

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ATHENA AUTOMATION LTD.,
Petitioner,

v.

HUSKY INJECTION MOLDING SYSTEMS LTD.,
Patent Owner.

Case IPR2013-00169
Patent 5,624,695

Before JENNIFER S. BISK, MICHAEL J. FITZPATRICK, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

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

I. INTRODUCTION

A. Background

Petitioner Athena Automation Ltd. filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1-17 (“the challenged claims”) of U.S. Patent No. 5,624,695 (Ex. 1001, “the ’695 patent”). 35 U.S.C. §§ 311-319. Patent Owner Husky Injection Molding Systems Ltd. waived the filing of a Preliminary Response. Paper 7. On July 30, 2013, the Board instituted trial (Paper 8, “Decision to Institute”), concluding that Petitioner had shown a reasonable likelihood of showing that the challenged claims were unpatentable based on the following grounds:

Reference[s] ¹	Basis	Claims challenged
Queré	§ 102	1-11 and 14
Arend	§ 102	1-4 and 14-17
Arend and Queré	§ 103	5-13
Arend, Queré, and Kushibe	§ 103	13
Stüdli	§ 102	1, 2, and 14-17
Stüdli and Queré	§ 103	9-13

After institution of trial, Patent Owner filed a Response. Paper 22 (“PO Resp.”). Patent Owner also filed a Motion to Amend claims by submitting proposed new claims 18-34 for claims 1-17. Paper 24 (“Mot. to Amend”). Petitioner filed a Reply to the patent owner response (Paper 33, “Reply”) and an Opposition to Patent Owner’s Motion to Amend (Paper 34, “Opp. Mot. to Amend”). Patent Owner then filed a Reply in support of its

¹ U.S. Patent No. 2,976,569 (Ex. 1002) (“Queré”); U.S. Patent No. 5,417,913 (Ex. 1003) (“Arend”); U.S. Patent No. 2,711,561 (Ex. 1004) (“Stüdli”); and U.S. Patent No. 4,874,309 (Ex. 1006) (“Kushibe”).

Motion to Amend (Paper 40, “Reply Mot. to Amend”). Oral hearing was held April 28, 2014, a transcript of which appears in the record. Record of Oral Hearing, Paper 50 (“Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Petitioner has shown, by a preponderance of evidence, that claims 1-17 are *unpatentable*.

Patent Owner’s Motion to Amend claims is *denied*.

B. Related Proceedings

The parties simultaneously are involved in two other *inter partes* reviews based on patents claiming similar subject matter. IPR2013-00167 involves U.S. Patent No. 5,620,723 (“the ’723 patent”) and IPR2013-00290 involves U.S. Patent No. 7,670,536. The ’695 patent shares much of the specification of the ’723 patent. In a separate decision, we conclude that claims 21-37 of the ’723 patent are unpatentable as obvious over combinations of some of the same references raised in this proceeding: Queré, Arend, and Stüdli. IPR2013-00167, Paper 51 (“the 2013-00167 Decision”). The Petition in IPR2013-00290 was filed several months after the other two petitions and is currently scheduled for oral hearing on July 22, 2014.

C. The ’695 Patent

The technology of the ’695 patent is the same as that of the ’723 patent and is described in the 2013-00167 Decision at pages 3-5. For the purposes of this decision, we adopt that description.

D. Illustrative Claims

Claim 1 is the only independent claim of the '695 patent. Claims 1, 12, and 13, reproduced below, are illustrative of the claimed subject matter:

1. A securing assembly for use with a first platen of an injection molding machine, comprising:
 - means for connecting said first platen to another platen;
 - and
 - means for securing said first platen to said means for connecting and adapted to be attached to said first platen, wherein said means for securing includes engagement means for placing said means for securing into and out of locking engagement with said means for connecting upon rotation of said means for securing, such that when said engagement means is out of locking engagement with said means for connecting, said means for securing and said means for connecting are relatively movable.
12. The securing assembly according to claim 11,
 - wherein said first platen is adapted to be forced in a direction for achieving clamping with said another platen
 - and wherein said first platen has a bore for receiving said means for securing,
 - wherein said means for conveying has an outer surface configured to form cavities between said outer surface and said bore and has surfaces extending substantially transversely to said direction, said cavities for the introduction of pressurized fluid and said surfaces for the receipt of pressure from said pressurized fluid thereagainst.
13. The securing assembly according to claim 12, wherein said first platen is a moveable platen.

