

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 RESPONSE

TABLE OF CONTENTS

I.	Introduction.....	1
II.	Capsa’s Heightened Level of Skill in the Art Cannot Save the Claims	2
III.	Capsa’s Lexicography Arguments Conflict with the Intrinsic Record.....	2
	A. The claims do not require enclosed compartments, but the prior art discloses them regardless	2
	B. Capsa’s predecessor-in-interest did not claim compartment(s) disposed “entirely within” the portion of the work platform that projects from the height adjustment mechanism in the forward direction.....	5
	1. Capsa failed to meet the high bar set to demonstrate lexicography applies	5
	2. Capsa’s lexicography arguments regarding prosecution activity of another patent in 2012 lack import to the claims of the ’668 patent issued in 2009.....	7
IV.	The Petition Explains that Clark, Manner, and Santoro render claim 3 obvious.....	9
	A. Clark teaches “compartments” under either parties’ construction	9
	B. Clark’s compartments are disposed in the portion of the work platform projecting from the height adjustment mechanism in the forward direction	10
	1. Clark expressly discloses the compartment disposition	10
	2. Because Clark expressly disclosed the claimed compartment(s), no additional motivation to combine/modify is needed	15
	3. Patent Owner’s top-heavy criticisms are both irrelevant and wrong.....	16
V.	The Petition Explains Clark and Manner render claim 4 obvious	22

VI.	The Petition Explains Reeder, Manner, and Santoro render claim 3 obvious.....	22
A.	Reeder discloses compartments disposed in the forward projecting portion of a work platform under the correct construction of the term.....	22
VII.	The Petition Explains Reeder and Manner also render claim 4 obvious	23
VIII.	Capsa’s Paltry Secondary Considerations Arguments Cannot Save the Claims	24
IX.	Conclusion	27

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. VirnetX Inc.</i> , IPR2015-00810, Paper 44 (P.T.A.B. Aug. 30, 2016).....	5
<i>Arris Int’l PLC v. Sony Corp.</i> , IPR2016-00834, Paper 54 (P.T.A.B. Sept. 28, 2017)	5
<i>Avid Tech., Inc. v. Harmonic, Inc.</i> , 812 F.3d 1040 (Fed. Cir. 2016).....	9
<i>Cook Grp. Inc. v. Cook Med. LLC</i> , IPR2017-00135, Paper 7 (P.T.A.B. May 16, 2017)	5
<i>Cordis Corp. v. Medtronic AVE, Inc.</i> , 339 F.3d 1352 (Fed. Cir. 2003).....	9
<i>Elbex Video, Ltd. v. Sensormatic Elecs. Corp.</i> , 508 F.3d 1366 (Fed. Cir. 2007).....	8
<i>Fox Factory, Inc. v. SRAM, LLC</i> , 944 F.3d 1366 (Fed. Cir. 2019).....	26
<i>Georgia-Pacific Corp. v. U.S. Gypsum Co.</i> , 195 F.3d 1322 (Fed. Cir. 1999), ...	7
<i>Hill-Rom Servs., Inc. v. Stryker Corp.</i> , 755 F.3d 1367 (Fed. Cir. 2014).....	4
<i>Intel Corp. v. PACT XPP Schweiz AG</i> , 61 F.4th 1373 (Fed. Cir. 2023).....	15, 21
<i>Intel Corp. v. Qualcomm Inc.</i> , 21 F.4th 784 (Fed. Cir. 2021).....	21
<i>Jungersen v. Ostby & Barton Co.</i> , 335 U.S. 560 (1949).....	24
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	21

<i>Massachusetts Inst. of Tech. v. Shire Pharms., Inc.</i> , 839 F.3d 1111 (Fed. Cir. 2016)	9
<i>Ormco Corp. v. Align Technology, Inc.</i> , 463 F.3d 1299 (Fed. Cir. 2006)	25, 26
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	6
<i>Process Control Corp. v. HydReclaim Corp.</i> , 190 F.3d 1350 (Fed. Cir. 1999)	6
<i>Rambus Inc. v. Rea</i> , 731 F.3d 1248 (Fed. Cir. 2013)	26
<i>Realtime Data, LLC v. Iancu</i> , 912 F.3d 1368 (Fed. Cir. 2019)	3
<i>Sierra Wireless, Inc. v. Sisvel Int’l S.A.</i> , IPR2020-01099, Paper 68 (P.T.A.B. May 28, 2024)	2
<i>SkinMedica, Inc. v. Hisogen Inc.</i> , 727 F.3d 1187 (Fed. Cir. 2013)	4
<i>Thorner v. Sony Computer Ent. Am. LLC</i> , 669 F.3d 1362 (Fed. Cir. 2012)	3, 5
<i>Trivascular, Inc. v. Samuels</i> , 812 F.3d 1056 (Fed. Cir. 2016)	8
<i>Xerox Corp. v. Bytemark, Inc.</i> , IPR2022-00624, Paper 9 (P.T.A.B. Aug. 24, 2022) (precedential)	27

LIST OF EXHIBITS

Exhibit #	Description
1001	U.S. Patent No. 7,594,668 (“’668 patent”)
1002	Prosecution File History of the ’668 patent
1003	Prosecution File History of U.S. Patent Application No. 10/783,030 (Parent Application to ’668 patent)
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 Reeder et al. (“Reeder”)
1007	U.S. Patent No. 5,682,825 to Manner (“Manner”)
1008	U.S. Patent Publication No. 2002/0145088 to Santoro et al. (“Santoro”)
1009	RESERVED
1010	U.S. 6,493,220 to Clark (“Clark”)
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
1034	Exhibit from the Cross-Examination of Dr. Ben-Tzvi
1035	Exhibit from the Cross-Examination of Dr. Ben-Tzvi
1036	Exhibit from the Cross-Examination of Dr. Ben-Tzvi
1037	Materials Management in Healthcare, Jaco Mobile Cart Division MLT 2001, Mar 26, 1997
1038	Stability Analysis from the Examination of Dr. Ben-Tzvi
1039	Transcript from the Examination of Pinhas Ben-Tzvi, Ph.D. in IPR2023-01274 and IPR2023-01275
1040	U.S. Provisional Application No. 60/518649
1041	Computing Carts M38e Product Sheet
1042	Mobile Nurse Station Carelink Product Sheet
1043	Slimcart Assembly & Operating Manual
1044	GCX Healthcare Solutions Jaco EVO Product Sheet
1045	Transcript from the Examination of Craig Rydingsward in IPR2023-01274 and IPR2023-01275
1046	The American Heritage College Dictionary, Third Edition (1997)
1047	Webster's Third New International Dictionary Unabridged (2002)

