

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MINIATURE PRECISION COMPONENTS, INC.,
Petitioner,

v.

EAGLE INDUSTRIES, INC.,
Patent Owner.

Case IPR2017-01403
Patent 8,205,592 B2

Before MICHAEL W. KIM, JAMES A. WORTH, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Miniature Precision Components, Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–19 of U.S. Patent No. 8,205,592 B2 (Ex. 1002, “the ’592 patent”). Paper 1 (“Pet.”), 1. Eagle Industries, Inc. (“Patent Owner”) did not file a Preliminary Response. Upon consideration of the Petition, we instituted an *inter partes* review pursuant to 35 U.S.C. § 314, as to claims 1–19. Paper 8 (“Inst. Dec.”). More specifically, we instituted review to decide whether claims 1–12 are unpatentable as anticipated by Polytec¹; and (2) whether claims 1–19 are unpatentable as obvious over Polytec and Burr.²

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 11, “PO Resp.”). On May 4, 2018, pursuant to the Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), we issued an Order instituting on all grounds mentioned in the Petition, including whether claims 1–19 are unpatentable as obvious based on Polytec alone. Paper 15. We granted Patent Owner’s request to file a Supplemental Response to address this additional ground (Paper 16), and Patent Owner filed a Supplemental Response on June 1, 2018 (Paper 19, “PO Supp. Resp.”). Petitioner filed a Reply (Paper 21, “Reply”). On September 7, 2018, we held an oral hearing. Paper 28 (“Tr.”).

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has demonstrated,

¹ WO 2008/055806 A1 (published May 15, 2008) (Ex. 1006). We will cite to an English translation of Polytec provided by Petitioner. *See* Ex. 1007.

² U.S. Patent No. 3,487,134 (issued Feb. 8, 1965) (Ex. 1008).

by a preponderance of the evidence, that claims 1–19 of the '592 patent are unpatentable.

A. Related Matters

Petitioner and Patent Owner state that there are no pending related matters. Pet. v; Paper 5, 1.

B. The '592 Patent

The '592 patent discloses a noise abatement “engine cover and method of making the same with a textured surface.” Ex. 1002, Abstract. The noise abatement cover includes a “textured, in-mold coated, high quality outer appearance with a core of medium density polyurethane.” *Id.* According to the Background section of the '592 patent, plastic injection molded covers already in use as engine covers provide improved aesthetics, but inferior sound absorption. *Id.* at 1:18–19. In addition, foam products may provide improved sound absorption, but not a quality surface appearance. *Id.* at 1:26–27. The '592 patent also states that designs prior to the '592 patent “contain multiple parts or components for equivalent appearance and noise abatement performance.” *Id.* at 2:3–4. The disclosed invention purportedly provides both improved appearance and noise abatement, and employs a “preferred single piece construction.” *Id.* at 2:8–13.

Figure 1 of the '592 patent is a top view of a noise abatement engine cover, and is reproduced below:

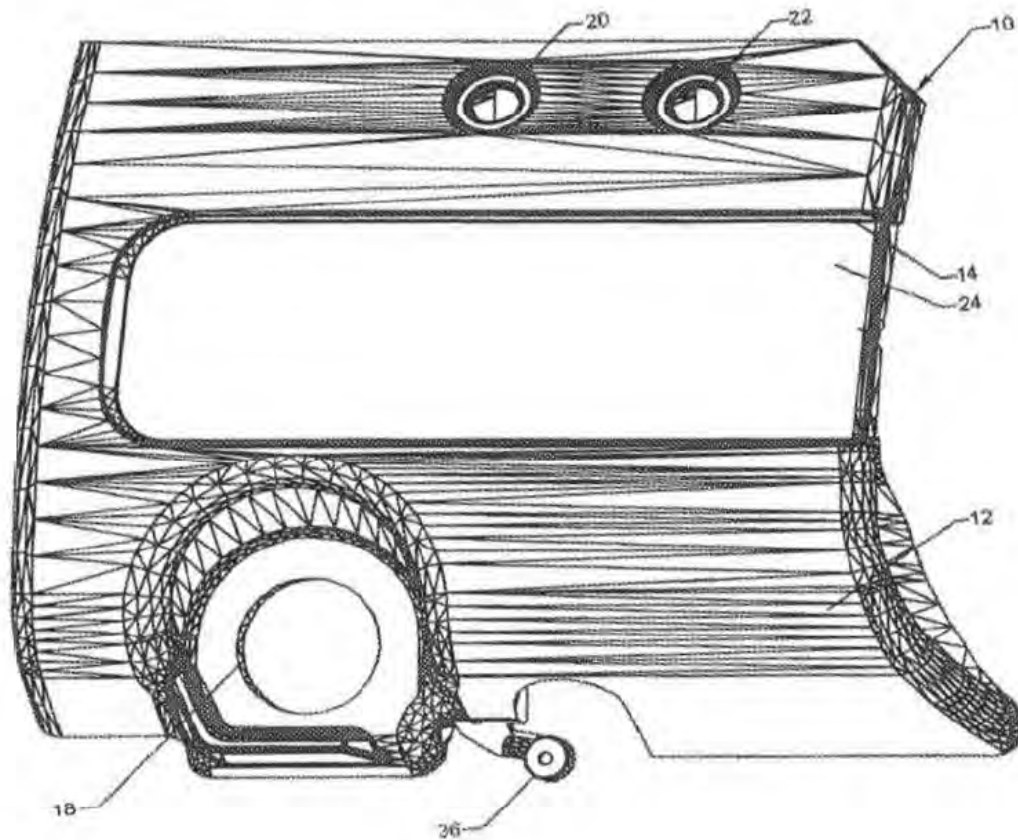


Fig. 1

As illustrated above, Figure 1 shows engine cover 10 including textured outer surface 12 with embedded coating 14. *Id.* at 3:7–8. Outer surface 12 “can receive its texture from [a] grained aluminum tool that forms part of the cavity during the molding process.” *Id.* at 3:11–13. Embedded coating 14 “can be an in-mold coating, such as urethane-based paint.” *Id.* at 3:13–15. Apertures 18, 20, 22 and attachment feature 36 help secure engine cover 10 to the engine. *Id.* at 3:25–29. Engine cover 10 includes a core of medium density foam, such as polyurethane. *Id.* at 3:21–22.

Of the challenged claims, claims 1, 9, and 13 are independent. Claim 1 is illustrative, and is reproduced below:

1. An exterior engine cover adapted to be used as an external cover of an engine comprising:

a core of the exterior engine cover being medium density polyurethane; and

a textured outer surface of the exterior engine cover with an embedded protective coating that is denser than the core

wherein the outer surface exposed to the environment has a visible outer surface when installed.

Ex. 1002, 4:21–28.

C. Instituted Grounds of Unpatentability

Petitioner challenges claims 1–19 based on the following grounds (Pet. 3, 11, 49):

| Reference(s) | Basis | Challenged Claims |
|------------------|-----------------------|-------------------|
| Polytec | § 102(b) ³ | 1–12 |
| Polytec and Burr | § 103(a) | 1–19 |
| Polytec | § 103(a) | 1–19 |

II. ANALYSIS

A. Principles of Law

To prevail in its challenge to Patent Owner’s claims, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, took effect on March 18, 2013. Because the application from which the ’592 patent issued was filed before that date, any citations to 35 U.S.C. §§ 102 and 103 are to their pre-AIA version.

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