

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOWARD INDUSTRIES, INC.,
Petitioner,

v.

CAPSA SOLUTIONS LLC,
Patent Owner.

IPR2023-01274
Patent 7,594,668 B2

Before BART A. GERSTENBLITH, MATTHEW S. MEYERS, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

Howard Industries, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 3 and 4 (“the challenged claims”) of U.S. Patent No. 7,594,668 B2 (“the ’668 patent,” Ex. 1001). Paper 1. Petitioner supports the Petition with a Declaration of Mr. Ronald B. Kemnitzer. Ex. 1004. Capsa Solutions LLC (“Patent Owner”) filed a Preliminary Response (Paper 6 (“Prelim. Resp.”)) supported by a Declaration of Pinhas Ben-Tzvi (Ex. 2001). On February 26, 2024, we instituted this *inter partes* review as to all challenged claims and all grounds presented in the Petition. Paper 9 (“Dec.”).

After institution, Patent Owner filed a Response to the Petition (Paper 14, “PO Resp.”) supported by a second Declaration of Pinhas Ben-Tzvi (Ex. 2012) and a Declaration of Craig Rydingsward (Ex. 2018). Petitioner filed a Reply (“Pet. Reply”). Paper 18. Patent Owner filed a Sur-reply (“Sur-reply”). Paper 19. An oral hearing was held on December 6, 2024, and the transcript is entered into the record. Paper 26 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims of the ’668 patent. For the reasons discussed below, we determine Petitioner establishes by a preponderance of the evidence that the challenged claims are unpatentable.

A. Related Matters

The parties identify the '668 patent as a subject of:

- 1) *Capsa Solutions LLC v. Howard Industries, Inc.*, 2:22-cv-00065 (S.D. Miss.);
- 2) *Capsa Solutions LLC v. Simplifi Medical, LLC*, 1:22-cv-05527 (N.D. Ill.);
- 3) *Rubbermaid, Inc. v. Capsa Solutions LLC*, 3:12-cv-00611 (W.D.N.C.); and
- 4) *Rubbermaid Inc. v. EnovateIT, LLC*, 3:11-cv-00209 (W.D.N.C.).

Pet. 87; Paper 3 (Patent Owner's Mandatory Notices), 1.

Although not identified by the parties as a related matter, Petitioner challenges claims of U.S. Patent No. 8,215,650 B2 ("the '650 patent") in co-pending IPR2023-01275. The '650 patent claims priority to the '668 patent. IPR2023-01275, Ex. 1001, code (60).

B. Real Parties-in-Interest

Petitioner identifies Howard Industries, Inc. as the sole real party-in-interest. Pet. 87. Patent Owner identifies Capsa Solutions LLC as the sole real party-in-interest. Paper 3, 1.

C. The '668 Patent

The '668 patent is titled "Medical Cart, Medication Module, Height Adjustment Mechanism, and Method of Medication Transport." Ex. 1001, code (54). The '668 patent issued on September 29, 2009, from application no. 12/193,346, which was filed on August 18, 2008, and claims priority through a series of applications to provisional application no. 60/448,920 filed February 24, 2003. *Id.* at codes (45), (21), (22), (63), (60).

The '668 patent discloses that “[s]ome hospitals provide nurses with medical carts on which a networked laptop computer facilitates the use of Electronic Medical Administration Records (‘EMAR’).” Ex. 1001, 1:25–28. However, these medical carts are unsatisfactory in that they are not ergonomically designed, lack a work surface, have bad placement of medication drawers or lack storage space, and cannot be raised or lowered. *Id.* at 1:41–49.

Figure 1 of the '668 patent is reproduced below:

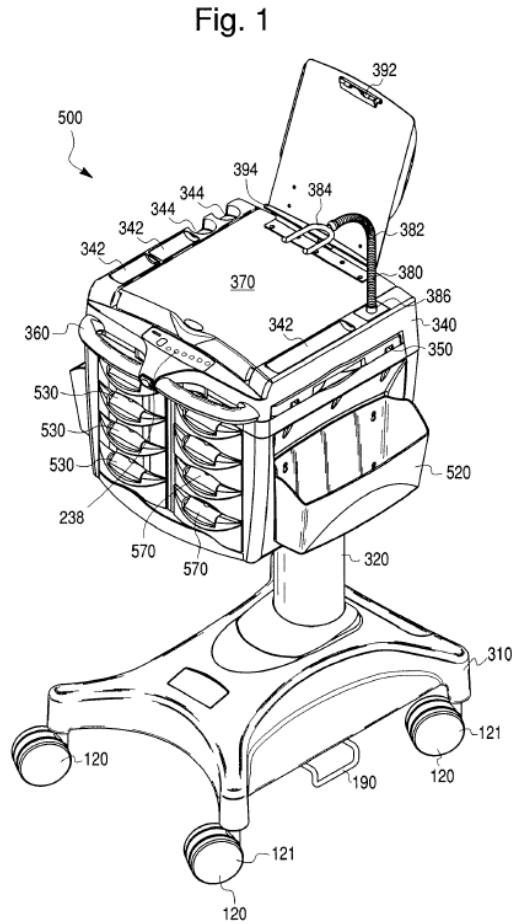


Figure 1 is a perspective view of a medical cart of the '668 patent. Ex. 1001, 3:13–14. Medical cart 500 includes laptop platform 370, work platform 340, work surface 350, compartments 530, and support mechanism 320 that supports and adjusts the height of work platform 340 on base 310. *Id.* at

4:23–31. Base 310 includes rolling members 120 such as casters for movability. *Id.* at 9:64–65.

Figure 9A of the '668 patent is reproduced below:

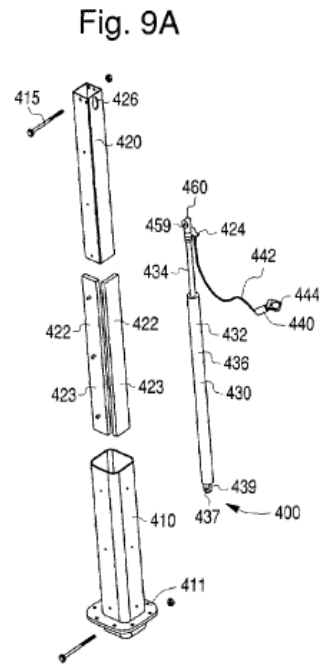


Figure 9A is an exploded view of a height adjustment mechanism of the medical cart. Ex. 1001, 3:37–38. The height adjustment mechanism includes driver 430 having gas driven piston 432 with body portion 436, and telescoping strut 434. *Id.* at 8:52–53. The height adjustment mechanism also includes outer casing 410, telescoping inner casing 420, drawer slides 422, and ball bearings which function as “conventional drawer rails.” *Id.* at 8:29–51. Driver 430 is controlled by actuator 440 and is connected to actuator 440 by connector 442. *Id.* at 8:54–55. Actuator 440 is “provided in a front portion” of medical cart 500. *Id.* at 9:1–2. Actuator 440 includes button 444 allowing work platform 340 to be releasably locked at a plurality of height positions. *Id.* at 9:2–21. A user “can ergonomically access” items as work platform 340 is raised or lowered. *Id.* at 4:34–35.

D. Illustrative Claim

Claims 3 and 4 are independent. Claim 3 is reproduced with Petitioner's annotations below:

[3pre] A cart comprising:

[3a] a work platform including a work surface and compartments for containing items;

[3b] a base configured to be movable in at least a rearward direction; and

[3c] a height adjustment mechanism for adjusting the height of the work platform relative to the base,

[3d] wherein the base includes a portion that projects from the height adjustment mechanism in a forward direction that is substantially opposite to the rearward direction,

[3e] wherein the work platform includes a portion that projects from the height adjustment mechanism in the forward direction, the compartments are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction, and the compartments are configured to permit a user facing in the rearward direction to access an item within the compartments,

[3f] wherein the height adjustment mechanism is configured to releasably lock the work platform at a plurality of heights,

[3g] wherein the height adjustment mechanism comprises:

a stationary casing connected to the base;

a telescoping casing connected to the work platform and configured to move relative to the stationary casing;

[3h] at least two drawer slides disposed between the stationary casing and the telescoping casing;

[3i] a driver configured to releasably lock the telescoping casing relative to the stationary casing; and

[3j] an actuator for controlling the driver, and

[3k] wherein the actuator is disposed above the compartments and on the portion of the work platform that projects in the forward direction.

Ex. 1001, 14:61–15:27; *see* Pet. 22–38 (Petitioner's annotations).

E. Prior Art and Asserted Grounds

Petitioner asserts that claims 3 and 4 are unpatentable on the following grounds (Pet. 3)¹:

Ground No.	Claim(s) Challenged	35 U.S.C. §²	References/Basis
1	3	103(a)	Clark, ³ Manner, ⁴ Santoro ⁵
2	3	103(a)	Clark, Manner, Santoro, Gillis ⁶
3	4	103(a)	Clark, Manner
4	4	103(a)	Clark, Manner, Gillis
5	3	103(a)	Reeder, ⁷ Manner, Santoro
6	3	103(a)	Reeder, Manner, Santoro, Gillis
7	4	103(a)	Reeder, Manner
8	4	103(a)	Reeder, Manner, Gillis

II. ANALYSIS

A. Overview

Petitioner bears the burden of establishing the unpatentability of the challenged claims by a preponderance of the evidence. 35 U.S.C. § 316(e);

¹ In the chart above, we have broken out the eight grounds asserted by Petitioner to identify each. Petitioner describes these eight grounds as “1A/B,” “2A/B,” “3A/B,” and “4A/B.” Pet. 3.

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included revisions to 35 U.S.C. § 103 that became effective after the effective filing date of the Challenged Claims. Therefore, we apply the pre-AIA version of 35 U.S.C. § 103.

³ U.S. Patent No. 6,493,220 B1 (Dec. 10, 2002). Ex. 1010 (“Clark”).

⁴ U.S. Patent No. 5,682,825 (Nov. 4, 1997). Ex. 1007 (“Manner”).

⁵ U.S. Patent Publication No. 2002/0145088 A1 (Oct. 10, 2002). Ex. 1008 (“Santoro”).

⁶ U.S. Patent Publication No. 2003/0084828 A1 (May 8, 2003). Ex. 1019 (“Gillis”).

⁷ U.S. Patent Publication No. 2002/0044059 A1 (Apr. 18, 2002). Ex. 1006 (“Reeder”).

37 C.F.R. § 42.1(d). This burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

A claim is unpatentable under § 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) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations). *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

The Supreme Court explained in *KSR International Co. v. Teleflex Inc.* that

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (alteration in original))).

“Whether an ordinarily skilled artisan would have been motivated to modify the teachings of a reference is a question of fact.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1327 (Fed. Cir. 2016). “[W]here a party argues a skilled artisan would have been motivated to combine references, it must show the artisan ‘would have had a reasonable expectation of success from doing so.’” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360–61 (Fed. Cir. 2017) (quoting *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1068–69 (Fed. Cir. 2012)).

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art “would have at least a four-year college degree in mechanical engineering, biomedical engineering, industrial design, or a closely related field and at least one year of experience in product development and design for commercial workstations and work platforms.” Pet. 7 (citing Ex. 1004 ¶¶ 17–18). Petitioner further contends that “[a]dditional education could substitute for professional experience, and significant work experience could substitute for formal education.” *Id.*

Patent Owner contends that a person of ordinary skill in the art “would have had a bachelor’s degree in a pertinent discipline involving mechanical product design, such as mechanical engineering, with 2-3 years experience in in [sic] the design, manufacture, or analysis of mechanical devices.” PO Resp. 18. Patent Owner alternatively argues that a person of ordinary skill in the art “with a 2-year mechanical engineering diploma and . . . 4-6 years of experience in in [sic] the design, manufacture, or analysis of mechanical components and devices.” *Id.* Patent Owner contends that

“Petitioner submits a somewhat different, and broader, definition” of a person of ordinary skill in the art than Patent Owner’s definition because Petitioner’s definition includes industrial design which is a field that does not require the same level of hard sciences as Patent Owner’s definition. *Id.* Patent Owner further contends that “the Petition should be denied under either party’s definition of a [person of ordinary skill in the art] as Petitioner has failed to meet its burden of establishing a *prima facie* case of obviousness.” *Id.* at 18–19 (citing Ex. 2012 ¶¶ 45–47).

We apply Petitioner’s level of ordinary skill in the art because it appears consistent with the problems addressed in the ’668 patent and the prior art. Our Decision would not be affected if we were to apply Patent Owner’s definition.

C. Claim Construction

We apply the same claim construction standard used by Article III federal courts and the International Trade Commission, both of which follow *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b) (2019). The claim construction standard includes construing claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art at the time of the invention. *See Phillips*, 415 F.3d at 1312–14. In construing claims in accordance with their ordinary and customary meaning, we take into account the specification and prosecution history. *Id.* at 1315–17.

If the specification “reveal[s] a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess[,] . . . the inventor’s lexicography governs.” *Phillips*, 415 F.3d at 1316 (citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366

(Fed. Cir. 2002)). Another exception to the general rule that claims are given their ordinary and customary meaning is “when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Uship Intellectual Props., LLC v. United States*, 714 F.3d 1311, 1313 (Fed. Cir. 2013) (quoting *Thorner v. Sony Comput. Entm’t. Am., LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)).

i. “actuator”

Petitioner contends in district court that the term “an actuator for controlling the driver” is indefinite for invoking means-plus-function claim language without providing corresponding structure. *Id.* at 8–9 (citing Ex. 1029, 36–40; Ex. 1030, 28–32; Ex. 1012, 3–4). For the purposes of this proceeding, Petitioner adopts the construction Patent Owner presented in the district court, i.e., “a mechanism to activate or control equipment, e.g., by use of pneumatic, hydraulic, or electronic signals.” *Id.* at 9 (quoting Ex. 1012, 3–4). Patent Owner does not address this term. *See generally* PO Resp.; Sur-reply. Because it is uncontested in this proceeding, we apply Patent Owner’s construction from the district court proceeding as presented here by Petitioner.

ii. “work surface”

Petitioner contends that, in the district court, the parties’ proposed competing constructions of “work surface” also differ. Pet. 9. Specifically, Petitioner advocates that the term should be construed as “a curved surface at the top of a cart large enough to dispense medication or hold work papers,” while Petitioner characterizes Patent Owner as arguing “for a broader ‘plain and ordinary meaning’ construction.” *Id.* (citing Ex. 1012, 8–9). Petitioner, however, states that it “includes alternate grounds using

Gillis to demonstrate how the claims are invalid under either Petitioner or Patent Owner’s construction.” *Id.* Patent Owner argues that “the definition of ‘work surface’ . . . is not dispositive.” PO. Resp. 31.