TABLE OF ABBREVIATIONS

Abbreviation	Document
Petition or “Pet.”	<i>Howard Indus. Inc. v. Capsa Sol. LLC</i> , IPR2023-01274, Paper 1, Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,594,668 (P.T.A.B. August 3, 2023)
POR	<i>Howard Indus. Inc. v. Capsa Sol. LLC</i> , IPR2023-01274, Paper 14, Patent Owner’s Response (P.T.A.B. May 28, 2024)

I. Introduction

In its Reply, Capsa merely repackages arguments the Board rejected at institution. For example, Capsa continues to rely on an overly narrow construction of “compartments,” arguing again that they be enclosed compartments. But while lexicography does not apply in the first place, Capsa’s claim construction of “compartments” is of no import because each of the primary references, Clark and Reeder, teach incorporating enclosed drawers into their respective work platforms.

Second, Capsa continues to insist on a manufactured point of novelty requiring compartments be disposed “entirely within” the forward projecting portion of the work platform. In doing so, however, Capsa mischaracterizes arguments made during prosecution of a later-filed application regarding another claim element, the “work surface.” Capsa never argued during prosecution that compartments must be disposed *entirely within* the forward projecting portion of the work platform, and the Board should reject Capsa’s request to retroactively rewrite the claims to include such a limitation.

Ultimately, Capsa concedes the examiner erred in allowing the ’668 patent. The Patent Owner Response effectively admits the alleged points of novelty/non-obviousness found by the Patent Office—the actuator location—are in fact, taught by the prior art. The Board should reject Capsa’s plea to misapply legal precedent and adopt constructions that conflict with the plain and ordinary meaning of the ’668

patent claims. Instead, the Board should maintain its pre-institution claim constructions and find all challenged claims of the '668 patent invalid.

II. Capsa's Heightened Level of Skill in the Art Cannot Save the Claims

The Petition demonstrates that the challenged claims would have been obvious to one of ordinary skill in the art, regardless of which parties' definition of ordinary skill is applied. Petition, 2-7; Ex. 1004, ¶¶17-19; *see also* Ex. 2010, 151:16-159:5, 27:23-29:1; Paper 9 ("Institution Decision"), 10; *Sierra Wireless, Inc. v. Sisvel Int'l S.A.*, IPR2020-01099, Paper 68, at *12 (P.T.A.B. May 28, 2024) ("We do not find it necessary to resolve the differences between the contentions of the parties as to the appropriate level of ordinary skill in the art because the findings and conclusions rendered in this Decision do not turn on either proposed definition."). In its Patent Owner Response, Capsa merely repackages part of its preliminary response arguments and provides the Board no new arguments to consider. The Board should thus continue to apply Petitioner's level of skill in the art because it is "consistent with the problems addressed in the '668 patent and the prior art." Institution Decision, 10.

III. Capsa's Lexicography Arguments Conflict with the Intrinsic Record

A. The claims do not require enclosed compartments, but the prior art discloses them regardless

All grounds of the Petition map "drawers" from at least one prior art reference to the '668 patent's claimed compartments, Paper 1 ("Petition"), 23-25, 56-69, and

both parties agree that the '668 patent expressly recognizes drawers as compartments, *e.g.*, Ex. 1001, 2:15. The Board can thus resolve this proceeding without construing “compartment(s),” despite Capsa’s urging. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019). In any event, the '668 patent calls upon the plain and ordinary meaning of “compartment.”

The '668 patent claims, specification, and prosecution history confirm the plain and ordinary meaning of “compartments” applies. Claim 3 explains that the “compartments” are “for containing items.” Ex. 1001, 14:62-63. The specification further explains that “[t]he compartment *can be* a drawer.” *Id.*, 2:15 (emphasis added); 3:29-30. The patent, however, places no restrictions on “compartment” requiring departure from the plain and ordinary meaning. The specification also confirms the Patentee did not limit the invention to disclosed embodiments. Ex. 1001, 14:5-6 (“Although the aforementioned describes embodiments of the invention, the invention is not so restricted.”). While Capsa argues the Applicant redefined “compartments” by implication and consistent usage, “[i]s not enough for a patentee to simply disclose a single embodiment or use a word in the same manner in all embodiments” for lexicography to apply. *Thorner v. Sony Computer Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012).

Ultimately, “compartment” is a commonly understood word with a readily apparent, ordinary meaning. Ex. 1001, 2:15; Ex. 2010, 124:21-125:13; Institution

Decision, 22 (*citing* <https://www.dictionary.com/browse/compartment>). Indeed, Capsa’s cited dictionary recognizes this ordinary meaning as its *first* definition. *See* Ex. 2014 (“1: a separate division or section”). The other dictionaries agree. Ex. 1046 (“One of the parts or spaces into which an area is subdivided”); Ex. 1047 (“A subdivision of three dimensional space”).

Capsa misplaces its reliance on *SkinMedica*. During prosecution of the patent in that case, the patentee distinguished its invention—culturing cells in three dimensions—as chemically distinct from culturing cells via conventional means. *SkinMedica, Inc. v. Hisogen Inc.*, 727 F.3d 1187, 1198-99 (Fed. Cir. 2013). The Federal Circuit thus construed the term “beads” to exclude culturing cells grown on beads because the specification (i) repeatedly described cultures grown on beads as conventional and (ii) expressly defined beads as culturing in two dimensions. *Id.*, 1198-2000, 1202-03. Here, unlike *SkinMedica*, the ’668 patent prosecution history does not distinguish enclosed from unenclosed compartments. Rather, Capsa points to the ’668 patent’s brief description of Figure 7 depicting a cart with its drawers removed as “a work platform of the medical cart of FIG. 1 without compartments.” Ex. 1001, 3:32-33, 7:46-67. Such a disclosure provides no clear intention to limit the claims and falls far short of the exacting standards necessary to establish lexicography and disavowal. *See Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014).

