

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAMPBELL SOUP COMPANY,
CAMPBELL SALES COMPANY, and
TRINITY MANUFACTURING, LLC,
Petitioner,

v.

GAMON PLUS, INC.,
Patent Owner.

IPR2017-00087
Patent 8,827,111 B2

Before GRACE KARAFFA OBERMANN, BART A. GERSTENBLITH,
and ROBERT L. KINDER, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision on Remand
Determining No Challenged Claims Unpatentable
Granting Patent Owner's Motion for Leave to
Request Certificate of Correction
35 U.S.C. §§ 144, 318; 37 C.F.R. § 42.20

I. INTRODUCTION

A. Background

Campbell Soup Company, Campbell Sales Company, and Trinity Manufacturing, LLC (collectively, “Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1–35 of U.S. Patent No. 8,827,111 B2 (Ex. 1001, “the ’111 patent”). We instituted *inter partes* review of claims 1–16, 27, 28, and 32–35. Paper 12, 52 (“Inst. Dec.”). We did not institute *inter partes* review of claims 17–26 and 29–31. *See, e.g., id.* at 51–52. In its Patent Owner Response (Paper 15), Patent Owner requested that claims 1–16 be cancelled.

In addition to the papers noted above, Petitioner filed a Motion to Exclude Evidence (Paper 44), Patent Owner filed an Opposition to Petitioner’s Motion to Exclude Evidence (Paper 52), and Petitioner filed a Reply in support of its Motion (Paper 59). Patent Owner filed a Motion for Observations on Cross-Examination of Steven C. Visser (Paper 45), and Petitioner filed a Response to Patent Owner’s Observations (Paper 51). A first oral argument was held on January 23, 2018, the transcript of which is in the record (Paper 72).

After trial, in a first Final Written Decision (Papers 73, 75, “Final Dec.”),¹ we (1) granted in part Petitioner’s Motion to Exclude by giving no weight to certain testimony from paragraph 20 of Paper 16, (2) granted Patent Owner’s request to cancel claims 1–16, and (3) determined that Petitioner had not established, by a preponderance of the evidence, that

¹ Paper 73 is a confidential version of our first Final Written Decision and Paper 75 is the public version. Citations are to the public version.

claims 27, 28, and 32–35 of the ’111 patent are unpatentable. Final Dec. 3, 71–72.

Petitioner appealed our first Final Written Decision to the U.S. Court of Appeals for the Federal Circuit. The Federal Circuit affirmed, “determin[ing] that claims 27, 28, and 32–35 of the ’111 patent are not unpatentable over the instituted grounds,” but remanded “for the Board to consider whether non-instituted claims 17–26 and 29–31 are unpatentable and whether claims 27, 28, [and] 32–35 are unpatentable based on the non-instituted grounds” in light of *SAS Institute v. Iancu*, 138 S. Ct. 1348 (2018). *Campbell Soup Co. v. Gamon Plus, Inc.*, No. 2018-2099, 2019 WL 5152396, at *6 (Fed. Cir. Oct. 15, 2019).

On December 20, 2019, we issued an order modifying our Institution Decision in accordance with the Federal Circuit’s direction. Paper 84 (“Order”). Specifically, we modified our Institution Decision to include each of the grounds challenging claims 17–26 and 29–31 and the non-instituted grounds challenging claims 27, 28, and 32–35. *Id.* at 3. We included the following chart indicating the 15 grounds to be addressed in this post-remand phase of the proceeding:²

² The chart has been modified to include footnotes citing each reference.

Ground³	Claim(s) Challenged	35 U.S.C. §	References/Basis
2a ⁴	17–20, 25, 26	103(a)	Weichselbaum, ⁵ Nesso ⁶
2b	18, 19	103(a)	Weichselbaum, Nesso, Rogers ⁷
3a ⁸	21, 22, 24	103(a)	Weichselbaum, Nesso, Mellion ⁹
3b	24	103(a)	Weichselbaum, Nesso, Mellion, Schwimmer ¹⁰
4	23	103(a)	Weichselbaum, Nesso, Luster ¹¹
5	27, 28, 33, 34	103(a)	Weichselbaum, Nesso, Rogers
6a ¹²	29	103(a)	Weichselbaum, Nesso, Luster
6b	29	103(a)	Weichselbaum, Nesso, Luster, Rogers
7a ¹³	30	103(a)	Weichselbaum, Nesso, Luster, Knott ¹⁴
7b	30	103(a)	Weichselbaum, Nesso, Luster, Knott, Rogers
8a ¹⁵	31	103(a)	Weichselbaum, Nesso, Luster, Mellion
8b	31	103(a)	Weichselbaum, Nesso, Luster, Schwimmer
8c	31	103(a)	Weichselbaum, Nesso, Luster, Mellion, Rogers
8d	31	103(a)	Weichselbaum, Nesso, Luster, Schwimmer, Rogers
9	32, 35	103(a)	Weichselbaum, Nesso, Mellion, Rogers

Order 4–5.

³ In our Institution Decision, we remarked that “Petitioner includes nine numbered grounds, many of which include several alternative combinations of references.” Inst. Dec. 5 n.3. For each ground that has one or more alternatives, we identify those alternatives in our chart above with a sub-letter designation, e.g., Grounds 2a and 2b.

⁴ Petitioner’s ground states: “Claims 17–20, 25 and 26 are obvious under 35 U.S.C. § 103 over Weichselbaum in view of Nesso. Alternatively, claims 18

Thereafter, Patent Owner filed a Merits Response on Remand (Paper 85, “PO Remand Resp.”), Petitioner filed a Reply to Patent Owner’s Merits Response on Remand (Paper 87, “Pet. Remand Reply”), and Patent

and 19 are obvious over Weichselbaum in view of Nesso and further in view of Rogers.” Pet. iii, 24–25.

⁵ U.S. Patent No. 2,382,191, issued August 14, 1945 (Ex. 1023, “Weichselbaum”).

⁶ European Patent Application Publication No. 0490693 A2, published June 17, 1992 (Ex. 1020, “Nesso”). This reference identifies James Roderick Oattes as the named inventor and “NESSO (ENGINEERS) LIMITED” as the applicant. Ex. 1020, 1. The parties refer to this reference as “Nesso,” and we do the same for consistency.

⁷ U.S. Patent No. 3,304,141, issued February 14, 1967 (Ex. 1024, “Rogers”).

⁸ Petitioner’s ground states: “Claims 21 and 22 are obvious under 35 U.S.C. § 103 over Weichselbaum in view of Nesso and further in view of Mellion, and claim 24 is obvious from the same combination or further in view of Schwimmer.” Pet. iii, 45.

⁹ U.S. Patent No. 3,395,809, issued August 6, 1968 (Ex. 1021, “Mellion”).

¹⁰ U.S. Patent No. 5,462,198, issued October 31, 1995 (Ex. 1027, “Schwimmer”).

¹¹ U.S. Patent No. 514,948, issued February 20, 1894 (Ex. 1030, “Luster”).

¹² Petitioner’s ground states: “Claim 29 is obvious under 35 U.S.C. § 103 over Weichselbaum in view of Nesso, and further in view of Luster alone or with Rogers.” Pet. iii, 63.

