

2023-1801, -1802, -1803

**United States Court of Appeals
for the Federal Circuit**

CONVERTER MANUFACTURING, LLC,

Appellant,

– v. –

TEKNI-PLEX, INC.,

Appellee.

*On Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in Nos. IPR2021-00919,
IPR2021-00918, IPR2021-00916*

**COMBINED PETITION FOR REHEARING AND
REHEARING *EN BANC* OF APPELLANT
CONVERTER MANUFACTURING LLC**

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OCTOBER 9, 2024



CERTIFICATE OF INTEREST

Counsel for Appellant-Patent Owner, Converter Manufacturing LLC, certifies the following information in compliance with Federal Rule of Appellate Procedure 26.1 and Federal Circuit Rules 26.1 and 47.4:

1. The full name of every party represented by us is: **Converter Manufacturing LLC.**
2. The names of the real parties in interest (if the party named in the caption is not the real party in interest) represented by us is: **NONE.**
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the following: **NONE.**
4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

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Brian Anscomb
Benjamin Schwartz
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5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. See Fed. Cir. R. 47. 4(a)(5) and 47.5(b):

Clearly Clean Prods. LLC, et al. v. Tekni-Plex, Inc., et al., United States District Court for the Eastern District of Pennsylvania, Civil Case No. 2:20-cv-04723.

Clearly Clean Prods. LLC, et al. v. Eco Food Pak USA Inc., et al., United States District Court for the Central District of California, Civil Case No. 5:20-cv-01054.

In re Certain Rolled-Edge Rigid Plastic Food Trays, United States International Trade Commission, Investigation No. 337-TA-1203.

6. 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. R. App. P. 47.4(a)(6): **NONE**.

October 9, 2024

/s/ Joseph A. Farco
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FEDERAL CIRCUIT RULE 35(b) STATEMENT OF COUNSEL

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. Whether by summarily affirming the decision of the United States Patent and Trademark Office (“USPTO”) under Fed. R. App. P. 36, this Court violated the Supreme Court’s mandate in Loper Bright Enterprises v. Raimondo, 144 S. Ct. 2244, 2273 (2024) by failing to independently decide whether the USPTO properly applied the law requiring prior art to be enabled for it to anticipate a claim or render a claim obvious under 35 U.S.C. §§102 and 103 based on the record evidence below.
2. Whether proof that the claimed invention was considered by skilled artisans “impossible” to achieve before the priority date overcomes the presumption of enablement afforded to any prior art and combinations thereof such that the proponent of that prior art must prove that skilled artisans could have actually made the claimed invention using the teachings of one or more of the prior art combinations before the priority date.

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States and decisions

precedential to this Court: Loper Bright Enterprises v. Raimondo, 144 S. Ct. 2244 (2024); Seymour v. Osborne, 78 U.S. 516 (1880); In re Donohue, 766 F.2d 531 (Fed. Cir. 1985); Enzo Biochem, Inc. v. Calgene, Inc., 188 F.3d 1362 (Fed. Cir. 1999); Plant Genetic Sys., N.V. v. DeKalb Genetics Corp., 315 F.3d 1335 (Fed. Cir. 2003); Depuy Spine, Inc. v. Medtronic Sofamor Danek, 567 F.3d 1314 (Fed. Cir. 2009); Daiichi Sankyo Co., Ltd. v. Matrix Labs., Ltd., 619 F.3d 1346 (Fed. Cir. 2010); In re Morsa, 803 F.3d 1374 (Fed. Cir. 2015); Trustees of Bos. Univ. v. Everlight Elecs. Co., 896 F.3d 1357 (Fed. Cir. 2018); McGuffin v. Soc. Sec. Admin., 942 F.3d 1099 (Fed. Cir. 2019); and Raytheon Techs. Corp. v. Gen. Elec. Co., 993 F.3d 1374 (Fed. Cir. 2021).

