

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHARKNINJA, INC., SHARKNINJA OPERATING LLC,
SHARKNINJA MANAGEMENT LLC, and
SHARKNINJA SALES COMPANY,
Petitioner,

v.

DYSON TECHNOLOGY LIMITED,
Patent Owner.

IPR2023-01324
Patent 9,414,662 B2

Before JAMES A. TARTAL, FRANCES L. IPPOLITO, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

We instituted trial as to claims 26–28 of U.S. Patent No. 9,414,662 B2 (“the ’662 patent,” Ex. 1001). Paper 7 (“Inst. Dec.”). After institution, Patent Owner filed a contingent Motion to Amend (Paper 19 (“Motion” or “Mot.”)) requesting that “[i]n the event the Board finds any original claim unpatentable,” “the Board grant this Motion to Amend and issue the corresponding substitute claims presented.” Mot. 1. Petitioner filed an opposition to the Motion. Paper 22 (“Opp.”).

In the Motion, Patent Owner requested preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 2; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend]”); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121 (regulatory requirements and burdens for a motion to amend); *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-

01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9,500.

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has shown a reasonable likelihood that it has satisfied these requirements for proposed substitute claims 40–42.

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
Yes. Patent Owner proposes one substitute claim for each of originally challenged claims 26–28. Mot., App. A (proposing substitute claims 40–42). Petitioner does not argue otherwise. <i>See</i> Opp.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

Yes.

Patent Owner responds to the grounds of unpatentability on which we instituted trial. Mot. 9–17, 20, App. A; *see* Inst. Dec. 6. In particular, in the Institution Decision we determined that the term “inner wall” did not require an inner wall of the appliance handle that extended all the way to the body of the appliance, and, based on this construction, determined that Patent Owner’s prior art arguments regarding the “inner wall” feature were not persuasive. *See* Inst. Dec. 14–17, 30, 34. The Motion proposes to amend originally challenged claim 26 to further define the “inner wall” as extending “to the first end of the handle,” which is “proximal to the body” (*see* Mot. 9, App. A), and thus responds to the grounds presented in the Petition. Petitioner does not argue otherwise. *See* Opp.

3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No.

The newly added limitations in Patent Owner’s proposed substitute claims 40–42 do not broaden the scope of the originally challenged claims. *See* Mot., App. A. In particular, claim 40 adds only narrowing limitations, and claims 41 and 42 depend from claim 40. *See id.* Petitioner does not argue otherwise. *See* Opp.

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No.

On this record, Patent Owner appears to have identified adequate written description support for proposed substitute claims 40–42. *See* Mot. 5–12.

Proposed substitute independent claim 40 adds limitations directed to the handle of the claimed appliance. *See* Mot., App. A. More particularly, proposed substitute claim 40 recites that the handle has “a first end proximal to the body and a second end distal from the body,” where the inner wall of the handle “extends from the primary fluid inlet to the first end of the handle.” *See id.*

Patent Owner’s Motion sets forth written description support for proposed substitute claim 40. *See* Mot. 4–9 (citing Ex. 1002, 10:8–9, 10:27–29, 19:8–9, 20:29–21:1, 28:23–25, 32:17–18, 33:16–17, 34:5–6, 34:9–13, 50–56). Patent Owner’s Motion also sets forth written description support for proposed substitute claims 41 and 42, which do not add any new limitations. *See id.* at 19–20 (citing Ex. 1002, 19:9–11, 52).

Petitioner, however, contends that Patent Owner fails to establish written description support for the limitation of an inner wall that “extends . . . to the first end of the handle.” Opp. 4–9. In particular, Petitioner argues that the Specification fails to convey to one of ordinary skill in the art “(1) where the ‘first end’ of the handle, *i.e.*, the boundary between the handle and the body is; and (2) whether the inner wall of the handle extends to that boundary, *i.e.*, comparing the end of the inner wall that is proximal to the body with the end of the handle that is proximal to the body.” *Id.* at 5. Petitioner also argues that the figures in the Specification are insufficient to show the required written description support because “even if the figures cited by Patent Owner were coincidentally showing an embodiment where the inner wall of the handle ‘extends to the first end of the handle,’ ” “a singular, coincidental embodiment [is] insufficient written support for an extrapolated genus.” *See id.* at 8.

