

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARGET CORPORATION
Petitioner

v.

DESTINATION MATERNITY CORPORATION
Patent Owner

Case No. IPR2013-00533
Patent RE43,531

Dated: May 5, 2014

**PATENT OWNER'S RESPONSE TO CORRECTED PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. RE43,531**

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LIST OF EXHIBITS

- Exhibit 1002: *J.C. Penney ontrend Maternity Catalog*, dated Fall/Winter 2005, cover and pages 15 and 19 (“JCP”)
- Exhibit 1011: Declaration of Frances Harder
- Exhibit 1018: Hendrickson et al. U.S. Patent No. RE43,531 (“the ’531 Patent”)
- Exhibit 1020: Certified File Wrapper of U.S. Patent No. 7,814,575 (whose reissue application resulted in the ’531 Patent)
- Exhibit 1021: Certified File Wrapper of U.S. Patent No. RE43,531
- Exhibit 2003: Color artifact of JC Penney Catalog 2005 found in USSN 12/117,004 (US 7,900,276)
- Exhibit 2004: December 4, 2011 Form 1449 from US RE43,563
- Exhibit 2005: Excerpts from the October 10, 2013 Deposition of Mindy Simon
- Exhibit 2017: Declaration of David Brookstein, Sc.D.
- Exhibit 2018: Deposition transcript of Frances Harder (April 24, 2014)
- Exhibit 2019: Deposition transcript of Amy Brady (October 10, 2013)
- Exhibit 2020: Exhibit 114 from deposition transcript of Amy Brady
- Exhibit 2021: July 17, 2007 Patent Owner press release - introduction to Secret Fit Belly styles
- Exhibit 2022: Declaration of Philip Green
- Exhibit 2023: Merriam-Webster’s Collegiate Dictionary, 11th Ed., 2007, p. 1245

Exhibit 2024: Merriam-Webster's Collegiate Dictionary, 11th Ed., 2007, p. 679

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.120, patent owner, Destination Maternity Corporation (“Patent Owner”), hereby submits the following Patent Owner Response to Target Corporation’s (“Petitioner”) Corrected Petition for *Inter Partes* Review of U.S. Patent No. RE43,531 (the “‘531 Patent”). This filing is timely under the Scheduling Order and Stipulated Notice. *See* PTAB Feb. 19, 2014 Order, Paper 12 at 5; Stip. Not., Paper 19, at 2.

Petitioner filed six requests for *Inter Partes* Review for the ‘531 Patent and U.S. Patent No. RE43,563 (the “‘563 Patent”) (collectively, the “Patents-in-Suit”). Four of the six *Inter Partes* Review petitions were instituted and two are pending with joinder motions.¹ The instant *Inter Partes* Review was instituted for claims 1

¹ IPR2013-00532 was instituted for claims 1, 2, 5, 6, 10, 11, and 15–17 of the ‘531 Patent. *See* PTAB Feb. 19, 2014 Dec. Paper 10, at 2. IPR2013-00533 was instituted for claims 1 and 24-29 of the ‘531 Patent. *See* PTAB Feb. 19, 2014 Dec. Paper 11, at 2. IPR2013-00530 was instituted for claims 1-4 and 6-8 of the ‘563 Patent. *See* PTAB Feb. 14, 2014 Dec. Paper 13, at 2. IPR2013-00531 was instituted for claims 1, 10-14, 16, and 20 of the ‘563 Patent. *See* PTAB Feb. 14, 2014 Dec. Paper 10, at 2. IPR2014-00509 requested review of claims 1, 2, 5, 6, 10, 11, 15-19, and 24-29 of the ‘531 Patent. *See* March 14, 2014 Pet., Paper No. 1, at 1. IPR2014-00508 requested

and 24-29 of the '531 Patent. *See* PTAB Feb. 19, 2014 Dec. Paper 11, at 2.

The Patents-in-Suit are asserted against Petitioner in the United States District Court for the Eastern District of Pennsylvania. In the litigation, Patent Owner alleges that maternity clothing sold by Petitioner infringes the Patents-in-Suit.

Petitioner's infringing maternity clothing products compete with Patent Owner's patented Secret Fit Belly® line of maternity bottoms, which practice the claims of the Patents-in-Suit. *See* Ex. 2017, Brookstein Dec. at ¶ 11. An exemplary image of Patent Owner's Secret Fit Belly® line of maternity bottoms is provided below:



review of claims 1-4, 6-8, 10-14, 16, 20, and 21 of the '563 Patent. *See* March 14, 2014 Pet., Paper No. 1, at 1.

The *Inter Partes* Review for the '531 Patent is predicated on anticipation by J.C. Penney ontrend Maternity Catalog at Page 15 (“JCP-A”). Corrected Pet. Ex. No. 1002 at 2; PTAB Feb. 19, 2014 Dec., Paper 11. JCP-A shows images of a maternity garment from a J.C. Penney catalog that was already considered by the PTO during prosecution of both Patents-in-Suit. This reference is not anticipatory because it does not disclose the limitations of “an upper edge of the bely panel that encircles a wearer's torso just beneath wearer's breast area” and “substantially covering the wearer's entire pregnant abdomen during all stages of pregnancy.”

II. BACKGROUND OF THE INVENTION

The '531 Patent, entitled "Belly Covering Garment," concerns a garment worn during different stages of pregnancy and different stages of postpartum body changes. '531 Patent, col.1 1.34-44, 64-67 (Corrected Pet Ex. No. 1018). As discussed in the patent, this new garment is a comfortable, non-constricting garment that adapts to cover and fit a growing abdomen during pregnancy, and actually stays up when worn – from the first trimester through pregnancy and post-pregnancy, post-partum body changes. *E.g., id.*

Maternity garments prior to the claimed invention had thin elastic waist bands at the upper edge, which caused discomfort when tightened around the body, particularly as a pregnant woman's sensitive abdominal region expanded during pregnancy. *Id.* 1.18-21. Others had panels sewn into place with seams, which also

caused discomfort to the sensitive abdominal region due to the panels pressing against the torso. *Id.* 1.21-24. Of utmost importance, women have complained that the maternity garments that existed prior to the claimed invention were difficult to keep in place, and gradually slipped downward while being worn, causing a pregnant woman to constantly pull her bottoms up throughout the day. *Id.* 1.25-27. As such, the inventors of the '531 Patent recognized that a need existed for a maternity garment that expanded to cover and fit over a growing abdomen during all stages of pregnancy, regardless of body type. *Id.* 1.34-38.

The inventor's fulfillment of the aforementioned needs, among others, was evidenced in the popularity and commercial success of Patent Owner's Secret Fit Belly® line of maternity bottoms. There are now hundreds of different Secret Fit Belly® styles currently available online, in Patent Owner's stores, and in third party department stores.

III. CLAIM CONSTRUCTION

The United States Patent and Trademark Office ("PTO") "determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (citations and internal punctuation omitted). Under this standard, claim terms are given their plain

meaning to those skilled in the art based on, *inter alia*, “the words of the claims themselves, the specification, drawings, and prior art.” MPEP 2111.01. Dictionary definitions may be used to determine the broadest reasonable interpretation of a claim term. *In re Scroggie*, 442 Fed. App’x 547, 550 (Fed. Cir. 2011).

