

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED INDUSTRIES CORPORATION,
Petitioner,

v.

SUSAN McKNIGHT, INC.,
Patent Owner.

Case IPR2017-01686
Patent 9,253,973 B2

Before JAMES A. TARTAL, TIMOTHY J. GOODSON, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

FINAL WRITTEN DECISION AND
ORDER DENYING MOTION TO AMEND
Inter Partes Review

35 U.S.C. §§ 316(d), 318(a) and 37 C.F.R. §§ 42.73, 42.121

I. INTRODUCTION

United Industries Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1–17 of U.S. Patent No. 9,253,973 B2 (Ex. 1001, “the ’973 patent”) owned by Susan McKnight, Inc. (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6(c) to hear this *inter partes* review instituted pursuant to 35 U.S.C. § 314. In this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, we find on the record before us that Petitioner has shown by a preponderance of the evidence that claims 1–17 of the ’973 patent are unpatentable. *See* 35 U.S.C. § 316(e). Further, Patent Owner’s Motion to Amend, which it filed “in an abundance of caution,” is denied as unnecessary and nonresponsive because we adopt the proposed claim construction for existing claims 1 and 16 that Patent Owner sought to make explicit through proposed amended claims.

A. PROCEDURAL HISTORY

Petitioner filed a Petition requesting institution of *inter partes* review of claims 1–17 of the ’973 patent on six grounds of alleged unpatentability. Pet. 3–4. Patent Owner filed a Preliminary Response (Paper 6, “Prelim. Resp.”). We initially instituted review of all challenged claims because we determined the Petition showed a reasonable likelihood that Petitioner would prevail as to the challenged claims on the following four grounds:

References	Basis	Claims Challenged
Jennerich, ¹ Lyng, ² and Jennings ³	§ 103	1–17
Anderson, ⁴ Dempster, ⁵ and Lang ⁶	§ 103	1–3, 7, 10, 14, 16, and 17
Anderson, Dempster, Lang, and Lyng	§ 103	4–6, 10, 11, 14, and 15
Anderson, Dempster, Lang, and Metcalfe ⁷	§ 103	8, 9, 12, and 13

Paper 7 (“Inst. Dec.”); *see also* 35 U.S.C. § 314.

After institution of *inter partes* review, Patent Owner filed a Response to the four grounds instituted. Paper 15 (“PO Resp.”). Patent Owner also filed a Motion to Amend contingent on a finding of unpatentability as to either claim 1 or claim 16. Paper 16 (“Mot. Amend”).

Subsequent to the Patent Owner Response, the Supreme Court held in *SAS Institute Inc. v. Iancu* that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. 138 S. Ct. 1348, 1359–60 (2018). In light of the Guidance on the Impact of SAS on

¹ U.S. Patent No. 2,167,978, issued August 1, 1939 (Ex. 1002, “Jennerich”) (citations to Jennerich are to the first or second page of text, then the first or second column of text on that page, followed by the line numbers).

² U.S. Patent App. No. 2005/0138858 A1, published June 30, 2005 (Ex. 1007, “Lyng”).

³ U.S. Patent No. 400,460, issued April 2, 1889 (Ex. 1006, “Jennings”) (citations to Jennings are to the page number and line number).

⁴ U.S. Patent No. 5,996,531, issued December 7, 1999 (Ex. 1003, “Anderson”).

⁵ U.S. Patent No. 1,024,767, issued April 30, 1912 (Ex. 1024, “Dempster”) (citations to Dempster are to the page number and line number).

⁶ U.S. Patent App. No. 2007/0044372 A1, published March 1, 2007 (Ex. 1008, “Lang”).

⁷ U.S. Patent No. 7,299,587 B1, issued Nov. 27, 2007 (Ex. 1012, “Metcalf”).

AIA Trial Proceedings⁸ issued by the Office, which states that “if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition,” we modified the Institution Decision to include review of all challenged claims on all grounds asserted in the Petition. Paper 17, 2. In particular, we further instituted review on the following claims and bases asserted in the Petition:

References	Basis	Claims Challenged
Denton, ⁹ Jennerich, and McKnight ’812 ¹⁰	§ 103	1–17
McGrath ¹¹ and Lyng	§ 103	1–7, 10, 11, and 14–17

Id. at 3–4. We also authorized Patent Owner to file supplemental briefing in response to the additional instituted grounds. Paper 18, 2–3.

Patent Owner filed a Supplemental Patent Owner Response to address grounds not addressed in the Patent Owner Response. Paper 19 (“PO Supp. Resp.”). Petitioner filed an Opposition to the Motion to Amend (Paper 22, “Opp. Mot. Amend) and a Reply addressing all six grounds instituted (Paper 23 (“Pet. Reply”)). Patent Owner filed a Surreply. Paper 25 (“PO Surreply”). Oral argument was held before the Board on October 18, 2018. Paper 33 (“Tr.”).

⁸ Available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

⁹ U.S. Patent No. 223,321, issued January 6, 1880 (Ex. 1004, “Denton”) (citations to Denton are to the page number and line number).

¹⁰ U.S. Patent No. 8,966,812 B2, issued March 3, 2015 (Ex. 1013, “McKnight ’812”).

¹¹ U.S. Design Patent No. 335,940, issued May 25, 1993 (Ex. 1005, “McGrath”).

B. RELATED MATTERS

The parties indicate that the '973 patent was asserted in a case captioned *Susan McKnight, Inc. v. United Industries Corp.*, No. 2:16-cv-02534-JPM-tmp (W.D. Tenn.). Pet. 1; Paper 4, 2. According to Petitioner, that proceeding was transferred to the Eastern District of Missouri, captioned *Susan McKnight, Inc. v. United Industries Corp.*, No. 4:18-cv-00338-RLW (E.D. Mo.), and stayed pending resolution of this *inter partes* review and the *inter partes* review of related U.S. Patent No. 9,066,511 B2 challenged by Petitioner in IPR2017-01687. Paper 14, 3.

C. REAL PARTIES IN INTEREST

Petitioner identifies United Industries Corporation and Spectrum Brands, Inc. as real parties in interest. Pet. 1. Patent Owner identifies itself and Purdue Research Foundation as real parties in interest. Paper 4, 2; Paper 14, 2–3.

II. BACKGROUND

The '973 patent, titled “Crawling Arthropod Intercepting Device and Method,” issued February 9, 2016, from U.S. Application No. 12/387,645, filed May 5, 2009. Ex. 1001. As background information for the '973 patent, below we provide a summary of the patent, discuss the prosecution history, and provide an illustrative claim. We also identify the proffered witness testimony.

A. SUMMARY OF THE '973 PATENT

The '973 patent generally relates to a device to intercept crawling arthropods and other crawling pests that includes “pitfall trap surfaces that form multiple pitfall traps.” *Id.* at Abstract. In one embodiment, “an intercepting device comprising an exterior, upstanding climbable surface

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