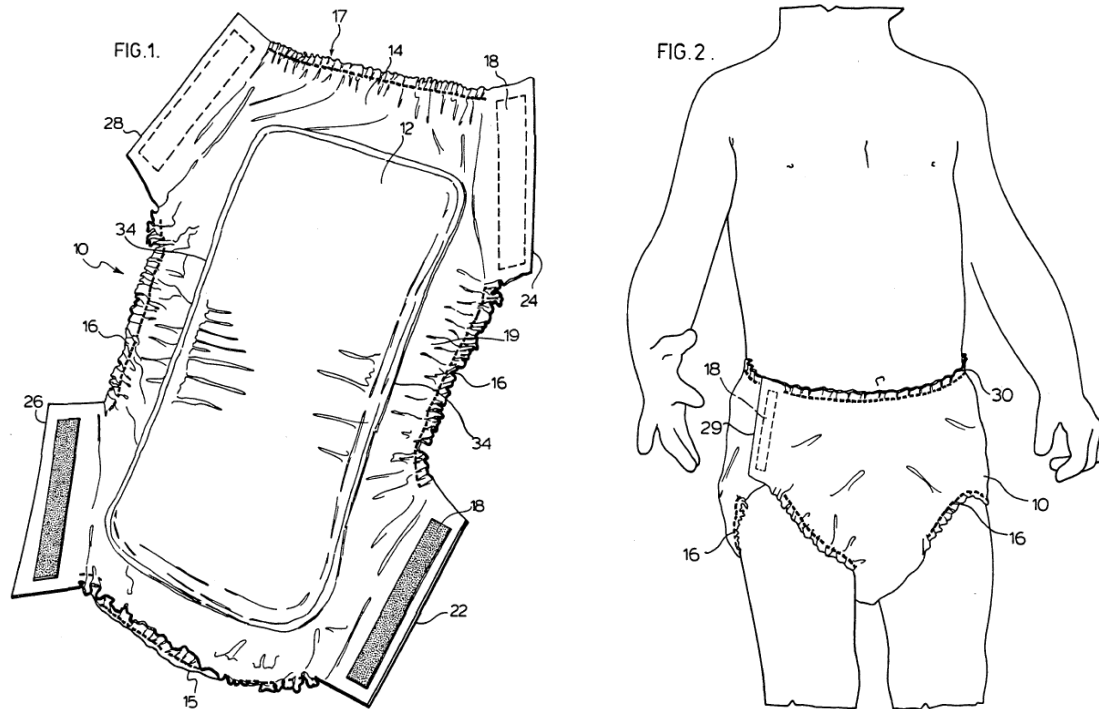


Figure 1 shows a perspective view of Anderson's disposable training panty, fully opened to show the inside of the panty and depicting the use of Velcro to secure the sides together. *Id.* at 3:17–20. Figure 2 shows Anderson's training panty as viewed on a child wearing the panty. *Id.* at 3:21–22.

Side 22 can be joined with side 24 using velcro 18 to form releasable side seam 29. *Id.* at 4:27–32. Similarly, sides 26 and 28 can be joined to form the other releasable side seam. *Id.* Thus, the side seams are secured to approximate the side seams of a normal underpant, but the seams are readily releasable in the event of an accident to facilitate removal of the panty without undue contamination. *Id.* at 4:32–37.

3. *Long*

Long relates to fastening systems for garments, such as disposable absorbent articles. Ex. 1007, 1:6–43. Such an article may have side panels that attach using mechanical fasteners, such as a hook layer configured to engage a loop material. *Id.* at 2:45–61, Fig. 1. The side panels may be composed of “a substantially non-elastomeric material, such as polymer films, woven fabrics, nonwoven fabrics or the like, as well as combinations thereof.” *Id.* at 13:18–21. Long also discloses the use of a “surge management portion” and elastic containment flaps, in conjunction with absorbent structures and other elements, to manage liquids introduced into the absorbent article. *Id.* at 4:53–65, 10:30–50, 11:63–12:16. U.S. Patent No. 4,704,116 (Ex. 1112, “Enloe”) is incorporated into Long’s disclosure by reference. *Id.* at 12:2–5.

4. *Claim 1*

Petitioner contends Brandon (including the disclosures of Van Gompel incorporated by reference) teaches all of the limitations of claim 1, except the recited fastening system for releasably securing the absorbent chassis. Pet. 20–21, 26–30. For example, Petitioner identifies Brandon’s teachings of front waist edge 118, front panel 12, back waist edge 118, back panel 14, and crotch panel 16, as teaching the recited front waist edge, front waist region, back waist edge, back waist region, and crotch region, respectively. *Id.* at 26. Petitioner asserts that Brandon’s disclosures of an absorbent pad, its associated structures and materials, outer cover graphics, and leg elastic 30, collectively, teach the elements of the “composite structure” recited in claim 1. *Id.* at 26–28. In addition, Petitioner cites Brandon’s disclosures relating to elastic side panels 18, including Van Gompel’s disclosures of certain dimensions and materials composition, as

teaching the recited front and back side panels of claim 1. *Id.* at 28–30. The Petition notes the similarities between, for example, Figure 2 of the '379 patent and Figure 2A of Brandon (Pet. 20–21):

