

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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C&D ZODIAC, INC.,  
Petitioner,

v.

B/E AEROSPACE, INC.,  
Patent Owner.

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Case IPR2017-01275  
Patent 9,073,641 B2

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JENNIFER S. BISK, MICHAEL J. FITZPATRICK, and  
SCOTT A. DANIELS, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION

Instituting *Inter Partes* Review  
35 U.S.C. § 314, 37 C.F.R. §§ 42.4, 42.108

I. INTRODUCTION

A. BACKGROUND

C&D Zodiac, Inc. (“Petitioner”), filed a petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1, 3–10, and 12–17 (the “challenged claims”) of U.S. Patent No. 9,073,641 B2(Ex. 1001, “the ‘641 patent”). 35 U.S.C. § 311. B/E Aerospace, Inc. (“Patent Owner”),

timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).<sup>1</sup> Institution of an *inter partes* review is authorized by statute when “the information presented in the petition filed under section 311 and any response filed under section 313 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.” 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. Based on our review of the record, we conclude that Petitioner is reasonably likely to prevail with respect to at least one of challenged claim.

Generally, Patent Owner contends that the Petition should be denied in its entirety. For the reasons described below, we institute an *inter partes* review of claims 1, 3–10, and 12–17.

B. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner contends that the challenged claims are unpatentable under 35 U.S.C. § 103(a)<sup>2</sup> based on the following grounds (Pet. 10–80):

References	Claims challenged
Admitted Prior Art <sup>3</sup> and U.S. Patent No. 3,738,497 (Ex. 1001, “Betts”)	1, 3–10, and 12–17

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<sup>1</sup> Patent Owner filed two versions of the Preliminary Response: Paper 7, to which access is restricted to the parties and the Board; and Paper 6, a publicly available, redacted version of Paper 7. For purposes of this Decision, we refer only to Paper 6, the redacted version of the Preliminary Response.

<sup>2</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, took effect on March 18, 2013. Because the application from which the ’641 patent issued was filed before that date, our citations to Title 35 are to its pre-AIA version.

<sup>3</sup> Petitioner defines “Admitted Prior Art” as certain portions of the ’641 patent. Pet. 11–14 (citing Ex. 1001, Fig. 1, 1:21–22, 3:65–67).

References	Claims challenged
Admitted Prior Art and KLM Overhead Crew Rest Document (Ex. 1009, “KLM Crew Rest”) <sup>4</sup>	1, 3–10, and 12–17

### C. RELATED PROCEEDINGS

The parties have identified as a related proceeding the co-pending district court litigation of *B/E Aerospace, Inc. v. Zodiac Aerospace, Inc.*, Case No. 2:14-cv-01417 (E.D. Tex). Paper 5, 3; Pet. 2. Petitioner concurrently filed *inter partes* review proceedings IPR2017-01273, IPR2017-01274, and IPR2017-01275 challenging three related utility patents and PGR2017-00019 challenging a related design patent. Pet. 2.

In addition, Petitioner previously filed a Petition challenging Patent No. 8,590,838 (“the ’838 patent”) in IPR2014-00727, which resulted in a final written decision finding unpatentable claims 1, 3–7, 9, 10, 12–14, 16–19, 21, 22, 24–29, 31, and 33–37 of the ’838 patent. IPR2014-00727, Paper 65 (Oct. 26, 2015). On October 3, 2017, the Federal Circuit affirmed that decision. *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 2017 WL 4387223 (Fed. Cir. Oct. 3, 2017). The ’641 is a continuation of application No. 13/089,063 that matured into the ’838 patent. Ex. 1001, [63].

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<sup>4</sup> File history for U.S. Application serial No. 09/947,275, which application issued as U.S. Patent No. 6,520,451 to Moore and which file history contains a drawing and related description of a KLM Crew Rest. *See, e.g.*, Ex. 1009, 70. Petitioner terms the file history “the KLM Crew Rest Document.” Pet. 16. We employ the same nomenclature.

## D. THE '641 PATENT

The '641 patent relates to space-saving aircraft enclosures, including lavatories, closets and galleys. Ex. 1001, 1:15–20, 2:14–19. Figure 2 of the '641 patent is reproduced below.

