

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOWARD INDUSTRIES, INC.
Petitioner,

v.

CAPSA SOLUTIONS LLC

Patent Owner.

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

Case No. IPR2023-01274

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

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*All emphasis added unless otherwise indicated.

LIST OF EXHIBITS

Exhibit #	Description
1001	U.S. Patent No. 7,594,668 (“’668 patent”)
1002	Prosecution File History of U.S. Patent No. 7,594,668
1003	Prosecution File History of U.S. Patent Application No. 10/783,030 (’668 Parent Application)
1004	Declaration of Mr. Ronald B. Kemnitzer (“Kemnitzer”)
1005	Curriculum Vitae of Mr. Ronald B. Kemnitzer
1006	U.S. Patent Publication No. 2002/0044059 to <i>Reeder et al.</i> (“ <i>Reeder</i> ”)
1007	U.S. Patent No. 5,682,825 to <i>Manner</i> (“ <i>Manner</i> ”)
1008	U.S. Patent Publication No. 2002/0145088 to Santoro et al. (“Santoro”)
1009	RESERVED
1010	U.S. 6,493,220 to <i>Clark</i> (“ <i>Clark</i> ”)
1011	U.S. 4,440,096 to Rice (“Rice”)
1012	<i>Capsa Solutions LLC v. Howard Indus. Inc.</i> , No. 2:22-cv-00065-HSO-BWR, Dkt. 42-1, Joint Claim Construction Chart (S.D. Miss Apr. 26, 2023)
1013	Claim Construction Order for U.S. Patent No. 8,215,650 in <i>Rubbermaid Inc. v. Ergotron, Inc.</i> , No. 3:12-cv-416-RJC-DSC, Dkt. 42 (W.D.N.C. Mar. 11, 2014)
1014	U.S. Patent No. 4,715,295 to Hartman (“Hartman”)
1015	U.S. Patent No. 5,806,943 to Dell (“Dell”)
1016	U.S. Patent No. 5,408,940 to Winchell (“Winchell”)
1017	European Patent Specification EP 0 680 433 B1 to Foster (“Foster”)
1018	U.S. Patent No. 5,518,310 to Ellman (“Ellman”)
1019	U.S. Patent Publication No. 2003/0084828 to Gillis (“Gillis”)
1020	U.S. Patent Publication No. 2002/0013640 to Phoon
1021	U.S. Patent No. 5,564,803 to McDonald
1022	U.S. Patent No. 4,790,611 to Craner
1023	U.S. Patent No. 5,598,789 to Jonker
1024	Camloc Motion Control Ltd., <i>Understanding the Basics of Gas Spring Application</i> , (Apr. 1, 2019), https://www.techbriefs.com/component/content/article/tb/supplements/md/features/articles/34117
1025	German Patent Application DE 102 56 419 A1 (with English certified translation)
1026	U.S. Patent No. 5,870,647 to Nada
1027	U.S. Patent No. 6,595,144 to Doyle
1028	U.S. Patent No. 6,119,605 to Agee

Exhibit #	Description
1029	Howard Industries, Inc.’s Preliminary Claim Construction Reply Brief, <i>Capsa Solutions LLC v. Howard Indus. Inc.</i> , No. 2:22-cv-00065-HSO-BWR, Dkt. 46, (S.D. Miss May 26, 2023)
1030	Howard Industries, Inc.’s Preliminary Claim Construction Reply Brief, <i>Capsa Solutions LLC v. Howard Indus. Inc.</i> , No. 2:22-cv-00065-HSO-BWR, Dkt. 48, (S.D. Miss June 16, 2023)
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)
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, (S.D. Miss June 16, 2023)
1033	Prosecution File History of U.S. Patent No. 8,215,650

Discretionary denial under § 325(d) is improper under Step One of *Advanced Bionics*, ending the analysis. The Office was never made aware of *Reeder* or *Manner* during original prosecution. And to the extent the Office considered *Clark* before, the Petition demonstrates how the Office erred in granting the '668 patent over *Clark*. Thus, under either step of the of the *Advanced Bionics* two-step framework, the Board should reject Capsa's demand to deny the Petition under 35 U.S.C. § 325(d).

I. Denial under 325(d) is improper under *Advanced Bionics*

Under § 325(d), the Board first considers “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper No. 6, 8 (P.T.A.B. February 13, 2020) (precedential). “[I]f either condition of first part of the framework is satisfied,” the Board considers “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Id.*

A. *Advanced Bionics*, Part 1 – The Office Has Never Considered the Petition's Art or Arguments

1. *Becton, Dickinson* Factors (a) and (b) Favor Institution

Petition grounds 1-4 each present new art and arguments not considered by the Office before. Indeed, Patent Owner's repeated suggestion that the Examiner

substantively considered *Clark* during prosecution in 2008-2009 provides a false narrative. *Clark* was never substantively discussed during prosecution of the '668 patent. *Amgen Inc. v. Alexion Pharm., Inc.*, IPR2019-00739, Paper 15 at 62 (P.T.A.B. Aug. 30, 2019) (“[t]he Board has consistently declined exercising its discretion under Section 325(d) when the only fact a Patent Owner can point to is that a reference was disclosed to the Examiner during the prosecution.”); *see also Amber.io, Inc. v. 72Lux, Inc.*, IPR2020-00015, Paper 8 at 19-20 (P.T.A.B. Apr. 1, 2020). Moreover, each of Grounds 1-4 include *Manner* as a secondary reference. Thus, while *Clark* is cited on the face of the '668 patent, the petition's combination of *Clark* and *Manner* is also new. During prosecution of the parent Application No. 10/780,030 (the “'030 application”), the Office considered *Clark* with another reference (*Rice*) with a control panel 30 cited for the claimed actuator position above the compartments on the work platform. Ex. 1003, 13, 44-45; *Rice*, Fig. 1, 2:35-50. *Manner* supplies this claim element via a mechanical relocatable actuator using a bowden pull cable, and *Manner* explains that its actuator may be substituted for a level actuator like that found in *Clark*. Pet. §§ VI.C.12, VII.A.11, IX.C.12, X.A.11. The Office never considered such a combination of *Clark* or *Reeder* with *Manner*.