Finally, Petitioner’s agreement to adopt Patent Owner’s construction of “compartment(s)” in the district court has no bearing on this proceeding. Institution Decision, 14, n.11. “Claim construction is a legal determination based on a hierarchy of evidence” and “not an issue of fact that can be conceded.” *Cook Grp. Inc. v. Cook Med. LLC*, IPR2017-00135, Paper 7, *7-8 (P.T.A.B. May 16, 2017); *Arris Int’l PLC v. Sony Corp.*, IPR2016-00834, Paper 54, *26-29 (P.T.A.B. Sept. 28, 2017) (declining to construe term per parties’ district court stipulation); *Apple Inc. v. VirnetX Inc.*, IPR2015-00810, Paper 44, *18–19 (P.T.A.B. Aug. 30, 2016) (“Neither are we persuaded that what the parties agreed to in the district court binds us....”). Thus, if determined necessary to resolve a dispute, the Board should adopt the plain meaning of “compartment(s)” set forth in the Institution Decision.

B. Capsa’s predecessor-in-interest did not claim compartment(s) disposed “entirely within” the portion of the work platform that projects from the height adjustment mechanism in the forward direction

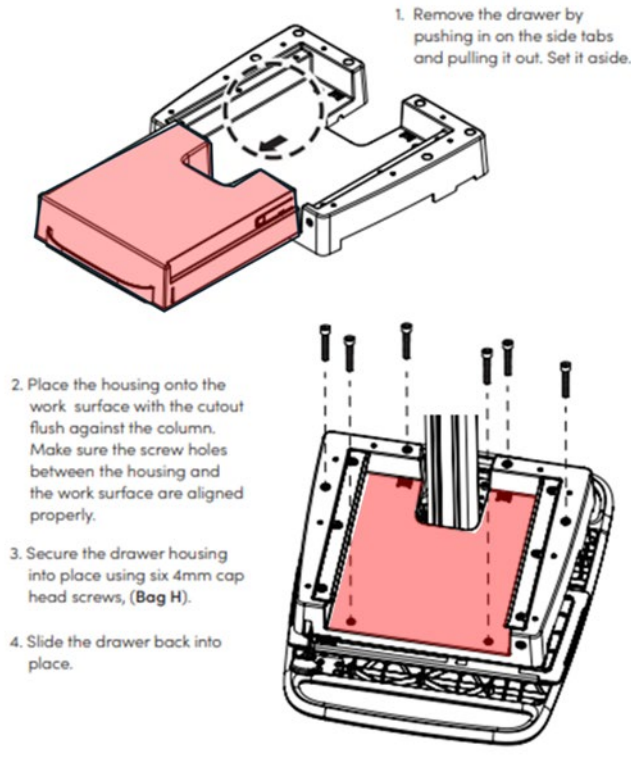
1. Capsa failed to meet the high bar set to demonstrate lexicography applies

Capsa’s arguments fall short of the exacting standards necessary to invoke lexicography and disavowal. *See Thorner*, 669 F.3d at 1365-66. The Board must therefore reject Capsa’s invitation to do so based on their characterization of the drawings as consistently depicting compartments contained in a forward portion of the work platform. POR, 25-26. As an initial matter, the Federal Circuit has

“repeatedly warned against confining the claims to [disclosed] embodiments.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005). Moreover, Capsa parses the word “forward” in isolation to support its unduly narrowing construction. The surrounding claim language makes clear “forward direction” describes an orientation that contrasts with “a user facing in the rearward direction.” Ex. 1001, claim 3. The specification confirms this understanding, describing that “[t]he plurality of compartments 530 *face the user*.” *Id.*, 7:28-31. It does not limit the claim scope, as Capsa would, to require compartments contained “entirely within” one portion of the work platform.

In practice, Capsa asks that the Board rewrite claims 3 and 4 of the ’668 patent to include a new adverb, “entirely,” that the original Applicant never argued for or included in the claims. *See* ’668 patent, claims 3 and 4. The Board should decline Capsa’s invitation out of hand. *See Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357 (Fed. Cir. 1999) (“[W]e do not permit courts to redraft claims.”).

Moreover, contrary to Capsa’s expert insisting that extending compartments into other portions of the work platform would be “impossible,” Ex. 2012, ¶57, §b, Capsa’s Senior VP of Capsa Healthcare (Craig Rydingsward) conceded otherwise. During his deposition, Mr. Rydingsward freely acknowledged that forward-facing drawers could have been configured to extend around the sides of a height adjustment mechanism just as readily as in Capsa carts today:



Ex. 1043, 17 (annotated)

Ex. 1043, 17; Ex. 1045, 39:16-22; 42:2-43:7; Ex. 2010, 102:13-103:1; *see also* Ex. 1040, 20. Petitioner therefore submits the Board should afford little or no weight to allegations of Capsa's expert and decline Capsa's invitation to rewrite the claims.

2. Capsa's lexicography arguments regarding prosecution activity of another patent in 2012 lack import to the claims of the '668 patent issued in 2009

As an initial matter, statements made by the Applicant during prosecution of the later filed '650 patent application did not retroactively create prosecution history disclaimer in the already issued '668 patent. *See Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1333 (Fed. Cir. 1999), opinion amended on reh'g, 204

F.3d 1359 (Fed. Cir. 2000) (rejecting argument that statements made in the prosecution history of a later patent application applied to the patent-in-suit that had issued nine months prior). Consequently, Capsa cannot meet its elevated “burden of proving the existence of a ‘clear and unmistakable’ disclaimer that would have been evident to one skilled in the art.” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1063–64 (Fed. Cir. 2016) (quoting *Elbex Video, Ltd. v. Sensormatic Elecs. Corp.*, 508 F.3d 1366, 1371 (Fed. Cir. 2007)).

