

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YKK CORPORATION,
Petitioner,

v.

3M INNOVATIVE PROPERTIES CO.,
Patent Owner.

IPR2020-00699
Patent 10,165,833 B2

Before BARRY L. GROSSMAN, KEVIN W. CHERRY, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

Denying Petitioner's Request for Rehearing of
Final Written Decision Determining Some Claims Unpatentable
37 C.F.R. § 42.71(d)

I. INTRODUCTION

YKK Corporation (“Petitioner”),¹ on March 10, 2020, filed a Petition to institute *inter partes* review of claims 1–20 of U.S. Patent No. 10,165,833 B2 (Ex. 1001, “the ’833 patent”). Paper 1 (“Petition” or “Pet.”). 3M Innovative Properties Co. (“Patent Owner”)² filed a Preliminary Response to the Petition. Paper 7 (“Preliminary Response” or “Prelim. Resp.”).

After institution, Patent Owner filed a Patent Owner Response (Paper 15), Petitioner filed a Reply (Paper 19, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 22). Patent Owner also filed a Conditional Motion to Amend (Paper 16), and Petitioner filed an Opposition to the Motion to Amend (Paper 20). We provided Preliminary Guidance on the Motion to Amend (Paper 21). Patent Owner filed a Revised Motion to Amend (Paper 23) and Petitioner filed an Opposition to the Revised Motion to Amend (Paper 25). An oral hearing was held on July 14, 2021, the transcript of which has been entered into the record. Paper 38 (“Tr.”).

On September 13, 2021, we entered a Final Written Decision determining that Petitioner had shown by a preponderance of the evidence that claims 1–11 and 13–20 of the ’833 patent were unpatentable but had not shown by a preponderance of the evidence that claim 12 was unpatentable. Paper 39 (“Dec.”). In the Final Written Decision, we also determined that all of Patent Owner’s proposed substitute claims were unpatentable.

¹ Petitioner identifies itself and YKK Corporation of America as the real parties in interest. Pet. 1.

² Patent Owner identifies itself and 3M Company as the real parties in interest. Paper 5, 1.

Dec. 82–114. Petitioner requests rehearing of our Final Written Decision. Paper 40 (“Rehearing Request” or “Reh. Req.”). For the reasons set forth below, Petitioner’s Rehearing Request is *denied*.

II. LEGAL STANDARDS

A party requesting rehearing bears the burden of showing that a decision should be modified. 37 C.F.R. § 42.71(d). The party must specifically identify all matters it believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* A request for rehearing, therefore, is not an opportunity merely to disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence. *See, e.g., Presidio Components, Inc. v. AVX Corporation*, IPR2015-01332, Paper 21, 4 (PTAB Feb. 21, 2016) (“Patent Owner’s arguments in this regard amount to a mere disagreement with our analysis or conclusion. But mere disagreement with our analysis or conclusion is not a sufficient basis for rehearing. It is not an abuse of discretion to provide analysis or conclusion with which Patent Owner disagrees.”)

III. ANALYSIS

In the Final Written Decision, we determined that Petitioner had not met its burden of showing, by a preponderance of the evidence, that claim 12 of the ’833 patent was unpatentable over Petersen-1 and Busam (Ground 8) or unpatentable over Petersen-1, Miller, Daio-Seishi, and Busam (Ground 9). Petitioner now requests that we reconsider the Final Written Decision and find that claim 12 is unpatentable in view of Petersen-1 and Busam (Ground

8), and Petersen-1, Miller, and/or Daio Seishi, and Busam (Ground 9). Reh. Req. 1.

In Section I of the Request for Rehearing, Petitioner argues that “the Board misapprehended that Grounds 8 and 9 incorporate the evidence and arguments for claims 1, 10, and 11, from which claim 12 depends.” Reh. Req. 2. According to Petitioner, because the Board found claims 1, 10, and 11 invalid, “the only remaining issue with respect to claim 12 was whether the desired fastening performance (‘wherein the mechanical fastener engages with the loop material with a shear strength of at least 2000 gram-force’) would have been obvious.” *Id.* Although Petitioner acknowledges that “it is true that claim 12 recites a slightly narrower loop basis weight range than intermediate claim 11,” “3M never challenged Busam’s overlapping loop basis weight range.” *Id.* at 6.

