

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MPL BRANDS NV, INC.

Petitioner,

v.

BUZZBALLZ, LLC

Patent Owner.

PTAB Case No. PGR2024-00035

U.S. Patent No. 11,932,441

**PETITIONER REPLY IN SUPPORT OF PETITION FOR POST-
GRANT REVIEW OF U.S. PATENT NO. 11,932,441**

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EXHIBIT LIST (Unchanged)

Exhibit	Description
Ex. 1001	U.S. Patent No. 11,932,441 B1 (“’441 patent”)
Ex. 1002	Declaration of Nathan J. Delson, PhD (“Delson”)
Ex. 1003	Prosecution File History of US Design Patent Application 29/824,813
Ex. 1004	Prosecution File History of ’441 Patent
Ex. 1005	Declaration of Joseph T. Norris (“Norris”)
Ex. 1006	Coca-Cola Plastic Can Marketing Material
Ex. 1007	The American Heritage Dictionary
Ex. 1008	U.S. Patent No. 8,524,349 B2 to Protais et al. (“Protais”)
Ex. 1009	U.S. Patent No. 4,405,546
Ex. 1010	U.S. Patent No. 8,141,741 B2 to Metzger, et al. (“Metzger”)
Ex. 1011	U.S. Patent No. 4,465,204 to Kaminski (“Kaminski”)
EX-1012	U.S. Patent No. 6,729,495 B2 to Gardiner (“Gardiner”)
EX-1013	U.S. Patent No. 6,585,123 B1 to Pedmo et al. (“Pedmo”)
EX-1014	U.S. Patent No. 4,024,981 to Brown (“Brown”)
EX-1015	The 1985 Los Angeles Times Article
EX-1016	The 1985 New York Times Article
EX-1017	Handbook of Engineering and Specialty Thermoplastics

Petitioner submits this reply to address three misleading arguments in Patent Owner's Preliminary Response ("POPR").

I. The '441 Patent Is PGR Eligible Because New Matter Was Added *When* The Parent Application Was Filed

The '441 patent claims priority to a series of patent applications, including Design Patent Application No. 29/824,813 ("813 application"). Pet., 5. Because the '813 application claimed new matter when filed, as recognized by the Examiner, it was not entitled to any earlier filing date and was therefore subject to the AIA. *Id.*, 6. The Examiner gave Patent Owner a choice: (1) proceed as is with the '813 application being a CIP application (entitled to January 27, 2022 filing date); or (2) change Figure 2 to the figure contained in the priority applications, and thereby obtain the benefit of the earlier priority dates. *Id.*, 107-108. But either way, the application would remain an AIA application under the terms of AIA § 3(n)(1)(A). And because the '441 patent claims priority to the '813 application, it is also an AIA patent that is PGR eligible. *See* AIA § 3(n)(1)(B).

Patent Owner argues that the '813 application is not an AIA application, alleging that "claims lacking written description support that are subsequently *canceled* do not convert an application from pre-AIA review to AIA review." POPR, 30 (emphasis in original). First, Patent Owner's argument runs directly contrary to the explicit terms of AIA § 3(n)(1) as noted above. Second, Patent Owner mischaracterizes a number of prior PTAB decisions, all of which are inapposite.

Patent Owner first asserts that both *Intex Recreation Corp. v. Team Worldwide Corp.*, PGR2019-00015, Paper 7, 14 (PTAB May 14, 2019) and *Rockwool International A/S, v. Knauf Insulation, Inc.*, PGR2022-00022, Paper 10, 5-7 (PTAB July 6, 2022) hold that the “temporary presence” of claims in an application cannot be the basis for subjecting the application to AIA review. POPR, 30. In both decisions, however, the new matter was not added and claimed *when* the purported continuation application was filed, which would have simply rendered the application a continuation-in-part application subject to AIA review. Instead, the new matter was added and claimed *after* the filing dates of those applications. *See* PGR2019-00015, Paper 7, 10-12; PGR2022-00022, Paper 10, 8. The Board held that the proposed claims that were then canceled were never properly proposed claims and therefore did not render those applications subject to the AIA. *See* PGR2019-00015, paper 7, 13-14; PGR2022-00022, Paper 10, 7-9. Notably, in PGR2022-00022, the Board reproduced and emphasized a section of MPEP §2159.02 that excludes amendments made in “*a preliminary amendment filed on the same day as such application*” from such consideration. PGR2022-00022, Paper 10, 7-8 (emphasis in original). Similarly in the ’813 application, the claims reciting new matter were part of the application *when* it was filed; they therefore were not improper, and, if maintained, they would have made the patent a continuation-in-part, as noted by the Examiner. Ex. 1003, 107-108.

