

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TECH 21 UK LTD.,
Petitioner,

v.

ZAGG INTELLECTUAL PROPERTY HOLDING CO., INC.,
Patent Owner.

Case IPR2014-01262
Patent 8,567,596 B1

Before MEREDITH C. PETRAVICK, SCOTT A. DANIELS, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

On August 8, 2014, Tech 21 UK LTD. (“Petitioner”) filed a Corrected Petition requesting *inter partes* review of claims 1–18 (“the challenged claims”) of U.S. Patent No. 8,567,596 B1 (Ex. 1001, “the ’596 patent”). Paper 5 (“Pet.”). *Inter partes* review was instituted on February 19, 2015 (Paper 13, “Dec.”) on the following grounds:

Ground	Claim(s)	Prior Art
§ 103	1, 3–8, and 10–14	Mason I ¹ and Thomas ²
§ 103	2 and 9	Mason I, Thomas, and Mase ³
§ 102	1, 5, 7, 8, 12, and 14	PALM ⁴
§ 103	2 and 9	PALM and Mase
§ 103	15–18	Mase and Mason I

On May 15, 2015, Patent Owner filed a Response to Decision to Institute *Inter Partes* Review. Paper 21 (“PO Resp.”). Petitioner filed a Reply to Patent Owner’s Response. Paper 22 (“Pet. Reply”).

On May 15, 2015, Patent Owner also filed a Motion to Amend (Paper 20, “Mot.”) and a Claims Listing (Ex. 2001). To support its Motion to Amend, Patent Owner submitted a Declaration of Jim Colby. Ex. 2014 (“Colby Decl.”). Petitioner filed an Opposition to the Motion to Amend

¹ Mason, Jr., U.S. Patent No. 7,389,869 B2 (issued June 24, 2008) (Ex. 1002).

² Thomas, U.S. Patent Application Publication No. US 2004/0246386 A1 (published Dec. 9, 2004) (Ex. 1004).

³ Mase, U.S. Patent Application Publication No. US 2009/0186181 A1 (published Jul. 23, 2009) (Ex. 1009).

⁴ *PalmTM Anti-Glare Screen Protectors* package photographs (Ex. 1010).

(Paper 23, “Opp.”), and Patent Owner filed a Reply in Support of the Motion to Amend (Paper 24, “PO Reply”).

As neither party requested an oral argument, no oral argument was held.

B. Patent Owner’s Request to Cancel Claims 2 and 5–18

In its Patent Owner’s Response and its Motion to Amend, Patent Owner requests cancellation of claims 2 and 5–18 of the ’596 patent. PO Resp. 1; Mot. 1. Patent Owner’s request to cancel these claims is not contingent on the claims being determined to be unpatentable or on the grant of the Motion to Amend with respect to the proposed substitute claims. Patent Owner’s request to cancel claims 2 and 5–18 is granted, and we need not address these claims further.

The remaining grounds are as follows.

Ground	Claim(s)	Prior Art
§ 103	1, 3, and 4	Mason I and Thomas
§ 102	1	PALM

C. Related Proceedings

Both parties state that the ’596 patent is involved in *Zagg Intellectual Property Holding Co., Inc. v. Tech21 LTD.*, Case 2:14-cv-00113-BCW, in the United States District Court for the District of Utah. Pet. 4; Paper 4, 2. In addition, Patent Owner states that the ’596 patent is involved in *Zagg Intellectual Property Holding Co. v. Superior Communications*, Case 2:14-cv-00121-TS, also in the District of Utah. Paper 4, 2.

D. The '596 patent

The '596 patent is titled “Electronic Device Protective Film Application Kit and Method” and issued from an application filed on August 13, 2010. The '596 patent claims priority as a continuation-in-part of Mason II⁵, which issued from an application filed on June 4, 2008. Mason II claims priority as a continuation-in-part of Mason I, which issued from an application filed on April 1, 2006.

The '596 patent discloses a kit for applying a protective film to a screen of an electronic device. Ex. 1001, col. 3, ll. 44–47. The kit includes a plurality of protective film sheets, a cleaning and/or activating solution, and a miniature squeegee, all in a package. *Id.* at col. 3, l. 48–col. 4, l. 41; Fig. 1. The '596 patent discloses two application embodiments: a dry-application embodiment (*id.* at Figs. 5–6) and a wet-application embodiment (*id.* at Figs. 3–4).

i. Dry-Application Embodiment

In the dry-application embodiment, the protective film has an adhesive covered by a peel-away cover sheet that has two portions. *Id.* at col. 3, ll. 16–23, col. 5, ll. 1–26. The '596 patent's Figure 6 is reproduced below.

⁵ Mason, U.S. Patent No. 7,784,610 B2 (issued Aug. 31, 2010) (Ex. 1003).

