

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

A&A GLOBAL IMPORTS, INC.,
Petitioner,

v.

LERMAN CONTAINER CORPORATION,
Patent Owner.

IPR2024-01138
Patent D781,151 S

Before GRACE KARAFFA OBERMANN, JENNIFER S. BISK, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

A&A Global Imports, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of the single claim of U.S. Patent No. D781,151 S (Ex. 1001, “the ’151 patent”) pursuant to 35 U.S.C. § 311(a). Lerman Container Corporation (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

After considering the parties’ arguments and the evidence of record, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in challenging the patentability of the ’151 patent’s claim. Thus, we do not institute an *inter partes* review.

B. *Real Parties-in-Interest*

Petitioner identifies itself, A&A Global Imports, Inc., as the only real party-in-interest. Pet. 1. Patent Owner identifies itself, Lerman Container Corp. “d/b/a eBottles.com,” as the only real party-in-interest. Paper 4,1. Nothing in the record challenges these assertions. *See generally*, Pet.; Prelim. Resp.

C. *Related Matters*

Petitioner indicates that on February 11, 2019, the ’151 patent was submitted for *ex parte* reexamination before the PTO in Reexamination No. 90/014,262 (“the ’151 Patent Reexam”), which resulted, on November 30,

2021, in an *Ex Parte* Reexamination Certificate confirming the patentability of the claim. Pet. 1 (citing Ex. 1003); Paper 4, 1. During the '151 Patent Reexam, the PTO issued a Final Office Action finding the '151 patent's claim unpatentable under 35 U.S.C. § 103. Ex. 1003, 235–244. Patent Owner appealed this decision and, on September 1, 2021, the PTAB reversed the Examiner's rejection. Ex. 2002 ("PTAB Appeal Decision").¹

Petitioner also indicates that Patent Owner asserted the '151 patent twice. First, in May 2019, Patent Owner initiated a case in the District of Maryland against "Lids and Jars, LLC d/b/a Cannaline." Pet. 1–2. That case was dismissed by the parties in February 2022. *Id.* (citing *Lerman Container Corp. d/b/a eBottles.com v. Lids and Jars, LLC d/b/a Cannaline*, No. 1-19-cv-01414); *see also* Paper 4, 1. Second, in November 2022, Patent Owner initiated a case in the Southern District of Florida against Greenlane Holdings, LLC. *Id.* at 2. The parties jointly stipulated to dismiss that case on March 16, 2023. *Id.* (citing *Lerman Container Corp. d/b/a eBottles.com v. Greenlane Holdings, LLC*, No. 9-22-cv-81723); *see also* Paper 4, 1.

Petitioner concludes that "there are no currently pending related matters that would affect, or be affected by, a decision in this proceeding" and Patent Owner "has not filed a complaint or served a complaint alleging infringement of [the '151 patent] against Petitioner." Pet. 1–2. Patent Owner agrees. Paper 4, 2 ("There are no judicial or administrative matters that would affect or be affected by a decision in the proceeding.").

¹ The PTAB Appeal Decision appears twice in the record—at pages 15–29 of Exhibit 1003 and Exhibit 2002. For clarity, in this Decision we refer to the copy in Exhibit 2002.

D. The '151 Patent

The '151 patent, titled “JAR,” issued March 14, 2017, from an application filed June 8, 2016. Ex. 1001, codes (22) (45), (54). The claim recites “[t]he ornamental design for a jar, as shown and described.” *Id.* at code (57). The drawings depict a transparent jar with certain unclaimed aspects of the jar illustrated by broken lines. *See id.* (“The broken lines shown in the drawings are included for the purpose of illustrating portions of the article that form no part of the claimed design.”). The '151 patent includes seven figures. Figures 1 and 2 of the '151 patent are reproduced below.

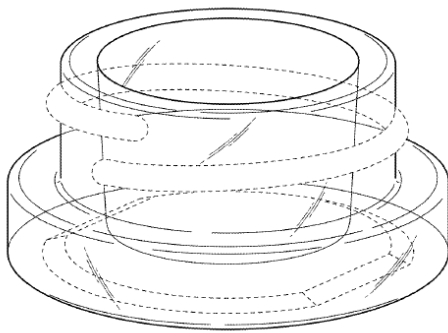


FIG. 1

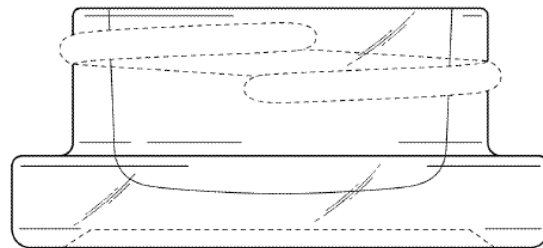


FIG. 2

Figure 1, on the left, shows a front side perspective drawing of a transparent jar with a base and threaded neck. Figure 2, on the right, shows a front elevation drawing of that same jar.

Ex. 1001. Figure 1, above left, depicts a top, front, right side perspective view of the claimed jar. *Id.* Figure 2, above right, depicts a front elevation view of the claimed jar. *Id.*

E. Asserted Challenges to Patentability

Petitioner asserts that the '151 patent is unpatentable based on the following grounds.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	103	Neutrogena, ² Canamasas Puigbo ³
1	103	Huang, ⁴ Canamasas Puigbo, Zamberlan ⁵
1	103	Huang, Neutrogena
1	103	McKernan, ⁶ Zamberlan

In support of its patentability challenge, Petitioner relies on, *inter alia*, the Declaration of Timothy P. Fletcher. Ex. 1011 (“Fletcher Decl.”).

In response, Patent Owner relies on, *inter alia*, the Declaration of Lance G. Rake. Ex. 2001 (“Rake Decl.”).

F. The Asserted Prior Art

1. Neutrogena

Petitioner asserts that “Neutrogena Corporation has been selling and advertising (via printed publications) skin care products in transparent

² Neutrogena Hydro Boost as seen in Exhibits 1015, 1016, 1017, 1022, and 1023 at pages 2–13, 33–39.

³ U.S. Patent No. D578,891 S, issued October 21, 2008. Ex. 1008.

⁴ U.S. Patent No. D795,705 S, issued August 29, 2017. Ex. 1007.

⁵ U.S. Patent No. D634,202 S, issued March 15, 2011. Ex. 1013.

⁶ McKernan jar image as seen in documents referred to as Exhibits B1–B4 in the Board Appeal Decision, including Beauty Packaging, McKernan Adds Low Profile, Frosted Glass Jars (June 2012) (<https://www.beautypackaging.com/issues/2012-06/view-design-center/mckernan-adds-low-profile-frosted-glass-jars>).

(printed Jan. 24, 2019) (“McKernan Exhibit B1”), McKernan Catalogue, published February 2012 (“McKernan Exhibit B2”), Image of McKernan jar, available from archive.org as of October 30, 2013 (“McKernan Exhibit B3”), McKernan Packaging Clearing House, part drawings, identifying Part Number EL-28595 and dated March 21, 2011 (“McKernan Exhibit B4”). Ex. 1003, 431–439.

jars/containers since at least 2006” and provides printed publications showing the Neutrogena Hydro Boost products. Pet. 17 (citing Ex. 1015; Ex. 1016; Ex. 1017). According to Petitioner these documents constitute printed publications available prior to the earliest effective filing date of D151. *Id.* at 19–20 (citing Fletcher Decl. ¶ 57). Images from Exhibit 1017, as presented by Petitioner, are reproduced below.



EX1017³

This figure includes two images side-by-side. The left image shows the front side of a light blue tinted, transparent jar with the words “Neutrogena,” “HYDRO BOOST™,” and “night concentrate.” It has a light blue cap covering the neck of the jar. The right image is of the same jar from the top with the lid removed showing the jar and its contents (a white lotion).

