

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOSE CORPORATION,
Petitioner,

v.

FREEBIT AS,
Patent Owner.

Case IPR2017-00129
Patent 8,630,436 B2

Before KRISTEN L. DROESCH, DAVID C. McKONE, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

DECISION
PATENT OWNER'S REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Bose Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–10 of U.S. Patent No. 8,630,436 B2 (Ex. 1001, “the ’436 patent”). Freebit AS (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). Pursuant to 35 U.S.C. § 314, in our Institution Decision (Paper 10), we instituted this proceeding as to claims 1–10. Patent Owner filed a Patent Owner’s Response (Paper 18, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner’s Response (Paper 22, “Reply”). Patent Owner filed a Motion for Observations Regarding the testimony of Dr. John G. Casali (Paper 26) and Petitioner filed a Response to that Motion (Paper 31). An oral argument was held on January 23, 2018 (Paper 34, “Tr.”). In a Final Written Decision (Paper 35, “Dec.”), we held that Petitioner showed, by a preponderance of the evidence, that claims 1–10 would have been obvious over Berg (Ex. 1004, US 6,944,307 B2), Varming (Ex. 1005, WO 2004/100508 A1), Aber (Ex. 1006, US 1,753,817), and, for claim 6, Marshall (Ex. 1007, US 5,625,171).

Petitioner relies on the Declarations of John G. Casali, Ph.D. (Ex. 1003, “Casali Decl.”; Ex. 1015, “Supp. Casali Decl.”). Patent Owner relies on the Declarations of Wayne J. Staab, Ph.D. (Ex. 2001, “Staab Decl.”; Ex. 2014, “2nd Staab Decl.”).

In a Request for Rehearing (Paper 36, “Req.”), Patent Owner contends that we overlooked cross-examination testimony of Dr. Casali and misapprehended how a person of ordinary skill in the art would have understood the disclosure of Aber and, accordingly, that we should determine that claims 1–10 would not have been obvious.

II. ANALYSIS

The burden of showing that the Decision should be modified is on Patent Owner, the party challenging the Decision. *See* 37 C.F.R. § 42.71(d). In addition, “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

In the Decision, we considered several arguments from Patent Owner that Aber describes a device that is fitted for the front of the ear, and that the groove accommodating the crus of helix at the front of the ear would not have been appropriate for accommodating the extension of the crus of helix at the back of the ear. Dec. 33. After considering the evidence adduced by the parties, including testimony from both experts, we found:

Aber provides a teaching that a groove embracing a ridge of the ear helps hold a device in place in the ear and find that this teaching would have been applicable to Berg’s earpiece. Because the extension of the crus of helix at the location of Varming’s gap is less pronounced than the crus of helix at the front of the ear, a groove at Varming’s gap providing the benefits expressly specified by Aber would be correspondingly less pronounced.

Id. at 34.

We also considered several arguments from Patent Owner that Aber’s groove 18 does not substantially conform to or fit closely against the concha. *Id.* at 35. After considering the evidence adduced by the parties, including testimony from both experts, we found:

Aber’s terms “partially embrace” and “partially surround” connote structure that closely fits against ridges of the ear. This understanding is reinforced by Aber’s description that its grooves “assist in firmly retaining the audiophone in place in the ear” and provide “a much greater area of contact between

the cap 14 and the ear than is commonly found in devices of this kind, which results in less strain on the ear.” Ex. 1006, 1:75–83. We find that Aber’s groove 18 substantially conforms to and fits closely against the crus of helix. It follows that a groove, per Aber’s teaching, placed on Berg’s C-shaped curve at the location specified by Varming would conform to and fit closely against the concha.

Id.

Patent Owner argues that the Decision “**overlooked** substantial evidence and at least one admission by Bose supporting the conclusion that ‘Aber’ teaches, at best, a groove 18 which enables an ear cap to **loosely fit** the crus of helix at the front of the ear.” Req. 2; *see also id.* at 8 (same). According to Patent Owner, “[a]bsent a teaching of structure which closely fits against the concha of the ear, Aber fails to remedy a deficiency of the primary reference, Varming.” *Id.* at 3.