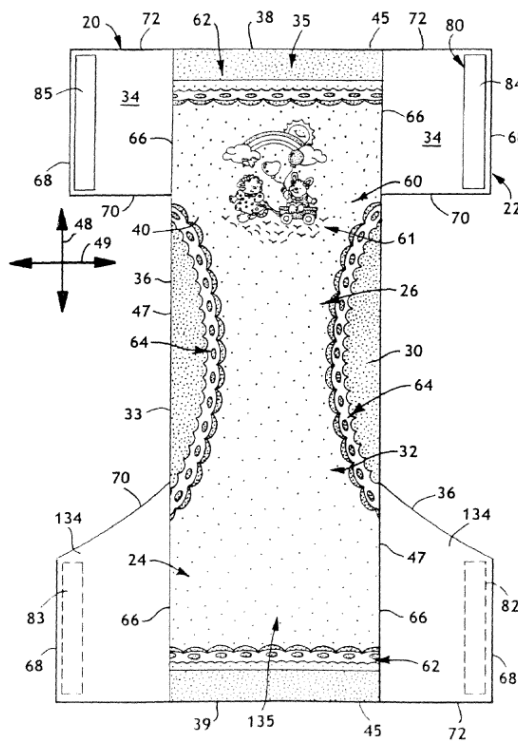


FIG. 2

'379 Patent

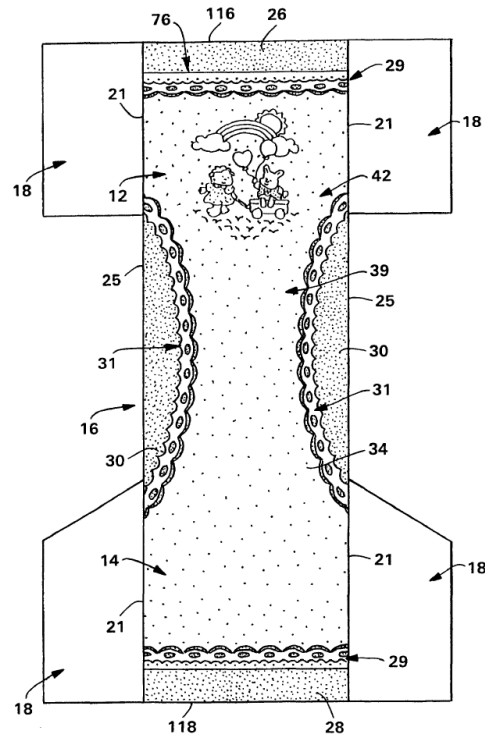


FIG. 2A

Brandon

Figure 2 of the '379 patent depicts an embodiment of the claimed disposable absorbent article in an unfastened, laid flat condition. Ex. 1001, 8:29–32. Figure 2A of Brandon similarly depicts a disclosed disposable absorbent article in a partially disassembled, stretched flat state. Ex. 1002, 5. Patent Owner does not dispute that Brandon teaches these aspects of claim 1.

With respect to the fastening system of claim 1, Petitioner contends the combination of Brandon and Anderson teaches each limitation. Pet. 21–25, 30–31. Specifically, Petitioner argues a person of ordinary skill would have been led to replace the bonded side seams of Brandon with the

refastenable side seams disclosed in Anderson. *Id.* According to Petitioner, velcro 18 on back side panels 24 and 28 in Anderson teach the first and second fastening components of claim 1 of the '379 patent, and corresponding velcro 18 on the front side panels 22 and 26 teach the first and second mating fastening components. *Id.* at 31. Petitioner also asserts that Brandon's bonded seams and Anderson's refastenable seams are each disclosed as covering 80–100% of the distance between the waist and leg openings of their respective training pants. *Id.* at 24.

Patent Owner contends, however, that the combination of Brandon and Anderson fails to teach the requirement that “engagement of the fastening components and mating fastening components defines refastenable seams that cover about 80 to 100 percent of a distance between the waist opening and the leg openings,” as recited in claim 1. PO Resp. 28–31 (citing Ex. 2006 ¶¶ 65–70). Petitioner replies that Patent Owner's proffered expert, Mr. Butterworth, admitted that Brandon teaches a bonded seam extending 100% of the distance between the waist and leg openings, and that it was well known in the art to provide such a seam. Pet. Reply 11–12 (citing Ex. 1014, 81:22–82:22, 85:3–8).¹⁰

¹⁰ Petitioner argues that many of Patent Owner's arguments are collaterally estopped based on a district court decision involving the validity of a related patent. *E.g.*, Pet. Reply 3–6 (citing *Ohio Willow Wood Co. v. Alps South, LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013)). Petitioner also notes that the district court in a related case addressing the '379 patent recently entered summary judgment of invalidity against Patent Owner based on collateral estoppel. *See* Ex. 1034, 4–11. We need not reach the issue of collateral estoppel, however, because we conclude a preponderance of the evidence establishes that the challenged claims are unpatentable even considering Patent Owner's arguments.

Based on the full record after trial, the evidence presented supports Petitioner's view. It is undisputed that Brandon teaches a seam extending 100% of the distance between the waist and leg openings. See Tr. 44:13–15; Ex. 1014, 82:15–22. The record also indicates it was well known in the art generally to provide 80–100% seams. Ex. 1014, 85:3–8; Ex. 1021 ¶ 99. Although Patent Owner disputes that Anderson teaches an 80–100% seam, such an express disclosure is not required given Brandon's disclosure of a 100% seam. See *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”). Moreover, Petitioner argues persuasively that a person of ordinary skill would have understood Anderson also to teach an 80–100% seam because such a seam was known to be important to prevent undesired tearing or separation, and to best approximate a normal underpant. Pet. Reply 11–13; see Ex. 1006, 2:35–36, 4:32–37, Fig. 2; Ex. 1014, 83:14–23, 85:3–20; Ex. 1021 ¶¶ 99, 101, 102, 104, 106, 107.¹¹ In sum, Petitioner has established sufficiently that the combination of Brandon and Anderson teaches or suggests each limitation of claim 1.

¹¹ Patent Owner also argues that Petitioner failed to articulate sufficiently its arguments and supporting evidence regarding the 80–100% limitation in the Petition. Tr. 36:8–24. We disagree. See Pet. 24, 30–31. Moreover, we determine that Petitioner's Reply was properly responsive to the arguments and evidence presented in Patent Owner's Response, and did not introduce new theories or improper arguments on this issue.