Patent Owner then mischaracterizes PTAB decisions by asserting that they “held that **only** new matter found in **issued claims** of a transition application subjects the patent to AIA review.” POPR, 30 (emphasis added). Each of those decisions did hold that, because of new matter in the issued claims, the patents were subject to AIA review. *Unified Patents, LLC, v. Ideahub Inc.*, PGR2022-00044, Paper 27, 16-17 (PTAB Feb. 5, 2024); *Home Depot U.S.A., Inc., v. Lynk Labs, Inc.*, PGR2022-00009, Paper 38, 51 (PTAB May 22, 2023); *Microsurgical Tech., Inc., v. The Regents of the U. of Colo.*, PGR2021-00026, Paper 12, 24 (PTAB Jun. 16, 2021). But none of those cases held that new matter in issued claims was the **only** way that a patent could be subject to AIA review. Indeed, such an assertion would render the words “or application” in AIA § 3(n)(1) meaningless.

In short, the ’813 application is subject to AIA review under AIA § 3(n)(1)(A) because it was filed with a claim that did not have an effective filing date before March 16, 2013. And the ’441 patent is subject to AIA review under AIA § 3(n)(1)(B) because it claims priority to the ’813 application.

II. The Differences In The Application Figures Constitute New Matter

Patent Owner mischaracterizes two PTAB decisions in arguing that the changes to Figure 2 of the ’813 application do not constitute new matter.

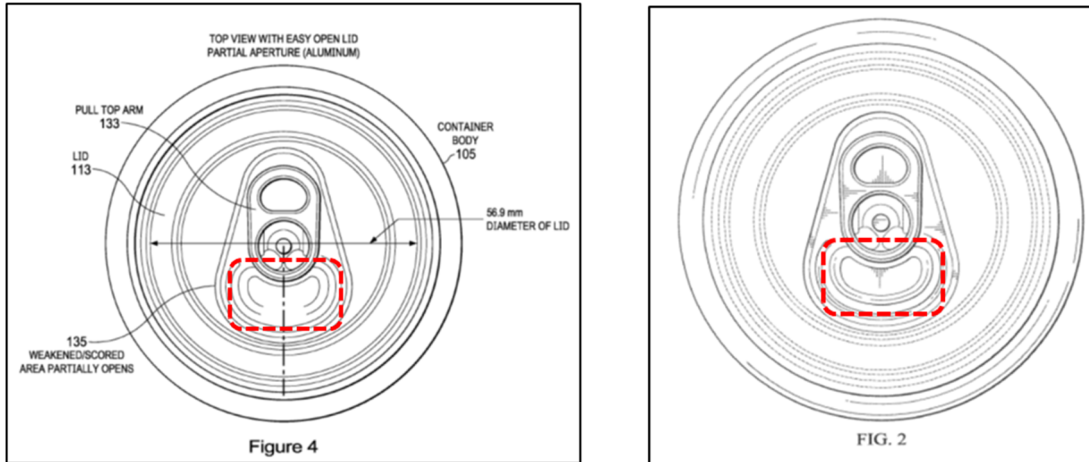
In *Skechers U.S.A., Inc., v. Nike, Inc.*, earlier applications in the priority chain contained 140 pictures of a Nike shoe. IPR2016-00871, Paper 8, 7 (PTAB Sept. 29,

2016). The later applications in the chain, including in the design patent at issue, replaced the pictures with line drawings of the shoe. *Id.* During the examination, the Examiner specifically addressed the change from the photographs to the drawings and determined that those drawings were fully supported by the photographs after conducting an evidentiary and factual analysis. *Id.*, 8-9. In its IPR petition, however, Skechers argued that the drawings were not supported by photographs, pointing to a number of alleged differences. *Id.*, 11. The Board rejected Skecher’s arguments because the differences were so minute they could only be observed, if at all, by magnifying the pictures and drawings. *Id.*, 21 (“The magnification of these differences between certain elements in the photographs and drawings highlights, at least on the evidence in this case, an over-emphasis of fairly trivial inconsistencies of the claimed design relative to the photographs.”); *see also*, *id.*, 14-15, 17, 21. Notably, the Board distinguished a prior decision that earlier-filed utility patent drawings did not support the differing drawings in a later-filed design application because “the side-by-side comparison was undertaken by the Board without any embellishment or magnification of the drawings.” *Id.*, 22, citing *Munchkin, Inc., et al. v. Luv N’ Care Ltd.*, IPR2013–00072 slip op. 6–8 (PTAB April 21, 2014) (Paper 28). The same is true here, where the differences between the full-size drawings can be easily observed without any embellishment or magnification. *Compare* Ex. 1003, 187 *with id.*, 102.

