

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOWARD INDUSTRIES, INC.,
Petitioner,

v.

CAPSA SOLUTIONS LLC,
Patent Owner.

IPR2023-01274
Patent 7,594,668 B2

Before BART A. GERSTENBLITH, MATTHEW S. MEYERS, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Howard Industries, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 3 and 4 (“the Challenged Claims”) of U.S. Patent No. 7,594,668 B2 (“the ’668 patent,” Ex. 1001). Paper 1. Petitioner supports the Petition with a Declaration of Mr. Ronald B. Kemnitzer. Ex. 1004. Capsa Solutions LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Patent Owner supports the Preliminary Response with a Declaration of Pinhas Ben-Tzvi. Ex. 2001. With our authorization, Petitioner filed a Preliminary Reply. Paper 7 (“Prelim. Reply”). Patent Owner filed a Preliminary Sur-reply. Paper 8 (“Prelim. Sur-reply”).

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314(a). *See* 37 C.F.R. § 42.4(a) (2021) (“The Board institutes the trial on behalf of the Director.”). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Considering the Petition, the Preliminary Response, Preliminary Reply, Preliminary Sur-reply as well as all supporting evidence, we conclude that the information presented in the Petition establishes a reasonable likelihood that Petitioner would prevail in showing at least one claim of the ’668 patent is unpatentable. Pursuant to 35 U.S.C. § 314, we hereby institute an *inter partes* review of all challenged claims of the ’668 patent on all grounds stated in the Petition. *See* 37 C.F.R. § 42 (“When instituting . . . review, the Board will authorize the review to proceed on all

of the challenged claims and on all grounds of unpatentability asserted for each claim.”); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1359–60 (Fed. Cir. 2018) (interpreting the relevant statutory provisions, in light of *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348 (2018), to require “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”).

A. Related Matters

The parties identify the ’668 patent as a subject of:

- 1) *Capsa Solutions LLC v. Howard Industries, Inc.*, 2:22-cv-00065 (S.D. Miss.) (“the Parties’ district court litigation”);
- 2) *Capsa Solutions LLC v. Simplifi Medical, LLC*, 1:22-cv-05527 (N.D. Ill.);
- 3) *Rubbermaid, Inc. v. Capsa Solutions LLC*, 3:12-cv-00611 (W.D. N.C.); and
- 4) *Rubbermaid Inc. v. EnovateIT, LLC*, 3:11-cv-00209 (W.D. N.C.).

Pet. 87; Paper 3, 1. Although not identified by the parties as a related matter, Petitioner challenges claims of U.S. Patent No. 8,215,650 B2 (“the ’650 patent”) in co-pending IPR2023-01275. The ’650 patent claims priority to the ’668 patent. IPR2023-01275, Ex. 1001, code (60).

B. Real Parties-in-Interest

Petitioner identifies Howard Industries, Inc. as the sole real party-in-interest. Pet. 87. Patent Owner identifies Capsa Solutions LLC as the sole real party-in-interest. Paper 3, 1.

C. The ’668 Patent

The ’668 patent is titled “Medical Cart, Medication Module, Height Adjustment Mechanism, and Method of Medication Transport.” Ex. 1001,

code (54). The '668 patent issued on September 29, 2009, from Application No. 12/193,346, which was filed on August 18, 2008. *Id.* at codes (45), (21), (22).

The '668 patent discloses that “[s]ome hospitals provide nurses with medical carts on which a networked laptop computer facilitates the use of Electronic Medical Administration Records (‘EMAR’).” Ex. 1001, 1:25–28. However, these medical carts are unsatisfactory in that they are not ergonomically designed, lack a work surface, have bad placement of medication drawers or lack storage space, and cannot be raised or lowered. *Id.* at 1:41–49.

Figure 1 of the '668 patent is reproduced below:

Fig. 1

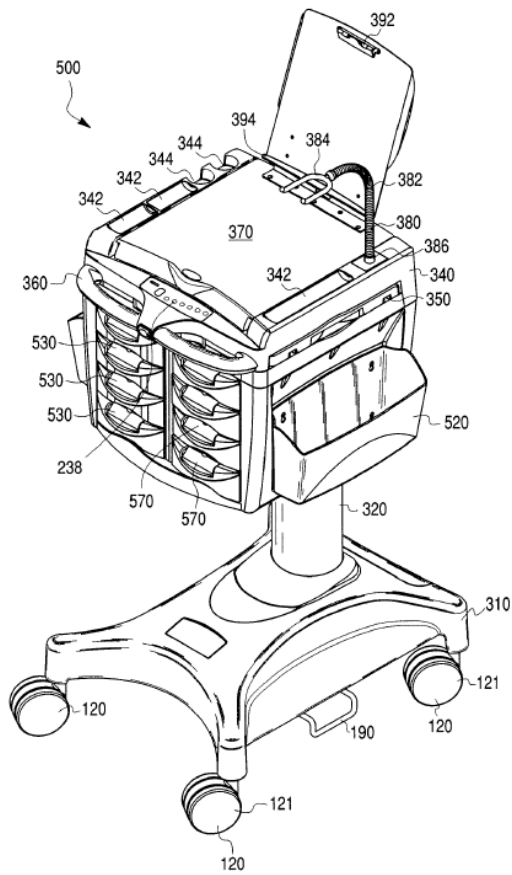


Figure 1 is a perspective view of a medical cart of the '668 patent. Ex. 1001, 3:13–14. Medical cart 500 includes laptop platform 370, work platform 340, work surface 350, compartments 530, and support mechanism 320 that supports and adjusts the height of work platform 340 on base 310. *Id.* at 4:23–31. Base 310 includes rolling members 120 such as casters for movability. *Id.* at 9:64–65.

Figure 9A of the '668 patent is reproduced below:

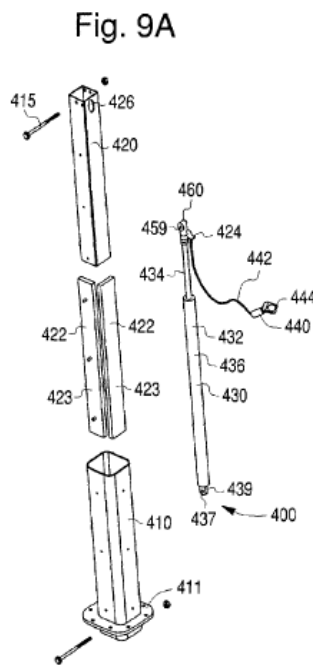


Figure 9A is an exploded view of a height adjustment mechanism of the medical cart. Ex. 1001, 3:37–38. The height adjustment mechanism includes driver 430 having gas driven piston 432 with body portion 436, and telescoping strut 434. *Id.* at 8:52–53. The height adjustment mechanism also includes outer casing 410, telescoping inner casing 420, drawer slides 422, and ball bearings which function as “conventional drawer rails.” *Id.* at 8:29–51. Driver 430 is controlled by actuator 440 and is connected to actuator 440 by connector 442. *Id.* at 8:54–55. Actuator 440 is “provided in

a front portion” of medical cart 500. *Id.* at 9:1–2. Actuator 440 includes button 444 allowing work platform 340 to be releasably locked at a plurality of height positions. *Id.* at 9:2–21. A user “can ergonomically access” items as work platform 340 is raised or lowered. *Id.* at 4:34–35.

D. Illustrative Claim

Claims 3 and 4 are independent. Claim 3 is reproduced with Petitioner’s annotations below:

- [3pre] A cart comprising:
 - [3a] a work platform including a work surface and compartments for containing items;
 - [3b] a base configured to be movable in at least a rearward direction; and
 - [3c] a height adjustment mechanism for adjusting the height of the work platform relative to the base,
 - [3d] wherein the base includes a portion that projects from the height adjustment mechanism in a forward direction that is substantially opposite to the rearward direction,
 - [3e] wherein the work platform includes a portion that projects from the height adjustment mechanism in the forward direction, the compartments are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction, and the compartments are configured to permit a user facing in the rearward direction to access an item within the compartments,
 - [3f] wherein the height adjustment mechanism is configured to releasably lock the work platform at a plurality of heights,
 - [3g] wherein the height adjustment mechanism comprises:
 - a stationary casing connected to the base;
 - a telescoping casing connected to the work platform and configured to move relative to the stationary casing;
 - [3h] at least two drawer slides disposed between the stationary casing and the telescoping casing;
 - [3i] a driver configured to releasably lock the telescoping casing relative to the stationary casing; and
 - [3j] an actuator for controlling the driver, and

[3k] wherein the actuator is disposed above the compartments and on the portion of the work platform that projects in the forward direction.

Ex. 1001, 14:61–15:27.