Petitioner asserts that a person of ordinary skill would have been led to combine the training pants of Brandon with the refastenable seam of Anderson because the references identify solutions for the same problem, namely potential contamination on the child when removing soiled training pants. Pet. 22–24 (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419–20 (2007)). The record supports Petitioner’s position. Brandon states that “side seams 20 may be constructed to be manually tearable in order to allow training pant 10 to be disassembled manually by the caregiver, so that it can be easily removed from the child after a bowel movement.” Ex. 1002, 11. Anderson discloses that training pants with tearable seams “facilitate removal of the panty after the child has either a bowel accident or a bladder accident,” which reduces “incidents of contamination on the child and in the area surrounding the child.” Ex. 1006, 1:46–55. Anderson further teaches refastenable side seams, as discussed above, explaining that “in the event of an accident the [refastenable] seams are readily released to facilitate removal of the panty without undue contamination.” *Id.* at 4:32–37.

Patent Owner contends, however, that a person of ordinary skill would not have been motivated to combine Brandon and Anderson in the manner asserted by Petitioner because both Brandon and Anderson teach away from such a combination. PO Resp. 31–39. First, Patent Owner argues Brandon teaches that training pants should be designed to feel different than diapers to facilitate toilet training, but that replacing its bonded seams by adding refastenable seams such as in Anderson contradicts that goal by making the training pants resemble diapers. *Id.* at 32–35. The evidence of record, however, belies that argument. As Petitioner notes (Pet. Reply 13), Anderson discloses explicitly that its refastenable seams “approximate the side seams of a normal underpant” (Ex. 1006, 4:27–34), and notes the

importance of training pants that “look like a normal panty when first put on by the child” (*id.* at 2:35–36).

Next, Patent Owner argues Anderson teaches away from the asserted combination with Brandon because Anderson teaches away from using its releasable fastening system with a liquid impermeable outer cover, as taught by Brandon and required by claim 1. PO Resp. 35–39. Patent Owner is correct that Anderson discloses advantages to constructing training pants to allow some moisture to leak through the outer cover. *See, e.g.*, Ex. 1006, 3:40–49 (explaining that a preferred embodiment of Anderson includes a “moisture permeable outer covering” that facilitates toilet training by alerting the child to a bowel or bladder accident). According to Patent Owner, Anderson discloses the use of refastenable seams because they facilitate removal while minimizing contamination, which is only necessary due to the moisture permeable covering. *See* PO Resp. 37–38. Patent Owner’s position is unpersuasive, however, because merely describing the benefits of a moisture permeable cover does not teach away from using an impermeable cover. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004); *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). At the oral hearing, Patent Owner also admitted that nothing in the record indicates a person of ordinary skill would have been led to avoid training pants that do not allow moisture to leak through the outer cover. *See* Tr. 61:21–62:6; *see also* Ex. 1014, 339:10–18 (Mr. Butterworth testifying that Anderson does not disparage the use of refastenable seams with liquid permeable outer covers). Based on the full record after trial, Petitioner has established sufficiently a reason with rational underpinning to combine Brandon and Anderson. *See KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Consequently, a preponderance of the evidence supports Petitioner's position that claim 1 of the '379 patent is unpatentable as obvious in view of the combination of Brandon and Anderson.

5. *Claims 2, 3, 5–7, 10, 12, 13, 15, 17, 19–21, and 23*

Petitioner asserts that claims 2, 3, 5–7, 10, 12, 13, 15, 17, 19–21, and 23, which depend from claim 1, also would have been obvious to a person of ordinary skill in light of the combined teachings of Brandon and Anderson. *See* Pet. 25–26, 31–35. Patent Owner does not argue the patentability of these claims separately, relying instead on its arguments for claim 1, which are addressed above. Based on the full record after trial and the arguments presented by the parties, a preponderance of the evidence supports Petitioner's contentions that these dependent claims are unpatentable as obvious in view of the combination of Brandon and Anderson.

6. *Claim 4*

Claim 4 of the '379 patent depends from claim 3 and further recites, “wherein the first and second fastening components are sized larger than the first and second mating fastening components.” Petitioner cited *Gardner v. TEC Systems, Inc.* to argue that claim 4 is obvious because “the only difference between the prior art and [claim 4] is the recitation of relative dimensions, and a device having the claimed dimensions would not perform differently than the prior art.” Pet. 25 (citing 725 F.2d 1338 (Fed. Cir. 1984) (en banc)) (emphases omitted). In *Gardner*, the Federal Circuit affirmed a district court's decision invalidating claims where “the dimensional limitations did not specify a device which performed and operated any differently from the prior art.” 725 F.2d at 1349.

Patent Owner argued in its Response that *Gardner* does not compel a conclusion of obviousness because the Petition failed to provide sufficient

analysis, and applied *Gardner* incorrectly as a *per se* rule. PO Resp. 41–43 (citing *Ex Parte Goodrich*, Case No. 2009-009437, 2010 WL 3441066 (BPAI Aug. 30, 2010) (non-precedential)). Relying on Mr. Butterworth’s Declaration, Patent Owner asserted that the relative size limitation of claim 4 provides enhanced functionality—i.e., adjustability and better coverage of fastening surfaces to prevent abrasions—rebutting Petitioner’s argument that the recited size relationship does not result in different performance. *Id.* at 41 (citing Ex. 2006 ¶¶ 95–96).

Subsequent to the Patent Owner Response, Petitioner deposed Mr. Butterworth. Ex. 1014. Mr. Butterworth provided the following testimony at his deposition:

[Q.] So in -- in December of 1998, is it correct that a person of ordinary skill in the art would have the general understanding that a training pant having one set of fasteners larger than the other would allow for adjustability?

* * *

THE WITNESS: I believe that would be the case because when you make one mating surface larger than the other most people recognize that that means that the target can be adjusted.

* * *

Q. Well, were fasteners -- prior to December 1997 were training pants having fasteners sized larger than their mating pairs of fasteners known in the prior art?

