

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SPIN MASTER, INC.,
Patent Owner.

Case IPR2023-01461
Patent 8,596,255

PATENT OWNER'S PRELIMINARY RESPONSE

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LIST OF EXHIBITS

EX2001-2006 RESERVED

EX2007 Initial Determination (Public Version), *Certain Soft Projectile Launching Devices, Components Thereof, Ammunition, and Products Containing Same*, Inv. No. 337-TA-1325 (ITC)

I. INTRODUCTION

Each of the Petition's Grounds 1 and 2 depends on a combination—the Peev-Spitballs combination—for which Petitioner provides no legally valid or factually credible motivation-to-combine. The stark flaws in Petitioner's motivation theory preclude a sustainable conclusion of obviousness.

That's why an Administrative Law Judge rejected the Peev-Spitballs combination in a parallel ITC investigation where Petitioner pursued an obviousness case against the '255 patent's predecessor based on the same arguments, experts, and evidence advanced in this Petition. The ALJ heard everything Petitioner had to say about the Peev-Spitballs combination—via briefing, oral argument, expert reports with supporting exhibits, deposition transcripts, and even live expert testimony—but it was not enough. *See, e.g.*, EX1004 (Hearing Tr.) at 71:7-92:6 (opening statement), 113:4-161:15 (direct examination of Petitioner's Mr. Delman), 161:22-243:17 (cross-examination of Mr. Delman); EX2007 (Initial Determination) at 71-77 (explaining the lack of motivation to combine Spitballs and Peev). And it's *still* not enough. The discussion below demonstrates why the ALJ was correct to find Petitioner's obviousness case wanting and why the Board should reach the same conclusion here, where Petitioner blatantly seeks to build the same record. *See* Pet. at *passim* (repeatedly citing EX1004, the transcript from the ITC hearing).

II. THE '255 PATENT

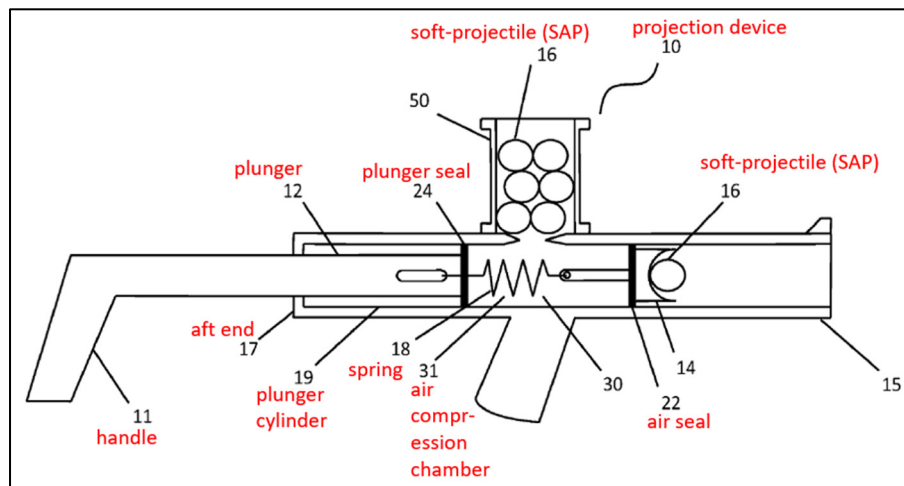
The '255 Patent claims innovative “soft-projectile launching devices that launch super absorbent polymer projectiles.” EX1001 ('255 Pat.) at 1:14-18.

At the time of the '255 Patent in 2010, the recreational projectile launcher market was dominated by foam-ammunition launchers, paintball guns, and airsoft guns. Each of these launcher types presented a distinct feature set that appealed to certain groups of enthusiasts and casual customers. And yet, despite their widespread commercial adoption, foam, paintball, and airsoft designs also had significant tradeoffs and drawbacks. *See, e.g.*, EX1001 at 1:23-2:3.

