

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOWARD INDUSTRIES, INC.

Petitioner,

v.

CAPSA SOLUTIONS LLC

Patent Owner.

Case IPR2023-01274

U.S. Patent No. 7,594,668

PATENT OWNER'S PRELIMINARY RESPONSE

UNDER 37 C.F.R. § 42.107

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EX. #	EXHIBIT DESCRIPTION
2001	Declaration of Ben-Tzvi in Support of Patent Owner’s Response to ’668 and ’650 IPR Petitions.
2002	US Pat. 6,721,178 to Clark, which is a continuation of the Clark reference cited by Petitioner.
2003	Office Action Response of 3/28/2012 in ’650 Patent File History at pgs. 8-12 (the entire OAR is attached).
2004	Dkt. 45-2, Declaration of Ben-Tzvi (in support of Patent Owner’s claim construction brief from on-going litigation).
2005	Dkt. 47-1, Declaration of Ben-Tzvi (in support of Patent Owner’s reply claim construction brief from on-going litigation).
2006	Declaration of James Kwak, with Attachment A (email from Howard counsel agreeing to the definition of “compartment(s)” proposed by Patent Owner in the parallel litigation).
2007	’650 File History, Notice of Allowance, 5/14/2012.
1004	Declaration of Mr. Ronald B. Kemnitzer (“Kemnitzer”) (filed by Petitioner with Petition for <i>Inter Partes</i> Review)
1012	<i>Capsa Solutions LLC v. Howard Indus. Inc.</i> , No. 2:22-cv-00065-HSOBWR, Dkt. 42-1, Joint Claim Construction Chart (S.D. Miss Apr. 26, 2023) (filed by Petitioner with Petition for <i>Inter Partes</i> Review)
1029	Howard Industries, Inc.’s Preliminary Claim Construction Brief, <i>Capsa Solutions LLC v. Howard Indus. Inc.</i> , No. 2:22-cv-00065-HSOBWR, Dkt. 46, (S.D. Miss May 26, 2023) (filed by Petitioner with Petition for <i>Inter Partes</i> Review)
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1031	Capsa’s Preliminary Claim Construction Brief, <i>Capsa Solutions LLC v. Howard Indus. Inc.</i> , No. 2:22-cv-00065-HSO-BWR, Dkt. 45, (S.D. Miss May 26, 2023) (filed by Petitioner with Petition for <i>Inter Partes</i> Review)
1032	Capsa’s Preliminary Claim Construction Reply Brief, <i>Capsa Solutions LLC v. Howard Indus. Inc.</i> , No. 2:22-cv-00065-HSO-BWR, Dkt. 47,

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US Pat. No. 7,594,668

Dkt. No. CAP2491-144

	(S.D. Miss June 16, 2023) (filed by Petitioner with Petition for <i>Inter Partes</i> Review)
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I. Introduction

Patent Owner, Capsa Solutions LLC (hereinafter also “Capsa” or “Patent Owner”), hereby provides a Preliminary Response under 35 U.S.C. § 313 and 37 CFR § 42.120 to the Petition for *Inter Partes* Review filed on August 3, 2023 (hereinafter also the “Petition”) by Petitioner, Howard Industries, Inc. (hereinafter also “Howard” or “Petitioner”). The Petition submitted by Howard requests *inter partes* review and cancellation of claims 3-4 of US Pat. No. 7,594,668 (hereinafter also “the ’668 Patent”), entitled “Medical cart, medication module, height adjustment mechanism, and method of medication transport”. The earliest priority date listed on the face of the ’668 Patent is February 24, 2003¹.

A. Statement of the Relief Requested

Patent Owner respectfully requests that the Board deny all of the grounds for unpatentability asserted by Petitioner and refuse to institute *inter partes* review of the ’668 Patent. Pursuant to 37 CFR § 42.108, institution of *inter partes* review should be refused in this case because the Petition submitted by Petitioner fails to demonstrate a reasonable likelihood that any of the claims of the ’668 Patent challenged in the Petition are unpatentable. At a minimum, the Board should exercise its discretion to deny institution of *inter partes* review.

¹ While the effective filing date of the ’668 Patent is not stipulated at this stage, the Petition does not turn on the assigned priority date. *E.g.*, Petition at pg. 2, fn 1.

B. Summary of Patent Owner's Argument

Petitioner waited more than 14 months after the filing of the Complaint in the underlying litigation between the parties to file its IPR Petition. More peculiar, Petitioner seeks an IPR on a patent that expires in less than one year from the filing date of the IPR Petition based on the same prior art (Clark) and substantially the same arguments overcome during the original prosecution of the Patents-at-issue.

The claimed invention provides a mobile medical cart station with enhanced ergonomics for nurses and other medical staff. *E.g.*, '650 Patent, Abstract. Prior to the '650 and '668 patents, no one in the industry had invented a mobile medical cart with height adjustable compartments and work surface(s) as part of a unified, compact work platform as recited in the claims at-issue or knew how to realize the same. *See* '668 Patent, claims 3, 4. Although carts with height adjustable work surfaces and keyboard trays (*e.g.*, workstations for computers) were known, these known carts lacked enclosed storage compartments (*e.g.*, for storing medications and medical supplies) that are also adjustable in height. Because these carts have to be mobile and light enough for nurses to easily move them around a hospital, nobody in the industry, prior to the '668 and '650 Patents, knew how to integrate relatively heavy compartments, and stored items within them, into a height adjustable work platform without sacrificing mobility, stability and weight constraints. In other words, the prior art carts did not have the stability to support compartments into a

height adjustable workstation, especially if the compartments were raised up to higher positions – they would be prone to toppling over from the top-heavy arrangement. Ex. 2001, Decl. of Ben-Tzvi, para. 12.

The inventors of the '668 Patent were the first to use the height adjustment mechanism as support for a compact work platform *including compartments*, allowing the compartments to be adjustable in height so nurses and other healthcare providers do not have to constantly bend over to obtain items stored in the compartments. The inventors of the '668 Patent were also the first to realize such a cart by placing the height adjustment mechanism at the rear of the work platform, thereby freeing up space for compartments to be “*disposed in* the portion of the work platform that projects from the height adjustment mechanism in the forward direction” as recited in the claims at issue. Configuring the inventive cart in this specifically claimed fashion allows the cart to be more compact with a lower center of gravity unlike the top-heavy carts of the Clark and Reeder references relied upon by Petitioner which, especially if modified as proposed by Petitioner, would result in an unstable and especially top-heavy configuration. The Patent Office agreed with this reasoning during the prosecution of the related '650 Patent in overcoming the Clark reference. Ex. 2001, Decl. of Ben-Tzvi, para. 13.

Contrary to the conclusory allegations made by Petitioner, the Petition fails to raise a *prima facie* case of obviousness as none of the cited references, including the

primary references of Clark and Reeder, teach or suggest all of the limitations of the claims at-issue, because no articulated reasons are provided as to why a PHOSITA would modify the cited references to reach the claimed inventions, and because there would be no reasonable expectation of success in modifying the primary reference of Clark and Reeder as proposed. For example, Petitioner provides no reasons as to why a PHOSITA would modify the carts of Clark or Reeder to dispose compartments in a forward-projecting portion of the height adjustable work platform or any evidence that there would be a reasonable expectation of success in this regard – instead mistakenly assuming that these references teach such claim elements. Petitioner’s failure to articulate a motivation to combine or modify the references to reach these limitations is enough basis, in and of itself, for denying the Petition (although Patent Owner herein responds with reasons why a PHOSITA would not have such motivation, such rebuttal is unnecessary when it is Petitioner’s burden to establish a *prima facie* case of obviousness). Ex. 2001, Decl. of Ben-Tzvi, para. 14. *Eli Lilly & Co. v. Teva Pharm. Int’l GmbH*, 8 F.4th 1331, 1348 (Fed. Cir. 2021) (finding it is the Petitioner’s burden to proving obviousness, including a motivation to combine or modify references with a reasonable expectation of success, and that burden never shifts to the Patent Owner).

Additionally, the Petition should be denied because the Petitioner makes substantially the same arguments made and overcome during prosecution. As

discussed in more detail throughout this response, the Clark reference (relied upon Petitioner as a primary reference) was effectively cited during the original prosecution and was overcome. Clark is cited on the face of the '668 Patent and an equivalent² was extensively discussed and overcome during prosecution of the related and co-challenged '650 Patent. Top-heavy carts of Clark (and now Reeder) were overcome during prosecution because the Examiner agreed that a PHOSITA would not be motivated to modify the already top-heavy cart of Clark to make it even more top-heavy by adding additional components (*e.g.*, pivotable trays) to the workstation because the carts modified in this manner would be more unstable and would not work for their intended purposes (*e.g.*, they would be more susceptible to toppling over from the extra weight). Because the inventive carts of the '650 and '668 patents have a lower center of gravity, they can support a heavier work platform that may also include extendable work surfaces and compartments. This is a distinction argued before the Office with regard to Clark in the related and co-challenged US Pat. No. 8,215,650 – an argument the Office rightfully agreed with. *See e.g.*, Ex. 2003, OAR of 3/28/2012 in '650 Patent File History at pgs. 8-12. For

² Ex. 2002, US Pat. 6,721,178 to Clark, which is a continuation of the Clark reference cited by Petitioner. The claims at issue in the '650 IPR Petition filed concurrently with this '668 IPR are substantially similar to the claims at issue from the '668 Patent. Thus, Petitioner's arguments made in the '668 IPR are very similar to the arguments made in the '650 IPR. For example, the only independent claim at issue in the related '650 Patent also recites limitations to a cart having a height adjustable work platform, including compartments, where the compartments are disposed in a forward projecting portion of the work platform. '650 Patent, claim 1.

example, the Applicant of the Patents-at-issue argued in overcoming Clark:

For example, if one of ordinary skill in the art had tried to incorporate the pivotal trays 48, 50, and 52 of Ellefson into the workstation of Clark, the resulting workstation would be top-heavy if the tray were deployed. The result is that the deployed trays would make the workstation of Clark unstable so that it would be easily knocked over. The reason that the pivotal trays can work in the tool chest of Ellefson is that a tool chest contains heavy tools so as to prevent instability, a condition that is lacking in Clark. In other words, the overall design of the tool chest of Ellefson (including its lower center of gravity) permits the use of pivotal trays while the workstation of Clark (with its higher center of gravity) does not. Accordingly one of ordinary skill in the art would not combine the teachings of Clark, Rice, and Ellefson so as to arrive at a height-adjustable work platform with a movable work surface located above a compartment...Similarly, one of ordinary skill in the art would not have had reason to incorporate any particular feature on Murphy into the workstation of Clark because Murphy is designed to be low to the ground...and modifying the workstation of Clark (with its higher center of gravity) based on the teachings of Murphy would likely make the resulting workstation top-heavy such that it would be easily knocked over.

Id. at 10 (emphasis added). The next action was a notice of allowance. *Id.*, see Ex. 2007, '650 File History, Notice of Allowance; Ex. 2001, Decl. of Ben-Tzvi, para. 15.

The Petitioner now similarly argues that the '668 Patent is obvious in view of modifying the workstation of Clark by adding alleged compartments into the height adjustable workstation of Clark. As discussed above, the proposed modification of the workstation of Clark by adding the pivotal trays and other components from Ellefson/Murphy was overcome during prosecution because such a combination would be excessively top-heavy and unstable. Thus, Petitioner makes substantially

the same arguments that were overcome during the prosecution of the related '650 Patent (*i.e.*, Petitioner's argument merely substitutes other alleged compartments for the pivotal trays and other features of the Ellefson/Murphy references cited by the patent Examiner during original prosecution.) Petitioner ignores these prior arguments made in overcoming Clark. For example, Petitioner completely fails to even address how Petitioner's proposed modification of adding compartments to the workstation of Clark (and Reeder) is different than the Examiner's prior consideration of Clark in combination with Ellefson or Murphy and fails to address, much less overcome, critical arguments made during prosecution in overcoming Clark (*e.g.*, Clark's unstable/top-heavy design which is prone to toppling due to additional weight from alleged modifications to the workstation). As the Petition fails to reasonably distinguish the Examiner's prior consideration of Clark, and Reeder is, in pertinent part, substantially the same as Clark, the Board should exercise its discretion under 35 U.S.C. § 325(d) and decline to institute review of any of the challenged claims. *Unified Patents Inc. v. Berman*, IPR2016-01571, Paper 10, pg. 12 (P.T.A.B. Dec. 14, 2016) (denying the Petition stating Petitioner failed to distinguish/address the prior consideration of the prior art).

The remaining secondary references, at least one of which is also of record in the '668 Patent are cited by Petitioner for other reasons and do nothing to cure these fundamental distinctions (*i.e.*, the addition of the secondary references does not

amount to new arguments that cure the top-heavy/instability deficiencies of Clark previously considered nor does Petitioner cite to them for such purposes).³ Ex. 2001, Decl. of Ben-Tzvi, para. 16.

