

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TROVE BRANDS, LLC,

Petitioner

v.

CAMELBAK PRODUCTS, LLC.

Patent Owner.

IPR2024-00858

Patent 8,905,252 B2

**PATENT OWNER'S PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. § 42.107**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	U.S. Design Patent No. D679,541 to Samartgis
2002	June 17, 2024 Order on Case Schedule in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal. Aug. 21, 2023) at Dkt. 92
2003	Docket in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal. Aug. 21, 2023)
2004	Initial Infringement Contentions in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal. Aug. 21, 2023), served December 21, 2023
2005	Initial Invalidity Contentions in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal. Aug. 21, 2023), served January 22, 2024
2006	First Amended Invalidity Contentions in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal. Aug. 21, 2023), served July 18, 2024
2007	Notice of Deposition of Erin Jones in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal. Aug. 21, 2023), served April 23, 2024
2008	Notice of Deposition of Jeff Sagud in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal. Aug. 21, 2023), served April 23, 2024

I. INTRODUCTION

The Petition does not show a reasonable likelihood of success on the merits, and the Board should therefore deny the Petition. The Board should also exercise its discretion to deny institution under 35 U.S.C. § 325(d) and *Fintiv*.

First, relying on the same primary references and cap designs already considered by the Office during prosecution, Petitioner fails to present evidence that any of these disclosures teach or render obvious the full claim requirements of challenged independent claims 5 and 19. Rather, Petitioner resorts to paraphrasing, or blatantly omitting, key limitations required by the claims to attempt to obscure the deficiencies in the art. Notably, none of the prior art relied on by Petitioner discloses the claimed requirements of the claimed “closure retention mechanism.” In particular, for Samartgis (Grounds 1 and 2) and Leoncavallo (Grounds 3 and 4), Petitioner fails to present any evidence that the references teach a “closure retention mechanism configured to ***selectively retain*** the closure in a stowed position relative to the handle” and “***when the closure is*** selectively removed from the drink spout and ***received by the closure retention mechanism,***” as required by claims 5 and 19. For both primary references, the Petition omits the bolded language from its mappings. Pet., 34-36, 67-70. Similarly, for Miller (Grounds 5 and 6), Petitioner lacks any evidence from Miller’s design patent figures showing “a ***drink spout extending from the base,***” “a closure configured to be ***removably coupled relative***

to the drink spout in a closed position to selectively restrict dispensing of drink liquid through the passage and to selectively permit dispensing of drink liquid through the passage when removed from the drink spout,” or “a closure retention mechanism” as required by claims 5 and 19. By glossing over or remaining silent on these limitations, the Petition fails to show a reasonable likelihood of success as to any claim, and institution should be denied.

Second, implicitly acknowledging the references do not disclose key limitations, Petitioner adds conclusory “catch all” obviousness arguments to the Petition. But as shown below, the Petitioner (and its expert) fail to set forth the obviousness grounds with the required particularity under the statute, including by failing to identify the particular limitations missing in the primary references or providing any motivations to modify the primary reference or to combine the secondary references to satisfy any such unidentified missing limitations. Indeed, Petitioner leaves it to the Board and Patent Owner to do Petitioner’s work for it and guess which claim limitations would have been obvious, as well as how and why. Such conclusory and unsupported obviousness arguments are insufficient under controlling law and warrant denial of institution.

Third, using its discretion under § 314, the Board should deny the Petition because institution would needlessly multiply litigation. Petitioner waited nearly nine month from filing its declaratory judgment lawsuit and nearly six months after

Patent Owner counterclaimed for infringement to file its Petition. Because of that delay, the related district court proceedings are scheduled for a jury trial, including on the same grounds of unpatentability presented here, well before any final written decision would issue. Additionally, the parties and the district court have invested significantly in the related litigation. For example, before an institution decision, the parties will have substantially completed document productions, exchanged infringement and invalidity contentions, resolved discovery disputes, fully briefed claim construction, argued claim construction disputes at a *Markman* hearing, and likely received a claim construction order from the district court. Although Petitioner has offered a watered-down stipulation in an attempt to alleviate duplicative and conflicting rulings on invalidity and unpatentability, Petitioner's stipulation stops well short of a *Sotera* stipulation or the scope of estoppel under 35 U.S.C. § 315(e). Further, the weaknesses identified below in Petitioner's grounds demonstrate a lack of compelling merits. Thus, the balance of the *Fintiv* factors weigh in favor of denying institution under § 314.

Finally, using its discretion under § 325(d), the Board should deny the Petition because it relies on the same or substantially the same prior art references that were already before the Office during prosecution. Specifically, Miller and Leoncavallo are cited on the face of the '252 patent. Additionally, the Samartgis design that is the same as what is depicted in Samartgis was submitted to the Office and cited on the

face of the '252 patent. Yet, the Petitioner relies on these three primary references exclusively to show all limitations in independent claims 5 and 19. Because these disclosures were already carefully considered by the Office and the challenged claims were allowed over them—presumably because of the same deficiencies discussed herein—the Board should exercise its discretion under § 325(d) to deny institution.

II. THE '252 PATENT

The '252 patent is titled “Drink Containers with Closure Retention Mechanisms,” and issued on December 9, 2014. Ex. 1001 (cover). The patent generally describes a drink container with a liquid container portion and a cap assembly portion removably coupled to the liquid container. Ex. 1001 at Abstract. The cap assembly may include a handle, a base, a drink spout, and a closure for the spout. *Id.*, 2:63-64, 7:54-62. The application that matured into the '252 patent, U.S. Patent Application No. 14/199,817, was filed on March 6, 2014, and claims priority to U.S. Provisional Patent Application No. 61/779,084, filed on March 13, 2013, and U.S. Provisional Patent Application No. 61/859,662, filed on July 29, 2013. *Id.*

A. Claims

The '252 patent has 20 claims. Ex. 1001, 18:1 to 20:46. Petitioner challenges claims 5-7 and 16-19 in the Petition, with claims 5 and 19 being the only independent claims. Pet., 15-16. Independent claim 5 recites:

5. A drink container, comprising:
- a liquid container having a neck with an opening and having an internal compartment sized to hold a volume of potable drink liquid; and
 - a cap assembly removably coupled to the liquid container, the cap assembly comprising:
 - a base removably coupled to the neck of the liquid container;
 - a drink spout extending from the base and defining a passage through which drink liquid from the internal compartment of the liquid container may be selectively dispensed;
 - a closure configured to be removably coupled relative to the drink spout in a closed position to selectively restrict dispensing of drink liquid through the passage and to selectively permit dispensing of drink liquid through the passage when removed from the drink spout;
 - a handle extending from the base, wherein the handle includes a closure retention mechanism configured to selectively retain the closure in a stowed position relative to the handle when the closure is selectively removed from the drink spout and received by the closure retention mechanism.

Ex. 1001, 18:44-67.

Independent claim 19 is similar to claim 5 and is directed to a cap assembly for use with a liquid container, containing many of the same elements as the cap assembly in claim 5. *Id.*, 20:16-37.

Dependent claim 6 depends from and incorporates the limitations of claim 5 and adds a limitation requiring that the handle defines a closed perimeter, and wherein a portion of the closure retention mechanism defines at least a portion of the closed perimeter. Ex. 1001, 19:1-3. Dependent claim 7 depends from and incorporates the limitations of claim 5 and adds a limitation requiring that the handle defines a closed perimeter and that in the stowed position the closure is positioned at least partially within the closed perimeter. *Id.*, 19:4-7. Dependent claim 16 depends from and incorporates the limitations of claim 5 and adds a limitation regarding the drink spout having an internal coupling structure, wherein the closure includes a plug structure that is configured to extend within the passage when the closure is in the closed position, and wherein the plug structure includes an external coupling structure that is configured to operatively mate with the internal coupling structure of the drink spout when the closure is in the closed position. *Id.*, 20:1-8. Dependent claim 17 depends from and incorporates the limitations of claim 5 and adds a limitation requiring that the drink spout defines an upper lip, wherein the upper lip does not engage the closure when the closure is in the closed position. *Id.*, 20:9-11. Claim 18 depends from and incorporates the limitations of claim 17 and adds a limitation requiring that the closure and drink spout define a void above the upper lip when the closure is in the closed position. *Id.*, 20:12-15.

B. Specification

The '252 patent discloses various embodiments to illustrate the claimed drink containers. Figure 8 below represents a cross-sectional view of a drink container according to the '252 patent, including a cap assembly (102), which includes a base (16), closure (20), handle (50), and tether (104). Ex. 1001, 12:8-23, Fig 8.

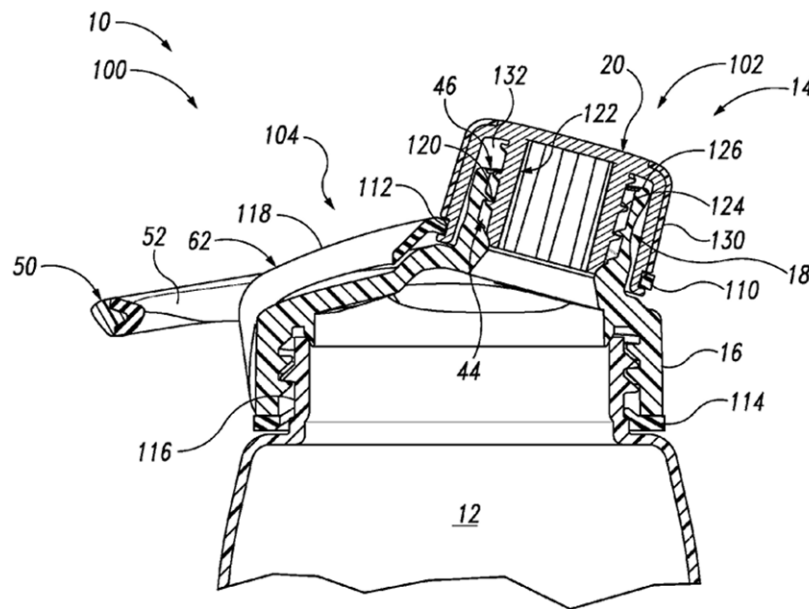


Fig. 8

Figure 7 below represents a top view of an exemplary cap assembly (102) according to the invention, including a closure retention mechanism (54), which further includes an exemplary closure retention structure (55) in the form of tabs (56). *Id.*, 10:4-8, Fig. 7.

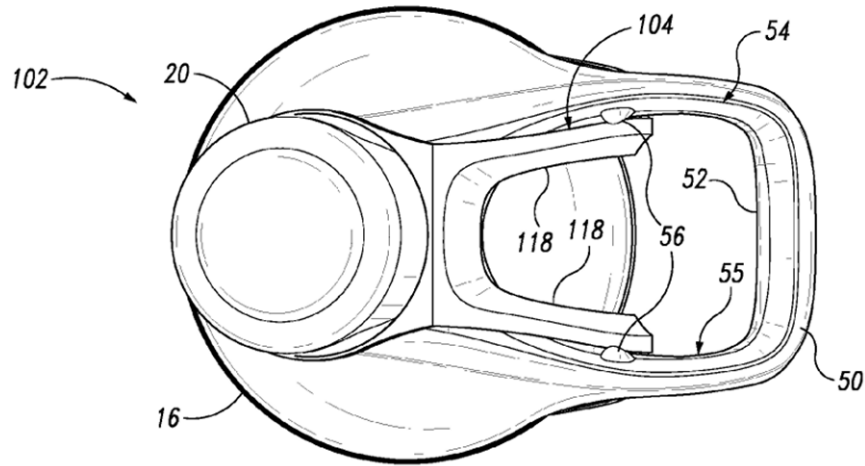


Fig. 7

Id., Fig. 7. The closure can be operatively positioned within a stowed position, as shown, for example, in Figures 10-13 of the '252 patent.