¹³ Petitioner’s ground states: “Claim 30 is obvious under 35 U.S.C. § 103 over Weichselbaum in view of Nesso, and further in view of Luster and Knott alone or with Rogers.” Pet. iii, 65.

¹⁴ U.S. Patent No. Des. 178,248, issued July 10, 1956 (Ex. 1029, “Knott”).

¹⁵ Petitioner’s ground states: “Claim 31 is obvious under 35 U.S.C. § 103 over Weichselbaum in view of Nesso, further in view of Luster and Mellion or Schwimmer alone, or with Rogers.” Pet. iii, 67.

Owner filed a Sur-reply (Paper 88, “PO Remand Sur-reply”). Patent Owner also filed a Motion for Leave to Request Certificate of Correction, which Petitioner did not oppose. Paper 91 (“Motion for Leave”). A second oral hearing was held on May 7, 2020, and a copy of the transcript is in the record. Paper 94 (“Tr.”).

During the second oral hearing, Petitioner explained that it no longer sought to assert 14 of the 15 grounds from the Petition that were identified for the remand phase of this proceeding. *See* Tr. 6:16–7:17 (Petitioner confirming that it seeks to maintain only Ground 2A, limited to claims 17, 20, 25, and 26); *see also* Pet. Remand Reply 1–2 & n.2 (explaining Petitioner’s initial identification of grounds it sought to maintain, which Petitioner then modified at the oral hearing). We advised the parties to meet and confer and discuss whether they could resolve their dispute pertaining to the grounds that Petitioner did not intend to pursue. *See* Tr. 6:16–13:15 (discussing the grounds Petitioner did not intend to pursue).

In response, the parties filed a Joint Stipulation on June 1, 2020, which states: “The parties stipulate that claims 18, 19, 21–24 and 27–35 of U.S. Patent No. 8,827,111 patent [sic] have not been proven to be unpatentable on the grounds set forth in the Petition (Paper 1).” Paper 95. Thus, the stipulation resolves each ground that was to be addressed on remand, with the exception of one. The one ground remaining is that identified in our chart, above, as Ground 2a. The claims challenged in that ground, however, have changed because the parties’ stipulation includes claims 18 and 19.

We accept the parties’ stipulation regarding the claims addressed therein. Thus, the sole ground that remains to be resolved in the remand phase of this trial is:

Ground	Claims Challenged	35 U.S.C. §	References/Basis
2a ¹⁶	17, 20, 25, 26	103(a) ¹⁷	Weichselbaum, Nesso

We have jurisdiction pursuant to 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 17–35 at issue on remand. 35 U.S.C. § 316(e) (2012); 37 C.F.R. § 42.1(d) (2016). Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

Having reviewed the arguments and the supporting evidence, we determine that Petitioner has not shown, by a preponderance of the evidence, that challenged claims 17, 20, 25, and 26 of the ’111 patent are unpatentable. Additionally, we accept the parties’ stipulation that Petitioner has not shown, by a preponderance of the evidence, that challenged claims 18, 19, 21–24, and 27–35 of the ’111 patent are unpatentable.

¹⁶ Although we maintain the designation of “Ground 2a,” the ground now challenges fewer claims than originally identified in the Petition and described in our Order modifying our Institution Decision.

¹⁷ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Given that the application from which the ’111 patent issued was filed before this date, the pre-AIA version of § 103 applies.

B. Related Proceedings

The parties indicate that the '111 patent is asserted in *Gamon Plus, Inc., et al. v. Campbell Soup Co., et al.*, No. 15-cv-8940-CRN-YBK (N.D. Ill.). Pet. 1–2; Paper 7, 1. Petitioner indicates that U.S. Patent Application No. 14/861,017 claims priority to the application that issued as the '111 patent and may be affected by a decision in this proceeding. Pet. 2.

C. Real Parties in Interest

The Petition identifies “Campbell Soup Company,” “Campbell Sales Company,” and “Trinity Manufacturing, L.L.C.” as real parties in interest. Pet. 1. Patent Owner identifies “Gamon Plus, Inc.” and “Gamon International, Inc.” as real parties in interest (collectively, “Gamon”). Paper 7, 1.

D. Declarations

Petitioner relies upon two declarations by Mr. Steven Visser, one filed with the Petition and dated October 14, 2016 (Ex. 1002, the “Visser Declaration”), and another filed with Petitioner’s Reply dated October 13, 2017 (Ex. 1065, the “Visser Reply Declaration”). Patent Owner relies upon two declarations by Mr. Terry Johnson, a first declaration dated July 12, 2017 (Paper 16, the “Johnson Declaration”), and a supplemental declaration, dated August 2, 2017 (Paper 53, “the “Johnson Supplemental Declaration”).¹⁸

¹⁸ Paper 16 is identified erroneously in the record as “EXHIBIT 2001 Declaration of Terry Johnson.” Patent Owner, however, did not file an exhibit 2001 in this case. Paper 53 is Bates stamped erroneously with the phrase “Gamon Exhibit no. 2027.” Paper 53, 1. Exhibit 2027 appears to be a copy of Exhibit 1065 marked during Mr. Visser’s deposition as

E. The '111 Patent

The '111 patent is directed to “dispenser racks and displays” and “to a compact, easy to assemble, easy to load and unload multiple chute dispenser with an integrated display.” Ex. 1001, 1:15–18. The dispenser includes “[a] set of panels having chutes therebetween. The chutes being defined by curvilinear rails on such panels. The curvilinear rails having stops thereon for stopping the products for viewing.” *Id.* at 1:58–61.

Figures 1 and 2 of the '111 patent are shown below:

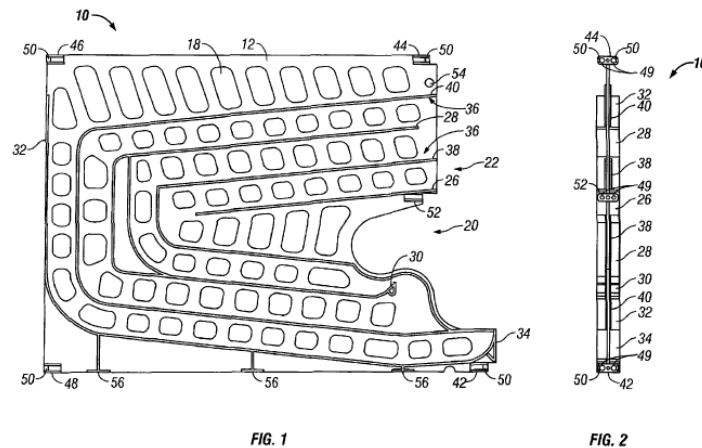


Figure 1 of the '111 patent “is a side view of a panel” (*id.* at 1:66–67), and Figure 2 is “an edge on view of a panel” (*id.* at 2:1–2). As shown, panel 10 is the “main element of the multi-chute gravity feed dispenser display” and “is generally formed as a vertical upright panel.” *Id.* at 4:8–10. Panel 10 is “preferably configured to be used in connection with conventional store shelving in place at a retailer.” *Id.* at 4:9–10.

