

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHAMPION LABORATORIES, INC., FIRST BRANDS GROUP, LLC,
Petitioner,

v.

HENGST SE,
Patent Owner.

IPR2024-00603
Patent 9,023,203 B2

Before KIMBERLY McGRAW, ELIZABETH M. ROESEL, and
SHELDON M. McGEE, *Administrative Patent Judges*.

McGEE, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314

I. INTRODUCTION

Petitioner filed a Petition (Paper 2, “Pet.”) for institution of an *inter partes* review of claims 1, 3, 5, 8–11, 15–17, 19, 23–25, and 28–30 of U.S. Patent No. 9,023,203 B2 (Ex. 1001, “the ’203 patent”). Patent Owner filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With Board authorization (Ex. 3001), Petitioner filed a Preliminary Reply (Paper 7), and Patent Owner filed a Preliminary Sur-reply (Paper 8).

The parties identify a district court action as a related matter: *Hengst SE v. Champion Laboratories, Inc.*, No. 23-cv-00794 (N.D. Ill). Pet. 4; Paper 3, 1.

II. BACKGROUND

A. The ’203 Patent (Ex. 1001)

The ’203 patent “relates to a liquid filter, in particular an oil filter for an internal combustion engine.” Ex. 1001, 1:5–6. The filter has a filter material body having top and bottom panels, where “an eccentric blocking element [is] arranged on the bottom front panel for engaging an eccentric opening in [a] filter housing.” *Id.* at 15:59–65 (independent claim 1); *see also* 17:37–43 (independent claim 15).

One embodiment of the ’203 patent’s eccentric blocking element is illustrated in Figure 8, reproduced below:

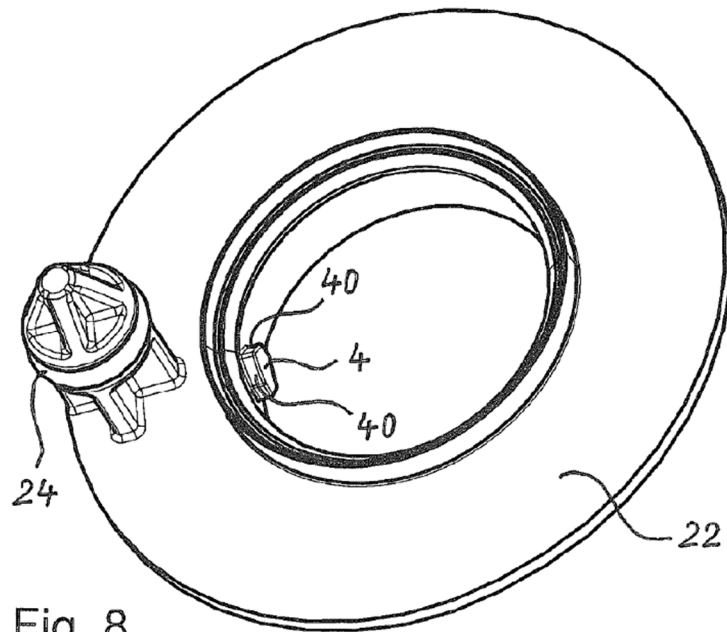


Fig. 8

Figure 8 of the '203 patent, reproduced above, depicts a bottom view of front panel 22, which has a through hole centrally located therein.

Ex. 1001, 8:52–58. Nose 4 is located on the inner circumference of the through hole in front panel 22, with blocking element 24 eccentrically located on the bottom of front panel 22. *Id.*

Figure 7 of the '203 patent, reproduced below, shows the interaction of two individual parts: front panel 22 (as viewed from the opposite (top) side) and centrally-arranged pipe nozzle 15 having two partial inclined planes 3.1 and 3.2 “which run towards each other and which merge into an axial guide 31 at their lower end.” Ex. 1001, 8:19–33.