Patent Owner also cites *David's Bridal, Inc. v. Jenny Yoo Collection, Inc.*, PGR2016-00041, Paper 9, but that case is also inapposite. In *David's Bridal*, the priority application contained numerous figures of dresses with varying shapes. *Id.*, 4-5. The new divisional application contained additional figures that combined aspects of the earlier figures. *Id.*, 6. Unlike the present case, the Examiner of the divisional application neither indicated that new matter was present, nor provided any analysis on the record that the application was not entitled to an earlier priority date. *Id.*, 11-12. The Board held that all aspects of the dresses in the divisional application had adequate written description support in the parent application through combinations of other figures. *Id.*, 17-18 ("Patent Owner fails to identify any features or aspects of the longer dress illustrated in Figures 2-4 that are not disclosed in original Figures 2-5 of the '548 application."). In contrast here, no other figures in the priority applications support the changes to the can lid design.

III. Evidence Of Record Refute Mr. Kirkpatrick's Declaration That New Contours Were Just Artistic Interpretations Of The Same Design

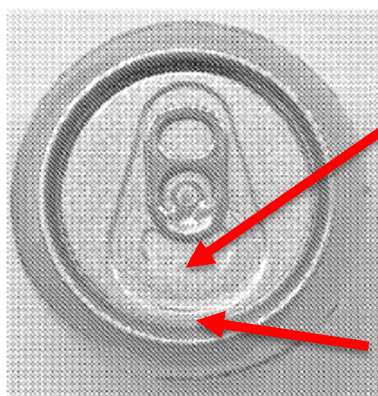
As noted earlier, the Examiner determined that Figure 2, as initially filed, contained new matter. Ex. 1003, 107-108. In the priority applications, the two innermost contours stemming from each side of the tab curve inward and stop (see Figure 4). *Id.* But in Figure 2 of the '813 application, the contours curve all the way around and connect, thereby depicting continuous contours. *Id.*; POPR, 15.



Mr. Kirkpatrick asserts that these differences “in no way reflect a change in the design of the lid, but instead simply show two approaches a draftsman may choose to illustrate the same design.” Ex. 2001, ¶16. Notably, Mr. Kirkpatrick provides no evidence that he spoke to the illustrator of either figure, or even whether they are the same person, so he is simply speculating about the illustrator’s action. Furthermore, an illustrator’s error (or “strategy,” as Mr. Kirkpatrick calls it (*id.*, ¶19)) in adding extra contour features does not absolve Patent Owner’s responsibility not to add new matter. Mr. Kirkpatrick’s assertion that “patent illustrators must make decisions of what lines to include or exclude based on their own judgment” (*id.*, ¶23) makes no sense whatsoever because the priority document’s Figure 4 already included contour lines that provided a clear depiction of the intended design; extra contour segments would not have made the design easier to understand. *Id.* Notably, the additional contour lines were not surface shadings intended for clarification, but were actual design features recognized by the Examiner as new matter; their

significance is further evidenced by Patent Owner's use of solid lines to claim those segments, while excluding other lid features via broken lines. Ex. 1003, 187, Fig. 2.

Patent Owner's actions during the prosecution of the '813 application further contradict Mr. Kirkpatrick's statements. Specifically, Patent Owner did not object, argue or otherwise refute the Examiner's new matter objections, and merely replaced Figure 2 with one having open contours (*id.*, 70); in contrast, Patent Owner made extensive arguments against other 112 rejections. *Id.*, 70-74. Mr. Kirkpatrick also speculates that both illustrations are intended to show the same design (Ex. 2001, ¶21), but the can he points to does not have connecting contour lines. As the photo (below left) shows, directly in from of the tab, the surface rises up to meet the rest of the lid surface without two contour lines. *Id.*, ¶¶25-26. While Mr. Kirkpatrick implies that the lines are there but can't be seen due to angle of the light source (*id.*, ¶29), that assertion is belied by the contour further out that can be seen all the way across the can. As to a can with fully connected contour lines, see the Sprite can (below right), depicting a considerably different design structure. See Ex. 1002, 22.



No contour
lines visible
all the way
across

Contour
lines visible
all the way



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CERTIFICATE OF SERVICE

I hereby certify that on October 17, 2024, a true and correct copy of the foregoing **PETITIONER REPLY IN SUPPORT OF PETITION FOR POST-GRANT REVIEW OF U.S. PATENT NO. 11,932,441** was served by electronic mail on the Patent Owner via its attorneys of record:

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