

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MATTHEWS INTERNATIONAL CORP.,
Petitioner,

v.

VANDOR CORP.,
Patent Owner.

Case IPR2016-00112
Patent 8,104,151 B2

Before PHILLIP J. KAUFFMAN, SCOTT A. DANIELS, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. OVERVIEW

Matthews International Corp. (“Petitioner”) filed a corrected Petition (Paper 5, “Pet.”) requesting *inter partes* review of claims 1–14 of U.S. Patent No. 8,104,151 B2 (Ex. 1001, “the ’151 patent”). Pet. 1.¹ Vandor Corp. (“Patent Owner”) filed a Preliminary Response (Paper 11, “Prelim. Resp.”) to the Petition.² We instituted an *inter partes* review of all challenged claims of the ’151 patent. Paper 12 (“Dec.”).

Subsequently, Patent Owner filed a Patent Owner Response (Paper 19, “PO Resp.”), and Petitioner filed a Reply (Paper 21, “Pet. Reply”).

Petitioner and Patent Owner each filed at least one outstanding motion, which we discuss in Section II below.

We held an oral hearing on Tuesday, December 20, 2016, and a transcript is included in the record.³ See Paper 40 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the claims on which we instituted trial.

¹ The Board asked that Petitioner correct several problems related to the original Petition (Paper 1), to include refile properly numbered exhibits and a corrected Petition (Paper 5). See Paper 4 (requesting corrections), Paper 6 (requesting to expunge exhibits 1001–1009), Paper 7 (accepting corrected Petition). The pages of the corrected Petition are not numbered. We provide numbers, assuming that the page following the table of contents is page 1.

² In association with Patent Owner’s Preliminary Response, Patent Owner filed Exhibits 1009–1017. The Institution Decision ordered Patent Owner to refile those exhibits as Exhibits 2001–2009.

³ Patent Owner’s request for oral hearing is Paper 31. We expunged Paper 32 because it is a duplicate of Paper 31. See Tr. 5:4–15.

This case turns on the meaning of a “casket body” as claimed, and the associated showing in the prior art.

For the reasons that follow, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–14 of the ’151 patent are unpatentable.

B. RELATED PROCEEDINGS

The parties indicate that the ’151 patent is at issue in: *Vandor Corporation v. Matthews International Corp and Matthews International-Cremation Division*, No. 1:15-cv-00838-RLY-TAB (S.D. Ind.). Pet. 1; Paper 9; Paper 10, 2.

II. MOTIONS

A. PETITIONER’S MOTION TO EXCLUDE EVIDENCE

Petitioner moves to exclude Exhibits 2001 and 2004–2009. Paper 23 (Motion to Exclude), Paper 14 (objections).⁴ Patent Owner filed an opposition to the Motion (Paper 29) and Petitioner filed a Reply to the Opposition (Paper 34). Petitioner has the burden of establishing that the Exhibits at issue should be excluded. See 37 C.F.R. § 42.20(c), § 42.22. For the reasons that follow, Petitioner’s Motion is *denied*.

Petitioner objected to Exhibits 2001–2009 within ten business days of institution. See Paper 14 (filing objections on April 29, 2016), Dec. (instituting trial on April 21, 2016); 37 C.F.R. § 42.64(b)(1). Petitioner

⁴ We expunged Paper 16 because it is duplicate of Paper 14. See Tr. 4:15–25.

preserved that objection with regard to Exhibits 2001 and 2004–2009 by filing a Motion to Exclude. *See* Paper 23; 37 C.F.R. § 42.64(c).

Petitioner objected to Exhibits 2001 and 2004–2009⁵ based on relevance under Federal Rules of Evidence (Fed. R. Evid.) 401 and 403. Paper 14, 2–6. Patent Owner does not assert that these objections lacked the particularity or explanation required by 37 C.F.R. § 42.64(c). *See* Paper 29, *passim*.

As detailed below, the cases cited by Petitioner deal with the weight to be afforded evidence and not admissibility. Each of the challenged Exhibits are relevant, and the probative value of these Exhibits outweighs the danger of unfair prejudice because, in our subsequent claim construction, we give each exhibit the weight that is warranted.

1. *Exhibit 2001*

Exhibit 2001 contains the definitions of “casket” and “coffin” from the Merriam-Webster’s Learner’s Dictionary. “Casket” is defined as “coffin,” and “coffin” is defined as “a box in which a dead person is buried.” Ex. 2001, 2–3. The definition of “coffin” is accompanied by a figure. *Id.* at 4. Patent Owner relies on this Exhibit in support of the ordinary meaning of the claim term “casket.” *See, e.g.*, PO Resp. 3–4 (citing Ex. 2012 ¶ 63, which in turn cites to the definitions at Ex. 2001).

Petitioner contends that the definition of “casket” as a “coffin” is simply the substitution of one word for another, and has no probative value. Paper 23, 3. Petitioner contends that the definition of “coffin” and the accompanying figure would confuse the issues “because the figure in

⁵ For a list of exhibits, *see* PO Resp. *i*.

Exhibit 2001 shows a solid wood or metal coffin meant to go into the ground, not a cardboard box that can be *used* as either a cremation or rental casket.” *Id.* at 4 (comparing to Figure 1 of the ’151 patent). Petitioner elaborates that the claimed casket is a completely different container from the illustration accompanying the definition of coffin. *Id.* at 4–5. Petitioner contends that ’151 patent expressly criticizes traditional wood and metal coffins like the one depicted in Exhibit 2001, and according to Petitioner, such extrinsic evidence cannot be used to contradict intrinsic evidence. *Id.* at 5 (citing *Summit 6, LLC v. Samsung Telecommunications America, LLC*, 802 F.3d 1283, 1290 (Fed. Cir. 2015)).

Patent Owner contends that the definitions are relevant to the meaning of casket. Paper 29, 2–3. Petitioner responds by essentially reiterating what is set forth in the Motion. *Compare* Paper 34, 1–2, *with* Paper 23, 3–5.

The ordinary meaning of “casket” is a fact of consequence in this proceeding, and the definitions at Exhibit 2001 are relevant in that they tend to make the ordinary meaning, as purportedly reflected in the definitions, more probable. *See* Fed. R. Evid. 401. That probative value is not substantially outweighed by a danger of unfair prejudice because we will give that evidence the weight that is warranted in a proper claim construction.

None of the cases cited by Petitioner exclude extrinsic evidence. Rather, the cited cases stand for the proposition that “when intrinsic evidence resolves any ambiguity in a disputed claim term it is improper to

rely on extrinsic evidence.” See *Intel Corp. v. VIA Technologies, Inc.*, 319 F.3d 1357, 1367 (Fed. Cir. 2003).⁶

Consequently, Petitioner has not persuaded us that Exhibit 2001 is inadmissible under FRE 402.

2. *Exhibits 2004–2007 and 2009*

Exhibits 2004–2007 and 2009 are Petitioner’s Corporate Tree (Exhibit 2004), two of Petitioner’s patents (Exhibits 2005 and 2009), and two excerpts from the file history of one of those patent’s (Exhibits 2006 and 2007). Patent Owner contends that during prosecution of two of Petitioner’s patents, Petitioner asserted that the term “casket” carries patentable weight. PO Resp. 8–12 (citing Exs. 2004–2007, and 2009).

Petitioner contends that each of these exhibits provide information regarding unrelated patents, and because unrelated patents shed no light on construction of the ’151 patent, this information has no probative value, and can only serve to confuse the issues. Paper 23, 2–3, 6–11.

Patent Owner contends that although these exhibits are technically not prior art, they are more or less contemporaneous with ’151 patent and are relevant in that they are evidence of what a person of ordinary skill would understand the ordinary meaning of “casket.” Paper 29, 3–6. Petitioner responds by asserting that Patent Owner ignores the case law cited in Petitioner’s Motion.

The ordinary meaning of “casket” is a fact of consequence in this proceeding, and the information in Exhibits 2004–2007 and 2009 is relevant

⁶ *Intel Corp* is cited in *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 862 (Fed. Cir. 2004), which is cited in *Summit 6, LLC v. Samsung Telecommunications America, LLC*, 802 F.3d 1283, 1290 (Fed. Cir. 2015).

in that it tends to make the ordinary meaning as purportedly reflected in the evidence more probable. *See* Fed. R. Evid. 401. That probative value is not substantially outweighed by a danger of unfair prejudice because we will give that evidence the weight that is warranted in a proper claim construction.

