

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OCADO GROUP PLC,
Petitioner,

v.

AUTOSTORE TECHNOLOGY AS,
Patent Owner.

PGR2021-00038
Patent 10,696,478 B2

Before BARRY L. GROSSMAN, MIRIAM L. QUINN, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-grant Review
35 U.S.C. § 324

I. INTRODUCTION

Ocado Group plc (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting a post-grant review of claim 19 of U.S. Patent No. 10,696,478 B2 (Ex. 1001, “the ’478 patent”). AutoStore Technology AS (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 7, “Prelim. Resp.”). Pursuant to our authorization for supplemental briefing, Petitioner filed a Reply to the Preliminary Response addressing discretionary denial under § 324(a) (Paper 8, “Prelim. Reply”), and Patent Owner filed a Sur-reply to that Reply (Paper 9, “Prelim. Sur-reply”). Petitioner filed forty-one exhibits (Exs. 1001–1041). Patent Owner filed thirty-one exhibits (Exs. 2001–2031).

Institution of a post-grant review is authorized by statute only when “the information presented in the petition . . . demonstrate[s] that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324; *see* 37 C.F.R. § 42.4 (2020). The burden is on Petitioner to show that the challenged patent is eligible for post-grant review. *Mylan Pharms. Inc. v. Yeda Research & Dev. Co.*, PGR2016-00010, Paper 9 at 10 (PTAB Aug. 15, 2016) (holding that the ultimate burden of persuasion remains with a petitioner to demonstrate that the challenged patent is eligible for post-grant review).

Upon considering the Petition, the Preliminary Response, the Reply, the Sur-reply, and the cited evidence, we conclude that Petitioner has not demonstrated that it is more likely than not that the ’478 patent has, or had, at least one claim having an effective filing date on or after March 16, 2013. Thus, the ’478 patent is not eligible for a post-grant review.

A. Related Proceedings

The parties identify various judicial and administrative matters that would affect or be affected by a decision in this proceeding. Pet. 1–2; Paper 5, 2.

The parties state that the '478 patent is at issue in *AutoStore Technology AS v. Ocado Central Services Ltd., Ocado Group plc, Ocado Innovation Ltd., Ocado Operating Ltd., Ocado Solutions Ltd. and Ocado Solutions USA, Inc.*, Civil Action No. 2:20-cv-00494 (E.D. Va.) (“District Court Litigation”). See Ex. 1016. The '478 patent also is at issue in *In the Matter of Certain Automated Storage and Retrieval Systems, Robots, and Components Thereof* (Inv. No. 337-TA-1228), filed October 1, 2020 (the “ITC investigation”). See Ex. 1017. The District Court Litigation has been stayed pending the ITC investigation. See Ex. 1016, 4 (Docket entry 20); Ex. 2001.

Four additional patents relating to subject matter similar to that disclosed and claimed in the '478 patent also have been challenged by Petitioner in the following *inter partes* review petitions: IPR2021-00274 regarding U.S. Patent No. 10,294,025 B2 (review instituted); IPR2021-00311 regarding U.S. Patent No. 10,474,140 B2 (review instituted); IPR2021-00398 regarding U.S. Patent No. 10,093,525 B2 (review denied); and IPR2021-00412 regarding U.S. Patent No. 10,494,239 B2 (review denied).

B. The '478 Patent

The '478 patent issued on June 30, 2020, from an application filed on October 1, 2019. Ex. 1001, codes (21), (22), (45). The '478 patent states that it is a:

Continuation of application No. 16/122,969, filed on Sep. 6, 2018, now Pat. No. 10,494,239, which is a continuation of application No. 15/818,791, filed on Nov. 21, 2017, now Pat. No. 10,093,525, which is a continuation of application No. 15/632,441, filed on Jun. 26, 2017, now Pat. No. 9,862,579, which is a continuation of application No. 15/411,301, filed on Jan. 20, 2017, now Pat. No. 9,856,082, which is a continuation of application No. 15/197,391, filed on Jun. 29, 2016, now Pat. No. 9,656,802, which is a continuation of application No. 14/650,757, filed as application No. PCT/EP2013/075671 on Dec. 5, 2013, now Pat. No. 9,422,108.

