

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MPL BRANDS NV, INC.
Petitioner

v.

BUZZBALLZ, LLC,
Patent Owner

PGR2024-00035

U.S. Patent 11,932,441

PATENT OWNER'S PRELIMINARY RESPONSE

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I. INTRODUCTION

Patent Owner, BuzzBallz, LLC, submits this Preliminary Response under 35 U.S.C. § 323 and 37 C.F.R. § 42.207 in response to the Petition for Post Grant Review (“Petition”) challenging claims 1-20 of U.S. Patent No. 11,932,441 (“the ’441 Patent”) (EX1001).

The Board should deny institution because the ’441 Patent is not eligible for Post Grant Review (“PGR”).

PGR is only available for AIA patents, not pre-AIA patents like the ’441 Patent. PGR proceedings only apply to patents “that contain[] or contained at any time – (A) a claim to a claimed invention that has an effective filing date” after March 15, 2013 or “(B) a specific reference...to any patent or application that contains or contained at any time such a claim.” AIA § 6(f)(2)(A); AIA § 3(n)(1). The ’441 Patent does not meet either of these requirements.

Petitioner incorrectly asserts that the ’441 Patent should be eligible for PGR for two faulty reasons. First, Petitioner asserts that claims 9, 10, 15, and 16 of the ’441 Patent include features related to a see-through container body that allegedly lack written description support. Second, Petitioner asserts that the parent design patent application of the ’441 Patent included a drawing (Figure 2) allegedly lacking written description support. Neither argument has merit.

“To satisfy the written description requirement, a patent specification must

describe the claimed invention in sufficient detail that **one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.**”

MPEP § 2163, citing *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563. The Federal Circuit has explained that the written description requirement is the same for utility patents and design patents. *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013).

Importantly, the Petition's arguments regarding lack of written description are all based on attorney argument, not the understanding of a POSITA. In fact, *both* of Petitioner's POSITA declarants contradict the Petition's assertion that claims 9, 10, 15, and 16 lack written description support, explaining that “**a POSITA would understand [PET] was a transparent material through which [structural features of the container] can be viewed,**” (EX1002, ¶114) and that one of the benefits of using PET is that the container is “**clear and allow[s] the product to be seen through the container.**” EX1005, ¶11. The evidence of record clearly establishes that a POSITA would know that the inventor had possession of the claimed invention set forth in claims 9, 10, 15, and 16 of the '441 Patent as of the pre-AIA priority date of April 19, 2010.

Similarly, a POSITA would also recognize that the inventor had possession of the invention shown in Figure 2 of the parent design patent application as of April 19, 2010. Neither of Petitioner's POSITA declarants asserts that Figure 2 lacks

written description support. Further, any minor “differences” between Figure 2 and the drawings in the earlier utility application are a result of using different drawing conventions, not a change in design. The Board has consistently held that a design patent cannot be deprived of its priority claim based on such minor differences. *See, e.g., Skechers U.S.A., Inc., v. Nike, Inc.*, IPR2016-00871, Paper 8 at 20 (PTAB Sept. 29, 2016) (“minor inconsistenc[ies]” in drawings are not “sufficient to show that [an inventor] did not have possession of the claimed invention.”); *David’s Bridal, Inc. v. Jenny Yoo Collection, Inc.*, PGR2016-00041, Paper 9 at 15 (“[t]he test for new matter is not whether the desired correction was ever specifically illustrated in a particular figure as filed” but whether the inventor had possession of the “design as a whole.” (quoting *Ex Parte Asano*, 201 U.S.P.Q. 315 (BPAI 1978))). The evidence of record here clearly establishes that the inventor had possession of the claimed invention set forth in Figure 2 of the design patent application as of the April 19, 2010 priority date.

Because the ’441 Patent is a pre-AIA patent and does not meet any of the requirements for PGR eligibility, the Board should deny institution.

Beyond the fact the ’441 Patent is not eligible for PGR, the Board should exercise its discretion to deny institution. The Board has previously denied institution using its discretion when—as is the case here—issues of priority date have arisen in the context of a patent’s eligibility for PGR. *See Ideavillage Products*

Corp., v. Koninklijke Philips N.V., IPR2022-00904, Paper 8 at 19 (Oct. 25, 2022)

(“The complexity of the issues raised in connection with the priority dispute tips the scale against institution of review in this case.”).

II. THE '441 PATENT IS NOT ELIGIBLE FOR PGR

On its face, the '441 Patent is a pre-AIA patent that claims priority to April 19, 2010. Petitioner bears the burden to show otherwise. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (burden of showing of unpatentability “never shifts to the patentee”). Because Petitioner has failed to establish that the '441 Patent satisfies either AIA §§ 3(n)(1)(A) or 3(n)(1)(B)¹, the '441 Patent is not eligible for PGR and institution should be denied.

A. The '441 Patent Does Not Satisfy AIA § 3(n)(1)(A).

None of claims 9, 10, 15, or 16 fall under the purview of AIA §§ 3(n)(1)(A)–(B). Claims 9, 10, 15, and 16 recite, in part, a depression that is “visible through at least a portion of the container body.” EX1001, 6:32-47 (claims 9-10), 8:62-9:5 (claims 15-16). Petitioner argues that this feature does “not find written description support in any prior filed applications.” Pet., 7. Petitioner argues that “[t]he

¹ Petitioner describes PGR eligibility in terms of MPEP § 2159. *See* Pet., 4-8.

Patent Owner addresses PGR eligibility using the controlling statutory language found in AIA §§ 3 and 6.

specification...fails to explain whether transparent resins are used” or “a transparent/translucent liquid.” Pet., 7. Contrary to Petitioner’s argument, a POSITA at the time of invention would have readily understood from the detailed description and drawings that the inventor had possession of the invention set forth in claims 9, 10, 15, and 16 as of the April 19, 2010 priority date, at least because of the drawings and detailed description in U.S. Patent Application No. 12/762,934, the first application in the priority chain of the ’441 Patent. *See infra* § II.A.1-2.

1. The specification provides written description support for transparent resins.

The specification provides a non-exhaustive list of materials that may be used for the container body, including “polyethylene terephthalate (PET) resin,” “polyamide resin, polycarbonate resin, polyacetal resin, polybutylene terephthalate resin or other synthetic resin.” EX1001, 2:43-49. Each of these materials was known by a POSITA to be transparent.

For example, “polyethylene terephthalate (PET)” is described as “[a] typical transparent polyester medium.” EX2005, 1:35-38; *see also* EX2006, 3:14-17 (“A polyethylene terephthalate film is used for the transparent film.”); EX2007, 5:52-57 (“Examples of the transparent polymer films include films of polyethylene terephthalate.”). The Petition cites to the Handbook of Engineering and Specialty Thermoplastics to argue that “PET material *can be* opaque.” Pet. 7 (citing EX1017, 39). However, reviewing the cited page of the Handbook makes clear that PET itself

is not opaque. Instead, the Handbook explains that PET can be *combined* “*with additives*” to create an “opaque or colored” material. EX1017, 39 (“opaque or colored (with additives)”).

