

OWENS CORNING v. FAST FELT CORPORATION, Appeal No. 2016-2613 (Fed. Cir. October 11, 2017). Before Newman, Dyk and Taranto. Appealed from PTAB.

Background:

Fast Felt holds a patent related to printing nail tabs or reinforcement strips for roofing material. Fast Felt sued Owens Corning for infringement based on Owens Corning's SureNail products, in response to which Owens Corning petitioned the Board for *inter partes* review of Fast Felt's claims based on a theory of obviousness.

Although the Board agreed with Owens Corning that all of the claimed features were found separately in the cited references, the Board determined that Owens Corning had failed to show that it would have been obvious for a skilled artisan to combine the teachings of the references to reach the claimed method. Owens Corning appealed.

Issue/Holding:

Did the Board err in finding the claims were not obvious? Yes, reversed.

Discussion:

On appeal, Owens Corning argued that the Board adopted an erroneous claim construction by treating the claimed "roofing or building cover material" as being limited to material which was or would be coated with asphalt. The claims at issue do not require the "roofing or building cover material" to be coated with asphalt or any particular material. Nevertheless, the Board's finding of a lack of combinability of the references was based on the difference in material used in the references for the "roofing or building cover material." The Board further relied on Fast Felt's experts who testified that the secondary references do not address using an asphalt-coated roofing material and would not have been used to modify the primary reference which uses asphalt-coated roofing material.

The Federal Circuit agreed with Owens Corning that this claim construction by the Board was inconsistent with the broadest-reasonable-interpretation standard applicable in IPRs. Because the claims do not require the roofing or building cover material to be asphalt-coated, the Board had erred by failing to consider the combinability of the references with respect to roofing or building cover materials that were not coated with asphalt.

The Federal Circuit then determined, based on its review of the prior art and expert testimony, that the combination of the prior art required a simple substitution of known deposition techniques and, in the absence of asphalt coating concerns, would have been obvious. The Federal Circuit thus found the claims to be obvious and reversed the Board's decision.