

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KRANOS CORPORATION
d/b/a Schutt Sports,
Petitioner,

v.

RIDDELL, INC.,
Patent Owner.

Case IPR2017-01530
Patent 8,938,818 B2

Before PHILLIP J. KAUFFMAN, BARRY L. GROSSMAN, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. §§ 314(a), 325(d); 37 C.F.R. § 42.108(b)

I. INTRODUCTION

Kranos Corporation (d/b/a Schutt Sports) (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–3, 5, 6, 8–12, 14–16, 18, 19, 21–25, 27, 29–32, 34, 36–40, 60, and 61 (collectively, the “challenged claims”) of U.S. Patent No. 8,938,818 B2 (“the ’818 patent”). Paper 1, 1 (“Pet.”). Patent owner, Riddell, Inc. (“Patent Owner”), filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” The Board determines whether to institute a trial on behalf of the Director. 37 C.F.R. § 42.4(a).

Upon consideration of the Petition and Patent Owner’s Preliminary Response, we exercise our discretion pursuant to 35 U.S.C. §§ 314(a), 325(d), and 37 C.F.R. § 42.108(b) and do not institute a trial of the challenged claims.

A. Related Matters

The parties state that the ’818 patent is the subject of a suit captioned *Riddell, Inc. v. Kranos Corporation, d/b/a Schutt Sports.*, Civ. No. 1:16-cv-4496 (N.D. Ill.). Pet. 1; Paper 6, 2.

The parties also identify as a related matter a suit captioned *Riddell, Inc. v. Xenith, LLC*, Civ. No. 1:16-cv-04498 (N.D. Ill.). *Id.*

1. Prior IPRs Involving the ’818 Patent

The ’818 patent is the subject of pending IPR2016-01650, filed by Petitioner. Pet. 1; Paper 6, 3. The challenged claims in the proceeding now before us (IPR2017-01530 (the “1530 Petition”)) also were challenged in IPR2016-01650 (the “1650 Proceeding”). See Ex. 1011, 7–8. In the 1650 Proceeding, the Board

declined to institute a trial on the same claims now challenged in the 1530 Petition. *Id.* at 13–17, 26–32.

Patent Owner also identifies as a related matter IPR2017-01317, filed by Xenith, LLC, challenging claims in the '818 patent. This proceeding was terminated prior to institution of a trial based on a Joint Motion to Terminate following a settlement agreement. *Xenith, LLC v. Riddell, Inc.*, IPR2017-01317 (PTAB Aug. 22, 2017) (Paper 9).

2. Prior IPRs Involving the '118 Patent

The '818 patent is based on a patent application that is a continuation application of the application that matured into U.S. Patent No. 8,528,118 (the "'118 patent"). Ex. 1001, 1.

The parties state that the '118 patent is the subject of a pending petition in IPR2016-01646 filed by Petitioner herein seeking an *inter partes* review of the '118 patent. Pet. 1; Paper 6, 3.

Patent Owner also identifies as a related matter IPR2017-01316, filed by Xenith, LLC, challenging claims in the '118 patent. Paper 6, 3. This proceeding was terminated prior to institution of a trial based on a Joint Motion to Terminate following a settlement agreement. *Xenith, LLC v. Riddell, Inc.*, IPR2017-01316 (PTAB Aug. 22, 2017) (Paper 9).

3. Pending Patent Applications

Patent Owner identifies as related matters pending U.S. Patent Applications Nos. 14/022,011, filed on September 9, 2013, and 14/605,765 filed on January 26, 2015, which "claim priority to the '118 Patent." Paper 6, 3.

B. The '818 Patent

The '818 patent relates generally to a sports helmet, such as a football helmet. Ex. 1001, 1:21–22¹. The disclosed and claimed helmet includes the basic elements well known for such helmets, such as a semi-rigid resinous shell provided with ear ports and with integral, downwardly depending jaw sections to cover the wearer's jaws. See, e.g., Figure 1 from U.S. Patent No. 2,969,546, which is listed as a reference in the '818 patent, and is reproduced below.

