

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MPL BRANDS NV, INC.
Petitioner

v.

BUZZBALLZ, LLC,
Patent Owner

IPR2024-01000

U.S. Patent 11,932,441

PATENT OWNER'S PRELIMINARY RESPONSE

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I. INTRODUCTION

Patent Owner, BuzzBallz, LLC, submits this Preliminary Response under 35 U.S.C. § 313 and 37 C.F.R. § 42.107 in response to the Petition for *Inter Partes* Review (“Petition”) challenging claims 1-20 of U.S. Patent No. 11,932,441 (“the ’441 Patent”) (EX1001).

Petitioner also filed a Petition for Post Grant Review (“PGR Petition”) challenging the same claims of the ’441 Patent. However, as set forth more fully in the Patent Owner Preliminary Response submitted concurrently in PGR2024-00035, the ’441 Patent is a pre-AIA patent, not subject to the first-inventor-to-file provisions of the AIA. As a result, the ’441 Patent is not eligible for PGR. Therefore, the Board should deny institution of the PGR.

The Board should also deny institution of this IPR under 35 U.S.C. § 314(a) because Petitioner has not shown a reasonable likelihood of prevailing with respect to any of the challenged claims. The Petition sets forth two grounds, each challenging claims 1-20 of the ’441 Patent. Both grounds are insufficient to establish a reasonable likelihood of prevailing.

Ground 1 is deficient for at least three reasons. First, Petitioner’s proposed combination for Ground 1 takes contradictory positions with respect to the lid limitations. On the one hand, the Petition alleges that the combination requires using “Kaminski’s alternate lid ... with Metzger’s container.” Pet., 13; *see also* 21 (“A

POSITA would have been motivated to use Kaminski's lid with Metzger's container"). On the other hand, the Petition relies *solely* upon Metzger's lid—not Kaminski's lid that is required by Petitioner's proposed combination—to address some of the lid-related claim limitations of independent claims 1 and 15 (e.g., [1.D], [15.D]). Pet., 22, 79. As a result, the Petition necessarily fails to show with particularity how *Petitioner's proposed combination* for Ground 1 teaches all the limitations of any of the challenged claims.

Second, Petitioner's Ground 1 requires combining multiple embodiments of Metzger but the Petition is silent as to any reason *why* it would have been obvious to combine the different embodiments in the manner required by Petitioner's proposed combination. Without such an explanation, the Petition's analysis critically lacks what would have led a POSITA—absent improper hindsight, using the claims of the '441 Patent as a roadmap—to make the proposed combination. *See Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996) ("The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made.'").

Third, Petitioner's Ground 1 requires modifying Metzger's base to use a resized, smaller base from Protais but fails to provide *any reason why* a POSITA would have been motivated to change the size of the base as required by Petitioner's

combination. Accordingly, Petitioner has necessarily failed to meet its burden.

Dynamic Drinkware, LLC v. Nat'l Graphics, Inc., 800 F.3d 1375, 1378 (Fed. Cir. 2015) (burden of showing of unpatentability “never shifts to the patentee”).

Ground 2 is likewise deficient for multiple reasons. Again, Petitioner provides no reason to combine disparate embodiments of Gardiner. In addition, Petitioner fails to identify disclosure in the cited references that meets each claim limitation of the '441 Patent, including the particular structural arrangements required by claim elements [1.N] and [1.P].

Because both Ground 1 and Ground 2 are deficient, Petitioner has not shown a reasonable likelihood of prevailing with respect to any claim challenged in the Petition. Therefore, institution should be denied.

II. THE '441 PATENT

A. Overview and Prosecution History

The '441 Patent claims a novel and non-obvious container. EX1001, 4:7-9:19. The claims of the '441 Patent require a container having a very specific combination of structural features, with the components of the container being formed of a particular combination of materials. *Id.* It was this combination of features and materials—defining the invention as a whole—the Examiner determined “[n]one of the prior art of record is seen to disclose or suggest.” EX1004, 220. For example, the Examiner explained in the Notice of Allowance that “the closest reference found”

failed to teach numerous aspects of both independent claim 1 and independent claim 15, including “wherein the container body is made out of a resin,” “wherein the resin is a polyethylene terephthalate (PET) resin,” “wherein the lid is made out of a metal,” and numerous of the specific structural features and arrangements recited. *Id.*, 218-225.

Zimmer does not teach wherein the container body is made out of a resin;

wherein the lid is made out of a metal; wherein the first portion of the lid defines a first circular shape; wherein the first portion of the lid further defines a second circular shape around which the first circular shape circumferentially extends; wherein the second circular shape defined by the first portion of the lid is concentric with the first circular shape defined by the first portion of the lid; wherein the first circular shape defined by the first portion of the lid is radially positioned between the container side wall and the second circular shape defined by the first portion of the lid; wherein a second portion of the lid extends horizontally and is positioned so that the second circular shape is radially positioned between the second portion of the lid and the first circular shape; wherein the second portion of the lid defines a total area across which the second portion of the lid extends horizontally; wherein the second portion of the lid comprises a weakened or scored area; wherein the weakened or scored area is less than the total area across which the second portion of the lid extends horizontally; wherein the lid further comprises an arm connected to the second portion of the lid and radially positioned within the second circular shape; wherein the arm comprises opposing first and second end portions; wherein the arm is pivotable from a first position, in which the arm extends horizontally and the weakened or scored area is not deformed, to a second position, in

which the arm does not extend horizontally and the weakened or scored area is deformed to provide a second opening to the interior of the container body; wherein, when the arm of the lid is in the first position and the weakened or scored area is not deformed: the first end portion of the arm is not positioned above the weakened or scored area of the second portion of the lid; and at least a portion of the second end portion of the arm is positioned above the weakened or scored area of the second portion of the lid; wherein the interior of the container body extends continuously across the cross-sectional diameter of the middle portion at a height midway between the circular neck and the base portion so as to be interrupted, if at all, only by the liquid contained within the container body; wherein the metal is aluminum; wherein the resin is a polyethylene terephthalate (PET) resin; wherein the first depression is visible through at least a portion of the container body; wherein the center element of the base portion is a downward extending protrusion; wherein the base portion further comprises a second depression adjacent the first depression; and wherein the second depression is visible through the at least a portion of the container body.