October 9, 2024

/s/ Joseph A. Farco
Joseph A. Farco (lead
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*Counsel for Appellant-Patent
Owner Converter
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INTRODUCTION

This case involves an invention having a priority date of August 31, 2015, which was claimed by Appellant Patent Owner/Petitioner Converter Manufacturing LLC (“CM”) in three patents. These patents claim *inter alia* an “article comprising a body having the shape of a rounded rectangular tray ... [and] has a smooth periphery,” (U.S. Patent No. 9,908,281 (the “’281 Patent”)), an “article having a smooth periphery and having the overall shape of a rectangular tray with rounded corners,” (U.S. Patent No. 10,189,624 (the “’624 Patent”)), or an “[a]n article having a smooth, non-circular periphery...” (U.S. Patent No. 10,562,680 (the “’680 Patent”)) (collectively, the “Challenged Patents”). *See* Appx751; Appx805-806; Appx860-861. The Challenged Patents also disclose the earliest evidence of a physical embodiment within the scope of the challenged claims:

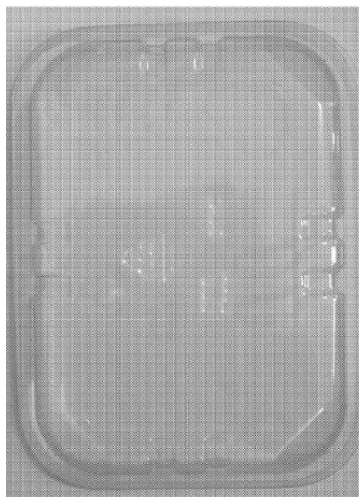


Fig. 6D

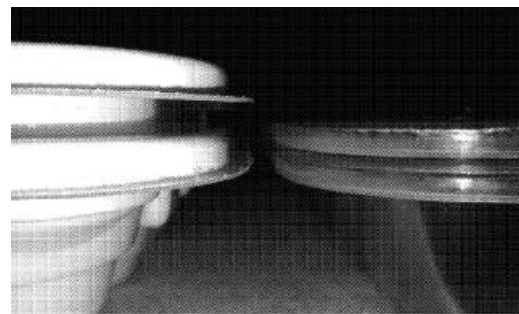
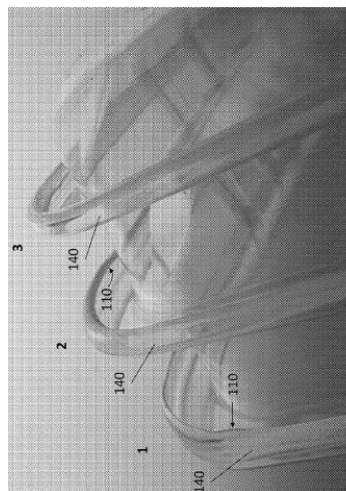


Fig. 9E

See Appx765-766, Appx780; Appx819-820, Appx834; Appx870, Appx887.

Prior to the August 31, 2015 priority date, **no non-hearsay evidence** was presented that anyone was able to produce articles within the scope of CM's inventions recited in the challenged claims. At least one third party manufacturer, DexterMT, considered the solution disclosed and claimed in the Challenged Patents to be "impossible" prior to 2016. The record in this regard was undisputed:

- May 18, 2012: WO96/01179A1 to Portelli et al. ("Portelli") disclosed a prior art double stage thermoforming method that often failed (forming "puckering and distortions") in attempting to form a smooth periphery. *See* Appellant's opening brief, Dkt. No. 22¹ ("Opening Br.") at 29 (citing Appx10660, 1:17-18, Appx10665, 6:29-33; *see also* Appx1138; Appx1311; Appx1435 (the "Australian patent" in WO2012/064203A1 to Long et al. ("Long") refers to Portelli).
- January 1, 2015: "[T]here has not been a process which can remove the sharp flanges and burs on rectangular shaped PET and HDPE packaging at high-speed production levels." Opening Br. at 29 (citing Appx12163, ¶[0003]).

¹ All citations to "Dkt. No." refer to the consolidated appellate docket for Appeal Nos. 2023-1801, -1802, -1803.

- August 12, 2015: Alto Packaging Limited (“Alto”), the assignee of the Long reference, stated that known thermal deformation methods (i.e., Portelli) caused “puckering and distortion of the lip” (i.e., the rim or periphery) of thermoformed articles. *See* Opening Br. at 30 (citing Appx21196).
- August 31, 2015 (the priority date): The Challenged Patents reported that rolling curved edges of corners of rectangular thermoformed articles using prior methods caused buckling or wrinkling that resulted in a non-smooth edge. *See* Opening Br. at 30 (citing Appx786, 4:9-21, Appx790, 12:57-67; Appx840, 4:15-27, Appx845, 13:2-12; Appx919, 13:25-35, Appx914, 4:50-62).
- 2016 (post-priority date): Third-party DexterMT stated that forming a smooth edge on non-circular thermoformed articles (referred to as rim-rolling) using its Rolled In-Rim Mold (“RRIM”) process² “has been *impossible* until now!” Opening Br. at 30 (citing Appx15527).³ In that

² Appellee represented to the USPTO and this Court that RRIM represented the prior art Portelli process. *See* Appx25; Appx118; Appx213.