The '111 patent explains:

The panel 10 includes at least one set of rails 20 which are formed as ribs extending normal to a side 12 of the panel 10 to cooperatively define a plurality of chutes 22, 24 for product

“Exhibit 2.” *See* Ex. 2027, 1. Therefore, we cite to each of Mr. Johnson’s declarations by the paper number under which it was filed.

which have a boustrophedonic or C-shaped configuration. A first rail 26 is disposed in the generally medial portion of the side 12 inclined to the horizontal, angled generally downwardly, and having a linear configuration. The second rail 28 is disposed about the first rail 26 and has a curvilinear configuration which is substantially C-shaped. The first and second rails 26 and 28 each having a minimum incline to the horizontal such that product is capable of continuous movement along such rails in response to a normal gravitational force, and where as shown in FIG. 1, can be a substantially slight angle. A first product travel stop or stop 30 is formed at a lowest extent of the second rail 28 as an enlarged portion thereof. The first stop 30 engages the product to prevent unwanted further movement down chute 22 and positions the product for viewing and selection by a customer. A third rail 32 has a curvilinear configuration which is substantially L-shaped and has a second stop 34, formed as an enlarged portion thereof at a lower end adjacent first stop 30, and prevents further downward motion down chute 24.

Ex. 1001, 4:19–41.

Figure 3A of the '111 patent is shown below:

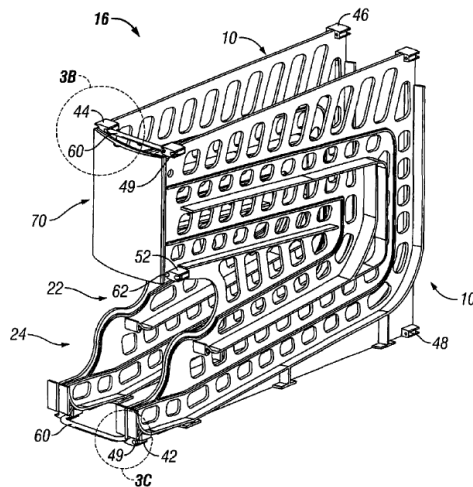


FIG. 3A

Figure 3A of the '111 patent “is a side perspective view of a display module.” *Id.* at 2:3–4. The '111 patent explains:

FIG. 3A shows a pair of panels, a display module 16 . . . connected by a pair of retention pins to define a dispenser module 16, one or more such dispenser modules 16 making up a multi-chute gravity feed dispenser display. The chutes 22, 24 are defined between adjacent pairs of panels 10 and are of a width slightly greater than the width of products 90 and which allow the products to be stored and dispensed therefrom.

Id. at 5:9–17.

Figure 6A of the '111 patent is shown below:

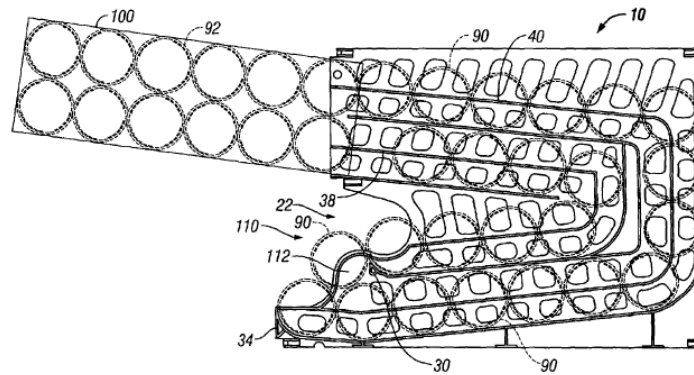


FIG. 6A

Figure 6A of the '111 patent “is a side view of both a display module with a loading magazine in a loading position.” *Id.* at 2:26–27. The '111 patent explains that “[w]hen loaded, the new product 92 simply rolls into the chute 22 or 24 whichever is empty and available.” *Id.* at 7:43–44.

The '111 patent describes, as an advantage of the invention, “the return area or replace stall 110 which is defined between the first and second stops 30 and 34 and a cradle member or ear 112 formed on the panel 10.” *Id.* at 7:49–52. In particular, “[t]he replace stall 110 is further defined as an area in which a product 90 may be replaced if the consumer decides not to purchase.” *Id.* at 7:52–54. Figure 6A shows the location of product 90, in replace stall 110, after being replaced by a consumer. *Id.* at 7:55–56.

F. Illustrative Claim

Claim 17 is the sole independent claim remaining in this proceeding. Claims 20 and 25 depend from claim 17, and claim 26 depends from claim 25. Ex. 1001, 18:66 (claim 20), 19:27 (claim 25), 19:32 (claim 26). Claim 17 is illustrative of the claimed subject matter and is reproduced below:

17. A display rack comprising:
 - a plurality of generally cylindrical products all having substantially equal diameters;
 - first and second product support structures defining respectively first and second chutes configured for the products to pass therethrough, each chute having a respective forward-facing product loading opening in a generally vertically disposed forward side of the display rack and configured to receive the products loaded into the chutes through the forward side, and a respective dispensing opening below the product loading opening such that the cylindrical products when placed in the product loading opening proceed by force of gravity through the associated chute to the dispensing opening;
 - the loading and dispensing openings of the second chute being situated between the loading and dispensing openings of the first chute;
 - a door supported for movement between a substantially vertical closed position wherein said door covers the product loading openings of both of the chutes and an open position wherein the door does not cover the product loading openings and the cylindrical products can be loaded into the chutes, said door in said closed position having a forwardly disposed face capable of holding a product label or advertising;
 - wherein the chutes each have a stop structure supported adjacent the respective dispensing opening and blocking movement of the products in the chute beyond said stop structure such that the products must be elevated above the stop structure to be removed from the dispensing opening of the chute; and

wherein the stop structure of the second chute is below a portion of the second product support structure adjacent the loading opening of the second chute and stops the products in the second chute rearward of the loading opening of the second chute, said second chute having a clearance space above the stop structure thereof such that a forwardmost one of the products resting thereagainst can be elevated by a user above the stop structure and removed from the second chute; and

the stop structure of said second chute being disposed above the dispensing opening of said first chute a vertical distance and offset rearwardly from the stop structure of said first chute a horizontal distance greater than the diameter of the products such that a forwardmost product of the products in the first chute can only be properly removed from the first chute, by lifting said forwardmost product up to a level wherein the forwardmost product is at least in part horizontally forward of the dispensing opening of the second chute.

Id. at 17:54–18:36.

G. Development of the '111 Patent and the Parties' Interactions

The history of Mr. Johnson's development of the '111 patent and the past interactions between the parties, which are relevant to, *inter alia*, Patent Owner's arguments pertaining to objective indications of nonobviousness, are detailed in our first Final Written Decision. Final Dec. 10–15. For the reasons explained below, we do not need to reach the issues described therein and, therefore, do not repeat expressly those findings here. Nonetheless, we incorporate that discussion herein for completeness.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art, as of the earliest priority date of the claims, would have had either: “(1) a Bachelor's Degree in Industrial Design and at least 1-2 years of experience in designing

gravity feed display dispensers, or (2) 5-10 years of experience in designing gravity feed display dispensers.” Pet. 7 (citing Ex. 1002 ¶ 36). Patent Owner did not propose an explicit level of ordinary skill in the art in its Response. Consistent with the level of ordinary skill in the art reflected by the prior art of record, *see Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978), in our first Final Written Decision we adopted Petitioner’s unopposed position as to the level of ordinary skill in the art. Final Dec. 18.