E. Prior Art and Asserted Grounds

Petitioner asserts that claims 3 and 4 would have been unpatentable on the following grounds (Pet. 3)¹:

Claim(s) Challenged	35 U.S.C. §²	References/Basis
3	103(a)	Clark, ³ Manner, ⁴ Santoro ⁵
3	103(a)	Clark, Manner, Santoro, Gillis ⁶
4	103(a)	Clark, Manner
4	103(a)	Clark, Manner, Gillis
3	103(a)	Reeder, ⁷ Manner, Santoro
3	103(a)	Reeder, Manner, Santoro, Gillis
4	103(a)	Reeder, Manner
4	103(a)	Reeder, Manner, Gillis

¹ In the chart above, we have broken out the eight grounds asserted by Petitioner to identify each. Petitioner describes these eight grounds as “1A/B,” “2A/B,” “3A/B,” and “4A/B.” Pet. 3.

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included revisions to 35 U.S.C. §§ 102 and 103 that became effective after the effective filing date of the Challenged Claims. Therefore, we apply the pre-AIA version of 35 U.S.C. § 103.

³ U.S. Patent No. 6,493,220 B1 (Dec. 10, 2002). Ex. 1010 (“Clark”).

⁴ U.S. Patent No. 5,682,825 (Nov. 4, 1997). Ex. 1007 (“Manner”).

⁵ U.S. Patent Publication No. 2002/0145088 A1 (Oct. 10, 2002). Ex. 1008 (“Santoro”).

⁶ U.S. Patent Publication No. 2003/0084828 A1 (May 8, 2003). Ex. 1019 (“Gillis”).

⁷ U.S. Patent Publication No. 2002/0044059 A1 (Apr. 18, 2002). Ex. 1006 (“Reeder”).

II. ANALYSIS

A. Overview

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations).⁸ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art “would have at least a four-year college degree in mechanical engineering, biomedical engineering, industrial design, or a closely related field and at least one year of experience in product development and design for commercial workstations and work platforms.” Pet. 7 (citing Ex. 1004 ¶¶ 17–18). Petitioner further contends that “[a]dditional education could substitute for professional experience, and significant work experience could substitute for formal education.” *Id.*

Patent Owner points to Dr. Ben-Tzvi’s testimony in which he contends that a person of ordinary skill in the art “would have had a

⁸ No evidence of secondary considerations has been presented at this stage of the proceeding.

bachelor's degree in a pertinent discipline involving mechanical product design, such as mechanical engineering, with 2-3 years experience in in [sic] the design, manufacture, or analysis of mechanical devices.” Ex. 2001 ¶ 21 *cited in* Prelim. Resp. 15.⁹ Dr. Ben-Tzvi also provides an alternative as one of ordinary skill in the art “with a 2-year mechanical engineering diploma and . . . 4-6 years of experience in in [sic] the design, manufacture, or analysis of mechanical components and devices.” *Id.* Patent Owner contends that “Petitioner submits a somewhat different, and broader, definition” of a person of ordinary skill in the art than Patent Owner’s definition because Petitioner’s definition includes industrial design which is a field that does not require the same level of hard sciences as Patent Owner’s definition. Prelim. Resp. 15–16. Patent Owner argues that “[w]hile the field of industrial design does not have a set definition, the field is generally more directed toward aesthetic design and, at best high-level functionality, rather than hard science type mechanical engineering, physics, and detailed implementation considerations.” *Id.* at 16. Patent Owner contends that its definition should be adopted but that notwithstanding, “the Petition should be denied under either party’s definition . . . as Petitioner has failed to meet its burden of establishing a *prima facie* case of obviousness.” *Id.* at 16 (citing Ex. 2001 ¶¶ 22–24).

Patent Owner’s argument that Industrial Design does not have a set definition is supported by Dr. Ben-Tzvi’s testimony. Ex. 2001 ¶ 22. Nonetheless, we give little weight to his testimony on this point because it

⁹ Patent Owner is reminded that arguments may not be incorporated by reference from one document into another document. 37 C.F.R. § 42.6(a)(3).

does not disclose the underlying facts or data on which the opinion is based. *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”). Based on the present record, we do not exclude Industrial Design from the definition of the level of ordinary skill in the art, although the parties are free to address this issue further during trial.

For the purposes of this Decision, we apply Petitioner’s level of skill in the art because it appears consistent with the problems addressed in the ’668 patent and the prior art. Our Decision would not be affected if we were to apply Patent Owner’s definition.

C. Mr. Kemnitzer’s Testimony

Patent Owner contends that we should give little to no weight to Mr. Kemnitzer’s testimony because his “education and experience is in industrial design, rather than mechanical engineering.” Prelim. Resp. 56 (citing Ex. 1004 ¶¶ 4–6). According to Patent Owner, “[s]uch qualifications are directed more toward aesthetics than hard science,” while “[m]echanical engineering concerns are at the core of certain deficiencies in Mr. Kemnitzer’s analysis.” *Id.* (citing Ex. 2001 ¶ 58).

Regardless of the precise contours of industrial design, Mr. Kemnitzer testifies that he has “substantial direct experience in designing products that utilize the manufacturing processes, components, and materials of the designs at issue in this matter” and “in designing fully adjustable products for the commercial furniture, computer, and healthcare industries.” Ex. 1004 ¶ 5. Thus, on the present record and at this stage of the proceeding, we decline to minimize the weight given to his testimony for

this reason. The parties, however, are free to address this issue further during trial.

D. Claim Construction

We apply the same claim construction standard used by Article III federal courts and the International Trade Commission, both of which follow *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b) (2019). The claim construction standard includes construing claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art at the time of the invention. *See id.* at 1312–14. In construing claims in accordance with their ordinary and customary meaning, we take into account the specification and prosecution history. *Id.* at 1315–17.

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*, 415 F.3d at 1316 (citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)). Another exception to the general rule that claims 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)).

Petitioner contends that “the ’668 patent is obvious under any reasonable constructions.” Pet. 8. Petitioner argues that it contends in district court that the term “an actuator for controlling the driver” is indefinite for invoking means-plus-function claiming without providing

corresponding structure. *Id.* at 8–9 (citing Ex. 1029, 36–40; Ex. 1030, 28–32; Ex. 1012, 3–4). Petitioner, however, adopts Patent Owner’s construction of this term for the purposes of this proceeding—“a mechanism to activate or control equipment, e.g., by use of pneumatic, hydraulic, or electronic signals.” *Id.* at 9 (quoting Ex. 1012, 3–4). Petitioner also points out that, in the district court, the parties’ proposed constructions of “work surface” also differ. Pet. 9. Specifically, Petitioner advocates that the term should be construed as “a curved surface at the top of a cart large enough to dispense medication or hold work papers,” while Petitioner characterizes Patent Owner as arguing “for a broader ‘plain and ordinary meaning’ construction.” *Id.* (citing Ex. 1012, 8–9). Petitioner, however, states that it “includes alternate grounds using Gillis to demonstrate how the claims are invalid under either Petitioner or Patent Owner’s construction.” *Id.*

Patent Owner contends that Petitioner fails to expressly adopt or set forth any claim definitions aside from the term “work surface.” Prelim. Resp. 17. Patent Owner, however, contends that the claimed invention is valid under any reasonable construction. *Id.* Patent Owner also contends that the term “compartment” should be construed as “an enclosed space for containing an item” and that the definition of the term “work surface” is not dispositive here. *Id.* at 19–20.

We determine that it is not necessary to construe “work surface” expressly at this stage of the proceeding because the construction of the term does not resolve the present controversy between the parties. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only

to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

With respect to “compartment,” Patent Owner contends that Petitioner agreed to its proposed construction in ongoing district court litigation between the parties. Prelim. Resp. 17 (citing Ex. 1031, 36; Ex. 2006). Patent Owner further contends that its “proposed definition of ‘compartment’ as being ‘*enclosed*’ is consistent with the definition adopted by the [United States District Court for the] Western District of North Carolina.” *Id.* at 17–18 (citing Ex. 1013, 6).¹⁰ According to Patent Owner, the Western District of North Carolina defined compartment “as ‘a drawer or other type of container that is enclosed when inserted into the work platform of which it forms a part.’” Ex. 1013, 6.

Patent Owner argues that the Specification of the ’668 patent supports its proposed construction. Prelim. Resp. 18–19. Patent Owner argues the ’668 patent “teaches that the ‘. . . compartments 530 enable a user (e.g., a nurse) to separately maintain medication for particular patients or for a particular room’” and “the compartments may be lockable . . . may be labeled drawers . . . and may be otherwise removable and/or exchangeable.” *Id.* at 18 (first omission in original) (citing Ex. 1001, 2:15, 7:30–35, 7:45–67, 8:1–5). Patent Owner further argues that the ’668 patent “repeatedly contrasts the claimed ‘compartment’ from unenclosed storage spaces.” *Id.* at 19 (citing Ex. 1001, 2:38–39, 3:14–15, 3:37, 4:30–34, Fig. 1). Patent Owner also argues that Figure 7 is described “as a medical cart ‘*without* compartments’ (showing the drawers removed) yet the side bin 520 storage

¹⁰ Petitioner was not a party to the Western District of North Carolina litigation. *See* Pet. 87.

unit is shown as part of the medical cart in Figure 7.” *Id.* at 19 (citing Ex. 1001, 3:33–35, Fig. 7). According to Patent Owner, “[t]his confirms that enclosed ‘compartments’ are distinguishable from open items like side bins and keyboard tray cavities.” *Id.*

We appreciate Patent Owner’s citations to the Specification. Patent Owner, however, does not argue that the ’668 patent contains a lexicographic definition of compartment or that the patentee disavowed the full scope of the claim term compartment. Prelim. Resp. 17–19. In the absence of either a lexicographic definition or disavowal of claim scope, we decline to limit compartment to the embodiments described in the Specification and apply the plain and ordinary meaning of compartment, as discussed below in our analysis of limitation 3[a], for the purposes of this Decision.¹¹

The parties are not precluded from arguing the construction of any claim term during trial and are free to do so in any subsequent briefing.