For example, “[o]ne reason [Hasbro’s] NERF® foam and other foam based projectile toys have become so popular has been due to the soft and light properties of the foam material,” which “can be formed into balls and darts and fired from toy weaponry with little risk of injury.” EX1001 at 1:40-51. But “[b]ecause foam based materials . . . are light, they are highly susceptible to air forces when trying to project them through the air in free flight as occurs when fired from toy weaponry.” *Id.* at 1:56-59; *see also id.* at 1:61-64 (“The low density of foam based projectiles . . . increases the effect of air resistance, drag, and other motion retarding forces.”). As for paintball and airsoft guns, while less susceptible to air forces, many of “these systems are for adult use only due to the energy imparted to the projectile and the ability of the projectile to do serious harm.” *Id.* at 1:66-2:3.

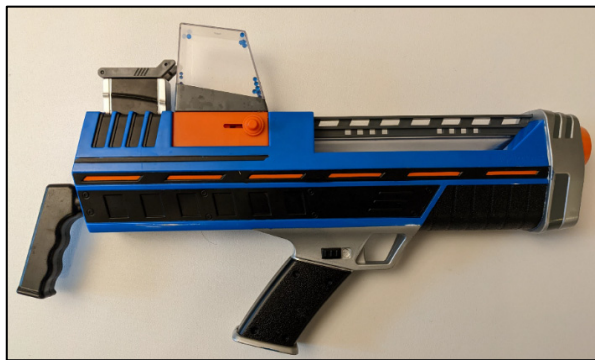
The '255 Patent's inventors sought "to provide an alternative soft-projectile launching system to those presently on the market," one that "increase[d] the user experience as compared to foam-based projectile toys, yet [also] remain[ed] safe for children to use." EX1001 at 2:9-11, 3:59-62. The inventors achieved this feat by creating a new type of projectile launcher that leverages the unique properties of super absorbent polymers ("SAPs"). SAPs are polymers that can absorb an extremely large amount of water relative to their own mass. *Id.* at 4:54-61. SAPs have been known since the 1960s and were primarily used in household items like diapers, protective underwear, and sanitary napkins. But SAPs had never before been formed as ammunition comprising a plurality of soft-projectiles configured for use with a projectile launcher in the specific ways claimed by the '255 Patent.

The '255 Patent's Figure 1 (annotated below) "illustrates . . . one embodiment of a projectile launching toy designed for use with a plurality of projectiles made from a super absorbent polymer." EX1001 at 4:6-8; *see also id.* at 6:47-7:41.

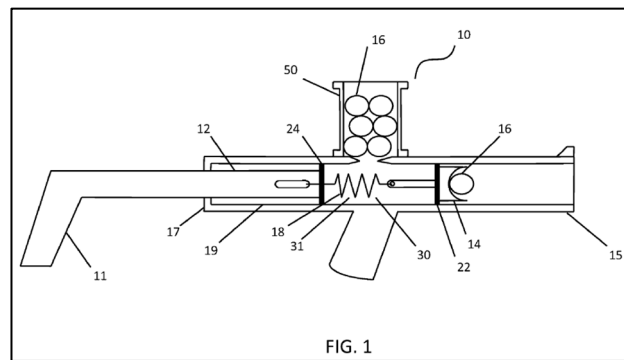


To begin the process, “a user pulls back on the handle 11 which retracts the plunger 12 out of the aft end 17 of a plunger cylinder 19.” *Id.* at 6:53-56. As shown, “[t]he plunger 12 is attached to spring 18.” *Id.* at 6:56-57. As the spring 18 is stretched, “air is sucked into an air compression chamber 31 located between plunger seal 24 and air seal 22.” *Id.* at 6:57-59. Then, “[w]hen the user releases the handle 12, the spring 18 quickly pulls the plunger 12 back inside the plunger cylinder 19,” which “creates a rapid increase in air pressure in the air compression chamber 31 between the plunger seal 24 and air seal 22.” *Id.* at 6:62-66. This air pressure causes “soft-projectile 16”—a SAP—to be “launched from the projection device 10 on a free trajectory.” *Id.* at 6:66-7:4.

