

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAFE HAVEN WILDLIFE REMOVAL AND
PROPERTY MANAGEMENT EXPERTS LLC,

Petitioner,

v.

MERIDIAN WILDLIFE SERVICES LLC,

Patent Owner.

Case IPR2023-01340
Patent No. 9,943,073

Patent Owner's Preliminary Response

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Declaration of Dr. Michael J. Chamberlain (Nov. 29, 2023)
2002	Safe Haven's Patent Owner Preliminary Response, IPR2022-01254, Paper 8 (October 19, 2022)
2003	Safe Haven's Patent Owner Preliminary Response, IPR2022-01340, Paper 6 (November 8, 2022)
2004	Safe Haven's Sur-Reply, IPR2022-01340, Paper 8 (November 22, 2022)

GLOSSARY OF TERMS

TERM	DEFINITION
“Patent Owner” or “Meridian”	Meridian Wildlife Services, LLC
“Petitioner” or “Safe Haven”	Safe Haven Wildlife Removal and Property Management Experts LLC
“Board”	USPTO Patent Trial and Appeal Board
“IPR”	<i>Inter Partes</i> Review
“POSA”	Person of ordinary skill in the art at the time of the invention.
“’073 Patent”	U.S. Patent No. 9,943,073 to Brugh et al
“’663 Patent”	U.S. Patent No. 10,154,663 to Brugh et al
“’374 Patent”	U.S. Patent No. 10,251,374 to Tolley
“’108 Patent”	U.S. Patent No. 10,729,108 to Tolley
“’683 Patent”	U.S. Patent No. 11,064,683 to Tolley
“Challenged Claims”	Claims 1-3 of U.S. Patent No. 9,943,073.
“Brugh”	U.S. Patent Application Publication No. 2017/0238524
“Kunz”	Thomas H. Kunz et al., <i>Ecological and Behavioral Methods for the Study of Bats</i> 1-29 (1st ed. 1990). (Ex-1009)
“Albanese”	Gene Albanese et al., <i>An Inexpensive Elevated Mist Net Apparatus</i> , 24 N. Am. Bird Bander 129-134 (1999) (Ex-1010)
“Sheldon”	William G. Sheldon, <i>A Method of Mist Netting Woodcocks in Summer</i> , 31 Bird Banding 130-135 (1960) (Ex-1011)
“Bird Barrier Video”	Bird Barrier, Mist Net Kit Assembly and Use, YouTube (Aug. 29, 2014), https://www.youtube.com/watch?v=yHtYi-vUFXs (Ex-1003 and Ex-1004)

I. INTRODUCTION

Safe Haven's Petition challenges the '073 patent's claims under a single invalidity ground, within which it asserts that various permutations of the Bird Barrier Video, Kunz, Albanese, and Sheldon render the challenged claims obvious. But the Petition's arguments lack sufficient particularity, leaving it up to the Board to reverse engineer how the various references are being combined and why a POSA would have found it obvious to do so. In any combination, however, the Petition's evidence fails to establish a reasonable likelihood of unpatentability.

The Petition fails to properly construe the claims—ignoring express definitions in the patent specification—and offers no supporting testimony from a witness (expert or otherwise) who has reviewed the '073 patent and offered opinions supporting the Petition. Rather than securing such testimony, Safe Haven points to inadmissible and irrelevant testimony from an entirely different proceeding regarding an entirely different patent. And while the Petition's cited references lack the necessary disclosure to support an obviousness finding, Safe Haven's proposed motivations for combining them are even more deficient. The Petition does an about-face, proposing combinations of references that Safe Haven itself argued would never be combined in IPRs last year. For at least these reasons, the Board should deny institution.

II. OVERVIEW OF THE '073 PATENT

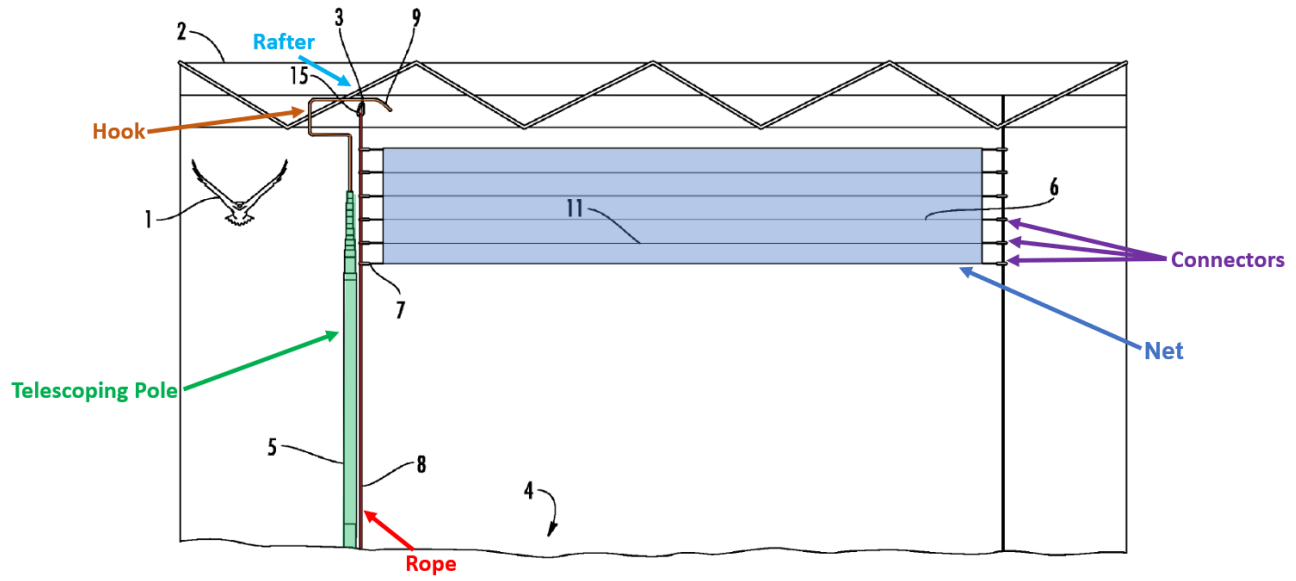
The method claimed and described in the '073 patent addresses a specific problem: how to remove a variety of flying vertebrate species from the inside of large, high-ceilinged buildings both safely and effectively. The resulting method—reflected in Claim 1 of the '073 patent—solved this challenging problem and has proven to be highly effective in the field.

As described in the '073 patent, the inventors first recognized that the “advent of large warehouses, big box stores, large grocery stores, malls, and the like, ... caused an increase in the number of birds, as well as other large flying vertebrates, such as bats, finding their way inside the buildings.” Ex-1001, 1:20-24. For large building operators, this proved highly problematic. “Depending on the species,” flying vertebrates could “remain in the building for an extended time,” leading to “the spread of disease,” “annoyance to customers,” and “the destruction of products inside the store.” Ex-1001, 1:24-29.

Equally problematic were the challenges in safely capturing and removing flying vertebrates in this indoor environment. Existing capture methods were typically inhumane, inefficient, or ineffective—in some cases all three. Ex-1001, 1:30-39. Moreover, large buildings “have high ceilings, making vertebrate removal very difficult.” *Id.*, 3:40-44. In addition, in any given large building, different species of flying vertebrate may be encountered—including “birds, bats, or any large flying

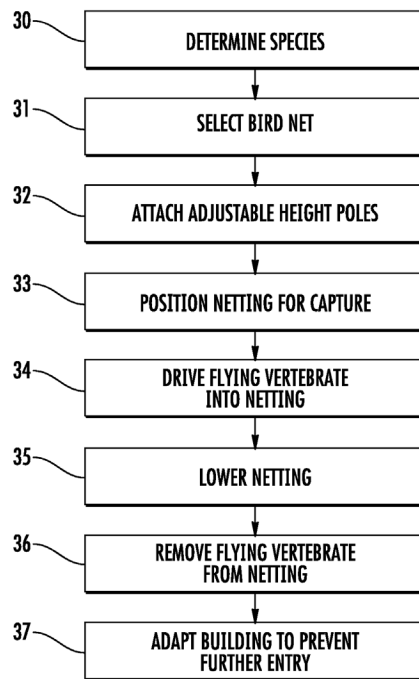
mammal.” *Id.*, 3:25-26, 1:21-29, 3:65 to 4:3. The variety of flying vertebrates encountered—coupled with the sheer size of the buildings they were increasingly inhabiting—presented a sizeable challenge.

