

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHURCH & DWIGHT CO., INC.,
Petitioner,

v.

RANDALL BATINKOFF,
Patent Owner.

IPR2020-00168
Patent 7,841,494 B2

Before LYNNE H. BROWN, MITCHELL G. WEATHERLY, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

INTRODUCTION

Church & Dwight Co., Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of an *inter partes* review of claims 1–11 of U.S. Patent No. 7,841,494 B2 (Ex. 1001, “the ’494 patent”). Randall Batinkoff (“Patent Owner”) filed a Corrected Preliminary Response. Paper 8 (“Prelim. Resp.”). Petitioner filed a Reply (Paper 9), to which Patent Owner filed a Sur-reply (Paper 10). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Upon consideration of the Petition and for the reasons explained below, we determine that Petitioner has shown that there is a reasonable likelihood that it would prevail with respect to at least one of the challenged claims. As such, we institute an *inter partes* review of all challenged claims on all presented challenges, and thus, institute an *inter partes* review of claims 1–11 of the ’494 patent.

BACKGROUND

A. Real Parties in Interest

Petitioner states that its real party in interest is itself. Pet. 64. Patent Owner states that its real parties in interest are itself and “Top Secret,” “a California corporation in the business of hair care.” Paper 4, 2.

B. Related Matters

The parties identify two proceedings that may affect, or could be affected by, a decision in this proceeding: (1) *Randall Batinkoff and Top Secret v. Church & Dwight Co., Inc. and Mark H. Kress*, 3:18-cv-16388 (D.N.J.) (filed Nov. 21, 2018) (the “district court litigation”); *Randall*

Batinkoff and Top Secret v. Dennis J. Smolinski, 2:18-cv-12905 (E.D.MI) (filed Sept. 17, 2018). Pet. 64; Paper 4, 2.

C. *The '494 Patent*

The '494 patent issued on November 30, 2010, from an application filed March 16, 2007. Ex. 1001, codes (22), (45). The '494 patent relates to “a manually activated pump dispenser having a pump cap which is adapted to couple to a receptacle.” *Id.* at 1:7–8. According to the '494 patent, prior art dispensers suffered from complicated designs that rendered them expensive to manufacture, and “the requirement of the use of both hands in order to operate the dispenser.” *Id.* at 1:42–45. The '494 patent discloses a pump dispenser “suitable for dispensing powder or fiber onto a scalp or other parts of the body” and “easily manipulated by a single hand of the user.” *Id.* at 1:8–11.

Figure 2 of the '494 patent is reproduced below.

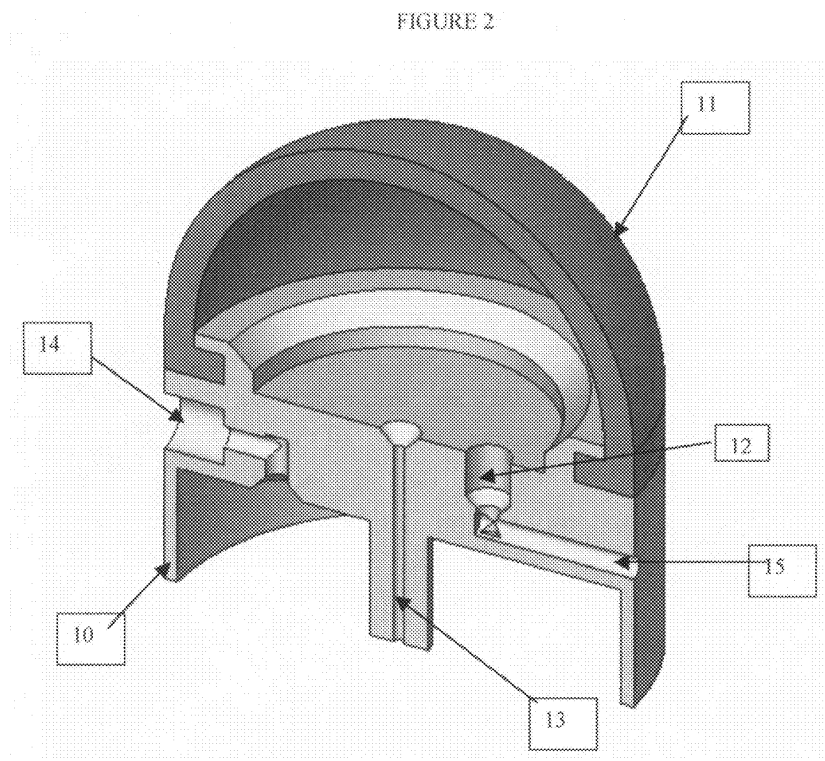


Figure 2 is “a cross sectional, side elevation view of an air atomizing spray gun.” Ex. 1001, 2:65–66. The pump cap includes elastomeric bulb 11 that forms a compressible interior air chamber and sits on top of a dispenser (not numbered). *Id.* at 3:14–16, 3:33–36. The pump cap has an opening on its bottom end defined by peripheral wall 10, with the opening adapted to couple to a receptacle (not shown) containing fibers or powder. *Id.* at 3:18–21, 3:28–30. The dispenser includes one-directional intake valve cavity 12 and valve vent 15 in communication with the chamber under bulb 11. *Id.* at 3:16–17, 3:43–47. The dispenser’s air passageway 13 is in communication with the chamber under bulb 11 on one end, and adjacent the media in the receptacle below on the other end. *Id.* at 3:18–21, 4:1–9. Product outlet 14 “draws the media from the receptacle and disperses same through an outside opening.” *Id.* at 4:9–11.

In operation, a user activates the pump dispenser by grasping the dispenser with one hand and manually pressing down on bulb 11 to direct air from the bulb 11’s interior chamber through passageway 13 to the receptacle containing media. Ex. 1001, 4:49–57. The air agitates and disperses the media throughout the receptacle chamber such that fibers are forced out through product outlet 14. *Id.* at 4:57–61.

D. Challenged Claims

Petitioner challenges claims 1–11. Pet. 10. Of those claims, claims 1 and 7 are independent. Ex. 1001, 5:12–8:6. Claim 1 is reproduced below.

