

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CATERPILLAR, INC.,
Petitioner,

v.

MILLER INTERNATIONAL, LTD.,
Patent Owner.

Case IPR2015-00416
Patent D673,982 S

Before HYUN J. JUNG, SCOTT A. DANIELS, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Caterpillar, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of the sole claim of U.S. Design Patent No. D673,982 S (“the ’982 patent”). Paper 2 (“Pet.”). Miller International Ltd. (“Miller” or “Patent Owner”) did not file a Preliminary Response. We instituted trial for the sole claim of the ’982 patent on certain grounds of unpatentability alleged in the Petition. Paper 4 (“Decision to Institute” or “Inst. Dec.”).

In the Scheduling Order, which sets times for taking action in this proceeding, we notified the parties that “any arguments for patentability not raised in the [Patent Owner] response will be deemed waived.” *See* Paper 5, 4. Additionally, the Board’s Trial Practice Guide states that the Patent Owner Response “should identify all the involved claims that are believed to be patentable and state the basis for that belief.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012).

Patent Owner did not file a Patent Owner Response within the time period set forth in the Scheduling Order. Patent Owner neither sought authorization to file a Patent Owner Response after the deadline, nor indicated that it wished to file such a Response or any further papers in this proceeding. We have before us, therefore, unrebutted argument and evidence as set forth in the Petition. Notably, there is no appearance by counsel for Patent Owner in this proceeding.

Because the Patent Owner *has not* entered an appearance in this proceeding, the Board conducted a conference call on April 7, 2016, with counsel for Petitioner in this proceeding and counsel for Patent Owner, Miller, in Cases IPR2015-00433, IPR2015-00434, and IPR2015-00435. Paper 6, 2. The utility patents at issue in IPR2015-00433 through -00435 are

unrelated to the '982 patent except that the utility patents address generally similar subject matter to the '982 patent, and the dispute over those patents involves the same parties. IPR2015-00433 through -00435 differ from this proceeding, in that Patent Owner *has* entered an appearance in those utility patent proceedings. *Id.* During the conference call, counsel for both parties in the utility patent proceedings communicated Miller's apparent intention not to participate in this proceeding.¹ *Id.*

In general, the lack of any appearance or communication by Patent Owner in a proceeding will constitute abandonment of the contest and will be construed by the Board as a request for adverse judgement under 37 C.F.R. 42.73(b)(4). In this proceeding, however, because no meaningful communication indicating abandonment of the contest was received until after all trial due dates had passed, we determine that the appropriate course of action is to readdress the merits of the Petition.

Thus, although Patent Owner has not entered an appearance or filed any papers in this proceeding, Petitioner still bears the burden to show, by a preponderance of the evidence, that the challenged claims are unpatentable. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that the sole claim of the '982 patent is unpatentable.

¹ For purposes of communication and notice of this Decision to Miller, we include as the correspondence addressees in this proceeding, Patent Owner's Counsel of record in IPR2015-00433 through -00435 as well as Mr. Justin Swindells of Nixon Peabody, LLP, Patent Owner's counsel of record during prosecution of the application that lead to the issuance of the '982 patent.

B. Additional Proceedings

Petitioner states that it is unaware of any other related matter involving the '982 patent. Pet. 5.

C. The '982 Patent

The '982 patent (Ex. 1001), titled “Operator-Visible Warning Symbol on a Coupler,” relates to the design of a warning symbol affixed to a coupler mechanism of an earth moving machine. Ex. 1001, 1 (Figure Description). Figures 1 and 3 of the '982 patent, illustrating perspective views of the warning symbol, are reproduced below.

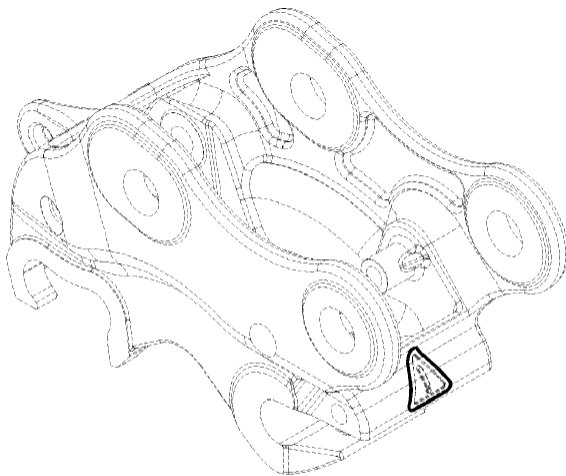


FIG. 1

Figure 1 is a “perspective view of an operator visible warning symbol on a coupler.” *Id.* (Figure Description).

