

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUANGDONG XINBAO ELECTRICAL APPLIANCES
HOLDINGS CO., LTD.,
Petitioner,

v.

ADRIAN RIVERA,
Patent Owner.

Case IPR2014-00042
Patent 8,291,812 B2

Before FRANCISCO C. PRATS, JOSIAH C. COCKS, and
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Petitioner Guangdong Xinbao Electrical Appliances Holdings Co., Ltd. (“Petitioner”) filed a corrected Petition (Paper 4, “Pet.”) to institute an *inter partes* review of claims 1, 2, 4–10, 14–17, and 19–23 of U.S. Patent No. 8,291,812 B2 (Ex. 1001, “the ’812 patent”). 35 U.S.C. § 311. Patent Owner Adrian Rivera (“Patent Owner”) did not file a Preliminary Response. We determined that the information presented in the Petition demonstrated that there was a reasonable likelihood that Petitioner would prevail in challenging claim 23, but not claims 1, 2, 4–10, 14–17, and 19–22, of the ’812 patent, as unpatentable. Paper 8 (“Dec. to Inst.”), 2, 6–7, 20–21. Pursuant to 35 U.S.C. § 314, we instituted this proceeding on February 19, 2014, to review whether claim 23 is unpatentable on the ground that Zhao¹ anticipates claim 23 under 35 U.S.C. § 102. Dec. to Inst. 20–21.

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 20, “PO Resp.”), as well as a Motion to Amend (Paper 21, “Motion”). Petitioner subsequently filed a Reply to the Response (Paper 27, “Reply”) and an Opposition to Patent Owner’s Motion to Amend (Paper 26, “Opp.”). Patent Owner then filed a Reply in support of its Motion to Amend (Paper 35, “Reply to Opp.”).

In addition, Patent Owner filed a Motion to Exclude seeking to exclude a Declaration by Dr. Alexander Slocum (Ex. 1021), which Petitioner relied upon in its Reply to the Response. Paper 32 (“Mot. to Exclude”). Petitioner filed an Opposition to Patent Owner’s Motion to Exclude. Paper 41. Patent Owner filed a Reply to Petitioner’s Opposition. Paper 42.

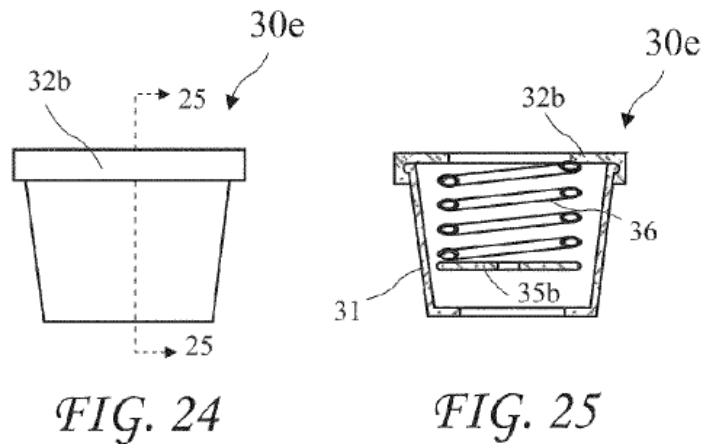
¹ Zhao, CN Patent Appl. No. ZL 200520143365.6, published Dec. 27, 2006 (“Zhao”) (Ex. 1003) (English translation Ex. 1004).

An oral hearing was held on October 29, 2014. A transcript of the hearing has been entered into the record. Paper 49 (“Tr.”).

We have statutory authority under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). Petitioner has shown by a preponderance of the evidence that claim 23 of the ’812 patent is unpatentable. We deny Patent Owner’s Motion to Amend, as well as Patent Owner’s Motion to Exclude.

B. The ’812 Patent (Ex. 1001)

The ’812 patent relates to a coffee holder that self-tamps loose coffee grounds into a compacted state, e.g., for use in a coffee maker. Ex. 1001, 1:34–56. The coffee holder comprises a holder base, a holder lid, a tamper, and a filter. *Id.* at 1:36–55. Embodiments of the coffee holder are shown in Figures 24–26C, reproduced below.