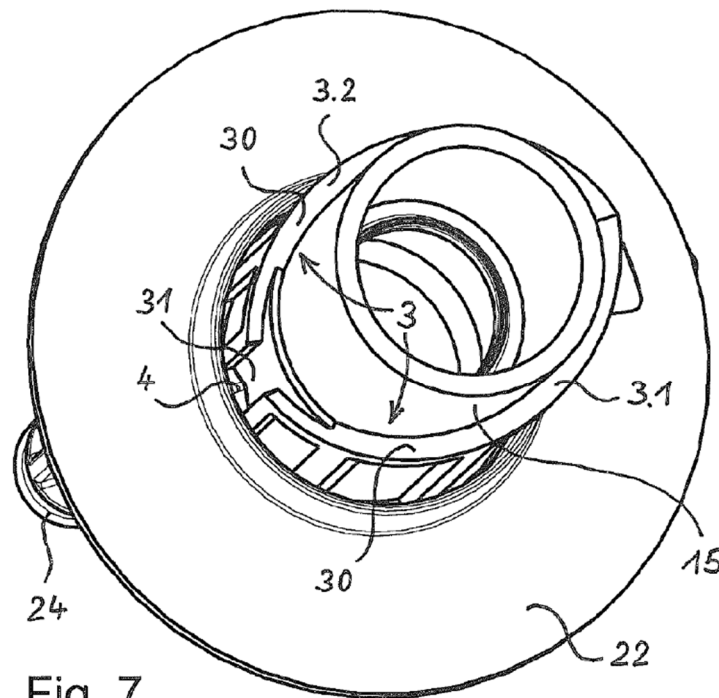


Fig. 7

Figure 7, reproduced above, depicts the top view of front panel 22 and illustrates how nose 4 slots into axial guide 31 as front panel 22 slides down pipe nozzle 15. Ex. 1001, 8:27–33. If front panel 22 is not positioned in the first instance to properly align the eccentric blocking element and the eccentric opening in the filter housing,

nose 4 initially impacts the inclined plane 3, here one of its partial planes 3.1 or 3.2. In response to a further downwards movement, the front panel 22 is inevitably brought into the correct rotation . . . by means of the nose 4, which slides on the inclined plane 3.

Id. at 8:39–44. This is the “correct position” for eccentric blocking element 24 vis-à-vis “the outlet, which is engagement-compatible for the blocking element.” *Id.* at 8:44–45.

B. Challenged Claims

Of the challenged claims, claims 1 and 15 are independent. Claim 1 is representative of the challenged claims and is reproduced below with Petitioner's limitation identifiers for ease of reference:

- 1[pre] A liquid filter, comprising:
 - [a] a filter housing,
 - [b] a ring filter insert, replaceably arranged in the filter housing, and
 - [c] a removable cover arranged to close the filter housing during operation,
 - [d] the filter housing including at least one inlet for raw liquid to be filtered, which inlet leads into a raw side of the filter housing, and
 - [e] a return extending from a clean side of the filter housing for filtered clean liquid,
 - [f] an eccentric opening arranged in a bottom of the filter housing,
 - [g] the ring filter insert comprising a hollow-cylindrical filter material body, surrounded on front sides by top and bottom front panels, the ring filter insert separating the raw side of the filter housing and the clean side of the filter housing from each another,
 - [h] an eccentric blocking element for the eccentric opening arranged on the bottom front panel,
 - [i] first and second interacting positioning means each on one of the ring filter insert and the filter housing and arranged to bring the blocking element into engagement with the eccentric opening when the ring filter insert is inserted into the filter housing,
 - [j] the first positioning means comprising an inclined plane,
 - [k] the second positioning means comprising a protruding nose which is arranged opposite the inclined plane, and
 - [l] the inclined plane and the nose arranged to be movable in relation to each other in such a way that they slide along each other and bring the blocking element into engagement with the eccentric opening, by rotating the ring filter insert relative to the filter housing,

- [m] the inclined plane being one of embodied and arranged on one of the inner circumference of the ring filter insert and the outer circumference of a filter housing part arranged inside the ring filter insert and the protruding nose being one of embodied and arranged on the other of the inner circumference of the ring filter insert and the outer circumference of the filter housing part,
- [n] the inclined plane comprising an incline which excludes a self-locking and
- [o] the eccentric opening being an outlet for emptying the filter housing when the filter insert is removed.

Ex. 1001, 15:46–16:22; Pet. -vi-, -vii-.

C. Asserted Grounds of Unpatentability

Petitioner advances three grounds asserting that the subject matter of claims 1, 3, 5, 8–11, 15–17, 19, 23–25, and 28–30 are unpatentable as set forth in the following table.

Claims Challenged	Statutory Basis	Reference(s)
15–17, 19, 23, 25, 30	§ 103	Yokoyama ¹
15–17, 19, 23–25, 28, 30	§ 103	Yokoyama, Cline ²
1, 3, 5, 8–11, 15, 17, 19, 23–25, 28–30	§ 103	Honermann, ³ Cline

Pet. 5. Petitioner’s challenge is supported by the Declaration of Mr. Michael Nranian (Ex. 1003).

