

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT AND APPEAL BOARD**

**A&A GLOBAL IMPORTS, INC.,
PETITIONER**

v.

**LERMAN CONTAINER CORPORATION,
PATENT OWNER**

Case No.: IPR2024-01138

U.S. Patent No. D781,151 S

PATENT OWNER'S PRELIMINARY RESPONSE

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Exhibit	Document
2001	Declaration of Prof. Lance Rake (with Appendices)
2002	<i>Ex Parte Lerman Container Corp.</i> Decision on Appeal, Appeal No. 2021-002799, Reexamination Control 90/014,262,, Patent D781,151 (PTAB Sept. 1, 2021)

I. INTRODUCTION

Petitioner seeks *inter partes* review of the claim of U.S. Patent No. D781,151 (the “D ‘151 patent”), directed to a jar, advancing four separate grounds of obviousness. The petition should be denied on its merits because none of the proposed grounds of invalidity would result in the same design as claimed in the D ‘151 patent and none presents a reasonable likelihood of unpatentability.

The products in the prior art cited by Petitioner in each of the four grounds, whether taken alone or in combination, present an overall visual appearance that differs substantially from the design of the ‘151 patent, including with respect to the ratio of the base height to the neck height, the neck diameter, the depth the interior cavity extends into the base, and the contour of the interior cavity. The Federal Circuit, in *LKQ Corp. v. GM Glob. Tech. Operations LLC*, emphasized that when considering obviousness of a design patent claim, the “inquiry focuses on the visual impression of the claimed design as a whole and not on selected individual features.” 102 F.4th 1280, 1299 (Fed. Cir. 2024). Contrary to this mandate, Petitioner improperly relies almost exclusively on comparisons between discreet design features in the cited art and discreet features of the claimed design while completely ignoring the proportional relationship of these feature in the design as a whole. These proportions do matter.

Indeed, Petitioner recognizes that significant visual differences do exist between the proposed combinations in each raised ground of obviousness. Nonetheless, Petitioner tries to bridge this gap by arguing, in mistaken reliance on its expert, that it would have been obvious to further modify the combination of references in order to change design features such as the height of the neck relative to the height of the base, the diameter of the neck relative to the diameter of the base, the depth of the interior volume of the jar, the angle of the interior sidewalls, and the shape of the bottom of the interior. As a matter of law, this additional testimony cannot be a basis for initiation of an IPR as *Inter partes review* can only be requested on the basis of what is specifically disclosed in prior art patents or printed publications. 35 U.S.C. § 311(b).

It is well settled that “expert testimony cannot take the place of disclosure from patents or printed publications. In other words, expert testimony may explain ‘patents and printed publications,’ but is not a substitute for disclosure in a prior art reference itself.” (U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Consolidated Trial Practice Guide 36 (Nov. 2019)) (hereafter “2019 Trial Practice Guide”). Moreover, even if such testimony is considered, the conclusion by Petitioner that these further design modifications of the prior art would produce the claimed design of the D ‘151 patent is a textbook example of the impermissible use of hindsight in an obviousness analysis. Taking Petitioner’s arguments to their

illogical conclusion, it is difficult to see how any cylindrical jar design would not be considered to have been obvious.

As discussed in detail below, none of the four obviousness grounds urged by Petitioner set forth a reasonable likelihood of unpatentability. Further, ground 4 should also not be considered as a basis for initiating *inter partes* review because it raises the same arguments that were already considered and rejected the Board during an *ex parte* reexamination of the D ‘151 patent (*In re Lerman Container Corp.*, Decision on Appeal, Appeal No. 2021-002799, Reexamination Control 90/014,262, Patent D781,151 (PTAB Sept. 1, 2021), EX1003 at 15-29; EX2002 (incorporated in its entirety) (hereafter “Reexam Appeal Decision”).¹ Specifically, Ground 4 proposes a combination of the supposed prior art “McKernan Jar” and U.S. Design Patent No. D634,202 to Zamberlain *et al.* (the “D ‘202 patent”). While the Board’s reexamination decision was issued when the *Rosen-Durling* two-part test for obviousness was in effect, the Board still expressly considered the same combination of the McKernan jar and D ‘202 patent that Petitioner presents in Ground 4. The Board concluded that even if these references were combined, the combination would not have resulted in the same design as in the D ‘151 patent, but

¹ The Board’s prior decision is included within EX1003 and resubmitted separately as EX2002 for ease of reference.

instead would have substantial visual differences. Reexam Appeal Decision, EX2002 at 13.

Not surprisingly, Petitioner has not identified any errors made by the Board in its analysis of the combination of the McKernan jar and the D ‘202 patent. Rather, it argues the decision should be reconsidered based on Petitioner’s expert testimony (Petition at 96). However, expert testimony that it would have been obvious to modify the McKernan jar with features from the D ‘202 patent adds nothing because the Board already considered that combination. (Petition at p. 96). Petitioner’s additional expert testimony proposing vague modifications that go beyond the prior art is inapplicable here because, as previously stated, a petition for *inter partes review* must be based on what is disclosed prior art patents and printed publications and expert testimony cannot be used as a substitute for disclosure that is missing in the prior art. 35 U.S.C. § 311(b); 2019 Trial Practice Guide at 36.

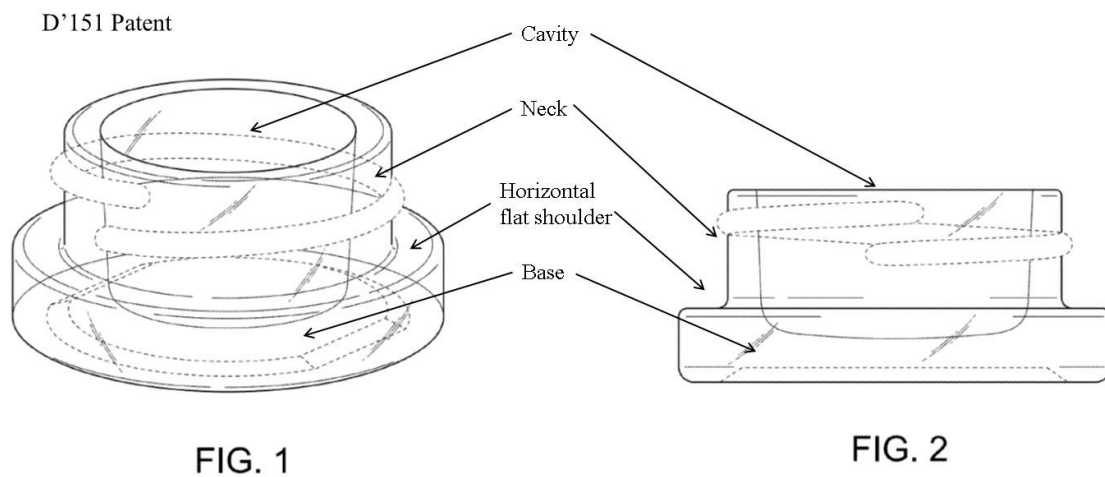
On the merits, none of Petitioner’s grounds meet the reasonable likelihood threshold required for institution of an *inter partes review* of the D ‘151 patent. Nor is there any basis for the Board to revisit its prior decision where the very same issues were fully considered and Petitioner does not claim any errors in the prior decision.

II. THE D '151 PATENT

A. The Design of the D '151 Patent

The D '151 patent claims the ornamental design of a jar as shown in the solid lines of

Figures 1-7. Annotated Figures 1 and 2 of a perspective and front elevation view, respectively, are shown below.



As can be seen, the jar of the D '151 patent is transparent and has features with relative proportions that, in combination, give the jar an elegant but solid character. EX2001 at ¶ 36. The height of the neck portion is slightly greater than $1\frac{1}{2}$ times the height of the base portion. The diameter of the neck portion is approximately $\frac{3}{4}$ the diameter of the base portion. The dimensions of the neck and base result in a significant horizontal offset shoulder with a width that is about $\frac{2}{3}$ the base height. The internal cavity resides mostly in the neck of the jar, extends

only slightly into the base portion and has a gently concave bottom and sidewalls that taper slightly inward. *Id.* at ¶ 33-36 *See also*, Reexam Appeal Decision, EX2002 at 2-3. (describing features of the claimed jar of the D ‘151 patent).

B. Prosecution of the D’151 Patent

The patent application that issued as the D ‘151 patent was filed on June 8, 2016. Applicant requested expedited examination and submitted the results of a prior art search, citing thirty-two (32) references that were found during a search. EX1010 at 48-58. The request for expedited examination was granted. *Id.* at 42-43. The application was subsequently allowed. *Id.* at 21-31. In the Notice of Allowance, the Examiner noted that all of the references submitted by the Applicant were considered. *Id.* at 33-36. The Examiner also cited and considered an additional ten (10) references (including U.S. Design Patent No. D578,891 to Canamasas Puigbo *et al.*, and U.S. Design Patent No. D634,202 to Zamberlain *et al.*, both of which are relied on by Petitioner). *Id.* at 31. The application was amended to respond to a restriction requirement issued with the allowance and subsequently issued on March 14, 2017 as U.S. Design Patent No. D781,151. *Id.* at 12-18.

C. Reexamination of the D’151 Patent

On February 11, 2019, a third-party requested *ex parte Reexamination* of the D ‘151 patent, arguing that the design claim was anticipated by or obvious in view of various documents showing a frosted jar referred to as the “McKernan Jar”.

EX1003 at 368, 397-413. *Ex Parte Reexamination* was thereafter ordered on June 5, 2019, finding that the McKernan Jar raised a substantial new question of patentability. *Id.* at 331-340. In a subsequent Office Action dated September 3, 2019, the claim of the D ‘151 patent was rejected as being obvious over a combination of the McKernan Jar and the D ‘202 patent. The Examiner was not persuaded by Patent Owner’s subsequent arguments that the rejection was improper and a Final Office Action was issued on December 26, 2019. The Patent Owner’s’s after-final arguments were also unsuccessful and, following an Advisory Action, the Patent Owner appealed. *Id.* at 273-297, 257—272, 234-243, 202-225, 196-199, 190.

On appeal, the Patent Owner argued that under the *Rosen-Durling* test, the McKernan Jar was not a suitable primary reference and that the D ‘202 patent was not a suitable secondary reference. The Patent Owner further argued that even if these references were combined as suggested, the result would still not produce the claimed design because *inter alia*, the interior of the McKernan Jar was undisclosed and the interior of the jar of the D ‘202 patent was completely different and extended through almost the entire base of the jar. *Id.* at 166. In the Examiner’s Response, the Examiner conceded that it was impossible to see through the frosted glass of the McKernan Jar in order to discern any features of the interior chamber below the mouth of the jar, but nonetheless argued that the combination was still proper and rendered the design obvious. *Id.* at 84-85. The Patent Owner reiterated various

arguments in its Reply, including that even if combined, the two references would not result in the claimed design. *Id.* at 39-61.

After considering the prior art and all the arguments, the U.S. Patent and Trial Appeal Board (“the Board”) reversed the Examiner’s rejection. At the time, the *Rosen-Durling* two-part test for obviousness was in place. Under that standard, the Board found that the McKernan Jar was not a suitable primary reference and that the D ‘202 patent was not sufficiently “so related” to be a secondary reference. Reexam Appeal Decision, EX2002 at 7-13. Significantly, the Board also held that the differences between the McKernan Jar and the design of the D ‘202 patent, such as the relative size and shapes of the bases and necks of the jars, and the prominent “waistline” of Zamberlan “were not minor” and that a designer of ordinary skill in the art would not have selectively picked out just one feature from the D ‘202 patent—transparency – in order to modify the McKernan Jar. *Id.* at 12-13.

