

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DAVID'S BRIDAL, INC.,  
Petitioner,

v.

JENNY YOO COLLECTION, INC.,  
Patent Owner.

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Case PGR2016-00041  
Patent D744,723

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Before KEN B. BARRETT, JENNIFER S. BISK, and TRENTON A. WARD,  
*Administrative Patent Judges.*

BISK, *Administrative Patent Judge.*

DECISION  
Denying Request for Rehearing  
*37 C.F.R. § 42.71(d)*

## SUMMARY

Petitioner, David's Bridal, Inc., requests rehearing of the Board's decision (Paper 11) ("Institution Decision"), entered February 22, 2017, denying institution of *inter partes* review of the sole claim of U.S. Patent D744,723 (Ex. 1002) ("the '723 patent"). Paper 12 ("Reh'g Req."). For the reasons that follow, Petitioner's request is *granted* to the extent that we address Petitioner's "acquiescence argument," but *denied* in all other respects.

## DISCUSSION

The applicable standard for granting a request for rehearing is abuse of discretion. The requirements are set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

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.

Petitioner argues that the Board: (1) "misapprehended and overlooked Petitioner's acquiescence arguments" (Reh'g Req. 1, 3, 4–8); and (2) "misapprehended relevant law and overlooked Petitioner's arguments regarding the written description of the claimed invention in Patent Owner's original application" (*id.* at 1, 3, 8–15).

### A. Acquiescence

Petitioner argues that after the Examiner's restriction requirement, Patent Owner "could fairly infer it had to temporarily abandon its attempt to get a design patent on the long dress and that, if it wanted a patent for the long dress, additional

drawings had to be added to any new application because those submitted with the original application were not enabling.” Reh’g Req. 5. According to Petitioner, by filing a divisional application, rather than arguing against the restriction requirement and the Examiner’s finding that the initial drawings did not satisfy the written description requirement, Patent Owner implied consent to the Examiner’s findings and is now unable to argue that issue. *Id.* at 4–8 (citing *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1440 (Fed. Cir. 1984); *Premium Sales Network, LLC v. Masterspas, Inc.*, 2016 WL 7325478 (M.D. Fla. Dec. 15, 2016)). Petitioner contends that we overlooked this argument in the Petition pointing to two sentences (Reh’g Req. 6) stating:

A key point in determining whether the ‘723 Patent is entitled to claim priority back to the ‘120 Patent is [Patent Owner’s] acquiescence to the examiner’s finding of nonenablement as demonstrated by a lack of argument and the submission of new drawings intended to cure the problem going forward. This weighs heavily towards a finding that the priority claim [is] ineffective because [Patent Owner] started with a nonenabling disclosure and then added new material to bring the application into compliance with the enablement standard.

Pet. 15.

Petitioner is correct that we did not address these sentences in the Institution Decision. *See generally* Inst. Dec. Although Petitioner failed to cite any supporting authority for this argument in its Petition, Petitioner augments its acquiescence argument in its Request for Rehearing by making clear that it is relying on *Litton* as barring Patent Owner from arguing that the written description could be satisfied by the drawings as originally presented. Reh’g Req. 6–7. In *Litton*, the only binding authority cited to by Petitioner, the Federal Circuit found that applicant “in response to a PTO requirement, voluntarily turned its Rule 60 continuation application into a C-

I-P application” noting that “[w]e are cognizant, however, of no reason for Litton to file a C-I-P application unless it thought it was ‘adding matter not disclosed’ in its parent application.” *Litton*, 728 F.2d at 1438. This occurred after an interview with the patent examiners that was documented with “a perfunctory paper, which Litton admitted during oral argument, said virtually nothing.” *Id.* at 1439. The Federal Circuit noted that at the time of prosecution, the MPEP required “[t]he substance of an interview must always be made [by the applicant] of record in the application, particularly where agreement between attorney and the Examiner is reached.” *Id.* The Examiner’s action in *Litton* was an “unambiguous rejection under section 112 that gave the applicant an opportunity to appeal to the Board or concede the lack of entitlement to the original filing date for the new matter in question.” *Waldemar Link v. Osteonics Corp.*, 32 F.3d 556, 559 (Fed. Cir. 1994). Accordingly, the court held that “[a]s a result of Litton’s own failure to document the results of its interview with the patent examiners, Litton is now estopped from showing that the prosecution record is not true and that what Litton then called a C-I-P in response to a new matter rejection does not contain new matter.” *Litton* at 1439.

