

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACCO BRANDS CORPORATION AND
ACCO BRANDS USA LLC,
Petitioner,

v.

THINK PRODUCTS, INC.,
Patent Owner.

Case IPR2015-01167
Patent 8,717,758 B2

Before RICHARD E. RICE, SCOTT A. DANIELS, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

ACCO Brands Corporation and ACCO Brands USA LLC (“Petitioner”) filed a corrected Petition to institute an *inter partes* review of claims 1–7, 9–14, and 16 (Paper 4; “Pet.”) of 8,717,758 B2, issued May 6, 2014 (Ex. 1001; “the ’758 patent”). Think Products, Inc. (“Patent Owner”) filed a Patent Owner Preliminary Response. Paper 12 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Upon consideration of the above-mentioned Petition and Preliminary Responses, we conclude that Petitioner has established that there is a reasonable likelihood that it will prevail with respect to at least one of the challenged claims. We institute an *inter partes* review as to claims 1–7, 9–14, and 16 of the ’758 patent.

A. *Related Matters*

According to Petitioner, the ’758 patent is involved in the following co-pending case: *Think Products, Inc. v. ACCO Brands Corp.*, Case No. 2:14-cv-06659 (E.D.N.Y.). Pet. iv. Petitioner has also requested *inter partes* review of related Patent US 8,837,144 B1, which has substantially the same specification as the ’758 patent at issue here. *See* Case IPR2015-01068, Paper 4.

B. *The ’758 patent (Ex. 1001)*

The ’758 patent, entitled “Locking Assembly for Electronic Tablet and Other Devices,” relates to locking assemblies for laptop and tablet computers, smart phones, electronic books, and other hand-held electronic

devices. Ex. 1001, 1:30–41. The '758 patent discloses a locking assembly comprising a captive security rod and a locking device:

[T]he invention includes a locking assembly for securing a portable electronic device having at least one housing to a substantially immovable object. The locking assembly includes *a captive security rod* having a locking end and an anchoring end, wherein the anchoring end is passed through the at least one housing to anchor the captive security rod thereto and a locking device with a locking mechanism, *wherein the locking device is configured to receive the locking end of the captive security rod to activate the locking mechanism and thereby lock the security rod and portable electronic device to the locking device.*

Id. at 5:10–21 (emphasis added); *see also id.* at 4:67–5:7 (corresponding method including step of “inserting the protruding end of the security rod into an opening in the locking device to actuate the internal locking mechanism and lock the locking device to the captive security rod”). Accordingly, the locking end of the captive security rod is received in the locking device to activate a locking mechanism of the locking device and thereby lock the security rod to the locking device. *Id.*

C. Illustrative Claims

Independent claim 1 is illustrative of the challenged claims, and is reproduced below:

1. A locking assembly for securing a portable electronic device having at least one housing to a substantially immovable object, the locking assembly comprising:
 - a captive security rod having a locking end and an anchoring end, wherein the anchoring end is passed through the at least one housing to anchor the captive security rod thereto;

said captive security rod partially in said at least one housing and partially out of said at least one housing during and before locking use; and
a locking device with a locking mechanism, wherein the locking device is configured with an opening to receive the locking end of the captive security rod to activate the locking mechanism, where the activation causes the locking mechanism to securely grasp the locking end and thereby lock the security rod and portable electronic device to the locking device.

The remaining challenged claims depend from claim 1, with the exception of claim 16, which recites a method for securing a portable electronic device using language similar to that of claim 1.

D. Prior Art and Supporting Evidence

Pursuant to 37 C.F.R. § 42.104(b), Petitioner identifies the following prior art as the basis of challenging claims 1–7, 9–14, and 16 of the '758 patent. *See* Pet. 5–6.

McDaid et al., U.S. Patent No. 6,360,405 B1, issued Mar. 26, 2002. Ex. 1008 (“McDaid”).

Chen, U.S. Patent No. 5,829,280, issued Nov. 3, 1998. Ex. 1009 (“Chen”).

Cheng, U.S. Patent No. 5,447,045, issued Sept. 5, 1995. Ex. 1010 (“Cheng”).

Lee, U.S. Patent No. 7,073,358 B1, issued July 11, 2006. Ex. 1012 (“Lee”).

