

CERTIFICATE OF INTEREST

Counsel for MeadWestvaco Packaging Systems, LLC certifies:

1. The full name of every party or amicus represented by me is:

MeadWestvaco Packaging Systems, LLC

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

MeadWestvaco Corporation

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None

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STATEMENT OF RELATED CASES

No appeal in or from the same administrative proceeding was previously before this Court or any appellate court. The following civil actions have been stayed pending this *inter partes* reexamination:

Lingamfelter v. Coca-Cola Enterprises, Inc. et al., Civil Action No. 04-1261-KAJ (D. Del. filed Sept. 15, 2004).

Graphic Packaging Int'l, Inc. v. Lingamfelter, Civil Action No. 1:04-CV-00842-JEC (N.D. Ga. filed Mar. 26, 2004).

COUNTERSTATEMENT OF THE ISSUES

1. Whether the PTO Board of Patent Appeals and Interferences (“Board”) properly rejected all claims in *inter partes* reexamination of a patent directed to a carton for holding beverage cans and having a top-corner opening, when:
 - a. a first set of claims requires a carton with the top-corner opening and a height “about equal to a whole multiple of a can diameter” without requiring the carton to hold cans in a configuration of columns, the Board construed “about” to mean “almost” or “nearly,” and an *Ellis* reference differs only by disclosing a carton height of 1.93 times a can diameter;
 - b. a second set of claims is limited to a carton with the top-corner opening and holding cans in a configuration of “rows and columns,” *Ellis* differs only by disclosing a can configuration of slanted columns, and most cartons of beverage cans ever sold have held cans in “rows and columns”;
 - c. a third set of claims requires the carton’s top-corner opening to include oblique edges or scored lines in the carton sidewall, an *Imazato* reference differs only by not disclosing oblique edges or scored lines on its sidewalls, and *Ellis* and other art teach that oblique edges for sidewall openings make it easier to grasp cans and teach making the openings with continuous scored lines;

d. a fourth set of claims requires a carton with the top-corner opening and a handle in the carton's top wall, placing handles in the top of beverage cartons was conventional and common sense, and the art did not discourage placing handles and openings together on the top wall of a carton; and

e. purported secondary considerations of nonobviousness lack a nexus with the claimed subject matter and are not commensurate with the claim scope.

2. Whether the PTO properly permitted all parties to submit declarations in *inter partes* reexamination, when the statute does not prohibit declarations, the PTO is entitled to *Chevron* deference of its application of the statute, the PTO's policy is consistent with Congress's intent for *inter partes* reexamination, and the PTO's multi-stage proceedings afforded Lingamfelter far more than the minimum of constitutional due process.

STATEMENT OF THE CASE

I. Preliminary Statement

The public domain has long included cartons for beverage cans having openings in the carton's top corner. Forty-six years ago, the PTO granted the *Ellis* patent to Anheuser-Busch on an improved carton for storing beverage cans in a refrigerator. That carton, in the shape of a thin rectangular box, held two rows of cans on their sides. Its top corner folded back to dispense individual cans. Similarly, a Japanese patent application to *Imazato* disclosed a carton for accessing cans by removing the carton's top corner along its top and front walls.

Notwithstanding this and other prior art, Mr. C. Brown Lingamfelter obtained U.S. Patent No. 6,789,673 ("the '673 patent") for essentially the same concept: removing a carton's top corner to permit "ease of access" to the cans. A125 at 1:57. But beginning with a 53-page Office Action in reexamination and continuing through six other decisions over six years, the PTO consistently held all claims in the '673 patent unpatentable over *Ellis*, *Imazato*, and other prior art. Among the many grounds for rejection, the Board concluded, "The Patent Owner's claimed invention is merely a predictable variation of the carton of *Ellis* to accommodate an arrangement of cans well known in the art." A88.

Lingamfelter now appeals nearly every issue possible, but none of them has merit. For instance, his efforts to narrowly construe "about" and "comprising"

contradict the common usages of those terms, which are not modified by the patent specification. And his attack on the combinability of overlapping references, such as *Ellis* and *Imazato*, defies the Supreme Court's instructions for obviousness by treating the skilled artisan as an automaton.

Although simplicity certainly does not prevent patentability, removing the top-corner of a beverage carton to access its contents as claimed in the '673 patent flows directly from the teachings of several prior art references, if not only from common sense. The Board properly found all claims of the '673 patent to be unpatentable.

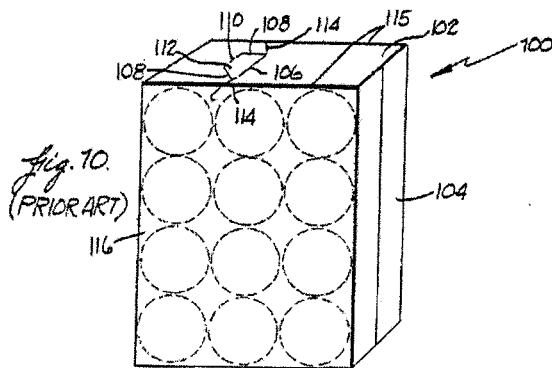
The Court should affirm.

II. Statement of Facts

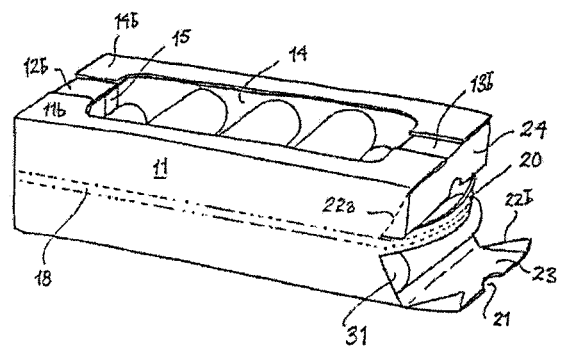
A. The Public Domain Includes Different Configurations of Beverage Cartons with Top-Corner Openings and Handles

This dispute involves cartons for packaging beverage cans. Appellees MeadWestvaco Packaging Systems, LLC and Graphic Packaging International, Inc. supply the cartons. Beverage companies, such as The Coca-Cola Company and their bottlers, package cans in the cartons and sell them via retailers.

Over time, carton size and can configuration have taken nearly every permutation imaginable. For decades, the 12-pack has been the dominant U.S. package, holding cans in either a “3x4” matrix of rows and columns (i.e., 3 cans wide, by 4 deep) or a “2x6” matrix. Below, U.S. Patent No. 4,785,991 (“Schuster,” A1944-56) at left illustrates a 3x4 configuration, and GB 2,186,550 (“Wonnacott,” A217-23) at right illustrates a 2x6 configuration (see also U.S. Patent No. 6,105,854 (“Spivey,” A3295-98)).



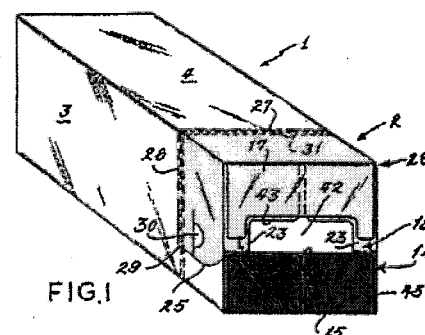
Schuster's FIG. 10
(A1949)



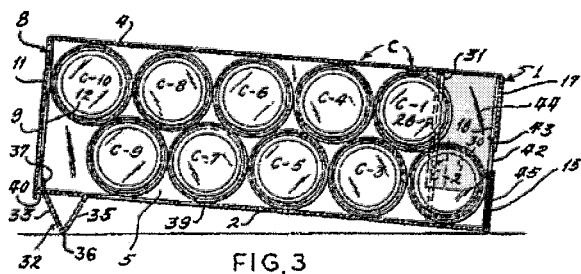
Wonnacott's FIG. 4
(A220)

Opening type has also varied for these cartons, including being positioned across the top corner of the package. As an example, U.S. Patent No. 3,178,242 (“*Ellis*”), issued in 1965, discloses a thin rectangular carton holding two rows of cans on their sides and including a top-corner opening. A3285-88. The carton is “adapted to be placed in a home refrigerator” and provides “a one-piece end loading self-dispensing carton having a removable upper front portion for removing cans one at a time” A3286 at 1:14, 1:22-25. In furtherance of these goals, *Ellis* discloses a carton with two features.

First, *Ellis* provides a top-corner dispenser (shown below in yellow) to retrieve cans easily from the carton, along with a bottom wall (shown in red) to prevent cans from rolling out of the carton. Designated as “R” in *Ellis*’s FIG. 1, the top-corner dispenser is defined by scores and cuts along the carton’s front wall 14, side walls 3 and 5, and top wall 4. A3285; A10.



Second, to allow for a “re-order” reminder placed on one of the cans to accurately notify the consumer when the package is almost empty, the cans in *Ellis*’s carton are staggered so they are removed in a



predetermined order. A3286 at 1:42-46; A3287 at 3:44-58, 3:70-74; A3285 at FIG. 3, shown above.

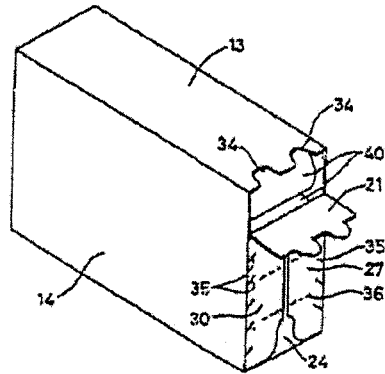
Regarding carton height, the rear wall 8 of *Ellis*'s carton has a preferred height of "about $5\frac{3}{16}$ inches." A3286 at 2:19-21. Since a can diameter is "about $2\frac{11}{16}$ inches" (*id.* at 2:11-13), *Ellis*'s carton has a height of 1.93 can diameters, or $\frac{3}{16}$ of an inch less than a carton holding cans in rows and columns. A390; A489; A563; A1341; A1586; A2526.

Regarding carton length, the illustrated carton holding 10 cans is 5.5 can diameters long, but "[t]he length of the carton 1 may be so dimensioned as to carry any number of cans or cylindrical objects, odd or even in number." A3287 at 3:74-4:2. As a result, a carton for an odd number of cans would have a length equal to a whole multiple of a can diameter. A150; A390; A488; A572.

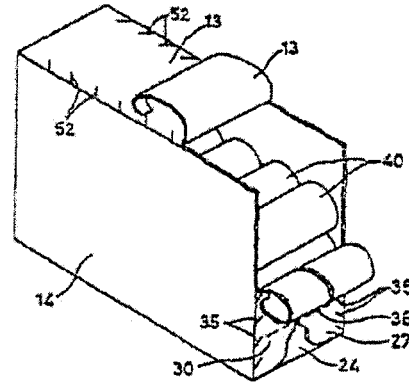
Acknowledging that packaged cans are typically arranged in vertical columns, *Ellis* notes that "[t]he same expensive high speed automatic equipment which loads sleeve or band type cartons from their ends with two rows of aligned cans can be used to load the present carton," with some modifications. A3287 at 3:11-18.

Published in 1995, Japanese patent application 7-9721 ("*Imazato*") also discloses a can carton with a top-corner opening. The cans are aligned in rows and columns. A175-90. To assist with removing the cans from the carton, *Imazato*

discloses score lines on the front wall, the intersection of the side and front walls, the top wall, and the intersection of the top and side walls.



