

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE BRINKMANN CORPORATION,
Petitioner,

v.

A&J MANUFACTURING, LLC,
Patent Owner.

IPR2015-00056
Patent 8,381,712 B1

Before RICHARD E. RICE, SCOTT E. KAMHOLZ, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

KAMHOLZ, *Administrative Patent Judge*.

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

I. INTRODUCTION

The Brinkmann Corporation filed a Petition (Paper 1, “Pet.”) on Oct. 13, 2014 requesting institution of an *inter partes* review of claims 1–20 of U.S. Patent No. 8,381,712 B1 (Ex. 1001, “the ’712 patent”). Patent Owner A&J Manufacturing, LLC filed a Preliminary Response (Paper 6, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

We institute *inter partes* review because we determine that the information presented in the Petition and in the Preliminary Response shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. *See* 35 U.S.C. § 314(a). In particular, we institute *inter partes* review with respect to claims 1–20.

II. DISCUSSION

A. *The ’712 Patent*

The ’712 patent is directed to a barbecue grill that allows, for example, simultaneous gas grilling and charcoal-fueled grilling. Ex. 1001, 2:25–36.

Claim 1 is illustrative of the claimed subject matter and is reproduced below.

1. A barbecue grill having multiple cooking units, comprising:
 - a support structure configured to support a plurality of cooking units;
 - a first cooking unit configured to cook food using gas cooking fuel, the first cooking unit attached to the support structure and including at least one first grill, the first

cooking unit further including an openable first cover attached to the first cooking unit that selectively covers the first grill, wherein the first cover includes at least one exhaust; and

a second cooking unit configured to cook food using solid cooking fuel, the second cooking unit attached to the support structure and including at least one second grill, the second cooking unit further including an openable second cover attached to the second cooking unit that selectively covers the second grill,

wherein the second cover includes at least one exhaust, wherein the first cooking unit and the second cooking unit are simultaneously operable to cook food and the first grill and second grill are selectively and independently coverable.

B. Challenges

Petitioner challenges the claims as follows.

Reference(s)	Basis	Claims Challenged
Koziol ¹ and Holland ²	§ 103	1, 4–10, and 13–16
Koziol, Holland, and Ducate ³	§ 103	2 and 11
Koziol, Holland, and Milloy ⁴	§ 103	3 and 12

¹ U.S. Pat. No. 5,632,265, iss. May 27, 1997 (Ex. 1003).

² U.S. Pat. App. Pub. No. 2002/0179081 A1, pub. Dec. 2, 2002 (Ex. 1004).

³ U.S. Pat. No. 4,886,045, iss. Dec. 12, 1989 (Ex. 1006).

⁴ U.S. Pat. No. 4,664,026, iss. May 12, 1987 (Ex. 1007).

Reference(s)	Basis	Claims Challenged
Koziol, Holland, and Oliver ⁵	§ 103	17–20
Oliver and Holland	§ 103	1, 4, 5, 7–9, 10, and 13–20
Oliver, Holland, and Ducate	§ 103	2, 6, and 11
Oliver, Holland, and Milloy	§ 103	3 and 12
BGE Manual I, ⁶ Holland, and BGE Manual II ⁷	§ 103	1, 2, 4, 5, 7–11, and 13–16
BGE Manual I, Holland, Milloy, and Beller ⁸	§ 103	3 and 12
BGE Manual I, Holland, BGE Manual II, and Ducate	§ 103	6
BGE Manual I, Holland, BGE Manual II, and Oliver	§ 103	17–20

Petitioner also relies on expert testimony of Glen Stevick, Ph.D., P.E. in support of its challenges. Dr. Stevick’s testimony is provided as Exhibit 1010.

C. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012); accord *In re Cuozzo Speed Techs., LLC*, 113 USPQ2d 1613, 1621

⁵ U.S. Pat. No. 6,189,528 B1, iss. Feb. 20, 2001 (Ex. 1005).

