

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NELSON PRODUCTS, INC.,
Petitioner,

v.

BAL SEAL ENGINEERING, INC.,
Patent Owner.

Case IPR2014-00572
Patent 8,297,662 B2

Before CHRISTOPHER L. CRUMBLY, KRISTINA M. KALAN, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Nelson Products, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–16 and 19 of U.S. Patent No. 8,297,662 B2 (Ex. 1001, “the ’662 patent”). Paper 7 (“Pet.”). Bal Seal Engineering, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). We instituted trial on Petitioner’s asserted ground that claims 1–16 and 19 are unpatentable. Paper 10 (“Dec.”).

During trial, Patent Owner filed a Patent Owner Response (Paper 17, “PO Resp.”), which was accompanied by Declarations from Pete Balsells (Ex. 2006), Daniel Poon (Ex. 2007), and J. Michael McCarthy, Ph.D. (Ex. 2008). Petitioner filed a Reply to the Patent Owner Response. Papers 30, 31 (“Pet. Reply”). An oral hearing was held on May 27, 2015. A transcript of the hearing has been entered into the record. Paper 54 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. We determine that Petitioner has shown by a preponderance of the evidence that claims 1–16 and 19 of the ’662 patent are *unpatentable*. Petitioner’s Motion to Exclude Evidence (Paper 40) is *denied*. Patent Owner’s Motion to Exclude Evidence (Paper 38) is *dismissed*.

B. Related Proceedings

The parties indicate that the ’662 patent is involved in the following proceeding: *Bal Seal Engineering, Inc., v. Nelson Products, Inc.*, No. 8:13-cv-01880-JLS-RNB (C.D. Cal.) (“the district court case”). Pet. 4; Paper 5, Related Matters, 2.

C. The '662 Patent

The '662 patent, titled “Method for Controlling Connect and Disconnect Forces of a Connector,” issued on October 30, 2012. The '662 patent relates to “a connector that requires low force to connect and high force to disconnect.” Ex. 1001, 1:19–21. Figure 1 is reproduced below:

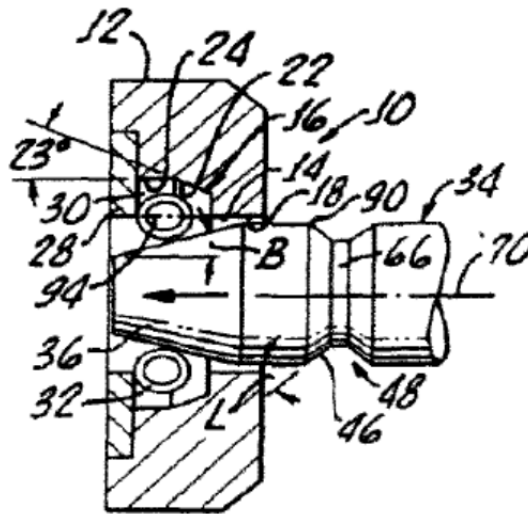


Figure 1 depicts one embodiment of the claimed connector. *Id.* at 2:48–49. The connector shown in Figure 1 includes “a housing with a bore and groove therein, a retainer for defining a spring cavity, a circular radial canted coil spring disposed in the cavity and a pin having a tapered end with a body diameter sized for sliding engagement with the bore inside surface.” *Id.* at 2:49–53. Specifically, Figure 1 shows connector 10, including housing 12 having bore 14, with groove 16 disposed on inside surface 18. *Id.* at 3:33–35. Groove 16 “establishes a release angle, or surface, 22 between a housing groove bottom 24 and the bore inside surface 18.” *Id.* at 3:35–37. Pin 34 includes circumferential pin groove 48 having load angle, or surface, 46. *Id.* at 3:44–45.

D. Illustrative Claim

Of the challenged claims, claims 1, 10, and 19 are independent. Claims 2–9 depend, directly or indirectly, from claim 1, and claims 11–16 depend, directly or indirectly, from claim 10. Claim 1 is reproduced below:

1. A connector having an insertion force that differs from a disconnection force comprising:

a pin comprising an elongated body defining a pin longitudinal axis, a pin insertion end comprising a tapered surface relative to the pin longitudinal axis, and a pin groove disposed about said elongated body, said pin groove comprising two tapered surfaces that converge in a direction of the pin longitudinal axis;

a housing comprising a housing bore having the pin disposed, at least in part, therein by moving the pin in a first direction relative to the housing to latch the pin to the housing; said housing bore comprising a lengthwise housing axis, a housing groove disposed on an inside surface of said housing bore and comprising a groove bottom surface being generally parallel to the length-wise housing axis; said housing bore being structured to permit disconnection of the pin from the housing when moving the pin in a second direction relative to the housing, which is opposite the first direction;

a canted coil spring comprising a plurality of coils each comprising a major axis, a minor axis, and a wire diameter sized to cooperate with the pin groove and the housing groove to permit latching and unlatching located in the pin groove and the housing groove with the plurality of coils contacting both tapered surfaces of the pin groove;

wherein the tapered surface of the pin insertion end lifts the plurality of coils during insertion of the pin in the first direction into the housing bore, said movement in the first direction produces a connect force; and

wherein at least one of the two tapered surfaces of the pin groove abuts and lifts the plurality of coils during disconnection of the pin from the housing by moving the pin in the second direction, said movement in the second direction produces a disconnect force.

Ex. 1001, 7:6–40.