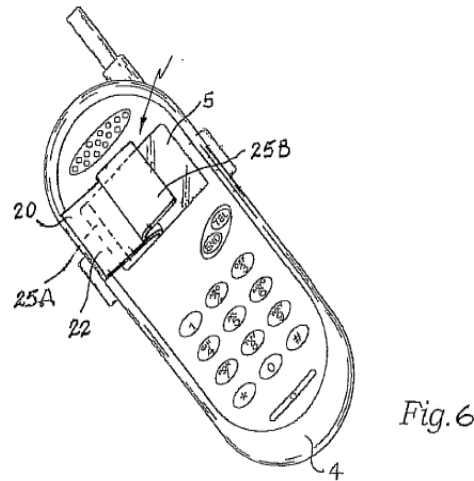


Fig. 6 depicts a step in the dry application of the protective film cover. For a dry application, first, screen 5 is cleaned. *Id.* at col. 5, ll. 4–7. Then, protective film sheet 20, with cover sheet 25, is placed in position on screen 5 and pinned into place on screen 5 with manual pressure. *Id.* at col. 5, ll. 7–10. Portion 25A of cover sheet 25 then is peeled off, and the portion of protective film sheet 20, with its adhesive layer now exposed, is pressed onto screen 5. *Id.* at col. 5, ll. 14–19. Next, portion 25B is peeled off, and the remaining portion of protective film sheet 20 is pressed onto screen 5. *Id.* at col. 5, ll. 19–22. Finally, squeegee 40 is used to assure that protective film sheet 20 is secured to screen 5 and to press out any air bubbles. *Id.* at col. 5, ll. 22–26.

ii. Wet-Application Embodiment

In the wet-application embodiment, protective film sheet 20 is coated with an adhesive that must be activated by solution 32, such as alcohol or water. *Id.* at col. 4, ll. 11–17. After cleaning screen 5, solution 32 is applied to screen 5 just prior to applying the protective film sheet. *Id.* After the

protective film sheet is applied, the squeegee is used to drain the solution and to press out any air bubbles. *Id.* at col. 4, ll. 35–39. The '596 patent's Figure 3 is reproduced below.

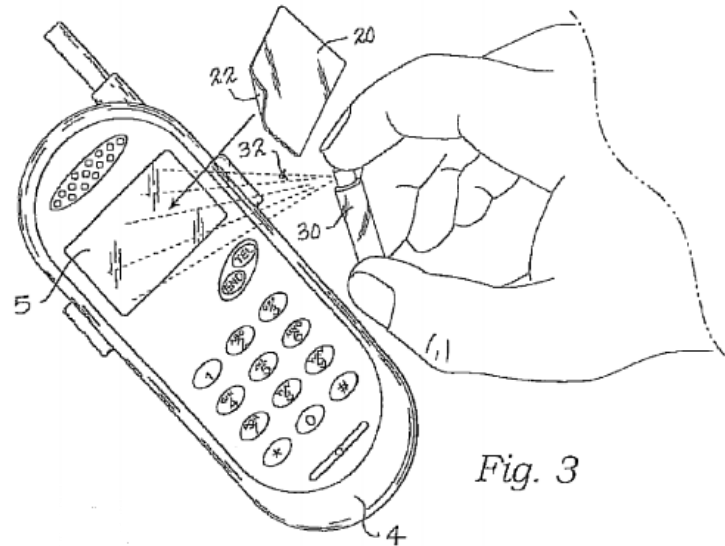


Fig. 3

Figure 3 depicts a step in the wet application of the protective film cover.

E. Illustrative Claim

Claim 1, reproduced below, is illustrative of the '596 patent.

1. A kit for protecting a surface of an electronic device, comprising:

a film sheet cut to a specific size and shape corresponding to a size and shape of a surface of an electronic device the film sheet is configured to protect;

an adhesive layer on one side of the film sheet;

a peel-away cover film impermanently secured to the adhesive layer;

an application element for removing air bubbles between the film sheet and a surface of an electronic device as the film sheet is applied to the electronic device; and a package containing the film sheet and the application element.

Id. at col. 6, ll. 2–14.

II. ANALYSIS

A. Priority Date of Claims 1, 3, and 4 of the '596 Patent

The parties dispute whether claims 1, 3, and 4 of the '596 patent are entitled to a priority date of August 13, 2010, the filing date of the '596 patent, or to a priority date of April 1, 2006, the filing date of parent patent Mason I. Pet. 7–11; Pet. Reply 1–2, 6–21; PO Resp. 1–4. At the crux of the dispute is whether certain disclosures of the prior art in the background sections of Mason I and Mason II provide sufficient written description support for the peel-away cover film feature required by claims 1, 3, and 4. *Id.*

i. Petitioner's Argument

Petitioner argues that the priority date for claims 1, 3, and 4 of the '596 patent is its filing date, August 13, 2010, and not the filing date of parent patent Mason I, because Mason I and Mason II do not disclose or otherwise provide adequate written description support for the peel-away cover film feature of the claims. Pet. 8–10; Pet. Reply 1–2, 6–21. According to Petitioner, the claimed peel-away cover film was first introduced in the '596 patent as part of the new dry-application embodiment. Pet. 9–10; Pet. Reply 6–9. Petitioner argues that Mason I and Mason II disclose the wet-application embodiment, but not the dry-application embodiment and, thus, Mason I and Mason II do not provide adequate written description support for the claimed peel-away cover film. *See* Pet. 9–10; Pet. Reply 6–9.

