

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT AND APPEAL BOARD

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A&A GLOBAL IMPORTS, INC.,  
PETITIONER

v.

LERMAN CONTAINER CORPORATION,  
PATENT OWNER

U.S. PATENT NO. D781,151  
ISSUED: MARCH 14, 2017

ENTITLED: JAR

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*Inter Partes* Review No.: IPR2024-01138

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**PETITION FOR *INTER PARTES* REVIEW**

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| Exhibit<br>1001 | U.S. Patent No. D781,151, filed June 8, 2016                                                                                                                    |
| Exhibit<br>1002 | Corrective Assignment from Lerman to Lehman Container Company of D781,151                                                                                       |
| Exhibit<br>1003 | <i>Ex Partes</i> Reexamination of D781,151 File History – 90/014,262                                                                                            |
| Exhibit<br>1004 | Complaint in <i>Lerman Container Corp. d/b/a eBottles.com v. Lids and Jars, LLC d/b/a Cannaline</i> , No. 1-19-cv-01414 in the District of Maryland             |
| Exhibit<br>1005 | Stipulated Dismissal for <i>Lerman Container Corp. d/b/a eBottles.com v. Lids and Jars, LLC d/b/a Cannaline</i> , No. 1-19-cv-01414 in the District of Maryland |
| Exhibit<br>1006 | Complaint in <i>Lerman Container Corp. d/b/a/ eBottles.com v. Greenlane Holdings, LLC</i> , No. 9-22-cv-81723 in the Southern District of Florida               |
| Exhibit<br>1007 | U.S. Patent No. D795,705, filed Dec. 30, 2015                                                                                                                   |
| Exhibit<br>1008 | U.S. Patent No. D578,891, filed Dec. 10, 2007                                                                                                                   |
| Exhibit<br>1009 | Assignment from Lerman to eBottles.com of D781,151                                                                                                              |
| Exhibit<br>1010 | U.S. Patent No. D781,151 – Prosecution File History                                                                                                             |
| Exhibit<br>1011 | Declaration of T. Fletcher                                                                                                                                      |
| Exhibit<br>1012 | U.S. Patent Application Publication 2010/0307521, filed Jun. 3, 2009                                                                                            |
| Exhibit<br>1013 | U.S. Patent No. D634,202 S, filed Dec. 28, 2009                                                                                                                 |
| Exhibit<br>1014 | Neutrogena – Our History, available at <a href="https://www.neutrogena.com/why-neutrogena.html">https://www.neutrogena.com/why-neutrogena.html</a>              |

|                 |                                                                                                                                                                                                                                                                                                                                                                                                                 |
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| Exhibit<br>1015 | Say Tioco – Neutrogena Hydro Boost Press Launch: The secret to soft and supple skin, available at <a href="http://saytiocoartillero.blogspot.com/2011/06/neutrogena-hydro-boost-press-launch.html">http://saytiocoartillero.blogspot.com/2011/06/neutrogena-hydro-boost-press-launch.html</a>                                                                                                                   |
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| Exhibit<br>1018 | U.S. Patent D563,221, filed Oct. 23, 2006                                                                                                                                                                                                                                                                                                                                                                       |
| Exhibit<br>1019 | Docket Report - <i>Lerman Container Corp. d/b/a/ eBottles.com v. Greenlane Holdings, LLC</i> , No. 9-22-cv-81723 in the Southern District of Florida                                                                                                                                                                                                                                                            |
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| Exhibit<br>1023 | Appendix A to Internet Archive Affidavit of N. Frank-White                                                                                                                                                                                                                                                                                                                                                      |
| Exhibit<br>1024 | Voluntary Dismissal in <i>Lerman Container Corp. d/b/a/ eBottles.com v. Greenlane Holdings, LLC</i> , No. 9-22-cv-81723 in the Southern District of Florida                                                                                                                                                                                                                                                     |
| Exhibit<br>1025 | Internet Archive of URL <a href="http://mckernan.com/store/images/D/EL-28595.jpg">http://mckernan.com/store/images/D/EL-28595.jpg</a> captured October 30 2013.                                                                                                                                                                                                                                                 |
| Exhibit<br>1026 | Internet Archive URL <a href="https://www.archive.org/web/20150606135050/http://www.beautypackaging.com/issues/201....">https://www.archive.org/web/20150606135050/http://www.beautypackaging.com/issues/201....</a>                                                                                                                                                                                            |

## **I. MANDATORY NOTICES**

### **A. Real Parties-In-Interest Pursuant to 37 C.F.R. § 42.8(b)(1)**

A&A Global Imports, Inc. (“Petitioner” or “A&A”) is the real party-in-interest.

### **B. Related Matters Pursuant to 37 C.F.R. § 42.8(b)(2)**

Records of the U.S. Patent and Trademark Office (“PTO”) indicate that U.S. Patent No. D781,151 (“’D151”) (EX1001) issued on March 14, 2017 from U.S. Patent Application No. 29/567,402. ’D151 was assigned from the named inventor Robert Lerman to Lerman Container Corporation (“Lerman” or “Patent Owner”) on June 7, 2016. *See* EX1002.

There are currently no pending related matters that would affect, or be affected by, a decision in this proceeding. Previously, on February 11, 2019, ’D151 was submitted for *ex partes* reexamination before the PTO in Reexamination No. 90/014,262, which resulted in an *Ex Parte* Reexamination Certificate on November 30, 2021 confirming the patentability of the claim under the pre-*LKQ Corp. v. GM Global Tech. Operations LLC*, Case No. 21-2348, 102 F.4th 1280 (Fed. Cir. 2024) (*en banc*) standard, which is discussed below. EX1003 at 1-2. Shortly after the *ex parte* reexamination was petitioned, in May 2019, Lerman asserted ’D151 against a third-party in *Lerman Container Corp. d/b/a eBottles.com v. Lids and Jars, LLC d/b/a Cannaline*, No. 1-19-cv-01414 in the District of Maryland, which concluded when the parties dismissed the dispute

in February 2022. EX1004; EX1005. On November 3, 2022, Lerman asserted 'D151 against a different third-party in *Lerman Container Corp. d/b/a/ eBottles.com v. Greenlane Holdings, LLC*, No. 9-22-cv-81723 in the Southern District of Florida (the "Florida Action"). EX1006. The parties to the Florida Action jointly stipulated to dismissal of that action on March 16, 2023. EX1024.

Lerman has not filed a complaint or served a complaint alleging infringement of the 'D151 against Petitioner. Therefore, no judicial or administrative matter would affect, or be affected by a decision in this proceeding.

**C. Lead and Back-Up Counsel Pursuant to 37 C.F.R. § 42.8(b)(3)**

Petitioner identifies Dipu A. Doshi Reg. No. 60,073 as Lead Counsel and Jonathan W.S. England Reg. No. 71,223 and Tara L. Marcus Reg No. 46,510 as Backup Counsel. Pursuant to 37 C.F.R. § 42.10(b), a Power of Attorney accompanies this Petition.

**D. Service Information Pursuant to 37 C.F.R. § 42.8(b)(4)**

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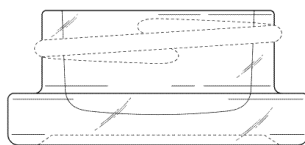
Petitioner agrees to electronic service at the emails provided above.

**E. Payment of Fees under 37 C.F.R. §§ 42.15(a) and 42.103**

The required fees are submitted herewith. If additional fees are owed during this proceeding, the PTO is authorized to charge Deposit Account No. [23-2185].

## II. INTRODUCTION

'D151 is directed to a simple transparent jar, as shown in representative Figure 3 below.

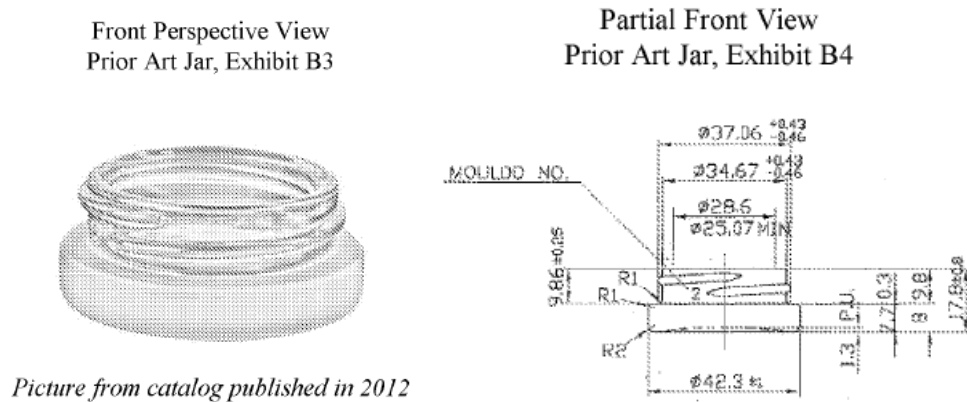


**EX1001, Fig. 3**

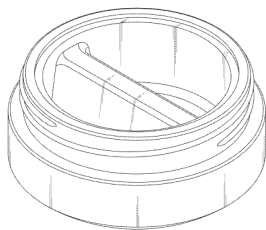
The jar has a tubular base portion, a narrower tubular neck portion extending upwards from the base portion, and a compartment (i.e., an internal chamber), extending from an opening at the top of the neck portion through the entirety of the neck portion and into the base portion where a concave surface defines the bottom of the compartment. The jar is defined by vertical tubular sidewalls including vertical tubular surfaces as well as horizontal top and bottom surfaces. Each of the transitions between the horizontal surface and its adjacent vertical surface is defined by a radiused, e.g., curved, transition. The neck portion of the 'D151 jar is taller than the base portion.

Jars like that of 'D151 were previously known and prevalent. The overall general design of containers that include wide tubular base portions and narrow tubular neck portions located above and concentric to the base portion were widely known prior to 'D151. For example, McKernan Frosted Jar ("McKernan Jar")

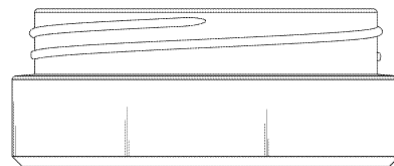
(EX1003 at 402-03, 408, 435-39) and U.S. Patent D795,705 (“Huang”) (EX1007) show the following:



**EX1003 at 402-03, 408-10, 435-39**

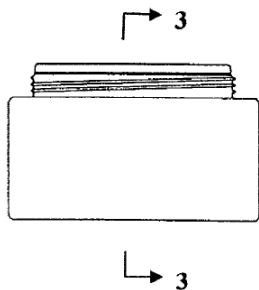


**EX1007, Fig. 1**

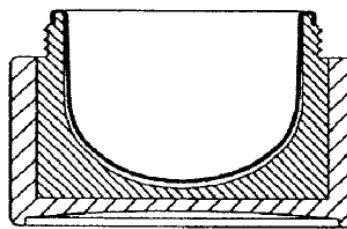


**EX1007, Fig. 2**

In addition, similar containers having tubular base and neck portions like that of the 'D151 jar, also include internal compartments defined by essentially vertical internal sidewalls that transition into a concave bottom surface through a radius transition, were also known, as shown in U.S. Patent D578,891 (“Canamasas Puigbo”) (EX1008).



**EX1008, Fig. 2**



**EX1008, Fig. 3**

Moreover, transparent jars/containers with generally the same overall visual appearance as 'D151, i.e. that include tubular base and neck portions and a visible internal compartment accessible through the top of the neck portion, had been sold and advertised in the cosmetics industry, such as by Neutrogena (EX1017).



**EX1017 at 1, 2<sup>1</sup>**

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<sup>1</sup> Petitioner notes that the web page images provided by the Internet Archive organization includes an image split between two pages. Upon close review, the Internet Archive image (EX1023 at 3-4, 9-10) is the same as the image currently

Such containers included radiused transitions between vertical and horizontal surfaces, concave bottom surfaces to internal compartments, and concentrically located compartments and neck portions. Such jars were sold and advertised in printed publications by Neutrogena, among others.

In short, 'D151 contributed nothing to the art by claiming the specific transparent jar. It merely assembled known elements from other designs that a designer would routinely look to incorporate, such as smooth transitions and transparency, as well as functional elements such as compartment volume and external display volume. The simple assembly of known prior art elements arranged as previously known for the same ornamental value is neither inventive nor entitled to a patent. For these reasons, 'D151 is unpatentable, and its claim should be cancelled.

### **III. U.S. PATENT D781,151**

'D151 is entitled "JAR" and issued on March 14, 2017 from application no. 29/567,402, filed on June 8, 2016 and claims the ornamental design for a jar. EX1001 at (21), (22), and (57). No priority is claimed and 'D151 is entitled to an effective filing date of June 8, 2016.

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appearing on the domain. EX1011 ¶57 (citing EX1017; EX1023 at 3-4, 9-10). For convenience, Petitioner herein refers to the unsplit version of the image.

'D151 includes seven figures showing different perspectives of the jar, reproduced below. 'D151 explicitly disclaims the aspects of the figures that are shown in broken lines *See id.* at [Description].

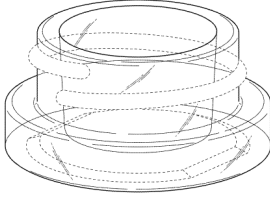
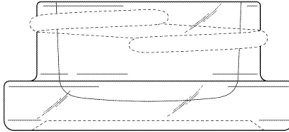
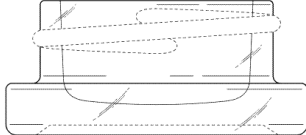
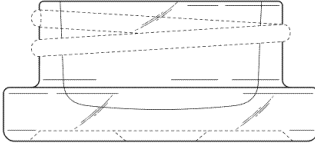
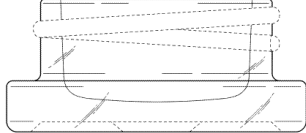
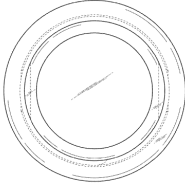
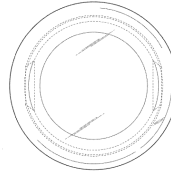
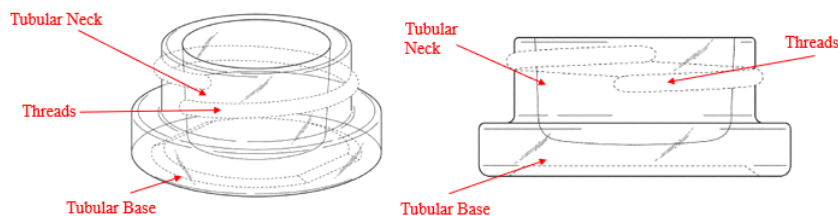
| Description                                       | Drawing                                                                              |
|---------------------------------------------------|--------------------------------------------------------------------------------------|
| <b>Fig. 1: Top, Front, Right Side Perspective</b> |    |
| <b>Fig. 2: Front Elevation Perspective</b>        |    |
| <b>Fig. 3: Rear Elevation Perspective</b>         |  |
| <b>Fig. 4: Right Side Elevation</b>               |  |
| <b>Fig. 5: Left Side Elevation</b>                |  |
| <b>Fig. 6: Top Plan View</b>                      |  |

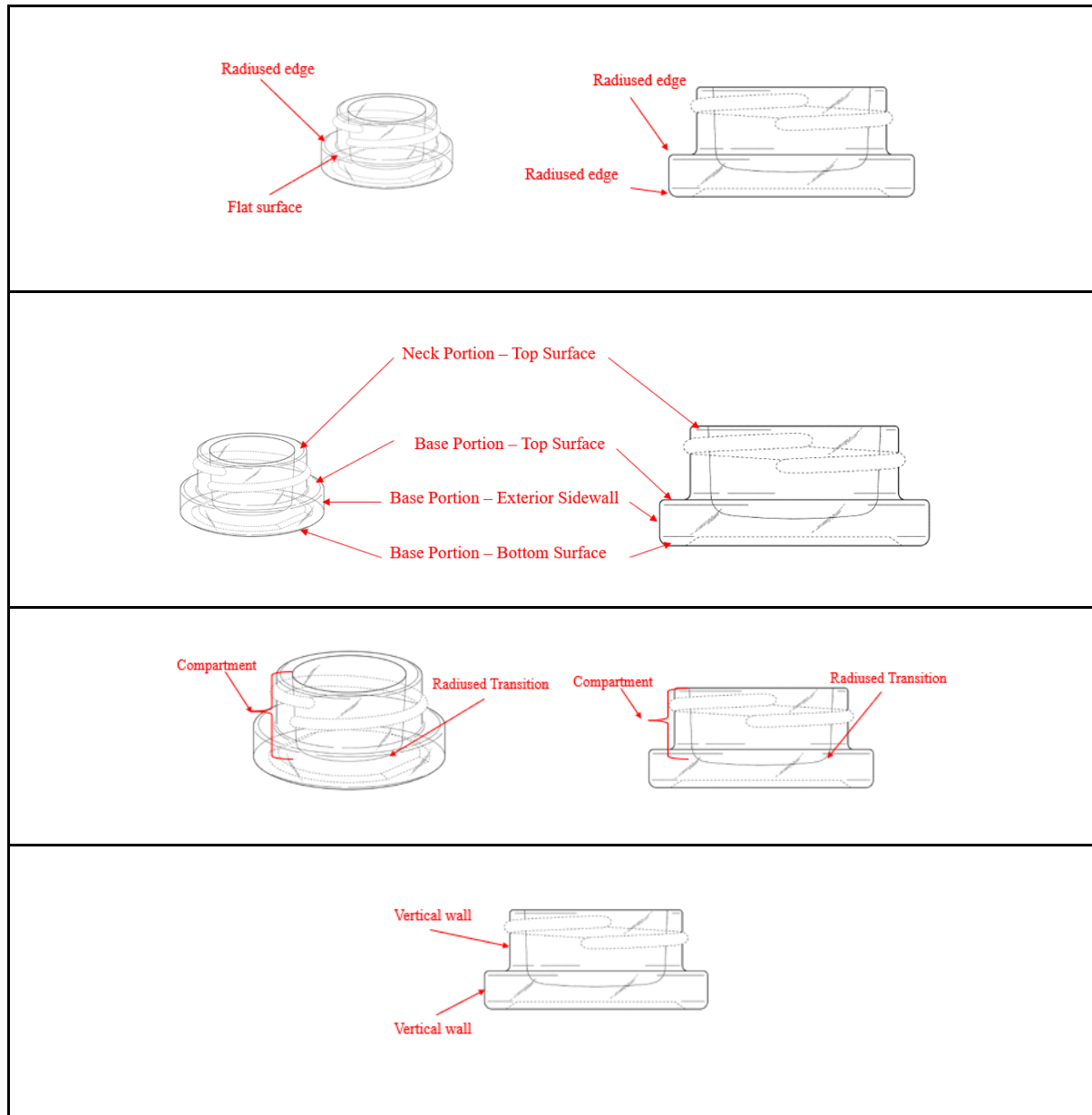
**Fig. 7: Bottom Plan View**



Below are annotated figures of 'D151 for reference herein. EX1011 ¶37. As shown, 'D151 claims a transparent jar having a tubular base portion and tubular neck portion concentrically located on and extending upwards from the top surface of the tubular base portion. *Id.* The tubular base portion is wider than the neck portion and includes horizontal top and bottom surfaces. *Id.* The base portion is slightly shorter than the neck portion. *Id.* 'D151 further includes an open-topped compartment that is disposed in the interior of the neck portion and extends into the base portion. *Id.* The transition between the exterior sidewall of the base portion and its respective horizontal top and bottom surfaces is a radiused transition. *Id.* at ¶¶37-38.

**'D151**





As shown, the external surface of the neck portion can accommodate threads, such as for attachment of a cap. *Id.* at ¶38. The top surface of the neck portion extends horizontally and is perpendicular to the vertical tubular sidewalls and further defines a cylindrical opening (circular from a top-down view) of the compartment. *Id.*; *see also* EX1001, Fig. 6. The transition from the interior

sidewalls of the neck portion to the top surface of the neck portion is rounded, similar to the transition between the exterior vertical walls of the neck portion and the top surface of the base portion. Exhibit 1011 ¶38.

