

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRUNSWICK CORP. and SEARAY BOATS, INC.,
Petitioner,

v.

COBALT BOATS, LLC,
Patent Owner.

Case IPR2015-01060
Patent 8,375,880 B1

Before RICHARD E. RICE, MITCHELL G. WEATHERLY, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Brunswick Corp. and SeaRay Boats, Inc. (collectively, “Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–6 (“the challenged claims”) of U.S. Patent No. 8,375,880 B1 (Ex. 1001, “the ’880 patent”). Paper 1 (“Pet.”). In our Decision on Institution (Paper 11, “Decision to Institute” or “Dec.”), we instituted a trial to review the patentability of claims 1–6 based on the following grounds:

References	Basis	Claims Challenged
Jaramillo ¹ and Curi ²	§ 103	1, 3, and 6
Jaramillo, Curi, and Bayliner ³	§ 103	1, 3, and 6
Jaramillo, Curi, Terry ⁴ , and Ord ⁵	§ 103	1, 3, and 6
McCrea ⁶ and Terleski ⁷	§ 103	1, 2, 4, and 6
Suiter ⁸	§ 102	5

Petitioner provides testimony from Charles Garriss, Ph.D. Ex. 1012 (“the Garriss Declaration”). Patent Owner provides testimony from Kevin Breen. Ex. 2051 (“the Breen Declaration”).

¹ U.S. Pat. No. 5,970,905, iss. Oct. 26, 1999 (Ex. 1003, “Jaramillo”).

² U.S. Pat. No. 7,314,019, iss. Jan. 1, 2008 (Ex. 1004, “Curi”).

³ BAYLINER 185, 195, 205, & 225 RUNABOUTS OWNER’S MANUAL SUPPLEMENT (2006) (Ex. 1005, “Bayliner”).

⁴ U.S. Pat. No. 4,462,485, iss. July 31, 1984 (Ex. 1007, “Terry”).

⁵ U.S. Pat. No. 4,293,967, iss. Oct. 13, 1981 (Ex. 1006, “Ord”).

⁶ U.S. Pat. No. 3,501,190, iss. Mar. 17, 1970 (Ex. 1008, “McCrea”).

⁷ U.S. Pat. No. 7,341,016, iss. Mar. 11, 2008 (Ex. 1009, “Terleski”).

⁸ U.S. Pat. No. 4,432,436, iss. Feb. 21, 1984 (Ex. 1010, “Suiter”).

Subsequent to institution, Cobalt Boats, LLC (“Patent Owner”) filed a Patent Owner Response. Paper 67 (“PO Resp.”).⁹ Petitioner filed a Reply to the Patent Owner Response. Paper 65 (“Pet. Reply”).¹⁰ Patent Owner additionally filed a contingent motion to amend, Paper 27 (“MTA”), Petitioner filed an opposition to that motion, Paper 36 (“MTA Opp.”), and Patent Owner filed a reply to that opposition, Paper 39 (“MTA Reply”). Pursuant to our authorization, Paper 42, Petitioner filed a sur-reply to Patent Owner’s MTA Reply, Paper 47 (“MTA Sur-reply”).

An oral hearing was held on July 14, 2016, and a transcript of the hearing is included in the record. Paper 72 (“Tr.”).¹¹ Subsequent to the oral hearing, we ordered additional briefing on claim construction. Paper 69 (“CC Order”). Pursuant to that order, the parties submitted the requested briefing. Paper 75 (“Pet. Br.”); Paper 77 (“PO Br.”).

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.

For the reasons that follow, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 1, 3, and 6 of the ’880 patent are unpatentable, but has failed to establish sufficiently that claims 2, 4, and 5 of the ’880 patent are unpatentable. Patent Owner has failed to establish patentability of proposed substitute claims 7, 9, and 12.

⁹ Paper 67 is a redacted version of Patent Owner’s Preliminary Response. Patent Owner additionally filed an unredacted version of the Preliminary Response (Paper 29), designated as “Board and Parties Only.”

¹⁰ Paper 34 is a redacted version of Petitioner’s Reply. Petitioner additionally filed an unredacted version of its Reply (Paper 65), designated as “Board and Parties Only.”

¹¹ Paper 72 is the redacted version of the transcript. A complete confidential version of the transcript is included in the record at Paper 71.

B. Related Proceedings

Petitioner and Patent Owner indicate that the '880 patent is the subject of the following co-pending federal district court case: *Cobalt Boats, LLC v. Sea Ray Boats, Inc.*, No. 2:150-cv-00021 (E.D. Va.).¹² Pet. 1; Paper 6, 2.

C. The '880 Patent

The '880 patent is directed to a retractable step for a boat swim platform. Ex. 1001, 1:17–18. Figures 2 and 3 illustrate the retractable step, and are reproduced below.

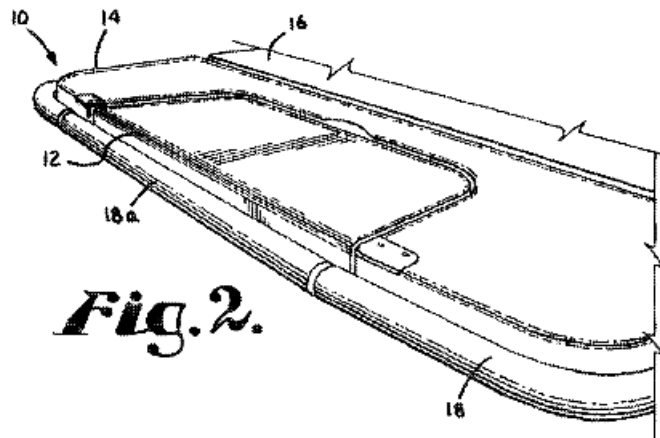


Figure 2 is a perspective view of the retractable step with step 12 in a stored position. *Id.* at 2:9–10.

¹² Both parties note that Patent Owner amended its complaint on February 23, 2015 to add Brunswick Corporation as a defendant. Pet. 1; Paper 6, 2.

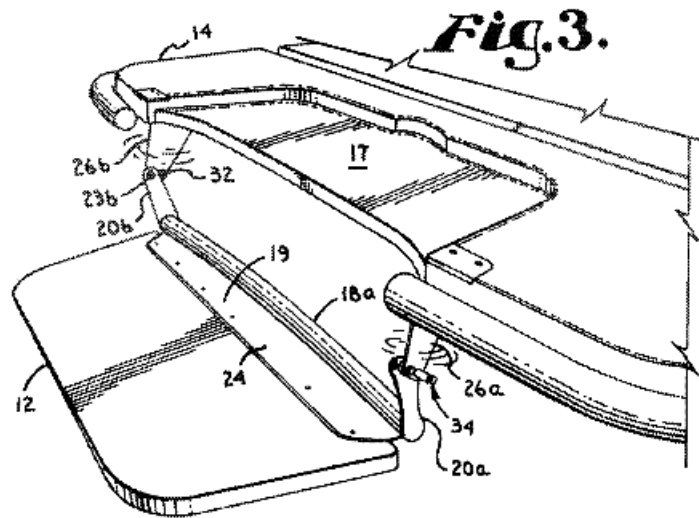


Figure 3 is a perspective view of the retractable step with step 12 in a deployed position. *Id.* at 2:11–12.

The retractable step includes step 12, base 14, movable arms 20a, 20b, stationary arms 26a, 26b, and lock 34. *Id.* at 2:26–3:6. Base 14 includes recess 17, which houses step 12 in the stored position. *Id.* at 2:41–43. Movable arms 20a, 20b are pivotally coupled to stationary arms 26a, 26b, with movable arms 20a, 20b secured to step 12 and stationary arms 26a, 26b secured to base 14. *Id.* at 2:54–55, 63–65. The pivotal coupling between movable arms 20a, 20b and stationary arms 26a, 26b is illustrated in Figure 4, reproduced below.

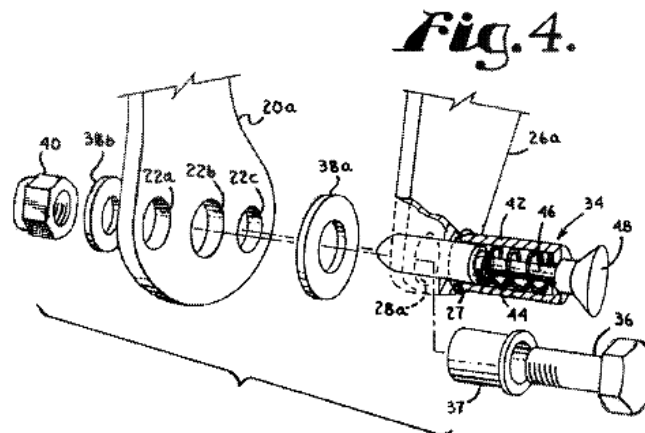


Figure 4 is an exploded view of the pivotal coupling between movable arm 20a and stationary arm 26a, and a sectional view of lock 34.