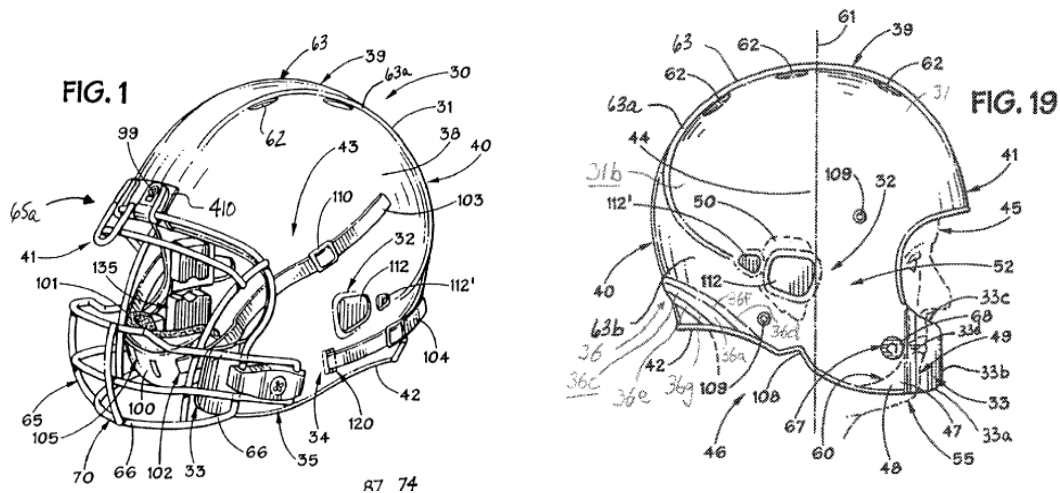


Figure 1 from U.S. Pat. No. 2,969,546
is a perspective view of a prior art sports helmet.

The '818 patent acknowledges “in general, the overall configuration and shape of a football helmet, has remained the same for many years.” Ex. 1001, 1:42–44.

The sports helmet disclosed in the '818 patent is shown generally in Figures 1 and 19, which are reproduced below.

¹ Citations to patent exhibits are in the form of “column:line,” rather than to the page number of the exhibit, in order to provide more specific identification of the cited material.



Figures 1 (perspective view) and 19 (side view)
of a sports helmet from the '818 patent.

As shown particularly in Figure 19, the sports helmet includes offset band 36 extending around a rear region of the shell and above the lower edge surface of the shell. Ex. 1001, Abstract. Offset band 36 includes offset band wall 36a having an inner band surface 36b (see Figure 20) offset from inner shell wall surface 31a. *Id.* at 6:44–46. Offset band 36 also includes outer band surface 36c offset from outer shell wall surface 31b. *Id.* at 6:46–47. As a result of this offset, outer band surface 36c is raised with respect to outer shell wall surface 31b. *Id.* at 50–51. Angled transition walls 36d, 36e extend between offset band wall 36a and rear region 40 of outer shell 31.

Shell 31 also includes raised central band 63 integrally formed as part of the shell and extending across crown region 39 to rear region 40. Band 63 has a width defined by opposed sidewalls 63a that extend outward or transversely from the outer surface of the shell 31. *Id.* at 6:22–24. The width of band 63 preferably increases as it extends across crown region 39 to rear region 40. *Id.* at 6:24–26. Band 63 also has opposed lower side portions 63b, which extend from rear region 40 to a lower portion of ear flap 32 and terminates proximate ear opening 112 (see Figure 19). As shown in Figures 19 and 20, shell 31 includes vent openings 62

aligned along each side of raised central band 63. The vent openings provide ventilation for the wearer's head. *Id.* at 6:10–14. The parties, however, have not directed us to anything in the '818 patent, or to other evidence, that discloses any function or purpose of offset band 36 and central band 63, and we have discerned no such disclosure in our review of the '818 patent.

C. Representative Claim

Among the challenged claims, claims 1, 14, and 29 are independent claims. Claim 1, reproduced below, is representative of the claimed invention:

1. A football helmet comprising:
 - a plastic shell configured to receive a head of a wearer of the helmet, the shell having:
 - a front region,
 - a crown region,
 - a rear region,
 - two side regions wherein each side region has an ear flap with an ear opening,
 - a lower edge surface extending generally from one of the ear flaps and along the rear region to the other of the ear flaps,
 - an inner shell wall surface,
 - an outer shell wall surface,
 - an offset band extending around the rear region and above the lower edge surface, the offset band including
 - an offset band wall having an inner band surface offset from the inner shell wall surface, and an outer band surface offset from the outer shell wall surface, and
 - a pair of angled transition walls, extending between the offset band wall and the rear region;
 - a raised central band integrally formed as part of the shell and extending across the crown region to the rear region, the raised

central band having a width defined by a pair of opposed sidewalls,

a first plurality of vent openings residing outside of the raised central band and aligned along a first side of the raised central band, and

a second plurality of vent openings residing outside of the raised central band and aligned along a second side of the raised central band;

a face guard secured to the shell by a face guard connector; and

a chin strap assembly that releasably secures the helmet to the wearer.