A. They probably were.

Id. at 151:2–13, 152:10–14. Relying on this testimony, Petitioner in its Reply argued that claim 4 is obvious because Mr. Butterworth admitted the recited size limitation and its benefits were known in the prior art. Pet. Reply 17. Petitioner also alleged that Mr. Butterworth admitted the relative

size limitation of claim 4 is “not critical to the claims of the ’379 Patent,” asserting that this alleged admission supports its argument that claim 4 is obvious under *Gardner*. *Id.* at 17–18 (citing Ex. 1014, 149:20–150:23).

At the oral hearing, Patent Owner acknowledged Mr. Butterworth’s deposition testimony (Tr. 54:1–16), but argued the testimony should be disregarded because neither Mr. Butterworth nor Patent Owner had fair notice of Petitioner’s arguments or an adequate opportunity to present counterevidence—for example, regarding possible teaching away (e.g., Tr. 54:19–55:9). We disagree. As an initial matter, Patent Owner is correct that the Petition does not include specifically an allegation that the size limitation was known generally in the art, and does not present evidence of that fact. Such evidence, however, was introduced into the record through discovery in the form of Mr. Butterworth’s deposition testimony. Patent Owner does not advance persuasively any reason to block Petitioner from relying on this evidence, which could not have been cited in the Petition because Mr. Butterworth’s deposition had not yet occurred.¹² In essence, Patent Owner requests that the Board prevent Petitioner from using evidence in the record it admits is inconsistent with its position on patentability, and which its own expert provided to Petitioner during discovery. We decline to do so.

Nor are we persuaded by Patent Owner’s protestations of prejudice. Although Patent Owner asserts Mr. Butterworth was not given a fair opportunity to “prepare” for Petitioner’s questions, Patent Owner proffered him as an expert in this field and otherwise relies on his testimony regarding

¹² Although Petitioner’s position would have been stronger had it provided similar evidence with the Petition, the fact remains that the record includes Mr. Butterworth’s testimony, which was routine discovery provided in the normal course of this *inter partes* review. See 37 C.F.R. § 42.51(b)(1)(ii).

similar issues. *See, e.g.*, PO Resp. 33–35 (citing Ex. 2006 ¶¶ 74–77 (Mr. Butterworth’s declaration testimony regarding “the conventional wisdom in the industry at the time of the invention”)). The testimony relied on by Petitioner was provided in response to basic questions about the understanding of a person of ordinary skill in the art and whether the recited limitation was known in the art at the time of the invention. Ex. 1014, 151:2–13, 152:10–14. Moreover, the Petition plainly raised the issue of whether any alleged functionality of the limitations of claim 4 already was known to be provided by the prior art. Pet. 25. Petitioner’s questioning of Mr. Butterworth on this issue should not have been unexpected considering he provided testimony on the subject in his Declaration, which Patent Owner submitted with its Response. *See* Ex. 2006 ¶ 95; PO Resp. 41.

Patent Owner does not dispute the veracity of Mr. Butterworth’s testimony. Further, Patent Owner does not argue that he misunderstood the questions (Tr. 53:18–24), and did not move to exclude the testimony.¹³ Patent Owner had the opportunity to adduce further testimony from Mr. Butterworth at his deposition to clarify or supplement his testimony, but it did not do so with respect to the testimony at issue. *See* Tr. 57:12–58:8. No attempt was made to seek relief from the Board or to introduce further information into the record (e.g., a supplemental declaration or additional briefing). *See* Tr. 59:18–60:6. Patent Owner made no request to have Mr.

¹³ Patent Owner properly raised at the oral hearing the issue of whether Petitioner’s arguments should be disregarded as improper new arguments, rather than raising the issue in a motion to exclude. *See* Tr. 58:9–59:2. That is a distinct issue, however, from whether Mr. Butterworth’s cross-examination testimony should be excluded as inadmissible because it is allegedly misleading or incomplete. In any event, we also conclude Petitioner’s arguments were not improper.

Butterworth testify at the oral hearing, or to secure any other opportunity for him to provide the additional testimony or evidence that Patent Owner asserts was prevented unfairly. *See id.* In these circumstances, we conclude that Petitioner's reliance on Mr. Butterworth's testimony is not improper, and that Patent Owner was not unfairly prejudiced.

Based on Mr. Butterworth's testimony, which we find credible, the record indicates that the limitations of claim 4 were known and obvious to one of ordinary skill in the art. Additionally, the record supports Petitioner's argument that the size limitations of claim 4 do not distinguish the claim from the prior art, which ordinary artisans knew to provide the benefit of adjustability, as Mr. Butterworth testified. *See Gardner*, 725 F.2d at 1349. Petitioner's contentions are further supported by the evidence indicating this alleged benefit was not a critical aspect of the claimed invention. *See In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990) ("These cases [including *Gardner*] have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range."). Consequently, considering the full record after trial, a preponderance of the evidence supports Petitioner's contention that claim 4 would have been obvious in view of the combination of Brandon and Anderson.

7. *Claims 8, 9, and 22*

Claim 8 of the '379 patent depends from claim 7 (which depends from claim 1), and further recites, "wherein the mating fastening components have a length-to-width ratio of about 5 or greater." Claim 22 also depends indirectly from claim 1, and further recites, "wherein the fastening components and the mating fastening components have a length-to-width ratio of about 5 or greater." Petitioner relies on *Gardner*, arguing that these

“length-to-width ratio” limitations do not distinguish the claims from the prior art. Pet. 25; Pet. Reply 18–19.

In support of its arguments, Petitioner cites Mr. Butterworth’s deposition testimony in which he acknowledges that the ’379 patent specification describes ratios other than 5 or greater—and, specifically, a ratio of 2 or greater—as desirable. See Ex. 1014, 153:14–154:17; Ex. 1001, 17:9–12. In addition, Petitioner cites Mr. Butterworth’s testimony that the ’379 patent does not describe any “benefits” of a ratio of 5 or greater compared to, for example, a ratio of 2 or greater. See Ex. 1014, 156:12–23. Based on this testimony, Petitioner contends claims 8 and 22 are unpatentable under *Gardner* because the recited size limitation does not provide any particular benefits and, thus, is not “critical” to the invention. Pet. Reply 18–19; see *Woodruff*, 919 F.2d at 1578. Petitioner’s arguments are persuasive and are supported by the record.

