

**From:** Trials <Trials@USPTO.GOV>  
**Sent:** Thursday, January 4, 2024 1:56 PM  
**To:** Young, Michael; Trials  
**Cc:** F. Michael Speed; Jeffrey Standley; James Kwak; Adam Smith; StandleyDocketing; Mulcahy, John; Ferrill, Elizabeth; Smiley, Deanna; Jordan, Dan; Rosenberger, Mark  
**Subject:** RE: Howard v. Capsa, IPR2023-01274 and -01275, Petitioner Request for Reply Brief to POPR

**Follow Up Flag:** Follow up  
**Flag Status:** Flagged

Counsel:

The panel has reviewed Petitioner's email request for additional briefing which is opposed by Patent Owner. The panel has considered the parties' respective positions set forth in the January 3<sup>rd</sup> email in light of the record and does not need a telephone conference with the parties.

Petitioner may submit a Reply to the Preliminary Response limited to responding to Patent Owner's request that the Board exercise its discretion to deny institution under 35 USC § 325(d). Petitioner is not authorized to address any other issues raised in its email request.

Petitioner is authorized to submit a 5 page Reply no later than January 11, 2024. Patent Owner may submit a 5 page Sur-reply responding only to Petitioner's Reply no later than January 18, 2024.

Regards,

Esther Goldschlager  
Supervisory Paralegal Specialist  
Patent Trial & Appeal Board  
U.S. Patent & Trademark Office

---

**From:** Young, Michael <[Michael.Young@finnegan.com](mailto:Michael.Young@finnegan.com)>  
**Sent:** Wednesday, January 3, 2024 4:49 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** F. Michael Speed <[mspeed@standleyllp.com](mailto:mspeed@standleyllp.com)>; Jeffrey Standley <[jstandley@standleyllp.com](mailto:jstandley@standleyllp.com)>; James Kwak <[jkwak@standleyllp.com](mailto:jkwak@standleyllp.com)>; Adam Smith <[asmith@standleyllp.com](mailto:asmith@standleyllp.com)>; [STANDLEYDOCKETING@STANDLEYLLP.COM](mailto:STANDLEYDOCKETING@STANDLEYLLP.COM); Mulcahy, John <[John.Mulcahy@finnegan.com](mailto:John.Mulcahy@finnegan.com)>; Ferrill, Elizabeth <[Elizabeth.Ferrill@finnegan.com](mailto:Elizabeth.Ferrill@finnegan.com)>; Smiley, Deanna <[Deanna.Smiley@finnegan.com](mailto:Deanna.Smiley@finnegan.com)>; Jordan, Dan <[Dan.Jordan@finnegan.com](mailto:Dan.Jordan@finnegan.com)>; Rosenberger, Mark <[mark.rosenberger@finnegan.com](mailto:mark.rosenberger@finnegan.com)>  
**Subject:** Howard v. Capsa, IPR2023-01274 and -01275, Petitioner Request for Reply Brief to POPR

|                                                                                                                                                                    |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>CAUTION:</b> This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments. |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------|

Dear Board,

Petitioner requests authorization to file a 7-page Pre-Institution Reply to Patent Owner's Preliminary Response (POPR) in the above-captioned proceedings. In particular, Petitioner requests authorization to reply to new issues raised in the POPR regarding claim construction, the level of ordinary skill, and discretionary denial.

Petitioner raised its request with Patent Owner on December 19, and the parties met and conferred on December 27. The Patent Owner opposes Petitioner's request for a reply after continued discussions. The parties therefore request a conference call with the Board, proving their respective positions below:

Petitioner: Regarding claim construction, Petitioner seeks the Board's permission to reply to the POPR's discussion of post-petition claim construction activity at the district court, including the agreed construction for "compartments" and a new claim construction proposed by the preliminary response that conflicts with Capsa's prior position regarding when compartments are "disposed in" the claimed work platform. Regarding the level of ordinary skill, Petitioner would respond to Patent Owner's proposed higher level of ordinary skill emphasizing "hard science type mechanical engineering, physics, and detailed implementation considerations" and associated suggestion that Mr. Kemnitzer lacks this experience with degrees in Industrial Design and a 40-year career designing furniture. This new emphasis conflicts with Patent Owner's prior acknowledgement that a person of ordinary skill need only a 2-year mechanical engineering degree with industry experience. And regarding discretionary denial, Petitioner would address Patent Owner's argument that the '668 patent should receive heightened deference based on its shared priority date with the '650 patent, and the Patent Owner's suggestion that the Board reconsider its current application of the *Fintiv* analysis to deny institution. There is good cause because Patent Owner argues each of these issues is dispositive and involve post-petition activities such that a commensurate reply from Petitioner would be beneficial for the Board (see, e.g., IPR2021-00788, Paper 17 at 2-3). Petitioner would not oppose Patent Owner filing a pre-institution sur-reply of equal length.

Patent Owner: Patent Owner respectfully asserts that there were no new issues raised in Patent Owner's Responses as alleged by Petitioner. The briefs already filed by the parties are entirely sufficient and need no further briefing. In particular:

1. Petitioner certainly anticipated the definition of "compartments" because Petitioner argued their IPR arguments in view of both Patent Owner's proposed definition (as being "enclosed" or "closed") and in the alternative Petitioner's proposed definition (not being "enclosed"). See e.g., '650 IPR, pg. 59-60. Petitioner's IPR Petitions address both alternative definitions. Second, it is Petitioner who agreed to Patent Owner's definition of "compartment" in the parallel litigation. It is disingenuous for Petitioner to agree to a definition of "compartments" previously proposed by Patent Owner in the on-going litigation (known to Petitioner prior to the filing of the IPR Petitions), then argue they were somehow prejudiced by their own actions.
2. Regarding the definition of compartments disposed in a forward-projecting portion of the work platform, these terms were recited in the '668 and '650

patents at the time Petitioner prepared and filed their IPR Petitions, so Petitioner should have anticipated these arguments. In fact, Petitioner did apply their own definition to this term based on how they read the claims at-issue against the Clark and Reeder references.

3. With respect to the level of ordinary skill, Patent Owner's definition of POSA has stayed consistent through the litigation and IPR responses. Petitioner was aware of Patent Owner's definitions and positions before the filing of the IPR Petitions based on knowledge of the arguments in Patent Owner's claim construction briefings in the on-going litigation which were served prior to the filing of the IPR Petitions.
4. Patent Owner did not argue a heightened deference for the '668 vs the '650 Patents and is unclear what Petitioner refers to here.

Based on the above, Patent Owner contends that nothing has changed since the filing of the IPR Petitions and Responses that amounts to good cause supporting the need for a reply brief, and Petitioner has not given any sufficient reasons.

Should Petitioner's petition for a reply brief be granted, Patent Owner respectfully requests the right to respond.

The parties are available Jan. 8-10 for a conference call. The parties also expect a claim construction order in the district court soon and would appreciate guidance on the panel's preference for receiving the entered claim construction order.

If any additional information is needed, please let us know.

Respectfully,

Michael Young, on behalf of Petitioner  
Reg. No. 61,180

F. Michael Speed, Jr., on behalf of Patent Owner  
Reg. No.: 53,627

**Michael V. Young, Sr. | Bio**  
Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP  
1875 Explorer Street, Suite 800, Reston, VA 20190-6023  
571.203.2788 | fax: 202.408.4400 | [michael.young@finnegan.com](mailto:michael.young@finnegan.com) | [www.finnegan.com](http://www.finnegan.com)

---

**FINNEGAN**

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.