Petitioner cites to *E.Digital Corp.* and *Texas Digital* in support of the contention that unrelated patents “cannot be used to construe claim terms in the ’151 Patent.” Paper 23, 1 (*E.Digital Corp. v. Futurewei Tech. Inc.*, 772 F.3d 723, 727 (Fed. Cir. 2014); *Texas Digital Sys. Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1211 (Fed. Cir. 2002)). These cases did not exclude unrelated patents. These cases, like those cited with regard to Exhibit 2001, relate to the weight of extrinsic evidence, not its admissibility.

Consequently, Petitioner has not persuaded us that Exhibits 2004–2007 and 2009 are inadmissible under FRE 402.

3. *Exhibit 2008*

Exhibit 2008 is *Classification Definitions for Class 27, Undertaking*. Patent Owner contends that use of the term “coffin” as a subclass makes clear that the term “coffin” has a meaning that lends patentable weight. PO Resp. 12.

Petitioner contends that in view of the claim construction provided in the Institution Decision, and

that this portion of the Manual of Patent Classification is irrelevant, Exhibit 2008 does not make any fact relevant to the grounds upon which trial was instituted more or less probable and any facts that might be established based on this exhibit is of no consequence in determining the issues on which trial was instituted.

Paper 23, 5–6. Petitioner adds that Exhibit 2008 would lead to confusion, a waste of time, and undue delay. *Id.* at 6.

Patent Owner contends that Exhibit 2008 is evidence regarding what a person of ordinary skill in the art would consider the ordinary meaning of “casket.” Paper 29, 3. Petitioner responds that Exhibit 2008 does not define “casket” and has no relevance or probative value. Paper 34, 4–5.

Exhibit 2008 includes the following statement:

This class includes coffins or caskets and portable coffin-cases for receiving and transporting dead bodies for burial; processes and apparatus for embalming and preserving the bodies of persons after death; and various attachments, accessories, and devices used in connection with the preparation of the bodies or employed at the time of interment at the grave, such as headrests, corpse-carriers, lowering devices, life-signals, and the like.

Ex. 2008, 1.

This Exhibit has a tendency to demonstrate that coffins and caskets are both devices for receiving and transporting dead bodies for burial processes. The ordinary meaning of “casket” is a fact of consequence in this proceeding, and the information in Exhibit 2008 is relevant in that it tends to make the ordinary meaning, as purportedly reflected in this exhibit, more probable. *See* Fed. R. Evid. 401. That probative value is not substantially outweighed by a danger of unfair prejudice because we will give that evidence the weight that is warranted in a proper claim construction.

Consequently, Petitioner has not persuaded us that Exhibit 2008 is inadmissible under FRE 402.

B. PATENT OWNER’S MOTION TO EXPUNGE PETITIONER’S MOTION FOR OBSERVATIONS

On June 24, 2016, Patent Owner cross-examined Petitioner’s expert Dr. Karvelis, regarding his Declaration. Ex. 2013 (Deposition Transcript); *see also* Ex. 1006 (Dr. Karvelis’s Declaration).

On July 21, 2016, Patent Owner filed its Response to the Petition. PO Resp. (Paper 19)

On October 3, 2016, Petitioner replied to Patent Owner’s Response. Pet. Reply (Paper 21).

On November 18, 2016, Petitioner filed a Motion for Observations on Cross Examination of Dr. Albert Karvelis. Paper 24 (“the Observations” or “the Motion for Observations”). This Motion included four observations.

On December 2, 2016, pursuant to our authorization, Patent Owner filed a Motion to Expunge Petitioner’s Motion for Observations on Cross-Examination of Dr. Albert Karvelis. *See* Paper 26 (order); Paper 27 (Patent Owner’s Motion).

Patent Owner contends that Petitioner’s observations were not authorized and should be expunged for two reasons: (1) the observations were not filed by the party taking the cross-examination, and (2) the cross-examination of Dr. Karvelis occurred before Petitioner’s last substantive paper was filed. Paper 27, 3–4. For the reasons that follow, we agree with Patent Owner.

A party may not enter a motion unless authorized by rule (Part 42) or a Board order.⁷ 37 C.F.R. § 42.20(b); *see also* 37 C.F.R. § 42.7(a)

⁷ For example, our rules permit a motion to exclude without prior Board authorization. 37 C.F.R. § 42.64(c).

(authorizing the Board to expunge unauthorized papers). Our Scheduling Order authorized a motion for observation on cross-examination to draw the Board's attention to relevant cross-examination testimony of a reply witness when no further substantive paper is permitted. *See* Paper 13, 5.

Petitioner's Motion for Observations was not authorized in two respects.

First, Petitioner's observations relate to the cross-examination of Dr. Karvelis by Patent Owner. *See* Ex. 2013. Accordingly, Petitioner is not the party taking the cross-examination. *See* Paper 27, 3; Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767–68 (Aug. 14, 2012) (“Trial Practice Guide”) (“The party taking the cross-examination files the observations.”); *see generally* *Seagate Tech. (US) Holdings, Inc. v. Enova Technology Corp.*, Case No. IPR2014-01178, slip op. at 5–6 (PTAB Oct. 28, 2015) (Paper 45) (granting Petitioner's Motion to Expunge Patent Owner's observations where Patent Owner did not take the cross-examination).

Second, as detailed above, the cross-examination occurred on June 24, 2016, before Petitioner filed its last substantive paper.⁸ *See* Paper 27, 3–4; Trial Practice Guide, 77 Fed. Reg. at 48,767–68 (motions for observation may be utilized to draw the Board's attention to testimony “[i]n the event that cross-examination occurs after a party has filed its last substantive paper on an issue”); *see generally* *Square, Inc. v. Protegrity Corp.*, Case CBM2014-00182, slip op. at 2–5 (PTAB Nov. 5, 2015) (Paper 56) (granting

⁸ Petitioner's Reply, Petitioner's last substantive paper, was filed on October 3, 2016.

Petitioner's Motion to Expunge Patent Owner's observations where cross-examination occurred before Patent Owner filed its last substantive paper).

Petitioner argues that observations 2 and 4 were previously addressed in Petitioner's Reply, and observation 3 was addressed in Patent Owner's Response. *See* Paper 28, 1–2. That the Observations were addressed in previously filed papers does not provide authorization for submitting those Observations.⁹ Petitioner's assertion that the content of the Observations is proper is likewise irrelevant to whether the Motion for Observations was authorized prior to filing. *See* Paper 28, 2–3.

For these reasons, Petitioner's Motion for Observations (Paper 24) was not authorized and will be expunged.

C. EXHIBITS 2012 AND 2013

Exhibits 2012 and 2013 were filed as confidential, but we are unable to locate a corresponding motion to seal or a properly executed protective order. If Patent Owner did not intend this information to be marked confidential, please refile as public documents. If Patent Owner intended this information to be confidential, please request a conference call.

III. THE CLAIMED SUBJECT MATTER

A. INTRODUCTION

The '151 patent is titled "Lightweight Casket Having Foldable Features." Ex. 1001, 1 (54).

⁹ This contention illustrates that Petitioner's Reply was Petitioner's opportunity to comment on the Deposition of Dr. Karvelis.

As background, the '151 patent describes it was known to use paper-based cremation containers because of low cost and because such containers are completely consumed during the cremation process. *Id.* at 1:15–28. These containers are roughly as bulky as traditional wood and metal caskets so that shipping is a premium and storage requires a relatively large area. *Id.* at 1:53–63. Shipping the container unassembled reduces these negative aspects, but assembly can be relatively complicated and time consuming. *Id.* at 1:64–2:3. Leakage of contents was another known problem with these containers. *Id.* at 2: 7–8. Consequently, there was a need for a cremation casket that reduces shipping costs without requiring complex assembly at the retail point of sale, and also reduces or prevents leakage. *Id.* at 2:4–15.

Casket arrangement 10 includes casket body 11 and lid 30.¹⁰ *Id.* at 3:38–40; Figs. 1, 2. Figure 1 follows.