E. Ground 1: Alleged Obviousness of Claim 3 over Clark, Manner, and Santoro, with or without Gillis

Petitioner contends claim 3 would have been obvious over Clark, Manner, and Santoro, with or without Gillis. Pet. 10–41. Petitioner supports its contentions with the Mr. Kemnitzer’s declaration. Ex. 1004.

We begin with a brief summary of Clark, Manner, Santoro, and Gillis and then address Petitioner’s contentions.

¹¹ We are not bound by agreements between Petitioner and Patent Owner concerning the construction of compartment or any other claim term.

1. *Clark (Ex. 1010)*

Clark is titled “Mobile Clinical Workstation.” Ex. 1010, code (54). Clark discloses “a mobile workstation that can include an adjustable-height horizontal tray, a pull-out keyboard tray, a vertically-mounted docking station mounted to the tray, a computer terminal mounted beneath the tray, a display screen mounted to the horizontal tray, and a power unit.” *Id.* at 1:7–12.

Figure 1 of Clark is reproduced below:

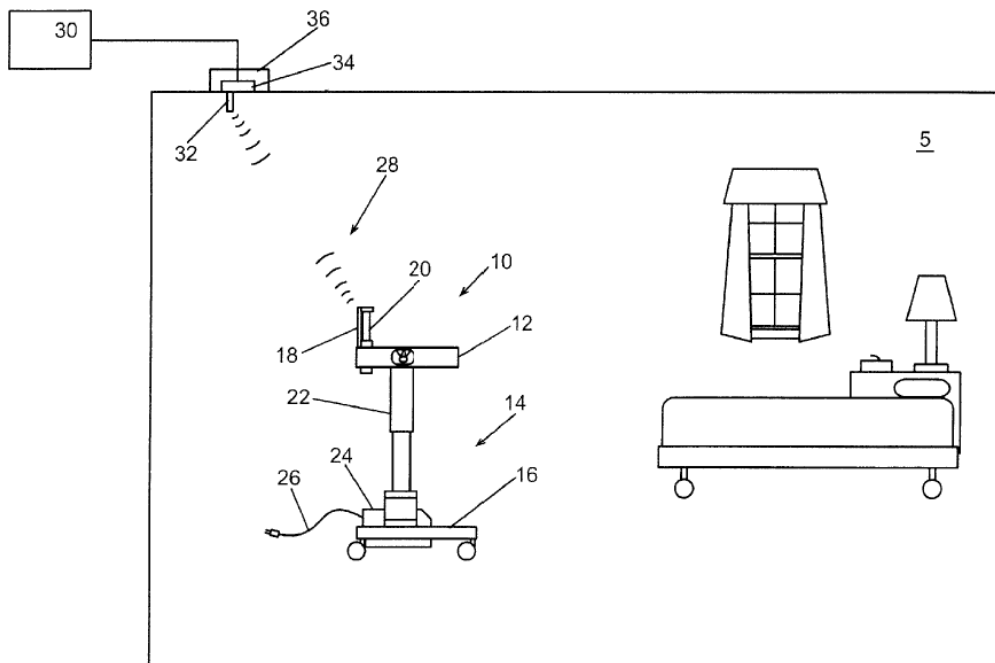


Fig. 1

Figure 1 illustrates a mobile workstation of Clark that is in a patient’s hospital room. Ex. 1010, 4:29–31. Mobile workstation 10 includes docking station 18 and adjustable-height tray 12 supported by chassis 14. *Id.* at 8:50–59. Chassis 14 includes vertical beam 22 and dolly assembly 16. *Id.* at 8:55–62. Vertical beam 22 includes “a gas-spring height adjustment mechanism for adjusting the length of the beam.” *Id.* at 8:63–64.

Figure 4B of Clark is reproduced below:

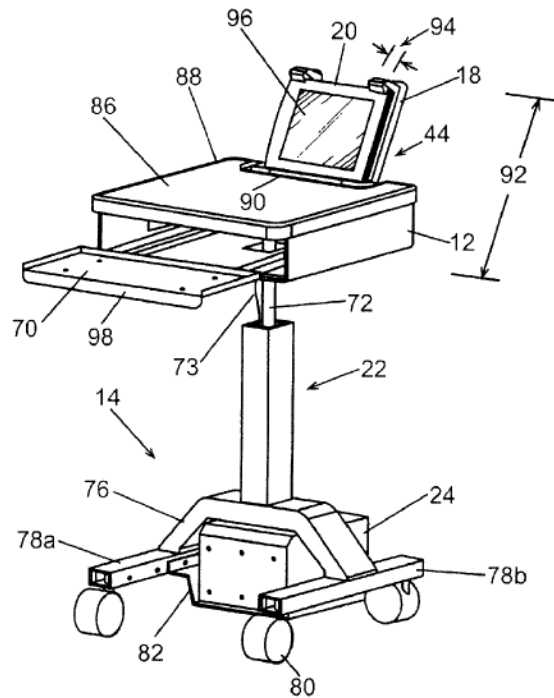


Figure 4B is a perspective view of a mobile workstation of Clark, with a pull-out keyboard tray. Ex. 1010, 4:40–42. The mobile workstation includes pull-out keyboard tray 70, which is supported by the underside of horizontal tray 12 and can slide from an inner position to an outer position as shown. *Id.* at 11:40–45.

2. Manner (Ex. 1007)

Manner is titled “Height-Adjustable Work Table.” Ex. 1007, code (54). Manner discloses that its height-adjustable work table has a support frame with at least one telescopic column. *Id.* at code (57).

Figure 5 of Manner is reproduced below:

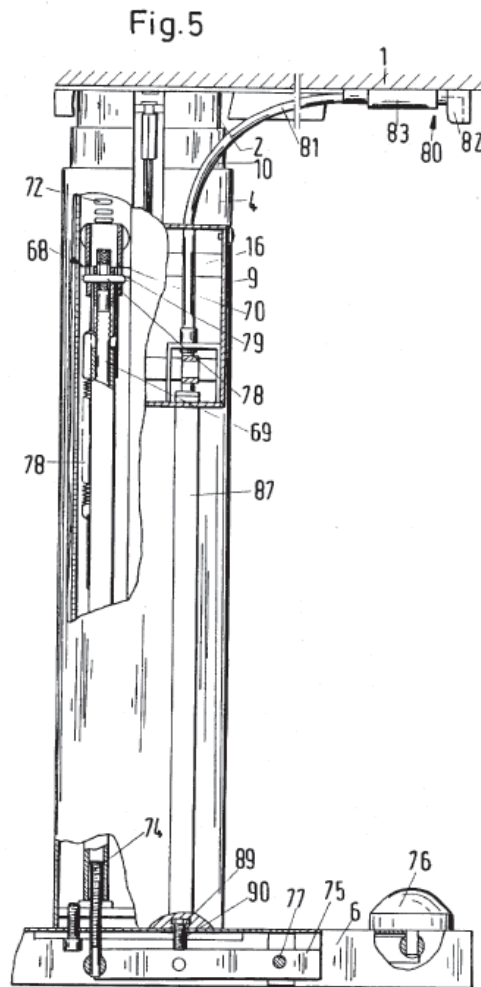


Figure 5 is a partly sectional and partly elevated view of a work table of Manner. Ex. 1007, 3:44–46. Manner discloses that table top 1 can be arrested at a “selected level relative to the table frame” via arresting device 68 in column 4. *Id.* at 8:38–40. Arresting device 68 is actuated by actuating device 80 which comprises Bowden pull 81. *Id.* at 9:17–26. Bowden pull 81 includes handle or pivotable grip 82 held by holder 83 that is positioned “at any desired location” so that “actuating device 80 can be easily activated by the user.” *Id.* at 9:26–36.

3. *Santoro (Ex. 1008)*

Santoro is titled “Workstation with Adjustable Height Frame.” Ex. 1008, code (54). Santoro discloses that its workstation includes slide mechanisms having ball bearings which “are well known to those skilled in the art of drawer slides, for example.” *Id.* ¶ 36.

4. *Gillis (Ex. 1019)*

Gillis is titled “Tray for Supporting a Computer Keyboard and Mouse on Substantially a Common Horizontal Plane.” Ex. 1019, code (54). The tray is “for supporting multiple input devices, such as a keyboard and a mouse, on substantially a common plane and for accommodating both left-handed and right-handed people.” *Id.* ¶ 1. The tray has a base and a slide member. *Id.* ¶ 20.