Disposed within both the base and neck portions is an internal compartment (marked in figured above). *Id.* at ¶39. The compartment is a space open at the top end of the neck portion and extending into a portion of the base portion, as shown above, where a radiused transition from the sidewalls to its bottom surface define a concave bottom of the compartment. *Id.* at ¶¶37, 39. The entirety of the article claimed in 'D151 is transparent such that the contours of the compartment are visible. *Id.* at ¶39.

#### **A. 'D151 Original Prosecution File History**

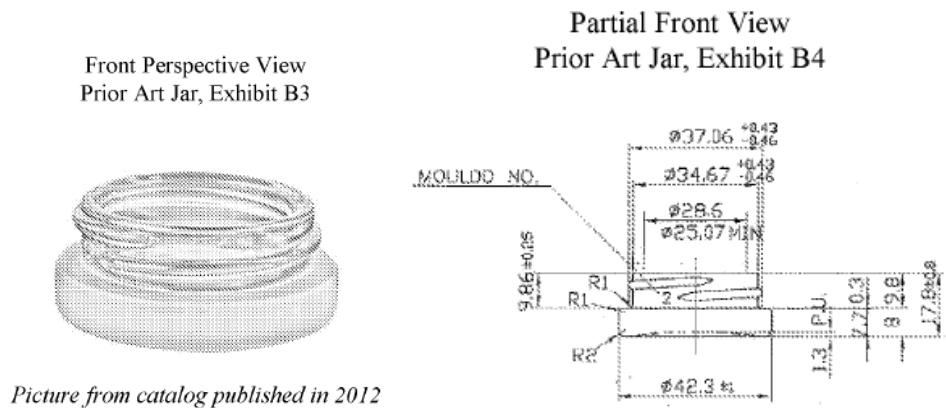
The PTO issued a Notice of Allowability together with an Election/Restriction requirement as its first response to the filing of the application. *See* EX1010 at 21-30. Lerman selected the embodiment covered by the seven figures of the issued patent and amended the description to renumber the figures directed to that embodiment. *Id.* at 12-18.

#### **B. 'D151 Reexamination Prosecution File History**

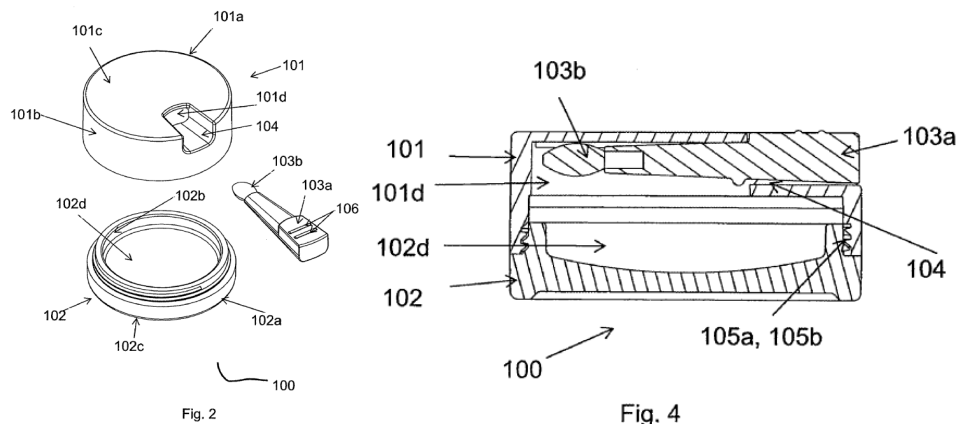
'D151 was subject to an *Ex Parte* Reexamination ("Reexamination"). As explained in further detail below, the Examiner rejected the claims, but was

ultimately reversed by the Patent Trial and Appeal Board (“PTAB”) based on the PTAB’s application of the now overruled *Rosen-Durling* test. *See* EX1003, 14-29.

The Reexamination request primarily asserted invalidity based on the McKernan Jar (EX1003 at 402-03, 408-10, 435-39) (reproduced below) in view of U.S. Patent Application Publication 2010/0307521 (“Pires”) (EX1012) (reproduced below).



### EX1003 at 402-03, 408, 435-39



### EX1012, Fig. 3, Fig. 4

The PTO instituted reexamination and issued a first Office Action finding 'D151 unpatentable over the McKernan Jar in view of U.S. Patent D634,202 ("Zamberlan") (EX1013)(reproduced below). EX1003 at 273-79. The Examiner found that the overall design characteristics of the McKernan Jar were basically the same as the design claimed in 'D151, except that it had a frosted finish at the base. *See id.* at 276. In the Examiner's view, that deficiency was cured by the transparent Zamberlan container (Fig. 7 shown below), such that the combined reference jar would be fully transparent. *See id.* at 276-277.

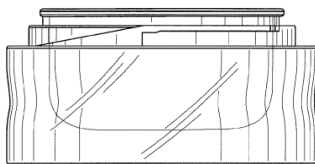


FIG. 7

### EX1013, Fig. 7

In response, Lerman asserted that the McKernan Jar could not be a primary reference under the *Rosen-During* test because it does not create the same visual impression as 'D151. EX1003 at 259-65. Lerman argued that 'D151 conveyed an overall visual impression of openness and clarity to permit an ordinary observer to see into the interior compartment of its jar, while the McKernan Jar conveyed a masked visual impression because it was opaque. *Id.* at 263. Lerman also emphasized the benefit of the functionality of the transparency of the claimed jar as

allowing anything stored inside the jar to be readily visible from the outside. *Id.* at 261. Indeed, Lerman specifically noted that the transparent design “enhanced child-proof characteristics.” *Id.* Lerman further argued that Zamberlan could not qualify as a secondary reference under the *Rosen-Durling* test because it was not sufficiently “related to” the McKernan Jar, due to essentially minor differences in appearance, such that a designer would not be persuaded to modify the McKernan Jar in view of Zamberlan. *Id.* at 265-70.

A final Office Action issued which found Lerman’s arguments unpersuasive and maintained the rejections. *See id.* at 234-242.

Lerman responded by rehashing its prior arguments and again noting the functional benefit of the transparent design of visibility of the jar’s interior chamber. *Id.* at 203-224. At no point during the reexamination did Lerman challenge the assertion that the McKernan Jar qualified as prior art to ’D151. The Examiner again found Lerman’s arguments unpersuasive. *Id.* at 199.

Lerman appealed and the PTAB issued its Decision on Appeal (“Decision”) reversing the Examiner’s rejection. *Id.* at 28. As discussed below, the PTAB’s Decision was based on the now overturned *Rosen-Durling* test that treated design applications differently than utility applications. The PTAB stated that “unlike a utility application”, they could find no particular reason that an ordinary designer would have combined a feature from one design with another design. *Id.* at 26.

The PTAB's Decision was a narrow holding based on *Rosen-Durling* and the Examiner's specifically articulated rejection, – not the patentability of 'D151 generally, or even based upon the McKernan Jar and Zamberlan as would be understood by a skilled designer.

The Decision focused on whether the McKernan Jar could function as a primary reference under the *Rosen-Durling* test and then whether the combination of the McKernan Jar and Zamberlan would have rendered 'D151 obvious. *Id.* at 22-27.

The Decision determined that the McKernan Jar could not function as a primary reference because the art is crowded and therefore even differences in small details would have more weight than in less crowded arts in the overall visual impression analysis. *Id.* at 22-23. In the PTAB's view, the McKernan Jar failed to create an overall visual impression that was basically the same as the claimed jar because the claimed jar is transparent and demonstrates openness and clarity that was lacking in the frosted McKernan Jar. *Id.* at 23.

The Decision further found that a skilled artisan would not have arrived at the claimed invention because the proposed combination lacked any particular reason, e.g., expert testimony or disclosure, for the inclusion by a skilled designer of certain features of Zamberlan into the McKernan Jar. *Id.* at 26. The Decision

did not address or weigh expert opinion with that regard because none was provided.

The Reexamination proceeding and Decision demonstrated the strict application of the *Rosen-Durling* test and the limitations of reexaminations – that *absent* specific expert opinion or references provided at the outset, the Examiner must take responsibility to provide evidence-backed reasons why a skilled designer would be motivated to replace a frosted base of a jar with a transparent base of a jar or the design of the interior of a jar.

#### **IV. PRIOR ART AND GROUNDS FOR RELIEF**

##### **A. Patents and Printed Publications Relied Upon for Statutory Grounds of Invalidity**

There is at least a reasonable likelihood that the claim of 'D151 will be found unpatentable based on the following prior art as identified in the following grounds of invalidity. As discussed in Section III, 'D151's earliest possible priority date is June 8, 2016; as such, 'D151 is subject to AIA 35 U.S.C. §§ 102 and 103. All of the prior art patents and printed publications discussed herein constitute prior art against 'D151 under AIA 35 U.S.C. §§ 102(a)(1)-(2) and are submitted under 35 U.S.C. § 312(a)(3).

## 1. Neutrogena Hydro Boost

Neutrogena Corporation has been selling and advertising (via printed publications) skin care products in transparent jars/containers since at least 2006.<sup>2</sup> Neutrogena Corporation sold and advertised (via direct and indirect printed publications) a product family, Hydro Boost, in transparent blue jars. *See, e.g.*, EX1014 at 4; EX1015 (copyright 2011); EX1022; EX1023 at 33-39. By July 29, 2014, Neutrogena Corporation also advertised Hydro Boost Range, which included purified Hyaluronic Acid. EX1016. The Neutrogena Hydro Boost and Hydro Boost Range products have been sold and advertised in printed publications in their distinctive transparent blue jars of which exemplary selective images are reproduced below. EX1011 at ¶57; EX1015; EX1016; EX1017; EX1022; EX1023 at 2-13, 33-39.



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<sup>2</sup> The terms “jar” and “container” are used interchangeably with respect to Neutrogena Corporation’s relevant products.



**EX1015**

July 29, 2014



**EX1016**



### EX1017<sup>3</sup>

As can be seen from the above images, Hydro Boost and Hydro Boost Range products were well known and advertised (directly or indirectly in printed publications) in distinctive blue tinted transparent jars/containers. *Id.* These jars have been advertised and marketed through online distributors and trade shows, which had been reduced to online and print media by the earliest effective filing date of 'D151, thereby constituting printed publications as they are easily found, publicly accessible, and written documents disclosing images of the bottle. *Id.*

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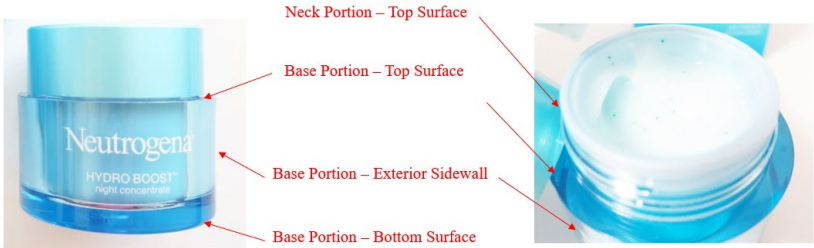
<sup>3</sup> Petitioner notes that the web page images provided by the Internet Archive organization includes an image split between two pages. Upon close review, the Internet Archive image (EX1023 at 3-4, 9-10) is the same as the image currently appearing on the domain. EX1011 ¶57 (citing EX1017; EX1023 at 3-4, 9-10). For convenience, Petitioner herein refers to the unsplit version of the image.

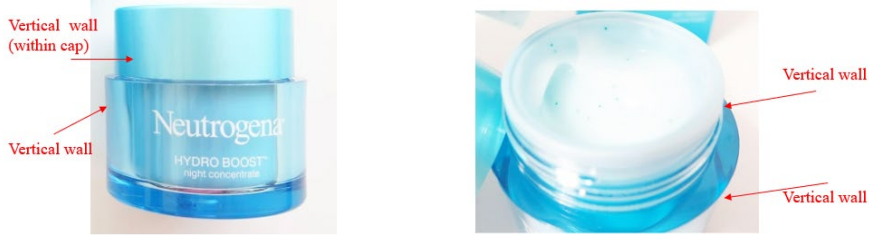
Evidence of their public accessibility by the earliest effective filing date includes: the dates on the websites, dates in the domain names, an affidavit provided by the Internet Archive organization, the multiple independent sources of these images, the date stamps of the comments on the websites, the copyright dates of the website and images, and the corporate timeline. There can be no reasonable dispute these printed publications have been available since as early as 2011 and as late as 2015. *See* EX1015; EX1017; EX1022; EX1023 at 2-13, 33-39; EX1011 ¶57; *see also* EX1014; EX1016. As such, these images are prior art to 'D151 under at least 35 U.S.C. § 102(a)(1). As Mr. Fletcher testifies, “the images of Exhibit 1015 and Exhibit 1017 both reflect the same Neutrogena jar and are referred to show different angles and aspects of the jar.” EX1011 ¶57. For convenience, Mr. Fletcher refers to these images as “Neutrogena.”

Below are annotated figures of Neutrogena for reference. *See id.* at ¶58. Neutrogena shows a transparent tinted blue jar having a tubular base and a tubular neck portion located concentrically on the top horizontal surface of the tubular base portion and extending upwards from the horizontal surface. *Id.* at ¶59. As illustrated by the narrower cap (and neck portion within the cap), the base portion has a greater diameter than the neck portion. *Id.* Further, the base portion includes horizontal top and bottom surfaces and an exterior vertical sidewall (with the interior defining a lower end of the compartment and a bottom surface of the

compartment). *Id.* As discussed below, the tubular neck portion and tubular base portion together define a compartment space open and accessible through the top of the neck portion. *Id.* The transition between the vertical exterior sidewall of the base portion and its respective top and bottom horizontal surfaces is curved. *Id.*

| Exhibit | Annotated Drawing                                                                                                                                                                                   |
|---------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| EX1015  |  <p>Tubular Neck (within cap)</p> <p>Tubular Base</p>                                                            |
| EX1017  |  <p>Tubular Neck (within cap)</p> <p>Tubular Base</p> <p>Tubular Neck</p> <p>Threads</p> <p>Tubular Base</p>    |
| EX1015  |  <p>Base Portion – Top Surface</p> <p>Base Portion – Exterior Sidewall</p> <p>Base Portion – Bottom Surface</p> |

|                      |                                                                                      |
|----------------------|--------------------------------------------------------------------------------------|
| <p><b>EX1017</b></p> |    |
| <p><b>EX1015</b></p> |    |
| <p><b>EX1017</b></p> |   |
| <p><b>EX1015</b></p> |  |

|               |                                                                                    |
|---------------|------------------------------------------------------------------------------------|
| <b>EX1017</b> |  |
| <b>EX1017</b> |  |

Images from EX1016, which show different angles, are consistent with those of EX1015 and EX1017. *Id.*

| Exhibit | Annotated Drawing                                                                                                                                                                                  |
|---------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| EX1016  |  <p>Tubular Neck (within cap)</p> <p>Tubular Base</p>                                                            |
| EX1016  |  <p>Base Portion – Top Surface</p> <p>Base Portion – Exterior Sidewall</p> <p>Base Portion – Bottom Surface</p> |
| EX1016  |  <p>Flat surface</p> <p>Radiused edge</p> <p>Radiused edge</p>                                                 |
| EX1016  |  <p>Compartment (within neck)</p> <p>Radiused Transition</p>                                                   |

As shown in EX1015 and EX1017, the neck portion is disposed above and is unitary with the base portion. An external surface of the neck portion includes threads for attachment of the cap. EX1011 at ¶¶59-60. The top surface of the neck portion defines the circular opening for the compartment. *Id.*

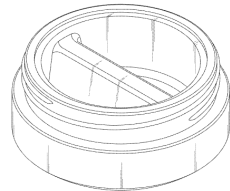
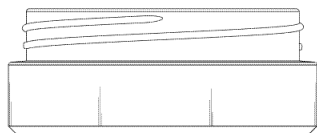
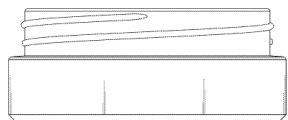
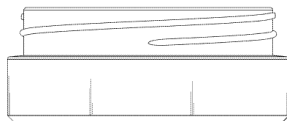
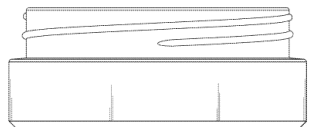
Disposed within both the base and neck portions is a compartment, in which a white liner is disposed and corresponds to the contours of the compartment. *Id.* at ¶61. The entire container is transparent such that an ordinary observer can see through the container to the contours of the compartment. *Id.* The open top end of the neck portion defines the entrance of the compartment, which extends from the top of the neck portion into the base portion and also allows an ordinary observer to see the contours of the compartment. *Id.* The compartment further includes a curved transition from its walls (internal surface of neck and base portion) to the bottom surface of the compartment, as shown in EX1015 and EX1017. *Id.* The bottom surface of the compartment is a slightly concaved in the upwards direction. *Id.* Finally, the tubular base portion includes a transparent section below the bottom surface of the compartment, and therefore an observer can see that the compartment extends into the base portion. *Id.*

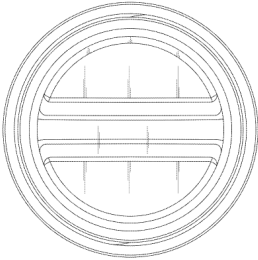
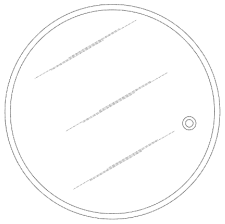
## **2. Huang (D795,705)**

Huang is entitled “COMPARTMENTALIZED CONTAINER” and claims the “ornamental design for a compartmentalized container . . . .” EX1007. Huang

issued on August 29, 2017 from U.S. Patent Application No. 29/550,094, filed on December 30, 2015 and is prior art under at least 35 U.S.C. § 102(a)(2).

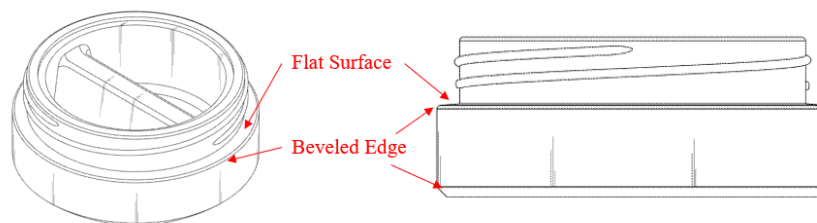
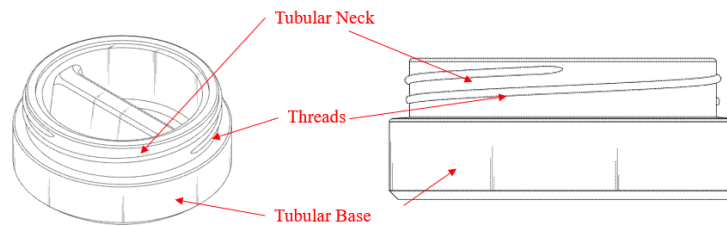
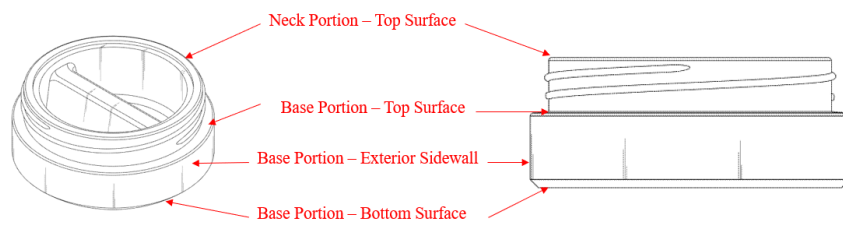
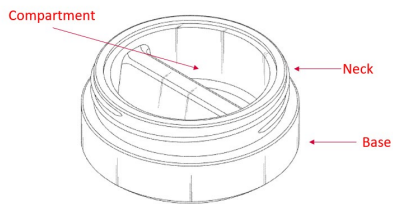
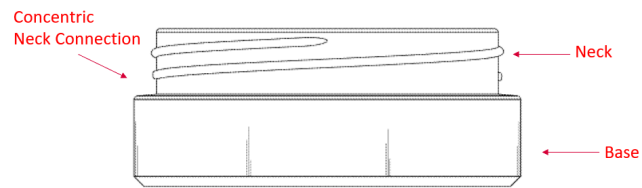
The specification of Huang includes seven Figures (reproduced below). *See id.*; EX1011 ¶63.

