

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MULTI PACKAGING SOLUTIONS, INC.,  
Petitioner,

v.

CPI CARD GROUP – MINNESOTA, INC.,  
Patent Owner.

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Case IPR2017-01650  
Patent 8,419,889 B2

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Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,  
and JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION

Instituting *Inter Partes* Review of Claims 1–30  
*35 U.S.C. § 314; 37 C.F.R. § 42.108*

## I. INTRODUCTION

Petitioner filed a Petition for *inter partes* review of claims 1–30 of U.S. Patent No. 8,419,889 B2 (Ex. 1001, “the ’889 patent”). Paper 2 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration that Petitioner is reasonably likely to prevail at trial with respect to at least one challenged patent claim, we institute review of claims 1–30 of the ’889 patent.

The following findings of fact and conclusions of law are not final, but are made for the sole purpose of determining whether Petitioner meets the threshold for initiating review. Any final decision shall be based on the full trial record, including any response timely filed by Patent Owner. Arguments not raised by Patent Owner in a timely-filed response shall be deemed waived, even if they were presented in the Preliminary Response.

Taking account of the information presented in the Petition and the Preliminary Response, we determine that Petitioner shows sufficiently the following facts for the purposes of trial institution.

### A. *Related Proceedings*

Patent Owner asserts claims 1–5, 7, 11, 16–18, 22–27 and 30 against Petitioner in a co-pending district court action. Pet. 3 (citing *CPI Card Group Inc. v. Multi Packaging Solutions, Inc.*, No. 1:16-CV-02536 D. Colo. (filed Oct. 11, 2016)).

### B. *The ’889 Patent (Ex. 1001)*

The ’889 patent is titled “Ultrasecure Card Package.” Ex. 1001, 1:1. The invention “relates generally to secure point-of-sale activated cards”—“such as debit cards, gift cards, credit cards, telephone cards and the like”—

and, specifically, to a method of packaging cards for “enhanced security.”  
*Id.* at 1:12–13, 16–17, 44.

The ’889 patent describes a method of retaining a card between two panels that are secured together by an adhesive. *Id.* at Abstract. The panels may be paper stock that is clay coated on both sides. “[A] heat-activated adhesive” may be “applied directly to the clay coated inner surfaces.” Polyurethane is a suitable heat activated adhesive for use in the claimed method. “The adhesive is applied using known printing techniques” that may involve a “printing roller” or “a Gravure press.” *Id.* at 8:20–36. “The heat activated adhesives . . . are applied to the cardstock in the normal printing process and allowed to dry to be activated later.” *Id.* at 8:45–47. “The heat activated adhesive can be applied to the entire surface of the panel, and only activated selectively by heating only the portions of the panels that are to be bonded.” *Id.* at 8:50–53.

### *C. Illustrative Claims*

Claims 1 and 18 are the only independent claims. Claim 1 is illustrative and reproduced below:

1. A method for producing a secure card package containing a point-of-sale activatable card, comprising:
  - providing a first panel and a second panel each comprising paper stock and having a non-polymeric coated inner surface;
  - printing a heat-activatable adhesive comprising polyurethane directly upon the non-polymeric coated inner surface of the first panel;
  - allowing the heat-activatable adhesive to dry upon the non-polymeric coated inner surface of the first panel;
  - locating a point-of-sale activatable card between the inner surface of the first panel and the inner surface of the

second panel, after the step of allowing the heat-activatable adhesive to dry upon the non-polymeric coated inner surface of the first panel; and,

activating the heat-activatable adhesive, after the locating step, by applying heat and pressure only in a region substantially surrounding and offset from the point-of-sale activatable card to enclose the point-of-sale activatable card in a secure space between the first and second panels.

Ex. 1001, 8:66–9:19.

Claim 18 (the only other independent claim) is similar to claim 1. Claim 18 further specifies that the surfaces of the panels are clay coated and the heat-activatable adhesive comprises polyurethane. *Id.* at 10:7–28.