Patent Owner contends that, in fact, the recited ratio of claims 8 and 22 provides benefits over the prior art. PO Resp. 43–44. For example, Patent Owner asserts that the recited ratio “preserves the elasticity of the side panel” and “aids in the flexibility of the fastener.” *Id.* at 44 (citing Ex. 2006 ¶ 99). These contentions are not persuasive, however, because Patent Owner does not identify evidence indicating these are improvements over the prior art. See *Gardner*, 725 F.2d at 1345–46 (focusing on whether the claimed size limitations “result in differences in performance over the prior art”). The only support in the record cited by Patent Owner is Mr. Butterworth’s Declaration, but he does not cite any evidence and does not purport to compare the alleged improved performance of the 5 or greater ratio to the performance of prior art fastening components. Ex. 2006 ¶ 99. For example, Mr. Butterworth states that “narrow” fasteners, such as

fasteners with a length-to-width ratio of 5 or greater, preserve the elasticity of the side panel, but he does not address whether “narrow” fasteners outside the recited range existed in the prior art, or whether prior art fasteners could also preserve side panel elasticity. *See id.*

Petitioner’s position is more persuasive and better supported by the record. As Mr. Butterworth testified at his deposition, the ’379 patent does not ascribe any particular advantage or difference in performance to the 5 or greater ratio, and indicates ratios outside of the recited ratio (such as 2 or greater) are also desirable. *See* Ex. 1014, 153:14–154:17, 156:12–23; Ex. 1001, 17:9–12. Based on *Gardner* and the full record after trial, a preponderance of the evidence supports Petitioner’s contention that claims 8 and 22 are obvious in view of the combination of Brandon and Anderson.¹⁴

Claim 9 depends from claim 8. Petitioner provides arguments and evidence supporting its contention that the limitations of claim 9 are taught by Brandon, and, thus, the claim would have been obvious in view of the combination of Brandon and Anderson. *See* Pet. 32. Patent Owner does not argue the patentability of claim 9 separately, relying instead on its arguments for claims 1 and 8, which are addressed above. Based on the full record after trial and the arguments presented by the parties, a preponderance of the evidence establishes that claim 9 is unpatentable as obvious in view of the combination of Brandon and Anderson.

8. *Claim 16*

Claim 16 depends from claim 1 and further recites, “wherein the training pant is prefastened to provide a pant-like product for the user.”

¹⁴ Petitioner also argues that Long teaches a 7:1 size ratio. Pet. Reply 18. Trial was not instituted on any ground based on Long for claims 8 or 22. Inst. Dec. 9. Thus, we do not consider this argument for this Decision.

Petitioner identifies disclosures in both Brandon and Anderson as teaching the subject matter of claim 16. *See* Pet. 33. For example, Petitioner relies on Anderson's disclosure that the described training panty "should look like a normal panty when first put on by the child." *See* Ex. 1006, 2:35–36. The record supports Petitioner's contentions.

Patent Owner contends that neither Brandon nor Anderson teaches fastening components disposed on side panels. PO Resp. 45. For the reasons discussed above for claim 1, we conclude Anderson teaches the claimed fastening components (and mating fastening components) disposed on side panels. Patent Owner also argues that neither Brandon nor Anderson teaches "prefastened" training pants because they do not disclose whether the described training pants are fastened during manufacture or prior to sale. This argument is unpersuasive. As discussed above, however, the broadest reasonable interpretation of this limitation requires that the training pant be fastened prior to wear, but does not require fastening during manufacture or prior to sale.

Based on the record and arguments presented, a preponderance of the evidence supports Petitioner's contention that claim 16 would have been obvious in view of Brandon and Anderson.

9. *Claims 11 and 14*

Petitioner contends claims 11 and 14 are unpatentable in view of the combination of Brandon, Anderson, and Long. Pet. 42, 44. Both claims depend from claim 1, and Petitioner relies on the combination of Brandon and Anderson for the limitations of the independent claim. *See id.* at 39. For the "containment flaps" and "surge layer" limitations of claims 11 and 14, respectively, Petitioner relies on elasticized containment flaps 82 and surge management portion 84 in Long. *Id.* at 42 (citing Ex. 1007, 4:53–63,

10:30–50, 11:63–12:16, Figs. 1, 2). Further, Petitioner asserts that a “clear motivation” existed to combine Long (and Enloe, which is incorporated by reference) with Brandon and Anderson to avoid soilage, a goal that would be facilitated by the teachings of Long. *Id.* (citing Ex. 1007, 10:30–50; Ex. 1012, 2:57–65 (Enloe)).

Patent Owner does not dispute that Long teaches these elements, but argues instead that Anderson teaches away from the asserted combination because Anderson teaches that permitting moisture to leak through the outer cover is advantageous, which would be frustrated by the anti-leak features taught by Long. *See* PO Resp. 39–41. This argument is unpersuasive for same reasons as Patent Owner’s similar argument for claim 1.

Based on the record and evidence presented, Petitioner has shown sufficiently that the combination of Brandon, Anderson, and Long teaches the limitations of claims 11 and 14. Petitioner also has articulated reasoning with rational underpinning to combine these references in the manner asserted. *See KSR*, 550 U.S. at 418. Thus, Petitioner has demonstrated by a preponderance of the evidence that claims 11 and 14 are unpatentable under § 103 in view of Brandon, Anderson, and Long.