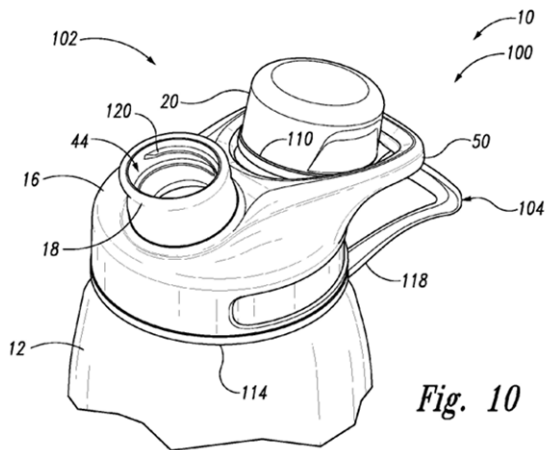


Fig. 10

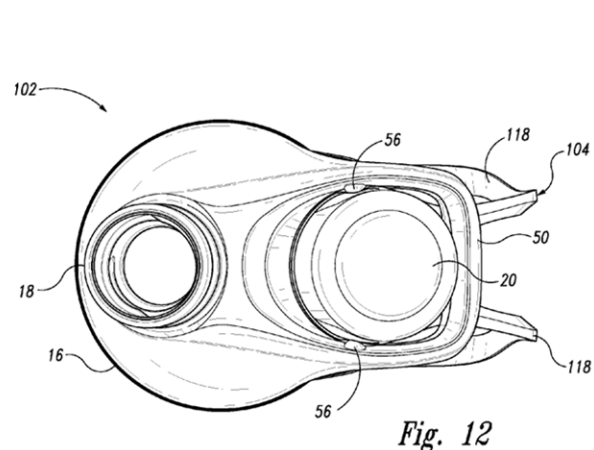


Fig. 12

Id., Figs. 10, 12; *see also id.* Figs. 11, 13. In particular, the closure retention mechanism receives the closure and retains it in a stowed position relative to the handle, providing the benefit of an ergonomic drinking of the drink liquid without

the closure engaging the user's face or blocking the user's line of sight. *Id.*, 13:14-46, 14:1-5.

C. Prosecution History

The Examiner allowed the claims of the '252 patent without rejection, stating that the prior art did not disclose the claimed limitations. Ex. 1002. Each of the primary references relied upon by Petitioner (or related references) were submitted to the Examiner during the prosecution of the application which matured into the '252 patent, and those references appear on the face of the patent. *See* Ex. 1001, page 2 (listing No. D679,541 to Samartgis, No. D586,184 to Miller et al., and No. 7,753,240 to Leoncavallo et al.).

III. PETITIONER'S GROUNDS AND CITED REFERENCES

Petitioner asserts that the challenged claims would have been anticipated and/or obvious based on six (6) grounds¹: Petitioner argues that claims 5-7, 16-19 are anticipated by and/or obvious in view of Samartgis² (Ground 1); Petitioner

¹ For Grounds 1 and 3, Petitioner identifies 35 U.S.C. §§ 102 **and** 103, and throughout the Petition makes separate anticipation and obviousness arguments. In effect, Petitioner has asserted eight (8) discrete invalidity grounds.

² U.S. Patent No. 9,272,822 to Samartgis (Ex. 1004).

argues that claims 16-18 are obvious in view of Samartgis in view of Gorskey³ and/or Johnson⁴ (Ground 2); Petitioner argues that claims 5-7, 16, and 19 are anticipated by and/or obvious in view of Leoncavallo⁵ (Ground 3); Petitioner argues that claims 17 and 18 are obvious over Leoncavallo in view of Gorskey and/or Johnson (Ground 4); Petitioner argues that claims 5-7, 16, and 19 are obvious over Miller⁶ in view of Leoncavallo (Ground 5); and Petitioner argues that claims 17-18 are obvious over Miller in view of Leoncavallo and in further view of Gorskey and/or Johnson (Ground 6).

A. Samartgis

U.S. Patent No. 9,272,822 to Samartgis (Ex. 1004) was filed as a PCT application on August 20, 2012, and purports to claim priority to a foreign application filed on August 18, 2011. Samartgis is assigned to The Décor Corporation Pty Ltd. Samartgis appears to relate to U.S. Design Patent No. D679,541, which names the same inventor and is also assigned to The Décor

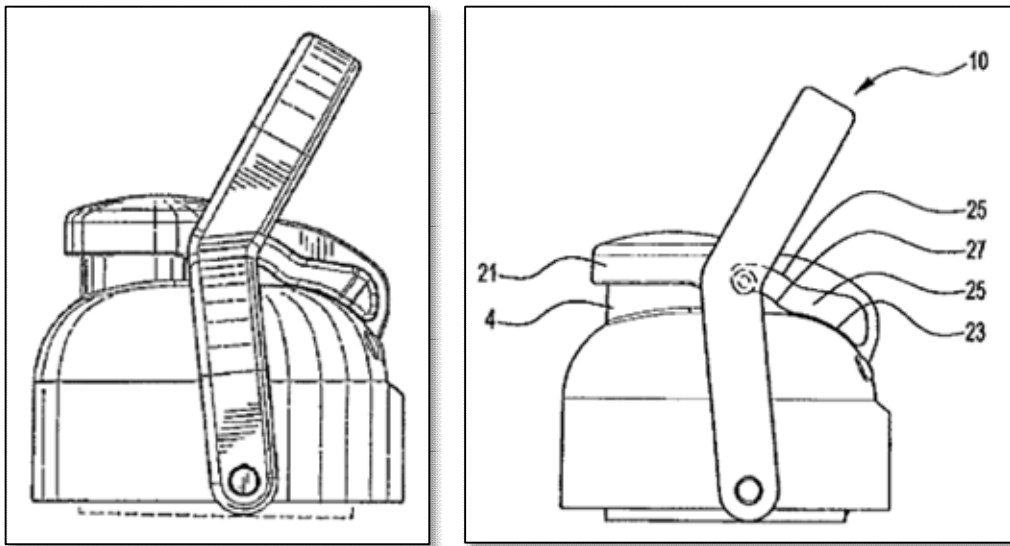
³ EP Publication 2177447A1 to Gorskey (Ex. 1011).

⁴ U.S. Patent Publication No. 2006/0006578 AI to Johnson (Ex. 1012).

⁵ U.S. Patent No. 7,753,240 to Leoncavallo (Ex. 1005).

⁶ U.S. Design Patent No. D586,184 to Miller (Ex. 1006).

Corporation Pty Ltd., and which was submitted to the Examiner during prosecution of the '252 patent. Ex. 2001 (hereinafter "Samartgis Design"); Ex. 1001, at 2. Samartgis Design (below left) depicts an essentially identical design to that depicted in Samartgis (below right):

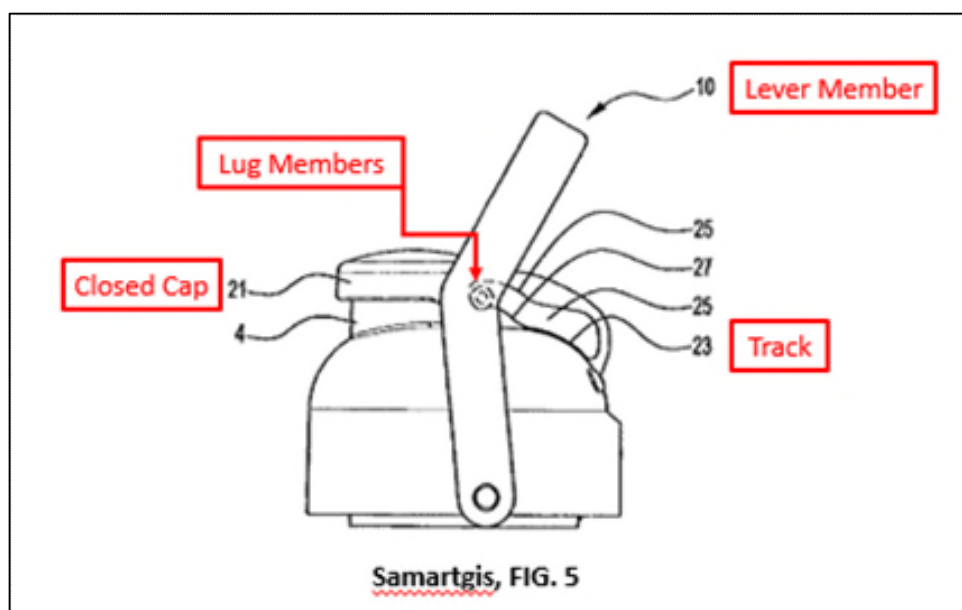


Compare Samartgis Design, FIG. 5 (Ex. 2001) with Samartgis, FIG. 5 (Ex. 1004)

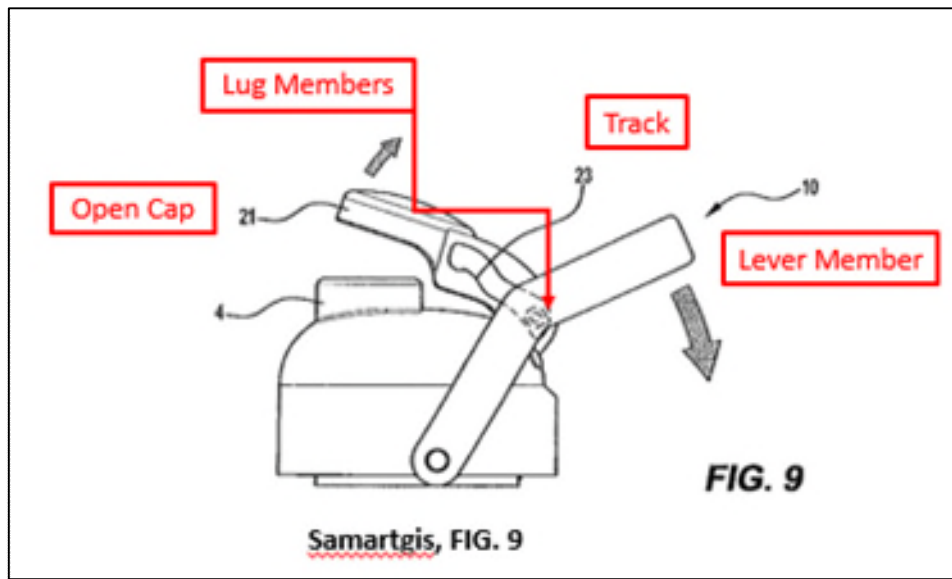
Samartgis discloses a drink dispensing assembly with a main body, flap member 20 with cap 21, and arm member 22. Ex. 1004 at 3:13-44. The arm member 22 has opposed tracks 23. *Id.* 3:45-47. Lever member 10 has two lug members 15 and 16 attached to the inside of the arm member 22 and extending inward. *Id.* at 3:37-39. Lug members 15 and 16 rest inside and move along tracks 23. *Id.* at 4:10-17. When cap 21 is in the closed position, lever member 10 is in the upright position with lug members 15 and 16 in the proximal end of tracks 23 as shown in the

annotated version below of Figure 5 (on top). *Id.* at 4:23-28; FIG. 5. When cap 21 is in the open position, lever member 10 is rotated clockwise with lug members 15 and 16 on the distal end of tracks 23 as shown in the annotated version below of Figure 9 (on bottom). *Id.* at 4:28-34; FIG. 9.