¹ JP 2004-136203, published May 13, 2004 (Ex. 1007), the certified English translation of which is filed as Exhibit 1008.

² US 2004/0232063 A1, published November 25, 2004 (Ex. 1009).

³ US 2010/0044295 A1, published February 25, 2010 (Ex. 1006).

III. ANALYSIS

We have authority to institute an *inter partes* review only where “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). The findings and conclusions set forth in this Decision are provided for the exclusive purpose of explaining our determination that Petitioner has met that standard on this record. Also, for the reasons discussed below, we determine that Patent Owner has not provided us with a persuasive reason to exercise our discretion to deny institution.

A. *Level of Ordinary Skill in the Art*

Petitioner contends that a person having ordinary skill in the art (“POSITA”) would have had

at least a master’s degree in chemical, electrical, mechanical, or automotive engineering, and at least two or more years of experience in the automotive industry designing, developing, testing, and engineering automotive components or practical experience servicing, assembling, repairing, and/or developing internal combustion engines and/or engine oil filters (or equivalent experience)

Pet. 5–6 (citing Ex. 1003 ¶ 50). Petitioner further states “that more education could compensate for less experience and vice versa.” *Id.* at 6. Petitioner’s position is, therefore, consistent with Patent Owner’s proffered level of skill in the art which reflects less education and more experience in substantially the same fields. Specifically, Patent Owner asserts that such a skilled artisan “would have at least a bachelor’s degree in mechanical or automotive engineering and/or five or more years of experience in the automotive industry designing, developing, testing, and engineering

automotive components or practical experience servicing, assembling, repairing, and/or developing internal combustion engines and/or engine oil filters.” Prelim. Resp. 4.

On this record, we determine that the level of ordinary skill is reflected in the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (specific findings on the ordinary skill level are not required “where the prior art itself reflects an appropriate level and a need for testimony is not shown” (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163–64 (Fed. Cir. 1985))). A more specific definition is not necessary for purposes of deciding whether to institute review. To the extent a more specific definition is required, however, we adopt Patent Owner’s definition because it is consistent with the disclosures of the asserted prior art references. We note, however, that we would reach the same conclusion under either parties’ definition.

B. *Claim Construction*

In an *inter partes* review, we construe a claim in an unexpired patent that would be “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). “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc).

Petitioner asserts that all non-“means” terms in the challenged claims should be afforded their plain and ordinary meaning, and that the “means” limitations recited in claims 1 and 15 should not be construed as means-plus-

function terms pursuant to 35 U.S.C. § 112(6). Pet. 7. According to Petitioner, claims 1 and 15 include additional limitations that denote structure for those “means” limitations and furthermore do not recite a function corresponding to the recited means. *Id.*

Patent Owner asserts that “the Board need not make a determination on claim construction in assessing whether to institute” trial. Prelim. Resp. 5.

After review of the preliminary record, we determine that no claim terms require an express construction for purposes of institution. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy.’”).

C. Request for Discretionary Denial under 35 U.S.C. § 325(d)

Patent Owner asserts that we should discretionarily deny the Petition under § 325(d). Prelim. Resp. 16–23. Specifically, Patent Owner asserts that we should exercise our discretion under 35 U.S.C. § 325(d) and deny the petition because two of Petitioner’s asserted references (Yokoyama and Cline) were already considered by the Office, and because the remaining reference relied on by Petitioner (Honeremann) is cumulative to such already considered art. *Id.* at 16–18. Patent Owner also asserts that Petitioner has failed to show material error in that consideration. *Id.* at 18–23. For its part, Petitioner argues that we should not exercise our discretion under § 325(d). Pet. 19–23.

1. The Legal Standard

In evaluating matters under § 325(d), the Board uses the two-part framework set forth under *Advanced Bionics, LLC v. Med-El*

Electromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*” or “*AB*”). Under the first prong of that framework, we must determine whether the same or substantially the same art or arguments previously were presented to the Office. If so, we turn to the second prong which focuses on whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. *Id.* at 8.

