

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEOSALES CORP LP,
Petitioner,

v.

ALLAN WENDLING,
Patent Owner.

PGR2021-00058
Patent 10,806,285 B2

Before GRACE KARAFFA OBERMANN, KRISTINA M. KALAN, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

DERRICK, *Administrative Patent Judge*.

DECISION
Denying Institution of Post Grant Review
35 U.S.C. § 324

I. INTRODUCTION

Petitioner Neosales Corp LP filed a Petition requesting institution of a post grant review of claims 1–9 (“the challenged claims”) of U.S. Patent No. 10,806,285 B2 (Ex. 1001, “the ’285 patent”). Paper 1 (“Pet.”). Patent Owner Allan Wendling did not file a Preliminary Response to the Petition.

We have authority to determine whether to institute a post grant review. *See* 35 U.S.C. § 324. The standard set forth in 35 U.S.C. § 324(a) requires Petitioner to demonstrate that it is more likely than not that at least one challenged patent claim is unpatentable. Petitioner has not met that standard and, accordingly, we do not institute a post grant review.

A. Real Parties-in-Interest

Petitioner Neosales Corp LP identifies Neosales Corp LP and its owners Andrii Gurinenko and Andriy Lagun as the real parties in interest. Pet. 6. Patent Owner Allan Wendling identifies himself as the real party in interest. Paper 4, 2. The parties do not raise any issues about real parties-in-interest.

B. Related Proceedings

The parties do not identify any judicial or administrative matter involving the ’285 patent. Pet. 6; Paper 4, 2. Patent Owner does, however, identify two pending applications that claim priority to applications that the ’285 patent claims the benefit of priority: U.S. Application Nos. 17/071,783 and 17/191,883. Paper 4, 2.

C. The ’285 Patent (Ex. 1001)

The ’285 patent is titled “Apparatus to Prevent Curling of a Rug Corner” and issued on October 20, 2020, from U.S. Application No. 16/454,560, filed on June 27, 2019. Ex. 1001, codes (21), (22), (45), (54). The ’285 patent is a continuation of U.S. Application No. 15/196,139, filed

on June 29, 2016, which is a continuation-in-part of U.S. Application No. 14/730,849, filed on June 4, 2015, which is a continuation-in-part of U.S. Application No. 14/542,774, filed on November 17, 2014. *Id.* at code (63), 1:7–12.

The '285 patent is directed to an apparatus to prevent curling of a rug corner. Ex. 1001, code (57). The challenged claims require the apparatus to have a rigid and planar body having a planar top and planar bottom, an adhesive layer applied to at least a portion of the top of the body, covered by a removable protective cover, and a sticky polyurethane gel layer having a first surface attached or laminated to the planar bottom of the body. Ex. 1001, 3:2–21 (claim 1), 3:27–4:7 (claim 4), 4:13–32 (claim 7).

Figure 3 is reproduced below:

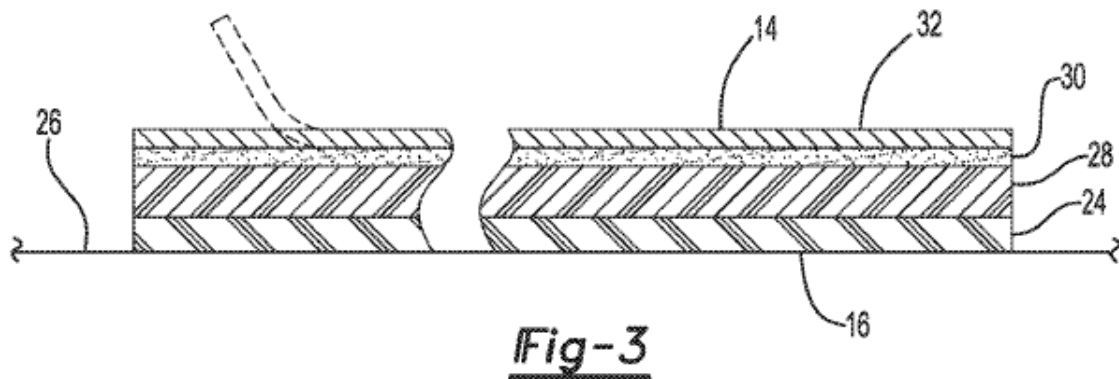
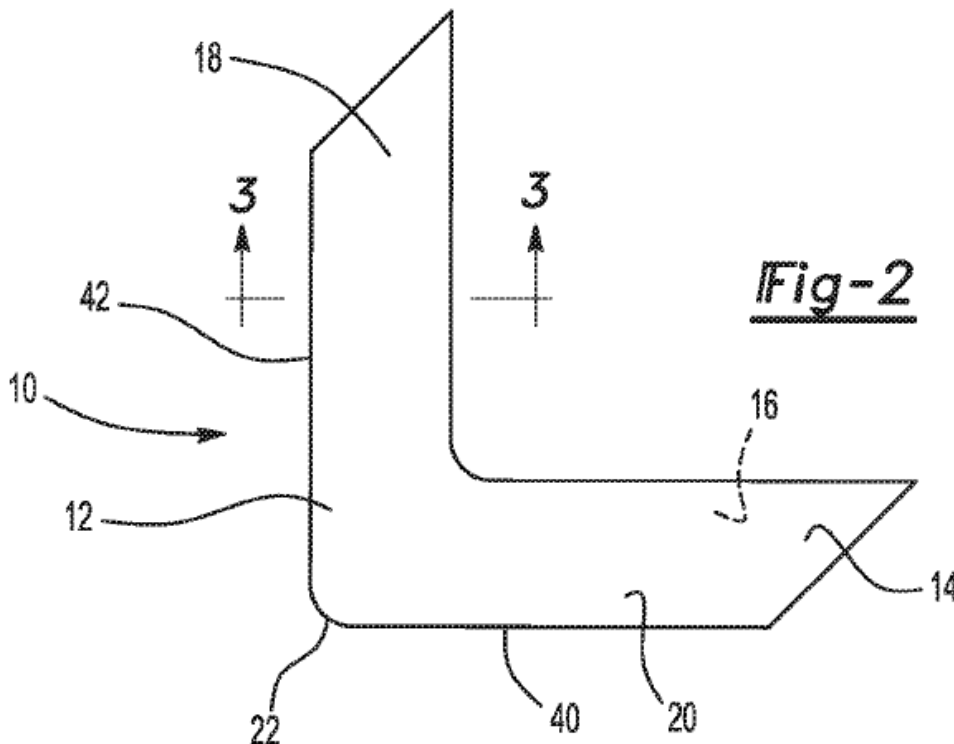