Closed Position:



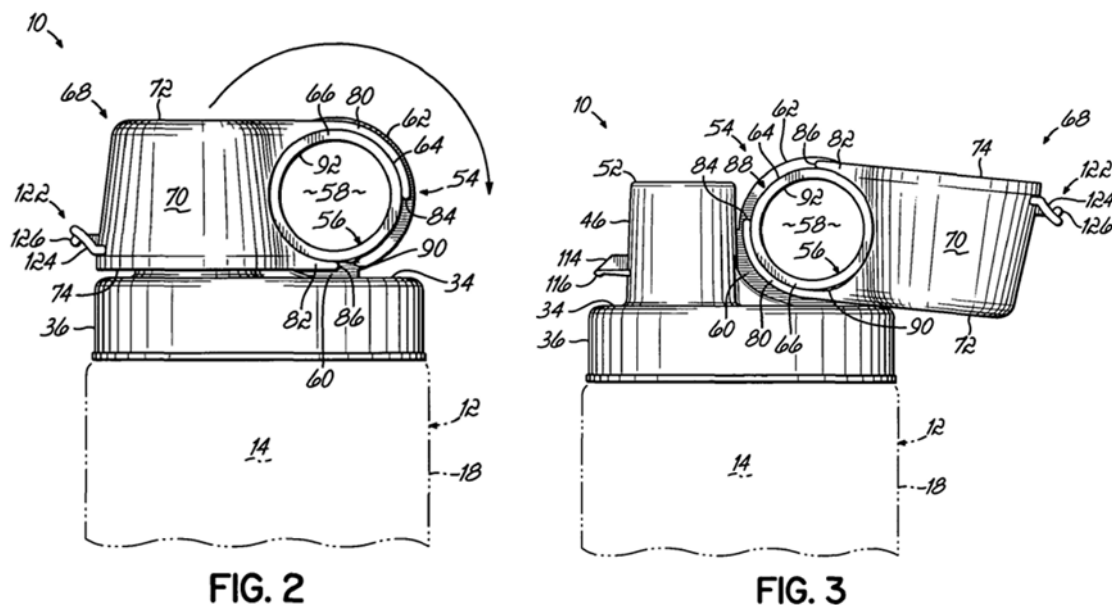
Open Position:



Id. at Fig. 5 (annotated), Fig. 9 (annotated).

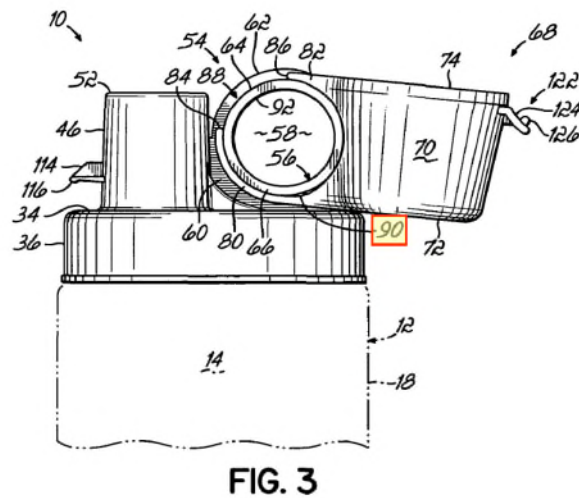
B. Leoncavallo

United States Patent No. 7,753,240 to Leoncavallo (Ex. 1005) was submitted to the examiner during prosecution of the '252 patent and is listed among the references cited on the face of the patent. Ex. 1001. Leoncavallo describes a liquid container. Ex. 1005, Abstract. Specifically, Leoncavallo includes a container 12 with a body, base and sidewall for receiving and storing liquids, and a closure 10, which is removably secured to the neck of the container 12. *Id.*, 3:10-19, 3:41-47. The closure 10 has an end wall 34 and annular skirt wall 36. *Id.*, 3:41-47. The closure also has a loop 54, which includes a generally tubular wall 58 and an opening therethrough so that a user's finger or attachment hardware, such as a hook or clip,



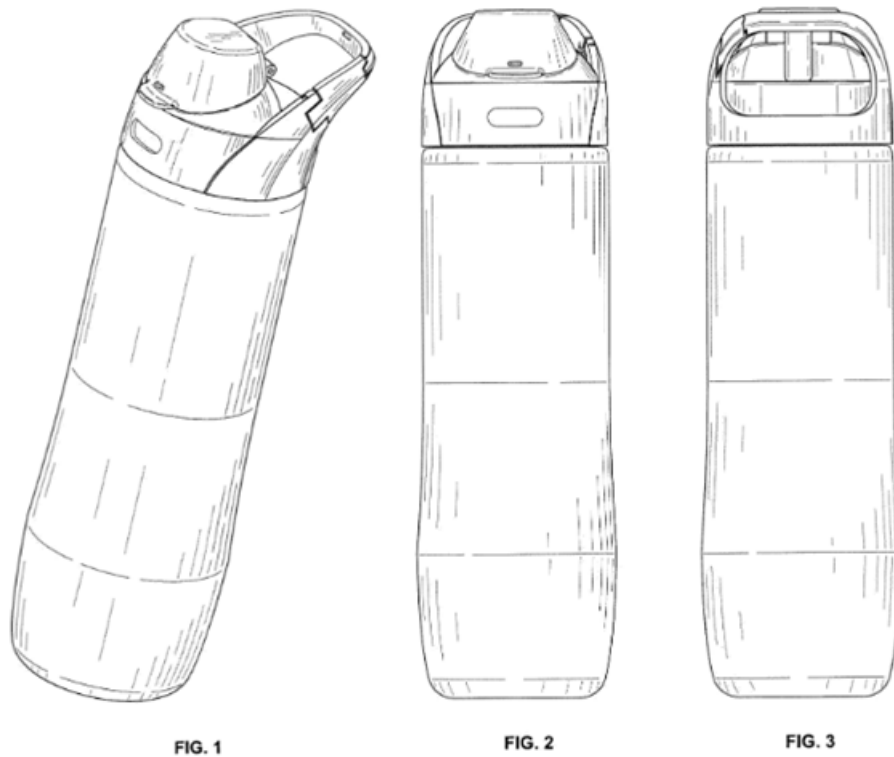
In addition to the container 12 and closure 10, Leoncavallo also includes a flip cap 68 that selectively covers the spout 46. *Id.*, 4:58-60. The flip cap 68 has a sidewall 70 with a top edge 72 and a bottom edge 74, with the bottom edge 74 having a lower opening 78 used to fit over the spout 46. *Id.*, 4:58 to 5:4. In addition, there are two arcuate connector members 80, 82 that releasably connect to the loop 54. *Id.*, 5:4-8. The connector members 80, 82 are configured to engage with an outer surface of loop 54 and rotate around it so that the flip cap 68 is rotatably supported by the loop 54 between open and closed positions. *Id.*, 5:4-8, 7:9-18, Fig. 3. The loop 54 may also include one or more detents 90 projecting from the outer arcuate surface

of the loop 54. *Id.*, 5:33-42. The detents 90 are designed to engage the connector member 80 “as it travels about the loop 54 when the flip cap 68 is moved to the open position of Figure 3,” as shown below. *Id.*, 5:33-42, Fig. 3.



C. Miller

U.S. Design Patent No. D586,184 (“Miller”) (Ex. 1006) was filed on January 18, 2008. Miller is assigned to Wilton Industries, Inc. Miller was submitted to the examiner during prosecution of the ’252 patent and is listed among the references cited on the face of the patent. Ex. 1001. Miller is a design patent titled “beverage container” and consists of seven figures depicting an “ornamental design for a beverage container.” Ex. 1006, at Claim. Figures 1-3 are shown below:



Ex. 1006 at Figs. 1-3. Because Miller is a design patent, it does not contain a narrative description of its seven figures, and the figures are unlabeled. The figures depict the “beverage container” from several different views.

IV. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner fails to show a reasonable likelihood of prevailing on any claim, even under the level of ordinary skill in the art Petitioner sets forth. Accordingly, for the purpose of this Preliminary Response only, Patent Owner assumes Petitioner has correctly stated the level of ordinary skill in the art and does not set forth its own definition. Patent Owner reserves the right to present evidence and argument in

support of a different position on this issue in other proceedings or later in this proceeding in the event necessary.

V. CLAIM CONSTRUCTION

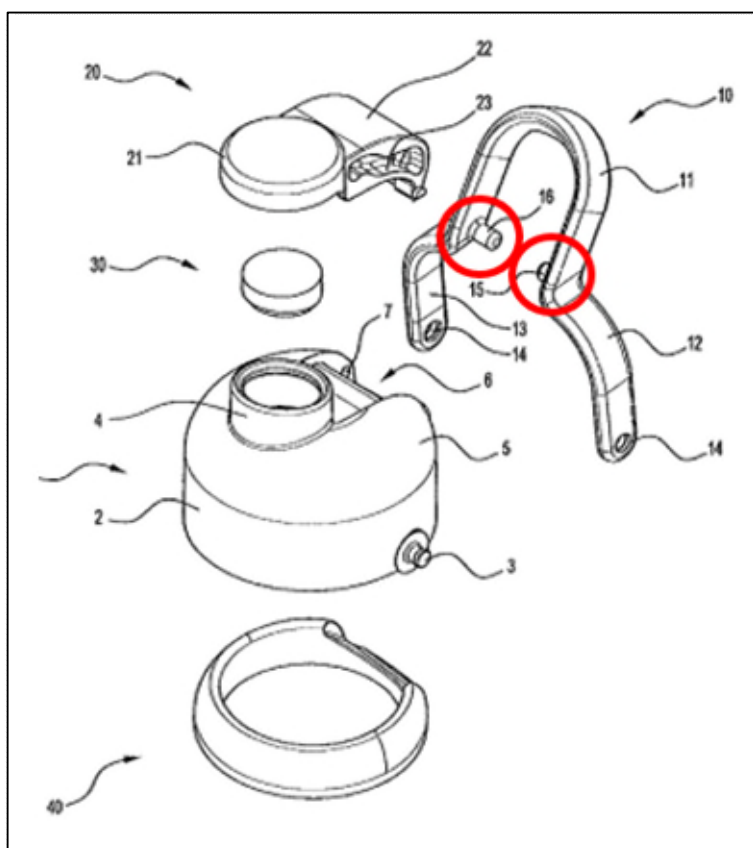
Petitioner contends that “closure retention mechanism” in claims 5 and 19 should be construed as a means-plus-function limitation under 35 U.S.C. § 112(f). Pet., 18-23. Although Patent Owner disagrees that § 112(f) applies, because Petitioner has not overcome the presumption against applying § 112(f) where the claims do not recite “means for” limitations, Petitioner has nonetheless failed to show that the other expressly claimed requirements of the “closure retention mechanism” are taught by the prior art under the plain and ordinary meaning of those requirements. As such, express construction is not necessary at this stage to resolve the parties’ dispute as to the grounds presented by Petitioner. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). Patent Owner reserves the right to address the proper construction of any claim terms in the future, as needed. By reserving such arguments at this stage, Patent Owner does not concede that the Petition uses claim language consistent with its proper construction(s).

VI. PETITIONER HAS NOT SHOWN A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CLAIM

Petitioner's asserted grounds for anticipation and obviousness are not supported by the evidence. Petitioner thus fails to show a reasonable likelihood of prevailing on any claim as required for institution. *See* 35 U.S.C. § 314(a).

A. Grounds 1 and 2 Fail Because Samartgis Does Not Disclose or Render Obvious the Closure Retention Mechanism in Claims 5 and 19

Independent claims 5 and 19 recite “a handle extending from the base, wherein the handle includes a *closure retention mechanism configured to selectively retain the closure in a stowed position relative to the handle when the closure is selectively removed from the drink spout and received by the closure retention mechanism.*” For the “closure retention mechanism,” Petitioner relies on lug members 15 and 16, shown in the annotated version of Figure 3 of Samartgis below. However, lug members 15 and 16 do not meet the requirements of claims 5 and 19, because they (1) do not selectively retain the closure in a stowed position relative to the handle, and (2) do not receive the closure.



Ex. 1004, Fig. 3 (annotated).

As explained below, Petitioner fails to show how this limitation is anticipated by, or rendered obvious in view of, Samartgis.