¹⁰ Notably, the '151 patent uses the term “casket arrangement” to mean the casket body only, and also to mean the casket body with lid. *Compare* Ex. 1001, 3:38–40 (referring to casket arrangement 10 as including casket body 11 and lid 30) *with* claims 1 and 2 (reciting a lid in dependent claim 2 while claim 1 that does not include a lid is directed to a “casket arrangement”). *See Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004) (“[W]here the limitation that is sought to be ‘read into’ an independent claim already appears in a dependent claim, the doctrine of claim differentiation is at its strongest.”).

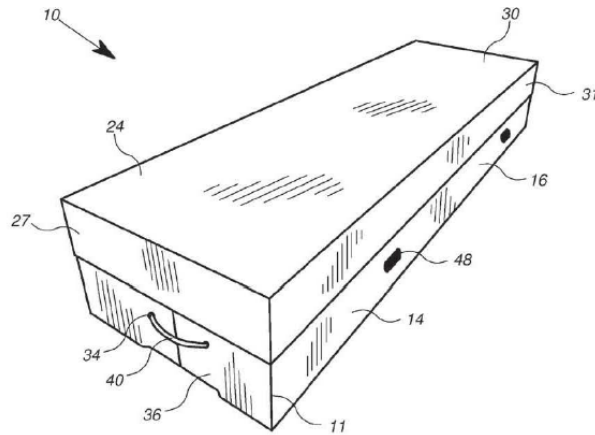


FIG. 1

Figure 1 is a perspective view of an embodiment of a casket in a first configuration. *Id.* at 3:6–8.

The '151 patent discloses a casket arrangement¹¹ having portions of the side and end panels that may be collapsed for a reduced shipping profile and a lid that may be used when the side and end panels are in either the fully assembled or the collapsed position. *Id.* at 2:26–32. An embodiment includes a bottom panel, side panels, and end panels, all formed intrinsically of a pliable material. *Id.* at 2:33–35. The side and end panels each include a lower section extending vertically upward from the bottom panel, and an upper section having two configurations. *Id.* at 2:35–39, 42–50.

¹¹ Here the '151 patent includes the lid as part of the arrangement. *See* Ex. 1001, 2:26–32.

Figure 5 follows:

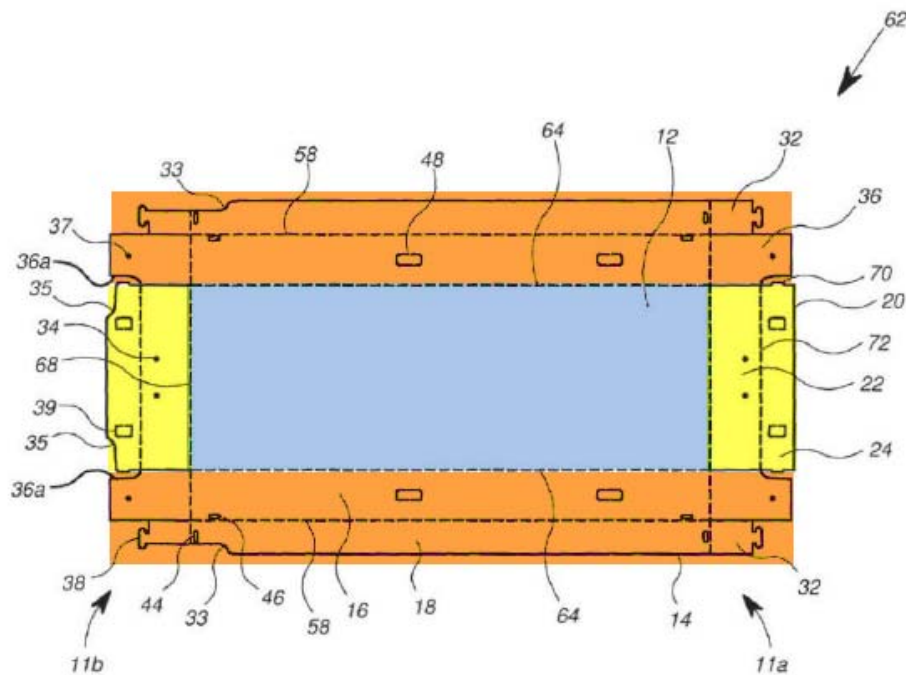


FIG. 5

Figure 5 is a top elevation view of the blank used to form the casket body. *Id.* at 3:16–17 (colors added for illustration). Casket body 11 includes bottom panel 12 (blue), first and second side panels 14 (orange), and first and second end panels 20 (yellow). *Id.* at 4:14–16. Side panels 14 are comprised of lower section 16 and upper section 18, with lower section 16 foldably attached to bottom panel 12 at edge 64. *Id.* at 4:23–27. End panels 20 are comprised of lower end panel 22 and upper end panel 24, with lower end panel 22 foldably attached to bottom panel 12 at edge 68. *Id.* at 4:53–60.

The casket arrangement¹² is capable of a first and a second configuration. In the first configuration (shown in Fig. 3, reproduced below), the upper panels of both the end and side panels extends vertically from its respective lower panels. *Id.* at 2:39–42. In the second configuration (shown in Figure 4, reproduced below), the upper panels of both the end and side panels extend other than vertically upward from its respective lower panel (Fig. 2). *Id.* Figures 3 and 4 follow:

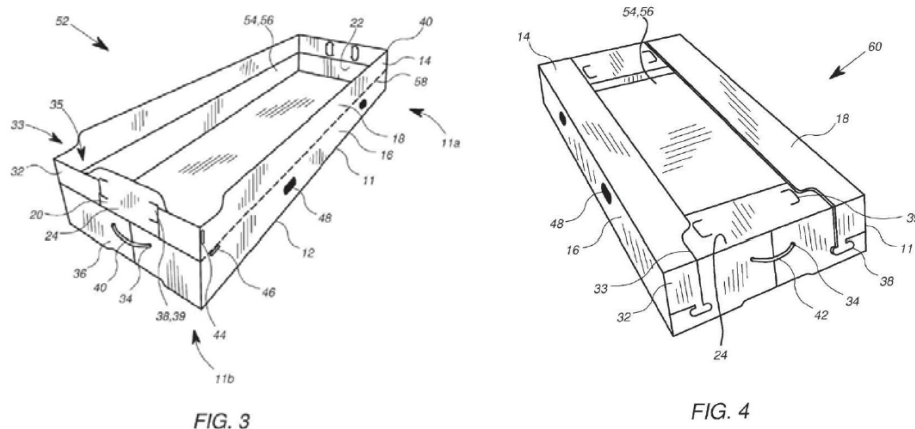


Figure 3 is a perspective view of the casket body in a first configuration, and Figure 4 is a perspective view of the casket body in a second configuration.

Id. at 3:12–15.

In the first configuration, as described in the Specification, casket body 11 forms a container for receiving the deceased. *Id.* at 3:41–43, Figs. 1, 3. In the second configuration, casket arrangement 10 is ready for shipment or storage. *Id.* at 3:62–4:4; Figs. 2, 4.

¹² As mentioned above, here the lid is included in the arrangement. *See* Ex. 1001, 2:26–32.

B. CHALLENGED CLAIMS

Of the challenged claims, independent claim 1 is illustrative and is reproduced below:

1. A casket arrangement having a first configuration and a second configuration, comprising:

a bottom panel formed of a pliable material;

side panels formed intrinsically with the bottom panel of the pliable material, each side panel including a lower section and an upper section foldably attached thereto, the lower section extending vertically upward from the bottom panel, the upper section in the first configuration extending upward from the lower section and in the second configuration extending in a direction other than vertically upward from the lower section;

end panels formed intrinsically with the bottom panel of the pliable material, each end panel including a lower end panel, and an upper end panel, the lower end panel extending vertically upward from the bottom panel and fixed in position, the upper end panel in the first configuration extending upward from the lower end panel and operably coupled to the upper section of at least one side panel, and the upper end panel in the second configuration extending in a direction other than vertically upward from the lower end panel: and

wherein the bottom panel, the side panels and the end panels form a casket body at least in the first configuration.

C. CLAIM INTERPRETATION

The Board interprets claims of an unexpired patent using the broadest reasonable construction. *See* 37 C.F.R. § 42.100(b).

For the purposes of this decision, and on this record, we determine that only the following claim terms require express interpretation. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)

(only those terms which are in controversy need to be construed, and only to the extent necessary to resolve the controversy).

