

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PRIME TIME TOYS LLC, PRIME TIME TOYS LTD., and EASEBON  
SERVICES LTD.,

Petitioner,

v.

SPIN MASTER, INC.,

Patent Owner.

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IPR2023-01339

Patent 8,640,683 B2

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Before HYUN J. JUNG, NEIL T. POWELL, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314

## I. INTRODUCTION

### A. *Background and Summary*

Petitioner, Prime Time Toys LLC, Prime Time Toys LTD., and Easebon Services LTD, requested that we institute an *inter partes* review challenging the patentability of claims 4–9, 12, and 14<sup>1</sup> (the “challenged claims”) of patent US 8,640,683 B2 (Ex. 1001, “the ’683 patent”). Paper 2 (“Pet.”). Patent Owner, Spin Master, Inc. (through its exclusive licensee, Hasbro Inc. (Paper 4, 2)), argued that Petitioner’s request is deficient and should not be granted. Paper 6. Petitioner also filed a Preliminary Reply (Paper 7), and Patent Owner filed a Preliminary Sur-reply (Paper 8).

In response, we denied institution of *inter partes* review. Paper 10 (“Decision Denying Institution”). The Director has now reversed and remanded our Decision Denying Institution. Paper 12 (“Remand Dec.”). Further, the Director ordered institution of *inter partes* review. *Id.* at 21.

Accordingly, we institute an *inter partes* review of the challenged claims.

### B. *Related Matters*

The parties identify that the ’683 patent is subject to an action in the United States International Trade Commission: *In the Matter of Certain Soft Projectile Launching Devices, Components Thereof, Ammunition, and Products Containing Same*, Investigation No. 337-TA-1325 (ITC) (“ITC proceeding”). Pet. 7; Paper 4, 2. The parties also identify that the ’683 patent has been involved in district court litigation and *inter partes* reviews which are no longer pending. Pet. 8; Paper 4, 2.

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<sup>1</sup> Claims 1–3 and 10–11 have been disclaimed. Ex. 2014.

*C. The '683 Patent*

The '683 patent is entitled, “Soft-Projectile Launching Device,” and is directed to a projectile launching device with ammunition made from super absorbent polymer (“SAP”). Ex. 1001, code (54), 1:12–16. SAPs are polymers that can absorb an extremely large amount of water relative to their own mass. *Id.* at 3:46–53.

The '683 patent describes using SAPs as ammunition in projectile launching devices to provide advantages compared to projectiles that were previously known, such as paint balls, plastics (e.g., as found in “airsoft” guns), and foams (e.g., as found in NERF® guns). *Id.* at 1:20–67, 3:58–4:3. For example, certain SAP projectiles have beneficial characteristics, in part because SAPs break down at different pressures based on their composition. *Id.* at 4:4–18. Hydrated SAP projectiles can be made to have sufficient cross-linking density such that they are projected from a projectile launching device without breaking apart. *Id.* at 4:19–21. At the same time, because hydrated SAP projectiles rupture when subjected to excessive pressure, such as when impacting a target after being launched from a projectile launcher, the force at impact is spread over a much wider surface area, thus reducing the likelihood of injury when the target is a person. *Id.* at 3:67–4:3, 4:21–24.

*D. Illustrative Claim*

All of the challenged claims depend from disclaimed claim 1, below:

1. A projectile launching system, comprising:

ammunition comprising a plurality of substantially spherical soft-projectiles formed from hydrated super absorbent polymer;  
and

a projectile launcher for launching the ammunition in free flight.

Ex. 1001, 9:39–43 (paragraphing added).

*E. Evidence*

Petitioner’s grounds of unpatentability rely on the following evidence:

| Name      | Non-Patent Document                                         | Exhibit                  |
|-----------|-------------------------------------------------------------|--------------------------|
| Spitballs | ThinkGeek Spitballs Internet Archive Webpage, Nov. 30, 2009 | 1002, 17–22 <sup>2</sup> |

| Name | Patent Document                               | Exhibit           |
|------|-----------------------------------------------|-------------------|
| Peev | Bulgarian Patent No. BG110343 (July 31, 2009) | 1003 <sup>3</sup> |

*F. Asserted Grounds*

Petitioner asserts the following grounds of unpatentability (Pet. 15), supported by the declarations of Joel Delman (Ex. 1016) and Dr. Mauren T.F. Reitman (Ex. 1017):

| Claim(s) Challenged          | 35 U.S.C. §         | Reference(s)/Basis |
|------------------------------|---------------------|--------------------|
| 4–9, 12, and 14 <sup>4</sup> | 103(a) <sup>5</sup> | Peev, Spitballs    |

## II. DISCUSSION

An *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). The Director

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<sup>2</sup> Exhibit 1002 includes a declaration from the Records Request Processor at the Internet Archive, as well as multiple copies of the Spitballs webpage and related category pages. Petitioner clarifies that it defines the prior art reference “Spitballs” as pages 17–22. Pet. 13–14.

<sup>3</sup> Includes an English language translation.

<sup>4</sup> Claims 1–3 and 10–11 have been disclaimed. Ex. 2014.

<sup>5</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. We refer to the pre-AIA version of § 103.

“determine[d] that Petitioner has shown a reasonable likelihood of prevailing in showing that at least one of the claims challenged . . . would have been obvious over Peev and Spitballs.” Remand Dec. 17. Additionally, having considered arguments from Patent Owner vying for discretionary denial of *inter partes* review, the Director “decline[d] to exercise . . . discretion under § 314(a) to deny institution of *inter partes* review.” *Id.* at 21. Accordingly, the Director “reverse[d] [our Decision Denying Institution] and remand[ed] to the Board to institute trial.” *Id.*

### III. CONCLUSION

For the reasons stated in the Director Review Decision (Paper 12), the Director has determined there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged.

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim or any underlying factual and legal issues.

### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 4–9, 12, and 14 of US 8,640,683 B2 is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of US 8,596,255 B2 shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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Patent 8,640,683 B2

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