The PTO’s standard is not boundless; rather, it must be “consistent with the interpretation that those skilled in the art would reach.” MPEP 2111. “Accordingly, the PTO’s interpretation of claim terms should not be so broad that it conflicts with the meaning given to identical terms in other patents from analogous art.” *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999).

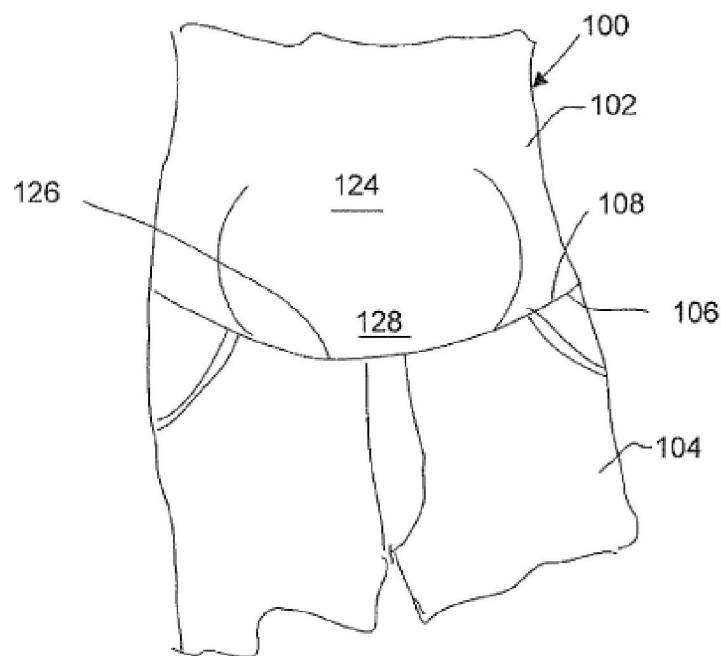
a. “just beneath wearer’s breast area”

The broadest reasonable construction of “just beneath the wearer’s breast area” is “beneath the location of the breasts by a very small margin.” *See* Ex. 2017, Brookstein Dec. at ¶¶ 13-22.

The claim term “breast area” was introduced via an examiner’s amendment. *See* Aug. 31, 2010 ‘575 patent Notice of Allowance Ex. 1020. This amendment was made after an office action that included a § 112 rejection requiring that the height of the panel be “defined in regard to the garment itself and not the wearer or the location needs to be defined in regard to the wearer **according to a body location that would not be different on each wearer** so that the location is clear and definite.” ‘575 patent, June 8, 2010 Office Action at 7 (emphasis added) Ex. 1020.

Accordingly, the Examiner required “just beneath the wearer’s breast area” to avoid the issue that a garment would satisfy claim 1 for one wearer but not another because of differences in the wearers’ body types.

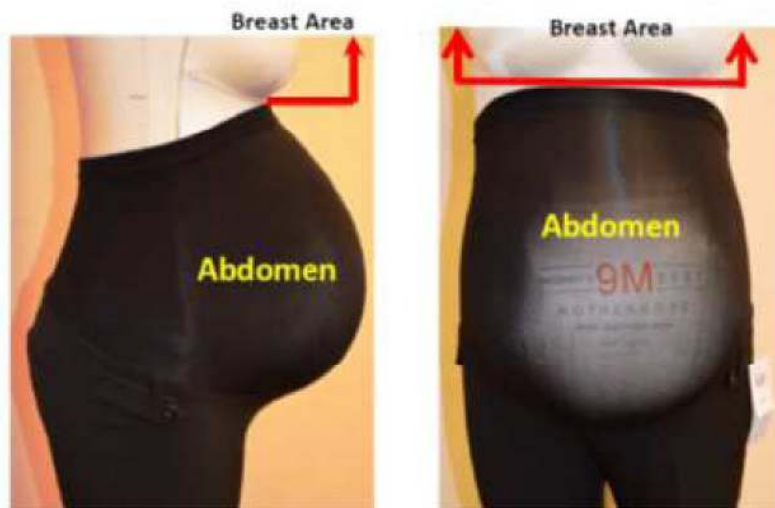
Although the specification does not discuss “breast area” in detail, Fig. 1A (reproduced below) shows that the panel may completely cover the abdomen and extended upward to the breasts. *See* ‘531 Patent, col. 2, 1.9-10 (“FIG. 1A is a view similar to FIG. 1, and discloses a body panel covering a growing abdomen”); Ex. 2017, Brookstein Dec. at ¶¶ 14-15.



In describing Fig. 1A, the specification states that “the garment upper portion 102 has a belly panel 124 to provide an abdomen covering area [that is] expansible . . . to cover and fit over a growing abdomen during different stages of pregnancy.” ‘531 patent, 2:59-63. As such, the Specification supports a construction of “just

beneath the wearer's breast area" as "beneath the location of the breasts by a very small margin."

The claim language also supports a construction that "just beneath the wearer's breast area" is "beneath the location of the breasts by a very small margin." *See* Ex. 2017, Brookstein Dec. at ¶ 16. Claim 1 states that the panel rises to a location "just beneath the wearer's breast area . . . substantially covering the wearer's entire pregnant abdomen during all stages of pregnancy." In other words, claim 1 requires that the breast area ends before the abdomen begins because substantial coverage of the abdomen cannot include partial coverage of the breast area as shown on the annotated picture below. *Id.* ¶ 11.



9 month

By using the terms "breast area" and "abdomen" to describe different locations on a wearer, the wording of claim 1 supports a construction that "breast area" is the location of the breasts. It also excludes a construction of "breast area"

that includes the abdomen because both terms are used in locating the top of the panel during all stages of pregnancy. *Id.* ¶ 16.

The Specification's discussion of different body types supports a construction of "just beneath the wearer's breast area" as "beneath the location of the breasts by a very small margin." *Id.* ¶¶ 17-18. The Specification explains that the expandible and contractible nature of the panel allows the panel to reach just beneath the breast area during all stages of pregnancy on wearers of different body types. The Specification states:

The tubular structure is adaptable to cover and fit different body types by being elastically expandible and contractible. Different body types have different muscle mass distributions and spinal columns of different curvatures, which make the tubular structure conform to the different body types by expanding and contracting in different locations and amounts when worn by the different body types. The tubular structure is elastically expandible to widen the tubular girth at selected locations and amounts where needed to fit a body type, and is elastically contractible to narrow the tubular girth at selected locations and amounts where needed to fit the body type. '531 Patent, col. 3 l.47-57.

The Specification does not indicate that body types will affect the location of the garment because the stretchability and contractability of the garment allows it to

adapt to different body types. For example, if a wearer is a size small and has a spinal column that is different than a standard spinal column that designers use for size small, the garment could expand to reach just beneath the breast area. The Specification shows that the garment is adaptable to cover and fit different body types.

