

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AL-KO KOBER, LLC
Petitioner

v.

LIPPERT COMPONENTS MANUFACTURING, INC.
Patent Owner

Case IPR2014-00211
Patent 8,240,744 B2

Before MICHAEL J. FITZPATRICK, BARRY L. GROSSMAN, and
CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

AL-KO Kober, LLC (“Petitioner”) filed a Corrected Petition requesting an *inter partes* review of claims 1-18 of U.S. Patent No. 8,240,744 B2 (“the ’744 patent”). Paper 5 (cited as “Pet.”). Lippert Components Manufacturing, Inc. (“Patent Owner”) filed a Mandatory Notice acknowledging ownership of the ’744 patent, but did not file a Preliminary Response.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a):

THRESHOLD.—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Upon consideration of the Corrected Petition, we determine that the information presented does not show that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any of claims 1-18. Accordingly, we deny the Corrected Petition and do not institute an *inter partes* review of the ’744 patent.

A. *Related Proceedings*

Petitioner states that the ’744 patent is involved in a pending district court case, *Lippert Components Manufacturing, Inc. v. AL-KO Kober LLC*, No. 3:13-CV-697 (N.D. Ind.), filed on July 11, 2013. Pet. 1.

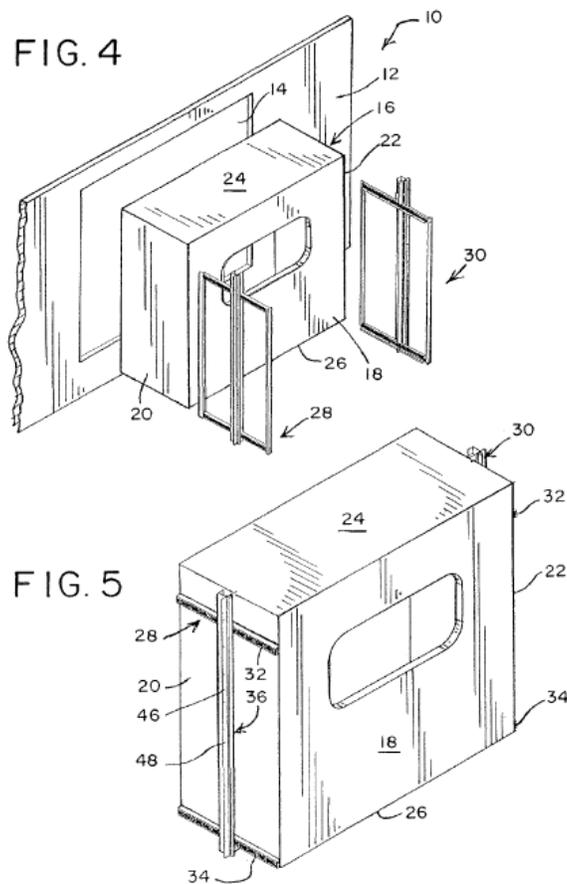
We note also that the ’744 patent and the patent at issue in IPR2014-00213, between the same parties as in this proceeding, are divisional applications of application No. 12/683,332, filed on Jan. 6, 2010, now U.S.

Patent No. 8,016,343. The '343 patent also is the parent of the patent involved in IPR2014-00313, U.S. Patent No. 8,573,666. The parties involved in IPR2014-00313 are the same as the parties in this proceeding, IPR2014-00211.

B. The '744 Patent

The invention claimed in the '744 patent relates, generally, to an actuating mechanism for mobile living quarters, such as a motor home or travel trailer. Ex. 1001, col. 1, ll. 18-23, col. 2, ll. 33-36.