Petitioner acknowledges that both parent patents—Mason I and Mason II—disclose, as background, prior art references that include a film

with a removable protective backing layer or a release liner. *See* Pet. 9; Pet. Reply 10–12. Petitioner, however, argues that this does not provide the required written description support because it is a description of the prior art and not a description of the invention. *Id.*

ii. Patent Owner’s Argument

Patent Owner argues that the priority date for claims 1, 3, and 4 of the ’596 patent is the filing date of parent patent Mason I, April 1, 2006. PO Resp. 3–4. Patent Owner argues that the disclosures of the prior art in Mason I “demonstrate that a peel-away cover film was known and available to the public prior to April 1, 2006” and “[t]hus, even if Patent Owner had not included the discussion of a peel-away cover in the prior art, it would be entitled to claim such a well-known feature without the need to expressly recite the feature in the specification.” *Id.*

iii. Analysis

To be entitled to the benefit of a parent application, one requirement is that the invention presently claimed must have been disclosed in the chain of parent applications in the manner provided by 35 U.S.C. § 112, first paragraph. *See* 35 U.S.C. § 120; *In re Lukach*, 442 F.2d 967, 968-69 (CCPA 1971). An *ipsis verbis* disclosure, however, is not necessary to satisfy the written description requirement. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). The disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question, even if every nuance of the claims is not explicitly

described in the specification. *Id.*; *see Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010).

The test for written description is an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Using this test, the invention must be described in a manner sufficient to demonstrate that the inventor actually invented the claimed invention. *Ariad*, 598 F.3d at 1351. “One shows that one is ‘in possession’ of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). Written description is a question of fact judged as of the relevant filing date. *Falko-Gunter Falkner v. Inglis*, 448 F.3d 1357, 1363 (Fed. Cir. 2006).

The dry-application embodiment is not disclosed in the description of the invention of either Mason I or Mason II. The dry-application embodiment is also not depicted in the figures of Mason I or Mason II. Neither Mason I nor Mason II discloses or depicts the use of a wet adhesive (i.e., one that does not require an activating solution) covered by a peel-away cover film in connection with its disclosed invention. The respective descriptions of the Mason I and Mason II inventions only disclose the wet-application embodiment. The dry-application embodiment appears to be subject matter added at the time the application of the ’596 patent was filed.

Mason I and Mason II do disclose, as background, prior art that includes a release liner or a removable protective backing layer used in connection with protective films (*see* Ex. 1002, col. 2, ll. 7–9, 35–38, 55–59; Ex. 1003, col. 2, ll. 13–15, 47–63, col. 2, l. 64–col. 3, l. 1). This disclosure, however, does not describe a peel-away cover film used in connection with

the wet-application embodiment described as the invention of Mason I and Mason II, and Patent Owner has not produced any other evidence sufficient to establish that these prior art disclosures “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, the [inventor] was in possession of the invention now claimed.” *Vas-Cath*, 935 F.2d at 1563–64.

At best, these disclosures of the prior art suggest that providing a peel-away cover film on the protective film sheet may have been obvious at the time Mason I and Mason II were filed. However, “[t]he question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.” *Lockwood*, 107 F.3d at 1572.

Upon review of the evidence, we determine that Mason I and Mason II fail to provide adequate written description support of the claimed kit, which has a peel-away cover film, and thus claims 1, 3, and 4 of the ’596 patent are entitled to its August 13, 2010 filing date and not to a priority date of the filing date of parent patents Mason I or Mason II.

B. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1276–78 (Fed. Cir. 2015). Claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire

disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner proposes a construction for the claim term “application element.” Pet. 18–20. Patent Owner does not propose a construction for any claim terms. PO Resp. 4. Based on our review of the record before us, however, no explicit construction of any claim term is needed.

C. Claims 1, 3, and 4 as obvious over Mason I and Thomas

a. Overview of Mason I

Mason I is a patent titled “Display Protective Film Application Kit,” and was issued on June 24, 2008 from an application filed on April 1, 2006. Ex. 1002, 1. Mason I is a parent application of the ’596 patent and also discloses a kit for applying a protective film sheet to the screen of an electronic device. Figure 3 of Mason I is reproduced below.