In summary, none of Petitioner’s cited references teach or suggest at least one element that is found in each of the independent claims of the subject patent, namely: “the compartments are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction” – a feature that provides the inventive cart of the ‘668 and ‘650 Patents with a lower center of gravity in which to support the height adjustable compartments. As properly defined, Petitioner’s cited primary references do not have *enclosed* compartments at all. Even if a broad interpretation is given to “compartments”, the carts in Petitioner’s references do not dispose the alleged compartments in a portion of an alleged work platform that projects from a height adjustment mechanism in the forward direction, instead placing them rearward (and to the side) of the alleged height adjustment mechanism. Additionally, the patent examiner, during original prosecution, rejected similar proposed modifications of Clark finding that adding additional components to the top-heavy workstation of Clark would render it unsatisfactory for its intended purpose. Ex. 2001, Decl. of Ben-Tzvi, para. 17.

³ *I.e.*, Petitioner relies on the secondary reference of Manner only for the limitation relating to the location of the actuator, Gillis for the arcuate work surface limitations, Hartman for the gas spring and Santoro for the drawer slides limitations.

For these and other reasons more fully set forth herein, Petitioner fails to carry its burden or presenting a reasonable likelihood of prevailing on its challenge against either of claims 3-4. Therefore, the Office should deny institution of the requested *inter partes* review. *Id.*

II. Background

A. Summary of the Technology at Issue

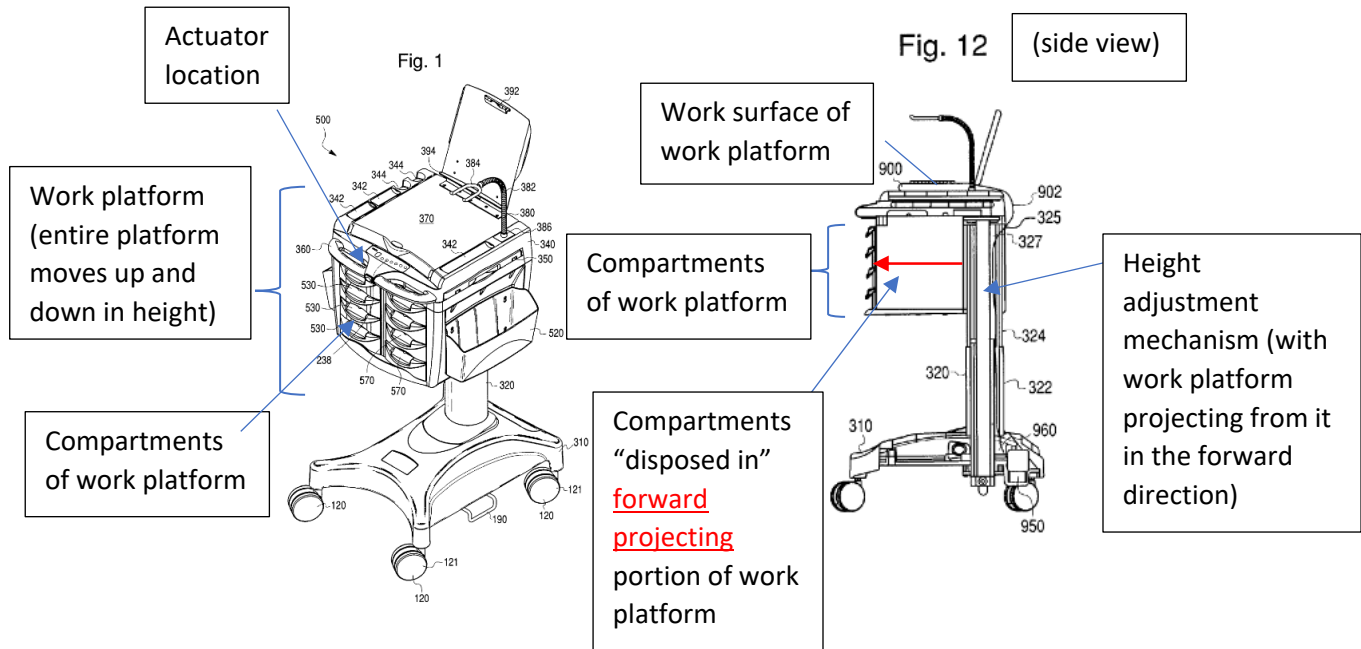
At a high level, the '668 Patent is directed to medical carts which improve workplace efficiency and ergonomics. *See e.g.*, col. 1 ll. 40-col. 2 ll. 7. These carts are quickly movable about a medical facility, such as room to room in a hospital, and facilitate many important functions such as accessing and dispensing medications or medical supplies at the cart, and performing other duties at the cart. *See e.g., id.* Prior carts lacked ergonomic and efficient designs and some of the advanced capabilities of today's carts. *E.g., id.*

B. Overview of the '668 Patent

The challenged claims require, among other limitations, a height adjustable work platform that includes compartment(s) and a work surface. *E.g.*, '668 Patent, claims 3-4. The work platform projects in a forward direction from a height adjustment mechanism to provide space for multiple compartments, such as extendable/stowable drawers, and so that a medical provider may stand in front of the cart to access the work platform (including at least the claimed work surface and

compartment(s)) in an ergonomic and efficient manner. *Id.*, see also e.g., col. 4 ll.

33-35. Exemplary figures with annotations from the '668 Patent in this regard are provided below to provide a generalized understanding of certain important claim features:



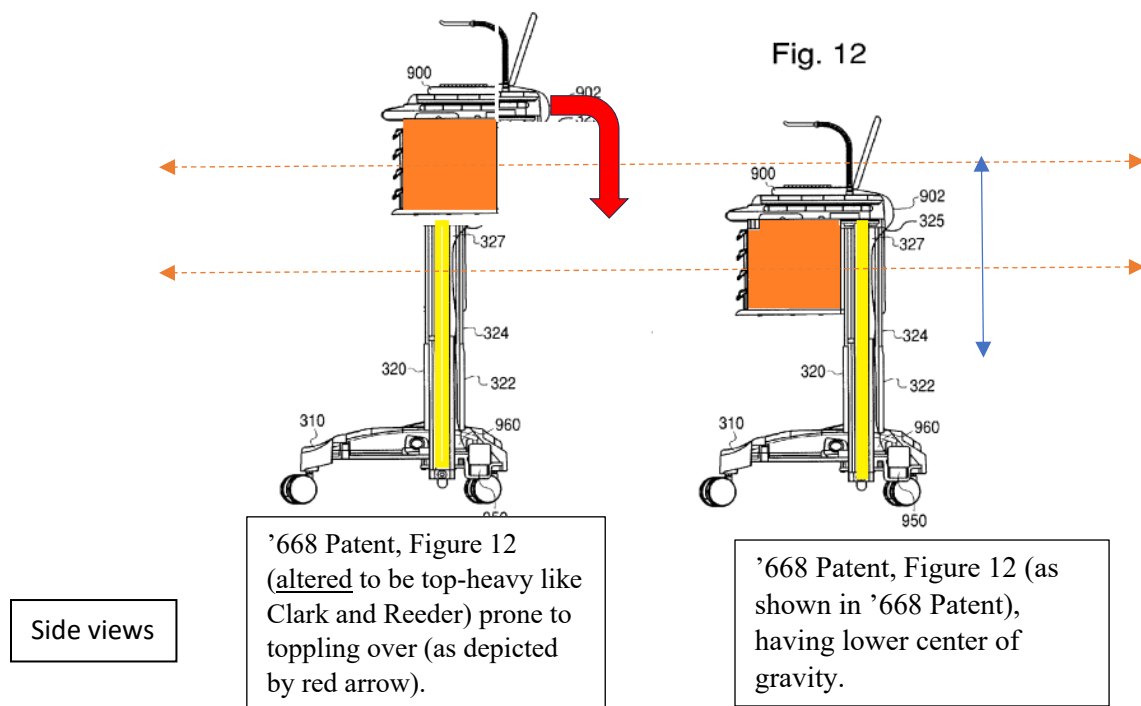
As particularly visible in the side view of Fig. 12 of the '668 Patent (annotated), the height adjustment mechanism is placed at the rear of the work platform, which allows the compartments to be “disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction” (see annotated red arrow pointing in the forward direction).⁴ This not only frees up space

⁴ There is no embodiment described in the '668 Patent where the compartments, or any part of the compartments, are disposed in a portion of a work platform that projects from the height adjustment mechanism in the rearward direction.

for the compartments (e.g., drawers), but also makes for a more stable cart with a centralized, lower center of gravity unlike the top-heavy carts of Clark and Reeder, allowing the work platform of the present invention to include compartments and additional, larger, work surfaces while retaining height adjustability functionality in a stable manner.

To demonstrate this advancement, an exemplary (altered) embodiment of the cart of the '668 Patent, derived from figure 12, is reproduced below with the compartments highlighted in orange and the height adjustment mechanism highlighted in yellow. If the cart of the '668 invention was configured to be top-heavy like the carts of Clark and Reeder, the resulting arrangement would be essentially as depicted on the left (showing work platform, including compartments, mounted on top of the centrally located height adjustment mechanism). The exemplary inventive design of the '668 and '650 Patents is depicted on the right, which is more compact and balanced and has a lower center of gravity. In other words, because the compartments are “disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction” they can move up and down along the length of the height adjustment mechanism which provides stabilizing support to the compartments and a lower center of gravity. See, for example, the blue arrow to the right of the inventive cart in the below annotated figure showing direction the work platform, including the compartments, moves. On

the contrary, because the annotated embodiment shown on the left is top-heavy, similar to the carts of Clark and Reeder that mount the entire workstation to the top of the centrally positioned height adjustment mechanism, the workstation can only move down to the top of the height adjustment mechanism resulting in a top-heavy and less stable cart.

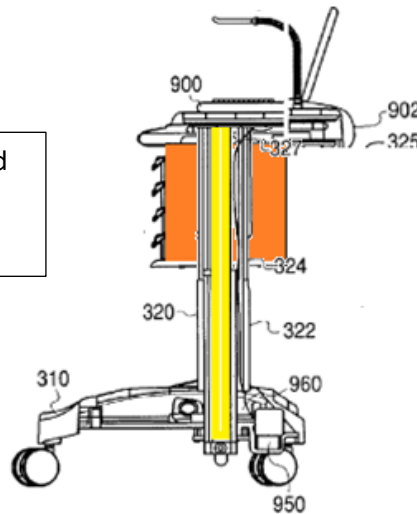


As argued during the prosecution of the '650 Patent with respect to Clark, a top-heavy cart is undesirable as it is more susceptible to toppling/knocked over due to the heavy weight of the work platform, including stored medical supplies, resting on top of the support. Thus, as explained in more detail below, a PHOSITA would not be motivated to add compartments (and heavy stored items) to the already top-heavy workstations of Clark and Reeder as they would be more at risk of toppling

over (especially if adjusted to higher heights) which may cause items to break and create safety issues.

Notably, in the alternative, modifying the claimed invention according to the teachings of Clark and Reeder, so that the vertical beam 22 extends through the alleged compartment(s), would essentially result in interrupted compartment space as depicted below. In such cases, the exemplary drawers would no longer be functional, such as for opening and closing and/or storing larger items (e.g., the drawers cannot be pulled out or accessed).

Figure 12, '668 Patent (altered to show impossible configuration).



Petitioner correctly identifies that minor differences exist between challenged claims 3 and 4, some of which are noted in the Petition and need not be repeated herein. Petition at pg. 6-7.

While the '668 Patent was allowed on a first action, the priority-claim related application resulting in the co-challenged '650 Patent was allowed over, and following, a discussion with the Office regarding an equivalent of the Clark reference relied upon by Petitioner herein.

C. Litigation

The '668 Patent is currently involved in litigation between Petitioner and Capsa. The litigation was instituted by Capsa filing a Complaint on May 12, 2022 in the U.S. District Court for the Southern District of Mississippi, which has been assigned Case No. 2:22-cv-00065-HSO-BWR. A *Markman* Hearing, including for many of the claim terms discussed herein, has been fully briefed by the Parties and a hearing before an appointed special master took place on October 18, 2023. The parties are waiting on a claim construction order. Trial on the issue of infringement is currently scheduled for August 5, 2024, which is less than the approximately one year in which any instituted *inter partes* review is likely to last. The related and co-challenged '650 Patent is part of the same parallel litigation.

III. Legal Standards

In an *inter partes* review, claims are “construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. §282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the

art and the prosecution history pertaining to the patent.” 37 CFR § 42.100(b). The Board must construe the claims where necessary to resolve the underlying controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Patent Owner submits that the ’668 Patent is valid under any reasonable construction. The Parties have fully briefed the Court in the parallel litigation and a *Markman* hearing has been held on the disputed claim terms, a decision was rendered. *See* Ex. 1029-32, 1012. The parties are waiting on the claim construction order. Notably, the claim construction order from the Western District of North Carolina cited by Petitioner was subsequently vacated. Petition at pg. 8.

For the sake of completeness, Patent Owner further notes that various claim terms remain disputed by the Parties as evidenced in the arguments below. Especially when properly construed, the cited art clearly fails to teach or suggest the elements in the manner claimed.