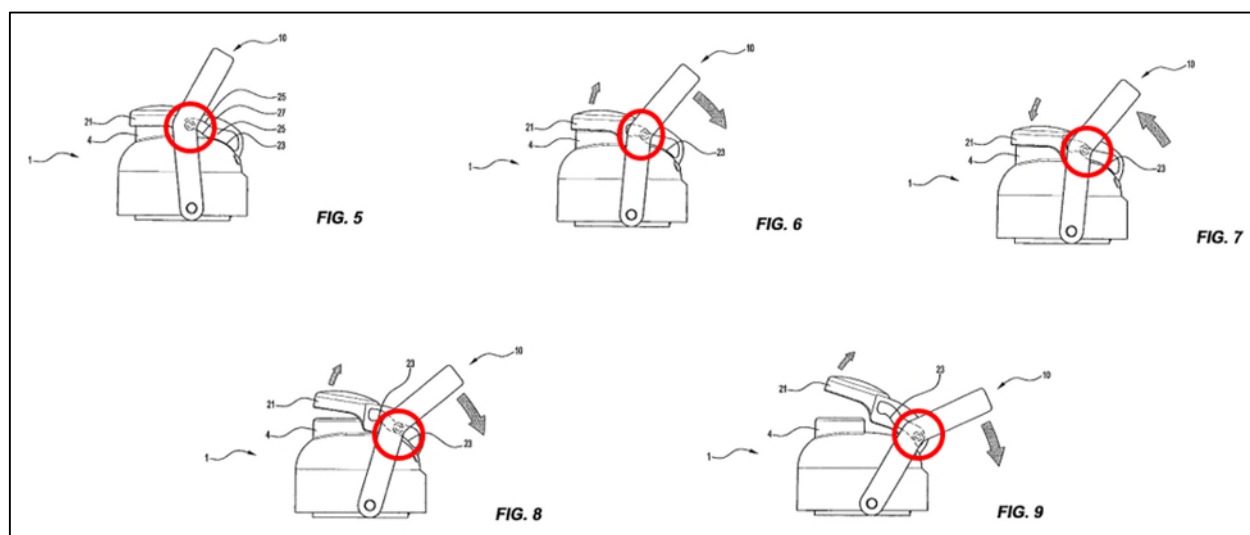
1. Petitioner Fails to Show Samartgis Anticipates Claim Elements 5[b][iv][a] and 19[d][1]

With respect to anticipation under § 102, Petitioner fails to show where all requirements in elements 5[b][iv][a] and 19[d][1] are disclosed in Samartgis. Specifically, Petitioner fails to demonstrate: 1) that the alleged closure retention mechanism in Samartgis (i.e., lug members 15 and 16) is configured to “retain” Samartgis’s alleged closure (flap member 20) “in a stowed position,” 2) that such

retention, if assumed to exist, is “selective[],” or 3) that the lug members 15 and 16 ever “receive[]” the alleged closure (flap member 20).

First, Petitioner fails to demonstrate how Samartgis discloses a closure retention mechanism⁷ that is configured to retain a closure in a stowed position. The purported closure (flap member 20) in Samartgis is always attached to lug members 15 and 16 and can freely move about lug members 15 and 16. *See* Ex. 1004, Figs. 5-9 (showing lug members 15 and 16 attached to tracks 23 of the flap member 20 in the open and closed configuration); *id.*, 4:12-19 (“lug members 15 and 16 being able to move along the tracks 23 of flap member 20”).

⁷ Patent Owner does not concede that lug members 15 and 16 are a “closure retention mechanism” under either a plain and ordinary meaning or Petition’s 112(f) proposed construction. However, for purposes of this preliminary response, the construction of “closure retention mechanism” is irrelevant because Petitioner fails to show lug members 15 and 16 are configured to meet other limitations of claims 5 and 19.



Ex. 1004, Figures 5-9 (annotated). When open, the flap member 20 is not “retain[ed]” in a “stowed position,” because nothing retains it in that particular position. Rather, the alleged closure can still freely rotate about lug members 15 and 16 and toward and away from the spout. Samartgis nowhere states that lug members 15 and 16 can retain the flap member 20 in a stowed position when it has been selectively removed from the drink’s spout, as required by the claims.⁸

⁸ Petitioner misinterprets Samartgis’s discussion to assert that “Figure 9 shows the lever 10 in the ‘locking position,’ meaning the closure (flap 20) is retained relative to the handle by the lug members 15 and 16 in the open position.” Pet., 34 (citing Ex. 1004 at 4:12-30). But the cited portion of Samartgis relied on actually states that when the lever member 10 is in the position shown in Figure 9, “it *can be returned*

Second, even assuming that lugs 15 and 16 are capable of “retain[ing]” Samartgis’s closure in a stowed position, Petitioner does not attempt to show how lug members 15 and 16 “**selectively** retain” the closure in a stowed position. Instead, Petitioner claims these members merely “retain[] the closure (flap member 20) in a stowed position relative to the handle (lever/carry member 10) when the closure is removed from the drink spout.” Pet., 34, 35 (omitting the required “selectively” language from the claim and any explanation of how the lug members 15 and 16 retain the closure in a stowed position). Even if lug members 15 and 16 could be considered a closure retention mechanism, the Petition is entirely silent on how those members “**selectively** retain the closure in a stowed position.” This omission is fatal

to the locking position, with the anti-tampering ramp section 25, lifting the flap member 20 and allowing the lever member 10 to pass through that section without any possibility of jamming.” Ex. 1004, 4:28-34 (emphasis added). Thus, contrary to Petitioner’s assertion, Figure 9 is not depicting the lever member 10 “in” a locking position. Further, elsewhere, Samartgis confirms that anti-tampering portions of the track 23 are used to “lock” flap member 20 in place in a “closed” position. Ex. 1004, 3:58-4:4; Figure 7. Thus, Samartgis discloses locking the flap member in a closed position, not in a stowed open position, as required by the claims.

to Grounds 1 and 2 because Petitioner does not carry its burden to show where Samartgis discloses or teaches the full claim language in elements 5[b][iv][a] and 19[d][1].

The Petition’s silence on this limitation is likely because there is no disclosure of selective retention in Samartgis. Indeed, the purported closure is always attached to lug members 15 and 16 and can freely move about lug members 15 and 16. *See* Ex. 1004, Figs. 5-9 (showing lug members 15 and 16 attached to tracks 23 of the flap member 20 in the open and closed configuration); *id.*, 4:12-19 (“lug members 15 and 16 being able to move along the tracks 23 of flap member 20”).

At best, Samartgis merely discloses that its flap member 20 can be closed to cover the spout or neck 4 (FIGS. 5-7) and that its flap member 20 can be opened by lifting it away from spout or neck 4 (FIGS. 8, 9). In both circumstances, flap member 20 is always engaged with the purported closure retention mechanism, lug members 15 and 16, so there is nothing “selective” about these lug members. That is, to the extent it is assumed that lug members 15 and 16 “retain” flap member 20, they certainly do not do so “selectively” because flap member 20 cannot become un-retained from the lug members 15 and 16.

Third, and for similar reasons, Petitioner fails to show that Samartgis discloses or teaches a closure retention mechanism that is “configured to selectively retain the closure in a stowed position . . . **when the closure . . . is received by the**

closure retention mechanism.” Once again, Petitioner excerpts and omits the “received” requirement in claims 5 and 19 in its description of Samartgis. Pet., 34. Specifically, Petitioner states that “lug members 15 and 16 are a closure retention mechanism because they are designed to, and do, perform the claimed function of retaining the closure (flap member 20) in a stowed position relative to the handle (lever/carry member 10) ***when the closure is removed from the drink spout.***” *Id.* (emphasis added) (omitting the rest of claim 5[b][iv][a]’s requirement that the closure be “received by the closure retention mechanism”).

Petitioner’s quotations of Samartgis in relation to the purported function do not match Petitioner’s proposed construction of the function under § 112(f), let alone the plain claim language, which requires that the “closure retention mechanism” be configured to “receiv[e]” the closure. Pet., 20 (Petitioner stating “the recited function of this means-plus-function clause is to ‘selectively retain the closure in a stowed position relative to the handle ***when the closure is*** selectively removed from the drink spout and ***received by the closure retention mechanism.***”) (emphasis added). Once again, this omission is fatal to Grounds 1 and 2 because Petitioner does not carry its burden to show where Samartgis discloses or teaches the full claim language in elements 5[b][iv][a] and 19[d][1].

Petitioner’s silence on the “received” limitation is not surprising because Samartgis does not disclose that lug members 15 and 16 are configured to receive a

closure. Indeed, lug members 15 and 16 are always situated within tracks 23 of the purported closure (flap member 20). Thus, Samartgis's purported closure can never be "received" by lug members 15 and 16. Samartgis, therefore, does not anticipate the challenged independent claims 5 and 19.

2. Petitioner Fails to Show Claim Elements 5[b][iv][a] and 19[d][1] are Obvious

As a conclusory fallback position, Petitioner makes a blanket assertion for Ground 1 that "[i]f the Board were to find that Samartgis does not disclose one or more limitations of the claimed invention, such limitation(s) are at least suggested by Samartgis for the reasons discussed above." Pet., 36. Without any further identification of which limitations would have allegedly been obvious or why, Petitioner simply concludes that "claim 5 would have been obvious to a POSITA in view of Samartgis." Pet., 35 (citing Ex. 1003, ¶ 103). Petitioner's conditional, conclusory, and non-specific obviousness argument is a "catch-all" position that fails the "particularity" requirement of Section 312 and fails to show a reasonable likelihood of success as to obviousness for Ground 1. 35 U.S.C. § 312(a)(3) ("A petition filed under section 311 may be considered only if . . . (a)(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim"); *see also* *Adaptics Ltd. v. Perfect Co.*,

IPR2018-01596, Paper 20 (PTAB March 6, 2019), at 19-20 (designated informative) (denying institution of petition for failing to satisfy the “particularity” requirement of 35 USC § 312(a)(3) where the petition “fail[ed] to specify what Petitioner regards as the difference(s) between [the alleged anticipatory references] and the challenged claims” in Petitioner’s “catch-all” obviousness grounds based on those references) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (requiring that the differences between the prior art and the claims at issue be ascertained as part of an obviousness analysis)); *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00003, Paper 7 (PTAB Oct. 25, 2012), at 2-3 (“Differences between the claimed invention and the prior art are a critically important underlying factual inquiry for any obviousness analysis. A petitioner who does not state the differences . . . and relies instead on the Patent Owner and the Board to determine those differences . . . risks having the corresponding ground of obviousness not included for trial.”)

In addition, Petitioner’s reliance on a single paragraph in Dr. Vallee’s declaration (Ex. 1003) does not cure the fatal defects in the Petition’s obviousness argument. Petitioner cites exclusively to paragraph 103 from Dr. Vallee’s declaration to support its obviousness argument for Ground 1. Pet., 35. But like the Petition, paragraph 103 of the declaration makes only conclusory and conditional statements that “it would have been within the knowledge of one skilled in the art to

modify the Samartgis device to achieve such features because the claimed features were well known in the art and represented simple, known techniques for beverage containers having removable cap assemblies.” Ex. 1003, ¶ 103. Nowhere does the expert explain, on a limitation-by-limitation basis, which claim elements would have been obvious to one skilled in the art or why. Indeed, Dr. Vallee does not even point to specific teachings from other references that would have informed a person of ordinary skill in the art that any specific “features would have been obvious.” This is insufficient. *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.”); *see also* *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1362 (Fed. Cir. 2019) (reversing obviousness determination in IPR because expert’s “conclusory statements and unspecific expert testimony” were “inadequate to support the Board’s factfinding regarding motivation to combine”); *DSS Tech. Mgmt., Inc. v. Apple Inc.*, 885 F.3d 1367, 1376 (Fed. Cir. 2018) (reversing obviousness finding because an expert’s “conclusory statements and unspecific expert testimony” were insufficient to support the Board’s findings of obviousness).

Further, nowhere does Petitioner (or its expert) identify the motivation or why one of ordinary skill would have had a reasonable expectation of success, let alone for which claim limitations. Again, this alone is reason to reject Petitioner’s obviousness grounds. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9

(PTAB August 24, 2022) (precedential) (denying institution where petitioner relied on conclusory, unsupported expert declaration that did not “cite to any additional supporting evidence or provide any technical reasoning” and instead merely repeated verbatim the assertion in the petition that the reference taught a limitation); *see also Wireless Seismic, Inc. v. Fairfield Indus., Inc.*, IPR2014-01205, Paper 8 (PTAB Jan. 14, 2015), at 29 (“The reasons one with ordinary skill in the art would have to make modifications to the prior art to arrive at the claimed subject matter cannot be discussed sufficiently or rationally without specifically identifying all the differences between the claimed subject matter and the prior art.”).