1. A pump cap for dispensing a cosmetic media from a receptacle, the receptacle having a base and an outer upright peripheral wall extending from the base to define a receptacle chamber for the cosmetic media, the upright peripheral wall terminating in an open end, said pump cap comprising:

- a closure including a top wall which terminates in a downward depending peripheral wall, said top wall having top and bottom sides, said closure receiving the open end of the receptacle adjacent said bottom side of said top wall of the closure and within the depending peripheral wall;
 - a deformable dome secured to said top wall of the closure to provide an air-tight dome chamber between said deformable dome and said top wall of said closure;
 - an air pump tube for providing airflow from said dome chamber to the open top end of the receptacle when said deformable dome is compressed, said air pump tube having a top end located in the dome chamber and a bottom end located in the receptacle chamber, said top end being flared out;
 - an air intake tube comprising a first air intake chamber running in a direction substantially parallel to the top wall of the closure and communicating with said peripheral wall of said closure, and a second air intake chamber communicating with said first air intake chamber and with said dome chamber, said second air inlet chamber being disposed perpendicularly to said first air inlet chamber, and being in communication with said first inlet chamber and said dome chamber, said air intake tube providing airflow from outside the dispenser to said dome chamber when deformable dome is released from a compressed to a non-compressed state; and
 - an outlet chamber for dispensing cosmetic media from the receptacle, said outlet chamber communicating between a media outlet opening on the peripheral wall of said closure, and a receptacle chamber media opening located on the bottom side of the top wall of said closure, said receptacle chamber media opening being flush against the bottom side of the top wall of the closure;
- such that the dispenser can be held in one hand and cosmetic media may be dispensed by successively compressing and releasing said deforming dome.

Id. at 5:12–52.

E. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–11 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–4, 6 ¹	103	Carsberg, ² Kross, ³ Kress ⁴
5, 7–11	103	Carsberg, Kross, Kress, Lundblad ⁵
1–11	103	Lundblad, Kross, Kress
1–11	103	Kross, Kress, Perritt, ⁶ Lundblad
1–11	103	Kross, Kress, Perritt, knowledge of POSITA ⁷

Petitioner also relies on the Declaration of Michael B. Jones.

Ex. 1003 (“Jones Declaration”).

¹ Although Petitioner refers to “Ground 1” as challenging claims 1–11 based on Carsberg, Kross, Kress, and Lundblad, Petitioner does not rely on all four references for each of claims 1–11. Pet. 26–38. For claims 1–4 and 6, Petitioner relies on Carsberg, Kross, and Kress, and does not explicitly refer to Lundblad. *Id.* at 26–33. We treat the challenge to claims 1–4 and 6 based on Carsberg, Kross, and Kress separate from the challenge to claims 5 and 7–11 based on those same references plus Lundblad.

² UK 748,530, published May 2, 1956 (“Carsberg”) (Ex. 1008).

³ US 2,223,256, issued November 26, 1940 (“Kross”) (Ex. 1005).

⁴ US 7,140,522 B2, issued November 28, 2006 (“Kress”) (Ex. 1007).

⁵ US 1,520,502, issued December 23, 1924 (“Lundblad”) (Ex. 1009).

⁶ US 2,098,160, issued November 2, 1935 (“Perritt”) (Ex. 1006).

⁷ Petitioner contends that the knowledge of one of ordinary skill in the art (“POSITA”) includes “the well-known manufacturing feature of rounded edges or ‘fillets.’” Pet. 50.

ANALYSIS

A. Denial Under 35 U.S.C. § 325(d)

Patent Owner argues that we should exercise our discretion to deny institution because the Examiner already considered the substance of the three references at issue here during prosecution. Prelim. Resp. 1, 3–9.

1. Legal Background

Section 325(d) provides that, in determining whether to institute an *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” The Board uses a two-part framework in determining whether to exercise its discretion under § 325(d), specifically:

(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6, 8 (PTAB Feb. 13, 2020) (precedential).

In applying the two-part framework, we consider several non-exclusive factors, including: (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or

Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). If, after review of factors (a), (b), and (d), we determine that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner demonstrates that the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 10.

For the reasons set forth below, under the facts presented and arguments made, we decline to exercise our discretion under 35 U.S.C. § 325(d) to deny instituting trial.

2. *The Prosecution History and the Parties' Positions*

During prosecution, the Examiner rejected the pending claims as obvious. Ex. 1002, 76–80, 117–119. The applicant amended several claims to require the air pump tube (passageway 13 in Figure 2) to have a “flared out” top end within the dome chamber under bulb 11. *Id.* at 60. The applicants alleged that the “flared out” tube end in the dome chamber prevents clogging of the air pump tube and “ensures free and proper flow of air into the receptacle.” *Id.* at 67. The Examiner found the claims allowable due to the addition of the “flared out” limitation. *Id.* at 35–36. The Examiner maintained obviousness rejections based on Kross, Kress, and Perritt for claims that did not contain the “flared out” limitation. *Id.* at 33–34. The applicant amended the remaining claims to add the “flared

out” limitation so that all claims included that feature, and the Examiner issued a Notice of Allowance following that amendment. *Id.* at 13, 23–24.

Patent Owner argues that “the same or substantially the same prior art or arguments previously were presented to the Office.” Prelim. Resp. 1 (quoting *Becton, Dickinson*, Paper 8 at 17–18). Patent Owner intersperses its § 325(d) argument with various “teaching away” arguments that go to the merits of the Petition. *See id.* at 3–9. Patent Owner argues that Kress was already considered by the Examiner, and argues that Kress teaches away from the claimed one-handed operation of the claimed device. *Id.* at 4. Patent Owner also argues that Kross and Perritt were considered by the Examiner and that such liquid-dispensing devices “would be incapable of disturbing hair fibers and aspirating them” and teach away from the claimed invention. *Id.* at 4–6. Patent Owner acknowledges that Carsberg and Lundblad were not before the Examiner, but argues that Carsberg “does not teach hair fibers” and Lundblad is a liquid-dispensing device that is cumulative of Kross and Perritt. *Id.* at 7–8. Patent Owner argues that because all challenges require Kress, Kross, Perritt, and Lundblad, they should all “be denied review.” *Id.* at 9.

