

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 No. 11,932,441

**PETITIONER'S AUTHORIZED RESPONSE TO
REQUEST FOR DIRECTOR REVIEW**

I. INTRODUCTION

The question of PGR eligibility in this matter boils down to a straightforward issue of Patent Owner adding and claiming new matter in a design patent application. The Patent Office has considered this issue three times—during the original prosecution, in deciding to institute this PGR, and in rendering the Final Written Decision (FWD)—and each time found that Patent Owner added and claimed new matter. Because new matter was added and claimed, that design patent application and any application that claims priority to it, including the application for U.S. Patent No. 11,932,441 (“the ’441 patent”), is subject to the provisions of the America Invents Act (AIA). And because the ’441 patent is subject to the AIA, it is eligible for PGR.

In its Request for Director Review (“Request”), Patent Owner does not dispute that the application that issued as the ’441 patent claims priority to design Patent Application No. 29/824,813 (“the ’813 application”). Patent Owner also does not dispute that the ’813 application contained a new figure depicting an ornamental pop top lid design that differs from the pop top lid design depicted in the earlier applications in the priority chain. Instead, Patent Owner asserts that Petitioner failed to present any evidence that the new design lacked written description support, despite the difference in the ornamental features being easily seen in the application figures, which are evidence. Patent Owner also asserts the Board made numerous other errors in finding the ’441 patent PGR eligible, but Patent Owner fails to demonstrate

any such errors. Finally, Patent Owner mischaracterizes the testimony of Petitioner's expert in the same way that the Board already rejected as inaccurate.

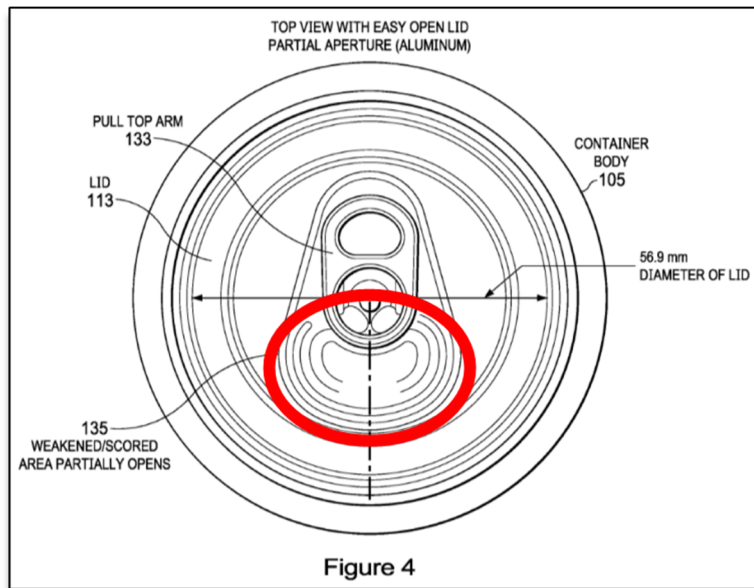
Patent Owner's arguments lack merit, and its Request should be denied.

