

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADAPTICS LIMITED,
Petitioner,

v.

PERFECT COMPANY,
Patent Owner.

Case IPR2018-01596
Patent 9,772,217 B2

Before BARBARA A. BENOIT, MIRIAM L. QUINN, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

Adaptics Limited (“Petitioner”) filed a Petition (Paper 4, “Pet.”) seeking *inter partes* review of claims 1, 5, 6, 9, 13, 14, 17, 21, and 22 (“the challenged claims”) of U.S. Patent No. 9,772,217 B2 (Ex. 1001, “the ’217 patent”). Perfect Company (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Pursuant to prior authorization from the Board (Paper 16), Petitioner filed a Reply to the Preliminary Response (Paper 17, “Pet. Reply”), and Patent Owner filed a Surreply to Petitioner’s Reply (Paper 18, “PO Surreply”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314. For the reasons discussed below, we deny the Petition and do not institute an *inter partes* review.

I. BACKGROUND

A. *Real Parties-in-Interest and Related Matters*

Pursuant to 37 C.F.R. § 42.8(b)(1), Petitioner identifies Drop Kitchen, Inc. as a real party-in-interest. Pet. 65.

Pursuant to 37 C.F.R. § 42.8(b)(2), the parties identify the following civil action as involving the ’217 patent: *Perfect Company v. Adaptics Limited*, No. 3:14-cv-05976 (W.D. Wash.) (filed Dec. 12, 2014 and consolidated with No. 3:17-cv-05922 on Mar. 8, 2018). Pet. 65; Paper 6, 1.

B. *The ’217 Patent (Ex. 1001)*

The ’217 patent issued September 26, 2017, from an application filed August 15, 2015, and asserts the benefit of an application filed July 23, 2014, now U.S. Patent No. 9,645,007; an application filed June 16, 2013, now U.S. Patent No. 8,829,365 (“the ’365 patent”); and a provisional application filed March 15, 2013. Ex. 1001, at (21), (22), (45), (60), (63).

The '365 patent was the subject of an *ex parte* reexamination requested by Petitioner, which resulted in issuance of a reexamination certificate on July 5, 2017. *See* Pet. 66; Prelim. Resp. 3; Ex. 1028 (excerpts from the file history for *ex parte* reexamination); Exs. 2004, 2019–2028 (same).

The '217 patent discloses a system and method for assisting a user in assembling a culinary combination according to a recipe. Ex. 1001, at (57). The system comprises a smart scale in communication with a smart device (computing device), such as a tablet computer or mobile phone. *Id.* at (57), 4:27–37, Figs. 1, 3, 5. The system displays information regarding ingredients of the recipe and displays a progress of assembling the culinary combination based on information from the scale. *Id.* at (57), 7:22–31, Fig. 7.

According to the '217 patent, the system includes a “software app” on the smart device, which is configured to receive real-time information from the smart scale. *Id.* at 4:38–40. The system has one or more graphical displays to show the real-time amount for any ingredient being added. *Id.* at 4:53–55. The '217 patent discloses several options for advancing from one ingredient to the next, including weight-based auto-advance, audio command advance, recipe block selection, and scale button navigation. *Id.* at 9:12–60. According to an exemplary implementation of the weight-based auto-advance option, once the system “detects that the target amount has been achieved, followed by a short period of inactivity, it then performs a ‘tare’ and advances to the next recipe block.” *Id.* at 9:34–37. To account for a user’s inability to add a target amount of an ingredient “with double-digit accuracy,” the '217 patent discloses a “dead-band” with upper and lower thresholds above and below the target amount, respectively. *Id.* at 3:42–45,

10:24–43, Figs. 14, 15. According to the ’217 patent, “[a]s the measured amount enters the dead-band, the app indicates to the user to stop pouring.” *Id.* at 10:28–30.

C. Illustrative Claim

The Petition challenges claims 1, 5, 6, 9, 13, 14, 17, 21, and 22, all of which are independent. Claim 1 is illustrative of the challenged claims and is reproduced below with bracketed letters added to correspond with Petitioner’s identification of claim elements:¹

1. [A] A method for a computing device to assist a user in assembling a culinary combination according to a recipe, the recipe identifying one or more ingredients and one or more target amounts, each of the ingredients associated with one of the target amounts, the method comprising:

[B] the computing device receiving real-time data from a scale;

[C] the computing device determining a tared weight based on the real-time data, wherein the tared weight represents weight added to the scale since taring;

[D] the computing device selecting a first ingredient as an active ingredient, wherein the first ingredient is one of the one or more ingredients, then selecting a target amount for the first ingredient as the target amount for the active ingredient, and then taring the tared weight;

[E] the computing device determining a measured amount of the active ingredient based on the tared weight;

[F] the computing device causing an electronic display to display real-time progress of the measured amount of the active ingredient; and

¹ For clarity and consistency, we use Petitioner’s identification of claim elements for all challenged claims throughout this Decision.