On appeal, the Federal Circuit did not disturb our finding as to the level of ordinary skill in the art. *See generally Campbell Soup Co.*, 2019 WL 5152396. The record on remand has not changed with respect to our consideration of this issue and, therefore, we maintain and reiterate that one of ordinary skill in the art would have had (1) a Bachelor’s Degree in Industrial Design and at least 1–2 years of experience in designing gravity feed display dispensers, or (2) 5–10 years of experience in designing gravity feed display dispensers.

B. Claim Construction

In an *inter partes* review based on a petition filed prior to November 13, 2018, claim terms in an unexpired patent are construed according to their broadest reasonable interpretation in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b) (2016);¹⁹ *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46

¹⁹ A recent amendment to this rule does not apply here because the Petition was filed before November 13, 2018. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before

(2016). There is a presumption that claim terms are given their ordinary and customary meaning, as would be understood by a person of ordinary skill in the art in the context of the specification. *See In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Nonetheless, if the specification “reveal[s] a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess[,] . . . the inventor’s lexicography governs.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)). Another exception to the general rule that claim terms are given their ordinary and customary meaning is “when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Uship Intellectual Props., LLC v. United States*, 714 F.3d 1311, 1313 (Fed. Cir. 2013) (quoting *Thorner v. Sony Comput. Entm’t Am., LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)).

Additionally, only terms that are in controversy need to be construed, and these need be construed only to the extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that “only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy”); *see also Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs.* in the context of an *inter partes* review).

the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (amending 37 C.F.R. § 42.100(b) effective Nov. 13, 2018) (now codified at 37 C.F.R. pt. 42 (2019)).

In our first Final Written Decision, we stated the following:

In our Institution Decision, we construed several claim terms recited in claims 1–17. Inst. Dec. 13–20. Patent Owner requests cancellation of claims 1–16 and we did not institute *inter partes* review of claim 17. Thus, none of the claim terms we construed previously are at issue in the trial. Additionally, Patent Owner’s Response and Sur-Reply and Petitioner’s Reply do not request that we construe any additional claim terms. Accordingly, we need not construe expressly any claim terms to resolve the controversy before us. *See Vivid Techs.*, 200 F.3d at 803.

Final Dec. 15. Thus, we did not construe any claim terms expressly in our first Final Written Decision.

In our Institution Decision, however, we discussed a phrase from claim 17 that is of critical importance on remand. In particular, the parties disputed, and continue to dispute, the construction of the phrase “the stop structure of said second chute being . . . offset rearwardly from the stop structure of said first chute a horizontal distance greater than the diameter of the products.” *See* Inst. Dec. 19–20. The phrase appears in the following clause of claim 17:

the stop structure of said second chute being disposed above the dispensing opening of said first chute a vertical distance and offset rearwardly from the stop structure of said first chute a horizontal distance greater than the diameter of the products such that a forwardmost product of the products in the first chute can only be properly removed from the first chute, by lifting said forwardmost product up to a level wherein the forwardmost product is at least in part horizontally forward of the dispensing opening of the second chute.

Ex. 1001, 18:27–36 (emphases added).

In our Institution Decision, we stated the following:

Petitioner contends that we should construe the phrase to mean “at least a portion of the stop structure of the second chute is offset by a distance greater than the diameter of the cylindrical products[] from at least a portion of the stop structure of the first chute.” Pet. 6–7 (citing Ex. 1002 ¶ 43). Petitioner contends that the ’111 patent specification does not define this phrase. *Id.* at 6.

Patent Owner disagrees with Petitioner’s construction and contends that Petitioner provides “no justification for . . . rewording the claim, except a bare assertion that the ’111 patent specification ‘does not define’ the term.” Prelim. Resp. 19. Patent Owner proposes that we construe the phrase “a horizontal distance” to mean “with a horizontal space between them,” to clarify the structural relationship between the stop structures of the respective chutes. *Id.* at 23.

Neither party explains persuasively why this claim phrase or any of the terms recited therein require construction. The meaning of each term as well as the entire phrase is clear, and, thus, does not require explicit construction. Nonetheless, we note that Petitioner fails to provide any support for its construction, which diverts from the express claim language in several respects,^[1] and we, therefore, decline to adopt it.

Inst. Dec. 19–20 (footnote omitted). In the footnote omitted from the quotation above, we further stated: “Petitioner’s construction, at a minimum, seeks to add the phrase ‘a portion of’ before each recitation of a ‘stop structure’ and seeks to omit the terms ‘rearwardly’ and ‘horizontal’ without providing any justification for the omissions.” *Id.* at 20 n.11 (citing Pet. 6–7).

In addressing Petitioner’s challenge based on the combination of Weichselbaum and Nesso (i.e., the ground we consider here), we found that “Petitioner’s position appears to be based on its claim construction, which we rejected.” Inst. Dec. 29 (citing our discussion of this claim phrase in

Section II.C. of the Institution Decision). We further stated that “[w]e decline to rewrite the claim to require only ‘at least a portion’ of the stop structure of the second chute to be offset a horizontal distance greater than the diameter of the products.” *Id.*

In its Patent Owner Response on Remand, Patent Owner agrees with our findings from the Institution Decision, noting that we “rejected Petitioner[’s] argued construction.” PO Remand Resp. 10.

In its Reply on Remand, Petitioner contests our construction of this phrase. Pet. Remand Reply 5–7. Petitioner acknowledges that the ’111 patent “does not define this claim limitation.” *Id.* at 5. Petitioner, however, contends that we erred in our construction because it results in “claim 17 and dependent claim 18 . . . be[ing] identical in scope,” which runs afoul of the doctrine of claim differentiation. *Id.* at 5–6. In accordance with the doctrine of claim differentiation, Petitioner asserts that independent claim 17 must be broader than claim 18, which depends therefrom. *Id.* Claim 18 recites:

The display rack of claim 17 wherein the horizontal distance that the stop structure of the second chute is offset rearwardly from the stop structure of the first chute is sufficient that one of the products removed by a user from the rack can be replaced on the rack supported with the replaced product resting directly on a rearward portion of said forwardmost product in the first chute.

Ex. 1001, 18:37–43. Petitioner asserts that “[c]laim 18 thus differs from claim 17 only in its further recitation that the horizontal distance by which the stop structure of the second chute is ‘offset rearwardly’ from the stop structure of the first chute (as recited in claim 17) is ‘sufficient’ to replace a product.” Pet. Remand Reply 6.

Petitioner contends that its proposed construction of the “offset rearwardly” limitation of claim 17 “includes within its scope a rearward offset that does not leave sufficient horizontal space to return a can.” *Id.* at 7. In so doing, Petitioner asserts “[t]hat breadth of scope is necessary to differentiate independent claim 17 from the narrower dependent claim 18, as the law requires.” *Id.* Petitioner thus encourages us to adopt its proposed construction. *Id.*

Patent Owner contends that “[c]laim 17 defines a display rack with a return position in language that is in some ways broader than the language of its dependent claim 18.” PO Remand Sur-reply 9. Patent Owner explains the following:

Claim 17 expresses the feature in terms that indicate a mathematical limit of an offset permitting return of one cylindrical product to rest on another one. The definition of the stop structure placement defined in claim 17 would encompass a display rack in which the rearward stop structure offset is only a very small additional distance, *e.g.*, one micron, greater than the product diameter. That configuration might not provide for a return except in the case of mathematically perfect or very high-tolerance circularly cylindrical products resting on the forwardmost cylindrical article below. In normal real-world can displays, however, the natural production variations in dimensions of the cans would mean that the offset distance would preferably be slightly greater to ensure that the replaced product would really be “resting directly on a rearward portion” of the forward product, making the functional requirement slightly narrower. In addition, the shape and exact vertical location of the upper stop structure might permit or prevent a return position, depending on a number of parameters.