IV. Level of Ordinary Skill in the Art

Patent Owner’s position on the definition of a Person of Ordinary Skill in the Art (PHOSITA or POSA) as submitted in the parallel litigation is essentially re-submitted herewith. Ex. 2001, Decl. of Ben-Tzvi, para. 21.

Petitioner submits a somewhat different, and broader, definition. Petition at pg. 7. The difference is notable particularly as it supports fields, such as industrial

design, that do not require the same level of hard sciences as Patent Owner's definition. In this regard, Petitioner's supplied expert testimony from Mr. Kemnitzer comes from an industrial designer. *E.g.*, Ex. 1004 at ¶ 4-6. Mr. Kemnitzer's background and qualification, while notable in his own field, fails to meet Patent Owner's definition for a PHOSITA. Indeed, Mr. Kemnitzer's education and experiences are in industrial design. *Id.* While the field of industrial design does not have a set definition, the field is generally more directed toward aesthetic design and, at best, high-level functionality, rather than hard science type mechanical engineering, physics, and detailed implementation considerations. This distinction in background is borne out in the insufficiency of Mr. Kemnitzer's analysis as further explained herein. As further explained herein, considerations of physics and/or mechanical engineering are at the core of at least several important reasons why the claimed invention is patentably distinct over the cited references as further described herein. Therefore, Patent Owner respectfully submits that its definition of a PHOSITA should be adopted. Notwithstanding, the Petition should be denied under either party's definition of a PHOSITA as Petitioner has failed to meet its burden of establishing a *prima facie* case of obviousness. Ex. 2001, Decl. of Ben-Tzvi, paras. 22-24.

V. Claim Construction

Petitioner fails to expressly adopt or set forth any claim definitions. While certain claim construction briefing documents are provided for “reference”, it is unclear if Petitioner actually intends for the Board to adopt such definitions, aside from the “work surface” term. *E.g.*, Petition at pg. 7-9. Ironically, this is a term that need not be construed for purposes of this preliminary response. While Patent Owner contends that the claimed invention is valid under any reasonable construction, Patent Owner expressly sets forth appropriate definitions herewith for certain key claim terms including the term “compartment(s)” which the Petitioner agreed to in the ongoing, parallel litigation. Ex. 2006. Because Petitioner has agreed to the definition of “compartment(s)” in the ongoing, parallel litigation, this definition requiring “enclosure” should be applied for this IPR proceeding.⁵ *Id.*, Ex. 2001, Decl. of Ben-Tzvi, para. 25.

A. “Compartment(s)”

Subsequent to the filing of the ’668 and ’650 IPR Petitions by Petitioner, Petitioner agreed to adopt the following definition for this term in the on-going parallel litigation: “[a]n enclosed space for containing an item.” *See, e.g.*, Ex. 1031 at pg. 36; Ex. 2006. This proposed definition of “compartment” as being “*enclosed*”

⁵ The parties also have interpreted the terms “compartments disposed in a portion of the work platform that projects from the height adjustment mechanism in the forward direction” differently as discussed in the relevant sections of this response.

is consistent with the definition adopted by the Western District of North Carolina.

See Petition Exhibit 1013, pg. 6 (the W.D.N.C. defining “compartment” as used in the related ’650 Patent as “a drawer or other type of container that is enclosed when inserted into the work platform of which it forms a part.”) The Petitioner should not be allowed to argue for a broader construction in the filed IPR Petitions in arguing for invalidity (*e.g.*, Petitioner arguing that “compartments” read on unenclosed storage trays and keyboard tray cavities), especially when Petitioner subsequently agreed to a more narrow definition in the parallel litigation.

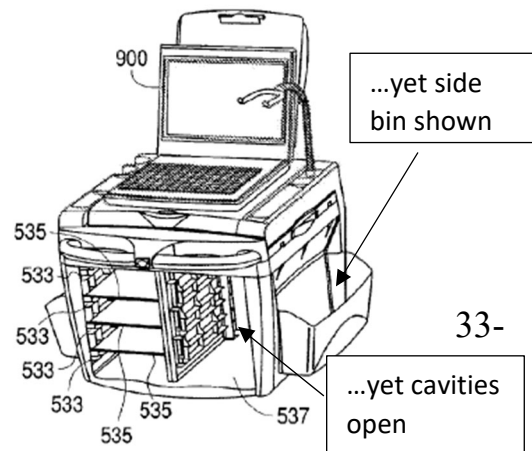
Patent Owner submits that this definition of “compartment” requiring it to be “enclosed” (not open) is the correct definition under claim construction principles under the *Phillips* standard that applies to this proceeding.⁶ *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). This definition is consistent with the teachings of the intrinsic evidence. For example, the ’668 Patent teaches that the “... compartments 530 enable a user (*e.g.*, a nurse) to separately maintain medication for particular patients or for a particular room.” ’668 Patent, col. 7 ll. 33-35. The ’668 Patent goes on to explain that the compartments may be lockable (*e.g.*, col. 8 ll. 1-5), may be labeled drawers (*e.g.*, col. 2 ll. 15, col. 7 ll. 30-35), and may be otherwise removable and/or exchangeable (*e.g.*, col. 7 ll. 45-67).

⁶ The Patent Examiner applied the broadest reasonable interpretation to the claim terms during the original prosecution of the ’650 and ’668 Patents-at-issue.

The description of the '650 and '668

Fig. 7 described as a cart
“*without* compartments” ...

Fig. 7



Patents repeatedly contrasts the claimed

“compartment” from unenclosed storage

spaces. '650 patent, Figure 1 (showing

compartments **530** as pull-out enclosure-

type containers or drawers); col. 3:14-15;

37; col. 4:30-34 (expressly distinguishing

“compartment” from other unenclosed storage spaces such as top bins **342**, side

bins **520**, cup holders **344**, barcode scanner holder); col. 2:38-39 (stating that the

work platform “houses the at least one compartment”). As another example, the

patentee explicitly describes Figure 7 (reproduced here) as a medical cart

“*without* compartments” (showing the drawers removed) yet the side bin 520

storage unit is shown as part of the medical cart in Figure 7. *Id.* at col. 3:33-35.

This confirms that enclosed “compartments” are distinguishable from open items

like side bins and keyboard tray cavities.

Based on the foregoing, Patent Owner respectfully submits that the definition of “compartment” as “an enclosed space for containing an item” is the definition that one of ordinary skill in the art would understand as the meaning of the term based on a review of the intrinsic evidence.

B. “Work Surface”

In the parallel litigation, the Parties dispute the definition that should be provided to the term “work surface”. *E.g.*, EX. 1031 at pg. 32. Essentially, Petitioner argues for a narrower definition and Patent Owner argues for plain and ordinary meaning. *Id.* This is the only definition expressly adopted by Petitioner in its Petition. Petition at pg. 9. While Patent Owner maintains its position that plain and ordinary meaning should be adopted, for purposes of this preliminary response the Board need not reach the construction of this claim term for at least the reasons further outlined below. In other words, the definition of “work surface” (*e.g.*, whether it is curved or not) is not dispositive here as there are other terms recited in the independent claims at-issue that are not taught or suggested by the prior art relied upon by the Petitioner.

VI. The Applied References

A. Clark

Clark teaches a height adjustable computer workstation, but does not teach or suggest disposing enclosed compartments (*e.g.*, drawers) in the workstation or how it can be accomplished (*e.g.*, where and how to place the drawers in the height adjustable workstation while maintaining stability). Clark is generally directed to a medical cart with height adjustable tray supporting a computer and a pull-out keyboard tray for a user to operate the computer. *E.g.*, Abstract, figure 4A. A

vertical beam extends to a middle/center of the tray area to provide height adjustability. *E.g.*, figure 4A-5A, col. 11 ll. 51-61. Height adjustment is provided when a user reaches into an opening in a side of the tray area to access a release lever therein. *E.g.*, figures 5A-5B, 11A-11B, col. 9 ll. 57-col. 10 ll. 8. Clark teaches cutting an access window within components to the height adjustable tray to accommodate a shaft for height adjustment. *E.g.*, figures 5A-5B, 11A-11B, col. 21 ll. 47-51. Notably, all embodiments of Clark teach a centrally located shaft (with respect to the tray/workstation), along with cut-out windows or other access windows for reaching an internally located release lever for height adjustment. *E.g.*, figures 5A-5B, 11A-11B, 16-20, col. 9 ll. 51-62. Exemplary figures from Clark are reproduced below for reference, with annotations.

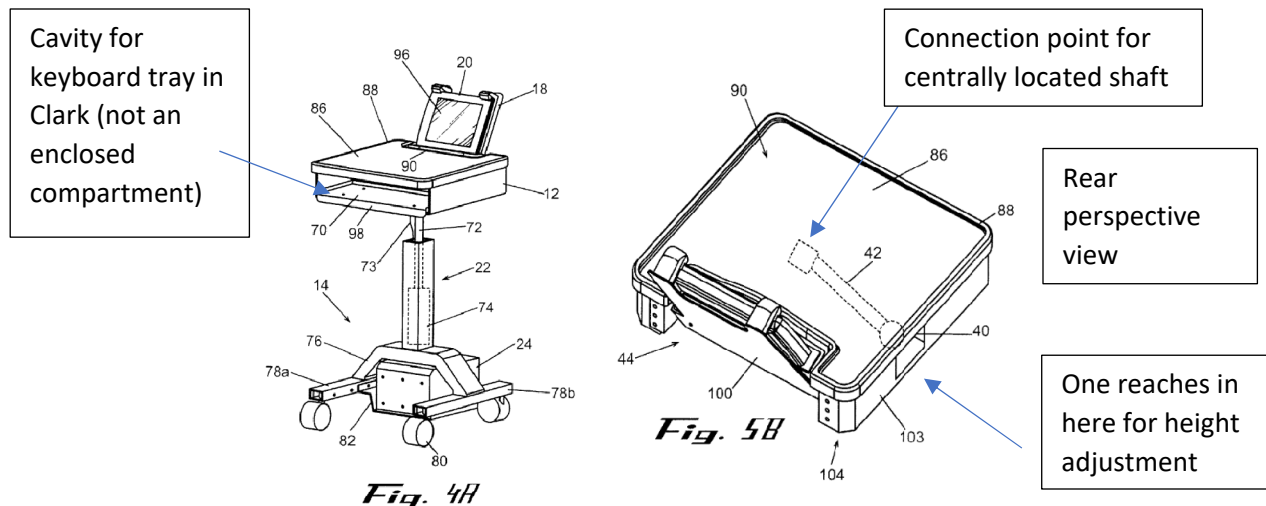


Figure 2B shown here is an annotated figure from Clark showing a side view of the cart of Clark with the entire workstation with keyboard tray 12 mounted on top of the center height adjustment mechanism resulting in the keyboard tray/cavity being disposed *outside* a

forward-projecting portion of the workstation. In other words, even if the keyboard tray/cavity of Clark is considered a “compartment” (which it is not since the

Thus, even if the opening for the keyboard tray 12 in Clark is considered a “compartment” it is disposed *outside* a forward-projecting portion of the workstation (the annotated red oval indicates a rear-facing portion of the workstation that the keyboard cavity is located).

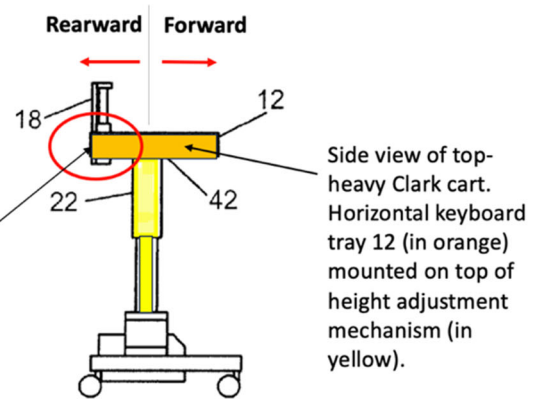


Fig. 2B

keyboard tray cavity is not an “enclosed” compartment), it is mounted on top of the centrally located height adjustment mechanism and clearly extends rearward of the height adjustment mechanism (*i.e.*, it is located *outside* a portion of the alleged work platform that projects from the height adjustment mechanism in the forward direction). The configuration of Clark results in a more top-heavy design compared to the invention of the ’650 and ’658 patents. See more detailed discussion below. Thus, Clark fails to teach or suggest any compartment(s) disposed in a forward-projecting portion of the work platform, alone or in combination. Ex. 2001, Decl. of Ben-Tzvi, para. 26.

B. Reeder

Reeder, like Clark, teaches a height adjustable computer workstation, but does not teach or suggest disposing enclosed compartments (e.g., drawers) in the workstation or how it can be accomplished. Reeder is generally directed to a patient monitoring cart/system. *E.g.*, Abstract. While a large number of embodiments are provided in Reeder, only a select few are relied upon by Petitioner. *E.g.*, Petition at pg. 46-48 (citing embodiments of figure 31, 45-46). The embodiments relied upon by Petitioner teach open top wire bins or open storage bins as opposed to enclosed compartments. *E.g.*, figure 31, 45-46. These components are not disposed in a “work platform” portion as required by the claims. *E.g.*, *Id.* Other embodiments utilize drawers but are not height adjustable, presumably for stability reasons. *E.g.*, figure 32-33. Exemplary figures from Reeder (annotated with color) are reproduced below for reference (showing work surface/workstation in orange and height adjustment mechanism in yellow). As illustrated, there are no enclosed compartments disposed in the height adjustable workstation of Reeder. Ex. 2001, Decl. of Ben-Tzvi, para. 27.

