

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POLARIS INDUSTRIES INC.,
Petitioner,

v.

ARCTIC CAT INC.,
Patent Owner.

Case IPR2016-01917
Patent 7,669,678 B2

Before MICHAEL W. KIM, SCOTT A. DANIELS, and
SCOTT C. MOORE, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background*

Polaris Industries Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–12 of U.S. Patent No. 7,669,678 B2 (Ex. 1001, “the ’678 Patent”). Paper 1 (“Pet.”). Arctic Cat Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

On March 20, 2017, we instituted an *inter partes* review of claims 1–12 on all grounds of unpatentability set forth in the Petition. Paper 8 (“Dec.”). After institution of trial, Patent Owner filed a Patent Owner Response (Paper 10, “PO Resp.”) and Petitioner filed a Reply (Paper 13, “Pet. Reply”). Petitioner filed a Motion to Exclude. Paper 15 (“Motion” or “Mot.”). Patent Owner filed a Response in Opposition to Petitioner’s Motion to Exclude (Paper 22, “Mot. Resp.”), and Petitioner filed a Reply in support of the Motion (Paper 26, “Mot. Reply”).

An oral hearing was held on November 17, 2017. Paper 30 (“Tr.”). The Board has jurisdiction under 35 U.S.C. § 6. In this Final Written Decision, after reviewing all relevant evidence and assertions, we determine that Petitioner has met its burden of showing, by a preponderance of the evidence, that claims 1–12 of the ’678 Patent are unpatentable.

B. Related Proceedings

Petitioner identifies the following district court proceeding concerning the '678 Patent: *Arctic Cat Inc. v. Polaris Industries Inc.*, Case No. 0:16-cv-00009-WMW-HB (D. Minn.). Pet. 3.¹

C. The '678 Patent

The '678 Patent relates generally to body fenders for all-terrain vehicles ("ATV"), the fenders having textured regions in high scuff areas to protect against scratches. Ex. 1001, 1:6–8. Figure 1 of the '678 Patent illustrates an ATV and is set forth below.

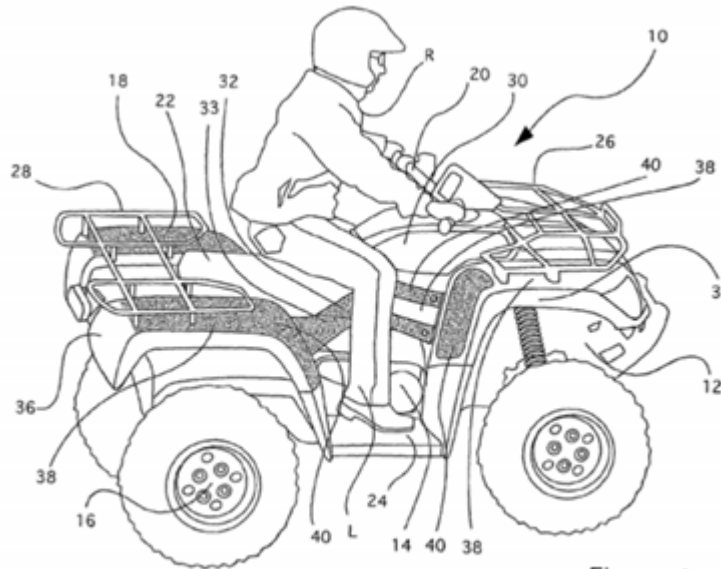


Figure 1

Figure 1 of the '678 Patent is a perspective view of an ATV with a rider thereon.

¹ Patent Owner identifies *Arctic Cat Inc. v. Polaris Industries Inc.*, Case No. 0:16-cv-00008 (D. Minn.). Paper 4, 2 (emphasis added). That district court proceeding, however, appears to involve different patents.

Ex. 1001, Fig. 1. As shown above, ATV 10 includes front fender 34 and rear fender 36 covering wheels 16. Ex. 1001, Abstr., 2:57–60. Front and rear fenders 34, 36 each have smooth portions 38 and textured portions 40 integrally formed in the same mold. Ex. 1001, 3:62–66, 4:3–4. Smooth portions 38 provide a clean, smooth appearance, and textured portions 40 protect against scratches in areas encountering frequent contact with rider R's legs or loads carried on rear rack 28. Ex. 1001, 2:39–45, 3:66–4:2, 4:15–19.

D. Illustrative Claim

A trial was instituted for claims 1–12 of the '678 Patent. Claim 1 is the only independent claim, and is reproduced below:

1. A body panel for a straddle-ridden type vehicle for use by a rider wherein the rider comes in frequent contact with the body panel during use, the panel comprising:
 - a. a smooth exterior portion; and
 - b. a textured exterior portion adjacent said smooth portion, said textured portion being positionable adjacent the leg of the rider in a frequent rider contact zone of the vehicle, wherein said smooth exterior portion and said textured exterior portion are formed of the same unitary body panel, said textured portion being molded unitarily with said smooth portion.

*E. Prior Art References Applied by Petitioner and
Grounds of Unpatentability Instituted for Trial*

We instituted review of claims 1–12 based on the following grounds and prior art references (Dec. 19):

Reference(s)	Basis	Challenged Claims
Tamashima ² and Melonio ³	§ 103(a)	1–12
Tamashima, Melonio, and Matsubayashi ⁴	§ 103(a)	1–12
Tamashima and Kia ⁵	§ 103(a)	1–12

II. ANALYSIS

A. *Level of Ordinary Skill in the Art*

“Section 103(a) forbids issuance of a patent when ‘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.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 405 (2007).

Regarding the level of ordinary skill in the art, Petitioner asserts:

A person of ordinary skill in the art (“POSITA”) in the field of the ’678 Patent at the time of its filing would be familiar with designing plastic components for vehicles and would have familiarity with molding plastics, either through a B.S. degree in engineering and at least three years of experience in vehicle plastic part design and plastic molding techniques, or a Master’s degree in engineering and at least two years of experience in the same fields. (Ex. 1006 ¶¶ 24–26.)

² U.S. Patent No. Des. 429,663, issued Aug. 22, 2000 (Ex. 1002, “Tamashima”).

³ U.S. Patent No. 4,321,105, issued Mar. 23, 1982 (Ex. 1003, “Melonio”).

⁴ U.S. Patent No. 5,107,952, issued Apr. 28, 1992 (Ex. 1004, “Matsubayashi”).

⁵ U.S. Patent Appl. Pub. No. 2003/0030177 A1, issued Feb. 13, 2003 (Ex. 1005, “Kia”).

Pet. 7. Although not discussed in the Patent Owner Response, Patent Owner's expert, Mr. Cowen, disagrees with Petitioner's proffered level of skill in the art, in particular, that experience in designing *vehicle* components is required. Ex. 2011 ¶ 13. Instead, Mr. Cowen asserts:

In my opinion, a POSITA at the relevant time includes a person skilled in plastic product design, tooling, decoration, and design of plastic components and assemblies such as those subject of the Patent, and who has at least five years of experience in plastic product and tooling design, manufacturing methods and decorative techniques applicable to those features prescribed in the Patent at the time of invention.

Ex. 2011 ¶ 14. As an initial matter, we do not discern that the proffered levels of skill are markedly different. Indeed, other than Petitioner's inclusion of vehicles, we discern little difference between the proffered levels of education. And with respect to "vehicles," while Mr. Cowen ostensibly objects to its inclusion, Mr. Cowen also asserts that a POSITA would have been skilled in "design of plastic components and assemblies *such as those subject of the Patent.*" Ex. 2011 ¶ 14 (emphasis added). As noted above, the '678 Patent relates generally to body fenders for all-terrain *vehicles*. Ex. 1001, 1:6–8. Thus, perhaps not in literal form, but in substance, Mr. Cowen effectively agrees with Petitioner. On that basis, we nominally adopt Petitioner's proffered level of skill in the art, but with the understanding that Petitioner's and Patent Owner's proffered levels of skill in the art are substantively indistinguishable.