The original patentee, Maya Group, implemented the '255 Patent's innovations in a line of blaster products called Xploderz (e.g., pictured below, left).



Xploderz XStormer 1000



'255 Patent at Figure 1

These patent-practicing Xploderz products enjoyed immense commercial success when they launched in 2011, and they were the recipient of widespread industry praise. *See* EX2007 (Initial Determination) at 82-96. The Xploderz received “best

toy” awards, sparked “an entirely new product segment” and became the “number one selling boy toy product for Target” when it launched, and enjoyed “sales over the life of the products [of] approximately \$50 million” with “multiple line extensions” placed at large retailers like Kmart, Target, Toys “R” Us, and Walmart.

Id. As the ALJ correctly found, the extensive success and praise of Xploderz supports patentability. *Id.*

III. THE PRIOR ART

A. The Spitballs Reference (EX1002)

The Spitballs reference includes what is purportedly a listing for a product called “Spit Balls” in the “Science Toys” department of an online store called ThinkGeek.com. *See* EX1002 at 15. According to the Spitballs reference, once grown in water, the Spit Balls polymer products “are slimy and squishy.” *Id.* at 15. “If you throw them gently, they will bounce. If you throw them hard enough, they will explode into mushy pieces.” Thus, the slogan: “grow ’em and throw ’em.” *Id.*

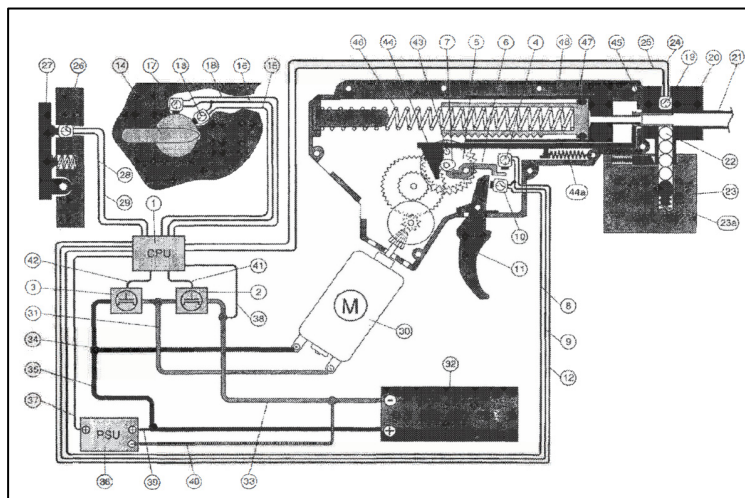


EX1002 at 15, 18.

At the parallel ITC hearing, Petitioner relied on several exhibits describing Spitballs, including from the DuneCraft and ThinkGeek websites. *See* EX1004 (Hearing Tr.) at 151:15-21 (Petitioner’s Mr. Delman discussing a DuneCraft webpage), 203:9-204:11 (Mr. Delman discussing a ThinkGeek webpage). Petitioner has submitted just a subset of the ThinkGeek evidence as the Spitballs reference in its Petition.

B. The Peev Reference (EX1003)

The Peev reference, titled “Air-Force Electric Rifle,” describes “an “electric airsoft gun [that] finds application in the sporting gun industry and is used for military simulations or training, or for entertainment in airsoft games.” EX1003 at 22. Peev explains that the purpose of “[e]lectric airsoft guns [is to] represent a copy of real firearms” and identifies its “task” as introducing improvements meant to make airsoft guns even more gun-like. *Id.* at 23-26.



Id. at 38 (Figure 1).

IV. PETITIONER CANNOT PREVAIL ON ANY CHALLENGED CLAIM

A. Petitioner Provides No Legitimate Reasons to Combine Spitballs with Peev

Petitioner's proffered motivation to combine Peev and Spitballs is that a skilled artisan:

(1) knew about the injury problem caused by airsoft guns (such as Peev), (2) knew one solution was to make the ammunition softer, (3) knew that there was prior art soft SAP ammunition available (Spit Balls) and few other alternatives, and (4) had the technical skill to combine this soft ammunition with Peev.