ClickSafe video (Ex. 1013), available online as early as October 12, 2010, and illustrated by still images therefrom (Ex. 1014). (Collectively, “ClickSafe”).

Petitioner further relies on Exhibit 1021, the Declaration of its expert, Ryan White; and, with respect to the provenance of Exhibits 1013 and 1014, on Exhibit 1015, the Declaration of Robert Humphrey. Petitioner also relies on a number of supplementary references, which are discussed herein only to the extent they provide relevant background or clarification of the asserted references.

E. Asserted Grounds

Petitioner challenges claims 1–7, 9–14, and 16 of the '758 patent on the following grounds. Pet. 2–3, 38–58.

Reference[s]	Basis	Claims challenged
ClickSafe	§ 102(a)	1–7, 9–13, and 16
ClickSafe and McDaid	§ 103(a)	14
McDaid and Chen	§ 103(a)	1–7, 9–14, and 16
McDaid and Cheng	§ 103(a)	1–7, 9–14, and 16
McDaid and Lee	§ 103(a)	1–7, 9–14, and 16

II. ANALYSIS

A. Claim Interpretation

We interpret claim terms in an unexpired patent 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); *see In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271, 1278–82 (Fed. Cir. 2015). Under this standard, 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). “Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification . . . when [it] expressly disclaim[s] the broader definition.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). “Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner, supported by testimony from its declarant, Ryan White, contends that a person of ordinary skill in the art (“POSA”) would have had “at least an undergraduate degree in industrial design or mechanical engineering, and about two years of experience designing locking devices for portable electronic equipment such as laptop computers, or equivalent experience.”¹

¹ We confess confusion regarding Patent Owner’s argument that Mr. White’s testimony is not relevant because he “is an actual person, not a ‘hypothetical’ one.” *See* Prelim. Resp. 15–16. Having reviewed Mr. White’s declaration, we find no reason to question his qualifications as an expert in the relevant field, or that his opinions are properly drawn from the perspective of one of ordinary skill in the art. Indeed, Mr. White expressly states that he applied this definition of POSA throughout his analysis. *See e.g.*, Ex. 1021 ¶ 14; *see also Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1361 (Fed. Cir. 2008) (Validity “[is] analyzed in great part from the perspective of a person of ordinary skill in the art, and testimony explaining the technical evidence from that perspective may be of great utility to the factfinder.”); *id.* at n.3.

Pet. 3–4 (citing Ex. 1021 ¶¶ 13, 14). Patent Owner does not dispute Petitioner’s contention. Prelim. Resp. 1–17. For purposes of this Decision, we adopt Petitioner’s definition of a POSA.

We address the claim terms below as part of our analysis. *See, e.g., Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

1. “captive security rod”

Neither party provides an express definition of the claim term “captive security rod.” We, nevertheless, interpret this term because it is central to our discussion of the earliest-possible effective filing date of the challenged claims, set forth *infra* in Section II(B).

The Specification of the ’758 patent describes a method for securing a portable electronic device to a substantially immovable object using “a locking assembly having a security rod or spike² formed with an anchoring end separated axially by a protruding end, a locking device with an internal locking mechanism and a cable permanently attached to the locking device.” Ex. 1001, 4:60–67. This embodiment comprises:

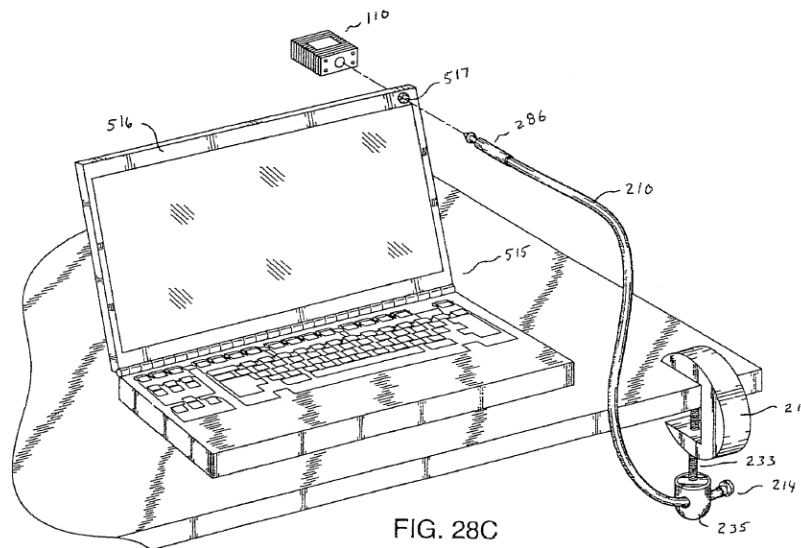
² As Patent Owner notes, a “rod” is commonly understood to mean “a straight, slender stick of wood, metal, or other material.” Prelim. Resp. 7 (citing *The Random House Dictionary*, 764 (1990)). The term “spike” may be defined as “a long metal nail used to hold something in place, or a shape that is long and narrow and comes to a point at one end.” *Cambridge Dictionaries Online*, available at <http://dictionary.cambridge.org/us/dictionary/english/spike> (last visited Oct. 2, 2015).

[S]ecuredly fixing the anchoring end of the security rod or spike to the portable electronic device upon or through the housing, attaching an other [sic] end of the cable to the substantially immovable object and inserting the protruding end of the security rod into an opening in the locking device to actuate the internal locking mechanism and lock the locking device to the captive security rod.

Id. at 4:67–5:7. In this embodiment, “[t]he security rod or spike has a protruding end, an anchoring end opposite the protruding end and a transverse hole positioned between the protruding end the anchoring end.”

Id. at 5:59–61. The anchoring end of the security rod or spike “is configured for passing through an opening in the housing to anchor the security rod to the portable electronic device.” *Id.* at 5:62–64.

Our understanding of the claim terms is informed by the embodiments illustrated in Figures 28–30 of the Specification. Figure 28C, reproduced below, illustrates an embodiment that employs neither a “security rod nor spike” nor a “captive security rod.”



Rather, the locking mechanism illustrated in Figure 28C illustrates ferrule 286 passaging through hole 517 to engage pin lock 110. Ex. 1001, 8:4–6, 14:4–18; *see* Ex. 1021 ¶¶ 54–55.

Figure 29, reproduced below, employs a “locking rod or spike” to affix the locking mechanism to a device.

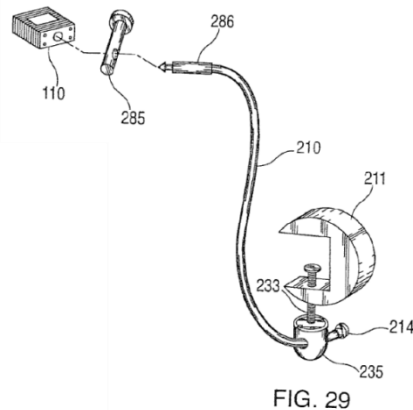


Figure 29 shows “locking rod or spike 285,” which is inserted in a hole in notebook computer or other personal electronic device. “Ferrule 286 . . . is then inserted through the transverse hole of spike 285 and locked with pin lock 110.” *Id.* at 14:19–27; *see* Ex. 1021 ¶¶ 56–57.

Figure 30 of the Specification, reproduced below, employs a “captive security rod.”

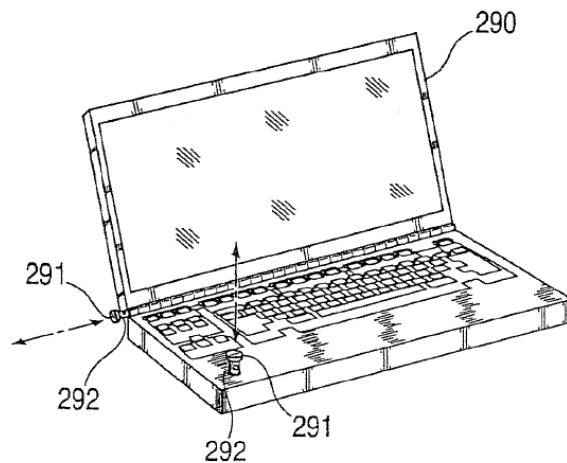


FIG. 30

In particular, Figure 30 shows “a variation of [the embodiment shown in Figure 29, in which] the separate spike **285** is replaced by a captive security rod **291**.” *Id.* at 14:28–29; *see id.* at 8:14–15; Ex. 1021 ¶ 58. The Specification teaches that:

[R]ods **291** are stored in a recessed position with only a small knob protruding so that they may be easily grasped to unlock into the extended position to expose a transverse hole. Ferrule **286** and lock **110** are then used in the same manner as with the separate spike **285**

of Figure 29, i.e., ferrule 286 passes through hole (292) to engage pin lock 110. Ex. 1001, 14:33–45; *see* Ex. 1021 ¶ 59.

As noted by Petitioner’s expert, “rod 291 is [] described as ‘captive’ because, unlike the embodiments of Figs. 28A-D in which a ferrule moves freely through a hole in a laptop housing, the rod 291 is mounted (i.e., “captive”) in the laptop housing.” Ex. 1021 ¶ 59. Consistent with this interpretation, the Specification teaches that “[t]he captive security rod, upon anchoring to the at least one housing of the portable electronic device, is stored in a recess and grasped to deploy in an extended position” (Ex. 1001, 5:32–34; *see id.* at 5:47–50) or “fixedly inserted through a surface of said second housing” (*Id.* at 6:20–22).

In light of the above, we interpret “captive security rod” to mean, “a rod-shaped portion of a locking assembly, wherein the rod is anchored to the housing of a portable electronic device.”

2. *“wherein the locking device is configured with an opening to receive the locking end of the captive security rod to activate the locking mechanism, where the activation causes the locking mechanism to securely grasp the locking end and thereby lock the security rod and portable electronic device to the locking device”*

Having construed the term “captive security rod,” we find that further construction of this claim language is unnecessary. We, nonetheless, note that Petitioner’s proposed construction that “the locking device has an opening into which the locking end of the captive security rod fits, and upon insertion of the captive security rod in the locking device, the rod becomes locked in the locking device” is not inconsistent the plain meaning of this phrase in claim 1. *See* Pet. 5. The meaning of the corresponding language of method claim 16 (“inserting the protruding end of the captive, security rod into an opening in the locking device to actuate the internal locking mechanism and lock the locking device to the captive security rod”) is also plain on its face.

3. *“means for securing the locking device . . . to a substantially non-movable object”*

Petitioner contends that this term should be interpreted as a means plus function term under 35 U.S.C. § 112, ¶ 6, wherein “[t]he structure for performing the recited function must include ‘a cable or a lanyard.’” Pet. 7–

8. In contravention of 37 C.F.R. § 42.104(b)(3)³, Petitioner bases this argument on the recitation in dependent claim 3 that “the means for securing is a cable or lanyard.” *Id.* at 8. We, nevertheless, note that the Specification recites “means for securing the locking device . . . to a substantially non-movable object, e.g., a cable or lanyard.” Ex. 1001, 5:22–26; *see* Figs. 28C, 29 (cable 210 secured to table top clamp 211). Accordingly, for the purpose of this opinion, we define “means for securing the locking device . . . to a substantially non-movable object” as meaning a cable or a lanyard with, or without, additional clamping elements.

4. “*wherein the small knob that is captured and held by the locking mechanism at locking actuation*”

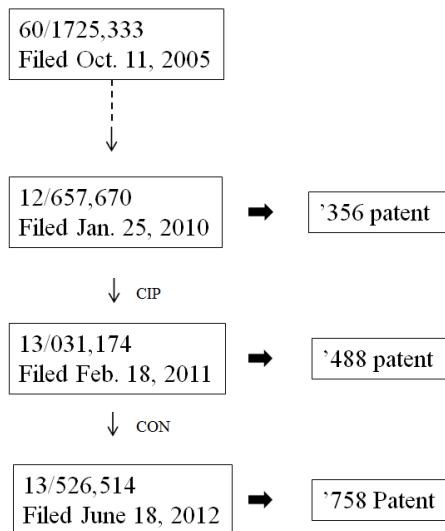
Petitioner contends that the words “small” and “that” in the above-quoted claim phrase appear to be errors in claim drafting. Pet. 8. Absent an alternative interpretation from Patent Owner, we accept Petitioner’s proposed construction of this phrase to mean “wherein the knob is captured and held by the locking mechanism at locking actuation.”

