

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOWARD INDUSTRIES, INC.

Petitioner,

v.

CAPSA SOLUTIONS LLC

Patent Owner.

IPR2023-01274

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

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO THE
RESPONSE TO THE PETITION**

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<i>TQ Delta LLC v. Cisco Sys.</i> 942 F.3d 1352 (Fed. Cir. 2019)	15
<i>Wasica Fin. GmbH v. Cont'l Auto. Sys.</i> 853 F.3d 1272 (Fed. Cir. 2017)	3

TABLE OF EXHIBITS

EX. #	EXHIBIT DESCRIPTION
2001	Declaration of Ben-Tzvi in Support of Patent Owner's Preliminary Response to '668 and '650 IPR Petitions.
2002	US Pat. 6,721,178 to Clark, which is a continuation of the '220 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	Declaration of Pinhas Ben-Tzvi in Support of Plaintiff Capsa's Opening Claim Construction Brief
2005	Declaration of Pinhas Ben-Tzvi in Support of Plaintiff Capsa's Reply Claim Construction Brief
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.
2008	Report and Recommendations of the Special Master regarding claim construction.
2009	PLACEHOLDER
2010	Transcript of Deposition of Ronald Kemnitzer
2011	U.S. Patent No. 5,961,134 to Kemnitzer et al. (including Congleton)
2012	Declaration of Ben-Tzvi in Support of Patent Owner's Response to '668 and '650 IPR Petitions.

2013	Declaration of James Kwak (authenticating documents attached to '650 and '668 IPR Responses and authenticating dictionary definitions cited herein).
2014	Excerpts of Dictionary Definitions Cited Herein
2015	https://www.schoolphysics.co.uk/age11-14/Mechanics/Statics/text/Stability_/index.html Website pages
2016	RESERVED
2017	U.S. Patent No. 9,367,061 to Miller
2018	Declaration of Craig Rydingsward
2019	Prosecution File History of U.S. Patent No. 8,215,650
1010	U.S. Patent No. 6,493,220 to Clark ("Clark")
1038	Stability Analysis From the Examination of Dr. Ben-Tzvi
1039	Deposition Transcript of Dr. Pinhas Ben-Tzvi
1043	Slimcart Assembly & Operating Manual

Abbreviations:

When citing to deposition transcripts, the format **page#:line numbers** will be used. For example, "Ex. 2010 at 9:5-15" means deposition exhibit 2010 at page 9, lines 5-15.

"Ex. 2010 at 10:3-11:12" means deposition exhibit 2010 at page 10, line 3 through page 11, line 12.

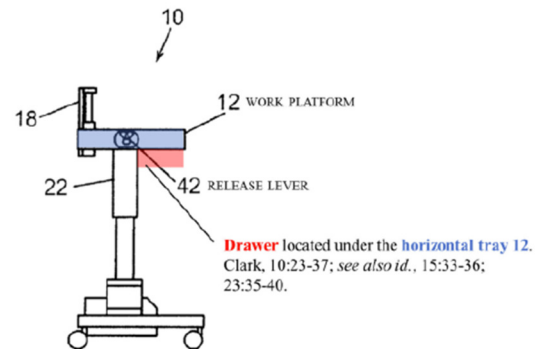
Patent Owner's Sur-reply in IPR2023-01274
US Pat. No. 7,594,668
Dkt. No. CAP2491-144

When citing to patents, the format **column, line numbers** will be used. For example, '668 Patent, col. 7, ll. 33-35 (or 7:33-35) refers to column 7, lines 33-35.

I. Summary of Sur-reply Argument

A. Petitioner Has Failed To Meet Its Burden To Provide Evidence of All the Elements of Obviousness

None of the prior art references relied upon by Petitioner teaches the placement of compartments at the very specific location claimed. Specifically, none of the references relied upon by Petitioner teach compartment(s) “disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction.” Petitioner merely relies on conclusory attorney argument to fill in the gaps left by Clark (and now Reeder). For example, in the Reply brief, Petitioner *draws in* a red drawer disposed in front of the height adjustment mechanism of Clark even though Clark never specifically states that the drawer should be placed in this specific location. See Petitioner Reply, pg. 12



Clark, Fig. 2B (annotated)

(Figure 2b of Clark with red drawer annotated by Petitioner reproduced above).

Petitioner also failed to provide evidence of a motivation to modify Clark or Reeder to place the compartments at this specific location claimed. Petitioner merely alleges that adding drawers is generally desirable and doing so would be routine for a PHOSITA and “within the level of ordinary skill.” *Id.* at 14. This conclusory allegation is insufficient evidence of a motivation to combine based on controlling case law cited in this Sur-reply. The law is clear - just because the prior art *can be* modified to reach the claimed invention does not make the modification obvious unless the prior art suggested the desirability of the specific combination recited in the claims. Petitioner has failed to meet its burden to prove all elements of obviousness and their Petition should be denied on this basis.