To address this problem, the inventors devised an improved method for the safe live capture of a flying vertebrate inside a large building. Ex-1001, 1:53 to 2:5, 5:13 to 6:17. The inventors first developed an improved capture device that could be “deployed, repositioned, and lowered” quickly and easily, thereby “allowing for a much higher chance of recovering the flying vertebrate without harm.” *Id.*, 1:48-52. As shown by way of example in the '073 patent's Figure 1, the improved capture device included a bird netting (6) having pockets (11), a plurality of adjustable height support poles (5), a hook (9) for attaching the poles overhead (e.g., to ceiling rafter (3)), a pulley (15) attached to an upper portion of the poles, and a rope (8) attached to the pulley (the rope being attached to the bird netting by attachment devices (7)). *Id.*, 4:28-46, Fig. 1.



'073 Patent – Figure 1 (annotated)

The inventors further developed a method of using the improved capture device to safely capture a flying vertebrate in a large building, which is outlined by way of example in Figure 4. The first step in the capture method is “*determining the species* of flying vertebrate inside the building” (labeled step “30”). Ex-1001, 1:56-57, Fig. 4. The '073 patent explains that “determining the species” requires “observing the flying vertebrate and having an expert, a guide book, or the like, for determining what kind of flying vertebrate needs to be captured.” *Id.*, 3:58-61 (emphasis added).



'073 Patent – Figure 4 (annotated)

The initial “determining the species” step is important and performed first for several reasons. Different species of flying vertebrate may inhabit the interior of a given large building, making it unique from other capture environments. Ex-1001, 1:21-29, 3:25-26, 3:58-64. As a result, when a user of the capture device enters the large building, the user is likely unaware of the species of flying vertebrate that is to be encountered and captured—necessitating a flexible and adaptable capture method. Moreover, the flight characteristics of the targeted flying vertebrate are different depending on their species. *Id.*, 3:65 to 4:3. Thus, in the interest of safely, quickly, and repeatedly capturing targeted flying vertebrates, the '073 patent's method requires first determining the species of flying vertebrate by (i) observing the flying vertebrate that is inside the large building and (ii) determining what kind

of flying vertebrate needs to be captured using an expert, a guide book, or the like. *Id.*, 1:56-57, 3:58-61, 4:47-52, 5:15, Fig. 4.

After the flying vertebrate has been observed and its species determined, bird netting is next selected (step “31”) and attached to the plurality of adjustable height poles (having the earlier-described hook, pulley, and rope arrangement) (step “32”). Ex-1001, 1:58-64, 4:52-54, 5:16 to 6:4, Fig. 4. Next, the netting is “position[ed] ... for capture based on the species of flying vertebrate and their flight characteristics utilizing the height adjustable poles to raise the netting” (step “33”). *Id.*, 1:65-67, 4:54-57, 6:5-7. In this regard, the '073 patent explains that positioning the netting for capture “refers to placing the bird net in an upper position wherein the flying vertebrate can fly into the netting.” *Id.*, 3:37-39.

Once again, it is critical that the netting is positioned based on the species of flying vertebrate and their flight characteristics. Ex-1001, 1:65-67, 4:54-57, 6:5-7. The specification teaches that—once the targeted vertebrate has been observed and its species determined—“one can determine how it flies” and thereby use the flight pattern associated with the species “to place the netting in relationship to the position of the flying vertebrate.” Ex-1001, 3:65 to 4:3. Thus, the '073 Patent's method requires (i) placing the bird netting in an upper position wherein the identified flying vertebrate can fly into the netting; and (ii) positioning the netting based on the

identified species of flying vertebrate and how that particular species of flying vertebrate flies. *Id.*, 3:65 to 4:3, 1:65-67, 4:54-57, 6:5-7.

“If the netting is placed correctly, then driving the vertebrate [step “34”] will cause it to fly into the netting and one of the pouches in the netting.” *Id.*, 4:4-9, 2:1-2, 6:8-9. With the targeted flying vertebrate retained by the netting pockets, the netting can be lowered using the height adjustable support poles (step “35”) and the flying vertebrate can be manually removed from the netting (step “36”). Ex-1001, 2:3-5, 4:10-13 and 57-59, 6:10-12. Optionally, once the targeted flying vertebrate has been retrieved, the large building may be adapted “to prevent further entry by the determined species of flying vertebrate.” *Id.*, 6:13-15, 4:60-64. This may be achieved by “taking the information about what species of flying vertebrate has entered the building and then adapting the building so that that species cannot easily return to the inside of the building” (e.g., by “eliminating nesting spots or using repellant at spots normally used for nesting, both outside and inside the building” and “adapting the entrances to prevent the species of bird from entering the building”). *Id.*, 4:14-24.

By combining the improved capture device with a focus on determining the species of flying vertebrate and positioning the netting based on the species of flying vertebrate and their flight characteristics, the inventors solved the problem of how

to remove a variety of flying vertebrate species from the inside of large, high-ceilinged buildings both safely and effectively.

III. THE PETITION FAILS TO MEET THE PARTICULARITY REQUIREMENT OF 35 U.S.C. § 312(a)(3) AND SHOULD BE DENIED UNDER § 314(a)

The Petition asserts that Claims 1-3 are obvious under Ground 1, which it characterizes as “Bird Barrier Video in view of Kunz and/or Albanese and/or Sheldon.” Pet. 5, 23. Although Safe Haven suggests this constitutes a single invalidity ground, the Petition’s proposed combination of the references under “Ground 1” would encompass seven unique combinations:

	Possible Combinations Encompassed by Petitioner’s Single “Ground 1”
1	Bird Barrier Video + Kunz
2	Bird Barrier Video + Albanese
3	Bird Barrier Video + Sheldon
4	Bird Barrier Video + Kunz + Albanese
5	Bird Barrier Video + Kunz + Sheldon
6	Bird Barrier Video + Albanese + Sheldon
7	Bird Barrier Video + Kunz + Albanese + Sheldon

While there is no rule prohibiting the assertion of seven different invalidity grounds, it is Petitioner’s responsibility—not the Board’s and not Meridian’s—to “identif[y] ... with particularity ... the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed.

Cir. 2016). This burden of persuasion never shifts to Meridian. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

Here, the Petition suggests that some permutation of Kunz, Albanese, and Sheldon would be combined with the Bird Barrier Video to render the challenged claims obvious. Pet. 5, 23. With respect to claim limitations [1.1], [1.2], [1.3.2], [1.3.3], [1.4], and [1.5],¹ the Petition points to all four cited references—Bird Barrier Video, Kunz, Albanese, and Sheldon. Pet. 24-34. In one instance, the Petition cites none of the four references at all. Pet. 23 (relying exclusively on USPN 117,729, which is not included in Ground 1). Moreover, the Petition offers no supporting testimony from a witness (expert or otherwise) who has reviewed the '073 patent and offered opinions supporting and clarifying Safe Haven's invalidity ground(s). With respect to each of the seven possible combinations of references, it is unclear what exactly in Kunz, Albanese, and/or Sheldon is being combined with the Bird Barrier Video (or not), how the disclosures are being combined (with the Bird Barrier Video or the other references), and what the specific motivations for each of the combinations would be.

¹ Meridian refers herein to the limitation numbers assigned to the challenged claims in the Petition. *See* Pet. 23-35

As an example, commenting on limitations [1.1] and [1.4], the Petition argues that “it would have been obvious for a POSA to modify the system of Bird Barrier Video with the teachings of Kunz, Albanese or Sheldon to include determining the species of flying vertebrate and positioning the netting for capture based on its flight characteristics.” Pet. 27. But in its arguments with respect to limitations [1.1] and [1.4], the Petition fails to explain which specific portions of Kunz, Albanese, and Sheldon disclose the separate steps of “a) determining the species of flying vertebrate” (limitation [1.1]) and “d) positioning the netting for capture based on the species of flying vertebrate and their flight characteristics utilizing the height adjustable poles to raise the netting” (limitation [1.4]). Pet. 25-27. For instance, the Petition asserts that “Albanese teaches that different species of flying vertebrates tend to fly at different heights above the ground,” but it fails to explain how this teaching equates to performing the steps recited in limitations [1.1] and [1.4] or how exactly a POSA would have adapted the teachings in the Bird Barrier Video in view of Albanese. Pet. 26.