We further note that the level of ordinary skill in the art is often reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). To that end, we note

that each of the '678 Patent, Tamashima, Matsubayashi, and Kia concern vehicle parts, and that Melonio concerns molding an article with a textured surface.

B. Claim Construction

In an *inter partes* review, a claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2142 (2016) (affirming that USPTO has statutory authority to construe claims according to 37 C.F.R. § 42.100(b)). Under the broadest reasonable construction standard, claim terms are generally given their ordinary and customary meaning, as would have been understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). Only terms which are in controversy need to be construed, and then 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).

We determine that, for the purposes of this Decision, only the following terms require express construction.

1. “*adjacent*”

Independent claim 1 recites “a textured exterior portion *adjacent* said smooth portion, said textured portion being positionable *adjacent* the leg of the rider in a frequent rider contact zone of the vehicle” (emphases added). Dependent claim 4 recites “said textured portion being a portion of the fender *adjacent* the seat” (emphasis added). Dependent claim 5 recites “said textured portion being a portion of the front fender *adjacent* the front of the leg of the rider” (emphasis added).

Petitioner asserts that “adjacent” should be construed as “near.” Pet. 30–31 (citing Ex. 1006 ¶¶ 92–94). In support of its assertion, Petitioner cites dictionary definitions of “adjacent” as “‘not distant: nearby’ or as ‘having a common endpoint or border,’” with an explanation in the dictionary that “adjacent may or may not imply contact.” Pet. 30 (citing Ex. 1028, 16). Petitioner concedes that, under these dictionary definitions, “adjacent” actually has two possible constructions: “having a common . . . border” and “nearby, but not requiring a common border” (hereinafter “nearby”). Of those two possible constructions, Petitioner asserts that “nearby” is more accurate, because it is consistent with the Specification. Specifically, Petitioner asserts that the embodiment in the Specification that most plausibly corresponds to “said textured portion being a portion of the front fender adjacent the front of the leg of the rider,” as recited in dependent claim 5, is the embodiment in which front fender 34 is “near” the front of the

leg of rider R, but not bordering or touching it. Pet. 30 (citing Ex. 1001, 4:59–62, Fig. 1).⁶

Patent Owner asserts that “adjacent” should be construed as “next to,” which Patent Owner argues requires “shar[ing] a common border” or “close enough to frequently touch.” PO Resp. 9, 11. Specifically, Patent Owner asserts that a construction of “adjacent” as “next to” is supported by the claims’ use of “adjacent” in three contexts, as articulated by Patent Owner: (1) “a smooth portion of a panel that is next to (e.g., has a common border with) a textured portion,” (2) “the location of a rider’s leg as next to (e.g., close enough to frequently touch) the textured portion of a panel,” and (3) “the location of a textured portion of a panel that is next to (e.g., close [to] or touching) the seat.” PO Resp. 9. Patent Owner asserts further that these usages are supported by the Specification. PO Resp. 10 (citing Ex. 1001, Abstract, 1:46–50, 2:10–14, 3:26–33, Figs. 1–3). Patent Owner argues that Petitioner’s construction of “adjacent” as “near” is overly broad, because it does not reflect “shar[ing] a common border” or being “close enough to frequently touch,” as set forth in the aforementioned portions of the Specification. PO Resp. 11 (citing Ex. 1001). Patent Owner acknowledges that “the Patent allows for a small gap between the seat 22 and the textured portions of the rear fender 40,” but asserts that “it is clear from the totality of the specification and Figures that the Patent requires the

⁶ Petitioner additionally argues that Patent Owner’s infringement contentions are consistent with construing “adjacent” as “nearby,” in that Patent Owner’s “infringement contentions in the litigation for claim 4 do not show texture next to or bordering the seat, only ‘near’ the seat.” Pet. 30–31 (citing Ex. 1029, 5–7); *see also* Pet. Reply 7 (asserting the same).

seat to be close to or touching the textured portions of a rear fender 40.” PO Resp. 10 (citing Ex. 1001, Fig. 2). In support of its construction, PO additionally cites a dictionary definition of “adjacent” as “next to; adjoining: adjacent garden plots.” PO Resp. 12 (citing Ex. 2001, 17).

As between “near” and “next to,” we agree with Patent Owner that “next to” is more accurate. As a matter of degree, we find that the aforementioned portions of the Specification do support a construction of “adjacent” that is closer in distance. We disagree with Patent Owner, however, that “adjacent,” or even “next to,” requires sharing a common border or touching. Indeed, Patent Owner’s analysis belies their own assertion. For example, Patent Owner asserts that “next to” includes “close enough to frequently touch.” By using the term “frequently,” Patent Owner is admitting that, at times, touching is absent. Furthermore, in setting forth the claims’ usage of “adjacent” in several contexts, Patent Owner uses the term “e.g.” “E.g.” is Latin for “*exempli gratia*,” which means “for example,” indicating, at a minimum, that those usages of “next to” are just exemplary, and, by implication, that “next to” includes other examples that must be broader than sharing a common border or touching. Finally, even Patent Owner acknowledges that Figure 2 of the ’678 Patent shows a gap between textured portion 40 of rear fender 36 and seat 22, which correspond to the claimed “said fender being a rear fender, said textured portion being a portion of the fender *adjacent* the seat” (emphasis added) in claim 4. Ex. 1001, Fig. 2, 4:55–57; *see* PO Resp. 10. Adding to that, Petitioner’s identification of the embodiment of the Specification concerning front fender 34, which does not include bordering or touching the front of the leg of the rider, and the unchallenged testimony of Petitioner’s Declarant, Dr.

Scott, on this issue (Ex. 1006 ¶¶ 92–94), testimony we find adequately supported and credible, we are unpersuaded that “adjacent,” or even “next to,” requires sharing a common border or touching, as asserted by Patent Owner.⁷

For the above reasons, we construe “adjacent” as “next to,” but without requiring adjacent portions to share a common border or be touching, such that our construction of “adjacent” covers an inconsequential gap or space between adjacent portions.

2. “*fender*”

Dependent claims 2–6 and 11–12 each recite “fender.” For example, dependent claim 2 recites “wherein said smooth exterior portion and said textured exterior portion both comprise a portion of a *fender*” (emphasis added). Dependent claim 3 recites “wherein said textured exterior portion is situated on said *fender* in a location of frequent rider leg contact” (emphasis added). Dependent claim 4 recites “said *fender* being a rear *fender*, said textured portion being a portion of the *fender* adjacent the seat” (emphases added). Dependent claim 5 recites “said *fender* being a front *fender*, said textured portion being a portion of the front *fender* adjacent the front of the leg of the rider” (emphases added).

In the Petition, Petitioner argues that “fender” should be construed as “any structure over the wheel.” Pet. 31. Patent Owner argues that Petitioner’s construction is unreasonably broad, and asserts that, because a

⁷ Patent Owner does not cite the Declaration of Mr. Cowen (Ex. 2011) in any portion of its Patent Owner Response. Nevertheless, we have reviewed his Declaration with respect to this issue, and find no relevant statements.