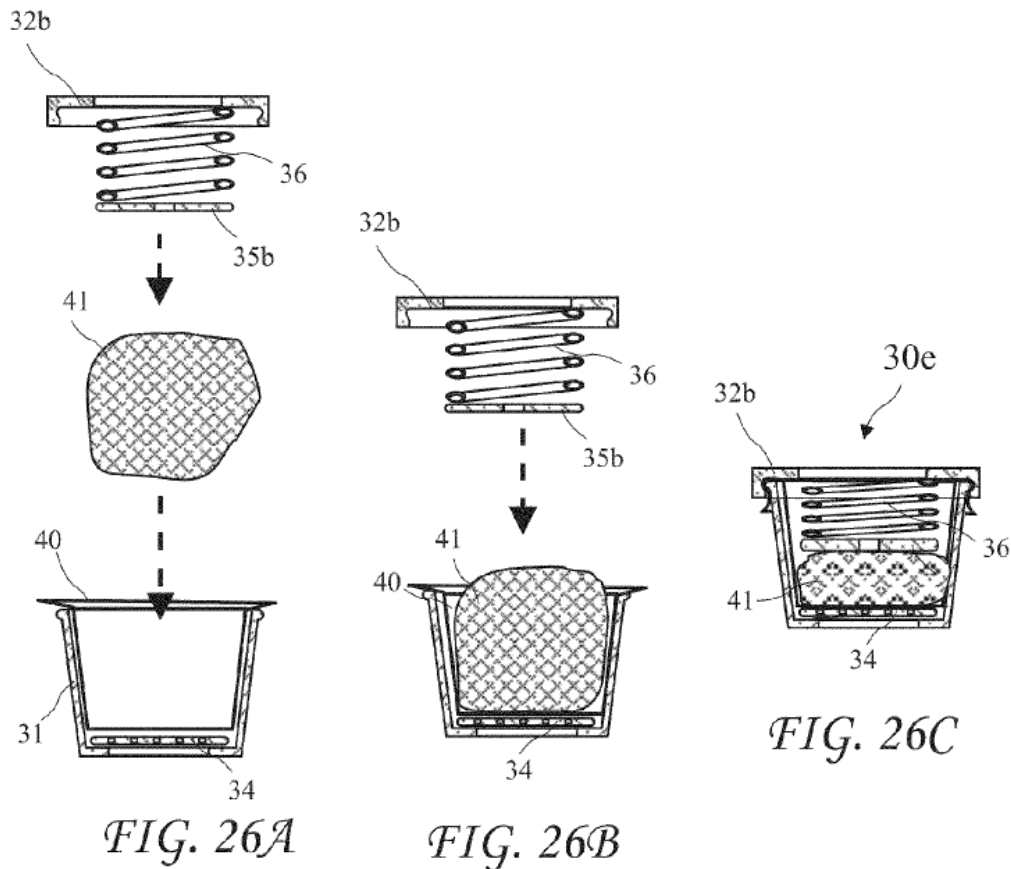


Figure 24 shows a side view of a coffee holder, and Figures 25–26C show different cross-sectional views of the same coffee holder, taken along line 25–25 in Figure 24. *Id.* at 4:17–39. The Figures depict coffee holder 30e, holder base 31, holder lid 32b, top tamper 35b, tamping spring 36, coffee 41, bottom tamper 34, and filter paper cup 40. The coffee holder may be placed inside a coffee maker, as depicted in Figure 2 (not shown).

Cup 40 may be made from “filter paper, nylon mesh, steel mesh, or any material suitable for filtration.” *Id.* at 9:41–43. In certain embodiments, “filter paper cup 40 includes a bottom 40b, sides 40a, and a rim 40c,” and “rim 40c rests on a top edge of the holder body 31 and is held between the holder cap [lid] and body when the cap is placed on the body.” *Id.* at 9:28–34.

C. Challenged Claim

Challenged claim 23 is independent, and is reproduced below.

23. A removable self tamping coffee holder comprising:

a coffee holder base having an open top configured for receiving a portion of untamped coffee

a holder lid attachable to close the open top of the coffee holder base to form an assembled coffee holder after receiving the untamped coffee in the coffee holder base, wherein the attached holder lid is configured to retain the coffee in the coffee holder base and to allow entry of liquid into the coffee holder through the holder lid;

the assembled coffee holder engagable with a coffee maker to make a serving of coffee *and the assembled coffee holder dis-engagable from the coffee maker* after each time the serving of coffee is prepared;

the holder lid detachable from the coffee holder base each time after making the serving of coffee allowing disposal of used coffee grounds and re-use of the coffee holder; and

a tamper residing in the coffee holder, the tamper tamping the untamped coffee inside the coffee holder in both conditions comprising:

whenever the holder lid is attached to the holder base and the coffee holder is not engaged with the coffee maker; and

whenever the holder lid is attached to the holder base and the coffee holder is engaged with the coffee maker.

Id. at 20:32–56 (emphases added).

II. ANALYSIS

For the challenged claim, Petitioner must prove unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). We begin our analysis with claim construction.

A. Claim Construction

We construe claims in an unexpired patent by applying the broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.100(b). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). On the other hand, a “claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer” and clearly set forth a definition of the claim term in the specification. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

1. “Tamper”

Petitioner contends that “tamper” means “any device capable of tamping or compressing coffee in a coffee holder.” Pet. 13. Petitioner points us to tamper 34 in Figure 4 of the Specification of the ’812 patent as “actively tamping coffee from the bottom of coffee holder 30a using spring 36,” as well as Figure 10 showing bottom tamper 34 and top tamper 35b, “in which top tamper 35b actively tamps coffee and bottom tamper 34 passively tamps coffee.” *Id.* at 13–14.