#### *D. Evidence Relied Upon*

The Petition identifies the following references as prior art in the grounds of unpatentability:

- (1) US Pat. Pub. No. 2006/0151348 A1, patent application to Rick L. Willard, published July 13, 2006 (Ex. 1010, “Willard”);
- (2) US Pat. Pub. No. 2007/0160833 A1, patent application to Kevin D. Maak, et al., published July 12, 2007 (Ex. 1011, “Maak”);
- (3) US Pat. Pub. No. 2007/0034543 A1, patent application to Marty Jones, published February 15, 2007 (Ex. 1012, “Jones”);
- (4) J. Dormish, *Tack Measurement of Heat-Activated Polyurethane Adhesives*, *Adhesives & Sealants Industry* Vol. 12, No. 11 (November 2005) (Ex. 1013, “ASI”);
- (5) US Pat. Pub. No. 2007/0051652, patent application to Christopher R. Tilton, published March 8, 2007 (Ex. 1014, “Tilton”);

(6) US Pat. No. 6,099,682, issued to Stephen E. Krampe, et al., on August 8, 2000 (Ex. 1045, “Krampe”);

(7) US Pat. No. 5,605,230, issued to Michael A. Marino, Jr. on February 25, 1997 (Ex. 1044, “Marino”);

(8) US Pat. No. 5,760,381, issued to Rebecca Stich, et al., on June 2, 1998 (Ex. 1020, “Stich”).

The Petition is supported by the Declaration of Paul Singh, Ph. D. Ex. 1002. For the purposes of this decision, we find that Dr. Singh is qualified to opine from the perspective of a person of ordinary skill in the art at the time of the invention. *See id.* ¶¶ 3–14 (Dr. Singh’s background and qualifications), Appendix A (Dr. Singh’s curriculum vitae).

*E. The Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims 1–30 of the ’889 patent on the following grounds (*see* Pet. 5 (grounds chart)):

<b>Claims</b>	<b>Basis</b>	<b>References</b>
1–3, 7, 9, 10, 12, 14, 16, 22–27, 30	§ 103	Willard, Maak, Jones
4, 5, 18	§ 103	Willard, Maak, Jones, ASI
6, 8, 11, 17	§ 103	Willard, Maak, Jones, Tilton
13	§ 103	Willard, Maak, Jones, Krampe
15	§ 103	Willard, Maak, Jones, Marino

28, 29	§ 103	Willard, Maak, Jones, Stich
19	§ 103	Willard, Maak, Jones, ASI, Tilton
20, 21	§ 103	Willard, Maak, Jones, ASI, Tilton, Marino

## II. ANALYSIS

We organize our analysis into five sections. First, we address the level of ordinary skill in the art at the time of the invention. Second, we discuss claim construction. Third, taking account of the information presented in the Petition and the Preliminary Response, including information pertaining to secondary considerations, we consider whether Petitioner makes out the threshold showing for *inter partes* review of claims 1 and 18 (the only independent claims). Fourth, we consider whether inclusion of claims 2–17 and 19–30 (the dependent claims) would unduly complicate the trial. Lastly, we set forth our rationale for declining to enter a discretionary denial of the Petition under 35 U.S.C. § 325(d).

### A. *Level of Ordinary Skill in the Art*

We consider the grounds of unpatentability in view of the understanding of a person of ordinary skill in the art at the time of the invention. Petitioner submits that an ordinary artisan would typically have had at least a bachelor's degree in packaging or a comparable field and about six months of internship or work experience creating, testing, and evaluating paperboard based packaging with adhesives. Pet. 10. Alternatively, in Petitioner's view, the ordinary artisan would have had about four years of relevant industry experience in packaging and a familiarity with paper and

paperboard packaging as well as converting and adhesives. Petitioner also asserts that “[a]dditional graduate education could substitute for professional experience, or significant experience in the relevant field . . . could substitute for formal education.” *Id.* at 11 (citing Ex. 1002 ¶¶ 3, 14, 36–39).