Before addressing specific claim terms, we address a related matter. Petitioner requested authorization to file a motion to strike the portion of Patent Owner's Response pertaining to construction of the term "casket," arguing that it was an untimely request for reconsideration of our Institution Decision. *See* Ex. 3002 (requesting authorization). We denied the request, noting that claim construction in an institution decision is preliminary.

Paper 20, 1. Specifically, we stated that

the parties are hereby given notice that claim construction, in general, is an issue to be addressed at trial. Claim construction will be determined at the close of all the evidence and after any hearing. The parties are expected to assert all their claim construction arguments and evidence in the Petition, Patent Owner's Response, Petitioner's Reply, or otherwise during trial, as permitted by our rules.

Id.

The fact that each party asserted a claim construction during the trial (Patent Owner's Response and Petitioner's Reply) illustrates that the parties understood that claim construction was an open issue during the trial.

1. *"formed intrinsically"*

Independent claims 1 and 14 each require that the side and end panels are formed intrinsically with the bottom panel.

In the Institution Decision, we determined that claims 1 and 14 require the end and side panels to be formed intrinsically with the bottom panel in that the panels are formed of a single piece. Dec. 8–9. Petitioner does not challenge that determination. *See* Pet. Reply 1–16. Patent Owner "does not believe that the term requires any construction at all," but does not provide

an alternative construction or otherwise challenge our interpretation. PO Resp. 3. Given that neither party challenges our interpretation, we adopt it here.

2. “casket”

a) *Introduction*

Independent claim 1 is an apparatus claim directed to a casket arrangement having bottom, side, and end panels as specified. These panels are capable of a first and a second configuration, and, at least when in the first configuration, the arrangement forms a “casket body.” Similarly, independent claim 14 is an apparatus claim directed to a casket arrangement having bottom, side, and end panels that form a “casket body.”

Our inquiry is whether the claim term “casket body” is entitled to patentable weight, if so what is the meaning of that term.

In our Institution Decision, we determined that that the term carries patentable weight, and that a casket body as claimed must be capable of receiving a deceased human. Dec. 9–12.

Petitioner contends that the term “casket” is entitled to no patentable weight. In particular, Petitioner contends the claims are not limited to a human deceased, and are not limited in terms of the position of the deceased body within the container (*i.e.*, not limited to the supine position). *Id.* at 1–13. Patent Owner contends that the claims require a negative volume capable of containing a body of a deceased person in a supine position. PO Resp. 3–4.

Contrary to Petitioner’s contentions, the term “casket body” is entitled to patentable weight. Contrary to Patent Owner’s assertions, claims 1 and

14 are not limited to the remains of a deceased human, and are not limited to containing the deceased remains in the supine position.

For the reasons that follow, we determine that claims 1 and 14 require that the claimed arrangement is capable of receiving the remains of a deceased.

b) Analysis

“[T]he claims define the scope of the right to exclude; the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim.” *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998) (citations omitted). “[T]he resulting claim interpretation must, in the end, accord with the words chosen by the patentee to stake out the boundary of the claimed property.” *Id.*

Absent any special definitions, we give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). The specification and prosecution history compel departure from the plain meaning in only two instances: lexicography and disavowal. *Pacing Techs., LLC v. Garmin Int’l, Inc.*, 778 F.3d 1021, 1024 (Fed. Cir. 2015).

(1) Patentable Weight

Despite acknowledging that “casket body” as claimed requires the prior art to be capable of receiving the remains of a deceased, Petitioner goes on to more specifically assert that the claim term “casket” is an intended use that should be given no patentable weight. See Pet. Reply 4 (citing Pet. 6–7); see also Pet. 9, 12 (asserting the term “casket” in claim 1 carries no patentable weight).

Several reasons provided by Patent Owner for giving patentable weight to the term “casket” are unpersuasive, yet we agree with Patent Owner’s contention that Petitioner’s approach is incorrect because it reads the term “casket” out of the claims. *See* PO Resp. 3.¹³ We discuss the unpersuasive reasons, and then discuss the persuasive reason.

Patent Owner contends that Petitioner’s assertion that the claim term “casket” should be given no patentable weight is directly contradicted by the prosecution history of the application that became the ’151 patent. PO Resp. 7–8. In particular, Patent Owner asserts that the language “wherein the bottom panel, the side panels and the end panels form a casket body at least in the first configuration” was added for the specific purpose of obtaining allowance of the claims. PO Resp. 7–8 (citing Exs. 1008, 2002).¹⁴ Patent Owner elaborates that the amendment was required to clarify that the scope of the invention was limited to caskets. *Id.* at 8 (citing Ex. 2003).

Patent Owner’s contention is unpersuasive because Patent Owner mischaracterizes the prosecution history. The Office Action in question rejected claim 1 under 35 U.S.C. 112, 2nd paragraph because it did not recite sufficient structure to enable the lower end panel to be fixed in position. Ex. 1008, Office Action responsive to communications filed on November 3,

¹³ Petitioner cites to the original Petition at Paper 1 rather than the corrected Petition at Paper 5, but this distinction does not alter our analysis.

¹⁴ Exhibit 1008 is the file history of the ’151 patent, and its pages are not numbered. *See* 37 C.F.R. § 42.63(d)(2)(i). Exhibits 2002 and 2003 are portions of that file history, and should not have been filed without Board approval. 37 C.F.R. § 42.6(c). Patent Owner cites the Exhibits as a whole and does not identify any pages within these Exhibits.

2008, 3.¹⁵ The Action also indicated that claim 1 would be allowable if rewritten or amended to overcome that rejection, and indicated that claim 14 was allowable.¹⁶ *Id.* at 4. Consequently, this portion of the prosecution history does not support the contention that a “casket” as claimed is capable of containing the body of a deceased person in a supine position

Patent Owner contends that Petitioner’s own patents use the term “casket” as having patentable weight. PO Resp. 8–10 (citing Exs. 2005, 2009). As an example, Patent Owner contends that the prosecution history of one of Petitioner’s patents demonstrates that the term casket has structural weight. *Id.* at 11–12 (citing Exs. 2006, 2007).

To the extent the Patent Owner contends that Petitioner’s patents demonstrate that “casket” means an arrangement capable of containing the body of a deceased person in a supine position, we disagree. The cited patents are unrelated to the ’151 patent and shed little light on the meaning of casket as claimed. *See E.Digital Corp. v. Futurewei Tech. Inc.*, 772 F.3d 723, 727 (Fed. Cir. 2014) (stating that claims of unrelated patents must be construed separately). Even considering this evidence, Patent Owner has not identified with specificity, nor do we discern, a figure or description in the cited Exhibits that supports such an interpretation. *See* Exs. 2005–2007, 2009. Even if Petitioner’s patents use the term casket in a manner that has patentable weight, that sheds little if any light on use of the term in the claims of the ’151 patent.

¹⁵ We refer to native page number 3 of this Office Action.

¹⁶ Claim 14 was then claim 20.

Patent Owner contends that the Manual of Patent Classification for the United States Patent and Trademark Office also supports the assertion that “casket” is entitled to patentable weight. PO Resp. 12–13 (citing Ex. 2008). Our analysis here parallels that of the prior contention. We agree that the term “casket” should be given patentable weight, but the cited evidence provides no support for the contention that a casket capable of containing the body of a deceased person in a supine position. Although Class 27 includes coffins or caskets “for receiving and transporting dead bodies for burial,” this definition is not limited to a human body. Ex. 2008, 1.

We seek to give meaning to each word in the claim and for that reasons, we agree with Patent Owner that Petitioner’s approach is incorrect because it reads the term “casket” out of the claims. See PO Resp. 3; *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) (judging the patentability of a claim against the prior art requires considering all words in the claim); *Bicon Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (“[C]laims are interpreted with an eye toward giving effect to all terms in the claim.”); *Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (denouncing claim constructions that render phrases in claims superfluous).