Patent Owner similarly contends that “tamper” means “a device that is used to distribute and compress ground coffee.” PO Resp. 10–11. Patent Owner further contends, however, relying on a Declaration by its expert, Mr. Paul Phillips, that Petitioner’s proposed construction of the term “reflects that tamping coffee does not mean pressing the coffee so that it does not float in water, but means that the tamper compresses the coffee.” *Id.* at 10 (citing Ex. 2001 ¶ 27 (Phillips Declaration)). Patent Owner refers to a reference entitled “*Coffee: A Guide to Buying, Brewing, and Enjoying*” by Kenneth Davids, which, according to Mr. Phillips, defines “tamper” as “[i]n espresso brewing, the small, pestlelike device

with a round, flat end used to distribute and compress the ground coffee inside the filter basket.” PO Resp. 10–11 (citing Ex. 2001 ¶ 28).

According to Patent Owner, “[u]sing a separation net,” such as the one described in Zhao (discussed below), “to prevent coffee powder from floating is not tamping coffee,” but rather “[t]amping involves the compression of coffee, not constraining it so that it does not float.” PO Resp. 11 (citing Ex. 2001 ¶ 29). In addition, Patent Owner contends that “in tamping, the compression of the coffee takes place before water is applied to the coffee.” *Id.*

The Specification of the ’812 patent does not define “tamper” per se, but depicts a number of embodiments with a tamper, such as top tamper 35b and bottom tamper 34, as shown in Figures 10, 26A–C, and 41–43. Both parties agree that “tamper” in claim 23 refers to something that compresses coffee, consistent with descriptions and depictions of tampers in the Specification. A dictionary definition provided by Petitioner for the word “compress,” i.e., to “press or squeeze together,” is reasonable and consistent with use of the term “tamper” in the Specification. Reply 3.

We interpret “tamper” to refer to an element that compresses, i.e., presses or squeezes together, coffee inside the claimed coffee holder. Neither claim 23 nor the Specification of the ’812 patent, however, limits “tamper” to one that compresses coffee before water is applied to the coffee. For example, claim 23 recites that the tamper tamps coffee inside the coffee holder, regardless of whether the holder is engaged with a coffee maker or not. We construe “tamper,” as recited in claim 23, as being capable of compressing coffee, regardless of whether it occurs before or after liquid, such as water, is added to the coffee holder through the holder lid.

2. “Engagable” or “dis-engagable” “with a coffee maker”

Patent Owner contends that a “standard dictionary definition of engage in the context of engineering is to interlock.” PO Resp. 13. Thus, according to Patent Owner, an ordinary artisan reading the ’812 patent “would understand ‘engage’ to involve some sort of interaction or interlocking between the coffee maker and the coffee holder.” *Id.* (citing Ex. 1001, 8:41–50; Ex. 2001 ¶ 31). Patent Owner further contends that “[p]lacing a strainer over a carafe does not constitute engaging and disengaging a coffee holder with a coffee maker,” because “sitting a strainer on top of a coffee cup does not provide an interlocking or interaction” between a coffee maker and a coffee holder. PO Resp. 15–16 (citing Ex. 2001 ¶ 34).

Petitioner responds that the plain meaning of the term “coffee maker” is a “device that makes coffee.” Reply 10 (citing Ex. 1016, 48:12–49:15). Petitioner also contends that “engagable” in claim 23 means “*capable of* interlocking or interacting, not already ‘engaged.’” Reply 12. Petitioner contends that this construction is consistent with the use of the term “engagable” in claim 23, as well as descriptions in the Specification of the ’812 patent. *Id.* at 12–13 (citing Ex. 1001, 9:44–55; Fig. 2). Petitioner also points out that by “Patent Owner’s own definition, engage means to ‘interact *or* interlock.’” Reply 13. According to Petitioner, a coffee holder “engagable with a coffee maker” encompasses a coffee holder that is “*capable of* some sort of interaction with any coffee maker.” *Id.* at 14.

We conclude that the ordinary meaning of the term “coffee maker” refers to something that makes coffee. Nothing in the Specification nor any other evidence of record, such as a dictionary definition, directs us to a more narrow construction. *See, e.g.*, Ex. 1001, 8:24–40 (stating “coffee maker 10 provides a flow of hot water

through coffee grounds to produce a coffee drink,” in relation to a “best mode” embodiment, as depicted in Figures 1A–C). We also conclude that “coffee holder engagable with a coffee maker” refers to a coffee holder that is capable of engaging with a coffee maker.

We further construe “engagable” to mean that the coffee holder is capable of interacting or interlocking with the coffee maker, in agreement with contentions of both parties, and consistent with the Specification at issue. Thus, a coffee holder interacting with a coffee maker is not limited to one that “interlocks” with a coffee maker. A coffee holder is “engagable” with a coffee maker even if the holder is capable of being placed on top of, or within, a portion of the coffee maker, as long as that placement allows the holder and coffee maker to work and interact together. This construction is consistent with descriptions in the Specification. *See, e.g.*, Ex. 1001, 1:52–55 (stating “[a]fter tamping, the coffee holder is places [sic] into a suitable coffee maker”), 2:7–9 (stating that “FIG. 2 is a side view of the coffee maker with an open lid allowing placement of a coffee holder according to the present invention inside the coffee maker”), 8:41–44.