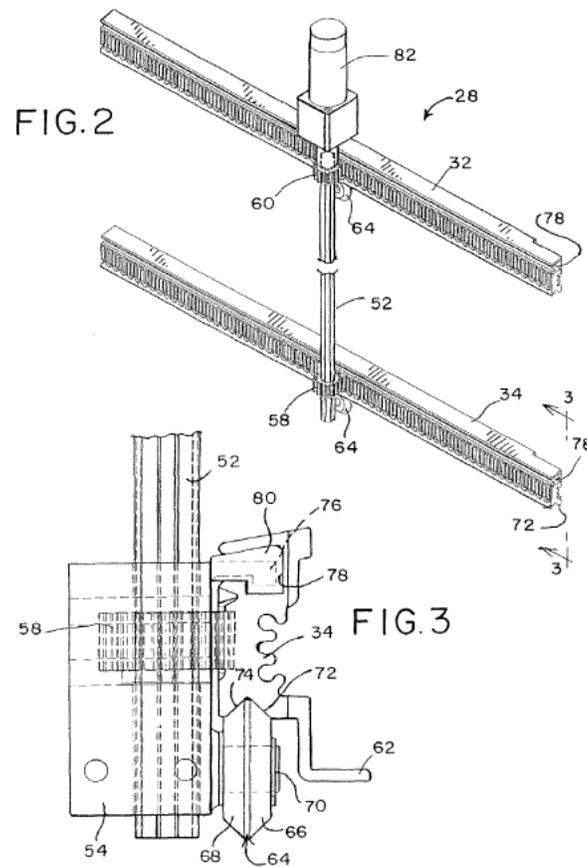
The general structure of the retractable room is shown in Figures 4 and 5 of the '744 patent, reproduced below.



Figures 4 and 5 from the '744 patent.

Mobile living quarters, such as a recreational vehicle, indicated generally at 10, includes side wall 12. Side wall 12 defines aperture 14 through which slide-out room 16 extends and retracts. Ex. 1001, col. 3, ll. 26-31. Slide-out room 16 includes front wall 18, two side walls 20, 22 extending from front wall 18, ceiling 24 and floor 26. *Id.* at col. 3, ll. 31-33. Actuation assemblies 28, 30 are mounted on side walls 20, 22 respectively. *Id.* at col. 3, ll. 34-35. Each actuation assembly includes upper rack or engagement member 32, lower rack or engagement member 34, and cover 36 defining a column which covers the mechanism that drives rack 32, 34. *Id.* at col. 3, ll. 37-41.

As shown in Figures 2 and 3 from the '744 patent, reproduced below, a drive member in the form of splined torque shaft 52 is defined by circumferentially spaced splines 56. Ex. 1001, col. 4, ll. 12-20. Splines 56 of shaft 52 are received in corresponding grooves in pinions 58, 60, which mesh with gear racks 32, 34, respectively. *Id.* at col. 4, ll. 20-23. Roller 64 has bearing faces 66, 68. *Id.* at col. 4, ll. 29-30. Racks 32, 34 have horizontally extending bearing surfaces defined by bearing faces 72, 74, shaped complementary to the cross section of roller 64. *Id.* at col. 4, ll. 36-39. A retention member, in the form of hooked extension 76, extends into a longitudinally extending groove of rack 34. *Id.* at col. 4, ll. 45-47.



Figures 2 and 3 from the '744 patent.

C. Illustrative Claim

Claim 1, the sole independent claim, is illustrative of the claimed invention:

1. An actuating mechanism for mobile living quarters having a side wall and a slide-out room movable relative to the side wall between a retracted position and an extended position extended from the side wall, said slide-out room being movable through an aperture in the sidewall, the actuating mechanism moving said slide-out room between the extended and retracted positions, said actuating mechanism comprising:

a first pair of engagement members mounted on said slide-out room and moving with said slide-out room, each said engagement member having a plurality of slots;

a pair of drive members, each drive member having engagement features meshing with a corresponding engagement member, said drive members being driven together to move said slide-out room between its retracted and extended positions; and

an engagement means maintaining a fixed predetermined distance between said drive members and said engagement members regardless of changes in spacing between said slide-out room and said aperture.

D. References Relied Upon

Petitioner relies upon the following prior art references:

Patent Number	Date	Exhibit Number
US 7,229,123 B2 (“Kunz ’123”)	Jun. 12, 2007	Ex. 1002
US 6,948,754 B2 (“Huffman”)	Sep. 27, 2005	Ex. 1003
US 7,607,365 B1 (“Courser”)	filed Apr. 5, 2007; issued Oct. 27, 2009	Ex. 1004
US 2005/0230989 A1 (“Nebel”)	Oct. 20, 2005	Ex. 1005
US 7,614,675 B2 (“Kunz ’675”)	filed Nov. 29, 2005; issued Nov. 10, 2009	Ex. 1006

E. The Asserted Grounds

Petitioner asserts the following seven grounds of unpatentability:

Claims Challenged	Prior Art	Statutory Basis
1 and 17	Kunz ’123	102
1-4, 6-11, and 14	Huffman	102
17 and 18	Kunz ’123	103
5 and 15	Huffman	103
2-11, 14, and 15	Kunz ’123 and Huffman	103
12 and 13	Kunz ’123, Huffman, Courser, and Nebel	103
16	Huffman, Nebel, and Kunz ’675	103

Pet. 12.