Although each recitation of “casket body” is in a “wherein” clause, the claims at issue are apparatus claims rather than method claims, and the language defines a functional capability or intended use for the apparatus. Consequently, when evaluating the prior art, whether we consider the claim term “casket body” to be an intended use or a functional limitation, our inquiry remains essentially the same. Specifically, that inquiry is whether the prior art is capable of the claimed use or function. *Intel Corp. v. U.S. Int’l Trade Comm’n*, 946 F.2d 821, 832 (Fed. Cir. 1991) (explaining that

functional recitations in an apparatus claim are given weight in that the corresponding prior art structures must possess the capability of performing the recited function).¹⁷

Consequently, the claim term “casket body” is entitled to patentable weight in that the apparatus must have a structure capable of such use.

(2) Meaning of “casket body”

The Specification does not include a lexicographical definition of a “casket,” or a “casket body.” See PO Resp. 4–5 (acknowledging that the ’151 patent does not provide an “unconventional definition” of casket).

As proffered by Patent Owner, an ordinary meanings of “casket” is “a coffin,” which in turn means “a box in which a dead person is buried.”¹⁸ See PO Resp. 6 (citing definitions at Ex. 2001). As proffered by Petitioner, another ordinary meaning of “casket” is a container in which a pet is buried. Pet. Reply 4 (providing evidence of pet cemeteries at Ex. 1009). We consider these ordinary meanings in light of the Specification as viewed by a person of ordinary skill in the art.

The ’151 patent, titled “Lightweight Casket having Foldable Features,” describes as background that corrugated paper caskets were known low cost alternatives to wood and metal caskets, particularly for cremation. Ex. 1001 (54), 1:15–36. Simple rectangular paper caskets were an even lower cost alternative to ornately designed paper caskets, and were

¹⁷ In the Patentability section that follows, we further address Petitioner’s burden in relation to this claim construction.

¹⁸ The alternative ordinary meaning of coffin as “a small chest or box for jewelry or other valuable things” is not consistent with the Specification of the ’151 patent. See Dec. 10, n.10.

suitable for situations of financial need or in disaster areas having many deceased in a relatively small area. *Id.* at 37–48. Because cardboard caskets were as bulky as traditional wood and metal caskets, shipping and storage costs were a known drawback. *Id.* at 1:53–63. Although these costs can be lowered by shipping and storing the cardboard caskets unassembled, such assembly may be complicated and time consuming. *Id.* at 1:64–2:3. Thus, according to the ’151 patent, there was a need for a cremation casket with reduced shipping costs that did not require complex assembly at the retail point of sale. *Id.* at 2:4–6. A second problem identified was the need to prevent leakage of the casket contents. *Id.* at 2:7–15.

The Specification describes that “casket body 11 forms a container for receiving the remains of the deceased.” Ex. 1001, 3:42–43. Consequently, an interpretation that a “casket body” as claimed is a container for receiving the remains of the deceased is consistent with the Specification.

The Specification does not use either the term “human” or the term “supine position.” Nor does the Specification describe or depict the position of the deceased within the casket.

Patent Owner makes several contentions in support of the argument that claims 1 and 14 require a structure configured to contain the body of a deceased person in a supine position. For the reasons that follow, these arguments are not persuasive.

Claims 1 and 14 do not recite the terms “human” or “supine,” and consequently, Patent Owner’s contention that the claims require the arrangement to contain a deceased human in the supine position is not supported by the language of the claims. *See* PO Resp. 3–4; *Innova/Pure Water*, 381 F.3d at 1115 (“It is a ‘bedrock principle’ of patent law that ‘the

claims of a patent define the invention to which the patentee is entitled the right to exclude.”); *see also* Pet. Reply 3 (noting that claims 1 and 14 do not make reference to a human deceased or the supine position).

Patent Owner contends that the casket-related patents filed as exhibits in this proceeding use the term casket to mean a structure configured to contain the remains of deceased humans in a supine position. PO Resp. 4 (citing Exs. 1005, 1007). The patents cited are unrelated to the ’151 patent and thus shed little light on the meaning of casket as claimed. *See generally Texas Digital Sys. Inc. v. Telegenix, Inc.*, 308 F.3d at 1211. Further, even considering this evidence, Patent Owner does not identify, nor do we discern an explicit disclosure in either patent that coffins contain the body of a deceased human in the supine position.¹⁹ It appears that Patent Owner relies upon the shape of the coffins depicted in these patents. Patent Owner reads too much into these Figures. None of the Figures depict a coffin containing a human in the supine position. *See* Ex. 1005, Figs. 1–4; Ex. 1007, Figs. 1–4. More importantly, such depictions are exemplary and Patent Owner has not explained effectively why the embodiments of these patents should be read into the claims of the ’151 patent.

Patent Owner contends that because the Specification does not set forth an unconventional definition of “casket,” a person of ordinary skill would consider a casket body to be a container that receives a human body in the supine position. PO Resp. 4–7 (citing Ex. 2012 ¶ 63). In the cited

¹⁹ *See* 37 C.F.R. § 42.22(a)(2) (requiring motions to include a detailed explanation of the significance of evidence); 37 C.F.R. § 42.23 (applying the content requirements of motions to oppositions and replies); 37 C.F.R. § 42.120(a) (stating that a patent owner’s response is an opposition).

portion of the Declaration, Mr. Anders states that a person of ordinary skill would understand that “casket” does not include a box that contains bodily remains in other than the supine position.²⁰ Ex. 2012 ¶ 63. Mr. Anders adds that given human dimensions, the container would have length greater than width, and width greater than depth. *Id.* Although not cited by Patent Owner, Mr. Ander’s explains that he disagrees with the claim construction in our Institution Decision because we failed to consider both the figures of the ’151 patent and the understanding of a person of ordinary skill. *Id.* ¶ 175.

We disagree with Mr. Ander’s interpretation. Claims 1 and 14 do not specify a size relationship between the length, width, and depth of the arrangement. For that reason, the language of claims 1 and 14 is broader than the exemplary embodiments depicted in the Figures of the ’151 patent, and consequently, such a limitation must not be read into the claims. *See* Ex. 1001, Figs. 1–9; *see also* Pet Reply 3 (asserting that the drawings make no reference to the deceased being in a supine position). Further, Mr. Ander’s opinion is based upon the interpretation that the claims require the arrangement to contain a deceased human in the supine position, a contention we disagree with for the reasons given above. These factors undermine Mr. Ander’s conclusory assertion that our interpretation is not from the perspective of a person of ordinary skill in the art.

²⁰ We considered Petitioner’s contention that Mr. Anders’s Declaration should be given little or no weight under 37 C.F.R. § 42.65. *See* Pet. Reply 20–22. The opinions of Mr. Anders identified by Petitioner relate to interpretation of figures. *See* Pet. 21 (citing Ex. 2012 ¶¶ 46, 47, 49, 51, 53). Such opinions are supported adequately by Mr. Anders’s knowledge and experience. *See* Ex. 2012 ¶¶ 1–24; *see also id.* at App’x A.

Our interpretation is the broadest *reasonable* interpretation, and cannot be divorced from the specification and the record evidence. *See Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015). As detailed above, a casket is a container for receiving the remains of a deceased. Consequently, a “casket body” as claimed must reasonably serve as container for the remains of a deceased. Petitioner asserts that any container (“body”) may serve as a casket body as claimed. Yet, a container may be too large or too small to reasonably serve in that capacity. *See* PO Resp. 4—5.

The challenged claims require that the arrangement is capable of serving as a casket body in that it can receive or contain the remains of a deceased.

c) Conclusion

For these reasons, we disagree with Petitioner’s contention that “casket” is entitled to no patentable weight, and we also disagree with Patent Owner’s contention that claims 1 and 14 require the casket body to contain the body of a deceased human in a supine position. Rather, claims 1 and 14 require that the claimed arrangement is capable of containing the remains of a deceased.

IV. PATENTABILITY

A. EVIDENCE AND ASSERTED GROUNDS OF UNPATENTABILITY

We instituted *inter partes* review on the following grounds of unpatentability:

Claims Challenged	§	References(s)
1, 2, 5, 8, 9, 11, and 13	102(a)	Groh ²¹
3, 4, 6, 7, 10, and 12	103(a)	Groh
1, 5, 6, 8, 9, and 13	102(a)	Watson ²²
7 and 10–12	103(a)	Watson
14	103(a)	Groh and Walding ²³

Dec. 25.