3. *Other Claim Terms*

Petitioner offers construction of the claim phrases “coffee holder,” “coffee holder base,” and “holder lid.” Pet. 12–13. Petitioner contends that “coffee holder” refers to an element that “provides an inside volume to contain or hold coffee.” *Id.* (citing Ex. 1001, 9:2–4 (stating that a “volume (or coffee holder interior) 38 is provided inside the coffee holder 30a to receive loose coffee 41”)). Petitioner also contends that “coffee holder base” refers to “the body” of the coffee holder, and “coffee holder lid” means “a cap attachable to the body.” Pet. 12–13. Patent Owner does not propose alternative claim constructions for those phrases in its Patent Owner Response. We conclude that Petitioner’s constructions of the

phrases correspond to the broadest reasonable interpretations in light of the Specification. *See, e.g.*, Ex. 1001, 11:40–63 (describing, as shown in Figures 24–26C (reproduced above), that coffee holder 30e comprises holder base 31 and holder lid 32b), 1:36–37 (stating that a “coffee holder includes a holder base and a holder cap,” and coffee “is loosely deposited in the coffee holder and the holder cap is attached to the holder base”).

B. Anticipation by Zhao

Petitioner contends that Zhao anticipates claim 23 of the ’812 patent. Pet. 3, 16–21.

1. Zhao (Ex. 1003) (English translation Ex. 1004)

Zhao describes a “strainer” for making thick coffee. Ex. 1004, 3. Zhao presents Figure 1, reproduced below.

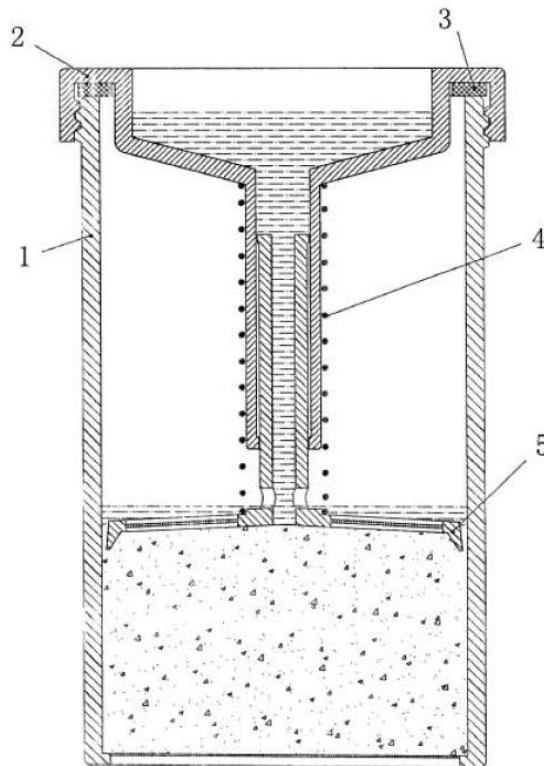


Figure 1

Figure 1 depicts a longitudinal section of a coffee strainer comprising strainer body 1, funnel 2, separation net 5, seal ring 3, and spring 4. Ex. 1003, 2; Ex. 1004, 3–4. As stated in Zhao, strainer body 1 “is cylinder-shaped, with a lot of fine meshes in the bottom and with threads in the head.” Ex. 1004, 3. “One end of the spring (4) is pushed below the funnel (2) and the other end is pushed above the separation net (5).” *Id.* at 4.

During use, “coffee powder is loaded into the strainer body,” and “water added from the funnel (2) flows through the funnel (2) to above the separation net (5).” *Id.* Thereafter, “[u]nder the action of the spring (4), the separation net (5) presses the coffee powder to the bottom of the strainer body (1) automatically to prevent the coffee powder from floating.” *Id.* Water (i.e., coffee) flows through meshes at the bottom strainer body 1, after passing through the coffee powder. *Id.*

2. Analysis

Petitioner contends that Zhao discloses each and every element of claim 23, referring to Figure 1 and other disclosures in the reference, as well as a claim chart in the Petition. Pet. 16–21. For example, Petitioner points to disclosure in Zhao as corresponding to certain elements in claim 23 as follows:

Element in claim 23	Disclosure in Zhao
“a coffee holder base having an open top”	Strainer body 1
“a holder lid attachable to close the open top of the coffee holder base,” where the lid is “configured to retain the coffee in the coffee holder base and to allow entry of liquid into the coffee holder through the holder lid” and is “detachable from the coffee holder base”	Funnel 2
“a tamper residing in the coffee holder”	Separation net 5

Pet. 18–20.

Petitioner further contends that Zhao describes other elements recited in claim 23, such as the assembled coffee holder being engagable or dis-engagable with a coffee maker after each use, and the tamper tamping coffee “whenever the holder lid is attached to the holder base,” whether the coffee holder is engaged or not with a coffee maker. *Id.* at 19–21. In support, for example, Petitioner points us to where Zhao describes that its coffee strainer “is mainly used in combination with common dripolator or coffee cup, and can also be used independently.” *Id.* (citing Ex. 1004, 3). Petitioner also contends that because Zhao’s “strainer can be used independently, separation net (5) can tamp ground coffee whenever funnel (2) is attached, regardless of whether the strainer is engaged with any coffee maker.” Pet. 20 (citing Ex. 1004, 3, 4).

