

Keywords: 35 U.S.C. §103, obviousness, claim construction, inter partes review (IPR)

Take Away: Motivation to combine references will not be extinguished based only on preferred or selected embodiments. To successfully argue that prior art references teach away from combination, there needs to be a showing that a person of ordinary skill in the art would not have been motivated to combine the prior art to reach any of the embodiments within the scope of the challenged claims.

Owens Corning v. Fast Felt Corp.

United States Court of Appeals for the Federal Circuit

No. 2016-2613

Decided: October 11, 2017

I. Facts

Fast Felt Corporation (“Fast Felt”) owns U.S. Patent No. 8,137,757 (“the ‘757 patent”), which describes and claims methods for printing nail tabs or reinforcement strips on roofing or building cover material. The 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,” whether or not the tab material is later coated with shingles or other roofing materials. The process can be a gravure or a gravure-like process in which print material from an engraved cylinder is transferred directly onto a substrate. Representative Claim 1 of the ‘757 patent, one of the two independent claims, recites:

1. A method of making a roofing or building cover material, which comprises treating an extended length of substrate, comprising the steps of: 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. (Emphasis added.)

Fast felt sued Owens Corning for infringement and in turn, Owens Corning filed a petition for an *inter partes* review (IPR) challenging claims 1, 2, 4, 6, and 7 on grounds of obviousness. All of the challenged claims contain the claim term “roofing or building cover material.”

In challenging the claims, Owen Corning primarily relied on U.S. Patent No. 6,451,409 (“Lassiter”), which teaches a process of using nozzles to deposit polymer nail tabs on roofing and building cover materials to solve the same industry problems as that of the ‘757 patent. The secondary references, U.S. Patent No. 5,101,759 (“Hefele”) and U.S. Patent No. 6,875,710 (“Eaton”), teach an offset-gravure printing to form coatings on flexible materials, and using a transfer roll to apply substances to reinforce substrates. Essentially, the two secondary references teach roll-based printing polymer tabs on a wide range of substrates and materials. Although Hefele and Eaton do not specifically recite roofing materials, Owens Corning asserted that it would have been obvious to substitute the nozzle-based process of Lassiter with the roll-based printing process of Hefele or Eaton, as substituting one well-known process for another would be obvious to a person of ordinary skill in the art.

Patent Trial and Appeal Board's Final Written Decision

In the final written decision by the Patent Trial and Appeal Board, the Board found that all of the elements of the independent claims were disclosed in Lassiter when combined with either Hefele or Eaton. However, the Board found that Owens Corning failed to show that a person of ordinary skill in the art would have combined Lassiter with Hefele or Eaton. Specifically, the Board found that Lassiter teaches away from Hefele and Eaton because Lassiter appears to teach away from using pressure or heat to add the reinforcement because it destabilizes asphalt roofing materials, while the processes of Hefele and Eaton are directed to other materials that are not covered with asphalt mix. In reaching this decision, the board construing the term “roofing or building cover material” to mean a material that is coated or eventually would be coated with asphalt mix. On that basis, the Board found that claims 1, 2, 4, 6, and 7 were not shown to be obvious. Owens Corning appealed.

II. Issues

- 1) Did the Board correctly construe “roofing or building cover material” as limited to material that either has been or would be coated or saturated with asphalt or asphalt mix, under the broadest-reasonable-interpretation standard?
- 2) When a correct claim construction is applied, are the claims obviousness in light of the prior art?

III. Holding and Reasoning

1. Yes, the Federal Circuit found that the Board incorrectly construed the claim language that a “roofing or building cover material” was limited to a material that either has been, or would be, coated or saturated with asphalt or an asphalt mix. While the Board applies a broadest reasonable interpretation standard for claim construction, the court found that the Board’s exclusion of materials that would not be coated in asphalt to be inconsistent with a broadest reasonable interpretation of the claims. Although the preferred embodiments focused on asphalt covered materials, this focus in the specification was not sufficient to limit the claim scope. The court noted that the claims themselves are not limited to roofing materials, as each claim recited building material as well, and further noted that the specification also encompassed building cover material which would not be covered with asphalt. Therefore, the court concluded that the broadest reasonable interpretation of “roofing or building cover material” would include materials that “neither have been nor coated or saturated with asphalt or asphalt mix” and, thus, the Board’s construction was found to be in error.

2. Yes, the Federal Circuit held that a person of ordinary skill in the art would have been motivated to combine the prior art references to print nail tabs on building cover materials that are not already or will not be asphalt coated or saturated, consistent with the broadest reasonable interpretation of the claims. The court upheld the Board decision that the prior art combinations at issue disclosed all of the elements of the claims. Thus, the only question was whether a person of ordinary skill in the art would have been motivated to make the combinations with a reasonable expectation of success. This inquiry is to be conducted in light of the Supreme Court’s observation

that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). In applying this test, the court found that Lassiter’s nozzle-based printing technique and Hefele’s and Eaton’s gravure based printing processes were known substitutes, with success predictable as to materials covered by the claims. Thus, the court reversed the decision of the Board and held that claims 1, 2, 4, 6, and 7 are unpatentable.

IV. Conclusion

Relying on a teaching away argument may only be supported if the claims at issue are narrowly focused to the portion of the reference teaching away from a proposed combination.