Petitioner relies on the Declaration of Dr. Albert Karvelis, an engineer with 40 years of experience in machinery and manufacturing. Ex. 1006 ¶¶ 1–4, App’x D (curriculum vitae); *see also* Ex. 2013, 5:10–17:24 (transcript of Dr. Karvelis’s deposition).

Patent Owner relies on the Declaration of Robert J. Anders, and industrial designer with over 50 years of experience. Ex. 2012 ¶¶ 1, 4 (curriculum vitae at App’x A).

B. ANTICIPATION BY GROH – CLAIMS 1, 2, 5, 8, 9, 11, AND 13²⁴

1. *Groh*

Groh discloses a collapsible ice chest formed of a sheet of material such as corrugated paper. Ex. 1002, Abstract. Collapsible cooler 10 includes a box-like ice chest portion 12 and a box-like cover or lid 14. *Id.* at 2:1–5.

²¹ U.S. Patent No. 5,050,766, issued Sept. 24, 1991 (Ex. 1002).

²² U.S. Patent No. 3,346,399, issued Oct. 10, 1967 (Ex. 1004).

²³ U.S. Patent No. 3,729,786, issued May 1, 1973 (Ex. 1007).

²⁴ As stated in our Institution Decision, Petitioner mistakenly includes claims 3 and 4 in the list of claims (Pet. 7), but these claims are not subject to this ground (Pet. 8–17). *See* Dec. 13.

Figures 1 and 3 of Groh follow.

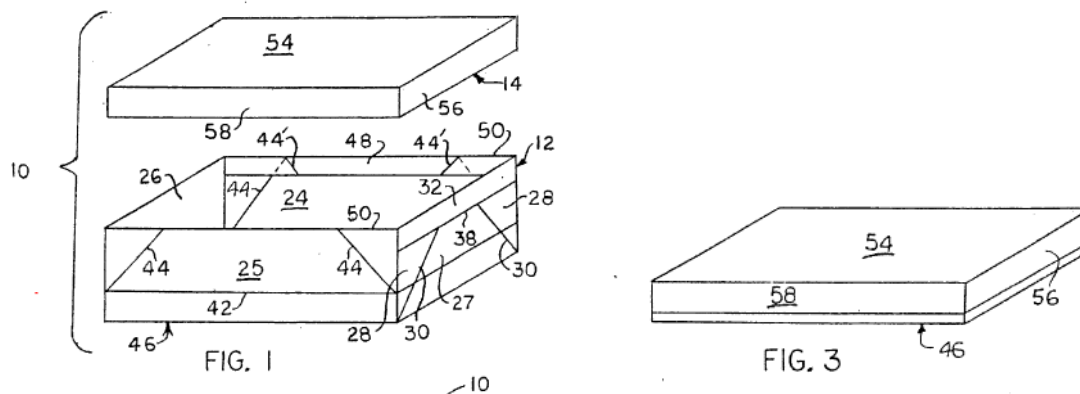


Figure 1 is an exploded perspective view of Groh's cooler 10 comprised of ice chest 12 and lid 14, and Figure 3 is a perspective view of cooler 10 in a closed collapsed condition. *Id.* at 1:57–58, 61–63.

2. Contentions

Petitioner contends that claim 1 is anticipated by Groh. Pet. 8–17.²⁵ Specifically, Petitioner contends that Groh discloses an arrangement (ice chest 12) having a first configuration (expanded, Figure 1) and a second configuration (collapsed, Figure 3). Pet. 8 (citing Ex. 1002, 3:26–31, 35–37, 46–50, 55–47).²⁶ Petitioner contends that Groh discloses a bottom panel (bottom panel 18) formed of a pliable material (corrugated paper). *Id.* at 9 (Ex. 1002, Abstract, 1:25–30, 2:6–8, 15–18, 3:42–46, Fig. 4). Petitioner contends that Groh's ice chest 12 is formed from a sheet of material (flat blank 16) so that the side and end panels are each formed intrinsically with the bottom panel (bottom panel 18). *Id.* at 9–12 (Ex. 1002, 2:6–7). Petitioner contends that Groh's side panels (side panels 24, 25) and end

²⁵ Petitioner refers to Groh as Ex. 1006, but it is Ex. 1002. See, e.g., Pet. 8.

²⁶ Petitioner cites to lines 46–60 and then lines 55–57, suggesting that 46–60 was intended to be 46–50. See Pet. 8.

panels (end panels 26, 27) are each comprised of foldably attached upper and lower panels, with the lower side panels extending vertically upward from the bottom panel (bottom panel 18), and the upper side panels extending vertically or other than vertically from the lower side panels. *Id.* (citing Ex. 1002, 1:49–50, 2:15–21, 48–51, 54–59, 3:26–31, 46–50, 55–57, Figs. 1–4).

Patent Owner contends Petitioner had not provided evidence that the prior art was capable of the claimed intended use. *See e.g.*, PO Resp. 15–17 (“Petitioner has not proffered evidence that Groh satisfies the Board’s definition of ‘casket body.’”).

3. *Analysis*

As explained above, in the Petition, Petitioner contends that use of the claim term “casket” in claim 1 is an intended use that carries no patentable weight. Pet. 9, 12. Because Petitioner attributed no patentable weight to “casket,” Petitioner presented no evidence that Groh was capable of serving as a casket. *Id.*; *see also* Karvelis Decl., Ex. 1006 ¶ 46 (“the term ‘casket’ should carry no weight with regard to patentability”) ¶ 69 (“the term ‘casket’ provides absolutely no structural limitations, the term should have no meaning in an apparatus claim such as claim 1, and should therefore be given no patentable weight regarding any comparison with the prior art”).

In its Response, Patent Owner asserts that Petitioner has not provided evidence that the prior art was capable of the claimed intended use. *See, e.g.*, PO Resp. 15 (“Petitioner has not proffered evidence that Groh satisfies the Board’s definition of ‘casket body.’”).

In its Reply, Petitioner persists in the contention that “casket” is entitled to no weight. Specifically, Petitioner asserts that Patent Owner’s

arguments are specious at best because the Board ruled in the Institution Decision that an intended use cannot be a patentable distinction. Pet. Reply 17.

Petitioner mischaracterizes our Decision. Our Institution Decision expressly determined that a “casket body” as claimed must be capable of receiving a deceased human, and if the prior art is capable of that intended use, then the term “casket” cannot serve as a patentable distinction over the prior art.²⁷ Dec. 11–12.

Although Petitioner acknowledges that “casket” is an intended use requiring the claimed apparatus to receive a deceased body, this is in the context that Petitioner further asserts that because it is an intended use, it carries no patentable weight. See Pet. Reply 4. Petitioner presents no evidence that Groh’s ice chest is capable of receiving a deceased (human or pet). Rather, Petitioner asserts, as attorney argument, that a deceased can fit into Groh’s ice chest. Pet. Reply 4, 17. Petitioner’s unsupported argument is not persuasive. See *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (attorney’s arguments do not take the place of evidence).

Patent Owner’s expert, Mr. Anders, opines that humans range from infants to 99 percentile persons.²⁸ See Ex. 2012 ¶ 63; see also Pet. Reply 17 (citing this portion of Ex. 2012). This evidence does not demonstrate sufficiently that Groh’s ice chest is capable of the claimed use. In order to know that a container may reasonably serve to hold the remains of a

²⁷ Here, we modify that interpretation to more broadly require the capability to contain the remains of a deceased rather than the remains of a deceased human.

²⁸ Notably this is Patent Owner’s evidence, not Petitioner’s.

deceased, it is necessary to know the dimensions of both the container and the deceased. Here the evidence does not address the size of Groh's device at all. With regard to deceased humans, at most, the evidence suggests that human size varies greatly; however, this evidence does not establish any quantitative dimensions for the remains of the deceased (*e.g.*, length, width, weight).

The question before us is not whether these claims are unpatentable as anticipated by Groh. The question before us is whether Petitioner has demonstrated such by a preponderance of the evidence. *See* 35 U.S.C. § 316(e). Though *Arendi* is in some respects distinguishable from the case at hand, it supports the proposition that in an *inter partes* review, a claim limitation (*e.g.*, "casket body") cannot be met by the conclusory assertion that the prior art has such capability. *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361–63 (Fed. Cir. 2016) (where "common sense" is used to supply a missing limitation, that assertion must be supported with evidence and a reasoned explanation). Petitioner's assertion requires a reasoned explanation and supporting evidence, neither of which is provided.

