

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. 8,215,650

Case No. IPR2023-01275

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

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STATUTES

35 U.S.C. § 325(d)	1, 5
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*All emphasis added unless otherwise indicated.

LIST OF EXHIBITS

Exhibit #	Description
1001	U.S. Patent No. 8,215,650 (“the ’650 patent”)
1002	Prosecution File History of U.S. Patent No. 8,215,650
1003	Declaration of Mr. Ronald B. Kemnitzer
1004	Curriculum Vitae of Mr. Ronald B. Kemnitzer
1005	Reserved
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	Reserved
1009	U.S. Pub. No. 2003/0084828 to Gillis (“Gillis”)
1010	U.S. 6,493,220 to Clark (“Clark”)
1011	U.S. Patent No. 4,715,295 to Hartman (“Hartman”)
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. 5,806,943 to Dell (“Dell”)
1015	U.S. Patent No. 5,518,310 to Ellman (“Ellman”)
1016	U.S. Patent Publication No. 2002/0013640 to Phoon
1017	U.S. Patent No. 5,564,803 to McDonald
1018	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
1019	German Patent Application DE 102 56 419 A1 (with English certified translation)
1020	U.S. Patent No. 5,870,647 to Nada
1021	U.S. Patent No. 6,595,144 to Doyle
1022	U.S. Patent No. 6,119,605 to Agee
1023	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)
1024	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)

Exhibit #	Description
1025	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)
1026	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)
1027	U.S. Patent No. 6,578,501 to Moore
1028	U.S. Patent No. 6,883,439 to Moore
1029	U.S. Patent No. 4,440,096 to Rice et al. (“Rice”)
1030	U.S. Patent No. 4,976,450 to Ellefson (“Ellefson”)

Discretionary denial under § 325(d) is improper under step one of *Advanced Bionics*, ending the analysis. The Office was never made aware of prior art analyzed by the Petition during original prosecution, including *Reeder* and *Manner*. And to the extent the Office previously considered *Clark*, the Petition demonstrates how the Office erred in granting the '650 patent over *Clark* in the first instance. Thus, under either step of the of the *Advanced Bionics* two-step framework, the Board should reject Capsa's demand to deny the Petition under 35 U.S.C. § 325(d).

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

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

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

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

The Petition presents new prior art not previously considered by the Office, including *Reeder* as a primary reference (Ground 3) and *Manner* as a supporting

reference (Grounds 1-3). *See* '650 patent, (56), Ex. 1002. The Petition thus presents prior art and combinations never considered by the Office, mooted Capsa's § 325(d) arguments. *See Unified Patents, LLC v. Lighthouse Consulting Grp.* IPR2020-00194, Paper 15, 13-14 (P.T.A.B. June 9, 2020).

While a related *Clark* disclosure was discussed during prosecution of the '650 patent, the Petition's combination involving *Clark* in Grounds 1-2 is new to the Office. During prosecution, the Examiner considered Applicant's arguments as it relates to the position of the actuator, including whether the cited supporting reference (*Rice*) disclosed a control panel 30 above a compartment on the portion of the work platform that projects in the forward direction. Ex. 1002 at 156-57; *Rice*, Fig. 1, 2:35-50. *Manner*, however, clearly supplies this claim requirement with its mechanical actuator readily relocatable using a Bowden cable. Pet. § VI.C.10, XI.C.10. Indeed, *Manner* explains that its actuator may be substituted for an actuator like that found in *Clark*. *Id.*

Ground 3 also presents an entirely new primary reference, *Reeder*, never considered by the Office before. *See* '650 patent, (56); Ex. 1002. *Reeder* differs from *Clark* in several respects. For example, *Reeder* discloses different arrangements of compartments compared to *Clark*. Pet. §§ VI.C.2, IX.C.2. *Reeder*'s compartments are also positioned lower on the cart relative to *Clark*, lowering the center of gravity and countering Patent Owner's suggestion that any newly proposed combination

would end up in a top-heavy arrangement. Indeed, *Reeder*'s base already projects in the forward direction to contribute toward stability of the cart when loading the compartments with items. Pet. § IX.C.8. Because *Clark* and *Reeder* are not substantially the same to the prior art considered during prosecution, *Becton*, *Dickinson* factors (a) and (b) favor institution.