Although not dispositive to our Decision, we apply the plain and ordinary meaning of this term, which does not require the work surface to be curved.

iii. “compartment”

Patent Owner contends that the term “compartment” should be construed as “an enclosed space for containing an item.” PO Resp. 23 (citing Ex. 2012 ¶¶ 50–54). According to Patent Owner, “Petitioner agreed to adopt the . . . definition for this term in the on-going parallel litigation” after the Petition was filed. *Id.* at 20 (citing Ex. 2006; Ex. 2008, 15).

Patent Owner next contends that “dictionary definitions . . . confirm the plain and ordinary meaning as proposed by [Patent Owner] as an enclosed space.” PO Resp. 21.

Patent Owner next contends that its “definition should be adopted because the term has been redefined by the ’668 Patent by implication and consistent usage throughout the ’668 Patent.” PO Resp. 21–22 (citing *SkinMedica, Inc. v. Histogen Inc.*, 727 F.3d 1187, 1203–04 (Fed. Cir. 2013)). Patent Owner argues the ’668 patent “teaches that the ‘. . . compartments 530 enable a user (e.g., a nurse) to separately maintain medication for particular patients or for a particular room’” and “the compartments may be lockable . . . may be labeled drawers.” *Id.* at 22 (first omission in original) (citing Ex. 1001, 2:15, 7:30–35, 7:45–67, 8:1–5).

Patent Owner next argues that “[t]he ’668 Patent goes on to explain. . . that the work platform ‘houses the at least one compartment.’” PO Resp. 22

(citing Ex. 1001, 2:15, 2:38–39, 7:33–35, 8:1–5). Patent Owner further argues that the '668 patent “repeatedly distinguishes the claimed ‘compartment’ from unenclosed storage spaces.” *Id.* (citing Ex. 1001, 3:14–15, 3:37, 4:30–34, Fig. 1). Patent Owner also argues that Figure 7 is described “as a medical cart ‘*without* compartments’ yet the enclosed side bin 520 storage unit and unenclosed cavities are shown as part of the medical cart in Figure 7.” *Id.* at 123 (citing Ex. 1001, 3:31–34, Fig. 7). According to Patent Owner, this “confirms that unenclosed items like side bins and open cavities are distinguishable and implicitly disclaimed from ‘compartments.’” *Id.*

Petitioner, in turn, contends that we can “resolve this proceeding without construing ‘compartment(s)’” because “both parties agree that the '668 patent expressly recognizes drawers as compartments.” Pet. Reply 3 (citing Ex. 1001, 2:15).

Petitioner next contends that “[t]he '668 patent claims, specification, and prosecution history confirm the plain and ordinary meaning of ‘compartments’ applies.” Pet. Reply 3. Petitioner argues that “[c]laim 3 explains that the ‘compartments’ are ‘for containing items.’” *Id.* (citing Ex. 1001, 14:62–63). Petitioner further argues that the Specification “explains that ‘[t]he compartment *can be* a drawer” and “places no restrictions on ‘compartment’ requiring departure from the plain meaning.” *Id.* (emphasis by Petitioner) (citing Ex. 1001, 2:15, 3:29–30). Replying to Patent Owner’s argument that “the Applicant redefined ‘compartments’ by implication and consistent usage,” Petitioner contends that “[i]t is not enough for a patentee to simply disclose a single embodiment or use a word in the same manner in all embodiments’ for lexicography to apply.” *Id.*

(quoting *Thorner v. Sony Computer Ent. Am. LLC*, 669 F. 3d 1362, 1365 (Fed. Cir. 2012)).

Petitioner next contends that “‘compartment’ is a commonly understood word with a readily apparent, ordinary meaning.” Pet. Reply 3 (citing Dec. 22; Ex. 1001, 2:15; Ex. 2010, 124:21–125:13). In support of this contention, Petitioner points to the dictionary cited by Patent Owner which includes a definition of “compartment” as “a separate division or section.” *Id.* at 4 (citing Ex. 2014). Petitioner cites to additional dictionary definitions of “compartment” as “[o]ne of the parts or spaces into which an area is subdivided” and “[a] subdivision of three dimensional space.” *Id.* (citing Ex. 1046; Ex. 1047).

We have considered the parties’ respective arguments concerning the construction of this claim term and, for the following reasons, we adopt Patent Owner’s construction of “compartment” as “an enclosed space for containing an item.” First, Petitioner does not dispute that it agreed to adopt Patent Owner’s construction in the district court proceeding between the parties. Pet. Reply 5; Tr. 8:14–21. Second, Petitioner cites to several Board Decisions in which the panels construed claim terms even though the parties agreed to constructions in parallel litigation and argues that the agreement between Petitioner and Patent Owner in the parallel district court proceeding has no bearing on this proceeding. *Id.* (citing *Cook Grp. Inc. v. Cook Med. LLC*, IPR2017-00135, Paper 7 at 7–8 (PTAB May 16, 2017); *Arris Int’l PLC v. Sony Corp.*, IPR2016-00834, Paper 54 at 26–29 (PTAB Sept. 28, 2017); *Apple Inc. v. VirnetX Inc.*, IPR2015-00810, Paper 44 at 18–19 (PTAB Aug. 30, 2016)). But, those cited decisions are not precedential and two of them were decided under the “broadest reasonable interpretation standard,”

not the *Phillips* standard, thereby rendering a stipulation between the parties in district court less informative to the panels' determinations. *See Apple*, IPR2015-00810, Paper 44 at 18; *Cook Grp.*, IPR2017-00135, Paper 7 at 7. More importantly, given Petitioner's agreement with Patent Owner's construction in the district court, we see no reason to apply a different construction here simply because Petitioner proposed that construction prior to agreeing to the construction with Patent Owner in district court.

Tr. 11:21–25.⁸

- iv. “compartment disposed in the portion of work platform that projects from the height adjustment mechanism in the forward direction”

Patent Owner contends that, “in the context of the rest of the claim terms,” the Applicant “redefined the term ‘disposed in’ to mean entirely in or ‘contained in’ by clear, implicit redefinition disclaimer and the term ‘forward’ means ‘in front.’” PO Resp. 24 (citing Ex. 2012 ¶¶ 55–56). Underlying these arguments is the unstated premise that a person of ordinary skill in the art would understand the ordinary and customary meaning of “disposed in” does not require that the compartments are entirely “disposed in” or “contained in” the recited portion of the work platform.

We first address Patent Owner's proposed construction of “disposed in” and then address its proposed construction of “forward.”

⁸ The construction agreed upon by the parties and that we apply herein is different than the preliminary construction we adopted in our Decision on Institution. Dec. 21–22. Petitioner and Patent Owner each represented during the oral hearing that it had a sufficient opportunity to address the construction of “compartment” and raise arguments based on any competing claim construction positions during trial. Tr. 12:1–17, 27:19–21.

Patent Owner argues that “all embodiments described in the . . . ’668 Patent[] show that the compartments are disposed entirely in the portion of the work platform projecting from the height adjustment mechanism in the forward direction.” PO Resp. 25 (reproducing Ex. 1001, Fig. 12 with annotations); Sur-reply 4–5 (“The only relevant embodiment described in the ’650 Patent has a drawer disposed entirely in front of the height adjustment mechanism.”). Patent Owner next argues that “[t]here are no embodiments of the invention described in the ’668 Patent where the compartments are disposed outside the portion of the work platform that projects from the height adjustment mechanism in the forward direction.” PO Resp. 25–26.

Patent Owner further argues that:

it is impossible for the compartments in the cart of . . . the ’668 Patent[] to extend outside the forward (front) projecting portion of the work platform . . . because the height adjustment mechanism would be in the way thus preventing a user from accessing items stored in the compartment as required by the claims at issue.

PO Resp. 26. In support of this argument, Patent Owner submits an “annotated/hypothetical” version of Figure 12 of the ’668 patent and argues that “the compartments/drawers . . . would not be functional as they could not be pulled open in such a configuration as the height adjustment mechanism goes through the middle of the drawers preventing them from being pulled out by the user.” *Id.* at 26–27. Based on this, Patent Owner argues that the “[a]pplicant clearly disclaimed compartments that have portions that extend outside the portion of the work platform that projects from the height adjustment mechanism in the forward direction” because the claims “require a user to be able to access stored items from the front of the

cart.” *Id.* at 27. According to Patent Owner, “it is clear from the intrinsic evidence that ‘disposed in’ in the context of claim 1 means entirely in or ‘contained in.’” *Id.* at 28 (citing Ex. 2012 ¶ 57).

Petitioner, in turn, contends that Patent Owner fails to meet “the exacting standards necessary to invoke lexicography and disavowal.” Pet. Reply 5 (citing *Thorner v. Sony Computer Ent. Am. LLC*, 669 F. 3d 1362, 1365–66 (Fed. Cir. 2012)). According to Petitioner, the Specification does not limit the claim scope “to require compartments contained ‘entirely within’ one portion of the work platform.” *Id.*

For the following reasons, we do not adopt Patent Owner’s proposed construction of “disposed in.”

There are two exceptions to the general rule that claims “are generally given their ordinary and customary meaning as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history.” *Thorner*, 669 F.3d at 1365. First, “when a patentee sets out a definition and acts as his own lexicographer” or second, “when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Id.* (citing *Vitronics Corp.*, 90 F.3d at 1580). In order for the patentee to act as his or her own lexicographer, the patentee

must ‘clearly set forth a definition of the disputed claim term’ other than its plain and ordinary meaning . . . [i]t is not enough for a patentee to simply disclose a single embodiment or use a word in the same manner in all embodiments, the patentee must ‘clearly express an intent’ to define the term.

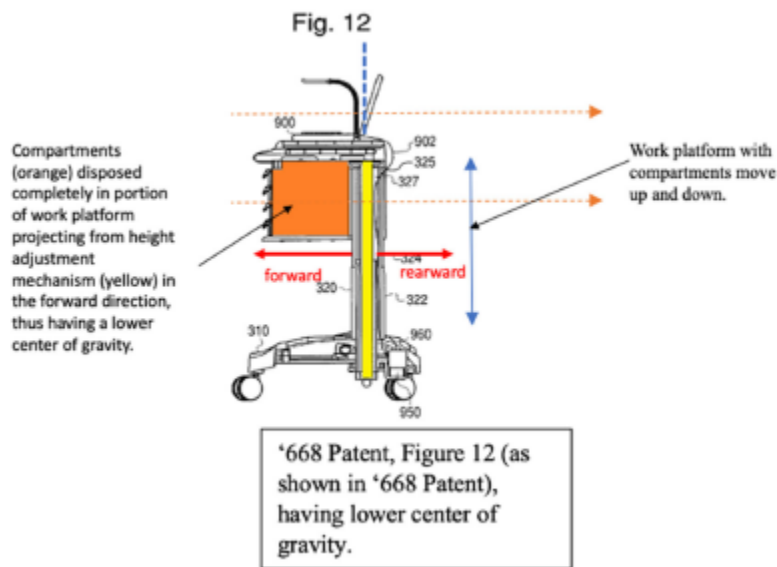
Id. Further, in order to establish disavowal of claim scope, the specification must “make[] clear that the invention does not include a particular feature . . . even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in

question.” *Id.* As noted above, the underlying premise of Patent Owner’s proposed construction is that the language “disposed in” is broad enough to encompass compartments not “entirely in” or “contained in” the recited portion of the work platform.

We start our analysis with the claim language. Claims 3 and 4 both recite “wherein the work platform includes a portion that projects from the height adjustment mechanism in the forward direction, the compartments are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction.” Ex. 1001, 15:4–8, 15:48–52. By reciting “a *portion* projects from the height adjustment mechanism,” the claim language implies that the entire work platform is not required to project in the forward direction. Further, the only restriction on the structure of the height adjustment mechanism or its placement relative to the work platform in each of the claims is that the height adjustment mechanism comprises “a telescoping casing connected to the work platform.” *Id.* at 15:17, 15:40. We also note that nothing in claim 3 or claim 4 requires any particular size of the compartments. The only recitation in the claims regarding the location of the compartments is that they “are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction,” but that language on its face does not require or suggest that the compartments are “entirely in” or only “contained in” the recited portion of the work platform. In other words, nothing in the claims expressly restricts the compartments from being disposed in the “portion” recited as well as another portion of the work platform that does not project from the height adjustment mechanism in the forward direction.

Turning to the Specification, Patent Owner does not direct us to any text in the Specification where the term “disposed in” is clearly defined as “disposed entirely in” or “contained in.” PO Resp. 23–28. Our review of the Specification does not reveal a lexicographic definition of “disposed in.”

In support of its construction, Patent Owner provides the following annotated version of Figure 12 of the '668 patent:



PO Resp. 25. Figure 12 is a “cross-sectional view of the medical cart of FIG. 1.” Ex. 1001, 3:48–49. In the annotated version of Figure 12, Patent Owner adds, *inter alia*, a red horizontal arrow from the height adjustment mechanism pointing to the left with red text “forward,” a red horizontal arrow from the height adjustment mechanism pointing to the right with red text “rearward,” orange shading in the area containing compartments, yellow shading of the height adjustment mechanism, and black text reading “Compartments (orange) disposed completely in portion of work platform projecting from height adjustment mechanism (yellow) in the forward direction, thus having a lower center of gravity.” PO Resp. 25.

