
LEAP Program Discussion and Oral Argument

*Presented at the PTAB Bar Association Annual Conference
September 23, 2021*

Panelists

- Vice Chief Judge Janet Gongola
- Senior Lead Judge Kalyan Deshpande
- Judge Amanda Wieker
- Deborah Yellin (Washington, D.C.: Crowell & Moring)
- Mike Babbitt (Chicago: Willkie Farr & Gallagher)

Overview of Claim Construction Case Law

Plain and Ordinary Meaning

- Claim Construction Standard

"[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc); see also 37 CFR § 42.100.

Additional Claim Construction Considerations

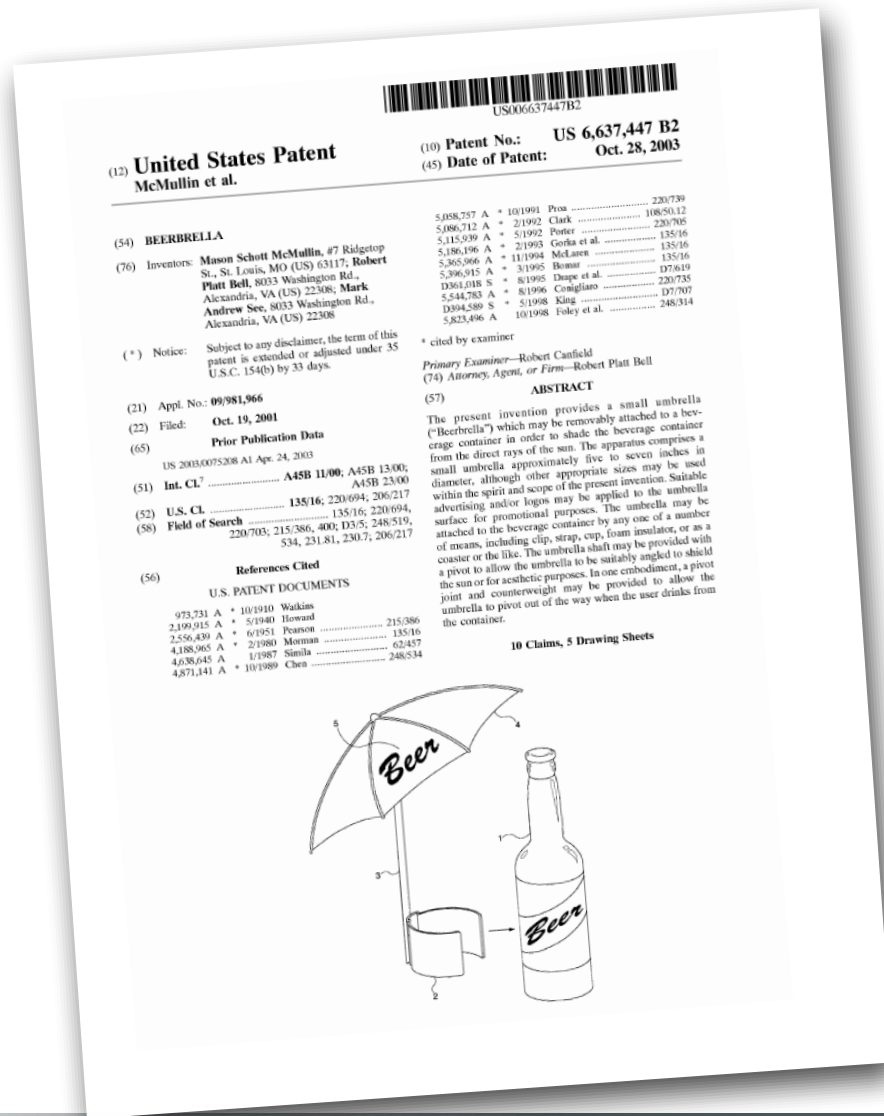
- “The determination of whether a preamble limits a claim requires a review of ‘the entire[]... patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.’” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed Cir. 2002) (citing *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989)).
- “In general, a preamble limits the invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim. Conversely, a preamble is not limiting where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention. *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed Cir. 2002) (internal citations and quotations omitted).

