

IN THE 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

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

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S OBJECTIONS TO PATENT OWNER'S EXHIBITS AND
MOTION TO EXCLUDE EXHIBITS 2020-2023**

I. Introduction

Precision's (Petitioner's) Objection (Paper 25) to and Motion (Paper 26) to Exclude Exs.2020-2023 and its related Motion to Strike (Paper 27) reflect Precision's procedural attempt to have the Board decide this case on a partial record—apparently fearful that its substantive case will not prevail. Like its substantive case, however, the Motions should fail. This paper responds to Papers 25 and 26.

II. The Board should not exclude Exhibits 2020-2023 because they are permitted by Rule and the Board's Trial Practice Guide

The basis for Precision's Objection to and Motion to Exclude Exs.2020-2023 is that the four exhibits constitute "new evidence other than deposition transcripts of the cross-examination of any reply witness." 37 C.F.R. § 42.23(b); *see also* Consolidated Trial Practice Guide, November 2019 ("CTPG") at 73. Precision does not contest that the four exhibits respond only to arguments raised in the Reply. Rather, per Precision, if an exhibit is not a deposition transcript, then it must automatically be excluded from the record. Maschio (Patent Owner) disagrees.

Three of the four exhibits are not "new evidence" (and Precision does not mention any prejudice that the Board's consideration of them would cause Precision).

- Ex.2020 is an updated version of Ex.2002, the District Court docket. Maschio included this exhibit for the benefit of the Board to provide the current status of the related litigation (stayed) and explain why no action can now be taken in the litigation. Although the Stay Order was issued on October 7, 2024, Precision failed to advise the Board of that Order in its Reply filed four days later. Regardless, Ex.2020 is neither new evidence nor new to Precision.
- Ex.2022 is a “Joint” Claim-Construction Brief that was filed with the District Court. The brief relates to the District Court Claim Construction Memorandum (Ex.2003) and Order (Ex.2004), respectively. Because Precision submitted this brief jointly, it is not new evidence and is not new to Petitioner. Maschio submitted the brief only to demonstrate that Precision’s Reply argument against application of the doctrine of claim differentiation in this proceeding is inconsistent with its position before the District Court.
- Ex.2023 is a copy of a case cited in the Sur-Reply, included only because it is required by 37 C.F.R. § 42.13(d) (citation of authority). The case is not new evidence.

Even if the three exhibits were new evidence, the Board should exercise its discretion under 37 C.F.R. § 42.5(b) to waive 37 C.F.R. § 42.23(b) and consider the

information. Maschio defers to the Board's discretion, however, about whether the information reflected in Exs.2020, 2022, and 2023 is helpful to the Board.

Ex.2021 is the Sur-Reply Declaration of Maschio's expert. As Precision recognizes in Paper 27 at page 2, the Declaration largely tracks the Sur-Reply. Therefore, Maschio's response with respect to the Declaration is included in its response to the Motion to Strike the Sur-Reply. Maschio notes here, however, that Precision's expert has filed two Declarations (Exs.1003 and 1021) and each side has deposed the other's expert (Exs.2014 and 1023). It would be fundamentally unfair to exclude the second (Sur-Reply) Declaration of Maschio's expert (Ex.2021) and limit Maschio to its first expert Declaration (Ex.2012), especially when the second Declaration only replies to the second (rebuttal) Declaration of Precision's expert.

III. Conclusion

Accordingly, Maschio respectfully requests that the Board deny the Motion to Exclude with respect to Exs.2020-2023.

Respectfully submitted,

Date: December 3, 2024

By: /Kevin R. Casey/

Kevin R. Casey, Reg. No. 32,117
Stradley Ronon Stevens & Young LLP
30 Valley Stream Parkway
Malvern, PA 19355-1481
Phone: (610) 640-5813
Fax: (610) 640-1965
kcasey@stradley.com

Ashley E. Shapiro, Pro Hac Vice
Stradley Ronon Stevens & Young LLP
2005 Market Street, Suite 2600
Philadelphia, PA 19103
Phone: (215) 564-8113
Fax: (215) 564-8120
ashapiro@stradley.com

ATTORNEYS FOR PATENT OWNER

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on December 3, 2024 a complete and entire copy of the PATENT OWNER'S OPPOSITION TO PETITIONER'S OBJECTIONS TO PATENT OWNER'S EXHIBITS AND OPPOSITION TO MOTION TO EXCLUDE EXHIBITS 2020-2023 was served via electronic mail, as agreed to by counsel, upon the following counsel of record for Petitioner:

Scott Brown: sbrown@hoveywilliams.com

Matthew Walters: mwalters@hoveywilliams.com

/Kevin R. Casey/
Kevin R. Casey, Reg. No. 32,117

Date: December 3, 2024