

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IDEAVILLAGE PRODUCTS CORP.,

Petitioner,

v.

KONINKLIJKE PHILIPS N.V.,

Patent Owner.

IPR2022-00904

Patent D870,972 S

Before JEFFREY N. FREDMAN, KEN B. BARRETT, and
GRACE KARAFFA OBERMANN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

IdeaVillage Products Corp. (“Petitioner”)¹ filed a Petition requesting *inter partes* review of U.S. Design Patent No. D870,972 S (“the D’972 patent”) (Ex. 1001). Paper 2 (“Pet.”). Petitioner challenges the patentability of the sole claim of the D’972 patent. Pet. 7–8 (grounds chart). Koninklijke Philips N.V (“Patent Owner”)² filed a Preliminary Response (Paper 7, “Prelim. Resp.”). We have authority to institute an *inter partes* review only where “there is a reasonable likelihood that the petitioner would prevail with respect to at least [one] of the claims challenged in the petition.” 35 U.S.C. § 314 (2018). For reasons set forth below, we deny institution.

B. *Related Proceedings*

Both parties identify *Koninklijke Philips N.V. v. IdeaVillage Products, Corp.*, Case No. 2:21-cv-08706 (D.N.J. April 2021) as a related proceeding. Pet. 4; Paper 6, 3. In addition, Patent Owner further identifies PGR2021-00116 (“PGR116”) as a related proceeding. Paper 6, 3.

C. *The D’972 Patent and the Claim*

We apply the claim construction standard used in district courts, namely, the standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.200(b) (2020). It is well-settled that a design patent claim is represented better by an illustration than a verbal description. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)). Although a design patent claim preferably is not construed by

¹ Petitioner identifies itself as the sole real party-in-interest. Pet. 3.

² Patent Owner identifies itself as the sole real party-in-interest. Paper 6, 2.

providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *Id.* at 679–80; *cf. High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1314–15 (Fed. Cir. 2013) (remanding to the district court, in part, for a “verbal description of the claimed design to evoke a visual image consonant with that design”).

The D’972 patent, titled “Blade For Hair Cutting Appliance,” issued December 24, 2019, from U.S. Application No. 29/696,507, filed June 28, 2019. Ex. 1001, codes (21), (22), (54). The claim is directed to “[t]he ornamental design for a blade for [a] hair cutting appliance, as shown and described.” *Id.*, code (57). The drawings depict the claimed blade mounted on a shaver head, with certain unclaimed aspects of the blade set and shaver head illustrated by broken lines. *See id.* (“The broken lines of even length illustrate portions of the blade for [a] hair cutting appliance that form no part of the claimed design. The broken lines of uneven length illustrate the boundary of the claimed design and form no part thereof.”). The D’972 patent contains eight figures, which we reproduce below.