Petitioner argues that all but one of the challenges include at least one prior art reference not before the Examiner during prosecution, and the final challenge employs Patent Owner’s claim construction advocated in the district court litigation that was not before the Examiner. Pet. 11. Petitioner also argues that the *Becton, Dickinson* factors weigh strongly against use of our discretion to deny institution. *Id.* at 12–13.

3. *Discussion*

We first consider “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” *Advanced Bionics*, Paper 6 at 8. Patent Owner concedes that Carsberg and Lundblad were not before the Examiner, and therefore all but one of the challenges in the Petition rely on art the Examiner never considered. *See* Prelim. Resp. 7–8. For all but one challenge, Petitioner relies on Carsberg and Lundblad as disclosing the allegedly missing “flared out” top end of the air pump tube, thereby disclosing the limitation the Examiner found lacking in the prior art. *See id.* at 19, 21–22, 28, 41, 50.

As to Carsberg, the primary reference in Petitioner’s first challenge in the Petition, Patent Owner does not argue that the reference was before the Examiner during prosecution or that it was cumulative of art before the Examiner. Prelim. Resp. 7. Patent Owner argues that Petitioner distinguished Carsberg during prosecution of its own patent, and that Carsberg’s failure to disclose hair fibers renders it “inapposite,” but neither argument bears on whether Carsberg is substantially similar to the art or arguments before the Examiner. *See id.* at 8. Further, Patent Owner never addresses Petitioner’s argument that Carsberg discloses the “flared out” limitation allegedly missing from the prior art before the Examiner. As discussed below, we find Petitioner’s argument persuasive on the current record, such that Carsberg discloses subject matter not substantially the same as that before the Examiner.

As to Lundblad, Patent Owner argues that such liquid dispensers are cumulative of other liquid dispensers before the Examiner, such as Kross

and Perritt. Prelim. Resp. 7–8. That argument, even if true as to the liquid nature of the dispensed media, does not address Petitioner’s argument that Lundblad discloses the “flared out” limitation allegedly not disclosed in the prior art before the Examiner. That is, the cumulative feature argued by Patent Owner is not the same feature relied on by the Petitioner in its obviousness challenge. As discussed below, we find Petitioner’s argument persuasive on the current record, such that Lundblad discloses subject matter not substantially the same as that before the Examiner.

Based on the foregoing, all but one of the grounds set forth in the Petition rely on prior art not before the Examiner. The other challenge employs a broad claim construction based on Patent Owner’s assertions in the district court, and reliance on the knowledge of a POSITA, which are not substantially the same as the approach employed by the Examiner. See Pet. 23–25, 50. Patent Owner does not allege that despite these differences, the arguments before the Examiner were substantially the same as those set forth in the Petition, and had Patent Owner done so, we would not find such an argument convincing. Accordingly, we determine that the first part of the framework set forth in *Advanced Bionics* is not met. We need not reach “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics* at 8–9.

4. Conclusion

After considering the framework set forth in *Advanced Bionics* and the appropriate *Becton, Dickinson* factors, the particular circumstances of this case do not indicate that we should exercise our discretion under § 325(d) to deny institution.

B. Denial under 35 U.S.C. § 314(a) Based on District Court Litigation

Institution of an *inter partes* review under 35 U.S.C. § 314(a) is discretionary. *See* 35 U.S.C. § 314(a) (stating “[t]he Director *may not* authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition” (emphasis added)); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). The Board will consider the advanced state of a district court proceeding as a “factor that weighs in favor of denying the Petition under § 314(a).” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential); *see also Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB March 20, 2020) (precedential) (listing factors that the Board has considered when the patent owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding).

Patent Owner, relying on *NHK*, argues that we should deny institution based on the advanced stage of the district court litigation. Prelim. Resp. 2–3. Patent Owner contends that “opening *Markman* briefs are scheduled on March 30, 2020 and the jury trial will likely be scheduled for July 2020, which is substantially sooner than a trial before the Board on May 20, 2021.” *Id.* at 2. Patent Owner further contends that Petitioner “relies on the same prior art (Kress, Kross, Carsberg, Perritt, and Lundblad) and arguments in its district court invalidity contentions as asserted in the Petition.” *Id.* Patent Owner also argues that “[i]t will be inefficient for the

both the Board and the district court to analyze and resolve the very same issues in duplicative proceedings and it will be inefficient use of Board's resources under the facts and circumstances here to institute a trial." *Id.* at 3.

In its Reply, Petitioner argues that the district court's "schedule does not permit a trial in 2020, much less by July 2020" as Patent Owner alleges.

Pet. Reply 1. Petitioner points to a number of deadlines set forth in the district court litigation relating to the *Markman* hearing, fact discovery, expert reports, expert discovery, and dispositive motions. *Id.* at 1–2.

Petitioner contends that the dates indicate "that expert discovery won't close until at least 195 days after the *Markman* ruling" and dispositive motions need not be filed until 225 days after the *Markman* ruling. *Id.* at 2 n.1.

Petitioner notes that further time will be necessary for the district court to decide *Markman* issues, receive briefing and deciding dispositive motions, and time for pretrial motions. *Id.* at 2–3. Petitioner also contends that previous statements by Patent Owner that Petitioner will "plead for settlement" after the *Markman* ruling are misplaced given Petitioner's confidence in its positions. *Id.* at 2 n.2.

In its Sur-reply, Patent Owner argues that nothing in the district court litigation scheduling orders "precludes trial in 2020, and, more specifically, in July 2020" or resolution of the district court litigation "without a trial." PO Sur-reply 1. According to Patent Owner, merely because the schedule allows for "a *Markman* hearing does not mean that the Court will require a *Markman* hearing after receiving the parties' claim construction briefs." *Id.* at 2. Patent Owner contends that once the *Markman* ruling issues, Petitioner "would either immediately plead for settlement and if not—Patent Owner will file a summary judgment of infringement." *Id.* at 2–3. Patent Owner

also contends that the district court litigation “will not require expert discovery for the reason that it will be resolved at the claim construction stage.” *Id.* at 3.