B. Petitioner Fails to Respond to Many Points Raised in Patent Owner's Response and Fails to Provide an Expert Declaration to Rebut Patent Owner's Expert Declaration

Petitioner fails to respond to many arguments and evidence set forth and cited to in PO's Response and the declaration from PO's technical expert Dr. Ben-Tzvi.¹ Even to the points Petitioner does respond to, Petitioner merely resorts to attorney argument while failing to attach a supporting declaration from their technical expert to rebut the many points raised by PO's expert in the filed Response relating to

¹ Throughout this Sur-reply, PO lists the arguments and evidence cited to in PO's Response that Petitioner failed to respond to or rebut.

technical issues and how a PHOSITA would interpret the claims and the prior art. [U]nsworn attorney argument . . . is not evidence and cannot rebut . . . other admitted evidence. *Wasica Fin. GmbH v. Cont'l Auto. Sys.*, 853 F.3d 1272, 1284 (Fed. Cir. 2017); *BAE Sys. Info. and Elec. Sys. Integration, Inc. v. Cheetah Omni, LLC*, IPR2013-00175, Paper 45 (PTAB June 19, 2014).

II. Claim Construction

Petitioner's claim construction arguments should be rejected as they rely on extrinsic evidence while ignoring the intrinsic evidence that is the most relevant to what the inventor believed to be the invention.

A. "Compartment(s)"

The term "compartment" should be given the definition that is consistent with the '650 Patent specification, the definition agreed upon by Petitioner in the parallel litigation between the parties and the definitions applied by the Western District of North Carolina and the Northern District of Texas – e.g., being "enclosed". Ex. 2012, ¶¶50-54. Again, Petitioner is being disingenuous by arguing two different definitions in two different parallel legal proceedings.

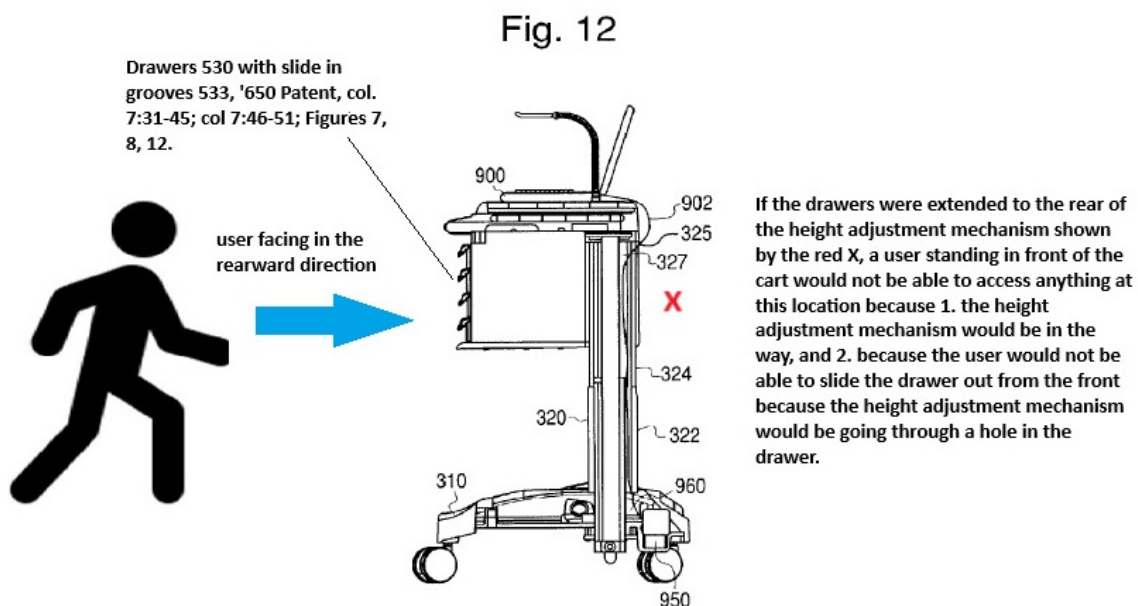
Even if the PTAB were to disagree with PO's proposed definition of "compartment", neither Clark nor Reeder teach compartments disposed at the

specific location claimed in the claims at issue under either parties' construction as explained in PO's Response and below.

B. “[C]ompartment is *disposed in* the portion of the work platform that projects from the height adjustment mechanism in the *forward* direction, and the compartment is configured to permit a user facing in the rearward direction to access the item within the compartment”

1. Implicit Redefinition/Disclaimer of “Disposed In” (in context of other claim terms)

As explained in PO's Response, PO's proposed definition of “disposed in” as being “contained in” or “entirely in” is consistent with the only embodiment disclosed and in the context with the rest of the claim language that requires the compartment(s) to be “configured to permit a user facing in the rearward direction to access the item within the compartment.” PO Response, pgs. 25-28; Ex. 2012, ¶ 57. The only relevant embodiment described in the '650 Patent has a drawer



disposed entirely in the front of the height adjustment mechanism (hereinafter “HAM”) and any other construction is inconsistent with the claim language because extending the drawers to the rear of the HAM would lead to an impossible result (a user facing in the rearward direction would not be able to access an item behind the HAM). *Id.*

In fact, Petitioner's own expert testified at his deposition that a PHOSITA would understand the drawers to be in the forward position in order to be accessible by the user. PO Response, pg. 27; Ex. 2010 at pg. 103:19-104:6; 134:15-135:7 (testifying that if the drawers of Fig. 12 were extended to the rear a user standing in front of the cart would not be able to access items to the rear of the support member). In the filed Reply, Petitioner failed to submit a declaration from their expert refuting this deposition testimony.²

Based on the intrinsic evidence (patent specification and claim language context), PO's expert Dr. Ben-Tzvi provided a declaration that a PHOSITA would construe the term “disposed in” as “contained in” or “entirely in”. Ex. 2012, ¶ 57.

