

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MUNCHKIN, INC.,  
Petitioner,

v.

INTERNATIONAL REFILLS COMPANY LIMITED,  
Patent Owner

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Case IPR2016-01154  
Patent 8,899,420 B2

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Before JOSIAH C. COCKS, BARRY L. GROSSMAN, and  
MICHAEL L. WOODS, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108(a)*

## I. INTRODUCTION

### A. Summary

On June 3, 2016, Petitioner, Munchkin, Inc. (“Munchkin”), filed a Petition (Paper 2, “Pet.”) to institute *inter partes* review of claims 1–17 of US Patent No. 8,899,420 (Ex. 1002, “the ’420 patent”). Patent Owner, International Refills Company Limited (“Int’l Refills”), filed a Preliminary Response (Paper 9, “Prelim. Resp.”) on September 13, 2016.

An *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons set forth below, we conclude that the information presented in the Petition does not establish a reasonable likelihood of success with respect to claims 1–17 of the ’420 patent. We do not institute an *inter partes* review.

### B. Related Matters

Munchkin and Int’l Refills identify the following court proceedings concerning the ’420 patent: *Int’l Refills Co. v. Munchkin, Inc.*, No. 3:16-cv-00094-VLB (Conn.); and *In the Matter of Certain Diaper Disposal Systems and Components Thereof, including Diaper Pail Refill Cassettes* (Inv. No. 337-TA-986) pending in the United States International Trade Commission. Pet. 2;<sup>1</sup> Paper 7, 1.

### C. The ’420 patent

The ’420 patent is titled “Cassette and Apparatus for Packing Disposable Objects into an Elongated Tube of Flexible Material.” Ex. 1002,

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<sup>1</sup> Int’l Refills styles the noted court proceeding in the District of Connecticut as *Edgewell Personal Care Brands, LLC et al. v. Munchkin, Inc.*

Title. Figure 1 of the '420 patent is reproduced below.

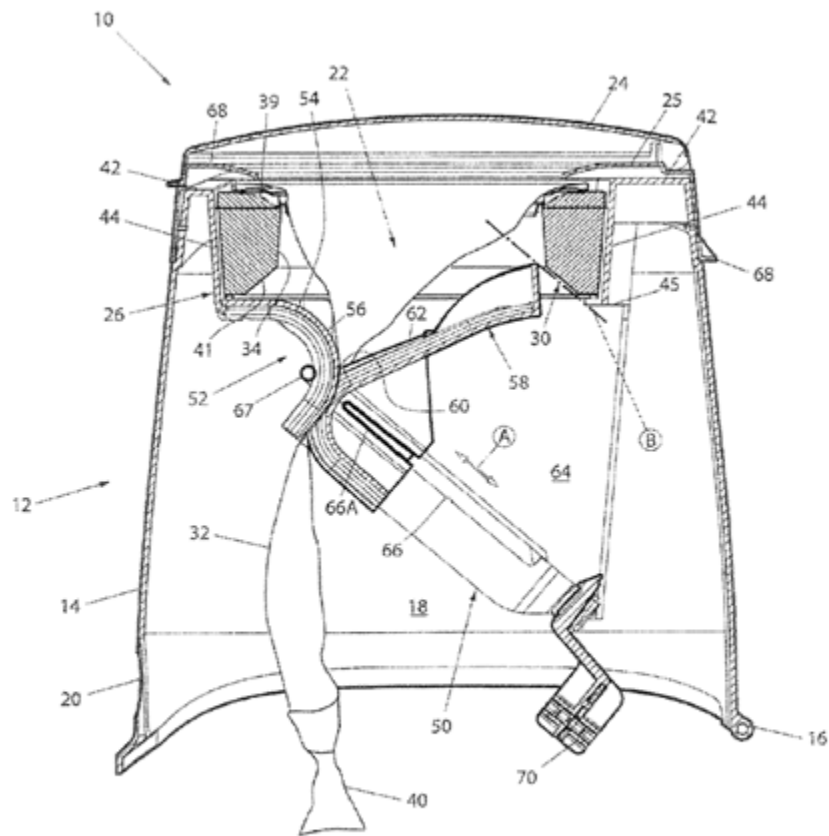


Fig. 1

Figure 1 depicts a cross-sectional view of an apparatus according to an embodiment of the invention. *Id.* at 3:66–67. Apparatus 10 includes bin 12 with top portion 14. *Id.* at 4:28–34. Top portion 14 includes holder 26 that receives cassette 30 containing flexible plastic film tubing 32. *Id.* at 4:54–60. Top portion 14 also includes an opening for receiving disposable objects therethrough. *Id.* at 4:42–43. The '420 patent describes the following as to the use of apparatus 10:

In order to prepare the apparatus 10 for use, and with reference to FIG. 1, a user person removes the lid 24 and funnel 25 assembly and inserts the cassette 30 in the correct orientation (i.e., with the chamfer clearance 41 facing downward.[]) The

user person withdraws a free end of the tubing 32 from the cassette 30, takes a leading edge of flexible tubing 32, ties it into the knot 40 and pushes the knot 40 through the openings 22, 34 and beyond the closing mechanism. It is pointed out that the knot 40 may be made prior to the cassette 30 being installed. The movable portion 58 opens as a result of the downward pressure, whereby the knot 40 reaches the enclosure 18 below the closing mechanism 50.