In *NHK*, the trial in the district court proceeding was set to conclude six months before a final Board decision would be due. *See NHK*, Paper 8 at 20. Here, however, the trial date in the related district court proceeding has not yet been set. Ex. 1013 (setting forth dates in district court litigation through filing of dispositive motions, and indicating that a “Final Pretrial Conference will be set at a later date.”).

Patent Owner maintains that despite the lack of any trial date, and the months of sequential deadlines set forth in the trial schedule in the district court, a trial will nevertheless be held soon because nothing in those scheduling orders precludes a trial within about 60 days, in July 2020. PO Sur-Reply 1. We decline to speculate as to when a trial in the related district court proceeding will occur. We see no basis for Patent Owner’s contention that we should deny institution because Petitioner will “immediately plead for settlement” as soon as the *Markman* ruling issues. *Id.* at 2–3. Again, we decline to speculate here as to what events *may* take place based on whether we exercise our discretion to deny institution in this proceeding.

Patent Owner’s argument that it will immediately move for summary judgment of infringement after receiving a *Markman* ruling also lacks foundation. *See* PO Sur-reply 3. Patent Owner apparently assumes that the district court will entertain a dispositive motion before fact and expert discovery end, and deprive Petitioner of the ability to engage in such discovery in an effort to oppose Patent Owner’s dispositive motion. *See*

Ex. 1013. We again decline to speculate as to what may or may not happen in the district court proceeding.

Patent Owner's argument that the district court litigation "will not require expert discovery" because the entire case "will be resolved at the claim construction stage," if true, could suggest an earlier trial date than the dates set forth in the district court's scheduling order might suggest. *See* PO Sur-reply 3. That is, Patent Owner's argument asks us to speculate as to what may occur in the related district court proceeding. We decline to do so.

Based on the record before us, where a trial date as not be scheduled in a related district court proceeding, we will not speculate as to the timing of events that may occur in that proceeding.

We address briefly the other factors set forth in the precedential *Fintiv* Order.⁸ As to the first factor, we have no evidence in the record before us that the district court has granted a stay, or that the district court has commented on the possibility of a stay in this case. Thus, this factor is neutral. The third factor weighs against discretionary denial because the parties and the court have not invested substantial effort on the substantive issues in the district court case at this stage. For instance, the district court has not yet held a claim construction hearing or issued a claim construction order. As to the fourth factor, the parties do not dispute that overlap exists between the invalidity issues in this case and in the district court. This overlap may inure to the district court's benefit, however, by simplifying issues for trial should we reach our determination on the challenges raised in the Petition before trial. Finally, the fact that the defendant in the district

⁸ The *Fintiv* Order was designated precedential on May 5, 2020, after briefing was complete.

court and the petitioner in this case are the same parties weighs slightly in favor of denial. On balance, the factors in this case weigh against discretionary denial. Based on the foregoing, we decline to exercise our discretion under 35 U.S.C. § 314(a).

C. Level of Ordinary Skill in the Art

Petitioner contends that a person having ordinary skill in the art “would have at least a Bachelor’s degree in Mechanical Engineering and at least four years of experience in pump design, with some general familiarity with manufacturing techniques such as injection molding, or equivalent education and training.” Pet. 11. Patent Owner does not address this issue in its Preliminary Response.

For purposes of this Decision, we preliminarily adopt Petitioner’s asserted level of ordinary skill because it is consistent with the problems addressed by the ’494 patent and the prior art of record.

D. Claim Construction

We interpret claims in the same manner as 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) (2019). Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Petitioner argues that the claims should “be given their ordinary and customary meaning” for purposes of this proceeding. Pet. 10–11. Patent Owner does not propose any explicit constructions for any claim terms.

Based on the record before us, we need not expressly construe any claim terms to resolve the issues presented in this Decision.

E. Obviousness of Claims 1–4 and 6 Based on Carsberg, Kross, and Kress

Petitioner challenges claims 1–4, and 6 under 35 U.S.C. § 103 based on Carsberg, Kross, and Kress. Pet. 26–33.⁹ For these challenges, Petitioner cites to the asserted references and the Jones Declaration. *Id.*

For the reasons discussed below, Petitioner has shown that there is a reasonable likelihood that it would prevail with respect to at least independent claim 1.

1. Legal Standard

A claim is unpatentable as obvious under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

⁹ As noted above (*see supra*, note 1), although Petitioner describes “Ground 1” as a challenge to claims 1–11 based on Carsberg, Kross, Kress, and Lundblad, Petitioner does not rely on Lundblad for claims 1–4 and 6. *See* Pet. 26–33.

2. Overview of Carsberg

Carsberg relates to “powder blowers” that force air into a powder container such that air and powder escape from the container. Ex. 1008, 1:9–12. The air is “compressed by means of a resilient deformable bulb attached to a head-piece which is secured to the powder container.” *Id.* at 1:12–15.

Carsberg’s Figure 2 is reproduced below.

