

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KARTRI SALES COMPANY, INC.
MARQUIS MILLS, INTERNATIONAL, INC.,
Petitioner,

v.

ZAHNER DESIGN GROUP, LTD.,
Patent Owner.

Case IPR2016-01327
Patent 8,235,088 B2

Before WILLIAM V. SAINDON, HYUN J. JUNG, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Kartri Sales Company, Inc. and Marquis Mills, International, Inc. (collectively, “Petitioner”) filed a Petition for *inter partes* review of claims 1–14 (all claims) of U.S. Patent No. 8,235,088 B2 (Ex. 1001, “the ’088 patent”). Paper 1 (“Pet.”). Zahner Design Group, Ltd. (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute only when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); see 37 C.F.R. § 42.108. Upon consideration of the Petition and Preliminary Response, we conclude the information presented does not show a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any of claims 1–14 of the ’088 patent.

A. Related Matters

Petitioner and Patent Owner identify the following pending judicial matters as relating to the ’088 patent: *Focus Products Group International LLC, Zahner Design Group, Ltd. v. Kartri Sales Co.*, No. 1:15 CV-05108 (S.D.N.Y.) and *Focus Products Group International LLC, Zahner Design Group, Ltd. v. Kartri Sales Co.*, No. 1:15 CV-10154 (S.D.N.Y.). Pet. 1; Paper 8, 2. Patent Owner also identifies an *Ex Parte* Reexamination Request filed by Kartri Sales Company, Inc. on July 14, 2016 against U.S. Patent No. 6,494,248 as an administrative proceeding that could affect, or be affected by, a decision in this proceeding. Paper 8, 2.

B. The '088 Patent

The '088 patent relates to a shower curtain having rings that reinforce openings in the shower curtain, and a slit in the ring that allows removal of the shower curtain from the rod without removing the rod from its supports. Ex. 1001, 3:46–60. The slit extends through the ring and the curtain material to the exterior of the curtain. *Id.* at 4:2–6. The slit, combined with the flexible material forming the ring, allows the ring to flex open and allow the rod to pass through the slit. *Id.* at 3:51–65. Figure 31B of the '088 patent is reproduced below:

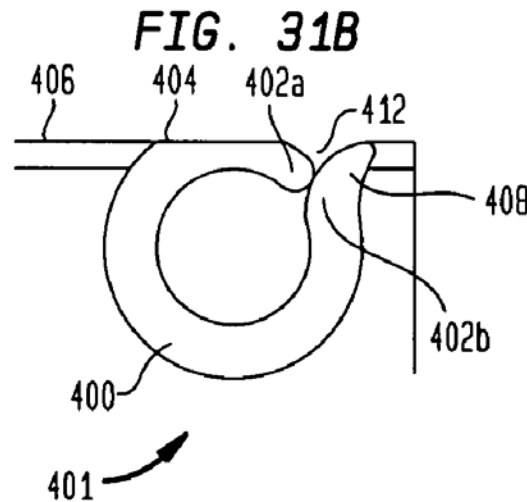


Figure 31B illustrates ring 400 including slit 412 and flat upper edge 404. *Id.* at 10:55–62. The flat upper edge provides support for the hem of the curtain's fabric. *See id.* at 9:11–17. Ring 400 includes “extension 408,” which may also be referred to as a “projecting edge,” that “serves to ease the opening of the ring and its attachment onto a rod, and also serves to support the hem 406.” *Id.* at 10:62–65, 7:56–59.

C. Illustrative Claim

Petitioner challenges claims 1–14 of the '088 patent. Claim 1 is independent and illustrative of the claimed subject matter:

1. A product, said product comprising:
 - a shower curtain, said shower curtain comprising an outer edge and an opening such that said product is suitable for suspension from a rod, said shower curtain further comprising a ring, wherein said ring reinforces said opening;
 - said ring comprising a flat upper edge, an inner circumference, and an outer circumference;
 - said ring further comprising a slit extending from said inner circumference through said ring and through said outer edge of said shower curtain;
 - said ring further comprising a projecting edge, said projecting edge being an edge which projects from said outer circumference of said ring; and,
 - wherein said slit exits said inner circumference at a location which is offset from the 12 o'clock position on said inner circumference.