EX1004, 223-224.

Petitioner's proposed grounds set forth in the Petition likewise fail to disclose or suggest the specific combination of features required by the claims of the '441 Patent.

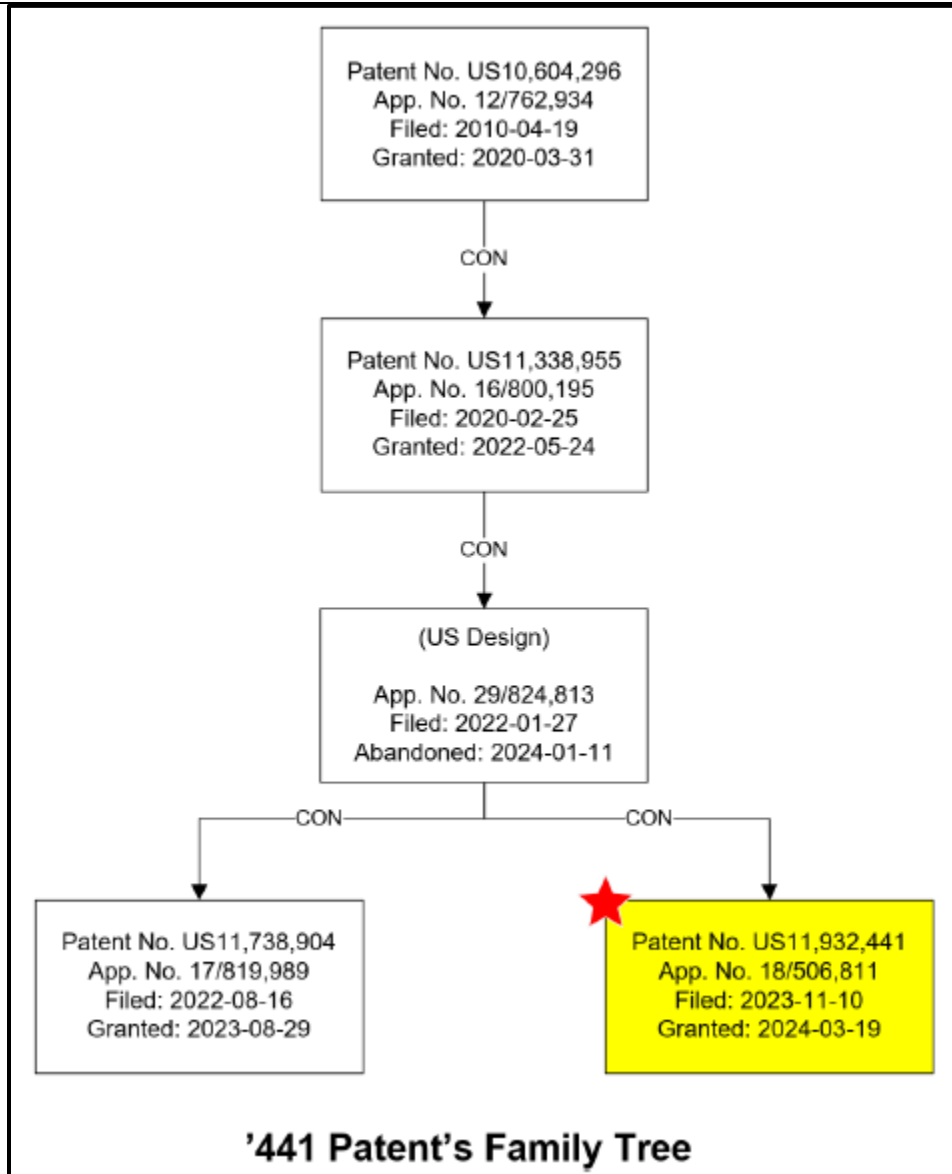
B. Priority of the '441 Patent

All the claims of the '441 Patent are entitled to a priority date of April 19, 2010.

The '441 Patent is a continuation of U.S. Design Patent Application No. 29/824,813 ('813 Application) filed on January 27, 2022, which is a continuation of U.S. Patent No. 11,338,955 ('955 Patent) filed on February 25, 2020, which is a continuation of U.S. Patent No. 10,604,296 ('296 Patent) filed on April 19, 2010.

EX1001, Cover Page. All the claims of the '441 Patent are fully supported by the original disclosure of the '296 Patent and continuity was maintained through the '955 Patent and the '813 Application. Therefore, all the claims are entitled to a priority date of April 19, 2010.

The Petition asserts that “[a]s explained in Section IV, claims 9, 10, 15 (and its dependents, including claim 16) have a priority date of November 10, 2023.” Pet., 9. However, there is no mention of any of claims 9, 10, 15, or 16 in Section IV. *See* Pet., 4-5. In fact, there is no discussion or explanation anywhere in the Petition as to why *any* claim of the '441 Patent would not be entitled to the April 19, 2010 priority date. To the contrary, Section IV of the Petition (1) sets forth the family tree clearly linking the '441 Patent back to the April 19, 2010 filing date of the '296 Patent, (2) acknowledges that the '441 Patent was “examined under the pre-AIA first to invent provisions,” and (3) explains that the Petition was filed in case the Board properly “concludes that the '441 patent is subject to pre-AIA provisions.” Pet., 4-5.



