

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MPL BRANDS NV, INC.,
Petitioner,

v.

BUZZBALLZ, LLC,
Patent Owner.

IPR2024-01098
Patent 11,738,904 B2

Before KEN B. BARRETT, ERIC C. JESCHKE, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

HARDMAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner MPL Brands NV, Inc. requests an *inter partes* review of claims 1–6 of U.S. Patent No. 11,738,904 B2 (“the ’904 patent,” Ex. 1001). Paper 1 (“Pet.”), 1, 4. Patent Owner BuzzBallz, LLC filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” After considering the briefing and cited evidence of record in view of this standard, we institute an *inter partes* review.

The following preliminary findings of fact and conclusions of law are made solely to determine whether to institute review. Any final decision will be based on the full trial record.

A. Real Parties in Interest

Petitioner identifies MPL Brands NV, Inc., which does business as Patco Brands, as the real party in interest. Pet. 2. Patent Owner identifies BuzzBallz, LLC, as the real party in interest. Paper 5 (Patent Owner Mandatory Notices), 2.

B. Related Matters

Petitioner states:

The ’904 patent was previously asserted against Petitioner’s products as part of the following matter, filed on September 15, 2023, but was subsequently withdrawn from the matter on November 2, 2023:

- *BuzzBallz, LLC et al. v. MPL Brands NV, Inc.*, 1:23-cv-1115-RP (W.D. Tex.).

That case was transferred to the Northern District of California and is now captioned:

- *BuzzBallz, LLC v. MPL Brands NV, Inc.*, No. 4:24-cv-04004-HSG (N.D. Cal.).

Pet. 2. Petitioner further states that it seeks a declaratory judgment of noninfringement of the '904 patent in *MPL Brands NV, Inc. v. BuzzBallz, LLC*, No. 3:24-cv-01282 (N.D. Cal. June 21, 2024), which is currently stayed. *Id.*

Petitioner further states that “[a]nother patent in the '904 patent family, U.S. Patent No. 11,932,441, is the subject of” the following four matters: (i) *MPL Brands NV, Inc. v. BuzzBallz, LLC*, No. 3:24-cv-01282 (N.D. Cal.); (ii) *BuzzBallz, LLC v. MPL Brands NV, Inc.*, No. 2:24-cv-00548 (D. Nev.); (iii) IPR2024-01000; and (iv) PGR2024-00035. *Id.* at 2–3.

Patent Owner identifies the same matters that Petitioner identifies. Paper 5, 2–3.

C. The '904 Patent (Ex. 1001)

The '904 patent, titled “Container,” issued on August 29, 2023, from U.S. Application 17/819,989, which was filed on August 16, 2022. Ex. 1001, codes (21), (22), (45), (54). The '904 patent claims priority, as a continuation, to a design patent application and two utility patent applications, the earliest of which was filed on April 19, 2010. *Id.* at code (63).

The '904 patent discloses a container for storing a liquid or solid, having a plastic body and metal lid. *Id.* at code (57), 1:18–21, 3:4–15. The container body may include a vertical neck and a lip, and the bottom wall may include a depression. *Id.* at code (57).

We reproduce below Figure 1 of the '904 patent:

Container Shape

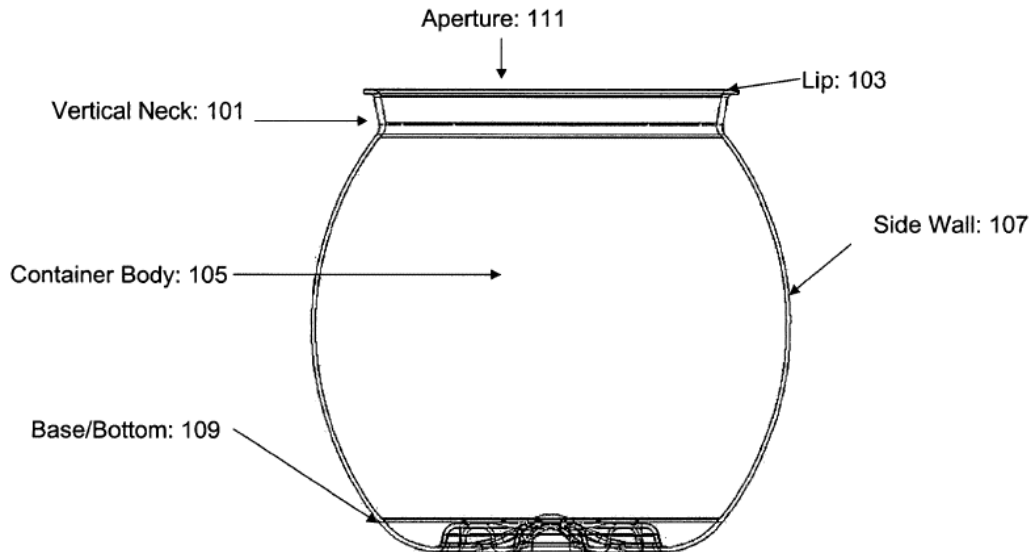


Figure 1

Figure 1, reproduced above, is a side view of hollow container body 105 having convex side wall 107 extending radially around a periphery of the container body. *Id.* at 2:22–29. The distal end of container side wall 107 is connected to base/bottom wall 109 to seal the first end of container 105. *Id.* at 2:30–32. The proximate end of container side wall 107 is connected to substantially vertical neck 101 around the periphery of container side wall 107. *Id.* at 2:32–35. Aperture 111 extends through vertical neck 101 to provide access to a liquid or a solid within container body 105. *Id.* at 2:35–37.

The container's metal lid includes a pop-top arm, which pivots and cooperates with a weakened area to provide access to the container body's interior. *Id.* at code (57). We reproduce below Figure 4 of the '904 patent:

