

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZURN INDUSTRIES, LLC,
Petitioner,

v.

SIOUX CHIEF MFG. CO., INC.,
Patent Owner.

Case IPR2018-00973
Patent 8,347,906 B1

Before RAE LYNN P. GUEST, TINA E. HULSE, and AVELYN M. ROSS,
Administrative Patent Judges.

HULSE, *Administrative Patent Judge.*

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

I. INTRODUCTION

Zurn Industries, LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–13 of U.S. Patent No. 8,347,906 B1 (Ex. 1001, “the ’906 patent”). Paper 1 (“Pet.”). Sioux Chief Mfg. Co., Inc. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply to the Preliminary Response (Paper 7, “Reply”), and Patent Owner filed a Surreply (Paper 8, “Surreply”).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Upon considering the arguments and evidence, we determine that Petitioner has not established a reasonable likelihood that it would prevail in showing that at least one of the challenged claims of the ’906 patent is unpatentable. Accordingly, we decline to institute an *inter partes* review of claims 1–13 of the ’906 patent.

A. *Related Proceedings*

Patent Owner has asserted the ’906 patent against Petitioner in a pending lawsuit styled *Sioux Chief Mfg. Co. v. Zurn Industries, LLC*, No. 1:18-cv-00163 (D. Del.). Pet. 1; Paper 4, 2.

Petitioner has concurrently filed a petition for *inter partes* review challenging claims 14–29 of the ’906 patent (IPR2018-00975).

B. *The ’906 Patent*

The ’906 patent relates to a system for installing drain fixtures in concrete slabs or floors using a concrete coring adaptor around which the slab is poured. Ex. 1001, 1:13–17. A drain is typically funnel shaped, with a tapered upper drain head and a lower step adapted for connecting

the drain to an adaptor for a drain pipe in the ground. *Id.* at 1:28–32. The drain head includes a grate at the upper end to prevent large pieces of debris from clogging the drain pipe. *Id.* at 1:32–34.

According to the specification, a typical prior art installation assembly includes a female threaded adaptor that is attached to a vertically extending drain pipe. *Id.* at 1:35–37. A drain with a threaded lower section is threaded into the adaptor. *Id.* at 1:37–38. Then the height of the drain may be minimally adjusted up or down by threading the drain further into or out of the adaptor. *Id.* at 1:38–44. Drains and drain adaptors, which are typically installed before pouring the surrounding concrete slab, are ideally installed at the proper height and so the grate is flush with the finished floor surface. *Id.* at 1:45–50.

The specification describes various disadvantages to the prior art drain assemblies. For example, plumbers often cover the drains with tape or plastic to protect them from being damaged or filled with concrete. *Id.* at 1:50–53. Time is then required to clean the drains and remove the covering after the floor has been poured. *Id.* at 1:53–55. Moreover, prior art drain assemblies often cannot be adjusted once the concrete is poured around the drains and set without chipping away the concrete. *Id.* at 1:63–2:16.

Thus, the specification states “there is an existing need for a system for installing floor drains that provides for easy installation, reduces damage to drain heads during and after pouring the surrounding slab, and provides a ready means for later height adjustment.” *Id.* at 2:17–21.

C. Illustrative Claim

Petitioner challenges claims 1–13 of the '906 patent, of which claims 1 and 10 are independent claims. Claim 1 is illustrative and is reproduced below:

1. A system for mounting a utility access fixture in fluid communication with a conduit, the conduit presenting a free end below the intended surface level of a poured slab, the mounting system comprising:
 - a) a utility access fixture having a fixture head projecting radially outward from a central fixture mounting stem,
 - b) a coring sleeve having a lower portion connectable in fluid communication with said conduit and a bowl projecting outward from said lower portion, said bowl defining a bowl cavity surrounding and opening centrally into a bore extending through said lower portion of said coring sleeve; said coring sleeve sized to removably receive the utility access fixture therein with the fixture head received within said bowl cavity and the central fixture mounting stem extending into said bore extending through said lower portion of said coring sleeve, and
 - c) a cover removably positionable to extend across said bowl cavity above a top surface of the utility access fixture received within the coring sleeve such that an upper surface of said cover extends generally flush with an upper edge of said bowl.

Ex. 1001, 15:54–16:7.

D. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–13 of the '906 patent on the following grounds:

References	Basis	Claims challenged
Izzi ¹ and Castillo ²	§ 103	1, 2, 8, and 9
Izzi, Castillo, and Stone ³	§ 103	3, 4, and 5
Izzi, Castillo, and Papp ⁴	§ 103	7, 10, and 11
Izzi, Castillo, Papp, and Stone	§ 103	6, 12, and 13
Izzi and Svirsky ⁵	§ 103	1, 2, 8, and 9
Izzi, Svirsky, and Stone	§ 103	3, 4, and 5
Izzi, Svirsky, and Papp	§ 103	7, 10, and 11
Izzi, Svirsky, Papp, and Stone	§ 103	6, 12, and 13

Petitioner also relies on the Declaration of Matthew Isaac Stein (Ex. 1021) to support its assertions.

II. ANALYSIS

A. *Person of Ordinary Skill in the Art*

Petitioner asserts that a person of ordinary skill in the art would have had at least a bachelor's degree in mechanical engineering or its equivalent and one year of work experience related to the design, installation, evaluation, or use of plumbing products or systems. Pet. 18 (citing Ex. 1021

¹ Lewis B. Izzi, US 4,067,072, issued Jan. 10, 1978 (“Izzi,” Ex. 1006).

² Castillo et al., US 6,076,559, issued June 20, 2000 (“Castillo,” Ex. 1007).

³ Robert E. Stone, US 3,445,973, issued May 27, 1969 (“Stone,” Ex. 1004).

⁴ David J. Papp, US 4,614,065, issued Sept. 30, 1986 (“Papp,” Ex. 1005).

⁵ Bennet Svirsky, US 2,324,545, issued July 20, 1943 (“Svirsky,” Ex. 1003).

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.