Patent Owner does not dispute that Zhao describes most elements of claim 23. Patent Owner contends, however, that “first, the strainer in Zhao does not constitute a self-tamping coffee holder, and two, the strainer does not engage and dis-engage from a coffee maker.” PO Resp. 10.

In relation to its position that Zhao’s strainer is not a self-tamping coffee holder, Patent Owner argues that the recited “tamper” must be capable of distributing and compressing coffee, not just pressing coffee so that it does not float in water. *Id.* According to Patent Owner, in Zhao, “separation net (5) even with the spring (4) is designed to press coffee powder so that it does not float on the water that’s poured into the strainer.” *Id.* at 11 (citing Ex. 2001 ¶ 29). Patent Owner contends that, in Zhao, coffee powder is placed in the strainer and when water is poured in, it disperses the coffee powder. *Id.* at 12. According to Patent Owner, separation net (5) prevents coffee powder “simply from floating above the water as the water initially fills in the strainer,” but Zhao “does not describe that the separation net compresses coffee grounds.” *Id.* Thus, Patent Owner contends

that spring 4 and separation net 5 do not correspond to a “tamper” as recited in claim 23. *Id.* at 13 (citing Ex. 2001 ¶ 30).

As discussed above, we interpret “tamper” in claim 23 to refer to an element that compresses, i.e., presses or squeezes together, coffee inside the claimed coffee holder. We further construe “tamper” as being capable of compressing coffee, regardless of whether it occurs before or after one adds water to the coffee holder through the holder lid. We are not persuaded by Patent Owner’s position that Zhao’s separation net (5) merely prevents coffee from floating above the water as the water fills the strainer. While Zhao describes that the separation net prevents coffee powder from floating (Ex. 1004, 3), it also expressly describes, and shows in Figure 1, that separation net (5) presses or squeezes together, i.e., compresses, coffee inside the strainer. Ex. 1004, 3 (stating that “[u]nder the action of the spring, the separation net presses the coffee powder to the bottom of the strainer body automatically”). Thus, Zhao describes a “tamper” as recited in claim 23.

Patent Owner also contends that Zhao does not anticipate claim 23 because Zhao’s strainer does not engage and dis-engage from a coffee maker. PO Resp. 10, 13–16. Patent Owner acknowledges that Zhao describes that its strainer “is mainly used in combination with common dripolator or coffee cup” (Ex. 1004, 3), but argues that an ordinary artisan would have understood that description as “referring to a brewing method of manual pour-over filter brewing, where a filter holding ground coffee is contained by a holder suitable for exposure to high temperature water.” PO Resp. 14 (citing Ex. 2001 ¶ 32). According to Patent Owner, because Zhao’s description refers to a manual, pour-over, filter-drip method, an ordinary artisan would have understood Zhao’s use of its strainer with a dripolator to refer to placing that strainer over a carafe or cup. PO Resp. 15. Patent Owner contends

that “[p]lacing a strainer over a carafe does not constitute engaging and disengaging a coffee holder with a coffee maker.” *Id.*

As discussed above, we construe “coffee maker” in claim 23 to refer to something that makes coffee. We also conclude that “coffee holder engagable with a coffee maker” refers to a coffee holder that is capable of engaging with a coffee maker. We construe “engagable” to mean that the coffee holder is capable of interacting or interlocking with the coffee maker. A coffee holder is “engagable” with a coffee maker even if the holder is capable of being placed on top of, or within, a portion of the coffee maker, as long as that placement allows the holder and coffee maker to work and interact together.

Evidence of record in this proceeding sufficiently establishes that a “common dripolator,” as described in Zhao, is a coffee maker. *See, e.g.*, Ex. 1016, 48:12–49:15 (testimony of Patent Owner’s expert, Mr. Phillips, stating that dripolator refers to “drip-type coffee makers”). Claim 23 requires that the recited coffee holder be “engagable” and “dis-engagable” with a coffee maker, and that the tamper is capable of tamping coffee inside the coffee holder when the coffee holder is engaged or not engaged with the coffee maker. Zhao discloses those elements where it describes that its strainer includes spring (4), which pushes separation net (5) to press coffee, and that the strainer can be used in combination with a dripolator or it can be used independently. Ex. 1004, 3–4.

Even assuming one simply places the strainer on top of, or within, a portion of a dripolator coffee maker, the terms “engagable” or “engaged” in claim 23 do not require anything more, as long as the strainer and dripolator work together. When describing the use of its strainer “in combination with [a] common dripolator,” Zhao describes a strainer that works together with a common dripolator, i.e., a coffee maker. Ex. 1004, 3. Thus, the strainer is capable of

engaging and disengaging from the coffee maker, and functioning, including tamping coffee, when engaged or not engaged with that coffee maker.

For the foregoing reasons, we find that Petitioner has demonstrated by a preponderance of the evidence that Zhao anticipates claim 23.

