

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF INDIANA
INDIANAPOLIS DIVISION



Provided by:
Overhauser Law Offices LLC
www.iniplaw.org
www.overhauser.com

VANDOR GROUP, INC.,)	
)	
Plaintiff,)	
)	
v.)	No. 1:23-cv-00013-MPB-MG
)	
BATESVILLE CASKET COMPANY, LLC.,)	
BATESVILLE SERVICES, LLC,)	
)	
Defendants.)	
<hr/>		
)	
BATESVILLE SERVICES, LLC,)	
BATESVILLE CASKET COMPANY, LLC.,)	
)	
Counter Claimants,)	
)	
v.)	
)	
VANDOR GROUP, INC.,)	
)	
Counter Defendant.)	

ORDER ON MOTIONS FOR SUMMARY JUDGMENT AND MOTION TO EXCLUDE

This case concerns a patent infringement lawsuit filed by Plaintiff Vandor Group, Inc. ("Vandor") against Defendants Batesville Casket Company, LLC and Batesville Services, LLC (collectively, "Batesville") for patent infringement. Vandor's patents at issue—U.S. Patent No. 8,104,151 ("151 Patent"); 8,959,732 ("732 Patent"); 9,649,240 ("240 Patent"); and 10,098,801 ("801 Patent") (collectively, "Patents-in-Suit")—comprise a rectangular box made of cardboard that operates as a casket insert, with side and end walls that can be folded down to shrink the box into a more compact size. Vandor alleges that Batesville's cardboard insert that was sold for

thirteen years ("B-Insert") infringes Vandor's patents.¹ Batesville counterclaimed for declaratory relief, arguing that Vandor's Patents-in-Suit were invalid for obviousness under 35 U.S.C. § 103.²

Before the Court are: (1) Vandor's Motion for Partial Summary Judgment (Docket No. 91), (2) Vandor's Motion to Exclude Testimony (Docket No. 91), (3) Vandor's Motion to Strike, or, alternatively, for Leave to File a Surreply (Docket No. 117), and (4) Batesville's Cross-Motion for Summary Judgment (Docket No. 96). For the reasons set forth below, Vandor's Motion to Exclude Testimony (Docket No. 91) is **DENIED**, Vandor's Motion to Strike, or, alternatively, for Leave to File a Surreply (Docket No. 117) is **DENIED**, Vandor's Motion for Partial Summary Judgment (Docket No. 91) is **DENIED**, and Batesville's Cross-Motion for Summary Judgment (Docket No. 96) is **GRANTED**.

I. Background

A. Overview of the Products

Founded in 1884, Batesville is one of the leaders in the funeral industry, offering an array of burial and cremation products and services that assist families and licensed funeral professionals. (Docket No. 34 at ECF p. 15). On or around August 15, 2011, it launched the B-Insert, Docket No. 97-9 at ECF pp. 17–18), a device used when a deceased's family selects cremation over burial but still desires to have a viewing ceremony before cremation (Docket No. 27 at ECF pp. 5–6; Docket No. 92 at ECF p. 7). As an alternative to a traditional burial casket, some families who elect for cremation choose to use a rental casket, which enables the viewing of the deceased during the funeral service; however, the rental casket itself is not cremated. (Docket No. 27 at ECF p. 6). To work around that issue, the casket contains an "insert," *i.e.*, a

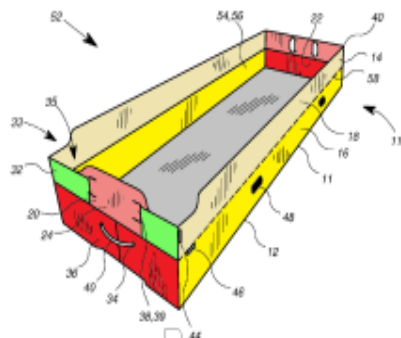
¹ Vandor alleges that Batesville infringed only the 732, 240, and 801 Patents. (Docket No. 11 at ECF pp. 4–21).

² Batesville also argued that the 732 and 801 Patents are invalid as indefinite under 35 U.S.C. § 112 and that, in any event, Batesville did not infringe any of the Patents-in-Suit. (Docket No. 99 at ECF p. 11).

carboard box that holds the deceased body for the viewing ceremony and, thus, is removed from the casket when it concludes, at which point the insert can be cremated with the deceased. (*Id.*).

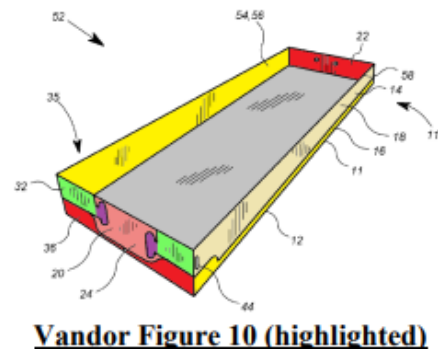
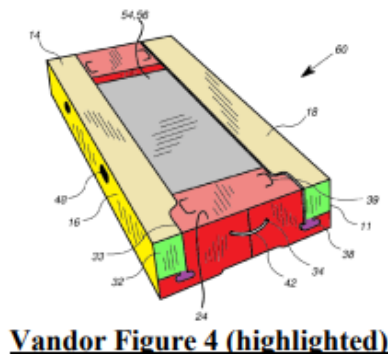
Before its invention was launched into the market, Vandor was a relatively smaller company that made parts for other casket manufacturers. (Docket No. 91-6 at ECF pp. 8–10). According to Vandor, the Patents-in-Suit created a "new paradigm" in the cremation industry. (Docket No. 92 at ECF p. 8). "The Patents-in-Suit cover a rental insert"—*i.e.*, cardboard box—that holds the deceased's body and is briefly placed into the rental casket. (Docket No. 27 at ECF p. 6). But, according to the specifications of the Patents-in-Suit, its "insert" can also be used as a "standalone" cardboard casket, and not only as an insert within a rental casket. (Docket No. 82-1 at ECF p. 127). Vandor admits that, before its invention, caskets were being constructed from "paper" materials, and such caskets were a "popular choice" for families choosing cremations, as they could be used for "presentation at a viewing and/or funerary service" before cremation. (Docket No. 82-1 at ECF p. 124). The advantage of its invention was that it was partially foldable, allowing for a reduced shipping profile and thus reduced costs. (*Id.*).

The following figures illustrate Vandro's cardboard casket and its respective functions. Figure 3 shows the general casket body, which is partially collapsible.



Vandor Figure 3 (highlighted)

(Docket No. 82-1 at ECF pp. 147, 125, 126). As shown by Figure 3, the casket body has a bottom panel (grey); two side panels with a lower side panel (16, bright yellow) and a foldable upper side panel (18, light yellow); and two end panels with each including a lower end panel (22, bright red) and a foldable upper end panel (24, light red). The body also has flaps (32, green) that extend laterally from the upper side panels, with tabs (38, purple below) that are inserted into the upper end panels to secure the box in its upright configuration. (*Id.* at ECF p. 125–26). The upper side panels can be folded inwardly towards the interior of the box, as shown in Figure 4, or outwardly from the interior of the box, as shown in Figure 10.



(Docket No. 11-1 at ECF pp. 6, 12).

B. Pre-Patent Conduct

On August 10, 2005, Vandor submitted a provisional patent application with the Patent and Trademark Office ("PTO") that would result in the 151 Patent—also known as the "parent" patent among the Patents-in-Suit. (Docket No. 82-1 at ECF p. 114). Yet on June 30, 2009, the PTO issued a Notice of Abandonment because Vandor's failed to meet a required deadline. (*Id.* at ECF p. 65). Over two years later, Vandor petitioned the PTO to reinstate its application. (*Id.* at ECF p. 108). Shortly later, the PTO granted the petition and revived the application on August

30, 2011.³ The PTO issued the 151 Patent on January 31, 2012. (*Id.* at ECF p. 114). In turn, it issued the "child" 732, 240, and 801 Patents to Vandor in 2015, 2017, and 2018, respectively. (Docket No. 11-1 at ECF p. 2; Docket No. 11-2 at ECF p. 2; Docket No. 11-3 at ECF p. 2).

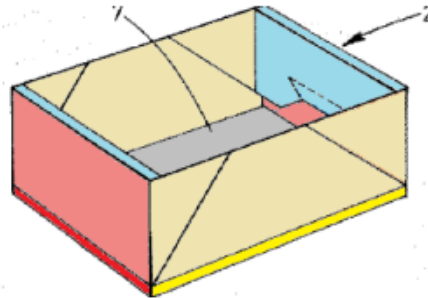
In 2008, Vandor provided a sample of its insert to Batesville for testing. (Docket No. 104-11 at ECF p. 3). Justin Gesell, an employee of Batesville, performed the testing and later requested that an outside vendor develop what would become the B-Insert. (Docket No. 104-14 at ECF 12–13). According to Vandor, this sample would have provided instruction sheets that included the notation "Domestic and International Patents Pending." (Docket No. 104-12 at ECF p. 5, 7). Batesville began its work on the B-Insert in late 2009 at the earliest. (Docket No. 97-9 at ECF pp.9–10). The B-Insert was introduced onto the market on or around August 15, 2011. (*Id.* at ECF pp.17–18). Thus, the B-Insert's launch took place before the Patents-in-Suit were issued.

C. Prior Art References

As of August 10, 2005 ("Priority Date") (Docket No. 82-1 at ECF p. 114), there were two key prior art references: Wood and Watson.

Issued in 2001, the Wood, U.S. Patent No. 6,317,943, describes a "box-like," "foldable" casket made from "carton board." (Docket No. 91-20 at ECF p. 9). It can be "collaps[ed] to adopt a relatively compact collapsed condition" or "erected to adopt a relatively upright erected condition." (*Id.*). Figure 2 (highlighted below) displays the Wood in its "erected" configuration.

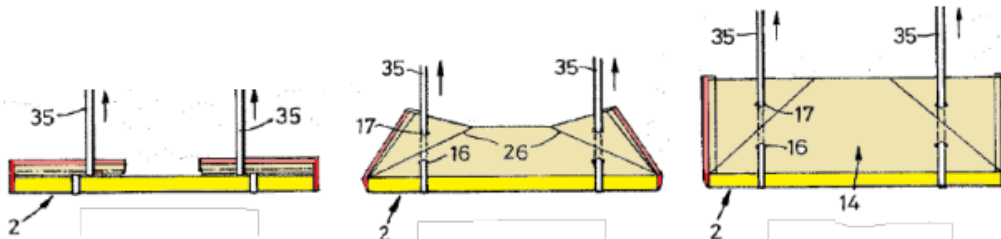
³ Vandor was recently granted leave to amend its responsive pleading to add a defense and counterclaim of "inequitable conduct." (Docket No. 120). The upshot of this request was that Vandor made a material misrepresentation in its petition to revive its abandoned application. (Docket No. 82 at ECF p. 3–8).