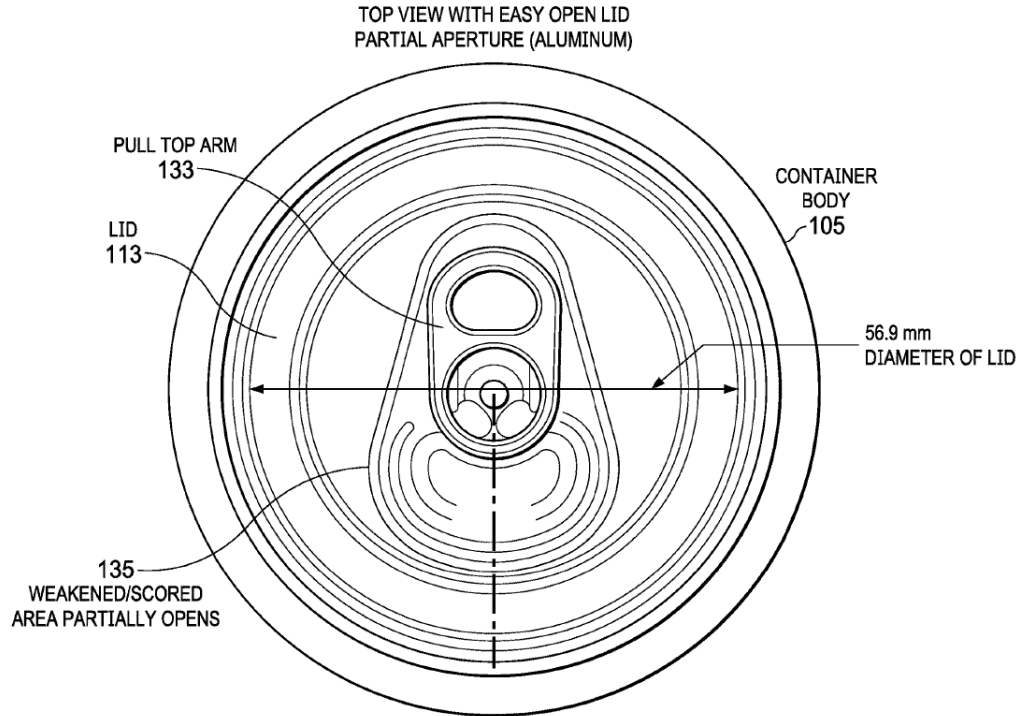


Figure 4

Figure 4, reproduced above, is a top view of deformable container lid 113. *Id.* at 3:31–34. When pull top arm 133 is pivoted by a user’s finger through an aperture of pull top arm 133, deformable area 135 provides an opening for access to the contents in container body 105. *Id.* at 3:34–41.

The bottom wall of the container body may include a center protrusion, a depression, and a radial-extending depression. *Id.* at code (57). We reproduce below Figure 3 of the ’904 patent:

Bottom of Container

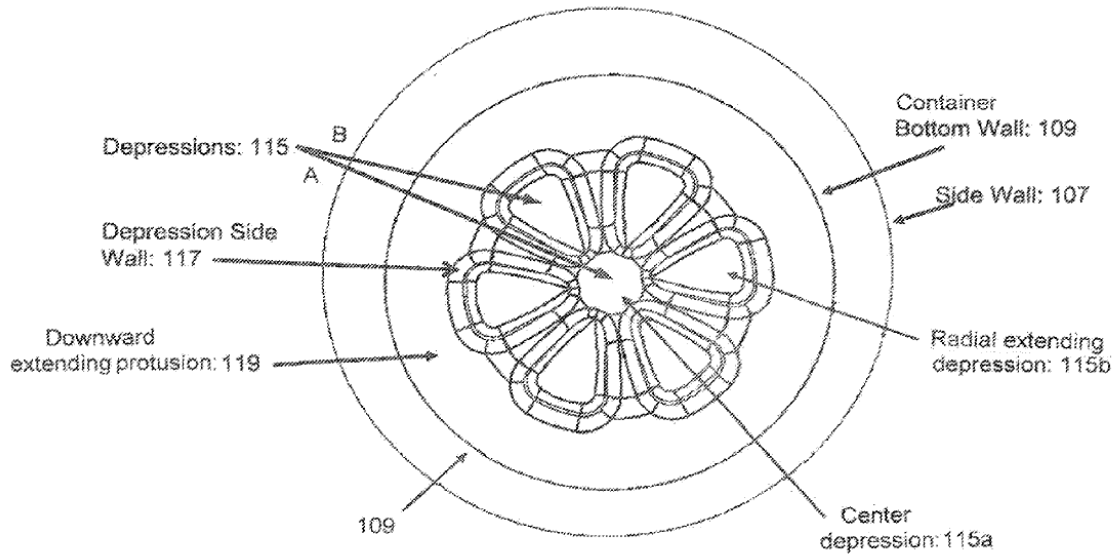


Figure 3

Figure 3, reproduced above, shows container side wall 107 extending radially outwards and bottom wall 109 having a multitude of radially-extending depressions 115, which increase in width as the radial distance from the center increases. *Id.* at 3:19–25. Depression 115 is defined by depression side wall 117 extending around the periphery of depression 115. *Id.* at 3:25–27. Bottom wall 109 includes downward extending protrusion 119 centered with respect to depressions 115 and bottom wall 109. *Id.* at 3:27–30.

D. The Challenged Claims

Petitioner challenges all claims (1–6) of the '904 patent. Claim 1, the only independent claim, is illustrative and is reproduced below with bracketed notations added:¹

1. [1.Pre.] A container, comprising:
 - [1a] a container body, said container body defining a first opening to an interior of said container body; and
 - [1b] a lid connected to the container body and covering the first opening to the interior of said container body;
 - [1c] wherein the container body is made out of a resin;
 - [1d] wherein the lid is made out of a metal;
 - [1e] wherein the container body comprises a container side wall and a horizontally-extending portion connected to the container side wall;
 - [1f] wherein the horizontally-extending portion comprises a bottom having a depression formed therein, said depression extending upwardly from an extant of the bottom;
 - [1g] wherein a cross-sectional diameter of the first opening to the interior of said container body is less than a cross-sectional diameter of a middle portion of said container body;
 - [1h] wherein the horizontally-extending portion defines a diameter that is less than the cross-sectional diameter of the middle portion of said container body;
 - [1i] wherein a lower portion of the container side wall extends downwardly from the middle portion of the container side wall to the horizontally-extending portion of the container body, said lower portion being greater in diameter along its entirety than the horizontally-extending portion, including the bottom, thereby rendering the container body stemless;

¹ For ease of reference, we use Petitioner's notations. *See* Pet. 17–40.