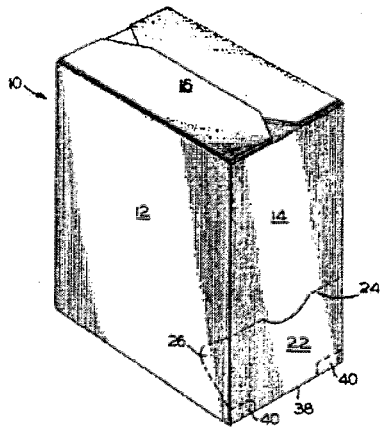
Imazato's FIG. 5
(A188)



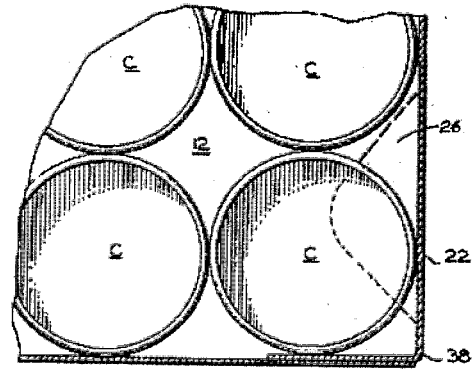
Imazato's FIG. 12
(A190)

In each embodiment, the front wall includes score lines 35 vertically down its sides and a series of horizontal "fold lines" 36 across its middle. A182. A user opens the carton by pulling down the top corner of the carton from two U-shaped "cut-off guides" 34 in the top wall to a fold line 36, as shown in *Imazato's* FIG. 5. *Id.* "In this state, the first metal can on the upper side can be removed." *Id.*

Beverage cartons have also included various arrangements of score lines to form the different openings. For instance, as with the score lines 26, 27 and cuts 25 in FIG. 1 of *Ellis* above, U.S. Patent No. 3,265,283 ("*Farquhar*," A3289-94) discloses a continuous score line 24 running obliquely with respect to a front wall 14 to form "ear portions 26":



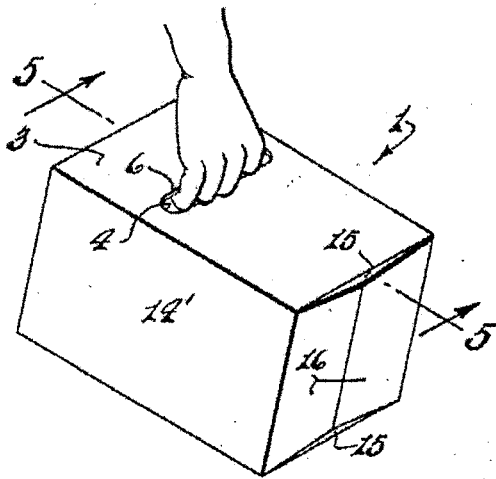
Farquhar's FIG. 1
(A3289)



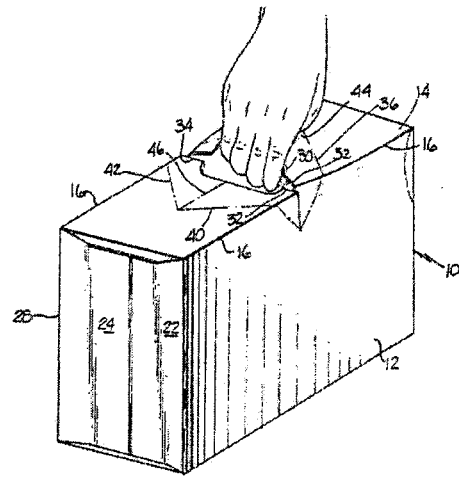
Farquhar's FIG. 3
(A3290)

When the package is opened, those ears “permit the thumb and forefinger to be readily placed about the ends of the cans C ... In the absence of the ear flaps as at 26, it will be appreciated that manual grasp of a container would be quite difficult or inconvenient” A3292-93 at 2:69-3:6.

Finally, handles placed in the top wall of a carton have been long conventional for beverage cartons, as exemplified by U.S. Patent No. 2,718,301 (“*Palmer*,” A3281-84) and *Schuster*.



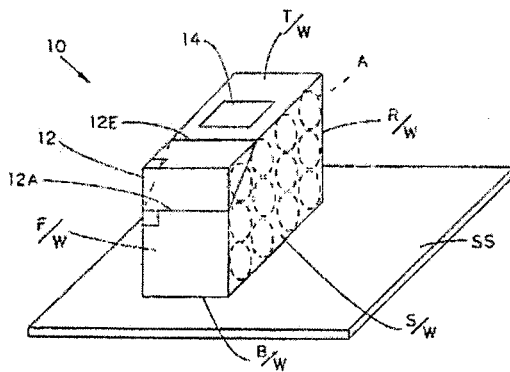
Palmer's FIG. 4
(A3281)



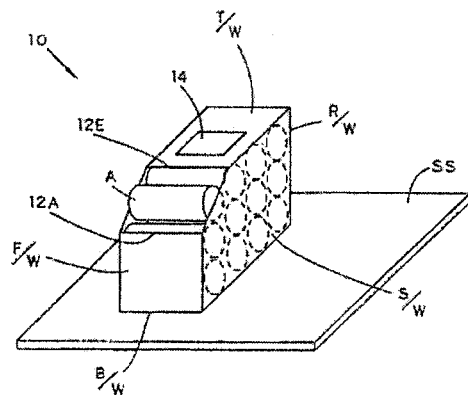
Schuster's FIG. 3
(A1945)

B. Lingamfelter Obtains the '673 Patent Without Full Consideration of the Art

Despite that cartons with top-corner openings for beverage cans were in the public domain, Lingamfelter was granted the '673 patent on September 14, 2004. The background of the patent explains that conventional cartons store cans in a 4x3 matrix, but that those cartons are allegedly not “handy for dispensing the cans.” A125 at 1:32-34. The patent purports to disclose and claim an improved opening for the carton—removal of its top corner when the carton is positioned with the cans on their sides. *See id.* at 1:51-54; FIGS. 1 & 1B below.



'673 Patent, FIG. 1
(A122)



'673 Patent, FIG. 1B
(A123)

The carton's top corner is a removable section 12. Scored lines 12A on the front wall, 12E on the top wall, and two diagonal lines through the side walls outline section 12. A125 at 2:18-33. According to the patent, scored lines "may be grooves, scratches or notches, or any other means known in the trade to weaken the paperboard such that it is easier for the user to remove portion twelve." A126 at 3:41-44; *see* A125 at 2:36-39.

The patent contains 29 claims, of which claims 1, 6, 11, 15, 19, 25, and 28 are independent. A126-28. The independent claims generally separate into two types. A first type claims opened cartons (claims 1, 6, and 28), reciting the top-corner opening in terms of dimensions for the carton's walls. The second type claims unopened cartons (claims 11, 15, 19, and 25), reciting the top-corner opening in terms of where score lines are located.

For purposes of this appeal, four sets of limitations are relevant, with some claims having more than one of the following limitations:

1. “Height” Claims

Independent claims 1, 11, 25, and 28 (and dependent claims 2, 4, 5, 13, 14, and 29) essentially require a carton with the top-corner opening and a carton height “about equal to a whole multiple of a can diameter,” without requiring the carton to hold cans in a configuration of “rows and columns.” A126-28.

2. “Column” Claims

Independent claim 19 (and dependent claims 20, 21, 23, and 24) essentially requires a carton holding cans in a configuration of “rows and columns,” without requiring the top-corner opening to include any sidewall scores or edges. A127.

3. “Sidewall” Claims

Independent claims 1, 6, 11, 15, and 28 (and dependent claims 2, 4, 5, 7, 9, 10, 16, 18, and 29) essentially require the carton’s top-corner opening to include oblique edges or scored lines in the carton’s sidewalls. A126-28.

4. “Handle” Claims

Dependent claims 3, 8, 12, 17, and 22 require, in various forms, “a handle defined at least partially by a cut-out in the top wall” of the carton. A126-27.

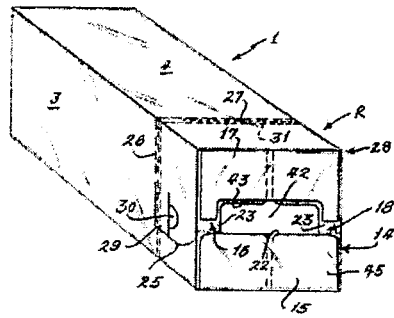
C. Lingamfelter Sues Coca-Cola and Others over Fridge Pack

In 2001, before the ’673 patent issued and before any of the applications that led to it became public, Coca-Cola adopted a new package for its beverage cans known as the Fridge Pack. A1267-69. A slender 2x6 configuration, the Fridge Pack arose from the desire for a package that consumers would store in their

refrigerators, thereby promoting more beverage consumption. A1267. Consumers indicated that the slender shape was an important reason for purchasing the Fridge Pack. *Id.* After initial tests, Coca-Cola shifted its bottling operations to the 2x6 Fridge Pack with a top-corner opening, a significant expense to the bottling lines driven entirely by the desired 2x6 configuration—not any particular opening feature. A1268-69. The shift essentially eliminated consumer access to a 3x4 carton for a Coca-Cola product. *Id.* Coca-Cola, the world’s most recognized brand, coupled its rollout with more than \$16 million in advertising for the Fridge Pack between 2001 and 2005. A1269.



Three years after the Fridge Pack first launched, and on the day the '673 patent issued, Lingamfelter sued Coca-Cola and other beverage and bottling companies in the District of Delaware. A1327-34. The suit sought an injunction and damages for infringement by the Fridge Pack and similar products. On behalf of those defendants, the third-party Appellees noted the substantial overlap between the prior art and both the '673 patent and Lingamfelter’s infringement allegations against the Fridge Pack. Indeed, *Ellis* and the Fridge Pack are nearly identical:

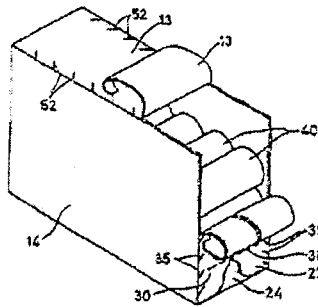


Ellis's FIG. 1
(A3285)

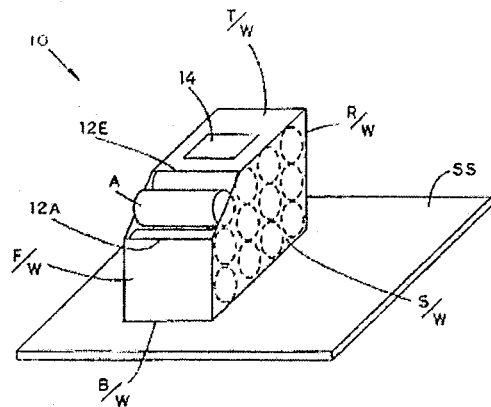


Fridge Pack
(A462)

In addition, *Imazato* is striking in its similarity to the only disclosed embodiment of the '673 patent:



Imazato's FIG. 12
(A190)



'673 Patent, FIG. 1B
(A123)

Accordingly, third-party Appellees MeadWestvaco and Graphic Packaging ("Requesters") separately requested *inter partes* reexamination of the '673 patent in the PTO. The district court entered a stay pending the reexamination and has since administratively closed the litigation. A2126; A2498.