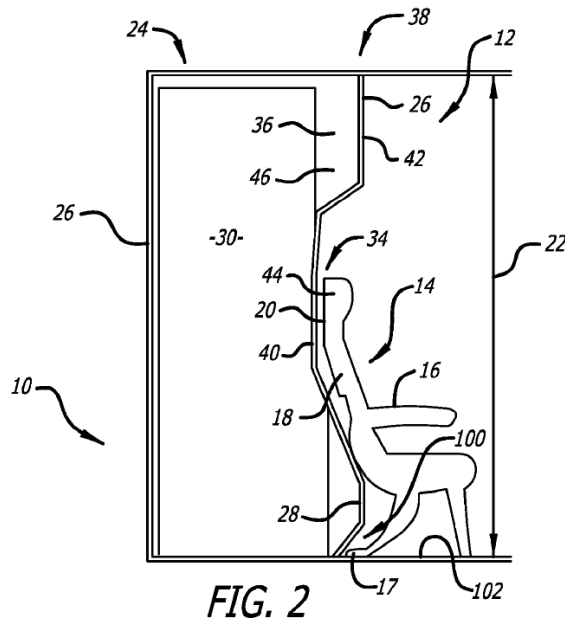


Figure 2, reproduced above, illustrates enclosure 10, such as a lavatory, positioned aft of aircraft cabin 12. Ex. 1001, 4:1–3, 4:8–13. Forward wall 28 of the lavatory is described as “substantially not flat in a vertical plane” and “disposed immediately aft of and adjacent to or abutting the exterior aft surface of” passenger seat 16. *Id.* at 4:15–24. In particular, the forward wall includes recess 34, which accommodates the partially-reclined backrest of the passenger seat, as shown in Figure 2. *Id.* at 4:24–28. In addition, the forward wall includes lower recess 100, which accommodates “at least a portion of an aft-extending seat support 17.” *Id.* at 4:31–36.

The '641 patent contrasts the embodiment of Figure 2 with a prior art configuration shown in Figure 1, which is reproduced below.

**FIG. 1**  
(Prior Art)

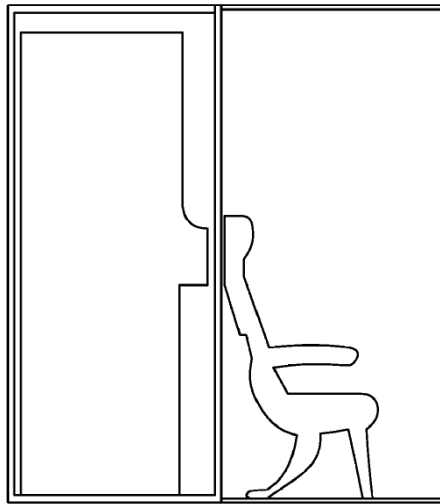


Figure 1, reproduced above, illustrates “a prior art installation of a lavatory immediately aft of an adjacent to an aircraft passenger seat.” Ex. 1001, 3:65–67. In the depiction of the prior art in Figure 1, a forward wall of the lavatory (double-lined structure immediately aft of seat) is flat and in a vertical plane.

As can be seen by comparing FIG. 1 and FIG. 2, the recess 34 and the lower recess 100 combine to permit the passenger seat 16 to be positioned farther aft in the cabin than would be possible if the lavatory enclosure 10 included a conventional flat and vertical forward wall without recesses like that shown in FIG. 1, or included a forward wall that did not include both recesses 34, 100.

*Id.* at 4:36–42. Notably, the passenger seat in the Figure 1 depiction of the prior art is identical to the passenger seat in the Figure 2 illustration of the invention.

#### E. THE CHALLENGED CLAIMS

Of the challenged claims, claims 1 and 8 are independent. Claim 1 is illustrative and reproduced below.

1. An aircraft lavatory for a cabin of an aircraft of a type that includes a forward-facing passenger seat that includes an upwardly and aftwardly inclined seat back and an aft-extending seat support disposed below the seat back, the lavatory comprising:
  - a lavatory unit including a forward wall portion and defining an enclosed interior lavatory space, said forward wall portion configured to be disposed proximate to and aft of the passenger seat and including an exterior surface having a shape that is substantially not flat in a vertical plane; and
  - wherein said forward wall portion is shaped to substantially conform to the shape of the upwardly and aftwardly inclined seat back of the passenger seat, and includes a first recess configured to receive at least a portion of the upwardly and aftwardly inclined seat back of the passenger seat therein, and further includes a second recess configured to receive at least a portion of the aft-extending seat support therein when at least a portion of the upwardly and aftwardly inclined seat back of the passenger seat is received within the first recess.

*Id.* at 4:63–5:17.

## II. ANALYSIS

### A. PATENT OWNER’S ARGUMENTS BEYOND RESPONDING TO PETITIONER’S OBVIOUSNESS CHALLENGES

Patent Owner devotes a substantial amount of its Preliminary Response to arguing that the Petition should be denied regardless of whether there is a reasonable likelihood that Petitioner would prevail with respect to at least 1 of the claims challenged in the Petition. Prelim. Resp. 1–23, 57. Specifically, Patent Owner presents two such arguments: (1) the Petition “presents substantially the same art and arguments that were already considered by the Patent Office [during examination of the ’641 patent], so the Petition should be denied under 35 U.S.C. §§ 325(d) and/or 314(a)”;

(2) “Petitioner did not name all Real Parties in Interest or Privies.” *Id.* at 1–2. For the reasons discussed below, we do not so deny the Petition.