- [1j] wherein the container body further comprises a circular neck extending from the container side wall so that the container side wall extends between the circular neck and the horizontally-extending portion;
- [1k] wherein an upper edge of said container side wall is adjacent to the circular neck of the container body;
- [1l] wherein the cross-sectional diameter of the middle portion of said container body is defined by the container side wall;
- [1m] wherein the container body further comprises a lip at the end of the circular neck opposite the upper edge of said container side wall;
- [1n] wherein said circular neck is adjacent to the lip;
- [1o] wherein a first portion of the lid is above the lip of the container body;
- [1p] wherein a second portion of the lid extends horizontally and is vertically offset from the first portion of the lid;
- [1q] wherein the second portion of the lid defines a total area across which the second portion of the lid extends horizontally;
- [1r] wherein the second portion of the lid comprises a weakened or scored area;
- [1s] wherein the weakened or scored area is less than the total area across which the second portion of the lid extends horizontally;
- [1t] wherein the lid further comprises an arm connected to the second portion of the lid;
- [1u] 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 said container body;
- [1v] wherein an upper portion of the container side wall extends upwardly from the middle portion of the container side wall to the upper edge of the container side wall, said upper

portion being greater in diameter along its entirety than the first opening to the interior of said container body;

[1w] wherein the container contains a liquid; and

[1x] wherein, when the arm of the lid is in the first position and the weakened or scored area is not deformed:

[1y] said liquid fills, or nearly fills, the interior of the container body, which interior extends continuously along a height of the entirety of the upper portion of the container wall so as to be interrupted only by the liquid; and

[1z] an actual volume of the liquid contained in the container is equal to, or less than, 211.5 mL.

Ex. 1001, 4:7–5:16.

E. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–6 are unpatentable on the following three grounds:

Ground	Claim(s) Challenged	35 U.S.C. § ²	Reference(s)/Basis
1	1–6	102/103	Kick ³
2	1–6	103	Ackermann, ⁴ Kaminski ⁵

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended several provisions of 35 U.S.C., including §§ 102 and 103, effective March 16, 2013. Although the ’904 patent on its face claims priority to a date before the applicable date of the AIA amendments (*see* Ex. 1001, code (63)), as discussed below in Section II.E.1.a, we agree with Petitioner that the challenged claims are entitled to a priority date no earlier than February 25, 2020. Accordingly, for purposes of this Decision, we apply the AIA versions of 35 U.S.C. §§ 102 and 103.

³ Kick, U.S. Patent Pub. 2011/0253720 A1, published October 20, 2011 (Ex. 1007).

⁴ Ackermann et al., DE 10 2004 046 423 A1, published December 22, 2005 (Ex. 1008). Ackermann is a German-language document (*see id.* at 18–29); we cite herein to an English translation of Ackermann (*see id.* at 1–17).

⁵ Kaminski et al., U.S. Patent 4,465,204, issued August 14, 1984 (Ex. 1009).

Ground	Claim(s) Challenged	35 U.S.C. § ²	Reference(s)/Basis
3	1–6	103	Ackermann, Kaminski, Hutchinson ⁶

Pet. 5. Petitioner supports its contentions with the Declaration of Nathan J. Delson, Ph.D. (Ex. 1002), among other evidence. Patent Owner supports its contentions with the Declaration of Folkers Eduardo Rojas, Ph.D. (Ex. 2014), among other evidence.

II. ANALYSIS

A. Legal Standards

In an *inter partes* review, “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). The petitioner ultimately bears the burden of persuasion to prove unpatentability of each challenged claim by a preponderance of the evidence. 35 U.S.C. § 316(e). This burden never shifts to the patent owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). The Board may authorize an *inter partes* review if we determine that the information presented in the petition and patent owner’s preliminary response shows a reasonable likelihood that the petitioner will prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314(a).

To anticipate under 35 U.S.C. § 102, each and every claim element, arranged as in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008). It is

⁶ Hutchinson et al., U.S. Patent Pub. 2008/0044603 A1, published February 21, 2008 (Ex. 1010).

permissible to consider not only the literal teachings of an alleged anticipatory prior art reference, but also the inferences a person of ordinary skill in the art would draw from the reference. *Eli Lilly and Co. v. Los Angeles Biomedical Res. Inst.*, 849 F.3d 1073, 1074–75 (Fed. Cir. 2017).

Under 35 U.S.C. § 103, a claim is unpatentable as obvious if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. 35 U.S.C. § 103; *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved based on underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) any objective indicia of nonobviousness.⁷ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

An obviousness determination requires finding a reason to combine accompanied by a reasonable expectation of achieving what is claimed in the challenged patent. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016). “[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR*, 550 U.S. at 419–20.

⁷ Patent Owner does not presently assert any objective indicia of nonobviousness on the current record. *See generally* Prelim. Resp.

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art (sometimes abbreviated herein as “POSITA”), “as of the priority date of February 25, 2020,” would have had “(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. 15 (citing Ex. 1002 (Delson Decl.) ¶ 14). Patent Owner does not dispute Petitioner’s proposal, or otherwise address the applicable level of skill in the art. *See generally* Prelim. Resp.

Petitioner’s proposed level of ordinary skill in the art appears to be consistent with the cited prior art and is undisputed on this record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (indicating that the prior art itself may reflect an appropriate skill level). However, we find some ambiguity in the last sentence of Petitioner’s proposal (“A POSITA could substitute additional education for industry experience and vice versa.”) because the reference to “additional education” is not tethered to relevant education. Accordingly, we modify the last sentence of Petitioner’s proposal to clarify that the additional education must be relevant. Thus, we restate that for purposes of this Decision, a person of ordinary skill in the art of the ’904 patent would have had:

(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 relevant education for practical experience and vice versa.

C. Claim Construction

In AIA proceedings, we interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.*

The parties agree that no claim term requires an express construction. *See* Pet. 15; Prelim. Resp. 11. On this record, we find it unnecessary to construe any claim term to decide whether Petitioner satisfies the standard for instituting trial. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Any final written decision entered in this case may include express claim constructions, or may include discussion of claim scope that differs from that provided in our analysis below. Any final claim constructions will be based on the full trial record.

D. Overview of Asserted Prior Art

1. Kick (Ex. 1007)

Kick, titled “Container,” is the October 20, 2011, publication of U.S. Application No. 12/762,934 (the “’934 application”), which is the first application in the series of asserted continuation applications that led to the ’904 patent. Ex. 1007, codes (54), (43), (21). Kick has the same or

similar figures and detailed description as the '904 patent. *Compare* Ex. 1007, *with* Ex. 1001.

As will be discussed further below in Section II.E.1.a, Patent Owner contends that Kick does not qualify as prior art to the challenged claims. *See* Prelim. Resp. 12–23.

2. Ackermann (Ex. 1008)

Ackermann, titled “Container, in particular reusable container, made of plastic,” published on December 22, 2005. Ex. 1008, codes (54), (43). Petitioner contends, and Patent Owner does not presently dispute, that Ackermann qualifies as prior art under 35 U.S.C. § 102(a). Pet. 42.