² Instead of relying on intrinsic evidence to construe this claim term, Petition merely relies on another Capsa commercial cart not described in the '650 Patent for support of its definition. Reply, pgs. 6-7; Ex. 1043. This is extrinsic evidence that should not be relied upon if the intrinsic evidence is clear as in this case. Petitioner also fails to address PO's argument that a user would not be able to access an item located behind the HAM if the drawer is extended to the rear of the HAM.

Petitioner failed to provide a reply declaration from its expert on how a PHOSITA would interpret this claim term in view of the evidence.

2. “Forward” means “in front”

a. This is the plain and ordinary meaning and no clear disclaimer is needed

PO provided evidence in the filed Response, demonstrating that the plain and ordinary meaning of “forward” means “in front” and not on top. See Response, pgs. 28-29 (citing to dictionary definitions of “forward”); Ex. 2012, ¶ 58; Ex. 2010, at 105:7-21 (Petitioner’s own expert agreeing that “forward” means “towards the front”). Petitioner failed to respond to this argument in its Reply.

b. In the alternative, there was clear disclaimer

Alternatively, as argued in PO’s Response, if “in front” is not considered the plain and ordinary meaning of “forward”, the Applicant clearly defined the term as such by disclaiming workstations that are mounted at the top of the cart or HAM. PO Response, pgs. Section II.B., pg. 29-30.

Petitioner now argues, by way of attorney argument, that there was no clear disclaimer alleging that the statements at issue from the ‘650 file history were “directed to the claimed work surface, not the compartments”. Reply, pgs. 7-8. Petitioner is wrong because Petitioner did not address all of the statements around Clark from the file history. The Applicant also distinguished Clark based on the

“structural compatibility” issues with combining the teachings of Clark with the other cited references (resulting in unstable combinations). As discussed in the filed Response, Clark was also disclaimed because the Patentee argued that the top-heavy workstation of Clark cannot adequately support the weight of “*any* particular feature(s)”/components because adding such components would make the cart too unstable so that it would be easily knocked over. See excerpt below from the ‘650 file history:

Similarly, one of ordinary skill in the art would not have had a reason to incorporate any particular feature on Murphy into the workstation of Clark because Murphy is designed to be low to the ground (that is, a lower center of gravity) and modifying the workstation of Clark (with its high 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. Accordingly, one of ordinary skill in the art would not combine the teachings of Clark, Rice, and Murphy so as to arrive at a height-adjustable work platform with a movable work surface located above a compartment. Thus, claim 1 is allowable over Clark, Rice, and Murphy.

See Response, pgs. 12-15 (citing to the ‘650 file history at Ex. 2003, OAR of 3/28/2012, pgs. 8-12 and also discussing “structural compatibility” issues discussed in the Examiner’s interview).³ The top-heavy workstation of Clark was disclaimed because it would not support the weight of “*any other feature*”/component – and not

³ These “structural compatibility” issues were separate arguments from the amendments made to the claims relating to moveability or positioning of the work surface in relation to the compartments. *Id.* As discussed in PO’s Response, the original Examiner required the Applicant to make these arguments relating to structural compatibility in order to gain allowance of the claims at issue. *Id.*

just the work surface as Petitioner alleges.⁴ In other words, Patentee disclaimed adding “any particular feature” (e.g., compartments) to top-heavy workstations like Clark located at the top of the cart. As discussed above, the patented ‘650 cart, unlike Clark, is designed to be lower to the ground (like Murphy discussed in the excerpt above) because the compartments of the patents-at-issue are in front of the HAM and not on top of it.⁵ Thus, by clearly claiming that the compartments are disposed in the portion of the workstation in front or forward of the HAM and thus lower to the ground, it follows that these claim terms should not be construed to include compartments on top of the HAM.⁶

⁴ Petitioner is now making essentially the same arguments in its Petition that were overcome during original prosecution. For example, Petitioner is now arguing that it is obvious to modify the workstation of Clark with the additional feature of compartment(s) even though the Patentee overcame similar arguments by disclaiming this modification as it would lead to an unstable cart.

⁵ Said another way, the only reason the claimed invention is designed to be lower to the ground when compared to the cart of Clark is due to the compartment(s) being disposed in front of the HAM, not on top of it.

⁶ Whether or not the cart of Clark is in fact unstable is not relevant for the purposes of claim construction. What is important is that the Patentee at the time of prosecution believed the cart was unstable and made the file history statements at-issue under that belief. Thus, these statements are the most relevant intrinsic evidence representing what the Patentee believed to be the invention. Petitioner also makes allegations based on extrinsic evidence that other factors go into stability of carts (etc., weight or width of base), yet none of these factors were raised in the ‘650 file history in overcoming Clark – only the top-heavy workstation portion was discussed.