The conclusions of the Board were noted by the Petitioner (Petition at pp. 14-16) and were guided by the requirements of the *Rosen-Durling* test. Reexam Appeal Decision, EX2002 at 6-7. Conspicuously unaddressed by the Petitioner in its summary of the D’151 reexamination is that the Board did not stop there. Instead, the Board went beyond *Rosen-Durling* and expressly considered the same combination of the McKernan jar and the D ‘202 patent now proposed by Petitioner – namely modifying the McKernan jar to be transparent like the flask disclosed in

the D ‘202 patent. *Id.* at EX12-13. For this combination, the Board also concluded that even if these references were combined and the McKernan jar was modified to be fully transparent, the combination would still not result in the claimed design. *Id.* at 13. As explained by the Board, because the shape and depth of the McKernan jar’s interior could not be determined, the only design available for the jar interior in the combination of prior art references was from Zamberlan, and the interior of the jar of Zamberlan is very different from the claimed design:

Zamberlan’s interior chamber extends substantially through the base with vertically walls...[y]et the claimed design has relatively shallow depth with respect to the base, the interior chamber residing mostly in the neck of the jar and taking up less than half of the depth of the base, in sharp contrast to Zamberlan’s design. Further, in the claimed design, the sides of the interior chamber are sloped down with a slight curve to an entirely sloped bottom, while the sides of Zamberlan’s interior chamber are substantially vertical and form a sharper curve down to a primarily flat bottom. We find these aspects of the design to be of significance in the overall visual impression of such an otherwise simple design, particularly in an otherwise crowded art.

*Id.*²

² The Board also took judicial notice that “there are many types of jars, and even the ‘small jar’ art is a crowded art. Thus, the differences in small details will have

III. SUMMARY OF PETITIONER’S ASSERTED GROUNDS

Petitioner presents four asserted grounds. These are listed below. Each of the references and the combinations are addressed in further detail herein.

- Ground 1: Obvious over the Neutrogena Hydro Boost jar (EX1015, EX1016, EX1017) (the “Neutrogena jar”) in combination with U.S. Design Patent No. D578,891 to Canamasas Puigbo (the “D ‘891 patent”) (EX1008).
- Ground 2: Obvious over U.S. Design Patent No. D795,705 to Huang (the “D ‘705 Patent”) (EX1007) in view of the D ‘891 patent and in further view of U.S. Design Patent No. D634,202 to Zamberlan (the “D ‘202 patent”) (EX1013).
- Ground 3: Obvious over the D ‘705 patent in view of the Neutrogena jar.
- Ground 4: Obvious over the McKernan Jar (EX1003 at 431-439) (multiple references) in view of the D ‘202 patent.

IV. PETITIONER’S ASSERTED ART

A. The Neutrogena Jar

Petitioner relies heavily on several separate documents that disclose various versions of jars offered under the name “Neutrogena Hydro Boost Line”. (EX1015,

more weight than in less crowded arts.” *Id.* at 8-9 (*Citing Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 675 (Fed. Cir. 2008).

EX1016, and EX1017). Images from these exhibits and on which Petitioner relies are reproduced below.



For purposes of this Preliminary Response, Patent Owner does not contest that these documents individually are prior art. As can be clearly seen above, the jars as shown in EX1015 and EX1017 are of different colors and have different caps but appear to have substantially the same physical shape. However, the jar in EX1016 is noticeably different, with a thinner sidewall and base thickness than that of the jars shown in EX1017. EX2001 at ¶ 41. Even the Petitioner and its expert recognizes

that the jar in EX1016 is not the same as the jars shown in EX1015 and EX1017, conceding that the jar in EX1016 is at best “consistent” with those jars. Petitioner Brief, pp. 20, 23, EX1011, Par. 57, 58. Petitioner provides no legal basis for combining these three separate exhibits and treating them as a single amalgamated primary or secondary reference.³

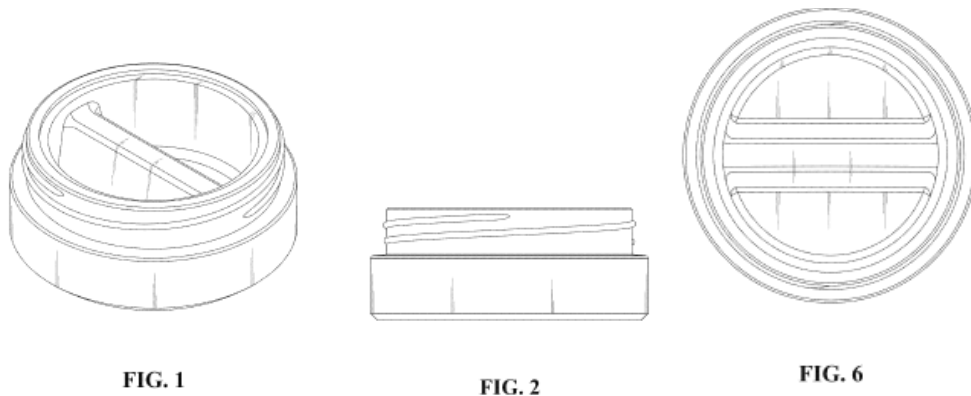
Whether treated individually or a combination, the only design features that are clearly disclosed in EXs 1015, 1016 and 1017 are the exterior proportions of the base, the approximate external diameter of the neck (as shown in EX1017), the maximum height of the neck (for EX1015 and 1016) because the neck must be narrower and shorter than the lid. EX2001 at ¶ 42. EX1017 shows a white liner within the jar that extends above the top of the neck portion. The height of the neck relative to the base of the jar cannot be clearly determined, but it must be less than the height of the cap covering the neck. *Id.* at ¶ 43. The interior of the jar appears to extend through almost the entire base of the jar. However, the specific contours

³ EX1014 is not prior art, despite Petitioner’s suggestion to the contrary. (Petitioner Br. at 20). The Exhibit shows a timeline that extends past 2018 and bears a 2022 copyright.

of the interior are distorted by reflections and refractions of the glass.⁴ Id. at ¶¶ 41, 70. The shape of the bottom of the interior cannot be seen. All that is visible is the periphery. Id. at ¶ 44. Even with these limited disclosures, the jar disclosed in each of EX1015, EX1016, and EX1017, has a tall base, a much shorter neck with a shoulder between the base and the neck that is very small relative to the base height, and an internal cavity that extends almost entirely through the base. Id. at ¶¶ 43, 44, 68.

B. U.S. Design Patent No. D 795,705 to Huang

The D ‘705 patent (EX1007) claims a “Compartmentalized Container”. Figures 1, 2 and 6 of the D ‘705 patent are shown below for reference.



⁴ If EX1016 is indeed the same jar design as shown in EX1015 and EX1017, this would demonstrate how distorted the views of the interior are as a result of the angle at which the jar is viewed.

The container as shown is opaque. The height of the base is slightly more than the height of the neck, resulting, by design, in a fairly balanced look. EX2001 at ¶¶ 46, 49. The neck is wide relative to the base and the shoulder between the base and the neck is very small. The upper compartment in Fig. 1 has a radiused or bevel edge that appears to define a bottom surface of half of the container. It appears that this compartment extends well into the base of the container, going nearly to the container's bottom. Id. at ¶ 46. The lower compartment as shown in Fig. 1 is largely obscured by the exterior of the container and its bottom cannot be seen. The top view of the patent (Fig. 6) shows both upper and lower compartments but has no depth information and so the two compartments may well have different depths or shapes. Id. at ¶ 47.

C. U.S. Design Patent No. D '578,891 to Canamasas Puigbo

The D '891 patent (EX1008) claims a "Bottle". Representative figures from the D '891 patent, including the side view of Fig. 2 and cross-sectional view of Fig. 3 of the patent are shown below for reference.

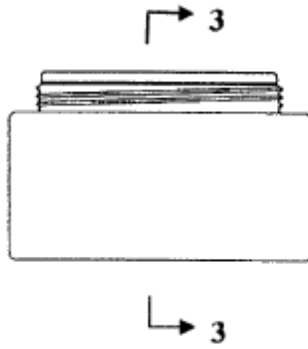


FIG. 2

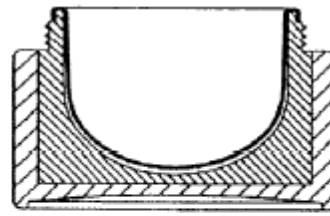


FIG. 3

The bottle of the D '891 patent has a very tall and wide base with a short neck. The height of the base is roughly $\frac{1}{2}$ its diameter and the neck is approximately $\frac{1}{3}$ the height of the base. The shoulder between the base and the neck is very small relative to the base height. As can be seen in Fig. 3, the internal cavity extends through most of the base and has a very rounded bottom. EX2001 at ¶¶ 51-53.

D. U.S. Design Patent No. D634,202 to Zamberlan

The D '202 patent (EX1013) claims a flask, cap and refill. Representative figures 6 and 7 from the D '202 patent, which depict a perspective view and a side view of the flask, respectively, are shown below.



FIG. 6

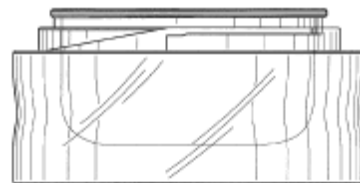


FIG. 7

The flask design disclosed in the D ‘202 patent has a relatively tall base with a distinctive horizontal indentation located approximately at the middle of the base. The flask has a short step-like neck and a very small shoulder width relative to the height of the base. An internal cavity with straight sidewalls extends from the opening in the neck more than halfway into the base. It has straight sidewalls and a flat bottom. EX2001 at ¶¶ 54-55, 101. *See also*, Reexam Appeal Decision EX2002 at 5-6) (discussing the design in the D ‘202 patent).

E. The McKernan Jar

Petitioner relies on four separate documents, referred to collectively as the McKernan jar, that were submitted to the Patent Office by a third party as Exhibits B1 – B4 in the Petition for Reexamination of the D ‘151 patent. (EX1003 at pp 431-439). As an initial point, it is noted that Petitioner has improperly combined multiple documents from different sources and with different dates, treating them as a single printed publication. (While the Reexamination file history itself, EX1003, might be considered a single document, it is of course, not prior art.)

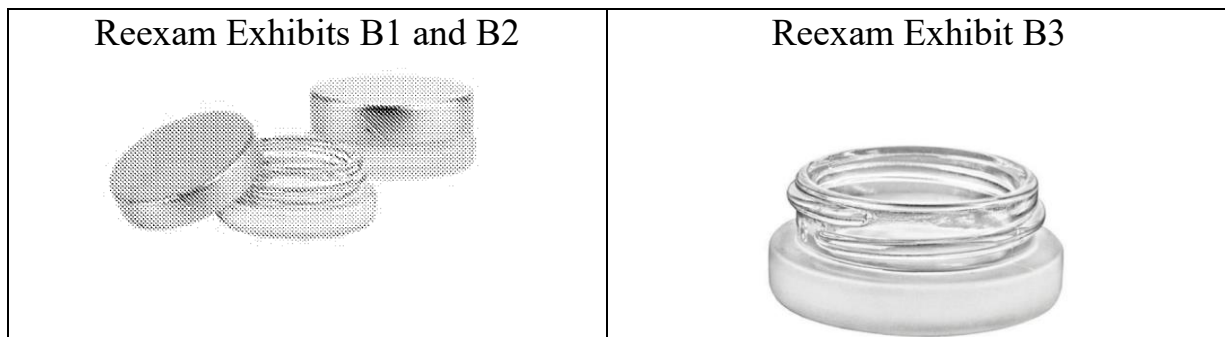
Reexamination Exhibit B1 (EX1003 p. 431-432) is a webpage printed on January 1, 2019 with an article dated June 1, 2012 and shows a rather poor-quality image of a frosted glass jar being offered by McKernan. Reexamination Exhibit B2 (EX1003, p. 433-434) appears to be a copy of a McKernan advertisement from 2012 with a picture of a jar that appears to be the same frosted jar picture of Exhibit B1.

