

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 RESPONSE

TABLE OF CONTENTS

I.	Introduction.....	1
II.	Claim Construction.....	3
III.	The '441 Patent is Not Eligible for PGR.....	3
A.	The '441 Patent Does Not Satisfy AIA § 3(n)(1)(B).....	3
1.	Petitioner fails to provide <i>any</i> evidence regarding the understanding of a POSITA.....	4
2.	The evidence of record establishes that a POSITA would find Figure 2 of the '813 Application did not include new matter.....	5
B.	The '441 Patent Does Not Satisfy AIA § 3(n)(1)(A).....	9
1.	The specification provides written description support for transparent resins.....	9
2.	The specification provides written description support for transparent or translucent liquids.	12
IV.	Petitioner's Grounds 1 and 2 Fail Because Petitioner Has Not Authenticated the Evidence Relied Upon.....	15
A.	Petitioner relies upon an unauthenticated Sprite Can for Grounds 1 and 2.	15
B.	Petitioner has not authenticated the Sprite Can.....	16
1.	The images Mr. Norris reviewed do not show the four features identified as authenticating.	17
2.	Mr. Norris's testimony regarding the four authenticating features is uncorroborated, inconsistent, and unreliable.	22
3.	Petitioner has not provided sufficient evidence to show that the Sprite Can was publicly available.....	25

4.	Petitioner has not established that the cans in its possession or the cans in Mr. Norris's possession were part of the allegedly publicly available cans.	29
V.	The Combination of the Sprite Can with Protais Does not Render the Claims Obvious	36
A.	Petitioner has not identified an adequate motivation to combine the Sprite Can with Protais's base.....	36
B.	Ground 2 of the Petition does not set forth the mapping of the prior art with particularity.	46
VI.	The Combination of Metzger, Protais, and Kaminski Does not Render the Claims Obvious.....	48
A.	Metzger does not disclose a container body...made out of a resin, as required by limitation [1.C].	48
1.	Petitioner's argument that plastics are equivalent to resins invokes inherency and is not supported by any evidence.	49
2.	Petitioner has not provided any reason that a POSITA would select a resin-based plastic.....	51
B.	A POSITA would have recognized that Metzger's container cannot be made of PET.	52
C.	The first depression of Protais's base, identified by the Petitioner, does not partially define[] a first outline, as required by limitation [1.G].....	55
VII.	The Combination of Gardiner, Pedmo, and Brown Does not Render the Claims Obvious.....	62
A.	Gardiner does not disclose a container body...made out of a resin, as required by limitation [1.C].	62
B.	Petitioner has not provided any reason to modify Gardiner's container to be made of PET.	63

C.	Gardiner does not disclose a circular neck, as required by limitation [1.N], or a lip as required by limitation [1.P].	65
VIII.	Conclusion	70
IX.	Certificate of Word Count	71

PATENT OWNER'S EXHIBIT LIST
March 12, 2025

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")
EX2014 (NEW)	Transcript of Deposition of Joseph T. Norris, February 20, 2025
EX2015 (NEW)	Transcript of Deposition of Nathan J. Delson, Ph.D., February 26, 2025
EX2016 (NEW)	U.S. Patent No. 6,131,761 to Cheng et al. ("Cheng")
EX2017 (NEW)	U.S. Patent No. 5,154,295 to Stoner ("Stoner")

EX2018 (NEW)	Huang et al., “Conformational changes and molecular motion of poly(ethylene terephthalate) annealed above glass transition temperature,” Polymer 41 (2000) 1741-1748, (“Huang”)
EX2019 (NEW)	Curriculum Vitae of Folkers Eduardo Rojas Ph.D.
EX2020 (NEW)	Academic Press Dictionary of Science and Technology
EX2021	Reserved
EX2022 (NEW)	Serope Kalpakjian et al., “Manufacturing Engineering and Technology” Fifth Edition, Pearson (2006) (“Kalpakjian”)
EX2023 (NEW)	Materials Data Book, Cambridge University Engineering Department (2003)
EX2024 (NEW)	Materials Data Book, Cambridge University Engineering Department (2011)
EX2025 (NEW)	MatWeb, Overview of materials for Polyethylene Terephthalate (PET), Unreinforced
EX2026 (NEW)	Han et al., “Application of structure optimization technique to aluminum beverage bottle design,” Springer-Verlag (2005), (“Han”)
EX2027 (NEW)	Kannan et al., “Heat transfer analysis of canned food sterilization in a still retort,” Journal of Food Engineering (2008), (“Kannan”)
EX2028 (NEW)	Declaration of Folkers Eduardo Rojas Ph.D.

I. INTRODUCTION

Patent Owner, BuzzBallz, LLC, submits this 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).

As a threshold matter, the '441 Patent is not eligible for PGR. Petitioner bears the burden to show the '441 Patent is eligible for PGR. The Petition alleges the '441 Patent is eligible for PGR based on a lack of written description support. It is well established that sufficient written description is provided where "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." *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013) (quoting *Ariad*, 598 F.3d at 1351). However, importantly, the Petition fails to provide *any* evidence that a POSITA would find the inventor did not have possession of the claimed subject matter at issue. Because the only evidence regarding the understanding of a POSITA establishes the inventor was in possession of the claimed invention as a whole, Petitioner has not met its burden and the '441 Patent is not eligible for PGR.

In addition, grounds 1 and 2 of the Petition fail because Petitioner has not authenticated or shown public accessibility of the evidence relied upon. Grounds 1 and 2 rely on a physical product in the form of a Sprite Can. However, Petitioner has not authenticated, nor shown publicly availability of the Sprite Can. The

uncorroborated and inconsistent testimony of Petitioner's declarant, Mr. Norris, raises more questions than answers and should be given little weight. Ground 2 fails because the combination of the Sprite Can with Protais does not disclose or suggest all the recited elements of the claims. In addition, Ground 2 fails because Petitioner has not articulated a sufficient reason to combine the Sprite Can with Protais other than hindsight based on the claims of the '441 Patent.

Ground 3 of the Petition fails because the proposed combination of Metzger, Protais, and Kaminski does not disclose all the recited elements of the claims. Further, a POSITA would have rejected Petitioner's proposed combination because it renders Metzger's container unsuitable for its intended purpose, which includes handling the high pressure and temperature requirements of a thermal retort process.

Finally, Ground 4 of the Petition also fails because the proposed combination of Gardiner, Pedmo, and Brown does not disclose all the recited elements of the claims. Ground 4 also fails because Petitioner has not articulated *any* reason to modify Gardiner's container as proposed.

II. CLAIM CONSTRUCTION

Before the Board, claims are “construed using the same claim construction standard...in a civil action under 35 U.S.C. 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. §42.100(b). The Board only construes claims to the extent necessary to resolve the underlying controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). Patent Owner submits that all terms in the challenged claims of the '441 Patent should be construed according to their plain and ordinary meaning as would be understood by a POSITA in light of the specification and prosecution history of the '441 Patent.

III. THE '441 PATENT IS NOT ELIGIBLE FOR PGR

Petitioner bears the burden to show the '441 Patent is eligible for PGR. *US Endodontics, LLC v. Gold Standard Instruments, LLC*, PGR2015-00019, Paper 17, 11–12 (PTAB Jan. 29, 2016) (explaining that Petitioner bears the burden of demonstrating that the challenged patent is eligible for post-grant review). Because Petitioner has failed to meet this burden, the '441 Patent is not eligible for PGR.

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

In the Institution Decision (Paper 10), the Board stated: “On the current record, Petitioner adequately demonstrates that the '813 design application as filed

on January 27, 2022, contained a claim that was not supported by the earlier-filed application, and was thus examined under the AIA provisions.” Paper 10, 22 (citing Pet., 7). Based on this preliminary determination, the Board found the ’441 Patent eligible for PGR under AIA §§ 3(n)(1)(B). Paper 10, 23. However, the complete record shows Fig. 2 of the ’813 Application is supported by the earlier-filed application and, therefore, the ’441 Patent is not eligible for PGR. *See* EX2028, ¶¶41-42.

1. Petitioner fails to provide *any* evidence regarding the understanding of a POSITA.

Petitioner 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”). *See* Pet., 5-7. However, the Petition fails to provide *any* evidence indicating that a POSITA would find Figure 2 of the ’813 Application lacked written description support. *Id.* 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” and that the 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.’” *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013) (quoting *Ariad*, 598 F.3d at 1351).

Here, the Petition's arguments regarding lack of written description are all attorney arguments based on the prosecution history, not the understanding of a POSITA. Pet., 5-7. Petitioner has provided *no evidence* regarding the understanding of a POSITA. *Id.* In fact, Petitioner's expert, Dr. Delson, confirmed during deposition that he "was not asked to give an opinion on whether a POSITA would understand if there was undisclosed new matter." EX2015, 24:19-21. Petitioner cannot meet its burden of showing the '441 Patent is eligible for PGR by having Dr. Delson—who testified he is "at least a person of ordinary skill in the art"—avoid the written description issue entirely. *See* EX1002, ¶15; EX2015, 22:12-15; EX2028, ¶¶43-45.

Because Petitioner has not provided *any* evidence showing a POSITA would find Figure 2 of the '813 Application included new matter, Petitioner has necessarily failed to meet its burden to show the '441 Patent is eligible for PGR.

2. The evidence of record establishes that a POSITA would find Figure 2 of the '813 Application did not include new matter.

The only evidence of record regarding the understanding of a POSITA establishes that a POSITA would understand the disclosure of the '195 Application "*reasonably conveys to those skilled in the art* that the inventor *had possession of the claimed subject matter*" of Figure 2 of the '813 Application. *In re Owens*, 710

F.3d 1362, 1366 (quoting *Ariad*, 598 F.3d at 1351); *see* EX2028, ¶¶40-54; EX2001, ¶¶10-32.

The Board has consistently held that a design patent cannot be deprived of its priority claim based on minor inconsistencies in the drawings so long as the inventor was in possession of the design as a whole. *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))); *Asano*, 201 U.S.P.Q. 315 (“Mechanical 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.”).

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. EX2028, ¶46.

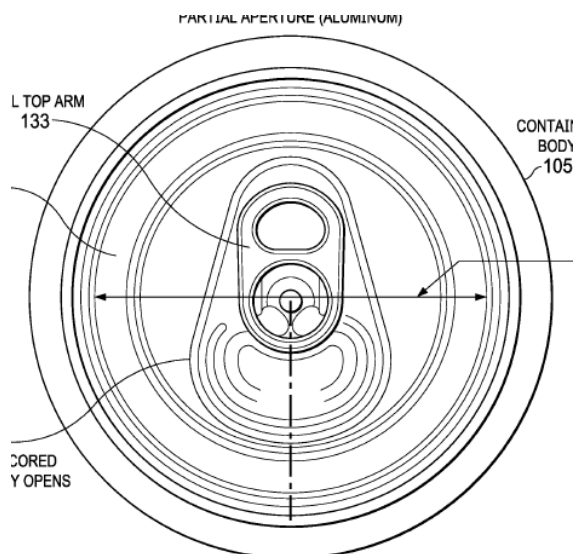


Figure 4

EX2002, 106
('195 Application)

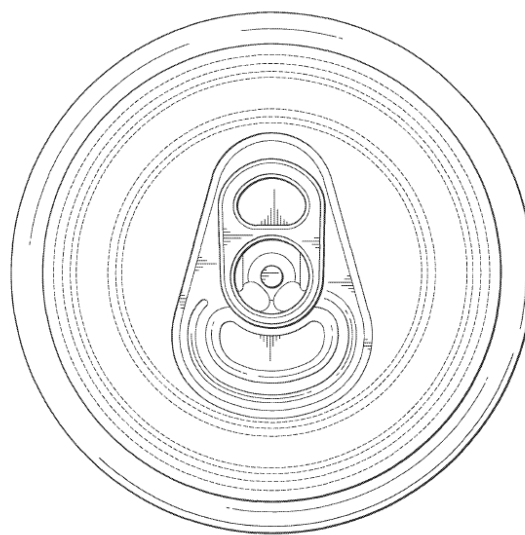


FIG. 2

EX1003, 187
('813 Application)

A simple comparison of these figures shows that the inventor was in possession of the “design as a whole.” *David’s Bridal*, Paper 9 at 15. Dr. Rojas confirms that “a POSITA would understand these drawings show the same design” and that “there is no new matter.” EX2028, ¶48.

As Dr. Rojas establishes, 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. EX2028, ¶50 (“A POSITA...would immediately recognize that the design as a whole...was the same design.”). The specific feature Petitioner identifies as allegedly new matter is well understood by a POSITA based on the drawings and detailed description of the ’195 Application. *See* EX2028, ¶¶47-50. More specifically, a POSITA would have

understood there was no new matter included in Fig. 2 of the '813 Application. EX2028, ¶54. As noted above, Petitioner does not provide *any* evidence from a POSITA to dispute this point and, in fact, did not even ask its POSITA expert to consider the issue. *See* Pet., 5-7; EX1002, ¶15; EX2015, 22:12-15, 24:19-21; Ex.2028, ¶¶51-54.

Beyond Dr. Rojas's testimony regarding the understanding of a POSITA, Mr. Kirkpatrick—a patent illustrator with over 32 years of experience—also testifies that “both figures reflect the same product design.” EX2001, ¶19; *see also*, ¶¶10-32. Mr. Kirkpatrick attributes the minor differences to “choices in drafting strategy of the respective illustrators,” noting 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, ¶¶5,19,20. 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. Dr. Rojas explains that a POSITA would agree with Mr. Kirkpatrick's determination that the drawings “reflect the same product design” and that no new matter was added. EX2028, ¶51 (quoting Ex.2001, ¶19).

Because the only evidence of record regarding the understanding of a POSITA shows the inventor was in full possession of the invention in satisfaction of the written description requirement, Petitioner has failed to meet its burden. Therefore,

AIA § 3(n)(1)(B) is not met, and the '441 Patent is not eligible for PGR.

