

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: December 4, 2013

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

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LIST OF EXHIBITS

- Exhibit 2001: October 19, 2007 blog post on The Mommy Playbook
- Exhibit 2002: July 31, 2008 blog post on Mamanista!
- 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 RE43,531
- Exhibit 2005: Excerpts from the October 10, 2013 Deposition of Mindy Simon
- Exhibit 2006: Excerpts from the October 4, 2013 Deposition of Gregory Stangle
- Exhibit 2007: May 31, 2008 blog post on Everyday Becky
- Exhibit 2008: July 15, 2008 Review: Secret Fit Belly Jeans from Motherhood Maternity
- Exhibit 2009: January 30, 2008 blog post on Pinching Your Pennies Forums
- Exhibit 2010: October 28, 2008 blog post on The Shy Girl's Guide to Pregnancy and Parenting
- Exhibit 2011: October 3, 2008 blog post on Mamapedia
- Exhibit 2012: January 2008 blog post on The Bump
- Exhibit 2013: October 15, 2008 blog post on Pregnant Fashionista
- Exhibit 2014: August 2008 blog post on Libby's Latest
- Exhibit 2015: January 6, 2009 blog post on Keeping the Kingdom First
- Exhibit 2016: May 21, 2009 blog post on Pregnant Fashionista

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.107, patent owner, Destination Maternity Corporation (“Patent Owner”), hereby submits the following Preliminary 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 35 U.S.C. 313 and 37 C.F.R. 42.107, as it is being filed within three months of the September 5, 2013 mailing date of the Notice granting the Corrected Petition a filing date of August 27, 2013. *See* PTAB Sept. 5, 2013 Not. at 1. A trial should not be instituted in this matter as none of the references relied upon by Petitioner in its Corrected Petition gives rise to a reasonable likelihood of Petitioner prevailing with respect to a challenged claim of the '531 Patent.

Petitioner has simultaneously filed three additional petitions for *Inter Partes* Review, two for each of the patents-in-suit (the '531 Patent and Patent No. RE43,563 (the “‘563 Patent”))¹ that are being asserted against Petitioner in a litigation pending

¹ The Petition for *Inter Partes* Review No. 2013-00532 requested review of claims 1, 2, 5, 6, 10, 11, 15-17 of the '531 Patent. The Petition for *Inter Partes* Review No. 2013-00530 requested review of claims 1-4 and 6-8 of the '563 Patent. The Petition for *Inter Partes* Review No. 2013-00531 requested review of claims 1, 10-14, 16, 20, and 21 of the '563 Patent.

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. An exemplary image of Patent Owner's Secret Fit Belly® line of maternity bottoms is provided below:



Petitioner's petitions, including the one at issue, all seek to cancel claim 1 of Patent Owner's patents-in-suit as anticipated, and each relies on the same three references: (1) 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; (2) an abandoned patent application for a piece of fabric that can be used to cover an open zipper when a pregnant woman's regular bottoms no longer fit when fastened; and (3) a patent for a *constricting* girdle, not an *expansible* maternity garment. Petitioner adds additional references to argue that the '531 Patent's dependent claims are obvious. None of these references make the claimed invention anticipated or obvious: they do not disclose or suggest the unique above-the-abdomen and below-the-breast elements that Patent Owner invented.

Moreover, Petitioner's arguments include three serious threshold issues. First, Petitioner asserts that the JC Penney reference was sent to the PTO by Patent Owner as low-quality black and white images. This statement is wrong. Patent Owner provided high quality color images to the PTO of this reference, as shown by the PTO's own records. Second, Petitioner "modified" images to make its arguments, but these modified images are not evidence, and should be disregarded. Petitioner's reliance on its "modified" images reflects the weakness of its case. Third, to skirt the 60-page limitation, Petitioner used claim charts in direct contravention of the rules, even after this Board identified a defect in Petitioner's charting in its original petitions. Most of Petitioner's arguments are recited in single-spaced claim charts.

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 Petition 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 covered and fit a growing abdomen of different body types during all stages of pregnancy, which fit comfortably. *Id.* 1.34-38.

The inventor's success in filling the aforementioned needs, among others, was evidenced in the popularity of Patent Owner's Secret Fit Belly® line of maternity

bottoms. Patent Owner's Secret Fit Belly® line of maternity bottoms achieved tremendous commercial success, which has led to the development of hundreds of different Secret Fit Belly® styles currently available online, in Patent Owner's stores, and in third party department stores. Shortly after the introduction of Patent Owner's Secret Fit Belly® styles, a customer commented that the products were "[r]eally hard to find though because they are selling out of them so fast." Ex. 2001. The customer also stated: "All my other maternity pants I'm always tugging up on to keep them up no matter how far along in the pregnancy I am. These pants I don't have to touch once I put on. Its such a nice change." *Id.* Another customer stated: "Secret Fit Jeans put full panel maternity jeans to shame. If you are tired of mid-belly panels that cut into your stomach, fall down, and create awkward 'panel lines,' you'll love the new secret fit panel that comes all the way above your belly to just below your chest." Ex. 2002. This commercial success and product buzz caused many in the industry, including Petitioner, to copy the Secret Fit Belly® styles, thereby prompting the aforementioned lawsuit between Patent Owner and Petitioner.