[G] the computing device de-selecting the first ingredient as the active ingredient and selecting a second ingredient as the active ingredient if the computing device determines the measured amount of the active ingredient is more than a lower threshold and less than an upper threshold followed by a period of inactivity wherein the second ingredient is one of the one or more ingredients, wherein the lower threshold is lower than the target amount for the active ingredient, wherein the upper threshold is greater than the target amount for the active ingredient.

Ex. 1001, 11:63–12:27; Pet. 19–26.

Like claim 1, claims 5 and 6 are also method claims and recite claim elements [A]–[F] essentially identically to claim 1. *See* Pet. 8 (characterizing the challenged claims). Claims 9, 13, and 14 are system claims that essentially parallel claims 1, 5, and 6. *Id.* Claims 17, 21, and 22 are computer-readable medium claims and likewise parallel the method claims. *Id.*

Petitioner groups the challenged claims into three categories, referring to claims 1, 9, and 17 as the “dead-band advance” claims; claims 5, 13, and 21 as the “user-command advance” claims; and claims 6, 14, and 22 as the “scale-command advance” claims. Pet. 2, 11–13, 17. Dead-band advance is recited representatively in claim element 1[G], user-command advance is recited representatively in claim elements 5[G]–[I], and scale-command advance is recited representatively in claim element 6[G]. *Id.* at 42–43, 52–53, 55–56.

D. Petitioner’s Evidence

Petitioner’s asserted grounds of unpatentability expressly identify and rely upon the following references:

Reference		Exhibit
Bendel	DE 10 2008 008 712 A1, published August 27, 2009	1005 ²
Sartorius	Operating Manual, Sartorius Combics Pro Application Software, Batching	1006
Williams	GB 2 251 960 B, published September 28, 1994	1007
Mettler	Mettler Toledo IND780 Terminal User's Guide	1008
Digi-Star	Digi-Star, The "EZ" Electronic Scale Indicators—Operation, Installation, and Technical Manual	1009
Yuyama	US 2008/0135309 A1, published June 12, 2008	1010
Wright	GB 2 397 657 B, published July 28, 2004	1011
Turnage	"Kitchen Scale App Prototype," a video	1013 ³
Abrams	US 6,587,739 B1, issued July 1, 2003	1020
Bordin	US 9,572,361 B2, PCT filed June 21, 2012	1030

Petitioner also relies on additional references, namely Herwig (US 2012/0030003 A1, published Feb. 2, 2012, Ex. 1012) and Kemink (US 6,563,430, issued May 13, 2003, Ex. 1029). Pet. 5, 61. In addition, Petitioner relies on a Declaration of Harry G. Direen, Jr., Ph.D., P.E. Ex. 1004.

Petitioner contends that Sartorius (Ex. 1006) was published on Sartorius AG's web site at least as early as 2006. Pet. 3, 28. As support for

² Exhibit 1005 includes a German language document (pages 14–28), an English language translation (pages 1–13), and a translator's certificate of accuracy (page 28).

³ Petitioner submits screenshots from the Turnage video as Exhibit 1021.

this contention, Petitioner relies on a declaration from an employee of a subsidiary of Sartorius AG (Ex. 1022), an affidavit of Christopher Butler of the Internet Archive (Ex. 1024, 52–53), a declaration from Petitioner’s former counsel (Ex. 1032), and exhibits to each of these declarations. Pet. 28–29; *see also* Papers 14, 15 (Motion for Withdrawal and Substitution of Counsel for Petitioner and Order granting that motion).