5. *Claim 3*

Petitioner provides a limitation-by-limitation analysis of claim 3, mapping each claim limitation to the combination of Clark, Manner, and Santoro, with or without Gillis. Pet. 22–41. Petitioner also argues that a person of ordinary skill in the art would have been motivated to combine the references with a reasonable expectation of success. *Id.* at 17–18.

Patent Owner argues that there are certain deficiencies in Clark. Prelim. Resp. 29–42. Patent Owner also argues that modifying Clark with Manner would not reach the claimed invention. *Id.* at 42–45.

We start by analyzing Petitioner’s contentions for the claim limitations.¹² We then address motivation to combine.

¹² For ease of reference, we utilize Petitioner’s claim annotations.

[3pre] A cart comprising:

Petitioner does not address whether the preamble is limiting but contends that Clark teaches “a cart in the form of ‘[a] mobile workstation includes an adjustable-height horizontal tray and a pull-out keyboard tray mounted beneath the horizontal tray to support a keyboard.’” Pet. 22 (citing Ex. 1004 ¶ 53;¹³ Ex. 1010, Abstract, 1:7–12, 2:59–67, 3:23–59, 4:5–11); *see also id.* at 24 (reproducing Ex. 1010, Fig. 4B).

Patent Owner does not address the preamble of claim 3 in the Preliminary Response. *See* Prelim. Resp. 29–42.

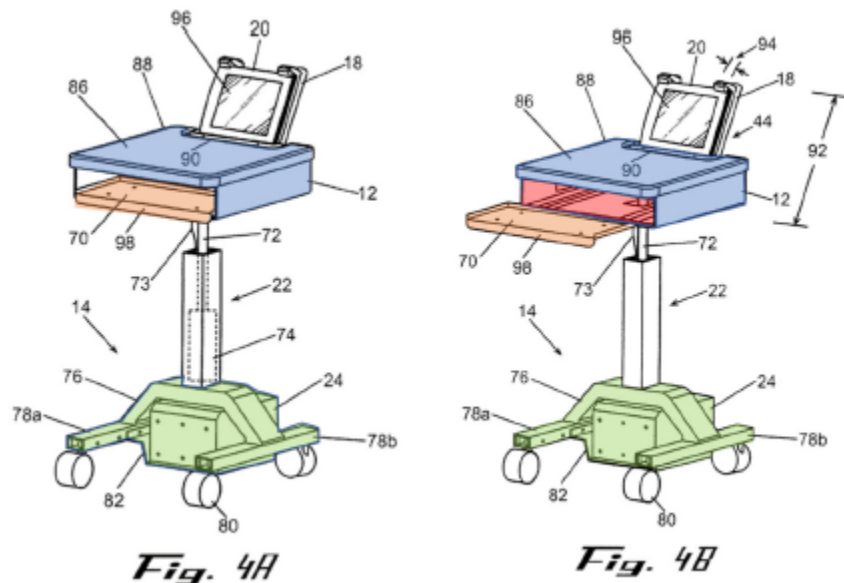
We have reviewed the evidence cited by Petitioner and find, on the present record and at this stage of the proceeding, that Clark sufficiently discloses the subject matter of the preamble. Because we find that Clark sufficiently discloses the subject matter of the preamble, we need not address whether the preamble of claim 3 is limiting.

[3a] a work platform including a work surface and compartments for containing items;

Petitioner contends that “Clark discloses a work platform in its horizontal tray 12” with a top side that “defines a substantially horizontal work surface 86.” Pet. 23 (citing Ex. 1010, 11:67–12:26). Petitioner further contends that “Clark discloses a work surface in the form of a pull-out keyboard tray 70” that “slides from an inner position, shown in FIG. 4A, to an outer position, shown in FIG. 4B.” *Id.* at 23–24 (citing Ex. 1004 ¶¶ 56–57; Ex. 1010, 11:40–45).

¹³ Petitioner’s citation is to “Kemnitzer, 53.” Pet. 22. Based on our review of the Kemnitzer Declaration (Ex. 1004), this citation is to paragraph 53, not page 53. We treat similar citations as referencing paragraphs not pages.

Petitioner provides the following color-annotated version of Figures 4A and 4B of Clark:



Pet. 24. Figures 4A and 4B “are perspective views of” Clark’s mobile workstation “showing the operation of a pull-out keyboard tray.” Ex. 1010, 4:41–43. Petitioner highlights Clark’s horizontal tray 12 in blue, pull-out keyboard tray 70 in orange, the internal walls of horizontal tray 12 in red, and a lower end of chassis 14 in green. Pet. 24.

Petitioner next contends that “Clark also teaches a compartment within the work platform in the form of a cavity below the work surface 86 and above the pullout keyboard tray 70.” Pet. 24 (citing Ex. 1004 ¶¶ 57–58; Ex. 1010, Figs. 4A, 4B). Petitioner argues that “Clark explains that the cavity may be a drawer” and can “alternatively be located **above** or under the horizontal tray 12, demonstrating the flexible nature of the positioning of the work surface and compartments in Clark within the work platform.” *Id.* (citing Ex. 1004 ¶ 59; Ex. 1010, 10:30–33).

Petitioner acknowledges that Clark discloses a single compartment but contends it would have been obvious to a person of ordinary skill in the art “to subdivide the cavity in Clark with multiple drawers or to implement more than one drawer “above or under the horizontal tray 12.” Pet. 25 (citing Ex. 1004 ¶ 59; Ex. 1010, 10:30–33). Petitioner contends that the ordinarily skilled artisan would have been motivated to do this “to improve the ability to organize unlike items in separate storage compartments.” *Id.* (citing Ex. 1004 ¶ 60). Petitioner also argues that “mere duplication of one compartment into two compartments has no patentable significance.” *Id.* (citing *In re Harza*, 274 F. 2d 669, 671 (C.C.P.A. 1960)).

Patent Owner first argues that Clark “does not teach or suggest disposing enclosed compartments (e.g., drawers) in the workstation or how it can be accomplished.” Prelim. Resp. 29. According to Patent Owner, Clark’s cavity does not correspond to the recited compartment because it “is not enclosed.” *Id.* This argument does not undercut Petitioner’s showing at this stage of the proceeding for the following reasons.

Claim 3 recites “compartments” not “enclosed compartments” or “drawers.” The Specification of the ’668 patent, however, suggests that the term compartment, while not necessarily requiring a drawer, encompasses drawers. *See* Ex. 1001, 3:32–33 (describing Figure 7 of the ’668 patent as “a perspective view of a work platform of the medical cart of FIG. 1 without compartments”), 10:37–39 (“The walls 112, 114 support a plurality of compartments 130 which, for example, may be in the form of drawers.”). As discussed above in our claim construction analysis, we do not limit the term “compartment” based on the portions of the ’668 patent cited by Patent Owner including the description of Figure 7, but rather apply the plain and

ordinary meaning. An ordinary definition of compartment is “a part or space marked or partitioned off.”

<https://www.dictionary.com/browse/compartment> (last accessed Jan. 25, 2024).¹⁴ Based on the current record, we preliminarily find that Clark’s cavity, annotated in red by Petitioner (Pet. 24), is a space that is marked or partitioned by four sides and satisfies the ordinary meaning of compartment.

Responding to Petitioner’s alternative argument, Patent Owner further contends “[w]hile Clark makes an unclear and passing reference to alternatively moving the vertically mounted computer docking station . . . to a supporting drawer or pull-out tray, the details are vague, hypothetical and aspirational.” Prelim. Resp. 30 (citing Pet. 24).¹⁵ Patent Owner also argues that “the keyboard cavity of Clark is not provided for the purpose of

¹⁴ We have no reason to believe the plain and ordinary meaning of compartment has changed between the assumed priority date of February 23, 2004 and the later date of the dictionary.

¹⁵ Patent Owner argues, without citation, that “the Examiner, during original prosecution, also dismissed this vague reference in Clark when considering the reference.” Prelim. Resp. 30; *see also id.* at 37 (arguing “the Applicant overcame Clark during prosecution”). The only evidence in the record that Clark was considered during prosecution is an office action issued during prosecution of the related ’650 patent. *See* Ex. 2003. Patent Owner has not identified anything in that office action that speaks to the alternative described in Clark where “the docking station 18 could be supported in a substantially horizontal position, for example by a drawer or pull-out tray located above or under the horizontal tray 12.” *See* Prelim. Resp. 30; Ex. 1010, 10:29–32. Further, that office action issued on January 12, 2012. IPR2023-01275, Ex. 1002, 153. The ’668 patent issued on September 29, 2009. Ex. 1001, code (45). In other words, the ’668 patent issued *before* the office action identified by Patent Owner. Thus, in addition to Patent Owner’s failure to identify where, if at all, the Examiner considered this alternative, the Examiner’s findings during prosecution of the ’650 patent were made after the ’668 patent had issued.

separately storing medical items as intended by the '668 Patent, *e.g.*, medications and medical supplies, because it is already occupied by a pull-out keyboard tray 70, 424 and computer keyboard.” *Id.* at 29–30 (citing Ex. 2001 ¶ 28); *id.* at 30–31 (arguing that modifying Clark’s keyboard cavity “would render the Clark reference unsatisfactory for its intended purpose.”). For the following reasons, these arguments do not undercut Petitioner’s alternative showing at this stage of the proceeding.