Independent claims 14 and 29 are similar to claim 1 in that they also include both an “offset band” and a “raised central band.” In the 1650 Petition, Petitioner referred to claims 1, 14, and 29, their contested dependent claims, and claims 60 and 61, as the “Offset Claims.” See Ex. 1011, 6. Claim 29 is nearly verbatim identical to claim 1, with some clauses merely repositioned. Claim 29 differs from claim 1 in that claim 29 recites that the “*outer* band surface” of the offset band is offset from the “*outer* shell wall” (Ex. 1001, 17:34–35 (emphasis added)), whereas claim 1 includes this recitation and also recites that the “*inner* band surface” is offset from the “*inner* shell wall” (*id.* at 14:65–67 (emphasis added)).

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 3):

Ground	Claims	Prior Art
§ 102	1–3, 5, 6, 8, 29–32, 34, and 60	Withnall ²

² Ex. 1004, US Patent Pub. No. U.S. 2011/02711428 A1, Nov. 10, 2011 (“Withnall”). We note that this application issued as U.S. Patent No. 9,289,024 on March 22, 2016, and states that the assignee is Riddell, Inc., the Patent Owner in the 1530 proceeding now before us.

Ground	Claims	Prior Art
§ 103	1–3, 5, 6, 8, 29–32, 34, and 60	Withnall, Monica ³ , and Halstead ⁴
§ 103	9–12, 14–16, 18, 19, 21–25, 27, 36–40, and 61	Withnall, Halstead, Monica, and Morgan ⁵ or Speed ⁶ (2 distinct grounds)
§ 103	1–3, 5, 8, and 60	Ide ⁷ , Monica, and Halstead
§ 103	9–12, 14–16, 18, 21–25, 27, and 61	Ide, Monica, Halstead, and Morgan or Speed (2 distinct grounds)
103	6, 2932, and 34	Ide, Monica, Halstead, and Racine ⁸
103	19 and 36–40	Ide, Monica, Halstead, Racine, and Morgan or Speed (2 distinct grounds)
103	1–3, 5, 6, 8, 29–32, 34, and 60	Halstead, Racine, and Monica
103	9–12, 14–16, 18, 19, 21–25, 27, 36–40, and 61	Halstead, Racine, Monica, and Morgan

Petitioner also relies on the declaration testimony (Ex. 1012) of Jamison Float.

³ Ex. 1005, U.S. Pat. No. 5,732,414, March 31, 1998 (“Monica”).

⁴ Ex. 1006, U.S. Pat. No. 6,219,850 B1, April 24, 2001 (“Halstead”).

⁵ Ex. 1007, U.S. Pat. No. 3,609,764, October 5, 1971 (“Morgan”).

⁶ Ex. 1008, “Fitting Instructions and Helmet Care,” Revolution® Speed Varsity Football Helmet, Riddell, Inc. (2010) (“Speed”).

⁷ Ex. 1009, U.S. Patent No. D511,026, October 25, 2005 (“Ide”).

⁸ Ex. 1010, U.S. Patent No. D453,399, February 5, 2002 (“Racine”).

II. ANALYSIS

A. Discretionary Authority to Institute under 35 U.S.C. § 325(d)

In determining whether to institute an *inter partes* review, the Board, acting on behalf of the Director, may take into account whether, and reject a petition because, the same or substantially the same prior art or arguments previously were presented to the Office. 35 U.S.C. § 325(d). Because the 1530 Petition now before us presents substantially the same prior art, and substantially the same arguments, as asserted in the petition in IPR2016-01650 (*see* Ex. 3002) (the “1650 Petition”), we exercise our discretion under 35 U.S.C. § 325(d) and deny institution of a trial.

1. Same Petitioner, Same Patent, Same Claims

The 1650 Petition (i.e., the first petition) and the 1530 Petition (i.e., the second petition, and the petition now before us) were filed by the same Petitioner (Kranos Corporation), challenging the same patent (the ’818 patent), and challenging the same claims. All the claims challenged in the 1530 Petition also were challenged in the 1650 Petition. *Compare* Pet. 3–4 (listing asserted grounds, references and challenged claims) *with* Ex. 3002, 3 (the 1650 Petition, also listing asserted grounds, references and challenged claims). Some claims challenged in the first, 1650 Petition, were not challenged in the second, 1530 Petition, but every claim challenged in the 1530 Petition also was challenged in the 1650 Petition.

2. Substantially the Same References

In the 1530 Petition, Petitioner asserts seven references against one or more of the Offset Claims. *See* Pet. 3–4. These seven references are: Withnall, Ide, Monica, Halstead, Morgan, Speed, and Racine. *Id.* Petitioner asserted five of these references (Monica, Halstead, Morgan, Speed, and Racine) against the Offset

Claims in the 1650 Petition. *See* Ex. 1011, 6–7. Thus, five of the seven references in this proceeding are not only “substantially the same” as the references in the 1650 Petition, they are *identical* to the references in the 1650 Petition. Moreover, Petitioner acknowledges that five of the seven references in the 1530 Petition (Monica Halstead, Morgan, Ide, and Racine) also were “considered during the prosecution of the ’818 patent.” Pet. 8–9. Further, Petitioner relies on these references in the same manner in the first and the second Petition, so that the arguments in each Petition also are substantially the same.