10. Claims 18 and 24

Claims 18 and 24 each depend from claim 1 and further recite that the front side panels are “non-stretchable” and “do not comprise elastic materials,” respectively. Petitioner contends these claims are obvious in view of Brandon, Anderson, and Long. Pet. 41–42, 44–45. Specifically, Petitioner relies on Long’s disclosure that side panels 90 may be composed of “a substantially non-elastomeric material, such as polymer films, woven fabrics, nonwoven fabrics or the like, as well as combinations thereof.” *See* Ex. 1007, 13:18–21. In addition, Petitioner argues that replacing an elastic

side panel, such as taught in Brandon, with a non-elastomeric panel, such as taught in Long, would not have been difficult and would have been an obvious design choice between a finite number of identified, predictable solutions. Pet. 41–42 (citing *KSR*, 550 U.S. at 421).

Patent Owner argues that “non-elastomeric” materials are not necessarily “non-stretchable.” PO Resp. 48–49. As discussed above, the broadest reasonable interpretation of “non-stretchable” is “unable to elongate,” and some non-elastomeric materials are able to elongate. Further, Patent Owner asserts that modifying the elastomeric side panels of Brandon to incorporate a non-stretchable front side panel would have been difficult, and would have required “significant modification” of the Brandon training pants. *Id.* at 49–50.

As an initial matter, Patent Owner is correct that the teaching of non-elastomeric side panels in Long does not necessarily teach non-stretchable side panels because, as Petitioner admitted (Tr. 30:12–31:14), not all non-elastomeric materials are non-stretchable. We are persuaded, however, that choosing a non-stretchable material for the side panels would have been an obvious design choice based on the teachings of the prior art and the knowledge of skilled artisans at the time of the invention.

Mr. Butterworth testified at his deposition that, at the time of the invention, a skilled artisan would have known of only three options with respect to choosing a type of material for the side panels of training pants: (1) elastic,¹⁵ (2) non-stretchable, and (3) stretchable (but not elastic). See Ex. 1014, 207:14–208:11. He further testified that a person of ordinary skill would have been able to choose an appropriate type of material from among

¹⁵ As noted earlier, the parties do not dispute that “elastic” and “elastomeric” are interchangeable for all relevant purposes.

those options, and would have been able to identify a specific material of that type. *See id.* at 254:4–255:15. Although Mr. Butterworth testified in his Declaration that modifying Brandon’s training pants to incorporate a non-stretchable front side panel would require “significant modification” (Ex. 2006 ¶ 112), he did not testify that such modifications would have been beyond the skill of an ordinary artisan.

The Supreme Court has instructed that:

[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

KSR, 550 U.S. at 421. The record supports Petitioner’s contention that a finite number of identified, predictable solutions for the material composition of training pant side panels were known to ordinary artisans at the time of the invention, including non-stretchable materials. Further, the evidence presented indicates that an ordinary artisan would have been able to select and implement a non-stretchable material for the front side panels of a training pant. Thus, a preponderance of the evidence indicates that claim 18 would have been obvious and, thus, is unpatentable under § 103. A preponderance of the evidence also indicates that claim 24 is unpatentable as obvious for similar reasons.

11. Reasonable Expectation of Success

In addition to the arguments addressed above, Patent Owner further alleged that a person of ordinary skill would not have expected the training pants taught by the prior art combinations advanced by Petitioner to work

successfully for its intended purpose. PO Resp. 50–54. Specifically, Patent Owner contends that a skilled artisan would have expected training pants with refastenable seams would fail because it would be too easy for children to disengage the fastening components, causing an unintentional failure of the seams. *See id.*

As Petitioner notes (Pet. Reply 22–23), however, the challenged claims do not require any particular degree of fastening efficacy. Nor does the ’379 patent identify or discuss the problem posited by Patent Owner, much less indicate that the claimed invention avoids or mitigates such a problem, or improves upon the prior art in that respect. Indeed, both the ’379 patent and Anderson utilize hook and loop fasteners, such as Velcro, which Patent Owner alleges suffers from the problem of unintentional seam failure. *See* Ex. 1001, 15:51–59; Ex. 1006, 4:27–32, Figs. 1, 2. Thus, unintentional seam failure due to the alleged weakness of refastenable seams is not a persuasive basis on which to distinguish the challenged claims from the prior art. In other words, a reasonable expectation of success with respect to the grounds of unpatentability asserted by Petitioner against the challenged claims here need not include “success” in avoiding the alleged weakness of refastenable seams, because such a property is not required by the challenged claims.

Thus, we are not persuaded that the grounds asserted by Petitioner are defeated because there was no reasonable expectation of success.

12. *Secondary Considerations of Non-Obviousness*

Patent Owner further contends that secondary considerations of non-obviousness compel a conclusion that the challenged claims are not unpatentable as obvious. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (holding that secondary considerations must be considered to

determine if challenged claims are not obvious). Specifically, Patent Owner alleges that the evidence of record establishes commercial success and industry skepticism, which are strong objective indicia of patentability. PO Resp. 54–60.¹⁶ Based on the evidence and arguments presented, however, the evidence of alleged secondary considerations is insufficient to overcome the strong evidence of obviousness discussed above.

a. Commercial Success

Patent Owner provides extensive evidence of alleged commercial success, including data regarding sales and relative market share, consumer studies regarding the specific product features and consumer preferences driving those sales, and declaration testimony from three witnesses. PO Resp. 55–60. Based on this evidence, Patent Owner relies on the alleged commercial success of its PULL-UPS refastenable training pants, and contends that a nexus exists between that commercial success and the “patented elastomeric refastenable sides” of the PULL-UPS product. *Id.*

To establish a nexus between alleged commercial success and the challenged claims, Patent Owner must show “that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent.” *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988); *see also In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995) (holding that a nexus was not demonstrated where “GPAC did not establish which claim(s) of the patent the [allegedly successful] licensing program incorporates”). Patent Owner does not,

¹⁶ As indicated earlier, we need not reach the issue of whether Patent Owner’s arguments as to secondary considerations are barred due to collateral estoppel because we conclude that a preponderance of the evidence establishes that the challenged claims are unpatentable, even considering Patent Owner’s arguments and evidence.

however, provide an analysis establishing that its PULL-UPS product practices any claim or claims of the '379 patent.