*1. Art and Arguments Previously Presented to the Office*

Section 325(d) of Title 35 provides that “[i]n determining whether to institute . . . , [the Board<sup>5</sup>] may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). Invoking this statute, Patent Owner asserts: “All of the IPR art and arguments were presented to the Examiner during prosecution of the challenged claims.” Prelim. Resp.1.

To the extent that the term “[a]ll of the IPR art and arguments” refers to all those in the instant Petition, the assertion would appear to be an overstatement. Patent Owner has not shown that the arguments in the Petition were ever previously presented to the Office. For example, the arguments in the Petition are based, in part, on a declaration of Alan Anderson executed on April 12, 2017, which was after the ’641 patent issued on July 7, 2015. *Compare* Ex. 1004, 129, *with* Ex. 1001, at [45].

To the extent that the term “[a]ll of the IPR art and arguments” refers instead to those in Case IPR2014-00727, the assertion is not directly relevant here. For it is the art and arguments of the instant Petition, to which § 325(d) might potentially apply.

It is true that substantially the same arguments and art are raised in the instant Petition as were raised during examination of the ’641 patent, and yet the ’641 patent issued. However, it is also true that substantially the same

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<sup>5</sup> Section 325(d) refers to “the Director,” but the Director has delegated institution authority to the Board. *See* 37 C.F.R. § 42.4(a).

arguments and art were raised in Case IPR2014-00727, and many of the challenged claims of the '838 patent were held unpatentable. Because the challenged claims before us are of similar scope to those held unpatentable in Case IPR2014-00727, we decline to invoke § 325(d) to reject this Petition.

## 2. *Real Parties in Interest*

Section 312(a)(2) of Title 35 states that a petition to institute an *inter partes* review “may be considered only if— . . . (2) the petition identifies all real parties in interest.” 35 U.S.C. 312(a)(2). Invoking this statute, Patent Owner asserts: “Zodiac’s Petition should be denied because the Petitioner did not name all Real Parties in Interest *or Privies*.” Prelim. Resp .1 (emphasis added). The statute, however, does not require the identification of privies, and Patent Owner has not persuaded us that the Petition fails to identify a real party in interest. Moreover, we have no reason to doubt that Petitioner has not satisfied its obligation to name any and all real parties in interest.

## B. CLAIM INTERPRETATION

“A claim in an unexpired patent that will not expire before a final written decision is issued shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b). When applying that standard, we interpret the claim language as it would be understood by one of ordinary skill in the art in light of the specification. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning ‘is the meaning that the term would have to



a person of ordinary skill in the art in question.”). Only terms which are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Petitioner proposes an express construction (albeit a partial construction) for “recess,” which is recited by both challenged independent claims. Pet. 30–31. Patent Owner opposes Petitioner’s construction, arguing that the claim language does not require express construction. Prelim. Resp. 26. Patent Owner also offers its own competing express construction of “recess” should an express construction be warranted. *Id.*

Independent claim 1 recites that that “said forward wall portion . . . includes a first recess” and “a second recess.”<sup>6</sup> Petitioner argues that the term *recess* “is at least broad enough to include ‘a wall that includes a contour in the vertical plane.’” Pet. 31. Petitioner’s proposed construction conflates the term *recess* with the term *partition* that, in turn, comprises the recesses. We reject Petitioner’s construction.

As noted above, Patent Owner argues that *recess* does not need express construction as its plain and ordinary meaning is apparent on its face. Prelim. Resp. 24. Patent Owner also argues that the recited “‘recesses’ are shaped to accommodate the shape of the seat portion in front of it.” *Id.* We agree in both respects. No express construction is needed. Claim 1

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<sup>6</sup> Independent claim 8 similarly recites “wherein the forward-extending upper portion, the aft extending mid-portion, and the forward extending lower portion combine to define a first aft-extending recess” and “wherein the forward partition further defines a second aft-extending recess.”

explicitly recites what Patent Owner argues the recesses are. In that regard, claim 1 recites the following:

at least one recess configured to receive at least a portion of the upwardly and aftwardly inclined seat back of the passenger seat, and

a second recess configured to receive at least a portion of an aft-extending seat support therein.

The term *recess* does not need an express construction. Its plain and ordinary meaning is readily apparent, particularly in view of surrounding claim language.

