

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Topp & Screed S.A.,

Petitioner,

v.

Somero Enterprises, Inc.

Patent Owner.

Case IPR2024-00051

Patent No. 8,038,366

Patent Owner's Preliminary Response

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I. INTRODUCTION

Patent Owner, Somero Enterprises, Inc., is a pioneer in the field of laser-guided concrete screeding machines. Its proprietary technology, for which it has been awarded dozens of patents, is used to achieve highly precise levels of concrete surface flatness at a higher rate of efficiency than conventional methods.

Through its Petition, Petitioner challenged the validity of one of those patents, U.S. Patent No. 8,038,366 (the “’366 Patent”). Patent Owner denies that Petitioner’s arguments have any merit. But more importantly at this juncture, the Petition ignores important procedural safeguards. The IPR process is designed to increase efficiencies. Accordingly, absent a showing of an error material to patentability, deference is given to prior Office evaluations. As it relates to the ’366 Patent, that evaluation occurred during prosecution, where the Examiner was presented with all of the art upon which Petitioner now relies. Because Petitioner failed to identify an error material to patentability, its Petition should be denied.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY THE PETITION UNDER 35 U.S.C. § 325(D)

The Board should exercise its discretion and deny institution pursuant to 35 U.S.C. § 325(d) and its precedential *Advanced Bionics* decision.

Pursuant to Section 325(d), “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30 or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or

substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

In *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH*, the Board set forth Section 325(d)’s two-part test:

- 1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- 2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.

IPR2019-01469, Paper 6 at 8 (PTAB Feb. 6, 2020) (precedential). “If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, ***the Director generally will exercise discretion not to institute inter partes review.***” *Id.* (emphasis added). The Board frequently weighs several non-exclusive factors as part of this analysis, including:

- a) the similarities and material differences between the asserted art and the prior art involved during examination;
- b) the cumulative nature of the asserted art and the prior art evaluated during examination;

- c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential).

Here, there is no dispute that Petitioner relied on the same or substantially the same art as that presented to the Office during prosecution. Because the Petitioner also failed to show material error by the Examiner during prosecution of the application that resulted in the '366 Patent, the Board should deny institution of this Petition.

A. The Same Art Was Previously Presented To The Office

There is no dispute that the art on which Petitioner relied is the same or substantially the same art presented to the Office during prosecution of the application that resulted in the '366 Patent. The grounds of the Petition rely on just

two references, Quenzi and Jochems. Petition at 3. Quenzi is simply the pre-issuance publication of U.S. Patent No. 6,976,805 (the “Quenzi Patent”). *Id.* at 7 (“U.S. 6,976,805 [] issued from Quenzi”). Petitioner concedes, as it must, that both the Quenzi Patent and Jochems were identified on an Information Disclosure Statement and presented to the Examiner during prosecution of the application that resulted in the ’366 Patent.¹ *Id.* at 7 (Petitioner admitting that the Examiner possessed the Quenzi Patent and Jochems); *id.* at 12 (noting that the Quenzi Patent and Jochems “were cited on an IDS”). That alone establishes that these references were previously presented to the Office, even if the Examiner did not apply them in a rejection. *Advanced Bionics*, Paper 6 at 7-8 (“Previously presented art includes . . . art provided to the Office by an applicant, such as on an Information Disclosure Statement, in the prosecution history of the challenged patent”); *Padagis Israel Pharms. Ltd., et al. v. Bausch Health Ireland Ltd.*, IPR2023-01114,

¹ Quenzi and the Quenzi Patent share a common specification, and are, therefore, the same or substantially the same art. *Intel Corp. v. 3D Surfaces, LLC*, IPR2022-01589, Paper 12 at 15 (PTAB April 19, 2023) (the Board finding that “two references are the same or substantially the same prior art because Sfarti is the pre-issuance publication of the ’501 patent and they share a common specification”).

Paper 18 at 12-13 (PTAB January 12, 2024) (rejecting argument that art never applied by the Examiner fails to satisfy part one of the test under Section 325(d)).

Accordingly, part one of the test under Section 325(d) is satisfied.

B. Petitioner Failed To Demonstrate That The Examiner Erred In A Manner Material To Patentability

The Petitioner did not identify Examiner error that was material to patentability. The Board, therefore, should exercise its discretion to deny institution of the Petition.

