

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BABY TREND, INC., DENNY TSAI, and BETTY TSAI,
Petitioner,

v.

WONDERLAND NURSERYGOODS CO., LTD.,
Patent Owner.

Case IPR2015-00841
Patent RE43,919

Before JAMES P. CALVE, JEREMY M. PLENZLER, and
JAMES A. WORTH, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* CALVE.

Opinion Dissenting filed by *Administrative Patent Judge* WORTH.

DECISION
Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Patent Owner Wonderland Nurserygoods Co., Ltd. (“Patent Owner”) filed a Request for Rehearing (Paper 79, “Req.”) of our Final Written Decision (Paper 77, “Dec.”) in which claims 15–29 of U.S. Patent No. RE43,919 (Ex. 1001, “the ’919 patent”) were found to be unpatentable. Dec. 89. We have considered Patent Owner’s Request for Rehearing but decline to modify the Decision.

II. STANDARD OF REVIEW

A party challenging a final written decision in a request for rehearing must identify all matters the party believes that the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). The challenging party bears the burden of showing that the decision should be modified. *Id.*

III. DISCUSSION

A. Introduction/Overview

In the Final Written Decision, we interpreted the claims under the broadest reasonable interpretation standard, which is the standard that is appropriate to these proceedings. Dec. 8. We interpreted the claims based on the claim language, specification, and prosecution history.

We interpreted “a fabric member” to include a single piece of fabric. Dec. 18–19. This interpretation encompasses the preferred embodiment of a baby crib in which fabric member 2 is mounted to bed frame structure 1. Ex. 1003, 2:17–20, Figs. 3–5; *see* Ex. 1001, 2:17–20, Figs. 3–5.

We also interpreted “an enclosure member” to mean “one or more members” based on the use of “an” and the plain language of claims 15 and 20, which recite an enclosure member including a plurality of side panels with edge portions, the Specification, and prosecution history. Dec. 17.

We interpreted the term “a” and “an” to mean one or more. *Id.* In related district court litigation involving the ’919 patent, Patent Owner has asserted that the term “an” can mean “one or more.” Ex. 1032, 6–7 (“it is generally accepted in patent parlance that ‘a’ or ‘an’ can mean ‘one or more.’”), 9 (“it is black-letter patent law that ‘an’ means ‘one or more’ in a patent claim.”).¹

35 U.S.C. § 251(a) is not a rule of claim construction in *inter partes* proceedings. § 251 prevents a patentee from claiming more in reissue than was disclosed of the invention in the original patent. We interpret the claims of the ’919 patent under a broadest reasonable interpretation standard in these proceedings. During reissue proceedings, Patent Owner represented that the amendments to the claims and specification did not introduce new matter. The Examiner found that those amendments did not introduce new matter and entered those amendments to the specification and claims.

In the event that our reviewing court disagrees with us, we agree with the Dissent that the reissued claims of the ’919 patent violate the original patent requirement of § 251. The scope of each of independent claims 1, 8, 15, and 20 was broadened beyond the invention that was disclosed in the ’957 patent.

In the Notice of Allowability for the ’957 patent, the Examiner stated that claims 1–7 were allowed because the prior art did not teach or suggest a baby crib with (1) a fabric member clamped between plural positioning posts and a plurality of upright posts (2) where each upright post has a tube wall

¹ All citations to Exhibit 1032, which is Patent Owner’s “Memorandum in Support of Motion for Summary Judgment of Infringement,” are to the page numbers of the document, not page numbers added to the exhibit.

defining a receiving hole for a positioning post and (3) *a slit* extending along the length of the tube wall and communicating with the receiving hole, and (4) the fabric member extends outwardly through *the slit* in each upright tube. Ex. 2002 (Notice of Allowability), 6 (Reasons for Allowance).

Claim 1 was amended during reissue to remove the limitation that the fabric member extends through a single slit in each upright tube and claim that the fabric member extends from each of the slits in each of the upright tubes. This amendment leaves open the possibility that each upright tube has a single slit of the preferred embodiment and more than one slit per tube.

Claims 8, 15, and 20 do not recite a slit in the upright tubes. They do not recite a fabric member that extends through a single slit in each upright tube. They do not recite that the enclosure member is clamped between the positioning posts and upright tubes. They do not recite an enclosure member formed of a single body. Claims 15 and 20 recite side panels with edges.

Patent Owner's infringement contentions in a related district court action between these parties demonstrate that the scope of the '919 patent was broadened beyond the invention disclosed in the '957 patent. Patent Owner has asserted the '919 patent against a play yard that includes two slits in each upright tube. The accused Breeze play yard includes an enclosure member with separate panels. Only one panel extends through each of the two slits on each upright tube. In addition, the edges of the side panels are not connected to one another. The edges are connected by another panel.

There is no complex reissue issue to be resolved, notwithstanding the Dissent's and Patent Owner's arguments to the contrary. We do not believe that we overlooked or misperceived any of the matters set forth in the Request for Rehearing.

B. Our Interpretation Comports with Ordinary Meaning of the Claims

Our interpretation of “a fabric member” and “an enclosure member” is consistent with the ordinary meaning of those terms.

We interpreted “a fabric member” in claim 1 to mean a single piece of fabric or multiple pieces of fabric. Dec. 18. This meaning encompasses the preferred embodiment of the ’957 specification in which fabric member 2 is mounted to bed frame 1. *See* Ex. 1003, 2:13–34, Figs. 3–5.

