

**UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT TRIAL AND APPEAL BOARD**

Camel Manufacturing Company, LLC

Petitioner,

v.

DLX Enterprises, LLC,

Patent Owner.

Case No. PGR2024-_____

U.S. Patent No. 11,732,496

PETITION FOR POST-GRANT REVIEW

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I. INTRODUCTION

Pursuant to 35 U.S.C. Section 322 and 37 C.F.R. Section 42.208, Petitioner, Camel Manufacturing Company, LLC (“Petitioner”) respectfully submits this Petition for Post-Grant Review (Paper No. 1) (“the Petition”) of claims 1-20 (“the Challenged Claims”) of U.S. Patent No. 11,732,496 (“the ‘496 Patent,” (Ex. 1001) owned by DLX Enterprises, LLC (“Patent Owner” or “DLX”).

Claims 1 through 20 of the ‘496 Patent are invalid over the on-sale bar of Section 102 and the public use bar of Section 102. Well prior to the effective filing date of the ‘496 Patent, Petitioner designed, manufactured, and sold products embodied by the Challenged Claims. Additionally, well prior to the effective filing date, Petitioner publicly displayed a product embodying the Challenged Claims. The claims are therefore invalid.

II. MANDATORY NOTICES

A. Real Party-In-Interest

The real parties-in-interest are:

1. Petitioner:

Camel Manufacturing Company, LLC, d/b/a Camel Expeditionary, a limited liability company formed under the laws of the State of North Carolina and having a principal place of business at 176 Luther Seiber Blvd., Pioneer, Tennessee.

2. Patent Owner:

DLX Enterprises, LLC, d/b/a Deployed Logix, a limited liability company

formed under the laws of the State of Oregon and having a principal office at 1075 Arrowsmith St., Eugene, Oregon.

3. Related Matters

There are no related matters.

B. Lead and Back-Up Counsel

Petitioner provides the following designation and service information for lead and back-up counsel. 37 C.F.R. § 42.8(b)(3) and (b)(4).

Lead Counsel	Back-Up Counsel
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Please address all correspondence to lead and back-up counsel. Petitioner consents to electronic service via email.

III. GROUNDS FOR STANDING

All claims in the '496 Patent have an effective filing date after March 15,

2013, so the American Invents Act applies. The ‘496 Patent issued on February 22, 2024. This Petition, therefore, is filed within nine months of issue and complies with 35 U.S.C. Section 321(c) and 37 C.F.R. Section 42.202.

Petitioner is not the owner of the ‘496 Patent, has not been sued for infringement of the ‘496 Patent, and has not requested a declaratory judgment of invalidity of the ‘496 Patent. This Petition therefore qualifies under 37 C.F.R. Section 42.201(a).

Petitioner is unaware of the same or substantially the same prior art or arguments having been presented previously to the Patent Office. Petitioner is not estopped from challenging the claims on the grounds identified in this Petition. This Petition therefore also qualifies under 37 C.F.R. Section 42.201(b).

Patent Owner sells a tent that it calls, on its website, an ASAP-HUB[®] SHELTER SYSTEM. Patent Owner asserts that this tent is covered by the ‘496 Patent. *See*, for example, Patent Owner’s Product Sheet, Ex. 1003, available on Patent Owner’s website at <https://deployedlogix.com/product/asap-hub/>. *See* Declaration of Timothy M. McCarthy, Ex. 1004.

Petitioner designs, manufactures, and sells shelters to Patent Owner and in competition with Patent Owner, including but not limited to “hub” shelters. Declaration of Mark Riffle, Ex. 1005, at ¶¶ 5, 15.

Patent Owner, through its counsel, sent a cease-and-desist letter to Western

Shelter, a customer of Petitioner. *See* Ex. 1006. In that letter, Patent Owner’s attorneys alleged that the shelters that Petitioner proposed to sell to Western Shelter violate Patent Owner’s intellectual property rights. One of the alleged intellectual property rights Patent Owner’s counsel claimed (by attachment to the letter) is the ‘496 Patent. Counsel for Patent Owner, by asserting that United States patent law provides for treble damages and attorney’s fees for intentional infringement, impliedly threatened Western Shelter with patent infringement litigation. This threat tends to affect the seller-customer relationship between Petitioner and Western Shelter and creates a substantial controversy between Petitioner and Patent Owner.

