

Nos. 2022-1373, 2022-1374

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

YITA LLC,
Appellant

v.

MACNEIL IP LLC,
Appellee

Appeals from the United States Patent and Trademark Office, Patent Trial and
Appeal Board in Nos. IPR2020-01139, IPR2020-01142

**APPELLEE MACNEIL IP LLC'S CORRECTED COMBINED PETITION
FOR PANEL REHEARING AND REHEARING EN BANC**

John D. Denkenberger
Brian F. McMahon
John E. Whitaker
CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}
1201 Third Avenue, Suite 3600
Seattle, WA 98101
Tel: 206.682.8100
Fax: 206.224.0779
john.denkenberger@cojk.com,
brian.mcmahon@cojk.com,
john.whitaker@cojk.com,
litdoc@cojk.com

July 7, 2023

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2022-1373; 2022-1374

Short Case Caption Yita LLC v. MacNeil IP LLC

Filing Party/Entity MacNeil IP LLC

Instructions:

1. Complete each section of the form and select none or N/A if appropriate.
2. Please enter only one item per box; attach additional pages as needed, and check the box to indicate such pages are attached.
3. In answering Sections 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance.
4. Please do not duplicate entries within Section 5.
5. Counsel must file an amended Certificate of Interest within seven days after any information on this form changes. Fed. Cir. R. 47.4(c).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 07/07/2023

Signature: /s/John D. Denkenberger

Name: John D. Denkenberger

FORM 9. Certificate of Interest

Form 9 (p. 2)
March 2023

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>
<p>MacNeil IP, LLC</p>	<p>MacNeil Automotive Products L.L.C. (formerly known as MacNeil Automotive Products, Limited)</p>	
	<p>WeatherTech Direct, LLC</p>	

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable Additional pages attached

Michele C. Bosch, David C. Reese, & Nicholas A. Cerulli Finnegan, Henderson, Farabow, Garrett & Dunner LLP	Jefferson Perkins Perkins IP Law Group LLC	

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

Yes (file separate notice; see below) No N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable Additional pages attached

TABLE OF CONTENTS

CERTIFICATE OF INTEREST	i
TABLE OF CONTENTS.....	iv
TABLE OF AUTHORITIES	v
STATEMENT OF COUNSEL	1
POINTS OF FACT OR LAW OVERLOOKED OR MISAPPREHENDED BY THE COURT	2
INTRODUCTION	3
BACKGROUND	6
I. Statement of the Case	6
II. The '186 Patent.....	6
III. The PTAB's FWD and the Evidence Before It.....	16
IV. The Panel's Decision.....	20
V. The Panel's Treatment of the '834 Decision.....	20
ARGUMENT	21
I. The Panel Misreads the PTAB's Findings Regarding MacNeil's Evidence of Secondary Considerations.....	21
II. The Panel's Decision is Premised on a Mistaken Application of This Court's Jurisprudence	24
CONCLUSION.....	27
CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS...	29
ADDENDUM	30

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Samsung Elecs Co.</i> , 839 F.3d 1034 (Fed. Cir. 2016) (en banc)	26
<i>Demaco Corp. v. F. Von Langsdorff Licensing Ltd.</i> , 851 F.2d 1387 (Fed. Cir. 1988)	1, 2
<i>Ethicon Endo-Surgery, Inc. v. Covidien LP</i> , 812 F.3d 1023 (Fed. Cir. 2016)	25
<i>K/S Himpp v. Hear-Wear Techs., LLC</i> , 751 F.3d 1362 (Fed. Cir. 2014)	26
<i>Medtronic, Inc. v. Teleflex Innovations S.a.r.l.</i> , 70 F.4th 1331 (Fed. Cir. 2023)	passim
<i>Ormco Corp. v Align Tech., Inc.</i> , 463 F.3d 1299 (Fed. Cir. 2006).....	25
<i>Rambus Inc. v. Rea</i> , 731 F.3d 1248 (Fed. Cir. 2013)	3, 6, 25, 27
<i>Teva Pharms. Int. 'l GmbH v. Eli Lilly & Co.</i> , 8 F.4th 1349 (Fed. Cir. 2021).....	24
<i>WBIP LLC v. Kohler Co.</i> , 829 F.3d 1317 (Fed. Circ. 2016)	4, 17, 25, 26

STATEMENT OF COUNSEL

Based on my professional judgment, I believe the Panel decision is contrary to the following precedents of this Court: *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387 (Fed. Cir. 1988) and its progeny, including *Medtronic, Inc. v. Teleflex Innovations S.a.r.l.*, 70 F.4th 1331 (Fed. Cir. 2023).

Based on my professional judgment, I also believe this appeal requires an answer to the following precedent-setting question of exceptional importance:

In a review of an IPR Final Written Decision (“FWD”), is it legal error for a Panel of the Court of Appeals in a precedential decision to substitute its own factual findings for those of the Patent Trial and Appeal Board (“PTAB”)—without remand—to overturn the PTAB’s holding of non-obviousness when substantial evidence supported the PTAB’s finding that patent owner’s objective evidence was tied to the “claim as a whole” rather than exclusively to a single known claim element?

/s/John D. Denkenberger
JOHN D. DENKENBERGER

**POINTS OF FACT OR LAW OVERLOOKED OR MISAPPREHENDED BY
THE COURT**

The Panel misapprehended *Demaco* and its progeny to negate Yita's failure to rebut the presumption of nexus that Patent Owner-Appellee MacNeil IP LLC's ("MacNeil") objective evidence was tied to the claim as a whole.

The Panel misapprehended the PTAB's FWD in two critical respects: First, the Panel misread the PTAB's findings to erroneously attribute secondary considerations exclusively to a single claimed feature rather than to the claim as a whole. Second, even if the PTAB's FWD rested on an error of law, substantial evidence nevertheless supported the PTAB's conclusion that secondary considerations were attributable to the claim as a whole.