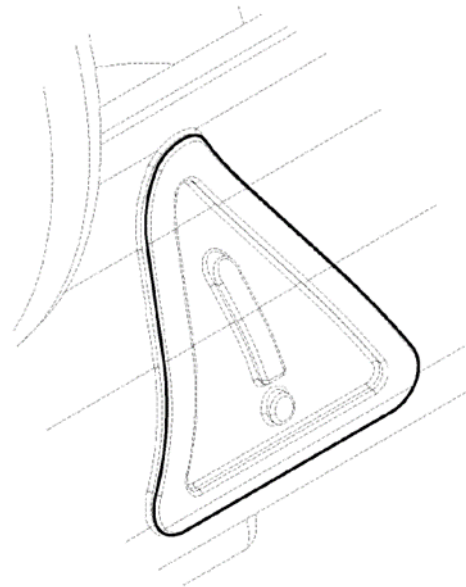


FIG. 3

Figure 3 is “an enlarged perspective view” of the operator visible warning symbol on a coupler. *Id.* (Figure Description).

D. The Instituted Grounds of Unpatentability

We instituted this *inter partes* review on the following specific grounds.

References	Basis
Coupler Manual ² in view of Hub	§ 103
Coupler Manual in view of Hub and Teo ³	§ 103

Petitioner supports these challenges with a Declaration of Mr. Alan Ball, B.I.D., (Ex. 1013) (“Ball Declaration”).

II. CLAIM CONSTRUCTION

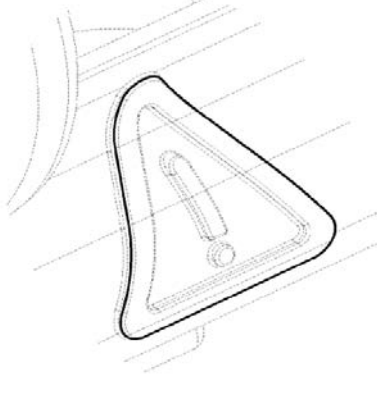
A. Legal Standard

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). With respect to design patents, it is well-settled that a design is represented better by an illustration than a description. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (citing *Dobson v. Dornan*, 118 U.S. 10, 14 (1886)). Although preferably a design patent claim is not construed by providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *Egyptian Goddess*, 543 F.3d at 679–80; *cf. High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1314–15 (Fed. Cir. 2013) (remanding to district court, in part, for a “verbal description of the claimed design to evoke a visual image consonant with that design”).

² Ex. 1005, Caterpillar, *Operation and Maintenance Manual: Cast Manual Pin Grabber Coupler* (2007) (“Coupler Manual”).

³ Ex. 1012, WO 02/090144 A1 published Nov. 14, 2002 (“Teo”).

In our Decision to Institute we determined a construction consistent with the broadest reasonable construction and followed the applicable guidance from the Federal Circuit, discussed above, relating to claim construction for design patent claims. Inst. Dec. 4–5. Accordingly, the following claim construction applies to this Decision:

Figure 3	Construction
 FIG. 3	The ornamental design of the operator visible warning symbol, as illustrated in Figures 1–7, except that the broken lines form no part of the claimed design, and the ornamental design includes an equilateral triangle with rounded corners and a horizontal base that is shaped as if projected onto a laterally extruded “S”-shaped surface, as shown in the solid lines in Figs. 1–7 of the ’982 patent.

III. ANALYSIS

A. Principles of Law

In a challenge to a design patent based on obviousness under 35 U.S.C. § 103, the ultimate inquiry is “whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved.” *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329 (Fed. Cir. 2012) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)).

The obviousness inquiry consists of two steps. *Apple*, 678 F.3d at 1329. In the first step, a primary reference (sometimes referred to as a “*Rosen* reference”) must be found, “the design characteristics of which are basically the same as the claimed design.” *Id.* (quoting *In re Rosen*, 673 F.2d 388, 391 (CCPA 1982)). This first step is itself a two-part inquiry

under which “a court must both ‘(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates ‘basically the same’ visual impression.’”

High Point Design, 730 F.3d at 1311–12 (quoting *Durling*, 101 F.3d at 103).

In the second step, the primary reference may be modified by secondary references “to create a design that has the same overall visual appearance as the claimed design.” *Id.* at 1311. However, the “secondary references may only be used to modify the primary reference if they are ‘so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other.’” *Durling*, 101 F.3d at 103 (quoting *In re Borden*, 90 F.3d 1570, 1575 (Fed. Cir. 1996)).