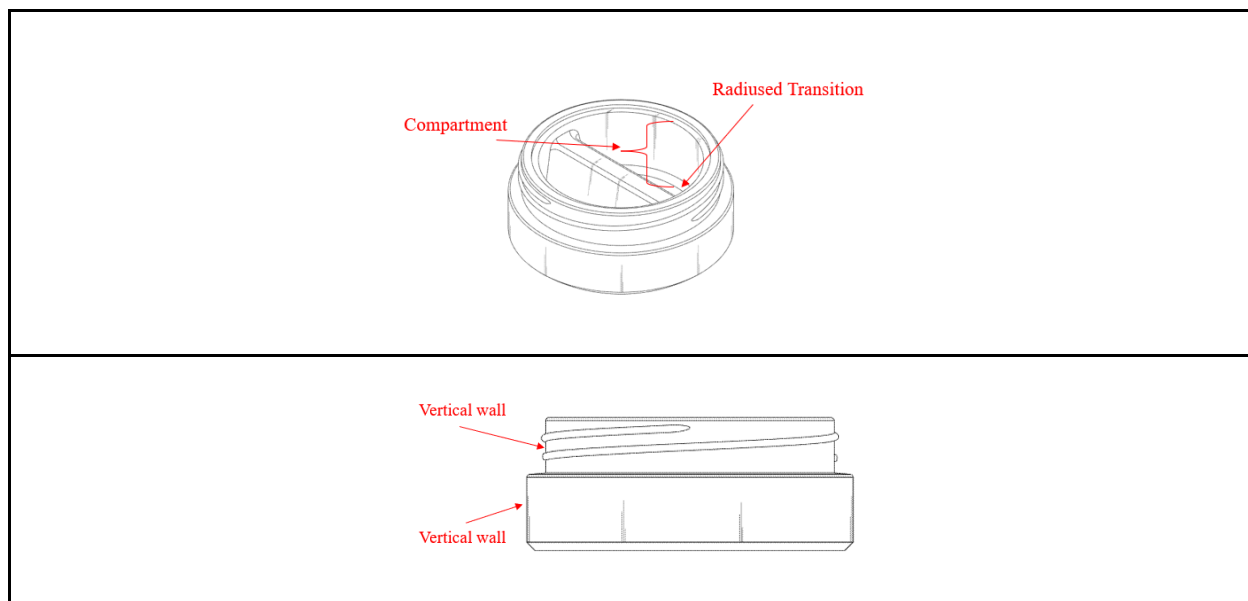
| Description                                | Drawing                                                                              |
|--------------------------------------------|--------------------------------------------------------------------------------------|
| <b>Fig. 1: Perspective View</b>            |   |
| <b>Fig. 2: Front Elevational View</b>      |   |
| <b>Fig. 3: Rear Elevational View</b>       |  |
| <b>Fig. 4: Left Side Elevational View</b>  |  |
| <b>Fig. 5: Right Side Elevational View</b> |  |

|                            |                                                                                     |
|----------------------------|-------------------------------------------------------------------------------------|
| <b>Fig. 6: Top View</b>    |   |
| <b>Fig. 7: Bottom View</b> |  |

Below are annotated figures of Huang for reference herein. EX1011 ¶64. Huang shows a container with a tubular base portion, a concentrically located tubular neck portion atop the horizontal surface of the tubular base portion, and a compartment disposed within the base and neck portions and accessible through the top of the neck portion. *Id.* at ¶65. The base portion of Huang has a greater diameter than the neck portion and is approximately the same height as the neck portion. *Id.* The base portion includes horizontal flat top and bottom surfaces and a vertical exterior sidewall. *Id.* The transition between the sidewall the respective top and bottom surfaces is beveled. *Id.* The entire article of Huang is opaque. *Id.*

## Annotated Drawing – Huang





The external surface of the concentrically located neck portion includes threads to allow for the attachment of a cap. *Id.* at ¶¶66-67. The top surface is horizontal, flat, and perpendicular to the internal and external vertical tubular sidewalls and defines the circular opening for the compartment, as illustrated by the annotated drawings. *Id.* Huang further contains a beveled edge transition between the vertical walls and top surface of the neck portion. *Id.*

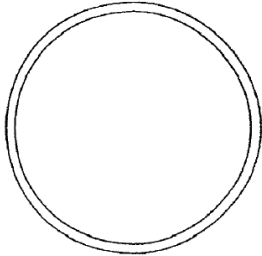
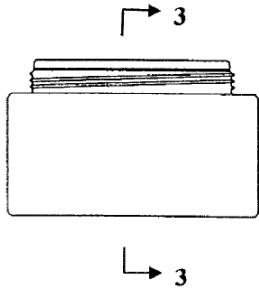
Disposed within both the base and neck portions is the compartment. *Id.* at ¶63. The compartment is an open space accessible at the top end of the neck portion. *Id.* The compartment extends from the container's top to the base portion and includes a beveled transition from its sidewalls to the concave bottom surface based upon the transition. *Id.* The compartment of Huang further includes a bisecting wall that does not extend to the top of the compartment but creates two

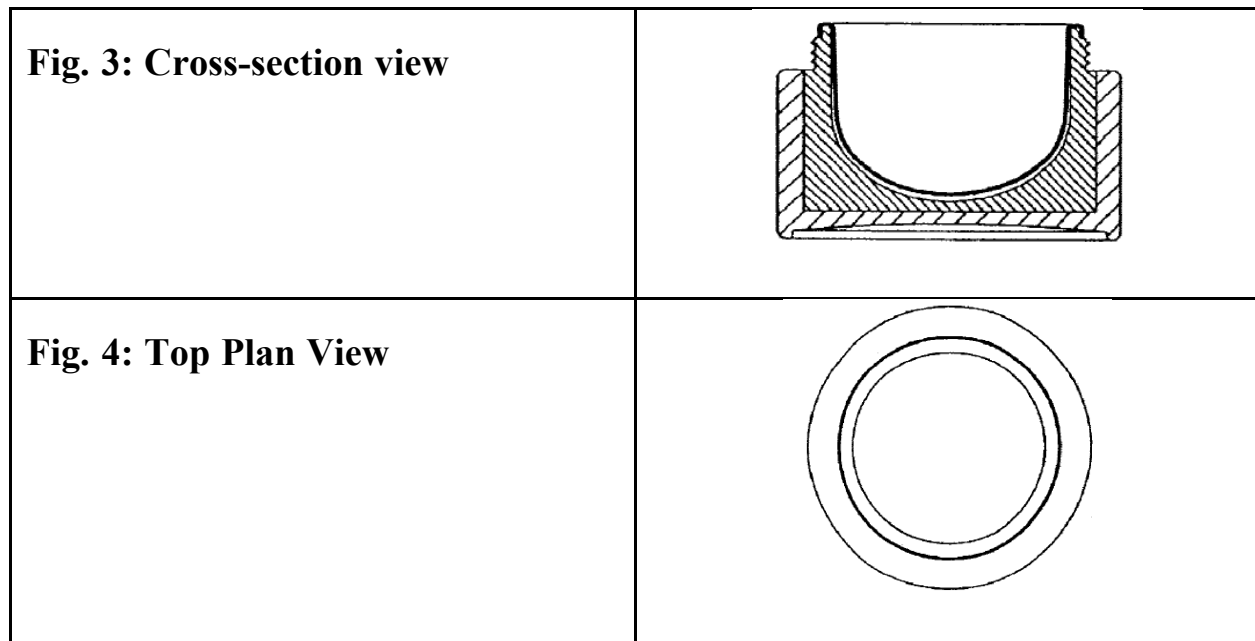
chambers. *Id.* As can be seen from the drawings, the compartment does not extend through the bottom of the base portion.

### 3. Canamasas Puigbo (“D578,891”)

Canamasas Puigbo issued on October 21, 2008 from U.S. Patent Application No. 29/298,626, which was filed on December 10, 2007. EX1008. Therefore, Canamasas Puigbo is prior art to 'D151 under at least 35 U.S.C. § 102(a)(1).

Canamasas Puigbo is entitled “BOTTLE” and claims the “ornamental design for a bottle.” *See id.* The specification of Canamasas Puigbo includes four drawings (reproduced below) that illustrate the claimed ornamental design:

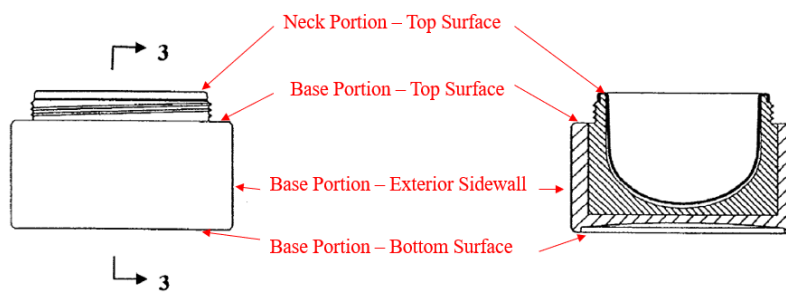
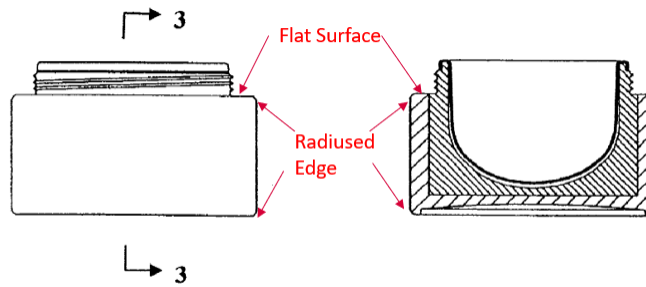
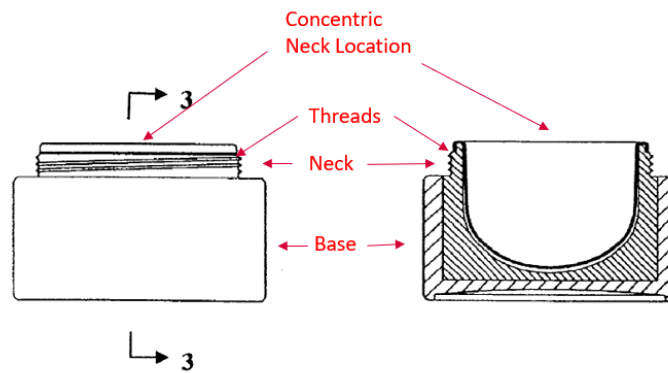
| Description                                                            | Drawing                                                                                                                                                                                                                                                                                                                                                                                                                |
|------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Fig. 1: Bottom Plan View</b>                                        |  A line drawing showing the bottom plan view of the bottle. It consists of two concentric circles, with the outer circle being slightly larger than the inner one, representing the base and the main body of the bottle respectively.                                                                                             |
| <b>Fig. 2: Front Elevation View (rear elevation view is identical)</b> |  A line drawing showing the front elevation view of the bottle. It is a rectangular shape with a slightly flared top edge. Above the rectangle, there is a small horizontal line with a right-pointing arrow and the number 3. Below the rectangle, there is a small L-shaped symbol with a right-pointing arrow and the number 3. |

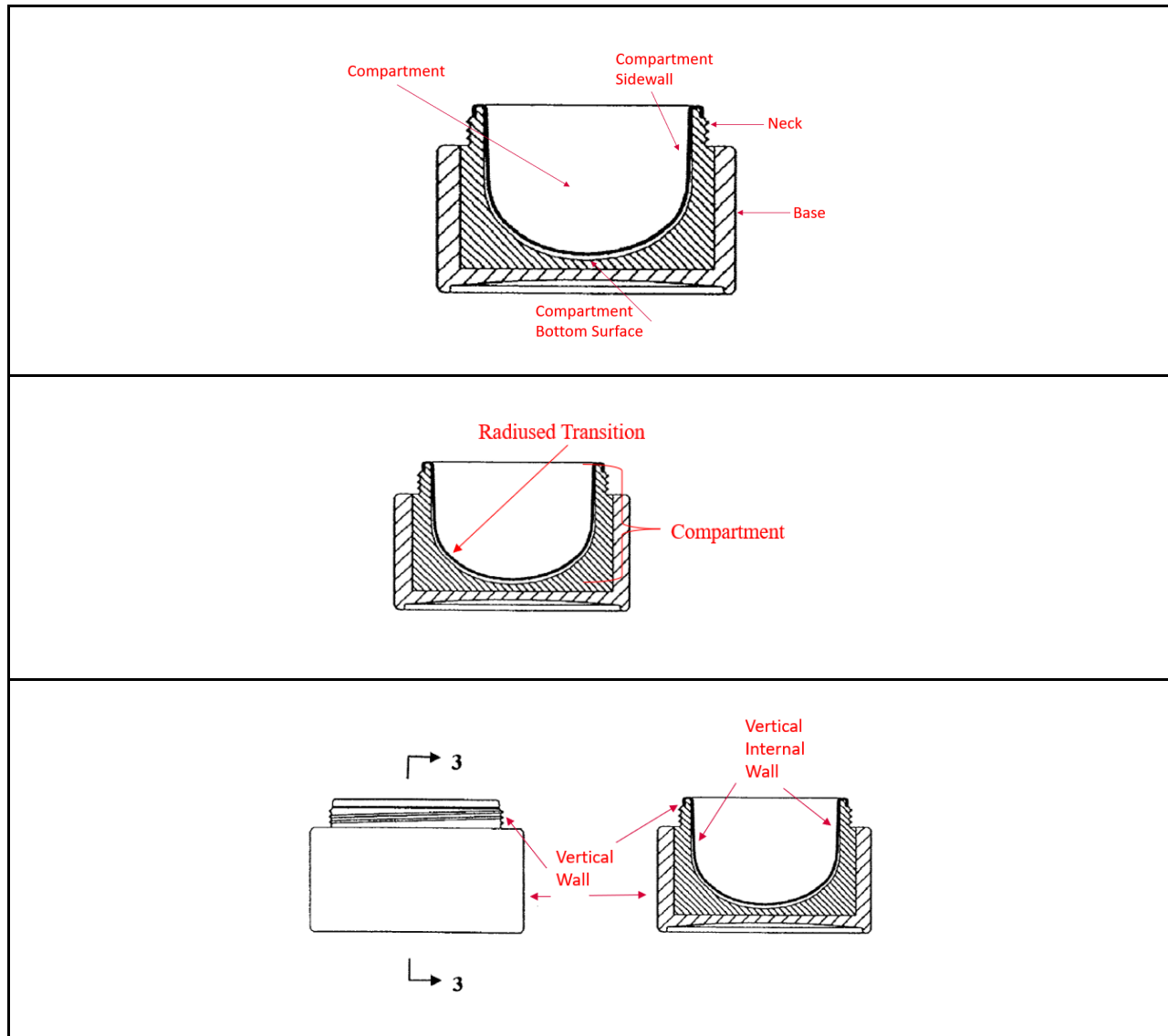


Shown below are annotated figures of Canamasas Puigbo. EX1011 ¶70.

Canamasas Puigbo illustrates a bottle having a tubular base portion, a concentrically located tubular neck portion disposed on top of the top horizontal flat surface of the tubular base portion, and a compartment disposed within the base and neck portions accessible through a circular opening at the top of the neck portion. *Id.* at ¶¶71-72. As can be seen from the images, the tubular base portion has a greater diameter than the neck portion. *Id.* The tubular base portion includes flat horizontal top and bottom surfaces, and a flat exterior sidewall. *Id.* The transition between the vertical exterior sidewall of the base portion and the respective top and bottom surfaces is curved. *Id.* The drawings show the neck portion includes only one material while the base portion is formed by two materials, one of which is the same unitary piece as the neck portion. *Id.*

## Annotated Drawing – Canamasas Puigbo





The external surface of the concentrically located neck portion includes threads to allow the attachment of a cap. *Id.* at ¶73. The neck portion further includes a top horizontal flat surface perpendicular to the internal and external vertical tubular sidewalls, and which also defines a circular opening for the compartment. *Id.* The drawings illustrate a curved transition from the vertical sidewalls to the top surface. *Id.*

Disposed within both the base and neck portions is the compartment. *Id.* at ¶¶73-74. The compartment extends from a tubular opening at the top end of the neck portion into the base portion. *Id.* The compartment includes a curved or sloped transition from its sidewalls to the bottom surface of the compartment, which is concave relative to the interior of the compartment. *Id.*

#### **4. McKernan Jar**

The McKernan Jar qualifies as prior art because printed publications evidencing the Jar were available as early as February 2012, and further confirmed as of October 2013. *See* EX1003 at 431-439; EX1025; EX1026. Certain printed publications showing the McKernan Jar were considered during the reexamination of 'D151 but under the now defunct *Rosen-Durling* test. Also, during reexamination of 'D151, Lerman conceded that the McKernan Jar is prior art to 'D151 by failing to challenge the assertion of the McKernan Jar as prior art at any point during the reexamination.

The McKernan Jar (EL-28595) image of the jar was published on October 30, 2013 on McKernan's online website. EX1003 at 436; EX1025. That is evidenced by the header shown in both the Reexamination Exhibit B3 (EX1003 at 436) and the enhanced color image EX1025 (noting capture date of October 30 2013 for McKernan.com/store website (reproduced below)). Further, Exhibit B3 identifies its URL as including "20131030045106", which establishes, as explained

by the declaration supporting other Internet Archive documents, that the image was captured October 30, 2013 at 4:51:06 a.m. *See also* EX1022 ¶5. Similarly, Reexamination Exhibit B1 (EX1003 at 431-432) publication with its image is further corroborated by EX1026, which includes a URL identifying that the webpage was captured by the Internet Archive on June 6, 2015 at 1:50:50 p.m. *See* EX1026 (capture date June 6, 2015); *see also* EX1022 ¶5.<sup>4</sup>



**EX1025 (annotated)**

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<sup>4</sup> Should *inter partes* review be instituted, to the extent necessary, Petitioner will seek a declaration to further establish the publication dates of EX1025-26.

## Design Center McKernan Adds Low Profile, Frosted Glass Jars

June 1, 2012



### Related Design Center

- [Lindal's New Ball Valve Now Available Globally](#)
- [MWV's MiniMod Offers Portability and Convenience](#)
- [Epopack's PET Heavy Wall Bottle Looks Like Glass](#)
- [ABA Packaging Stocks Blue Glass Bottles and Droppers](#)

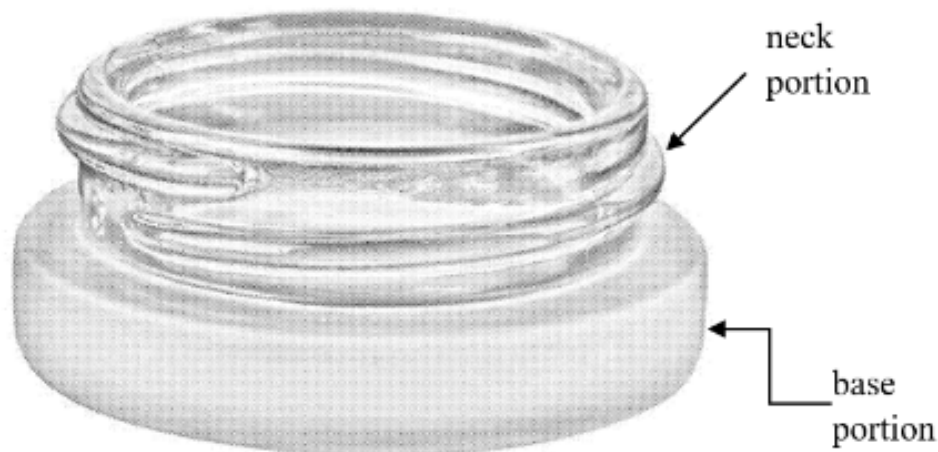
McKernan Packaging has added a 7ml frosted glass jar to its continuous stock inventory. This jar is offered with a metal unishell, brushed silver closure in a 38/400 finish with a foam liner. It is ideal for lipgloss, blush, eye creams and numerous other cosmetic products. The frosted jar is currently in stock and ready to ship with no lead times and is also available in flint. The caps are available in custom high gloss or matte colors. Call (800) 787-7587 or (775)-356-6111 to talk to a McKernan Packaging professional about more info on this jar and closure.