A POSITA understood that PET is a transparent material. The Handbook itself confirms this understanding. It explains that in its “amorphous state, *PET is transparent*,” that “[l]ight transmission can reach 85 %,” and it can be “used as overhead projector transparency, photographic film, etc.” EX1017, 28-29. And even in its “semi-crystalline state,” PET is “translucent.” EX1017, 23. The Handbook’s introduction to PET further explains that it is “one of the most important industrial polymers because of its excellent properties as tensile impact strength, chemical resistance, processability, *clarity*, thermal stability and others.” EX1017, 22.

That PET is a transparent material is also supported by the testimony of Petitioner’s own experts, Mr. Joseph T. Norris and Dr. Nathan J. Delson. Mr. Norris describes the development of the “PCAN project” which “mimic[ed] the design and shape of Coca-Cola’s 12oz aluminum cans” but used “PET for the body of the can instead of aluminum.” EX1005, ¶11. Mr. Norris explains that “[t]he differentiator was that *these cans were clear and allowed the product to be seen through the container*.” EX1005, ¶11. Dr. Delson’s testimony corroborates Mr. Morris’s, explaining that “*a POSITA would understand [PET] was a transparent material through which [structural features of the container] can be viewed*.” EX1002,

¶114. Dr. Delson also noted that the “see-through properties” of PET are “corroborated by the Coca-Cola Marketing Material indicating ‘[T]he new package is *translucent and semi-transparent, so you can see inside.*’” EX1002, ¶109 (quoting EX1006, 1). Dr. Delson further explains that “*it was well known to a POSITA that PET could be translucent or transparent.*” EX1002, ¶247.

Further, the other exemplary materials recited in the specification are also transparent. For example, “polyamide” is “*excellent in transparency.*” EX2008, 5:72-6:2; *see also* EX2009, [0001] (“[P]olyamides have some or all of the properties listed below: *transparency*”). Similarly, “polycarbonate” is “an industrial plastic material...that has *the same transparent property.*” EX2010, [0030]; *see also* EX2011, 1:59-60 (listing “excellent properties inherent to a polycarbonate resin such as *transparency*, heat resistance and dimensional stability.”).

Based on the evidence of record, it is undisputed that there is adequate written description support for a transparent container body such that the depression is “visible through at least a portion of the container body,” as recited by claims 9, 10, 15, and 16.

2. The specification provides written description support for transparent or translucent liquids.

While Patent Owner disagrees that claims 9, 10, 15, and 16 require a transparent or translucent liquid for the depression to be “visible through at least a portion of the container body,” the ’441 Patent has more than adequate written

description support for claiming transparent and translucent liquids.

The standard for written description support is “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed.Cir.2010). Here, it is clear from the detailed description and drawings that the inventor contemplated a transparent or translucent liquid within a transparent container body. Petitioner's POSITA declarants do not dispute this fact.

The exemplary liquids described in the '441 Patent description are transparent or translucent. For example, the '441 Patent mentions beverages, such as “beer and soda,” as liquids for which the claimed container would be suitable. EX1001, 1:25-27. A POSITA would have recognized that beer is typically see-through, or translucent. EX2012, [0024] (inspecting bottles that “are made of a transparent material, for example glass or a transparent plastic such as PET, for example, and are filled with *a transparent liquid* (e.g. *beer*, table water, mineral water, wine etc.)”). In addition, sodas are also transparent or translucent. EX2013, [0008] (“translucent to transparent liquids such as water, *soda*, juice, or the like”). Given that the '441 Patent specifically identifies beer and soda as beverages the described and claimed container was intended to hold, the written description provides explicit support for having transparent or translucent liquids within the container.

In addition to the disclosure above, the '441 Patent provides multiple side views of the claimed container filled with a liquid/solid in which the depression is visible through the side walls. For example, in both Figures 1 and 2, shown below, the bottom depression is visible through “the container side wall 107” and “the liquid/solid within the container body 105.”

Container Shape

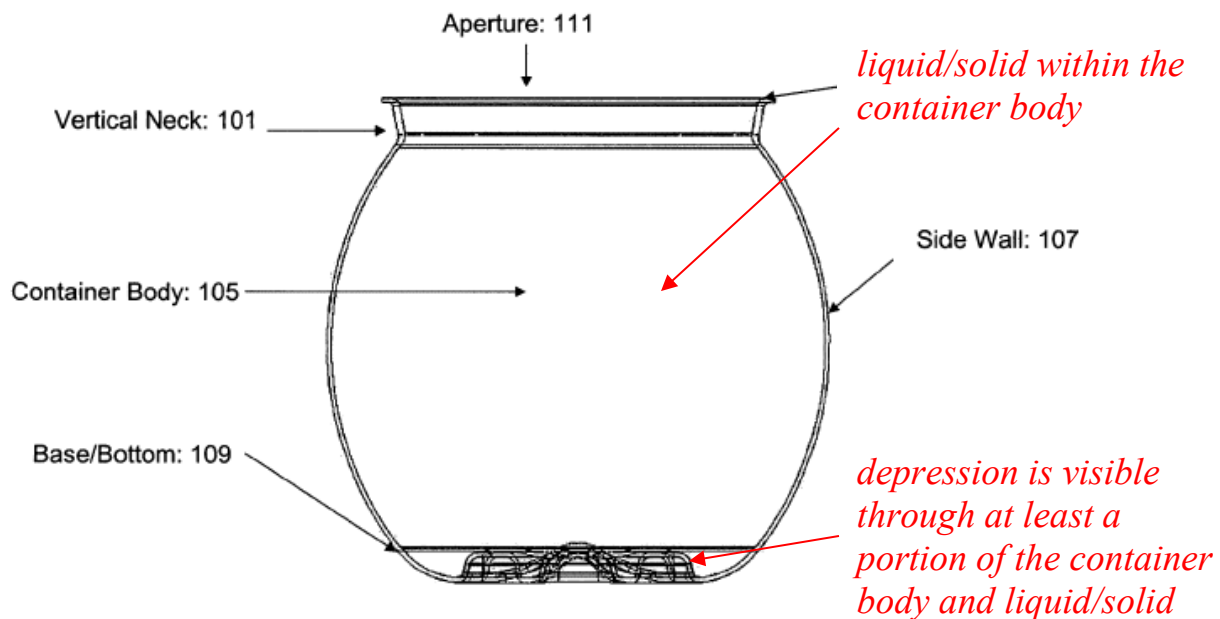


Figure 1

EX1001, Fig. 1 (annotated)