Please note that this Exhibit is not offered to prove the truth of the matter asserted in the letter: that Petitioner’s products infringed Patent Owner’s intellectual property. Petitioner disputes the truth of this allegation and submits the Exhibit to show that a threat was made.

Petitioner reasonably believes that it is damaged by its customers’ reluctance to purchase products that purportedly infringe someone else’s patent or patents.

IV. THE ‘496 PATENT

A. Overview of the ‘496 Patent

The ‘496 Patent claims a “hub shelter.” A shelter is the same as a tent; the term “hub shelter,” in the context of the ‘496 Patent, is a central shelter to which other shelters can be attached to radiate outward from the central shelter.

The '496 Patent is a continuation-in-part of an earlier patent. The effective filing date for the claims of the '496 Patent is no earlier than April 28, 2020, and is later than that date as will be explained in greater detail. The chain of patents is as follows:

1. **The provisional patent application:** Patent Owner filed United States Provisional Application No. 62/356,793 on June 30, 2016 (Ex. 1007). This provisional contained no subject matter claimed in the '496 Patent.
2. **The original non-provisional patent application:** United States Patent Application No. 15/639,261 was filed on June 30, 2017 and issued as United States Patent No. 10,309,093 (Ex. 1008), and claims priority to the '793 Provisional Application.
3. **The first continuation application:** United States Patent Application No. 16/431,322, a continuation application, was filed on June 4, 2019 and issued as United States Patent No. 10,941,559 (Ex. 1009). Please note that this patent contains Figures 1 through 15G.
4. **The first continuation-in-part application:** United States Patent Application No. 16/861,012 (together with its prosecution history, Ex. 1010), a continuation-in-part application, was filed on April 28, 2020 and issued as United States Patent No. 11,280,107 (Ex. 1011).
5. **The second continuation-in-part application:** United States Patent Application No. 17/677,210 (together with its prosecution

history, Ex. 1012) was filed as a continuation application on February 22, 2022 but was amended to be a continuation-in-part application, as will be explained in greater detail below. This application issued as United States Patent No. 11,898,366 (Ex. 1013).

6. **The third continuation-in-part application (the patent under review):** United States Patent Application No. 17/886,132 (Ex. 1002) was filed as a continuation-in-part application on August 11, 2022 and issued as the ‘496 Patent (Ex. 1001).

B. The effective filing date of the claims of the ‘496 Patent is August 11, 2022.

The subject matter of the ‘496 Patent’s claims did not appear in the original provisional patent application (Ex. 1007), in the original non-provisional application (which became the ‘093 Patent, Ex. 1008), or in the first continuation patent application (which became the ‘559 Patent, Ex. 1009). Instead, every element recited in each claim that issued in the ‘496 Patent is based on general disclosures first made in the filing of the ‘012 Application (Ex. 1010) on April 28, 2020; but such subject matter was not described in detail until the filing of the ‘132 Application (Ex. 1002) on August 11, 2022. The effective filing date is, therefore, no earlier than April 28, 2020, but more exactly August 11, 2022.

C. Prosecution History of the ‘496 Patent

The provisional application states that it relates to “hub systems for shelters.” A “hub,” as that term is used in the provisional application, included “at least one receiver slot 12, a receiver sleeve 20, and at least one attachment projection 30.” (Ex. 1007 at pg. 6, lns. 20-22.) A “hub,” then, as defined and used in the provisional application and in the first several nonprovisional applications in the patent family, is a connector piece for portions of a tent frame, a far different meaning than a “hub” as used later in the patent family.

The first nonprovisional application and the first continuation application claimed a “hub” in this sense, as a connector piece for structural frame portions. (Exs. 1008 and 1009).

The first continuation-in-part application introduced the concept of a “hub” as a system of shelters in which there is a central shelter (*i.e.*, the “hub shelter”) with connected shelters (*i.e.*, non-“hub” shelters) radiating outwards. (Ex. 1010). For example, this continuation-in-part application added Figures 18, 19, 20A, 20B, and 20C. The specification also added this language:

The rapid-deployment shelter system may include more than one shelter. The rapid-deployment shelter system may include more than one shelter mated with other rapid-deployment shelters. A shelter hub may interconnect more than one rapid-deployment shelter.

See Ex. 1010 at pg. 4, lns. 9-12.