Petitioner contends that Mettler (Ex. 1008) was published at least as early as 2010 (Pet. 4) and was publicly distributed via Mettler Toledo’s web page prior to March 12, 2012 (*id.* at 46). As support for these contentions, Petitioner relies on a declaration from an employee of Mettler-Toledo, LLC (Ex. 1023),⁴ the Butler Affidavit (Ex. 1024, 52–53), the declaration from Petitioner’s former counsel (Ex. 1032), and exhibits to each of these

⁴ Petitioner identifies “Exhibit 1023” as “Declaration of Rome Wallace (Mettler Toledo) and Exhibits 1–4 thereto” and “Exhibit 1024” as “Declaration of Rome Wallace, Exhibit 5 (Affidavit of Christopher Butler and exhibits thereto).” Pet. vii. The documents filed as Exhibits 1023 and 1024 do not, however, conform to these descriptions. Exhibit 1023 includes the Wallace declaration and Exhibits 1 and 2 and part of Exhibit 3 referenced therein. Exhibit 1024 includes the remainder of Wallace Exhibit 3 and Wallace Exhibit 5, the Affidavit of Christopher Butler and Exhibit A thereto, which contains archived HTML and PDF files. Wallace Exhibit 4 is missing. The pages of Exhibit 1024 are numbered from 1 to 501 and incorrectly marked with the legend, “Adaptics 1023.” Petitioner’s pinpoint citations to Exhibit 1024 are inaccurate, making it difficult, if not impossible, to locate the pages of the exhibit referenced in the Petition. For example, the Petition cites pages 1 and 34–165 of Exhibit 1024 as support for the assertion that Mettler (Ex. 1008) was published at least as early as 2010. Pet. 4. The cited pages include part of Wallace Exhibit 3, the Butler Affidavit, and part of Butler Exhibit A. Although it appears Petitioner intended to cite the Butler Affidavit and an archived PDF file corresponding to Mettler, the Petition fails to identify the correct pages of Exhibit 1024.

declarations. Pet. 4, 46. Petitioner additionally contends that prior to March 12, 2012, Mettler Toledo distributed a different document, the IND780 Terminal Technical Manual, which allegedly contained the same information as Mettler, i.e., the IND780 Terminal User's Guide. Pet. 46 (citing Ex. 1024, 15, 544).⁵

Petitioner contends that Digi-Star was published via the internet since at least 2009 and that copies were distributed with products sold between 1995 and 2004. Pet. 4, 44. As support for this contention, Petitioner relies on the Direen Declaration (Ex. 1004 ¶ 212), an e-mail to Petitioner's counsel responding to a subpoena (Ex. 1025), and the declaration from Petitioner's former counsel (Ex. 1032). Pet. 4, 44.

Petitioner contends that Turnage was presented at South by Southwest (SXSW) on March 9, 2012 and published on YouTube in April 2012. Pet. 3, 57. As support for these contentions, Petitioner relies on a Declaration of William Turnage (Ex. 1026) and a video of the SXSW presentation (Ex. 1031). *Id.* at 57.

E. Asserted Grounds of Unpatentability

Petitioner asserts each of the following grounds of unpatentability against all of the challenged claims:

Reference(s)	Statutory Basis
Bendel	35 U.S.C. § 102

⁵ The citation to Exhibit 1024 appears to be incorrect. It appears Petitioner intended to cite Exhibit 1023, pages 16 and 544, which are portions of the tables of contents for the IND780 Terminal Technical Manual and the IND780 Terminal User's Guide, respectively.

Reference(s)	Statutory Basis
Sartorius	35 U.S.C. § 102
Williams in view of Bendel, Sartorius, Mettler, Digi-Star, Yuyama, and/or Wright ⁶	35 U.S.C. § 103
Turnage in view of Bendel, Sartorius, Williams, Digi-Star, Yuyama, Mettler, and/or Wright	35 U.S.C. § 103
Bendel or Sartorius in view of Williams, Turnage, Abrams, or Bordin, and in further view of each other, Mettler, Digi-Star, Yuyama, and/or Wright ⁷	35 U.S.C. § 103

Pet. 19, 28, 36–37, 57, 62.

⁶ Sartorius is not included in the heading on page 36 of the Petition, but it is included in the discussion of the ground, e.g., at pages 37, 42–43, and 50–51 of the Petition.

⁷ Williams is not included in the heading on page 62 of the Petition, but it is included in the discussion of the ground at pages 62–63 of the Petition. Furthermore, in contrast to the heading on page 62 of the Petition, the discussion of the ground joins all of the references with the conjunction, “and/or.” Pet. 62. Still further, claim 9 is not listed in the heading on page 62 of the Petition, but the discussion of the ground states it is asserted against “the challenged claims” (Pet. 62), which includes claim 9. *See, e.g., id.* at 6 (listing challenged claims). The discrepancies between the headings and the text contribute to a lack of particularity of the asserted grounds, as discussed below.