It is well-settled that “a” and “an” mean “one or more” unless a clear intent is evinced to limit those terms to just “one.” Dec. 17. In contrast to Patent Owner’s arguments in this proceeding (Req. 8–9), Patent Owner, in related district court action, repeatedly asserted that the term “an” in claim 8 can mean “one or more.” Ex. 1032, 6–7 (“it is generally accepted in patent parlance that ‘a’ or ‘an’ can mean ‘one or more.’”), 9 (“it is black-letter patent law that ‘an’ means ‘one or more’ in a patent claim.”).

Original reissue claim 8 recited “an enclosure member formed in a single body and defining a plurality of side panels joined one another.” *See* Ex. 1004, 511. This language indicates that “an enclosure member” by itself does not connote a single, monolithic element. Dec. 17–19. It also indicates that the side panels of an enclosure member recited in claims 15 and 20 are not understood to be joined to one another unless claimed to be so joined.

Independent claim 15 recites “*an enclosure member including a plurality of side panels contiguously connected to one another along edge portions and surrounding an enclosed space.*” The plain meaning of this language is that the enclosure member includes plural side panels that are connected contiguously to one another along edge portions. Side panels are not necessarily understood to be connected along their edge portions even

when they surround an enclosed space unless they are claimed to be as in claim 15, in contrast to claim 8. “[A]n enclosure member” is not claimed as a monolithic member formed in a single body, either, in claim 15. *Id.* at 19.

Independent claim 20 recites “*an enclosure member including a plurality of side panels having edge portions . . . whereby the side panels surround an enclosed space, and each of the side panels extends generally between two of the support tubes substantially out of contact with outwardly facing surfaces of the outer walls thereof.*” Claim 20 also recites that “*the edge portions of the enclosure member*” are mounted and secured along the support tubes. *Id.* at 20.

Like claim 15, “an enclosure member” is made up of a plurality of individual side panels. In contrast to claim 15, claim 20 does not require the edge portions of the side panels to be connected contiguously or otherwise to one another. The side panels merely need to surround an enclosed space and extend between two of the support tubes. Therefore, claim 20 does not, by its plain language, require edges of the side panels of the enclosure member to be connected or formed as a unitary enclosure member. *See id.* at 20.

Patent Owner argues that our interpretation of “an enclosure member” is in error because

all terms in a claim should be given meaning, and in order to give meaning to the term “enclosure member,” the member must surround an enclosed space and must be understood to itself be a distinct, single unit in order for the “enclosure member” to be attached to a frame structure or upright tubes/support tubes as required by the claims.

Req. 9. This argument is not persuasive of error in our interpretation.

Independent claim 1 recites “a fabric member.” Independent claims 8, 15, and 20 recite “an enclosure member” that further includes side panels in claims 15 and 20. Each of these members also defines a surrounding wall or surrounds an enclosed space. In claim 1, “a fabric member” “define[s] a surrounding wall.” In claims 8 and 15, “an enclosure member” “surround[s] an enclosed space.” In claim 20, “the side panels surround an enclosed space.” In order to give meaning to the “surrounding wall” or “surrounding” limitations, we did not read the limitations into fabric or enclosure member.

If we had interpreted “an enclosure member” to mean “one or more members” that “surround an enclosed space” as Patent Owner urges (Req. 9), we would have interpreted the enclosure member to include features that are recited expressly in claims 8, 15, and 20. We thus interpreted these limitations to avoid rendering other claim terms like “surround[ing] an enclosed space” in claims 8, 15, and 20 superfluous. Dec. 18–19. Patent Owner’s Response did not propose any meaning for the term “enclosure” in “an enclosure member.” Paper 26 (“PO Resp.”), 13–14. Instead, Patent Owner argued that “an enclosure member” is “a unitary enclosure element comprising a plurality of side panels.” *Id.* Patent Owner used “enclosure” to define enclosure member, and also read “a plurality of side panels” into enclosure member when side panels are recited in claims 15 and 20.

Because we interpreted claims 8, 15, and 20 to require the enclosure member to surround an enclosed space in our analysis of the asserted grounds of unpatentability, we gave meaning to all terms in the claims and have addressed Patent Owner’s concerns. We determined that the prior art disclosed an enclosure member with side panels surrounding an enclosed space as recited in claims 15 and 20. Dec. 31, 33–34.

Pasin discloses this exact arrangement of claim 20. Pasin discloses an enclosure member 10 with plural side panels 12 that surround an enclosed space. Ex. 1015, 1:21–54, 2:14–25. Panels 12 are mounted on upright tubes 14 with keder connections to form structures such as forts, houses, tents, tunnels, and caves that surround an enclosed space. *Id.* at 1:39–41. Pasin illustrates an exemplary house. *Id.* at 1:39–43, 2:18–21, Fig. 1. Edges of side panels 12 mount and secure along slits in support tubes (frame members 14). *Id.* at 3:3–22, Figs. 1, 4, 4A, 6A, 6B, 7; *see* Dec. 28–35.

Pasin illustrates that an enclosure member can be formed of separate side panels that are not connected contiguously along edge portions and still surround an enclosed space, as recited in claim 20. Even if we interpret “a fabric member” to mean a single piece of fabric or a monolithic member in a single body, claims 8, 15, and 20 recite “an enclosure member.” In claims 15 and 20, the enclosure member has side panels that may be connected along edge portions (claim 15) or may not be (claim 20).

Patent Owner recited “a fabric member” in claim 1 and “an enclosure member” in claims 8, 15, and 20, where the enclosure member includes side panels in claims 15 and 20. However, Patent Owner urged us to interpret “a fabric member” and “an enclosure member” to have the same meaning of “a unitary [enclosure/fabric] element comprising a plurality of side panels.” PO Resp. 13–14. Patent Owner may claim its baby crib with subtle nuances in claim limitations to provide different claim scope. However, for that very reason, we must give meaning to those differences where the claims make clear that those terms are used differently, rather than interchangeably. For example, “a fabric member” does not have side panels. “An enclosure member” does. One is made of fabric. The other is not so claimed.