We do not find Petitioner’s arguments persuasive.

Claim 12 of the ’833 patent recites “[t]he fastening system of claim 11, wherein the loop material has a fiber basis weight in a range from 20 grams per square meter to 30 grams per square meter, and wherein the mechanical fastener engages with the loop material with a shear strength of at least 2000 gram-force.” Ex. 1001, 27:7–11. Claim 11 recites “wherein the loop material has a fiber basis weight in a range from 10 grams per square meter to 30 grams per square meter.” *Id.* at 27:4–6. Thus, the basis weight range of the loop material of claim 11 (10–30 gsm) is twice as broad as the basis weight range of the loop material of claim 12 (20–30 gsm). Thus, we cannot agree with Petitioner’s contention that the loop material basis weight range of claim 12, which is half that of claim 11, is only

“slightly narrower.”

We also do not agree with Petitioner’s contention that “the only remaining issue with respect to claim 12” relates to “the desired fastening performance” (i.e., shear strength). As we noted in the Final Written Decision, with respect to Ground 8, “Patent Owner does not present any argument for claims 11 and 14 other than what we have already considered with respect to claim 1.” Dec. 68. Patent Owner did, however, present additional arguments and evidence specific to claim 12 regarding the basis weight of the loop material disclosed in Busam. *Id.* 69. More specifically, as quoted in the Final Written Decision, Patent Owner argued, *inter alia*, that:

Busam does **not** disclose, and Petitioner[] fail[s] to show, that the sample fasteners for which the shear strength results were reported in Busam, in fact, used a loop material having a fiber basis weight in a range from 20–30 grams per square meter. The fiber basis weight of the loop material of the tested “selection of samples” in Busam could have been above or below this claimed range.

Id. (citing PO Resp. 59 (citing Ex. 2008 ¶ 116)). After reviewing all of the parties’ arguments and evidence regarding claim 12, we concluded that “Petitioner has not demonstrated whether the fiber basis weight of the loop material used in Busam’s testing falls within the fiber basis weight range, as recited by claim 12.” Although Petitioner’s contention that “3M never challenged Busam’s overlapping loop basis weight range” may be true with respect to claim 11, it simply is not true with respect to claim 12. With respect to claim 12, we specifically agreed with Patent Owner’s expert, Mr. Kline, that “[t]he fiber basis weight of the loop material of the tested

‘selection of samples’ in Busam could have been above or below this claimed range.” Dec. 72 (citing Ex. 2008 ¶ 116). Simply put, Petitioner’s Request for Rehearing overlooks the fact that Patent Owner presented additional arguments and evidence specific to claim 12. Although we agreed with Petitioner’s arguments and evidence with respect to claims 1, 10, and 11, we nevertheless agreed with Patent Owner’s arguments and evidence specific to claim 12.

In Section II of the Request for Rehearing, Petitioner argues that the analysis of Busam in the Final Written Decision was incorrect for three reasons. Reh. Req. 9. Specifically, Petitioner argues:

The Board’s analysis is incorrect because it (1) relies only on Busam’s explicitly disclosed measured shear strengths, (2) ignores Petitioner’s evidence demonstrating that it would have been obvious to achieve claim 12’s shear strength performance, and (3) fails to take into account [sic - Busam’s] disclosure of an overlapping loop basis weight range.