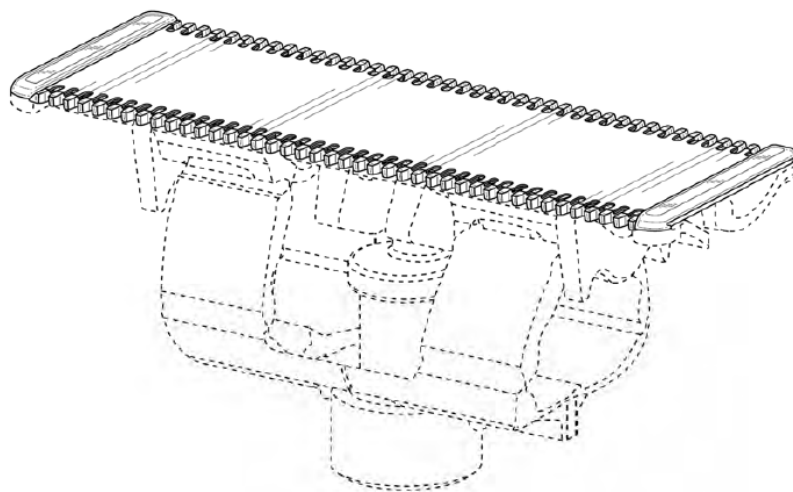


FIG. 1

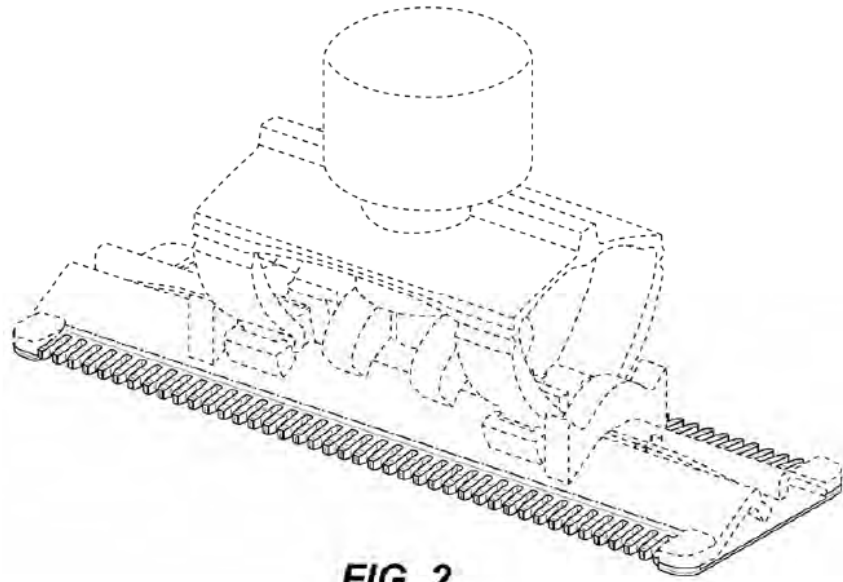


FIG. 2

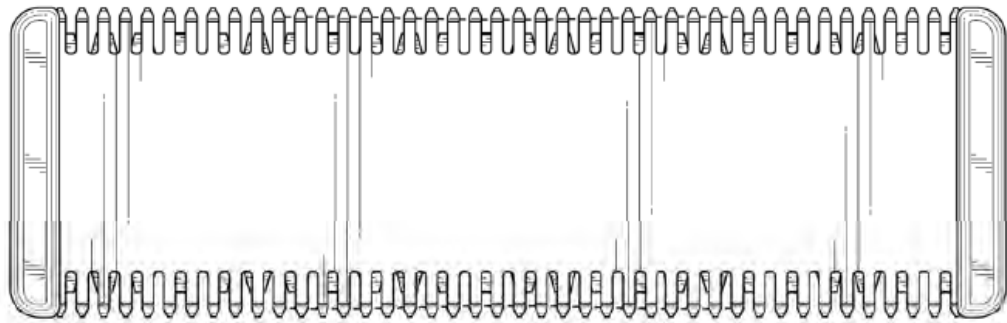


FIG. 3

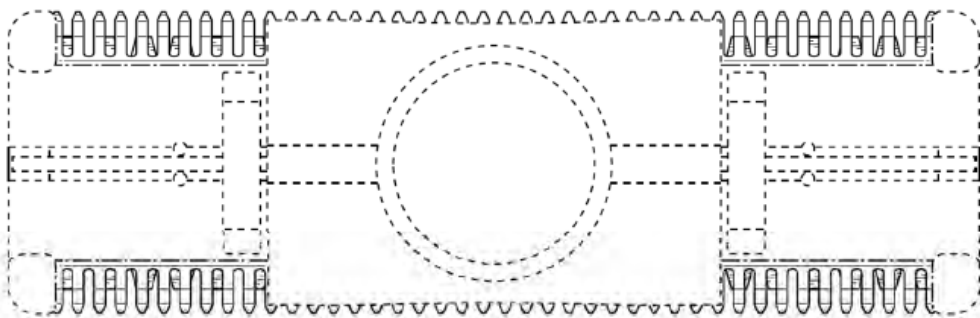


FIG. 4

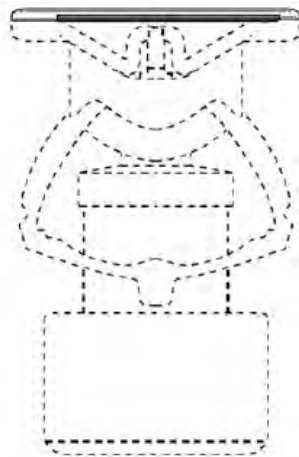


FIG. 5

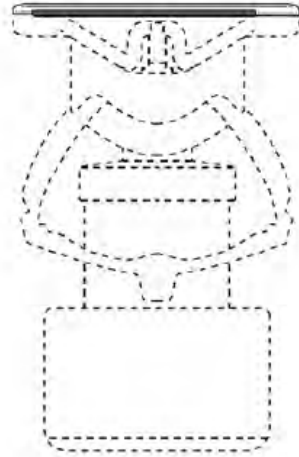


FIG. 6

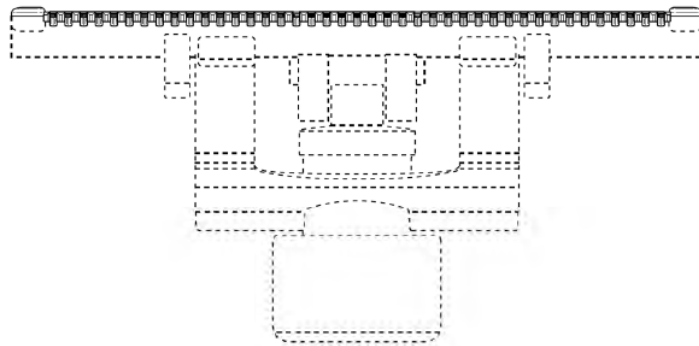


FIG. 7

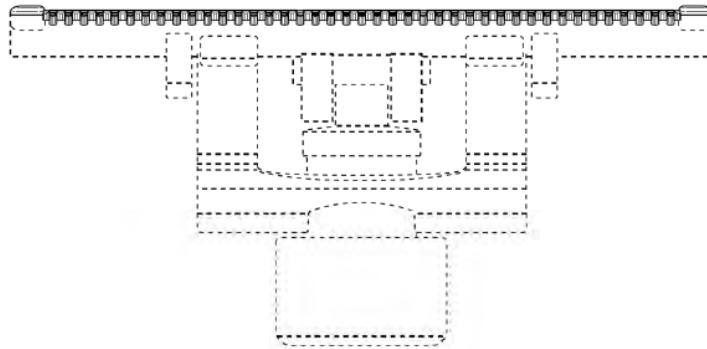


FIG. 8

Ex. 1001. Figures 1–8 depict, respectively, the following views of the claimed design: (1) a top, front, right perspective view; (2) a bottom, rear, left perspective view; (3) a top plan view; (4) a bottom plan view; (5) a right side elevation view; (6) a left side elevation view; (7) a rear elevation view; and (8) a front elevation view. *Id.*, code (57).

Petitioner, addressing claim construction, turns to the written description provided in U.S. Application No. 15/301,428 (“the ’428 application”), a utility patent application that is the parent of the D’972 patent. Pet. 24–26 (citing Ex. 1011); *see* Ex. 1001, code (62). Petitioner argues that the ’428 application “point[s] out the various features comprising the overall appearance of the design claimed in the D’972 patent.” Pet. 24. Elsewhere, somewhat incongruously, Petitioner argues that the figures in that same application “do not disclose the design claimed in the D’972 [p]atent.” *Id.* at 31.

In any event, by reference to an embodiment in the ’428 application, Petitioner characterizes the claimed design of the ’972 patent as follows.

The D’972 patent has disclaimed nearly the entire shaving head structure of the blade for a hair cutting appliance, reducing the claimed subject matter to rows of teeth, the gaps formed by the teeth, a front central component (thin metal component 40 – cover plate), a portion of the rear central surface (portion of plastic component 38), glimpses of the cutting blade visible in the gaps (movable cutter blade 24) and portions of side guards which cover the lateral edges of the stationary blade 22 (lateral protecting elements 42). The overall appearance of the claimed subject matter is informed by the characteristics of these individual elements (side guards, teeth, gaps, and front central component) and the proportional relationship of the elements to each other.

Id. at 26–27; *see id.* at 25–26 (Petitioner’s annotated versions of Figures 2, 3, 12, and 14 from the ’428 application).

For purposes of this decision, however, we determine that no verbal description of the claimed design is necessary to resolve whether to institute review. *Cf. Egyptian Goddess*, 543 F.3d at 679–680 (“[I]n deciding whether to attempt a verbal description of the claimed design, the court should recognize the risks entailed in such a description, such as the risk of placing

undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole.”).