Pet. 19. Petitioner asserts that the Neutrogena Hydro Boost products show a “transparent tinted blue jar having a tubular base and a tubular neck portion located concentrically on the top horizontal surface of the tubular base portion and extending upwards from the horizontal surface.” *Id.* at 20 (citing Fletcher Decl. ¶ 59). According to Petitioner, “[t]he open top end of the neck

portion defines the entrance of the compartment, which extends from the top of the neck portion into the base portion and also allows an ordinary observer to see the contours of the compartment.” *Id.* at 25. Petitioner acknowledges that the interior compartment includes a white liner. *Id.*

Patent Owner does not contest that Exhibits 1015, 1016, and 1017, individually, are prior art. Prelim. Resp. 11. Patent Owner notes that the jars shown in Exhibits 1015 and 1017 are “different colors and have different caps but appear to have substantially the same physical shape,” whereas the jar shown in Exhibit 1016 “is noticeably different, with a thinner sidewall and base thickness than that of jars shown in EX1017.” *Id.* (citing Rake Decl. ¶ 41). According to Patent Owner, “Petitioner provides no legal basis for combining these three separate exhibits and treating them as an amalgamated primary or secondary reference.” *Id.* at 12. In addition, Petitioner disputes that Exhibit 1014 is prior art because it bears a 2022 copyright and shows a timeline that extends past 2018. *Id.* n.3.

Notwithstanding these arguments, Patent Owner acknowledges that “[t]he interior of the jar appears to extend through almost the entire base of the jar,” but notes that “the specific contours of the interior are distorted by reflections and refractions of the glass” and the “shape of the bottom of the interior cannot be seen.” *Id.* at 12–13 (citing Rake Decl. ¶¶ 41, 44, 70). Patent Owner also points out that “[t]he height of the neck relative to the base of the jar cannot be clearly determined, but it must be less than the height of the cap covering the neck.” *Id.* at 12 (citing Rake Decl. ¶ 43). Patent Owner concludes that the jar shown by Exhibits 1015–1017 “has a tall base, a much shorter neck with a shoulder between the base and the neck that is very small relative to the base height, and an internal cavity that

extends almost entirely through the base.” *Id.* at 13 (citing Rake Decl. ¶¶ 43, 44, 68).

As discussed in more detail below, we are not persuaded of a reasonable likelihood that Petitioner will prevail in any of the asserted challenges as presented in the Petition. Accordingly, we do not further address the propriety of combining Exhibits 1015, 1016, and 1017, together, as a single piece of prior art or their suitability as prior art.

2. *Canamasas Puigbo*

Canamasas Puigbo is a design patent titled “BOTTLE,” issued on October 21, 2008, from a patent application filed on December 10, 2007. Ex. 1008, codes (22), (45), (54). The four drawings of Canamasas Puigbo, as presented by Petitioner, are reproduced below.

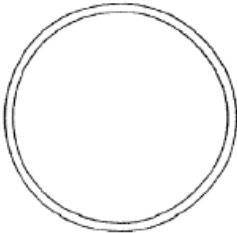
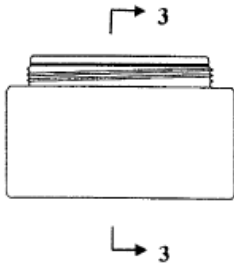
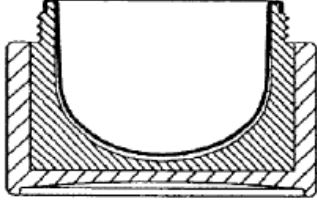
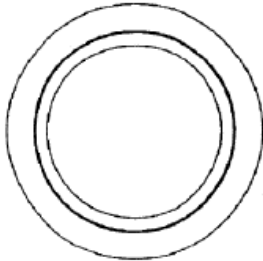
Description	Drawing
Fig. 1: Bottom Plan View	 A technical drawing showing the bottom plan view of a bottle. It consists of two concentric circles, with the outer circle being slightly larger than the inner one, representing the base of the bottle.
Fig. 2: Front Elevation View (rear elevation view is identical)	 A technical drawing showing the front elevation view of a bottle. It is a rectangular shape with a slightly flared top. Above the rectangle, there is a small horizontal line with a right-pointing arrow and the number 3. Below the rectangle, there is a small horizontal line with a left-pointing arrow and the number 3.

Fig. 3: Cross-section view	
Fig. 4: Top Plan View	

This is a table of 4 rows with 2 columns. Row 1 is labeled “Fig. 1: Bottom Plan View” and the drawing show an outer circle with an inner circle much closer to the outer circle than the center. Row 2 is labeled “Fig. 2: Front Elevation View (rear elevation view is identical)” and the drawing shows a jar with a base and a threaded neck. Row 3 is labeled “Fig. 3: Cross-section view” and the drawing shows a side view of the interior of the jar including a “U” shaped compartment. Row 4 is labeled “Fig. 4: Top Plan View” and the drawing shows three concentric circles with the two interior circles very close to each other and closer to the outer circle than the middle.

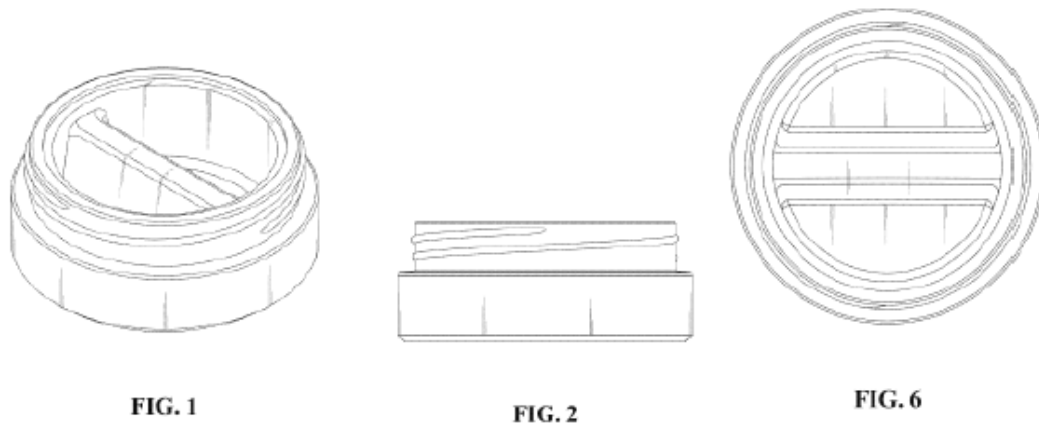
Pet. 30–31. These four drawings show Canamasas Puigbo’s bottle from the bottom, front, cross-section, and top. Ex. 1008. Petitioner describes Canamasas Puigbo as “a bottle having a tubular base portion, a concentrically located tubular neck portion,” with a smaller diameter than the base, and “disposed on top of the horizontal flat surface of the tubular base portion.” *Id.* at 31 (citing Fletcher Decl. ¶¶ 71–72).

Patent Owner emphasizes that Canamasas Puigbo’s bottle “has a very tall and wide base with a short neck,” and “[t]he shoulder between the base and the neck is very small relative to the base height.” Prelim. Resp. 15.

Patent Owner also notes that “the internal cavity extends through most of the base and has a very rounded bottom.” *Id.* (citing Rake Decl. ¶¶ 51–53).

3. *Huang*

Huang is a design patent titled “COMPARTMENTALIZED CONTAINER,” issued on August 29, 2017, from a patent application filed on December 30, 2015. Ex. 1007, codes (22), (45), (54). Figures 1, 2, and 6 of Huang, as presented by Patent Owner, are reproduced below.



This figure shows three side-by-side figures from Huang of a jar including a base and threaded neck with no cap. The drawing on the left is labeled “FIG. 1” and shows a perspective view of the jar, including an interior compartment divided in half by a ridge. The middle drawing is labeled “FIG. 2” and shows a front view of the jar. The drawing on the right is labeled “FIG. 6” and shows a top view of the jar, including the divided interior.

Prelim. Resp. 13. Petitioner describes Huang’s container as having “a tubular base portion, a concentrically located tubular neck portion atop the horizontal surface of the tubular base portion, and a compartment disposed within the base and neck portions and accessible through the top of the neck portion.” Pet. 27 (citing Fletcher Decl. ¶ 65). Petitioner acknowledges that the height of the base and neck are “approximately the same,” “[t]he entire

article of Huang is opaque,” and the interior compartment “includes a bisecting wall that does not extend to the top of the compartment but creates two chambers.” *Id.* at 27–30.

