

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMILEGEND CORPORATION,
Petitioner,

v.

MANEHU PRODUCT ALLIANCE, LLC,
Patent Owner.

PGR2024-00014
Patent 11,781,703 B2

Before WILLIAM V. SAINDON, BENJAMIND. M. WOOD, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION
Granting Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

A. *Background and Summary*

Lumi Legend Corporation (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting a post-grant review of claims 33–36 (the “challenged claims”) of U.S. Patent No. 11,781,703 B2 (Ex. 1001, “the ’703 patent”). Manehu Product Alliance, LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

We have authority to determine whether to institute a post-grant review. 35 U.S.C. § 324(a) (2018); 37 C.F.R. § 42.4(a) (2023) (“The Board institutes the trial on behalf of the Director.”). Section 324(a) provides that a post-grant review may not be instituted “unless . . . the information presented in the petition . . . , if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.”

Upon considering the evidence and arguments in the Petition (including its supporting testimonial evidence) and the evidence and arguments in the Preliminary Response (including its supporting testimonial evidence), we determine that the information presented shows that it is more likely than not that Petitioner would prevail with respect to at least one of the challenged claims. Accordingly, we institute post-grant review on all challenged claims on all asserted grounds. *See* 37 C.F.R. § 42.208(a) (“When instituting post-grant 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.”); *see also SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

B. Real Parties in Interest

Petitioner identifies itself as the sole real party-in-interest. Pet. 1. Petitioner also states that “Lumi Legend Group Company is a parent company of Lumi Legend Corporation.” *Id.*

Patent Owner states that “Manehu Product Alliance, LLC, d/b/a/ MantelMount is the real party in interest” in this proceeding. Paper 5, 1 (Patent Owner’s Mandatory Notices).

C. Related Matters

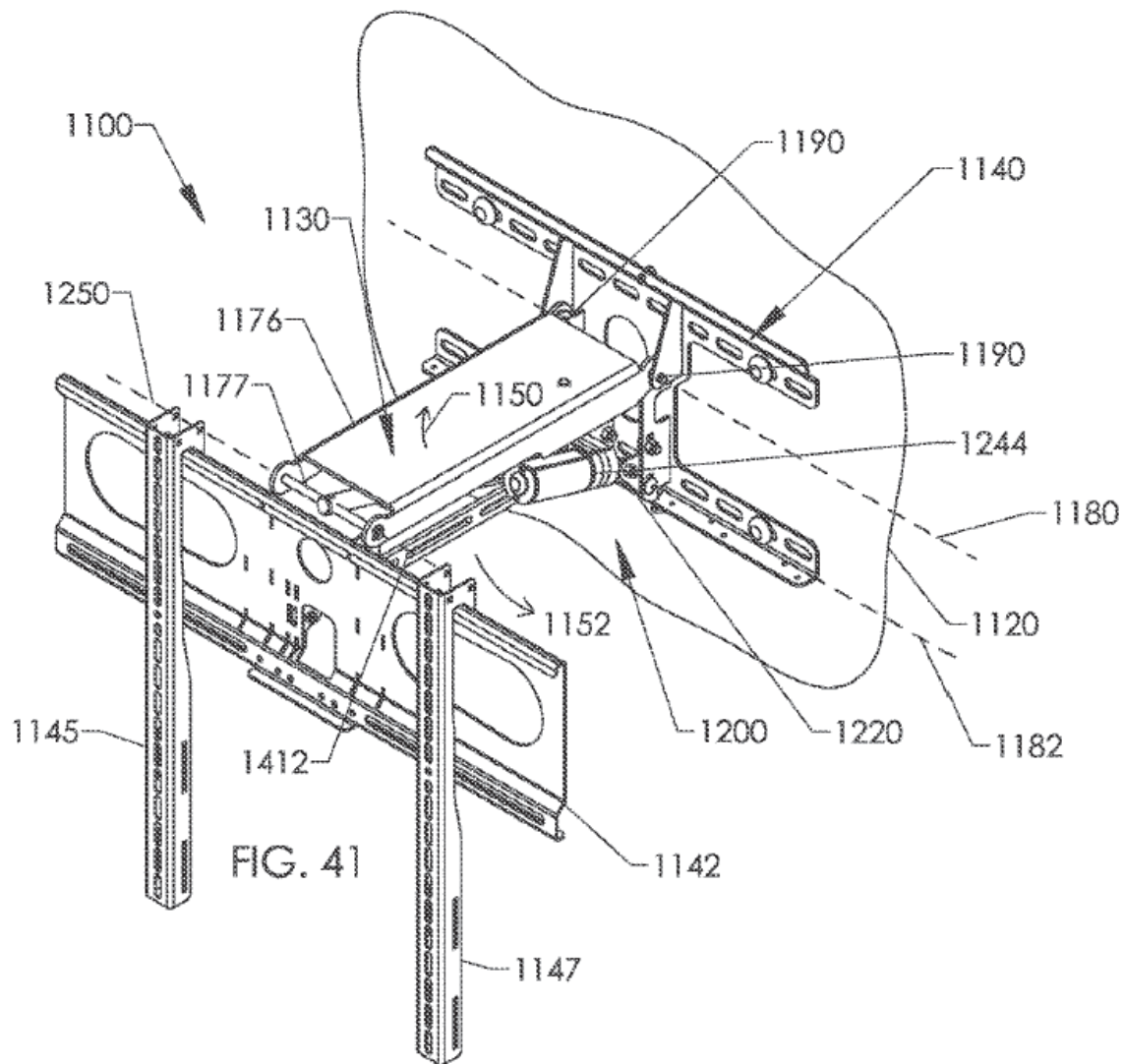
The parties state that the ’703 patent is the subject of the following District Court proceeding: *Cknapp Sales Inc., d/b/a VIVO v. Manehu Product Alliance, LLC d/b/a Mantelmount*, No. 1:23-cv-16181 (N.D. Ill. Nov. 21, 2023). Pet. 1; Paper 5, 1. The parties to that District Court proceeding filed a “Joint Stipulation of Dismissal” explaining that they jointly stipulate to the dismissal of all claims and counterclaims asserted in that proceeding. Ex. 3001. Accordingly, on June 18, 2024, all claims in the case were dismissed with prejudice consistent with the terms of the Joint Stipulation. Ex. 3002.

