

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NESTLÉ HEALTHCARE NUTRITION, INC.,
Petitioner,

v.

STEUBEN FOODS, INC.,
Patent Owner.

Case IPR2015-00094
Patent 6,209,591

Before PHILLIP J. KAUFFMAN, JAMES P. CALVE, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. OVERVIEW

Petitioner, Nestlé Healthcare Nutrition, Inc., filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1, 2, 16-18, 26, and 27 (the “challenged claims”) of U.S. Patent No. 6,209,591 B1¹ (Ex. 1001, “the ’591 patent”). Patent Owner, Stueben Foods, Inc., filed a timely Preliminary Response (Paper 8, “Prelim. Resp.”). The Board denied institution of an *inter partes* review. Paper 14 (“Dec.”). Petitioner filed a Request for Rehearing asking that the Board reconsider its decision not to institute with regard to one of the two asserted grounds of unpatentability. Paper 16 (“Req. Reh’g”). Specifically, Petitioner asks that the Board reconsider our Decision and institute on obviousness over Ondrus², Hayashi³, Bev Tech⁴, Takei⁵, and David⁶. *Id.* at 1. For the reasons that follow, this request is denied.

II. STANDARD

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may

¹ *See also* Reexamination certificate issued Nov. 25, 2013.

² Ex. 1006, U.S. Patent No. 5,746,239 (May 5, 1998).

³ Ex. 1007, Mitsuo Hayashi, *New Technology for CAF Aseptic Filling*, Beverage Japan, No. 193 at 73–75 (Jan. 1998). Also at Exhibit 1014, with translation affidavit.

⁴ Ex. 1009, Luigi Baiocchi, *Latest Innovations In Aseptic Filling*, Int’l Soc. of Beverage Technologists, Prcdgs. of 44th Ann. Conf. “Bev Tech 97,” Ft. Lauderdale, FL, Apr. 28-30, 1997, 123–130.

⁵ Ex. 1010, Japanese Pat. App. Publ. No. H4-154501 (with translation) (May 27, 1992).

⁶ Ex. 1005, J.R.D. David et al., *Aseptic Processing and Packaging of Food: A Food Industry Perspective*, chs. 6, 8 (1996).

be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). The party challenging the decision has the burden of showing a decision should be modified, and the request for rehearing must specifically identify all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. ANALYSIS

Petitioner's arguments are predominately based on the assertion that the Decision misconstrued the challenged claims. We begin our analysis with claim construction, and then turn to the related arguments.

A. Claim Construction

Independent claim 1 is illustrative and follows:

1. Apparatus for aseptically filling a series of bottles comprising:

a valve for controlling a flow of low-acid food product at a rate sufficient to dispense the food product at a rate of more than 350 bottle per minute in a single production line;

a first sterile region surrounding a region where the product exits the valve;

a continuously sterilized second sterile region positioned proximate said first sterile region whereby said second sterile region is continuously sterilized during operation;

a valve activation mechanism for controlling the opening or closing of the valve by extending a portion of the valve from the continuously sterilized second sterile region into the first sterile region and by retracting the portion of the valve from the first sterile region back into the continuously sterilized second sterile region.

Petitioner disagrees with the claim construction in the Decision. Req. Reh’g. 1–14. According to Petitioner, relying upon an incorrect claim construction led the Board to incorrectly apply the prior art (Ondrus and Hayashi) to the claims at issue, and to improperly evaluate Petitioner’s rationale for the ground of unpatentability. *Id.*

Specifically, Petitioner contends that the preamble of the independent claims is entitled to no patentable weight.⁷ *Id.* at 6–7 (citing *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014)). Petitioner contends that the independent claims do not require a routing valve or a filling valve; rather, the claims require a valve able to control the flow of food product anywhere in the food processing plant. *Id.* at 4–13. In short, Petitioner characterizes the claimed subject matter as directed only to a valve that controls the flow of food product.