INTRODUCTION

The Panel decision conflicts with this Court’s opinion issued one day prior in *Medtronic* (Fed. Cir. June 5, 2023) and should be reheard. Left undisturbed, the Panel’s decision would cause confusion amongst lower courts, the PTAB and practitioners on critical issues, such as the proper standard and scope of appellate review, the deference due to the PTAB’s factual findings and reasoning, and the use of the PTAB’s analysis, in a separate proceeding, of a different patent. The Panel’s reversal of the PTAB’s finding of non-obviousness – rather than remanding – is contrary to this Court’s precedent in *Rambus Inc. v. Rea*, 731 F.3d 1248 (Fed. Cir. 2013). The matter should be reheard.

This case involves MacNeil’s WeatherTech® vehicle floor tray and U.S. Patent No. 8,382,186 (“the ’186 Patent”) regarding the same. When the vehicle floor tray was introduced into the market, the industry described it as “revolutionary.” (Appx9903). The Board agreed that MacNeil’s objective evidence was “incredible” (Appx75), “strongly persuasive” (Appx77), and “compelling” (Appx81).

Like *Medtronic*, the PTAB found that each element of Claim 1 of the ’186 Patent was found in Petitioner’s three prior art references, and thus a *prima facie* case was made. Importantly, however, Claim 1, including the claim elements 1[c] and [e] containing close conformance, required a combination of all three prior art references. (Appx6-51).

The PTAB found:

After weighing all the evidence submitted by the parties in light of the *Graham* factors, we determine Petitioner has not demonstrated by a preponderance of the evidence that any of the challenged claims would have been obvious.... ***Patent Owner's evidence of secondary considerations is compelling*** and indicative of non-obviousness. We, therefore, ***accord substantial weight to it*** in our analysis of the *Graham* factors.

(Appx81¹). The PTAB rejected Petitioner's argument that "close conformance" was well-known in the prior art. (Appx74-75). Citing *WBIP LLC v. Kohler Co.*, 829 F.3d 1317, 1330 (Fed. Circ. 2016), the PTAB ***expressly stated*** that it was examining the "claimed combination [of the floor tray] as a whole" in considering the objective evidence and that the PTAB's analysis ***was not*** dependent upon any one claim element of the '186 Patent/floor tray. This is the situation addressed by the Court in *Medtronic*, which affirmed the PTAB's finding of non-obviousness.

Here, the Panel reversed the PTAB because it misapprehended the PTAB's analysis and the record by misstating that the secondary-considerations evidence related exclusively to the claim element "close conformance" and by using the PTAB's analysis of a different patent from a different proceeding to analyze the PTAB's reasoning as to the '186 Patent. That is error. For the '186 Patent, the

¹ All emphasis added unless otherwise indicated.

PTAB expressly stated their analysis related to the claimed floor tray’s “combination as a whole,” and the Panel substituted the PTAB’s fact-finding with its own.

The PTAB found that close conformance is a *necessary* part of the combination, but it did not cite it as the *exclusive* reason for MacNeil’s secondary-considerations evidence.

In both its *prima facie* and objective evidence arguments, Yita stated that close conformance was well-known and thus the invention would have been obvious. But MacNeil presented secondary-considerations evidence that was “incredible” and “compelling.” Thus, if Yita’s argument was accepted, *it must have been something else* in the claimed floor tray that allowed MacNeil to achieve the phenomenal success it did. Indeed it was—and the PTAB found as much. Several claim elements were crucial to its success, and *the combination of all these elements into its floor tray product* was the foundation of its objective evidence considered and credited by the Board. The PTAB’s FWD should be affirmed as to the ’186 Patent.

However, especially in light of *Medtronic*, if the Panel believes it made no error in reading the PTAB’s FWD, then this Court’s jurisprudence evaluating the import of objective indicia requires clarification. Without clarification, the Panel’s precedential decision to reverse without remand will lead to continued irreconcilable results. At minimum, to be consistent with this Court’s reasoning and holding in

Rambus, this matter should be remanded to the PTAB for further fact-finding proceedings consistent with the direction of the Court.

BACKGROUND

I. STATEMENT OF THE CASE

This appeal arises out of two IPR proceedings challenging all claims of two related patents, the '186 Patent and U.S. Patent No. 8,833,834 (“the '834 Patent”) (IPR2020-01139 and 2020-01142, respectively). *See* Dkt. 21, at 3. The claims at issue are commercially embodied by the now ubiquitous WeatherTech® floor tray. *See id.* This Petition seeks rehearing on issues arising from the Panel’s decision regarding IPR2020-01139, relating to the '186 Patent.

II. THE '186 PATENT

The Panel described the invention of the '186 Patent in relevant part:

The subject addressed is a “vehicle floor tray... ***thermoformed from a polymer sheet of substantially uniform thickness.***” The specification explains that traditional vehicle “[floor mats can be] *pushed up* so as to occlude the gas, brake, or clutch pedals”; or “*bunched up or folded over....*”

(Slip Op. at 2 (citations omitted)). However, the Panel overlooked other disclosures concerning the importance of other claimed elements of the tray in the '186 Patent that stated as follows:

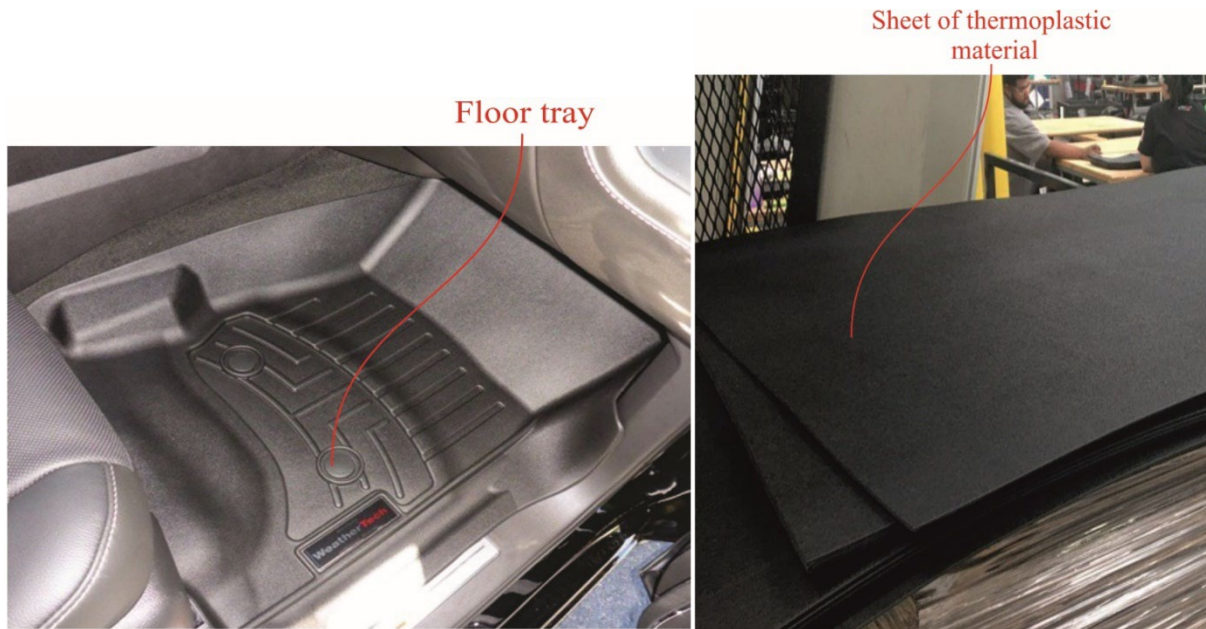
Some vehicle floor mats that are now on the market have fluid reservoirs built into them... But including such a reservoir within a floor tray that otherwise has an

acceptable fit to the surface of a vehicle foot well *has not yet been done*, since there are problems in incorporating a three-dimensional liquid-holding vessel into a product that ideally conforms, on its lower surface, to the surface of the footwell.... Multiple treads/baffles are disposed in the reservoir.... The treads/baffles are adapted to elevate the foot or shoe...[and] are adapted to impede lateral movement of the collected fluid within the reservoir....

(Appx360, col. 2, lines 9-10, 20-25; col. 5, lines 18-20, 23-27).

Mr. Ryan Granger provided detailed claim charts and annotated photographs of MacNeil's floor tray regarding each element of Claim 1, *which the PTAB expressly relied upon*, as follows:²

Limiting Preamble and all Claim Elements (Appx10357-8):



² These individual claim elements are set forth in the same manner and enumeration as analyzed by the PTAB. (Appx6-7).

Claim elements 1[a-b] (Appx10359):

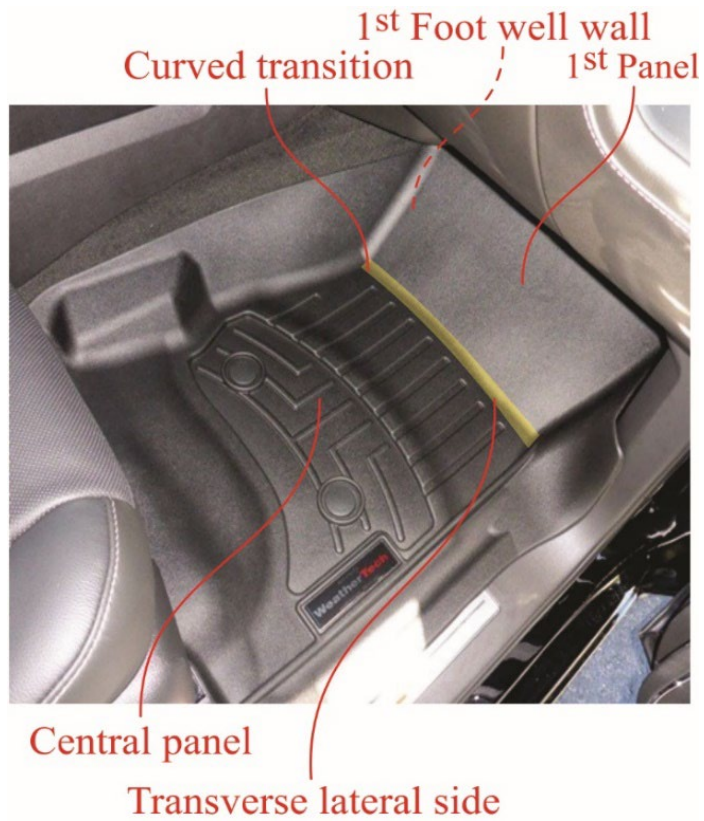
Longitudinal lateral side Transverse lateral side



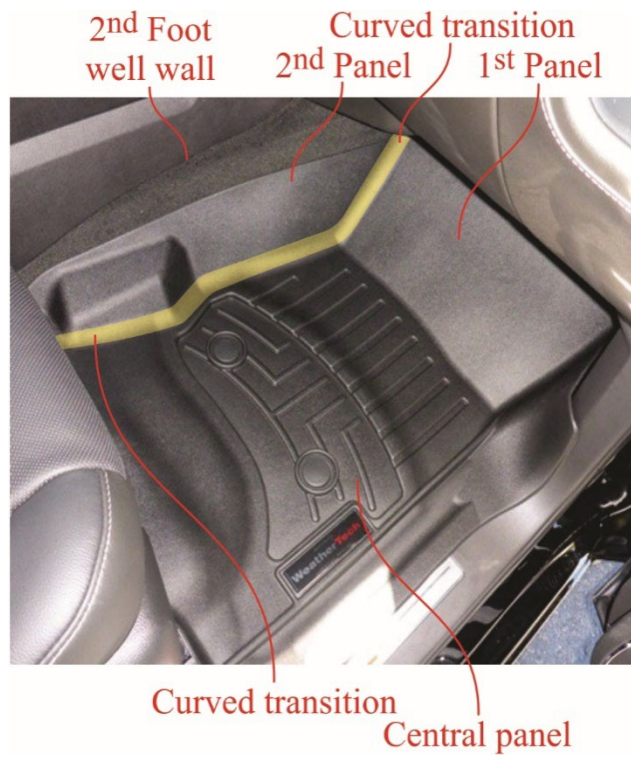
Central panel

Foot well floor

Claim elements 1[c-d] (Appx10360):