E. Asserted Grounds of Unpatentability

We instituted the instant *inter partes* review on the following grounds:

1. Whether claims 1–3, 5–11, 13–16, and 19 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Guertin (US Patent No. 5,433,247, issued July 18, 1995 (Ex. 1002));
2. Whether claims 4 and 12 are unpatentable under 35 U.S.C. § 103(a) as obvious over Guertin and Poon (US Patent Application Publication No. 2002/0122690 A1, published September 5, 2002 (Ex. 1005));
3. Whether claims 1–6, 8–14, and 19 are unpatentable under 35 U.S.C. § 102(e) as anticipated by Poon; and
4. Whether claims 7, 15, and 16 are unpatentable under 35 U.S.C. § 103(a) as obvious over Poon.

Dec. 18.

II. ANALYSIS

For the challenged claims, Petitioner must prove unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). We begin with a claim construction analysis, and then follow with specific analysis of the prior art.

A. Claim Construction

In an *inter partes* review, “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271, 1279–83 (Fed. Cir. 2015). In determining the broadest reasonable construction, we presume that claim terms carry their

ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Only those terms which are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). In the Decision to Institute, we determined that no term needed express interpretation. Dec. 6. Neither party has proposed additional claim constructions following the Decision to Institute. Therefore, we see no reason to change our initial position that no term in this case needs express interpretation.

B. Grounds Based Solely on Poon

i. Poon as Prior Art

Under 35 U.S.C. § 102(e),¹ a person shall be entitled to a patent unless “the invention was described in . . . an application for a patent, published under section 122(b), *by another* filed in the United States before the invention by the applicant for patent” (emphasis added). An application issued to the same inventive entity cannot be prior art under section 102(e). *See Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1355–56 (Fed. Cir. 2003); *In re Mathews*, 408 F.2d 1393, 1396 (CCPA 1969); *In re Facius*, 408 F.2d 1396, 1407 (CCPA 1969); *In re Land*, 368 F.2d 866, 878 (CCPA 1966). An applicant may overcome a reference by showing that the relevant disclosure is a description of the applicant’s own work. *In re*

¹ The application that issued as the ’662 patent was filed on April 16, 2012, and claims priority to an application filed on November 19, 2002. Ex. 1001, cover page. Accordingly, the versions of §§ 102 and 103 in effect before the Leahy-Smith America Invents Act (AIA) apply to the claims of the ’662 patent. *See* AIA, Public Law 112-29, § 3, 125 Stat. 288.

Costello, 717 F.2d 1346, 1349 (Fed. Cir. 1983). What is significant is not merely the differences in the listed inventors, but whether the portions of the reference relied on as prior art represent the work of a common inventive entity. See *In re DeBaun*, 687 F.2d 459, 462 (CCPA 1982). The issue is whether all the evidence, including the references, truly shows knowledge by another prior to the time appellants made their invention or whether it shows the contrary. See *Land*, 368 F.2d at 878.

Regarding the relative burdens of proof in this proceeding, it is an established concept that there are two distinct burdens of proof: a burden of persuasion and a burden of production. See *Dynamic Drinkware, LLC v Nat'l Graphics, Inc.*, No. 2015-1214, 2015 WL 5166366 at *2 (Fed. Cir. Sept. 4, 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)). As noted by the court:

The burden of persuasion “is the ultimate burden assigned to a party who must prove something to a specified degree of certainty,” such as by a preponderance of the evidence or by clear and convincing evidence. In an *inter partes* review, the burden of persuasion is on the petitioner to prove “unpatentability by a preponderance of the evidence,” 35 U.S.C. § 316(e), and that burden never shifts to the patentee.

A second and distinct burden, the burden of production, or the burden of going forward with evidence, is a shifting burden, “the allocation of which depends on where in the process of trial the issue arises.” The burden of production may entail “producing additional evidence and presenting persuasive argument based on new evidence or evidence already of record.”

Id. at *2–3 (citations omitted). Though *Dynamic Drinkware* concerned a question of which party bears the burden of proving that a patent is entitled to claim priority to an earlier application, the same reasoning applies to the

question of who must prove whether a reference is “by another.” Thus, Petitioner always bears the ultimate burden of persuasion, but Patent Owner bears the burden of production on the issue of whether the Poon reference is “by another.”

The ’662 patent names Peter J. Balsells as the sole inventor. The Poon reference (Ex. 1005) names Daniel Poon and Peter J. Balsells as joint inventors. The ’662 patent claims priority to a provisional application filed November 21, 2001. Poon claims priority to a provisional application filed March 5, 2001.

In our Decision to Institute, we determined that, at that stage of the proceeding, Patent Owner failed to show that the subject matter illustrated in Figures 11–20 of Poon was Mr. Balsells’s work alone, and thus, not § 102(e) prior art. Dec. 11–12. We left open the possibility that Patent Owner could introduce additional evidence at trial to support its argument that Poon is not § 102(e) prior art. *Id.* at 12. At trial, Patent Owner argues that Figures 11–20 of Poon, upon which Petitioner relies, are not “by another” and, therefore, are not prior art under 35 U.S.C. § 102(e).

Patent Owner presents evidence that “Mr. Balsells declares that he is the sole inventor of the subject matter illustrated in Figures 11–20 of the Poon reference.” PO Resp. 12 (citing Ex. 2006). Patent Owner also provides a Declaration executed by Mr. Poon, in which Mr. Poon declares “that he contributed to inventive subject matter with regard to Figures 1–10, but had nothing to do with the subject matter illustrated in Figures 11–20 of the Poon reference.” *Id.* (citing Ex. 2002).²

² At oral hearing, Patent Owner argued that Petitioner applied an incorrect “collaboration” standard to its analysis (citing *In re DeBaun*, 687 F.2d 459

Petitioner argues that Poon and Balsells are joint inventors of the Poon reference, and thus, the Poon reference is presumptively “by another.” Pet. Reply 1 (citing MPEP 2136.04(I)). Petitioner argues that “joint inventorship only requires a minimal amount of collaboration such as working under common direction or building on a relevant report.” *Id.* at 3 (citing 35 U.S.C. § 116; *Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co.*, 973 F.2d 911, 917 (Fed. Cir. 1992)). Specifically, Petitioner argues that Figures 11–20 of Poon are prior art because Mr. Poon and Mr. Balsells admit in their declarations and depositions that they collaborated together to produce the subject matter of Figures 11–20. *Id.* at 2–4 (citing Exhibits 1010–1012 as evidence of collaboration). Petitioner also argues that Figures 11–20 of Poon are prior art because Mr. Poon and Mr. Balsells admit in their depositions that Figures 11–20 contain contributions from both inventors. *Id.* at 4.