Figure 3 illustrates the layered arrangement of the claimed apparatus, as positioned on floor surface 26, with elastomeric layer 24, plastic layer 28 that maintains the body in rigid planar form, adhesive layer 30, and, covering adhesive layer 30, protective cover 32. *Id.* at 2:16–43, Fig. 3 (depicting sectional side view of apparatus). Elastomeric layer 24 is set forth as preferably “compris[ing] a sticky gel (polyurethane gel) covered by a removable backing.” *Id.* at 2:28–30; *see also id.* at 2:34 (“Alternatively, the bottom layer 24 is made of a sticky gel.”). The '285 patent explains that

“[t]he sticky gel adheres to the floor to prevent slippage, but without marring or otherwise damaging the floor surface.” *Id.* at 2:35–36. Figure 3 further depicts the top 14 and the bottom 16 of the apparatus. *Id.* at 2:1–2, Fig. 3.

The '285 patent specification describes a particular, preferred embodiment as depicted in Figures 1–3. *Id.* at 1:66–2:4, 2:9–11. We reproduce Figure 2 below.



Ex. 1001, Fig. 2. As depicted in Figure 2 and described in the specification, the device includes V-shaped body 12 having two elongated legs 18 and 20 that intersect together generally perpendicularly, and rounded nose 22. *Id.* at 2:9–15, Fig. 2. As discussed in our analysis below, however, the challenged claims do not specify a V-shaped body.

D. Claimed Subject Matter

Claims 1, 4, and 7—all independent claims—are reproduced below:

1. Apparatus to prevent curling of a rug corner away from a floor surface, the apparatus comprising:
 - a rigid and planar body having a planar top and planar bottom,
 - an adhesive layer applied to at least a portion of said top of said body,
 - a removable protective cover provided over said adhesive layer, and
 - a sticky polyurethane gel layer that includes a first surface and an opposite second surface, said first surface is attached to at least a portion of said planar bottom of said body, said second surface of said sticky polyurethane gel layer is configured to contact the floor surface,
- wherein upon removal of said protective cover and exposure of said adhesive layer, said body is adhered to the rug corner by said adhesive whereby said body maintains the rug corner in a flat condition,
- wherein the body and the sticky polyurethane gel layer are a laminate structure.

Ex. 1001, 3:2–21.

4. Apparatus to prevent curling of a rug corner away from a floor surface, the apparatus comprising:
 - a laminate structure comprising:
 - a rigid and planar body having a planar top and planar bottom; and
 - a sticky polyurethane gel layer that includes a first surface and an opposite second surface, said first surface is laminated to said planar bottom of said body;
 - an adhesive layer applied to at least a portion of said top of said body; and
 - a removable protective cover provided over said adhesive layer,

wherein upon removal of said protective cover and exposure of said adhesive layer, said laminate structure is adhered to the rug corner by said adhesive whereby said body maintains the rug corner in a flat condition and said second surface of said sticky polyurethane gel layer is configured to adhere to the floor surface to prevent slipping of the rug corner.

Id. at 3:27–4:7.

7. Apparatus to prevent curling of a rug corner away from a floor surface, the apparatus consisting of:

a laminate structure comprising:

a rigid and planar body having a planar top and an opposite planar bottom; and

a sticky polyurethane gel layer that includes a first surface and an opposite second surface, the first surface is laminated to said planar bottom of said body, an adhesive layer applied to at least a portion of the top of the body; and

a removable protective cover provided over the adhesive layer,

wherein upon removal of said protective cover and exposure of the adhesive layer, said laminate structure is adhered to the rug corner by said adhesive whereby said body maintains the rug corner in a flat condition and said second surface of said sticky polyurethane gel layer is configured to adhere to the floor surface to prevent slipping of the rug corner.

Id. at 4:13–32.

E. The Asserted Grounds of Unpatentability

Petitioner contends that the challenged claims are unpatentable based on the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1–9	103	Bongiovanni, ¹ Haas ²
1–9	103	Bongiovanni, Zegler ³
1–9	103	Bongiovanni, McDonald ⁴
1–9	112(a)	Written Description

The Petition is supported by the Declaration of Leon H. Phillips, Jr. Ex. 1003 (“the Phillips Declaration”). For purposes of this decision, based on his statement of qualifications (*id.* ¶¶ 5–19) and curriculum vitae (Ex. 1004), we find Mr. Phillips is qualified to opine about the perspective of a person of ordinary skill in the art at the time of the invention.