Wood Figure 2 (highlighted)

(*Id.* at ECF p. 4). The casket has a bottom, a pair of end panels, and a pair of side panels. (*Id.* at ECF p. 9).⁴ The side panels consist of a lower side panel (bright yellow) and an upper side panel (light yellow), and each end panels have a lower end panel (bright red) and an upper end panel (light red). (*Id.*; Docket Nos. 97-3 at ECF p. 39; 91-14 at ECF pp. 14, 32–33). The blue "extension tab" is folded inwardly over each end panel. (Docket No. 91-20 at ECF p. 10).

Figure 4 shows Wood from a side view in its collapsed configuration. Figures 5 and 6 display how the casket transforms from this collapsed to upright configuration of Figure 2.

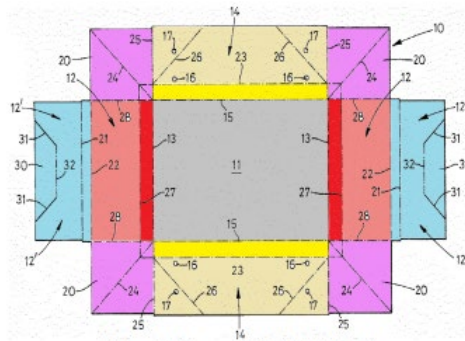


Wood Figures 4 (left), 5 (middle), and 6 (right) (all highlighted)

(*Id.* at ECF p. 6); (*see also id.* at ECF p. 9). Figures 5 and 6 show the upper side panels (light yellow) and upper end panels (light red) are folded down. They must be pulled up into an upright position to create the shape in Figure 2. (*See* Docket No. 91-15 at ECF pp. 36–41).

Figure 3 shows that, after the upper side panels and upper end panels are folded into their upright positions, "gussets" are used to maintain them in those respective positions.

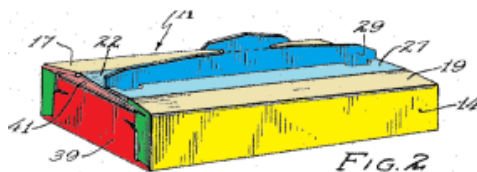
⁴ Wood refers to these as the "base," "first extensions," and "second extensions," respectively. (*Id.*).



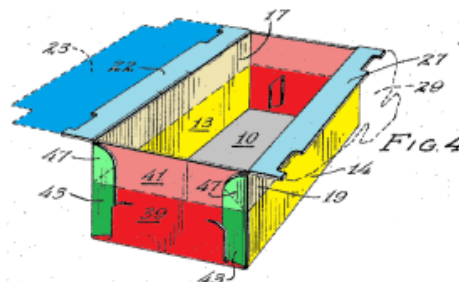
Wood Figure 3 (highlighted)

(Docket No. 91-20 at ECF pp. 5, 9). The gussets are the four corners (purple). As the upper side panels (light yellow) and upper end panels (light red) are folded into their upright state, each gusset is pinched around the crease line 24 and pulled inwardly, towards the interior of the box, to form a folded, inward-facing triangular panel. (Docket No. 91-15 at ECF p. 38). Once the side and end panels are in their upright configuration, the gussets are pressed up against the interior of the now-upright adjoining end panels. (*Id.* at ECF pp. 38–39). The blue extension tabs are then subsequently pulled down and secured over the gussets and adjoining end panels to hold them in a fixed, upright position. (*Id.* at ECF pp. 39–40).

Issued in 1967, the Watson, U.S. Patent No. 3,346,399, is a paperboard container for the packing and baking of dough. (Docket No. 91-21 at ECF pp. 3–5). Figures 2 and 4 show it in a partially collapsed (or closed) and upright (or open) configuration, respectively.



Watson Figure 2 (highlighted)

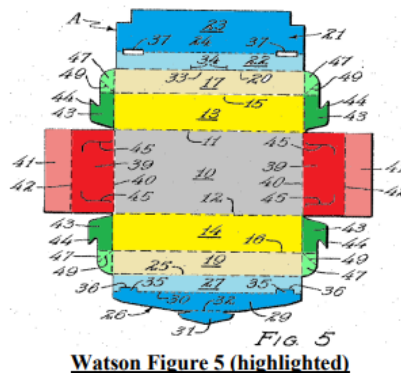


Watson Figure 4 (highlighted)

(*Id.* at ECF p. 3; *see also id.* at ECF p. 5). Both configurations serve different roles: the frozen dough is packed into the container in its collapsed state, but, given that dough expands when

baked, it also provides an upright condition to allow the dough room to rise during baking. (*Id.* at ECF p. 5). The Watson has a bottom panel, two side panels, and two end panels. Like Wood, each side panel consists of a lower side panel 14 (bright yellow) and an upper side panel 19 (light yellow), and each end panel has a lower end panel 39 (bright red) and an upper end panel 41 (light red). The lower side and end panels are in a fixed, upright position; the upper side and end panels alternates between vertically upright and horizontally collapsed. (*Id.* at ECF p. 3; Docket No. 91-15 at ECF pp. 41–42; Docket No. 91-14 at ECF pp. 14,32–34).

To hold the lower side and end panels in a fixed, upright position, Watson uses "corner flaps" 43 (dark green in Figures 2 and 4, respectively). These flaps extend from the lower side panels and have hooks that can be tucked into the slots in the lower end panels. (Docket No. 91-21 at ECF p. 6). As such, these hooks are not visible in Figures 2 and 4 because they have been inserted into the slots. Figure 5, however, indicates these hooks by number 44, which displays the flat paperboard "bank" from which the container is assembled.



(*Id.* at ECF p. 4). Watson also uses "corner flaps" 47 to keep the upper side panels and upper end panels in a fixed, upright position. These upper corner flaps (light green in Figures 2,4, and 5, respectively) are positioned right above the bottom corner flaps. (*Id.* at ECF p. 6).

At the heart of this dispute is Vandor's allegation that Batesville, through its B-Insert, infringed the Patents-in-Suit ("Asserted Claims"). (See Docket No. 97-2).⁵ It seeks partial summary judgment as to Patent 732 (Docket No. 91), whereas Batesville seeks summary judgment that *all* the Asserted Claims of the Patents-in-Suit are invalid. (Docket No. 96).

II. Legal Standards

A. Evidence Rule 702 and *Daubert*

Federal Rule of Evidence 702 and the United States Supreme Court's decision in *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579 (1993), govern the admissibility of expert testimony. "Whether proffered evidence is admissible at trial is a procedural issue not unique to patent law, and [the Federal Circuit] therefore reviews the district court's decision to admit expert testimony under the law of the regional circuit," which here, is the Seventh Circuit. *Summit 6, LLC v. Samsung Electronics Co., Ltd.*, 802 F.3d 1283, 1294 (Fed. Cir. 2015). Expert testimony is admissible under Rule 702 if technical or specialized knowledge "will assist the trier of fact to understand the evidence or to determine a fact in issue." And while *Daubert* construed a previous iteration of Rule 702, "it remains the gold standard for evaluating the reliability of expert testimony and is essentially codified in the current version" of the Rule. *Manpower, Inc. v. Insurance Co. of Penn.*, 732 F.3d 796, 806 (7th Cir. 2013). Under *Daubert*, a trial judge executes an essential gatekeeping function of evidence and is responsible for ensuring that proposed expert testimony "is not only relevant, but reliable." 509 U.S. at 589. In assessing the reliability of testimony, "the role of the court is to determine whether the expert is qualified in the relevant

⁵ Vandor alleges that Batesville infringes only the 732, 240, and 801 Patents. (Docket No. 11, Amended Complaint ("Compl.") at ECF pp. 4–21). Vandor's pre-suit letter also alleged that Batesville infringed the 151 Patent (Docket No. 34 at ECF p. 30), so Batesville included that patent in its counterclaim for a declaratory judgment of patent invalidity and non-infringement to "clear the air" with Vandor (Docket No. 99 at ECF p. 12 n. 2). As such, Vandor only alleges that Batesville willfully infringed three of the Patents-in-Suit: the 732, 240, and 801 Patents. (Compl. at ECF pp. 4–21). Thus, Vandor does not allege infringement of Patent 151, let alone willful infringement. (*Id.*). Instead, the 151 Patent is before the Court given Batesville's counterclaim for declaratory relief. (Docket No. 34).

field and to examine the methodology the expert has used in reaching his conclusions." *Smith v. Ford Motor Co.*, 215 F.3d 713, 718 (7th Cir. 2000). Relevant factors in this determination include, but not limited to, testing, peer review, error rates, and acceptance by the relevant expert community. *See Daubert*, 509 U.S. at 593–94. But reliability review is flexible and not all factors will apply in every case. *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 141 (1999).

An expert may be qualified by "knowledge, skill, experience, training, or education." Fed. R. Evid. 702. And while "extensive academic and practical experience" in an area is typically enough to be an expert, *Bryant v. City of Chicago*, 200 F.3d 1092, 1098 (7th Cir. 2000), "Rule 702 specifically contemplates the admission of testimony by experts whose knowledge is based on experience," *Walker v. Soo Line R. Co.*, 208 F.3d 581, 591 (7th Cir. 2000).

B. The Declaratory Judgment Act

Batesville's counterclaims seek a declaratory judgment as to the invalidity of the four Patents-in-Suit. The Declaratory Judgment Act ("Act") sets forth the following permissive standard: "In a case of actual controversy within its jurisdiction . . . any court of the United States, upon the filing of an appropriate pleading, *may declare* the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought." 28 U.S.C. § 2201(a) (emphases added). The "actual controversy" requirement in the Act "refers to the type of cases and controversies that are justiciable under Article III" of the Constitution. *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 127 (2007) (cleaned up). In patent cases, the Act can help provide "the allegedly infringing party relief from uncertainty and delay regarding its legal rights." *Goodyear Tire & Rubber Co. v. Releasomers, Inc.*, 824 F.2d 953, 956 (Fed. Cir. 1987). As such, "when deciding whether to exercise its discretion" under the Act, a district court should decide whether doing so would "serve the objectives for which the . .

. Act was created." *Micron Technology, Inc. v. Mosaid Technologies, Inc.*, 518 F.3d 897, 902 (Fed. Cir. 2008) (citing *Capo, Inc. v. Dioptics Med. Prods., Inc.*, 387 F.3d 1352, 1355 (Fed. Cir. 2004)). Thus, because a declaration as to patent invalidity would necessarily provide Batesville "relief from uncertainty and delay regarding its legal rights," *Goodyear Tire & Rubber Co.*, 824 F.3d at 956, the Court exercises its discretion under the Act to do so. 28 U.S.C. § 2201(a)

C. Summary Judgment

Summary judgement is appropriate if no genuine issues of material fact exist such that the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). At this stage, courts review the evidence in the light most favorable to the non-moving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986). This Court "can properly grant, as a matter of law, a motion for summary judgment on patent invalidity when the factual inquiries into obviousness present no genuine issue of material facts." *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1353 (Fed. Cir. 2013) (citation omitted). Obviousness is a legal question based on underlying facts, *Allergan, Inc. v. Sandoz, Inc.*, 726 F.3d 1286, 1290 (Fed. Cir. 2013)., and must be established by clear and convincing evidence. *Proctor & Gamble Co. v. Teva Pharm. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009). The burden of proof is thus placed on the challenger. *Plantronics*, 724 F.3d at 1353. Of course, the Court "can and should take into account expert testimony" addressing obviousness to the extent it "may resolve or keep open certain questions of fact." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007). But obviousness requires "a legal determination." *Id.* The key question on summary judgment, then, "is whether a jury applying the clear and convincing evidence standard could reasonably find, based on the evidence produced by the accused infringer, that the claimed invention was obvious." *Plantronics*, 724 F.3d at 1353. Thus, "because patents are presumed valid, a moving party seeking to invalidate a patent . . . must submit such

clear and convincing evidence of facts underlying invalidity that no reasonable jury could find otherwise." *TriMed, Inc. v. Stryker Corp.*, 608 F.3d 1333, 1340 (Fed. Cir. 2010) (cleaned up).