Id.

We begin our analysis with the language of claim 17, which states: “the stop structure of said second chute being . . . offset rearwardly from the

stop structure of said first chute a horizontal distance greater than the diameter of the products.” Ex. 1001, 18:27–31. Petitioner proposes that we construe this phrase to mean “*at least a portion of* the stop structure of the second chute is offset by a distance greater than the diameter of the cylindrical products[] from *at least a portion of* the stop structure of the first chute.” Pet. 6–7 (emphases added) (footnote omitted) (citing Ex. 1002 ¶ 43). As noted above, in our Institution Decision, we stated that “Petitioner’s construction, at a minimum, seeks to add the phrase ‘a portion of’ before each recitation of a ‘stop structure’ and seeks to omit the terms ‘rearwardly’ and ‘horizontal’ without providing any justification for the omissions.” Inst. Dec. 20 n.11 (citing Pet. 6–7).

The claim language does not include the terms “at least a portion of” as proposed by Petitioner. Rather, the claim states that the stop structure of the second chute is “offset rearwardly from” the stop structure of the first chute a horizontal distance greater than the diameter of the products. In this context, we agree with Patent Owner that the most reasonable interpretation of one structure being “offset rearwardly from” another structure is that the offset, i.e., the distance between the structures (their separation), is measured from the rear of the first stop structure to the front of the second stop structure.

Turning to the Specification, we find that there is no intrinsic evidence supporting Petitioner’s proposed construction—the Specification does not define the phrase to include “at least a portion of,” the Specification does not use the phrase in the same or another context that suggests we should read “at least a portion of” into the claim, and none of the embodiments or figures

support Petitioner’s argument that the phrase should be construed to include “at least a portion of.” And, Petitioner does not contend otherwise.

Additionally, neither party relies upon the prosecution history of the ’111 patent, and we do not find anything particularly helpful therein on this issue. *See generally* Exs. 1004–1014.

In the Petition, the sole support for Petitioner’s construction is extrinsic evidence—a citation to Mr. Visser’s testimony. *See* Pet. 6–7 (citing Ex. 1002 ¶ 43). Mr. Visser states:

There is nothing in the ‘111 patent specification that defines this claim limitation. Accordingly, in my opinion, a [person of ordinary skill in the art] would understand this term to mean “at least a portion of the stop structure of the second chute is offset by a distance greater than the diameter of the cylindrical products from at least a portion of the stop structure of the first chute.”

Ex. 1002 ¶ 43. As reflected above, Mr. Visser does not explain why he believes “at least a portion of” should be read into the claim simply because the Specification does not define the “offset rearwardly” phrase. Mr. Visser also does not cite to any intrinsic evidence to support his construction. Unsupported testimony is entitled to little or no weight and here, in light of the absence of any reason provided, we give it none. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) at 40–41, available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (citing *Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997)).

In all of the briefing submitted in this proceeding, the *sole reason* provided by Petitioner for twice reading “at least a portion of” into claim 17 is the doctrine of claim differentiation. *See* Tr. 17:11–18:9 (confirming

claim differentiation as the sole basis for Petitioner’s position). We do not find that argument persuasive because we do not find that this issue presents a question of claim differentiation.

“The concept of claim differentiation . . . states that claims should be *presumed* to cover different inventions. This means that an interpretation of a claim should be avoided if it would make the claim read like another one.” *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1538 (Fed. Cir. 1991) (quoting *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 404 (Ct. Cl. 1967)). “Claim differentiation[, however,] is a guide, not a rigid rule. If a claim will bear only one interpretation, similarity will have to be tolerated.” *Id.* (quoting *Autogiro*, 384 F.2d at 404). In accordance with the doctrine, limitations stated in dependent claims “should ordinarily not be read into independent” claims. *Dow Chem. Co. v. United States*, 226 F.3d 1334, 1341 (Fed. Cir. 2000); *see Phillips*, 415 F.3d at 1314–15 (“[T]he presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.”) (citation omitted); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004) (same).

The doctrine, however, “cannot broaden claims beyond their correct scope.” *Dow Chem.*, 226 F.3d at 1341 (citing *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1480 (Fed. Cir. 1998)). As explained in *Liebel-Flarsheim*, “where 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.” *Liebel-Flarsheim*, 358 F.3d at 910 (citation omitted).

In the circumstances before us, it is *Petitioner's* proposed construction that seeks to “read” language into claim 17 (i.e., *add* language to the independent claim), not Patent Owner’s construction or our preliminary construction from the Institution Decision. In particular, Petitioner seeks to “read” the phrase “at least a portion of” into claim 17 in two instances. This is not the typical circumstance in which claim differentiation arises. Rather, as explained in the case law cited and quoted above, the doctrine of claim differentiation is most commonly applied to *avoid* adding limitations to independent claims where those limitations are expressly recited in dependent claims. This circumstance is not present here.

Claim 18 further limits the horizontal distance of the offset stop structures of claim 17 by reciting that the horizontal distance “is sufficient that one of the products removed by a user from the rack can be replaced on the rack supported with the replaced product resting directly on a rearward portion of said forward most product in the first chute.” Our construction of claim 17 does not read this, fairly large, limitation of claim 18 into claim 17, as would be contrary to the presumption provided by the doctrine of claim differentiation. Rather, the scope of claims 17 and 18 depend, at least in part, on not just the horizontal distance, but also the size of the products.²⁰

Importantly, even if Petitioner were correct that the meaning of claim 18 fails to distinguish over claim 17, Petitioner fails to provide any support for its proposed *solution*—reading “at least a portion of” into claim 17, twice. In particular, Petitioner does not explain how it arrives at adding “at least a portion of” into the claim when that phrase does not

²⁰ Claim 17 expressly recites “a plurality of generally cylindrical products all having substantially equal diameters.” Ex. 1001, 17:55–56.

appear in the '111 patent. Petitioner does not contend that such meaning was intended by the patentee or provide any reason as to why one of ordinary skill in the art would have understood claim 17 to include that unwritten phrase.

To the extent an explanation of claim scope is provided, it is provided by Patent Owner. Patent Owner explains that claim 17 covers the circumstance where the offset distance is only marginally greater than the product diameter—e.g., one micron greater. PO Remand Sur-reply 9. In that circumstance, Patent Owner contends that although the offset would read on claim 17, it would not read on claim 18 because a replaced can could not rest directly on a rearward portion of the forwardmost product in the first chute, as recited by claim 18. *Id.* Additionally, Patent Owner contends that “the shape and exact vertical location of the upper stop structure might permit or prevent a return position, depending on a number of parameters.” *Id.* In other words, there are other possibilities to consider before reading limitations into claim 17 that do not have intrinsic or extrinsic support.