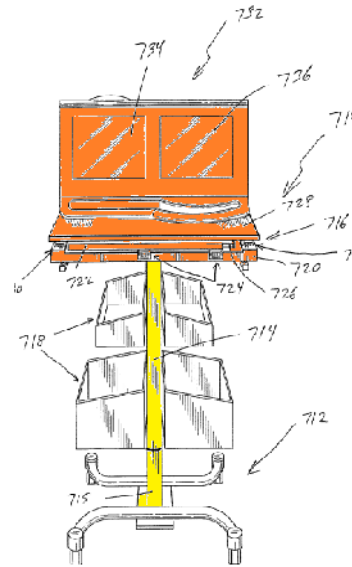
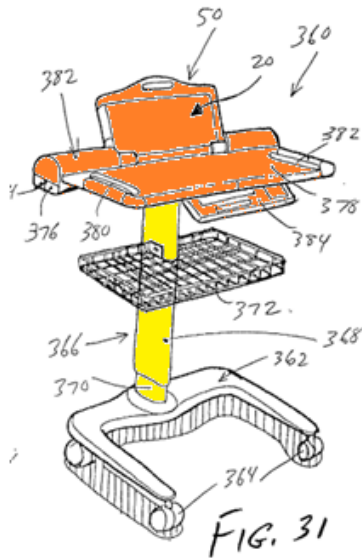


Fig. 45

Again, the cart of Reeder, like Clark, is inherently top-heavy because it is also configured with a workstation/work surface mounted entirely on top of the centrally located height adjustment mechanism. *See* Reeder, paras. [0118], [0147]-[0148] (describing “center” vertical support member 714 with workstation 710 mounted entirely to the top of the center height adjustment mechanism). Because Reeder teaches an already top-heavy cart, Reeder does not teach or suggest disposing additional enclosed compartments into the height adjustable workstation or explain how it can be accomplished. For example, the above carts of Reeder merely teach wire trays or side bins⁷ attached to the center support (i.e., they are not “disposed in” anything, much less in a height adjustable work platform as claimed). Thus, the

⁷ Again, as previously discussed, the '668 and '650 Patents distinguish side bins from enclosed compartments that are disposed in the work platform.

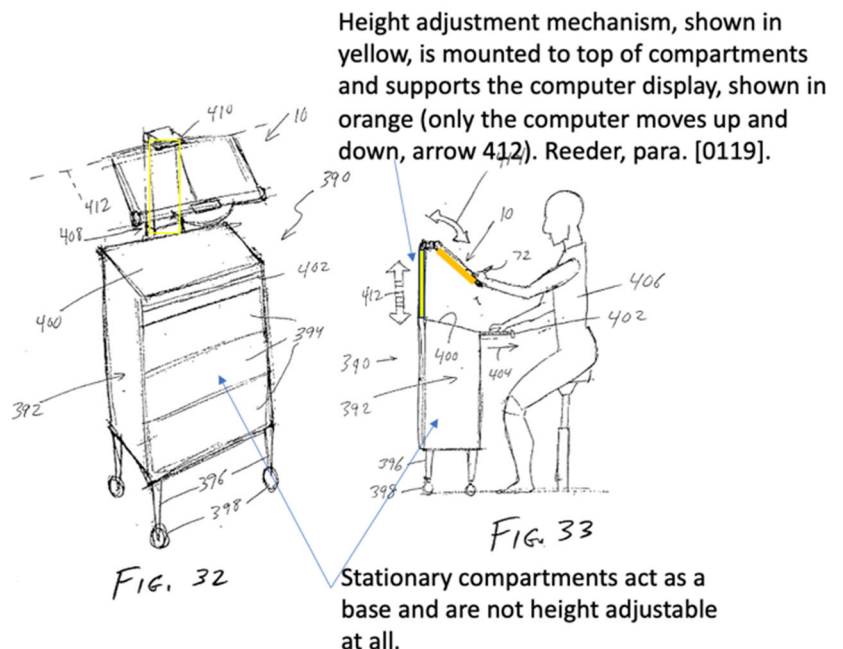
inventors of Reeder (like Clark) did not solve the “top-heavy” problem addressed by the 668 and ’650 Patents (e.g., how to put enclosed compartments (accessible from the front of the cart), loaded with stored items, as part of the height adjustable work platform while maintaining mobility and stability of the cart). Additionally, the wire tray and side bins of Reeder hang off the side of the center support (and towards the rear of cart) and thus are not “disposed in” a forward-projecting portion of a work platform as claimed. *Id.* at para. 27.

In fact, the only carts with compartments described in Reeder (embodiments of Figures 32, 33 of Reeder reproduced here) utilize the compartments as the base of the cart that does not adjust up and down in height at all. Thus, Reeder teaches the exact opposite of what the

‘650 and ’668 patents teach and fails to solve the same problems in the art. Instead, in this embodiment, the height adjustment mechanism of Reeder is supported by the compartments and not the

other way around as provided by the inventive carts of the ’668 and ’650 Patents.

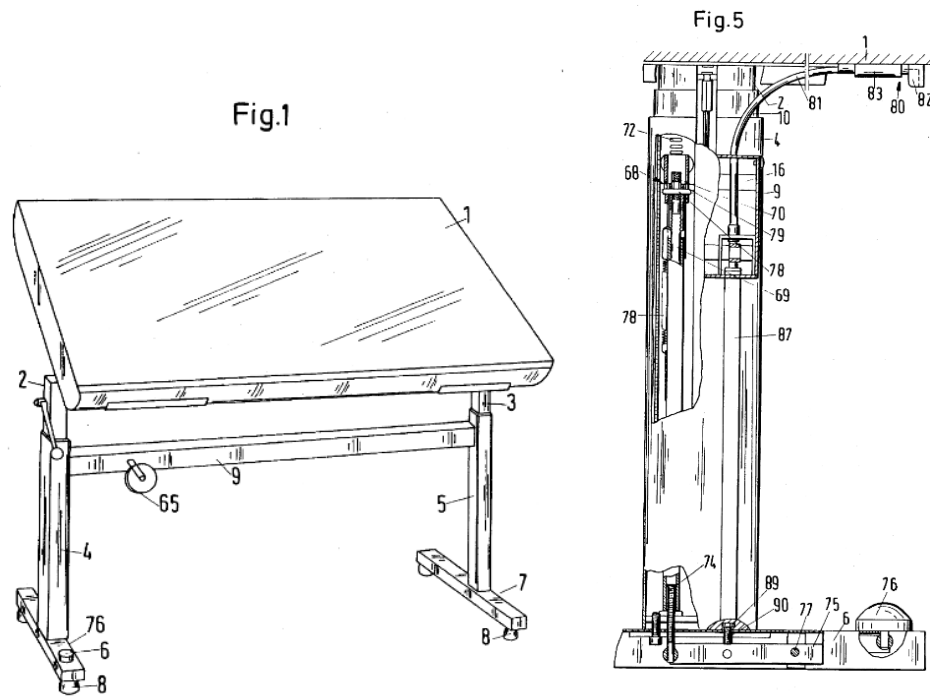
See arrow 412 in Figures 32, 33 of Reeder, Reeder at para. [0119]. In other words,



the compartments of Reeder are not projecting forward from anything (instead, they serve as the base unit). Thus, the embodiments of Figures 32, 33 of Reeder do not teach or suggest the claim limitations of compartment(s) “*disposed in* the portion of the work platform that projects from the height adjustment mechanism in the forward direction”. Reeder provides further evidence that at the time of filing of the ’668 and ’650 Patents at-issue, no one in the industry had incorporated enclosed compartments into a height adjustable work platform or knew how to accomplish it. *Id.* at para. 27.

C. Manner

Manner is cited by Petitioner to purportedly remedy admitted deficiencies in Clark and Reeder regarding the specifically claimed location of the actuator for controlling height adjustment. *E.g.*, Petition at pg. 38. Manner is generally directed to a height adjustable table. *E.g.*, Abstract. In relevant part, Manner teaches a Bowden pull which is extended in an elongated arc through an unoccupied space to a location below the height adjustable table surface for a user to actuate. *E.g.*, figure 5, col. 9 ll. 24-31. Exemplary figures are reproduced below for reference.



D. Santoro

Santoro is cited by Petitioner to purportedly remedy admitted deficiencies in Clark and Reeder regarding the use of drawer slides in at least some of the claims. *E.g.*, Petition at pg. 35. Santoro is generally directed a height-adjustable workstation frame. *E.g.*, Abstract. Slides that utilize rows of ball bearings are described generally to provide movement between inner and outer legs. *E.g.*, para. [0036]. The addition of Santoro, which is listed on the face of the '668 Patent, is not central to Patent Owner's arguments for this preliminary response.

E. Gillis

Gillis is cited by Petitioner to purportedly remedy admitted deficiencies in Clark and Reeder regarding a curved work surface, should the Board adopt such a

definition. *E.g.*, Petition at pg. 9. Gillis is generally directed to a tray which has a curved portion that slides from side to side. *E.g.*, figures 5-6. The addition of Gillis is not central to Patent Owner's arguments for this preliminary response.

VII. Arguments Against Asserted Grounds of Unpatentability

A. Generally

The Office correctly identified the challenged claims as allowable over the prior art, including certainly expressly considered references relied upon by Petitioner. Patent Owner refutes each and every ground of alleged unpatentability set forth by Petitioner. When the claims are considered under any reasonable construction, the cited art fails to teach or suggest each and every limitation of the challenged claims as required.

As Petitioner has correctly identified, there are many similarities between challenged claims 3 and 4. And, the proffered grounds of alleged unpatentability involve the same references. Thus, Petitioner's proffered arguments can essentially be "boiled down" to the application of one of: 1) Clark, or 2) Reeder in view of Manner and Santoro (and optionally also Gillis). As some of the same, or substantially the same, arguments apply across the various grounds of alleged unpatentability, some such grounds are discussed collectively herein. Furthermore, for purposes of this preliminary response Patent Owner does not separately challenge the application of Santoro or Gillis. Thus, to focus the Board's analysis

and meet response word limits, deficiencies in Clark and Reeder are respectively discussed with regard to both challenged claims, along with problems with the alleged modification of Clark and Reeder, respectively, with Manner.

B. Deficiencies in Clark

While Patent Owner disputes that Clark teaches any compartments that are enclosed, even if the Board finds that the cited elements of Clark (e.g., keyboard tray cavity) are considered compartments, Clark fails to teach or suggest disposing such compartment(s) in a forward-projecting portion of a height adjustable work platform as claimed. Furthermore, modifying Clark in such a way would result in an impermissibly top-heavy and unstable design.

1. Clark Fails to Teach or Suggest Any Compartments

Clark teaches a height adjustable computer workstation, but does not teach or suggest disposing enclosed compartments (e.g., drawers) in the workstation or how it can be accomplished. Petitioner relies on an open (not enclosed), keyboard tray cavity of Clark as allegedly providing the “compartment(s)” of the challenged claims. *E.g.*, ’668 IPR Petition at pg. 24 (citing figures 4A-4B). *This open keyboard tray cavity does not meet definition for the “compartment(s)” as “an enclosed space for containing an item” as agreed to by Petitioner in the ongoing, parallel litigation. See section V(A) supra.* Clearly, this open keyboard cavity of Clark is not enclosed. Additionally, the keyboard cavity of Clark is not provided for the purpose of

separately storing medical items as intended by the '668 Patent, *e.g.*, medications and medical supplies, because it is already occupied by a pull-out keyboard tray 70, 424 and computer keyboard. Ex. 2001, Decl. of Ben-Tzvi, para. 28.

While Clark makes an unclear and passing reference to alternatively moving the vertically mounted computer docking station 18 (and attached computer terminal 20) to a supporting drawer or pull-out tray, the details are vague, hypothetical, and aspirational.⁸ *E.g.*, '668 IPR Petition at pg. 24 (citing col. 10, ll. 30-33 of Clark). The drawer in question is not illustrated or described in any detail. *See id.* *See Tris Pharma Inc. v. Actavis Laboratories FL, Inc.*, No. 21-1495, 2022 U.S. App. LEXIS 18630 (Fed. Cir. July 7, 2022) (non-precedential), (finding that such aspirational and hypothetical references without any data or explanations or why or how the claimed limitations could be accomplished would be dismissed by a skilled artisan). It is apparent that the Examiner, during original prosecution, also dismissed this vague reference in Clark when considering the reference.