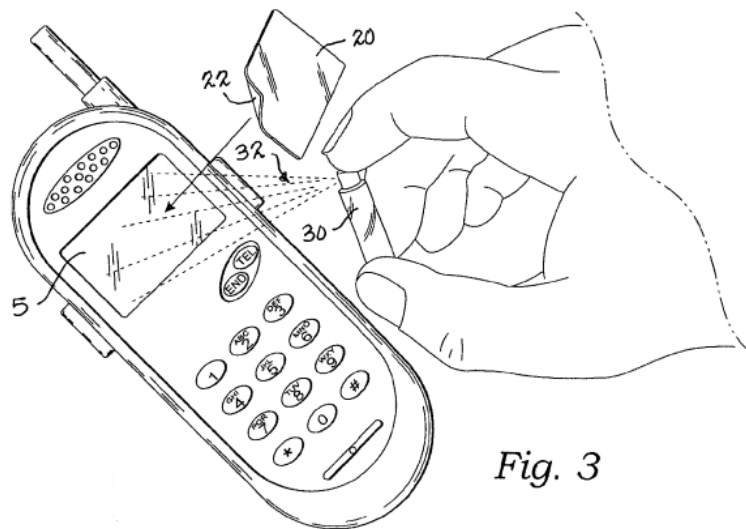


Fig. 3

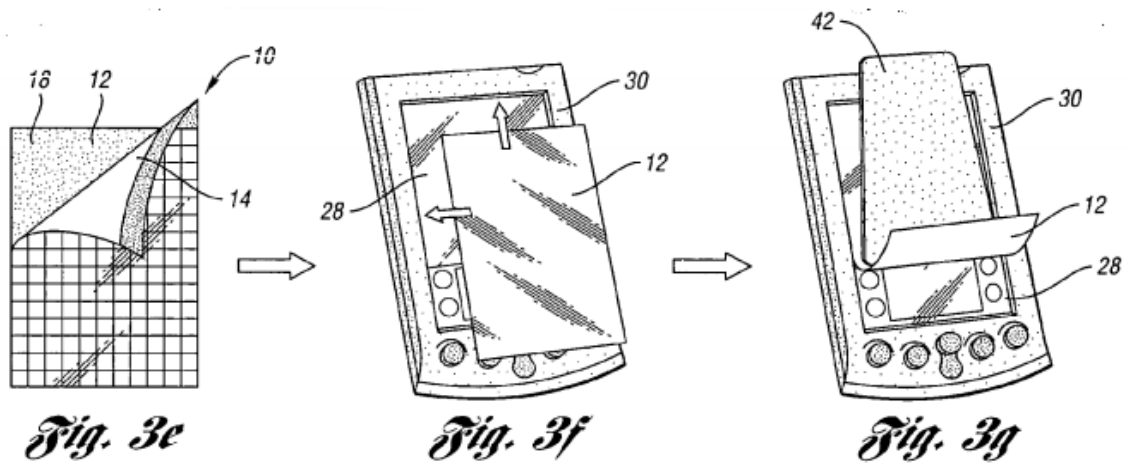
Figure 3 depicts an application of protective film sheet 20 to electronic display 5. To apply protective film sheet 20 to electronic display

5, electronic display 5 first is cleaned with cleaning and activating solution 32. *Id.* at col. 4, ll. 57–62. After cleaning, cleaning and activating solution 32 again is sprayed onto electronic display 5, and film sheet 20, with adhesive layer 22 in contact with electronic display 5, is positioned on the electronic display 5. *Id.* at col. 4, ll. 62–67. Then, the cleaning and activating solution 32 is pressed out from between the film sheet and electronic display 5 by squeegee 40. *Id.* at col. 5, ll. 1–5.

Mason I discloses that a plurality of film sheets 20, bottle 30 of cleaning and activating solution 32, and squeegee 40 can be packaged together on a molded support card 10. *Id.* at col. 4, ll. 13–55; Figs. 1–2. The film sheets 20 are cut to the exact size of electronic display 5. *Id.* at col. 4, ll. 21–23.

b. Overview of Thomas

Thomas is a patent application publication titled “Screen Protection Kit Having a Sizing Grid” and published on December 9, 2004. Ex. 1004, 1. Thomas discloses a screen protection shield assembly that includes a transparent overlay sheet, an adhesive layer, and a removable backing sheet 14. Ex. 1004, Abstract. Figures 3e–3g of Thomas are reproduced below.



Figures 3e–3g depict the application of transparent overlay sheet 12 to PDA 30. To apply transparent overlay sheet 12 to display screen 28, shield assembly 10 first is trimmed to the size of display screen 28 using a sizing grid. *Id.* ¶¶ 40–42. A portion of removable backing sheet 14 then is removed from transparent overlay sheet 12 to expose adhesive layer 18. *Id.* ¶ 43. The exposed portion of transparent overlay sheet 12 then is aligned with the edges of display screen 28 and secured to display screen 28. *Id.* ¶ 44. Applicator card 42 then is used to apply the remainder of transparent overlay sheet 12 to display screen 28 by sliding applicator card 42 across display screen 28 as removable backing sheet 14 is peeled away. *Id.* ¶ 45. Applicator card 42 then can be used to remove any air bubbles. *Id.*

Thomas discloses a plastic receptacle for packaging a plurality of screen protection shield assemblies, a cleaning cloth, an applicator card, and instructions. *Id.* ¶ 51; Figs. 5a, 5b.

c. Analysis

Petitioner argues that Mason I discloses all of the limitations of independent claim 1 and dependent claims 3 and 4, except that Mason I’s

protective film sheets have a dry adhesive instead of a wet adhesive covered by a peel-away film. Pet. 28, 45–47. Petitioner cites to Thomas’s shield assembly to teach that use of protective overlay sheets having a wet adhesive covered by a removable backing was known. *Id.* at 29. Petitioner argues that substituting Thomas’s shield assembly with wet adhesive for Mason I’s film sheet with dry adhesive would have been obvious because it avoids the necessity and mess of using a liquid to activate the dry adhesive. *Id.* at 27.

Upon review of Petitioner’s evidence and analysis, we determine that Petitioner has established by a preponderance of the evidence that claims 1, 3, and 4 are unpatentable over a combination of Mason I and Thomas. As discussed above, Mason I discloses a package that includes: a screen protector, which has an adhesive layer; a peel-away cover film; a cloth; an application card; and a liquid cleaning solution. As also discussed above, Thomas discloses a similar protective transparent overlay sheet that is secured to a display screen by a wet-adhesive, after a removable backing sheet is peeled away. We agree with Petitioner that it would have been obvious to one of ordinary skill in the art to use the wet-adhesive with removable backing sheet disclosed in Thomas with the screen protector of Mason I to avoid the necessity and mess of using a liquid to activate a dry adhesive.