We disagree with Petitioner’s interpretation that the claims are directed only to a valve. As stated in the Decision, “[t]he independent claims are not directed to a valve. Rather, the independent claims are directed to an apparatus (claims 1 and 26) or method (claim 16) for aseptically filling a series of bottles at a specified rate (more than 350 bottles per minute).” Dec. 10.

For two primary reasons, Petitioner has not persuaded us that our claim construction was in error. Interpreting claim 1 to require a valve that can control the flow of food product anywhere in the food processing plant (Req. Reh’g 5) is inconsistent with the language of claim 1 interpreted in light of the ’591 patent specification. Claims 1, 16, and 26 recite “a first sterile region surrounding a

⁷ Of the challenged claims, claims 1, 16, and 26 are independent. We note that claim 16 is a method rather than an apparatus claim, but is similar to independent claims 1 and 26 in other respects.

region where the product exits the valve,” “a continuously sterilized second sterile region positioned proximate said first sterile region,” and “a valve activation mechanism for controlling the opening or closing of the valve by extending a portion of the valve from the continuously sterilized second sterile region into the first sterile region and by retracting the portion of the valve from the first sterile region back into the continuously sterilized second sterile region.”⁸

The '591 patent specification makes clear that the claimed sterile regions *and valve* are located in product dispensing and bottle filler apparatus 50. The '591 patent discloses inventive methods and systems for providing container product filling in an aseptic processing apparatus. Ex. 1001, 1:9–13, 2:32–46. To address the problem of portion 264A of valve stem 256A of filling nozzles 190A, 190B moving through non-sterile region 268 prior to entering sterile region 260 where product is dispensed into containers (*see* Figs. 23, 24), the '591 patent adds second sterile region 270A to ensure that contaminants from non-sterile region 268 are not introduced by valve stem 256A into first sterile region 260 when food product is dispensed into bottles 12 from filling nozzles 190A, 190B. *Id.* at 13:8–14:63; Figs. 23–26.

The Petition did not identify any disclosure in the '591 patent to indicate that the claimed valve was part of a product routing apparatus. To the contrary, the Petition asserted that the “valve for controlling a flow of low-acid food product at a rate sufficient to dispense the food product at a rate of more than 350 bottles per minute in a single product line” includes “a plurality of valves” because the filling

⁸ Claim 16 recites method steps of “surrounding a region where the food product exits the valve with a sterile region,” “providing a continuously sterilized second sterile region positioned proximate said first sterile region,” and “controlling the opening or closing of the valve by extending a portion of the valve from the continuously sterilized second sterile region into the first sterile region.”

apparatus uses twelve valves, one for each filling nozzle in a twelve-bottle matrix. Pet. 11. Thus, the Petition took the position that the claimed valve dispensed product into bottles. *See id.* To that end, Petitioner argued that the routing valves of Ondrus could be used in the bottle filling apparatus of Hayashi. *Id.* at 21–22. However, as discussed below, the Decision explained that this contention was not supported by David or the Heldman Declaration. Dec. 8.

Further, the preamble of the independent claims is entitled to patentable weight. *See Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 952 (Fed. Cir. 2006) (“it is not unusual for a court to treat preamble language as limiting”). The preamble of claim 1 recites an “[a]pparatus for aseptically filling a series of bottles,” and the body of the claim recites that the valve of that apparatus controls “a flow of low-acid food product at a rate sufficient to dispense the food product at a rate of more than 350 bottle per minute in a single production line.” In doing so, the claim utilizes both the preamble and the body to define the subject matter as an apparatus that includes a valve that is part of a filling method or apparatus that permits filling of a series of bottles at the specified rate. *See Bell Commc'ns Research, Inc. v. Vitalink Commc'ns Corp.*, 55 F.3d 615, 620 (Fed.Cir.1995) (giving weight to a preamble where the subject matter was defined using both the preamble and the body of the claim). The preambles clarify that the claimed valve is part of a filling apparatus or method that fills a series of bottles. As explained in our Decision, the '591 patent describes a conveying apparatus that delivers bottles to a filler apparatus, and moves those bottles through the various operations of the filler so that a series of bottles may be filled. *See* Dec. 4–5.