C. Our Interpretation is Consistent with the Specification

The '957 patent, which reissued as the '919 patent, discloses a baby crib that comprises bed frame structure 1, fabric member 2, and positioning posts 22. Ex. 1003, 2:13–16. The '957 specification discloses that fabric member 2 is formed with four lateral sides when it is mounted on bed frame structure 1. *Id.* at 2:43–45. The '919 specification also discloses that sleeve portions 21 can be formed on fabric member 2 by sewing. *Id.* at 2:31–38. We have some idea of what the four lateral sides look like from the exploded view of Figure 3 of the '957 patent. See Dec. 4.

The term “enclosure member” only appears in the '957 specification in relation to the *prior art* baby crib illustrated in Figures 1 and 2. Ex. 1003, 1:14–17. Prior art enclosure member 9 is mounted on bed frame 8 to define a receiving space for a baby. *Id.* Like fabric member 2 of the invention, enclosure member 9 also includes sleeves, but the sleeves are sleeved onto, i.e., over and around, the four upright tubes 81. *Id.* at 1:20–22, Fig. 1.

Patent Owner amended the '957 specification in reissue to disclose fabric member 2 “extends outward through the slit 112 in each of the upright tubes 11 . . . to form an enclosure member having a plurality of side panels that surround an inner enclosed space 3 for receiving a baby” after it is clamped between upright tubes 11 and posts 22. Ex. 1001, 2:63–3:2.

Although Patent Owner added numeral 3 to Figure 5 to identify the enclosed space, Patent Owner did not identify the side panels with numerals in the specification or the drawings. Nor did Patent Owner identify edges or “edge portions” of the side panels, even though these features were claimed.²

² “The drawing in a nonprovisional application must show every feature of the invention specified in the claims.” 37 C.F.R. § 1.83(a).

Patent Owner has not argued, and we find no evidence in the record, of a lexicographic definition of “fabric member” or “enclosure member” as being a single body or a unitary member. Patent Owner has not argued that the specification disclaims a fabric member or enclosure member including multiple side panels that may or may not be connected along edge portions.

The ’957 specification discloses a preferred embodiment of a baby crib (Ex. 1003, 2:13–16), but the invention is not limited to the embodiment.

While the present invention has been described in connection with what is considered the most practical and preferred embodiment, it is understood that this invention is not limited to the disclosed embodiment but is intended to cover various arrangements included within the spirit and scope of the broadest interpretation so as to encompass all such modifications and equivalent arrangements.

Ex. 1001, 3:47–52.

There is no disclosure in the ’957 specification about the features of fabric member 2. If fabric member 2 is a single piece of fabric, i.e., a single body, it is unclear how fabric member also can include side panels with edge portions connected contiguously (claim 15) or not so connected (claim 20). See PO Resp. 14. An ordinary meaning of “edge” is “the line where an object begins or ends.” See MERRIAM-WEBSTER.COM, <http://www.merriam-webster.com/dictionary/edge> (last viewed Aug. 7, 2016).

If fabric member 2 is formed as a single body (there is no disclosure in the ’957 specification to this effect), fabric member 2 may have included two edges that were sewn together to transform a linear piece of fabric into something that defines a surrounding wall around bed frame structure 1. See Ex. 1003, 2:31–34, Fig. 3. The top and bottom edges of fabric member 2 are parallel to one another and are not contiguous or connected. *Id.* at Fig. 3.

The edges of fabric member 2 form its top and bottom edges when fabric member is mounted to bed frame 1. These edges are parallel to one another as shown in Figure 3. They never touch.

We find no disclosure in the '957 specification (or '919 specification for that matter) of separate side panels that are sewn or otherwise connected to form a unitary fabric member 2 of a unitary enclosure member as Patent Owner contends. PO Resp. 13–14. To the contrary, Figure 5 of the '957 specification shows a continuous piece of fabric 2 that enters upright tube 11 through slit 112, continues around positioning post 22 as sleeve 21, and exits from upright tube 11 through the same slit 112. Ex. 1003. No edges or edge portions are identified on the continuous fabric member 2 in Figure 5. The side panels and edge portions are not identified by numeral in the preferred embodiment illustrated in Figures 3–5 or described in the '957 specification.

Claims 15 and 20 thus recite features—side panels and edge portions—that are not disclosed in the preferred embodiment of the '957 specification. Patent Owner's arguments that “an enclosure member” should be construed as “a unitary enclosure element comprising a plurality of side panels” does not identify these features or aid our interpretation of an enclosure member including side panels with edge portions. *See* Req. 8.

Even if we interpreted “a fabric member” to mean a single piece of fabric or element as Patent Owner and Dissent urge, claims 8, 15, and 20 do not recite “a fabric member.” Instead, they recite “an enclosure member.” Patent Owner recognizes that limitations should not be read into the claims from the specification. *See* Ex. 1032, 10. Claims 8, 15, and 20 do not recite that the enclosure member is formed by mounting a fabric member to a bed frame or any other relationship to a fabric member.