Id. at 11:10–26. Claims 2–7 depend from claim 1. Claim 8 is independent and, similar to claim 1, requires a “projecting edge . . . being an edge which projects from said outer circumference.” *Id.* at 12:10–16. Claims 9–14 depend from claim 8.

D. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–14 are unpatentable based on the following grounds (Pet. 5):

Grounds	Reference(s)	Basis	Challenged Claims
1	U.S. Patent No. 6,494,248 B1 (“the ’248 patent”) ¹	§ 102(b)	1–14
2	Lishman ² and Sawaya ³	§ 103(a)	1–14
3	Lishman and Kaldenbaugh ⁴	§ 103(a)	1–14
4	Winkel ⁵ and Lishman	§ 103(a)	1–14
5	Winkel, Lishman, and Bussell ⁶	§ 103(a)	1–14

II. DISCUSSION

A. Claim Construction

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard). Consistent with the broadest reasonable construction, claim terms are presumed to have their ordinary and customary meaning as understood by a person of ordinary skill in the art in the context of the entire patent

¹ Ex. 1003.

² U.S. Patent No. 2,831,538 (“Lishman”) (Ex. 1004).

³ U.S. Patent No. 5,111,868 (“Sawaya”) (Ex. 1005).

⁴ U.S. Patent No. 4,948,267 (“Kaldenbaugh”) (Ex. 1006).

⁵ DE 7834247 (“Winkel”) (Ex. 1007; machine translation at Ex. 1008).

⁶ U.S. Patent No. D299,313 (“Bussell”) (Ex. 1017).

disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner proposes constructions for “shower curtain,” “ring,” “outer circumference,” “inner circumference,” “flat upper edge,” and “slit.” Pet. 18–19. We need not construe those terms in order to resolve the issues raised by Petitioner’s contentions below. Petitioner also proposes a construction for “projecting edge” that will be discussed below.

B. Ground 1: Asserted Anticipation by the ’248 Patent

The ’088 patent claims priority to the ’248 patent through a series of three continuation applications. See Ex. 1001, (60). Petitioner asserts that the ’248 patent is prior art to the ’088 patent due to a “defective” priority claim. Pet. 11–12. More specifically, Petitioner contends that the application that matured into the ’088 patent—Application No. 11/978,532 (“the ’532 Application”)—is a divisional of the application that preceded the ’532 Application, Application No. 11/209,334. *Id.* at 12. Petitioner bases this assertion on an “apparent intent” by Patent Owner and the Patent Office to treat the ’532 Application as a divisional. *Id.* Petitioner reasons that the Examiner’s withdrawal of a double patenting rejection during prosecution can “only be explained” by concluding that the ’532 Application received the benefit of a “safe harbor” provision limited to divisional applications. *Id.* at 14–15. Petitioner contends that the “misidentification of the relationship to the parent application (as a continuation and not as a divisional) renders the entire priority claim defective and therefore inapplicable.” *Id.* at 12 (citing *Encyclopaedia Britannica, Inc. v. Alpine Elec. of Am., Inc.*, 609 F.3d 1345, 1350–51 (Fed. Cir. 2010); *Medtronic*

CoreValve, LLC v. Edwards Lifesciences Corp., 741 F.3d 1359, 1363 (Fed. Cir. 2014)).

Patent Owner argues that Petitioner’s priority attack contains several fatal flaws. First, Patent Owner argues that the ’532 Application falls within the MPEP’s definition of a continuation application, and because Petitioner does not establish that the ’532 Application fails to meet that definition, the application could not be improperly identified as a continuation. Prelim. Resp. 3–4. Second, even if Petitioner correctly asserts that the ’532 Application must be a divisional application, that does not mean that there was any “misidentification” of the application because all divisionals are also continuation applications—i.e., divisionals are a subset of continuation application. *Id.* at 4. Third, Patent Owner argues that the ’532 Application does not meet the definition of a divisional application because its claimed inventions are not “independent and distinct” from the claims of the parent patent. *Id.* at 5–6. Fourth, Patent Owner argues that it and the Patent Office treated the ’532 Application as a continuation application, not a divisional. Fifth, Patent Owner argues that Petitioner’s cited case law does not support Petitioner’s position. *Id.* at 10–12. Sixth, Patent Owner alleges that once it designated the ’532 Application as a continuation, it was bound by that designation and neither it nor Petitioner can “look back now and redesignate” the ’532 Application as a divisional. *Id.* at 12–13. Finally, Patent Owner asserts that adopting Petitioner’s position would be unprecedented and bad policy. *Id.* at 13–16.

Petitioner has not established that the ’088 patent includes a defective priority claim. As an initial matter, Petitioner never addresses the definition of a continuation application, using the MPEP definition or a definition from

any other sources, or alleges that the '532 Application does not meet any such definition. See MPEP § 201.07. In addition, as Patent Owner points out, there may be overlap in the definitions of continuation and divisional applications. Prelim. Resp. 3–4. In that case, even if the '532 Application qualifies as a divisional that does not mean that it was “misidentified” as a continuation. Petitioner did not address any of these issues in the Petition. Further, we are reluctant to find that the '532 Application *must* fall within the definition of a divisional application merely because the Examiner withdrew a double patenting rejection, without any mention of the continuation/divisional issue in the prosecution history. We do not find, as Petitioner urges, that the Examiner made an implicit determination that the application was a divisional (despite Patent Owner’s designation as a continuation application), afforded Patent Owner the safe harbor of § 121, and withdrew the double patenting rejection based on this unstated rationale, all while keeping these important facts off of the public record. Such an interpretation of the prosecution history strains credulity. Petitioner has not pointed to any authority that has interpreted a prosecution history in a related manner, and we decline to do so here.

Further, Petitioner fails to cite any case law or policy that supports its approach. As Patent Owner points out, the Federal Circuit cases relied on by Petitioner do not support its position, as the priority defects in those cases involved complete failures to cite a priority application, leading to a clear break in the priority chain. *Encyclopaedia Britannica*, 609 F.3d at 1350–51; *Medtronic CoreValve*, 741 F.3d at 1363–64. Petitioner does not allege that Patent Owner failed to cite a priority application in the priority chain. Petitioner also relies on *Apple Inc. v. E-Watch, Inc.*, Case IPR2015-00414

(PTAB July 1, 2015) (Paper 13). That non-precedential case does not bind us here, and includes distinguishable facts. *Apple* involved an inaccurate designation of a continuation application as a divisional (the converse of the situation here) based on an improper cut-and-paste of a priority claim from an ancestor application. *Id.* at 11. Petitioner does not cite any case where a tribunal combed through the prosecution record, inferred an unstated intent to treat an application as a divisional based on the withdrawal of a rejection, then used that unstated intent to break a chain in priority and lead to the invalidity or unpatentability of a claim. Moreover, Patent Owner advances several policy reasons against such an approach. Prelim. Resp. 13–16. As Patent Owner points out, designating an application as a divisional rather than a continuation because it claims “independent and distinct” subject matter may not always be clear. *Id.* at 14. Petitioner’s approach would allow accused infringers to attack any designation in a priority claim as improper after the fact. *Id.*

Based on the foregoing, we conclude that Petitioner has not established that the designation of the ’532 Application as a continuation led to a break in the priority chain. Without a break in the priority chain, the ’248 patent is not prior art to the ’088 patent and cannot anticipate the ’088 patent. Accordingly, we determine the information presented does not show a reasonable likelihood that Petitioner would prevail in establishing that any of claims 1–14 are anticipated by the ’248 patent.

C. Ground 2: Asserted Obviousness over Lishman and Sawaya

Petitioner contends claims 1–14 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Lishman and Sawaya. Pet. 27–39. Relying on the testimony of Paul Hatch, Petitioner explains how the

references allegedly teach or suggest all of the claim limitations and contends that a person having ordinary skill in the art would have been motivated to combine the references. *Id.* (citing Ex. 1009, “Hatch Decl.”). Patent Owner counters that the asserted combination fails to disclose certain limitations of independent claims 1 and 8 and that the Petition fails to provide adequate motivation for combining the references. Prelim. Resp. 16–21.

1. Summary of Lishman

Lishman, titled “Drapery Support,” discloses an invention related to draperies such as shower curtains. Lishman, 1:6–16. Figure 1 of Lishman is reproduced below:

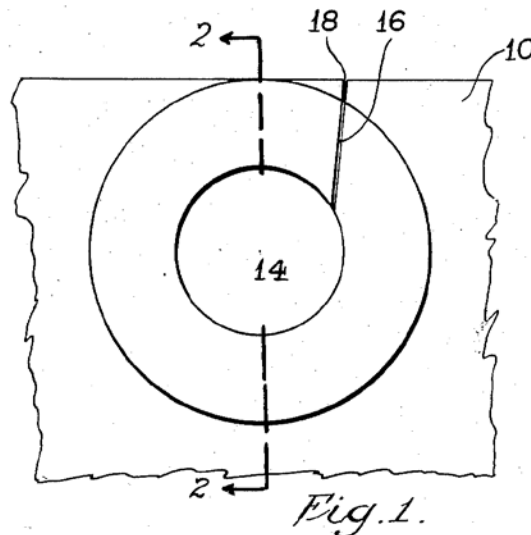


Figure 1 illustrates a ring in drapery fabric 10. *Id.* at 1:35–37. The ring includes open center 14 and slit 16. *Id.* at 1:44–46. Slit 18 in fabric 10 combines with slit 16 to create a single, openable slit to allow mounting of a curtain on a rod. *Id.* at 45–48, 53–55.

2. Summary of Sawaya

Sawaya discloses an apparatus for reinforcing holes in a curtain, including shower curtains. Sawaya, 1:6–13. Figure 2 of Sawaya is reproduced below:

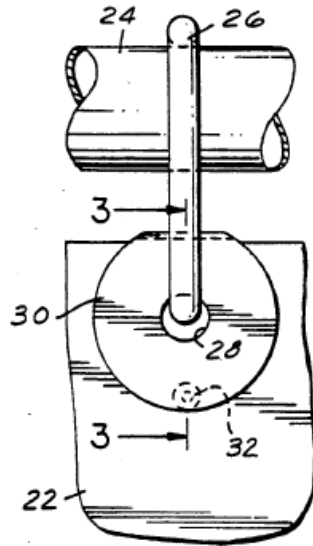


FIG. 2

Figure 2 illustrates reinforcement member 30 surrounding hole 28. *Id.* at 2:23–24. In Sawaya, ring 26, separate from reinforcement member 30, connects curtain 22 to rod 24. *Id.* at 2:12–15.

Further details of reinforcement member 30 are depicted in Figure 4 of Sawaya, reproduced below:

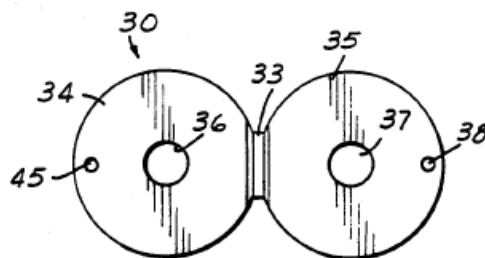


FIG. 4

Figure 4 depicts flexible hinge 33 connecting two sides 34, 35 of reinforcement member 30. *Id.* at 2:27–29. Apertures 36 and 37 of the sides are preferably aligned with hole 28 in the curtain when reinforcement member 30 is attached to the curtain. *Id.* at 2:28–32.

3. Analysis

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in the record, objective evidence of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Petitioner alleges that Lishman discloses “a majority of the structure” of claims 1–14, including the claimed slit, and that a “simple combination of Lishman with a particular teaching of Sawaya results in a modified device that includes all of the claimed features.” Pet. 28. Petitioner relies only on Sawaya for the claimed “flat upper edge” and “projecting edge.” *Id.* at 29–31. In its claim construction argument, Petitioner contends that “projecting edge” is “defined as” a projection “off of the ring (preferably off of the ring’s outer circumference), which extend[s] beyond the ring away from the hanging product (e.g. toward the ceiling).” *Id.* 20 (quoting Ex. 1001, 7:59–62). Petitioner concludes that “projecting edge” should be construed “to be

an edge that projects from the perimeter of the ring as indeed, the claims define a projecting edge to be ‘an edge which projects from said outer circumference of said ring.’” *Id.* Petitioner points to “the edge of flexible hinge 33 which is perpendicular to the flat upper edge” of Sawaya as disclosing this limitation. *Id.* at 31. Petitioner’s annotated version of Sawaya’s Figure 4 appears below.

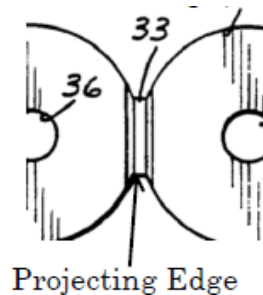


Figure 4 illustrates the horizontal line that Petitioner identifies as the claimed “projecting edge.” *Id.*

Patent Owner argues Petitioner fails to show that Sawaya discloses a projecting edge from the outer circumference as required by claims 1 and 8. Prelim. Resp. 17. According to Patent Owner, the “projecting edge” relied on by Petitioner projects from flat upper edge rather than the outer circumference of the ring. *Id.* at 17–18. Patent Owner also alleges that Petitioner fails to show that Sawaya discloses an aligned front and back edge as required by independent claim 8. Prelim. Resp. 18–19. Patent Owner also raises various arguments against the combination of Lishman and Sawaya. *Id.* at 19–21.

We agree with Patent Owner that Petitioner has not met its burden to show that Sawaya discloses the “projecting edge” limitation of claims 1 and 8, although for reasons different from those advanced by Patent Owner. Claims 1 and 8 are both directed to an assembled “product” that includes a

“shower curtain,” a “ring” that reinforces an opening in the curtain, and a “slit” extending from the inner circumference of the ring through the ring and through the outer edge of the curtain. Ex. 1001, 11:11–26, 11:41–12:30. These and other limitations make clear that the claims require the assembled curtain and ring, and do not cover the curtain and ring separately. Petitioner relies only on Figure 4 of Sawaya, which shows reinforcement member 30 in an open configuration different from its configuration when assembled on the curtain as shown in Figures 2 and 3. Sawaya, Figs. 2–4. As a result, Petitioner fails to show how the portion of the flexible hinge it relies upon satisfies the “projecting edge” requirement of claims 1 and 8 when assembled on the curtain.

Moreover, when viewing Figures 2 and 3 with the reinforcement member assembled on the curtain as in the claims, Petitioner’s allegation that the flexible hinge 33 “projects from said outer circumference of said ring” lacks support. In those figures, the hinge 33 extends away from and generally perpendicular to the plane defining the ring and its outer circumference. See Sawaya, Figs. 2, 3. We do not read the limitation so broadly that it encompasses such an arrangement. To the extent that Petitioner’s construction—“an edge that projects from the perimeter of the ring”—can be read in that manner, we decline to adopt it. As part of its claim construction analysis, Petitioner points out that “projecting edge” in the ’088 specification is “defined as” a projection “off of the ring (preferably off of the ring’s outer circumference), which extend[s] beyond the ring away from the hanging product (e.g. toward the ceiling).” *Id.* 20 (quoting Ex. 1001, 7:59–62). Following that logic, to project from the outer circumference of the ring as required by the claims requires projecting *away*

from the ring, for example, “toward the ceiling,” as the specification indicates. Even if Petitioner properly relied upon Sawaya’s figures that show the ring assembled with the curtain, it does not appear that the flexible hinge 33 projects away from the outer circumference of the ring in this manner.

For at least these reasons, Petitioner has not shown sufficiently that the combination of Lishman and Sawaya discloses all of the limitations of independent claims 1 or 8. Accordingly, we determine the information presented does not show a reasonable likelihood that Petitioner would prevail in establishing that any of claims 1–14 would have been obvious over Lishman and Sawaya.

C. Ground 3: Asserted Obviousness over Lishman and Kaldenbaugh

Petitioner contends claims 1–14 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Lishman and Kaldenbaugh. Pet. 39–51. Kaldenbaugh discloses a “hangable flexible plastic pouch having a rectangular body with a reclosable side aperture.” Kaldenbaugh, Abstract. The pouch includes ventilation holes to accommodate a moisture-containing object such as a glove. *Id.* The pouch includes a hanger hook arrangement that allows the pouch to hang on a rod at a point of sale. *Id.* at 1:19–21.

Relying on the testimony of Paul Hatch, Petitioner explains how the combination of Lishman and Kaldenbaugh allegedly discloses all of the claim limitations and contends that a person having ordinary skill in the art would have been motivated to combine the references. Pet. 39–51. Petitioner relies on Kaldenbaugh for its alleged disclosure of the claimed flat upper edge, projecting edge, and slit. Pet. 40–42. Regarding the rationale

for the combination, Petitioner argues that it would have been obvious “to modify the Lishman ring to include the shape of Kaldenbaugh, which includes a flat upper edge and a projecting edge.” Pet. 42. According to Petitioner, “[o]ne o[f] ordinary skill in the art would recognize the change in shape of the ring as an obvious matter of design choice, as an alternative shape for a hanging ring known in the same field of endeavor.” *Id.* at 42–43. Petitioner further argues that one designing a hanging ring for a curtain would have looked to Kaldenbaugh’s hanging ring design “as a means to identify various functional and aesthetic features for such a hanging ring.” *Id.* at 43. Finally, because Kaldenbaugh’s hanging features allegedly operate in substantially the same way as Lishman, one “could modify the Lishman ring to include the shape of the Kaldenbaugh hanging feature with a reasonable expectation of success.” *Id.* The stated rationale for the combination remains the same for claim 8, and the Hatch Declaration contains virtually the same language as the Petition. *See id.* at 47–48; Hatch Decl. ¶¶ 98, 100.

Patent Owner argues that the asserted combination fails to disclose certain limitations of independent claims 1 and 8, and that the Petition fails to provide adequate motivation for combining the references given that Kaldenbaugh teaches away from the combination. Prelim. Resp. 21–28.

After a review of the record, including the cited portions of the Hatch Declaration, we determine that Petitioner’s stated reasons for the proposed modification of Lishman to include the hanging structure of Kaldenbaugh are insufficient to establish a reasonable likelihood that claims 1 or 8 are unpatentable. Petitioner’s assertion that the proposed modification is a mere change in “shape” to that disclosed in Kaldenbaugh, and that this aspect of

the product boils down to “an obvious matter of design choice” lacks a reasoned basis with rational underpinnings. Pet. 42–43; *see KSR*, 550 U.S. at 418 (stating that obviousness requires more than “mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006))). By resorting to the design choice rationale, Petitioner suggests that changing the shape from the circular Lishman shape to that of Kaldenbaugh does not impact the functionality of the proposed combination. Yet Petitioner relies on Kaldenbaugh for more than its shape; Petitioner relies on Kaldenbaugh for, among other things, its alleged “flat upper edge” and “projecting edge.” *Id.* at 41–42. The ’088 patent describes the important functionality of these features. *See* Ex. 1001, 8:7–17 (describing “numerous functions” of projecting edges/extensions), 9:11–15, 10:60–65 (noting support function of flat upper edge as well as support and ease of opening function of projecting edge 408). The ’088 patent itself, therefore, suggests that the features Petitioner seeks to take from Kaldenbaugh and add to Lishman are more than mere shapes that do not impact the functionality of the proposed combination. Merely stating “design choice” when confronted with a missing limitation, without citing any authority or references to establish why the feature in question amounts to a mere design choice, does not carry Petitioner’s burden. The Hatch Declaration goes no further, and repeats the conclusory assertions in the Petition without explaining why the decision to use Kaldenbaugh’s “shape” amounts to a mere design choice. *See* Hatch Decl. ¶¶ 98, 100. Based on the foregoing, Petitioner did not establish that it

relied only on Kaldenbaugh's shape or that such a decision amounted to a mere "design choice."

The remainder of Petitioner's analysis also lacks sufficient support. Petitioner alleges that one designing a hanging ring for a curtain would look to Kaldenbaugh's hanging ring design "as a means to identify various functional and aesthetic features for such a hanging ring." This broad, unsupported statement does not explain why one of ordinary skill in the art, starting with the shower curtain ring of Lishman, would look to a golf glove hanger used at a point of sale in a retail location for modifications to the curtain's hanging ring. At best, the statement may go to whether Kaldenbaugh falls within the scope of analogous art, but does not explain adequately why one would consider the combination of the hanging feature of Kaldenbaugh's golf glove pouch and Lishman's shower curtain ring. Petitioner's analysis concludes by alleging that the functionality of Lishman and Kaldenbaugh are similar enough that "one of ordinary skill in the art could modify the Lishman ring to include the shape of the Kaldenbaugh hanging feature with a reasonable expectation of success." Pet. 43. Even if true, this allegation goes to whether one "could" make the modification, i.e., whether it was possible, not whether the combination would have been obvious to a person of ordinary skill in the art.

Based on the foregoing, Petitioner has not provided a sufficient rationale for its proposed combination of Lishman's ring and Kaldenbaugh's hanging feature. Accordingly, we determine the information presented does not show a reasonable likelihood that Petitioner would prevail in establishing that any of claims 1–14 would have been obvious over Lishman and Kaldenbaugh.

D. Ground 4: Asserted Obviousness Based on Winkel and Lishman

Petitioner contends claims 1–14 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Winkel and Lishman. Pet. 51–59. Winkel discloses a “safety suspension device . . . used for fast and safe hanging and transporting at least one object.” Winkel ¶ 6. Winkel discloses a suspension system that can be hung from the back of a vehicle seat in a safe manner by attaching a structure to the vertical rod supporting the seat’s headrest. *See id.* at ¶¶ 29, 96, Fig. 9.

Petitioner relies on Winkel for the majority of the limitations in the challenged claims, and relies on Lishman for its disclosure of a shower curtain. Pet. 52–54. Regarding the rationale for combination, Petitioner stated the following:

[I]t would have been obvious to one of ordinary skill in the art at the time of the invention to use the Winkel ring in conjunction with a shower curtain, by adapting the ring to reinforce an opening in a shower curtain, as taught by Lishman. Hatch Aff., para. 113. Winkel discloses a device for hanging an item and Lishman discloses that a shower curtain is one such item that may be hung by a similar ring configuration. Hatch Aff., para. 113. One of ordinary skill in the art could modify the Winkel ring to hang a shower curtain with a reasonable expectation of success. Hatch Aff., para. 113. The resulting shower curtain would include the Winkel slit extending through the outer edge of the shower curtain, in order to allow the supporting rod to be inserted into the opening reinforced by the ring. Hatch Aff., para. 113.

Pet. 54–55. The stated rationale for the combination remains the same for claim 8, with only a sentence or two of additional analysis to address limitations found in claim 8 but not claim 1. *See id.* at 56. The Hatch

Declaration contains virtually the same language as the Petition when addressing these issues. Hatch Decl. ¶¶ 113, 117.

Patent Owner argues that the asserted combination fails to disclose certain limitations of independent claims 1 and 8, and that the Petition fails to provide adequate motivation for combining the references. Prelim. Resp. 29–31. On the combination issue, Patent Owner asserts that Petitioner fails to identify a teaching, suggestion, or motivation explaining why one of ordinary skill “would engage in any such modification of a shower curtain to include the Winkel product.” Prelim. Resp. 30. Patent Owner also argues that one of ordinary skill would not view the approaches as relevant to one another given that Lishman hangs a product from a horizontal rod (a shower curtain rod) and Winkel hangs a product from a vertical rod (the head rest support). *Id.* Finally, Patent Owner alleges that the proposed modification would encounter difficulties and would not work. *Id.* at 31.

We agree with Patent Owner that Petitioner has failed to argue persuasively that one of ordinary skill in the art would have made the proposed modification. Patent Owner correctly notes that Petitioner fails to explain why one of ordinary skill in the art would modify a shower curtain of Lishman to include the Winkel product. Petitioner also fails to explain why one would modify the Winkel ring to include the shower curtain of Lishman. *See* Pet. 54. Merely asserting that one would use “the Winkel ring in conjunction with a shower curtain, by adapting the ring to reinforce an opening in a shower curtain,” does not make it so. *See id.* at 54. Similarly, the fact that Winkel discloses a device for hanging an item, and one such hangable item includes a shower curtain, does not establish a reason to combine. *See id.* at 54–55. Likewise, Petitioner’s assertion that one of

ordinary skill in the art “could” make the modification does not articulate a reason to combine. *See id.* at 55. Petitioner fails to provide sufficiently reasoned analysis and persuasive explanation in support of its proposed combination of the Winkel ring and the shower curtain of Lishman. Further, the lack of an explanation of how the combination would be made, and what the resulting combination would look like given the two-ring structure of Winkel and single-ring structure of Lishman, underscores the need for further explanation and analysis. *See* Pet. 53; Prelim. Resp. 31; Winkel, Fig. 12; Lishman, Fig. 1.

Based on the foregoing, Petitioner has not articulated sufficient reasons to modify the ring of Winkel to incorporate the shower curtain of Lishman, or vice versa. Accordingly, we determine the information presented does not show a reasonable likelihood that Petitioner would prevail in establishing that any of claims 1–14 would have been obvious over Winkel and Lishman.

E. Ground 5: Asserted Obviousness Based on Winkel, Lishman, and Bussell

Petitioner contends claims 1–14 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Winkel, Lishman, and Bussell. Pet. 59–60. Petitioner relies on Bussell for its alleged disclosure of a flat upper edge. The proposed combination relies on the same proposed combination of Winkel and Lishman found lacking above, and does not address any of the shortcomings in that analysis. *Id.* Accordingly, for the same reasons provided above, we determine the information presented does not show a reasonable likelihood that Petitioner would prevail in establishing that any of claims 1–14 would have been obvious over Winkel, Lishman, and Bussell.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented does not establish a reasonable likelihood that Petitioner would prevail in showing that claims 1–14 of the '088 patent are unpatentable on the grounds asserted in the Petition.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is denied as to all challenged claims, and no trial is instituted.

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