Contrary to the incorrect statements of Petitioner, the Clark reference never states that the opening/cavity for the keyboard tray 70 can be “*converted*” to a drawer. *See* '668 IPR Petition, pg. 24. Notwithstanding, a PHOSITA would not be motivated to make such a modification to the keyboard cavity of Clark as such a

⁸ For example, the docketing station 18 supports a wireless computer terminal 20 which is displayed to the user, yet it is unclear why or how such a docketing station would be placed into a drawer or how this would be accomplished.

modification would render the Clark reference unsatisfactory for its intended purpose, *i.e.*, converting the keyboard tray cavity to a drawer for supporting a docking station 18 and computer 20 would leave no area for holding the keyboard, and, adding additional drawers to the already-top-heavy cart of Clark would cause it to be more susceptible to toppling over. Even if Clark would have taught an enclosed compartment, there is no teaching in Clark that such an enclosed compartment be “disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction” as recited in each of the claims at-issue or how this could be accomplished. *See infra*, Section VII.B.2, VII.B.3 below; *Id.* at para. 29.

In view of the foregoing, Patent Owner respectfully submits that Clark fails to teach or suggest the claimed compartment(s). *Id.* at para. 30.

2. Clark Fails to Teach or Suggest Compartment(s) “Disposed in” a Height Adjustable Work Platform

While Clark makes a vague, passing reference to supporting a docking station 18 (e.g., for holding a computer terminal 20) by a drawer, Clark does not explain or suggest that such a hypothetical, aspirational, unillustrated and non-enabled drawer be “disposed in” a height adjustable work platform as claimed or how it would be configured or accomplished. *E.g.*, ’668 IPR Petition at pg. 24 (citing col. 10, ll. 30-33 of Clark), Instead, Clark vaguely states that such a drawer could be located above

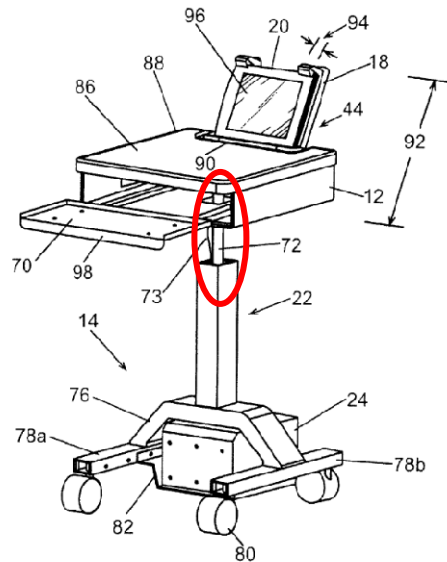
or below the tray 12 (in other words “somewhere on the cart”). *Id.* Clark never explains where or how such a drawer should be attached, how far below the tray, or whether it is disposed in the alleged work platform as claimed (e.g., much less in a forward-projecting portion of the work platform). Ex. 2001, Decl. of Ben-Tzvi, para. 31. On the contrary, Clark states that the docking station 18 (without the drawer) can be mounted to the underside of the horizontal tray, but says nothing about the specific location of the alleged drawer. *Id.* at col. 10: 34-38. By explicitly stating that the docking station 18 (with attached computer terminal 20) can be mounted to the underside of the tray, but not a drawer, indicates that the inventors of Clark also appreciated that adding a drawer to the computer workstation of Clark was not feasible or desired. The Examiner, during original prosecution, also came to this conclusion by allowing the claims of the ’668 and ’650 Patents over Clark.

As similarly argued in overcoming Clark during the original prosecution, a PHOSITA would not be motivated to add compartments to the already top-heavy workstation of Clark as discussed in more detail below. Furthermore, the alleged drawer of Clark would be occupied by the computer terminal 20 and the docking station 18, and thus would not function as a compartment for storing removable items in the sense of the claimed invention. Modifying Clark as urged by Petitioner would defeat its intended purpose in this regard. Further still, by describing the location as above or below, a PHOSITA would interpret Clark as providing little, if

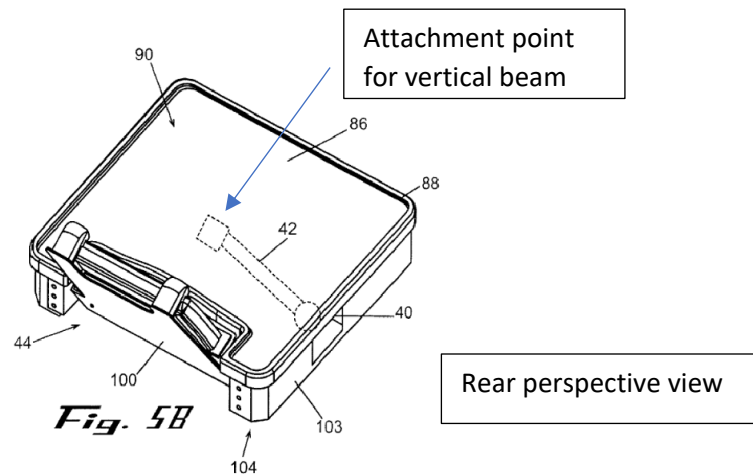
any, significance to the location when reviewing Clark. This stands in contrast to the challenged claims where the location is important for ergonomics and cart stability. Therefore, Patent Owner respectfully submits that Clark fails to teach or suggest compartment(s) disposed within a height adjustable work platform as required by the challenged claims. *Id.* at para. 32.

3. Clark Fails to Teach or Suggest Compartment(s) “Disposed in the Portion of the Work Platform that Projects from the Height Adjustment Mechanism in the Forward Direction”

Irrespective of the foregoing, Clark fails to teach any purported compartments as being “disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction” as required by the challenged claims. ’668 Patent, claims 3-4 (also reciting that the “forward direction...is substantially opposite to the rearward direction”). Essentially, this necessarily requires that the height adjustment mechanism be located at a rear of the work platform, or at least sufficiently rearward to accommodate the compartments in a forward-projecting portion of the work platform. However, the alleged height-adjustment mechanism (vertical beam 22) of Clark extends through a middle/center portion of the alleged compartment (keyboard tray cavity 12), essentially dividing it in half. *See e.g.*, Clark, figures 4A-4B. An annotated version of figure 4B of Clark is reproduced below to illustrate this arrangement.



Ex. 2001, Decl. of Ben-Tzvi, para. 33. Further illustrating this arrangement, figure 5B of Clark illustrates a release lever 42 contained in the cavity for the keyboard tray extending towards an opening 40 in an outer edge of the tray 12 to permit a user to access the release lever 42 for height adjustment. Figure 5B is reproduced below for reference with annotations.



Ex. 2001, Decl. of Ben-Tzvi, para. 34.

Petitioner incorrectly interprets the teachings of Clark and wrongly assumes that Clark teaches compartments “disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction” as required by the claims at issue (relying on a front view of Figure 4A). *See* ’668 IPR Petition, pgs. 30-31, Kemnitzer, at 71-72. First, Petitioner takes an unreasonably broad, unsupported and impossible interpretation of this claim term. For example, Petitioner argues that the keyboard tray cavity of Clark meets this limitation even though that cavity extends rearward of the height adjustment mechanism. In an attempt to stretch Clark’s teachings to meet the claim limitations, Petitioner essentially argues that a front area (or front pocket of space) of the keyboard tray cavity meets this limitation, thereby essentially dividing the alleged compartment into separate, fractional pockets of space/air. *See* ’668 IPR Petition, pgs. 30-32

(arguing that the front area/space of the keyboard tray cavity meets this limitation).

This is wholly inconsistent with the teachings of the '668 Patent. First, all embodiments described in the '668 Patent show that the compartments are disposed only in the portion of the work platform projecting from the height adjustment in the

forward direction. '668

Patent, Figure 12

(annotated side view here

showing no part of the

compartments (in orange)

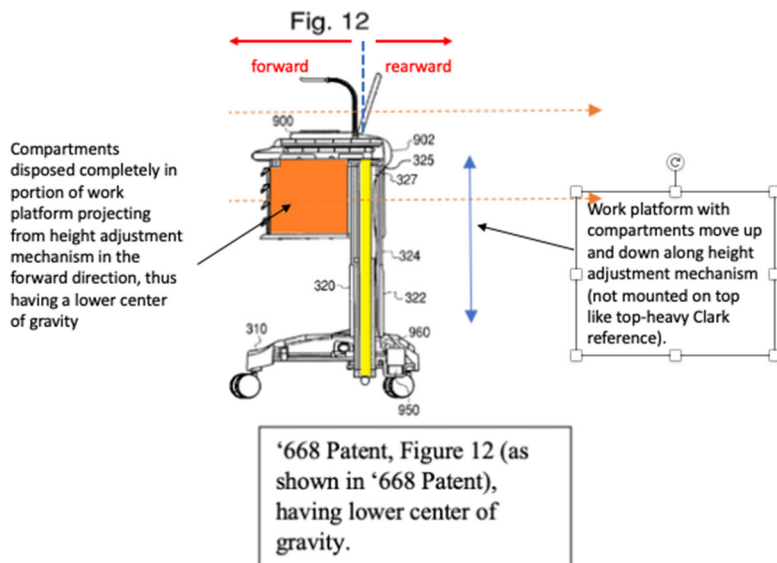
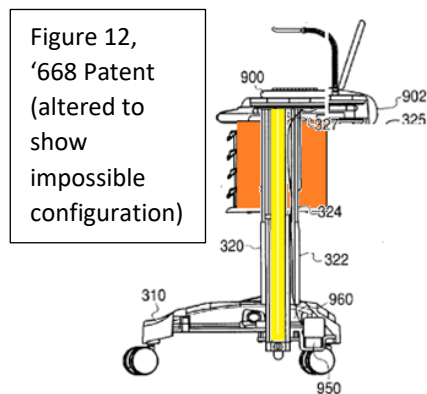
extending to the rearward

direction from the height

adjustment mechanism (in yellow)). In fact, it is impossible for the compartments

in the cart of the '668 Patent to extend to the rearward direction from the height

adjustment mechanism because the height adjustment mechanism is in the way (to



do this would require a large hole to be bored

through the middle of the compartments for the

height adjustment mechanism which would prevent

access to the compartments, e.g., drawers could not

even be pulled open in such a configuration, *see*

annotated figure shown here). Certainly, the ability to move up and down along the

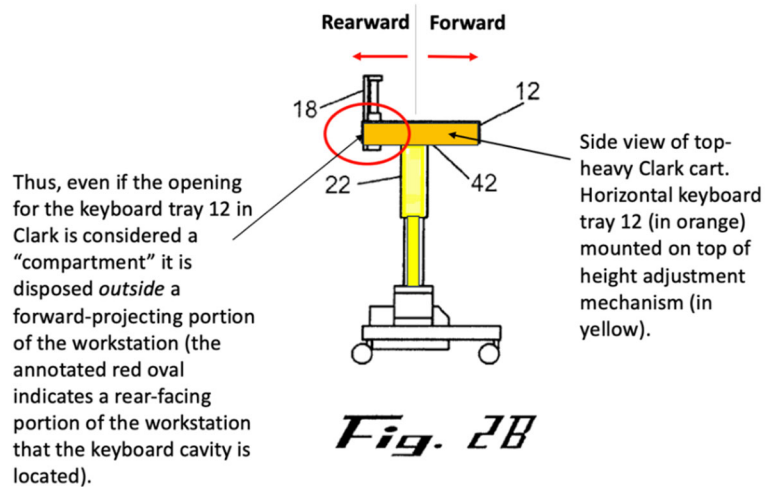
height adjustment mechanism would also be compromised. Ex. 2001, Decl. of Ben-Tzvi, para. 35.

Additionally, the prosecution history is contrary to Petitioner's broad interpretation of the claims. As discussed throughout this response, the Applicant of the '668 Patent consistently asserted that a key aspect of the invention is a lower, centralized center of gravity (which as discussed is realized by putting the height adjustment mechanism at the rear of the work platform and disposing the compartments in the portion of the work platform projecting from the height adjustment mechanism in the forward direction). Again, the Applicant overcame Clark during prosecution because Clark mounts the alleged work platform/compartment centrally, and entirely, on top of the height adjustment mechanism such that the alleged compartment (cavity for keyboard tray) runs the entire length of the workstation from the forward to rear direction, resulting in an inherently top-heavy design which would be further destabilized if modified to meet the claim language. Thus, when construing the claims in view of the intrinsic evidence, the requirement that "the compartments are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction" means that no part of the compartment can be disposed outside of the

forward-projecting portion of the work platform, including in the rearward direction

of the height adjustment mechanism.⁹ Ex. 2001, Decl. of Ben-Tzvi, para. 36.

Inspection of the side view of the cart of Clark illustrates that the alleged compartment (horizontal keyboard tray cavity 12) is not “disposed in” a portion of the work platform that projects



from the height adjustment mechanism in the forward direction.¹⁰ Figure 2B shown here is an annotated figure from the Clark patent showing a side view of the Clark cart with the keyboard tray cavity 12 mounted on entirely top of the center height adjustment mechanism. Even if the keyboard tray cavity of Clark is considered a compartment (which it is not as it is open in the front and not “enclosed”), it is centrally mounted on top of the height adjustment mechanism and it runs the entire length (forward to rear) of the cart and thus it is not “disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward

⁹ In other words, the space that the compartment resides in defines the compartment.