II. ANALYSIS

A. *Eligibility of the ’285 Patent for Post Grant Review*

The America Invents Act’s post-grant review provisions apply to patents that “contain[] or contained at any time . . . a claim to a claimed invention that has an effective filing date . . . that is on or after [March 16, 2013].” Leahy-Smith America Invents Act (“AIA”) §§ 3(n)(1), 6(f)(2)(A) (2011). In addition, a “petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).” 35 U.S.C. § 321(c); *see* 37 C.F.R. § 42.202(a) (2020).

¹ Bongiovanni et al., US 2012/0285613 A1, published Nov. 15, 2012 (Ex. 1008).

² Haas et al., US 4,554,194, issued Nov. 19, 1985 (Ex. 1009).

³ Zegler et al., US 5,567,497, issued Oct. 22, 1996 (Ex. 1010).

⁴ McDonald et al., US 8,468,770 B2, issued Jun. 25, 2013 (Ex. 1011).

Petitioner states that the '285 patent is eligible for post grant review because it contains at least one claim with an effective filing date after March 16, 2013. Pet. 7. Petitioner contends that there is no support for the '285 patent claims' "limitations related to 'a sticky polyurethane gel layer'" in the earliest applications in the '285 patent's priority claim, namely, that support for "'a sticky polyurethane gel layer' [only] first appears in [Application No. 15/196,139], which discloses an 'elastomeric layer 24 [that] comprises a sticky gel (polyurethane gel) covered by a removable backing.'" *Id.* at 12–13 (citing Ex. 1005, 2:25–27) (last addition in original). Petitioner relies on U.S. Application No. 15/196,139 as being the earliest application supporting a limitation to "a sticky polyurethane gel layer" and, thus, on its filing date of June 29, 2016, falling after March 6, 2013. *Id.* at 13.

Petitioner also states that the Petition is timely filed, i.e., within 9 months of the issue date. *Id.* at 7.

For purposes of this decision, we accept Petitioner's representations set forth above as to eligibility for post grant review, which are not opposed by Patent Owner on this record. Accordingly, based on the information presented, we find that the '285 patent is eligible for post grant review.

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art "would have had at least a High School Diploma with 5 years of experience in the flooring industry" and that they "would also understand that there is a requirement that many accessible surfaces must be slip resistant to minimize hazards to users of the surface." Pet. 13–14 (citing Ex. 1003 ¶¶ 21–26).

On this record, for purposes of this decision, we agree that a person of ordinary skill in the art would have had at least the qualifications set forth in

Petitioner’s definition of the level of ordinary skill, which is not opposed by Patent Owner and appears, on this record, to be consistent with the disclosures of the ’285 patent and the asserted prior art references. We further note that the prior art itself demonstrates the level of skill in the art at the time of the invention. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that “specific findings on the level of skill in the art . . . [are not required] ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’” (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985))).

C. Claim Construction

In a post grant review, we construe the challenged claims under the framework set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–19 (Fed. Cir. 2005) (en banc). Under this framework, claim terms generally are given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification (including other claims), the prosecution history, and even extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Id.* Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

Only those claim terms that are in controversy need to be construed and only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *see also U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997) (holding claim construction is not necessary when it is not “directed to, or has been shown reasonably to affect, the determination of obviousness”).

Petitioner proposes that all claim terms should be construed in accordance with their ordinary meaning except for “laminate structure” and “laminated.” Pet. 14–15 (citing Ex. 1003 ¶¶ 36–41). As to these terms, the Petition relies on a quotation, describing what is shown in Figure 3, that includes the term “laminate structure” from the ’285 patent.⁵ *Id.* at 15 (“As best shown in FIG. 3, the body is a *laminate structure* and comprises a bottom elastomeric layer 24 of an elastomeric material . . . floor surface 26.”); Ex. 1001, 2:16–20, Fig. 3. Petitioner also relies on Merriam-Webster’s definition of “laminate” as ‘a product made by laminating,’” where “laminating” means “to unite (layers of material) by an adhesive or other means.” Pet. 15 (quoting Ex. 1013) (citing Ex. 1011 [sic] Ex. 1013). Petitioner contends that “the term ‘laminate structure’ should be construed to mean a ‘body having an adhered elastomeric material’” and that “the term ‘laminated’ should be construed as ‘adhered.’” *Id.*

On this record, and for purposes of this decision, we decline to construe any claim terms beyond the limited extent we do so below in our analysis, because it is not necessary to do so in reaching our decision on institution.

D. Principles of Law

Petitioner challenges claims under 35 U.S.C. §§ 103 and 112(a) as obvious and lacking written description, respectively. A claim is

⁵ Petitioner and its declarant improperly cite to the ’285 patent disclosure by reference to paragraph number. Pet.; Ex. 1003. The ’285 patent does not include paragraph numbers. Ex. 1001. The application from which the ’285 patent issued does, however, include paragraph numbers. Ex. 1002, 16–24. Determining the corresponding column and line number from the cited paragraph, we use the corresponding column and line numbering throughout this decision.

unpatentable under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) if in evidence, objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

A claim is unpatentable under 35 U.S.C. § 112(a) for lack of written description if the specification fails to “reasonably convey[] to those skilled in the art that the inventor had possession” of the claimed invention as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Although the specification need not recite the claimed invention *in haec verba*, it must do more than simply render the claimed invention obvious. *Id.* at 1352 (citing *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571–72 (Fed. Cir. 1997)). “[W]hether a patent complies with the written description requirement will necessarily vary depending on the context,” including “the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.* at 1351 (citing *Capon v. Eshar*, 418 F.3d 1349, 1357–59 (Fed. Cir. 2005)); *see also Capon*, 418 F.3d at 1357 (“Since the law [of written description] is applied to each invention in view of the state of relevant knowledge, its application will vary with differences in the state of knowledge in the field and differences in the predictability of the science.”). “[M]any original claims will satisfy the

written description requirement,” even though “certain claims may not.”
Ariad, 598 F.3d at 1349.

