

Filed on behalf of:
Precision Planting, LLC

Paper 33
Filed: January 17, 2025

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 RESPONSE TO THE BOARD'S
JANUARY 10, 2025 REQUEST FOR FURTHER BRIEFING**

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Patent Owner's Sur-Reply argues for the first time that the thrust-bearing element (TBE) claimed in the '121 patent must be located *entirely* within the movable portion of housing of the seed distribution element. (*Compare* Paper 24 at 21 *with* Paper 17 at 12–13.) The claims require only that the TBE be “supported rotatably in the movable portion.” (Ex.1001 at 5–6, col. 4:38–39, col. 6:4.) Although the preferred embodiment places the disclosed structure of the TBE entirely within the movable portion, it would be error for the Board to import such a limitation from the specification into the claims.

I. The Objects of the Invention and Other Language in the Specification Do Not Limit the Scope of the Thrust-Bearing Element.

As the Board notes, “easy retrofitting, all without removing movable parts and/or operations of disconnecting the sowing disc” is “[a]mong the principal advantages of the distribution element” that the inventor recites in the '121 patent's specification. (Ex. 1001 at 5, col. 4:1–2, 7–9.) In the same paragraph, the inventor recites two other “principal advantages” of the invention:

- “the wear on the seal resulting from the sliding contact with the seed selector disc is substantially reduced, if not eliminated” (*id.*, col. 4:2–4); and
- “the thrust-bearing element is self-cent[e]ring, thereby allowing easy opening and closing of the movable portion on the fixed portion of the housing” (*id.*, col. 4:4–7).

Even to the extent these “advantages” are construed as objects of the invention, they do not limit the scope of the claims. “The fact that a patent asserts that an invention achieves several objectives does not require that each of the claims be construed as limited to structures that are capable of achieving all of the objectives.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004), *quoted with approval in Phillips v. AWH Corp.*, 415 F.3d 1303, 1327 (Fed. Cir. 2005) (*en banc*). “[I]t is generally not appropriate to limit claim language to exclude particular devices because they do not serve a perceived ‘purpose’ of the invention An invention may possess a number of advantages or purposes, and there is no requirement that every claim directed to that invention be limited to encompass all of them.” *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1325 (Fed. Cir. 2008) (citation and internal quotations omitted).

“Absent a clear disclaimer of particular subject matter, the fact that the inventor may have anticipated that the invention would be used in a particular way does not mean that the scope of the patent is limited to that context.” *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 1355 (Fed. Cir. 2003). Where an inventor merely lists objects of the invention that correspond to features recited in one or more claims, it is “unlikely that the inventor intended for each claim to be limited to all of the many objects of the invention.” *Pacing Techs., LLC v. Garmin Int'l, Inc.*, 778 F.3d 1021, 1025 (Fed. Cir. 2015). Without more, such a recitation is

not a “clear and unmistakable statement of disavowal or disclaimer.” *Id.* The Federal Circuit has found that such a disclaimer occurs when the specification states that *all* “objects and features of the present invention are accomplished, as embodied and fully described herein,” by a particular embodiment—thereby clearly and unmistakably limiting the invention to that embodiment.

In contrast, the '121 patent is unclear exactly what part of “the system” obtains the advantage, what part is easily retrofitted, what parts need not be removed, and what “operations of disconnecting the sowing disc” can be avoided in the stated object called out by the Board in its request for further briefing. (Ex.1001 at 5, col. 4:7–9.) No evidence establishes that this nebulous advantage could not be achieved with a TBE that is partially outside the movable portion when assembled. And even assuming that locating the TBE entirely within the housing's movable portion increases ease of retrofitting compared to a TBE not located entirely within the movable portion, the '121 patent does not clearly and unmistakably limit claim scope to structures in which the TBE is located entirely within the movable portion. *See, e.g., Phillips*, 415 F.3d at 1326–27 (“The fact that the written description of the '798 patent sets forth multiple objectives to be served by the baffles recited in the claims confirms that the term “baffles” should not be read restrictively to require that the baffles in each case serve all of the recited functions.”).

II. Claim 10's "Pre-assembled" Limitation Does Not Require the TBE to Be Located Entirely Within the Movable Portion.

While claim 1 recites a seed distribution element, claim 10 recites a kit for retrofitting seed distribution elements, wherein the kit comprises the movable portion "pre-assembled with: a [TBE] of the sowing disc, which [TBE] is supported rotatably in the movable portion" (Ex.1001 at 6, col. 6:1–4.) At oral argument, Maschio argued that this language, along with the specification's statement that "[t]he whole of the movable portion 12 complete with thrust-bearing element 26 and seal 24 lends itself advantageously to the production of a kit for the retrofitting of existing seed drills," (Ex.1001 at 5, col. 3:60–63) supports its "entirely within" construction. (Paper 32 at 40:5–14.) Judge Marschall further suggested that "you would have to have all of this structure within the movable portion based on that pre-assembled with language." (*Id.* at 49:8–10.)

Using the specification's "advantageously" language to require claim 10's TBE to be entirely within the movable portion is another example of improperly importing specification language to limit the claims. *See* § II, *supra*. The "pre-assembled" claim language also does not limit the TBE to being entirely within the movable portion. Because claim 10 recites that the kit "comprises" the movable portion pre-assembled with a TBE, it does not exclude a kit that includes both the movable portion and fixed portion—or one or more elements therein—pre-

assembled with a TBE. *See Vehicular Techs. Corp. v. Titan Wheel Int'l, Inc.*, 212 F.3d 1377, 1383 (Fed. Cir. 2000) (“A drafter uses the term ‘comprising’ to mean ‘I claim at least what follows and potentially more.’”). Moreover, even a pre-assembled movable portion alone could include parts of the TBE—like Fiorido’s centering dowel and drive pin (*see* Paper 20 at 26, 29)—that, when assembled with the rest of the seed distribution element, could protrude beyond the movable portion, through the sowing disc, and *into* the fixed portion, one boundary of which is delimited by the opposing side of the sowing disc. (*See* Ex.1001 at 6, col. 5:4–18.)

Thus, as discussed at oral argument, claim 10—like claim 1—is broad enough to encompass a kit in which the TBE is supported rotatably in, but not located entirely within, the movable portion. (Paper 32 at 48:11–49:16.)

III. Maschio’s Proposed Construction Is Inconsistent with Its Own Identification of the Purported Elements of the TBE.

Maschio argues that the seat 29 of the movable portion of the housing is part of the TBE. (Paper 17 at 9–10, 12; Paper 24 at 7, 10–11.) This argument is inconsistent with Maschio’s new position that the TBE must be located entirely within the movable portion. The seat 29 is not located within the movable portion and is certainly not *supported rotatably* in it, as the claim language requires of the TBE. (Paper 20 at 12–13.) Rather, the seat 29 is a stationary *part* of the movable portion and thus defines the space in which the TBE must be supported rotatably.

Respectfully submitted,

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Certificate of Service

Pursuant to 37 C.F.R. § 42.6(e), I certify that on January 17, 2025, a true and correct copy of **Petitioner's Response to the Board's January 10, 2025 Request for Further Briefing** was served by electronic mail on Maschio's lead and backup counsel at the following email addresses:

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