C. Patent Owner's Motion to Amend

Patent Owner moves to substitute independent claim 24 for challenged independent claim 23, assuming we find claim 23 unpatentable. Motion 2. As stated above, we determine that Petitioner has demonstrated by a preponderance of the evidence that challenged claim 23 is unpatentable. Thus, Patent Owner's Motion to Amend is before us for consideration. For the reasons set forth below, Patent Owner's Motion to Amend is denied.

Proposed substitute claim 24 is reproduced below:

24. A removable self tamping coffee holder comprising:
- a coffee holder base having an open top configured for receiving a portion of untamped coffee;
 - a holder lid attachable to close the open top of the coffee holder base to form an assembled coffee holder after receiving the untamped coffee in the coffee holder base, wherein the attached holder lid is configured to retain the coffee in the coffee holder base and to allow entry of a pressurized flow of liquid into the coffee holder through the holder lid;
 - the assembled coffee holder engagable with a coffee maker to make a serving of coffee and the assembled coffee holder dis-engagable from the coffee maker after each time the serving of coffee is prepared;
 - the holder lid detachable from the coffee holder base each time after making the serving of coffee allowing disposal of used coffee grounds and re-use of the coffee holder; and
 - a tamper residing in the coffee holder, the tamper tamping the untamped coffee inside the coffee holder in both conditions comprising:

whenever the holder lid is attached to the holder base and the coffee holder is not engaged with the coffee maker; and

whenever the holder lid is attached to the holder base and the coffee holder is engaged with the coffee maker.

Id. at 4–5 (underlining added by Patent Owner to show added feature).

A motion to amend claims in an *inter partes* review is not, itself, an amendment. As the moving party, Patent Owner bears the burden of proof to establish that it is entitled to the relief requested. 37 C.F.R. § 42.20(c). Thus, Patent Owner’s proposed substitute claim is not entered automatically, but only upon Patent Owner having demonstrated by a preponderance of the evidence the patentability of that substitute claim. *See, e.g.*, 37 C.F.R. § 42.1(d) (noting that the “default evidentiary standard [in proceedings before the Board] is a preponderance of the evidence”).

1. Claim Construction

Claim construction is an important step in a patentability determination. *Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331, 1339 (Fed. Cir. 2003). Thus, a motion to amend claims must identify how the proposed substitute claims are to be construed, especially when the proposed substitute claims introduce new claim terms. *See Idle Free Sys., Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, slip op. at 7 (PTAB June 11, 2013) (Paper 26) (“*Idle Free*”).

In its Motion to Amend, Patent Owner introduces a new phrase—i.e., “a pressurized flow of liquid”—in its proposed substitute claim. Patent Owner argues that this claim feature distinguishes the proposed substitute claim from the prior art. *See, e.g.*, Motion 7–13. Patent Owner does not provide adequately, however, a claim construction for this new phrase. For example, in relation to “pressurized flow,” Patent Owner does not point to where the Specification defines the phrase,

does not provide an ordinary and customary meaning, and does not refer to a dictionary definition of the term “pressurized” in the context of liquid flow in a coffee apparatus.

At most, Patent Owner contends that written description support for substitute claim 24 exists in the Specification, citing Figure 2A as presenting a diagram of coffee maker 10, which includes water pump 21. *Id.* at 6. Patent Owner points to where the Specification describes that water pump 21 “provides water pressure to the nozzle 19 at a preferred pressure of at least one PSI, with the check valve providing a limit to the pressure provided,” and that in “this embodiment, it is the nozzle that provides this pressurized water to the coffee holder.” *Id.* at 6–7. Patent Owner also refers to where the Specification describes pressurizing water in water tank 18, and that “a coffee maker using any means to provide a forced flow of water is intending to [sic] within the scope of the present invention.” *Id.* at 7. While those portions of the Specification identified by Patent Owner may describe embodiments that are capable of providing “a pressurized flow of liquid,” those descriptions, by themselves, do not define the parameters of “pressurized flow.” In this case, that Patent Owner provides no claim construction for the added feature of “a pressurized flow of” liquid alone demonstrates that Patent Owner has not met its burden to show patentability of the proposed substitute claim under 37 C.F.R. § 42.20(c).

Furthermore, as Patent Owner implies in its Motion to Amend in relation to Zhao, Patent Owner’s counsel, upon questioning during the oral hearing, suggested that “a pressurized flow of” liquid excludes water under the force of gravity. Tr. 65; Motion 7–9. The Motion to Amend, however, does not present expressly such a claim construction, nor refer to any evidence, e.g., a dictionary or scientific definition, in support. On the record before us, it is not apparent why a pressurized

liquid that derives its pressurization from the force of gravity is excluded from the proposed added limitation of “a pressurized flow of” liquid.

2. *Patentability Over Prior Art*

In a motion to amend, a patent owner bears the burden of proof to demonstrate patentability of its proposed substitute claims over the prior art, and, thus, entitlement to the claims. 37 C.F.R. § 42.20(c). This does not mean that the patent owner is assumed to be aware of every item of prior art known to a person of ordinary skill in the art. The patent owner should explain in its motion, however, why the proposed substitute claim is patentable over not just the prior art of record, but also prior art not of record but known to the patent owner. *Idle Free* at 7. Thus, in its Motion to Amend, Patent Owner must show that the conditions for novelty and nonobviousness are met for the prior art known to Patent Owner.