E. Grounds Based on Obviousness

Petitioner challenges claims 1–9 as unpatentable for having been obvious over Bongiovanni in view of Haas (Pet. 16, 18–45), Bongiovanni in view of Zegler (*id.* at 16, 45–69), and Bongiovanni in view of McDonald (*id.* at 16, 69–94). Petitioner relies on Bongiovanni in the same manner and for the same purposes in each ground, that is, for everything except for the “sticky polyurethane gel layer” included in the laminated structure. *See, e.g., id.* at 21 (“Bongiovanni, however, does not disclose the floor side as having a ‘sticky polyurethane gel layer.’”). Likewise, Petitioner relies, in turn, on each of the additional references for the “sticky polyurethane gel layer” included in the laminate structure. *See, e.g., id.* at 21–24 (Haas), 47–50 (Zegler), 71–74 (McDonald). As discussed below in greater detail, in each case, Petitioner fails to establish a sufficient basis in the additional references for the “sticky polyurethane gel layer.”

1. Bongiovanni and Haas

a) Bongiovanni (Ex. 1008)

Bongiovanni is titled “Anti-Curling Reinforcement Device for Area Rug Corners” and directed to an “anticurling device [that] can be applied to corners of a rug, . . . to prevent the corners from curling.” Ex. 1008, codes (54), (57). Bongiovanni describes the device as comprising “a device body having an L-shape with outside rounded corners and an inside rounded corner” and “having a floor side and an adhesive side” with an adhesive covered by “an adhesive backing” “adapted to be removed to expose the adhesive.” *Id.* ¶ 6. Bongiovanni describes that, in its use to prevent or eliminate curling at corners of rugs, the adhesive backing is removed to

expose the adhesive disposed on the adhesive side of the device body and the exposed adhesive (and associated device) is applied “to a bottom of the rug at a corner . . . , where the L-shape of the device body follows along the corner.” *Id.* ¶ 7. Bongiovanni also discloses that the floor side can include a design to increase the rigidity of the device (*id.* ¶ 21) and that “[t]he [anticurling] device 18 performs its desired function by adding weight to the problem corner of the rug 10 [as] [b]y adding weight, combined with the stiffness of the [anticurling] device 18, the rug corner lies flat and does not curl” (*id.* ¶ 25).

b) Haas (Ex. 1009)

Haas is titled “Self-Adhesive Floor Covering” and is directed to floor coverings having a surface to face the floor that constitutes, at least in part, “an adhesive capable of forming a bond enab[ling] the [floor] covering to be readily applied to the floor.” Ex. 1009, codes (54), (57). Haas further discloses that the surface comprising the adhesive to bond to the floor “may be covered by a protective foil . . . prevent[ing] the covering from sticking to other objects” which is “removed before applying the covering to the floor.” *Id.* at code (57). Haas discloses that the floor covering may be carpet, and illustrates two different embodiments in Figures 1 and 4, reproduced below.

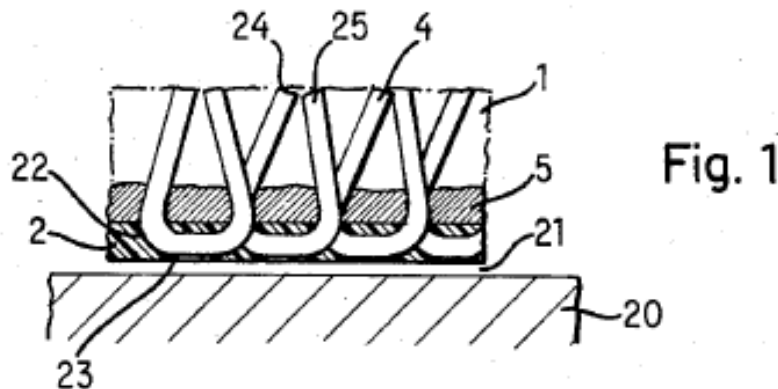


Figure 1 depicts a sectional view of a carpet applied to a floor that includes bonding layer 2 that is itself adhesive and can form an adhesive bond to the floor. *Id.* at 4:63–65, 5:46–50, Fig. 1. As depicted, the carpet to be applied to floor 20 comprises base layer 5, bonding layer 2, and a plurality of fibers 4. *Id.* at 5:26–28. Fibers 4 are stitched into base layer 5 and extend into bonding layer 2 forming loops 22 having closed ends 23, which protrude outwardly from bonding layer 2 at underside 21 of the carpet. *Id.* at 5:28–30, 5:34–38. Haas discloses that “bonding layer 2 firmly adheres to the loops 22 and thereby retains the fibers 4 in the carpet,” “prevent[ing] the fibers 4 from being pulled out.” *Id.* at 5:30–34. Haas further discloses that “[i]n the carpet of FIG. 1, the bonding layer 2 itself is composed of a material which is capable of forming an adhesive bond with the floor 20.” *Id.* at 5:48–50.