As an initial matter, the Petitioner alleges that the Examiner erred by “fail[ing] to consider a material reference,” i.e. Quenzi. Petition at 13. That is not so. As the Petitioner admits, the “’366 Patent expressly relies on, and incorporates by reference, Quenzi’s prior art disclosure.” Petition at 15. Quenzi’s disclosure, therefore, “is effectively part of [the ’366 patent] as if it were explicitly contained therein.” *Paice LLC v. Ford Motor Co.*, 881 F.3d 894, 906 (Fed. Cir. 2018) (“Incorporation by reference provides ‘a method for integrating material from various documents into a host document[] . . . by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein.’” (quoting *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000))); *see also* MPEP § 2163.07(b) (“The information incorporated [by reference] is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part

of the text of the application as filed.”). By rule, the Examiner is presumed to have reviewed the “complete specification, including the detailed description of the invention, any specific embodiments that have been disclosed, [and] the claims.” MPEP § 2103. Here, that includes Quenzi’s disclosures, which were incorporated by reference into the specification of the ’366 Patent. Accordingly, the Examiner is presumed to have considered Quenzi.

Further, the claim construction arguments in the Petition undercut any attempt to identify a material error. In presenting its section on claim construction, Petitioner states that it “does not believe that any term requires explicit construction.” Petition at 14. Yet, when applying the prior art in each of its grounds, for each of the independent claims, the Petitioner improperly construed the claims without any significant claim construction analysis.

The Petitioner’s error is illustrated in its analysis of Element 1.7. This limitation reads: “wherein said vibratable member is adjustably attached at a rearward end of said grade establishing element.” Petition at 31. However, the Petitioner effectively re-wrote this limitation to require that the vibratable member is “attached at a location rearward ~~end~~ of said grade establishing element.” *Id.*

(Petitioner stating that “Element 1.7 reflects two requirements . . . (2) attached at a location rearward of the grade establishing member”).²

The Petitioner has not properly justified such a re-writing of the claims. Petitioner argues that the use of “‘at’ to reference a general location” is consistent with how “similar phrasing” is used in the ’366 Patent. *Id.* However, Petitioner’s underdeveloped claim construction analysis ignores evidence to the contrary. For example, in claim 16, when identifying a location, the applicant used the word “location,” not simply the word “at.” Exhibit 1001, p. 33, Claim 16 (“detecting a surface irregularity of the subgrade upon which the wheels travel and at a **location** forward of . . .”) (emphasis added); *see also id.*, Claim 3: (“an auger **disposed behind** said plow member”). The Petitioner’s analysis does not support a re-writing of the claims.

Because the Petition relies on an improper claim construction, it cannot identify any Examiner error **material to patentability** for the claims **as drafted**. Indeed, it is reasonably likely that the Examiner did not apply these same rejections because the Examiner did not interpret the claims as Petitioner has here.

² Petitioner applied this same approach to independent claim 13, and its limitation 13.5, which Petitioner simply stated is analogous to claim 5, which itself depends from claim 1. Petition at 87.

Under such circumstances, there is no showing of a material error. *Advanced Bionics*, at 9 (“If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability”).

Because the Petitioner failed to satisfy section 2 of the test, the Board should exercise its discretion to deny institution.

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition.

Dated: February 20, 2024

Respectfully submitted,

/s/ Sarah E. Waidelich
Sarah E. Waidelich
Registration No. 78,706
Lead Counsel for Patent Owner

HONIGMAN LLP
315 E. Eisenhower Parkway, Suite 100
Ann Arbor, MI 48103
Telephone: 734-418-4242
Fax: 734-418-4243
Email: swaidelich@honigman.com

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Preliminary Response contains 1,868 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 14,000 word type-volume limit specified by 37 C.F.R. § 42.24(b)(1).

Dated: February 20, 2024

Respectfully submitted,

/s/ Sarah E. Waidelich

Sarah E. Waidelich

Registration No. 78,706

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Preliminary Response has been served electronically via email upon the following:

dion.bregman@morganlewis.com
jwhite@morganlewis.com
james.kritsas@morganlewis.com
nicholas.restauri@morganlewis.com

Dated: February 20, 2024

Respectfully submitted,

/s/ Sarah E. Waidelich
Sarah E. Waidelich
Registration No. 78,706
Lead Counsel for Patent Owner