Patent Owner identifies pending U.S. Patent Application No. 18/241,861, filed September 2, 2023, as related to the ’703 patent. Paper 5, 1. Petitioner also identifies various patent applications related to the ’703 patent. Pet. 2.

D. The ’703 Patent

The ’703 patent is titled “Adjustable Mounting Systems for Televisions.” Ex. 1001, code (54). The disclosed technology “relates generally to mounting systems” and more specifically “to adjustable mounting systems for mounting objects to structures.” *Id.* at 1:30–33.

Claim 33, the sole independent challenged claim, is directed specifically to a television mounting system comprising a support bracket, a display bracket, an arm assembly, and a motorized actuator assembly. *Id.* at 26:21–37. Figure 41 of the '703 patent, reproduced below, depicts an embodiment wherein the actuator assembly comprises a motor. *Id.* at 17:59–63.



As shown in Figure 41, wall mount 1100 comprises a linkage assembly 1130, a support bracket 1140, and a display bracket 1142 with electronic display holders or brackets 1145, 1147. *Id.* at 17:23–27. The linkage

assembly 1130 is rotatably coupled to the support and display brackets 1140, 1142 and can swing upwardly (indicated by arrow 1150 of Fig. 41) or downwardly (indicated by arrow 1152 of Fig. 41). *Id.* at 17:27–31. The support bracket 1140 is mounted on a support structure 1120, which can be a vertical wall. *Id.* at 17:31–33. The wall mount 1100 can include an actuator assembly 1200 operable to drive the display bracket 1142 to different positions. *Id.* at 17:33–35. Actuator assembly 1200 can include a linear actuator 1218, motor 1244, controller, processing units, combinations thereof, or the like. *Id.* at 17:55–58. Linear actuator 1218 can be rotatably coupled to the support bracket 1140 and the display bracket 1142. *Id.* at 17:58–59. The motor 1244 can include one or more drive motors, stepper motors, or the like that are mounted on the linear actuator 1218, the mounting bracket 1142, or another suitable component. *Id.* at 17:59–63.

E. Illustrative Claim

Petitioner challenges claims 33–36. Claim 33, the only independent claim challenged, is illustrative and is reproduced below.

33. A television mounting system comprising:
- a support bracket configured to couple to a wall;
 - a display bracket configured to hold a television;
 - an arm assembly pivotally coupled to the support bracket and movable between a raised configuration to position the display bracket at a raised position and a lowered configuration to position the display bracket at a lowered position, wherein the arm assembly includes an upper arm and a lower arm; and
 - a motorized actuator assembly having a support bracket end rotatably coupled to the support bracket and a display bracket end rotatably coupled to the arm assembly, wherein at least a portion of the motorized actuator assembly moves toward and

past a portion of the lower arm when the arm assembly moves toward the raised configuration.

Ex. 1001, 26:21–37.

F. The Asserted Grounds of Unpatentability

Petitioner asserts that claims 33–36 would have been unpatentable based on the following six grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
36	112(a)	Written Description
36	112(b)	Indefinite
33–36	102(a)	Clary
33–36	103	Clary, Tsuji
33–36	102(a)	Pankros
33–36	103	Pankros, Clary

Petitioner also relies on the Declaration testimony of John D. Pratt. *See* Ex. 1003. Patent Owner relies on the Declaration testimony of Kirsten Carr, Ph.D. *See* Ex. 2004.

II. POST-GRANT REVIEW ELIGIBILITY

The post-grant review provisions of section six of the Leahy-Smith America Invents Act (“AIA”), Pub L. No. 112-29, 125 Stat. 284 (2011), apply only to patents subject to the first inventor to file provisions of the AIA. AIA § 6(f)(2)(A). Specifically, the first inventor to file provisions apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time a claim to a claimed invention that has an effective filing date on or after March 16, 2013. AIA § 3(n)(1).

Furthermore, “[a] petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).” 35 U.S.C. § 321(c); *see also* 37 C.F.R. § 42.202(a) (setting forth the same).

