

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUV N' CARE, LTD.,
Petitioner,

v.

MUNCHKIN, INC.,
Patent Owner.

Case IPR2015-00872
Patent 8,739,993 B2

Before SHERIDAN K. SNEDDEN, MITCHELL G. WEATHERLY, and
JAMES A. TARTAL, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Luv N’ Care, Ltd. (“Petitioner”) filed a corrected Petition to institute an *inter partes* review of claims 1–7 (Paper 4; “Pet.”) of US 8,739,993 B2, issued June 3, 2014 (Ex. 1001, “the ’993 patent”). Munchkin, Inc. (“Patent Owner”) filed a Patent Owner Preliminary Response. Paper 8 (“Prelim. Resp.”).

Based on these submissions, we instituted trial on the following grounds of unpatentability asserted by Petitioner:

Reference[s]	Basis	Claims challenged
Whiteman ¹	§ 102	1–7
Atkins ²	§ 102	1–7
Whiteman and Atkins	§ 103(a)	1–7

Decision to Institute (Paper 9, “Dec.”).

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 13, “PO Resp.”), to which Petitioner filed a Reply (Paper 22, “Pet. Reply”).

Petitioner relies on the Declarations of John Staats (Ex. 1027) and Vincent Valderrama (Ex. 1033).

Patent Owner relies on the Declaration of Travis McCallon (Ex. 2011).

¹ U.S. Patent No. 3,101,856, issued Aug. 27, 1963 (Ex. 1002).

² U.S. Patent No. 4,230,232, issued Oct. 28, 1980 (Ex. 1003).

Patent Owner filed a Contingent Motion to Amend (Paper 14, “Mot. Amend”), to which Petitioner filed an Opposition (Paper 23, “Opp. Mot. Amend”) and Patent Owner filed a Reply (Paper 37, “Reply Mot. Amend”).

Oral argument was conducted on May 10, 2016. A transcript is entered as Paper 53 (“Tr.”).

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). We conclude for the reasons that follow that Petitioner has shown by a preponderance of the evidence that claims 1–7 of the ’993 patent are unpatentable. Furthermore, we deny Patent Owner’s Motion to Amend.

A. The ’993 patent (Ex. 1001)

The ’993 patent discloses “a spillproof container assembly that provides guidance to consumers as to the proper degree of tightening between the lid and the container body.” Ex. 1001, 2:21–24. The spillproof container assembly includes a container body and a lid body, which are provided with mating helical threads so that the lid body may be fastened to the container body by screwing. *Id.* at 2:65–3:8.

The spillproof container assembly may be provided with a structure for providing “visual, audible and tactical feedback to a user in determining when the optimum design tightness and position has been reached” between the lid body and the container body. *Id.* at 5:65–6:2. A snap projection is disclosed as one such structure. *Id.* at 6:3–13. The snap projection may be in the form of a snap ridge or, alternatively, as “single or multiple bumps or posts, which could work individually or as a group to engage the flexible tab.” *Id.* at 8:11–15.

Figure 11 of the '993 patent is reproduced below.

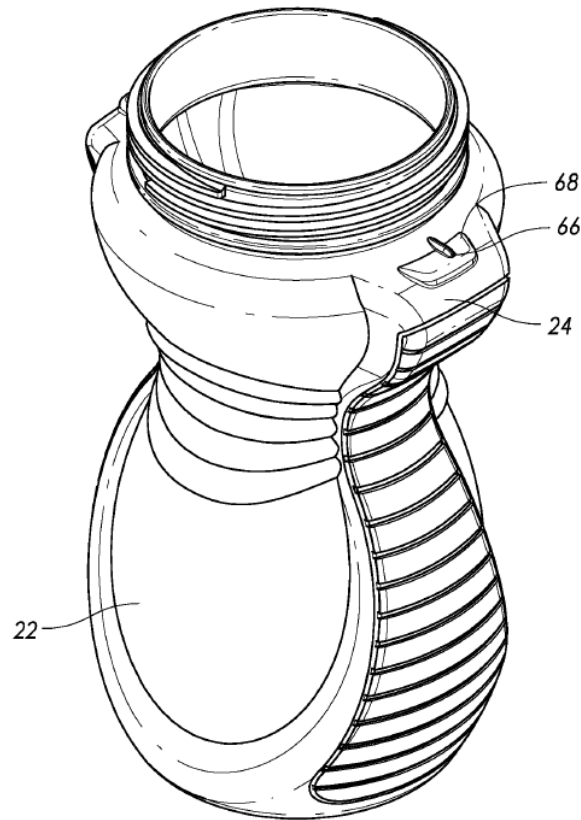


FIG. 11

Figure 11 is a perspective of container body 22. *Id.* at 3:65–67. With reference to Figure 11, the '993 patent provides as follows:

Cup body 22 includes at least one container wing or cup wing that protrudes radially outwardly from a first side of the cup main body 23, which enables a consumer to grip and exert torque on the cup body 22 during tightening and untightening of the lid body 12. In the preferred embodiment, the cup body 22 includes a first cup wing 24 that protrudes radially outwardly from a first side of the cup main body 23 and a second cup wing 26 that protrudes radially outwardly from a second, opposite side of the

cup main body 23. The respective cup wings 24, 26 both preferably form part of the upper surface of the cup body 22.

Id. at 5:13–21.

Container body 22 is shown with platform 68, which “is preferably substantially flat, and is further preferably substantially disposed within a plane that is substantially normal to a longitudinal axis of the cup body 22.”

Id. at 6:18–21. Snap ridge 66 projects upwardly from the raised platform 68 that is located on the shoulder of container body 22. *Id.* at 8:7–10.

B. Illustrative Claims

Independent claim 1 is illustrative of the challenged claims, and is reproduced below:

1. A container for a spillproof drinking assembly, comprising:
 - a container body having a first upper open end and a lower closed end;
 - a neck extending cylindrically outward and away from the first upper end of the container body, the neck including at least one threaded fastener on an outer surface of the neck to receive a cap,
 - wherein an outer surface of an upper end of the container body extends below the neck radially outward to define a shoulder;
 - a platform is disposed on the shoulder; and
 - a snap projection is disposed on the platform, wherein the snap projection extends upward, away from the platform to a predetermined height.

Claims 2–7 depend from claim 1, either directly or indirectly.

II. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, the Board interprets claim terms in an unexpired patent according to the broadest reasonable construction in light

of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under that standard, and absent any special definitions, we generally give claim terms their ordinary and customary meaning, as would have been understood by one of ordinary skill in the art at the time of the invention. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definitions for claim terms must be set forth with reasonable clarity, deliberateness, and precision. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

We interpret “shoulder” as recited in the challenged claims as part of our analysis. Our decision does not require explicit construction of any other claim term. *See, e.g., Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

In our Decision to Institute, we declined to adopt Petitioner’s construction of the term “shoulder” to mean “a part with a suddenly increased width or thickness (compared to its neighboring structure).” Pet. 4 (citing Ex. 1010³) (emphasis omitted). In doing so, we noted that the term “shoulder” is expressly defined in the following clause from claim 1: “wherein an outer surface of an upper end of the container body extends below the neck radially outward to define a shoulder.” In its Reply, Petitioner does not contest this construction. Pet. Reply 3–7.

³ The *McGraw-Hill Dictionary of Scientific and Technical Terms* (6th ed.) (2003).

Patent Owner, however, proposes a different construction for “shoulder.” PO Resp. 9–15. Patent Owner contends that “the ordinary meaning of ‘shoulder’ is ‘a rounded or sloping part (as of a stringed instrument or a bottle) where the neck joins the body.’” *Id.* at 14–15 (citing Ex. 2004⁴). Patent Owner further contends that “the specification is clear that the claimed shoulder extends from the neck of the container,” and that “the language of claim 1 itself, like the specification, dictates that the shoulder joins the neck (at the ‘upper end’ of the container body).” PO Resp. 12, 14 (emphasis omitted). To support this argument, however, Patent Owner attempts to equate the claimed “shoulder” with a “cup wing” structure described in the specification. *Id.* at 10–12 (citing Ex. 1001, 5:12–23, 6:13–14, Figure 11). Patent Owner reasons that because the specification discloses that “the first cup wing 24 extends radially outwardly from the cup main body 23 by a third distance D_3 ,” that a person of ordinary skill in the art would understand that the “shoulder” element of the claims must join the neck. *Id.* at 12 (citing Ex. 1001, 6:58–60.)