Moreover, the prosecution history of the later filed ’650 patent shows the alleged disavowal arguments were directed to the claimed work surface, not the compartments disposed in the forward projecting portion of the work platform. Ex. 1033, 132, 133, 135 (amending claims 1, 9, and 16), 137-143. In particular, the Applicant argued multiple times during prosecution of the ’650 patent that a POSITA would not combine the prior art references applied in the rejections “to arrive at a height-adjustable work platform *with a moveable work surface* located above a compartment.” *Id.*, 139 (emphasis added); *see also id.* (arguing same for a separate combination); *id.*, 140 (arguing same for claim 9); *id.*, 141 (arguing same for claim 16).¹ Where the alleged disavowal “is ambiguous, or even ‘amenable to multiple

¹ Patent Owner mischaracterizes these arguments to wrongly suggest that Petitioner did not address them. The Office raised Ellefson to teach a cart “with at least one left-right movable work surface which follows an arcuate path.” Ex. 1033 at 158. The Petition devotes entire alternative grounds based on Gillis to teach a work surface that moves in this way. Petition, 9, 21-22, 25-27, 41-42, 54, 60-61, 84-85.

reasonable interpretations,’ [the Federal Circuit has] declined to find prosecution disclaimer.” *Avid Tech., Inc. v. Harmonic, Inc.*, 812 F.3d 1040, 1045 (Fed. Cir. 2016) (quoting *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1359 (Fed. Cir. 2003)). The Board should do the same here.

Moreover, as the Board’s Institution Decision recognizes, the Applicant’s arguments in 2012 while prosecuting the ’650 patent are of no import to the claims of the ’668 patent issued in 2009. Institution Decision, 30. In fact, the challenged claims here lack the ’650 patent’s required “moveable work surface,” the subject of those amendments and arguments cited by Capsa. *Compare* Ex. 1033, 132 *with* Ex. 1001, claims 3 and 4. The Board should therefore discard Capsa’s arguments that their predecessor-in-interest disavowed compartments disposed outside of the forward projecting portion of the work platform. *See Massachusetts Inst. of Tech. v. Shire Pharms., Inc.*, 839 F.3d 1111, 1120 (Fed. Cir. 2016) (finding no disavowal based on statements made in prosecution that “were made in the context of different claims that did not include the [disputed] term[.]”).

IV. The Petition Explains that Clark, Manner, and Santoro render claim 3 obvious

A. Clark teaches “compartments” under either parties’ construction

Clark discloses the claimed invention under either parties’ construction of “compartments.” As the Petition explains, Clark explicitly teaches a compartment within the work platform in the form of a cavity below the work surface 86 and

above the pullout keyboard tray 70. Petition, 24; Clark, Figs. 4A-B. Clark's cavity is a space that is marked or partitioned by four sides and satisfies the plain and ordinary meaning of a "compartment." Institution Decision, 22. Clark also discloses "a drawer . . . located above or under the horizontal tray 12." Clark, 10:30-33. Clark's drawer satisfies both the plain and ordinary meaning of "compartment" and Capsa's proposed narrow construction that requires compartments to be "enclosed." Indeed, there is no reasonable dispute that Clark's drawer is a compartment because the '668 patent expressly identifies a "drawer" as a "compartment." Ex. 1001, 2:15.

B. Clark's compartments are disposed in the portion of the work platform projecting from the height adjustment mechanism in the forward direction

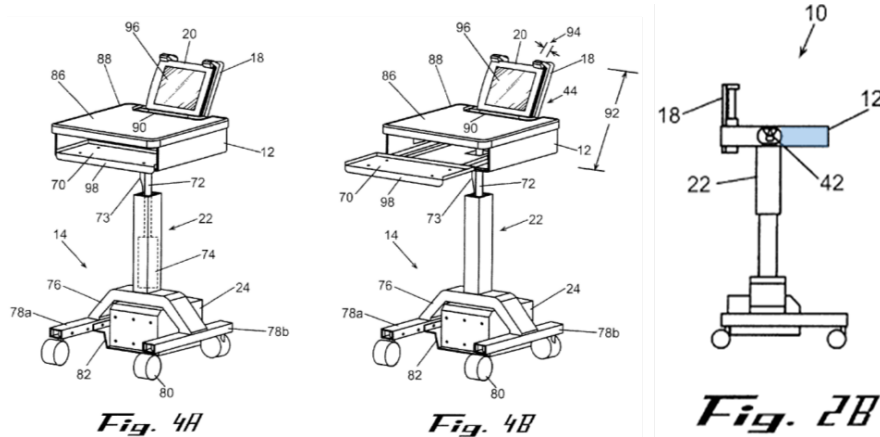
1. Clark expressly discloses the compartment disposition

Both of Clark's compartments are "disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction."

a. The Compartment housing the pull-out keyboard tray 70 is disposed in the forward-projecting portion

Figures 4A-B of Clark clearly show that the compartment formed between the horizontal tray 12 and the bottom of the work surface 86 to house pull-out tray 70 in its retracted position is "disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction." *See* Petition, 30-

32; Clark, Fig. 4A-B. This portion is highlighted in the below-annotated copy of Clark's Figure 2B:



Clark, Figs. 4A-B and Fig 2B (annotated)

Capsa has alleged that Clark's compartment is not "disposed in the portion of the work platform that projects from the work platform in the forward direction" because Clark's keyboard tray is supposedly mounted "entirely on top of the height adjustment mechanism." *See* POR at, e.g., 30, 32-33, 37, 39, 40; Ex. 2012, e.g., ¶¶60, 64, 72; Ex. 1039, 112:15-117:11, 117:17-127:3.