III. Discussion

A. Motion to Exclude Expert Opinion Testimony of Lawrence Dull

Vandor's Motion to Exclude Testimony (Docket No. 91) is premised on two grounds. First, Vandor asks this Court to exclude the lay witness testimony of Gary Cox, Gerald Davis, and Chad Eversole regarding infringement, invalidity, and constructions of the claims of the Patents-in-Suit as inadmissible under Rule 701. Second, Vandor seeks to exclude the expert testimony of Mr. Lawrence Dull as to the invalidity of Patent 732 as inadmissible under Rule 702. Because the Court only relies on the expert testimony of Mr. Dull, it will address the admissibility of his testimony alone.

Under the Rule 702 and *Daubert* framework, there is a three-part analysis: "the witness must be qualified as an expert by knowledge, skill, experience, training, or education, the expert's reasoning or methodology underlying the testimony must be scientifically reliable; and the testimony must assist the trier of fact to understand the evidence or to determine a fact in issue." *Ervin v. Johnson, Inc.*, 492 F.3d 901, 904 (7th Cir. 2007).

Vandor challenges that Mr. Dull's testimony and opinions are "based on insufficient and erroneous facts" and therefore "do not meet the reliability standards" under Rule 702. (*See id.* at ECF pp. 44. The premise of this unreliability argument is that Mr. Dull misunderstood features of the Wood and Watson and, thus, his testimony should be excluded as an expert. (*Id.* at ECF pp. 32–34). According to Vandor, Mr. Dull ultimately "did not understand the purpose of the fold line [49] of Watson" or "the function of Wood's end flaps [30]." (*Id.* at ECF p. 33). Even if that were true, it is well established as a matter of law that "mistakes and misunderstandings are not

grounds for excluding evidence [under *Daubert*]." *Endurance Capital, LLC v. Seneca Ins. Co., Inc.*, No. 1:21-cv-03015, 2023 WL 7159000, at *6 (S.D. Ind. Oct. 31, 2023) (citing *Daubert*, 509 U.S. at 596). At bottom, questions about misunderstandings are better suited for cross-examination and not resolved by a court as to reliability. *See Manes' Pharmacy, Inc. v. AmerisourceBergen Drug Corp.*, No. 2:22-cv-2186, 2024 WL 3510047, at *4 (W.D. Ark. July 23, 2024) ("If [a party] contends that [an expert] misunderstands or should have placed more emphasis on certain facts, those matters can be addressed through cross-examination.").

This Court's role under Rule 702 and *Daubert* is not "to decide whether an expert's opinion is correct," but instead is "limited to determining whether expert testimony is pertinent to an issue in the case and whether the methodology underlying that testimony is sound." *Smith*, 215 F.3d at 719; *see Kumho*, 526 U.S. at 159 (Scalia, J., concurring) (positing the trial court's role under *Daubert* is "to choose among *reasonable* means of excluding expertise that is *fausse* and science that is *junky*") (emphasis in original). Here, Vandor's challenge based on Mr. Dull's testimony as unreliable is flawed because it goes to the *weight* of the evidence, not its admissibility. *See Daubert*, 509 U.S. at 596 ("Vigorous cross-examination, presentation of contrary evidence, and careful instruction on the burden of proof are the traditional and appropriate means of attacking shaky but admissible evidence."). For this reason, Vandor's Motion to Exclude Testimony (Docket No. 91) is **DENIED**.

B. Validity and Obviousness

A hallmark feature of patent law is that "[a] patent shall be presumed valid" and "[t]he burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity." 35 U.S.C. § 282. As such, patent law requires "that the party asserting an invalidity defense must prove that defense by clear and convincing evidence." *Astell Pharma*,

Inc. v. Sandoz Inc., 117 F.4th 1371, 1377 (Fed. Cir. Sept. 18, 2024) (citing *Microsoft Corp v. I4I Ltd. P'ship*, 564 U.S. 91, 95 (2011)). In other words, a patent is not found "valid" because it is already presumed to be so. *See Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1569 (Fed. Cir. 1987) ("It is neither necessary nor appropriate for a court to declare a patent valid."). The Court's role in patentability challenges "does not require [the Court] to conclude whether something was or was not 'invented,' or whether the court subjectively considers the invention 'worthy' of patent protection." *Lindemann Mashinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1457 n.1 (Fed. Cir. 1984). Instead, the Court must "determine whether the patent's challenger carried the burden of establishing invalidity." *Id.*

To establish patent invalidity, the challenger must show "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103 (2010).⁶ The Supreme Court addressed the meaning of patentability under § 103 in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). *Graham* highlighted that, while the ultimate determination of obviousness is a *legal* conclusion, it is based on several underlying "factual inquiries," including: (1) "the scope and content of the prior art"; (2) "differences between the prior art and the claims at issue"; (3) "the level of ordinary skill in the pertinent art"; and (4) relevant "secondary considerations," including "commercial success, long felt but unsolved needs, [and] failure of others" *Id.* at 17–18. In addition, "whether one of skill in the art would have had a motivation to combine pieces of prior art in the way claimed by the patent is also a factual determination." *ZUP, LLC v.*

⁶ 35 U.S.C. §§ 103 was amended in 2011. *See* Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, § 3(b)–(c), 125 Stat. 284, 285–87 (2011). Thus, pre-AIA § 103 applies to the Patents-in-Suit, which have effective filing dates before March 16, 2023. *See* AIA, 125 Stat. at 293. Throughout this opinion, any reference to §102 or §103 refers to the pre-AIA versions of those statutes.

Nash Manufacturing, Inc., 896 F.3d 1365, 1371 (Fed. Cir. 2018). "The determination of obviousness is made with respect to the subject matter as a whole," not "separate pieces" of the invention." *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1086 (Fed. Cir. 2008). If these facts are "not in material dispute," and "the obviousness of the claim is apparent," then "summary judgment is appropriate." *KSR*, 550 U.S. at 427 (citing *Graham*, 383 U.S. at 17–18).

The Supreme Court instructs federal courts to employ an "expansive and flexible approach" when determining whether a patent was obvious at the time it was made under *Graham*'s multi-factor, analytical framework, *KSR*, 550 U.S. at 415, and avoid the gravitational pull towards "[r]igid preventative rules that deny factfinders recourse to common sense," *id.* at 421. "Neither the enactment of § 103 nor the analysis in *Graham* disturbed [the Supreme Court's] earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art." *Id.* at 415.

Two background legal principles provide this Court insight. First, when work is available in a field, "design incentives and other market forces can prompt variations of it, either in the same field or a different one." *Id.* at 417. Thus, § 103 will likely bar patentability in the event "a person of ordinary skill can implement a predictable variation." *Id.* Second, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices," the employment of that method "is obvious unless its actual application is beyond his or her skill." *Id.* Together, these principles help courts "ask whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* A court can also consider "the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 418. The nature of the art, too, may prove vital because mechanical arts—unlike chemical arts—are "predictable" arts, *Spectra-Physics, Inc. v.*

Coherent, Inc., 827 F.2d 1524, 1533 (Fed. Cir. 1987), and in cases involving predictable arts, the record "may more readily show a motivation to combine known elements to yield a predictable result, thus rendering a claimed invention obvious" *Rothman v. Target Corp.*, 556 F.3d 1310, 1319 (Fed. Cir. 2009). In short, these principles inform the following analysis of whether the Patents-in-Suit are obvious based upon the prior art of the Wood and Watson patents.

C. Obviousness in View of Prior Art

The first three *Graham* factors are analyzed in the following order: (1) the level of ordinary skill in the art; (2) the scope and content of the prior art; and (3) the asserted differences between the prior art and the Patents-in-Suit. 383 U.S. at 17; *see also KSR*, 550 U.S. at 407 (explaining that the district court may "reorder[] in any particular case" the "sequence" in which it considers the *Graham* factors). If Batesville succeeds in making a clear and convincing *prima facie* showing of obviousness, which "requires a motivation to select the references and to combine them in the particular claimed manner to reach the claimed invention," *Eli Lilly & Co. v. Zenith Goldline Pharmaceuticals, Inc.*, 471 F.3d 1369, 1379–80 (Fed. Cir. 2006), the burden will then shift to Vandor to rebut that showing with objective indicia of nonobviousness, *Ormco Co. v. Align Tech, Inc.*, 463 F.3d 1299, 1311 (Fed. Cir. 2006). Critically, the Court will not make an ultimate finding of obviousness—and, in that event—a finding of invalidity, until all record evidence of obviousness and nonobviousness has been reviewed. *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617 F.3d 1296, 1305 (Fed. Cir. 2010).

1. The Level of Ordinary Skill in the Art

In a patent case, obviousness is determined from the perspective of a hypothetical person of the ordinary skill in the art ("POSITA"). *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985). A POSITA is a "legal construct" that is "akin to the 'reasonable person' used

as a reference in negligence determinations," and "also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). "A person of ordinary skill [in the art] is also a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at 421. In assessing obviousness from the perspective of POSITA, a court may consider "the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 418. Determining what constitutes a POSITA is a unique factual question. *Alza Corp. v. Andrx Pharm.*, 603 F.3d 935, 940 (Fed. Cir. 2010).

Here, the level of ordinary skill in the art is undisputed. Batesville's expert, Mr. Dull, and Vador's expert, Dr. Marion Schafer, agree that a POSITA is someone who designs different types of cardboard containers for a wide range of uses. *See* (Docket No. 91-14 at ECF p. 9; Docket No. 91-15 at ECF p. 21). Mr. Dull explains that a POSITA would look to containers designed for other uses when designing a type of cardboard container. (Docket No. 91-14 at ECF p. 9). Dr. Schafer does not disagree. (*See generally* Docket No. 91-15 at ECF pp. 19–21). Thus, the Court finds there is no genuine issue of material fact as to the level of the ordinary skill in the art governing this action: Mr. Dull's description of a POSITA is reasonable and uncontested.

