

Filed on behalf of:
Precision Planting, LLC

Paper 37
Filed: January 31, 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 REPLY IN SUPPORT OF ITS RESPONSE TO THE
BOARD'S JANUARY 10, 2025 REQUEST FOR FURTHER BRIEFING**

Table of Authorities**Cases***Acceleron, LLC v. Dell, Inc.*

No. 12-cv-4123, 2018 WL 7018005 (N.D. Ga. Nov. 14, 2018).....2

GE Lighting Solutions, LLC v. AgiLight, Inc.

750 F.3d 1304 (Fed. Cir. 2014) 1

Inpro II Licensing, S.A.R.L. v. T-Mobile USA Inc.

450 F.3d 1350 (Fed. Cir. 2006) 1, 2

Open Text S.A. v. Box, Inc.

No. 13-cv-4910, 2014 WL 6766018 (N.D. Cal. Dec. 1, 2014) 1

Single Chip Systems Corp. v. Intermec IP Corp.

No. 04-cv-1517, 2006 WL 6143241 (S.D. Cal. Aug. 7, 2006) 1

Textron Innovations Inc. v. Toro Co.

No. 05-cv-486, 2006 WL 6209924 (D. Del. Oct. 20, 2006) 1

Regulations

37 C.F.R. § 42.6 4

The '121 patent does not limit the TBE to being “entirely mounted on the movable portion” (Paper 36 at 1, 4), “completely supported [with]in the movable portion” (*id.* at 2, 4), “entirely within the movable portion” (*id.* at 2–5), or “entirely supported **by** the movable portion” (*id.* at 5, emphasis added). Maschio’s five-page argument cycles through all these alternative constructions. But nothing in the specification disclaims the full claim scope, which requires only a TBE “supported rotatably in the movable portion.” (Ex.1001 at 5–6, col. 4:37–39, col. 6:3–4.)

Instead of addressing the Board’s cited language about the three “principal advantages of the distribution element according to the invention” (*id.* at 5, col. 4:1–9), Maschio focuses only on the 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 seed drills.” (*Id.*, col. 3:60–64.) Citing *Inpro II Licensing, S.A.R.L. v. T-Mobile USA Inc.*, 450 F.3d 1350 (Fed. Cir. 2006), Maschio argues that this language operates as a disclaimer. (Paper 36 at 3.) But the '121 patent does not describe a TBE “entirely within the movable portion” as “the present invention, as essential, or as important.” *GE Lighting Sols., LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1309–10 (Fed. Cir. 2014). And as several courts have noted,¹

¹ *E.g.*, *Open Text S.A. v. Box, Inc.*, No. 13-cv-4910, 2014 WL 6766018, at *8 (N.D. Cal. Dec. 1, 2014); *Textron Innovations Inc. v. Toro Co.*, No. 05-cv-486, 2006 WL 6209924, at *4 n.5 (D. Del. Oct. 20, 2006); *Single Chip Sys. Corp. v. Intermec IP Corp.*, No. 04-cv-1517, 2006 WL 6143241, at *5 (S.D. Cal. Aug. 7, 2006).

Inpro II based its disclaimer holding in part on statements during prosecution to avoid prior art. 450 F.3d at 1356–57. No such statements are at issue here. Moreover, Maschio's assertion that the specification links a TBE “***completely supported within*** the movable portion” to “easy retrofitting” (Paper 36 at 2, emphasis added) is unsupported attorney argument. The specification makes no such link.

Thus, *Inpro II* “is clearly distinguishable from this case in the nature, amount, and variety of disparaging remarks cited in the intrinsic evidence and prosecution history as well as the patent's lengthy discussion of overcoming specific issues found in the prior art.” *Acceleron, LLC v. Dell, Inc.*, No. 12-cv-4123, 2018 WL 7018005, at *6 (N.D. Ga. Nov. 14, 2018). “The [four] lines from the '[121] Patent specification cited by [Maschio] are insufficient to support a result similar to the one reached by the *Inpro* court.” *See id.*

Precision's Response addresses the Board's query whether the retrofitting advantage “would be achieved if a portion of the thrust-bearing element remains in the fixed portion.” (See Paper 33 at 5.) Maschio responds that such an embodiment would still be “supported entirely by the movable portion.” (*Id.* at 5.) But “supported ***by***” appears nowhere in the '121 patent and, as the Board has already recognized (see Paper 12 at 11), is a different and narrower concept than “supported [or located] ***in***.” Maschio's continued shape-shifting is unavailing.

Respectfully submitted,

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Certificate of Service

Pursuant to 37 C.F.R. § 42.6(e), I certify that on January 31, 2025, a true and correct copy of **Petitioner's Reply in Support of Its 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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