*Id.* at 7:3–14.

Claims 1, 6, and 11 are independent. Claims 2–5, ultimately depend from claim 1, claims 7–10 ultimately depend from claim 6, and claims 12–17 ultimately depend from claim 11. Claim 1 is illustrative of the subject matter at issue, and is reproduced below.

1. A cassette for packing at least one disposable object, comprising:

an annular receptacle including an annular wall delimiting a central opening of the annular receptacle, and a volume configured to receive an elongated tube of flexible material radially outward of the annular wall;

a length of the elongated tube of flexible material disposed in an accumulated condition in the volume of the annular receptacle; and

an annular opening at an upper end of the cassette for dispensing the elongated tube such that the elongated tube extends through the central opening of the annular receptacle to receive disposable objects in an end of the elongated tube,

wherein the annular receptacle includes a clearance in a bottom portion of the central opening, the clearance extending continuously from the annular wall and radially outward of a downward projection of the annular wall, the clearance delimiting a portion of the volume having a reduced width relative to a portion of the volume above the clearance.

*D. Asserted Ground of Unpatentability*

Petitioner contends that claims 1–17 are invalid under 35 U.S.C. § 102(d) based on the Morand Registration.<sup>2</sup>

II. ANALYSIS

The sole ground of unpatentability proposed in the Petition for claims 1–17 of the '420 patent arises under 35 U.S.C. § 102(d). That section as it appeared prior to the enactment of the Leahy-Smith America Invents Act reads as follows:<sup>3</sup>

**§ 102. Conditions for patentability; novelty and loss of right to patent.**

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(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

A.

At the outset, we observe that 35 U.S.C. § 311 specifically identifies the scope of a *inter partes* review—namely “[a] petitioner in an *inter partes* review may request to cancel as unpatentable 1 or more claims of a patent only a ground that could be raised under section 102 or 103 and only on the

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<sup>2</sup> Community Design Registration No. EM 000792031-0001 issued to Moran on September 9, 2007 (Exhibit 1004, “Morand Registration”).

<sup>3</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 296–07 (2011), took effect on September 16, 2012. Because the application for the patent at issue in this proceeding has an effective filing date before that date, we refer to the pre-AIA versions of the statute.

basis of prior art consisting of patents or printed publications.” Thus, § 311 establishes that a petitioner’s request for *inter partes* review must: (1) be on a ground that could be raised under 35 U.S.C. § 102 or 103, and (2) the ground must be one that is “on the basis of prior art.” Although Munchkin contends that the Morand Registration “is prior art under § 102(d),” Munchkin does not consider appropriately the context of § 102(d). *See* Pet. 8

Pre-AIA § 102 includes seven subsections (a)–(g), and those subsections are considered in connection with certain conditions for patentability, i.e., either: (1) “novelty,” i.e., prior art, or (2) “loss of right to patent.” The Federal Circuit has given guidance as to which of subsections (a)–(g) pertain to which condition of patentability, determining that 102(f)’s status as a “prior art” provision may be somewhat unclear in certain circumstances, but making the following concrete conclusions as to the remaining subsections:

Subsections (a), (b), (e), and (g), on the other hand, are clearly prior art provisions. They relate to knowledge manifested by acts that are essentially public. Subsections (a) and (b) relate to public knowledge or use, or prior patents and printed publications; subsection (e) relates to prior filed applications for patents of others which have become public by grant; and subsection (g) relates to prior inventions of others that are either public or will likely become public in the sense that they have not been abandoned, suppressed, or concealed. Subsections (c) and (d) are loss-of-right provisions. Section 102(c) precludes the obtaining of a patent by inventors who have abandoned their invention. Section 102(d) causes an inventor to lose the right to a patent by delaying the filing of a patent application too long after having filed a corresponding patent application in a foreign country. *Subsections (c) and (d) are therefore not prior art provisions.*

*OddzOn Prod., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1402 (Fed. Cir. 1997) (emphasis added). Thus, the Federal Circuit concluded that § 102(d) is a “loss-of-right” provision rather than a “prior art” provision. Indeed, as noted by the Federal Circuit, § 102(d) has a particular role in acting to deter an inventor from filing a patent application in the United States too long after having filed a corresponding patent application in a foreign country. That role is untethered to any contemplation that a given patent or inventor’s certificate in a foreign country is prior art.