II. ARGUMENT

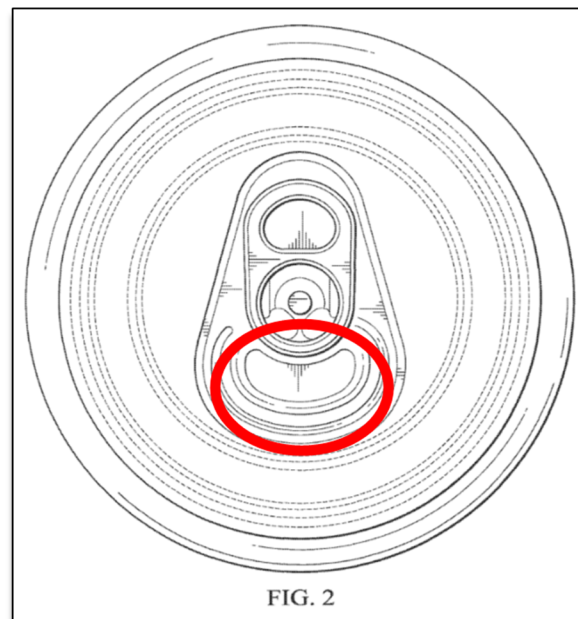
A. The '441 Patent Is PGR Eligible

A patent is subject to the AIA, and therefore eligible for PGR review, if (1) it contains a claim that has a priority date after March 15, 2013, or (2) if it claims priority to "any patent or application that contains or contained at any time" a claim that had an effective filing date after March 15, 2013. AIA, § 3(n)(1). (FWD at 13.) The '441 patent satisfies the latter requirement.

The '441 patent claims priority to the '813 application, which was a design patent application filed on January 27, 2022. When the '813 application was filed, the applicants represented that it was a "continuation" of earlier-filed applications. (EX1003 at 176.) The '813 application, however, contained a new figure that depicted a pop top lid design that was not contained in the preceding (or any) application earlier in the priority chain. (*Id.* at 187.) Specifically, Figure 4 of Patent Application No. 16/800,195 ("the '195 application"), to which the '813 patent claims priority, depicted contour lines on the break-away portion of the lid just below the tab that curved inward and then stopped, without connecting in the middle:

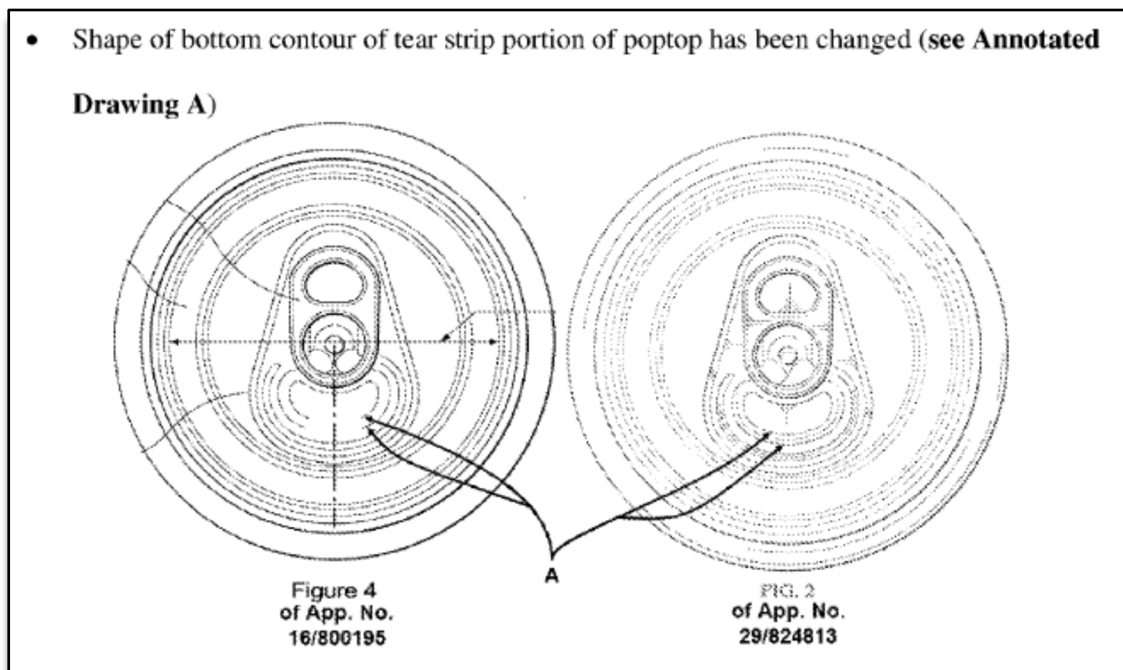


(EX2002 at 106 (red annotation added).) Newly added Figure 2 of the '813 application, however, depicted a design with contour lines that curved inward, did not stop, and connected across in front of the tab:



(EX1003 at 187 (red annotation added).) There is no description or depiction of contour lines that connect in that manner anywhere in the '195 application.