II. DISCUSSION

A. *Overview of Petitioner's References*

1. *Bendel (Ex. 1005)*

Bendel discloses a device and method for providing guidance during cooking and baking. Ex. 1005, at (57), ¶ 6. The device includes a scale and a processor, along with a memory unit, input unit, and display. *Id.* A recipe may be selected from the memory, and the ingredients and operational steps needed for the recipe are displayed. *Id.* The ingredients are weighed and the operational steps worked through interactively via the program. *Id.*

2. *Sartorius (Ex. 1006)*

Sartorius is an operating manual that describes the operation of a batching application software package for use with a user display terminal. Ex. 1006, 1, 7, 9.⁸ The application functions with up to four weighing scales and can be used for producing batches according to recipes. *Id.* at 8, 40. Example recipes are food products, such as sugar bread and almond cake. *Id.* at 63. A related product brochure shows an automated manufacturing operation. Ex. 1022, 206–07.

3. *Williams (Ex. 1007)*

Williams discloses a “cooking apparatus comprising computer means adapted to have a recipe entered thereinto and having display means for displaying successive steps of the recipe, and one or more cooking devices, including a weighing machine, coupled to the computer.” Ex. 1007, 3,

⁸ We cite to Sartorius (Ex. 1006), Williams (Ex. 1010), Mettler (Ex. 1008), Digi-Star (Ex. 1009), and Wright (Ex. 1011) using the page numbers added by Petitioner.

Fig. 1. Williams describes how the weighing machine (scale), computer, and display can be used to assist a user in weighing ingredients called for by a recipe. *Id.* at 4.

4. *Mettler (Ex. 1008)*

Mettler is an operating manual for a user terminal for industrial weighing applications. Ex. 1008, 18. The operating manual describes the basic functionality of the user terminal, including tare, target comparison, bar graph mode, and over/under mode. *Id.* at 46, 48–52, 57–69. Mettler discloses an exemplary use of the target comparison function for controlling an automatic filling system, whereby the terminal could control a feeder system to fill a container to a desired target weight. *Id.* at 57.

5. *Digi-Star (Ex. 1009)*

Digi-Star is an operation, installation, and technical manual for a series of electronic scale indicators. Ex. 1009, 1, 6. The functionality described by the manual includes preloading a tare value, programming a new recipe, and using auto-advance and delay-time features. *Id.* at 3, 22, 29, 32, 33. The manual describes using the scale indicator to prepare animal feed recipes and weighing loads on the order of thousands of pounds. *Id.* at 25–28.

6. *Yuyama (Ex. 1010)*

Yuyama discloses a medicine weighing device for use in hospitals and dispensing pharmacies for weighing and inspecting prescription medicines in powder and liquid form. Ex. 1010 ¶ 1. The weighing device includes a scale, a touchscreen display, a processor, and a memory. *Id.* ¶¶ 76, 91, 92, 97, 98, Figs. 1, 2. Yuyama describes the operation of the weighing device,

including its use by dispensing staff to weigh out a prescribed dose of medicine. *Id.* ¶¶ 141, 142, Fig. 22.

7. *Wright (Ex. 1011)*

Wright discloses an electronic scale and a method of using the scale to prepare a food product according to a recipe. Ex. 1011, 5, 7–8, Figs. 1, 3. Wright discloses an example of the use of the electronic scale to allow a cook to select a recipe, display each step of the recipe, and display the weight of an ingredient as it is being measured. *Id.* at 10–12, Fig. 3.

8. *Turnage (Ex. 1013)*

Turnage is a ninety-second silent digital video showing a top-down view of a glass bowl sitting on a platform scale connected to a touchscreen tablet computer running a software application that receives data from the scale and displays user instructions. The initial instruction is: “Place an empty bowl on the scale.” The video shows a user hitting a touchscreen button labeled “Let’s Begin!” Thereafter, the user instruction changes to “Add flour to the bowl,” and a horizontal bar labeled “flour” appears on the screen. As flour is added to the bowl, a red bar moves across the horizontal bar, providing a visual representation of how much of a required amount of flour has been added. When the red bar reaches the end of the horizontal bar, the color changes to green, the user instruction changes to “Add water to the bowl,” and the horizontal bar label changes to “water.” As water is added to the bowl, a green bar moves across the horizontal bar to show the progress of the addition. When it reaches the end, the user instruction changes to: “Add a packet of yeast and a pinch of salt. Now start kneading.” Exs. 1013, 1021.