Petitioner presents the testimony of Mr. Poon, who states that he developed the “basic concept” of Figures 1–9, gave his work to Mr. Balsells, and interacted with Mr. Balsells to clarify and explain his work. *Id.* at 2–3 (citing Ex. 2002 ¶ 3). Mr. Poon states, for example, that he conceived of the basic concept of an axial spring with clearance around the axial spring, which structural elements are present in Figures 11 and 13. *Id.* at 4 (citing Ex. 1015, 139:9–140:12). Petitioner also presents the testimony of Mr. Balsells, who states that Mr. Poon’s work laid the foundation that served as a catalyst for Mr. Balsells’ improvements, and that Mr. Balsells “appended”

(CCPA 1982). This argument, however, was not raised in the Patent Owner Response. Accordingly, although we are cognizant of the cited case law, we do not consider arguments presented for the first time at oral hearing.

that, looking at the invention as a whole, “all of the inventions in the Poon reference are all by the combination of both Poon and Mr. Balsells.”

Tr. 34:18–20.

We are not persuaded that the subject matter of Figures 11–20 of the Poon reference are “by another.” Mr. Poon and Mr. Balsells were joint inventors under the standards highlighted by the court in *Kimberly-Clark*. They exhibited elements of joint behavior: they worked at the same company, under common direction, at the same physical location. Mr. Poon and Mr. Balsells exchanged notes and drafts leading to the final invention described in the Poon reference. The inventors worked on the same subject matter and made contributions to the inventive thought and to the final result. *Monsanto Co. v. Kamp*, 269 F.Supp. 818, 824 (D.D.C. 1967). The collaborative nature of the invention is apparent in the evidence presented by Petitioner, in which Mr. Poon and Mr. Balsells could not avoid acknowledging the elements of their common contributions to the invention claimed in the Poon reference.

To the extent that the burden of production shifted to Patent Owner, Patent Owner presented evidence in support of its arguments that Poon and Balsells were not joint inventors of the Poon reference. Weighing all the evidence before us, however, we are persuaded that the record as a whole supports Petitioner’s argument that Poon is prior art under 35 U.S.C. § 102(e).

ii. Anticipation and Obviousness Grounds Based on Poon

We instituted *inter partes* review to determine whether claims 1–6, 8–14, and 19 are unpatentable under 35 U.S.C. § 102(e) as anticipated by

Poon; and whether claims 7, 15, and 16 are unpatentable under 35 U.S.C. § 103(a) as obvious over Poon.

Poon discloses a “circular canted coil spring assembled in a housing groove and a shaft with a groove in which the spring is positioned in a manner such that when the shaft is moved axially against the housing the spring is compressed axially against the groove.” Ex. 1005 ¶ 5. The structure of the invention “results in a disconnect force which is greater than the connect force.” *Id.* at ¶ 9.

Petitioner refers to Poon’s Figure 13 to argue that Poon teaches detachable connector 150 having a housing with groove 154 with one or more tapered sidewalls 156, 158 extending from a groove bottom. Pet. 24–25. Petitioner further argues that pin/piston 162 having groove 154 with tapered surfaces 164, 166 can be inserted into the housing 152 until the spring 160 rests between housing groove 154 and the piston groove. *Id.* at 25. As reproduced below, Petitioner provides an annotated version of Poon’s Figure 13:

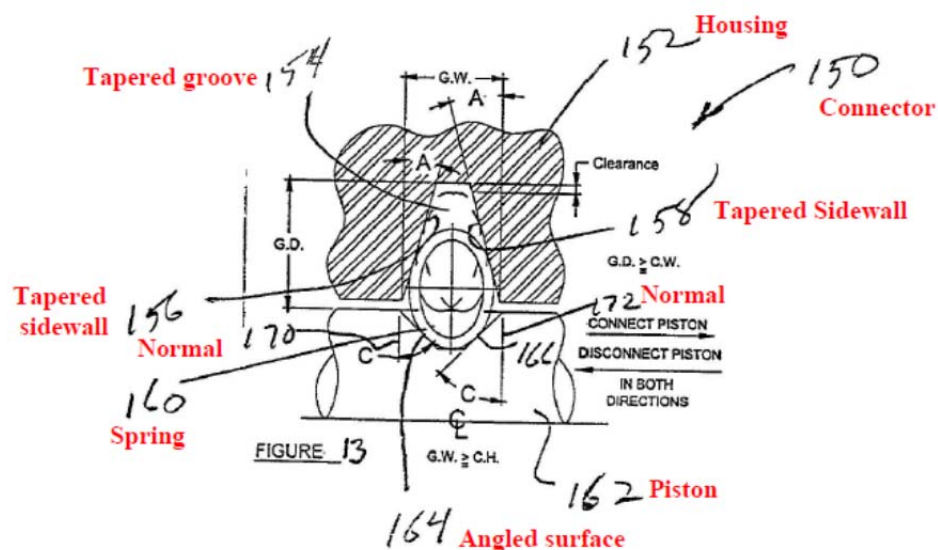


Figure 13 depicts an embodiment of Poon showing housing 152, groove 154, and angled sidewalls 156, 158. Ex. 1005 ¶ 68; Pet. 24. Petitioner argues that Poon discloses every element of claims 1 and 19, relying in whole or in part on the structure shown in Figure 13 in support of its arguments. Pet. 24–28, 29–32.