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764, 48,766 (Aug. 14, 2012) (Claim Construction); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). “[W]hen interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Id.* Against this background of general principles, we construe the claim terms in the ’455 patent.

Petitioner proposes specific construction only for the claim term “an engagement means.” Pet. 13-14. Petitioner asserts that this phrase “should not be interpreted as a means-plus-function limitation” under 35 U.S.C. § 112, ¶6.¹ *Id.* at 13. Petitioner asserts this phrase should be “interpreted according to its plain and ordinary meaning as an engagement element, i.e.,

¹ The change creating subsections (a) to (f) in Section 112 does not apply to the ’744 patent. The amendment of Section 112 by Pub. L. No. 112–29 was effective upon the expiration of the one-year period beginning on September 16, 2011, and applicable to any patent application that is filed on or after that effective date, Pub. L. No. 112–29, § 4(e), Sept. 16, 2011, 125 Stat. 297. The application on which the ’744 patent is based was filed on July 12, 2011.

an element that interlocks the drive members with the engagement members.” *Id.* at 14-15.

Section 112, ¶ 6 allows a patentee to express a claim limitation as “a means or step for performing a specified function without the recital of structure, material, or acts in support thereof.” Section 112, ¶ 6 also provides that claim limitations expressed in this manner “shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” This provision applies, however, “only to purely functional limitations that do not provide the structure that performs the recited function.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1311 (Fed. Cir. 2005) (en banc).

The use of the term “means,” as in the claims of the ’455 patent, triggers a rebuttable presumption that § 112, ¶ 6 governs the construction of the claim term. *Inventio AG v. ThyssenKrupp Elevator Americas Corp.*, 649 F.3d 1350, 1356 (Fed. Cir. 2011). Although “the terms ‘means’ and ‘means for’ have become closely associated with means-plus-function claiming” (*id.*), the focus of the analysis is not solely on the word “means” or the phrase “means for,” but on whether the claim, as properly construed, recites sufficiently definite structure to avoid the ambit of § 112, ¶ 6. *Personalized Media Commc’ns, LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 704 (Fed. Cir. 1998); *see also Sage Prods. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed. Cir. 1997) (“[W]here a claim recites a function, but then goes on to elaborate sufficient structure, material, or acts within the claim itself to perform entirely the recited function, the claim is not in means-plus-function format” even if the claim uses the term “means.”)

Because the clause uses the word “means,” we start with the rebuttable presumption that § 112, ¶ 6 governs the construction of the claim term. *Inventio*, 649 F.3d at 1356; *TriMed, Inc. v. Stryker Corp.*, 514 F.3d 1256, 1259 (Fed. Cir. 2008) The presumption is overcome when the limitation further recites sufficient structure for performing the described functions in their entirety. *Id.* “Sufficient structure exists when the claim language specifies the exact structure that performs the functions in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure.” *Id.* at 1259-1260.

We construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations. *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed. Cir. 2002). The function recited in claim 1 is “maintaining a fixed predetermined distance between said drive members and said engagement members regardless of changes in spacing between said slide-out room and said aperture.”

Petitioner asserts that “the use of the term ‘an engagement’ to modify the term ‘means’ in claim 1 provides sufficient structure for carrying out the claimed function of ‘maintaining a fixed predetermined distance....’” Pet. 13. There is no persuasive evidence that the term “engagement” is a structural term. There also is no persuasive evidence that, even if the term “engagement” is structural, it defines sufficient structure for carrying out the claimed function of “maintaining a fixed predetermined distance.”

The word “engagement” has the following dictionary definitions:

1. The act of engaging or the state of being engaged.
- ...
3. Something that serves to engage; a pledge.

...

7. The condition of being in gear.

The American Heritage Dictionary of the English Language, Fourth Edition (2000).² None of these definitions suggests the term “engagement” defines sufficient structure for performing, in its entirety, the described functions recited in claim 1 to rebut the presumption that § 112, ¶ 6 applies.