Additional Claim Construction Considerations

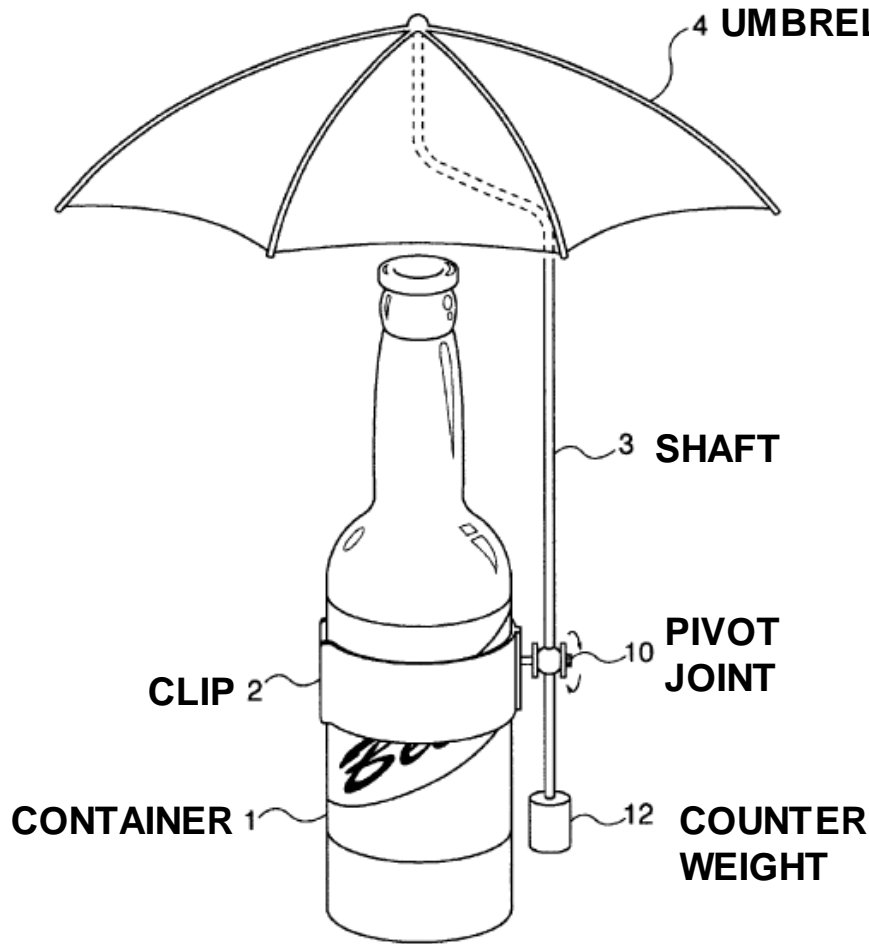
- “[W]hen the patentee unequivocally and unambiguously disavows a certain meaning to obtain a patent, the doctrine of prosecution history disclaimer narrows the meaning of the claim.” *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1350 (Fed. Cir. 2013).
- “Rather, because the disputed term is a coined term, meaning it has no ordinary and customary meaning, the question is whether the intrinsic evidence provides objective boundaries to the scope of the term. In these circumstances, where there is no clear ordinary and customary meaning of a coined term of degree, we may look to the prosecution history for guidance without having to first find a clear and unmistakable disavowal.” *Iridescent Networks, Inc. v. AT&T Mobility, LLC*, 933 F.3d 1345, 1353 (Fed. Cir. 2019) (internal citations and quotations omitted).