We are not persuaded by Patent Owner’s argument that “shoulder,” as used in the claims, has the same meaning as “wings,” as used elsewhere in the specification. If the drafters of the claims intended the claims to be limited to the preferred embodiment disclosed in the specification, described as having wings, then the drafters could have chosen to use the language of the specification that describes that embodiment and included a clear and precise definition of the term “wings.” The drafters of the claim did not use

⁴ Definition of “shoulder” retrieved from the website of Merriam Webster (<http://www.merriam-webster.com/dictionary/shoulder>). Ex. 2004.

terms such as “wings” to claim their invention. The drafters chose the word “shoulder,” which does not appear in the descriptive portion of the specification of the ’993 patent. We must otherwise “avoid giving invention-defining effect to specification language included for other descriptive and enablement purposes.” *Straight Path IP Group, Inc. v. Sipnet EU S.R.O.*, 806 F.3d 1356, 1361 (Fed. Cir. 2015); *Epos Techs. Ltd. v. Pegasus Techs. Ltd.*, 766 F.3d 1338 (Fed. Cir. 2014) (claim construction based on a preferred embodiment is improper). Thus, the only definition of the term “shoulder” appears in claim 1. Patent Owner has not otherwise directed us to any evidence suggesting that the inventors attempted to be their own lexicographer requiring us to give other special meaning to the term “shoulder.”

We acknowledge that a dictionary definition may be useful in ascertaining the way in which one of ordinary skill in the art would use the claim term. *Starhome GmbH v. AT&T Mobility LLC*, 743 F.3d 849, 856–57 (Fed. Cir. 2014). However, in this case “shoulder” is expressly defined as “an outer surface of an upper end of the container body [that] extends below the neck radially outward to define a shoulder.” We are not persuaded that Petitioner’s dictionary definition (see Pet. 4 (citing Ex. 1010 (“[t]he portion of a shaft, a stepped object, or a flanged object that shows an increase of diameter”)) or Patent Owner’s dictionary definition (see PO Resp. 14–15 (citing Ex. 2004) supersedes the express definition provided in the claims.

We maintain our determination that the term “shoulder” is expressly defined in the following clause from claim 1: “wherein an outer surface of an upper end of the container body extends below the neck radially outward to define a shoulder.” Accordingly, we decline Patent Owner’s invitation to

import a requirement from a dictionary definition of shoulder which refers broadly to an area “where the neck joins the body” to preclude a structure in which the recited platform “disposed on the shoulder” results in a platform adjacent to the neck. .

B. Asserted Grounds of Unpatentability

1. Anticipation of Claim 1–7 over Whiteman

Petitioner contends that Whiteman anticipates claims 1–7. Pet. 10–18. In support of its assertion that Whiteman anticipates claims 1–7, Petitioner sets forth the following teachings of Whiteman and provides a detailed claim chart explaining how each claim limitation is disclosed in Whiteman. Pet. 10–18.

Whiteman discloses “a bottle closure incorporating a locking mechanism for securing the cap to the bottle whereby the same cannot be removed without the proper manipulation of the bottle.” Ex. 1002, 1:7–11. Figure 1 of Whiteman is reproduced below.

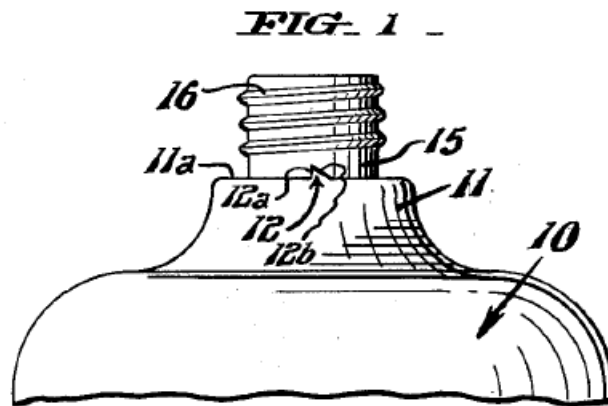


Figure 1 shows container 10 with neck 15, shoulder portion 11, flat surface 11a, and saw-tooth protrusions 12. *Id.* at 1:68–2:24. Neck 15 includes spiral thread 16, which is designed to complement the thread

positioned in the interior surface of a cap. *Id.* As the cap is threaded onto the container, indentations on the cap slip over and engage protrusions 12 and prevent the cap from rotating in the loosening direction. *Id.* at 2:25–45.