Id. at 9. As to Petitioner’s first and second arguments, we specifically addressed Petitioner’s argument that the proposed combination of Petersen-1 and Busam would meet the shear strength limitation of claim 12. Dec. 69–73. After reviewing the evidence and arguments presented by both parties, we agreed with Patent Owner’s position. As to Petitioner’s third argument, that we overlooked Busam’s disclosure of an overlapping loop basis weight range, that disclosure was never in dispute. Petitioner argues that “Patent Owner attempted to shift the focus of the Board to the unrelated issue of whether Busam explicitly discloses an anticipating example.” Req. Reh. 11. Petitioner seems to be implying that we applied an anticipation standard to its obviousness arguments, but we did not. Instead, our decision was based

on a lack of record evidence of obviousness. See, e.g., Dec. 72–73 (“Petitioner does not point us to any evidence that Busam’s female loop material is capable of engaging with a male fastening portion with a shear strength that was ‘reported to be greater than 500 grammes’ and has ‘a fiber basis weight in a range from 20 grams per square meter to 30 grams per square meter,’ as claim 12 requires.”). We also agreed with Patent Owner that the Petitioner had impermissibly relied on new obviousness theories in its Reply that were not presented in the Petitioner. Dec. 73 (“Petitioner does not explain why the arguments made in its Reply relating to claim 12 could not have been presented in the first instance in the Petition or how the arguments in the Reply are responsive to Patent Owner’s arguments in the Patent Owner Response”).

We are not persuaded by Petitioner’s arguments, which rehash arguments on these issues considered fully and rejected in our Final Written Decision, while failing to show that we misapprehended or misconstrued those arguments in reaching that conclusion.

In Section III of the Request for Rehearing, Petitioner argues against our determination that Petitioner’s Reply presented new theories of obviousness for claim 12. Req. Reh. 11.

In its Reply Brief, Petitioner argued:

Either the cited art necessarily discloses the claimed shear strength, because all other claimed structural features are met or it would have been within the level of POSITA to vary known parameters to arrive at the shear strength [of claim 12].

Pet. Reply 28.

According to Petitioner, its arguments in the Reply were not new.

Petitioner argues that its “unpatentability [arguments] with respect to claim 12 in Grounds 8 and 9 build on the unpatentability arguments (and supporting evidence) for claims 1, 10, and 11” (*id.*) and, thus, “Petitioner properly elaborated on its original obviousness theory” (*id.* at 13).

The difficulty with Petitioner’s argument is that none of claims 1, 10, and 11 recites any limitation on shear strength. With regard to claim 12, the only theory set forth in the Petition was that “[b]y combining the mechanical fastener of Petersen with the loop material disclosed by Busam, the resulting combination would cause ‘a shear strength of at least 2000 gram-force’, as specified by claim 12” and “[i]t would have been obvious to combine the disclosures of Petersen with those of Busam for at least the reasons [sic – discussed] above.” Pet. 72. We do not see how Petitioner’s arguments about optimizing the fastener of claims 1, 10, and 11 to obtain some unspecified, desired shear strength relate to Petitioner’s new arguments that it would have been desirable to vary parameters of the Petersen-Busam combination in order to obtain the specific shear strength recited in claim 12. Petitioner’s only argument in the Petition for claim 12 was that the combination of Petersen-1 and Busam would necessarily “cause” the resulting fastener to possess the claimed shear strength, an argument that we rejected as unsupported in the Final Written Decision. *See* Dec. 72–73 (“Petitioner does not point us to any evidence that Busam’s female loop material is capable of engaging with a male fastening portion with” the shear strength required by claim 12.)

In Section IV of the Request for Rehearing, Petitioner argues that its Reply argument discussed above was not new because it was responsive to

Patent Owner's argument in the Response. Req. Reh. 13–14. Yet, even if we were to agree with Petitioner that a portion of its Reply argument was responsive to Patent Owner's Response, that does not change our view that Petitioner's argument was not supported by the evidence for the reasons explained in the Final Written Decision. Dec. 72–73.