II. ANALYSIS

A. Assignor Estoppel

Patent Owner argues that Petitioner is barred from challenging the validity of the '695 patent by assignor estoppel. PO Resp. 37-59. Patent Owner contends that Mr. Robert Schad, one of the named inventors of the '695 patent, is the founder, co-owner, President, Chief Executive Officer, and one of two directors on the Board of Directors of Petitioner and is, therefore, in privity with Petitioner. *Id.* at 37-39. Thus, according to Patent Owner, Petitioner is estopped from challenging the patentability of the '695 patent under the doctrine of assignor estoppel. *Id.*

We have determined previously, in the related proceeding, IPR2013-00290, that assignor estoppel is not a basis for denying a petition requesting *inter partes* review:

Under the AIA, “a person *who is not the owner of a patent* may file with the Office a petition to institute an *inter partes* review of the patent.” 35 U.S.C. § 311(a) (emphasis added). Consequently, under the statute, an assignor of a patent, who is no longer an owner of the patent at the time of filing, may file a petition requesting *inter partes* review. This statute presents a clear expression of Congress’s broad grant of the ability to challenge the patentability of patents through *inter partes* review.

Athena Automation Ltd. v. Husky Injection Molding Sys. Ltd., IPR2013-00290, slip op. at 12-13 (PTAB Oct. 25, 2013) (Paper 18); *see also Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, slip op. at 11-14 (PTAB Dec. 19, 2013) (Paper 16).

Patent Owner does not persuade us otherwise in this proceeding. Specifically, we are not persuaded by Patent Owner’s argument that 37 C.F.R. § 42.101(c), enacted pursuant to 35 U.S.C. §§ 312 and 316, modifies the broad statutory language of § 311. *See* PO Resp. 45-50. We

are also not persuaded that § 311(b) limits the scope of § 311(a) to grounds not subject to assignor estoppel. *See* PO Resp. 49-50 n.6.

Because we are not persuaded that assignor estoppel, an equitable doctrine, provides an exception to the statutory mandate that any person who is not the owner of a patent may file a petition for an *inter partes* review, we decline to dismiss this *inter partes* review based on the doctrine of assignor estoppel.

B. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Pursuant to that standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

In the Decision to Institute, we adopted Petitioner’s construction of several claim terms, concluding that they correspond to the plain and ordinary meaning in the context of the Specification. Decision to Institute 4-5. Although Petitioner did not propose a construction for “movable platen,” we expressly construed that term as well. *Id.* at 5. In particular, we construed “movable platen” as “a platen that, at certain times, is capable of being moved—i.e. not in a fixed position—relative to a stationary platen and connecting tie bars.” *Id.* For all other claim terms not specifically addressed in the Petition, we applied the plain and ordinary meaning that the term

would have had to a person of ordinary skill in the art, without further elaboration. *Id.*

Patent Owner argues “movable platen” should instead be construed as “a platen that is movable *during an injection molding operation*” and “stationary platen” should be construed as “a platen that does not move *during an injection molding operation.*” PO Resp. 21-23. Petitioner disagrees and asserts that the differences between Patent Owner’s proposed construction and the construction adopted in the Decision to Institute are irrelevant. Reply 2 n.1. Patent Owner agreed at oral argument that, for this proceeding, the analysis is the same whether or not we adopt Patent Owner’s proposed construction. *See* Tr. 19:1-13.

We agree with the parties that, on this record, either construction of the term “movable platen” would result in the same patentability analysis. Therefore, for purposes of this decision, we proceed under the construction adopted in the Decision to Institute.

C. Claims 5-10

Previously, we considered the Petition and determined it was reasonably likely that Petitioner would prevail in showing that claims 5-10 are unpatentable as anticipated by Queré and obvious over the combination of Arend and Queré. Decision to Institute 6-8. We also determined that it was reasonably likely that Petitioner would prevail in showing that claims 9 and 10 are unpatentable for the additional reason that they are obvious over the combination of Stüdli and Queré. *Id.* at 9-10.