The Examiner of the '813 application immediately identified the lack of written description support for the new lid design in the first Office Action. (EX1003 at 107 (“The disclosure of the prior-filed 16/800195 fails to provide adequate written description support....”).) The Examiner annotated Figure 4 of the '195 application and Figure 2 of the '813 application to highlight the different designs:



(EX1003 at 107.) The Examiner added that “[w]ithout additional directions or guidance in the prior-filed application, a design that includes the above feature could not have been recognizable upon filing of the earlier application.” (*Id.* at 108.)

The Examiner advised that the applicants could overcome the objection if they were to: (1) “keep the changed tear strip appearance” and change the application status from “Continuation” to “Continuation-In-Part;” or (2) “[c]onvert the tear strip appearance in Fig. 2 to that which was shown in the parent application” and “keep

the Continuation status.” (*Id.*) The Examiner further indicated that the ’813 design patent application would be examined pursuant to the AIA. (*Id.* at 107; FWD at 20.)

The Applicant chose the second option and submitted an amended Figure 2, which replicated Figure 4 of the ’195 application in order to maintain the application as a continuation. (EX1003 at 70.) In light of that amendment, the Examiner withdrew the objection but again repeated that the ’813 application was being examined pursuant to the AIA (*id.* at 51), which was appropriate given that the application contained, at one time, a claim that had a priority date after March 15, 2013.

The ’441 patent is likewise subject to the AIA because it claims priority to the ’813 application, which contained, at one time, a claim that had a priority date after March 15, 2013. (FWD at 22-23.) And because the ’441 patent is subject to the AIA, it is eligible for PGR.

B. The Board Correctly Found that Petitioner Carried Its Burden of Demonstrating the ’441 Patent Is PGR Eligible

In its Request, Patent Owner asserts that the Board did not require Petitioner to meet its burden of showing that the ’441 patent is PGR eligible. (Request at 2-4.) Patent Owner raises three bases for that assertion, none of which have merit.

1. Petitioner Presented Evidence from Which the Board Properly Found Lack of Written Description for the New Ornamental Contour Line Design in the ’813 Application

At the outset of its analysis of the PGR eligibility issue, the Board properly placed the burden on Petitioner, stating that “Petitioner bears the burden of

demonstrating that the challenged patent is eligible for post-grant review.” (FWD at 13.) In assessing whether Petitioner carried that burden, the Board then analyzed the evidence and arguments of the parties across 16 pages in the FWD and concluded that Petitioner met its burden by demonstrating that contour lines in Figure 2 of the ’813 application lacked written description support in the ’195 application. (*Id.* at 17-32.) The evidence presented by Petitioner and considered by the Board included:

- Figure 4 of the ’195 application (EX1003 at 107; EX2002 at 106);
- Figure 2 of the ’813 application (EX1003 at 187);
- the prosecution history of the ’813 application, where the Examiner rejected Figure 2 of the ’813 application as lacking written description support (*id.* at 107-08), and Applicant acquiesced to the rejection by replacing it with a replica of Figure 4 of the ’195 application (*id.* at 102);
- images of real can lids that correspond to the differing designs depicted in Figure 4 of the ’195 application and Figure 2 of the ’813 application (EX1019 at 6-8); and
- the Reply Declaration of Dr. Delson discussing the actual can lids and refuting Patent Owner’s arguments that the two patent figures depict the same design with merely lighting or shading differences (*id.* at 4-9).

Thus, contrary to Patent Owner's assertion, Petitioner presented and the Board relied upon that *evidence* to conclude that Petitioner carried its burden of proving lack of written description support in the '195 application for the contour design in Figure 2 of the '813 application. (FWD at 22-31.)

