

Filed on behalf of:
Precision Planting, LLC

Filed: December 10, 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 REPLY IN SUPPORT OF ITS
MOTION TO EXCLUDE EXHIBITS 2020–2023**

Maschio attempts to rewrite the history of this proceeding and its own actions to deprive Precision Planting of a fair opportunity to cross-examine Maschio's expert and respond to Maschio's ever evolving position in this case. Because Maschio fails to present any cognizable argument for the admission of its late evidence, the Board should exclude it as untimely and exclude with it Maschio's sur-reply arguments based on such evidence.¹

I. Maschio Ignores Its Role in Failing to Timely Present Evidence and Arguments.

Maschio bases its arguments on the false premise that Precision has abandoned a prior claim construction position to adopt a new one. But the claim construction arguments in Precision's Petition were consistent with the claim construction arguments previously presented by the parties before the district court. (*See* Paper 20 at 2.) In its POPR, Maschio likewise appeared to stand by the claim construction positions it took before the district court. (Paper 7 at 28 ("Maschio suggests that the Board need not expressly construe any claim term for purposes of

¹ Maschio opposes portions of Precision's motion to exclude by reference to its contemporaneously filed opposition to Precision's motion to strike. (*See* Paper 29 at 3 ("Maschio's response with respect to the Declaration is included in its response to the Motion to Strike the Sur-Reply.")).

a decision to deny institution of trial.”.) Then, after institution, Maschio took an entirely new approach in its Patent Owner Response, arguing for the first time anywhere that “thrust-bearing element” should be construed as a means-plus-function term. (Paper 17 at 4–5.)

In its Reply, Precision did not abandon its prior claim construction position. Rather, Precision argued that the Board’s preliminary *non*-means-plus-function construction is correct. (Paper 20 at 4–7.) Precision also responded to Maschio’s newly proposed 112(f) construction by establishing that, even if the Board determines the claim term is subject to 112(f), Maschio failed to properly address 112(f) equivalents, and anticipation and obviousness are satisfied by the disclosures under the asserted grounds. (Paper 20, at 7–24, 28–30). Thus, Precision maintained the position it has urged all along while also addressing Maschio’s new arguments. The Board should not accept Maschio’s circular argument that *its own* eleventh-hour about-face somehow establishes good cause to submit sur-reply evidence in response to the arguments Precision was forced to make in reply to Maschio’s brand-new claim construction positions. Maschio could have—and should have—presented evidence in support of its new claim construction arguments when the arguments were first made. The Board should not reward Maschio for inexplicably waiting to submit that supporting evidence as “sur-reply” material.

II. Maschio Fails to Establish Any Exceptions Excusing Its Improper and Prejudicial Evidence.

Maschio does not dispute that 37 C.F.R. § 42.23(b) prohibits filing “new evidence other than deposition transcripts of the cross-examination of any reply witness.” Instead, Maschio asks the Board to waive the clear rule because it would be unfair to exclude Maschio’s sur-reply declaration and corresponding arguments when “Precision already cross-examined Maschio’s expert” and can “address the POSR at oral argument.” (Paper 28 at 5.) Maschio further argues that any prejudice to Precision is “self-inflicted.” (*Id.*) None of these arguments permit the Board to ignore or waive its rules.

Maschio’s Exhibits 2020–2023 are undeniably “new” because they were not previously of record in this proceeding. As established in Precision’s motion, Maschio extensively relies on its sur-reply declaration of Dr. Dankowicz rather than evidence already of record or the cross-examination of Precision’s expert. (Paper 27 at 2.) That fact alone establishes that Maschio is presenting new arguments based on new evidence. Further, while some evidence may have existed elsewhere *outside the record of this proceeding*, that evidence is nevertheless still *new* when introduced here.

While it is true Precision has already cross-examined Dr. Dankowicz about his prior Responsive Declaration (Paper 18, Exhibit 2012), Precision has not had

any opportunity to cross-examine Dr. Dankowicz about his new sur-reply declaration (Exhibit 2021), which was filed November 21, a mere *three weeks before oral argument of this matter*. Moreover, the parties' previous agreement—and the Board's authorization—to amend the scheduling order in this matter does not license Maschio to abuse due process and the rules with the late submission of evidence.

Precision does not and cannot have a full and fair opportunity to cross-examine Dr. Dankowicz about his new opinions in time to meaningfully respond at oral argument as Maschio suggests. This prejudice to Precision is *not* “self-inflicted,” as Maschio argues. It is a result of Maschio's own changed positions and late efforts to fill gaps that it should have addressed when it introduced its new claim construction. In any event, “[u]nless [the Board] cho[oses] to exercise its waiver authority under 37 C.F.R. ¶ 42.5(b), the Board [i]s obligated to dismiss ... untimely argument[s]....” *Dell Inc. v. Acceleron, LLC*, 884 F.3d 1364, 1369–70 (Fed. Cir. 2018).

Finally, the Board should not waive 37 C.F.R. § 42.23(b) in the circumstances presented here because it would establish a precedent encouraging late development of arguments, clear violations of § 42.23(b) without prior Board approval, and deprivation of Petitioner's rights to cross-examine a patent owner's witness. Maschio should have known its sur-reply evidence was improper under

the rules and sought relief prospectively rather than simply breaking the rules and asking for forgiveness. Maschio should not be rewarded for holding back evidence that could and should have been presented earlier, thereby denying Precision an opportunity to achieve a “just, speedy, and inexpensive resolution” of this proceeding under 37 C.F.R. § 42.1.

Dated: December 10, 2024

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Certificate of Service

Pursuant to 37 C.F.R. § 42.6(e), I certify that on December 10, 2024, a true and correct copy of **Petitioner's Reply in Support of its Motion to Exclude Exhibits 2020–2023** was served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

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