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

In the POPR, Capsa argues the mapped combination to claim 1 would result in impermissibly top-heavy carts prone to tipping over. POPR 62-63. This is demonstrably wrong. As an initial matter, the Applicant made its top-heavy argument during prosecution with respect to what would become dependent claim 7, not a broader independent claim challenged here. Specifically, the Applicant argued the tool chest design of *Ellefson*, “(including its lower center of gravity) permits the use of pivotal trays while the workstation of Clark (with its higher center of gravity) does not.” Ex. 1002 at 138-139. This argument addressed a different reference, *Ellefson*, as it relates to this unchallenged dependent claim 7: “the work surface is configured to move in at least one of a leftward direction and a rightward direction along an arcuate path”). *Id.*, 156-158, 235; *Ellefson*, Fig. 1 (trays 48, 50, and 52). But unlike *Ellefson*'s supposedly heavy components, the Petition explains *Gillis* teaches a clearly lighter keyboard tray that moves along an arcuate path. Pet., 15-16, *Gillis*, Figs 1-2. The Petition also explains how *Gillis* would have been substituted

for *Clark*'s existing keyboard tray without having to introduce other components making the cart top-heavy. Pet. §§ VI.B, VI.C.2, IX.C.2. Capsa's top-heavy arguments against the *Clark-Ellefson* combination are, therefore, besides the point.

As the Petition explains, the Examiner missed how *Clark* teaches a moveable work surface "above a compartment" because the Examiner did not appreciate that *Clark* describes a drawer positioned under the pull-out keyboard. Pet. § VI.C.2; *Clark*, 10:30-33. *Clark*'s combination with *Manner* therefore does not propose adding heavy components rendering the resulting cart unsteady, and the Petition further recognizes *Clark*'s full disclosure was overlooked by the Examiner. Thus, the Petition presents new arguments not previously considered by the Office, and *Becton, Dickinson* factor (d) favors institution.

B. *Advanced Bionics*, Part 2: The Office Erred When It Allowed the '650 patent

Because step one of the *Advanced Bionics* framework favors institution, the Office need not consider step two. *Advanced Bionics*, 10. Nevertheless, step two also favors institution because the Petition demonstrates the Office erred in granting the '650 patent over *Clark*. During prosecution, the Applicant amended claim 1 to limit the work surface to being "disposed above a top of the at least one compartment" and being "movable relative to a remainder of the work platform from an extended position to a non-extended position." Ex. 1002, 132. The Applicant argued that *Clark*

did not teach a moveable work surface located above the mapped compartment, and the patent was allowed. *Id.*, 125, 138.

This was error because when the Applicant argued that *Clark* lacked a “movable work surface located above a compartment,” the Examiner overlooked an explicit teaching described in the specification that was not depicted in *Clark*’s figures. As the Petition explains, *Clark* teaches a moveable work surface above a compartment **because *Clark* explicitly teaches that a drawer may be positioned under the pull-out keyboard.** Pet. § VI.C.2. In particular, *Clark* states “the docking station 18 could be supported in a substantially horizontal position, for example by a drawer or pull-out tray located above or under the horizontal tray 12.” *Clark*, 10:30-33. By disclosing that its drawer can be located under the horizontal tray 12, and that its pull-out keyboard can be located above the horizontal tray 12, *Clark* discloses a moveable work surface disposed above a top of a compartment. Thus, the Office overlooked this express teaching by *Clark*, and it was error to issue the ’650 patent. Thus, step two of the *Advanced Bionics* framework favors institution.

II. Conclusion

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

Date: January 11, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Reply to Patent Owner's Preliminary Response and Exhibits 1029 - 1030** were served electronically via email on January 11, 2024, in its entirety on the following:

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