Assuming, *arguendo*, that Patent Owner’s argument that Figure 12 illustrates compartments that are disposed entirely in or contained in the portion of the work platform projecting from the height adjustment mechanism in the forward direction is correct, Figure 12 is a representation of an embodiment disclosed in the ’668 patent which, without more, is not sufficient to establish a clearly expressed intent to define “disposed in” as “entirely in” or “contained in.” *See Thorner*, 669 F.3d at 1365 (“not enough for a patentee to simply disclose a single embodiment or use a word in the same manner in all embodiments, the patentee must ‘clearly express an intent’ to define the term”). We, thus, determine that the ’668 patent does not “clearly express an intent” to define the term “disposed in” as “disposed entirely in” or “contained in.” Likewise, for the same reasons, the ’668 patent does not clearly disavow the scope of “disposed in” and limit the term to “disposed entirely in” or “contained in.”⁹

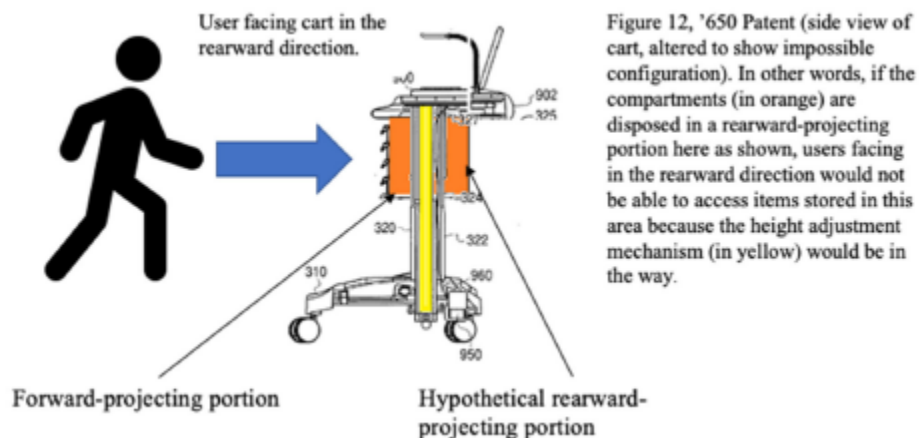
Apart from its lexicography and claim scope disavowal arguments, Patent Owner contends that “it is impossible^[10] for the compartments in the cart of the ’650 [patent] to extend outside the forward (front) projecting portion of the work platform . . . because the height adjustment mechanism would be in the way thus preventing a user from accessing items stored in

⁹ Patent Owner cites to *Cao Lighting, Inc. v. GE*, 2002 U.S. Dist. Lexis 84058 (D. Del. May 10, 2022), where the court construed the term “within” in an unrelated patent. PO Resp. 28. Patent Owner does not explain the relevance of claim construction from a different patent to the claim construction analysis here. *See id.* Further, even if the determination in *Cao* had some import, the word “within” is not recited in the portion of claims 3 and 4 of the ’668 patent at issue.

¹⁰ Patent Owner conceded during oral argument that it would not be “impossible.” Tr. 43:21–44:18.

the compartment as required by the claims.” PO Resp. 26 (footnote added). The testimony of Patent Owner’s declarant, Dr. Ben-Tzvi, is essentially the same as the argument in Patent Owner’s Response on this point. Ex. 2012 ¶ 57b.

The basis for Patent Owner’s argument is a hypothetical modification of Figure 12 of ’668 patent, which is reproduced below:



PO Resp. 27. Figure 12 is a “cross-sectional side view of the medical cart” disclosed in the ’668 patent. Ex. 1001, 3:48–49. Patent Owner’s proposed hypothetical assumes that if an ordinarily skilled artisan moved the height adjustment mechanism toward the front of the work station as shown in modified Figure 12, the compartments must remain the same shape, width, and length in the horizontal direction as in unmodified Figure 12. Neither Patent Owner nor Dr. Ben-Tzvi cite to any requirement of claim 3 or claim 4 or other intrinsic evidence to support this assumption. PO Resp. 26–27; Ex. 2012 ¶ 57b.

Claims 3 and 4 recite the “compartments are for containing items,” “are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction,” and “are configured

to permit a user facing in the rearward direction to access an item within the compartments.”

Patent Owner questioned Mr. Kemnitzer during his deposition about Patent Owner’s proposed hypothetical modification to Figure 12. The following colloquy occurred:

Q: In your opinion, would it be possible for those drawers to be extended rearward of the support member?

...

THE WITNESS: Well, that’s a hypothetical. But I think, is it possible? It may be possible to have the drawers shaped in a way that they surround that column, which reduces the size of them somewhat. It is also possible to, as in Figure 7 and 7/8, it shows the compartments split down the middle so they only are half as wide as the unit. And they could also be configured to go around the column.

Ex. 2010, 102:13–103:1.¹¹ In other words, Mr. Kemnitzer testified that it was possible for the drawers to extend rearward of the support member. *Id.*

Petitioner also directs us to the testimony of Patent Owner’s Vice-President, Mr. Rydingsward, who confirmed that Patent Owner’s currently marketed cart comprises forward-facing drawers “configured to extend around the sides of a height adjustment mechanism.” Pet. Reply 6–7 (citing Ex. 1043, 17; Ex. 1045, 39:16–22, 42:2–43:7).

For the following reasons, we are not persuaded that moving the height adjustment mechanism forward as shown in modified Figure 12 renders “it . . . impossible for the compartments in the cart of the ’650 . . . Patent[] to extend outside the forward (front) projecting portion of the work platform . . . because the height adjustment mechanism would be in the way

¹¹ Petitioner cites to this testimony by Mr. Kemnitzer in the Petitioner Reply. Pet. Reply 7.

thus preventing a user from accessing items stored in the compartment as required by the claims.” PO Resp. 26.

We initially observe that neither Patent Owner’s hypothetical nor its modified Figure 12 constitute intrinsic evidence. Neither claim 3 nor claim 4 require that the recited compartments be of any specific length or width. Based on Mr. Kemnitzer’s testimony (Ex. 2010, 102:13–103:1), which we credit as supported at least by Figure 7 of the ’668 patent, we find that if a person of ordinary skill in the art were to modify the shape of the drawers to surround the height adjustment mechanism or narrowed the compartment width, as suggested by Figure 7 of the ’668 patent so that the compartments would not be blocked by the height adjustment mechanism, a user’s access to items in the drawers would not be impeded even if a portion of the compartments was not in the forward projecting portion of the work platform.

Patent Owner does not offer any argument or evidence that it would have been beyond the level of skill of a person of ordinary skill in the art to adjust the size of the compartments if the height adjustment mechanism were moved forward as shown in Patent Owner’s modified Figure 12. PO Resp. 26. Dr. Ben-Tsvi’s testimony is entitled to little, if any, weight because his testimony mirrors Patent Owner’s argument verbatim without providing sufficient support for his opinion. Ex. 2012 ¶ 57b.

Although Mr. Rydingsward’s testimony about Patent Owner’s carts does not relate to a prior art cart, it illustrates a possible solution to the problem posed by Patent Owner’s hypothetical.¹² Patent Owner does not

¹² Our determination would be unaffected if Mr. Rydingsward’s testimony and Exhibit 1043 were not part of the record in this case.

argue that the arrangement shown in Exhibit 1043 would have been beyond the skill level of a mechanical engineer with two years of work experience in February 2003 but dismisses the testimony of Mr. Rydingsward and Exhibit 1043 as “extrinsic evidence.” Sur-reply 5 n.2. We find this argument unavailing because, as discussed above, Patent Owner’s hypothetical modification of Figure 12 is itself extrinsic evidence.

For the foregoing reasons, Patent Owner’s hypothetical construct does not alter our determination not to limit “disposed in” to require the compartments to be “contained in” or “entirely disposed in” the recited portion of the work platform.

v. “forward”

Patent Owner first argues that “the plain and ordinary meaning of ‘forward’ as . . . ‘in front’ applies.” PO Resp. 29. Patent Owner alternatively argues that “if ‘in front’ is not considered the plain and ordinary meaning of ‘forward’, the Applicant clearly redefined the term as such by disclaiming work stations that are mounted on top of or over the height adjustment mechanism.” *Id.*

In support of its’ alternative argument, Patent Owner reiterates its argument discussed above, which we determine to be unavailing, i.e., that “all embodiments disclosed in the ’650 dispose the compartments in the portion of the work platform in front of the height adjustment mechanism.” PO Resp. 29.

Patent Owner additionally argues that, during prosecution, the Applicant “consistently asserted a key aspect of the invention is a lower [center of gravity].” PO Resp. 29. According to Patent Owner, the Applicant overcame Clark “because it is ‘top-heavy’ (i.e., the workstation of

Clark, with keyboard tray, is mounted entirely on top of the height adjustment mechanism) resulting in a higher [center of gravity] without adequate stability to support additional components without it being more easily knocked over.” *Id.* at 30. According to Patent Owner, “the file history arguments in overcoming Clark demonstrate that the ’668 Patent Applicant explicitly disclaimed carts having workstations mounted entirely to the top of the height adjustment mechanism.” *Id.*

Petitioner, in turn, replies that Patent Owner “parses the word ‘forward’ in isolation to support its unduly narrowing construction” and the “claim language makes clear ‘forward direction’ describes an orientation that contrasts with ‘a user facing in the rearward direction.’” Pet. Reply 6 (citing Ex. 1001, 7:28–31, claim 3). Petitioner also argues that Patent Owner improperly relies on “statements made by the Applicant during prosecution of the later filed ’650 patent application” which, according to Petitioner, “did not retroactively create prosecution history disclaimer in the already issued ’668 patent.” *Id.* at 7 (citing *Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1333 (Fed. Cir. 1999), opinion amended on reh’g, 204 F.3d 1359 (Fed. Cir. 2000)). Petitioner argues that “the prosecution history of the later filed ’650 patent shows the alleged disavowal arguments were directed to the claimed work surface, not the compartments disposed in the forward projecting portion of the work platform.” *Id.* at 8 (citing Ex. 1033, 132, 133, 135, 137–43¹³). According to Petitioner, “the Applicant argued multiple times during prosecution of the ’650 patent that a [person of ordinary skill in the art] would not combine the prior art references applied in the rejections ‘to arrive at a height-adjustable work

¹³ Exhibit 1033 is the file history of the ’650 patent.

platform *with a moveable work surface* located above a compartment.” *Id.* (citing Ex. 1033, 139–41). Petitioner also points out that “the challenged claims here lack the ’650 patent’s required ‘moveable work surface,’ the subject of those amendments and arguments cited by” Patent Owner. *Id.* at 9 (citing Ex. 1001, cls. 3, 4; Ex. 1033, 132).

Patent Owner responds that “Petitioner did not address all of the statements around Clark from the file history.” Sur-reply 6. Patent Owner argues that “[t]he Applicant also distinguished Clark based on the ‘structural compatibility’ issues with combining the teachings of Clark with the other cited references (resulting in unstable combinations).” *Id.* at 6–7. According to Patent Owner, “[t]he top-heavy workstation of Clark was disclaimed because it would not support the weight of ‘*any other feature*’/component – and not just the work surface as Petitioner alleges.” *Id.* at 7–8.

Patent Owner’s first argument that we should apply the plain meaning of “forward” as “in front” is an attempt to rewrite the limitation “the compartments are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction” to “the compartments are disposed in the portion of the work platform *in front of the height adjustment mechanism.*” PO Resp. 29–30 (“disposing the compartments in the portion of the work platform in front of the height adjustment mechanism”). We look to the claim language in its entirety to evaluate this argument.

Claim 3 recites “a base configured to be movable in at least a rearward direction” and “the base includes a portion that projects from the height adjustment mechanism in a forward direction that is substantially

opposite to the rearward direction.” Ex. 1001, 15:64–65, 16:1–3. This language defines the general forward and rearward orientation of the cart. Additionally, “forward direction,” as recited in the “wherein the base” clause, provides antecedent basis for the succeeding “wherein the work platform” clause, i.e., “a portion [of the work platform] that projects from the height adjustment mechanism in *the forward direction*.” *Id.* at 16:4–6 (emphasis added). Thus, claims 3 and 4 require a portion of the base and a portion of the work platform, not the entirety of the base or the entirety of the work platform, to project from the height adjustment mechanism in the same direction, i.e., the forward direction.

When the clause “the compartments are disposed in” is considered in the context of the entire claim, several issues with Patent Owner’s argument become apparent. First, the location where the compartments are recited as “disposed in” is defined relative to the portion of the work platform projecting from the height adjustment mechanism in the forward direction not the height adjustment mechanism itself as Patent Owner asserts. PO Resp. 23–24 (arguing that one of the questions for construing where the compartments are disposed is “whether the phrase at issue, particularly the term ‘forward’ means in front of the height adjustment mechanism or whether it can include portions that are over or on top of the height adjustment mechanism”). Patent Owner’s argument, if adopted, would fundamentally alter the relationship recited in claims 3 and 4 by requiring that where the compartments are disposed is determined relative to the height adjustment mechanism itself rather than the recited portion of the work platform projecting from the height adjustment mechanism.

We now turn to Patent Owner’s prosecution history disclaimer arguments.

“[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Phillips*, 415 F.3d at 1317. For example, “a patentee may define a claim term . . . in the prosecution history.” *Honeywell Inc. v. Victor Co. of Japan, Ltd.*, 298 F.3d 1317, 1323 (Fed. Cir. 2002). Additionally, “[a] patentee may, through a clear and unmistakable disavowal in the prosecution history, surrender certain claim scope to which he would otherwise have an exclusive right by virtue of the claim language.” *Vita-Mix Corp. v. Basic Holding, Inc.*, 581 F.3d 1317, 1324 (Fed. Cir. 2009). “[D]isclaimer ‘ensures that claims are interpreted by reference to those ‘that have been cancelled or rejected.’” *Festo Corp. v. Shoketsu Kinzoko Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 733 (citing *Schriber–Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220 (1940)). “The party seeking to invoke prosecution history disclaimer bears the burden of proving the existence of a ‘clear and unmistakable’ disclaimer that would have been evident to one skilled in the art.” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1063–64 (Fed. Cir. 2016) (citation omitted).

In this case, Patent Owner bases its prosecution history disclaimer arguments on statements made during the prosecution of the ’650 patent. The ’650 patent is a continuation of the ’668 patent. Ex. 1033, 28. The parties dispute whether or not statements made during the prosecution of the ’650 patent, after the ’668 patent issued, can provide the basis for

prosecution history disclaimer in the '668 patent. Pet. Reply 7–8; Sur-reply 9 n.7.