The '880 patent explains that “[b]olt 36, bushing 37, washers 38a and 38b, and nut 40 are used to pivotally couple moveable arm 20a and stationary arm 26a at aligned apertures 28a and 22b,” and that “[a]rms 20b and 26b are pivotally coupled in a similar manner using bolt 23b.” *Id.* at 3:10–14. Lock 34 includes hollow sleeve 42 secured to stationary arm 26a at lock aperture 27. *Id.* at 3:15–16. Spring 44 and pin 46 are located in sleeve 42, and spring 44 biases pin 46 in the locking position extending out of the end of sleeve 42. *Id.* at 3:17–18. The '880 patent notes that “[p]in head 48 at one end of pin 46 is of a size and shape that will allow a user to easily pull pin 46 into its unlocked position, i.e., within sleeve 42.” *Id.* at 3:19–21.

D. Illustrative Claims

As noted above, Petitioner challenges claims 1–6. Claims 1, 5, and 6 are independent claims, with claims 2–4 depending from claim 1. Claims 1, 5, and 6 are reproduced below:

1. A retractable step for use with a boat in water comprising:
 - a base having a recess;
 - a pair of stationary arms, each of said arms coupled with said base;
 - a pair of moveable arms, each of said moveable arms coupled with one of said stationary arms;
 - a step having a top side and an underside, said step coupled with said moveable arms and capable of being rotated 180° between a stored position within said recess, wherein said underside is exposed, and a deployed position below the water surface, wherein said top side is exposed; and
 - a spring biased locking mechanism configured to hold at least

one of said moveable arms in a stationary position when said platform is in said deployed position and releasable to accommodate movement of said platform to said stored position.

Ex. 1001, 4:15–32.

5. A deployable swim step for use with a boat in water comprising:

a step having a top side and an underside;

means for coupling said step with the boat, said coupling means configured to permit rotation of said step 180° from a stored position above the water surface, wherein said underside is exposed, and a deployed position below the water surface, wherein said top side is exposed; and

means for locking said coupling means in a stationary position when said step is in said deployed position, said locking means further configured to accommodate movement of said step to said stored position.

Id. at 4:39–51.

6. A method of deploying a retractable step used with a boat in water, said method comprising:

providing a base having a recess;

providing a step having a top side and an underside, said step moveably coupled with said base and positioned within said recess when in a stored position, wherein said underside is exposed;

providing a spring biased locking mechanism to hold said step in said stored position;

disengaging said locking mechanism;

rotating said step 180° out of said recess and into a deployed position below the water surface, wherein said top side is exposed; and

reengaging said locking mechanism to hold said step in said deployed position.

Id. at 4:52–65.

II. ANALYSIS

A. Claim Construction

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). We construe the claims using the broadest reasonable construction in light of the '880 patent Specification. See 37 C.F.R. § 42.100(b). Applying that standard, we interpret the claim terms of the '880 patent according to their ordinary and customary meaning in the context of the patent's written description. See *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor is entitled to be his or her own lexicographer of patent claim terms by providing a definition of the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a definition, however, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Petitioner and Patent Owner propose specific constructions for several limitations. Pet. 9–19; Pet. Br. 1–5, 8–15; PO Resp. 9–19; PO Br. 1–14. We determine that only the following express constructions are required in order to reach our Decision.

1. “recess” (claims 1 and 6)

Claims 1 and 6 each recite “a base having a recess.” Petitioner contends, for example, that “[t]he ordinary meaning of ‘recess’ encompasses an ‘alcove’ or ‘indentation.’” Pet. 11 (citing Ex. 1013 (definition from Dictionary.com)). Petitioner notes that the preferred embodiment of the '880 patent “depicts a form-fitting recess into which step 12 fits to provide a

uniform level surface,” but contends that “the claims are not limited to this preferred embodiment.” *Id.* Accordingly, Petitioner contends that “a person of ordinary skill in the art at the time of the invention would determine that the broadest reasonable interpretation of ‘recess’ in light of the specification is: *an indentation or alcove.*” Pet. 11.

Patent Owner responds that the “recess” recited in the claims requires “an alcove or indentation [] that corresponds in shape to the step such that the underside of the step lies flush with the top of the base to define a level surface when in the stored position.” PO Resp. 12 (emphasis omitted). Patent Owner contends that the recitation in claims 1 and 6 that the step is “within the recess” with its “underside exposed” in the stored position requires that the recess is “configured to receive the step” and that “one of skill in the art understands that the purpose of the recess is to ‘store’ the step on the swim platform, which clears the platform of trip hazards and other obstacles.” *Id.* at 11. Patent Owner also cites the Specification of the ’880 patent as supporting its proposed construction. *Id.* at 15–16 (citing Ex. 1001, 1:55–62).

The plain language of the claim does not require any specific arrangement for the “recess” other than specifying that it houses the step in a stored position (i.e., the step is “within the recess” with its “underside exposed” in the stored position), and we are not persuaded that the cited portions of the Specification provide a special meaning for the term. *See, e.g.,* Ex. 1001, 1:55 (referring to “one embodiment”). We are apprised of no reason to depart from the plain and ordinary meaning of “recess” noted by Petitioner. Accordingly, we construe the “recess” recited in claims 1 and 6

as an alcove or indentation, without any further requirement that the alcove or indentation be form-fitted to the step.

2. “arm” (claim 1)

Claim 1 requires “a pair of stationary arms” and “a pair of movable arms.” Petitioner contends that the “arms” should be construed as projections. Pet. 11–12. Patent Owner responds that “[w]hile an arm may be a projection, one skilled in the art—including Brunswick’s own expert, Dr. Garris—would not consider all projections (such as pivot pins and hinges) to be arms.” PO Resp. 12 (citing Ex. 2018, 208:23–209:10). Patent Owner proposes that

the broadest reasonable interpretation of “stationary arm” is: *an immobile structure projecting outwardly from the base and configured to be coupled with the moveable arms beyond the perimeter of the base*, and the broadest reasonable interpretation of “moveable arm” is: *a rotatable structure projecting outwardly from the step and configured to be coupled with the stationary arms beyond the perimeter of the step*.

Id. at 14. Our Decision on Institution provided a preliminary construction of “arm” consistent with that proposed in the Petition (i.e., “the arms recited in claim 1 encompass a projection”). Dec. 11. In view of the full record now before us, we agree with Patent Owner that the preliminary construction was overly broad. The additional limitations proposed in the Patent Owner Response regarding the extent of the arms being “beyond a perimeter” of the base or step, however, are overly narrow.

In order to assess adequately the proper construction of “arms,” we ordered additional briefing specifically directed to whether it would be “reasonable to construe ‘arm’ as ‘a slender part of a structure, machine or an instrument projecting from a main part, axis, or fulcrum’?” and “[e]ven if we

were to maintain a construction of ‘arm’ as a projection, is it reasonable to require that projection to be something other than a pivot or a fastener?” CC Order 2. Petitioner contends that both proposals in our order are overly narrow, Pet. Br. 1–5, while Patent Owner agrees with both proposals, PO Br. 1–9. Based on the record before us, we determine that although a projection may be an “arm,” it would not be consistent with the Specification of the ’880 patent to consider a pivot or a fastener, by itself, to be an “arm.” During his deposition, Petitioner’s declarant, Dr. Garris, even agreed that although “an arm is a projection . . . not all projections are arms.” Ex. 2018, 209:2–3.

Claim 1 recites that “each of said moveable arms [is] coupled with one of said stationary arms” and, as Patent Owner notes, the ’880 patent distinguishes between its arms and the pivot coupling. PO Br. 7 (citing Ex. 1001, 3:7–13). The ’880 patent describes movable arms 20a, 20b and stationary arms 26a, 26b, and separately describes a pivot coupling for those arms. Ex. 1001, 2:53–3:14. Petitioner contends that

neither the ordinary meaning nor the intrinsic evidence mandate that coupling requires structure separate from the structure being coupled. Accordingly, the broadest reasonable construction of “arms” that are “coupled” would encompass not **only** the preferred embodiment where the arms are **pivotally** coupled via two apertures and a bolt (Ex. 1001 at 3:12-13), but could also include coupling (the claim does not recite pivotally coupled) by broad means including welding, glue, a ball-and-socket joint, integral threading, a Morse taper (*see, e.g.*, U.S. Pats. 2,526,998 & 5,782,921), one arm with an aperture and the other with an integrated pivot or hook, or even magnetic attraction.