We also take note of content of Exhibit 1008 that was offered by Munchkin in support of its Petition. Pet. 9. Exhibit 1008 is a document titled “First Inventor to File (FITF) Comprehensive Training” and indicates that its specific discussion is directed to “Prior Art Under the AIA.” Ex. 1008, 1. Exhibit 1008 is understood as guidance offered by the United States Patent and Trademark Office (“Office”) to the examining corps in connection with aspects of the AIA. Page 52 of that exhibit is directed to discussion of 35 U.S.C. § 102(d) and includes a statement that “35 U.S.C. 102(d) is NOT the basis for a prior art rejection.” *Id.* at 52. Thus, the guidance offered by the Office indicates a prohibition as to the use of § 102(d) in a “prior art rejection.” That guidance is consistent with the above-noted explanation of the Federal Circuit in *OddzOn Prod., Inc.* pertaining to § 102(d)’s lack of affiliation with prior art.

With the above in mind, we conclude that Munchkin does not offer any adequate explanation as to why a document offered under § 102(d)—a loss-of-right provision—is considered appropriately as a ground presented in a Petition for *inter partes* review as being “on the basis of prior art” as required by § 311.

*B.*

In any event, even were we to assume that it is appropriate to consider a ground offered under § 102(d) in the context of a Petition for *inter partes* review, we discern that an additional and notable defect associated with the Morand Registration emerges.<sup>4</sup> The Manual of Patent Examining Procedure (“MPEP”) provides guidance as to the general requirements of § 102(d). To that end, the MPEP sets forth four conditions that must each be present in order to establish a bar against grant of a patent. MPEP 2135.01. One of those conditions is that the “same invention” must be involved as between the foreign filing and the application for a United States patent. *Id.* More particularly, the MPEP explains that, in such respect, § 102(d) would be applicable if “applicant’s foreign application supports the subject matter of the U.S. claims.” *Id.*

Here, each of independent claims 1, 6, and 11 is directed to a “cassette for packing at least one disposable object,” that includes, among other things, “an annular receptacle” with a “volume configured to receive an elongated tube of flexible material.” Those claims further also separately require “a length of the elongated tube of flexible material disposed in an accumulated condition in the volume of the annular receptacle.” Thus, it is clear that independent claims 1, 6, and 11, and all claims depending therefrom, require a length of an elongated tube of flexible material disposed

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<sup>4</sup> We take note that it is not clear immediately that the Morand Registration, as a community design registration, is a document that “was first patented or caused to be patented, or was the subject of an inventor’s certificate” as is required by § 102(d). For purposes of this Decision, however, we need not resolve that uncertainty.



in a particular configuration, i.e., an accumulated condition, within the volume of an annular receptacle.

The Morand Registration includes five figures illustrating the design of “[f]ilm cassettes for garbage.” Ex. 1004, 3–4. The Morand Registration, however, does not show or illustrate any elongated flexible tubing. In accounting for the claim requirement of such elongated flexible tubing arranged in an accumulated condition with the volume of an annular receptacle, Munchkin contends that the mention of “plastic film” as a part of the Morand Registration somehow “requires” a length of elongated flexible material configured and arranged as required. Pet. 15–16. Munchkin also contends that based on description of background art in the ’420 patent, Int’l Refills “admitted” that it was known to those of ordinary skill in the art to include such material in an accumulated condition in a receptacle. *Id.* at 16.

We determine that Munchkin has not established that the content of the Morand Registration presents the same invention as that of the ’420 patent. The mention of “plastic film” alone is not sufficient to convey the particular elongated flexible tubing of the claims, much less the particular configuration of that tubing, i.e., arranged in an accumulated condition with an annular receptacle. Munchkin also does not explain adequately why consideration of a skilled artisan’s knowledge based on prior art outside of the content of the Morand Registration’s disclosure is appropriate in assessing whether the Morand Registration presents the same invention as the ’420 patent.

Accordingly, even were we to consider § 102(d) as a viable ground of unpatentability in the context of a *inter partes* review, here, we are not persuaded that Munchkin has made an adequate showing that the

requirements of that section are met.

### III. CONCLUSION

For the foregoing reasons, we are not persuaded that the Petition warrants institution of an *inter partes* review. We, thus, do not do so.

### IV. ORDER

It is ORDERED that no trial or *inter partes* review is instituted for any claim of the '420 patent on any ground in this proceeding.

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