The continuation-in-part application also amended the specification by adding this language:

Joined shelters may be considered shelter systems 170 including more than one shelter joined at a matched face 100 and include any of the embodiments and features included in the present disclosure. Some shelters 50 may serve as a shelter hub 150 and include scalability of connectivity between two or more shelters.

See Ex. 1010 at pg. 9, lns. 19-23.

The first continuation-in-part application, then, uses the term “hub” in the sense of joined shelter systems. For example, Figure 20B shows a central hub shelter (150) with four non-hub shelters (50) radiating outwards:

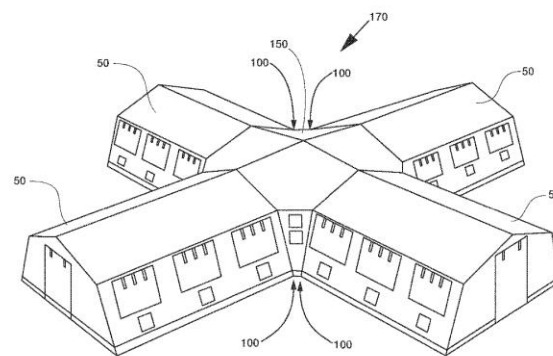


FIG. 20B

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All the claims of the ‘496 Patent recite a “hub shelter.” Both independent

claims, claims 1 and 15, recite “A rapid-deployment hub shelter comprising” (Ex. 1002 at pg. 39). For purposes of the ‘496 Patent, a “hub shelter” should be construed as a central shelter to which other shelters can be attached to radiate outward from the central shelter.

Since the concept of a “hub” as a system of shelters in which there is a central shelter with connected shelters radiating outwards was first submitted with Patent Owner’s first continuation-in-part application (Ex. 1010), all claims relating to a “hub shelter” have an effective filing date, at the earliest, of April 28, 2020, the filing date of that first continuation-in-part application.

Please note, however, that the first continuation-in-part application did not describe the hub shelter in detail. Further amendments were made by further continuation-in-part applications.

United States Patent Application No. 17/677,210 (together with its prosecution history, Ex. 1012) was filed on February 22, 2022 as a continuation-in-part application. This application added the following language to the specification (among other changes):

The frame 72 may include corners 112 formed by lower frame poles 52c, 52d, from differing shelter sides, and a shoulder support 52e. Shoulder support 52e may extend linearly between the lower frame poles 52c, 52d.

See Ex. 1012 at pg. 82.

Patent Owner next filed United States Patent Application No. 17/886,132 (Ex. 1002) on August 11, 2022. This Application Data Sheet (pgs. 310-18) improperly asserted that the application was a continuation of U.S. Application No. 17/677210 (which is Ex. 1012). See Application Data Sheet, Domestic Benefit/National Stage Information, Ex. 1002 at pg. 312.

The Examiner, in a first Office Action dated April 25, 2023 (Ex. 1002 at pg. 113-20), objected to calling the application a “continuation,” because, among other things, the specification had added Fig. 19A and its description. The Examiner required that a corrected Application Data Sheet be submitted. Ex. 1002 at pg. 115.

Patent Owner then submitted an amended Application Data Sheet, noting that the application was a continuation-in-part of the ‘210 Application. Ex. 1002 at pg. 43.

Besides the addition of Figure 19A, the application also added the following language:

FIGS. 19 and 19A show one example of a frame of hub shelter 150 for supporting the shelter. The frame 72 may include a frame front end 172a, a frame back end 172d, a frame side 172b, and a frame opposite side 172c. The frame 72 may in this example be a four-sided shelter frame including frame corners 112a offset between each of the shelter sides,

frame ends. The frame configuration, in some examples, may be the same on each of the frame front end, the frame back end, the frame side, and/or the frame opposite end. The frame front end 172a, frame back end 172d, frame side 172b and frame opposite side 172c may each include a first upper frame pole 52a and a second upper frame pole 52b. The first upper frame pole 52a and the second upper frame pole 52b may be joined at peak 152. Each end and side may include a peak 152. The frame may include a first leg pole 52c supporting the first upper frame pole and a second leg pole 52d supporting the second upper frame pole. There may be a shoulder 153 formed between each upper frame pole and each attaching leg pole and a shoulder 153 formed between each second upper frame pole and each attaching second leg pole. A center frame assembly 174 may include a set of extension poles 52e that extend outwardly from a center point of the center frame assembly to one of the frame peaks 152. A frame corner 112a may be formed between the frame front end 172a and each of the frame sides 172b, 172c, and the frame opposite side 172d. A frame corner 112a may be formed between the frame back end 172d and each of the frame side 172b, and the frame opposite side 172c.