Petitioner’s definition, which is not challenged in the Preliminary Response, is comparable to the level of skill reflected in the asserted prior art references. On this record, we find that the prior art itself is sufficient to demonstrate the level of ordinary skill in the art at the time of the invention. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art itself can reflect the appropriate level of ordinary skill in the art).

#### *B. Claim Construction*

The Board interprets claims in an unexpired patent using the “broadest reasonable construction in light of the specification of the patent.” 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under that standard, claim terms are given their ordinary and customary meaning in view of the specification, as understood by a person of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We resolve disputed claim terms only to the extent necessary to our decision. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“we need only construe terms ‘that are in controversy, and only 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))).

Neither party identifies a claim term that requires express construction at this stage of the proceeding. Pet. 10; Prelim. Resp. 10–11. Based on the

information presented in the Petition and the Preliminary Response, we find that no term requires express construction for purposes of this decision.

*C. Independent Claims 1 and 18*

In this section, we first address the subject matter of claim 1, and then turn to the subject matter of claim 18. Those are the only independent challenged claims. *See* Ex. 1001, 8:65–11:6 (claims 1–30).

(1) Claim 1

The information presented in the Petition and the Preliminary Response establishes sufficiently the following facts, which bear on whether Petitioner is reasonably likely to prevail at trial in showing that the subject matter of claim 1 would have been obvious over the combined disclosures of Willard, Maak, and Jones. Pet. 5 (grounds chart). We emphasize that the following findings are preliminary and any final findings will be based upon consideration of the full record developed during trial. On that point, we emphasize that Patent Owner may challenge these preliminary factual findings through discovery and in a timely-filed response to the Petition.

Claim 1 is directed to “[a] method for producing a secure card package containing a point-of-sale activatable card” that includes a first step of “providing a first panel and a second panel each comprising paperstock and having a non-polymeric coated inner surface.” Ex. 1001, 8:66–9:3. In the method of claim 1, the card is located “between the inner surface of the first panel and an inner surface of the second panel.” *Id.* at 9:8–10. Willard discloses a method for producing a secure package for a point-of-sale activatable card between two panels of “conventional” paperboard—and Willard’s card is “disposed between” the panels. Pet. 1; Ex. 1010, 32, claim 7; *see* Pet. 16–17 (claim chart, and citations to Willard therein).



Maak discloses a selectively heat-activatable aqueous dispersion “for forming an adhesive bond” that is useful in “packaging.” Ex. 1011, Abstract, ¶ 2; *see* Pet. 12 (discussing Maak’s disclosure) (citing Ex. 1011, Abstract, 10–12, 19). Jones discloses providing a “top panel” and a “bottom panel” of “paperboard” having a “clay-coated” inner surface. Pet. 18–20 (quoting Ex. 1012 ¶¶ 11, 15, 25, 32). Both Jones and Maak disclose panels of “paperboard” (Pet. 19) or “cardboard” (Pet. 20) that have a non-polymeric “clay” coated inner surface.<sup>1</sup> Ex. 1012 ¶¶ 11, 15, 25, 32 (Jones); Ex. 1011 ¶¶ 16, 117 (Maak); Pet. 18–20 (and citations therein to Jones (Ex. 1012) and Maak (Ex. 1011)).

The method of claim 1 requires as a second step “printing a heat-activatable adhesive directly upon the non-polymeric coated inner surface of the first panel.” Ex. 1001, 9:4–5. Both Maak and Jones disclose or suggest printing an adhesive on a non-polymeric coated panel—specifically, a clay coated panel. *See* Pet. 2, 12–13, 29–22 (and citations therein to Jones (Ex. 1012) and Maak (Ex. 1011)). Maak discloses printing an adhesive that comprises polyurethane. Ex. 1011 ¶¶ 22–23 (Maak, explaining that the adhesive may comprise “polyurethane polyvinyl chloride”); Pet. 53.

