

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TELEBRANDS CORP.,  
Petitioner,

v.

TINNUS ENTERPRISES, LLC,  
Patent Owner.

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Case PGR2017-00015  
Patent 9,527,612 B2

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Before MICHAEL W. KIM, FRANCES L. IPPOLITO, and  
KEVIN W. CHERRY, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 328(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

Telebrands Corp. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) for post-grant review of claims 1–4 of U.S. Patent No. 9,527,612 B2 (Ex. 1001, “the ’612 patent”). Pursuant to 35 U.S.C. § 324, we determined that Petitioner showed that the information presented in the Petition, if such information was not rebutted, would demonstrate that it is more likely than not that claim 3 of the ’612 patent was unpatentable for indefiniteness. Paper 16 (“Inst. Dec.”). We did not institute post-grant review of claims 1, 2, and 4 or on all of the grounds set forth in the Petition. Inst. Dec. 24. Tinnus Enterprises, LLC (“Patent Owner”) filed a Patent Owner Response (Paper 23, “PO Resp.”). Petitioner filed a Reply. Paper 28 (“Reply”).

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314, the statute governing the related type of post-grant proceedings known as *inter partes* reviews, may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1369–70 (2018). On May 3, 2018, we determined that *SAS* governed post-grant reviews as well, and issued an order instituting on all of claims and all of the grounds of the Petition as suggested by *SAS*. Paper 30 (“*SAS* Order”).

On May 31, 2018, we issued a revised schedule. Paper 36 (“Order”). As we explained in our Order, Patent Owner had informed us that it would not participate any further in these proceedings. Order 3–4. We allowed Patent Owner to rely on its arguments submitted in its Preliminary Response (Paper 13, “Prelim. Resp.”) regarding the previously un-instituted grounds and claims. *Id.* at 4. We further allowed Petitioner to submit a Supplemental Reply (Paper 37, “Supp. Reply”). Petitioner also filed a

Motion to Exclude. Paper 39 (“Mot.”). An oral hearing was held on August 31, 2018. Paper 86 (“Tr.”).<sup>1</sup>

We issue this Final Written Decision pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine Petitioner has not proven by a preponderance of the evidence that claims 1–4 of the ’612 patent are unpatentable. *See* 35 U.S.C. § 326(e). Petitioner’s Motion to Exclude is *dismissed as moot*.

#### A. *Related Proceedings*

We are informed that the ’612 patent is involved in the following two federal district court cases:

- *Tinnus Enterprises, LLC v. Telebrands Corp.*, Civil Action No. 6:17-cv-00170-RWS-JDL (E.D. Tex.); and
- *Tinnus Enterprises, LLC v. Wal-Mart Stores, Inc. d/b/a Wal-Mart*, Civil Action No. 6:17-cv-00361-RWS-JDL (E.D. Tex.)

Pet. 3; Paper 12, 2–3. The ’612 patent was also subject to a petition for post-grant review in PGR2017-00051, which we denied.

Related U.S. Patent No. 9,051,066 B1 (“the ’066 patent”) is the subject of post-grant review in PGR2015-00018 involving the same parties (“the -00018 PGR”). The Board instituted trial in the -00018 PGR on January 4, 2016. *See Telebrands Corp. v. Tinnus Enterprises, LLC*, Case PGR2015-00018 (PTAB Jan. 4, 2016) (Paper 7) (“-00018 PGR DI.”). A final written decision in PGR2015-00018 issued on December 30, 2016

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<sup>1</sup> The original hearing was scheduled for August 13, 2018 (*see* Papers 41, 44), but Petitioner was unable to attend. A rescheduled hearing was held on August 31, 2018. *See* Paper 43.

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finding claims 1–6, 8, and 10–14 of the '066 patent unpatentable for indefiniteness under 35 U.S.C. § 112(b). *See Telebrands Corp. v. Tinnus Enterprises LLC*, Case PGR2015-00018 (PTAB Dec. 30, 2016) (Paper 75) (“-00018 PGR FD”). The Federal Circuit reversed and remanded the -00018 PGR FD determining that the claims were not indefinite. *See Tinnus Enterprises, LLC v. Telebrands Corp.*, 733 F. App'x 1011 (Fed. Cir. May 30, 2018) (non-precedential).

