

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIANJIN SHUANGRONG PAPER PRODUCTS CO., LTD. AND
SHUANG RONG AMERICA, LLC,
Petitioner,

v.

KISS NAIL PRODUCTS, INC.,
Patent Owner.

Case IPR2016-00371
Patent 8,561,619 B1

Before JOSIAH C. COCKS, MICHAEL W. KIM, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Petitioner, Tianjin Shuangrong Paper Products Co., Ltd. and Shuang Rong America, LLC (collectively, “Tianjin”), filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–5 of U.S. Patent No. 8,561,619 B2 (“the ’619 patent”). Patent Owner, Kiss Nail Products, Inc. (“Kiss Nail”), timely filed a Preliminary Response (Paper 10, “Prelim. Resp.”) to the Petition. We have jurisdiction under 35 U.S.C. § 314.

To institute an *inter partes* review, we must determine that the information presented in the Petition shows “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons set forth below upon considering the Petition and the Preliminary Response, we conclude that the information presented in the Petition establishes a reasonable likelihood that Tianjin will prevail in challenging claims 1–5 of the ’619 patent. Pursuant to 35 U.S.C. § 314, we hereby authorize an *inter partes* review to be instituted as to those claims.

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far. This decision to institute trial is not a final decision as to patentability of claims for which *inter partes* review is instituted. Our final decision will be based on the full record developed during trial.

A. Related Matters

According to the Petition, the ’619 patent has been asserted against Petitioner by Patent Owner in *Kiss Nail Products, Inc. v. Tianjin Shuangrong Paper Products Co., Ltd. et al.*, no. 1:15-cv-06019 (KPF), U. S.

District Court for the Southern District of New York. Pet. 2; *see also* Paper 6, 1 (providing Patent Owner’s mandatory notices and identifying this pending litigation).

B. The '619 Patent

The '619 patent, titled “Artificial Nail or Tip Arrangement and Method of Making Same,” issued October 22, 2013. Ex. 1001. The claims of the '619 patent are directed to artificial nails with a removable protective layer over an adhesive, with the removable layer including slits. *Id.* at 7:12–8:25. The slits purportedly allow the surface of the protective layer to remain smooth after the layer adheres to the adhesive. *Id.* at 2:16–19.

Figures 1 and 2, reproduced below, depict an embodiment of the artificial nail.

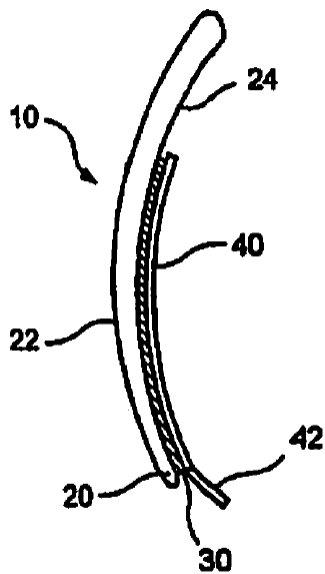


FIG. 1

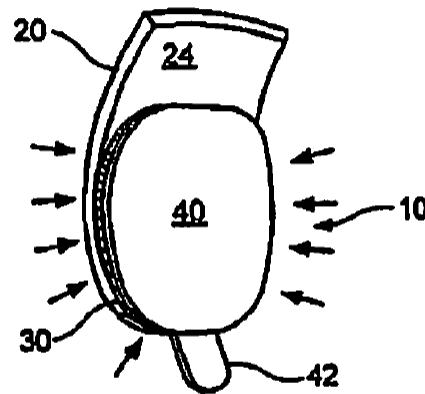


FIG. 2

Figure 1 depicts a side view of an embodiment of the artificial nail arrangement and Figure 2 depicts a perspective view of the bottom of the artificial nail of the embodiment shown in Figure 1. Ex. 1001, 2:46–49. Artificial nail 10 includes polymeric body 20 shaped like a natural fingernail and having upper surface 22 and lower surface 24, with lower surface 24 structured to face the top surface of a user's natural nail. *Id.* at 3:21–23, 3:48–54. Adhesive layer 30 is secured to a portion of lower surface 24 and is configured to adhere to the upper surface of the user's fingernail. *Id.* at 3:54–59.

Removable layer 40 covers adhesive layer 30. Ex. 1001, 3:63–64. When the artificial nail is used, tab 42 is used to remove removable layer 40 and expose adhesive layer 30, which is applied to the user's natural nail. *Id.* at 3:63–4:3.

Figure 10E of the '619 patent, reproduced below, depicts an embodiment of removable layer 40 with slits.

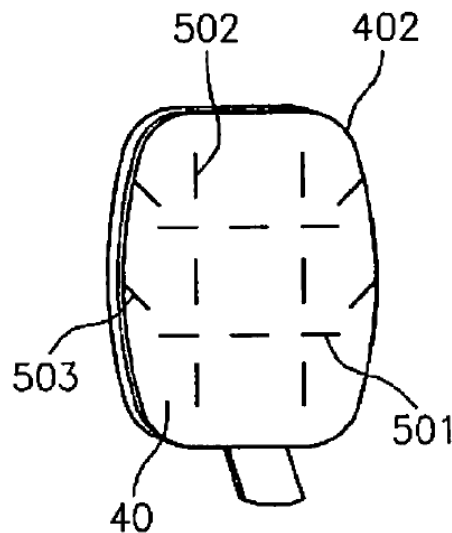


FIG. 10E

Figure 10E depicts a perspective view of removable layer 40 with slits 501, 502, 503. Ex. 1001, 6:6–11. Slit 501 is oriented horizontally, slit 502 is oriented vertically, and slit 503 is oriented radially, with slit 503 extending from edge 402 of removable layer 40. *Id.* The slits are preferably die cut, where the die is shaped to cut the number and orientation of slits desired in removable layer 40. *Id.* at 6:12–19. As seen in Figure 10E, slits may be non-continuous, forming co-linear slits separated by uncut portions. *Id.* at 6:6–11; *see also* Pet. 8 (providing an annotated version of Figure 10E identifying the non-continuous, co-linear slits). “[R]emovable layer 40 will no longer crease or wrinkle due to the space and flexibility provided by slits 401.” Ex. 1001, 6:3–5; *see also id.* at 1:54–58 (discussing a problem with the prior art, where the removable layer creases or wrinkles when contacting the adhesive layer during manufacture).

C. Illustrative Claims

Claim 1 of the '619 patent, the sole independent claim, is representative of the claimed subject matter and is reproduced below.

1. An artificial nail or tip arrangement comprising:
 - a body having a concave lower surface with a shape corresponding to a shape of at least one portion of a natural nail;
 - an adhesive layer having a first surface and an opposing second surface, wherein the first surface adheres to at least one portion of the concave lower surface of the body and the second surface is provided to adhere to the at least one portion of the natural nail when applied thereto; and
 - a removable layer that covers at least one portion of the second surface of the adhesive layer, and which is removable to expose the at least one portion of the second surface of the adhesive layer for application to the at least one portion of the natural nail, the removable layer comprising a plurality of slits

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