Having reviewed the entire patent, we determine that the preamble of claim 1 is necessary to give meaning to the claim by making clear that the valve and other claimed elements are part of a food dispensing apparatus and method that fill

bottles at the claimed rate, and therefore is limiting. *See Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002). In light of this, Petitioner's reliance on *Digitech* is misplaced. *See* Req. Reh'g 6. In *Digitech*, the preamble of the claim at issue merely stated the purpose or intended use of the invention, and in contrast the preamble of independent claim 1 is used to define the invention. *See Digitech*, 758 F.3d at 1351. Similarly, Petitioner's reliance on *Schreiber* is misplaced because the limitation at issue in *Schreiber* was only an intended use and such is not the case here. *See* Req. Reh'g 6–7 (analogizing to *Schreiber*); *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

B. Ondrus's Valve and Rationale

Petitioner's assertion that the Board improperly distinguished between a routing valve and a filling valve is based upon the assertion that the claim construction in the Decision was in error. Req. Reh'g 4–7. This contention is unpersuasive because, as detailed above, the claim construction in the Decision was not in error. Petitioner's assertion that the claimed valve can be a routing dispensing valve that directs food product to a dispensing and filling apparatus is raised for the first time in the Request for Rehearing (Req. Reh'g 5–6) and does not persuade us that we overlooked or misapprehended anything in reaching our Decision, particularly in view of Petitioner's proposed construction of “valve” in the Petition to mean one of twelve valves that dispense food product into bottles, as discussed above. *See* Pet. 12.

Following this, Petitioner contends that Ondrus's valve could be used as a filling valve. Req. Reh'g 7. Specifically, Petitioner contends that “[t]here is no evidence that a valve capable of controlling the flow of food product through a piping system requires or lacks any features that would disqualify the valve from operating as a ‘filling’ valve.” *Id.* at 8. Petitioner adds that the Board

misinterpreted Dr. Heldman's testimony about the suitability of Ondrus's valve in a filler as limited to ZFL. Req. Reh'g 8 (referring to the Declaration of Dr. Heldman, Exhibit 1004). For the reasons that follow, these contentions are not persuasive.

Petitioner's contention that there is no evidence that Ondrus's valve is not capable of use as claimed is to some extent an attempt to improperly shift the burden of proof. It is Petitioner's burden, not Patent Owner's, to explain how the challenged claim is unpatentable. *See* 37 C.F.R. § 42.104(b)(4)–(b)(5).

Regarding the Board's alleged misinterpretation of the Heldman Declaration, as explained in the Decision, the Petition cites to a paragraph of the Heldman Declaration dealing with the ground of unpatentability based in part on Ondrus and ZFL in support of the ground of unpatentability based in part on Ondrus and Hayashi.⁹ *See* Dec. 7–8; Pet. 21–22 (citing the Heldman Declaration, Ex. 1004 ¶ 80); *see also* Ex. 1004 ¶¶ 55–61 (addressing Ondrus and Hayashi), ¶¶ 74–82 (addressing Ondrus and ZFL), ¶ 80 (“The *Ondrus* valve has no limitations that would preclude its use in *ZFL*.”). Further, the portion of the Heldman Declaration dealing with the ground of unpatentability based in part on Ondrus and ZFL (Ex. 1004 ¶ 80) states that David discloses that valves such as Ondrus's routing valve were used in filling applications, while the portion of the Heldman Declaration addressing the ground based in part on Ondrus and Hayashi (Ex. 1004 ¶ 59) contains no such statement. Consequently, the Board did not misapprehend; rather, as correctly stated in the Decision, “[t]he portion of the Heldman Declaration cited by Petitioner actually applies to the ground of unpatentability based upon Ondrus and ZFL, not the ground at hand.” *See* Dec. 8.