The parties only dispute whether Whiteman discloses the requirement that “a platform is disposed on the shoulder.” Patent Owner contends that Whiteman fails to disclose this requirement because the language of the claim should be construed to require the neck to join the container body and, thus, “the platform cannot be disposed between the shoulder and the neck,” as is disclosed in Whiteman. PO Resp. 21. Patent Owner’s argument is based on its proposed claim construction of the term “shoulder” as requiring a structure in which the neck joins the body.” PO Resp. 14–15. For the reasons explained above, however, we are not persuaded by Patent Owner’s proposed construction of “shoulder.”

Rather, we agree with Petitioner that the position of the platform between the shoulder and the neck does not negate anticipation. The recited element of “a platform is disposed on the shoulder” is met by the combination of flat surface 11a and supporting structure 11, which sits upon a shoulder (beside reference numeral 10 in Figure 1 of Whiteman) that extends radially outward. Pet. 12–13; Pet. Reply 21. We further agree with Petitioner that Whiteman discloses each claim limitation of the challenged claims. Pet. 10–18.

Accordingly, for the reasons provided in the Petition, which we adopt, we determine that Petitioner has demonstrated by the preponderance of evidence that Whiteman anticipates claims 1–7 of the ’993 patent. Pet. 10–18.

2. Anticipation of Claim 1–7 over Atkins

Petitioner contends that Atkins anticipates claims 1–7. Pet. 23–28. In support of its assertion that Atkins anticipates claims 1–7, Petitioner sets forth the following teachings of Atkins and provides a detailed claim chart explaining how each claim limitation is disclosed in Atkins. *Id.*

Atkins discloses “a capped bottle wherein the cap screws onto a neck portion of the bottle and which has an arrangement for ensuring the positive alignment of the cap on the neck of the bottle.” Ex. 1003, 1:4–7.

Figure 3 of Atkins is reproduced below.

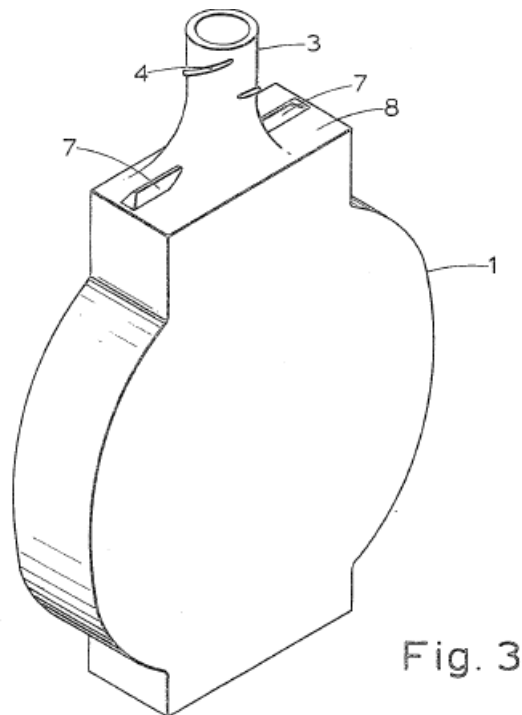
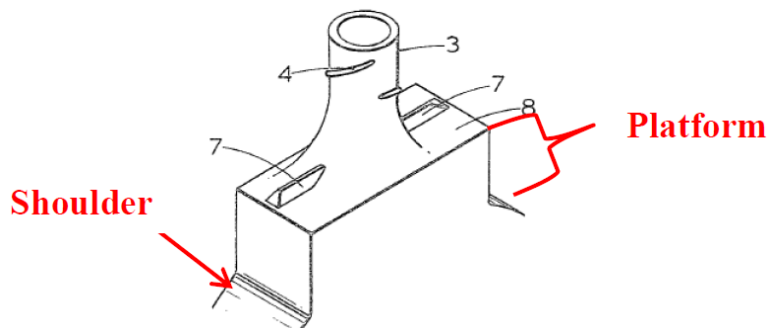


Figure 3 shows bottle 1 with neck portion 3 having threads 4. *Id.* at 2:32–43. Threads 4 cooperate with the inner threads formed on the inside of a tubular socket portion of the cap. *Id.* Protuberances 7 in the form of ridges of inverted V-shaped cross-section are formed on shoulder 8 of bottle

1. *Id.* These protuberances engage matching notches located inside the cap when the cap is in position on the bottle (not shown). *Id.*

Petitioner contends that the recited element of “a platform is disposed on the shoulder” is taught by Atkins in the disclosure of a shoulder in Figure 3, wherein surface 8 may be considered a platform that sits upon the shoulder of bottle 1. Petitioner supports its argument with an annotated Figure 3, reproduced below:



Id. 25–28. Petitioner’s annotated portion of Atkins’s Figure 3 includes identifiers for the claimed shoulder and platform.