Preliminarily, we do not find Petitioner’s contentions persuasive. Written description support requires that “the application relied upon reasonably conveys to those skill in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). As Petitioner concedes, with respect to Figure 5 of the Specification, “a POSITA would know that there is a border where the **handle’s inner wall** abuts the **body’s outer wall.**” Opp. 6. Petitioner’s argument highlighted above (*see id.* at 5) with respect to where the boundary is between the inner wall of the handle and the body speaks more to whether the inner wall is recited with sufficiently clear scope, which we address below with respect to alleged indefiniteness. For the written description requirement, at this stage in the

proceeding, we determine that the embodiment shown in Figure 5, among other cited portions of the Specification (see Mot. 5–7 (citing Ex. 1002, 28:23–25, 32:17–18, 33:16–17, 50–56)), sufficiently conveys possession of the disputed feature to one of ordinary skill in the art. Specifically, Figure 5 shows inner wall 220 of handle 20 meeting outer wall 360 of body 30 at one end (see Ex. 1002, Fig. 5, 32:17–18), which provides support for the limitations of a handle with “a first end proximal to the body and a second end distal from the body,” where the inner wall of the handle “extends . . . to the first end of the handle,” as recited in proposed substitute claim 40.

Petitioner’s argument that the figures fail to support a genus with a representative number of species is unavailing, as Petitioner does not explain what genus is covered by proposed substitute claim 40 that is not adequately supported by the figures’ alleged limited disclosure of a singular embodiment. See Opp. 8. To the extent Petitioner asserts that the location of “where the ‘first end’ of the handle is” amounts to a genus, we disagree. Proposed substitute claim 40 recites that the first end of the handle is “proximal to the body,” where the handle has an end proximal to the body and an end distal from the body. Figure 5 of the Specification supports a handle with an end proximal to the body (see Ex. 1002, 54), which Petitioner recognizes in stating that “the **handle’s inner wall** abuts the **body’s outer wall**.” Opp. 6. And in any case, as discussed above, Patent Owner also provides ample support in the text of the Specification for the disputed feature. See Mot. 5–8.

Thus, at this stage, we are not persuaded by Petitioner’s assertions that Patent Owner’s proposed substitute claim 40 adds new subject matter. As Petitioner’s arguments focus solely on proposed substitute claim 40, Petitioner also has not shown a reasonable likelihood that proposed substitute claims 41 and 42 lack written description support.

B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record,¹ it appears that Petitioner (or the record) has shown a reasonable likelihood that proposed substitute claims 40–42 are unpatentable.

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

I. Indefiniteness

No.

Petitioner argues that “[i]n order for a POSITA to determine if an inner wall of a handle ‘extends to the first end of the handle’ the POSITA needs to know where the first end of the handle is, i.e., where the handle borders the body; additionally, the POSITA needs to know where the inner wall of the handle is extended to, proximal to the body.” Opp. 10. According to Petitioner, there are no examples or explanations in the Specification on “how to positionally define where the inner wall of the handle ends when the inner wall continues into the body or positionally define the ‘first end’ of the handle where the body and the handle form a continuous shape.” *Id.* Therefore, Petitioner concludes, “the proposed substitute claims fail to inform a POSITA about the scope of the invention with reasonable certainty.” *Id.* at 11.

Preliminarily, Petitioner’s argument does not appear to establish a reasonable likelihood that proposed substitute claims 40–42 are indefinite.

Claims must “inform those skilled in the art about the scope of the invention with reasonable certainty”. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). At this stage, we determine that proposed substitute claim 40 sufficiently defines the scope of the claimed “inner wall” so as to provide reasonable certainty to one of ordinary skill in the art. Specifically, the inner wall is defined in part based on its relationship to the handle of which it is a part, namely, in that it extends “to the first end of the handle.” The inner wall is also defined in part by virtue of the first end of the handle being “proximal to the body.” One of ordinary skill

¹ We express no view on the patentability of originally challenged claims 26–28 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in the Patent Owner’s Motion to Amend.

in the art would thus understand that the inner wall itself would be proximal to the body, as it extends to the first end of the handle that is proximal to the body.

Petitioner's argument appears to suggest that in proposed substitute claim 40 the position of the end of the handle to which the inner wall extends must be more specifically defined. See Opp. 10 (“[T]he POSITA needs to know where the inner wall of the handle is extended to, proximal to the body.”). We see no need for such a requirement to meet the standard for definiteness. The end of the handle to which the inner wall extends is defined as the end that is proximal to the body, as opposed to distal from the body. In other words, in an appliance with two main parts, the body and the handle, the inner wall of the handle extends to the end of the handle where the body is. This provides one of ordinary skill in the art with a sufficient understanding of the scope of the inner wall in proposed substitute claim 40.