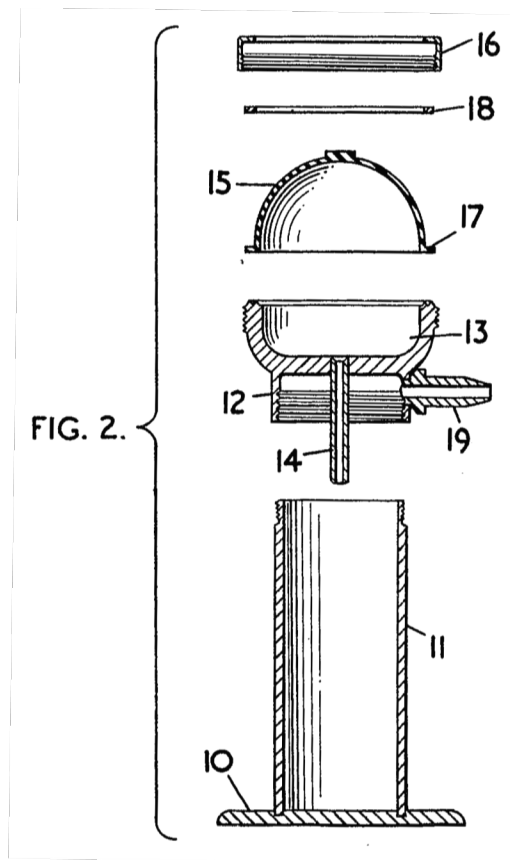


Figure 2 depicts “a sectional side elevation of the separated components of the blower.” Ex. 1008, 1:71–72. Rubber bulb 15 sits on top of cup 13, with ring 16 connecting bulb 15 and cup 13. *Id.* at 1:81–84, Figs. 1, 2. Short tube 14 extends downward from cup 13 into container 11. *Id.* at 1:77–80, Fig. 2. Outlet nozzle 19 extends from collar 12, which is integral with

cup 13, with nozzle 19 communicating with the inside of container 11. *Id.* at 2:7–8, Fig. 2.

When in use, Carsberg states that the device “can be picked and operated with one hand, either the thumb or a finger being used to depress the bulb.” Ex. 1008, 2:18–21. The user can apply a desired quantity of powder by controlling the amount of pressure applied to the bulb. *Id.* at 2:22–28.

3. *Overview of Kross and Kress*

Kross discloses an attachment to a milk bottle to separate the cream from the milk. Ex. 1005, 1:1–5. In Kross’s device, air enters the device via air inlet duct 16 in body 1 of the device, passing through valve 13, and into a cylindrical area under bulb 6. *Id.* at 1:15–16, 1:50–54, Fig. 4. A user operates the device by pressing and releasing bulb 6 to draw air through duct 16, and expelling air through air duct 17 that extends downward through body 1 of the device. *Id.* at 1:54–2:3, 2:11–17, Figs. 1, 4.

Kress discloses an applicator for hair building cosmetic fibers, powders, and particles. Ex. 1007, code (57). Kress’s device includes a nexus 32 attached to lid 24 of container 22. *Id.* at 4:17–26, Fig. 5. Directing tube 38 extends between the underside of nexus 32 at orifice 44 on one end, and nozzle 42 that can be directed towards an area of treatment on the other end. *Id.* at 4:34–42, Figs. 2, 5, 7A.

4. *Discussion of Claim 1*

a) *Disclosure of the Limitations of Claim 1*

Petitioner asserts that the combination of Carsberg, Kross, and Kress discloses all limitations of claim 1. Pet. 26–38. Petitioner provides analysis of each limitation in claim 1, with citations to the references that correspond

to each of the claim limitations. *Id.* Petitioner also cites to the relevant declarant testimony. *Id.* (citing various portions of Ex. 1003). Although Patent Owner addresses the failure of specific references to disclose certain limitations, Patent Owner does not argue that the combination fails to disclose any specific limitation. Prelim. Resp. 3–12.¹⁰

The preamble of Claim 1 states: “A pump cap for dispensing a cosmetic media from a receptacle, the receptacle having a base and an outer upright peripheral wall extending from the base to define a receptacle chamber for the cosmetic media, the upright peripheral wall terminating in an open end.” Petitioner asserts that, to the extent the preamble limits the claim, Carsberg’s powder blower having container 11 for holding the powder discloses the contents of the preamble. Pet. 26 (citing Ex. 1003 ¶ 102; Ex. 1008, 1:29–35). To the extent that the preamble limits the claim, Petitioner establishes sufficiently, based on the current record, that Carsberg’s container 11 discloses the claim terms related to the receptacle, and the powder discloses a “cosmetic media” recited in the preamble. *See id.*

Claim 1 requires “a closure including a top wall which terminates in a downward depending peripheral wall . . . [and] a deformable dome secured to said top wall of the closure to provide an air-tight dome chamber between said deformable dome and said top wall of said closure.” Petitioner argues

¹⁰ The only argument by Patent Owner that arguably suggests that the combination fails to disclose a claim limitation is Patent Owner’s assertion that Carsberg can be distinguished from “the claimed invention of the ’494 patent” because it “does not teach hair fibers.” Prelim. Resp. 7. Patent Owner does not tie this argument to any particular claim limitation, and claim 1 does not require “hair fibers.” *See id.*; Ex. 1001, 5:12–52.

that Carsberg discloses the claimed “closure” and “deformable dome” in the form of collar 12 having cup 13 on a top side of collar 12, to which a bulb 15 (i.e., the claimed “deformable dome”) is secured. Pet. 26–27 (citing Ex. 1003 ¶¶ 104–105; Ex. 1008, 1:81–82, 2:38–39, Figs. 1, 2). Petitioner establishes sufficiently, based on the current record, that Carsberg’s collar 12 discloses the claimed “closure” and bulb 15 discloses the claimed “deformable dome.”

Claim 1 requires “an air pump tube for providing airflow from said dome chamber to the open top end of the receptacle . . . , said air pump tube having a top end located in the dome chamber and a bottom end located in the receptacle chamber, said top end being flared out.” Petitioner argues that Carsberg discloses the claimed “air pump tube” meeting the requirements of claim 1, including a “top end being flared out.” Pet. 27–28. More specifically, Petitioner contends that Carsberg’s tube 14 extends from the bottom of cup 13 of collar 12, into container 11, and discloses deforming bulb 15 to provide airflow when a user depresses bulb 15. *Id.* at 27–28 (citing Ex. 1003 ¶¶ 106–107; Ex. 1008, 1:77–80, 2:22–28). Petitioner also contends Carsberg’s Figure 2, when enlarged, shows a “flared out” top end of tube 14. *Id.* at 28 (citing Ex. 1003 ¶ 108; Ex. 1008, 1:77–80, Fig. 2); *see also id.* at 19 (depicting allegedly flared out top end of tube 14). Based on the current record, Petitioner establishes sufficiently that Carsberg’s tube 14 discloses the claimed “air pump tube” required by claim 1, including a “flared out” top end.

