Trials@uspto.gov
571-272-7822

Paper No. 8
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GROWLERWERKS, INC.,
Petitioner,

v.

DRINK TANKS CORPORATION,
Patent Owner.

Case IPR2016-01125
Patent 9,156,670 B2

Before PHILLIP J. KAUFFMAN, BEVERLY M. BUNTING, and JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, GrowlerWerks, Inc., filed a Petition (Paper 1, "Pet.," "the 1125 Petition") requesting *inter partes* review of claims 1–19 of U.S. Patent No. 9,156,670 B2 (Ex. 1001, "the '670 patent"). Patent Owner, Drink Tanks Corporation, filed a Preliminary Response. Paper 7 ("Prelim. Resp."). Pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we have jurisdiction to determine whether to institute review.

Upon consideration of the information presented in the Petition and Preliminary Response, and for the reasons explained below, we exercise our discretion and deny the Petition and do not institute an *inter partes* review of the '670 patent based on any of the asserted grounds.

A. RELATED MATTERS

The parties identify the following pending judicial matter as relating to the '670 patent: *Drink Tanks Corporation v. GrowlerWerks, Inc.*, No. 3:16-cv-00410-SI (D. Or.), filed Nov. 16, 2015, in the U.S. District Court for the District of Delaware and transferred to the District of Oregon on March 7, 2016. Pet. 2; *see* Paper 6, 1.

Additionally, Petitioner filed an additional petition for *inter partes* review of the '670 patent, IPR2017-00262 (Paper 2).

B. THE '670 PATENT (EX. 1001)

The '670 patent is titled "Systems for Storing Beverages." Ex. 1001, at [54]. The application resulting in the '670 patent was filed October 14, 2014, as a continuation of an application filed June 28, 2013, which itself claims priority to provisional applications filed February 18 and 20, 2013. Ex. 1001, 1:5–10; *accord id.* at [60], [63].

The '670 patent describes systems for storing and dispensing beverages, including carbonated or pressurized beverages. *Id.* at 1:35–46.

C. PROPOSED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability under 35 U.S.C. § 103(a):

Ground	References	Challenged Claim(s)
1	Olson,[1] Rosbach,[2] and Snead[3]	1–4, 7, 9, 10, 14, 15, 18, 19
2	Olson, Rosbach, Snead, and Arellano[4]	3–6
3	Olson, Rosbach, Snead, and Wissinger[5]	8
4	Olson, Rosbach, Snead, and Ash[6]	11–13
5	Olson, Rosbach, Snead, and Hammond[7]	11–13
6	Olson, Rosbach, Snead, and Laib[8]	15
7	Olson, Rosbach, Snead, and Russell[9]	16, 17

[1] U.S. Pat. Pub. No. 2008/0047922 A1, pub. Feb. 28, 2008 (Ex. 1009) ("Olson").
[2] U.S. Pat. Pub. No. 2013/0032564 A1, pub. Feb. 7, 2013 (Ex. 1010) ("Rosbach").
[3] U.S. Pat. Pub. No. 2013/0319969 A1, pub. Dec. 5, 2013 (Ex. 1011) ("Snead").
[4] U.S. Pat. No. 6,651,852 B2, iss. Nov. 25, 2003 (Ex. 1012) ("Arellano").
[5] U.S. Pat. No. 5,918,761, iss. July 6, 1999 (Ex. 1013) ("Wissinger").
[6] U.S. Pat. No. 5,199,609, iss. Apr. 6, 1993 (Ex. 1008) ("Ash").
[7] U.S. Pat. No. 7,131,560 B2, iss. Nov. 7, 2006 (Ex. 1014) ("Hammond").
[8] U.S. Pat. No. 9,114,911 B2, iss. Aug. 25, 2015 (Ex. 1015) ("Laib").
[9] U.S. Pat. No. 3,159,176, iss. Dec. 1, 1964 (Ex. 1016) ("Russell").

Ground	References	Challenged Claim(s)
8	Olson, Rosbach, Snead, and Windmiller[10]	16
9	Olson, Rosbach, Snead, and Wallace[11]	17
10	Olson, Rosbach, and Mociak[12]	1–4, 7, 9, 10, 18, 19
11	Olson, Rosbach, Mociak, and Arellano	4–6
12	Olson, Rosbach, Mociak, and Wissinger	8
13	Olson, Rosbach, Mociak, and Hammond	11–13
14	Olson, Rosbach, Mociak, and Laib	14, 15
15	Olson, Rosbach, Mociak, and Windmiller	16
16	Olson, Rosbach, Mociak, and Wallace	17

II. DISCUSSION

A. DISCRETION TO INSTITUTE

Institution of *inter partes* review is discretionary. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding."); *see* 37

[10] U.S. Pat. Pub. No. 2008/0142421 A1, pub. June 19, 2008 (Ex. 1017) ("Windmiller").
[11] U.S. Pat. Pub. No. 2011/0151085 A1, pub. June 23, 2011 (Ex. 1018) ("Wallace").
[12] U.S. Pat. Pub. No. 2014/0262899 A1, pub. Sept. 18, 2014 (Ex. 1019) ("Mociak").

C.F.R. § 42.108(a); 35 U.S.C. § 314(a). Panels of this Board have considered a variety of factors in deciding whether to exercise discretion not to institute review, including whether two separate petitions address substantially overlapping issues. *See, e.g.*, *Marvell Semiconductor, Inc. v. Intellectual Ventures I LLC*, IPR2014-00552, slip op. at 16–18 (PTAB Dec. 3, 2014) (Paper 16).