Pet. at 39. To be sure, *KSR* holds that a reference combination may be upheld “[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified predictable solutions.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). But Petitioner’s Peev-Spitballs combination does not fit the bill. *See* Pet. at 34-40.

For one, the fact that being shot with ammunition fired from an airsoft gun may cause an injury is not a “problem” with that type of gun. Firing hard ammunition at high speed is how airsoft guns are designed to work because their purpose is to provide a close but non-lethal facsimile to a real gun. The injury risk associated with being shot is a natural consequence, not a design “problem” with airsoft guns. Even if the injury risk were a known design problem with some airsoft

guns, Petitioner fails to establish that it applies specifically to Peev’s design and, equally important, that SAP ammunition would be curative. The ALJ exposed this infirmity in Petitioner’s case in the ITC investigation. What’s more, Petitioner skips a critical step in *KSR*’s problem-solution analysis—Petitioner provides no credible evidence at all that SAP ammunition was an “identified” solution to an injury risk problem with airsoft guns.

These fundamental errors preclude a finding that Petitioner is reasonably likely to prevail in this proceeding based on the Peev-Spitballs combination.

1. The injury risk associated with airsoft guns is not a design “problem” applicable to Peev

Everyone agrees that Peev discloses an airsoft gun and that airsoft guns are typically designed to replicate real guns. Mr. Delman’s declaration and the evidence he relies on says so. *See* EX1016 (Delman Dec.) ¶ 75 (explaining that “Peev discloses an airsoft gun” and quoting from EX1005); EX1005 at 3 (“They [airsoft guns] look and behave exactly [l]ike real guns so that it feels like you’re firing a real gun.”). Patent Owner’s expert, Dr. Kudrowitz testified to the same. *See* EX1004 (ITC Hearing Tr.) at 364:22-365:4 (Dr. Kudrowitz describing Peev as an airsoft gun), 366:20-25 (“The intent [of an airsoft gun] is to be like a real gun.”). And Peev says it, too. EX1003 (Peev) at 23 (“Electronic airsoft guns represent a copy of real firearms.”).

In fact, Peev's stated "task" is to make airsoft guns even more gun-like:

The task of the invention is to create an electric airsoft gun that provides improved operational performance, as well as bringing the way of functioning and manipulation of the electric airsoft gun *as close as possible to* the way of functioning and manipulation of *the real firearm*.

EX1003 (Peev) at 26 (summarizing problems in older prior art that "make[] handling electric airsoft guns quite different from handling real firearms"). A skilled artisan looking to improve upon Peev's airsoft gun, which is designed to be "as close as possible to . . . [a] real firearm," (*id.*), would not have been concerned with reducing the injury risk associated with being shot by the hard plastic ammunition. Both parties' experts provided testimony to this effect at the hearing before the ALJ.

For example, when asked on cross-examination whether "the fact that an Airsoft gun could do serious harm was a problem," Patent Owner's Dr. Kudrowitz said, "No, I think what this is saying here is that Airsoft guns or some Airsoft guns and paintball guns can do harm, and that's why they're for adults." EX1004 (ITC Hearing Tr.) at 439:10-15. Petitioner's Mr. Delman also explained that the injury risk associated with airsoft guns has never been problematic from his perspective. Mr. Delman has used airsoft guns extensively and supervised his sons using them. *See id.* at 229:15-17. Critically, though, he has "*never been worried* about" his sons being injured by the hard ammunition of an airsoft gun. *Id.* at 231:11-232:15.