Pet. Br. 5. Petitioner further contends that “[t]he arms disclosed in the ’880 patent are both, as the disclosed coupling apertures (28) are part of the pivot structure, and the arms are part of the structure that fastens the step to the

boat.” *Id.* We agree with Petitioner that a “pivot structure” may be *part* of an arm. Although a pivot structure could be *part of* an arm, however, that pivot structure *by itself*, cannot reasonably be considered an arm. Petitioner provides no persuasive argument to the contrary.

Accordingly, we determine that the term “arm” encompasses a projection, but that projection must be something more than simply a pivot coupling or fastener.

3. “*exposed*” (*claims 1, 5, and 6*)

Claims 1, 5, and 6 each recite that the underside of the step is “exposed” in the stored position and the top side of the step is “exposed” in the deployed position. Petitioner contends that “[t]he specification provides no special definition of ‘exposed,’” and that “the ordinary meaning of ‘exposed’ encompasses ‘unconcealed.’” Pet. 14 (citing Ex. 1022 (definition from Dictionary.com)). Patent Owner contends that “exposed” requires upward facing. PO Resp. 17–18. Patent Owner, however, fails to identify anything in the claims or the Specification of the ’880 patent that imposes such a requirement, and at oral hearing acknowledged that it would be “fair” to characterize “exposed” as “just not covered.” Tr. 59:21–25.

Based on the record before us, we agree with Petitioner that the broadest reasonable construction of “exposed” is unconcealed. We are not apprised of anything in the claims, the Specification, or the prosecution history that requires a construction of “exposed” different from the plain and ordinary meaning of that term.

4. “*means for coupling said step with the boat*” (*claim 5*)

Claim 5 recites “means for coupling said step with the boat.” Petitioner acknowledges, and Patent Owner does not dispute, that this is a

means-plus-function limitation that should be construed in accordance with 35 U.S.C. § 112, ¶ 6.¹³ Pet. 17. We agree. Petitioner and Patent Owner disagree, however, as to the proper construction of this limitation.

A means-plus-function limitation “shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” 35 U.S.C. § 112, ¶ 6. Petitioner contends that the structure corresponding to “means for coupling” is “a movable projection pivotally coupled with a stationary projection coupled with the base coupled to the boat, and equivalent structures thereof at the time of patent issuance.” Pet. 17 (emphasis omitted). Patent Owner does not propose a specific construction in its Response and, instead, discusses the application of our preliminary construction of “means for coupling.” PO Resp. 57–60. That preliminary construction determined that the broadest reasonable interpretation of “means for coupling” covers “the structure used to couple to the step to the boat[, which] includes movable arms 20a, 20b, stationary arms 26a, 26b, and the pivotal coupling (bolt 36, bushing 37, washers 38a, 38b, and nut 40) . . . and equivalent structures at the time of patent issuance.” Dec. 13–14.

The main dispute between the parties is whether the structure described in the ’880 patent as corresponding to the “means for coupling” includes *two* (i.e., the pair of) movable arms 20a, 20b and *two* (i.e., the pair of) stationary arms 26a, 26b, as set forth in our Decision on Institution, or

¹³ Section 4(c) of the Leahy-Smith America Invents Act (“AIA”) re-designated 35 U.S.C. § 112, ¶ 6, as 35 U.S.C. § 112(f). Pub. L. No. 112-29, 125 Stat. 284, 296 (2011). Because the ’880 patent has a filing date before September 16, 2012 (effective date of § 4(c)), we will refer to the pre-AIA version of § 112.

only *a single one* of movable arms 20a, 20b and *a single one* of stationary arms 26a, 26b. The parties do not dispute that at least one of movable arms 20a, 20b is required in the structure corresponding to the “means for coupling” in the ’880 patent. Pet. Br. 9–13; PO Br. 9–12.

Petitioner provides no persuasive explanation as to why only *a single one* of movable arms 20a, 20b and *a single one* of stationary arms 26a, 26b is required as part of the structure corresponding to the “means for coupling” in the ’880 patent. The Petition acknowledges that the Specification of the ’880 patent “discloses that ‘Movable arms 20a and 20b are each pivotally coupled with metal stationary arms 26a and 26b, which in turn are coupled with base 14.’” Pet. 17 (quoting Ex. 1001, 2:63–65). Without explanation, Petitioner concludes that “the broadest reasonable interpretation of ‘means for coupling said step with the boat’ in light of the specification is: *a movable projection pivotally coupled with a stationary projection coupled with the base coupled to the boat, and equivalent structures thereof at the time of patent issuance.*” *Id.* In its Reply, Petitioner also fails to offer any meaningful explanation, simply alleging that “[t]he proper broadest reasonable construction should not require **pairs** of arms because **each** arm is corresponding structure performing the recited function.” Pet. Reply 11 (citing *Serrano v. Telular Corp.*, 111 F.3d 1578, 1583 (Fed. Cir. 1997)).

We agree with Patent Owner that the structure described in the Specification of the ’880 patent as corresponding to the “means for coupling” clearly includes at least the pair of movable arms 20a, 20b and the pair of stationary arms 26a, 26b. See Ex. 1001, 2:53–65.

B. Obviousness over Jaramillo and Curi

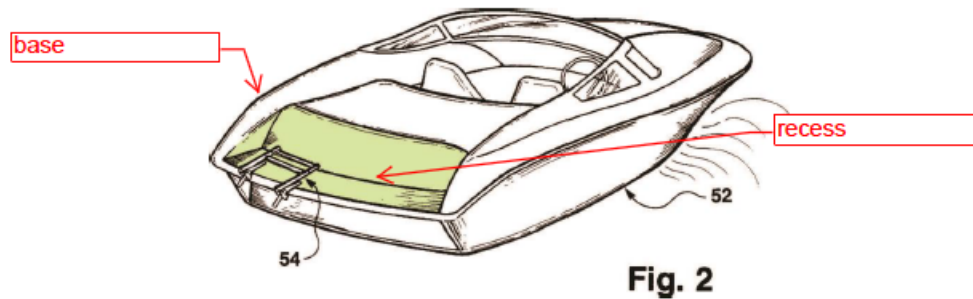
Petitioner contends that claims 1, 3, and 6 would have been obvious over Jaramillo and Curi. Pet. 19–28. Patent Owner disagrees. PO Resp. 51–54. We have reviewed the Petition, the Patent Owner Response, and the relevant evidence discussed in those papers and are persuaded by Petitioner’s contentions.

Claim 1 is directed to a “retractable step,” and claim 3 depends from claim 1. Petitioner contends that Jaramillo teaches each limitation of claims 1 and 3, except the “spring-biased locking mechanism.” Pet. 19–23, 25. Petitioner cites Curi for this limitation, *id.* at 19, 24–25, and contends that “Curi also expressly teaches one of ordinary skill to combine its locking mechanism with the retractable step of Jaramillo,” *id.* at 25 (citing Ex. 1004, 1:21–23, 4:32–4). Claim 6 is directed to a method of operating a swim step, and the majority of Petitioner’s contentions regarding claim 6 are similar to those regarding claim 1. *See id.* at 25–28.

With respect to this ground, Patent Owner’s arguments are directed to whether Jaramillo teaches “a base having a recess” and “a step . . . capable of being rotated 180° between a stored position . . . wherein said underside is exposed, and a deployed position below the water surface, wherein said top side is exposed.” PO Resp. 51–54. Patent Owner does not address specifically Petitioner’s contentions regarding the other limitations recited in claim 1 or 6 or those recited in dependent claim 3, or Petitioner’s rationale for combining the teachings of Jaramillo and Curi.

Jaramillo is directed to “a boat or watercraft step.” Ex. 1003, 1:7. Petitioner contends that “[t]he entire boat of Jaramillo comprises the claimed base” and “[t]he rear of the boat includes the claimed recess, *i.e.*, an

indentation or alcove, which is shown by light green highlighting to Jaramillo Fig. 2.” Pet. 20. Petitioner’s annotated version of Figure 2 from Jaramillo, found on page 20 of the Petition, is reproduced below.