A modifier of the term “means” may, in some instances, be a structural term, but there is no persuasive evidence that the term “engagement” is a structural term in claim 1. *Compare Enviroco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1365 (Fed. Cir. 2000) (finding that a claim’s recitation of a “baffle means” overcame the § 112, ¶ 6 presumption because “the term ‘baffle’ itself imparts structure”) with *Unidynamics Corp. v. Automatic Prods. Int’l, Ltd.*, 157 F.3d 1311, 1319 (Fed. Cir. 1998) (holding that the claim language “spring means tending to keep the door closed” invokes § 112, ¶ 6, notwithstanding “the recitation of ‘spring,’ which is structural language.”) *See also Baran v. Med. Device Techs., Inc.*, 616 F.3d 1309, 1316-17 (Fed. Cir. 2010) (holding that the phrase “release means for retaining” included the functions of both releasing and retaining, and that the fact the word “release” preceded and modified the “means for” clause did not change the “means-plus-function” interpretation of the claim); *Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1356 (Fed. Cir. 1999) (construing “ink delivery means” to be equivalent to “means for ink delivery” because “ink delivery” was purely functional language).

² Available at <http://www.thefreedictionary.com/engagement>. Last checked on May 2, 2014.

Petitioner does not direct us to evidence in the Specification or elsewhere that persuades us that the phrase “an engagement” recites sufficient structure to remove it from the ambit of § 112, ¶ 6. Petitioner does not identify any specific structure discussed in the Specification or shown in the drawings that is the asserted engagement “structure.” Petitioner refers to “hooked extension 76 and groove 78,” which Petitioner identifies as “one of the structures performing the function of *restraining movement* of the drive members away from the engagement members.” Pet. 15, fn. 2 (emphasis added). The functional limitation in the claim, however, is not “restraining movement,” it is “maintaining a fixed predetermined distance. . . .” As we have interpreted the means plus function clause, hooked extension 76 and groove 78 are part of the structure corresponding to the “means.” Being one of the structures performing the claimed function, or being part of the structure for performing the claimed function, is not a proper construction of the corresponding structure in the Specification for performing the claimed function. Petitioner’s reference to hooked extension 76 and groove 78 is not persuasive that the phrase “an engagement” is structural.

Petitioner also asserts, without citation of supporting evidence, that the term “‘engagement’ is commonly understood to mean the act of engaging, i.e., interlocking or meshing.” Pet. 14. The “act of engaging,” however, is functional, not structural. Also, there is no evidence that “the act of engaging” requires interlocking or meshing, as proposed by Petitioner. *Id.*³

³ Petitioner also proposes that “an engagement means” should be interpreted according to its plain and ordinary meaning as “an engagement element, i.e., an element that *interlocks* the drive members with the engagement

Finally, Petitioner refers to the prosecution history and the co-pending district court case to support the assertion that the “engagement means” is structural, not functional. Pet. 14. Petitioner cites no evidence to establish these asserted facts. Neither the prosecution history nor the referenced case documents are exhibits in this proceeding, and, thus, they are not evidence that is before the Board. 37 C.F.R. § 42.63(a) (“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.”); *see also In re Schulze*, 346 F.2d 600, 602 (CCPA 1965) (“Argument in the brief does not take the place of evidence in the record.”)

Accordingly, for purposes of this decision, based on the totality of facts and law discussed above, we construe the term “an engagement means maintaining a fixed predetermined distance between said drive members and said engagement members regardless of changes in spacing between said slide-out room and said aperture” under § 112, ¶ 6 to cover the corresponding structure, material, or acts described in the Specification, and equivalents thereof.

We turn to the Specification to determine the corresponding structure, material, or acts for performing the claimed function. The structure disclosed in the Specification is the corresponding structure only if the Specification or the prosecution history clearly links or associates that structure to the function recited in a means plus-function claim limitation.

members.” Pet. 14-15 (emphasis added). Without any explanation, this construction requires interlocking but omits the alternative meaning of “meshing” that is acknowledged by Petitioner (““engagement” is commonly understood to mean the act of engaging, i.e., interlocking *or meshing*.”) *Id.* at 14 (emphasis added).