C. OBVIOUSNESS IN VIEW OF ADMITTED PRIOR ART AND BETTS

A claim is unpatentable “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103(a). “Obviousness is a question of law based on underlying facts.” *MobileMedia Ideas LLC v. Apple Inc.*, 780 F.3d 1159, 1167 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 270 (2015). The underlying facts include (i) the scope and content of the prior art, (ii) the differences between the prior art and the claimed invention, (iii) the level of ordinary skill in the field of the invention, and (iv) any relevant objective considerations of nonobviousness that are presented. *Id.* (citing *Graham v. John Deere*, 383 U.S. 1, 17–18 (1966)). An additional underlying fact is whether there was a reason to combine prior art teachings as asserted. *Id.*

Petitioner asserts that the subject matter of claims 1, 3–10 and 12–17 would have been obvious over the Admitted Prior Art and Betts. Pet. 10–11. For the reasons explained below, we determine Petitioner has established a

reasonable likelihood of prevailing on this assertion with respect to at least one claim.

*1. The Admitted Prior Art*

Petitioner asserts as Admitted Prior Art the illustration and related disclosure of Figure 1 in the '641 patent, which is discussed above. *See* Pet. 11–14. We agree that the asserted Admitted Prior Art, in fact, constitutes admitted prior art. *See* Ex. 1001, 3:65–67 (“FIG. 1 is a schematic diagram of a *prior art* installation of a lavatory immediately aft of and adjacent to an aircraft passenger seat.”) (emphasis added).

Petitioner additionally asserts that “[t]he only aspect of the purported invention in the '641 Patent that is not admitted prior art is the contoured forward wall depicted in Figure 2.” Pet. 13. We generally agree with this additional assertion, but we make two clarifications. First, the invention of the '641 patent is not necessarily limited to the specific shape of the forward wall as depicted in Figure 2 but rather may include other differently shaped forward walls. *See* Ex. 1001, 4:1–3 (“FIG. 2 is a schematic diagram of an installation of a lavatory according to the present invention immediately aft of and adjacent to or abutting an aircraft cabin passenger.”), 4:8–9 (“the drawings . . . are provided by way of example, and not by way of limitation”). Second, Figure 2 includes additional features not present in Figure 1 that are created by the contouring of the forward wall, such as secondary space 36.

Of particular relevance here is that the Admitted Prior Art includes the passenger seat shown in Figure 1 of the '641 patent complete with its aft-extending seat support.

## 2. *Betts*

Betts notes a desire to “provide more room for passengers in an aircraft or other vehicle.” Ex. 1005, 1:6–7. Figure 1 of Betts is reproduced below.

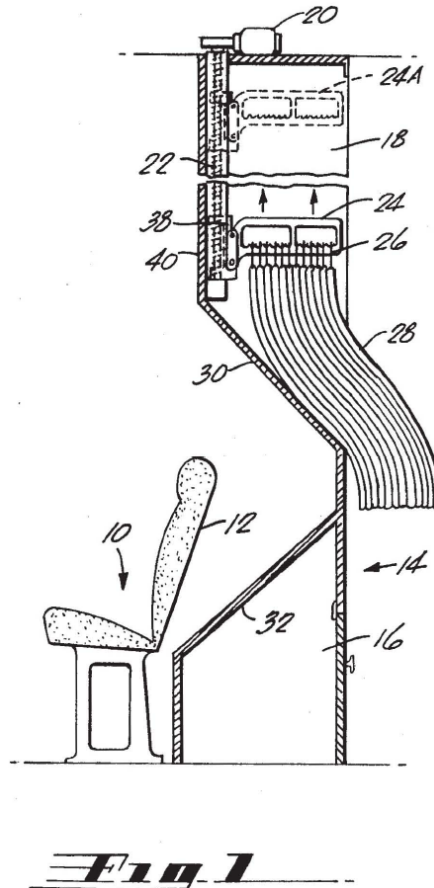


Figure 1 discloses airplane passenger seat 10 having tiltable backrest 12. Ex. 1005, 2:8–9. Behind the seat is coat closet 14, which has luggage space 16 along the floor and overhead coat compartment 18. *Id.* at 2:9–14. “The lower portion 30 of the coat compartment 18 slants rearwardly to provide a space for seatback 12 to be tilted rearwardly as desired by the occupant. The top 32 of storage space 16 also slants rearwardly so as not to interfere with seatback 12 when tilted.” *Id.* at 2:19–24.

### 3. *Application of the Asserted Prior Art to Claim 1*

As discussed below, and notwithstanding Patent Owner's secondary considerations arguments, Petitioner shows sufficiently for purpose of institution, that the subject matter of independent claim 1 would have been obvious to a person of ordinary skill in the art in view of Admitted Prior Art and Betts.