A shoulder support 176 may extend between adjacent shoulders 153 of each corner 112a. The frame corners 112a may be offset from the frame sides. The frame corners 112a may, as shown, have a face that extends in a different plane than a plane formed by the face of the frame ends or sides 172. The frame corners may include a shoulder support 176 and two frame legs 52. The legs 52 may be, in some instances, a leg from a frame side and a leg from a frame end.

Supports 178 may be located, by way of example, between an extension pole 52e and either a frame front, frame back, frame side, or frame opposite side. Supports 178 may extend to an upper frame pole 52a or a second upper frame pole 52b.

Frame legs may extend from a shoulder 153 downward toward a footing 179 that supports the leg on a ground surface. Legs forming a corner 112a may angle toward one another and meet at a ground surface. Legs 5c, 5d may be distanced apart by a shoulder support 176 at a distance greater than they are from one another at the footings 179. The frame corner 112a may space apart a frame end and a frame side. Each frame end and each frame side may be flanked by a frame corner 112a. The

frame poles 52 may be articulating frame poles that move about an axis joint where one pole attaches to another pole.

Ex. 1002 at pg. 67, ln. 9 to pg. 68, ln. 7.

This submission added descriptions for, at least, the following elements:

- frame front end 172a
- frame back end 172d
- frame opposite side 172c
- leg poles 52c, 52d
- shoulder 153
- center frame assembly 174
- extension poles 52e
- corner 112

These elements, then, have an effective filing date of August 11, 2022, the filing date of the ‘132 Application (Ex. 1002) that issued as the ‘496 Patent (Ex. 1001). Before August 11, 2022, Petitioner had sold 279 tents embodying the claims of the ‘496 Patent to Patent Owner.

V. CLAIM CONSTRUCTION

In a post-grant review proceeding, a claim of a patent should be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. Section 282(b), including construing 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.
37 C.F.R. Section 42.200.

There are no prior decisions construing the claims of the '496 Patent to the knowledge of Petitioner.

The claims of the '496 Patent should be construed as follows:

US Patent No. 11,732,496	Claim construction
rapid deployment	Can be erected quickly
hub shelter	A central shelter to which other shelters can be attached to radiate outward from the central shelter
frame	Structure that creates or defines a space
frame front end	No construction needed; plain and ordinary meaning applies.
frame back end	
frame side	
frame opposite side	
pole	No construction needed; plain and ordinary meaning applies.
upper frame pole	A pole forming the two upper portions of a quadrangular side of a hub shelter

US Patent No. 11,732,496	Claim construction
peak	No construction needed; plain and ordinary meaning applies.
leg pole	A pole connecting an upper frame pole of a hub shelter to the ground
shoulder	A connector between an upper frame pole and a leg pole
center frame assembly	A center point and a set of poles extending outwardly from it
corner	The connection point between the leg poles of a hub shelter
frame peak	The highest point of a frame side
shoulder support	A pole extending between adjacent shoulders of a hub shelter
trapezoidal	No construction needed; plain and ordinary meaning applies.
leg	Same as a “leg pole”
support	No construction needed; plain and ordinary meaning applies.

US Patent No. 11,732,496	Claim construction
opening	No construction needed; plain and ordinary meaning applies.
offset	Not in the same plane
angle alpha a	An angle formed by two poles
adjacent	Next to
footer	A structure that supports a leg pole on a ground surface
collapsing position	No construction needed; plain and ordinary meaning applies.
deployed position	No construction needed; plain and ordinary meaning applies.

The claim constructions are based on how the terms are used in the ‘496 Patent. The source for each term of the claims of the ‘496 Patent can be found in the attached Ex. 1014, which identifies the corresponding element number for each claim term and identifies where in the ‘496 Patent the term is used.

VI. PERSON OF ORDINARY SKILL IN THE ART

The person of ordinary skill in the art is a person with mechanical aptitude and at least five years’ experience in mechanical design.