Claim 1 requires an “air intake tube” with a number of features:
an air intake tube comprising a first air intake chamber running in a direction substantially parallel to the top wall of the closure and communicating with said peripheral wall of said closure,

and a second air intake chamber communicating with said first air intake chamber and with said dome chamber, said second air inlet chamber being disposed perpendicularly to said first air inlet chamber, and being in communication with said first inlet chamber and said dome chamber, said air intake tube providing airflow from outside the dispenser to said dome chamber when deformable dome is released from a compressed to a non-compressed state.

Ex. 1001, 5:31–42. Petitioner argues that Kross’s air inlet duct 16 discloses the claimed “air intake tube.” Pet. 28–29 (citing Ex. 1002, 33; Ex. 1003 ¶¶ 112–113; Ex. 1005, 1 at 2:50–54, Fig. 4). We address the proposed combination below. Based on the current record, Petitioner establishes sufficiently that Kross’s air inlet duct 16 discloses the claimed “air intake tube” required by claim 1.

Claim 1 requires

an outlet chamber for dispensing cosmetic media from the receptacle, said outlet chamber communicating between a media outlet opening on the peripheral wall of said closure, and a receptacle chamber media opening located on the bottom side of the top wall of said closure, said receptacle chamber media opening being flush against the bottom side of the top wall of the closure.

Ex. 1001, 5:43–52. Petitioner argues that Carsberg’s outlet nozzle 19 discloses the claimed outlet chamber for dispensing cosmetic media, that and that Kress’s orifice 44 on nexus 32 disclose the claimed “receptacle chamber media opening being flush against the bottom side of the top wall of the closure.” Pet. 30 (citing Ex. 1003 ¶¶ 119, 121–123; Ex. 1007, 4:24–26, 5:10–12, Fig. 5; Ex. 1008, 2:7–11, Fig. 2). We address the proposed combination below. Based on the current record, Petitioner establishes sufficiently that Carsberg’s outlet nozzle discloses the claimed “outlet chamber” and Kress’s orifice 44 on nexus 32 discloses the claimed

“receptacle chamber media opening flush against the bottom side of the top wall of the closure” as required by claim 1.

Claim 1’s final limitation requires “such that the dispenser can be held in one hand and cosmetic media may be dispensed by successively compressing and releasing said deforming dome.” Petitioner argues that Carsberg discloses a device that can be held in one hand while compressing and releasing its bulb 15. Pet. 31 (citing Ex. 1003 ¶¶ 124–125; Ex. 1008, 2:18–21 (“[I]t can be picked and operated with one hand.”)). Based on the current record, Petitioner establishes sufficiently that Carsberg’s device can be held in one hand while compressing and releasing a deformable dome.

Based on the foregoing, Petitioner has established a reasonable likelihood that it would prevail in showing that the combination of Carsberg, Kross, and Kress discloses all limitations of claim 1.

b) The Proposed Combination

Petitioner argues that Carsberg, Kross, and Kress are analogous art because they all teach manually activated pump caps that employ pressurized air to move a fluid. Pet. 25 (citing Ex. 1003 ¶ 101). Petitioner proposes two modifications to Carsberg. First, Petitioner proposes modifying Carsberg’s outlet nozzle 19 with Kross’s air intake duct 16. *Id.* at 29. Petitioner argues that a POSITA would recognize that Carsberg’s outlet nozzle 19 “also functions as an air inlet” and that a POSITA would have been motivated to modify outlet nozzle 19 to improve its ability to dispense, while also providing a separate air intake as in Kross “to enable the pump cap to quickly reset the pump cap for multiple uses in quick succession.” *Id.* (citing Ex. 1003 ¶¶ 114–115). Second, as to the combination of Carsberg and Kress, Petitioner argues that a “POSITA would

have recognized that agitated media could more easily have been directed out of the container through an orifice at the bottom side of the top wall of the closure, and as a result would have been motivated to combine the teachings of Carsberg and Kress.” Pet. 30–31 (citing Ex. 1003 ¶ 123).

Patent Owner does not address Petitioner’s specific reasoning for the combination of Carsberg with Kross and Kress. Instead, Patent Owner argues more broadly that “the art taught away from use of the claimed one-handed hair fiber applicator,” including Kress, which “teaches the two-handed applicator, not one-handed one.” Prelim. Resp. 3–4 (citing Ex. 1007, Fig. 5). Patent Owner also argues that Kross, a “liquid-dispensing device,” “would be incapable of disturbing hair fibers and aspirating them” because its tube 9 “would be located in the layer of hair fibers and would get clogged.” *Id.* at 4 (citing Ex. 1005, Fig. 1). Patent Owner asserts that solid substances used in the cosmetic industry would not work in liquid media. *Id.* at 5–6. Patent Owner further asserts that Kross discloses a device “unsuitable for aspiration and ejection of hair fibers and therefore taught away from the invention and are non-analogous prior art.” *Id.* at 6. As to Carsberg in combination with Kress, Patent Owner argues that Petitioner engages in “impermissible hindsight” given the decades of time between the filing of the patents and Kress’s failure to cite to Carsberg, allegedly because it was not analogous art. *Id.* at 7–8. Patent Owner also argues that Petitioner fails to establish a reasonable expectation of success given that the prior art devices, after decades of development, “still teach two-handed applicators.” *Id.* at 9–10 (citing Carsberg and other references).

Based on the current record, Petitioner establishes sufficiently that one of ordinary skill in the art at the time of invention would have been

motivated to modify Carsberg with the teachings of Kross and Kress in the manner Petitioner proposes. Patent Owner raises several factual arguments based on how one of ordinary skill in the art would interpret the references, including Patent Owner's non-analogous art, teaching away, and no reasonable expectation of success arguments. *See, e.g.*, Prelim. Resp. 3, 5–6, 9. Those arguments are not supported by any testimony from one of ordinary skill in the art, and on the current record, amount to unsupported attorney argument. *See id.* Petitioner's arguments are supported by its declarant, and, more broadly, by the Examiner's combination of Kross and Kress despite alleged "teaching away" due to one reference disclosing a liquid dispenser (Kross) and the other a two-handed device (Kress). *See* Pet. 25, 29–31; Ex. 1003 ¶¶ 101, 114–115, 123; Ex. 1002, 33–35.