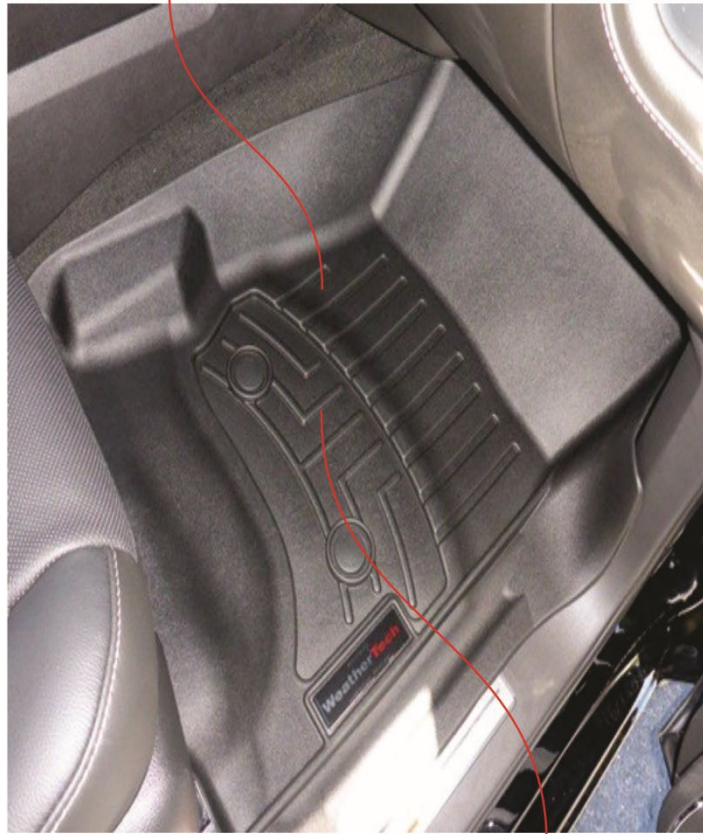


Claim elements 1[e-f] (Appx10361):



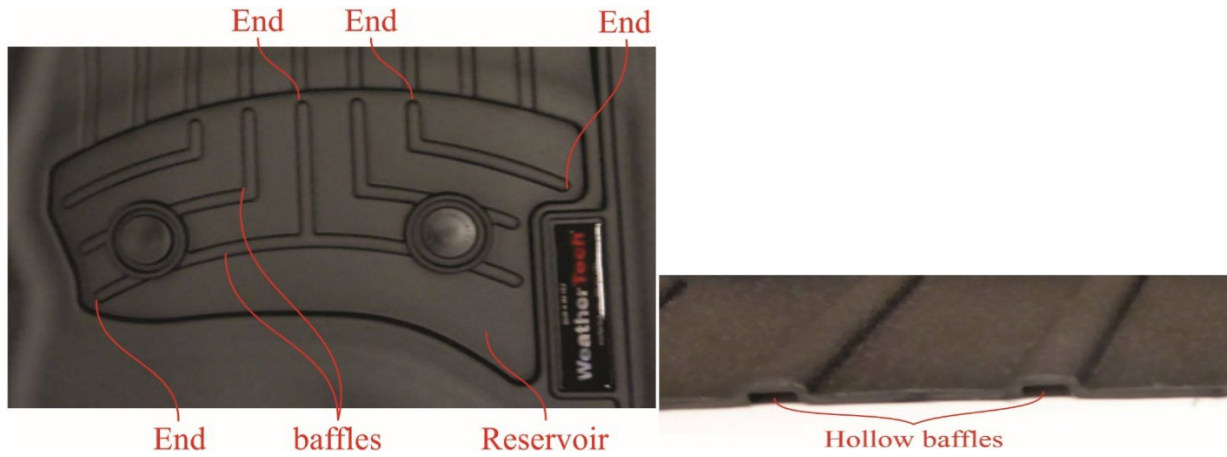
Claim element 1[g] (Appx10362):

Central panel

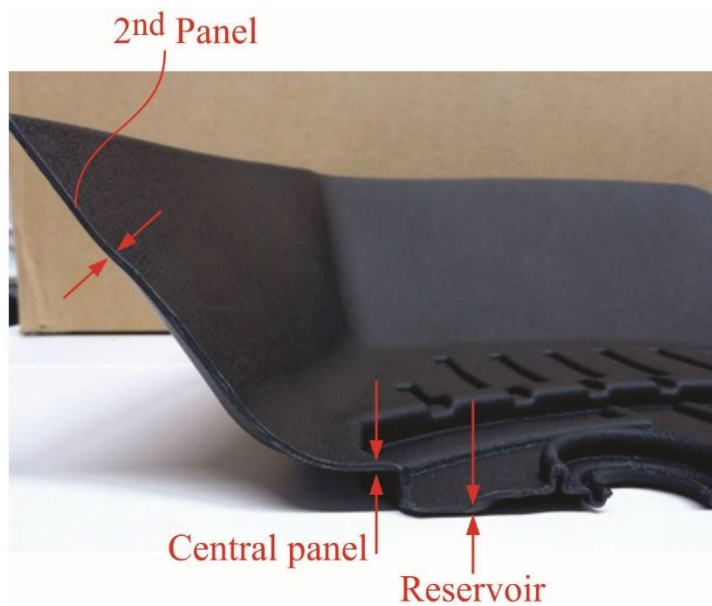


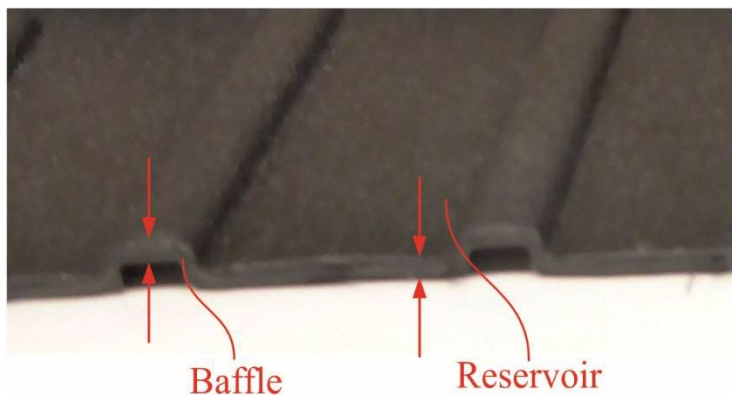
Reservoir

Claim elements 1[h-i] (Appx10363):