Patent Owner adds that the Huang container’s “neck is wide relative to the base and the shoulder between the base and the neck is very small.” Prelim. Resp. 14. Patent Owner also notes that the figures do not clearly show how deep the interior compartment extends into the base or whether the two chambers have the same depths. *Id.*

4. *Zamberlan*

Zamberlan is a design patent titled “FLASK, CAP AND REFILL,” issued on March 15, 2011, from a patent application filed on December 28, 2009. Ex. 1013, codes (22), (45), (54). Figures 6 and 7 of Zamberlan, as presented by Patent Owner, are reproduced below.



FIG. 6

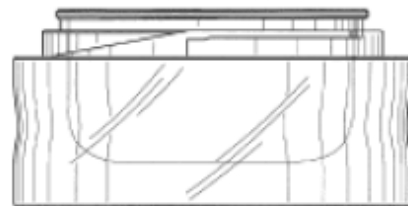


FIG. 7

This figure shows two side-by-side figures from Zamberlan of a jar with a base and a threaded neck. The drawing on the left is labeled “FIG. 6” and shows a perspective view of the jar. The right is labeled “FIG. 7” and shows a front view of the jar.

Prelim. Resp. 15. Petitioner states that Zamberlan’s flask “is transparent thereby revealing an interior bowl-shaped compartment.” Pet. 40 (citing Fletcher Decl. ¶ 81).

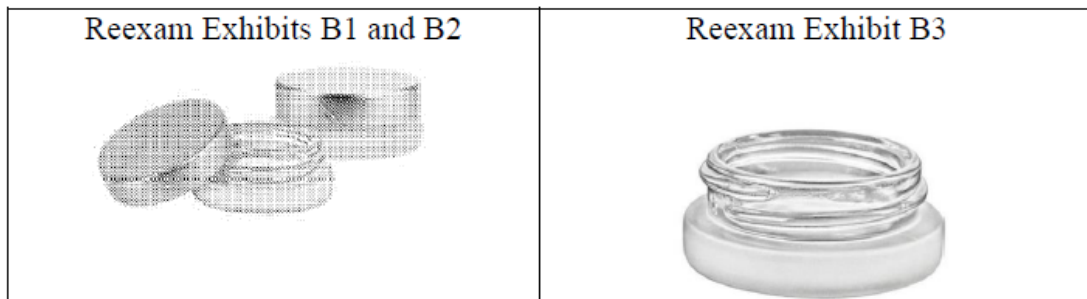
Patent Owner notes that Zamberlan’s flask “has a relatively tall base with a distinctive horizontal indentation located approximately at the middle of the base” and “a short step-like neck and a very small shoulder width relative to the height of the base.” Prelim. Resp. 16. Patent Owner adds that the internal cavity has “straight sidewalls” that extend from the top of the neck “more than halfway into the base” ending in a “flat bottom.” *Id.* (citing Ex. 2002, 5–6).

5. *The McKernan Jar*

The McKernan Jar refers to four separate documents that were submitted to the Patent Office by a third party as Exhibits B1–B4 in the Petition for Reexamination of D151. Ex. 1003, 431–439. Petitioner asserts that they collectively qualify as prior art “because printed publications evidencing the Jar were available as early as February 2012, and further confirmed as of October 2013.” Pet. 34 (citing Ex. 1003, 431–439; Ex. 1025; Ex. 1026). According to Petitioner, Exhibit 1025 was published on October 30, 2013 on McKernan’s online website and Exhibit 1026 was published at least by June 6, 2015. *Id.* at 34–35 (citing Ex. 1003, 431–432, 436; Ex. 1025; Ex. 1022 ¶ 5; Ex. 1026); *see also* Prelim. Resp. 16–17. The images contained in these documents were considered by the Board in the ’151 Patent Reexam. Ex. 2002, 4. Petitioner asserts that Patent Owner “conceded that the McKernan Jar is prior art to D151 by failing to challenge the assertion of the McKernan Jar as prior art at any point during the reexamination.” Pet. 34.

Patent Owner argues that Petitioner “has improperly combined multiple documents from different sources and with different dates, treating them a single printed publication” and asserts that it has not conceded the status of the four documents as printed publications. Prelim. Resp. 16–17. However, Patent Owner states that it “will assume, solely for purposes of the present Response, that all four referenced documents in EX1003, pp. 431–439 qualify as prior art.” *Id.* at 18. Based on Patent Owner’s assumption and because, as discussed in detail below, we are not persuaded of a reasonable likelihood that Petitioner will prevail in any of the asserted challenges as presented in the Petition, we do not further address the propriety of the McKernan Jar as prior art or of the various exhibits relied upon by Petitioner as printed publications.

The images shown in Exhibits B1–B3 of the D151 Reexam are shown below, as presented by Patent Owner.



This figure shows two side-by-side figures of the McKernan Jar. The image on the left is labeled “Reexam Exhibits B1 and B2” and shows two images of the jar, the first image is the jar with the cap off and leaning against the jar. The second image is slightly behind and to the right of the first image and shows the jar with the cap on. The right image is labeled “Reexam Exhibit B3” and shows a front view of the jar without the cap.

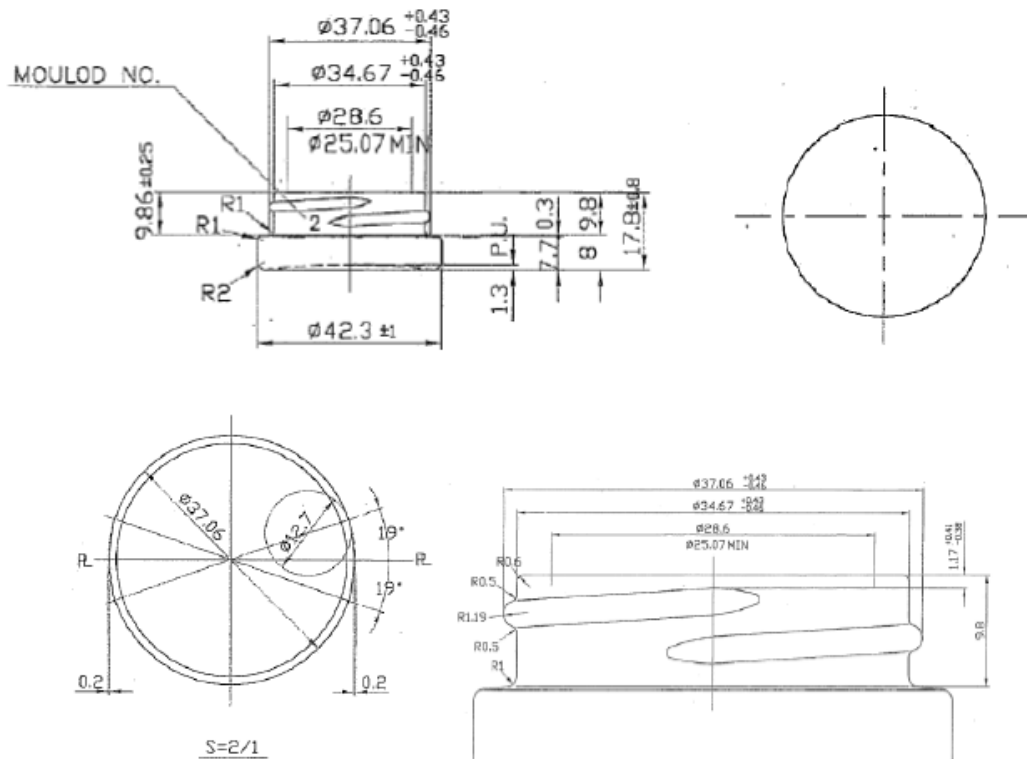
Prelim. Resp. 18. The image above left, from Reexam Exhibits B1 and B2 shows a “7 ml frosted glass jar.” Ex. 1003, 432, 434. The image above right, from Reexam Exhibit B3 shows a similar jar from the front without a cap. *Id.* at 436. Petitioner provides an “enhanced color image” of the McKernan Jar in Exhibit 1025, reproduced below.



EX1025 (annotated)

Exhibit 1025 is an image of the front with a cylindrical jar with the cap off. It has a frosted base and a transparent neck with threading.