D. USPTO Reexamines the '673 Patent and Holds All Claims Unpatentable

The PTO merged the reexaminations and, over a six-year period, issued seven decisions consistently holding all claims unpatentable. A550-54; A133-34; A136-38; *see* A561; A1339; A1572; A2505; A2; A3167-68; A97.

The Examiner issued three actions before Lingamfelter appealed to the Board. In response to a first Office Action, Lingamfelter declined to amend any claims and attempted to traverse, to which Requesters commented. *See* A133; A136; A561. The Examiner followed with a 176-page, single-spaced Action Closing Prosecution. *See* A1339. Following a belated attempt by Lingamfelter to amend certain claims (A1518-21), the Examiner issued an equally detailed Right of Appeal Notice (*see* A1572). The Action Closing Prosecution and the Right of Appeal Notice contained 19 rejections, nine involving the independent claims and 10 others directed to just dependent claims. *See* A2510-11.

All parties submitted declarations during the reexamination. Lingamfelter first submitted declarations attesting to claim scope, the applied art, and the Requesters' commercial activities allegedly supporting nonobviousness. *See* A746; A3500. Requesters responded with competing declarations (*see* A1260-69, A1301-21), to which Lingamfelter had the opportunity to reply but chose not to (*see* A1518-26; A3264).

The Board affirmed all or part of five of the nine rejections involving independent claims, adopted two new rejections involving independent claims, and affirmed the rejection of the Handle Claims. A68-71; A83-84; A92. On remand to the Examiner to consider the Board's two new rejections, Lingamfelter amended two dependent claims, submitted additional evidence, and attempted to traverse the Board's new rejections. *See* A2792. The Examiner maintained the Board's new rejections. A3164-99. Following remand, the Board declined to withdraw its two new rejections and re-affirmed that evidence of secondary considerations was unpersuasive to overcome the *prima facie* case of obviousness. A107-115.

**1. Rejections of Height Claims and Column Claims
Based on *Ellis***

Relevant to this appeal, the Board addressed five rejections based on *Ellis* involving the Height Claims and the Column Claims. Those rejections and abbreviations for them, as they are listed in the Board's first Decision (*see* A68-71, A93; A2510-11), are:

Claim Set	Rejection	Abbreviation
Height Claims	Anticipation of claims 1 and 28 by <i>Ellis</i>	Examiner Rejection 1a
	Obviousness of claims 1, 11, and 28 over <i>Ellis</i>	Examiner Rejection 2a
	Obviousness of claim 1 over <i>Ellis</i> and <i>Imazato</i>	Examiner Rejection 3a
	Obviousness of claim 25 over <i>Ellis</i> and <i>Wonnacott</i>	Examiner Rejection 19
Column Claims	Obviousness of claim 19 over <i>Ellis</i> in view of <i>Imazato</i> and <i>Wonnacott</i> or <i>Spivey</i>	Board Rejection 2

First, the Board affirmed that *Ellis* anticipates independent claims 1 and 28 [Examiner Rejection 1a].¹ A34-35; *see* A562-70; A1340-58; A1586-94; A2529-31. These claims require that the carton’s rear-wall height and bottom-wall length be “about a whole multiple” of a can diameter. The Board affirmed the Examiner’s construction of “about” as being “almost” or “nearly.” A32; *see* A563; A1341, A1350-57; A1586; A2521-28. Construing “about” to be a manufacturing “tolerance” to provide tight packaging or to require a column/row arrangement of cans, reasoned the Board, would unduly restrict the claims and read in limitations from the specification. A30-32; *see* A2521-28. Because “about” means “almost” or “nearly,” the phrase “about a whole multiple of the can diameter” reads on the

¹ Because Lingamfelter contests unpatentability on the merits of only the independent claims and the dependent Handle Claims (*see* Br. 31-49), this brief addresses only those claims for simplicity.

height of *Ellis*'s carton, which is 1.93 times a can diameter. A34-35; *see* A2529-30; A1586-93. "About a whole multiple of the can diameter" is not so broad, however, as to encompass $\frac{1}{4}$ of a can diameter (i.e., 1.75 can diameters for a 2x carton holding cans in vertical columns). A51.

Also, independent claim 1 requires a container "comprising ... twelve" cans. The Board rejected Lingamfelter's argument that this language should exclude 13 or more cans. The adopted construction, which allows for more than 12 cans, does not "abrogate" the 12-can limitation, particularly considering that the number of cans "is not tied to any structural or functional limitations within the claims." A40. Because *Ellis* discloses its carton "may be so dimensioned as to carry any number of cans or cylindrical objects, odd or even in number" (A11), and because an *Ellis* carton with 13 cans would have a length equal to a whole multiple of a can diameter and include 12 cans (A36), claim 1 reads on *Ellis* (A35-40).

The Board found it unnecessary to reach the Examiner's additional logic that claims 1 and 28 do not recite carton length in terms of specific cans within the carton. A36; *see* A2530-31; A1369-72. Nor did the Board address that even if "comprising ... twelve" cans means exactly 12 cans, claim 1 reads on a 13-can *Ellis* carton after one can has been removed. *See* A2534; A2361.

Second, the Board affirmed that independent claims 1, 11, and 28 would have been obvious over *Ellis* [Examiner Rejection 2a]. A42-44; *see* A571-73;

A1375-77; A1597-99; A2534-36. The Examiner had made this rejection in the event the claims were found to recite carton length in terms of specific cans within the carton, which the Board did not address. A1597-99. Nonetheless, the Board affirmed this rejection after dismissing each of Lingamfelter's challenges to it. A42-44.

Third, the Board affirmed that *Ellis* in view of *Imazato* would have rendered obvious independent claim 1 [Examiner Rejection 3a]. A45-46; *see* A573-74; A1414-22; A1611-12; A2539-40. Independent claim 1 recites a length for the top wall (or location of a top-wall score line) that is less than the bottom-wall length by "at least about" the can diameter or column width. The Examiner made this rejection in the event "about" could be construed as "not less than" a can diameter, concluding that it would have been obvious to modify *Ellis* in view of *Imazato* to enlarge the top-wall opening. A1611; A2539-40. Without adopting Lingamfelter's restrictive definition of "about," the Board affirmed this rejection after dismissing each of Lingamfelter's challenges to it. A45-46.

Fourth, the Board rejected Column Claim 19 over *Ellis* in view of *Imazato* and *Wonnacott* or *Spivey*, a rejection the Examiner had viewed as "not necessary" in light of other conclusions [Board Rejection 2]. A87-91; A104-07; A3177-79; A1669. Independent claim 19 requires "cans in a row and column arrangement," a carton height "about equal to a multiplicity of whole can diameters," and

“comprising ... twelve” cans. A127. According to the Board, “[t]he Patent Owner’s claimed invention is merely a predictable variation of the carton of Ellis to accommodate an arrangement of cans well known in the art” (A88), such that it would have been obvious “to arrange the cans in the carton of Ellis to be in rows and columns as suggested by either Wonnacott or Spivey” (*id.*). A87-91. “[T]here is an established benefit to providing a row/column arrangement over the arrangement of Ellis such as reduction in the paperboard used.” A106; A88.

Ellis does not teach away from taking its cans out of a staggered relationship, reasoned the Board. A89. A reference can teach away when it discourages a person of ordinary skill from following the reference’s path or leads that person away from the applicant’s path, but nothing in *Ellis* qualifies as teaching away from a row and column arrangement of cans. *Id.* No objective evidence supported Lingamfelter’s contention that modifying *Ellis* to have rows and columns would necessarily involve eliminating its top-wall opening. A105; A3177-79; *see* A3073-74.

Moreover, modifying *Ellis* to have rows and columns would not “destroy the intended purpose of Ellis,” alleged by Lingamfelter to be dispensing cans in a predetermined order. A89. A reference must be viewed for all it teaches, including in *Ellis* the “broader purpose of containing and dispensing cans.” A90. “In our view, this broader purpose of Ellis is clearly evident, and we decline to

view a person of ordinary skill as being merely an automaton.” A104. According to the Board, “even the inventors of Ellis viewed their invention more broadly than as suggested by the Patent Owner since the claims of Ellis do not recite, or otherwise require, staggered arrangements of the cans, nor that the cans to be packaged in the carton are to be dispensed in a predetermined order.” A90.

Fifth, the Board affirmed the Examiner’s rejection of claim 25 over *Ellis* in view of *Wonnacott* [Examiner Rejection 19]. A61-63; *See* A609-11; A1505-10; A1662-67; A2556-58. That claim requires “folding [a] sheet member around a plurality of cans ... arranged in a plurality of stacked rows.” The Board found no basis to construe “stacked rows” as “rows and columns” or to require a columnar arrangement. A62. Restricting the phrase, reasoned the Board, would be tantamount to reading the preferred embodiment into the claims. A63. Therefore, applying the wraparound process disclosed in *Wonnacott* to form *Ellis*’s stacked-row carton rendered claim 25 obvious. *Id.*

2. Rejections of Sidewall Claims and Column Claims Based on *Imazato*

Relevant to this appeal, the Board addressed three rejections regarding *Imazato* as a primary reference.

Claim Set	Rejection	Abbreviation
Sidewall Claims	Obviousness of claims 1, 6, 15, and 28 over <i>Imazato</i> in view of <i>Ellis</i> and <i>Farquhar</i>	Examiner Rejection 4
	Obviousness of claim 11 over <i>Imazato</i> in view of <i>Ellis</i> and <i>Farquhar</i>	Board Rejection 1
Column Claims	Obviousness of claim 19 over <i>Imazato</i> and <i>Ellis</i>	Examiner Rejection 15

The Board first affirmed that it would have been obvious to modify *Imazato* to include oblique sidewall edges or scores based on the teachings of *Ellis* and *Farquhar* for claims 1, 6, 15, and 28 [Examiner Rejection 4]. A46-50; *see* A575-80; A1424-36; A1613-1620; A2540-44. A reason for the modification is “to improve access so that the can may be grasped between the thumb and finger.” A50. The Board dismissed arguments against modifying *Imazato* as “based on speculation as to criticality of the strength of the sidewalls of *Imazato* without persuasive objective evidence.” A49; *see* A2543-44.

Using the same combination, the Board reversed the Examiner and rejected independent claim 11 [Board Rejection 1]. A77-80; A100-04; *see* A3174-79. Similar to claim 15, claim 11 requires a “scored line defining a removable section of the container” that includes segments on the front wall, the top wall, and the side walls, where the sidewall segments are oblique. A127. The Board’s rejection involved “modifying the carton of *Imazato* with its key teaching of a can

dispensing opening at a top-corner of the carton which is defined by the top wall and the front wall so as to incorporate the side wall openings of Ellis and Farquhar to further facilitate removal of cans.” A78-79. The Board disagreed with Lingamfelter that a person of ordinary skill would not have modified *Imazato*’s score lines in view of *Ellis* and *Farquhar* because allegedly the “common wisdom ... is to make dispensing openings just large enough for their intended purpose” and to “minimize the size of weakening features” A101. The Board found insufficient evidence of such “common wisdom” and reasoned that “it is self-evident that presence of, or increasing the size of, perforations or scoring in a given package will necessarily weaken the ultimate strength of the package to some extent.” According to the Board, the question is whether, knowing this fact, a person of ordinary skill would have been dissuaded from providing scores on *Imazato*’s sidewalls (*id.*), which they would not have (A102-103). *See* A3073.