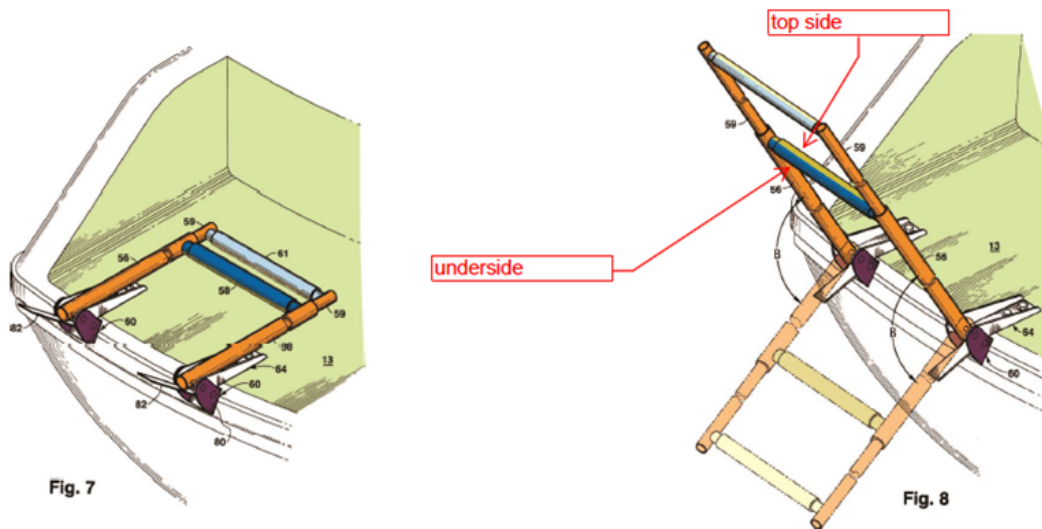
Petitioner’s annotated version of Figure 2 from Jaramillo is a perspective view of a boat with a ladder mounted to the top of a rear platform of the boat, and includes Petitioner’s labels of what it considers as corresponding to the recited “base” and “recess.”

Patent Owner responds that “[o]ne of skill in the art would not consider the entire boat the ‘base’ as Brunswick has done here . . . because the claims of the ’880 Patent distinguish between a ‘boat’ and a ‘base.’” PO Resp. 52. In support of its position, Patent Owner notes that claim 2, which depends from claim 1, recites “said base is demountably coupled with the boat,” and argues that claim differentiation requires the base and the boat to be different in claim 1. *Id.* This is not persuasive. The ’880 patent explains that the base may be separate and demountable from the boat or integral with the boat. Ex. 1001, 3:22–28, 3:67–4:2. Indeed, claim 3, which Patent Owner fails to mention, even recites that “said base is integral with the boat.” Accordingly, claim 1 (as well as claim 6) encompasses arrangements where the base is integral with the boat or separate from the boat, and we are persuaded that Jaramillo’s boat defines an integral base as indicated on Petitioner’s annotated version of Figure 2 from Jaramillo shown above.

Patent Owner additionally contends that Jaramillo does not teach the recited recess because “the ladder does not fit into, ‘an alcove or indentation formed therein that corresponds in shape to the step.’” PO Resp. 51–52. That contention is not persuasive because it requires a narrower construction of recess, which we specifically rejected above.

We are persuaded that Petitioner has established sufficiently that at least the rear of Jaramillo’s boat corresponds to a base and defines an alcove or indentation (i.e., “a recess”) as indicated on the annotated version of Jaramillo’s Figure 2 shown above.

As for the “step . . . capable of being rotated 180°” (claim 1) and “rotating said step 180°” (claim 6), and the requirements of portions of the step being “exposed,” Petitioner cites Figures 7 and 8 of Jaramillo. Pet. 22–23, 27–28. Petitioner provides annotated versions of Figures 7 and 8, which are reproduced below.



Petitioner’s annotated version of Figure 7 from Jaramillo is a perspective view of the ladder in a stored position and includes blue highlighting on portions of the ladder steps. Petitioner’s annotated version of Figure 8 from

Jaramillo is a perspective view of the ladder in a deployed position and includes the blue highlighting from Figure 7, as well as yellow highlighting on portions of the ladder steps opposite the portions highlighted in blue.

Petitioner contends that “Jaramillo discloses rung 61, which is *a rest for a foot, the rest having opposing sides, i.e.,* the claimed step having a top side and an underside (highlighted in blue).” Pet. 22. Petitioner further contends that “[r]ung 61 is capable of being *rotated at least 180 degrees* between a stored position within the recess (highlighted in green in Fig. 7), and a deployed position, depicted in the shadow lines of Fig. 8.” *Id.* Petitioner notes that “[a]n underside (highlighted in blue) of the step is *unconcealed, i.e.,* exposed, when in the stored position, and the opposing side (highlighted in yellow) is *unconcealed* when in the deployed position.” *Id.* at 23.

Patent Owner responds by asserting that “exposed” requires the “exposed” surface to be facing upward. PO Resp. 53. As noted above in our discussion of claim construction, we do not read the claim as requiring any particular orientation for the surfaces of the step to be “exposed” and, instead, determine that “exposed” simply requires that a surface is not concealed. Under that construction, even if we consider the “top side” of the step to be the portion a user would step on and the “bottom side” to be the side opposite that “top side,” we are persuaded that Jaramillo teaches such an arrangement. There does not appear to be any dispute, and Jaramillo’s Figure 8 clearly shows, that the portion of its step a user would step on (the “top side”) is exposed in the deployed position, and Figure 7 shows at least a portion of the opposite side being exposed in the stored position.

Patent Owner's additional contentions relate to Jaramillo's step being rotatable *beyond* 180 degrees. *Id.* at 53–54. Specifically, Patent Owner contends that the claim limits rotation of the step to no more than 180 degrees. PO Resp. 17. Patent Owner contends that “the ’880 Patent specifically teaches the addition of a stop to prevent such rotation” and “one of ordinary skill in the art would not want the step of the ’880 Patent to rotate past 180° because it would create a downward sloping surface in the water, rendering it more slippery and less stable for use by a boater.” *Id.* We are not persuaded that the claim limits rotation to no more than 180 degrees. Rather, to meet the limitation, a step must be able to be rotated at least 180 degrees from the stored position. The plain language of the claims does not limit rotation of the step to 180 degrees. We are apprised of no other reason to limit the claim in that manner. Rather, the claims simply require that the step is “capable of being rotated 180°” (claim 1) or “rotating said step 180°” (claim 6). If a step is rotated more than 180 degrees, it necessarily has been rotated through 180 degrees. Patent Owner does not dispute, and we agree, that Jaramillo teaches over 180 degrees of rotation of its step, as is shown clearly in Figures 7 and 8.

As for the additional limitations not disputed by Patent Owner, we are persuaded by, and adopt, Petitioner's contentions that Jaramillo teaches stationary arms (depicted in purple in the annotated versions of Figures 7 and 8 above) and movable arms (depicted in orange in the annotated versions of Figure 7 and 8 above). *See* Pet. 21. We are also persuaded by, and adopt, Petitioner's contentions that Curi teaches a spring biased locking mechanism. *See id.* at 24; *see also* Ex. 1004, 3:61–62, 4:4–15, 4:18–20, Figs. 4, 4A, 5, 8. Petitioner's rationale for combining the teachings of Curi

with those of Jaramillo is also persuasive because, as Petitioner notes, Pet. 25, Curi expressly suggests using its locking mechanism with Jaramillo's swim step, Ex. 1004, 1:21–23, 4:32–34.

For the reasons set forth above, we are persuaded that Petitioner has established, by a preponderance of the evidence, that the features of claims 1, 3, and 6 are taught by the combination of Jaramillo and Curi and that one skilled in the art would have combined those teachings.

C. Additional Grounds Based on Jaramillo and Curi

Petitioner additionally contends that claims 1, 3, and 6 would have been obvious over Jaramillo, Curi, and Bayliner (Ground 2), Pet. 28–34, and that claims 1, 3, and 6 would have been obvious over Jaramillo, Curi, Ord, and Terry (Ground 3), Pet. 34–38. Petitioner contends that “Ground 2 is relevant only if the Board determines that the broadest reasonable interpretation of ‘recess’ requires an indentation form-fitted to the step and/or the broadest reasonable interpretation of ‘step having a top side and an underside’ requires a flat step with flat sides,” Pet. 28, and that “Ground 3 also is relevant only if the Board determines that the broadest reasonable interpretation of ‘recess’ requires an indentation form-fitted to the step and/or the broadest reasonable interpretation of ‘step having a top side and an underside’ requires a flat step with flat sides,” Pet. 34. As indicated above, we do not construe those limitations as requiring the additional features noted by Petitioner.

We initially instituted trial on those additional grounds even though our preliminary constructions also did not require the additional features noted by Petitioner because those claim constructions were not final, and could change after institution of trial. *See* Dec. 21–22. Because this

Decision is final, and we do not construe those limitations as requiring the additional features noted by Petitioner, we need not reach those additional challenges.