Withnall is the only truly new reference in the 1530 Petition now before us, in that it was not considered in either the 1650 proceeding or the prosecution of the ’818 patent. *See* Ex. 1011, 6.

Withnall and Ide⁹ are the only references cited in the 1530 Petition now before us that were not cited in the 1650 Petition. As we discuss in detail below, with regard to how these references are relied upon, Withnall and Ide are substantially similar to the references asserted in the 1650 Petition.

In the 1650 Petition, Petitioner relied on Speed to assert that the Offset Claims were anticipated under § 102. Ex. 1011, 6. We did not institute a trial in the 1650 proceeding on this asserted ground. Ex. 1011, 13–17 (*see id.* at 17 (“Accordingly, we do not institute trial on this asserted ground of unpatentability.”)).

In the 1530 Petition now before us, Petitioner relies on Withnall to assert that a subset of the Offset Claims, claims 1–3, 5, 6, 8, 29–32, 34, and 60 are anticipated under § 102.

⁹ We note that Christopher Withnall and Thad Ide are among the people named as inventors in the ’818 patent.

In the 1650 Petition, Petitioner relied on Sears or Rappleyea, combined with one or more of the five references relied on in both the 1650 Petition and the 1530 Petition (Monica, Halstead, Morgan, Speed, and Racine) to assert that all or some of the Offset Claims would have been obvious.

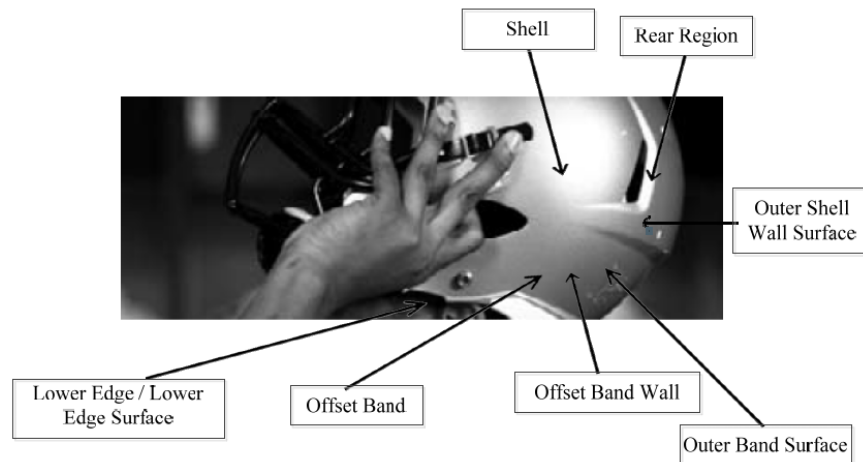
In the 1530 Petition, Petitioner relies on Withnall or Ide, combined with one or more of the five references relied on in both the 1650 Petition and the 1530 Petition (Monica Halstead, Morgan, Speed, and Racine) to assert that all or some of the Offset Claims would have been obvious.

The various combinations of references, asserted against various subsets of the Offset Claims in the 1530 Petition do not change the fundamental fact that the new references, Withnall and Ide, and supporting arguments are substantially similar to the references and arguments asserted in the 1650 Petition challenging some or all of the Offset Claims.