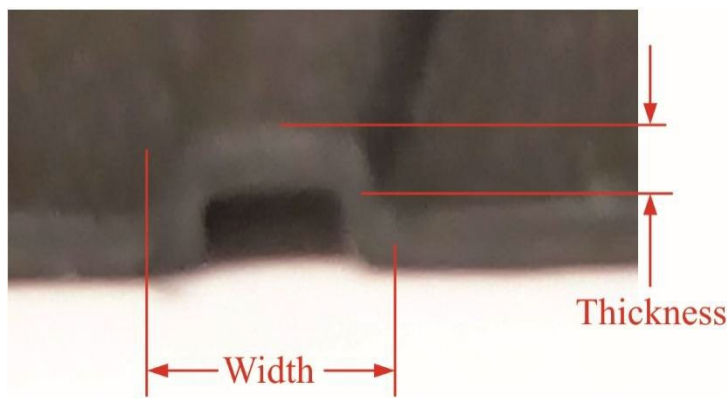


Claim element 1[j] (Appx10364-5):

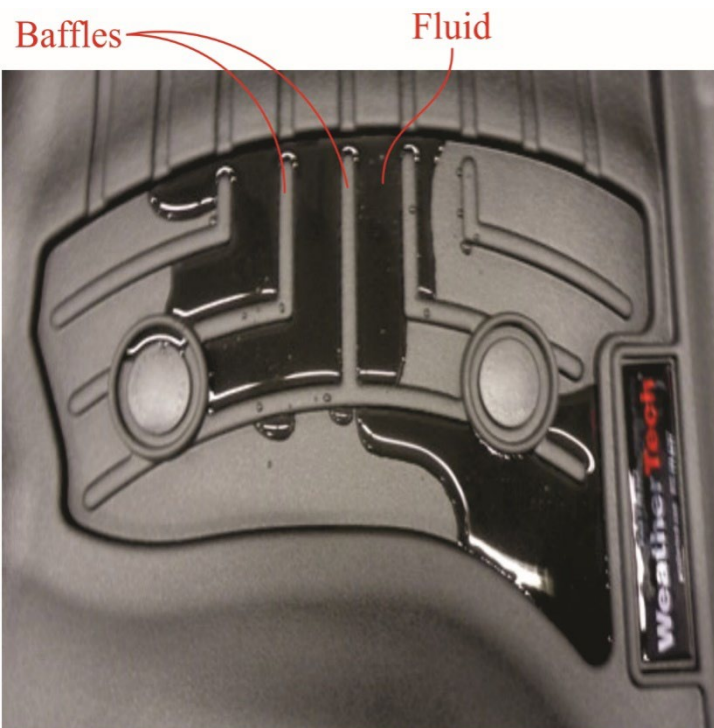


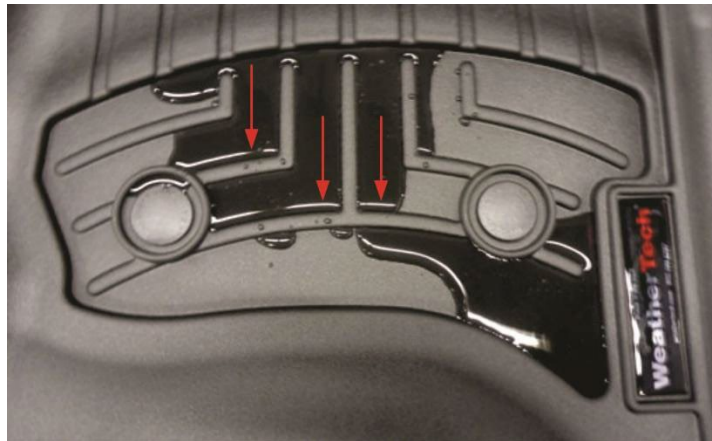
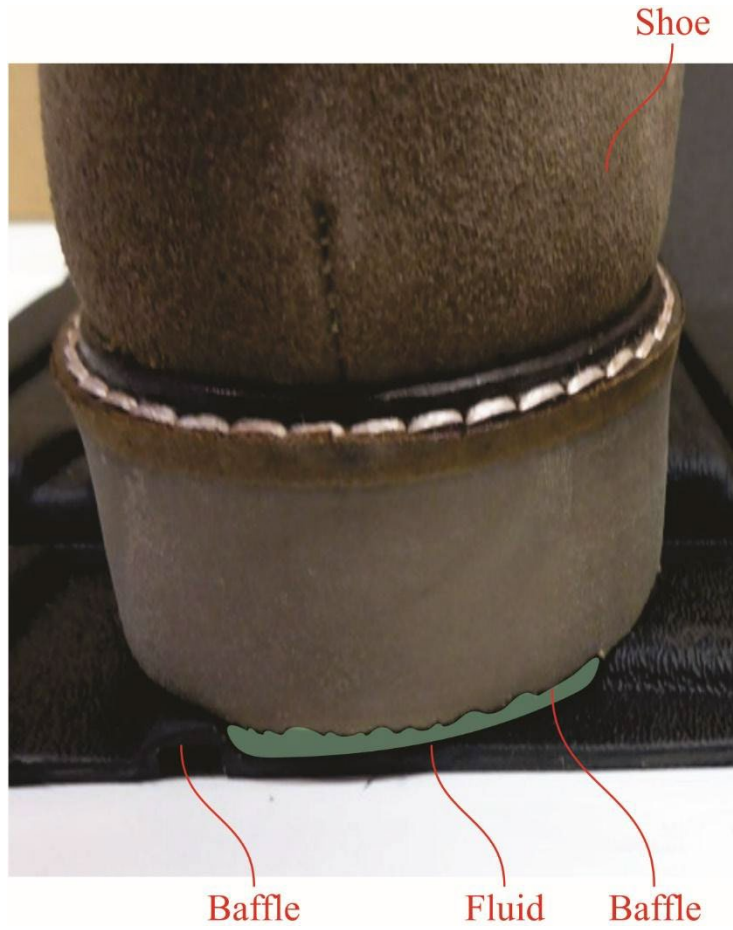