The same defect applies to the Petition's arguments with respect to Kunz and Sheldon. Pet. 25-27. While the Petition includes cites to various portions of the references, it is unclear which portions of the references are being equated to which limitations, why this is the case, and why a POSA would combine the references with the Bird Barrier Video (or one another).

The Petition also offers an omnibus “Motivation for Combining” section that it seems to suggest applies to all seven combinations of the references and for every challenged claim. Pet. 37-38. The Petition argues that “[t]he only arguable novelty [of the claimed invention] involves raising the net to a height based on flight characteristics of the targeted species”² and that—if the Board determines that the Bird Barrier Video does not disclose this feature—“then (as discussed above) *Kunz, Albanese, and Sheldon* expressly teach it.” Pet. 38 (emphasis added). In the next sentence, the Petition provides a conclusory and unsupported assertion that a POSA would have combined the references in some way:

[B]ecause those references and Bird Barrier Video all pertain to mist nets hung between two poles that can be raised and lowered, and they all focus on the common goal of capturing birds, *a POSA would have been motivated to combine them to arrive at the claimed invention.*

Id. (emphasis added).

However, as explained herein (*infra* § V(A)(2)(b)), neither a “common goal of capturing birds” nor the use of a mist net between poles is a specific reason that a POSA *would have* modified the Bird Barrier Video, much less one that would specifically lead to modifications of the Bird Barrier Video satisfying each of the

² For the reasons provided herein, Meridian disagrees with this characterization.

See infra § V.

limitations where the Petition relies on all four cited references ([1.1], [1.2], [1.3.2], [1.3.3], [1.4], and [1.5]). Elsewhere, the Petition argues that a POSA would be motivated to modify the Bird Barrier Video in view of Kunz, Albanese, and Sheldon in relation to limitations [1.1] and [1.4] “to increase the chances of capturing a targeted bird within a large building.” But the Petition provides no cite for this alleged motivation, no expert declaration or other supporting evidence, and no reasoned explanation of why a POSA would have believed this to be true.

For all of these reasons, the Petition's analysis of Ground 1 lacks sufficient particularity. Where a petition “asserts that several of the claimed limitations are taught by multiple references,” and it is unclear “what, exactly, is being combined to meet the claimed limitations,” the Board has found a failure to meet the particularity requirement of 35 U.S.C. § 312(a)(3). *Salpeter v. ARP Wave LLC*, IPR2019-01384, Paper 12 at 24-25 (PTAB Jan. 27, 2020) (citing 35 U.S.C. § 312(a)(3) and 37 C.F.R. § 42.104(b)(4)). For each limitation in the challenged claims, the Petition's arguments leave it unclear how and why Kunz, Albanese, and/or Sheldon are being combined with the Bird Barrier Video (individually or in various combinations with one another).

Notably, the Petition certifies that it contains 6,913 words—7,087 words less than the 14,000 words permitted by the Board's rules. Pet. 43 (certificate of compliance); 37 C.F.R. § 42.24(a)(1)(i). Had Safe Haven desired to provide greater

clarity with respect to its challenges to the '073 patent, it could have. It is not Meridian's or the Board's responsibility to reverse engineer why, exactly, Safe Haven believes the challenged claims to be unpatentable under the various combinations of references it proposes (purportedly as a single invalidity ground). This burden belongs exclusively to Safe Haven and the Petition's failure to meet it warrants the Board exercising its discretion to deny the Petition under 35 U.S.C. § 314(a). *See Adaptics LTD. v. Perfect Co.*, IPR2018-01596, Paper 20 at 13-21 (PTAB March 6, 2019) (Informative) (denying institution where Petition lacked "particularity" because it presented a "multiplicity of grounds" from using "and/or" conjunction between references in Grounds); *Salpeter*, IPR2019-01384, Paper 12 at 24-25 (finding no likelihood of prevailing in part based on lack of particularity).

IV. CLAIM CONSTRUCTION

A. Safe Haven fails to sufficiently identify how the challenged claims are to be construed as required by 37 C.F.R. § 42.104(b)(3).

In an IPR, a petitioner "must identify" in the petition "[h]ow the challenged claim is to be construed." 37 C.F.R. § 42.104(b)(3). Safe Haven's petition fails to satisfy this bedrock requirement, leaving its challenge to the '073 patent's claims insufficient to warrant institution. 35 U.S.C. § 314(a).

The Petition's analysis of the challenged claims begins with Safe Haven's affirmation that it "does not propose any constructions for this proceeding." Pet. 22. The Petition offers nothing more. In fact, the Petition fails to identify the standard

under which the challenged claims are interpreted, fails to account for the '073 patent's prosecution history in interpreting the challenged claims, and—most glaringly—*ignores explicit definitions for claim terms provided in the '073 patent's specification*. Under these circumstances, the Petition cannot be regarded as satisfying the requirements of 37 C.F.R. § 42.104(b)(3). *See e.g., Volkswagen Group of America, Inc. v. Michigan Motor Technologies, LLC*, IPR2020-00229, Paper 13 at 9-10 (PTAB July 6, 2020) (“Petitioner’s failure to recognize and address the express construction, coupled with Petitioner’s failure to otherwise sufficiently address the meaning of the term, is insufficient to satisfy the requirements of 37 C.F.R. § 42.104(b)(3)”).

In this proceeding, the '073 patent claims are construed under the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b). Thus, the claims terms are generally given their ordinary and customary meaning as would be understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *See id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc). The context provided by the patent disclosure is critical as the claim terms “*must* be read in view of the specification,” which is highly relevant, usually dispositive, and “the single best guide to the meaning of a disputed term.” *Phillips*, 415 F.3d at 1315 (citations omitted) (emphasis added). In particular, “[w]hen a patentee explicitly

defines a claim term in the patent specification, the patentee's definition controls.”
Martek Biosciences Corp. v. Nutrinova, Inc., 579 F.3d 1363, 1380 (Fed. Cir. 2009).

The Petition eschews these well-settled claim construction principles entirely. Safe Haven chooses not to propose any claim constructions at all, while at the same time purporting to “expressly reserve[] its claim scope arguments” for some (unstated) later time. Pet. 22. Although the PTAB may permit a Petitioner to respond to “new claim construction issues raised by the patent owner,” this is not an invitation for a Petitioner to simply ignore its burden to identify how the challenged claims are to be construed and unilaterally defer its claim construction arguments and evidence to a time of its choosing. *See Consolidated Trial Practice Guide* at 44-45 (November 2019).

The '073 patent's specification includes a section entitled “Definitions,” which even a cursory review of the specification would have revealed. Ex-1001, 2:45-4:24. In the Definitions section of the specification, many of the terms appearing in the challenged claims were explicitly defined. Ex-1001, 2:45 to 4:24; *see infra* § IV. For example, Claim 1 recites the steps of “a) determining the species of flying vertebrate” (limitation 1.1) and “d) positioning the netting for capture based on the species of flying vertebrate and their flight characteristics utilizing the height adjustable poles to raise the netting” (limitation 1.4). Ex-1001, 5:16, 6:5-7. Among other terms, the specification provides express definitions for “determining the

species” (as recited in limitation 1.1) and “positioning the netting for capture” (as recited in limitation 1.4). Ex-1001, 3:37-39 and 58-64. The Petition makes no mention of these definitions and utterly fails to account for them in its analysis of the challenged claims—both of which Safe Haven was obligated to do under *Phillips* and the Board’s rules. 37 C.F.R. § 42.104(b)(3); *Phillips*, 415 F.3d at 1315.

The Petition’s failure to account for these definitions is not inconsequential. As explained herein, under the correct claim construction of limitations 1.1 and 1.4, the Petition fails to establish a reasonable likelihood that the challenged claims are unpatentable. *Infra* § V. Furthermore, the Petition itself identifies these limitations as important to patentability. The Petition allocates more words to its analysis of limitations 1.1 and 1.4 than any other feature of Claim 1. *See* Pet. 23-35 (pages 24-28 addressing limitations 1.1 and 1.4). The Petition also appears to regard these limitations as the “only arguable novelty” of Claim 1. Pet. 38. Yet the Petition provides no explanation for disregarding and failing to address the express definitions of these important claim terms.