Petitioner, therefore, has failed to show a reasonable likelihood of success with regard to independent claims 5 and 19 for Grounds 1 and 2.⁹

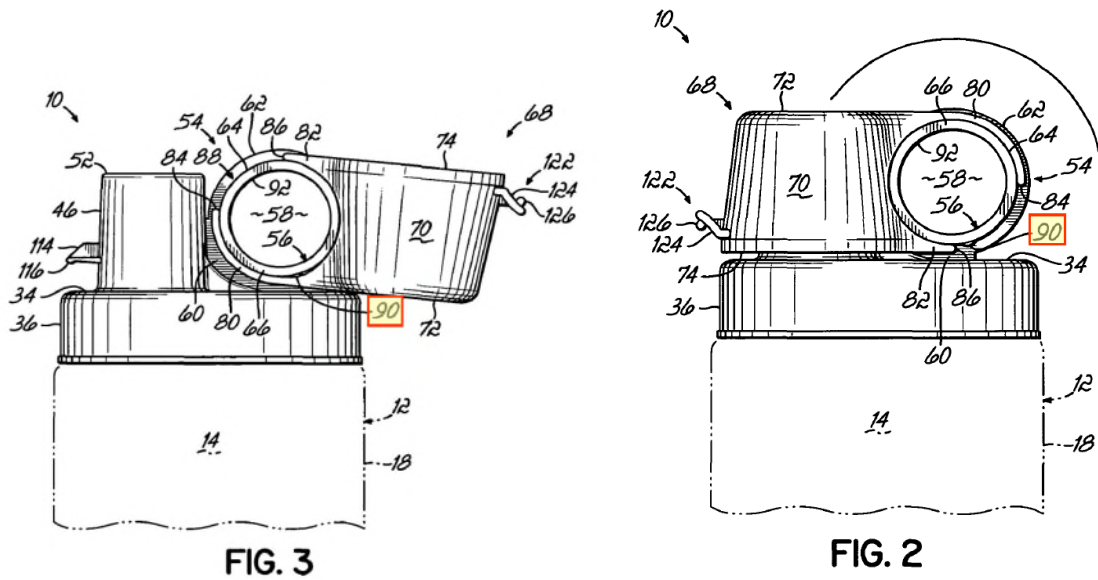
B. Petitioner’s Grounds Based on Leoncavallo Also Fail Because the Cited Art Does Not Disclose or Render Obvious Claims 5 and 19.

Petitioner argues that Leoncavallo meets all of the limitations of independent claims 5 and 19, including “a handle extending from the base, wherein the handle includes a *closure retention mechanism configured to selectively retain the closure in a stowed position relative to the handle when the closure is selectively removed*

⁹ Ground 2 challenges claims 16-18. Because claims 16-18 depend from claim 5, Petitioner’s failures with respect to claim 5 also apply to claims 16-18.

from the drink spout and received by the closure retention mechanism.” However, Petitioner fails to identify any portion of Leoncavallo that discloses or renders obvious (1) a closure retention mechanism that is “configured to selectively retain the closure in a stowed position,” (2) that is configured to “selectively retain the closure in a stowed position . . . when the closure is . . . received by the closure retention mechanism” or (3) where “the closure is . . . **received by** the closure retention mechanism.” These omissions are fatal to Grounds 3 and 4 because Petitioner does not carry its burden to show where Leoncavallo discloses or teaches the full claim language in independent claim elements 5[b][iv][a] and 19[d][1], and Petitioner’s obviousness grounds based on Groskey and Johnson are not offered to cure this deficiency. Rather, Petitioner cites Groskey and Johnson solely for dependent claims 16 and 17.

First, regarding the first missing limitation, Petitioner argues that the detents 90 of Leoncavallo are a “closure retention mechanism configured to selectively retain the closure in a stowed position,” as shown in the figures immediately below.



(Ex. 1005, Figs. 2-3). However, Leoncavallo does not disclose or teach that the detents 90 “*selectively retain the closure in a stowed position relative to the handle*” when the closure is . . . received by the closure retention mechanism” (claims 5 and 19).¹⁰ Rather, Leoncavallo states that “[t]he detents 90 are configured to frictionally engage the connector member 80 as it travels about the loop 54 when the flip cap 68 is moved to the open position as shown in Fig. 3.” Ex, 1005, 5:36-39. At no point

¹⁰ Patent Owner does not concede that detents 90 are a “closure retention mechanism” under either a plain and ordinary meaning or Petitioner’s proposed construction under § 112(f). However, for purposes of this preliminary response, the construction of “closure retention mechanism” is irrelevant because Petitioner fails to show detents 90 are configured to meet other limitations of claims 5 and 19.

does Leoncavallo state that this mere friction between the detents 90 and the connector member 80 during rotation about loop 54 causes the detents 90 to **retain** the alleged closure (flip cap 68) in a **stowed position relative to the handle**. On the contrary, the frictional engagement between detents 90 and the connector member 80 merely “**aid** in keeping the flip cap 68 in the open position when the user desires access to the spout 46.” *Id.*, 5:39-42 (emphasis added); see Pet., 68 (modifying quote to eliminate the “**aid in keeping**” portion of specification). To accomplish this, as the Petition acknowledges, the connector member 80 of Leoncavallo “travels about loop 54,” *i.e.*, is not retained, over detents 90 for a distance before the “flip cap 68 is moved to the open position as shown in FIG. 3” where it appears to rest against end wall 34. To the extent Petitioner suggests the “open position” shown in Figure 3 may be the “stowed position,” there is no disclosure in Leoncavallo that the detents 90 **retain** the alleged closure in that particular “open position” shown in Figure 3 or that such a position is a “**stowed position relative to the handle**.” Indeed, there is nothing about the friction provided by the detents 90 at the open position shown in Figure 3 that distinguishes that particular open position from any other particular open position where there is the same frictional contact occurring between the detents 90 and connector member 80.

Second, as to the next missing limitation, even accepting Petitioner’s unsupported argument that the detents 90 somehow “retain” the alleged closure in a

“stowed position” in Leoncavallo, Petitioner nonetheless fails to meet its burden to show that the detents 90 “selectively retain the closure ***in a stowed position . . . when the closure is . . . received*** by the closure retention mechanism.” As an initial matter, Petitioner never clearly explains how or when the closure is “received by” detents 90 or what constitutes a “stowed position” in Leoncavallo. To the extent Petitioner argues that (1) the closure is “received by” the detents 90 any time there is frictional contact between the connector member 80 and detents 90 and (2) the “stowed position” is the fully open position shown in Figure 3, then the “closure” is not “in a stowed position . . . when the closure is . . . received by” the detents 90 under Petitioner’s theory. Pet., 69 (“The detents retain the closure in a stowed position relative to the handle ***when the user*** removes the closure from the drink spout and ***rotates the closure to frictionally engage the detents***, which thereafter maintain the closure in the open position.”) (emphasis added). When Petitioner’s alleged “closure retention mechanism” (detents 90) comes into frictional contact with the connector member 80 (alleged “recei[pt] by the closure retention mechanism”), the flip cap 68 (alleged closure) is still in the process of opening and has not yet reached any alleged “stowed position,” to the extent one exists, because the front edge of the connector member 80 travels far past the detents 90 before reaching the alleged “stowed position” shown in Figure 3. Ex. 1005, 5:36-39 (“The detents 90 are configured **to**

frictionally engage the connector member 80 as it travels about the loop 54 when the flip cap 68 is moved to the open position as shown in FIG. 3.”) (emphases added).

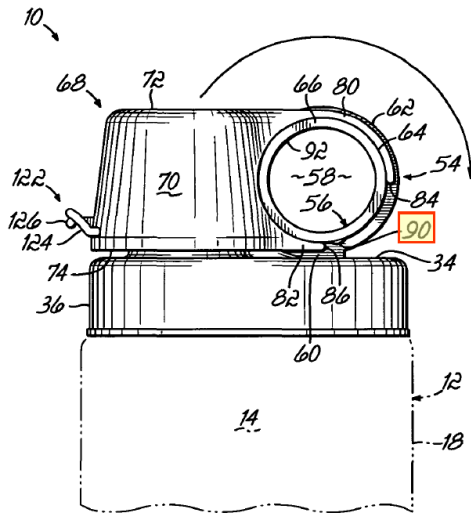


FIG. 2

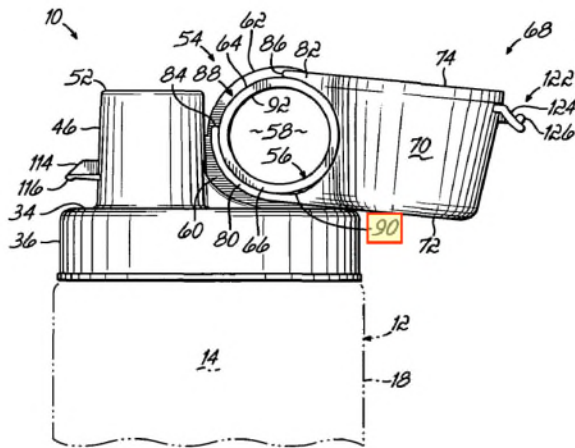


FIG. 3

Ex. 1005, Fig. 3. Therefore, under Petitioner’s seeming theory, Leoncavallo’s alleged closure retention mechanism does not “selectively retain the closure in a stowed position . . . *when the closure is . . . received by the closure retention mechanism.*”

However, if Petitioner’s theory relating to how “the closure is . . . **received by** the closure retention mechanism” or what constitutes the “stowed position” is different from what Patent Owner states above, Petitioner fails to adequately articulate its theory with sufficient particularity and fails to meet its burden for this additional reason.

Third, Leoncavallo does not meet the limitation requiring that “**the closure**” be “received by the closure retention mechanism.” The alleged “closure retention mechanism”—detents 90—only frictionally engage with the connector member 80. Petitioner does not argue that connector member 80 forms any part of the closure to the spout 46. The function of the connector member 80 is only to rotate about the loop 54, and the connector member 80 never covers the spout 46. Thus, Petitioner does not establish that connector member 80 is a “closure” that is “received by” the alleged “closure retention mechanism”—detents 90. Further, the sidewall 70 and top edge 72 of flip cap 68 are the only structures in Leoncavallo that cover the spout 46 and could, therefore, be considered a “closure.” But sidewall 70 and top edge 72 are never “received by” detents 90. Therefore, Petitioner fails to establish that Leoncavallo discloses or renders obvious that “the closure that is selectively removed . . . [is] **received by** the closure retention mechanism.”

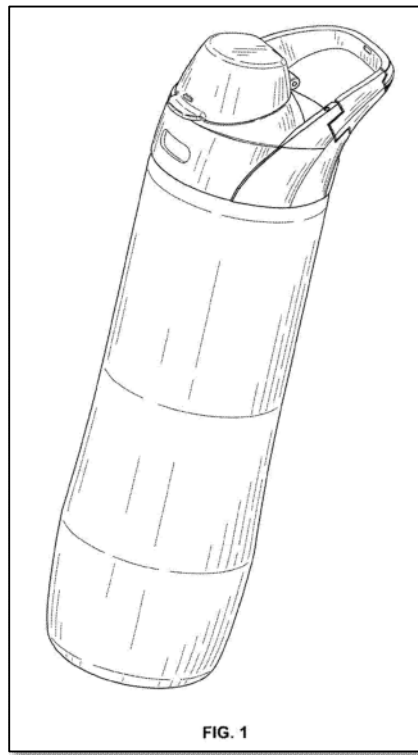
Finally, Petitioner advances an argument that the entirety of claims 5 and 19 would have been obvious in view of Leoncavallo, but fails to explain which limitations would have been obvious or to offer any reasoned, non-conclusory expert opinion(s) regarding why claims 5 and 19 would have been obvious in view of Leoncavallo. This “catch-all” obviousness argument is plainly insufficient under the law and also fails to meet the statutory “particularity” requirement for all the reasons discussed in Section VI.A.2 *supra*. Therefore, all grounds that any challenged claim

would have been obvious in view of Leoncavallo alone or in combination with other references should be rejected.