In addition, even assuming *arguendo* that Patent Owner's evidence establishes a nexus between the commercial success of its PULL-UPS product and the specific refastenable fastening system recited in the challenged claims, Patent Owner has failed to demonstrate that "the asserted commercial success of the product [is] due to the merits of the claimed invention *beyond what was readily available in the prior art.*" See *J. T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997) (emphasis added). As discussed above, the record establishes that the refastenable fastening system recited in the challenged claims was taught in the prior art.

Relying on *Gillette Co. v. S.C. Johnson & Son, Inc.*, Patent Owner argues that the "fact that all elements of a claim are in the prior art does not by itself defeat commercial success," and that "the prior art discloses only individual elements of the patented training pants, but there is no prior art that discloses the unique combination found in the claims of the '379 Patent." PO Resp. 59 (citing 919 F.2d 720, 725 (Fed.Cir.1990)). In *Gillette*, although each individual element of the claimed chemical composition was known in the art, it was undisputed that the composition as a whole had "superior properties" that were unique to the composition rather than any individual component. See 919 F.2d at 725. In contrast, Patent Owner's arguments and evidence focus on a single element of its claimed invention—"refastenable elastomeric sides"—and Patent Owner does not identify any evidence indicating the claimed refastenable sides (or any other claimed

feature) had unique properties or advantages beyond those found in the prior art training pants relied on by Petitioner.¹⁷ See PO Resp. 56–58.

Based on the full record after trial, Patent Owner has not established an adequate nexus between the alleged commercial success of its PULL-UPS products and the challenged claims.

b. Industry Skepticism

Patent Owner also posits that the evidence it presents with respect to reasonable expectation of success also demonstrates industry skepticism of the efficacy of refastenable elastomeric side panels. See PO Resp. 60. Skepticism in the art may be relevant and persuasive evidence of non-obviousness. See *Gillette*, 919 F.2d at 726. This argument is unpersuasive, however, for reasons similar to those already discussed above. For example, Patent Owner has not explained sufficiently how the refastenable seams of the claimed invention are different, or yield different results, than those of prior art training pants. Further, Patent Owner has not demonstrated that the claimed invention actually overcame the alleged concerns underlying the industry skepticism. Cf. *id.* (approving the district court’s conclusion that skepticism was persuasive evidence of non-obviousness where the claimed invention *actually provided better results*, contrary to expectations in the field). Moreover, the challenged claims do not require the refastenable side panels to be effective to any specific degree with regard to unintentional seam failures. Thus, skepticism that such side panels could achieve a

¹⁷ Indeed, evidence in the record suggests that the only distinction between the refastenable sides of the challenged claims and Anderson’s refastenable sides that arguably is identified by Patent Owner—that they are “elastomeric”—may have been considered a *drawback* at the time of the invention. See PO Resp. 51–53 (citing evidence allegedly showing that refastenable elastomeric side panels were expected to be problematic).

particular degree of efficacy has little relevance to whether the recited refastenable side panels, or the challenged claims as a whole, are obvious in light of the prior art.

c. Long-Felt But Unmet Need

In a section titled “Resolving the Level of Ordinary Skill in the Art,” the Patent Owner’s Corrected Response addresses alleged facts and provides arguments that appear to advance a theory that the invention of the ’379 patent solved a long-felt but unmet need. *See* PO Resp. 7–9. While this aspect of the Response may not meet the standard of clarity required by our Rules, we consider nonetheless these arguments and conclude they are unpersuasive for reasons similar to those discussed above with respect to alleged industry skepticism and reasonable expectation of success. For example, Patent Owner cites no evidence supporting its allegation that the training pants of the ’379 patent solved the “problems” it identifies, nor does Patent Owner explain how any specific feature of the claimed training pants is distinguishable from the prior art in terms of solving such problems.

13. Conclusion as to Asserted Grounds of Unpatentability

For the reasons discussed above and based on the full record after trial, we conclude Petitioner has established by a preponderance of the evidence that: (1) claims 1–10, 12, 13, 15–17, and 19–23 are unpatentable under § 103 in view of the combination of Brandon and Anderson; and (2) claims 11, 14, 18, and 24 are unpatentable under § 103 in view of the combination of Brandon, Anderson, and Long.

C. Petitioner’s Motion to Exclude

Petitioner filed a Motion to Exclude Evidence requesting that several categories of evidence submitted by Patent Owner be excluded. Paper 38 (“Mot. Excl.”). Patent Owner filed an Opposition to the Motion (Paper 43,

“Opp. Mot. Excl.”), and Petitioner filed a Reply in support of its Motion (Paper 46, “Reply Mot. Excl.”).¹⁸

First, Petitioner seeks to exclude all of Patent Owner’s evidence relating to secondary considerations of non-obviousness as not relevant under Fed. R. Evid. 401 and 402. Mot. Excl. 2–5. In essence, Petitioner argues that Patent Owner failed to provide certain analyses and evidence necessary to sustain its arguments as to secondary considerations and, thus, all related evidence is irrelevant. *See id.* Rule 401 states that evidence is relevant if “(a) it has any tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action.” Petitioner does not dispute that the evidence in question pertains to facts underlying Patent Owner’s contentions regarding secondary considerations. Whether Patent Owner failed to provide sufficient evidence or neglected to supply all of the necessary analysis does not negate the relevance of that evidence. In addition, we note that Petitioner’s motion is moot because of our decision above that the challenged claims are unpatentable even considering this evidence. This portion of the Motion is *denied*.

Second, Petitioner moves to exclude essentially all of Patent Owner’s evidence regarding obviousness as not relevant under Fed. R. Evid. 401 and 402 because, it contends, Patent Owner is collaterally estopped from advancing the corresponding arguments. Mot. Excl. 6–8. Petitioner’s motion is moot, however, because of our decision above that the challenged claims are unpatentable even considering this evidence. This portion of the Motion is *dismissed as moot*.