In an effort to mimic real firearms, many airsoft guns are specifically designed to fire hard ammunition at high speeds. This is a feature, not a bug, because “[t]he intent is to be like a real gun” for use in “hunting . . . [or] target practice.” *See* EX1004 (ITC Hearing Tr.) at 366:23-367:15 (Dr. Kudrowitz testifying). Stated differently, if the design goal was to create a projectile launcher without injury risk, a skilled artisan would not have started with an airsoft gun like Peev’s. The ALJ recognized this flaw in Petitioner’s Peev-Spitballs combination and credited Patent Owner’s expert, Dr. Kudrowitz, who pointed it out:

First, *KSR* assumes a starting reference point or points in the art, prior to the time of invention, from which one of ordinary skill in the art might identify a problem and pursue potential solutions. Here, it is not clear from the record that a person of ordinary skill would even likely start with an airsoft gun (or reference). For example, Complainants’ expert, Dr. Kudrowitz, provided the following testimony during the Hearing:

From how I understand this, Mr. Delman says that these claims are not valid and it would be obvious based on combining two patents related to Airsoft *guns*, Peev and Nagayoshi, with two science *toys* [Spit Balls and Clear Spheres]. And I don’t agree with that obviousness assessment. Peev and Nagayoshi are both about taking Airsoft guns and trying to make them *more* like real firearms. And if you put SAP in Airsoft guns, it makes them *less* like Airsoft guns.

(Tr. (Kudrowitz) at 455:22-456:5 (emphases added)).

See EX2007 (Initial Determination) at 71 (highlighting added).

2. Petitioner fails to establish that SAP ammunition would reduce the injury risk of Peev’s airsoft gun

Yet another problem with Petitioner’s case-in-chief is that it fails to establish how SAP ammunition would reduce a specific injury risk associated with Peev’s airsoft gun, which Petitioner repeatedly characterizes as a “toy.” *See* Pet. at 4, 40,

48. Specifically, the Petition identifies injuries such as “penetration of skin and bone” that do not apply universally to all airsoft guns. *See id.* at 35-36. According to the Petition, these types of injuries occur with muzzle velocities¹ at above the 300-400 foot per second (fps) range, (*see id.*), but everyone agrees that some airsoft guns have much lower velocities. For example, Petitioner’s Mr. Delman testified that a certain “low-powered” airsoft gun called the “Daisy AirStrike 470”—which he considers to be a “toy”—“operates similarly to [] Peev” and has “a muzzle velocity of about 160 feet per second”:

Q. The AirStrike 470 is the one Daisy product that you tested, right?

A. Yes.

Q. And you agree that the Daisy AirStrike 470 is a low-powered airsoft rifle, correct?

A. Correct. I believe it has a muzzle velocity of about 160 feet per second.

Q. Correct. And you would consider the Daisy AirStrike 470 to be a type of airsoft gun that would be considered a toy for children, right?

A. Yes.

Q. And it's your opinion that the Daisy AirStrike 470 operates similarly to the Peev and Nagayoshi references, correct?

A. Yes.

See EX1004 (ITC Hearing Tr.) at 213:21-214:10 (highlighting added).

¹ Muzzle velocity is the speed at which the ammunition exits the gun’s muzzle. *See* EX1004 (ITC Hearing Tr.) at 372:7-8.

To the extent Petitioner and Mr. Delman view Peev's airsoft gun as a youth-focused "toy," it would fall into the low-powered category of such devices. *See* EX1004 (ITC Hearing Tr.) at 368:7-14 (Dr. Kudrowitz, with reference to Mr. Delman's expert report, explaining the distinction between adult airsoft guns and youth-focused airsoft guns with lower muzzle velocities); EX2007 (Initial Determination) at 73 n34 (noting the same). Such a "lower-powered" airsoft gun, however, has a muzzle velocity "that's half, or less than half, of the velocity that breaks the skin." *Id.* at 370:2-7. Consequently, Peev's airsoft gun—to the extent it is a "toy," as Petitioner would have it—lacks a skin-breakage problem. And as Dr. Kudrowitz put it: "what's the motivation if they already don't break the skin"? *Id.* at 369:18-370:1; *see also* EX2007 (Initial Determination) at 72-73 (the ALJ crediting Dr. Kudrowitz and explaining that Petitioner's "contention that one of ordinary skill would be motivated to combine the teachings of Peev[] with another ammunition type for 'skin breakage' safety reasons, or to prevent skin breakage, rings hollow").