Patent Owner again contends that the feature Petitioner identified as a shoulder fails to meet the properly-construed claim because the shoulder does not join the neck of the container body. PO Resp. 23–24. As discussed above, we are not persuaded by this argument. The language of the claim does not require the neck to join the container body and, thus, does not preclude the insertion of the platform between the neck and shoulder. Rather, claim 1 recites: “wherein an outer surface of an upper end of the container body *extends below the neck radially outward* to define a shoulder.”

Rather, we agree with Petitioner that the position of the platform between the shoulder and the neck does not negate anticipation. The recited

element of “a platform is disposed on the shoulder” is met by the combination of flat surface 8 and supporting structure, which sits upon a shoulder that extends radially outward, as depicted in Petitioner’s annotated portion of Atkins’s Figure 3, above. Pet. 27–28; Reply 21. We further agree with Petitioner that Atkins discloses each claim limitation of the challenged claims. Pet. 24–26.

Accordingly, for the reasons provided in the Petition, which we adopt, we determine that Petitioner has demonstrated by the preponderance of evidence that Atkins anticipates claims 1–7 of the ’993 patent. Pet. 23–28.

*3. Obviousness of Claims 1–7 Over the Combination of
Whiteman and Atkins*

Petitioner contends that claims 1–7 would have been obvious in view of the combination of Whiteman and Atkins. Pet. 18–22, 29–30. With regard to claims 1–5 and 7, however, Petitioner argues that the elements of these claims are expressly taught by Atkins. *Id.* at 29 (“Atkins alone renders at least claims 1–5 and 7 obvious.”). In its obviousness ground, however, Petitioner provides additional argument with regard to claim 6, which we address below.

Claim 6 depends from claims 1, 4, and 5. Claims 4–6 are reproduced below:

4. A container for a spillproof drinking assembly according to claim 1, wherein the snap projection extends radial from a first end adjacent to an outer end of the shoulder.
5. A container for a spillproof drinking assembly according to claim 4, wherein the snap projection extends radially inward to a

second end adjacent to an inner end of the shoulder adjacent to the neck.

6. A container for a spillproof drinking assembly according to claim 5, wherein a gap is provided between the second end of the snap projection and the neck.

With regard to claims 6, Petitioner additionally argues that “[e]ven if Atkins is construed as not having a ‘gap’ between the inside edge of snap projection 7 and the neck 3 as recited in claim 6, such a configuration is shown in Whiteman.” *Id.* at 29. Petitioner further contends that “[i]t would have been a routine matter of design choice to a person of ordinary skill in the art to modify the bottle of Atkins to add a space between the snap projection 7 and the neck 3 as taught by Whiteman,” and that “[a] person of ordinary skill in the art would recognize that combining these prior art elements according to known methods would yield the predictable results of the container claimed in the ‘993 patent.” Pet. 29–30.

Patent Owner responds as follows:

As described above, both Whiteman and Atkins fail to teach or meet the properly construed limitations of the ‘993 Patent’s claims. And because Whiteman and Atkins fail to teach or meet the patent’s limitations for the exact same reasons, a combination of Whiteman and Atkins remains deficient for the same reasons that each individual reference is deficient. Moreover, the instituted combination of Whiteman and Atkins for claim 1 focuses solely on the “snap projection” limitation. For the purposes of this proceeding, Munchkin has not argued that such a snap projection is missing from Whiteman or Atkins. As such, Atkins adds nothing to the disclosure of Whiteman.

PO Resp. 24.

As discussed above, we are not persuaded by Patent Owner’s arguments based on its proposed claim construction of the term “shoulder.”

Patent Owner make no further argument to rebut Petitioner's obviousness ground. We further find persuasive Petitioner's identification of the features of claims 1–7 as corresponding to features described in Atkins and Atkins, as well as Petitioner's asserted rationale for combining Whiteman and Atkins with respect to claim 6. Pet. 23–28

As set forth above in our discussion of Petitioner's anticipation ground, we determine Petitioner has demonstrated by the preponderance of evidence that Atkins anticipates claims 1–7 of the '993 patent for the reasons set forth in the Petition. *See id.* The same issues are dispositive of Petitioner's instituted obviousness ground. *In re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2002) ("It is well settled that 'anticipation is the epitome of obviousness.'"), *quoting In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982).