In addition, although we reach no final determination as to Patent Owner's non-analogous art, teaching away, and no reasonable expectation of success arguments, the current record does not appear to support Patent Owner's factual assertions. For example, the failure of any of the prior art to work with hair fibers is not tied to a requirement recited in claim 1, which merely refers to "cosmetic media," and would seemingly encompass powders in addition to hair fibers. *See* Prelim. Resp. 3–4, 6–12. Further, contrary to Patent Owner's assertion that there can be no expectation of success given the use of two-handed applicators in the prior art, Carsberg refers to one-handed operation. *See* Ex. 1008, 2:18–21 (describing powder blower as able to "be picked and operated with one hand"); Prelim. Resp. 9–10 (arguing that Carsberg and other references "still teach two-handed applicators"). We invite the parties to provide more clarity on these issues during trial.

Based on the evidence of record, Petitioner has established a reasonable likelihood that it would prevail in showing that one of ordinary skill in the art at the time of invention would have been motivated to modify Carsberg with the teachings of Kross and Kress in the manner Petitioner proposes.

c) Objective Indicia of Nonobviousness

Patent Owner argues that Petitioner cannot overcome objective indicia of non-obviousness, including commercial success, long-felt need, industry praise, unexpected results, skepticism, failure of others, copying, and licensing. Prelim. Resp. 12–22. Petitioner asserts in the Petition that it “is unaware of any evidence suggesting the existence of secondary factors of non-obviousness that are actually related to the alleged invention.” Pet. 12.

We do not reach Patent Owner’s arguments as to objective indicia at this time. Petitioner has not had a chance to respond to Patent Owner’s arguments and evidence. Rather than address these issues based on a partial record now, we will allow the record to develop further during trial.

d) Conclusion

Based on our review of the current record, Petitioner has established sufficiently that the combination of Carsberg, Kross, and Kress discloses all limitations of claim 1, and that one of ordinary skill in the art would have been motivated to modify Carsberg based on the teachings of Kross and Kress. Accordingly, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to claim 1.

5. Claims 2–4 and 6

We have also reviewed Petitioner’s challenge to claims 2–4 and 6. Pet. 31–33. Based on our review of Petitioner’s arguments and evidence for

these claims, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing claims 2–4 and 6 to be unpatentable under 35 U.S.C. § 103 based on Carsberg, Kross, and Kress.

F. Obviousness of Claims 5 and 7–11 Based on Carsberg, Kross, Kress, and Lundblad

Petitioner challenges claims 5 and 7–11 under 35 U.S.C. § 103 based on Carsberg, Kross, Kress, and Lundblad. Pet. 32–38. For these challenges, Petitioner cites to the asserted references and the Jones Declaration. *Id.*

Lundblad discloses “a discharge closure for liquid containers.” Ex. 1009, 1:9–10. Lundblad’s device includes bulb 14 attached to body member 5 via flange 7. *Id.* at 1:91–95, Fig. 2. Lundblad’s tube-like extension 22 extends downward from body member 5 a short distance into the interior of container A. *Id.* at 2:6–11. Air passage 23 extends through body member 5 and extension 22, providing communication between container A and air chamber 16 above body member 5 and below bulb 14. *Id.* at 1:96–98, 2:11–15. Lundblad also discloses liquid discharge passage 26 within body member 5, with passage 26 “communicating through a port 27 with the chamber 13 beneath” body member 5. *Id.* at 2:35–38.

Petitioner builds this challenge on top of the previous challenge based on Carsberg, Kross, and Kress, and relies on Lundblad for certain limitations related to a “flange” in claim 5 and a “media outlet chamber” in claim 7. *See id.* at 32–33 (citing Ex. 1003 ¶¶ 134–138; Ex. 1009, 1:91–95), 36 (citing Ex. 1003 ¶¶ 157–158; Ex. 1009, 2:35–47). Petitioner asserts that combining Carsberg and Lundblad would have been a matter of design choice. *Id.* at 33 (citing Ex. 1003 ¶¶ 134–138).

Patent Owner’s arguments discussed above apply equally to this challenge. Patent Owner also raises arguments as to Lundblad that track

those arguments. For example, Patent Owner argues that Lundblad, like Kross, is a liquid-dispensing device, and Lundblad merely discloses two-handed operation. Prelim. Resp. 8–10. For the same reasons discussed above, based on the current record, these arguments do not undermine Petitioner’s arguments and evidence.

Based on our review of the current record, Petitioner has established sufficiently that the combination of Carsberg, Kross, Kress, and Lundblad discloses all limitations of claims 5 and 7–11, and that one of ordinary skill in the art would have been motivated to modify Carsberg based on the teachings of Kross, Kress, and Lundblad. Accordingly, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to claims 5 and 7–11.

G. Obviousness of Claims 1–11 Based on Lundblad, Kross, and Kress

Petitioner challenges claims 1–11 under 35 U.S.C. § 103 based on Lundblad, Kross, and Kress. Pet. 39–49. For these challenges, Petitioner cites to the asserted references and the Jones Declaration. *Id.*

In this challenge, Petitioner relies on Lundblad as the primary reference that discloses the majority of limitations in the claims. *See* Pet. 39–49. For example, Petitioner contends that Lundblad’s “passage 23 defined by extension 22 is flared out” and discloses the claimed “air pump tube” with a “top end being flared out” as required by claim 1. Pet. 21 (citing Ex. 1003 ¶¶ 92–93; Ex. 1009, 2:80–94, Fig. 2), 41–42 (citing Ex. 1003 ¶¶ 174–175; Ex. 1009, Fig. 2; MPEP § 2125). Petitioner asserts that combining Lundblad with Kress would have been an obvious matter of design choice and combining Lundblad and Kross to incorporate Kross’s

intake tube “provide[s] greater flexibility in the choice of valve used.” *See, e.g., id.* at 40, 42 (citing Ex. 1003 ¶¶ 172, 176).