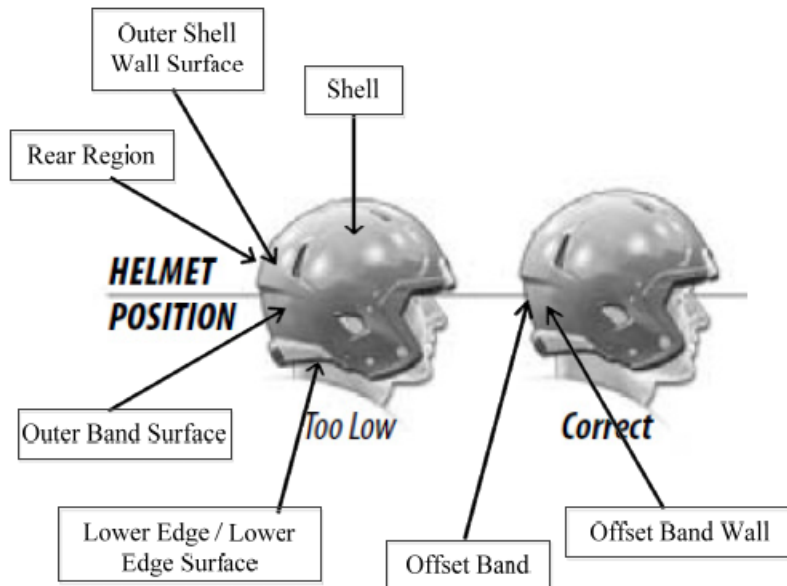
3. Asserted Anticipation

In the 1650 Petition, Petitioner asserted that Speed anticipated the Offset Claims and disclosed the outer offset band, recited in independent claims 1, 14, and 29. Ex. 3002, 19–49. In the 1530 Petition, Petitioner asserted that Withnall anticipated a subset of the Offset Claims. Pet. 19–37. Thus, we consider whether Withnall is substantially similar to Speed in the context of the asserted anticipation of a subset of the Offset Claims.

Reproduced below are two of Petitioner’s annotated figures of Speed from the 1650 Petition, specifically addressing the offset band limitations in the Offset Band claims. *Id.* at 21–22.

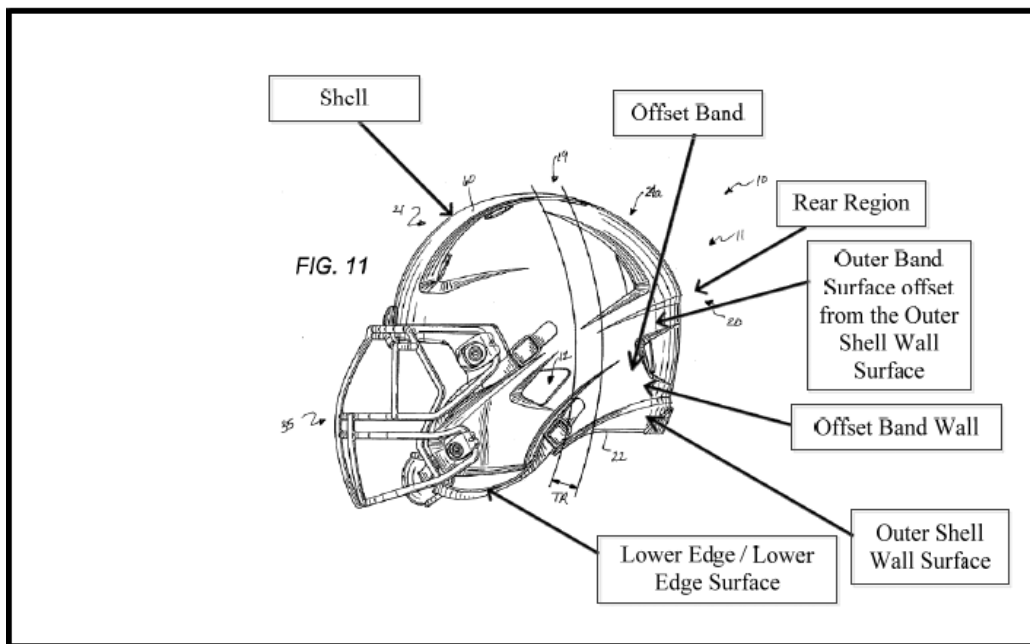


Petitioner's Annotated Figure from Speed. Ex. 3002, 21.