VII. RELIEF REQUESTED AND THE REASONS FOR THE REQUESTED RELIEF

Petitioner requests that the Board find all claims of ‘496 Patent to be unpatentable as invalid under 35 U.S. Code Section 102 and that the Office issue and publish a certificate canceling all claims of the ‘496 Patent.

A. IDENTIFICATION OF GROUNDS

This Petition challenges the patentability of all claims 1-20 of the ‘496 Patent (“the Challenged Claims”) as follows:

Ground	Claims	Basis	Prior Art
On-sale bar	1-20	35 U.S.C. § 102(a)(1)	Sales by Petitioner to Patent Owner
Public use	1-20	35 U.S.C. § 102(a)(1)	Public use by Petitioner and Patent Owner

VIII. THE BOARD SHOULD INSTITUTE POST-GRANT REVIEW

A. The grounds presented in this Petition are not cumulative to prosecution of the ‘496 Patent

The Examiner never raised a Section 102(a)(1) objection during prosecution. Indeed, the Examiner would not have known that the claims that Patent Owner was seeking related to, were based upon, and were for a tent that had been designed and sold by Petitioner well before the effective filing date.

B. No parallel litigation

There is no parallel litigation.

IX. IDENTIFICATION OF HOW THE CLAIMS ARE UNPATENTABLE

The claims are unpatentable because products designed, manufactured, and sold by Petitioner were on sale and in public use prior to the effective filing date of the claims of the '496 Patent. As will be explained in the following subsection, by April 28, 2020, the earliest effective filing date to which Patent Owner is entitled, Petitioner had sold approximately 122 tents to Patent Owner, which tents embodied the claims of the '496 Patent.

A. Petitioner designed, manufactured, and sold tents to Patent Owner before April 28, 2020.

Scott Campbell, Program Manager for Petitioner and designer of new products, met with Mr. J.J. Urhausen, CEO of Patent Owner, prior to June 15, 2017. At that time, Mr. Urhausen related that his company wanted “an ASAP-style” tent. *See Declaration of Scott Campbell, Ex. 1015, at ¶ 6.*

An “ASAP-style tent” was known in the industry long before April 28, 2020, and refers to a generally rectangular tent with sloping side walls and end walls in a quadrangular shape. (Ex. 1015 at ¶ 5) The end walls are perpendicular to the ground when the ASAP tent is erected. An example of an ASAP-style tent can be found on the DLX website at <https://deployedlogix.com/asap-rapid-shelter-systems/> (Ex. 1015 at ¶ 5):



Mr. Campbell designed and prepared a two-window, three-bay skin for that style of tent. Mr. Urhausen then asked that Mr. Campbell develop a connector to join three or four ASAP tents. Mr. Campbell did so and developed a design for what Petitioner called a “hub tent.” Petitioner called it a “hub” tent because it had the capability to connect to four ASAP tents. (Ex. 1015 at ¶ 7)

Mr. Campbell then sent a conceptual design to Mr. Urhausen by email dated June 15, 2017 (Ex. 1016 at ¶ 1). This email attached some very rough sketches of the proposed hub tent. The first attachment, Exhibit 1016 pg. 2, shows a hub tent, with a skin on it, and three ASAP-style tents radiating outward from the hub tent. The second attachment, Exhibit 1016 pg. 3, shows a hub tent, with a skin on it, and four ASAP-style tents radiating outward from the hub tent. The third attachment, Exhibit 1016 pg. 3, is Mr. Campbell’s basic concept of the frame for the hub tent.

Mr. Urhausen was pleased with the conceptual design and asked, by return email the same day, when he could get a prototype. (Ex. 1015 ¶ 14 and Ex. 1016

pg. 5) Mr. Urhausen had prospective customers for the hub shelter and was prepared to buy demo units immediately. (*Id.*) Petitioner then prepared a prototype, which Mr. Urhausen thought was “awesome.” (Ex. 1015 ¶¶ 15-16 and Ex. 1016 pgs. 7-8) The photographs of the prototype are in Exhibit 1016, pgs. 9-14.