Where express definitions of important claim terms are provided in the patent specification, Petitioner’s generic assertion that it “does not propose any constructions for this proceeding” is insufficient. *See* Pet. 22. Here, the Petition’s failure to recognize and address the express constructions provided in the specification—coupled with Safe Haven’s failure to sufficiently address the

meaning of these terms in its unpatentability analysis or construe the claims at all—is insufficient to satisfy the requirements of 37 C.F.R. § 42.104(b)(3). Safe Haven's failure to satisfy the Board's rules further warrants denial of institution under 35 U.S.C. § 314(a).

B. The preamble of Claim 1 is limiting.

The preamble of Claim 1 recites “[a] method for the safe live capture of a flying vertebrate that is inside a large building.” Ex-1001, 5:13-14. As the preamble provides antecedent basis for the term “flying vertebrate” in the body of the claim—and because the claims, patent specification, and prosecution history reinforce that the claims are directed to capturing a flying vertebrate inside a large building—the preamble is limiting.

Whether a preamble is limiting is “determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.” *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1572–73 (Fed. Cir. 1996). “Generally, a preamble limits the invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” *Catalina Marketing Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). Additionally, “dependence on a particular disputed preamble phrase for

antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention Likewise, when the preamble is essential to understand limitations or terms in the claim body, the preamble limits claim scope.” *Catalina*, 289 F.3d at 808 (internal citations omitted).

The body of Claim 1 recites the step of “a) determining the species of flying vertebrate,” where Claim 1’s preamble provides the antecedent basis for the term “flying vertebrate.” For example, the preamble introduces this term, reciting “a flying vertebrate that is inside a large building.” The body of Claim 1 always recites “flying vertebrate” or “the flying vertebrate” (never *a* flying vertebrate), and therefore refers back to the preamble for antecedent basis. In this way, Claim 1 relies “on both the preamble and claim body to define the claimed invention.” *See Catalina*, 289 F.3d at 808 (internal citations omitted). The preamble thus limits Claim 1 by requiring that the “flying vertebrate” referenced in the claim body is one “that is inside a large building.”

Elsewhere in Claim 1, the preamble’s limitation that the flying vertebrate “is inside a large building” is reinforced. For example, Claim 1 recites the step of “attaching a plurality of adjustable height support poles to the netting” (limitation 1.3) where the adjustable height support poles must include “a hook for attaching the poles overhead” (limitation 1.3.1). There would be no need for the poles to have such a hook for attachment “overhead” if they were not used in an indoor

environment. *See also* Ex-1001, 3:33-36, 4:33-40, Fig. 1 (describing poles as attachable to “rafters, beams, or the like on the ceiling”).

The '073 patent's specification also underscores the importance of the “flying vertebrate” being “inside a large building” as recited in the preamble. The specification characterizes the problem addressed by the claimed method as originating from “[t]he advent of large warehouses, big box stores, large grocery stores, malls, and the like, [which] has caused an increase in the number of birds ... finding their way inside the building.” Ex-1001, 1:21-24. Accordingly, the inventors identified “a need for a better method of removing flying vertebrates from a large building” (Ex-1001, 1:39-41) and thus devised an improved method for this environment. *See* Ex-1001, 1:53 to 2:5 (describing “a method for the safe live capture of a flying vertebrate inside a large building”), 3:40-44 (defining “large building” as the “interiors of buildings, such as large box stores, warehouses, storage facilities, retail buildings and the like”), 4:28-33 (describing Fig. 1 as depicting a flying vertebrate flying around the ceiling “of a large warehouse building”). The specification goes on to define the field of invention as relating to “the live capture of flying vertebrates *in an indoor setting*” and “a net deploying system designed *for inside large enclosure buildings*.” Ex-1001, 1:15-19 (emphases added).

Finally, the '073 patent's prosecution history confirms that that the preamble provides the antecedent basis for the claim term “flying vertebrate” and thus limits

Claim 1. During prosecution, the Examiner rejected the original version of Claim 1 under § 112 as having “insufficient antecedent basis.” Ex-1002, 4 (Office Action dated Oct. 24, 2017). Meridian overcame this rejection by amending the preamble to recite “a flying vertebrate that is inside a large building” (amendment underlined) and relied on the preamble to provide antecedent basis for the term “flying vertebrate” in the body of the claim. Ex-1002, 9-11 (Response dated Dec. 22, 2017).

For at least the foregoing reasons, the '073 patent's intrinsic record requires a construction in which the preamble of Claim 1 is limiting. Ultimately, “[w]hether to treat a preamble as a limitation is a determination ‘resolved only on review of the entire[] ... patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.’” *Catalina*, 289 F.3d at 808 (quoting *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989)) (alterations in original). Here, all facets of the intrinsic record indicate that what the inventors intended to encompass by Claim 1 was a method for “[a] method for the safe live capture of a flying vertebrate *that is inside a large building*.”³

³ Although the Petition is silent with respect to interpreting the claims, it appears Safe Haven would agree. The Petition characterizes the '073 patent as “claim[ing] a method for the safe live capture of flying vertebrates *inside a large building*.” Pet. 5 (emphasis added); *see also* Pet. 1 (describing '073 patent as being directed to

C. Construction of “determining the species of flying vertebrate” (limitation 1.1).

Claim 1's capture method first recites the step of “a) determining the species of flying vertebrate.” While no construction of this phrase appears in the Petition, one is clearly provided in the '073 patent's specification:

As used herein, the term “determining the species” refers to observing the flying vertebrate and having an expert, a guide book, or the like, for determining what kind of flying vertebrate needs to be captured.

Ex-1001, 3:58-61 (emphasis added). As is the case here, “[w]hen a patentee explicitly defines a claim term in the patent specification, the patentee's definition controls.” *Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363, 1380 (Fed. Cir. 2009); *see also Phillips*, 415 F.3d at 1316. Thus, as defined in the '073 patent, the phrase “determining the species” means (i) observing a flying vertebrate and (ii) determining what kind of flying vertebrate needs to be captured using an expert, a guide book, or the like. Ex-1001, 3:58-61.

Nothing in the '073 patent's intrinsic record suggests otherwise. For example, the specification explains that determining the species of flying vertebrate may involve “inspecting the vertebrate in the location, inspecting evidence in the

a “method for the safe live capture of a flying vertebrate *within a building*”) (emphasis added).

surrounding area of the types of vertebrates in the area, as well as the location of the vertebrate in the building.” Ex-1001, 4:48-52. The specification also notes that observing the surrounding area may “aid in prevention of further entry by a flying vertebrate.” Ex-1001, 3:61-64. But at the very least, the specification makes clear that the phrase “determining the species” requires (i) observing a flying vertebrate and (ii) determining what kind of flying vertebrate needs to be captured using an expert, a guide book, or the like. Ex-1001, 3:58-61.

The language of limitation 1.1 must also be read in the context of the preamble, which is limiting for the reasons explained earlier. *Supra* § IV(B). As confirmed by the preamble, the “flying vertebrate” in limitation 1.1 is one that “that is inside a large building.” Ex-1001, 5:13-14.⁴ Accordingly, read in context, “determining the species of flying vertebrate” as recited in Claim 1 requires (i) observing a flying vertebrate that is inside a large building and (ii) determining what kind of flying vertebrate needs to be captured using an expert, a guide book, or the like. Ex-1001, 3:58-61.

⁴ The '073 patent also defines “flying vertebrates” as “birds, bats or any large flying mammal or the like,” and defines “large building” to mean “interiors of buildings such as large box stores, warehouses, storage facilities, retail buildings and the like.” Ex-1001, 5:25-26 and 40-42.

D. Construction of “positioning the netting for capture based on the species of flying vertebrate and their flight characteristics” (limitation 1.4).

Claim 1 recites the additional step of “d) positioning the netting for capture based on the species of flying vertebrate and their flight characteristics utilizing the height adjustable poles to raise the netting.” Once again, although no construction of this phrase appears in the Petition, the '073 patent's specification provides a pair of important definitions:

As used herein, the term “*positioning the netting for capture*” refers to placing the bird net in an upper position wherein the flying vertebrate can fly into the netting.

Ex-1001, 3:37-39 (emphasis added).

As used herein, the term “*flight characteristics*” refers to the flying vertebrate, *once it has been identified, one can determine how it flies.* e.g. a bat flies in a different pattern than a sparrow. That flight pattern can then be used to place the netting in relationship to the position of the flying vertebrate.