9. *Abrams (Ex. 1020)*

Abrams discloses a system of intelligent appliances coupled by common household power lines or wireless links. Ex. 1020, at (57). In relevant part, Abrams discloses using a Personal Digital Assistant (“PDA”) or telephone to communicate with a mixer appliance to execute a recipe. *Id.* at 5:41–55, 16:26–39. According to Abrams, the mixer can include weight measurement capability. *Id.* at 17:65–18:10.

10. *Bordin (Ex. 1030)*

Bordin discloses a cooking system for automating cooking steps of a recipe on a stove. Ex. 1030, at (57). In relevant part, Bordin discloses a cooking system that “interfaces with intelligent scales 52, with the ability to measure weight values, zero settings, ingredient type, etc., and to set weight set points.” *Id.* at 9:12–15. The system includes “Smart Device 56 (eg iPad, iPhone or similar device), hosting custom software for iCookit Controller control, recipe storage and upload, download etc.” *Id.* at 9:29–32.

B. *Parties’ Contentions*

Petitioner contends that the challenged claims are anticipated by each of Bendel and Sartorius. Pet. 19–36. In addition, Petitioner asserts three obviousness grounds against the challenged claims. *Id.* at 36–63.

Petitioner’s first obviousness ground relies on Williams as a primary reference. *Id.* at 36. Petitioner contends that Williams discloses elements [A]–[F] of claims 1, 5, and 6. *Id.* at 37–43, 52, 55. Petitioner contends that “Williams does not specifically disclose the deadband-advance, user-command, or scale-command limitations, but those limitations are obvious over Williams in view of Bendel, Sartorius, Mettler, Digi-Star, Yuyama, and Wright.” *Id.* at 37. Specifically, Petitioner contends that claim

element 1[G] is disclosed by Bendel, Sartorius, Mettler, Digi-Star, and Yuyama. *Id.* at 43–50. Petitioner contends that claim elements 5[G]–[I] are disclosed by Bendel, Sartorius, Digi-Star, Yuyama, and Wright. *Id.* at 52–54. Petitioner contends that claim element 6[G] is disclosed by Bendel, Sartorius, Digi-Star, Yuyama, and Wright. *Id.* at 55–56. Petitioner contends that a person of ordinary skill in the art (“POSITA”) would have been motivated to combine Williams with the other references. Pet. 50–52 (claim 1); *id.* at 54–55 (claim 5); *id.* at 56–57 (claim 6). Petitioner contends that claims 9, 13, 14, 17, 21, and 22 would have been obvious for the same reasons as claims 1, 5, and 6. *Id.* at 57.

Petitioner’s second obviousness ground relies on Turnage as a primary reference. Pet. 57. Petitioner contends that Turnage teaches at least elements [A]–[F] of claims 1, 5, and 6. *Id.* at 57–60. For claim elements 1[G], 5[G], and 6[G], Petitioner’s second obviousness ground relies on the same references and contentions as presented for the first obviousness ground. *Id.* at 60. Petitioner contends that a POSITA would have been motivated to combine those references with the app taught by Turnage, relying on the same reasons as presented for the first obviousness ground. *Id.* at 60–61.

Petitioner’s third obviousness ground is a “catch-all” ground. Petitioner contends that “[i]f Bendel and Sartorius are not anticipatory, the challenged claims are obvious over these references in combination with each other, Williams, Turnage, Abrams, Bordin, Mettler, Digi-Star, Yuyama, and/or Wright.” Pet. 62. According to Petitioner, “[t]hese combinations were obvious for, and would have been motivated by, the

same basic reasons outlined above for Williams and Turnage with each of these secondary references.” *Id.*

In response, Patent Owner argues that several factors favor denial of institution pursuant to the Board’s discretionary authority under 35 U.S.C. § 314(a). Prelim. Resp. 7. Patent Owner criticizes Petitioner’s use of the conjunction “and/or” to combine references in the asserted grounds of unpatentability and Dr. Direen’s reliance on references not included in the grounds of unpatentability asserted in the Petition. *Id.* at 7–8, 10. Patent Owner relies on these defects to argue that the Petition fails to state the precise grounds of unpatentability. *Id.* at 7. According to Patent Owner, Petitioner’s use of “and/or” results in thousands (if not millions) of obviousness combinations. *Id.* at 10–13. Patent Owner argues that even if the order of references is disregarded, there are still hundreds of combinations, making it “virtually impossible for [Patent Owner] to present a reasoned response . . . in 14,000 words.” *Id.* at 13. Patent Owner characterizes Petitioner’s third obviousness ground as a “‘kitchen sink’ ground” that “is substantially devoid of an explanation why so many references need to be combined to reach the claims.” *Id.* at 14.