Petitioner’s drawings labeled “Pioneer Hub Assembly” and containing the Drawing Number PHB-000_CMC are submitted as Exhibit 1018. These drawings were prepared by Kevin Brown, who was, at the time, an engineer employed by Petitioner. (Ex. 1015 at ¶ 25-27)

An employee of Petitioner prepared these drawings, in the scope of that employee’s employment with Petitioner. The drawings were prepared at or near the date shown on the drawings. The drawings are stored and retrievable within Petitioner’s office. These drawings were kept in the ordinary course of business of Petitioner’s manufacturing operations, and it was a regular practice of Petitioner to create those drawings. (*Id.*)

The drawings attached as Exhibit 1017 show the design of all the Pioneer Hub tents that Petitioner manufactured and sold to Patent Owner. The Alliance Hub tents that Petitioner manufactured and sold to Patent Owner had the same design except the dimension were larger. (Ex. 1015 at ¶ 27)

Petitioner sold approximately 122 tents to Patent Owner before April 28, 2020. Petitioner issues invoices upon the sale of products to a customer, upon the

shipment of the products. Invoices for sales to Patent Owner were prepared at or near the time of the sale of the tents referred to in the invoices, by someone with knowledge of the sale or from information transmitted by someone with knowledge of the sale. Those invoices were prepared and kept in Petitioner's regular course of business. It was Petitioner's regular practice to prepare and maintain these invoices. Declaration of Crystal Young, Ex. 1021, at ¶¶ 5-9.

The number of underlying invoices is large. Petitioner accordingly offers the summary table, Ex. 1019, to prove the contents of the invoices. *See* Federal Rule of Evidence 1006. (Please note that Petitioner offers the invoices only to show that sales were made, not to prove the dollar amounts of the sales.) Petitioner will make copies of these invoices (which are saved electronically) available for examination or copying by Patent Owner.

Attached as Ex. 1019 is a spreadsheet showing all sales by Petitioner to Patent Owner of Alliance and Pioneer hub tents. *See* Declaration of D. Mercer, Ex. 1020, at ¶ 10.

All the sales shown in Ex. 1019 were based on Mr. Campbell's design. (Ex. 1015 at ¶ 27). There were no obligations of confidentiality with respect to the sales or manufacture of these tents.

B. Petitioner publicly displayed a tent prior to April 28, 2020

At the request of Patent Owner, Petitioner brought an ASAP-style hub tent to

an exhibition in North Carolina in approximately November of 2017. Petitioner's employees erected the hub tent and attached three ASAP tents to it. (Ex. 1015 at ¶ 20) Here is what it looked like at the exhibition (Ex. 1015 ¶¶ 20-21):



The exhibition was meant for first responders, but anyone at the exhibition could see Petitioner's tent. (*Id.* at ¶ 21). In fact, many members of the public (not affiliated with Patent Owner or Petitioner) attended; indeed, the photograph shows a dozen people standing by the tent.

C. The tents sold to Patent Owner anticipate the claims of the '496 Patent

Every claim of the '496 Patent is anticipated by the tents designed, manufactured, sold, and displayed by Petitioner (referred to hereinafter as "the

Publicly Sold Tents”). See Report of Professor S. Adanur, Ex. 1022, at ¶¶ 11-12.

Professor Adanur’s qualifications are set forth in detail in Paragraphs 1 through 5 of his Report, Ex. 1022. Among other qualifications, he has a Bachelor of Science degree in Mechanical Engineering from Istanbul Technical University, Istanbul, Turkey, and both a Master of Science (“M.S.”) degree in Textile Engineering and Science, and a Ph.D. degree in Fiber and Polymer Science, from North Carolina State University in Raleigh, N.C.

He is a Professor at Auburn University (“Auburn”), in Auburn, Alabama, in the Departments of Textile Engineering, Polymer and Fiber Engineering and Mechanical Engineering. He teaches courses such as Kinematics and Dynamics (MECH 2140) to undergraduate students and Polymer Processing (MECH 5520/PFEN 6200) and Engineered Fibrous Structures (MECH 5320) to graduate students. Both of these classes involve design and/or manufacture of fibers, yarns, fabrics, fabric structures and textile machinery and equipment.

He is the author of Wellington Sears Handbook of Industrial Textiles (Routledge 1995) (ASIN 1566763401), in which tent and shelter structures are covered in Chapter 6, Architectural and Construction Textiles.