E. Asserted Prior Art

The Petition advances challenges based on the following references:

Reference	Exhibit No.
Philip’s Press Release, “Philips Norelco OneBlade hybrid electric trimmer and shaver,” https://web.archive.org/web/201701260830949/https://www.amazon.com/Philips-Norelco-OneBlade-QP2520-90/dp/B01D328BG6/ , Feb. 25, 2022 (“Philips OneBlade”)	1005
US D776,878 S; filed Aug. 3, 2015; issued Jan. 17, 2017 (“Andersson US”)	1007
EU RCD 002627372-0002; registered Feb. 5, 2015 (“Philips RCD”)	1008
WO 2016/134979 A1; filed Feb. 11, 2016; published Sept. 1, 2016 (“Stapelbroek PCT”)	1009
EP 2 857 158 B1; filed Oct. 1, 2013; published Apr. 8, 2015 (“Stapelbroek EP”)	1010
US 2017/0113361 A1; filed Oct. 3, 2016; published Apr. 27, 2017 (“Feijen US”)	1011
WO 2015/158923 A1; filed Apr. 20, 2015; published Oct. 22, 2015 (“Feijen PCT”)	1012

Pet. 6–7.

The Petition is supported by the declaration of Mr. Mark Peyser (Ex. 1003). In addition, the Petition advances the affidavit of Mr. Nathaniel E. Frank-White (Ex. 1005) and the declaration of Dr. Sylvia Hall-Ellis (Ex. 1006) in support of arguments about the publication date of Philips OneBlade.

D. Asserted Grounds of Unpatentability

Petitioner identifies seven grounds of unpatentability.³ Pet. 7–8.

Ground	35 U.S.C. §	Reference(s)/Basis
1	102(a)(1)	Philips OneBlade
2	103	Andersson US, alone or in combination with Philips OneBlade, Philips RCD, Stapelbroek PCT, Stapelbroek EP, Feijen US, or Feijen PCT
3	103	Philips RCD, alone or in combination with Philips OneBlade, Andersson US, Stapelbroek PCT, Stapelbroek EP, Feijen US, or Feijen PCT
4	103	Stapelbroek PCT, alone or in combination with Philips OneBlade, Andersson US, Philips RCD, Stapelbroek EP, or Feijen US or Feijen PCT
5	103	Stapelbroek EP, alone or in combination with Philips OneBlade, Andersson US, Philips RCD, Stapelbroek PCT, Feijen US, or Feijen PCT
6	103	Feijen US, alone or in combination with Philips OneBlade, Andersson US, Philips RCD, Stapelbroek PCT, Stapelbroek EP, or Feijen PCT
7	103	Feijen PCT, alone or in combination with Philips OneBlade, Andersson US, Philips RCD, Stapelbroek PCT, Stapelbroek EP, or Feijen US

³ Petitioner purports to assert six obviousness grounds, but our review of those grounds reveals that 42 discrete obviousness challenges are embedded within them. *See* Pet. 7–8 (grounds chart), 64–88 (obviousness challenges). As explained in our analysis below, Petitioner asserts six single-reference obviousness challenges, based on a primary reference alone, and 36 (thirty six) two-reference obviousness challenges, based on each primary reference in combination with each of six alternative secondary references. *See id.*

II. ANALYSIS

A. Principles of Law

1. Priority and the Effective Filing Date

“[A] patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008) (quoting *In re Chu*, 66 F.3d 292, 297 (Fed. Cir. 1995)); see *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013).

The test for sufficiency of the written description, which is the same for either a design or a utility patent, has been expressed as “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” . . . In the context of design patents, the drawings provide the written description of the invention.

In re Owens, 710 F.3d at 1366 (citations omitted). Petitioner argues that the D’972 patent has “an effective filing date of no earlier than June 28, 2019” and, further, that a “break in the claim of priority provides the underlying basis for” each of the seven grounds asserted in the Petition. Pet. 37.

Specifically, in Petitioner’s view, the D’972 patent is not entitled to claim priority through EP14165283 (“the ’283 application”), PCT/EP2015/058486 (“the ’486 application”), or the ’428 application. Pet. 37–57; see Ex. 1001, codes (30), (62) (domestic and foreign application priority data).