Ackermann describes a beverage container with a plastic body and a metal lid. Ex. 1008, code (57), ¶¶ 4, 22, 27. Ackermann teaches that the lid “may be torn away for removing goods from the container,” and for reuse of the container, the lid is stripped off using compressed air, and the container is cleaned and reused. *See id.* at code (57), ¶ 8.

We reproduce below Ackermann’s Figure 1:

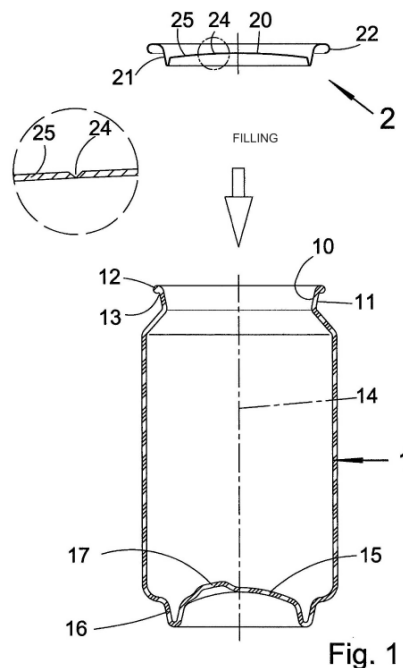


Figure 1 above shows a side view of Ackermann's plastic can during filling, together with metal lid 2. *Id.* ¶¶ 11, 22, 28.

3. Kaminski (Ex. 1009)

Kaminski, titled "Pull Tab for Easy Open End," issued on August 14, 1984, and is directed to "a pull tab which is retained to the can end after opening." Ex. 1009, codes (45), (54), 1:5–8. Petitioner contends, and Patent Owner does not presently dispute, that Kaminski qualifies as prior art under 35 U.S.C. § 102(a). Pet. 43.

Kaminski describes an "easy open can end having a retained tear strip extending diametrically partly across the can end defined by a score line, and a graspable pull tab adjacent and outside the open end of the score line." Ex. 1009, code (57).

We reproduce below Kaminski Figure 1:

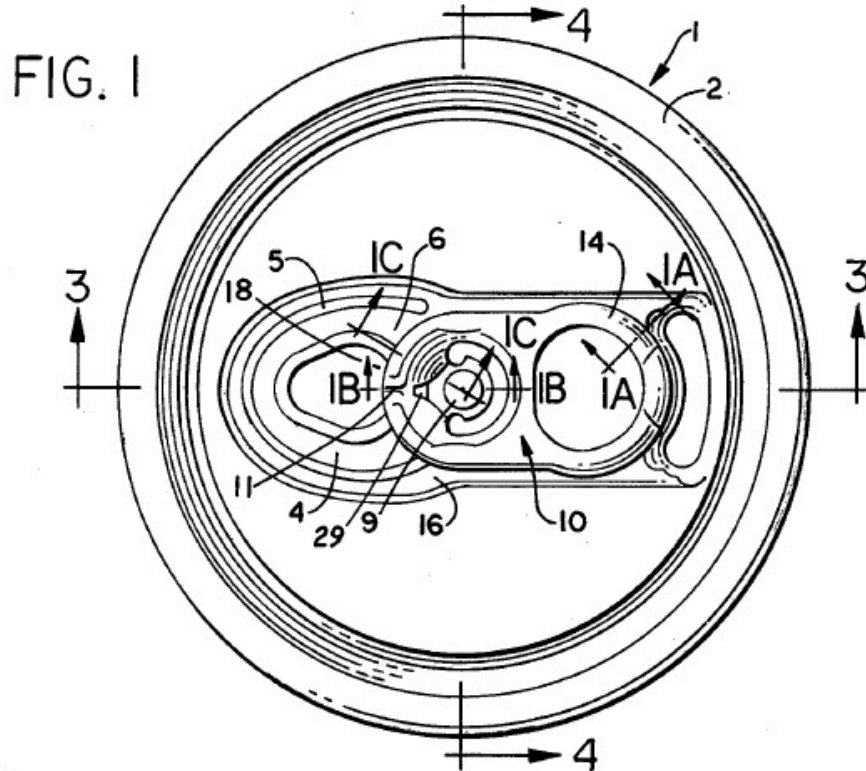


Figure 1 above depicts a top plan view of an easy open can end incorporating a pull tab. Ex. 1009, 2:27–28. The can end includes retained tear strip 4, raised edge 2, U-shaped score or tear line 5, open end 6, integral rivet 9, graspable ring-like pull tab 10, nose portion 11, finger end 14, recessed portion 16, open end 18, and coined V-shape 29. *Id.* at 3:5–3:36. Can end 1 includes circumferentially extending raised edge 2 for attaching can end 1 to a suitable cylindrical beverage can 3. *Id.* at 2:67–3:1.

Can end 1 is “manufactured of a relatively ductile metal, such as aluminum, . . . but may be made from plastic or other materials.” *Id.* at 3:2–4.

4. Hutchinson (Ex. 1010)

Hutchinson, titled “Plastic Multi-Piece Containers and Methods and Systems of Making Same,” published on February 21, 2008, and “is directed toward devices for containing liquid beverages, liquid foods, liquid food beverages and other foodstuffs.” Ex. 1010, codes (45), (54), ¶ 3. Petitioner contends, and Patent Owner does not presently dispute, that Hutchinson qualifies as prior art under 35 U.S.C. § 102(a). Pet. 4.

Hutchinson teaches that “the capacity of the formed container is approximately 200 ml,” but can be “slightly or significantly lower than 200 ml” or “slightly or significantly higher than 200 ml.” Ex. 1010 ¶ 241.

E. Petitioner’s Asserted Grounds of Unpatentability

We address each of Petitioner’s three grounds of alleged unpatentability in turn.