Please note that the Section 102(b) on-sale bar requires the device sold “fully anticipated the claimed invention or would have rendered the claimed invention obvious by its addition to the prior art.” *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192

F.3d 1353, 1358 (Fed. Cir. 1999)). Notably, “Section 102(b) does not require a strict identity between the claimed invention and the device involved in the public use or on sale activities.” *In re Smith*, 714 F.2d 1127, 1137 n. 13 (Fed. Cir. 1983). In this matter, however, there is, indeed, identity.

D. Ground No. 1: Claims 1-20 are invalid under 35 U.S.C. § 102(a)(1) as being subject to the on-sale bar

1. The tents were sold by Petitioner to Patent Owner

Petitioner sold tents embodying the claims of the ‘496 Patent to Patent Owner. Patent Owner requested the Publicly Sold Tents by purchase order, Petitioner manufactured and sold them, and Patent Owner received them and paid for them. There was, therefore, an offer, acceptance, performance, and consideration.

Contract law and commercial law principles apply to determine whether a commercial sale or offer for sale occurred. *Medicines Co. v. Hospira, Inc.*, 827 F.3d 1363, 1373, 119 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2016) (*en banc*). Section 2-106(1) of the Uniform Commercial Code describes a “sale” as “the passing of title from the seller to the buyer for a price.” U.C.C. § 2-106(1) (AM. LAW INST. & UNIF. LAW COMM’N 1977). The passage of title indicates that a product is “on sale.” A “sale” occurs when the parties give and “pass rights of property for consideration.” *Medicines*, 827 F.3d. at 1375. *See also In re Caveney*, 761 F.2d 671, 676, 226 U.S.P.Q. 1, 4 (Fed. Cir. 1985) (“It is well settled that a sale is a contract between parties to give and to pass rights of property for consideration which the buyer pays

or promises to pay the seller for the thing bought or sold.”).

The transaction at issue here was undisputedly a “sale” in a commercial law sense.

2. Section 102 bars patentability of claims

The American Inventors Act version of 35 U.S.C. 102 took effect on March 16, 2013. AIA Section 102 applies to any patent application that contains or contained at any time a claim to a claimed invention that has an effective filing date that is on or after March 16, 2013. Patent Owner’s earliest filing date is the provisional application (Ex. 1007) filed on June 30, 2016. Accordingly, AIA Section 102 applies to this matter.

AIA Section 102 states in pertinent part:

(a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

- (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention;

35 U.S.C. § 102(a)(1).

The on-sale bar is a mechanism that renders a patent invalid when certain requirements are satisfied. *See Robotic Vision Sys., Inc. v. View Eng'g, Inc.*, 249 F.3d 1307, 1313 (Fed. Cir. 2001). On-sale activity will bar patentability if the claimed invention was: (1) the subject of a commercial sale or offer for sale, not

primarily for experimental purposes; and (2) ready for patenting. *See Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67, 119 S. Ct. 304, 142 L. Ed. 2d 261, 48 U.S.P.Q.2d 1641, 1646-47 (1998).

In this matter, the tents were not merely the subject of an offer for sale, the tents were actually sold. Hundreds of them!

Additionally, the tents were ready for patenting. Patent Owner applied for and obtained a patent on the tents, so it cannot be disputed that the tents were ready for patenting.

Finally, we address whether the invention was ready for patenting as of the critical date of April 28, 2020. There are at least two ways in which an invention can be shown to be ready for patenting: “by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.” *Pfaff*, 525 U.S. at 67–68; *Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc.*, 855 F.3d 1356, 1371 (Fed. Cir. 2017), *aff’d*, 586 U.S. 123, 139 S. Ct. 628, 202 L. Ed. 2d 551 (2019).

The present matter meets both tests. The tents were clearly reduced to practice. An invention is reduced to practice when the inventor constructs an embodiment that met all the limitations and determines that the invention would work for its intended purpose. *In re Omeprazole Patent Litig.*, 536 F.3d 1361, 1373

(Fed. Cir. 2008) (citing *Z4 Techs., Inc. v. Microsoft Corp.*, 507 F.3d 1340, 1352 (Fed. Cir. 2007)). As Petitioner manufactured and sold the tents, it constructed numerous embodiments that meet all the limitations of the ‘496 Patent and work for their intended purpose.

Petitioner also has drawings sufficiently specific to enable a person of skill in the art to practice the invention. *See* Ex. 10198.