2. The Scope and Content of the Prior Art

In general, "prior art" in the obviousness realm is "technology already available to the public." *See OddZOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1402 (Fed. Cir. 1997) (quoting *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1453 (Fed. Cir. 1984)). Thus, prior art amounts to the publicly available material described in the novelty provision of the Patent Act, § 102(a), (e), (g), and (f). *See id.*; *see also Mass Engineered Design, Inc. v. Ergotron, Inc.*, 633 F.Supp.2d 361, 371 (E.D. Tex. 2009) (explaining that, "[i]n order for prior art to be used in combination to determine obviousness under 35 U.S.C. § 103, the alleged prior art

must first qualify as prior art" under the novelty provision of the Patent Act). The material described in the provision of § 102 encompasses patents and printed publications of all kinds available to the public before the date of the invention at issue, as well as prior use or knowledge that occurred in the United States before the date of the invention. *See* 35 U.S.C. § 102 (2010). Because the Patents-in-Suit relate back to the patent application filed by Vandor on the Priority Date, that serves as the proper reference point for prior art. (Docket No. 82-1 at ECF p. 114; Docket No. 11-1 at ECF p. 2; Docket No. 11-2 at ECF p. 2; Docket No. 11-3 at ECF p. 2).

(a) Scope of the Prior Art

The first issue is whether the Wood and Watson serve as analogous prior art references, and thus fall within the scope of the problem sought to be solved by a POSITA. Batesville defines the general problem as follows: the B-Insert was designed to address the issue of designing a foldable cardboard casket with two configurations, one of which enables a compact shipping profile. (Docket No. 91-14 at ECF pp. 12–13). Vandor seems to object to this framing on the theory that Batesville relies on hindsight "to solve a problem that did not exist at the *time* the invention was made." (Docket No. 105 at ECF p. 28) (emphasis added).⁷ But it does not appear to object to whether Wood or Watson are, in fact, analogous prior art references.

The Federal Circuit uses "two separate tests [to] define the scope of analogous art: '(1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.'" *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1379 (Fed. Cir. 2019) (quoting *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004)). Thus, prior art is not rigidly confined to the specific field of

⁷ Vandor's argument about hindsight will be addressed in greater depth in Section III(D)(2) because it primarily concerns whether a POSITA would have been motivated to combine these analogous prior art references.

invention at issue, but rather may extend broadly to fields rationally related to the general issue facing the inventor. *See In re ICON Health & Fitness*, 496 F.3d 1374, 1379–80 (Fed. Cir. 2007) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.") (citing *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992)); *In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006) ("References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.") (citing *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992)). Stated differently, "familiar items may have obvious uses *beyond* their *primary* purposes." *KSR*, 550 U.S. at 420 (emphases added). Thus, the problem helps define the scope of the prior art.

Applying the prior art jurisprudence to this case yields a clean answer: Wood and Watson are analogous prior art references within the scope of the general problem with which a POSITA would be involved in solving. First, the Patents-in-Suit relate back to a provisional patent application filed by Vandor on the Priority Date in August 2005. (Docket No. 82-1 at ECF p. 114). Both Wood (issued in 2001) and Watson (issued in 1967) existed as of the Priority Date. *See* 35 U.S.C. § 102; (Docket No. 91-20 at ECF p. 3; Docket No. 91-21 at ECF p. 5). Thus, Wood and Watson at least qualify as "prior art" under the Patent Act, § 102(a), (e), (g), (f).

Second, the Wood and Watson qualify as analogous prior art references. Wood indeed falls within the ambit of the first test—"the same field of endeavor." *Airbus S.A.S.*, 941 F.3d at 1379. It has a foldable "box-like" casket made of "carton board," and its casket can be "collaps[ed] to adopt a relatively compact collapsed condition" or "erected to adopt a relatively upright erected condition." (Docket No. 91-20 at ECF p. 9). Wood's casket also has a bottom, a pair of end panels, and a pair of side panels. (*Id.*). Batesville's expert observes a POSITA would

have considered the Wood an analogous prior art reference in facing this problem. (Docket No. 91-14 at ECF p. 12). Vandor's expert does not disagree, but rather takes issue with the supposed motivation to combine Wood with Watson, a subsidiary issue addressed below. (*See* Docket No. 91-15 at ECF pp. 45–53). Thus, there is no genuine issue of material fact that a POSITA tasked with designing a cardboard casket with two configurations would have found Wood to be an analogous reference within the "same field" of casket-making. *Airbus S.A.S.*, 941 F.3d at 1379.

Watson, on the other hand, comes within the sweep of the second test—"the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *Id.* It describes a paperboard container for the packing and baking of dough. (Docket No. 91-21 at ECF p. 5). This container has an upright configuration and a partially collapsed configuration. (*Id.* at ECF p. 3). The frozen dough is packed into the container in its collapsed configuration; and because the dough expands when baked, Watson provides an upright configuration to give it enough room to rise during baking. (*Id.* at ECF p. 5). Once more, Batesville's expert observes that a POSITA would have considered Watson an analogous prior art reference for the general problem at hand. (Docket No. 91-14 at ECF p. 12). Vandor's expert does not appear to disagree with that conclusion. (*See* Docket No. 91-15 at ECF pp. 45–53). Thus, there is no genuine issue of material fact as to whether a POSITA tasked with designing a cardboard casket with two configurations would have found Watson to be an analogous prior art reference that was "reasonably pertinent" to the problem at hand. *Airbus S.A.S.*, 941 F.3d 1379.

(b) Content of the Prior Art

Batesville argues there is no genuine issue of material fact that Wood and Watson taught the basic, general concept of a cardboard box with partially collapsible side and end panels. (Docket No. 99 at ECF p. 32). Vandor does not appear to challenge those general teachings but

takes issue with whether Watson taught away certain modifications, or whether a POSITA would have been motivated to combine certain references. (Docket No. 105 at ECF p. 22–23). The Court will address those fine distinctions in the prior art,⁸ but first concludes that there is no genuine issue of material fact about the basic, general concept taught by Wood and Watson.

Before addressing the key factual disputes between the parties about teaching away and the motivation to combine—both subsidiary inquiries within the broader *Graham* analysis—the Court must first address a minor disagreement about the content of the prior art: whether Wood or Watson teach, or render obvious, lower end walls in a fixed upright position. Vandor presses this argument and argues Batesville cannot make this showing.⁹ On reply, Batesville expresses its confusion with this line of argument. This Court will, in turn, give this argument airtime.

To recap, Watson describes a paperboard container for packing and baking dough. (Docket No. 91-21 at ECF p. 5). This container has an upright configuration and a partially collapsed configuration, as shown in Figures 4 and 2, respectively. (*Id.* at ECF pp. 3, 5). Yet in both configurations, the lower end panels (highlighted in bright red) are in a *fixed*, upright position. (Docket No. 99 at ECF p. 19). Vandor argues that, as Figures 6 and 7 of Watson illustrate, the lower side panels are "angled outwardly in the baking configuration to

⁸ Batesville identifies its expert report, which contained a detailed "claims chart" explaining, for each Asserted Claim, how each element of that claim is taught in the prior art. (*See* Docket No. 91-14 at ECF pp. 1985–2015). It thus confines its summary judgment briefing to "the specific claim elements that Vandor's expert suggests are missing from the prior art." (Docket No. 99 at ECF p. 32 n.9). In turn, Vandor engages with Batesville's arguments about the teaching of the prior art. (Docket No. 105 at ECF pp. 23–27). Out of respect for the "principle of party presentation," this Court will "rely on the parties to frame the issues for decision." *United States v. Sineneng-Smith*, 590 U.S. 371, 375 (2020); *see also* *Castro v. United States*, 540 U.S. 375, 386 (explaining the adversarial system "is designed around the premise that [parties represented by competent counsel] know what is best for them, and are responsible for advancing the facts and argument entitling them to relief") (Scalia, J., concurring in part, concurring in judgment). Thus, this Court will confine its analysis to the parties' summary judgment briefing about the genuine issues of material fact about the prior art teachings pertaining to the patent claims and will not address arguments or claims that have not been identified as genuine issues of material fact.

⁹ While Vandor mentions both Wood and Watson in its heading on this argument, it only discusses *Watson*. (Docket No. 105 at ECF p. 33–34). The Court will review only this argument. *Sineneng-Smith*, 590 U.S. at 375.

accommodate the desired shape of the loaf of bread," and thus it, "does not teach the lower end panels that are fixed in position." (Docket No. 105 at ECF p. 34). Vandor argues that Batesville cannot show that claims 1, 2, 5 of the 151 Patent; claims 13 and 15 of the 240 Patent; and claims 12-14 and 17 of the 801 Patent would have been obvious at the time of the invention. (*Id.*).

In Vandor's expert report, however, Dr. Schafer explicitly concluded that *Wood*—not *Watson*—"does not include a lower end panel extending vertically upward from the bottom panel that is fixed in position." (Docket No. 91-15 at ECF pp. 75, 80, 84). Nowhere in Dr. Schafer's report does he mention that *Watson* does not teach, or render obvious, lower end walls in a fixed, upright position as required by some Asserted Claims here. (*Id.*). And even if *Watson's* lower end panels may slightly move when the bread dough in the container expands during baking (Docket No. 105 at ECF p. 34), that does not necessarily mean *Watson* does not teach the general, basic use of lower end walls that are in a fixed, upright position that could be used in another, repurposed context, such as a collapsable casket insert. Accordingly, there is no genuine issue of material fact that *Watson*, as a prior art reference, taught lower end walls in a fixed, upright position as required by some Asserted Claims. (Docket No. 91-21 at ECF pp. 3, 5)

3. The Differences Between the Prior Art and the Patents-in-Suit

Under the Patent Act, a patent is obvious if the "differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a) (2010) (emphases added); *see also Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 717 (Fed. Cir. 1991) (explaining that courts must not "unduly focus on one facet of the claimed invention"). While "the claim should be considered as a whole," the "differences between the claim and the prior art need to be identified to place the

obviousness analysis into proper perspective." *Id.* At any rate, the Federal Circuit has stated that "[f]ocusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness." *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 724 (Fed. Cir. 1990) (citing *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987)). Once the key asserted differences between the prior art and claimed invention—or lack thereof—are properly ascertained, the obviousness analysis then centers on the ultimate legal question: "whether these differences are such that the claimed invention *as a whole* would have been obvious to one of ordinary skill in the art at the time the invention was made." *Gardner v. TEC Sys.*, 725 F.2d 1338, 1345 (Fed. Cir. 1984) (emphasis in original).

Here, the analysis starts with commonalities between the prior art and the Patents-in-Suit. As shown in Figure 3 of the patents, Vandor's casket body is a partially collapsible cardboard box that includes a bottom panel; two *side* panels, each of which includes a *lower* side panel and a *foldable upper* side panel; and two *end* panels, each of which includes a *lower* end panel and a *foldable upper* end panel. (Docket No. 82-1 at ECF pp. 117, 125, 126); (Docket No. 99 at ECF p. 14). Vandor's casket body also has flaps that extend laterally from the upper side panels. (Docket No. at 82-1 at ECF pp. 125–26); (Docket No. 99 at ECF p. 14). Both Wood and Watson share each of these elements. (Docket No. 91-20 at ECF p. 4); (Docket No. 91-21 at ECF p. 3). In short, there is no genuine issue of material fact as to these common features at play.¹⁰

¹⁰ In its "Material Facts in Dispute" section, Vandor claims these features are materially disputed. (Docket No. 105 at ECF p. 8). But it never develops an argument for *why* they are materially disputed. Thus, any dispute as to them is waived. See *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) (explaining that "mere disagreements . . . as to the existence of factual disputes do not amount to a developed argument").