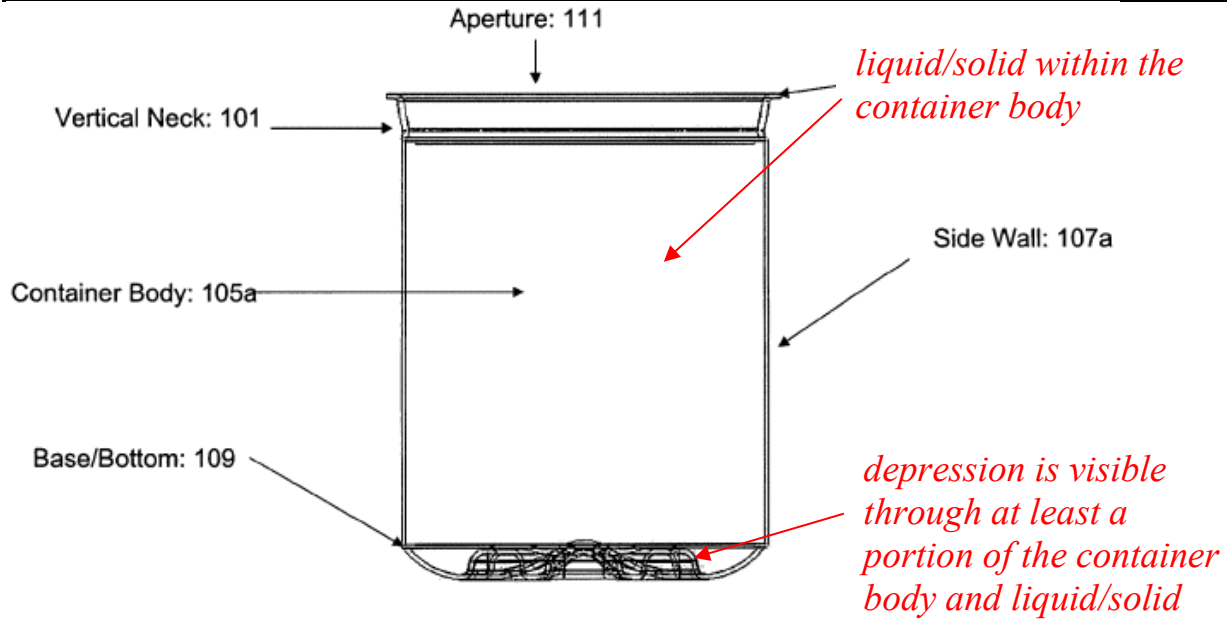


Figure 2

EX1001, Fig. 2 (annotated)

Tellingly, these figures are not described as cross-sectional views of the container. Both are referred to simply as traditional “side view[s].” EX1001, 1:62-65. These views and associated descriptions show that the inventor was in possession of both a transparent container body and transparent contents (liquids/solids) within the container body.²

For at least these reasons a POSITA would have recognized that the inventor

² Originally-filed figures 1 and 2 of U.S. Patent Application No. 12/762,934—the first application in the priority chain of the ’441 Patent—also confirm the inventor was in possession of the inventions of claims 9, 10, 15, and 16 as of April 19, 2010.

had full possession of the invention set forth in claims 9, 10, 15, and 16 as of the claimed priority date. Therefore, the '441 Patent does not contain, nor has it ever contained, a claim to an invention that has an effective filing date after March 15, 2013.

B. The '441 Patent Does Not Satisfy AIA § 3(n)(1)(B).

The Petitioner also argues that Figure 2 of the '813 Application—the parent design application of the '441 Patent—lacked written description support in its parent application, U.S. Patent Application 16/800,195 (“the '195 Application”), such that the '813 Application and its children (including the '441 Patent) should be examined under the AIA. Contrary to Petitioner’s suggestions, there was no break in the priority claim between the '195 Application and the '813 Application. Figure 2 of the '813 Application always retained written description support and the minor drawing changes from the '195 Application did not introduce new claims under the AIA.

The Federal Circuit has explained that “the test for sufficiency of the written description...*is the same for either a design or a utility patent.*” *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013). That standard is “expressed as ‘whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor *had possession of the claimed subject matter* as of the filing date.’” *Id.* (quoting *Ariad*, 598 F.3d at 1351).

In determining whether a design patent claim is adequately supported, “the proper analysis is to view the...design as a whole.” *David’s Bridal*, Paper 9 at 15. To that end, “[m]echanical drawing errors and inconsistencies between the figures of the drawing...do not preclude the overall understanding of the drawing as a whole” and “are an insufficient basis for holding the design both indefinite and insufficiently disclosed under 35 USC 112.” *Asano*, 201 U.S.P.Q. 315. The Board has similarly explained that “minor inconsistenc[ies]” in drawings are not “sufficient to show that [an inventor] did not have possession of the claimed invention.” *Skechers*, Paper 8 at 20.

Figure 2 of the ’813 Application—the figure that Petitioner alleges lacks written description support—is shown on the right below beside the corresponding figure of the parent ’195 Application.