The '066 patent is also involved in federal district court proceedings, *Tinnus Enterprises, LLC, et al. v. Telebrands Corp., et al.*, 6:15-cv-00551 RWS-JDL (E.D. Tex.) and *Tinnus Enterprises, LLC, et al. v. Telebrands Corp.*, Civil Action No. 6:17-cv-00199-RWS-JDL. Paper 12, 3–4. The Federal Circuit affirmed the district court's decision granting a preliminary injunction in the 15-cv-000551 proceeding in *Tinnus Enterprises, LLC v. Telebrands Corp.*, 846 F.3d 1190 (Fed. Cir. 2017).

Additionally, related U.S. Patent Nos. 9,242,749 B2 (“the '749 patent”) and 9,315,282 B2 (“the '282 patent”) are the subject of post-grant review petitions filed by Petitioner in PGR2016-00030 and PGR2016-00031, respectively. *See* Paper 12, 2. We instituted post-grant reviews involving both patents on February 21, 2017. *See Telebrands Corp. v. Tinnus Enterprises, LLC*, Case PGR2016-00030 (PTAB Feb. 21, 2017) (Paper 16) (instituting post-grant review as to the '749 patent) (“-00030 DI”); *Telebrands Corp. v. Tinnus Enterprises, LLC*, Case PGR2016-00031 (PTAB Feb. 21, 2017) (Paper 15) (instituting post-grant review as to the '282 patent) (“-00031 DI”). On February 7, 2018, we entered Final Written Decisions in both cases finding that Petitioner had failed to show any of the challenged claims were unpatentable. *See Telebrands Corp. v. Tinnus*

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*Enterprises, LLC*, Case PGR2016-00030 (PTAB Feb. 7, 2018) (Paper 91) (finding all claims of the '749 patent had not been shown to be unpatentable as obvious) (“-00030 FD”); *Telebrands Corp. v. Tinnus Enterprises, LLC*, Case PGR2016-00031 (PTAB Feb. 7, 2018) (Paper 88) (finding all of the challenged claims of the '282 patent had not been shown to be unpatentable) (“-00031 FD”). These decisions are currently on appeal to the Federal Circuit. See *Tinnus Enterprises, LLC v. Telebrands Corp.*, Nos. 2017-1175, 2018-1681, 2018-1682 (Fed. Cir.).

We are informed that Petitioner is named as a defendant in federal district court cases involving the '749 and '282 patents—*Tinnus Enterprises, LLC v. Telebrands Corp.*, Civil Action No. 6:16-cv-00033-RWS-JDL (E.D. Tex.) and *Tinnus Enterprises, LLC v. Wal-Mart Stores, Inc.*, Civil Action No. 6:16-cv-00034-RWS-JDL (E.D. Tex.). Paper 12, 3–4. The Federal Circuit issued summary orders affirming the district court’s grant of a preliminary injunction against Petitioner regarding the '749 and '282 patents—*Tinnus Enterprises, LLC v. Telebrands Corp.*, 709 F. App’x 704 (Fed. Cir. Jan. 16, 2018) (non-precedential); *Tinnus Enterprises, LLC v. Telebrands Corp.*, 708 F. App’x 1019 (Fed. Cir. Jan. 16, 2018) (non-precedential). On November 21, 2017, a jury issued a verdict in favor of Patent Owner finding infringement, no invalidity, and damages of \$12.3 million for the '749 patent. Ex. 2028.

There were also three additional petitions for post-grant review filed—PGR2017-00024, PGR2017-00040, and PGR2017-00052. Paper 12, 2. PGR2017-00024 and PGR2017-00052 challenged U.S. Patent No. 9,533,779 B2. PGR2017-00040 challenged U.S. Patent No. 9,682,789 B2. We denied institution of all of these petitions.

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