Patent Owner cites to *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004), in support of its position that we should consider statements made during the prosecution of the '650 patent in this proceeding. Sur-reply 9 n.7. In *Microsoft*, the claim construction issue related to whether various limitations “are restricted to communications over a telephone line or whether they encompass communications over a packet-switched network such as the Internet.” *Id.* at 1346. The Federal Circuit first looked to the common specification of the patents at issue and determined that “the specification shared by all three patents leads to the ‘inescapable conclusion’ that the communications between the local and remote sites of the claimed inventions must occur directly over a telephone line.” *Id.* at 1348. The Federal Circuit then turned to the prosecution history, which it determined “confirms that Multi-Tech viewed its invention as being limited to communications over a telephone line.” *Id.* at 1349. In this context, the Federal Circuit, distinguished its holding in *Georgia-Pacific*, and explained that:

Any statement of the patentee in the prosecution of a related application as to the scope of the invention would be relevant to claim construction, and the relevance of the statement made in this instance is enhanced by the fact that it was made in an official proceeding in which the patentee had every incentive to exercise care in characterizing the scope of its invention. Accordingly, we conclude that Multi-Tech’s statements made during prosecution of the [later filed patent application] with regard to the scope of its inventions as disclosed in the common specification are relevant . . . to the earlier issued . . . patent.

Id. at 1350.

With these principles in mind, we first provide a summary of the pertinent portions of the prosecution history of the '650 patent and then analyze whether the prosecution history supports a disclaimer of claim scope and whether or not any such disclaimer applies to the claims of '668 patent.

The application for the '650 patent, No. 13/187,328, was filed on July 20, 2011, with original claims 1–24. Ex. 1033, 202, 234–38. On January 12, 2012, the Examiner rejected claims 1–24. *Id.* at 153–54. The Examiner rejected, *inter alia*, then-pending claims 1, 2, 3, 5, 6, and 8 as obvious over Clark and Rice, claim 4 as obvious over Clark, Rice, and Murphy, and claim 7 as obvious over Clark, Rice, and Ellefson. *Id.* at 156–58.

On March 20, 2012, the applicant initiated an interview with the Examiner. Ex. 1033, 150. The applicant proposed an amendment to then-pending claim 1 to add two additional limitations, i.e., “wherein the work surface is disposed above a top of the at least one compartment” and “wherein the work surface is movable relative to a remainder of the work platform from an extended position to a non-extended position.” *Id.* at 152. The Examiner’s interview summary provides:

that as regards the proposed amendment to claim 1, that the combined base and modifying references (e.g., Clark et al. and Rice et al.) would not reasonably meet a claim with these further limitations. As regards the claims initially including some recitations directed to movable work surfaces (which claim 1 initially did not include), the examiner noted that currently the critical modifying reference would be the reference to Ellefson, and there was some further discussion directed to the structural compatability [sic] of the Ellefson reference, with the examiner suggesting that in combination with the amendment, an argument directed to the structural issues associated with the combination

of Clark et al. and Ellefson would likely be persuasive in overcoming the rejections as currently set forth.

Id.

The applicant subsequently amended then-pending claim 1 to add limitations that recite “wherein the work surface is disposed above a top of the at least one compartment” and “wherein the work surface is movable relative to a remainder of the work platform from an extended position to a non-extended position.” Ex. 1033, 132. The applicant argued that amended claim 1 should be allowable over Clark, Rice, Murphy, and/or Ellefson “because none of these references discloses a cart having a height-adjustable work platform with a movable work surface located above a compartment.”

Id. at 138.

The applicant next argued that an ordinarily skilled artisan “would not incorporate the teachings of Rice, Murphy, and Ellefson into the workstation of Clark so as to arrive at a height-adjustable work platform with a movable work surface located above a compartment.” Ex. 1033, 138. In support of this argument, the applicant submitted that if an ordinarily skilled artisan “had tried to incorporate the pivotal trays 48, 50, and 52 of Ellefson into the workstation of Clark, the resulting work station would be top heavy if the trays were deployed” resulting in the deployed trays making “the workstation of Clark unstable so that it would be easily knocked over.” *Id.* at 138–39. According to the applicant, because Ellefson’s “tool chest contains heavy tools so as to prevent the instability, a condition that is lacking in Clark,” Ellefson’s tool chest with its lower center of gravity “permits the use of pivotal trays while the workstation of Clark (with its higher center of gravity) does not.” *Id.* at 139. The applicant makes similar

arguments with respect to the rejection of pending claim 4, which relied on Murphy in combination with Clark and Rice. *Id.*

The Examiner subsequently allowed amended claims 1–24. Ex. 1033, 125. The Examiner did not provide a Statement of Reasons for Allowance. *Id.*

For the following reasons, we determine that the portions of the prosecution history of the '650 patent relied on by Patent Owner do not “prov[e] the existence of a ‘clear and unmistakable’ disclaimer that would have been evident to one skilled in the art.” *Trivascular*, 812 F.3d at 1063–64.¹⁴

Patent Owner argues that the prosecution history redefined the term forward “by disclaiming workstations that are mounted on top of or over the height adjustment mechanism.” PO Resp. 29. Claims 3 and 4 recite “a work platform including a work surface and compartments for containing items” not a “workstation.” It is unclear what Patent Owner is referring to as the “workstation,” i.e., the recited “work platform,” the recited “work surface,” or the combination of “work platform,” “work surface,” and the recited “compartments.” Patent Owner injects further ambiguity by rephrasing the disclaimer, as “Applicant explicitly disclaimed carts having work stations mounted *entirely to* the top of the height adjustment mechanism (e.g., carts like Clark and Reeder).” *Id.* at 30 (emphasis added). Regardless of these

¹⁴ Because of our determination that the requirements for a clear and unmistakable disclaimer are not met by the cited portions of the prosecution history of the '650 patent, we need not and do not reach the question of relevance of the statements in the prosecution of the '650 patent to the claims of the '668 patent.

ambiguities, Patent Owner misinterprets the statements in the prosecution history.

The applicant's primary argument was that an ordinarily skilled artisan would not have incorporated moveable work surfaces above the "compartment" of Clark. Ex. 1033, 137–38. The applicant's arguments, thus, do not support Patent Owner's argument here that "workstations" should not be mounted "over or on top of the height adjustment mechanism." *See id.*

Similar to claims 3 and 4 here, then-pending claim 1 in the '650 patent application recited "wherein the work platform includes a portion projecting, relative to the height adjustment mechanism, in the forward direction, wherein the *compartment is disposed in the portion of the work platform projecting in the forward direction.*" Ex. 1033, 132 (emphasis added). Our review of the applicant's remarks cited by Patent Owner reveals no mention at all of limiting the scope of "disposed in" or that "forward" means in front of the height adjustment mechanism. Likewise, there is no argument in the prosecution history concerning workstations "mounted on top of or over the height adjustment mechanism" or "entirely to" the top of the height adjustment mechanism.

Patent Owner also argues that "a key aspect of the invention is a lower [center of gravity] (which as discussed above is realized by disposing the compartments in the portions of the work platform projecting in front of the height adjustment mechanism as opposed to mounting the work station on top it)." PO Resp. 29–30. Patent Owner does not cite to any portion of the Specification where "center of gravity" is discussed or explained and our review has found no reference to center of gravity. Further, there is nothing

recited in claim 3 or claim 4 relating to center of gravity. The only support for Patent Owner's argument is the prosecution history of the '650 patent. In the *Microsoft* case, the Federal Circuit discussed that the prosecution history of the later-filed application confirmed what was in the common specification of the related patents, i.e., the claims were limited to communications over a telephone line. *Microsoft*, 357 F. 3d 1340 at 1349. Here, there is no relation between the statements in the prosecution history concerning center of gravity and the Specification of the '668 patent, let alone confirmation of what is described in the Specification of the '668 patent.

For all the foregoing reasons, we determine that the prosecution history of the '650 patent does not contain "a 'clear and unmistakable' disclaimer" of "carts having workstations mounted entirely to the top of the height adjustment mechanism." Consequently, we apply the plain and ordinary meaning of forward as opposite of rearward in the context of claims 3 and 4.

D. Ground 1: Alleged Obviousness of Claim 3 over Clark, Manner, and Santoro

Petitioner contends claim 3 would have been obvious over Clark, Manner, and Santoro. Pet. 10–41. Petitioner supports its contentions with Mr. Kemnitzer's declaration. Ex. 1004.

Patent Owner contends that Petitioner fails to establish that Clark discloses compartments "disposed in the work platform that project from the height adjustment mechanism in the forward direction" and fails to articulate a motivation to combine/modify Clark to reach the claimed invention. PO Resp. 32, 37. Patent Owner supports its contentions with Dr. Ben-Tzvi's declaration. Ex. 2012.

Patent Owner also contends that secondary considerations of non-obviousness support the patentability of the challenged claims. PO Resp. 61–63. Patent Owner supports this contention with Mr. Rydingsward’s declaration. Ex. 2018.

We begin with a brief summary of Clark, Manner, and Santoro and then address the parties’ contentions.

1. Clark (Ex. 1010)

Clark is titled “Mobile Clinical Workstation.” Ex. 1010, code (54). Clark discloses “a mobile workstation that can include an adjustable-height horizontal tray, a pull-out keyboard tray, a vertically-mounted docking station mounted to the tray, a computer terminal mounted beneath the tray, a display screen mounted to the horizontal tray, and a power unit.” *Id.* at 1:7–12.

Figure 1 of Clark is reproduced below:

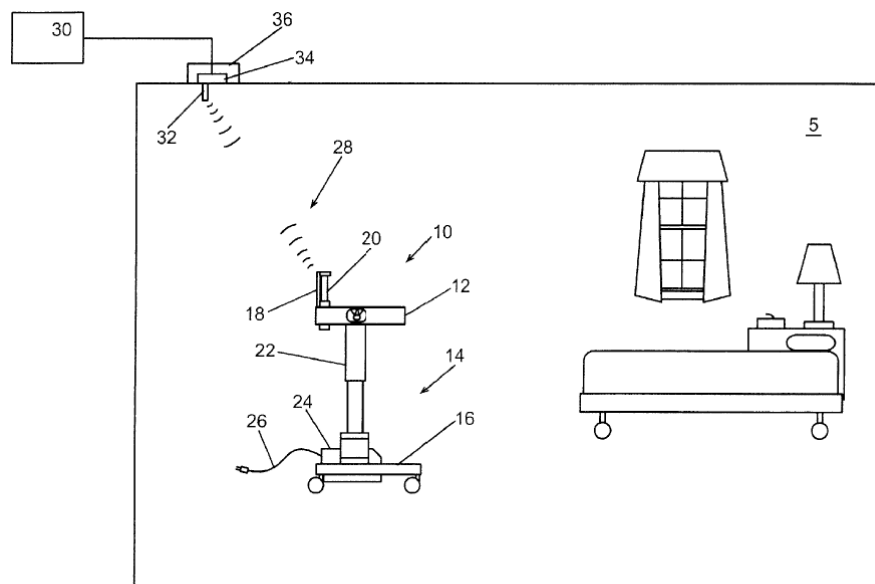


Fig. 1

Figure 1 illustrates a mobile workstation of Clark that is in a patient’s hospital room. Ex. 1010, 4:29–31. Mobile workstation 10 includes docking

station 18 and adjustable-height tray 12 supported by chassis 14. *Id.* at 8:50–59. Chassis 14 includes vertical beam 22 and dolly assembly 16. *Id.* at 8:55–62. Vertical beam 22 includes “a gas-spring height adjustment mechanism for adjusting the length of the beam.” *Id.* at 8:63–64.

Figure 4B of Clark is reproduced below:

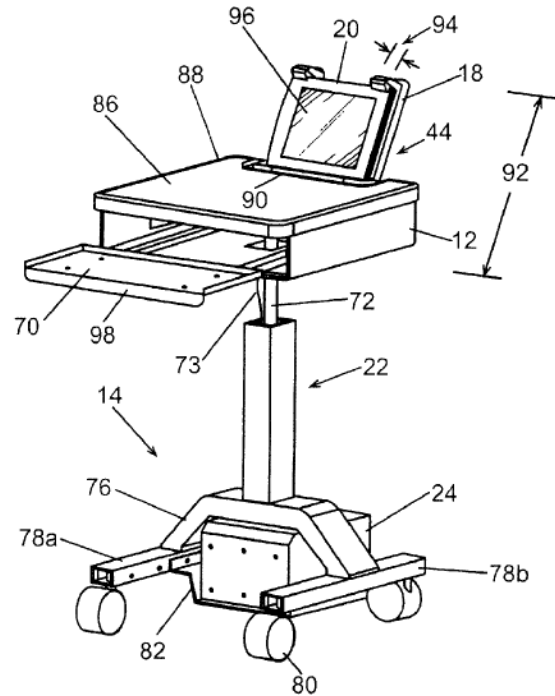


Fig. 4B

Figure 4B is a perspective view of a mobile workstation of Clark, with a pull-out keyboard tray. Ex. 1010, 4:40–42. The mobile workstation includes pull-out keyboard tray 70, which is supported by the underside of horizontal tray 12 and can slide from an inner position to an outer position as shown. *Id.* at 11:40–45.

2. Manner (Ex. 1007)

Manner is titled “Height-Adjustable Work Table.” Ex. 1007, code (54). Manner discloses that its height-adjustable work table has a support frame with at least one telescopic column. *Id.* at code (57).

Figure 5 of Manner is reproduced below:

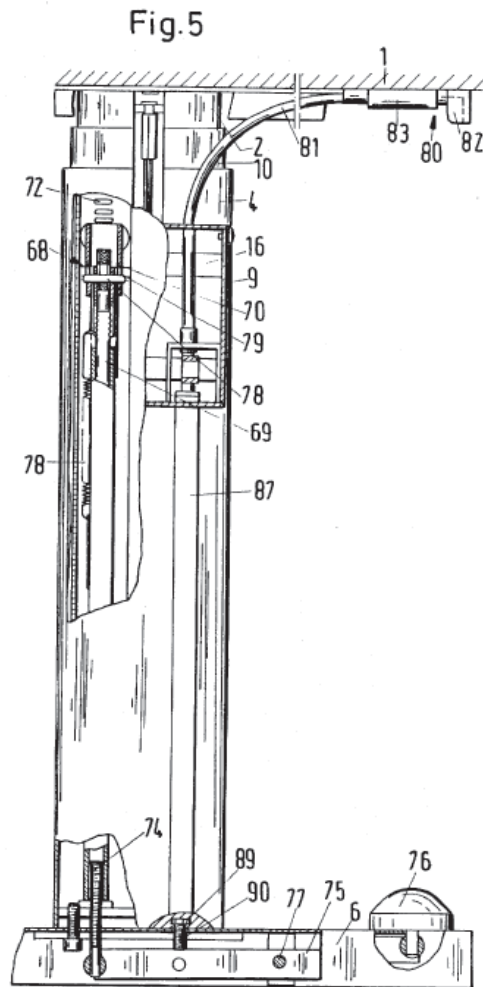


Figure 5 is a partly sectional and partly elevated view of a work table of Manner. Ex. 1007, 3:44–46. Manner discloses that table top 1 can be arrested at a “selected level relative to the table frame” via arresting device 68 in column 4. *Id.* at 8:38–40. Arresting device 68 is actuated by actuating device 80 which comprises Bowden pull 81. *Id.* at 9:17–26. Bowden pull 81 includes handle or pivotable grip 82 held by holder 83 that is positioned “at any desired location” so that “actuating device 80 can be easily activated by the user.” *Id.* at 9:26–36.