With respect to claim 10, Petitioner relies on Poon’s Figure 16 to disclose certain limitations such as the housing groove’s tapered surface and a sidewall extending therefrom. Pet. 34. Specifically, Petitioner points to left sidewall of groove 234, noting in its annotations that the left sidewall comprises a tapered sidewall and a perpendicular sidewall. Petitioner’s annotated Figure 16 is reproduced below:

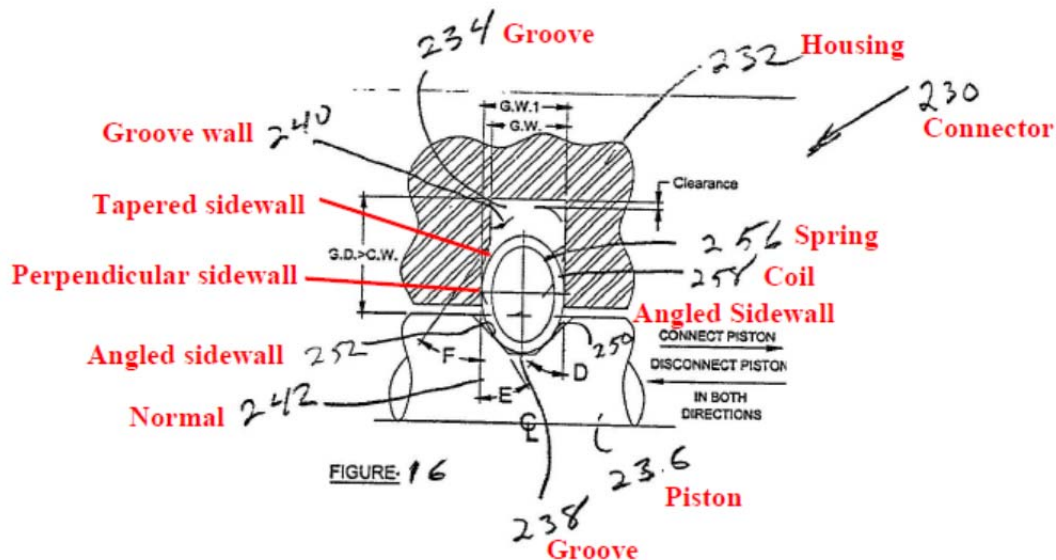


Figure 16 is “is a cross sectional view of yet another embodiment of the present invention in which the piston includes two contact retaining walls defining a tapered groove.” Ex. 1005 ¶ 39.

Petitioner also challenges claims 7, 15, and 16 as unpatentable under 35 U.S.C. § 103(a) over Poon in view of an obvious design choice to

combine the features of Figures 13 and 16 of Poon. Pet. 36–38. Petitioner argues that Figure 16 of Poon is an embodiment with a housing groove having a groove bottom surface, a tapered release surface, a side wall extending from the tapered release surface, and a side wall extending from the groove bottom surface. *Id.* at 37. As such, Petitioner argues that the embodiments found in claims 7, 15, and 16 merely combine known elements, such as the tapered surface extending from a groove bottom surface in Figure 13, and perpendicular sidewalls shown in Figure 16. *Id.* at 38. Patent Owner did not contest whether combining Poon’s embodiments would be a mere design choice. Poon discloses a wide range of designs for the housing groove, including designs containing and combining the various elements identified by Petitioner, which supports the argument that the elements could be combined as a matter of design choice.

Patent Owner argues, with respect to the anticipation and obviousness grounds based on Poon alone, that the subject matter of Poon’s Figures 13, 16, and 18 is not prior art to the ’662 patent, and thus, these two grounds must fail. PO Resp. 13. Patent Owner agreed that it has not made any substantive arguments on the point of whether Poon anticipates the challenged claims. Tr. 60:7–13. Patent Owner, however, did not expressly concede that Poon anticipates. *Id.* at 60:22–25.

Petitioner responds that Patent Owner “failed to present any arguments as to how the claims-at-issue differ from the Poon Reference.” Pet. Reply 6. Petitioner, referring back to its Petition, maintains that Figure 13 teaches every limitation of claims 1–6, 8–14, and 19, and that the combination of Figures 13 and 16 teach all the limitations of claims 7, 15, and 16. *Id.*

Upon review of the complete record, we find that Petitioner has established, by a preponderance of the evidence, that claims 1–6, 8–14, and 19 are unpatentable under 35 U.S.C. § 102(e) as anticipated by Poon; and that claims 7, 15, and 16 are unpatentable under 35 U.S.C. § 103(a) as obvious over Poon. We have reviewed the arguments presented in the Petition and the supporting evidence regarding the anticipation of claims 1–6, 8–14, and 19, and the obviousness of claims 7, 15, and 16, the substance of which was not disputed by Patent Owner in its Response. Patent Owner, in its Response, relies solely on its arguments and evidence concerning whether Poon is prior art, and relies on its conclusion that Poon is not prior art to argue that the anticipation and obviousness grounds based on Poon must fail. *See generally* PO Resp. In the Scheduling Order, we cautioned Patent Owner that any arguments for patentability not raised in the Response would be deemed waived. Paper 11, 3.

We find a preponderance of the evidence establishes that Poon expressly discloses each and every element of claims 1–6, 8–14, and 19, and that claims 7, 15, and 16 are obvious in view of Poon. We conclude that claims 1–6, 8–14, and 19 are unpatentable as anticipated by Poon, and that claims 7, 15, and 16 are unpatentable as obvious over Poon.