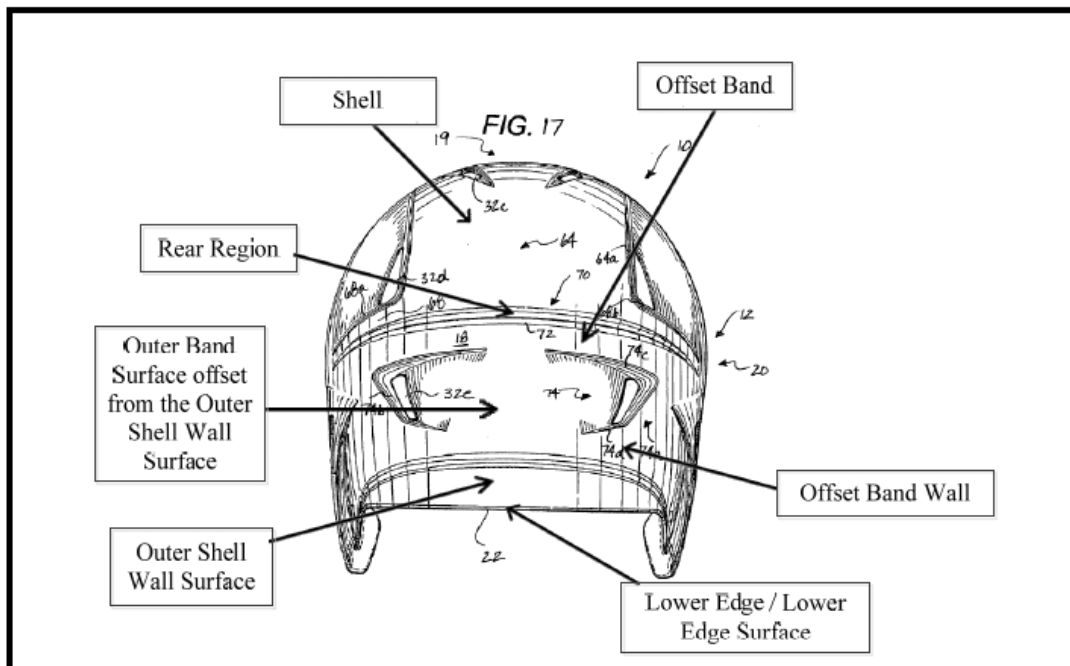


Petitioner's Annotated Figure from Speed. Ex. 3002, 22.

In the 1530 proceeding now before us, Petitioner relies on annotated figures from Withnall, two of which are reproduced below, to establish that Withnall anticipates a subset of the Offset Claims challenged in the 1650 Petition. Pet. 19–37.



Petitioner's Annotated Figure from Withnall. Pet. 22.



Petitioner's Annotated Figure from Withnall. Pet. 23.

Withnall and Speed (Ex. 1008) each are helmets patented (see Ex. 3001) or sold by Patent Owner Riddell. Based on a comparison of the annotated illustrations from Withnall and Speed asserted by Petitioner, the disclosures of

these references, and the related arguments concerning these two references, we determine that the disclosures in Speed and Withnall, and the arguments asserting anticipation, are substantially similar. The alleged offset bands and associated offset band structure (i.e., the offset band wall) in the two references appear to be substantially the same structures. Petitioner has not directed us to persuasive, substantive differences between these two references, or the arguments based on the references, and we discern no such differences on our own analysis.

Accordingly, in the context of the issue before us, we determine that Withnall is substantially similar to Speed and the arguments asserting anticipation are substantially similar.

4. *Asserted Obviousness*

Petitioner asserted in both the 1650 Petition and in the 1530 Petition that claims 1–3, 5, 6, 8, 29–32, 34, and 60 would have been obvious based on Monica, Halstead, and Racine. *Compare* Ex. 3002, 3 (Ground 4) *with* Pet. 3 (Ground 8). Thus, in both cases, Petitioner asserted the *identical* references against the *identical* claims.

Petitioner also asserts, in the 1530 Petition, that a subset of the Offset claims would have been obvious based on Halstead, Racine, Monica, and Morgan. Pet. 4 (Ground 9). These identical references also were asserted to establish obviousness of the Offset Claims in the 1650 Petition, although not in this specific combination. *See* Ex. 3002, 3 (Ground 4, Ground 5). We denied institution of a trial for Grounds 4 and 5 in the 1650 Petition. *See* Ex. 1011, 31 (“Accordingly, we do not institute a trial on this ground [Ground 4]”); *id.* at 32 (“Accordingly, we do not institute a trial on this ground [Ground 5]”). In Ground 9 of the 1530 Petition, Petitioner has repeated the obviousness challenge based on the identical references (Halstead,

Racine, Monica, and Morgan) asserted in the 1650 Petition, although in a slightly modified combination.

Some of the asserted grounds based on obviousness in the 1530 Petition rely on references (Withnall and Ide) that were not asserted in the 1650 Petition. We consider these two different references to determine whether they are substantially similar to the references that were asserted in the 1650 Petition.

In the 1650 Petition, Petitioner relied on Sears *or* Rappleyea combined with various combinations of Halstead, Racine, and Morgan to assert that subsets of the Offset Claims would have been obvious. *See*, Ex. 3002, 3 (Grounds 3 and 5).

In the 1530 Petition, Petitioner relies on Withnall *or* Ide, combined with one or more of the five references relied on in the 1650 Petition (Monica, Halstead, Morgan, Speed, and Racine) to challenge the exact same claims. Pet. 3–4 (Grounds 2–7).

Thus, the issue before us is whether the references and arguments asserted in the 1530 Petition are the same or substantially similar to the references and arguments in the 1650 Petition. As discussed below, in the context of the assertions of obviousness in the 1530 and 1650 Petitions, we determine the references and arguments asserted each Petition are the same or substantially similar.

Sears is a page from a 1971 Sears catalog, depicting football helmets. The image from the catalog relied on by Petitioner is reproduced below. *See* Ex. 1011, 18–19.