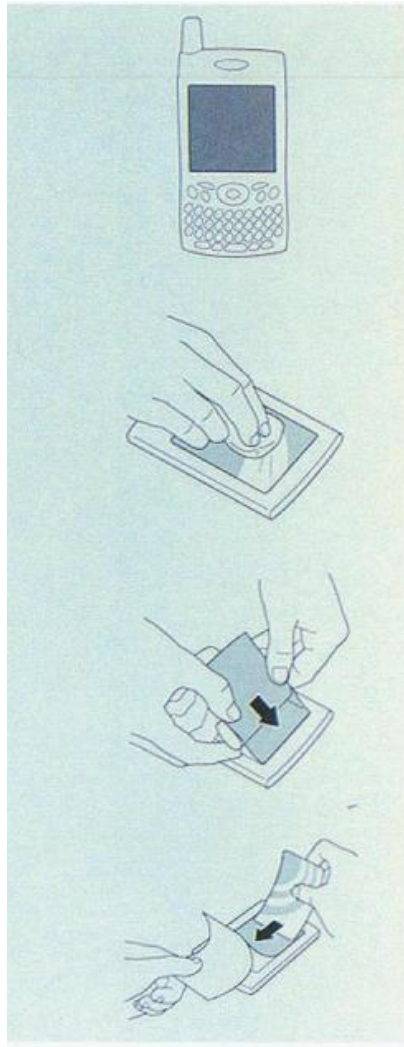
Patent Owner argues that claims 1, 3, and 4 are patentable over Mason I and Thomas because Mason I is not prior art and Thomas, alone, does not disclose all of the claimed elements. PO Resp. 4–8. Patent Owner argues that Mason I is not prior art because the ’596 patent is entitled to a priority date of Mason I’s filing date. As discussed above, claims 1, 3, and 4 of the ’596 patent are not entitled to the priority date of the filing date of Mason I.

Mason I issued on June 24, 2008, more than one year prior to the August 13, 2010 filing date of the '596 patent and is thus available as prior art under 35 U.S.C. § 102(b).

D. Claim 1 as Anticipated by PALM

a. Overview of PALM

PALM is a series of photographs of a package of anti-glare screen protectors that are pre-cut to fit a PALM™ Treo's screen. Ex. 1010, 1. The package includes printed information and a figure. The printed information states that the package includes two screen protectors, a cleaning cloth, and an application card. *Id.* at 2. The figure from PALM is reproduced below.



The figure depicts the application of the screen protector to the Treo's screen. To apply the screen protector, the figure depicts first cleaning the screen with the cloth. *Id.* at 5. The figure then depicts a first edge of the screen protector being aligned with the screen while a first portion of a cover sheet is peeled away. *Id.* The cover sheet then is depicted as being removed while the card is used to secure the screen protector to the screen. *Id.*

b. Claim 1

Petitioner argues that PALM anticipates claim 1 because PALM describes each and every element. Pet. 41–43. In particular, Petitioner

argues that PALM describes an electronic device, a package, a film sheet with an adhesive layer, a peel-away cover film, and an application element as required by claim 1. *Id.*

Upon review of Petitioner's evidence and analysis, we determine that Petitioner has established by a preponderance of the evidence that claim 1 is anticipated by PALM. As discussed above, the written material on the PALM package describes and the figure depicts that the package includes: a screen protector, which is pre-cut to fit a screen of a Treo and which has an adhesive layer; a peel-away cover film; a cloth; and an application card. Ex. 1010, 1, 4–5.

Patent Owner argues that Petitioner fails to demonstrate that the PALM package is prior art. PO Resp. 4–5⁶; Mot. 10–12. Petitioner responds that indicia on the PALM package and the declarations of Ms. Veals and Ms. Robbins⁷ sufficiently establish that the PALM package was publicly disseminated prior to the critical date. Pet. Reply 21–22; Opp. 9–12. According to Patent Owner, however, the declarations of Ms. Veals and Ms. Robbins fail to establish that they have personal knowledge of a specific sale or receipt by a customer of PALM and, thus, fail to provide sufficient detail to convincingly demonstrate that PALM was publicly disseminated

⁶ Patent Owner's Response improperly incorporates its arguments regarding whether PALM is prior art from the Motion to Amend. *See* 37 C.F.R. § 42.6(a)(3) ("Arguments must not be incorporated by reference from one document into another document."). Nonetheless, we have considered Patent Owner's argument. *See* 37 C.F.R. § 42.5(b).

⁷ Patent Owner indicates in its Motion to Amend that it objects to Petitioner's declaration evidence and that it intends to file a motion to exclude. Mot. n. 2. Patent Owner, however, did not timely object to the declaration evidence or file a motion to exclude by the due date set in the Scheduling Order. *See* 37 C.F.R. § 42.64; Paper 14, 5.

prior to April 1, 2006. PO Resp. 4–5; Mot. 10–12. Patent Owner further argues that “reliance on the copyright date is equally unavailing.” PO Resp. 5; *see* Mot. 10.

The determination of whether a given reference qualifies as a prior art “printed publication” involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). The key inquiry is whether the reference was made “sufficiently accessible to the public interested in the art” before the critical date. *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989); *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981). “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006) (citation omitted).

As discussed above, we determined that claims 1, 3, and 4 of the ’596 patent were entitled to a filing date of August 13, 2010 and not entitled to a priority date of April 1, 2006, the filing date of Mason I or Mason II.

Printed on the PALM package are bar codes, stock-keeping unit (“SKU”) numbers, and a 2005 copyright notice. Ex. 1010, 2. Both Ms. Veals and Ms. Robbins testify that they have personal knowledge of the facts to which they testify. Ex. 1020 ¶ 1; Ex. 1021 ¶ 1. Ms. Robbins indicates that she was employed by Palm in 2005 (Ex. 1020 ¶¶ 2–4) and testifies that the photographs⁸ attached to her Declaration show kits sold by

⁸ Attached to the Declaration of Ms. Veals are photographs of the package of the PALM kit that appear to be identical to the photographs of Exhibit 1010.