Accordingly, for the reasons provided in the Petition, which we adopt, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–7 are unpatentable under 35 U.S.C. § 103(a) for obviousness in view of the disclosures of Whiteman and Atkins. Pet. 18–22, 29–30.

III. CONTINGENT MOTION TO AMEND

Patent Owner filed a Contingent Motion to Amend, requesting substitution of various claims in the event certain claims in the '993 patent were found to be unpatentable, which has come to pass as just explained. Having reviewed the briefing on Patent Owner's Contingent Motion to Amend, we determine that there are dispositive issues under 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii) that preclude entry of the proposed substitute claims. We first discuss the relevant principles of law

and then address the issue of whether the proposed amendment enlarges the scope of the claim of the '993 patent.

A. Principles of Law – Motion to Amend in Inter Partes Review

In an *inter partes* review, a patent owner may file a motion to amend to propose a reasonable number of substitute claims for each challenged claim. 35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3). Among other requirements, a patent owner must show support in the original disclosure of the patent for each claim that is added or amended. 37 C.F.R. § 42.121(a)(b)(1). Furthermore, the proposed substitute claims in an *inter partes* review “may not enlarge the scope of the claims of the patent.” 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii).

As the moving party, Patent Owner has the burden to establish it is entitled to the requested relief. 37 C.F.R. § 42.20(c); *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040, slip op. at 4 (PTAB July 15, 2015) (Paper 42) (precedential) (indicating a patent owner, as movant, bears “the ultimate burden of persuasion . . . to demonstrate the patentability of the amended claims”); see *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1306 (Fed. Cir. 2015) (indicating 37 C.F.R. § 42.20(c) is “plainly applicable to motions to amend filed during [*inter partes* reviews]”); but see *In re Aqua Products*, No. 2015-1177, 2016 WL 4375651, at *1 (Fed. Cir. Aug. 12, 2016) (order granting rehearing *en banc* to address burdens of persuasion and production regarding motions to amend under 35 U.S.C. § 316(d) and vacating *In re Aqua Products*, 823 F.3d 1369 (Fed. Cir. 2016)).

B. Nature of Substitute Claims and Parties’ Contentions

Patent Owner proffers claim 8 as a substitute for claim 1 of the '993 patent. Mot. Amend, Claim App’x. Substitute claim 8 is reproduced below:

8. A container for a spillproof drinking assembly, comprising:
a container body having a first upper open end and a lower closed end;

a neck extending cylindrically outward and away from the first upper end of the container body, the neck including at least one threaded fastener on an outer surface of the neck to receive a cap,

wherein an outer surface of an upper end of the container body extends below the neck radially outward to define a shoulder;

a platform is disposed on the shoulder; and

a snap projection is disposed on the platform, wherein the snap projection extends upward, away from the platform to a predetermined height;

wherein “an outer surface of an upper end of the container body extends below the neck radially outward to define a shoulder” means “an outer surface of an upper end of the container body extends down from the neck radially outward to define an outwardly-extending area having a top surface that slopes downwardly in a non-concave manner, the shoulder being located where the neck joins the container body”; and

wherein “a platform is disposed on the shoulder” means “a structural feature distinct from the shoulder and the container body and disposed on the shoulder to change the contour of the shoulder”.

Id. (emphasis added to show text added to claim 1).

Patent Owner characterizes the substitute claim as conforming to “the claim constructions adopted by the United States District Court for the Central District of California after a lengthy claim construction process in *Munchkin, Inc. v. Luv N’ Care, Ltd.*, No. 13-cv-06787-JEM (C.D. Cal. Aug. 27, 2015), Dkt. No. 101. (Exh. 2017).” *Id.* at 2. Patent Owner further asserts that substitute claim 8 would not enlarge or change the scope of the claims as properly construed by the district court. *Id.* at 2, 6–9. Patent Owner asserts that substitute claim 8 is supported by the ’993 patent (*id.* at

9–11), and that the substitute claim 8 is further distinguished over the material prior art (*id.* at 11–24). Patent Owner also points to the original specification of the '993 patent as fully supporting the substitute claims. *Id.* at Claim App'x 3–8.

Petitioner asserts that the substitute claim fails to meet the procedural requirements concerning motions to amend set forth in the above-cited cases. In particular, Petitioner argues that Patent Owner's Motion to Amend should be denied because substitute claim 8 is broadening, lacks written description support, lacks support in the original disclosure, and is indefinite. Opp. Mot. 1.

Additionally, Petitioner asserts that Whiteman, Atkins, and other prior art of record are anticipatory references or otherwise renders substitute claim 8 obvious. Opp. Mot. 14–25.

C. Whether Substitute Claim 8 is Broadening

Petitioner contends that the proposed amendment would enlarge the scope of the “platform” limitation because the proposed amended claim expands the meaning of “platform” to “*any* structural feature that changes the contour of the shoulder.” Opp. Mot. 5. Petitioner cites to our Decision to Institute in which we adopted its broadest reasonable interpretation of the term “platform” as “a raised level surface” and argues that the plain meaning of “platform” requires the structure to be flat. *Id.* at 5 (citing Dec. 7); *see also* Pet. 5 (citing Ex. 1111). Petitioner further argues that substitute claim 8 would encompass a platform in the form of a pyramid even though a pyramid is not a level surface. Specifically, Petitioner provides as follows:

According to [Patent Owner]’s definition, even a pyramid would constitute a “platform” within Claim 8. However, a pyramid clearly is not within the scope of claim 1. Under any sensible interpretation of “platform,” a pyramid is not a *level* surface. But according to proposed Claim 8, because a pyramid would change the contour of the shoulder (putting aside indefiniteness queries for the moment), it would become a “platform.”

Id. at 5–6.

Patent Owner argues that the specification states that the platform “is preferably substantially flat,” and thus necessarily allows the platform to not be flat. Reply Mot. Amend 3 (citing Ex. 1001, 6:18–19). Patent Owner directs our attention to dependent claim 3 of the ’993 patent, and argues that the recitation in claim 3 of “platform that is substantially flat” (Ex. 1001, 10:26), “gives rise to an ‘especially strong’ presumption that claim 1 does not require such flatness.” *Id.* (citing *InterDigital Comms., LLC v. ITC*, 690 F.3d 1318, 1324–25 (Fed. Cir. 2012)). Patent Owner further argues as follows:

[Petitioner] further argues that a pyramid would qualify as a platform under claim 8, but not under claim 1. But the construction of the “platform” incorporated into claim 8 does not allow for structures that are not platforms, as [Patent Owner] did not excise the term “platform” from the claim. Instead, the construction merely brings clarity to how and where the platform appears. And claim 8 still requires a “snap projection” that is “disposed on the platform” and “extends upward, away from the platform.” Thus, a pyramid that renders this impossible would not qualify as a “platform” under the language of the claim.

Reply Mot. Amend 3.

We find Petitioner to have the more persuasive position. Patent Owner’s proposed amendments attempt to define expressly the phrase “a platform is disposed on the shoulder” recited in original claim 1. In doing

so, Patent Owner enlarges the scope of the platform element of the claim such that the “platform” may be any structural feature. There is insufficient evidence of record to support a conclusion that a person of ordinary skill in the art would equate a “platform” with the more abstract description of a structural feature that merely changes the contour of the shoulder. Rather, the evidence of record suggest that a platform, as understood by a person of ordinary skill in the art, would at least be substantially flat, if not indeed “a raised level surface,” which is the dictionary definition of the term “platform” presented by Petitioner. Ex. 1001, 6:18–19; Pet. 5 (citing Ex. 1111⁵); *see also*, Ex. 1001, 8:7–10 (describing a raised platform). Accordingly, we deny Patent Owner’s Motion to Amend because the proposed amendments set forth in substitute claim 8 enlarge the scope of original claim 1.

D. Other Challenges to Proposed Substitute Claims

Petitioner contends also that the proposed substitute claims are indefinite, lack written description support, and are unpatentable over prior art on record. Opp. Mot. Amend 6–12. Because we deny Patent Owner's motion to amend on the basis that the proposed amendments enlarge the scope of the claims of the patent, we do not reach or decide Petitioner’s other challenges with respect to substitute claim 8.

⁵ The *New Oxford American Dictionary* (3d ed.) (2010).

IV. ORDER

For the reasons given, it is
ORDERED that claims 1–7 of the '993 Patent are held unpatentable;
FURTHER ORDERED that Patent Owner's Motion to Amend is
denied; 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.

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