2. *Advanced Bionics Prong One: whether “the same or substantially the same art or arguments previously were presented to the Office”*

As Petitioner acknowledges, a Japanese-language version of Yokoyama was cited in an IDS without an English translation. Pet. 19; Ex. 1002, 34 (indicating that an English translation was not provided by virtue of the absence of a checkmark in the “T” column on the far right of the PTO/SB/08a form).⁴ The Yokoyama reference relied on in the Petition (Ex. 1008) however, includes an English language translation of the text in

⁴ It is also not readily apparent that Patent Owner complied fully with the “Content Requirements for an Information Disclosure Statement” as set forth in MPEP § 609 in its IDS submission dated March 30, 2015. Specifically, § 609.04(a)(III) states that “[e]ach information disclosure statement *must* further include a concise explanation of the relevance . . . of the information listed that is not in the English language.” (italicized emphasis added, underlining in original); *see also* § 609.01 B.3 (stating this requirement). It does not appear that any concise explanation was filed with respect to either Japanese reference filed in the IDS. *See* Ex. 1002, 13–38 (IDS documents pertaining to Yokoyama reference); *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1376 (Fed. Cir. 2000) (“[A]lthough MPEP Section 609[] allows the applicant some discretion in the manner in which it phrases its concise explanation, it nowhere authorizes the applicant to intentionally omit altogether key teachings of the reference.”).

addition to the Drawings that also appear in the untranslated Japanese-language version of Yokoyama submitted during prosecution. *Compare* Ex. 1007 (containing Japanese text with Figures 1–7c), *with* Ex. 1008 (containing English text along with Figures 1–7c). As such, the Yokoyama reference relied on in the Petition—being in English—contains roughly ten pages of more readily discernible information than the Japanese-language version of this reference submitted during prosecution. Significantly, Petitioner relies on *textual disclosure* in the *English-translated* version of Yokoyama in its challenges. Pet. 28–51, 54, 58, 59 (citing Ex. 1008 repeatedly). Such English-translated disclosure was not previously before the Examiner. Ex. 1002, 13–38. In view of this additional disclosure before us in English, i.e., disclosure that was not presented previously to the Office, we find that the English translated version of Yokoyama relied on here (Ex. 1008) is not “the same or substantially the same art” that was previously presented to the Office (Ex. 1007).

Regarding Cline, Petitioner indicates that this reference “was cited in an IDS and briefly mentioned in the examiner’s notice of allowance.” Pet. 19–20 (citing Ex. 1002, 132). Patent Owner echoes Petitioner’s statement that Cline was submitted in an IDS. Prelim. Resp. 17.

Both parties are wrong regarding Cline. Specifically, Petitioner presents two challenges that include “Cline” where “Cline” is identified as “U.S. Patent Pub. No. 20040232063” filed as Exhibit 1009. *See, e.g.*, Pet. v, 52– 5, The “Cline” reference that is referenced in the ’203 patent file history, however, is US 6,572,768. Ex. 1002, 132; *see also* Ex. 1001, 1–2 code (56)

(identifying US 6,572,768 B1” as a patent “cited by [the] examiner”⁵). The parties do not explain—and we are unable to discern—how the Cline reference relied on in the Petition (i.e., US 2004/0232063 A1; Ex. 1009) is the same or substantially the same art as the Cline reference that was before the Examiner during prosecution and cited on the face of the ’203 patent (i.e., US 6,572,768 B1). We have reviewed each of the “Cline” references and find they contain different figures and disclosure. Thus, it is not at all clear on this preliminary record how the Cline reference relied on here is the same or substantially the same art that was previously before the Office.

We need not address whether Honermann is the same or substantially the same art or arguments as previously presented to the Office pursuant to *AB* prong one for several reasons. First, the parties agree that this reference was not before the Office previously. Pet. 19; Prelim. Resp. 17. Also, all three challenges set forth in the Petition rely at least in part on Yokoyama and/or Cline, i.e., art that we have already found to be materially different than that previously presented. *See* Pet. 5 (summarizing Grounds 1–3).⁶

3. *Conclusion regarding 35 U.S.C. § 325(d)*

We find that the same or substantially the same art relied on in the Petition previously was not presented to the Office, and thus do not consider

⁵ This reveals further error in both parties’ statements that “Cline” was filed in an IDS.

⁶ For this reason, we also need not consider the persuasiveness of Patent Owner’s assertion that Honermann is cumulative or substantially similar to Yokoyama. Prelim. Resp. 17–18. Such a determination would be moot for purposes of determining if we should exercise our discretion to deny institution under § 325(d) because we have already determined that Yokoyama (Ex. 1008) was not previously considered by the Office.

prong two of the *Advanced Bionics* analysis. We, therefore, decline to exercise discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d).