¹⁸ Petitioner moved to exclude Exhibit 2042 in the Motion to Exclude, but withdrew its objection in its Reply. *See* Reply Mot. Excl. 5.

Third, Petitioner moves to exclude Exhibits 2032–2036 as not relevant under Fed. R. Evid. 401 and 402, not authenticated under Fed. R. Evid. 901, and because they allegedly lack foundation. Mot. Excl. 8–9. Petitioner’s motion is moot because of our decision above that the challenged claims are unpatentable even considering this evidence. This portion of the Motion is *dismissed as moot*.

Fourth, Petitioner moves to exclude alleged opinions set forth in paragraph 11 of Exhibit 2039 as not relevant under Fed. R. Evid. 401 and 402. Mot. Excl. 9–11. The testimony at issue addressed considerations involved in designing training pants prior to the introduction of Patent Owner’s PULL-UPS products, which Patent Owner relies on for its commercial success arguments. *See* Ex. 2039 ¶ 11. This testimony is clearly relevant to factual issues of consequence in assessing secondary considerations of non-obviousness. Thus, Petitioner’s motion to exclude this testimony under Rules 401 and 402 is *denied*.¹⁹

Finally, Petitioner moves to exclude Exhibits 2017–2021 as inadmissible hearsay under Fed. R. Evid. 802, and as not authenticated under Fed. R. Evid. 901. Mot. Excl. 12. The parties do not dispute that these documents were relied on by Steven S. Bullock—who was proffered by Patent Owner as an expert witness—in forming the opinions expressed in his Declaration (Ex. 2024). Mot. Excl. 12; Opp. Mot. Excl. 15. An expert witness may rely on otherwise inadmissible evidence in forming his opinions. Fed. R. Evid. 703. Petitioner does not dispute that experts in Mr.

¹⁹ Although Petitioner’s arguments for excluding Ms. Panning’s testimony focus on whether they contain improper opinions because she was not proffered as an expert, Petitioner does not move to exclude the testimony under Fed. R. Evid. 701.

Bullock's field would reasonably rely on information like Exhibits 2017–2021 in forming their opinions. *See id.* Thus, after consideration of the parties' arguments, Petitioner's motion to exclude these exhibits is *denied*.

D. Motions to Seal

The parties filed several motions to seal. Patent Owner moves to seal portions of Exhibit 2039, which it asserts contains confidential information belonging to a non-party, Procter and Gamble. Paper 17, 2. The parties jointly move to seal portions of Exhibit 1019, the transcript of a deposition of Cynthia Panning, because it purportedly contains confidential trade secret information belonging to Patent Owner. Paper 18, 2. Petitioner moves to seal the portions of its Petitioner's Reply and Exhibit 1021 (Rebuttal Declaration of John Blevins) referencing confidential portions of Exhibits 2039 and 1019. Paper 21, 2–3. The parties move jointly to seal Exhibits 2043, 2044, 2046–2049, 2051, and 2052, as well as portions of Patent Owner's Motion to Vacate (Paper 25) that reference those exhibits. Paper 29, 1–2. The parties assert that these exhibits contain sensitive and confidential business, financial, and/or strategy information of Petitioner and other entities affiliated with Petitioner. *Id.* at 2–6. Petitioner moves to seal portions of its Opposition to Patent Owner's Motion to Vacate as well as portions of Exhibit 1031, the Declaration of Holly Ellers, which was submitted in conjunction with its Opposition and purportedly contains Petitioner's confidential business information. Paper 32, 2–4. Finally, Patent Owner moves to seal Exhibit 2055, which purportedly contains the confidential information of a non-party, Procter and Gamble. Paper 36, 1–2. The parties also move to enter a proposed Protective Order attached as Exhibit A to Paper 17.

Upon review, good cause exists to seal the above information as set forth in the above motions. In addition, the parties' proposed Protective Order is acceptable and will be entered. We note that none of the sealed information was relied upon or disclosed in this Decision.

Because there is an expectation that information will be made public where the information is identified in a final written decision, confidential information that is subject to a protective order ordinarily would become public 45 days after final judgment in a trial, unless a motion to expunge is granted. 37 C.F.R. § 42.56; Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012). A party who is dissatisfied with this Final Written Decision, however, may appeal this Decision pursuant to 35 U.S.C. § 141(c), and has 63 days after the date of this Decision to file a notice of appeal. 37 C.F.R. § 90.3(a).

In view of the above, the sealed information discussed above will remain under seal, at least until the time period for filing a notice of appeal has expired or, if an appeal is taken, the appeal process has concluded. The record for the instant proceeding will be preserved in its entirety, and the confidential documents will not be expunged or made public, pending possible appeal. Notwithstanding 37 C.F.R. § 42.56 and the Office Patent Trial Practice Guide, neither a motion to expunge confidential documents nor a motion to maintain these documents under seal is necessary or authorized at this time. *See* 37 C.F.R. § 42.5(b).

CONCLUSION

For the foregoing reasons, Petitioner has shown by a preponderance of the evidence that claims 1–24 of the '379 patent are unpatentable under 35 U.S.C. § 103(a).

ORDER

It is

ORDERED that claims 1–24 of the '379 patent are held unpatentable under 35 U.S.C. § 103(a);

FURTHER ORDERED that Petitioner's Motion to Exclude Evidence (Paper 38) is denied-in-part and dismissed-in-part;

FURTHER ORDERED that the proposed Protective Order (Ex. A to Paper 17) is entered;

FURTHER ORDERED that the parties' Motions to Seal (Papers 17, 18, 21, 29, 32, and 36) are granted;

FURTHER ORDERED that the information sealed in this Decision remain under seal, and the record preserved, until the time period for filing a notice of appeal of this Decision has expired or, if an appeal is taken, the appeal process has concluded; and

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

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