C. Analysis

A petition for *inter partes* review (“IPR”) must identify “with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also* 37 C.F.R. § 42.104(b) (specifying necessary elements of a petition).

As the Federal Circuit has explained, “[i]n an IPR, the petitioner has the burden from the onset to show with particularity why the patent it

challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (emphasis added) (citing 35 U.S.C. § 312(a)(3)); *see also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” (quoting 35 U.S.C. § 312(a)(3))).

Consistent with the statute and case law, our *Trial Practice Guide* advises that petitioners should “avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012).

Under 35 U.S.C. § 314(a), an IPR can be instituted only if there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314(a). Under § 314, the Board is required to make “a binary choice—either institute review or don’t.” *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018); *see also Guidance on the Impact of SAS on AIA Trial Proceedings* (April 26, 2018)⁹ (explaining that “the PTAB will institute as to all claims or none” and “if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition”).

⁹ Available at: <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

Even when a petitioner demonstrates a reasonable likelihood as to at least one claim, however, institution of an IPR remains discretionary. *SAS*, 138 S. Ct. at 1355 (“§ 314(a) invests the Director with discretion on the question *whether* to institute review”); *Harmonic*, 815 F.3d at 1367 (“First of all, the PTO is permitted, but never compelled, to institute an IPR proceeding.” (citing 35 U.S.C. § 314(a))). As explained in our *Trial Practice Guide Update*, “[t]he Director’s discretion is informed by 35 U.S.C. §§ 316(b) and 326(b), which require the Director to ‘consider the effect of any such regulation [under this section] on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.’” *Trial Practice Guide Update*,¹⁰ at 9; *see also* Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39,989 (Aug. 13, 2018) (discussing and providing link to *Trial Practice Guide Update*).

The statutory requirement for particularity in a petition for IPR takes on heightened importance when considered in conjunction with *SAS*’s “all-or-nothing” approach. Because the Board’s practice, in light of *SAS*, is to institute on all grounds asserted in a petition, the Board may consider whether a lack of particularity as to one or more of the asserted grounds justifies denial of an entire petition. For example, where a petition contains voluminous or excessive grounds, Office guidance indicates “[t]he panel will evaluate the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system (*see* 35 USC § 316(b)), the entire petition should be denied under 35 USC

¹⁰ Available at: <https://go.usa.gov/xU7GP>.

§ 314(a).” *SAS Q&As* (June 5, 2018) (“*SAS Q&As*”),¹¹ at Part D, Effect of *SAS* on future challenges that could be denied for statutory reasons, Question D2.

In this case, we agree with Patent Owner that the Petition suffers from a lack of particularity that results in voluminous and excessive grounds. Petitioner’s third obviousness ground—the “catch-all” ground—is the worst offender. There, Petitioner contends that “[i]f Bendel and Sartorius are not anticipatory, the challenged claims are obvious over these references in combination with each other, Williams, Turnage, Abrams, Bordin, Mettler, Digi-Star, Yuyama, and/or Wright.” Pet. 62.¹² We agree with Patent Owner that Petitioner’s reliance on up to ten references connected by the conjunction “and/or”¹³ results in a multiplicity of grounds, none of which is presented with sufficient particularity.¹⁴ Even if we were to disregard the

¹¹ Available at:
https://www.uspto.gov/sites/default/files/documents/sas_qas_20180605.pdf.

¹² As discussed above, the statement of the ground in the text of the Petition at page 62 differs from the statement of the ground in the heading on the same page. *See* page 9 n.7, *supra*. The discrepancies further contribute to a lack of particularity of the asserted ground.

¹³ Wikipedia explains: “And/or . . . is a grammatical conjunction used to indicate that one or more of the cases it connects may occur. For example, the sentence ‘He will eat cake, pie, and/or brownies’ indicates that although the person may eat any of the three listed desserts, the choices are not mutually exclusive; the person may eat one, two, or all three of the choices.” It has been criticized as “[a] device, or shortcut, that damages a sentence and often leads to confusion or ambiguity.” William Strunk, Jr. and E. B. White, *Elements of Style* (Macmillan 2d ed. 1972), 35.