With the addition of “enclosure member” in claims 8, 15, and 20, Patent Owner also added other features that are not recited in claim 1 as part of the claimed “fabric member.” In claims 15 and 20, the enclosure member “include[es] a plurality of side panels.” In claim 15, the “plurality of side panels [is] contiguously connected to one another along edge portions.” In claim 20, the enclosure member includes “a plurality of side panels having edge portions,” but the edge portions are not connected to one another as in claim 15. Instead, claim 20 recites “an attachment structure [is] configured to mount and secure the edge portions of the enclosure member along the support tubes.” The edge portions of the side panels in claim 20 also appear to be on the enclosure member. Similarly, claim 15 recites that positioning posts are provided on the enclosure member “*at locations corresponding to the edge portions of the enclosure member.*” See Dec. 19–20.

Claims 8, 15, and 20 do not recite a fabric member or a unitary fabric. Claim 1 recites “a fabric member” clamped between positioning posts and upright tubes, but the fabric member does not include side panels or edge portions. Because Patent Owner claimed these members differently, we do not read features of “a fabric member” into “an enclosure member.” *Inline Plastics Corp. v. EasyPak, LLC*, 799 F.3d 1364, 1371 (Fed. Cir. 2015).

Because our interpretation of “a fabric member” in claim 1 includes a unitary piece of fabric (Dec. 18) that extends through a single slit in each upright tube, claim 1 encompasses what Patent Owner considers to be the preferred embodiment (PO Resp. 5–6) without any side panels or edges. Thus, there is no requirement or presumption that claims 8, 15, and 20 also must claim that preferred embodiment, particularly where claims 8, 15, and 20 claim the baby crib with different features.

Even if the '957 specification describes a single embodiment, that fact, by itself, does not limit otherwise broad claim language. *Howmedica Osteonics Corp. v. Wright Med. Tech., Inc.*, 540 F.3d 1337, 1345 (Fed. Cir. 2008) (declining to impute a limitation into a disputed claim term absent a clear *requirement* in the specification, even where “every disclosure of [the disputed term] in the specification shows [the alleged limitation]”); *Ventana Med. Sys., Inc. v. Biogenex Labs., Inc.*, 473 F.3d 1173, 1181 (Fed. Cir. 2006) (“the mere fact that the '861 patent discloses [only certain] embodiments . . . does not in and of itself mean that the method claims at issue are limited to the disclosed embodiments”); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc) (“[W]e have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.”); Dec. 22–23.

D. Our Interpretation is Consistent with the Prosecution History

As discussed below, the prosecution history indicates the Examiner and Patent Owner understood “a fabric member” to encompass non-unitary elements and “an enclosure member” to include separate and unconnected side panels. The prosecution history also makes clear that Patent Owner and the Examiner understood the claims to encompass upright tubes with more than one slit and a different side panel or fabric/enclosure member extending through different slits in each upright tube to surround an enclosed space.

1. Inter Partes Reexamination Proceedings

Petitioner asserted six grounds against claims 1–7 of the '957 patent in *inter partes* reexamination. Ex. 1005, 67, 72. The Examiner found that the prior art taught all of the limitations, but the references were combined in a way that omitted the surrounding wall of Oliphant.

In particular, the Examiner found that

Oliphant and Colby (before they are combined as proposed) teach elements which, when taken together, seem to show all of the elements of claim 1 of the '957 patent [and] the Request relies on Oliphant to provide the surrounding wall around the bed frame . . . , but when the fabric member, horizontal bars, and vertical posts of Oliphant are replaced with the fabric member and post/tube assembly of Colby as proposed, the resulting structure no longer defines a “surrounding wall around” the frame structure as recited in claim 1.

Id. at 10. Similar findings were made for other grounds. *Id.* at 16 (Oliphant and Goodman), 21–22 (Oliphant and Gaylord), 25 (Oliphant and Hood), 31–32 (Oliphant and Baslow), 37–38 (Oliphant and Northrup). Thus, the prior art taught the features of claims 1–7 but was not combined properly.

2. Reissue Proceedings

During Reissue, Patent Owner amended the '957 specification to state that fabric member 2 forms an enclosure member having a plurality of side panels that surround an inner enclosed space 3 when fabric member 2 is clamped between each upright tube and a corresponding positioning post 22 and extends through *the slit 112* in each upright tube 11. Ex. 1001, 2:67–3:2. Patent Owner represented that the amendment was fully supported by the original '957 specification and did not add any new matter. Ex. 1004, 55–56, 176–177.

As part of this amendment to the '957 specification, Patent Owner amended claim 8 to delete the requirement that the enclosure member is “formed in a single body.” *Id.* at 178. Patent Owner did not amend claim 15, which still recited “an enclosure member including a plurality of side panels contiguously connected to one another along edge portions.” *Id.*

Patent Owner amended claim 20 to delete the requirement that the enclosure member included a plurality of side panels “connected one another along edge portions.” *Id.* at 179. As amended, claim 20 recited an enclosure member that “include[ed] a plurality of side panels having edge portions.” *Id.* The side panel edge portions were no longer claimed to be connected.

The reissue prosecution history indicates that the Examiner interpreted “a fabric member” in original claim 1 of the ’957 patent to read on separate side panels 56, 66 of Gibbs. Ex. 1004, 441. The Examiner found that Gibbs discloses a fabric enclosure member mounted on a bed frame to define a surrounding wall around the bed frame structure. *Id.* The separate side panels 56, 66 of Gibbs corresponded to the claimed fabric member. *See id.*

Reissue claim 20 recited “an enclosure member including a plurality of side panels connected one another along joining edge portions.” *Id.* at 512. The Examiner found that Gibbs anticipates claim 20 by disclosing an enclosure member including a plurality of side panels (seat members 56, 66) connected to one another as shown in Figures 3–5 along their joining edge portions (enlarged end portions 84, 86, 88, 90 of each seat member 56, 66) and attachment structure/positioning posts (rods 100, 102, 104, 106) that are mounted on the fabric member and inserted into receiving holes in upright tubes in Figure 5. *Id.* at 441. The Examiner treated separate seat members 56, 66 of Gibbs’ two seat chair as forming an enclosure member with plural side panels connected along joining edge portions, as in reissue claim 20.