3. *Santoro (Ex. 1008)*

Santoro is titled “Workstation with Adjustable Height Frame.” Ex. 1008, code (54). Santoro discloses that its workstation includes slide mechanisms having ball bearings which “are well known to those skilled in the art of drawer slides, for example.” *Id.* ¶ 36.

4. *Claim 3*

We start by analyzing Petitioner’s contentions for the claim limitations in light of Patent Owner’s contentions.¹⁵ We then address motivation to combine.

[3pre] A cart comprising:

Petitioner does not address whether the preamble is limiting but contends that Clark teaches “a cart in the form of ‘[a] mobile workstation includes an adjustable-height horizontal tray and a pull-out keyboard tray mounted beneath the horizontal tray to support a keyboard.’” Pet. 22 (citing Ex. 1004 ¶ 53;¹⁶ Ex. 1010, Abstract, 1:7–12, 2:59–67, 3:23–59, 4:5–11); *see also id.* at 24 (reproducing Ex. 1010, Fig. 4B).

Patent Owner does not address the preamble of claim 3. *See* PO Resp. 31–48.

We have reviewed the evidence cited by Petitioner and find that Clark discloses the subject matter of the preamble for the reasons explained by Petitioner. Because we find that Clark discloses the subject matter of the preamble, we need not address whether the preamble of claim 3 is limiting.

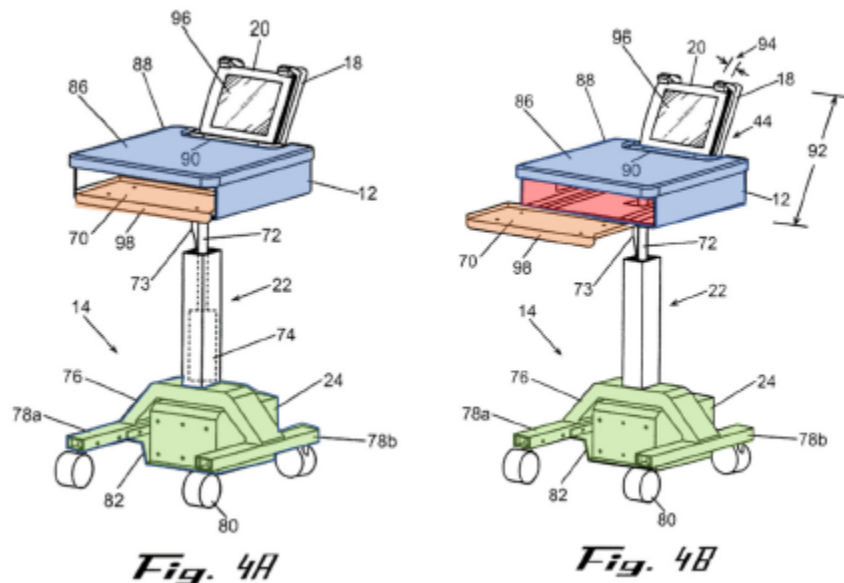
¹⁵ For ease of reference, we utilize Petitioner’s claim annotations.

¹⁶ Petitioner’s citation is to “Kemnitzer, 53.” Pet. 22. Based on our review of the Kemnitzer Declaration (Ex. 1004), this citation is to paragraph 53, not page 53. We treat similar citations as referencing paragraphs not pages.

[3a] a work platform including a work surface and compartments for containing items;

Petitioner contends that “Clark discloses a work platform in its horizontal tray 12” with a top side that “defines a substantially horizontal work surface 86.” Pet. 23 (citing Ex. 1010, 11:67–12:26). Petitioner further contends that “Clark discloses a work surface in the form of a pull-out keyboard tray 70” that “slides from an inner position, shown in FIG. 4A, to an outer position, shown in FIG. 4B.” *Id.* at 23–24 (citing Ex. 1004 ¶¶ 56–57; Ex. 1010, 11:40–45).

Petitioner provides the following annotated version of Figures 4A and 4B of Clark:



Pet. 24. Figures 4A and 4B “are perspective views of” Clark’s mobile workstation “showing the operation of a pull-out keyboard tray.” Ex. 1010, 4:41–43. Petitioner highlights Clark’s horizontal tray 12 in blue, pull-out

keyboard tray 70 in orange, the internal walls of horizontal tray 12 in red, and the lower portion of chassis 14 in green. Pet. 24.

Petitioner next contends that “Clark also teaches a compartment within the work platform in the form of a cavity below the work surface 86 and above the pullout keyboard tray 70.” Pet. 24 (citing Ex. 1004 ¶¶ 57–58; Ex. 1010, Figs. 4A, 4B). Petitioner alternatively argues that “Clark explains that the cavity may be a drawer” and can “alternatively be located **above** or under the horizontal tray 12, demonstrating the flexible nature of the positioning of the work surface and compartments in Clark within the work platform.” *Id.* (citing Ex. 1004 ¶ 59; Ex. 1010, 10:30–33).

Petitioner acknowledges that Clark discloses a single compartment but contends it would have been obvious to a person of ordinary skill in the art “to subdivide the cavity in Clark with multiple drawers or to implement more than one drawer “above or under the horizontal tray 12.” Pet. 25 (citing Ex. 1004 ¶ 59; Ex. 1010, 10:30–33). Petitioner contends that the ordinarily skilled artisan would have been motivated to do this “to improve the ability to organize unlike items in separate storage compartments.” *Id.* (citing Ex. 1004 ¶ 60). Petitioner also argues that “mere duplication of one compartment into two compartments has no patentable significance.” *Id.* (citing *In re Harza*, 274 F. 2d 669, 671 (CCPA 1960)).

Patent Owner first contends that Clark’s “open keyboard tray does not meet the definition for ‘compartment(s) as ‘an enclosed space for containing an item.’” PO Resp. 33 n.15 (emphasis omitted). Patent Owner argues that “this open keyboard cavity of Clark is not enclosed” and “is not provided for the purpose of separately storing medical items as intended by the ’668

[patent] . . . *e.g.*, medications and medical supplies, because it is already occupied by a pull-out keyboard tray 70, 424 and computer keyboard.” *Id.*

Petitioner argues that “Clark explicitly teaches a compartment within the work platform in the form of a cavity below the work surface 86 and above the pullout keyboard tray 70.” Pet. Reply 9–10 (citing Pet. 24; Ex. 1010, Figs. 4A–4B). Petitioner further contends that Clark “discloses ‘a drawer . . . located above or under the horizontal tray 12’ which ‘satisfies both the plain and ordinary meaning of ‘compartment’ and [Patent Owner’s] proposed narrow construction that requires compartments to be ‘enclosed.’” *Id.* (citing Ex. 1010, 10:30–33). According to Petitioner, “there is no reasonable dispute that Clark’s drawer is a compartment because the ’668 patent expressly identifies a ‘drawer’ as a ‘compartment.’” *Id.* (citing Ex. 1001, 2:15).

As discussed above in our claim construction analysis, a “compartment” is “an enclosed space for containing an item.” During the oral hearing, Petitioner conceded that “cavity below [Clark’s] work surface 86 and above the pullout keyboard tray 70” (*see* Pet. 24) does not meet this construction of “compartment;” instead Petitioner relies on its alternative argument that Clark’s disclosure of a drawer satisfies the “compartment” limitation. Tr. 16:1–12.

The Specification of the ’668 patent provides that “[t]he compartment can be a drawer.” Ex. 1001, 2:15. Clark discloses “a drawer or pullout tray located above or under the horizontal tray 12.” Ex. 1010, 10:31–32. Based on these disclosures, we find that Clark discloses a “compartment.”

Patent Owner does not dispute Petitioner’s contentions concerning the recited “work platform,” “work surface,” or that duplication of one

compartment into two compartments would have been obvious. PO Resp. 31–48. We find Clark discloses these elements for the reasons explained by Petitioner.

For the reasons explained above, we find that Clark teaches this limitation.

[3b] a base configured to be movable in at least a rearward direction; and

Petitioner contends that “Clark explains the ‘dolly assembly includes an arched cross-beam 76 that connects to two horizontal runner beams 78a-b’ and “[t]wo casters, represented by the caster 80, are connected to the bottom sides of each horizontal runner beam.” Pet. 27 (citing Ex. 1010, 11:59–63, 16:26–30, Fig. 4B). Petitioner further contends that an ordinarily skilled artisan “would have understood casters attached to the bottom of Clark’s dolly assembly enabled the base to be movable in several directions, including at least a rearward direction (i.e., away from a user facing the computer screen).” *Id.* at 27–28 (citing Ex. 1004 ¶¶ 64–65).

Patent Owner does not address this limitation. *See* PO Resp. 31–48.

We have reviewed Petitioner’s contentions and evidence and find that Clark teaches this limitation for the reasons explained by Petitioner.

[3c] a height adjustment mechanism for adjusting the height of the work platform relative to the base,

Petitioner contends that “Clark discloses a height adjustment mechanism in the form of a vertical beam 22, a gas-spring height adjustment mechanism 74, and shaft 72.” Pet. 28. According to Petitioner, “Clark explains its embodiment has ‘vertical beam 22 [that] includes a gas-spring height adjustment mechanism for adjusting the length of the beam and, thus, the height of the horizontal tray 12 above the dolly assembly 14.’” *Id.* (citing

Ex. 1010, 8:63–9:10). Petitioner further contends that Clark’s “[s]haft 72 connects to the gas-spring height adjustment mechanism 74 that allows adjustment of the height of the horizontal tray 12. The gas-spring height adjustment mechanism 74, which is located at the bottom of the vertical beam 22, sits on top of the dolly assembly 16.” *Id.* (quoting Ex. 1010, 11:54–58).

Patent Owner does not address this limitation. *See* PO Resp. 31–48.

We have reviewed Petitioner’s contentions and evidence and find that Clark teaches this limitation for the reasons explained by Petitioner.

[3d] wherein the base includes a portion that projects from the height adjustment mechanism in a forward direction that is substantially opposite to the rearward direction,

Petitioner contends that “Clark’s base includes a portion, runner beam 78a, that projects from the height adjustment mechanism (vertical beam 22, a gas-spring height adjustment mechanism 74, and shaft 72) in a forward direction that is substantially opposite to the rearward direction.” Pet. 29–30 (citing Ex. 1004 ¶¶ 69–70; Ex. 1010, 11:59–63, Fig. 4A).

Patent Owner does not address this limitation. *See* PO Resp. 31–48.

We have reviewed Petitioner’s contentions and evidence and find that Clark teaches this limitation for the reasons explained by Petitioner.

[3e] wherein the work platform includes a portion that projects from the height adjustment mechanism in the forward direction, the compartments are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction, and the compartments are configured to permit a user facing in the rearward direction to access an item within the compartments,

Petitioner provides an annotated version of Clark’s Figure 4A, which Petitioner contends “depicts a portion of work platform 12 projecting in a

forward direction from height adjustment mechanism 74.” Pet. 30. We reproduce Petitioner’s annotated Figure 4A below:

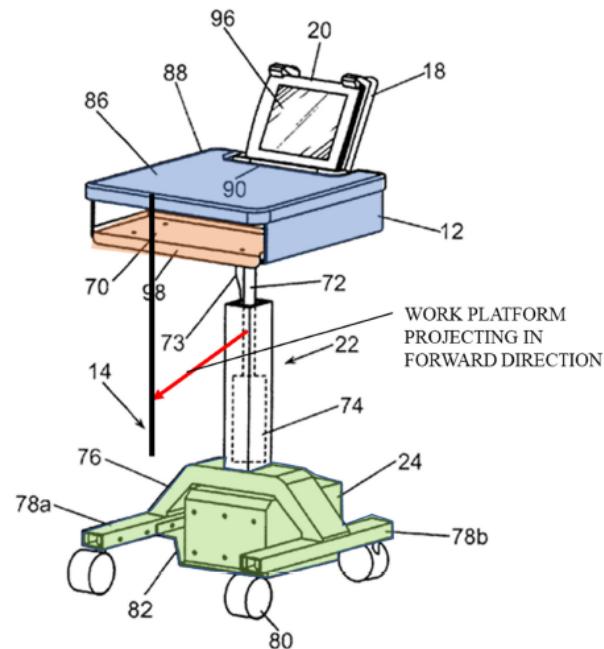


Fig. 4A

Pet. 31. Figure 4A is a perspective view of Clark’s mobile work station. Ex. 1010, 4:41–41. In this annotated Figure 4A, Petitioner highlights Clark’s horizontal tray 12 in blue, pull-out keyboard tray 70 in orange, and a lower end of chassis 14 in green. *Id.* Petitioner also adds a vertical black line running downward from the top front edge of work surface 86, a red generally horizontal arrow from the front of height adjustment mechanism 74 to the vertical black line, and a second generally horizontal line pointing to the vertical black line from text stating “WORK PLATFORM PROJECTING IN FORWARD DIRECTION.” *Id.*

Petitioner contends that “[t]he compartment shown below horizontal work surface 86 is disposed in the portion of the work platform that projects, relative to the height adjustment mechanism, in the forward direction

because it extends to the forward side of the height adjustment mechanism within the work platform” and “[t]he compartments are configured to permit a user facing in the rearward direction to access an item within the compartments because the compartment is open on the side facing the user when the user faces the computer.” Pet. 31–32 (citing Ex. 1004 ¶¶ 71–72).