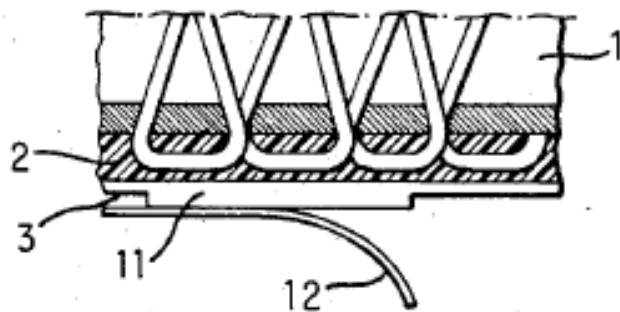


Fig. 4

Figure 4 depicts a sectional view of a carpet that includes a bonding layer 2 that is not adhesive, and thus requires added adhesive material, which is provided as adhesive layer 3 covered by removable protective foil 12. *Id.* at 5:4–6, 5:61–63, 6:30–32, Fig. 4. Haas discloses that “[i]t is possible for the bonding layer 2 to be incapable of forming an adhesive bond with the floor 20 and to apply an adhesive material to the bonding layer 2” (*id.* at 5:61–63) and that the carpet has “the entire underside . . . covered with a

layer . . . of adhesive capable of forming a bond with a floor” with the adhesive layer 3 being “formed with spaced adhesive projections 11” (*id.* at 6:30–33) and being “covered with . . . protective foil 12” (*id.* at 7:10–11).

Haas discloses that “the bonding layer [2] may be composed of a polyurethane,” and advises that “[t]he adhesive [used] should then be one which does not attack polyurethanes.” *Id.* at 8:36–39. Haas provides four examples (Examples I–IV) (*id.* at 11:32–12:43), with each using a bonding layer 2 of foamed or unfoamed polyurethane and a heat-activated adhesive (Helmitherm® 42006) applied to the polyurethane layer (*id.* at 11:46–49, 11:65–68, 12:18–21, 12:39–42).

c) Petitioner’s Contentions and Analysis

Petitioner contends that Bongiovanni and Haas render claims 1–9 obvious and unpatentable under § 103. Petitioner relies on Bongiovanni (Ex. 1008) alone for most claim elements. Pet. 19–26. As to the “sticky polyurethane gel layer that includes a first surface and an opposite second surface,” however, Petitioner states that while the apparatus of Bongiovanni has a “floor side,” it “does not disclose the floor side as having a ‘sticky polyurethane gel layer’” and relies on Haas’ disclosure of “a carpet with an underside adhesive designed to bond with the floor.” *Id.* at 21 (citing Ex. 1003 ¶¶ 62–63; Ex. 1009, 3:3–23). Petitioner further relies on Haas’ base layer of polypropylene and bonding layer of foamed polyurethane secured to the base layer. *Id.* at 22 (citing Ex. 1009, 11:32–37; Ex. 1003 ¶ 65). Petitioner argues that it would have been obvious to a person of ordinary skill in the art to include “the foamed polyurethane surface-facing bonding layer that is under portions of the carpet as disclosed in Haas” in Bongiovanni’s apparatus. *Id.* at 23 (citing Ex. 1003 ¶ 66; Ex. 1008 ¶ 21). Petitioner further contends that the “augmented carpet-to-floor contact

system would produce the same effect claimed by a ‘sticky [bonding] polyurethane gel [foam] layer.’” *Id.* at 24 (citing Ex. 1003 ¶ 67). Further, with respect to the limitation “wherein the body and the sticky polyurethane gel layer are a laminate structure,” Petitioner also relies on Haas’ teaching that an adhesive material can be applied to its bonding layer 2 to form an adhesive bond with the floor when the bonding layer itself is not adhesive. *Id.* at 25–26 (citing Ex. 1009 5:61–6:2; Ex. 1003 ¶¶ 73–74). Petitioner contends that it would have been obvious to a person of ordinary skill in the art to “include[e] the foamed polyurethane surface-facing bonding layer” of Haas in the apparatus of Bongiovanni. *Id.* at 23.

On this record, Petitioner fails to establish a basis for the recited “sticky polyurethane gel layer.” Although it is evident that Haas’ “bonding layer 2” can itself be formed of an adhesive material (*see, e.g.*, Ex. 1009, 5:48–50), it can also be formed of material that is not adhesive (or sticky) (*see, e.g., id.* at 5:61–63). Petitioner offers no support for Haas’ polyurethane foam layer itself being an adhesive or sticky material. Pet. 21–24. Further, the disclosure relating to Haas’ polyurethane layer is contrary to the polyurethane being an adhesive or sticky material because Haas teaches applying an adhesive to the polyurethane layer. *See, e.g.*, Ex. 1009, 8:36–38, 11:32–12:43 (Examples I–IV). Likewise, Petitioner offers no support for the polyurethane foam being a polyurethane gel. *See, e.g.*, Pet. 21–24. Petitioner rather merely asserts that its “augmented carpet-to-floor contact system would produce the same effect claimed by a ‘sticky [bonding] polyurethane gel [foam] layer,’” which falls short of establishing that the polyurethane foam meets the limitation requiring gel. Pet. 24.

The Phillips Declaration essentially repeats arguments set forth in the Petition, including as to the “sticky polyurethane gel layer that includes a

first surface and an opposite second surface,” without further analysis. *Compare* Ex. 1003 ¶¶ 61–67, *with* Pet. 20–24. The cited testimony, thus, lacks the necessary objective evidence to support the opinions expressed as to Haas teaching or suggesting a “sticky polyurethane gel layer.” *See Velandier v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) (“It is within the discretion of the trier of fact to give each item of evidence such weight as it feels appropriate.”); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985) (“Lack of factual support for expert opinion going to factual determinations, however, may render the testimony of little probative value in a validity determination.”).

Petitioner relies on the same disclosure and reasoning as to the “sticky polyurethane gel layer” required by independent claims 4 and 7. Pet. 28–32, 37–41. Accordingly, on this record, Petitioner fails to show that any claim more likely than not is unpatentable over Bongiovanni and Hass.