B. Designer of Ordinary Skill

Petitioner asserts that the relevant designer of ordinary skill is “someone with a background and training in the design of earth-moving equipment and who is presumed to have knowledge of prior art equipment, including couplers . . . that includes familiarity with international design symbols, including the ISO 3864 and ISO 7100.” Pet. 23 (citing Ex. 1013 ¶¶ 13–18, 20).

Petitioner provided the Declaration of Mr. Alan Ball in support of its obviousness contentions. See Pet. 1; Ex. 1013. We find Mr. Ball’s testimony, as an industrial designer with approximately 30 years of design experience in a broad range of construction and industrial product fields, persuasive as to the level of ordinary skill in the art of designing and labeling products for user interface and safety. Ex. 1013 ¶¶ 5–6. Based on Mr. Ball’s testimony we determine that a designer of ordinary skill in the art would have, *inter alia*, been a designer with “at least five years of

experience working in the heavy construction industry designing products . . . familiar with relevant industry standards such as those published by standards organizations such as the ISO or ANSI and the techniques for applying a two-dimensional design to a three-dimensional surface.” *Id.* at ¶ 20.

C. Obviousness – Coupler Manual and Hub

Petitioner alleges that “the Coupler Manual is a suitable primary reference, because it discloses a coupler with a triangular-shaped warning symbol.” Pet. 44–45. Illustration 1 of the Coupler Manual (Ex. 1005) is reproduced below.

