

Seyfarth PTAB Blog



A legal look at Patent Trial and Appeal Board decisions and trends

PTAB Brews a Denial That Should Wake Up All Patent Practitioners

By Patrick T. Muffo

The PTAB recently affirmed their earlier denial to institute an Inter Partes Review (IPR) because the original Petition did not sufficiently prove that hotels provide coffee makers in hotel rooms. In *Hamilton Beach v. Courtesy Products*, Case IPR2014-01260, September 2, 2015 (Motion for Reconsideration denied), Hamilton Beach filed a Motion for Reconsideration of an earlier decision to deny institution of the IPR. Specifically, Courtesy Products owns a patent related to single-serving coffee makers provided within a hotel or “lodging establishment.” The Board denied the first Petition because Hamilton Beach cited only “relevant hospitality regulations” or expert declarations for disclosure of the lodging establishment limitations, and had not sufficiently explained the expert declaration cites in the petition.

Some of the challenged claims require the “lodging establishment” limitations in the preamble, while others include such limitations in the body of the claim. For the preamble limitations, Hamilton Beach originally argued that such limitations are presumed limiting. In the Motion to Reconsider, however, Hamilton Beach argued “the preamble is of no significance because it cannot be said to constitute or explain a claim limitation.” The Board found this argument to be the opposite of the original Petition, and declined to revisit their earlier decision in light of new arguments raised for the first time in the Motion.

The Petition also argued the lodging establishment limitations would have been obvious “because these actions are inherent to an in-room beverage service,” and even cited expert declaration paragraphs for support. However, these citations were not sufficiently explained, and were merely cited without further elucidation. The Board therefore concluded that the citations were “improper incorporations by reference of arguments made in the declarations that circumvented page limits that apply to petitions.”

Hamilton Beach also pointed to the prosecution history of the patents at issue to show that hotels historically provide coffee makers in rooms. The PTAB rejected this argument, finding it to be absent in the original Petition and disconnected from the prior art cited by Hamilton Beach.

Takeaway

This decision highlights the importance of not only making the right arguments, but where such arguments are made. The original Petition included citations to what should be a relatively obvious concept – that hotels provide in-room coffee makers. But such arguments were made in the expert declarations and merely cited in the Petition without any explanation. The arguments themselves, no matter how obvious they may seem, must be made in the Petition to avoid the Board scrutinizing petitioners for circumventing page limits.

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