Petition, 4.

III. PERSON OF ORDINARY SKILL IN THE ART

For purposes of this Preliminary Response only, Patent Owner applies Petitioner's proposed level of ordinary skill in the art: "a person having, as of either the alleged April 2010 priority date or the '441 patent's November 2023 filing date:

(i) an associate's or bachelor's degree in mechanical, industrial or manufacturing

engineering and (ii) at least two to three years of practical experience with designing or manufacturing mechanical products such as food or beverage packaging. A POSITA could substitute additional education for industry experience and vice versa.” Pet., 10.

IV. CLAIM CONSTRUCTION

For purposes of this Preliminary Response only, Patent Owner agrees that claim construction is unnecessary as no claim terms require construction for the Board to resolve the present controversy at this preliminary stage. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only terms in controversy need to be expressly construed, and only to the extent necessary to resolve controversy); *Shenzhen Liown Elects. Co. v. Disney Enters., Inc.*, IPR2015-01656, Papers 7, 10 (Feb. 8, 2016). To the extent necessary, Patent Owner reserves the right to address claim construction at a later stage in this proceeding or in other proceedings.

V. PETITIONER HAS NOT SHOWN A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY OF THE CHALLENGED CLAIMS

The Board should deny institution because Petitioner has not shown a reasonable likelihood of prevailing with respect to any claim challenged in the Petition. *See* 35 U.S.C. § 314(a) (the Board “may not authorize an inter partes review to be instituted unless...the information presented in the petition...shows that there

is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”). “In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring IPR petitions to identify “with particularity...the evidence that supports the grounds for the challenge to each claim.”)). This burden of persuasion never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in an IPR).

The Petition sets forth two grounds, each challenging claims 1-20 of the ’441 Patent: Ground 1 based on Metzger, Protais, and Kaminski (Pet., 10-92) and Ground 2 based on Gardiner, Pedmo, and Brown (Pet., 92-190). Ground 1 is deficient for multiple reasons. For example, as noted above, Petitioner’s proposed combination for Ground 1 takes contradictory positions with respect to the lid limitations. On the one hand, the Petition alleges that the combination requires using “Kaminski’s alternate lid ... with Metzger’s container.” Pet., 13; *see also* 21 (“A POSITA would have been motivated to use Kaminski’s lid with Metzger’s container”). On the other hand, the Petition relies *solely* upon Metzger’s lid—not Kaminski’s lid that is required by Petitioner’s proposed combination—to address some of the lid-related claim limitations of independent claims 1 and 15 (*see, e.g.,* [1.D], [15.D]). As a

result, the Petition necessarily fails to show with particularity how *Petitioner's proposed combination* for Ground 1 teaches the limitations of the challenged claims.

As another example, Petitioner's proposed combination in Ground 1 requires combining multiple embodiments of Metzger. However, the Petition is completely silent as to any reason why it would have been obvious to combine the different embodiments in the particular manner required by Petitioner's proposed combination. The Petition also fails to provide a reason for combining Metzger's container with a resized, smaller version of Protais' base to meet the requirements of limitation [1.N].

Without such explanations, the Petition's analysis critically lacks what would have led a POSITA—absent improper hindsight use of the claims of the '441 Patent as a roadmap—to make the proposed combinations. *See Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996) (stating “[t]he invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made.”).

Ground 2 is likewise deficient. Like Ground 1, Petitioner's proposed combination requires combining multiple embodiments of Gardiner. But again, the Petition is silent as to any reason why it would have been obvious to combine the different embodiments in the particular manner required by Petitioner's proposed combination. The Petition also does not identify adequate prior art disclosures that

correspond to “a circular neck” or “a lip” as required by both independent claim 1 and independent claim 15. *See* 37 C.F.R. § 42.104(b)(4) (“The petition must specify where **each element** of the claim is found in the prior art patents or printed publications relied upon.”).

Because both Ground 1 and Ground 2 are deficient, institution should be denied.

A. Ground 1 is deficient.

1. The Petition fails to provide sufficient reason to combine the different embodiments of Metzger required by Petitioner's proposed combination.

Limitation [1.C] recites a “body” that is “made out of a resin.” EX1001, 4:12. Limitation [1.D] recites a “lid” that is “made out of a metal.” EX1001, 4:13.

Petitioner relies on Metzger alone to show limitations [1.C] and [1.D]. *See* Pet., 22. According to Petitioner, “Metzger's container was made of ‘various plastics,’” Pet., 22 (quoting EX1010, 3:56-58), and Metzger's lid was “made of ‘metals, such as steel or aluminum,’” Pet., 22 (quoting EX1010, 3:49-50). Metzger's actual disclosure, however, does not support Petitioner's position. In reality, Metzger's container is preferably made of metal. *See* EX1010, 2:35-48 (a “metal sidewall”), 2:49-3:4 (a “metal body”), 7:34-36 (“According to an exemplary embodiment, container 1 is formed of metal about 0.0095 inches thick and is primarily made of tin-plated steel.”), 12:43-13:5 (claim 1) (a “metal body”), 13:20-

21 (claim 6) (“the metal body”), 13:22-26 (claim 7) (“the metal body”), 13:33-34 (claim 11) (“the container end is made of metal”), 13:35-14:44 (claims 12 and 13) (a “metal food can”).

Petitioner's argument relies entirely on generic phrases from the specification that say, in full, “the container may be formed from any material, including metals, various plastics, and glass” and the “container end may be made of metals, such as steel or aluminum, metal foil, plastics, composites, or combinations of these materials.” EX1010, 3:49-51, 3:57-58. Guided by the claims of the '441 Patent, Petitioner selects a container made of “plastic” from the first list and combines it with a lid made of metal from the second. *See* Pet., 22. However, Metzger never discloses this particular combination and Petitioner has not identified any reasons—other than the claims of the '441 Patent—that would motivate a POSITA to attempt such a combination.