Petitioner's expert's deposition testimony supports a construction of "breast area" as the "location of the breasts"; for example:

Q. Okay. Before you were involved in this case, what was your understanding of where the breast area is -- is located on a person?

A. Well, the breast area could -- could, in theory, talk about the bra, talk about the actual breast. So it depends on, you know, what -- what in -- in what context we're talking about. Or it could be area -- it could be, what is the area? I mean, what is the area of L.A.? You're talking about miles or are you talking about 5 -- 5 feet?

Q. Sure.

A. So it depends on what you define as what the area is. Every -- every -- every definition of area could -- could be different.

Q. Sure. Sure. But when you're working with clothing to cover the breast area, what's your understanding of breast area in that context?

A. To cover the breast area?

Q. Yes.

A. Then I would think we're talking about a bra.

Q. Okay. Are there other definitions of -- well, what do you mean by "bra" when you said we're talking about the bra?

A. Well, the bra is holding the actual breast of the woman. And that would be considered, as you were talking about, something covering the breast area.

Harder Dep. 17:8-18:11 (Ex. 2018)

Q. BY MR. POLLACK: Normally, breast area would refer to over the breast?

A. Over the breast.

Q. Okay.

A. So that's what I would define normally as being the breast area.

Id. 24:9-14.

Q. Okay. And the breast area is the breasts?

A. Is -- we've --

Q. The bra?

A. Yeah. We've already discussed that the breast area would be where the bra would be fitting.

Id. 47:24-48:3.

Q. Yes.

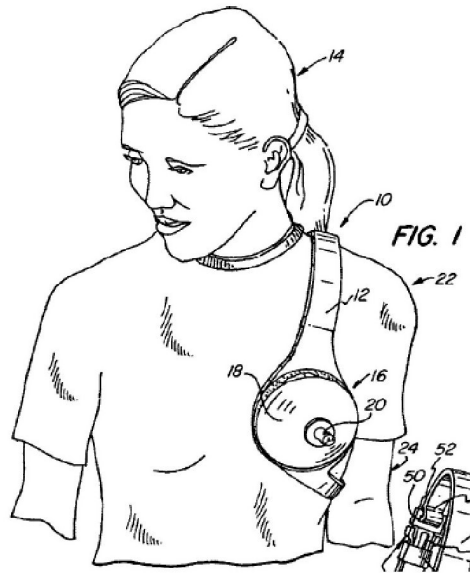
Does -- does the maternity brief in Figure 11 encircle -- have an upper edge of a belly panel that encircles a wearer's torso just beneath the wearer's breast area?

A. It's hard to tell because there's no reference of where -- the breast area here. You see that -- the bulge of the stomach, and it looks like it tapers down. And that's normally where a pregnant woman's breast -- a pregnant woman's belly or abdomen would grow is below the breast. But without seeing where the reference of the breast is on this, it's very hard to tell where it finishes or where it starts.

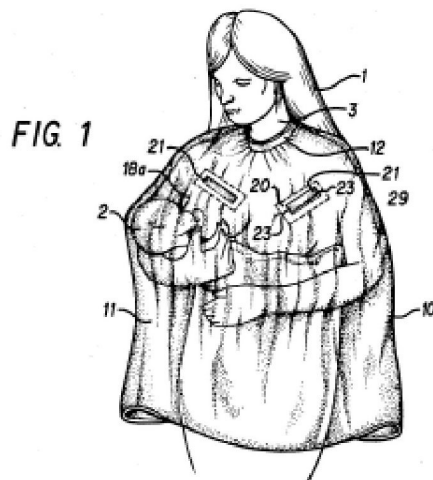
Id. 78:13-79:1.

Petitioner's expert further testified that she has the expertise to define "breast area." *Id.* 51:11-19. Petitioner's expert also admitted that the asserted prior art did not define the term "breast area." *E.g.*, *Id.* 27:8-10 (JC Penny catalog); *id.* 28:13-21 (Browder); 30:4-7 (Sara); *id.* 30:17-31:2 (Stangle); *id.* 32:5-8 (Pergament).

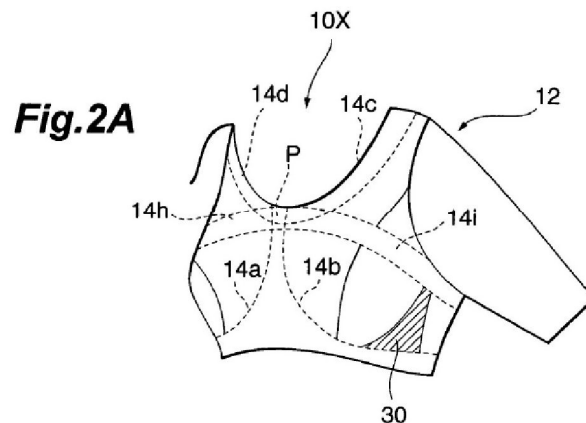
Even though the asserted prior art did not discuss "breast area," the term is well known in the art and analogous art shows that the "breast area" is the location of the breasts. *See* Ex. 2017, Brookstein Dec. at ¶ 19. For example, U.S. Patent No. 6,669,064 (the "'064 patent") explains that "Nurser 10 includes a flexible shoulder sling 12 to which is attached, positioned in the **breast area** of user's chest . . . the sling holds container 16 in the **breast area** of the user's." '064 patent, 4:36-46 (emphasis added). Figure 1 below read with this description shows that the described "breast area" is the location of the breasts.



U.S. Patent No. 5,034,999 (the “999 patent”) explains that, during nursing, “the mother will want to check on his or her progress . . . by opening one of the portals 18 above each **breast area** 18a . . . where the child would be nursing, preferably near the infant's head while he is nursing.” 2:60-67 (emphasis added). Again, Figure 1 below read with this description shows that the described “breast area” is the location of the breasts.



Analogous art also shows that the bottom of the breast area does not include the abdomen. U.S. Pat. No. 7,089,597 (the “‘597 patent”) shows that the breast area ends at the empire line or inframammary fold. In describing Fig. 2A (reproduced below), the ‘597 patent states: “wide fabrics 14a and 14b are stitched along lines that extend from a supporting point P at the front center to the armpits, passing **beneath the breast area.**” ‘597 patent, 9:34:38 (emphasis added). Of note, the Primary Examiner for the ‘597 patent is the same Primary Examiner for the Patents-in-Suit.



Moreover, as the term “breast area” is known in the art as the location of the breasts, analogous art includes patents where the term “breast area” is only found in the claims. *See* Ex. 2017, Brookstein Dec. at ¶ 20; *see also, e.g.*, U.S. Patent No. 8,016,640, claim 3 (“said piece of stretchable material is formed as a sling and is shaped inwardly **from a direction at a center of a breast area at its ends to allow the sling to sit neatly on the breast** while holding the breast with the breast

supported from said outside edge”) (emphasis added); U.S. Patent No. 4,590,624, claim 1 (“each of said left and right blouse panels configured when laid flat and without stitching to be **larger than the breast area of the gown, thereby producing a billowing of the blouse panels for accommodating the patient's breasts** with the edges of the blouse panels interconnected to the back panel and corresponding skirt panels”) (emphasis added).