We are not in the business of rewriting claims. Our primary problem with Petitioner’s proposed construction is that it lacks any support in the record. Patent Owner provides a reasonable explanation as to how to view the claims that results in a difference in scope. To the extent that our construction is perceived as rendering the same scope for claims 17 and 18, we find that the claims present the unusual situation where a dependent claim does not narrow the claim from which it depends. Even in that circumstance, however, we do not believe there is any basis to read “at least a portion of” into claim 17, when that phrase lacks support in the intrinsic

and extrinsic evidence in the record before us. Rather, we find that circumstance to be the result of poor claim drafting.

Accordingly, we maintain and reaffirm our preliminary determination that “at least a portion of” should not be read into the meaning of the “offset rearwardly” limitation of claim 17. *See* Inst. Dec. 29. Rather, the phrase should be understood according to its plain and ordinary meaning. Further, for the reasons discussed above, one of ordinary skill in the art would understand that the horizontal distance recited in this limitation is measured from the end of the first stop structure to the beginning of the second stop structure, as that is the horizontal distance by which the structures are offset.

C. Legal Standards – Obviousness

The U.S. Supreme Court set forth the framework for applying the statutory language of 35 U.S.C. § 103 in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966):

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

As explained by the Supreme Court in *KSR International Co. v. Teleflex Inc.*:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion

claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)).

“Whether an ordinarily skilled artisan would have been motivated to modify the teachings of a reference is a question of fact.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1327 (Fed. Cir. 2016). “[W]here a party argues a skilled artisan would have been motivated to combine references, it must show the artisan ‘would have had a reasonable expectation of success from doing so.’” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360–61 (Fed. Cir. 2017) (quoting *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1068–69 (Fed. Cir. 2012)).

1. *Level of Ordinary Skill in the Art*

As discussed above, we find that one of ordinary skill in the art at the time of the invention would have had (1) a Bachelor’s Degree in Industrial Design and at least 1–2 years of experience in designing gravity feed display dispensers, or (2) 5–10 years of experience in designing gravity feed display dispensers. *See supra* § II.A.

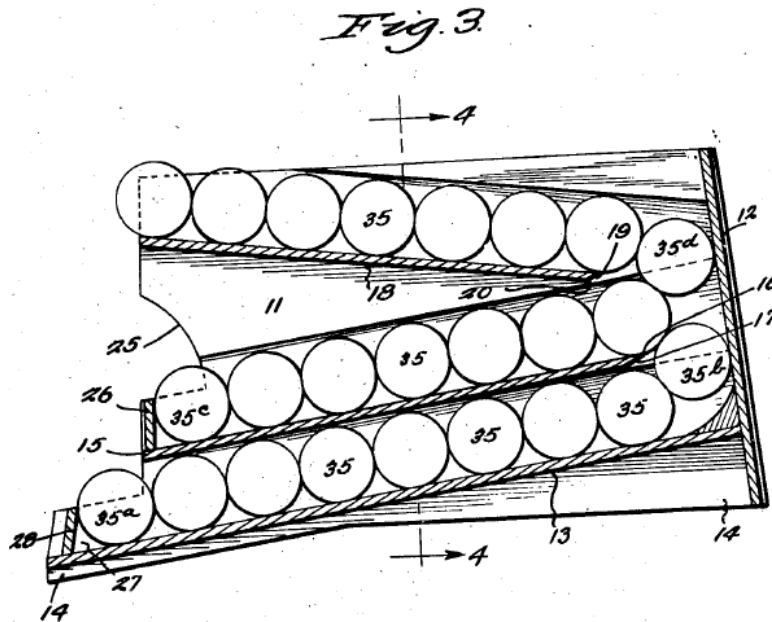
2. *Scope and Content of the Prior Art*

a) *Weichselbaum*

Weichselbaum is directed to “a dispensing device and more particularly to a device for dispensing cylindrical objects such, for example,

as canned goods.” Ex. 1023, 1:1–4.²¹ Weichselbaum teaches that the dispenser is “so dimensioned as to fit normally between shelves of customary height in a grocery store or the like.” *Id.* at 1:15–18.

Weichselbaum’s Figure 3 is shown below:



Weichselbaum’s Figure 3 “is a sectional view taken along the line 3—3 of Figure 2 as viewed in the direction of the arrows.” *Id.* at 2:5–7.

Weichselbaum explains:

The dispensing device . . . is comprised of a pair of side walls 11 and rear wall 12, a shelf 13, inclined forwardly downwardly from rear wall 12, serving as a base therefor. . . . A second shelf 15 is secured between side walls 11 in parallel relation to base shelf 13 but terminates at a point 16 spaced from rear wall 12 by a distance slightly in excess of the diameter of an individual can. . . . A third shelf 18 is also positioned between side walls 11 but is inclined downwardly toward rear wall 12 thereof in a direction opposite to the angle

²¹ Weichselbaum contains three pages of text, each page containing two columns. Ex. 1023. Citations are to the column and line numbers of the reference.

of inclination of shelves 13 and 15, and terminates at a point 19 spaced from rear wall 12

Side walls 11 are provided with aligned notches 25 adjacent but positioned above shelf 15, a stop member 26 being positioned between the side walls at the end of the shelf and extending upwardly to the bottoms of notches 25, thus providing a recessed aperture through which the can at the end of shelf 15 adjacent stop member 26 may be readily grasped for removal. . . .

A stop 28 of a height substantially equal to the height of portions 27 is positioned adjacent the end of shelf 13 to prevent the cans from rolling out of the receptacle.

Id. at 2:13–3:1.

b) Nesso

Nesso is directed to “a compact refrigerated dispenser for dispensing cooled articles, such as soft drink cans.” Ex. 1020, 1:1–3. Figure 4 of Nesso is shown below:

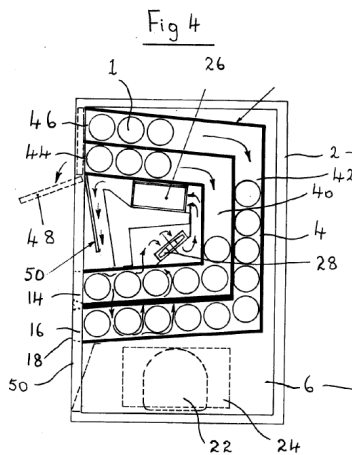


Figure 4 “is a cross-sectional side view” of an embodiment of Nesso’s dispenser. *Id.* at 2:8–9. Figure 4 shows, *inter alia*, two chutes, 40 and 42, which are filled by inserting cans through entrances 44 and 46. *Id.* at 3:25–29. Cans are dispensed by removing them from apertures 14 and 16. *Id.* at 3:37–38.

3. *Differences Between the Prior Art and the Claims;
Motivation to Modify*

Petitioner asserts that the combined teachings of Weichselbaum and Nesso would have rendered the subject matter of claims 17, 20, 25, and 26 obvious to one of ordinary skill in the art at the time of the invention. Pet. 24–45; *see* Paper 95 (narrowing the claims for which this challenge is maintained).

a) *Claim 17*

Petitioner provides a claim chart indicating where each limitation of claim 17 allegedly is taught in Weichselbaum, Nesso, or both. Pet. 28–31. In particular, Petitioner relies upon Weichselbaum as disclosing most of the elements of the claim, but acknowledges that Weichselbaum “does not have a second upper chute having a second loading opening, and it does not have a door movable between an open position wherein the loading openings are exposed and a closed position wherein the door covers the loading openings.” *Id.* at 31–32. Instead, Petitioner relies upon Nesso as disclosing those elements of the claim. *Id.*

Petitioner contends that one of ordinary skill in the art would have been motivated to “add a second upper chute section to Weichselbaum to allow for two different canned products to be dispensed and/or to increase the capacity of the dispenser using roughly the same amount of shelf space.” *Id.* at 32 (citing Ex. 1002 ¶ 168). Additionally, Petitioner asserts that one of ordinary skill in the art would have been motivated “to include a hinged door covering the loading openings as that would allow a retailer to include labeling advertising the products being sold.” *Id.* (citing Ex. 1002 ¶ 169).