⁶ “Big Green Egg Cooking Center Use and Care Manual” (Ex. 1008).

⁷ “Big Green Egg Cookbook and Manual” (Ex. 1009).

⁸ U.S. Pat. No. 5,195,423, iss. Mar. 23, 1993 (Ex. 1013).

(Fed. Cir. 2015) (“Even if the broadest reasonable interpretation standard were not incorporated into the IPR provisions of the statute, the standard was properly adopted by PTO regulation.”). 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).

We determine that no claim terms require express construction for purposes of this decision.

D. Related Proceedings

The salient facts concerning certain other proceedings involving the ’712 patent, as related by Patent Owner, are presented here.

Patent Owner sued Petitioner for infringement of the ’712 patent on August 21, 2013 in a case captioned *A&J Manufacturing v. The Brinkmann Corp.*, No. 2:13-cv-00114 (S.D. Ga) (“the Georgia ’114 civil action”). Paper 5, 2; Prelim. Resp. 5–6. Patent Owner simultaneously sued several other defendants for infringement of the ’712 patent in a series of cases filed in the same court on the same day. Paper 5, 2; Prelim. Resp. 6. Patent Owner sent Petitioner a copy of the complaint in the Georgia ’114 civil action and a request for waiver of service on October 7, 2013. Prelim. Resp. 7; Ex. 2010, 1. Petitioner executed the waiver on October 14, 2013. Ex. 2010, 2. Patent Owner filed Petitioner’s waiver of service with the United States District Court for the Southern District of Georgia on October 21, 2013. Prelim. Resp. 7; Ex. 2010, 1 (header stamp).

Also on August 21, 2013, Patent Owner filed a complaint with the U.S. International Trade Commission (“ITC”) naming 21 respondents,

including Petitioner, Char-Broil, LLC, Academy, Ltd., and Outdoor Leisure Products, Inc. Prelim. Resp. 5. The ITC instituted an investigation, captioned *In the Matter of Certain Multiple Mode Outdoor Grills*, No. 337-TA-895, and served Petitioner with Patent Owner's complaint, on September 23, 2013. Prelim. Resp. 6–7; Ex. 2008, 1.

On September 23, 2013, Char-Broil, LLC sued Patent Owner in a declaratory judgment action challenging the validity of the '712 patent, captioned *Char-Broil, LLC v. A&J Mfg., LLC*, No. 2:13-cv-00140 (S.D. Ga). Paper 5, 2; Prelim. Resp. 7.

On July 17, 2014, Academy, Ltd. sued Patent Owner in a declaratory judgment action challenging the validity of the '712 patent, captioned *Academy, Ltd. v. A&J Mfg., LLC*, No. 4:14-cv-02043 (S.D. Tex.). Paper 5, 2; Prelim. Resp. 9.

E. Standing Challenges

Patent Owner challenges Petitioner's standing to present the Petition and asserts that institution of *inter partes* review is barred. Prelim. Resp. 12–37.

1. 35 U.S.C. § 315(b) Bar Based on Service of Civil Action Complaint

Patent Owner argues that Petitioner was served with the complaint in the Georgia '114 civil action more than one year before the Petition was filed, because Petitioner was sent a copy of the complaint on October 7, 2013. Prelim. Resp. 28–37.

This argument is not persuasive. Petitioner waived service of the complaint, and Patent Owner filed Petitioner's waiver of service with the

district court on Oct. 21, 2013. This is the date that Petitioner is deemed to have been served. *See* FED. R. CIV. P. 4(d)(4) (“these rules apply as if a summons and complaint had been served at the time of filing the waiver”); *accord Macauto U.S.A. v. Bos GmbH & KG*, IPR2012-00004, Paper 18, 16 (PTAB Jan. 24, 2013); *Motorola Mobility LLC v. Arnouse*, IPR2013-00010, Paper 20, 6 (PTAB Jan. 30, 2013); *The Scotts Co. LLC v. Encap, LLC*, IPR2013-00110, Paper 12, 3 (PTAB July 3, 2013).