That the different embodiments of a plastic container and a metal lid come from the same Metzger reference does not relieve Petitioner of its duty to provide a reason that a POSITA would have made this particular selection of the many options provided. In *In re Stepan Company*, the Federal Circuit rejected the argument that a patent challenger “need not establish a reasonable expectation of success where there is a single prior art reference.” 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017). The court explained that even when “combining multiple embodiments from a single

reference, ...there must be a motivation to make the combination.” *Id.*

Similarly, in multiple cases, the Board has denied institution of IPRs when petitioners have proposed combining different embodiments of a single prior art reference without articulating a sufficient motivation to combine. For example, in *Abiomed, Inc. v. Maquet Cardiovascular, LLC*, the petitioner “failed to provide a sufficient rationale to combine the teachings of [a single prior art reference]’s different embodiments.” IPR2017-01204, Paper 9 at 11 (PTAB Oct. 23, 2017). The Board was “unpersuaded that the features of [the prior art reference]’s various embodiments [were] interchangeable or that one skilled in the art would have combined those features in the manner proposed by Petitioner.” *Id.*; *see also Apple Inc. v. Arigna Tech. Ltd.*, IPR2022-01037, Paper 9 at 20 (PTAB Dec. 2, 2022) (“Petitioner has not described a motivation to combine the different embodiments of” a single prior art reference.); *Microsoft Corp. v. Virtru Corp.*, IPR2023-00018, Paper 12 at 14-15 (PTAB May 17, 2023) (agreeing that “Petitioner ‘fails to provide a motivation to combine these two embodiments of” of a single reference); *Markforged Inc. v. Continuous Composites, Inc.*, IPR2022-01431, Paper 7 at 12-14 (PTAB Jan. 18 2023) (“Petitioner’s reliance on multiple embodiments in [a single prior art reference] falls short” because “Petitioner has not sufficiently explained why the ordinarily skilled artisan would have combined the” different embodiments.).

Petitioner has not met this requirement. While Petitioner has proposed some reasons why a POSITA would have combined Metzger's container with Protais's base, Pet., 14 ("increase the strength"), and why a POSITA would have combined Metzger's container with Kaminski's lid, Pet., 15 ("ecological and safety reasons"), Petitioner has not provided any motivation for its proposed combination of unrelated embodiments in Metzger alone—the selection of a plastic container and a metal lid. This combination is purely dictated by the claims of the '441 Patent. Using the claims as a roadmap is improper. *See ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998) ("Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."). Accordingly, for at least this reason, Petitioner has failed to meet its burden for Ground 1 and institution should be denied.

2. The Petition's contradictory positions with respect to the lid-related limitations fail to show with particularity how the proposed combination teaches all limitations of the challenged claims.

Compounding the shortcomings of the Petition described above, Petitioner's mapping of the prior art to the limitations reciting the lid are inconsistent with Petitioner's proposed combination. While the Petition relied on Metzger alone to show a metal lid and a resin body for limitations [1.C] and [1.D] (providing no reason for this particular combination, as explained above), Petitioner's proposed combination requires using *Kaminski's* lid, not Metzger's. *See* Pet., 20-21

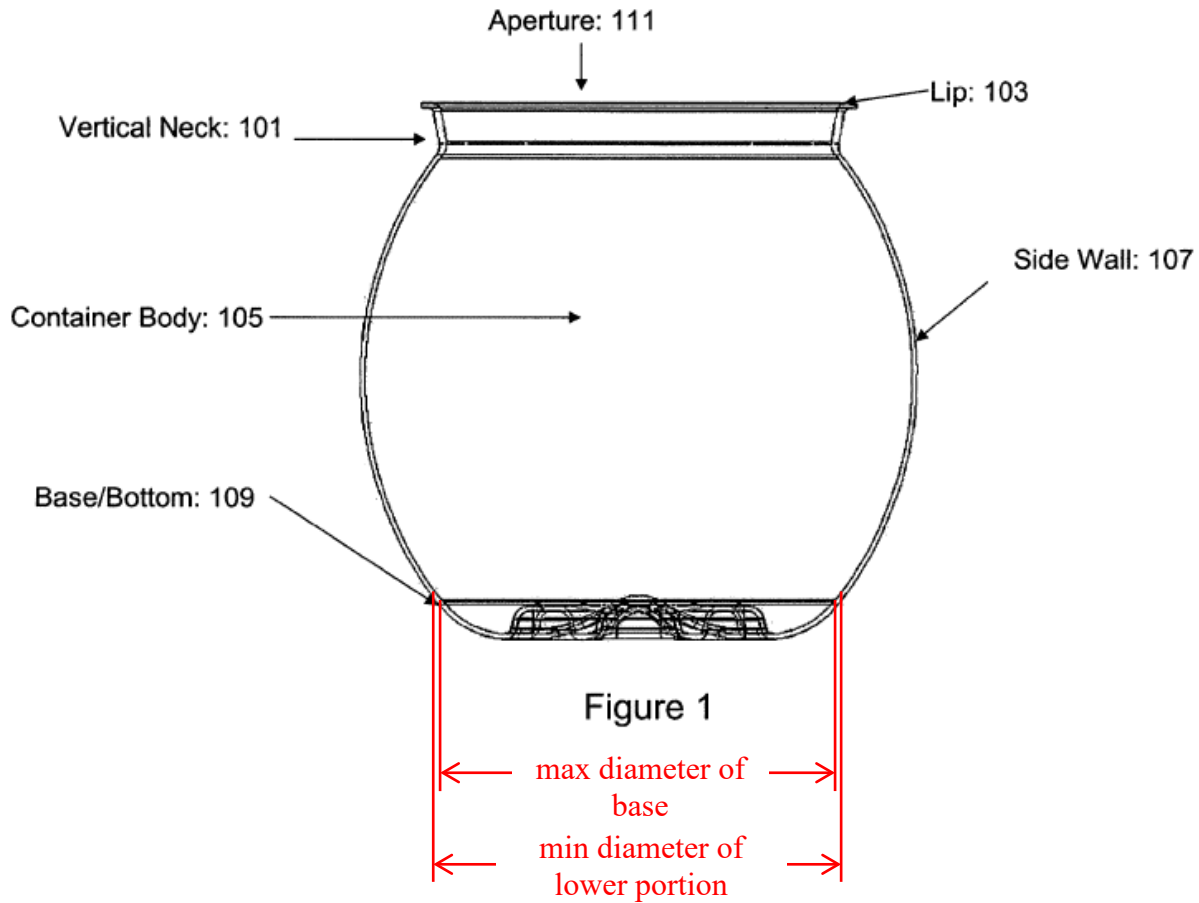
(limitation [1.B]), 44-57 (limitations [1.R]-[1.AC]), 60-62 (limitations [1.AF]-[1.AG]), 79 (limitation [15.B]), 82-85 (limitations [15.R]-[15.AC], [15.AF]-[15.AG]).