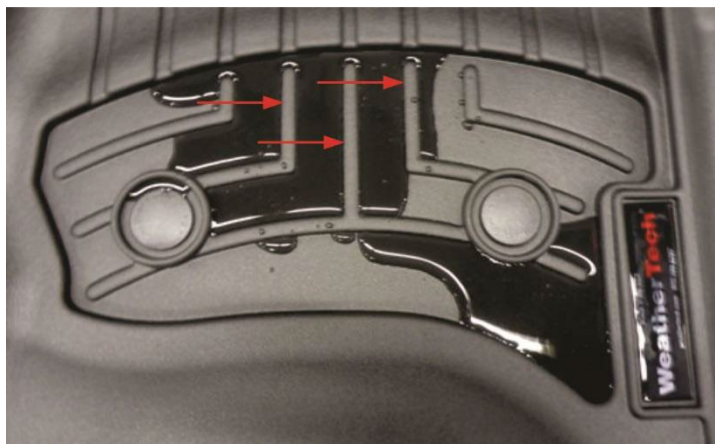
Claim element 1[k] (Appx10366):



Claim element 1[I] (Appx10367-70):







Claim element 1[m] (Appx10371):



III. THE PTAB'S FWD AND THE EVIDENCE BEFORE IT

In reaching its conclusion regarding non-obviousness, the PTAB's FWD assessed each of the *Graham* factors. (Appx1-86). The PTAB stated that it had considered *all of the evidence* presented. (*Id.* at 81).

The PTAB also evaluated the parties' respective arguments and the teachings of "Rabbe" (French Patent Publication 2,547,252 (1984) (Appx1727-1731)). (Appx39). The PTAB concluded that Rabbe taught the close conformance limitations of elements 1[c] and [e]. (Appx39-40, 44). However, the PTAB rejected Yita's argument that the close conformance limitation was "well-known." Further, the PTAB found that MacNeil had "establishe[d] that WeatherTech's *vehicle trays embody the claimed invention and are coextensive with the claims.*" (Appx73-74).

The PTAB found that Yita had introduced *no evidence* to rebut MacNeil's assertion of nexus. (Appx77). Again citing *WBIP*, the PTAB afforded MacNeil the presumption of nexus, finding unpersuasive Yita's *unsupported contention* that secondary considerations were attributable *solely* to the close-conformance limitations. (*Id.*). Instead, the PTAB stated that it must evaluate the claim "*as a whole*" when evaluating objective indicia, and that is what it did. (Appx99).

And the PTAB had before it substantial evidence that MacNeil's secondary-considerations evidence was attributable to the claimed floor tray, *as a whole*. The PTAB did find that "close conformance" was taught by Rabbe, but it did not conclude that Rabbe taught close conformance of a sheet-thermoformed floor tray (*i.e.*, a vehicle floor tray with all the features as claimed in the '186 Patent).

The following excerpts are examples of evidence before the PTAB supporting its conclusion that MacNeil's secondary-consideration evidence was tied to the

“claim as a whole,” and not exclusively to the "close conformance" limitations of Claim 1[c] and [e]³:

Independent Industry Reviews/Articles:

- The tray has “a lower reservoir to minimize fluid movement while driving. Once the fluid is away from your shoes and clothing, it can be easily be removed...” (**baffles/reservoir**) “WeatherTech liners [are] durable and rigid in strength [] and keep from curling and cracking...” (**sheet-thermoforming**) (Appx9893).
- [W]e were pleasantly surprised by the hardy construction... (**sheet-thermoforming**) (Appx9895).
- The tray “allows for a rigid core for strength” (**sheet-thermoforming**) and the “lower reservoir uses additional channeling to minimize fluid movement while driving.” (**reservoir, baffles**) (Appx9900).
- Prior art floor mats “curled at the corners and ended up under the pedals in a mess.” (**sheet-thermoforming**) (Appx9903).
- “The remarkable fit and tough (but pliable and comfortable) material...” (**sheet-thermoforming**) “All that mud and moisture has to go somewhere, so DigitalFit FloorLiners use...a lower reservoir that keeps it away from your shoes and clothing.” (**reservoir, baffles**) (Appx9911).

Mr. Sherman’s Report:

- “When I was first able to review MacNeil’s floor trays after they were introduced to the market, the product was like nothing I had seen before in the industry. MacNeil’s floor trays were structurally sound, durable and fit...” (**sheet-thermoforming**); “in the early 2000s, there remained a need for a custom-fit floor tray that presented a solid, steady surface to the user’s feet” (**sheet-thermoforming**); “Industry participants have

³ Other claim elements identified in bold and parenthesis.

praised WeatherTech's® floor trays for features described [in the '186 Patent] including for conformance to the vehicle interior, for the baffle/reservoir arrangement, and for the panel arrangement." (**reservoir/baffles**); "In my opinion, this praise stemmed from the combination of the claimed features—close conformance, an effective panel arrangement, and integration of the baffles and reservoir—in a single tray product..." (**baffles/reservoir/sheet-thermoforming**) (Appx9171, 9215, 9219-20).

Mr. Granger's Testimony:

- "Q. And in your mind, what is the main thing that sets the MacNeil products apart from the competition? A. I don't have one main thing.... [W]hen a product is successful in a marketplace, it's not one thing.... *So it's a combination* of a lot of different attributes that have led to the success of the MacNeil automotive form." (**sheet-thermoforming**) (Appx4583).

The PTAB had before it all this evidence and for each consideration (Commercial Success, Long-Felt Need, and Industry Praise) found that this evidence was the result of "the close conforming vehicle floor tray which is coextensive with the claims." (Appx77-79). Accordingly, substantial evidence supports the PTAB's finding that the secondary considerations are directed to the claim as a whole and not merely to the "closely conforming" limitation.

IV. THE PANEL'S DECISION

The Panel reversed the PTAB's determination that Yita failed to demonstrate that the challenged claims were obvious. In doing so, the Panel relied on two inaccurate observations.

First, the Panel noted that "the Board found that 'Rabbe discloses the close conformance limitation in claim 1' of the '186 patent," but it failed to recognize that the quoted passage exclusively focused on the close-conformance limitation of claim 1[c]. (*Compare* Slip Op. at 7 (citing Appx39-40) *with* Appx28-42 (discussion of claim 1[c]).)

Second, the Panel summarized the PTAB's findings regarding secondary considerations, but in quoting the PTAB, the Panel truncated essential language from the quoted passages: "the evidence of [each consideration was] due to the closely conforming vehicle floor tray...". (Slip Op. at 9 (quoting Appx77-79, but truncating "*which is coextensive with the claims*").)

V. THE PANEL'S TREATMENT OF THE '834 DECISION

The Panel relied more on the PTAB's '834 Decision to analyze the '186 Patent than it did on the '186 Decision. But the Panel misapprehended crucial differences between the two decisions. First, the PTAB found that MacNeil had not even introduced co-extensiveness claim charts with regard to the '834 Patent claims in question, which lacked a close conformance limitation. (Appx135). Regardless, the

PTAB independently reviewed the objective evidence. Second, the PTAB's discussion expressly recognized that certain objective evidence *related to other claim elements* but found that, absent the combination of the close conformance limitation (which was a significant focus of the evidence), the evidence lacked a nexus to the objective indicia.

The Panel, twice, cited statements by the PTAB that the evidence “‘relate[d] entirely’ to the close-conformance limitation disclosed in the prior art.” and “‘relate[d] specifically to the ‘close conformance’ [feature].” (Slip Op. at 14; *Id.* n.4). This misstates the Board's findings. As to the first quote, it is: “relates entirely to the closely-conforming floor tray, a feature not recited in claims 13-15.” (Appx137, emphasis changed). As to the second, the quote is: “relates specifically to the ‘close conformance of WeatherTech's® trays...” (Appx139).

ARGUMENT

I. THE PANEL MISREADS THE PTAB'S FINDINGS REGARDING MACNEIL'S EVIDENCE OF SECONDARY CONSIDERATIONS

One day prior to the Panel's decision, the Court issued its Opinion in *Medtronic, Inc. v. Teleflex Innovations S.a.r.l.*, 2023 WL 3806380 (Fed. Cir. June 5, 2023), which is on all fours with the facts of this case. In *Medtronic*, for the “Side-Opening Claims,” the PTAB found that each claim element was individually known in the prior art, “but correctly concluded this did not preclude nexus where the evidence was ‘tied to the combination of the features as a whole’ and the

combination was not previously known.” (*Id.* at *4). The PTAB found that although Medtronic had proved a close *prima facie* case, the “strong” objective evidence overcame Medtronic’s evidence. (*Id.* at *10).

Appellant-Medtronic also argued that the PTAB erred by considering a claim element “rare” in the prior art. (*Id.* at *11). The Court disagreed and noted that “Medtronic’s petition contended that side openings were ‘well known’ in the prior art...” The Court found: “The Board did not err in taking this testimony into account when assessing the strength of Medtronic’s evidence. Testimony that a prior art feature was rare is plainly relevant to whether it was in fact well known...” (*Id.*).

Finally, discussing the proper standard of review, the Court stated:

[W]e have also repeatedly explained “the Board is not require[d] ... to address every argument raised by a party or explain every possible reason supporting its conclusion.... The central inquiry is whether we can ‘reasonably discern that [the Board] followed a proper path, even if that path is less than perfectly clear.”

(*Id.* at *10 (citations omitted)). The Court found that the PTAB’s path was discernible and had, as is the case here, properly examined the *prima facie* arguments and evidence, and that following that examination: “[t]he Board went on to expressly identify the prevailing argument driving its decision, namely the strong objective evidence of nonobviousness....” (*Id.*).

The reasoning in *Medtronic* applies equally here, and it underscores the Panel’s errors. Specifically, it misconstrued the PTAB’s FWD to erroneously

conclude that the PTAB attributed secondary-considerations evidence exclusively to a single claimed feature known in the prior art. The record establishes otherwise—the PTAB consistently and explicitly related the secondary considerations to the claimed floor tray *as a whole*. The Panel noted that the PTAB “found that ‘Rabbe discloses the close conformance limitation in claim 1.’” (Slip Op. at 7 (citing Appx39-40)). But the Panel incorrectly construed this to mean that the PTAB “found that MacNeil’s secondary-consideration evidence ‘relate[d] entirely’ to the close-conformance limitation disclosed in the prior art.” (Slip. Op. at 14 (citing Appx137)).

The PTAB made no such finding. The close-conformance teachings of Rabbe, under the most generous interpretation, do not amount to the claimed combination of the “close conforming vehicle *floor tray*.” (Appx77-79). Further, the Panel’s conclusion overlooks critical language from the FWD: “we find the evidence of [secondary considerations] is due to the close conforming vehicle floor *tray which is coextensive with the claims*.” (*Id.*). The Panel’s error is stark when realizing that the opinion omits the bolded language above from every relevant citation. (*E.g.*, Slip Op. at 9).

This error leads to the Panel’s mistaken presumption that the PTAB committed legal errors. (*Id.* at 12). The PTAB did not find MacNeil’s secondary-considerations evidence persuasive “presumably because...close conformance was

not “*well-known*” as the Panel concluded. (*Id.* at 9).⁴ Rather, the PTAB found the evidence persuasive because MacNeil established nexus (Appx72-75), Yita failed to rebut the presumption (*id.*), and the evidence was not limited to the close-conformance limitation of the prior art but rather discussed the attributes of the entire invention—“a closely conforming vehicle floor tray.”

Because the record establishes that the PTAB made no legal error, and the PTAB’s findings are supported by substantial evidence, MacNeil respectfully requests reconsideration to affirm the PTAB’s FWD. (*Supra* at 16-19).

II. THE PANEL’S DECISION IS PREMISED ON A MISTAKEN APPLICATION OF THIS COURT’S JURISPRUDENCE

If the Court concludes that the Panel’s reading of the FWD was proper, then the precedential nature of the Panel decision necessarily requires clarification of this Court’s law regarding the presumption of nexus. Prior to the Panel’s opinion, this Court had consistently held that, “a patentee is entitled to a rebuttable presumption of nexus between the asserted evidence of secondary considerations and a patent claim if the patentee shows that the asserted evidence is tied to a specific product and that the product ‘is the invention disclosed and claimed.’” *E.g., Teva Pharms. Int.’l GmbH v. Eli Lilly & Co.*, 8 F.4th 1349, 1360 (Fed. Cir. 2021) (citations omitted).

⁴ Although as *Medtronic* makes clear, it was entirely proper for the PTAB to consider this point in weighing the *Graham* factors.

This Court has also consistently held that the presumption may be rebutted if the patent challenger *proves* that the secondary considerations relate exclusively to a “feature...known in the prior art.” *Ormco Corp. v Align Tech., Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006)⁵. Here, Yita introduced no evidence. *See also WBIP*, 829 F.3d at 1329 (“a patent challenger cannot successfully rebut the presumption with argument alone—it must present evidence”). Further, this Court had consistently held that “the fact that an isolated feature may be present in the prior art may not render irrelevant objective evidence of non-obviousness of that feature in [a] claimed combination.” (*Id.* at 1330-31 (summarizing *Rambus*)).

The Panel’s precedential decision here, if left undisturbed, will serve only to confuse the Court’s presumption-of-nexus jurisprudence that was sufficiently clear just one day prior to the Panel’s opinion. *See Medtronic*. In relevant part, the *Medtronic* Panel noted that the presumption of nexus applied because the ““objective evidence is tied to a specific product...and that product is the invention disclosed and claimed.”” (*Id.* at *4 (citations omitted)). The Panel, appropriately deferring to the PTAB’s factual findings, affirmed the PTAB’s decision. (*Id.* at *5-6 (“Questions of nexus are highly fact-dependent....” (quoting *WBIP*, 829 F.3d at 1331))).

⁵ Cited by the Panel (Slip Op. at 13), both *Ormco* and *Ethicon* are inapposite. In *Ormco*, the patent owner admitted that its objective evidence was due to unclaimed features. (*Id.* at 1312-13). In *Ethicon*, Ethicon did not even attempt to argue that its evidence was related to a combination of the prior art features. *Ethicon Endo-Surgery, Inc. v. Covidien LP*, 812 F.3d 1023, 1035 (Fed. Cir. 2016).

In contrast, the Panel here did exactly what the Court in *WBIP* expressly denounced as improper—it “render[ed] irrelevant [all of MacNeil’s] objective evidence of non-obviousness.” *WBIP*, 829 F.3d at 1330-31. And the Panel did so by mistakenly concluding that the PTAB found all of MacNeil’s secondary-consideration evidence related exclusively to a known feature in the prior art. In addition, even though it acknowledged that MacNeil’s evidence also “mentions other features as well,” the Panel improperly substituted its own factual findings for the PTAB’s. Specifically, the Panel stated:

MacNeil refers to one article in the record that mentions other features as well, *id.* at 72 (citing [Appx]9892–93), the Board was not required to deem that article significant within the full record on industry praise. Nor, in any event, would this one article be entitled to significant weight in the overall legal weighing of the prior-art and secondary-consideration findings and evidence.

(Slip Op. at 14 n 4.)

The “substantial evidence” standard is not a high bar. Indeed, “[a] finding is supported by substantial evidence if a reasonable mind might accept the evidence to support the finding.” *K/S Himpp v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1364 (Fed. Cir. 2014). “It is not our role to reweigh the evidence or consider what the record might have supported.” *Apple Inc. v. Samsung Elecs Co.*, 839 F.3d 1034, 1056 (Fed. Cir. 2016) (en banc).

It was not proper under any standard for the Panel to substitute its own factual findings for that of the PTAB and outright reverse—especially when the decision rested in part on incorrect “presum[ptions]” (Slip Op. at 9), and particularly when the record does not support the Panel’s substituted factual findings. A remand for further proceedings was exactly the approach taken by the Court in *Rambus*, where it vacated the PTAB’s finding of obviousness and remanded, stating: “*At least* some of Rambus’s objective evidence of nonobviousness [related to other claim elements].” 731 F.3d at 1258 (emphasis added).

CONCLUSION

MacNeil respectfully requests reconsideration of the Panel’s decision, if not by the Panel itself, then by the Court *en banc*, to affirm the PTAB’s Final Written Decision in IPR2020-1139. In the alternative, MacNeil respectfully requests that the Panel instead remand this matter to the PTAB for further proceedings.

Dated: July 7, 2023

Respectfully submitted,

/s/John D. Denkenberger

John D. Denkenberger

Brian F. McMahon

John E. Whitaker

CHRISTENSEN O'CONNOR

JOHNSON KINDNESS^{PLLC}

1201 Third Avenue, Suite 3600

Seattle, WA 98101

Tel: 206.682.8100
Fax: 206.224.0779
john.denkenberger@cojk.com,
brian.mcmahon@cojk.com,
john.whitaker@cojk.com,
litdoc@cojk.com

Attorneys for Patent Owner-Appellee
MACNEIL IP LLC

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2022-1373; 2022-1374

Short Case Caption: Yita LLC v. MacNeil IP LLC

Instructions: When computing a word, line, or page count, you may exclude any items listed as exempted under Fed. R. App. P. 5(c), Fed. R. App. P. 21(d), Fed. R. App. P. 27(d)(2), Fed. R. App. P. 32(f), or Fed. Cir. R. 32(b)(2).

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because it meets one of the following:

- the filing has been prepared using a proportionally-spaced typeface and includes 3,706 words.
- the filing has been prepared using a monospaced typeface and includes _____ lines of text.
- the filing contains _____ pages / _____ words / _____ lines of text, which does not exceed the maximum authorized by this court's order (ECF No. _____).

Date: 07/07/2023

Signature: /s/John D. Denkenberger

Name: John D. Denkenberger