D. Obviousness over McCrea and Terleski

Petitioner contends that claims 1, 2, 4, and 6 would have been obvious over McCrea and Terleski. Pet. 38–47. We have reviewed the Petition, the Patent Owner Response, and the relevant evidence discussed in those papers. Based on the record now before us, we determine that Petitioner has failed to demonstrate, by a preponderance of the evidence, that claims 1, 2, 4, and 6 would have been obvious over McCrea and Terleski.

1. Claims 1, 2, and 4

Petitioner cites McCrea for the majority of limitations recited in claims 1, 2, and 4, and additionally cites Terleski for the locking features recited in claim 1, as well as the additional limitations recited in dependent claims 2 and 4. *Id.* at 38–45. With respect to the “stationary arms” recited in claim 1, Petitioner cites McCrea’s pins 10, which are illustrated in Figure 2 of McCrea, reproduced below. *Id.* at 40–41 (citing Ex. 1008, 2:31–32).

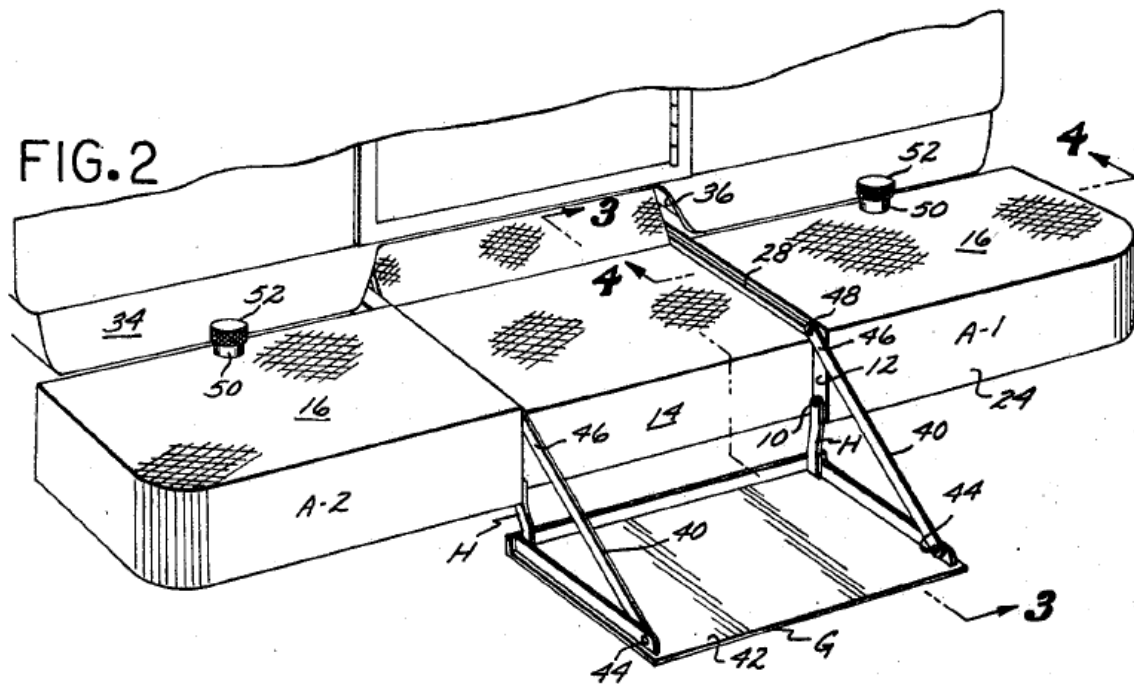


Figure 2 is a perspective view of McCrea's bumper assembly with the step in a deployed position. McCrea explains that "[a]rms H are pivotally supported at their upper ends by pins 10 that project outwardly from adjacent faces 12 of the reservoirs A-1 and A-2." Ex. 1008, 2:32-34.

Patent Owner contends that "one of ordinary skill in the art would not understand the pivot pin 10 of McCrea to be a 'stationary arm'" because "the pivot pin 10 is merely a fastener that extends transversely through the upper end of arms H and interior face of the bumper." PO Resp. 48-49 (citing 2051 ¶ 151). Patent Owner additionally points out that Petitioner's declarant, Dr. Garriss, "agrees that the pivot pin merely acts as a fastener that sticks out only far enough to hold arm H in place and to allow it to rotate around the pin." *Id.* at 50 (citing Ex. 2018, 197:3-198:11). In its Reply, Petitioner does not respond to those contentions, other than addressing

Patent Owner’s proposed constructions for “stationary arms” and “movable arms,” generally. *See* Pet. Reply 4–5, 12–18.

As noted above, we construe the “arms” recited in claim 1 as projections that are something more than simply a pivot coupling or fastener. In our order requesting additional briefing on claim construction, we authorized “the parties [to] use the briefing to address any impact a changed construction of ‘arms’ . . . may have on the challenges to claim[] 1.” CC Order 6. In that briefing, however, Petitioner does not address how McCrea teaches “stationary arms” under that construction. Pet. Br. 6–8. Petitioner, instead, states that Terleski includes stationary arms. Pet. Br. 7–8. The challenge, however, relies on McCrea for that teaching. *See* Pet. 40. Because McCrea’s pivot pin 10 is nothing more than a pivot coupling or a fastener, Petitioner has failed to establish sufficiently that McCrea teaches “stationary arms” as required by claim 1.

2. Claim 6

Claim 6 requires “rotating said step 180° out of said recess and into a deployed position below the water surface, wherein said top side is exposed.” In its challenge to claim 6 based on the combination of McCrea and Terleski, Petitioner contends that this limitation is “[d]isclosed by McCrea.” Pet. 46 (citing Ex. 1008, 3:14–16, Figs. 1, 2). Petitioner also directs us to “[s]ee discussion of limitation [1e] under Ground 4 above.” *Id.* (citing Ex. 1012 ¶ 105). The discussion of “limitation [1e]” referenced by Petitioner contends that “[b]elow the water surface’ does not define the claimed *apparatus* and so does not limit the claim.” *Id.* at 42 (emphasis added). This contention does not apply to claim 6, which recites a *method* requiring rotating the step below the water surface. Petitioner further

contends, however, that “it would be obvious to one of ordinary skill in the art to utilize this structure on a watercraft so that the step extended below the water surface, based on the teachings of Terleski or other references.” *Id.* (citing Ex. 1012 ¶ 94). The cited portions of the Garris Declaration simply repeat what is included in the Petition: that “it would be obvious to one of ordinary skill in the art to utilize this structure on a watercraft so that the step deployed below the water surface, based on the teachings of Terleski or other references.” Ex. 1012 ¶¶ 94, 105.

In our Decision on Institution, we made a preliminary determination that it was reasonably likely that one skilled in the art would have found it obvious to use McCrea’s step on a watercraft (or on some other structure) in a manner such that the step would be below the surface of water in a deployed position. Dec. 25. Patent Owner disputes that determination, and responds that neither McCrea nor Terlski teach this limitation, “[n]or has [Petitioner] presented any argument that would suggest such a modification of the references.” PO Resp. 47. Patent Owner further notes that there is “no explanation nor identification of ‘other references’ that allegedly support [Petitioner’s] obviousness position.” *Id.*

There appears to be no dispute, and we agree, that McCrea does not teach this limitation itself, as that reference is directed to a terrestrial vehicle with no mention of water. As for Terleski, Patent Owner contends that its swim platform is not designed to go below the surface of water and, instead, that swim platform is actually maintained above the water surface. *Id.* In its Reply, Petitioner does not dispute Patent Owner’s contentions and, instead, argues that “using a step on a boat in that manner . . . was well known and obvious.” Pet. Reply 17 (citing Ex. 1012 ¶¶ 94, 99; Ex. 2018 234:25–

235:6). Petitioner further contends that “[t]his conventional limitation is satisfied based on the knowledge of a person of skill in the art.” *Id.* (citing *MobileMedia Ideas LLC v. Apple Inc.*, 780 F.3d 1159, 1173 (Fed. Cir. 2015)). The Petition, however, did not allege that the limitation was a conventional one, satisfied based on the knowledge of a person skilled in the art. Rather, the Petition relied on the teaching being found in “Terleski or other references.” Pet. 42.