³ Emphasis added unless otherwise noted.

same time frame, DexterMT also stated that “*rolling the edge has only been possible with round products.*” *Id.* (citing Appx22116-22117).

- March 5, 2018: Pieter-Jans Willemse (“Willemse”) of DexterMT stated that there were “unknowns” and experimentation was required to use the RRIM process to make an embodiment of the challenged claims. *See* Opening Br. at 32-35 (citing Appx22118-22119; Appx22151; Appx22161-22163, ¶¶3-5; Appx22367, 35:5-36:3; Appx20286-20294; Appx20610-20618; Appx20925-20935). Thus, this evidence proved that skilled artisans still required experimentation with using the RRIM process to make a smooth periphery in a rectangular thermoformed article nearly three years *after* the priority date.

The USPTO never held that the above unrefuted evidence failed to satisfy CM’s burden to rebut the presumption of enablement afforded to Meadors, Portelli, Long, and the Portelli-Long combination. *See In re Morsa*, 713 F.3d 104, 110 (Fed. Cir. 2013) (presumption of enablement rebutted when patent owner makes “a non-frivolous argument that cited prior art is not enabling,” and “do[es] more than state an unsupported belief that a reference is not enabling.”) To the contrary, this unrefuted evidence is in the record and is fully supported.

Patent-challenger Tekni-Plex, Inc. (“Appellee”) only established that *after 2016* (after the priority date) third parties made articles that practiced one or more

distinct and conflicting methods disclosed in three prior art references and a combination thereof: U.S. Patent No. 4,228,121 to Meadors (“Meadors”), Portelli, Long, and a hypothetical combination of Portelli and Long. Notably, Appellee never compared the alleged articles to any of the challenged claims. Apart from uncorroborated hearsay regarding alleged manufactures in 2012 of products that were never demonstrated to embody any challenged claim, **no evidence exists** that skilled artisans could, using the prior art references, make an article that satisfied every limitation of one or more challenged claims on or before August 31, 2015.

Despite the lack of evidence of enablement of the prior art, a three-judge panel of this Court (the “Panel”) on September 9, 2024 used Fed. R. App. P. 36 defer to the USPTO, a federal executive branch agency, to apply its own law of prior art enablement, notwithstanding the fact that such deference is contrary to the Supreme Court’s decision in Loper Bright and the Administrative Procedure Act (“APA”). Consequently, the Panel declined to disturb the USPTO finding that all challenged claims were unpatentable as: (i) anticipated by Meadors; (ii) anticipated and obvious over Portelli; and (iii) obvious over a combination of Portelli in view of Long. *See Rates Tech., Inc. v. Mediatrix Telecom, Inc.*, 688 F.3d 742, 750 (Fed. Cir. 2012). Although Fed. R. App. P. 36 “ought to leave little doubt why the decision of the lower tribunal was affirmed,” Innovation Scis., LLC v. Amazon.com, Inc., 842 F. App’x 555, 558 (Fed. Cir. 2021), the Panel’s silent affirmance of the USPTO’s

interpretation of the law of prior art enablement is irreconcilable with the legally relevant record evidence of *non*-enablement.

The Panel clearly overlooked the unrefuted documentary evidence *supra* that the prior art cited by Appellee was non-enabling and accepted the USPTO applying its own version of prior art enablement law to factual “findings” consisting of the conclusory, self-serving testimony of Appellee’s expert, which was contradicted by the same unrefuted documentary evidence. *See McGuffin v. Soc. Sec. Admin.*, 942 F.3d 1099, 1107, 1110 (Fed. Cir. 2019); *Homeland Housewares, LLC v. Whirlpool Corp.*, 865 F.3d 1372, 1378 (Fed. Cir. 2017) (expert testimony disregarded when it “is plainly inconsistent with the record.”); *see also Ericsson Inc. v. Intell. Ventures I LLC*, 890 F.3d 1336, 1346 (Fed. Cir. 2018) (what prior art shows to skilled artisan “is not a matter of credibility but of technological evidence.”)