According to the parties, the key differences coalesce around two main features between the Watson and Patents-in-Suit: (1) the upper side panels and (2) upper corner flaps. (*See* Docket No. 99 at ECF pp. 25–26; Docket No. 105 at ECF p. 23). In turn, the Court will address both.

The first difference is the folding of the upper side panels. Figure 10 shows Vandor's upper side panels are folded *outwardly* when the box is in its collapsed configuration, (Docket No. 11-1 at ECF p. 12), whereas Wood and Watson's drawings show the upper side panels are folded *inwardly*, towards the interior of the container, (Docket No. 91-20 at ECF p. 6; Docket No. 91-21 at ECF p. 3). Yet Watson still allows outward folding to a certain degree. (*See* Docket No. 91-21 at ECF p. 5) (explaining one of its features "resides in the fact that the carton is so constructed that the outward folding of the upper portions of the side and end walls is limited."). This "limited feature" enables "the upper portions of the side and end walls" to "be forced into vertical position by the raising of the dough, thus insuring (sic) a properly shaped loaf." (*Id.*).

The second difference is the use of upper "corner flaps" with the inclusion of tabs/hooks. Unlike Vandor's rental insert, Watson's "corner flaps" (47) do not have tabs/hooks that can be inserted into the upper end panels to keep the upper half of the container *upright* and thus removed from the upper panels to *collapse* it. (Docket No. 91-15 at ECF p. 67). Dr. Schafer testifies that Watson's corner flaps essentially are "gussets," because, to move the container into its collapsed state, each upper corner flap (47) is folded onto itself along a diagonal crease line (49) in Figure 5. (Docket No. 91-15 at ECF p. 43); (Docket No. 97-3 at ECF pp. 35–36).

Reviewed cumulatively, there are no genuine issues of material fact as to the key differences between the prior art and the Patents-in-Suit: the folding feature of the upper side panels and the use of tabs/hooks in the upper corner flaps. To the extent there *is* lingering disagreement, it would concern whether Watson's "corner flaps" (47) are properly characterized

as "gussets," as suggested by Vandor's expert (Docket No. 91-15 at ECF p. 43), even though Watson explicitly refers to them as "corner flaps." (Docket No. 91-21 at ECF p. 6). To be sure, Batesville presses that Watson's corner flaps should be referred to as such, even though they "might be more appropriately described as gussets." (Docket No. 99 at ECF p. 34). Regardless of the label, this difference is immaterial to the obviousness analysis for the reasons that follow. The Court will refer to Watson's upper corner flaps interchangeably as "flaps" and "gussets." Thus, there are no genuine issues of *material* fact that the parties agree as to the key differences at play.

D. Subsidiary Inquiries

Subsumed within the *Graham* analysis are two subsidiary inquiries: (1) whether the prior art references *taught away* the claimed invention, and (2) whether a POSITA would have been *motivated to combine* those references to produce the claimed invention. The motivation to combine is a condition that must be satisfied to establish obviousness, *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007), whereas the teaching away of a prior art is a factor that can, but will not necessarily, foreclose a finding of obviousness, *In re Mouttet*, 686 F.3d 1322, 1333 (Fed. Cir. 2012). The Court must determine if there is a genuine issue of material fact as to whether the prior art "teaches away from the claimed invention, and whether it motivates a combination of teachings" from its references. *In re Fulton*, 391 F.3d at 1199–1200.

1. Prior Art Teaching Away from Claimed Invention

Vandor argues that Batesville's combination of prior art references requires modifying Watson in a way that renders Watson "unsuitable for its intended purpose." (Docket No. 105 at ECF p. 23). Thus, Watson "teach[es] away" from the Patents-in-Suit. (*Id.* at ECF p. 24). Not so.

The touchstone for determining obviousness, according to the Supreme Court, is predictability. *KSR*, 550 U.S. at 416 ("The combination of familiar elements according to known

methods is likely to be obvious when it does no more than yield predictable results."). Indeed, the "predictable result" outlined in *KSR* "refers not only to the expectation that prior art elements are capable of being physically combined, but also that the combination would have worked for its intended purpose." *DePuy Spine, Inc. v. Medtronic Sofamor Danek*, 567 F.3d 1314, 1326 (Fed. Cir. 2009). In other words, "when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR*, 550 U.S. at 417 (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)). The inverse is true "if the prior art indicated that the *invention* would not have worked for *its* intended purpose or otherwise taught away from the invention." *DePuy Spine*, 567 F.3d at 1326 (emphases added); *see also United States v. Adams*, 383 U.S. 39, 52 (1966) (upholding a finding of nonobviousness where prior art references teaching away claimed invention would "deter any investigation into such a combination").

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be *discouraged* from following the path set out in the reference, or would be led in a direction *divergent* from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (emphases added). To determine if "the prior art teaches away from the claimed invention is a question of fact." *Spectralytics, Inc. v. Cordis Corp.*, 649 F.3d 1336, 1343 (Fed. Cir. 2011). Of course, the relative "degree of teaching away" depends on the facts of a case, but "a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 F.3d at 553; *see also Baxter Int'l, Inc. v. McGaw, Inc.*, 149 F.3d 1321, 1328 (Fed. Cir. 1998) (finding no teaching away where nothing in the prior art suggested the claimed invention at issue was unlikely to work). A prior art reference will also teach away "from a combination

when using it in that combination would produce an inoperative result." *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007); *see also In re Sponnoble*, 405 F.2d 578, 587 (CCPA 1969) (references taken in combination teach away since they would produce a "seemingly inoperative device"). The flip side is also true: a prior art reference will not teach away if does not "criticize, discredit, or otherwise discourage the solution claimed." *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). While a finding of teaching away may be a "significant factor" in favor of nonobviousness, *In re Gurley*, 27 F.3d at 553, "there is no rule that a single reference that teaches away will mandate a finding of nonobviousness." *Adapt Pharma Operations Limited v. Teva Pharmaceuticals USA, Inc.*, 25 F.4th 1354, 1371 (Fed. Cir. 2022).

Instead, courts must examine the *entire* teaching of the prior art—not just teachings that may be suitable for certain uses. *In re Applied Materials, Inc.*, 692 F.3d 1289, 1298 (Fed. Cir. 2012), ("A reference must be considered for everything that it teaches, not simply the described invention or a preferred embodiment.") (citing *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985)). Thus, "[o]n the issue of obviousness, the combined teachings of the prior art as a whole must be considered." *EWP*, 755 F.2d at 907. While a prior art reference may indicate a certain combination is unsuitable for its *own* purposes, the reference can nonetheless teach that combination if it remains suitable for the claimed invention. *See In re Kahn*, 441 F.3d at 990 ("[T]he teaching of [a reference] is not limited to the specific invention disclosed."); *see also In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983) (explaining "[t]he use of patents as references is not limited to what the patentees described as their own inventions") (cleaned up).

Vandor primarily contends that Batesville's modification requires modifying Watson in a way that renders Watson unsuitable for its *original* purpose. (Docket No. 105 at ECF p. 23). Specifically, Vandor advances two arguments: first, modifying the container such that the

extensions (17, 19) of the upper side panels fold outwardly and downwardly instead of inwardly would "necessarily destroy the corner flaps (47) of Watson, since the gusseted configuration is designed" to limit "the side wall extensions from folding outwardly and downwardly." (*Id.* at ECF p. 26) (citing Docket No. 91-21 at ECF p. 5; Docket No. 91-15 at ECF p. 59). Second, replacing the corner flaps (47) with tabs/hooks would render it "incapable of performing its intended purpose" of "holding bread dough and, when opened, permitting the dough to rise during baking and cooking." (*Id.*) (citing Docket No. 91-21 at ECF p. 5). But whether these proposed modifications would render Watson unsuitable for its intended purpose is beside the point because a prior art reference can still teach a combination if it remains suitable for the *claimed invention*. See, e.g., *Kahn*, 441 F.3d at 990; *In re Heck*, 699 F.2d at 1333. Nonetheless, whether Watson teaches away these proposed modifications must be examined.

It is true that Watson could teach away these features—and thus obviate a POSITA's motivation to combine its references—if a POSITA "would be discouraged from following the path set out in the [Watson] or would be led in a direction divergent from the path that was taken by [Vandor]." *Gurley*, 27 F.3d at 553. But it does not. Instead, Watson's teaching blazes a broad path for a POSITA to follow and does not teach away Batesville's proposed use of upper side panels that fold outwardly and the replacement of gussets with upper corner flaps that contain tabs/hooks enabling the casket to go from its partially collapsed state into a fully upright state.

For starters, it is undisputed that Wood and Watson taught the basic concept of a cardboard box with partially collapsible side and end panels. And Watson's foldable container uncontestably taught two configurations—an upright configuration and a collapsed configuration for shipping. (Docket No. at 91-21 at ECF pp. 3, 5). Watson also taught the use of "corner flaps" to hold the *lower* side and end panels in a fixed upright position. These lower corner flaps (43)

extend from the lower side panels and have hooks that can be tucked into slots in the lower end panels. (Docket No. 91-21 at ECF p. 6). In addition, Watson uses corner flaps (47) (or gussets) to keep the *upper* side panels and upper end panels in a fixed upright position. (*Id.*). But Batesville's modest proposed modifications would not require diverging from Watson's general teachings, but rather would enable suitable changes within the broad path already laid forth by Watson.

Watson taught the basic concept that its upper side panels could be folded outwardly. (Docket No. 91-21 at ECF p. 5). True, its outward folding feature was "limited" for its intended purpose of holding frozen bread dough and, when opened, permitting the dough to rise during baking and cooking and thus producing "a properly shaped loaf." (*Id.*). Equally true: folding this feature outward, as proposed by Batesville, would *frustrate* Watson's original aim by destroying the gusseted configuration in the corner flaps 47 of the Watson. (*Id.* at ECF p. 6). But that does not necessarily teach away the general outward folding feature for another purpose, such as allowing an unobstructed view of the deceased body in a casket. (Docket No. 11-1 at ECF p. 13). Dr. Schafer agrees: to satisfy a design for a casket with a viewing option, the upper side panels could be folded outwardly to avoid issues with the body. (Docket No. 97-3 at ECF pp. 48–49) ("[y]ou would not want them to go inwardly" because "[i]f you had them fold inwardly, not only would it be difficult to get the flaps back up, but it would be contaminated by [the] body [and] bodily fluids, and that would be undesirable as well"). Thus, while Watson's limited outward folding feature served a purpose of securing "a properly shaped loaf" (Docket No. 91-21 at ECF p. 5), there is no evidence that Watson "criticize[s], discredit[s], or otherwise discourage[s] the solution" sought by the Patents-in-Suit, *Fulton*, 391 F.3d at 1201, and thus taught away its use. Watson, as a prior art reference, is "not limited to what the patentees described" in it. *In re Heck*, 699 F.2d at 1333. On these facts, Watson did not teach away this proposed change.