B. Benefit of Priority

As illustrated below, the ’758 patent issued from a chain of U.S. applications including application No. 13/031,174 (“the ’174 application”), filed Feb. 18, 2011, (now U.S. Patent No. 8,223,488 B2 (“the ’488 patent”)),

³ A petition for *inter partes* review “must set forth: . . . How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. § 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function” 37 C.F.R. § 42.104(b)(3).

of which the '758 patent is a continuation (“CON”); application No. 12/657,670, filed January 25, 2010, (now U.S. Patent No. 8,139,356 B2 (“the '356 patent”), of which the '174 application is a continuation-in-part (“CIP”); and further including a number of U.S. provisional applications, in particular, application No. 60/1725,333, (“the '333 provisional application”), filed October 11, 2005.



Petitioner contends that ClickSafe (available on line as of October 12, 2010) qualifies as prior art because “the challenged claims are not entitled to a priority benefit date earlier than February 18, 2011 (the filing date of the application that issued as U.S. Patent No. 8,223,488 B2, of which the '758 patent is a continuation).” Pet. 11–12. In particular, Petitioner argues that the figures and text of the earlier '356 patent fail to disclose “a captive security rod . . . and a locking device with a locking mechanism including an opening to receive the locking end of the captive security rod, where the insertion of the locking end of the captive security rod in the opening activates and locks the locking mechanism,” as required by the challenged

claims. *Id.* at 12–19; *see* 35 U.S.C. § 120; *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997) (holding that “to gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement”).

Patent Owner responds that ClickSafe does not qualify as prior art because the challenged claims are entitled to benefit of priority extending to the October 11, 2005, filing of ’333 provisional application.⁴ Prelim. Resp. 8–15. In support of this position, Patent Owner relies on disclosure in that application “illustrated by FIGS. 28 - 30 of the [’333] provisional patent application, which drawing figures are substantially the same as FIGS. 28, 28A, 28B, 28C and 29 of [the ’758 patent].” *Id.* at 9–13; *see also* Ex 1021, ¶ 47 (comparing figures of the ’758, ’356, and ’144 patents).

As is evident from our discussion of Figures 28C, 29, and 30 of the ’758 patent in section II(A), above, we do not discern where the figures relied on by Patent Owner disclose a “captive security rod to activate the locking mechanism,” as required by independent claim 1, nor the step of “inserting the protruding end of the captive[] security rod into an opening in the locking to device to actuate the internal locking mechanism and lock the locking device to the captive security rod” as recited in independent claim 16. Most notably, neither the ’333 provisional application, nor the ’356 patent, include disclosure comparable to the ’758 patent’s description of securing a portable electronic device by:

[S]ecuredly fixing the anchoring end of the security rod or spike to the portable electronic device upon or through the

⁴ Patent Owner does not contest the prior art status of McDaid and Chen.

housing, attaching an other [sic] end of the cable to the substantially immovable object and *inserting the protruding end of the security rod into an opening in the locking device to actuate the internal locking mechanism and lock the locking device to the captive security rod.*

See Ex. 1001, 4:67–5:7 (italics added); *see also id.* at 5:10–21 (description of locking assembly including a “locking device [] configured to receive the locking end of the captive security rod to activate the locking mechanism and thereby lock the security rod and portable electronic device to the locking device”).

On the present record, Patent Owner has not demonstrated entitlement to a filing date earlier than February 18, 2011, with respect to the challenged claims.

C. Asserted Grounds of Unpatentability

An *inter partes* review may be instituted only if “the information presented in the [Petition and Preliminary Response] shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). To prevail in its challenges to the patentability of the claims, a petitioner must establish facts supporting its challenges by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

A claim is unpatentable under 35 U.S.C. § 103(a) 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) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“It is well settled that ‘anticipation is the epitome of obviousness.’” *In re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2002) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

1. Anticipation of Claims 1–7, 9–13, and 16 in View of ClickSafe

Petitioner asserts that ClickSafe discloses all limitations of claims 1–7, 9–13, and 16. Pet. 51–56; Ex. 1021 ¶¶ 91–107, 112, 113, 132–35.