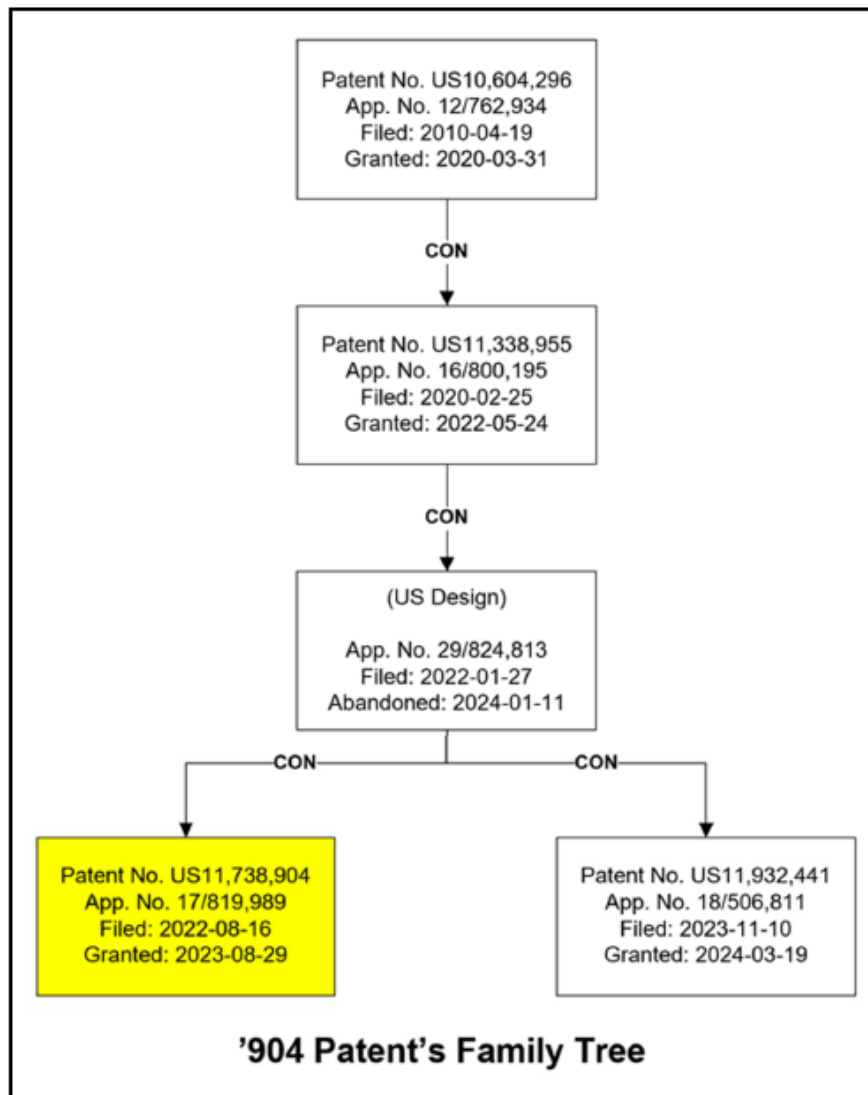
1. Ground 1: Whether Petitioner Demonstrates a Reasonable Likelihood that Claims 1–6 are Anticipated by, or Would Have Been Obvious Over, Kick

Petitioner challenges claims 1–6 as anticipated by, or obvious over, Kick. Pet. 16–41. Patent Owner argues that Ground 1 fails because Kick, which is part of the priority chain of the '904 patent, does not qualify as prior art. Prelim. Resp. 12.

As will be discussed below, on this record we determine that Petitioner demonstrates a reasonable likelihood that the challenged claims are unpatentable as anticipated by, or obvious over, Kick. We begin by analyzing whether Kick qualifies as prior art, then turn to the merits of Petitioner's unpatentability arguments over Kick.

a. Whether Kick Qualifies as Prior Art

Whether Kick qualifies as prior art to the challenged claims depends on whether the challenged claims have adequate written description support in the priority applications. To provide context for our analysis of this issue, we reproduce below Petitioner's graphic showing the asserted priority chain of the '904 patent:



Pet. 7. As shown in the graphic above, the '904 patent family tree comprises five applications. Relevant here, the '904 patent (yellow box) claims priority to three prior applications, the earliest of which is the '934 application. Kick is the October 20, 2011, publication of the '934 application. *See* Ex. 1007 (Kick), codes (43), (21).

i. Legal Standards Regarding Priority

To rely on the filing date of an earlier application, the earlier application must include a disclosure that complies with the written description requirement of 35 U.S.C. § 112. *Lockwood v. Am. Airlines, Inc.*,

107 F.3d 1565, 1571–72 (Fed. Cir. 1997); 35 U.S.C. § 120. The written description requirement requires that a patent’s specification “contain a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The test for sufficiency of a written description under 35 U.S.C. § 112 is whether the earlier application’s disclosure “reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter *as of the filing date.*” *Id.* (emphasis added).

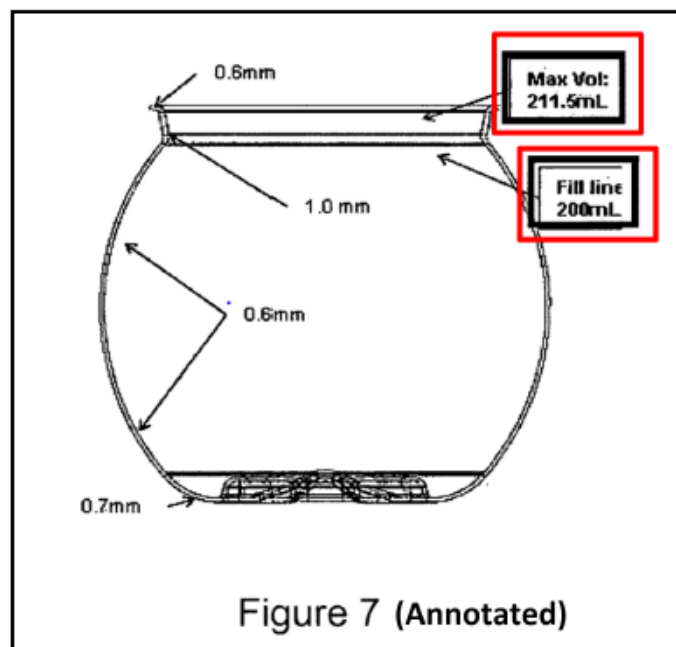
The written description “test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Id.* “[T]he disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter.” *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). However, “one skilled in the art, reading the original disclosure, must immediately discern the limitation at issue in the claims.” *Id.* “[A] description that merely renders the invention obvious does not satisfy the [written description] requirement”; “it is the specification itself that must demonstrate possession.” *Ariad Pharms.*, 598 F.3d at 1352.

ii. Overview of Petitioner’s Argument

Petitioner asserts that Kick qualifies as prior art under 35 U.S.C. § 102(a)(1) because claims 1–6 of the ’904 patent are not entitled to a filing date earlier than February 25, 2020, which is the filing date of U.S. Patent Application No. 16/800,195 (the “’195 application”), which is the grandparent to the ’904 patent. *See* Pet. 16, 7–11. This is because,

Petitioner contends, more than one month after the '934 application was filed, the applicant revised the specification and added four new figures (Figures 6–9), thereby “improperly inject[ing] new matter into the application.” *Id.* at 8.