Patent Owner argues in its response that claims 5-8 are not obvious over Arend and Queré and that claims 9 and 10 are not obvious over either the combination of Arend and Queré or Stüdli and Queré. PO Resp. 33-37.

Patent Owner, however, does not address whether these claims are anticipated by Queré. Thus, Patent Owner has not directed us to any argument or evidence to rebut Petitioner's demonstration that claims 5-10 are unpatentable.

Moreover, during oral argument, Petitioner's counsel stated that "[w]ith regard to the '695 patent, the 169 matter², Claims 12 and 13 remain on the table . . . Mr. Robinson noted in the . . . conference call on Friday that the other claims have all been waived." Tr. 5:4-7. In response, Patent Owner's counsel stated that "I agree with Mr. Schmitt with regard to the original claims at issue, [for the] '695 patent, we're talking about Claims 12 and 13." *Id.* at 17:23-24. Patent Owner's counsel also conceded that "it turns out upon closer scrutiny, while there's an individual preferred embodiment that's represented by some of the dependent claims, including the ones we're talking about here today, some of the broader features were shown . . . 40 years before the patent was actually filed." *Id.* at 17:11-18.

To the extent that any of Patent Owner's arguments presented for the patentability of claims 12 and 13 are also applicable to the patentability of claims 5-10, we are not persuaded for the reasons discussed below. Thus, the preponderance of the evidence, including the findings of fact and reasoning set forth in our Decision to Institute, indicate that these claims are unpatentable as anticipated by Queré. We do not address the proposed grounds of obviousness for claims 5-10. Accordingly, based on the record before us, we conclude that a preponderance of the evidence demonstrates that claims 5-10 are unpatentable as anticipated by Queré.

² Referring to case caption IPR2013-00169.

D. Claims 1-4, 11, and 14-17

Previously, we considered the Petition and determined it was reasonably likely that Petitioner would prevail in showing that claims 1-4, 11, and 14-17 are unpatentable based on multiple grounds. Decision to Institute 6-10. As noted above, Patent Owner did not file a Preliminary Response in this proceeding and its Response addresses only claims 5-10, 12, and 13. See PO Resp. 23-37. Thus, Patent Owner has not directed us to any argument or evidence to persuade us that Petitioner fails to demonstrate that claims 1-4, 11, and 14-17 are unpatentable. Moreover, as described in more detail above, during oral argument, Patent Owner's counsel clarified that Patent Owner is arguing patentability of only claims 12 and 13.

To the extent that any of Patent Owner's arguments presented for the patentability of claims 12 and 13 are also applicable to claims 1-4, 11, and 14-17, we are not persuaded for the reasons discussed below. Thus, the preponderance of the evidence, including the findings of fact and reasoning set forth in our Decision to Institute, indicate that these claims are unpatentable.

Accordingly, based on the record before us, we conclude that a preponderance of the evidence demonstrates that claims 1-4, 11, and 14-17 are unpatentable based on the following grounds:

- (1) claims 1-4, 11, and 14 are anticipated by Queré;
- (2) claims 1-4 and 14-17 are anticipated by Arend;
- (3) claim 11 is obvious over Arend and Queré;
- (4) claims 1, 2, and 14-17 are anticipated by Stüdli; and
- (5) claim 11 is obvious over Stüdli and Queré.

E. Claims 12 and 13

Claims 12 and 13 indirectly depend from independent claim 1. PO Resp. 23-37. For the reasons discussed below, we conclude that a preponderance of the evidence demonstrates that these claims are unpatentable.

1. Overview of Arend

Arend is described in the 2013-00167 Decision at pages 17-19. For the purposes of this decision, we adopt that description.

2. Overview of Queré

Queré is described in the 2013-00167 Decision at pages 10-12. For the purposes of this decision, we adopt that description.