¹⁴ Patent Owner directs us to Office guidance regarding *inter partes* reexaminations that warned requestors, “Do not lump together multiple rejections by using ‘and/or.’” Prelim. Resp. 9; Ex. 2011, 3 (Best Practices

order of references and consider only the two-reference combinations encompassed by Petitioner's asserted ground, Petitioner's contention encompasses nine combinations with Bendel and another eight distinct combinations with Sartorius, for a total of seventeen possible combinations. Even that conservative interpretation of Petitioner's contention yields an unduly burdensome number of combinations. Petitioner's use of "and/or," however, expands the ground to include combinations of three, four, or more references, yielding hundreds of possible combinations. *See* Prelim. Resp. 12; PO Surreply 1.

Petitioner argues that the grounds asserted in the Petition are "limited and distinct" and provides the following explanation as support:

Petitioner is requesting the Board to review nine effectively identical claims which differ only in their final 'trigger' element. The Petition asserts two grounds of anticipation and three grounds of obviousness. Each obviousness ground maps the primary reference alone to each of the identical limitations. Each secondary reference individually and separately discloses the final 'trigger' element. The obviousness grounds are indexed with consolidated secondary references Evaluating a small set of secondary references against a single element does not amount to the hyperbolic "statistical nightmare" asserted by Patent Owner.

Pet. Reply 3.

Petitioner's argument is not an accurate characterization of Petitioner's third obviousness ground for two reasons. First, Petitioner's "catch-all" ground does not "map[] the primary reference alone to each of the identical limitations," as asserted by Petitioner. Pet. Reply 3. Instead, it

and FAQs for Filing Requests for Reexamination Compliant with 37 CFR 1.510 and 1.915).

assumes that one or more claim limitations is *not* disclosed by the primary references. Indeed, the Petition asserts, “*If Bendel and Sartorius are not anticipatory, [then] the challenged claims are obvious*” Pet. 62 (emphasis added). Critically, however, the Petition fails to specify what Petitioner regards as the difference(s) between Bendel or Sartorius and the challenged claims. *See Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (requiring that the differences between the prior art and the claims at issue be ascertained as part of an obviousness analysis). Instead, Petitioner provides three “example” limitations that Bendel or Sartorius may be deemed not to disclose. Pet. 62–63. Petitioner does not, however, state that these limitations are missing from Bendel or Sartorius, nor limit its third obviousness ground to these exemplary limitations.

Second, contrary to Petitioner’s argument, Petitioner’s third obviousness ground does not rely on a small set of secondary references to teach “the final ‘trigger’ element.” Pet. Reply 3. Two out of Petitioner’s three “example” obviousness contentions provided in its discussion of this asserted ground do not relate to “the final ‘trigger’ element.” Pet. 62–63 (addressing “computing device” and “scale” limitations). Petitioner’s third example pertains to the “period of inactivity” limitation, which is part of the “trigger” element of claim 1, but Petitioner does not assert that this limitation is taught by any of the secondary references. *Id.* at 62. Accordingly, Petitioner’s third obviousness ground does not require merely “[e]valuating a small set of secondary references against a single element,” as argued by Petitioner. Pet. Reply 3.

Petitioner’s “catch-all” ground attempts to require Patent Owner to address whether each and every claim limitation is taught not only by each

of Bendel and Sartorius, but by each of these references in combination with one or more of the other references asserted in the proceeding. In this way, Petitioner’s “catch-all” ground is not reasonably bounded in scope and unduly burdensome for both Patent Owner and the Board to address.

The lack of particularity is not limited to Petitioner’s “catch-all” ground. Petitioner’s first and second obviousness grounds also suffer from a lack of particularity that results in voluminous and excessive grounds. For both of these grounds, Petitioner’s reliance on a large number of secondary references connected by “and/or” results in a multiplicity of grounds for the same reasons discussed above.¹⁵ Furthermore, as noted by Patent Owner (Prelim. Resp. 11), Petitioner relies on the Direen Declaration, which adds four more references (Abrams, Bordin, Kemink, and Herwig) to Petitioner’s second obviousness ground. Pet. 60–61 (citing Ex. 1004 ¶¶ 247–63); Ex. 1004, p. 103 (heading XI) & ¶¶ 247, 256–259, 261–263 (relying on Abrams, Bordin, Kemink, and Herwig to teach claim element 1[F] and discussing motivation to combine these references with Turnage).