We reproduce below Petitioner’s annotated version of Figure 7, one of the four new figures submitted more than one month after the '934 application was filed:



Pet. 9. Figure 7 depicts a container with text (highlighted by Petitioner in red boxes) that states, “Max Vol: 211.5mL” and “Fill line 200mL.” *Id.* at 8–9 (citing Ex. 1004 ('934 prosecution history), 54.).

Petitioner correctly notes that challenged claim 1 recites that “an actual volume of the liquid contained in the container is equal to, or less than, 211.5 mL,” and dependent claims 2 and 6 recite an actual volume of liquid of 200 mL. *Id.* at 10. According to Petitioner, these volume-related limitations in the challenged claims were not described in the '934 application as originally filed, and only find proper support in the later-filed

Figure 7. *Id.* at 10–11. This Figure 7 was part of the original filing of the next application in the priority chain, i.e., the '195 application, and thus Petitioner asserts that the filing date of challenged claims 1–6 is no earlier than the February 25, 2020, filing date of the '195 application. *Id.* at 11.

iii. Analysis of Petitioner's Arguments

We agree with Petitioner that the volume limitations recited in challenged claims 1, 2, and 6 lack adequate written description support in the '934 application as filed. *See* Pet. 10–11. The specification, figures, and claims as originally filed do not disclose any volume limitations. *See* Ex. 1004 ('934 prosecution history), 1–17. Instead, the volume limitations recited in the challenged claims find their first support in Figure 7, which was filed over one month after the '934 application was originally filed. *Compare id.* at 1–17, *with id.* at 34–56.

The addition of new matter during prosecution of a patent application is prohibited. *See* 35 U.S.C. § 132(a) (“No amendment shall introduce new matter into the disclosure of the invention.”); *see also* 37 C.F.R. § 1.121(f); Manual of Patent Examining Procedure (“MPEP”) § 608.04. Therefore, we agree with Petitioner that “the new matter improperly added during the prosecution of the '934 application cannot be considered part of the disclosure of the original, April 19, 2010 application and/or relied upon for claiming priority in subsequent applications.” Pet. 9.

Prior to the '934 application issuing as a patent, on February 25, 2020, the applicant filed the '195 application.⁸ *See, e.g.,* Ex. 1006 ('195

⁸ We agree with Petitioner that although the applicant “designated the '195 application as a ‘continuation’ of the '934 application, it is, at best, a continuation-in-part (CIP) of the '934 application because it contained new

prosecution history), 34. We agree with Petitioner that “any claims in the subsequent applications that recite the new matter [are] entitled to, at the earliest, a priority date of February 25, 2020—the filing date of the ’195 application.” Pet. 10. As discussed above, challenged claims 1, 2, and 6 recite volume limitations that first find adequate support in Figure 7 of the ’195 application.

Accordingly, on this record (and after consideration of Patent Owner’s arguments, discussed below), we determine that the priority date of the challenged claims is no earlier than the February 25, 2020, filing date of the ’195 application. *Id.* at 10–11. We agree with Petitioner that “Kick is prior art under 35 U.S.C. § 102(a)(1) with respect to the claims of the ’904 patent because it was published more than one year before the February 25, 2020, priority date of the challenged claims.” Pet. 16.

iv. Patent Owner’s Arguments

Patent Owner argues that the challenged claims are entitled to the April 19, 2010, filing date of the ’934 application, and thus Kick is not prior art. *See* Prelim. Resp. 12–23. According to Patent Owner, based on the original disclosure filed for the ’934 application, a person of ordinary skill in the art would have understood that the inventor was in possession of the volume limitations recited in the challenged claims. *Id.*

First, Patent Owner argues that the applicant filed Figure 7 during prosecution of the ’934 application “in response to a request by the Patent Office, and the Patent Office never objected to [it] as adding new matter or

content that was not part of the ’934 application when it was filed.” Pet. 10 (citation omitted).

otherwise creating any break in the claimed priority date.” Prelim. Resp. 14 (citing Ex. 1004 (’934 prosecution history), 31–32, 58–69).

To the extent Patent Owner suggests that addition of Figure 7 was proper because the Office requested it, we disagree. The Office requested replacement drawings “free from erasures . . . alterations, overwriting, interlineations, folds, and copy marks.” Ex. 1004 (’934 prosecution history), 31. The Office did not request “add[ed] drawings” like those submitted by the applicant. *Id.* at 34. And although Patent Owner is correct that the Examiner did not object to Figure 7, we are not bound by the Examiner’s actions. “[W]ritten description is the metric against which a subsequently added claim is measured to determine if it is due the priority date of the original patent.” *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003). Regardless of the Examiner’s actions, on this record, Petitioner demonstrates that the challenged claims lack adequate written description support in the ’934 application as filed.

Second, Patent Owner argues that “the original disclosure of [the] ’934 Application provides direct and clear support for the volume limitations claimed by the ’904 Patent.” Prelim. Resp. 14. According to Patent Owner, “[t]he detailed description of the ’934 Application discloses that the container is shaped to fit with a standard, pop-top lid and the drawings show the dimensions of the container relative to the standard, pop-top lid.” *Id.* at 16 (citing Ex. 1004 (’934 prosecution history), 2 (original specification stating, “[C]ontainers having an easy-open-end have been used . . . for a number of years.”)). Patent Owner, supported by its declarant Dr. Rojas, argues that a person of ordinary skill in the art “would have recognized the dimensions of a standard, pop-top lid” for a soda or beer can,

and “would also have recognized that the ’934 Application figures were drawn to scale because they are based on a CAD model.” *Id.* (citing Ex. 2014 (Rojas Decl.) ¶¶ 12, 43). Based on this information, Patent Owner argues that a person of ordinary skill in the art “would have understood that the originally filed figures of the ’934 Application depicted a container having a maximum volume of 211.5 mL and a fill line volume of 200 mL.” *Id.*; *see also id.* at 16–23 (explaining Dr. Rojas’s methodology and opinions); Ex. 2014 (Rojas Decl.) ¶¶ 18–43.

On this record, Patent Owner’s arguments are unavailing. As an initial matter, Patent Owner’s arguments are based on an assumption that the ’934 application figures are drawn to scale. *See, e.g.*, Prelim. Resp. 16 (“[A] POSITA would also have recognized that the ’934 Application figures were drawn to scale because they are based on a CAD model.”). However, “it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” *Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956 (Fed. Cir. 2000). Here, Patent Owner has not identified, nor do we discern, any portion of the ’934 application that indicates the figures are drawn to scale.