Relevant to the printing step of claim 1, Maak applies the adhesive on a substrate (such as “clay-coated cardboard”) “with a roll coater or a gravure coater.” Ex. 1011 ¶ 71; Pet. 12, 21–22. Those specific printing techniques

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<sup>1</sup> The record supports a finding that clay is “a non-polymeric” coating within the embrace of claim 1. Pet. 52 (“clay” “is a well-known type of ‘non-polymeric’ coating”) (citing Ex. 1001, 9:20–22 (claim 2, which depends from claim 1 and specifies “clay” as the non-polymeric coating); Ex. 1002 ¶ 42 (Dr. Singh’s declaration)). Patent Owner does not dispute this factual contention at this stage of the proceeding. *See generally* Prelim. Resp.

are discussed and claimed in the '889 patent. Ex. 1001, 4:5–8, 9:4–46 (the '889 patent, including claim 9, which specifies that the printing step of the invention “is completed utilizing at least one of a printing roller, a flood coater, a gravure press, and an anilox roller plate”).

Maak discloses conventional techniques of printing a heat-activatable adhesive on a clay-coated (a type of non-polymeric coating) surface of cardboard. Pet. 21–22 (claim chart, citing Ex. 1011 ¶¶ 10, 16, 18, 167, and 171). Willard secures the two panels with “a heat-activated adhesive” that is “pre-applied” using “conventional techniques.” Pet. 1, Ex. 1010 ¶¶ 35–36; *see* Pet. 20–21 (including citations to Willard). Jones similarly seals panels together “by any known means” and refers to “gluing and heating processes known to [those skilled in the art].” Pet. 22 (quoting Ex. 1012 ¶ 34).

The third step of the method of claim 1 involves “allowing the heat-activatable adhesive to dry upon the non-polymeric coated inner surface of the first panel.” Ex. 1001, 9:6–7. Maak discloses “letting the [adhesive] precursor solution dry” on a “clay coated cardboard” substrate. Ex. 1011 ¶ 167; Pet. 23. Maak explains that “[t]he resultant coated substrate may then be shipped to another location for activation, or may be stored for later use.” Ex. 1011 ¶ 168; Pet. 23. Maak’s process thereby “provides a source of ‘on-demand’ adhesives” for use in packaging. Ex. 1011 ¶ 168, Pet. 23.

Claim 1 includes a fourth step of “locating” the card between the panels after the drying step. Ex. 1001, 9:8–12. Willard and Jones suggest locating “a point-of-sale activatable card between the inner surface of the first panel and an inner surface of the second panel” as specified in claim 1. Ex. 1001, 9:8–10; *see* Pet. 24–27 (including citations to Willard and Maak).

The fifth method step of claim 1 requires “activating the heat-activatable adhesive” selectively; that is, “only in a region substantially surrounding and offset from the” card. Ex. 1001, 9:13–18. Maak discloses shipping the “unactivated” and “potentially dry” adhesive coated substrate to allow for subsequent activation by means of the “application of heat” or “pressure” “at a later time” and “at the specific substrate location where bonding is desired.” Ex. 1011 ¶ 18; Pet. 24–28; *see* Ex. 1001, 9:8–15 (claim 1 limitations pertaining to these steps).

In sum, the Petition directs us to information (including a claim chart) sufficient to show that each feature of the method of claim 1 was known and available to an ordinary artisan at the time of the invention. Pet. 16–29 (and evidence cited therein). The Petition identifies additional information (including Dr. Singh’s declaration) explaining why the prior art references occupy the same field of invention as the ’889 patent, relating to packaging using an adhesive. *See id.* at 15–16 (including citations to Dr. Singh’s declaration (Ex. 1002)). On that point, the Petition shows sufficiently that an ordinary artisan “would look to each reference when developing a method for making a secure card package.” *Id.* at 16 (citing Ex. 1002 ¶¶ 67, 69, 71, 73, 75, 77, 79, 81). In addition, the Petition adequately establishes that a person, exercising no more than ordinary skill in the art, would have been led by the disclosures of Willard, Maak, and Jones to the combination of method steps specified in claim 1. *Id.* at 42–48 (and evidence cited therein).