2. *Bongiovanni and Zegler*

a) *Zegler (Ex. 1010)*

Zegler is titled “Skid-Resistant Floor Covering and Method of Making Same” and is directed to a floor covering that includes: (i) a floor covering layer having a face layer and a thermoplastic lower backing layer; and (ii) a thermoplastic contact layer, which is fused to the upper surface of the lower backing layer. Ex. 1010, codes (54), (57), 2:21–25. Zegler discloses that the face layer can be carpet. *Id.* at 2:29–30. Zegler also discloses that the lower surface of the thermoplastic contact layer includes a plurality of shallow thermoplastic projections away from the floor covering face layer, i.e., toward the floor, and that these shallow thermoplastic projections are sufficiently elastic to impart skid resistance to the floor covering. *Id.* at 2:25–29. Zegler also discloses that the thermoplastic used in the contact

layer “should have an inherently high coefficient of friction” and “must have sufficient elasticity to deform when pressure is applied to the face layer of the floor covering so that more of the lower surface of the contact layer meets the underlying floor.” *Id.* at 5:18–24. Zegler lists a number of suitable thermoplastics for the contact layer, including polyurethanes. *Id.* at 5:25–28. Zegler also discloses that the thermoplastic contact layer can be a foamed thermoplastic. *Id.* at 7:56–62 (discussing use of a blowing agent that will foam the contact layer during the heating step used to fuse the face layer and contact layer).

b) Petitioner’s Contentions and Analysis

Petitioner contends that Bongiovanni and Zegler render claims 1–9 obvious and unpatentable under § 103. Petitioner again relies on Bongiovanni (Ex. 1008) for most claim elements. Pet. 45–52. As to the “sticky polyurethane gel layer that includes a first surface and an opposite second surface,” however, Petitioner states that while the apparatus of Bongiovanni has a “floor side,” it “does not disclose the floor side as a ‘sticky polyurethane gel layer’” and relies on Zegler’s disclosure of “skid-resistant floor covering using elastic thermoplastic projections.” *Id.* at 47–50. Petitioner relies on Zegler’s thermoplastic contact layer having projections that “are sufficiently elastic to impart skid resistance.” *Id.* at 48 (citing Ex. 1010, 2:17–29; Ex. 1003 ¶ 127). Petitioner also relies on Zegler disclosing polyurethane as an exemplary thermoplastic and that the thermoplastic may be foamed. *Id.* at 49–50 (citing Ex. 1010, 5:25–29, 7:56–61; Ex. 1003 ¶¶ 130–131). Petitioner contends that it would have been obvious to a person of ordinary skill in the art to “includ[e] the foamed polyurethane non-skid layer” of Zegler in the apparatus of Bongiovanni. *Id.* at 50. Petitioner further contends that this would provide “the claimed

“sticky [non-skid] polyurethane gel [foam] layer.”” *Id.* (citing Ex. 1003 ¶ 133).

On this record, Petitioner fails to establish a basis for the recited “sticky polyurethane gel layer.” Although it is evident that Zegler’s non-skid layer can be formed of foamed polyurethane, it is not apparent that it is a “sticky polyurethane gel layer.” Zegler’s non-skid layer is based on the friction provided by the contact layer having “skid-resistance” provided by the included projections, the material’s high coefficient of friction, and its elasticity to allow greater contact when pressure is applied. *Id.* at 2:25–29 (disclosing that the included “plurality of shallow thermoplastic projections . . . are sufficiently elastic to impart skid resistance”), 5:20–24 (“[T]he thermoplastic should have an inherently high coefficient of friction, and it must have sufficient elasticity to deform when pressure is applied . . . so that more of the lower surface of the contact layer meets the underlying floor.”). It is not apparent that a polyurethane foam that imparts non-skid properties based on friction is *sticky* within the meaning of the ’285 patent that claims a “sticky polyurethane gel layer” and describes a sticky gel as *adhering* to the floor. Ex. 1001, 2:32. Neither Petitioner nor its declarant provides any further reasoning or explanation for its contention that Zegler’s polyurethane foam is “sticky” within the meaning of the ’285 patent claims. Pet. 47–50; Ex. 1003 ¶¶ 127–133. Similarly, Petitioner offers no support for the polyurethane foam being a polyurethane gel. *See, e.g.*, Pet. 47–50. Petitioner merely asserts that the result of the combination would include “the claimed ‘sticky [non-skid] polyurethane gel [foam] layer,’” and this falls short of establishing that the foam meets the limitation requiring a “sticky polyurethane gel layer.” *Id.* at 50.

Petitioner relies on the same disclosure and reasoning as to the “sticky polyurethane gel layer” required by independent claims 4 and 7. Pet. 54–58, 62–66. Accordingly, on this record, Petitioner fails to show that any claim more likely than not is unpatentable over Bongiovanni and Ziegler.

3. *Bongiovanni and McDonald*

a) *McDonald (Ex. 1011)*

McDonald is titled “Floor Covering Product and Method of Using Same” and is directed to floor coverings “that do not require an adhesive to apply them to and retain them on a floor surface,” particularly a floor covering that includes a face surface and a back surface, with the back surface having a layer of polyurethane having a cure index of between approximately 70 and 90. Ex. 1011, codes (54), (57), 1:9–10. McDonald discloses that the floor covering can be carpet, and that polyurethane on the back surface having a cure index in the range of 70 and 90 adheres to the floor to which it is applied, with lower cure index values indicating greater adherence. *Id.* at 4:23–34, 4:36–44. Figure 2 is reproduced below.