The burden is on Petitioner to show that the challenged patent is eligible for post-grant review. *See Mylan Pharms. Inc. v. Yeda Research & Dev. Co.*, PGR2016-00010, Paper 9 at 10 (PTAB Aug. 15, 2016) (holding that the ultimate burden of persuasion remains with a petitioner to demonstrate that the challenged patent is eligible for post-grant review).

A. Petition Filing Date

The Petition's filing date, January 24, 2024 (Paper 3, 1), is not later than nine months after the '703 patent's grant date of October 10, 2023. Ex. 1001, code (45). Accordingly, the petition was timely filed prior to the deadline set forth in 35 U.S.C. § 321(c).

B. Priority Claim

The '703 patent claims priority to several earlier-filed applications, including two pre-AIA applications: (1) U.S. Provisional Application No. 61/396,850 filed on June 4, 2010; and (2) U.S. Patent Application No. 13/118,297, filed on May 27, 2011. *See* Ex. 1001, code (63). Based solely on the claimed priority dates of June 4, 2010 and May 27, 2011, both of which are before March 16, 2013, the '703 patent would not be eligible to be challenged in a post-grant proceeding. Petitioner, therefore, has the burden of production to show that the challenged patent is eligible for a PGR proceeding. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (explaining in the context of a priority claim for a reference in an *inter partes* review proceeding "the established concept that there are two distinct burdens of proof: a burden of persuasion and a burden of production").¹

¹ We cite *Dynamic Drinkware* for its discussion of the procedural shifting of the burden of production of evidence. We do not cite *Dynamic Drinkware*

A patent's claims are not entitled to an earlier priority date merely because the patentee claims priority, however. *In re NTP, Inc.*, 654 F.3d 1268, 1276 (Fed. Cir. 2011). “It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008). In the absence of an interference or rejection which would require the PTO to make a determination of priority, the PTO does not make such findings as a matter of course in prosecution. *Id.* at 1306.

A claim in a patent application is entitled to the benefit of the filing date of an earlier filed, related application if it meets the requirements of 35 U.S.C. § 120. These requirements include, *inter alia*, that: (1) the written description of the earlier filed application provides support for the claim as of its earlier filing date, as required under 35 U.S.C. § 112; and (2) the later application —contains or is amended to contain a specific reference to the earlier filed application. 35 U.S.C. § 120; *NTP*, 654 F.3d at 1277; *PowerOasis*, 522 F.3d at 1306.

To establish that the '703 patent is eligible for this PGR proceeding, Petitioner first must raise the issue of entitlement to a claimed priority date by identifying, specifically, the features, claims, and ancestral application or applications allegedly lacking § 112 support for the claims based on the

for the issue of whether any claim of a reference patent document is actually entitled to a priority date under 35 U.S.C. 119, 120. The date of a reference is not at issue here; the filing date of the challenged patent is at issue. *See Penumbra, Inc. v. RapidPulse, Inc.*, IPR2021-01466, Paper 34 (March 10, 2023) (Precedential § II.E.3).

identified features. Then, to overcome a claim of PGR eligibility, the patent owner must make a sufficient showing of entitlement to earlier filing date(s), in a manner that is commensurate in scope with the specific points and contentions raised by the Petitioner. *See Dynamic Drinkware*, 800 F.3d at 1379 (explaining that the burden of production, or the burden of going forward with evidence, is a shifting burden).

Here, Petitioner contends that “[t]he ’703 patent is eligible for PGR because it has at least one claim that is not entitled to the filing date of either the ’850 Provisional or the ’297 Application (‘the pre-AIA applications’).” Pet. 17. In particular, Petitioner contends that “at least claims 8, 14, 25, and 26 of the ’703 patent include subject matter that is not disclosed in the pre-AIA applications.” *Id.* On pages 17–27, Petitioner supports that assertion with a detailed discussion of the prosecution history and the claimed subject matter of claims 8, 14, 25, and 26 of the ’703 patent.

Patent Owner states it “does not address the Petitioner’s contentions because Petitioner has failed to meet its burden to establish that it is more likely than not that at least one of the challenged claims 33–36 of the ’703 Patent is invalid.” Prelim. Resp. 20. Patent Owner further states it “reserves the right to respond to Petitioner’s contentions in the event institution is not denied.” *Id.*

In summary, based on Petitioner’s priority analysis discussed above, the priority date of the ’703 patent is after March 13, 2013. Moreover, Petitioner “certifies that the ’703 patent is available for PGR and Petitioner is not barred or estopped from requesting PGR on the identified grounds.” Pet. 3. Patent Owner does not dispute Petitioner’s priority analysis or certification. Accordingly, we determine that the ’703 patent is eligible for post-grant review.

III. ANALYSIS

A. *Principles of Law*

1. *Written Description*

Under 35 U.S.C. § 112(a), a patent specification shall contain a “written description” of the invention. The purpose of the written description requirement is to “ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920 (Fed. Cir. 2004) (quoting *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000)). This requirement protects the *quid pro quo* between inventors and the public, whereby the public receives “meaningful disclosure in exchange for being excluded from practicing the invention for a limited period of time.” *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 970 (Fed. Cir. 2002).

