

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KLEIN TOOLS, INC.,
Petitioner,

v.

MILWAUKEE ELECTRIC TOOL CORP.
& KETER HOME AND GARDEN PRODUCTS, LTD.,
Patent Owner.

IPR2024-01401
Patent 11,794,952 B2

Before CARL M. DeFRANCO, ERIC C. JESCHKE, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

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

I. BACKGROUND

Petitioner Klein Tools, Inc. filed a Petition to institute *inter partes* review of claims 1–23 of U.S. Patent No. 11,794,952 B2 (Ex. 1001, “the challenged patent”). Paper 2 (“Pet.”). Milwaukee Electric Tool Corp. and Keter Home and Garden Products, Ltd. (collectively “Patent Owner”) timely filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). With prior authorization (Ex. 3001), Petitioner filed a Preliminary Reply to address discretionary denial under 35 U.S.C. § 325(d) (Paper 12 (“Prelim. Reply”)), to which Patent Owner filed an authorized Preliminary Sur-reply (Paper 13 (“Prelim. Sur-reply”)). With further authorization (Ex. 3002), Patent Owner filed an additional brief to address discretionary denial under 35 U.S.C. § 314(a) (Paper 14 (“*Fintiv* Br.”)), to which Petitioner filed an authorized opposition (Paper 15 (“*Fintiv* Opp.”)).

We have authority to determine whether to institute *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2024) (“The Board institutes the trial on behalf of the Director.”). *Inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314. Upon consideration of the evidence and arguments in the record, for the reasons below, we determine that the information presented shows a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. We thus institute *inter partes* review on all challenged claims on all asserted grounds. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1354, 1359–60 (2018); 37 C.F.R. § 42.108(a) (“When instituting *inter partes* review, the Board will

authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

A. Related Proceedings

The parties both identify two proceedings involving the challenged patent: (1) *Milwaukee Electric Tool Corp. v. Klein Tools, Inc.*, No. 1:24-cv-04928 (N.D. Ill.), filed June 13, 2024, in the U.S. District Court for the Northern District of Illinois (the “District Court Litigation”), and (2) *Certain Storage Containers and Toolboxes, Organizers, Component Boxes, Coolers, and Accessories Used Therewith*, Dkt. No. 337-TA-1409 (U.S. I.T.C.), filed June 13, 2024, in the U.S. International Trade Commission (the “ITC Litigation”). Pet. 5; Paper 3 (Patent Owner’s Mandatory Notices) at 3; Paper 10 (Patent Owner’s Updated Mandatory Notices) at 3. The parties also identify certain withdrawn proceedings involving the challenged patent, certain proceedings involving allegedly related patents, and certain patent applications allegedly related to the challenged patent. Pet. 5–6; Paper 3 at 1–3; Paper 10 at 1–3.

Both proceedings listed above also involve U.S. Patent No. 11,365,026 B2 (“the ’026 patent”). The same day as the filing of the Petition in this proceeding, Petitioner filed a petition for *inter partes* review of certain claims of the ’026 patent in IPR2024-01400. *See Klein Tools, Inc. v. Milwaukee Elec. Tool Corp. & Keter Home and Garden Prods., Ltd.*, IPR2024-01400, Paper 2 (PTAB Sept. 17, 2024). We grant institution in that proceeding concurrently with this Decision. *See IPR2024-01400*, Paper 15.

B. The Challenged Patent

The challenged patent “is directed to a container assembly and more specifically to a utility assembly comprising two or more detachably attachable utility modules.” Ex. 1001, 1:27–29.

Figure 1A is below:

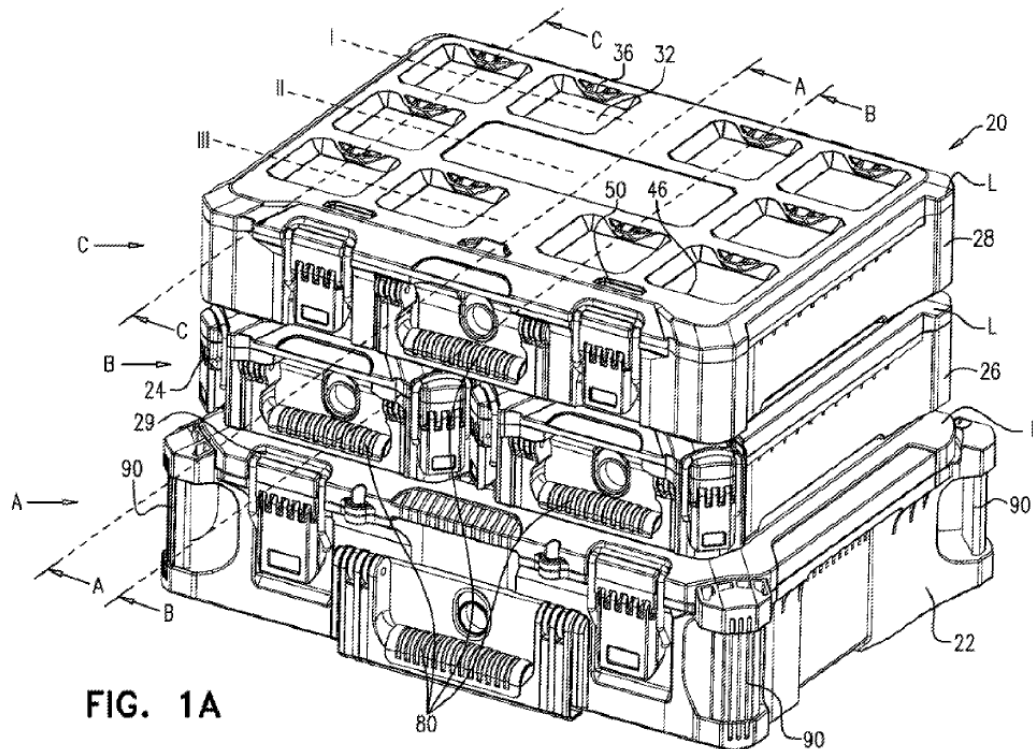


Figure 1A is a top perspective view of a container assembly. Ex. 1001, 14:63–64. As shown, container assembly 20 includes four containers: container 22 in first stage A; half-size containers 24 and 26 in second stage B; and container 28 in third stage C. *See id.* at 16:3–11. Second-stage containers 24 and 26 overlap the footprint of first stage container 22 and third stage container 28. *See id.* Each of the containers has

a lid L, which is “pivotally attached and securely articulated to the respective container through a toggle locking latch 29.”¹ *Id.* at 16:25–28.

Figures 1B and 1C are below:

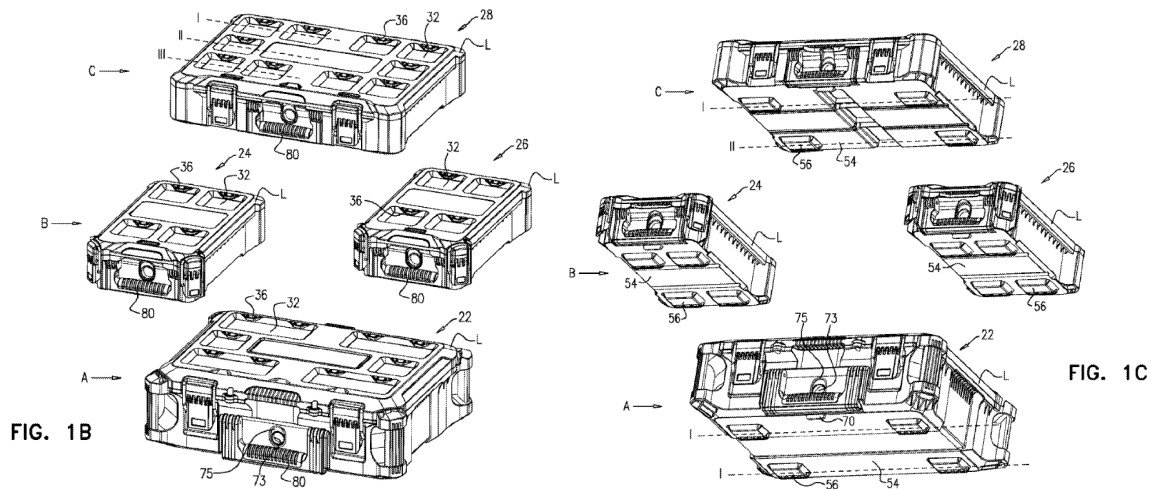
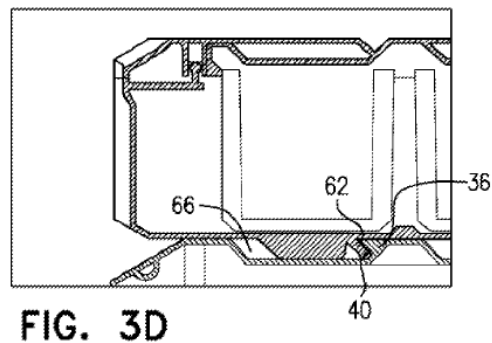
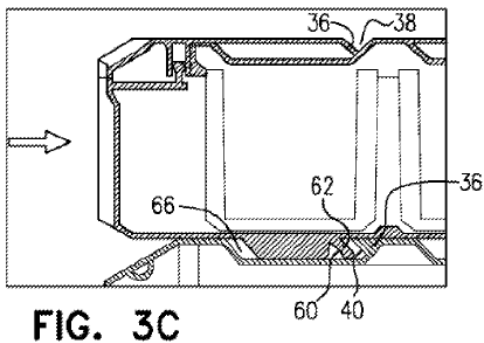
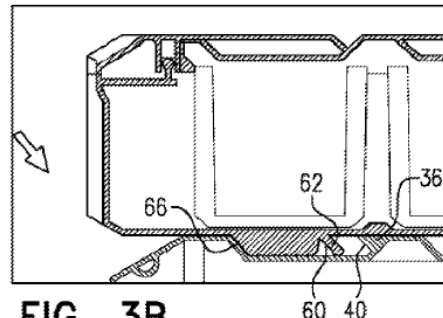
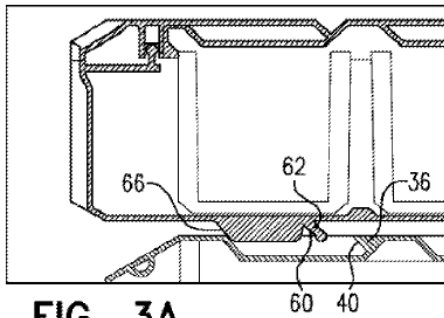


Figure 1B is an exploded view of the container assembly in Figure 1A; Figure 1C is a bottom front perspective view of the assembly in Figure 1B. Ex. 1001, 14:65–67. As shown in these Figures, each of containers 22, 24, 26, 28 has a tiltable carrying handle 80 for carrying a respective container or the entire container assembly 20. *Id.* at 17:46–49. Moreover, as shown in Figure 1B, the top face of each of containers 22, 24, 26, 28 has several depressed locking locations 32, each of which contains a “laterally projecting locking rib 36 extending from a rear portion of the depressed locking location 32 towards a front face of the container.” *Id.* at 16:28–36. And as shown in Figure 1C, bottom face 54 of each container 22, 24, 26, 28 has several projecting portions 56 that may align with depressed locking locations 32 of other containers. *Id.* at 16:47–52.

¹ In this Decision, we omit emphasis on reference numerals in quotations from the challenged patent and prior art references.

Figures 3A–3D are below:



Figures 3A–3D depict consecutive steps illustrating locking engagement of the locking tongue of a second container (in the upper portion of each figure) with the locking rib of a first container (in the lower portion of each figure). Ex. 1001, 15:5–7. To detachably attach the second container to the first container, the second container is placed over the first (as shown in Figure 3A), and configured such that locking tongues 60 engage and are arrested by their respective locking ribs 36 (Figures 3B–3D). *See id.* at 17:22–28.

Figures 4A–4D are below:

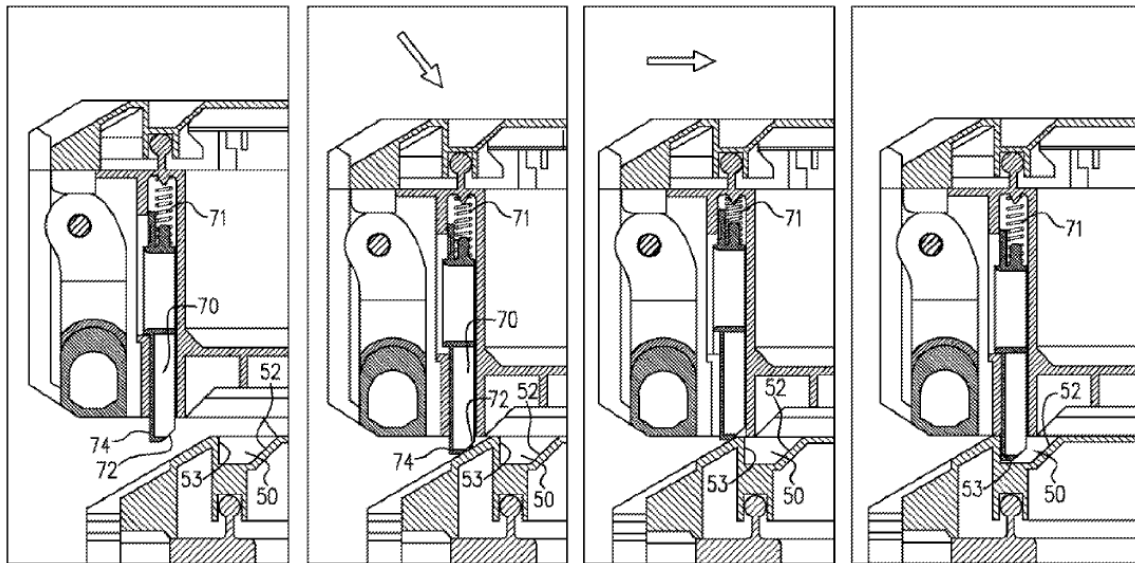


FIG. 4A

FIG. 4B

FIG. 4C

FIG. 4D

Figures 4A–4D depict consecutive steps illustrating locking engagement of the locking latch of a second container (in the upper portion of each figure) with the locking latch arresting location of a first container (in the lower portion of each figure). Ex. 1001, 15:8–11. As part of the process of detachably attaching the second container to the first container (as shown, in part in Figures 3A–3D above), locking latch 70 of the second container slides into a locking latch arresting location (recess 50) and snaps into locking engagement. *See id.* at 17:28–37; Figs. 4A–4D.

C. The Challenged Claims

Petitioner challenges claims 1–23, of which claims 1, 9, and 17 are independent. Claims 2–8 depend from claim 1, claims 10–16 depend from claim 9, and claims 18–23 depend from claim 17. Independent claim 1 is reproduced below, reformatted from the version provided in the challenged patent and with bracketed alphanumeric designations added to identify certain language:

1. **1[pre]** A container assembly comprising:

1[a] a first container comprising:

a first coupler extending from a top face of the first container, **1[b]** the first coupler comprising two sidewalls, a back wall, and a rib, the back wall located between the two sidewalls, **1[c]** the two sidewalls and the back wall projecting above a depressed surface of the top face, **1[d]** and the rib extending away from the back wall in a first direction;

1[e] a first lid pivotally attached to the first container; and

1[f] a first toggle locking latch configured to latch the first lid of the first container in a closed position; and

1[g] a second container comprising:

a second coupler extending from the second container, **1[h]** the second coupler comprising a tongue extending in a direction parallel to a bottom face of the second container, the tongue extends in a second direction opposite the first direction, the tongue of the second container is engageable with the rib of the first container such that the tongue engages between the rib and the depressed surface;

1[i] a second lid pivotally attached to the second container;

1[j] a second toggle locking latch configured to latch the second lid of the second container in a closed position;

1[k] a front face; a first side face; an opposing side face; a first corner bumper coupled to the second container between the front face and the first side face, the first corner bumper defining a first outer surface that faces away from each of the front face and the first side face; and

1[l] a second corner bumper coupled to the second container between the front face and the second side face, and the second corner bumper defining a second outer surface that faces away from each of the front face and the second side face;

1[m] wherein the first and second couplers of the first and second containers engage each other when the first and second containers are slid with respect to each other along a sliding path defined by the rib and the tongue;

1[n] a locking latch arresting location defined by one of the first container or the second container; and

1[o] a locking latch coupled to the other of the first container or the second container, the locking latch positionable in a locked position engaging the locking latch arresting location thereby limiting sliding displacement of the first container with respect to the second container.

Ex. 1001, 23:2–52.²

² We adopt and apply below Petitioner’s designations for the elements of the challenged claims. *See* Pet. vii–xiii (showing alphanumeric designations for the language in the challenged claims).

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–23 on the following grounds:

Claim(s) Challenged	35 U.S.C. §³	Reference(s)/Basis
1–23	103	Burchia, ⁴ Metabowerke ⁵
1–23	103	Burchia, Metabowerke, Lafragette ⁶
1, 10, 18	103	Burchia, Metabowerke, Chen ⁷
4, 13	103	Burchia, Metabowerke, Lin ⁸
8, 16, 23	103	Burchia, Metabowerke Bensman ⁹
1–23	103	Metabowerke, Burchia, Lafragette

³ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Pub. L. No. 112-29, §§ 3(b)–3(c), 3(n)(1), 125 Stat. 284, 285–87, 293 (2011). Because there is no dispute that the challenged claims have effective filing dates after March 16, 2013, we apply the AIA versions of the statutes. We would reach the same outcome, however, under the pre-AIA versions.

⁴ US 10,750,833 B2, issued August 25, 2020 (Ex. 1004, “Burchia”).

⁵ DE 20 2014 103 695 U1, published December 11, 2014 (Ex. 1006 (German version) and Ex. 1020 (English translation), “Metabowerke”).

⁶ US 2003/0139080 A1, published July 24, 2003 (Ex. 1005, “Lafragette”).

⁷ US 2014/0265440 A1, published September 18, 2014 (Ex. 1024, “Chen”).

⁸ US 9,375,835 B1, issued June 28, 2016 (Ex. 1007, “Lin”).

⁹ US 2013/0127129 A1, published May 23, 2013 (Ex. 1008, “Bensman”).

Claim(s) Challenged	35 U.S.C. § ³	Reference(s)/Basis
1, 10, 18	103	Metabowerke, Burchia, Chen
4, 13	103	Metabowerke, Burchia, Lin
8, 16, 23	103	Metabowerke, Burchia, Bensman

Petitioner supports its challenges with a declaration from Dr. John M. Collins. Ex. 1003 (“the Collins Declaration” or “Collins Decl.”).

II. DISCUSSION

A. The Level of Ordinary Skill in the Art

The level of ordinary skill in the art is “a prism or lens” through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). The person of ordinary skill in the art is a hypothetical person presumed to have known the relevant prior art. *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). In determining the level of ordinary skill in the art, we may consider certain factors, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *Id.* (internal quotation marks and citation omitted).

Petitioner contends, with accompanying declaration testimony, that a person having ordinary skill in the art “would have had (1) a bachelor’s degree in mechanical engineering or a related discipline and at least two years of experience in the mechanical design of consumer products, or (2)

five years or more of experience in the mechanical design of consumer products.” Pet. 8 (citing Collins Decl. ¶ 19).

Patent Owner does not address Petitioner’s proposal, but states, without accompanying declaration testimony, that a person having ordinary skill in the art “would have possessed at least a bachelor’s degree in mechanical engineering, industrial engineering, industrial design, or a similar discipline with at least 1–2 years of professional engineering and/or industrial design work experience.” Prelim. Resp. 4. According to Patent Owner, “[s]uch a person would also qualify . . . if s/he had some combination of (1) more formal education (i.e., an advanced degree in mechanical engineering, industrial engineering, industrial design, or a similar discipline) and less professional experience, or (2) less formal education and more professional experience.” *Id.*

Petitioner’s and Patent Owner’s proposals as to the level of ordinary skill in the art overlap in certain aspects. For example, the first option presented by Petitioner (requiring a bachelor’s degree) largely aligns with the first sentence in Patent Owner’s proposal above (also requiring a bachelor’s degree). *Compare* Pet. 8, *with* Prelim. Resp. 4. The second and final sentence from Patent Owner provides other options but is imprecise as to how much “more” or “less” of either formal education or experience are sufficient. *See* Prelim. Resp. 4. At this stage of the proceeding, Patent Owner does not argue that Petitioner’s proposal for the level of ordinary skill in the art leads to an improper understanding of how a skilled artisan would understand either the challenged patent or the prior art.

With that, and the lack of declaration testimony supporting Patent Owner’s proposal, we adopt, for purposes of this Decision, Petitioner’s

proposal as to the level of ordinary skill in the art, which appears consistent with the record at this stage of the proceeding, including the prior art. *See GPAC Inc.*, 57 F.3d at 1579.

B. Discretion Under 35 U.S.C. § 314(a)

1. Legal Framework

In deciding whether to exercise discretion under § 314(a), the Board may consider events in other proceedings related to the same patent, whether at the U.S. Patent and Trademark Office, in the International Trade Commission, or in federal district courts. *See* Consolidated Trial Practice Guide 58 (Nov. 2019), <https://www.uspto.gov/TrialPracticeGuide> Consolidated (“TPG”). The precedential order in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020), identifies factors to consider when a patent owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv, Paper 11 at 5–6. “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. There is some overlap among these factors and some facts may be relevant to more than

one factor. *Id.* In evaluating the factors, the Board takes a holistic view of whether the efficiency and integrity of the system are best served by denying or instituting review. *Id.*

On February 28, 2025, the U.S. Patent and Trademark Office rescinded a prior memorandum, issued June 21, 2022, titled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation.” *See* https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

On March 24, 2025, the Office issued a memorandum with guidance on the rescission of the June 2022 Memorandum. *See* Memorandum from Scott R. Boalick, Chief Administrative Patent Judge to Members of the Patent Trial and Appeal Board (March 24, 2025), *available at* https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf (providing guidance on the rescission of the June 2022 Memorandum). The recent Memorandum provided, among other guidance, that “the Board will apply the *Fintiv* factors when there is a parallel proceeding at the International Trade Commission (‘ITC’).” *Id.* at 2.

2. Analysis

Patent Owner argues that we should exercise our discretion to deny institution under 35 U.S.C. § 314(a) based on the ITC Litigation. *Fintiv* Br. 1–5. Petitioner opposes. *See Fintiv* Opp. 1–5. For the reasons below, we are not persuaded that we should exercise discretion to deny institution under 35 U.S.C. § 314(a) based on the parallel litigation. We discuss each *Fintiv* factor in turn.

a. Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

Patent Owner contends that this factor favors denial because (1) neither side requested a stay of the ITC Litigation, (2) the trial in the ITC Litigation has concluded, and (3) the initial determination in the ITC is due June 20, 2025. *Fintiv* Br. 3. Petitioner responds that the District Court Litigation is stayed pending the ITC Litigation, which weighs against denial. *See Fintiv* Opp. 2–3. Petitioner acknowledges that no stay was requested in the ITC Litigation, but cites a recent nonprecedential decision of the Board, which viewed this factor as neutral under a similar procedural posture. *Id.* at 3 (citing *POSCO Co. v. ArcelorMittal*, IPR2024-01376, Paper 11 at 11–17 (PTAB Mar. 18, 2025)).

We agree with Petitioner and the overall reasoning in the *POSCO* decision. *See POSCO Co. v. ArcelorMittal*, IPR2024-01376, Paper 11 at 11–17 (PTAB Mar. 18, 2025) (declining to deny institution under similar circumstances). As noted in *Fintiv*, a “district court stay of litigation pending resolution of the PTAB trial allays concerns about inefficiency.” *Fintiv*, Paper 11 at 6. On the facts here, however, the District Court Litigation is stayed pending the ITC Litigation, not a proceeding before the Board. *See* Minute Entry, *Milwaukee Elec. Tool Corp. v. Klein Tools, Inc.*, No. 1:24-cv-04928 (N.D. Ill. Aug. 14, 2024), ECF No. 16 (“Based on the discussion held on the record, [Petitioner’s] unopposed motion to stay . . . is granted. The court stays this case pending a resolution of the USITC investigative proceedings.”).

In such a situation, the analysis focuses on “whether the patentability disputes before the ITC will resolve all or substantially all of the

patentability disputes between the parties, regardless of the stay.” *Fintiv*, Paper 11 at 9. We address *that* issue in the discussion of the fourth *Fintiv* factor below. Given the framing in *Fintiv* of this situation, the weight of the *lack* of a stay of the ITC Litigation depends, at least in part, on the fourth *Fintiv* factor. *See POSCO*, Paper 11 at 13; *Fintiv*, Paper 11 at 9. Thus, we determine that the first *Fintiv* factor, by itself, is neutral or bears little weight in the analysis, but it elevates the importance of the fourth *Fintiv* factor.

b. Factor 2: proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision

Patent Owner notes that the trial in the ITC Litigation has concluded and the Initial Determination is expected on or before June 20, 2025, which is approximately ten months before the due date for a final written decision in this proceeding. *Fintiv* Br. 3–4. According to Patent Owner, this favors denial. *Id.* at 4. Petitioner responds that, although the expected dates for the Initial Determination (June 20, 2025) and the target date (October 20, 2025) in the ITC Litigation will both precede any final written decision in this proceeding, that “does not diminish the Board’s statutory role in reviewing patentability, which has long-term effects, including on future district court litigation and licensing.” *Fintiv* Opp. 3. According to Petitioner, the second *Fintiv* factor only marginally favors denial and is not dispositive. *Id.*

The target date for issuing a final determination in the ITC Litigation is October 20, 2025, which is almost six months before the statutory deadline for a final written decision in this proceeding. *See Certain Storage Containers and Toolboxes, Organizers, Component Boxes, Coolers, and Accessories Used Therewith*, Dkt. No. 337-TA-1409 (U.S. I.T.C. Aug. 21, 2024), Order No. 4 (Setting 15-Month Target Date and Preliminary

Conference); *see also* *POSCO*, Paper 11 at 14 (collecting cases discussing the use of the target date as to this *Fintiv* factor in similar situations). For these reasons, this factor overall favors discretionary denial.

c. Factor 3: investment in the parallel proceeding by the court and the parties

Patent Owner argues that the third *Fintiv* factor favors discretionary denial because the trial in the ITC Litigation has concluded. *Fintiv* Br. 4. Petitioner responds that it diligently prepared the Petition and filed it on September 17, 2024, only about three months after the complaints in both the District Court Litigation and the ITC Litigation. *Fintiv* Opp. 3–4. According to Petitioner, the third *Fintiv* factor only marginally favors discretionary denial. *Id.* at 4.

The precedential decision in *Fintiv* instructs Board panels to consider “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. The current record supports that the ITC and the parties have completed substantial work in the ITC Litigation. Mitigating this evidence somewhat is Petitioner’s uncontested diligence in filing the Petition here. *See* *Fintiv*, Paper 11 at 11 (“If the evidence shows that the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution”). On the current record, we determine that the third *Fintiv* factor weighs slightly in favor of discretionary denial.

d. Factor 4: overlap between issues raised in the petition and in the parallel proceeding

The fourth *Fintiv* factor requires consideration of “inefficiency and the possibility of conflicting decisions.” *See* *Fintiv*, Paper 11 at 12.

Therefore, “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Id.* The *Fintiv* panel stated that “the degree of overlap is highly fact dependent” and encouraged the parties to “indicate whether all or some of the claims challenged in the petition are also at issue in district court.” *Id.* at 13. For the reasons below, we view this factor overall as weighing strongly against denial.

We first address the degree of overlap in issues based on the *prior art* at issue in each proceeding. *See Fintiv*, Paper 11 at 12–13 (discussing how, “if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution”). Patent Owner states that “two references (Burchia and Bensman) from the ITC [Litigation] reappear” in this proceeding. *Fintiv* Br. 4. Petitioner argues that its invalidity case in the ITC Litigation relies on two grounds—(1) the Auer System in view of Bensman and Lifshitz and (2) Burchia in view of Bensman and Lifshitz—and *neither* of those grounds is in this proceeding. *Fintiv* Opp. 2, 4. Further, Petitioner highlights that Metabowerke is relied upon (at least in the alternative) for each of the grounds in the Petition here, and Metabowerke is *not* currently at issue in the ITC Litigation. *Id.* at 2, 4.

The record here supports Petitioner’s argument that the grounds in this proceeding were not “presented in” the trial hearing in ITC Litigation and, thus, the ITC will not adjudicate the patentability grounds raised here. *See Fintiv*, Paper 11 at 12 (focusing on the “claims, grounds, arguments, and evidence as *presented in* the parallel proceeding” (emphasis added)). Moreover, as discussed at length below (*see* § II.E.3), we determine that the

Petition shows a reasonable likelihood that Petitioner would prevail in demonstrating that claims 9 and 17 would have been obvious based on Burchia and Metabowerke, and we determine (at least on the current record) that Petitioner has made a sufficient showing that Metabowerke (but not Burchia) discloses the “two sidewalls” limitation in dispute between the parties (*see* § II.E.3.a). Thus, this proceeding will likely address issues not analyzed in the ITC Litigation. *See Fintiv*, Paper 11 at 13 (discussed whether the parallel proceeding will “resolve key issues in the petition”).

Patent Owner posits as “extremely likely” that even the Federal Circuit will issue a decision on the ITC Litigation—i.e., a decision on appeal from an ITC decision not yet issued—before a final written decision in this proceeding. *Fintiv* Br. 4. But that hypothetical future Federal Circuit decision will *definitely* not address Metabowerke in relation to the challenged claims. *See* § II.E.3; *see also Fintiv* Opp. 4 (arguing that “the ITC will have no occasion to decide the grounds presented here because Metabowerke was not presented at the hearing”). This aspect of the fourth *Fintiv* factor weighs heavily against discretionary denial.

We next address the degree of overlap in issues based on the *claims* in each proceeding. *See Fintiv*, Paper 11 at 13 (“The existence of non-overlapping claim challenges will weigh for or against exercising discretion to deny institution under *NHK* depending on the similarity of the claims challenged in the petition to those at issue in the district court.”). In the ITC Litigation, Petitioner challenges dependent claims 3, 4, 8, and 16, which are a *subset* of claims 1–23 challenged in this proceeding. *See Fintiv* Br. 2, 4; *Fintiv* Opp. 2, 4. Patent Owner correctly points out that, in challenging dependent claims 3, 4, 8, and 16 in the ITC Litigation, Petitioner will have to

address the limitations recited in claims 1, 3, 4, 8, 9, and 16, based on their dependencies: claims 3, 4, and 8 depend from independent claim 1; claim 16 depends from independent claim 9. *See Fintiv* Br. 2, 4; 35 U.S.C. § 112(d) (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”). But that leaves 17 of the 23 claims of the challenged patent *not* addressed by the invalidity arguments in the ITC. Overall, this fourth *Fintiv* factor weighs heavily against discretionary denial.

e. Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party

As stated by Patent Owner and Petitioner, the parties in the ITC Litigation are the same as in this proceeding. *See Fintiv* Br. 4; *Fintiv* Opp. 5. This factor weighs in favor of discretionary denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (informative).

f. Factor 6: other circumstances that impact the Board’s exercise of discretion, including the merits

Patent Owner argues that the sixth *Fintiv* factor favors discretionary denial because the Petition’s merits are weak. *Fintiv* Br. 5. Petitioner responds that the Petition’s merits are strong. *Fintiv* Opp. 5. For the reasons we explain below, the overall merits of the Petition are particularly strong. *See, e.g.*, § II.E.

As to Patent Owner’s argument that Burchia and Metabowerke have “already been thoroughly considered and rejected by the Office” (*Fintiv* Br. 5), for the reasons below, the facts here do not present a strong case for

denial under 35 U.S.C. § 325(d). *See* § II.C.¹⁰ This factor, thus, weighs against discretionary denial.

3. Conclusion

After weighing all of the factors and taking a holistic view of the relevant circumstances of this proceeding, we determine that we should not exercise our discretion to deny institution under § 314(a).

C. Discretion Under 35 U.S.C. § 325(d)

Patent Owner argues that we should exercise discretion to deny institution under 35 U.S.C. § 325(d). *See* Prelim. Resp. 10–21; Prelim. Sur-reply. Petitioner argues we should not exercise discretion to deny. Pet. 18–25; Prelim. Reply.

1. Legal Framework

Section 325(d) provides that, in determining whether to institute *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” The Board uses a two-part framework in determining whether to exercise its discretion under § 325(d): (1) determining whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either

¹⁰ The *Fintiv* decision discusses “considerations implicated by 35 U.S.C. § 325(d)” under the separate heading of “Other Considerations” that may impact the Board’s discretion to deny institution. *Fintiv*, Paper 11 at 16. *Fintiv* does not discuss § 325(d) considerations under the sixth *Fintiv* factor, and we do not consider § 325(d) in a holistic assessment of the six *Fintiv* factors. We address Patent Owner’s arguments under 35 U.S.C. § 325(d) separately below. *See* § II.C.

condition of the first part of the framework is satisfied, determining whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). In applying this framework, we consider several non-exclusive factors, including:

(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph). If, after review of factors (a), (b), and (d), we determine that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner demonstrates that the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 10.

2. Summary of the Prosecution History

The challenged patent issued from U.S. Application No. 18/051,749, filed on November 1, 2022. *See* Ex. 1001, codes (21), (22). In an IDS included with the original filing, the applicants listed, among other

references, (1) Burchia, (2) Bensman, and (3) Metabowerke. Ex. 1002 at 362 (listing Burchia at A164), 365 (listing Bensman at A265), 371 (listing Metabowerke at A443).

In the first of two office actions in the prosecution history, the examiner presented double patenting rejections based on Patent Owner’s related ’026 patent (at issue in IPR2024-01400) alone and in view of U.S. Patent Publication No. 2007/0138041 A1 to Welsh (Ex. 1023). *See* Ex. 1002 at 278–81. In the second office action, the examiner presented a double patenting rejection based on the ’026 patent. *See* Ex. 1002 at 201–205. After filing a terminal disclaimer (*id.* at 252) and amending the claims (*id.* at 185–196), the challenged patent issued.

3. *Analysis*

a. Whether the Same or Substantially the Same Art or Arguments Were Presented to the Office

We first consider “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” *Advanced Bionics*, Paper 6 at 8. As to the first part of the framework, Patent Owner argues that both Burchia and Metabowerke were already considered during prosecution and listed on an IDS, later signed as having been considered by the examiner. *See* Prelim. Resp. 10–11; Ex. 1002 at 292 (A164), 301 (A443). Although not mentioned by Patent Owner, Bensman was also indicated as considered by the examiner. *See* Ex. 1002 at 295 (A265).

Petitioner argues that, although Burchia and Metabowerke were identified, those references were listed on a lengthy IDS and not “substantively discussed by the examiner.” Pet. 19–20. Further, in the Preliminary Reply, Petitioner contends that a translation of Metabowerke

was never submitted to the examiner, and thus, that reference *could not* have been considered. *See* Prelim. Reply 1–4 (discussing *Semiconductor Energy Lab’y Co. v. Samsung Elecs. Co.*, 204 F.3d 1368, 1376–77 (Fed. Cir. 2000)). The precedential decision in *Advanced Bionics* undermines Petitioner’s arguments, stating that “[p]reviously presented art includes . . . art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS).” *Advanced Bionics*, Paper 6 at 7–8. Here, the examiner signed an IDS indicating that Metabowerke was considered. *See* Ex. 1003 at 301 (A443). The *Semiconductor Energy* decision cited by Petitioner predates the *inter partes* review process and relates to inequitable conduct in an appeal from district court litigation; it does not set forth an exception to the precedential *Advanced Bionics* decision’s statement regarding IDSs or address discretionary denial under section 325(d). *See Semiconductor Energy*, 204 F.3d at 1373–78. Thus, we agree with Patent Owner that three of the five references—Burchia, Metabowerke, and Bensman—are the same art as previously presented to the Office.

Next, we discuss Lafragette, which Petitioner relies on in two grounds, both addressing all challenged claims. *See* Pet. 7–8, 89–94, 102–146. Petitioner correctly notes that Lafragette was not listed in an IDS or discussed during prosecution. *See* Pet. 19–20. Patent Owner responds that Lafragette “was not cited . . . as it is clearly non-analogous art.” Prelim. Resp. 11.

As discussed below (*see* § II.F.2.b), we do not address at this time whether Lafragette is nonanalogous art and thus do not focus on that basis in the analysis under § 325(d). We do note, however, that, in this proceeding, Lafragette is relied on by Petitioner *in the alternative* to Burchia and

Metabowerke, and to address only certain claim limitations. *See* Pet. 89–94 (relying on Lafragette in the alternative to Burchia for certain limitations), 102–103, 128, 130, 134 (all relying on Lafragette in the alternative to Metabowerke for certain limitations). On the facts here, we consider Lafragette as substantially the same prior art to Burchia and Metabowerke—both listed on IDSs—as to the relevant claim features.

We turn now to Lin, which Petitioner applies in two grounds, both challenging solely claims 4 and 13. Pet. 7–8, 98–100, 146–147. Petitioner notes that Lin was not cited or discussed by the examiner during prosecution. *See* Pet. 19–20. Patent Owner argues that the fact that Lin was *not* included on an IDS, or discussed during prosecution, should carry little weight because Lin is relied on as to only one limitation in a dependent claim. Prelim. Resp. 12, 16. We agree with Petitioner as to Lin, which was not considered during prosecution.

Lastly, we turn to Chen, which Petitioner applies in two grounds, both challenging claims 1, 10, and 18. Pet. 7–8, 95–98, 146. Patent Owner acknowledges that Chen was not listed on an IDS and argues that Chen “is relied on in the Petition as allegedly teaching only limitation 1[k] and 1[l] (the corner bumper limitations) of independent claim 1.” *See* Prelim. Resp. 12 (citing Pet. 95, 146). According to Patent Owner, “[t]he arguments involving Chen share the same deficiencies as those presented in the Petition regarding the remaining limitations of the independent claims, which are based solely on Burchia, Metabowerke, and Lafragette.” *Id.*; *see also id.* at 16 (providing a similar argument in the bottom paragraph).

The record does not support that the grounds involving Chen “share the same deficiencies” as those based on Burchia, Metabowerke, and

Lafragette as argued by Patent Owner. For example, Patent Owner argued that the grounds based on Burchia, Metabowerke, and/or Lafragette lack the “corner bumper” limitations. *See* Prelim. Resp. 34–37, 73–74. But Patent Owner does not argue that Chen fails to disclose the “corner bumper” limitations; instead, Patent Owner argues that Petitioner has not shown adequately *how* Chen would be combined with Burchia and Metabowerke. *Id.* at 57–60.

With that, it is unclear how Chen is “the same or substantially the same prior art” as previously presented to the Office. Regardless, when considering the Petition as a whole, and for purposes of this Decision, we find that it sufficiently implicates the concerns addressed by § 325(d) to find the first part of the framework in *Advanced Bionics* satisfied. We turn now to the second part of the framework: “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, Paper 6 at 8–9.

b. Whether Petitioner Sufficiently Demonstrates that the Office Erred

In the second part of the framework, “Petitioner must demonstrate that the Examiner erred in the evaluation of the prior art, for example, by showing that the Examiner misapprehended or overlooked specific teachings in the relevant prior art such that the error by the Office was material to the patentability of the challenged claims.” *Advanced Bionics*, Paper 6 at 21. “An example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Id.* at 8–9 n.9.

Petitioner argues that the “Petition’s arguments were never previously presented” in that the only art rejections were for obviousness-type double

patenting based on a related patent and Welsh and were overcome by a terminal disclaimer. *See* Pet. 19. According to Petitioner, “[i]t was material error not to reject the claims based on the art” in the Petition. Pet. 20. Petitioner contends that “the Office erred in not applying Burchia or Metabowerke because they disclose all limitations.” *Id.*; *see also* Pet. 23 (discussing how the examiner did not give Burchia and Metabowerke “due consideration”).

Patent Owner responds that “[r]ather than an error or mistake, there was careful and repeated consideration of both references, and an ultimate conclusion that Burchia and Metabowerke did not render the claims unpatentable.” Prelim. Resp. 18.

On the record here, we determine that Petitioner has sufficiently shown material error by the Office in not having substantively considered Burchia and Metabowerke as to the challenged claims. As discussed below, we determine that the Petition shows at least a reasonable likelihood that Petitioner would prevail in demonstrating that claims 9 and 17 would have been obvious based on Burchia and Metabowerke. *See* § II.E.3.h. Patent Owner takes the position that the examiner “clearly understood this art”—including Burchia and Metabowerke—“to be either cumulative of other art applied during prosecution or lacking the requisite disclosures.” Prelim. Resp. 18. Given the prosecution history’s silence on Burchia and Metabowerke, however, we do not view the alleged understanding as in any way “clear[.]” *See Advanced Bionics*, Paper 6 at 10 (“For example, if the record of the Office’s previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking

something persuasive under factors (e) and (f).”). For these reasons, we determine that Petitioner has sufficiently shown material error by the Office.

4. Conclusion

For the reasons above, we find that the same or substantially the same art was presented to the Office, but we find that Petitioner has adequately shown that the Office materially erred in a manner that impacts the patentability of the challenged claims. Accordingly, we do not exercise discretion to deny institution under § 325(d).

D. Claim Construction

In *inter partes* reviews, the Board interprets claim language using the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b), as described in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b). Under that standard, we generally give claim terms their ordinary and customary meaning, as would be understood by a person of ordinary skill in the art at the time of the invention, in light of the language of the claims, the specification, and the prosecution history. *See Phillips*, 415 F.3d at 1313–14. Although extrinsic evidence, when available, may also be useful when construing claim terms under this standard, extrinsic evidence should be considered in the context of the intrinsic evidence. *See id.* at 1317–19.

In this proceeding, neither Petitioner nor Patent Owner proposes constructions for any claim terms. *See* Pet. 10–11; Prelim. Resp. 6. Based on the current record, we need not construe explicitly any claim terms because doing so would not change the outcome of the analysis below. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy,

and only to the extent necessary to resolve the controversy.” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

E. Asserted Obviousness of Claims 1–23 Based on Burchia and Metabowerke

Petitioner asserts that claims 1–23 of the challenged patent would have been obvious based on Burchia and Metabowerke. Pet. 7, 25–89. Patent Owner provides arguments specifically addressing this asserted ground. Prelim. Resp. 21–48. We first summarize aspects of the relied-upon prior art.

1. Overview of Burchia

Burchia discloses stackable “suitcase[s]” that are coupled together and temporarily locked in place. Ex. 1004, code (57).¹¹ As one example, the suitcase “is a tool case, which serves for transporting and/or storing tools and/or material and/or equipment of a craftsman or technician, for example.” *Id.* at 8:58–61.

¹¹ Petitioner asserts that Burchia is prior art under 35 U.S.C. §§ 102(a)(2) and 102(d)(2) “because it issued from a national stage application of a PCT claiming foreign priority to a German patent application filed August 18, 2015, before the earliest effective priority date of May 2, 2016.” Pet. 12 (citing *Penumbra, Inc. v. RapidPulse, Inc.*, IPR2021-01466, Paper 34 at 29–35 (PTAB March 10, 2023) (precedential as to section II.E.3)). In support, Petitioner provides a chart allegedly “showing support in the Burchia priority application for the citations to Burchia” relied on. Pet. 12–13. Patent Owner does not challenge this position. For purposes of this Decision, we assume Burchia is prior art to the challenged patent.

Figure 1 of Burchia is reproduced below:

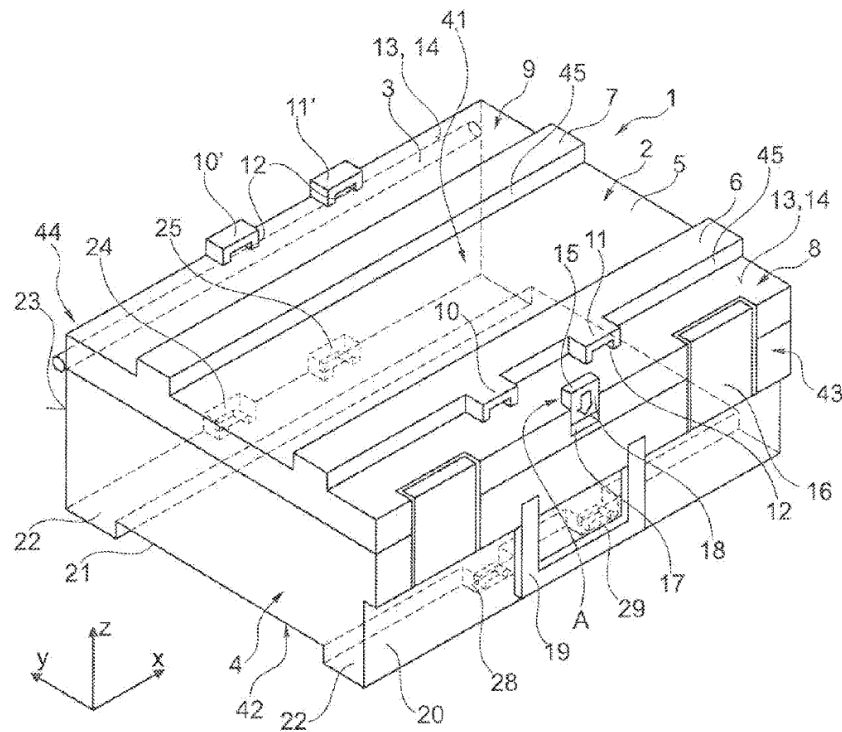


Fig. 1

Figure 1 is a perspective view of one embodiment of a “stackable suitcase.” Ex. 1004, 8:28–29. Depicted suitcase 1 includes lid part 2 and lower part 4, which can be covered by lid part 2. *See id.* at 9:4–5. Two closure elements 16 prevent unintentional opening of lid part 2 relative to lower part 4. *See id.* at 9:13–17. Two coupling parts 10/11 can be brought together with related counter-coupling parts on another suitcase to form a “plug-in connection.” *Id.* at 9:32–36. Similarly, two additional coupling parts 10'/11' can be brought together with additional related counter-coupling parts on another suitcase to form another “plug-in connection.” *Id.* at 10:36–43. Locking element 18 secures the plug-in connection formed by coupling parts 10/11 to prevent it from coming loose. *See id.* at 11:34–37.

Figure 2 is reproduced below:

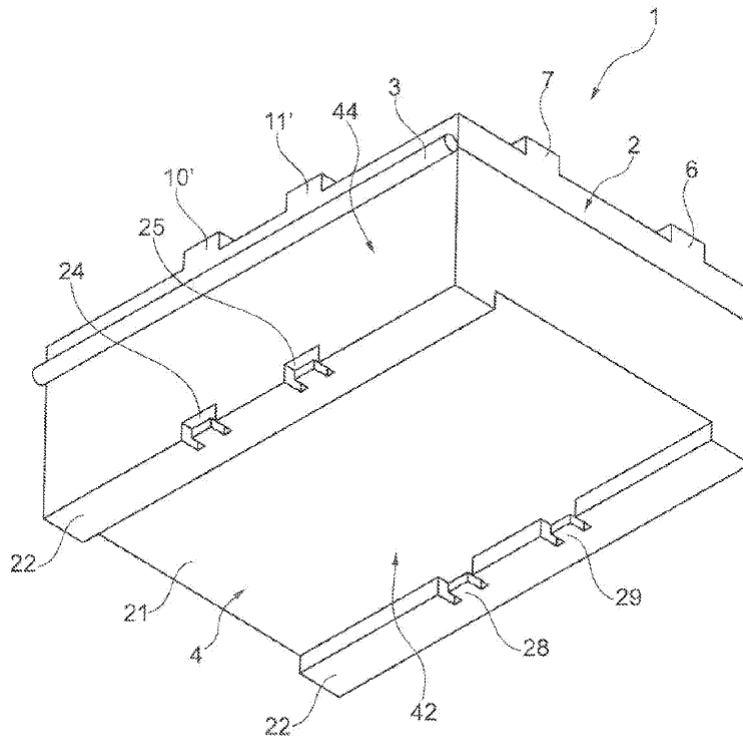


Fig. 2

Figure 2 is a perspective view of the “stackable suitcase” of Figure 1 from below. Ex. 1004, 8:30–31. Shown on the bottom side of suitcase 1 in this view are counter-coupling parts 24/25 and counter-coupling parts 28/29. *See id.* at 11:27–33.

Figures 4 and 5 are reproduced below:

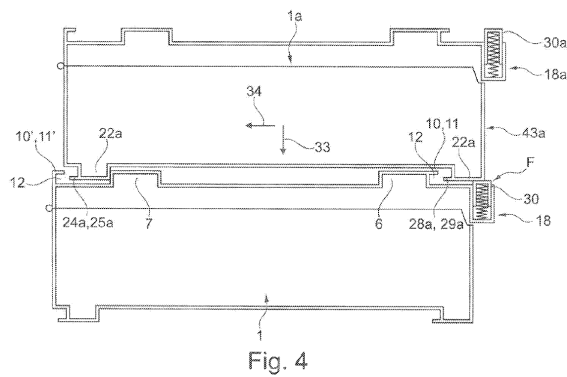


Fig. 4

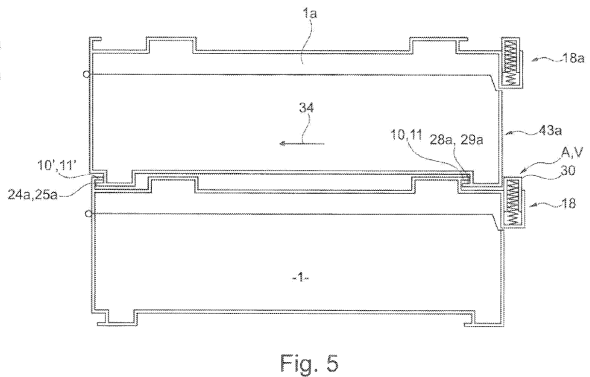


Fig. 5

Figures 4 and 5 show two suitcases 1/1a in two different states, with suitcase 1a stacked on suitcase 1 in Figure 4, and with suitcase 1a brought into a fastening position against suitcase 1 in Figure 5. Ex. 1004, 8:36–42. In the fastening position shown in Figure 5, coupling parts 10'/11' on suitcase 1 have formed a plug-in connection with counter-coupling parts 24a/25a on suitcase 1a, and coupling parts 10/11 on suitcase 1 have formed a plug-in connection with counter-coupling parts 28a/29a on suitcase 1a. *See id.* at 9:37–41, 10:36–43. During this process, locking element 18 is first depressed to allow engagement of suitcases 1 and 1a, and then locking element 18 rebounds by spring force to prevent disengagement. *See id.* at 11:34–61, 12:37–62.

2. Overview of Metabowerke

Metabowerke discloses “a stackable container” for use, for example, “to accommodate electric hand tools or also consumable materials in the trade environment,” such as on construction sites. Ex. 1020 ¶ 1.

Figure 1 of Metabowerke is reproduced below:

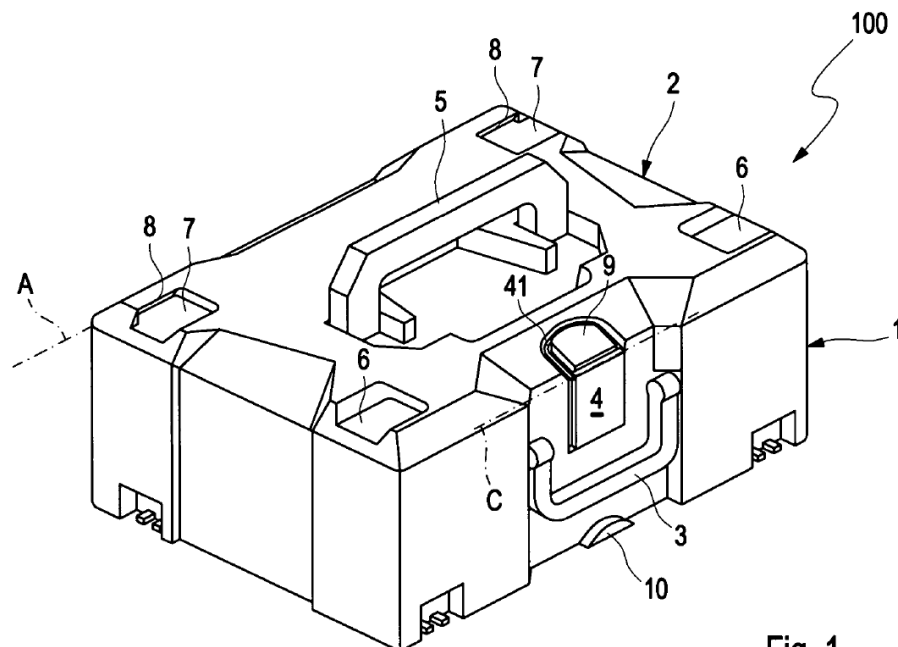


Fig. 1

Figure 1 is a perspective view of a stackable container. Ex. 1020 ¶ 22. Depicted stackable container 100 includes base part 1 and cover 2, which is capable of pivoting about axis A. *Id.* ¶ 41. Buckle 4 includes clip 41 to close container 100 or couple container 100 to other containers (as shown in Figure 2, below). *Id.* Cover 2 includes two front recesses 6 and two rear recesses 7, each of which “serve to accommodate the standing feet or support elements of another similar container 100 standing on the container 100.” *Id.*

Figure 2 is reproduced below:

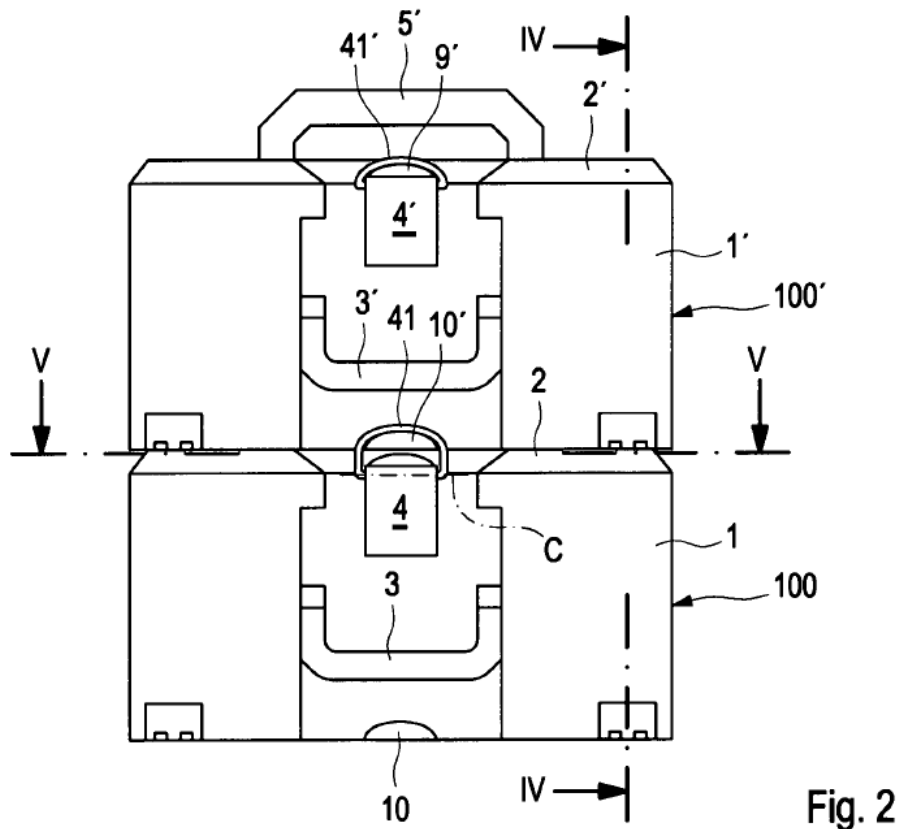


Figure 2 depicts two stacked containers 100/100' locked together. *See* Ex. 1020 ¶ 42. As shown in Figure 2, clip 41 of container 100 grips coupling tab 10' of container 100', thereby securing container 100' against container 100. *Id.*

Figure 4 is reproduced below:

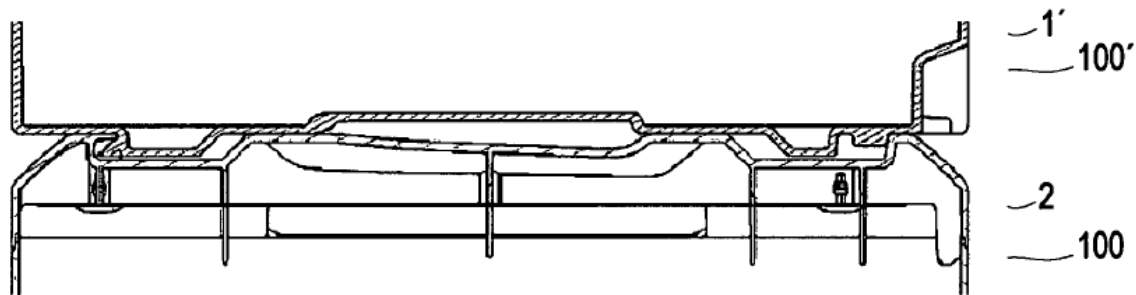


Fig. 4

Figure 4 depicts a cross-sectional view along lines IV-IV in Figure 2, showing “the conditions both in the region of the rear and the front surface 13', 12' and the support element 11'.” Ex. 1020 ¶ 46. On the left side, this Figure shows the engagement of projection 14' of rear standing foot 13' of container 100' into an undercut in recess 7 of bottom container 100. *Id.* On the right side, Figure 2 shows support element 11' of container 100' resting against the front side wall of front recess 6 of bottom container 100, “so that pulling off or slipping off of the top container 100' towards the front is effectively prevented.” *Id.*

3. Independent Claims 1, 9, and 17

For independent claims 1, 9, and 17, Petitioner contends that the proposed combination of Burchia and Metabowerke discloses each limitation. Pet. 25–67, 79–83, 86. To support its arguments, Petitioner identifies certain passages in the cited references and explains the significance of each passage with respect to the corresponding claim limitation. *Id.* Petitioner also articulates reasons to combine the relied-upon aspects of Burchia and Metabowerke. Pet. 26–27. Patent Owner challenges

several aspects of Petitioner’s positions, as detailed below. *See* Prelim. Resp. 21–48.

We have reviewed Petitioner’s contentions with respect to claims 9 and 17, and for the reasons below, we determine that the Petition shows a reasonable likelihood that Petitioner would prevail in demonstrating that claims 9 and 17 would have been obvious based on Burchia and Metabowerke. As to claim 1, for the reasons below, we need not reach a conclusion as to whether the Petition shows a reasonable likelihood that Petitioner would prevail in demonstrating that claim 1 would have been obvious based on Burchia and Metabowerke, based on the current record. We address in turn each of Patent Owner’s arguments.

a. The “two sidewalls” Limitations

Limitation 1c recites, in part, that the “two sidewalls” of the “first coupler” (recited in limitation 1b) are “projecting above a depressed surface of the top face” of the “first container” (recited in limitation 1a). *See* Ex. 1001, 23:7–9. Independent claims 9 and 17 recite the same requirements. *Id.* at 24:23–25 (claim 9), 25:38–40 (claim 17). We will refer to these as the “two sidewalls” limitations. In this asserted ground, Petitioner provides two alternative positions on how the proposed combination satisfies these limitations, which we discuss in turn.

(1) Reliance on Burchia

As the first alternative position, Petitioner relies on Burchia, as shown in the annotated version of Figure 1 reproduced below:

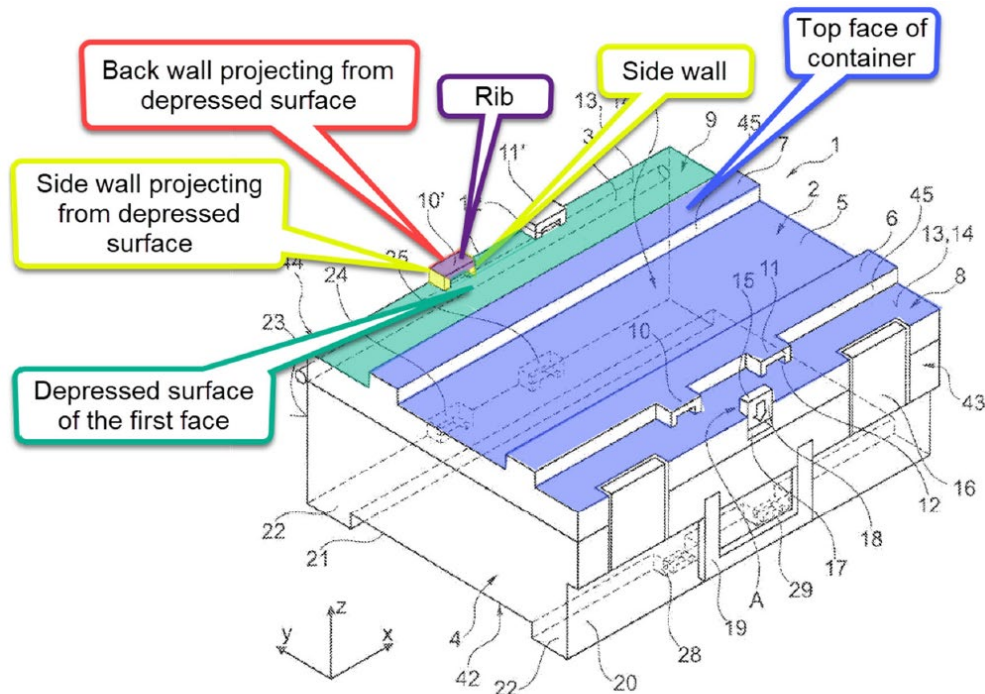


Fig. 1

Pet. 33; *see also* Collins Decl. ¶¶ 71–72 (discussing reliance on Burchia). In the annotated version of Figure 1 of Burchia here, Petitioner added (1) a green text box and green shading identifying a “Depressed surface of the first face,”¹² (2) a yellow text box and yellow shading identifying a “Side wall projecting from depressed surface,” (3) a red text box and red shading identifying a “Back wall projecting from depressed surface,” (4) a purple text box and purple shading identifying a “Rib,” (5) a yellow text box and yellow shading identifying a “Side wall,” and (6) a blue text box and blue

¹² As noted by Patent Owner, Petitioner labels the green portion as “Depressed surface of the first face, but the independent claims each recite “depressed surface of the top face.” Prelim. Resp. 25 n.3.

shading identifying a “Top face of container.” Pet. 33. For claims 9 and 17, Petitioner refers back to the discussion as to claim 1. *See* Pet. 80, 86.

Patent Owner contends that Burchia does not disclose the “two sidewalls” limitations. *See* Prelim. Resp. 24–27. Specifically, Patent Owner argues that the portion in the annotated version of Figure 1 of Burchia labeled “Depressed surface of the first face” by Petitioner “is not a depressed surface at all” because one of ordinary skill in the art “would have understood that a depressed surface of the top face is a surface that is situated lower than the general surface and thus should form a depression **relative to the surrounding** surface.” *Id.* at 25–26 (citing Ex. 2008 (dictionary definition of “depressed”)).

At this stage of the proceeding, we agree with Patent Owner’s argument that the green structure in the annotated version of Figure 1 of Burchia above would not have been considered a “depressed surface of the top face” of the container shown. Specifically, as noted by Patent Owner, Burchia describes the two raised cross-ribs 6/7 shaded in blue—one of which Petitioner identifies using the text box as “Top face of container”—as “elevated.” Ex. 1004, 10:22–25, *cited at* Prelim. Resp. 26. We agree with Patent Owner that, if cross-ribs 6/7 would have been considered “elevated,” each of the two remaining blue surfaces (i.e., receiving region 8 and cross-groove 5) and the green surface identified by Petitioner (i.e., receiving region 9) would have been considered the “general surface” of the container rather than a “depressed surface.” *See* Prelim. Resp. 26; *see also* Ex. 1004, 10:21–60 (describing various aspects of Figure 1 of Burchia). Moreover, at this stage, neither Petitioner nor Dr. Collins has adequately explained why receiving region 9 in green would have been considered a “depressed surface

of the top face” whereas receiving region 8 and cross-groove 5 would have been considered a “top face” when all three of those structures appear to be aligned in the z-direction. *See* Prelim. Resp. 26 (arguing that receiving region 9 “runs across the entire edge in the x-direction of the suitcase in Burchia and resides at the same height as the general surface of the suitcase” (citing Ex. 1004, 10:48–54)).

For these reasons, on the current record, we determine that Petitioner has not made a sufficient showing that Burchia discloses the “two sidewalls” limitations.

(2) Reliance on Metabowerke

As the second alternative position as to the “two sidewalls” limitation, Petitioner relies on Metabowerke, as shown in the annotated version of Figure 1 reproduced below:

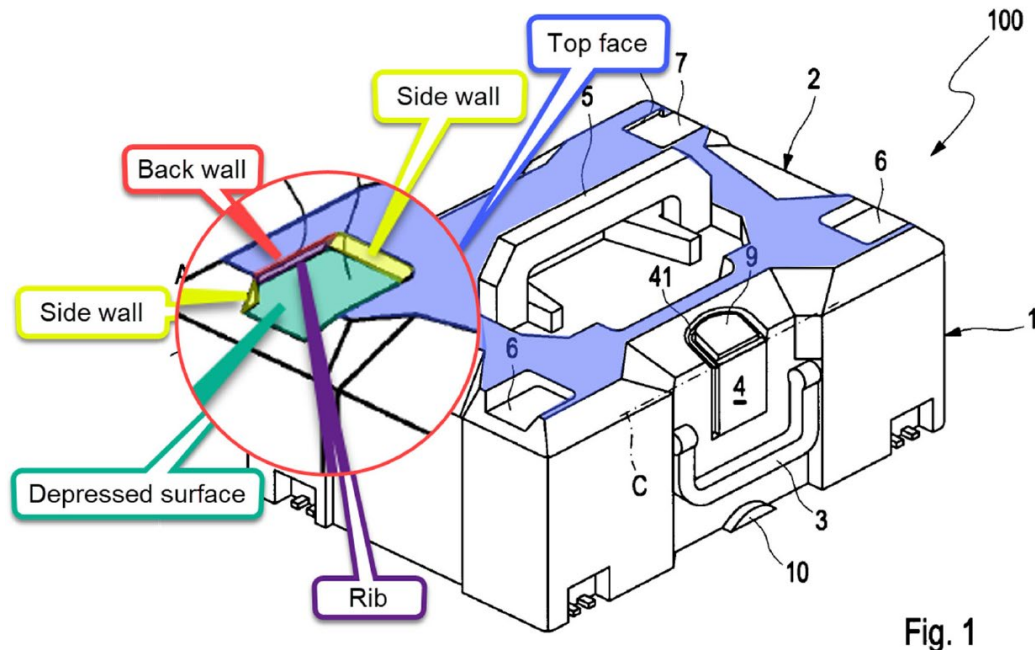


Fig. 1

Pet. 35; *see also* Collins Decl. ¶¶ 73–76 (discussing reliance on Metabowerke). In the annotated version of Figure 1 of Metabowerke here, Petitioner added (1) a green text box and green shading identifying a

“Depressed surface,” (2) two yellow text boxes and yellow shading identifying two separate portions as a “Side wall,” (3) a red text box and red shading identifying a “Back wall,” (4) a purple text box and purple shading identifying a “Rib,” and (5) a blue text box and blue shading identifying a “Top face.” Pet. 35. For claims 9 and 17, Petitioner refers back to the discussion as to claim 1. *See* Pet. 80, 86.

Patent Owner contends that Metabowerke does not disclose the “two sidewalls” limitations. *See* Prelim. Resp. 27–32. Specifically, Patent Owner first argues that the “coupler” identified in the annotated version of Figure 1 of Metabowerke above includes *at most* one sidewall, rather than the recited “two sidewalls.” *See id.* at 27–29. According to Patent Owner, “[t]here is insufficient evidence that the smaller yellow triangle region” in the annotated version of Figure 1 of Metabowerke above is a “sidewall” at least, in part, because that region is “unlabeled and not textually described by Metabowerke.” *Id.* at 28. Patent Owner asserts that the alleged “complete lack of detail in Metabowerke” on this issue is “fatal to the Petition’s reasoning on this ground.” *Id.* at 29.

At this stage of the proceeding, we are persuaded that Petitioner has adequately shown that Metabowerke discloses the “two sidewalls” limitations. Although patent drawings not designated as drawn to scale should generally not be relied on for measurements or to define precise proportions of depicted elements if the specification is silent on the issue, *see Hockerson-Halberstadt, Inc. v. Avia Grp. Int’l, Inc.*, 222 F.3d 951, 956 (Fed. Cir. 2000), that does not mean “that things patent drawings show clearly are to be *disregarded*,” *In re Mraz*, 455 F.2d 1069, 1072 (CCPA 1972). Here, after considering the annotated version of Figure 1 of

Metabowerke as a whole, we view it as showing with adequate clarity to one of ordinary skill in the art that the structure identified by Petitioner as the first “coupler” (i.e., rear access 7) includes “two sidewalls.”

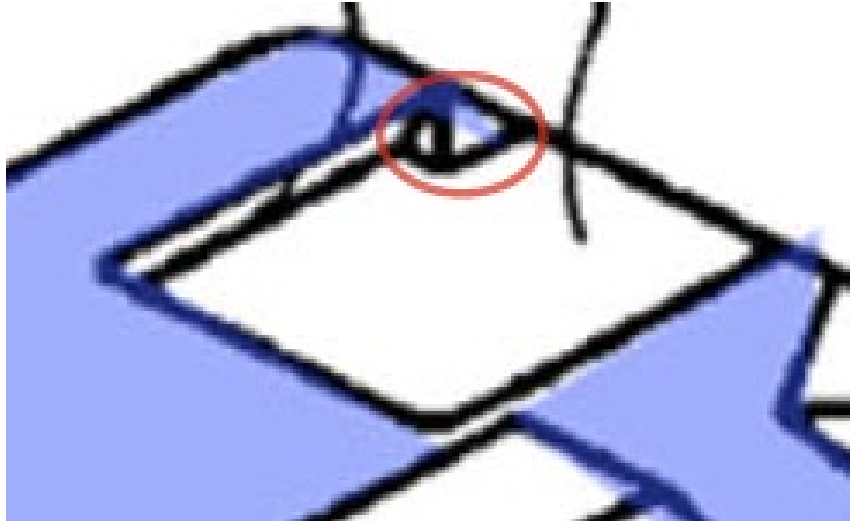
At issue here is whether the structure in the following excerpt of Petitioner’s annotated version of Figure 1 of Metabowerke shaded in yellow and inside a red circle (with the red circle added by the Board) indicates the presence of a “sidewall.”



The image above is an excerpt of Petitioner’s annotated version of Figure 1 of Metabowerke (Pet. 35) with a red circle added by the Board. Patent Owner does not challenge that the *other* yellow structure in the upper right part of the image above is a “sidewall.”

Although the triangular face with yellow shading inside the red circle above faces *the front* of the container in Figure 1 (rather than facing, for example, the *other* yellow “sidewall”), we glean additional understanding of the *overall* shape of the alleged second “sidewall” in the red circle above from the symmetrically situated structure (also shown inside a red circle added by the Board) located on the outer edge of the *other* rear recess 7 in

the following additional excerpt of Petitioner's annotated version of Figure 1 of Metabowerke:



The image above is another excerpt of Petitioner's annotated version of Figure 1 of Metabowerke provided above (Pet. 35) with a red circle added by the Board. On the left side of the structure in the red circle above, Figure 1 of Metabowerke clearly shows a face generally oriented towards the *other* "sidewall" in that rear recess 7 (not visible in the image directly above). At this stage of the proceeding, we understand a symmetrically situated face to be present on the hidden side of the yellow triangular structure inside the red circle included two images above. *See In re Burckel*, 592 F.2d 1175, 1179 (CCPA 1979) ("Under 35 U.S.C. § 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests."); *In re Preda*, 401 F.2d 825, 826–27 (CCPA 1968) ("[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom."). From this, one of ordinary skill in the art could reasonably infer, on the current record, the presence of a second "sidewall" in the identified "first coupler."

Patent Owner appears correct that Metabowerke offers no *textual* description of the structure at issue. *See* Prelim. Resp. 28–29. As discussed above, however, features shown only in patent drawings may be relied upon if those features are depicted with sufficient clarity. *See Mraz*, 455 F.2d at 1072; *see also In re Aslanian*, 590 F.2d 911, 914 (CCPA 1979) (“[A] drawing in a utility patent can be cited against the claims of a utility patent application even though the feature shown in the drawing was unintended or unexplained in the specification of the reference patent.”). On the current record, we determine that those features are.

Patent Owner also contends that Petitioner’s argument that Metabowerke discloses a “coupler” with “two sidewalls” suffers from the same deficiency as did a denied petition filed by a different petitioner in an allegedly “related IPR”—namely, IPR2021-00373, which challenged Patent Owner’s U.S. Patent No. 10,583,962 B2 (the “962-IPR”). *See* Prelim. Resp. 29–32. In the 962-IPR, the Board considered whether references known as Auer-Press and Madsen disclose with sufficient specificity “a back wall, a rib, and two sidewalls in the particular relationship required by each challenged claim,” finding they did not. Ex. 1017 at 16; *see id.* at 15–23 (entire discussion on these issues).¹³

Put simply, we view the persuasive weight of the denial in the 962-IPR as minimal here, given the different facts. The panel in the 962-IPR described the shape at issue in Auer-Press as “featureless and not

¹³ In its discussion of the decision denying institution in the 962-IPR, Patent Owner cites a portion of the entire prosecution history of the patent at issue in that case despite the decision denying institution already having been submitted by Petitioner. *Compare* Ex. 1017, *with* Ex. 2002 at 1821–1849. We cite the original, more legible document.

amendable to meaningful interpretation” (Ex. 1017 at 17) and found that Madsen does not disclose or suggest the presence of the recited features (*id.* at 21). In contrast, for the reasons discussed above, on the current record, we determine that Petitioner has made a sufficient showing, at this stage of the proceeding, that Metabowerke discloses the “two sidewalls” limitations.

b. The “toggle locking latch” Limitations

Limitation 1f recites “a first toggle locking latch configured to latch the first lid of the first container in a closed position” and limitation 1j recites “a second toggle locking latch configured to latch the second lid of the second container in a closed position.” Ex. 1001, 23:12–13, 23:25–27. Independent claims 9 and 17 recite the same requirements. *Id.* at 24:28–29 & 24:47–49 (claim 9), 25:43–44 & 26:1–3 (claim 17). We will refer to these as the “toggle locking latch” limitations. Addressing limitation 1f, Petitioner asserts that Burchia discloses “that the first lid is secured using ‘closure elements 16, such as closure latches.’” Pet. 40 (emphasis omitted) (quoting Ex. 1004, 9:13–15¹⁴) (citing Collins Decl. ¶¶ 82–85). According to Petitioner, one of ordinary skill in the art “would understand that ‘**closure latches**’ are a broader category which includes ‘**toggle-locking latches**.’” *Id.* (citing Collins Decl. ¶¶ 51–55, 82–85). In support, Petitioner provides this annotated version of Figure 1 of Burchia:

¹⁴ Petitioner cites column 10 of Burchia, but the quoted text is actually in column 9.

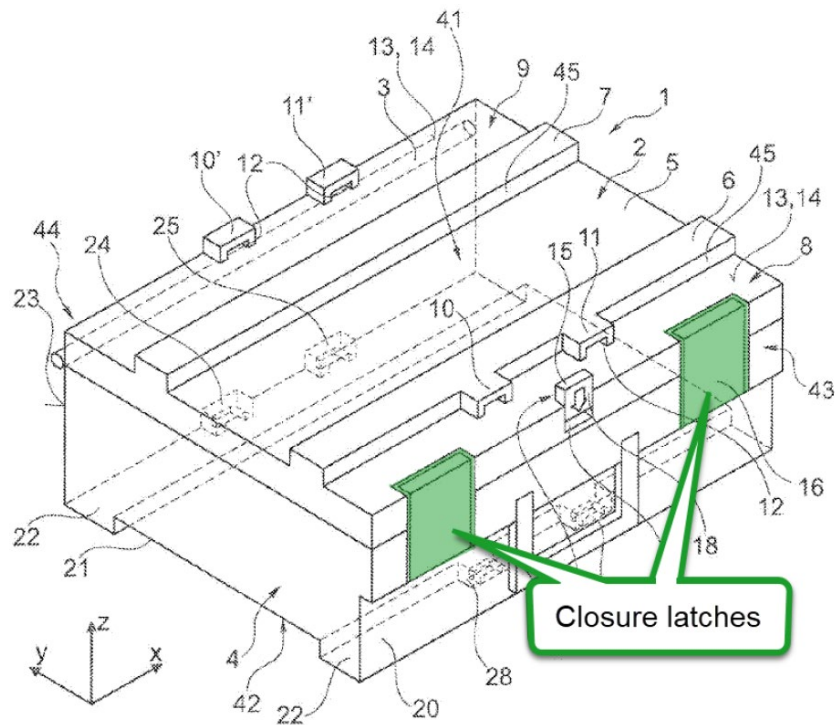


Fig. 1

Pet. 41. In this annotated version of Figure 1 of Burchia, Petitioner added a green text box and green shading identifying elements 16 as “Closure latches.” *Id.* Citing the Collins Declaration for support, Petitioner states that “[t]oggle-locking latches are those latches wherein a lever or handle is stable in two positions, ‘toggling’ between locked and unlocked positions” and that “[s]uch latches are called ‘toggle locking’ because they toggle between two positions such as the movement of a toggle light switch.” Pet. 40–41 (citing Collins Decl. ¶ 82). For limitation 1j, Petitioner relies on the same arguments. *See* Pet. 52–53 (citing Collins Decl. ¶¶ 96–97). For claims 9 and 17, Petitioner refers back to the discussion as to claim 1. *See* Pet. 80, 86.

Patent Owner contends that Petitioner has failed to show that Burchia discloses the “toggle locking latch” limitations. *See* Prelim. Resp. 32–34. First, Patent Owner argues that Burchia “in no way describes its closure

latches 16 as toggle locking latches” and that, “[i]nstead, Burchia merely states that ‘closure elements 16, such as closure latches, for example, can be provided.’” *Id.* at 33 (quoting Ex. 1004, 9:12–15).

Although these statements by Patent Owner each generally appear accurate, they do not lead to the proposed conclusion. In an obviousness analysis, the question “is not merely what the references expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made.” *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976). Here, we understand Petitioner to take the position that the structures shown in green in the annotated version of Figure 1 of Burchia above would have been understood as “toggle locking latch[es]” to one of ordinary skill in the art, despite being described in text using the allegedly broader category of “closure latches.” *See* Ex. 1004, 9:12–15. This understanding is supported by the Collins Declaration. *See* Collins Decl. ¶ 85 (stating, “[t]hus, even if Burchia’s closure latches are not considered toggle locking latches (*they are*)” (emphasis added)), *cited at* Pet. 43.

On that point, Patent Owner responds that “it is evident from Figure 1 that the closure elements 16 are not toggle locking latches at all.” Prelim. Resp. 33. At this stage of the proceeding, however, this assertion is mere attorney argument, unsupported by declaration testimony or other evidence of the understanding of one of ordinary skill in the art on the relevant issue. *See Elbit Sys. of Am., LLC v. Thales Visionix, Inc.*, 881 F.3d 1354, 1359 (Fed. Cir. 2018) (“‘[A]ttorney argument is not evidence’ and cannot rebut other admitted evidence.” (quoting *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017))). On the current record, we

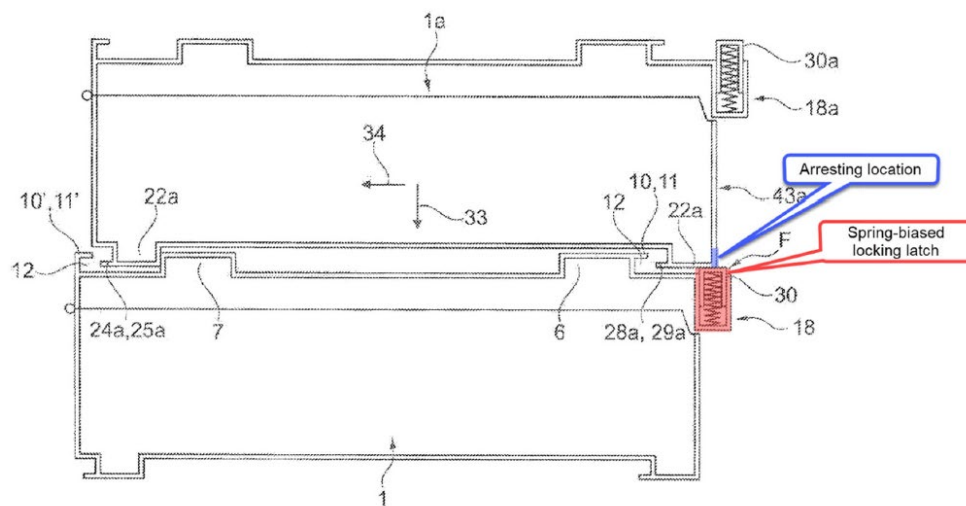
determine that Petitioner has made a sufficient showing that Burchia discloses the “toggle locking latch” limitations.

In the alternative to relying on Burchia for the “toggle locking latch” limitations, Petitioner also asserts that one of ordinary skill in the art would have used toggle locking latches as an “obvious design choice” based on alleged findings by the examiner during prosecution of the ’026 patent that Bensman teaches the relevant features. *See* Pet. 41–43. As noted by Patent Owner, however, “Bensman is not included as a reference in this ground.” Prelim. Resp. 33. And Petitioner presented a ground based on Burchia, Metabowerke, and Bensman, but it challenged only dependent claims 8, 16, and 23, not independent claims 1, 9, or 17. *See* Pet. 100–101. If Petitioner had intended to include Bensman as part of *this* ground challenging claims 1–23, it could have done so. *See Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1335–37 (Fed. Cir. 2020) (determining that the Board erred in instituting trial on the basis of a ground not expressly presented by the petitioner, which included a reference relied on as evidence of general knowledge of a feature); *see also SAS*, 138 S. Ct. at 1351 (stating the statute confirms that the petition “should guide the life of the litigation”). For these reasons, we question Petitioner’s apparent alternative reliance on Bensman in the context of this asserted ground based on Burchia and Metabowerke. To the extent that Petitioner relies on Bensman as mere support for its design choice argument, we need not reach that argument given that we already found persuasive Petitioner’s reliance on Burchia for the “toggle locking latch.”

c. The “locking latch arresting location” Limitations

Limitation 1n recites “a locking latch arresting location defined by one of the first container or the second container.” Ex. 1001, 23:46–47. Independent claims 9 and 17 recite the same requirements. *Id.* at 24:55–56 (claim 9), 26:9–10 (claim 17). We will refer to these as the “locking latch arresting location” limitations.

Petitioner states that “Burchia discloses a **locking latch arresting location** defined by the lower front face of the second (top) container.” Pet. 58 (citing Collins Decl. ¶¶ 107–113). According to Petitioner, “Burchia describes that its containers have a ‘locking element for securing the plug-in connection to prevent release.’” *Id.* (quoting Ex. 1004, 11:34–36) (citing Collins Decl. ¶ 107). Petitioner adds that “[t]his locking element is a **locking latch**,” before providing the following annotated versions of Figures 4 and 5 of Burchia:



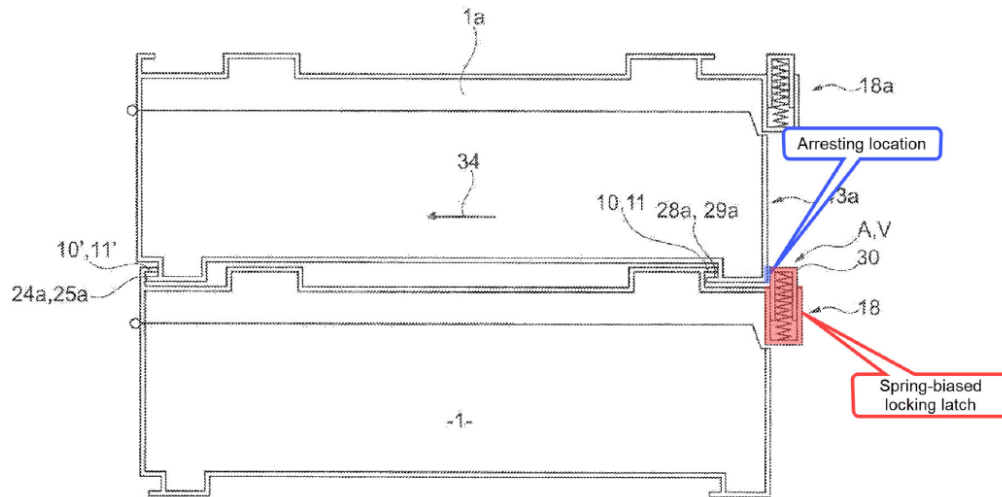


Fig. 5

Pet. 59–60. In both the annotated version of Figure 4 of Burchia and the annotated version of Figure 5 of Burchia above, Petitioner added (1) a blue text box and blue shading identifying an “Arresting location” and (2) a red text box and red shading identifying element 18 as a “Spring-biased locking latch.” Pet. 59–60. Petitioner states that “Burchia explains that when the locking element is in the locking position, as shown in Figure 5, it ‘serves as a stop’ for the container and prevents displacement of one container from the other.” Pet. 59 (quoting Ex. 1004, 12:61–67) (citing Ex. 1004, Fig. 5; Collins Decl. ¶ 108). Thus, according to Petitioner, “[t]he stop position for the **locking latch** is on the lower front face of the second container and is a **locking latch arresting location**.” *Id.*

Petitioner adds that “Burchia also explains that the ‘stop surface’ does not have to be at the end of the container, and instead can be formed in a ‘setback surface’ or recess.” Pet. 61 (citing Ex. 1004, 6:48–50; Collins Decl. ¶ 110); *see also* Pet. 61–63 (further discussing this alternative position). For claims 9 and 17, Petitioner refers back to the discussion of claim 1. *See* Pet. 80, 86.

Patent Owner argues that Petitioner has failed to show that Burchia discloses the “locking latch arresting location” limitations. *See* Prelim. Resp. 38–40. Specifically, Patent Owner posits as “self-evident” from Petitioner’s annotated figures above that “Burchia fails to *define* any location in the top container for arresting the locking latch” because, according to Patent Owner, “Petitioner’s annotated blue region is nothing more than a portion of the face of Burchia’s container.” *Id.* at 39. In support, Patent Owner provides these definitions: “*Define* (verb) as: mark out the boundary or limits of; *Defined* (adj.) as: make clear the outline of; delineate.” *Id.* at 38 (quoting Ex. 2005 at 3).

At this stage of the proceeding, we do not agree with Patent Owner. Even applying the definitions provided by Patent Owner, on the current record, the identified “locking latch arresting location” appears to be “defined by” the upper of the two depicted containers in that—as acknowledged by Patent Owner (Prelim. Resp. 39)—a portion of the face of the upper container *is* the identified “locking latch arresting location.” For these reasons, on the current record, we determine that Petitioner has made a sufficient showing that Burchia discloses the “locking latch arresting location” limitations.

d. The “corner bumper” Limitations

Limitation 1k recites certain requirements as to a “first corner bumper” and limitation 1l recites certain requirements as to a “second corner bumper.” Ex. 1001, 23:31–40. Independent claims 9 and 17 *do not* recite similar limitations, but dependent claims 10 and 18 (which depend from claims 9 and 17, respectively) do. *Id.* at 23:31–40 (claim 1), 24:62–25:5

(claim 10), 26:22–32 (claim 18). We will refer to these as the “corner bumper” limitations.

In this asserted ground, Petitioner does not rely on Burchia or Metabowerke as disclosing the “corner bumper” limitations, but still takes the position that it would have been obvious to one of ordinary skill in the art “to include a first corner bumper, as such a bumper would provide additional protection to the corner of the container and was an obvious design option.” Pet. 54 (citing Collins Decl. ¶¶ 98–102). In support, Petitioner highlights findings by the examiner during prosecution of the challenged patent¹⁵ that U.S. Patent Publication No. 2007/0138041 A1 to Welsh (Ex. 1023) discloses “corner bumpers.” Pet. 54–55 (citing Ex. 1002 at 281). Then, in a footnote, Petitioner identifies four additional references discussed in the Collins Declaration that allegedly “show the obviousness of adding corner bumpers to modular toolboxes.” Pet. 55 n.6 (citing Exs. 1025–1028). For claims 10 and 18, Petitioner relies on the same arguments. *See* Pet. 83, 87.

Patent Owner contends that there is a “complete lack of evidence” to support Petitioner’s position because Welsh and the four additional references are not part of this asserted ground. *See* Prelim. Resp. 34–37. At this stage of the proceeding, we agree with Patent Owner’s argument. If Petitioner had intended to include Welsh (or any of the four additional references) as part of this ground challenging claims 1, 10, and 18, it could

¹⁵ Petitioner states that the findings as to Welsh were during prosecution of the “related ’026 patent,” but the citation is to Exhibit 1002—the prosecution history *of the challenged patent*. *See* Pet. 54 (citing Ex. 1002), vi (listing Exhibit 1002 as the file history for the challenged patent).

have done so. *See Koninklijke Philips*, 948 F.3d at 1335–37; *see also SAS*, 138 S. Ct. at 1351. Notably, in two of the grounds asserted in this proceeding—one based on Burchia, Metabowerke, and Chen (Pet. 95–98) and one based on Metabowerke, Burchia, and Chen (Pet. 146)—Petitioner expressly includes Chen in the grounds to address the “corner bumper” limitations. *See* Pet. 96–98 (discussing the corner bumpers allegedly disclosed in Chen). For these reasons, we question Petitioner’s apparent reliance on Welsh and the four additional references of this asserted ground based on Burchia and Metabowerke. On the current record and in view of our decision to institute based on another ground (*see* § II.E.3.h), we reach no conclusion as to whether Petitioner has made a sufficient showing that the proposed combination of Burchia and Metabowerke discloses the subject matter of the “corner bumper” limitations in claims 1, 10, and 18.

e. The Combination of Burchia and Metabowerke

Petitioner provides reasons that one of ordinary skill in the art would have combined Burchia and Metabowerke. *See* Pet. 26–27 (citing Collins Decl. ¶¶ 63–64). According to Petitioner, one of ordinary skill in the art would have been “motivated to include Metabowerke’s connector, which is a smaller depressed surface on the face of a container lid instead of Burchia’s connector, which protrudes from a depressed surface that extends across the entire length of a container lid.” Pet. 26 (citing Collins Decl. ¶ 63). Petitioner adds, “[b]y using a smaller depressed surface instead of the larger depressed surface, Metabowerke reduces the possibility of a protruding coupler being damaged” and “creates more contiguous space within the container to hold items.” *Id.* (citing Collins Decl. ¶ 63). Petitioner states, “[t]his is because in Metabowerke, the coupling rib is flush

with most of the surface of the lid, whereas in Burchia, the coupling rib protrudes” such that, “[w]hen coupling another container on top by sliding its surface, Metabowerke’s flush connector is less likely to become damaged compared to Burchia’s connector.” *Id.* (citing Collins Decl. ¶ 63).

Petitioner also discusses why there would have been a reasonable expectation of success in the combination. *See* Pet. 27 (citing Collins Decl. ¶ 64).

Patent Owner argues that Petitioner has not articulated a sufficient rationale as to how or why one of ordinary skill in the art would have combined Burchia and Metabowerke. *See* Prelim. Resp. 41–45. First, Patent Owner alleges a lack of clarity in Petitioner’s proposed modification, with Patent Owner stating two options: (1) “Burchia would remain the same, but its coupler replaced with that of Metabowerke” and (2) “Burchia would remain the same, except that the rear portion of Burchia’s top face would be completely removed, the raised rib extended backwards, and Metabowerke’s depressions added, but the rest of Burchia’s coupler would remain the same.” Prelim. Resp. 42.

Having reviewed the current record, we do not view either of Patent Owner’s options as accurately capturing Petitioner’s proposed modification. Petitioner’s discussion of the benefit of “more continuous space within the container to hold items” and of a “smaller depressed surface on the face of [the] container lid” shows that the structural features of the upper portion of the lid in the proposed modified device more closely resemble those in Metabowerke’s Figure 1 than Burchia’s Figure 1. *See* Pet. 26–27. In addition, the remaining of Burchia’s coupler structures on the bottom side of each container would need to be modified to operate with Metabowerke’s

couplers on the top side. *See* Pet. 27 (“The corresponding male-couplers with tongues could then simply be sized to enter the depressed surface and engage the rib.”).

Thus, Patent Owner’s option 1 is not entirely accurate, as the container lid would be modified as discussed above. As to option 1, Patent Owner argues that the proposed modification would not satisfy the “two sidewalls” limitation. *See* Prelim. Resp. 42. For the reasons already discussed above (*see* § II.E.3.a(2)), we disagree.

Option 2 appears closer to the proposed structural changes in the lid. As to option 2, Patent Owner asserts a lack of clarity as to how “Burchia’s coupler” would work with “Metabowerke’s depressions.” Prelim. Resp. 42. As stated by Petitioner, the “corresponding male-couplers with tongues”—i.e., on the bottom side of the container as disclosed in Burchia—“could then simply be sized to enter the depressed surface and engage the rib,” i.e., of the female-couplers similar to the top side of the lid as disclosed in Metabowerke Figure 1. *See* Pet. 27.

Finally, Patent Owner argues that the motivation provided is “based solely on ex post facto reasoning supported only by conclusory expert testimony.” Prelim. Resp. 43. According to Patent Owner, the alleged benefits from the modification—reduced possibility of a coupler being damaged and more contiguous space within the container to hold items (Pet. 26)—are “completely speculative and even nonsensical” and also “unreasonable.” Prelim. Resp. 44.

At this stage of the proceeding, Petitioner adequately explains the reasons to combine Burchia and Metabowerke, which is supported by the Collins Declaration. In contrast, Patent Owner relies on attorney argument

as to the Petition’s alleged failings. *See Elbit Sys.*, 881 F.3d at 1359. On the current record, we determine that Petitioner has made a sufficient showing that a person of ordinary skill in the art would have had reason to modify Burchia and Metabowerke as proposed and that the articulated reasoning is supported by rational underpinning.

f. Other Arguments

Patent Owner presents two additional overall arguments as to this asserted ground. First, Patent Owner asserts that Petitioner has failed to address the obviousness factors from *Graham* by not identifying the differences between the claimed subject matter and the prior art. *See* Prelim. Resp. 21–23; *see also Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (“Under § 103, the scope and content of the prior art are to be determined; *differences between the prior art and the claims at issue are to be ascertained*; and the level of ordinary skill in the pertinent art resolved.” (emphasis added)). According to Patent Owner, “Petitioner asserts that ***Burchia* discloses each and every element of the independent claims**” but “does not provide Patent Owner[] or the Board with the required specificity as to what claim element(s) are purportedly missing from one reference and disclosed by another.” Prelim. Resp. 22 (citing Pet. 25).

We disagree with Patent Owner. The sentence in the Petition *immediately following* that quoted by Patent Owner as allegedly showing that Petitioner relies on Burchia for “**each and every element**” of claim 1 makes clear that Petitioner relies on Metabowerke *in the alternative* in this asserted ground as to certain claim language: “To the extent [P]atent [O]wner argues that Burchia fails to disclose a ‘depressed surface’ having a ‘back wall,’ ‘sidewalls,’ and a ‘rib,’ it would have been obvious to

incorporate such a depressed surface from Metabowerke, as set forth below.” Pet. 25–26 (citing Collins Decl. ¶¶ 62–164). Then, in line with that statement, as to at least limitations 1c, 1d, 1g, 1h, and 1m, Petitioner presents arguments as to Burchia, and then, *in the alternative*, presents arguments as to Metabowerke. *See* Pet. 32–39, 44–50, 56–58.

For example, as to limitation 1c (discussed in detail above (*see* § II.E.3.a)), Petitioner argues, with sufficient particularity, that, if Burchia does not disclose “two sidewalls” “projecting from a depressed surface,” Metabowerke does. *See* Pet. 32–37; *see also* *Intelligent Bio-Sys., Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” (quoting 35 U.S.C. § 312(a)(3))). Indeed, Petitioner’s alternative arguments as to limitation 1c were sufficiently clear that Patent Owner responded substantively to both the primary argument (as to Burchia) and the alternative argument (as to Metabowerke). *See* Prelim. Resp. 26–35; *see also* *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 296 (2016) (Alito, J. concurring in part and dissenting in part) (“Section 312(a)(3)’s particularity requirement is designed, at least in part, to ensure that a patent owner has sufficient notice of the challenge against which it must defend.”).

As its second overall argument as to this ground, Patent Owner contends that the Collins Declaration should be given “little (if any) weight” because Dr. Collins allegedly “parrots the Petition, does not identify any additional facts or information supporting the Petition’s assertions, and provides only conclusory testimony.” Prelim. Resp. 45 (citing *Xerox Corp.*

v. Bytemark, Inc., IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential) (denying institution and determining that testimony of a declarant that merely repeats, *verbatim*, conclusory assertions from a petition, without citing additional supporting evidence or providing technical reasoning to support the testimony, is entitled to little weight).

We disagree with Patent Owner’s view that Dr. Collins merely repeats *verbatim* conclusory assertions from the Petition. As one example, Dr. Collins’s discussion of limitation 1c in the context of this asserted ground provides additional relevant information, including the understanding of one of ordinary skill in the art as to the term “depressed”—“offset by a vertical distance downward in the direction generally perpendicular to a reference surface”—to further explain *why* Burchia allegedly discloses a “depressed surface.” *Compare* Collins Decl. ¶ 71, *with* Pet. 32–34; *see also* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”). Thus, contrary to Patent Owner’s position, the added discussion in the Collins Declaration goes beyond exhibit labeling and “some small typographical changes.” *Cf.* Prelim. Resp. 46 n.5.

g. Conclusion for Claim 1

Because the Petition shows a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims based on at least one of the asserted grounds (*see* § II.E.3.h), we include claim 1 in the context of this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

h. Conclusion for Claims 9 and 17

Patent Owner does not offer any arguments specifically addressing the remaining limitations of claims 9 and 17. *See* Prelim. Resp. 21–48. We have reviewed Petitioner’s contentions with respect to the remaining limitations, and we determine that the Petition provides a sufficient showing, at this stage of the proceeding, that the combination of Burchia and Metabowerke satisfies each limitation and that one of ordinary skill in the art would have had reason to combine the references.

For the reasons above, we determine, based on the current record, that the Petition shows a reasonable likelihood that Petitioner would prevail in demonstrating that claims 9 and 17 would have been obvious based on Burchia and Metabowerke.

4. Claims 2–8, 10–16, and 18–23

For dependent claims 2–8 (which depend from claim 1), claims 10–16 (which depend from claim 9), and 18–23 (which depend from claim 17), Petitioner contends that the proposed combination of Burchia and Metabowerke satisfies each limitation. Pet. 68–79, 83–86, 87–89. Patent Owner does not present any arguments specifically addressing claims 2–8, 10–16, and 18–23 (aside from the argument addressing the “corner bumper” limitations). *See* Prelim. Resp. 21–48. We include claims 2–8, 10–16, and 18–23 in the context of this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

F. Asserted Obviousness of Claims 1–23 Based on Burchia, Metabowerke, and Lafragette

Petitioner asserts that claims 1–23 of the challenged patent would have been obvious based on Burchia, Metabowerke, and Lafragette. Pet. 7, 89–94. Patent Owner provides arguments specifically addressing this

asserted ground. Prelim. Resp. 48–57. We first summarize aspects of the relied-upon prior art.

1. Overview of Lafragette

In this asserted ground, Petitioner relies on Lafragette, in addition to Burchia (summarized above (*see* § II.E.1)) and Metabowerke (summarized above (*see* § II.E.2)). Lafragette discloses “a connection device for an electronic box.” Ex. 1005 ¶ 1.

Figure 1 of Lafragette is reproduced below:

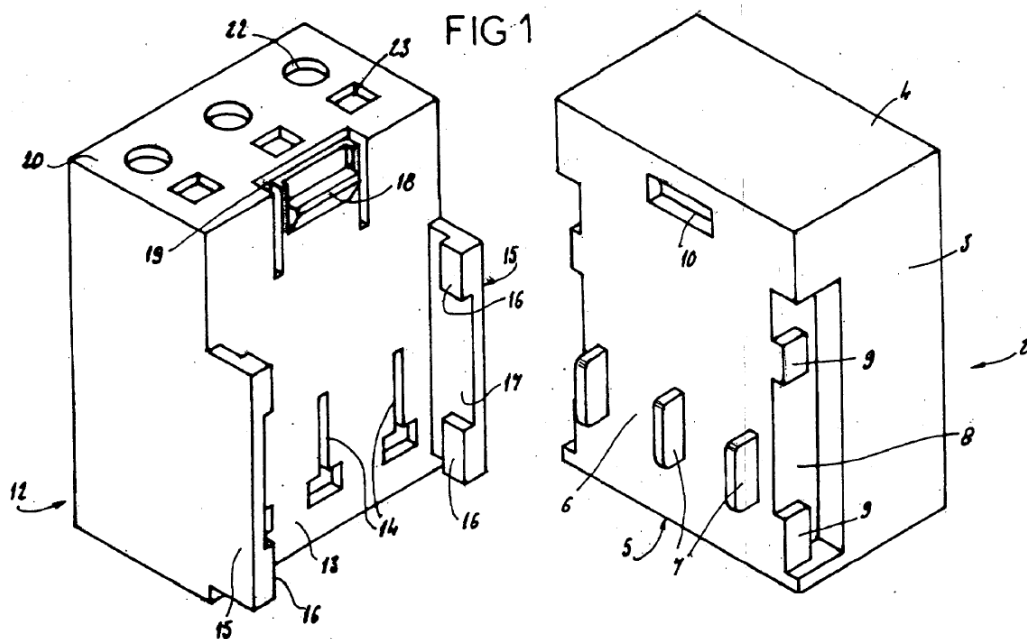


Figure 1 is a “perspective view of an electronic box and a connection module.” Ex. 1005 ¶ 23. On the right, Figure 1 shows a box 2, which contains at least one “electronic card.” *Id.* ¶ 28. Longitudinal assembling face 6 of box 2 is “bounded laterally by two parallel recesses 8, partially blocked near the longitudinal assembling face by two lugs 9.” *Id.* ¶ 29. In addition, provided in longitudinal assembling face 6 near upper face 4 of box 2 is a recess 10. *Id.* ¶ 30. On the left, Figure 1 shows a connection module 12. *Id.* ¶ 31. Near its upper edge, assembling face 13 of module 12

includes resilient tab 18, which is designed to fit in recess 10 of box 2 (shown on the right). *Id.*

2. Independent Claims 1, 9, and 17

For independent claims 1, 9, and 17, Petitioner contends that the proposed combination of Burchia, Metabowerke, and Lafragette discloses each limitation. Pet. 89–94. Patent Owner challenges several aspects of Petitioner’s positions, as detailed below. *See* Prelim. Resp. 48–57. We address in turn each of Patent Owner’s arguments.

a. The Combination of Burchia, Metabowerke, and Lafragette

Petitioner provides reasons that one of ordinary skill in the art would have modified Burchia/Metabowerke to include “a recess as an arresting location” for its locking latch, as allegedly taught in Lafragette. *See* Pet. 89–91 (citing Collins Decl. ¶¶ 165–175). Specifically, Petitioner identifies recess 10 in Lafragette (shown in Figure 1 above) as an arresting location for its locking latch. Pet. 89 (citing Collins Decl. ¶ 166). According to Petitioner, it would have been obvious to one of ordinary skill in the art:

to include a recess, as taught in Lafragette, in the bottom face of Burchia’s top container as an arresting location for Burchia’s locking latch, because a recess would provide additional protection for the latch itself (e.g., to prevent inadvertent disassembly) and provide additional lateral force opposing lateral movement of the containers.

Pet. 89–90 (citing Collins Decl. ¶ 166). Petitioner adds that, “depending upon the designer’s preference, the arresting location of the locking latch could be in different locations (e.g., on the front face of the other container or in a recess in the bottom of the other container).” Pet. 90 (citing Collins Decl. ¶ 167). Petitioner states that “[t]hese are obvious design choices

within the common knowledge and common sense of a [person of ordinary skill in the art] at the time of the claimed invention” and that “[t]he different design choices would provide predictable functionality” to one of ordinary skill in the art. Pet. 91 (citing Collins Decl. ¶ 168). Petitioner adds that there would have been a reasonable expectation of success in the proposed modification. *Id.* (citing Collins Decl. ¶ 169).

Patent Owner argues that Petitioner has not articulated a sufficient rationale as to how or why one of ordinary skill in the art would have combined Burchia, Metabowerke, and Lafragette. *See* Prelim. Resp. 54–56. First, Patent Owner contends that “Burchia already describes a locking element 18 disposed in a recess 17 on the front side 43 of the suitcase” such that “Burchia already achieves the purported motivation of providing additional protection for the latch that Petitioner claims Lafragette would purportedly add.” *Id.* at 55 (footnote omitted) (citing Ex. 1004, 11:52–54).

Based on the current record, we view this argument as not properly addressing the benefit identified by Petitioner. Here, the proposed modification would add a recess *on the top container* to engage locking element 18 (from Burchia) *on the bottom container*. *See, e.g.*, Pet. 90 (discussing how “the arresting location of the locking latch could be in different locations (e.g., on the front face *of the other container* or in a recess in the bottom *of the other container*)” (emphasis added)). In contrast, Patent Owner highlights a recess *on the same container* as locking element 18. Prelim. Resp. 55.

Next, Patent Owner contends that Petitioner’s proposed modification “would make it more difficult to access the sliding part 30 needed to be depressed to release the containers.” Prelim. Resp. 55 (citing Ex. 1004,

13:9–16). Even if adding a recess on the upper container in the proposed modified device would have made it more difficult to disengage the container, the added benefits highlighted by Petitioner (Pet. 89–91) may have outweighed that disadvantage to one of ordinary skill in the art. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (stating that “a given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine”); *see also Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000) (“The fact that the motivating benefit comes at the expense of another benefit . . . should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.”). The parties should consider developing this issue during trial.

Finally, Patent Owner contends that the proposed modification “would render Burchia unsuitable for its intended purpose of easily connecting and disconnecting the containers by requiring Lafragette’s use of ‘a Screwdriver, in order to disengage [resilient tab 18] from the recess 10.’” Prelim. Resp. 55 (quoting Ex. 1005 ¶ 33). Resilient tab 18 from Lafragette, however, will not be present in the proposed modified device; rather, as acknowledged elsewhere by Patent Owner (Prelim. Resp. 55), locking element 18 from Burchia will. For at least that reason, the current record does not support that a screwdriver would be necessary to disengage the containers in the context of the modified device.

On the current record and in view of our decision to institute based on another ground (*see* § II.E.3.h), we reach no conclusion as to whether

Petitioner has made a sufficient showing that one of ordinary skill in the art would have combined Burchia, Metabowerke, and Lafragette as proposed.

b. Whether Lafragette is Nonanalogous Art

Patent Owner argues that one of ordinary skill in the art would not have combined Burchia or Metabowerke with Lafragette because Lafragette is nonanalogous art. *See* Prelim. Resp. 49–54. “Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004), *quoted in Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 1359 (Fed. Cir. 2020) (applying *In re Bigio* in an appeal from an *inter partes* review).

Petitioner states that “Chen, Burchia, Metabowerke, Lafragette, and the [challenged] patent, are in the analogous field of modular toolboxes or connectable containers.” Pet. 95 (citing Collins Decl. ¶ 177); *see also* Pet. 98 (citing Collins Decl. ¶ 186) (similar); Pet. 128 (citing Collins Decl. ¶ 240) (stating that “all of the art is in the field of connectable containers”). Petitioner does not address the “reasonably pertinent” test.

Because the Petition shows a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims based on another asserted ground (*see* § II.E.3.h), and because a petitioner need not anticipate or raise analogous art arguments in its petition (*Sanofi-Aventis Deutschland GmbH v. Mylan Pharma., Inc.*, 66 F.4th 1373, 1379 (Fed. Cir. 2023)), we do not address the merits of Patent Owner’s argument at this

time. If Patent Owner maintains this argument at trial, the parties should *fully* brief this issue, beginning with Patent Owner’s Response.

c. Other Arguments

Patent Owner presents two other general arguments as to this asserted ground. First, Patent Owner again asserts that Petitioner has failed to address the obviousness factors from *Graham* by not identifying the differences between the claimed subject matter and the prior art. *See* Prelim. Resp. 48–49. According to Patent Owner, “[j]ust as with the combination of Burchia and Metabowerke . . . , Petitioner fails to identify with the required specificity what claim element(s) are purportedly missing from one reference and disclosed by another reference.” *Id.* at 48–49.

We again disagree with Patent Owner. For this asserted ground, Petitioner adds Lafragette to the prior combination of Burchia and Metabowerke, and still challenges claims 1–23. *See* Pet. 89–94. Yet the discussion of this asserted ground only addresses the motivation to combine the references and limitations 1n, 1o, 9l, 9m, 17l, and 17m. *See* Pet. 89–94. Thus, as to the other limitations in claims 1, 9, and 17, and as to dependent claims 2–8, 10–16, and 18–23, Petitioner relies on the positions stated as to the asserted ground based on Burchia and Metabowerke. For those aspects, for the reasons above, we determine that Petitioner presents with sufficient particularity the differences between the claimed subject matter and the prior art. *See* § II.E.3.f.

As to limitations 1n, 1o, 9l, 9m, 17l, and 17m, Petitioner makes clear that it relies on Lafragette *in the alternative* as to certain specific claim language: “To the extent [P]atent [O]wner argues that Burchia lacks an ‘arresting location,’ it would have been obvious to modify Burchia

according to Lafragette’s teaching to include a recess as an arresting location.” Pet. 89 (citing Collins Decl. ¶¶ 165–175). Then, in line with that statement, Petitioner addresses why Lafragette allegedly teaches limitations 1n, 1o, 9l, 9m, 17l, and 17m. *See* Pet. 91–94.

As its second general argument, Patent Owner relies on its prior argument—presented in the context of the asserted ground of Burchia and Metabowerke—that the Collins Declaration should be given “little (if any) weight.” Prelim. Resp. 56. For the same reasons discussed above, we disagree with this argument. *See* § II.E.3.f.

d. Conclusion for Claims 1, 9, and 17

Because the Petition shows a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims based on another asserted ground (*see* § II.E.3.h), we include this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

3. Claims 2–8, 10–16, and 18–23

For dependent claims 2–8 (which depend from claim 1), claims 10–16 (which depend from claim 9), and 18–23 (which depend from claim 17), Petitioner contends that the proposed combination of Burchia, Metabowerke, and Lafragette satisfies each limitation. Pet. 89–94. Patent Owner does not present any arguments specifically addressing claims 2–8, 10–16, and 18–23. *See* Prelim. Resp. 48–57. We include claims 2–8, 10–16, and 18–23 in the context of this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

G. Asserted Obviousness of Claims 1, 10, and 18 Based on Burchia, Metabowerke, and Chen

Petitioner asserts that claims 1, 10, and 18 of the challenged patent would have been obvious based on Burchia, Metabowerke, and Chen. Pet. 7, 95–98. Patent Owner provides arguments specifically addressing this asserted ground. Prelim. Resp. 57–60. We first summarize aspects of the relied-upon prior art.

1. Overview of Chen

In this asserted ground, Petitioner relies on Chen, in addition to Burchia (summarized above (*see* § II.E.1)) and Metabowerke (summarized above (*see* § II.E.2)). Chen discloses “a cart having drawers, four corner bumpers, two side containers, and two corner top holders.” Ex. 1024 ¶ 2.

Figure 1 of Chen is reproduced below:

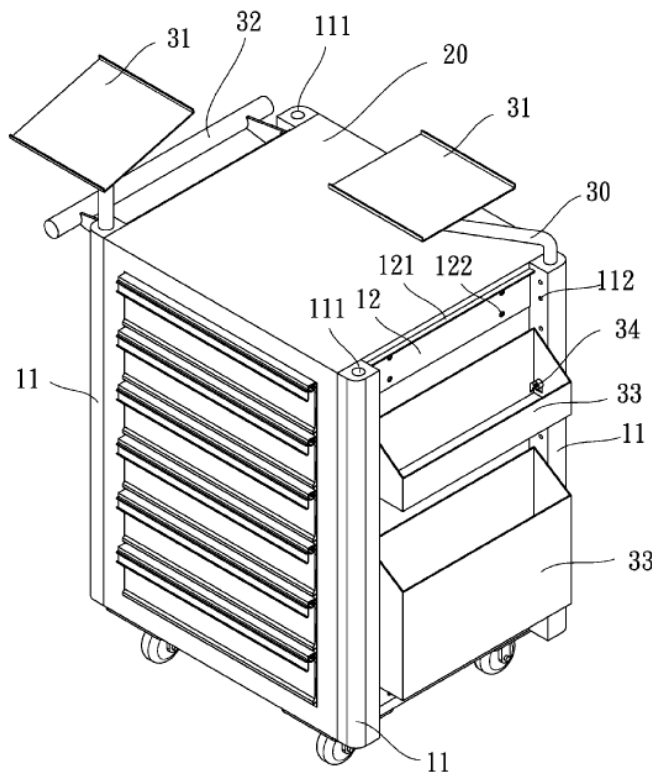


Fig. 1

Figure 1 is a perspective view of “a cart having drawers, corner bumpers, side containers, and corner top holders.” Ex. 1024 ¶ 9. The depicted cart includes four vertical bumpers 11, each formed of elastomeric material. *See id.* ¶ 15.

2. Analysis

As discussed above (*see* § II.E.3.d), in the context of this ground, Petitioner builds on the ground based on Burchia and Metabowerke to rely on Chen to address the “corner bumper” limitations in claims 1, 10, and 18. Petitioner highlights teachings as to corner bumpers 11 in Chen as to the “corner bumper” limitations. *See* Pet. 96–97 (citing Collins Decl. ¶ 182). According to Petitioner, one of ordinary skill in the art “would have been motivated to add the corner bumpers of Chen to the containers of Burchia to protect the corners from damage.” Pet. 95 (citing Collins Decl. ¶ 177). Petitioner also discusses why there would have been a reasonable expectation of success in adding the corner bumpers of Chen to Burchia/Metabowerke. *See* Pet. 97–98 (citing Collins Decl. ¶ 183).

Patent Owner asserts that Petitioner has failed to explain adequately how Burchia/Metabowerke would be combined with Chen to address the “corner bumper” limitations. *See* Prelim. Resp. 57–60. Specifically, Patent Owner references Figure 1 of Burchia and states

Given that Burchia’s “stop surface 20” is “offset toward the rear in the Y direction,” it is not clear how Chen’s corner bumper[s] would be applied such that Burchia’s “locking element” would still be able to “lie against the stop surface 20a . . . secur[ing] the coupling connection between the suitcases 1 and 1a to prevent unintentional disengagement.”

Prelim. Resp. 59 (quoting Ex. 1004, 12:62–13:8).

“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). “Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *Id.* This argument appears based on an improper bodily incorporation theory framing the proposed combination as the simple physical incorporation of Chen’s bumpers into Burchia/Metabowerke. If Patent Owner maintains this argument at trial, the parties should *fully* brief this issue, beginning with Patent Owner’s Response. On the current record and in view of our decision to institute based on another ground (*see* § II.E.3.h), we reach no conclusion as to whether Petitioner has made a sufficient showing that the proposed combination of Burchia, Metabowerke, and Chen satisfies the “corner bumper” limitations.

3. Conclusion

Because the Petition shows a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims based on another asserted ground (*see* § II.E.3.h), we include this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

H. Asserted Obviousness of Claims 4 and 13 Based on Burchia, Metabowerke, and Lin

Petitioner contends that claims 4 and 13 (which depend from claims 1 and 9, respectively) would have been obvious based on Burchia, Metabowerke, and Lin. Pet. 7, 98–100. Patent Owner does not present any arguments specifically addressing claims 4 and 13 in the context of this asserted ground, but rather, relies on the same arguments presented as to the ground based on Burchia and Metabowerke. *See* Prelim. Resp. 60. We

include claims 4 and 13 in the context of this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

I. Asserted Obviousness of Claims 8, 16, and 23 Based on Burchia, Metabowerke, and Bensman

Petitioner contends that claims 8, 16, and 23 (which depend from claims 1, 9, and 16, respectively) would have been obvious based on Burchia, Metabowerke, and Bensman. Pet. 7, 100–101. Patent Owner does not present any arguments specifically addressing claims 8, 16, and 23 in the context of this asserted ground, but rather, relies on the same arguments presented as to the ground based on Burchia and Metabowerke. *See Prelim. Resp.* 61. We include claims 8, 16, and 23 in the context of this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

J. Asserted Obviousness of Claims 1–23 Based on Metabowerke, Burchia, and Lafragette

Petitioner asserts that claims 1–23 of the challenged patent would have been obvious based on Metabowerke, Burchia, and Lafragette. Pet. 8, 102–146. Patent Owner provides arguments specifically addressing this asserted ground. *Prelim. Resp.* 61–73.

1. Asserted References

In this asserted ground, Petitioner relies on Metabowerke (summarized above (*see* § II.E.2)), Burchia (summarized above (*see* § II.E.1)), and Lafragette (summarized above (*see* § II.F.1)).

2. Independent Claims 1, 9, and 17

For independent claims 1, 9, and 17, Petitioner contends that the proposed combination of Metabowerke, Burchia, and Lafragette discloses

each limitation. Pet. 102–130, 141–143, 144–145. Patent Owner challenges several aspects of Petitioner’s positions, as detailed below. *See* Prelim. Resp. 61–73. We address in turn each of Patent Owner’s arguments.

a. The “two sidewalls” Limitation

In this ground, Petitioner relies on Metabowerke as to the “two sidewalls” limitation in the same manner as discussed as the alternative in the ground based on Burchia and Metabowerke. *Compare* Pet. 34–37 (reliance on Metabowerke for limitation 1c in the asserted ground based on Burchia and Metabowerke), *with* Pet. 111–113 (reliance on Metabowerke for limitation 1c in this asserted ground).

Patent Owner first relies on its arguments presented as to the ground of Burchia and Metabowerke that Metabowerke does not disclose the “two sidewalls” limitation. *See* Prelim. Resp. 64 (first paragraph). For the reasons discussed above (*see* § II.E.3.a(2)), on the current record, we determine that Petitioner has made a sufficient showing that Metabowerke discloses the “two sidewalls” limitation.

Patent Owner then addresses certain *additional* argument and evidence presented by Petitioner in the context of this asserted ground as to why Metabowerke allegedly discloses the “two sidewalls” limitation. *See* Prelim. Resp. 64–68. Because we did not rely on this additional evidence to reach the conclusion in the prior paragraph (and in the asserted ground of Burchia and Metabowerke) that Petitioner has made a sufficient showing that Metabowerke discloses the “two sidewalls” limitation, we need not and do not address the additional argument and evidence now.

*b. The “toggle locking latch” Limitations and the
“locking latch” Limitation*

Above, we discussed the “toggle locking latch” limitations in claims 1, 9, and 17. *See* § II.E.3.b. In addition, limitation 10 recites “a locking latch coupled to the other of the first container or the second container, the locking latch positionable in a locked position engaging the locking latch arresting location thereby limiting sliding displacement of the first container with respect to the second container.” *Id.* at 23:48–52. Independent claims 9 and 17 recite the same requirements. *Id.* at 24:57–61 (claim 9), 26:11–15 (claim 17). We will refer to these as the “toggle locking latch” limitations.

As evidence of both the “toggle locking latch” of the “first container” and the “toggle locking latch” of the “second container,” Petitioner provides this annotated version of Figure 1 of Metabowerke:

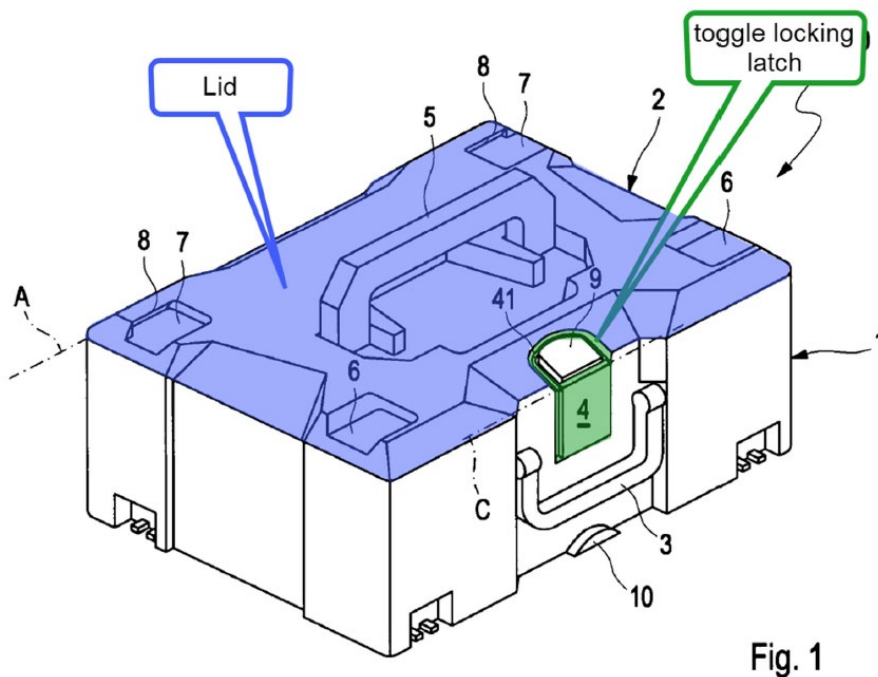
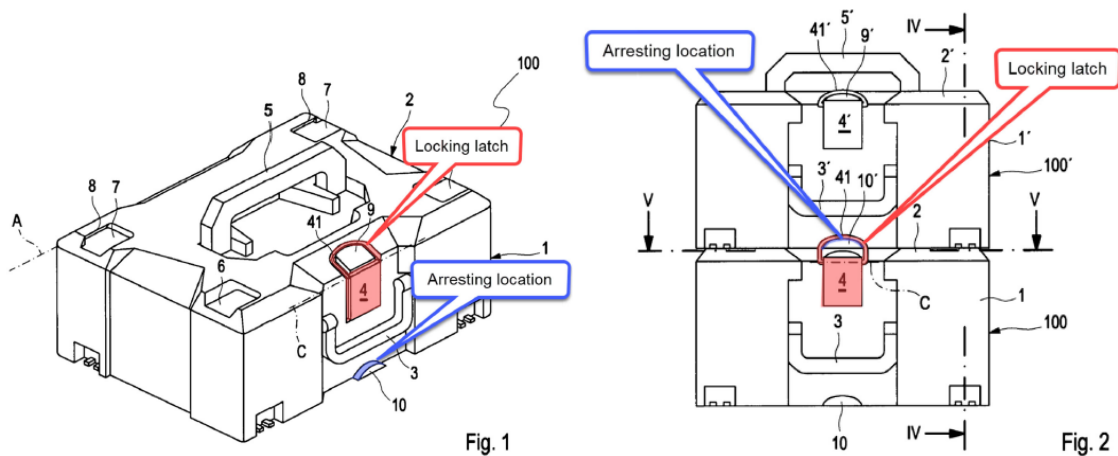


Fig. 1

Pet. 117, 123. In the annotated version of Figure 1 of Metabowerke, Petitioner added (1) a blue text box and blue shading identifying a “Lid” and

(2) a green text box and green shading identifying element 4 as a “toggle locking latch.” Pet. 117, 123. Petitioner states that “Metabowerke discloses a **toggle locking latch** configured to latch” the **lid** of each container (i.e., the “first” and the “second”) in a closed position. Pet. 116 (citing Collins Decl. ¶¶ 217–219), 122 (citing Collins Decl. ¶¶ 227–229).

For the “locking latch” limitations, Petitioner provides these annotated versions of Figures 1 and 2 of Metabowerke:



Pet. 129. In the annotated version of Figure 1 of Metabowerke on the left, Petitioner added (1) a blue text box and blue shading identifying element 10 as an “Arresting location” and (2) a red text box and red shading identifying element 4 as a “Locking latch.” Pet. 129. In the annotated version of Figure 2 on the right, Petitioner added (1) a blue text box and blue shading identifying element 10’ on the upper container as an “Arresting location” and (2) a red text box and red shading identifying element 4 on the lower container as a “Locking latch,” with the identified “Arresting location” and “Locking latch” engaging each other. *Id.* Petitioner adds that “[t]he **locking latch** is positionable in a locked position by engaging the tab in the **locking latch arresting location**.” Pet. 130 (citing Collins Decl. ¶ 242). For

claims 9 and 17, Petitioner refers back to the discussion of claim 1. *See* Pet. 80, 86.

Patent Owner contends that Petitioner has improperly identified “buckle 4” in Metabowerke as *both* the “locking latch” in limitation 1o and the “toggle locking latch” in limitation 1f or 1j (and the corresponding limitations in claims 9 and 17).¹⁶ *See* Prelim. Resp. 68–71, 73 (addressing claims 9 and 17). According to Patent Owner, “[e]ven if this mechanism in Metabowerke met the limitations of the claim, which it does not, it can only perform one of these functions at any one time, and as such, cannot simply disclose both of the claim elements.” *Id.* at 70 (citing *Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 547 (Fed. Cir. 1994)).

Whether it is improper to identify one feature (e.g., a given structural element) in the prior art as satisfying two (or more) different claim elements is an issue of claim construction, turning on whether the claim—when properly construed—requires the separateness of the two (or more) claim elements. *See Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1303–04 (Fed. Cir. 2011) (addressing a similar issue in a section on “Claim Construction”); *HTC Corp. v. Cellular Commc’ns Equip., LLC*, 701 F. App’x 978, 981 (Fed. Cir. 2017) (discussing the Board’s prior ruling on a similar issue as “a ruling on claim construction”). Some decisions from the Federal Circuit have permitted reliance on the same prior art features for two (or more) different claim elements, whereas others have not—all based on

¹⁶ Patent Owner does not challenge Petitioner’s reliance on buckle 4 in Figure 1 of Metabowerke for both “toggle locking latch” limitations because the identified buckles would be on different containers—a “first container” (for limitation 1f) and a “second container” (for limitation 1j).

the facts and evidence in each particular situation. *Compare, e.g., Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1253–57 (Fed. Cir. 2010) *and HTC Corp.*, 701 F. App’x at 981–84 (both construing claims to require separate components for the claim elements at issue), *with Retractable Techs.*, 653 F.3d at 1303–04, *Powell v. Home Depot U.S.A., Inc.*, 663 F.3d 1221, 1231–32 (Fed. Cir. 2011), *and Gen. Elec. Co. v. Int’l Trade Comm’n*, 685 F.3d 1034, 1044–46 (Fed. Cir. 2012) (all construing claims *not* to require separate components for the claim elements at issue).

Here, Patent Owner has not adequately developed this argument because it has not discussed *any* of the evidence supporting its implied claim construction. *See* Prelim. Resp. 68–713–66. Instead, Patent Owner cites *Lantech* as if that decision set forth a *per se* rule on the issue. *See id.* at 70. It does not. For its part, Petitioner—despite expressly relying on the same structure in Metabowerke for different claim elements (*see, e.g.,* Pet. 122–123, 128–130)—did not address whether that reliance was proper as a matter of claim construction, and (of course) has not responded to Patent Owner’s argument on this issue.

If Patent Owner maintains this argument at trial, the parties should *fully* brief this issue in sections of their briefs addressing claim construction, beginning with Patent Owner’s Response. On the current record and in view of our decision to institute based on another ground (*see* § II.E.3.h), we reach no conclusion as to whether Petitioner has made a sufficient showing that Metabowerke satisfies the claim language at issue based on the same structural feature.

c. The Combination of Metabowerke, Burchia, and Lafragette

Petitioner “relies primarily” on Metabowerke in the context of this asserted ground but states that “Metabowerke does not expressly disclose a spring-biased locking latch.” Pet. 102 (citing Collins Decl. ¶¶ 194–280). According to Petitioner, one of ordinary skill in the art would have “readily modified Metabowerke according to the teachings of Lafragette (or Burchia) to include a spring-biased locking latch” because a “spring-biased locking latch would facilitate quicker locking when the top container is placed on the bottom container, rather than requiring a user to manually lock the latch in place.” *Id.* (citing Collins Decl. ¶ 196). Petitioner also discusses why one of ordinary skill in the art would have had a reasonable expectation of success in the combination. Pet. 103 (citing Collins Decl. ¶¶ 197–198).

Patent Owner argues that Petitioner has not articulated a sufficient rationale as to *why* or *how* one of ordinary skill in the art would have combined Metabowerke, Burchia, and Lafragette. *See* Prelim. Resp. 62–64. According to Patent Owner, it is “not clear” that the proposed spring-biased locking latches “**could operate**” with Metabowerke’s overall system, let alone that they would “facilitate quicker locking.” *Id.* at 63.

As to the “why” of the combination, Petitioner takes the position—shared by Dr. Collins—that the proposed modification would allow “quicker locking” because a spring would avoid the need to manually move the latch. Pet. 102 (citing Collins Decl. ¶ 196). As to the “how” of the combination, at this stage of the proceeding, Petitioner adequately explains the nature of the proposed modification over nearly two pages of explanation, which is supported by the Collins Declaration. *See, e.g.*, Pet. 102–103 (discussing how one of ordinary skill in the art would “have readily modified

Metabowerke to include the spring-biased locking latch of Lafragette, which is a resilient tab protruding from a second container that engages a recess on the top of the first container when the containers are brought together and slid backwards” Pet. 103 (citing Collins Decl. ¶ 196)).

In addition, Patent Owner again contends that Lafragette is nonanalogous art. *See* Prelim. Resp. 63. For the same reasons discussed above (*see* § II.F.2.b), we do not address the merits of that argument at this time. If Patent Owner maintains the argument at trial, the parties should *fully* brief that issue, beginning with Patent Owner’s Response.

Patent Owner also asserts that one of ordinary skill in the art would not have been motivated to modify Metabowerke to use a recess as to the “locking latch arresting location” limitations. *See* Prelim. Resp. 71–72 (discussing Pet. 128). The argument highlighted from the Petition is presented *in the alternative*, i.e., if Patent Owner argues Metabowerke does not disclose the “locking latch arresting location” limitations. *See* Pet. 128 (first paragraph). Because Patent Owner did not challenge that Metabowerke discloses the “locking latch arresting location” limitations (*see* Prelim. Resp. 61–73), we do not address this alternative position.

On the current record and in view of our decision to institute based on another ground (*see* § II.E.3.h), we reach no conclusion as to whether Petitioner has made a sufficient showing that one of ordinary skill in the art would have combined Metabowerke, Burchia, and Lafragette as proposed.

d. Alleged Improper Obviousness Analysis

Patent Owner again asserts that Petitioner has failed to address the obviousness factors from *Graham* by not identifying the differences between the claimed subject matter and the prior art. *See* Prelim. Resp. 61–62.

According to Patent Owner, “Petitioner alleges that Metabowerke discloses **all claim limitations except a spring-biased locking latch**,” but “Petitioner also asserts that Burchia **discloses all claim limitations**.” *Id.* at 61 (citing Pet. 102 & 25, respectively). Patent Owner contends that Petitioner “fails to identify with the required specificity what claim element(s) are purportedly missing from one reference and disclosed by another reference.” *Id.* at 61–62.

We again disagree with Patent Owner. As an initial matter, Patent Owner’s alleged support for the proposition that Petitioner relies on Burchia for “**all claim limitations**” comes from page 25 of the Petition, which addresses the asserted ground *based on Burchia and Metabowerke* (see § II.E), not the *current* asserted ground based on Metabowerke, Burchia, and Lafragette. *See* Prelim. Resp. 61.

Moreover, the *first paragraph* of the section of the Petition addressing this ground provides the information Patent Owner alleges absent:

Ground 6 relies primarily on Metabowerke as disclosing all claim limitations. [Collins Decl.] ¶¶194-280. However, Metabowerke does not expressly disclose a spring-biased locking latch. *Id.*, ¶194. It would have been obvious to incorporate Burchia’s spring-biased locking latch in the container assembly of Metabowerke. *Id.*

Pet. 102. Then, in the context of at limitations 1n and 1o, Petitioner presents arguments as to Metabowerke, and, *in the alternative*, presents arguments as to Lafragette or Burchia. *See* Pet. 126–130. And for claims 3, 12, and 20—which require that “the locking latch is spring biased to engage with the locking latch arresting location”—Petitioner relies *solely* on Lafragette or Burchia for the added limitation. *See* Pet. 134, 143, 145. We find these

positions to be stated with sufficient particularity at this stage of the proceeding. *See Intelligent Bio-Sys., Inc.*, 821 F.3d at 1369.

e. Conclusion as to Claims 1, 9, and 17

Because the Petition shows a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims based on another asserted ground (*see* § II.E.3.h), we include this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

3. Claims 2–8, 10–16, and 18–23

For dependent claims 2–8 (which depend from claim 1), claims 10–16 (which depend from claim 9), and 18–23 (which depend from claim 17), Petitioner contends that the proposed combination of Burchia and Metabowerke satisfies each limitation. Pet. 131–140, 143–146. Patent Owner does not present any arguments specifically addressing claims 2–8, 10–16, and 18–23. *See* Prelim. Resp. 61–73. We include claims 2–8, 10–16, and 18–23 in the context of this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

K. Asserted Obviousness of Claims 1, 10, and 18 Based on Metabowerke, Burchia, and Chen

Petitioner asserts that claims 1, 10, and 18 of the challenged patent would have been obvious based on Metabowerke, Burchia, and Chen. Pet. 8, 146. Patent Owner provides arguments specifically addressing this asserted ground. Prelim. Resp. 74–75.

1. Asserted References

In this asserted ground, Petitioner relies on Metabowerke (summarized above (*see* § II.E.2)), Burchia (summarized above (*see* § II.E.1)), and Chen (summarized above (*see* § II.G.1)).

2. *Analysis*

As discussed above (*see* § II.E.3.d), in the context of this ground, Petitioner builds on the ground based on Metabowerke and Burchia to rely on Chen to address the “corner bumper” limitations in claims 1, 10, and 18. Specifically, Petitioner references the discussion of the ground based on Burchia, Metabowerke, and Chen (*see* § II.G). *See* Pet. 146 (citing Collins Decl. ¶¶ 281–282).

Patent Owner presents two arguments. *See* Prelim. Resp. 74–75. First, Patent Owner states that “the Petition provides no evidentiary support for the assertion that Metabowerke discloses corner bumpers.” *Id.* at 74 (citing Pet. 146). We agree. In the short section of the briefing addressing the ground, Petitioner states “Metabowerke discloses corner bumpers, or in the alternative [one of ordinary skill in the art] would have been motivated to add the corner bumpers of Chen to the containers of Burchia and Metabowerke to protect the corners from damage.” Pet. 146. But, as argued by Patent Owner, Petitioner does not present evidence that Metabowerke discloses the “corner bumper” limitations. *See, e.g.*, Pet. 53–56, 95–98, 124–125 (all addressing the “corner bumper” limitations but not relying on Metabowerke).

Second, Patent Owner references its argument from the ground based on Burchia, Metabowerke, and Chen that Petitioner has failed to explain adequately how Metabowerke/Burchia would be combined with Chen to address the “corner bumper” limitations. *See* Prelim. Resp. 74.

As discussed above, that argument appears based on an improper bodily incorporation theory framing the proposed combination as the simple physical incorporation of Chen’s bumpers into Metabowerke/

Burchia. *See* § II.G.2 If Patent Owner maintains this argument at trial, the parties should *fully* brief this issue, beginning with Patent Owner’s Response. On the current record and in view of our decision to institute based on another ground (*see* § II.E.3.h), we reach no conclusion as to whether Petitioner has made a sufficient showing that the proposed combination of Metabowerke, Burchia, and Chen satisfies the “corner bumper” limitations.

3. Conclusion

Because the Petition shows a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims based on another asserted ground (*see* § II.E.3.h), we include this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

L. Asserted Obviousness of Claims 4 and 13 Based on Metabowerke, Burchia, and Lin

Petitioner contends that claims 4 and 13 (which depend from claims 1 and 9, respectively) would have been obvious based on Metabowerke, Burchia, and Lin. Pet. 8, 146–147. Patent Owner does not present any arguments specifically addressing claims 4 and 13 in the context of this asserted ground, but rather, relies on the same arguments presented as to the ground based on Metabowerke and Burchia. *See* Prelim. Resp. 75. We include claim 8 in the context of this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

M. Asserted Obviousness of Claims 8, 16, and 23 Based on Metabowerke, Burchia, and Bensman

Petitioner contends that claims 8, 16, and 23 (which depend from claims 1, 9, and 16, respectively) would have been obvious based on

Metabowerke, Burchia, and Bensman. Pet. 8, 147–148. Patent Owner does not present any arguments specifically addressing claims 8, 16, and 23 in the context of this asserted ground, but rather, relies on the same arguments presented as to the ground based on Metabowerke and Burchia. *See* Prelim. Resp. 75. We include claims 8, 16, and 23 in the context of this asserted ground in the instituted *inter partes* review. *See SAS*, 138 S. Ct. at 1354, 1359–60; 37 C.F.R. § 42.108(a).

III. CONCLUSION

For the reasons above, we determine that the Petition shows a reasonable likelihood that Petitioner would prevail with respect to at least one of challenged claims 1–23 of the challenged patent. At this stage of the proceeding, no final determination has yet been made with regard to the patentability of any of the challenged claims or any underlying factual or legal issues, including the construction of claim terms. The final determination will be based on the record as developed during the *inter partes* review.

IV. ORDER

Accordingly, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1–23 of the challenged patent on all asserted grounds and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, *inter partes* review shall commence on the entry date of this Decision, with notice hereby given of the institution of a trial.

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