Petitioner does not even address these particular file history statements nor does the Petitioner provide any declarations from their expert on how a PHOSITA would interpret these statements around Clark. Petitioner also does not address the Examiner Interview where the Examiner asked the Patentee to address the “structural compatibility” issues with the combination of Clark with the other cited references (e.g., instability). Thus, the only evidence in the present record relating to these file history statements is PO’s expert’s un rebutted testimony that a PHOSITA would interpret these statements as meaning that “forward” means “in front” and not on top. Ex. 2012, ¶ 38-44, 59-61.

Based on the foregoing, the claim phrase “compartment is *disposed in* the portion of the work platform that projects from the height adjustment mechanism in the forward direction” in the context of the other claim terms means “compartment is *contained in* the portion of the work platform projecting in front of the height adjustment mechanism”.⁷

⁷ Petitioner cites to the *Gypsum* case for alleged support of their argument that the file history statements from the ‘650 Patent are not relevant to the ‘668 Patent. In its Reply, Petitioner fails to address the relevancy of the *72Lux* case cited for support by PO. Nevertheless, the facts of the *Gypsum* and *72Lux* (and the present case) can be distinguished. In the present case, similar to the *72Lux case*, the parent and child patents shared the same exact descriptions, the same claim language at-issue, and the same Examiner, thus making it logical to apply the file history statements to the claim term common to both patents. To hold otherwise would lead to different

III. GROUNDS 1 and 2: Petitioner Fails to Show that any Challenged Claim Is Unpatentable Under Grounds 1-2

A. None of the Cited References, Including Clark, Discloses Configuring Compartment(s) at the Specific Location Claimed

- 1. Even assuming the keyboard tray cavity of Clark is a “compartment”, the keyboard tray cavity is on top of the HAM and not contained in the portion of the work platform projecting in front of the height adjustment mechanism**

Petitioner alleges that the portion of the keyboard cavity shaded in blue meets these claim limitations. PO disagrees because the keyboard cavity of Clark: 1.) is not an “enclosed” compartment; 2.) even assuming it is a “compartment”, it is not disposed in front of the HAM (it is on top); and, 3.) even if, it meets the “forward” limitation, it is not contained/entirely in the forward-projecting portion of the

definitions for the same claim term from patents sharing the exact same descriptions. Even assuming that the statements from the ‘650 file history do not amount to “automatic” estoppel, these statements are relevant to what the Applicant felt was the invention and the scope of the claims. *Microsoft Corp. v. Multi-Tech Sys.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004) (the CAFC finding that file history statements from a child application were relevant to claim construction of similar claims in the previously issued parent application stating “the relevance of the statement made in this instance is enhanced by the fact that it was made in an official proceeding in which the patentee had every incentive to exercise care in characterizing the scope of its invention”). *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005) (finding that claims must be interpreted consistently across all related patents and that file history statements made in one patent are relevant to the scope the same term used in other related patents).

workstation. As illustrated in the annotated photo below, the unenclosed keyboard cavity of Clark is not located in the specific location recited in the claims (shown in green).⁸

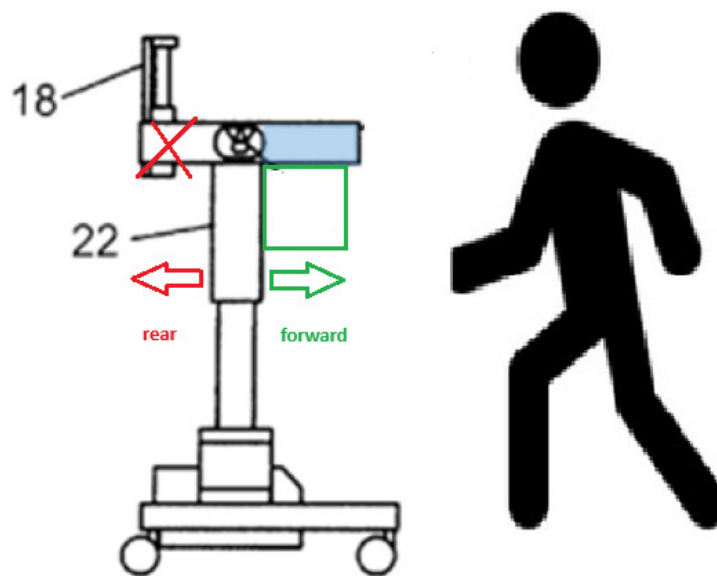


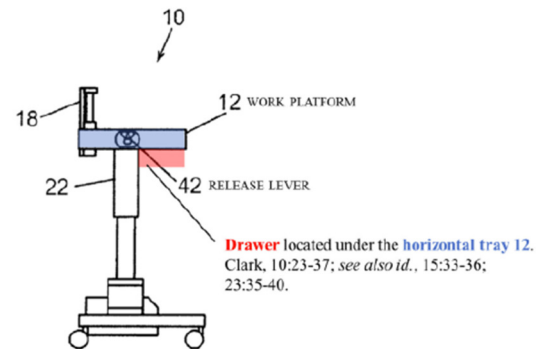
Fig. 2B

⁸ Contrary to Petitioner's allegations, the keyboard tray 12 is mounted to the top of the HAM. The tray 12 is mounted to the telescoping cover portion 22 or 226 of the HAM. Clark, Ex. 1010 at 8:60-66; 13:50-59. Initially, Petitioner improperly cites to the Preliminary Response for support. Further, the only portion that goes through the hole in the keyboard cavity is inner shaft 72 (inside of component 22) that is pushed to move the HAM up and down. Clark, Ex. 1010, col. 11:50-59; 12:20-29; Figs. 9A-9D. The keyboard cavity (alleged compartment) does not project from this inner shaft portion.