In Section V of the Request for Rehearing, Petitioner argues that the Board misapprehended original Ground 9 with respect to claim 12. Req. Reh. 14. Petitioner argues that, with respect to Ground 8, “the Board agreed that a POSITA would have found it obvious to optimize shear performance for an intended application.” *Id.* Petitioner argues that “Ground 9 relies in part on Daio-Seishi, which discloses shear performances in the claimed range, thereby demonstrating that such values were known in the art to be attainable for these types of fastening systems.” *Id.* (citing Pet. 74).

Petitioner's argument seems to imply, again, some logical inconsistency in the Final Written Decision because we agreed with Petitioner as to claims 11 and 14 under Ground 8, but not with respect to claim 12. We are not persuaded that we misapprehended Petitioner's original Ground 9 with respect to claim 12.

In the Final Written Decision, regarding Ground 8, the Board determined “that Petitioner has demonstrated by a preponderance of the evidence that claims 11 and 14 would have been obvious in view of Petersen-1 and Busam.” Dec. 68. That determination was made in the absence of any argument from Patent Owner specific to claims 11 and 14, as discussed above. In particular, as to claims 11 and 14, Patent Owner did not contest Petitioner's reliance on Busam as disclosing a loop material having a

fiber basis weight within the claimed range. As to claim 12, however, Patent Owner argued:

Busam does **not** disclose, and Petitioner[] fail[s] to show, that the sample fasteners for which the shear strength results were reported in Busam, in fact, used a loop material having a fiber basis weight in a range from 20–30 grams per square meter. The fiber basis weight of the loop material of the tested “selection of samples” in Busam could have been above or below this claimed range.

PO Resp. 59 (citing Ex. 2008 ¶ 116). We did not agree with Petitioner’s argument in response, namely Petitioner’s argument that Busam discloses a loop material having the claimed fiber basis weight after subtracting the basis weight of the adhesive from the preferred maximum basis weight of the female loop/adhesive combination. Pet. Reply 27. In other words, we did not agree with Petitioner’s position that Busam discloses a loop material having a fiber basis weight within the range of claim 12, in view of Patent Owner’s arguments and evidence presented specifically with respect to claim 12. With regard to Ground 9, in which Petitioner additionally relies on Daio-Seishi, we explained that:

similar to the deficiency identified by Patent Owner with respect to Busam, Petitioner does not point us to any evidence supporting a teaching in Daio-Seishi that the female loop material capable of engaging with a male fastening portion with a shear strength between ranges of 3,500 to 5,000 grams and 4,500 to 8,000 grams, respectively, was a female loop material having “a fiber basis weight in a range from 20 grams per square meter to 30 grams per square meter,” as claim 12 requires.

Dec. 76. In other words, Petitioner’s additional reliance on Daio-Seishi in Ground 9 as disclosing the claimed shear strength did not alter our

conclusion with regard to the fiber basis weight of the loop material in Busam.

In Section VI of the Request for Rehearing, Petitioner presents the same argument for Ground 9 as in Section IV regarding Ground 8. Req. Reh. 15 (“Petitioner’s Ground 9 reply argument was not new and was responsive to Patent Owner’s arguments for the same reasons as discussed above with respect to Petitioner’s Ground 8 reply argument”). We have already addressed those arguments above, and found them unpersuasive.

For the above reasons, we determine Petitioner has not carried its burden of showing that we misapprehended or overlooked any matter or that we abused our discretion in determining that Petitioner had failed to show by a preponderance of the evidence that claim 12 was unpatentable in view of Petersen-1 and Busam (Ground 8), or Petersen-1, Miller, and/or Daio Seishi, and Busam (Ground 9).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Request for Rehearing is *denied*.

IPR2020-00699
Patent 10,165,833 B2

FOR PETITIONER:

William Mandir
Raja Saliba
John Bird
SUGHRUE MION, PLLC
wmandir@sughrue.com
rsaliba@sughrue.com
jbird@sughrue.com

FOR PATENT OWNER:

Heidi Keefe
Joseph E. Van Tassel
COOLEY LLP
hkeefe@cooley.com
jvantassel@cooley.com