

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 SUR-REPLY

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TABLE OF EXHIBITS

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.
1003	Prosecution File History of U.S. Patent Application No. 10/783,030 ('668 Parent Application)

I. Introduction¹

Nothing in Petitioner's Reply changes the fact that Petitioner is presenting substantially the same prior art and arguments that were overcome during prosecution. The Clark reference was cited in the '668 Patent and rejections based on Clark combined with Ellefson or Murphy were overcome during the prosecution of the related '650 Patent. Ex. 2003, '650 File History, Amendment filed 3/28/2012, pgs. 7-12. Petitioner now merely substitutes other alleged compartments for the tray/features of Ellefson/Murphy in Petitioner's combinations with Clark. Petitioner's grounds present substantially the same question of patentability previously considered by the Examiner: whether it would have been obvious to add additional trays/features into the workstation of Clark as claimed. The other secondary references cited by Petitioner are cited for non-dispositive limitations (Manner as to the location of the actuator), alternate constructions (Gillis as to a "curved" work surface), or dependent claims and do not cure the deficiencies of Clark (and now Reeder).

II. Denial under 325(d) is Proper under *Advanced Bionics*

A. *Advanced Bionics*, Part 1 – The Office Considered Petitioner's Art and Arguments

¹ As argued in fn. 1 of the Sur-reply in the '650 IPR, IPR2023-01275, Petitioner's Reply should be struck as it addresses issues outside the scope authorized by the Board.

1. *Becton* Factors (a) and (b) Favor Denial of Institution

Because the same Examiner examined the related '668 and '650 Patents, and the '030 Application, and the claims at-issue are similar and have the same dispositive limitations², it follows that Petitioner is presenting substantially the same prior art and arguments that were made to the Patent Office and were overcome. Specifically, the same Examiner prosecuted all of these applications so he was aware of his prior actions in the previous '030 application and the '668 Patent when he subsequently allowed the claims of the '650 Patent over Clark in view of Ellefson/Murphy. Subsequent to the abandonment of the '030 Application, the Examiner recognized the allowability of the claims of the '668 and '650 Patent after continued prosecution and further development of the arguments by the Applicant. In other words, the prosecution of the '650 Patent, being last, is the culmination of the prosecution of the '030 Application, and the '668 and '650 Patents (especially since the claims addressed in each case are very similar and have the same dispositive limitations).³ Thus, the totality of the circumstances demonstrates that

² For example, all of the claims at-issue from the '030 Application and the '668 and '650 Patents have the dispositive limitations of a height adjustable work platform (including compartments disposed in a forward-projection portion of the work platform), etc.

³ In other words, the same arguments and claim limitations relied upon to overcome the Clark reference in the prosecution of the '650 Patent also apply to the claims at-issue in the '668 Patent.

the Petitioner is presenting substantially the same prior art and arguments that were previously made to the Patent Office 11 years ago, and that were overcome. *Amber.io, Inc. v. 72Lux, Inc.*, IPR2020-00015, Paper 8 at 17-19 (P.T.A.B. Apr. 1, 2020) (finding that the Solonchev and Tarvydas references were deemed considered in the '563 Patent at issue because the references were previously considered in a related '170 divisional application that contained similar claims).⁴

As explained in detail in Patent Owner's Preliminary Responses to the '668 and '650 IPR Petitions and in its Sur-reply relating to the '650 Patent, Reeder is, at most, cumulative and substantially the same to Clark in this context because it describes a top-heavy cart (e.g., like Clark, it has a workstation centrally mounted to the top of the height adjustment mechanism) that does not have the stability to support compartments disposed in the top, height adjustable, workstation portion. Reeder, like Clark, only teaches a cart having a height adjustable computer

⁴ Although Petitioner cites to the *72Lux* case in support of *Becton* factors (a), (b), (d), the Board in that case found for the *Patent Owner* on these factors and only denied discretionary denial under *Becton* factors (c), (e), (f), finding error by the Examiner for failing to substantively consider the Solonchev and Tarvydas references at any time during prosecution of the challenged patent and related applications - a fact that is not present here. *Id.* at 19-21. In the present case, the Examiner did not commit error in allowing the '668 Patent claims over Clark because it *was* substantively considered, and overcome, during the prosecution of the related '650 Patent. The facts of the *Alexion Pharm.* case cited by Petitioner are also distinguishable. In that case, the Bell reference was cited in an IDS but was never substantively discussed in any of the relevant patent applications.

workstation and did not solve the problem of how to include storage compartment(s) as part of the height adjustable workstation while maintaining stability.

2. *Becton* Factor (d) Favors Denial of Institution

As discussed in length in the previous section, the totality of the facts demonstrates that the Examiner considered the Clark reference in combination with Ellefson/Murphy. *Amber.io, Inc. v. 72Lux, Inc.*, IPR2020-00015, Paper 8 at 17-21. Contrary to Petitioner's argument, Petitioner now makes substantially the same arguments overcome during original prosecution. As discussed, Petitioner now merely substitutes other alleged compartments for the tray/features of Ellefson/Murphy in Petitioner's combinations with Clark. Patent Owner also distinguishes Petitioner's allegations with respect to Clark (and now Reeder) in the same way as Applicant overcame these references during prosecution (*e.g.*, that a PHOSITA would not combine, or modify the cart with, other trays/features of secondary references into the workstation portions of Clark as they did not have the stability to support these components, and there is no motivation or reasonable expectation of success to do so). Thus, there is significant overlap between the arguments made during prosecution and the manner in which Petitioner now relies

on Clark (and the cumulative Reeder) and the manner in which Patent Owner distinguishes their teachings from the present invention.⁵ *Becton* factor (d).

B. *Advanced Bionics*, Part 2 – The Office did Not Err When It Allowed the '668 Patent

For the reasons discussed above, the Office did not err in granting the '668 Patent. *See, e.g., supra* fn. 4 (unlike the PTAB decisions relied upon by Petitioner, Clark was substantively discussed at length with the Examiner and overcome in the prosecution of the related '650 Patent after the prosecution of the '030 Application).

III. Conclusion

The Petition for *inter partes* review of the '668 Patent should be denied.

Date: January 18, 2024

Respectfully submitted,

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⁵ Petitioner cites to *Manner* for the limitation relating to the position of the actuator, but what Petitioner fails to acknowledge however, is that during prosecution the Applicant made a number of other arguments around the Clark reference that were used to overcome the Examiner's prior rejections based on Clark that are not cured by the *Manner* reference. For example, the Applicant argued in detail that Clark and the secondary references were deficient because a PHOSITA would not incorporate "*any particular feature* [of Murphy] into the workstation of Clark...and modifying the workstation of Clark (with its higher center of gravity) ...would likely make the resulting workstation top heavy such that it would be easily knocked over." Ex. 2003, '650 File History, Amendment filed 3/28/2012, pgs. 7-12. Petitioner does not cite to any new prior art that addresses these arguments.

Sur-reply 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 Patent Owner's Sur-reply was served via electronic mail on January 18, 2024, on the following counsel of record for Petitioner as follows:

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