

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 IPR2023-01341
Patent No. 10,154,663

**Patent Owner's Sur-Reply to Petitioner's Reply to
Patent Owner's Preliminary Response**

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)

I. CLAIM CONSTRUCTION

Safe Haven argues that the Trial Practice Guide allows it to “respond to any such new claim construction issues raised by the patent owner.” Reply at 1. But the claim construction articulated in Meridian’s Preliminary Response is nothing new—it is rooted in express statements made to the USPTO when the limitations in question were added during prosecution to the ’663 patent’s claims. Safe Haven was obligated to account for the prosecution history in the Petition and it failed to do so.

Claim 1 of the ’663 patent recites that “the rope is configured to raise *the entire* bird netting to the upper portion of the plurality of poles in a deployed position to capture the flying vertebrate.” During prosecution of the ’663 patent, the “entire” language was added by amendment to distinguish the claims from art cited by the Examiner. Ex-1002, 18 (Amendment in Response dated April 18, 2018). Commenting on the meaning of this claim amendment, Meridian represented to the USPTO that “[t]he entire netting needs to be raised to the upper part of the poles to prevent it from blocking activities on the floor of the building it is used in.” *Id.* at 21. Thus, Meridian explained in its Preliminary Response that Claim 1 must be construed to require the capability to *raise the entire bird netting to prevent the netting from blocking activities on the floor of the building it is used in.*

Despite Meridian identifying this clear indication of how the inventor understood and limited the claimed invention, Safe Haven continues to insist that

the claim term “require[s] no express construction.” Reply at 3. Safe Haven first argues that the claims should not be construed consistent with the prosecution history because “[t]he claims themselves contain no such requirement.” Reply at 2. However, interpreting claims based on the “claim language[] standing alone is not the correct standard of law and is contrary to uniform precedent.” *Nature Simulation Systems Inc. v. Autodesk, Inc.*, 50 F. 4th 1358, 1364 (Fed. Cir. 2022). In addition to the claim language and specification, the prosecution history must be consulted in interpreting the claims. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc); *see also Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) (“We cannot look at the ordinary meaning of the term ... in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history.”)

Safe Haven next argues that the '663 patent's prosecution history contains “no clear and unmistakable disavowal of the plain and ordinary meaning.” Reply at 3. Yet, Meridian's arguments during prosecution were made specifically to distinguish the '663 patent's claims from prior art in which the entire netting was not configured “to be raised to the upper part of the poles to prevent it from blocking activities on the floor of the building it is used in.” Ex-1002, 21. Prosecution arguments of this nature that “draw distinctions between the patented invention and the prior art are useful for determining whether the patentee intended to surrender territory, since

they indicate in the inventor's own words what the invention is not.” *MBO Labs., Inc. v. Becton, Dickinson & Co.*, 474 F.3d 1323, 1330 (Fed. Cir. 2007).

Here, a reasonable competitor would understand the arguments in the '663 patent's prosecution history as clearly disclaiming devices that are incapable of raising the entire bird netting to prevent the netting from blocking activities on the floor of the building it is used in. *See Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 956-957 (Fed. Cir. 2000). Meridian could not now extend the '663 Patent's claims to cover devices lacking this configuration, nor can Safe Haven demonstrate a reasonable likelihood of the claims' unpatentability without showing that this specific configuration was obvious. *Id.* at 957 (“The prosecution history constitutes a public record of the patentee's representations concerning the scope and meaning of the claims, and competitors are entitled to rely on those representations when ascertaining the degree of lawful conduct, such as designing around the claimed invention.”).

II. HEARSAY

Safe Haven recognizes that “Dr. Chamberlain provided his declaration for Patent Owner *in a different proceeding*” and appears to concede that it cannot produce Dr. Chamberlain for cross-examination in this IPR. Reply at 4 (emphasis in original). Thus, Dr. Chamberlain's testimony in Exhibit 1013 is hearsay unless one of the exceptions under Fed. R. Evid. 801(d) applies.

Safe Haven argues that Dr. Chamberlain's entire testimony in Exhibit 1013 is admissible under Rule 801(d)(2)(B) as a statement that Meridian "manifested that it adopted or believe to be true." Reply at 5. However, Rule 801(d)(2)(B) has a "restrictive scope" that requires "a finding that the party has specifically adopted *each statement at issue* made by the expert, rather than treating as admissible any statement made by the witness within the scope of his agency." *Pernix Ireland Pain Dac v. Alvogen Malta Operations Ltd.*, 316 F. Supp. 3d 816, 824 (D. Del. 2018) (citations omitted; emphasis added). Moreover, as the proponent of the statements, "[t]he burden is on [Safe Haven] to lay a foundation for the admission of the [declaration] by laying a foundation to show that *the statements that it wishes to introduce* are non-hearsay under Rule 801(d)(2)(B)." *Id.* at 825.

Ignoring the restrictive scope of Rule 801(d)(2)(B), Safe Haven fails to identify specific statements by Dr. Chamberlain adopted by Meridian in relation to the '663 patent. For example, at the outset of its Petition, Safe Haven argued that Dr. Chamberlain "acknowledged and expressly represented to the Board that features corresponding to each element of Claims 1-3 of the '663 patent are taught or rendered obvious by prior art references that are the subject of this Petition." Pet. at 1-2. But Safe Haven identifies no specific statement in which Dr. Chamberlain acknowledges or represents this, much less one that Meridian then manifested that it adopted or believed to be true. Indeed, Dr. Chamberlain's prior testimony makes

no mention of the '663 patent's claims, how the '663 patent claims relate to the entirely different patent that was addressed in his declaration (USPN 10,251,374), or how the '663 patent claims (correctly construed) relate to the prior art cited in Safe Haven's Petition. These circumstances are in stark contrast to *Motionpoint Corp. v. Transperfect Glob., Inc.*, where the Board admitted a prior declaration directed to the same patent. See Reply at 5; CBM2014-00060, Paper 41 at 21-23.

Safe Haven alleges that Meridian's arguments relating to the admissibility of Dr. Chamberlain's testimony are an "attempt[] to hide from the prior testimony of its own expert." Reply at 4. Meridian is doing nothing of the sort. Dr. Chamberlain offered testimony in relation to an entirely different patent in an entirely different proceeding. Safe Haven knew this when it chose to rely on Dr. Chamberlain's prior testimony to support its Petition, failed to establish how specific statements by Dr. Chamberlain have been expressly adopted by Meridian in relation to the '663 patent's claims, and failed to support its Petition with testimony from an expert that has actually evaluated the '663 patent.

Dated: December 21, 2023

Respectfully submitted,

/Christopher B. Kelly/

Christopher B. Kelly, Esq.

Reg. No. 62,573

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 Sur-Reply to Petitioner's Reply to Patent Owner's Preliminary Response** was served on December 21, 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.

Preston Heard (Preston.Heard@wbd-us.com)

John F. Morrow, Jr. (John.Morrow@wbd-us.com)

James E. Dority (James.Dority@wbd-us.com)

Dated: December 21, 2023

/Christopher B. Kelly/

Christopher B. Kelly
Reg. No. 62,573