3. Alleged Obviousness over Arend, Queré, and Kushibe

Petitioner asserts that claims 12 and 13 are obvious over the combination of Arend and Queré, and claim 13 is also obvious over the combination of Arend, Queré, and Kushibe. Pet. 35-44. In particular, Petitioner asserts that Arend discloses every limitation of claims 12 and 13 except (1) means for securing “comprises a piston positioned coaxially relative to said means for connecting,” (2) “means for securing further comprises means for conveying a clamping force to said first platen,” and (3) “wherein said first platen has a bore for receiving said means for securing” (“the bore limitation”). *Id.* at 36-37. Petitioner relies on Queré as disclosing these limitations. *Id.*

In addition, for claim 13, Petitioner argues that, depending on the construction of “movable platen,” Arend’s platen 16 would meet claim 13’s limitation that “said first platen is a movable platen.” Pet. 42-43. Petitioner alternatively relies on Kushibe, cited in the ’695 patent (Ex. 1001, 1:13-17, 26-30), to show that a person of ordinary skill in the art would find it an

obvious design choice to make platen 16 movable as recited in claim 13.
Pet. 42-43.

Regarding the bore limitation, Petitioner concedes that Arend does not disclose that the bore is within platen 16, because Arend discloses modified cam nut 134 positioned within annular sleeve 128, which is secured to a rear surface of platen 16 by fasteners 130. *Id.* at 37-38. According to Petitioner, it would have been obvious to integrate part or all of sleeve 128 with platen 16, as opposed to being attached externally, to reduce part count, without any effect on the function of platen 16. *Id.* Such integration would result in the bore limitation—platen 16 having the bore of sleeve 128. *Id.*

As discussed above, we have already determined that both Queré and Arend each disclose every limitation of claim 1, from which claims 12 and 13 depend. Regarding the limitations added by claims 12 and 13, Patent Owner addresses only the bore limitation, arguing that Arend does not disclose this limitation, because tie rod locks 126 are attached to platen 16, but are not “*within* a platen.” PO Resp. 25. We note that claim 12, which recites the bore limitation, does not use the language *within* the platen, but instead recites that “said movable platen *has* bores for receiving said means for securing” (emphasis added). Even assuming, as both parties appear to do, that claims 12 and 13 require the bore to be within the platen, we agree with Petitioner that a person of ordinary skill would have found it obvious, based on the disclosure in Arend and Queré, to locate the bore within platen 16.

Patent Owner argues that modification of Arend to make sleeve 128 of tie rod locks 126 integral with platen 16, as suggested in the Petition, would prevent installation of cam nuts 134 within the sleeves 128. *Id.* at 26-

27 (citing Ex. 2006 ¶ 29). Thus, according to Patent Owner, the suggested modification would make the resulting machine inoperable. PO Resp. 27-28 (citing Ex. 2006 ¶ 30). In support of this argument, Patent Owner's declarant, Frederick G. Steil, testifies that Arend, modified as suggested, would be inoperable due to the disparate relative diameters of the components. Ex. 2006 ¶¶ 30-33. Further, changing the size to permit the modification would result in a platen 16 that is difficult and costly to manufacture. *Id.* Petitioner replies that a person of ordinary skill would have found it an obvious design choice to size the components of Arend appropriately to produce an embodiment meeting the bore limitation. Pet. 38; Reply 2-3.

We agree with Petitioner. Patent Owner does not assert that there are more than two obvious locations for securing the bore—either within the platen or attached to the platen. Nor does Patent Owner point to persuasive evidence that the particular location of the bore would achieve any novel or unexpected results. Finally, Patent Owner does not point to persuasive evidence that a person of ordinary skill would have been discouraged from making the modification because of the size issue. Moreover, Stüdl explicitly discloses this limitation, as described in more detail below, evidencing that at the time of the invention a person of ordinary skill in the art would have known to locate a bore in the platen. *See* Ex. 1004, Fig. 7. Thus, we are persuaded that the location of the bore using appropriately sized components would have been an obvious design choice within the abilities of a person of ordinary skill. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”); *In re Sovish*, 769 F.2d 738, 742

(Fed. Cir. 1985) (affirming a rejection of obviousness when modifying one reference with a component of another reference required “no more change than to make it the right size”).

We are not persuaded by Mr. Steil’s testimony that integration of elements would increase the complexity of the design and the cost of manufacturing. *See* Ex. 2006 ¶¶ 31-33; *Medichem S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“[A] given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.”). Moreover, Patent Owner does not point to persuasive evidence that a person of ordinary skill would have been discouraged from making the modification or found such modification not obvious because of this increased expense. *See, e.g.*, Tr. 25-26. Merely knowing that the integration would cause increased expense does not indicate whether such integration would not have been obvious to persons of ordinary skill in the art. *Orthopedic Equip. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983) (“[T]he fact that the two disclosed apparatus would not be combined by businessmen for economic reasons is not the same as saying that it could not be done because skilled persons in the art felt that there was some technological incompatibility that prevented their combination.”). In light of the disclosures of Arend and Queré, we are not persuaded that a potential increase in cost of machining complexity changes the fact that a person of ordinary skill in the art would have found obvious the minimal modification of integrating the two components.