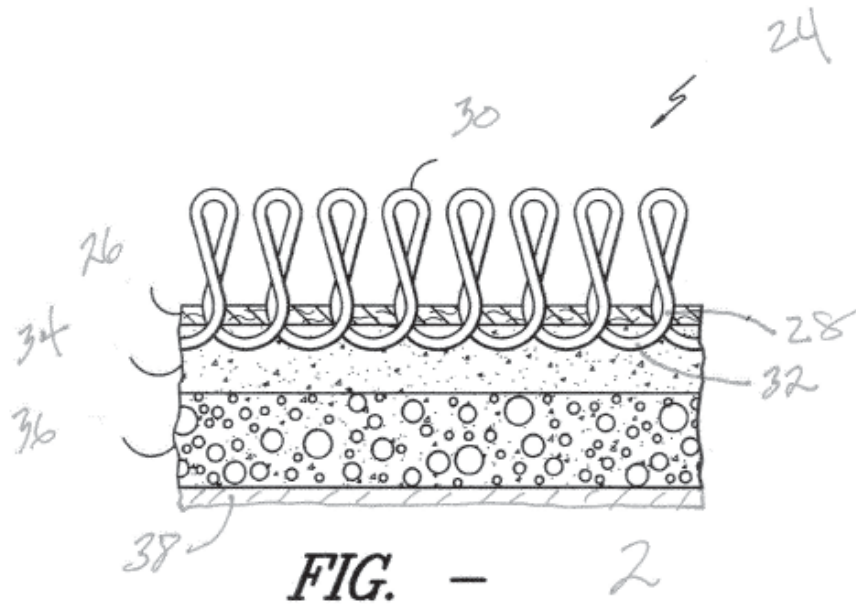


Figure 2 depicts a sectional view of carpet 24 with primary backing material 26 with tufts forming face pile 30 and loop backs 32, precoat layer 34, layer of cushion foam 36, and low cure index polyurethane layer 38. *Id.* at 6:62–7:8. McDonald contrasts the use of polyurethane having a low cure index of between approximately 70 and 90 with polyurethane having a cure index of 100 or greater that is typically used in floor materials. *Id.* at 4:34–38. McDonald also discloses that “standard polyurethane compositions” can be used “in a foam or cellular form” for making “other aspects of the invention.” *Id.* at 6:32–35.

b) Petitioner’s Contentions and Analysis

Petitioner contends that Bongiovanni and McDonald render claims 1–9 obvious and unpatentable under § 103. Petitioner again relies on Bongiovanni (Ex. 1008) for most claim elements. Pet. 69–77. As to the “sticky polyurethane gel layer that includes a first surface and an opposite second surface,” however, Petitioner states that while the apparatus of Bongiovanni has a “floor side,” it “does not disclose the floor side as a

‘sticky polyurethane gel layer’” and relies on McDonald’s disclosure of a polyurethane layer from “a floor covering with a polyurethane layer on one face of the covering.” *Id.* at 71–74. Petitioner further relies on McDonald’s “polyurethane[s] . . . [having] a low Cure Index of approximately 70 to approximately 90” and its teaching that “the lower the Cure Index the greater the adherence.” *Id.* at 73. Petitioner also relies on this low cure index polyurethane layer being what contacts the floor. *Id.* (citing Ex. 1003 ¶ 198). McDonald states that “[i]n prior art polyurethanes used in connection with floor covering materials, the polyurethane typically has a Cure Index of 100 or greater.” Ex. 1011, 4:34–36; Pet. 73 (quoting Ex. 1011, 4:34–47). Still further, Petitioner relies on McDonald disclosing that the polyurethane layer “may be foam: ‘Although it is contemplated that certain disclosed embodiments of the polyurethane composition may be used as an elastomer, it is also specifically contemplated that standard polyurethane composition can also be used to make other aspects of the invention, such as in . . . foam or cellular form.’” Pet. 72 (quoting Ex. 1011, 6:30–34) (citing Ex. 1003 ¶ 195).

Petitioner contends that it would have been obvious to a person of ordinary skill in the art to “includ[e] the elastomeric, foamed polyurethane layer having appropriate contact to a face of a floor covering (such as, for example, polyurethane with a cure index of approximately 70 to approximately 90)” in the apparatus of Bongiovanni. *Id.* at 73. Petitioner further contends that this would provide “the claimed ‘sticky [having a low Cure Index of approximately 70 to approximately 90] polyurethane gel [foam] layer.’” *Id.* at 74 (citing Ex. 1003 ¶ 200).

On this record, Petitioner fails to establish a basis for the recited “sticky polyurethane gel layer.” Petitioner relies on McDonald disclosing its

low cure index polyurethane in the form of foam for the layer of polyurethane covering the back surface of the flooring material, that is, the layer of polyurethane that contacts and adheres to the floor. McDonald's disclosure, however, states that "it is also specifically contemplated that *standard polyurethane compositions* can also be used to make *other aspects of the invention*, such as *in a foam or cellular form*." Ex. 1011, 6:32–34 (emphasis added). This statement follows an extended discussion of the layer of polyurethane covering one face of the floor covering material and having a low cure index of approximately 70 to approximately 90. *Id.* at 4:23–6:29. Accordingly, the disclosure relating to making "other aspects of the invention" reasonably relates to elements other than the layer of low cure index polyurethane covering the back surface that can contact and adhere to the floor. Petitioner does not explain sufficiently, for purposes of instituting trial, why an ordinarily skilled artisan would have understood McDonald to teach the use of foamed polyurethane for the layer covering the back surface and articulates no rationale why this teaching would lead the skilled artisan to provide a foamed polyurethane layer covering the back surface. Pet. 71–74. Further, even if we accept that McDonald would have been understood to teach more generally that foamed polyurethane can be used as the outermost layer on the back surface, McDonald further teaches in this same disclosure that it is the "standard polyurethane compositions" that can be used. Significantly, McDonald expressly distinguishes those polyurethane compositions from its inventive low cure index polyurethane that is sticky and adheres to the floor. Ex. 1011, 4:34–38. Petitioner does not adequately address these issues. Pet. 71–74.