To satisfy the written description requirement, the disclosure must reasonably convey to skilled artisans that the inventor possessed the claimed invention as of the filing date. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). “One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). “The invention is, for purposes of the ‘written description’ inquiry, whatever is now claimed.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). Such description need not recite the claimed invention *in haec verba* but must do more than merely disclose that which would render the claimed invention obvious. *Univ. of Rochester*, 358 F.3d at 923; *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566–67 (Fed. Cir. 1997); *see also PowerOasis, Inc. v. T-*

Mobile USA, Inc., 522 F.3d 1299, 1306–07 (Fed. Cir. 2008) (explaining that § 112, ¶ 1 “requires that the written description actually or inherently disclose the claim element”).

2. *Indefiniteness*

Under 35 U.S.C. 112(b), a patent specification “shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor ... regards as the invention.” This is commonly referred to as the definiteness requirement.

The Board applies in post-grant reviews the same indefiniteness standard as used in federal courts and the U.S. International Trade Commission under *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014), and its progeny. USPTO Memorandum, Approach To Indefiniteness Under 35 U.S.C. § 112 In AIA Post-Grant Proceedings (Jan. 6, 2021).² Under *Nautilus*, “[a] patent is invalid for indefiniteness if its claims, read in light of the patent’s specification and prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus*, 572 U.S. at 898–99 (emphasis added). “[A] patent must be precise enough to afford clear notice of what is claimed, thereby apprising the public of what is still open to them,” but the present standard recognizes that “absolute precision is unattainable.” *Id.* at 899 (internal quotation marks omitted).

² available at <https://www.uspto.gov/sites/default/files/documents/IndefinitenessMemo.pdf>.

3. *Anticipation*

“To anticipate a claim, a prior art reference must disclose each and every element of the claim, either explicitly or inherently.” *Adasa Inc. v. Avery Dennison Corp.*, 55 F.4th 900, 910 (Fed. Cir. 2022) (citing *Eli Lilly & Co. v. Zenith Goldline Pharms., Inc.*, 471 F.3d 1369, 1375 (Fed. Cir. 2006)). “While those elements must be arranged or combined in the same way as in the claim, the reference need not disclose the elements in the very same terms used by the patent.” *Id.* (citing *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (“[T]he reference need not satisfy an *ipsissimis verbis* test.” (citing *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990))). “The question of what a reference teaches and whether it describes every element of a claim is a question for the finder of fact.” *Id.* (citing *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1221 (Fed. Cir. 2003)). As further explained in *Net MoneyIN*,

unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008); *see also Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

4. *Obviousness*

Whether the challenged claims would have been obvious over the cited references also is at issue in this proceeding. Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when available, evidence such as commercial success, long felt but unsolved needs, and failure of others. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *see KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”). The Court in *Graham* explained that these factual inquiries promote “uniformity and definiteness,” for “[w]hat is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context.” 383 U.S. at 18.

The Supreme Court made clear that we apply “an expansive and flexible approach” to the question of obviousness. *KSR*, 550 U.S. at 415. Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. To support this conclusion, however, it is not enough to show merely that the prior art includes separate references covering each separate

limitation in a challenged claim. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness additionally requires that a person of ordinary skill at the time of the invention “would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.*

In determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is insufficient to simply conclude the combination would have been obvious without identifying any reason why a person of skill in the art would have made the combination. *Metalcraft of Mayville, Inc. v. Toro Co.*, 848 F.3d 1358, 1366 (Fed. Cir. 2017).

Moreover, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 164 (Fed. Cir. 1985) (“It is elementary that the claimed invention must be considered as a whole in deciding the question of obviousness.”); *see also Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983) (“[T]he question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious. Consideration of differences, like each of the findings set forth in *Graham*, is but an aid in reaching the ultimate determination of whether the claimed invention as a whole would have been obvious.”).

As a factfinder, we also must be aware “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.” *KSR*, 550 U.S. at 421.

Applying these general principles, we consider the evidence and arguments of the parties.

B. Level of Ordinary Skill in the Art

The level of 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). “This reference point prevents . . . fact finders from using their own insight or, worse yet, hindsight, to gauge obviousness.” *Id.*

“The Graham analysis includes a factual determination of the level of ordinary skill in the art. Without that information, a . . . court cannot properly assess obviousness because the critical question is whether a claimed invention would have been obvious at the time it was made to one with ordinary skill in the art.” *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *see also Ruiz v. A.B. Chance*, 234 F.3d 654, 666 (Fed. Cir. 2000) (“The determination of the level of skill in the art is an integral part of the *Graham* analysis.”).

Factors pertinent to a determination of the level of ordinary skill in the art include: (1) educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of workers active in the field. *Best Med. Int’l, Inc. v. Elekta Inc.*, 46 F.4th 1346, 1353 (Fed. Cir. 2022) (citing *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007) (quoting *Env’t Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696 (Fed. Cir. 1983)). These factors are not exhaustive but merely are a guide to determining the level of ordinary skill in the art. *Daiichi Sankyo*, 501 F.3d at 1256. In determining a

level of ordinary skill, we also may look to the prior art, which may reflect an appropriate skill level. *Okajima*, 261 F.3d at 1355.