Palm, Inc. “at least as early as June 2005” (*id.* ¶¶ 5–6). Ms. Veals indicates that since 1998 she has been employed by Superior Communication in various purchasing related positions (Ex. 1021 ¶¶ 2, 4) and that “at least as early as 2005” she was involved in the purchase for sale of Palm, Inc., kits shown in the photographs attached to her Declaration (*id.* ¶ 5). We determine that this evidence sufficiently establishes that the PALM package depicted in the photographs was sufficiently accessible to the interested public prior to the critical date.

III. MOTION TO AMEND

Patent Owner’s Motion to Amend seeks to substitute new claims 19–32 for original claims 2 and 5–18. Mot. 1–3. For the reasons discussed below, Patent Owner’s Motion to Amend is denied.

As the moving party, the patent owner “has the burden of proof to establish that it is entitled to the requested relief.” *See* 37 C.F.R. § 42.20(c). Rule 42.20(c) places the burden on the patent owner to show a patentable distinction on each proposed substitute claim over the prior art. While not required to prove that the claims are patentable over every item of prior art known to a person of ordinary skill, the patent owner is required to explain why the claims are patentable over the prior art of record. *Microsoft Corp. v. Proxycorr, Inc.*, 789 F.3d 1292, 1307–8 (Fed. Cir. 2015) (affirming the Board’s denial of a motion to amend claims where the patent owner failed to establish the patentability of the substitute claims over the prior art of

See Ex. 1021, 3–7. Attached to the Declaration of Ms. Robbins are photographs of a PALM kit that appears to be the same kit as the PALM kit photographed in Exhibit 1010. *See* Ex. 1020, 3–8.

record); *see also Masterimage 3D, Inc. v. Reald, Inc.*, Case IPR2015-00040, slip op. at 2 (PTAB July 15, 2015)(Paper 42) (explaining that prior art of record includes any material art of record in the current proceeding, including art asserted in grounds on which the Board did not institute review).

i. Substitute Claims 19 and 22–32

a. Independent Claims 19, 22, and 29

Substitute claim 19 corresponds to original dependent claim 2, rewritten in independent form and with added subject matter, shown underlined in the reproduced claim below. Mot. 1

19. A kit for protecting a surface of an electronic device, comprising:

a film sheet cut to a specific size and shape corresponding to a size and shape of a surface of an electronic device the film sheet is configured to protect;

an adhesive layer on one side of the film sheet;

a peel-away cover film impermanently secured to the adhesive layer;

an application element for removing air bubbles between the film sheet and a surface of an electronic device as the film sheet is applied to the electronic device; and

a package containing the film sheet and the application element;

wherein the peel-away cover film includes two portions and perforations defining a boundary between the two portions, each portion of the two portions being configured to be peeled away from the adhesive layer without disturbing another portion of the two portions, wherein the first portion comprises less than half of the total surface area of the peel-away cover and the second portion comprises greater than half of the total surface area of the peel-away cover, the first portion having a longitudinal length substantially equal to a length of a display of the electronic device.

Ex. 2001, 2–3.

Substitute claim 22 corresponds to original independent claim 8, with added subject matter, shown underlined in the claim reproduced below. Mot. at 2.

22. A combination electronic device and a kit for protecting a surface of an electronic device, the combination comprising:
- an electronic device with a display surface having a specific size and shape; and
 - a kit, including:
 - a film sheet cut to a specific size and shape that corresponds to the specific size and shape of the display surface of the electronic device;
 - an adhesive layer on one side of the film sheet,
 - a single peel-away cover film cut to a specific size and shape that corresponds to the film sheet, said cover film impermanently secured to the adhesive layer, wherein the peel-away cover film comprises a side strip separate from a main body, wherein each of the side strip and the main body are configured to be peeled away from the adhesive layer without disturbing the other portion of the cover film, the main body comprising a rectangle having a top length and a side length, the side strip comprising (i) a longitudinal length substantially equal to a side length of the main body, and (ii) a top length smaller than the top length of the main body;
 - an application element for removing air bubbles between the film sheet and a surface of an electronic device as the film sheet is applied to the electronic device; and
 - a package carrying the application element and the film sheet with the adhesive layer and the peel-away cover film.

Ex. 2001, 3–4.

Substitute claim 29 corresponds to original independent claim 15, with added subject matter, shown underlined in the reproduced claim below. Mot. at 2.

29. A method for protecting a screen of an electronic device, comprising:

removing from a package a film sheet cut to a specific size and shape of the screen of the electronic device the film sheet is configured to protect and an application device, the film sheet comprising a cover sheet cut to a specific size and shape that corresponds to the film sheet, said cover film having a side strip corresponding to a first portion of the film sheet and a main body corresponding to a second portion of the film sheet, wherein the side strip has a longitudinal length substantially similar to a length of the screen of the device;

placing the film sheet into contact with the screen with the cover sheet between the film sheet and the screen;

moving the film sheet to achieve registration between the film sheet and the screen;

pinning the second portion [of the] film sheet to the screen;

peeling the side strip of the cover sheet away from the film sheet to expose an adhesive;

pressing the adhesive to the screen to adhere the first portion of the film sheet to the screen and to fix registration between the first portion [of the] film sheet and the screen;

with the first portion of the film sheet adhesively secured to the screen, lifting the second portion of the film sheet away from the screen while peeling away the main body of the cover sheet to expose a remainder of the adhesive; and

pressing the adhesive of the second portion of the film sheet to the screen.