Petitioner, of course, knew before filing its Petition that characterizing Peev as a "toy" undermined its *KSR* problem-solution rationale. But rather than producing credible evidence to establish that a low-powered airsoft gun in the 160 fps range would actually cause significant injuries, Petitioner instead tried to improve its position by characterizing Dr. Kudrowitz's cross-examination testimony as a

pertinent admission on this point. *See* Pet. at 36-37 (“He admitted that there would still be a risk of bruises, black and blue marks, welts, and eye injuries.”). Not so. Petitioner mischaracterized Dr. Kudrowitz in three respects.

First, Petitioner omits the important fact that Dr. Kudrowitz’s cited cross-examination testimony is limited to the context of a report by Petitioner’s Mr. Delman showing injuries associated with muzzle velocities in the 350 fps range,² much higher than that of the youth-focused airsoft gun that Mr. Delman called a “toy.” In this context, what Dr. Kudrowitz said about bruising and welts is no admission at all. Dr. Kudrowitz was merely analyzing Mr. Delman’s report, which, like his current declaration here in this proceeding, gave no indication of whether bruises or welts would occur under 350 fps.

² On direct, Dr. Kudrowitz referenced a demonstrative slide summarizing Mr. Delman’s report, and the cross-examination testimony the Petition cites is about that same slide. *See* EX1004 (ITC Hearing Tr.) at 368:7-16 (Dr. Kudrowitz testifying on direct that “slide 29” illustrates how “Mr. Delman’s report” shows “penetration of skin” at “over 350 feet per second), 532:24-533:13 (Dr. Kudrowitz explaining on cross that his testimony regarding injuries is simply “what I’m getting from [Mr. Delman’s] sources”).

Second, Petitioner downplays the nature of the question Dr. Kudrowitz was asked: “Are you saying that a muzzle velocity below 350 feet per second, there’s *no chance* of injury?” Pet. at 36-37; EX1004 (ITC Hearing Tr.) at 441:14-16. Of course Dr. Kudrowitz could not say that bruising or welts are impossible. He had not seen any evidence one way or the other. Again, Mr. Delman did not address those types of injuries in the ITC investigation. Nor does he address them now.

Third, Dr. Kudrowitz’s statements that minor injuries like bruising and welts might possibly occur at “a muzzle velocity below 350 feet per second,” (Pet. at 36-37), do not mean these types of injuries would occur at the drastically lower velocity (e.g., 160 fps) of a youth-focused airsoft gun. No evidence to that effect exists on this record, not even in Mr. Delman’s declaration. *See generally* EX1016 (Delman Dec.) ¶¶ 75-81; *see also* EX2007 (Initial Determination) at 74 (the ALJ summarizing that Petitioner “presented no evidence that []Spit Balls’ teachings would be any ‘safer’ at that [lower muzzle] speed”).

The only other potential ammunition-related injury the Petition identifies is “damage to the human eye.” Pet. at 35. But this path is a dead end, too. Here again, Petitioner has an evidence problem. The record is devoid of any evidence that soft SAP ammunition would prevent eye injuries. Even Petitioner’s paid expert, Mr. Delman, is silent on this point. *See generally* EX1016 (Delman Dec.) ¶¶ 75-81. No surprise. After all, by the time Petitioner filed its Petition, Mr. Delman had already

admitted that the answer to preventing eye injuries with airsoft guns—regardless of ammunition type—is protective eyewear. *See* EX1004 (ITC Hearing Tr.) at 214:14-23, 216:20-218:8 (“I believe that most ***any projectile*** launched at somebody else can pose a risk of an eye injury.”). The ALJ said it best:

Respondents did not provide any evidence that shooting SAP projectiles instead of plastic airsoft ammunition would reduce the risk of eye injury. Indeed, Mr. Delman acknowledged that persons familiar with airsoft guns would have recognized that it is unsafe to use airsoft guns without protective eyewear. (Tr. (Delman) at 280:14-23.). Respondents also failed to explain why SAP ammunition would reduce the risk of eye injury compared to airsoft ammunition, if persons using airsoft guns are already wearing protective eyewear. Even if airsoft users were not wearing protective eyewear, there is no evidence that SAP ammunition would provide a safety improvement: the Accused Products themselves include protective eyewear and legal disclaimers that recommends the use of protective eyewear. (Tr. (Delman) at 283:9-21; CX-0323.0003 (Nebula Pro Instructions stating that, in all caps, “EYE PROTECTION SHOULD BE WORN DURING PLAY, WHETHER SHOOTING OR OBSERVING”).).