C. Anticipation by Guertin

We instituted *inter partes* review to determine whether claims 1–3, 5–11, 13–16, and 19 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Guertin; and whether claims 4 and 12 are unpatentable under 35 U.S.C. § 103(a) as obvious over Guertin and Poon.

Guertin discloses “breakaway couplings for use with a coaxial fuel supply and vapor recovery hose.” Ex. 1002, 1:7–8. Guertin’s Figure 1, depicted below, illustrates an exemplary embodiment.

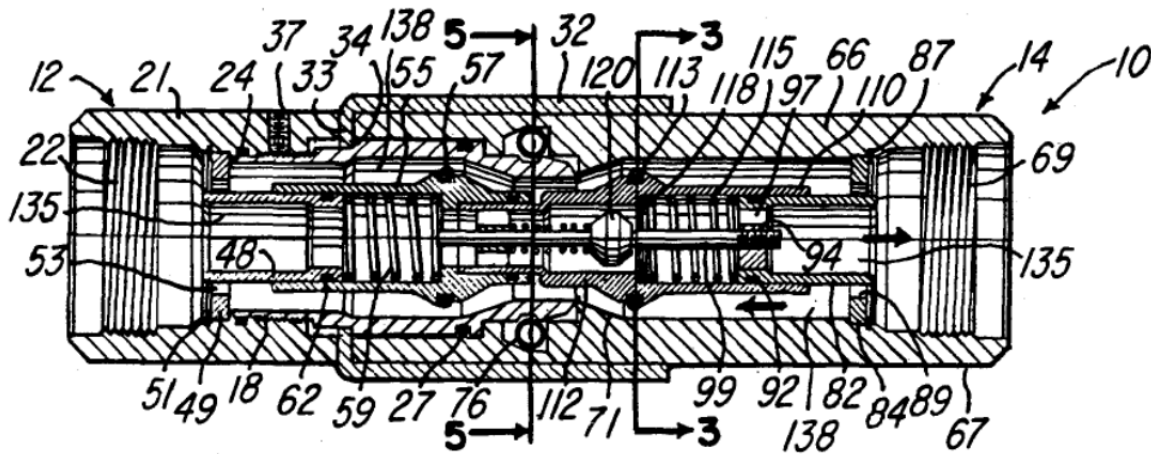
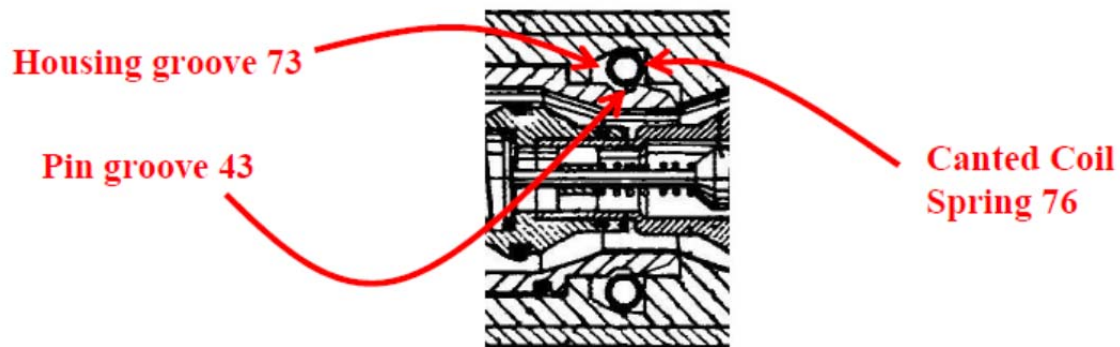


Figure 1 depicts an axial section of a coaxial breakaway coupling shown in its coupled position. *Id.* at 2:56–58. This embodiment includes coaxial breakaway coupling 10 with interfitting sections 12 and 14. *Id.* at 3:6–7. Annular canted coil spring 76 is confined within groove 73 and is expanded slightly by end portion 42 of valve body 16 until spring 76 snaps into external groove 43 within valve body 16 when coupling sections 12 and 14 are pressed axially together to a connected or coupled position. *Id.* at 3:61–68.

Guertin’s canted coil spring 76 and the “tapered surfaces of the grooves 73 and 43 are selected to provide for separation of the coupling

sections 12 and 14 with a predetermined tension force and the recoupling of the sections with a substantially lower axial or compression force.” *Id.* at 4:1–5. Petitioner provides an annotated detail of Guertin’s Figure 1, reproduced below, illustrating elements 43, 73, and 76:



Annotated Figure 1 depicts a segment of an axial section of a coaxial breakaway coupling shown in its coupled position. Pet. 8.

Figure 6 of Guertin is depicted below, for comparison:

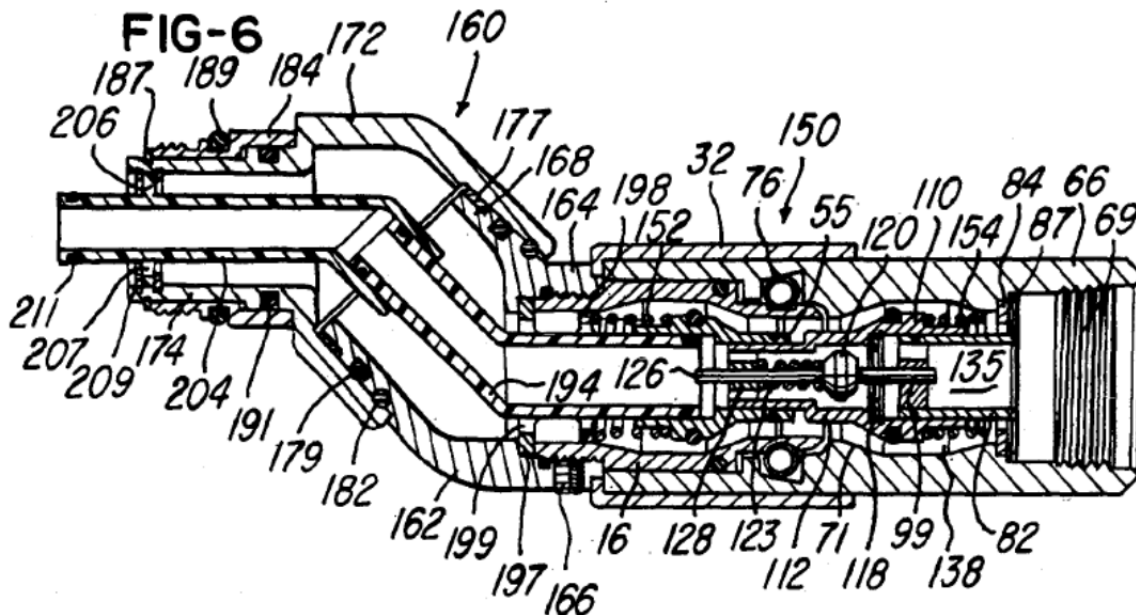


Figure 6 is “an axial section of a modified coaxial breakaway coupling similar to the coupling shown in FIG. 1 and integrated with a swivel

coupling in accordance with another embodiment of the invention.”

Ex. 1002, 2:67–3:2. Guertin states that in Figure 6, the “coaxial breakaway coupling 150 is constructed substantially the same as the coupling 10 except with a shorter length. Accordingly, the same reference numbers are used to identify the same corresponding parts or components.” *Id.* at 5:11–15.

Details of Figure 1 and Figure 6 highlighted by the parties are shown below.

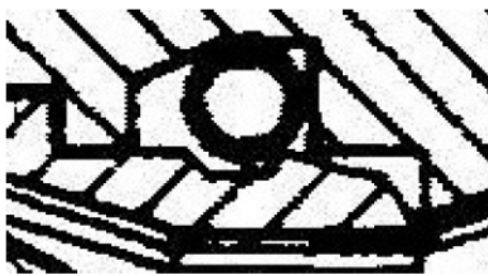


FIG-1



FIG-6

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). “[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed, and thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

Regarding the Figures of Guertin, Patent Owner argues, first, that Guertin's Figure 1 embodiment does not show all the limitations as arranged in the independent claims. PO Resp. 22. Patent Owner argues, second, that Guertin's Figure 6 embodiment does not show all the limitations as arranged in the independent claims. *Id.* at 26. Patent Owner argues: "If anything, the clearer figure of Guertin, Figure 1, should be used and not the smudged and unclear Figure 6." *Id.* at 30. Finally, Patent Owner argues that the couplers depicted in Guertin's Figure 1 and Figure 6 are different and cannot be combined to anticipate any claims. *Id.* at 31. In sum, Patent Owner argues that Figure 1 fails to show several claimed features; Figure 6 is blurred, smudged, unclear, and fails to show with particularity all the claimed structural features and how they are put together, and thus, "neither the Figure 1 embodiment nor the Figure 6 embodiment teaches all of the limitations of any of independent claims 1, 10 and 19." *Id.* at 34, 36.

Patent Owner argues that, although an enabling picture may be used to reject claims, the picture must show all the claimed structural features and how they are put together. PO Resp. 17 (citing MPEP §2121.04; *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928)). Patent Owner also argues that drawings and pictures can anticipate claims if they clearly show the structure claimed, but that "Guertin's drawings clearly show features that depart from the claimed connectors and/or are blurred and smeared by ink or by poor reproduction, among other things, and therefore do not clearly show all of the claimed limitations." *Id.* at 18 (citing MPEP § 2125).

Regarding the specification of Guertin, Patent Owner states that Guertin is "completely silent regarding the geometry of the external groove 43 and internal grooves 73 other than a passing statement that they have

“tapered surfaces”, and does not disclose how the two grooves 43, 73 allow separation of the two couplings 12, 14.” *Id.* at 21. Patent Owner notes that Guertin dedicates “only a single paragraph to describing the coupling structure that holds sections 12 and 14 together.” *Id.* at 20.

Petitioner argues: “The detailed description in Guertin explicitly establishes a direct link between coupling 10 (in Figure 1) and coupling 150 (in Figure 6): ‘Referring to FIG. 6, a coaxial breakway *coupling 150 is constructed substantially the same as the coupling 10 except with a shorter length.*’” Pet. Reply 7 (quoting Ex. 1002, 5:11–13). Petitioner takes issue with the case law cited by Patent Owner in support of its position, noting that in this case, unlike in *Net MoneyIn*, there are no separate, independently functioning protocols. *Id.* at 8. Petitioner relies on the Declaration of David Imler to support its assertion that coupling 10 and coupling 150 have identical geometries. *Id.* at 7–8, 10 (citing Ex. 1017 ¶¶ 26–27). Petitioner urges the Board to “look to the commercial versions of couplings 10 and 150 to identify their inherent features.” *Id.* at 10 (citing *In re Baxter*, 656 F.2d 679 (CCPA 1981)). Petitioner asks us to credit the testimony of its experts Imler, Cook, and Pratt (Exs. 1017, 1018, 1019) but not the testimony of Mr. Poon (Exs. 1015, 2002, 2007), who Petitioner argues only focused on Guertin’s Figure 6 “on its face,” or the testimony of Mr. McCarthy (Ex. 2008). *Id.* at 11–15.