B. Filing Date of the Petition

A petition may not be filed less than nine months from the grant of the challenged patent if it "is a patent described in section 3(n)(1) of the Leahy-Smith America Invents Act" (the AIA). 37 C.F.R. § 42.102; *see* 35 U.S.C. § 311(c)(1); 37 C.F.R. § 42.3(b). Section 3(n)(1) of the AIA states that such patents include those with a claim with an effective filing date on or after March 16, 2013.[13]

In the instant petition, the challenged claims' effective filing date depends on application of 35 U.S.C. § 100(i)(1)(B), which provides that the effective filing date means "the filing date of the earliest application for which the patent or application is entitled, as to such invention, . . . to the benefit of an earlier filing date under section 120." In relevant part, 35 U.S.C. § 120 provides that

> [a]n application for patent for an invention disclosed in the manner provided by section 112(a) . . . in an application previously filed in the United States . . . shall have the same effect, as to such invention, as though filed on the date of the

[13] Section 3(n)(1) of the AIA applies an "effective date" defined as "upon the expiration of the 18-month period beginning on the date of the enactment of this Act." Because the AIA was enacted in law on September 16, 2011 (Pub. L. No. 112-29, 125 Stat. 284), the effective date of Section 3 is March 16, 2013.

> prior application . . . if it contains or is amended to contain a specific reference to the earlier filed application.

As described above, through its parent, the '670 patent claims priority to provisional applications filed February 18 and 20, 2013. Ex. 1001, 1:5–10; *accord id.* at [60], [63]; *see* 35 U.S.C. § 120. Thus, the "effective filing date" for the challenged claims depends on whether those claims were "disclosed in the manner provided by section 112(a)" in the provisional applications. *See* 35 U.S.C. § 120.

Petitioner argues that no claim of the '670 patent is entitled to an effective filing date earlier than June 28, 2013.[14] Pet. 8–11. Patent Owner does not address this issue in the Preliminary Response. *See generally* Prelim. Resp. Petitioner addresses this question with two separate arguments, one directed to independent claim 1 and dependent claims 2–17 (*id.* at 9–10), and the other directed at independent claim 18 and dependent claim 19 (*id.* at 10–11). While we take no position on these arguments at this time, if we were to conclude Petitioner is correct about either of those arguments, the '670 patent would contain a claim with an effective filing date after March 13, 2016, and 37 C.F.R. § 42.102(a)(1) would require a petition for IPR be filed no earlier than nine months after the grant of the patent, here July 13, 2016. The present Petition was filed June 2, 2016 (*see* Paper 4).

Out of an abundance of caution, we initiated a conference call with the parties on this issue. Specifically, in a teleconference with the parties on October 24, 2016, we apprised the parties of concerns regarding the Petition's filing date. During the conference, Petitioner and Patent Owner

[14] Petitioner must prevail with this assertion to maintain the grounds relying on Mociak.

indicated that we should continue with the present Petition. Petitioner indicated additionally that it expected to refile the petition. Indeed, on November 14, 2016, Petitioner filed a new petition. IPR2017-00262 (Paper 2) ("the 262 Petition"). The 262 Petition "is essentially identical to the petition filed in case IPR2016-01125, except for its filing date, correction of a few typographical errors, and other non-substantive changes primarily to meet the word count limitation." IPR2017-00262, Ex. 1021 (showing changes between the 1125 Petition and 262 Petition).

C. Exercise of Discretion

The 1125 Petition presents a question regarding the effective filing date of the challenged claims, as a predicate to applying Mociak as prior art to the '670 patent; as discussed above, the answer to that question controls whether the 1125 Petition was untimely filed. Because the 262 Petition was filed after July 13, 2016, this second petition does not present the same untimely filing concern under 37 C.F.R. § 42.3 and 37 C.F.R. §§ 42.102(a)(1) as the 1125 IPR. The 262 Petition, however, does present the same question regarding effective filing date. Thus, deciding whether the 1125 Petition was untimely filed would potentially mean addressing the same question twice. We decline to do so.

In our view, our decision on the effective filing date of the '670 patent is best constrained to a single petition. First, addressing the question in a single proceeding conserves judicial resources because we will not be addressing the same question twice. Moreover, doing so avoids any possibility of reaching different decisions based on different evidence or arguments. Further, our approach does not unduly prejudice either Petitioner or Patent Owner. Petitioner took the opportunity to file the same

substantive challenge to the '670 patent. And Patent Owner did not challenge the filing date of the 1125 Petition in its Preliminary Response. Because the refiled petition proposes the same grounds and arguments for invalidity as the present Petition—it is substantively identical (IPR2017-00262, Ex. 1021)—and was filed before any decision in this proceeding, it therefore does not present any concerns of taking a "second bite at the apple" or using our decision as a "roadmap" that other panels of the Board have found persuasive when considering multiple petitions against a given patent. *See, e.g.*, *Butamax Advanced Biofuels LLC v. Gevo, Inc.*, IPR2014-00581, slip op. at 12 (PTAB Oct. 14, 2014) (Paper 8).

We exercise our discretion to make our substantive determinations pursuant to the refiled 262 Petition, and deny the 1125 Petition.

III. CONCLUSION

For the reasons discussed above, we exercise our discretion to deny this Petition. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108; *see also Harmonic*, 815 F.3d at 1367.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is *denied* and no trial is instituted.

PETITIONER:

Kevin S. Ross
kevin_ross@techlaw.com

Sean D. O'Brien
seanobrien@techlaw.com

PATENT OWNER:

Craig R. Smith
csmith@lalaw.com

Eric P. Carnevale
ecarnevale@lalaw.com