Petitioner offers no explanation as to how Terleski teaches this feature, nor does Petitioner even identify what these “other references” are. Petitioner’s new reliance on “the knowledge of a person skilled in the art” is improperly raised for the first time in its Reply. Nothing is identified as necessitating this new argument other than deficiencies in the Petition. Nevertheless, even if we were to consider that argument, it fails because it is based solely on Dr. Garris’ conclusion that such a feature would have been obvious with no further support. *See, e.g.*, Ex. 1012 ¶ 105 (stating that “it would be obvious to one of ordinary skill in the art to utilize this structure on a watercraft so that the step deployed below the water surface, based on the teachings of Terleski or other references”).

3. Summary

Based on the record before us, we determine that Petitioner has failed to establish, by a preponderance of the evidence, that claims 1, 2, 4, and 6 would have been obvious over McCrea and Terleski.

E. Anticipation by Suiter

Petitioner contends that claim 5 is anticipated by Suiter. Pet. 47–51. We have reviewed the Petition, the Patent Owner Response, and the relevant evidence discussed in those papers. Based on the record now before us, we

determine that Petitioner has failed to demonstrate, by a preponderance of the evidence, that claim 5 is anticipated by Suiter.

Petitioner cites Suiter as disclosing each limitation of claim 5. *Id.* Claim 5 requires “means for coupling said step with the boat.” As noted above, the structure described in the Specification of the ’880 patent as corresponding to the “means for coupling” includes at least the pair of movable arms 20a, 20b and the pair of stationary arms 26a, 26b. Petitioner cites Suiter’s post 24 and brackets 18 as the structure corresponding to the “means for coupling” described in the ’880 patent (at least as the structure corresponding to the arms). Pet. 48–49. Petitioner concludes that, accordingly, “Suiter discloses structure that is *a movable projection pivotally coupled with a stationary projection coupled with the base coupled to the boat, and equivalent structures thereof at the time of patent issuance.*” *Id.* (citing Ex. 1012 ¶¶ 110–111).

Patent Owner responds that Suiter’s post 24 is not a *pair* of movable arms. PO Resp. 59. We agree with Patent Owner that a single post (e.g., Suiter’s post 24) is not a pair of arms. Accordingly, Petitioner has failed to establish that Suiter discloses the structure from the ’880 patent corresponding to the “means for coupling.” Next, we turn to whether Suiter discloses an equivalent of that structure.

Although the Petition does not address whether equivalent structure is disclosed in Suiter, *see* Pet. 48–50, Patent Owner responds that “one of ordinary skill in the art would not view [Suiter’s] post 24 as an equivalent” to the pair of movable arms 20a, 20b in the ’880 patent, PO Resp. 59. In order to be an equivalent, there must be insubstantially different structure. *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267 (Fed. Cir. 1999)

(“the identical function recited in the claim and be identical or equivalent to the corresponding structure in the specification”). In support of its position, Patent Owner explains that “the post [in Suiter] does not support the step in the same manner as do the arms of the ’880 Patent” and that “if one of ordinary skill applied the bracket and post to the ’880 Patent, the post would have to be connected to and support the center portion of the step . . . [and] a sizeable plate (or brace) would need to be placed along the bottom side of the step for stability.” PO Resp. 59–60 (citing Ex. 2051 ¶¶ 195–197). As noted above, Exhibit 2051 is the testimony of Patent Owner’s Declarant, Mr. Breen, and the cited portions support Patent Owner’s position that Suiter’s structure, including the single movable arm (post 24), is a substantially different structure. *See, e.g.*, Ex. 2051 ¶ 197 (“If one of ordinary skill in the art were to apply the bracket and post of Suiter . . . there would need to be a sizeable plate, or brace placed along the bottom side of the step (in the center) to make the step stable.”).

Although Petitioner’s Reply states that “Suiter’s structure is certainly equivalent and thus within the scope of the limitation,” it offers little support for its position. Pet. Reply 11–12. Petitioner acknowledges that “[s]tructural equivalence under § 112, ¶ 6 is met when the differences are insubstantial.” *Id.* at 11 (citing *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267 (Fed. Cir. 1999)). Petitioner provides no reason, however, for us to find that using a single arm would not require the additional structure suggested by Mr. Breen noted above. In fact, Petitioner does not appear even to dispute that such structure would be required. Weighing the evidence before us, Petitioner has failed to establish sufficiently that a single

movable arm is insubstantially different from the structure described in the '880 patent.

Accordingly, we are not persuaded that Suiter discloses structure equivalent to that in the '880 patent corresponding to the “means for coupling.”

F. Secondary Considerations

As part of our obviousness analysis, we consider the evidence and arguments submitted by Patent Owner regarding secondary considerations of non-obviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). To be relevant, evidence of non-obviousness must be commensurate in scope with the claimed invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011). There must be a nexus between the merits of the claimed invention and the evidence of secondary considerations. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). “Nexus” is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in determining non-obviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988).

Patent Owner contends that “objective indicia related to commercial success, copying, long-felt but unsolved needs, and failure of others, presented herein establishes the patentability of the challenged claims.” PO Resp. 23.

1. Copying

Patent Owner alleges that Petitioner copied the claimed invention (i.e., Patent Owner’s swim step). *Id.* at 23–26. “[C]opying requires the replication of a specific product.” *Iron Grip Barbell Co. v. USA Sports, Inc.*,

392 F.3d 1317, 1325 (Fed. Cir. 2004). In support of its allegations of copying, Patent Owner contends that

Brunswick admits that it knew of the Cobalt Swim Step feature before it began designing its own Swim Step, that the Cobalt Swim Step influenced Brunswick to design its Swim Step, and that it consulted or reviewed at least one Cobalt Swim Step both prior to and during the design process which began in March 2012.

PO Resp. 24. Petitioner responds that rather than copying, it made a concerted effort to *avoid* copying, including design-around efforts to avoid Patent Owner's locking mechanism. Pet. Reply 22–23.

Claims 1, 3, and 6 each require a “spring biased locking mechanism.” Patent Owner does not dispute that Petitioner's swim step, which is allegedly the result of copying Patent Owner's swim step, fails to include this feature. See PO Resp. 26 (noting that Petitioner “claims its Swim Step does not have a locking mechanism” and “that [Petitioner] says it consciously avoided [that feature],” without disputing those contentions). Patent Owner fails to direct us to any authority that supports its position that copying can be established when an alleged copier intentionally avoids copying (i.e., purposefully does not include claimed features).

Nevertheless, even if we were to accept Patent Owner's allegations of copying, they would not outweigh the case of obviousness for claims 1, 3, and 6 based on the combination of Jaramillo and Curi. In that combination, Petitioner cites Jaramillo as teaching each of the features recited in claims 1, 3, and 6, other than the “spring biased locking mechanism.” As explained above, the “spring biased locking mechanism” is the very feature that Petitioner sought to exclude from its design. Accordingly, the allegedly

“copied” portions of the claims are found in a single embodiment of a single prior art reference.

2. Commercial Success

Patent Owner alleges that evidence of commercial success weighs against a determination of obviousness of claims 1, 3, and 6. PO Resp. 25–32. Patent Owner relies on evidence of commercial success of both its swim step, *id.* at 27–29, as well as Petitioner’s swim step, *id.* at 29–30.

a. Patent Owner’s Swim Step

The only discussion provided in Patent Owner’s Response as to how its swim step includes the features recited in claims 1, 3, and 6 is a general allegation that “[t]he Cobalt Swim Step is offered on various Cobalt boats, is described by the ’880 Patent, and includes every limitation recited in Claims 1–5 of the ’880 Patent.” *Id.* at 23 (citing Ex. 2019 ¶¶ 4–6; Ex. 2051 ¶¶ 166–69). Paragraph 169 of the Breen Declaration (Ex. 2051) references Exhibit 2049, which is a claim chart mapping Patent Owner’s swim step to various claim elements. Initially, we note that such an incorporation by reference is inappropriate and Patent Owner’s contentions regarding commercial success fail for this reason alone, as Patent Owner’s Response fails to tie its swim step to the features of the claims. *See* 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”).

Furthermore, we are not persuaded that Petitioner has established the required nexus between the alleged commercial success and the claimed invention. “Evidence of commercial success, or other secondary considerations, is only significant if there is a nexus between the claimed invention and the commercial success.” *Ormco Corp. v. Align Tech., Inc.*,

463 F.3d 1299, 1311–12 (Fed. Cir. 2006). In some instances, there may be a presumption of nexus. *See WBIP, LLC v. Kohler Co.*, No. 2015-1038, 2016 WL 3902668, at *6 (Fed. Cir. July 19, 2016) (“[T]here is a presumption of nexus for objective considerations when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘is the invention disclosed and claimed in the patent.’”). Patent Owner contends, at least for its swim step, that such a presumption is appropriate in this case. PO Resp. 27. We disagree.