Finally, to the extent that Patent Owner argues that (1) Queré does not show a cavity for pressurized fluid within the bore and improperly only accommodates mold sections that have the same shut height, or

(2) modification of Queré to include the bore limitation would be inoperable because it would not include these features, we do not find these arguments persuasive.³ See Tr. 23-24; Ex. 2006 ¶¶ 16-22. Claims 12 and 13 do not recite a cavity for pressurized fluid within the bore or that the claimed machine must accommodate mold sections with different shut heights. See, e.g., Tr. 37.

We conclude that a preponderance of the evidence demonstrates that claims 12 and 13 are unpatentable based on the combination of Arend and Queré and claim 13 is unpatentable based on the combination of Arend, Queré, and Kushibe.

4. Overview of Stüdli

Stüdli is described in the 2013-00167 Decision at pages 22-24. For the purposes of this decision we adopt that description.

5. Alleged Obviousness over Stüdli and Queré

Petitioner asserts that Queré discloses all the limitations of claims 12 and 13 except the bore limitation and that a person of ordinary skill in the art would find it obvious to modify Queré in light of Stüdli's disclosure of a bore located within a platen in order to reduce part count.⁴ Pet. 57-60.

³ Patent Owner's Response does not present these arguments. See PO Resp. 25-30. We address them solely because Patent Owner's declaration testimony and oral argument, which referred to these features, do not clearly identify what, precisely, Patent Owner's arguments are or to what specific grounds they apply. See, e.g., Tr. 23-24; Ex. 2006 ¶¶ 16-22.

⁴ Petitioner alternatively argues that Stüdli discloses every limitation of claims 12 and 13 except "the means conveying a clamping force to said platens for clamping said platens during injection molding" and relies on Queré for disclosing this limitation. Pet. 52-57. Because we find that claims 12 and 13 are obvious based on the argument addressed here, we do not reach Petitioner's alternative argument.

Specifically, Petitioner asserts that a person of ordinary skill would have found it an obvious design choice to have made part or all of pressure cylinder 9, which includes bore B, integral with block 7. *Id.* at 57-58 (citing Ex. 1006 ¶ 11). As discussed above, we have already determined that Queré discloses every limitation of claims 1 and 11, from which claims 12 and 13 depend. Also discussed above, we agree (1) that Stüdli discloses a bore within a platen, and (2) that the location of the bore is an obvious design choice within the abilities of a person of ordinary skill. *See KSR*, 550 U.S. at 421.

Patent Owner argues that this particular combination would not have been obvious, because it would increase the complexity and manufacturing cost of the resulting machine. PO Resp. 30-33 (citing Ex. 2006 ¶¶ 10-15). We are not persuaded by this argument for the reasons discussed above with respect to the combination of Arend and Queré. More specifically, merely knowing that the integration would cause increased expense or machining complexity does not indicate whether such integration would have been nonobvious to persons of ordinary skill in the art. On this record, we are persuaded that, despite a potential increase in cost and machining complexity, a person of ordinary skill in the art would have found obvious the modification of Queré by relocating pressure cylinder 9, including bore B, within block 7.

We conclude that a preponderance of the evidence demonstrates that claims 12 and 13 are unpatentable based on the combination of Stüdli and Queré.

F. Patent Owner's Motion to Amend Claims

Because we determine that claims 1-17 are unpatentable we turn to Patent Owner's contingent request to enter proposed, amended claims 18-34. In its Motion to Amend, Patent Owner proposes replacements for each of the challenged claims. At oral argument, however, Patent Owner stated that it is only interested in pursuing proposed claims 29 and 30, the proposed substitutes for claims 12 and 13. Tr. 18:1-6, 49:14-16. Thus, we explicitly address only proposed claims 29 and 30.