Petitioner asserts that a person of ordinary skill in the art “would have had at least a bachelor’s degree in mechanical engineering, electrical engineering, or similar technical degree and at least 2 years of experience in the field of mechanical design or relevant product design experience.”

Pet. 27 (citing Ex. 1003 ¶¶ 56–58). Petitioner also asserts that “[f]or individuals with different educational backgrounds, a person could still be of ordinary skill in the art provided that person’s additional experience compensates for any differences in that person’s education as stated above.” *Id.*

At this stage of the proceeding, Patent Owner does not dispute Petitioner’s level of ordinary skill in the art, but “reserves the right to propose or challenge the level of ordinary skill and claim constructions should the Board institute trial.” Prelim. Resp. 21.

Based on the record before us, we adopt, for purposes of this Decision, Petitioner’s proposed, and unopposed, level of ordinary skill. We also determine that this level of skill is consistent with the disclosed invention and the cited references.

C. Claim Construction

We interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2019). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.*

Petitioner suggests claim constructions for two claim clauses, one clause in claim 33 (Pet. 28–30), and one clause in claim 34 (*id.* at 31–33). Petitioner, however, also asserts that “the claims are unpatentable as anticipated and/or obvious under any reasonable construction” of the two clauses identified. *Id.* at 31, 34 (citing Ex. 1003 ¶¶ 64, 68-69).

In its Preliminary Response, “Patent Owner does not address claim construction . . . because no construction of any term is necessary in order to find that the Petitioner has failed to meet its burden to establish that it is more likely than not that any of the challenged claims 33–36 of the ’703 Patent are unpatentable.” Prelim. Resp. 21.

Having considered the parties’ positions and evidence of record, we determine that no express construction of any claim term is necessary to determine whether to institute post-grant review. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))). To the extent further discussion of the meaning of any claim term is necessary to our decision, we provide that discussion below in our analysis of the asserted grounds of unpatentability.

Any claim discussion in this Decision does not preclude the parties from arguing their proposed constructions of the claims during trial. Indeed, the parties are hereby given notice that final claim construction, in general, is an issue to be addressed at trial. Claim construction will be determined at the close of all the evidence and after any hearing. The parties are expected to assert all their claim construction arguments and evidence in the Petition,

Patent Owner's Response, or otherwise during trial, as permitted by our rules.

D. Ground 4 – Obviousness of Claims 33–36 Over Combination of Clary and Tsuji

We begin our analysis of the asserted grounds with Ground 4.

1. Overview of Clary (Ex. 1004)

Clary is titled “Wall-Affixed Vertically Articulated Flat Panel Display Mount.” Ex. 1004, code (54). Figure 2 of Clary, reproduced below, is a perspective view of a wall-affixed vertically articulated flat panel display mount shown in a lowered position. *Id.* ¶ 6.