The image depicts four similar football helmets (differing in color only). *Id.*

Rappleyea, is directed to “[a] protective helmet having an outer durable shell and an inner replaceable liner of expanded, closed cell, plastic material of a type which is capable of absorbing energy by taking a permanent set.” *See id.* at 19–21. Rappleyea’s Figures 1–5 are reproduced below:

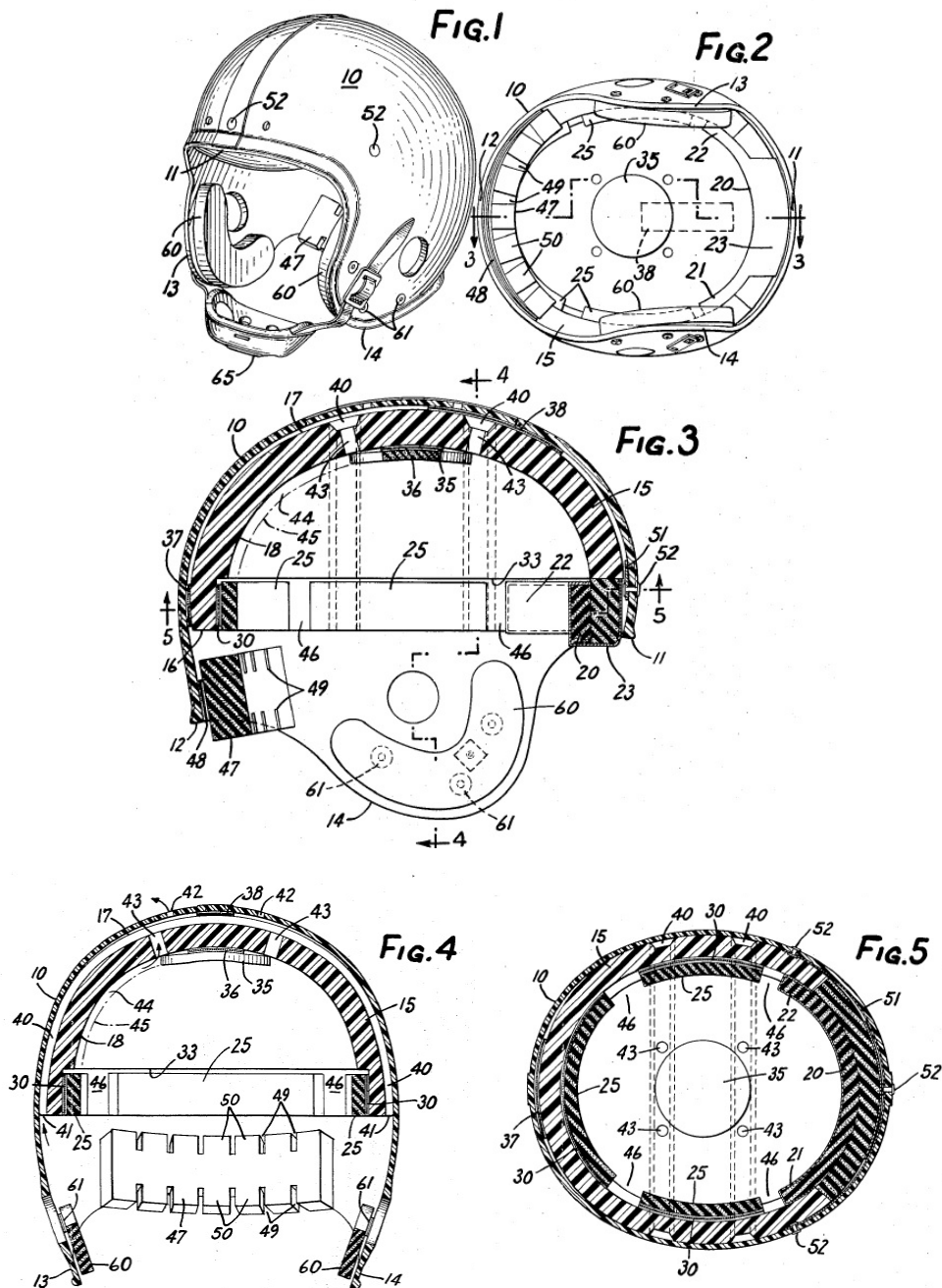
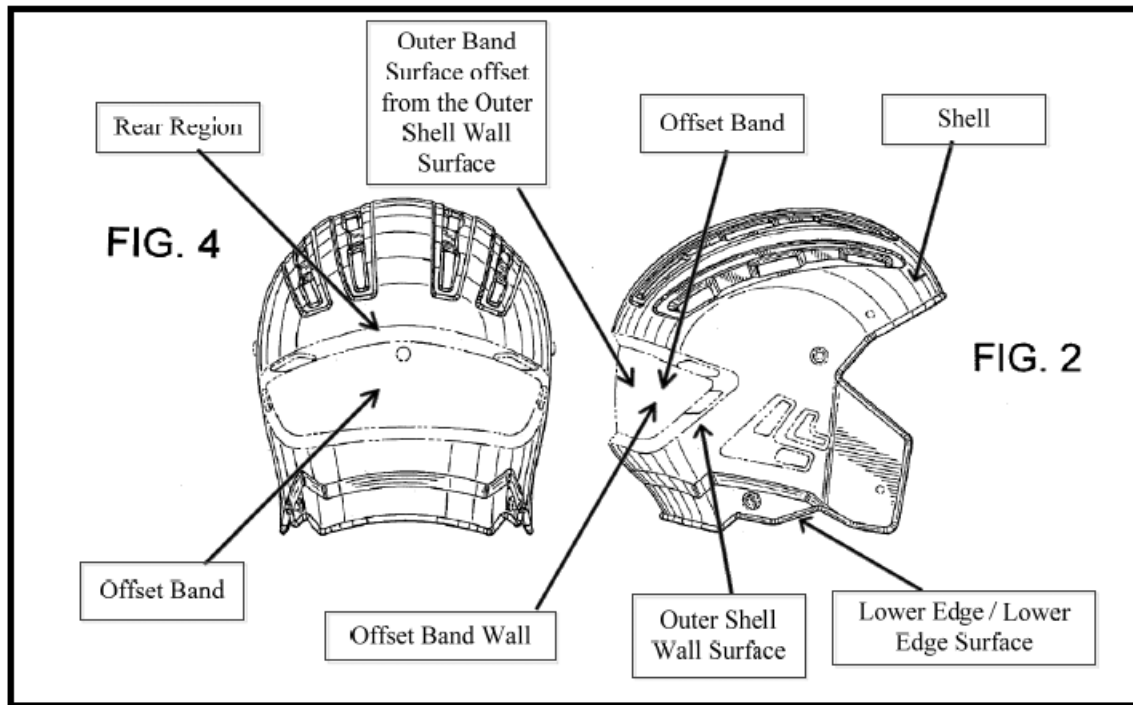