More info: [www.mckernan.com](http://www.mckernan.com)

<https://web.archive.org/web/20150606135050/http://www.beautypackaging.com/issues/201...>

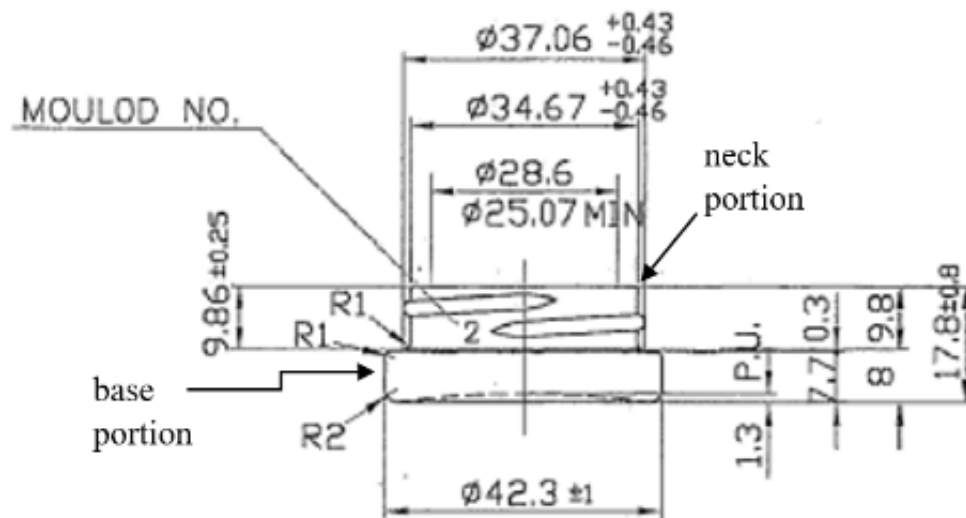
### EX1026 at 1-2

As seen below (annotated), the McKernan Jar is a glass jar with a frosted base portion and a neck portion that includes threading. EX1003 at 436. The base portion is wide and truncated while the neck portion is narrower and taller than the base portion. *Id.*



### EX1003 at 436

Below is a part drawing of the McKernan Jar (shown with annotations). *Id.* at 438. This part drawing, dated March 2011, corresponds to the product identified in the catalog published in 2013 (*compare* EX1003 at 435-46, EX1025 (identifying “EL-28595” as the product in the URL) *with* EX1003 at 438 (identifying “EL-28595” as the DWG NO.)) shows that the base portion has a width 42.3mm as compared to the narrower width of 34.67mm of the neck portion; and shows the height of the base portion of 7.7mm as compared to the taller neck portion which has a height of 9.8mm. *Id.*

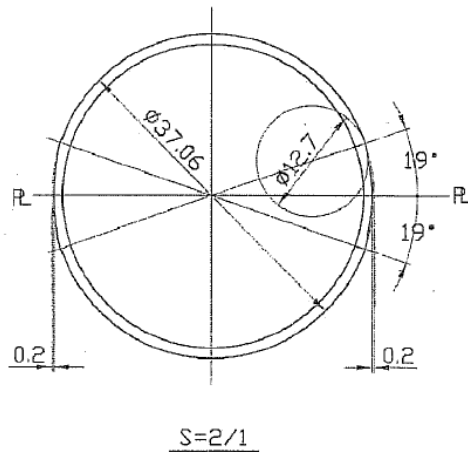


**EX1003 at 438<sup>5</sup>**

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<sup>5</sup> If Exhibit B4’s status as a printed publication is challenged, which was conceded during the Reexamination, Petitioner will seek leave to obtain a subpoena and

Below is part drawing of the McKernan Jar showing a top view of the neck portion of the jar. *Id.* at 439.



### EX1003 at 439

Although the above view shows only the neck portion and does not include the base portion of the McKernan Jar, a skilled designer would recognize that the base portion, which has a tubular shape, would present as an outermost circle from a top view of the jar that is concentric with the innermost circle (seen in the view above) that is presented by the neck portion. *See* EX1011 ¶78. That is supported by the above picture and side view of the McKernan Jar which show that the base

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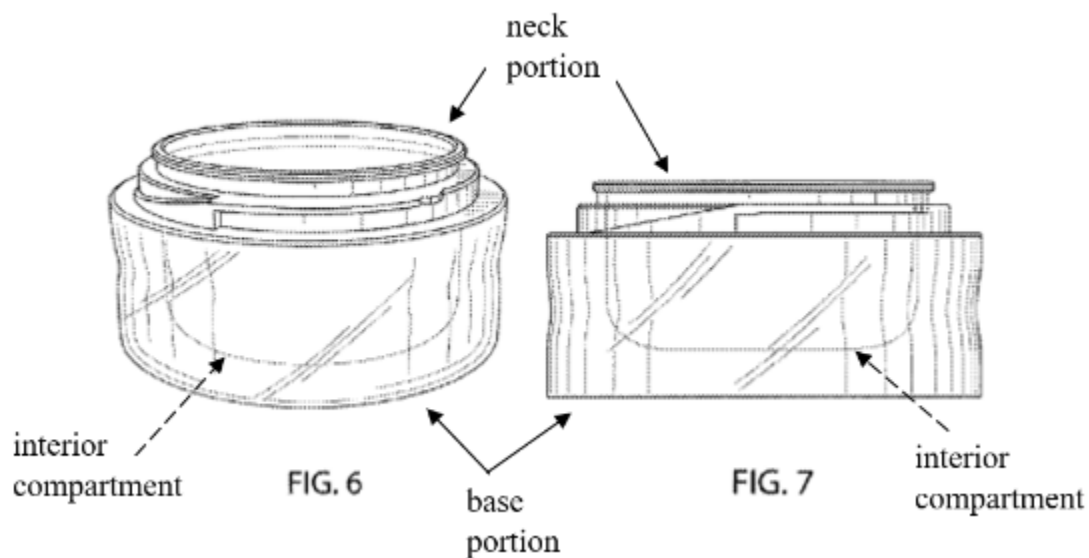
evidence to authentic the document and its accessibility. *See Coastal Indus., Inc. v. Shower Enclosures Am., Inc.*, IPR2017-00573 (Paper No. 27) (Feb. 20, 2018).

portion has a tubular shape and is wider than the neck portion, and that the neck portion is concentric with the base portion. *Id.*

## 5. Zamberlan (“D634,202”)

Zamberlan is prior art because it issued March 15, 2011, before the priority date of 'D151. *See* EX1013 at (45). Zamberlan was considered during the reexamination of 'D151 but under the defunct *Rosen-Durling* test.

Zamberlan discloses a “flask” that includes a base portion and a narrower threaded neck portion. *Id.* at (54). Figs. 6 and 7 of Zamberlan are top perspective and front elevation views, respectively, of the flask. *Id.* at [Description] and Figs. 6 and 7.



**EX1013, Figs. 6 and 7**

As seen in Figs. 6 and 7, the flask is transparent thereby revealing an interior bowl-shaped compartment. EX1011 ¶81.

**B. Statutory Grounds of Invalidity**

Petitioner submits that the claim of 'D151 is invalid in view of all, and at least one, of the following grounds of invalidity.

**Ground 1:** Invalid as obvious under AIA 35 U.S.C. § 103 in light of the Neutrogena and Canamasas Puigbo and the knowledge of a designer of ordinary skill in the art.

**Ground 2:** Invalid as obvious under AIA 35 U.S.C. § 103 in light of Huang, Canamasas Puigbo, and Zamberlan and the knowledge of a designer of ordinary skill in the art.

**Ground 3.** Invalid as obvious under AIA 35 U.S.C. § 103 in light of Huang and Neutrogena and the knowledge of a designer of ordinary skill in the art.

**Ground 4:** Invalid as obvious under AIA 35 U.S.C. § 103 in light of the McKernan Jar in view of Zamberlan and the knowledge of a designer of ordinary skill in the art.

## **V. STATEMENT OF REASONS FOR THE REQUESTED RELIEF**

### **A. Statement of Precise Relief Requested**

Pursuant to 37 C.F.R. §42.104(b), Petitioner respectfully requests *inter partes* review of the claim of 'D151 under 35 U.S.C. §§ 311 – 318 and 37 C.F.R. §§ 42.100 – 42.123, and cancellation as being unpatentable under 35 U.S.C. § 103.

### **B. Claim Construction**

The claimed design is an ornamental design for a jar, as shown and described. *See* EX1001 [Claim]. 'D151 explicitly disclaims portions of the illustrated designs by stating: “The broken lines shown in the drawings are included for the purpose of illustrating portions of the article that form no part of the claimed design.” *Id.* at <Description>. For the purposes of this proceeding, no explicit construction is required for the claims; however, the PTAB’s prior descriptive interpretation of the claimed subject matter is informative, but not definitive.<sup>6</sup> *See, e.g.,* EX1003 at 16-17; EX1011 ¶¶46-47.

In the Decision, the PTAB did not construe the claim, but simply noted Lerman’s Appeal brief as asserting the 'D151 jar has a wide and thick circular base, a tall narrow circular neck extending upwardly from the base, wherein the

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<sup>6</sup> Petitioner reserves the right to advocate a different claim interpretation in any other proceeding if necessary.

base and neck are concentric and the base encompasses about 40% of the total height of the jar, e.g., a slightly taller neck portion than base portion. *See* EX1003 at 16; EX1011 ¶47. In addition, the PTAB found that 'D151 was transparent having an exteriorly visible interior storage chamber extending from the top of the neck and partially into the base. *See* EX1003 at 17.

### **C. Designer of Ordinary Skill**

For purposes of this proceeding, Petitioner submits that a person or designer of ordinary skill in the art (“DOSITA”) at the time of the alleged invention of 'D151 who designs relevant articles would have had a minimum of a bachelor's degree in Industrial Design, Mechanical Engineering, or related field and approximately 5 years of professional experience in the field designing consumer products. EX1011 ¶48. However, additional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education. Thus, the more experience one has in a relevant field, the less formal education that may be required in order to attain the level of ordinary skill in the art, and vice versa. *Id.*

### **D. Brief Summary of Reasons for Relief Requested**

The grounds of invalidity presented in this Petition have not been before the PTO previously or have not been considered under the *LKQ* standard as provided by the Updated Guidance and Examination Instructions for Making a

Determination of Obviousness in Designs in Light of *LKQ Corp. v. GM Global Technology Operations LLC* dated May 22, 2024 (“Guidance”). Importantly, this Petition is supported by the expert testimony of Mr. Fletcher, which was not previously available to the PTO in consideration of ’D151 and provides explicit motivation to either combine or modify the references.

The identified grounds of invalidity each include primary references that disclose essentially the same ornamental features arranged in the same manner and tied to the same commercial article as claimed in ’D151, such that the primary references are basically the same as ’D151. These references convey the same overall visual appearance as ’D151 allowing visibility of internal contours of the compartment through their either transparency or openness at the top of the compartment. The identified secondary references are further very similar in design, ornamental aspects, and aesthetics to the respective primary reference that they are essentially the same as the primary reference and therefore provide an additional motivation to a DOSITA to apply the ornamental design elements of the secondary reference into the primary reference. Further, a DOSITA would have independent motivations to incorporate known design elements of the background art and secondary references into the primary reference. Finally, to the extent that any difference remains, any such difference would have been obvious and/or *de*

*minimis* and not independently confer patentability onto 'D151. As explained below, at least for these reasons, the claim of 'D151 is invalid as obvious.

## **VI. LEGAL STANDARDS FOR INVALIDITY**

The Federal Circuit abrogated the *Rosen-Durling* test requirement in its recent *en banc* decision in *LKQ Corp. v. GM Global Technology Operations LLC*, 102 F.4th 1280 (Fed. Cir. 2024). The Commissioner for Patents issued an updated Guidance, in which it enumerated the factual inquiries that must be made in determining obviousness in the context of design patents. Under this Guidance, the design claim at issue is obviousness in light of the art relied on.

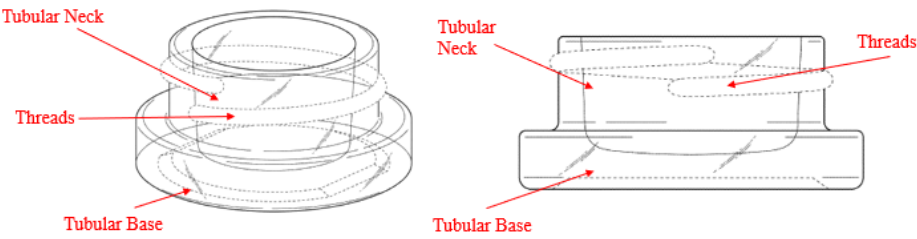
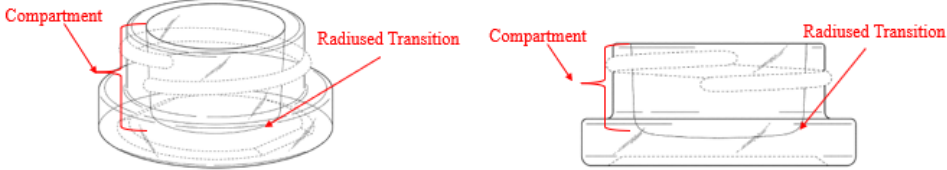
## **VII. SPECIFIC IDENTIFICATION OF WHERE EACH ELEMENT OF THE CLAIM IS DISCLOSED IN PRIOR ART PATENTS AND PRINTED PUBLICATIONS**

### **A. Ground 1: Neutrogena in View of Canamasas Puigbo**

The 'D151 is invalid because a DOSITA that designs containers/jars would have found 'D151 to have been obvious by Neutrogena as modified by Canamasas Puigbo and with knowledge of a DOSITA as of the priority date of 'D151. Neutrogena constitutes “something in existence,” and visually similar to the design claim. Guidance at 2. Canamasas Puigbo is in the same field of endeavor as Neutrogena and would have provided motivation for a DOSITA to modify Neutrogena.

As illustrated below, Neutrogena is visually similar to the design claim .

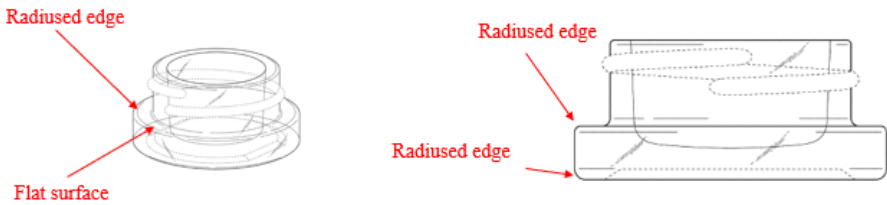
EX1011 ¶¶83-84; *see also* EX1014; EX1015; EX1016; EX1017.

| Reference  | Image                                                                                |
|------------|--------------------------------------------------------------------------------------|
| 'D151      |    |
| 'D151      |    |
| Neutrogena |  |
| Neutrogena |  |

Both Neutrogena and the design claim relate to a transparent container having a wide and thick tubular (or circular) base and a narrower tubular neck

portion extending upwardly from the base portion, with the neck porting being concentrically located. EX1011 at ¶85. They both further include an exteriorly visible interior compartment extending from the top of the neck and partially into the base. *Id.* The vertical sidewalls of each define the compartment transition via curved edges to a slightly concave bottom surface of the compartment located in the base portion of the container. *Id.*

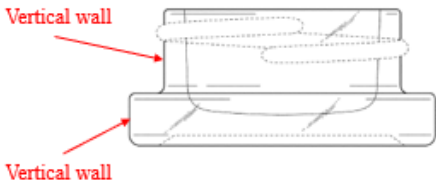
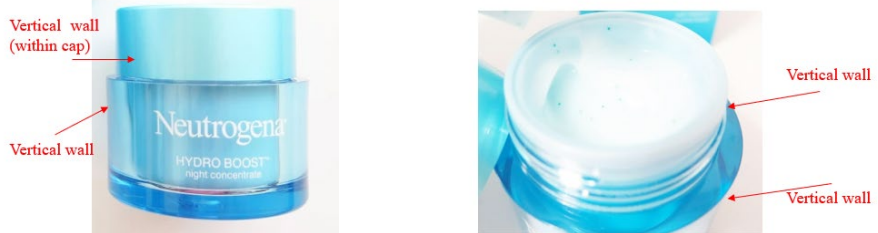
As shown below, a DOSITA would find that Neutrogena is visually similar to the design claim. *See id.* at ¶86.

| Reference  | Image                                                                                |
|------------|--------------------------------------------------------------------------------------|
| 'D151      |  |
| Neutrogena |  |

Starting at the base portion, Neutrogena discloses curved edges at the external surface transitions from sidewall to horizontal top and bottom surfaces, just like 'D151. *See id.* at ¶¶86-87. Further, the base portion is transparent and

wider than the neck portion of the container, and only optical reflections make the solid bottom of base portion appear a darker shade of blue (still transparent). *Id.*

As further shown below, the transparent tubular neck portion of Neutrogena is also visually similar to the design claim. *Id.* at ¶87. The transition between the base portion and the neck portion on the top surface of the base portion is curved. *Id.* Further, the neck portion of Neutrogena, like the design claim, possesses essentially vertical external sidewalls parallel to the external sidewalls of the base portion. *Id.* Finally, like the design claim, Neutrogena is designed for use with a lid as both include threads positioned on the exterior surface of the neck portion. *Id.*

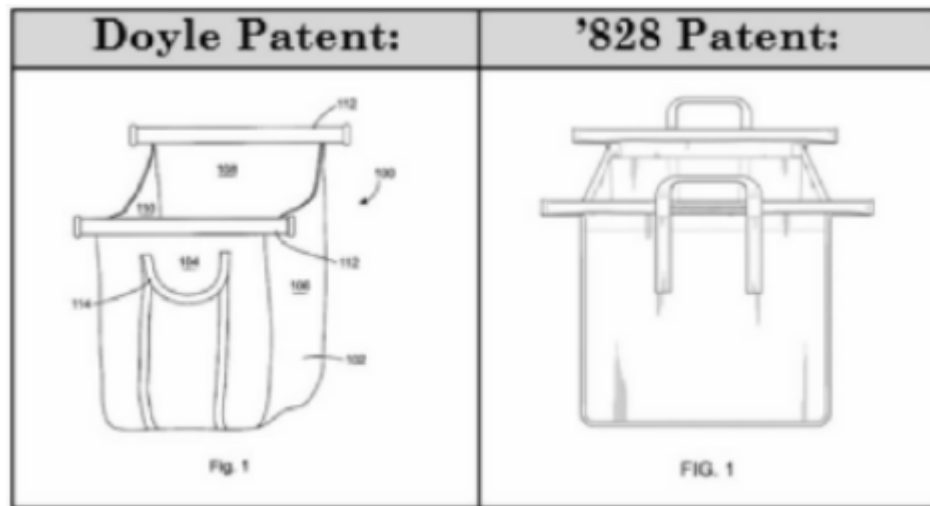
| Reference  | Image                                                                                |
|------------|--------------------------------------------------------------------------------------|
| 'D151      |  |
| Neutrogena |  |

Further, both include a compartment disposed concentrically within the neck portion and extending into the base portion. *Id.* at ¶88. Like the design claim, Neutrogena’s compartment is defined by a circular opening at the top of the neck portion, with the compartment demarcated by essentially vertical sidewalls internal to the neck and base portions. *Id.* The contours can be seen through the sidewalls. *Id.* Finally, Neutrogena’s compartment has a slight concavity to its bottom surface that is located within the base portion with curved transition between the sidewalls and bottom surface. *Id.* Neutrogena further includes an interior liner within the compartment, but an interior liner is not disclaimed by ’D151 and the container of Neutrogena (*sans* liner) still displays the same overall visual appearance including transparency and openness. *Id.*; *see also Samsung Electronics Co., Ltd. v. Apple Inc.*, 580 U.S. 53, 60 (2016) (“The Patent Office and the courts have understood § 171 to permit a design patent for a design extending to only a component of a multicomponent product.”—reversing Federal Circuit’s holding that “article of manufacture” must be the end product sold when the end product is a multicomponent product and the ornamental design is affixed only to one of the components).