Regardless of the effective priority date, however, for reasons set forth below, we decline to institute review based on any ground asserted in the Petition. Accordingly, in this decision, we do not resolve the parties’ dispute about a purported break in the priority chain. *Compare* Prelim. Resp. 4–49, with Pet. 16, 37–57 (setting forth the parameters of the priority dispute).

2. Obviousness and the Designer of Ordinary Skill in the Art

When assessing a design patent challenge based on obviousness, the ultimate inquiry is “whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.”

Apple, Inc. v. Samsung Elec. Co., 678 F.3d 1314, 1329 (Fed. Cir. 2012)

(internal quotation and citations omitted); *see also High Point Design*, 730 F.3d at 1313. The analysis involves two steps: first, “one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design”; second, “once this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design.”

High Point Design, 730 F.3d at 1311 (internal quotation and citations omitted).

Petitioner proposes that a designer⁴ of ordinary skill in the art:

would possess [a] Bachelor’s degree in mechanical engineering or industrial design (or a related or equivalent field) and at least ten (10) years of research or work experience related to designing, developing, specifying, testing or analyzing multi-component consumer products (or supervising the same), with experience related to handheld consumer products such as shavers.

Pet. 14.

Patent Owner does not disagree or propose a different definition of the designer of ordinary skill in the art. *See generally* Prelim. Resp.

⁴ Petitioner refers to the “person of ordinary skill in the art (‘POSITA’).” Pet. 6; *see id.* at 14 (Petitioner’s arguments pertaining the level of skill). For purposes of this decision, we assume Petitioner means the designer of ordinary skill in the art. *See In re Nalbandian*, 661 F.2d 1214, 1216 (CCPA 1981) (“In design cases we will consider the fictitious person identified in § 103 as ‘one of ordinary skill in the art’ to be the designer of ordinary capability who designs articles of the type presented in the application.”).

Based on the limited record before us, we determine that Petitioner’s definition is consistent with the level of ordinary skill reflected in the prior art references of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (recognizing that the prior art itself may reflect an appropriate level of skill in the art). For purposes of this decision, therefore, we apply Petitioner’s definition of the designer of ordinary skill in the art.

3. Anticipation and the Ordinary Observer

When assessing a design patent challenge based on anticipation, we assess whether the claimed and prior art “designs are substantially the same,” which requires consideration of whether “their resemblance is deceptive to the extent that it would induce an ordinary observer, giving such attention as a purchaser usually gives, to purchase an article having one design supposing it to be the other.” *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308, 1312–13 (Fed. Cir. 2001) (citing *Gorham Mfg. Co. v. White*, 81 U.S. 511, 528 (1871)).

B. Grounds Based on Obviousness

The Petition advances Andersson US, Philips RCD, Stapelbroek PCT, Stapelbroek EP, Feijen US, and Feijen PCT in six obviousness challenges. Pet. 7–8 (grounds chart), 64–88 (arguments). In each asserted ground, however, Petitioner advances a primary reference alone or in combination with any one of six secondary references raised in the alternative. Pet. 7–8 (employing the “or” connector in relation to six secondary references in each of the six asserted obviousness grounds); *see infra* 8 n.3.

For example, the first obviousness ground is based on Andersson US “either alone or in combination with Philips OneBlade, Philips RCD, Stapelbroek PCT, Stapelbroek EP, Feijen US, or Feijen PCT.” *Id.* at 7. In

similar fashion, each of the other five obviousness grounds is based on a primary reference “either alone or in combination with” any one of six other references. *Id.* at 7–8. Thus, by our count, the Petition advances 42 distinct obviousness challenges—six based on a single reference and 36 based on combinations of primary and secondary references. *Id.*

An obviousness analysis involves two steps; first, “one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design”; second, “once this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design.” *High Point Design*, 730 F.3d at 1311 (internal quotation and citations omitted). Even when secondary references are not used, however, the analysis still requires an explanation as to how and why the primary reference (something having design characteristics basically the same as the claimed design) would have been modified to arrive at a design that has the same overall visual appearance as the claimed design. *See, e.g., In re Nalbandian*, 661 F.2d at 1217 (involving single-reference obviousness rejection and addressing the differences between the reference and the claimed design); *In re Lamb*, 286 F.2d 610, 611 (CCPA 1961) (affirming the Board in a case involving a single-reference obviousness rejection where “the board observed that it is conventional to use relatively slimmer handles with slim blades and that therefore, ‘it would be expected that a designer skilled in the cutlery art would use a somewhat narrower or slimmer handle with a slim blade’”).