Reexamination Exhibit B3 (EX1003, p. 435-436) is a printout of a JPG image of a frosted jar from an Internet Archive Capture dated October 30, 2013. Petitioner EX1025 is the same archived image as B3 but with a better quality. Reexamination Exhibit B4 (EX1003, p. 437-439) contains engineering drawings identified as being from McKernan and bearing a 2011 date. All four of these documents were considered by the Board in the Reexamination appeal. Reexam Appeal Decision, EX2002 at 4.

As a matter of law, Petitioner has failed to meet its burden to “identify with particularity evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent, and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 16, 2019 Pat. App. LEXIS 11903 (PTAB Dec. 20, 2019) (precedential). With respect to Exhibit B4 (EX1003, p. 437-439) specifically, Petitioner has submitted no evidence whatsoever that this document, even if it relates to the same jar as shown in Reexamination Exhibits B1-B3 (EX1003, p. 431-436), was available as a prior art printed publication. Instead, Petitioner argues merely that the status of the four Reexamination Exhibits collectively as printed publications was conceded during the Reexamination of the D ‘151 patent. (Petition, p. 37, n. 5). This is not true and Petitioner, not surprisingly, cites to no such admission on the record as no such

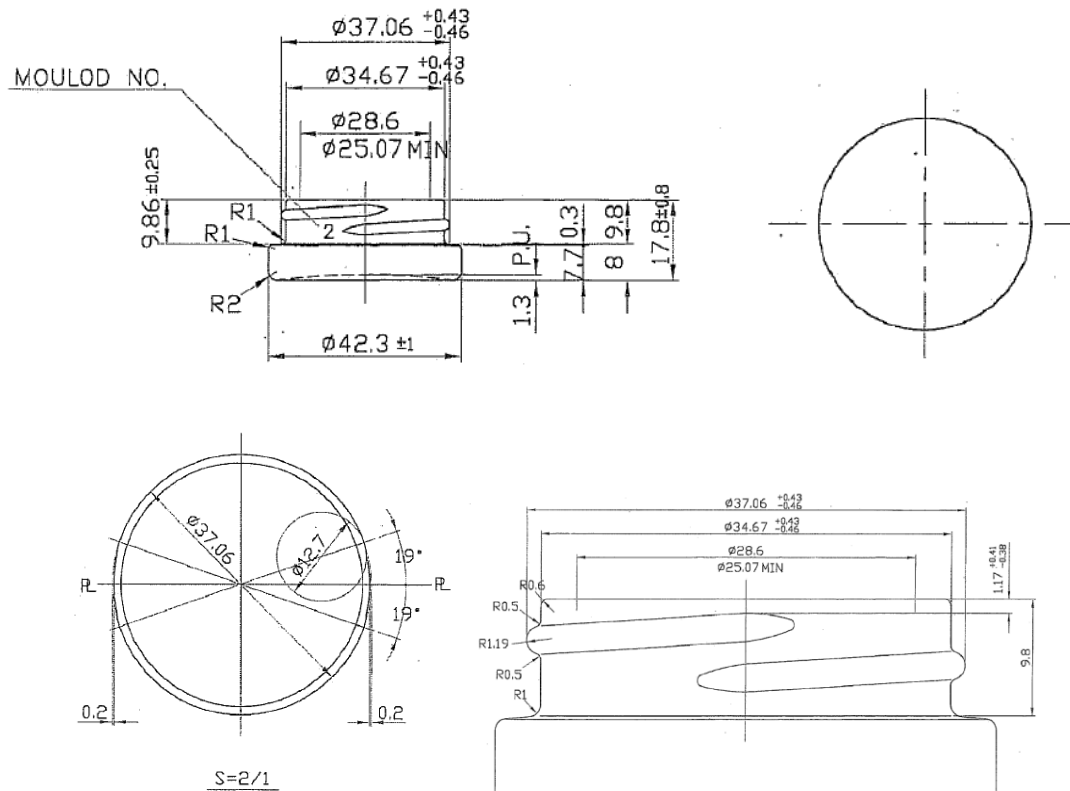
concession or admission was ever made. Nor did the Examiner or the Board make any specific factual findings of the prior art status of the cited references. Notwithstanding Petitioner's failure to meet its burden, Patent Owner will assume, solely for purposes of the present Response, that all four referenced documents in EX1003, pp. 431-439 qualify as prior art.

The image of the frosted jar shown in Reexam exhibits B1, B2, and B3 (EX1003, pp. 432, 434, 436) and reproduced below.



These three documents disclose a jar with a clear neck and a frosted base. Because the base is frosted, the interior of the jar below the rim is hidden and it impossible to know how the interior cavity is shaped or how deep the cavity extends. EX2001 at ¶¶ 56, 61. The height of the neck is slightly greater than the height of the base. The jar has a modest shoulder that appears in the image to be about half as wide as the base height. Id. at ¶ 60.

Excerpts from engineering images from Reexamination Exhibit B4 (EX1003, p. 437-439) are shown below.



This document does provide some additional detail about the proportions of the jar's exterior but provides no information about the interior depth or shape of the jar beyond the rim. EX2001 at ¶¶ 58-59. *See also*, Rexam Appeal Decision, EX2002 at 9, 13. Accordingly, even if all the exhibits, B1-B4, (EX1003, pp. 431-439) are considered, there is still no disclosure of the shape and depth of the interior below the neck of the jar.

V. DEFINITION OF A DESIGNER OF ORDINARY SKILL IN THE ART

Patent Owner does not dispute Petitioner's description of a designer of ordinary skill in the art. EX2001 at ¶ 29.

VI. LEGAL STANDARDS OF OBVIOUSNESS

In *LKQ Corp. v. GM Glob. Tech. Operations LLC*, the Federal Circuit overruled the long-standing *Rosen-Durling* test used to evaluate obviousness of a design patent claim. 102 F.4th 1280 (Fed. Cir. 2024). The Circuit held that in accordance with *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), the *Rosen-Durling* test for identifying suitable primary and secondary references was too rigid and instead the more flexible *Graham* factors should apply. *Id.* at 1293-1296; *see also Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). Following the *LKQ* decision, on May 22, 2024 the Patent Office issued “Updated Guidance and Examination Instructions for Making a Determination of Obviousness in Designs in Light of *LKQ Corp. v. GM Global Technology Operations LLC*” (hereafter “Updated Guidance”). The Updated Guidance specifies that the PTAB must follow the *LKQ* decision. *Id.* at 3.

When evaluating obviousness, there must be a “record supported reason (without impermissible hindsight), to modify a primary reference with features from a secondary reference to create the same overall appearance as the claimed design.” *Id.* at 3 (citing *LKQ Corp.*, slip opn. at 26-28, 102 F.4th at 1299). Importantly, the Federal Circuit and the Patent Office both have emphasized that in an obviousness analysis, a claimed design should not be dissected and considered as a collection of separate parts. Rather, the inquiry must focus on “the visual impression of the

claimed design as a whole and not on selected individual features.” *LKQ Corp.*, 102 F.4th at 1299 (quoting *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996)); *Updated Guidance* p. 3. *See also*, *Masimo Corp. v. Apple Inc.*, IPR2023-00831, Paper 9, 2023 Pat. App. LEXIS 3912 at * 4-5 (PTAB Nov. 21, 2023) (“When evaluating prior art references for purposes of determining patentability of ornamental designs, the focus must be on actual appearances and specific design characteristics rather than design concepts.” (Citing *In re Harvey*, 12 F.3d 1061, 1064 (Fed. Cir. 1993))).

VII. THE D’151 PATENT REQUIRES NO CONSTRUCTION

The scope of a design patent claim is defined by the figures of the patent and the overall visual impression they convey. *LKQ Corp.*, 102 F.4th at 1289. A verbal “construction” of the design is not typically necessary and may result in an oversimplification of the claimed design. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (*en banc*) (“Given the recognized difficulties entailed in trying to describe a design in words, the preferable course ordinarily will be for a district court not to attempt to ‘construe’ a design patent claim by providing a detailed verbal description of the claimed design.”).

VIII. PETITIONER HAS NOT MET ITS BURDEN ON ANY OF THE GROUNDS OF OBVIOUSNES

A. Petitioner Ignores the Claimed Design and its Proportions as a Whole

Ignoring applicable law, Petitioner consistently and incorrectly addresses invalidity by dissecting the claimed design of the D'151 patent into discrete individual features and then comparing each of these to corresponding features in the cited art. The Federal Circuit and the USPTO have both recently reiterated that an obviousness inquiry of a design patent must focus on “the visual impression of the claimed design as a whole and not on selected individual features.” *LKQ Corp.*, 102 F.4th at 1299; *Updated Guidance* at 3.

While many jars have the same basic parts such as a base, an inside, and a neck on which a cap can be placed, having the same discrete features does not mean that the designs have the same overall visual impression any more than, as explained by Patent Owner’s expert, a giraffe and a donkey would be considered as having the same *visual* appearance even though they present the same combination of discrete features arranged in a similar manner. EX2001 at ¶ 65. Likewise, two hypothetical jars with similar discrete design features may still have different overall visual impressions where the proportions of and between the design features in each are very different. That is precisely what we have here.

A very significant aspect of the ornamental design of the D ‘151 patent as a whole is the overall proportions between the individual features in the claimed jar design. *Id.* at ¶ 108. *See Masimo Corp. v. Apple, Inc.*, IPR2023-00831, Paper 9, 2023 Pat. App. LEXIS 3912 (PTAB Nov. 21, 2023) (finding prior art was not basically the same as the claimed design because they had different proportions). Indeed, Petitioner’s expert Mr. Fletcher recently testified under penalty of perjury that “[t]he importance of relative proportions is *crucial* for a POSITA attempting to be informed of the overall claimed design.” *Ideavillage Products Corp. v. Koninklijke Philips N.V.*, PGR2021-00116, Paper No. 6, Decision Denying Institution of Post Grant Review at p. 22, 2022 Pat. App. LEXIS 1763 at *19 (PTAB March 24, 2022) (emphasis added) (quoting the Declaration of Mr. Fletcher, opining on indefiniteness of a design patent and giving his testimony no weight because the proper viewpoint to consider in a design patent indefiniteness analysis is that of an ordinary observer, not a POSITA)⁵; *Cf., Lanard Toys Ltd. v. Toys “R” US-Delaware, Inc.*, No. 3:15-cv-849-J-34PDB, 2019 U.S. Dist. LEXIS 46911, at *53 (M.D. Fla. Mar. 21, 2019), *aff’d* 958 F.3d 1337 (Fed. Cir. 2000) (granting summary judgment

⁵ Mr. Fletcher’s opinion as to the importance of relative proportions is relevant here because obviousness is evaluated from the viewpoint of a designer of ordinary skill in the art.

in favor of non-infringement where the patent and the accused design both were generally pencil shaped but where a “readily apparent distinction” was that “the proportions of the design are different”).