D. Request for Discretionary Denial under 35 U.S.C. § 314(a)

Patent Owner also argues that we should exercise our discretion to deny institution under 35 U.S.C. § 314(a) and not institute trial. Prelim. Resp. 6–16. Petitioner disagrees. Pet. 23–25.

When determining whether to exercise discretion to deny institution in view of a parallel proceeding, we consider the following factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* In evaluating the *Fintiv* factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review,” recognizing that “there is some overlap among these factors” and that “[s]ome facts may be relevant to more than one factor.” *Id.* at 6.

On June 21, 2022, the Director of the United States Patent and Trademark Office issued a Memorandum setting forth an “Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation.”⁷ The Guidance Memo states that “to benefit the patent system and the public good, the PTAB will not rely on the *Fintiv* factors to discretionarily deny institution in view of parallel district court litigation where a petition presents compelling evidence of unpatentability.” *Id.* at 2. “Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” *Id.* at 4.

In the analysis that follows, we first consider whether *Fintiv* factors 1–5 weigh in favor of denying institution, and, if so, we must also determine whether the Petition presents compelling merits. *See CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4 (PTAB Feb. 27, 2023) (precedential) (“In circumstances where ... the Board’s analysis of *Fintiv* factors 1–5 favors denial of institution, the Board shall then assess compelling merits.”).

1. Likelihood of a Stay

Petitioner asserts that the District Court has not granted a stay and that no request for such a stay has been filed. Pet. 23; Paper 7, 1. Patent Owner agrees that no stay has been granted. Prelim. Resp. 6–7. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative), cautions against speculating whether the district court would

⁷ https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf (“Guidance Memo”).

grant a stay if one were requested. Thus, we decline to speculate and determine this factor is neutral.

2. Proximity of Trial Date to Projected Statutory Deadline

Petitioner asserts that “[t]he Court has not set a trial date,” which “heavily weighs in favor of institution.” Pet. 23. Patent Owner provides an “Estimated Patent Case Schedule” for the District Court for the Northern District of Illinois, which reflects that a trial date would be expected on June 25, 2025. Prelim. Resp. 8 (citing Ex. 2010). According to Patent Owner, that date would be “over three months before the Board would issue a final written decision [in] this proceeding.” *Id.*

The Guidance Memo states that “[p]arties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides for the PTAB’s consideration.” Guidance Memo 8–9. Patent Owner’s “Estimated Patent Case Schedule” is not based on the most recent statistics for the Northern District of Illinois,⁸ which indicate a median time-to-trial of 56.9 months, not 102 weeks as stated by Patent Owner. Ex. 2010, 2. Based on the February 8, 2023 filing date in the Northern District of Illinois provided by both parties (Paper 3, 1; Pet. 4), a trial date in the parallel litigation would be expected in November 2027. We disagree with Patent Owner (Paper 8, 2–3) that we should disregard the published median time-to-trial statistics and, instead, rely on Patent Owner’s proffered estimate of 102 weeks after the filing of the Complaint or 52 weeks after the filing of the Joint Claim Construction Chart. Prelim. Resp. 8; Ex. 2010, 2. Patent Owner’s estimated

⁸ <https://www.uscourts.gov/statistics/table/na/federal-court-management-statistics/2024/06/30-1>, last accessed August 14, 2024.

pre-trial deadlines are keyed off the district court’s Claim Construction Ruling date, which is admittedly uncertain. Ex. 2010, 2 (“Six weeks (?)”). Moreover, it is unclear on this record how Patent Owner determined the “Case Ready for Trial” date (*id.*) or how that date relates to a projected trial date. On the other hand, the median time-to-trial statistics relied on by Petitioner were published by a neutral entity which is the same entity referenced at page 9 of the Guidance Memo.

Because we must issue a final written decision within one year of institution, and because the district court trial is estimated to begin over two years after that date, this factor weighs heavily against discretionary denial.

3. *Investment in the Parallel Litigation*

Petitioner makes several contentions regarding the state of the parallel proceeding at the time the Petition was filed. Pet. 23–24. We give those assertions minimal weight because they are not based on the work that will be completed by the parties “at the time of the institution decision.” *Fintiv*, at 9. In its Preliminary Reply, Petitioner states that the parties have not invested significant resources, noting that “less than 17 hours of deposition time was taken and few documents were produced,” that expert discovery has not yet been scheduled, and that no claim construction hearing has been held or order issued. Paper 7, 1–2.