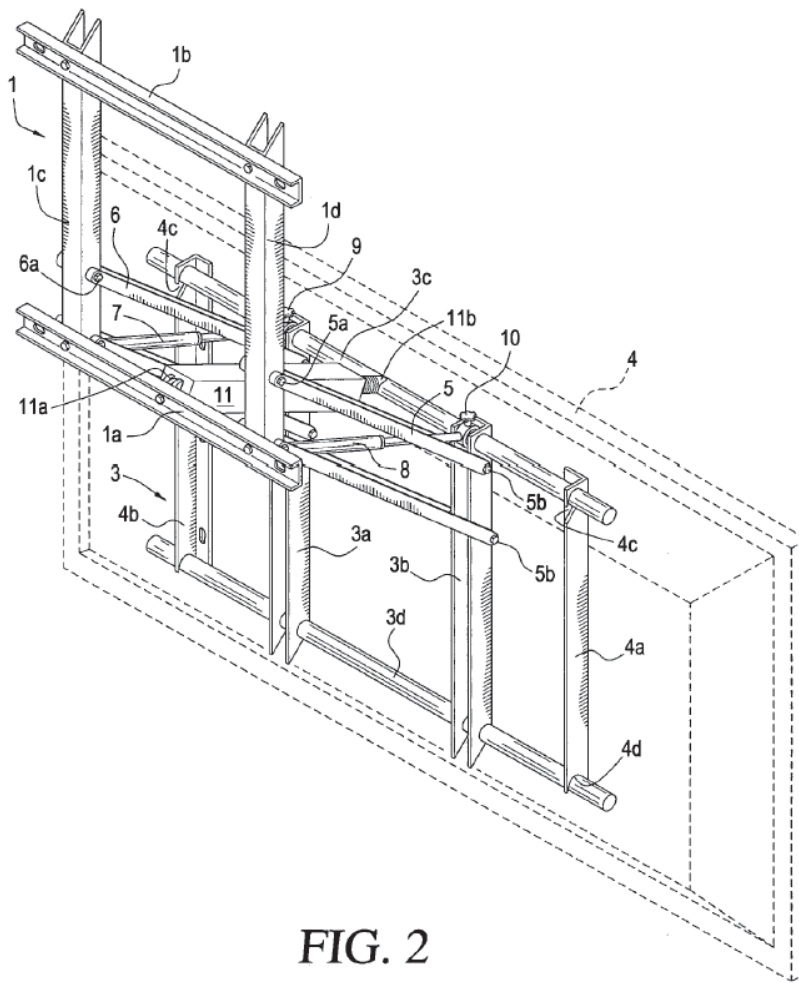
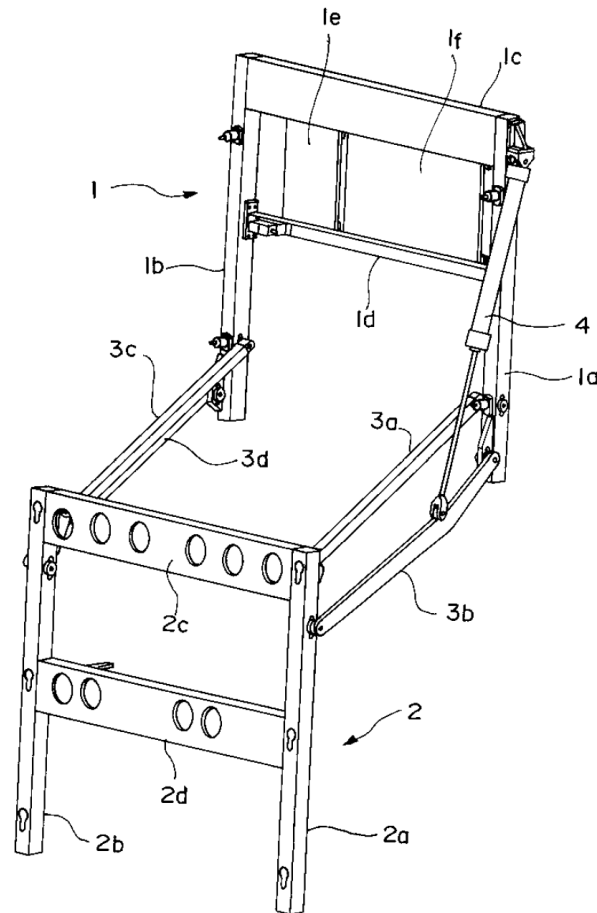


FIG. 2

As shown in Clary's Figure 2, Clary's display mount comprises first frame assembly 1 secured to wall 2 by suitable bolts, and second frame assembly 3 secured to the back of flat screen display 4. *Id.* ¶¶ 13, 14. The frame assemblies 1 and 3 are vertically articulated relative to each other by means of two pairs of horizontally spaced, parallel links 5 and 6. *Id.* ¶ 15.

2. *Overview of Tsuji (Ex. 1015)*

Tsuji is titled "Supporting device for display." Ex. 1004, code (54). Tsuji relates to "a support device for a display that allows maintenance of the display to be easily performed and installation work to be easily performed by a small number of people." *Id.*, code (57). Figure 1 of Tsuji, reproduced below, "shows the basic configuration of the support device in the deployed state (with the second frame lowered relative to the first frame)." *Id.* ¶ 15.



As shown in Tsuji's Figure 1, the support device comprises a first frame 1 attached to a vertical structure (such as a wall or pillar), and a second frame 2 mounted to support a display at the back of the display. *Id.* ¶ 16, 18. One end of hydraulic cylinder 4 is axially supported at the upper end of the right column 1a that constitutes first frame 1, and the other end of the hydraulic cylinder 4 is also axially supported on the rotational free end side away from the axial support point of the right column 1a in the lower link arm 3b. *Id.* ¶ 22.

3. Analysis of Independent Claim 33

Petitioner provides a limitation-by-limitation explanation showing how, in Petitioner's view, Clary and Tsuji disclose every limitation of independent claim 33. Pet. 60–109.

a) *“A television mounting system comprising:”*

Petitioner asserts that “[t]o the extent the preamble is limiting, Clary discloses such a television mounting system.” Pet. 60 ((citing Ex.1004, 12, 18 (“the wall frame 1”); Ex. 1003 ¶¶ 107–108). At this stage of the proceeding, Patent Owner has not disputed this assertion. On the record before us, Petitioner has sufficiently shown that Clary discloses this limitation for purposes of institution.

b) *“a support bracket configured to couple to a wall;”*

Petitioner asserts that Clary discloses “a support bracket configured to couple to a wall.” Pet. 60–61. At this stage of the proceeding, Patent Owner has not disputed this assertion. On the record before us, Petitioner has sufficiently shown that Clary discloses this limitation.

c) *“a display bracket configured to hold a television;”*

Petitioner asserts that Clary discloses “a display bracket configured to hold a television.” Pet. 61–62. At this stage of the proceeding, Patent Owner has not disputed this assertion. On the record before us, Petitioner has sufficiently shown that Clary discloses this limitation.

d) *“an arm assembly pivotally coupled to the support bracket and movable between a raised configuration to position the display bracket at a raised position and a lowered configuration to position the display bracket at a lowered position”*