In addition to the individual elements, the totality of each reference further illustrates the shared same overall visual appearance. *Id.* at ¶89. Both containers

are transparent and open at the top. *Id.* The blue tint to Neutrogena is understood to be transparent to a DOSITA. *Id.*

Slight differences, like the neck of 'D151 being taller than the base portion, do not preclude a finding that Neutrogena is not visually similar. *See Golden Eye Media USA, Inc. v. Evo Lifestyle Prods. Ltd.*, No. 2021-2096, 2022 WL 2232517, at \*4 (Fed. Cir. June 22, 2022). In *Golden Eye*, the Federal Circuit affirmed the lower court's finding that the Doyle reference was "basically the same" as the asserted patent (side-by-side comparison provided below). *Id.*



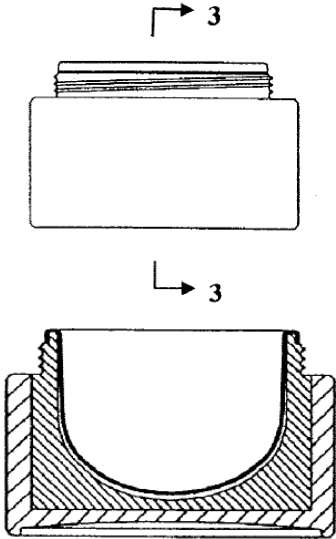
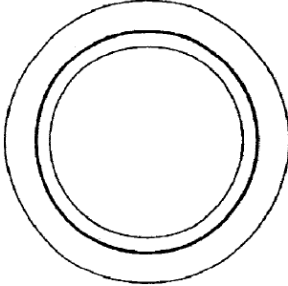
Under the now defunct *Rosen-Durling* test, the Federal Circuit held that the “district court's conclusion is consistent with our precedent where we have found that primary references may contain slight differences relative to a patented design.” *Id.* Importantly, slight differences can include dimensions of the primary reference and the challenged patent. In *Campbell Soup Co. v. Gamon Plus, Inc.*,

939 F.3d 1335 (Fed. Cir. 2019), the court – again using the restrictive *Rosen-Durling* test – vacated the Board’s factual finding that a reference was not a proper primary reference because of the dimensional differences between the primary reference and the challenged patent. *Id.* at 1341. The court held that “the ever-so-slight differences in design, in light of the overall similarities, do not properly lead to the result that Linz is not a single reference that creates basically the same visual impression as the claimed designs.” *Id.* (quotations omitted).

Similarly, in this case, a DOSITA would recognize any differences as “slight.” For example, Neutrogena and the design claim are both intended for use with a cap or lid that can cover the neck portion. EX1011 ¶90. It would be a functional design element to optimize the height and diameter of the neck portion to correspond to the cap. *Id.* Similarly, it would be a functional design element to optimize the volume of the compartment. *Id.* And further, it would also be a minor functional design option to optimize the overall height of the neck portion for providing a tool to access and extract contents from the compartment, such as, for example, a nail polish cap having an integrated brush for nail polish containers. *Id.*

Based on the similarities discussed above, a DOSITA would find that Neutrogena illustrates the same overall visual appearance as ’D151.

A DOSITA would have been motivated to modify Neutrogena – to the extent necessary – with Canamasas Puigbo. *Id.* at ¶91. While there is no requirement that the primary and secondary references need to be “so related,” in this case they are as shown below.

| Neutrogena                                                                          | Canamasas Puigbo                                                                     |
|-------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------|
|   |   |
|  |  |

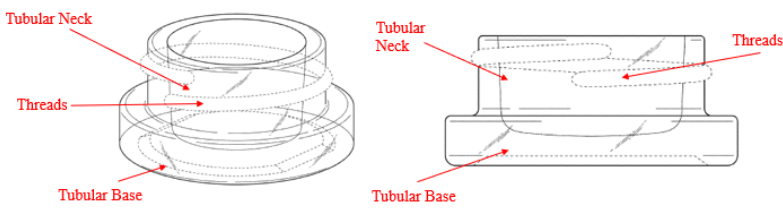
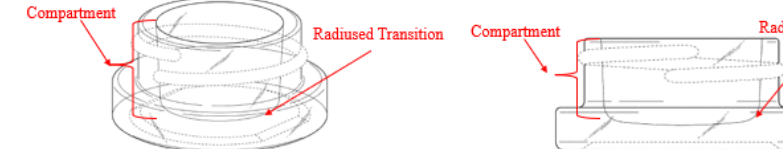
Canamasas Puigbo relates to the ornamental design for a bottle, which would be considered by a DOSITA to overlap with the article of Neutrogena. As demonstrated from different views, Neutrogena and Canamasas Puigbo illustrate the same article having the same overall design. EX1011 ¶92.

As demonstrated from above, both references include the same tubular base portion, tubular neck portion, and compartment disposed within the neck portion and extending downwardly partially into the base portion. *Id.* In addition, both articles incorporate curved edge transitions throughout the design, including at the external edges of the base portion, the external edges of the tubular neck portion, and the transition from the vertical walls to bottom surface of the compartment. *Id.* Moreover, in both designs the tubular neck portion has a smaller diameter than the tubular base portion. *Id.* The mere similarity in design would therefore provide motivation for a DOSITA to incorporate design features from Canamasas Puigbo into Neutrogena. *Id.*; see also *MRC Innovations, Inc. v. Hunter Mfg.*, 747 F.3d 1326, 1334 (Fed. Cir. 2014).

Although Neutrogena discloses a transparent container, while Canamasas Puigbo illustrates an opaque container, such minor difference would not dissuade a DOSITA from finding the designs sufficiently related to apply design features from one to the other. A DOSITA would be able to view the entirety of both objects (internal and external contours) due to the circular opening of the

compartment and design of the compartment to be fully viewable from a top perspective (*e.g.*, the compartment volume is defined by the vertical interior sidewalls). EX1011 at ¶¶92-93. Moreover, both references disclose threads on the external surface of the tubular neck portion, which may be used to attach a transparent or opaque cap to the design, thereby rendering additional aspects opaque or transparent to end users. *Id.* Hence, a DOSITA would be motivated to include design aspects of Canamasas Puigbo – to the extent necessary – to the design of Neutrogena.

As illustrated below, Neutrogena alone discloses or suggests essentially each design element claimed in 'D151 in the same configuration and orientation. A DOSITA would have been motivated to modify Neutrogena – if necessary – with Canamasas Puigbo and background experience and knowledge, which would render 'D151 invalid as obvious. *See id.* at ¶94.

| Reference | Image                                                                                |
|-----------|--------------------------------------------------------------------------------------|
| 'D151     |  |
| 'D151     |  |

|                         |                                                                                       |
|-------------------------|---------------------------------------------------------------------------------------|
| <b>Neutrogena</b>       | <div data-bbox="427 268 776 495"> </div> <div data-bbox="898 275 1360 489"> </div>    |
| <b>Neutrogena</b>       | <div data-bbox="427 548 797 831"> </div> <div data-bbox="927 552 1338 781"> </div>    |
| <b>Canamasas Puigbo</b> | <div data-bbox="534 867 777 1136"> </div> <div data-bbox="1036 911 1312 1087"> </div> |

As discussed above, Neutrogena discloses the same overall shape and configuration of 'D151. EX1011 ¶95. Neutrogena is a transparent container that includes a tubular bottom portion, tubular neck portion, and a compartment disposed within the tubular base and neck portions. *Id.* Further, like the claimed jar, Neutrogena discloses the same curved transitions both internally and externally when making a transition between perpendicular or essentially perpendicular surfaces. *Id.* And, like the claimed jar, Neutrogena discloses a concentrically located tubular neck portion narrower than the base and having a

concentrically located circular opening for the internal compartment. *Id.* The Neutrogena internal compartment contains essentially vertical walls defining the compartments, and curved transitions to a slightly concaved bottom surface located in the base portion. *Id.*

To the extent patentee argues that Neutrogena does not explicitly show a top surface of the neck portion being flat with curved edges due to the interior lining in the images, a DOSITA would understand that the top surface of the tubular neck portion is flat and contains radiused edges not only because it is shown but such a design would conform with the overall design of the container. *Id.* at ¶96. In addition, a DOSITA would have been motivated to design a jar having a flat top surface of its neck portion and a radiused transition to the internal and external sidewalls. *Id.* at ¶¶96-97 (citing Canamasas Puigbo). The mere similarity between Neutrogena and Canamasas Puigbo would motivate a DOSITA to apply the flat horizontal top surface of Canamasas Puigbo neck portion to Neutrogena. *Id.* Moreover, such a minor modification (to the extent even necessary) would not change the overall design of Neutrogena. *Id.* Also, practical considerations, such as comfort, safety, and leak-prevention would have motivated a DOSITA to have incorporated a flat top surface being having radiused edges to the internal and external vertical sidewalls. *Id.* Having a flat surface would serve to properly seal the contents with a cap during travel and storage. *Id.* And sharp edges could lead

to inadvertent injuries especially for use of the Neutrogena contents that appear to be targeting use with a finger. *Id.*

Similarly, to the extent Patent Owner argues Neutrogena fails to explicitly show a container having a concave bottom surface, a DOSITA would have been motivated to incorporate a slightly concave surface for at least the simple function of pooling the contents to ensure use of and accessibility to all of the contents, especially in this case where the Neutrogena contents that appear to be targeting use with a finger. *Id.* at ¶¶97-98. In addition, a DOSITA would understand that it would be more aesthetically pleasing to include a minor radius of curvature of a concave bottom surface, especially in light of the tubular design of the Neutrogena container. *Id.* at ¶98. For example, a DOSITA would have seen other examples, like Canamasas Puigbo, explicitly disclosing a concave bottom surface of a compartment. *Id.* As noted above, the similarities in design would motivate a DOSITA to apply the concave bottom surface of the compartments known in the art (e.g., Canamasas Puigbo) to Neutrogena. *Id.* at ¶97; *see also MRC Innovations*, 747 F.3d at 1334. Not only would such a modification not affect any other design aspect of Neutrogena, but a DOSITA would have understood that different degrees of radius for the concave bottom surface would be a design choice for volume and accessibility to the contents, especially together with the radiused transition between the sidewall and bottom surface. EX1011 ¶98.

Moreover, the height of the neck portion would directly functionally impact the volume within the compartment, and therefore, adjusting the length of the neck would directly adjust the volume contained in the compartment. *Id.* at ¶¶99-100. For example, reduced shelf space (footprint) for the same amount of product. *Id.* To the extent that the length of the neck is not a functional aspect, modifying the proposed combination to incorporate a taller neck portion relative to the base portion would have been obvious to a DOSITA to adjust the volume within the compartment to either aesthetically illustrate additional product without providing additional product in the compartment, or to correspond to the cap dimensions, which would be a designer's consideration as the proposed hypothetical combination is intended for use with a cap, as shown by the threaded drawings of 'D151; an elongation of the neck would also provide for the ability to include an accessibility tool in the cap. *Id.* Such a modification of the proportional height would have been minor and not have resulted in any material alteration to other design features of the hypothetical combination. *Id.*; *see also KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 407, 415-21 (2007).

For the reasons above, the expressed modifications would be considered *de minimis* by a DOSITA and driven by obvious design choices. Indeed, the Federal Circuit has acknowledged that design patents can be invalidated "despite the inclusion of ornamental features that were entirely absent from prior art designs."

*MRC Innovations*, 747 F.3d at 1334; (citing *In re Nalbandian*, 661 F.2d 1214, 1217 (C.C.P.A. 1981) (different shape of fluting on finger grips and different shape of pincers were *de minimis* differences in design for tweezers); *In re Carter*, 673 F.2d 1378, 1380 (C.C.P.A. 1982) (modifications to the waistband of an infant garment); *In re Chung*, 243 F.3d 561, No. 00-1148, 2000 U.S. App. LEXIS 24916, 2000 WL 1476861, at \*3 (Fed. Cir. Oct. 4, 2000) (two small depressions in the design of a cigarette package); *In re Cooper*, 480 F.2d 900, 901-02 (C.C.P.A. 1973) (affirming Board's conclusion that numerous changes to the design of a prior art building—including a single rather than double door and the addition of windows—were *de minimis* because the overall impression was still a building that looked like a barrel)). Thus, to the extent a specific ornamental feature is not found in the prior art does not prevent a finding of obviousness of 'D151.

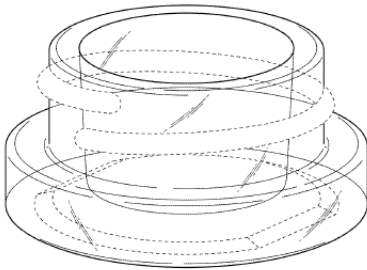
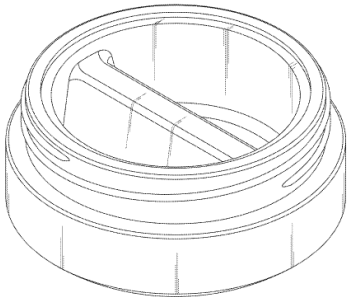
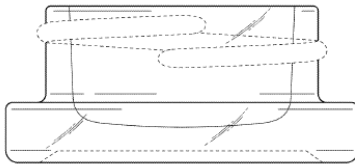
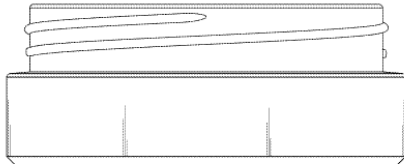
For at least the above reasons, a DOSITA would have found 'D151 obvious in view of Neutrogena and Canamasas Puigbo and the background knowledge of a DOSITA. EX1011 ¶101.

**B. Ground 2: Huang in View of Canamasas Puigbo in further view of Zamberlan Renders Obvious 'D151**

A DOSITA would find 'D151 obvious in view of Huang and Canamasas Puigbo further in view of Zamberlan together with the background and experience of the DOSITA. Huang discloses an article that is visually similar to the design claim. Moreover, Huang, Canamasas Puigbo, and Zamberlan are so related –

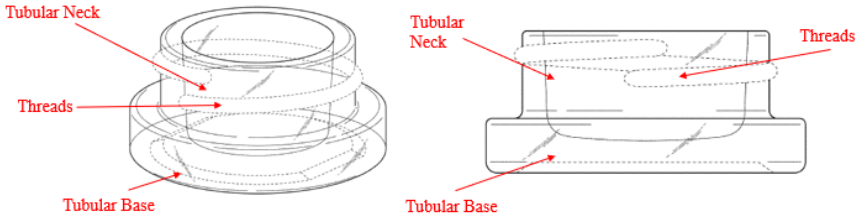
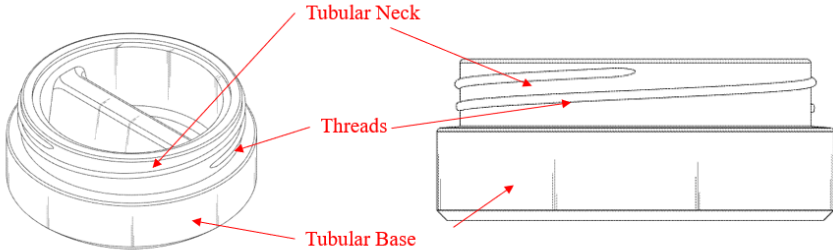
though not required post *Rosen Durling*– and provide a DOSITA suggestion to apply the features of Canamasas Puigbo and Zamberlan’s transparency to Huang. Additionally, other considerations would further motivate a DOSITA to apply features of Canamasas Puigbo to Huang.

As shown below, a DOSITA would have considered Huang as visually similar to the design claim. See EX1011 ¶¶102-03.

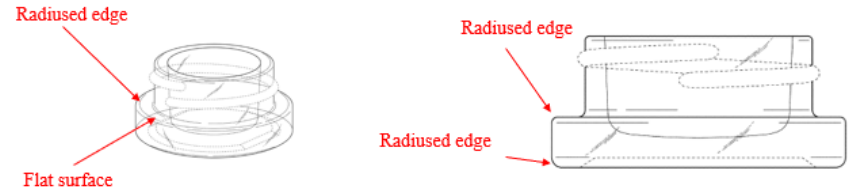
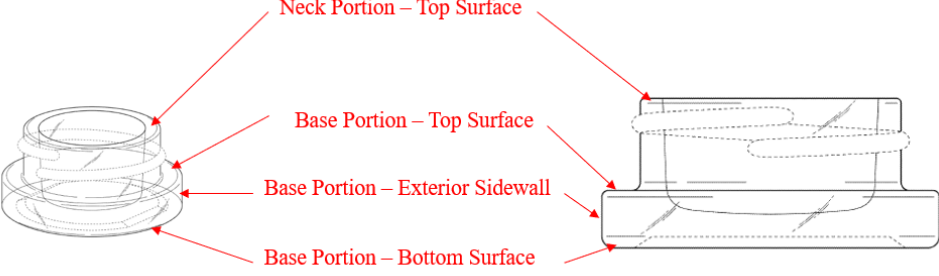
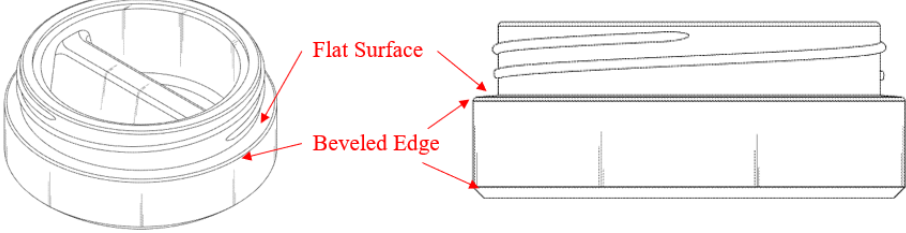
| Figure # | 'D151                                                                               | Huang                                                                                |
|----------|-------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------|
| 1        |   |  |
| 2        |  |  |

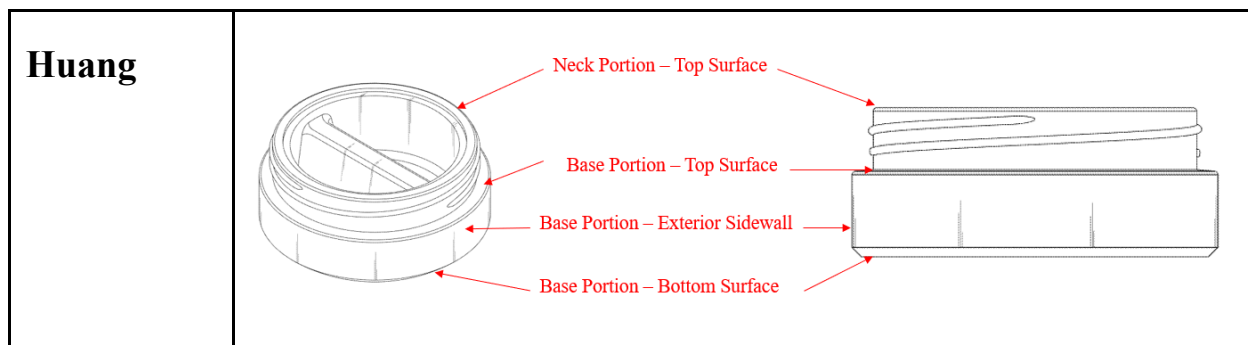
Huang is a prior art reference that was in existence. See *MRC Innovations*, 747 F.3d at 1331. Moreover, both Huang and 'D151 are in the same field as being drawn to ornamental features of the same article, *i.e.*, jar. Compare EX1007 with EX1001; EX1011 ¶103.