B. Braun Med. Inc., v. Abbott Labs., 124 F.3d 1419, 1424 (Fed. Cir. 1997). We recognize that structural limitations from the written description that are unnecessary to perform the claimed function cannot be imported into the claim. *Welker Bearing Co. v. PhD, Inc.*, 550 F.3d 1090, 1097 (Fed. Cir. 2008) *citing Wenger Mfg., Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1233 (Fed. Cir. 2001). Reviewing the Specification, we find clear and unambiguous reference to the structure for the “engagement means maintaining a fixed predetermined distance. . . .”

As described in the Specification, roller 64 and bearing surfaces 72, 74 of engagement members or gear racks 32, 34 “*form part of an engagement means maintaining a fixed predetermined distance* 81 between the racks 32, 34 and their respective pinions 60, 58.” Ex. 1001, col. 4, ll. 39-43 (emphasis added). The Specification also states “bearing faces [72, 74] will, of course, be shaped complementary to the cross section of the roller.” *Id.* at col. 4, ll. 37-39. “The engagement means restrains movement of the drive members (the pinions 60 and 58) from the engagement members (the racks 32 and 34).” *Id.* at col. 4, ll. 43-45. Hooked extension 76 extends from bearing block 54 into longitudinally extending groove 78 (FIG. 2) of rack 34. *Id.* at col. 4, ll. 45-47. Hooked extension 76 is covered by low friction, plastic shoe 80, which rides in groove 78 as the slide-out room extends and retracts. *Id.* at col. 4, ll. 47-50. “The shoe 80 and groove 78 maintain engagement of the roller 64 with the rack 34 and *further comprise part of the engagement means which maintains engagement of the rack with the pinion by maintaining the fixed predetermined distance* 81 therebetween.” *Id.* at 50-54 (emphasis added).

Thus, we construe the claim term “an engagement means maintaining a fixed predetermined distance between said drive members and said engagement members regardless of changes in spacing between said slide-out room and said aperture” under § 112, ¶ 6 to cover roller 64, bearing surfaces 72, 74 of gear racks 32, 34 shaped complementary to the cross section of roller 64, shoe 80 covering hooked extension 76, and groove 78, and equivalents thereof.

B. Asserted Grounds of Unpatentability

1. Anticipation Based on Kunz '123

a. Claim 1

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

Petitioner asserts that “the track 48 and slide block 42 arrangement of Kunz. . . [meet] the engagement means limitation of claim 1.” Pet. 23, *see also* Pet. 30 (“Thus, the slide block 42 and track 48 of Kunz correspond to the claimed engagement means,” citing Ex. 1007 ¶¶ 16-20). As we have construed independent claim 1, the “engagement means” requires the following structure (or an equivalent): a roller; gear racks having bearing surfaces shaped complementary to the cross section of the roller on which

the rollers roll; and a covered, hooked extension, separate and distinct from the roller, that rides in a groove as the slide-out room extends and retracts. Petitioner has not pointed to any disclosure by Kunz '123 of such structure (or its equivalent).

As asserted by Petitioner, and as shown in Figure 10 of Kunz '123, reproduced below, the bearing surfaces in Kunz '123 are between block 42 and track 48, not between block 42 and gear rack 52, as required by claim 1.

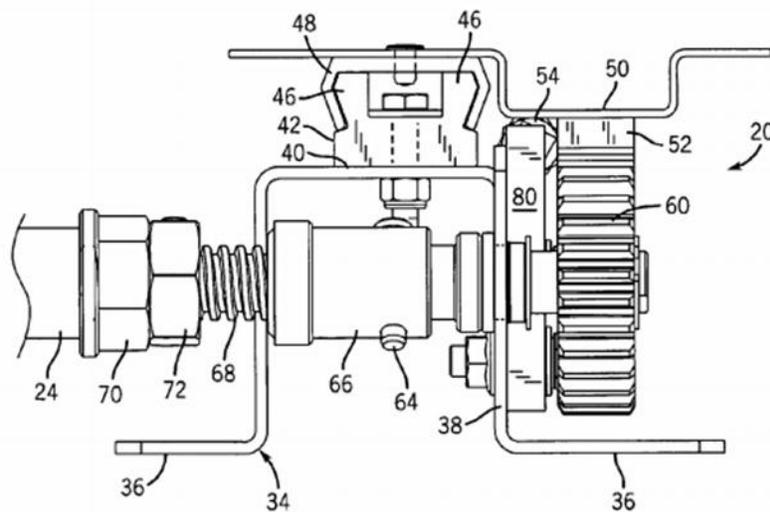


FIG. 10

Figure 10 from U.S. Patent 7,229,123.