Proposed claims 29 and 30, reproduced below⁵ with underlining to indicate additions and strikethrough to indicate deletions from claims 12 and 13 of the issued '695 patent, recites:

29. (Proposed Conditional Substitute for Challenged Claim 12)

A securing assembly for use with a first platen of an injection molding machine, comprising:

a securing assembly for use with a first platen of an injection molding machine, comprising;

means for connecting said first platen to said means for connecting and adapted to be attached to said first platen,

wherein said means for securing includes engagement means for placing said means for securing into and out of locking engagement with said means for connecting upon rotation of said for securing, such that when said engagement means is out of locking engagement with said means for connecting, said means for securing and said means for connecting are relatively movable;

wherein said means for securing includes a first cylindrical portion, a second cylindrical portion, and a tapered portion extending between and connecting said first cylindrical portion and said second cylindrical portion, said first cylindrical portion including a larger

⁵ For purposes of our analysis, we have rewritten proposed claim 29 in independent form such that it includes the content of proposed claims 28 and 18 from which claim 29 depends.

diameter than said second cylindrical portion and being disposed farther from the other of said movable platen and said stationary platen than said second cylindrical portion;

wherein said means for securing further comprises means for conveying a clamping force to said first platen for clamping said first platen to said another platen during injection molding;

wherein said first platen is adapted to be forced in a direction for achieving clamping with said another platen

and wherein said first platen has a bore for receiving said means for securing, wherein said means for conveying has an outer surface including said tapered surface and surfaces extending substantially transversely to said direction configured to form cavities between said outer surface and said bore ~~and has surfaces extending substantially transversely to said direction~~, said cavities for the introduction of pressurized fluid and said surfaces for the receipt of pressure from said pressurized fluid thereagainst.

30. (Proposed Conditional Substitute for Challenged Claim 13) The securing assembly according to claim ~~12~~29, wherein said first platen is a movable platen.

During an *inter partes* review, we enter proposed amended claims only upon a showing that the amended claims are patentable. *Idle Free Sys. v. Bergstrom, Inc.*, IPR2012-00027, slip op. at 33 (PTAB Jan. 7, 2014) (Paper 66). This burden may not be met merely by showing that the proposed claims are distinguished over the prior art references applied to the original patent claims. Instead, because there is no examination of the proposed claims, the patent owner must show that the subject matter recited is not taught or suggested by the prior art in general for us to determine that they comply with 35 U.S.C. §§ 102 and 103. *Id.*

Patent Owner argues that the securing assemblies recited in the proposed claims 29 and 30 are patentable over Queré, because Queré fails to disclose a coupling sleeve that includes a tapered portion that extends

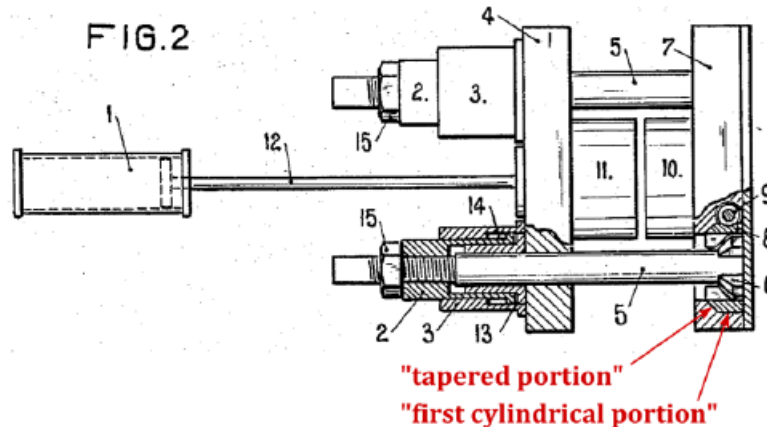
between and connects first and second cylindrical portions (“the tapering limitation”). Mot. to Amend 3 (citing Ex. 2013 ¶ 8). Although it is Patent Owner’s burden to show patentability over the prior art in general, Patent Owner does not assert, or direct us to evidence, that the claimed securing assemblies were novel over other securing assemblies known in the art. Instead, Patent Owner focuses only on the disclosure of Queré. Patent Owner does not direct us to evidence, such as the testimony of one of at least ordinary skill in the art, that it is unaware of any other anticipatory art. *See* Tr. 50:22-51:12. Nor does Patent Owner direct us to evidence that the proposed claim would not have been obvious over Queré either alone or in combination with another prior art reference. *Id.* at 51:17-22. Accordingly, Patent Owner has not met the burden it undertook by putting forth proposed amended claims.