The overall visual impression of Huang represents an open and accessible container including tubular base and neck portions and a compartment, where the tubular neck portion is concentrically positioned on the top surface of the tubular base portion and together with the base portion defines an internal compartment open at the top of the container. *See* EX1011 ¶103. Huang, like 'D151, has a base portion with a greater diameter than the neck portion, with the tubular neck portion extending vertically from the top surface of the base portion, as shown below in annotated comparison figures. EX1011 ¶104. Both 'D151 and Huang illustrate threads. EX1011 ¶¶104-05.

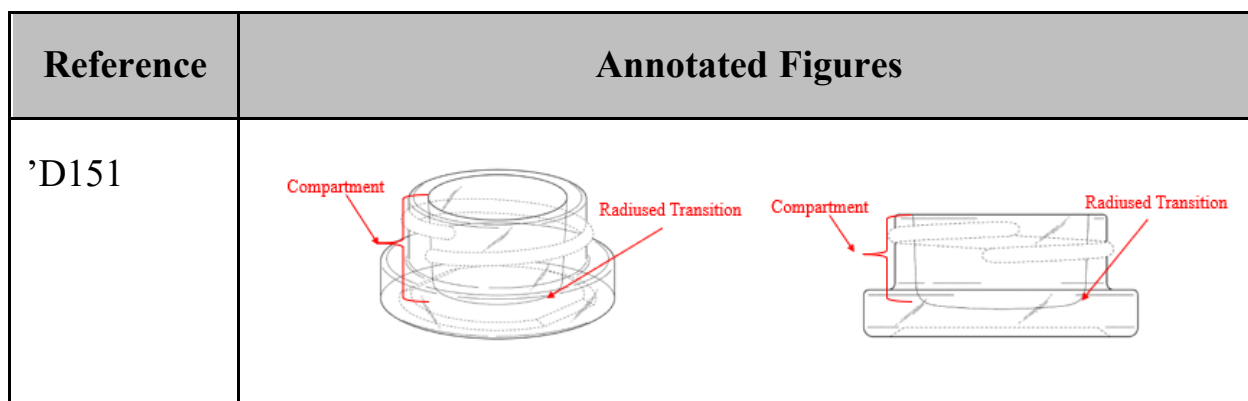
| Reference | Annotated Figures                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                               |
|-----------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 'D151     |  <p>The figure for 'D151 consists of two line drawings. The left drawing is a perspective view of a container with a wider 'Tubular Base' and a narrower 'Tubular Neck' on top. Red arrows point to the 'Tubular Neck', 'Threads' (on the neck), and 'Tubular Base'. The right drawing is a side cross-sectional view showing the internal structure, with red arrows pointing to the 'Tubular Neck', 'Threads' (on the neck), and 'Tubular Base'.</p>      |
| Huang     |  <p>The figure for Huang also consists of two line drawings. The left drawing is a perspective view of a container with a wider 'Tubular Base' and a narrower 'Tubular Neck' on top. Red arrows point to the 'Tubular Neck', 'Threads' (on the neck), and 'Tubular Base'. The right drawing is a side cross-sectional view showing the internal structure, with red arrows pointing to the 'Tubular Neck', 'Threads' (on the neck), and 'Tubular Base'.</p> |

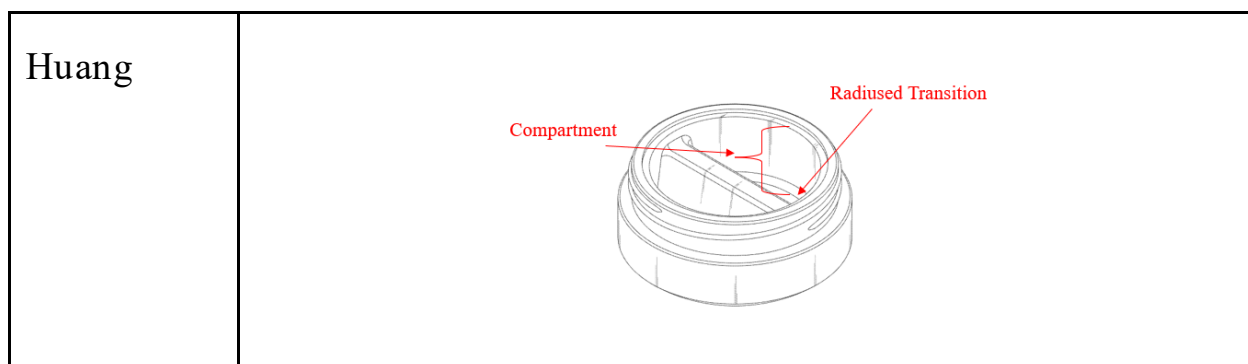
In addition, as shown below, Huang, like 'D151, discloses flat horizontal top surfaces of the tubular base portion and non-cornered transitions of the top and bottom surfaces and the sidewall of the base portion. *Id.* Any difference in the degree of curvature illustrated in the respective drawings would not affect the similarity between the overall visual appearance between the two articles. *Id.* at ¶105.

| Reference | Annotated Figures                                                                    |
|-----------|--------------------------------------------------------------------------------------|
| 'D151     |   |
| 'D151     |  |
| Huang     |  |



Huang and 'D151 also both include internal compartments having circular openings at the top end of the tubular neck portion, which allows an ordinary observer to view the interior contours of the compartments. *Id.* at ¶106. The compartments extend from the top end of the neck portion into the base portion to form the compartment space. *See* EX1011¶¶86, 107. Both 'D151 and Huang also disclose non-cornered transitions between essentially vertical sidewalls defining the compartment and the bottom surface of the compartments. *Id.*





The minor difference in arrangement of 'D151's compartment having one chamber and the dual chamber shown in Huang would not have distracted a DOSITA from the two references having the same overall visual appearance and being basically the same. *Id.* at ¶107. Indeed, single chamber and multiple chamber articles such as 'D151 have been known and used as obvious variants to a DOSITA driven by a number of different functional requirements. *Id.* Moreover, the overall design and dimension of the compartment (absent the divider) is the same as 'D151. *Id.*

Although 'D151 is transparent while Huang is opaque, a DOSITA would have been motivated to include Zamberlan's transparent material to further show the contents of the jar while providing the same visual impression. *Id.* at ¶108. Indeed, DOSITAs at the relevant time were well aware of transparency and would not have determined such a feature to materially differentiate articles that are otherwise fully externally visible. *Id.* Moreover, transparency is a functional feature. *Id.* at ¶¶108, 146. Lerman conceded the functionality of the transparent nature of the claimed design during the reexamination of 'D151 when arguing non-

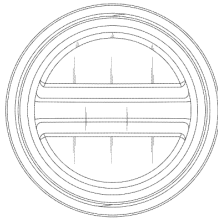
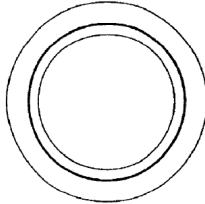
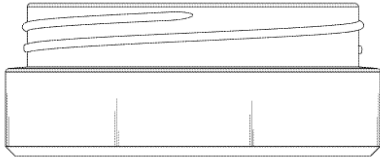
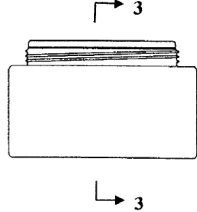
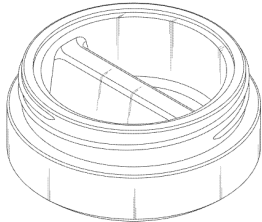
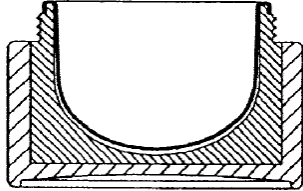
obviousness of the claimed design. *See* EX1003 at 261. Lerman specifically argued that the transparency of the claimed jar allowed “anything stored inside the jar to be readily visible from the outside” and “enhanced child-proof characteristics.” *Id.* As such, the transparency of the design claim should be given little if any patentable weight.

Finally, the neck portion of 'D151 is slightly vertically longer than the height of the base portion. EX1011 ¶109. However, minor adjustments in proportions absent a criticality would not have been seen by a DOSITA to substantially modify the overall visual appearance of the design. *Id.* A DOSITA would recognize that by adjusting the height of the neck portion, the volume of the compartment could be easily adjusted, and hence it would not have affected the similarity of the overall visual appearance between the two designs. *Id.*; *see also id.* at ¶¶90, 99-100, 109. Moreover, the use of a cap would further likely obfuscate the view of the length of the neck. Therefore, it would likely only be considered a functional difference by a DOSITA, and still be found to be basically the same.

A DOSITA would have sought to modify Huang with Canamasas Puigbo and Zamberlan because Huang, Canamasas Puigbo, and Zamberlan are all, amongst other reasons, containers and thus analogous art.

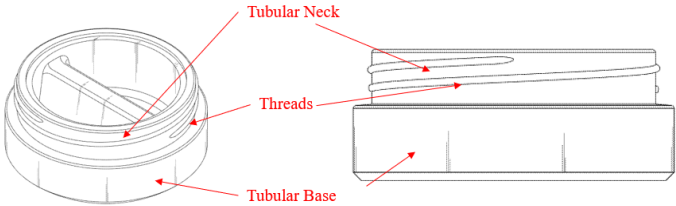
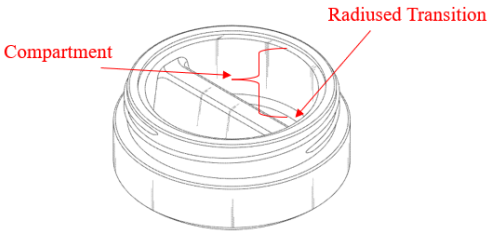
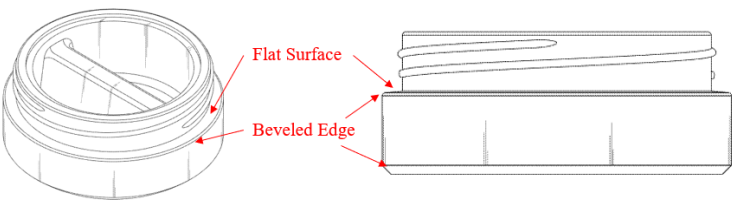
As shown from the top, cross-section view, and front elevation view, Huang and Canamasas Puigbo represent very similar designs for a container, of which the

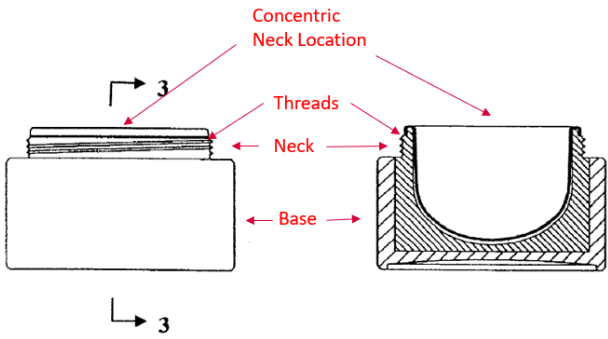
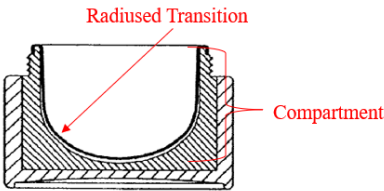
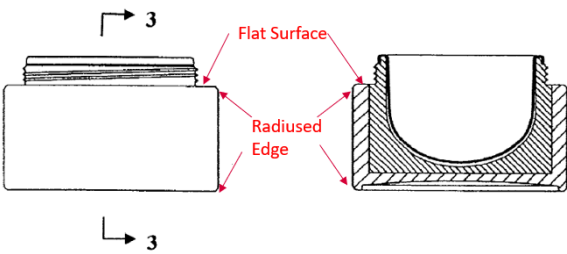
mere similarity is sufficient to motivate a skilled artisan to incorporate features of Canamasas Puigbo into Huang. *See MRC Innovations*, 747 at 1334; *see also* EX1011 ¶111.

| Figure               | Huang                                                                               | Canamasas Puigbo                                                                      |
|----------------------|-------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------|
| Top View             |    |    |
| Front Elevation View |   |   |
| Compartment View     |  |  |

First, Canamasas Puigbo discloses the same overall configuration and is related to the same article, *i.e.*, container/bottle, as Huang. *Id.* at ¶112. Both have tubular base portions, concentrically located tubular neck portions (with threads) projecting from the tubular base portion, and a compartment disposed concentrically to the tubular neck portion that has an open top, vertical side walls,

and radiused edges transitioning to the bottom surface of the compartment. *Id.* Moreover, the respective transition edges of the surfaces also are similarly non-cornered. Thus, the overall design of both references suggests the applicability of elements from Canamasas Puigbo into Huang. *Id.* Annotated comparisons are shown below. *Id.*

| Reference    | Annotated Figures                                                                                                                                                                                                                                                                                                                                                                                                                                                                                      |
|--------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Huang</b> |  <p>This figure shows two views of a container. The left view is a perspective drawing of a cylindrical container with a lid. The right view is a side cross-section of the container. Red arrows point to specific features: 'Tubular Neck' points to the upper rim of the lid, 'Threads' points to the threaded section on the side of the lid, and 'Tubular Base' points to the bottom of the container body.</p> |
| <b>Huang</b> |  <p>This figure shows a perspective view of a container. Red arrows point to specific features: 'Compartment' points to the interior of the container, and 'Radiused Transition' points to the curved edge where the interior surface meets the bottom.</p>                                                                                                                                                        |
| <b>Huang</b> |  <p>This figure shows two views of a container. The left view is a perspective drawing of a cylindrical container with a lid. The right view is a side cross-section of the container. Red arrows point to specific features: 'Flat Surface' points to the top surface of the lid, and 'Beveled Edge' points to the angled edge where the lid meets the container body.</p>                                        |

|                         |                                                                                     |
|-------------------------|-------------------------------------------------------------------------------------|
| <b>Canamasas Puigbo</b> |   |
| <b>Canamasas Puigbo</b> |   |
| <b>Canamasas Puigbo</b> |  |

An additional related and similar element is the location, dimensions, configuration, and design of the compartment disposed within the article. *Id.* at ¶¶112-15. The respective compartments extend from the top and into the base portion, providing for a small amount of solid space below the compartment. *Id.* The annotated figures demonstrate that the sidewalls of the compartment are similarly vertical, tubular, and extend from the top of the neck portion (into the

base portion to form the bottom surface of the compartment after a non-cornered transition). *Id.* A DOSITA would have been motivated to simply substitute Huang's compartment shape with Canamasas Puigbo's. "If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *KSR*, 550 U.S. at 417.

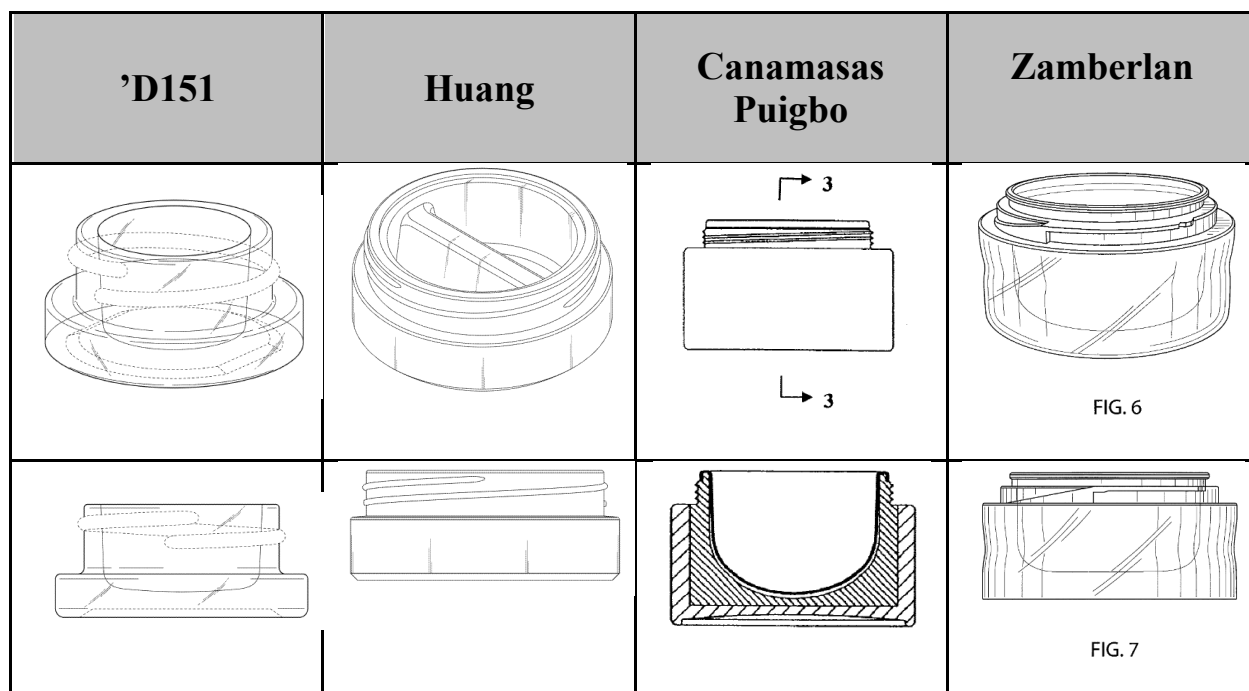
For at least the above reasons, the teachings of Huang and Canamasas Puigbo are *so related* that the appearance of ornamental design features (and functional features), suggests the application of those features of Canamasas Puigbo to the container of Huang. Indeed, as stated by the Federal Circuit, the mere similarity in appearance itself between the two references is sufficient motivation to incorporate features of Canamasas Puigbo into Huang. *See MRC Innovations*, 747 F.3d at 1334.

Such a modification would also not require any additional modifications to the remainder of the article. EX1011 ¶116. A designer further would be motivated to make such a substitution to increase volume within the chamber, provide a wider chamber diameter, ease manufacture, and provide an aesthetically symmetrical appearance of the internal compartment and external tubular container. *Id.* at ¶¶116-17.

Similarly, Zamberlan suggests the application of its transparent feature to the Huang to reveal the contents of the jar. *Id.* at ¶118. A skilled designer with

knowledge of the Zamberlan flask design would have found it obvious to incorporate the transparency of Zamberlan into Huang based on the similarity of the two containers and also to reveal the contents within the interior compartment.

*Id.* Additional known motivations also existed to modify containers of this type to be transparent. For example, a skilled artisan would be motivated to modify the combination to be transparent to improve aesthetic appeal of the design, permit a consumer to view the product within the compartment through the sidewalls, tint the hue to color of the product, and provide a general overall improved visual appeal of the bottle/container. *Id.*



As demonstrated by the Figures above, the substitution of the compartment of Canamasas Puigbo for the compartment of Huang and the opaque material for the transparent material of Zamberlan would not have changed the configuration or dimensions of Huang. *Id.* at ¶¶116-19. In addition, to the extent that Huang does not explicitly disclose sufficiently radiused edges either internally or externally, it would have been obvious to a DOSITA based on either Canamasas Puigbo or background knowledge to modify Huang such that the edges of the bottom tubular portion, transition between top surface of bottom portion and sidewalls of top portion, transition between top portion sidewalls and top surface, and other non-cornered transitions would be radiused transitions. *Id.* at ¶¶116-19. The similarity between Huang and Canamasas Puigbo provides this suggestion to a DOSITA.