The Examiner did not view the separate seat members 56, 66 of Gibbs as disclosing “an enclosure member *formed in a single body* and defining a plurality of side panels joined one another,” as recited in reissue claim 8. *Id.* at 441, 511 (emphasis added). Nor did the Examiner treat the separate seat

members 56, 66 of Gibbs as disclosing “an enclosure member including a plurality of side panels *contiguously connected* one another along joining edge portions,” as recited in new reissue claim 15. *Id.* at 441, 512 (emphasis added). Instead, the Examiner determined it would have been obvious to form seat members 56, 66 as a single body with side panels contiguously connected along joining edge portions as in claims 8 and 15. *Id.* at 443.

In response, Patent Owner argued that Gibbs discloses a seat member with horizontal seat portion 56a, 66a and vertical backrest portion 56b, 66b and the “teachings of *Gibbs* clearly fail to meet the claimed fabric member that surrounds the bed frame structure and defines an enclosed space adapted to receive the placement of a baby, as claim 1 requires.” *Id.* at 432.

For claim 20, Patent Owner argued that Gibbs does not “disclose a baby crib with an enclosed space, and neither teach or suggest support tubes that are exposed outward the enclosed space, as claim 20 requires.” *Id.*

Patent Owner did not argue that “a fabric member” in reissue claim 1 must be a single body or a unitary member as Patent Owner now asserts. *Id.* Instead, Patent Owner amended claim 1 to add the limitation “wherein the fabric member defines an enclosed space adapted for receiving a baby therein.” *Id.* at 426. Patent Owner argued that this new limitation defined over Gibbs, rather than a fabric member being a unitary element. *Id.* at 432.

Nor did Patent Owner argue that “an enclosure member” in claim 20 is a single, unitary member. *Id.* Instead, Patent Owner argued that Gibbs does not teach a baby crib with an enclosed space, an implicit reference to “an enclosure member” forming an enclosed space. Patent Owner chose to rely on the enclosing nature of “an enclosure member” rather than on some undisclosed and unclaimed unitary or monolithic feature now asserted.

Patent Owner's decision to emphasize claim features other than the alleged unitary nature of the fabric or enclosure member is consistent with reissue claim 8, which recited "an enclosure member formed in a single body." *Id.* at 511. This recital in claim 8 indicates that Patent Owner did not consider "an enclosure member" to be formed in a single body in all cases.

Similarly, reissue claim 15 recited an enclosure member including a plurality of side panels contiguously connected along joining edge portions. Reissue claim 20 recited an enclosure member including "a plurality of side panels connected one another along joining edge portions."

Claims 8, 15, and 20 indicate that Patent Owner viewed an enclosure member as a non-unitary element that was not necessarily formed in a single body unless so claimed but could include side panels that may be connected.

The Examiner objected to reissue claims 8–27 because they did not recite a single slit extending along the length of each upright tube wall in spatial communication with a receiving hole in each upright tube and a fabric member that extends outward through the slit in each upright tubes as recited in claims 1–7 of the '957 patent. *See* Ex. 1004, 440.

In response, Patent Owner represented:

Because the present reissue application was filed within two years after issuance of the '957 patent, and because no rejections were made to any of the pending claims presented in the original application no. 10/829,027 from which the '957 patent was granted, Applicant is entitled to pursue broadened claims in the current reissue application in compliance with the provisions of 35 U.S.C. 251. Therefore, Applicant respectfully submits that this rejection is improper, and kindly request its withdrawal.

Id. at 431.

Patent Owner thus represented that the reissue broadened claims 1–7 of the '957 patent. Reissue Claims 8, 15, and 20 did not recite that each upright tube includes a single slit along its length and the fabric member extends through the slit in each tube. *Id.* at 511–513; Ex. 1003, 4:1–40.

The Examiner understood that reissue claims 8–27 covered upright tubes with more than one slit through which a fabric member or side panel extends. This understanding is evident from the Examiner's finding that Gibbs anticipated claims 1 and 20. Claim 1 still recited a slit along each upright tube and the fabric member extending through the slit in each of the upright tubes. New reissue claim 20 did not recite any slit whatsoever.

Figure 5 of Gibbs is reproduced below to illustrate these features.