As evidence of the ClickSafe video and its publication, Petitioner relies on the Declaration of Robert Humphrey (Ex. 1015). Pet. 32–33 (citing Ex. 1015 ¶¶ 4–8; Exs. 1016–1018). Mr. Humphrey states that he has been employed by Kensington, which is part of ACCO Brands Corporation, since 1994. Ex. 1015 ¶ 1. Mr. Humphrey further states that, from 2009 to 2011, he held the title of “Director – Security Products, Global Business for Kensington,” and that his responsibilities during that period of time included working with development and operational teams to launch Kensington’s ClickSafe® line of computer lock products. *Id.* ¶ 2.

According to Mr. Humphrey’s testimony, (i) “Kensington developed a ClickSafe website to promote the ClickSafe line of computer lock products,” (ii) “[t]his website contained a link to a ClickSafe product video (Exhibit 13) demonstrating the use and functionality of the ClickSafe® Keyed Laptop Lock,” and (iii) “the ClickSafe website was continuously available to the public from the launch date [October 12, 2010] until at least September 3, 2011.” *Id.* ¶¶ 3, 4.

Still frames 11 and 12 from the ClickSafe video, including annotations added by Petitioner, are reproduced below.



Kensington ClickSafe Keyed Laptop Lock

Kensington ClickSafe Keyed Laptop Lock

Ex. 1014, 11–12; Ex. 1015 ¶ 10; *see* Pet. 32–33. Petitioner asserts that, as illustrated in the annotated figures above, the ClickSafe video discloses a locking assembly comprising locking device G with opening H and captive security rod C with locking end D. Pet. 33. Mr. White testifies that the ClickSafe video discloses that the locking end of the captive security rod is received in the opening of the locking device to activate a locking mechanism and lock the captive security rod and the portable electronic device (to which the captive security rod is attached) to the locking device. Ex. 1021 ¶ 95. Another still frame from the ClickSafe video, also including annotations added by Petitioner, is reproduced below.



Ex. 1014, 9. As illustrated in the annotated figure above and asserted by Petitioner, the ClickSafe video discloses that the locking assembly includes a cable for securing the locking device to substantially immovable object F. Pet. 37.

Petitioner contends that the ClickSafe video is a printed publication that was made publicly available at the URL <http://clickittokeepit.com> beginning October 12, 2010, and that the video is prior art to the '144 Patent under 35 U.S.C. § 102(a). Pet. 51–52 (citing *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981); Manual of Patent Examining Procedure (“MPEP”) § 2128 (9th ed. 2014)). On the record at this stage of the proceeding, we agree. As discussed above, Patent Owner has not persuaded us that the challenged claims are entitled to the benefit of the earlier filing date of the '333 Provisional Application. *See supra* Section II(B); Prelim. Resp. 8–14. Accordingly, based on the current record, we agree with Petitioner that ClickSafe qualifies as prior art.

Having considered the Petition, the Preliminary Response, and the evidence of record, we are persuaded that Petitioner has demonstrated a

reasonable likelihood of prevailing with respect to its challenge to claims 1–7, 9–13, and 16 as anticipated by the ClickSafe video.

2. Obviousness of Claim 14 over the Combination of ClickSafe and McDaid

Claim 14 recites: “The locking assembly as set forth in claim 1, wherein the locking device is a pin lock.” Ex. 1003, 20:11–12. Petitioner relies on the ClickSafe video for the limitations of claim 1, from which claim 14 depends, and on McDaid and the knowledge of a POSA for the additional pin lock limitation of claim 14. Pet. 58. Petitioner contends that a POSA would have recognized that the lock mechanism depicted in Figure 1 of McDaid is “a tubular key type pin lock” (*id.* at 27, citing Ex. 1021 ¶ 81), and that a POSA would have known to substitute McDaid’s pin lock for the disk lock depicted in the ClickSafe video, as a lower-cost alternative to the “relatively more expensive disk lock.” *Id.* at 58 (citing Ex. 1021 ¶¶ 143, 144).

