

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

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450
Submitted Electronically via the Patent Review Processing System

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The description in the '121 Patent related to how the invention provides for easy retrofitting supports the Patent Owner's (PO) construction of the term "thrust-bearing element...supported rotatably in the movable portion" by requiring the entire thrust-bearing element (TBE) be supported within the movable portion. As explained in the '121 Patent, this ease of retrofitting derives from the fact that the TBE is entirely mounted on the movable portion thereby making it easier to replace the movable portion as a whole when compared to a TBE partially or entirely mounted on the fixed portion. This is accomplished because the movable portion complete with the entire TBE can be provided as a single unit preassembled kit.

I. The '121 Patent establishes the claimed invention achieves the retrofitting advantage by supporting the TBE entirely on the movable portion.

Claim terms are interpreted in light of the specification and prosecution history, rather than in isolation. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). The specification and prosecution history warrant departing from plain meaning in two scenarios: lexicography and disclaimer in the relevant specification. *Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). Disclaimer is at issue here.

Courts have noted the specification, is "the single best guide to the meaning of a disputed term." *Phillips*, 415 F.3d at 1315. The '121 Patent states: "[t]he whole of the movable portion 12, **complete with thrust bearing element 26** ... lends itself advantageously to the production of a kit for the retrofitting of existing seed drills."

(Ex. 1001 at 5 col. 3:60-64) (emphasis added). Such language provides that easy retrofitting derives from the fact that the TBE is completely supported within the movable portion thereby making it easier to replace as a whole as compared to a TBE supported partially or entirely within the fixed portion.

Recognizing the need for the claims to achieve the ease of retrofitting advantage, the Board requested briefing on whether some construction – other than the preferred embodiment identified in the '121 Patent – would accomplish the ease of retrofitting advantage. Although Petitioner declined to address this issue, Patent Owner will demonstrate how consistent with the disclosure in the '121 Patent the flagged advantage is not achieved if part of the TBE is supported in the fixed portion.

II. The only embodiment recognized as achieving the retrofitting advantage is the preferred embodiment, which all parties agree mounts the TBE entirely within the movable portion.

As the '121 Patent discloses the Patent Owner's preferred embodiment achieves the retrofitting advantage. *See* § I, *supra*. The Petitioner also acknowledges that the preferred embodiment “places the disclosed structure of the TBE entirely within the movable portion.” (Paper 33 at 1) In its response, Petitioner remained silent on whether embodiments, other than the preferred embodiment, would achieve the retrofitting advantage. This silence is unsurprising as the '121 Patent does not indicate a configuration – other than the preferred embodiment where the TBE is depicted entirely within the movable portion – that results in the flagged advantage.

The Federal Circuit has applied disclaimer to limit a claim element to a feature found only in a preferred embodiment when the specification is devoid of other alternative. *See Inpro II Licensing, S.A.R.L. v. T-Mobile USA Inc.*, 450 F.3d 1350, 1354–55 (Fed. Cir. 2006). Here, the only disclosed or suggested embodiment of the TBE that accomplishes the retrofitting advantage in the '121 Patent is a TBE supported entirely within the movable portion. Although the *Inpro* court had additional support for its limiting construction from statements in the summary of the invention, the Federal Circuit did not indicate that these statements were the decisive factor. *Id.* Indeed, *Inpro* recognized, “[a]lthough claims need not be limited to the preferred embodiment when the invention is more broadly described, ‘neither do the claims enlarge what is patented beyond what the inventor has described as the invention.’” *Id.* (citing *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed.Cir. 2001)).

Like *Inpro*, disclaimer is appropriate in this situation to construe the entire TBE as being within the movable portion. That is the construction of the TBE disclosed in the '121 Patent that accomplishes the retrofitting advantage. To construe the TBE as supported anywhere else would impermissibly enlarge the '121 Patent.

III. The '121 Patent supports the conclusion that the entire TBE must be within the movable portion to achieve the retrofitting advantage.

Regardless of whether the Board deems *Inpro* applicable, Petitioner's difficulty in identifying alternate embodiments is unsurprising, as the '121 Patent

clearly links the TBE support to the flagged advantage. The '121 Patent explains – with reference to the preferred embodiment – 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. 3:60-64). The flagged advantage – easy retrofitting – is linked by the '121 Patent to the TBE in the preferred embodiment, which all parties agree is supported entirely within the movable portion. Because the '121 Patent provides no alternative construction for the TBE to achieve the retrofitting advantage, nor has any party explained how the TBE could be supported all or partially in the fixed portion but still achieve the flagged advantage, the TBE must be construed as being entirely within the movable portion.

IV. The “Pre-assembled” limitation in Claim 10 also supports the conclusion that the TBE must be entirely supported within the movable portion.

The Petitioner continues to argue the ease of retrofitting advantage should have no effect on claim construction as it relates to the “pre-assembled” limitation of claim 10. As outlined above, the TBE should be construed as being entirely supported in the movable portion. *See* § II, *supra*. Furthermore, the '121 Patent makes clear that the flagged advantages is not achieved if a portion of the TBE is supported outside the movable portion. *See* § III, *supra*. Again, the '121 Patent makes clear ease of retrofitting is derived from the fact that the TBE is entirely mounted on the movable portion thereby making it easier to replace as a whole when

compared to a TBE partially or entirely mounted in the fixed portion. (Ex. 1001 at 5 col. 3:60-64). Specifically, this advantage is achieved because the movable portion complete with the entire TBE can be provided as a single unit preassembled kit. *Id.*

Petitioner includes a passing remark that a pre-assembled movable portion of claim 10 could include parts of the TBE that when closed against the fixed portion could potentially protrude into the fixed portion. Petitioner, however, fails to explain how such an embodiment would not be entirely supported by the movable portion, so as to achieve the ease of retrofitting advantage. Regardless of whether a minute section of the TBE protrudes outside the movable portion, it would still be supported entirely by the movable portion – a point noted at oral argument. (Paper 32 at 49:8-10). As a result of the limitations that the easy retrofitting advantage imposes, the pre-assembled language in claim 10 should be construed to further reinforce the requirement that the TBE be supported entirely within the movable portion.

V. Petitioner's acknowledgments that the seat is a part located entirely in the movable portion further supports PO's contention the entire TBE is supported within the movable portion.

Precision argues that the seat 29 "is not located within the movable portion," but is a part of the movable portion. This is a distinction without a difference. It is also inconsistent with the view of a POSA. Ex.2021, 8, 22, 24; Ex.1023, 68. Thus, regardless of how the location of the seat is classified one fact remains – no portion of the seat, or other TBE element, is supported in the fixed portion.

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Patent Owners Response to Petitioner's Response
To the Board's Request for Further Briefing
Respectfully submitted,

Date: January 24, 2025

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Patent Owners Response to Petitioner's Response
To the Board's Request for Further Briefing
CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on January 24, 2025 a complete and entire copy of the **PATENT OWNER'S RESPONSE TO PETITIONER'S RESPONSE TO THE BOARD'S JANUARY 10, 2025 REQUEST FOR FURTHER BRIEFING** was served via electronic mail, as agreed to by counsel, upon the following counsel of record for Petitioner:

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