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

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 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. EX2028, ¶¶55-65; *see infra* § III.B.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. EX2028, ¶56.

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)”); Ex.2028, ¶57.

A POSITA understood that PET is a transparent material. EX2028, ¶57. The Handbook itself confirms this understanding. EX2028, ¶58; EX1017, 22-23, 28-29. The Handbook 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; Ex.2028, ¶58.

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; Ex.2028, ¶59.

Further, the other exemplary materials recited in the specification are also transparent. EX2028, ¶60. 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. Ex.2028, ¶61.

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. Ex.2028, ¶62.

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. EX2028, ¶¶62-65.

The exemplary liquids described in the '441 Patent description are transparent or translucent. EX2028, ¶63. 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. EX2028, ¶63; 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. EX2028, ¶63; 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. EX2028, ¶63.

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. EX2028, ¶64 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.” EX2028, ¶64.

Container Shape

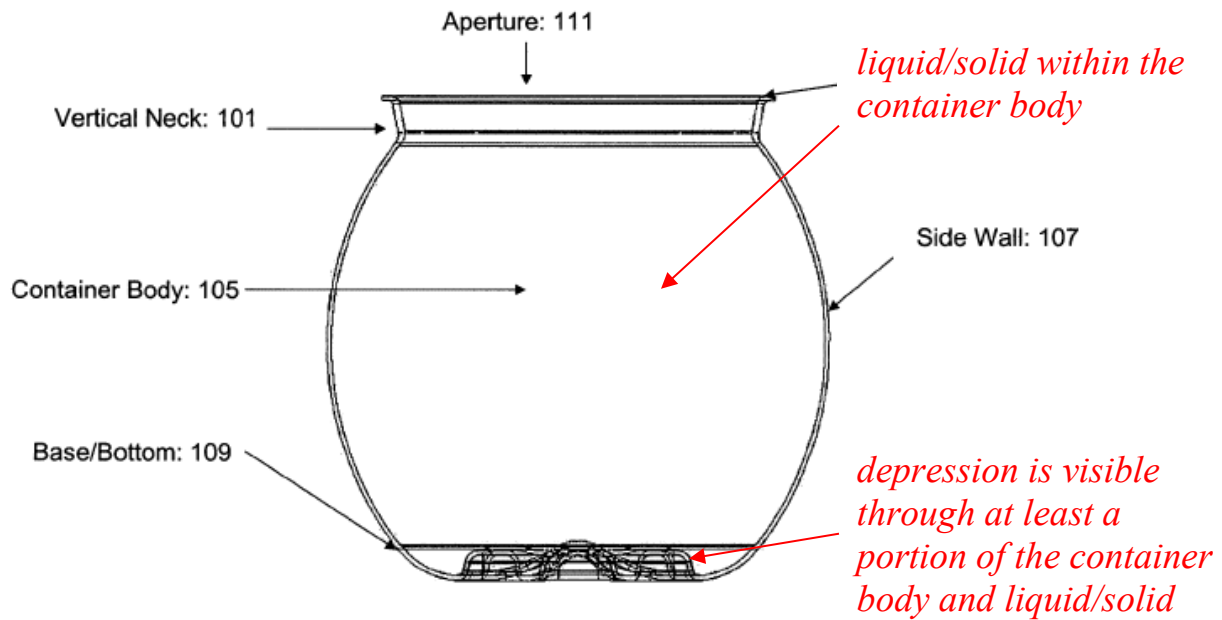


Figure 1

EX1001, Fig. 1 (annotated)

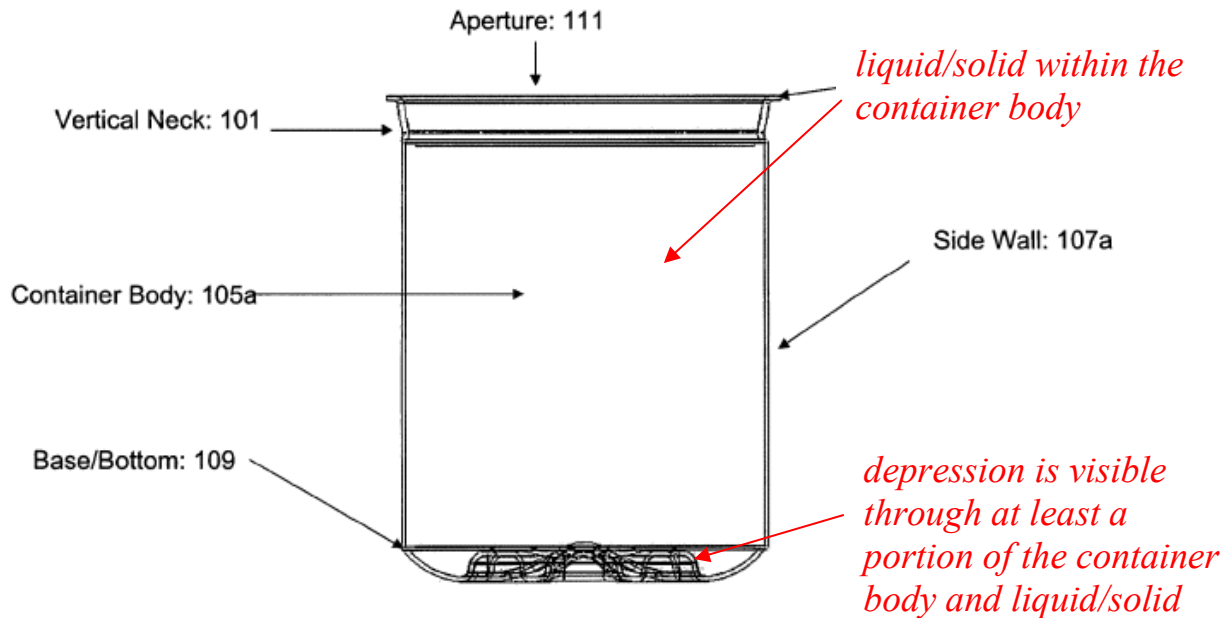


Figure 2

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.¹ EX2028, ¶65.

For at least these reasons a POSITA would have recognized that the inventor 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. EX2028, ¶66.

IV. PETITIONER'S GROUNDS 1 AND 2 FAIL BECAUSE PETITIONER HAS NOT AUTHENTICATED THE EVIDENCE RELIED UPON

A. Petitioner relies upon an unauthenticated Sprite Can for Grounds 1 and 2.

Grounds 1 and 2 of the Petition rely on a Sprite Can. *See* Pet., 13 (“Petitioner selected a Sprite Can.”), Pet., 15-68 (mapping Sprite Can to claim limitations). The Petition refers to this Sprite Can as “[t]he Coca-Cola PET Can” or “Coca-Cola

¹ 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.

PCAN.” Pet., 15, n.3. According to Petitioner, the Sprite Can “is a beverage container with a plastic body and an aluminum lid that was manufactured and publicly sold from 1985-1986.” Pet., 13. According to Petitioner, the Sprite Can was sold “in Western Georgia and Eastern Alabama for around six months” “starting in October 1985.” Pet. 14. However, as shown below, Petitioner has failed to establish the public availability and authenticity of the Sprite Can.

B. Petitioner has not authenticated the Sprite Can.

Petitioner has not authenticated the Sprite Can for several reasons.

First, although Mr. Norris identified four features that allegedly authenticate a Coca-Cola PET Can, neither he nor Petitioner have shown these four features on the Sprite Can relied upon.

Second, even if Mr. Norris’s four authenticating features were shown, Mr. Norris’s testimony regarding the four authenticating features has been inconsistent, uncorroborated, and unreliable.

Third, Petitioner has also not provided sufficient evidence corroborating Mr. Norris’s declaration that Coca-Cola PET Cans were publicly available during the time-period alleged.

Fourth, even if Petitioner had proven that Coca-Cola PET Cans were publicly available during the time-period alleged, Petitioner has not established that either the

Sprite Can relied upon in the Petition or the cans in Mr. Norris's possession are examples of the Coca-Cola PET Cans that were allegedly publicly available.

1. The images Mr. Norris reviewed do not show the four features identified as authenticating.

In his declaration, Mr. Norris identifies four specific features that would indicate the Sprite Can is authentic. These features include (1) a Canning Label, (2) a Recycling Label, (3) a Product Specific Bar Code, and (4) a Petainer Mark. Mr. Norris's testimony, on its face, cannot reliably authenticate the Sprite Can because the images Mr. Norris reviewed do not show these features and Mr. Norris never inspected Petitioner's cans in person.

Regarding the Canning Label, Mr. Norris testified in his declaration that "[e]ach PET can filled and assembled in the Columbus, Georgia facility bore a label that stated 'CANNED UNDER THE AUTHORITY OF THE COCA-COLA COMPANY, ATLANTA GA. BY COLUMBUS COCA-COLA BOTTLING COMPANY, COLUMBUS, GA 31908[']'." EX1005, ¶33.

For the Recycling Label, Mr. Norris's declaration states that "[t]he labels further were labeled 'CONSUMER/RECYCLING INFORMATION CALL 1-800-GET-COKE (438-2053)'." EX1005, ¶33.

For the Bar Code, Mr. Norris said the labels "bore a bar code unique to the beverage being sold to aid in supermarket scanning." EX1005, ¶33. Mr. Norris testified that, for each can, this bar code included "the same Universal Product Code,

but each of them have a unique number” that “identif[ies] the unique beverage you are buying or unique product you’re buying.” EX2014, 27:8-12.

For the Petainer Mark, Mr. Norris testified that “each PET can also included a mark on the pushup portion of the base that identified Petainer S.A. as the manufacturer of the PET can body.” EX1005, ¶34. Elsewhere in his declaration, Mr. Norris added that the Petainer Mark included a “PETAINER” label “on the base in CAPS and the patent # PAT 4,405,546 and other designs.” EX1005, ¶35.

On cross-examination during his deposition, Mr. Norris confirmed each of these four specific authenticating features, *see* EX2014, 25:13-27:18, and verified that “these four markings are indicative of an authentic” can. EX2014, 27:19-21. Mr. Norris further testified that he used *only* these four features to form his opinion regarding the authenticity of Petitioner’s can. *See* EX2014, 27:19-21 (“Q. Okay. And these four markings are indicative of an authentic Coca-Cola PCAN, correct? A. They are.”); 28:4-7 (“Q. Okay. Are there any other markings that you relied upon to identify the PET can products in MPL counsel’s possession as authentic Coca-Cola PCANs? A. No.”).

Mr. Norris testified that the basis of his authentication of Petitioner’s cans was a comparison of these four authenticating features on Petitioner’s counsel’s cans and cans in his possession. *See* EX1005, ¶36 (“Based on the markings of the PET can products in possession of MPL and a comparison of these products to the ones in my

possession, I can verify that the Coca-Cola PET cans...are the same products that were commercialized by Coca-Cola in 1985 and 1986.”); *see also* EX2014, 27:22-28:3 (Referring “to paragraph 36,” “are you referring to the four different markings we just discussed? A. Yes.”). However, Mr. Norris never physically examined or handled Petitioner’s counsel’s cans:

Q. And have you ever physically seen or physically handled any of the cans in MPL counsel’s possession?

A. No.

EX2014, 21:9-12.

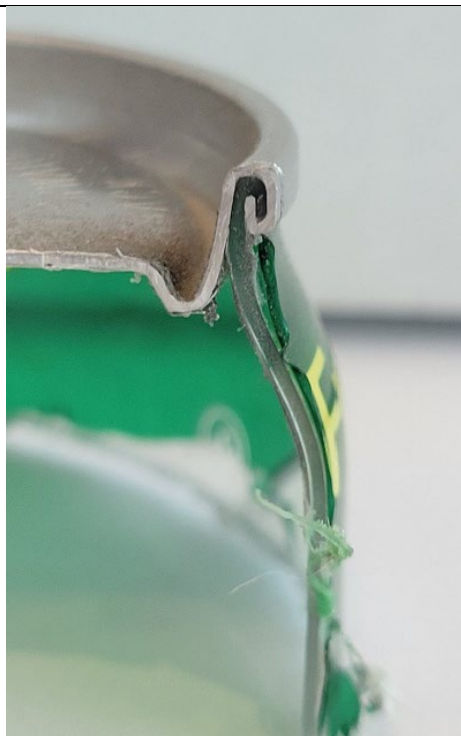
Mr. Norris’s comparison was “[b]ased on the photographs that were supplied to [him].” EX2014, 28:2-3. But Mr. Norris never explained what images he reviewed. And although he testified that he did not rely on “any other documents or evidence beyond what is referenced in [his] declaration,” EX2014, 16:17-21, the images in his declaration do not show the four authenticating features he identified. None of the images in his declaration, all shown below, illustrate the Canning Label, the Recycling Label, or the Bar Code.



EX1005, ¶16



EX1005, ¶17



EX1005, ¶24

At best, these images show a single, unclear photograph of the Petainer Mark of the can. *See* EX1005, ¶16. But this photograph does not provide a clear enough view to confirm the words of the Petainer Marking, described by Mr. Norris as including “PETAINER on the base in CAPS and the patent # PAT 4,405,546 and other designs.” EX1005, ¶35. Mr. Norris does not explain what exactly the “other designs” of the Petainer Mark are either.

The images in the Petition and Dr. Delson’s declaration also do not show all four authenticating features, adding only depictions of a bar code. *See* Pet., 16, 21-24, 27 (showing barcode of Sprite Can sample); 55 (showing additional text with insufficient clarity to confirm either the Canning Label or Recycling Label);

EX1002, ¶¶39, 45-48, 50, 58 (corresponding images). The mere presence of a bar code is common to nearly every product sold anywhere in world and hardly authenticates Petitioner's cans. Notably, Petitioner and Mr. Norris have not provided any evidence to corroborate that the provided bar code is the correct bar code for a Sprite Can of the time-period alleged.