Petitioner asserts that the nine challenged claims are “effectively identical” and “differ only in their final ‘trigger’ element.” Pet Reply 3. Yet Petitioner fails to explain why it needs to assert so many grounds and references to show unpatentability of such a limited number of “essentially identical” claims. The number of asserted grounds and references is

¹⁵ Petitioner’s first obviousness ground relies on six secondary references (Bendel, Sartorius, Mettler, Digi-Star, Yuyama, and/or Wright) and its second obviousness ground relies on seven secondary references (Bendel, Sartorius, Williams, Digi-Star, Yuyama, Mettler, and/or Wright). Pet. 37, 57.

disproportionately large when compared with the number of distinct challenged claims, which indicates that the Petition imposes an undue burden on Patent Owner and the Board.

The asserted grounds of unpatentability also suffer from a lack of particularity and indefinite scope due to Petitioner's and Dr. Direen's reliance on *additional* documents relating to Sartorius, Mettler, and Turnage. *See* Prelim. Resp. 36–38 (asserting that Direen Declaration goes beyond the “four corners” of the references). The declarations in support of these references include voluminous additional exhibits containing substantive disclosures relating to the subject matter of the challenged patent claims. Ex. 1022, 112–213 (Sartorius operating manual, patents, and product brochure); Ex. 1023, 6–529, 648–851 (Mettler Toledo manuals); Ex. 1024, 1–50, 55–82, 212–501 (Mettler manual and archived HTML and PDF files from Mettler and Sartorius); Ex. 1026, 13–14, 17–19 (video of SXSW presentation and source code excerpt). Petitioner and Dr. Direen rely on at least some of these documents to show the relevance of the references or the presence of claim elements in the prior art. Pet. 46 (asserting that Mettler's “related marketing brochures teach[] use of the IND780 in the food industry,” citing Ex. 1024, 12, 19, 24, 30, 85, 166); *id.* at 51 (asserting that weigh systems are marketed simultaneously to both food and pharmaceutical industries, citing Ex. 1024, 166); Ex. 1004 ¶¶ 142, 143, 145, 153 (relying on Mettler and Sartorius patents, Sartorius web page, and Turnage source code). The extent to which these additional documents may be relied upon to fill gaps in the asserted references with respect to the claimed subject matter increases our concern that the Petition lacks the required particularity, and, instead, turns the Petition into an empty invitation for the Board and Patent

Owner to search the record for evidence that might support the full breadth of Petitioner's contentions.

The lack of particularity and volume of issues raised by the Petition is further aggravated by Petitioner's contentions seeking to establish Sartorius, Mettler, Digi-Star, and Turnage as prior art printed publications. As discussed above, Petitioner relies on the testimony of third-party fact witnesses to support its assertions that Sartorius, Mettler, and Turnage were published before the effective filing date of the challenged patent. Pet. 3–4, 28–29, 46, 57; Ex. 1022, 1–3; Ex. 1023, 1–4; Ex. 1024, 52–53; Ex. 1026, 1–6; Ex. 1032, 1–3. In the case of Digi-Star, Petitioner relies on factual assertions in an e-mail from a third party. Pet. 4, 44; Ex. 1025. Although Petitioner asserts that each of these references was published before the effective filing date of the challenged patent, the Petition presents virtually no analysis of how or why the references were publicly accessible. Pet. 28–29 (Sartorius); *id.* at 44 (Digi-Star); *id.* at 46 (Mettler); *id.* at 57 (Turnage). For example, Petitioner addresses neither whether the references were meaningfully indexed and could be located by a POSITA using a reasonably diligent search, nor whether they were widely disseminated to persons of ordinary skill in the art. *See, e.g., Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 774 (Fed. Cir. 2018) (test for public accessibility is whether reference was “meaningfully indexed such that an interested artisan exercising reasonable diligence would have found it”); *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1356–60 (Fed. Cir. 2018) (reviewing cases and identifying factors relevant to determining whether a reference was publicly accessible due to dissemination). *See* Prelim. Resp. 51–52 (arguing that copies of Turnage were not distributed to

attendees of SXSX presentation and there is no significant indexing that would lead a POSITA to the video).

Considering the totality of the issues addressed above, we determine that the Petition fails to meet the particularity requirement of 35 U.S.C. § 312(a)(3) and that the lack of particularity results in voluminous and excessive grounds. We further determine that, in the interests of efficient administration of the Office and integrity of the patent system and as a matter of procedural fairness to Patent Owner, the entire petition should be denied under 35 USC § 314(a). *See* 35 U.S.C. § 316(b); *see also* SAS Q&As, question D2.

III. CONCLUSION

We exercise our discretion under 35 U.S.C. § 314(a) to deny review.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied*, and no *inter partes* review is instituted.

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