Patent Owner contends that “the Parties have expended tremendous time and resources on the District Court Proceeding” because they “have exchanged initial and final infringement and invalidity contentions, completed all depositions of numerous fact witnesses, completed all briefing on claim construction, and fact discovery has closed.” Prelim. Resp. 9. Patent Owner also asserts that a claim construction hearing “will be held on

August 7, 2024,” with a ruling based on that hearing projected to be issued before the time our institution decision is entered. *Id.* at 9–10; *see also* Paper 8, 3 (indicating “the claim construction hearing was scheduled to and did take place one day after Petitioner’s filed the Reply.”). Patent Owner asserts that “[b]ecause the District Court will have likely issued a claim construction ruling at the time of the Board’s decision on institution and the Parties have expended significant time and resources in the parallel proceeding, this factor weighs in favor of denial.” Prelim. Resp. 10. Patent Owner also points out how Petitioner waited until the last possible day to file its Petition. *Id.* (“If Petitioners had waited another day to file the present proceeding, it would have been barred under 35 U.S.C. § 315(b).”)

We determine that this factor weighs neither in favor of nor against discretionary denial. While some amount of time and resources have been expended in the parallel proceeding (Prelim. Resp. 9–10, Paper 8, 3), a significant amount of work remains because, as set forth above in our discussion of factor 2, trial is projected to begin over three years from the date of this decision.

On the other hand, Petitioner’s delay in filing the Petition on the last possible day before a statutory bar is also relevant under this factor. Petitioner provides no explanation for this timing. *See Pet., generally.* We note that Petitioner filed the Petition over a week after Patent Owner filed its response to Petitioner’s final invalidity contentions. *Compare Pet.* 111 (indicating a Petition filing date of February 22, 2024), *with Ex.* 2004, 9 (Patent Owner’s Response to Final Invalidity Contentions dated February 13, 2024). *See Fintiv* at 11–12 (noting that “if . . . the evidence shows that the petitioner did not file the petition expeditiously, such as at or around the

same time that the patent owner responds to the petitioner’s invalidity contentions, or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.”).

Accordingly, factor 3 weighs neither in favor of nor against exercising discretion to deny institution, i.e., the factor is neutral.

4. *Overlap of Issues*

The ’203 patent includes thirty claims. In this proceeding, Petitioner challenges seventeen of those claims and identifies eight challenged claims that are not being challenged in the parallel proceeding, asserting that we will need to resolve several patentability issues not before the District Court. Pet. 24 (noting that claims 1, 3, 5, 8–11, and 29 challenged here are not at issue in the District Court). Petitioner also sets forth a stipulation that it “will not pursue in the Litigation the specific grounds identified above in connection with the referenced patents and claim.” Pet. 24.

Patent Owner argues that Petitioner’s stipulation is “meaningless” because Petitioner has already raised and abandoned in the parallel proceeding the grounds that are presented here. Prelim. Resp. 11–13; *see also* Paper 8, 3–4 (Patent Owner arguing that Petitioner raised the same grounds at issue here in the parallel proceeding, but ultimately did not include them in the final invalidity contentions).

Although limited in scope, Petitioner’s stipulation “mitigates to some degree the concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sand Revolution II, LLC v. Continental Intermodal Group—Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (informative). Moreover, the fact that Petitioner challenges eight patent claims here that are

not at issue in the parallel proceeding further mitigates our concerns regarding the amount of overlap between the parallel proceeding and the challenges before us. And while we understand Patent Owner’s concern (Prelim. Resp. 14) that there is some overlap between claim 1 (challenged only in this proceeding) and claim 15 (challenged here and in the parallel proceeding), claim 1 contains numerous other limitations (e.g., 1[c], 1[d], 1[e], 1[n], 1[o]) not present in claim 15. *See* Pet. 110–11 (setting forth how claim 1 “mirror[s]” claim 15 for certain other limitations).

For these reasons, we determine that this factor weighs against discretionary denial.

5. Identity of Parties

The parties agree that one of the real parties in interest here, Champion Laboratories, Inc., is the defendant in the parallel proceeding. Pet. 25; Prelim. Resp. 14. Thus, this factor weighs in favor of discretionary denial.