Even if Mr. Norris's account of the four authenticating features is accurate, there is no way to confirm the Sprite Can includes these features with the evidence provided.

2. Mr. Norris's testimony regarding the four authenticating features is uncorroborated, inconsistent, and unreliable.

As explained above, Mr. Norris set forth in his declaration the four allegedly authenticating features, including the Canning Label, Recycling Label, Bar Code, and Petitioner Mark. *See* EX1005, ¶¶33-35. Mr. Norris confirmed each of these features verbatim on cross-examination. *See* EX2014, 25:13-27:18. However, Mr. Norris has not provided any corroboration for his assertion that these four features can reliably indicate an authentic can. As explained above, unsupported witness testimony is given little weight. *See* 37 C.F.R. § 42.65(a); *Xerox*, IPR2022-00624, Paper 9 at 16.

In addition to this lack of corroboration, Mr. Norris's testimony regarding these features is inconsistent. On redirect during his deposition, when Petitioner's

counsel asked Mr. Norris about the Recycling Label, Mr. Norris realized that a can in his possession did not match his declaration:

Q. And do you see in – and if you look in paragraph 33 of your declaration, the last sentence quotes – says, “The labels were further labeled, quote, ‘Consumer/Recycling information call 1-800-GET-COKE (438-2053).’”

Do you see that in your declaration?

A. I do, but I’m looking at the can, and *the correct number is 438-2653*.

EX2014, 34:20-35:2.

During this same exchange, Mr. Norris also noticed that another can in his possession was labeled differently than he originally testified:

Q. Okay. And can you look at the Coke Classic can you said you have there in your possession?

A. Yes, I'm looking at it.

Q. Okay. Can you look on the label.

Does that contain the same -- same phrase that is in your declaration regarding the consumer recycling?

A. Yeah. This particular one says “Consumer/recycling information call 1-800-GET-COKE,” *but it doesn't have the translation into the numeric equivalent*.

EX2014, 35:11-20.

These discrepancies in Mr. Norris's testimony—Petitioner's sole support for authenticating its prior art—make it impossible to determine the authenticity of the Sprite Can and the cans in Mr. Norris's possession. If the four authenticating features from Mr. Norris's declaration and cross-examination are accurate, then are the cans in Mr. Norris's possession not authentic because they do not have the correct matching features? Which of the three conflicting versions of the Recycling Label that Mr. Norris has testified about, if any, did Mr. Norris observe when reviewing images of Petitioner's Sprite Can? Put simply, it is impossible to determine whether the Sprite Can relied upon in the Petition is authentic based on Mr. Norris's testimony.

Relatedly, these discrepancies raise the question of whether Mr. Norris produced these four authenticating features from his own “personal knowledge and recollection,” EX1005, ¶1, or whether Mr. Norris identified the four authenticating features by looking at the cans in his collection and choosing some features that seemed to indicate whether a PCAN was authentic. If the latter, Mr. Norris likely admitted that he is not qualified to select which specific features of a vintage Coca-Cola product distinguish a genuine example from a replica. During his deposition he said that he does not have “*any knowledge*” of fake Coca-Cola products or trademark-related items that would be necessary to distinguish authentic products from fake ones. *See, e.g.*, EX2014, 31:21-22 (referring to his collection as

“somewhat minor”), 32:8-12 (explaining that he does not keep “any documentation of the items in [his] collection”), 33:3-12 (acknowledging that he is “not aware” of “any fake versions of Coca-Cola products or memorabilia” and he “do[es]n’t have *any knowledge* of that.”).

These discrepancies, particularly when taken together and weighed against Mr. Norris’s assertion that *only* these four features authenticate the Sprite Can, cast doubt as to the reliability of Mr. Norris testimony regarding these features, which already lacks any form of corroboration.

3. Petitioner has not provided sufficient evidence to show that the Sprite Can was publicly available.

Even if, despite the problems outlined above, Mr. Norris’s testimony was taken to be true, Petitioner has not made a sufficient showing that the Sprite Can specifically photographed and relied upon in the Petition was publicly available. In total, Petitioner has provided (1) the uncorroborated and inconsistent testimony of Mr. Norris, (2) two news articles from 1985 that report Coca-Cola announced that it *would* test market plastic cans, and (3) paper advertising material for a Coke can with a 1985 copyright date. Based on past Board decisions, this evidence is insufficient.

In *AQ Textiles v. Arun Agarwal*, a petitioner similarly relied on a physical product—the “Valiant 600” bed sheets—as prior art in its petition. *AQ Textiles, LLC v. Arun Agarwal*, PGR2017-00042, Paper 10 at 14 (PTAB Feb. 7, 2018). To show

public availability, the petitioner provided (1) testimony from the “manager for the manufacturer of the Valiant 600 sheets” testifying “to manufacture and sale of the product,” (2) “a sales invoice pre-dating the priority date,” and (3) “lab reports for the sheets also pre-dating the priority date.” *Id.* at 13-15. The Board held that this evidence was “*sparse*” but “sufficient” for purposes of institution. *Id.* at 15.

Like the petitioner in *AQ Textiles*, in this case, Petitioner has relied on the testimony of the manager for the manufacture of the alleged prior art—Mr. Norris. But Mr. Norris’s testimony is not supported by anything like the sparse evidence in *AQ Textiles*. *Id.* Petitioner has not provided any sales invoice predating the priority date showing any sale of the PCAN of any kind. Petitioner has also not produced any evidence of the development, design, and testing of the PCAN, such as the lab reports provided in *AQ Textiles*.

In this case, while both news articles predate the priority date, they only state that Coca-Cola *planned* to test market the PCAN—not that Coca-Cola ever actually sold a plastic can. *See* EX1015 (“Coca-Cola *plans to* test market a plastic container”); EX1016 (“Coca-Cola U.S.A. said today that it *will begin* testing a plastic soft-drink can this week”). Both news articles are unrelated to Coca-Cola, and don’t appear to have any connection to or presence in the very narrow geographical area of the alleged test market. *Compare* EX1005, ¶20 (“Western

Georgia and Eastern Alabama”); *with* EX1015 (“Los Angeles Times”); EX1016 (“The New York Times”).

The only date found on the paper advertisement is a copyright date indicating 1985. *See* EX1006. However, a copyright date on prior art itself is alone “insufficient, without other persuasive evidence” that the product was on sale. *Telebrands Corp. v. Tinnus Enters., LLC*, PGR2016-00030, Paper 16 at 21-22 (PTAB Feb. 21, 2017); *see also Wright Med. Tech., Inc. v. Biomed. Enters. Inc.*, IPR2015-00786, Paper 7 at 9-10 (PTAB Aug. 10, 2015). Here, the paper advertisement is not even the prior art and does not reference the Sprite Can specifically relied upon at all.

Other Board decisions further confirm Petitioner's showing in this case is insufficient. In *Pelican Biothermal v. Va-Q-Teq AG*, the petitioner submitted two pieces of product prior art for insulated containers identified by their part numbers—a “98330-type product” and a “98596-type product.” *Pelican Biothermal, LLC v. Va-Q-Teq AG*, PGR2021-00085, Paper 9 at 61-63 (December 17, 2021). The Board rejected the first product prior art because, although the petitioner submitted “sales records that appear to show sales of a NanoCool Insulated Shipper bearing the part number ‘2-98830,’ which sales predate the priority date,” there was no evidence that the “photos of a product that purports to be a 98330-type product” was actually the same product. *Id.* at 62-63. For the second product, however, the Board “reach[ed]

a different result” because “the 98596 sample includes a sticker on the sample itself that provide a part number (‘P/N 2-98596’), a description as ‘985 Long Haul Shipping Unit,’ and indicates expiry in ‘04/2015.’” *Id.* at 63. Based on this evidence supporting the witness testimony, the Board could determine that “the 98596-type product and physical sample that [was] photographed was made...before the...priority date.” *Id.* In this case, although food and beverage products would be expected to include an expiration date, no such expiration date has been identified by either Petitioner or Mr. Norris.

Like the first product in *Pelican Biothermal*, the photographs of the Sprite Can provided by Petitioner do not show any self-corroborating date. Further, no sales invoices have been provided, let alone evidence that definitively identifies the prior art, which was lacking in *Pelican Biothermal*. Petitioner has provided virtually no evidence supporting Mr. Norris’s testimony and the evidence falls well short of the “sparse” but “sufficient” evidence offered in *AQ Textiles*. Testimony not supported by corroborating evidence is given little to no weight. *See* 37 C.F.R. § 42.65(a); *Xerox*, IPR2022-00624, Paper 9 at 16. Accordingly, Petitioner has not demonstrated that the Sprite Can is prior art.

4. Petitioner has not established that the cans in its possession or the cans in Mr. Norris's possession were part of the allegedly publicly available cans.

Finally, when relying on product prior art, it is not enough to only show that a group of products was publicly available before the priority date. A petitioner must also demonstrate that the specific sample relied upon is, in fact, of the same group of products that was publicly available. As explained above, Petitioner has failed to meet its burden to show that the Coca-Cola PET Can was, in fact, publicly available. But, to the extent the Board disagrees, Petitioner has also failed to meet the second requirement. Petitioner has provided practically no evidence regarding the origin or chain of custody of the Sprite Can or the cans in Mr. Norris's possession. Without meeting this second requirement, there is no way of knowing whether the Sprite Can is an example of the products allegedly sold in 1985 and 1986.

Petitioner explains that it has obtained and photographed four cans, shown below. *See Pet.*, 14.



Pet., 14

Beyond including pictures of these cans and specifically the Sprite Can relied upon, *see* Pet., *passim*, EX1002, *passim*, Petitioner has made essentially no attempt to explain their origin or chain of custody. The Petition contains a single sentence stating “Petitioner purchased a set of Coca-Cola PCANs (below) from an on-line website.” Pet., 13. When asked “how MPL’s counsel obtained the cans in their possession,” Mr. Norris could only provide hearsay testimony: “I believe when I asked that question they said they purchased them on eBay.” EX2014, 21:13-16.

Notably, Petitioner has not explained which company or individual sold the cans, where the seller obtained the cans, how the cans were stored by the seller, whether the seller made any modifications to the cans, which individual purchased

the cans (e.g., an employee of MPL or Perkins Coie), the address at which the cans were received, how or when the cans were shipped, which individual received the cans, where the cans were stored after purchase, or what was done with the cans after receiving them. Petitioner also has not explained who took photographs of the cans. We do not know whether during the allegedly 40 years of their existence, the cans experienced any deterioration or wear. Based on the images presented in the Petition and Dr. Delson's declaration, we know that some modifications were made to the Sprite Can, including cutting vertically down the middle, *see* Pet., 18, 34-50, cutting horizontally, and removing the label, *see* Pet., 72. Yet, no record or explanation has been provided documenting these modifications.

This type of documentation is critical to establishing real evidence as authentic and reliable. And the Board has frequently ruled against petitioners for failure to provide just such evidence.

For example, in *China Lithium Battery v. Contemporary Amperex*, a petitioner relied on a physical battery for several grounds of a PGR petition. *China Lithium Battery Tech. Co., Ltd. v. Contemporary Amperex Tech. Co., Ltd.*, PGR2022-00008, Paper 8 at 6 (PTAB June 6, 2022). Although the petitioner provided a "sales receipt" indicating the purchase of the specific battery, the patent owner argued that "the Petitioner and its experts provide[d] no evidence of how anyone...kept track of the specific battery that was tested" including its "purchase, storage, chain of custody,

and usage...over the years.” *China Lithium Battery Tech. Co., Ltd. v. Contemporary*

Amperex Tech. Co., Ltd., PGR2022-00008, Exhibit 2003 at 22 (PTAB Mar. 9, 2022).

The Board agreed and explained that “Petitioner...provides little evidence regarding the storage and usage of the prior art batteries between their acquisition and testing.”

China Lithium, PGR2022-00008, Paper 8 at 15. Without this additional authenticating evidence, the Board explained, it was impossible to tell if the “storage and use of [the batteries] caused any changes to the condition of the batteries that could alter” their condition. *Id.*

In *Albany v. Kimberly-Clark*, a petitioner relied on a belt fabric, “the MS015 fabric” as prior art. *Albany Int’l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 18 at 2 (PTAB Mar. 22, 2021). The petitioner purchased the fabric “after it was installed at a customer’s facility.” *Id.* at 71. The patent owner argued that the petitioner did “not explain the chain of custody of this sample” providing only an unsupported statement from a witness that “to his ‘best understanding and belief, no other alteration and testing was made to the sample(s)’ from the initial sale in 2013 to its measurement in 2019.” *Id.* The Board “agree[d] with Patent Owner that Petitioner ha[d] not shown persuasively that the samples it relie[d] upon accurately represent the fabrics that were allegedly sold” and “Petitioner makes no attempt to explain how and why the sample it tested accurately

represents the fabric that was sold.” *Albany Int’l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 22 at 29-30 (PTAB June 22, 2021).

By contrast, in cases in which petitioners do successfully authenticate physical products, evidence is provided establishing an unbroken chain of custody. *See, e.g., CQV Co., Ltd. v. Merck Patent GmbH*, PGR2021-00054, Paper 11 at 2 (PTAB Sep. 22, 2021) (“provid[ing] testimony regarding chain of custody of the tested samples”); *Cast Lighting LLC v. Wangs Alliance Corp.*, PGR2021-00012, Paper 2 at 12-13 (PTAB Nov. 24, 2020) (“attest[ing] to the unbroken chain of custody” of the prior art “to Petitioner’s expert”); *Amgen, Inc. v. Alexion Pharm. Inc.*, IPR2019-00741, Exhibit 2026 at 4 (PTAB Nov. 22, 2019) (referring to “chain of custody log,” “packing slip,” and evidence of package received for prior art evidence).

