

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIRSTSPEAR, LLC,
Petitioner,

v.

LINEWEIGHT, LLC,
Patent Owner.

IPR2019-01170
Patent 9,173,436 B2

Before PATRICK R. SCANLON, JAMES J. MAYBERRY, and
RYAN H. FLAX, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of Decision
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

FirstSpear, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–15 of U.S. Patent No. 9,173,436 B2 (Ex. 1001, “the ’436 patent”). Lineweight, LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

On December 9, 2019, we issued a Decision Denying Institution of *Inter Partes* Review. Paper 15 (“Decision” or “Dec.”).

Petitioner requests rehearing of our Decision. Paper 16 (“Rehearing Request” or “Reh. Req.”). For the reasons set forth below, Petitioner’s Request for Rehearing is *denied*.

II. ANALYSIS

A. Legal Standard

The applicable requirements for a request for rehearing are set forth in 37 C.F.R. § 42.71(d), which provides:

A party dissatisfied with a decision may file a single request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The 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.

We review our Decision under an abuse of discretion standard. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

“Substantial evidence is ‘such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.’” *OSI Pharm., LLC v. Apotex Inc.*, 939 F.3d 1375, 1381 (Fed. Cir. 2019) (quoting *Consol. Edison Co. v. N.L.R.B.*, 305 U.S. 197, 229 (1938)). “The substantial evidence standard asks ‘whether a reasonable fact finder could have arrived at the agency’s decision.’” *OSI Pharm.*, 939 F.3d at 1381–82 (quoting *Gartside*, 203 F.3d at 1312).

B. The Decision Denying Institution

The Petition asserts one of ordinary skill in the art “would have been motivated to adhere Fegen’s exterior garment layer to a substrate in order to provide a substrate material having water-proofing or scent blocking properties as taught by Stevens.” Pet. 31–32 (citing Ex. 1002 ¶ 55; Ex. 1006, 2:1–4, 3:50–53). In addition, the Petition asserts that one of ordinary skill in the art “would understand that the slits in Fegen extend all the way through the exterior layer and the substrate in order to permit attachments to be more easily secured to Fegen’s garment.” *Id.* at 35 (citing Ex. 1002 ¶ 62; Ex. 1005, Fig. 3).

In the Decision, we determined that Petitioner had failed to establish sufficiently that it would have been obvious to one of ordinary skill in the art to combine Fegen and Stevens in the manner proposed. Dec. 14–16. In particular, we determined that providing slits or openings in the substrate of the proposed combination of Fegen and Stevens “would defeat, or at least greatly diminish, any water-proofing or scent blocking properties of the substrate.” *Id.* at 15. Thus, we disagreed with Petitioner’s contention that one of ordinary skill in the art would have been motivated to add a substrate

to Fegen's garment for the purpose of providing water-proofing or scent blocking properties. *Id.*

C. Petitioner's Arguments on Rehearing

Petitioner argues that the factual finding regarding providing slits or openings in the substrate of the proposed combination of Fegen and Stevens "is not supported by any evidence of record and is directly contrary to the evidence of record." Reh. Req. 2. To support of this argument, Petitioner points to three passages from the Petition and contends that providing the substrate with water-proofing or scent blocking properties prevents the exterior layer from absorbing the user's sweat and increasing the garment's weight and odor. *Id.* (citing Pet. 31–32, 37, 42). Thus, according to Petitioner, "[p]ortions of the exterior layer that are non-existent, due to a slit or opening, cannot contact or absorb fluids," such that "the presence (or absence) of the substrate layer where there is an opening in the exterior layer is inconsequential in terms of the effectiveness of water-proofing and scent blocking properties." *Id.* at 2–3.

We disagree with this broad assertion because the Petition does not demonstrate sufficiently why providing openings in the substrate, as the claims require, would not have led one of ordinary skill in the art to consider such openings detrimental to the rationale of providing water-proofing or scent blocking properties. Petitioner's assertion also ignores the fact that the corresponding openings in the substrate would allow sweat and odor to pass through freely, thereby decreasing the effectiveness of water-proofing and scent blocking properties. Although no evidence of record appears to state expressly that openings of the size claimed would allow sweat and odor to pass freely through the substrate, this fact would have been readily apparent

to one of ordinary skill in the art. Thus, the Rehearing Request fails to demonstrate that a reasonable fact finder could not have arrived at this fact, such that our determination is supported by substantial evidence. *See OSI Pharm.*, 939 F.3d at 1381–82.