⁹ Petitioner does not contend that the Petition's citation to paragraph 80 of the Heldman Declaration (Ex. 1004) was typographical or clerical error.

Further, the Decision went on to address Petitioner's contention that David discloses that valves such as Ondrus's routing valve were used in filling applications. *See* Dec. 8–9. Therefore, to the extent that the Request for Rehearing argues that this contention in the Petition was overlooked by the Decision, such is not the case. The Decision explained that David discloses that routing valves direct product to a filler, and does not disclose that routing valves may be used in filling applications, *i.e.*, to dispense food product, as the Petition contends. *Id.* Nothing in the request for rehearing persuades us the Decision was in error on that point.

C. Hayashi

Petitioner contends that the claims require no structure other than the valve to satisfy the bottles per minute limitation of the challenged claims. *Req. Reh'g.* 12–13. Based on this, Petition contends that Hayashi need not provide the details of structure that provides the bottle throughput. *Id.*

As explained above, the claims require an apparatus that includes a valve and permits filling a series of bottles at the specified rate. Although the filling of a series of bottles at a specified rate is a functional limitation, functional language cannot simply be ignored. *See e.g., In re Echerd*, 471 F.2d 632, 635 (CCPA 1973). The apparatus proposed by Petitioner must be capable of performing the claimed function. As stated in the Decision, it is Petitioner's burden to explain how the disclosures of Ondrus and Hayashi would have rendered obvious the claimed subject matter. Dec. 11 (citing 37 C.F.R. § 42.104(b)(4)-(b)(5)).

In the Petition, Petitioner proposed to “combine the valve described in *Ondrus* with the bottle-filling system described in *Hayashi*.” *See* Pet. 21; Dec. 7 (quoting this portion of the Petition). Now in the Request for Rehearing, Petitioner

changes course to contend that Hayashi need not provide the details of any structure because Ondrus's valve alone meets the challenged claims.¹⁰

Ondrus discloses a valve for controlling the flow of food product through a piping system in a food processing plant. *See* Ex. 1006, 1:4–14; Dec. 7. Petitioner has not explained adequately why a skilled artisan would have considered using the routing valve of Ondrus to dispense food product in the bottle-filling system of Hayashi to permit filling a series of bottles at the specified rate as claimed. *See* Dec. 7–9. The disclosure in David (Ex. 1005, 26), and Heldman Declaration assertions based thereon (Ex. 1004 ¶ 80), do not explain why it would have been obvious to use a routing valve to dispense food product into bottles at the claimed rate. Dec. 9. David discloses only that “[t]hese [routing] valves were used to direct the product to a filler, aseptic tank, or the drain-supply.” Even if the claimed valve covered routing valves, as Petitioner now asserts, the Petition did not explain how addition of such a routing valve to Hayashi would have resulted in the claimed filling rate, or why a skilled artisan would have been motivated to add such a routing valve to Hayashi to increase the dispensing rate of Hayashi to meet the claimed filling rate.

D. Bucher Declaration

Petitioner contends that it was legal error for the Decision to rely upon the Declaration of Dr. Buchner (Ex. 2027), because that declaration is new testimonial evidence precluded by 37 U.S.C. § 42.107(c). *Req. Reh’g* 13. Petitioner adds that even if the Declaration may be considered, it is inapposite because it does not discuss Hayashi. *Id.* at 13–14.

¹⁰ “Ondrus satisfies all of the ‘valve’ limitations of the claims, there is no need for modification.” *Req. Reh’g.* at 11.

This contention is unpersuasive because the Decision does not cite to, nor rely upon the Declaration of Dr. Buchner. *See* Dec. 10. Instead, the Decision explains that Hayashi is nonpatent literature that provides a high-level overview of the Krones system without the details of the filling operation. *Id.* (citing Prelim. Resp. 10–11).

IV. CONCLUSION

We have considered the Request for Rehearing, but decline to modify the Decision.

V. ORDER

For the foregoing reasons, it is
ORDERED that Petitioner’s Request for Rehearing is *denied*.

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