In this case, Petitioner has done nothing of the sort. Petitioner has not provided any evidence to explain how it obtained the Sprite Can or establish any reliable chain of custody to show in what way the Sprite Can was modified, either before or after being obtained by Petitioner. On this basis alone, the Board should not consider the Sprite Can as authenticated prior art.

To the extent Petitioner argues that it is exempt from any requirement to establish the origin of its cans because Mr. Norris compared the cans to his own, this argument is also unavailing.

While it is true that comparison by an expert witness can satisfy the authentication requirement, *see* Fed. R. Evid. 901(b)(3), such comparison only satisfies the Rule if the proffered real evidence is compared “with *an authenticated specimen* by an expert witness or the trier of fact.” Fed. R. Evid. 901(b)(3). Just as Petitioner failed to do with the Sprite Can, Petitioner has also failed to authenticate the cans in Mr. Norris’s possession. Neither Petitioner nor Mr. Norris provides any evidence establishing the origin or chain of custody of the cans in Mr. Norris’s possession.

Mr. Norris’s declaration only states that his “collection includes multiple Coca-Cola PET cans that were manufactured and sold during the, around, six-month period that these products were publicly available in 1985 and 1986.” EX1005, ¶32. Nothing in Mr. Norris’s declaration, however, actually explains how Mr. Norris came into possession of the cans. It is unknown whether he purchased them from a local distributor, whether they were obtained as samples or prototypes during one of his visits to Dongen, Netherlands, or at Coca-Cola’s Columbus, Georgia facility.

On redirect during his deposition, Petitioner’s counsel attempted to remedy this lack of evidence. *See* EX2014, 34:8-9 (“[H]ow did you come into possession of those cans?”). But all Mr. Norris added was that he came “into possession of [the] cans” “[f]rom the Columbus, Georgia, market trial” in “October ’85.” EX2014, 34:8-16.

Along with the absence of any explanation of the origin of Mr. Norris's cans is, again, the absence of any evidence supporting Mr. Norris's testimony. If Mr. Norris did purchase the cans, he has not provided any receipt or evidence of purchase. There are no pictures of Mr. Norris's cans predating the priority date in this case. There is no record of when the cans were added to Mr. Norris's collection. And Mr. Norris admits that he does not "keep any documentation of the items in [his] collection." EX2014, 32:8-12.

There is also no evidence establishing any chain of custody for Mr. Norris's cans. Mr. Norris testified that his collection is stored "down in [his] basement" or "sometimes" at his "desk." EX2014, 31:24-25. Although he has moved his collection, he did not keep a record of how the PET Cans were moved, other than saying his collection was "put...in boxes." EX2014, 32:7. While gaps in a chain of custody are not dispositive of an item's admissibility, *see Melendez-Diaz v. Massachusetts*, 557 U.S. 305, 311 (2009), neither Petitioner nor Mr. Norris have established any chain of custody at all, let alone a chain of custody stretching back the nearly 40 years that would be required in this case.

For these additional reasons, the Board should not consider the Sprite Can authenticated prior art.

* * *

Because Petitioner has not (1) shown that Mr. Norris observed the four features he indicates authenticate Petitioner's Sprite Can, (2) provided any evidence corroborating the four features as indicative of an authentic can, (3) established plastic cans were publicly available in the time-period alleged, or (4) established Petitioner's Sprite Can or the cans in Mr. Norris's possession are part of the allegedly publicly distributed plastic cans, Petitioner has failed to establish the Sprite Can relied upon in the Petition is prior art. Accordingly, Grounds 1 and 2, which rely on the Sprite Can for all challenged claims fails.

V. THE COMBINATION OF THE SPRITE CAN WITH PROTAIS DOES NOT RENDER THE CLAIMS OBVIOUS

Petitioner's Ground 2 combines the Sprite Can with the base of Protais and is used to challenge claims 9-20 of the '441 Patent. *See* Pet., 3-4. As an initial matter, Ground 2 fails for the same reasons described above with reference to Ground 1. Petitioner has not sufficiently authenticated the Sprite Can. *See supra* § IV. In addition, Petitioner's proposed combination of the Sprite Can with Protais's base does not render obvious claims 9-20 for the additional reasons presented below. EX2028, ¶67.

A. Petitioner has not identified an adequate motivation to combine the Sprite Can with Protais's base.

For a patent claim to be obvious based on a combination of prior art references, "there must exist a motivation to combine" them. *Virtek Vision Int'l ULC*

v. Assembly Guidance Sys., Inc., 97 F.4th 882, 887 (Fed. Cir. 2024). Petitioner

reasons that a POSITA would have been motivated to combine the Sprite Can with Protais's base because both are "plastic" and "circular." Pet., 70. Petitioner also argues that a POSITA would implement Protais's base with the Sprite Can because "Protais's ribs, notches, and/or grooves" provide "increased strength and resistance to deformation" to make the Sprite Can shorter. Pet., 70; EX2028, ¶68.

Petitioner's reasoning overlooks several intended functions provided by the specific design features of the Sprite Can base that would be lost if replaced with the Protais base, as described below. It is clear that Petitioner's proposed combination is improperly based on the claims of the '441 Patent and not the teachings of the references themselves. *See TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1361 (Fed. Cir. 2019) (patent challenger may not "use the challenged patent as a roadmap to reconstruct the claimed invention using disparate elements from the prior art"); EX2028, ¶69.

As Mr. Norris testified, the Sprite Can was designed to mimic a standard aluminum soda can as closely as possible. *See* EX1005, ¶21 ("The PET can is very close in shape and size to the existing 12oz aluminum can and mimicked its profile."). Mr. Norris further explained that the "changes in the shape of the PET can body" were "minor" and "did not materially affect the filling and assembly process." EX1005, ¶22. After filling, the PET cans were stacked like normal when they "were

palletized like aluminum cans.” EX1005, ¶22; EX2028, ¶70.

The bottom of a standard 12oz aluminum can is shaped specifically to be nested within the can top so that the cans are stable when stacked. EX2028, ¶71. This feature is illustrated by Cheng, below, which describes standard “12 ounce cans having 202 ends, and bottoms.” EX2016, 8:24-28; EX2028, ¶71.

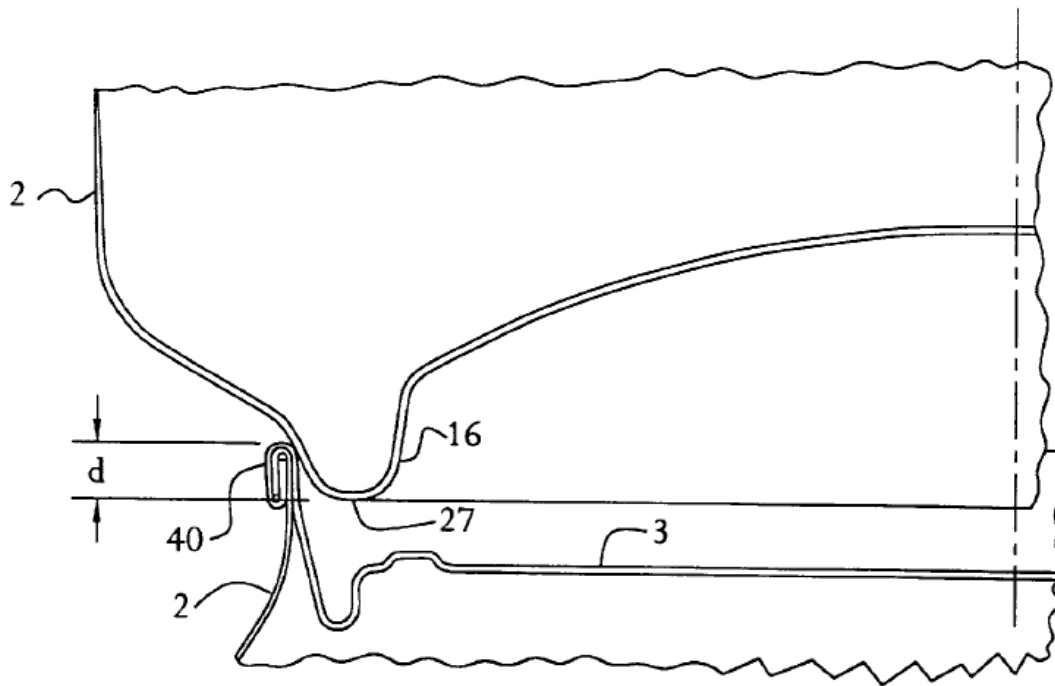


FIG. 3

EX2016, Fig. 3

As shown above, “an annular nose 16 extends downwardly from the frustoconical portion 8.” EX2016, 4:41-42; EX2028, ¶72. The diameter between the annular nose 16 is selected so that “when two similarly constructed cans are stacked one atop the other, the bottom 6 of the upper can will penetrate into the end 3 of the

lower can so that the base 27 of the nose 16 of the upper can extends a distance d below the lip formed on the seaming panel 40 of the lower can.” EX2016, 5:22-27. These geometries of typical beverage cans are elsewhere described as “interlocking means” that enable “stable, interlocking stacking in packaging to create packaging alternatives.” EX2017, 1:41-42, 3:39-42, Figs. 2-3; EX2028, ¶72.

The bottom of the Sprite Can, like the bottom of conventional 12 oz cans, includes these same interlocking features. EX2028, ¶73.



Pet., 16 (annotated)

As shown above, the Sprite Can includes an annular nose that, like the annular nose of a standard 12oz can, is shaped to nest between the outer rim of another Sprite Can's lid. EX2028, ¶74. Accordingly, the outer diameter of the annular nose of the base is slightly smaller than the inner diameter of the lid. After filling, the PET cans

were stacked when they “were palletized like aluminum cans.” EX1005, ¶22; EX2028, ¶74.

In addition, the domed shape of the Sprite Can bottom, in addition to being strong against internal pressure, creates the necessary space to accommodate the pull-tab of another can when the cans are stacked, as shown by Cheng, below. EX2028, ¶75.

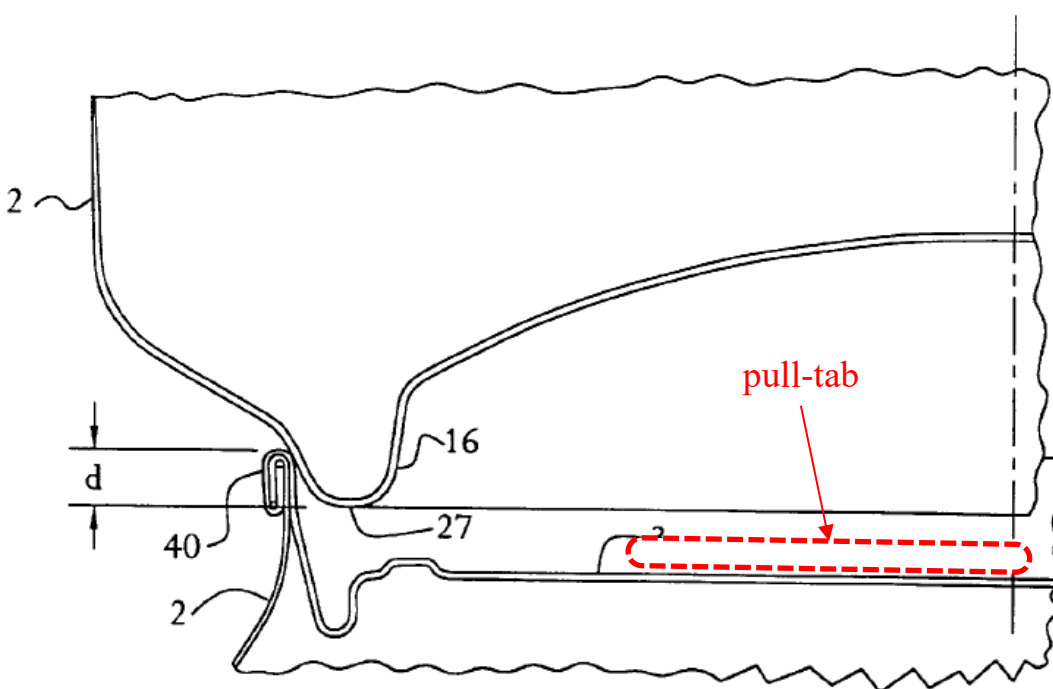


FIG. 3

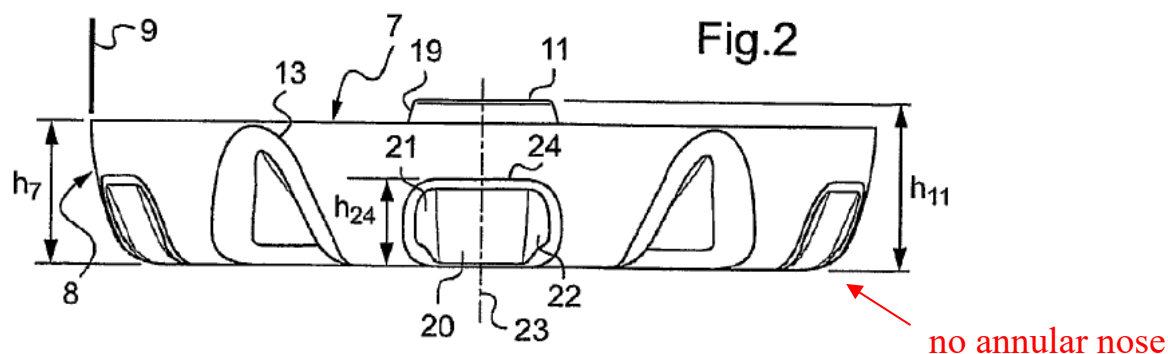
EX2016, Fig. 3 (annotated)

Simply replacing the bottom of the PCAN with the bottom described by Protais, as Petitioner suggests, would take away these features providing the stackability of the Sprite Can. EX2028, ¶76. A POSITA would certainly evaluate

these features in selecting suitable alternative designs for the bottom of the Sprite Can. EX2028, ¶76. As shown below, Protais's bottom does not include the desired features. EX2028, ¶76. For example, Protais's base does not include any annular nose that would extend into the lid of another PCAN when stacked. EX2028, ¶76.