The Board also reversed a rejection that supports its judgment of invalidity for the Column Claims. Notwithstanding independent claim 19’s plain wording—“such that removal of a front wall portion above the front wall scored line segment will define a lip” (A127, emphases added)—the Board declined to adopt a rejection of that claim over *Imazato* in view of *Ellis* [Examiner Rejection 15]. A59-61; *see* A605-06; A1492-99; A1655-57; A2553-56. The Board disagreed “that the peeled back portions of *Imazato*’s carton are capable of being removed simply by the

virtue of the fact that the carton is made of paperboard” (A60), even though “removal ... above the front wall scored line segment” in claim 19 includes peeling back the front wall portion and does not further require tearing along the lip to detach it, as the Examiner had found. A2553-56 (“As to that argument the [sic] that ‘removal’ has the meaning of complete separation from the carton, there is no requirement in claim 19 for this interpretation.”). Indeed, Lingamfelter had attempted to narrow claim 19 to require removal “along the front wall scored line segment” rather than “above” it, but prosecution had already closed. A1519-20, A1523-24; A1578-79; A1544-48. Moreover, the Board did not agree that “scored lines” as claimed read on *Imazato*’s front-wall fold lines, even though the patent defined “scored line” as “grooves, scratches or notches, or any other means known in the trade to weaken the paperboard such that it is easier for the user to remove portion twelve.” A126 at 3:41-44; A60-61.

3. Rejections of Handle Claims

For the Handle Claims, the Board affirmed the various claim rejections relating to top-wall handles. A54-58, A69-70; A1637-45, A1659-61.

Claims	Rejection	Name
Handle Claims	Obviousness of claims 3, 8, and 17 over <i>Imazato, Ellis, Farquhar</i> , and admitted prior art (“APA”)	Examiner Rejection 8
	Obviousness of claim 3, 8, and 17 over <i>Imazato, Ellis, Farquhar</i> , and <i>Palmer</i>	Examiner Rejection 9
	Obviousness of claims 3 and 12 over <i>Ellis</i> and APA	Examiner Rejection 10a
	Obviousness of claims 3 and 12 over <i>Ellis</i> and <i>Palmer</i>	Examiner Rejection 11a
	Obviousness of claim 3 over <i>Ellis, Imazato</i> , and APA	Examiner Rejection 12a
	Obviousness of claim 3 over <i>Ellis, Imazato</i> , and <i>Palmer</i>	Examiner Rejection 13a
	Obviousness of claim 22 over <i>Imazato, Ellis</i> , and APA	Examiner Rejection 16
	Obviousness of claim 22 over <i>Imazato</i> and APA	Examiner Rejection 17
	Obviousness of claim 22 over <i>Imazato, Ellis</i> , and <i>Palmer</i>	Examiner Rejection 18

While handles present a design tradeoff by weakening a carton, reasoned the Board, that tradeoff would not have rendered the choice unobvious for a carton having a top-corner opening. A55; A2549-50. Nothing in the art taught away from including handles and openings on the top wall of a carton. A55-56.

4. Secondary Considerations

The Board also found unpersuasive Lingamfelter’s evidence of secondary considerations of nonobviousness. A63-66; A107-114. That evidence

predominantly involved the Fridge Pack, a product buoyed by substantial advertising, having a slender shape for refrigerator loading not recited in Lingamfelter's claims, and enjoying market exclusivity by Coca-Cola. A63-66; A1267-69. According to the Board, "the required 'nexus' between the merits of the claimed invention and the purported evidence of secondary considerations has not been established" (A65), the same conclusion the Examiner reached after extensively weighing all available facts (A1251-55; A1378-89, A1398-414, A1599-610; A2536-39; A3179-83, A3190-96).

Following Lingamfelter's additional submissions on remand regarding alleged significance to the top-corner opening, the Board found that "even when the evidence in the record is reconsidered together with the Patent Owner's new evidence," the conclusion remains the same. A107. While Lingamfelter relied on alleged commercial success of Fridge Pack, the Board found "there is evidence that the success may have been largely due to other factors" A112. Notably, the slender shape of the Fridge Pack, "which allows it to be easily received in the consumer's refrigerator," and "[p]romotion and advertising of the Fridge Pack in an amount in excess of \$16,000,000 since 2001" were primary factors. A109-10. Moreover, Lingamfelter failed to disclose details of an alleged license with Pepsi, a company that did not find commercial success for a 3x4 configuration with a top-corner opening as expressly disclosed in the '673 patent and dropped it "at

significant expense, in favor of the 2x6 configuration.” A113. This evidence “significantly diminish[ed] the strength of the Patent Owner’s argument as to the nexus between the claimed feature and the success.” A112.

In short, “the evidence of success and praise of the commercially sold ‘Fridge Pack’ and similar cartons does not outweigh the evidence of record pointing to the obviousness of the claimed invention.” A114. The Board also dismissed Lingamfelter’s other alleged secondary considerations as not having an appropriate nexus to the claims. A64; A114-15.

This appeal followed.

SUMMARY OF THE ARGUMENT

This Court should affirm the unpatentability of all claims in the '673 patent.

Regarding the Height Claims, the Board properly construed “about” to mean “almost” or “nearly” and concluded that *Ellis*'s carton height of 1.93 can diameters is “about a whole multiple of a can diameter.” Although not necessary, the Board also correctly construed “comprising ... twelve” cans to include 12 or more cans. Since Lingamfelter's appeal of the rejections of the Height Claims based on *Ellis* turns entirely on the construction of “about” and “comprising,” which are correct, the Court should affirm those rejections.

Regarding the Column Claims, substantial evidence supports the Board's findings regarding *Ellis*. That reference discloses all limitations of the Column Claims except cans arranged in columns, while cartons with cans in columns were commonplace and commercially desirable. Therefore, modifying the *Ellis* carton to hold cans in columns would have been an obvious variation, as the record indicates.

For the Sidewall Claims, *Imazato* discloses all limitations except the top-corner opening including the carton sidewalls. *Ellis* and *Farquhar*, however, disclose accessing the cans via sidewalls, and *Farquhar* explains that side access exposes the top and bottom of a can that might otherwise be difficult to grasp. Moreover, *Farquhar* teaches using a continuous score line across multiple surfaces

to form the dispenser opening for a carton. Accordingly, the Court should affirm these rejections.

The Handle Claims are also not patentable. Placing a handle on the top of a beverage carton is conventional and common sense. The art did not teach away from including both a handle and portions of an opening on the top wall of a beverage carton.

Moreover, substantial evidence supports the Board's findings regarding lack of secondary considerations of nonobviousness. Any commercial success for the accused Fridge Pack rests with its slender 2x6 configuration that fits on refrigerator shelves, Coca-Cola's advertising for the roll-out, and the fact that it quickly became the only package available for Coca-Cola's canned products. Indeed, Pepsi shifted from a 3x4 package with a top-corner opening to a 2x6 package at great expense, indicating that the shape and not the opening was paramount.

Finally, the PTO acted properly in accepting declarations from all parties. The PTO's policy is entitled to *Chevron* deference and is consistent with a reasonable interpretation of "written comments" in the statute. While Lingamfelter would prefer to have submitted declarations without rebuttal—including ones addressing commercial activities of Requesters' products—the PTO's acceptance of declarations from all parties comports with Congress's intention for *inter partes* reexamination and does not violate due process.

ARGUMENT

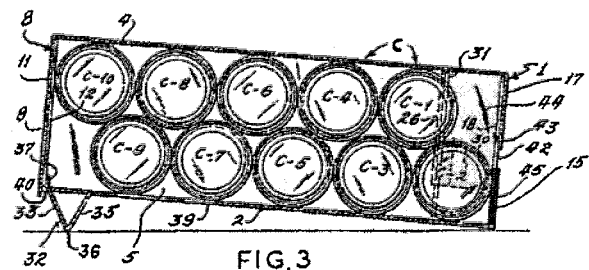
I. The Board Properly Held All Claims Unpatentable

The Board concluded that all claims of the '673 patent are unpatentable over either *Ellis* or *Imazato* as primary references. Lingamfelter has not identified legal error or a lack of substantial evidence undermining those rejections, and this Court should affirm. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359,1363 (Fed. Cir. 2004) (“We review the Board’s legal conclusions de novo and uphold its factual findings if they are supported by substantial evidence.”).

A. Rejections Based on *Ellis*

The Board’s two Decisions resulted in rejections of the Height Claims (claims 1, 11, 19, 25, and 28) involving *Ellis* as a primary reference. Relevant to Examiner Rejections 1a, 2a, 3a, and 19, claims 1, 11, 25, and 28 contain no

limitations to a configuration of cans in columns but require a rear-wall height and a bottom-wall length of “about a whole multiple”



or “about equal to a multiplicity” of a can diameter. Under the Board’s correct construction of “about,” *Ellis* discloses the claimed carton. Relevant to Board Rejection 2, claim 19 requires cans in a “row and column arrangement” and modifying *Ellis* into this ubiquitous configuration would have been a natural step in light of the art.

1. For the Height Claims, *Ellis* Discloses the Claimed Carton

The Board properly concluded that “about” means “almost” or “nearly” and that, for claims 1, 11, 25, and 28, *Ellis*’s carton height of 1.93 times a can diameter is “about a whole multiple” of a can diameter [Examiner Rejections 1a, 2a, 3a, and 19]. A30-35, A42-46, A61-63. Lingamfelter challenges the construction of “about” and, although not necessary to resolving these rejections, “comprising.” In both instances, the Board construed the terms correctly in keeping with their broadest reasonable interpretations, as the PTO requires during reexamination. *In re Yamamoto*, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984).

a. “About” Means “Almost” or “Nearly”

The Board properly construed “about” to have its ordinary meaning of “almost” or “nearly.” A34-35. Dictionaries uniformly define “about” as “almost” or “nearly” (*see, e.g.*, Webster’s Int’l Dictionary 5 (3d ed. 1993)), and this Court has recognized that “the word ‘about,’ avoids a strict numerical boundary to the specified parameter.” *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217 (Fed. Cir. 1995). Also, nothing in the ’673 patent indicates criticality to the term. *See Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1368-69 (Fed. Cir. 2008) (considering criticality to “about” in defining the term “about 30 μm ”).

At most, the specification uses the term in the context of rounding numbers. According to the patent, a stack of three cans, each “typically about 6.6 cm,” will

be “about 20 cms” high, which simply rounds up 19.8 cm [$3 \times 6.6 = 19.8$] to 20 cm. A125 at 2:64-67 (emphasis added). The specification also rounds down the length of four can diameters [$4 \times 6.6 = 26.4$] to “about 26 cms.” *Id.* at 2:64-66 (emphasis added). Accordingly, “about” means “almost” or “nearly.”

Lingamfelter criticizes this construction, but provides no guidance for concluding differently. Indeed, his latest proposal—“snug”—introduces more ambiguity than it removes. Br. 29.² And it continues the shifting constructions Lingamfelter has offered, from a manufacturing tolerance of “ $1/32^{\text{nd}}$ of an inch or 1%” (A637, A747-48) to “fit for use” (A636; A1721). *Cf.* A1225-28; A1307-08; A1350-58.