An IPR petition must identify “with particularity...the evidence that supports *the grounds for the challenge* to each claim.” 35 U.S.C. § 312(a)(3). Here, Petitioner’s *grounds for the challenge* under Ground 1 are clear: use Kaminski’s lid with Metzger’s container body. Pet., 21 (“A POSITA would have been motivated to use Kaminski’s lid with Metzger’s container”); *see also* 13 (“Kaminski’s alternate lid could be used with Metzger’s container”). However, Petitioner has failed to show with particularity how *Petitioner’s proposed combination* meets all the limitations of the independent claims. Therefore, for this additional reason, Petitioner has failed to meet its burden for Ground 1 and institution should be denied.

3. The Petition fails to provide sufficient reason to combine Protais’ base with Metzger’s container in the arrangement required by the claims.

Limitation [1.M] requires that “a lower portion of the container side wall extends downwardly from the middle portion of the container side wall to the base portion of the container body, the lower portion along its entirety being greater in diameter along its entirety than the base portion, including the bottom, thereby rendering the container body stemless.” EX1001, 4:38-43 (claim 1). This feature is illustrated in Figure 1 of the ’441 Patent, below.

Container Shape



EX1001, Fig. 1 (annotated)

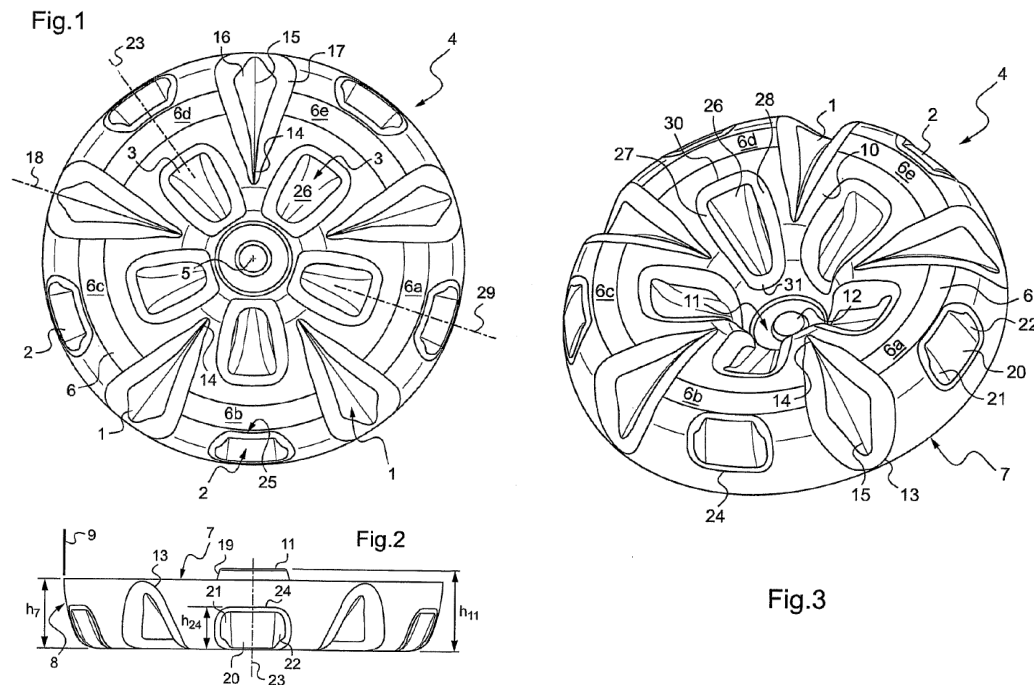
As shown above, at every point “along its entirety,” the diameter of the lower portion of the container body is “greater in diameter than the base portion, including the bottom.”