“fender” protects a rider from debris, “fender” should instead be construed as “a guard over the wheel of a motor vehicle.” PO Resp. 12–13. In support of its assertion, Patent Owner lists various dictionary definitions of “fender,” including that cited by Petitioner, as indicating that a fender is a guard mounted over the wheel of a vehicle, to protect against the splashing of debris, such as mud or water. PO Resp. 13–14 (citing Exs. 1028, 2001–2003). For example, *Merriam Webster’s Collegiate Dictionary* (11th ed. 2003) defines “fender” as “a guard over the wheel of a motor vehicle” (Ex. 1028, 461) and *The American Heritage College Dictionary* (4th ed. 2002) defines “fender” as “[a] guard over each wheel of a motor vehicle, for example, that blocks the splashing of water or mud” (Ex. 2001, 511). At oral argument, Petitioner agreed that Patent Owner’s construction has merit. Tr. 12 (“MR. MORTON: . . . [Patent Owner has] taken some issue with that, and said that a fender is really a guard over a wheel, it’s not any structure over a wheel. And we’re fine with that, Your Honor. I think they may be trying to construe their own construction. We’ll see what arguments they make, but it is a structure, a guard -- whatever you like to call it -- over the wheel, that protects the rider from debris.”).

We agree with the parties that the evidence of record supports Patent Owner’s construction of “fender” as “a guard over the wheel of a motor vehicle.”

C. *The Parties’ Post-Institution Arguments*

In our Decision on Institution, we concluded that the arguments and evidence advanced by Petitioner demonstrated a reasonable likelihood that claims 1–12 were unpatentable over certain combinations of Tamashima, Melonio, Matsubayashi, and Kia. Dec. 19. We must now determine

whether Petitioner has established by a preponderance of the evidence that the specified claims are unpatentable over the cited prior art. 35 U.S.C. § 316(e). We previously instructed Patent Owner that “any arguments for patentability not raised in the [Patent Owner Response] will be deemed waived.” Paper 9, 6; *see also* 37 C.F.R. § 42.23(a) (“Any material fact not specifically denied may be considered admitted.”). Additionally, the Board’s Trial Practice Guide states that the Patent Owner Response “should identify all the involved claims that are believed to be patentable and state the basis for that belief.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012).

In its Patent Owner Response, Patent Owner did not contest Petitioner’s contentions that certain claim limitations are described in the prior art. We find Petitioner identifies where each of these limitations is disclosed or suggested in the prior art. . *See* Pet. 31–79 (citing Exs. 1002–1009, 1012, 1013, 1015, 1017, 1020–1022) (unchallenged portions only). Based on the preponderance of the evidence before us, we conclude that the prior art identified by Petitioner describes all limitations of the reviewed claims that were not contested by the Patent Owner in the Patent Owner Response. *In re NuVasive*, 841 F.3d 966, 974 (2016). We address only the contested limitations below.

*D. Claims 1–12 as Unpatentable over
Tamashima and Melonio*

Petitioner asserts that claims 1–12 are obvious over Tamashima and Melonio. Pet. 31–58 (citing Exs. 1001–1003, 1006–1009, 1012–1013, 1015, 1017, 1020, 1022). Patent Owner responds. PO Resp. 15–31 (citing Exs.

1001, 1002, 1006, 2004–2010, 2012–2018). Petitioner replies. Pet. Reply 8–28 (citing Exs. 1004–1006, 1020–1022, 1030, 2012–2019).

1. Tamashima (Ex. 1002)

Tamashima is a design patent for an off-road vehicle. Figure 1 of Tamashima depicts an off-road vehicle and is set forth below.

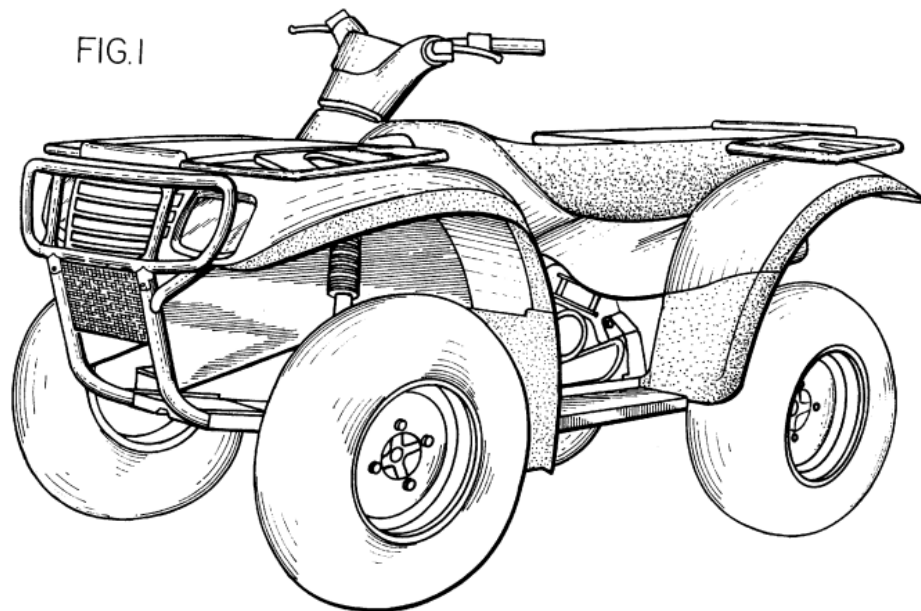


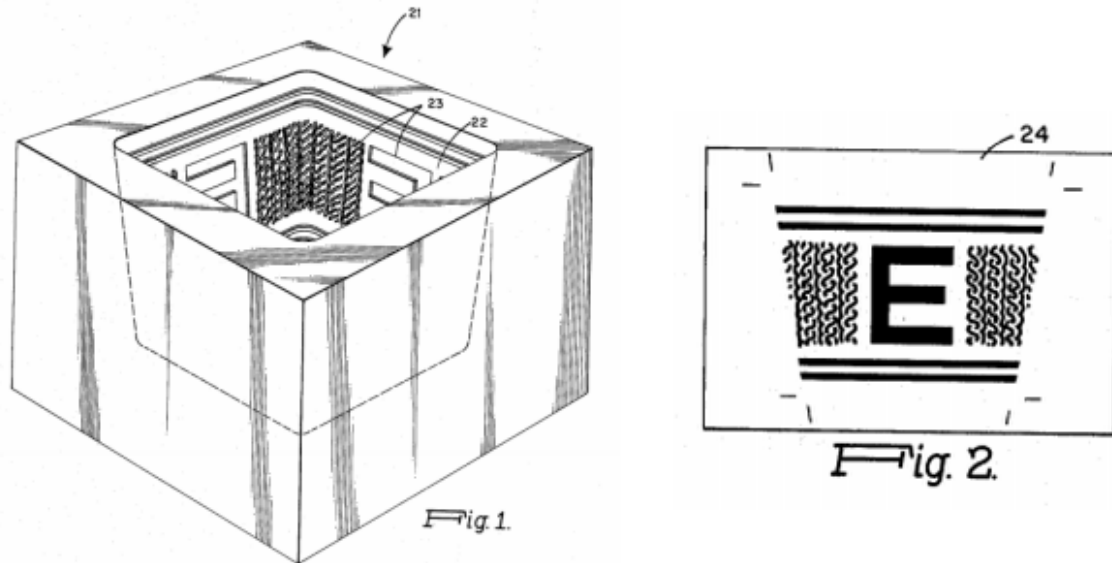
Figure 1 of Tamashima is a perspective view of an off-road vehicle.

Ex. 1002, Fig. 1. As shown in Figure 1, above, Tamashima discloses a body panel design for an off-road vehicle having fenders above the wheels of the vehicle. Bottom and edge portions of the fenders are shaded with a grainy, stippled pattern. Adjacent the stippled portions are top, inner fender portions illustrated without stippling and having a smooth appearance.

2. Melonio (Ex. 1003)

Melonio is directed to a method for producing embossed designs on work surfaces, such as on molds. Ex. 1003, Abstr. Figure 1 of Melonio

depicts a mold cavity having a pattern formed on its surfaces. Figure 2 of Melonio depicts the design to be embossed onto the mold surfaces. Figures 1 and 2 of Melonio are set forth below.