III. PETITIONER'S REFERENCES DO NOT ANTICIPATE THE '531 PATENT'S 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.

Petitioner attacks this claim solely based on anticipation under 35 U.S.C. § 102. Petitioner relies on three references: (1) J.C. Penney ontrend Maternity Catalog at Page 15 ("JCP-A"), Corrected Pet. Ex. No. 1002 at 2; (2) U.S. Patent App. Pub. No. US 2004/0049834 A1 to Stangle et al. ("Stangle"), Corrected Pet. Ex. No. 1003; and (3) U.S. Patent No. 6,276,175 to Browder ("Browder") Corrected Pet. Ex. No. 1004. Yet none of JCP-A, Stangle, or Browder disclose the claimed elements of a garment upper portion reaching over the belly to just below the breast area as

required for an anticipatory § 102 reference. And neither Stangle nor Browder disclose a garment lower portion that recedes downward to make way for expansion of the belly panel. Indeed, Petitioner's JCP-A reference was submitted by Patent Owner to the United States Patent and Trademark Office (“PTO”) in high quality color (contrary to Petitioner’s assertions), considered by the Examiner, and was not even deemed relevant enough to warrant an Office Action. Ex. 2003; Ex. 2004. As further detailed below, none of Petitioner's asserted references anticipate claim 1 under §102.²

a. JCP-A does not disclose the garment upper portion having the features claimed

JCP-A is not an anticipatory reference simply because someone at JC Penney labeled a picture as “over-the-belly coverage.” The picture above the JCP-A “over-the-belly coverage” description does not show an upper edge of the belly panel that encircles a wearer's torso *just beneath the wearer's breast area*; the JCP-A picture does not show either the model's breast area or the top of the belly. And the JCP-A picture does not show the extent of belly coverage during different stages of pregnancy. Accordingly, what JC Penney called “over-the-belly coverage” does not

² The Corrected Petition’s grounds for unpatentability of the dependent claims hinge on either JCP-A, Stangle, or Browder anticipating claim 1. Because none of JCP-A, Stangle, or Browder anticipates claim 1, these grounds also fail.

meet the '531 Patent claims' requirement that the "upper portion ... encircles a wearer's torso just beneath the wearer's breast area"

To the contrary, in the photographs from JCP-A, 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:



Consistent with these conclusions, JC Penny's corporate witness testified that JCP-A's "over-the-belly" design rested on the belly, rather than at 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?

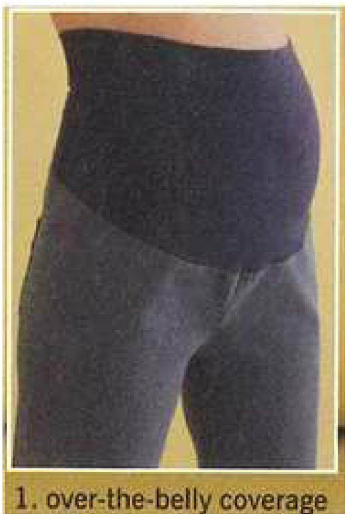
A. Because the belly is curved, **so when it sits on the belly, it curves to the shape of the belly.**

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®

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, an upper edge of the belly panel that encircles a wearer's torso just beneath the wearer's breast area or substantial coverage of the wearer's entire pregnant abdomen.

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 33. 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. Corrected Pet. at 32-33. In the JCP-A images reproduced below, the already incomplete belly coverage discussed above is shown on a model who appears to be at nearly the same stage of pregnancy in all three images, with no disclosure relating to holding the garment "up and in place about the torso during all stages of pregnancy":



In addition, in portions of the JCP-A product description omitted by Petitioner, JCP-A describes the above images and states that it is the "fold-over

panel design that allows you to wear them before, during and after your pregnancy (see inset photos)” and that JCP-A “can be worn 3 ways depending on your stage of pregnancy.” 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. 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. As such, JCP-A fails to 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. Thus, JCP-A does not disclose claim 1's new 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.

Petitioner also 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.³ Ex. 2003; Ex. 2004.



³ 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).

JCP-A was sent to the PTO in high quality and clearly shows all details of JCP-A, including the boundaries of the disclosed belly panel and the text as to the functionality of the fold over panel.

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 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, which was rendered by a seasoned examiner of apparel patent applications, should be afforded substantial weight in determining whether to institute an *Inter Partes* Review, especially in view of the fact that JCP-A was considered twice by the PTO, and was in high resolution color each time. *See* 35 U.S.C. § 325(d) ("In determining whether to institute or order a proceeding under . . . chapter 31 [*Inter Partes* Review] . . . the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office"); *see also 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); *Rohr v. McNulty et al.*, 2003 WL 1386643, at *2-3 (Bd. Pat. App. & Interf. Mar. 6, 2003) (deferring to the experience of examiners when denying a request to add claims to an interference.)

In sum, JCP-A does not anticipate claim 1 of the '531 Patent, Petitioner's asserted arguments fail, and a trial should not be instituted on these grounds.