Pet. 35. The images from Reexam Exhibit B4 are reproduced below, as presented by Patent Owner.



Reexam Exhibit B4 shows 4 engineering drawings of a jar. The numbers depicted in several of the drawings are small and hard to read. The first drawing, top left, shows a side view of the jar with numbers indicating various heights and radii. The second drawing, top right, shows a bottom view of the jar represented as a circle with vertical and horizontal lines. The third drawing, bottom left, shows the bottom view of the jar with several numbers indicating radii. The fourth drawing is a side view of the neck of the jar with various numbers indicating measurements of the various portions of the neck and threading.

Prelim. Resp. 19 (citing Ex. 1003, 437–439). These images are engineering drawings annotated with details about the proportions of the jar's exterior. Ex. 1003, 437–439.

Petitioner asserts that the McKernan Jar has a base portion with a tubular shape that is wider than the concentric neck portion. Pet. 37–38.

Petitioner adds that the neck portion of the McKernan Jar, at 9.8mm, is taller than the base portion of the jar, at 7.7mm. *Id.*

Patent Owner agrees that the height of the McKernan Jar neck “is slightly greater than the height of the base” and that the McKernan Jar “has a modest shoulder that appears in the image to be about half as wide as the base height.” Prelim. Resp. 18. Patent Owner adds that “[b]ecause the base is frosted, the interior of the jar below the rim is hidden and it [is] impossible to know how the interior cavity is shaped or how deep the cavity extends.” *Id.*

II. ANALYSIS

“In an [*inter partes* review], 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) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also* 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied upon).

“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 171(a). These requirements include that the design be novel and nonobvious. 35 U.S.C. §§ 102, 103; *see also* 35 U.S.C. § 171(b) (“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”).

A. Designer of Ordinary Skill in the Art

We review the grounds of unpatentability in view of the understanding of a designer of ordinary skill in the art at the time of the invention. *LKQ Corp. v. GM Glob. Tech. Operations LLC*, 102 F.4th 1280, 1299 (Fed. Cir. 2024) (en banc) (stating “[i]n design cases we will consider the fictitious person identified in § 103 as ‘one of ordinary skill in the art’ to be the designer of ordinary capability who designs articles of the type presented in the application”) (quoting *In re Nalbandian*, 661 F.2d 1214, 1216 (CCPA 1981)) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)).

Petitioner submits that a designer of ordinary skill in the art at the time of the invention would have had “a bachelor’s degree in Industrial Design, Mechanical Engineering, or related field and approximately 5 years of professional experience in the field designing consumer products.” Pet. 42 (citing Fletcher Decl. ¶ 48). Petitioner adds that “[a]dditional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education.” *Id.* Patent Owner does not dispute this proposed definition. Prelim. Resp. 19.

For purposes of this Decision, we adopt Petitioner’s uncontested proposal regarding a designer of ordinary skill in the art. *See* Fletcher Decl. ¶ 48; Rake Decl. ¶ 29.

B. Claim Construction

In an *inter partes* review proceeding, we construe a claim of a patent “using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. 282(b). *See* 37 C.F.R. § 42.100(b). The Federal Circuit holds that tribunals “should not treat the

process of claim construction [in design patent cases] as requiring a detailed verbal description of the claimed design, as would typically be true in the case of utility patents.” *LKQ*, 102 F.4th at 1301 (quoting *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. 2008) (en banc)). According to the Federal Circuit, “a design is better represented by an illustration.” *Egyptian Goddess*, 543 F.3d at 679.

Both parties agree that, for purposes of this proceeding, no explicit construction of the ’151 patent is required. Pet. 41; Prelim. Resp. 21. Although preferably a design patent claim is not construed by providing a detailed verbal description, it may be “helpful to point out . . . various features of the claimed design as they relate to the . . . prior art.” *Egyptian Goddess*, 543 F.3d at 679; *cf. High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1314–15 (Fed. Cir. 2013) (remanding to the district court, in part, for a “verbal description of the claimed design to evoke a visual image consonant with that design”). The following, therefore, is not a claim construction, but a brief description pointing out various features of the claimed jar in order to aid in analysis.

Both parties agree that the ’151 patent claims a transparent jar with a base, a neck, and an internal cavity. Pet. 41–42; Prelim. Resp. 5–6. Moreover, neither party disputes the description provided by the Board in the PTAB Appeal Decision (Ex. 2002, 2–3) indicating that the claimed jar “has a wide and thick circular base, and a tall narrow circular neck extending upwardly from the base.” *See* Pet. 41–42; *see generally* Prelim. Resp. The parties also appear to agree on many of the details of the claimed subject matter. For example, the neck portion of the jar extends upwardly from, and

is taller than, the base.⁷ In addition, the diameter of the neck portion is smaller than the diameter of the base resulting in a horizontal offset shoulder between the base and neck.⁸ “All of the claimed exterior edges of the jar are curved but for the top surface of the neck, which is flat and has an interior right angle with the interior storage chamber.” Ex. 2002, 3.⁹ And, the internal cavity of the claimed jar has sidewalls that extend from the neck into the top portion of the base and has a curved bottom edge.¹⁰

The thread on the neck of the jar and the punt (the indentation on the bottom exterior of the base) are depicted in broken lines and, therefore, form no part of the claimed design. Ex. 1001.

⁷ Pet. 41–42 (“[T]he base encompasses about 40% of the total height of the jar, e.g., a slightly taller neck portion than base portion.”); Prelim. Resp. 5 (“The height of the neck portion is slightly greater than 1 ½ times the height of the base portion.”); Ex. 2002, 2 (“The neck encompasses the remainder of the jar’s height that is about 60% of the total height.”).

⁸ Prelim. Resp. 5 (“The diameter of the neck portion is approximately ¾ the diameter of the base portion. The dimensions of the neck and base result in a significant horizontal offset shoulder with a width that is about 2/3 the base height.”); Ex. 2002, 3 (“[T]he top surface of the neck . . . is flat . . .”).

⁹ See also Pet. 4 (“The jar is defined by vertical tubular sidewalls including vertical tubular surfaces as well as horizontal top and bottom surfaces. Each of the transitions between the horizontal surface and its adjacent vertical surface is defined by a radiused, e.g., curved, transition.”).

¹⁰ Ex. 2002, 3 (“The interior storage chamber has a slight frustoconical shape within the neck, and an ellipsoidal shape within the base. . . [or, in other words has] a bowl-like shape with a curved bottom edge extending below the shoulder of the thick circular base.”); Pet. 41–42 (stating the ’151 patent has “an exteriorly visible storage chamber extending from the top of the neck and partially into the base”) (citing Ex. 2002, 3)); Prelim. Resp. 5–6 (“The internal cavity resides mostly in the neck of the jar, extends only slightly into the base portion and has a gently concave bottom and sidewalls that taper slightly inward.”).

C. Obviousness

After the PTAB Appeal Decision in the '151 Patent Reexam, the Federal Circuit, in *LKQ*, adopted an obviousness approach “which provides that the same conditions for patentability that apply to utility patents apply to design patents”—“a more flexible approach than the *Rosen-Durling* test.” *LKQ*, 102 F.4th at 1287. The obviousness inquiry asks “whether an ordinary designer in the field to which the claimed design pertains would have been motivated to modify the prior art design ‘to create the same overall visual appearance as the claimed design.’” *LKQ*, 102 F.4th at 1299 (quoting *Campbell Soup, Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1275 (Fed. Cir. 2024)).

Rather than starting with a primary reference that must qualify as “basically the same,” as was previously required by *Rosen*, *LKQ* informs us, “there is no threshold similarity or ‘basically the same’ requirement to qualify as prior art.” *LKQ*, 102 F.4th at 1296 (citation omitted). The court, instead, instructs us to rely on the analogous art requirement to “rein[] in the scope of prior art.” *Id.* For designs, analogous art “includes art from the same field of endeavor as the article of manufacture of the claimed design.” *Id.* at 1297.

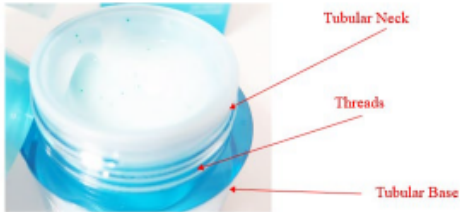
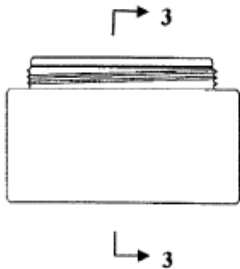
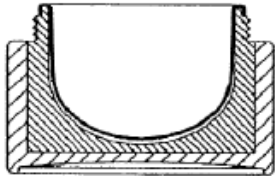
1. Neutrogena and Canamasas Puigbo

a. The Proposed Ground

Petitioner asserts that the '151 patent's claim would have been obvious over Neutrogena in view of Canamasas Puigbo. Pet. 44–58. Petitioner provides the following table showing select figures of the '151 patent, Neutrogena, and Canamasas Puigbo.

Reference	Image
'D151	
'D151	

This figure is a table with 2 rows and 3 columns. Row 1 is labeled “’D151” and shows annotated versions of the perspective and front views of the claimed jar. The perspective drawing on the left is annotated with “Tubular neck” pointing to the neck portion of the jar, “Threads” pointing to the threads on the neck, and “Tubular Base” pointing to the base portion of the jar. The drawing on the right has the same annotations pointing to the same portions of the jar. Row 2 is also labeled “’D151” and shows the same figures, but the annotations for the drawings are “Compartment,” pointing to the interior compartment within the neck and a portion of the base, and “Radiused Transition,” pointing to the rounded edges of the interior compartment.

Neutrogena	 
Neutrogena	 
Canamasas Puigbo	 

This figure is a table with 3 rows and 3 columns. Rows 1 and 24 are labeled “Neutrogena” and each includes annotated images of the front side view and a top view of the Neutrogena jar. The front view image on the left in Row 1 is annotated “Tubular Neck (within cap)” pointing to the cap of the jar, and “Tubular Base” pointing to the base portion of the jar. The top view image in Row 1 show the jar with no cap and is annotated “Tubular Neck” pointing to the neck portion of the jar, “Threads” pointing to the threads of the jar, and “Tubular Base” pointing to the base of the jar. Row 3 is labeled “Canamasas Puigbo” and includes two side views of the jar, the first side view is from the outside, and the second side view shows the interior of the jar.

Pet. 53–54. The Petition asserts that Neutrogena is “visually similar to the design claim” in that they both show transparent containers with a wide and

thick circular base and a narrower neck portion extending upwardly from the base with an interior compartment extending from the top of the neck and partially into the base. *Id.* at 44–46. Petitioner also asserts that the interior compartment has a slightly concave bottom surface, and the transition between the base and neck is curved. *Id.* at 46–47.

Petitioner acknowledges that Neutrogena includes an interior liner. To the extent that Patent Owner argues that “Neutrogena does not explicitly show a top surface of the neck portion being flat with curved edges due to the interior lining in the images” (*id.* at 48–49, 55), Petitioner points to Canamasas Puigbo as including this design element, stating “[t]he mere similarity between Neutrogena and Canamasas Puigbo would motivate” a designer of ordinary skill to modify Neutrogena to include a flat top with radiused transitions as well as “practical considerations, such as comfort, safety, and leak-prevention.” *Id.*

b. Proportional Height of Base and Neck

Petitioner acknowledges that the neck of the claimed design is taller than the base portion, but this is not case in Neutrogena. *See* Pet. 49 (“Slight differences, like the neck of ’D151 being taller than the base portion, do not preclude a finding that Neutrogena is not visually similar.”), 50 (noting any such differences are “slight”), 57 (explaining why a designer of ordinary skill would incorporate into Neutrogena a taller neck portion relative to the base). More specifically, we agree with Patent Owner that the height of the neck relative to the base of the Neutrogena jar “cannot be clearly determined, but it must be less than the height of the cap covering the neck.” Prelim. Resp. 12 (citing Rake Decl. ¶ 43). Based on the drawings in the record, Neutrogena’s cap appears to be shorter than the height of the base.

Petitioner asserts that “[i]t would be a functional design element to optimize the volume of the compartment” and “a minor functional design option to optimize the overall height of the neck portion for providing a tool to access and extract contents from the compartment, such as, for example, a nail polish cap having an integrated brush for nail polish containers.” Pet. 50 (citing Fletcher Decl. ¶ 90). Petitioner adds that “the height of the neck portion would directly functionally impact the volume within the compartment, and therefore, adjusting the length of the neck would directly adjust the volume contained in the compartment.” *Id.* at 57 (citing Fletcher Dec. ¶¶ 99–100).

To the extent that Petitioner is arguing that the proportion of base to neck height of the claimed jar is not limiting because it is a functional design element, we do not agree. It is true that a design patent only protects the novel, ornamental features of the patented design. *Oddzon Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir. 1997). However, so long as the design is not primarily functional, the design claim is not invalid even if certain elements have functional purposes. *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1320 (Fed. Cir. 2016). That is because a design patent’s claim protects an article of manufacture, which necessarily serves a utilitarian purpose. *Id.* Where a design contains both functional and non-functional elements, the scope of the claim must be construed in order to identify the non-functional aspects of the design shown in the patent. *Id.* Thus, while certain elements of a device may be functional, their functionality does not preclude those elements from having protectable ornamentation. *Id.* at 1321 (stating that “in no case did we entirely eliminate

a structural element from the claimed ornamental design, even though that element also served a functional purpose”).

In determining whether a claimed design is primarily functional, the functionality of the article itself must not be confused with the functionality of the design of the article. *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1328 (Fed. Cir. 2015). In determining whether a design is dictated by function, several factors may be assessed, including whether (1) “the protected design represents the best design,” (2) “alternative designs would adversely affect the utility of the specified article,” (3) “there are any concomitant utility patents,” (4) “the advertising touts particular features of the design as having specific utility,” and (5) “there are any elements in the design or an overall appearance clearly not dictated by function.” *High Point Design*, 730 F.3d at 1315. “[A]vailability of alternative designs [i]s an important—if not dispositive—factor in evaluating the legal functionality of a claimed design.” *Ethicon*, 796 F.3d at 1329–30. If there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose. *Id.* at 1330. In other words, if other designs could produce the same or similar functional capabilities, the design of the article in question is likely ornamental, not functional. *Id.*

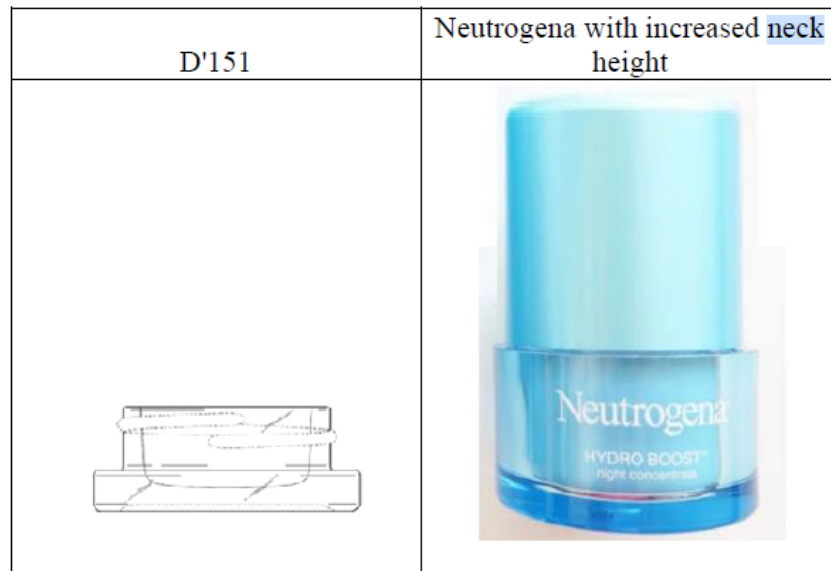
Here, the height of the neck serves a useful purpose as it encloses a portion of the interior compartment that contains product and, therefore, contributes to the volume of that compartment. However, the present record does not support a finding that, while other neck heights are possible, functionality dictates a certain proportion of base to neck height. Petitioner cites to only one example of a jar having a taller neck than base—the

McKernan Jar—and acknowledges that the McKernan Jar does not include the same base to neck height proportion as does the claimed design. *See* Pet. 94 (explaining why a designer of ordinary skill would modify the proposed combination of the McKernan Jar with Zamberlan to incorporate the same base to neck height proportions as claimed by the '151 patent). Thus, this record does not include any examples of jars having the same base to neck proportions as the claimed design.

Given that alternative base to neck height proportions are available, and Petitioner's failure to persuasively explain why the particular proportion depicted in the '151 patent is preferable to any other, Petitioner has not sufficiently shown that this proportion is primarily functional and should not be considered as part of the ornamental design. *See, e.g., LA Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993) (“When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose.”).

Moreover, we agree with Patent Owner that the differences in proportion between Neutrogena and the claimed design contribute significantly to the overall visual impression of the design. *See* Prelim. Resp. 28 (“[T]he two designs considered as a whole present dramatically different visual appearances.”), 33–36 (“To get from the Neutrogena jar design . . . to the design of the D '151 patent would require entirely changing the proportions of the jar—from a short neck with a tall base to a tall neck with a short base . . .”). For example, Patent Owner creates an image showing that simply changing the height of the Neutrogena jar neck to have the same neck-height to base-height ratio as the '151 patent without changing the

other dimensions of the jar would yield a “ridiculous result.” *Id.* at 37. We agree that the two images, reproduced below, do not convey the same overall visual impression.



This figure contains two images side by side. On the left is a side view drawing of the claimed jar. On the right is a front side image of the Neutrogena jar with the image manipulated to show a neck to base proportion equivalent to that of the claimed jar drawing.

Prelim. Resp. 38. The images above show a figure from the '151 patent, above left, and Patent Owner's created image of Neutrogena, above right, with only the neck height modified to match the proportion of neck to base height shown in the '151 patent. Although we do not necessarily agree with Patent Owner's assertion that the created Neutrogena image represents the proposed combination asserted in the Petition, or that the modified image created by Patent Owner is accurate, we do agree with Patent Owner that the image of the modified Neutrogena jar illustrates that the proportion of neck height to base height contributes to ornamental aspects of the claimed jar and significantly affects the overall visual impression.

Petitioner further argues that, even if not primarily functional, it would have been obvious to a designer of ordinary skill to incorporate a taller neck portion relative to the base portion in order to “adjust the volume within the compartment to either aesthetically illustrate additional product without providing additional product in the compartment” or “to correspond to the cap dimensions” for example, “to include an accessibility tool in the cap.” Pet. 57 (citing Fletcher Decl. ¶ 100).

We are not persuaded by this argument, which does not explain why the particular neck height to base height proportion claimed by the ’151 patent would have been obvious, but instead suggests that any proportion would have been obvious based on the use of the jar. *See* Pet. 57 (“[A] modification of the proportional height would have been minor and not have resulted in any material alteration to other design features of the hypothetical combination.”). Petitioner also does not dispute the finding in the PTAB Appeal Decision that the relevant art field is crowded and “[t]hus, the differences in small details will have more weight than in less crowded arts.” PTAB Appeal Decision 8–9; *see* Pet. 15 (noting, without disputing, the finding in the PTAB Appeal Decision). And, as discussed above, we agree with Patent Owner that the record evidence shows that the differences in proportions between the ’151 patent and the Neutrogena designs are more than *de minimus*. Thus, even combining the visual features of the two references, the skilled artisan would not have arrived at the claimed design.

We are not persuaded to the contrary by Petitioner’s expert testimony. Mr. Fletcher testifies that a designer of ordinary skill would have recognized that the difference in neck to base height proportions in the ’151 patent and Neutrogena “as minimal or an obvious design variant to known designs in

the field based upon known design considerations,” including those functional considerations discussed above. Fletcher Decl. ¶¶ 90, 100. However, Mr. Fletcher does not support this conclusion with any objective evidence, such as pointing to prior art with similar base to neck height proportions, or otherwise explain why a designer of ordinary skill in the art would have chosen to use the particular proportions claimed by the ’151 patent as opposed to all other possible configurations, including those illustrated by Neutrogena and Canamasas Puigbo. *See id.* ¶¶ 83–101. Mr. Fletcher also does not persuasively address how the neck to base height proportions affect the overall visual impression of the claimed jar. *Id.* Moreover, “expert testimony cannot take the place of disclosure from patents or printed publications.” U.S. Patent Trial and Appeal Board, Consolidated Trial Practice Guide 36 (Nov. 2019) (“2019 Trial Practice Guide”). While an expert “may explain ‘patents and printed publications,’ [expert testimony] is not a substitute for disclosure in a prior art reference itself.” *Id.*

Accordingly, even after combining the visual features of Neutrogena and Canamasas Puigbo as proposed by Petitioner, record evidence does not support Petitioner’s assertion that a designer of ordinary skill in the art would have found it obvious to modify Neutrogena such that its neck to base height proportions are the same as that claimed by the ’151 patent.

c. The Interior Compartment

We agree with Patent Owner that the depth of the interior compartment cannot be determined based on the images contained in Neutrogena. Petitioner provides annotated images, reproduced below, to illustrate the assertion that Neutrogena’s “vertical sidewalls . . . define the

compartment transition via curved edges to a slightly concave bottom surface of the compartment located in the base portion of the container.” Pet. 45–46 (citing Fletcher Decl. ¶ 85).

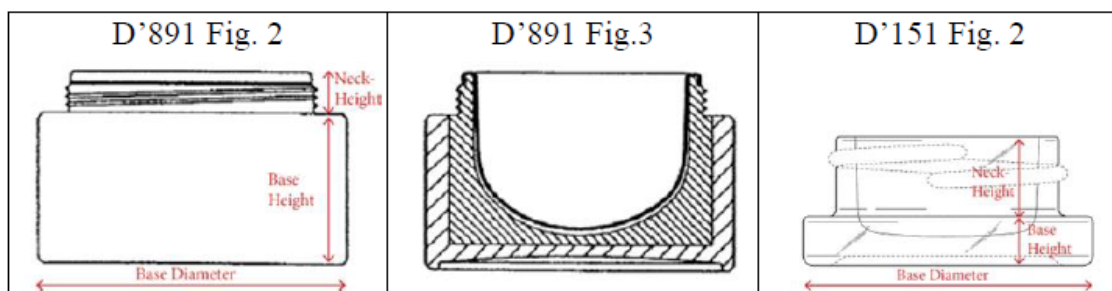


This figure includes a label “Neutrogena” and two side-by-side images on the Neutrogena jar. The left image is an annotated front side view with the cap on the jar pointing to a portion of the neck and the base of the jar labeled “Compartment (within neck)” and to a point near the bottom of the jar labeled “Radiused Transition.” The image on the right is from the top view with the cap off and is annotated “Compartment.”

Pet. 44. Although Mr. Fletcher testifies that “[a] designer of ordinary skill in the art can visually see the concave nature of each of the ’151 Patent and Neutrogena through the above images, and further recognize that radiused edge transitions would naturally yield to a certain extent concave bottom surfaces” (Fletcher Decl. ¶ 85), we are not persuaded that simply understanding that the bottom of the compartment is concave is enough to show that the shape and depth of the Neutrogena compartment is the same as that shown in the ’151 patent. Instead, we agree with Mr. Rake’s testimony that “photos taken through the transparent base of the Neutrogena jar distort any internal features,” such that it is impossible to tell “with any degree of precision the specific shape” of the interior compartment. Rake Decl. ¶ 41.

In the alternative, Petitioner points to Canamasas Puigbo as explicitly disclosing a concave bottom surface of a compartment. *Id.* at 56. According to Petitioner, “to the extent Patent Owner argues Neutrogena fails to explicitly show a container having a concave bottom surface,” a designer of ordinary skill would have been motivated to incorporate such a bottom surface “for at least the simple function of pooling the contents to ensure use of and accessibility to all the contents” and because “it would be more aesthetically pleasing to include a minor radius of curvature of a concave bottom surface, especially in light of the tubular design of the Neutrogena container.” *Id.* (citing Fletcher Decl. ¶ 97).

Petitioner’s arguments fail to address the difference in the shape and depth of the interior compartment of the ’151 patent and Canamasas Puigbo. We agree with Patent Owner that the depth of that cavity in Canamasas Puigbo is different than that in the ’151 patent. *See* Prelim. Resp. 28–30. Patent Owner provides a side-by-view, reproduced below, of Figures 2 and 3 of Canamasas Puigbo and Figure 2 of the ’151 patent.



This figure has three side-by-side drawings. The drawing on the left is labeled “D’891 Fig. 2” and shows a front side view of Canamasas Puigbo’s jar. It is annotated with “Base Diameter,” “Base Height,” and “Neck Height.” The middle drawing is a side view showing the interior of Canamasas Puigbo’s jar and is labeled “D’891 Fig. 3.” The drawing on the right is labeled “D’151 Fig. 2” and is a drawing showing the front side view of

the claimed jar with annotations “Neck Height,” “Base Height,” and “Base Diameter.”

Prelim. Resp. 30. Figure 3 of Canamasas Puigbo, above middle, shows an interior compartment with a highly rounded bottom that extends through a significant portion of the base ending just above the exterior of the jar.

Figure 2 of the ’151 patent, above right, in contrast, shows an interior compartment with a flatter bottom that extends less than halfway into the base and ends with more space between it and the exterior of the jar.

We find these aspects of the design significantly affect the overall visual impression of an otherwise simple design, particularly in an otherwise crowded art. Petitioner addresses these differences by stating that a designer of ordinary skill in the art “would have understood that different degrees of radius for the concave bottom surface would be a design choice for volume and accessibility to the contents, especially together with the radiused transition between the sidewall and bottom surface.” Pet. 56 (citing Fletcher Decl. ¶ 98). However, the present record does not support a finding that, even though other interior compartment shapes and depths are available, functionality dictates a certain shape and depth. Petitioner cites no other prior art that shows an interior compartment with a shape and depth equivalent to that shown in the ’151 patent. *See* Pet. 28–29 (showing annotated versions of Huang’s drawings, which do not clearly show the shape or depth of the interior compartment), 63 (proposing to modify Huang’s two chamber interior compartment with that of Canamasas Puigbo), 85–88 (showing the McKernan Jar drawings, which do not indicate the shape or depth of the interior compartment); Ex. 2002, 13 (explaining that

the interior of Zamberlan is different in shape and depth than the claimed design).

We are not persuaded to the contrary by Petitioner’s expert testimony. Mr. Fletcher testifies that Canamasas Puigbo “explicitly discloses a concave bottom surface in an article having *more visually similar design*, which would provide ample motivation to incorporate the feature.” Fletcher Decl. ¶ 98 (emphasis added). Thus, Mr. Fletcher appears to agree that the shape of the Canamasas Puigbo’s internal compartment is noticeably different than that of the ’151 patent. Mr. Fletcher does not address why a designer of ordinary skill in the art would have overlooked these differences or found them so minimal as to not affect the overall impression of the resulting modified jar. For example, Mr. Fletcher does not support this conclusion with any objective evidence, such as pointing to other prior art with an interior compartment the same shape and depth as that of the ’151 patent. Nor does Mr. Fletcher otherwise explain why a designer of ordinary skill in the art would have chosen to use the particular shape and depth claimed by the ’151 patent as opposed to all other possible configurations. *See, id.* ¶¶ 83–101. Moreover, as noted above, “expert testimony cannot take the place of disclosure from patents or printed publications.” 2019 Trial Practice Guide at 36.

Accordingly, even after combining the visual features of Neutrogena and Canamasas Puigbo as proposed by Petitioner, the record evidence does not support Petitioner’s assertion that a designer of ordinary skill in the art would have found it obvious to modify Neutrogena such that its internal compartment is the same shape and depth as claimed by the ’151 patent.

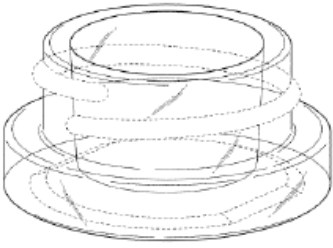
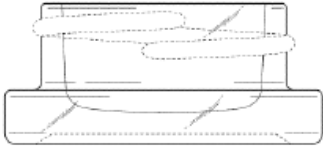
d. Conclusion

For all the reasons expressed above, we find that Petitioner fails to demonstrate that an ordinary designer would have been motivated to modify Neutrogena or Canamassas Puigbo to create a jar with the same overall visual appearance as the claimed design. Accordingly, Petitioner fails to demonstrate a reasonable likelihood that the claimed design would have been obvious over Neutrogena and Canamasas Puigbo.

2. Huang, Canamasas Puigbo, and Zamberlan

a. The Proposed Ground

Petitioner asserts that the '151 patent's claim would have been obvious over Huang in view of Canamasas Puigbo and Zamberlan. Pet. 58–72. Petitioner provides the following table showing Figures 1 and 2 of the '151 patent and Huang.

Figure #	'D151	Huang
1		
2		

This figure is a table with two rows and three columns. Row 1 shows Figure 1 of the '151 patent on the left and Figure 1 of Huang on the right. Row 2 shows Figure 2 of the '151 patent on the left and Huang on the right.

Pet. 59. The Petition asserts that Huang, like the '151 patent, “has a base portion with a greater diameter than the neck portion, with the tubular neck portion extending vertically from the top surface of the base portion.” *Id.* at 60. Petitioner also notes that Huang “discloses flat horizontal top surfaces of the tubular base portion and non-cornered transitions of the top and bottom surfaces and the sidewall of the base portion.” *Id.* at 60–61. Petitioner also points out that Huang’s opening at the top of the neck shows an interior compartment. *Id.* at 62.

Petitioner acknowledges that Huang’s interior compartment includes a “dual chamber” *Id.* at 63. According to Petitioner, this is a “minor difference” and would not have distracted a designer of ordinary skill from understanding the '151 patent and Huang to have the “same overall visual appearance.” *Id.* (citing Fletcher Decl. ¶ 107). Petitioner adds that using a dual chamber instead of a single chamber would have been “known and used as obvious variants” to a designer of ordinary skill “driven by a number of different functional requirements.” *Id.* Petitioner also points to the interior compartment of Canamasas Puigbo and argues that a designer of ordinary skill “would have been motivated to simply substitute Huang’s compartment shape with Canamasas Puigbo’s” in order to “increase volume within the chamber, provide a wider chamber diameter, ease manufacture, and provide an aesthetically symmetrical appearance of the internal compartment and external tubular container.” *Id.* at 68 (citing Fletcher Dec. ¶¶ 116–117).

Petitioner also acknowledges that Huang is opaque. *Id.* at 63. Petitioner points to Zamberlan as disclosing transparency, stating it was a known feature and a designer of ordinary skill “would not have determined such a feature to materially differentiate articles that are otherwise fully

externally visible.” *Id.* Petitioner adds that “transparency is a functional feature,” further arguing that “the transparency of the design claim should be given little if any patentable weight.” *Id.* at 63–64 (citing Ex. 1003, 261) (noting Patent Owner’s acknowledgement, during prosecution, of the functional aspects of transparency).¹¹

Petitioner adds that “to the extent that Huang does not explicitly disclose sufficiently radiused edges either internally or externally,” a designer of ordinary skill would have found it obvious based on “either Canamasas Puigbo or background knowledge to modify Huang such that the edges of the bottom tubular portion, transition between top surface of bottom portion and sidewalls of top portion, transition between top portion sidewalls and top surface, and other non-cornered transitions would be radiused transitions.” *Id.* at 70 (citing Fletcher Decl. ¶¶ 116–119).

b. Proportional Height of Base and Neck

Petitioner acknowledges that the neck of the claimed design is taller than the base portion, but this is not case in Huang, Canamasas Puigbo, or

¹¹ Although not essential to the outcome of this analysis, we note that we do not agree that the element of transparency is primarily functional such that it does not limit the design claim. Although we agree that transparency can serve a useful purpose by allowing the contents of the jar to be visible from the outside, it also contributes to the overall visual impression of the jar. *See, e.g.*, Ex. 2002, 9 (“We agree with the Appellant that the overall visual impression of the claimed jar design as a transparent jar conveys an impression of openness and clarity that is lack in the frosted finish of McKernan’s jar, which creates a visual impression of being masked or visually closed from the outside due to the prominent opaque base.”). It is, therefore, proper to take the element of transparency into account when defining the scope of ’151 patent as its overall ornamental visual impression. *Sport Dimension*, 820 F.3d at 1320–1321.

Zamberlan. *See* Pet. 64 (stating “the neck portion of [the ’151 patent] is slightly vertically longer than the height of the base portion,” however, “minor adjustments in proportions absent a criticality would not have been seen by a [designer of ordinary skill] to substantially modify the overall visual appearance of the design”). More specifically, we agree with Patent Owner that the height of Huang’s base is slightly more than the height of the neck. Prelim. Resp. 14 (citing Rake Decl. ¶¶ 46, 49). Similarly, we agree that Canamasas Puigbo has a tall base with a short neck and Zamberlan has a relatively tall base with a shorter neck. Prelim. Resp. 14–16 (citing Rake Decl. ¶¶ 51–55).

Petitioner reiterates the argument that the base to neck height proportions of the jar would be considered a “functional difference” by a designer of ordinary skill such that any such differences are either irrelevant or obvious. *See* Pet. 64. We are not persuaded by these arguments for the reasons discussed above in Section II.C.1.b.

c. The Interior Compartment

Petitioner’s arguments also fail, as described above in Section II.C.1.c, to address the difference in the shape and depth of the interior compartment of the ’151 patent and Canamasas Puigbo. We agree with Patent Owner that the full shape and depth of the interior compartment cannot be seen in Huang and the shape and depth of that cavity in Canamasas Puigbo is different than that in the ’151 patent. *See* Prelim. Resp. 28–30.

d. Conclusion

For all the reasons expressed above, we find that Petitioner fails to demonstrate that an ordinary designer would have been motivated to modify

Huang, Canamassas Puigbo, or Zamberlan to create a jar with the same overall visual appearance as the claimed design. Accordingly, Petitioner fails to demonstrate a reasonable likelihood that the claimed design would have been obvious over Huang, Canamasas Puigbo, and Zamberlan.

3. *Huang and Neutrogena*

Petitioner asserts that the '151 patent's claim would have been obvious over Huang in view of Neutrogena. Pet. 72–84. This ground is similar to the ground, discussed in Section II.C.2 above, proposing a combination of Huang, Canamasas Puigbo, and Zamberlan. For this ground, Petitioner relies on Neutrogena instead of (1) Zamberlan for the element of transparency and (2) Canamasas Puigbo for a single chamber compartment with “a concave bottom surface.” Pet. 79–81.

This ground suffers from the same deficiencies as the two grounds described above in Sections II.C.1–2. Both Huang and Neutrogena have a taller base portion than the neck portion. *See* Ex. 1007; Ex. 1014; Ex. 1015; Ex. 1016. Petitioner again relies on the assertion that “incorporating a taller neck portion than base portion” is primarily functional or would have been an obvious modification. Pet. 82–83. As discussed in detail in Sections II.C.1.b and II.C.2.b, record evidence does not support Petitioner's assertion that a designer of ordinary skill in the art would have found it obvious to modify Huang such that its neck to base height proportions are the same as that claimed by the '151 patent.

In addition, both Huang and Neutrogena fail to show, with any detail, the shape and depth of the interior compartment. As discussed above in Section II.C.1.c, we agree with Patent Owner that Neutrogena does not sufficiently show the shape and depth of the interior compartment. *See*

Prelim. Resp. 28–30. Accordingly, even after combining the visual features of Huang and Neutrogena as proposed by Petitioner, the record evidence does not support Petitioner’s assertion that a designer of ordinary skill in the art would have found it obvious to modify Huang with Neutrogena such that the resulting internal compartment is the same shape and depth as claimed by the ’151 patent.

For all the reasons expressed above, we find that Petitioner fails to demonstrate that an ordinary designer would have been motivated to modify Huang or Neutrogena to create a jar with the same overall visual appearance as the claimed design. Accordingly, Petitioner fails to demonstrate a reasonable likelihood that the claimed design would have been obvious over Huang and Neutrogena.

4. *McKernan and Zamberlan*

Petitioner asserts that the ’151 patent’s claim would have been obvious over McKernan in view of Zamberlan. Pet. 84–95. This is the same combination of references addressed in the PTAB Appeal Decision. *See* Ex. 2002. According to Petitioner, the PTAB Appeal Decision “was a narrow holding based on *Rosen-Durling*” and “did not address or weigh expert opinion.” Pet. 14–15.

Patent Owner argues that although the PTAB Appeal Decision was issued under the *Rosen-Durling* test, “its conclusion was not constrained by *Rosen-Durling* and is equally valid” even after *LKQ*. Prelim. Resp. 50. We agree with Patent Owner that the PTAB Appeal Decision went beyond determining the *Rosen-Durling* test requirements. In addition to finding that under the *Rosen-Durling* test McKernan was not a suitable primary reference and that Zamberlan was not “so related” such that it qualified as a

secondary reference, the Board also expressly found that “even if the references were combined, we agree with Appellant that the interior chamber of Zamberlan is visually different than the interior of the claimed design” and “[t]hus, even in combining the visual features of the two references, the skilled artisan would not have arrived at the claimed design.” Ex. 2002, 12–13.

Petitioner does not explicitly dispute this finding by the Board, but asserts that any such difference in interior compartment shape and depth is “*de minimus* and would have been obvious as mere design choices to a skilled designer.” Pet. 91 (citing Fletcher Decl. ¶ 151). According to Petitioner, a designer of ordinary skill “would have been motivated to incorporate such a concave shape for at least the simple function of pooling the contents of the jar to ensure use of and accessibility to all of the contents, especially to facilitate access to the contents, such as when using a finger.” *Id.* at 91–92 (citing Fletcher Decl. ¶ 152). Petitioner also points to Canamasas Puigbo as an example that “containers with interior compartments that have a sloped sides and minor radius of curvature of a concave bottom surface are well known in the art.” *Id.* at 92.

We agree with Patent Owner that Petitioner’s assertions do not sufficiently solve the interior compartment deficiency noted by the PTAB Appeal Decision. First, we agree with Patent Owner that, as noted by the PTAB Appeal Decision, Zamberlan’s interior compartment has a different shape and depth than that of the ’151 patent. Prelim. Resp. 9 (quoting Ex. 2002, 13). Second, as discussed in Sections II.C.1.c and II.C.2.c above, the shape and depth of Canamasas Puigbo’s interior compartment is noticeably different than that of the ’151 patent and Petitioner’s expert testimony is not

sufficient to explain why a designer of ordinary skill in the art would have chosen to use the particular shape and depth claimed by the '151 patent as opposed to all other possible configurations.

In addition, this ground suffers from the same problem as the other grounds with respect to base to neck height proportions. As discussed in Section II.C.1.c, although McKernan shows the only jar in the record with a neck that is taller than the base, it does not include the same base to neck height proportion as does the claimed design. *See* Pet. 94. And, as discussed in detail above, we do not agree that this element of the design is primarily functional or that the record supports a finding that difference from the claimed proportion is *de minimus* or would have been obvious. *See* Pet. 94–95 (citing Fletcher Decl. ¶¶ 157–159); Prelim. Resp. 54–55 (citing Rake Decl. ¶¶ 60, 95).

For all the reasons expressed above, we find that Petitioner fails to demonstrate that an ordinary designer would have been motivated to modify McKernan or Zamberlan to create a jar with the same overall visual appearance as the claimed design. Accordingly, Petitioner fails to demonstrate a reasonable likelihood that the claimed design would have been obvious over Huang and Neutrogena.

III. CONCLUSION

For the reasons set forth above, we determine that Petitioner has not shown a reasonable likelihood that it would prevail with respect to the claimed design of the '151 patent.

IV. ORDER

Accordingly, it is:

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

IPR2024-01138
Patent D781,151 S

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