Figures 1 and 2 of Melonio depict a mold cavity having a pattern formed on its surfaces and the design embossed onto the mold surfaces, respectively.

Ex. 1003, Figs. 1, 2. As shown above, “mold cavity 21 [has] internal wall surfaces 22 with decorative patterns 23 embossed therein. . . . so that articles formed in the cavity will have the design embossed therein as an integral part of their outer surface.” Ex. 1003, 2:61–3:5. This results in a “surface texture in an article made with the engraved mold.” Ex. 1003, 1:52–55.

3. Independent Claim 1: Textured Exterior Portion

Petitioner asserts that independent claim 1 is obvious over Tamashima and Melonio. Pet. 31–46 (citing Exs. 1002–1003, 1006–1009, 1012–1013, 1015, 1017, 1020, 1022). For example, independent claim 1 recites “a smooth exterior portion.” Petitioner cites Tamashima for suggesting body

panels with smooth exterior portions. Pet. 39–40. Figure 1 of Tamashima, annotated by Petitioner with red arrows to identify where Tamashima suggests smooth exterior portions, is reproduced below:

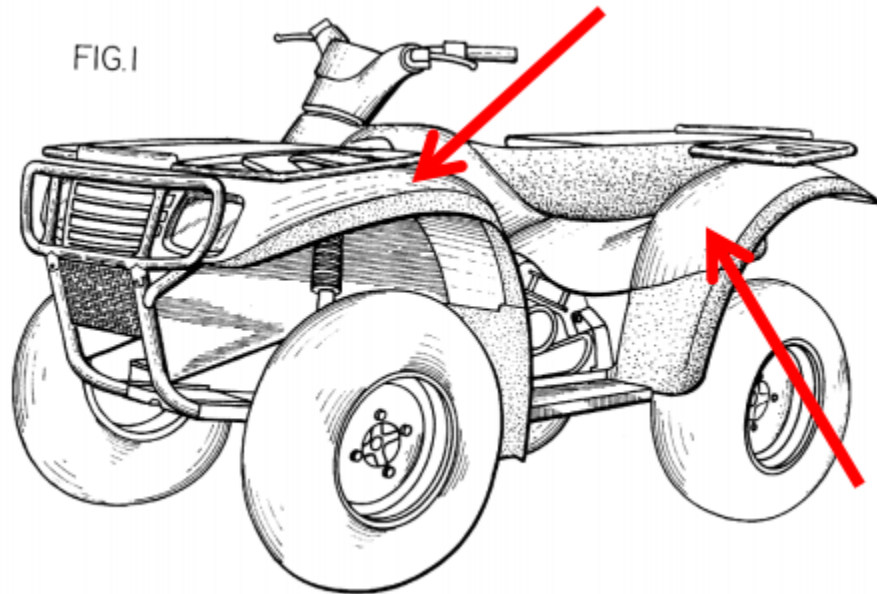


Figure 1 of Tamashima, annotated by Petitioner to point out where Tamashima suggests smooth exterior portions.

Pet. 40. Petitioner additionally cites Melonio for disclosing molded articles with smooth exterior portions corresponding to the smooth portions of internal wall surface 22 of mold cavity 21. Pet. 40.

Independent claim 1 further recites “a textured exterior portion adjacent said smooth portion, said textured portion being positionable adjacent the leg of the rider in a frequent rider contact zone of the vehicle.” Petitioner cites Tamashima for suggesting textured exterior portions adjacent said smooth portion and adjacent the leg of the rider. Pet. 41, 43–44. Figure 1 of Tamashima, annotated by Petitioner with red arrows to identify portions shaded with a stippled pattern, i.e., where Tamashima allegedly suggests textured exterior portions, is reproduced below:

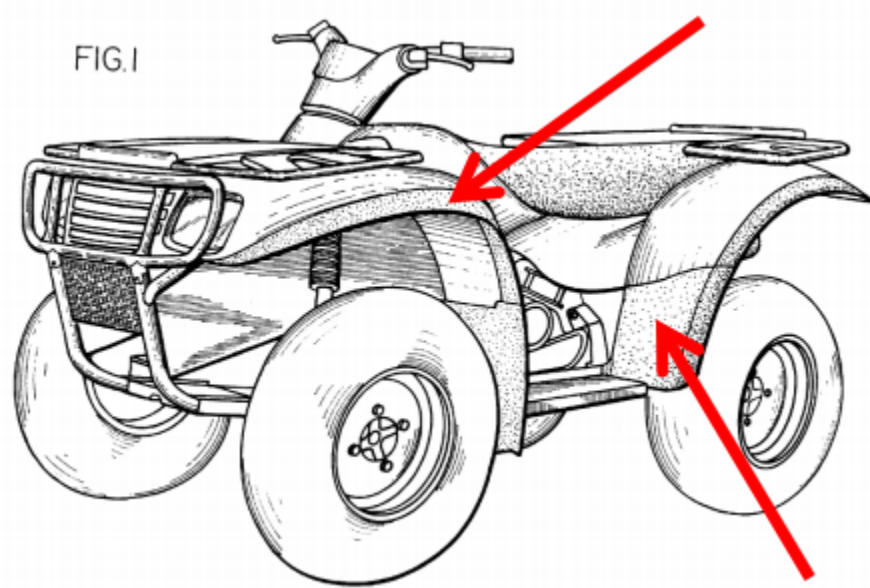


Figure 1 of Tamashima is annotated by Petitioner to identify where Tamashima suggests textured exterior portions.

Pet. 41. According to Petitioner,

[T]he stippling on . . . Tamashima suggest[s] that the areas are textured because a person of ordinary skill in the art would understand that the stippling represents a limited number of possibilities for ATV body panel exteriors: either texturing (on the same or different piece of the fender), or using a different color or material for that portion of the fender.

Pet. 22–23 (citing Ex. 1006 ¶ 84). For example, Petitioner cites MPEP § 608.02, *Drawing Symbols* (7th ed. Rev. 1 Feb. 2000) and notes that, during prosecution of the '678 Patent, Patent Owner argued that a textured surface may be illustrated using the suggested shading from the Manual for Patent

Examination Procedure. Pet. 22–23.⁸ Petitioner additionally cites Melonio for disclosing unitary molded articles with textured exterior portions, corresponding to decorative patterns 23 of mold cavity 21, adjacent the smooth exterior portions, corresponding to the smooth portions of internal wall surface 22. Pet. 42–43.

Independent claim 1 further recites “said smooth exterior portion and said textured exterior portion are formed of the same unitary body panel, said textured portion being molded unitarily with said smooth portion.” Petitioner again relies upon Melonio for disclosing manufacturing unitary molded articles with smooth exterior portions adjacent textured exterior portions. Pet. 44–46.

Petitioner asserts the following based on the Declaration of Dr. Scott:

A POSITA would understand that the straddle-ridden vehicle of Tamashima would have body panels with areas of frequent rider contact. . . . Selectively texturing these areas was a well-known method of improving the appearance of the vehicle, and

⁸ Specifically, Petitioner asserts the following regarding prosecution of the ’678 Patent, in which U.S. Publication No. 2002/0047257 A1, issued Apr. 25, 2002 (Ex. 1021, “Rondeau”), was applied as prior art:

As the patentee argued during prosecution, the grainy, dot speckled shaded portions on these design patents would teach texturing. (See Ex. 1024 at 163 (“If Rondeau wanted to teach a textured surface, he could have easily illustrated such texturing with the suggested shading from the Manual for Patent Examination Procedure. See MPEP § 608.02(IX).”).) As that section of the MPEP shows, grainy and dot speckled portions of drawings represent “stipple.”