In Kunz '123, track 48 is fastened to slide plate 50 that is secured to the floor of the slide-out room. Ex. 1002, col. 3, ll. 44-50. Gear rack 52 is secured to the slide plate parallel and laterally outward of track 48 of each slide unit. *Id.* Thus, the Kunz '123 structure is different from the claimed structure. Petitioner also has not identified any structure in Kunz '123 that corresponds to a covered, hooked extension in claim 1 that rides in a groove as the slide-out room extends and retracts.⁴ Accordingly, the asserted

⁴ In the context of discussing claim 17, Petitioner asserts slide block 42 of

structure in Kunz '123—track 48 and slide block 42—does not meet all the structural limitations of claim 1. It is not enough merely to show performance of the recited function. *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934 (Fed. Cir. 1987) (“[S]ection 112, paragraph 6, rules out the possibility that any and every means which performs the function specified in the claim *literally* satisfies that limitation.”)

Petitioner also asserts “the slide block 42 and track 48 of Kunz [’123] are equivalent to the structures disclosed in the ’744 patent specification for performing the function of ‘*restraining movement* of said drive members away from said engagement members”. Pet. 23, fn. 3 (emphasis added). The function claimed, however, is “maintaining a fixed predetermined distance between said drive members and said engagement members regardless of changes in spacing between said slide-out room and said aperture.” The Specification of the ’744 patent states that the “engagement means restrains movement of the drive members (the pinions 60 and 58) from the engagement members (the [gear] racks 32 and 34).” Ex. 1001, col. 4, ll. 43-45. Restraining movement of the drive members, however, is not the function claimed. “If the required function is not performed *exactly*. . .it must be borne in mind that section 112, paragraph 6, equivalency is not involved. Section 112, paragraph 6, plays no role in determining whether an

Kunz '123 has dovetail portions 46 that are bent or hooked relative to the rest of slide block 42 and base member 34 from which they extend, and angled inward portions of track 48 correspond to the claimed groove. Pet. 30-31. Petitioner also asserts, without citation of evidentiary support, that “[i]n common usage, something that is ‘hooked’ is curved or bent for catching, holding or pulling something.” *Id.* at 30. Dovetail portions 46 do not, however, correspond to the disclosed covered, hooked extension, separate from the roller, as we have construed claim 1.

equivalent function is performed by the accused device under the doctrine of equivalents.” *Pennwalt*, 833 F.2d at 934.

The proper test for determining equivalent structure under § 112, ¶ 6 is whether the differences between the structure in the asserted reference and the structure in the properly construed claim are insubstantial. *See Valmont Indus., Inc. v. Reinke Mfg. Co., Inc.*, 983 F.2d 1039, 1043. (Fed. Cir. 1993) (“In the context of section 112, however, an equivalent results from an insubstantial change which adds nothing of significance to the structure, material, or acts disclosed in the patent specification.”) In our view, the differences between the structure asserted by Petitioner, slide block 42 and track 48 of Kunz ’123, and claim 1 as we have construed it are more than “insubstantial.” As discussed above, for example, the bearing surfaces in Kunz ’123 are between block 42 and track 48, not between block 42 and gear rack 52 as required by claim 1. Also, Petitioner does not point to persuasive evidence that the slide block 42 and track 48 are equivalent to features of claim 1. The cumulative effect of these differences results in a substantially different structure.

Accordingly, on the record before us, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in showing that claim 1 is unpatentable under 35 U.S.C. § 102 based on Kunz ’123.

b. Claim 17

Claim 17 depends from claim 1 and thus includes all its limitations. Claim 17 recites that the hooked extension, which is part of the engagement means, extends from each bearing block into a groove in each engagement member, i.e., in each gear rack 32, 34. The fact that claim 17 recites structure already included in claim 1 based on the claim construction of the

term “engagement means,” does not change our analysis of claim 1.⁵

Because Kunz ’123 does not anticipate claim 1, it also does not anticipate claim 17. Accordingly, on the record before us, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in showing that claim 17 is unpatentable under 35 U.S.C. § 102 based on Kunz ’123.