Patent Owner, for its part, directs us to information bearing on secondary considerations of non-obviousness. Prelim. Resp. 67–70. Specifically, Patent Owner identifies a declaration of Mr. Dennis R. Smith, the named inventor of the ’889 patent, which was submitted during patent

prosecution to overcome an obviousness rejection. *Id.* at 67–68; *see* Ex. 1006 ¶¶ 1 (declaration, stating that Mr. Smith is “the named inventor in the above-identified application”). Patent Owner submits that Mr. Smith’s declaration testimony demonstrates “the tremendous commercial success of secure card packages” that embody the claimed invention. Prelim. Resp. 68. Patent Owner alleges that sales figures and gross revenues discussed by Mr. Smith establish commercial success that is “attributable to the features” of the claimed invention. *Id.* at 68–69.

Petitioner disagrees, arguing that Patent Owner fails to come forward with objective proof sufficient to establish a nexus between the alleged market success and the features of the claimed invention. Pet. 9 (citing Ex. 1002 ¶¶ 195–196). Patent Owner responds that the Petition refers to “contributing factors that may affect the sales of secure card packages” without identifying objective proof that other factors, in fact, affected the gross sales revenues of the products alleged to embody the claimed invention. Prelim. Resp. 69. Petitioner similarly argues that Mr. Smith’s opinions are unsupported by objective proof and conclusory. *Ibid.*

We are mindful that the lack of objective proof, observed by both parties, may be the practical result of two circumstances. First, Mr. Smith’s declaration was prepared to respond to an Examiner’s rejection during an *ex parte* patent examination, not to overcome an adversarial challenge in an *inter partes* review. Second, at this stage of the proceeding, Petitioner has had no opportunity to challenge Mr. Smith’s contentions through our discovery process. On this preliminary record, we decline to draw any conclusions on the disputed factual issues surrounding secondary considerations, except to observe that the Petition is supported by

information (including opinion testimony) sufficient to demonstrate a reasonable likelihood of prevailing at trial. *See* Pet. 9 (citing Ex. 1002 ¶¶ 194–195). Given the nature of the dispute, it makes sense to permit the parties to develop these issues during trial to the extent permitted by our rules. We will resolve the dispute, if necessary, in any final written decision after consideration of the full trial record, including any information presented in a timely patent owner’s response and petitioner’s reply. As a reminder, arguments not raised in a responsive paper are deemed waived.

Patent Owner raises other arguments that, at this stage of the proceeding, are unpersuasive because they consist of conclusory statements of counsel. For example, without citation to any persuasive objective support, the Preliminary Response states that, “[f]rom a manufacturing point of view, it would be incredibly difficult, if not impossible, to apply the requisite heat and pressure” in Willard “to activate the adhesive on the panel 515 without either damaging the card 505B or adhering the card to the panel 515.” Prelim. Resp. 63. The Preliminary Response advances other arguments that similarly lack adequate objective support at this stage of the proceeding. *See id.* at 64–67 (conclusory argument that an ordinary artisan would have discerned an inconsistency in Willard’s Figures 6 and 9 and, therefore, would not have understood Willard to disclose the claim limitation that requires “applying heat and pressure only in a region substantially surrounding and offset from” the card); *see especially id.* at 67 (conclusory argument that “a person of ordinary skill in the art would not use any of the secondary references to modify [the] teachings of Willard as it defeat [sic] the functionality of Willard’s package as shown in Figures 7–9”).

On this record, we find that Petitioner is reasonably likely to prevail at trial in showing that the method of claim 1 would have been obvious to an ordinary artisan over the combined disclosures of Willard, Maak, and Jones.