None of the 42 obviousness challenges advanced in the Petition is supported by an adequate analysis of those two steps. *See id.* at 64–88. In particular, none sufficiently discusses **both** the differences between the

claimed and prior art designs *and* how any primary reference would have been modified (alone or in view of any other reference) to have the same visual appearance as the claimed design. *Id.*

The articulations of Petitioner’s obviousness challenges all follow a similar pattern. *See* Pet. 64–88 (citing Ex. 1003 ¶¶ 62–93). For each ground, Petitioner argues, “The below side-by-side visual comparison shows that [the subject reference] creates the same visual impression” and “is basically the same as the D’972 patent,” followed by a group of images that constitute the visual comparison. *Id.* at 65, 70, 74, 77–78, 81, 85. Thus, at this point in its analysis, Petitioner alleges only that it has presented an appropriate primary reference, one with design characteristics basically the same as the claimed design.

Petitioner highlights alleged similarities between each primary reference and the claimed design (*id.* at 65–66, 70–71, 74, 77–78, 81, 85), then acknowledges “minor differences in the shape of the teeth” or the shape of “the side guards” (*id.* at 68, 73, 76, 79, 83, 87). Without any analysis, however, and in connection with each ground, Petitioner submits that these differences “are *de minimus.*” *Id.* Similarly, Petitioner’s witness, Mr. Peyser, testifies only that these differences “can be considered *de minimus.*” Ex. 1003 ¶¶ 64, 69, 74, 79, 84, 90. Significantly, neither Petitioner nor Mr. Peyser explains *why* a designer of ordinary skill in the art would consider these differences to be “*de minimus.*” Pet. 68, 73, 76, 79, 83, 87; Ex. 1003 ¶¶ 64, 69, 74, 79, 84, 90. That deficiency permeates each of the six single-reference obviousness challenges raised in the Petition.

In each ground, moreover, Petitioner also lists six alternative secondary references, but fails to discuss the relevant design features of any of them. Pet. 69, 73, 76–77, 79–80, 84, 87–88. Further, Petitioner makes no attempt

to explain how any primary reference would have been modified in view of any particular secondary reference to arrive at a design that has the same overall visual appearance as the claimed design. *Id.* That deficiency permeates each of the 30 discrete obviousness challenges that are based on combinations of applied prior art references.

In a nutshell, the Petition lacks the requisite obviousness analysis and rests instead on conclusory assertions of obviousness. Mr. Peyser repeats conclusory assertions set forth in the Petition. *See* Ex. 1003 ¶¶ 62–93. On this record, Petitioner’s obviousness grounds are deficient for failure to include, for example, an adequate discussion of the differences between the challenged claim and each asserted primary prior art reference *along with* an explanation as to why it would have been obvious to modify the reference, alone or in combination with any asserted secondary reference, to arrive at a design that has the same overall visual appearance as that of the challenged claim. *See High Point Design*, 730 F.3d at 1311.

Accordingly, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing at trial in showing that the challenged claim is unpatentable as obvious over the asserted references. Pet. 64–88.

C. The Ground Based on Anticipation

Petitioner argues that the design claim of the D’972 patent is anticipated by Philips OneBlade. Pet. 57–64. This challenge presents a closer case than those based on obviousness.

On the one hand, Petitioner directs us to information tending to show that the design disclosed in Philips OneBlade is substantially similar to six of the eight perspective views of the claimed design as illustrated in Figures 1–6 of the D’972 patent. *Id.*; Ex. 1003 ¶¶ 58–60. On the other hand,

however, Petitioner acknowledges that Philips OneBlade “does not include a front and rear elevation view” as shown in Figures 7 and 8 of the D’972 patent. Pet. 62. Petitioner and its witness, Mr. Peyser, contend, with at most marginal objective support, that “the overall appearance of the shaver head is sufficiently disclosed” in that allegedly anticipatory reference. *Id.*; Ex. 1003 ¶ 60.