Moreover, it matters not that it was the Patent Owner that ordered the tents. There was no confidentiality agreement and no nondisclosure agreement with the Patent Owner limiting public disclosure of the tent design, and therefore nothing to limit public knowledge of the design of the Publicly Sold Tents. This is much like the situation in *Brasseler, U.S.A. I, L.P. v. Stryker Sales Corp.*, 182 F.3d 888 (Fed. Cir. 1999). In that matter, “DS Manufacturing made a large number of the agreed-upon product for general marketing by Brasseler.” *Id.* at 891. The parties invoiced and understood the transaction to comprise a sale of product. *Id.* Therefore, the Section 102 on-sale bar applied. *Id.* at 891.

Accordingly, the tents at issue were commercially sold. The design of the tents was ready for patenting and, in fact, that design was patented. The Board should find the claims of the ‘496 Patent invalid as unpatentable over the on-sale bar of Section 102.

E. Ground No. 2: Claims 1-20 are invalid under 35 U.S.C. § 102(a)(1) as having been publicly disclosed

Much of the above analysis applies to Ground No. 2. Petitioner displayed a tent at a public exhibition. There was no requirement of secrecy, and any attendee could and did see the displayed tent.

To establish public use under Section 102, a petitioner must show that the purported use was (i) accessible to the public, or (ii) was commercially exploited prior to the date of the patent application. *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1380 (Fed. Cir. 2005). A patented invention is considered to be in public use if it is shown to or used by an individual other than the inventor under no limitation, restriction, or obligation of confidentiality. *Petrolite Corp. v. Baker Hughes Inc.*, 96 F.3d 1423, 1425 (Fed. Cir. 1996).

Here, the patented invention was shown by an individual other than the inventors named in the '496 Patent. And there were no limitation, restriction, or obligation of confidentiality.

Petitioner recognizes that the usual application of the public-use bar of Section 102 is when the inventor named in the patent publicly uses the invention. But Section 102 makes no such requirement. Numerous cases have enforced the public-use bar when the public user is not the inventor named in the patent.

The classic standard for assessing the public nature of a use was established in *Egbert v. Lippmann*, 104 U.S. 333, 336, 26 L. Ed. 755 (1881). The inventor of a

corset spring gave two samples of the invention to a lady friend, who used them for more than two years before the inventor applied for a patent. *Id.* at 335. Although the inventor later married the lady friend, the Supreme Court nevertheless found it a public use to give or sell the invention to another, without limitation or restriction, or injunction of secrecy. *Id.* at 336.

The Supreme Court also found two patents invalid because the defendant in a case had continuously employed the alleged infringing machine and process for the production of lead oxide powder used in the manufacture of plates for storage batteries, which plates were then sold. *Elec. Storage Battery Co. v. Shimadzu*, 307 U.S. 5, 59 S. Ct. 675, 684, 83 L. Ed. 1071 (1939). This use was more than two years before the inventor applied for patents and, therefore, the use invalidated the claims in suit. *Id.* at 20.

“The law is clear that a use is ‘public’ where the practice of the invention is carried out in the usual course of producing goods for commercial purposes” *Chemithon Corp. v. Procter & Gamble Co.*, 287 F. Supp. 291, 309 (D. Md. 1968), *aff’d*, 427 F.2d 893 (4th Cir. 1970). It matters not if the public use was by the inventor named in the patent or, as in these cases, by someone else.

Petitioner publicly used and displayed the patented invention before the effective filing date. The claims of the ‘496 Patent are therefore invalid.

X. CONCLUSION

In view of the foregoing, Petitioner respectfully submits that the Board should institute a Post-Grant Review on all Grounds of the Petition.

Dated: May 21, 2024

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CERTIFICATE OF LENGTH (37 C.F.R. § 42.24(d))

The undersigned hereby certifies that, according to the word-processing system used to prepare the foregoing document, this document has 6,907 words and thus complies with the applicable word limit.

Dated: May 21, 2024

s/ James P. Murphy

USPTO Reg. number 40,741

An attorney for Petitioner

CERTIFICATE OF SERVICE (37 C.F.R. §§ 42.6(E), 42.105(A))

The undersigned hereby certifies that on May 21, 2024, a complete and entire copy of this Petition for Post Grant Review including all exhibits was provided via Priority Mail Express to the Patent Owner by serving the correspondence address of record listed in Patent Center as of May 20, 2024 for the '496 patent:

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