By rehearing this case and/or rehearing this case *en banc*, the Court can rectify the precedent-destroying and irreconcilable holdings and factual findings of the USPTO left untouched by the Panel under Fed. R. App. P. 36. This Court can properly apply the rule of law that will permit the public to distinguish between a reference that is more akin to science fiction than one that conveys a practical, enabling disclosure of a prior solution to a technological problem.

REHEARING AND REHEARING EN BANC IS NECESSARY

I. LOPER BRIGHT BARS THIS COURT FROM DEFERRING TO THE USPTO’S INTERPRETATION OF 35 U.S.C. §§102 AND 103 ON THE ISSUE OF PRIOR ART ENABLEMENT UNDER FED. R. APP. P. 36.

By failing to overturn the USPTO’s misinterpretation of the law regarding enablement of prior art references, the Panel substituted the USPTO’s unsupportable law of prior art enablement for its own. As discussed *infra*, the USPTO’s prior art enablement law contravenes the closest relevant decisions of the U.S. Supreme Court and of this Court. While taking a short cut using Fed. R. App. P. 36, the Panel neglected its duty under Article III of the U.S. Constitution to apply this Court’s and the Supreme Court’s prior art enablement law to the record evidence, as opposed to the aberration of the law applied by the USPTO.

Only two statutes in the Patent Act (Title 35) mention enablement as a requirement: 35 U.S.C. §§ 112 and 122. According to 35 U.S.C. § 112(a), “[t]he specification [of an issued United States patent] shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms *as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . .*” According to 35 U.S.C. §122(b)(2)(B)(v), “[t]he provisions of section 154(d) shall not apply to a claim if *the description of the invention published* in the redacted

application filed under this clause with respect to the claim *does not enable a person skilled in the art to make and use the subject matter of the claim.*”

35 U.S.C. § 102 identifies subject matter that can be considered prior art, and 35 U.S.C. § 103 specifies the circumstances under which prior art will render a claim obvious. Neither Section 102 nor Section 103 specifies an enablement requirement for prior art nor the standard under which subject matter disclosed in prior art must be enabled. Therefore, the enablement requirement implicit under Sections 102 and 103 is entirely absent from either statute. The USPTO has no authority to read words into statutes and then apply its own interpretation of those words to a case before it.

The Panel’s affirmance under Fed. R. App. P. 36 is tantamount to deferring to agency interpretation of the law of prior art enablement under 35 U.S.C. §§102 and 103 under the APA. However, this Court “under the APA may not defer to an agency interpretation of the law simply because a statute is ambiguous.” Loper Bright, 144 S. Ct. at 2273. Here, the requirement that prior art be enabled under 35 U.S.C. §§102 and 103 is not ambiguous. Neither statute says *anything* about enablement that would permit the USPTO to apply its own agency interpretation thereto. Through its silence, the Panel’s Rule 36 affirmance gave the USPTO the same power as this Court to define the patent law, here the law of prior art enablement, and then apply it to the record below. The USPTO’s law of prior art enablement is manifest in its Final Written Decisions, namely, the USPTO decisions

that three references (Meadors, Portelli, and Long) and a combination of references (Portelli and Long) were “enabling” to render the challenged claims anticipated and/or obvious over the same. The USPTO’s finding rested on (i) the words of publications; (ii) a paid expert’s testimony regarding post-priority-date manufacture of products that were never compared by Appellee or its expert to the challenged claims; and (iii) its agency decision to disregard the undisputed pre-priority-date documentary evidence of “impossibility” on the part of skilled artisans to successfully manufacture an embodiment of the challenged claims. Thus, under the USPTO’s illogical version of prior art enablement law, prior art or prior art combinations are enabling as of their prior art dates once there is evidence that their disclosures were accomplished, including being accomplished for the first time *after* the challenged claims’ priority date. This is an absurd interpretation of the law as it would allow the radio watch used by Dick Tracy to be enabling prior art as of 1940 merely because smart watches were finally created in the 21st Century. This Court cannot countenance the USPTO’s illogical and absurd prior art enablement law.

The Panel’s silence in summarily affirming the USPTO’s clearly erroneous interpretation of the law regarding prior art enablement under 35 U.S.C. §§102 and 103 violates the Supreme Court’s holding in Loper Bright and deprived CM of due process under the APA.