Claim 1 recites "a lavatory unit including a forward wall portion and defining an enclosed interior lavatory space, said forward wall portion configured to be disposed proximate to and aft of the passenger seat and including an exterior surface having a shape that is substantially not flat in a vertical plane." Petitioner argues that a person of ordinary skill in the art would know that the contoured forward wall of Betts could be used in place of a flat forward wall to allow the seat be placed further aft in an aircraft cabin. Pet. 33–34 (Ex. 1004 ¶¶ 176–78). We find, at least preliminarily, that a person of ordinary skill in the art would have known about flat forward walls and contoured forward walls, that the latter could be used in lieu of the former, and the space-saving advantage of doing so. *See, e.g.*, Ex. 1001, Fig. 1; Ex. 1005, Fig. 1.<sup>7</sup>

Claim 1 also recites that "wherein said forward wall portion is shaped to substantially conform to the shape of the upwardly and aftwardly inclined

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<sup>7</sup> In Case IPR2014-00727, which involved a related patent, Petitioner similarly "relie[d] on Betts's recessed forward wall and desire for increased efficiency in the use of space on an aircraft to motivate one of ordinary skill in the art to modify an existing lavatory (or other enclosure) by applying Betts's recessed forward wall to that conventional lavatory." *B/E Aerospace*, 2017 WL 4387223, at \*5. The Court of Appeals found this to be substantial evidence that supported the Board's obviousness conclusion in that *inter partes* review. *Id.*

seat back of the passenger seat, and includes a first recess configured to receive at least a portion of the upwardly and aftwardly inclined seat back of the passenger seat therein.” As argued by Petitioner, Betts discloses this limitation. *See* Pet. 34–36 (citing Ex. 1005, Fig. 1; Ex. 1004 ¶¶ 181–83); *see also B/E Aerospace*, 2017 WL 4387223, at \*4 (“Walls 30 and 32 [in Figure 1 of Betts] slant rearwardly to allow the occupant to recline seatback 12 of passenger seat 10.”) (citing Ex. 1005, 2:7–24).

Finally, claim 1 recites that “said forward wall portion . . . further includes a second recess configured to receive at least a portion of the aft-extending seat support therein when at least a portion of the upwardly and aftwardly inclined seat back of the passenger seat is received within the first recess.” Betts alone does not disclose this limitation. Petitioner, however, argues the limitation is met by the combined teachings of the Admitted Prior Art and Betts. In that regard, Petitioner first notes that the Admitted Prior Art includes “[a] seat with an aft extending seat support.” Pet. 37 (citing Ex. 1001, Fig. 1). Petitioner argues that the same logic of using a recess to receive the seat back applies to using another recess to receive the aft extending seat support. *Id.* at 37–38 (citing Ex. 1004 ¶¶ 188, 189, 191). Petitioner further points out that adding a second recess is nothing more than the application of known technology (i.e., Betts) for its intended purpose and predictable result (i.e., to position the seat as far back as possible). *Id.* at 37–39. On the present record, Petitioner has shown sufficiently for purposes of institution that Betts teaches or suggests this limitation.

Accordingly, Petitioner adequately maps the Admitted Prior Art and Betts to independent claim 1 and provides sufficient reasoning for why a person of ordinary skill in the art would have combined the asserted

teachings of those references. As further discussed below, and despite Patent Owner's secondary considerations argument to the contrary, Petitioner has demonstrated a reasonable likelihood of prevailing.

Patent Owner argues that the Petition "ignores the prosecution history of patents related to the challenged patent," which includes "substantially more [secondary considerations] information tha[n] what was presented in the '838 patent," and "instead focuses on an IPR of a separate patent." Prelim. Resp. 44 (referring to Case IPR2014-00727 and the '838 patent). Patent Owner likewise argues that the Petition fails to address secondary considerations evidence "discovered during the co-pending litigation." *Id.* at 53. Patent Owner argues that Petitioner had an obligation, in its Petition, to introduce and address such secondary considerations evidence. *Id.* at 44–47, 53–56. Patent Owner cites no binding precedent to support its position. We disagree with that position. Petitioner had no such obligation.

We turn now to the secondary considerations evidence that Patent Owner has cited in this proceeding as purportedly demonstrating non-obviousness of claim 1 (as well as the other challenged claims). *See* Prelim. Resp. 44–56. "For objective [evidence of secondary considerations] to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the *claimed invention*." *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010) (alteration and emphasis in original) (quoting *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995)). Patent Owner has not done so.

