

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOLT'S CIGAR HOLDINGS, INC.,
Petitioner,

v.

BOVEDA INC.,
Patent Owner.

Case IPR2015-01844
Patent 5,936,178

Before BRIAN J. MCNAMARA, HYUN J. JUNG, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

INTRODUCTION

A. Background

Holt's Cigar Holdings, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 12, 13, 15, 19–21, 24–26, and 31–34 of U.S. Patent No. 5,936,178 (Ex. 1001, "the '178 patent"). Boveda, Inc. ("Patent Owner") filed a Preliminary Response.¹ Paper 5 ("Prelim. Resp.").

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless the Director determines . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

After considering the Petition and the Preliminary Response, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that any of the claims it challenges are unpatentable. Accordingly, we do not institute *inter partes* review.

¹ Patent Owner's Preliminary Response was accompanied by a motion seeking acceptance of the Preliminary Response because it was filed by electronic mail. Paper 6. The submission via electronic mail occurred because the Patent Review Processing System was unavailable on the date when the Preliminary Response was due. *Id.* at 1. Patent Owner's motion meets the requirements of 37 C.F.R. § 42.6(b)(2), which governs the acceptance of submissions made by means other than electronic filing. Accordingly, we grant the motion and accept Patent Owner's filing via electronic mail.

B. Related Matters

Neither party has identified any related matters involving the '178 patent. Pet. 1; Paper 4. We note that a related patent, U.S. Patent No. 6,921,026, is being challenged in IPR2015-01845.

C. The Asserted Grounds of Unpatentability

Petitioner contends that claims 12, 13, 15, 19–21, 24–26, and 31–34 of the '178 patent are unpatentable under 35 U.S.C. § 103 based on the following grounds (Pet. 8–56):²

| Statutory Ground | Basis³ | Challenged Claims⁴ |
|-------------------------|--|--------------------------------------|
| § 103 | St. Charles, Tolman, Spruill, and Harrison | 12, 13, 19, 20, 24–26 |
| § 103 | St. Charles and Harrison | 31, 32, 34 |

² Petitioner also provides a declaration from Fernando J. Muzzio, Ph.D. Ex. 1003 (“the Muzzio Declaration” or “Muzzio Decl.”).

³ St. Charles, U.K. Patent Application Publication No. GB 2 222 816 A, published Mar. 21, 1990 (Ex. 1005) (“St. Charles”); Harrison et al., European Patent Application Publication No. 0 212 913 A2, published Mar. 4, 1987 (Ex. 1006) (“Harrison”); Tolman et al., U.S. Patent No. 5,130,018, issued July 14, 1992 (Ex. 1007) (“Tolman”); Spruill et al., U.S. Patent No. 5,035,731, issued July 30, 1991 (Ex. 1008) (“Spruill”); Klett, U.S. Patent No. 5,773,105, issued June 30, 1998 (Ex. 1009) (“Klett”); Dobson, Jr. et al., U.S. Patent No. 4,822,500, issued Apr. 18, 1989 (Ex. 1010) (“Dobson”).

⁴ The list of challenged claims in the Petition, Pet. 2–3, omits certain claims for which detailed arguments are presented, Pet. 8–56, and includes some claims with no detailed arguments. In reciting the claims challenged on each ground, we rely on the detailed arguments Petitioner presents rather than on the list of claims.

| Statutory Ground | Basis ³ | Challenged Claims ⁴ |
|------------------|---|--------------------------------|
| § 103 | St. Charles, Tolman, Spruill, Harrison, and Klett | 15, 20, 21, 33 |
| § 103 | St. Charles, Tolman, Spruill, and Dobson | 12, 19, 24–26 |
| § 103 | St. Charles and Dobson | 31, 34 |

D. The '178 Patent

The '178 patent relates to humidity control devices that can maintain a desired humidity level. Specifically, the '178 patent describes a humidity control device that includes

a case with a plurality of openings, a polymeric pouch having walls sufficiently thin to permit migration of water through the film in the form of water vapor and yet thick enough to prevent the escape of liquid water, and a solution including an organic or an inorganic solute (e.g., salt or sugar), vegetable gum and water.

Ex. 1001, 5:43–49. The '178 patent describes the saturated solution as “contain[ing] excess solute (e.g., salt or sugar crystals) and [as] preferably made more viscous with a thickening agent.” *Id.* at 5:50–52. “The case may be of any suitable size and shape,” *id.* at 5:55, and the '178 patent describes using the humidity control device in various spaces, such as “a violin case,” *id.* at 5:56, “a piano,” *id.* at 5:65, “a bulk package of tobacco products or confections,” *id.* at 5:65–66, and a “case . . . for use in conjunction with a bass violin,” *id.* at 6:5–6.

E. Illustrative Claim

Of the challenged claims in the '178 patent, claims 12, 19, and 31 are independent. Claim 12 is illustrative and recites:

12. A humidity control device for maintaining a desired humidity,
said device including a protective case, a water vapor permeable pouch and a thickened saturated salt solution,
said case comprising wall means defining an enclosure, said wall means including a plurality of openings through which water vapor may freely move,
said pouch being formed of a thin wall polymer film through which water vapor may pass,
said thickened saturated salt solution comprising water, salt and a thickening agent, said thickening agent being present in an amount sufficient to thicken the salt solution,
said salt solution being contained within the polymeric pouch and sealed from escape from the pouch,
said pouch containing the thickened salt solution, said pouch being contained within the protective case to protect the pouch from rupture.

Ex. 1001, 9:43–57 (paragraphing added for clarity).

ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuzzo Speed Techs., LLC*, 793 F.3d 1268, 1275–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuzzo Speed Techs. LLC v. Lee*, 136 S. Ct. 890

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