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AVITA MEDICAL VS. RENOVACARE SCI.
IPR2017-01243

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JORGEN J. MOLLER, JR.,
Appellant

Appeal 2010-012534
Reexamination Control 90/009,124
Patent 7,299,592
Technology Center 3900

Before RICHARD M. LEOVITZ, JEFFREY B. ROBERTSON, and
DANIEL S. SONG, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

This is a decision on the appeal by the Patent Owner of U.S. Patent No. 7,299,592 from the Patent Examiner's rejections 1-27 in an *ex parte* reexamination proceeding. The Board's jurisdiction for this appeal is under 35 U.S.C. §§ 6(b), 134(b), and 306. We reverse.

STATEMENT OF THE CASE

U.S. Patent No. 7,299,592 (hereinafter "the '592 patent") issued November 27, 2007. The named inventor is Jorgen J. Moller, Jr. A Third-Party Requester requested *ex parte* reexamination of claims 1-26 of the '592 patent pursuant to 35 U.S.C. §§ 302-307 and 37 C.F.R. § 1.510 ("Req." filed June 5, 2008). Reexamination was sought on the basis of several prior art publications said to raise substantial new questions of patentability (Req. 2). Reexamination was ordered. Claim 27 was added during the reexamination proceeding and patented claims 1, 7, 11, 14, 16, 19, 23, and 25 were amended. In a Final Rejection dated December 16, 2009, claims 1-27 were rejected. The rejection was appealed by the Patent Owner.

The claims involve injection molded floor panels. According to the '592 patent, injection molding was a known way of making floor tiles (col. 1, ll. 40-41). "Injection molding involves injecting heated liquid plastic into a mold." (Col. 1, ll. 41-42.) After injection into the mold, "the liquid plastic is allowed to cool thereby solidifying into the desired floor tile." (Col. 1, ll. 42-45). The '592 patent identified "sink marks" as a prominent problem that occurs with injection molding (col. 1, ll. 47-49).

[W]hen the liquid plastic cools it often forms sink marks on the top surface of the floor tile. The sink marks generally coincide with the support systems located on the bottom side of the floor tile. Sink marks are caused by extra material in certain areas

inside of the mold that requires additional cooling time. For example, if the bottom side of the tile contains numerous support structures, there will often be coinciding sink marks visible on the top surface of the final floor tile.

(Col. 1, ll. 48-56.)

The '592 patent states that sink marks detract from the appearance of the floor tile and collect dirt. The patent describes eliminating sink marks by aligning the support members on the floor tile bottom with the structures on the tile surface (col. 2, ll. 4-10). This configuration is said by the patent to prevent the surface of the tile under the support member from sinking during the cooling process (col. 2, ll. 11-14).

The appealed claims are directed to a molded floor panel with structures which extend upward from the main floor panel and support members which extend downward. The structures and support members are aligned and "an area defined by each of the one or more structures is contained within and positioned directly above an area defined by the one or more support members." The claims stand rejected by the Examiner under 35 U.S.C. § 103(a) as obvious in view of prior art disclosed in the '592 patent, Margolis,² and Osswald.³ Claim 1 is representative as reads as follow (with underlining indicating subject matter added to the issued claims):

1. An injection molded floor panel, comprising:
an at least substantially solid main floor panel;

² ENG'G THERMOPLASTICS: PROPERTIES AND APPLICATIONS, PLASTICS ENG'G 8 (James M. Margolis ed., 1985).

³ INJECTION MOLDING HANDBOOK (Tim A. Osswald et al. eds., 2001).

one or more structures which extend upward from the at least substantially solid main floor panel, the one or more structures including all structures which extend upward from the at least substantially solid main floor panel; and

one or more support members which extend downward from the at least substantially solid main floor panel;

wherein at least substantially all of the one or more structures are at least substantially vertically aligned with the one or more support members;

wherein an area defined by each of the one or more structures is contained within and positioned directly above an area defined by the one or more support members;

wherein the one or more structures form a discontinuous pattern of separate, elongated protrusions;

wherein the at least substantially solid main floor panel is continuous and solid between the one or more structures and the one or more support members; and

wherein the injection molded floor panel is rigid.

CLAIM INTERPRETATION

Statement of the Issue

Claim 1 is directed to an injection molded floor panel. The floor panel comprises surface “structures” which extend upward and “support members” which extend downward (*see* ‘592 patent, Fig. 4A, where **220** is a surface structure and **217** is a support member). The claim recites that “an area defined by each of the one or more structures is contained within and positioned directly above an area defined by the one or more support members.” All the independent claims recite this same or similar limitation. The Examiner took the position that the recited limitation, “an area” of the structure is “contained within” an area defined by the support member, was properly interpreted to require that only a part of the structure be contained

within the support member (Ans. 18-20; Final Office Action 16). The Examiner interpreted the claim to permit the top structures to extend outside the area of the bottom support members.