In its Motion, Patent Owner contends that substitute claim 24 is patentable over Zhao, a prior art reference of record in this proceeding. Motion 7–10. Patent Owner also discusses the state of the art in coffee brewing in 2009, stating that “the predominant technology for brewing coffee . . . would involve low/no pressurize methods,” such as drip coffee, percolator coffee, and French press coffee. Motion 10. Patent Owner also discusses prior art “methods to concentrate bulk-brewed coffee into concentrates or soluble coffee powders,” as well as “an evolution to bring . . . to the mainstream consumer the concept of pressure-brewed coffee.” *Id.* at 10–11. Patent Owner contends that “the ‘812 patent, sought another space—a low cost system that automatically tamped the user’s coffee (as required for pressure brewing) with a reusable mechanism, which can be used with a relatively low cost brewing machine.” *Id.* at 12.

When arguing that substitute claim 24 is patentable over prior art generally, Patent Owner contends that “[w]hile in 2009 there was a trend toward single serve

coffee makers using capsules, the reusable self-tamped coffee holder claimed in claim 24, for not only tamping, but receiving a pressurized flow of water did not exist.” *Id.* at 12–13 (citing Ex. 2001 ¶¶ 20, 40). In support for this contention, Patent Owner and its expert address three prior art references raised in the Petition, i.e., Kraan,² Kirschner,³ and Guerrero.⁴ Motion 12–13; Ex. 2001 ¶¶ 20, 40; Pet. 3; Dec. to Inst. 6–7. More specifically, Patent Owner contends that these three references “*do not anticipate* a system as defined by claim 24, where the equivalent to the pod is re-usable, it is assembled (filled, emptied and refilled by the user, the tamping process occurs each time the user loads coffee in the holder) and engaged for use in the machine.” Motion 13 (emphasis added, original emphasis omitted).

In its Opposition to the Motion to Amend, Petitioner accurately points out that Patent Owner’s Motion fails to address adequately nonobviousness of substitute claim 24 in view of prior art of record, as well as prior art not of record but known to Patent Owner. Opp. 2–3. Instead, Patent Owner addresses nonobviousness expressly for the first time in its Reply in support of its Motion. Even assuming it would be appropriate for us to consider nonobviousness contentions raised for the first time in a reply, Patent Owner only responds in the Reply that substitute claim 24 is not obvious over specific prior art identified by Petitioner in its Opposition. Opp. 4–14; Reply to Opp. 4–5. The Reply does not establish sufficiently nonobviousness in view of prior art not of record but known

² Kraan, U.S. Pat. No. 6,748,850 B1, issued June 15, 2004 (“Kraan”) (Ex. 1006).

³ Kirschner et al., U.S. Pat. No. 8,327,754 B2, issued Dec. 11, 2012 (“Kirschner”) (Ex. 1005).

⁴ Guerrero, U.S. Pat. No. 7,461,587 B2, issued Dec. 9, 2008 (“Guerrero”) (Ex. 1007).

to Patent Owner. Thus, Patent Owner has not met its burden to demonstrate patentability of proposed substitute claim 24 in its Motion to Amend.

In any event, as noted by Petitioner (Opp. 6), Zhao describes the following, as a part of its invention:

The water added from the funnel (2) flows through the funnel (2) to above the separation net (5). Because the space between [the] funnel (2) and the separation net (5) is enclosed, the pressure formed naturally by the water above the funnel (2) relative to the bottom of the strainer body (1) is transmitted to above the separation net (5). So the water can flow out only by passing through the coffee power sufficiently. Because the funnel is in the upper part of the strainer body, the water above the funnel forms pressure naturally to the bottom of the strainer body. The higher is the funnel (2), the greater is this water pressure and the faster is the speed of the water penetrating through the coffee powder.

Ex. 1004, 4.

Thus, Zhao describes that the configuration and positioning of funnel 2 causes water contained therein to pass under pressure through coffee powder. Patent Owner does not explain adequately why that description does not amount reasonably to disclosure of a pressurized flow of liquid as a part of Zhao's coffee making technique.

Furthermore, we observe that the record is replete with references describing various mechanisms for developing pressurized liquid used during the course of coffee making (*e.g.*, Garte (Ex. 1012),⁵ Kraan (Ex. 1006), and Kirschner (Ex. 1005)). Patent Owner generally discounts the teachings of those references with respect to their disclosure of pressurized flows of liquid. Mot. 12–13; Reply to Opp. 4–5. Patent Owner does not explain persuasively, however, why a person of

⁵ Garte, U.S. Pat. No. 3,120,170, issued Feb. 4, 1964 (“Garte”) (Ex. 1012).

ordinary skill in the art, who is also a person of ordinary creativity, *see KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007), would not have understood readily that any of the variety of known ways to develop pressurized flow in the art would have been viable for use in Zhao's coffee making device. Indeed, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.* at 417. Patent Owner does not explain why that obviousness principle is not applied reasonably here.

Accordingly, for those reasons also, we are not persuaded that Patent Owner has met its burden to demonstrate patentability of proposed substitute claim 24 in its Motion to Amend.

D. Patent Owner's Motion to Exclude

In its Motion to Exclude, Patent Owner moves to exclude a Declaration by Dr. Alexander Slocum (Ex. 1021), relied upon by Petitioner in its Reply to Patent Owner's Response. Mot. to Exclude 2. As indicated previously, Petitioner opposes Patent Owner's Motion to Exclude, and Patent Owner filed a Reply to Petitioner's Opposition to its Motion to Exclude. Papers 41, 42.

In its Motion to Exclude, Patent Owner contends that Petitioner cannot meet its burden to show unpatentability, absent Dr. Slocum's testimony, which Patent Owner alleges Petitioner inappropriately cites for the first time in its Reply. Mot. to Exclude 2–3, 10. Specifically, according to Patent Owner, the Petition lacks expert testimony as to how a person of ordinary skill would have interpreted Zhao. *Id.* at 2–3, 6–7. Patent Owner argues that the Petition fails to provide a declaration from a technical expert in support of its arguments regarding anticipation, and does

not provide evidence as to “how one of ordinary skill would have interpreted Zhao.” *Id.* at 3, 10.

As a general matter, a motion to exclude is not an appropriate vehicle for challenging a reply or a reply’s supporting evidence as exceeding the scope of a proper reply. *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00002, slip op. at 62 (PTAB Jan. 23, 2014) (Paper 66); *Norman Int’l, Inc. v. Andrew Toti Testamentary Trust*, Case IPR2014-00283, slip op. at 2 (PTAB Jan. 22, 2015) (Paper 33). As noted by Petitioner, the purpose of a motion to exclude is to challenge admissibility of evidence. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012); Paper 41, 1–2. We consider Patent Owner’s argument here, however, because the panel previously indicated that Patent Owner may challenge this reply evidence in a motion to exclude. Paper 31, 1–2.

Testimony from a technical expert can be helpful to show what would have been known to a person of ordinary skill in the art and explain the significance of elements in a claim. Testimony from a technical expert is not a prerequisite for establishing unpatentability by a preponderance of the evidence, however, just as it is not a prerequisite for a petition seeking *inter partes* review. *See U.S. Bancorp v. Retirement Capital Access Management Co.*, CBM2013-00014, slip op. at 18–19 (PTAB Aug. 22, 2014) (Paper 33); *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009) (“Nor are expert opinions always a prerequisite [to show unpatentability], for ‘[i]n many patent cases expert testimony will not be necessary because the technology will be “easily understandable without the need for expert explanatory testimony.”’”) (quoting *Centricut, LLC v. Esab Group, Inc.*, 390 F.3d 1361, 1369 (Fed. Cir. 2004) (quoting *Union Carbide Corp. v. Am. Can Co.*, 724 F.2d 1567, 1573 (Fed. Cir. 1984))).

Every case is different and will depend on its own facts. Here, Zhao describes a relatively straightforward and easily understandable technology regarding a coffee holder and coffee maker. Under the particular facts of this case, we determine, for the reasons discussed above, that Petitioner provides sufficient explanation and evidence—relying on Zhao itself as evidence—as to why Zhao anticipates claim 23, without the need for testimony from a technical expert, such as Dr. Slocum. Thus, we do not rely upon Dr. Slocum’s Declaration when addressing Petitioner’s arguments regarding anticipation by Zhao.

In its Motion to Exclude, Patent Owner further contends “[t]hat the Petition utterly lacked evidence from the perspective of one having ordinary skill was noted several times by the Board.” *Id.* at 2, 8 (citing Dec. to Inst. 13, 16, 18)). The pages of our Institution Decision cited by Patent Owner state, however, that we were not persuaded that Petitioner “articulates sufficiently, or provides specific evidence of” a reason to combine elements as disclosed in different references at issue in three non-instituted obviousness grounds. Dec. to Inst. 13, 16, 18. Our Institution Decision does not suggest that the Petitioner can never meet its burden to establish unpatentability of a claim if it does not provide, along with its Petition, expert testimony explaining how an ordinary artisan would have interpreted prior art at issue.

Accordingly, we deny Patent Owner’s Motion to Exclude.

III. CONCLUSION

For the foregoing reasons, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that claim 23 is unpatentable as anticipated by Zhao under 35 U.S.C. § 102. In addition, for the reasons discussed above, Patent Owner has not, in its Motion to Amend, satisfied its burden of proof. For the reasons discussed above, we also deny Patent Owner’s Motion to Exclude.

IV. ORDER

Accordingly, it is

ORDERED that Petitioner has shown by a preponderance of the evidence that claim 23 of the '812 patent is *unpatentable*;

FURTHER ORDERED that Patent Owner's Motion to Amend is *denied*;

FURTHER ORDERED that Patent Owner's Motion to Exclude is *denied*;

and

FURTHER ORDERED that, because this is a Final Written Decision, the parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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