The Metzger container, on the other hand, does not include these features. Like many standard drink cans, the Metzger container includes a metal base 30 “including folds of metal joining a bottom lip or flange of sidewall 20 and bottom

Because Metzger's base is wider than the lower portion of the can, it provides added stability for the can, given its relatively tall shape. But because the diameter of Metzger's base is greater than a diameter of the lower portion, Metzger alone does

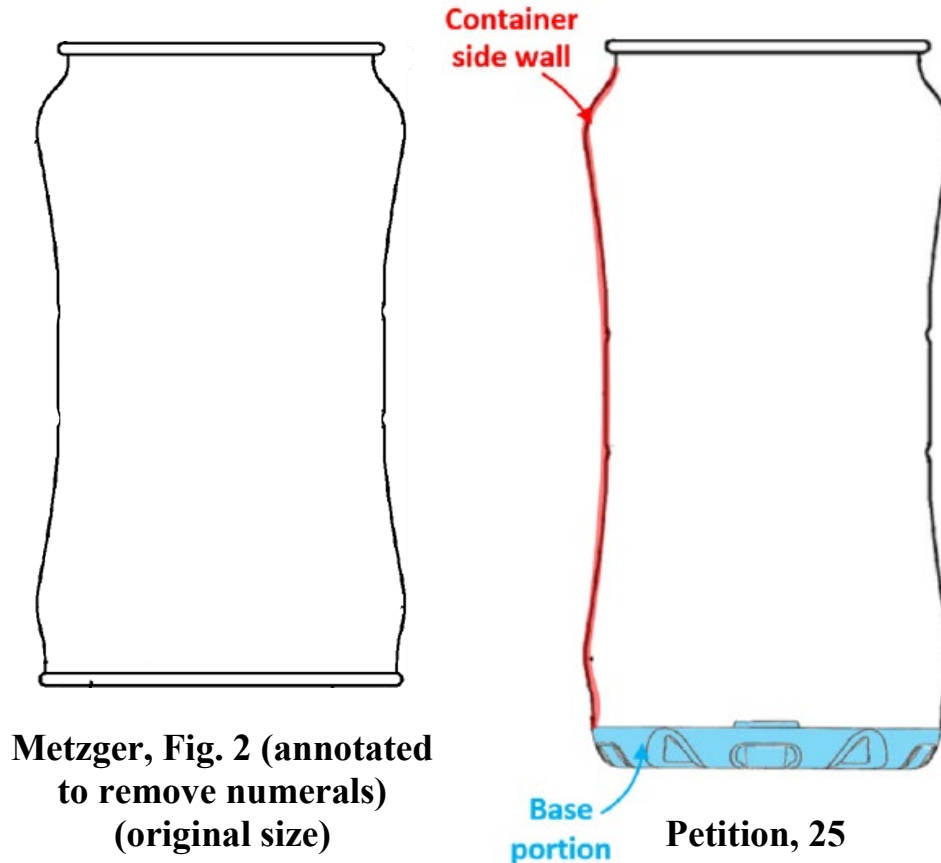
not disclose limitation [1.M].

Petitioner's proposed combination utilized Metzger's container with the Protais base. *See* Pet., 37-40. But Protais does not remedy Metzger's deficiencies regarding [1.M]. Far from disclosing a container body that is "greater in diameter than the base portion," Protais does not disclose any container body at all—only a standalone container base, shown in all three figures of Protais below.



EX1008, Figs. 1-3

So, Petitioner produced its own figure which stretches Metzger's container lengthwise and attaches the Protais base to the bottom in a manner that allegedly results in meeting the requirements of [1.M].



But Petitioner never identifies any reason to modify the base of the Metzger's container so the "lower portion" of the container body is "greater in diameter than the base portion," as claimed. The only reason Petitioner provides for combining the Metzger container with the Protais base is for "increase[d]...strength and resistance to deformation" provided by Protais' "ribs, notches, and grooves." Pet., 14. The Petition proposed combining the Metzger container with the Protais base to meet multiple claim limitations, including, for example, (1) to show depressions in the container base, Pet., 25-32 (Limitations [1.F]-[1.J]) and (2) the relative diameter elements described above, Pet. 37-40 (Limitation [1.M]). However, Petitioner's

motivation to analysis applies only to the first aspect. Petitioner's motivation to combine rationale has nothing to do with its second proposed combination of Metzger and Protais, including resizing a diameter of the base to be less than the diameter of the lower portion.

Petitioners "must articulate a *reason why* a PHOSITA would combine the prior art references." *In re Nuvasive, Inc.*, 842 F.3d 1376, 1382 (Fed. Cir. 2016) (emphasis in original). "Identifying a motivation to combine the prior art is important because 'inventions in most, if not all, instances rely on building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.'" *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1357 (Fed. Cir. 2019) (quoting *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–19, (2007)). Petitioner has not met this standard.

In short, Petitioner has not shown *why* a POSITA would have been motivated to modify Metzger's base to use a resized, smaller base from Protais as Petitioner's combination requires. Accordingly, Petitioner has failed to meet its burden for Ground 1 and institution should be denied.

B. Ground 2 is deficient.

- 1. The Petition fails to provide sufficient reason to combine the different embodiments of Gardiner required by Petitioner's proposed combination.**

Ground 2 of the Petition fails for similar reasons described above at Ground

1. As explained above, claim 1 recites a “body...made out of a resin” and a “lid...made out of a metal.” EX1001, 4:12-13 (limitations [1.C] and [1.D]).