EX2007 (Initial Determination) at 72 (highlighting added).

To sum up, Petitioner intentionally characterized Peev’s airsoft gun as a “toy” because it knew Dr. Kudrowitz would testify, as the ALJ has now credited, that using soft SAP ammunition would “destroy the basic purpose of [a high-powered, adult] airsoft gun.” EX2007 (Initial Determination) at 74-76. But trying to plug that hole sprung a different leak in Petitioner’s case. Petitioner has no evidence that a youth-focused (or “toy”) airsoft gun would cause skin breakage or even lesser body injuries to someone who is shot. Petitioner also has no evidence that SAP ammunition would

prevent eye injuries to someone who is shot. Without these critical facts, Petitioner's problem-solution rationale cannot prevail, just as the ALJ recently determined. *See* EX2007 (Initial Determination) at 74 ("In sum, Respondents failed to meet their burden . . ."), 77 ("None of the cited articles or reports teach or suggest that using an alternative, softer ammunition would alleviate safety concerns with airsoft guns.").

3. Even if SAP ammunition could solve Petitioner's alleged injury risk "problem," it was not an "identified" solution

According to Petitioner, a skilled artisan would have known that softer ammunition could reduce airsoft gun injuries, and "Spitballs were softer projectiles." *See* Pet. at 37-38. But even if using the Spit Balls polymer products as ammunition would have solved a legitimate injury risk problem with Peev's airsoft gun (which Petitioner has not shown), that alone is not conclusive under the *KSR* problem-solution rubric that Petitioner invokes. *See* Pet. at 34. To sustain Petitioner's Peev-Spitballs combination, the Spit Balls polymer products must have been counted among the "identified" prior art solutions to an injury risk problem. *See KSR*, 550 U.S. at 421 ("a finite number of *identified* predictable solutions"). As before, Petitioner is short on evidence here, too.

Specifically, Petitioner lacks record evidence that soft polymer spheres like those described in Spitballs were used in the prior art as ammunition for any type of projectile launcher that even remotely resembles Peev's electric airsoft gun. While

Petitioner says “soft plastics, such as SAPs” were known ammunition options, it provides no credible evidentiary support. Pet. at 38. The only potential backstop for Petitioner’s claim is Mr. Delman’s declaration, which merits no weight because it merely parrots back the same conclusory sentence from the Petition without corroboration. *See* EX1016 (Delman Dec.) ¶ 77; *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential) (“[T]he cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.”). Besides, even if the Board were to credit Mr. Delman, all he says is that “a POSITA *could have* considered,” (EX1016 ¶ 77), SAPs as an ammunition option for an airsoft gun, which falls beneath the legal standard. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.” (original emphasis)).

Spitballs repeatedly instructs users to “throw,” “chuck,” and “fl[i]ng” the Spit Balls polymer products that Petitioner says are SAPs. *See* EX1002 (Spitballs) at 15, 18. Spitballs also discloses the product packaging for the Spit Balls polymer products, which features a cartoon of a child using a cylindrical tube to shoot a projectile. *Id.* at 18. As is clear from the packaging, the purpose of the cartoon

spitball is to accentuate the product name—“Spit Balls.” The name and the concomitant cartoon are part of a marketing ploy that promotes the product as a novelty item mimicking the classic spitball prank made from a wad of paper wetted by human spit. The cartoon is fictional and obviously not a representation of the Spit Balls polymer products, which have no connection to human spit. Regardless, even the most charitable interpretation of Spitballs for Petitioner (which Patent Owner does not concede) is that it teaches blowing the Spit Balls polymer products through a tube. Critically, though, Spitballs does not teach or suggest using the Spit Balls polymer products as ammunition for a gun-like launcher analogous to Peev’s airsoft gun. Petitioner does not argue otherwise.