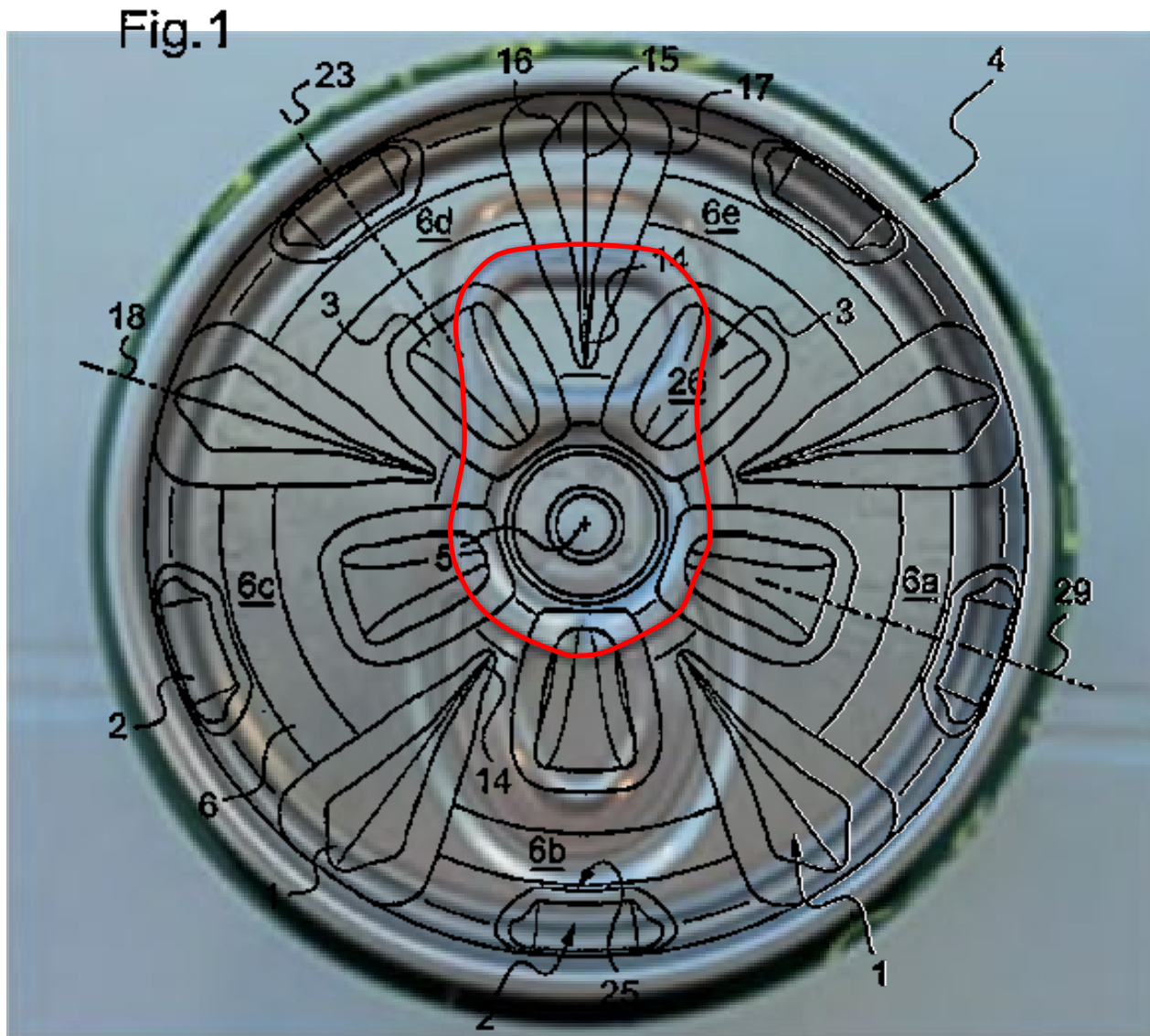


Pet., 16 (cropped and annotated)



Protais, Fig. 2 (annotated)

Protais's bottom similarly does not include an adequate space to accommodate the pull-tab when stacked, as shown by the figure below, overlapping Protais's base over the PCAN's lid. EX2028, ¶77.



**EX1008, Fig. 1 overlaid over figure from Pet., 16
(pull-tab outlined in red)**

Even assuming Protais's base would fit within the Sprite Can's lid, as shown above, it would contact the pull-tab of the Sprite Can lid, causing it to rest on an uneven surface (i.e., the pull-tab). EX2028, ¶78. This uneven contact would cause the upper Sprite Can to rock in response to external forces, significantly impairing

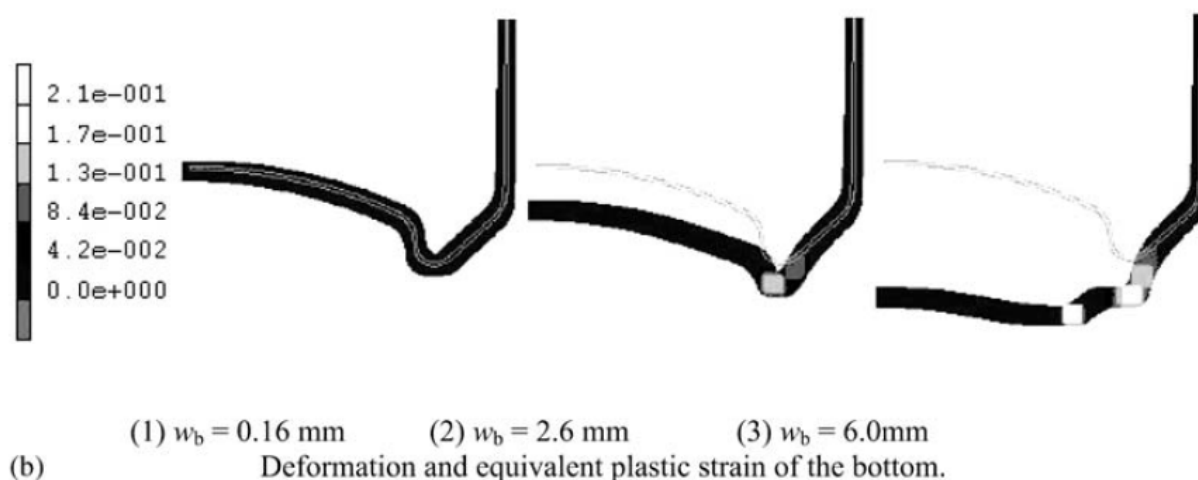
the stability of stacked cans. EX2028, ¶78.

Petitioner's first proposed reason for the modification—"increased strength," Pet., 70—would be far outweighed by either a significantly greater risk of falling if PCANs were stacked or significantly increased complexity of storage and transportation if the PCANs could not be stacked. EX2028, ¶79. Petitioner's second proposed reason—"making the Coca-Cola PCAN shorter...allowing the user of standard filling and packaging equipment," Pet., 70—is also far outweighed by the greater risk of falling when stacked, as well as rebutted by the testimony of Mr. Norris, who explained that "[t]he minor changes" between the PCAN and standard aluminum cans "did not materially affect the filling and assembly process." EX1005, ¶22; EX2028, ¶79. Because neither of Petitioner's proposed reasons for modification are correct, the claims of the '441 Patent improperly provide the only reason for replacing the Sprite Can's base with the base of Protais's unrelated container.

In addition, ample documentation shows that the dome shaped base of standard cans is not only adequate, but superior for resisting internal pressure and conserving material used. EX2028, ¶80. For example, Han described an "optimization technique" for "beverage bottle design" in which the ideal dome shape was determined to be a dome shape similar to the bottom of the Sprite Can. *See* EX2020, 310 (Fig. 10a). Han shows, below, how a domed bottom of a can deforms under internal pressure without failure because the dome may bulge downward while

preserving the shape of the remainder of the container. *See* EX2020, 306 (Fig. 3b).

Protais's bottom does not allow for this deformation of the bottom while preserving the shape of the remainder of the bottle. EX2028, ¶80.



EX2020, 306 (Figure 3b)

Given that the design of the Sprite Can's bottom is already adequately strong against internal pressure from carbonation while also preserving the interlocking features important for stacking, storing, and transporting, a POSITA would not have been motivated to modify the PCAN base to one of presumably equal strength but sacrificing interlocking features when stacked. EX2028, ¶81. For at least these reasons, a POSITA would not have been motivated to modify the PCAN base as Petitioner suggests.

Accordingly, the combination of the Sprite Can and Protais does not render obvious claims 9-20 of the '441 Patent.

B. Ground 2 of the Petition does not set forth the mapping of the prior art with particularity.

An IPR petition must identify “*with particularity*...the evidence that supports *the grounds for the challenge* to each claim.” 35 U.S.C. § 312(a)(3). Petitioner’s Ground 2 fails to do so at least for multiple limitations of claim 15. EX2028, ¶83.

The Petition initially explains its proposed combination for Ground 2 as “a container that has the body and lid of the Coca-Cola PCAN, *and Protais’ bottom*.” Pet., 69. It continues that “[t]he chart below illustrates claims 9-20 are obvious in view of *the combination*.” Pet., 70; EX2028, ¶84.

Independent claim 15 includes multiple limitations (at least limitations [15.E]-[15.J] and [15.L]-[15.M]) that recite a container bottom with various features. *See, e.g.*, EX1001, 4:14-16 (Limitation [15.E]) (“*a base portion*”), 4:17-19 (Limitation [15.F]) (“*base portion comprises a bottom and a first depression...*”), 4:20-21 (Limitation [15.G]) (“*first depression...partially defines a first outline*”), 4:22-24 (Limitation [15.H]) (“*base portion further comprises a center element*”). For each of these limitations, Petitioner provides no analysis explaining how its proposed combination of the Sprite Can with *Protais’* bottom renders the claim limitations obvious. Instead, the Petition only includes citations to the claim 1 analysis. However, given that Petitioner’s Ground 2 proposes a combination of the Sprite Can and Protais, it is unclear whether these citations, presumably to the claim 1 analysis from Ground 1, are intended to show how the Sprite Can’s bottom rendered the

limitations above obvious, particularly given the proposed combination of the Sprite Can with Protais's bottom. EX2028, ¶85.

As an example, limitation [1.G] recites “*wherein the first depression at least partially defines a first outline.*” EX1001, 4:20-21. Ground 2 purports to show how the combination of the Sprite Can's container and lid combined with Protais's bottom render claims 9-20 obvious. *See* Pet., 69. According to this combination, Ground 2 would presumably show how Protais's bottom includes a “*first depression*” that “*at least partially defines a first outline.*” The Petition's reference to Ground 1 only addresses the Sprite Can alone. This mapping is inconsistent with Ground 2, and does not show how Protais's bottom discloses or renders obvious the limitation. To the extent the Petition meant to refer the reader to the analysis in Ground 3, such an internal reference is not at all clear, and the analysis in Ground 3 is inconsistent with Ground 2 because it combines Protais's bottom with Metzger's container. In addition, to the extent the Petition's analysis for limitation [15.G] of Ground 2 refers to the analysis of Ground 3, Protais's bottom does not disclose or render obvious a “*first depression*” that “*at least partially defines a first outline.*” *See infra* § VI.C (explaining how the first depression of Protais's bottom identified by Petitioner does not partially define the first outline identified by Petitioner). However, Patent Owner maintains that the internal references for at least limitations [15.E]-[15.J] and [15.L]-[15.M] are not sufficiently clear to meet the requirement

that a petition identify “with particularity...the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). Accordingly, Ground 2 is also insufficient to render obvious claim 15, as well as claims 16-20 depending from claim 15. EX2028, ¶86.

VI. THE COMBINATION OF METZGER, PROTAIS, AND KAMINSKI DOES NOT RENDER THE CLAIMS OBVIOUS

Petitioner's Ground 3 presents a combination of Metzger, Protais, and Kaminski. For the reasons presented below, Petitioner's Ground 3 does not render the claims obvious. EX2028, ¶87.

A. Metzger does not disclose a container body...made out of a resin, as required by limitation [1.C].

Limitation [1.C] recites “*wherein the container body is made out of a resin.*” EX1001, 4:12. Claims 2, 5-6, and 8 add that “*the resin is a polyethylene terephthalate (PET) resin.*” EX1001, 6:4-6, 12-21, 26-29.

None of the prior art references of Ground 3 make any reference to “*a resin,*” or “*a polyethylene terephthalate (PET) resin.*” Instead, the Petition simply says that “Metzger's container was made of ‘various plastics’” and “plastics *can* be made out of a resin.” Pet., 108 (quoting EX1010, 3:56-58). Petitioner's analysis is insufficient for at least two reasons. EX2028, ¶89.

1. Petitioner's argument that plastics are equivalent to resins invokes inherency and is not supported by any evidence.

By equating plastic with resin, Petitioner is, effectively, arguing that any disclosure of plastic inherently also discloses a resin. If a claim limitation is not disclosed by the prior art, a patent challenger can fill the gap if the missing limitation “is *necessarily* present, or inherent” in the prior art. *In re Montgomery*, 677 F.3d 1375, 1380 (Fed. Cir. 2012). “The inherent result *must inevitably result* from the disclosed steps.” *Id.* It “may not be established by probabilities or possibilities.” *Id.* (quoting *Bettcher Indus., Inc. v. Bunzl USA, Inc.*, 661 F.3d 629, 639 (Fed. Cir. 2011)). For limitation [1.C], Petitioner has not demonstrated that all plastics are “necessarily” or “inevitably” resins, as it must, given the lack of disclosure of resin in the prior art. Rather, Petitioner merely argues that “plastics *can* be made out of a resin.” Pet., 108. Therefore, Petitioner has not made the necessary showing that the prior art relied upon renders obvious a resin in spite of the lack of disclosure. EX2028, ¶90.