Also, it would have been obvious based on known design considerations such as avoiding sharp edges, improving structural integrity, providing better hand feel and visual aesthetic qualities, and such design choices were obvious variations on non-cornered perpendicular transitions. *Id.* Optimization of the degree of curvature would easily be within the skill and ability of a DOSITA. *Id.*

Moreover, a designer would recognize that the height of the neck portion would directly functionally impact the volume within the compartment, and therefore, adjusting the length of the neck would directly adjust the volume of the compartment. *Id.* at ¶¶120-21. However, to the extent that the length of the neck is not a functional aspect, modifying the proposed combination of Huang and Canamasas Puigbo to have a neck portion taller than the height of the base portion would have been obvious to a DOSITA. For example, a DOSITA would be motivated to do so to adjust the volume within the compartment to either aesthetically illustrate more product without providing additional product in the compartment, or to correspond to the cap dimensions. *Id.* Such a modification of the proportional height would have been minor, within the skill of a DOSITA, and not have resulted in any material alteration to other design features of the hypothetical combination. *See KSR*, 550 U.S. at 407, 415-21.

For the reasons discussed above, any modifications would be considered *de minimis* by a DOSITA and driven by obvious design choices. As discussed above

in Section VII.A, the Federal Circuit has acknowledged that design patents can be invalidated “despite the inclusion of ornamental features that were entirely absent from prior art designs.” *MRC Innovations*, 747 F.3d at 1334; (citing *In re Nalbandian*, 661 F.2d at 1217; *In re Carter*, 673 F.2d at 1380; *In re Chung*, 243 F.3d 561, No. 00-1148, 2000 U.S. App. LEXIS 24916, 2000 WL 1476861, at \*3; *In re Cooper*, 480 F.2d at 901-02). Thus, to the extent a specific ornamental feature is not found in the prior art does not prevent a finding of obviousness of ’D151.

**C. Ground 3: Huang in View of Neutrogena Renders Obvious ’D151**

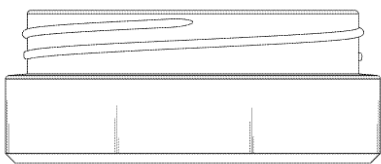
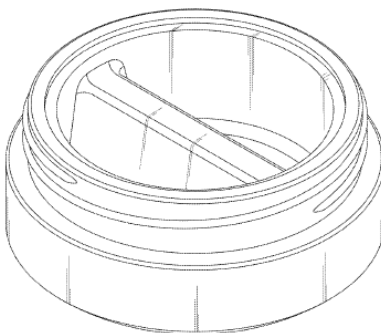
The design claim would have been obvious to a DOSITA based on Huang in view of Neutrogena together with common knowledge.

For the reasons discussed above in Section VII.B, Huang is a proper primary reference because it is visually similar to the design claim. Petitioner herein incorporates by reference in their entirety arguments from Section VII.B. The arguments previously presented concerning primary references are applicable to this ground because under design patent law, primary reference analysis is independent of the secondary reference(s).

Neutrogena is very similar and related to Huang and the mere similarity in design and visual impression would serve as a motivation to a DOSITA to modify Huang to obtain the design disclosed and claimed in ’D151. Moreover, a DOSITA

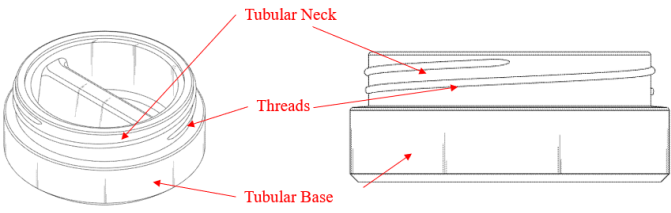
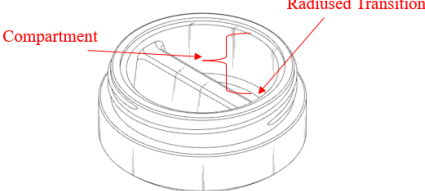
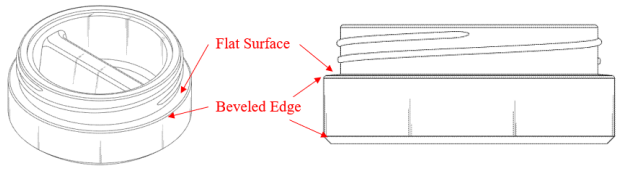
would understand benefits of features disclosed by Neutrogena (discussed above with respect to Ground 1) and seek to incorporate them into the disclosure of Huang, which would result in a hypothetical combination that a DOSITA would recognize renders 'D151 as a whole obvious.

As discussed above, Neutrogena is a transparent container that includes an opaque interior liner located within the compartment and an opaque lid. *Id.* at ¶125-27. The view from different perspectives between Huang and Neutrogena demonstrate that the references are related in appearance, design, and representative article of commerce that a designer would find applicable features of one as applicable to another. *Id.* Incorporating the elements of Neutrogena into Huang would simply be utilizing the same design feature for its intended ornamental purpose in the same configuration for the same article. *Id.* The only noticeable differences are the transparency of Neutrogena and the shape of Neutrogena's compartment. *Id.*

| Figure                | Huang                                                                              | Neutrogena                                                                          |
|-----------------------|------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------|
| Front Elevation View  |   |   |
| View into Compartment |  |  |

Neutrogena teaches the same overall configuration as Huang and is also a container. *Id.* at ¶127. As shown from the views in the above table, Neutrogena containers are similar to Huang in design and configuration, for example, both have tubular base portions, concentrically located tubular neck portions extending from the tubular base portion and made of a unitary material, and compartments disposed concentrically within the neck/base portions and opening via a circle at the top of the neck portion. *Id.* Moreover, both include non-cornered edges transitioning from the vertical sidewalls of the compartment to the horizontal bottom surface of the compartment. *Id.* And as shown, both Huang and

Neutrogena include threads on the tubular neck portion, which indicates a design for inclusion of a cap. *Id.*

| Reference         | Annotated Figures                                                                                                                                                                                |
|-------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Huang</b>      |  <p>Tubular Neck</p> <p>Threads</p> <p>Tubular Base</p>                                                        |
| <b>Huang</b>      |  <p>Compartment</p> <p>Radiused Transition</p>                                                                |
| <b>Huang</b>      |  <p>Flat Surface</p> <p>Beveled Edge</p>                                                                     |
| <b>Neutrogena</b> |  <p>Tubular Neck (within cap)</p> <p>Tubular Base</p> <p>Tubular Neck</p> <p>Threads</p> <p>Tubular Base</p> |

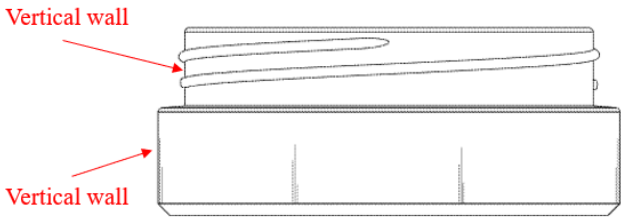
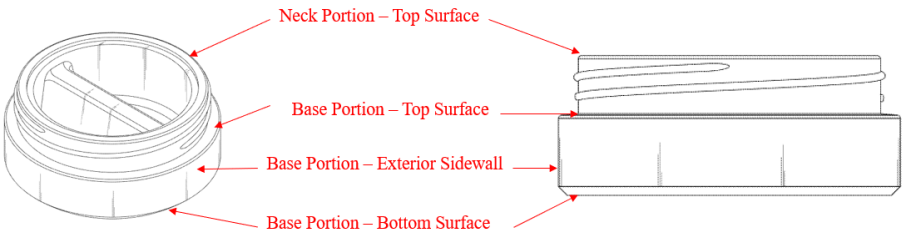
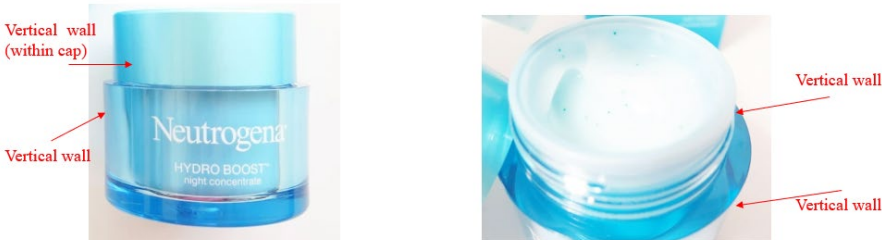
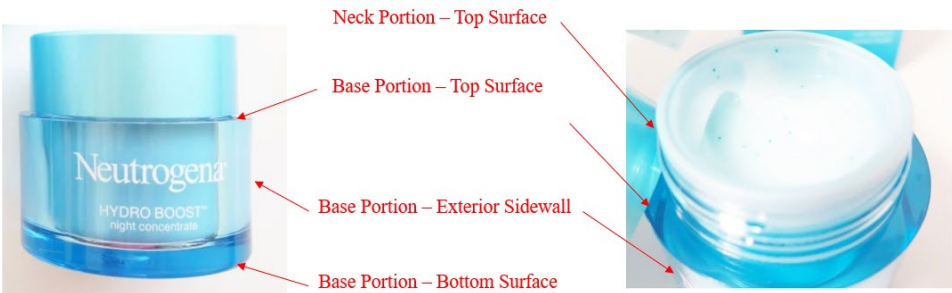
|            |                                                                                    |
|------------|------------------------------------------------------------------------------------|
| Neutrogena |  |
| Neutrogena |  |

Moreover, both Huang and Neutrogena disclose containers wherein the tubular neck portion is narrower than the tubular base portion, with the neck portion having the same height or a slightly shorter height than its respective base portion. *Id.* A DOSITA would recognize that the threads indicate the design of the neck portion should conform to the interior of a cap. *Id.*

An additional related and similar element is the location, dimensions, configuration, and design of the compartment extending from and within the top end of the neck portion and into the base portion. *Id.* at ¶¶128-29. The annotated figures demonstrate that the side walls of the compartment corresponding to the interior sidewalls of the neck and base portions are similarly essentially vertical, tubular, extend into the base portion, such that the only opening in the

compartment is through the top of the tubular neck portion. *Id.* Moreover, the bottom surface of the compartments is connected to the sidewalls through a non-cornered transition. *Id.* The mere inclusion of a divider in Huang would not detract from the compartments having basically the same relative dimensions and configurations. For instance, simple removal of the interior wall creating the two chambers in Huang would result in a compartment containing almost an identical ornamental design as the compartment in Neutrogena. *Id.*

Further, the minute details are also similar, the respective base portions contain flat horizontal top and bottom surfaces and the top of the neck portion is flat and horizontal as well. *Id.* at ¶¶128-30 Similarly, the exterior and interior sidewalls of the base and neck portions are parallel to each other and perpendicular to the horizontal surfaces. *Id.*

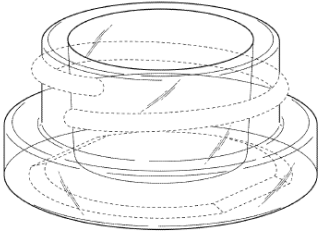
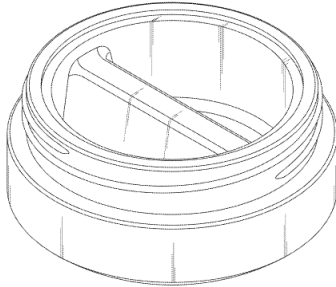
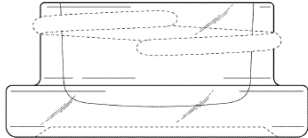
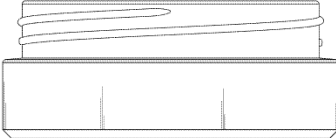
| Reference         | Annotated Figures                                                                    |
|-------------------|--------------------------------------------------------------------------------------|
| <b>Huang</b>      |    |
| <b>Huang</b>      |    |
| <b>Neutrogena</b> |   |
| <b>Neutrogena</b> |  |

For at least the above reasons, a DOSITA would find that the design of the container of Huang and Neutrogena *so related* (a standard no longer necessary)

that it would have been appropriate and obvious to incorporate and apply design elements from Neutrogena into the container of Huang. *See MRC Innovations*, 747 F.3d at 1334. The similarity in design and appearance of Huang and Neutrogena provide a DOSITA the motivation to incorporate design features of Neutrogena into Huang. *See id.*; EX1011 ¶¶129-32.

More specifically, a DOSITA would be motivated to incorporate the concave bottom surface of the compartment of Neutrogena (to the extent Huang does not disclose a concave bottom surface of the compartment) having the radiused transition edges from the vertical sidewalls of the compartment. EX1011 ¶¶133-34. Such a modification would not require any additional modifications to the remainder of the article of Huang. *Id.* at ¶¶129, 133-34.

In addition, the substitution of a single chamber compartment for a dual chamber compartment is within the ability and knowledge, and would have been obvious to a DOSITA. For example, a single chamber would provide more volume within the chamber, be easier to manufacture, and provide an added aesthetic benefit based on the overall cylindrical design of the articles. *Id.* Thus, the proposed combination would result in Huang having a single chamber compartment defined by essentially vertical sidewalls and a radiused transition to a slightly concave bottom surface located in the base section. *Id.* Moreover, such a chamber would have an opening at the top end of the neck portion.

| 'D151                                                                             | Huang                                                                              | Neutrogena                                                                          |
|-----------------------------------------------------------------------------------|------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------|
|  |  |  |
|  |  |  |

In addition, to the extent that Huang does not explicitly disclose sufficiently radiused edges either internally or externally, it would have been obvious to a DOSITA based on either Neutrogena or background knowledge to modify Huang such that the edges of the bottom tubular portion, transition between top surface of bottom tubular portion and sidewalls of top tubular portion, transition between top tubular portion sidewalls and top surface, and transition between the compartment's tubular walls and bottom surface, would be radiused transitions. *Id.* at ¶135. The similarity between Huang and Neutrogena provides this suggestion to a DOSITA. *Id.* Also, it would have been obvious based on known design considerations such as avoiding sharp edges due to structural integrity and better hand feel, better visual aesthetic qualities, and such design choices were obvious variations on non-cornered perpendicular transitions. *Id.* Optimization of

the degree of curvature, to the extent necessary, would easily be within the skill and ability of a DOSITA. *Id.*

The inclusion of the transparent design taught by Neutrogena would also have been obvious to a DOSITA to incorporate into Huang and further also be motivated to do so based on the similarity of references. *Id.* at ¶136. The combination would achieve the hypothetical combination's design, but utilizing a transparent material, as shown in Neutrogena such that an end user would be able to see through the container and a DOSITA would recognize numerous other motivations to substitute a transparent material. *Id.* This would also conform with Huang's intent of teaching an open top compartment. For instance, and without providing a comprehensive list, a DOSITA would seek to apply a transparent material to allow the user to see through the container to ascertain the material without the container or the amount of material remaining in the container, the transparent material can be transparent but tinted in such a manner to better present the appearance of the material contained within the container, a transparent material can allow light through the outer material to illuminate the product within the compartment, and/or a transparent material can simply aesthetically catch the eye of a purchaser in a more meaningful manner depending on the composition intended to be sold. *Id.* This is further shown by the Neutrogena container as it is tinted a shade of blue, which presents the interior white cream in a more appealing

color and texture due to the transparency and tint of the container. *Id.* Such a substitution would have, as of the priority date of 'D151, been within the experience and ability of a DOSITA, and such a designer would have been motivated to do so for the above-mentioned benefits, the knowledge that transparent containers of this type with these ornamental design features were known, and because the prior art explicitly demonstrates the benefit. *Id.*; *KSR*, 550 U.S. at 407, 415-21.

Moreover, the proposed inclusion of both the compartment taught in the Neutrogena and the transparent material for the entire container, as taught in Neutrogena, would have had obvious synergistic benefits. EX1011 ¶137. The combination would allow end purchasers of such container articles to see not only the ornamental design of the compartment due to the transparency of the container material, but also to see through the container to view the product or quantity of product contained within the compartment. *Id.* Thus, these ornamental features provide not only desirable aesthetic ornamental value, but also practical value for the end user, and make the design not only more appealing, but more practical. *Id.* at ¶¶137-38. Thus, the inclusion of both the compartment and transparency of Neutrogena into Huang would have been obvious to a DOSITA.

'D151 further illustrates the functional design of incorporating a taller neck portion than base portion. As shown by the threaded (unclaimed) drawings of

'D151, the neck portion is intended to be covered by a cap. *Id.* at ¶128. Moreover, the height of the neck portion would directly functionally impact the volume within the compartment, and therefore, adjusting the length of the neck would directly adjust the volume of the compartment. *Id.* However, to the extent that the length of the neck is not a functional aspect, modifying the proposed combination of Huang and Neutrogena to have a neck portion taller than the height of the base portion would have been obvious to a DOSITA. It not only would have been an obvious modification, but also a DOSITA would be motivated to do so to adjust the volume within the compartment to either aesthetically illustrate more product without providing additional product in the compartment, or to correspond to the cap dimensions, which would be considered as the proposed hypothetical combination intends for a cap. *Id.* Such a modification of the proportional height would have been minor and not have resulted in any material alteration to other design features of the hypothetical combination. *Id.*; *KSR*, 550 U.S. at 407, 415-21.

Any remaining differences between the hypothetical embodiment of Huang and Neutrogena and 'D151 as a whole would be considered *di minimis* and/or known in the art related to this field of articles by a DOSITA and within the skill and ability of such a designer to make such minor modifications to achieve the claimed design of 'D151. EX1011 ¶140. In other words, any other differences are

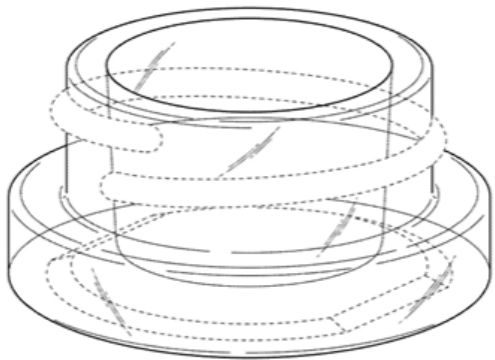
not patentable distinctions and would not be innovative or patentable over the hypothetical combination.

In sum, as explained in detail above with expressed motivations to modify Huang, the expressed modifications would be considered *de minimis* by a DOSITA and driven by obvious design choices. As discussed above in Section VII.A, the Federal Circuit has acknowledged that design patents can be invalidated “despite the inclusion of ornamental features that were entirely absent from prior art designs.” *MRC Innovations*, 747 F.3d at 1334; (citing *In re Nalbandian*, 661 F.2d at 1217; *In re Carter*, 673 F.2d at 1380; *In re Chung*, 243 F.3d 561, No. 00-1148, 2000 U.S. App. LEXIS 24916, 2000 WL 1476861, at \*3; *In re Cooper*, 480 F.2d at 901-02). Thus, to the extent a specific ornamental feature is not found in the prior art does not prevent a finding of obviousness of ’D151.