Furthermore, Petitioner’s argument that the “non-existent” portions (i.e., the openings) of the exterior layer cannot contact or absorb fluids does not persuade us that at least some of the sweat passing through the openings would not contact portions of the exterior layer surrounding the openings and therefore be absorbed by the exterior layer, which Petitioner asserts would not have water-proofing or scent blocking properties. *See* Pet. 37 (citing Ex. 1002 ¶ 65).

Petitioner also argues that “[t]here is no evidence supporting a difference in effectiveness of the water-proofing and scent blocking properties of the substrate whether the substrate is a solid sheet of material or the substrate contains slots or openings in the same location as the exterior layer.” Reh. Req. 3. This argument, however, attempts to improperly shift the burden of persuasion away from Petitioner. “In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). The burden of persuasion rests with Petitioner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes*

review). Thus, Petitioner has the burden of presenting evidence supporting its assertion that there is no difference in effectiveness of the water-proofing and scent blocking properties of the substrate with or without openings.

To that end, Petitioner argues that Stevens contradicts the Board's findings by disclosing that "the substrate can be 'any desired sheet material, . . . or mesh material and can include a scent blocking material.'" Reh. Req. 3 (citing Ex. 1006, 3:50–53; Pet. 37, 42–43; Ex. 1002 ¶¶ 65, 74). According to Petitioner, "Stevens' mesh embodiment demonstrates that a substrate may have holes in the form of a mesh and still effectively provide the beneficial properties." *Id.* This argument is not persuasive for the following reasons.

First, although citing Stevens's disclosure that the substrate can be a mesh material, the Petition does not state expressly that this disclosure demonstrates that a mesh substrate would effectively provide water-proofing and scent blocking properties. *See* Pet. 37 (citing Ex. 1002 ¶ 65; Ex. 1006, 2:1–4, 3:50–53), 42–43 (citing Ex. 1002 ¶¶ 74–75; Ex. 1006, 2:1–4, 3:12–13, 3:50–53; Ex. 1007, 5:6–9). Dr. Palmer's testimony, which merely repeats the Petition's assertions, also does not state expressly that Stevens's disclosure demonstrates that a mesh substrate would effectively provide water-proofing and scent blocking properties. *See* Ex. 1002 ¶¶ 65, 74–75. We could not have misapprehended or overlooked an argument that was not presented in the Petition.

Second, we are not persuaded that Stevens would have suggested to one of ordinary skill in the art that openings could have been formed in the substrate without decreasing the effectiveness of its water-proofing and scent blocking properties. Stevens discloses "[c]amouflage material 12 comprises a substrate material 22, which can be any desired sheet material, including a

woven or non-woven fabric or mesh material and can include a scent blocking material.” Ex. 1006, 3:50–53. This disclosure, however, does not indicate that the mesh material itself has water-proofing or scent blocking properties. In particular, the disclosure that the substrate can be a mesh material *and can include a scent blocking material* indicates that a separate material is provided with the mesh material to produce scent blocking properties.

Stevens also does not disclose specifically that the mesh material is water-proof. Stevens mentions water-proofing only once, stating: “[o]ne problem with [applying heat to join an outer garment layer to a substrate] is that it cannot be used where the substrate is manufactured from typical waterproof material or scent absorbing material, which has a melting point significantly less than the temperature applied to the outer layer.” *Id.* at 1:67–2:4. This passage is not an affirmative indication that the substrate of the camouflage material disclosed in Stevens is water-proof. Even to the extent that this passage evinces a preference for a water-proof substrate, Stevens still does not disclose that the mesh material is necessarily water-proof and, in fact, is silent as to how any of its substrates would be made water-proof. Moreover, the Petition appears to suggest that Stevens’s mesh material is distinct from water-proof or scent blocking materials, asserting that “Stevens teaches a substrate having different properties than the outer layer, with examples being a substrate made from waterproof or scent blocking material, *or made from a mesh material.*” Pet. 37 (citing Ex. 1006, 2:1–4, 3:50–53) (emphasis added). Accordingly, we disagree that Stevens’s mesh embodiment demonstrates that a substrate may have holes in

the form of a mesh and still effectively provide water-proof or scent blocking properties.

For the above reasons, we are not persuaded our determination that providing slits or openings in the substrate of the proposed combination of Fegen and Stevens “would defeat, or at least greatly diminish, any water-proofing or scent blocking properties of the substrate” is not supported by substantial evidence or that we abused our discretion by reaching that determination. Thus, after considering Petitioner’s arguments for rehearing, we determine Petitioner has not carried its burden of showing that we misapprehended or overlooked any matter or that the Decision denying institution of *inter partes* review was an abuse of discretion.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Request for Rehearing (Paper 16) is *denied*.

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