C. Petitioner’s Grounds Based On Miller Fail Because Miller Does Not Disclose Or Render Obvious the Drink Spout, Closure Limitations, or Closure Retention Mechanism

Independent claims 5 and 19 recite: 1) “*a drink spout extending from the base,*” 2) “*a closure configured to be removably coupled relative to the drink spout in a closed position to selectively restrict dispensing of drink liquid through the passage and to selectively permit dispensing of drink liquid through the passage when removed from the drink spout,*” and 3) “wherein the handle includes *a closure retention mechanism* configured to selectively retain the closure in a stowed position relative to the handle when the closure is selectively removed from the drink spout and received by the closure retention mechanism.” Petitioner first argues that Miller alone discloses these limitations (Pet., 85-89 (arguing “Miller alone” discloses these limitations)), but Petitioner’s analysis of Miller is fatally deficient as to each.

First—as Petitioner’s own expert admits—there is no description of a “drink spout” in Miller. Ex.1003, ¶ 224. In each of Miller’s seven figures, the only visible structure is the alleged “closure,” which covers any opening to the beverage container, if one even exists, below the alleged “closure.” See Ex. 1006, Figs. 1-7. This can be seen in exemplary Figure 1 of Miller below:



Ex. 1006, Fig. 1. Rather than provide evidence showing the required “drink spout,” Petitioner simply concludes that “any cap assembly would necessarily include an opening forming a passageway for dispensing the beverage.” Pet., 85. But the claims do not merely require an “opening”—they require “a drink spout.” Moreover, in presuming that a “drink spout” exists (without any disclosure), Petitioner ignores the additional, specific language in the claim: namely, the drink spout must be “extending from the base.” Nowhere in the Petition is there any evidence, or even an argument, that Miller discloses “a drink spout extending from the base,” rather than the mere “opening” that Petitioner speculates would exist. See Pet., 85-86.

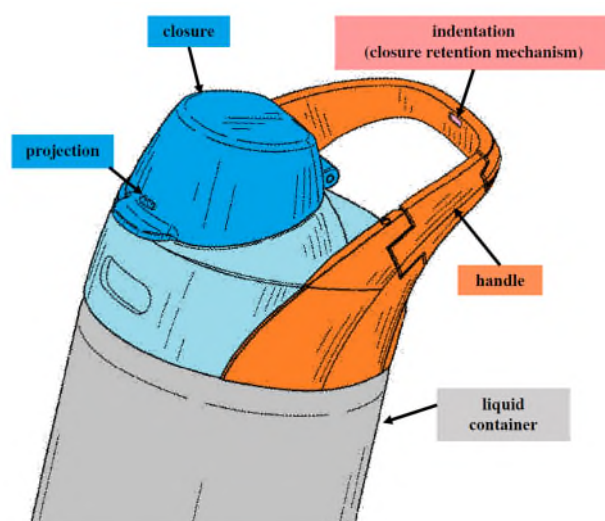
Second, Petitioner does not cite any evidence in Miller that the purported “closure” is “configured to be removably coupled relative to the drink spout,” as required by the claims. Instead, the Petition cites to Dr. Vallee’s conclusory assertions that “[o]ne skilled in the art would have understood that any cap assembly including a spout would *necessarily* need” the cap assembly to be “removably coupled” relative to a drink spout. Ex.1003, ¶ 226 (emphasis added). But Dr. Vallee’s declaration provides no evidence or factual support to back this assertion, let alone evidence of any disclosure of a “drink spout” (as opposed to just an opening) in the first place. 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.”); *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (P.T.A.B. August 24, 2022) (precedential) (denying institution where petitioner relied on conclusory, unsupported expert declaration that did not “cite to any additional supporting evidence or provide any technical reasoning”).

Third, Petitioner fails to identify any evidence that any such “removabl[e] coupl[ing]” relative to a “closure” and “drink spout” would “selectively restrict dispensing of drink liquid through the passage [defined by the drink spout] and to selectively permit dispensing of drink liquid through the passage when removed from the drink spout” per claims 5 and 19. Indeed, Petitioner does not identify and Miller does not disclose any “drink spout,” much less how the alleged closure of

Miller would couple relative to any drink spout if one existed or how, or whether the closure would selectively restrict and permit dispensing of drink liquid through the passage defined by the drink spout. Instead, Petitioner assumes a closure “would be necessary to allow the user to close the spout and prevent spills or leakage when not in use.” Pet., 87. But there is no evidence presented to suggest (1) that the purported closure in Miller is anything more than a cover; (2) that Miller has any drink spout extending from the base rather than a mere opening under the cover, (3) that Miller’s cover selectively restricts dispensing drink liquid through the passage defined by the drink spout when the cover is closed, or (4) that Miller’s cover selectively permits dispensing of drink liquid through the passage defined by the drink spout when the cover is removed from the drink spout. Petitioner’s position is based entirely on conjecture and speculation from a single set of drawings in a design patent that does not depict any structure under Miller’s cover.

Fourth, Petitioner and its expert rely on pure speculation to contend that Miller’s handle includes a “closure retention mechanism configured to selectively retain the closure in a stowed position relative to the handle when the closure is selectively removed from the drink spout and received by the closure retention mechanism.” Specifically, Petitioner and its expert speculate that an apparent “projection” on Miller’s alleged “closure” would “snap together” with an apparent “indentation” in Miller’s handle. Pet., 88-89. Petitioner labels the alleged

“projection” and alleged “indentation,” which Petitioner contends satisfies the claimed “closure retention mechanism,” in the below annotated version of Figure 1 of Miller:



Pet. at 89. But Miller is a design patent that must depict an “ornamental design” (Ex. 1006 at Claim) rather than particular functional features of such a container, like a utility patent would. *See, e.g., PHG Technologies, LLC v. St. John Companies, Inc.*, 469 F.3d 1361, 1366 (Fed. Cir. 2006) (“As the statute indicates, a design patent is directed to the appearance of an article of manufacture. If the patented design is primarily functional rather than ornamental, the patent is invalid.”). Thus, Miller’s alleged “projection” and “indentation” are presumptively ornamental, rather than functional. Further, none of Miller’s figures ever depict the alleged “projection” on the alleged “closure” snapping together with or otherwise engaging the alleged “indentation.” In addition, because Miller is a design patent, it contains no written

description of any such function of Miller either. Thus, Petitioner has failed to adequately demonstrate that Miller discloses a “handle [that] includes a closure retention mechanism configured to selectively retain the closure in a stowed position relative to the handle when the closure is selectively removed from the drink spout and received by the closure retention mechanism.” *See Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1284 (Fed. Cir. 2017) (affirming Board’s finding that prior art did not teach limitation and noting that “it has long been understood that ambiguous references do not, as a matter of law, anticipate a claim.”). Petitioner and its expert’s speculation does not create a “reasonable likelihood” of prevailing with regard to this limitation.

The Petition attempts to overcome the lack of disclosure in Miller by arguing that these limitations would have also been obvious over Miller. But these arguments are unavailing.

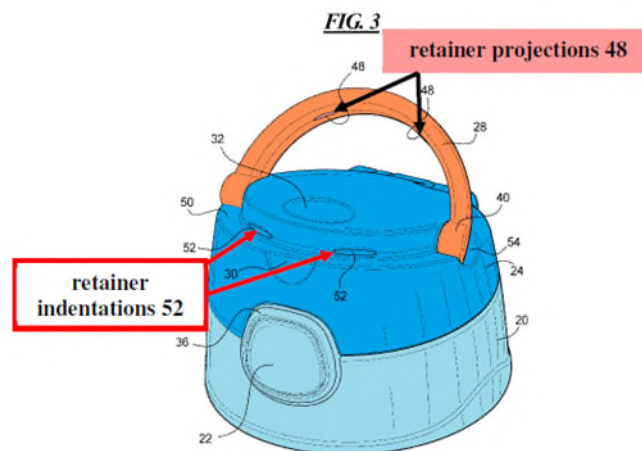
First, Petitioner argues that a closure, as claimed, would have been obvious to a POSITA, relying only on Dr. Vallee’s assertion that “cap assemblies with a pivotally connected closure were conventional at the time of the invention.” Ex. 1003, ¶¶ 226-227; Pet., 86-88. This conclusory statement is insufficient to support obviousness. An element being known in the prior art is not sufficient to establish obviousness. *Vision Intl. ULC v. Assembly Guidance Sys., Inc.*, 97 F.4th 882, 887 (Fed. Cir. 2024); *see also KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)

(“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.”). To show obviousness, Petitioner is required to provide factual support for the assertion that a POSITA would have been motivated to implement or combine a known element in the prior art with the container of Miller to arrive at the claimed invention, and it has not done so. *Apple Inc. v. MPH Technologies Oy*, 28 F.4th 254, 262–63 (Fed. Cir. 2022); *see also* VI.A.2, *supra*.

Second, Petitioner’s argument in Section XII(B)(2) ignores the remaining elements of the “closure” limitation, including that the “closure” must be ***“configured to be removably coupled relative to the drink spout in a closed position to selectively restrict dispensing of drink liquid through the passage and to selectively permit dispensing of drink liquid through the passage when removed from the drink spout.”*** Even if “cap assemblies with a pivotally connected closure” were known in the art, Petitioner fails to establish that such assemblies necessarily result in a bottle closure that is “removably coupled relative to the drink spout” or that selectively restricts dispensing of drink liquid through the passage defined by the drink spout in a closed position and selectively permits such dispensing through the spout when removed from the spout, as claimed in the ‘252 patent, nor does Petitioner mention any motivation to alter Miller to provide such a coupling or such

selective restriction or permission of dispensing through a spout upon coupling or removal of such a closure. Pet., 86-88, 95-97.

Third, with regard to the alleged “closure retention mechanism,” Petitioner argues that “[a] POSITA would have recognized that using one or more cooperating projections and indentations on a closure and handle to removably connect the two together was conventional at the time of the invention.” Pet., 90. To support this contention, Petitioner relies on the Lane reference (Ex. 1007). *Id.* However, as shown in Petitioner’s annotated version of Fig. 3 below, Lane discloses a handle that folds down to stow in a closed cap/closure, which is the **opposite** of claims 5 and 9’s handle, which includes a closure retention mechanism configured to receive and retain a closure/cap in a stowed position when the closure/cap is opened.



Pet. 90 (citing Ex. 1007, Fig. 3 (annotated)). Thus, Lane’s **stowed handle in a closed cap/closure** does not suggest that the claimed **stowed open cap/closure** is conventional. Further, unlike Petitioner’s speculative “indentation” in Miller’s

handle for receiving the “projection” of Miller’s cap, Lane’s handle includes ***projections***, not indentations, that engage with Lane’s cap’s ***indentations***. Thus, Lane’s handle does not receive anything whatsoever and has an engagement mechanism that is the ***reverse*** of that which Petitioner speculates is present in Miller. Lane, therefore, on its face, does not support Petitioner’s alternative contention that the claimed “closure retention mechanism” is obvious over Miller.

Finally, perhaps recognizing these deficiencies in Lane, Petitioner contends “a pivotal closure cooperating with a handle to maintain the closure open while drinking was conventional at the time of the invention” and cites to Samartgis and Leoncavallo. Pet., 90-91. This does nothing to cure Miller’s deficiency in not disclosing a handle that includes closure retention mechanism configured to receive and selectively retain a closure in a stowed position. As discussed above, Samartgis does not teach a closure retention mechanism that “receive[s]” a closure or that “selectively retains” a closure. *See* Sec. VI.A, *supra*. And Leoncavallo does not selectively retain a closure, does not retain a closure “in a stowed position . . . when the closure is . . . received by the closure retention mechanism,” and does not “receive[]” a “closure.” *See* Sec. VI.B, *supra*. Thus, even by purporting to rely on Samartgis or Leoncavallo, Petitioner does not cure the deficiency in Miller, because none of those references satisfy the claimed requirements of the claimed “closure retention mechanism.”