2. Obviousness Based on Kunz ’123

a. Claims 17 and 18

Claim 17 depends from claim 1 and is summarized above. Claim 18 depends from claim 17 and recites that the hooked extension is covered by a low friction, plastic shoe.

With respect to claim 17, Petitioner asserts that “[r]eversing the arrangement of the hook and the groove would have been obvious to one of ordinary skill in the art.” Pet. 41. The “hook and groove” to which Petitioner refers are dovetail portions 46 of slide block 42 and angled inward portions of track 48. *See* Pet. 30-31. As discussed above, Petitioner has not shown that Kunz ’123 discloses or suggests the “engagement means”

⁵ *See Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1538 (Fed. Cir. 1991) (The interpretation of a “means for” clause “comes from the specification via section 112(6),” not from a dependent claim. Thus, the prohibition against reading limitations from a dependent claim into the independent claim is not violated. . . . “Simply stated, the judicially developed guide to claim interpretation known as ‘claim differentiation’ cannot override the statute. A means-plus-function limitation is not made open-ended by the presence of another claim specifically claiming the disclosed structure which underlies the means clause or an equivalent of that structure. If Laitram’s argument were adopted, it would provide a convenient way of avoiding the express mandate of section 112(6). We hold that one cannot escape that mandate by merely adding a claim or claims specifically reciting such structure or structures.”)

Two pairs of rollers 28 are mounted to support member 26 and support rail member 30. *Id.* Toothed rack 32 is fixed to rail member 30. *Id.* Rotatably driven pinion 34 engages rack 32 to drive rail member 30, and thus the slide-out section. *Id.*

Petitioner asserts Huffman discloses an actuating mechanism that is “designed to restrain movement of the pinions away from their corresponding racks.” Pet. 22. According to Petitioner, because rollers 28 are fixed relative to pinion 34, engagement of the rollers in the C-channels of the rail members restrains movement of the pinions away from the racks and maintains pinion 34 at a fixed distance from rack 32 regardless of changes in spacing between the slide-out room and the aperture in the side wall of the recreational vehicle. Pet. 23-24. Based on this analysis, Petitioner concludes that “rollers 28 and rail members 30 of Huffman meet the engagement means limitation of claim 1.” *Id.* at 24, *see also id.* at 35 (“The rollers 28 and rail members 30 correspond to the claimed engagement means.”)

Our analysis and conclusion are the same as stated above with respect to the asserted anticipation based on Kunz '123. As we have construed independent claim 1, the “engagement means” in claim 1 requires the following structure (or its equivalent): a roller; gear racks having bearing surfaces shaped complementary to the cross section of the roller on which the rollers roll; and a covered, hooked extension, separate and distinct from the roller, that rides in a groove as the slide-out room extends and retracts. Petitioner has not pointed to any disclosure by Huffman of this structure (or an equivalent). As asserted by Petitioner, the bearing surfaces in Huffman are between rollers 28 and the C-channels of rail members 30, not between

rollers 28 and bearing surfaces on gear rack 32, as required by claim 1. Thus, the Huffman structure is different from the claimed structure. Accordingly, the asserted structure in Huffman, rollers 28 and rail members 30, does not meet all the structural limitations of claim 1. *Pennwalt*, 833 F.2d at 934 (“[S]ection 112, paragraph 6, rules out the possibility that any and every means which performs the function specified in the claim *literally* satisfies that limitation.”)

Again, as with Kunz ’123, Petitioner asserts that its analysis and conclusion are the same whether or not the “engagement means” limitation is considered a “means-plus-function” limitation because rollers 28 and C-channel rail members 30 of Huffman “are equivalent to the structures disclosed in the ’744 patent specification for performing the function of ‘restraining movement of said drive members away from said engagement members.’” Pet. 23, fn. 3. As discussed in our analysis of Kunz ’123, the function claimed in claim 1 is “maintaining a fixed predetermined distance between said drive members and said engagement members regardless of changes in spacing between said slide-out room and said aperture.” Restraining movement of the drive members is not the function claimed. “If the required function is not performed *exactly*. . . it must be borne in mind that section 112, paragraph 6, equivalency is not involved. Section 112, paragraph 6, plays no role in determining whether an equivalent function is performed by the accused device under the doctrine of equivalents.” *Pennwalt*, 833 F.2d at 934.