In its Request, Patent Owner states that the test for written description 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.” (Request at 3 (emphasis in original).) Based upon that standard, Patent Owner jumps to the erroneous conclusion that, without an expert opinion on the issue, Petitioner did not provide *any* evidence to support a finding of a lack of written description. (*Id.* at 4-5.) Not surprisingly, Petitioner provides no case law to support such an assertion, as the Federal Circuit has repeatedly held that expert testimony is not needed when issues can be resolved based upon the disclosure in the relevant documents. For example, in *Adang v. Umbeck*, the Federal Circuit stated:

As the Board explained, however, there is no strict requirement for extrinsic evidence (expert or otherwise) as to how one of ordinary skill in the art would view the application before the Board can determine whether the written description requirement has been satisfied. To the contrary, as we have noted, a patent can be held invalid for failure to

meet the written description requirement, based solely on the language of the patent specification.

No. 2007-1120, 2007 WL 3120323, *2 (Fed. Cir. Oct. 25, 2007) (internal quotation marks and citation omitted). This is especially true when the technology at issue is easily understandable, as it is here. *See, e.g., Union Carbide Corp. v. Am. Can Co.*, 724 F.2d 1567 (Fed. Cir. 1984) (expert testimony not needed for non-complex technology in assessing whether a patent would be obvious to a POSITA); *Primera Tech., Inc. v. Automatic Mfg. Sys., Inc.*, IPR2013-00196, 2014 WL 4421844, *3-4 (PTAB Aug. 29, 2014) (rejecting argument that the Board “misapprehended or overlooked that attorney argument is not evidence” because the evidence was “easily understandable”).

2. The Board Did Not Improperly Replace the Perspective of a POSITA

Patent Owner next argues that the Board substituted its own perspective and that of a patent examiner for the perspective of a POSITA. (Request at 7-9.) In making this argument, Patent Owner faults the Board for comparing the figures in the two patent applications. (*Id.* at 7.) According to Patent Owner, “the Board’s comparison of the figures does nothing to inform what a POSITA would have understood when evaluating the figures.” (*Id.*) But Patent Owner fails to explain why a POSITA would view the figures differently than anyone else. As shown above, Figure 4 of the ’195 patent depicts contour lines that stop, and Figure 2 of the ’813

application depicts contour lines that continue across in front of the tab and connect. Patent Owner fails to identify anything technical that would be understood differently by a POSITA.

Patent Owner further argues that the Board merely identified differences in the figures without addressing what the differences would convey to a POSITA. But the Board addressed this issue in finding that “the figures on their face convey different ornamental pop-top designs.” (FWD at 23.) In reaching that conclusion, the Board noted that “the Federal Circuit has ‘recognized that some cases involve technologies and prior art that are simple enough that no expert testimony is needed.’” (*Id.* at 25, quoting *Intercontinental Great Brands LLC v. Kellogg N. Am.*, 869 F.3d 1336, 1348 (Fed. Cir. 2017).) The Board further noted that “[t]his is such a case” because “[t]he written description question here is resolved by a straightforward visual comparison of the ornamental design of a pop-top in two figures.” (FWD at 25.)

Patent Owner also argues that the Board improperly relied upon the prosecution history of the ’813 application in which the Examiner also found a lack of written description. (FWD at 8.) Patent Owner cites *Anascape, Ltd. v. Nintendo of Am., Inc.*, 601 F.3d 1333, 1338 (Fed. Cir. 2010) for the proposition that an examiner’s designation of an application as a “continuation” or “continuation-in-part” does not determine its legal status. (Request at 8.) *Anascape*, however, was addressing the designation given to an application by an *applicant*, who first designated the

application as a continuation-in-part and then changed the designation to a continuation. *Anascape*, 601 F.3d at 1338 n.2. But more importantly, the prosecution history here does not simply concern a designation given to an application by an examiner. Instead, the prosecution history contains a detailed analysis of the written description issue where the Examiner rejected Figure 2 of the '813 application due to lack of written description (EX1003 at 107-08), and the applicant acquiesced to that rejection by changing the figure (*id.* at 102).