(2) Claim 18

Claim 18 is similar to claim 1, except that claim 18 further specifies that the surfaces of the panels are clay coated and the heat-activatable adhesive comprises polyurethane. *Compare* Ex. 1001, 8:66–9:19 (claim 1) *with id.* at 10:7–28 (claim 18); *see* Ex. 1002 ¶ 19 (Dr. Singh’s declaration). Petitioner directs us to a claim chart that shows sufficiently where each limitation of claim 18 is disclosed or suggested by Willard, Maak, Jones, and ASI. Pet. 52–55. Petitioner also advances argument, supported by the declaration of Dr. Singh, which establishes adequately that a person of ordinary skill in the art would have been led to combine the disclosures of Willard, Maak, Jones, and ASI in a manner that would have resulted in the method of claim 18. *Id.* at 55–57 (and citations therein to Ex. 1002).

Our analysis above pertaining to claim 1 applies equally to claim 18. On this record, we find that Petitioner is reasonably likely to prevail at trial in showing that the combined disclosures of Willard, Maak, Jones, and ASI would have suggested to an ordinary artisan the method of claim 18.

*D. Dependent Claims 2–17 and 19–30*

The Petition asserts challenges against dependent claims 2–17 and 19–30 that similarly are based on the disclosures of Willard, Maak, and Jones in combination with one or more additional references. *See* Pet. 5 (grounds chart); Pet. 29–42, 55, 57–61, 64–72 (claim charts). Based on our review of the information presented in the Petition and the Preliminary Response, and without reaching any preliminary findings or conclusions on

the merits, we determine that inclusion of the challenges against those dependent claims will not unduly complicate the trial. Our decision is driven by the circumstance that all of the grounds stated in the Petition have in common three prior art references—Willard, Maak, and Jones. Pet. 5 (grounds chart). Inclusion of all claims will advance our overarching goal of securing the just, speedy, and efficient resolution of the parties' dispute. *See* 37 C.F.R. §§ 42.1(b), 42.108 (reflecting the Board's mission of securing "the just, speedy, and inexpensive resolution" of patentability disputes).

Accordingly, having determined, in our analysis of claims 1 and 18 above, that the record supports institution of trial "with respect to at least 1 of the claims challenged" (35 U.S.C. § 314(a)), we exercise our discretion under 37 C.F.R. § 42.108(a) and order that the trial shall proceed on all other claims challenged in the Petition. *See* Pet. 5 (grounds chart).

*E. Declining to Exercise Discretion Under 35 U.S.C. § 325(d)*

Patent Owner invites us to exercise our discretion to "reject" the Petition under 35 U.S.C. § 325 (d) ("Section 325(d)"). Prelim. Resp. 12–62. Section 325(d) permits, but does not require, the Director (and the Board pursuant to delegated authority) to "reject" a petition where "the same or substantially the same prior art or arguments previously were presented to the Office." Prelim. Resp. 12 (quoting the authorizing statute).

As an initial matter, we are not persuaded that the Petition raises concerns of "harassment" or represents an unfair use of our process as "a means to prevent market entry through repeated litigation and administrative attacks." Prelim. Resp. 12 (citations omitted). The Petition is not one of a series of multiple petitions filed against the same patent. Nor does the record reflect that Patent Owner has been drawn into repeated litigation as

an unwilling participant. On the contrary, the Petition represents the first and only request for *inter partes* review of the '889 patent, and was filed by a party named as the defendant in a co-pending district court infringement action initiated by Patent Owner. Pet. 3 (identification of related matters).

Patent Owner alleges that “the references used by the Petitioner are substantially the same, if not identical, to the references cited and used by the Examiner in the prosecution of the '889 patent.” Prelim. Resp. 15. The information presented, however, persuades us that, of the references asserted in this proceeding, “only Stich was cited during prosecution.” Pet. 11 (citing Ex. 1002 ¶ 65); Prelim. Resp. 9–11 (Patent Owner’s overview of the prosecution history, identifying Stich, but no other references asserted in the Petition, as previously before the Examiner), 16 (Patent Owner, observing that “Stich was cited and applied during prosecution”). Petitioner asserts Stich in only one of eight grounds, and only in connection with the patentability of dependent claims 28 and 29. Pet. 5 (grounds chart).