In *Masimo Corp. v. Apple Inc.*, the Board denied the IPR petition after it considered validity of a design patent for a puck-shaped device charger and Petitioner had argued obviousness in view of a prior art disc-shaped wireless charger. IPR2023-00831, Paper 9, 2023 Pat. App. LEXIS 3912 (PTAB Nov. 21, 2023). A significant factor supporting the Board’s decision was different proportions of the claimed charger design as compared to prior art charger designs. Side views of the claimed design and the prior art “Lee” reference are shown below:



Id. at *28

Specifically, and dispositively, the Board rejected Petitioner’s claim construction because it omitted “important visual characteristics that significantly contributed to the overall appearance of the claimed charger” including omitting that “the overall cylindrical shape has a distinctive ratio of width (e.g., diameter) to

height that, as shown in the figures of the claimed design, evoking the overall appearance of a compact ice hockey puck shape.” *Id.* at *17-18, 21. The Board also specifically noted that while both designs were circular and cylindrical,

“there is a significant difference in the diameter to height ratio between Lee and the claimed design...It is clear from even a cursory comparison that Lee is thinner and has a proportionally larger diameter compared to the distinctive smaller diameter and thicker profile of the claimed charger. Given this proportional difference in the overall appearances of the two designs Lee appears as more of a flatter, thinner, disc shape rather than a compact ice hockey puck shape.”

Id. In view of these differences in proportions, the Board held that Lee was not “basically the same as the compact ice hockey puck design of the claimed design.”

Id. Other grounds of invalidity were also rejected for reasons that included differences in the proportions of the claimed design as compared to the prior art. *Id.* at *38, *49-50.

Instead of addressing the clear differences in proportions of the individual jar design features in the D ‘151 patent and the designs in the cited prior art, Petitioner brushes them aside and suggests that gross differences in proportions are still ‘ever so slight’, asserting for example, that a jar with a tall base, short neck, and narrow shoulder presents the “same overall visual appearance” as the jar of the D ‘151 patent

with its short, wide base, tall neck, and a prominent shoulder. (Petition, pp. 48-50).

A simple comparison below immediately shows how ridiculous this conclusion is:

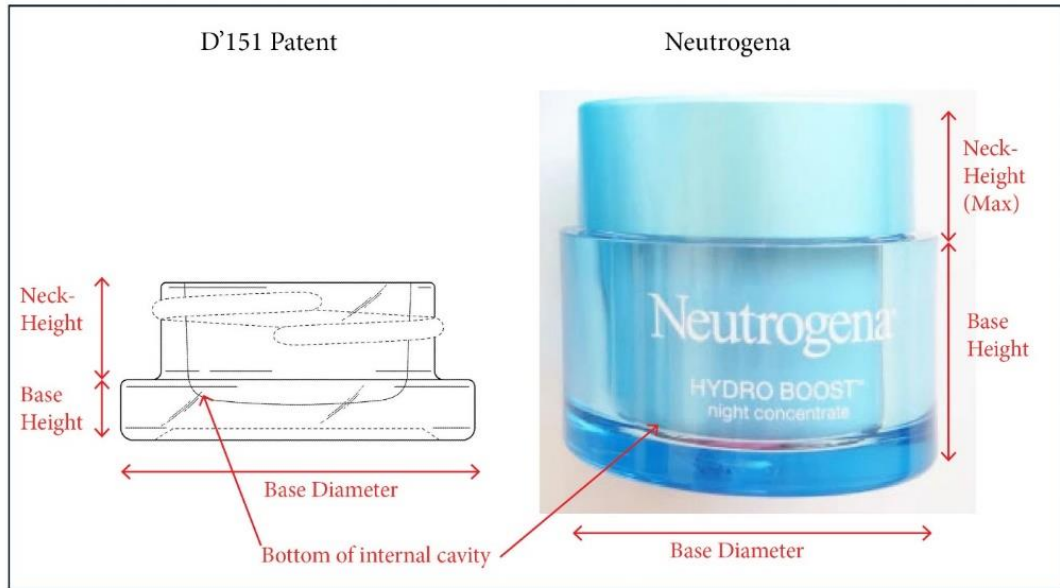


As addressed herein, Petitioner fails in each ground to consider the overall design as a whole, and that includes the overall proportions of the design as illustrated by *Masimo Corp. v. Apple Inc.*, When the design as a whole is considered, none of the proposed grounds create the same overall appearance as the claimed design and, accordingly, the petition for *inter partes* review should be denied.

B. Ground 1: Petitioner Fails to Meet Its Burden of Showing Alleged Obviousness based on the Neutrogena Jar in view of the D'891 patent (Canamasas Puigbo)

A cursory comparison the designs Petitioner submitted as prior art references for the D '151 patent, the Neutrogena Jar and the bottle of the D '891 patent, shows

that the proportions of the D '151 patent are entirely different from the submitted references and no combination of this prior art could result in a design that presents the same overall visual appearance as in the D '151 patent. EX2001 at ¶¶ 72, 74. Each reference is addressed in turn below.



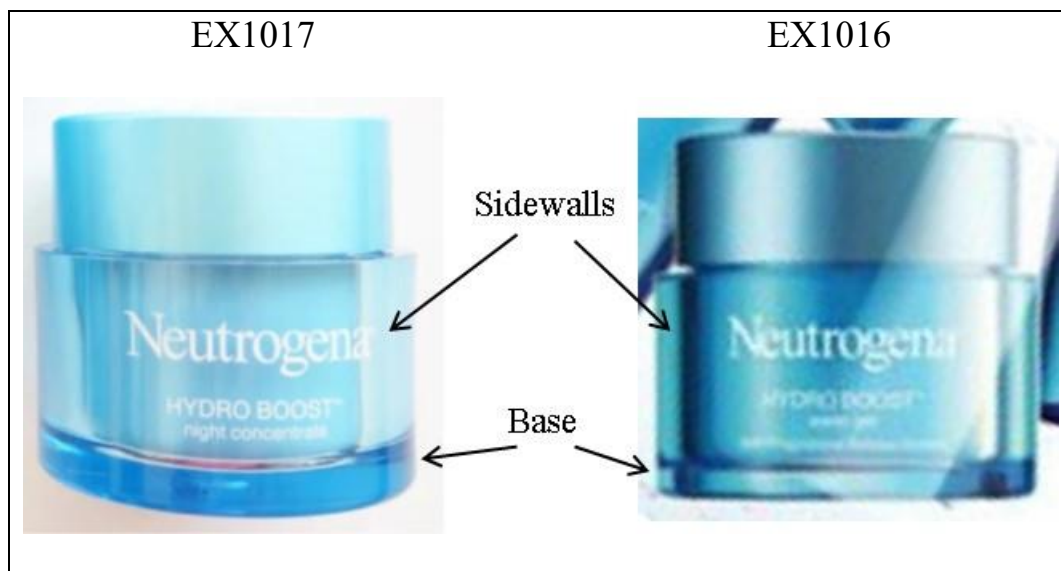
In comparing the Neutrogena jar to the D'151 jar, Petitioner and its expert focus on specific discrete features of the two jars, such as curved edges, transparency, a wider base than the neck, vertical sidewalls, and an internal compartment, finally concluding that the two very different jar designs still have “the same overall visual appearance.” (Petition pp. 45-48; EX1011, Pars. 84-86). This conclusion is wrong on its face because it improperly focuses only on selected individual features while conspicuously ignoring the design as a whole. *LKQ Corp.*, 102 F.4th at 1299. As is immediately apparent from the image above, the two jars

present fundamentally very different visual appearances with the D ‘151 jar and Neutrogena jar differing proportionally in (1) base height, (2) height of the neck, (3) neck diameter, (4) shoulder width relative to base height, and (5) depth of the interior cavity. EX2001 at ¶¶ 67, 74.

The jar of the D ‘151 patent has a tall neck that is slightly greater than 1.5 times the height of the base with a relatively narrow neck portion, about $\frac{3}{4}$ the diameter of the base, creating a significant horizontal offset shoulder. The interior portion extends downwardly from the top of the jar with slightly tapered side walls, ending in a gently concave bottom that extends only slightly into the base portion. Overall, the proportions give the jar an elegant, but solid character, with a tall neck and a low, stable base. *Id.* at ¶¶ 34-36. In contrast, the Neutrogena jar has a base that is at least three times the height of the jar of the D ‘151 patent, a neck that is much shorter than its base, a small shoulder relative to the base height, and an internal cavity that extends almost completely through the base. *Id.* at ¶¶ 43-44. Even, assuming *arguendo* that there are discrete features which are similar in isolation, the two designs considered as a whole present dramatically different visual appearances. *Id.* at ¶¶ 43, 67-72. *Masimo Corp. v. Apple Inc.*, IPR2023-00831, Paper 9, 2023 Pat. App. LEXIS 3912 at 28 (prior art disc shaped charger not basically the same as claimed hockey puck shaped design because of significant differences in diameter to height ratio of the two designs); *Cf. Ideavillage Prods. Corp.*

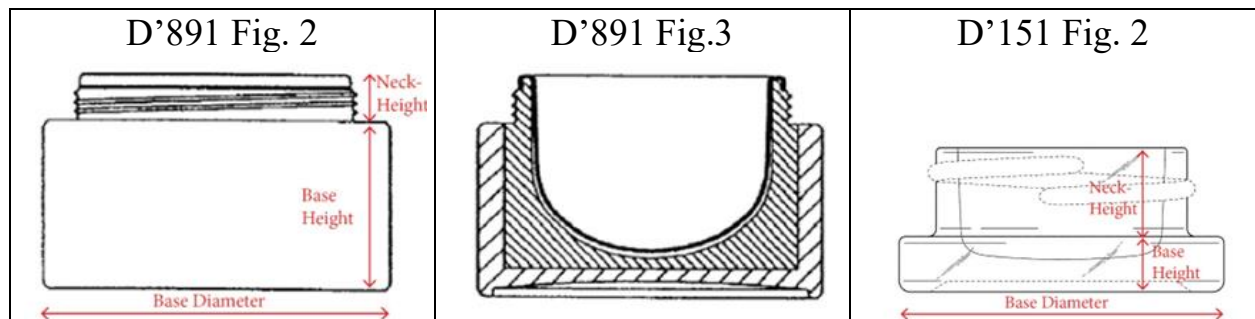
PGR2021-00116, Paper 6, 2022 Pat. App. LEXIS 1763 at *19 (quoting Petitioner’s expert’s testimony that knowing the relative proportions is “crucial” for one of ordinary skill in the art to understand a claimed design).

Petitioner also claims that the Neutrogena jar interior has “a slight concavity to its bottom surface with a curved transition between the sidewalls and the bottom surface” without offering any supporting evidence. Petition, p. 48, EX1011 at Par. 85, 88. While it is quite apparent that, unlike the design in the D ‘151 patent, the interior of the Neutrogena jar extends nearly to the bottom of the base, it is impossible to tell, for example, if sidewalls are thick or thin or if the bottom is flat or curved because the view of the interior is distorted and looks noticeably different in the Neutrogena jar exhibits Petitioner submitted, as shown below. EX2001 at ¶¶ 41, 44.



Moreover, in EXS 1016 and 1017, it is at best the *periphery* of bottom of the interior that is visible. The actual bottom of the interior is hidden, and it is impossible to tell what the contour of the bottom might be, much less conclude that it is slightly concave. Id. at ¶¶ 44, 70, 73.