Ex. 2001, 5.

As can be seen from the above, Patent Owner added features to these substitute claims, which further require that the cover film/sheet have a first portion and second portion (i.e., a main body and a side strip) and a specific geometry. The claimed geometry is depicted in Figure 6 of the '596 patent,

reproduced above. Patent Owner argues that none of the prior art of record discloses or teaches these added features. Mot. 16–20; PO Reply 7–12.

Petitioner argues that Patent Owner has not demonstrated that the added features are patentable over Mason I, Thomas, PALM, and Mase. Opp. 12–23. In particular, Petitioner argues that the added features are obvious over Thomas, PALM, and Mase. *Id.* We are persuaded by Petitioner that Patent Owner fails to sufficiently demonstrate that the added features are patentable over the prior art of record. Although none of Thomas, PALM, and Mase, individually, discloses the claimed features, Patent Owner has not sufficiently established that the added features would have been unobvious to one of ordinary skill in the art, given the teachings of these references.

As depicted in Thomas’ Figure 3e, reproduced and discussed above, Thomas discloses a transparent overlay sheet that has an adhesive layer covered by a removable backing sheet. Ex. 1004 ¶ 43. Thomas discloses peeling away portions of the transparent overlay sheet from a removable backing sheet, using a scored edge, so that the exposed portion of the transparent overlay sheet may be secured to a display screen prior to removal of the remainder of the removable backing sheet. *Id.* ¶¶ 43–45.

Thomas states:

Removable backing sheet 14 is not limited to one single sheet. Rather, it is fully contemplated that removable backing sheet 14 can be comprised of multiple sheets to facilitate easier removal from transparent overlay sheet 12, similar to that of a name tag.

Id. ¶ 34.

Similarly, Mase discloses a screen protector film that has multiple layers. Ex. 1009 ¶ 22.⁹ Figure 1 of Mase is reproduced below.

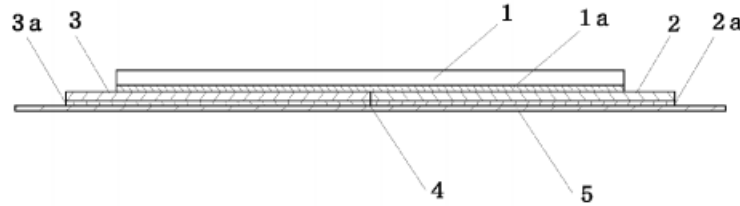


Fig. 1

Figure 1 depicts a sectional view of the protective film set. The film set includes first film peeling layer 5; first adhesive layer 2a, 3a; second film cleaning layer 2, 3; second adhesive layer 1a; and third film protective layer 1. *Id.* The first adhesive layer and second film cleaning layer is divided by cut 4. *Id.* ¶ 24.

To apply film protective layer 1 to a screen of an electronic device, first, half of film peeling layer 5 is peeled back to expose adhesive layer 2a and cleaning film layer 2, which are then positioned on the screen. *Id.* ¶ 30. The remaining portion of film peeling layer 5 is then removed, and the now-exposed adhesive layer 3a and cleaning film layer 3 can contact the screen. *Id.* ¶ 30; Fig. 5. Next, first adhesive layer 2a and cleaning film layer 2 are peeled away, exposing half of adhesive layer 1a and protective film layer 1. *Id.* ¶¶ 31–32; Fig. 6. This half of adhesive layer 1a and protective film layer 1 are then placed on the screen. *Id.* ¶ 32; Fig. 7. Adhesive layer 3a and cleaning film layer 3 are then peeled away and the exposed remaining

⁹ Paragraph 22 mistakenly refers to the first film peeling layer as item 6 instead of item 5, as shown in Figure 1, and the first adhesive layer as item 2a, 2b instead of item 2a, 3a, as shown in Figure 1. We will refer to the numbering as shown in Figure 1.

portion of adhesive layer 1a and protective film layer 1 are then placed on the screen. *Id.* ¶ 33; Figs. 8–10. Mase teaches that this application is easier and more accurate because the applicer only has to work with half of the film at one time. *Id.* ¶¶ 6, 9, 32, and 34.

Likewise, as depicted in PALM’s figure, reproduced and discussed above, PALM discloses peeling away a smaller portion (i.e., a strip) of the cover sheet from the screen protector. Ex. 1010, 5. The remaining larger portion of the cover sheet is then peeled away from the screen protector as the screen protector is applied to the screen. *Id.* The cover sheet has a size and shape that corresponds to the screen protectors. *Id.*

Given the teachings of Thomas, Mase, and PALM discussed above, we are not persuaded by Patent Owner that the features added to substituted claims 19, 22, and 29 are patentable over the prior art of record. Although the Patent Owner argues that none of Thomas, Mase, or PALM, individually, discloses the added features (*see e.g.*, Mot. 17), Patent Owner does not adequately address why the added features would not have been obvious to one of ordinary skill in the art, particularly given the disclosures discussed above. The mere existence of differences between the prior art and the claim does not establish nonobviousness. *Dann v. Johnston*, 425 U.S. 219, 230 (1976). The issue is “whether the difference between the prior art and the subject matter in question ‘is a difference sufficient to render the claimed subject matter unobvious to one skilled in the applicable art.’” *Dann*, 425 U.S. at 228–29 (citation omitted).