Figure 1 depicts an external view of an embodiment of the disclosed helmet. Figure 2 shows a view of the helmet of Figure 1 from the bottom. Figure 3 depicts a vertical section along line 3-3. Figure 4 depicts a transverse section through line 4-4. Figure 5 depicts a horizontal section through line 5-5. *Id.*

Withnall has been described above.

Ide (Ex. 1009) is a design patent. In the 1530 Petition, Petitioner relies on Ide to show an “offset band,” among other features, as summarized in the annotated illustration from Ide reproduced below.



Petitioner’s Annotated Figure from Ide. Pet. 66.

Petitioner asserts “[t]o the extent Ide does not disclose ‘an offset band wall having an inner band surface offset from the inner shell wall surface,’ Halstead does.” Pet. 66 (citing Ex. 1006, 3:9–16). Halstead was asserted in the 1650 Petition. *E.g.*, Ex. 3002, 72 (“Halstead discloses the Offset Band Limitation.”).

In the 1650 Petition, Petitioner relied on Sears or Rappleyea for the basic structure of the claimed helmet. Ex. 3002, 71 (“[E]ach of Sears and Rappleyea discloses the Plastic Shell Limitation, the Raised Central Band Limitation, the Vent Openings Limitation, and the Chin Strap Limitation.”) These same elements also are disclosed in the newly cited Withnall and Ide references and in the five references common to both petitions.

Accordingly, in the context of the obviousness challenge to a subset of the Offset Claims, we determine that the references and arguments asserted in the 1530 Petition are substantially similar to the references and arguments asserted in the 1650 Petition.

III. CONCLUSION

Upon review of the arguments and evidence in the Petition and Preliminary Response, we conclude that the 1530 Petition presents substantially the same prior art and arguments previously presented by Petitioner in the 1650 petition against the same claims. Indeed, Petitioner's newly asserted grounds are based on essentially the same combinations of references asserted in the 1650 Petition. We also consider Patent Owner's interest in avoiding harassment and delays, the Board's interest in deciding issues efficiently, and potential prejudice to the Petitioner if we deny institution. *See Toyota Motor Co. v. Adaptive Headlamp Technologies, Inc.*, IPR2016-01740 (PTAB March 10, 2017) (Paper 7).

On the record before us, we conclude that the circumstances in this case weigh in favor of invoking our discretion under 35 U.S.C. § 325(d) and 37 C.F.R. § 42.108(b) to deny institution of an *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is ORDERED that the Petition is denied as to all grounds and all challenged claims, and we do not institute a trial based on the Petition.

Case IPR2017-01530

Patent 8,938,818 B2

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