Mock Argument Facts

The '447 “Beerrella” Patent



Industry Giant Shady Beer's Invention - The Beerbrella



Clip 2 may be removably attached to container 1 such that the apparatus may be reused on another container when container 1 is empty. Attached to clip 2 is shaft 3 for supporting umbrella 4. Umbrella 4 may be fixed to shaft 3 or may be attached using a pivot joint or the like as will be discussed in more detail below. Shaft 3 may be made of plastic, wood, cardboard, or metal, but in the preferred embodiment is plastic.

FIG. 2 is a front perspective view of a second embodiment of the present invention. In the embodiment of FIG. 3, umbrella shaft 3 may be provided with a pivot joint 10 and counterweight 12 to umbrella 4 to pivot out of the way when the user drinks from the container. When the user places the container back in an upright position, umbrella 4 will automatically pivot back into position by action of gravity.

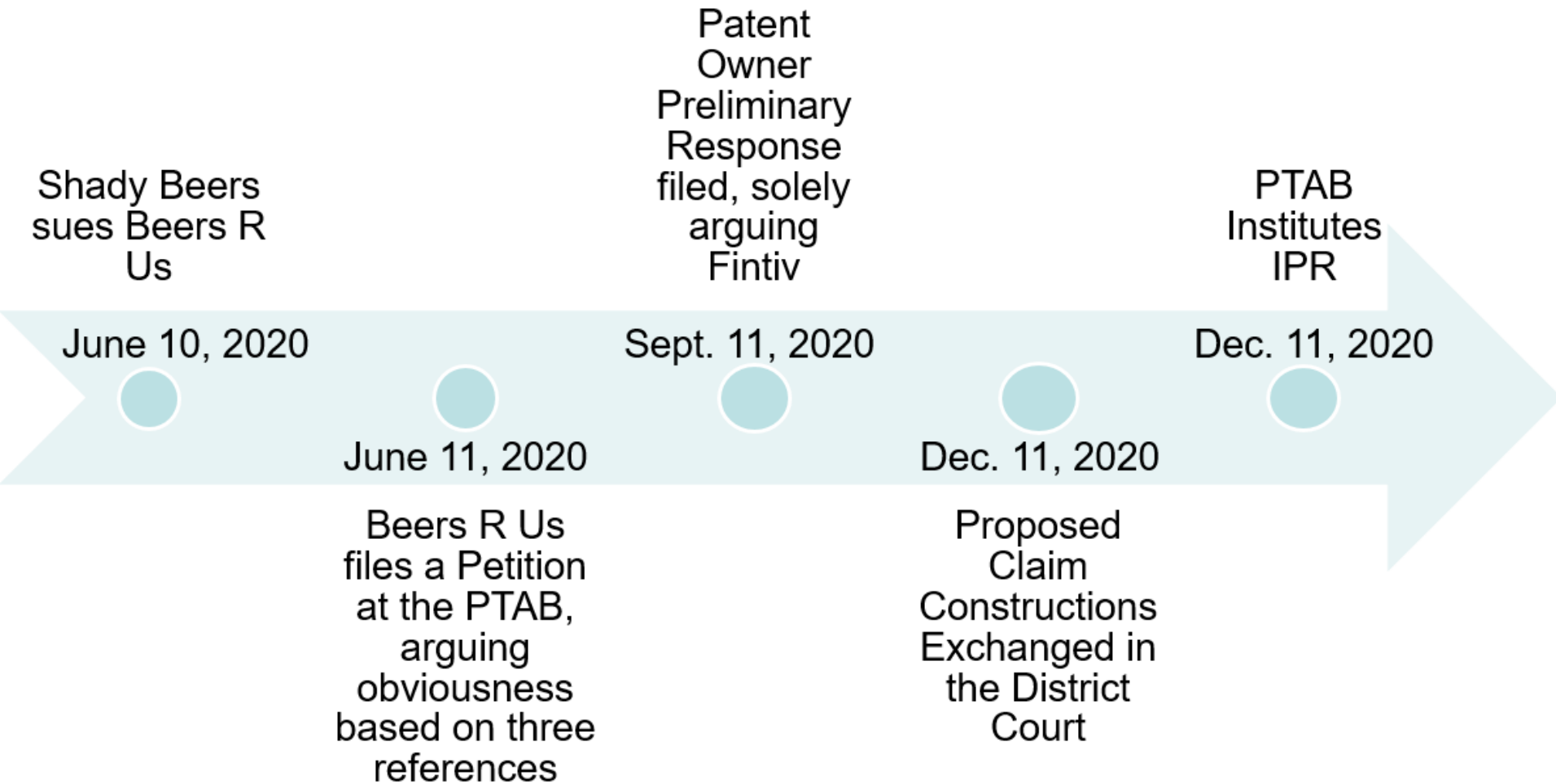
'447 Patent Prosecution History Excerpts