¹⁰ The claims at-issue state that the compartments are “disposed in” this forward-projecting portion of the work platform and not “around” it or “attached” to it, or disposed “in-part” or “partially” in this forward space.

direction” (i.e., the alleged compartment of Clark is clearly disposed outside this forward-projecting region). Only a front pocket of space/air of the alleged compartment of Clark is found in the forward-projecting space, but the alleged compartment itself is clearly not disposed therein. Thus, Clark fails to teach or suggest all of the claimed limitations, alone or in combination.¹¹ Ex. 2001, Decl. of Ben-Tzvi, para. 37.

The Petition should also be denied because Petitioner fails to articulate any basis for why a PHOSITA would be motivated to modify the cart of Clark to include a compartment “disposed in the portion of the work platform that projects from the height adjustment mechanism in the *forward direction*” as claimed. Petitioner mistakenly assumes that the unenclosed keyboard tray cavity of Clark teaches this limitation and thus completely fails to articulate a motivation to combine or modify Clark to reach this limitation or explain how there would be a reasonable expectation

¹¹ Additionally, on page 33 of the ’650 IPR Petition, in discussing the claimed limitation of the actuator location, Petitioner draws in a red drawer at the bottom of the alleged work platform of Clark, but nowhere in Clark does it state or suggest that the drawer be disposed in this manner or location and nowhere does Petitioner provide any articulated reason why a PHOSITA would make such a modification or that there is a reasonable expectation of success (considering the center support is not located at the rear of the work platform thus providing little room for disposing compartments in a forward-projecting portion). This amounts to a conclusory argument. For example, based on the teachings of Clark, this drawer could be placed under the horizontal tray but mounted entirely on top of the center height adjustment mechanism and not disposed in the portion projecting from the height adjustment mechanism in the forward direction. Or a PHOSITA, to maintain stability, could configure the cart similar to Figures 32 and 33 of Reeder where the compartments/drawers are placed as the base of the cart that does not project from the height adjustment mechanism at all.

of success in doing so. *See* '668 IPR Petition at 30-32, Kemnitzer, 71-72. For example, no articulated reasons are provided as to why a PHOSITA would add enclosed storage compartments in the workstation portion at all, much less the forward-projecting portion, or how such a modification would be successful in view of Clark's centrally configured support column and top-heavy design.¹² This failure alone amounts to a basis for denying the Petition. *Johns Manville Corp. v. Knauf Insulation, Inc.* (IPR2018-00827, Paper 9) at 13. Because Petitioner fails to articulate any reasons for why a PHOSITA would modify Clark to include a compartment disposed in a portion of the work platform projecting from the height adjustment mechanism in the forward direction as claimed, Petitioner has failed to meet their burden to demonstrate a *prima facie* case of obviousness even if Patent Owner does not provide rebuttal arguments. Although a rebuttal argument is not required, Patent Owner has provided counter arguments below. Ex. 2001, Decl. of Ben-Tzvi, para. 38.

Again, as previously discussed, there are two main reasons why a PHOSITA would not be motivated to modify the carts of Clark to reach the claimed invention: first, because the entire workstation of Clark is mounted on top of a centrally located support, there is insufficient space to dispose compartments in a portion of the

¹² This failure is even more glaring because the Examiner, during the original prosecution of the related '650 Patent, found the workstation of Clark could not support additional components in the workstation while maintaining stability due to its top-heavy design.

workstation that projects from the center support in the forward direction; and

second, because adding relatively heavy compartments to the workstation of Clark

would render the cart excessively top-

heavy and unstable and prone to toppling

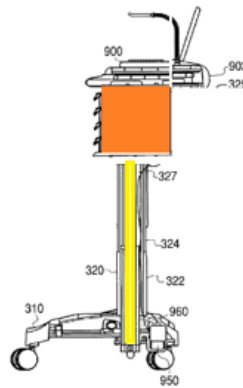
over (e.g., thus unsatisfactory for its

intended purpose). In other words, the

cart of Clark teaches an inherently top-

heavy cart (e.g., the height adjustable

workstation is mounted entirely to the top



'668 Patent, Figure 12
(altered to be top-heavy
like Clark and Reeder)

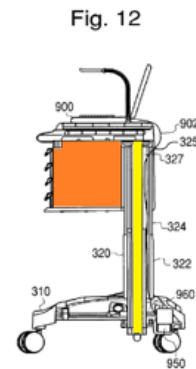


Fig. 12

'668 Patent, Figure 12 (as
shown in '688 Patent),
having lower center of
gravity.

of a center support column), and adding heavy compartments to this already top-

heavy design would make it even more unstable. Adding compartments to the cart

of Clark would result in a cart that looks like the annotated cart shown here on the

left (which is top-heavy compared to the cart of the present invention shown on the

right). Ex. 2001, Decl. of Ben-Tzvi, para. 39. Thus, not only does Clark fail to

teach or suggest such limitations, but a PHOSITA would avoid modifying the top-

heavy workstation of Clark with compartment(s) to preserve balance and stability.

Again, Petitioner makes the same arguments relating to the Clark reference

that were overcome during the original prosecution. The Clark reference was

similarly overcome during the prosecution of the patents-at-issue in view of other

secondary references (like the Ellefson reference) that allegedly taught pivotal trays.

See, Ex. 2003, '650 file history, Applicant Response and Amendment dated 03/28/2012, pgs. 8-10 (overcoming the Clark reference by stating that a PHOSITA would not modify Clark in this manner because if an additional component (e.g., pivotal tray) was added to the already top-heavy workstation of Clark, it would not work for its intended purpose as it would be more susceptible to being toppled over). Ex. 2001, Decl. of Ben-Tzvi, para. 40.

C. Modifying Clark with Manner Would not Reach the Claimed Invention

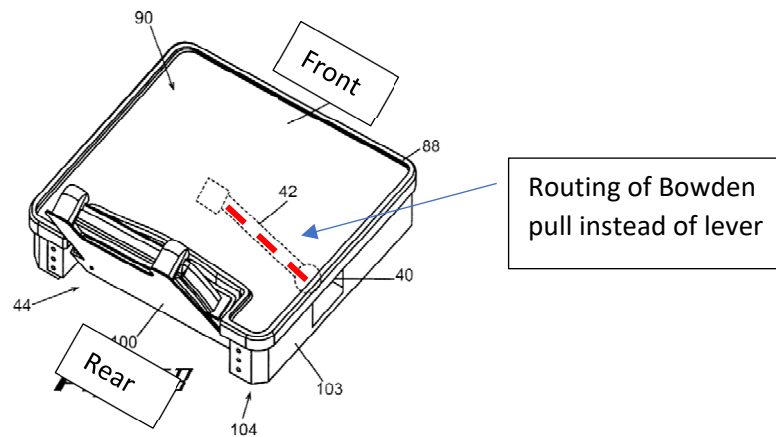
Petitioner relies on Manner only for the limitation relating to the location of the actuator, thus Manner does not cure the deficiencies of Clark discussed above. Ex. 2001, Decl. of Ben-Tzvi, para. 42. However, even if the Board should find that Clark teaches the other claimed elements discussed above as Petitioner alleges, Petitioner admits that Clark fails to teach or suggest the claimed feature generally involving locating an actuator for controlling height adjustment operations “above the compartment(s) and on the portion of the work platform that projects in the forward direction”, instead citing to Manner. *E.g.*, '668 IPR Petition at pg. 39, claims 3-4.

The cited passages of Manner at best teaches placing the actuating device 80, and specifically user-interactive grip 82 portion thereof within a holder 83 underneath a “compartment-less” table surface. *E.g.*, Petition at pg. 39 (citing figure

5, col. 9 ll. 26-28). Indeed, the cited passages state that, “[t]his grip 82 is fastened within a holder 83 that is connected to the underside of the table top 1 and is pivotable in the holder 83.” *Id.* Initially, as Manner fails to teach or suggest compartments, Manner necessarily cannot teach or suggest placing the actuating device, and specifically the grip portion 82 thereof, above any such non-existent compartments. Ex, 2001, para. 43.

Nevertheless, Manner at best teaches routing a Bowden pull 81 a column and outward below a next horizontal surface. In this fashion, while it is not clear how Petitioner would modify Clark with Manner, it is clear that incorporating the teachings of Manner into Clark would motivate a PHOSITA to place the alleged actuator below the alleged work platform (the tray 12) of Clark, or at least below the alleged work surface in view of Manner’s teachings, rather than above it. Thus, even if Clark’s release lever 42 were substituted with the Bowden pull 81 of Manner as asserted by Petitioner, the Bowden pull 81 would remain *within* the alleged compartment of Clark. Ex. 2001, para. 44.

At best, a “simple substitution” of the release lever 42 of Clark with the Bowden pull 81 of Manner, as proffered by Petitioner, would result in a laterally extending Bowden pull 81 instead of the laterally extending release lever 42. An annotated version of figure 5B from Clark is provided below to illustrate this hypothetical arrangement. Ex. 2001, para. 45.



There is no specific description in Manner stating that the actuator should be place above compartments or how doing so could be accomplished. For one, Manner teaches a “compartment-less” table. Petitioner’s heavy reliance on the brief statement in Manner that “[t]he holder 83 can be connected at any desired location to the table top 1 so that the actuating device 80 can be easily activated by the user” is misplaced. ’668 IPR Petition at pg. 51. This brief statement in Manner suggesting a vague, possible modification to the “compartment-less” table of Manner is aspirational at best, and at a minimum is far removed from Petitioner’s specific alleged modifications to the portable workstation of the cart of Clark needed to reach the claimed invention. In other words, Petitioner is essentially arguing that a PHOSITA would be motivated to modify the cart of Clark to place the actuator above compartments based on a proposed modification to the “compartment-less” table of Manner. A meritless and conclusory assertion. Ex. 2001, para. 46.

Even still, the addition of Manner does not cure other deficiencies of the primary references of Clark previously discussed. For example, this proposed modification does not cure the failure of the top-heavy cart of Clark to teach the disposing compartments in a portion of a work platform projecting from the height adjustment mechanism in the forward direction as previously discussed. Ex. 2001, para. 47.

In view of the foregoing, Patent Owner respectfully submits that the addition of Manner does not cure the deficiencies of Clark. At a minimum, these unanswered questions render any combination of Clark with Manner not *prima facie* obvious, easy, and/or a matter of simply rearranging or substituting known components. Ex. 2001, para. 48. For at least these additional reasons, Patent Owner respectfully submits that the combination of Clark with Manner is not obvious. *Id.*

D. Deficiencies in Reeder

While Patent Owner disputes that Reeder teaches any height adjustable compartments, even if the Board finds that the cited elements (e.g., unenclosed wire trays and side bins) are “compartments”, such compartment(s) are not disposed in a work platform and are not height adjustable as required. Additionally, Petitioner’s arguments with respect to the top-heavy, unstable, cart of Reeder are substantially the same as the arguments with respect to the Clark reference that were already considered and overcome during the original prosecution. Petitioner fails to address

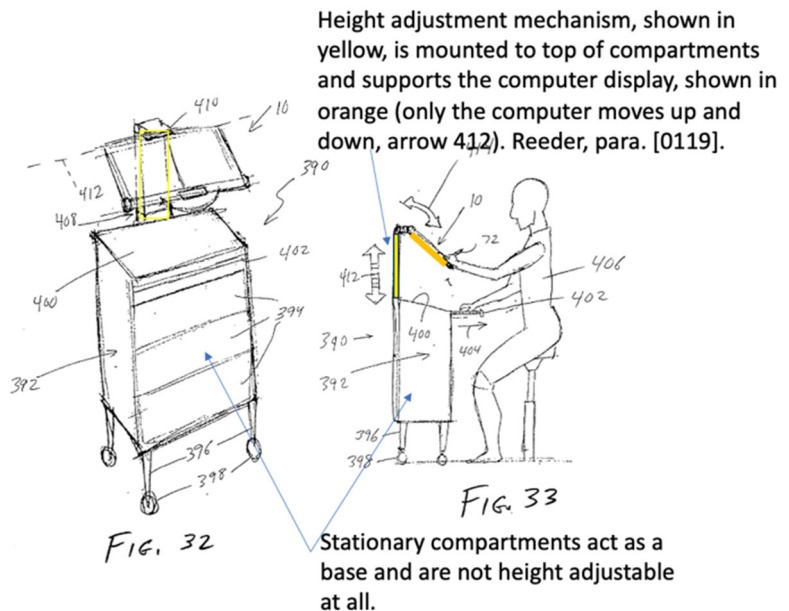
how Petitioner's proposed modification of adding compartments to the computer workstation of Reeder is different than the Examiner's prior consideration of Clark in combination with Ellefson or Murphy and fails to address, much less overcome, critical arguments made during prosecution in overcoming Clark (e.g., Clark's (and now Reeder's) unstable/top-heavy design which is prone to toppling due to additional weight from alleged modifications to the workstation). Thus, Petitioner fails to reasonably distinguish the Examiner's prior consideration of the prior art.