Petitioner asserts that Clary discloses this limitation. Pet. 63–67. At this stage of the proceeding, Patent Owner has not disputed this assertion. On the record before us, Petitioner has sufficiently shown that Clary discloses this limitation.

e) *“wherein the arm assembly includes an upper arm and a lower arm;”*

Petitioner asserts that Clary discloses this limitation. Pet. 68–69. At this stage of the proceeding, Patent Owner has not disputed this assertion. On the record before us, Petitioner has sufficiently limitation.

f) *“a motorized actuator assembly having a support bracket end rotatably coupled to the support bracket and a display bracket end rotatably coupled to the arm assembly, wherein at least a portion of the motorized actuator assembly moves toward and past a portion of the lower arm when the arm assembly moves toward the raised configuration.”*

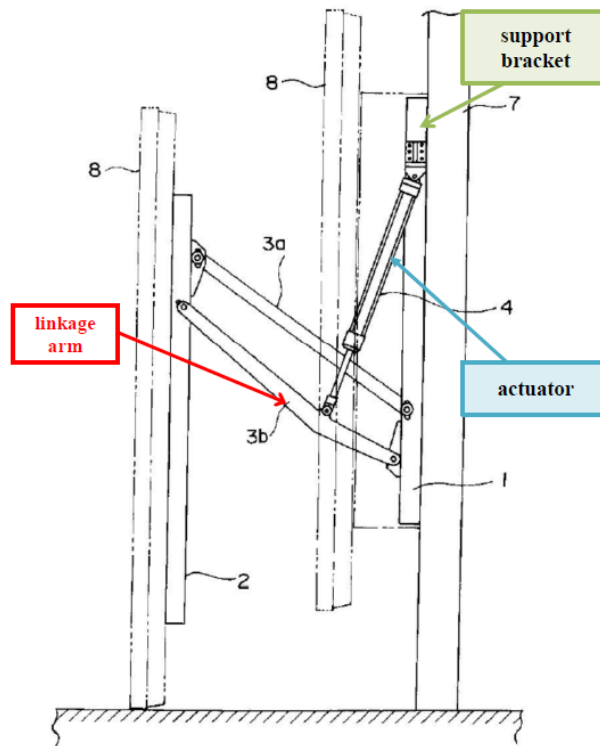
Clary discloses a manually operated mounting system. Ex. 1004, ¶ 4 (disclosing a system “allowing for manual movement of the flat panel display upward and downward”). Clary also discloses, however, that the mounting system can be motorized for automatic, or remote control, operation. Pet. 92–93; Ex. 1004. at ¶ 5 (“A linear drive can also be provided between the first and second frame assemblies to allow for automatic lowering and lifting of the flat panel display.”); ¶ 17 (“a linear actuator can be provided for articulating the display mount. . . . A remote control (not shown) may be used to actuate the linear actuator.”).

Petitioner asserts that “[t]o the extent Clary somehow fails to disclose the actuator assembly having a display bracket end rotatably coupled to the arm assembly, it would have been obvious, based on Tsuji, to rotatably couple Clary’s actuator assembly directly to one of the arms of the arm assembly.” Pet. 94 (citing Ex. 1003 ¶ 139) (emphasis omitted).³ Petitioner contends that “Tsuji discloses an actuator assembly 4 that is directly

³ Petitioner also asserts that Juan (Ex. 1005) and Pankos, as representative of prior known systems, “also disclose[] a mounting system with a motorized actuator assembly which is attached to the arms of the arm assembly.” Pet. 95–98.

rotatably coupled at one end to a linkage arm 3b and to the support bracket 1 at the other end, as shown below in annotated Figure 4.” *Id.* (citing Ex. 1015 ¶¶ 22, 23).

Petitioner’s annotated version of Figure 4 of Tsuji is reproduced below.



As to why a person of ordinary skill would have modified Clary based on Tsuji, Petitioner asserts “rotatably coupling the actuator assembly directly to a linkage arm instead of a bracket or other intervening part would have been a mere design choice from a finite number of options.” Pet. 98 (citing Ex. 1003 ¶ 142). Petitioner also asserts that “in a four-bar linkage system like Clary, there are only a few options for coupling the actuator.” *Id.* If one end of the actuator assembly is coupled to the support bracket, then the other end of the actuator assembly can be coupled to a linkage arm or the display bracket. Pet. 98 (citing Ex. 1003 ¶ 142).

Additionally, Petitioner asserts a person of ordinary skill:

would have been motivated to directly rotatably couple the actuator assembly to an arm of the arm assembly because this could reduce the number of parts and provide direct force from the actuator to the arm assembly which causes the display bracket to move. This configuration would simplify the design by reducing part count resulting in reduced inventory, assembly and inspection costs. Such a modification could also allow for a shorter actuator.

Pet. 99 (citing Ex. 1003 ¶ 142).

Patent Owner takes a different view of the evidence. Patent Owner contends:

A POSITA would not be motivated to modify Clary based on Tsuji to arrive at claims 33–36 because coupling Clary’s actuator 11 to link 5 or 6 of Clary in a manner similar to Tsuji’s hydraulic cylinder 4 (i.e., extending upward from a lower arm to an upper end of a frame 1) would place the actuator 11 in the same plane of motion as the lower arm link, resulting in the link blocking the actuator from passing, and vice versa, when moving the arm assembly toward a raised position. A POSITA would recognize that this would prevent the flat panel display screen from being “positioned flat against the wall frame 1” as shown in Figure 3 of Clary. (citing Ex. 1004, [0018]).