Ex-1001, 3:65 to 4:3 (emphasis added).

Once again, the patentee's definition must control. *See Martek*, 579 F.3d at 1380. Thus, as defined in the '073 patent, the phrase “positioning the netting for capture based on the species of flying vertebrate and their flight characteristics” means: (i) placing the bird netting in an upper position wherein the identified flying vertebrate can fly into the netting; **and** (ii) positioning the netting based on the

identified species of flying vertebrate and how that particular species of flying vertebrate flies. Ex-1001, 3:37-39, 3:65 to 4:3.

**V. THE PETITION FAILS TO DEMONSTRATE A REASONBLE
LIKELIHOOD THAT THE '073 PATENT'S CLAIMS ARE
UNPATENTABLE**

Safe Haven's failure to correctly construe the claims infects the entirety of its invalidity analysis. As explained herein, under the correct claim construction, the cited references fail to disclose every limitation of independent Claim 1. The Petition also fails to establish a sufficient motivation for combining the references in the various combinations it asserts under Ground 1. Moreover, in its attempt to fashion a motivation to combine, the Petition advances arguments that are diametrically opposed to those it made in prior IPR proceedings before the Board. For these reasons, the Board should deny institution.

A. Claim 1

In the amalgamation of references cited, the Petition argues that limitation 1.1 and 1.4 in Claim 1 are rendered obvious by the Bird Barrier Video, Kunz, Albanese, and Sheldon. The Petition first argues that the Bird Barrier Video discloses these limitations and that Meridian has admitted as much, but the Bird Barrier Video plainly fails to disclose limitations 1.1 and 1.4 (and Meridian certainly has never conceded otherwise). The Petition next points to a combination of Kunz, Albanese, and Sheldon—each of which are directed to outdoor capture techniques that Safe

Haven has previously argued would never be combined with indoor capture techniques, leaving no motivation to combine the references with the Bird Barrier Video. But even if these references were combined, the Petition fails to demonstrate that they disclose limitations 1.1 and 1.4, provides no expert testimony supporting its arguments, and instead points to inadmissible testimony from Meridian's expert in a prior proceeding relating to a different patent. For all of these reasons, the Petition fails to show a reasonable likelihood that Claim 1 is unpatentable.

1. Bird Barrier Video fails to disclose or suggest “determining the species of flying vertebrate” (limitation 1.1) and “positioning the netting for capture based on the species of flying vertebrate and their flight characteristics” (limitation 1.4).

As discussed above, limitation 1.1—“determining the species of flying vertebrate”—requires at least **(i)** observing a flying vertebrate that is inside a large building and **(ii)** determining what kind of flying vertebrate needs to be captured using an expert, a guide book, or the like. *Supra* § IV(C). Furthermore, limitation 1.4—“positioning the netting for capture based on the species of flying vertebrate and their flight characteristics”—requires **(i)** placing the bird netting in an upper position wherein the identified flying vertebrate can fly into the netting; and **(ii)** positioning the netting based on the identified species of flying vertebrate and how that particular species of flying vertebrate flies. *Supra* § IV(D). Properly construed, the Bird Barrier Video fails to disclose these steps.

The Bird Barrier Video discloses positioning its net assembly by “walk[ing] the completed net assembly to a target location near where the bird activity has been observed”—nothing more. Ex-1004, 1 (1:15 to 1:44). In other words, in the Bird Barrier Video, the net assembly is positioned based only on the location of observed bird activity. *See* Ex-1012, 57 (noting that a POSA would anticipate observed birds flying in the same location where activity was observed). Thus, in contrast to the method of Claim 1, the positioning of netting in the Bird Barrier's Video's method is entirely agnostic as to the *species of flying vertebrate*.

At no point does the Bird Barrier Video disclose or suggest that a species of flying vertebrate should be determined before placing its netting or otherwise factored into the placement of the netting. Indeed, the word “species” is not uttered during the Bird Barrier Video, nor is any species of flying vertebrate discussed or described. Rather, the Bird Barrier Video teaches that a location of observed bird activity—irrespective of species—is all that is needed. Ex-1004, 1 (1:15 to 1:44).

The Petition fails to identify any portion of the Bird Barrier Video that it alleges to disclose “determining the species of flying vertebrate.” *See* Pet. 24-25 (lacking cites to any portion of the Bird Barrier Video where a species is determined). Instead, the Petition points to prior arguments made by Meridian and Dr. Chamberlain in a different proceeding, relating to a dependent claim in a different patent owned by Safe Haven. Pet. 12 (citing Ex-1012, 70 and Ex-1013, ¶

204) (Petition citing to Meridian's IPR petition in IPR2022-1253). In particular, Safe Haven alleges that "Meridian and Dr. Chamberlain represented that 'Bird Barrier Video discloses positioning nets 'at a height above the floor of the enclosed building based on the species of animal being relocated.'"" *Id.*

Safe Haven's reliance on Meridian's and Dr. Chamberlain's prior comments in IPR2022-01253 is fully misplaced. In that earlier proceeding, Meridian challenged claims in Safe Haven's U.S. Patent No. 10,251,374, including *inter alia* independent Claim 1 and dependent Claim 4. *See e.g.*, Ex-1012, 65-70. Claim 1 of the '374 patent was directed to "a method for relocating *animals* within an enclosed building." Ex-1012, 74-76 (emphasis added). As Meridian explained in its Petition, Claim 1 was not limited to the capture of birds or other flying vertebrates—it "extend[ed] to the capture of 'animals' generally." Ex-1012, 1 (n.1) and 74-76. Dependent Claim 4 then limited the claimed method to placing nets at a height above a building floor "based on the *species of animal* being relocated." Ex-1012, 70 and 76 (emphasis added).

In relation to Dependent Claim 4, Meridian pointed to screen captures of the Bird Barrier Video depicting a net being raised to a height above the building floor for the purpose of capturing birds—i.e., a particular "species of *animal*." Ex-1012, 70 (citing Ex-1014, Figs. 10-13). Meridian's point was simply that raising the net above the floor was an example of positioning the net to capture a species of animal

that flies (e.g., a bird) as opposed to one that does not (e.g., a rodent). But distinguishing a flying animal from a ground-based animal is not that same as “determining a species *of flying vertebrate*” and “positioning the netting for capture based on the species *of flying vertebrate* and their flight characteristics” as recited in Claim 1 of the '073 patent. Meridian never alleged that the Bird Barrier Video discloses either of these steps. Moreover, for the reasons explained in Section V(A)(4) herein, Dr. Chamberlain's testimony from IPR2022-01253 is inadmissible and, at the very least, entitled to no weight.

Safe Haven's reliance on Meridian's arguments from a different IPR also underscores its disregard for the proper construction of the '073 patent's claims. As discussed above, the '073 patent provides specific definitions for limitations [1.1] and [1.4], which do not apply to the unrelated patent addressed in IPR2022-01253. With respect to “determining the species of flying vertebrate” [1.1], the Bird Barrier Video makes no mention of **(i)** observing a flying vertebrate that is inside a large building **and** **(ii)** *determining what kind of flying vertebrate needs to be captured using an expert, a guide book, or the like. Supra § IV(C).* And with respect to “positioning the netting for capture based on the species of flying vertebrate and their flight characteristics” [1.4], the Bird Barrier Video fails to disclose **(i)** placing the bird netting in an upper position wherein the identified flying vertebrate can fly into the netting; **and** **(ii)** positioning the netting *based on the identified species of*

flying vertebrate and how that particular species of flying vertebrate flies. Supra § IV(D).

In contrast to the '073 patent, the Bird Barrier Video's method does not involve determining a species of flying vertebrate and does not account for an identified species of flying vertebrate when positioning its netting. Nor does the Petition offer any argument or evidence that limitations 1.1 and 1.4 would have been obvious to a POSA. Thus, under the correct claim construction, the Bird Barrier Video fails to disclose or suggest "determining the species of flying vertebrate" (limitation 1.1) and "positioning the netting for capture based on the species of flying vertebrate and their flight characteristics" (limitation 1.4) as recited in Claim 1.

2. The Petition fails to establish a sufficient motivation for combining Kunz, Albanese, and/or Sheldon with the Bird Barrier Video.