Appellant contends that, when the limitation is read in light of the ‘592 patent, it would be understood that the entire area of the upwardly extending structure is within the area of the support member (App. Br. 21). The issue is therefore the proper interpretation of this phrase. The following facts are relevant to this determination.

Findings of Fact (“FF”)

1. In describing the embodiment shown in Figures 6-10, the ‘592 patent states:

The pattern formed by the vertical and horizontal members **215**, **217** is aligned with the pattern essentially formed by the surface structure **220** as shown in FIG. 4B.

(Col. 6, ll. 5-8.)

2. Figure 4B, an embodiment of the invention, is reproduced below:

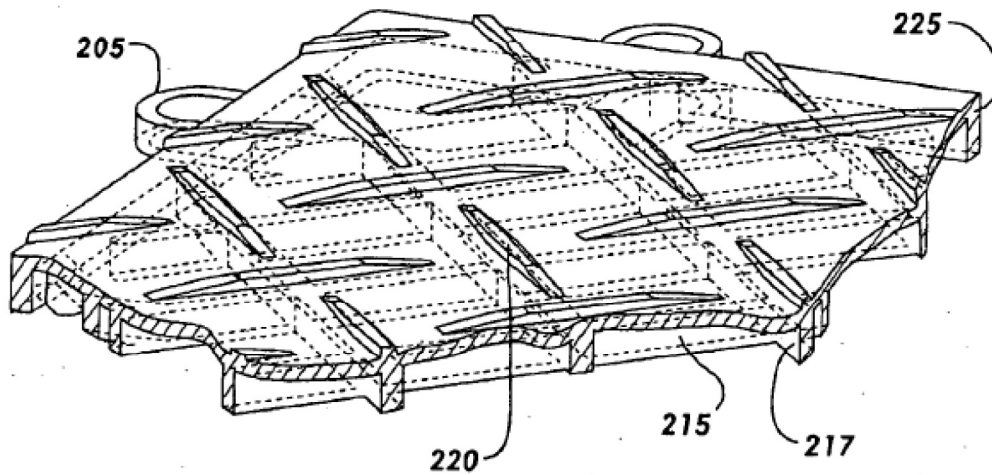


Fig. 4B

Figure 4B, reproduced above, shows upper structures **220** where the area defined by it are entirely contained within, and aligned with, an area defined by the lower support members **215** and **217**.

3. Figure 3B of the '592 patent was designated by the inventor as prior art. Figure 3B is reproduced below:

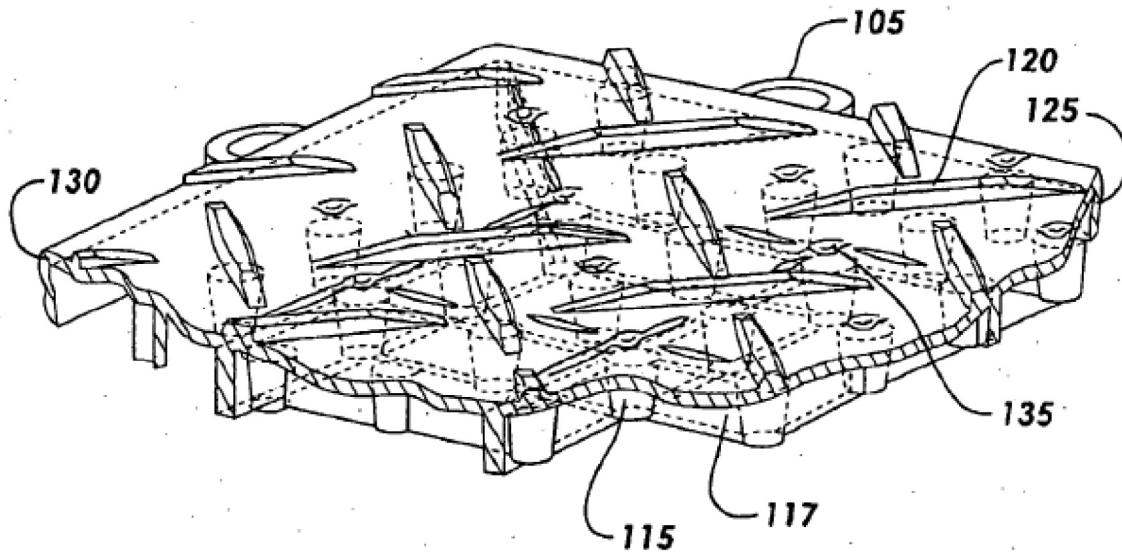


Fig. 3B
Prior Art

Figure 3B, reproduced above, shows that the area of upper structures **120** is not aligned with, nor contained entirely within, the area of the lower support members **115** and **117**, although there are overlapping areas.