Further, an *inter partes* review differs from an *ex parte* proceeding. In an *ex parte* proceeding, where the examiner demonstrates that the prior art has the claimed structure, the burden shifts to the appellant to demonstrate that the prior art is not capable of the claimed intended use or function. *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) (once the Examiner establishes a reasonable basis that the prior art is capable of performing the claimed function, the burden shifts to the applicant to show that the prior art structure is not capable of performing the claimed function); *see also Mytee Products, Inc. v. Harris Research*, 439 Fed. Appx. 882, 886 (Fed. Cir. 2011)

(clarifying that *Schreiber* did not establish a presumption of inherency for issued patents, rather, it held only that after an examiner establishes a prima facie case of anticipation, the burden shifts to the applicant to show that the prior art structure did not inherently possess the functionally defined limitations of the claimed apparatus). In contrast, here, in an *inter partes* proceeding, there is no such burden shift. Petitioner carries the burden of proof and that does not shift to the Patent Owner. *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1378–79 (Fed. Cir. 2015); *see also In re Magnum Oil Tools International, Ltd.*, 829 F.3d 1364, 1375–76 (Fed. Cir. 2016) (clarifying the applicability of *Dynamic Drinkware* to *inter partes* reviews and explaining that the shifting burden of production does not apply except with regard to affirmative defenses).

As our Institution Decision expressly stated, the claimed arrangement must be capable of containing the remains of a deceased. The Decision emphasizes that the prior art must be capable of that claimed use. Despite this guidance, Petitioner presents no persuasive evidence that Groh’s ice chest has such capability.

4. Conclusion

Petitioner has not demonstrated by a preponderance of the evidence that claim 1 is unpatentable under 35 U.S.C. § 102(b) as anticipated by Groh. The same is true of claims 2, 5, 8, 9, 11, and 13 by virtue of their dependence from claim 1.

C. OBVIOUSNESS OVER GROH – CLAIMS 3, 4, 6, 7, 10, AND 12

Petitioner contends that claims 3, 4, 6, 7, 10 and 12 would have been obvious over Groh. Pet. 17–23. Petitioner relies upon the analysis of

independent claim 1 from the prior ground of unpatentability. *Id.* at 17.

Petitioner does not provide any persuasive evidence that Groh's apparatus is capable of containing the remains of a deceased body, nor does Petitioner propose a modification of Groh that would provide such capability. *Id.*

Thus, this ground of unpatentability suffers from the same shortcoming as the prior ground, namely, a failure to properly construe a claim limitation with a corresponding failure to provide persuasive evidence that the limitation has been met. Petitioner has not directed us to persuasive evidence that the differences between the claimed invention and the prior art would have been obvious. Petitioner also has not provided a persuasive rationale as to why any such differences would have been obvious.

Although the claimed invention is seemingly simple, simplicity is not inimical to patentability. *In re Oetiker*, 977 F. 2d 1443, 1447 (Fed. Cir. 1992); *see also*, *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1572 (Fed.Cir.) (the patent system is not foreclosed to those who make simple inventions). Our decision is based on the evidence and arguments before us. The preponderance of the evidence on which Petitioner relies does not disclose or suggest the casket body recited in the challenged claims. "The emphasis on nonobviousness is one of inquiry, not quality" of the advance. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). While "the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not," (*Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed.Cir.2007)), the determination is made not after observing what the inventor actually did, but in light of the state of the art before the invention was made. *Outside the Box Innovations, LLC v. Travel Caddy, Inc.*, 695 F.3d 1285, 1298 (Fed. Cir. 2012).

On the record before us, Petitioner has not demonstrated by a preponderance of the evidence that claims 3, 4, 6, 7, 10 and 12 are unpatentable under 35 U.S.C. § 103(a) as obvious over Groh.

We note that this ground of unpatentability suffers from other shortcomings. Given our analysis above, we need not address these other shortcomings in detail, but we provide a representative example. Claim 3 adds that the first side panel includes an upper connecting extension spaced apart from the upper end panel. Petitioner proposes to modify Groh by cutting along diagonal fold line 30 as “simply a matter of design choice.” Pet. 18. We agree with Patent Owner that such modification is more than a matter of design choice, and would have rendered Groh unsuitable for its intended purpose. PO Resp. 18. In particular, the modification alters the function of Groh, and the modification would defeat the leak-proof design. *See id.* at 24–27; Ex. 2012 ¶ 93; Ex. 1002, 2:24–37 (describing that the apparatus provides “a closed, leak proof box construction”). Further, we do not consider Petitioner’s response that claim 3 is anticipated by Groh because it is a change in theory from the Petition that Patent Owner has not had opportunity to respond to. *Compare* Pet. 17–19 (asserting claim 3 is obvious in view of Groh), *with* Pet. Reply 18 (citing Ex. 2013, 85–107, and asserting the Groh anticipates claim 3).

D. ANTICIPATION BY WATSON – CLAIMS 1, 5, 6, 8, 9, AND 13

Petitioner contends that claims 1, 5, 6, 8, 9, and 13 are anticipated by Watson. Pet. 37–45.

1. *Watson*

Watson is titled, “expandable frozen dough package,” and discloses an expandable package that may contain frozen dough and be used as a disposable cooking receptacle. Ex. 1004, 1:12, 1:27–34; 2:46–47. Figure 5 follows.

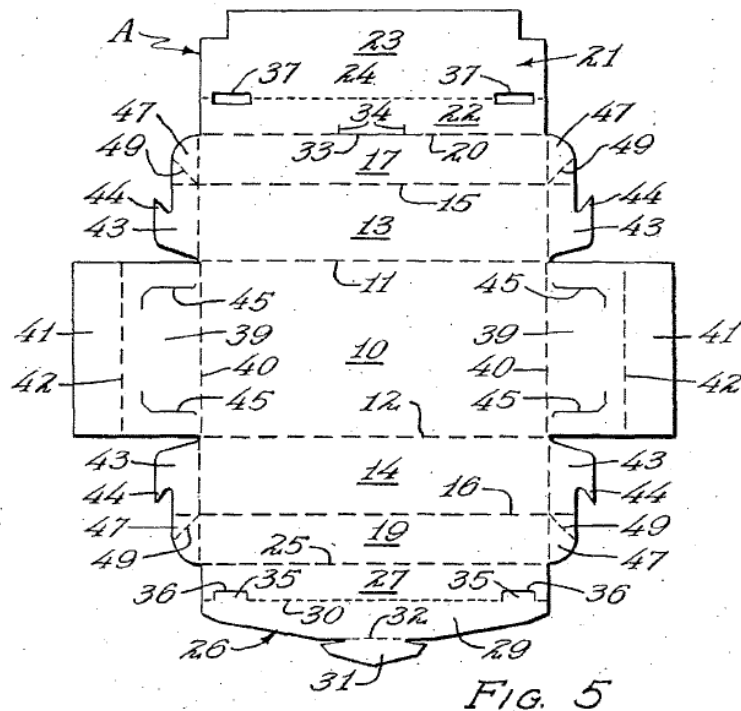


Figure 5 is a diagrammatic view of the blank used to form the package. *Id.* at 2:46–47.

Figures 1 and 4 follow.

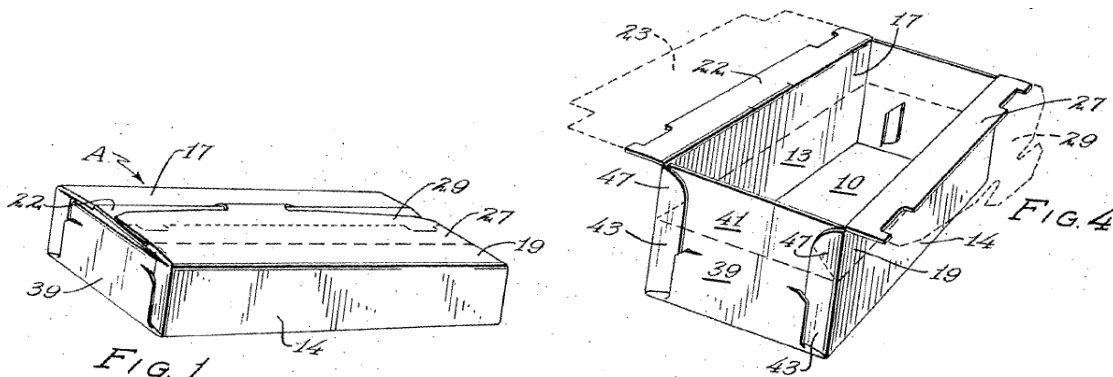


Figure 1 is a perspective view of the package in the closed position and Figure 4 is a perspective view of the carton in the open position. *Id.* at 2:38–39, 44–45.