To the extent Petitioner argues that it should not be held to the inherency standard because it did not explicitly invoke or use the term “inherent” in its Petition, this is irrelevant. The Board and the Federal Circuit have repeatedly held that petitioners effectively invoke inherency, even without using the term, when attempts are made to fill gaps in the prior art. *See, e.g., PersonalWeb Technologies, LLC v. Apple, Inc.*, 917 F.3d 1376, 1382 (Fed. Cir. 2019) (holding that petitioner's argument

that the prior art could disclose a missing limitation was not sufficient because a “mere possibility is not enough”); *LBT IP I LLC v. Apple Inc.*, No. 2022-1613, 2023 WL 3914920, at *3–4 (Fed. Cir. June 9, 2023) (non-precedential) (holding that petitioner’s argument that “a skilled artisan *would understand*” the missing limitation to be present was effectively an argument of inherency “[a]lthough [petitioner] does not purport to rely on inherency.”).

Petitioner has not established that all plastics are necessarily resins as they must in this case. In fact, when asked about the issue at deposition, Dr. Delson refused to take any position at all. He stated “I have not given an opinion on every type of -- of various plastics that are out there to determine -- to evaluate Metzger’s intent.” EX2015, 49:21-23. When asked if Metzger’s “‘various plastics’...include plastics both formed from a resin and plastics not formed from a resin,” Dr. Delson responded “I have not evaluated that” and again said “I have not considered all of the various plastics that Metzger is referring to.” EX2015, 50:6-12; EX2028, ¶91.

In reality, not all plastics are formed from a resin. As explained by Dr. Rojas, the Dictionary of Science and Technology 1992 defines plastic as “*any* of various synthetic or organic materials that can be molded or shaped, generally when heated, and then hardened into a desired form.” EX2020, 1667. Plastics formed from a resin are just one of many examples of plastics, which also include plastics formed without resins. *See* EX2020, 1667; EX2028, ¶92.

Because the prior art does not disclose a resin and Petitioner has not met its burden to show that a resin is inherently disclosed by the “various plastics” it references, the combination of Metzger, Protais, and Kaminski do not render obvious limitation [1.C], claim 1, or any of its dependent claims. EX2028, ¶93.

2. Petitioner has not provided any reason that a POSITA would select a resin-based plastic.

To the extent the Board finds that Petitioner does not need to show that Metzger’s “various plastics” necessarily include a resin, Petitioner’s analysis is still insufficient because the Petition does not provide any reason or motivation to specifically select a resin-based plastic. EX2028, ¶94.

In *In re Stepan Company*, the Federal Circuit made clear that when a petitioner selects one embodiment among many from a single reference, it must identify a motivation for selecting that particular embodiment. “Whether a rejection is based on combining disclosures from multiple references, combining multiple embodiments from a single reference, or *selecting from large lists of elements in a single reference, there must be a motivation to make the combination* and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.” *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017).

Even assuming Metzger contemplated a resin-based plastic as one of its “various plastics” (it does not, *see supra* § VI.A.1), Petitioner has not identified any

reason that a POSITA would have selected a resin-based plastic. For this additional reason, the combination of Metzger, Protais, and Kaminski does not render obvious limitation [1.C], claim 1, or any of its dependent claims. Limitation [15.C] is identical to limitation [1.C] and the combination of Metzger, Protais, and Kaminski does not render obvious limitation [15.C] for the same reasons. Claims 16-20 depend from claim 15 and are, therefore, also not rendered obvious by the combination of Ground 3. EX2028, ¶95.

B. A POSITA would have recognized that Metzger's container cannot be made of PET.

As mentioned above, claims 2, 5-6, and 8 add that “*the resin is a polyethylene terephthalate (PET) resin.*” EX1001, 6:4-6, 12-21, 26-29. Petitioner acknowledges that “Metzger did not explicitly disclose a PET resin.” Pet., 149. Instead, Petitioner argues that a POSITA would have been motivated to construct Metzger's container using PET because Protais's mentions PET and says it has “good mechanical strength and thermal resistance.” Pet., 149 (quoting EX1008, 1:50-51). However, a POSITA would not have been motivated to make Petitioner's proposed modification because constructing Metzger's container from PET would render it unsuitable for its intended purpose. EX2028, ¶96.

Metzger's container was specifically designed to address “the pressure and temperature rigors of [a] thermal retort process” which often “compromise[s] the seal.” EX1010, 2:19-22. A thermal retort process is a process for sealing food in a

container and then raising the temperature for a period of time to eliminate harmful microorganisms that may cause food spoilage. *See* EX2027, 1-3. Metzger explains that “[d]uring a thermal retort process, the container and the food inside the container will be brought to a temperature of about at least 200 degrees Fahrenheit.” EX1010, 11:35-37. To this end, Metzger explains that the container “should be able to withstand a thermal retort process of about 250 degrees Fahrenheit...for a period of about 45 minutes.” EX1010, 11:43-49; EX2028, ¶97.

A POSITA would have recognized that PET would not have been able to withstand the thermal retort process because the glass transition temperature of PET is below the temperatures of Metzger's thermal retort process. EX2028, ¶98.

As a thermoplastic “is raise above the glass-transition temperature, T_g , or melting point, T_m , certain polymers become easier to form or molded into desired shapes. The increased temperature weakens the secondary bonds (through thermal vibration of the long molecules), and the adjacent chains thus move more easily when subjected to external shaping forces.” EX2022, 202. “If the temperature of a thermoplastic polymer is raised above its T_g , it first becomes *leathery* and then increasing temperature, *rubbery*.” EX2022, 202; EX2028, ¶99.

Regarding PET specifically, Protais explains that “[w]hen conventional bi-oriented PET containers are taken to a temperature higher than the glass transition

temperature, *they undergo significant shrinkage* due to release of stresses.”

EX1008, 1:37-39; EX2028, ¶100.

Huang discloses the “glass transition temperature (T_g)” of PET as 73.6 degrees Celsius (164.48 degrees Fahrenheit). EX2018, 2. The Materials Data Book (2003 Edition) from the Cambridge University Engineering Department indicates a range between 68° C and 80° C for the glass transition temperature of PET. EX2023, 9; *see also* EX2024, 9. A third reference from the online MatWeb website lists the glass transition for PET between 70° C and 82° C. EX2025, 3. Because PET transitions from a rigid structure to a leathery and rubbery structure between about 155° and 180° Fahrenheit, a POSITA would have recognized that PET would not be a suitable material for Metzger’s container because it could not withstand the thermal retort temperatures it describes, including a minimum of 200 degrees Fahrenheit and a preferred “250 degrees Fahrenheit...for a period of about 45 minutes.” EX1010, 11:43-49; EX2028, ¶101.

If Metzger’s container were made of PET, a POSITA would have known that it would undergo a softening as the increase in temperature weakens the secondary bonds in the material resulting in a leathery material that significantly deforms depending on the geometry, magnitude of the temperature above the glass transition, and pressurization within the container. That PET containers are only suitable for lower temperatures is confirmed by Protais’s disclosure as well. EX2028, ¶102.

Protais describes containers used for containing liquids of temperatures at or below the glass transition temperature of PET—“between about 60° C. and 80° C.” (140-176 degrees Fahrenheit). EX1008, 2:25-29. Protais's containers are not subjected to the temperatures of Metzger's thermal retort process—in excess of 200 degrees Fahrenheit—when filled with product. EX2028, ¶103.

Because PET would not withstand the thermal retort process Metzger's container is specifically designed to address, a POSITA would have recognized that Metzger's disclosure of “various plastics” could not include PET. EX2028, ¶104. For similar reasons, a POSITA would not have attempted to modify Metzger's container to be made of PET as required by Petitioner's combination for claims 2, 5-6, and 8. Therefore, Petitioner has not met its burden of establishing that claims 2, 5-6, and 8 are unpatentable. EX2028, ¶105.

C. The first depression of Protais's base, identified by the Petitioner, does not partially define[] a first outline, as required by limitation [1.G].

Limitation [1.G] recites “*wherein the first depression at least partially defines a first outline.*” EX1001, 4:20-21.

A first depression partially defining a first outline is illustrated in Figure 3 of the '441 Patent, annotated below. EX2028, ¶107.

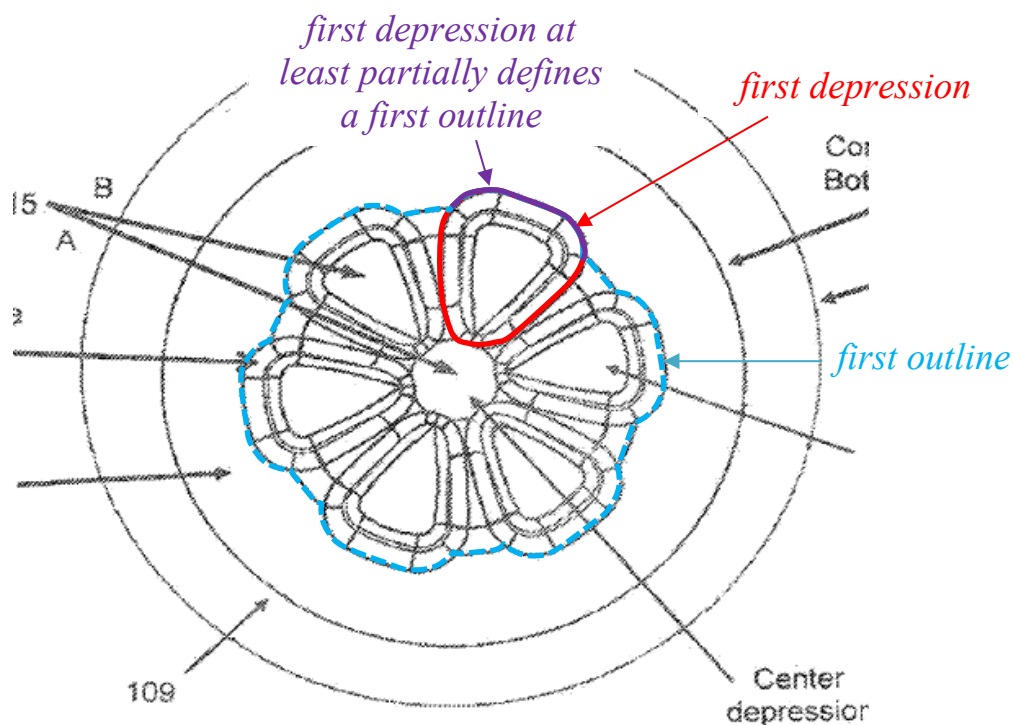
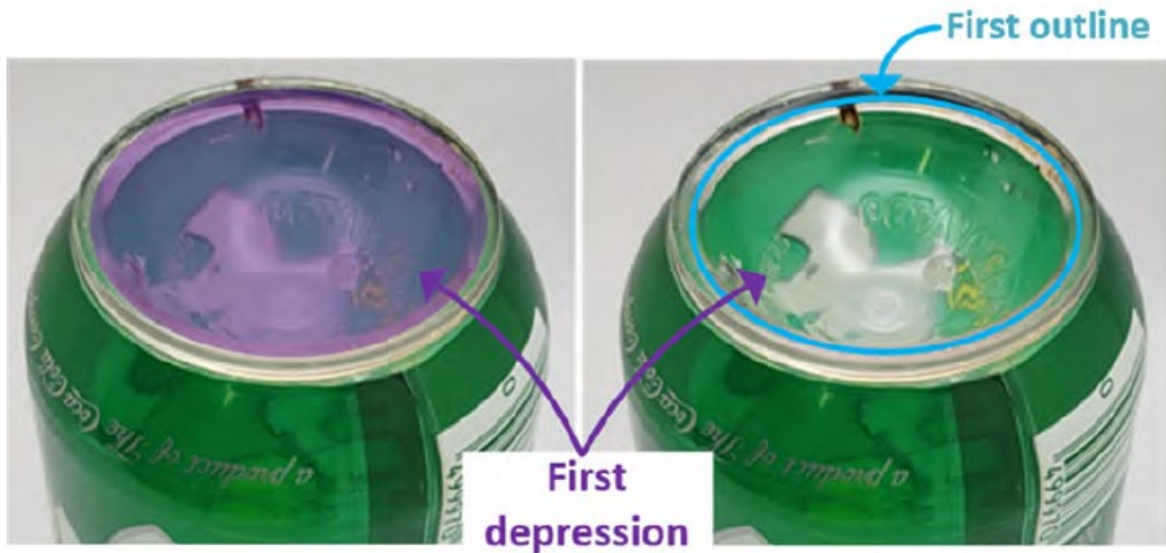


Figure 3

EX1001, Fig. 3 (cropped and annotated)

As shown in Figure 3 above, a portion of the first depression at least partially defines the first outline because it forms a portion of the first outline. This portion shared by both the first depression and the first outline is highlighted in purple, above. EX2028, ¶108.

Petitioner's interpretation of a first depression at least partially defining the first outline is consistent with the '441 Patent's description for grounds 1 and 4. For Ground 1, Petitioner shows that the first depression of the PCAN not only partially defines the first outline, but completely defines the first outline because it forms the entire first outline. EX2028, ¶109.



Pet., 29

Dr. Delson confirmed that the first outline in blue on the right is defined “based on the outer boundary of [the] first depression.” EX2015, 72:14-17; EX2028, ¶110.

For Ground 4, Petitioner shows two interpretations of a first depression and explains how either partially define the first outline. In one example, Petitioner defines the first depression as the circular region shown in purple. EX2028, ¶111.