Patent Owner contends that “the keyboard tray of Clark (even assuming it is a ‘compartment’)[] is mounted on top of the height adjustment mechanism and thus is disposed outside a portion that is forward (or in front) of the height adjustment mechanism.” PO Resp. 33. Patent Owner illustrates its contention with the following annotated version of a portion of Clark’s Figure 1:

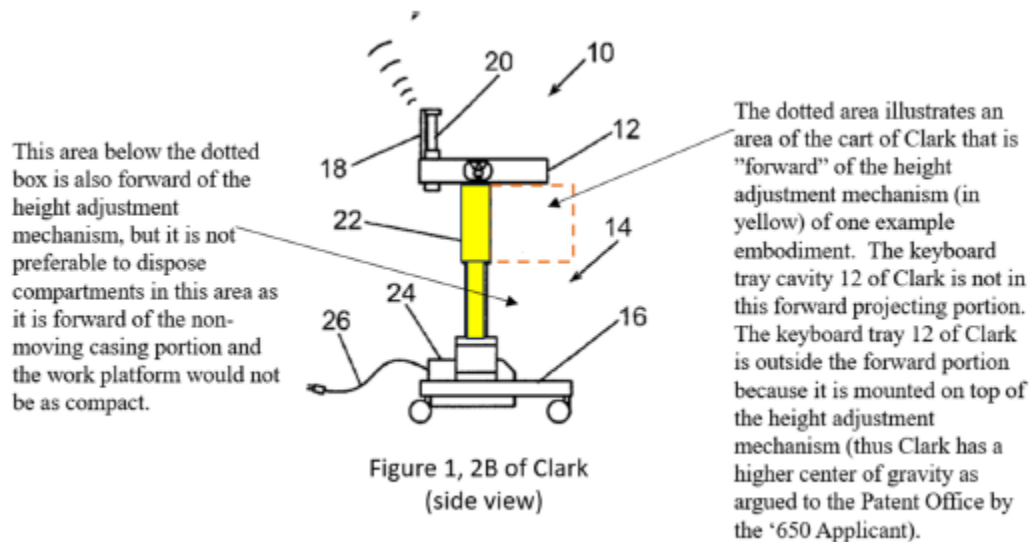


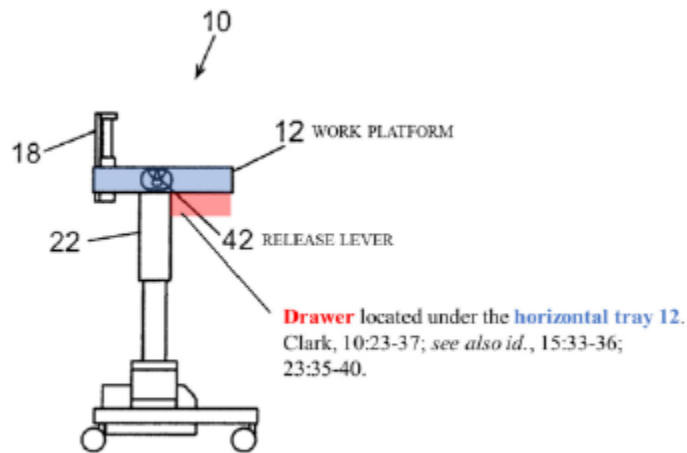
Figure 1 is a side view of Clark’s mobile work station. Ex. 1010, 4:29. Patent Owner adds text blocks to the right and left of Figure 1, shades element 22 in yellow and adds an orange-dashed rectangle to the right of the top portion of element 22 below horizontal tray 12. According to Patent Owner, this annotated drawing shows that “the keyboard tray 12 of Clark . . . does not meet this limitation as it is not contained entirely in a portion of the

work platform projecting in front of the height adjustment mechanism.” PO Resp. 34 (citing Ex. 2012 ¶¶ 63–66).

Responding to Petitioner’s alternative argument that Clark discloses a drawer under keyboard tray 12, Patent Owner contends “[w]hile Clark makes an unclear and passing reference to alternatively moving the vertically mounted computer docking station . . . to a supporting drawer or pull-out tray, the details are vague, hypothetical and aspirational.” PO Resp. 34 (citing Pet. 24). Patent Owner argues that “Clark does not explain or suggest that such a hypothetical, aspirational, and unillustrated drawer be contained in a *forward* projecting portion of a height adjustable work platform as claimed or how it would be configured or accomplished.” *Id.* at 35 (citing Pet. 24; Ex. 1010, 10:30–33). According to Patent Owner, “Clark never explains specifically where or how such a drawer should be attached” or “how far under the tray the drawer should be placed, or whether it is disposed in the alleged work platform as claimed, much less *contained in the portion of the work platform projecting in front of the height adjustment mechanism.*” *Id.*; *id.* at 36 (repeating the same argument (citing Ex. 2012 ¶¶ 67–70)). Patent Owner also argues that, because Clark states “that the docking station 18 (with attached computer terminal 20) can be mounted to the underside of the tray, but not a drawer,” Clark “indicates that the inventors of Clark also appreciated that adding a drawer to the computer work station of Clark was not feasible or desired.” *Id.* at 36.

In the Reply, Petitioner argues that “[t]he claims simply do not require a compartment disposed entirely in the portion of the work platform projecting from the height adjustment mechanism in the forward direction.”

Pet. Reply 14. Petitioner provides the following annotated version of Clark's Figure 2B:



Clark, Fig. 2B (annotated)

Id. Figure 2B is a side view of Clark's mobile workstation. Ex. 1010, 4:32–33. Petitioner annotates Figure 2B by highlighting work platform 12 in blue, adding a red rectangle under the front portion of work platform 12, adding black text reading “WORK PLATFORM” next to the numeral 12, adding black text reading “RELEASE LEVER” next to number 42, and text reading “Drawer 12 located under the horizontal tray 12, Clark, 10:23–57; see also *id.*, 15:33–36, 23:35–40” with a black line pointing to the red rectangle. Pet. Reply 14.

Petitioner contends that this annotated Figure 2B shows that “Clark expressly discloses a drawer located ‘under the horizontal tray 12.’” Pet. Reply 14 (citing Ex. 1010, 10:22–57, 15:33–36, 23:35–40). According to Petitioner, an ordinarily skilled artisan “would have understood this drawer would be located as shown in the above annotated copy of Clark’s Figure 2B” and “that Clark’s drawer is ‘disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward

direction.” *Id.* (citing Ex. 2010, 129:4–12, 129:16–130:4, 131:8–25, 133:15–135:5).

Patent Owner, in turn, argues that Petitioner’s expert “admitted that this one sentence in Clark fails to explicitly teach that the alleged drawer in Clark be attached to the underside of the keyboard tray 12 and fails to explicitly state the alleged drawer should be contained entirely in the forward projecting portion of the workstation of Clark.” Sur-reply 12 (citing Ex. 2010, 132:1–135:7). Patent Owner then argues that Clark’s drawer could hypothetically be placed at two locations/orientations under Clark’s horizontal tray 12 that are different than the location shown by Petitioner in its Reply. *Id.* at 12–13.

For the following reasons we find Petitioner’s argument supported on the complete record before us and Patent Owner’s contentions unavailing.

Claim 3 recites that “the work platform includes *a portion* that projects from the height adjustment mechanism in the forward direction.” Ex. 1001, 15:4–6 (emphasis added).

Petitioner maps the recited “work platform” to Clark’s horizontal tray 12 comprising work surface 86. Pet. 23 (citing Ex. 1010, 11:67–12:26, Fig. 4A). Petitioner maps the height adjustment mechanism to “vertical beam 22, a gas-spring height adjustment mechanism 74, and shaft 72.” *Id.* at 28. Patent Owner does not dispute that Clark discloses these elements of limitation [3e]. PO Resp. 31–36. Petitioner establishes by way of annotated Figure 4A that a portion of work platform 12 projects from the height adjustment mechanism in the forward direction. Pet. 31.

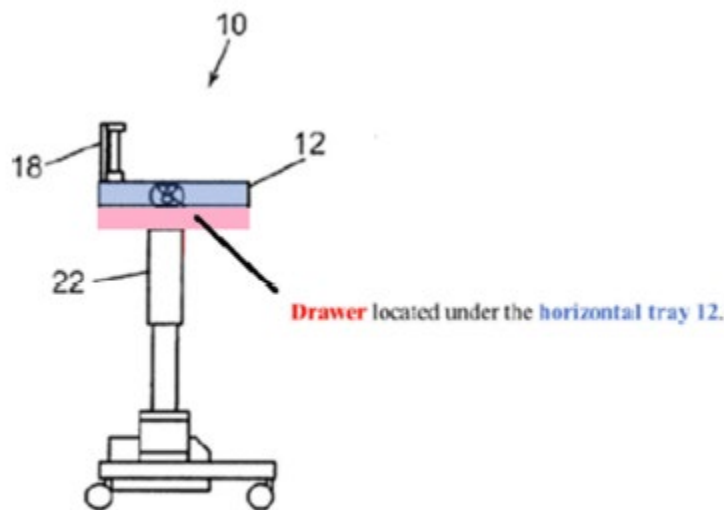
Patent Owner, relying on its proposed constructions of “disposed in” and “front,” argues that Clark does not teach or suggest compartments

“disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction.” PO Resp. 32; *id.* at 33 (arguing Clark’s keyboard tray 12 “is not contained entirely in the portion of the work platform projecting in front of the height adjustment mechanism”); *id.* at 35 (Clark’s drawer is “*not contained in the portion of the work platform projecting in front of the height adjustment mechanism.*”). Because we do not adopt Patent Owner’s proposed constructions, these contentions are unavailing.

We now turn to the question of whether Petitioner establishes that Clark teaches or suggests drawers disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction as required by the ordinary and customary meaning of claim 3.

Petitioner relies on Clark’s disclosure that “docking station 18 could be supported in a substantially horizontal position, for example by a drawer . . . located above or under the horizontal tray 12.” Pet. 24 (quoting Ex. 10:30–33). Patent Owner argues that Clark’s disclosure of the drawer is “hypothetical, aspirational, and unillustrated.” PO Resp. 35. In response to Patent Owner’s argument, Petitioner provides an example of a drawer placement that not only meets the ordinary and customary meaning of “compartment” in claim 3 but also Patent Owner’s proposed construction requiring that the drawer be contained in the portion of the work platform projecting in front of the height adjustment mechanism. Pet. Reply 12. Patent Owner, in turn, argues that “Clark does not teach the placement of compartments at this very specific location claimed.” Sur-reply 12 (citing Pet. Reply 12).

In connection with Clark's Figure 4B and the text at column 10, lines 30–33, Mr. Kemnitzer testifies that the meaning of “under” is that “[i]t could be . . . touching it. Or it could mean there's . . . a space between it.” Ex. 2010, 133:16–134:1. The testimony that the drawer “under” the compartment is touching the compartment aligns with Patent Owner's example on page 13 of the Sur-reply, which is reproduced below:



Clark, Fig. 2B (annotated)

Id. at 13. Figure 2B is a side view of Clark's mobile workstation. Ex. 1010, 4:40–41. With respect to the location of the drawer, Mr. Kemnitzer also testifies that “I think any designer of ordinary skill would understand that it would be in the forward position, so it could be accessible by the user of the platform.” *Id.* at 135:2–5.

Dr. Ben-Tzvi's testimony on the placement of the drawer is essentially the same as the Patent Owner Response. He testifies that

[a]s to being placed ‘under’ the tray, Clark never explains specifically where or how such a drawer should be attached. In other words, this one sentence in Clark never explains how far

under the tray the drawer should be placed, or whether it is disposed in the alleged work platform, much less *contained in the portion of the work platform projecting in front of the height adjustment mechanism*.

Ex. 2012 ¶ 68. Although we agree with Patent Owner and Dr. Ben-Tzvi that Clark does not explicitly disclose the precise placement of the drawer under compartment 12, this is an obviousness ground not anticipation. The inquiry is what Clark teaches or suggests to one of ordinary skill in the art about the placement of the drawer under the keyboard compartment. Neither Patent Owner nor Dr. Ben-Tzvi dispute Mr. Kemnitzer’s testimony that a person of ordinary skill in the art would understand that “under” can mean touching the compartment and the drawer would be in the forward position to be accessible by the user. Ex. 2010, 133:6–134:1, 134:15–135:5.

Patent Owner’s argument—that adding a drawer to the “workstation of Clark was not feasible or desired” because Clark explicitly states that the docking station can be mounted to the underside of the tray (PO Resp. 36)—is also unavailing for the following reasons.¹⁷ Clark explicitly states that “docking station 18 could be supported in a substantially horizontal position by a drawer . . . located . . . under the horizontal tray 12.” Ex. 1010, 10:30–32. Clark also discloses that “[o]ther locations for the docking station 18 may be preferred in certain environments. For example, the docking station could mounted to . . . the underside of the horizontal tray 12.” *Id.* at 10:32–37 (emphasis added). Clark, thus, explicitly discloses two embodiments where the docking station is either supported by a drawer under the horizontal tray 12 or mounted to the underside of the horizontal tray 12

¹⁷ Dr. Ben-Tzvi repeats Patent Owner’s argument essentially verbatim in his testimony. Ex. 2012 ¶ 68.

presumably without a drawer. These express disclosures from Clark contradict Patent Owner's argument and Dr. Ben-Tzvi's testimony that adding a drawer to the workstation of Clark was not feasible or desired.

Based on Mr. Kemnitzer's testimony, which we credit as consistent with Clark's explicit disclosure of a drawer located "under" the compartment, we find that an ordinarily skilled artisan would have understood that Clark suggests at least one option for the placement of the drawer in the position shown in Petitioner's Reply at page 14.

For the foregoing reasons, we find that Clark teaches or suggests this limitation.

[3f] wherein the height adjustment mechanism is configured to releasably lock the work platform at a plurality of heights,

Petitioner contends that "Clark's height adjustment mechanism can be positioned at multiple heights" and includes "[a] locking mechanism [that] selectively prevents the leveling tray from moving vertically." Pet. 32 (citing Ex. 1004 ¶¶ 73–74; Ex. 1010, 1:61–63, 4:5–11). Petitioner further contends that "Clark explains '[o]nce the horizontal tray 12 is at a desired height, represented by the height shown in FIG 2B, **the operator releases the lever 42, which locks the tray at the desired height.**'" *Id.* (citing Ex. 1010, 9:53–10:8, 14:65–15:10).

