

Fed. Circ. Shoots Down WeatherTech Rehearing Bid

By **Dani Kass**

Law360 (August 9, 2023, 8:44 PM EDT) -- The Federal Circuit will not reconsider its decision to invalidate two patents underlying the WeatherTech brand of floor mat, which had originally been upheld at the Patent Trial and Appeal Board, the court said Tuesday.

Both the original panel and full Federal Circuit were unpersuaded by arguments from the patent owner — WeatherTech parent MacNeil IP LLC — that an opinion issued by the court one day before its own patents were invalidated justifies reconsideration and that the circuit court should have remanded the case rather than reverse the PTAB's ruling.

The disputes center on objective indicia of nonobviousness, also known as secondary considerations, where a finding that the invention would have been obvious over prior art can be overridden by the reality of the situation. Those factors include commercial success of the invention.

MacNeil had urged the court to take back how it had interpreted objective evidence of nonobviousness in the June 6 WeatherTech decision and to instead use the interpretation from June 5's *Medtronic v. Teleflex*. In *Medtronic*, the Federal Circuit denied the medical device company's bid to invalidate Teleflex's catheter patents, citing objective evidence.

The July 6 petition for rehearing doesn't make the conflicting parts of the two precedential rulings clear, other than the difference being about analyzing such evidence.

With MacNeil, the PTAB had found that prior art would have shown obviousness, but that there had been a long-felt need for stable vehicle floor mats, and that need was not met before WeatherTech. To top it off, the industry had praised MacNeil's invention and that it directly led to a large amount of sales for WeatherTech.

The PTAB had upheld the two MacNeil patents challenged by Yita LLC based on such evidence, but the Federal Circuit reversed the decision. MacNeil called for either a full reversal of that ruling or, at a minimum, a remand to the PTAB rather than a reversal.

After the Federal Circuit's opinion against MacNeil came down, its Baker Botts LLP legal team was replaced with attorneys from Christensen O'Connor Johnson Kindness PLLC, an intellectual property firm based in Seattle.

"Yita is very pleased with this result, which it fully expected," Mark P. Walters of Lowe Graham Jones

PLLC said in an email for his client.

Counsel for MacNeil didn't immediately respond to a request for comment Wednesday.

U.S. Circuit Judges Richard G. Taranto, Raymond T. Chen and Kara Farnandez Stoll sat on the original panel for the Federal Circuit.

The patents-in-suit are U.S. patent Nos. 8,382,186 and 8,833,834.

Yita is represented by Mark P. Walters of Lowe Graham Jones PLLC and Jason A. Fitzsimmons and Ralph W. Powers III of Sterne Kessler Goldstein & Fox PLLC.

MacNeil is represented by John D. Denkenberger, Brian F. McMahon and John E. Whitaker of Christensen O'Connor Johnson Kindness PLLC.

The case is Yita LLC v. MacNeil IP LLC, case numbers 22-1373, 22-1374, in the U.S. Court of Appeals for the Federal Circuit.

--Editing by Andrew Cohen.