To the extent Petitioner argues there must be a more exact relative differentiation of the handle from the body, in light of the Specification's disclosure of embodiments where the inner wall of the handle and part of the body form a single piece (see Opp. 10 (asserting that the Specification does not aid in determining “how to positionally define where the inner wall of the handle ends when the inner wall continues into the body or positionally define the ‘first end’ of the handle where the body and the handle form a continuous shape”)), we disagree. Even in such an embodiment, for example, in which “outer wall 360 of the body 30 and inner wall 220 of the handle 20 are moulded as a one piece unit from a plastic material” (Ex. 1002, 32:17–18; see also *id.* at 54), one of ordinary skill in the art would understand that a portion of this single piece could reasonably be referred to as part of the “handle,” while the remaining portion could reasonably be referred to as part of the “body.” That the exact division of such an embodiment into portions deemed a “handle” and a “body” may have some margin of flexibility (see Opp. 7 (annotating the possible boundaries between the handle and body in a single piece embodiment)) does not show that proposed substitute claim 40 is indefinite. Rather, it illustrates the permissibility of capturing a desired breadth in the scope of the claim. See *In re Miller*, 441 F.3d 689, 693 (CCPA 1971) (“[B]readth is not to be equated with indefiniteness.”). Petitioner has not shown that Patent Owner's defining of the extent of the inner wall in proposed substitute claim 40 in terms of its interrelationships

with other elements of the appliance, rather than in exact measures of length or proportion, fails to provide reasonable certainty as to the desired breadth of scope of the inner wall element.

Accordingly, at this stage of the proceeding, on the record before us, Petitioner has not shown a reasonable likelihood that proposed substitute claim 40 is indefinite. As Petitioner's arguments focus solely on proposed substitute claim 40, Petitioner also has not shown a reasonable likelihood that proposed substitute claims 41 and 42 are indefinite.

II. Anticipation

Yes.

Petitioner asserts that proposed substitute claims 40–42 are anticipated by Yang (Ex. 1016)². Opp. 12–18. We focus here on the newly recited limitations, which are presented in proposed substitute claim 40. Petitioner also provides citations to Yang for the originally recited limitations retained in proposed substitute claim 40. *See id.* at 13–17.

On this record, it appears that Petitioner has shown a reasonable likelihood that Yang discloses the newly recited limitations in proposed substitute claim 40.

Yang relates to an air spray gun that includes an air spray tube and a grip. Ex. 1016, 2:22–23. With respect to the newly added limitation that the handle has “a first end proximal to the body and a second end distal from the body,” Petitioner contends that Yang's description of a “grip 205 [] fixed at the bottom of the rear tube 202” discloses a handle with a first end proximal to a body. Opp. 14 (citing Ex. 1016, 3:43–48, Figs. 4, 5). With respect to the newly added limitation that the inner wall of the handle “extends from the primary fluid inlet to the first end of the handle,” Petitioner contends Yang's description of a “high-pressure air tube 208 [] ‘connected with an air compressor or an air supply system’ (i.e., ‘primary fluid inlet’),” where “through the high-pressure air tube 208, ‘the high-pressure air will be blown out toward a front side of the air-discharge conduit 2011 of the front tube 201 through the air-taking ring 2027,’” discloses an inner wall of the handle extending from the primary fluid inlet to the first end of the handle. *Id.* at 15 (citing Ex. 1016, 3:43–51).

² US 8,104,694 B2, issued Jan. 31, 2012.

At this stage of the proceeding, we determine that Petitioner has shown a reasonable likelihood that Yang anticipates proposed substitute claim 40.

We acknowledge that Patent Owner has not yet had the opportunity to respond to this ground. Patent Owner will have the opportunity to do so in its Reply to Petitioner's Opposition (or in a revised motion to amend) in this proceeding. *See Notice, passim.*

III. Obviousness

Yes.

Petitioner asserts that proposed substitute claims 40–42 are obvious over:

Yang in view of Jeong (Ex. 1004)³, or Jeong in view of Yang;
and

Yang in view of Yoshida (Ex. 1005)⁴, or Yoshida in view of Yang.

See Opp. 18–25.

On this record, it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 40–42 are unpatentable as obvious based on the grounds identified above.

In the two obviousness combinations, Petitioner relies on Yang for the newly recited limitations in proposed substitute claim 40, and relies upon Jeong and Yoshida either solely for teaching the preamble of proposed substitute claim 40, namely, “[a] hair care appliance,” or, alternatively, for the original limitations retained in proposed substitute claim 40 in addition to the preamble. *See Opp.* 18–24.

Given that Petitioner does not rely on either Jeong or Yoshida for the newly recited limitations in proposed substitute claim 40, and given that we addressed Patent Owner's preliminary arguments regarding Jeong and Yoshida in the Institution Decision (*see Inst. Dec.* 29–30, 33–34), we need not discuss Jeong or Yoshida in detail with respect to the original limitations. We note, however, that we did not address, for purposes of institution, whether the preamble of challenged original claim 26 (the preamble of which is retained in proposed substitute claim 40) was limiting. Because Petitioner relies on Jeong and Yoshida for teaching the

³ US 2013/0111777 A1, published May 9, 2013.