For these reasons, the grounds relying on Miller fail.

D. Petitioner’s Ground Based on Miller in view of Leoncavallo Fails Because the Petition Fails to Establish a Specific Motivation to Combine Miller and Leoncavallo for Particular Missing Limitations or How such a Combination Would Have Been Made

The Petition’s analysis regarding a motivation to combine Miller and Leoncavallo is conclusory and unsupported by factual evidence. Petitioner’s motivation to combine analysis is not specific to the missing “drink spout” or “closure” limitations of Miller or to any specific disclosures in Leoncavallo. Pet., 95-96. It consists of bare assertions that the elements of the proposed combination were “well-known, leading a POSITA to reasonably expect success in the combination” and “represent[] nothing more than the simple addition of known elements . . .to another known element . . . to obtain predictable results.” Pet., 97; Ex.1003, ¶¶ 235-237. At best, these conclusory statements suggest that Leoncavallo’s “closure” was known but not how any aspects of Leoncavallo’s closure would have been combined with Miller or that a POSITA would have been motivated to combine any particular known elements of Leoncavallo with Miller, particularly when Petitioner also fails to identify any particular shortcoming in the design of the Miller bottle for which it is combining Leoncavallo. *Virtek Vision Intl. ULC v. Assembly Guidance Sys., Inc.*, 97 F.4th 882, 887 (Fed. Cir. 2024) (element being “known” in the prior art is not sufficient to establish motivation to combine);

see also Personal Web Techs., LLC v. Apple, Inc., 848 F.3d 987, 994 (Fed. Cir. 2017) (arguing that references “could” be combined “does not imply a motivation to pick [the references] and combine them to arrive at the claimed invention”) *Vision Intl. ULC v. Assembly Guidance Sys., Inc.*, 97 F.4th 882, 887 (Fed. Cir. 2024); *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.”).

In reference to the “closure” limitation specifically, the Petition argues only that a POSITA would have been motivated to modify Miller to include Leoncavallo’s closure because “including a closure and plug disclosed in Leoncavallo would provide the user with a way to securely close the spout to prevent leakage or spills when not in use, and to open the spout to take a drink.” Pet., 96; Ex.1003, ¶ 235. But this statement is unsupported by any evidence, including any specific disclosure showing that Leoncavallo’s “closure” does in fact “securely close the spout to prevent leakage or spills,” and is therefore insufficient to show a motivation to modify Miller using Leoncavallo’s closure. *See TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1362 (Fed. Cir. 2019) (reversing obviousness determination when expert’s testimony was “[u]ntethered to any supporting evidence”).

Further, because Petitioner fails to identify particular missing elements of Miller or the specific elements of Leoncavallo that Petitioner is proposing to combine with Miller, Petitioner has failed to explain how Leoncavallo would be combined with Miller or how such a combination would even work. A Petitioner cannot carry its burden to show obviousness where there is no “clear, evidence-supported account” of “how the combination” would work. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017); *see also Apple v. Uniloc Luxembourg S.A.*, IPR2018-00420, (PTAB August 6, 2018), Paper 7, at 18 (denying petition because Petitioner did not provide “a clear, evidence-supported account of how the alleged teachings work together in a cogent mapping of the claim as a whole”). As just one example, Petitioner has not explained whether or how any particular aspects of Leoncavallo’s rotating flip cap and loop assembly would be combined with Miller’s container, which has a handle that would appear to block placement of such a loop and also obstruct such rotation. Because Petitioner has failed to articulate which specific components or teachings of Leoncavallo would have been combined with Miller or how they would have been combined, Petitioner has failed to demonstrate a reasonable likelihood of prevailing with regarding to this obviousness ground.

For these reasons, all grounds in the Petition relying on a combination of Miller and Leoncavallo fail.

VII. THE BOARD SHOULD DENY THE PETITION UNDER § 325(D) BECAUSE THE OFFICE PREVIOUSLY CONSIDERED THE PRIMARY REFERENCES DURING EXAMINATION

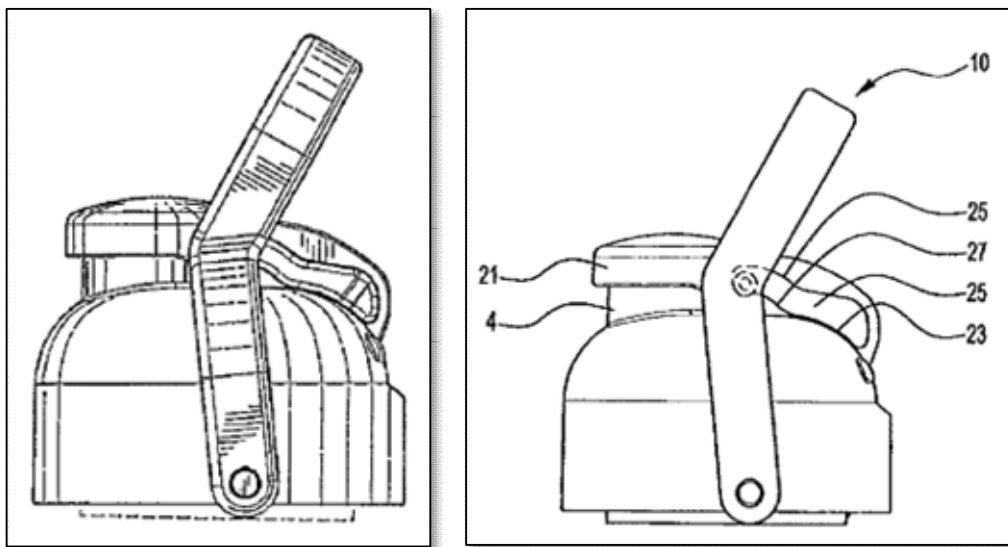
Contrary to Petitioner's claim that the Petition "rests on prior art and arguments not previously presented to the PTO" (Pet., 101), Leoncavallo and Miller were submitted to the PTO during examination of the '252 patent. Additionally, Samartgis's corresponding design patent disclosing a design for the same or a substantially similar dispensing container as that disclosed in the asserted Samartgis reference was also submitted to the PTO during examination. Petitioner relies exclusively on these three primary references for the limitations contained in independent claims 5 and 19. In other words, all of Petitioner's grounds for the challenged claims rely on disclosures that were before the PTO. The Board may deny institution where "the same or substantially the same prior art or arguments" have already been presented to the Office. 35 U.S.C. § 325(d). Accordingly, the Board should exercise its discretion and deny institution under 35 U.S.C. § 325(d).

Section 325(d) provides the Board, acting on behalf of the Director, with discretion to deny institution on a petition for IPR because "the same or substantially the same prior art or arguments previously were presented to the Office." Under Board precedent, "the question of whether proffered art or arguments are 'the same or substantially the same' as art or arguments previously presented to the Office is a highly factual inquiry, which may be resolved by reference to the factors set forth in

Becton, Dickinson.” *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (Feb. 13, 2020) (precedential) (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017)). Under the precedential framework set forth in *Advanced Bionics*, the Board first considers *Becton, Dickinson* factors (a), (b), and (d) to determine whether the same or substantially the same art or arguments previously were presented to the Office, and if so, then the Board considers factors (c), (e), and (f) to determine whether Petitioner has demonstrated a material error by the Office. *Advanced Bionics*, IPR2019-01469, Paper 6 at 8-11. The six factors from *Becton, Dickinson*, when considered under the *Advanced Bionics* framework, favor denial of the Petition.

Factors (a) and (b), the similarities, cumulative nature, and material differences between the asserted art and the prior art involved during examination, favors denying institution because all three primary references in the Petition are the same as, or substantially identical to, references submitted during prosecution of the ‘252 patent. Both Leoncavallo and Miller were submitted with an IDS during examination, and cited on the face of the ‘252 patent. Ex. 1001, page 2 (listing No. D586,184 to Miller et. al., and No. 7,753,240 to Leoncavallo et al.). Additionally, the same cap configuration in Samartgis was submitted during examination via a design patent naming the same inventor (Samartgis) that was submitted and cited on

the face of the ‘252 patent. *Id.* (listing No. D679,541 to Samartgis). As shown below, Samartgis Design discloses a substantially similar, if not identical, cap configuration that Petitioner relies on in Samartgis. Thus, Samartgis is “substantially the same” as Samartgis Design, which was submitted during prosecution.



Compare Samartgis Design, FIG. 5 (Ex. 2001) with Samartgis, FIG. 5 (Ex. 1004)

Factor (d), the extent of overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art is neutral as the Examiner did not issue any substantive rejections during examination. *Id.*

Because factors (a), (b), and (d) demonstrate that “the same or substantially the same art” was previously presented to the Office, the analysis turns to factors (c), (e), and (f) to determine whether the Petitioner has demonstrated a material error by the Office.

Factor (c), the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection, is neutral as the Examiner did not issue any substantive rejections during examination.

Factors (e) and (f), whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art, and the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments favors denying institution because Petitioner has made no showing the Examiner materially erred in evaluation of the asserted prior art. Petitioner's only argument is that the Examiner "clearly and materially erred in not applying" the cited references because the same references submitted to the Examiner purportedly "present a strong case for unpatentability." Pet., 103. Where, as here, the record of the Office's consideration of the cited art is silent, a petitioner may show the Office erred "by overlooking something persuasive under factors (e) and (f)." *Advanced Bionics*, IPR2019-01469, Paper 6, at 10. But, here, Petitioner has failed to specifically identify any particular teaching of any of the references that Petitioner contends is persuasive and was overlooked. Instead, Petitioner merely asserts, in conclusory fashion, that these references present a strong case of unpatentability. More is required to demonstrate material error where, as here, the same or substantially art was previously before the Office, so as to give the proper deference owed to the Office's previous consideration required under §325(d).

Further, as explained above, Petitioner has not carried its burden to show a reasonable likelihood of success on any asserted Ground and none of the asserted references teach or render obvious the challenged claims.

In sum, the same or substantially the same art has already been considered, and Petitioner has failed to articulate any material error was made by the Office. The Board should, therefore, exercise its discretion under § 325(d) to deny institution.

VIII. THE BOARD SHOULD EXERCISE DISCRETION UNDER § 314(A) TO DENY THE PETITION

Petitioner waited nearly six months to file its Petition after Patent Owner asserted infringement counterclaims for the '252 patent against Petitioner in the Northern District of California and nearly nine months after Petitioner first filed suit against Patent Owner.¹¹ Meanwhile, the district court scheduled a jury trial for September 22, 2025 and set a scheduling order with deadlines premised on that trial date. Petitioner's unwarranted delay makes it almost certain that trial in the district court will conclude before the Board has the opportunity to reach a final written decision should institution be granted. Instituting IPR on this Petition, despite

¹¹ Petitioner filed suit against Patent Owner asserting claims seeking declaratory judgment of non-infringement of the '252 patent on August 21, 2023. Patent Owner counterclaimed for infringement of the '252 patent on November 8, 2023.

considerable investment by the parties and the trial court in the co-pending litigation, would frustrate Congress’s intent that IPRs serve as a faster, less costly alternative to litigation on the issue of invalidity. *See, e.g., SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341, 1357–58 (Fed. Cir. 2016) (Newman, J., dissenting-in-part) (collecting evidence of legislative intent regarding § 315 estoppel), rev’d in part by *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

The Board has recognized the importance of honoring this goal and laid out factors to guide how courts exercise their discretion on whether to institute trial on a petition. *See NHK Spring Co. Ltd. v. Intri-Plex Techs. Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential); *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 5–16 (PTAB Mar. 20, 2020) (precedential). Applying the *Fintiv* factors (as further clarified in the Director’s Memorandum¹² dated June 21, 2022)

¹² Director Vidal’s Memorandum to Members of the Board re: Interim Procedure for Discretionary Denials in AIA Postgrant Proceedings with Parallel District Court Litigation (*available at* https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf) (hereinafter “Director’s Memorandum”).

establishes that the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution in this proceeding.