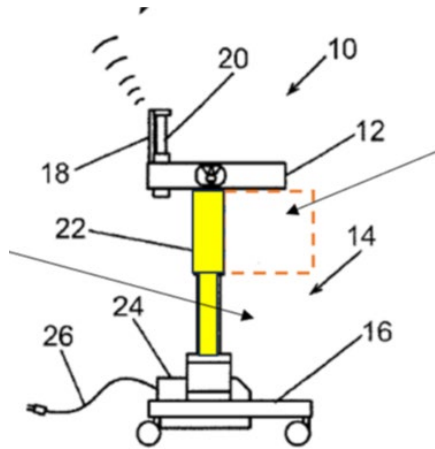
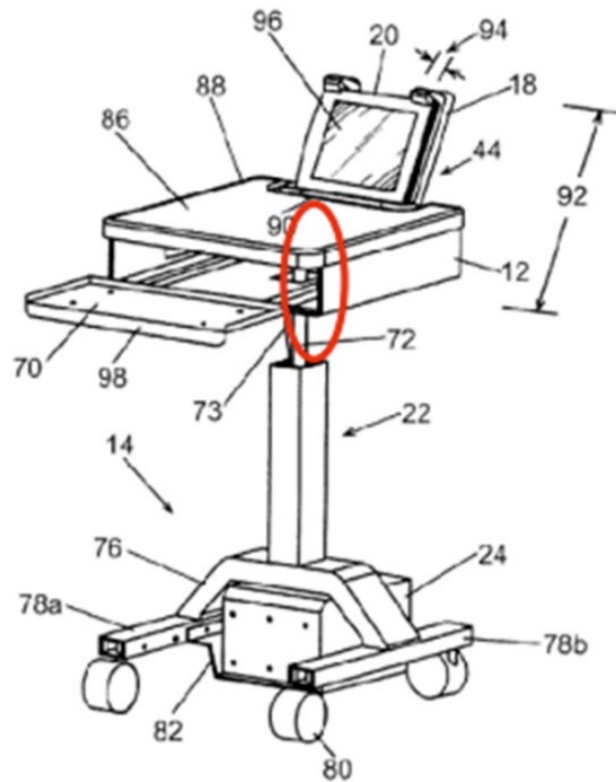


Figure 1, 2B of Clark
(side view)

Clark, Fig. 1 (as annotated in POR)

As shown in the above illustration taken from the POR, Capsa would limit the “forward portion” of the work platform to be below the top of the height adjustment mechanism 22, which Capsa alleges to be connected *to the bottom* of Clark’s horizontal tray 12. POR, 22; Ex. 1036. But this conflicts with the earlier testimony of Capsa’s expert. In his declaration supporting Capsa’s *Preliminary Response*, Dr. Ben-Tzvi opined the opposite: “the alleged height-adjustment mechanism (vertical beam 22) of Clark *extends through a middle portion of the alleged compartment (keyboard tray cavity 12)*, essentially dividing it in half.” Ex. 2001 (emphasis added), ¶33; POPR, 33-34.

As observed by a brief review of Clark’s FIG. 4B, and confirmed by Dr. Ben-Tzvi in his pre-institution declaration (Ex. 2001, ¶33), Clark’s height adjustment mechanism extends *through* Clark’s horizontal tray 12:

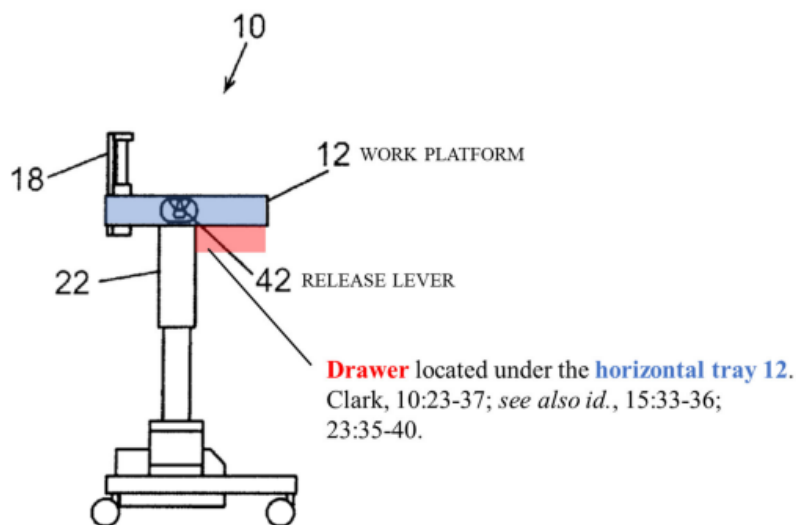


Clark, Fig. 4B (annotated)

Clark thus makes clear that the compartment cavity below the work surface 86 and above the pullout keyboard tray 70 is “disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction.”

b. Clark's drawer is disposed in the forward-projecting portion

The claims simply do not require a compartment disposed entirely in the portion of the work platform projecting from the height adjustment mechanism in the forward direction. Section III.B. But even under Capsa's construction, Clark expressly discloses a drawer located "under the horizontal tray 12":



Clark, Fig. 2B (annotated)

Clark, Fig. 2B (annotated), 10:22-37, 15:33-36, 23:35-40. As explained in the Petition and Howard's expert, a POSITA would have understood this drawer would be located as shown in the above-annotated copy of Clark's Figure 2B. Ex. 2010, 129:4-12, 129:16-130:4, 133:16-135:5. Accordingly, a POSITA would have understood that Clark's drawer is "disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction." *Id.*, 131:8-25, 133:16-135:5.

2. Because Clark expressly disclosed the claimed compartment(s), no additional motivation to combine/modify is needed

Clark expressly teaches a compartment in two forms: (i) the compartment housing the pullout keyboard tray 70 (Clark, FIG. 4A), and (ii) a drawer located “under the horizontal tray 12” corresponding to the claimed work platform. Petition, 23-25; Ex. 1004, ¶¶57-60. So, while Capsa urges that the petition falls short in explaining how a POSITA would modify Clark, no explanation was necessary. Petition, 23-25; *see also* Institution Decision, 16-24.

Nevertheless, the Petition also explains a POSITA would have implemented drawers in Clark’s work platform “to improve the ability to organize unlike items in separate storage compartments.” Petition, 25; Ex. 1004, ¶60. The Petition also recognizes that “security of health information (medical histories, test results, prescriptions, etc.,) as well as the medications themselves, was a common concern in the medical cart industry.” Petition, 20, Ex. 1004, ¶47; Ex. 1020, [0004]-[0005]; Ex. 1021, 1:35-55. Such “universal motivations known in a particular field to improve technology provide a motivation to combine prior art references even absent any hint of suggestion in the references themselves.” *Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1380 (Fed. Cir. 2023) (“*PACT*”) (internal quotations omitted). Finally, Howard’s expert confirmed such modifications were routine and

well within the level of ordinary skill as supported by Ellman, Reeder, and other prior art references. Ex. 1004, ¶60; Reeder, Figs. 30, 32; Ellman, 2:18-24, Figs 1-2.