Patent Owner further argues that the Examiner applied an incorrect legal standard. (Request at 9.) But the Examiner's statement that the design of the '813 design "could not have been recognizable" from the figures in the '195 application is not an incorrect legal standard, but instead reflects that no one, including a POSITA, could find that the '195 patent figures showed that the inventor possessed the ornamental shape of the contour lines depicted for the first time in Figure 2 of the '813 design patent application.

3. The Board Correctly Found that No Expert Testimony Was Needed Given the Simplicity of the Technology at Issue

As discussed above, the Board properly found that, given the simplicity of the technology at issue, no expert testimony was needed to resolve the written description issue. Patent Owner asserts that the Board's finding that no expert testimony was needed was contradicted by both parties' experts. In making that assertion,

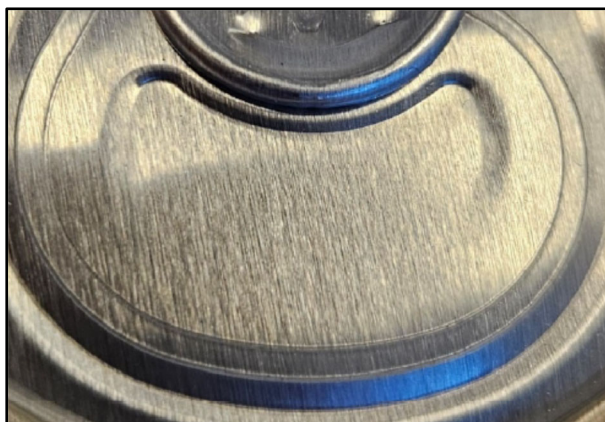
Patent Owner once again misrepresents the testimony of Petitioner's expert in the same manner that was rejected by the Board. (FWD at 25.)

In its Request, Patent Owner quotes Petitioner's expert, Dr. Delson's discussion of the "significant effort and optimization" needed to properly design contour lines on can lids such that the portion of the lid that gets displaced when the tab is lifted will have sufficient rigidity to open correctly. (Request at 10-11.) That is a discussion of what is needed to properly *design* the contour lines to support the proper functioning of the lid-tab interaction. (FWD at 25 ("Dr. Delson was discussing the analysis needed to 'design[] a lid to function properly.'"), quoting EX2034 (alteration in original).) Patent Owner ignores that figures in a design patent, constituting the claimed invention, are solely concerned with "ornamental design for an article of manufacture." 35 U.S.C. 17(a). Nowhere does Dr. Delson say that analyzing the figures of the '813 and '195 applications to determine whether they disclose different ornamental contour lines would require any significant effort or technical understanding. (EX1019 at 8-9; FWD at 25-26.)

Contrary to Patent Owner's assertion, the Board also did not merely cast aside the testimony of Patent Owner's experts. The Board assessed that testimony and found it "entitled to little weight." (FWD at 26.) In regard to Mr. Kirkpatrick, the Board recognized that he is a patent illustrator, not a POSITA, and therefore he was not qualified to opine as to what a POSITA would understand in observing the

figures in the applications. (*Id.* (“For these reasons, we accord no weight to Mr. Kirkpatrick’s opinions on how a person of ordinary skill in the art would have viewed the figures.”).) As to Dr. Rojas, the Board found that his opinions were entitled to little weight given that he did not support his conclusions. (*Id.* at 27-28.) Specifically, Dr. Rojas opined that both figures depict an angled ridge that is more steeply inclined at the top and gradually flattens toward the bottom. (*Id.* at 26.) But he offered no explanation “how or why he concluded that the lines depict a sloping surface or a ridge.” (*Id.* at 27.)

