

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ARTSANA USA, INC.,  
Petitioner,

v.

KOLCRAFT ENTERPRISES, INC.,  
Patent Owner.

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Case IPR2014-01053  
Patent 8,388,501 B2

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Before JAMES T. MOORE, HYUN J. JUNG, and  
BARRY L. GROSSMAN, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING  
*37 C.F.R. § 42.71*

I. INTRODUCTION

Artsana USA, Inc. (“Petitioner”) filed a Corrected Petition (Paper 5, “Pet.”) seeking to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 8,388,501 B2 (“the ’501 patent”) pursuant to 35 U.S.C. §§ 311–319. Kolcraft Enterprises, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 11, “Prelim. Resp.”). The Board instituted review

(Paper 14, “Dec.”). Petitioner seeks rehearing of that decision. (Paper 16 “Req. Reh’g”).

We have considered the Request for Rehearing and grant it in part.

## II. STANDARD OF REVIEW

In a request for rehearing, the dissatisfied party must identify, specifically, all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously. 37 C.F.R. § 42.71(d). Upon a request for rehearing, the decision on a petition will be reviewed for an abuse of discretion. 37 C.F.R. § 42.71(c).

## III. ANALYSIS

### A. *Basis for Request and Requested Relief*

Petitioner contends that our Decision is based upon the erroneous determination that a document disclosing the Tyco Sesame Street Cozy Quilt Gym (“Tyco”), which document is a declaration filed in litigation in New Jersey in 1995, and was attached as Exhibit 1009 to Petitioner’s Petition, is not a printed publication. Req. Reh’g 1. Petitioner then seeks institution of *inter partes* review on grounds 4-7 of the Petition as relief. *Id.*

### B. *Printed Publications*

A printed publication in the United States is prior art if it was described in a printed publication prior to the applicant’s date of invention. 35 U.S.C § 102(a) (2000). Whether a document is a “printed publication” is “a legal determination based on underlying fact issues.” *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986). To qualify as a printed publication, a document must be generally available. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990). There must be sufficient evidence to find that anyone could have had access to the documents by the exercise of

reasonable diligence. *Id.* “Anyone” is “the pertinent part of the public,” and “diligence” is “the diligence of persons interested in and of ordinary skill in the subject matter or art.” *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981).

*C. The Asserted Error*

Petitioner focuses its argument principally on the accessibility of the records of a court. Req. Reh’g 5–7. “[A]ccessibility always was and is the key inquiry.” *Id.* at 6 (emphasis in original). “[T]he key inquiry is whether the reference was publicly accessible.” *Id.* at 7 (emphasis in original). Petitioner cites two United States District court cases in support of that argument. Req. Reh’g 6.

In *Brian Jackson Associates, Inc. v. San Manuel Copper Corp.*, 259 F. Supp. 793 (D. Ariz 1966) Petitioner asserts that the court determined that licensee instructions found in the records of the United States Court of Appeals for the Third Circuit qualified as publications within the meaning of 35 U.S.C. § 102. *Id.*

The pertinent part of the court’s decision is reproduced below:

There has been some contention as to whether the Instructions to the Pierce-Smith Licensees are a publication within the meaning of 35 U.S.C. § 102. They are a part of the records of the United States Courts of Appeals for the Third Circuit. Those of the public who have an interest in them may easily obtain a copy. I find that this satisfies the requirement of a “publication.”

259 F. Supp at 804.

In *Wichester Carton Corp. v. Standard Box Co.*, 294 F. Supp. 1207 (D. Mass 1969), Petitioner asserts that the court determined that a published judicial opinion of the Supreme Judicial Court of Massachusetts constituted

a prior art publication that rendered two claims of the patent at issue invalid.  
Req. Reh'g 6.

The pertinent part of the court's decision is reproduced below:

The court concludes that the two plates in the 1962 opinion constitute a prior publication of claims 1 and 2 of the Wischusen patent so that the patent is invalid with respect to these claims.

294 F. Supp. 1213.

Petitioner then asserts "District Court records and documents satisfy this 'key inquiry' and qualify as printed publications." Req. Reh'g 7.

It is important to note that in one instance the actual opinion itself constituted the prior art (e.g., the Massachusetts decision containing actual photographs). We are not provided with the nature of the Instructions to the Pierce-Smith Licensees other than they are a part of the court records and a copy "may easily be obtained." What that court's determination was based upon is unknown to us.

Petitioner's position is that "[a]fter reading the published opinion that contained a detailed description of Tyco (Petition Ex.1009), it would be a reasonable exercise of due diligence to locate the publicly available case file." Req. Reh'g. 11.

Petitioner also asserts, without evidentiary citation, that the court decision "was not the only means to locate the Conley Declaration and accompanying exhibits." Req. Reh'g. 9.

Petitioner's arguments tend to conflate the District Court decision, the case file, and the underlying individual documents in the litigation. While the District Court decision itself may be a publication, searchable to those interested, and an entire case file generally findable and accessible, we are far less certain about the level of diligence required to find this specific

declaration and exhibits without prior knowledge thereof, and whether that level is reasonable.

As evidence, Mr. Morgan testifies that he discovered the case while “seeing the report case at .” Ex. 2012 ¶ 3. Despite this infirmity in his declaration, we believe it is probable that he did find the case.

Mr. Morgan further testified that he reviewed the case file, which we agree as a whole is locatable exercising reasonable diligence, and made scanned copies of certain docket numbers. Ex. 1012 ¶¶ 5 and 6.

However, the evidentiary record becomes sparse at this point in the search for the specific documents forming Exhibit 1009. We are not provided with the process Mr. Morgan used to determine the relevance of those docket numbers. Did Mr. Morgan already know about the declaration and was he looking for it based on prior knowledge, having used some other means to locate it, as suggested could be done in the Request for Rehearing at page 9?

We are not provided with copies of the court indexing documents he used to identify and arrive at the relevant documents. Does the court’s index identify the description of a play gym? Is the court’s index by declarant name or by number only? What led Mr. Morgan to select docket numbers 1, 7, 9, 13, 14, 15, 23, 26, 28, 29, 30, 31, 50, 52, and 75? Ex. 1012 ¶ 6.

The Request for Rehearing specifically urges that one interested in its subject matter could have readily used the district court decision as a “roadmap” to locate the Conley Declaration and accompanying exhibits. Req. Reh’g 9.

Our review of that published decision, *Tyco Industries, Inc. v. Tiny Love, Ltd.*, 914 F. Supp. 1068 (D.N.J. 1996) indicates that it references

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