Petitioner relies on the following disclosure of Clark: “docking station 18 could be supported in a substantially horizontal position, for example by a drawer or pull-out tray located above or under the horizontal tray 12.” Pet. 24 (quoting Ex. 1010, 10:30–33) (citing Ex. 1004 ¶ 59). We disagree with Patent Owner’s characterization of this excerpt from Clark as vague, hypothetical, and aspirational. Based on the present record, a person of ordinary skill in the art would have understood that a drawer could be positioned above or under horizontal tray 12. Because pull-out keyboard tray 70 is supported by the underside of horizontal tray 12 (Ex. 1010, 11:40–43, Figs. 4A, 4B), a person of ordinary skill in the art would have understood that locating a drawer under horizontal tray 12, as taught in Clark, would not affect use of keyboard tray 70 for containing a computer keyboard while the drawer contemplated under horizontal tray 12 could be utilized for medications and medical supplies. Further, because drawers are contemplated by the '668 patent to be encompassed within the meaning of compartment, this limitation also is satisfied by Clark’s description of locating a drawer above or under horizontal tray 12.

Patent Owner also argues that Clark does not illustrate the referenced drawer in any detail and “never states that the opening/cavity for the

keyboard tray 70 can be *converted* to a drawer.” Prelim. Resp. 30. On the present record, we agree with Patent Owner that Clark does not provide additional details regarding the alternative of adding a drawer aside from expressly stating the option of doing so and does not appear to state that the cavity housing keyboard tray 70 would be converted to a drawer in the alternative described. Nonetheless, as discussed above, Clark expressly describes an alternative configuration where a drawer is added above or under horizontal tray 12 and, on this record at this stage of the proceeding, such drawer satisfies the requirement of a compartment as recited by limitation [3a].

We have reviewed Petitioner’s contentions and evidence in light of Patent Owner’s arguments and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that Clark teaches this limitation.

[3b] a base configured to be movable in at least a rearward direction; and

Petitioner contends that “Clark explains the ‘dolly assembly includes an arched cross-beam 76 that connects to two horizontal runner beams 78a-b” and “[t]wo casters, represented by the caster 80, are connected to the bottom sides of each horizontal runner beam.” Pet. 27 (citing Ex. 1010, 11:59–63, 16:26–30, Fig. 4B). Petitioner further contends that an ordinarily skilled artisan “would have understood casters attached to the bottom of Clark’s dolly assembly enabled the base to be movable in several directions, including at least a rearward direction (i.e., away from a user facing the computer screen).” *Id.* at 27–28 (citing Ex. 1004 ¶¶ 64–65).

Patent Owner does not address this limitation in the Preliminary Response. *See* Prelim. Resp. 29–42.

We have reviewed Petitioner’s contentions and evidence and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that Clark teaches this limitation.

[3c] a height adjustment mechanism for adjusting the height of the work platform relative to the base,

Petitioner contends that “Clark discloses a height adjustment mechanism in the form of a vertical beam 22, a gas-spring height adjustment mechanism 74, and shaft 72.” Pet. 28. According to Petitioner, “Clark explains its embodiment has ‘vertical beam 22 [that] includes a gas-spring height adjustment mechanism for adjusting the length of the beam and, thus, the height of the horizontal tray 12 above the dolly assembly 14.’ *Id.* (citing Ex. 1010, 8:63–9:10). Petitioner further contends that Clark’s “[s]haft 72 connects to the gas-spring height adjustment mechanism 74 that allows adjustment of the height of the horizontal tray 12. The gas-spring height adjustment mechanism 74, which is located at the bottom of the vertical beam 22, sits on top of the dolly assembly 16.” *Id.* (quoting Ex. 1010, 11:54–58).

Patent Owner does not address this limitation in the Preliminary Response. *See* Prelim. Resp. 29–42.

We have reviewed Petitioner’s contentions and evidence and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that Clark teaches this limitation.

[3d] wherein the base includes a portion that projects from the height adjustment mechanism in a forward direction that is substantially opposite to the rearward direction,

Petitioner contends that “Clark’s base includes a portion, runner beam 78a, that projects from the height adjustment mechanism (vertical beam 22,

a gas-spring height adjustment mechanism 74, and shaft 72) in a forward direction that is substantially opposite to the rearward direction.” Pet. 29–30 (citing Ex. 1004 ¶¶ 69–70; Ex. 1010, 11:59–63, Fig. 4A).

Patent Owner does not address this limitation in the Preliminary Response. *See* Prelim. Resp. 29–42.

We have reviewed Petitioner’s contentions and evidence and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that Clark teaches this limitation.

[3e] wherein the work platform includes a portion that projects from the height adjustment mechanism in the forward direction, the compartments are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction, and the compartments are configured to permit a user facing in the rearward direction to access an item within the compartments,

Petitioner provides an annotated version of Clark’s Figure 4A, which Petitioner contends “depicts a portion of work platform 12 projecting in a forward direction from height adjustment mechanism 74.” Pet. 30. We reproduce Petitioner’s annotated version of Figure 4A below:

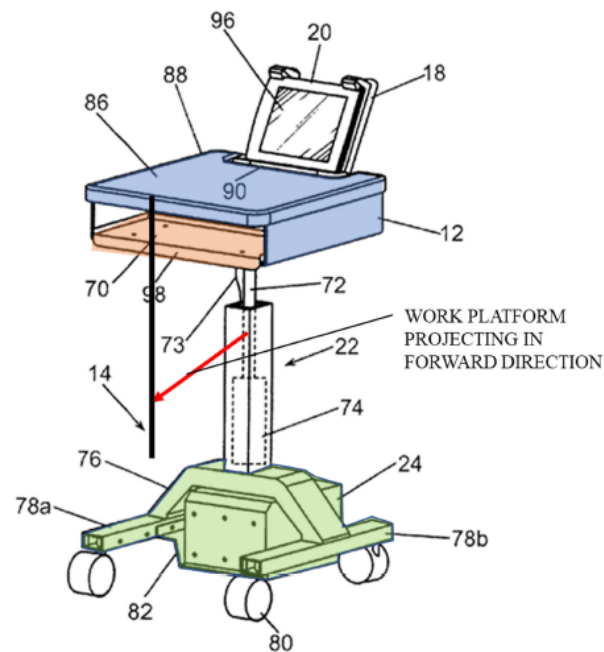


Fig. 4A

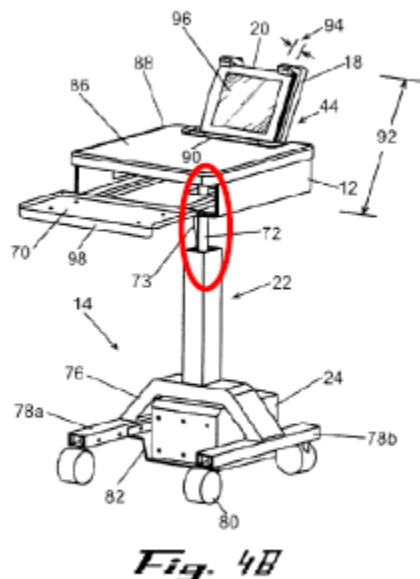
Pet. 31. Figure 4A is a perspective of Clark’s mobile work station. Ex. 1010, 4:41–41. In this annotated version of Figure 4A, Petitioner highlights Clark’s horizontal tray 12 in blue, pull-out keyboard tray 70 in orange, and a lower end of chassis 14 in green. *Id.* Petitioner also adds a vertical black line running downward from the top front edge of work surface 86, a red generally horizontal arrow from height adjustment mechanism 74 to the vertical black line, and a second generally horizontal line pointing to the vertical black line with text stating “WORK PLATFORM PROJECTING IN FORWARD DIRECTION.” *Id.*

Petitioner contends that “[t]he compartment shown below horizontal work surface 86 is disposed in the portion of the work platform that projects, relative to the height adjustment mechanism, in the forward direction because it extends to the forward side of the height adjustment mechanism within the work platform” and “[t]he compartments are configured to permit

a user facing in the rearward direction to access an item within the compartments because the compartment is open on the side facing the user when the user faces the computer.” Pet. 31–32 (citing Ex. 1004 ¶¶ 71–72).

Patent Owner contends that Clark does not meet the limitation of compartments “disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction.” Prelim. Resp. 33. To support this contention, Patent Owner argues that this phrase should be construed to “necessarily require[] that the height adjustment mechanism be located at a rear of the work platform, or at least sufficiently rearward to accommodate the compartments in a forward-projecting portion of the work platform.” Prelim. Resp. 33; *id.* at 37–38 (when construing the claims, this limitation “means that no part of the compartment can be disposed outside of the forward-projecting portion of the work platform, including in the rearward direction of the height adjustment mechanism”).