Additionally, on this record, we have concerns about the propriety of Dr. Rojas’s analysis. For example, his analysis is based on the assertion that “[t]he detailed description of the ’934 Application discloses that the container is shaped to fit with a standard, pop-top lid” for a 355 mL (12 fl. oz.) can. Prelim. Resp. 16; *see also id.* at 20; Ex. 2014 (Rojas Decl.) ¶¶ 19, 24–25. Patent Owner and Dr. Rojas are correct that under a heading titled “Background,” the originally-filed specification states, “[c]ontainers having

an easy-open-end have been used . . . for a number of years.” Ex. 1004 (’934 prosecution history), 2. The specification, however, purports to describe an “*improved* container.” *See id.* at 1 (title) (emphasis added). Patent Owner does not point us to any disclosure indicating that the inventive container is limited to, or even necessarily uses, a “standard” pop-top lid for a 355 mL (12 fl. oz.) can, as Dr. Rojas assumes. *See, e.g.*, Ex. 2014 (Rojas Decl.) ¶¶ 19, 24–25. Thus, on this record, the foundational assumption underpinning Dr. Rojas’s methodology is questionable, because it is based on scaling the figures in the ’934 application as filed to the size of a “standard” pop-top lid for a 355 mL (12 fl. oz.) can. *See id.*

Additionally, Dr. Rojas’s analysis is based on several other assumptions that do not appear to be supported by the disclosure of the ’934 application as filed. For example, he assumes, that the “thickness illustrated in Figure 1 of the Original ’934 Application was consistent with common products available to consumers.” Ex. 2014 (Rojas Decl.) ¶ 29. He also assumes, based on “the Figure 1 original drawing,” that “the neck of the container may be thicker,” and thus adds material to his models in the course of determining the volume of the container depicted in Figure 1. *Id.* ¶ 35. Dr. Rojas also assumes the location of the claimed “fill line,” finding that a person of ordinary skill in the art would assume it is at “the transition between the neck 101 and body 107 of the container.” *Id.* ¶ 42.

Dr. Rojas’s assumptions do not appear to be stated in the disclosure of the ’934 application as filed. Yet “the hallmark of written description is disclosure.” *Ariad Pharms.*, 598 F.3d at 1352. “[A] description that merely renders the invention obvious does not satisfy the [written description] requirement.” *Id.* at 1351. The appropriateness of Dr. Rojas’s assumptions

is unsupported on this record, or at the very least, presents issues of material fact for further development at trial.

For the above reasons, we determine on this record that the priority date of the challenged claims is no earlier than the February 25, 2020, filing date of the '195 application, and thus Kick qualifies as prior art to the challenged claims.

We next analyze whether Petitioner has demonstrated a reasonable likelihood that the challenged claims are unpatentable over Kick.

b. Whether Petitioner Demonstrates a Reasonable Likelihood that Claims 1–6 are Unpatentable Over Kick

Petitioner contends that the challenged claims are anticipated by or obvious over Kick. Pet. 16–41. Kick published with the additional figures and disclosure the applicant submitted during prosecution of the '934 application, and its detailed description and figures are the same as or similar to that of the '904 patent. *See id.* at 16; *compare* Ex. 1007 (Kick), *with* Ex. 1001. Petitioner compares Kick to each limitation of the challenged claims. *See* Pet. 16–41.

Based on the record before us, we find that Kick teaches or suggests all of the limitations of the challenged claims, for the reasons discussed in the Petition. *See id.* At this stage, Patent Owner does not dispute that if Kick is prior art, it anticipates or would have rendered obvious the challenged claims. *See generally* Prelim. Resp.

For the foregoing reasons, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that Kick renders claims 1–6 of the '904 patent unpatentable as anticipated or

obvious. On this basis, we institute an *inter partes* review of all challenged claims. *See* 37 C.F.R. § 42.108(a).

We now turn to providing guidance on our current view of the parties' arguments for Grounds 2 and 3.

2. Ground 2: Whether Petitioner Demonstrates a Reasonable Likelihood that Claims 1–6 are Unpatentable as Obvious Over Ackermann and Kaminski

Petitioner asserts that claims 1–6 are unpatentable as obvious over the combined teachings of Ackermann and Kaminski. Pet. 41–77. In brief, Petitioner proposes combining Ackermann's can and lid with Kaminski's "lid-opening features." *See, e.g., id.* at 43. According to Petitioner, "Kaminski teaches a pop-top tab for opening a can of liquid, which was in common use by the February 25, 2020 priority date" of the challenged claims. *Id.* at 43–44 (citing Ex. 1002 (Delson Decl.) ¶ 83). Petitioner asserts that "Ackermann described lids that could be opened via a 'tear-away removal opening 25,'" but a person of ordinary skill in the art would have been motivated to instead use Kaminski's "retained-tab lid" because it is "superior to tear-away lids '[f]or ecological and safety reasons'" and because it uses less metal. *Id.* at 44 (citing, e.g., Ex. 1009 (Kaminski), 1:5–8, 1:14–17, 1:27–31; Ex. 1008 (Ackermann) ¶ 28; Ex. 1002 (Delson Decl.) ¶¶ 83–87). Petitioner argues that "[t]he Ackermann-Kaminski combination would have been a simple combination of known elements by known methods, yielding predictable results." *Id.*

Petitioner, supported by Dr. Delson, argues that the proposed combination teaches or suggests each limitation of claims 1–6, except the volume limitations of claims 1, 2, and 6. *See id.* at 45–80. Taking as representative claim limitation [1z] (which recites, "an actual volume of the

liquid contained in the container is equal to, or less than, 211.5 mL”), Petitioner asserts that “Ackermann does not explicitly describe a volume of its container,” but “the size of a container is a simple design choice that is guided by the intended use of the container.” *Id.* at 77, 45; *see also* Ex. 1002 (Delson Decl.) ¶ 135. Petitioner contends that “[i]t would have been obvious to a POSITA that the beverage container could be made any preferred size, including having an actual volume of liquid equal to or less than 211.5 mL,” and “[t]here is nothing special about that size that would provide any unexpected results.” Pet. 77 (citing Ex. 1002 (Delson Decl.) ¶ 137). Petitioner further argues that “a claimed device is obvious over a prior art device where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device.” *Id.* (citing *Gardner v. TEC Sys., Inc.*, 725 F.2d 1338 (Fed. Cir. 1984)).