Patent Owner argues "there had never, before B/E's invention, been a lavatory with a contoured forward wall, allowing for extra seats to be added to an aircraft. It is exactly this feature of B/E's product [Spacewall] that was

consistently praised.” Prelim Resp. 53. By “this feature,” we understand Patent Owner means the *combination* of an aircraft lavatory and a contoured front wall. Thus, we understand Patent Owner to merely be pointing out that the challenged claims are not anticipated. But, Petitioner does not argue that the claims are anticipated. Rather, Petitioner argues they are obvious, in part, because both aircraft lavatories and contoured forward walls were known in the art. What the ’641 patent, like the ’838 patent, generally claims is using a contoured forward wall, which Betts teaches (*see* Ex. 1005, Fig. 1), as the forward wall of an aircraft lavatory, which was admittedly known in the art (*see* Ex. 1001, Fig. 1). “[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). Yet, there is nothing unpredictable about the invention of the ’641 patent in light of Betts. Rather, a person of ordinary skill in the art would immediately recognize that the space-saving contoured forward wall of Betts works to save space despite what is placed behind the wall. *See* Ex. 1005, 1:6–7 (noting a desire “to provide more room for passengers in an aircraft”).

The secondary considerations evidence regarding the space-saving aspect of Patent Owner’s Spacewall product, are not probative of non-obviousness because the space-saving feature of contoured forward walls was already known in the art. *See* Prelim Resp. 48–49 (“Here, the objective evidence ties directly to the claimed features. For example, an article reported that ‘Boeing says: ‘The B/E Aerospace modular lavatory system was selected for use in the Next Generation 737 to provide greater value to our airplane customers by **freeing up floor space in the cabin.**’”) (quoting



Ex. 2055) (Petitioner’s emphasis)); *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997) (“asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art.”).

Patent Owner argues that an \$800 million contract it received from Boeing “was the direct result of the patent.” Prelim. Resp .49 (citing Ex. 2054 ¶ 5). The cited declaration testimony of Mitchell Freeman, however, was executed on March 28, 2016, which predates the ’641 patent. Thus, we are not persuaded that the touted contract was a direct result of the ’641 patent.

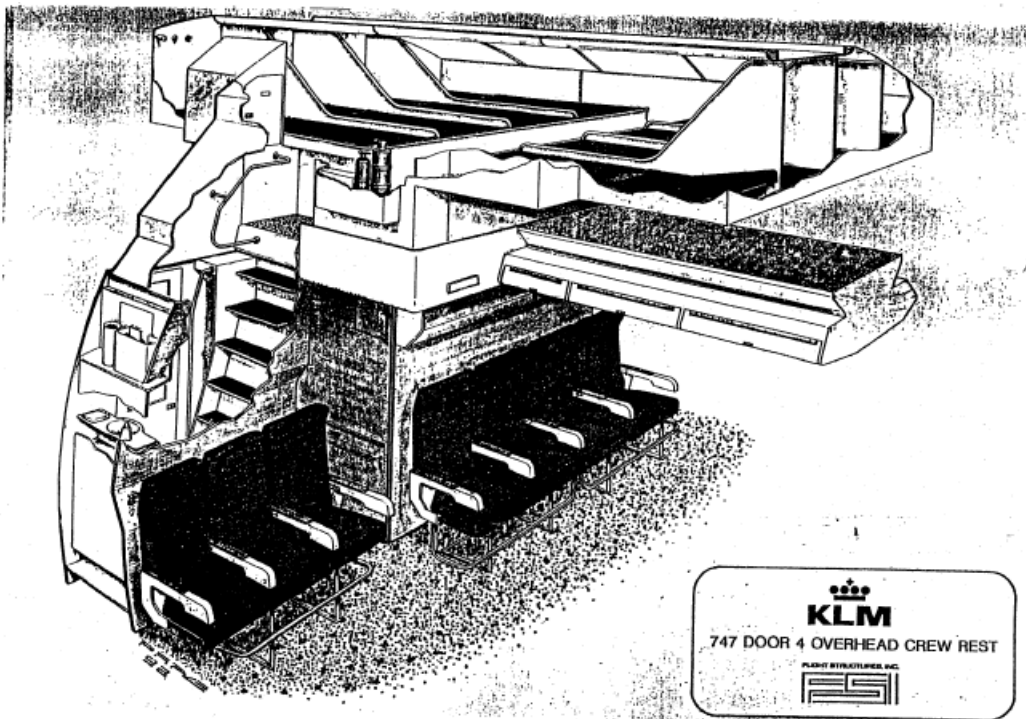
Petitioner has shown a reasonable likelihood prevailing on this ground with respect to at least one claim.