Lingamfelter contends that “about” implicitly recites a row and column configuration for claims 1, 11, 25, and 28. Br. 28. But that position improperly reads a “row and column” limitation from the specification, restricts the claims to the preferred embodiment, and discards the “broadest reasonable interpretation” to be followed in reexamination. *In re Am. Acad.*, 367 F.3d at 1364 (“The ‘broadest reasonable construction’ rule applies to reexaminations as well as initial examinations.”). And it ignores that independent claims 6, 15, and 19 already recite a “row and column” limitation and “about a whole multiple” of a can

² Citations to “Br. ___” refer to Brief of Appellant C. Brown Lingamfelter.

diameter for carton height. *See, e.g., Jack Guttman, Inc. v. Kopykake Enters., Inc.*, 302 F.3d 1352, 1358 (Fed. Cir. 2002) (“Furthermore, the other independent claims explicitly recite a ‘substantially straight copy path,’ suggesting that the applicant chose ‘non-tortuous copy path’ to mean something different from, and presumably broader than, a substantially straight copy path.”).

Similarly, the argument that “about” cannot allow the Height Claims to read on “two distinct can configurations” lacks merit. Br. 29. Besides again reading in a “row and column” limitation and limiting the claims to the preferred embodiment contrary to the broadest reasonable interpretation, the argument contradicts Lingamfelter’s efforts to read the claims on the Fridge Pack, which has a slender 2x6 can configuration distinct from any configuration disclosed in the patent.

Lingamfelter contends that the Board erred because its construction of “about” would improperly read on $\frac{1}{2}$ a can diameter when applied to an *Ellis* carton 6.5 cans long (Br. 30), but that is wrong for two reasons. First, the Examiner and the Board never applied “about” as Lingamfelter alleges. Their rejections only read on *Ellis* embodiments having a length exactly equal to a whole multiple of can diameters, such as when holding an odd number of cans. *See* A43. Second, the Board did not construe “about” as broadly as Lingamfelter alleges. In reversing rejections not at issue here, the Board held that “about a whole multiple of a can diameter” is not so broad as even $\frac{1}{4}$ of a can diameter. A52 (“6.25 can

diameters, with a 0.25 can diameter difference, is not ‘about’ six whole can diameters”).

The Board correctly concluded that “about” means “almost” or “nearly.”

b. “Comprising” Is Open-Ended

Lingamfelter contends that “comprising ... twelve” cans should mean exactly 12 cans. Br. 30-31. Because an *Ellis* carton with exactly 12 cans would presumably have a carton length of 6.5 can diameters and not a length of “about a whole multiple of the can diameter,” Lingamfelter asserts that claim 1 would not read on *Ellis*. Br. 30-32. Claim 1, however, is directed to an opened carton. Regardless of the meaning of “comprising,” claim 1 would read on an *Ellis* carton designed for 13 cans—thereby having a length exactly equal to “a whole multiple of the can diameter”—and holding exactly 12 cans after the first one is removed.³ See A2534; A2361. Nonetheless, the Board’s proper construction of “comprising” is addressed below for the sake of completeness.

The Board properly construed “comprising” as being open-ended. A35-40. When used as a transitional term, “comprising” “creates a presumption that the body of the claim is open ... [and] that the recited elements are only a part of the

³ Lingamfelter also raises “comprising ... twelve” cans for claim 19 (Br. 30-31), but the rejection of that claim involves modifying *Ellis* to be a conventional 12-pack with rows and columns [Board Rejection 2], making the scope of “comprising ... twelve” irrelevant for claim 19. See A86-91.

device, that the claim does not exclude additional, unrecited elements.” *Crystal Semiconductor Corp. v. Tritech Microelecs. Int’l, Inc.*, 246 F.3d 1336, 1348 (Fed. Cir. 2001). Correctly acknowledging that presumption, the Board held that “comprising” in claims 1 and 19 “allows for additional cans beyond the recited twelve cans.” A35-40; *see Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1371-72 (Fed. Cir. 2005) (safety razor “comprising ... a group of first, second, and third blades” reads on safety razors with more than three blades).

Of course, “comprising” cannot be used to abrogate limitations or to erase representations made in obtaining the patent. Indeed, in *Dippin’ Dots, Inc. v. Mosey*, this Court rejected a patentee’s effort to rely on “comprising” to expand a claim term after the patentee had convinced the district court to construe the same term restrictively. 476 F.3d 1337 (Fed. Cir. 2007). The claim recited a method of making a novelty ice cream product “comprising ... freezing said dripping alimentary composition into beads....” *Id.* at 1340 (emphasis added). The specification defined “beads” as having a “smooth, spherical appearance,” and the patentee had successfully argued below that “beads” meant “small frozen droplets ... which have a smooth, spherical (round or ball shaped) appearance,” i.e., not irregularly shaped. *Id.* at 1342-43. This Court prevented the patentee from renegeing on its prior construction to capture a method of making a combination of smooth and irregularly shaped beads. *Id.* at 1343.

If anything, the opposite of *Dippin' Dots* applies here. Nowhere does the '673 patent or the prosecution history indicate any criticality to 12 cans. Just as permitting a changed position on a claim term would have disturbed the public notice function in *Dippin' Dots*, restrictively construing “comprising” would disturb the public notice in this case, particularly under the broadest-reasonable-interpretation standard. Indeed, having had the opportunity in this reexamination to amend “comprising” to fix the ambiguity, Lingamfelter is the one to bear the consequences of its breadth. *Yamamoto*, 740 F.2d at 1571-72 (noting that broadest-reasonable-construction standard is balanced with applicant’s opportunity to amend during reexamination).

c. *Ellis* Discloses Carton Height of “About a Whole Multiple of a Can Diameter”

Lingamfelter appeals the rejections of (i) claims 1 and 28 for anticipation over *Ellis* [Examiner Rejection 1a], (ii) claims 1, 11, and 28 for obviousness over *Ellis* [Examiner Rejection 2a], and (iii) claim 25 for obviousness over *Ellis* in view of *Wonnacott* [Examiner Rejection 19] entirely on the construction of “about” and “comprising,” discussed above. Br. 32-37, 49-51. Because those constructions are correct and because Lingamfelter does not otherwise contest the rejections, the Court should affirm them. A1586-94, A1597-99, A1662-67; A2529-31, A2534-36, A2556-58; *see* A2356-62; A1225-41.

Lingamfelter’s additional argument—that if “comprising” is limited to 12 cans then claim 1 cannot read on *Ellis*—is irrelevant and wrong. Br. 32, 34. The claims are not so limited, but, even if they were, claim 1 reads on an *Ellis* carton dimensioned for 13 cans after the first can has been removed. *See* A2534; A2361.

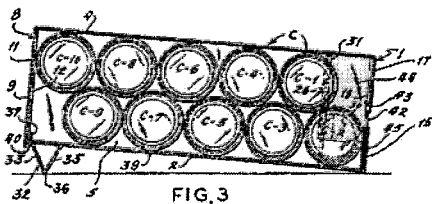
Lingamfelter’s arguments regarding modifying *Ellis* from its staggered arrangement for these rejections are misplaced. Br. 32-34, 50-51. Lingamfelter appears to be defending against hypothetical rejections if the construction of “about” is reversed. For obviousness of claim 1 over *Ellis* alone [Examiner Rejection 2a], however, the Examiner based the rejection on several alternative readings of the claims and *Ellis*, none of which became necessary for the Board given the proper construction of “about” and “comprising.” A1597-99. Thus, the Board correctly affirmed after dismissing Lingamfelter’s specific challenges. A42-44. For obviousness of claim 25 over *Ellis* in view of *Wonnacott* [Examiner Rejection 19], the Board focused on the claimed wraparound process and stacked rows, not “modify[ing] *Ellis* out of its staggered arrangement,” as Lingamfelter contends here. Br. 51; A61-63; *see* A1662-67; A2556-58.

For the rejection of claim 1 for obviousness over *Ellis* in view of *Imazato* [Examiner Rejection 3a], Lingamfelter challenges this rejection on the construction of “about” and “comprising,” discussed above, and on the combinability of these references. Br. 35-37. Lingamfelter points to the different can configurations and

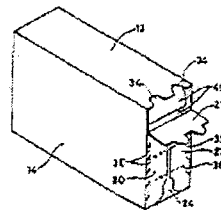
dispensing features in the references, but the Examiner turned to *Imazato* only for the teaching to enlarge its top opening, if that were required by the claim. A2539-40; A1611; A46 (“The Examiner merely relies on *Imazato* for teaching that sizing of the opening is known.”). Accordingly, Lingamfelter’s arguments are off point.

2. For the Column Claims, Modifying *Ellis* to Hold Cans in Columns Would Have Been Obvious in View of *Imazato* and *Wonnacott* or *Spivey*

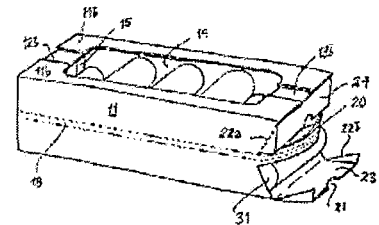
As the Board held, *Ellis* combined with *Imazato* and *Wonnacott* or *Spivey* would have rendered obvious the Column Claims [Board Rejection 2]. A87-91; A104-07; A1611-12; A2539-40; *see* A2361-62. That claim 19 requires, among other things, a carton holding cans in a “row and column arrangement.” A127. At least *Ellis* discloses the claimed top-corner opening, and *Imazato*, *Wonnacott*, and *Spivey* disclose cans in the “row and column arrangement.”



Ellis's FIG. 3
(A3285)



Imazato's FIG. 5
(A188)



Wonnacott's FIG. 4
(A220)

Lingamfelter cannot identify a lack of substantial evidence supporting this rejection, which hinges on application of common sense to simple technology. To start, Lingamfelter undermines his own argument in trying to distinguish the Board’s and the Supreme Court’s “automaton” language. Br. 44-45; *KSR Int’l Co.*

v. Teleflex Inc., 550 U.S. 398, 421 (2007) (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). While Lingamfelter suggests that his carton arises from “careful, elegant balancing of design elements” (Br. 45), that does not make it patentable over the prior art. As the Board noted, “The Patent Owner’s claimed invention is merely a predictable variation of the carton of Ellis to accommodate an arrangement of cans well known in the art.” A88-89 (citing *KSR*, 550 U.S. at 417); *see also KSR*, 550 U.S. at 427 (“[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws.”). Indeed, “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 550 U.S. at 420.

Ellis does not have a “primary purpose” of “ordered dispensing,” as Lingamfelter contends. *Ellis* discloses several purposes and functions for its package, including use as a “self-dispensing carton” and as “adapted to be placed in a home refrigerator.” A3286-87; A90.

Also, while Lingamfelter demands an “apparent reason” to combine these references (Br. 45), the record is replete with them. They include: (i) cartons of beverage cans commonly sold for decades contained cans in aligned rows (A1260, A1262), as evidenced by *Imazato*, *Wonnacott*, and *Spivey*; (ii) *Ellis* itself expressly

acknowledges that conventional cartons stored cans in two aligned rows (A3287 at 3:11-13); (iii) a carton containing cans in aligned rows requires less paperboard than does a carton for staggered rows as in *Ellis*'s FIG. 3 (A1263; A88); and (iv) staggering cans requires modifying automatic packaging equipment that *Ellis* describes as "expensive" (A3287 at 3:11), a cost that a skilled artisan would naturally wish to avoid. *See also* A1235-38; A1550-52.