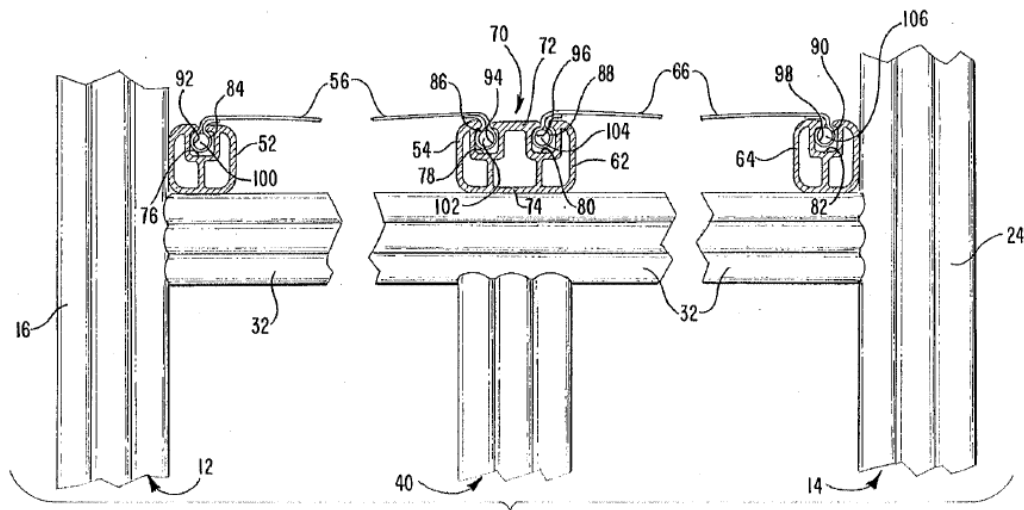


Figure 5 is a front elevation view of a two seat chair of Gibbs. As illustrated above in Figure 5 of Gibbs upon which the Examiner relied for an anticipation rejection, Gibbs discloses tubes with a single slit leading to a T-shaped slot 76, 82 in rail 84, 90 on either side of each seat portion as the Examiner found. Ex. 1004, 441; Ex. 1049, 3:63–66. *The separate seat panels 56, 66 formed the enclosure member, as discussed above.*

Gibbs also discloses a center rail 70 that includes two slits leading to respective T-shaped slots 78, 80 in Figure 5. Ex. 1049, 3:60–68.

Patent Owner did not traverse this rejection by arguing that a single slit in each upright tube is a requirement of the invention. Rather, and in line with Patent Owner’s traversal of the broadening reissue rejection under 35 U.S.C. § 251, Patent Owner allowed the Examiner to treat the invention as including more than one slit per frame tube and as more than one side panel extending from an upright tube as disclosed in Gibbs above. Instead, Patent Owner argued that Gibbs does not disclose a fabric member that surrounds a bed frame structure and defines an enclosed space. Ex. 1004, 432, 321–322.

Patent Owner also amended claims 1, 8, 15, and 20 to recite that the fabric member and the side panels of the enclosure member extend between upright tubes “out of contact with outside surfaces of the outer tube wall of each of the upright tubes.” Ex. 1004, 271, 273, 274, 275. Patent Owner argued that Figure 5 of the ’957 patent showed a fabric/enclosure member as being out of contact with the outwardly facing surface of the upright tube and both Gibbs and Colby rely on contact of the fabric enclosure member with the outwardly facing surface of the tubes for support. *Id.* at 281–282.

Patent Owner gave no indication that the plural, separate side panels of Gibbs did not form a fabric or enclosure member. Rather, Patent Owner chose to distinguish the claims over Gibbs by reciting that the separate side panels of the fabric or enclosure member of Gibbs contacted the outer surface of the upright tubes and did not enclose anything. *Id.*, *see id.* at 243.

Nor is there any indication in the prosecution history that a fabric member or an enclosure member forms a surrounding wall, encloses a space, or extends out of contact with upright tubes simply because they are unitary.

In that regard, the Examiner rejected independent claims 1, 8, 15, and 20 during reissue based on Moltane and Gibbs and relied on Moltane for the features of the fabric member and enclosure member as follows.

Moltane shows the claimed limitations of a baby crib (10) comprising a fabric enclosure member (14) formed in a single body including a plurality of side panels (16) contiguously connected to one another along edge portions (as shown in Figures 1 & 2); a plurality of positioning posts (40) mounted on the edge portions of fabric enclosure member; wherein the fabric member surrounds an enclosed space adapted for receiving a baby therein

Ex. 1004 (Final Action, mailed Dec. 28, 2010), 254. The Examiner retained that rejection in the following office action. *Id.* (Office Action, mailed July 12, 2011) at 225; *see id.* at 300–301 (Moltane discloses “a fabric enclosure member (14) formed in an single body including a plurality of side panels (16) contiguously connected to one another along edge portions”). Patent Owner did not dispute that Moltane discloses a fabric member forming an enclosure, as claimed. *Id.* at 242.

Whereas the Examiner previously relied on a double seat of Gibbs to anticipate the fabric member and enclosure member of claims 1 and 20 and to render obvious the enclosure member of claims 8 and 15 (*id.* at 394, 396), the Examiner changed the rejection and relied on Moltane to teach “a fabric enclosure member (14) formed in a single body including a plurality of side panels (16) contiguously connected to one another along edge portions.” *Id.* at 300–301, 254, 225.

At this point in reissue, claim 8 recited “an enclosure member *formed in a single body.*” *Id.* at 273 (emphasis added). Claims 15 and 20 recited side panels that were connected along edge portions. *Id.* at 274–275.

At this point in the reissue prosecution history, claim 1 recited “a fabric member mounted on said bed frame structure to define a surrounding wall around said bed frame structure.” *Id.* at 271, 313.

Claim 8 recited “an enclosure member formed in a single body.” *Id.* at 273, 314, 427. In fact, Patent Owner treated this limitation as equivalent to “defining a plurality of side panels joined one another” because Patent Owner removed the latter limitation from claim 8 as follows. *Id.* at 427.

an enclosure member formed in a single body;

Id. at 427. This amendment indicates that “formed in a single body” does not have the same meaning as a plurality of side panels joined one another. An enclosure member can be formed in a single body without having to join side panels to one another.

Claim 15 recited “an enclosure member including a plurality of side panels contiguously connected to one another along edge portions.” *Id.* at 274, 315, 428.

Claim 20 recited “an enclosure member including a plurality of side panels connected one another along edge portions.” *Id.* at 275, 316, 429. In one amendment, Patent Owner deleted language that the edge portions of the side panels that were connected to one another were joining edge portions as indicated below.

an enclosure member including a plurality of side panels
connected one another along edge portions;

Id. at 429. Thus, merely reciting that edge portions of side panels are connected to one another, does not mean that the side panels join one another in some fashion.

