

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN KEAN SILICONE PRODUCT CO., LTD.,
Petitioner,

v.

PKOH NYC, LLC,
Patent Owner.

Case IPR2017-01327
Patent 7,959,036 B2

Before MITCHELL G. WEATHERLY, JAMES A. TARTAL,
and ROBERT L. KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

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

Shenzhen Kean Silicone Product Co., Ltd. (“Petitioner”) filed a Petition (Paper 1, “the Petition” or “Pet.”)¹ to institute an *inter partes* review of claims 1–7, 10–15, 20–32, and 35–38 of U.S. Patent No. 7,959,036 B2 (Ex. 1001, “the ’036 patent”). PKOH NYC, LLC (“Patent Owner”) filed a Preliminary Response (Paper 11, “Prelim. Resp.”).

Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we instituted an *inter partes* review, but not as to all challenged claims or as to all alleged grounds of unpatentability. (Paper 14, “Dec.,” 44).

During the trial, Patent Owner filed a Patent Owner Response (Paper 18, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner Response (Paper 24, “Pet. Reply”). An oral hearing was held on August 29, 2018, and a copy of the transcript has been made part of the record. Paper 32 (“Tr.”).

On April 24, 2018, the Supreme Court determined that a decision to institute under 35 U.S.C. § 314 may not institute review of fewer than all claims challenged in the petition. *SAS Inst. Inc. v. Iancu*, 138 S.Ct. 1348, 1359–60 (2018). On April 26, 2018, the Office issued Guidance on the Impact of SAS on AIA Trial Proceedings, which states that “if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.” <https://www.uspto.gov/patents-application-process/patent-trial->

¹ See Decision on Institution, Paper 14, 2–4 (determining that we only consider those grounds and arguments presented in the original Petition (Paper 1) and expunging the First Amended Petition and the Second Amended Petition from the proceeding as unauthorized filings).

and-appeal-board/trials/guidance-impact-sas-aia-trial. Subsequently, on April 30, 2018, we issued an Order modifying the Decision on Institution “to institute on all of the challenged claims and all of the grounds presented in the Petition.” Paper 19, 2.

Pursuant to our authorization (Paper 21), the parties thereafter filed a “Joint Motion to Limit Proceeding” (Paper 22), requesting that we “limit[] the *inter partes* review proceeding IPR2017-01327 to the grounds and claims instituted on December 6, 2017, in the Decision on Institution (Paper 14).” Paper 22, 2. Specifically, the parties requested that the proceeding be limited to the following claims and grounds:

Reference	Basis	Claim(s)
Cho	§ 103	1, 2, 14, 21, 22, 24, and 26
Cho and Mueller	§ 103	1, 3–6, 10–13, 20, and 28–32
Cho, Mueller, and Rohr	§ 103	31, 32, and 35–38
Cho and Raja	§ 103	7
Cho and Trecek	§ 103	24 and 26

Paper 22, 4; *see also* Paper 14, 44. On May 24, 2018, we granted the Parties’ Joint Motion to Limit Proceeding. Paper 23, 2. Accordingly, this Decision addresses only the claims and grounds set forth above.

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the claims for which we instituted trial. Based on the final trial record, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 1, 2–7, 10–13, 20–22, 24, 26, 28–32, and 35–38 of the ’036 patent are unpatentable. Petitioner has not shown that claim 14 is unpatentable.

I. BACKGROUND

A. *The '036 Patent (Ex. 1001)*

The '036 patent is titled “Elastomeric Dispensing Container” and is directed to “[a]n elastomeric dispensing container for a fluid.” Ex. 1001, [54], [57]. The invention “relates broadly to containers for storing and dispensing fluids, [and] specifically to such containers of the type utilizing an elastomeric receptacle and a dispensing cap.” *Id.* at 1:17–19. As explained by the '036 patent, “it is an object and advantage of the present invention to provide an elastomeric dispensing container comprising an elastomeric receptacle and a dispensing cap in secure and substantially fluid-tight engagement which also facilitates attachment and detachment of the cap.” *Id.* at 1:53–57. The elastomeric receptacle defines an internal chamber and has “an integrally formed gasket extending radially from an opening formed on a lower end and a receptacle neck providing communications between the chamber and the opening.” *Id.* at 1:66–2:4. A cap having a lid covers the receptacle opening. *Id.* at 2:4–10.

The “flexible and resilient” receptacle 200, depicted below in Figure 2B, is described as being made of an “elastomeric material,” “preferably silicone for its favorable mechanical properties and chemical inertness, although any other suitable elastomeric material could be used.” *Id.* at 2:55–57.

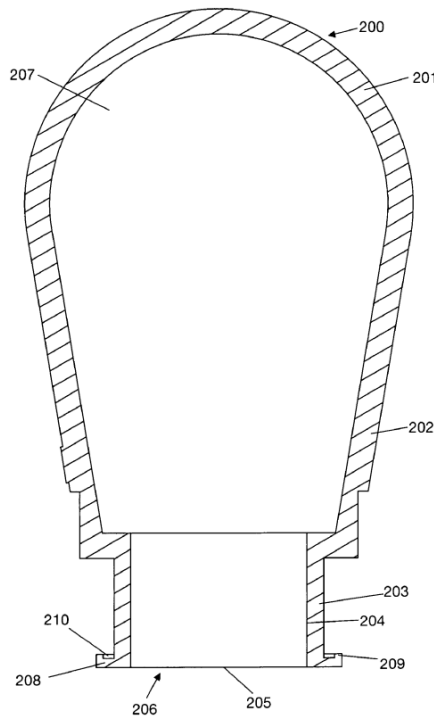


FIG. 2B

Figure 2B is a side cross-sectional view of an elastomeric receptacle. The elastomeric wall portion of the receptacle is configured to be “resiliently deformable and which has a predetermined, non-deformed configuration.” *Id.* at 5:9–20; *see also id.* at 2:59–63 (“The elastomeric material is . . . of an appropriate durometer . . . to make the squeeze bulb 200 substantially deformable yet resilient”). The wall portion returns to the “predetermined, non-deformed” configuration after being compressed by the user. *Id.* at 5:9–20

B. Illustrative Claim

Claims 1 and 31 are independent and claim 1 is illustrative of the claims at issue:

1. An elastomeric dispensing container for a fluid comprising:
a flexible and resilient receptacle composed of an elastomeric material defining a chamber therein;

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