United States Court of Appeals for the Federal Circuit

OWENS CORNING,
Appellant

v.

FAST FELT CORPORATION,
Appellee

2016-2613

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2015-00650.

Decided: October 11, 2017

CONSTANTINE L. TRELA, JR., Sidley Austin LLP, Chicago, IL, argued for appellant. Also represented by THOMAS D. REIN, STEVEN J. HOROWITZ, STEPHANIE P. KOH, BRYAN C. MULDER; PETER S. CHOI, ANNA MAYERGOYZ WEINBERG, Washington, DC.

SCOTT A. BRISTER, Andrews Kurth Kenyon LLP, Austin, TX, argued for appellee. Also represented by GREGORY LAWRENCE PORTER, Houston, TX; JAMES D. PETRUZZI, The Petruzzi Law Firm, Houston, TX.

Before NEWMAN, DYK, and TARANTO, *Circuit Judges*.

TARANTO, *Circuit Judge*.

Fast Felt Corporation owns U.S. Patent No. 8,137,757, which describes and claims methods for printing nail tabs or reinforcement strips on roofing or building cover material. Fast Felt sued Owens Corning for infringement, and Owens Corning then filed a petition with the Patent and Trademark Office (PTO) seeking an *inter partes* review of claims 1, 2, 4, 6, and 7 under 35 U.S.C. §§ 311–19. The Patent Trial and Appeal Board, acting as the delegate of the PTO's Director under 37 C.F.R. § 42.4(a), instituted a review of all of the challenged claims on grounds of obviousness. Institution of Inter Partes Review at 26, *Owens Corning v. Fast Felt Corp.*, No. IPR2015-00650 (P.T.A.B. Aug. 13, 2015), Paper No. 9 (*Institution Decision*). After conducting the review, the Board concluded that Owens Corning had failed to show obviousness of any of the challenged claims. Final Written Decision, *Owens Corning v. Fast Felt Corp.*, No. IPR2015-00650, 2016 WL 8999740, at *23 (P.T.A.B. Aug. 11, 2016) (*Final Decision*).

Owens Corning appeals from the Board's decision. It contends that, once the key claim term is given its broadest reasonable interpretation, the record conclusively establishes obviousness. We agree, and we reverse the Board's decision.

I

A

The '757 patent addresses applying polymer "nail tabs" on "roofing and building cover material." '757 patent, abstract; *id.*, col. 1, lines 29–34 ("The invention relates generally to roofing materials or other building materials normally employed as cover materials over a wood roof deck or stud wall and more specifically to such cover materials and methods for incorporating therein a

plurality of integrally formed nail tabs or a continuous reinforcing strip."). The specification explains that nail tabs have been used to reinforce specific locations on roofing or building cover material at which nails will be driven through the material to attach it to a wood roof deck or a building stud wall. *See id.*, col. 1, lines 29–34. Such reinforcement helps prevent the nails from tearing through the cover material. *See id.*, col. 2, lines 20–26. Commonly, the specification observes, separate washers or tabs are applied with every nail to provide reinforcement, but that practice is expensive, inefficient, and dangerous. *Id.*, col. 2, lines 44–63.

The '757 patent proposes an asserted improvement: use of an "automated" process to "permanently and reliably" affix or bond "tab material that quickly solidifies and adheres or bonds to the surface." *Id.*, col. 5, line 63–col. 6, line 2. The surface to which the tab material is affixed or bonded can be "either dry felt, saturated felt, a fiberglass, polyester or other inorganic substrate roofing material whether or not coated with asphalt or an asphalt mix, or roll roofing material or shingles." *Id.*, col. 5, lines 64–67. The automated process can be "gravure, rotogravure or gravure-like transfer printing (the 'gravure process') or offset printing." *Id.*, col. 3, lines 24–26.[1]

Claim 1 is one of two independent claims. It reads:

> A method of making a roofing or building cover material, which comprises treating an extended length of substrate, comprising the steps of:

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[1] Gravure printing transfers a print material from an engraved cylinder directly onto a substrate. Appellant's Br. 7. Offset-gravure printing uses a second roller to pick up the print material from the engraved cylinder and transfer the print material onto the substrate. *Id.* at 8.

> depositing tab material onto the surface of said roofing or building cover material at a plurality of nail tabs from a lamination roll, said tab material bonding to the surface of said roofing or building cover material by pressure between said roll and said surface.

Id., col. 13, lines 13–20. All of the challenged claims contain the claim term "roofing or building cover material." *Id.*, col. 13, line 13–col. 14, line 17. Claim 7, the second independent claim, is similar to claim 1 but does not require a lamination roll. *Id.*, col. 14, lines 11–17. On appeal, the parties treat independent claims 1 and 7 as substantively equivalent. Several dependent claims add narrowing limitations, but Fast Felt does not argue them separately here.

B

The Board instituted review on three grounds, all under 35 U.S.C. § 103 (2006). *Institution Decision* at 26.[2] Owens Corning does not press one of those grounds on appeal, so we discuss only two of the grounds. U.S. Patent No. 6,451,409 (Lassiter) is the key piece of prior art. It specifically teaches a process of using nozzles to deposit polymer nail tabs on roofing and building cover materials to solve some of the same industry problems as are identified in the '757 patent. Lassiter, abstract, col. 1, lines 10–15, col. 2, lines 3–18.

The first ground of asserted unpatentability, applicable to claims 1, 2, 4, 6, and 7, is obviousness over a combination of Lassiter and U.S. Patent No. 5,101,759 (Hefele).

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[2] The '757 patent, which issued from a 2010 application, is governed by the version of § 103 that was in effect before the provision's amendment by the Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3(n)(1), 125 Stat. 284, 293 (2011).

Institution Decision at 26. Hefele discloses an offset-gravure printing process using a pressure roller to form "grid-like coatings" on a variety of "web-like flexible planar" materials. Hefele, abstract. The other asserted ground of unpatentability that is presented to us, applicable to claims 1, 2, 4, 6, and 7, is obviousness over a combination of Lassiter and U.S. Patent No. 6,875,710 (Eaton). *Institution Decision* at 26. Eaton discloses a process of using a transfer roll to apply "discrete polymeric regions" to reinforce various substrates and a process for laminating two substrates together. Eaton, col. 2, lines 16–29, col. 3, lines 6–22.

In its Final Written Decision, the Board found that, contrary to Fast Felt's contentions, all of the elements of the independent claims are disclosed in Lassiter when combined with either Hefele or Eaton. *See Final Decision*, 2016 WL 8999740, at *12–13, *20–21. Fast Felt has not meaningfully argued to this court that those findings are unsupported by substantial evidence.[3] The Board further found that Owens Corning had failed to show that a skilled artisan would have combined Lassiter with Hefele or Eaton. *Id.* at *13–15, *21–22. On that basis, the Board rejected Owens Corning's challenges to claim 1. *Id.* Finding no material difference between claim 1 and either claim 7 or the dependent claims 2, 4, and 6, the Board also rejected the challenges to those claims for the same reasons. *Id.* at *16, *22.

Owens Corning appeals the Board's decision. We have jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

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[3] The two-sentence footnote in Fast Felt's brief reasserting its position, Appellee's Br. 5 n.2, does not suffice to preserve a challenge. *See SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006). In any event, it does not persuasively show error by the Board in this respect.

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