The Guertin specification states that the coupling 150 in Figure 6 is “constructed substantially the same as the coupling 10 [in Figure 1] except with a shorter length. Accordingly, the same reference numbers are used to identify the same corresponding parts or components.” Ex. 1002, 5:12–15. The language “substantially the same” does not address, specifically, what

elements are identical between Figure 1 and Figure 6. The language “except with a shorter length,” however, indicates that the portions of Figure 1 that are not concerned with making the length shorter remain unchanged in Figure 6. Guertin discusses specifically which structures of Figure 1 are replaced by different structures in Figure 6 to obtain the shorter length; these do not include pin groove 43 or housing groove 73. *Id.* at 5:15–21.

Guertin’s specification further states that “spring 76 snaps into the external groove 43 within the valve body 16, as shown in FIG. 1, when the coupling sections 12 and 14 are pressed axially together to a connected or coupled position.” Ex. 1002, 3:64–68. The “snaps into” language indicates that spring 76 is seated in pin groove 43. Patent Owner does not argue persuasively that there is any other interpretation to this language, other than “I guess you could say, it snaps partially in.” Tr. 47:14–15. Thus, Guertin’s specification alone discloses that spring 76 snaps into pin groove 43, which has tapered surfaces to provide for separation of the coupling sections 12 and 14 with a predetermined tension force and the recoupling of the sections with a substantially lower axial or compression force.

Guertin’s Figure 1 is clear, but does not show the coil seated in the pin groove. Figure 1 shows that the pin groove has tapered sidewalls. Figure 2, in which pin groove 43 is called out, also shows that pin groove 43 has tapered sidewalls. Figure 6 is not as clear as Figure 1 in its depiction of the sidewalls of pin groove 43, but pin groove 43 also is partially obscured by spring 76. Figure 1 is in a different position (fully engaged) than Figure 6 (not completely engaged), which Patent Owner agrees is the case. PO Resp. 32. Petitioner’s expert Mr. Imler further testified that, based on his experience in manufacturing the breakaway couplings described in Guertin,

any variations among Figure 1, 2, and 6 “are the product of inaccuracies in the drawings.” Imler Decl. ¶ 27 (cited in Pet. Reply 7–8); see *In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991) (“[E]xtrinsic evidence may be considered when it is used to explain, but not expand, the meaning of a reference.”).

We are not persuaded by Patent Owner’s arguments. Based on the current record, we do not see anything in the disclosure of Guertin, nor does Patent Owner point to anything in the disclosure of Guertin, that confirms or demonstrates that the pin grooves of Figure 1 and Figure 6 are separate and unrelated embodiments. Nor is there any indication in Guertin that, apart from the shorter length and the swivel connection, that Figures 1 and 6 describe embodiments that are unrelated to each other. Rather, as discussed above, Figures 1 and 6 describe the structure of the canted coil spring system portion of Guertin, with features common to all of the embodiments disclosed in Guertin. Based on the current record, Figures 1 and 6 are more reasonably understood as describing a single embodiment of the canted coil spring system portion of Guertin. See *Groupon, Inc., v. Blue Calypso, LLC*, Case CBM2013-00034, slip. op. at 38–39 (PTAB Dec. 17, 2014) (Paper 45) (distinguishing *Net MoneyIN*, 545 F.3d 1359, which relied on *In re Arkley*, 455 F.2d 586 (CCPA 1972)); see also *Wm. Wrigley Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d 1356, 1361 (Fed. Cir. 2012) (distinguishing *Net MoneyIN*).

Additionally, the language of claim 1 and claim 10 only requires that the spring be “sized to cooperate with the pin groove and the housing groove to permit latching and unlatching located in the pin groove and the housing groove with the plurality of coils contacting both tapered surfaces of the pin

groove.” Claims 1 and 10 do not say when the plurality of coils need to be contacting both tapered surfaces of the pin groove. The contact of coils with both tapered surfaces of the pin groove is indicated by the “snaps into” language, and is shown in Figure 6. Claim 19 states that the spring is “sized to cooperate with the pin groove and the housing groove to permit latching and unlatching located in both the pin groove and the housing groove with the plurality of coils simultaneously contacting the two tapered surfaces of the pin groove and the tapered surface of the housing groove.” This too is indicated by the “snaps into” language and Figure 6. As Guertin’s Figure 6 depiction shows the plurality of coils contacting both tapered surfaces of the pin groove at a different stage in the process, there are not necessarily inconsistencies within Guertin’s disclosure relating to the plurality of coils contacting both tapered surfaces of the pin groove. We further credit Mr. Imler’s testimony that a person of ordinary skill in the art would “understand from Guertin that the pin groove in Figure 6 has two tapered surfaces,” and “that Figure 6 depicts a canted coil spring in contact with the two tapered surfaces of the pin groove.” Ex. 1017 ¶ 38.

We determine that Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–3, 5–11, 13–16, and 19 are anticipated by Guertin.

D. Obviousness over Guertin and Poon

Regarding its argument that claims 4 and 12 as unpatentable under 35 U.S.C. § 103 over Guertin in view of Poon, Petitioner states that “Guertin does not explicitly disclose a canted coil spring spaced from the tapered surface or housing groove.” Pet. 23. Petitioner argues, however, that it would have been obvious “as a mere design choice to increase the depth of

groove 73 or decrease the diameter of the canted coil spring 76 in Guertin to provide a space between the canted coil spring and tapered surface or bottom surface of a housing groove in view of Poon.” *Id.* Patent Owner did not contest whether combining Guertin’s and Poon’s teachings would be a mere design choice. The shape of Guertin’s housing groove is similar to the shape of certain of Poon’s housing grooves, such as those shown in Figures 1 and 12. Poon additionally discloses a wide range of designs for the housing groove, which supports the argument that the size of the elements identified by Petitioner could be increased or decreased as a matter of design choice. Patent Owner states that “since the present proceeding concerns only the law of anticipation, Patent Owner directs the present discussion to arguments showing that Guertin cannot anticipate the claims.” PO Resp. 36 n.1. After review of the record, we are persuaded that Petitioner has shown that claims 4 and 12 would have been obvious over Guertin and Poon.