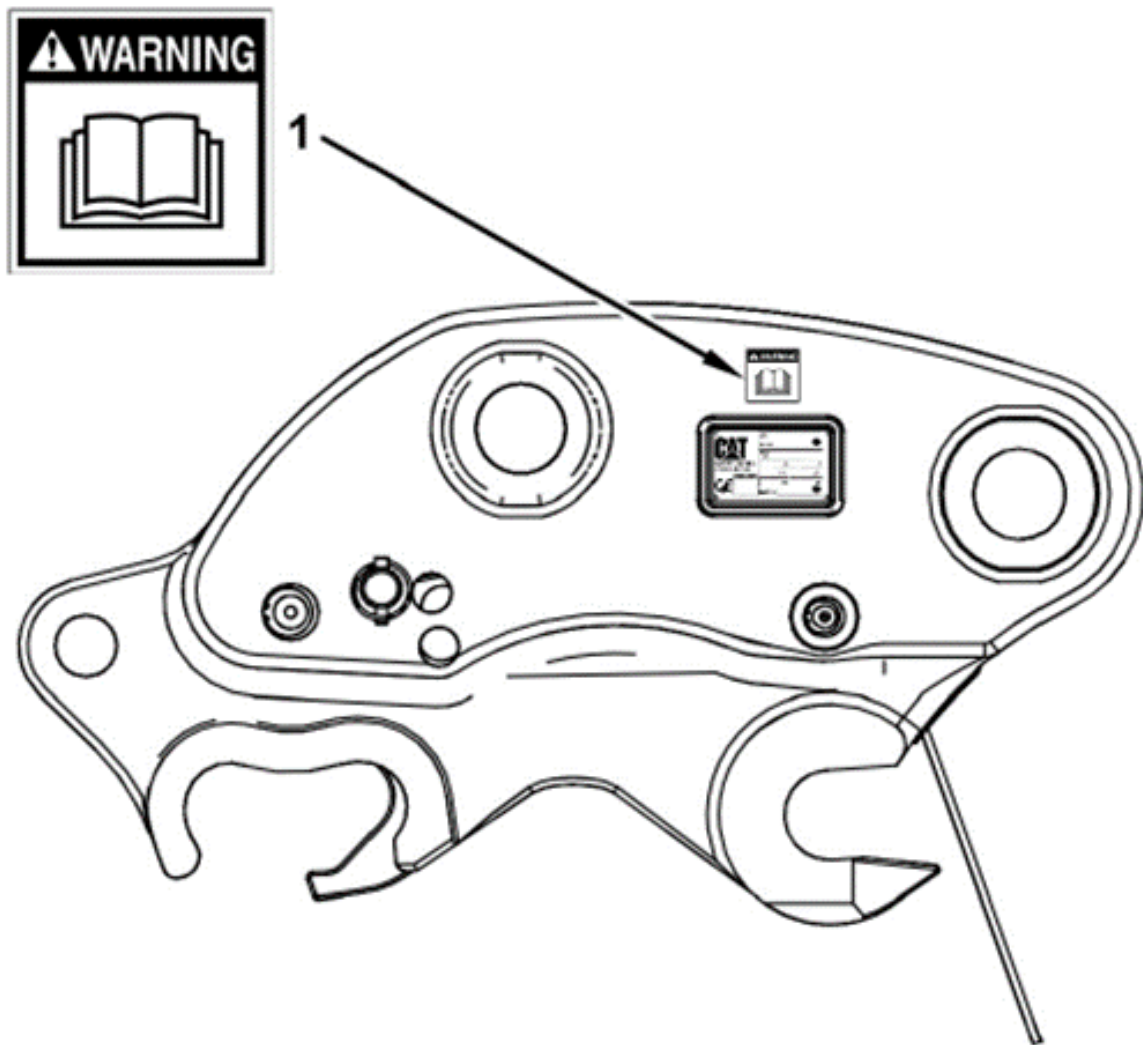


Illustration 1 depicts, by exploded view, a triangular warning symbol affixed on the side of a coupler. The warning symbol disclosed by the Coupler Manual at reference numeral 1 includes an equilateral triangle with rounded corners as defined by a black border. The only difference, Petitioner argues, between the claimed design and the Coupler Manual warning symbol is that the Coupler Manual warning symbol is affixed to a flat surface, and is thus basically the same as the claimed design. See Pet. 45. Below, is a side-by-side comparison of Figure 7 of the '982 patent with an enlarged view of the triangular portion of the coupler manual triangle warning symbol.

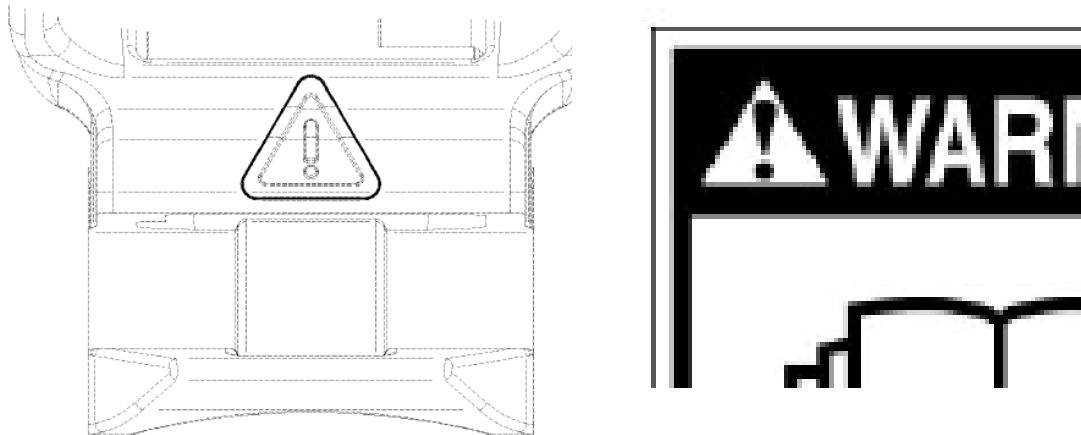


FIG. 7

Above is Figure 7 of the '982 patent illustrating the claimed operator visible warning symbol.

Above is the triangular warning symbol shown in the Coupler Manual.

We are persuaded by Petitioner's evidence that the Coupler Manual is a suitable primary reference because the Coupler Manual warning symbol gives the same overall visual impression when compared to the claimed warning symbol design as a whole. Ex. 1013 ¶ 31, and see *Durling*, 101 F.3d at 103. We are further persuaded that any apparent minor differences in the designs are of little, if any, significance to the ordinary observer

because the well-known equilateral triangular warning symbol, shown below, is an international standard and would have been universally understood by a person of skill in the art.



W001

General warning
sign

Ex. 1008, 10. The General warning sign, above, is illustrated by an exclamation point within a yellow triangle and black triangular border. The requirement that the design characteristics of the proposed primary reference be the same as the claimed design does not imply that the appearance of the prior art article must be identical to the claimed design. *Cf. In re Lamb*, 286 F.2d 610, 611 (CCPA 1961) (“[T]he mere fact that there are differences over the prior art structures is not alone sufficient to justify a holding that the design is patentable.”).

Based on the evidence presented we determine that the Coupler Manual equilateral triangle warning symbol is basically the same as the claimed design and, therefore, a valid primary reference.

Hub discloses a coupler having a curved surface facing an operator (Ex. 1010, 6), and is combined by Petitioner as a secondary reference with the Coupler Manual. The Hub coupler is shown, below, with the curved surface above the open attachment jaw and facing the reader.