**D. Ground 4: The McKernan Jar in View of Zamberlan and the common knowledge in the art renders the claim of ’D151 obvious**

’D151 is invalid because a DOSITA that designs containers/jars would have found the claimed design to have been obvious over the McKernan Jar in view of Zamberlan and with knowledge of a DOSITA as of the priority date of ’D151. EX1011 at ¶142. As shown below, a comparison of the figures of ’D151 to the McKernan Jar demonstrates that the McKernan Jar has a substantially similar overall visual appearance to the jar of the claimed design. *Id.* That is, the basic

design characteristics of the claimed design are found in the McKernan Jar, namely a glass jar with a wide tubular base portion and a narrow tubular neck portion where the neck portion is taller than the base portion. *See* EX 1003 at 431-439. The view of the open top of the McKernan Jar also shows that the McKernan Jar has a compartment or interior chamber. *Id.* at 436. Such is consistent with the nature of a jar which, by definition, is a type of container that would necessarily include some type of interior compartment. *See* EX 1011 ¶142.

| 'D151                                                                                            | McKernan Jar                                                                        |
|--------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------|
|  <p>FIG. 1</p> |  |

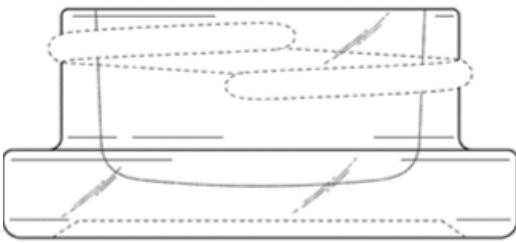


FIG. 2

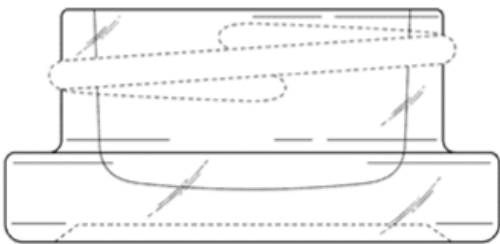
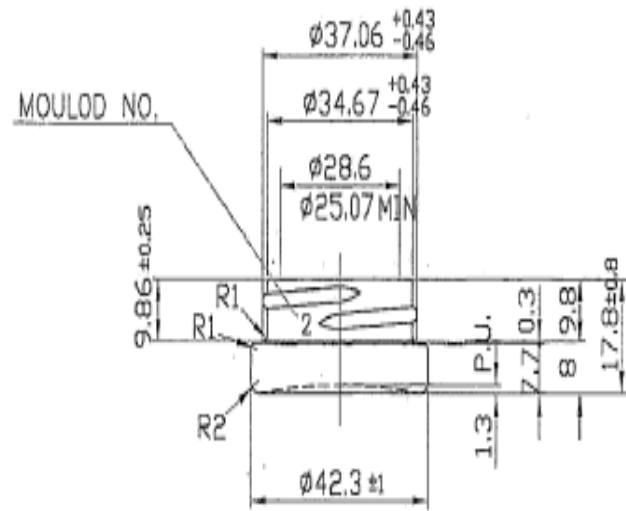


FIG. 3



Side view figure from part drawing dated 2011

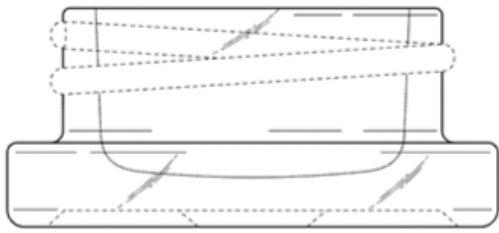


FIG. 4

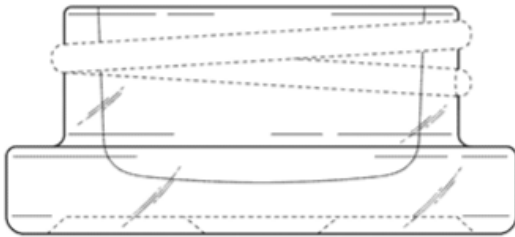


FIG. 5



Side view figure from part drawing dated 2011 (annotated to remove dimension markings for clarity)

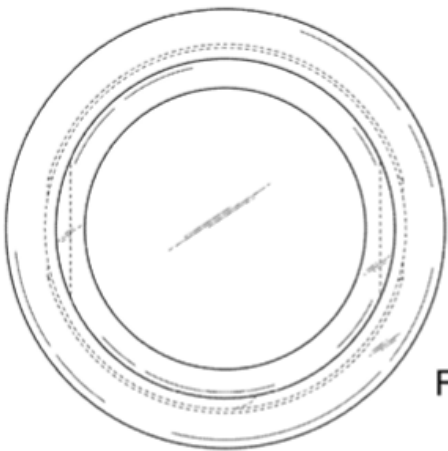
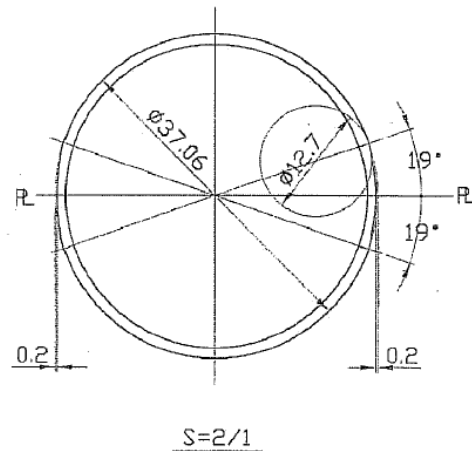
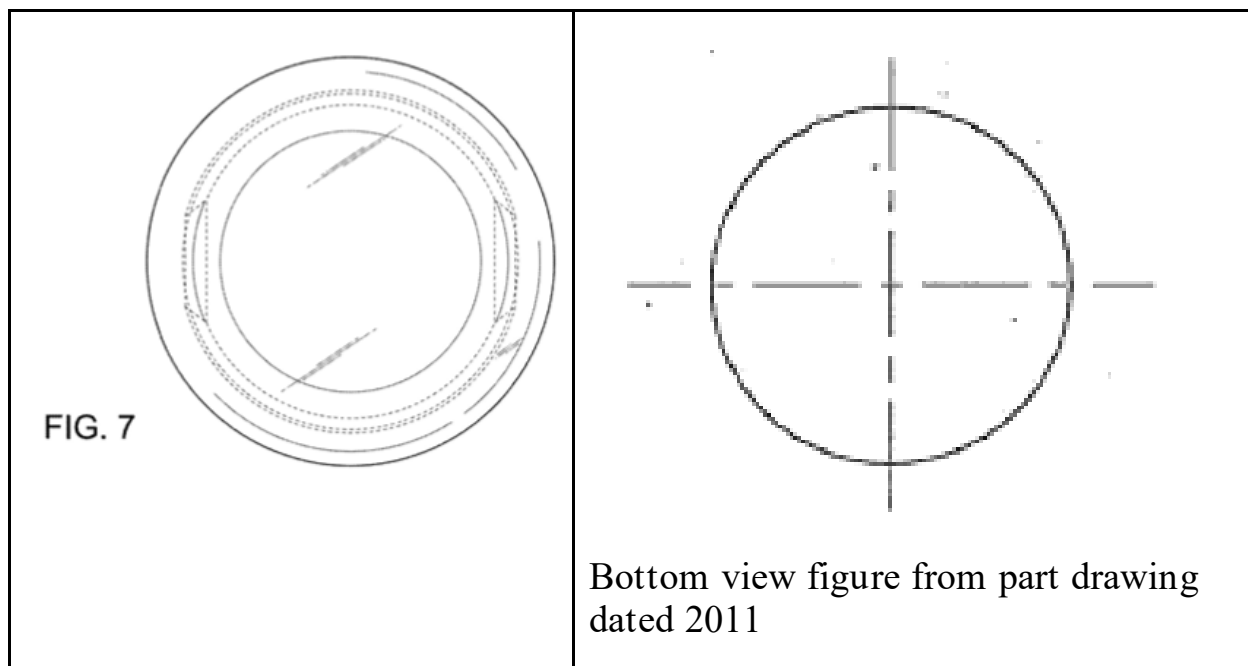


FIG. 6



Top view figure from part drawing dated 2011 (showing top view of the neck portion only)



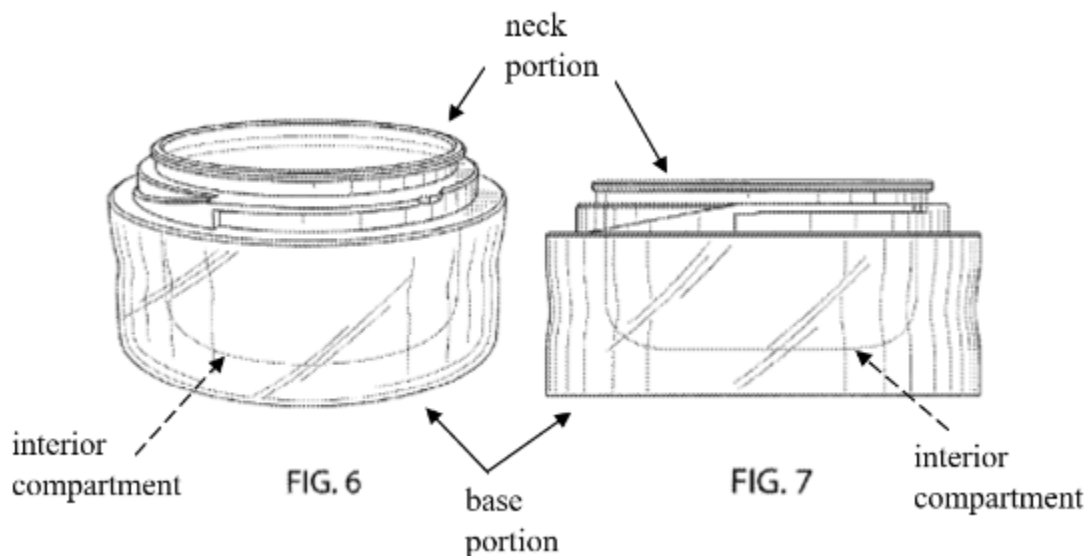
As seen above, both the claimed design and the McKernan Jar incorporate rounded edge transitions throughout the design, including at the external edges of the base portion, the external edges of the tubular neck portion, and the transition from the vertical walls to bottom surface of the compartment. *See* EX1011 at ¶143.

Regarding Fig. 6 of 'D151 in the above comparison, a DOSITA would recognize that the base portion (not shown in the top view of the McKernan Jar) would present as an outermost circle from a top view of the jar that is concentric with the innermost circle that is presented by the neck portion. *Id.* at ¶144. That is supported by the picture and side view of the McKernan Jar shown above, which show that the base portion has a tubular shape and is wider than the neck portion, and that the neck portion is concentric with the base portion. *Id.*

The primary difference between the design of the McKernan Jar and the claimed design is that only the neck portion of the McKernan Jar is transparent rather than the entirety of the McKernan Jar. In other words, the base portion of the McKernan Jar, unlike its neck portion, is frosted and thus not see-through. *Id.* at ¶145. Transparency, however, is a functional feature that should be given little if any patentable weight in connection with the claimed design. *Id.* Lerman, in fact, admitted to the functionality of the transparent nature of the claimed design during prosecution of the reexamination of 'D151 when arguing non-obviousness of the claimed design. *See* EX1003 at 261. Lerman specifically argued that the transparency of the claimed jar allowed “anything stored inside the jar to be readily visible from the outside” and “enhanced child-proof characteristics.” *Id.*

Notwithstanding the functional nature of the transparency of the claimed design, transparent containers are well known in the art. *See* EX1011 ¶¶146-47. Zamberlan, for example, discloses a transparent flask. *Id.*; *see also* EX1013 at (54), (57) and Figs. 6 and 7. Petitioner notes that the claimed design, the McKernan Jar, and the flask of Zamberlan are all containers and thus are from the same field of design. Thus, the McKernan Jar and Zamberlan qualify as analogous art under *Graham*. *See* EX1011 ¶147.

Like the claimed design, the flask of Zamberlan has a tubular base portion and a narrower tubular neck portion. *See id.* at ¶148; *see also* EX1013 at Figs. 6 and 7. The neck portion of the Zamberlan flask is sized to accommodate threading for receiving a cap. *Id.* As seen in Figs. 6 and 7 of Zamberlan (shown below), the flask is entirely transparent revealing an interior bowl-shaped compartment similar to the claimed design. *Id.*



#### EX1011 ¶148

Zamberlan suggests the application of its transparent feature to the McKernan Jar to reveal the interior compartment of the McKernan Jar. *See Id.* at ¶149 A skilled designer with knowledge of the Zamberlan flask design would have found it obvious to remove the frosted finish from the base portion of the McKernan Jar such that the entirety of the McKernan Jar is transparent to reveal

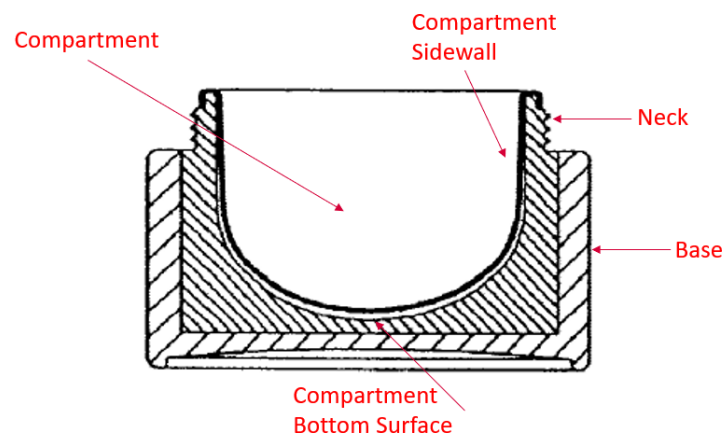
the interior compartment of the McKernan Jar and the contents therein. *Id.* Such a modification of the McKernan Jar would have been obvious to a DOSITA to provide visibility into the base portion of the McKernan Jar and any contents therein. *Id.*

Other rationales for combining the McKernan Jar and Zamberlan include design incentives, such as to improve aesthetics, and market forces such as to improve the look and value of the jar to customers. *Id.* at ¶150. Moreover, it would have been obvious to a DOSITA to try a finite number of identified predictable solutions to a problem, such as complete transparency of the McKernan Jar to solve the problem of not being able to see the contents inside of the jar. *Id.*

To the extent that the combination of the McKernan jar and Zamberlan is considered to not explicitly show every design feature of the claim, any remaining differences from the claimed design are *de minimis* and would have been obvious as mere design choices to the skilled designer. *Id.* at ¶151.

For example, to the extent that the combination of the McKernan Jar and Zamberlan is considered to fail to explicitly show that the interior compartment thereof has a sloped sides with a concave bottom surface like that of the claimed design, a DOSITA would have been motivated to incorporate such a concave shape for at least the simple function of pooling the contents of the jar to ensure use of

and accessibility to all of the contents, especially to facilitate access to the contents, such as when using a finger. *Id.* at ¶152. Also, containers with interior compartments that have a sloped sides and minor radius of curvature of a concave bottom surface are well known in the art. For example, as discussed above, Canamasas Puigbo discloses a bottom surface of a compartment having a concave curvature. *Id.*; see also EX1008, Fig. 3 (shown below).



#### EX1011 ¶152

Like the design claim and Zamberlan, the compartment of Canamasas Puigbo extends from a neck portion of the container into a base portion of the container. See EX1011 at ¶153. As can be seen in Fig. 3 of Canamasas Puigbo, the interior compartment thereof has sidewalls that slope into the bottom surface that has a concave curvature like the claimed design. *Id.*

The similarities in design would motivate a DOSITA to apply the sloped sides with concave bottom surface of the compartments known in the art (e.g., Canamasas Puigbo) to the combination of the McKernan jar and Zamberlan. *Id.* at ¶154; *see also MRC Innovations*, 747 F.3d at 1334. Such a modification would not affect any other design aspect of the combination of the McKernan jar and Zamberlan. EX1011 ¶154. And a DOSITA would have understood that the sloped sides and different degrees of radius for the concave bottom surface would be a design choice for accessibility to the contents and depend on the contents of the container for optimization of the degree of curvature, especially together with the radiused transition between the sidewall and bottom surface. *Id.*

To the extent that the interior compartment of the combination of the McKernan Jar and Zamberlan is considered to be deeper than that of the claimed design, it would have been an obvious design choice to select any desired depth (shallow or deep) for the compartment based on the desired volume of contents to be held within the jar. *Id.* at 155. Moreover, in view of the truncated nature of the base portion of the McKernan Jar, a DOSITA would recognize the advantage of limiting the depth of the interior compartment into the base portion to maintain a solid base for the jar and avoid damage. *Id.*

Furthermore, the height of the neck portion as compared to the base portion would functionally impact the volume within the compartment, and therefore, adjusting the height of the neck would directly adjust the volume contained in the compartment. *Id.* at ¶156. For example, reduced shelf space would be required for the same amount of product. *Id.* And the height of the neck portion allows the neck portion to accommodate threading. *Id.* Thus, the specific height of the neck portion as compared to the base portion is functional and entitled to little patentable weight in connection with the claimed design. *Id.*

To the extent that the neck height is not considered to be functional, modifying the proposed combination of the McKernan Jar and Zamberlan to incorporate a taller neck portion relative to the base portion would have been obvious to a DOSITA to, for example, adjust the volume within the compartment to either aesthetically illustrate additional product without providing additional product in the compartment, or to correspond to the cap dimensions, which would be a designer's consideration as the proposed hypothetical combination is intended for use with a cap, as shown by the threads in the drawings of 'D151; an elongation of the neck would also provide for the ability to include an accessibility tool in the cap. Such a modification of the proportional height would have been minor and not have resulted in any material alteration to other design features of the hypothetical combination. *Id.* at ¶157; *see also KSR*, 550 U.S. at 407, 415-21.

For the reasons explained in detail above, supported by express motivation to modify the McKernan Jar, the expressed modifications would be considered *de minimis* by a DOSITA and driven by obvious design choices. EX1011 ¶158. As explained above, the Federal Circuit has acknowledged that design patents can be invalidated “despite the inclusion of ornamental features that were entirely absent from prior art designs.” *MRC Innovations*, 747 F.3d at 1334. Thus, to the extent a specific ornamental feature is not found in the combination of the McKernan Jar and Zamberlan, such does not prevent a finding of obviousness of ’D151.

For at least the above reasons, a DOSITA would have found the claimed design ’D151 as a whole obvious in view of the combination of the McKernan Jar and Zamberlan and the background knowledge of a DOSITA. EX1011 ¶159. Any deficiencies in the combination of the McKernan Jar and Zamberlan would have been considered by a skilled designer to be minor, commonplace in the design of jars, and obvious design choices and thus would not preclude a finding of obviousness. *Id.*

#### **VIII. 325(d) SHOULD NOT BAR THIS PETITION**

The Board should not exercise its discretion to deny this meritorious Petition under 35 U.S.C. § 325(d) because the PTO has not considered the primary references or the expert testimony relied upon in this Petition. *See, e.g., Unified Patents, Inc. v. Berman*, IPR2016-01571, Paper 10, at 12-13 (PTAB Dec. 14,

2016) (informative) (institution grounds relying on art not cited previously). Indeed, 'D151 received only a cursory examination, essentially receiving a first action allowance, and the reexamination proceeding was conducted under *Rosen-Durling* and without the benefit of a DOSITA's perspective. *See e.g.*, EX1003 at 15-29. In addition, at least three grounds include primary references not considered during prosecution or reexamination (*see, e.g., Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential)), and present different arguments with supporting expert testimony (*see id.*; *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6, at 7 (PTAB Feb. 13, 2020) (precedential)). As such, no basis exists for denying institution under 35 U.S.C. § 325(d).

## **IX. GROUNDS FOR STANDING**

Pursuant to 37 C.F.R. § 42.104(a), Petitioner certifies that 'D151 is available for *inter partes* review. Petitioner is not barred or estopped from requesting *inter partes* review challenging the patent claim on the grounds set forth herein.

**X. CONCLUSION**

Since there is a reasonable likelihood that Petitioner would prevail with respect to the claim of 'D151, this Petition for *inter partes* review should be granted.

Respectfully submitted,

Dated: July 1, 2024

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## **CERTIFICATE OF WORD COUNT**

Pursuant to 37 C.F.R. § 42.24, the undersigned attorney for Petitioner certifies that the document contains 13,563 words in 14-point Times New Roman font, excluding the parts of the document that are exempted by 37 C.F.R. §42.24(a)(1), according to the word count tool in Microsoft Word.

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## **CERTIFICATE OF SERVICE**

I hereby certify that on July 1, 2024, a true and correct copy of the foregoing *PETITION FOR INTER PARTES REVIEW* including exhibits was filed with the Patent Trial and Appeal Board Case Tracking System (P-TACTS) and served via overnight FedEx to the Patent Owner at the correspondence addresses of record as follows:

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