Patent Owner does not address this limitation. PO Resp. 31–48.

We have reviewed Petitioner's contentions and evidence and find that Clark teaches this limitation for the reasons explained by Petitioner.

[3g] wherein the height adjustment mechanism comprises: a stationary casing connected to the base; a telescoping casing connected to the work platform and configured to move relative to the stationary casing;

Petitioner provides the following annotated version of Clark's Figure 2B:

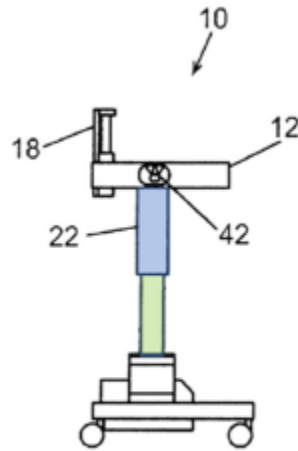


Fig. 2B

Pet. 34. Figure 2B is a side view of Clark's mobile work station. Ex. 1010, 4:32–33. In this annotated view, Petitioner highlights Clark's vertical beam 22 in blue and what it contends is the recited stationary casing in green.

Pet. 34. Petitioner contends that Clark teaches “a telescoping casing [highlighted in blue] connected to the work platform and configured to move relative to the stationary casing [highlighted in green].” *Id.* According to Petitioner, “Clark's vertical beam 22 is a telescoping casing and moves relative to the stationary casing connected to the base,” as shown in Figures 2A–2D. *Id.*

Patent Owner does not address this limitation. PO Resp. 31–48.

We have reviewed Petitioner's contentions and evidence and find that Clark teaches this limitation for the reasons explained by Petitioner.

[3h] at least two drawer slides disposed between the stationary casing and the telescoping casing;

Petitioner acknowledges that “Clark does not expressly disclose drawer slides.” Pet. 35. Petitioner contends that “Santoro describes ‘[a] pair of **conventional slide mechanisms** generally designated respectively 50 and 52 in FIG. 6 are operationally mounted between the inner leg 32 and the outer leg 34.’” *Id.* (citing Ex. 1008 ¶ 36, Fig. 6). Petitioner further contends that “Santoro’s slide mechanisms are ‘operationally mounted between the inner leg 32 and the outer leg 34’ which are components of Santoro’s telescoping leg 14, a part of Santoro’s height adjustable workstation.” *Id.* (citing Ex. 1008 ¶¶ 28, 33, 34, 36).

Patent Owner does not address this limitation. PO Resp. 31–48.

We have reviewed Petitioner’s contentions and evidence and find that the combination of Clark and Santoro teaches this limitation for the reasons explained by Petitioner.

[3i] a driver configured to releasably lock the telescoping casing relative to the stationary casing; and

Petitioner contends that “Clark discloses ‘**a gas-spring height adjustment mechanism** for adjusting the length of the beam and, thus, the height of the horizontal tray 12 above the dolly assembly 14’” and “[t]he gas-spring height adjustment mechanism 74, which is located at the bottom of the vertical beam 22, sits on top of the dolly assembly 16.” Pet. 36 (citing Ex. 1004 ¶¶ 83, 84; Ex. 1010, 8:63–9:10, 11:50–58). Petitioner further contends that “Clark explains that ‘[a]ssistance provided by the gas-spring height adjustment mechanism allows the operator to change the height of the horizontal tray with little effort’ and once the tray ‘is at a desired height . . . **the operator releases lever 42, which locks the tray at the desired**

height.” *Id.* at 36–37 (citing Ex. 1004 ¶ 85; Ex. 1010, 9:53–10:8, 14:65–15:10).

Patent Owner does not address this limitation. PO Resp. 31–48.

We have reviewed Petitioner’s contentions and evidence and find that Clark teaches this limitation for the reasons explained by Petitioner.

[3j] an actuator for controlling the driver, and

Petitioner contends that Clark’s release lever 42 corresponds to the recited actuator. Pet. 37. Petitioner argues that release lever 42 “releases a stop in the gas-spring height adjustment mechanism in the vertical beam” and “[t]he operator then raises or lowers the horizontal tray 12 while holding the release lever 42 in a raised position.” *Id.* (citing Ex. 1010, 9:50–62, 10:50–62, 12:20–44, 13:50–65).

Patent Owner does not address this limitation. PO Resp. 31–48.

We have reviewed Petitioner’s contentions and evidence and find that Clark teaches this limitation for the reasons explained by Petitioner.

[3k] wherein the actuator is disposed above the compartments and on the portion of the work platform that projects in the forward direction.

Petitioner contends that the combination of Clark and Manner teaches this limitation. Pet. 38. Petitioner argues that “Clark’s actuator is disposed above the compartments . . . that . . . are located below the work platform.” *Id.* (citing Ex. 1004 ¶¶ 91–92; Ex. 1010, 10:23–37, 15:33–36, 23:35–40). Petitioner notes that Clark’s actuator is located “on the side of the work platform,” but contends “[i]t would have been obvious . . . to modify Clark to incorporate an actuator on the portion of the work platform that projects in the forward direction.” *Id.* at 39 (citing Ex. 1004 ¶ 93; Ex. 1010, Figs. 2A–2D, 5A–5B, 9A–9D, 11A–11B, 20).

Petitioner provides the following annotated version of Manner's Figure 5 (Pet. 40):

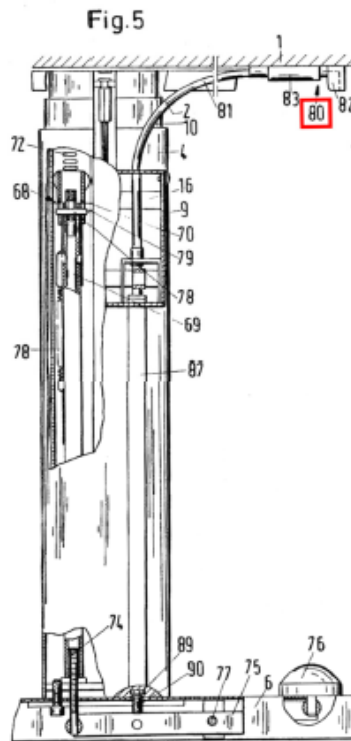


Figure 5 is a partial side section view of Manner's device. Ex. 1007, 3:44–46. Petitioner adds a red square around numeral 80. Pet. 40. Petitioner contends that Manner's actuator 80 is “positioned ‘to the edge of the table top 1 facing the user of the work table.’” *Id.* at 39 (citing Ex. 1007, 9:24–26). Petitioner further contends that “Manner explains that the ‘holder 83 [of the actuator] can be connected **at any desired location to the table top 1** so that the actuating device 80 **can be easily activated by the user.**” *Id.* (citing Ex. 1007, 9:33–35).

Patent Owner does not address this limitation. PO Resp. 31–48.

We have reviewed Petitioner's contentions and evidence and find that the combination of Clark and Manner teaches this limitation for the reasons explained by Petitioner.

Motivation to Combine and Reasonable Expectation of Success

Petitioner contends that Clark, Manner, and Santoro are in the same field of endeavor, i.e., “height adjustable work stations.” Pet. 17–18 (citing Ex. 1004 ¶¶ 41–44; Ex. 1007, 15:62–67, 16:8–9; Ex. 1008 ¶ 11, Abstract; Ex. 1010, 8:50–9:10, 10:5–8, Figs. 2A–D). Petitioner further contends that “[b]ecause all references generally disclose height-adjustable work platforms and work surfaces with telescoping supports, a [person of ordinary skill in the art] would have found them combinable with a reasonable expectation of success.” *Id.* at 18 (citing Ex. 1004 ¶ 45).

Petitioner acknowledges that Clark does not “expressly disclose (1) an actuator disposed on the portion of the work platform that projects in the forward direction, or (2) drawer slides.” Pet. 18 (citing Ex. 1004 ¶ 46). Petitioner contends that “Manner discloses a height-adjustable work platform with a telescopic column” and “provides details of the internal components to the telescopic column supporting the height adjustment functionality of Manner’s work platform.” *Id.* at 18–19 (citing Ex. 1004 ¶ 48; Ex. 1007, 1:5–7; 9:33–35, 15:8–10, 15:61–16:9, Fig. 5, 12). According to Petitioner, an ordinarily skilled artisan “would have been motivated by Manner’s teaching to make the actuator ‘easily activated by the user’ and would have looked to substitute Clark’s lever actuator with Manner’s actuator.” *Id.* at 19 (citing Ex. 1004 ¶ 48).

Petitioner next contends that an ordinarily skilled artisan “would have recognized Manner’s Bowden pull actuator as a suitable substitute for the lever actuator 42 disclosed in Clark” because “Manner expressly states that these two actuators may be substituted for each other.” Pet. 19 (citing Ex. 1007, 9:17–31). According to Petitioner, an ordinarily skilled artisan

“would have been motivated to implement the actuator in Manner to control Clark’s gas-spring height adjustment mechanism to provide flexibility in locating the actuator.” *Id.* (citing Ex. 1004 ¶ 49). Petitioner also contends that “Clark’s gas spring driver is controlled by a release lever 42 that extends through ‘an opening 40 in the side of the horizontal tray’ and would have motivated an ordinarily skilled artisan “to reposition the actuator to another location on the work platform to implement the drawers recited in Clark” to prevent actuation of lever 42 by the contents of the drawer. *Id.* at 19–20 (citing Ex. 1004 ¶ 47; Ex. 1010, 9:51–62).

Petitioner next contends that an ordinarily skilled artisan “would have been motivated to implement the Bowden pull actuator in Manner to control Clark’s gas-spring height adjustment mechanism to provide flexibility in locating the actuator and to ensure operation of Clark’s drawer embodiments.” Pet. 41 (citing Ex. 1004 ¶ 95). Petitioner further contends that Manner’s disclosure, at column 9, lines 33 to 35, provides motivation for the combination ,and that “[i]t was routine and well understood by a [person of ordinary skill in the art] to position an actuator at the front of a work platform for ease of access by the user.” *Id.* (citing Ex. 1004 ¶ 95).

For the combination of Clark and Santoro, Petitioner contends that Santoro discloses that “its slide mechanisms were ‘conventional slide mechanisms’ and ‘well known to those skilled in the art of drawer slides.’” Pet. 20 (citing Ex. 1008 ¶ 36). According to Petitioner, an ordinarily skilled artisan “would have recognized the benefit of reducing binding between the sections of [Clark’s] telescoping column and would have looked to slides as in Santoro to reduce that binding.” *Id.* (citing Ex. 1004 ¶ 50). Petitioner further contends that the technique of using slides to reduce binding was

“wholly conventional to” a person of ordinary skill in the art. *Id.* at 21 (citing Ex. 1004 ¶ 50). Petitioner also contends the combination of Clark and Santoro would have resulted “in quieter operation for less patient disturbance.” *Id.* at 36 (citing Ex. 1004 ¶ 82).

Petitioner contends that an ordinarily skilled artisan “would have had a reasonable expectation of success in combining these features because the prior art recognized that height adjustable work platforms include weight-compensation devices employing gas springs.” Pet. 21 (citing Ex. 1007, 1:13–33, 7:6–15, 7:60–67, 15:8–12, 15:62–16:23). According to Petitioner, “[t]he combination would have involved combining known prior art elements (a medical cart, a gas spring, drawer slides, and a Bowden pull actuator on the front of a work platform) according to known methods . . . to yield predictable results.” *Id.* (citing Ex. 1004 ¶ 51).

Patent Owner does not address Petitioner’s contentions concerning motivation to combine Clark, Manner, and Santoro or reasonable expectation of success. PO Resp. 31–48.

We have reviewed Petitioner’s contentions and evidence concerning motivation to combine and reasonable expectation of success and find Petitioner has shown that an ordinarily skilled artisan would have been motivated to combine Clark, Manner, and Santoro with a reasonable expectation of success because the combination involves known elements, i.e., a medical cart, as gas spring, drawer slides, and a Bowden pull actuator combined according to known methods to yield the predictable result of a cart with a height adjustable work platform with a telescoping column easily adjustable by a user of the cart by means of a Bowden pull actuator mounted to the front of the work platform. *See* Ex. 1004 ¶¶ 46–51.

Patent Owner contends that Petitioner does not provide argument why an ordinarily skilled artisan “would be motivated to modify the cart of Clark to include compartment(s) ‘disposed in the portion of the work platform that projects from the height adjustment mechanism in the *forward direction*’ as claimed.” PO Resp. 37. According to Patent Owner, Petitioner relies on an overly broad claim construction and “completely fails to articulate a motivation to combine or modify Clark to reach this limitation or explain how there would be a reasonable expectation of success in doing so.” *Id.* (citing Pet. 30–32; Ex. 1004 ¶¶ 80–81).

Petitioner, in turn, contends that Clark expressly teaches a compartment, i.e., “a drawer located ‘under the horizontal tray 12’ corresponding to the claimed work platform.” Pet. Reply 15 (citing Pet. 23–25; Ex. 1004 ¶¶ 57–60). Based on this express disclosure, Petitioner argues that no motivation to combine or modify Clark is necessary. *Id.* Notwithstanding this argument, Petitioner contends that “the Petition also explains a [person of ordinary skill in the art] would have implemented drawers in Clark’s work platform ‘to improve the ability to organize unlike items in separate storage compartments.’” *Id.* (citing Pet. 25; Ex. 1004 ¶ 60). Petitioner further argues that the Petition “recognizes that ‘security of health information . . . as well as medications themselves, was a common concern in the medical cart industry.’” *Id.* (citing Pet. 20; Ex. 1004 ¶ 47; Ex. 1020, 4–5; Ex. 1021, 1:35–55). According to Petitioner, its “expert confirmed such modifications were routine and well within the level of ordinary skill as supported by Ellman, Reeder, and other prior art references.” *Id.* at 15–16 (citing Ex. 1004 ¶ 60; Ex. 1006, Figs. 30, 32; Ex. 1018, 2:18–24, Figs. 1, 2).