Petitioner fails to establish, however, that this holding has been expanded by the Federal Circuit to apply to filing a divisional in response to a restriction requirement. In fact, the Federal Circuit, in discussing the *Litton* holding, held “[e]stoppel does not occur . . . in the absence of an explicit final rejection under 35 U.S.C. § 112, first paragraph.”<sup>1</sup> *Waldemar*,

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<sup>1</sup> Although Petitioner does not address *Waldemar*, Petitioner does state, in a footnote, that “[a] rejection need not ‘take the technical form of a final rejection under PTO regulations’ to create *prima facie* estoppel. *Advanced Video Techs.*

32 F.3d at 559 (citing *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659 (Fed. Cir. 1986) *cert. denied*, 480 U.S. 933 (1987)); *accord Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1065 (Fed. Cir. 2016) (distinguishing *Litton* and stating that “[a] review of the prosecution history in each case is necessarily context-specific”). According to the court in *Waldemar*, no estoppel attached, in part, because the issue could not have been appealed. *Id.*; *accord Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 663 (Fed. Cir. 1986).

The Request for Rehearing contends, with no citation to authority, “the restriction requirement entered was the functional equivalent of a § 112 rejection when coupled with the examiner’s conclusions regarding enablement and indefiniteness” and “[w]hen the patent owner submitted the new matter, it acquiesced to the examiner’s statements.” *Id.* at 7. Thus, Petitioner urges us to extend *Litton*’s estoppel to a divisional filed in response to a restriction requirement. Petitioner fails to identify anything in the case law to justify such extension.

Accordingly, we are not persuaded, even considering Petitioner’s augmented acquiescence argument in its Request for Rehearing, that Patent Owner is unable to argue written description support solely based on its action, during prosecution, of filing a divisional application with additional

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*LLC v. HTC Corp.*, No. 11 CIV. 6604 CM, 2013 WL 6017923, at \*8 (S.D.N.Y. Nov. 7, 2013).” Reh’g Req. 7, n.1. This citation, to nonbinding authority, is not persuasive. Moreover, Petitioner does not address *Advanced Video*’s sentence, in the paragraph immediately following the quoted language, stating that “the Court has been unable to locate any cases in which anything other than a CIP application has been used as the basis for estoppel.”

drawings in response to the Examiner's restriction requirement.

*B. Written Description*

Petitioner also argues that “the Board misapprehended that a single figure of an embodiment may satisfy the written description requirement in the context of a design patent.” Reh’g Req. 8–10. From Petitioner’s explanation, however, it is clear that this is merely a rearguing of its contentions from the Petition that “the original application did not contain sufficient views for enablement.” *Id.* We addressed this argument in our Institution Decision. *See* Inst. Dec. 12–18.

Petitioner also contends that we “misapprehended *Ex Parte Asano* which condoned ‘correct[ing] minor drafting errors,’ not the intentional and wholesale substitution of new figures.” Reh’g Req. 11. According to Petitioner, the Petition “correctly explained why *In Re Owens*, 710 F.3d 1362 (Fed. Cir. 2013), applied here (a case of intentional conduct).” *Id.* (citing Pet. 10–13). We are not persuaded that we misapprehended *Ex Parte Asano* or incorrectly applied *In Re Owens* and, accordingly, we decline to modify the Institution Decision. *See* Inst. Dec. 12–18.

Finally, Petitioner argues that we overlooked its argument that in “Figs. 2 and 3 of the ‘723 Patent, ‘the panels splay apart at a lower rate with decreasing height” than Figs. 3 and 2 of the ‘120 Patent.” Reh’g Req. 12 (citing Pet. 13). Again, this appears to be Petitioner supplementing its argument, from the Petition, that the figures added to the ‘723 patent were necessary to overcome the Examiner’s finding of nonenablement. We addressed this argument in our Institution Decision, including explicitly quoting parts of Petitioner’s arguments on page 13 of the Petition. *See* Inst. Dec. 15. We are not persuaded of error in our decision by Petitioner’s emphasis of its assertion that the panels of the claimed

dress splay at different rates in the shorter and longer dress. As noted in the Institution Decision, we do not agree with Petitioner's assertion that the Figures of the '723 patent "add additional elements" or "views." *Id.*

*C. Conclusion*

For the foregoing reasons, Petitioner's Request for Rehearing is *granted* to the extent that we have reconsidered our Institution Decision in light of Petitioner's acquiescence argument and otherwise *denied* because we see no basis for changing that Decision.

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