The Petition acknowledges that the Bird Barrier Video fails to disclose or suggest every limitation of Claim 1. *See* Pet. 5 (setting forth no anticipation or single-reference obviousness grounds based on Bird Barrier Video). To cure the deficiencies in the Bird Barrier Video, the Petition points to an ambiguous

combination of Kunz, Albanese, and/or Sheldon. *Id.*, 5 and 23.⁵ Although the Petition lacks sufficient particularity with respect to exactly how these references are combined (*supra* § III), the Petition plainly fails to establish that a POSA would have been motivated to combine Kunz, and/or Albanese, and/or Sheldon with the Bird Barrier Video to arrive at Claim 1.

- (a) **Safe Haven previously argued to the Board that references directed to outdoor capture techniques (including Kunz) would not be combined with references directed to indoor capture techniques (including the Bird Barrier Video and the publication of the '073 patent's underlying application).**

The Petition begins its motivation to combine analysis by discussing an entirely different proceeding (IPR2022-01253) where Meridian challenged Safe Haven's U.S. Patent No. 10,251,374. Pet. 37. As the Petition acknowledges, in this earlier proceeding Safe Haven argued that a POSA *would not* be motivated to combine the Bird Barrier Video with Kunz—the opposite of what it argues now. *Id.* The Petition casts aside this about-face, suggesting that Safe Haven's prior arguments against combining the Bird Barrier Video and Kunz were limited and focused only on a particular system of nets claimed by the '374 patent. Pet. 37-38.

⁵ Patent Owner disputes that any of these references supplies the missing limitations, see *infra* § V(A)(3). But even assuming they do disclose these elements, the Petition fails for the reasons explained here.

But Safe Haven sells its prior arguments short. In a pair of companion IPR proceedings that the Petition fails to address in its motivation to combine analysis (IPR2022-0154 and IPR2022-01340), Safe Haven's arguments were far more robust than the current Petition lets on. The central theme of Safe Haven's arguments in these earlier IPRs was this: a POSA would never be motivated to combine a reference directed to *indoor* trapping techniques (Bird Barrier Video) with references directed to *outdoor* trapping techniques (e.g., Kunz). This argument—which Safe Haven repeated ad nauseum to the Board—is the *opposite* of what it now argues in the current Petition.

In IPR2022-01254 and IPR2022-01340, *Safe Haven argued repeatedly and unequivocally that a POSA would never combine the teachings of Kunz with the teachings of the Bird Barrier Video because Kunz is directed to outdoor capture techniques and the Bird Barrier Video is directed to indoor capture techniques.*

Below are four examples of these arguments:

- “As noted above, capturing bats in outdoor settings presents a very different set of challenges than trapping vertebrate in indoor structures due to the presence of walls and ceilings. ***For this reason alone, a POSA would not be motivated to combine the teachings of Bird Barrier Video with Kunz.***” Ex-2002, 56 (Safe Haven's Preliminary Response, IPR2022-01254) (citations omitted) (emphasis added).

- “As explained throughout the Preliminary Response, ***Kunz is irrelevant to the claimed invention as it is directed to outdoor netting systems.*** Likewise, Mattox is directed to outdoor netting systems. The fact that Mattox is directed to capturing ‘large, wild foraging animals’ is beside the point – ***no POSITA seeking to design a method and system for capturing birds inside big box stores would look to Kunz or Mattox, and the Examiner apparently agreed. Legally and factually, neither reference is relevant or material to the patentability of the claimed invention.***” Ex-2004, 1-2 (Safe Haven’s Sur-Reply, IPR2022-01340) (citations omitted) (emphasis added).
- “As noted above with respect to Brugh in view of Kunz, capturing bats in outdoor settings presents a very different set of challenges than trapping vertebrate in indoor structures due to the presence of walls and ceilings. Thus, ***a POSA similarly would not be motivated to combine the teachings of Bird Barrier Video with Kunz. Any alleged advantage of Kunz’s outdoor capture system would not apply to Bird Barrier Video’s indoor capture system.***” Ex-2003, 44 (Safe Haven’s Preliminary Response, IPR2022-01340) (citations omitted) (emphasis added).
- “[A]lthough Kunz is not cited on the face of the ‘683 Patent, ***that is no surprise considering it covers the use of outdoor trapping nets . . .***” Ex-2003, 22 (Safe Haven’s Preliminary Response, IPR2022-01340) (emphasis added).

Safe Haven used the same distinction to also argue that a POSA would never combine the teachings of Kunz with the teachings of Brugh (U.S. Patent Publication No. 2017/0238524), which is the initial publication of the application leading to the '073 patent. *Stated plainly, Safe Haven argued to the Board that a POSA would not be motivated to consider Kunz in combination Brugh—the publication of the very patent it now argues is invalid in view of Kunz:*

- First and foremost, due to the presence of walls and ceilings, *trapping vertebrates in enclosed spaces is nothing like capturing bats in outdoor settings* and presents a very different set of challenges. *A POSA would not be motivated to look to a patent direct to outdoor bat-capturing systems like Kunz to modify an indoor trapping system like that taught in Brugh.* Ex-2002, 45 (Safe Haven's Preliminary Response, IPR2022-01254) (citations omitted) (emphasis added).
- First and foremost, a POSA would have no motivation to modify the capture system of Brugh with the teachings of Kunz *in general because any alleged advantage of Kunz's outdoor capture system would not apply to Brugh's indoor capture system.* Due to the presence of walls and ceilings, *trapping vertebrates in enclosed spaces is very different from capturing bats in outdoor settings and presents a very different set of challenges.* Ex-2003, 38-39 (Safe Haven's Preliminary Response, IPR2022-01340) (citations omitted) (emphasis added).

The Board found Safe Haven's arguments convincing and—in each of IPR2022-01253, IPR2022-01254, and IPR2023-01340—denied institution. But Safe Haven now asks the Board to do the *opposite* in this proceeding and combine a reference directed to *indoor* capture techniques (Bird Barrier Video) with various references exclusively directed to *outdoor* capture techniques (Kunz, Albanese, Sheldon). The Petition offers no compelling reason for the Board to do so and points to no evidence (including no expert testimony addressing the proposed combination(s)) to support its position.

Like Kunz, Albanese and Sheldon are directed to outdoor capture techniques. *See* Ex-1009, 8-16 (Kunz describing outdoor placement of nets). Albanese describes the “use of a mist net apparatus capable of sampling vegetation strata from ground level to an 8.5m height” and tested its net “on the north side of Pewaukee Lake in Waukesha Co., Wisconsin.” Ex-1010, 129. Sheldon describes techniques for “capturing American woodcocks (*Philohela minor*) with Japanese mist nets during the summer months in central Massachusetts” and describes the placement of these nets in multi-acre outdoor fields. Ex-1011, 130, 1314. None of Kunz, Albanese, or Sheldon disclose or suggest indoor capture techniques.

By Safe Haven's own admission, references directed to outdoor capture techniques are “irrelevant” to capturing flying vertebrates inside large buildings. *See* Ex-2004, 1-2. Thus, a POSA would not have been motivated to combine Kunz,

Albanese, and/or Sheldon with the Bird Barrier Video. For at least this reason, the Petition fails to establish a sufficient motivation for combining the references under Ground 1.

(b) The Petition's new rationales for combining Kunz, Albanese, and/or Sheldon with the Bird Barrier Video are unavailing.

Following its analysis of Claims 1-3, the Petition sets forth a "Motivation for Combining" section that focuses primarily on attempting to explain away Safe Haven's own previous arguments in IPR2022-01253 (again, ignoring the even more contradictory arguments advanced in IPR2022-01254 and IPR2022-01340). In fact, the Petition's "Motivation for Combining" section includes just a single sentence directed to why a POSA would have allegedly combined the references under Ground 1. The Petition explains that because the Bird Barrier Video, Kunz, Albanese, and Sheldon "all pertain to mist nets hung between two poles than can be raised and lowered, and they all focus on the common goal of capturing birds, a POSA would have been motivated to combine them to arrive at the claimed invention." Pet. 38.

As an initial matter, the Petition's argument is diametrically opposed to its arguments in IPR2022-01254 and IPR2022-01340, where it characterized references directed to outdoor capture techniques as "irrelevant" to references directed to

indoor capture techniques. Ex-2004, 1-2; *supra* § V(A)(2)(a). Nevertheless, the Petition's argument is deficient for additional reasons.