E. Motions to Exclude

i. Petitioner’s Motion to Exclude

Petitioner filed a Motion to Exclude (Paper 40, “Pet. Mot. to Excl.”), to which Patent Owner responded (Paper 45, “Resp. to Pet. Mot. to Excl.”) and to which Petitioner filed a Reply (Paper 48, “Reply on Pet. Mot. to Excl.”). Petitioner’s Motion seeks to exclude Exhibits 2018 and 2019, which are photographs of couplers shown to expert David Imler during his deposition. Pet. Mot. to Excl. 2. Petitioner objects to Exhibits 2018 and 2019 because Patent Owner “failed to lay a foundation for the couplers, failed to authenticate the couplers, and failed to properly serve the couplers.” *Id.* Petitioner also alleges that the Exhibits 2018 and 2019 should be excluded as outside the proper scope of Mr. Imler’s cross-examination. *Id.*

at 3. Petitioner's Motion also seeks to exclude Exhibit 2020, which is identified as Catlow Assembly Drawing No. C1000S, because "(1) the Catlow Assembly Drawing exceeds the scope of the cross-examination, (2) the Catlow Assembly Drawing is irrelevant, and (3) the Catlow Assembly Drawing cannot be authenticated." *Id.* at 5.

Patent Owner argues that Exhibit 2020 is directly within the scope of Mr. Imler's Declaration because it shows his testimony to be untrue, and relevant because it shows a main basis for Mr. Imler's opinion was untrue; Patent Owner further argues Mr. Imler is a person having direct knowledge of Catlow's products and drawings, and confirmed that Exhibit 2020 depicted Catlow's breakaway couplings. Resp. to Pet. Mot. to Excl. 2–7. With respect to Exhibits 2018 and 2019, Patent Owner argues that (1) Mr. Imler is a person having direct knowledge of Catlow's products and drawings, and confirmed that Exhibits 2018 and 2019 were Catlow's breakaway couplings; (2) Exhibits 2018 and 2019 are directly within the scope of Mr. Imler's Declaration; and (3) Patent Owner sufficiently served the couplers depicted in Exhibits 2018 and 2019 to opposing counsel, and opposing counsel was able to handle and inspect the couplers. *Id.* at 9–15.

The moving party has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). We are unpersuaded that the Exhibits at issue should be excluded. Petitioner's objections to Exhibits 2018, 2019, and 2020 are directed more to the weight that the information disclosed therein should be afforded, than to its admissibility. It is within our discretion to assign the appropriate weight to be accorded to the information in Exhibits 2018, 2019, and 2020. The Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine

and assign appropriate weight to evidence presented. *Gnosis S.P.A. v. S. Ala. Med. Sci. Found.*, IPR2013-00118, slip op. at 43 (PTAB June 20, 2014) (Paper 64); *see also Donnelly Garment Co. v. NLRB*, 123 F.2d 215, 224 (8th Cir. 1941) (“One who is capable of ruling accurately upon the admissibility of evidence is equally capable of sifting it accurately after it has been received.”). We, thus, decline to exclude Exhibits 2018, 2019, and 2020, and deny Petitioner’s Motion.

ii. *Patent Owner’s Motion to Exclude*

Patent Owner filed a Motion to Exclude (Paper 38, “PO Mot. to Excl.”), to which Petitioner responded (Paper 44, “Resp. to PO Mot. to Excl.”) and to which Patent Owner filed a Reply (Paper 45, “Reply on PO Mot. to Excl.”). Patent Owner’s Motion seeks to exclude Exhibit 1016 (U.S. Patent No. 5,570,719 to Richards) and the portions of Paper 31, Exhibit 1014, Exhibit 1017, Exhibit 1018, and Exhibit 1019 that refer to or discuss Exhibit 1016. PO Mot. to Excl. 1.

Petitioner argues that Patent Owner’s Motion is an improper sur-reply. Resp. to PO Mot. to Excl. 1. Petitioner further argues that Exhibit 1016 was properly cited as extrinsic evidence for anticipatory purposes. *Id.* at 2.

We have concluded that the challenged claims are unpatentable without relying upon Exhibit 1016 or on any portions of Exhibit 1016 in the papers and Exhibits indicated by Patent Owner. We, therefore, need not decide the Motion to Exclude as to this Exhibit; it is dismissed as moot.

III. SUMMARY

Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–3, 5–11, 13–16, and 19 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Guertin; that claims 4 and 12 are unpatentable under

35 U.S.C. § 103(a) as obvious over Guertin and Poon; that claims 1–6, 8–14, and 19 are unpatentable under 35 U.S.C. § 102(e) as anticipated by Poon; and that claims 7, 15, and 16 are unpatentable under 35 U.S.C. § 103(a) as obvious over Poon. This is a Final Written Decision of the Board under 35 U.S.C. § 318(a).

IV. ORDER

For the reasons given, it is

ORDERED that Petitioner’s Motion to Exclude is *denied*;

FURTHER ORDERED that Patent Owner’s Motion to Exclude is *dismissed*;

FURTHER ORDERED that claims 1–16 and 19 of the ’662 patent are *unpatentable*; and

FURTHER ORDERED that parties to the proceeding seeking judicial review of this Final Written Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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Patent 8,297,662 B2

FOR PETITIONER:

John van loben Sels
Joseph Andelin
Mei Tsang
FISH & TSANG LLP
jvanlobensels@fishiplaw.com
jandelin@fishiplaw.com
mtsang@fishiplaw.com

FOR PATENT OWNER:

Tom H. Dao
Glen L. Nuttall
KLEIN, O'NEILL & SINGH, LLP
tdao@koslaw.com
gnuttall@koslaw.com