The figure from Hub, above, shows in a perspective view the curved surface on the portion of the coupler viewable by an operator.

We are persuaded by Petitioner’s evidence that Hub is a suitable secondary reference because Hub, like the Coupler Manual, also discloses a coupler for an earthmoving machine. *Compare* Ex. 1010, 6, with Ex. 1005, Illustration 1. Petitioner’s reasoning and reliance on Mr. Ball’s testimony are also persuasive that one of ordinary skill in the art would look to the curved portion of Hub’s coupler facing the operator “as the reasonable location for moving the warning symbol disclosed in the Coupler Manual” because, in this location on the coupler, the symbol would be “readily visible to the operator of the earth-moving equipment.” Pet. 46–47 (citing Ex. 1013 ¶ 31).

For the foregoing reasons, we agree with, and adopt as our own, Petitioner’s analysis under *Durling* and the combination of the Coupler Manual and Hub. Based on that analysis, we conclude that Petitioner has

demonstrated by a preponderance of the evidence that the sole claim of the '982 patent is obvious over the Coupler Manual and Hub.

D. Obviousness – Coupler Manual, Hub, and Teo

Petitioner asserts an additional secondary reference, Teo (Ex. 1012), in combination with the Coupler Manual and Hub, as suggesting affixing a warning symbol to a curved surface. Pet. 48–50.

Teo discloses that a triangular warning symbol made of a flexible magnetic material can be applied to a curved surface of a vehicle. *Id.* at 47 (citing Ex. 1012, 2:29–30). Petitioner asserts that Teo is a valid secondary reference related to Hub and the Coupler Manual because Teo discloses a triangle-shaped warning symbol with rounded corners applied to a curved surface of a vehicle. *Id.* at 49 (citing *In re Borden*, 90 F.3d at 1574–75). We determine that Teo, as it discloses a warning symbol affixed or supported on a curved vehicle component, is so related to the Coupler Manual that the appearance of features in Teo would suggest the application of those features to the Coupler Manual.

Petitioner contends specifically that a designer of ordinary skill in the art would have accomplished the application of a warning symbol on the curved surface shown in the Coupler Manual, because,

[i]n particular, Teo discloses a triangle with rounded corners and an exclamation point shown molded to the curved surface of a vehicle, and Hub discloses the operating-facing portion of a coupler with an “S”-shaped surface that matches the curved shape of the claimed design.

Pet. 49 (citing Ex. 1013 ¶ 32). Our review of Teo is consistent with Petitioner’s position. Teo states that

[t]he key aspect of the present invention is the combination of the general magnetic properties of the warning sign so as to make

it affixable to a ferromagnetic surface, the use of a flexible magnetic material for the entire warning sign 1 permitting attachment of the warning sign 1 to a curved surface.

Ex. 1012, 6:10–13.

We are persuaded that Petitioner has identified evidence and analysis supporting the combination of the Coupler Manual, Hub, and Teo. We are also persuaded that Petitioner has explained by sufficient reasoning and evidence, including the testimony of Mr. Ball, that a designer of ordinary skill would, as described in Teo, apply the warning symbol to a curved surface such as Hub. Ex. 1013 ¶ 32. Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that the sole claim of the '982 patent would have been obvious over the Coupler Manual, Hub, and Teo.

For the foregoing reasons, we agree with, and adopt as our own, Petitioner's analysis under *Durling* and the combination of the Coupler Manual, Hub, and Teo. We further determine that Petitioner has demonstrated by a preponderance of the evidence that the sole claim of the '982 patent is obvious over the Coupler Manual, Hub, and Teo.

IV. SUMMARY

For the foregoing reasons, we determine that Petitioner has demonstrated by a preponderance of the evidence that the sole claim of the '982 patent is unpatentable under 35 U.S.C. § 103 in view of the combination of Coupler Manual and Hub, and the combination of Coupler Manual, Hub, and Teo.

V. ORDER

For the reasons given, it is

ORDERED that the sole claim of the '982 patent is held *unpatentable*;
and

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.

IPR2015-00416
Patent D673,982 S
For PETITIONER:

Mark D. Sweet
Timothy McAnulty
Elizabeth Ferrill
Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.
mark.sweet@finnegan.com
timothy.mcanulty@finnegan.com
elizabeth.ferrill@finnegan.com

For PATENT OWNER:

John E. Thomas
Harter Secrest & Emery LLP
jthomas@hselaw.com

Justin Swindells
NIXON PEABODY, LLP
300 S. Riverside Plaza, 16th Floor
Chicago, IL 60606-6613