The Petition's suggestion that the references pertain to adjustable mist nets between poles and relate to capturing birds is, at most, an argument that the references might be regarded as analogous art (notwithstanding the contradictory positions Safe Haven has taken previously). But "[d]emonstrating that a reference is analogous art or relevant to the field of endeavor of the challenged patent is not sufficient to establish that one of ordinary skill would have had reason to combine its teachings with other prior art in the manner set forth in the claim." *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9 at 10 (PTAB Oct. 16, 2018) (informative) (citing *Securus Techs., Inc. v. Global Tel*Link Corp.*, 701 F. App'x 971, 977 (Fed. Cir. 2017) ("a broad characterization of [prior art references] as both falling within the same alleged field . . . without more, is not enough for [Petitioner] to meet its burden of presenting a sufficient rationale to support an obviousness conclusion")). Moreover, "[m]ere compatibility of the references is likewise not sufficient." *Id.* at 11 (citing *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993 (Fed. Cir. 2017) (it is not enough to show that "a skilled artisan, once presented with the two references, would have understood that they could be combined"))).

Here, the Petition fails to explain why a POSA *would have* combined the four references in Ground 1 in the manner set forth in the claim. *KSR Int'l Co. v. Teleflex*

Inc., 550 U.S. 398, 418 (2007) (obviousness requires “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does”). Indeed, the Petition proposes modifying numerous aspects of the Bird Barrier Video in view of different disclosures in Kunz, Albanese, and Sheldon. Pet. 23-35. But the Petition fails to sufficiently explain what would have motivated a POSA to make each of these modifications in view of the various combination of references (and cites to no testimony from a POSA suggesting that it would do so).

Elsewhere, the Petition proposes other motivations for some of the combinations contemplated by Ground 1 (but not others). For example, with respect to limitations [1.1] and [1.4], the Petition argues that “it would have been obvious for a POSA to modify the system of Bird Barrier Video with the teachings of Kunz, Albanese or Sheldon to include determining the species of flying vertebrate and positioning the netting for capture based on its flight characteristics.” Pet. 27. The Petition explains “[a]s further detailed below, a POSA would be motivated to combine those references with the teachings of Bird Barrier Video to increase the chances of capturing a targeted bird within a large building.” *Id.* But there is no “further detail” provided, nor is there any evidence. If anything, Safe Haven’s argument appears to be rooted purely in hindsight. *See* Ex-1001, 1:48-52 (’073 patent explaining that its method offers “a much higher chance of recoverin the

flying vertebrate without harm”); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983) (impermissible hindsight occurs when a person of ordinary skill in the art is imbued with knowledge taught only by the inventor of the challenged patent).

The Petition cannot satisfy its burden of proving obviousness by employing conclusory statements. There must “instead [be] specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016); *KSR Int’l*, 550 U.S. at 418. As noted earlier, the Petition provides no support for why a POSA would have believed combining the references would “increase the chances of capturing a targeted bird *within a large building*.” Pet. 27 (emphasis added). Safe Haven offers no expert testimony of its own relating to this proposed motivation and no other supporting evidence is cited. Moreover, no reasoned explanation of why a POSA would have perceived this alleged improvement is provided. And, notably, the Petition fails to explain how the *outdoor* capture techniques described in Kunz, Albanese, and Sheldon (apparently no longer irrelevant) would improve the *indoor* capture techniques of the Bird Barrier Video.

Ultimately, the Petition fails to provide a reason, supported by rational underpinnings, to combine the teachings of Bird Barrier Video, Kunz, Albanese,

and/or Sheldon and, accordingly, fails to demonstrate obviousness. *KSR Int'l Co.*, 550 U.S. at 418.

3. **Even if combined with the Bird Barrier Video, Kunz, Albanese, and Sheldon fail to disclose or suggest “determining the species of flying vertebrate” (limitation 1.1) and “positioning the netting for capture based on the species of flying vertebrate and their flight characteristics” (limitation 1.4).**

As discussed above, the Bird Barrier Video to disclose fails limitations [1.1] and [1.4]. However, even if combined, the disclosures of Kunz, Albanese, and Sheldon are similarly deficient.

Claim 1 is directed to a method for “the safe live capture of a flying vertebrate *that is inside a large building.*” Unlike outdoor environments, a user of Claim 1’s method entering a large building is likely to be unaware of the species of flying vertebrate he or she will encounter. Rather than ignoring the species of flying vertebrate and placing nets based only on the location where flying vertebrate activity is observed (as in the Bird Barrier Video), the method of Claim 1 requires “determining the species of flying vertebrate” (limitation 1.1) and “positioning the netting for capture based on the species of flying vertebrate and their flight characteristics” (limitation 1.4).

As discussed herein, limitation 1.1—“determining the species of flying vertebrate”—requires at least (i) observing a flying vertebrate that is inside a large building and (ii) determining what kind of flying vertebrate needs to be captured

using an expert, a guide book, or the like. *Supra* § IV(C). With respect to (i), Kunz, Albanese, and Sheldon each fail to disclose observing a flying vertebrate *that is inside a large building*. Rather, each reference is quite clearly directed to *outdoor* capture techniques.

With respect to (ii), none of the references disclose determining what kind of flying vertebrate needs to be captured using an expert, a guide book, or the like. The Petition identifies no disclosure in Kunz in which a flying vertebrate is observed and its species determined using an expert, guide book, or the like. Pet. 25-26 (citing only to Ex-1009, 8, 16, 18). Indeed, nothing in Kunz involves determining a species using an expert or guide book because its methods are based on the location of visually observed activity. Ex-1009, 8. Similarly, neither Albanese nor Sheldon ever discusses observing a flying vertebrate and *determining the species* of the identified vertebrate (and the Petition fails to identify any portion of these references that does). *See* Pet. 26-27.

Limitation 1.4—“positioning the netting for capture based on the species of flying vertebrate and their flight characteristics”—requires **(i)** placing the bird netting in an upper position wherein the identified flying vertebrate can fly into the netting; **and** **(ii)** positioning the netting based on the identified species of flying vertebrate and how that particular species of flying vertebrate flies. *Supra* § IV(D). The Petition fails to explain how Kunz discloses these requirements. For example,

while Kunz suggests that that “productive netting sites can often be identified from visual observations of flying bats,” this disclosure is no different from the Bird Barrier Video’s teaching that nets should be placed in a location where activity has been observed. Pet. 26 (citing Ex-1009, 8); Ex-1004, 1 (1:15 to 1:44). In other words, Kunz’s net placement is based only on the location of observed activity—it does not involve positioning the netting *based on the identified species of flying vertebrate and how that particular species of flying vertebrate flies*. Nor should it as Kunz is not concerned with capturing a variety of flying vertebrate species, quickly and effectively, within a large building.

Similarly, Albanese discloses placing nets to “cover the entire vegetation height” in order to capture a “sampling of birds” in that area. Ex-1010, 129, 133. In other words, Albanese discloses the placement of nets based only on the location of activity (above the vegetation strata). At no point does Albanese teach or suggest positioning the netting based on an identified species of flying vertebrate and how that particular species of flying vertebrate flies, as required by the claim.

Sheldon discloses placing its nets around large outdoor fields and based on the location of visually observed activity. Ex-1011, 134. However, unlike the environment of a large indoor building, Sheldon is not concerned with the unpredictability of which species might be encountered. Sheldon places nets around outdoor fields based on the location of observed activity and, due to the geography

("central Massachusetts") and season ("summer months"), expects to capture American woodcocks. *Id.*, 130, 134. But, like Albanese, Sheldon never positions netting based on an identified species of flying vertebrate and how that particular species of flying vertebrate flies.

Accordingly, even if combined with the Bird Barrier Video, Kunz, Albanese, and Sheldon fail to disclose or suggest "determining the species of flying vertebrate" (limitation 1.1) and "positioning the netting for capture based on the species of flying vertebrate and their flight characteristics" (limitation 1.4). For these additional reasons, the Petition fails to establish a reasonable likelihood that the challenged claims are unpatentable.

4. Safe Haven cannot rely on a hearsay declaration from another proceeding and, even if it were permissible, the declaration does not support Safe Haven's arguments.