Specifically, on that crucial issue, Mr. Peyser testifies “that the multiple perspective views are informative enough to prov[id]e *me* an understanding of what the front and rear views of the shaver head would look like.” Ex. 1003 ¶ 60 (emphasis added). Mr. Peyser neither explains why the perspective views are sufficient to disclose the missing front and rear views of the Philips OneBlade shaver head, nor keys his testimony, with sufficient clarity, to the understanding of an ordinary observer. Ex. 1003 ¶ 60 (referring to “me,” not the ordinary observer). When Mr. Peyser does turn to the relevant inquiry, therefore, focusing on the ordinary observer, his opinions are not tethered adequately to supporting facts. Ex. 1003 ¶ 61. Stated somewhat differently, his ultimate opinion is conclusory. *See id.*; *see also In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (a petitioner’s burden of proving obviousness cannot be satisfied by employing “mere conclusory statements”).

In the alternative, we take note that Mr. Peyser’s opinions about whether the drawings in Philips OneBlade are sufficient to anticipate the claimed design are incongruous, at best, with his opinions aimed at breaking the priority chain. For example, when addressing the priority dispute, Mr. Peyser relies on a greatly magnified image of Figure 7 from the D’972 patent, directing the Board to minute details from Figure 7, in an attempt to explain why, in his view, the claimed invention cannot claim priority

through two secondary references asserted in the obviousness grounds. Pet. 55; Ex. 1003 ¶¶ 46–47 (Mr. Peyser’s testimony)⁵.

By contrast, when addressing anticipation, Mr. Peyser readily acknowledges that Philips OneBlade does *not* disclose the front view of the claimed design that is shown in Figure 7 of the D’972 patent. Ex. 1003 ¶ 60. Without adequate explanation, Mr. Peyser nevertheless opines that he (and, by extrapolation, an ordinary observer) would discern from the perspective drawings provided in Philips OneBlade the overall appearance of the claimed design—which we must assume includes the minute details shown in Figure 7, which are highlighted elsewhere in the Petition when discussing priority. Ex. 1003 ¶¶ 60–61 (opinions pertaining to anticipation); *see id.* ¶¶ 46–47 (incongruous opinions pertaining to priority). That incongruity casts a cloud over the value of his opinions.

In particular, it is not clear on this record, and neither Petitioner nor Mr. Peyser explains adequately, how or why an ordinary observer would have discerned that Philips OneBlade, like Figure 7, includes the “tangent line” or lacks the “solid line above [the] teeth” as illustrated in Figure 7 of the D’972 patent. Pet. 55; Ex. 1003 ¶¶ 60–61. Here again, we observe, Mr. Peyser does not attempt to reconcile his incongruous opinions as presented across the issues of anticipation and priority. *Compare* Ex. 1003 ¶¶ 60–61 (opinions on Figure 7 in connection anticipation), *with id.* ¶¶ 46–

⁵ Mr. Peyser labels the relevant figure as “Fig. 9 — D’972 detail mag.” Ex. 1003 ¶ 46. Given that (1) the challenged patent includes no Figure 9, (2) the figure reproduced by Mr. Peyser matches Figure 7 from the challenged patent; and (3) Petitioner directs us to this same paragraph from Mr. Peyser’s declaration for support of arguments surrounding Figure 7, we determine that Mr. Peyser’s reference to “Fig. 9” is a typographical error and, in fact, Mr. Peyser here intends to refer to Figure 7 of the D’972 patent.

47 (incongruous opinions on Figure 7 in connection with the priority dispute). On this record, Mr. Peyser’s opinions about anticipation are undercut by his incongruous opinions about priority. *Id.*

Accordingly, we determine that Petitioner’s showing with respect to the anticipation ground is marginal, at best. We next address whether trial institution is warranted under the totality of circumstances presented, where Petitioner advances 42 obviousness challenges that fall plainly short of meeting the threshold showing necessary to support institution of review, and one marginal anticipation ground that presents a closer case.

D. Discretionary Denial

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); *see also SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review.” (emphasis omitted)); *Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that, under Section 314(a), the Office “is permitted, by never compelled, to institute an [*inter partes* review] proceeding”).