Patent Owner responds that “Ackermann teaches away from using Kaminski’s lid design” because Ackermann teaches a reusable container that can be cleaned through “a large container opening,” but Kaminski’s lid is “usable only once” and “would prevent Ackermann’s reusable container from being cleaned for reuse,” given its small opening. Prelim. Resp. 23–24 (emphasis omitted), 27, 28, 31.

Patent Owner’s argument is unavailing on the current record. First, it misconstrues Petitioner’s proposed combination. Patent Owner contends that the proposed combination results in “an unremovable and irreplaceable lid that stays together with the container.” Prelim. Resp. 32. But as we presently understand it, Petitioner’s proposed combination uses *Ackermann’s lid* with Kaminski’s lid-opening features (i.e., Kaminski’s pop-top). *See, e.g.*, Pet. 43, 49 (referring only to Ackermann’s lid), 64–70

(discussing Ackermann's lid and Kaminski's pop-top). Patent Owner has not adequately explained, and we do not otherwise perceive, how addition of Kaminski's pop-top to Ackermann's lid undermines Ackermann's goals. Second, even if Petitioner's proposed combination used Kaminski's lid, it still appears that Ackermann's goals of reusability and cleaning of the container can be achieved. This is because Ackermann teaches that the lid (whether Ackermann's or Kaminski's) is stripped off to clean the container for reuse. *See* Ex. 1008 (Ackermann) ¶ 8 ("For reuse of the used container, the previously used and broken-open lid is stripped off by applying a suitable pressure in the container [A]fter it has been cleaned the container may be refilled and closed with a new lid."). Patent Owner does not articulate a reason why Kaminski's lid, or Ackermann's lid with Kaminski's pop-top, could not be stripped off for container cleaning and reuse. Accordingly, on this record, we do not agree with Patent Owner that Ackermann teaches away from using Kaminski's lid design.

Patent Owner also questions Petitioner's asserted motivation based on Kaminski's pop-top using less metal (Pet. 44), and argues that Kaminski's lid actually uses more metal than Ackermann's lid. Prelim. Resp. 33–34 (citing Ex. 1009 (Kaminski), 4:30–34 (describing a pull tab that is "0.014 inch to 0.016 inch" thick and allegedly depicting an even thicker lid); Ex. 1008 (Ackermann), 8 (claim 6) (claiming a lid with a "thickness in [the] range of 0.01 mm to 0.3 mm," or 0.0004–0.012 inches). Patent Owner's argument is unavailing because it compares the purported thicknesses of Kaminski's and Ackermann's lids. As explained above, however, Petitioner's proposed combination uses Ackermann's lid, not Kaminski's. The relevant comparison—which neither party addresses on this record—is

the relative amounts of metal in Ackermann's tear-away opening and Kaminski's pull tab.

Finally, Patent Owner argues that Petitioner "does not identify any prior art patent or printed publication disclosure" for the volume limitation recited in claim 1, limitation 1[z]. Prelim. Resp. 35. According to Patent Owner, Petitioner instead "incorrectly states that 'Ackermann does not explicitly describe a volume of its container' and uses this perceived omission to render obvious any volume requirement." *Id.* (quoting Pet. 77). Patent Owner points out that "in fact, Ackermann does specifically recite multiple volumes, including 'cans from 0.5 liters to 1 liter.'" *Id.* at 35–36 (quoting Ex. 1008 (Ackermann), 8 (claim 3)). Patent Owner further argues that Petitioner, in arguing that the claimed volume "is nothing special" and does not "provide any unexpected results," improperly shifts the burden of proof to Patent Owner to demonstrate patentability. *Id.* at 38–39 (quoting Pet. 77). Finally, Patent Owner argues that Petitioner's reliance on *Gardner* is unavailing given the differences between the claims there and here, and because other cases demonstrate that the volume limitations in the challenged claims must be given patentable weight. *Id.* at 36–38.

On this record, we find that the issues the parties raise regarding limitation [1z] are highly fact-intensive and implicate genuine issues of material fact that are more appropriately resolved on a fully-developed record. Accordingly, on this record we reserve judgment on these arguments, to allow the record to develop during trial.

3. Ground 3: Whether Petitioner Demonstrates a Reasonable Likelihood that Claims 1–6 are Unpatentable as Obvious Over Ackermann, Kaminski, and Hutchinson

For Ground 3, Petitioner starts with the same prior art references it uses in Ground 2 (Ackermann and Kaminski), and for the volume limitations of challenged claims 1, 2, and 6, Petitioner adds Hutchinson for its disclosure that plastic beverage containers “can be made to hold a variety of different volumes, including a volume of approximately 200 milliliters.” Pet. 81 (citing Ex. 1010 (Hutchinson) ¶ 241). Petitioner argues that although “Ackermann did not identify possible volumes of its container, a POSITA would have found it obvious to look to other references for beverage containers, such as Hutchinson, which explained suitable sizes for containers for storing beverages.” *Id.* (citing Ex. 1010 (Hutchinson) Abstr., ¶ 241; Ex. 1002 (Delson Decl.) ¶ 146). Petitioner relies on its Ground 2 arguments for most of the limitations of independent claim 1, and cites Hutchinson for limitation [1z], as well as for the volume limitations recited in dependent claims 2 and 6. *Id.* at 82–83.

Patent Owner repeats its arguments regarding lack of motivation to combine made with respect to Ground 2. Prelim. Resp. 40. Patent Owner further argues that “the Petition offers *no reason* to change Ackermann’s stated container volumes of .25–2L or Kaminski’s container volume of 12 oz (355 mL) to the ‘approximately 200 mL’ disclosed by Hutchinson.” *Id.* at 41 (citing Pet. 82).

As we stated above, the issues the parties raise regarding Ground 2 (and repeat for Ground 3) are highly fact-intensive and implicate genuine issues of material fact that are more appropriately resolved on a fully developed record. The same is true of Patent Owner’s additional argument

regarding whether Petitioner has demonstrated an adequate motivation to combine Hutchinson with Ackermann and Kaminski. Accordingly, on this record, we reserve judgment on the parties' arguments to allow the record to develop during trial.

III. CONCLUSION AND NOTICES

On the current record, Petitioner sufficiently shows a reasonable likelihood that least one of the challenged claims is unpatentable. Accordingly, we institute an *inter partes* review.

At this preliminary stage, we have not made a final determination regarding the patentability of any challenged claim or any underlying factual and legal issues. *See TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a petitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”). Any final decision in this proceeding will be based on the full trial record.

The Board will deem forfeited any issue not raised by Patent Owner in a timely response to the Petition, or as permitted in another manner during trial, even if asserted in the Preliminary Response or discussed in this Decision.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted based on all grounds asserted in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this Decision.

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