In sum, Petitioner relies on a combination of teachings from McDonald that require modification from what is set forth to reach the

claimed subject matter and Petitioner fails to explain sufficiently why a person of ordinary skill in the art would have undertaken the modifications necessary to reach the claimed subject matter. *See Belden 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.”). Further, “[c]are must be taken to avoid hindsight reconstruction by using ‘the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.’” *Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988) (quoting *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1012 (Fed. Cir. 1983)). Given the absence of a clear alternative explanation for the proposed modifications, we discern here an exercise of impermissible hindsight reconstruction.

Petitioner similarly relies on the same disclosure and reasoning as to the “sticky polyurethane gel layer” required by independent claims 4 and 7. Pet. 78–82, 87–91. Accordingly, on this record, Petitioner fails to show that any claim more likely than not is unpatentable over Bongiovanni and McDonald.

F. Ground Based on Written Description

Petitioner challenges claims 1–9 as unpatentable for lack of written description of an apparatus that is not limited to a V-shaped apparatus. Pet. 95–100. Petitioner contends, specifically, that the claims fail to satisfy the written description requirement “because they lack limitations that are disclosed in the originally filed application of the ’285 Patent.” *Id.* at 96. Petitioner relies on “the shape of the disclosed apparatus [being] specified—

both descriptively and visually—*only* as a ‘V-shaped body.’” *Id.* As to descriptive text, Petitioner relies on four (4) statements: (i) “The apparatus includes a rigid and planar ***V-shaped body*** having a top surface and a bottom surface.” (Ex. 1001 at code (57)); (ii) “In brief, the apparatus of the present invention comprises a rigid and ***planar V-shaped body***.” (*id.* at 1:41–42); (iii) “Upon doing so, the rigid and planar ***V-shaped body*** maintains the rug corner in a flat condition.” (*id.* at 1:52–53); and (iv) “The apparatus 10 includes a ***V-shaped body*** 12 with a top 14 and bottom 16.” (*id.* at 2:11–12). As to visual description, Petitioner relies on the depiction of a V-shaped apparatus in Figures 1 and 2. Pet. 96–97 (citing Ex. 1001, Figs. 1–2; Ex. 1003 ¶ 271). Citing the Phillips Declaration, Petitioner contends that “[t]here are no other discussions about the shape of the apparatus in the specification of the ’285 Patent.” *Id.* at 97 (citing Ex. 1003 ¶ 272).

Petitioner similarly highlights the disclosure relating to the intended use to prevent rug corners from curling up and argues that this emphasis is further evidence that the specification discloses an invention that is limited to a V-shaped apparatus because such is “ideally suited for use under the corner of a rug (rather than the side or center).” *Id.* at 97–99 (citing Ex. 1001, codes (54), (57), 1:27–34, 1:49–57, 2:53–60; Ex. 1003 ¶¶ 273–274).

Based on the specification’s disclosure relating to the apparatus’ shape and use, Petitioner argues that a person of ordinary skill in the art would understand that the invention is limited to a V-shaped apparatus and that the claims, lacking this limitation, are invalid for lack of written description support. *Id.* at 99–100 (citing Ex. 1003 ¶¶ 275–277).

Petitioner fails to establish sufficiently that the claims lack sufficient written description support. In particular, Petitioner does not account

adequately, if at all, for whether the original claims in the application that issued as the '285 patent provide written description support.⁶ *See Ariad Pharms.*, 598 F.3d at 1349. And while our reviewing court has recognized that certain original claims may not suffice, it sets forth that many will, and sets forth that determining whether they do requires consideration of the state of the knowledge in the field and on the complexity and predictability of the relevant technology. *Id.* at 1349, 1351–52. Rather than addressing these factors for determining whether these original claims provide the necessary written description support, Petitioner cites to case law addressing what written description support is needed for *amending or adding claims* during prosecution of a previously filed application (Pet. 95) and discusses the disclosure of the specification in a manner more appropriate to that issue (*id.* at 96–99). But as the Petition itself notes, the claims in this case were neither amended nor added during prosecution. *Id.* at 8 (“The [16/454,560] Application issued as the '285 Patent . . . with no changes to its original 9 claims.”). Petitioner thus fails to address the issues relevant to the claims of the '285 patent, which were originally filed with the application, including the state of knowledge in the field as to the use of different shapes for apparatus such as that claimed or to the predictability of using different shaped apparatus. Pet. 96–100; *Ariad Pharms.*, 598 F.3d at 1349, 1351–52. Accordingly, on this record, Petitioner has not demonstrated that it is more likely than not that there is a lack of written description for the claims.

⁶ It is not contested that the '285 patent issued from the 16/454,560 application with no changes to its original nine claims. Pet. 8; *compare* Ex. 1001, 3:2–4:37, *with* Ex. 1002, 5–7.

III. CONCLUSION

For the reasons set forth above, we determine that Petitioner has failed to demonstrate that it is more likely than not that at least one challenged patent claim is unpatentable. Accordingly, we do not institute a trial on the grounds asserted in the Petition.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is *denied* and no post grant review is instituted.

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Patent 10,806,285 B2

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