**D. OBVIOUSNESS IN VIEW OF ADMITTED PRIOR ART AND THE KLM CREW REST DOCUMENT**

Petitioner asserts that the subject matter of claims 1, 3–10, and 12–17 would have been obvious over the Admitted Prior Art and the KLM Crew Rest Document. Pet. 10–11. Petitioner has not shown that the KLM Crew Rest Document is a printed publication. Accordingly, we deny institution on this ground. *See* 35 U.S.C. § 311(b) (“A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.”).

Exhibit 1009 is represented, and appears, to be the file history of U.S. Patent Application serial no. 09/947,275, which issued as U.S. Patent No. 6,520,451 to Moore on February 18, 2003 (“the Moore patent”). Pet. iii (“List of Exhibits”); Ex. 1009; Ex. 1010, at [45]. Subsequently, Exhibit

1009 is asserted to be the KLM Crew Rest Document, although clearly only part of the exhibit pertains to the referenced crew rest. Pet. 16 (“**The KLM Crew Rest Document (Exhibit 1009)**”), 11 (“the KLM Crew Rest documents (Exhibit 1009)”). Page seventy of Exhibit 1009 is part of a document disclosed via an Information Disclosure Statement during examination of the unrelated Moore patent. Ex. 1009, 70. Page seventy includes a diagram, which is reproduced below.



Ex. 1009, 70. The diagram, reproduced above, shows a portion of an aircraft interior, including a contoured forward wall positioned between a row of passenger seats and a room containing a sink and staircase. *Id.*

Petitioner argues that Exhibit 1009 constitutes a prior art printed publication because the file history was open to the public at least as early as February 18, 2003, the date on which the Moore patent issued. Pet. 17. Petitioner has shown that Exhibit 1009 is prior art, but not that it is a “printed publication[]” within the meaning of 35 U.S.C. § 102(b) (pre-AIA)

and § 311(b) (AIA). Petitioner’s argument primarily is based on 37 C.F.R. § 1.11(a), but that regulation actually undermines Petitioner’s position. *See* Pet. 17–18. Section 1.11(a) states the following:

The specification, drawings, and all papers relating to the file of:  
A published application; a patent; or a statutory invention  
registration are open to inspection by the public, and copies may  
be obtained . . .

37 C.F.R. § 1.11(a). Thus, the Office’s regulation refers to a “published application,” but not a published file history. The file history is described as “open to inspection by the public,” but not published under Rule 1.11(a). Accordingly, we are not persuaded that, under Rule 1.11(a) (or any other authority), file histories of patent applications generally constitute printed publications by virtue of their being open to inspection by the public.

Exhibit 1009 may nonetheless constitute a printed publication if it was publicly accessible. *See In re Bayer*, 568 F.2d 1357, 1359 (C.C.P.A 1978) (“It is well settled that in determining whether a printed document constitutes a publication bar under 35 U.S.C. § 102(b) the touchstone is public accessibility.”).

A document is publicly accessible if it “has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation.”

*Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1333 (Fed. Cir. 2009) (quoting *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)).

In *In re Wyer*, the Court of Customs and Patent Appeals determined that an Australian patent application constituted a prior art printed publication because it “was laid open to public inspection by the Australian

Patent Office *and a printed abstract thereof was published.*” 655 F.2d at 222 (emphasis added); *see also id.* at 224 (“The application was classified, and the Abstract was arranged with other Abstracts according to this classification system.”).

In a case years later, *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, (Fed. Cir. 2006), the Court of Appeals for the Federal Circuit followed *Wyer* when faced with similar facts. In doing so, the Court summarized *Wyer*’s holding as follows:

Controlling in our determination whether the [Canadian] ’119 application was “publicly accessible” is our predecessor court’s decision in *In re Wyer*. In that case, an Australian patent application was laid open for public inspection and an abstract of the application was published by the Australian Patent Office more than two years before the filing date of the corresponding U.S. patent application at issue in that case. *Id.* at 222. The existence of a published abstract that would have allowed one skilled in the art exercising reasonable diligence to locate the foreign patent application and the fact that the application was classified and indexed in the patent office, were central to the *Wyer* court’s conclusion that the application was “publicly accessible.” The court noted, “[g]iven that there is no genuine issue as to whether the application was properly classified, indexed, or abstracted, we are convinced that the contents of the application were sufficiently accessible to the public and to persons skilled in the pertinent art to qualify as a ‘printed publication.’” *Id.* at 226.