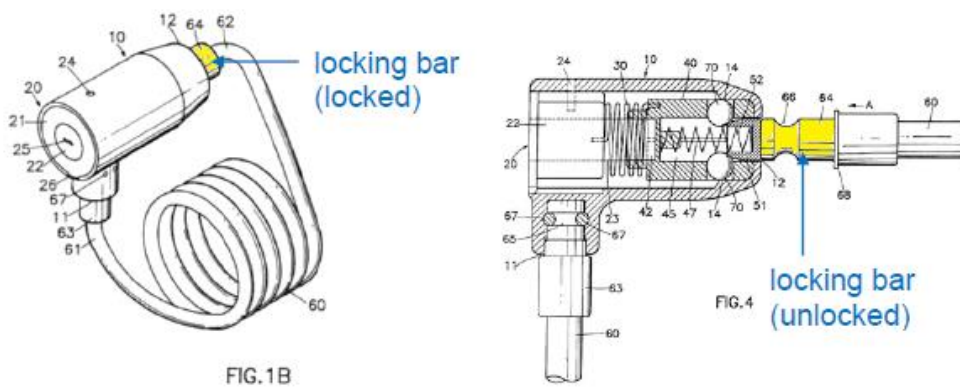
Having considered the Petition, the Preliminary Response, and the evidence of record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to its challenge to claim 14 as obvious over the ClickSafe video and McDaid.

3. Obviousness of Claims 1–7, 9–14, and 16 Over the Combination of McDaid and Chen

Petitioner contends that claims 1–7, 9–14, and 16 would have been obvious in view of the combination of McDaid and Chen. Pet. 20–47. In particular, Petitioner asserts that McDaid discloses all limitations of claims 1–7, 9–14, and 16 except that McDaid teaches the activation of the locking mechanism using a key, rather than by insertion of the captive security rod

as required by the challenged claims. *Id.* at 38–39 (citing *id.* at 20–28 (section IV(B)) and 39–45 (detailed claim chart)).

With respect to activation of the locking mechanism by insertion of the captive security rod, Petitioner relies on Chen’s disclosure of “a cable locking device for use on portable objects such as bicycles.” *Id.* at 28, 45. Chen Figures 1B and 4, as annotated by Petitioner, are reproduced below.



See id. at 29. Figures 1B and 4 show external and internal views, respectively, of Chen’s cable lock assembly. With reference to these figures, Petitioner contends that “Chen discloses a cable lock assembly with a lock that is automatically locked (activated) when a locking bar (referred to as locking head 64) is inserted into the locking device (head hole 12 of main body 10).” *Id.* Thus,

To fasten and lock the cable **60** to the locking device, the user can manually insert the locking head **64** of the cable **60** into the head hole **12** in the main body **10**. By doing this, the locking head **64** is locked to the locking device. The user needs not to use the key of the locking device to turn the inner cylinder **22** and the locking mechanism **40** to the unlocked state in order to receive the locking head **64** as required when using a prior art locking device.

Ex. 1009, 5:49–57. In discussing the advantages of this design, Chen teaches that “the locking device of the invention allows the unfastened cable to be fastened and locked to the main body without having to use the key, allowing the cable locking device of the invention to be quickly put into use.” *Id.* at 7:40–44.

Petitioner contends that it would have been obvious to combine the teachings of McDaid and Chen because both references are directed to cable lock assemblies for use to secure portable articles. Pet. 46. Moreover,

Automatically-activated lock mechanisms, such as those disclosed in Chen, were well known in the art. A POSA would have understood that the Chen lock mechanism was suitable for use in the McDaid locking assembly. In addition, as suggested in Chen and known in the art, an automatic lock mechanism has advantages over key-activated lock mechanisms in that such mechanisms may be locked without the use of a key.

Id. (citing Ex. 1021 ¶ 117).

Patent Owner argues that McDaid teaches away from combination with Chen because “Chen deems it beneficial to have the two ends of the cable locking device to be ‘freely rotatable when the cable is in locked state,’” whereas McDaid “expressly” teaches that rotation of the locking head relative to the anchor (analogized to a captive security rod) “should be avoided to prevent unwanted ‘stresses on the relatively small anchor’” and, thus, “suggests the external member skirt (64) with a series of valleys (66) and peaks (68) for preventing undesirable rotation.” Prelim. Resp. 3–4.