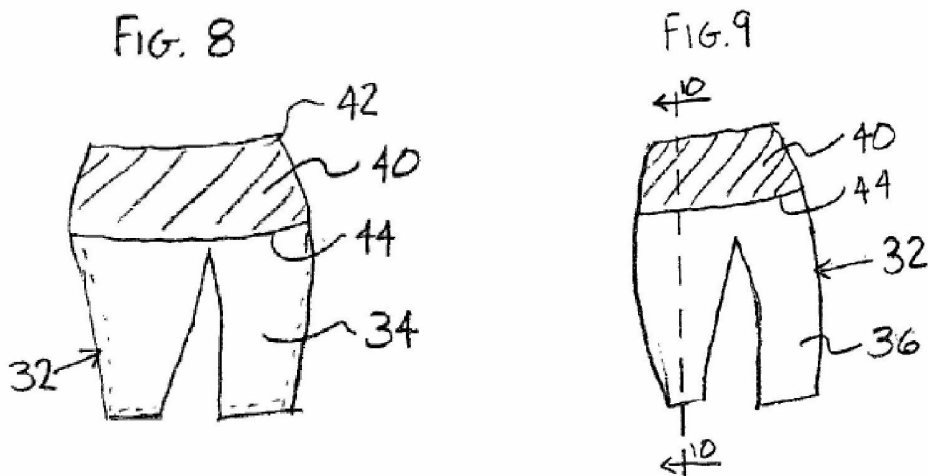
- b. Stangle does not disclose either a garment upper portion or a garment lower portion that recedes downward to make way for expansion of the belly panel

There are two key elements that Stangle does not disclose: (1) "a garment upper portion ... that is expansible to cover and fit over a growing abdomen during different states of pregnancy ..."; and (2), "a garment lower portion ... that recedes downward to make way for expansion of the belly panel." Instead, Stangle discloses a tube of fabric that is used to cover an unzipped pair of non-maternity pants. *E.g.*, Stangle, Fig. 9; ¶ [0040] (Corrected Pet. Ex. No. 1003).

First, Stangle does not disclose a garment upper portion that is expansible to cover and fit over a growing abdomen during different states of pregnancy. The one Stangle embodiment that is attached to clothing, shown in Stangle Figures 7-10,

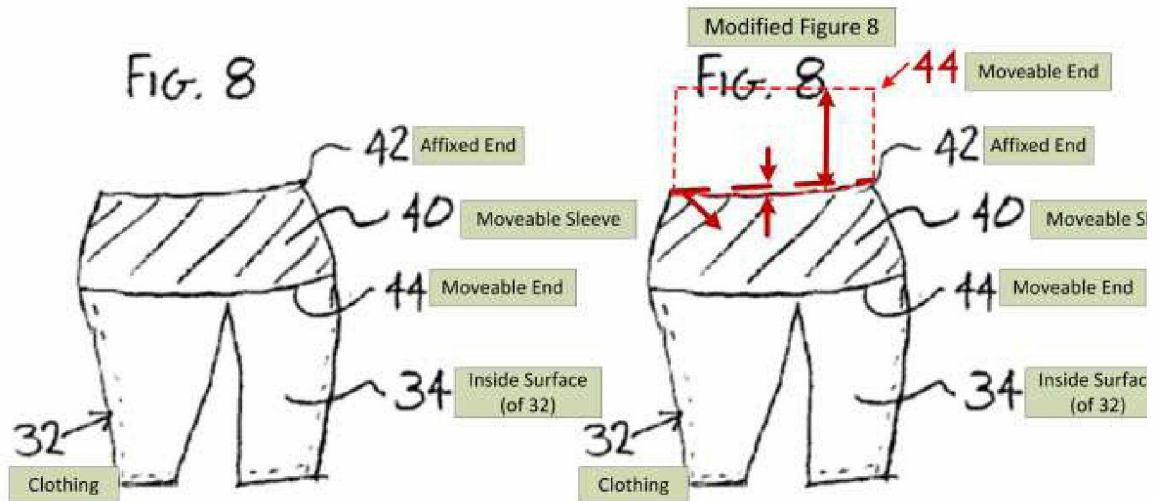
folds from the waist area downward toward the crotch to operate as a covering for unfastened conventional pants and provide support so the pants do not fall down. *Id.* Figs. 7-10; ¶¶ [0037] – [0042]. As such, Stangle is worn very low on the body, and goes no higher on the wearer than the top of a lower-body garment (e.g., pant waist line), which is ordinarily worn around the waist area.

Stangle Figures 8 and 9 illustrate the function of the attached moveable sleeve. Figure 8, an inside-out view of clothing, shows the sleeve *not in use* and “folded over inside the clothing 32 when not deployed by the wearer” Stangle, ¶ [0040]. Figure 9 shows the sleeve *in use* when, “as the wearer finds necessary for fastening undersize clothing or providing additional coverage or support, the wearer would instantly deploy the movable sleeve 40 by simply folding it out and over the outside surface 36 of the clothing 32 to achieve its function” *Id.*



In its Corrected Petition, Petitioner “modified” Stangle Figure 8 by sketching

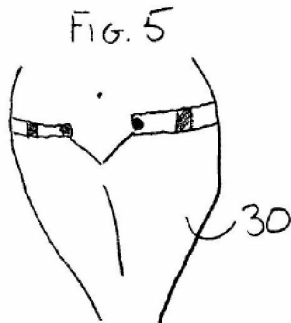
new features into Figure 8. Corrected Pet. at 25, 43-47.