The Board further found that Dr. Rojas’ opinion was refuted by the images of actual lid designs depicted in Dr. Delson’s reply declaration. (*Id.* at 28; EX1019 at 6-8.) Those images show numerous can lids where the contour lines curve inward and stop, as depicted in the ’195 application, and other can lids where the contour lines continue across and connect, as depicted in the ’813 application, including the close-up images below:



(FWD at 28; EX1019 at 8.) In finding that these images refuted Dr. Rojas' conclusory assertions, the Board stated:

We agree with Dr. Delson that the differences shown in these photographs are “not a matter of lighting or viewing angle,” but instead “are actual differences in the structure of the lids.” . . . These photographs, like the relevant patent figures, show different ornamental pop-top designs, e.g., the photo on the right shows a kidney-bean shape that is absent from the photo on the left. This undermines Dr. Rojas's testimony that the differences between Figure 4 of the '195 Application and Figure 2 of the '813 Design Application are “mere shading or contour lines” that show the “same feature.”

(FWD at 28-29 (internal citation omitted).)

Patent Owner asserts that in response to Patent Owner's experts, Petitioner's expert, Dr. Delson, “did not address whether the disclosure of the '195 Application reasonably conveys to a POSITA that the inventor had possession of the design in Figure 2 of the '813 application.” (Request at 6.) That is incorrect. In addition to discussing the differences in the two application figures and how they correspond to actual can designs, as addressed above, Dr. Delson then stated:

Any assertion by Mr. Kirkpatrick or Dr. Rojas that the two figures depict the same design is incorrect. And for the same reason, a POSITA

would not have recognized that a patent applicant in possession of the lid design in Fig. 4 of the '195 application was in possession of the lid design in Fig. 2 of the '183 application.

(EX1019 at 9.)

Finally, Patent Owner asserts that the Board's reliance on *In re Owens* and *In re Berkman* is misplaced. (Request at 12.) The Board cited those cases (FWD at 25) as demonstrating that the question of written description is frequently resolved with expert testimony. *In re Owens*, 710 F.3d 1362, 1368 (Fed. Cir. 2013) (affirming Board's determination that design of mouthwash bottle in continuation application was not adequately disclosed in parent application; no expert testimony cited); *In re Berkman*, 642 F.2d 427, 430 (CCPA 1981) (disagreeing that one skilled in the art would recognize later-claimed storage-case insert in earlier design application figures; no expert testimony cited). Patent Owner argues that those cases concern patent applications, where the applicant bears the burden to prove compliance with the written description requirement, as opposed to a PGR, where the Petitioner bears the burden to show PGR eligibility. (Request at 12.) But the Federal Circuit has held that patents can be held invalid based solely on the face of the patent, even when the patent challenger faces a clear and convincing burden, which is higher than the burden faced by Petitioner here. For example, in *University of Rochester v. G.D. Searle*

& Co., in affirming a grant of summary judgment that a patent was invalid for lack of written description, the Federal Circuit stated:

[The] argument that a patent may not be held invalid on its face is contrary to our case law. . . . [A] patent can be held invalid for failure to meet the written description requirement, based solely on the language of the patent specification. After all, it is in the patent specification where the written description requirement must be met.

358 F.3d 916, 927 (Fed. Cir. 2004). Moreover, there are numerous cases in which a patent challenger bore the burden of proving lack of invalidity on an issue evaluated from the point of view of a POSITA, and the issue was decided in the patent challenger's favor without expert testimony because of the simplicity of the technology at issue. *See, e.g., Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1348 (Fed. Cir. 2017) (finding obviousness despite no expert testimony from the patent challenger given that the technology was simple and the patent owner's expert testimony was conclusory); *Union Carbide Corp.*, 724 F.2d at 1567 (expert testimony not needed for non-complex technology in assessing whether a patent would be obvious to a POSITA).

III. CONCLUSION

Because Patent Owner fails to identify error in the Board's PGR eligibility determination, Petitioner respectfully asks that Patent Owner's Request be denied.

Dated: December 24, 2025

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on December 24, 2025, a true and correct copy of the foregoing **PETITIONER'S AUTHORIZED RESPONSE TO REQUEST FOR DIRECTOR REVIEW** was served by electronic mail on the Patent Owner via its attorneys of record:

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Dated: 12/24/2025

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