Claims 1, 3, and 6 are each directed to a swim step (or method of operating a swim step), and Patent Owner provides information regarding sales for its *boats* that include the swim step, rather than sales information for *swim steps individually*. *See* PO Resp. 28–29. A limited exception to the presumption of nexus exists where the patented invention is only a component of the product to which the asserted objective considerations are tied. *Demaco*, 851 F.2d at 1392. Here, the swim step is a component of the boat. Accordingly, Patent Owner enjoys no presumption of nexus. Petitioner contends that Patent Owner offers no meaningful discussion of nexus. Pet. 20–21. We agree. Indeed, Patent Owner simply alleges that sales of *boats* with swim steps have increased year-over-year without explaining why the claimed features of the swim step are responsible for the increase in sales. *See, e.g.*, PO Resp. 28–29.

Furthermore, even if nexus were established, Patent Owner does not provide information regarding sales volume or market share as compared to providers of competing products. Rather, Patent Owner offers evidence of its own sales. *See id.* This information, without market share information, is

only weak evidence, if any, of commercial success. *See In re Applied Materials, Inc.*, 692 F.3d 1289, 1299 (Fed. Cir. 2012).

b. Petitioner's Swim Step

Initially, we note that there is no discussion directed to how Petitioner's swim step includes the features recited in claims 1, 3, or 6 of the '880 patent in Patent Owner's contentions regarding commercial success. *See* PO Resp. 29–32. Patent Owner, instead, appears to rely on its allegations of copying discussed above. As noted above, however, Patent Owner has not established that Petitioner's swim step includes the “spring biased locking mechanism” required by claims 1, 3, and 6. Patent Owner fails to establish the requisite nexus between Petitioner's sales and the claimed invention. Also, similar to the deficiencies regarding its allegations of commercial success of its own swim step, Patent Owner fails to provide any information regarding market share when discussing Petitioner's alleged commercial success. *See* PO Resp. 29–30. In fact, Patent Owner makes no mention of Petitioner's sales, noting only that “25% to 35% of [Petitioner's] boats ordered include the option.” *Id.* at 29.

c. Licensing

In its discussion of alleged commercial success, Patent Owner additionally contends that it “has been approached by two of its direct competitors requesting [] a license.” *Id.* at 32. Patent Owner offers no further argument or evidence on this issue. This contention is also unpersuasive. Although licenses taken under the patent in suit may constitute evidence of non-obviousness, only little weight can be attributed to such evidence if the patentee does not demonstrate “a nexus between the

merits of the invention and the licenses of record.” *In re GPAC Inc.*, 57 F.3d at 1580 (internal quotation and citations omitted).

3. *Industry Praise*

Patent Owner alleges that industry praise supports a determination of non-obviousness. PO Resp. 33. As with commercial success, evidence of industry praise is only relevant when it is directed to the merits of the invention claimed. *See Ormco*, 463 F.3d at 1311. Patent Owner, however, offers no explanation as to how any of the alleged praise is due to specific features that are present in the claims.

4. *Long-Felt Need and Failure of Others*

Patent Owner alleges that long-felt need and failure of others supports a determination of non-obviousness. PO Resp. 33–38. To show a long-felt need, Patent Owner must introduce evidence to show when such a need first arose and how long this need was felt, and must introduce evidence to show that this need was met by the patented invention. *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1332 (Fed. Cir. 2009). “[L]ong-felt need is analyzed as of the date of an articulated identified problem and evidence of efforts to solve that problem.” *Tex. Instruments, Inc. v. U.S. Int’l Trade Comm’n*, 988 F.2d 1165, 1178 (Fed. Cir. 1993).

In support of its contentions regarding long-felt need, Patent Owner initially notes that “many of the references cited by the Petitioner are quite old (McCrea is over forty years old).” PO Resp. 33. This, by itself, is unpersuasive. *See Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004) (“Absent a showing of long-felt need or the failure of others, the mere passage of time without the claimed invention is not evidence of nonobviousness.”). Patent Owner further contends that

[t]here has been a long-felt need recognized by designers and manufacturers in the recreational boating industry for a manually operable feature or device that would provide a more aesthetically pleasing and user friendly way for boaters (and their pets) to get into and out of the water from boats that dates back at least to 1971, and likely further.

PO Resp. 33–34 (citing Ex. 2019 ¶ 11; Ex. 2051 ¶¶ 154–165). Patent Owner notes complaints about traditional folding ladders and drawbacks of hydraulic platforms. *Id.* at 34–35. Patent Owner additionally contends that Petitioner failed to develop an alternative to its swim step. *Id.* at 36–38.

Patent Owner has failed to establish sufficiently a long-felt need for the claimed swim step. Patent Owner characterizes the need as being for “a more aesthetically pleasing and user friendly way for boaters (and their pets) to get into and out of the water from boats,” but at the same time acknowledges that hydraulic platforms already existed. *See* PO Resp. 33–35. Patent Owner fails to explain persuasively how these hydraulic platforms failed to meet that need. Patent Owner’s allegation of failure by others fails for reasons similar to its allegation of long-felt need.

G. Summary

Weighing all of the evidence before us, Patent Owner’s contentions regarding secondary considerations of non-obviousness do not overcome the strong case of obviousness of claims 1, 3, and 6 over Jaramillo and Curi. Accordingly, we are persuaded that Petitioner has established, by a preponderance of the evidence, that claims 1, 3, and 6 would have been obvious over Jaramillo and Curi.

III. MOTION TO AMEND

Patent Owner moves to substitute claims 7–12 for claims 1–6, respectively, if we determine claims 1–6 to be unpatentable. MTA 1. Because we determine that Petitioner has established, by a preponderance of the evidence, that claims 1, 3, and 6 are unpatentable, but not that claims 2, 4, and 5 are unpatentable, Patent Owner’s motion to substitute claims 7, 9, and 12 for claims 1, 3, and 6 is before us.

A. Proposed Substitute Claims

Proposed substitute claims 7 and 12 are independent, and are reproduced below.

7. A retractable step for use with a boat in water comprising:

a base on a boat, said base having an upper, upward facing surface with a recess formed therein;

a pair of stationary arms, each of said arms coupled with said base and extending outwardly from said base to a second end beyond the perimeter of said base;

a pair of moveable arms, each of said moveable arms coupled with the second end of one of said stationary arms;

a flat step having a top side and an underside when in a deployed position, said top side and underside defining opposed surfaces that are each configured to support a seated user, said step coupled with said moveable arms and capable of being rotated 180° to flip the step between a stored position within said recess, wherein said underside surface is exposed and positioned facing up, and a deployed position below the water surface, wherein said top side surface is exposed and positioned facing up;

wherein said recess corresponds in shape to said step such that said underside surface lies flush with the upper surface of said base to define a level surface when said step is in the stored position; and

a spring biased locking mechanism configured to hold at

least one of said moveable arms in a stationary position when said platform is in said deployed position and releasable to accommodate movement of said platform to said stored position.

MTA 1–2.

12. A method of deploying a retractable step used with a boat in water, said method comprising:

providing a base on a boat having an upper, upward facing surface with a recess formed therein;

providing a flat step having a top side and an underside when in a deployed position, said top side and underside defining upper and lower opposed surfaces that are each configured to support a seated user, said step moveably coupled with said base and positioned within said recess when in a stored position, wherein said underside surface is exposed and positioned facing up;

providing a spring biased locking mechanism to hold said step in said stored position;

disengaging said locking mechanism;

rotating said step 180° to flip the step out of said recess and into a deployed position below the water surface, wherein said top side surface is exposed and positioned facing up;

reengaging said locking mechanism to hold said step in said deployed position.

Id. at 4–5.

B. Analysis

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 Prods.*, 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 Prods.*, 823 F.3d 1369 (Fed. Cir. 2016)). At a minimum, Patent Owner has the burden of showing that (1) the substitute claims are patentable over the prior art asserted against claims 1, 3, and 6 in the instituted challenges and (2) its request meets all the procedural requirements concerning motions to amend set forth, for example, in our rules, *Idle Free Sys., Inc. v Bergstrom, Inc.*, Case IPR2012-00027 (PTAB June 11, 2013) (Paper 26) (informative), and *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42) (precedential).