Pet. 22. We note that Rondeau is a utility patent publication, as opposed to a design patent publication. Ex. 1021.

integrally molding the textured and smooth portions in the same unitary body panel was a well-known manufacturing technique. Pet. 38 (citing Ex. 1006 ¶¶ 69–72, 76–77, 88–89, 124–125). Thus, Petitioner asserts that “[a] POSITA would have been motivated to combine Tamashima and Melonio, a well-known method of producing unitary plastic panels with both textured and smooth portions in the same mold.” Pet. 34. Petitioner performs a similar analysis for dependent claims 2–12. Pet. 46–58.

Patent Owner argues that Petitioner has not shown adequately that Tamashima’s stippled portion is a sufficient evidentiary basis to account for the “textured exterior portion” recited in independent claim 1. More specifically, Patent Owner argues that Tamashima, a design patent, contains no technical disclosure (PO Resp. 17) and that, “in view of the drawing requirements for design patents. . . . stipple shading does not necessitate texture” (PO Resp. 4). According to Patent Owner, the stippling in Tamashima more likely indicates a different body panel or different color. PO Resp. 18.⁹ Patent Owner argues further that the stippled portions in Tamashima correspond to smooth mud flaps on Kawasaki ATVs, such as the Kawasaki Prairie 650, and that a POSITA would, thus, conclude that the

⁹ Patent Owner cites MPEP 1503.02(II), of Revision 7.1, which pertains to design patents, and states, “[a] contrast in materials may be shown by using line shading and stippling to differentiate between the areas; such technique broadly claims this surface treatment without being limited to specific colors or materials.” PO Resp. 18. Patent Owner notes additionally that, in a more current MPEP version (Ninth Edition, Revision 07.2015), MPEP 608.02(IX) discourages from using graphic drawing symbols in design patent applications to represent a particular material or color. PO Resp. 18–19 n.1.

stippled portions in Tamashima are smooth mud flaps, which would not account properly for a “textured exterior portion . . . of the same unitary body panel,” as recited in independent claim 1. PO Resp. 19–22 (citing Exs. 1002, 2004–2010).¹⁰

Petitioner counters that “the relevant inquiry is not what one commercial product discloses, but instead what the references together teach one of ordinary skill.” Pet. Reply 8. Petitioner asserts that, against the backdrop of known mold texturing technology and integral molding in the automotive body panel art,¹¹ Tamashima would have at least suggested the claimed “textured exterior portions” to one of ordinary skill. Pet. Reply 13–14.

As an initial matter, we agree with Patent Owner that the stipple shading in the ’678 Patent does not necessitate texture, as the various provisions of different versions of the MPEP cited by the parties provide no indication that it does. MPEP § 608.02, *Drawing Symbols* (7th ed. Rev. 1 Feb. 2000), cited by Petitioner, pertains to utility patents, not design patents.¹² MPEP 1503.02(II), of Revision 7.1, cited by Patent Owner, indicates that stippling may be used to “differentiate between the areas” and

¹⁰ Patent Owner refers additionally to Exhibits 2012–2018, which relate to Kawasaki ATVs, purportedly the physical embodiment of the vehicle design claimed in Tamashima. See PO Resp. 22–26. As noted in our analysis below, however, whether the commercial counterpart to the stippled portions of Tamashima is actually smooth or textured is immaterial. Accordingly, there is no need to further evaluate this evidence on this basis.

¹¹ This prior art includes Melonio, as well as Matsubayashi (Ex. 1004) and Kia (Ex. 1005), the secondary references in the other grounds.

¹² Chapter 600 of this version of the MPEP is titled “Parts, Form, and Content of Application.” Chapter 1500 is the “Design Patents” chapter.

show a “contrast in materials,” but that provision and MPEP 608.02(IX) (Ninth Edition, Revision 07.2015) indicate that such graphic drawing symbols generally should not be used in design patent applications to represent a particular material or color. Neither of these two latter MPEP provisions discusses using stippling to denote texture.

Unrelated to minutiae concerning the MPEP, however, Petitioner cites the testimony of Dr. Scott for asserting the following additional theory with respect to the stippled portion of Tamashima:

[T]here are essentially three things that the stippling on Tamashima . . . would likely represent. It is either texturing . . . [or] a different color or made of different material. A person of skill in the art would immediately recognize that texturing was one of the limited number of options for manufacturing an ATV body panel that corresponded to these design patents. Indeed, the locations of the stippling on these design patents *suggest* to a person of ordinary skill that they are textured because the areas come in frequent contact with debris during riding and with the rider as he or she enters or exits or rides the vehicle.

Ex. 1006 ¶ 84 (citing Ex. 1025 (showing a portion of a vehicle including scratch marks)) (emphasis added); *see also* Pet. Reply 11–14 (citing Ex. 1006 ¶¶ 76–84) (providing further analysis concerning the same). Patent Owner asserts that Petitioner’s argument regarding the “suggestion” of texturing is both conclusory and legally insufficient. PO Resp. 19. We disagree. Specifically, we disagree that Petitioner’s “suggestion” argument is conclusory, because Petitioner has provided evidentiary support in the form of nine (9) paragraphs of testimony by Dr. Scott, each paragraph being supported by at least one citation to evidence, all of which we find adequate and credible. In particular, we find credible Dr. Scott’s testimony that

texturing exterior portions on straddle-ridden vehicle exteriors was known. Ex. 1006 ¶ 83 (citing Exs. 1005, 1022).

We also disagree that the “suggestion” is legally insufficient, as *KSR* expressly states the following:

When 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 in the art 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.

KSR Int’l Co., 550 U.S. at 402–403. Petitioner’s assertions fall directly within this rubric, in that Petitioner has expressly identified a design need to address scratching in “areas [that] come in frequent contact with debris during riding and with the rider as he or she enters or exits or rides the vehicle” (Ex. 1006 ¶ 84; *see also* Ex. 1006 ¶ 40 (“Riders and passengers on straddle-ridden vehicles were particularly known for scratching and scuffing vehicle exterior surfaces”))), a need we find credible, and one of ordinary skill would understand that the stippling in Tamashima represents a small number of options, of which one, texturing, is a predictable solution to that identified need. *See* Ex. 1006 ¶ 72 (“Selectively texturing these components to prevent or diminish the appearance of scratching was well-known at this time to straddle-ridden vehicle designers.”). Thus, we are persuaded that the stippling in Tamashima at least suggests to one of ordinary skill in the art that those areas are textured. Finally, we note that the test for obviousness is indeed what the combined teachings would have *suggested* to one of ordinary skill in the art. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Independent from the suggestion of texture by Tamashima's stippling alone, Petitioner additionally cites Melonio for the disclosure of manufacturing unitary molded articles with adjacent smooth and textured portions, and concludes that it would have been obvious to do the same for the corresponding portions of Tamashima for various reasons. Pet. 38, 42–46 (citing, e.g., Ex. 1003, Fig. 1, 2:61–3:5; Ex. 1006 ¶¶ 69–72, 97, 124–125). Patent Owner does not dispute that Melonio discloses “a textured exterior portion adjacent [a] smooth portion . . . said textured portion being molded unitarily with said smooth portion.” *See generally* PO Resp. 15–31. We find that Melonio discloses exactly that.

