

Filed on behalf of:
Precision Planting, LLC

Filed: November 26, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRECISION PLANTING, LLC,
Petitioner,

v.

MASCHIO GASPARDO S.p.A.,
Patent Owner.

Case IPR2024-00008
U.S. Patent No. 8,770,121

Before BENJAMIN D.M. WOOD, LYNNE H. BROWNE,
and RICHARD H. MARSCHALL, *Administrative Patent Judges*.

PETITIONER'S MOTION TO STRIKE PATENT OWNER'S SUR-REPLY

I. Background

On November 21, 2024, Patent Owner filed its Sur-Reply including improper evidence and arguments. (Paper 24). Petitioner timely objected to Patent Owner's Exhibits 2020–2023 on November 22, 2024. (Paper 25). On November 22, 2024, Petitioner requested Patent Owner withdraw Exhibits 2020–2023 and new arguments within Patent Owner's Sur-Reply (POSR). Since oral argument is presently scheduled for this matter on December 12, 2024, Petitioner immediately sought and received the Board's authorization on November 25 to file this motion to strike new arguments from the POSR.

II. The Board should strike portions of Patent Owner's Sur-Reply because it presents new arguments, which are inappropriate for sur-reply.

In its Sur-Reply, Patent Owner raises a number of new issues that Patent Owner should have previously raised. While Patent Owner is entitled to respond to Petitioner's reply, "[r]espond," in the context of 37 C.F.R. § 42.23(b) does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing." Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 ("Trial Practice Guide") at 74. Consequently, a "sur-reply that raises a new issue or belatedly presents evidence may not be considered." *Id.* Further, the "Board is not required to attempt to sort proper from improper portions of the reply or sur-reply" brief. *Id.*

At the outset, Patent Owner relies heavily throughout the POSR on impermissible evidence, which taints the propriety of the entire POSR. Patent Owner's heavy reliance on inappropriate evidence demonstrates the volume of new arguments Patent Owner presents in the POSR and provides an independent basis to strike portions or the entirety of the POSR.

Patent Owner's most egregious substantive reliance on new evidence is on Exhibit 2021—the sur-reply declaration of its expert, Dr. Dankowicz, which Petitioner has sought to exclude. Patent Owner relies on Exhibit 2021 to support the POSR at least 24 times in its 29-page submission. (Paper 24 at 4–5, 7–8, 8–9, 10–11, 13, 15, 16, 18–19, 21, 24–27, 29). Tellingly, Exhibit 2012—Dr. Dankowicz's prior declaration submitted months ago with Patent Owner's Response—is cited only five times. (Paper 24, at 18, 24–27). Patent Owner's frequent and inextricable reliance on new evidence and arguments, impermissibly introduced weeks before the scheduled oral argument of this matter, deprives Petitioner of any opportunity to cross-examine or otherwise respond to Patent Owner's positions or evidence. If Patent Owner had made these arguments previously, Patent Owner would not have needed to so extensively rely on new evidence to support them. These new arguments should be stricken. Trial Practice Guide, at 74. Moreover, assuming Patent Owner's sur-reply evidence—Exhibits 2020–2023—is stricken as impermissible, the vast majority of the POSR should be

stricken as attempting to introduce new arguments, even if unsupported by evidence.

In addition to its inextricable reliance on new evidence throughout the brief, Patent Owner makes arguments that should be stricken as new or taking a new direction from its previous positions. First, Patent Owner presents new arguments about whether VenHuizen anticipates the claims. Previously, Patent Owner did not argue that VenHuizen does not anticipate under the Board’s preliminary interpretation. Patent Owner’s Response argued “[t]he anticipation grounds based on VenHuizen fail because it does not disclose a [thrust-bearing element] under the correct [means-plus-function] interpretation of that claim limitation.” (Paper 17 at 18 (emphasis added)). Patent Owner’s expert agreed VenHuizen anticipates if the Board maintains its preliminary construction:

Okay, so I’m going to read to you what the Board said. (Quote as read): Accordingly, on this preliminary record, we agree with Petitioner’s construction of thrust-bearing element as an element that provides support against an axial force.

With that understanding, do you agree that if the Board maintains that interpretation, then VenHuizen anticipates?

A. Yes. ...

(Exhibit 1023 at 89:1–12 (emphasis added), cited by Paper 20 at 16–17). Now, in the POSR, Patent Owner argues that VenHuizen does not anticipate under the Board’s preliminary construction—and attempts to repurpose its prior arguments and reason for alleging a means-plus-function interpretation. (Paper 24 at 15–16). The Board should strike this new argument.

Second, the POSR argues that the prior art lacks disclosure of 112(f) equivalents under Patent Owner’s interpretation of “thrust-bearing element” (TBE) when it could have but did not argue it earlier. (Compare Paper 24 at 17–26 with Paper 17). Patent Owner knew a 112(f) interpretation of TBE includes equivalents (Paper 17 at 6), but did not present any arguments or evidence explaining why the asserted prior art did not disclose equivalent structure. (*See generally* Paper 17). Patent Owner’s equivalents arguments raised for the first time on sur-reply should be stricken. (Paper 24 at 17–22, 25–27).

Third, Patent Owner now proposes an independent argument for validity based on a new claim construction of “rotatable”—requiring 360-degree unrestricted free rotation—when it nowhere argued this independent basis before. (*Compare* Paper 24 at 15 *with* Paper 17 at 21–22). When Patent Owner previously argued the meaning of “rotatable,” it did so in the context of analyzing whether VenHuizen disclosed the same structure under its 112(f) interpretation of TBE, not

that VenHuizen—or other prior art—failed to disclose a “rotatable” TBE under the Board’s interpretation. (*Id.*) Thus, this argument should also be stricken.

Fourth, on page 21, the POSR alleges VenHuizen fails to disclose the *entirety* of its equivalent TBE structure being located in the movable portion of the housing. While the Board did state that the TBE needed to be in the movable portion, Patent Owner has never before raised the alleged requirement that the *entire* TBE must be in the movable portion. (*Compare* Paper 24 at 21 *with* Paper 17 at 12–13). Because Petitioner has not had an opportunity to contest Patent Owner’s new, maximalist argument about the location of the TBE, this argument should also be stricken.

The Board should strike at least the portions of the POSR making the arguments enumerated above. And since the “Board is not required to attempt to sort proper from improper portions of the reply or sur-reply” brief, Trial Practice Guide at 74, the Board should consider striking the entire POSR because the new arguments and evidence are so pervasive and inextricably intertwined with whatever remnants of Patent Owner’s old arguments and evidence may have survived.

Dated: November 26, 2024

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Certificate of Service

Pursuant to 37 C.F.R. § 42.6(e), I certify that on November 26, 2024, a true and correct copy of **Petitioner's Motion to Strike Patent Owner's Sur-Reply** was served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

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