The Petition provides no testimony from a witness (expert or otherwise) who has reviewed the '073 patent and offered opinions supporting Safe Haven's invalidity ground(s). Instead, Safe Haven cites liberally to a previous declaration submitted by Dr. Michael Chamberlain (Meridian's expert) in IPR2022-01253. Pet. 24-35; *see generally* Ex-1013. Safe Haven's reliance on Dr. Chamberlain's prior declaration is both impermissible and misguided.

In the event the Board institutes this IPR, Meridian intends to object to Ex-1013 (Dr. Chamberlain's declaration in IPR2022-01253) as being inadmissible and

intends to move to exclude it from this proceeding. First, Safe Haven cannot comply with 37 C.F.R. §§ 42.51–42.53 as it cannot produce Dr. Chamberlain for cross-examination in relation to his prior testimony in Ex-1013. Dr. Chamberlain has provided a declaration, accompanying this Preliminary Response, in which he confirms that he was “unaware of the Safe Haven Petitions until being informed of their existence by counsel for Meridian,” has “never provided testimony in support of the Safe Haven Petitions,” and was “never asked by Safe Haven (or its counsel) to do so.” Ex-2001, ¶ 3. Dr. Chamberlain testifies that he has “never been engaged by Safe Haven, compensated by Safe Haven, or otherwise provided consulting services for Safe Haven.” *Id.*

Dr. Chamberlain also testifies that he is “unwilling to participate in a deposition or otherwise sit for cross-examination in relation to any of my prior testimony that has been (or will be) submitted by Safe Haven in support of the Safe Haven Petitions.” Ex-2001, ¶ 4. Finally, Dr. Chamberlain confirms that his “contractual obligations to Meridian constrain [him] from participating in . . . cross-examination.” *Id.* Thus, Safe Haven will not be able to comply with 37 C.F.R. §§ 42.51–42.53 and produce Dr. Chamberlain for cross-examination in relation to his prior testimony in Ex-1013.

Under these circumstances, the Board may not consider Dr. Chamberlain's testimony in Ex-1013 as cited in the Petition. “[I]f a party proffers a witness's

testimony, that party must make that witness available for cross-examination by the other party.” *Vudu, LLC v. Ideahub, Inc.*, Case IPR2020-01688, Paper 47 (March 16, 2022) (citing 37 C.F.R. §§ 42.51–42.53); *see also* Consolidated Trial Practice Guide 23 (November 2019); 37 C.F.R. § 42.53(g) (burden of producing a witness for cross-examination falls on the party presenting the witness). Furthermore, the Board has consistently held that “responsibility for [a] declarant’s refusal to participate in [a] deposition ultimately must rest with . . . the party proffering the witness.” *HTC Corporation et. al, v. NFC Technology, LLC*, IPR2014-01198, Paper 41 at 5 (PTAB Nov. 6, 2015) (striking declaration of non-party witness who refused to partake in deposition noticed by petitioner).

The Board has also held that “where a third party has submitted a declaration and has either refused or otherwise has not been made available to be cross examined, we have historically given little weight to or stricken the third party’s declaration.” *Vudu*, IPR2020-01688, Paper 47 at 10-11; *L’Oreal USA, Inc. v. Liqwd, Inc.*, PGR2018-00025, Paper 107, 55–60 (PTAB July 30, 2019) (giving little weight to inventor (alleged third-party) declaration submitted during prosecution and related expert testimony on alleged unexpected results because Patent Owner did not make the inventor available for cross examination on the testing reported in the declaration); *HTC Corp.*, IPR2014-01198, Paper 41, 4–5 (striking declaration of non-party witness who refused to participate in deposition noticed by petitioner);

John's Lone Star Distribution, Inc. v. Thermolife Int'l, LLC, IPR2014-01201, Paper 31, 3 (PTAB May 13, 2015) ("By refusing to make [the declarant] available for cross-examination, Petitioner has failed to comply with an applicable rule in this proceeding, entirely to Patent Owner's detriment. Thus, an appropriate action is to expunge [the declaration]."). Accordingly, Dr. Chamberlain's testimony in Ex-1013 should be stricken or, at the very least, accorded no weight.

In the absence of cross-examination of Dr. Chamberlain, which will not occur, his testimony in Ex-1013 is also inadmissible hearsay.⁶ *See* Federal Rules of Evidence 801 and 802; 37 CFR § 42.62. Moreover, none of the hearsay exceptions will apply. For example, as an expert witness, Dr. Chamberlain is not an agent or employee of Meridian with respect to Federal Rules of Evidence 802(d)(2)(C)-(D). *See HTC Corp. v. Telefonaktiebolaget LM Ericsson*, 12 F.4th 476, 489-490 (5th Cir. 2021) ("Since an expert witness is not subject to the control of the party opponent with respect to consultation and testimony he or she is hired to give, the expert witness cannot be deemed an agent." (quoting *Kirk v. Raymark Indus., Inc.*, 61 F.3d 147, 164 (3d Cir. 1995))).

⁶ Meridian acknowledges that objections to evidence are ordinarily not served until after institution. In this case, addressing the objection is appropriate at this stage.

Even if the Board declined to strike or expunge Dr. Chamberlain's declaration, it would be entitled to no weight in this proceeding. Dr. Chamberlain's declaration assesses an entirely different patent—Safe Haven's U.S. Patent 10,251,374. Ex-1013, ¶¶ 1-2. Dr. Chamberlain did not purport to have reviewed the claims of the '073 patent and certainly did not consider their patentability in view of the Petition's proposed combination of the Bird Barrier Video, Kunz, Albanese, and Sheldon. *Id.*, ¶ 12. Moreover, in reviewing Dr. Chamberlain's testimony in IPR2022-01253, the Board itself previously afforded it minimal weight in denying institution. Ex-1014, 35-37 (cites to Ex-1004 corresponding to Ex-1013 in the current proceeding). Accordingly, for purposes of evaluating institution of *this* IPR, the Board should assign no weight to Dr. Chamberlain's testimony in Ex-1013.

For all of the foregoing reasons, the Petition fails to establish a reasonable likelihood that Claim 1 is unpatentable under Ground 1. The Board should therefore deny institution.

B. Claims 2 and 3

For the reasons explained above with respect to Claim 1, the Petition's arguments in relation to Claims 2 and 3 are similarly insufficient and do not warrant institution. Meridian reserves the right to comment further on the patentability of Claim 2 and 3 in the event the Board institutes review.

VI. CONCLUSION

For at least the foregoing reasons, Patent Owner Meridian requests that the Board decline to institute this proceeding.

Dated: November 29, 2023

Respectfully submitted,

/Christopher B. Kelly/
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VII. CLAIMS LISTING

Claim Element	Challenged Claims
[1.0]	1. A method for the safe live capture of a flying vertebrate that is inside a large building comprising:
[1.1]	a) determining the species of flying vertebrate;
[1.2]	b) selecting bird netting having netting pockets;
[1.3]	c) attaching a plurality of adjustable height support poles to the netting, the poles comprising:
[1.3.1]	i. a hook for attaching the poles overhead;
[1.3.2]	ii. a pulley attached to an upper portion of the pole; and
[1.3.3]	iii. a rope attached to the pulley, the rope having devices to attach the bird netting to the rope;
[1.4]	d) positioning the netting for capture based on the species of flying vertebrate and their flight characteristics utilizing the height adjustable poles to raise the netting;
[1.5]	e) driving the flying vertebrate or waiting for the flying vertebrate to fly into the netting pockets;
[1.6]	f) lowering the netting using the height adjustable support poles; and
[1.7]	g) removing the flying vertebrate from the netting.
[2]	2. The method according to claim 1 which comprises the additional step adapted a building to prevent further entry by the determined species of flying vertebrate.
[3]	3. The method according to claim 1 wherein the poles are telescoping poles.

VIII. CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(b)(1), the undersigned hereby certifies that the foregoing **Patent Owner's Preliminary Response** contains 10,315 words, which is less than the total words permitted by the U.S. Patent Trial and Appeal Board rules. Counsel relies on the word count of the computer program used to prepare the brief

Dated: November 29, 2023

/Christopher B. Kelly/

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IX. CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a complete and entire copy of the foregoing **Patent Owner's Preliminary Response** and all supporting exhibits were served on November 29, 2023, via e-mail to the counsel of record for Petitioner at the email addresses below. The parties both consented to electronic service prior to filing of this Petition.

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