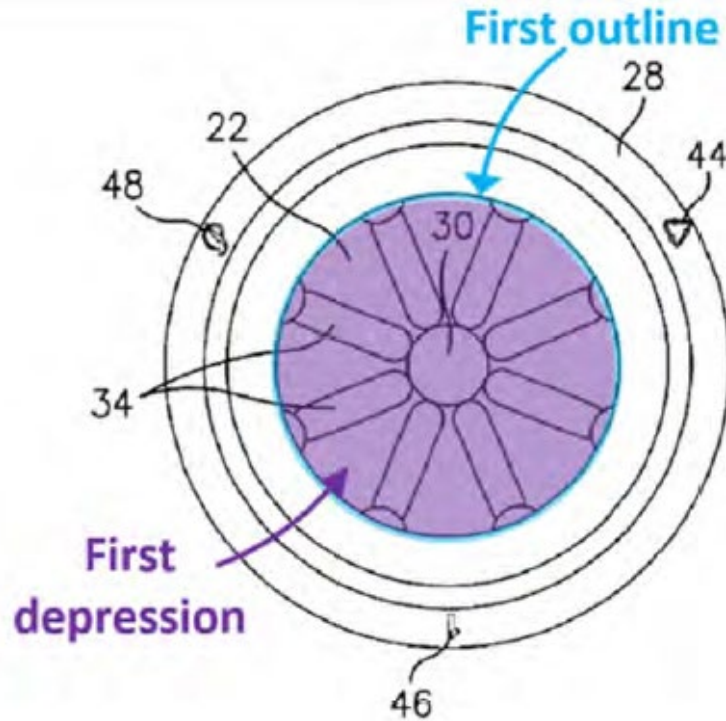


FIG. 2

Pet., 186

For this example, Dr. Delson also confirmed that the first outline “indicat[ed] the outer contours of boundaries of...the first depression.” EX2015, 76:10-14. Like Petitioner’s mapping for Ground 1, the first depression not only partially defines the first outline, it completely defines it. EX2028, ¶112.

Petitioner’s second alternative, in which a first depression is defined as only one segment, highlighted below, shows an example of partially defining the first outline. EX2028, ¶113.

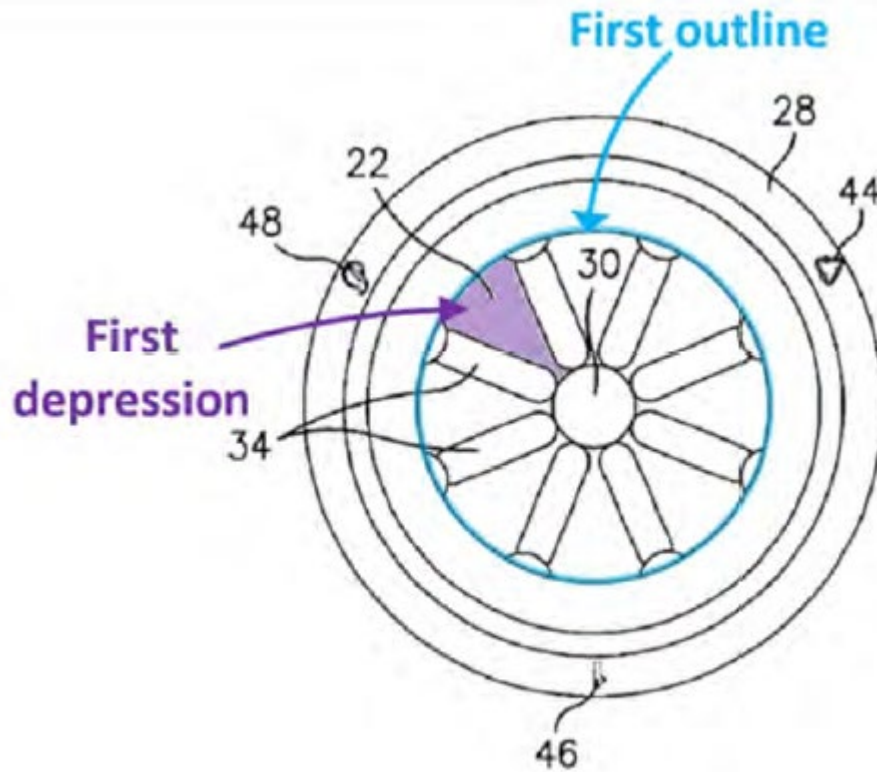
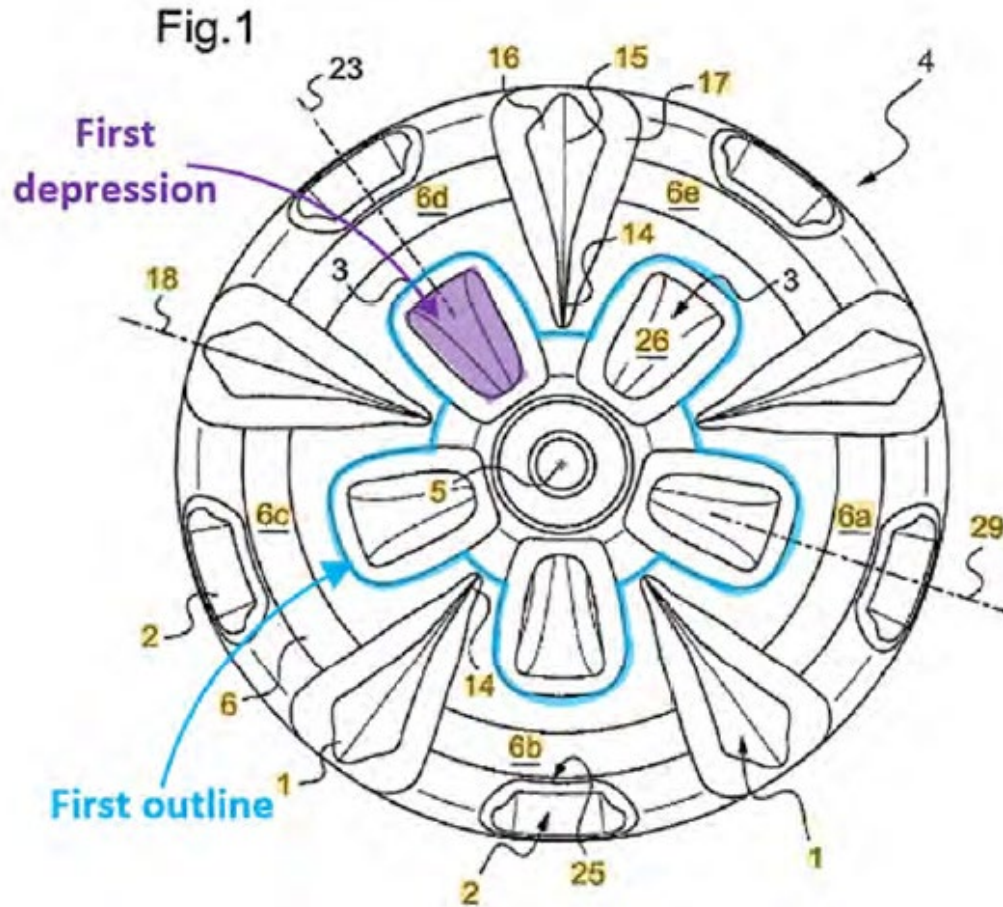


FIG. 2

Pet., 188

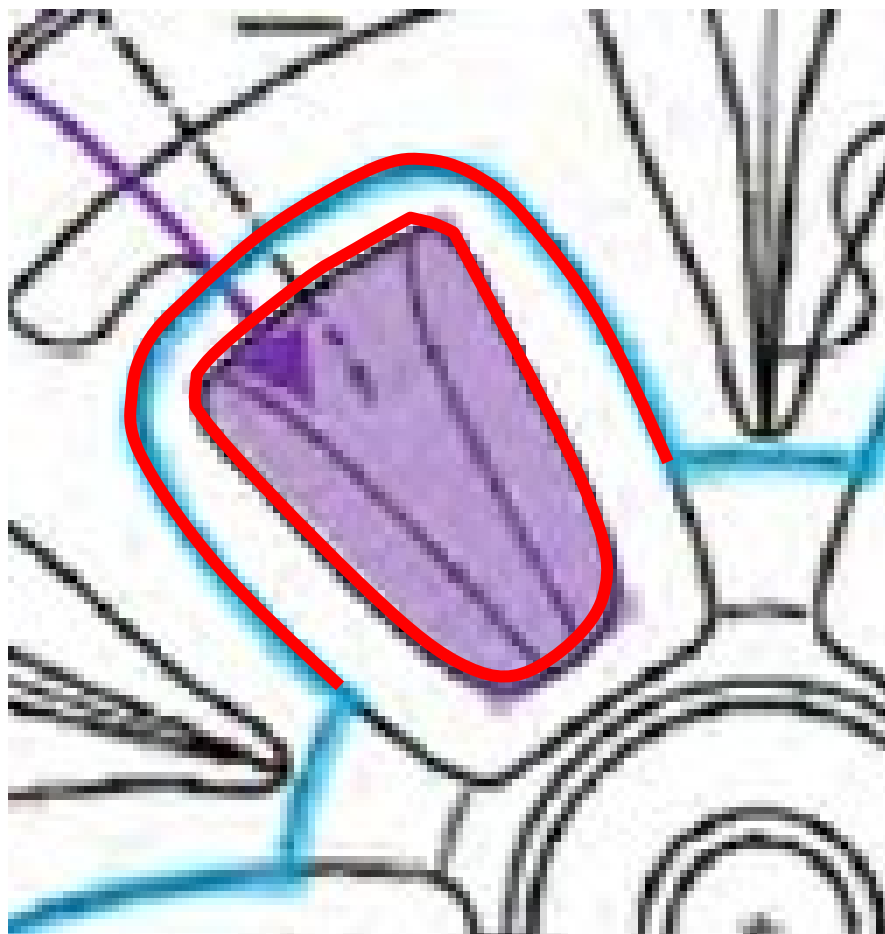
Here again, Dr. Delson confirmed that the “outer edge of the first depression forms part of the first outline.” EX2015, 77:25-78:3; EX2028, ¶114.

Petitioner’s mapping for Ground 3, however, stands in contrast to these examples above of depressions that define or partially define the first outline. For Ground 3, the Petition identifies the first depression and first outline as shown below. EX2028, ¶115.



Pet., 114

Unlike the depressions and outlines in every other example of the Petition, no portion of the outer boundary of the first depression forms or defines the first outline in any way. The shapes of the first depression and the first outline are not the same and are not based on one another. Even the portion of the first outline around the first depression is a different shape than the first depression, as highlighted in red below. EX2028, ¶116.



Pet., 114 (enlarged)

Accordingly, the first depression of Protais's base does not "*partially define a first outline,*" as claimed. For this independent reason, the combination of Metzger, Protais, and Kaminski does not disclose or render obvious limitation [1.G]. Claims 2-14 all depend from independent claim 1 and are therefore not rendered obvious by the combination for the same reasons. Limitation [15.G] is identical to limitation [1.G] and the combination of Metzger, Protais, and Kaminski do not render obvious limitation [15.G] for the same reasons. Claims 16-20 depend from claim 15 and are, therefore, also not rendered obvious by the combination of ground 3. EX2028, ¶117.

VII. THE COMBINATION OF GARDINER, PEDMO, AND BROWN DOES NOT RENDER THE CLAIMS OBVIOUS

Petitioner's Ground 4 presents a combination of Gardiner, Pedmo, and Brown. For the reasons presented below, Petitioner's Ground 4 does not render the claims obvious. EX2028, ¶118.

A. Gardiner does not disclose a container body...made out of a resin, as required by limitation [1.C].

Like the combination in Ground 3, the combination of Gardiner, Pedmo, and Brown does not disclose or render obvious a resin. Limitation [1.C] recites “*wherein the container body is made out of a resin.*” EX1001, 4:12. Claims 2, 5-6, and 8 add that “*the resin is a polyethylene terephthalate (PET) resin.*” EX1001, 6:4-6, 12-21, 26-29; EX2028, ¶119.

Like Ground 3, none of the prior art references of Ground 4 make any reference to “*a resin,*” or “*a polyethylene terephthalate (PET) resin.*” Here again, the Petition simply argues that “[i]t would have been obvious to a POSITA that plastics *can* be made out of a resin.” Pet., 178. As described above regarding Metzger in Ground 3, the combination of Ground 4 does not render obvious limitation [1.C] because Petitioner's argument that plastics can be made out of resin requires either (1) an argument for inherency—that all plastics are necessarily made out of a resin—or (2) some reason or motivation that would have prompted a

POSITA to specifically select a resin-based plastic for Gardiner's container.

Petitioner has not shown either and Ground 4 fails for the same reasons described above for Ground 3. *See supra* § VI.A.1-2; EX2028, ¶120.

First, as explained above, *see supra* § VI.A.1, by equating plastic with resin, Petitioner is, effectively, arguing that any disclosure of plastic inherently also discloses a resin. This argument for inherency requires showing that the missing limitation “is *necessarily* present.” *In re Montgomery*, 677 F.3d at 1380; *see also Bettcher Indus.*, 661 F.3d at 639. Because Petitioner has not established that all plastics are “necessarily” or “inevitably” resins, Petitioner has not met its burden. In reality, not all plastics are formed from a resin. *See* EX2020, 1667. Because the prior art does not disclose a resin and Petitioner has not met its burden to show that a resin is inherently disclosed by the “various plastics” it references, the combination of Metzger, Protais, and Kaminski do not render obvious limitation [1.C], claim 1, or any of its dependent claims.

Second, as also explained above, *see supra* § VI.A.2, Petitioner has also not provided any reason to or motivation to specifically select a resin-based plastic. *See In re Stepan*, 868 F.3d at 1346 n.1.

B. Petitioner has not provided any reason to modify Gardiner's container to be made of PET.

Claims 2, 5-6, and 8 add that “*the resin is a polyethylene terephthalate (PET) resin.*” EX1001, 6:4-6, 12-21, 26-29.