⁴ JP S60-249907, published Dec. 10, 1985.

preamble (*see* Opp. 18, 23), we provide a preliminary and non-binding construction of the preamble, which we note appears to be not limiting.

“[A] preamble is not limiting ‘where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.’” *Catalina Marketing Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)). This rule against giving effect to intended-use language in the preamble “reflects a longstanding substantive aspect of the patent statute—specifically, the ‘well settled’ fundamental principle ‘that the recitation of a new intended use for an old product does not make a claim to that old product patentable.’” *Arctic Cat Inc. v. GEP Power Products, Inc.*, 919 F.3d 1320, 1328 (Fed. Cir. 2019) (quoting *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)). In this case, we preliminarily view the phrase “hair care appliance” to be indicative of an intended use of an appliance, rather than a structural limitation, and, as such, is not limiting.

On the current record, Patent Owner does not appear to have pointed to any structural limitation required by the preamble term “hair care.” Instead, Patent Owner has relied on the antecedent basis that the preamble term “appliance” provides for the body of the claim’s recitation of “the appliance” to bootstrap the whole preamble phrase “hair care appliance” into providing a structural limitation. *See* Prelim. Resp. 9–10. Patent Owner has analogized *Shoes by Firebug* to the current case for this line of argument (*see* Prelim. Resp. 10 (citing *Firebug LLC v. Stride Rite Children’s Grp., LLC*, 962 F.3d 1362, 1368 (Fed. Cir. 2020))), but that case is distinguishable.

In *Shoes by Firebug*, the claim for which the Federal Circuit found the preamble to be limiting included the phrase “textile footwear” in the preamble. 962 F.3d at 1365. The term “textile” in the context of the patents at issue in *Shoes by Firebug* denoted a structural material. *See id.* at 1368 (“[T]he written description itself discloses numerous materials other than textile suitable for footwear manufacture, including ‘leather, synthetics, [and] plastics.’”⁵). In contrast, the term “hair care” in proposed substitute claim 40 does not provide any further structural limitation. The Specification describes “a hair care appliance” as encompassing “a hairdryer or hot styling brush” (Ex. 1001, 1:12–13), but this does not define any particular structure. To hold that the term “hair care” provides a necessary structural limitation in proposed substitute claim 40 would

simply beg the question as to which of the structures associated with an appliance used for hair care to include in the claim. In other words, we would appear to need to resort to speculation and improper importation of limitations from the Specification into proposed substitute claim 40.

The term “hair care” has not been shown to be part of any “essential structure or steps” or “necessary to give life, meaning, and vitality to” proposed substitute claim 40. *Catalina Marketing*, 289 F.3d at 808 (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). Although, as Patent Owner has asserted, “the [S]pecification is replete with references to use of the appliance for hair care” (Prelim. Resp. 9), the Specification also makes clear that the disclosed invention relates more broadly to “hot air blowers [that] are used for a variety of applications.” Ex. 1001, 1:17–18. Therefore, on the current record, it appears that one of ordinary skill in the art would have understood that the structure described in the body of proposed substitute claim 40 would be functional for blowing air, whether used for hair care or some other purpose, without the need for some other unspecified elements implied by the term “hair care.”

As proposed substitute claim 40 does not require the claimed appliance to be used for hair care, based on our construction of the preamble at this juncture, the disclosures of Jeong and Yoshida are merely cumulative to the disclosure Petitioner identifies in Yang with respect to anticipation. Accordingly, for the same reasons discussed above regarding anticipation of proposed substitute claim 40 by Yang, on this record, Petitioner appears to have shown a reasonable likelihood that the grounds based on the combination of either Jeong or Yoshida with Yang render proposed substitute claim 40 obvious. *See In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982) (“[E]vidence establishing lack of all novelty in the claimed invention necessarily evidences obviousness”).

We acknowledge that Patent Owner has not yet had the opportunity to respond to these grounds. Patent Owner will have the opportunity to do so in its Reply to Petitioner’s Opposition (or in a revised motion to amend) in this proceeding. *See Notice, passim.*

⁵ Here, although the Federal Circuit quotes from the specification of a different patent than that for which a claim preamble was found to be limiting in *Shoes by Firebug*, it noted that the specifications of the two patents at issue shared a “substantially identical written description.” 962 F.3d at 1364 n.1.

III. CONCLUSION

This concludes the Preliminary Guidance. Notice, 84 Fed. Reg. at 9,497. Patent Owner, under the Board's pilot program, may file a revised motion to amend by DUE DATE 3. *See* Scheduling Order.

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