Patent Owner’s argument is based on the following passage from McDaid:

The locking head **104** is composed of a number of components, including a housing **122**, an eyelet **124**, a cup

126, a cylinder **128**, and a barrel **130**. The housing **122** is the outer component of the locking head **104**. The outer end has an opening **132** for receiving the anchor knob **60**. In one configuration, the opening **132** is round to mate with a round external member skirt **64**. *In another configuration, shown in FIGS. 8, the opening 132 is shaped with peaks 134 and valleys 136 to mate with the valleys 66 and peaks 68 of the 20 external member skirt 64 of FIG. 4. With this configuration, the locking head 104 will not rotate relative to the anchor 20 when they are engaged.* By preventing such rotation, stresses on the relatively small anchor **20** caused by moving the portable article **10** while the tether **102** remains attached to **25** the stationary fixture **6** are reduced. Since these stresses are transferred to the portable article **10**, there is less likelihood that inadvertent damage will be caused to the portable article **10**.

Ex. 1008, 6:11–28 (emphases added). Accordingly, the configuration relied on by Patent Owner is but one embodiment disclosed in the referenced passage. It is well established that “[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed.” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Patent Owner further argues that one of ordinary skill in the art would not have combined the teachings of McDaid and Chen because insertion of the locking bar **64** of Chen into the locking head of McDaid would render the combination inoperable and/or change the principle of operation disclosed in McDaid. Prelim. Resp. 4–6. We do not read Petitioner’s argument as requiring the blind insertion of Chen’s locking bar into McDaid’s locking head. And, contrary to Appellants’ argument,

[I]t is not necessary that a device shown in one reference can be physically inserted into the device shown in the other. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

In re Keller, 642 F.2d 413, 425 (CCPA 1981) (citations omitted); *see also KSR*, 550 U.S. at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Based on the current record, we conclude that Petitioner has established a reasonable likelihood of prevailing on its assertion that claims 1–7, 9–14, and 16 are unpatentable as obvious over the combination of McDaid and Chen. Patent Owner’s arguments do not persuade us to the contrary. *See KSR*, 550 U.S. at 416 (“If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability.”).

4. Petitioner’s Remaining Grounds

The patent rules promulgated for AIA post-grant proceedings, including those pertaining to institution, are “construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *see also* 35 U.S.C. § 316(b) (regulations for AIA post-grant proceedings take into account “the efficient administration of the Office” and “the ability of the Office to timely complete [instituted] proceedings”). Therefore, we exercise our discretion and, for reasons of administrative necessity to ensure timely completion of the instituted proceeding, do not

institute a review on any ground other than those specifically instituted in the Order below. *See* 37 C.F.R. § 42.108(a).

III. CONCLUSION

We conclude that Petitioner has established a reasonable likelihood of prevailing on its assertions that claims 1–7, 9–14, and 16 of the '758 patent are unpatentable as anticipated and/or obvious.

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim or the construction of any claim term. Thus, our view with regard to any conclusion reached in the foregoing could change upon consideration of Patent Owner's merits response and upon completion of the current record.

IV. ORDER

For the reasons given, it is

ORDERED that the Petition is granted with regard to the following asserted grounds:

- A. Claims 1–7, 9–14, and 16 of the '758 patent under 35 U.S.C. § 103(a) as obvious in view of McDaid and Chen;
- B. Claims 1–7, 9–13, and 16 of the '758 patent under 35 U.S.C. § 102 as anticipated by ClickSafe; and
- C. Claim 14 of the '758 patent under 35 U.S.C. § 103(a) as obvious over the combination of ClickSafe and McDaid.

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '758 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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FURTHER ORDERED that the trial is limited to the grounds listed in the Order. No other grounds are authorized.

PETITIONER:

Michael R. Weiner
Sandip H. Patel
MARSHALL, GERSTEIN & BORUN LLP
mweiner@marshallip.com
spatel@marshallip.com
Docket@marshallip.com

PATENT OWNER:

Edwin D. Schindler
John F. Vodopia
EDSchindler@att.net
jvodopia@gmail.com