Ex. 1001, code (63), 1:6–17.

The '478 patent also claims priority to a Norwegian Application No. 20121488 filed on December 10, 2012 (“NO/488”¹). Ex. 1001, code (30).

The '478 patent, titled “Automated Storage System,” is directed to “a remotely operated vehicle for picking up storage bins from a storage system.” Ex. 1001, 1:23–24. The invention “also relates to a storage system using the inventive vehicle.” *Id.* at 1:26–27.

Claim 19, the sole challenged claim, is directed specifically to an automated storage system having pillars defining storage columns, supporting rails on the pillars, and a plurality of remotely controlled robot vehicles. *Id.* at 8:64–9:9. The vehicle or robot includes a vehicle body, vehicle driving means, and a storage section for receiving any storage bin stored in a storage column within the storage system. *Id.* at 2:19–23. The vehicle or robot also includes a lifting device which is at least indirectly connected to the vehicle body in order to lift a storage bin into the storage section. *Id.* at 2:23–25. This general structure, admittedly, is well known,

¹ We use the “NO/488” short form for consistency, because this is what the parties have used. *See, e.g.*, Pet. 4; Prelim. Resp. xi, 30.

and is shown in Figures 1 and 2, which are identified as “prior art.”
Id. at 1:28–44.

The disclosed invention also includes a first set of wheels or other “vehicle rolling means” (*see, e.g.*, Ex. 1001, 2:26) to allow movement of the vehicle along a first direction (X) within the storage system and a second set of wheels or “vehicle rolling means” to allow movement of the vehicle along a second direction (Y) in the storage system. *Id.* at 2:26–31. The second direction (Y) is oriented perpendicular to the first direction (X). Ex. 1001, 2:31–33.

Figure 6, reproduced below, shows an embodiment of the storage structure, and Figure 8, also reproduced below, shows an embodiment of the disclosed vehicle or robot on the structure.

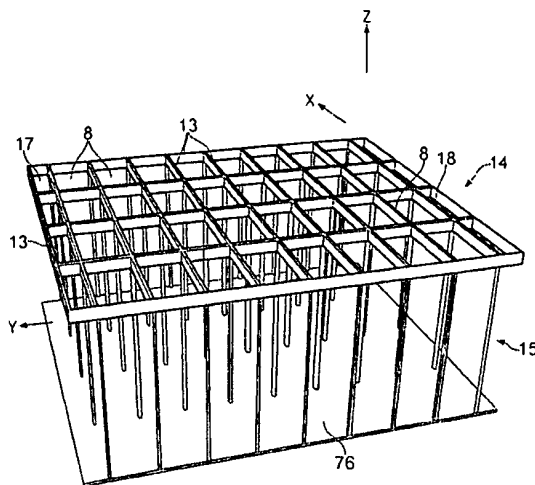


FIG. 6

FIG. 6 is a perspective top view of a bin storing grid and a vehicle support. Ex. 1001, 4:39–40.

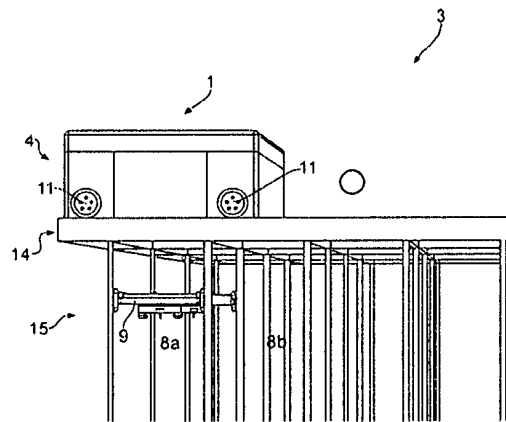


FIG. 8

FIG. 8 is a perspective side view of part of a storage system including a bin storing grid, a vehicle support and a remotely operated vehicle. Ex. 1001, 4:43–46.

C. Illustrative Claim

Claim 19 is the sole challenged claim and is reproduced below.

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