2. *35 U.S.C. § 315(b) Bar Based on Service of ITC Complaint*

Patent Owner argues that *inter partes* review is barred under 35 U.S.C. § 315(b) because Petitioner was served with the complaint in ITC Investigation No. 337-TA-895 more than one year before the Petition was filed. Prelim. Resp. 28–37. In particular, Patent Owner argues that the ITC served the complaint, as part of its Notice of Investigation, on Petitioner on September 23, 2013. Prelim. Resp. 2; Ex. 2007 (institution notice); Ex. 2008 (certificate of service for institution notice).

This argument is not persuasive. The phrase “served with a complaint alleging infringement of the patent” means a complaint in a civil action for patent infringement, not in an arbitral or administrative proceeding. *Amkor Tech., Inc. v. Tessera, Inc.*, IPR2013-00242, slip op. at 6–18 (PTAB, Jan. 31, 2014) (Paper 98). As explained in *Amkor*, we construe the § 315(b) bar as triggered only by civil actions, because the term “action” in the caption to § 315(b), as well as the phrase “served with a complaint,” connote a civil

action, and because Congress used different language to identify or encompass proceedings before the ITC. *Amkor*, Paper 98 at 7, 9–11.⁹

3. *Bars Premised on Failure to Identify Real-Parties-in-Interest or Actions of Those Supposed Parties*

Patent Owner argues that the defendants named in the other Georgia civil actions, as well as Petitioner’s co-respondents in the ITC proceeding, are real-parties-in-interest to this proceeding because they entered into a joint defense agreement, because many of the unpatentability challenges in the Petition are similar to the invalidity contentions in the ITC proceeding, and because Petitioner’s expert witness in this proceeding, Dr. Stevick, was also the respondents’ expert in the ITC proceeding and was hired jointly by the respondents. Prelim. Resp. 12–27.

This argument is not persuasive, because it is not supported by credible evidence that any of the other defendants or respondents played an actual role in preparing or filing the Petition or has a continuing interest in this proceeding beyond the common interest in any effect of this review on other disputes concerning the ’712 patent. On the present record, we determine, therefore, that institution of *inter partes* review is not barred under § 315(a) or (b) due to the actions of the asserted real-parties-in-interest or privies, nor is the Petition dismissible under § 312(a)(2) for failure to

⁹ Patent Owner argues that *Amkor* is dicta to the extent it deals with the preclusive effect of a “complaint” in an administrative proceeding such as an ITC investigation, because *Amkor* concerned the preclusive effect of a “complaint” in an arbitration proceeding. Prelim. Resp. 30. Regardless of whether that part of the holding is dicta, we agree with the reasoning.

identify all real-parties-in-interest. Patent Owner may pursue this matter during its discovery period, in accordance with our rules.

F. Obviousness of Claims 1, 4–10, and 13–16 over Koziol and Holland

Petitioner argues that Koziol discloses, or a person of ordinary skill would have understood from consideration of Koziol, all limitations of claim 1 except the inclusion of an exhaust by each of the first and second covers. Pet. 9–20 (citing Ex. 1003 *passim*; Ex. 1010 ¶¶ 74–76, 82, 83, 85, 88, 90, 91, 94, 101–13). According to Petitioner, Koziol discloses inclusion of “cut outs” to provide combustion air, but these cutouts are not in the covers. *Id.* at 15 (citing Ex. 1003, 3:52–56). Petitioner argues that Holland discloses a grill assembly having exhaust vent 30 on the grill cover. *Id.* at 15 (citing Ex. 1004 ¶ 23, Figs. 1–8). Petitioner argues that it would have been obvious to add Holland’s cover exhausts to Koziol’s covers in view of Holland’s teaching that it is common to provide grills with exhaust vents to eliminate smoke. *Id.* (citing Ex. 1004 ¶ 4; Ex. 1010 ¶¶ 95–97). Petitioner makes analogous arguments concerning claim 10.¹⁰

Patent Owner argues that Koziol and Holland do not invalidate the claims of the ’712 patent for the reasons given in the Final Initial

¹⁰ Petitioner argues that claim 10 recites several limitations in means-plus-function format, including a “second means for cooking food” which includes an “openable second cover means,” which in turn includes “at least one exhaust” means. Pet. 20–21. Whatever else the “at least one exhaust” means may encompass, we determine for purposes of this decision that it encompasses exhaust structures 112, 212, and 312 disclosed in the ’712 patent.

Determination issued in the ITC proceeding. Prelim. Resp. 37 (citing Ex. 2001, 63–77). This argument is unpersuasive, because Patent Owner does not identify what those reasons are in the body of the Preliminary Response (*see* 37 C.F.R. § 42.6(a)(3)) and because the issue under consideration before us—unpatentability—is not the same as the issue that was before the ITC—invalidity of claims in the face of a presumption of validity. *See* 35 U.S.C. §§ 316(e), 318(a); Changes to Implement *Inter Partes* Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents; Final Rule, 77 Fed. Reg. 48756, 48697 (Aug. 14, 2012); *cf.* 35 U.S.C. § 282(a).¹¹

Upon consideration of the arguments and evidence presented in the Petition and in the Preliminary Response, we determine that Petitioner has demonstrated a reasonable likelihood that claims 1 and 10 are unpatentable under 35 U.S.C. § 103(a) for obviousness over Koziol and Holland. We have considered Petitioner’s arguments and evidence directed to dependent claims 4–9 and 13–16 and are persuaded of a reasonable likelihood that these claims are unpatentable as well.

G. Obviousness of Claims 2 and 11 over Koziol, Holland, and Ducate

Claim 2 depends from claim 1 and further requires a side burner for preparing food using radiant heat or flames simultaneously with the other cooking units. Claim 11 resembles claim 2 but uses “means” language.

¹¹ Petitioner repeatedly mischaracterizes its arguments before us as being directed to “invalidity.” *See, e.g.*, Pet. 6, 21.

Petitioner argues that Ducate discloses a grill having a side gas burner for simultaneous use with a grilling operation. Pet. 24–25 (citing Ex. 1006, 1:43–47, 1:56–58, 3:43–54, Figs. 1–4; Ex. 1010 ¶¶ 125, 126). Petitioner argues that it would have been obvious to add a side gas burner to Koziol’s grill, in view of Ducate’s suggestion of simultaneous operation and Koziol’s disclosure of an auxiliary burner. *Id.* at 25–26 (citing Ex. 1003, 4:17–41, Fig. 6; Ex. 1006, 1:43–47; Ex. 1010 ¶ 127). Patent Owner does not direct any arguments to this challenge specifically.

Upon consideration of the arguments and evidence presented in the Petition, we determine that Petitioner has demonstrated a reasonable likelihood that claims 2 and 11 are unpatentable under 35 U.S.C. § 103(a) for obviousness over Koziol, Holland, and Ducate.

H. Obviousness of Claims 3 and 12 over Koziol, Holland, and Milloy

Claim 3 depends from claim 2 and further requires a firebox that is configured to provide heat or smoke to the second cooking unit and is simultaneously operable with the cooking units and the side burner. Claim 12 resembles claim 3 but uses “means” language.

Because claim 3 depends from claim 2, it incorporates the limitations of claim 2, in particular the requirement for a side burner. Claim 12 similarly incorporates the side burner means limitation of claim 11. Petitioner’s unpatentability argument for claim 3 does not address whether or how Koziol, Holland, or Milloy discloses a side burner. *See* Pet. 26–29. Accordingly, we determine that Petitioner has not demonstrated a reasonable likelihood that claims 3 and 12 are unpatentable under 35 U.S.C. § 103(a) for obviousness over Koziol, Holland, and Milloy.

I. Obviousness of Claims 17–20 over Koziol, Holland, and Oliver

Independent claim 17 resembles claim 1 but specifies that the first and second cooking units each have a substantially cylindrical shape and are supported by the support structure.

Petitioner argues that it would have been obvious to fashion Koziol's cooking units with substantially cylindrical shapes in view of Oliver's disclosure that such a shape was used in multiple-mode grill assemblies. Pet. 29–33 (citing e.g., Ex. 1005, Fig. 20; Ex. 1010 ¶¶ 114–17, 120).

Upon consideration of the arguments and evidence presented in the Petition, we determine that Petitioner has demonstrated a reasonable likelihood that claim 17 is unpatentable under 35 U.S.C. § 103(a) for obviousness over Koziol, Holland, and Oliver. We have considered Petitioner's arguments and evidence directed to dependent claims 18–20 and are persuaded of a reasonable likelihood that these claims are unpatentable as well.

J. Obviousness of Claims 1, 4, 5, 7–9, 10, and 13–20 over Oliver and Holland; Obviousness of Claims 2, 6, and 11 over Oliver, Holland, and Ducate; Obviousness of Claims 3 and 12 over Oliver, Holland, and Milloy

We exercise our discretion not to institute a trial with respect to Petitioner's challenge to claims 1, 4, 5, 7–9, 10, and 13–20 for obviousness over Oliver and Holland, or the challenge to claims 2, 6, and 11 for obviousness over Oliver, Holland, and Ducate, because Petitioner has not persuaded us that those challenges are necessary in addition to the challenges of those claims based on Koziol in various combinations.

Regarding the challenge to claims 3 and 12 for obviousness over Oliver, Holland, and Milloy, Petitioner again fails to account for the limitations of intervening claims 2 and 11 in its obviousness analysis. *See* Pet. 45–46. Accordingly, we determine that Petitioner has not demonstrated a reasonable likelihood that claims 3 and 12 are unpatentable under 35 U.S.C. § 103(a) for obviousness over Oliver, Holland, and Milloy.

K. Obviousness of Claims 1, 2, 4, 5, 7–11, and 13–16 over BGE Manual I, Holland, and BGE Manual II

Petitioner argues that BGE Manual I describes a cooking center having a gas grill and a receptacle for a “Big Green Egg” charcoal grill and smoker, which is described in greater detail in BGE Manual II. Pet. 46–50. According to Petitioner, BGE Manual I and BGE Manual II disclose, or a person of ordinary skill would have understood from consideration of BGE Manual I and BGE Manual II, all limitations of claim 1 except the inclusion of an exhaust by the first cover. *Id.* at 46–52 (citing Ex. 1008 *passim*; Ex. 1009 *passim*, Ex. 1010 ¶¶ 208–210, 215, 217–219). According to Petitioner, it was well known that covered grills require vents and that it would have been obvious to add Holland’s cover exhausts to the gas grill cover in BGE Manual I in view of Holland’s teaching that it is common to provide grills with exhaust vents to eliminate smoke. *Id.* at 49–50. Petitioner makes analogous arguments concerning claim 10. Patent Owner directs no specific arguments to this challenge.

Upon consideration of the arguments and evidence presented in the Petition, we determine that Petitioner has demonstrated a reasonable likelihood that claims 1 and 10 are unpatentable under 35 U.S.C. § 103(a)

for obviousness over BGE Manual I, Holland, and BGE Manual II. We have considered Petitioner's arguments and evidence directed to dependent claims 2, 4, 5, 7–9, 11, and 13–16 and are persuaded of a reasonable likelihood that these claims are unpatentable as well.

L. Obviousness of Claims 3 and 12 over BGE Manual I, Holland, Milloy, and Beller

Petitioner argues that Milloy discloses adding a firebox to a barbecue grill and that Beller recommends separating the smoking and heating functions from one another due to the advantages of intense smoking at cooler temperatures. Pet. 56–57 (citing Ex. 1007, 1:33–36, 8:7–11; Ex. 1013, 1:45–49; Ex. 1010 ¶¶ 130, 229). Petitioner argues that it would have been obvious to modify BGE Manual I to have a separate firebox from the “Big Green Egg” charcoal grill in order to avoid the disadvantages of cooking and smoking in the Big Green Egg's single chamber. *Id.* at 57 (citing Ex. 1010 ¶ 230).

Upon consideration of the arguments and evidence presented in the Petition, we determine that Petitioner has demonstrated a reasonable likelihood that claims 3 and 12 are unpatentable under 35 U.S.C. § 103(a) for obviousness over BGE Manual I, Holland, Milloy, and Beller.

M. Obviousness of Claim 6 over BGE Manual I, Holland, BGE Manual II, and Ducate

Claim 6 further limits claim 1 to require that the support structure have at least two wheels. Petitioner argues that although BGE Manual I does not disclose clearly whether it has wheels, such a feature was well known, as evidenced by Ducate, and would have been obvious to add to

BGE Manual I. Pet. 57–58 (citing Ex. 1006, Figs. 1–3; Ex. 1010 ¶¶ 236–37).

Upon consideration of the arguments and evidence presented in the Petition, we determine that Petitioner has demonstrated a reasonable likelihood that claim 6 is unpatentable under 35 U.S.C. § 103(a) for obviousness over BGE Manual I, Holland, BGE Manual II, and Ducate.

N. Obviousness of Claims 17–20 over BGE Manual I, Holland, BGE Manual II, and Oliver

Petitioner argues it would have been obvious to provide the gas and charcoal grills of BGE Manual I and BGE Manual II with substantially cylindrical shapes as an obvious design choice in view of Oliver. Pet. 58–59 (citing Ex. 1005, Figs. 19–21, 23; Ex. 1010 ¶ 223).

Upon consideration of the arguments and evidence presented in the Petition, we determine that Petitioner has demonstrated a reasonable likelihood that claim 17 is unpatentable under 35 U.S.C. § 103(a) for obviousness over BGE Manual I, Holland, BGE Manual II, and Oliver. We have considered Petitioner’s arguments and evidence directed to dependent claims 18–20 and are persuaded of a reasonable likelihood that these claims are unpatentable as well.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has demonstrated that there is a reasonable likelihood of its proving unpatentability of claims 1–20 of the ’712 patent.

The Board has not made a final determination on the patentability of the challenged claims.

IV. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–20 of U.S. Patent No. 8,381,712 B1 on the following grounds of unpatentability:

- A. Obviousness of Claims 1, 4–10, and 13–16 over Koziol and Holland;
- B. Obviousness of Claims 2 and 11 over Koziol, Holland, and Ducate;
- C. Obviousness of Claims 17–20 over Koziol, Holland, and Oliver;
- D. Obviousness of Claims 1, 2, 4, 5, 7–11, and 13–16 over BGE Manual I, Holland, and BGE Manual II;
- E. Obviousness of Claims 3 and 12 over BGE Manual I, Holland, Milloy, and Beller;
- F. Obviousness of Claim 6 over BGE Manual I, Holland, BGE Manual II, and Ducate; and
- G. Obviousness of Claims 17–20 over BGE Manual I, Holland, BGE Manual II, and Oliver;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, the trial commencing on the entry date of this decision; and

FURTHER ORDERED that the trial is limited to the grounds identified above, and no other grounds are authorized.

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For PETITIONER:

Gary A. Clark
Bridgette A. Agness
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
gclark@sheppardmullin.com
bagness@sheppardmullin.com

For PATENT OWNER:

Lance D. Reich
MILLER NASH GRAHAM & DUNN LLP
patent@millernash.com