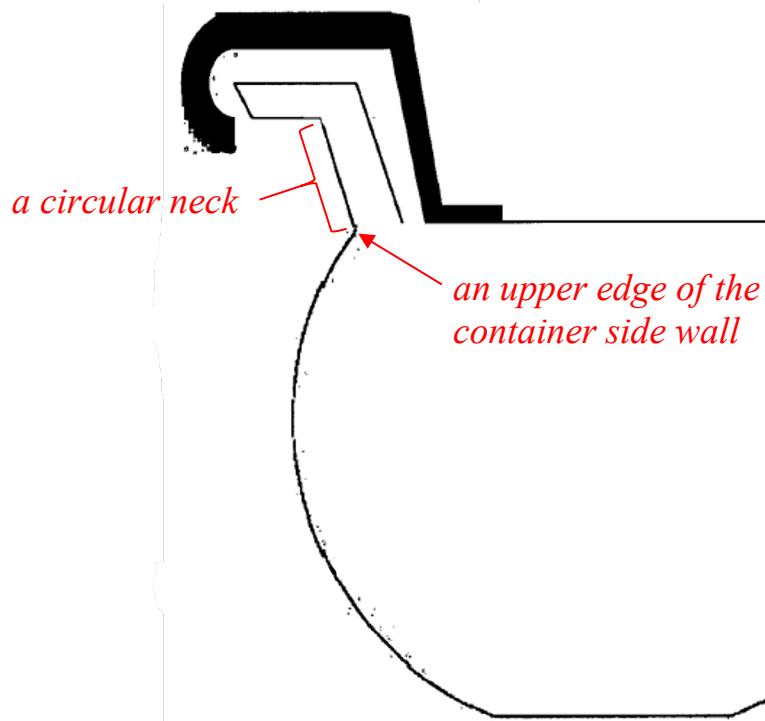
As in Ground 1, Petitioner relies on a single reference, Gardiner, for limitations [1.C] and [1.D] in Ground 2. *See* Pet., 103-104. According to Petitioner, “Gardiner’s container ‘can be made of any suitable material’ including plastic.” Pet., 103 (quoting EX1012, 2:22-23, 4:30-31). Petitioner also explains that “Gardiner’s cap member (lid) was made from aluminum.” Pet., 104, (citing EX1012, 7:30, 2:22-23). Here again, Gardiner’s actual disclosures do not support Petitioner’s position. Like Metzger’s metal container, Gardiner’s container is a standard aluminum beverage can. *See, e.g.*, EX1012, 1:25-27 (“aluminium alloy drink cans”), 4:27-31 (“aluminium alloy beverage can”), 6:18-21 (“industrial standard B64 alloy beverage can”). Like Metzger, Gardiner provides a list of materials for the beverage container, including “[a]luminium, aluminium alloy, steel and plastic.” EX1012, 2:22-24. Like Metzger, Gardiner does not identify the specific combination of materials claimed by the ’441 Patent, a “body...made out of a resin” and a “lid...made out of a metal.” EX1001, 4:12-13. Rather, the only specific variation to the standard aluminum cans described throughout is an example in which “the body member can be made of steel and the cap member made of plastic.” EX1012, 2:26-27.

As in Ground 1, Petitioner has not provided any motivation for its proposed selection of a plastic container and a metal lid. *See Stepan*, 868 F.3d at 1346

(“combining multiple embodiments from a single reference” requires “a motivation to make the combination.”). Like Ground 1, Petitioner’s motivation to combine arguments are limited to the combination of Gardiner with Pedmo and Brown, *see* Pet., 96-98, but does address why a POSITA would have combined the disparate embodiments of Gardiner. The combination of a plastic container and a metal lid is purely dictated by the claims of the ’441 Patent. This form of using the claims as a roadmap is improper. *See ATD Corp. v. Lydall, Inc.*, 159 F.3d 534,546 (Fed. Cir. 1998) (“Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.”). Accordingly, for at least this reason, Petitioner has failed to meet its burden for Ground 2 and institution should be denied.

2. Petitioner’s proposed combination in Ground 2 fails to teach “the container body further comprises a circular neck” as required by [1.N].

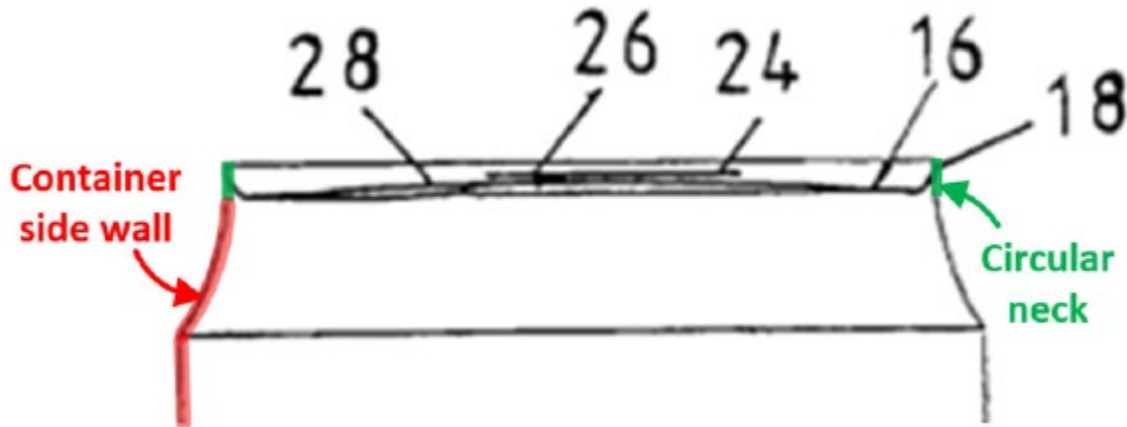
Claim limitations [1.N]-[1.R] recite various features of the upper region of the claimed container. Specifically, limitation [1.N] recites “the container body further comprises a circular neck.” This circular neck “extend[s] from the container side wall” (limitation [1.N]) and is “adjacent to” the “upper edge of the container side wall” (limitation [1.O]). Examples of these claim features are illustrated in Figure 5 of the ’441 Patent, shown below with annotations.



EX1001, Fig. 5 (annotated)

The Petition has not identified these features in the prior art. In particular, what Petitioner identifies as “a circular neck” of “the container body” for limitation [1.N] is not a part of the container body in Gardiner.

At limitation [1.N], Petitioner identifies the “rim 18” as the claimed “circular neck” of the container body. *See* Pet., 125.