In any event, even if Patent Owner’s burden was to show patentability over only the prior art of record, we would not be persuaded that the proposed claims are patentable, because Patent Owner addresses only whether Queré anticipates the newly claimed injection molding machine, not whether ordinarily skilled artisans would have considered Queré to render the newly claimed securing assemblies obvious.

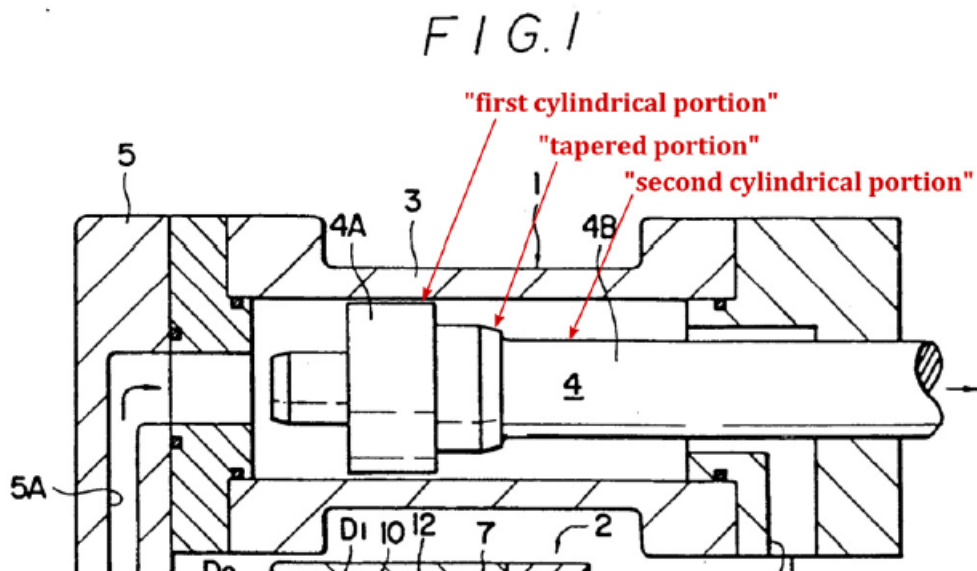
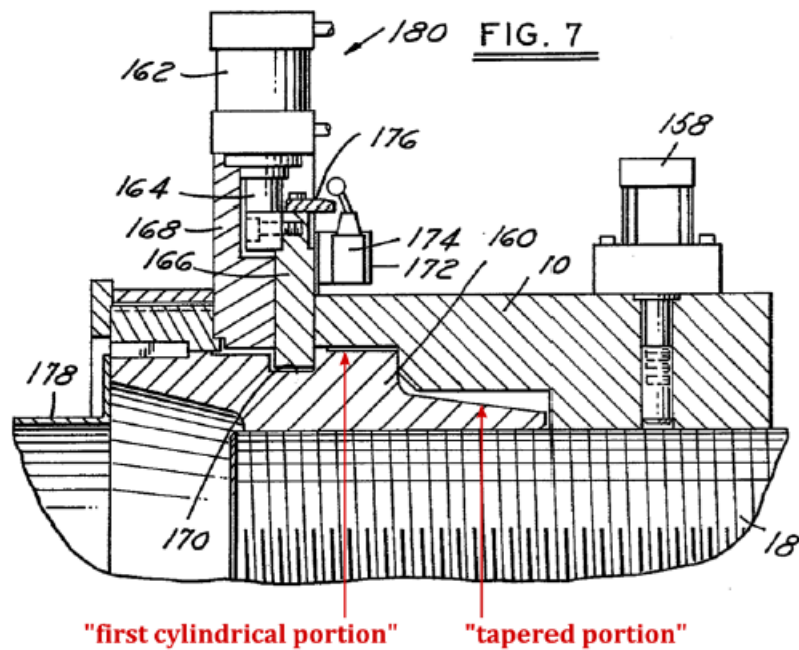
To argue for patentability of the proposed claim, Patent Owner’s Motion argues that Queré fails to disclose a coupling sleeve that includes a tapered portion that extends between and connects first and second cylindrical portions. Mot. to Amend 2-3 (citing Ex. 2013 ¶ 8). Petitioner, in response, argues that claims 29 and 30 are obvious over a combination of Queré and one of U.S. Patent No. 2,916,768 (Ex. 1014; “Queré II”), U.S.