2. The vague, one-sentence, mention of a “drawer” in Clark does not specify that it is “disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction”

Clark does not teach the placement of compartments at this very specific location claimed. Petitioner merely relies on conclusory attorney argument to fill in the gaps left by Clark (and now Reeder). For example,

in the Reply brief, Petitioner *draws in* a red drawer disposed in front of the height adjustment mechanism of Clark even though Clark never specifically states that the drawer should be placed in this specific

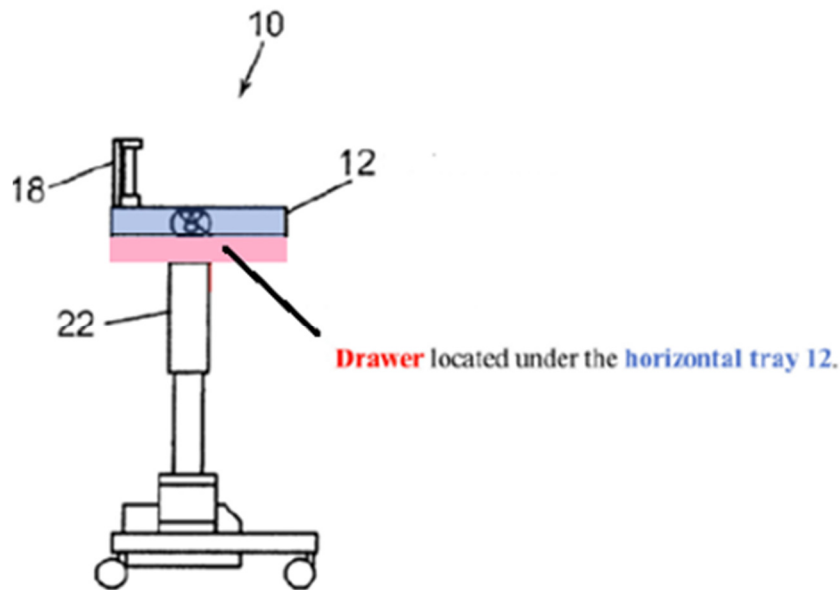


Clark, Fig. 2B (annotated)

location. See Petitioner Reply, pg. 12 (Figure 2b of Clark with red drawer annotated by Petitioner reproduced above).

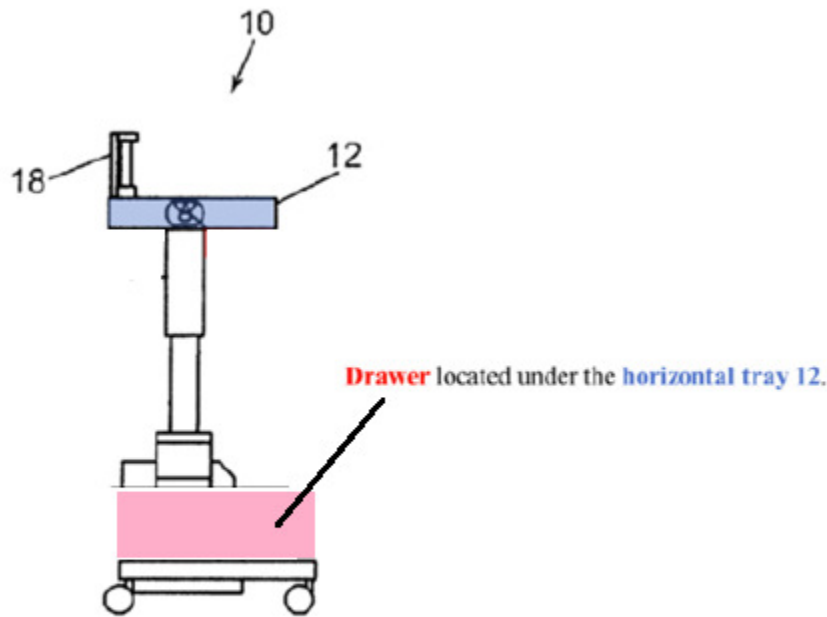
As explained in PO's Response, Petitioner's expert even admitted that this one sentence in Clark fails to explicitly teach that the alleged drawer of Clark be attached to the underside of the keyboard tray 12 and fails to explicitly state the alleged drawer should be contained entirely in the forward-projecting portion of the workstation of Clark as required by the '650 claims at issue as properly construed. Ex. 2010 at 132:1-135:7 (Petitioner's expert admitting that “under the tray” could mean all the way at the base where the battery is located and it could also mean there

is a space between the drawer and the tray), Response, pg. 36.⁹ For example, the alleged drawer of Clark could, *hypothetically*, be placed at any of the locations illustrated below which further confirms that the passing, vague, one-sentence to the alleged drawer teaches nothing about placing the drawer at the specific location recited in the claims at-issue.