Patent Owner raises several arguments in response to Petitioner’s challenge. We focus on Patent Owner’s arguments directed to the “offset

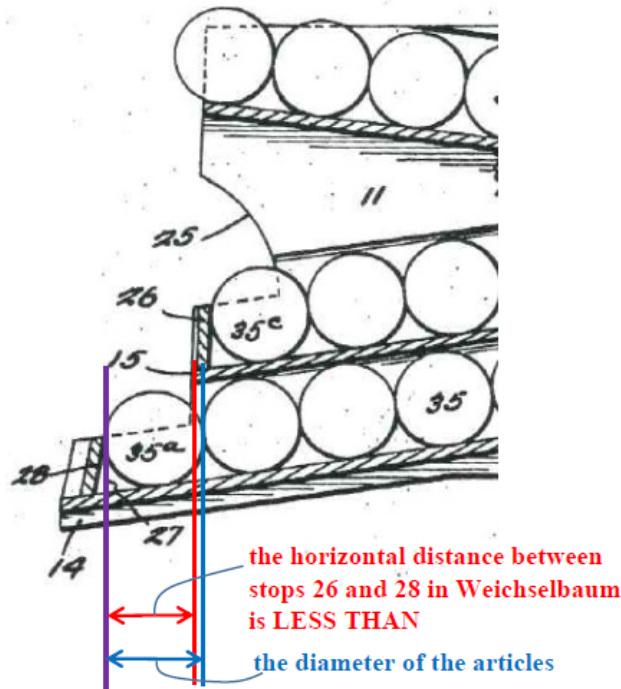
rearwardly” limitation of the claims. *See, e.g.*, PO Remand Resp. 26–33. Patent Owner reiterates its argument from the Preliminary Response that Petitioner relies upon Figure 3 of Weichselbaum as disclosing the stop structures’ locations, but that Figure 3 fails to teach the “offset rearwardly” limitation because the offset in Weichselbaum is not greater than the diameter of the products. *Id.* at 28–29.

No new evidence has been presented on this issue on remand and the parties’ arguments are essentially the same as those presented prior to our Institution Decision. In our Institution Decision, we stated the following:

Claim 17 recites, *inter alia*, “the stop structure of said second chute being . . . offset rearwardly from the stop structure of said first chute a horizontal distance greater than the diameter of the products.” Ex. 1001, 18:27–31. The Petition attributes this limitation to Weichselbaum in the following manner: “Fig. 3; the stop structure (26) of the second (upper) chute is offset rearwardly from the stop structure (28) of the first (lower) chute a horizontal distance greater than the diameter of the products.” Pet. 31. Petitioner’s position appears to be based on its claim construction, which we rejected. *See supra* Section II.C. (discussing the construction of the phrase “the stop structure of said second chute being . . . offset rearwardly from the stop structure of said first chute a horizontal distance greater than the diameter of the products”). We decline to rewrite the claim to require only “at least a portion” of the stop structure of the second chute to be offset a horizontal distance greater than the diameter of the products.

Additionally, Figure 3, as discussed by Patent Owner, does not, on its face, appear to satisfy the offset requirement

recited in the claim. Weichselbaum's Figure 3, annotated by Patent Owner, is reproduced below:



Weichselbaum, detail of FIG. 3, annotated.

Patent Owner annotated Figure 3 of Weichselbaum to identify the horizontal distance of the offset between the two stop structures. Prelim. Resp. 25.^[22]

Patent drawings not designated as being drawn to scale cannot be relied upon to define precise proportions of elements if the specification is completely silent on the issue.

Hockerson-Halberstadt, Inc. v. Avia Grp. Int'l, Inc., 222 F.3d 951, 956 (Fed. Cir. 2000). Nonetheless, Petitioner bases its argument on Figure 3, unmodified. Pet. 31. Petitioner bears the burden to show that it is likely to prevail in its challenge to the claims. In light of Petitioner's focus on Figure 3, Patent Owner is entitled to rely upon the same figure to rebut Petitioner's position. Here, Patent Owner has done so successfully. In light of the lack of any argument or explanation by Petitioner as to how Figure 3 teaches this

²² Patent Owner reproduces the same annotated version of Weichselbaum's Figure 3 in its Response on Remand. See PO Remand Resp. 33.

element of the claim, we determine that Petitioner's assertion is not supported sufficiently for purposes of this Decision.

Inst. Dec. 29–30.

Petitioner has not provided any persuasive reason as to why we should disturb our preliminary findings with respect to whether Weichselbaum teaches the “offset rearwardly” limitation of claim 17. *See* Pet. Remand Reply 17 & n.8 (Petitioner reiterates its reliance on Weichselbaum's Figure 3 even though not drawn to scale). In particular, the only argument raised by Petitioner as to how Weichselbaum allegedly teaches the “offset rearwardly” limitation of claim 17 is dependent upon Petitioner's proposed construction, which we do not adopt. *See* Pet. Remand Reply 17 (arguing only based on Petitioner's proposed construction). Patent Owner's annotation, reproduced above, however, demonstrates that Weichselbaum's Figure 3 does not teach “the stop structure of said second chute being . . . offset rearwardly from the stop structure of said first chute a horizontal distance greater than the diameter of the products,” as recited in claim 17. Therefore, we find that Petitioner has not shown by a preponderance of the evidence that Weichselbaum teaches the “offset rearwardly” limitation.

Additionally, we find that Petitioner has not set forth any argument or evidence that a person of ordinary skill in the art would have modified Weichselbaum to meet the “offset rearwardly” claim limitation. Nor does Petitioner rely upon Nesso to meet this claim limitation. *See* Pet. 31 (mapping the “offset rearwardly” limitation in its chart to Weichselbaum, Figure 3). At the oral hearing, counsel for Petitioner confirmed that its challenge to claim 17, in the Petition, is based upon its proposed claim construction and that it does not assert that the combination of Weichselbaum and Nesso would have rendered claim 17 obvious under the

construction we adopted preliminarily in our Institution Decision, and which we have reaffirmed here. Tr. 27:18–28:23.

Accordingly, on the full record before us, we determine that Petitioner has not shown that the combination of Weichselbaum and Nesso teaches the rearward offset limitation recited by claim 17, and that Petitioner has not shown that one of ordinary skill in the art would have had a reason to modify Weichselbaum to meet this limitation of claim 17.

b) Claims 20, 25, and 26

Claims 20, 25, and 26 depend from claim 17. With respect to these dependent claims, Petitioner relies upon Weichselbaum to the same extent discussed above and does not rely upon Nesso as teaching the “offset rearwardly” limitation of the stop structures. *See* Pet. 41–43 (claim 20), 43–44 (claim 25), 45 (claim 26). Accordingly, we find that the deficiency identified above regarding claim 17 applies equally to dependent claims 20, 25, and 26.