Patent No. 4,285,384 (Ex. 1015; “Wunder”), and U.S. Patent No. 5,061,175 (Ex. 1016, “Iwamoto”). Opp. Mot. to Amend 2-5.

Petitioner points to Figure 2 of Queré II as disclosing sleeve 8 having a first cylindrical portion and a tapered portion extending from that portion to a smaller diameter end portion. *Id.* In support of this assertion, Petitioner’s declarant, Mr. Link, testifies that “Queré II discloses an injection molding machine very similar to that disclosed in Queré and includes” (Ex. 1019 ¶ 6) the tapering limitation, pointing to an annotated version of Figure 2 of Queré II, reproduced below.



Annotated Figure 2, above, points to a portion of sleeve 8 as meeting the tapering limitation. Ex. 1019 ¶¶ 5-6. Mr. Link also testifies that a tapered transition portion on the outer surface of a sleeve is disclosed in Figure 7 of Wunder and Figure 1 of Iwamoto, both reproduced below.



Annotated Figures 7 and 1, above, each point to a portion of a sleeve as including the tapering limitation. *Id.* at ¶¶ 7-8. In addition, Mr. Link testifies that “a person of ordinary skill in the art reading the ’695 patent would understand that the ’695 patent teaches that the tapered shape of the transitional portion 59a is not critical to the claimed device and [is] merely a

matter of design choice.” *Id.* at ¶ 9. Mr. Link adds that “the shape chosen for the corresponding transitional portion 59a of piston 44a also is not critical and could be any number of different shapes without affecting the piston’s function.” *Id.* at ¶ 10.

Patent Owner argues in reply that Petitioner does not provide a rationale for combining Queré II, Wunder, or Iwamoto with Queré. Reply Mot. to Amend 4-5. Patent Owner also argues that Petitioner improperly picks and chooses the added elements from the secondary references even though the structures perform a different function than the claimed securing means. *Id.* at 4.

We are not persuaded, by either of Patent Owner’s arguments, that the injection molding machine of the proposed claim is patentable under 35 U.S.C. § 103. We credit Mr. Link’s testimony that a person of ordinary skill in the art would have found it an obvious design choice to substitute the tapered shape disclosed in Queré II, Wunder, or Iwamoto between the cylindrical portions of coupling sleeve 8 of Queré. Ex. 1019 ¶ 9. We also credit Mr. Link’s testimony that such substitution would not affect the machine’s function. *Id.* at ¶ 10. Patent Owner does not assert that this substitution would achieve any novel or unexpected results. Nor does Patent Owner point to any persuasive evidence that a person of ordinary skill would have been discouraged from making such a substitution. Thus, we are persuaded that modifying Queré as disclosed in Queré II, Wunder, or Iwamoto to achieve the tapering limitation would be an obvious design choice within the abilities of a person of ordinary skill. *See KSR*, 550 U.S. at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Thus, we are not persuaded that proposed claims 18-34 are patentable over a combination of Queré and one of Queré II, Wunder, or Iwamoto.

III.CONCLUSION

Petitioner has shown, by a preponderance of the evidence, that the challenged claims are unpatentable based on the following grounds:

(1) claims 1-11 and 14 are anticipated by Queré; (2) claims 1-4 and 14-17 are anticipated by Arend; (3) claims 11-13 are obvious over Arend and Queré; (4) claim 13 is obvious over Arend, Queré, and Kushibe; (5) claims 1, 2, and 14-17 are anticipated by Stüdli; and (6) claims 11-13 are obvious over Stüdli and Queré.

Patent Owner has not shown that its proposed substitute claims 18-34 are patentable over the prior art.

Accordingly, it is

ORDERED that claims 1-17 of the '695 patent are determined to be *unpatentable*;

FURTHER ORDERED that Patent Owner's Motion to Amend Claims is *denied*;

FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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Patent 5,624,695

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