Grounds 3-4 also apply an entirely new primary reference, *Reeder*, that was never considered by the Office. *See* '668 patent, (56); Ex. 1002; Ex. 1003. *Reeder* differs from *Clark* in several respects. For example, *Reeder* discloses different

arrangements of compartments compared to *Clark*. Pet. 23-25, 56-59. *Reeder*'s compartments are positioned lower on the cart relative to *Clark*'s compartment, lowering the center of gravity of the cart. This arrangement counters Patent Owner's new arguments that the combination is top heavy. *Reeder*'s base projecting in the forward direction also contributes to the stability of the cart when loading the compartments with items, further distinguishing Capsa's post-grant novelty arguments. Pet. § IX.C.5. *Becton, Dickinson* factors (a) and (b) thus favor institution.

2. *Becton, Dickinson* Factor (d) Favors Institution

All arguments in the Petitioner are necessarily new, as the Applicant made no arguments to the Office during examination of the '668 patent. Ex. 1002. Rather, the prosecution history of the '668 patent contains only a recital of prior art references and no substantive comments in the Notice of Allowability. *Id.*, 91-94. The Patent Owner's Preliminary Response, however, seeks to conjure up a supporting narrative through unresolved comments regarding compactness and mobility made years afterward during prosecution of U.S. Patent No. 8,215,650 (the "'650 patent"). Paper 6, 61-62 (citing Ex. 2003, OAR of 3/28/2012 in '650 Patent). Indeed, the Office Action cited by Patent Owner was mailed more than two years after the '668 patent issued. Moreover, the claim element discussed in the '650 patent involved the work surface being movable to an extended and non-extended position, a requirement that does not appear in claims 3 or 4 of the '668 patent. Ex. 2003, 8 Patent Owner's

arguments, however characterized, were thus not considered during examination of any proceeding involving the '668 patent. *See Unified Patents, LLC v. Lighthouse Consulting Grp.*, IPR2020-00194, Paper 15, 13-14 (P.T.A.B. June 9, 2020) (finding later-filed arguments in proceeding involving related patent were “not previously considered during the prosecution of the [challenged patent].”).

Looking to the prosecution history of the abandoned parent application to the '668 patent, Application No. 10/780,030 (the “'030 application”), likewise finds no arguments similar to the Petition grounds. Rather, the applicants’ arguments in the '030 application involved the location of the claimed actuator, not basic concepts associated with weight distribution and/or center of gravity. Notably, the Examiner applied *Clark* late in prosecution of the '030 application to reject a newly added claim 43 proposing the actuator location as a point of novelty. Ex. 1003 at 60, 66, 267-275, 298-306. Claim 43 and claim 4 of the '668 patent are nearly identical, but claim 43 merely requires that the actuator “is disposed above the compartment and on the work platform” instead of “on *the portion of* the work platform *that projects in the forward direction.*” Ex. 1003 at 60, 668 patent, claim 4. The Examiner *refused* to allow claim 43 over *Clark* and other references, noting it would have been obvious to modify *Clark*’s actuator location, and the application went abandoned. Ex. 1003, 2, 12-13, 45. *Manner* and its relocatable pull cable actuator therefore supplies the only limitation that is different between the rejected claim 43 of the '030 application

and claim 4 of the '668 patent: moving the actuator to *the portion of the work platform that projects in the forward direction.*" Pet. §§ VI.B and VI.C.12; *Manner*, 9:17-31, 9:33-36. The Examiner never considered this combination or arguments.

B. *Advanced Bionics*, Part 2: The Office erred granting the '668 patent

Because step one of the *Advanced Bionics* framework favors institution, the Office need not consider step two. *Advanced Bionics*, 10. Nevertheless, step two favors institution because the Petition demonstrates the Office erred in granting the '668 patent. The Office's remarks when rejecting claim 43 of the '030 application demonstrate that the Office considered nearly identical claims to those of the '668 patent unpatentable over *Clark*. The Office's further remarks in the later-filed '650 patent confirm the error. Ex. 1033, 156-57. There, the Office recognized that *Clark* in view of *Rice* teach that it would have been obvious to position *Clark*'s actuator on the portion of the work platform that projects in the forward direction. *Id.* The petition and its discussion of *Manner*'s relocatable actuator further demonstrate the Office's error in allowing the '668 patent over *Clark*. Thus, step two of the *Advanced Bionics* framework favors institution.

II. Conclusion

For the foregoing reasons, denial under § 325(d) is improper.

Date: January 11, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Reply to Patent Owner's Preliminary Response and Exhibit 1033** were served electronically via email on January 11, 2024, in its entirety on the following:

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Dated: January 11, 2024

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