Prelim. Resp. 46 (citing Ex. 2004 ¶¶ 52–54). We disagree, based on the record before us. We have not been directed to any persuasive evidence that the proposed combination necessarily results in “the link blocking the actuator from passing,” as asserted by Patent Owner.

Moreover, *KSR* does not require that a combination only unite old elements without changing their respective functions. *KSR*, 550 U.S. at 416. Instead, *KSR* teaches that “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 421. Here, the level of skill is high – a degreed engineer in a relevant field with at least 2 years of

experience in the field of mechanical design or relevant product design experience. *KSR* also explains that the ordinary artisan recognizes “that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 420. *KSR* does not support a theory that a person of ordinary skill can only perform combinations of a puzzle element A with a perfectly fitting puzzle element B. *ClassCo, Inc. v. Apple, Inc.*, 838 F.3d 1214, 1219 (Fed. Cir. 2016).

IV. REMAINING GROUNDS

Because Petitioner meets the threshold for institution by demonstrating that at least one challenged claim is more likely than not to be unpatentable as obvious over the combination of Clary and Tsuji, we do not decide Petitioner’s other challenges. Those challenges, in our view, are best left for trial after full development of the record.

V. 35 U.S.C. § 325(d) DISCRETION

Patent Owner argues, *inter alia*, that we should exercise our discretion to deny institution “because Petitioner relies on some of the very same references that were already considered by the examiner.” Prelim. Resp. 61. According to Patent Owner, “Grounds 3–6 are based on primary references Clary and Pankros [that] were considered by the examiner during prosecution.” *Id.* at 62.

A. Legal Standard

We have discretion to deny review when “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). In that respect, section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based

on matters previously presented to the Office. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

In evaluating the exercise of discretion to deny institution under § 325(d), the Board applies a two-part framework: (1) first, we determine 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 condition of the first part of the framework is satisfied, we examine whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Id.* at 8.

In applying the two-part framework, we consider several nonexclusive 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) (“*Becton, Dickinson*”). Factors (a), (b), and (d) of the *Becton, Dickinson* factors relate to whether the art or arguments presented in the petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. “If, after review of Factors (a), (b), and (d), it is determined 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 has demonstrated a material error by the Office.” *Id.*

B. Advanced Bionics Step 1: Factors (a), (b), and (d)

There is no assertion that Tsuji was before the Examiner during prosecution. Patent Owner argues that “Tsuji and Xu are cumulative of the art of record or do not cure the deficiencies of the already considered art.” Prelim. Resp 62. However, apart from this conclusory statement, Patent Owner does not make any effort to explain *how* Tsuji is cumulative of the art of record. Accordingly, we are not persuaded that Tsuji was previously presented to the Office. Because Tsuji was not previously presented to the Office, we need not consider step 2 of *Advanced Bionics* as to Ground 4.

For the reasons set forth above, we conclude that the circumstances of this case, on the record presented, do not warrant exercise of our discretion to deny institution based on § 325(d).

VI. CONCLUSION

We have determined that it is more likely than not that Petitioner will prevail on at least one challenged claim. Accordingly, we institute a post-grant review on all challenged claims on each asserted ground. A decision to institute is “a simple yes-or-no institution choice respecting a petition,

embracing all challenges included in the petition.” *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018).

Our review of the Petition under 35 U.S.C. § 324 is not to determine whether an individual asserted fact is indisputable or whether a preponderance of the evidence supports Petitioner. Our review is to determine whether the totality of the information presented in the Petition and Preliminary Response shows that it is more likely than not that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. This standard is a somewhat flexible standard that allows the Board room to exercise judgment. Patent Trial and Appeal Board Consolidated Trial Practice Guide at 53 (Nov. 2019).⁴

This is a decision to institute a post-grant review under 35 U.S.C. § 324. Our determinations at this stage of the proceeding are preliminary, and based on the evidentiary record developed thus far. This is not a final decision as to the patentability of claims for which post-grant review is instituted. Any final decision will be based on the record as fully developed during trial, including all arguments and evidence in the Patent Owner’s Response,⁵ or submitted otherwise during trial, as permitted by our rules.

VII. ORDER

Upon consideration of the record before us, it is:

⁴ available at

<https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

⁵ See *In re Nuvasive, Inc.*, 842 F.3d 1376, 1381 (Fed. Cir. 2016) (explaining that a patent owner waives an issue presented in its preliminary response if it fails to renew the issue in its response after trial is instituted).

ORDERED that, pursuant to 35 U.S.C. § 324(a), post-grant review is instituted as to claims 33–36 of the '703 patent on each ground set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 324(c) and 37 C.F.R. § 42.4(b), post-grant review of the '703 patent shall commence on the entry date of this Decision, and notice is hereby given of the institution of a trial.

PGR2024-00014
Patent 11,781,703 B2

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