Watson also did not teach away the replacement of gussets with upper "corner flaps" having hooks/tabs. To begin, Watson already taught that the type of flap could be used to connect, and secure in position, the *lower* sections of the side and end panels of the container. (Docket No. 91-21 at ECF p. 3). And Dr. Schafer conceded that using "flaps" in the *upper* corner of such a container would, in fact, enable the container to transform from its partially collapsed state into an upright state. (Docket No. 97-3 at ECF pp. 46–47). True, he did not explicitly mention the use of "tabs/hooks" on such flaps. (*See id.*). But regardless, if the flaps—with or without tabs/hooks—followed Watson's general teaching and produced a functioning invention with two configurations, it would not be taught away. *In re Gurley*, 27 F.3d at 553; *Baxter Int'l, Inc.*, 149 F.3d at 1328 (nothing in the prior art suggested the claimed invention at issue was unlikely to work). Here, Batesville's modification would execute the same function of enabling a casket to change from its partially collapsed state into an upright state by connecting and securing in position (or releasing) the foldable upper sections of the side panels and end panels. (*See* Docket No. 97-3 at ECF pp. 46–47). In short, Dr. Schafer's critique that such a design would not be the "best" or "optimal" solution (Docket No. 97-3 at ECF p. 47) is ultimately irrelevant to whether Watson taught away its use, *In re Gurley*, 27 F.3d at 553, because it can still teach a combination if it remains suitable for the claimed invention. *See, e.g., Kahn*, 441 F.3d at 990; *In re Heck*, 699 F.2d at 1333. And, since there is no evidence that Watson "criticize[d], discredit[ed], or otherwise discourage[ed]" the use of flaps with tabs/hooks, *Fulton*, 391 F.3d at 1201, Watson did not teach away this proposed change.

To be sure, Watson was designed for the initial purpose of packing and baking dough (Docket No. 91-21 at ECF p. 5), which perhaps reflects its "preferred embodiment." *In re Applied Materials, Inc.*, 692 F.3d at 1298. The parties do not dispute that original aim. Yet, at the

same time, a POSITA "cannot be assumed to ignore [Watson] because it is primarily directed to a specific patent application *different* from the application claimed in the patent at issue." *Raytheon Co. v. Sony Corp.*, 2017-1554, 2017-1556, 2017-1557, 727 Fed. App'x. 662, 667 (Fed. Cir. April 2, 2018) (emphasis added). That would make "little sense" under the obviousness jurisprudence. *See KSR*, 550 U.S. at 420–21 ("The idea that a designer hoping to make an adjustable electronic pedal would ignore Asano because Asano was designed to solve the constant ratio problem makes little sense."). Rather, "[c]ommon sense teaches . . . that familiar items may have obvious uses *beyond their primary purposes*, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 420 (emphases added). Vandor fails to show that Watson would have "discouraged" a POSITA from following Watson's general teachings that taught two configurations—a partially collapsible position and a fully upright one—or led a POSITA "in a direction divergent" from its path that had foldable upper side panels with corner flaps. *In re Gurley*, 27 F.3d at 553. And there is no evidence that such proposed modifications would render the Patents-in-Suit inoperable rather than less efficient or less desirable. *See Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016) ("Although modification of the movable blades may impede the quick change functionality disclosed by Caterpillar, '[a] given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.'). Rather, these changes yield "no more than one would expect from such an arrangement." *KSR*, 550 U.S. at 417. Accordingly, there is no genuine issue of material fact: Watson did not teach away these proposed modifications.

2. Motivation to Combine Prior Art References

Even if the prior art references do not teach away the claimed invention, the Court must still consider whether "a skilled artisan *would* have been motivated to combine the teachings of the prior art references to achieve the claimed invention." *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007) (emphasis added). The question of whether a POSITA would have been motivated to combine prior art references is fact-dependent question that implicates two *Graham* factors. *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1290 (Fed. Cir. 2006) ("[T]he motivation to combine requirement entails consideration of both the scope and content of the prior art and level of ordinary skill in the pertinent art aspects of the *Graham* test.").

Underlying this inquiry is the sound assumption that "a skilled artisan is a person of ordinary creativity with common sense, common wisdom, and common knowledge." *Elektta Limited v. ZAP Surgical Systems, Inc.*, 81 F.4th 1368, 1374 (Fed. Cir. 2023). Once again, the Supreme Court eschewed "rigid preventative rules" for the obviousness inquiry, *KSR* 550 U.S. at 421, and instead adopted a more "expansive and flexible approach" to determine whether a patented invention was obvious at the time it was made, *id.* at 415. Within this flexible approach, *see KSR*, 550 U.S. at 421 ("[Supreme Court] cases have set forth an expansive and flexible approach" to the obviousness question), is a focus on common sense, which "can be a source of reasons to combine or modify prior art references to achieve the patented invention." *Plantronics*, 724 F.3d at 1354 (citing *KSR*, 550 U.S. at 420). In addition, the motivation to combine prior art may be located "explicitly or implicitly in market forces; design incentives; the interrelated teachings of multiple patents; any need or problem known in the field of endeavor at the time of invention and addressed by the patent; and the background knowledge, creativity, and common sense of the person of ordinary skill." *Plantronics*, 724 F.3d at 1354 (cleaned up).

The role of expert testimony regarding motivation to combine, although helpful, and in some cases necessary, is not required to support a determination of obviousness where the technology is "easily understandable." *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1240 (Fed. Cir. 2010) (citing *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1330 (Fed. Cir. 2009)). Moreover, in appropriate cases, expert testimony regarding motivation to combine, even if present, "will not necessarily create a genuine issue of material fact." *Id.* at 1239 (citing *KSR*, 550 U.S. at 427, 127 S. Ct. 1727). In cases where "the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors, summary judgment is appropriate." *KSR*, 550 U.S. at 427. Thus, in the appropriate case where the technology in question is easily understandable and the content of prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, the determination of obviousness may include "recourse to logic, judgment, and common sense, in lieu of expert testimony." *Wyers*, 616 F.3d at 1239 (citing *Perfect Web*, 587 F.3d at 1329; *Ball Aerosol & Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009)).

It is also a well-established principle of patent law that "an obviousness determination does not always require prior art to expressly state a motivation for every obvious determination." *Eletka Limited v. ZAP Surgical Systems, Inc.*, 81 F.4th 1368, 1374 (Fed. Cir. 2023) (citing *Fleming v. Cirrus Design Corp.*, 28 F.4th 1214, 1223 (Fed. Cir. 2022)). The Supreme Court and Federal Circuit each have "repeatedly held that the motivation to modify a prior art reference to arrive at the claimed invention need not be the *same* motivation that the patentee had." *Alcon Research, Ltd. v. Apotex, Inc.*, 687 F.3d 1362, 1368 (Fed. Cir. 2012) (emphasis added); *KSR*, 550 U.S. at 420 (stating that it is error to look "only to the problem the

patentee was trying to solve"). To that flexible end, federal circuit precedent also "does not require that the motivation be the *best* option, only that it be a *suitable* option from which the prior art did not teach away." *Par Pharm, Inc., v. TWi Pharms., Inc.*, 773 F.3d 1186, 1197–98 (Fed. Cir. 2014) (emphasis in original) (citations omitted); *see also Norvatis Pharms. Corp. v. West-Ward Pharms., Int'l Ltd.*, 923 F.3d 1051, 1059 (Fed. Cir. 2019) (explaining that precedent does not "require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide motivation for the current invention").

The gravamen of the parties' dispute hinges on whether a POSITA would have been motivated to combine features from the Wood and Watson to design the Patents-in-Suit. Batesville argues that there is no genuine issue of material fact pertaining to three main points. First, a POSITA would have been motivated to adapt a container having Watson's basic structure for use as a casket. Second, a POSITA would have been motivated to modify Watson's upper side panels so that they could be folded outward for viewing purposes. Third, a POSITA would have been motivated to replace the upper corner flaps with flaps containing tabs/hooks. (*Id.*). Vandor counters that adopting Watson as a casket would be "[i]neffective at reducing the shipping volume," (Docket No. 105 at ECF p. 20) and that Batesville's obviousness argument is premised "solely on hindsight." (*Id.* at ECF p. 33). Each of these arguments are addressed in turn.

First, Batesville argues that a POSITA would have been motivated to adapt a container with Watson's basic structure, which has a bottom panel enclosed by side and end panels that could be folded approximately in half, for the repurposed use of a foldable casket. Of course, Wood already taught the use of a foldable container as a casket. (Docket No. 91-20 at ECF p. 9). But, as Batesville's expert explained, a "POSITA would have been motivated by the need to create a corrugated board casket having two configurations to allow for a reduced shipping

volume" given the "well known" opportunity for "cost savings in shipping containers." (Docket No. 91-14 at ECF p. 12). And Watson specifically disclosed "an expandable container design to save half the space during storage and shipping." (*Id.* at ECF p. 13). According to Batesville's expert, a POSITA would have been motivated to combine Wood and Watson to produce a casket with Watson's basic structure given its two configurations, including one for reduced shipping volume. (*Id.*). As such, using Watson would thus allow a POSITA to "offer the same type of benefit" offered in Wood—that is, "the capacity to be folded into a more compact size in order to reduce shipping costs." (Docket No. 99 at ECF p. 33).

In response, Vador's expert disagrees that a POSITA would have been motivated to adapt Watson's design for use as a casket because Wood already addressed the need for a foldable casket with a "reduced shipping volume." (Docket No. 91-15 at ECF pp. 47). He also contends that Watson "produces [a] 'relatively compact collapsed condition' that is inferior to Wood's compact collapsed condition," and, in particular, offers only about a 40% reduction in size in the collapsed condition in comparison to Wood's approximately 80% reduction in size. (*Id.* at ECF p. 46). Vador seizes on that testimony and argues a "POSITA looking to achieve a reduced shipping volume would not have looked to the Watson design, which does a far inferior job of achieving that goal, to improve on the Wood casket." (Docket No. 105 at ECF p. 22).

Reviewing the parties' arguments, the Court finds that a POSITA would have been motivated to adapt Watson's design for use as a casket to offer a compact size to reduce shipping costs. While Vador's expert disagrees, that disagreement cannot be used to manufacture a genuine issue of material fact. Common sense about this relatively understandable technology suggests otherwise. *Wyers*, 616 F.3d at 1239. Vador's central critique on this point is that a POSITA would have lacked motivation to adapt Watson's container because, as adapted, it would

have "provide[d] no improvement" over Wood's casket. (Docket No. 105 at ECF p. 21). But that premise clashes directly with Federal Circuit precedent which abstains from imposing such a high bar. *See, e.g., Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1381 (Fed. Cir. 2023) (explaining that the patent challenger "never had to show" that replacing an element from a first prior-art reference with a similar element from a second reference "was an 'improvement' in a categorical sense"). In other words, the patent challenger did not have to show that a POSITA would be motivated to produce the "*best* option, only that it be a suitable option from which the prior art did not teach away." *Par Pharm, Inc.*, 773 F.3d at 1197–98 (emphasis in original) (citations omitted); *see also Norvatis Pharms. Corp.*, 923 F.3d at 1059 (explaining that precedent does not "require that a particular combination must be the preferred" combination for the claimed invention). Nothing in Vandor's expert report disputes that Watson would not have been a "suitable" option for addressing the need of having a cardboard casket with compact shipping configurations. Thus, there is no genuine issue of material fact that a POSITA would have been motivated to adapt a container using Watson's basic structure as a foldable casket.