We are persuaded that Patent Owner has satisfied the procedural requirements set forth in our rules. We disagree with Petitioner’s contention that the amended claims are not supported by the written description of the ’880 patent. MTA Opp. 2–3. Petitioner contends that a number of features are not supported by the original disclosure, including the step having surfaces “configured to support a seated user” and that the step is capable to being rotated 180 degrees “to flip the step.” *Id.* at 2–3. With respect to the surfaces of the step being “configured to support a seated user,” however, Petitioner acknowledges that “the specification discloses that the surfaces may be used for sitting.” *Id.* at 2. Furthermore, the ’880 patent explicitly states that in the stored position “the underside of step 12 is flush with the top surface of base 14, thus restoring full functionality to base 14 as a platform with a level surface that may be used for standing, sitting, or storage,” Ex. 1001, 3:47–50, and “[w]hen in the deployed position, step 12

provides a seat on which swimmers may rest while partially submerged in the water,” *id.* at 3:61–64. As for the ability to “flip the step,” we are apprised of no reason why that is not disclosed by at least the illustration in Figures 2 and 3 of the ’880 patent, which shows the stored and deployed positions of the step.

Although we are satisfied that Patent Owner has met the procedural requirements set forth in our rules, we are not persuaded that Patent Owner has met its burden of showing that substitute claims 7, 9, and 12 are patentable.¹⁴ For example, the Petition asserted the combination of McCrea and Terleski as rendering original claims 1, 3, and 6 obvious, and cited McCrea for the majority of features recited in claims 1 and 6. Pet. 38–47. Although we determined that Petitioner had not established unpatentability of claims 1, 3, and 6 (for which claims 7, 9, and 12 are substitutes) over McCrea and Terleski, that does not mean those claims are patentable over those references. Rather, we simply determined that Petitioner had not met *its burden* of establishing unpatentability of those claims. As noted above, in a Motion to Amend, the burden is on Patent Owner.

In its Motion to Amend, Patent Owner does not dispute that McCrea teaches the features of substitute claims 7 and 12, other than the base being on a boat and the stationary arms that extend beyond and below the base. MTA 11–15. For those features not disputed, Patent Owner’s analysis with respect to McCrea rests on McCrea allegedly being non-analogous art. See MTA 12–13. The Motion to Amend, however, offers no analysis as to why McCrea is non-analogous art. See *id.* at 12 (simply concluding that Patent

¹⁴ Patent Owner’s Motion to Amend fails to address patentability of claim 9 separately.

Owner “maintains its position that McCrea is not analogous art”); *see also id.* at 13 (again stating only that Patent Owner “maintains its position that McCrea is not analogous art,” while citing 28 paragraphs of the Breen Declaration without further explanation). In its Motion to Amend, Patent Owner never characterizes the field of endeavor or the problem addressed by the ’880 patent. To the extent Patent Owner implies that we should look to its arguments related to whether McCrea is analogous art in its Patent Owner Response because it “maintains the position,” we note that this is an improper incorporation by reference. *See* 37 C.F.R. 42.6(a)(3). This argument fails for that reason alone. Moreover, to the extent we were to consider the portions of Patent Owner’s Response addressing whether McCrea is analogous art, that discussion is ultimately one regarding whether Petitioner had met *its burden* in establishing McCrea as analogous art. *See* PO Resp. 42 (“[Petitioner] has not provided any evidence or information that validates an assertion—much less meets its burden—that McCrea is analogous prior art with respect to the ’880 Patent.”). Indeed, in its Patent Owner Response, Patent Owner also fails to characterize the field of endeavor or the problem addressed by the ’880 patent. Accordingly, Patent Owner has failed to establish that McCrea is non-analogous art.

With respect to the base being on a boat, Patent Owner fails to offer *any* explanation as to why one skilled in the art would not have found it obvious to use McCrea’s arrangement on a boat. *See* MTA 14 (stating that “[t]his [base on a boat] limitation distinguishes from McCrea” without further explanation). The same is true for the “stationary arms . . . extending outwardly from said base to a second end beyond the perimeter of said base”

recited in substitute claim 7.¹⁵ In addressing that limitation relative to McCrea, Patent Owner simply states that “[t]his limitation has been included to distinguish over the pivot pin 10 of McCrea asserted in the Petition to be a stationary arm.” *Id.* There is no discussion as to why this results in a patentable substitute claim. Petitioner points out these shortcomings, as well as others, and cites additional references not addressed in Patent Owner’s Motion to Amend to further support its contentions regarding unpatentability of the challenged claims. MTA Opp. 8–20.

In Response to Petitioner’s Opposition, with respect to McCrea, Patent Owner offers no further argument as to why one skilled in the art would not include McCrea’s step on a boat, and does not dispute that a number of additional references cited by Petitioner include stationary arms as recited in the substitute claims. MTA Reply 9–10. Rather, Patent Owner focuses on why one skilled in the art would not add stationary arms from those additional references into McCrea. *Id.* Patent Owner, however, misses the point. The question of patentability is not whether one skilled in the art would bodily incorporate an element from one reference into another, but whether the combined teachings of references render the claimed arrangement obvious. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Patent Owner fails to establish persuasively that one skilled in the art would not find the arrangement of the substitute claims obvious in view of at least the combination of McCrea and any one of the numerous other references cited by Petitioner, and acknowledged by Patent Owner, that teach stationary arms.

¹⁵ We note that this feature is not included in substitute claim 12.

In support of the patentability of the proposed substitute claims, Patent Owner additionally contends that it

presented evidence of long-felt unmet need, commercial success and copying tied specifically to the amended claim limitations – a *flat* step having opposing side surfaces *configured to support a seated user*, a seat that *flips* from one side *positioned facing up* to the other, a seat that fits *flush* into a recess resulting in a *level surface*.

MTA Reply 12. But Patent Owner provides no meaningful discussion of these secondary considerations of non-obviousness in its Motion to Amend or its Reply to Petitioner's Opposition to the Motion to Amend. In fact, Patent Owner does not even reference these secondary considerations in its Motion to Amend. Patent Owner's Reply to Petitioner's Opposition simply includes the general statement above, and proceeds to cite large portions of the record. We need not determine whether it is appropriate for Patent Owner to raise this issue for the first time in its Reply, as Petitioner contends, MTA Sur-reply 5–6, because that general discussion is insufficient. Again, we note that Patent Owner has the burden to establish patentability of the substitute claims, and its failure to offer *any* explanation to support its allegations regarding secondary considerations relative to the proposed substitute claims is fatal to those contentions.

Accordingly, Patent Owner has failed to meet its burden to establish patentability of the proposed substitute claims. In view of that determination, we need not reach Petitioner's additional contentions that a number of limitations in the substitute claims are indefinite.

IV. MOTIONS TO EXCLUDE

Petitioner and Patent Owner each filed motions to exclude evidence in this proceeding. Paper 46 (“Pet. MTE”); Paper 50 (“PO MTE”).

A. Petitioner’s Motion to Exclude

Petitioner moves to exclude portions of Exhibit 2094 (the Declaration of Kevin Breen in support of Patent Owner’s Motion to Amend), certain articles relied upon by Patent Owner (Exhibits 2003–2005, 2028, and 2029), as well as certain exhibits relied upon in Patent Owner’s Preliminary Response, but not relied upon in Patent Owner’s Response (Exhibits 2001–2013). Pet. MTE 1. Petitioner’s motion is moot with respect to the Declaration of Kevin Breen because even considering the portions of that Declaration relied on in Patent Owner’s Papers, we find in favor of Petitioner in denying Patent Owner’s Motion to Amend. Petitioner’s motion is also moot with respect to Exhibits 2001–2013, as those exhibits are not relied upon in Patent Owner’s post-institution filings or our Decision. Petitioner’s motion is also moot with respect to Exhibits 2028 and 2029, as Patent Owner’s arguments directed to industry praise also fail even considering those exhibits.

Accordingly, Petitioner’s Motion to Exclude is denied as moot.

B. Patent Owner’s Motion to Exclude

Patent Owner seeks to exclude portions of the deposition testimony of Paxson St. Clair. PO MTE 2–3. Patent Owner’s motion is moot, as that testimony is not relied upon in reaching our Decision.

Accordingly, Patent Owner’s Motion to Exclude is denied as moot.

V. CONCLUSION

For the foregoing reasons, we determine that Petitioner has established, by a preponderance of the evidence, that claims 1, 3, and 6 of the '880 patent are unpatentable, but has failed to establish that claims 2, 4, and 5 are unpatentable. Patent Owner has failed to establish patentability of proposed substitute claims 7, 9, and 12.

VI. ORDER

For the reasons given, it is

ORDERED that claims 1, 3, and 6 of the '880 patent are unpatentable;

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

FURTHER ORDERED that Petitioner's Motion to Exclude is denied as moot;

FURTHER ORDERED that Patent Owner's Motion to Exclude is denied as moot; 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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