Specifically, Patent Owner argues that we overlooked cross-examination testimony of Petitioner’s expert witness, Dr. Casali, who allegedly acknowledged that (1) Aber’s use of the term “partially surround” connotes structure that does not require touching the crus of helix, (2) Aber’s use of “partially embrace” means only touching the crus of helix in part, and (3) Aber’s use of “accommodate” means that the device only need straddle the concha or give room for the concha under the device. *Id.* at 8–9 (citing Ex. 2015, 9:6–12, 17:4–18, and 18:2–12; Paper 26, 3). Patent Owner argues that Petitioner, in responding to its Motion for Observations, “admitted that the terms accommodate, conform, and straddle can each connote touching or not depending on the context.” *Id.* at 9 (citing Paper 31, 2). Patent Owner points to Dr. Staab’s testimony, which characterizes Dr. Casali as admitting that “accommodating,” as used in Aber, does not require even a partial

embrace. *Id.* at 9 (citing Ex. 2014 ¶ 48). According to Patent Owner, “[m]ere touching of the crus of helix at the front of the ear where the crus of helix is most prominent does not constitute or suggest curvature which provides a close fit at the rear of the concha.” *Id.* at 4.¹

We do not read Dr. Casali’s cross-examination testimony to include admissions that Aber’s device only loosely fits the crus of helix. Rather, in context, Dr. Casali considered “accommodate” and “partially embrace,” as used in Aber, to be synonymous with “conform,” as used in the ’436 patent. Ex. 2015, 11:14–12:12, 13:11–19, 17:4–18. Moreover, we do not read Aber’s references to “accommodate,” “partially embrace,” and “partially surround” in isolation, but rather in the context of its full disclosure. As noted above and in the Decision (Dec. 35), Aber expressly states that its device embraces the crus of helix in such a way as to provide “much greater contact” between the device and the crus of helix and “assist in firmly retaining” the device in the ear. Ex. 1006, 1:17–83. To the extent that “accommodate,” “partially embrace,” and “partially surround” could be read more broadly, Aber makes clear that its device substantially conforms to the concha at the position of the crus of helix. Thus, we did not overlook Dr. Casali’s testimony.

¹ As discussed in the Decision, Petitioner does not rely on Aber for the position of its groove. Dec. 34. Rather, Petitioner contends, and we find, that Aber teaches a groove that substantially conforms to anatomy of the ear and that a skilled artisan would have incorporated an appropriately sized groove at the position in the back of the concha identified by Varming. *Id.* To the extent Patent Owner seeks to reargue that point (Req. 5–7), we fully considered and rejected Patent Owner’s arguments in the Decision. *Id.* at 32–34.

Patent Owner contends that we misapprehended Aber's description and that, instead, "retention and increased contact between the cap and the ear are primarily attributable to Aber's horn-like extension 22," while groove 18 merely assists in retaining the device in place. Req. 10 (citing Ex. 2001 (Staab Declaration) ¶ 100). We fully considered this argument in the Decision and rejected it. Dec. 33 (citing PO Resp. 55–56).² In any case, Aber states that "[a] horn-like extension 22 at the extreme upper portion of the cap lies against the inner surface of the upper forward portion of the helix 7 and within the fossa 10" and "is partially embraced by the helix 7 as shown more clearly in Fig. 1 and by reason of the relatively great distance of this extension from the axis of the cap, a comparatively secure holding effect is produced." Ex. 1006, 1:66–75. Thus, horn-like extension 22 is one feature of Aber's device that helps secure it in the ear. That does not diminish, however, Aber's clear description that groove 18 assists in firmly retaining the device in the ear by partially embracing and providing a much greater area of contact with the crus of helix, as we found in the Decision (Dec. 35). *Id.* at 1:75–83.

Patent Owner further argues that we misapprehended that a groove that partially embraces or partially surrounds a ridge of the ear would only loosely fit against the ear's anatomy and, by virtue of having fewer points of contact, lead to increased discomfort. Req. 11 (citing Ex. 2014 (2nd Staab Declaration) ¶ 49). Patent Owner makes a similar argument that "[i]n contrast to the curvature defined by the subject claims, prior earpieces such

² Patent Owner contends it made this argument at page 59 of its Response. Req. 10. Patent Owner actually made the argument, citing Ex. 2001 ¶ 100, at pages 55–56 of the Response.

as Aber and Feldman included a groove which was merely designed to accommodate, but in many cases interfered, with the crus of helix at the ***front of the ear*** where the crus of helix is most prominent.” *Id.* at 7 (citing Ex. 2014 ¶¶ 21–22). However, as we note in the Decision (Dec. 35), Aber describes that the increased contact area provided by groove 18 results in “less strain on the ear,” i.e., decreased discomfort. Ex. 1006, 1:79–83. If we credit Dr. Staab’s testimony that a device conforming to the concha reduces discomfort, Aber’s description of a groove that fits so as to provide less strain on the ear is further evidence that groove 18 substantially conforms to the concha at the point of the crus of helix, contrary to Patent Owner’s argument. In sum, we did not misapprehend Aber’s disclosure.

III. CONCLUSION

Patent Owner has not shown that we misapprehended or overlooked any of its arguments or evidence. Accordingly, we decline to change our Decision.

IV. ORDER

For the reasons given:

Patent Owner’s Request for Rehearing is denied.

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