Petitioner acknowledges that “Gardiner did not explicitly disclose a PET resin.” Pet., 235. The Petition then asserts that Pedmo “explained that PET was a material used to manufacture plastic containers.” Pet., 235. The Petition, however, fails to identify any reason or motivation that would have prompted a POSITA to make the proposed combination. The Petition simply asserts that a “POSITA would have been motivated to use PET to manufacture the Gardiner-Pedmo-Brown container based on Pedmo’s teachings.” Pet., 235-236 (citing EX1013, 3:9-10, 4:8-9). The portion of Pedmo Petitioner cites as providing a motivation to combine Pedmo with Gardiner does nothing of the sort. Pedmo, 3:9-10 is a partial sentence that recites: “Preferably, the plastic is polyethylene terephthalate; however, other suitable plastics may be readily used alone or.” EX1013, 3:9-10. Pedmo, 4:8-9 is claim 4, which recites: “A hollow plastic bottle according to claim 1, wherein said bottle is polyethylene terephthalate.” EX1013, 4:8-9. Nothing about these passages provides any reasons that would motivate a POSITA to modify Gardiner’s teachings to use PET to manufacture the container. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007). A petitioner must also “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.*; EX2028, 122.

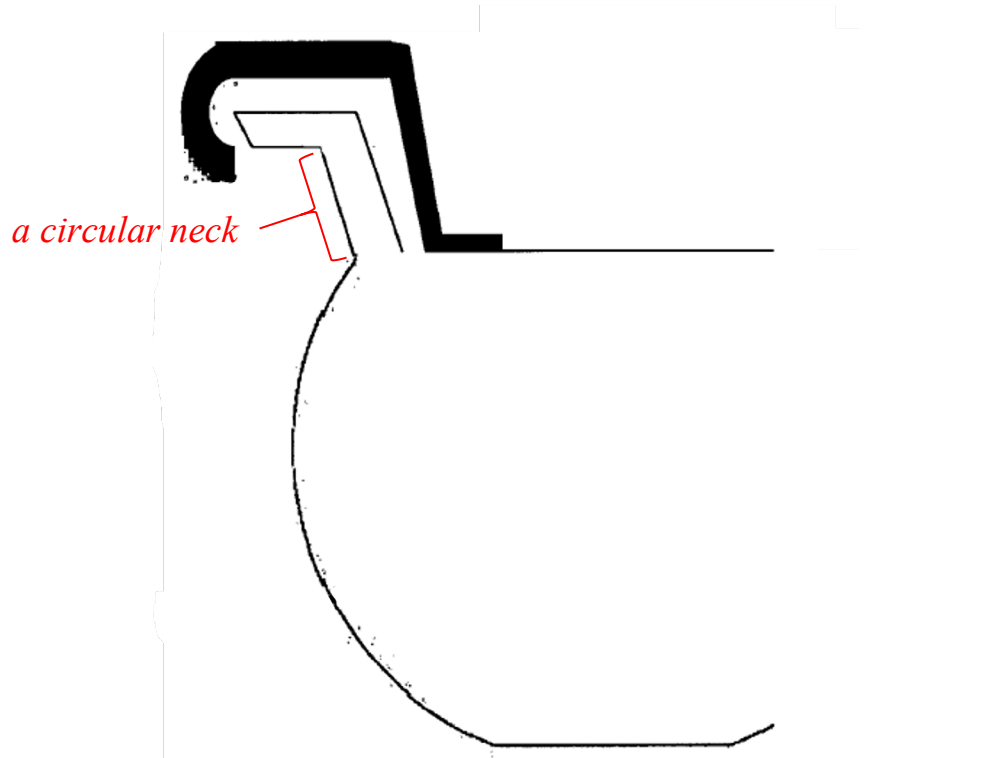
For claim 2, the Petition then cites to paragraphs 380 and 381 of Dr. Delson's declaration. *See* Pet., 236. To the extent the Petition attempts to incorporate by reference additional analysis regarding a motivation to combine Pedmo with Gardiner, this is improper. *See* 37 C.F.R. § 42.6(a)(3). However, Dr. Delson only states that a POSITA would be motivated to combine Pedmo with Gardiner because "PET was a suitable plastic for containers" and was used "for making plastic bottles." EX1002, ¶381. That a modification to a prior art reference is merely "suitable" and is used in other prior art is not a sufficient motivation to combine. EX2028, ¶123.

The Petition references this same analysis for claims 5, 6, and 8. *See* Pet., 236-237. Accordingly, for this additional, independent reason, the combination of Gardiner, Pedmo, and Brown do not render obvious claims 2, 5-6, and 8. EX2028, ¶124.

C. Gardiner does not disclose a circular neck, as required by limitation [1.N], or a lip as required by limitation [1.P].

Claim limitations [1.N]-[1.R] recite various features of the upper region of the claimed container. Specifically, limitation [1.N] recites "*the container body further comprises a circular neck.*" EX1001, 4:44-47. This circular neck "*extend[s] from the container side wall*" (limitation [1.N]) and is "*adjacent to*" the "*upper edge of the container side wall*" (limitation [1.O]). EX1001, 4:44-49. An example of a circular neck illustrated in Figure 5 of the '441 Patent, shown below with

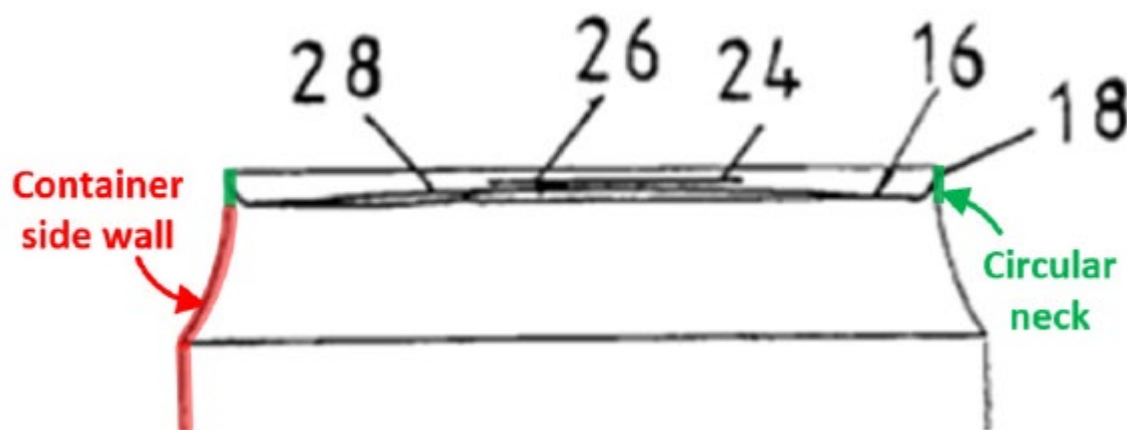
annotations. EX2028, ¶125.



EX1001, Fig. 5 (annotated)

The Petition has not identified these features in the prior art presented in ground 4. What Petitioner identifies as “*a circular neck*” of “*the container body*” for limitation [1.N] is, in fact, not a part of the container body in Gardiner. EX2028, ¶126.

At limitation [1.N], Petitioner points to the “rim 18” as the claimed “circular neck” of the container body. *See* Pet., 200; EX2028, ¶127.

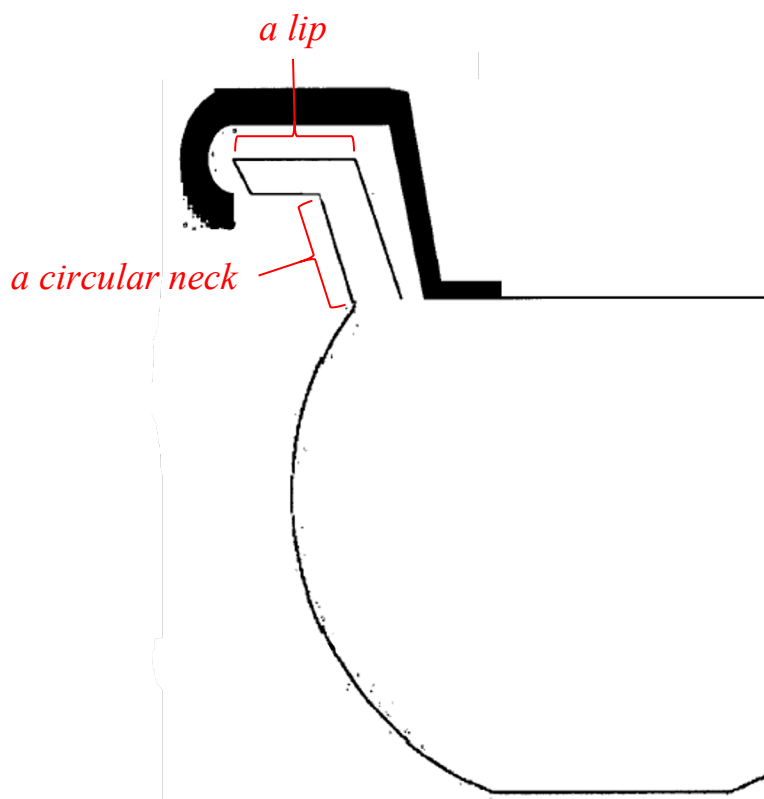


Petition, 125

But Gardiner's rim 18—what Petitioner points to as the “*circular neck*”—is not part of Gardiner's container body at all. Gardiner explains that the rim 18 is formed by positioning the peripheral 140 *of the cap member 100* around the open end of a can and seaming the cap to the container walls. EX1012, 5:42-46. This process of forming the rim 18 with the cap member 100 is described in detail. Specifically, Gardiner explains that “[t]he cap member is sealingly fixed to the body member...*forming a rim.*” EX1012, 1:64-67. “The cap member 100 has a cap body 120 with a peripheral 140 which is shaped to be positioned...over an open end of a can body and seamed thereat to join to the can body *for forming a rim of the can.*” EX1012, 5:42-46. Gardiner's abstract equates the rim 18 to the peripheral 140 of the cap member 100. EX1012, Abstract (“rim (18) or rim forming portion (140)”). Therefore, what Petitioner has mapped as the circular neck *of the container* (the rim

18) is actually the peripheral 140 *of the cap member 100* after it has been sealed to the top of the can. EX2028, ¶¶128-129.

Compounding the problems of limitation [1.N] above, the Petition also fails to identify “*a lip*” as required by limitation [1.P]. The claimed lip is required to be positioned “*at the end of the circular neck opposite the edge of the container side wall,*” as illustrated below. EX1001, 4:50-52 (Limitation [1.P]); EX2028, ¶130.



EX1001, Fig. 5 (annotated)

Like the circular neck, the claimed “*lip*” is also a part of the *container body*, not the lid. At limitation [1.P], addressing the claimed “*lip*,” Petitioner refers to a “reciprocal shape” that is neither described nor illustrated anywhere in Gardiner.

Pet., 203. Petitioner points to Gardiner's "cap member" shown in Figures 10 and 13 as the alleged disclosure of a "reciprocal shape" lip. EX1012, 3:56-58; Pet., 202-204; EX2028, ¶131.

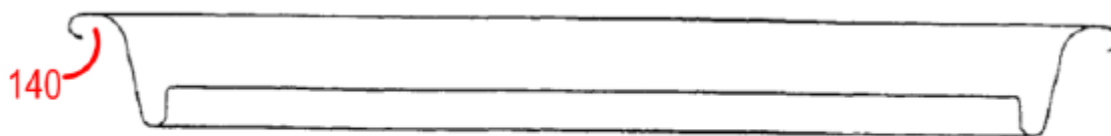


FIG. 13

Pet., 203

However, there is no such reciprocal shape. As explained above regarding the circular neck of limitation [1.N], the rim 18 is formed by seaming the peripheral 140 around "*an open end* of a can body." EX1012, 5:42-46. There is no disclosure or suggestion of any lip on the open end of the can body in Gardiner. EX2028, ¶132.

A "petition must specify where **each element** of the claim is found in the prior art." 37 C.F.R. § 42.204(b)(4). The Petition has not identified any prior art disclosure corresponding to "*a circular neck*" of limitation [1.N] or "*lip...at the end of the circular neck opposite the edge of the container side wall*" of limitation [1.P]. Limitations [15.N] and [15.P] are respectively the same as limitation [1.N] and [1.P]. Accordingly, the combination of Gardiner, Pedmo, and Brown does not render obvious claims 1-20. EX2028, ¶133.

VIII. CONCLUSION

The Board should find the challenged claims patentable for the reasons presented above.

Respectfully submitted,

Dated: March 12, 2025

/ Gregory P. Webb /
Gregory P. Webb
Registration No. 59,859
Lead Counsel for Patent Owner

IX. 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-VIII) has 12,596 words, according to the word count tool in Microsoft Word™.

/ Gregory P. Webb /
Gregory P. Webb
Registration No. 59,859
Lead Counsel for Patent Owner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BuzzBallz, LLC,
Patent Owner

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

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. §§ 42.105 and 42.6, that service was made on Petitioners' counsel as detailed below.

Date of service March 12, 2025

Manner of service Electronic Service: tehranchi-ptab@perkinscoie.com; tyler-ptab@perkinscoie.com; shvodian-ptab@perkinscoie.com; Kendrick-ptab@perkinscoie.com; kalamarides-ptab@perkinscoie.com

Documents served Patent Owner's Response; Exhibits 2014-2020, 2022-2028

Persons served Babak Tehranchi
M. Craig Tyler
Daniel T. Shvodian
R. Tyler Kendrick
Andrew Kalamarides (*Pro Hac Vice* forthcoming)
PERKINS COIE LLP
11452 El Camino Real, Suite 300
San Diego, CA 92130

/ Gregory P. Webb /
Gregory P. Webb
Registration No. 59,859
Lead Counsel for Patent Owner