Another "apparent reason" to modify *Ellis* to hold cans in rows and columns comes from Lingamfelter's expert himself—to have a commercially viable package. According to his declaration, "For a package to be commercially viable, that is for it to have any chance of success, it must stand up to the rigors of manufacturing and distribution" (A2877), which cartons holding cans in rows and columns have done for decades. In contrast, *Ellis*'s staggered configuration "creates problems that make it very unattractive from a commercial standpoint." A2878. Its staggered configuration results in "wasted paperboard" that "significantly reduce[s] distribution and cost efficiencies" and adversely impacts distribution systems due to "weak spots" and "stresses" in the package. *Id.* Lingamfelter's expert further declared that the *Ellis* design "is not a package that lends itself to successful commercialization" because "fewer cans per cubic foot can be shipped with *Ellis*" A2878-79. Thus, arranging *Ellis*'s cans in rows and columns adopts a predictable variation in the art driven, among other reasons, by

commercial benefits. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1241-42 (Fed. Cir. 2010) (modifying reference to avoid shelf-space problem for retailers) (citing *KSR*, 550 U.S. at 421 (addressing obviousness when “market pressure to solve a problem” coincides with finite, predictable solutions)).

Finally, Lingamfelter provides no reason to adopt the theory that *Ellis*’s top opening “existed for its ordered dispensing purpose” and would not be included if the package were modified to hold cans in rows and columns. Br. 46. *Ellis* is silent about why its opening (and score line) exists on the top wall. As the Board observed, “the Patent Owner does not provide any objective evidence ... [to] compel its further modification to delete the score on the top wall.” A105; *cf.* A3102. On the other hand, the record supports the conclusion that with the carton’s various purposes, the top-wall opening provides many advantages, such as making the contents of the carton viewable and “freely accessible after the refrigerator door is opened” (A3287 at 3:39-41) and enabling the user to extract all other cans, which roll to the front of the carton in the bottom row (A3286 at 1:39-41). Without a top-wall opening on the *Ellis* carton, a user could not readily see or access the carton’s remaining contents. *See* A3100-04.

B. Rejections Based on *Imazato*

The Board’s two Decisions resulted in rejections of the Sidewall Claims (claims 1, 6, 11, 15, and 28) involving *Imazato* as a primary reference. The

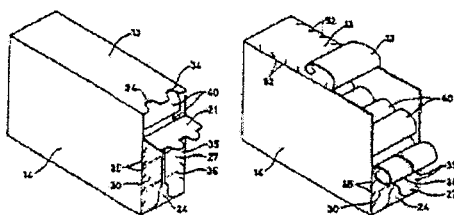
Sidewall Claims require a sidewall edge or a sidewall score as part of the opening. Relevant to Examiner Rejection 4, modifying *Imazato* to include such edges or scores would have been obvious in light of *Ellis* and *Farquhar* to improve access to at least the first can. Similarly, claim 11 requires a continuous “scored line” having segments on the carton’s front, top, and side walls to form a removable section and, relevant to Board Rejection 1, would also have been obvious in light of *Ellis* and *Farquhar* at least because that is the customary manner of forming openings in the art.

Also, although not necessary to resolve this appeal, an alternative ground to support the judgment for the Column Claims is their obviousness over *Imazato* in view of *Ellis* [Examiner Rejection 14], which the Board erroneously reversed.

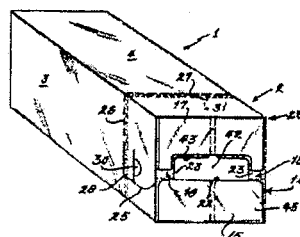
1. For the Sidewall Claims, Extending *Imazato*’s Top-Corner Opening Across Its Sidewalls with a Continuous Scored Line Would Have Been Obvious in View of *Ellis* and *Farquhar*

The Sidewall Claims require, in part, sidewall edges or scores wherein “at least a part of each” is oblique with respect to the front and top walls. The Board properly concluded that it would have been obvious to modify *Imazato* to include oblique sidewall edges or scores based on the teachings of *Ellis* and *Farquhar* [Examiner Rejection 4]. A46-50; *see* A575-80; A1424-36; A1613-20; A2540-44; A3174-77; A2364-66; A3092-96.

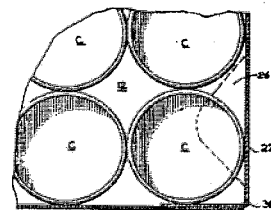
As partly shown below, *Imazato* discloses most of the claimed carton and explains that after opening, “the first metal can on the upper side can be removed.” A182. *Ellis* discloses sidewall edges or scores wherein “at least a part of each” is oblique, and *Farquhar* provides further reasoning to use oblique scores/cutouts in each sidewall to “permit the thumb and forefinger to be readily placed about the ends of cans C whereby the same may be easily grasped and pulled from the carton.” A3292 at 2:70-3:1.



Imazato's FIGS. 5 and 12
(A188, A190)



Ellis's FIG. 1
(A3285)



Farquhar's FIG. 3
(A3290)

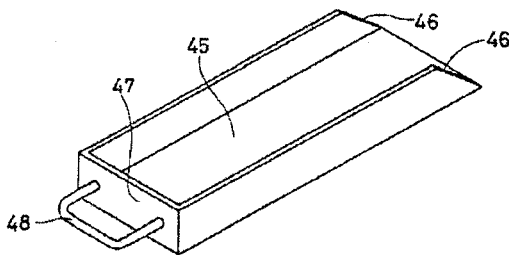
In his brief, Lingamfelter represents that “*Imazato* specifically avoided sidewall openings.” Br. 37. But *Imazato* says nothing about avoiding sidewall openings, and a reference’s silence cannot suffice as a “teaching away.” See *Par Ordnance Mfg., Inc. v. SGS Imps. Int’l, Inc.*, 73 F.3d 1085, 1090 (Fed. Cir. 1995).

Similarly, no support exists for concluding that *Imazato* teaches keeping score lines off the sidewalls to “ensure no loss of strength.” Br. 37. The most *Imazato* says about its score lines is that they “are formed by oblique cut-ins” (A183), which are known in the art to retain better vertical strength than would

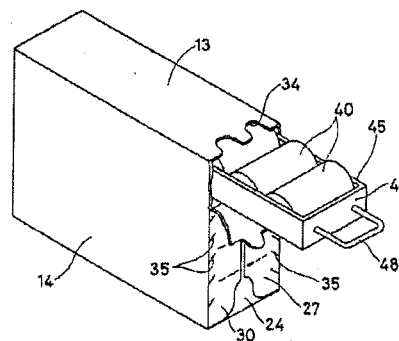
other types of perforations (A1264; A1249). *Imazato* says nothing about keeping them off sidewalls.

Nor does *Imazato* indicate that sidewall strength is “important” or “critical,” as Lingamfelter exaggerates. Br. 39. As the Board observed elsewhere, even if that were the case, loss of strength from scores or weakened areas in a carton may present a tradeoff design consideration, but “such a tradeoff within carton design does not preclude one of ordinary skill in the art from making such a design choice, or render such choice unobvious.” A55; A3076; A1435-36; A2543-44; A3174-77; A3247-51.

Improving *Imazato*’s carton with sidewall scores/edges would not “impair the guiding function, and allow cans to be misaligned as they exit,” as Lingamfelter contends. Br. 37. In fact, *Imazato* discloses a removal tool 45 that may be used to remove one row of cans at a time that includes “inclined surface[s] 46” having oblique sidewalls:



Imazato FIG. 8
(A189)



Imazato FIG. 9
(*Id.*)

Inclined surfaces 46 form the point at which cans are dispensed into a vending machine chute and will not “allow cans to become misaligned as they exit.” Br. 37; A183-84; A2544.

The fact that *Imazato* discloses a two-step opening does not teach away either. Br. 37-38. After the initial step, “the first metal can on the upper side can be removed” (A182), a process for which, according to *Ellis* and *Farquhar*, adding oblique sidewall openings will make it easier to “grasp the ends of cans for pulling cans from the opening of a carton.” A3292 at 2:25-45. Also, “including multiple side wall features to allow the graduated opening” for *Imazato*’s second opening step is not necessary. Br. 38. Improving access to “the first metal can” provides sufficient motivation to combine *Ellis*’s teachings for that purpose. A2543-44.

Lingamfelter’s argument that adding oblique sidewalls to *Imazato* would “require that its whole mode of operation be changed” lacks substance. Br. 38. *Imazato*’s two-step opening process would happen the same way. A1430-36; A1247-48. A user would pull down a top-corner section exposing the “first metal can” to grasp, and the front and top wall would then be “peeled” down and back, respectively, in further stages “in accordance with the need,” as *Imazato* discloses. A184; A366; A1247-48; A2366; A2544.

Finally, accusing the Board of collecting “bits and pieces” from the art “in a treasure hunt,” Lingamfelter simultaneously contends that the Board treated carton

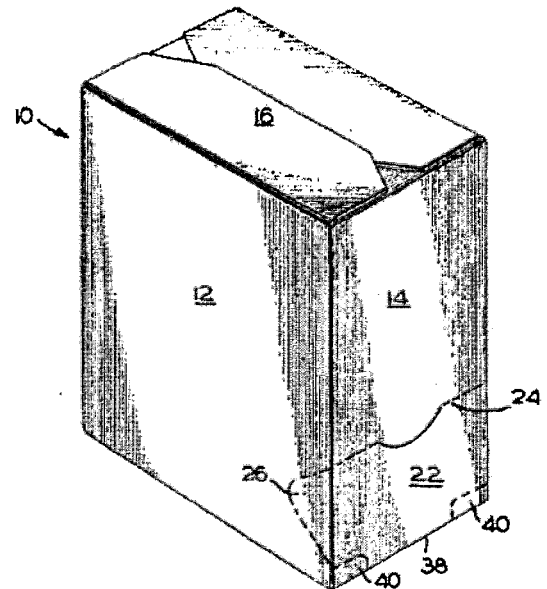
openings as “interchangeable” and endorsed “wholesale replacement of one opening” for another. Br. 40. To the contrary, the Board and the Examiner merely followed the teachings and reasons in the art for improving *Imazato* and did not supplant one opening for another between references as if “plug and play.” Br. 40; *see* A46-50; A1613-20; A2540-44; A1424-36; A2364-66. Indeed, the Examiner refused to adopt certain proposed rejections based on that principle (*see, e.g.*, A1439-41), while the Board clarified that “wholesale replacement” of openings was not a basis for any proposed rejection (A78-79).

Regarding independent claim 11, which requires, in part, a continuous “scored line” having segments on the carton’s front, top, and side walls to form a removable section, *Imazato* discloses all other claim limitations relating to carton geometry and discloses a scored line to define an opening that traverses its top and front walls as claimed. The Board properly concluded that it would have been obvious to modify *Imazato* so that its scored lines traverse the carton’s front, top, and side walls based on the teachings of *Ellis* and *Farquhar* [Board Rejection 1]. A77-80; A100-04; *see* A3174-79.

As noted by the Board, “*Ellis* clearly illustrates a scored line on the side walls interconnected with the scored line on the top wall, and the cut line 25 with the front wall (FF 1) and *Farquhar* illustrates a scored line on the side walls interconnected with the score line on the front wall (FF 9).” A79; *see* A3289

(*Farquhar* and scored line 24 at right).

“Indeed, the prior art relied upon appears to indicate that such score lines on cartons are typically formed in a continuous manner on the carton blank.” A79 (citing *Ellis and Farquhar*). Finally, “a score line defining a removable section is specifically disclosed in *Ellis*.” *Id.*



Lingamfelter does not address the obviousness of a continuous score line fundamental to this rejection. Br. 40-43. Instead, he rehashes many of the same arguments regarding modifying *Imazato*'s sidewalls for the previous rejection, none of which is persuasive as discussed above.