The nub of Patent Owner’s argument on this point is that Willard’s disclosure “is essentially a verbatim copy of the Hansen reference,”<sup>2</sup> which was before the Examiner during patent prosecution. Prelim. Resp. 22; *see id.* at 23–41 (charts identifying similarities between the disclosures of Willard and Hansen). Even if we agree that Willard and Hansen have similar disclosures (Prelim. Resp. 23–41), for reasons that follow, we disagree that the Petition advances “substantially the same prior art” previously presented to the Examiner within the meaning of Section 325(d).

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<sup>2</sup> US Pat. No. 6,315,206 B1, issued to Roger P. Hansen, et al., on November 13, 2001.



Willard and Hansen share no common inventors, were not assigned to the same entity, issued years apart in time, and are not the progeny of a shared ancestor application. *Compare* Ex. 1010 (Willard, cover page) *with* Ex. 1022 (Hansen, cover page). Even Patent Owner observes that Willard discloses “changes made from the Hansen reference” and describes “a different invention of Hansen.” Prelim. Resp. 65 (identification of differences); *see id.* at 22 (asserting that Willard discloses “improvements [] made to Hansen’s flap structures for accessing the card after purchase”).

More significantly, Patent Owner’s argument that Maak (asserted in the Petition) “is substantially similar to Egan”<sup>3</sup> (considered by the Examiner) cannot withstand scrutiny. Prelim. Resp. 49 (topical heading). The information presented does not support a finding that “[t]he teaching of Maak is only slightly different from that of Egan.” *Id.* at 50. As Patent Owner necessarily acknowledges, Egan discloses “drying an adhesive on a carrier sheet, not the final product, such that it is still tacky,” whereas Maak teaches “drying its adhesive on a clay coated cardboard.” *Id.*

Our comparison of the references persuades us that Maak is more relevant than Egan to the drying limitation of the challenged claims. Unlike Egan, Maak specifically discloses drying the adhesive on a non-polymeric coated inner surface of a first panel, wherein the non-polymeric coating is clay. *Compare* Ex. 2001, 6:32–37 (Egan, disclosing an “adhesive-coated strip” that “is passed through a dryer” that “dries the adhesive to form a tacky, pressure-sensitive coating on [a] carrier surface”) *with* Ex. 1011 ¶¶ 16, 18 (Maak, disclosing the selective activation of a heat-activatable

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<sup>3</sup> US Pat. No. 4,544,590, issued to James R. Egan on October 1, 1985.

adhesive that is applied in “potentially dry” form on “clay-coated cardboards”); *see* Ex. 1001, 10:6–7 (claim 1, requiring a method that includes “allowing the heat-activatable adhesive to dry upon the non-polymeric coated inner surface of the first panel), 10:15–16 (claim 18, requiring a method that includes “allowing the heat-activatable adhesive to dry upon the clay inner surface of the first panel”); *see also* Pet. 52 (“clay” “is a well-known type of ‘non-polymeric’ coating”) (citing Ex. 1001, 9:20–22 (claim 2); Ex. 1002 ¶ 42 (Dr. Singh’s declaration testimony)).

Unlike Egan, Maak teaches a “selectively activatable adhesive” applied “only in the locations where sufficient heat and/or pressure is applied to achieve a bond.” *Compare* Ex. 1011 ¶¶ 167–168 (Maak) *with* Ex. 2001, 6:62–7:5 (Egan). In addition, unlike Egan (*see generally* Ex. 2001), Maak teaches the specific techniques of adhesive printing (“with a roll coater or a gravure coater”) that are described in the disclosure of the ’889 patent. *Compare* Ex. 1011 ¶ 171 *with* Ex. 1001, 4:5–8. Egan and Maak share no common inventors, were not assigned to the same entity, issued more than a decade apart in time, and are not the progeny of a shared ancestor application. *Compare* Ex. 1011 (Maak, cover page) *with* Ex. 2001 (Egan, cover page). The totality of circumstances in this case persuades us that Maak and Egan are not “substantially the same prior art” reference within the meaning of Section 325(d). Pet. 50.