The prosecution history makes clear that the Examiner interpreted the claims to cover a unitary fabric or unitary enclosure member because Patent Owner claimed “an enclosure member” “*formed in a single body* (claim 8), “including a plurality *side panels connected contiguously to one another along edge portions*” (claim 15), and “including a plurality of *side panels connected to one another along edge portions*” (claim 20). The reissue prosecution history does not support Patent Owner’s argument that “an enclosure member” inherently means a single piece of fabric. Req. 12.

After the Examiner allowed these claims (Ex. 1004, 148), Patent Owner removed the requirements that the enclosure member is formed in a single body in claim 8 and that the side panels of the enclosure member of claim 20 are “connected one another along edge portions” (*id.* at 178–179).

Regarding claim 8, Patent Owner removed the requirement that the enclosure member is “formed in a single body.” *Id.* at 178. Regarding claim 20, Patent Owner removed the requirement that the plurality of side panels of the enclosure member are “connected one another along edge portions” to instead recite merely that the side panels have edge portions. *Id.* at 179.

As amended, claim 8 recited “an enclosure member surrounding an enclosed space adapted for receiving a baby therein.” *Id.* at 178. Whereas formerly the enclosure member extended “*out of contact* with the outside surfaces of outer walls of the upright tubes,” now claim 8 merely required that the side panels extend “*substantially out of contact* with the outside surfaces of outer walls of the upright tubes.” *Id.* Claim 8 was broadened.

Patent Owner thus also broadened the scope of claim 8 regarding the out of contact limitation. The side panels did not have to be *completely* out of contact. They only had to be *substantially* out of contact.

Therefore, we are not persuaded by the Dissent's argument that the "substantially out of contact" serves a similar purpose as the single "slit" limitation that Patent Owner omitted from the claims. Dissent, 9. To the contrary, Patent Owner removed the single slit feature of the invention *and* also broadened the scope of the "out of contact" limitation that already was recited in claims 1, 8, 15, and 20. *See* Ex. 1004, 177, 178, 179.

Patent Owner also broadened claim 20 by removing the requirement that the edge portions of the side panels were connected one another. Now, claim 20 recited only "an enclosure member including a plurality of side panels having edge portions." *Id.* at 174. In contrast to claim 20, claim 15 still recited "an enclosure member including a plurality of side panels contiguously connected to one another along edge portions." *Id.* at 173.

Even when claims 8, 15, and 20 recited an enclosure member formed in a single body or including a plurality of side panels with edge portions connected to one another, claims 8, 15, and 20 also recited "the enclosure member surrounds an enclosed space." *Id.* at 314–316. Thus, the alleged unitary nature of the fabric/enclosure member was not necessary for these members to surround an enclosed space or a surrounding wall.

Similarly, even though claim 1 recited "a fabric member mounted on said bed frame structure to define a surrounding wall around said bed frame structure," Patent Owner also recited "wherein the fabric member defines [surrounds] an enclosed space adapted for receiving a baby therein." *Id.* at 313, 426.

For all these reasons, we do not view "an enclosure member" to mean a single body of fabric or a unitary member, or to have side panels connected contiguously, except in claim 15 where it is recited expressly.

E. 35 U.S.C. § 251 is not a Rule of Claim Construction

The original patent requirement of 35 U.S.C. § 251(a) is not a rule of claim construction. We interpret the claims under the broadest reasonable interpretation standard. Dec. 8. Then, we determine the patentability of those claims under 35 U.S.C. § 102 or § 103. 35 U.S.C. § 311. We do not consider the original patent requirement in our claim construction. Neither Patent Owner nor the Dissent cites any authority for the proposition that our claim construction must consider the original patent requirement in this proceeding. Req. 4–5; Dissent 2–4. Neither party raised this issue in their briefs. Our claim interpretation is consistent with the '957 specification, as discussed above. Patent Owner sought and obtained broader claim scope than the preferred embodiment. Dec. 16–24. If that claim scope violates the original patent requirement, that issue must be resolved in another forum.

F. Reissue Proceedings are not Before us for Review

A claim submitted in reissue may be rejected under the original patent clause of § 251 if the specification of the original patent before reissue lacked a disclosure sufficient to indicate that a patentee could have claimed the subject matter recited in the reissue patent. *In re Amos*, 953 F.2d 613, 618 (Fed. Cir. 1991). That issue is not before us, however. Dissent 3–4.

During reissue, the Examiner rejected new reissue claims 8–27 under § 251 as improperly broadening the scope of claims 1–7 of the '957 patent. Ex. 1004, 440. The Examiner found that reissue claims 8–27 were broader because they did not claim a “slit that extends along the length of the tube wall and that is in spatial communication with said receiving hole.” *Id.* The claims also eliminated the limitation that “said fabric member . . . extending outward through said slit in each of said upright tubes.” *Id.*

The Examiner withdrew this rejection in response to Patent Owner's arguments that the reissue was a broadening reissue, and Patent Owner was entitled to pursue the broader claims under § 251. *Id.* at 397, 431. The Examiner did not reject the amendments to the claims or '957 specification under the original patent requirement during reissue proceedings.

Patent Owner represented that new reissue claims 8–27 did not add new matter and were supported by the disclosure of the '957 patent. *Id.* at 514. Each time that Patent Owner amended the claims in reissue, including original claim 1, Patent Owner represented that the amendments did not add new matter. *Id.* at 56, 179–180, 280, 319–320.