Petitioner’s “modified” figure—created with knowledge of the invention—cannot be used to add to what Stangle disclosed. Petitioner’s “modified” Figure 8 is misleading and not evidence, and should be disregarded. Moreover, Petitioner imported dimensions to a patent figure that was not drawn to scale, which cannot be used to challenge validity. *See, e.g., Nystrom v. TREX Co., Inc.*, 424 F.3d 1136, 1149 (Fed. Cir. 2005) (“arguments based on drawings not explicitly made to scale in issued patents are unavailing”).

When attached to clothing, the Stangle sleeve is folded on top of, and downward over, the waist area of unfastened pants to cover the crotch area of the unfastened pants. Stangle, Figs. 7-10; ¶¶ [0037] – [0042]. Stangle does not work with its sleeve folded up, because the wearer would be forced to expose an

unfastened crotch as shown in Stangle Figure 5:



The above analysis is buttressed by Gregory Stangle's own deposition testimony:

Q. I want to go back to your patent application. I think it's Exhibit 4. You testified earlier that figures 7 to 10 are the figures where the -- we have it attached to the pants; is that correct?

A. Yes.

Q. Okay. And the description of those, I believe, starts around paragraph 37. Take some time to review paragraph 37 to 46. (Witness viewing document.)

BY THE WITNESS:

A. Okay.

Q. In what you reviewed, do any of the paragraphs discuss wearing these -- the attached sleeve up over the belly, upwards from the waist?

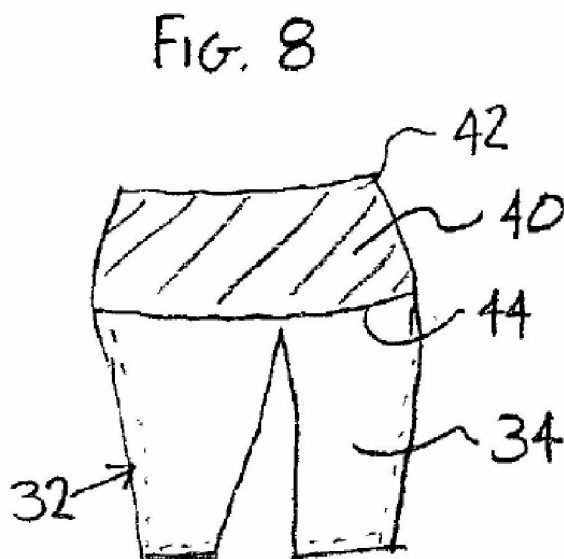
A. No.

Q. Does anywhere in your patent application disclose that way of wearing the pants, the attachments?

A. No.

Stangle Dep. 173:21-174 (Ex. 2006).

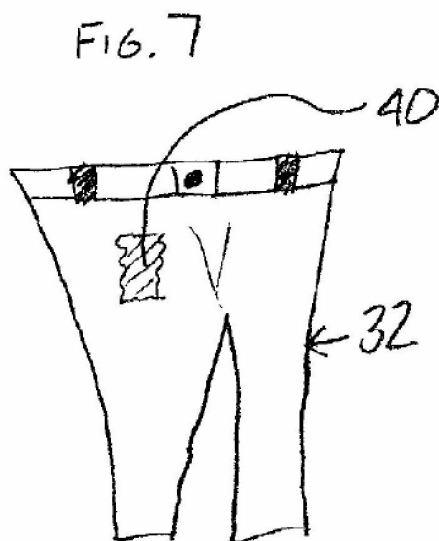
Significantly, even if a user pulled the Stangle sleeve upwards—thus exposing the crotch—the top of the moveable sleeve would not reach just beneath the wearer's breast area. As illustrated in unmodified Stangle Figure 8, the sleeve extends only from the waist to the crotch:



If the Stangle sleeve were made long enough to reach to just below the breast area, it would bunch up at the inseam in Figure 8. Stangle's attached sleeve is meant to be "built into clothing 32 without impacting normal use." Stangle, [0025], [0040]. Bunched-up material inside the pants at the crotch would impact Stangle's

normal use, not only by being uncomfortable, but by impeding the fit and closure of the garment.