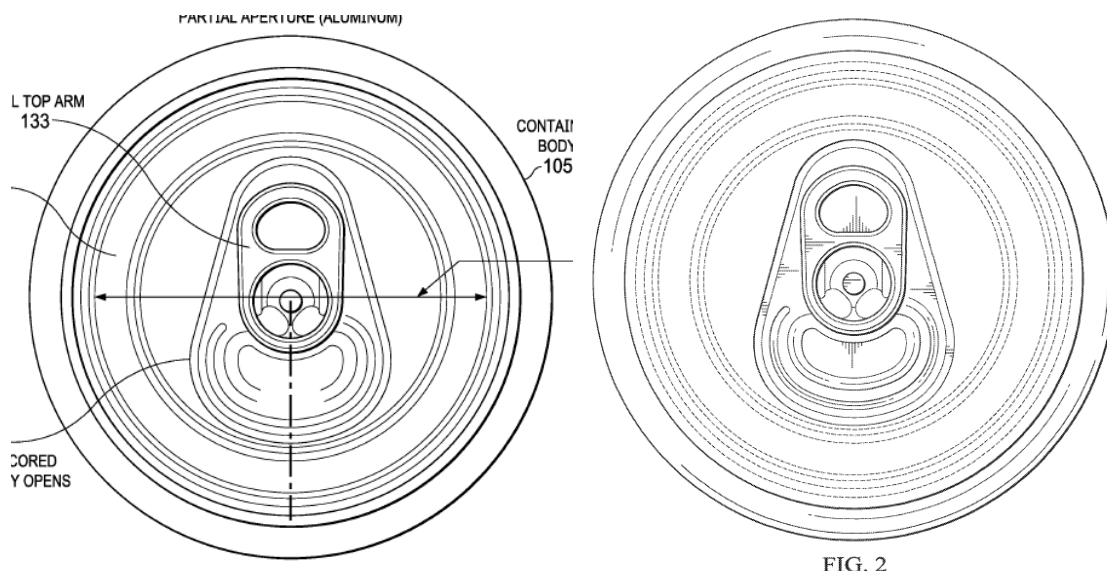


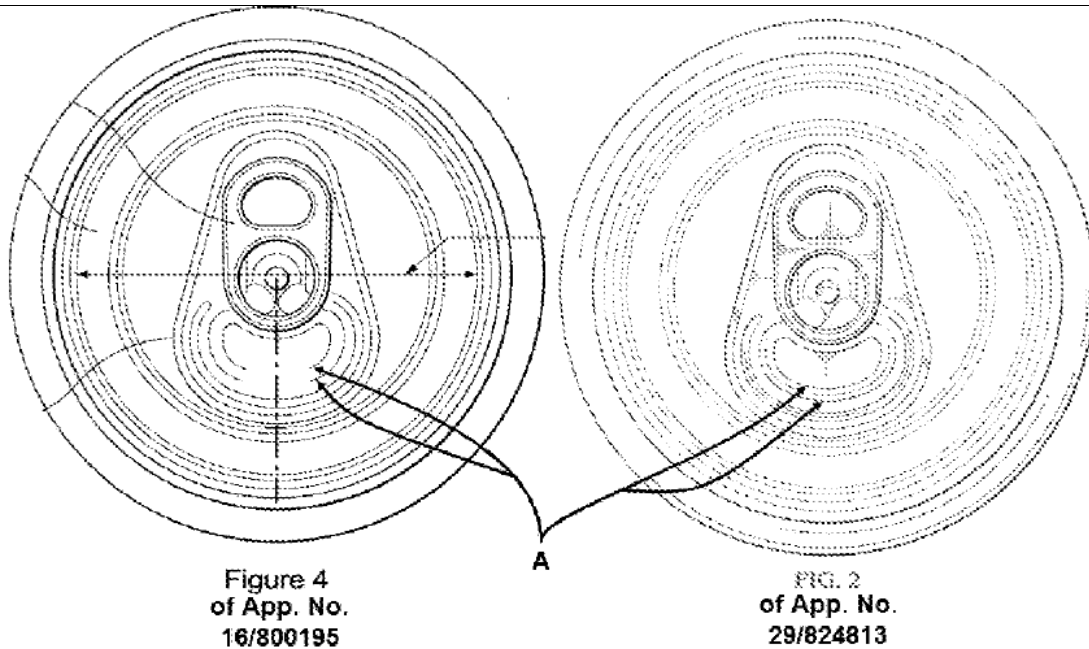
Figure 4
EX2002, 106
(’195 Application)

FIG. 2
EX1003, 187
(’813 Application)

A simple comparison of these figures shows that the inventor was in adequate possession of the “design as a whole.” *David’s Bridal*, Paper 9 at 15. The “minor inconsistencies” Petitioner scrutinizes do not show otherwise, as explained in more detail below.

1. The Examiner of the ’813 Application Applied an Incorrect and Overly Rigid Standard for Written Description.

The first Office Action of the ’813 Application indicated that the design application would be “examined under the first to file provisions of the AIA.” EX1003, 107. The examiner provided an annotated figure, shown below, comparing Figure 4 of the ’195 Application (on the left) to Figure 2 of the ’813 Application (on the right). EX1003, 107.



EX1003, 107

The Examiner decided that the “[s]hape of [the] bottom contour of [the] tear strip portion of [the] pop top has been changed” and used the annotation “A” with arrows to point to the “difference.” EX1003, 107. In Figure 4 of the ’195 Application, the two lines identified by the Examiner’s “A” arrow do not connect along the lower part of the tear strip portion. In Figure 2 of the ’813 Application, those lines are connected.

Based on this difference alone, the Examiner concluded that the ’813 design “*could not have been recognizable* as a design in the prior art application’s disclosure.” EX1003, 107.

The Examiner’s objection was unfounded and applied an incorrect and overly rigid standard. A POSITA would immediately recognize that the top of the container

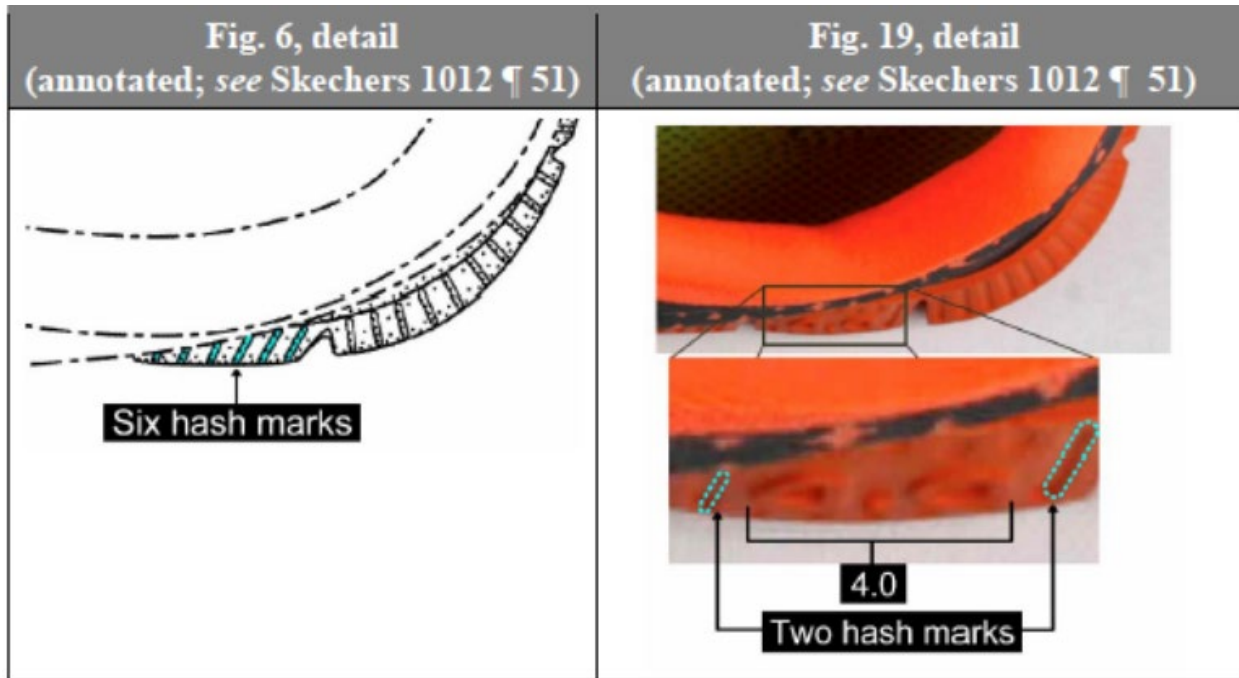
shown in Figure 2 of the '813 Application is the same design as the top of the container shown in Figure 4 of the '195 Application. Notably, Petitioner's POSITA declarants do not allege otherwise. There was no change in the design. The minor change to Figure 2 of the '813 Application hardly renders the design *unrecognizable*.

The Examiner's objection was based on requiring the figures to be *identical*. But this overly rigid standard is not supported by any PTAB or Federal Circuit precedence. As explained above, "the test for sufficiency of the written description...*is the same for either a design or a utility patent*." *Owens*, 710 F.3d at 1366. A design has written description support if "the inventor had possession" of the "design as a whole." *Id.* (quoting *Ariad*, 598 F.3d at 1351); *David's Bridal*, Paper 9 at 15.

Following this standard, PTAB panels have consistently rejected similar attempts to deprive design patents of their priority dates based on inconsequential differences in figures.

