

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRIME TIME TOYS LLC, PRIME TIME TOYS LTD.,
and EASEBON SERVICES LTD.,
Petitioner,

v.

SPIN MASTER, INC.,
Patent Owner.

IPR2023-01461
Patent 8,596,255 B2

Before HYUN J. JUNG, NEIL T. POWELL, and BRENT M. DOUGAL,
Administrative Patent Judges.

JUNG, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. *Background and Summary*

Prime Time Toys LLC, Prime Time Toys Ltd., and Easebon Services Ltd. (collectively “Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of an *inter partes* review of claims 1, 2, 13, and 15–20 of U.S. Patent No. 8,596,255 B2 (Ex. 1001, “the ’255 patent”). Spin Master, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

Under 35 U.S.C. § 314, an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition in view of the Preliminary Response and for the reasons explained below, we determine that Petitioner has not shown a reasonable likelihood of prevailing with respect to at least one of the challenged claims.

Thus, we do not institute an *inter partes* review of claims 1, 2, 13, and 15–20 of the ’255 patent.

B. *Real Parties in Interest*

Petitioner identifies Prime Time Toys LLC, Prime Time Toys Ltd., and Easebon Services Ltd. as real parties in interest. Pet. 8. Patent Owner identifies Spin Master, Inc. and Hasbro, Inc. as real parties in interest. Paper 6, 2.

C. *Related Matters*

The ’255 patent issued from a continuation-in-part of an application that is now U.S. Patent No. 8,371,282 (Ex. 1025, “the ’282 patent”). Ex. 1001, code (63); *see also* Pet. 3 (noting the ’282 patent). U.S. Patent No. 8,640,683 (“the ’683 patent”) issued from a divisional of the application that is now the ’282 patent. *See* Pet. 9 (identifying the ’683 patent).

The parties identify that the '282 and '683 patents are subject to an action in the United States International Trade Commission: *In the Matter of Certain Soft Projectile Launching Devices, Components Thereof, Ammunition, and Products Containing Same*, Investigation No. 337-TA-1325 (ITC) (“ITC proceeding”). Pet. 9; Paper 6, 2. The parties also identify that the '282 and '683 patents have also been involved in district court litigation and *inter partes* reviews, most of which are no longer pending. Pet. 9–10; Paper 6, 2–3.

The '282 patent is challenged in IPR2023-01348, and the '683 patent is challenged in IPR2023-01339. Pet. 9–10; Paper 6, 2–3.

D. The '255 Patent (Ex. 1001)

The '255 patent issued on December 3, 2013 from an application filed on December 20, 2010 that is a continuation-in-part of an application filed on May 10, 2010. Ex. 1001, codes (22), (45), (63), 1:7–10.

The '255 patent describes that using a super absorbent polymer (“SAP”) as ammunition in projectile launching devices to provide advantages compared to projectiles that were previously known, such as paint balls, plastics (e.g., as found in “airsoft” guns), and foams (e.g., as found in NERF® guns). Ex. 1001, 1:23–2:3, 3:18–28, 3:59–62, 4:62–5:34. For example, certain SAP projectiles have beneficial characteristics, in part because SAPs break down at different pressures based on their composition. *Id.* at 5:12–13. Hydrated SAP projectiles can be made to have sufficient cross-linking density such that they are projected from a projectile launching device without breaking apart. *Id.* at 3:26–28, 5:2–5. At the same time, because hydrated SAP projectiles rupture when subjected to excessive pressure, such as when impacting a target after being launched from a projectile launcher, the force at impact is spread over a much wider surface

area, thus reducing the likelihood of injury when the target is a person. *Id.* at 3:59–62, 5:8–11.

E. Illustrative Claim

The '255 patent includes 20 claims, of which Petitioner challenges claims 1, 2, 13, and 15–20. Of the challenged claims, claims 1 and 13 are independent and reproduced below is claim 1.

1. A device for projecting a soft-projectile made from a super absorbent polymer, the device comprising:
 - a feed chamber including a plurality of soft-projectiles having the same shape, each soft-projectile being formed from a hydrated super absorbent polymer, wherein the device is adapted to load a soft-projectile from the feed chamber to a firing position;
 - a firing mechanism operatively arranged to accelerate the soft-projectile made from a super absorbent polymer, from the firing position, down a barrel; and
 - a safety mechanism obstructing an end of the barrel and designed to prevent access to the interior of the barrel but allow a soft-projectile accelerated by the firing mechanism to exit the barrel.

Ex. 1001, 18:22–35.

Independent claim 13 recites the same preamble and includes the same feed chamber and firing mechanism limitations but does not recite the safety mechanism limitation. *Compare* Ex. 1001, 18:22–35, *with id.* at 19:7–16; *see also* Pet. 1 (stating that “Independent Claim 13 includes the same limitations as Claim 1, except Claim 13 does not require the safety mechanism”).

F. Asserted Prior Art and Proffered Testimonial Evidence

Petitioner identifies the following references as prior art in the asserted grounds of unpatentability:

Name	Reference	Exhibit
Moorhouse	US 4,834,059, issued May 30, 1989	1006
Peev	BG 110343, published July 31, 2009	1003 ¹
Spitballs	ThinkGeek Spitballs Internet Archive Webpage, Nov. 30, 2009	1002 ²

Petitioner contends that Peev and Spitballs are prior art under § 102(a) and that Moorhouse is prior art under § 102(b).³ Pet. 12, 16. Petitioner also provides a Declaration of Mr. Joel Delman (Ex. 1016) and Dr. Maureen E. Reitman, Sc.D., F.S.P.E., P.E. (Ex. 1017).

G. Asserted Grounds

Petitioner asserts that claims 1, 2, 13, and 15–20 are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
13, 15–20	103(a)	Peev, Spitballs
1, 2	103(a)	Peev, Spitballs, Moorhouse

Pet. 16.

¹ Includes an English language translation. Ex. 1003, 22–41.

² Exhibit 1002 includes a declaration from the Records Request Processor at the Internet Archive (Ex. 1002, 1–2), as well as multiple copies of the Spitballs webpage and related category pages (*id.* at 5–28).

³ The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (Sept. 16, 2011), took effect on March 16, 2013. Because the ’255 patent issued from an application filed before that date, our citations to 35 U.S.C. §§ 102 and 103 in this Decision are to their pre-AIA versions. *See also* Pet. 12 (noting that “[t]he earliest date of invention claimed [in the ITC proceeding] was February 21, 2010”).

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