- In an Office Action Response, Applicant argued:
 - “The Beerbrella is a revolutionary invention that will help to keep your beer cold longer.”
 - “The Beerbrella is a nonobvious and novel invention which may generally be described as an umbrella that can be removably attached to beverages.”
 - “The beverage container is intended for a person to drink a beverage from said beverage container, such as a glass, can, or bottle.”
 - “The Beerbrella has a relatively compact footprint, which facilitates ease of transport and conveniently allows you to keep your drink cool wherever you go.”
 - “The Beerbrella can keep your beer cool once it is opened.”
 - “The clip can be adjusted to fit drinks of different sizes.”
- In response, the Examiner allowed the claims and stated:
 - “The prior art of record does not disclose the claimed Beerbrella.”

Beers R Us's Allegedly Infringing System



Timeline of the Lawsuit – Part 1



Timeline of the Lawsuit – Part 2

Markman Hearing

Jan. 11, 2021



Mar. 11, 2021



Shady Beers files PO Response, putting claim construction at issue

IPR Oral Argument

Sept. 23, 2021



Jan. 2022

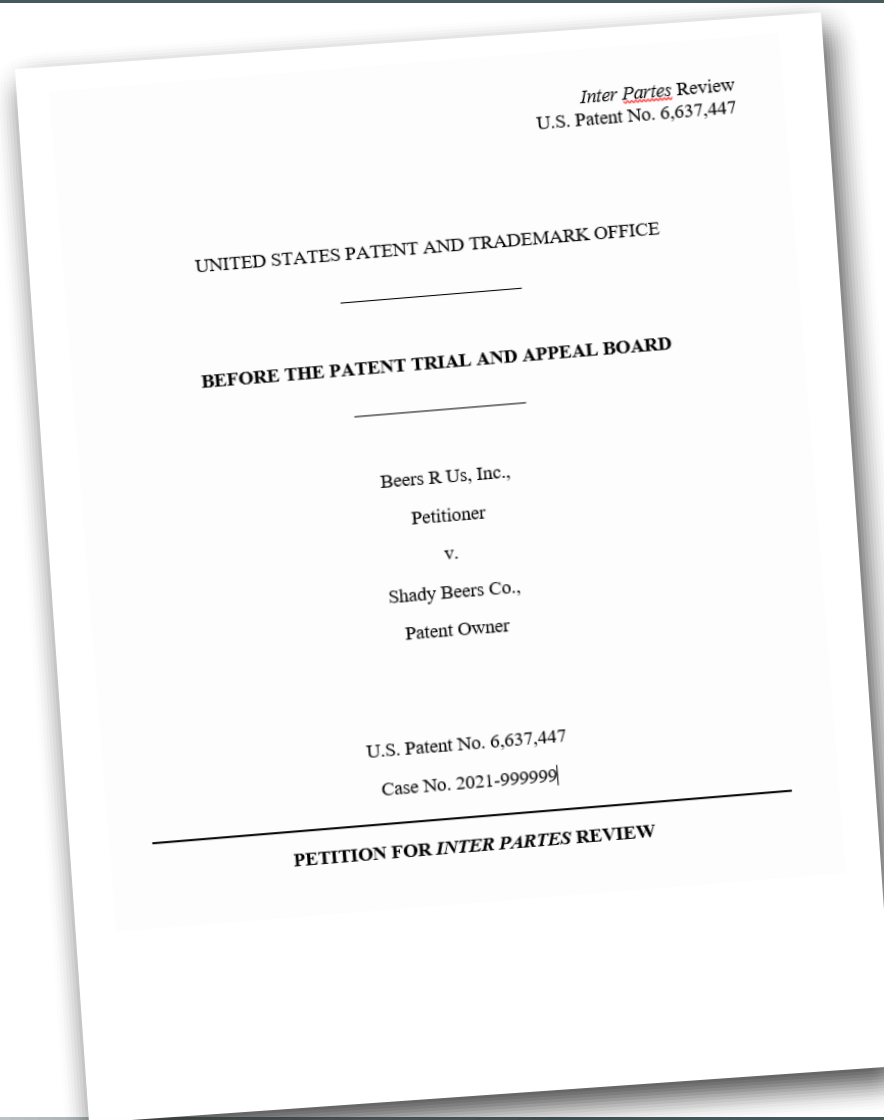


Expected Markman Decision Date

Shady Beers Sues Beers R Us



Beers R Us Petitions for IPR of the '447 Patent



The Beerbrella Abstract

US00637447B2

(12) **United States Patent**
McMullin et al.

(10) Patent No.: **US 6,637,447 B2**
(45) Date of Patent: **Oct. 28, 2003**

(54) **BEERBRELLA**

(70) Inventors: **Mason Scott McMullin**, #7 Ridgeway St., St. Louis, MO (US) 63117; **Robert Platt Bell**, 8033 Washington Rd., Alexandria, VA (US) 22308; **Mark Andrew See**, 8033 Washington Rd., Alexandria, VA (US) 22308

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 33 days.

(21) Appl. No.: **09/981,966**
(22) Filed: **Oct. 19, 2001**
(65) **Prior Publication Data**
US 2003/0075208 A1 Apr. 24, 2003

(51) **Int. Cl.⁷** **A45B 11/00**; A45B 13/00; A45B 23/00

(52) **U.S. Cl.** **135/16**; 220/694; 206/217

(58) **Field of Search** 135/16; 220/694; 220/703; 215/386; 400/133; 248/519; 534; 231.81; 230.7; 206/217

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Primary Examiner—Robert Canfield
(73) *Attorney, Agent, or Firm*—Robert Platt Bell

(57) **ABSTRACT**
The present invention provides a small umbrella ("Beerbrella") which may be removably attached to a beverage container in order to shade the beverage container from the direct rays of the sun. The apparatus comprises a small umbrella approximately five to seven inches in diameter, although other appropriate sizes may be used within the spirit and scope of the present invention. Suitable advertising and/or logos may be applied to the umbrella surface for promotional purposes. The umbrella may be attached to the beverage container by any one of a number of means, including clip, strap, cup, foam insulator, or as a coaster or the like. The umbrella shaft may be provided with a pivot to allow the umbrella to be suitably angled to shield the sun or for aesthetic purposes. In one embodiment, a pivot joint and counterweight may be provided to allow the umbrella to pivot out of the way when the user drinks from the container.

10 Claims, 5 Drawing Sheets



(57) **ABSTRACT**

The present invention provides a small umbrella ("Beerbrella") which may be removably attached to a beverage container in order to shade the beverage container from the direct rays of the sun. The apparatus comprises a small umbrella approximately five to seven inches in diameter, although other appropriate sizes may be used within the spirit and scope of the present invention. Suitable advertising and/or logos may be applied to the umbrella surface for promotional purposes. The umbrella may be attached to the beverage container by any one of a number of means, including clip, strap, cup, foam insulator, or as a coaster or the like. The umbrella shaft may be provided with a pivot to allow the umbrella to be suitably angled to shield the sun or for aesthetic purposes. In one embodiment, a pivot joint and counterweight may be provided to allow the umbrella to pivot out of the way when the user drinks from the container.

Hypothetical Independent Claim 11

11. A Beerbrella for shading beverage containers, comprising:
- a beverage container, for containing a beverage;
 - a means for removably attaching the apparatus to the beverage container;
 - a shaft, coupled to the means for removably attaching the apparatus, and extending vertically with respect to the beverage container;
 - an umbrella, coupled to the shaft at a point above the means for removably attaching, so as to shade the beverage container;
- wherein the means for removably attaching comprises a clip provided to attach to the beverage container by means of spring action and friction.

Claim Construction Positions

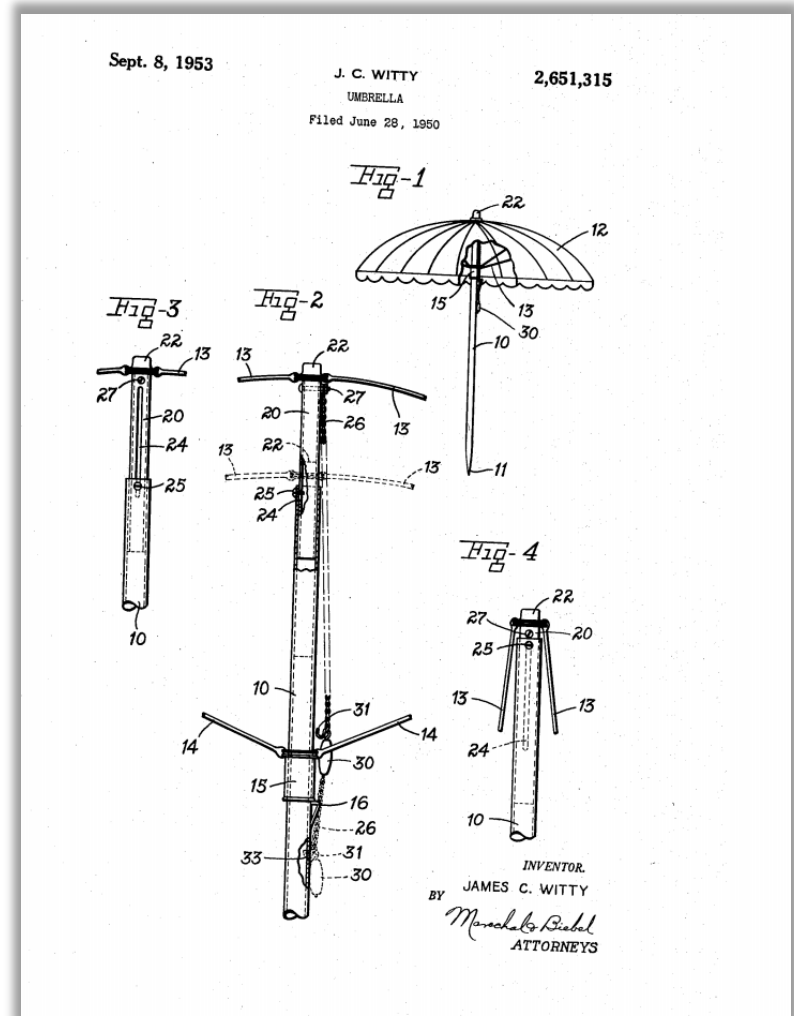
	Patent Owner	Petitioner
Beerrella	<p>IPR: the preamble is limiting and requires a smaller umbrella.</p> <p>District court: Patent Owner did not propose any explicit construction.</p>	<p>IPR: the preamble is not limiting.</p>
Beverage container	<p>IPR: A vessel to contain beer.</p>	<p>IPR: no construction necessary/plain and ordinary meaning.</p> <p>District court: Petitioner proposed an explicit construction of “glasses, cans, or bottles, particularly those that contain alcoholic beverages.”</p>

Expert Deposition Statements in the IPR

- Patent Owner's expert, Dr. Arthur Kegger, Chair of Fermentation at a prestigious party school, testified:
 - Q: Dr. Kegger, wouldn't you agree that once you open a beer, it heats up more quickly?
 - A: Well, it is my understanding that the Beerbrella does a great job keeping open beers cool.
- Petitioner's expert, Dr. Susan Brew, founder of the U.S. Institute for Beer Preservation, testified:
 - Q: Dr. Brew, do you see in the Abstract of the '447 patent where it states that the apparatus comprises a small umbrella approximately five to seven inches?
 - A: Well, uh, I suppose, uh, I guess that would be a good size umbrella to keep a beer cool.

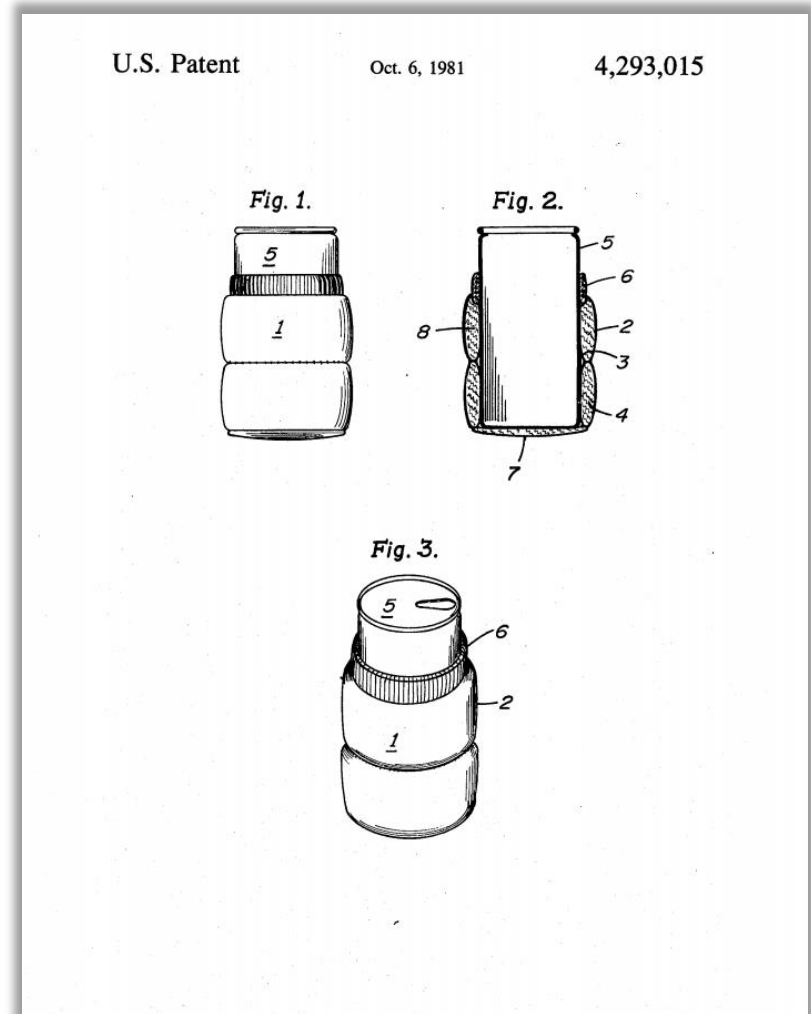
IPR Ground 1, Reference 1 – U.S. Patent No. 2,651,315

- “This invention relates to umbrellas, and more particularly to umbrellas of comparatively large size such as beach or garden umbrellas or the like.”



IPR Ground 1, Reference 2 – U.S. Patent No. 4,293,015

- “This invention relates to a means for providing an insulated cylindrical jacket for cold beverage cans...so the beverage remains cold, and also, is highly portable.”



IPR Ground 1, Reference 3 – Portable Wine Cooler

- Petitioner also submitted evidence of a covered portable wine cooler as part of its obviousness grounds.
- Petitioner argued the portable wine cooler keeps beverages cool.



Mock Arguments & Practice Pointers

THANK YOU!