*Bruckelmyer*, 445 F.3d 1378–79. In *Bruckelmyer*, the defendant had sought to invalidate the claims of the patents-in-suit by relying on two figures (Figures 3 and 4) that had been included in a Canadian patent application but not the Canadian patent that ultimately issued. 445 F.3d at 1376 (“Figures 3 and 4 are not in the issued patent because they were cancelled during prosecution.”). The Court held that the application, and thus Figures 3 and

4, constituted a printed publication even though the application itself was never disseminated. *Id.* at 1379. The Court reached this conclusion because the application was open to the public, and the issued patent would have led persons interested and ordinarily skilled in the art to the application. *See, e.g., id.* (“In this case, the published ’119 patent is even more of a road map to the application file than the abstract was in *Wyer*.”).

The instant facts, however, are different significantly than those in *Wyer* and *Bruckelmyer*. In *Wyer*, persons interested and ordinarily skilled in the relevant art could have used the published abstract as a roadmap to locate the application through no more than reasonable diligence. *Wyer*, 655 F.2d at 222, 224. Similarly, in *Bruckelmyer*, persons interested and ordinarily skilled in the relevant art could have used the published patent as a roadmap to locate the application through no more than reasonable diligence. *Bruckelmyer*, 445 F.3d at 79. Here, Petitioner has provided no argument or evidence showing a potential roadmap such that no more than reasonable diligence would have been required for relevant persons to use the Moore patent to locate the diagram on page seventy of Exhibit 1009. That diagram is not part of the invention or disclosure of the Moore patent. It is, in our judgment, without any evidence of a roadmap, too much to expect relevant persons, in the course of exercising reasonable diligence, to search the complete file histories of issued patents for third party disclosures that might possibly be contained therein.<sup>8</sup>

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<sup>8</sup> We acknowledge Petitioner’s citation of *Duodecad IT Servs. Luxembourg S.A.R.L.*, IPR2015-01036, 2016 WL 6946904 (PTAB Oct. 20, 2016). *See* Pet. 18. In that decision, the Board held the following:

File histories are commonly ordered by those performing reasonable diligence who have an

Petitioner has not met its burden to show that the diagram on page seventy of Exhibit 1009 and associated disclosure (Ex. 1009, 69–76) constitute a printed publication under 35 U.S.C. § 102(b) (pre-AIA) and § 311(b) (AIA). Accordingly, there is not a reasonable likelihood of Petitioner prevailing on this ground with respect to any claim challenged.

### III. CONCLUSION

For the foregoing reasons, we are persuaded that the information presented in the Petition establishes that there is a reasonable likelihood that

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interest in a patent. Chen [i.e., the Chen patent] describes subject matter that is close enough to the challenged patent that one interested in the subject matter of the [challenged] patent would, in the exercise of due diligence, locate the Chen patent and be interested in its file history. We agree with Patent Owner that nothing in Chen specifically points to its file history. However, we find that test to be inappropriately limiting. It is undisputed that Chen FH [i.e., the Chen patent's file history] was fully available to anyone who ordered it. We find that one of ordinary skill, being aware of Chen, would consult its file history. We conclude, based on the record as fully developed, that Chen FH is available as prior art against the challenged claims.

*Id.* at \*8. According to Petitioner, under *Duodecad*, if a patent is prior art, then its file history (assuming it is open to public inspection) constitutes a printed publication. Pet. 17–18. Petitioner, however, has not persuaded us that such is the law. Moreover, we find Petitioner's recitation of the law to be inconsistent with *Wyer* and *Bruckelmyer*. Such a broad and general rule would render meaningless the analysis contained within those cases. See *Wyer*, 655 F.2d at 225–26 (“Decision in this field of statutory construction and application must proceed on a case-by-case basis.”); *Bruckelmyer*, 445 F.3d at 1377–79 (“In this case, the published ’119 patent is even more of a roadmap to the application file than the abstract was in *Wyer*.”).

Petitioner will prevail in showing unpatentability of claim 1 of the '641 patent. Accordingly, we institute an *inter partes* review of claims 1, 3–10, and 12–17. *See* 35 U.S.C. § 314(a) (“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.”) (emphasis added); 37 C.F.R. § 42.108(c) (“*Inter partes* review shall not be instituted for a ground of unpatentability unless the Board decides that the petition supporting the ground would demonstrate that there is a reasonable likelihood that *at least one* of the claims challenged in the petition is unpatentable.”) (latter emphasis added). This Decision does not reflect a final determination on the patentability of any claim.

#### IV. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314, an *inter partes* review of U.S. Patent No. 9,073,641 B2 is hereby instituted on the ground that claims 1, 3–10, and 12–17 are asserted to be obvious in view of Admitted Prior Art and Betts;

FURTHER ORDERED that no other ground of unpatentability alleged in the Petition for any claim is authorized for this *inter partes* review; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial commences on the entry date of this decision.

IPR2017-01275

Patent 9,289,688 B2 9,073,641 B2

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