

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DONNELLY DISTRIBUTION LLC
and
RAIMONDI S.P.A.,
Petitioner,

v.

RUSSO TRADING CO., INC.,
Patent Owner.

Case IPR2019-00761
Patent 9,279,259 B1

Before ANDREI IANCU, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*,
SALLY C. MEDLEY, and KEVIN W. CHERRY,
Administrative Patent Judges.

CHERRY, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background*

Donnelly Distribution LLC and Raimondi S.P.A. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 6 and 7 (the “challenged claims”) of U.S. Patent No. 9,279,259 B1 (Ex. 1001, “the ’259 Patent”). Russo Trading Co., Inc. (“Patent Owner” or “Russo Trading”) did not file a Preliminary Response. We have authority to consider the Petition and determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), which provide that an *inter partes* review may not be instituted unless the information presented in the Petition “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.” Having considered the arguments and the associated evidence presented in the Petition, for the reasons described below, we institute *inter partes* review of all of the challenged claims on the grounds set forth in the Petition.

B. *Related Proceedings*

Petitioner informs us that the ’259 Patent is involved in litigation in *Russo Trading Company, Inc., v. Donnelly Distribution LLC*, No. 18-CF-1851-JPS (E.D. Wis.). Pet. 7; Ex. 1014. This litigation has been stayed pending the outcome of this proceeding. *See* Ex. 3001.

C. *The ’259 Patent*

The ’259 Patent issued from Application Serial Number 14/823,085 (“the ’085 application”) filed August 11, 2015. Ex. 1001, [21], [22]. The

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'085 application is a continuation-in-part of Application Serial Number 14/718,131 (“the '131 application”) filed on May 21, 2015.¹ *Id.* at [63].

The '259 Patent “relates generally to tiles and more specifically to a tile lippage removal system.”² Ex. 1001, 1:14–15. The '259 Patent explains that when laying tiles, it is important not to exert a lateral force which tends to spread the tiles away from each other, such that the tile edges are no longer parallel to each other, which is unacceptable. *Id.* at 1:21–28. The desired lippage removal system provides only a downward force that does not mar a top of the tiles or cause lateral movement of the tiles, which causes oozing of tile glue. *Id.* at 1:30–35.

The '259 Patent describes various designs for a tile lippage removal system with an exemplary embodiment of a cap depicted in Figure 3A, reproduced below.

¹ Petitioner argues, with supporting evidence, that the '259 Patent is not entitled to the filing date of the '131 application. Pet. 19–21 (citing Ex. 1004 ¶¶ 91–95). Patent Owner has not yet contended that the '259 Patent is entitled to the earlier filing date of the '131 application. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1379–80 (Fed. Cir. 2015). The Board thus treats the '259 patent as having an effective filing date of August 11, 2015. *See* Ex. 1001, [22].

² The Tile Council of North America states that the American National Standards Institute (ANSI) Standard A108.02, § 4.3.7 explains: “Lippage refers to differences in elevation between edges of adjacent tile modules.” *See* Tile Council of North America, Inc. Website, *available at* <https://www.tcnatile.com/faqs/175-lippage.html> (last visited Sept. 3, 2019) (Ex. 3002)

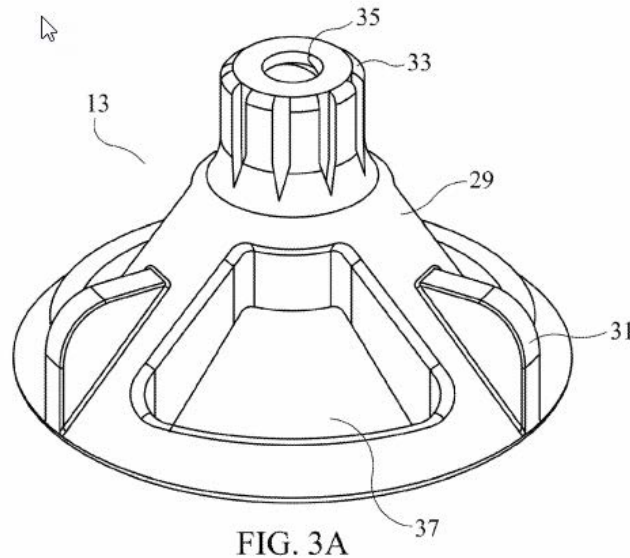


Figure 3A is a top perspective view of a design of a “threaded cap of a tile lippage removal system.” *Id.* at 2:23–24. Threaded cap 13 includes an inverted cup 29 and a plurality of grip extensions 31. *Id.* at 3:13–15. A plurality of sight openings 37 are formed through inverted cup 29 to form a plurality of ribs. *Id.* at 3:19–20. The plurality of sight openings 37 allow a distance between two adjacent tiles 100 to be viewed through threaded cap 13. *Id.* at 3:67–4:2; Fig. 1. A hub 33 extends from a top of inverted cup 29. *Id.* at 3:15–16. “A female thread 35 is formed through a center of the hub 33 to threadably receive [a] threaded shaft 20.” *Id.* at 3:16–18. An exemplary threaded shaft 20 is depicted in Figure 2, reproduced below.

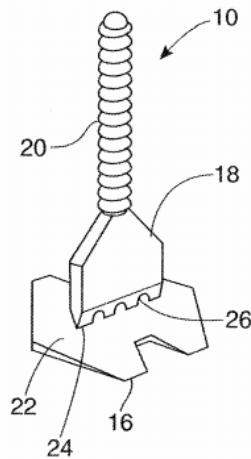


FIG. 2

Figure 2 is a perspective view of a spacer post of a tile lippage removal system. *Id.* at 2:18–19. Spacer post 10 includes base member 16, spacer member 18 and threaded shaft 20. *Id.* at 2:59–60. A bottom of threaded shaft 20 extends from a top of spacer member 18. *Id.* at 3:3–4. A bottom of spacer member 18 extends from a top of base member 16. *Id.* at 2:61–62. A break away connection 22 is made between spacer member 18 and base member 16 that allows spacer member 18 to be separated from base member 16. *Id.* at 2:62–3:1. In order not to exert a lateral force on the tiles, spacer member 18 has a thickness, which is less than a gap between two adjacent tiles. *Id.* at 3:2–3, Fig. 1.

D. Challenged Claims

Of the challenged claims, claim 6 is independent. Claim 7 depends from claim 6.

Claims 6 and 7 are reproduced below:

6. A tile lippage removal system comprising:
 - a spacer post includes a base member, a spacer member and a threaded shaft, a bottom of said spacer member extends

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