Clark, Fig. 2B (annotated)

⁹ Petitioner cites to other portions of Mr. Kemnitzer's deposition for support, but these conclusory statements by Petitioner's expert cannot fill in gaps in the teachings of Clark. Reply, pg. 12-13. At most, these statements by Petitioner's expert are mere opinions that the alleged drawer *could be* placed at specific locations –not that they are. *Id.*



Clark, Fig. 2B (annotated)

Clark does not teach the placement of a drawer at the specific location recited in the claims and Petitioner improperly relies on attorney argument and conclusory statements from its expert to fill in the gaps of Clark. *Osram Sylvania, Inc. v. Am. Induction Techs., Inc.*, 701 F.3d 698, 705-06 (Fed. Cir. 2012)(reversing anticipation decision because Defendant failed to rebut Patentee's expert or provide specific factual evidence of how a PHOSITA would interpret the vague, generic disclosure).

B. Petitioner Failed to Articulate a Motivation to Combine/Modify Clark to Reach the Claimed Invention

Because Clark does not teach the placement of the alleged drawer at the specific location recited in the claims at issue, the only way Petitioner can meet its

burden of proving obviousness is by providing evidence of a motivation to combine or modify the references to reach the claimed invention. Petitioner has failed to provide such evidence.

Petitioner's only argument relating motivation to combine/modify the references amounts to conclusory statements from its expert that, in general, the use of drawers was desired and obvious and that "such modifications were routine and with the level of ordinary skill". Reply at 14-15. These conclusory statements, even if true, do not rise to sufficient evidence of a motivation to combine/modify the references.

Petitioner fails to provide any evidence of a motivation to modify Clark or Reeder to place the compartments at the specific location claimed. The case precedent is clear. Just because the prior art *can be* modified to reach the claimed invention does not make the modification obvious unless the prior art suggested the desirability of the combination.

"Conclusory expert testimony and attorney argument cannot constitute substantial evidence of a motivation to combine... We have found expert testimony insufficient where, for example, the testimony consisted of conclusory statements that a skilled artisan *could* [**19] combine the references, not that they *would* have been motivated to do so.

Acoustic Tech., Inc. v. Itron Networked Sols., Inc., 949 F.3d 1366, 1375-76 (Fed. Cir. 2020); *TQ Delta LLC v. Cisco Sys.*, 942 F.3d 1352, 1360 (Fed. Cir. 2019).

(Petitioner must provide evidence why a PHOSITA would combine references “in the way the claimed invention does.”). Additionally, mere recognition by the Petitioner of the need for drawers does not render the specific solution obvious. *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 381 F.3d 1371, 1377 (Fed. Cir. 2004)(finding recognition of the problem does not render the solution obvious). Petitioner improperly uses the teachings of the patents-at-issue as a blueprint, in hindsight, to reconstruct the patented invention.

As stated in PO's Response, Petitioner has failed to articulate any reasons as to why a PHOSITA would be motivated to dispose enclosed storage compartments in the workstation portion of Clark at all, much less disposed in the portion of the work platform projecting in front of the height adjustment mechanism, or how such a modification would be successful in view of the fact that the workstation of Clark is mounted entirely on top of the height adjustment mechanism resulting in an unstable design with a higher center of gravity (or “COG”). Because Petitioner has failed to meet its burden to provide evidence of a motivation to combine/modify Clark to reach the claimed invention, the Petition should be denied – this burden never shifts to PO.

C. Even though Petitioner failed to provide evidence of a motivation to modify Clark to reach the specific limitations (which is fatal to their Petition), and even though the burden never shifts to PO, Patent PO

provided evidence that a PHOSITA would not be motivated to modify Clark to reach the claimed invention

As discussed in PO's Response and above, Petitioner failed to provide a motivation to combine/modify the references to reach all the limitations of the claimed invention. If the PTAB agrees, there is no need to address the below arguments as the burden never shifts to PO. Notwithstanding, PO did submit evidence in its Response that a PHOSITA would not be motivated to modify Clark to reach the claimed invention. For example, PO provided evidence that a PHOSITA concerned with stability, would side with conventional wisdom at the time, and would keep the top workstation of Clark as light and unencumbered as possible. See Response, pgs. 39-47 (citing to the Reeder and Petitioner's own expert's patent (Ex. 2011 to Kemnitzer)). In Petitioner's Reply, instead of rebutting this evidence¹⁰, Petitioner cites to irrelevant hypothetical embodiments and to static formulas that are not relevant to stability of objects.

1. Statics vs Dynamic: The static formulas used in Petitioner's Exhibit 1038 are not relevant to object stability

PO's expert testified at his deposition that the "static" formulas and *F (force)* discussed in the hypothetical examples of Exhibit 1038 relates to the force to start

¹⁰ Again, Petitioner's expert did not even submit a declaration with Petitioner's Reply.

the lifting of the cart/object off the level ground but is not determinative of how stable the object is (how resistant the cart is to tipping over when an external force is applied or when it goes over a slanted surface). As discussed in depth in PO's Response, the COG *is* relevant to when the object tips over (or how resistant the object is to tipping). In other words, all other factors staying the same (e.g., base weight, base weight, distance from pivot point to COG), a decrease in the COG will increase the stability of the object/cart.¹¹

Petitioner provided no admissible evidence that the static formula used by Petitioner in Exhibit 1038 is relevant to stability testing of objects or that is used in UL60601 stability testing. Petitioner's expert failed to provide any testimony or declaration statements that the static formula is relevant in this context.