1. Reeder Fails to Teach or Suggest Height Adjustable Compartment(s)

Reeder, like Clark, teaches a height adjustable computer workstation, but does not teach or suggest enclosed compartments (e.g., drawers) as part of the workstation or how it can be accomplished. Like Clark, Reeder teaches a top-heavy workstation with a higher center of gravity that cannot support heavy components, like compartments, while maintaining stability. The only embodiments of Reeder that include enclosed compartments (e.g., drawers) configure the compartments at the stationary base cabinet which is not height adjustable. Reeder, figures 30, 32-33; *supra* section VI.B. Petitioner points to various other components of Reeder as the alleged compartments, none of which meet the requirements of the challenged claims (in embodiments of Figures 31, 45-46 of Reeder). More specifically, Petitioner's citations to the unenclosed wire storage tray 372 and/or storage

containers 718 are unavailing as they fail to meet the proper definition of “compartments” – *e.g.*, the definition agreed to by the Patent Owner and Petitioner in the on-going Litigation and the W.D.N.C. claim construction order – which requires the compartments to be enclosed. ’668 IPR Petition at pg. 47 (citing figure 31 of Reeder). Additionally, as explained in detail in the next section of this response, these wire trays and storage bins are not “disposed in” anything, much less a height adjustable work platform as recited in the claims at-issue. *See infra*, Sections VII.D.2; Ex. 2001, Ben-Tzvi Decl. at para. 49.

The only brief mention in Reeder of using drawers 346, 394 is with regard to the embodiment shown in figures 30 and 32-33, none of which are height adjustable. Reeder, Figs. 30, 32, 33, *e.g.*, para. [0117]-[0119].¹³ Presumably,



this is because the top-heavy embodiment of Reeder figures 31, 45-46 lack the

¹³ Reeder fails to make any reference to use of drawers 346, 394 with respect to the top-heavy embodiments of figures 31 or 45-46. *See id.* Notably, while beginning with a discussion of figures 30-33, Reeder expressly move away from figure 31 in its discussion regarding the drawers 344, 392. *See id.*

requisite central base portion 344, 392 in which to dispose such drawers 346, 394.

Id. Instead, Reeder uses fixed, forward legs 396 and/or base 342 to provide needed stability in this regard. Reeder, *e.g.*, figures 30, 32, para. [0117], [0119]. Notably, these embodiments instead provide height adjustability to a computer 10 by way of a telescoping arm 408, such as highlighted in the annotated version of figure 33 below. *E.g., Id.* at para. [0119]. Reeder presumably moved to this approach with a stationary set of drawers and height adjustable computer 10 in these embodiments to provide stability/balance. Ex. 2001, Ben-Tzvi Decl. at para. 50.

Reeder fails to teach or suggest making the alleged compartments part of a height adjustable work platform as claimed. At a minimum, Petitioner provides only conclusory allegations in this regard, alleging that modification is a matter of simple substitution, and fails to address this balance/stability consideration. '668 IPR Petition at 68-69. As discussed in more detail below, on the contrary, a PHOSITA would not be motivated to add compartments to the height adjustable workstation/work surface of Reeder as the already top-heavy workstation of Reeder (like Clark) would be easily toppled over from the added weight. If anything, Reeder teaches away from height adjustable compartments, as the only embodiments of Reeder that describe compartments configure the drawers as part of a stationary base that are not height adjustable at all (Reeder figures 30, 32-33). It is improper for Petitioner to use the teachings of the '668 and '650 Patents, in hindsight, as a

blueprint for combining or modifying references to meet the claimed inventions. Ex.

2001, Ben-Tzvi Decl. at para. 51.

In view of the foregoing, Patent Owner respectfully submits that Reeder fails to teach or suggest the claimed height adjustable compartment(s).

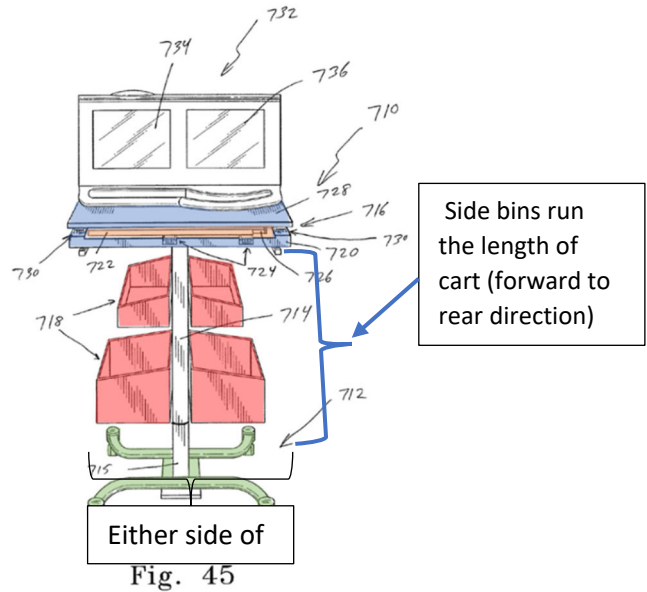
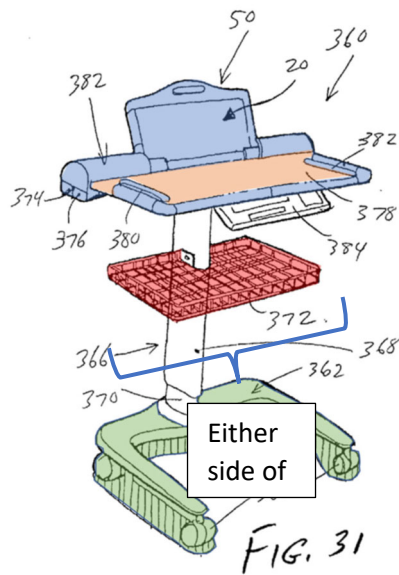
2. Reeder Fails to Teach or Suggest Compartment(s) “Disposed in the Portion of the Work Platform that Projects from the Height Adjustment Mechanism in the Forward Direction”

A quick look at the figures of Reeder shows that Reeder only teaches a height adjustable computer workstation (that does not have enclosed “compartments” as claimed). Even assuming that Reeder teaches “compartments”, none of the cited wire storage tray 372 and storage containers 718 or drawers 394 are disposed in the alleged height adjustable work platform, much less in a portion of an alleged work platform that projects from the height adjustment mechanism in the forward direction as recited in the claims at issue. Petitioner incorrectly interprets the teachings of Reeder and wrongly assumes that Reeder teaches this limitation (relying on Figures 31, 45). *See* ’668 IPR Petition, pgs. 66-69, Kemnitzer, at 144-147. Ex. 2001, para. 52.

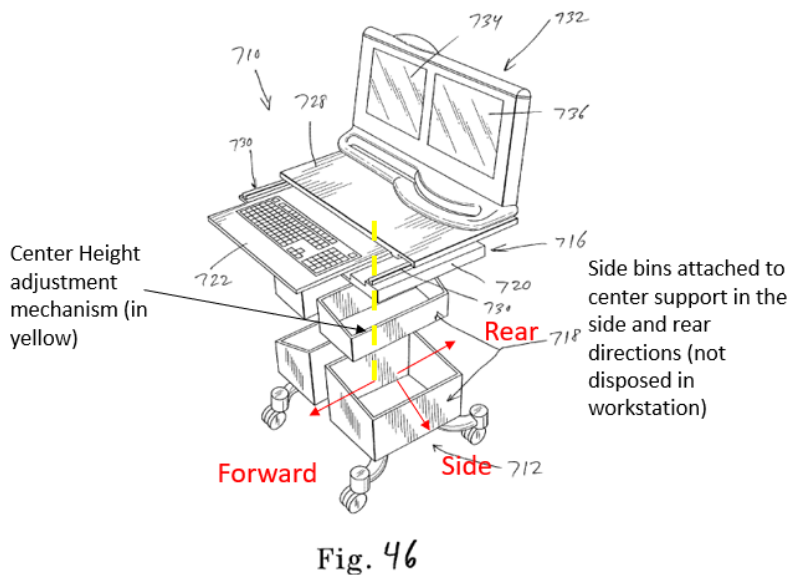
Again, Petitioner takes an unreasonably broad, unsupported and impossible interpretation of the claim terms “the compartments are disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward

direction.” For example, Petitioner essentially argues that a front area (or front pocket of space) of their alleged compartment meets this limitation. *See* ’668 IPR Petition, pgs. 66-68 (arguing that the front space of the wire trays and side bins of Reeder meets this limitation). In an attempt to stretch Reeder’s teaching to meet the claims, Petitioner’s argument essentially divides the alleged compartments into separate, fractional pockets of space/air. Again, such an interpretation is unsupported and contrary to a reasonable reading of the ’668 Patent as previously discussed above with respect to the Clark reference. Ex. 2001, para. 53.

Inspection of the side view of the cart of Reeder illustrates that these wire trays and side bins of Reeder merely hang off the center support and are not “disposed in” anything, much less in the portion of the alleged work platform that projects from a height adjustment mechanism in the forward direction as specifically claimed in the claims at-issue. Reeder at figures 31, 45-46. For example, similar to Clark, the wire tray and side bins of Reeder hang off the sides and to the rear of the central support 714, and therefore are disposed outside of a portion of the work platform that projects from the height adjustment mechanism in the forward direction. The annotated versions of figures 31 and 45 from the Petition are reproduced below with further annotations to demonstrate this distinction. ’668 IPR Petition at pgs. 57-58, Ex. 2001, para. 54.



This distinction is better illustrated in the perspective view of Figure 46 of Reeder. As illustrated in the annotated Figure 46 of Reeder shown here, even if the wire tray and side bins of Reeder are considered “compartments” (which they are not as they are not enclosed in anything), they



hang off the side of the height adjustment mechanism (center vertical support 714) and run the entire length (forward to rear) of the cart and thus are not “disposed in

the portion of the work platform that projects from the height adjustment mechanism in the forward direction”. Thus, Reeder fails to teach or suggest all of the claimed embodiments, alone or in combination. Ex. 2001, para. 55.

The Petition should also be denied because Petitioner fails to articulate any basis for why a PHOSITA would be motivated to modify the cart of Reeder to include a compartment “disposed in the portion of the work platform that projects from the height adjustment mechanism in the *forward direction*” as claimed. Petitioner instead mistakenly assumes that side bins and wire trays or substituted drawers¹⁴ of Reeder meet this limitation and thus Petitioner completely fails to articulate a motivation to combine or modify Reeder to reach this limitation.¹⁵ See ‘668 IPR Petition at 66-69, Kemnitzer, 144-147. For example, Petitioner alleges in conclusory fashion that a PHOSITA would know to add drawers to the “bottom side of the work platform” but never opines on if a PHOSITA would be motivated to dispose drawers in a height adjustable work platform, how it would be accomplished, or that there would be a reasonable expectation of success in view of Reeder’s centrally located support column and top-heavy design. *TQ Delta LLC v. Cisco Sys.*,

¹⁴ Petitioner states in conclusory fashion that a PHOSITA would know to substitute drawers for the side bins or trays shown in Reeder, yet this substitution, if even successful, would also not reach the invention as any substituted drawers, like the side bins and trays, would also be disposed outside the forward-projecting portion. ‘668 IPR Petition, pg. 68.

¹⁵ Petitioner cites to the Ellman reference for support, but Ellman does not teach height adjustable compartments at all much less disposed in a portion of the work platform projecting from a height adjustment mechanism in the forward direction. ‘668 IPR Petition, at pg. 68.

PHOSITA would combine references “in the way the claimed invention does.”)

This failure alone amounts to a basis for denying the Petition as Petitioner has failed to demonstrate all the required proof for meeting a *prima facie* case of obviousness.

Ex. 2001, para. 56.

As discussed, even though no rebuttal is necessary here, there is no motivation or reasonable expectation of success of modifying Reeder to include compartments in a forward-projecting portion of a height adjustable work platform because 1. the alleged work platform of Reeder is mounted on entirely on top of a centrally located support, thus there is insufficient space to dispose compartments in a portion of the workstation that projects from the center support in the forward direction; and 2. as successfully argued during the prosecution of the related ‘650 Patent in overcoming Clark, a PHOSITA would not be motivated to dispose additional, heavy components, such as storage compartments, in the already top-heavy workstation of Reeder as doing so would destabilize the cart of Reeder, rendering the workstation more readily prone to toppling over.

Mirroring the arguments made in the prosecution of the ‘650 Patent in overcoming Clark: if a PHOSITA had tried to incorporate the heavy compartments into the workstation of Reeder in the manner claimed, the resulting workstation would be top-heavy, particularly when the compartments were deployed. The result

is that the compartments would make the workstation of Reeder unstable so that it would be easily knocked over. Notably, in this regard Reeder teaches the cited embodiment of figure 31 as having a “*central* pedestal 366” and the cited embodiment of figure 45 as likewise having a “*center* vertical support 714,715.” Reeder, paras. [0118], [0148], respectively (emphasis added). On the contrary, the claimed compartments work in the cart of the ’668 invention because the claimed cart has a different, lower center of gravity, a condition lacking in Reeder. In other words, the overall design of the inventive cart of the ’668 Patent (including its lower, different center of gravity) permits the use of height adjustable compartments while the workstation of Reeder (with its different, higher center of gravity) does not. Accordingly, a PHOSITA would not modify or combine the teachings of Reeder so as to arrive at a height-adjustable work platform with compartment(s) “disposed in a portion of the work platform that projects from the height adjustment mechanism in the forward direction”. The inventor of the ’668 Patent was the first to think of placing the height adjustment mechanism at the rear of the height adjustable work platform allowing ample space to dispose the compartments in a forward-projecting portion of a height adjustable work platform resulting in cart with a lower center of gravity. Ex. 2001, para. 57.