Legal Principles

During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

In re ICON Health & Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007);
see also In re Suitco Surface, Inc., 603 F.3d 1255, 1259 (Fed. Cir. 2010).

“[A] person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005).

Analysis

Claims must be read in light of the specification of which they are part. *Phillips*, 415 F.3d at 1313. The ‘592 patent expressly acknowledges prior art molded floor tiles in which “sink marks” are formed on the tile top surface at positions corresponding to the position of the support systems located on the tile’s bottom floor (‘592 patent, col. 1, ll. 45-55) (*see supra* “Statement of the Case”). Figure 3B illustrates a prior art plastic injected molded tile “that suffers from the sink mark problem” (*id.* at col. 3, ll. 59-61). Figure 3B (FF3) clearly shows areas in which the upperwardly extending structure **120** overlap with the downwardly extending support members **115** and **117**. That is, an area of the upper structure **120** overlaps the area of a support member of the prior art molded tile. However, the upper structures are not co-extensive with the support members. The figure shows the upper structures criss-crossing in certain regions with the lower support member, producing areas in which the upper surface structure extend outside the support members.

The ‘592 patent describes the invention as addressing the sink mark problem by aligning the support system with the outwardly extending top surface structures. Certain embodiments show precisely the configuration in which the entire area defined by all of the top structures is within the area of

the support system (FF2). While we do not import limitations from the Specification into the claims, the claims must be read consistently with the Specification. *ICON*, 496 F.3d at 1379; *Suitco*, 603 F.3d at 1259. In this case, the Examiner's interpretation of the disputed limitation to permit parts of the upper surface structure to extend outside of the support system is not reasonable when read in light of the Specification.

First, the Examiner's interpretation of the disputed limitation corresponds to the configuration of the prior art tile depicted in Figure 3. This configuration is discussed above as resulting in sink marks. It is not reasonable to read the claims as reading on a prior art configuration which was expressly addressed and remedied by the '592 patent.

Secondly, a plain reading of the claim is consistent with the interpretation that the entire top structure area is completely "within" the support member system. The claim recites that "an area defined by each of the one or more structures is contained within and positioned directly above an area defined by the one or more support members." The written description does not define what "an area" constitutes, but the claimed "structures" would reasonably be understood to refer to all structures in the tile that extend upward. The claim also requires that the structures are vertically aligned with support members. Thus, the claim expressly characterize all the upwardly extending structures as aligned with the support members, which would indicate that – when aligned – they are completely contained within the bottom members.

Thirdly, as mentioned above, all the embodiments depicted in the '592 patent in which the upper and lower elements are characterized as vertically

aligned, all show the upper surface structure entirely within the lower support member (FF1 & FF2).

In view of these disclosures, persons of ordinary skill in the art would have understood that the claimed requirement that an “area” of a surface structure “is contained within ... an area defined by” the support member means that the entire upper area is within the lower area. The Examiner’s interpretation is not the broadest reasonable interpretation of the claims when read in view of the ‘592 patent.

OBVIOUSNESS REJECTION

The claims stand rejected over the prior art molded tiles shown in Figures 1-3 of the ‘592 patent in combination with the Margolis and Osswald publications. The Examiner found that Margolis and Osswald taught that sink marks on molded tile surfaces could be eliminated by putting outwardly extending ribs on the tile surface directly opposite the support member (Ans. 5). The Examiner concluded that it would have been obvious to modify the prior art molded tile with surface rib structures to avoid sink marks as taught by Margolis and Osswald (*id.* at 6.)

The Examiner’s rationale, at most, explains why the supporting members of the prior art molded tile would be covered by surface ribs – where the ribs correspond to the claimed “structures which extend upward from the . . . main floor panel.” However, the claims also require the area defined by all of the upward surface structures to be within the area of the downward bottom support members. The Examiner has not provided an adequate rationale as to why persons of ordinary skill in the art would have

had reason to make this configuration. The Examiner did not provide evidence that the prior art reasonably suggested the top ribs be placed completely within the area of the lower member support.

As pointed out by the Patent Owner, simply realigning the surface and support elements of the prior art molded tile depicted in Figure 1 of the '592 patent to make them directly opposite each other would result in some of the surface elements extending outside of the area of the support member (Reply Br. 4), a configuration excluded by the claim. The Examiner did not dispute this, but instead took the position that the claim language does not restrict the area of the surface structures to the entirety of the support members (Ans. 19), an interpretation that we have found to be unreasonably broad (*supra* at p. 7). Consequently, we are compelled to reverse the obviousness rejection of claims 1-27.

Requests for extensions of time in this *ex parte* reexamination proceeding are governed by 37 C.F.R. § 1.550(c). *See* 37 C.F.R. § 41.50(f).

REVERSED

bim

Appeal 2010-012534
Reexamination Control 90/009,124
Patent 7,299,592

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