Moreover, the record does not support Lingamfelter's supposed "common wisdom" to make openings "just large enough for their intended purpose." As the Board found, "[T]he evidence indicates that those of ordinary skill in the packaging art routinely design openings for packages having different configurations that incorporate perforations or scoring that is significantly larger than that required for removing the cans." A102. Lingamfelter challenges that finding with opinion and attorney argument, but cannot identify a lack of

substantial evidence undermining the Examiner's and the Board's weighing of facts. *See* A77-80; A3174-79; A100-04.

Lingamfelter's attempt to reword the Board's self-styled issue as "whether [designers] choose openings larger than necessary to accomplish the objective of the designer" just adds confusion and error. Br. 42 (emphasis added); A3174-77. The question is not how the inventors of *Imazato* would have modified their own carton for their own purposes. *See Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."). Second, the "intended purpose" in *Imazato* also includes removal of the first can from the carton (A182, A188 at FIG. 5), for which sidewall openings—making the opening larger than "necessary"—provide an enhancement. And third, nothing in *Imazato* indicates that an opening with oblique side walls would be too large for pouring out cans. A2543-44; A3093-94.

As the Supreme Court has recognized, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR*, 550 U.S. at 417. There is no evidence that enlarging the opening to a beverage carton is beyond the skill of an ordinary artisan.

2. Alternatively for the Column Claims, *Imazato* Discloses That “Removal of a Front Wall Portion Above the Front Wall Scored Line Segment Will Define a Lip”

As discussed in Section I.A.2, *supra*, the Board properly entered a new ground of rejection for the Column Claims for obviousness over *Ellis* in view of *Imazato* and *Wonnacott* or *Spivey* [Board Rejection 2]. A86-91; A3177-79; A104-07. That new ground of rejection is sufficient to dispense with claim 19. Although unnecessary to decide this appeal, another ground to support the unpatentability judgment for claim 19 is the obviousness of that claim over *Imazato* in view of *Ellis* and *Farquhar*, which rejection the Board reversed [Examiner Rejection 15]. A59-61; A605-06; A1492-99; A1655-57; A2553-56; A2367; *see Aventis Pharma S.A. v. Hospira, Inc.*, 637 F.3d 1341, 1343 (Fed. Cir. 2011) (“Attorneys are free to devote as much of their responsive briefing as needed to flesh out additional arguments and alternative grounds for affirming the judgment on appeal.”).

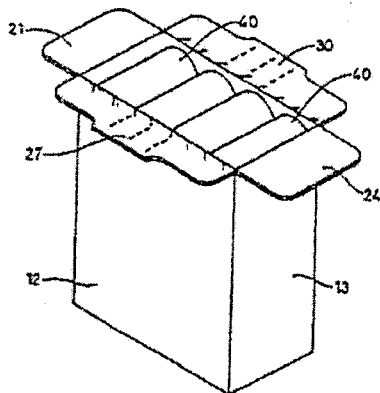
Claim 19 recites “a front wall scored line segment located below the bottom level of the top row and above the bottom level of the next-to-the-top row such that removal of a front wall portion above the front wall scored line segment will define a lip” A127 (emphases added). The Board disagreed that *Imazato* discloses the claimed scored line or removal of a front wall portion (A60-61), but neither conclusion is sound.

The patent defines scored lines as “grooves, scratches or notches, or any other means known in the trade to weaken the paperboard such that it is easier for the user to remove the portion twelve.” A126 at 3:41-44; see A125 at 2:36-38.

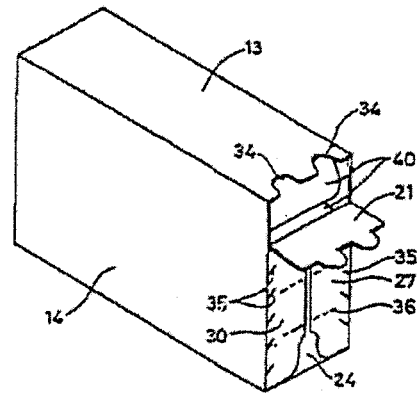
Clearly, this definition—as with the ordinary meaning of “score lines” (A1265)—includes fold lines, which necessarily weaken paperboard. A1656; A2553-56.

Imazato includes “a front wall scored line segment” in the form of fold lines 36.

Those lines are positioned as claimed, as shown by the dashed lines and reference 36 in the figures below:



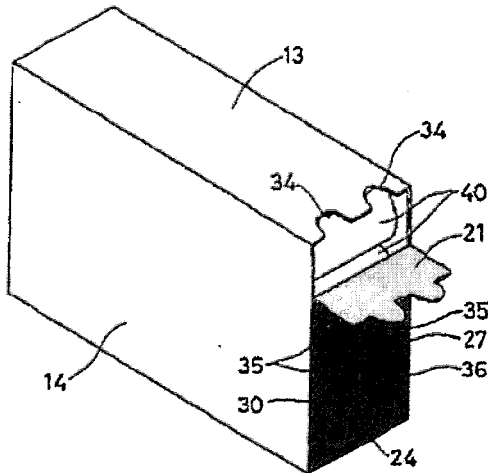
Imazato's FIG. 2
(A187)



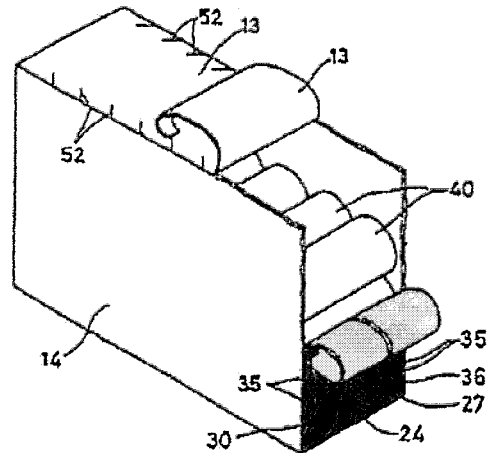
Imazato's FIG. 5
(A188)

Further, the Board believed that “*Imazato* does not disclose or suggest what portion of the front wall is to be removed for defining a lip, or that the peeled back portion of the front wall is capable of being removed.” A60. But *Imazato* plainly shows that its front wall 21 is removed from the rest of the carton “above the front wall scored line segment” (yellow portion below) and “to define a lip that will

retain the next-to-the-top row of cylindrical cans” (intersection of red and yellow portions below):



Imazato's FIG. 5
(A188)



Imazato's FIG. 12
(A190)

The Board's concerns about whether peeled back portions of *Imazato's* carton (yellow portions in figures above) are "capable of being removed," i.e., detached from the carton along the lip, are misplaced. The claims require that "removal of the front wall portion above the front wall scored line segment" defines a lip; whether the yellow removed portion remains hanging from the carton on or below the scored line segment is immaterial. Indeed, Lingamfelter had attempted to narrow claim 19 to require removal "[above] along the front wall scored line segment" to avoid this breadth, but prosecution had already closed. A1519-20, A1523-24; A1578-79; A1544-48; *see* A2367-68.

Accordingly, the Board erred in reversing the rejection of the Column Claims over *Imazato* in view of *Ellis* and *Farquhar*, which rejection supports the judgment.

C. For the Handle Claims, the Art Did Not Discourage Placing a Handle and an Opening on the Top Wall

The Board properly affirmed the rejections of dependent claims 3, 8, 12, 17, and 22, which all require, in different forms, “a handle defined at least partially by a cut-out in the top wall” [Examiner Rejections 8, 9, 10a, 11a, 12a, 13a, and 16-18]. A54-58; A69-70; A2549-50. Lingamfelter’s complaints lack merit.

First, Lingamfelter ignores common sense in questioning “why one would be led to make the combination” of placing a handle in the top of a carton—it makes carrying the package easier. Br. 47. Indeed, the ’673 patent admits that it is conventional to provide a cut-out handle in the top wall (A125 at 1:32-33, 2:64-3:8), and Lingamfelter cannot identify any unexpected results from combining that handle and a conventional top-corner opening.

Second, the prior art does not teach “against combining top opening features with top wall handles,” and Lingamfelter does not identify a lack of substantial evidence on that point. Br. 48; *cf.*; A2372; A2772; A3177-79. While alleging that *Imazato* “teaches away” from a top handle, Lingamfelter fails to cite anything in *Imazato* evidencing such discouragement. *See Para-Ordnance*, 73 F.3d at 1090 (reference’s silence does not teach away). Nothing suggests that *Imazato*’s carton,

which is essentially identical to that in the '673 patent, “would cause a handle to fail.” Br. 48. Lingamfelter accuses the Board of requiring “too much of patent owners” because *Imazato* does not criticize or discredit the combination, but the Board simply applied the standards for teaching away. Br. 49; A56.

Finally, Lingamfelter goes too far in charging the PTO with not weighing design tradeoffs before dismissing Lingamfelter’s *Schuster* arguments. Br. 49. Lingamfelter never contested unpatentability of the Handle Claims to the Examiner and first addressed *Schuster* after reexamination closed. A1469-70, A1471-73, A1475-76, A1500-05 (“Patent owner did not argue this specific rejection.”); A1637-39, A1640-45, A1659-61 (“No arguments have been made by patent owner ... after ACP with regard to the above rejection.”); A1564-66; A1673; A1735.

D. Secondary Considerations Lack a Nexus to the Claims

As before the PTO, Lingamfelter expends considerable effort seeking to have alleged secondary considerations—particularly commercial activities of Requesters’ products—trump clear unpatentability over the prior art. While Lingamfelter accuses the Board of improperly weighing the facts, more than substantial evidence supports the Board’s conclusions.

The Board did not “ignore[]” or “fail to consider” the evidence. Br. 53-54. To the contrary, the Examiner and the Board patiently evaluated Lingamfelter’s theories multiple times. A63-66; A106-07; A1251-55; A1378-89, A1398-414,

A1599-610; A2536-39; A3179-83, A3190-96. As stated by the Board, “We are also not dismissing the evidence of commercial success and praise, or refusing to consider such evidence. Rather, we are weighing the evidence of commercial success and praise together with the countervailing evidence of record ... to conclude that the entirety of the evidence is insufficient to establish non-obviousness.” A113-14.

Lingamfelter seeks a written analysis that “listed all the factors that may have driven success” and weighed their relative importance. Br. 60. But the Examiner performed that detailed analysis (A1251-55; A1378-89, A1398-414, A1599-610; A2536-39; A3179-83, A3190-96), and the Board addressed Lingamfelter’s arguments more than “in a manner adequate to permit judicial review.” *In re Hyatt*, 211 F.3d 1367, 1371 (Fed. Cir. 2000); *see* A63-66; A107-115.

The evidence simply does not support commercial success driven by the claimed top-corner opening. Assertions that “Ellis failed” and “was not successful,” while “the claimed rows and columns are essential to the success” of the Fridge Pack, ignore several facts. Br. 55-56 (emphasis added). First, Lingamfelter provided no evidence that an *Ellis* carton was ever commercialized, successfully or not. Second, most cartons of beverage cans sold in the past 50 years stored cans in “rows and columns.” Third, nowhere does the record indicate

that Lingamfelter crafted his carton by modifying an *Ellis*-type carton. Instead, the '673 patent states that Lingamfelter cut off the top corner of a conventional 3x4 carton with a knife. A125 at 1:37-39; A126 at 3:6-8 & 23-24.

