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Paper 9
Entered: June 1, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EURAMAX INTERNATIONAL, INC.,
Petitioner,

v.

INVISAFLOW, LLC,
Patent Owner.

Case IPR2016-00423
Patent 8,556,195 B1

Before SALLY C. MEDLEY, LYNNE E. PETTIGREW, and AMANDA F. WIEKER, *Administrative Patent Judges.*

WIEKER, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, Euramax International, Inc., filed a Petition requesting an *inter partes* review of claims 1–11 of U.S. Patent No. 8,556,195 B1 (Ex. 1001, "the '195 patent"). Paper 1 ("Pet."). In response, Patent Owner, Invisaflow, LLC, filed a Preliminary Response. Paper 7 ("Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted "unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

For the reasons set forth below, we institute an *inter partes* review of claims 1–11 of the '195 patent.

A. Related Matter

According to Petitioner, the '195 patent is involved in the following lawsuit: *InvisaFlow LLC. v. Euramax International, Inc. et al.*, No. 1:14-cv-3026 (N.D. Ga.). Pet. 1.

B. The '195 Patent

The '195 patent relates to "an attachment for emitting water from a water source." Ex. 1001, Abstract. Figures 1 and 2 are reproduced below.

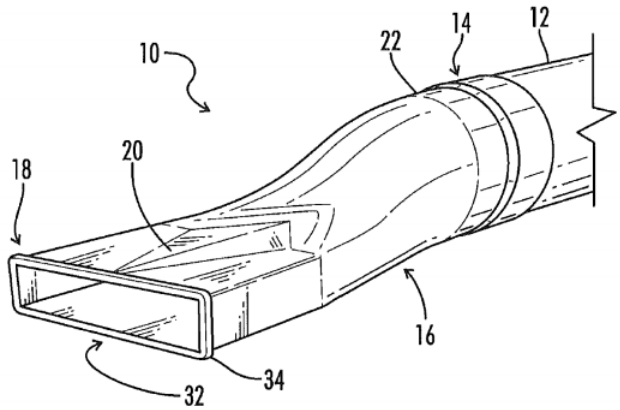

FIG. 1

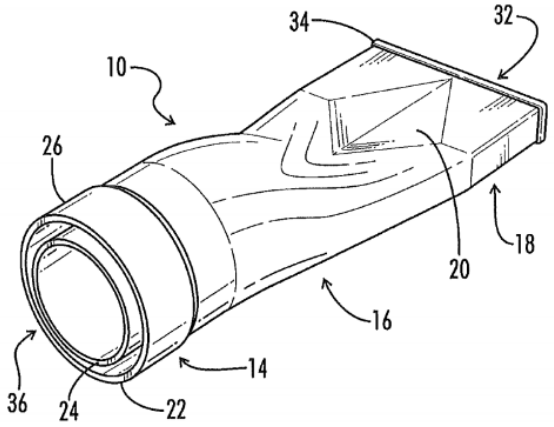

FIG. 2

Figures 1 and 2 depict the attachment of the '195 patent, which includes inlet end 14, outlet end 18, and transitional section 16 therebetween. *Id.* at 3:17–20, 3:45–49.

C. Illustrative Claim

Claim 1 is the only independent claim. Claims 2–11 depend directly or indirectly from independent claim 1.

Claim 1, reproduced below, is illustrative:

> 1. A drainage attachment for directing water from an elevated water source, the attachment comprising:
>
> an inlet end including an intake opening, the intake opening comprising an inlet width, the intake opening including an inlet center point defining a longitudinal axis;
>
> an outlet end comprising a top portion, a bottom portion, and first and second side portions, the outlet end including an outlet opening, the outlet opening comprising an outlet width; and
>
> a transitional section between the inlet end and the outlet end, wherein the transitional section increases in width and decreases in height towards the outlet end;
>
> wherein the longitudinal axis extends in a first plane that is parallel to a second plane that is located between the top and bottom portions of the outlet end and bisects the first and second side portions of the outlet end;

wherein at least a portion of the outlet opening top portion is positioned below the first plane; and

wherein the outlet width is greater than the inlet width to disperse water flowing through the attachment and out of the outlet opening, thereby reducing the effects of erosion adjacent the outlet opening.

Ex. 1001, 6:12–33.

D. Prior Art Relied Upon

Petitioner relies upon the following prior art references:

Francis	US 2,397,655	Apr. 2, 1946	(Ex. 1003)
Farmer	US 1,239,373	Sept. 4, 1917	(Ex. 1004)
Hicks	US 3,640,465	Feb. 8, 1972	(Ex. 1005)
Sweers	US 5,658,092	Aug. 19, 1997	(Ex. 1006)

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Reference(s)	Basis	Challenged Claims
Francis	§ 103(a)	1–11
Francis and Sweers	§ 103(a)	8–9
Farmer	§ 103(a)	1–11
Farmer and Hicks	§ 103(a)	9
Francis and Farmer	§ 103(a)	1–11
Francis, Farmer, and Sweers	§ 103(a)	8–9

II. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. "A drainage attachment for directing water from an elevated water source" (Claim 1, preamble)

Patent Owner contends that the preamble of claim 1 is limiting because it represents the essence of the invention and was relied upon during prosecution of the '195 patent and its parent, Application No. 12/620,327 ("the '327 application"). Prelim. Resp. 13–15. Petitioner disagrees. Pet. 6.

Generally, a preamble is not construed as a limitation. *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002). In particular, when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure, the preamble is not limiting. *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002). A preamble is limiting, however, when "it is 'necessary to give life, meaning, and vitality' to the claim.'" *Id.* (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999)).

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