Petition, 125

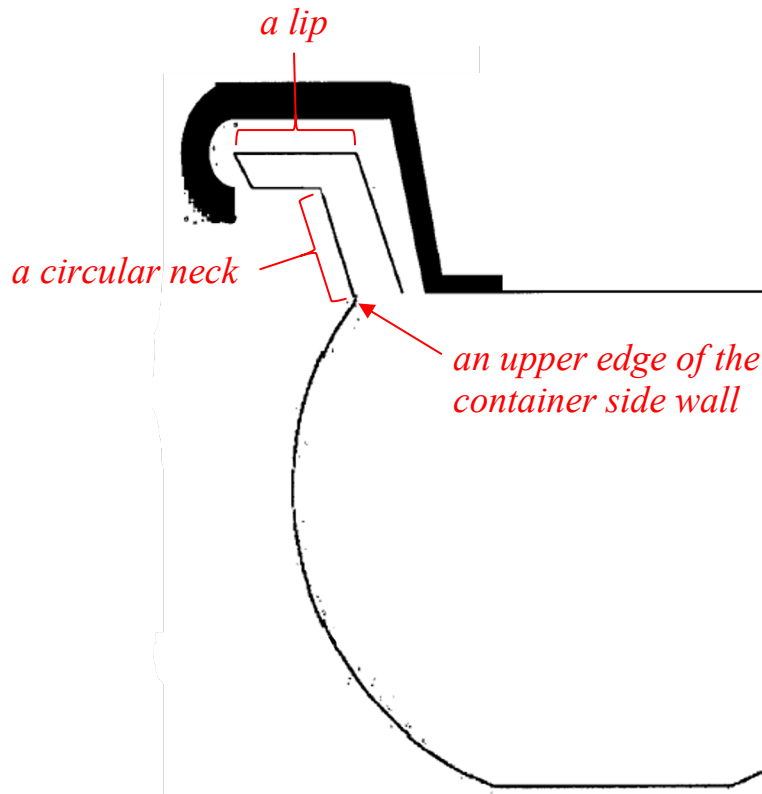
But Gardiner's rim 18—what Petitioner points to as the “circular neck”—is not part of Gardiner's container body. Gardiner explains that the rim 18 is formed by positioning the peripheral 140 *of the cap member 100* around the open end of a can and seaming the cap to the container walls. EX1012, 5:42-46. This process of forming the rim 18 with the cap member 100 is described in detail. Specifically, Gardiner explains that “[t]he cap member is sealingly fixed to the body member...*forming a rim.*” EX1012, 1:64-67. “The cap member 100 has a cap body 120 with a peripheral 140 which is shaped to be positioned...over an open end of a can body and seamed thereat to join to the can body *for forming a rim of the can.*” EX1012, 5:42-46. In fact, the abstract equates the rim 18 to the peripheral 140 of the cap member 100. EX1012, Abstract (“rim (18) or rim forming portion (140)”). Therefore, what Petitioner has mapped as the circular neck *of the container* (the rim 18) is actually the peripheral 140 *of the cap member 100* after it has been sealed to

the top of the can.

Accordingly, the component Petitioner has identified as being the claimed circular neck—the rim 18—is not a part of the container body, but a part of the cap member 100. The Petition fails to identify any prior art disclosure that renders obvious “the container body further comprises a circular neck” of limitation [1.N]. Therefore, for this additional reason, Petitioner has failed to meet its burden for Ground 2 and institution should be denied.

3. Petitioner's proposed combination in Ground 2 fails to teach “a lip” as required by [1.P].

Compounding the shortcomings regarding limitation [1.N] above, the Petition also fails to describe “a lip” as required by limitation [1.P]. The claimed lip is required to be positioned “at the end of the circular neck opposite the edge of the container side wall,” as illustrated below. EX1001, 4:50-52 (Limitation [1.P]).



EX1001, Fig. 5 (annotated)

Like the circular neck, the claimed “lip” is also a part of the *container body*, not the lid. At limitation [1.P], addressing the claimed “lip,” Petitioner refers to a “reciprocal shape” that is neither described nor illustrated anywhere in Gardiner. Pet., 128. Petitioner points to Gardiner’s “cap member” shown in Figures 10 and 13 as the alleged disclosure of a “reciprocal shape” lip. EX1012, 3:56-58; Pet., 127-129.

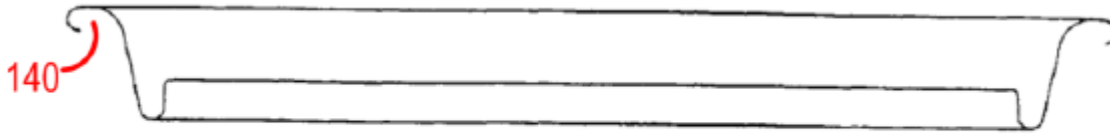


FIG. 13

Petition, 128

However, there is no such reciprocal shape. As explained above regarding the circular neck of limitation [1.N], the rim 18 is formed by seaming the peripheral 140 around “*an open end* of a can body.” EX1012, 5:42-46. There is simply no disclosure or suggestion of any lip on the open end of the can body in Gardiner.

A “petition must specify where **each element** of the claim is found in the prior art.” 37 C.F.R. § 42.104(b)(4). The Petition has not identified any prior art disclosure corresponding to a “lip ... at the end of the circular neck opposite the edge of the container side wall,” as required by independent claims 1 and 15. Accordingly, Petitioner has not met its burden and institution should be denied for this additional reason.

VI. CONCLUSION

The Board should deny institution of the Petition for the reasons presented above.

Respectfully submitted,

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VII. CERTIFICATE OF WORD COUNT

Under 37 C.F.R. § 42.24(b)(1), the undersigned attorney for the Patent Owner declares that the argument section of this Patent Owner's Preliminary Response (Sections I-VI) has 4,712 words, according to the word count tool in Microsoft Word™.

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§ Patent Owner's Preliminary Response
§
§ U.S. Patent No. 11,932,441
§

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