2. Petitioner's technical discussion of skewed, hypothetical embodiments with different COGs is irrelevant

Petitioner's arguments are also biased and misleading as it skews the dimensions of the two hypothetical carts to achieve the *static* results they desired (e.g., Petitioner changed the horizontal location of the COG from left to right and increased the length of the TAM on only one of the hypothetical carts but not the

¹¹ Pinhas deposition transcript, Ex. 1039, pg. 182:20-22, and page 183:1-9; pgs. 181:11- 184:21, (testifying that this force only relates to momentary lifting of the wheel off the ground and does not relate to stability of the object).

other of the cart).¹² For example, if one moved the COG horizontally to the right, or decreased the COG from 18" to 12" in Figure 1, the force required to lift the cart off the ground would be greater for Figure 1 than Figure 2.¹³ Additionally, even if Petitioner's hypothetical examples increases stability on one side of the cart, it decreases stability on the other side (carts need to be stable in all directions). Thus, even if Petitioner's static formulas are relevant to stability (which they are not), the hypothetical examples of Exhibit 1038 are manipulated and skewed to obtain only one desired result the Petitioner is looking for.

3. On the contrary the formulas cited in the Response Declaration of Expert Pinhas Ben-Tzvi cite to formulas that relate to object stability in a dynamic context (the Petitioner has failed to rebut the relevancy of these formulas or analysis with competing expert testimony or declarations)

PO expert, Dr. Ben-Tzvi, testified in his declaration and explained the torque and tipping angle formulas for explaining stability or dynamic tipping forces. See Response, pgs. 42-45; Pinhas Response Declaration, Ex. 2012, paras. 81-85 (discussing the rotational torque formula and tipping angle formulas). Contrary to

¹² It requires more force to lift the cart of Figure 1 off the ground than the cart of Figure 2 when applying force to the opposite side from the red arrow indicated in Exhibit 1038.

¹³ Additionally, Petitioner's Exhibit 1038 is wrong because Petitioner uses the height of the cart 36" as the height (h) instead of the height of the COG (12" for Figure 1 and 18" for Figure 2).

Petitioner's arguments, these formulas show that COG *is* relevant to *when* the object tips over (or *how resistant the object is to tipping over*). *Id.* In other words, as explained, torque causes rotational motion, and tipping over of the object occurs when the torque generated by an applied force overcomes the stabilizing torque created by the object's weight acting through the center of gravity. *Id.* In other words, all other factors staying the same (e.g., base weight, base weight, distance from pivot point to COG), a decrease in the COG will increase the stability of the object/cart (a lower COG means that the distance between the COG and the base of the object is reduced because by lowering the COG, the lever arm through which gravity can exert torque on the object is effectively decreased, making it more stable and resistant to tipping over). *Id.* at para. 82. Said in an opposite way, in a real-world dynamic situation, the higher the COG, the more top-heavy the system, and the easier it becomes to tip over the cart once rotational motion begins. *Id.* The higher the COG leads to a larger moment arm, and as the cart starts lifting off the ground, it will gain rotational momentum much more quickly when compared to a cart with a lower COG. Petitioner has failed to provide any evidence or rebuttal from their expert (e.g., in the form of a declaration or otherwise), rebutting the application of the torque and tipping angle formulas applied by Patent Owner's expert to object stability.

4. Petitioner relies on conclusory opinions that the battery of Clark weighs 70 pounds to argue that Clark is not top-heavy

Petitioner cites to the spec sheet of a JACO branded battery (extrinsic evidence not found in the Clark patent) and concludes that this particular battery must be the exact battery and weight used by the cart described in Clark patent. However, Petitioner's expert admitted that this Jaco battery might not be the actual battery used in Clark, that he has never seen a commercial embodiment of the cart of Clark, and he does not know how much other portions of the cart weighs. Ex. 2010, pgs. 15:14-23:6; 86:4-87:7. There is absolutely no discussion in the Clark patent regarding stability, much less any teaching or suggestion to increase the weight or size of the base portion to increase stability. On the contrary, PO's expert Dr. Ben-Tzvi testified at his deposition that it was improper to conclude the battery of Clark was 70 pounds based on weight-to-capacity ratios of batteries of that timeframe. Ex. 1039, 143:5-149:3. He also testified that there is no way for sure to tell if the actual commercial embodiment of the cart described in Clark is unstable because no such cart exists, at least in evidence. *Id.*

Even if Petitioner's arguments about the weight of Clark's battery were true (e.g., that it is 70 pounds) and that the cart of Clark could support additional weight (e.g., without becoming unstable), PO provided evidence that a PHOSITA, at the time of filing of the patents-at-issue, would still want to keep the weight at the top

of the workstation as light and unencumbered as possible (lower COG) in order to increase the stability of the cart (the more stable the cart, the better). Response, pgs. 38-47. As discussed above, the evidence (including Petitioner's expert's patent) shows that a PHOSITA would place the compartments at a stationary base portion far away from the top-heavy workstation. Again, Petitioner failed to provide any declarations from its expert rebutting this evidence.