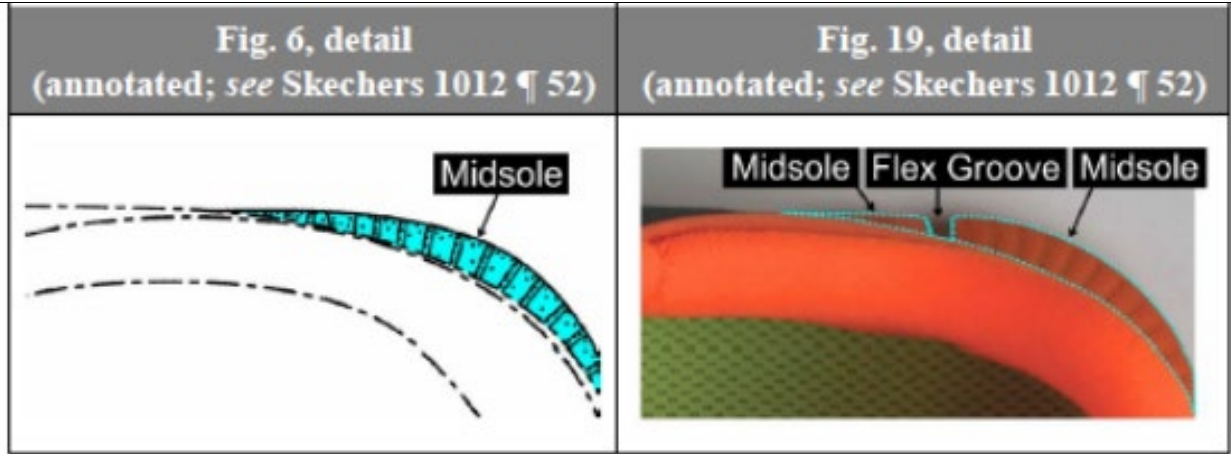
In *Skechers*, the petitioner "assert[ed] that there [were] at least 13 differences" between the figures of a challenged design patent and photographs submitted as figures in the parent application. *Skechers*, Paper 8 at 11. According to the petitioner, these differences "constitute[d] new matter...precluding any claim to priority based on that parent application." *Id.* The petitioner provided enlarged side-by-side comparisons of the figures to illustrate the differences, shown below, and reproduced

in the Board's decision denying institution. *See id.* at 14-19. One of these differences included six hash marks on the lower sole of a shoe in one figure (on the left) compared with only two hash marks and the lettering "4.0" in the corresponding figure of the parent application (on the right), as shown below. *Id.* at 14.



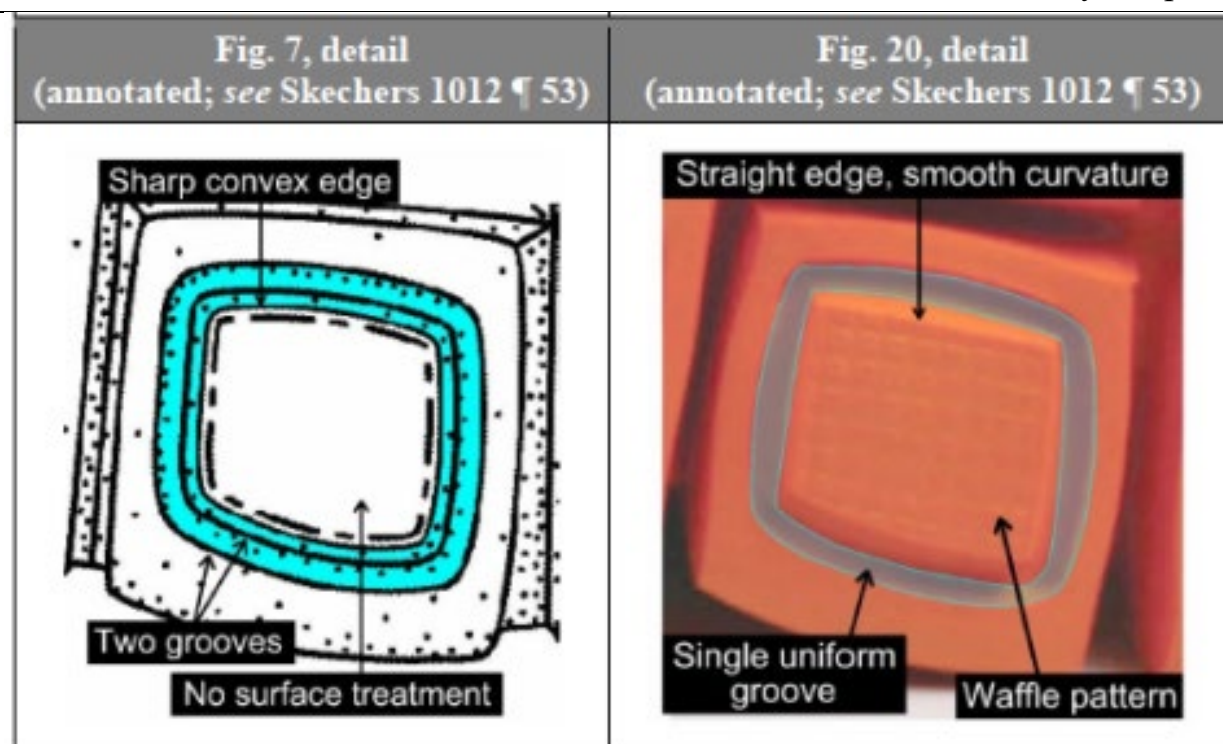
***Skechers*, Paper 8 at 14**

The petitioner further showed a figure of the child application showing a continuous “midsole” while the parent figure included a “flex groove” at the same location. *Id.* at 16.



Skechers, Paper 8 at 16

The petitioner also pointed to another region of the sole that included “two grooves” and a “sharp convex edge” in the child application, where the parent application included a “single uniform groove” and a “straight edge” with “smooth curvature,” shown below. *Id.* at 19.

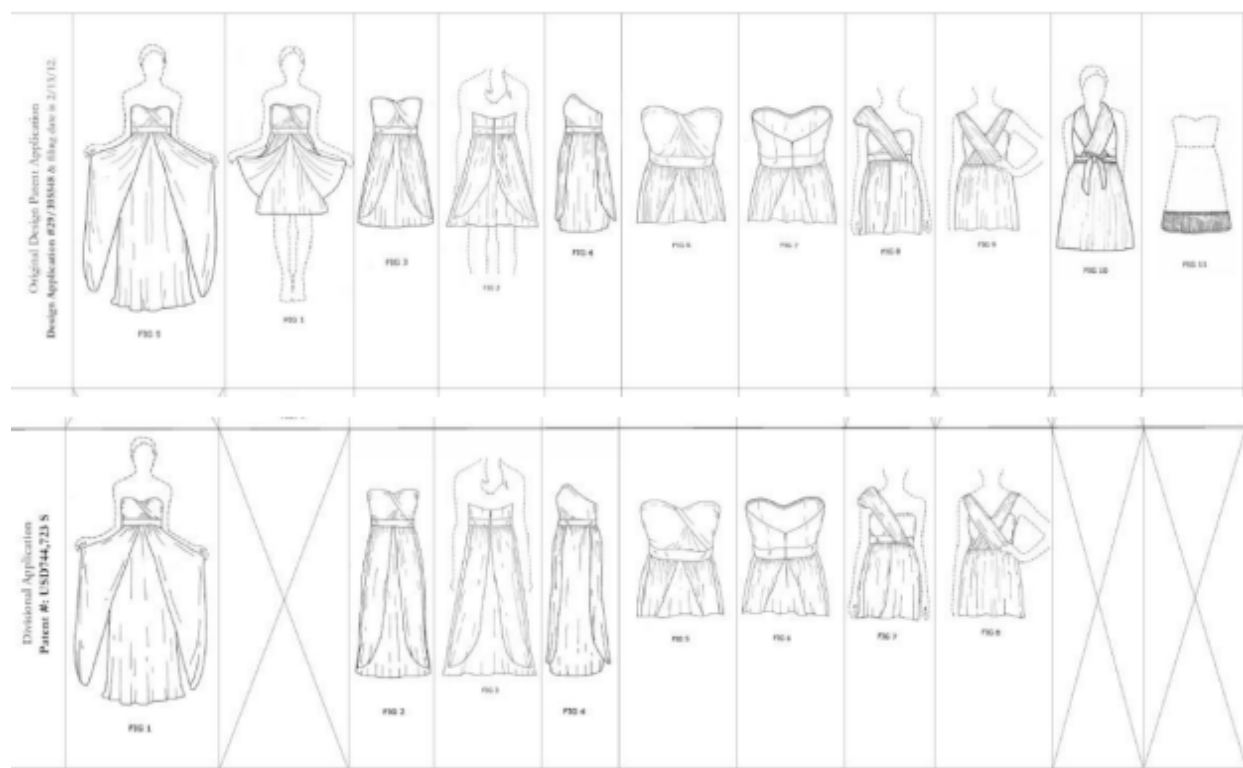


Skechers, Paper 8 at 19

The PTAB acknowledged these differences in the figures but correctly explained that the Petitioner was applying an overly rigid standard. The Board described the comparisons as “an excessively critical micro-analysis that any observer, when comparing the photograph to the respective line drawing, would be hard-pressed to discern.” *Id.* at 14. Further, despite the differences, “[i]t is not imperative...that the drawings in the continuation be exactly the same as the [figures] of the parent.” *Id.* at 21. The differences identified by the petitioner were “trivial and/or minor drafting inconsistencies that [did] not detract from understanding the design as a whole.” *Id.* at 23. Further, the Board explained that “minor inconsistenc[ies]” are not “sufficient to show that [an inventor] did not have

possession of the claimed invention.” *Id.* at 20. Accordingly, the Board correctly preserved the priority date of the later filed design patent and denied institution. *Id.* at 29-30.

The Board denied institution of a PGR in *David's Bridal* for the same reason. In *David's Bridal*, the petitioner argued that a design patent filed after March 15, 2013 should be eligible for PGR due to numerous discrepancies between the figures of the design patent and its pre-AIA parent. The Board compared the figures of the parent application (on the top row) with the design patent figures (on the bottom row).



***David's Bridal*, Paper 9 at 16**

The Petitioner argued that because Figures 2-4 showed dress designs of different lengths not disclosed in the parent application, the design patent should be deprived of its pre-AIA status and subject to PGR.

The Board rejected the petitioner's scrutiny of the minor differences in the figures because "[t]he test for new matter is not whether the desired correction was ever specifically illustrated in a particular figure as filed." *David's Bridal*, Paper 9 at 15 (quoting *Asano*, 201 U.S.P.Q. 315). Instead, the question is whether the inventor had possession of the "design as a whole." *Id.*

The Board's reasoning in both *Skechers* and *David's Bridal* directly applies here. Just like the petitioners in those cases, the Petitioner here points to a nearly indiscernible difference between Figure 2 of the '813 Application and Figure 4 of the '195 Application to argue that Figure 2 of the '813 lacks written description support such that the inventor did not adequately possess the invention. Petitioner's argument is a similarly improper "micro-analysis" comparison. *Skechers*, Paper 8 at 9.

In this case, one of ordinary skill in the art would have readily and easily recognized that the "design as a whole" shown in both Figure 4 of the '195 Application and Figure 2 of the '813 Application was the same. This review of the drawings alone shows that the inventor was in full possession of the invention in satisfaction of the written description requirement and AIA § 3(n)(1)(B) is not met.

2. Figure 2 of the '813 Application was Adequately Supported by the Detailed Description of the '195 Application.

Beyond Figure 4 of the '195 Application providing written description support, the detailed description of the '195 Application also provided written description support for Figure 2 of the '813 Application. The specific feature the Petitioner identifies as allegedly new matter is well understood by a person of ordinary skill in the art. In this regard, the '195 Application describes “a container lid having an easy-open ‘pop-top arm’” and “a weakened (scored metal area).” EX2002, 92. It describes “a pop top (or easy open) lid 131.” EX2002, 94. It also describes a “container lid 113 which may be deformable” to “provide[] an opening when the ‘pull top’ arm 133” is “pivoted by the user.” EX2002, 95-96. The novelty of the '441 Patent is not defined by these features, but instead by the particular combination of components, geometries, and materials set forth in the claims. EX1001, 4:6-9:19 (claims 1-20).

The pull tab and tear strip features in question are common components of containers. As of the claimed priority date, these components had been used to open cans “for a number of years.” *See* EX1001, 1:25-27, 1:34-36 (“the pop top lid is very popular.”). Accordingly, a POSITA would have readily recognized and understood from the relevant descriptions in the '195 application that the scope of this common feature encompassed the design shown in Figure 2 of the '813 Application. Again, and importantly, Petitioner's POSITA declarants do not assert that Figure 2 of the

'813 Application is not adequately supported by the '195 Application.

That Figure 2 of the '813 Application was adequately supported by the written description of the '195 Application is further confirmed given the level of complexity of the technology. The “level of detail required to satisfy the written description requirement depends, in large part, on the nature of the claims and the complexity of the technology.” *Streck, Inc. v. Rsch. & Diagnostic Sys., Inc.*, 665 F.3d 1269, 1285 (Fed. Cir. 2012) (citing *Ariad*, 598 F.3d at 1351). Accordingly, little detail was required to provide adequate written description support for Figure 2 of the '813 Application.

3. Any Difference in the Figures Is a Difference in Drawing Convention—Not a Difference in Design.

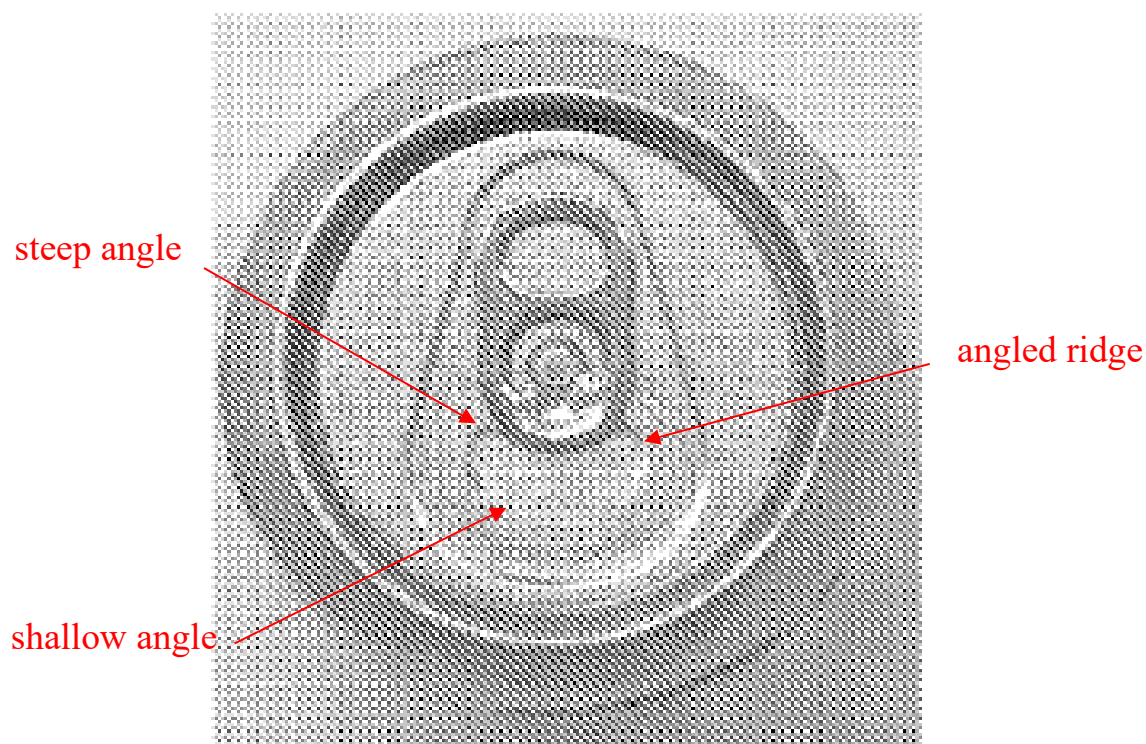
The PTAB has distinguished differences in figures resulting from drawing conventions from differences in a design itself. “Mechanical drawing errors and inconsistencies between the figures of the drawing, which do not preclude the overall understanding of the drawing as a whole[,] are an insufficient basis for holding the design both indefinite and insufficiently disclosed under 35 USC [§] 112.” *David's Bridal*, PGR2016-00041 at 18 (quoting *Asano*, 201 U.S.P.Q. at 315); *see also Skechers*, IPR2016-00871 at 21 (attributing differences to “mechanical drawing consistency”). Recognizing this distinction between differences reflecting alternative drawing conventions and differences reflecting changes to the design is critical for design patents.

Upon review of Figure 2 of the '813 Application and Figure 4 of the '195 Application, Mr. Kirkpatrick—a patent illustrator with over 32 years of experience who provides a declaration in support of this Preliminary Response—concludes that “the differences...reflect choices in drafting strategy of the respective illustrators.” EX2001, ¶¶5,19. Mr. Kirkpatrick explains that “[p]atent illustrators do not always provide the same amount of detail for well-known components” because “details that such a skilled person would know to provide may be left out.” EX2001, ¶19 (quoting EX2003, 93). Mr. Kirkpatrick further explains that “both figures reflect the same product design.” EX2001, ¶19. Mr. Kirkpatrick notes the “striking similarity” between the figures, and that although “various contour lines” had been included in Figure 2 of the '813 Application, “the geometry of the container lid in each figure is identical.” EX2001, ¶20. According to Mr. Kirkpatrick, “there is nothing to indicate that the drafter of Figure 2 of the '813 Application illustrated a different product or design.” EX2001, ¶21.

Mr. Kirkpatrick further explains multiple constraints in patent illustrations that commonly lead to such minor differences in figures. *See* EX2001, ¶¶22-32. Patent drawings must illustrate three-dimensional, color objects with “clean, black” lines. EX2001, ¶22 (citing 37 C.F.R. 1.84(l); MPEP 608.02; EX2004, 97). In performing this task, “patent illustrators must make decisions of what lines to include or exclude based on their own judgment” and require “trade-offs for clarity,

simplicity, detail, and personal or client preferences.” EX2001, ¶23 (citing EX2004, 278).

Mr. Kirkpatrick explains that slopes from a top-down view like the one shown in Figure 2 of the '813 Application are “commonly difficult to illustrate.” EX2001, ¶24. Given the image of the can in question, shown below, Mr. Kirkpatrick notes that the lines in question denote an “angled ridge” that appear to form a “slight depression” in the top of the can. EX2001, ¶¶26-28 (annotating EX1003, 37).



EX1003, 37 (enlarged)

Because the slope of this angled ridge gradually changes from a steeper angle at the top of the depressed region to a nearly flat, shallow angle at the bottom of the depressed region, the patent illustrator creating a drawing for the product would have

to choose “at what point from the upper portion to the lower portion the lines should be terminated (as in Figure 4 of the ’195 Application) or whether the lines should simply be connected (as in Figure 2 of the ’813 Application).” EX2001, ¶¶31-32. Given the geometries of the product, it “is to be expected” that there would be variations between draftspersons. EX2001, ¶32.

Based on a simple comparison of the figures at issue, and based on the evidence of record, a POSITA would recognize that Figure 4 of the ’195 Application and Figure 2 of the ’813 Application illustrate the same design. EX2001, ¶33. Figure 2 of the ’813 Application adds details implying shading, contours, and flat or curved surfaces. EX2001, ¶¶13-16. That the draftsperson of Figure 2 of the ’813 Application chose to connect the two lines in question on the tear strip hardly demonstrates an entirely separate design or any type of new matter. EX2001, ¶¶22-32.

In addition, a POSITA would have recognized the difference in the purpose of utility patent drawings (the ’195 Application) as opposed to design patent drawings (the ’813 Application). Because the lines of a design patent drawing define the scope of the invention, it should be expected that design patent drawings will not be identical to drawings of the same product or design in a utility patent. Drawings of a utility patent merely aid “the understanding of the subject matter sought to be patented.” 37 C.F.R. 1.81(a). Different requirements are placed upon design drawings that are not required of utility drawings. *See* 37 C.F.R. § 1.152. Therefore,

it is reasonable to expect that design drawings will be different in some aspects to corresponding utility drawings for the same product.

Accordingly, a POSITA would have recognized that the inventor in this case had possession of the design shown in Figure 2 of the '813 Application based on Figure 4 of the '195 Application despite any trivial differences in drawing convention. EX2001, ¶33.

4. The Examiner's Preliminary Objection to Figure 2 of the '813 Application Has No Bearing on the Board's Determination.

During prosecution of the '813 Application, in the first Office Action, the Examiner indicated that it was “being examined under the first inventor to file provisions of the AIA.” EX1003, 107, 51, 11. This indication has no impact on the Board's decision. “[W]ritten description is the metric against which” a priority claim is measured, not the priority designation of an examiner. *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003); *Anascape, Ltd. v. Nintendo of Am. Inc.*, 601 F.3d 1333, 1338 (Fed. Cir. 2010) (“[T]he designation given to a derivative application does not determine its legal status.”).

The Board is not bound by the Examiner's determination. *See, e.g., Propel Orthodontics, LLC v. OrthoAccel Techs., Inc.*, IPR2018-00296, Paper 36 at 26-27 (PTAB June 10, 2019) (“[W]e do not find persuasive Patent Owner's reliance on the Examiner's findings in the prosecution of the related patent applications” related to

priority determinations.); *Platinum Optics Tech. Inc. v. Viavi Sols., Inc.*, IPR2022-01489, Paper 25 at 19-20 (finding claims lacked support although “the Examiner already made a determination regarding written description support for the claims.”).

Further, that the Applicant submitted replacement drawings in the '813 Application at the Examiner's request does not represent any concession on the Applicant's part that the Examiner's position was correct. Rather, the replacement drawings were submitted in the interests of furthering prosecution. *See, e.g.*, EX1003, 75 (“Applicant has made a diligent effort to advance the prosecution of this application by amending the drawings and submitting arguments in support of the patentability of the design claim.”). And, as discussed above, both versions of the figure illustrate the same design.

In addition, the Examiner's initial designation of the '813 Application as an AIA patent is at odds with the subsequent prosecution history of the '441 Patent. In the Notice of Allowance leading to the '441 Patent, a different Examiner indicated that “[t]he present application is being examined under the pre-AIA first to invent provisions.” EX1004, 216.

5. Even If Figure 2 of the '813 Application Were Construed as New Matter, the '441 Patent Would Still Not Satisfy AIA § 3(n)(1)(B).

Assuming *arguendo* that Figure 2 of the '813 Application included new matter (to which the Patent Owner does not concede), that alleged new matter was never

contained at any time in the '813 Application in a manner that would trigger AIA eligibility in accordance with PTAB precedence.

In *Intex v. Team Worldwide*, the PTAB explained that claims lacking written description support that are subsequently ***canceled*** do not convert an application from pre-AIA review to AIA review. “[W]e do not agree with Petitioner that the claims added to the '073 application that were canceled after being rejected for containing new matter converted the transition application into an application eligible for post-grant review.” *Intex Recreation Corp. v. Team Worldwide Corp.*, PGR2019-00015, Paper 7 at 14 (PTAB May 14, 2019); *see also Rockwool International A/S, v. Knauf Insulation, Inc.*, PGR2022-00022, Paper 10 at 5-7 (PTAB July 6, 2022) (agreeing with Patent Owner that the “temporary presence” of a claim that recites new matter “does not trigger the AIA.”).

By contrast, the PTAB has held that only new matter found in issued claims of a transition application subjects the patent to AIA review. *See Unified Patents, LLC, v. Ideahub Inc.*, PGR2022-00044, Paper 27 at 16-18 (PTAB Feb. 5, 2024); *Home Depot U.S.A., Inc., v. Lynk Labs, Inc.*, PGR2022-00009, Paper 38 at 58 (PTAB May 22, 2023); *Microsurgical Tech., Inc., v. The Regents of the U. of Colo.*, PGR2021-00026, Paper 12 at 24 (PTAB Jun. 16, 2021).

Because the Applicant replaced Figure 2 of the '813 Application with a figure that was essentially identical to Figure 4 of the '195 Application—cancelling any

potential claim to the alleged new matter—and because Figure 2 of the '813 Application never ultimately issued, even if Figure 2 of the '813 Application were construed as new matter, the '813 Application never contained the alleged new matter for purposes of subjecting the '813 Application or subsequent applications to AIA review. Accordingly, for this additional reason, the '441 Patent is not eligible for PGR and institution should be denied.

III. DISCRETIONARY DENIAL

Finally, when issues of priority date have arisen in the context of a patent's eligibility for PGR, the Patent Trial and Board has chosen to exercise its discretion to deny institution. *See Ideavillage Products Corp., v. Koninklijke Philips N.V.*, IPR2022-00904, Paper 8 at 19 (Oct. 25, 2022) (“The complexity of the issues raised in connection with the priority dispute tips the scale against institution of review in this case.”). The Board should do the same here, particularly where the Petitioner has submitted a separate cumulative IPR petition challenging the same claims of the '441 patent based on two of the same grounds in the PGR. *See MPL Brands NV, Inc. v. BuzzBallz, LLC*, IPR2024-01000, Paper 1 (June 7, 2024). Denying institution in this case would not significantly prejudice the Petitioner given its independent and overlapping IPR challenge. And, if institution is granted in the present case, the parties and the Board will have to litigate both the substantive issues of obviousness as well as the issues of priority and PGR eligibility. This factor should “tip[] the

scale against institution.” *Ideavillage*, Paper 8 at 19.

IV. CONCLUSION

The Board should deny institution of the Petition for the reasons presented above.

Respectfully submitted,

Dated: September 20, 2024
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V. CERTIFICATE OF WORD COUNT

Under 37 C.F.R. § 42.24(b)(1), the undersigned attorney for the Patent Owner declares that the argument section of this Patent Owner's Preliminary Response (Sections I-III) has 5,688 words, according to the word count tool in Microsoft Word™.

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PATENT OWNER'S EXHIBIT LIST

EX2001	Declaration of Richard D. Kirkpatrick
EX2002	Prosecution History of U.S. Patent Application No. 16/800,195 ("195 Application")
EX2003	Jack Lo et al., "How to Make Your Own Patent Drawings," Nolo (2019) ("Lo")
EX2004	J. W. Jack Koller, "How to Make Your Own Patent Drawings and Save Thousands," Atlantic Publishing Group (2011) ("Koller")
EX2005	U.S. Patent No. 5,723,202 to Mueller et al. ("Mueller")
EX2006	U.S. Patent No. 6,559,902 to Kusuda et al. ("Kusuda")
EX2007	U.S. Patent No. 5,880,476 to Suzuki ("Suzuki")
EX2008	U.S. Patent No. 3,597,400 to Kashiro et al. ("Kashiro")
EX2009	U.S. Patent Publication No. 2002/0179888 to Montanari et al. ("Montanari")
EX2010	U.S. Patent Publication No. 2009/0119823 to Lee ("Lee")
EX2011	U.S. Patent No. 5,463,013 to Tokuda et al. ("Tokuda")
EX2012	U.S. Patent Publication No. 2009/0279082 to Till et al. ("Till")
EX2013	U.S. Patent Publication No. 2009/0272015 to Schnuckle ("Schnuckle")

§ Patent Owner's Preliminary Response
§
§ U.S. Patent No. 11,932,441
§

CERTIFICATE OF SERVICE

Date of service September 20, 2024

Documents served **Patent Owner's Preliminary Response, Exhibit List and Exhibits EX2001 – EX2013.**

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