Under Office guidance, if the Board “institutes a trial,” it must “institute on all challenges raised in the petition.” Guidance on the Impact of *SAS* on AIA Trial Proceedings⁶ (April 26, 2018); *see* 37 C.F.R. § 42.108(a) (“When instituting . . . review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). When a petition fails to satisfy the evidentiary threshold necessary to support some challenges, the Board evaluates “all the

⁶ Available at <https://www.uspto.gov/patents/ptab/trials/guidance-impact-sas-aia-trial>.

challenges and determine[s] whether, in the interests of efficient administration of the Office and integrity of the patent system, the entire petition should be denied.” Patent Trial and Appeal Board Consolidated Trial Practice Guide⁷ 64 (Nov. 2019) (citing 37 C.F.R. §§ 316(b), 326(b)).

Here, for reasons explained above, we determine that Petitioner advances 42 obviousness challenges that are insufficient to support institution of review. Under these circumstances, should we institute review based on the one marginal ground based on anticipation, Patent Owner would be placed in the untenable position of having to defend against 43 challenges, even though only one challenge even arguably meets the “reasonable likelihood” standard for trial institution.

Two additional circumstances favor a discretionary denial of review in this case. First, the instant Petition was filed about one month *after* the Board issued the decision denying review in PGR116. As a result, Petitioner was in a position to take unfair advantage of that prior decision to refine and improve arguments presented in the Petition.⁸

⁷ Available at <https://uspto.gov/sites/default/files/documents/tpgnov.pdf>.

⁸ In PGR116, Petitioner unsuccessfully requested post-grant review of U.S. Patent No. D905,346 S (the D’346 patent), which “is a child of the D’972 patent.” Paper 6, 3; *see* PGR116, Ex. 1001, code (60) (related application data). About four weeks *after* the Board denied review of the D’346 patent in PGR116, Petitioner filed the instant Petition against the D’972 patent based on essentially the same prior art. *Compare* PGR016, Paper 6 (entered March 24, 2022), *with* Pet. (filed April 20, 2002); *compare* PGR116, Paper 1, 7, *with* Pet. 6–7 (identification of essentially the same prior art across the two petitions). We take note that, although Petitioner presents somewhat different documents to establish the design features of the Philips OneBlade reference across the two proceedings, we discern no meaningful differences in their relevant substance. *Compare* Ex. 1001, 1004, *with* PGR116, Exs. 1005, 1113.

Second, Patent Owner presents relatively strong evidence and arguments opposing Petitioner’s information about the asserted break in the priority chain. *Compare* Prelim. Resp. 4–49, *with* Pet. 16, 37–57. Based on the information presented, we have serious concerns about Petitioner’s view that the D’972 patent is entitled to a priority date “no earlier than June 28, 2019,” which even Petitioner admits “provides the underlying basis for” each of the 43 challenges presented in the Petition. Pet. 37. Moreover, even at this preliminary stage, the parties both focus on the priority dispute. *Ibid.* The complexity of the issues raised in connection with the priority dispute tips the scales against institution of review in this case. Under these particular circumstances and unique facts, we are not persuaded that Patent Owner should have to take on the task of establishing priority in order to defend against 42 poorly-supported challenges and one marginally-supported challenge as advanced in the Petition.

Taking a holistic view of the totality of the circumstances, we find that institution of review based on the 43 discrete challenges raised in the Petition—where adequate information is presented, arguably, in connection with only a single challenge—would be an inefficient use of the Board’s time and resources. *Cf. Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9, 10–11 (PTAB Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-091310, Paper 7 (PTAB Jan. 24, 2019) (informative). Accordingly, we exercise our discretion and do not institute an *inter partes* review based on the marginal anticipation ground.

III. CONCLUSION

For the above reasons, based on the information presented, we deny the Petition and do not institute *inter partes* review of the challenged claim of the D'972 patent.

IV. ORDER

It is

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

IPR2022-00904
Patent D870,972 S

PETITIONER:

Christopher V. Carani
Scott P. McBride
Dunstan H. Barnes
Philipp Ruben
McANDREWS, HELD & MALLOY LTD.
ccarani@mcandrews-ip.com
smcbride@mcandrews-ip.com
dbarnes@mcandrews-ip.com
pruben@mcandrews-ip.com

PATENT OWNER:

Elizabeth D. Ferrill
Joshua L. Goldberg
Umber Aggarwal
FINNEGAN, HENDERSON, FARABOW, GARRETT
& DUNNER, LLP
elizabeth.ferrill@finnegan.com
joshua.goldberg@finnegan.com
umber.aggarwal@finnegan.com