Patent Owner’s arguments discussed above apply equally to this challenge. For the same reasons discussed above, based on the current record, these arguments do not undermine Petitioner’s arguments and evidence.

Based on our review of the current record, Petitioner has established sufficiently that the combination of Lundblad, Kross, and Kress discloses all limitations of claims 1–11, and that one of ordinary skill in the art would have been motivated to modify Lundblad based on the teachings of Kross and Kress. Accordingly, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to this challenge to claims 1–11.

H. Obviousness of Claims 1–11 Based on Kross, Kress, Perritt, Lundblad

Petitioner challenges claims 1–11 under 35 U.S.C. § 103 based on Kross, Kress, Perritt, and Lundblad. Pet. 50–63. For these challenges, Petitioner cites to the asserted references and the Jones Declaration. *Id.*

In this challenge, Petitioner relies on the same art before the Examiner and argues that, as the Examiner found, the combination of Kross, Kress, and Perritt disclose all limitations of the claims with the exception of the “flared out” top end of the air pump tube. *See* Pet. 50–63. As with the previous challenge, Petitioner relies on Lundblad’s passage 23 as disclosing the “flared out” limitation. *Id.* at 53–54. Petitioner also sets forth reasoning in support of the proposed combination of prior art. *See id.* at 52 (citing Ex. 1003 ¶ 219), 54 (citing Ex. 1003 ¶¶ 225–227).

Patent Owner's arguments discussed above apply equally to this challenge. Patent Owner also argues that Perritt, like Kross, discloses a liquid-dispensing device not cable of working with hair fibers. *See* Prelim. Resp. 4–6. For the same reasons discussed above, based on the current record, these arguments do not undermine Petitioner's arguments and evidence.

Based on our review of the current record, Petitioner has established sufficiently that the combination of Kross, Kress, Perritt, and Lundblad discloses all limitations of claims 1–11, and that one of ordinary skill in the art would have been motivated to modify Kross, Kress, and Perritt with Lundblad's teachings. Accordingly, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to this challenge to claims 1–11.

I. Obviousness of Claims 1–11 Based on Kross, Kress, Perritt, and the Knowledge of a POSITA

Petitioner challenges claims 1–11 under 35 U.S.C. § 103 based on Kross, Kress, Perritt, and the knowledge of a POSITA. Pet. 50–63. For these challenges, Petitioner cites to the asserted references and the Jones Declaration. *Id.*

In this challenge, Petitioner again relies on the same art before the Examiner and argues that, as the Examiner found, the combination of Kross, Kress, and Perritt disclose all limitations of the claims with the exception of the “flared out” top end of the air pump tube. *See* Pet. 50–63. For this challenge, Petitioner argues that if we use Patent Owner's implicit construction for “flared out” from the district court litigation that covers “any widening” of the top end of the air pump tube, the limitation covers “the well-known manufacturing feature of rounded edges or ‘fillets.’”

Pet. 50 (citing Ex. 1003 ¶¶ 263–300); *see also id.* at 23–25. Patent Owner’s position from the district court litigation posits that a “flared out” top end of a tube, such as that shown in Figure 2 of the ’494 patent, encompasses “what is known in manufacturing as [sic] ‘fillet’ transition.” Ex. 1011, 14, 25.

Patent Owner also asserted in the district court litigation that “[b]ecause the diameter of the outside edge of the fillet transition is greater than the diameter of the inside tube, it is ‘flared out,’” and that there is no “limitation of the diameter and/or size of the ‘flare out’ element at the top end of the air pump tube.” *Id.* at 14. Petitioner asserts that such rounded edges or fillets were well known to a POSITA due to their common use with injection molded parts. *Id.* at 23–24 (citing Ex. 1003 ¶¶ 95–100; Ex. 1012, 5–6).

Petitioner also sets forth reasoning in support of the proposed combination of prior art. *See id.* at 50 (citing Ex. 1003 ¶¶ 263–300), 52 (citing Ex. 1003 ¶ 219), 54 (citing Ex. 1011, 14).

Patent Owner’s arguments discussed above as to Kross, Kress, and Perritt apply equally to this challenge. Patent Owner does not address Petitioner’s use of Patent Owner’s positions from the district court litigation.

As in the previous challenge, based on the current record, Petitioner establishes sufficiently that Kross, Kress, and Perritt disclose all limitations of these claims with the exception of the “flared out” limitation. Petitioner also establishes sufficiently, based on the current record, that: (1) if we construe the “flared out” limitation as broadly as Patent Owner suggests in the district court litigation, that any round or fillet at the top end of the air pump tube, no matter how small, would meet that limitation and (2) such

features were well known in the injection molding art and would have been obvious to incorporate in the proposed combination.¹¹

Based on our review of the current record, Petitioner has established sufficiently that the combination of Kross, Kress, Perritt, and the knowledge of a POSITA discloses all limitations of claims 1–11, and that one of ordinary skill in the art would have been motivated to modify Kross, Kress, and Perritt with the knowledge of a POSITA. Accordingly, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to this challenge to claims 1–11.

CONCLUSION

Because Petitioner has shown that there is a reasonable likelihood that it would prevail with respect to at least one of the challenged claims, we institute an *inter partes* review of all challenged claims on all presented challenges.

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claims or any underlying factual and legal issues.

¹¹ Although we apply Patent Owner’s implicit construction as Petitioner proposes, without opposition from Patent Owner, we do not necessarily agree that the construction accurately defines the metes and bounds of the “flared out” limitation. The ’494 patent does not describe the “flared out” limitation with any text, and Figure 2 shows a top end of the tube “flared out” in an easily recognizable, conical manner. *See* Ex. 1001, Fig. 2. The construction Petitioner relies upon here may be too broad by encompassing any rounded edge, or widened diameter, at the top end of the tube, no matter how small. *See* Ex. 1011, 14. We doubt that a POSITA would read the claim term that broadly, and we invite the parties to address this issue further during trial.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–11 of U.S. Patent No. 7,841,494 B2 is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of U.S. Patent No. 7,841,494 B2 shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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