3. Patent Owner’s top-heavy criticisms are both irrelevant and wrong

The Board should reject Capsa’s attempt to manufacture requirements for stability or locations for a specific center of gravity into the claims. The claims do not require any standard for stability or a center of gravity at any particular location. Indeed, the term “center of gravity” never appears in the patent. And as explained in Section III.B, the Applicant’s arguments made for the child ’650 application were made in support of its claim amendments to the moveable work surface, not the location of compartments in the work platform.² Capsa’s arguments carry no relevance to the claims of the ’668 patent.

Moreover, Capsa’s arguments on stability are flawed. As an initial matter, Clark’s horizontal tray 12 is not mounted on top of height adjustment mechanism 22. Section IV.B.1.a. And while Capsa’s expert refused to acknowledge this during his examination, Ex. 1039, 116:20-127:3, he previously recognized it in his declaration supporting the Patent Owner Preliminary Response. There, he stated “the

² Indeed, Mr. Kemnitzer’s testimony that he did not include discussion on stability of the Clark unit in his declaration because he “didn’t think it was a bone of contention” demonstrates that Capsa’s new-found characterization of its arguments directed to the claimed work surface could not have been anticipated. Ex. 2010, 10:22-12:21.

alleged height-adjustment mechanism (vertical beam 22) of Clark extends through a middle portion of the alleged compartment (keyboard tray cavity 12), essentially dividing it in half,” Ex. 2001, ¶33; Clark, Fig. 4B. Indeed, Clark’s height adjustment mechanism extends through Clark’s work platform to leave a portion of Clark’s work platform projecting in front of the height adjustment mechanism. In other words, the ’668 patent does not provide stability improvements over Clark based on how the work platform attaches to the height adjustment mechanism.

Moreover, as Capsa and its expert must recognize, object stability depends on factors other than the center of gravity location of an object. These factors include “the base area of the object [or] the mass distribution.” POR, 43; Ex. 2010, 59:19-61:20; Ex. 1039, 176:4-177:15. Indeed, it is the center of gravity’s position compared to the object’s tipping point that determines stability, not simply the height of the center of gravity. POR, 45 (“If an object is tilted, it will tip over if a vertical line from its COG falls outside the base...”); Ex. 2010, 60:23-61:20 (discussing how a higher center of gravity can cause tipping in extreme circumstances, but must move center of gravity beyond the footprint of the base); *Id.*, 50:19-51:7; 57:24-59:4 (explaining tilting mechanics, “when the center of gravity is within the footprint of the chair, no problem...[i]n order for the unit to tilt, the center of gravity has to pass beyond that line, that perimeter line of the base.”); *Id.*, 67:2-13 (explaining that raising the center of gravity only matters to stability if “the center of gravity was

near the edge of the cart” because “if it’s in the center of the cart, then it becomes more stable because it takes less [sic], more force to move that center of gravity behind the footprint of the base, and that’s what it takes to make it tip over”); *Id.*, 71:2-12 (describing alternative ways to effect stability including “a wider footprint”); *see also id.* 123:21-24.

Capsa’s analysis of the ’668 patent’s so-called improvements over the prior art ignore these and other factors affecting stability. Capsa never explains, beyond conclusory testimony from its expert, why a POSITA would allow concerns over stability to dissuade them from attaching drawers under Clark’s horizontal tray 12 *as expressly disclosed by Clark*. Ex. 1039, 135:12-141:20. Notably, the URL cited by Capsa’s stability explanation confirms the science at issue is suitable for school-aged children between the ages of 11 and 14, a level well-below either party’s definition of a POSITA in this case. *See* Ex. 2015 (www.schoolphysics.co.uk/age11-14/Mechanics/Statics/text/Stability_/index.html).

In its briefing, Capsa invents a solution to a problem that never existed. While Capsa argues carts with higher centers of gravity are “more prone to toppling over,” it necessarily ignores other basic factors impacting stability like position of the cart’s base or orientation of its mass. POR, 8-9. For example, as the Board recognized in Capsa’s criticism of Clark at the preliminary stage, positioning the height adjustment mechanism at the rear of the work platform as Capsa proposes for stability may make

the work platform *more* susceptible to tipping. Institution Decision, 30-31. In particular, Clark's Figure 2B positions the center of gravity closer to the front of the work platform, and "the smaller moment arm appears, based on the present record to make the platform less susceptible to tipping when the drawers are extended." *Id.* Capsa's expert confirmed the Board's observation on moment arms and tipping during his examination.

For example, Dr. Ben-Tzvi reviewed two hypothetical statics problems involving carts:

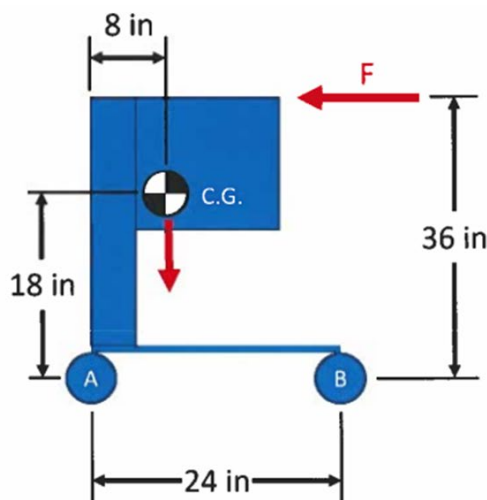


Figure 1

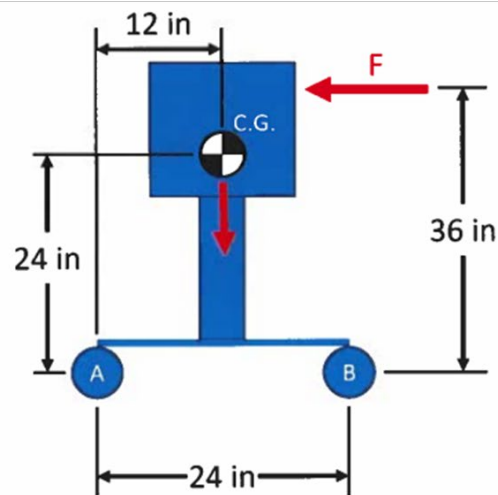


Figure 2

Ex. 1038; Ex. 1039, 181:8-186:18. The cart of Figure 1 above is positioned with a height adjustment mechanism at the rear of the work platform with a center of gravity at 18 inches above tipping point A, capturing the alleged improved lower center of gravity of the '668 patent. Ex. 1038. The cart of Figure 2, on the other hand, has a higher center of gravity at 24 inches above tipping point A and is centered