Patent Owner, in turn, contends that “Petitioner’s only argument relating motivation to combine/modify the references amounts to conclusory statements from its expert that in general, the use of drawers was desired and obvious and that ‘such modifications were routine and [within] the level of ordinary skill.’” Sur-reply 15 (citing Pet. Reply 14–15). According to Patent Owner, “[t]hese conclusory statements, even if true, do not rise to sufficient evidence of a motivation to combine/modify the references.” *Id.*

We do not agree with Patent Owner that a motivation to modify/combine Clark to reach limitation [3e] is needed. As discussed above for limitation [3e], Clark explicitly discloses a drawer under compartment 12 and suggests to a person of ordinary skill in the art the placement of the drawer in the portion of the work platform forward of Clark’s height adjustment mechanism. Thus, no modification to Clark is required to teach limitation [3e].

Summary of Claim 3

For the foregoing reasons, we determine that Petitioner establishes that the combination of Clark, Manner, and Santoro teaches or suggests every limitation of claim 3 and that an ordinarily skilled artisan would have been motivated to combine Clark, Manner, and Santoro with a reasonable expectation of success.

Objective Indicia of Non-Obviousness

We now turn to Patent Owner’s objective indicia contentions.

Patent Owner argues three types of objective indicia. First, that its carts have been a commercial success and been praised (PO Resp. 61); second, that competitors copied the patented features (*id.* at 62); and third, that the patented invention satisfied a long felt need and there was a failure

of others (*id.* at 62–63). We analyze each type of objective indicia separately.

Nexus

In order for us to accord substantial weight to objective indicia of non-obviousness in the analysis of the *Graham* factors, Patent Owner must establish “a ‘nexus’ to the claims, *i.e.*, there must be ‘a legally and factually sufficient connection’ between the evidence and the patented invention.” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) (citations omitted). We presume a nexus when the evidence is tied to a specific product that is “coextensive” with the claimed invention, for example, because “the unclaimed features amount to nothing more than additional insignificant features.” *Id.* at 1373–74. Without the presumption, a patentee may establish nexus by showing the objective indicia evidence of non-obviousness is the “direct result of the unique characteristics of the claimed invention,” *id.* (quoting *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996)), rather than a feature that was “known in the prior art,” *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006). Both presumption of nexus and a nexus in fact are fact questions. *Fox Factory*, 944 F.3d at 1373; *WBIP*, 829 F.3d at 1331–32.

We note that each type of objective evidence of non-obviousness must be shown to have nexus. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995) (nexus generally); *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996) (commercial success); *Wm. Wrigley Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d 1356, 1364 (Fed. Cir. 2012) (copying); *Rambus Inc. v. Rea*, 731 F.3d 1248, 1256 (Fed. Cir. 2013) (long-felt need); *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1328 (Fed. Cir. 2008) (praise).

Commercial Success and Praise

Patent Owner contends that “[t]he commercial success of [Patent Owner’s] patented carts . . . and the praise received from customers over the years is directly related to the patented features.” PO Resp. 61. According to Patent Owner, “customers love the fact that drawers of the patented M38 and M48 . . . carts are height adjustable, and yet the carts have maintained their stability (e.g., certified under UL60601’s strict stability requirements).” *Id.* (citing Ex. 2018 ¶¶ 1–17). Patent Owner’s only evidence of commercial success and praise is the Declaration of Craig Rydingsward, Exhibit 2018. Tr. 31:18–21; 54:10–18.

Petitioner contends that Mr. Rydingsward “touts the commercial success of Capsa’s M38 and Carelink carts . . . but he provides no sales data to substantiate that success.” Pet. Reply 24 (citing Ex. 1045, 26:9–11). Additionally, “Mr. Rydingsward attributes the success of Capsa medical carts to their ‘lower center of gravity and better weight distribution’” but according to Petitioner, “[t]he claims require no center of gravity or weight distribution, and Mr. Rydingsward admits he has no engineering experience to evaluate these features in the first place.” *Id.* (citing Ex. 1045:12:7–15; Ex. 2018 ¶ 14).

Petitioner next contends that Patent Owner’s commercial success arguments are doomed because Patent Owner “cannot demonstrate a nexus between the claimed features and the commercial success of Capsa’s product.” Pet. Reply 27. According to Petitioner, “Mr. Rydingsward conceded he was unfamiliar with the claims of the ’668 patent and could not provide a nexus between the claims and the commercial success of Capsa’s products” and “admitted that unclaimed features such as aesthetics, touch

screen interface, and fleet management software features also contributed to Capsa’s ‘commercial success.’” *Id.* (citing Ex. 1045, 9:15–10:12, 15:1–9, 23:7–24:1, 25:1–26:1). Petitioner also argues that Patent Owner “spent an unspecified amount of resources on marketing its M38 and Carelink cart products, and . . . made no attempt to establish that sales of its carts are driven by claimed features rather than its marketing efforts.” *Id.* (citing Ex. 1045, 21:5–19).

Patent Owner, in turn, argues that Mr. Rydingsward’s declaration provides evidence of nexus. Sur-reply 25. Patent Owner cites generally to paragraphs 1–17 and argues that Mr. Rydingsward “stat[es] that the placement of the drawer in front of the [Height Adjustment Mechanism] is a major reason carts have a lower COG, are stable and sell so well.” *Id.*

Analysis

Patent Owner’s arguments on commercial success and praise are silent as to nexus, fail to cite evidence in support of nexus (e.g., a claim chart identifying how Patent Owner’s product maps to either of the Challenged Claims), and fail to provide any indication of whether Patent Owner relies on the presumption of nexus or nexus in fact. PO Resp. 61. Patent Owner’s attempt to rely on Mr. Rydingsward’s declaration testimony to establish nexus is misplaced because he states:

I know, firsthand that customers appreciate and respect and purchase in many instances a Capsa cart over other carts *because of the UL60601 certification.*

Ex. 2018 ¶ 11 (emphasis added). Neither claim 3 nor claim 4 requires UL606601 certification. His testimony on this point undercuts any argument that there is a nexus between the claimed invention and the alleged commercial success. For these reasons, we find that Patent Owner has not

established a nexus, by presumption or otherwise, between the Challenged Claims and the evidence it relies on for commercial success and praise.

Patent Owner's evidence of commercial success and praise is likewise deficient. Patent Owner's only evidence of commercial success is Mr. Rydingsward's declaration. Tr. 54:4–9. Mr. Rydingsward does not provide any sales data such as monetary amounts of sales, the number of carts sold, or market share. *See* Ex. 2018; Tr. 54:10–13. Likewise for praise, Patent Owner's only evidence is Mr. Rydingsward's declaration. *Id.* at 54:14–18. Patent Owner did not submit any documents or testimony substantiating praise of Patent Owner's medical carts by customers or competitors.

Mr. Rydingsward is employed by Patent Owner as “Senior Vice President of Capsa Healthcare.” Ex. 2018 ¶ 2. Given his position with Patent Owner and the absence of objective evidence to support his testimony on commercial success and praise, we give little weight to his testimony.

In the absence of a showing of nexus and the absence of any objective evidence such as sales information, market share, or documents or testimony from customers, Patent Owner's evidence of commercial success and praise is entitled to very little weight.

Copying

Patent Owner contends that, after Rubbermaid, the initial assignee of the '668 patent “filed the patent applications that issued into the '668 and '650 Patents, and after Rubbermaid started commercially selling medical cart[s] incorporating the patented features all of the major players in the medical cart industry” began selling medical carts that copied the patented features. PO Resp. 62 (citing Ex. 2018 ¶ 18).

Patent Owner did not submit any documents illustrating any competitor's medical carts or a claim chart comparing the allegedly copied carts to the claims of the '668 patent or Patent Owner's carts. Tr. 54:19–55:1, 55:12–55:17. The only evidence in the record is Mr. Rydingsward declaration. Ex. 2018 ¶ 18. However, as Petitioner contends, “Mr. Rydingsward did not enter the industry until after the priority application to the '668 patent was filed” and “lacks personal knowledge on the state of the industry at the 2003 critical date.”¹⁸ Pet. Reply 26.

Without at least rudimentary evidence concerning the design of the medical carts allegedly copied from the '668 patent and argument tying the features of those carts to the claimed invention, we find that Patent Owner's copying contentions are unsupported attorney argument, fail to establish nexus, fail to establish copying, and are entitled to very little weight.

Long Felt Need and Failure of Others

Referring to prior art references such as Clark, Reeder, and Exhibit 2011, Patent Owner contends that “people have been trying to figure out a better way to stabilize portable (mobile), computer workstations and carts by lowering the cart's [center of gravity].” PO Resp. 62. Patent Owner further contends that “each of these prior art patents, went with conventional wisdom at the time prior to the '650 and '668 Patents of placing the workstation portion entirely on top of the height adjustment mechanism while keeping it as light and unencumbered as possible.” *Id.* According to Patent Owner, at time of filing of the '668 patent, the state of the art “as

¹⁸ Mr. Rydingsward testified that he did not consider himself a person of ordinary skill in the art, he is not an expert in the design of medical carts, he is not an expert in patent law, and he doesn't know what the claims of the '668 patent or the '650 patent require. Ex. 1045, 14:14–15:9.

shown by the prior art, demonstrates that nobody in the industry has gone the direction of the '650 Applicant who was the first to contain the compartment(s) entirely in the portion of the work platform in front of the height adjustment mechanism," which "keep[s] the [center of gravity] lower and maintain[s] the needed stability of the cart." *Id.* at 63.

In order to establish long felt need, Patent Owner must establish that "such a 'problem' objectively existed, as distinguished from its acknowledged subjective existence in the minds of the inventors and their patent counsel." *In re Gershon*, 372 F.2d 535, 538 (CCPA 1967). Patent Owner must also establish that others unsuccessfully attempted to solve the problem. *See Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.3d 1376, 1382 (Fed. Cir. 1983).

Patent Owner does not cite to any evidence in support of nexus, long-felt need and failure others let alone objective evidence that a problem existed or any evidence that others unsuccessfully attempted to solve the problem. The contentions are, thus, unsupported attorney argument. For each of the above reasons, we give very little weight to Patent Owner's arguments concerning long-felt need and failure of others.

Summary of Objective Indicia of Non-Obviousness

For all the foregoing reasons, we find that Patent Owner's evidence of objective indicia of non-obviousness lacks a nexus to the claimed invention and, even if nexus was shown, fails to support a finding of commercial success, praise, copying, long-felt need, or failure of others. Consequently, it is entitled to very little weight even in the aggregate in the analysis of the *Graham* factors.

Weighing the Graham Factors

We have considered the scope and content of the prior art, the differences between the claimed subject matter and the prior art, the level of ordinary skill in the art and Patent Owner’s contentions and evidence concerning objective indicia of non-obviousness. After weighing all the evidence in the record and the parties’ competing arguments, we determine that Petitioner’s evidence of obviousness far outweighs Patent Owner’s minimal evidence of non-obviousness; therefore, we determine that Petitioner establishes by a preponderance of the evidence that claim 3 would have been obvious to one of ordinary skill in the art at the time of the invention over Clark, Manner, and Santoro.

E. Ground 3

Petitioner contends that, “[u]nlike claim 3, claim 4 does not include drawer slides” and “is unpatentable over Clark and Manner.” Pet. 41. For each limitation of claim 4, Petitioner relies on its contentions and evidence for the corresponding limitation of claim 3 with additional testimony of Mr. Kemnitzer (Ex. 1004 ¶¶ 97–108). *Id.* at 41–43. For motivation to combine and reasonable expectation of success, Petitioner relies on its contentions for claim 3. *Id.* at 41 (citing Ex. 1004 ¶ 96).

Patent Owner does not argue for the patentability of claim 4 apart from its contentions for claim 3. PO Resp. 31–48.

We have reviewed Petitioner’s arguments and additional evidence of Mr. Kemnitzer’s testimony in support thereof and for the same reasons discussed above for claim 3 (including the weighing of the evidence in favor of obviousness and against), we determine that Petitioner establishes by a preponderance of the evidence that claim 4 would have been obvious to one

of ordinary skill in the art at the time of the invention over Clark and Manner.

F. Grounds 2, 4, and 5–8

Petitioner submits these alternate challenges to the patentability of claims 3 and 4. Pet. 3. As discussed above, we have addressed all challenged claims based on Grounds 1 and 3, and as such, we need not and do not decide whether Petitioner has shown by a preponderance of the evidence that the challenged claims also would have been unpatentable over any of these alternate challenges. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding that a petitioner “is entitled to a final written decision addressing all of the claims it has challenged”); *see also* 35 U.S.C. § 318(a); *cf. In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009) (not reaching other grounds of unpatentability after affirming the anticipation ground); *see also Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (holding that once a dispositive issue is decided, there is no need to decide other issues).

III. CONCLUSION¹⁹

Weighing the competing evidence and testimony, we determine that Petitioner establishes by a preponderance of the evidence that claims 3 and 4 of the ’668 patent are unpatentable.

¹⁹ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we

In summary:

Claims Challenged	35 U.S.C. §	Reference(s)/ Basis	Claim(s) Shown Unpatentable	Claim(s) Not Shown Unpatentable
3	103(a)	Clark, Manner, Santoro	3	
3	103(a)	Clark, Manner, Santoro, Gillis ²⁰		
4	103(a)	Clark, Manner, Santoro	4	
4	103(a)	Clark, Manner, Santoro, Gillis ²¹		
3	103(a)	Reeder, Manner, Santoro ²²		
3	103(a)	Reeder, Manner, Santoro, Gillis ²³		
4	103(a)	Reeder, Manner, Santoro ²⁴		
4	103(a)	Reeder, Manner, Santoro, Gillis ²⁵		
Overall Outcome			3, 4	

remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

²⁰ We do not reach this ground because we determine that claim 3 is unpatentable based on Petitioner’s first ground.

²¹ We do not reach this ground because we determine that claim 4 is unpatentable based on Petitioner’s third ground.

²² We do not reach this ground because we determine that claim 3 is unpatentable based on Petitioner’s first ground.

²³ We do not reach this ground because we determine that claim 3 is unpatentable based on Petitioner’s first ground.

²⁴ We do not reach this ground because we determine that claim 4 is unpatentable based on Petitioner’s third ground.

²⁵ We do not reach this ground because we determine that claim 4 is unpatentable based on Petitioner’s third ground.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 3 and 4 of the '668 patent have been shown by a preponderance of the evidence to be unpatentable; and

FURTHER ORDERED that any party seeking judicial review must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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Patent 7,594,668 B2

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