6. Other Circumstances, Including the Merits

a. Compelling Merits Analysis Unnecessary

Under *CommScope*, if we determine that the other *Fintiv* factors favor discretionary denial, we must also consider whether the Petition presents compelling merits. IPR2022-01242, Paper 23 at 4–5. As set forth above, we have considered the circumstances and facts before us in view of *Fintiv* factors 1–5, and determine that:

Factor 1 is neutral,
Factor 2 weighs heavily against discretionary denial,
Factor 3 is neutral,
Factor 4 weighs against discretionary denial, and
Factor 5 weighs in favor of discretionary denial.

Factors 1–5, considered as a whole, collectively weigh against exercising discretion to deny institution. As such, we need not undertake a “compelling merits” analysis as set forth under *CommScope*.

b. The Merits

Even though we do not consider here whether the merits are “compelling,” we do consider the merits of the Petition under *Fintiv* factor 6. As set forth below, we determine that Petitioner has satisfied the reasonable likelihood standard for purposes of institution. Such satisfaction weighs further against discretionary denial of the Petition.

c. Purported Inconsistent Claim Construction Positions

Patent Owner argues that Petitioner has advanced inconsistent claim construction positions here vis-à-vis those advanced in the District Court and, thus, the Petition should not be instituted. Prelim. Resp. 23–25 (citing *ResMed Corp. v. Cleveland Medical Devices Inc.*, IPR2023-00565, Paper 13 (PTAB Sept. 25, 2023); *see also* Paper 8, 5 (advancing a similar argument). Petitioner disputes Patent Owner’s argument. Paper 7, 4–5.

We disagree with Patent Owner that we should discretionarily deny the Petition for this reason (Prelim. Resp. 23; Paper 8, 5), or that it should weigh in favor of discretionary denial. Here, Patent Owner relies on a non-precedential Board decision for the proposition that an inconsistent claim construction advanced in a parallel proceeding should result in denying the Petition. Notably, however, the *ResMed* Decision was highly fact specific where Petitioner asked the Board “to review the unpatentability arguments under a construction it already asserted in the district court is wrong.” *ResMed Corp.*, IPR2023-00565, Paper 13, 17 (PTAB Sept. 23, 2023). Those specific facts are not before us here. Moreover, that Decision is not

binding on this panel and was even vacated by the Director. *ResMed Corp.*, IPR2023-00565, Paper 15 (Vidal Nov. 16, 2023); *see also Philip Morris Products, S.A. v. RAI Strategic Holdings, Inc.*, IPR2020-00921, Paper 13 at 43 (PTAB Aug. 5, 2021) (“Numerous decisions have held that this rule [37 C.F.R. § 42.104(b)] does not require a petitioner to express a subjective belief in the correctness of its proffered claim constructions, nor prohibit a petitioner from relying on claim constructions that it believes are incorrect.” (citing cases)); *10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00086, Paper 8 at 18 (PTAB Apr. 27, 2020) (“Under the circumstances of this case, the rule [37 C.F.R. § 42.104(b)] does not prohibit Petitioner from submitting a claim construction it believes is incorrect and relying on that construction to show how the claim is unpatentable.”).

The parties are welcome to brief this issue further during trial if desired, but we determine that it is not dispositive for purposes of institution.

7. Conclusion regarding Discretionary Denial Under § 314(a)

As discussed above, we determine that *Fintiv* factors 1–5 weigh collectively against discretionary denial of institution. *Fintiv* factor 6 further weighs against discretionary denial because Petitioner establishes a reasonable likelihood for prevailing in its patentability challenge of claim 1 as set forth below.

E. Petitioner’s Challenge of Claim 1 Based on Honermann and Cline

Petitioner challenges independent claim 1 of the ’203 patent as obvious over the disclosures of Honermann and Cline. Pet. 71–103. Petitioner identifies disclosure in both Honermann and Cline for limitations 1[pre] – 1[o], and provides color-coded annotated figures from these

references identifying structures it contends correspond to certain claim elements. *Id.* at 78–103. For example, Petitioner identifies, *inter alia*, Honermann’s filter bowl 36 as the claimed “filter housing,” filter cartridge 38 as the claimed “ring filter insert,” and Honermann’s basket 304 containing inclined plane 314, and Honermann’s protrusion arrangement 118 containing protrusions 121, 122 as the claimed first and second “positioning means,” respectively. *Id.* at 79–95. Petitioner also identifies where Cline discloses “eccentric blocking element” 66 for “eccentric opening” 36 arranged on the bottom front panel of its ring filter insert, and provides reasons why it would have been obvious to a person of ordinary skill in the art to replace Honermann’s blocking element and outlet with that disclosed in Cline. *Id.* at 71–78, 87–88, 91–93. Petitioner further explains—and provides additional annotated Figures to show—how Honermann’s inclined plane and nose are arranged to be moved in relation to each other in such a way that they slide along each other, and how this interaction would bring the blocking element of the Honermann-Cline combination into engagement with the eccentric opening by rotating the ring filter insert relative to the filter housing. *Id.* at 97–99.