2. *Contentions*

Petitioner contends that claim 1 is anticipated by Watson.²⁹ Pet. 37–42. Specifically, Petitioner contends that Watson discloses an arrangement (expandable package) having a first configuration (expanded, Figure 4) and a second configuration (collapsed, Figure 1). Pet. 38 (citing Ex. 1004, 2:6–35, 3:44–49, 53–57, 60–67, 4:1–6, 5:14–32, Figs. 1–4). Petitioner contends that Watson discloses a bottom panel (bottom panel 10) formed of a pliable material. *Id.* at 39 (Ex. 1004, 2:54–57, Fig. 5). Petitioner contends that Watson’s side and end panels are each formed intrinsically with the bottom panel (bottom panel 10). *Id.* Petitioner contends that Watson’s side panels and end panels are each comprised of foldably attached upper and lower panels, with the lower side panels (lower side wall portions 13, 14) extending vertically upward from the bottom panel (bottom panel 10), and the upper side panels (upper side wall portions 17, 19) extending vertically or other than vertically from the lower side panels. *Id.* 39–42 (Ex. 1004, 2:6–35, 57–59, 3:44–49, 53–57, 60–65, 4:1–6, Figs. 1–7). Petitioner contends that in the first configuration, the upper end panel (end flap extension 41) is operably coupled to the upper section of at least one side panel (upper sidewall portion 19). *Id.* at 41.

²⁹ Petitioner correctly refers to Watson as Exhibit 1004 (Pet. 37), and mistakenly refers to Watson as Exhibit 1006 (Pet. 38).

Patent Owner asserts that Petitioner has not provided evidence that the prior art was capable of receiving the remains of a deceased. PO Resp. 35–36.

3. *Analysis*

Watson discloses a container for frozen dough that serves as a disposable cooking receptacle. The record does not contain any evidence that Watson’s device is capable of receiving the remains of a deceased. Consequently, our analysis here parallels that of the ground of unpatentability based on anticipation by Groh.

4. *Conclusion*

Petitioner has not demonstrated by a preponderance of the evidence that claim 1 is unpatentable under 35 U.S.C. § 102(b) as anticipated by Watson. The same is true of claims 5, 6, 8, 9, and 13 by virtue of their dependence from claim 1.

We note without providing a detailed analysis, that at least claim 13 suffers from an additional shortcoming. Claim 13 depends from claim 1 and adds that the pliable material is corrugated paperboard. We agree with Patent Owner that Petitioner’s citation to Watson’s disclosure of “paperboard” does not demonstrate adequately that Watson discloses or suggests corrugated paperboard as claimed. See Pet. 45³⁰; PO Resp. 37; Ex. 1004, 4:15 (describing “paperboard”); Ex. 2012 136 (opining that a person or ordinary skill would not interpret “paperboard” as necessarily meaning

³⁰ Petitioner’s citation to Ex. 1004, 1:37–39 adds nothing to Petitioner’s contention because Watson only discloses as background a known use of “paperboard.”

corrugated paperboard); Pet. Reply, *passim* (choosing not to address Patent Owner's argument).

E. OBVIOUSNESS OVER WATSON – CLAIMS 7 AND 10–12

Petitioner contends that claims 7 and 10–12 would have been obvious over Watson. Pet. 46–47. Petitioner relies upon the analysis of independent claim 1 from the prior ground of unpatentability. *Id.* at 46. Petitioner does not provide any evidence that Watson's apparatus is capable of receiving the remains of a deceased, nor does Petitioner propose a modification that would provide such capability. *Id.* Thus, this ground of unpatentability suffers from the same shortcoming as the prior ground.

Similar to our analysis above for Groh, Petitioner has not demonstrated by a preponderance of the evidence that claims 7 and 10–12 are unpatentable under 35 U.S.C. § 103(a) as obvious over Watson.

F. OBVIOUSNESS OVER GROH AND WALDING – CLAIM 14

Independent claim 14 is similar to independent claim 1, except that claim 14 has an additional requirement regarding handholds. Specifically, claim 14 recites that “each side panel having a plurality of handholds formed therein wherein a mean distance of said handholds from an end of the casket is less than the distance from said end to the center of the side panel whereby the handholds are asymmetrically located at a distance from the center of the side panel.”

1. *Walding*

Walding discloses a cardboard blank that forms a coffin. Ex. 1007, 1:5–7. Figures 1 and 3 of Walding follow.

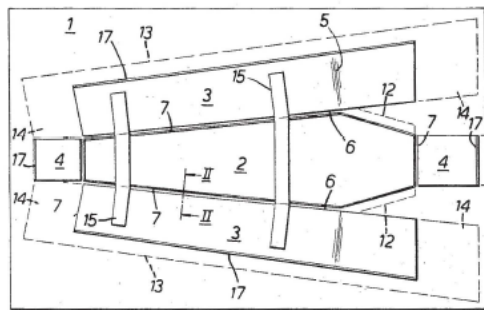


FIG. 1.

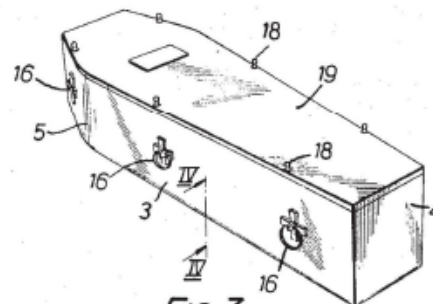


FIG. 3.

Figure 1 is a plan view of a composite blank, and Figure 3 is a perspective view of the erected coffin with lid with external side handles 16 visible. *Id.* at 1:66–67, 2:3–4, 3:16–20.

2. Contentions

Petitioner contends that claim 14 is obvious over Groh and Walding. Pet. 55–60. Petitioner repeats the contentions regarding Groh regarding anticipation by Groh, and relies upon Walding for asymmetrical handholds. *Id.* In particular, with regard to the handholds, Petitioner contends that, “Walding discloses multiple asymmetrical handholds.” *Id.* at 58 (citing Ex. 1007, 3:16–24, Fig. 3).

Petitioner contends that combining Groh with Walding “would yield predictable results with a reasonable expectation of success.” Pet. 56. Petitioner states that “[h]aving asymmetrical handholds on a lightweight box would have been obvious to a person of ordinary skill in the art before August 10, 2005 based on *Walding* in view of *Groh* at least because one of ordinary skill in the art would use *Walding*.” *Id.* at 58.

Patent Owner contends that Petitioner has not provided a sufficient reason to combine. PO Resp. 45. In response, Petitioner “maintains its position that claim 14 is obvious over Groh in view of Walding,” but does

not address Patent Owner's argument regarding the reason to combine. Pet. Reply 20.

3. *Analysis*

Petitioner's statement that combining Groh and Walding would yield predictable results is conclusory. *See* Pet. 56. Further, Petitioner's assertion that a person of ordinary skill would have made the proposed modification "at least because one of ordinary skill in the art would use Walding" (Pet. 58) is circular logic that does not provide a sufficient reason to combine the references. *See* PO Resp. 45.

4. *Conclusion*

Petitioner has not demonstrated by a preponderance of the evidence that claim 14 is unpatentable under 35 U.S.C. § 103(a) as obvious over Groh and Walding.

V. ORDER

For the reasons given, it is:

ORDERED that claims 1–14 have not been shown to be unpatentable;
FURTHER ORDERED that Petitioner's Motion to Exclude is denied;
FURTHER ORDERED that Patent Owner's Motion to Expunge
Petitioner's Motion for Observations on Cross Examination of Dr. Karvelis
(Paper 24) is granted;

FURTHER ORDERED that Patent Owner either refile Exhibits 2012
and 2013 as public exhibits or request a conference call, within seven
business days of entry of this decision; and

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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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Patent 8,104,151 B2

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