E. Modifying Reeder with Manner Would not Reach the Claimed Invention

Manner is cited by Petitioner here solely for allegedly teaching the recited location of the actuator. '668 IPR Petition at pg. 81-83. Thus, at a minimum, the addition of Manner does not cure other deficiencies of the primary references of Reeder previously discussed. For example, Manner does not cure the failure of the top-heavy cart of Reeder to teach the disposing of compartments in a portion of a work platform projecting from the height adjustment mechanism in the forward direction as previously discussed.

F. Adding Santoro Does Not Cure the Deficiencies in Clark or Reeder (Alone or modified with Manner)

Santoro is cited by Petitioner solely for allegedly providing the drawer slides of challenged claim 3. '668 IPR Petition at pg. 49, 52. Thus, at a minimum, the addition of Santoro does not cure the foregoing deficiencies of primary references Clark and Reeder. Notably, Santoro is cited on the face of the '668 Patent.

G. Adding Gillis Does Not Cure the Deficiencies in Clark or Reeder (Alone or Modified with Manner)

Gillis is cited by Petitioner solely for allegedly providing Petitioner's narrower, improper definition of work surface. '668 IPR Petition at pg. 54. Thus, at a minimum, the addition of Gillis, even if required, does not cure the foregoing deficiencies of primary references Clark and Reeder.

H. Arguments Against Petitioner’s Expert Testimony

1. Generally

Respectfully, Petitioner’s Expert, Mr. Kemnitzer, has qualification that fail to meet Patent Owner’s proffered definition of a PHOSITA. Notably, Mr. Kemnitzer’s education and experience is in industrial design, rather than mechanical engineering. *E.g.*, Ex. 1004 at ¶ 4-6. Such qualifications are directed more toward aesthetics than hard science. Mechanical engineering concerns are at the core of certain deficiencies in Mr. Kemnitzer’s analysis, as further described herein. Ex. 2001, para. 58.

Furthermore, Mr. Kemnitzer, applies the “plain and ordinary meaning of each claim term” for each claim term. Ex. 1004 at ¶ 23. Thus, the Mr. Kemnitzer’s testimony fails to address any of the claim construction issues argued herewith.

For at least the foregoing reasons, Patent Owner respectfully requests that the Board give little to no weight to Mr. Kemnitzer’s testimony.

Further deficiencies in Mr. Kemnitzer’s analysis are described herein.

2. Deficiencies in Mr. Kemnitzer’s Analysis with Particular Regard to Clark

Mr. Kemnitzer’s analysis with regard to Clark is based on fundamental misapprehensions and/or misrepresentations of what Clark teaches in multiple instances.

Mr. Kemnitzer testifies that “[t]hough not shown in the figures, Clark explains that the cavity may be a drawer”. Ex. 1004 at ¶ 59 (citing figures 4A-4B and col. 10 ll. 30-33). This is incorrect. This passage, at best, teaches placing a separate drawer or pull-out tray above or below the tray 12. This passage does not state that such a drawer or pull-out tray is attached to the tray 12 or moveable therewith. Ex. 2001, para. 59.

Mr. Kemnitzer notes that “Clark’s gas spring driver is controlled by a release lever 42 that extends through¹⁶ ‘an opening in the side of a horizontal tray.’ Clark, 10:51-62.”. Ex. 1004 at ¶ 47. Based on the aforementioned passage regarding a separate drawer or pull-out tray above or below the tray 12 of Clark, Mr. Kemnitzer concludes that, “a POSITA implementing the drawer embodiment recited in Clark would have recognized the interior drawer contents would compromise the functionality of the lever 42, for example, by preventing actuation or unintentionally activating lever 42.” *Id.* However, Clark presumably teaches this above/below relationship because locating such a drawer within the tray 12 would interfere with

¹⁶ Notably, the cited passage of Clark provides no such teaching. Presuming Petitioner’s Expert intended to cite the corresponding lines from column 9 in Clark, this passage makes it clear that the release lever 42 is located *within* the tray 12 rather than “extending *through* ‘an opening in the side of a horizontal tray’” as alleged by Mr. Kemnitzer. Clark, 9:51-62 (emphasis added). Indeed, Clark teaches that “[t]o raise the tray, the operator places *his or her hand through* an opening 40 in the side of the horizontal tray 12... [to] lifts[] a release lever 42...” Col. 9 ll. 56-60 (emphasis added). This is consistent with the top, perspective view in figure 5B where the release lever 42 clearly resides within the tray 12.

the release lever 42. If the drawer of Clark is placed above or below the tray 12, there would be no interference with the release lever 42 since Clark teaches that the release lever 42 is disposed *within* the tray 12. Thus, Mr. Kemnitzer's concern about interference with the release lever 42 actually teaches away from placement of the drawer or other such compartment(s) within the tray 12 of Clark as alleged by Petitioner. Ex. 2001, para. 60.

In this regard, Mr. Kemnitzer's cited concern of "a hole in the side of the horizontal tray would compromise the functionality of the drawer because the interior drawer contents would be accessible from the side through the hole" is likewise without merit as Clark teaches placing the alleged drawer above or below the tray 12, rather than within it. Ex. 1004 at ¶ 47; Ex. 2001, para. 61.

Furthermore, Mr. Kemnitzer's analysis appears to be predicated on the notion that Clark teaches or suggests modifying the tray 12 to include anything other than a keyboard tray. *See* Ex. 1004 at ¶ 47. For example, Mr. Kemnitzer's analysis discusses the "security of health information (medical histories, test results, prescriptions, etc.,) as well as the medications themselves" as presumably being placed in these areas. *Id.* However, Clark expressly teaches that the tray 12 is used to support a pull-out keyboard tray 70 stowable therein. *E.g.*, col. 11 ll. 40-50. And the cited drawer embodiment of Clark is expressly used for the docking station 18, which is used to store a wireless computer terminal 20 with a display screen. *E.g.*,

col. 8 ll. 58-61, col. 10 ll. 30-33. Thus, Clark fails to teach or suggest storing other components in these areas. This deficiency is not addressed in Mr. Kemnitzer's testimony or otherwise by Petitioner. This is demonstrative of the hindsight nature of the analysis in Mr. Kemnitzer's testimony and used by Petitioner more generally to arrive at its conclusions. Ex. 2001, para. 62.

In view of the foregoing, Mr. Kemnitzer's testimony, and Petitioner's analysis adopting the same, is deficient at least for using hindsight bias and providing meritless alleged motivations to modify Clark. *Id.*

Additionally, recognizing the deficiency in Clark with regard to multiple *arguendo* compartments, Mr. Kemnitzer declares that it would have been obvious to "...subdivide the cavity in Clark with multiple drawers...." Ex. 1004 at ¶ 60. This is notable as Petitioner's expert admits that this area as a "cavity" rather than a functional "compartment". *See id.* Also, because Mr. Kemnitzer's analysis fails to consider the stated purpose of the cavity in Clark as a pull-out keyboard tray. *E.g.*, col. 11 ll. 40-50. Mr. Kemnitzer's analysis fails to explain how this cavity of Clark could still be used for its intended purpose as a keyboard tray if it were subdivided. Indeed, if the cavity of Clark were so subdivided it could no longer accommodate a keyboard tray, which would extend all or substantially all the lateral width thereof. Ex. 2001, para. 63.

For at least this additional reason, Mr. Kemnitzer's testimony, and Petitioner's analysis adopting the same, is deficient and should be afforded little to no weight. *Id.*

Further still, Mr. Kemnitzer's analysis fails to consider the resulting top-heavy nature of a modified Clark as proposed. As discussed herein, the proposed modifications to Clark are not a matter of simple substitution, particularly considering such a substitution would result in a further destabilized and top-heavy cart prone to tipping. *Id.*

VIII. Discretionary Denial is Appropriate Under 35 U.S.C. § 325(d) and *Advance Bionics*

While Petitioner's *Sotera* stipulation¹⁷ is appreciated, it does not end the Board's analysis. The Board should exercise its discretion to deny instruction under 35 U.S.C. § 325(d) and the *Advanced Bionics* framework. *Advanced Bionics, LLC v. MedEl Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020), *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017). The *Advance Bionics* decision adopts the non-exclusive factor analysis of *Becton, Dickinson* to consider:

¹⁷ Without the *Sotera* stipulation the *Fintiv* factors weigh heavily in Patent Owner's favor. In view of the USPTO's current guidance on *Fintiv* and *Sotera* stipulations, Patent Owner believes a further discussion is not required. However, should the Office's position change, Patent Owner reserves the right to revisit the *Fintiv* analysis.

(a) the similarities and material differences between the asserted art and the prior art involved during examination;

(b) the cumulative nature of the asserted art and the prior art evaluated during examination;

(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;

(d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;

(e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Here, as acknowledged by Petitioner, one of the two primary references, Clark, and one of the secondary references, Santoro, are listed on the face of the '668 Patent. Furthermore, Clark's equivalent was discussed during prosecution of the related and co-challenged '650 Patent. *See e.g.*, Ex. 2003, OAR of 3/28/2012 in '650 Patent. In its response, the Applicant argued a distinction similar to what is argued in several instances herein against both primarily cited references, Clark and Reeder. *E.g., id.* at pg. 8-9. Essentially, the Applicant argued that a PHOSITA would not be motivated to modify already top-heavy carts of Clark to include additional heavy

components in the manner claimed as the resulting device would be impermissibly top-heavy and prone to tipping over. Patent Owner maintains this position herein. It was not until the '668 Patent that this problem was solved.

The substitution of different secondary references does not change this analysis. For example, Gillis is only cited to supply a relatively minor element based on a possible, alternative claim term definition, which is not critical to the arguments provided herein or during examination of the '668 and/or '650 Patents. And, Manner is similarly only relied upon to provide a relatively minor element and does not cure the fundamental deficiencies of Clark and Reeder.

Furthermore, as the '668 Patent and the '650 Patent share a common priority claim, shared a common Examiner, and were prosecuted around the same time, the Office was well aware of the relevant art and Applicant's position regarding the same. Particularly with the foregoing in mind, it would be unfair to punish Patent Owner because the Office allowed the '668 Patent without an initial rejection. The quick allowance by the Office of the '668 Patent instead is demonstrative of how strongly the Office rightfully felt that the '668 Patent was patentable, especially in view of its familiarity with the subject matter and relevant art.

While Petitioner attempts to stir up a non-existent controversy surrounding prosecution strategy in support of proceeding with the *inter partes* review, Applicant notes that the same Examiner considered the abandoned parent application (US App.

No. 10/783,030) and the '668 Patent. Thus, the same Examiner was certainly well aware of his own thoughts as well as the relevant art when considering the '668 Patent, by citation in the '668 Patent, personal knowledge, and/or Office policy on examination of related applications.

The Petition is essentially an attempt to get another bite at the apple. The Office rightfully decided that the '668 Patent was allowable. That decision should not be disturbed by Petitioner's attempt to revisit this decision with primarily the same art and arguments already considered (especially here where Petitioner fails to address/distinguish the Examiner's prior consideration of Clark). Furthermore, despite the *Sotera* stipulation, Patent Owner notes that the parallel litigation is well underway and a trial set for before any instituted *inter partes* review is likely to be completed. It is also notable that little life remains on the '668 Patent. Thus, if nothing else, the Office's resources are better spent elsewhere. Therefore, Capsa respectfully submits that the Board should exercise its discretion to deny institution of the requested *inter partes* review.

IX. Conclusion

Far from establishing a reasonable likelihood of success, analysis of the Petition reveals glaring weaknesses in Petitioner's arguments. Furthermore, despite a *Sotera* stipulation, several factors weigh heavily in favor of discretionary denial.

Preliminary Response by Patent Owner in IPR2023-01274

US Pat. No. 7,594,668

Dkt. No. CAP2491-144

Therefore, and for at least the reasons more fully set forth above, the Petition for *inter partes* review of the '668 Patent should be denied.

Date: November 29, 2023

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Preliminary Response by Patent Owner in IPR2023-01274

US Pat. No. 7,594,668

Dkt. No. CAP2491-144

CERTIFICATE OF COMPLIANCE

In accordance with 37 C.F.R. 42.24, the undersigned certifies that according to the Microsoft Word application used to prepare this Preliminary Response by Patent Owner Under 37 C.F.R. § 42.107, the word count of this document, excluding portions exempt from the word count rules, is less than 14,000 words and is, in fact, 13,837 words (including footnotes).

Date: November 29, 2023

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Preliminary Response by Patent Owner in IPR2023-01274
US Pat. No. 7,594,668
Dkt. No. CAP2491-144

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that the foregoing Preliminary Response by Patent Owner Under 37 C.F.R. § 42.107 and the Patent Owner's Exhibits referenced in the Table of Exhibits were served via electronic mail on November 29, 2023, on the following counsel of record for Petitioner as follows:

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