II. ONCE ITS PRESUMPTION OF ENABLEMENT HAS BEEN OVERCOME, AN UNMAKEABLE PRIOR ART EMBODIMENT CANNOT ANTICIPATE OR RENDER OBVIOUS AN INVENTION UNLESS THERE IS EVIDENCE THAT SKILLED ARTISANS COULD ACTUALLY MAKE THAT EMBODIMENT ON OR BEFORE THE PRIORITY DATE

A. Failures By Those Skilled in the Art (Having Possession of the Information Disclosed by The Prior Art) Are Strong Evidence that the Disclosures of the Prior Art Are Non-Enabling

The Supreme Court in Seymour v. Osborne held that prior art publications have to “enable any person skilled in the art or science to which it appertains, to *make, construct, and practice* the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent” and in order for the publication to serve as prior art, “must be an account of a complete and *operative invention capable of being put into practical operation.*” 78 U.S. 516, 555 (1870). If the evidence showed that skilled artisans were incapable of putting a prior art embodiment into practical operation, as CM has proven here (*see* Introduction, *supra*), then that prior art could not have enabled that embodiment under Seymour.

The Panel during oral argument referenced this Court’s caselaw suggesting that “invention in a prior art publication need not have actually been made or performed to satisfy enablement.” In re Antor Media Corp., 689 F.3d 1282, 1290 (Fed. Cir. 2012) (citing In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985) (“fact that the author of a publication did not attempt to make his disclosed invention does

not indicate one way or the other whether the publication would have been enabling.”)) But the Panel failed to consider this Court’s precedent that proof that skilled artisans could not make the invention using the prior art constitutes “***strong evidence that the disclosure of the publication was nonenabling***”:

It is not, however, necessary that an invention disclosed in a publication shall have actually been made in order to satisfy the enablement requirement. In re Wiggins, 488 F.2d 538, 179 USPQ 421 (CCPA 1973) and In re Sheppard, 339 F.2d 238, 144 USPQ 42 (CCPA 1964), do not support a contrary view. In those cases, ***the references were deemed insufficient, because they stated that attempts to prepare the claimed compounds were unsuccessful. Such failures by those skilled in the art (having possession of the information disclosed by the publication) are strong evidence that the disclosure of the publication was nonenabling.***

See Donohue, 766 F.2d at 533.

This Court’s leading precedent on prior art enablement, Raytheon Techs., Corp. v. Gen. Elec. Co., 993 F.3d 1374 (Fed. Cir. 2021) (Chen, J.) is consistent with the above-cited analysis from Donohue. This Court in Raytheon framed the prior art enablement inquiry as “whether a skilled artisan can ***make*** and ***use*** the subject matter disclosed in the reference.” Id. at 1376. In the context of combinations of references under 35 U.S.C. § 103, this Court also stated in Raytheon that “if an obviousness case is based on a non-self-enabled reference, and no other prior art

reference or evidence would have enabled a skilled artisan to *make* the claimed invention, then the invention cannot be said to have been obvious.” Id. at 1377.

This Court’s Rule 36 confirmation of the USPTO’s enablement decision contradicts the Supreme Court’s Seymour precedent and contradicts its decisions in Donohue and Raytheon. This Court in Raytheon faulted the patent challenger for failing to prove that skilled artisans “could have actually built” the prior art embodiment and instead relied on a “computer model simulation”:

GE neglected to mention that what its expert “constructed” was a computer model simulation of Knip's imagined engine, not a physical working engine. *GE’s expert never suggested that a skilled artisan could have actually built such an engine.*

Compare Raytheon, 993 F.3d at 1382 *with* Novo Nordisk Pharms., Inc. v. Bio-Tech. Gen. Corp., 424 F.3d 1347, 1356 (Fed. Cir. 2005) (finding 1981 article enabled because “[expert] actually made the subject matter of claim 1 using the disclosed materials and methodology set forth in the Pavlakis 1981 article.”)

The facts in this case are more compelling of non-enablement than those before this Court in Raytheon and warrant a finding that pre-priority evidence of failures and “impossibility” by those in the industry were “strong evidence” that Meadors, Portelli, Long, and the Portelli-Long combination were *non*-enabling according to this Court’s analysis in Donohue. Here, after CM overcame the presumption of enablement afforded all of Appellee’s prior art and combinations

thereof, Appellee relied on third-party products made *after 2016* and allegedly made according to the conflicting processes disclosed in Long and Portelli. Cf. Appellant’s reply brief, Dkt. No. 30 (“Reply Br.”) at 13 (citing Appellee’s opposition brief, Dkt. No. 27 (“Opp’n Br.”) at 50). Moreover, when confronted with CM’s evidence that others thought the achievement of the claimed inventions was “impossible” before the priority date, Appellee’s expert did not “actually build” any embodiment of the Meadors prior art to refute that technical evidence. According to this Court’s precedent, CM’s un rebutted evidence that Meadors, Portelli, Long, and Portelli-and-Long combined failed to enable skilled artisans to “actually build” a non-circular/rectangular article with a smooth periphery “is conclusive” of non-enablement. See Raytheon, 993 F.3d at 1382 (“Board’s finding that [prior art] is ‘enabling’ is legal error.”)

Therefore, the Panel should have faulted the USPTO for failing to follow the Supreme Court’s Seymour decision and this Court’s analyses in its Donohue and Raytheon precedents. Properly applying the law of prior art enablement to CM’s evidence that skilled artisans considered it “impossible” to make a claimed embodiment before 2016 (i.e., before the priority date), this Court must find that this evidence of “failures by those skilled in the art (having possession of the information disclosed by the [Meadors, Portelli, Long, and Portelli-and-Long combinations]) are

strong evidence that the disclosure of the publication[s] was *nonenabling*.”

Donohue, 766 F.2d at 533.

B. The Challenged Patent’s Disclosure of a Physical Embodiment Provides a Basis for What Is Required for Enablement of Prior Art.

According to the Supreme Court’s Seymour decision, the prior art publication must teach the public how “to make, construct, and practice the invention *to the same practical extent as they would be enabled to do if the information was derived from a prior patent*.” 78 U.S. at 555. The skilled artisan viewing the information derived from the Challenged Patents is provided a physical embodiment depicted and described as of the priority date. *See* Opening Br. at 9 (citing Appx765-766, Appx780; Appx819-820, Appx834); *see also* Appx870, Appx887. In other words, physical reproduction of the claimed invention (i.e., the rectangular thermoformed article with a smooth periphery) using the disclosed process is a requirement for enabling disclosure in this case. Appellee does not disagree – it told the USPTO that Wands factor 3, the existence of working examples, was “the most relevant of the factors” in determining enablement. *See* Opening Br. at 35 (citing Appx2618, Appx2644; Appx2686, Appx2704; Appx2754, Appx2779).

This Court has used the challenged patent’s disclosure as a basis for comparison with the prior art reference when it comes to determining enablement of the reference. *See* SRI Int’l, Inc. v. Internet Sec. Sys., Inc., 511 F.3d 1186, 1194 (Fed. Cir. 2008) (comparing publication disclosure to patent specification to show

publication was enabled to the same extent as patent). However, unlike the Challenged Patents, none of Meadors, Portelli, Long, the Portelli-Long combination, or any printed document anywhere in the record (including the irrelevant Throne text book on which Appellee relies throughout its briefing to the Panel) depict any real life picture of a rolled rim/smooth periphery rectangular article supposedly made using a prior art process and that also meets each and every limitation of every challenged claim. At best, Appellee presented hearsay regarding undated photographs of unfinished parts and computer screens that the USPTO acknowledged were unreliable. Opening Br. at 17, 38-39 (citing Appx38-39, Appx87; Appx131-132, Appx183; Appx228-229, Appx265). Otherwise, there is no evidence of an actual product made by the prior art *before* the priority date or an actual product that is within the scope of any challenged claim either *before* or *after* the priority date.

The only evidence of a commercial embodiment of the challenged claims is CM's evidence of its own products that garnered it commercial success, industry praise, skepticism, and long felt need, and Appellee's infringing copy-cat products, which corroborate the fact that no one was able to achieve the claimed solution until CM. See Opening Br. at 10-11 (citing Appx21109, 78:6-79:6; Appx21940-21945, ¶¶7-11 (commercial success); Appx785, 2:5-14, Appx790, 12:29-32; Appx839, 2:6-15, Appx844, 12:38-44; Appx913, 2:21-30, Appx918, 12:28-31; Appx21939, ¶4

(long felt need); Appx21972; Appx21946, ¶¶14-15, Appx20264-20265, ¶235; Appx20590, ¶235; Appx20899-20900, ¶236; Appx21979-21980; Appx21973-21975; Appx21966-21968; *see also* Appx20263-20264, ¶¶232-233; Appx20588-20589, ¶¶231-233; Appx20898, ¶¶233-234; Appx20264, ¶234; Appx20589-590, ¶234; Appx20899, ¶235 (industry praise)); *see also* Opening Br. at 12 (citing Appx66; Appx161; Appx254 (objective indicia not disputed by Appellee)).

As this Court held in Raytheon, it was Appellee’s burden to present evidence that skilled artisans could have “actually” made the prior art embodiment of the claimed invention. Raytheon, 993 F.3d at 1382 (patent challenger failed to prove “that a skilled artisan could have made the *claimed* turbofan engine with the recited power density.”) The Panel failed to reverse the USPTO’s implied finding to the contrary premised on articles that admittedly were never shown to be an embodiment of any challenged claim (assuming they did practice the prior art). *See* Reply Br. at 12-13 (Appellee argued that it did not have to prove whether any post-priority date product met any challenged claim).

C. Post-Priority Date Evidence of Alleged Practice of Prior Art Does Not Prove Enablement of That Prior Art Before the Priority Date.

Because skilled artisans were unable to make any embodiment of Meadors, Portelli, Long, or Portelli-and-Long combined before August 31, 2015, the USPTO instead justified its legal conclusion of enablement on evidence presented by Appellee that skilled artisans had made articles using third party processes akin to

those described in the prior art *after* the priority date. *See* Opening Br. at 25 (citing Appx25; Appx118; Appx213). By confirming this legal error under Fed. R. App. P. 36, the Panel contradicted this Court’s precedents in Trustees of Boston University, 896 F.3d at 1364, Plant Genetic Systems, 315 F.3d at 1344, and Enzo Biochem, 188 F.3d at 1376.

Even if third parties finally succeeded in using the processes disclosed in Meadors, Portelli, Long, or the Portelli-Long combination *after* the priority date, “[s]imply observing that it could be done—years after the patent’s effective filing date—bears little on the enablement inquiry.” Trustees of Bos. Univ., 896 F.3d at 1364. A “[r]eport of a first success after [the priority date] indicates failure or difficulty in or before [the priority date].” Plant Genetic Sys., 315 F.3d at 1344; *see also* Enzo Biochem, 188 F.3d at 1376 (expert declaration identifying “a number of examples of post-filing success” actually “support[ed] a conclusion of nonenablement.”) Again, the USPTO’s erroneous understanding of prior art enablement law would allow science fiction to become enabling prior art as of its publication regardless of evidence that skilled artisans could not actually make such science fiction as of the priority date of the claim(s) under review.

The Panel should have followed this Court’s precedent and rejected all post-priority date evidence of articles as proof of enablement of the prior art. Rather, this Court should have held that Appellee’s proof of first time, post priority-date

successes based on the prior art was evidence of *non*-enablement and undue experimentation *before* the priority date.

CONCLUSION

For the foregoing reasons, CM respectfully requests that this Court grant its request for panel rehearing and rehearing *en banc* to decide each of the precedent-setting questions set forth above and to correct the errors of law and fact that were overlooked by the prior panel of the Court.

Respectfully Submitted,

October 9, 2024

/s/ Joseph A. Farco

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ADDENDUM

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

CONVERTER MANUFACTURING, LLC,
Appellant

v.

TEKNI-PLEX, INC.,
Appellee

2023-1801, 2023-1802, 2023-1803

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2021-00916, IPR2021-00918, IPR2021-00919.

JUDGMENT

JOSEPH ANTHONY FARCO, Norris McLaughlin, PA, New York, NY, argued for appellant. Also represented by BENJAMIN D. SCHWARTZ.

MICHAEL A. FISHER, Dechert LLP, Philadelphia, PA, argued for appellee. Also represented by ROBERT W. ASHBROOK, JR., DIANE SIEGEL DANOFF, KEVIN M. FLANNERY, LUKE M. REILLY.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (DYK, CHEN, and CUNNINGHAM, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

September 9, 2024
Date



Jarrett B. Perlow
Clerk of Court

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

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2023-1801, 2023-1802, 2023-1803

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Signature: /s/ Joseph A. Farco

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