Second, Batesville argues that a POSITA would have been motivated to modify Watson such that, in adopting Watson's container as a casket, "its upper side panels . . . could be folded outwards, away from the center of the casket," to circumvent "interfering with viewing of the body when folded." (Docket No. 99 at ECF p. 34). As shown in Vandor's Figure 10, the upper side panels of the box are folded outwardly and downwardly when the box is in its collapsed configuration, while Watson's and Wood's drawings show the upper side panels being folded inwardly towards the interior of the container. (*Compare* Wood, Docket No. 91-20 at ECF p. 4 and Watson, Docket No. 91-21 at ECF p. 3, *with* Vandor, Docket No. 11-1 at ECF p. 12). As such, a POSITA designing a foldable cardboard casket would have been motivated to construct a

cardboard casket with a viewing feature. For example, the "Background of the Invention" section in the Patents-in-Suit admits that, as of the Priority Date, paper-based caskets were often used "for presentation at a viewing and/or funerary service." (Docket No. 11-1 at ECF p. 13).

Accordingly, a POSITA would have been motivated to construct a cardboard casket in such a manner to allow the body to be viewed in an unobstructed way. Dr. Schafer agrees. (*See* Docket No. 97-3 at ECF pp. 48–49) ("[y]ou would not want them to go inwardly" because "[i]f you had them fold inwardly, not only would it be difficult to get the flaps back up, but it would be contaminated by [the] body [and] bodily fluids, and that would be undesirable as well").

Undeterred by this evidence, Vandor hangs its hat on another theory: Batesville impermissibly relies on "hindsight" because this modification would not have been obvious before the Priority Date of the Patents-in-Suit because, before that date, no one in the industry would have recognized the need to have a *rental insert* with outwardly folding sides. (Docket No. 105 at ECF pp. 27–31). According to Vandor, the need for this type of rental insert did not arise until Vandor introduced a new rental casket with an "adjustable bed mechanism." (*Id.* at ECF p. 29). Rather, this "new rental casket shell" with an "elevating bed mechanism" that "allowed the head and upper torso of the deceased to be raised for easy viewing," according to Vandor, introduced a "new paradigm." (Docket No. 92 at ECF pp. 8–9). Part of this new paradigm also included "rollers to facilitate loading and unloading" of the cardboard inserts into the rental casket; and a "wider interior" that accommodated a greater range of body types. (*Id.*). Vandor contends that it solved a problem that had not yet been discovered in the marketplace—that is, the need "for a reduced height to enable viewing when the head portion of the deceased was raised in Vandor's adjustable bed rental casket." (Docket No. 105 at ECF pp. 29–30).

Therefore, Batesville's obviousness conclusion on this point is purportedly premised "on the existence of a problem yet unknown in the art at the time of the invention." (*Id.* at ECF p. 30).

Hindsight bias is prohibited as a matter of patent law. *See* 35 U.S.C. § 103 (2010) (prescribing that obviousness is measured "at the time the invention was made"); *see also KSR*, 550 U.S. at 422 (explaining that factfinders "should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning"). Indeed, obviousness may be established "by noting there existed at the *time of the invention* a known problem for which there was an obvious solution encompassed by the patent's claims." *Id.* at 419–20 (emphases added). But none of this makes a material difference for Vandor—who advances a red herring argument—because Batesville is arguing that a POSITA would have adapted Watson's container not simply as a rental insert within a rental casket, but rather as a *standalone* cardboard casket. (Docket 99 at ECF pp. 12–13; Docket No. 114 at ECF p. 7). In fact, the Asserted Claims are not confined to rental inserts. Rather, the specification of the Patents-in-Suit explains that it can just as easily be employed as a "standalone" cardboard casket. (Docket No. 82-1 at ECF p. 124). And before Vandor's invention, caskets were being constructed from several different materials, including "paper materials," such that paper-based caskets were a "popular choice" for families choosing cremation; moreover, these types of caskets were often deployed for "presentation at a viewing and/or funerary service" before cremation. (*Id.*). As Batesville points out, the proper question is whether a POSITA would have been motivated to change the Watson container such that its upper sides could be folded outwards for such purposes. The answer, based on this record, is, yes. Accordingly, there is no genuine issue of material fact that a POSITA would have been motivated to modify the Watson container to enable its upper side panels to fold outwardly.

Third, Batesville argues that a POSITA would have been motivated to replace the corner gussets with flaps containing tabs/hooks. On this point, Vandor mainly challenges this modification as being taught away from the prior art reference because it would render Watson "unsuitable" for its original purpose. (*See* Docket No. 105 at ECF pp. 23–27). The key challenge to whether a POSITA would have been motivated to replace Watson's gussets with corner flaps containing tabs/hooks is found in a footnote. (*Id.* at ECF p. 28 n.79). Nonetheless, the evidence points the Court in a clear direction: Vandor's expert conceded that using upper corner "flaps" would have been an "obvious" option in a range of options for designing a container that was partially collapsible. (Docket No. 97-3 at ECF pp. 46–47). His main qualification was that using upper corner flaps would not be the "best" or "optimal solution." (*Id.* at ECF p. 47). But that is beside the point: Batesville need not show the motivation be the "*best*" option, only that it be a *suitable* option" from which the Watson "did not teach away." *Par Pharm, Inc.*, 773 F.3d at 1197–98 (emphasis in original); *Norvatis Pharms. Corp.*, 923 F.3d at 1059 (same). And here, Vandor's own expert admits that using flaps to enable the casket container to go from its partially collapsed state into its fully upright state would be a suitable "option" in a range of options for effecting such a design. (Docket No. 97-3 at ECF pp. 46–47). If flaps with tabs/hooks would execute that function, a POSITA would have been motivated to use them. Accordingly, there is no genuine issue of material fact that a POSITA would have been motivated to replace Watson's gussets with upper corner flaps with tabs/hooks.

Having found no genuine issue of material fact as to the three factors under *Graham* and its subsidiary inquiries, the Court must now determine whether objective indicia of nonobviousness exists, and then determine whether the Patents-in-Suit would have been obvious to a POSITA under § 103.

E. Objective Indicia of Nonobviousness

As established, Batesville has clearly and convincingly made a *prima facie* showing of obviousness. *See Eli Lilly & Co.*, 471 F.3d at 1379–80 (Fed. Cir. 2006) ("[T]o establish a *prima facie* case of obviousness based on a combination of elements in the prior art, the law requires a motivation to select the references and to combine them in a particular claimed manner to reach the claimed invention."). But "[a] nonmovant may rebut a *prima facie* showing of obviousness with objective indicia of nonobviousness." *Ormco Corp.*, 463 F.3d at 1311 (citation omitted). "If all of the factual disputes regarding the objective evidence resolve in favor of [plaintiff], it has presented a strong basis for rebutting the *prima facie* case [of obviousness]." *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617 F.3d 1296, 1305 (Fed. Cir. 2010). As such, this Court must "consider any objective evidence of nonobviousness presented" by Vandor, *id.*, before making a finding that the Patents-in-Suit were "obvious" and therefore finding such patents "invalid on those grounds," *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litigation*, 676 F.3d 1063, 1075 (Fed. Cir. 2012).

The inquiry into objective indicia of nonobviousness requires a court to consider several auxiliary factors "such as commercial success of the invention, satisfying a long-felt need, failure of others to find a solution to the problem at hand, and copying of the invention by others." *Pro-Mold & Tool Co., Inc. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1572 (Fed. Cir. 1996). Objective evidence, in effect, protects "against slipping into use of hindsight and to resist the temptation to read into the prior art the teachings of the invention in issue." *Graham*, 383 U.S. at 36 (cleaned up). "Obviousness requires a court to walk a tightrope blindfolded (to avoid hindsight)—an enterprise best pursued with the safety net of objective evidence." *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1379 (Fed. Cir. 2012). Yet such "secondary considerations" do

not determinatively control the question of obviousness. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988), *cert. denied*, 493 U.S. 814 (1989). Indeed, where the undisputed evidence clearly and convincingly establishes obviousness based on the primary considerations, summary judgment is appropriate even if the face of "strong" evidence of secondary considerations that favor the patent holder. *ZUP, LLC v. Nash Mfg.*, 896 F.3d 1365, 1374 (Fed. Cir. 2018); *see also Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997) ("In reaching an obviousness determination, a trial court may conclude that patent claim [was] obvious, even in the light of strong objective evidence tending to show nonobviousness."). Indeed, *KSR* affirmed summary judgment on the basis of obviousness in the face of evidence that the invention in question was commercially successful. 550 U.S. at 412–13. While these considerations are labeled "secondary," they are not relegated to a "secondary status." *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litigation*, 676 F.3d at 1078.

Here, Vandor makes three arguments on nonobvious grounds. First, its product was commercially successful. Second, Batesville "deliberately copied the features" of its design. (Docket No. 105 at ECF p. 33). Third, Batesville cannot show "why, if the patented invention were so obvious, no one considered the inventors' solution obvious at the time of the invention." (*Id.*). Batesville takes issue with each point.

1. Commercial Success

"A nexus must be established between the merits of the claimed invention and evidence of commercial success before that evidence may become relevant to the issue of obviousness." *Solder Removal Co. v. U.S. Intern. Trade Comm'n*, 582 F.2d 628, 637 (C.C.P.A. 1978). Here, Vandor cites evidence of the "[s]ales of the products embodying" the Patents-in-Suit. (Docket No. 105 at ECF p. 32). At first glance, the evidence cited by Vandor—the number of rental

inserts sold and the revenue generated—"provides a very weak showing of commercial success, if any." *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996); *see also Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026–27 (Fed. Cir. 1985) (finding sales of 5 million units represents a minimal showing of commercial success because "[w]ithout further economic evidence . . . it would be improper to infer that the reported sales represent a substantial share of any definable market"). Simply put, evidence of raw sales data—without more—is "insufficient to establish commercial success." *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991); *see also Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151 (Fed. Cir. 1983) (finding of obviousness was not erroneous where evidence of commercial success consisted only of number of units sold and where no evidence of nexus). At bottom, Vandor delivers no helpful evidence of "market share, of growth in market share, of replacing earlier units sold by others," or anything providing context of the economic landscape. *Id.* Accordingly, Vandor has failed to rebut Batesville's *prima facie* showing of obviousness through its reliance on evidence pertaining to its invention's alleged commercial success.