Patent Owner provides the following annotated version of Clark’s Figure 4B:



Id. at 34. Figure 4B is a perspective of Clark’s mobile work station. Ex. 1010, 4:41–41. Patent Owner adds a red vertically oriented ellipse near the top of Clark’s height adjustment mechanism 22 extending up to work surface 86. *Id.* Patent Owner argues that this annotated version of Figure 4B illustrates that Clark fails to meet the limitation according to Patent Owner’s proposed construction because “the alleged height adjustment mechanism . . . of Clark extends through a middle/center portion of the alleged compartment (keyboard tray cavity 12), essentially dividing it in half.” *Id.* at 33 (citing Ex. 1010, Figs. 4A, 4B), 35 (arguing “Petitioner takes an unreasonably broad, unsupported and impossible interpretation of this claim term” because it “argues that the keyboard tray cavity of Clark meets this limitation even though that cavity extends rearward of the height adjustment mechanism”), 38 (citing Ex. 1010, Fig. 2B). Patent Owner supports this argument by referring to Figure 12 of the ’668 patent which, according to Patent Owner, illustrates that “all embodiments described in the ’668 Patent show that the compartments are disposed only in the portion of the work platform projecting from the height adjustment in the *forward* direction.” *Id.* 36 (citing Ex. 1001, Fig. 12).

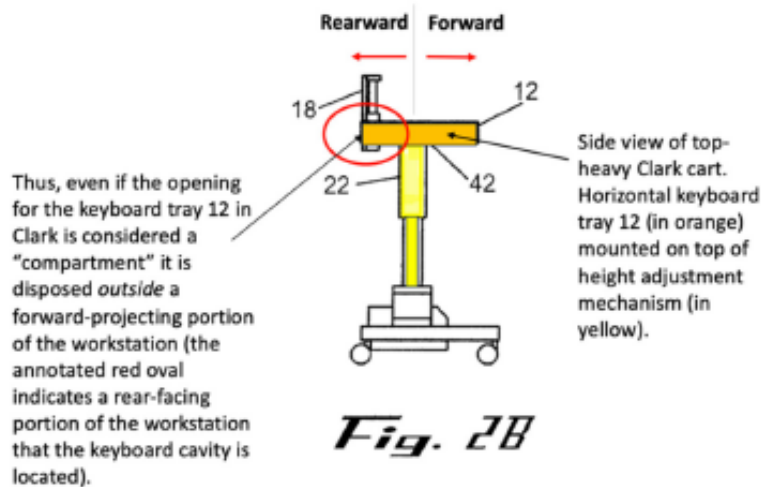
For the following reasons, Patent Owner’s contention is unavailing based on the record before us at this stage of the proceeding.

Claim 3 recites that “the work platform includes *a portion* that projects from the height adjustment mechanism in the forward direction.” Ex. 1001, 15:4–6 (emphasis added). Claim 3 further recites that “the compartments are disposed in the *portion* of the work platform that projects from the height adjustment mechanism in the forward direction.” *Id.* at 15:6–8 (emphasis added). Consequently, the language of claim 3 does not

support limiting the breadth of claim 3 to a height adjustment mechanism mounted at the rear of the work platform or that “the compartments are disposed *only* in the portion of the work platform projecting from the height adjustment in the *forward* direction” as Patent Owner asserts. Prelim. Resp. 36 (emphasis added).

Patent Owner’s citation to Figure 12 of the ’668 patent to support its claim construction argument is unavailing because it amounts to importing limitations from the Specification into claim 3. Prelim. Resp. 36. Based on the present record, we decline to import limitations from the Specification into claim 3.

Patent Owner also cites to a statement by the applicant in a response to an office action during prosecution of the ’650 patent that adding drawers to Clark would purportedly render Clark top heavy and susceptible to tipping. *Id.* at 37–38 (citing Ex. 2001 ¶ 36). As discussed above, the office action issued after the ’668 patent and is of little import here. Nonetheless, we note that it is not clear on the present record that Clark’s cart as modified would be top heavy and susceptible to tipping as Patent Owner asserts. For example, Patent Owner provides an annotated version of Clark’s Figure 2B showing the height adjustment mechanism spaced from the rear side of the medical cart. *Id.* at 38. The annotated version is reproduced below:



Id. Figure 2B is a “side view” of Clark’s mobile workstation. Ex. 1010, 4:32–33. Patent Owner adds orange highlighting to the work platform, yellow highlighting to the height adjustment mechanism, text blocks to the right and left of the mobile workstation, and a red arrow with the notation “rearward” and a second red arrow with the notation “forward.” It appears from Patent Owner’s annotated Figure 2B, based on the present record, that if the height adjustment mechanism were located at the rear of the work platform, as Patent Owner asserts is required by claim 3, then the mobile work station may be more susceptible to tipping if drawers were extended in the forward direction (toward the right in Figure 2B). In Figure 2B, the height adjustment mechanism, which supports the modified platform, is located closer to the frontward extended drawer providing a smaller moment arm than if the support were located at the rear of the modified work platform. The smaller moment arm appears, based on the present record, to make the platform less susceptible to tipping when the drawers are extended. The parties, however, may choose to address this issue further in subsequent briefing.

Patent Owner's contentions for this limitation are all based on its proposed construction that claim 3 requires the height adjustment mechanism to be located near or at the rear of the work platform. Prelim. Resp. 33–42. Because we do not adopt Patent Owner's proposed construction, the contentions are unavailing based on the present record.

We have reviewed Petitioner's contentions and evidence in light of Patent Owner's contentions and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that Clark teaches this limitation.

[3f] wherein the height adjustment mechanism is configured to releasably lock the work platform at a plurality of heights,

Petitioner contends that “Clark's height adjustment mechanism can be positioned at multiple heights” and includes “[a] locking mechanism [that] selectively prevents the leveling tray from moving vertically.” Pet. 32 (citing Ex. 1004 ¶¶ 73–74; Ex. 1010, 1:61–63, 4:5–11). Petitioner further contends that “Clark explains ‘[o]nce the horizontal tray 12 is at a desired height, represented by the height shown in FIG 2B, **the operator releases the lever 42, which locks the tray at the desired height.**’” *Id.* (citing Ex. 1010, 9:53–10:8, 14:65–15:10).

Patent Owner does not address this limitation in the Preliminary Response. *See* Prelim. Resp. 29–42.

We have reviewed Petitioner's contentions and evidence and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that Clark teaches this limitation.

[3g] wherein the height adjustment mechanism comprises: a stationary casing connected to the base; a telescoping casing connected to the work platform and configured to move relative to the stationary casing;

Petitioner provides the following annotated version of Clark's Figure 2B:

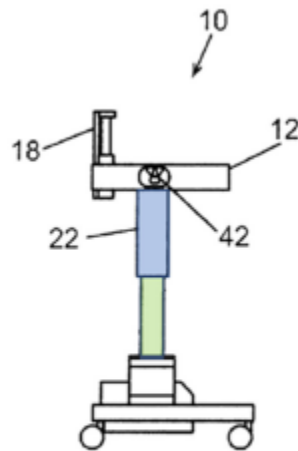


Fig. 2B

Pet. 34. Figure 2B is a side of view of Clark's mobile work station. Ex. 1010, 4:32–33. In this annotated view, Petitioner highlights Clark's vertical beam 22 in blue and what it contends is the recited stationary casing in green. *Id.* Petitioner contends that Clark teaches “a telescoping casing [highlighted in blue] connected to the work platform and configured to move relative to the stationary casing [highlighted in green].” *Id.* According to Petitioner, “Clark's vertical beam 22 is a telescoping casing and moves relative to the stationary casing connected to the base” as shown in Figures 2A–2D. *Id.*

Patent Owner does not address this limitation in the Preliminary Response. *See* Prelim. Resp. 29–42.

We have reviewed Petitioner's contentions and evidence and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that Clark teaches this limitation.

[3h] at least two drawer slides disposed between the stationary casing and the telescoping casing;

Petitioner acknowledges that “Clark does not expressly disclose drawer slides.” Pet. 35. Petitioner contends that “Santoro describes ‘[a] pair of **conventional slide mechanisms** generally designated respectively 50 and 52 in FIG. 6 are operationally mounted between the inner leg 32 and the outer leg 34.’” *Id.* (citing Ex. 1008 ¶ 36, Fig. 6). Petitioner further contends that “Santoro’s slide mechanisms are ‘operationally mounted between the inner leg 32 and the outer leg 34’ which are components of Santoro’s telescoping leg 14, a part of Santoro’s height adjustable workstation.” *Id.* (citing Ex. 1008 ¶¶ 28, 33, 34, 36).

Patent Owner does not address this limitation in the Preliminary Response. *See* Prelim. Resp. 29–42.

We have reviewed Petitioner’s contentions and evidence and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that the combination of Clark and Santoro teaches this limitation.