The word “just” is defined as “by a very small margin.” *See* just. Merriam-Webster's Collegiate Dictionary, 11th Ed., 2007, p. 679 Ex. 2024; *see also* Ex. 2017, Brookstein Dec. at ¶ 21. This definition of “just” comports with the remainder of the claim, which requires that the garment upper portion “substantially² cover[] the wearer's entire pregnant abdomen during all stages of pregnancy.” In other words, if a wearer's entire pregnant abdomen is substantially covered during all stages of pregnancy, the top of the garment upper portion must be below the location of the breasts by a very small margin and vice-versa.

Based on the language of the claims, the Specification, the file history, and analogous art, the broadest reasonable construction of “just beneath the wearer’s

² The definition of “substantially” is “being largely but not wholly that which is specified.” *See* substantial. Merriam-Webster's Collegiate Dictionary, 11th Ed., 2007, p. 1245 Ex. 2023.

breast area” is “beneath the location of the breasts by a very small margin.” *See* Ex. 2017, Brookstein Dec. at ¶¶ 13-22.

IV. JCP-A DOES NOT ANTICIPATE CLAIM 1

To anticipate a claim under § 102, "a single prior art reference [must] 'not only disclose all of the elements of the claim within the four corners of the document, but ... also disclose those elements arranged as in the claim.'" *Cheese Sys., Inc. v. Tetra Pak Cheese and Powder Sys., Inc.*, 725 F3d 1341, 1351 (Fed. Cir. 2013). If even one element is missing, there is no anticipation. MPEP § 2131.

Claim 1 of the ‘531 Patent recites:

A garment, comprising:

a garment upper portion having a belly panel that is expansible to cover and fit over a growing abdomen during different stages of pregnancy;

a garment lower portion having a first torso encircling circumference that recedes downward to make way for expansion of the belly panel; and

the garment upper portion having a second torso encircling circumference defining an upper edge of the belly panel that encircles a wearer's torso just beneath the wearer's breast area configured to hold the garment up and in place about the torso in a position of a location of maximum girth of the abdomen thereby substantially covering the wearer's entire pregnant abdomen during all stages of pregnancy.

JCP-A does not disclose, at a minimum, either “an upper edge of the bely

panel that encircles a wearer's torso just beneath wearer's breast area” or “substantially covering the wearer's entire pregnant abdomen during all stages of pregnancy.” See Ex. 2017, Brookstein Dec. at ¶¶ 34, 40-48. Indeed, JCP-A was already considered by the PTO in high quality color (contrary to Petitioner’s assertions) and was not even deemed relevant enough to warrant an Office Action. Ex. 2003; Ex. 2004.³

- a. JCP-A does not disclose “an upper edge of the belly panel that encircles a wearer's torso just beneath wearer's breast area”

JCP-A does not disclose an upper edge of the belly panel that encircles a wearer's torso just beneath the wearer's breast area, i.e., *beneath the location of the breasts by a very small margin*, because, at a minimum, JCP-A does not show either the model's breast area or even the top of the belly, and the surrounding text does not suggest that JCP-A is intended to reach that high. See Ex. 2017, Brookstein Dec. at ¶¶ 53-57. Petitioner’s expert testified that it cannot be determined whether a panel reaches to the breast area without also picturing the breast area when discussing Browder:

³ The instituted grounds for unpatentability of the dependent claims hinge on JCP-A anticipating claim 1. Because JCP-A does not anticipate claim 1, these grounds also fail.

Q. Yes.

Does -- does the maternity brief in Figure 11 encircle -- have an upper edge of a belly panel that encircles a wearer's torso just beneath the wearer's breast area?

A. It's hard to tell because there's no reference of where -- the breast area here. You see that -- the bulge of the stomach, and it looks like it tapers down. And that's normally where a pregnant woman's breast -- a pregnant woman's belly or abdomen would grow is below the breast. But without seeing where the reference of the breast is on this, it's very hard to tell where it finishes or where it starts.

Harder Dep. 78:13-79:1 (Ex. 2018).

Petitioner's expert also testified that the breasts are not pictured in JCP-A. *Id.* 177:15-19. Without seeing a JCP-A sample, Petitioner's expert could only conclude that the panel ended "below the breast area somewhere." *Id.* 179:7-180:12. Petitioner's expert did not see any garment samples of asserted prior art, even though she further testified that she would need to see the garments to determine validity. *See, e.g., id.* 96:20-97:13 (expert did not see any prior art samples and was surprised that none existed); *see also id.* 55:20-56:4 (expert would have to see the Browder garment to determine whether it is expansible). As such, Petitioner's expert's opinion that JCP-A anticipates is not credible.

Indeed, if JCP-A reached to the breast area, it would be expected that the text

would say so and would refer to this unusual feature. Ex. 2017, Brookstein Dec. at ¶ 46. Instead, JCP-A does not even show the model's breast area or the top of the belly, since JC Penney did not consider the breast area to be important to its design. *See* Ex. 2017, Brookstein Dec. at ¶ 43.

Moreover, what JC Penney called “over-the-belly coverage” is a different type of product that does not meet the '531 Patent claims' requirement that the "upper portion ... encircles a wearer's torso just beneath the wearer's breast area" *Id.* The reference to “over-the-belly coverage” in JCP-A is a term of art for products having a belly panel with an upper end that rests directly on the user's belly. This type of product is the type of prior art garment referred to in the '531 Patent, which suffered from the problem that it was difficult to keep in place, as it gradually slipped downward while being worn. *E.g.*, '531 Patent, col. 1, 1.25-27. Consistent with these conclusions, JC Penny's corporate witness testified that JCP-A's “over-the-belly” design rested directly on the belly, rather than extend upward to a point encircling a wearer's torso just beneath the wearer's breast area thereby substantially covering the wearer's entire pregnant abdomen:

Q. I'm sorry; the one that's Number 1 [of JCP-A]
over the belly coverage there.

A. Okay.

Q. The top edge of the band.

A. Yes.

Q. Is -- does it go straight across the belly?

A. Straight across?

Q. Yes.

A. It -- it kind of curves along the belly.

Q. I'm not going to test you on what kind of a curve that is --

A. Thank you.

Q. -- but can you explain why it curves?

A. Because the belly is curved, **so when it sits on the belly, it curves to the shape of the belly.**

Q. When you say, "Sits on the belly," how does it sit on the belly?

A. Well, your belly -- I mean (indicating) it sits on your belly. This is your belly and it's -- it comes -- in picture 1, it comes over the belly, so **it rests on the top of your belly.**

Simon Dep. 187:1-21 (emphasis added) (Ex. 2005).