2. Copying

"It is well established that copying by a competitor is a relevant consideration in the objective indicia analysis." *Liqwd, Inc. v. L'Oreal USA, Inc.*, 941 F.3d 1133, 1137 (Fed. Cir. 2019). It thus "may be evidence that the patented invention is nonobvious." *Id.* (citing *Vandenberg v. Dairy Equip. Co.*, 740 F.2d 1560, 1567 (Fed. Cir. 1984)). Indeed, "copying may often be the most probative and cogent evidence of nonobviousness." *Advanced Display Sys. v. Kent State Univ.*, 212 F.3d 1272, 1285 (Fed. Cir. 2000) (cleaned up); *Windsurfing Int'l, Inc. v. AMF, Inc.*, 782 F.2d 995, 1000 (Fed. Cir. 1986), *cert. denied*, 477 U.S. 905 (1986) (reasoning that "copying the claimed invention, rather than one in the public domain, is indicative of non-

obviousness"). At its most elemental form under patent law, copying "requires duplication of features of the patentee's work based on access to that work, lest all infringement may be mistakenly treated as a copying." *Institut Pasteur & Universite Pierre Et Marie Curie v. Focarino*, 738 F.3d 1337, 1347–48 (Fed. Cir. 2013).

In *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, the Federal Circuit held that "copying requires the replication of a *specific product*." 392 F.3d 1317, 1325 (Fed. Cir. 2004) (emphases added). Cases following *Iron Grip Barbell* have similarly reaffirmed the principle that "similarities between an issued patent and an accused product do not, on their own, establish copying." *Liqwd, Inc.*, 941 F.3d at 1137; *see also Wyers v. Master Lock Co.*, 616 F.3d 1231, 1245–46 (Fed. Cir. 2010) (holding that the patent owner failed to establish copying despite its contention that "competitors' copying and marketing of convertible shank hitch pin locks shortly after the invention's existence became known supports a finding of nonobviousness"). The principles of patent infringement and copying, too, are distinguishable: "Not every competing product that arguably falls within the scope of a patent is evidence of copying; otherwise, 'every infringement suit would automatically confirm the nonobviousness of the patent.'" *Id.* at 1246 (quoting *Iron Grip Barbell*, 392 F.3d at 1325). That said, the Federal Circuit has held that "access to an *issued patent* coupled with circumstantial evidence regarding changes to a competitor's design is sufficient to support copying." *Liqwd, Inc.*, 941 F.3d at 1138 (emphases in original); *see also DePuy Spine*, 567 F.3d at 1328–29 (holding that the defendant's early attempts at one design together with the "prompt adoption of the claimed feature soon after the patent issued, are relevant indicia of nonobviousness") (citing *Graham*, 383 U.S. at 17–18).

On this point, Vandor argues that "Batesville deliberately copied the features" of its design. (Docket No. 105 at ECF p. 33). Vandor merely incorporates by reference its copying

argument from its argument section contending Batesville *willfully infringed* the Patents-in-Suit, a separate legal question about intent underlying supposed infringement. (Docket No. 105 at ECF pp. 39–43). Typically, such arguments "not appropriately developed in a party's briefing may be deemed waived." *CardSoft v. Verifone, Inc.*, 769 F.3d at 1119. Still, because Vandor argues that Batesville *deliberately* copied its design, it may find some compatibility with its willful infringement argument, since "willfulness requires deliberate or intentional infringement." *Bayer Healthcare LLC v. Baxalta*, 989 F.3d 964, 988 (Fed. Cir. 2021). In that spirit, the Court will import Vandor's more developed copying theory—and its cited evidence—from its willfulness argument section and apply it under the nonobviousness rubric to see if, in fact, Batesville engaged in copying.

To begin, Vandor argues that Batesville copied Vandor's "patented rental casket insert" in designing the B-Insert. (Docket No.105 at ECF p. 40). Yet that assertion is mugged by reality.¹¹ The undisputed facts show the following: Vandor filed its provisional application (that later resulted in the 151 Patent) on August 10, 2005. (Docket No. 82-1 at ECF p. 114). On June 30, 2009, the PTO issued a Notice of Abandonment advising Vandor that, given its failure to meet a mandatory deadline, the agency rendered the application abandoned. (*Id.* at ECF p. 65). Vandor did not petition the PTO to reinstate the abandoned application until August 12, 2011. (*Id.* at ECF pp. 108–09). The application did not issue as the parent patent—the 151 Patent—until January 31, 2012. (*Id.* at ECF p. 114). The "child" 732, 240, and 801 Patents issued to Vandor in 2015, 2017, and 2018, respectively. (Docket No. 11-1 at ECF p. 2; Docket No. 11-2 at ECF p. 2; Docket No. 11-3 at ECF p. 2). Batesville, on the other hand, did not begin its design work on the

¹¹ In this section, Vandor consistently refers to its "patented product." (Docket No. 105 at ECF p. 39–40). But at the time Batesville reviewed this product in 2008, the product was *not patented*. (Docket No. 82-1 at ECF p. 1222).

B-Insert until late 2009 at the earliest. (Docket No. 97-9 at ECF pp. 10). Its commercial launch occurred on or around August 15, 2011. (*Id.* at ECF pp. 17–18). In other words, it is undisputed on this record that Vandor had no issued patents on its rental insert product *before* Batesville introduced the B-Insert onto the market—full stop. Thus, even if Vandor could show that Batesville copied parts of Vandor's product, this would be insufficient to establish a specific intent by Batesville to infringe Vandor's *non-existent* patent rights. *Cf. Liqwd, Inc.*, 941 F.3d at 1038 (explaining that "access to an *issued patent*" combined with existing "circumstantial evidence" about modifications to a competitor's design was enough to support a finding of copying) (emphases added); *see also DePuy Spine*, 567 F.3d at 1328–29 (holding that initial attempts at one design combined with the "prompt adoption of the claimed feature soon *after the patent issued*, are relevant indicia of nonobviousness") (emphases added).

Instead, Vandor relies on another argument: evidence of pre-patent copying. Vandor suggests Batesville knew that Vandor's patent application was pending in 2008 when one of Batesville's employees, Justin Gesell, reviewed the insert. (Docket No. 104-11 at ECF p. 3). The Court, however, is not convinced that Batesville had sufficient knowledge of the product's pending status when Vandor provided a sample of its rental insert to Batesville for testing. Vandor asserts that, when providing this sample, it would have included instruction sheets that included the generic notation "Domestic and International Patents Pending." (Docket No. 104-12 at ECF pp. 5, 7). But this notation did not specify any patents or applications of the 732, 240, and 801 Patents. Indeed, the earliest of those patents would not issue until 2015—*seven* years later. (Docket No. 11-1 at ECF p. 2). Yet even if the notation in Vandor's 2008 instructions could have conferred *knowledge* to Batesville of Vandor's application for the 151 Patent, which was still pending before the PTO, that is still not enough on this record to establish evidence of copying.

Vandor suggests there is more to the story. After reviewing the product, Mr. Gesell instructed an outside vendor to develop the B-Insert in a manner that was pre-assembled but also compact. (Docket No. 104-14 at ECF pp. 12–13). According to Vandor, "[t]he evidence shows the only casket insert that Batesville was aware of at the time, which was both partially collapsible and shipped substantially assembled, was Vandor's . . . rental casket insert." (Docket No. 105 at ECF p. 40). Yet Vandor does not cite *any* evidence in the record for this point. It just says so without explanation. And even if Vandor was correct that its rental insert was the "only" rental insert on the market with these features, that is not enough to establish that Batesville copied Vandor's *specific* product. *Iron Grip Barbell*, 392 F.3d at 1325 ("copying requires the replication of a specific product"); *Liqwd, Inc.*, 941 F.3d at 1137 ("similarities between an issued patent and accused product do not, on their own, establish copying"). Nevertheless, Vandor's assertion also belies the reality that the general features in the B-Insert—partial collapsibility and capacity to be shipped in a substantially assembled state—had already existed for years in other products, such as the Wood and Watson. (Docket No. 91-20 at ECF p. 9; Docket No. 91-21 at ECF pp. 3–5). Despite this fact, Vandor concludes that it is a "reasonable inference" that Batesville directed the vendor to "copy" the product's features. (Docket No. 105 at ECF p. 40). Simply put, without more evidence in this record, this Court cannot find this evidence amounts to a copying of its product. As such, Vandor does not provide enough evidence to establish objective indicia of nonobviousness that would overcome Batesville's *prima facie* case.

The central legal question at summary judgment "is whether a jury applying the clear and convincing standard could reasonably find," based on the evidence of obviousness and nonobviousness in the record, "that the claimed invention was obvious." *Plantronics*, 724 F.3d at 1353. Batesville has successfully put forth "clear and convincing evidence of facts underlying

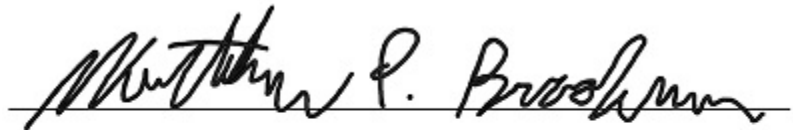
invalidity that no reasonable jury could find otherwise." *TriMed, Inc.*, 608 F.3d at 1340. Because the Patents-in-Suit when viewed as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made, the 151 Patent, the 732 Patent, the 240 Patent, and the 801 Patent are invalid pursuant to 35 U.S.C. § 103(a). Thus, given these legal conclusions regarding the validity of the four Patents-in-Suit, Vandor's remaining allegations of patent infringement against Batesville fail as a matter of law.

IV. Conclusion

For the foregoing reasons, the 151 Patent, 732 Patent, 240 Patent, and the 801 Patent, are invalid as obvious under § 35 U.S.C. 103(a). Vandor's Motion to Exclude Testimony (Docket No. 91) is **DENIED**, Vandor's Motion to Strike, or, alternatively, for Leave to File a Surreply (Docket No. 117) is **DENIED**, Vandor's Motion for Partial Summary Judgment (Docket No. 91) is **DENIED**, and Batesville's Cross-Motion for Summary Judgment as to the Invalidity of the 151 Patent, 732 Patent, 240 Patent, and 801 Patent (Docket No. 96) is **GRANTED**. Final judgment shall issue by separate entry.

IT IS SO ORDERED.

Dated: November 20, 2024

A handwritten signature in black ink, reading "Matthew P. Brookman", is written over a horizontal line.

Matthew P. Brookman, Judge
United States District Court
Southern District of Indiana

Distribution:

Travis W. Baxter
MAGINOT, MOORE & BECK LLP
twbaxter@maginot.com

Arlene L. Boruchowitz
Dinsmore & Shohl
arlene.boruchowitz@dinsmore.com

Luca Lee Hickman
Dinsmore & Shohl LLP
luca.hickman@dinsmore.com

Oleg Khariton
Dinsmore & Shohl, LLP
oleg.khariton@dinsmore.com

Harold C. Moore
MAGINOT, MOORE & BECK LLP
hcmoore@maginot.com

Brian S. Sullivan
DINSMORE & SHOHL LLP
brian.sullivan@dinsmore.com

Michael A. Swift
Maginot, Moore & Beck LLP
maswift@maginot.com

Daniel D. Trachtman
Dinsmore & Shohl LLP
daniel.trachtman@dinsmore.com