A. Factor 1: Likelihood of Stay

Petitioner has not moved for a stay in the district court proceeding. *See generally* Ex. 2003. Petitioner asserts its intention “to move to stay the district court action *as it pertains to the ’252 patent pending resolution of this IPR.*” Pet., 99 (emphasis added). It does not make any showing that its potential request is likely to be granted, especially where Petitioner’s anticipated stay request only addresses one of eight patents at issue in the district court. *See id.*; *see also Finjan, Inc. v. FireEye, Inc.*, No. 4:13-cv-03133, 2017 WL 1150283, at *3 (N.D. Cal. Mar. 28, 2017) (institution of IPR on only of only one out of seven asserted patents weighs against stay); *Finjan, Inc. v. Blue Coat Sys., Inc.*, No. 5:15-cv-03295, 2016 WL 7732542, at *4 (N.D. Cal. July 25, 2016) (institution of IPR on only three of ten asserted patents weighs against stay).

Should Petitioner request a stay of the district court proceeding, and should this Petition be instituted, it is unlikely the district court will grant the motion given the significant investment made by the district court, the proximity of trial, and the fact that seven additional patents are at issue in the district court litigation. Together, these facts make it likely that any motion to stay the district court litigation will be denied.

For these reasons, factor 1 weighs in favor of exercising discretion to deny the petition.

B. *Factor 2: Trial Date Relative to Final Written Decision Due Date*

Trial in the district court is scheduled to begin September 22, 2025. Ex. 2002. The Board’s deadline to reach a final written decision is likely to fall in November 2025—after the district court trial. *See* 35 U.S.C. §§ 314(b), 316(a)(11); 37 C.F.R. § 42.100(c). Accordingly, the present trial date is nearly two months before the Board would issue a final written decision in this proceeding. Further, Petitioner has offered no justification for its substantial delay in requesting IPR, especially where all of its asserted primary prior art references were the same or substantially the same as the prior art that was already publicly available and known to Petitioner when it first filed suits nine months before filing its Petition. This weighs in favor of exercising discretion to deny the Petition, especially because Petitioner has offered no justification for its substantial delay in requesting IPR. *See Fintiv*, IPR2020-00019, Paper 11 at 9.

C. *Factor 3: Investment in Trial Court Proceedings*

By the institution deadline, the parties will have invested substantial time and effort in the co-pending litigation (as shown below), and Petitioner’s lack of diligence is a contributing cause of this. Accordingly, factor 3 weighs heavily in favor of discretionary denial. This factor is evaluated based on the date of the

Board’s decision on institution—not the filing date of the Petition as Petitioner suggests. *See Verizon Bus. Network*, IPR2020-01292, Paper 13 at 14 (“[T]he appropriate time to evaluate the investment of the parties in the Parallel Proceeding is at the time of the institution decision and not at the time of the filing of the petition.”). Petitioner cites the incomplete claim construction process and close of fact discovery as reasons Petitioner contends this factor does not warrant denial (Pet., 99), but claim construction briefing will be complete before the Board is expected to make its institution decision in November 2024. Indeed, the Court will hold the claim construction hearing on September 24, 2024 and fact discovery closes in December 2024. Ex. 2002; Ex. 2003 at Dkt. 99.

The district court is, therefore, likely to issue a claim construction order before the deadline for the decision on institution, and Patent Owner will (if authorized) notify the Board when that order issues. The parties have exchanged multiple rounds of infringement and invalidity contentions, including Patent Owner’s Amended Infringement Contentions (served May 8, 2024), and Petitioner’s Amended Invalidity Contentions (served March 27, 2024). *See* Exs. 2004; 2003 at Dkt. 73; 2006. Fact discovery closes in about four months (on December 20, 2024) (Ex. 2002), the parties have already served extensive written discovery on the merits, including third-party discovery, and Petitioner has taken two party depositions. *See* Exs. 2007, 2008. The production of documents and ESI is already substantially

complete. *See* Ex. 2003, Dkt. 49. And the district court has already invested considerable time and resources in the litigation, including presiding over several discovery disputes. Ex. 2003, Dkts. 44, 49, 77, 86, 87.

This investment is similar to that in *10x Genomics, Inc. v. President and Fellows of Harvard College*, which the Board determined “weighs in favor of exercising our discretion to deny institution.” IPR2023-01299, Paper 15 at 17-18 (P.T.A.B. Aug. 30, 2023). In that case, like here, at the time of the institution decision, the district court had issued substantive orders related to the challenged patent, the parties had exchanged initial and supplemental infringement and invalidity contentions, the parties had completed claim construction briefing and held a claim construction hearing, the parties had substantially completed document production, and the court had resolved substantive discovery disputes. *Id.*

Further, like the petitioner in *10x Genomics, Inc.*, Petitioner in this proceeding did not diligently prepare and file its Petition after Patent Owner identified the asserted claims in the co-pending litigation. *Id.* On December 21, 2023, Patent Owner served its Disclosure of Asserted Claims and Infringement Contentions, in which it identified claims 5-7, 16-18, and 19 as the asserted claims of the ‘252 patent. Ex. 2004, 3. Petitioner served Invalidity Contentions listing Samartgis, Leoncavallo, and Miller among the prior art with its disclosures of January 22, 2024. Ex. 2005, 5. Petitioner continues to pursue the same prior art from this Petition in district court

as of July 18, 2024. Ex. 2006, 5. Petitioner waited to file its Petition challenging the same claims asserted based on prior art from its contentions until April 29, 2024—more than nine months after first filing suit, more than six months after learning of the asserted claims, and more than three months after serving its invalidity contentions. And Petitioner relies on the same or substantially the same prior art that was already before the Office during examination of the ‘252 patent and that it was already aware of when it first filed suit. Petitioner offers no explanation for this delay. Petitioner’s lack of diligence further increases this factor’s weight in favor of discretionary denial. *See Fintiv*, IPR2020-00019, Paper 11 at 11 (“If, however, the evidence shows that the petitioner did not file the petition expeditiously . . . or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.”).

For these reasons, factor 3 weighs heavily in favor of exercising discretion to deny the petition.

D. *Factor 4: Overlap of Issues*

This factor also favors discretionary denial because the same claims and prior art are at issue in the co-pending litigation. *See Fintiv*, IPR2020-00019, Paper 11 at 12 (explaining that “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” when the same claims, prior art, and arguments are at issue in both proceedings). As noted above, the same set of claims is

challenged in the Petition and asserted in the district court. Pet., 2–3; Ex. 2006, 2. And the same prior art asserted in the Petition is also listed in Petitioner’s invalidity contentions. *Id.*

Further, Petitioner does not agree to a *Sotera* stipulation, as suggested in the Director’s Guidance, to remove concerns with potentially conflicting decisions. Instead, Petitioner states: “[i]f the action is not stayed, Petition hereby stipulates not to argue in the action on invalidity of the ‘252 patent based on the grounds advanced in this petition or on any ground that relies on the references cited herein.” Pet., 100. However, in addition to the same references presented in the Petition, Petitioner also asserts in district court different prior references that have the same or similar concepts as the references asserted in the Petition. Ex. 2006, 2. Thus, although Petitioner’s stipulation is “somewhat broader than the stipulation in *Sand Revolution*, the concerns discussed in *Sand Revolution* remain” because, like here, “the relevant art appears to include multiple references that disclose the same basic concepts” and “the Petitioner could raise substantially the same arguments in district court using prior art references that did not ‘form [] the basis of any instituted ground.’” *Samsung Elec. Co., Ltd. v. Mojo Mobility Inc.*, No. IPR2023-01098, Paper 11 at 11-12 (P.T.A.B. Jun. 30, 2023) (finding this factor “weighs only slightly against discretionary denial” where the petitioner offered such a stipulation somewhat broader than *Sand Revolution* but less than *Sotera*).

Factor 4 is neutral in light of the complete overlap balanced against Petitioner’s stipulation, which is less than a full *Sotera* stipulation.

E. Factor 5: Same Parties

The parties in this IPR and the parties in the co-pending litigation are identical, so this factor weighs in favor of discretionary denial. *Sotera*, IPR2020-01019, Paper 12 at 19 (precedential); *Fintiv*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (informative). Petitioner does not dispute the weight of this factor, instead only arguing it “is not determinative.” Pet., 101. It may not warrant denial on its own, but it certainly weighs in favor of denial. *See Sotera*, IPR2020-01019, Paper 12 at 19 (precedential) (“[T]his factor supports denying institution.”); *Fintiv*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (informative) (“[T]his factor weighs in favor of discretionary denial.”).

Factor 5 weighs in favor of discretionary denial.

F. Factor 6: Other Considerations

Under Board precedent, the Board should only consider the compelling merits standard under factor 6 if the first five factors favor denial. *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4–5 (PTAB February 27, 2023) (precedential). Here, factors 1–3 and 5 all weigh in favor (some heavily) of exercising discretion to deny institution, and factor 4 is neutral. Thus, because

consideration of the first five factors favors denial, the Board should consider the compelling merits standard under factor 6 here.

The compelling merits standard is met when “the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Director’s Memorandum at 4 (underline added). A challenge can only meet this standard “if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.” *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (PTAB Oct. 4, 2022) (precedential). The Petition presents no compelling merits that weigh against discretionary denial. For the reasons explained above, the merits of the Petition’s grounds are weak and independently warrant denying institution. Because the evidence does not even meet the “reasonable likelihood” threshold for institution, it certainly does not meet the even higher “highly likely” threshold or “plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.”

While this factor is primarily interested in the strength of the evidence on the merits, the Board has also used it to consider issues of fairness and equity not encompassed by other factors. *See Fintiv*, IPR2020-00019, Paper 11 at 14–15. Here, not only are the Petition’s grounds too weak to establish a high likelihood of

prevailing, they are also based on prior art that is the same or substantially the same as the art that was already before the Office.

Therefore, consideration of the compelling merits factor weighs strongly in favor of discretionary denial.

G. Combined Factors

When combined, the *Fintiv* factors strongly favor discretionary denial under § 314(a). Factors 1–3, 5 and 6 all weigh in favor (some heavily) of exercising discretion to deny institution, and factor 4 is neutral. Viewing the factors holistically, discretionary denial is the outcome that best serves the “efficiency and integrity of the system.” Far from being the *alternative* to district court litigation that Congress envisioned, Petitioner has turned this proceeding into a bonus round. Patent Owner and the Board will pay the cost.

The facts bear this out. Petitioner offers no justification for its lengthy delay in filing its Petition, even after relying on prior art that is the same as or substantially the same as prior art that was cited during prosecution and known to Petitioner when filing its lawsuit nine months before filing its Petition and even after preparing invalidity contentions in the co-pending litigation relying on the same art asserted in this Petition many months before it was filed. Because of this delay, the co-pending litigation advanced so far that even claim construction will be done by the institution deadline and fact discovery will close one month later. The parties will have borne

all the expense of fact discovery and related depositions. Trial, including on invalidity, is all but certain to happen before the Board issues a final written decision in this case. That trial will involve the claims challenged in this case, and Petitioner will not be subject to estoppel under § 315(e) and may try to assert art and grounds similar to those raised in the Petition, even if based on slightly different art. Even if trial ends in a judgment for Patent Owner, Petitioner would still have the option to maintain this proceeding as a second bite at the apple.

Hence, whether by design or unintentional delay, the timing of the Petition gives Petitioner two chances to litigate invalidity and obtain its preferred outcome. This does not serve the efficiency of the system, which already expends considerable public resources to litigate invalidity once. In addition, the possibility of inconsistent results compromises the patent system's integrity. This is the archetypal case that justifies discretionary denial under § 314(a), and the Board should deny institution at least on that basis.

IX. CONCLUSION

For at least the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition.

Dated: August 13, 2024

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE, according to the word-processing system used to prepare the paper and not including those parts excluded by § 42.24(a)(1), has 12,686 words, which is within the type-volume limit set by § 42.24.

By: /Ryan J. Schletzbaum/
Ryan J. Schletzbaum
Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on August 13, 2024, a complete and entire copy of the foregoing Patent Owner's Preliminary Response and Exhibits 2001-2008 were provided via email to Petitioner's counsel of record as follows:

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