[3i] a driver configured to releasably lock the telescoping casing relative to the stationary casing; and

Petitioner contends that “Clark discloses ‘a **gas-spring height adjustment mechanism** for adjusting the length of the beam and, thus, the height of the horizontal tray 12 above the dolly assembly 14’” and “[t]he gas-spring height adjustment mechanism 74, which is located at the bottom of the vertical beam 22, sits on top of the dolly assembly 16.” Pet. 36 (citing Ex. 1004 ¶¶ 83, 84; Ex. 1010, 8:63–9:10, 11:50–58). Petitioner further contends that “Clark explains that ‘[a]ssistance provided by the gas-spring height adjustment mechanism allows the operator to change the height of the

horizontal tray with little effort” and once the tray “is at a desired height . . . **the operator releases lever 42, which locks the tray at the desired height.**” *Id.* at 36–37 (citing Ex. 1004 ¶ 85; Ex. 1010, 9:53–10:8, 14:65–15:10).

Patent Owner does not address this limitation in the Preliminary Response. *See* Prelim. Resp. 29–42.

We have reviewed Petitioner’s contentions and evidence and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that Clark teaches this limitation.

[3j] an actuator for controlling the driver, and

Petitioner contends that Clark’s release lever 42 corresponds to the recited actuator. Pet. 37. Petitioner argues that release lever 42 “releases a stop in the gas-spring height adjustment mechanism in the vertical beam” and “[t]he operator then raises or lowers the horizontal tray 12 while holding the release lever 42 in a raised position.” *Id.* (citing Ex. 1010, 9:50–62, 10:50–62, 12:20–44, 13:50–65).

Patent Owner does not address this limitation in the Preliminary Response. *See* Prelim. Resp. 29–42.

We have reviewed Petitioner’s contentions and evidence and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that Clark teaches this limitation.

[3k] wherein the actuator is disposed above the compartments and on the portion of the work platform that projects in the forward direction.

Petitioner contends that the combination of Clark and Manner teaches this limitation. Pet. 38. Petitioner argues that “Clark’s actuator is disposed above the compartments . . . that . . . are located below the work platform.” *Id.* (citing Ex. 1004 ¶¶ 91–92; Ex. 1010, 10:23–37, 15:33–36, 23:35–40).

Petitioner notes that Clark’s actuator is located “on the side of the work platform” but contends “[i]t would have been obvious . . . to modify Clark to incorporate an actuator on the portion of the work platform that projects in the forward direction.” *Id.* at 39 (citing Ex. 1004 ¶ 93; Ex. 1010, Figs. 2A–2D, 5A–5B, 9A–9D, 11A–11B, 20).

Petitioner provides the following annotated version of Manner’s Figure 5 (Pet. 40):

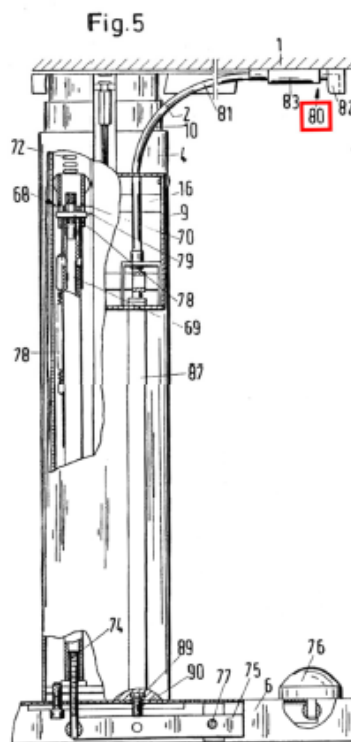


Figure 5 is a partial side section view of Manner’s device. Ex. 1007, 3:44–46. Petitioner adds a red square around numeral 80. Pet. 40. Petitioner contends that Manner’s actuator 80 is “positioned ‘to the edge of the table top 1 facing the user of the work table.’” *Id.* at 39 (citing Ex. 1007, 9:24–26). Petitioner further contends that “Manner explains that the ‘holder 83 [of the actuator] can be connected **at any desired location to the table top**

1 so that the actuating device 80 **can be easily activated by the user.**” *Id.* (citing Ex. 1007, 9:33–35).

Patent Owner argues that “Manner at best teaches placing the actuating device 80 . . . within a holder 83 underneath a ‘compartment-less’ table surface” and “cannot teach or suggest placing the actuating device . . . above any such non-existent compartments.” Prelim. Resp. 42–43 (citing Pet. 39; Ex. 2001 ¶ 43). This argument does not undercut Petitioner’s showing at this stage of the proceeding because it attacks Manner in isolation while Petitioner’s ground is based on the combination of Clark and Manner.

Patent Owner’s remaining arguments concerning Manner are directed to motivation to combine (Prelim. Resp. 42–44), which we address below.

We have reviewed Petitioner’s contentions and evidence in light of Patent Owner’s contentions and find, on the present record and at this stage of the proceeding, that Petitioner sufficiently establishes that the combination of Clark and Manner teaches this limitation.

Motivation to Combine

Petitioner contends that Clark, Manner, and Santoro are in the same field of endeavor, i.e., “height adjustable work stations.” Pet. 17–18 (citing Ex. 1004 ¶¶ 41–44; Ex. 1007, 15:62–67, 16:8–9; Ex. 1008 ¶ 11, Abstract; Ex. 1010, 8:50–9:10, 10:5–8, Figs. 2A–D). Petitioner further contends that “[b]ecause all references generally disclose height-adjustable work platforms and work surfaces with telescoping supports, a [person of ordinary skill in the art] would have found them combinable with a reasonable expectation of success.” *Id.* at 18 (citing Ex. 1004 ¶ 45).

Petitioner acknowledges that Clark does not “expressly disclose (1) an actuator disposed on the portion of the work platform that projects in the forward direction, or (2) drawer slides.” Pet. 18 (citing Ex. 1004 ¶ 46). Petitioner contends that “Manner discloses a height-adjustable work platform with a telescopic column” and “provides details of the internal components to the telescopic column supporting the height adjustment functionality of Manner’s work platform.” *Id.* at 18–19 (citing Ex. 1004 ¶ 48; Ex. 1007, 1:5–7; 9:33–35, 15:8–10, 15:61–16:9, Fig. 5, 12). According to Petitioner, an ordinarily skilled artisan “would have been motivated by Manner’s teaching to make the actuator ‘easily activated by the user’ and would have looked to substitute Clark’s lever actuator with Manner’s actuator.” *Id.* at 19 (citing Ex. 1004 ¶ 48).

Petitioner next contends an ordinarily skilled artisan “would have recognized Manner’s Bowden pull actuator as a suitable substitute for the lever actuator 42 disclosed in Clark” because “Manner expressly states that these two actuators may be substituted for each other.” Pet. 19 (citing Ex. 1007, 9:17–31). According to Petitioner, an ordinarily skilled artisan “would have been motivated to implement the actuator in Manner to control Clark’s gas-spring height adjustment mechanism to provide flexibility in locating the actuator.” *Id.* (citing Ex. 1004 ¶ 49). Petitioner also contends that “Clark’s gas spring driver is controlled by a release lever 42 that extends through ‘an opening 40 in the side of the horizontal tray’ and would have motivated an ordinarily skilled artisan “to reposition the actuator to another location on the work platform to implement the drawers recited in Clark” to prevent actuation of lever 42 by the contents of the drawer. *Id.* at 19–20 (citing Ex. 1004 ¶ 47; Ex. 1010, 9:51–62).

Petitioner next contends that an ordinarily skilled artisan “would have been motivated to implement the Bowden pull actuator in Manner to control Clark’s gas-spring height adjustment mechanism to provide flexibility in locating the actuator and to ensure operation of Clark’s drawer embodiments.” Pet. 41 (citing Ex. 1004 ¶ 95). Petitioner further contends that Manner’s disclosure at column 9, lines 33 to 35, provides motivation for the combination and that “It was routine and well understood by a [person of ordinary skill in the art] to position an actuator at the front of a work platform for ease of access by the user.” *Id.* (citing Ex. 1004 ¶ 95).

For the combination of Clark and Santoro, Petitioner contends that Santoro discloses that “its slide mechanisms were ‘conventional slide mechanisms’ and ‘well known to those skilled in the art of drawer slides.’” Pet. 20 (citing Ex. 1008 ¶ 36). According to Petitioner, an ordinarily skilled artisan “would have recognized the benefit of reducing binding between the sections of [Clark’s] telescoping column and would have looked to slides as in Santoro to reduce that binding.” *Id.* (citing Ex. 1004 ¶ 50). Petitioner further contends that the technique of using slides to reduce binding was “wholly conventional to” a person of ordinary skill in the art. *Id.* at 21 (citing Ex. 1004 ¶ 50). Petitioner also contends the combination of Clark and Santoro would have resulted “in quieter operation for less patient disturbance.” *Id.* at 36 (citing Ex. 1004 ¶ 82).