within the work platform, like Clark. Ex. 1038. When comparing the hypothetical carts, Dr. Ben-Tzvi agreed that the force required to tip the cart in Figure 2 was greater than the force required to tip the cart of Figure 1 despite the higher center of gravity. Ex. 1039, 186:9-18.

Moreover, Capsa's criticisms of Clark as top-heavy/unstable ignore critical portions of Clark's disclosure. Clark's cart includes a 12-volt sealed lead acid battery at the bottom of its frame, the weight of which contributes to a low center of gravity and provides stability to the frame. Clark, 9:11-23, 14:8-16; Ex. 2010, 12:1-14:12; Ex. 1039, 148:11-149:3 ("putting batteries at the bottom...lower[s] the center of gravity"). Additionally, Clark specifies its chassis "may be a model MPC 2001 manufactured by Jaco, Inc." Clark, 8:66-9:1. The MPC 2001 was a commercially sold height adjustable cart weighing 70 pounds capable of supporting heavy elements like cathode-ray monitors on its top. *See* Ex. 1037, 11; Ex. 1039, 155:8-19.

Dr. Ben-Tzvi, however, did not consider the MPC 2001 specified by Clark prior to submitting his declaration and commenting on Clark's stability. Ex. 1039, 150:3-10. When confronted with the MPC 2001 specification sheet during his examination, Dr. Ben-Tzvi claimed he still had insufficient detail to determine if adding a drawer underneath the keyboard tray of Clark's chassis would make the cart unstable. *Id.*, 160:7-163:3. He later admitted, however, that he did not determine adding a drawer under Clark's keyboard tray made the Clark combination or its

chassis unstable. *Id.*, 163:10-164:15. Thus, there is no support for Patent Owner’s arguments that Clark “would be more unstable and top-heavy” or “more easily knocked over,” than the claimed cart, and the Board should discount those arguments. POR, 40-41.

Even assuming Capsa’s criticism of Clark as top-heavy is true (and it is not), the prior art is replete with evidence that a POSITA would have recognized that multiple drawers are desirable to, for example, store unlike items separately. Clark, 10:30-33; Reeder, Figs 30, 32; Ellman, 2:18- 24, Figs 1-2; *see also Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 800 (Fed. Cir. 2021) (“It’s not necessary to show that a combination is the *best* option, only that it be a *suitable* option.”) (internal quotations omitted). To be sure, the mechanics of installing a drawer below Clark’s horizontal tray 12 were well within the skillset of a POSITA in 2003. Ex. 2010, 10:29-37, 15:33-41, 23:35-44; Ex. 1004, ¶¶57-60. The ’668 patent is obvious in light of the prior art. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill”); *PACT*, 61 F.4th at 1380 (“And if there’s a known technique to address a known problem using ‘prior art elements according to their established functions,’ then there is a motivation to combine.”) (internal quotations omitted).

V. The Petition Explains Clark and Manner render claim 4 obvious

The Petition shows that Clark and Manner render claim 4 obvious. Claim 4 lacks the drawer slides of claim 3 and requires only a single compartment but otherwise recites corresponding limitations. Thus, for the reasons explained in Sections III and IV above and in the Petition, claim 4 of the '668 Patent would have been obvious in light of Clark and Manner.

VI. The Petition Explains Reeder, Manner, and Santoro render claim 3 obvious

A. Reeder discloses compartments disposed in the forward projecting portion of a work platform under the correct construction of the term

Capsa's criticisms of Reeder depend on the same overly narrow claim construction positions used to criticize Clark. As the Petition shows, Reeder's wire storage tray 372 and storage containers 718 are compartments under the plain and ordinary meaning of the term because they are each a part or space marked or partitioned off. Petition, 56-58. Moreover, the Petition also explains that it would have been obvious to incorporate the drawers from Reeder's embodiments shown in figured 30 and 32 into Reeder's height adjustable carts in figures 31, 45, and 46. *Id.*, 59. Drawers are compartments under either party's proposed construction. And substituting drawers for Reeder's wire storage tray 372 or storage containers 718 would render the '668 patent obvious because they would be disposed in the portion of the work platform that projects from the height adjustment mechanism in the

forward direction. *See* Petition, 66-68. The claims do not prohibit the compartments from extending from the front side of the height adjustment mechanism to the mechanism's side or rear. *See* Section III.B.

Nevertheless, the Petition also explains that it would have obvious to attach Reeder's drawer-style compartments to the bottom side of Reeder's work platform in the portion that extends in the forward direction "to provide secure storage on the height adjustable cart." Petition, 68-69. And Mr. Kemnitzer's observations that such drawers were well-known in the art of medical carts and within the skill of a POSITA is supported by prior art in the field. Ex. 1004, ¶147; Ellman, 2:18-24, Figs. 1-2.

Capsa's criticisms of Reeder as top heavy and unsuitable to be modified again miss the mark. Capsa ignores, for example, Reeder's large base and the contribution the base makes to the stability of Reeder. POR, 49-51; Ex. 2010, 138:9-16. Capsa's expert also admitted that he could not determine if Reeder had a higher center of gravity than the cart in the '668 patent. Ex. 1039, 167:3-9. The Board should thus ignore Capsa's criticisms that the proposed modifications to Reeder would make it unstable.