JCP-A's incomplete coverage is even more evident when compared to the exemplary image of Patent Owner's Secret Fit Belly® line of maternity bottoms:



JCP-A



Secret Fit Belly®

See Ex. 2017, Brookstein Dec. at ¶ 42. As shown, the top of the garment rests directly on the user's belly and also curves downward substantially (which appears consistent with similarly constructed prior art garments that suffered from the problem that they would gradually slip downward while being worn). The absence of the breast area in the JCP-A picture is also apparent. JCP-A cannot anticipate claim 1 without explicitly showing either the breast area or even the top of the belly. The JCP-A text also does not suggest that the garment is intended to reach higher to the breast area, and JCP-A's inset photos that omit the breast area evidences that JC Penney did not consider the breast area to be important to its design. *See Id.* ¶ 47.

The difference in height is important. By rising just beneath the breast area, the '531 Patent provides a product that stays up better than JCP-A and other prior art

products. *See* Ex. 2017, Brookstein Dec. at ¶ 11. The additional coverage to the breast area creates more frictional force to hold the garment up. *Id.* Also, to move downward, a large portion of the ‘531 Patent’s upper garment portion needs to first significantly *expand* over a belly to move from a position just beneath the breast area off the wearer. *Id.* The functional advantages of Patent Owner’s invention was confirmed by Petitioner:



Redacted



Redacted

Brady Dep. 71:8-72:22 (Ex. 2019)

As shown in the photographs from JCP-A (reproduced below), the pregnant belly continues upward outside the picture frame to an unknown point, and the top of the garment curves downward substantially (perhaps even falling down), thereby providing incomplete coverage even to the portion of the belly region shown in these photographs. Thus, JCP-A does not disclose either an upper edge extending to "just beneath the wearer's breast area," or a "garment upper portion ... substantially covering the wearer's entire pregnant abdomen ...," as required by the claims:



In its institution decision, the Board stated:

In [JCP-A], the upper edge of the fold-over panel extends to just beneath the wearer's breast area. The skin of the model that is visible above the fold-over panel is part of the breast area, within the broadest reasonable interpretation of that term. Further, the fold-over panel would extend even higher on a wearer of a shorter stature. *See* PTAB Feb. 19, 2014 Dec. Paper 11, at 12.

Using Patent Owner's claim construction, the skin of the model above the JCP-A garment is not part of the breast area because it is not the location of the breasts. *See* Ex. 2017, Brookstein Dec. at ¶ 43. Rather, the skin of the model above the JCP-A garment is part of the abdomen. Neither the top of the abdomen nor the breast area is shown. As such, JCP-A is not anticipatory.

Moreover, Patent Owner's claim construction is not affected by wearers of

different body types. *See* Ex. 2017, Brookstein Dec. at ¶ 44. As noted above, the portions of the specification that describe coverage on different body types shows that the expansible and contractible nature of the patented garment allows the panel to reach just beneath the breast area during all stages of pregnancy on wearers of different body types. Even assuming, *arguendo*, that the model in JCP-A has a non-standard body type, JCP-A would still have to reach just beneath the breast area to be anticipatory. It does not.

Further, it is understood by one skilled in the art that the correct size of the garment is worn. *See* Ex. 2017, Brookstein Dec. at ¶ 45; Harder Dep. 133:10-17, 212:23-214:16 (Ex. 2018). The possibility that the pictured garment in JCP-A could reach just beneath the breast area on a person where the pictured JCP-A is a few sizes too big does not convert JCP-A into a § 102 reference. *See Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient”). Further, Petitioner does not provide any analysis that the possibility is even viable. *Id.* at 1268 (“[Extrinsic evidence] must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill”). Rather, Petitioner’s expert explained how a garment could be designed to reach just beneath the breast area

accounting for different sizes:

Q. BY MR. POLLACK: If you wanted to design a product that would go up to just beneath the breasts, what would you do?

A. Probably I would get in some models and find out what the measurements are and do a fit and sort of do a technical analysis of what you would need to do and then also analyze the fabrics to see which types of fabrics stretch better. And some of them will stretch more than others and be -- and be comfortable on different sizes.

Q. Would you use mannequins, as well? Is that something that's done?

A. Yeah. You have mannequins with -- sometimes they will have a strap-on pregnant belly or you can actually have mannequins made to different sizes of the pregnancy.

Q. Okay. And that would be part of the process of designing a -- maternity pants that went to just under the breast area?

A. That's right. They would check it on different sizes -- different sizes and different timing of the pregnancy, so six months, seven months, eight months, depending on that.

Harder Dep. 135:2-24 (Ex. 2018).

Moreover, Petitioner's expert testified that the JCP-A pants were "too big for

the mannequin”:

Q. And you're saying these are loose around the crotch?

A. They look loose.

Q. Is it possible that the reason for that is that the jeans are falling down a little bit on this mannequin so it's not tight over the crotch?

MR. LECHLEITER: Objection. Form.

THE WITNESS: I would say that the pants are too big for the mannequin, so that's probably the reason why.

Id. 189:10-19.

If Petitioner’s expert is correct, the panel in JCP-A is pictured extending higher than it would on a correctly-sized wearer because smaller sized pants that actually fit on the mannequin would have a lower panel. *See Id.* 133:10-17, 212:23-214:16; Ex. 2017; Brookstein Dec. at ¶ 45.

JCP-A does not show a garment that extends just beneath the breast area and, thus, JCP-A is not anticipatory.

b. JCP-A does not disclose “substantially covering the wearer's entire pregnant abdomen during all stages of pregnancy”

Petitioner contends that JCP-A anticipates the claim’s substantially covering the wearer’s entire pregnant abdomen during all stages of pregnancy limitation because “[t]he upper edge of the belly panel in JCP-A is above the belly, i.e. at the wearer’s upper torso, because the belly panel provides ‘over-the-belly coverage.’

and holds the garment in place ‘before, during and after your pregnancy.’” Corrected Pet. at 32; *see also* Ex. 2017, Brookstein Dec. at ¶ 46. Yet Petitioner ignores that in the JCP-A picture, the garment does not have an upper edge encircling the wearer’s torso just beneath the breast area which is configured to hold the garment up and in place about the torso during all stages of pregnancy. *Id.* In the garments of JCP-A, the already incomplete belly coverage discussed above is shown with no disclosure relating to holding the garment up and in place about the torso “during all stages of pregnancy.” *Id.*

Indeed, in portions of the JCP-A product description omitted by Petitioner, JCP-A states that the “fold-over panel design” of its jeans “allows you to wear them before, during and after your pregnancy (see inset photos),” such that they “can be worn 3 ways depending on your stage of pregnancy.” JCP-A, Ex. 1002 at 2; Ex. 2017, Brookstein Dec. at ¶¶ 46-47. In other words, JCP-A confirms that its “fold-over” feature is essential for holding the garment up and in place during certain stages of pregnancy. *Id.*; *see also* Harder Dep. 198:1-9 (folding fabric increases hold), 199:4-20 (folding fabric may be needed to keep pants up) (Ex. 2018). As illustrated above, when the garment is in the “fold-over” configuration (i.e., images 2. and 3.), which, by JCP-A's own statements, is required at certain stages of pregnancy, even less of the pregnant abdomen is covered. *See* Ex. 2017, Brookstein Dec. at ¶¶ 46-47. Image 3 does not even show coverage to the belly

button, which cannot disclose substantial coverage. *Id.* If JCP-A could operate in the image 1 configuration throughout pregnancy, a person of ordinary skill in the art would expect that unique feature to be advertised. *Id.* ¶ 47. Instead, JCP-A specifically directs users to fold down the garment depending on stage of pregnancy, which shows that the garment could not operate in the image 1 configuration throughout pregnancy. *Id.* As such, JCP-A does not disclose an upper edge encircling the wearer's torso just beneath the breast area configured to hold the garment up and in place about the torso during all stages of pregnancy.

The above analysis is again confirmed by JC Penney's deposition testimony regarding maternity design generally and the design shown in the JCP-A reference, which shows that different styles and locations are used for different stages of pregnancy, rather than one design covering the wearer's entire pregnant abdomen during all stages of pregnancy. For example:

Q. Was there anything particular or special to maternity that other --

A. Yes.

Q. -- design projects didn't have?

A. Yes.

Q. Like what?

A. The fit is much more complicated.

Q. What do you mean?

A. How it fits the body, because you have this belly

that is changing every single day, and you want this pant to fit numerous women of all different sizes of all different stages of pregnancy. So it's really hard to get a good-fitting maternity pant.

Q. How do you address that issue in designing maternity pants?

A. That's why there's multiple styles to address different fits for different women.

Simon Dep. 39:20-40:11 (Ex. 2005).

Q. What about the normal -- whatever -- whatever you designed [JCP-A] on, the normal customer, how would it -- would it change how they wore it depending on what stage of pregnancy they were in?

A. It could.

Q. How could it change?

A. Personal preference. Some people don't like anything over their belly, so regardless of how big they were, they might still want it under their belly. Some people that are used to -- the younger customer that's used to low-rise jeans might love it under the belly and might never raise it over her belly. It's -- it's really a personal preference on where she wants to put it.

Id. 176:25 - 177:6-12.

Q. Okay. We're going to go to the figure Number 1 from [JCP-A]. So pulled all the way up, could someone

who was not pregnant wear the pants that way?

A. They could. I don't know why they would, but they could.

Q. All right. Would the pants -- do you think the pants would stay up if they did that?

A. It depends how skinny she is.

Id. 186:13-20.

By requiring the “fold-over” feature to hold the garment up and in place at earlier stages of pregnancy, the JCP-A garment necessarily exposes more of the wearer’s abdomen during those stages. *See* Ex. 2017, Brookstein Dec. at ¶¶ 46-47. Thus, JCP-A does not disclose claim 1's patented garment that substantially covers the entire abdomen during all stages of pregnancy. Further, even when the JCP-A garment is worn with its fold-over panel in an unfolded position (*i.e.*, image 1. above), the top of the fold-over panel curves downward substantially, further confirming that the JCP-A garment does not include an upper edge that encircles a wearer’s torso just beneath the breast area.

In its institution decision, the Board stated:

[JCP-A] shows that the fold-over panel substantially covers the model’s entire pregnant abdomen; full coverage is not required by the claim. Further, and again, the claim is not limited to a wearer of any particular height or body type. Thus, the fold-over panel would cover even more, and perhaps all, of another wearer’s entire pregnant

abdomen if that wearer were shorter and/or gained less abdominal girth during pregnancy. *See* PTAB Feb. 19, 2014 Dec. Paper 10, at 11.

Using Patent Owner's claim construction, JCP-A does not substantially cover the wearer's entire pregnant abdomen during all stages of pregnancy. Although full coverage may not be required, the top of the panel must also reach just beneath the breast area, which JCP-A does not show.

Even disregarding the "just beneath the breast area" limitation, JCP-A does not disclose "substantially covering the wearer's entire pregnant abdomen during all stages of pregnancy" because JCP-A shows coverage below the belly button in the earliest stages of pregnancy. *See* Ex. 2017, Brookstein Dec. at ¶ 47.

As noted above, claim 1 is not affected by wearers of different body types in the manner asserted by the Board. *See* Ex. 2017, Brookstein Dec. at ¶ 44. The Specification describes the same coverage on different body types because of the expansible and contractible nature of the patented garment, which allows the panel to reach just beneath the breast area during all stages of pregnancy on wearers of different body types thereby substantially covering the entire pregnant abdomen. Even assuming, *arguendo*, that the model in JCP-A has a non-standard body type, JCP-A would still have to reach just beneath the breast area to be anticipatory. It does not.

Further, as noted above, it would be understood by one skilled in the art that the correct size of the garment is worn. *See* Ex. 2017, Brookstein Dec. at ¶ 45; Harder Dep. 133:10-17, 212:23-214:16 (Ex. 2018). The possibility that the pictured garment in JCP-A could reach just beneath the breast area thereby covering the entire pregnant abdomen during all stages of pregnancy on a person where the pictured JCP-A is a few sizes too big does not convert JCP-A into a § 102 reference. Rather, Petitioner’s expert explained how a garment could be designed to reach just beneath the breast area accounting for different sizes. Harder Dep. 135:2-24 (Ex. 2018).

Moreover, Petitioner’s expert testified that the JCP-A pants were “too big for the mannequin.” *Id.* 189:10-19. If Petitioner’s expert is correct, the panel in JCP-A is pictured extending higher than it would on a correctly-sized wearer.

JCP-A does not show “substantially covering the wearer’s entire pregnant abdomen during all stages of pregnancy” and, thus, JCP-A is not anticipatory.

c. The PTO already concluded that JCP-A is not anticipatory

Petitioner contends that Patent Owner failed to submit JCP-A to the PTO in color. Corrected Pet. at 15-17. To the contrary, the PTO considered JCP-A in high resolution color, in direct contrast to Petitioner’s argument that “the scanned excerpt appears to have been of very low quality . . . image does not provide a clear illustration of the boundaries of the disclosed belly panel in the three figures, and the

text describing the functionality of the fold over panel in the three figures is illegible.” *Id.* at 15-16. Patent Owner’s submission of JCP-A to the PTO is reproduced below and taken directly from the PTO’s records.⁴ Ex. 2003; Ex. 2004.



The PTO thus fully considered JCP-A, and decided that JCP-A was not relevant to the claims of the ‘531 Patent. Ex. 2003; Ex. 2004; Corrected Pet. Ex. No. 1021. Indeed, JCP-A was so inconsequential that the Examiner did not issue an office action citing JCP-A. *See* Petitioner Exhibits 1020-21. Significantly, the PTO

⁴ JCP-A was submitted in color in all prosecutions and the same PTO examiner reviewed all patents. Patent Owner obtained a color artifact from the PTO from the file history for U.S. 7,900,276 (reissued as the '563 Patent).

reached the same exact conclusion in Patent Owner's '563 Patent, where JCP-A was again submitted to the PTO in high resolution color, considered by the Examiner, and no rejections were raised there either. *Id.* 1007.

The PTO's decision on JCP-A was rendered by a seasoned examiner of apparel patent applications versed in analogous art whose amendment added the aforementioned limitations that Patent Owner asserts JCP-A does not disclose. The examiner's decision should be afforded substantial weight. *See Andersen Corp. v. Pella Corp.*, 300 Fed. App'x 893, 899 (Fed. Cir. 2008) ("When no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job, which includes one or more examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents") (citations omitted).

V. THE DEPENDENT CLAIMS ARE VALID BECAUSE JCP-A DOES NOT ANTICIPATE CLAIM 1

A dependent claim that adds additional limitations to a valid independent claim cannot be invalid for anticipation or obviousness. 37 C.F.R. 1.75(c) (dependent claims further limit independent claims); *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1343-45 (Fed. Cir. 2009) (vacating a judgment and ordering a new trial on obviousness when a jury found a dependent claim obvious while finding

its independent claim nonobvious).

Here, dependent claims 24-29 are challenged because JCP-A allegedly anticipates claim 1, and JCP-A, either alone or in combination with other alleged prior art, allegedly teach the additional limitations of dependent claims 24-29. As shown above, JCP-A does not anticipate claim 1. Accordingly, dependent claims 24-29 are likewise patentable because they further narrow claim 1. *See* Ex. 2017, Brookstein Dec. at ¶¶ 42, 49.

The challenged dependent claims are patentable because each adds additional limitations to Patent Owner’s valid independent claim 1, as shown below.

Claim 24 further limits claim 1 because it requires that the garment upper portion be “foldable toward the garment lower portion to provide a folded band on the garment lower portion to be worn as a garment bottom having no top.” ‘531 Patent, claim 24.

Claim 25 further limits claim 1 because it requires that “the garment lower portion comprises one of a pair of trousers and a skirt.” *Id.*, claim 25.

Claim 26 further limits claim 1 because it requires that “the garment lower portion comprises denim jeans.” *Id.*, claim 26.

Claim 27 further limits claim 1 because it requires that “the garment lower portion comprises a zipperless fly.” *Id.*, claim 27.

Claim 28 further limits claim 1 because it requires that the “first

torso-encircling circumference recedes downward with a parabolic shape . . . including a shallow curvature.” *Id.*, claim 28.

Claim 29 further limits claim 1 because it requires that the “belly panel extends at least partially under the abdomen of the wearer to meet the parabolic receding circumference of the garment lower portion.” *Id.*, claim 29.

As such, Petitioner’s Corrected Petition should be dismissed because (a) JCP-A does not anticipate claim 1 of the ‘531 Patent; (b) the grounds for anticipation and obviousness for the dependent claims require claim 1 to be anticipated by JCP-A; and (c) claims 24-29 further narrow claim 1.

VI. JCP-A DOES NOT DISCLOSE THE LIMITATIONS OF CLAIM 24

Claim 24 requires that “the garment upper portion is foldable toward the garment lower portion to provide a folded band on the garment lower portion to be worn as a garment bottom having no top.” ‘531 Patent, claim 24. Although JCP-A is described and illustrated as foldable, the pictured images of JCP-A neither overlay any portion of the jeans nor provide a garment bottom with no top. *See* Ex. 2017, Brookstein Dec. at ¶ 53. Also, nothing in JCP-A supports that JCP-A is capable of operating in this manner without falling down. *Id.* As such, JCP-A does not disclose the limitations of Claim 24.

Even assuming, *arguendo*, that JCP-A may be folded to a position creating a folded band located completely on the garment lower portion, the JCP-A pants would not function in such a position. *Id.* As noted above, the JCP-A garment engages its “fold-over panel” feature that is placed directly on the belly to hold the garment up and in place during certain stages of pregnancy. As such, the added belly girth of a pregnancy would be needed along with a fold-over at a lower portion of the belly for JCP-A to function. *Id.* Notwithstanding, the mere possibility that JCP-A could disclose claim 24 is insufficient for anticipation. *See Continental Can Co. USA, Inc.*, 948 F.2d at 1269 (“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient”).

VII. CLAIMS 26 AND 27 ARE NOT OBVIOUS BECAUSE OF SECONDARY CONSIDERATIONS

Even if, *arguendo*, JCP-A anticipates claim 1, copying and commercial success⁵ show that claims 26 and 27 are not obvious. “Secondary considerations evidence can establish that an invention appearing to have been obvious in light of the prior art was not and may be the most probative and cogent evidence in the

⁵ Patent Owner, Destination Maternity Corporation (formerly Mothers Work, Inc.), sells products under multiple brands, including Motherhood Maternity®, A Pea in the Pod®, Oh Baby by Motherhood®, and Two Hearts by Destination Maternity®.

record." *Apple Inc. v. ITC*, 725 F.3d 1356, 1366 (Fed. Cir. 2013) (citations and internal punctuation omitted). "This evidence guards against the use of hindsight because it helps turn back the clock and place the claims in the context that led to their invention." *Id.* (citations and internal punctuation omitted). "Objective evidence of nonobviousness can include copying, long felt but unsolved need, failure of others, commercial success, unexpected results created by the claimed invention, unexpected properties of the claimed invention, licenses showing industry respect for the invention, and skepticism of skilled artisans before the invention." *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 711 F.3d 1348, 1368 (Fed. Cir. 2013).

Petitioner states that it is "unaware" of secondary considerations of nonobviousness. Corrected Pet. at 54. This is surprising, since Petitioner began selling products identical to Patent Owner's Secret Fit Belly® product after seeing the commercial success of the Secret Fit Belly® styles. See Ex. 2021 (July 17, 2007 Patent Owner press release introducing Secret Fit Belly®), available at <http://destinationmaternitycorp.mediaroom.com/index.php?s=43&item=55>; Ex.

2020 (**Redacted**)
Redacted
Redacted); Brady Dep. 111:15-112:8 (**Redacted**)
Redacted) (Ex. 2019); *id.* 43:21-44:5 (**Redacted**)

Redacted

Redacted).

In fact, Petitioner's expert testified that the only difference between Petitioner's pants and Patent Owner's Secret Fit Belly® styles she was aware of was that one of the Target pants had a seam in the back:

A. And also with Target's, I -- the attorneys showed me maternity samples.

Q. Did you compare Secret Fit with Target's pants?

MR. LECHLEITER: Objection. Form.

THE WITNESS: I think that we, obviously, talked about any differences.

Q. BY MR. POLLACK: Well, what differences did you see?

MR. LECHLEITER: Objection. Form.

THE WITNESS: I think that on the -- one of the Target ones, they were -- had a seam maybe in the back, and that was -- I don't know about the other differences. I think they're all -- I think there was a combination, but not -- no.

Harder Dep. 125:6-20 (Ex. 2018).

As such, Petitioner merely copied Patent Owner's successful Secret Fit Belly® styles.

The success of the patented Secret Fit Belly® styles, which practice all of the

instituted claims of the Patents-in-Suit including the claims challenged for obviousness, is evidenced in the attached commercial success report. *See* Ex. 2022, Green Dec.. at 31-37; Ex. 2017, Brookstein Dec., Exhibit 2. As shown, Secret Fit Belly® bottoms practicing the Patents-in-Suit are commercially successful. *See* Green Dec. at 31-37. The economic evidence of commercial success is powerful, and is demonstrated by the following: (1) millions of dollars of sales and profits for the patented products; (2) Secret Fit Belly® bottom sales have steadily increased as non-patented product sales have significantly decreased; (3) Secret Fit Belly® bottoms receive a price premium over non patented bottoms; and (4) the patented product has been used by competitors such as Target, which is evidenced above. *Id.* Indeed, the graphs below, taken from the Declaration of Philip Green, Patent Owner's commercial success expert, demonstrates that the patented products took away most of the market for non-patented products, even though the patented products cost more on average and were otherwise identical or nearly identical to the non-patented products:

Redacted

The Secret Fit Belly® bottom commercial success is due to the patented technology rather than marketing or other promotional activities, availability, or the non-patented features of the bottoms. Green Dec. at ¶¶ 38-42. For example, Redacted

Redacted

Redacted

Id. at ¶39. Patent Owner also sells its patented Secret Fit Belly® bottoms and unpatented bottoms in all of its stores and collections. *Id.* Finally, the only difference between the Secret Fit Belly® bottoms and all other bottoms are the patented features. *Id.* at ¶42.

VIII. PETITIONER’S EXPERT’S CONTRIBUTION IS TENUOUS

Petitioner’s expert’s contribution is questionable because (1) Petitioner’s expert does not appear to understand the requirements for anticipation; (2) Petitioner’s expert does not appear to understand patents; (3) Petitioner’s expert did not appear to do much, if any, independent evaluation; (4) Petitioner’s expert did not review prior art sample garments, but stated that she would need to see samples to form an opinion as to whether claim elements were present; and (5) even if Petitioner’s expert is an expert fashion designer, she is not an expert on a critical question at issue here: whether the invention provides functional advantages due to the panel height.

First, Petitioner’s expert does not appear to understand the requirements for anticipation because she believed that prior art only needed “most of the elements.” Harder Dep. 52:12-53:1 (Ex. 2018). Even though Petitioner’s expert was corrected, this “most of the elements” belief appeared to carry through her testimony because Petitioner’s expert was more focused on testifying that it would have been obvious

to make the claimed inventions. *Id.* 34:6-9 (“I’m here . . . as an expert to discuss what -- what would be obvious for anyone to make into a garment. . . .”); *id.* 49:2-10 (“A. I was hired . . . as an expert in the clothing industry, as a person who -- who understands what anyone would be able to do when they were putting together a garment or pieces to put the garments together. I’m not here to give definitions on legal terms or to answer examinations as to what definitions of legal terms are.”); *id.* 71:3-9 (“I’m not here today to give you translations from patents. I’m not an expert on legalese. So I’m here to give you an idea of what a person of ordinary interest would understand from taking the information that’s already available and out in the market and making it into a garment that they could wear when they were pregnant.”); *id.* 150:1-6 (“I think we were discussing what it would need for an ordinary person in the arts to be able to take the existing -- pre-existing artwork to come to the conclusion that was obvious to create a maternity pant with an extended tubular knit to go over the belly.”); *id.* 151:15-20 (alleging that Patent Owner’s inventor is obvious); *id.* 153:1-7 (same).

Moreover, although Petitioner’s expert testified that Browder is not anticipatory, Petitioner’s expert also agreed, in direct conflict, to claim charts alleging anticipation by Browder. *Compare Id.* 53:17-20 (testifying that Browder is not anticipatory); *with id.* 166:4-167:11 (explaining expert’s involvement in claim charts) *and* Harder Dec. at ¶ 18 (Ex. 1011) (“I have reviewed and agree with [the

petitions’] unpatentability grounds and their associated claim charts and descriptions of unpatentability grounds, in all respects”). Accordingly, Petitioner’s expert’s support for anticipation is tenuous at best.

Second, Petitioner’s expert does not appear to understand patents. Petitioner’s expert neither worked on a patent case nor read a patent before this engagement. Harder Dep. 71:25-72:7 (Ex. 2018). Petitioner’s expert did not spend much time reviewing the Patents-in-Suit and admitted that she did not retain much. *E.g.*, Harder Dep. 9:16-10:5 (Ex. 2018). Petitioner’s expert also could not locate claims within a patent or the claim charts within one of Petitioner’s petitions. *Id.* 12:14-15:23 (claims); *id.* 168:8-23 (claim chart). Moreover, Petitioner’s expert could not explain what the acronym “POSA” means, *id.* 148:13-149-17, and did not recall the term “claim construction.” *Id.* 48:6-8.

Third, Petitioner’s expert did not appear to do much, if any, independent evaluation. Petitioner’s expert only reviewed information supplied by counsel and did not request any additional information. *Id.* 96:8-19. Petitioner’s expert also could not remember what contributions she made to the claim charts, but claimed that she agreed with counsel on terminology. *Id.* 170:4-11, 173:22-175:9. Accordingly, it appears that Petitioner’s claim charts were merely rubber stamped by Petitioner’s expert.

Fourth, Petitioner’s expert did not review prior art sample garments, yet stated

that she would need to see samples to form an opinion as to whether claim elements were present. *Id.* 55:20-56:4 (expert would have to see the Browder garment to determine whether it is expansible); *id.* 67:18-68:16 (same); *id.* 60:6-62:21 (expert would need to see a fabric sample to define Browder's one by one alternating tuck stitch pattern and determine expansibility); *id.* 72:16-73:2 (expert would need to see a sample of Browder to evaluate Browder's tuck stitch); *id.* 76:25-77:17 (same); *id.* 96:20-97:13 (expert did not see any prior art samples and was surprised that none existed). Because Petitioner's expert would need to see actual clothing samples and did not, Petitioner's expert's support for invalidity is incredible.

Finally, even if Petitioner's expert is an expert fashion designer, she is not an expert on a critical question at issue here: whether the invention provides functional advantages due to the panel height. *E.g., Id.* 192:14-18, 199:21-200:5 (the ability to hold up pants is not affected by coverage); *id.* 195:14-19 (folding JCP-A only affects comfort); *id.* 196:15-197:2 (confusing the frictional force that helps hold pants up with rubbing on skin); *id.* 207:10-15 (a technical designer would be needed to determine whether pants are sufficiently held up); *id.* 223:22-224:19 (forces that affect pant functionality is outside of Petitioner's expert's expertise). Without an ability to understand the functionality of the Patents-in-Suit, Petitioner's expert is ill equipped to opine on validity.

IX. CONCLUSION

Based on the foregoing, the instituted claims should be held valid.

Dated: May 5, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6 and 42.120, the undersigned certifies that on May 5, 2014, a complete and entire copy of Patent Owner Destination Maternity Corporation's Response to Corrected Petition for *Inter Partes* Review of U.S. Patent No. RE43,531 was provided via email to the Petitioner by serving the email correspondence address of record as follows:

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