The factor that dominates the attraction for the Fridge Pack is its slender 2x6 shape, which allows the package to fit neatly on a refrigerator shelf. A1267-69. The '673 patent does not even disclose that 2x6 configuration. Tellingly, Pepsi introduced the claimed opening on its existing 3x4 cartons, but did not find commercial success. A1268; A111; A2819-20; A1314-16. Therefore, it moved at significant expense to the 2x6 configuration, similar to the Fridge Pack, which it still sells today. *Id.*

Additional facts likewise undermine Lingamfelter's theories of commercial success, including:

- Lingamfelter's proof on commercial success relates only to the initial launch of the Fridge Pack in which the carton merely supplanted 3x4 cartons (*see* A3109; A1404);
- Lingamfelter's data suggests that the Fridge Pack did not sustain its initial sales increase after its launch period (A765; A1404; A3109; A1251-52);
- Coca-Cola stopped using the Fridge Pack carton design mentioned in Lingamfelter's claim charts around October 2005 (A3074; A3109-10),

and Lingamfelter provided no claim charts relating to products since that time;

- Lingamfelter’s proof is not tied to the purported contribution to the art by the claims (i.e., adding oblique side-wall scores to an *Imazato* carton or enlarging *Ellis*’s carton height by a few millimeters) (A3110);
- Coca-Cola’s change to the Fridge Pack cartons required an expensive conversion of 3x4 manufacturing equipment to make the slender 2x6 package, which would have been unnecessary and not undertaken if consumer demand were driven by the top-corner opening rather than the slender shape (A1268; A3111, A3113-14);
- Coca-Cola made significant advertising and marketing expenditures for the Fridge Pack in its launch of that new carton (A1269; A3114-15), which weighs against success being attributable to the claims (*McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1370 (Fed. Cir. 2003) (“massive marketing and advertising campaign in connection with the launch” of a product obscures any purported nexus)), notwithstanding Lingamfelter’s contrary theories (*cf.* Br. 59);

- Coca-Cola enjoys broad market power and brand attraction, and its advertising and marketing actions can impact consumer behavior (A1269; A3113); and
- When introduced, the Fridge Pack replaced all other Coca-Cola packages for cans in a geographic region, eliminating any choice for consumers purchasing a Coca-Cola canned product (A1269; A3113-14).

Lingamfelter's other alleged secondary considerations are equally flawed. The effort to twist Pepsi's abandonment of the 3x4 package for the undisclosed 2x6 package "due to consumer preference" somehow being "high praise indeed" for the '673 patent defies logic. Br. 61; *see* A1268; A3111-12, A3116-17. Nor does Lingamfelter adequately explain how an undisclosed license, another's non-commercialized design, the lack of technology at issue, allegations between Requesters about a different patent, or Requesters' initial efforts to protect their own designs could possibly substantiate patentability. Br. 61; *see* A3115-19.

II. The PTO Appropriately Received Declarations from All Parties

Without a basis for patentability on the merits, Lingamfelter criticizes the PTO for its procedure in receiving declarations from the third-party requesters. To the contrary, the PTO properly accepted those declarations to balance the record, even though they were unnecessary to finding unpatentability.

Section 314(b)(2) of Title 35 permits a third-party requester in *inter partes* reexamination to file “written comments” addressing an Office Action or a patent owner’s response. According to Lingamfelter, “written comments” excludes declarations or other evidence, making the PTO’s acceptance of the Requesters’ declarations *ultra vires*. Br. 21-25. Moreover, Lingamfelter maintains that his inability to cross-examine Requesters’ declarants deprived him of due process. Br. 25-27. Both contentions are incorrect.

A. The PTO’s Policy Is Entitled to *Chevron* Deference and Follows a Permissible Construction of the Statute

“[T]he Patent Office is specifically charged with administering statutory provisions relating to ‘the conduct of proceedings in the Office’” *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1337 (Fed. Cir. 2008). As such, in particular circumstances, this Court defers to the PTO’s interpretation of those provisions—including the conduct of *inter partes* reexamination under Section 314—under *Chevron, U.S.A., Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837, 866 (1984). Analysis of *Chevron* deference involves determining: (i) “whether

Congress has directly spoken to the precise question at issue,” and, if not, (ii) “whether the agency’s interpretation is based on a permissible construction of the statutory language at issue.” *Cooper*, 536 F.3d at 1337-38 (internal citations omitted).

As Lingamfelter acknowledges, Section 314(b)(2) does not expressly define “written comments.” Br. 22. Under its ordinary meaning, “written comments” can embrace all documentary submissions to the PTO that respond to the Examiner or patent owner positions. Neither other portions of the statute nor the legislative history, however, defines or otherwise addresses the scope of “written comments,” notwithstanding Lingamfelter’s efforts to find support for a restrictive definition from the words “comment” and “argue.” Br. 23. Accordingly, Congress has not “directly spoken to the precise question at issue.” *Chevron*, 467 U.S. at 842.

Through its rules and conduct of *inter partes* reexaminations, the PTO has interpreted “written comments” to include declarations and other evidence. For example, while the Manual of Patent Examining Procedure (“MPEP”) does not expressly interpret “written comments,” it indicates that requester declarations are permitted by including declarations as part of the requester’s page count. MPEP § 2667(I)(A)(2) (8th ed. Rev.8, July 2010) (“Any affidavit or declaration (or a clearly defined portion thereof) that contains opinon(s) [sic] of the affiant/declarant, or argument(s) ... is considered to be part of the comments

submitted by the patent owner, or by the third party requester") (emphasis added); *see also* MPEP § 2671.02 (referring to "complete comments by the third party requester (including early presentation of evidence under 37 CFR 1.131 or 1.132)"). More significantly, as in this case, the PTO has routinely accepted requester declarations in many *inter partes* reexaminations, dating back to the first one ever filed. *See* Control No. 95/000,001, *available at* <http://portal.uspto.gov/external/portal/pair>.

Lingamfelter summarily concludes that regulations relating to reopening reexamination on remand "distinguish 'comments' from 'evidence.'" Br. 23-24 (citing 37 C.F.R. § 41.77(c) (2004)). But those regulations use the terms interchangeably and not comparatively, particularly when viewed in light of the PTO's practice of accepting requester declarations on remand from a Board decision. Moreover, the regulations contemplate requesters submitting declaration evidence in their briefs to the Board. 37 C.F.R. § 41.68(b)(1)(viii) (2004) ("*Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or any other evidence entered by the examiner and relied upon by respondent in the appeal") & 41.68(b)(2) ("A respondent brief shall not include ... any new or non-admitted affidavit or other evidence.") (emphases added).

The PTO's interpretation of "written comments" to include requester declarations is reasonable. Indeed, declarations and their affiliated evidence are both "written" and are presented as "comments" in response to an Office Action or patent owner's position. Moreover, the PTO's interpretation comports with the purpose of *inter partes* reexamination. *Ex parte* reexaminations were "used infrequently since a third party who requests reexamination cannot participate at all after initiating the proceedings," and Congress hoped that allowing requesters greater participation in reexamination would "reduce expensive patent litigation in U.S. district courts." H.R. Conf. Rep. No. 106-464, at 133 (1999). In exchange for greater participation rights for requesters, Congress placed onerous estoppel provisions on requesters. *See id.*; 35 U.S.C. § 317(b). Therefore, construing "written comments" to include declarations comports with Congress's intent for greater participation, while excluding them would frustrate that intent, both by restricting requester participation and causing requesters to favor litigation.

The new Leahy-Smith America Invents Act ("AIA") confirms the propriety of the PTO's interpretation. Specifically, among the "improvements" to *inter partes* challenges, the AIA permits depositions of declarants from all parties, indicating that Congress understood current practice to include submission of declarations without deposition. H.R. Rep. No. 112-98(I), at 57 (2011) ("Parties may depose witnesses submitting affidavits or declarations and seek such

discovery as the Patent Office determines is otherwise necessary in the interest of justice.”); *see Bell v. New Jersey*, 461 U.S. 773, 784-85 (1983) (“[T]he view of a later Congress does not establish definitively the meaning of an earlier enactment, but it does have persuasive value.”).

While Lingamfelter contends that declarations and evidence from requesters “upsets Congress’s carefully selected balance in *inter partes* reexaminations” and places patent owners “at a decided disadvantage” (Br. 24), that is not correct. Muzzling requesters would create imbalance by permitting patent owners to submit “cherry-picked evidence” with no recourse from requesters. Indeed, it is particularly egregious for Lingamfelter to suggest that he should be entitled to present declarations and evidence relating to commercial activities for Requesters’ products, while the Requesters should be forbidden from submitting corrective or contrary evidence. *See* Br. 24. Allowing declarations and evidence from all parties—as the PTO permits—levels the playing field and does not advantage either side.

B. The PTO Did Not Violate Due Process

Finally, Lingamfelter alleges that the PTO deprived him of due process by allowing Requesters to submit declarations. Br. 25-27. Lingamfelter has failed to show that due process requires the PTO to afford him the opportunity to cross-examine the declarant or to conduct discovery. “Due process is flexible and calls

for such procedural protections as the particular situation demands.” *Mathews v. Eldridge*, 424 U.S. 319, 334 (1976) (quotations and citations omitted). It does not always require the opportunity to cross-examine an adverse witness or the right to conduct discovery. *See, e.g., Cellular Mobile Sys. of Pa., Inc. v. FCC*, 782 F.2d 182, 198 (D.C. Cir. 1985) (“Cross-examination is therefore not an automatic right conferred by the APA; instead, its necessity must be established under specific circumstances by the party seeking it.”).

Lingamfelter also argues that the PTO’s decision to consider Requesters’ declaration evidence deprived him of due process rights because he “may have no opportunity to rebut, depending on when the requesters offer the evidence.”

Br. 26. But *inter partes* reexamination enables patent owners to rebut any declaration from a requester, even if the next action closes reexamination. 37 C.F.R. § 1.951(a) (2001) (“After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution.”). The multi-stage process of reexamination afforded Lingamfelter the repeated ability to air his issues and respond to those of the Requesters.

Inter partes reexamination provides a balanced approach for third parties to challenge validity and have the PTO reassess a patent grant. Following that

balanced approach in this case, the PTO did not disturb any of Lingamfelter's due-process rights.

CONCLUSION

The Board properly held unpatentable all claims of the '673 patent. This Court should affirm.

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that on November 21, 2011, two true and correct copies of the foregoing Brief for Appellee MeadWestvaco Packaging Systems, LLC were served by the indicated means to the persons at the addresses listed:

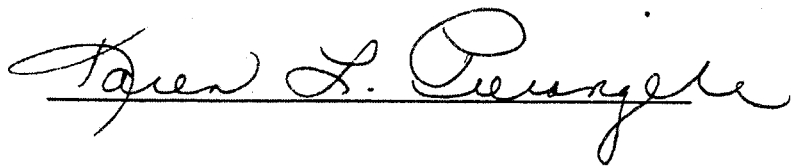
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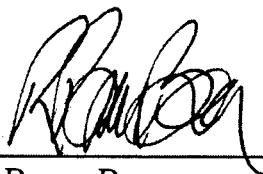


CERTIFICATE OF COMPLIANCE

I certify that the foregoing Brief for Appellee MeadWestvaco Packaging Systems, LLC contains 12,554 words as measured by the word processing software used to prepare this brief.

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