Further, we are not persuaded by the testimony of Patent Owner’s declarant, Mr. Jim Colby, that one of ordinary skill in the art would not have found the added features obvious. *See Colby Decl.* ¶ 9. As Petitioner points

out (Opp. 4–6), although Mr. Colby testifies that he “considers [himself] to be a person of ordinary skill with the technology disclosed” in the ’596 patent, Mr. Colby provides no testimony as to his level of education or knowledge, other than to state that he has been employed by Patent Owner as a senior product manager for the past two years. *See* Colby Decl. ¶¶ 2, 4. Additionally, Mr. Colby states that he is not aware of any prior art or knowledge in the art that would motivate a person to arrive at the added features of the substitute claims (*id.* ¶ 9). Mr. Colby’s declaration, however, does not indicate whether he was aware of the teachings of Thomas, Mase, or PALM discussed above.

We determine that Patent Owner fails to establish that substitute claims 19, 22, and 29 are patentable over the prior art of record.

b. Dependent Substitute Claims 23–28 and 30–32

Patent Owner contends that substitute claims 23–28 and 30–32 are patentable because they depend from substitute claims 22 or 29. Mot. 19–20. As discussed above, however, we determined that Patent Owner has not established that substitute claims 22 or 29 are patentable over the prior art of record. Patent Owner thus fails to establish that substitute claims 23–28 and 30–32 are patentable over the prior art of record.

ii. Substitute Claims 20 and 21

a. Independent Claim 20

Substitute claim 20 corresponds to original dependent claim 5, rewritten in independent form and with added subject matter, which is shown underlined in the reproduced claim below.

20. A kit for protecting a surface of an electronic device, comprising:

a film sheet cut to a specific size and shape corresponding to a size and shape of a surface of an electronic device the film sheet is configured to protect;

an adhesive layer on one side of the film sheet,

a peel-away cover film impermanently secured to the adhesive layer;

an application element for removing air bubbles between the film sheet and a surface of an electronic device as the film sheet is applied to the electronic device, wherein the application element has a contact edge length smaller than a largest linear dimension of the surface of the electronic device; and

a package containing the film sheet and the application element, wherein the application element is disposed within a first pocket of a molded support card and the film sheet is disposed with in [a] second pocket of the molded support card; and

a liquid solution disposed in a recess of the package, said liquid solution secured in said recess by a plurality of tabs extending over the opposing sides of said recess.

Ex. 2001, 3.

Patent Owner contends that claim 20 is patentable because the prior art of record does not disclose the additional subject matter underlined above. Mot. 13–15; PO Reply 6–7. Petitioner responds that “based on the false premise that Mason I is not prior art, Patent Owner does not consider Mason I” and that Mason I discloses the additional subject matter. Opp. 7–9 (citing Ex. 1002, Figs 1, 2); *see id.* at 13. Patent Owner counters that Mason I is not prior art to substitute claim 20. PO Reply 6–7.

Substitute claim 20 recites the same peel-away cover film feature recited by original claim 1. As discussed above, neither Mason I nor Mason II provides adequate written description support for claim 1’s kit having this

peel-away cover film feature, and thus claim 1 of the '596 patent is entitled to its August 13, 2010, filing date and not to a priority date of the filing date of parent patents Mason I or Mason II. For the same reasons, we determine that neither Mason I nor Mason II provides adequate written description support for substitute claim 20's kit having the same peel-away cover film feature. Accordingly, substitute claim 20 is entitled to the August 13, 2010, filing date of the '596 patent and not to a priority date of the filing date of parent patents Mason I and Mason II. Mason I is available as prior art to claim 20 under 35 U.S.C. § 102(b).

Mason I discloses the subject matter of features added to substituted claim 20. Mason I discloses a molded support card 10 having two pockets 12 and 14 separated by a molded recess 16. Ex. 1002, col. 4, ll. 15–19; Fig. 1. Pocket 12 contains a plurality of film sheets 20. *Id.* at col. 4, ll. 20–21. Pocket 14 contains a miniature squeegee 40. *Id.* at col. 4, ll. 48–49. Molded recess 16 contains a spray bottle 30 of cleaning and activating solution 32, which is secured by tab 18. *Id.* at col. 4, ll. 38–39 and 53–55.

We thus determine that Patent Owner fails to establish that substitute claim 20 is patentable over the prior art of record.

b. Substitute claim 21

Patent Owner contends that substitute claim 21 is patentable because it depends from substituted claim 20. Mot. 16. As discussed above, however, we determined that Patent Owner has not established that substitute claim 20 is patentable over the prior art of record, and Patent Owner thus fails to establish that substituted claim 21 is patentable over the prior art of record.

IV. CONCLUSION

We determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 3, and 4 are obvious over Mason I and Thomas and that claim 1 is anticipated by PALM.

We also determine that Patent Owner fails to demonstrate that proposed substitute claims 19–32 are patentable.

This is a Final Written Decision of the Board under 35 U.S.C. § 318(a). Parties to the proceeding seeking judicial review of this Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 3, and 4 of U.S. Patent No. 8,567,596 B1 are *unpatentable*; and

FURTHER ORDERED that Patent Owner's Motion to Amend is *granted* as to its request to cancel claims 2 and 5–18 of the '596 patent and claims 2 and 5–18 are hereby canceled; and

FURTHER ORDERED that Patent Owner's Motion to Amend is *denied* as to its request to add proposed substitute claims 19–32.

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Patent 8,567,596 B1

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