Second, Stangle does not disclose a garment lower portion that recedes downward. Stangle's Figure 7 shows that there is no area that recedes downward to make way for expansion of the belly panel. Instead, Stangle's tube is attached and worn with *conventional* pants. In conventional pants, the waist band extends straight across. And when Stangle's tube is deployed on conventional pants, it too extends straight across to cover an open zipper and hold the pants up. *E.g.*, Stangle, Fig. 7, ¶¶ [0038] – [0039]:



Stangle's attached sleeve is meant to be “built into clothing 32 without impacting normal use.” Stangle, [0025], [0040]. This allows a wearer to don the clothing in a normal fashion and only deploy the sleeve when necessary due to, for

example, the clothing no longer fastening. *Id.* at [0040]. Accordingly, aside from not being disclosed, the fabric tube of Stangle to be used with traditional clothing would not include a first torso encircling circumference that recedes downward to make way for expansion of the belly panel. Moreover, even aside from the fact that Stangle fails to disclose a downward recession, there is no reason why Stangle would need a downward recession in its waist band, as it would serve no purpose: Stangle's sleeve is folded over unfastened pants. Accordingly, Stangle does not disclose a garment lower portion that recedes downward as shown in Figure 7.

In sum, Stangle does not anticipate claim 1 of the '531 Patent.

- c. Browder fails to disclose either a garment upper portion or a garment lower portion that recedes downward to make way for expansion of the belly panel

Browder is a girdle. The Browder embodiments Petitioner points to are not maternity garments. It is also missing two key elements: (1) an "upper portion that is expansible to cover and fit over a growing abdomen"; and (2) a "lower portion ... that recedes downward ..."

First, Browder fails to disclose a garment upper portion that is expansible to cover and fit over a growing abdomen. The Browder girdle requires "at least one area of control that has a stitch pattern increasing its modulus by about 8%, to provide a balance of comfort and control." Browder, Abstract (Corrected Pet. Ex. No. 1004). The control area is a portion of the girdle that is manufactured by

“tightening the fabric . . . by using a 1 by 1 (1×1) alternating tuck stitch pattern.” *Id.* col.3, 1.37-38. The tightened fabric pattern “increases the modulus of the fabric . . . [such that] the fabric stretches less and controls more.” *Id.* 1.39-41. Accordingly, the control area of Browder is specifically designed to tighten, rather than expand, like the garment upper portion of claim 1. It would be quite unpleasant to wear for a pregnant woman, if not harmful to the baby.

Like all girdles, the "control area" 35 of Browder tightens, rather than expands. *See* Browder, col. 3, 1.53-57 (“FIGS. 3 and 4 illustrate . . . control area 35 . . . extended over the abdomen and ends below the wearer’s breasts”).

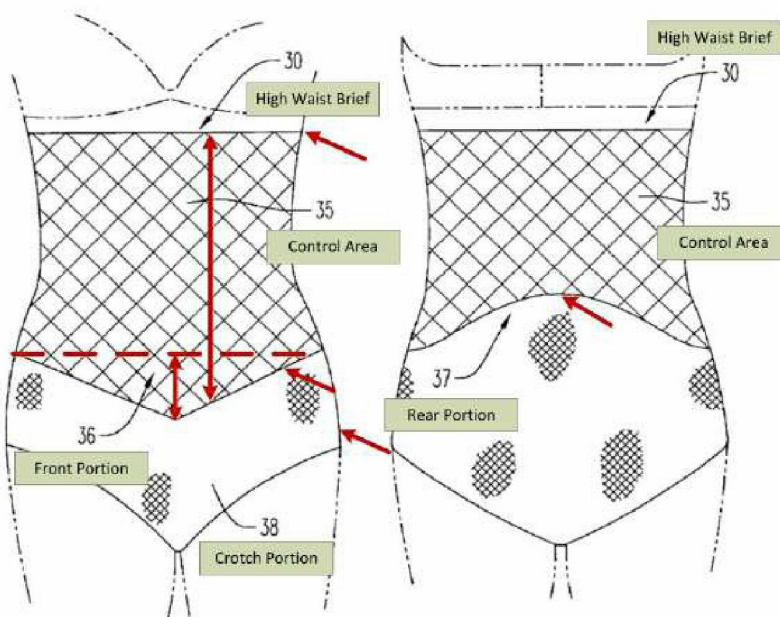


FIG. 3

FIG. 4

Browder’s control area 35 prevents expansion in the waist, rather than promotes it. As such, Figures 3 and 4 do not disclose an expansible belly panel that

either covers and fits over a growing abdomen during different stages of pregnancy or substantially covers the wearer's entire pregnant abdomen during all stages of pregnancy.

Second, Browder does not disclose a garment lower portion that recedes downward to make way for expansion of the belly panel. And the downward recession does not make way for an expanding belly panel because the control area 35 prevents expansion in the waist.

Browder also discloses a maternity brief. But Petitioner omitted the figure of Browder's maternity brief, which tops out at the hip, and does not include a downward recession to make way for expansion, as shown in Browder Figure 11:

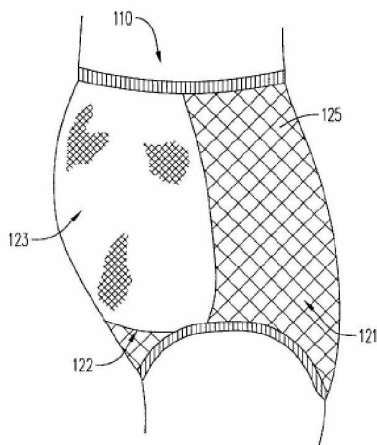


FIG. 11

In describing Figure 11, Browder states that the “control area 125 extends over rear portion 121 and also extends onto front portion 122 covering the wearer’s groin.” Browder, col. 4, 1.53-55. The control area “controls the wearer’s buttocks

and hips, while simultaneously lifting the wearer's stomach area." *Id.* 1.58-59. As can be seen in Browder's Figure 11 that illustrates the maternity brief, this maternity girdle provides partial and incomplete coverage of the belly region, and does not approach the breast area, which again is not pictured. Accordingly, Browder's maternity brief—not maternity clothing—only covers as high as a wearer's hips, and extend nowhere near the breast area or abdomen.

Browder's maternity brief also does not include a lower portion that recedes downward. As can be seen in Browder's Figure 11, the maternity girdle's waist band is designed to run straight across, in order to maintain "control" of the buttocks and hips.

Since at least two key elements are missing, Browder does not anticipate claim 1 of the '531 Patent.

d. The dependent claims are neither anticipated nor obvious because none of the asserted prior art is anticipatory to 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, Petitioner alleges that dependent claims 18, 19, and 24-29 are invalid because JCP-A, Stangle, and Browder anticipate claim 1, and either JCP-A, Stangle, or Browder alone, or in combination with other alleged prior art, teach the additional limitations of dependent claims 18, 19, and 24-29. Corrected Pet. Grounds 1-8. As shown above, none of JCP-A, Stangle, or Browder anticipate claim 1. Accordingly, if dependent claims 18, 19, and 24-29 further narrow claim 1, each are patentable.

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

Claim 18 further limits claim 1 because it requires that the garment upper portion be a "tubular structure [] shaped and formed as a hyperboloid cylinder to fit a body type having a tapered torso." '531 Patent, claim 18.

Claim 19 further limits claim 1 because it requires that the garment upper portion be a "tubular structure [] shaped and formed as a straight sided cylinder to fit a body type having a corresponding shaped torso." *Id.*, claim 19.

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." *Id.*, 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 17.

As such, Petitioner’s Corrected Petition should be dismissed because (a) none of JCP-A, Stangle or Browder anticipates claim 1 of the ‘531 Patent; (b) Petitioner’s anticipation arguments and obviousness combinations for the dependent claims require claim 1 to be anticipated by JCP-A, Stangle or Browder, which is clearly lacking; and (c) claims 18, 19, and 24-29 further narrow claim 1.

e. Petitioner's references do not disclose the limitations of the dependent claims

Even if, *arguendo*, Petitioner met its *Inter Partes* Review burden for claim 1, Petitioner's references do not disclose all of the limitations of the challenged dependent claims.

For reasons of an illustrative example only, and without limitation, Petitioner failed to meet its burden for claim 19. As noted above, claim 19 further requires that the garment upper portion be a “tubular structure [] shaped and formed as a straight sided cylinder to fit a body type having a corresponding shaped torso.” ‘531 Patent, claim 19. Petitioner’s grounds for the unpatentability of claim 19 depend exclusively on either JCP-A or Stangle disclosing each and every element of claim 19. *See* Corrected Pet. Grounds 1 and 5. However, neither JCP-A nor Stangle discloses a garment upper portion having a tubular structure shaped and formed as a straight sided cylinder to fit a body type having a corresponding shaped torso, as claim 19 requires.

JCP-A fails to disclose a garment upper portion having a tubular structure shaped and formed as a straight sided cylinder to fit a body type having a corresponding shaped torso. JCP-A does not disclose either a garment or a torso shaped as a straight sided cylinder as shown in the pictures below, which have no straight garment or body lines.



Stangle also fails to disclose a garment upper portion having a tubular structure shaped and formed as a straight sided cylinder to fit a body type having a corresponding shaped torso. As noted above, the Stangle embodiment that is attached to clothing (Stangle Figures 7-10) folds from the waist area downward toward the crotch to cover unfastened pants and provide support. Stangle, Figs. 7-10; ¶¶ [0037] – [0042] (Corrected Pet. Ex. No. 1003). As such, it does not disclose covering the torso regardless of shape.

Petitioner also uses the “modified” Figure 8 to support Stangle’s disclosure of claim 19, where Petitioner chose to draw a straight-sided addition to Stangle’s Figure 8. Corrected Pet. At 45. As noted above, Petitioner’s *post hoc* drawing is not evidence, and should not be considered to disclose claim 19 simply because Petitioner chose to draw straight lines above the clearly curved tube shown in Stangle’s Figure 8.

If an *Inter Partes* Review is ordered, Patent Owner reserves the right to

provide additional support regarding the inapplicability of the prior art to all of the dependent claims, which for simplicity are not set forth in greater detail herein.

IV. THE CORRECTED PETITION'S CLAIM CHARTS IMPROPERLY CIRCUMVENT THE PAGE LIMIT SET FORTH IN 37 C.F.R. § 42.24

The Board has set forth clear rules for use of claim charts in IPR petitions:

D12. Can claim charts include claim constructions, arguments, and explanations as to how the claims are unpatentable?

No. Extensive usage of claim charts in a petition is discouraged. The rules require that a petition identify how the challenged claims are to be construed and how the claims are unpatentable under the statutory grounds raised. This information is to be provided pursuant to the page limit requirements, which require double spacing. Additionally, the rules require that the petition specify where each element of a challenged claim is to be found in the prior art. The element by element showing may be provided in a claim chart, which is permitted to be written with single spacing. See § 42.6(a)(2)(iii). **Placing one's argument and claim construction in a claim chart to circumvent the double spacing requirement is not permitted.**

and

D13. What is the preferred format for claim charts?

Claim charts should be presented in a **readable format** so that a reader (e.g.,

the patent owner or a deciding official) is able to locate the disputed claim limitations and the relied-upon portions of the prior art quickly. Presenting claim limitations and prior art teachings in a single column format and/or without appropriate spacing creates inefficiency and, at times, appears to circumvent the page limit set forth in 37 C.F.R. § 42.24. Claim limitations should be presented in a separate column (e.g., claim limitations in the left column and prior art teachings in the right column), and **each claim should be presented in a separate chart.**

Frequently Asked Questions for Filing a Petition at D. 12-13, available at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>. (emphasis added.)

Petitioner did not comply with these rules in at least three ways. First, Petitioner circumvents the page limit set forth in 37 C.F.R. § 42.24 by using claim charts to make additional patentability arguments. *See* Corrected Pet. at 32-36, 38, 40, 42, 43-47, 49-50, 51, 53-56. For example, Petitioner's chart for claim 19 in Ground 1 includes over 100 words of argument. *Id.* at 33-34. Petitioner's additional arguments made in single-spaced claim charts violate the rules, and should be ignored, so that Petitioner is not rewarded for these violations.

Second, Petitioner circumvents the page limit by not providing separate charts for each claim as required. *See* Corrected Pet. at 32-36, 38, 43-47, 49-50, 54-56. Petitioner only provided a single charts for claims when a single claim was challenged in a Ground. *Id.* at 40, 42, 54.

Finally, Petitioner circumvents the page limit set forth in 37 C.F.R. § 42.24 by using hodgepodge uneven column widths and inserting images that exceed chart boundaries. *See* Corrected Pet. at 32-36, 38, 40, 42, 43-47, 49-50, 51, 53-56. None of Petitioner's claim charts (except for Petitioner's Grounds where only one claim is challenged) use consecutive rows with uniform column widths as required. *Id.* And even Petitioner's Ground 4 chart, which only challenged claim 26, includes an image that crosses over the bottom edge of the claim chart. *Id.* At 42. Petitioner's space-saving hodgepodge columns and chart-exceeding images violate the rules and circumvent the page limits. This tactic also makes the charts difficult to read, causing inefficiency.

Accordingly, Petitioner's Corrected Petition should be denied under 37 C.F.R. § 42.24 for failing to adhere to the 60-page limitation, or at least, its additional arguments in the charts should be ignored.

V. THE REAL-WORLD VALUE OF THE INVENTION IS SUPPORTED BY STRONG SECONDARY CONSIDERATIONS OF NON-OBVIOUSNESS

"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 record.'" *Apple Inc. v. ITC*, 725 F.3d 1356, 1366 (Fed. Cir. 2013). "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.*

"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 56. 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.

Indeed, the following publicly available reviews for Patent Owner's Secret Fit Belly® line of maternity bottoms call out claimed features of Patent Owner's Secret Fit Belly® garments, show praise for the invention's claimed features, and explain its commercial success⁴:

An October 19, 2007 online review stating "Dude these are the best maternity jeans i've ever had! They are at Motherhood and the best. Really hard to find though because they are selling out of them so fast. I finally gave in and just ordered them

⁴ 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®.

online because I was tired of calling the store checking on each shipment delivery. Has anyone else tried them yet? . . . All my other maternity pants I'm always tugging up on to keep them up no matter how far along in the pregnancy I am. These pants I don't have to touch once I put on. Its such a nice change." Ex. 2001.

A May 13, 2008 blog titled "The BEST Maternity Clothes Ever" states "I discovered a new type of pants/shorts/skirts at Motherhood Maternity called 'Secret Fit Belly.' Oh, if I could only have discovered these gems earlier (or they had been invented earlier!). . . . With other types of maternity belly styles, I am constantly yanking my pants back up where they belong. I never have to do that with these. The belly isn't tight at all, I hardly feel like I'm wearing anything, but somehow it just stays put." Ex. 2007.

A July 15, 2008 blog titled "Review: Secret Fit Belly Jeans from Motherhood Maternity" states "On a recent trip to Motherhood Maternity store, I came across when [sic] of their fairly new products called Secret Fit Belly Jeans. . . . As soon as I slipped the jeans on I could tell that they were no ordinary jeans. When I got the jeans all the way up, it was amazing. They were the most comfortable jeans I have ever worn, pregnant and not pregnant. The Secret Fit Belly jeans from Motherhood Maternity appear to be normal maternity jeans with the full panel. But the belly panel is something quite different. It is like a nylon fabric that has no visible seams. The panel stretches all the way up the belly, but the great part is that at the top there

is no seam on the panel so it is very comfortable on your belly. Also, when you wear a tighter shirt with these Secret Fit Belly jeans you will not be able to tell that you are wearing maternity jeans that have a full panel, as it is smooth on the belly. The belly panel on the Secret Fit Belly jeans hugs the belly and adapts to your growing curves. It is not too tight and it does not keep falling down like other maternity jeans do. . . .

" Ex. 2008.

A July 31, 2008 online review stating "Secret Fit Jeans put full panel maternity jeans to shame. If you are tired of mid-belly panels that cut into your stomach, fall down, and create awkward 'panel lines,' you'll love the new secret fit panel that comes all the way above your belly to just below your chest." Ex. 2002.

A January 30, 2008 online review stating "I am wearing my secret fot [sic] belly jeans right now! These jeans, I kid you not, are the most comfortable jeans I own. I wear them almost every day now that I am 38 week pregnant and everything else is soooooo uncomfortable. I can wear these jeans all day and they never hurt. . . Hands down then best invention since my last pregnancy!" Ex. 2009.

An October 28, 2008 blog entry from The Shy Girl's Guide to Pregnancy and Parenting titled "Things I bought: Most Comfortable Maternity Jeans (and Pants) Ever!!!" that states "Those stretch-band maternity pants can be the pits and at two months post-partum I am (sadly) still more comfy in pants with a stretch waist than my pre-baby jeans. So I wanted to share with you maternity and

someday-may-be-maternity-again mamas the best, most comfortable pair of maternity jeans I have EVER tried on (seriously!) . . . These are Motherhood Maternity's jeans with the "Secret Fit Belly™", and the first time I put them on I told my husband I might just keep wearing them after the baby came. The tummy panel is sooo comfortable, and fits well enough to wear from early baby-belly all the way through the ninth month..." Ex. 2010.

An October 30, 2008 post on mamapedia.com that states "The 'Secret Fit' from Motherhood Maternity. They also have other jeans at the store, but this kind is the best. They kinda look funny because the stretchy top part covers your whole belly, but with your top on, you can't see it. I also bought some from Old Navy and Gap, but they always slid down or felt like they would." Ex. 2011.

A January 2008 blog that states "They go all the way up and are SO much more comfy than any of the ones that are considered full panel but sit across the middle of my belly. As long as you find the ones that are comfortable where the jeans meet the material, then I would bet you will LOVE them!" Ex. 2012; *see also* additional exemplary reviews at Exs. 2013-2016.

If an *Inter Partes* Review were instituted, Patent Owner may submit additional evidence of secondary considerations, and may move to file non-public evidence under seal, such as evidence of copying and financial success.

VI. IF THE CORRECTED PETITION IS GRANTED, THE VERTICAL AND HORIZONTAL REDUNDANCIES IN PRIOR ART AND INTER PARTES PETITIONS SHOULD BE ELIMINATED

Petitioner's Corrected Petition provides three alternative allegedly anticipatory references to claim 1 (Grounds 1, 5, and 9), two alternative allegedly anticipatory references for claims 19, 24, 25, 28, and 29 (Grounds 1 and 5), five allegedly anticipatory/obvious combinations for claims 18 and 26 (captured in Grounds 1-9), and two alternative obviousness combinations for claim 27 (Grounds 2 and 6), without providing any meaningful distinction between them. *E.g.*, Corrected Pet at ii. This tactic is contrary to regulatory and statutory mandate. *See* 37 C.F.R. 42.1(b) ("just, speedy, and inexpensive resolution of every proceeding"); 35 U.S.C. 316(b) ("the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter"); *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, slip op. CBM2012-00003, 6-17 (PTAB Oct. 25, 2012) (ordering the Petitioner to eliminate redundant grounds).

As such, Petitioner should be ordered to eliminate this horizontal and vertical redundancy.

Moreover, Petitioner filed three additional *Inter Partes* Petitions (IPR Review Nos. 2013-00531, 2013-00530, and 2013-00531), which are replete with

redundancy within themselves and with the instant Corrected Petition. Notably, and in contravention of the rules, these Petitions were not listed by Petitioner as related matters. *See* Frequently Asked Questions for Filing a Petition at D. 15, *available at* <http://www.uspto.gov/ip/boards/bpai/prps.jsp> ("[T]he petitioner should list other related review proceedings, as related matters, including those that are being filed concurrently or subsequently."). In all four petitions, Petitioner alleges that JCP-A, Stangle, and Browder anticipate claim 1 in both the '531 Patent and the '563 Patent, which is a child of the '531 Patent.

As such, if Petitioner's Corrected Petition is granted, it should be consolidated into either one proceeding addressing a subset of alleged prior art or at most two proceedings – one for the '531 Patent and one for the '563 Patent – limited to the same subset of alleged prior art.

VII. CONCLUSION

Based on the foregoing, Petitioner's Corrected Petition should be dismissed.

Dated: December 4, 2013

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on December 4, 2013, a complete and entire copy of Patent Owner Destination Maternity Corporation's Preliminary 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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