Accordingly, on the record before us, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in showing that claim 1 is unpatentable under 35 U.S.C. § 102 based on Huffman.

b. Dependent Claims 2-4, 6-11, and 14

Claims 2-4, 6-11, and 14 depend directly or indirectly from claim 1 and thus include all its limitations. Because we have determined that Huffman does not disclose the identical invention recited in claim, it follows that Huffman also does not anticipate claims 2-4, 6-11, and 14. *Richardson v. Suzuki*, 868 F.2d at 1236 (“Every element of the claimed invention must be literally present, arranged as in the claim.”)

Accordingly, on the record before us, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in showing that claims 2-4, 6-11, and 14 are unpatentable under 35 U.S.C. § 102 based on Huffman.

4. Obviousness Based on Huffman

a. Claims 5 and 15

Claims 5 and 15 depend indirectly from claim 1 and, thus, include all its limitations. Claims 5 and 15 require “means for ensuring^[6] said engagement members are substantially parallel.” The clauses in claims 5 and 15 are in “means-plus-function” format and are construed in accordance with 35 U.S.C. § 112, ¶ 6. The corresponding structure for performing this function described in the Specification is assembly straps 38, 40, illustrated in Figures 1 and 4, which are temporary straps to assure that the alignment of racks 32, 34 remain parallel to each other. Ex. 1001, col. 3, ll. 49-52. Thus, these straps, and their equivalent, are the structure called for in the claims.

⁶ Claim 15 is identical to claim 5 except it recites “means for assuring. . .” In this context, we view this as a distinction without a difference.

Petitioner asserts that structures incorporating elements arranged to ensure parallelism, features (such as shoulders) on parts for ensuring parallelism, and utilization of jigs or fixtures to ensure parallelism had been known before the effective filing date of the '744 patent, and that the use of such structures or features would have been well known to those of skill in the art. Pet. 43. This assertion fails to establish that the structure called for in the claims, temporary straps, would have been obvious. Petitioner's assertions about what would have been obvious concerning claims 5 and 15 (Pet. 43) also do not cure the deficiencies in Huffman concerning failure to disclose the elements required in independent claim 1.

Accordingly, on the record before us, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in showing that claims 5 and 15 are unpatentable under 35 U.S.C. § 103 based on Huffman.

5. Obviousness Based on Kunz '123 and Huffman

a. Claims 2-11, 14, and 15

For claims 2-6, 8-11, 14, and 15, with the exception of claim 7, Petitioner asserts that one skilled in the art would understand that the roller and rail system of Huffman could also be used in place of slide block 42 and track 48 of Kunz '123 because both arrangements restrain movement of the pinion away from the rack. *E.g.*, Pet. 44. For claim 7, Petitioner asserts one skilled in the art would understand that single shaft 36 arrangement of Huffman could be used in the Kunz '123 actuating system because the single shaft of Huffman performs the same function as the two-piece shaft 22, 24 arrangement of Kunz '123. Pet. 48. Neither assertion overcomes the basic deficiencies of these references in failing to disclose or suggest the structure required by claim 1.

Accordingly, on the record before us, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in showing that claims 2-11, 14, and 15 are unpatentable under 35 U.S.C. § 103 based on Kunz '123 and Huffman.

6. Additional Grounds

Petitioner asserts additional grounds against dependent claims 12, 13, and 16 in which additional references are combined with Kunz '123 and/or Huffman. These additional references, however, fail to overcome the basic deficiencies of Kunz '123 and/or Huffman, as discussed above, in failing to disclose or suggest the structure required by claim 1.

Accordingly, on the record before us, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in showing that claims 12, 13, and 16 are unpatentable under 35 U.S.C. § 103.

III. CONCLUSION

For the foregoing reasons, based on the information presented in the Corrected Petition, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in establishing that any of claims 1-18 of the '744 patent is unpatentable. Accordingly, we deny the Petition and do not institute an *inter partes* review of the '744 patent.

IV. ORDER

For the reasons given, it is

ORDERED that the Petition challenging the patentability of the claims of U.S. Patent No. 8,240,744 B2 is *denied*.

Case IPR2014-00211
Patent 8,240,744 B2

For PETITIONER:

Wesley Mueller
wmueller@leydig.com

Gregory Bays
gbays@leydig.com

For PATENT OWNER:

Mark Hagedorn
mhagedorn@btlaw.com