4. Objective Indicia of Nonobviousness

The parties raise arguments regarding objective indicia of nonobviousness. PO Remand Resp. 38–48; Pet. Remand Reply 20–23; PO Remand Sur-reply 1–10. As noted above, however, Petitioner (1) fails to establish that the combination of Weichselbaum and Nesso teaches the “offset rearwardly” limitation recited in the claims, and (2) does not argue that it would have been obvious to modify the rearward offset of Weichselbaum. Therefore, we need not determine whether Patent Owner has established that the objective indicia of nonobviousness support its

arguments for patentability of claims 17, 20, 25, and 26 in order to reach a determination as to the balance of the evidence before us.²³

5. *Weighing the Graham Factors*

“Once all relevant facts are found, the ultimate legal determination [of obviousness] involves the weighing of the fact findings to conclude whether the claimed combination would have been obvious to an ordinary artisan.” *Arctic Cat*, 876 F.3d at 1361. In weighing the facts here, we determine that the level of skill in the art does not favor either Petitioner’s or Patent Owner’s case. Neither party argues that the level of skill is either so high or low as to weigh in favor of their arguments as opposed to the other’s; nor do the parties argue that the level of skill specifically impacts our legal determination of obviousness in any specific manner.

Turning to our findings regarding the scope and content of the prior art and the differences between the prior art and the claimed invention, we determine that they weigh in favor of Patent Owner. Although the scope and content of the prior art are in some ways similar to the claimed invention, we determine that Petitioner has not shown sufficiently that the combination of Weichselbaum and Nesso teaches the “offset rearwardly” limitation of

²³ In our first Final Written Decision, we found (1) that Patent Owner’s evidence “provide[s] a strong showing of commercial success of the commercial embodiment of claim 27 of the ’111 patent” (Final Dec. 62) and (2) that Patent Owner “established that Petitioner copied Patent Owner’s display racks” (*id.* at 64). We then determined that “[o]n balance . . . based on the complete record before us, Patent Owner’s evidence of non-obviousness outweighs Petitioner’s evidence of obviousness.” *Id.* at 65. The Federal Circuit confirmed that our findings regarding secondary considerations were supported by substantial evidence. *Campbell Soup Co.*, 2019 WL 5152396, at *5.

claim 17 and the challenged claims that depend therefrom. Thus, the scope and content of the prior art and differences between the prior art and the claims at issue weigh in favor of Patent Owner on the record before us. Accordingly, regardless of whether objective indicia support patentability, on balance, we determine that Petitioner fails to establish that claims 17, 20, 25, and 26 would have been obvious to one of ordinary skill in the art at the time of the invention. Accordingly, we determine that Petitioner has not demonstrated, by a preponderance of the evidence, that claims 17, 20, 25, and 26 of the '111 patent are unpatentable.

D. Patent Owner's Motion for Leave

Patent Owner seeks leave to file a certificate of correction to correct two alleged errors: (1) to change the dependency of claim 20 from claim 17 to claim 19 and (2) to change the dependency of claim 21 from claim 18 to claim 20. Motion for Leave 2. Patent Owner contends that the changes proposed are to correct printing errors. *Id.* Patent Owner represents that “[t]he correction should not be prejudicial to any party to the present IPR, and, in fact, may be postponed until after a Final Written Decision.” *Id.* Patent Owner also represents that Petitioner does not contest the Motion for Leave. *Id.* at 3.

We have exclusive jurisdiction over the challenged patent during an *inter partes* review proceeding and may determine the manner in which review of a request for certificate of correction pursuant to 35 U.S.C. § 255 and 37 C.F.R. § 1.323 is to proceed. *See* 35 U.S.C. § 255 (giving the Director authority to determine the manner in which an *inter partes* review and any other proceeding or matter involving the patent may proceed); 37 C.F.R. § 42.3(a) (granting the Board “exclusive jurisdiction within the

Office over every involved application and patent during the proceeding, as the Board may order”).

Claim 20 is included in Ground 2a and is not part of the stipulation between the parties. If claim 20 depended from claim 19, instead of claim 17, it is likely that the parties may have included claim 20 within their stipulation as they have with other claims that depend from claim 19, e.g., claim 23.²⁴ *See* Motion for Leave 3 (referring to the challenges withdrawn in Petitioner’s Reply on Remand).

We do not control the process by which a certificate of correction is reviewed, nor do we control the speed by which that process occurs. Thus, to keep the record as clear as possible, we did not rule on Patent Owner’s Motion for Leave prior to issuing this Final Written Decision. At this time, however, we see no reason to delay Patent Owner from filing its request for correction. Accordingly, Patent Owner’s Motion for Leave is granted.²⁵

²⁴ Petitioner explained during the second oral hearing that it sought to withdraw its challenge to claim 23 because it depends from claim 18. Tr. 7:1–9. Claim 19 depends from claim 18. Therefore, any claims that depend from claim 19, which would include claim 20 if corrected, also depend from claim 18.

²⁵ We do not express any opinion on the merits of the errors alleged by Patent Owner or the future request for correction. Patent Owner should reference this Decision in its request.

III. SUMMARY

For the reasons discussed above, Petitioner has not shown, by a preponderance of the evidence, that claims 17, 20, 25, and 25 would have been obvious over the combination of Weichselbaum and Nesso.

Additionally, we accept the parties' stipulation that Petitioner has not shown, by a preponderance of the evidence, that claims 18, 19, 21–24, and 27–35 of the '111 patent are unpatentable. The chart below summarizes our conclusions and the parties' stipulation.

Claim(s)	35 U.S.C. §	References/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
17–20, 25, 26	103(a)	Weichselbaum, Nesso		17–20, 25, 26
18, 19	103(a)	Weichselbaum, Nesso, Rogers		18, 19
21, 22, 24	103(a)	Weichselbaum, Nesso, Mellion		21, 22, 24
24	103(a)	Weichselbaum, Nesso, Mellion, Schwimmer		24
23	103(a)	Weichselbaum, Nesso, Luster		23
27, 28, 33, 34	103(a)	Weichselbaum, Nesso, Rogers		27, 28, 33, 34
29	103(a)	Weichselbaum, Nesso, Luster		29
29	103(a)	Weichselbaum, Nesso, Luster, Rogers		29
30	103(a)	Weichselbaum, Nesso, Luster, Knott		30
30	103(a)	Weichselbaum, Nesso, Luster, Knott, Rogers		30
31	103(a)	Weichselbaum, Nesso, Luster, Mellion		31
31	103(a)	Weichselbaum, Nesso, Luster, Schwimmer		31
31	103(a)	Weichselbaum, Nesso, Luster, Mellion, Rogers		31
31	103(a)	Weichselbaum, Nesso, Luster, Schwimmer, Rogers		31
32, 35	103(a)	Weichselbaum, Nesso, Mellion, Rogers		32, 35
Overall Outcome				17–35

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 17–35 of U.S. Patent No. 8,827,111 B2 have not been shown to be unpatentable;

FURTHER ORDERED that Patent Owner’s Motion for Leave to Request Certificate of Correction is *granted*; and

FURTHER ORDERED that, because this a Final Written Decision, parties to this proceeding seeking judicial review of this Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2017-00087
Patent 8,827,111 B2

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