Nor does this proceeding involve “substantially the same” arguments previously presented to the Examiner. 35 U.S.C. § 325(d). For example, during patent prosecution, the Examiner was presented with the Applicant’s extensive and unopposed argument that an ordinary artisan would have had no reason to combine the applied prior art references to arrive at the claimed

subject matter. *See* Ex. 1043, 31–37.<sup>4</sup> In response, the Examiner allowed the claims to issue without significant analysis. *See* Prelim. Resp. 11 (Patent Owner, observing that, in the reasons for allowance, “the Examiner stated that [the] prior art did not teach the claimed invention”) (citing Ex. 1043, 7–12); *see* Ex. 1043, 12 (“reasons for allowance,” consisting of Examiner’s statement that “[t]he prior art does not teach a method” that comprises the features of the claimed invention).

The Petition, by contrast, presents new argument, not considered by the Examiner, identifying specific reasons why an ordinary artisan would have been prompted to combine the asserted prior art references in the manner claimed. Pet. 42–52, 55–57, 61–67, 69–73 (extensive new argument pertaining to an alleged “[m]otivation to [c]ombine”). Significantly, that new argument is supported by new evidence—the declaration of Dr. Singh—which also was not presented to the Examiner during patent prosecution. *See generally id.* (including extensive citations therein to Ex. 1002 (Dr. Singh’s declaration)).

Under these particular facts and circumstances, based on the entirety of the information presented in the Petition and the Preliminary Response, we are not persuaded that the Petition asserts “substantially the same” argument or evidence previously presented to the Examiner during patent prosecution. 35 U.S.C. § 325(d). Accordingly, we decline to exercise our discretion to “reject” the Petition on that basis. *Id.*

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<sup>4</sup> We refer to the page numbers added by Petitioner, not the original page numbers of the document.

### III. CONCLUSION

For the above reasons, we institute an *inter partes* review as set forth in the Order below. Trial shall commence on the entry date of this decision.

### IV. ORDER

It is

ORDERED that an *inter partes* review is instituted on the following grounds:

(1) Whether the subject matter of claims 1–3, 7, 9–10, 12, 14, 16, 22–27, and 30 would have been obvious under 35 U.S.C. § 103 over the combined disclosures of Willard, Maak, and Jones;

(2) Whether the subject matter of claims 4, 5, and 18 would have been obvious under 35 U.S.C. § 103 over the combined disclosures of Willard, Maak, Jones, and ASI;

(3) Whether the subject matter of claims 6, 8, 11, and 17 would have been obvious under 35 U.S.C. § 103 over the combined disclosures of Willard, Maak, Jones, and Tilton;

(4) Whether the subject matter of claim 13 would have been obvious under 35 U.S.C. § 103 over the combined disclosures of Willard, Maak, Jones, and Krampe;

(5) Whether the subject matter of claim 15 would have been obvious under 35 U.S.C. § 103 over the combined disclosures of Willard, Maak, Jones, and Marino;

(6) Whether the subject matter of claims 28 and 29 would have been obvious under 35 U.S.C. § 103 over the combined disclosures of Willard, Maak, Jones, and Stich;

(7) Whether the subject matter of claim 19 would have been obvious under 35 U.S.C. § 103 over the combined disclosures of Willard, Maak, Jones, ASI, and Tilton; and

(8) Whether the subject matter of claims 20 and 21 would have been obvious under 35 U.S.C. § 103 over the combined disclosures of Willard, Maak, Jones, ASI, Tilton, and Marino;

FURTHER ORDERED that no other ground of unpatentability is authorized during the trial; and

FURTHER ORDERED that 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, which will commence on the entry date of this decision.

PETITIONER:

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