Petitioner contends that an ordinarily skilled artisan “would have had a reasonable expectation of success in combining these features because the prior art recognized that height adjustable work platforms include weight-compensation devices employing gas springs.” Pet. 21 (citing Ex. 1007, 1:13–33, 7:6–15, 7:60–67, 15:8–12, 15:62–16:23). According to Petitioner,

“[t]he combination would have involved combining known prior art elements (a medical cart, a gas spring, drawer slides, and a Bowden pull actuator on the front of a work platform) according to known methods . . . to yield predictable results.” *Id.* (citing Ex. 1004 ¶ 51).

Patent Owner argues that “incorporating the teachings of Manner into Clark would motivate a [person of ordinary skill in the art] to place the alleged actuator below the alleged work platform (the tray 12) of Clark, or at least below the alleged work surface in view of Manner’s teachings, rather than above it.” Prelim. Resp. 43. Patent Owner further argues that Manner’s teaching that “[t]he holder 83 can be connected at any desired location to the table top 1 so that the actuating device 80 can be easily activated by the user” is “a vague, possible modification to the ‘compartment-less’ table of Manner is aspirational at best, and at a minimum is far removed from Petitioner’s specific alleged modification” to Clark. *Id.* at 44. According to Patent Owner, this is “[a] meritless and conclusory assertion.” *Id.* (citing Ex. 2001 ¶ 46). This argument does not undercut Petitioner’s showing at this stage of the proceeding because it appears to be a bodily incorporation argument and does not address Petitioner’s reasons discussed above for combining the teachings of Clark and Manner.

Additionally, the Specification of the ’668 patent does not indicate that the recited position of the actuator is mandatory but provides that “actuator 440 *may be* provided in a front portion of the medical cart 500.” Ex. 1001, 9:1–2 (emphasis added). Further, the Specification does not provide any specific reason why the actuator must be located on a front portion of the medical cart. *See id.* at 9:1–38. Consequently, Petitioner’s showing that Manner’s teaching of locating the actuating device so it can be

easily activated by a user provides sufficient motivation, based on the present record, to support its contentions that an ordinarily skilled artisan would have been motivated to locate the actuator as proposed in Petitioner's combination of Clark and Manner with a reasonable expectation of success. Ex. 1004 ¶¶ 91–95.

Patent Owner does not address Petitioner's contentions concerning motivation to combine Clark and Santoro and reasonable expectation of success. *See* Prelim. Resp.

Summary of Claim 3

For the foregoing reasons, we determine that Petitioner establishes a reasonable likelihood of showing that claim 3 is unpatentable over Clark, Manner, and Santoro.¹⁶

F. Ground 2: Alleged Obviousness of Claim 4 over Clark and Manner, with or without Gillis

Petitioner notes that “[u]nlike claim 3, claim 4 does not include drawer slides.” Pet. 41. Petitioner contends claim 4 would have been obvious over Clark and Manner, with or without Gillis. *Id.* For motivation to combine Clark and Manner, Petitioner relies on its contentions for claim 3 discussed above. *Id.* (citing Ex. 1004 ¶ 96). For the limitations of claim 4, Petitioner relies on the disclosures from Clark and Manner discussed above for claim 3. *Id.* at 41–43.

Patent Owner does not provide contentions for claim 4 apart from its contentions for claim 3. *See* Prelim. Resp.

¹⁶ Because Petitioner establishes a reasonable likelihood that claim 3 would have been unpatentable over Clark, Manner, and Santoro, we do not reach Petitioner's alternate Ground 1B (Pet. 25–26) adding Gillis to the combination of Clark, Manner, and Santoro.

For the reasons discussed above for claim 3, we determine that Petitioner establishes a reasonable likelihood of showing that claim 4 is unpatentable over Clark and Manner.¹⁷

G. Grounds 3 and 4: Alleged Obviousness of Claims 3 and 4 over Reeder, Manner, and Santoro, with or without Gillis

Petitioner presents these alternate challenges to claims 3 and 4. Pet. 3. Because we have already determined that Petitioner has shown a reasonable likelihood that these claims would have been unpatentable over Clark and Manner, we do not reach these grounds at this time.

H. Discretionary Denial of Institution Under 35 U.S.C. § 325(d)

I. Analytical Framework

The statute provides that “the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

We use a two-part framework to analyze a request to deny institution under § 325(d). First, we determine “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020). Second, “if either condition of [the] first part of the framework is satisfied,” we determine “whether the petitioner has demonstrated that the Office erred in a manner

¹⁷ Because Petitioner establishes a reasonable likelihood that claim 4 would have been unpatentable over Clark and Manner, we do not reach Petitioner’s alternate Ground 2B (Pet. 42) adding Gillis to the combination of Clark and Manner.

material to the patentability of [the] challenged claims.” *Id.* In applying this framework, we refer to the non-exclusive factors delineated in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential). These factors are a) the similarities and material differences between the asserted art and the prior art involved during examination; b) the cumulative nature of asserted art and the prior art evaluated during examination; c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; d) the extent of overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments. *Id.* at Paper 8, 17–18.

These factors “should be read broadly . . . to apply to any situation in which a petition relies on the same or substantially the same art or arguments previously presented to the Office during a proceeding pertaining to the challenged patent.” *Advanced Bionics*, Paper 6 at 10. If, after review of factors (a), (b), and (d), we determine the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner demonstrates that the Office erred in a manner material to patentability of the challenged claims. *Id.*

i. Petitioner’s Contentions

Petitioner acknowledges “that Clark was of record during the prosecution of the ’668 patent.” Pet. 44. Petitioner contends that Clark was

“not relied upon by, the Office during prosecution of the ’668 patent” and “the prosecution history includes no substantive discussion of the prior art of record because the claims issued from a first action allowance.” *Id.* (citing Ex. 1002, 87–92).

Petitioner next contends that discretionary denial under § 325(d) is inappropriate because of the alternative grounds based on Reeder. Pet. 45; Prelim. Reply 2. Petitioner argues that none of Reeder, Gillis, and Manner “were cited (much less applied, alone or in combination) by the Examiner.” Pet. 45.

ii. Patent Owner’s Contentions

Patent Owner contends that “Clark’s equivalent was discussed during prosecution of the related and co-challenged ’650 Patent.” Prelim. Resp. 61 (citing Ex. 2003 (the “Applicant Response”)). According to Patent Owner, the applicant responded to the office action with arguments similar to those Patent Owner makes here. *Id.* at 61–62. In the Preliminary Sur-reply, Patent Owner argues that Reeder is cumulative of Clark. Prelim. Sur-reply 4–5.

2. Advanced Bionics Framework Prong One: Were the Same or Substantially the Same Art or the Same or Substantially the Same Arguments Presented to the Office?

“Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics*, Paper 6 at 7–8.

There is no dispute that Clark was of record during prosecution of the ’668 patent. Ex. 1001, code (56). There is no evidence, however, that Reeder and Manner were of record during prosecution of the ’668 patent or

that the Office considered the Clark and Manner combination proposed by Petitioner.

Patent Owner, however, argues that Reeder is cumulative of Clark because “like Clark, it has a workstation centrally mounted to the top of the height adjustment mechanism.” Prelim. Sur-reply 3. We disagree with Patent Owner. A comparison of Clark’s medical cart (Pet. 24 (reproducing Clark’s Figures 4A and 4B)) and Reeder’s medical cart (Pet. 57–59 (reproducing Reeder’s Figures 30–32, 45, and 46)) reveal numerous differences between Clark and Reeder relating to the type and placement of compartments and drawers relied on by Petitioner.

Because neither Reeder nor Manner were cited during prosecution of the ’668 patent and because we find that Reeder is not cumulative of Clark, we find that the same or substantially the same art or arguments were not presented to the Office during prosecution of the ’668 patent. Consequently, we do not reach the second prong of the *Advanced Bionics* framework concerning whether or not the Office erred.

For the foregoing reasons, we decline to exercise our discretion to deny institution under 35 U.S.C. § 325(d).

III. CONCLUSION¹⁸

Based on the present record, we determine that Petitioner demonstrates a reasonable likelihood that it would prevail in establishing that at least one challenged claim of the ’668 patent is unpatentable. We,

¹⁸ Patent Owner is cautioned that any arguments not raised in the Patent Owner Response may be deemed waived. *See In re NuVasive, Inc.*, 842 F.3d 1376, 1379–82 (Fed. Cir. 2016) (holding that a patent owner waived an argument addressed in a Preliminary Response by not raising the same argument in the Patent Owner Response).

thus, institute an *inter partes* review of all challenged claims of the '668 patent based on all grounds in the Petition.

Our factual findings, claim construction, and legal conclusions at this stage of the proceeding are based on the evidentiary record developed thus far. This decision to institute trial is not a final decision as to the unpatentability of the claims for which *inter partes* review is instituted. Our final decision will be based on the full record developed during trial.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of the '668 patent is instituted with respect to all challenged claims on all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4(b), *inter partes* review of the '668 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

IPR2023-01274
Patent 7,594,668 B2

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