IV. GROUND 3: Petitioner Fails to Show that any Challenged Claim is Unpatentable under Ground 3

Petitioner fails to rebut PO's arguments relating to Reeder. Reeder does not teach disposing compartments (enclosed or not) at the specific location recited in the patents-at-issue.

A. None of the cited references, including Reeder, discloses compartment(s) "disposed in" a height adjustable work platform

Even if the unenclosed wire trays and storage bins of Reeder are considered "compartments", they are not disposed in anything, much less a height adjustable work platform as claimed. Again, Petitioner has failed to rebut its own expert's previous deposition testimony that there are no drawers in the workstation portion 378 of Reeder.

B. None of the cited references, including Reeder, discloses compartment(s) "disposed in the portion of the work platform that projects from the height adjustment mechanism in the forward direction"

As discussed in PO's Response, Reeder fails to teach the placement of compartments in the workstation portion at all, much less at the very specific location claimed. The only drawers mentioned in Reeder, are placed at a stationary base portion as far away from the workstation at the top of the cart as possible.

C. Petitioner Has Failed to Articulate a Motivation to Combine/Modify Reeder to Reach the Claimed invention

As discussed in PO's Response, Petitioner fails to provide any argument whatsoever that a PHOSITA would be motivated to add compartments/drawers at the very specific location claimed (contained in the portion of the work platform projecting in front of the HAM). Petitioner merely cites to evidence that drawers, in general, are desired in mobile carts (and then in conclusory fashion opines that one could place the drawers below/under¹⁴ the workstation) but provides no argument, much less evidence, that a PHOSITA would be *motivated* to dispose the compartments at the *very specific location* claimed (e.g., instead of at the stationary base where Reeder actually places the drawers or mounted on top of the HAM).¹⁵ Response, pgs. 57-60. Petitioner improperly uses the teachings of the patents-in-

¹⁴ As discussed in Section III.A.2, "under" can mean different things including at the base of the cart as opposed to being attached to the underside of the cart.

¹⁵ Petitioner cites to the Ellman reference for support, but Ellman does not teach height adjustable compartments at all much less compartments contained in a portion of the work platform projecting in front of the height adjustment mechanism.

suit, in hindsight, as a blueprint to modify the references. Petitioner's grounds fail to demonstrate the required proof for meeting a prima facie case of obviousness. Just because a PHOSITA *could* add drawers to Reeder does not provide evidence that a PHOSITA, at the time of filing the patents-in-suit, would have a motivation or desire to configure the compartments at the specific location claimed. See case law cited in Section III.B. Because Petitioner has failed to meet its burden, its grounds based on Reeder must fail, and the burden to rebut never shifts to PO.

Although the burden never shifted to PO, PO provided evidence that a PHOSITA at the 2003-2004 timeframe had motivations to keep the workstation at the top of the cart as light and unencumbered as possible to maintain stability. The only drawers mentioned in Reeder are placed at a stationary base portion as far away from the workstation at the top of the cart as possible. Ex. 2012, paras. 104-107. Thus, PO's expert opined that Reeder would have led a PHOSITA in a different direction. *Id.* Thus, PO provided evidence that a PHOSITA would not be motivated to add compartments to the workstation of Reeder.

V. Secondary Considerations of Nonobviousness

Because Petitioner has failed to meet its burden to prove obviousness, resort to secondary considerations is not needed. However, PO provided this evidence in Response, and the evidence does confirm the nonobviousness of the patents-at-issue.

Contrary to Petitioner's allegations, PO did provide evidence of a nexus between the success of the patented cart and the claims of the patents-in-suit. Ex. 2018, Rydingsward dec., paras. 1-17 (stating that the placement of the drawers in front of the HAM is a major reason the Capsa carts have a lower COG, are stable, and sell so well).¹⁶

Mr. Rydingsward also provided evidence that many competitors, including Capsa, copied the inventions of the patents-in-suit after Rubbermaid, the original Patentee, came out with their invention. Petitioner fails to rebut this evidence of copying with contrary evidence (for example, Petitioner failed to provide any evidence that Petitioner, Capsa, Enovate, or Miller knew of or developed carts with the patented features prior to the patents-in-suit). See *Id.*, para. 18. Response, pg. 62.

Date: October 1, 2024

Respectfully submitted,

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¹⁶ Contrary to Petitioner's arguments, evidence of other Capsa carts without drawers is irrelevant. The claims of the Patents-in-suit recite a height adjustable work platform *with* compartment(s) in a manner that is designed to be lower to the ground (lower COG), and therefore more stable. The evidence demonstrates that nobody, at the time of filing, knew how to accomplish this without sacrificing stability.

Patent Owner's Sur-reply in IPR2023-01274
US Pat. No. 7,594,668
Dkt. No. CAP2491-144

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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 Patent Owner's Sur-reply to Petitioner's Reply to the Response to the Petition, the word count of this document, excluding portions exempt from the word count rules, is less than 5,600 words and is, in fact, 5595 words (including footnotes).

Dated: October 1, 2024

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Patent Owner's Sur-reply 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 to Petitioner's Reply to the Response to the Petition was served via electronic mail on October 1, 2024, on the following counsel of record for Petitioner as follows:

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