Instead, Patent Owner argues that because the stippled portion of Tamashima, as purportedly evidenced by the corresponding Kawasaki ATV, is a smooth mud flap, a POSITA would not have selected Tamashima as a primary reference for a “textured exterior portion . . . of the same unitary body panel,” as recited in independent claim 1, or been motivated to combine it with Melonio or the other secondary references to form the same, and that to do so can only be based on impermissible hindsight reasoning. PO Resp. 27. While not entirely clear, Patent Owner appears to be implying that a smooth mud flap cannot correspond to a body panel. Petitioner counters that, “[a]s Dr. Scott concluded, a POSITA starting with prior art ATV designs like Tamashima and using the well-known manufacturing methods of Melonio, Matsubayashi, or Kia would understand that selectively texturing high-contact areas would improve the appearance of the vehicle.” Pet. Reply 19 (citing Pet. 33–37).

We agree with Petitioner, as we find its line of reasoning adequate, supported, and credible. By contrast, we find Patent Owner's line of

reasoning difficult to follow and inadequately supported. Specifically, Patent Owner appears to be asserting that one of ordinary skill, viewing Tamashima, would have immediately associated Tamashima with a Kawasaki ATV, and known that the stippled portion of Tamashima corresponds to a smooth mud flap of the Kawasaki ATV. And since a smooth mud flap cannot correspond to a body panel, there would be no basis to modify the stippled portion of Tamashima, which is a mud flap, to be textured, as in Melonio.

As an initial matter, and fundamentally, we are unclear as to why a “mud flap” cannot correspond to the recited “body panel.” While neither party, nor the ’678 Patent, provides a construction or definition of “body panel,” the ’678 Patent does provide the following exemplary guidance:

ATV body panels, such as fenders are constructed of thermoplastic materials, such as polyethylene, polypropylene, and TPR. Such polymers may be molded to a desired body shape and they are extremely durable: they do not easily break or tear. They also can be formed with smooth, high-gloss surfaces. However, due to the relative softness of these materials they also scratch easily such that the surface finish may be ruined.

Ex. 1001, 1:29–36. The ’678 Patent does not expressly recite the term “mud flap.” From the Patent Owner Response, we are able to glean that Patent Owner asserts that “mud flaps” have the following features: they are smooth (PO Resp. 3, 4, 15, 20, 22, 27–29); they are separate and distinct from a plastic fender (PO Resp. 3, 5, 22–24, 27, 29–30); they are attached to a body panel (PO Resp. 20); and they are smooth black plastic (PO Resp. 24). We

find that these features of a “mud flap” meet the aforementioned guidance, set forth in the ’678 Patent, concerning “body panel.”¹³

Moreover, whether the stippled portion of Tamashima is or is not a “mud flap” is ultimately misplaced, as Patent Owner admits the following: “a POSITA would recognize, as admitted by Petitioner’s Expert, that not only could the stippling be a different body panel, formed from a different colored material, but that it was intended to represent a smooth mud flap.” PO Resp. 22. In other words, Patent Owner admits, and we find, that one of ordinary skill reasonably would have viewed the stippled portion of Tamashima as being a different body panel. *See also* Ex. 1006 ¶ 84 (“Further, based on my experience and review of the relevant art, there are essentially three things that the stippling on Tamashima and Lin would likely represent. It is either texturing—of the same or a different body panel—or it shows two separate portions of the body panel that are either a different color or made of different material.”). With that, and our other

¹³ Mr. Cowan asserts that “mud flaps” are made of “rubber.” Ex. 2011 ¶¶ 35, 36, 39, 42, 43, 45. Such an assertion, however, is not set forth in the Patent Owner Response, and, thus, is not properly set forth in this proceeding. Paper 9, 6 (“The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.”). Instead, the only material explicitly identified for the “mud flap” in the Patent Owner Response is a smooth black plastic (PO Resp. 24), and, in any case, Patent Owner admits that mud flaps are interchangeable with body panels made of different materials. PO Resp. 22 (“Patent Owner submits this evidence to demonstrate that a POSITA would recognize, as admitted by Petitioner’s Expert, that not only could the stippling be a different body panel, formed from a different colored material, but that it was intended to represent a smooth mud flap.”). Thus, at a minimum, we find that “mud flaps” are not *required* to be rubber.

findings set forth above, we are persuaded that one of ordinary skill would have chosen Tamashima as a primary reference. We find further that the various reasons identified in the Petition for modifying the adjacent body panels, including the stippled portions, of Tamashima, such that they are a unitary molded article with adjacent smooth and textured portions, as disclosed in Melonio, are persuasive. Pet. 38, 42–46 (citing, e.g., Ex. 1003, Fig. 1, 2:61–3:5; Ex. 1006 ¶¶ 69–72, 97, 124–25).

Patent Owner asserts additionally that because the Kawasaki ATVs, on which Tamashima is purportedly based, have separate, smooth mud flaps, a person of ordinary skill would have been led away from modifying Tamashima to combine that separate, smooth mud flap with an adjoining panel to arrive at the claimed invention. PO Resp. 27. Patent Owner asserts relatedly that Petitioner’s rationale to combine lacks sufficient rational underpinnings, and is a result of impermissible hindsight. PO Resp. 27–28. Those assertions are unpersuasive, for the same reasons set forth above.

Finally, with respect to secondary considerations, Patent Owner asserts that Petitioner’s discussion of (1) marring and scratching problems of vehicle surfaces, (2) texturing solutions, and (3) unitary molding as being conventional “shows that the claimed invention met a long-felt but unmet need in the art for a unitarily molded body panel with adjacent smooth and textured portions.” PO Resp. 28–29 (citing Pet. 7–23). According to Patent Owner, “[i]f the problem and the solution were really decades old, as asserted by Petitioner, then someone else would have done it first.” PO Resp. 29. Petitioner counters that Patent Owner has not identified an unresolved problem, or submitted any evidence demonstrating that “widespread efforts of skilled workers having knowledge of the prior art had

failed to find a solution to the problem.” Pet. Reply 21–22 (quoting *In re Allen*, 324 F.2d 993, 997 (CCPA 1963)). We need not delve much into the merits of this assertion because, absent evidentiary support, which Patent Owner does not provide, Patent Owner’s argument that the invention of the ’678 Patent met a long-felt but unsolved need is untenable.¹⁴ And even if Patent Owner has made a facially sufficient evidentiary showing, for example, via Patent Owner’s references to the *Petition*, we are persuaded that Patent Owner’s evidence regarding secondary considerations of non-obviousness is not sufficient to outweigh Petitioner’s evidence supporting obviousness, including Melonio and Dr. Scott’s Declaration, which we find adequately supported and credible.

For the above reasons, we are persuaded that Tamashima in view of Melonio renders obvious independent claim 1, including the “textured exterior portion” limitation.

4. Dependent Claims 2–6, 11, and 12: Fender

Dependent claims 2–6 and 11–12 recite, among other limitations, “fender.” Petitioner asserts that Tamashima and Melonio render obvious dependent claims 2–6, 11, and 12. Pet. 47–50, 57–58 (citing Ex. 1002, Figs. 1, 5; Ex. 1003, 1:35–58; Ex. 1006 ¶¶ 69–72, 90–91, 104–118, 124–125). As corresponding to the recited “fender,” Petitioner references the portions of Tamashima’s body panels identified as textured exterior portions and smooth exterior portions (i.e., the stippled and non-stippled portions of the Tamashima’s body panels above the wheels). Pet. 47–50, 57–58.

¹⁴ We have reviewed Mr. Cowen’s Declaration (Ex. 2011), but are unable to identify therein any evidentiary support for this assertion.

Patent Owner argues that “[t]he Tamashima mud flap is not a ‘fender’ in view of Patent Owner’s proposed claim construction because it is not a *guard* over the wheel of a vehicle.” PO Resp. 30 (citing Ex. 1001, 2:25–60, Figs. 1–3). Specifically, Patent Owner argues that “[t]he Tamashima mud flap, standing alone, would clearly do little to prevent a rider from being splattered with debris from the wheels.” PO Resp. 30. Petitioner replies that, under either of Petitioner and Patent Owner’s proposed constructions for “fender,” the stippled portions in Tamashima satisfy the claimed “portion of a fender” (*see* claim 2). Pet. Reply 24–25.

As set forth above, we construe “fender” as “a guard over the wheel of a motor vehicle.” As an initial matter, we are unpersuaded that the stippled areas in Tamashima must represent mud flaps to one of ordinary skill, as discussed above. Nevertheless, we are persuaded, and find, that even a “mud flap” is, at a minimum, capable of guarding against debris, most prominently, mud. We find that the portions in Tamashima corresponding to the claimed “textured exterior portion” and “smooth exterior portion,” i.e., the stippled and non-stippled portions of Tamashima’s body panels above the wheels, together form guards over the wheels of the vehicle, and, thus, each of those body panels corresponds properly to “a portion of a fender,” as recited in dependent claim 2.

Finally, with respect Patent Owner’s assertions concerning secondary considerations, we determine that they are insufficient to outweigh Petitioner’s evidence of obviousness of these claims, for reasons analogous to those set forth above for independent claim 1.

For the above reasons, we are persuaded that Tamashima in view of Melonio renders obvious dependent claims 2–6 and 11–12.

*5. Dependent Claim 10: Textured Exterior Portion
of Frequent Vehicle Load Contact*

Dependent claim 10 recites “said textured exterior portion extending to location of frequent vehicle load contact.” For this limitation, Petitioner cites the stippled portions of the front and rear fenders in Tamashima. Pet. 54–57 (citing Ex. 1001, 2:9–10, 3:12–15; Ex. 1002, Figs. 1, 4, 5; Ex. 1006 ¶¶ 69–72, 114–116, 118, 124–125). Figure 1 of Tamashima, annotated by Petitioner with red and yellow highlights to identify areas having frequent vehicle load contact, is reproduced below:

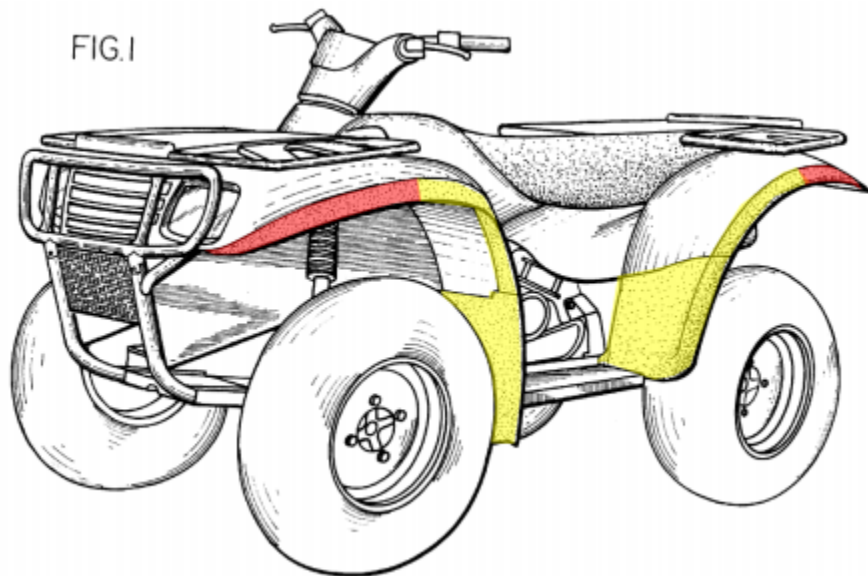


Figure 1 of Tamashima, annotated by Petitioner to highlight areas having frequent vehicle load contact.

Pet. 56. Petitioner identifies in Tamashima, by highlighting in red, areas on the front and rear fenders that would frequently contact loads placed on the front or rear cargo racks. Pet. 54–57 (citing Ex. 1006 ¶¶ 69–72, 118, 124–125). Petitioner additionally asserts that the areas highlighted in yellow above also have “frequent vehicle load contact” by contacting the rider, because the ’678 Patent Specification states that, “[b]roadly, the ‘load’ also

includes the rider.” Pet. 55 (citing Ex. 1001, 3:12–15, 2:9–10; Ex. 1006 ¶¶ 114–116).¹⁵

Patent Owner argues that the yellow-highlighted areas do not satisfy the “location of frequent vehicle load contact” limitation, because “frequent vehicle load contact” must have a distinct meaning from “frequent vehicle rider contact” in light of the Specification. PO Resp. 30 (citing Ex. 1001, 3:64–4:3 (mentions “leg and/or footwear contact from rider R” apart from “load contact from the load being held on rear rack 28”)); *see also* PO Resp. 14–15 (arguing that “frequent rider contact” and “frequent vehicle load contact” are distinctly recited in the claims) (citing Ex. 1001, 3:6–7, 4:37–48, 5:6–8). Patent Owner further argues that the claim term “location of frequent vehicle load contact” corresponds to “the textured area on top of fender 36 and under rack 28” in the ’678 Patent, and that “[t]he outward edge of the rear fender of Tamashima identified in the Petition . . . is clearly not an area of ‘frequent vehicle load contact’ as recited by claim 10.” PO Resp. 30.

Petitioner replies that the ’678 Patent “does not narrowly define load contact to only contact *underneath* the rack.” Pet. Reply 26 (emphasis in original). Referring to Tamashima, Petitioner further explains that bulky or heavy loads that are difficult to maneuver may make contact with the edges

¹⁵ Petitioner asserts that a POSITA would understand that these areas on the body panels would come into frequent contact with loads placed on the front or rear cargo racks, or with the rider during use or mounting or dismounting, and that “selectively texturing these areas would improve the appearance of the body panel.” Pet. 55 (citing Ex. 1006 ¶¶ 69–72, 104–107, 118, 124–125). As discussed above, we find that the combined references suggest providing texture on these portions of the body panels.

of the fenders highlighted in red above, when being placed onto the front or rear storage racks. Pet. Reply 26–27 (quoting Ex. 1006 ¶ 118).

With respect to Patent Owner’s argument that “the frequent vehicle load contact,” recited in dependent claim 10, is distinct from the “frequent rider contact” of independent claim 1, we acknowledge it has some merit. Having said that, the argument is ultimately misplaced, as, regardless of whether the yellow-highlighted areas in Tamashima can be said to extend to a “location of frequent vehicle load contact” by virtue of contacting the rider, we find that at least the red-highlighted areas extend to a “location of frequent vehicle load contact.” In particular, we find credible Dr. Scott’s testimony that the areas in Tamashima highlighted in red by Petitioner are located sufficiently close to the front and rear cargo racks such that they would frequently come into contact with large or heavy items being loaded on or off the cargo racks. See Ex. 1006 ¶ 118.¹⁶ We further agree with Petitioner that nothing in the Specification, or the claims, requires the recited “textured exterior portion extending to location of frequent vehicle load contact” to be a textured area on top of the fender under the cargo rack, as embodied in the ’678 Patent.

¹⁶ For example, as Petitioner explained in oral argument:

Just to give a brief Minnesota example -- these are both Northern Minnesota companies where people deer hunt. And they go out, and they collect the deer that they get with a four-wheeler. And believe me if you [put] a deer up onto one of those cargo racks, you're going to scrape or scruff right where that red portion is in Tamashima. So whatever “Load contact” means, we’ve covered it.

Tr. 15.

Finally, with respect Patent Owner's assertions concerning secondary considerations, we determine that they are insufficient to outweigh Petitioner's evidence of obviousness of this claim, for reasons analogous to those set forth above for independent claim 1.

6. Dependent Claims 7–9

Petitioner asserts that a combination of Tamashima and Melonio renders obvious dependent claims 7–9. Pet. 51–54 (citing Ex. 1002, Figs. 1, 5; Ex. 1006 ¶¶ 111–113). For the reasons set forth in the Petition, which are supported by the cited evidence, we are persuaded that Petitioner is correct.

7. Summary

We are persuaded that Petitioner has met its burden of showing, by a preponderance of the evidence that claims 1–12 are obvious over Tamashima and Melonio.

*E. Claims 1–12 as Unpatentable over
Tamashima, Melonio, and Matsubayashi*

Petitioner asserts that claims 1–12 are obvious over Tamashima, Melonio, and Matsubayashi. Pet. 58–60 (citing Exs. 1004, 1006, 1021). Patent Owner responds. PO Resp. 15–31 (citing Exs. 1001, 1002, 1006, 2004–2010, 2012–2018). Petitioner replies. Pet. Reply 8–28 (citing Exs. 1004–1006, 1020–1022, 1030, 2012–2019).

1. Matsubayashi (Ex. 1004)

Matsubayashi discloses an off-road vehicle in which a rear fender and storage receptacle are formed as an integral unit. Ex. 1004, Abstr., 4:20–22. According to Matsubayashi, “[t]he integrally constructed rear fender and storage receptacle unit is advantageous for many reasons, including

relatively low manufacturing cost, increased structural strength and rigidity, attractive appearance, etc.” Ex. 1004, 4:25–29.

2. Analysis

Petitioner asserts that claims 1–12 are obvious over Tamashima, Melonio, and Matsubayashi. Pet. 58–60 (citing Exs. 1004, 1006, 1021). Petitioner relies upon the same teachings of Tamashima and Melonio for the same limitations as set forth above, adding, “Matsubayashi explicitly discloses molding plastic body panels integrally with other components.” Pet. 59–60 (citing Ex. 1004, 4:20–29; Ex. 1021 ¶ 37). Petitioner asserts that “[a] POSITA would have combined the references based on the aesthetic appearance gained by texturing high contact areas as well as the savings in manufacturing and labor costs associated with molding the texture and smooth portions in the same unitary body panel.” Pet. 59. Petitioner asserts further that a POSITA would “modify Matsubayashi’s integrally formed ATV body panels made of moldable plastic and add both textured and smooth portions on the same unitary panel as taught by Melonio.” Pet. 59–60.

Other than its assertions concerning Tamashima and Melonio that have already been addressed above, Patent Owner does not further challenge this ground of unpatentability with respect to Matsubayashi. *See generally* PO Resp. 15–31. For all other limitations and analysis, we are persuaded that Petitioner has met its burden of showing, by a preponderance of the evidence that claims 1–12 are obvious over Tamashima, Melonio, and Matsubayashi, for the reasons set forth in the Petition.

*F. Claims 1–12 as Unpatentable over
Tamashima and Kia*

Petitioner asserts that a combination of Tamashima and Kia renders obvious claims 1–12. Pet. 60–79 (citing Exs. 1002, 1004–1006). Patent Owner responds. PO Resp. 15–31 (citing Exs. 1001, 1002, 1006, 2004–2010, 2012–2018). Petitioner replies. Pet. Reply 8–28 (citing Exs. 1004–1006, 1020–1022, 1030, 2012–2019).

1. Kia (Ex. 1005)

Kia relates to a molding process using a textured film layer to form a composite article with a textured surface. Ex. 1005, Abstr. The film layer “can have multiple areas of texturing or can have some smooth and some textured areas.” Ex. 1005 ¶ 28. The textured surface “would be a suitable show surface for automotive interior and exterior panels.” Ex. 1005 ¶ 16.

2. Analysis

Petitioner asserts that a combination of Tamashima and Kia renders obvious claims 1–12. Pet. 71–98 (citing Exs. 1002, 1004–1006). Petitioner relies upon the same teachings of Tamashima for the same limitations, including ATV body panels having textured portions adjacent smooth portions, as set forth above. Pet. 61–79. Petitioner cites Kia for disclosing methods to form exterior vehicle body panels having textured portions molded unitarily with smooth portions. Pet. 60–66, 68, 72–73, 79. Petitioner asserts the same rationale to combine the references as discussed above—“[s]traddle-ridden vehicle exteriors are subject to scratching by rider contact, texturing portions of body panels in rider contact areas adjacent smooth portions is a known and effective method to improve the appearance

of the vehicle, and manufacturing the body panels unitarily saves on manufacturing and labor costs.” Pet. 62 (citing Ex. 1006 ¶¶ 124–125).

Other than its assertions concerning Tamashima and Melonio that have already been addressed above and found unpersuasive, Patent Owner does not further challenge this ground of unpatentability with respect to Kia. *See generally* PO Resp. 15–31. This includes Patent Owner’s assertions with respect to secondary considerations. PO Resp. 28–29.

We have reviewed the arguments and supporting evidence cited by Petitioner, and are persuaded that Petitioner has met its burden of showing, by a preponderance of the evidence, that claims 1–12 are obvious over Tamashima and Kia, for the reasons set forth in the Petition.

G. Petitioner’s Motion to Exclude

Petitioner filed a Motion to Exclude, seeking to exclude Exhibits 2011–2018. Mot. 1–8. Specifically, Petitioner moves to exclude Exhibit 2011 as irrelevant under Federal Rules of Evidence (“FRE”) 401 and 402 (Mot. 1–2), and Exhibits 2012–2018 as unauthenticated under FRE 901 and impermissible hearsay under FRE 801 and 802. Mot. 2–8. Patent Owner opposes Petitioner’s Motion to Exclude (Mot. Resp. 1–8), and Petitioner filed a Reply in support of the Motion (Mot. Reply 1–6).

With respect to Exhibit 2011, the Declaration of Mr. Cowen, Patent Owner admits that it did not cite any portion of the Declaration in its Patent Owner Response. Tr. 39:17–41:19.¹⁷ Nevertheless, the Board, in its

¹⁷ We note that with respect to *Petitioner’s* citations to its expert Declaration, Patent Owner asserts the following: “the Board should ignore arguments presented only in an expert declaration and cited without

discretion, has identified certain discrete portions of the Declaration that we were able to readily deduce as relevant to the corresponding portions of the Patent Owner's Response identified above. Accordingly, unless expressly identified above, the Board did not consider any other portion of Mr. Cowen's Declaration. Furthermore, as set forth above, even when those identified, discrete portions of the Declaration are considered, we determine that Petitioner has met its burden of showing, by a preponderance of the evidence, the unpatentability of the challenged claims, on the grounds set forth herein. Accordingly, on that basis, we deny Petitioner's Motion to Exclude Exhibit 2011.

With respect to Exhibits 2012–2018, because we did not rely on these Exhibits, or any testimony associated with them, in reaching our Decision, Petitioner's Motion to Exclude Exhibits 2012–2018 is *dismissed as moot*.

III. CONCLUSION

Petitioner has met its burden of showing the following: Claims 1–12 are obvious over Tamashima and Melonio; claims 1–12 are obvious over Tamashima, Melonio, and Matsubayashi; and claims 1–12 are obvious over Tamashima and Kia. Accordingly, Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–12 of the '678 Patent are unpatentable.

explanation. When relying on evidence such as an expert declaration, the petition must include a detailed explanation of the significance of the declaration, and the Board may exclude or give no weight to the declaration if the petitioner does not explain its relevance. 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(5).” PO Resp. 16.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–12 of the '678 Patent are held unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude with respect to Exhibit 2011 is *denied*;

FURTHER ORDERED that Petitioner's Motion to Exclude with respect to Exhibits 2012–2018 is *dismissed*; and

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

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Patent 7,669,678 B2

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