A side-by-side comparison of the bottle claimed in the D ‘891 patent and the jar claimed in the D’151 patent, is shown below.



The bottle of the D ‘891 patent looks like the Neutrogena jar (but possibly with an even shorter neck) and is equally as different in design from the jar of the D ‘151 patent as the Neutrogena jar. Like the Neutrogena jar, the bottle of the D ‘891 patent presents a totally different visual appearance from jar of the D ‘151 patent, including, but not limited to, differences in: (1) base height, (2) height of the neck, (3) shoulder width relative to base height, and (4) shape and depth in the base of the interior cavity. EX2001 at ¶¶ 52-53. No matter how the features of the Neutrogena jar and the bottle of the D ‘891 patent are combined, there is simply no way that the

combination could result in anything even close to being the same visual design as a whole as that of the D ‘151 patent. Id. at ¶ 74.

Petitioner appears to argue that the Neutrogena jar could, if necessary, be further modified to incorporate the design of the interior of the bottle of the D ‘891 patent (Canamasas Puigbo). (Petition, p. 56, EX1011 at Par. 98). Even if this modification were made, the combination would still result in a jar with the Neutrogena exterior and having an interior that, like the Neutrogena jar, extended substantially to the bottom of the jar. The interior would have a generously rounded bottom. This combination still would have a substantially different overall visual appearance and impression as a whole as compared to the design of the D ‘151 patent.⁶ EX2001 at ¶¶ 72-74.

Petitioner relies on its expert in an effort to bridge the significant gap between the combined prior art and the claimed design. Petitioner and its expert argue that the height and width of the neck of a jar, such as the Neutrogena jar, has function and a designer of ordinary skill in the art would have found it obvious to adjust these

⁶ Petitioner also argues that it would have been obvious to modify the neck of the Neutrogena jar to give it the top surface and sidewall transitions of the D ‘891 patent bottle. (Petition, p. 55). Whether obvious or not, this modification is immaterial given the substantial differences in overall visual design discussed herein.

parameters “to optimize the volume of the compartment”, for amorphous and irrelevant reasons related to tool access to the interior, in order to match the size of a cap, and for “aesthetic” reasons. (Petition, p. 50, 56-57, EX1011 Pars. 90, 98-100). Likewise, Petitioner argues that it would have been obvious to adjust the curvature of the bottom surface of Neutrogena jar (and presumably Neutrogena in combination with the bottle of the D ‘871 patent) to allow easy access to the jar contents with a finger and for “aesthetic” reasons (p. 56, pars 97-98).

However, neither the Petitioner nor its expert provides any patent or prior art basis to support the conclusion that a designer of ordinary skill in the art would select, from all the possible ways in which these features could be changed, the specific changes needed to produce the claimed design of the D ‘151 patent. It is wholly improper for Petitioner to rely on its expert to bridge the gap between the disclosure in the prior art and the claimed design. *Inter partes* review can only be requested on the basis of what is taught in prior art patents or printed publications. 35 U.S.C. § 311(b). “[E]xpert testimony cannot take the place of disclosure from patents or printed publications. In other words, expert testimony may explain ‘patents and printed publications, but is not a substitute for disclosure in a prior art reference itself.’” 2019 Practice Guide at 36. The ‘bridge the gap’ testimony relied on by Petitioner is not to explain the prior patents or printed publications, or argue how they could be combined, but instead is a red herring offered in an attempt to

substitute testimony for claimed design features not disclosed in the prior art on which Petitioner relies. The Board has consistently held that “[t]estimony cannot take the place of disclosure in a prior art reference, when that disclosure is required as part of the unpatentability analysis”. *Samsung Electronics Co. Ltd. et al. v. Power2B, Inc.*, IPR2022-0035, Paper 36, 2023 Pat. App. LEXIS 2113 at *59-60 (PTAB June 26, 2023). *See also, Hesai Technology Co. Ltd. et al v. Ouster, Inc.*, IPR2023-01458, Paper 8, 2024 Pat. App. LEXIS 1269 at *14 (PTAB Mar 28, 2024) (expert testimony to fill in a claim limitation missing from the cited prior art is an improper attempt to substitute testimony for disclosure in the prior art) (citing 2019 Trial Practice Guide); *Nichia Corp. v. Document Security Systems, Inc.*, IPR2018-01165, Paper 28, 2018 Pat. App. LEXIS 13204 at *56-57 (PTAB Dec. 10, 2019) (expert testimony that a limitation missing from the prior art is insubstantial and would have been obvious to one of ordinary skill rejected as an improper attempt to substitute testimony for a disclosure in the prior art) (citing Trial Practice Guide update 2018). Based on precedent and for the reasons explained above, the Board should similarly reject this aspect of Petitioner’s expert testimony as an improper attempt to substitute testimony for a disclosure missing in its prior art submission.

Further, Petitioner’s characterization of the changes needed to produce the D ‘151 patented design as being minor or *de minimis* (Petition, pp. 57-58) is absurd on its face. The differences between the designs are significant. EX2001 at ¶¶ 75-77

and the changes needed to morph the design of the Neutrogena jar to create the design of the D ‘151 patent are not minor design features that do not impact the overall appearance. This is in significant contrast to the designs considered in *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1334 (Fed Cir. 2014), cited by Petitioner, in which the Court found that slight differences in placement of ornamental stitching on a football jersey were *de minimis*. and in contrast to the situations addressed in the other cases cited by Petitioner for support.⁷

⁷ *In re Nalbandian*, 661 F.2d 1214 (C.C.P.A. 1981) (where claimed tweezer design was “substantially identical in overall configuration” of the prior art, “slight” differences of fluting on finger grips and curve pincers were *de minimis* differences); *In re Carter*, 673 F.2d 1378 (C.C.P.A. 1982) (where shape of infant garment in primary reference was “nearly identical” to claimed design it was obvious to modify to the flap shape of the primary reference to be that disclosed in the secondary reference); *In re Chung*, No. 00-1148, 2000 U.S. App. LEXIS 24916 (Fed. Cir. Oct. 4, 2000) (addressing rejection of a design claim to a cigarette package and affirming decision that two small depressions on the interior of a cigarette package considered *de minimis* difference relative to the prior art when the depressions were not observable when the cigarette packet is closed and therefore did not enhance the saleable value of the package); *In re Cooper*, 480 F.2d 900 (C.C.P.A. 1973) (claim

Petitioner relies on *MRC Innovations* for the proposition that design patents can be found invalid “despite the inclusion of ornamental features that were entirely absent from prior art designs” (Petition p. 57). This reliance is misplaced. In *MRC Innovations*, the Court considered if a design patent could be invalid if *de minimis* changes to a prior art design were needed to add a feature not in the prior art but within the skill of an ordinary designer. 747 F.3d at 1335. However, that decision was made in the context of the invalidity burdens and rules for a district court action, *not* an *inter partes* review that can only be requested on the basis of prior art patents or printed publications. 35 U.S.C. § 311(b). Further, as explained *supra*, in an *inter partes* review petition, expert testimony cannot substitute for disclosure in the prior art, even where the expert’s opinion is that the feature is insubstantial and would have been obvious to add, as Petitioner’s expert improperly offers here. U.S. Patent and Trademark Office, Patent Trial and Appeal Board, Consolidated Trial Practice Guide 36 (Nov. 2019).

For example, in *Nichia Corp. v. Document Security Systems, Inc.*, the Board ruled against petitioner in a challenged claim that required that an LED be connected

to barrel shaped building obvious over prior art despite minor differences in features such as windows and single vs. double doors, where prior art “succeeds quite well in looking like a barrel”).

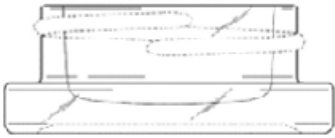
to electrical leads that supply power when this connection (of the LED to power), was not in the prior art but where petitioner's expert testified that the missing limitation was "insubstantial" and it would have been obvious to connect an LED as recited in the claim. *Nichia Corp., v. Document Security Systems, Inc.*, IPR2018-01165, Paper 28, 2019 Pat. App. LEXIS 13204 at *56-57. Citing to the Trial Practice Guide, the Board found this to be an improper attempt to substitute expert testimony for disclosure in the prior art. Because there was no disclosure of this claim feature identified in a prior art reference, the Board held that petitioner did not meet its burden to show the claim would have been obvious over the prior art. *Id.* at *57-58. The same result is warranted based on the facts here.

Likewise, contrary to Petitioner's claim, the proposed design changes here are not *de minimis*. To get from the Neutrogena jar design (with or without the bottle design of the D '891 patent) to the design of the D '151 patent would require entirely changing the proportions of the jar – from a short neck with a tall base to a tall neck with a short base, from an interior that goes nearly to the bottom of the base to one that extends only slightly into the base. EX2001 at ¶¶ 75-77.⁸ Merely changing the

⁸ The circumstances here are very different than those considered, for example, in *Campbell Soup Co. v. Gamon Plus, Inc.*, cited by Petitioner, in which the Court held that a reference showing a can dispenser without a can within it was a proper primary

height of the Neutrogena jar neck to have the same neck-height to base-height ratio as that of the D'151 Jar (slightly greater than 1 ½ x higher), as Petitioner suggests on p. 46, without also changing the other dimensions of the jar would yield a ridiculous result that looks at least as different from the D'151 jar as the original Neutrogena jar as shown below. *Id.* at ¶ 76.

reference that presented “basically the same visual impression” as a claimed can dispenser, where the claim included the can because the differences due to issues related to size of the can was “ever-so-slight”. 939 F.3d 1335, 1341 (Fed. Cir. 2019). In a subsequent appeal in this matter following a remand, the ‘ever-so-slightly’ differing designs were described as being “virtually indistinguishable”. *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2021).

D'151	Neutrogena with increased neck height
	

Petitioner conveniently ignores these significant differences. These proportions do matter and significantly impact the visual impression of the claimed design as a whole. *See, Masimo Corp. v. Apple Inc.*, IPR2023-00831, Paper 9 at 28, 2023 Pat. App. LEXIS 3912 at *28 (proportions of claimed design different from cited art); *Cf., Ideavillage Products Corp. v. Koninklijke Philips N.V.*, PGR2021-00116, Paper 6, 2022 Pat. App. LEXIS 1763 at *19 (quoting Petitioner’s expert’s testimony that the proportions of a design are “crucial” for one of ordinary skill in the art to understand a design patent claim). Moreover, Petitioner presents no basis – much less support in a prior art patent or printed publication – under which a designer of ordinary skill in the art would further modify the proposed prior art

combination in the specific way needed to somehow arrive at the jar design of the D ‘151 patent.

In *Next Step Group, Inc. v. Deckers Outdoor Corporation*, IPR2024-00525, Paper 16, 2024 Pat. App. Lexis 2897 (PTAB, Aug. 6, 2024), it was argued that a design patent for the ornamental design for a footwear upper was, *inter alia*, anticipated or obvious and raised similar issues about further modifying the prior art produce the claimed design. Among the differences between the claimed design and cited art that the Board considered was that the “top opening of the footwear of the [challenged] patent appears to constitute more than 50% of the length of the boot in contrast to the opening depicted in [the prior art].” *Id.* at * 43. Next Step tried to side-step this difference by arguing that “any differences ... [in] proportions would have been obvious because they are purely functional, rather than ornamental”⁹, that changing the length and width of footwear would have been obvious “because a designer would ‘understand that any given footwear upper could be easily modified to be longer or shorter depending on the application”, and “that a designer of ordinary skill would have been motivated to vary the overall size of the footwear upper to suit the particular application.” *Id.* at *44. The Board squarely and correctly

⁹ Petitioner here does not argue that neck height is “purely functional” but merely that the feature has some functionality.

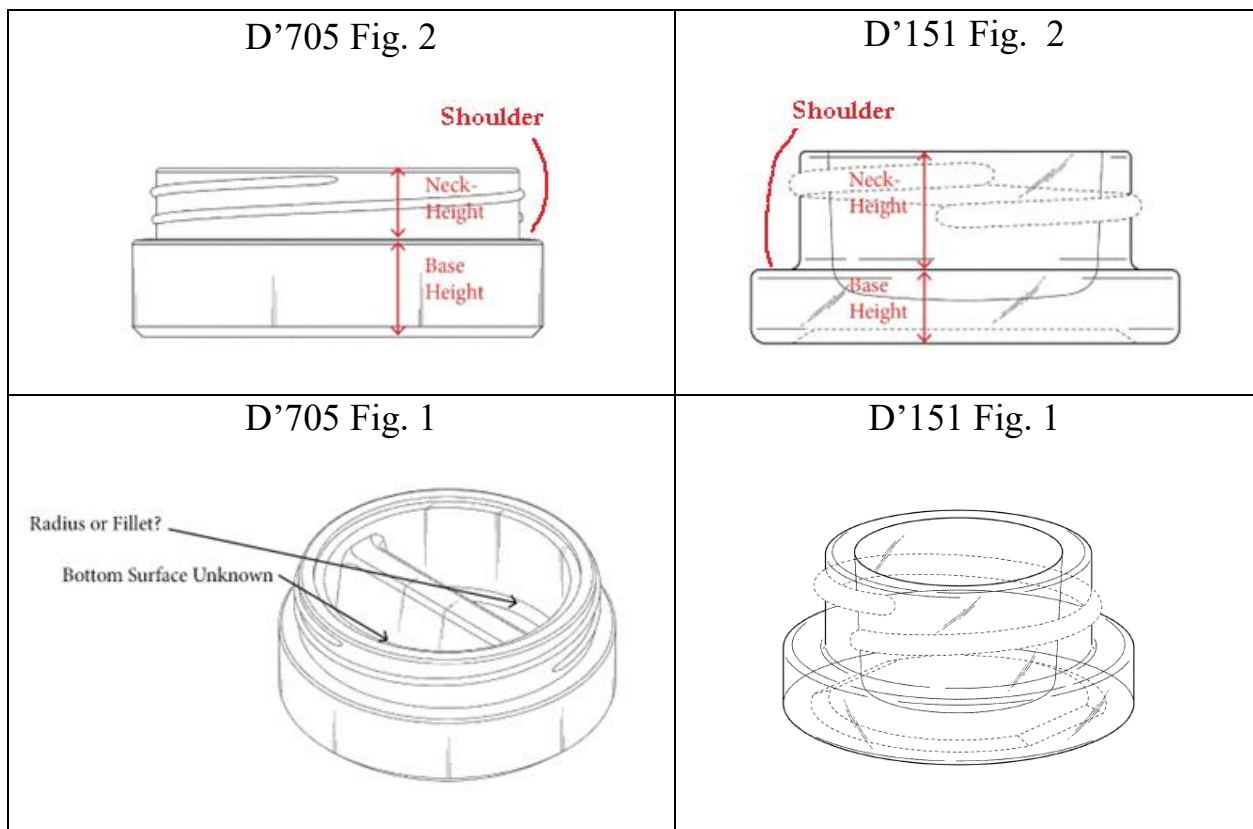
rejected these arguments because Next Step “fail[ed] to address the differences between the overall appearance of the claimed design and the cited reference, including the ratio of the length of the foot opening to the length of the boot.” *Id.* at *44. Responding to Next Step’s argument to modify the primary reference to add a pull tab to the back of the shoe since this was a common, well-known industry feature, the Board rejected this argument as well because “Petitioner does not offer adequate reasoning why a designer would select, from all the possible design options, the specifically configured pull tab of the claimed design”. *Id.* at *44-*45

Likewise, to the extent that this aspect of Petitioner’s expert testimony is considered here, its expert provides no reason, other than impermissible hindsight, why a designer of ordinary skill in the art would select, from all the possible ways in which these features could be adjusted for physical or aesthetic reasons, the many changes needed to produce the design of the D ‘151 patent. *Updated Guidance* at 3 (warning against impermissible use of hindsight in an obviousness analysis); EX2001 at ¶ 77.

Accordingly, Petitioner has failed to demonstrate a reasonable likelihood that it would prevail on Ground 1.

C. Ground 2: Petitioner Fails to Meet Its Burden of Showing Alleged Obviousness based on the D ‘705 patent to Huang in view of the D ‘891 patent to Canamasas Puigbo

As with the Neutrogena jar, a cursory comparison of the design of the D ‘151 patent with that of the container of the D ‘705 patent (EX1007) shows that the proportions of the two designs are drastically different, giving these designs completely different overall visual appearances. EX2001 at ¶¶ 48, 79-80. Side and perspective views of the representative figures from the D ‘705 patent and the D ‘151 patent are shown below.



The container of the D ‘705 patent has a neck height that is smaller than the base height, but with a proportional difference in neck-to-base height that is not very

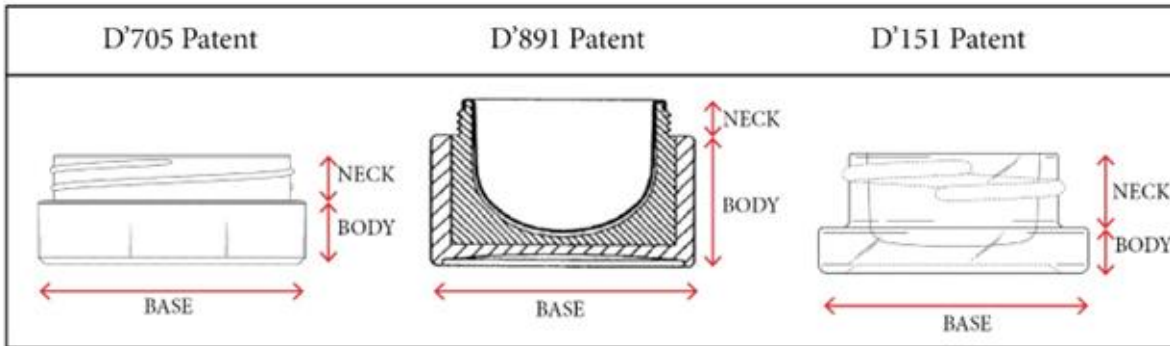
large. In contrast, the jar of the D ‘151 patent has a neck that is much higher than the base, slightly more than 1 ½ times. The diameter of the neck of the D ‘705 container is relatively large compared to the diameter of its base giving it a small shoulder, in contrast to the much larger shoulder of the D’151 jar. The shoulder width relative to base height of the D’705 container is also much smaller than that of the D’151 jar due to the combination of the smaller shoulder and taller base of the D’705 container relative to the wider shoulder and shorter base of the D’151 jar. EX2001 at ¶¶49, 79. Because the height of the neck and the height of the base of the D’705 container are similar, there is a symmetry and balance to the container of the D ‘705 patent. In contrast, because the height of the neck of the D ‘151 jar is so much greater than the height of its base, the jar of the D ‘151 patent presents a much lighter visual appearance, but with a less balanced look and feel than the container of the D ‘705 patent. Id. at ¶¶ 79-80.

The interiors of the container of the D ‘705 patent and the jar of the D ‘151 patent are also very different. The container of the D ‘705 patent has a prominent divider that separates the container’s interior into two compartments, one compartment that appears to extend deep into the base, in contrast to the interior of the jar of the D ‘151 patent, which extends only slightly into the base, and one compartment with a depth that cannot be determined. Id. at ¶¶ 48-49, 80.

Petitioner and its expert argue that any differences between the design of the D ‘705 patent and the design of the D ‘151 are merely minor and therefore the two designs still present “the same overall visual appearance.” (Petition, p. 63, EX1011 at Par. 107). While both designs have the same parts any cylindrical jar or container would have—a base, a neck, a shoulder, and an interior—considering these features individually totally and impermissibly ignores the details of the two designs as a whole, including the overall proportions of each design, and is contrary to the Federal Circuit’s requirements. *LKQ Corp.*, 102 F.4th at 1299; *Masimo Corp. v. Apple Inc.*, IPR2023-00831, Paper 9, 2023 Pat. App. LEXIS 3912 at *28. *Cf.*, *Ideavillage Products Corp. v. Koninklijke Philips N.V.*, PGR2021-00116 Paper 6 at *19, 2022 Pat. App. LEXIS 1763 at *19 (quoting Petitioner’s expert’s testimony that the proportions of a design are “critical” to understanding a design patent claim).

When the design of each is considered as whole, the multiple differences between the container of the D ‘705 patent and the jar of the D ‘151 patent are quite substantial and cannot be overlooked as Petitioner apparently does. The designs are substantially very different in appearance, differing proportionally in (1) base height, (2) height of the neck relative to the base, (3) neck diameter, and (4) shoulder width relative to base height. Further, (5) the shape of the interior cavities are very different, and (6) the container of the D ‘705 patent is opaque while the jar of the D ‘151 is transparent. EX2001 at ¶ 80.

Petitioner argues that it would have been obvious to “simply substitute [D’705 to] Huang’s compartment shape with Canamasas Puigbo’s [D’891].” (Petition, p. 68). The three designs are shown below.



Such a modification would entirely undermine the central feature of the D ‘705 design as a “*Compartmentalized Container*.” (emphasis added); *Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 Fed. Appx. 755, 758 (Fed. Cir. 2015) (“combinations that change the basic principles under which the [prior art] was designed to operate, . . . may fail to support a conclusion of obviousness.”); EX2001 at ¶ 81. Moreover, the interior of the D ‘891 bottle is huge and was designed to extend nearly to the bottom of a very high base portion, not the lower profile of the container of the D ‘705 patent. A designer of ordinary skill in the art who wanted to use the design of the interior of the D ‘891 bottle art would need make the base of the container of the D ‘705 patent significantly taller so that the interior of the D ‘891 bottle would fit. *Id.* at ¶¶ 84-85.

Modifying the D ‘705 container to have just a single interior chamber, as in the D ‘891 patent bottle, would not produce the interior design of the D’151 jar. It also would do nothing to alter the significant proportional differences between the design of the ‘D’705 container and of the D’151 jar, which as stated, give the two designs significantly different overall visual appearances. *Id.* at ¶ 84. Further modifying the combination to make the D’705 container transparent like the flask of the D ‘202 patent (Petition, p. 68) would not change this. *Id.* at ¶ 87.

In an effort to bridge the gap, as it did in Ground 1, Petitioner, relies on its expert to argue that a designer of ordinary skill in the art would have found it obvious to modify the neck height of the D ‘705 patent container to produce the base-to-neck height proportions of the D ‘151 patent jar. (Petition, p. 64, 71, EX1011 Par. 109). Such an argument is completely improper. As discussed above with respect to Ground 1, a petition for *inter partes* review can only be requested on the basis of what is disclosed in prior art patents or printed publications; Petitioner cannot rely on its expert to fill in features missing from the prior art, even if its expert argues that the modifications needed to get from the prior art to the claimed design are *de minimis* and would have been obvious. 35 U.S.C. § 311(b); 2019 Trial Practice Guide at 36; *Nichia Corp. v. Document Security Systems, Inc.*, IPR2018-01165, Paper 28, 2918 Pat. App. LEXIS 13204 at *56-57 (PTAB Dec. 10, 2019).

Petitioner's suggestion that the design of the neck is not important because the cap on a container would obscure the neck while the cap is on (Petition at 64) is totally irrelevant because the claimed design is for a capless jar and, in any event, a cap would obviously be removed when the container is used such that the neck would then be visible. *In re Chung*, No. 00-1148, 2000 U.S. App. LEXIS 24916 at *9 (Fed. Cir. Oct. 4, 2000) (cited by Petitioner) (rejecting the argument that design claim features not observable when a container is closed are not relevant to patentability when those features are visible when the container is opened during normal use).

Moreover, while neck height could physically be changed from one that is shorter than the base to one that has a height slightly more than 1.5 times the base height, as discussed with respect to Ground 1, Petitioner has not offered any evidence on what would motivate a designer to completely alter the basic proportions of the D'705 container in this manner. If the goal is to increase the volume of the interior, many features could be changed individually or in combination, including neck height, neck width, base height, and depth and width of the interior, or the entire jar could just be scaled up to preserve the ratio of the base height to neck height. EX2001 at ¶ 83. Simply stated, Petitioner provides no reason at all why a designer of ordinary skill in the art would select, from all the possible ways to increase volume, other than through impermissible hindsight, the changes to the neck height

that would match the design of the D ‘151 patent. *See e.g., Next Step Group, Inc. v. Deckers Outdoor Corporation*, IPR2024-00525, Paper 16, 2024 Pat. App. Lexis 2897 at *43-45 (PTAB, Aug. 6, 2024) (rejecting arguments that modifying the length and width of footwear depending on application would have been obvious because petitioner “fail[ed] to address the differences between the overall appearance of the claimed design and the cited reference including....the ratio of the length of the foot opening to the length of the boot” and because, with respect to the configuration of a separate feature, “Petitioner does not offer adequate reasoning why a designer would select, from all the possible design options” the feature specifically as shown in the claimed design.).

Even if, *arguendo*, the neck height of the D ‘705 patented container was changed from being less than the base height to slightly more than 1.5 times the base height, the modified container would still have very different width-to-height ratios for the base and different neck widths/shoulder sizes, differences that the Petitioner conveniently fails to address in Ground 2. *See e.g., Masimo Corp. v. Apple Inc.*, IPR2023-00831, Paper 9 at 28, 2023 Pat. App. LEXIS 3912 at *28 (finding two disk shaped charger designs not basically the same where one was thin with a large diameter while the other was narrower and taller).

Accordingly, Petitioner has failed to demonstrate a reasonable likelihood that it would prevail on Ground 2.

D. Ground 3: Petitioner Fails to Meet Its Burden of Showing Alleged Obviousness based on the D ‘705 patent to Huang in view of the Neutrogena Jar

In Ground 3, Petitioner argues that the claim of the D ‘151 patent is obvious over the container design of the D ‘705 patent in view of the Neutrogena jar.



The substantial differences between the container of the D ‘705 patent and the jar of the D ‘151 patent are discussed above with respect to Ground 2 and incorporated here. *See also* EX2001 at ¶¶ 89-90. In Ground 3, Petitioner argues that would have been obvious to remove the divider separating the container interior of the D ‘705 patent into two compartments and to “incorporate the concave bottom surface of the compartment of Neutrogena” (as opposed to using the interior shape of the D ‘891 patent as in Ground 2). (Petition, p. 79). This argument clearly fails because Neutrogena does not disclose an interior with a concave bottom surface. Instead, the bottom surface of the Neutrogena jar is not visible in any of the documents submitted by Petitioner. Rather, only its periphery can be seen. *Id.* at ¶ 92.

What is disclosed in the Neutrogena jar is an interior that extends almost all the way through the base. Replacing the interior of the container of the D ‘705 patent with that of the Neutrogena jar would therefore also result in a container with an interior that extends almost all the way through the base and that has an undefined bottom, unlike the design of the jar of the D ‘151 patent, which has an interior that extends only slightly into the base, and with a gently concave bottom. *Id.* As discussed above with respect to Ground 2, the combination of the D ‘705 patent teaching with the interior of the Neutrogena jar would also result in a container design differing substantially from the design of the D ‘151 jar in the diameter of the neck, height of the base, height of the neck, the shoulder width, and shape of the interior. In other words, the combination would result in a design which is very different from that of the D ‘151 patent. *Id.*

Lastly, Petitioner, for the same reasons as proposed in Ground 2, argues that it would have been obvious to modify the design of the D ‘705 patent by adjusting the length of the neck in order to achieve the design of the D’151 jar. (Petition, p. 82-83). This argument is totally improper for the same reasons discussed above with respect to Grounds 1 and 2 and incorporated here. *See also*, EX2001 at ¶ 93.

Accordingly, Petitioner has failed to demonstrate a reasonable likelihood that it would prevail on Ground 3.

E. Ground 4: Petitioner Fails to Meet Its Burden of Showing Alleged Obviousness based on the McKernan Jar in view of the D ‘202 patent to Zamberlan and common knowledge in the art

1. The Board has already considered the combination of McKernan Jar and the D ‘202 patent and held the combination would not result in the same overall visual design as the D ‘151 patent.

Ground 4 proposes a combination of the “McKernan Jar” and the flask of the D ‘202 patent. The Board has already considered this combination of references and held that the combination did not render the design of the D ‘151 patent obvious. Although the Board’s reexamination decision was issued when the *Rosen-Durling* two-part test for obviousness was in effect, its conclusion was not constrained by *Rosen-Durling* and is equally valid following the Federal Circuit’s *LKQ Corp.* decision. Noticeably, Petitioner has not identified any error in the Board’s prior analysis, and it presents no valid reason for the Board to revisit the same arguments it has already considered and rejected.

Petitioner suggests that because the reexamination was conducted under *Rosen-Durling*, the recent *LKQ Corp.* decision could change the outcome. (Petition at 96). Petitioner is wrong. While *LKQ Corp.* opens the door for a wider range of prior art that to be used in an obviousness analysis, that change would not have altered the Board’s decision, and even though the Board found that under *Rosen-Durling* the McKernan jar was not a suitable primary reference and the D’202 patent was not sufficiently ‘so related’ be a secondary reference, significantly it did not stop

its analysis there. The Board went further and expressly considered the same combination of the McKernan Jar and the D ‘202 patented flask that Petitioner now presents in Ground 4 – namely modifying McKernan to be transparent and to have an interior shape like that of the D ‘202 flask. Reexam Appeal Decision, EX2002 at 13. The Board held that even if these references were combined, the combination would not have resulted in the same design as the jar of the D ‘151 patent. Instead, there would be substantial visual differences. *Id.* The same result is warranted here.

Petitioner also suggests that the Board’s decision should be reconsidered because Petitioner’s expert testimony here was not previously considered. (Petition at 15-16, 96). As explained in detail above, this suggestion is nothing but a red-herring as Petitioner’s expert testimony fails to present any new basis for obviousness that should be considered or reconsidered.

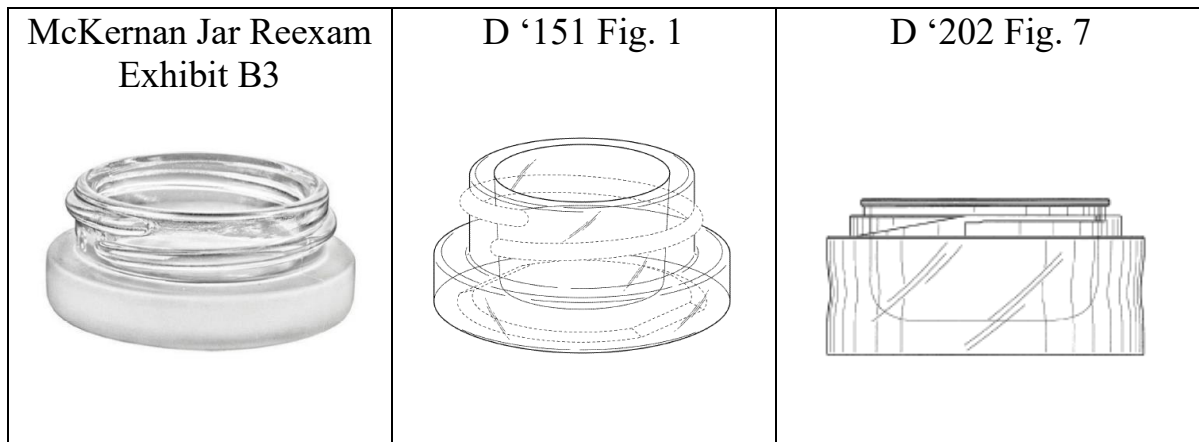
Indeed, Petitioner’s expert testimony arguing for the combination of the McKernan Jar with the D’202 flask adds nothing new because the Board already considered that combination on its merits. Petitioner also relies on testimony of its expert that that a designer of ordinary skill in the art, starting with the combination of a transparent McKernan Jar having the interior design of the D ‘202 flask, would have found it obvious to further modify that design to alter design features including the proportion of the neck height relative to the base, the angle of the interior sidewalls, the depth the interior extends within the base, and the degree of curvature

of the bottom of the interior, thereby achieving the design of the D ‘151 patent. Petition at pp. 91-94; EX1011 at 151-157. Once again, Petitioner is improperly trying to use expert testimony to fill in the gaps between the claimed design of the D ‘151 patent and what is disclosed in the prior art. As discussed above, *inter partes* review can only be requested on the basis of what is taught in prior art patents or printed publications, 35 U.S.C. § 311(b), and “expert testimony cannot take the place of disclosure from patents or printed publications.” 2019 Trial Practice Guide at 36. While an expert “may explain ‘patents and printed publications,’ [expert testimony] is not a substitute for disclosure in a prior art reference itself.” *Id.* See also, *Hesai Technology Co. Ltd. et al v. Ouster, Inc.*, IPR2023-01458, Paper 8, 2024 Pat. App. LEXIS 1269 at *14; *Samsung Electronics Co. Ltd. et al. v. Power2B, Inc.*, IPR2022-0035, Paper 36, 2023 Pat. App. LEXIS 2113 at *59-60, and *Nichia Corp. v. Document Security Systems, Inc.*, IPR2018-01165, Paper 28, 2018 Pat. App. LEXIS 13204 at *56-57. Accordingly, and pursuant to the Board’s well-settled precedent, this other testimony of Petitioner’s expert’s is impermissible to consider in a petition for *inter partes* review therefore does cannot form a basis to revisit the Board’s prior decision.

2. The combination of the McKernan Jar and the D ‘202 patent does not result in the same overall visual design as the D ‘151 patent.

Even if the Board chooses to redo the same analysis it has done previously, Petitioner has failed to meet its burden because Petitioner again failed to demonstrate a reasonable likelihood it would prevail on Ground 4.

The McKernan Jar, as disclosed in Reexam exhibits B1-B3 (EX1003 at 431-436), and figures from the D ‘151 patent (EX1001) and the D ‘202 patent (EX1013) are shown below.



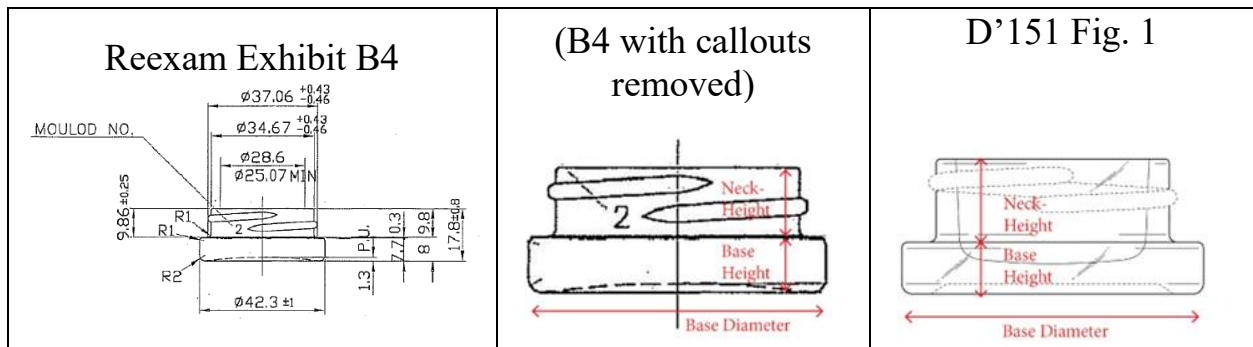
In the first place, the base of the McKernan jar is frosted, and as can be seen above, has a softer, rounder look with apparently larger fillets than the base of the jar of the D ‘151 patent. EX2001 at ¶ 95. Because of the frosted base, it is impossible to determine the shape of interior cavity of the McKernan jar. Id. at ¶¶ 61, 95; EX2002, Reexam Appeal Decision at 5. As such, there is no way to tell whether the side walls

are straight or tapered or how deep the cavity extends into the base, if at all, or the contour of the bottom of the interior.

Secondly, the visible portions of the pictured McKernan jar have noticeably different proportions than the proportions of the jar of the D ‘151 patent. The McKernan jar has a neck height that is only slightly greater than the base height, much less than the neck height of the D ‘151 jar at more than 1.5x base height. The neck of the McKernan jar is also noticeably wider, giving the jar a comparatively wide mouth with a shoulder that is relatively narrow as compared to the more pronounced shoulder and smaller mouth of the D ‘151 jar. EX2001 at ¶¶ 60, 95. These different proportions give the jar of the D ‘151 patent a markedly different look from the McKernan jar; in other words, the two designs are far from presenting the same overall visual appearance. Id. at ¶ 95. In fact, these differences in design are accentuated given the crowded small jar art as is well recognized. EX2002, Reexam Appeal Decision at 8-10 (citing *Egyptian Goddess, Inc. v Swisa, Inc.*, 543 F.3d at 675 and taking judicial notice that the small jar art is crowded and so smaller design differences matter more, and holding that while the shape of the McKernan jar was similar to that of the D ‘151 patent, the designs are not “basically the same”).

The engineering drawings of Reexam Exhibit B4 (EX1003, p. 438-439), even if considered appropriate printed publications for an *inter partes* review, provide no additional information about the shape of the interior of the McKernan’s jar below

the rim. EX2001 at ¶ 58. These drawings do make it clear that the neck height of the McKernan jar is only about 20% greater than the height of the base, compared to the about 50% difference with the jar of the D ‘151 patent, and that the shoulder of the McKernan jar is noticeably narrower than the shoulder of the D ‘151 patented jar design. Id. at ¶ 60.



Petitioner, relying on the flask design of the D ‘202 patent, argues that it would have been obvious to make the McKernan jar transparent. (Petition at 90) While transparency does have a functional aspect, deciding how much of a jar is transparent vs. frosted is very much a design choice. EX2001 at ¶ 98; *see also Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1322 (Fed. Cir. 2016) (features with functional purposes can nevertheless be considered ornamental). Even assuming, *arguendo*, that it would have been obvious to modify McKernan to be entirely transparent, the transparent version of McKernan jar would still be proportionally different from the jar of the D ‘151 patent giving the jars significant and materially different overall visual appearances. Id. at ¶¶ 99-101.

Petitioner's Ground 4 further suggests modifying the McKernan jar to have the interior as disclosed in the D '202 patent. Petition at 84, 93 (referring to the "interior compartment of the combination of the McKernan Jar and [D '202]"). Again, this is the very same combination that was considered during the Reexamination. Reexam decision at 13. Significantly, the interior chamber of the D '202 flask has straight sides and extends substantially through most of the base of the flask, ending in a flat bottom. This is very different from the design of the jar of the D '151 patent in which the internal cavity resides mostly in the neck of the jar, extends only slightly into the base portion and has a gently concave bottom and sidewalls that taper slightly inward. EX2001 at ¶ 101; Reexam decision at 13. While the so-modified combination of references would now define a jar having an interior, the overall visual impression of the design as a whole would still be materially different from the design of the jar of the D '151 patent. Stated differently, there is simply no way that McKernan and the flask of the D '202 patent could be combined by a designer of ordinary skill in the art such that the result would be a jar with the same overall visual appearance as the jar of the D '151 patent. EX2001 at ¶ 96.

As in prior Grounds, Petitioner again discounts neck height as having any weight to the overall design because changing neck height has a functional effect. This position is overly simplistic, narrow-minded, and conveniently ignores the fact that a design feature can have both functional and ornamental aspects. *Sport*

Dimension, Inc. v. Coleman Co., 820 F.3d 1316, 1322 (Fed. Cir. 2016). Petitioner suggests that neck height is functional because the threads for a cap are on the neck. (Petition at 94; EX1011 at 156). Petitioner’s suggestion, however, ignores the fact that the threads are not part of the claimed design of the D ‘151 patent. Moreover, nothing precludes a jar from being kept open or having a cap that is a friction fit such that it does not require threads; in fact, there is no specific configuration for the threads on the neck of a jar, as illustrated by comparing the threads shown in Fig. 2 of D ‘705 patent with those in Fig. 2 of the D ‘891 patent. (Ex1007, EX1008).

Petitioner implicitly acknowledges that the combination of the McKernan jar and the D ‘202 flask yields a jar design that is proportionally different from the D ‘151 patent, both inside and outside. Similar to its arguments in Grounds 1, 2, and 3, Petitioner argues, through its expert, that this combination can be further modified to give the interior a concave base and sloped sides, and that it would also have been obvious to change the interior to be of any depth, as well as obvious to adjust the height of the neck to be as long or short as desired. (Petition at 92-93, EX1011 at Par. 156-157).

As discussed above, this additional expert testimony should not be considered because it is an improper attempt to substitute expert testimony for disclosure in the prior art. 2019 Consolidated Trial Practice Guide at 36. Even if this testimony is considered, as discussed with respect to Grounds 1, 2, and 3, and as can well be

appreciated, there are virtually an infinite number of design choices that could be applied. To produce the jar design of the D ‘151 patent, the combination of McKernan and the D ‘202 patent would need to be modified to (1) make the neck taller relative to the base, (2) make the neck narrower relative to the base, (3) change the depth of the interior from going mostly through the base to going only slightly into the base, (4) change the contour of the interior from being flat to having not just a concave bottom, but rather a gently concave bottom, and (5) change the interior sidewalls from being straight to slightly tapered. The Petitioner does not offer any reason why a designer of ordinary skill in the art would select all of the specific changes that would be needed to create the jar design of the D ‘151 patent other than through the improper use of hindsight. EX2001 at ¶¶ 102, 106-107. *See e.g., LKQ Corp.*, 102 F.4th at 1299 (“there must be some record-supported reason (without hindsight) that an ordinary designer in the field of the article of manufacture would have modified the primary reference with the feature(s) from the secondary reference(s) to create the same overall appearance as the claimed design.”); *Next Step Group, Inc. v. Deckers Outdoor Corporation*, IPR2024-00525, paper 16, 2024 Pat. App. Lexis 2897 at * 43-45 (rejecting arguments that it would have been obvious to modify the length and width of footwear depending on application because petitioner “fail[ed] to address the differences between the overall appearance of the claimed design and the cited reference including....the ratio of the

length of the foot opening to the length of the boot” and because, with respect to the configuration of a separate feature, “Petitioner does not offer adequate reasoning why a designer would select, from all the possible design options” the feature specifically as shown in the claimed design.).

Petitioner references the D ‘891 bottle to illustrate that a designer of ordinary skill in the art would know of interiors with concave bottoms and sloped sides, but in fact does not specifically argue to modify the combination of the McKernan jar and the flask of the D ‘202 patent to use the interior of the bottle of the D ‘891 patent. (Petition at 91-93; EX1011 at 153). As such, this combination should not be considered as an alternative basis for obviousness. In any event, relying on D’891 merely to support the idea that a concave interior was known still does not avoid the fact that there are a myriad of different ways in which even a concave jar interior can be configured. Again, Petitioner provides no explanation of why a designer would select, from all the possible design options, the particular configuration of shape and depth of the D’151 jar. Moreover, even if the combination of the McKernon jar, the flask of the D’202 patent and the bottle of the D’891 patent were considered, the result would still not be the same visual impression as a whole as that of the D ‘151 patent and would differ in external proportions as well as the configuration of the interior. *LKQ Corp.*, 102 F.4d at 1299. Particularly in the case of a transparent jar, the shape of the jar’s interior is an important feature of the overall

visual design that should not be ignored. EX2001 at ¶¶103-104. As discussed above with respect to Ground 2, the D ‘891 patent teaches a deep and very concave interior that was designed to extend through a very tall base portion, not a base with a low profile like that of the McKernan jar. Id. at ¶ 104. A designer of ordinary skill in the art who wants to modify the McKernan jar to have the interior of the D ‘891 bottle would also need make the base of the McKernan jar significantly taller to accommodate that interior design. Id. at ¶ 104.

Accordingly, Petitioner has not demonstrated a reasonable likelihood that it would prevail on Ground 4.

IX. CONCLUSION

Petitioner, in all respects, has failed to demonstrate a reasonable likelihood that the claimed jar design of the D ‘151 patent is obvious in view of the teachings in the cited prior art. As previously explained, its futile arguments improperly focus on specific and compartmentalized design features while intentionally ignoring the designs as a whole, including the overall proportions of the particular design element.

Petitioner submits that none of the combinations proposed in Grounds 1, 2, 3, or 4 advanced by Petitioner would result in a design with the same overall appearance as the claimed jar design of the D ‘151 patent. In each Ground, Petitioner

tries to bridge the gap between the design that would perhaps result from the proposed obviousness combination and the jar of the D ‘151 patent.; Petitioner does this by simply offering expert testimony which opines that it would have been obvious to change and manipulate various differing design features of each combination in order to achieve the design of the D ‘151 patent. Suffice it to say, this argument is a legally improper attempt to substitute expert testimony for design features the Petitioner could not find in the prior art. Moreover, even if this testimony were considered, Petitioner presents no viable reason why, from the innumerable ways in which these design features could be modified and/or altered, a designer of ordinary skill in the art could have possibly created the jar of the D ‘151 patent except through impermissible hindsight. As such, Petitioner’s expert testimony should be precluded and not considered here.

Therefore, all of the presented grounds advanced by Petitioner for instituting an IPR in this matter should be denied in their entirety and the Board should deny this IPR in favor of the Patent Owner

Dated: October 28, 2024

Respectfully Submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned attorney for Patent Owner certifies that the document contains 13,614 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 October 28, 2024, a true and correct copy of the foregoing *PATENT OWNER'S PRELIMINARY RESPONSE* including exhibits was filed with the Patent Trial and Appeal Board Case Tracking System (P-TACTS) and served via electronic-mail to the Petitioner at the correspondence addresses of record as follows:

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