Patent Owner does not address the merits of Petitioner’s challenge of claim 1 or the proffered evidence and instead focuses on discretionary denial and asserts in that context that the primary references have “several key deficiencies that the Petitioner[] did not address.” Prelim. Resp. 20–21. Even though Patent Owner’s assertions are made in the context of § 325(d), in the interest of fairness to Patent Owner, we address those assertions here as we assess whether the Petition satisfies the reasonable likelihood standard. *Id.* at 21–23.

First, Patent Owner asserts that the prior art does not have a “structure capable of bringing an eccentric blocking element into a single rotational position such that the eccentric blocking element could align with a single eccentric opening as claimed.”⁹ Prelim. Resp. 21–22. This argument lacks persuasive merit at this stage of the proceeding. Here, we observe that claim 1 does not recite a “single rotational position” as suggested by Patent Owner’s argument. Thus, it is unclear whether such a single rotational position is required by claim 1. If Patent Owner believes it is, the parties are encouraged to address this issue more fully during trial.

Next, Patent Owner argues that the challenged “[p]atent emphasizes that the eccentric blocking element is ‘brought into its engagement-compatible rotational position for the blocking element relative to the outlet virtually solely by means of the force of gravity.’” Prelim. Resp. 22 (citing Ex. 1001, 3:31–35). Patent Owner contends that “[t]he Petition is unclear as to how, for filter elements such as those disclosed in . . . Honermann which [is] installed and screwed upwards into a filter housing, the first and second positioning means could be used to align an eccentric blocking element by the force of gravity.” Prelim. Resp. 22.

This argument is also unpersuasive at this stage of the proceeding. Even if Patent Owner is correct that the first and second positioning means of claim 1 must use gravity to align the eccentric blocking element (*see* Prelim. Resp. 22), Honermann’s filter cartridge 38 (the “ring filter insert”) appears to be positioned into filter bowl 36 (the “filter housing”) from the top, i.e., is gravity-fed, to create filter assembly 34 prior to filter assembly 34

⁹ Although the quoted sentence refers to Yokoyama and Cline, the remainder of Patent Owner’s argument addresses Honermann. Prelim. Resp. 21.

being screwed upwards into removable cover 32. *See* Ex. 1006, Figs. 1, 2; ¶ 113 (“The bowl 36 has, at one end, an open mouth 154 for allowing the filter cartridge 38 to be selectively inserted”), ¶ 78 (disclosing that, in Figure 1, “one of the filter assemblies 34 is shown in an exploded perspective view as including filter bowl 36 and a removable and replaceable filter cartridge 38.”). The parties are invited to address this issue, including the proper construction of the first and second positioning means, at trial.

Lastly, Patent Owner asserts that Petitioner did not provide adequate reasoning regarding its proposed combination with Cline. Prelim. Resp. 22–23. That argument lacks merit at this stage of the proceeding. For purposes of institution, Petitioner provided sufficient reasons to combine Honermann with Cline. Pet. 71–78.

We have reviewed the Petition and the cited evidence and we determine that the information set forth in the Petition and the Preliminary Response shows a reasonable likelihood that Petitioner would prevail on its challenge of claim 1 based on Honermann and Cline.

F. Notices

The Board shall deem waived any issue not raised by Patent Owner in a timely response to the Petition or as permitted in another manner during trial, even if the issue was raised in the Preliminary Response or discussed in this Decision. Moreover, nothing in this Decision authorizes Petitioner, in a manner not otherwise permitted by the Board’s rules, to supplement the information supporting any ground advanced in the Petition.

IV. CONCLUSION

We institute an *inter partes* review of all challenged claims based on all grounds asserted in the Petition pursuant to 35 U.S.C. § 314(a). *See PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1359–60 (Fed. Cir. 2018) (interpreting relevant statutory provisions and caselaw to require “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition.”).

V. ORDER

It is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of all challenged claims of the '203 patent is instituted on all grounds of unpatentability set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, notice is given of institution of trial commencing on the entry date of this Decision.

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