VII. The Petition Explains Reeder and Manner also render claim 4 obvious

The Petition established that Reeder and Manner also render claim 4 obvious. Claim 4 lacks the drawer slides of claim 3 and requires only a single compartment but otherwise recites corresponding limitations. Thus, for the reasons explained in

the Petition and Sections III and VI above, claim 4 of the '668 Patent would have been obvious in light of Reeder and Manner.

VIII. Capsa's Paltry Secondary Considerations Arguments Cannot Save the Claims

Capsa's self-serving declaration on secondary considerations cannot overcome the overwhelming evidence presented in the petition demonstrating the '668 patent claims are obvious. "Where ... invention is plainly lacking, commercial success cannot fill the void." *Jungersen v. Ostby & Barton Co.*, 335 U.S. 560, 567 (1949).

Moreover, Capsa's declaration in support of secondary considerations by Mr. Rydingsward faces critical shortcomings in proving commercial success or copying. For example, Capsa improperly relies on secondary considerations without supporting evidence and attributes commercial success to unclaimed features known in the prior art. First, Mr. Rydingsward's declaration touts the commercial success of Capsa's M38 and Carelink carts, Ex. 1045, 26:9-11, but he provides no sales data to substantiate that success. Second, Mr. Rydingsward attributes the success of Capsa medical carts to their "lower center of gravity and better weight distribution." Ex. 2018, ¶14. The claims require no center of gravity or weight distribution, and Mr. Rydingsward admits he has no engineering experience to evaluate these features in the first place. Ex. 1045, 12:7-15.

Capsa also cannot demonstrate a nexus between the claimed features and the commercial success of Capsa's product. This dooms its secondary considerations analysis. *See Ormco Corp. v. Align Technology, Inc.*, 463 F.3d 1299, 1311–12 (Fed. Cir. 2006) (“[I]f the commercial success is due to an unclaimed feature of the device, the commercial success is irrelevant.”) During his deposition, Mr. Rydingsward conceded he was unfamiliar with the claims of the '668 patent and could not provide a nexus between the claims and the commercial success of Capsa's products. Ex. 1045, 9:15-10:12; 15:1-9. Mr. Rydingsward admitted that unclaimed features such as aesthetics, touch screen interface, and fleet management software features also contributed to Capsa's “commercial success.” *Id.*, 23:7-24:1, 25:1-26:1. Finally, Capsa has spent an unspecified amount of resources on marketing its M38 and Carelink cart products, and Capsa made no attempt to establish that sales of its carts are driven by claimed features rather than its marketing efforts. *Id.*, 21:5-19.

More problems with Capsa's commercial success argument remain. Mr. Rydingsward claims that commercial success of Capsa's cart is “due to fact that these carts have height adjustable compartments yet are UL60601 certified.” Ex. 2018, 11. But Clark, Reeder, and Dell each themselves confirm that height adjustable compartments were well-known in the art. Clark, Figs. 4A-B (showing cavity below the work surface 86), 10:30-33; Reeder, ¶¶[0018], [0147], Figs. 31, 45-46; Ex. 1015 Fig. 1 (bins 34 and 36); *see Rambus Inc. v. Rea*, 731 F.3d 1248, 1257

(Fed. Cir. 2013) (“[O]bjective evidence of nonobviousness lacks a nexus if it exclusively relates to a feature that was known in the prior art.”). Furthermore, Capsa markets and sells versions of the M38 and Carelink cart *without* drawers, undercutting his claim that drawers drive sales of the product. Ex. 1041, 2; Ex. 1042, 2; Ex. 1045, 33:8-35:8 (noting Capsa cart M38e without drawers meets UL60601 and uses the same base and height as the drawer model); Ex. 1045, 36:10-39: 8 (same for Capsa’s Carelink cart); *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) (“[w]hen the thing that is commercially successful is not coextensive with the patented invention...the patentee is not entitled to a presumption of nexus”). Lastly, the claims require no UL60601 certification, making Capsa’s stability certifications irrelevant. *See Ormco Corp.*, 463 F.3d at 1312 (“if the commercial success is due to an unclaimed feature of the device, the commercial success is irrelevant”).

Finally, Capsa’s statements on long felt unmet need and copying should be afforded no weight, as neither witness provided reliable supporting evidence for their testimony. For example, Dr. Ben-Tzvi could not identify any medical cart manufacturers that operated in 2003. Ex. 1039, 21:9-11. And Mr. Rydingsward did not enter the industry until after the priority application to the ’668 patent was filed. Ex. 1045, 12:7-15. Mr. Rydingsward thus lacks personal knowledge on the state of the industry at the 2003 critical date. Accordingly, Capsa’s arguments on secondary

considerations should be given no weight. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (P.T.A.B. Aug. 24, 2022) (precedential) (giving little weight to conclusory or unsupported testimony that lacks additional supporting evidence or technical reasoning).

IX. Conclusion

For the reasons set forth above, and as outlined in the Petition, Petitioner has established that each challenged claim is unpatentable. Petitioner respectfully requests that the Board cancel each challenged claim.

Date: August 20, 2024

Respectfully Submitted,

/Michael V. Young/
Michael V. Young
Lead Counsel for Petitioner
Reg. No. 61,180

CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Pursuant to 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the foregoing PETITIONER’S REPLY TO PATENT OWNER’S RESPONSE contains 5,540 words, the parts exempted under 37 C.F.R. § 42.24(c), as measured by the word-processing system used to prepare this paper.

Date: August 20, 2024

/Michael V. Young/
Michael V. Young
Lead Counsel for Petitioner
Reg. No. 61,180

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Reply to Patent Owner's Response and Exhibits 1034-1047** were served electronically via email on August 20, 2024, in its entirety on the following:

Jeffrey S. Standley
James L. Kwak
F. Michael Speed, Jr.
Adam J. Smith
Standley Law Group LLP
6300 Riverside Drive
Dublin, Ohio 43017
Telephone: (614) 792-5555
Facsimile: (614) 792-5536
jstandley@standleyllp.com
jkwak@standleyllp.com
mspeed@standleyllp.com
asmith@standleyllp.com
standleydocketing@standleyllp.com

Patent Owner has consented to service by electronic mail.

Dated: August 20, 2024

By: /Mark A. Rosenberger/
Mark A. Rosenberger
Case Manager

Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP