

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEIL ZIEGMAN, N.P.Z., INC.,
Petitioner,

v.

CARLIS G. STEPHENS,
Patent Owner.

Case IPR2015-01860
Patent 8,881,447 B2

Before MICHAEL W. KIM, CARL M. DEFRANCO, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background*

Neil Ziegmann, N.P.Z., Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 12–15 of U.S. Patent No. 8,881,447 B2 (Ex. 1001, “the ’447 patent”). Paper 1 (“Pet.”). Carlis G. Stephens (“Patent Owner”) filed a Preliminary Response (Paper 9; “Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314(a), which provides that 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.” Upon consideration of the Petition and Preliminary Response, we conclude that the Petition presents substantially the same art or arguments as those previously presented to the Office, and, thus, exercise our discretion under 35 U.S.C. § 325(d) to deny institution of an *inter partes* review as to claims 12–15.

B. *Related Proceedings*

Petitioner and Patent Owner identify the following district court proceedings concerning the ’447 patent: *Stephens v. Neil P. Ziegmann, NPZ, Inc., et al*, Civ. No. 4:15-cv-00954 (E.D. Mo.). Pet. 1; Paper 7, 2.

C. *The ’447 Patent*

The ’447 patent discloses the following in its “Field of the Invention” section:

The present invention relates generally to a trap and more specifically it relates to an animal trap for efficiently restraining animals, such as raccoons, in a secure manner using a diamond-shaped restraint and having an interchangeable and easy-setting

trigger which allows for a push-pull type or a pull-only type trigger and having an easy clean-out system for the trap.

Ex. 1001, 1:17–23. The '447 patent discloses that “current traps [] generally either have a push or a pull-type trigger thus either not efficiently providing a means to engage the trap, wherein the animal may possibly retrieve the bait without causing the trap to engage.” Ex. 1001, 1:30–34. Thus, according to the '447 patent, there is a need for an interchangeable and easy-setting trigger which allows for a push-pull type trigger. Ex. 1001, 1:41–48.

A version of Figure 3 of the '447 patent annotated by Petitioner is set forth below:

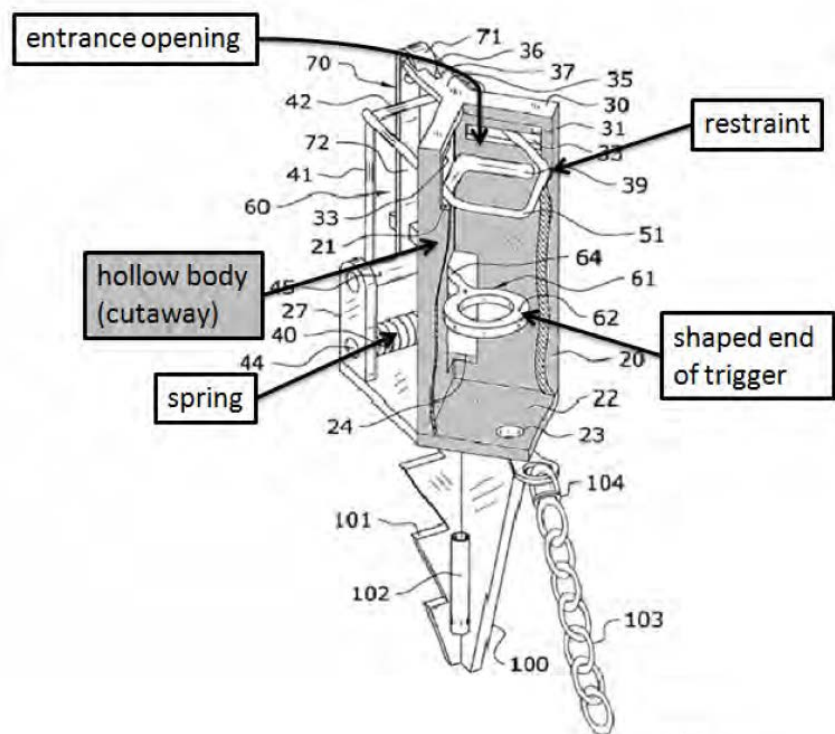


FIG. 3

Annotated Figure 3 discloses a front upper perspective view of a cutaway portion of hollow body 20 of animal trap 10. Ex. 1001, 2:36–37. When an animal places an extremity within hollow body 20 to retrieve bait placed

behind trigger member 61, 81, the animal pushes or pulls trigger member 61, 81, causing the animal's extremity to be retained by restraint member 50. Ex. 1001, 3:39–54, 7:46–57.

D. Illustrative Claim

Petitioner challenges claims 12–15 of the '447 patent. Independent claim 12 is illustrative of the challenged claims and is reproduced below:

12. An animal trap for humanely trapping animals and for preventing theft by an animal of bait placed in the trap to lure the animal to the trap, comprising:

a hollow body having an entrance opening;

a spring supported adjacent said body and a restraint member connected to said spring, said restraint member adapted to engage an extremity of the animal when the extremity is inserted into said body through said entrance opening to restrain the animal in the trap;

a trigger assembly restraining said restraint member in an armed position, said trigger assembly including a trigger member located intermediate said entrance opening and a location within the trap where bait is placed for the animal's extremity to contact said trigger member when attempting to reach the bait thereby releasing said restraint member from said armed position when either a first directional force or a second and substantially opposite directional force is applied to the trigger member of said trigger assembly; and,

wherein said trigger member has a shaped end encompassing a substantial cross-section portion of said hollow body whereby insertion of the animal's extremity into the hollow body to reach the bait causes contact of the extremity with the shaped end of the trigger member and results in capture of the animal while also preventing theft of the bait.

Id. at 10:5–31.

E. Asserted Grounds of Unpatentability

Petitioner challenges claims 12–15 on the following grounds.

Reference(s)	Basis	Challenged Claims
Ziegmann ¹ in view of Custard ²	§ 103(a)	12–15
Ziegmann in view of Custard and the Sullivan Circle Triggers Advertisement ³	§ 103(a)	12–15
Ziegmann in view of Danison ⁴	§ 103(a)	12, 14
Ziegmann in view of Danison and the Berkshire U-Forms Triggers Advertisement ⁵	§ 103(a)	12, 14
Ziegmann in view of Lindblad ⁶	§ 103(a)	12, 15
Ziegmann in view of Mast ⁷	§ 103(a)	12, 13, 15

¹ U.S. Patent No. 8,230,642 B2, issued July 31, 2012 (Ex. 1003).

² U.S. Patent No. 4,158,929, issued June 26, 1979 (Ex. 1007).

³ The Snare Shop, 2006–2007 Catalog, p. 26 (Ex. 1019).

⁴ U.S. Patent No. 4,601,128, issued July 22, 1986 (Ex. 1008).

⁵ The Snare Shop, 2006–2007 Catalog, p. 26 (Ex. 1021).

⁶ U.S. Patent No. 4,306,370, issued Dec. 22, 1981 (Ex. 1009).

⁷ U.S. Patent No. 600,156, issued Mar. 8, 1898 (Ex. 1010).

Reference(s)	Basis	Challenged Claims
Ziegmann in view of Mast and Edwards ⁸	§ 103(a)	12, 13, 15

II. ANALYSIS

Our discretion on whether to institute is guided by 35 U.S.C. § 325(d), which provides, in relevant part:

MULTIPLE PROCEEDINGS -- . . . In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.⁹

Patent Owner asks that we deny institution of trial on all grounds in the Petition, because all of the prior art cited in the Petition was either before the Examiner during prosecution, or does not present any new issues that were not addressed fully during prosecution. Prelim. Resp. 25–47. We, therefore, first examine whether the grounds asserted in the instant Petition present “the same or substantially the same prior art or arguments” as those previously presented to the Office. Then, we determine whether it is appropriate to exercise our discretion to deny institution.

⁸ U.S. Patent No. 465,056, issued Dec. 15, 1891 (Ex. 1022).

⁹ Although this provision appears in Chapter 32 of the Patent Act, which is directed to post-grant reviews, by its terms it is applicable also to proceedings under Chapter 31, which covers *inter partes* review proceedings.

A. Prosecution History of Claims 12–15 of the '447 Patent

The '447 patent issued from U.S. Patent Application No. 13/937,403 (the '403 application). Originally-filed claims 13–16 of the '403 application were prosecuted and renumbered at issuance as claims 12–15 of the '447 patent. For clarity and consistency, all references herein will be to claims 12–15 of the '447 patent, unless indicated otherwise.

Ziegmann was previously published as U.S. Patent Application Publication No. 2010/0275503 A1 (“Ziegmann '503”). Ex. 1003, [65]. Both Ziegmann and Ziegmann '503 were cited to the Examiner via an Information Disclosure Statement (“IDS”) filed July 22, 2013. Ex. 1002, 234. On March 27, 2014, the Examiner indicated that Ziegmann and Ziegmann '503 were considered by appending the following to the bottom of the IDS: “ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /J.B./” Ex. 1002, 182. Ziegmann and Ziegmann '503 are both listed under the References Cited section of the '447 patent, and each include an asterisk indicating that they were “* cited by examiner.” Ex. 1001, [56].

In an Office Action mailed June 4, 2014, claims 12–15 were rejected under 35 U.S.C. § 103(a) as unpatentable over McCulloch¹⁰ in view of Armstrong.¹¹ Ex. 1002, 68–69. In rejecting claims 12–15, the Office Action reads “McCulloch does not teach wherein said trigger member has a shaped end encompassing a substantial cross-sectional portion of said hollow body, said trigger member end has a generally circular shape or cross shape or

¹⁰ U.S. Patent Application Publication No. 2005/0274057 A1, published Dec. 15, 2005. Ex. 1026.

¹¹ U.S. Patent No. 872,041, issued Nov. 26, 1907. Ex. 1013.

square shape. Armstrong teaches a circular trigger (11).” Ex. 1002, 69. Independent claim 12 recites “wherein said trigger member has a shaped end encompassing a substantial cross-sectional portion of said hollow body,” (hereinafter “shaped-end trigger”). In the same Office Action, claim 1 was rejected under 35 U.S.C. § 103(a) as unpatentable over Ziegmann ’503 in view of Golden.¹² Ex. 1002, 67.

In response to the above Office Action, an Amendment was filed, in which evidence was submitted in support of an argument concerning secondary considerations, to overcome the rejection of claims 12–15 as obvious over McCulloch and Armstrong. Ex. 1002, 25–57. In response to that Amendment, a Notice of Allowability was mailed on September 30, 2014, in which the Office asserted the following:

The following is an examiner’s statement of reasons for allowance: Applicant has supplied written accounts from those highly skilled in the art for a period of time that dates back prior to the filing of the prior art stating that the invention as claimed has provided a long felt need which has been unsolved in the entire history of trapping substantially eliminating the huge problem of bait theft. The results of and success of the application as provided by applicant show that not only does the invention as claimed solve the problem but practically eliminated bait theft. Support is also given related to the increased sales and increased competitors using the design of applicant’s invention. Because of the level of success and the solution to a long felt, and unsolved need in the art as well as consideration by the highest level of those skilled in the art, the prior art would not have been used in combination to anticipate applicants invention.

Ex. 1002, 14.

¹² U.S. Patent No. 1,002,260.

B. Relevant Portions of Petition

Petitioner asserts that “[i]n essence, the Examiner concluded that McCollough ’057 [sic] disclosed all elements of claim 12 with the exception of a shaped trigger which was disclosed by Armstrong ’041.” Pet. 7; *see also* Pet. 51. Petitioner asserts further that “[t]o begin, Ziegmann ’642 discloses all of the elements of claim 12 as arranged in the claim with the exception of a trigger end which encompasses a substantial cross section portion of the interior of the trap housing.” Pet. 25; *see also* Pet. 39, 44, 46.

C. Same or Substantially the Same Prior Art or Arguments

Petitioner asserts that claims 12–15 are unpatentable as obvious over Ziegmann in view of several secondary references, where the secondary references are directed to the shaped-end trigger recited in independent claim 12. To that end, an analysis under 35 U.S.C. § 325(d) for this proceeding requires two determinations: (1) whether or not Ziegmann was presented to and considered previously by the Office in conjunction with claims 12–15; and (2) whether or not modifying the primary reference to include the shaped-end trigger was also presented to and considered previously by the Office.

Concerning Ziegmann, we determine that Ziegmann was substantively presented to and considered by the Office in conjunction with claims 12–15. The totality of facts in support of that determination are as follows. First, both Ziegmann and Ziegmann ’503 were cited in an IDS of the ’403 application, and the Examiner indicated that both Ziegmann and Ziegmann ’503 were presented and considered. Ex. 1001, [56]; Ex. 1002, 182, 234; Ex. 1003, [65]. Additionally, Ziegmann ’503 was cited expressly in a rejection of a claim of the ’403 application. Ex. 1002, 67. While the

rejection where Ziegmann '503 was cited was for a claim other than claims 12–15, claims 12–15 were rejected, albeit on another ground, in the same Office Action in which a claim was rejected as obvious over Ziegmann '503. Ex. 1002, 68–69. Specifically, claims 12–15 were rejected as obvious over McCulloch, where the Office indicated that McCulloch lacked the shaped-end trigger recited in claim 12. Ex. 1002, 69. In other words, for claims 12–15, McCulloch was used in the same manner by the Office as Petitioner uses Ziegmann in the instant proceeding. Pet. 7, 25. Accordingly, based on the totality of evidence, we find that Ziegmann itself, and certainly the substance of Ziegmann, was considered by the Office with regards to claims 12–15.

We determine also that it was previously presented to and considered by the Office as to whether it would have been obvious to modify a primary reference to include the shaped-end trigger recited in independent claim 12. As noted above, both the Office and the Petitioner agree that the only difference between the primary reference and claim 12 is the shaped-end trigger. Ex. 1002, 69; Pet. 25; *see also* Pet. 39, 44, 46. While the Office cited Armstrong and Petitioner cites other references to account for the aforementioned difference with the primary reference, we are persuaded that prior art and arguments substantially similar to those set forth by Petitioner were previously presented to and considered by the Office. Specifically, (1) the Office articulated expressly the differences between the primary reference and the claimed invention as being the shaped-end trigger and cited Armstrong for that difference (Ex. 1002, 69), (2) we find that all of the references cited by the Petitioner are directed to the shaped-end trigger, and (3) the Office acknowledged expressly that the evidence of secondary

considerations presented overcame the Office's previous analysis concerning modifying the primary reference to include the shaped-end trigger.

Petitioner asserts that "secondary considerations of non-obviousness simply cannot overcome a strong prima facie case of obviousness." Pet. 50–51 (*citing LKQ Corp. v. Clearlamp, LLC*, IPR2013-00020, Paper No. 73 at 26 (PTAB Mar. 27, 2014) (*quoting Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010) (alterations omitted))). Petitioner's assertions are misplaced, as the relevant question here is whether "the same or substantially the same prior art or arguments previously were presented to the Office," which is unrelated to the relative strength of evidence of secondary considerations in an obviousness analysis. To that end, we determine, for the reasons set forth *supra*, that arguments, concerning weighing evidence of secondary considerations relative to the Office's previous analysis regarding modifying the primary reference to include the shaped-end trigger, was previously presented to and considered by the Office.

Petitioner asserts further that "[f]or whatever reason, the Examiner failed to fully appreciate the relevant teachings in Ziegmann '642 during the original prosecution, including, *inter alia*, the disclosure of a two-way/push-pull trigger." Pet. 51. While we agree that it is unclear whether the Office considered Ziegmann '642 expressly in relation to the limitation that corresponds to the two-way/push-pull trigger, we find that the Office did consider expressly that limitation with respect to McCulloch. Ex. 1002, 69–70. Furthermore, Petitioner's assertions are misplaced, as the prosecution history indicates that the difference overcome by the evidence of secondary

considerations was the shaped-end trigger, and not the claimed two-way/push-pull trigger. Ex. 1002, 69.

Petitioner asserts additionally that there is an insufficient nexus between the evidence of secondary considerations and claims 12–15. Specifically, Petitioner asserts that the significant improvement of the '447 patent is the two-way/push-pull trigger, and that it is unclear whether the evidence of secondary considerations was directed more to the shaped-end trigger or the two-way/push-pull trigger. Petitioner's assertions are again misplaced, as the relevant question here is whether "the same or substantially the same prior art or arguments previously were presented to the Office," which is unrelated to the relative strength of evidence of secondary considerations in an obviousness analysis. To that end, we determine that arguments concerning weighing evidence of secondary considerations relative to the Office's previous analysis regarding modifying the primary reference to include the shaped-end trigger were previously presented to and considered by the Office.

D. Discretion to Deny Institution of Trial

Having found that the instant Petition raises the same or substantially the same prior art and arguments as those previously presented to the Office, § 325(d) states that we may take these facts into consideration when determining whether to institute trial. The question, therefore, is whether we should exercise our discretion to deny the Petition, after weighing the particular circumstances of this proceeding, the interests of the parties, and the needs of the Board.

While petitioners may have sound reasons for raising art or arguments similar to those previously considered by the Office, the Board weighs

petitioners' desires to be heard against the interests of patent owners, who seek to avoid harassment and enjoy quiet title to their rights. *See* H.R. Rep. No. 112-98, pt.1, at 48 (2011) (AIA proceedings "are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation.").

We acknowledge that there are several factors weighing in Petitioner's favor and against denying the instant Petition under § 325(d). Foremost among them include that the '447 patent has not previously been before the Board, and Petitioner has not challenged previously the '447 patent in a proceeding before the Office. Nevertheless, we determine that these factors are outweighed by the following countervailing factors. The same primary reference asserted by the Petitioner was previously presented to, and considered by, the Office in the same substantive manner as advocated for by Petitioner. Petitioner identifies the same difference between the primary reference and claims 12–15 as identified expressly and unambiguously by the Office, and, thus, asks the Board to, essentially, second-guess the Office's previous decision on substantially the same issue. And in requesting that second-guess, Petitioner asks the Board to reconsider evidence of secondary considerations that, again, the Office expressly determined was sufficient to overcome the expressly and unambiguously identified difference between the primary reference and claims 12–15. Indeed, given the relative clarity of the already-considered difference in scope between the primary reference and claims 12–15, we need not resort to undue speculation to conclude that the proceeding will devolve into a

resource-consuming dispute concerning evidence with regards to secondary considerations, again, on an issue already and unambiguously presented previously to and considered by the Office. Under these facts, we are unpersuaded that adjudicating such a dispute on an already-considered issue is an efficient use of Board resources.

E. Conclusion

For the foregoing reasons, we conclude that the instant Petition raises the same or substantially the same prior art or arguments as those previously presented to the Office concerning claims 12–15 of the '447 patent. Furthermore, we conclude that the circumstances of this case justify exercising our discretion not to institute trial.

III. ORDER

It is ORDERED that the Petition is *denied*, and no trial is instituted.

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