

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ATHENA AUTOMATION LTD.,  
Petitioner,

v.

HUSKY INJECTION MOLDING SYSTEMS LTD.,  
Patent Owner.

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Case IPR2013-00169  
Patent 5,624,695

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Before JENNIFER S. BISK, MICHAEL J. FITZPATRICK, and  
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

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

## I. INTRODUCTION

### A. Background

Petitioner Athena Automation Ltd. filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1-17 (“the challenged claims”) of U.S. Patent No. 5,624,695 (Ex. 1001, “the ’695 patent”). 35 U.S.C. §§ 311-319. Patent Owner Husky Injection Molding Systems Ltd. waived the filing of a Preliminary Response. Paper 7. On July 30, 2013, the Board instituted trial (Paper 8, “Decision to Institute”), concluding that Petitioner had shown a reasonable likelihood of showing that the challenged claims were unpatentable based on the following grounds:

| Reference[s] <sup>1</sup> | Basis | Claims challenged |
|---------------------------|-------|-------------------|
| Queré                     | § 102 | 1-11 and 14       |
| Arend                     | § 102 | 1-4 and 14-17     |
| Arend and Queré           | § 103 | 5-13              |
| Arend, Queré, and Kushibe | § 103 | 13                |
| Stüdli                    | § 102 | 1, 2, and 14-17   |
| Stüdli and Queré          | § 103 | 9-13              |

After institution of trial, Patent Owner filed a Response. Paper 22 (“PO Resp.”). Patent Owner also filed a Motion to Amend claims by submitting proposed new claims 18-34 for claims 1-17. Paper 24 (“Mot. to Amend”). Petitioner filed a Reply to the patent owner response (Paper 33, “Reply”) and an Opposition to Patent Owner’s Motion to Amend (Paper 34, “Opp. Mot. to Amend”). Patent Owner then filed a Reply in support of its

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<sup>1</sup> U.S. Patent No. 2,976,569 (Ex. 1002) (“Queré”); U.S. Patent No. 5,417,913 (Ex. 1003) (“Arend”); U.S. Patent No. 2,711,561 (Ex. 1004) (“Stüdli”); and U.S. Patent No. 4,874,309 (Ex. 1006) (“Kushibe”).

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Motion to Amend (Paper 40, “Reply Mot. to Amend”). Oral hearing was held April 28, 2014, a transcript of which appears in the record. Record of Oral Hearing, Paper 50 (“Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Petitioner has shown, by a preponderance of evidence, that claims 1-17 are *unpatentable*.

Patent Owner’s Motion to Amend claims is *denied*.

#### *B. Related Proceedings*

The parties simultaneously are involved in two other *inter partes* reviews based on patents claiming similar subject matter. IPR2013-00167 involves U.S. Patent No. 5,620,723 (“the ’723 patent”) and IPR2013-00290 involves U.S. Patent No. 7,670,536. The ’695 patent shares much of the specification of the ’723 patent. In a separate decision, we conclude that claims 21-37 of the ’723 patent are unpatentable as obvious over combinations of some of the same references raised in this proceeding: Queré, Arend, and Stüdli. IPR2013-00167, Paper 51 (“the 2013-00167 Decision”). The Petition in IPR2013-00290 was filed several months after the other two petitions and is currently scheduled for oral hearing on July 22, 2014.

#### *C. The ’695 Patent*

The technology of the ’695 patent is the same as that of the ’723 patent and is described in the 2013-00167 Decision at pages 3-5. For the purposes of this decision, we adopt that description.

*D. Illustrative Claims*

Claim 1 is the only independent claim of the '695 patent. Claims 1, 12, and 13, reproduced below, are illustrative of the claimed subject matter:

1. A securing assembly for use with a first platen of an injection molding machine, comprising:

means for connecting said first platen to another platen;

and

means for securing said first platen to said means for connecting and adapted to be attached to said first platen, wherein said means for securing includes engagement means for placing said means for securing into and out of locking engagement with said means for connecting upon rotation of said means for securing, such that when said engagement means is out of locking engagement with said means for connecting, said means for securing and said means for connecting are relatively movable.

12. The securing assembly according to claim 11,

wherein said first platen is adapted to be forced in a direction for achieving clamping with said another platen

and wherein said first platen has a bore for receiving said means for securing,

wherein said means for conveying has an outer surface configured to form cavities between said outer surface and said bore and has surfaces extending substantially transversely to said direction, said cavities for the introduction of pressurized fluid and said surfaces for the receipt of pressure from said pressurized fluid thereagainst.

13. The securing assembly according to claim 12, wherein said first platen is a moveable platen.

## II. ANALYSIS

### A. Assignor Estoppel

Patent Owner argues that Petitioner is barred from challenging the validity of the '695 patent by assignor estoppel. PO Resp. 37-59. Patent Owner contends that Mr. Robert Schad, one of the named inventors of the '695 patent, is the founder, co-owner, President, Chief Executive Officer, and one of two directors on the Board of Directors of Petitioner and is, therefore, in privity with Petitioner. *Id.* at 37-39. Thus, according to Patent Owner, Petitioner is estopped from challenging the patentability of the '695 patent under the doctrine of assignor estoppel. *Id.*

We have determined previously, in the related proceeding, IPR2013-00290, that assignor estoppel is not a basis for denying a petition requesting *inter partes* review:

Under the AIA, “a person *who is not the owner of a patent* may file with the Office a petition to institute an *inter partes* review of the patent.” 35 U.S.C. § 311(a) (emphasis added). Consequently, under the statute, an assignor of a patent, who is no longer an owner of the patent at the time of filing, may file a petition requesting *inter partes* review. This statute presents a clear expression of Congress’s broad grant of the ability to challenge the patentability of patents through *inter partes* review.

*Athena Automation Ltd. v. Husky Injection Molding Sys. Ltd.*, IPR2013-00290, slip op. at 12-13 (PTAB Oct. 25, 2013) (Paper 18); *see also Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, slip op. at 11-14 (PTAB Dec. 19, 2013) (Paper 16).

Patent Owner does not persuade us otherwise in this proceeding. Specifically, we are not persuaded by Patent Owner’s argument that 37 C.F.R. § 42.101(c), enacted pursuant to 35 U.S.C. §§ 312 and 316, modifies the broad statutory language of § 311. *See* PO Resp. 45-50. We

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