In the end, Petitioner falls short on both sides of its problem-solution rationale. Just as Petitioner fails to establish an injury risk “problem” with Peev’s airsoft gun, Petitioner also has nothing beyond its conclusory allegations to show that the polymer products in Spitballs were an “identified” solution to such a problem.

4. Petitioner’s alternative motivation theories also fail

Petitioner posits two alternative theories at the tail end of its motivation discussion; each are easily dispelled.

First, Petitioner suggests that the Peev-Spitballs combination can be sustained merely because the two references “are in the same field of endeavor.” Pet. at 39-40. But this argument is unsound both legally and factually. The mere existence of

two references in one field does not explain **why** a skilled artisan would have combined them. *See TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016) (it is necessary to explain “**why** the references would be combined”). The *Tyco* decision Petitioner cites does not relieve its burden to answer the **why** question at the heart of any motivation-to-combine inquiry. *See* Pet. at 39-40. In *Tyco*, the Court simply observed that the art references in question shared “a common field of endeavor” as part of its rationale for rejecting the patent owner’s rebuttal argument about the combination being unworkable. *See Tyco Healthcare Grp. LP v. Ethicon Endo-Surgery, Inc.*, 774 F.3d 968, 978 (Fed. Cir. 2014). This case does not lower the bar on obviousness.

Petitioner is likewise wrong on the facts. Spitballs is directed to a science **toy** and Peev describes an airsoft **gun** that mimics a real firearm. *See* EX1002 (Spitballs) at 15 (“Geek Toys” and “Science Toys”); EX1003 (Peev) at 26 (“The task of the invention is to create an electric airsoft gun[.]”). These references are **not** in the same field, which is confirmed by Dr. Kudrowitz’s testimony that the ALJ credited.

From how I understand this, Mr. Delman says that these claims are not valid and it would be obvious based on combining two patents related to Airsoft **guns**, Peev and Nagayoshi, with two science **toys** [Spit Balls and Clear Spheres]. And I don’t agree with that obviousness assessment. Peev and Nagayoshi are both about taking Airsoft guns and trying to make them **more** like real firearms. And if you put SAP in Airsoft guns, it makes them **less** like Airsoft guns.

(Tr. (Kudrowitz) at 455:22-456:5 (emphases added).).

EX2007 (Initial Determination) at 71.

Second, Petitioner provides a one-sentence allegation that the Peev-Spitballs combination is merely “a simple substitution” of known elements. Pet. at 40. But here, too, Petitioner relies on a distorted view of the law. *KSR*’s discussion of a “simple substitution” is in the context of repurposing “prior art elements according to their *established functions*.” *KSR*, 550 U.S. at 417. As discussed (*supra*, § IV.A.3), Petitioner has not presented any credible evidence that ammunition for an airsoft gun was an “established function” of a polymer product like the one in Spitballs. See *AviaGames, Inc. v. Skillz Platform, Inc.*, IPR2022-00531, Paper 13 at 24 (PTAB Aug. 4, 2022) (denying institution and rejecting a petitioner’s over-reliance on “*KSR* buzzwords”).

V. CONCLUSION

For all the foregoing reasons, the Petition is fatally deficient. Patent Owner, therefore, requests that the Board decline to institute *inter partes* review.

Respectfully submitted,

Date: January 17, 2024

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Preliminary Response to Petition totals 4,062 which is less than the 14,000 allowed under C.F.R. § 42.24(b)(1).

Respectfully submitted,

Date: January 17, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on January 17, 2024, complete and entire copy of this Patent Owner's Preliminary Response and its supporting exhibit were provided via email to the Petitioner by serving the correspondence address of record as follows:

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