Patent Owner also amended the drawings and the specification of the '957 patent during reissue. The amendment to the specification added that the fabric member 2 “*form[s] an enclosure member having a plurality of side panels that surround an inner enclosed space 3 for receiving a baby.*” *Id.* at 169; *see* Ex. 1001, 2:67–3:2 (the new language appears in italics).

Patent Owner's remarks accompanying this amendment referenced a telephone interview in which the Examiner indicated that the amendment to the drawings and specification would not result in a new matter rejection. Ex. 1004, 169. The Examiner objected to amendments to the drawing and the specification because new Figure 5 did not include the term “Amended” and matter omitted from the specification by reissue was not enclosed in brackets. *Id.* at 147. The Examiner did not reject the amendments to the drawing or specification for new matter. *Id.* Once Patent Owner corrected these drawing and specification formalities (*id.* at 54–55), the Examiner issued a Notice of Allowability for reissue claims 1–29 (*id.* at 21–23).

The '957 patent discloses a baby crib with (1) a plurality of upright tubes 11, each of which included a single slit 112 along the length of its outer wall (Ex. 1003, 2:23–28, 4:3–6, Fig. 5), (2) a fabric member 2 that is clamped between each upright tube 11 and a corresponding positioning post 22, and (3) fabric member 2 extends outwardly through the single slit 112 in each of the upright tubes 11 (*id.* at 2:43–64, 4:11–17, Figs. 3–5).

In the Notice of Allowability for the '957 patent, the Examiner set forth Reasons for Allowance to identify the novel and non-obvious features of the invention. Ex. 2002, 6. The Examiner determined that the prior art singly or in combination did not teach or suggest (1) “the particular structure of a fabric member *being clamped between* a plurality of positioning posts mounted thereon and a plurality of upright posts,” (2) “each of the upright tubes having a tube wall defining a receiving hole into which a corresponding positioning post is inserted,” (3) each of the upright tubes “defining a slit that extends along the length of the tube wall, wherein the slit also communicates spatially with the receiving hole,” (4) the fabric member extends outward through the slit in each of the upright tubes, as explicitly recited in Applicant’s sole independent claim 1.” *Id.*

The Dissent asserts that the invention disclosed in the original '957 specification is “a unitary enclosure member with corner connection pieces, whereby two ends of (connected) fabric emerge from each corner through a single slit in the corner piece.” Dissent, 4. As discussed above, reissue claims 8–27 are broader than this original disclosure. Claim 1 is as well if “a slit” means more than one slit. Patent Owner has asserted claim 8 against a play yard with multiple side panels and two slits per upright tube with the edges of the panels placed separately in each slit. See Ex. 1032, 5, 7, 8.

G. Bidwell Discloses an Upright Tube

We interpreted “a plurality of upright tubes defining corners of the baby crib, wherein each of the upright tubes has an outer wall that defines an outer contour shape of the upright tube” in claim 15 consistent with the plain language of the claims in light of the ’919 Specification. Claim 15 recites “upright tubes defining corners of the baby crib, wherein each of the upright tubes has an outer wall that defines an outer contour shape of the upright tube.” Ex. 1001, 5:7–9. We found that Bidwell discloses retaining members 22 that satisfy these claimed features. Dec. 42.

Unlike the upright tubes recited in claims 1 and 8, the upright tubes of claim 15 are not claimed to be part of a bed frame. Even if we considered the other features recited for the upright tubes in claims 1 and 8 – an inner tube wall, an outer tube wall defining an outer contour shape, a receiving hole, and a slit extending the length of the outer tube wall – Bidwell teaches retainer 22 as including all of these claimed features of tube wall 24, hollow interior 26, slot 28. Ex. 1016, 3:8–15, Fig. 1.

As with the other disputed claim limitations, Patent Owner wants us to read selected features from the ’919 Specification into “upright tubes.” Req. 13–14. Patent Owner wants us to interpret “upright tube” to mean “a rigid component of the bed frame.” *Id.* Patent Owner did not assert this claim interpretation in the Response. See Paper 26, 9–20, 25–27. Thus, we did not misapprehend or misunderstand an argument that was not made.

Even so, Bidwell’s retainer 22 clamps a fabric sleeve 14 between its inner wall and corner post 20, which Petitioner asserted was comparable to the claimed positioning post. See Ex. 1016, Fig. 2; Ex. 1001, Fig. 5. Two side panels extend from a single slot 28 of retainer 22. Ex. 1016, Figs. 1, 2.

IV. CONCLUSION

We have reviewed and considered Patent Owner's arguments in the request for rehearing and determine that Patent Owner has not carried its burden of demonstrating that the Board misapprehended or overlooked any matters in rendering the Final Written Decision. We decline to modify the Final Written Decision.³

V. ORDER

Accordingly, it is

ORDERED that the Request for Rehearing is *denied*.

³ The Chief Judge was informed of Patent Owner's request to expand the panel (*see* Req. 1) and declined to do so.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BABY TREND, INC., DENNY TSAI, and BETTY TSAI,
Petitioner,

v.

WONDERLAND NURSERYGOODS CO., LTD.,
Patent Owner.

Case IPR2015-00841
Patent RE43,919

Before JAMES P. CALVE, JEREMY M. PLENZLER, and
JAMES A. WORTH, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* CALVE.

Opinion Dissenting filed by *Administrative Patent Judge* WORTH.

DECISION
Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

JAMES A. WORTH, *Administrative Patent Judge, Dissenting*.

I dissent for the reasons set forth in my previous dissent.

IPR2015-00841
Patent RE43,919

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