

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALLIANCE NORTH AMERICA, INC.,
Petitioner

v.

MULTIQUIP INC.,
Patent Owner

IPR2024-00211
U.S. PATENT NO. 8,816,651

PATENT OWNER PRELIMINARY RESPONSE TO PETITION

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TABLE OF EXHIBITS

Exhibit	Description
2001	<i>Multiquip, Inc. v. ANA, Inc.</i> Case No. 3-22-cv-02599, Dkt. 32 (Joint Claim Construction and Prehearing Statement) (N.D. TX. June 19, 2023).
2002	<i>Multiquip, Inc. v. ANA, Inc.</i> Case No. 3-22-cv-02599, Dkt. 44 (Joint Claim Construction Chart) (N.D. TX. September 11, 2023).
2003	<i>Multiquip, Inc. v. ANA, Inc.</i> Case No. 3-22-cv-02599, Dkt. 33 (Plaintiff Opening Claim Construction Brief) (N.D. TX. August 3, 2023).
2004	<i>Multiquip, Inc. v. ANA, Inc.</i> Case No. 3-22-cv-02599, Dkt. 36 (Defendant Responsive Claim Construction Brief) (N.D. TX. August 17, 2023).
2005	<i>Multiquip, Inc. v. ANA, Inc.</i> Case No. 3-22-cv-02599, Dkt. 44 (Plaintiff Reply Claim Construction Brief) (N.D. TX. August 31, 2023).
2006	<i>Multiquip, Inc. v. ANA, Inc.</i> Case No. 3-22-cv-02599, Dkt. 47 (Claim Construction Order) (N.D. TX. November 22, 2023).
2007	<i>Multiquip, Inc. v. ANA, Inc.</i> Case No. 3-22-cv-02599, Dkt. 1 (Original Complaint) (N.D. TX. November 18, 2022).
2008	<i>Multiquip, Inc. v. ANA, Inc.</i> Case No. 3-22-cv-02599, Dkt. 25 (Scheduling Order) (N.D. TX. February 17, 2023).
2009	ANA's Invalidity Contentions dated May 8, 2023.
2010	Declaration of Sean D. Burdick

Multiquip, Inc. (“Patent Owner” or “Multiquip”) submits this preliminary response in accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107, responding to the Petition for *Inter Partes* Review (“Petition”) of claims 1, 4, 8-19, 22, and 26-36 of U.S. Patent No. 8,816,651 (the “’651 Patent”) filed by Alliance North America, Inc. (“Petitioner” or “ANA”).¹

I. INTRODUCTION

The Board should deny institution in its discretion under 35 U.S.C. § 314(a) for at least any one of the following reasons:

Procedurally, the petition should be denied on *Fintiv* grounds in light of the underlying district court litigation where trial is set for October 14, 2024 – more than seven months prior to a potential final written decision date of May 27, 2025.

Substantively, the Petition fails to establish the obviousness of combining all the references in each Ground in a manner that would result in the claimed subject matter and that would have been obvious to a POSITA.

¹ Petitioner and Patent Owner are direct competitors in the generator market.

II. RELATED PROCEEDINGS

The '651 patent is involved in *Multiquip, Inc. v. ANA, Inc.*, No. 3:22-cv-2599, filed in the Northern District of Texas on November 18, 2022 (the “Texas Litigation”).

III. THE '651 PATENT

The '651 Patent discloses an innovative “engine-generator with load bank and control system.” The invention employs a specialized controller to automatically add or subtract resistive load from a load bank to ensure that total load on the generator remains within preset minimum and maximum limits. Maintaining total generator load within these limits prevents “wet-stacking” and soot build-up in the engine exhaust by keeping exhaust temperature at desired levels. The invention thereby allows the engine-generator to operate more efficiently over its service lifespan by decreasing (or altogether eliminating) the frequency of regeneration cycles that would otherwise be needed to periodically clean the exhaust system to ensure compliance with EPA emissions standards.

Among other things, as relevant to this Patent Owner Preliminary Response, each of Independent Claims 1 and 19 recites the connection of a load bank to an engine in one of two scenarios: neglect or regeneration.

For the “neglect scenario” or “neglect case,” the ‘651 Patent explains that the load bank is engaged when the load on the generator goes below a preset level in order to “minimize” or “prevent” wet-stacking and soot buildup:

In accordance with some embodiments of the disclosed technology, the generator and load bank controllers are configured to initiate the load bank when certain conditions exist. The load bank is initiated when there is a “neglect scenario” or “neglect case.” The generator controller, via the load bank controller, monitors the load connected to the generator to ensure that the load is within a “window” or “load window” bounded by pre-set lower and upper load levels. ***If the load connected to the generator remains at or below some pre-set load condition—i.e., below the window—for a pre-set duration, the generator controller signals the load bank controller to initiate the load bank.*** The load bank controller then increases or decreases the total resistance of the load bank by connecting or disconnecting load step resistors as necessary to maintain the load within window. If the load rises above the window, the steps of the load bank are disconnected as necessary. In this way, the total load on the generator—i.e., the real load and the resistance of the load bank—remains within pre-set limits. ***The pre-set load corresponds to a power demand on the generator that provides for optimal operation, which minimizes wet stacking and soot build up.***

Restricting the load bank to operation in a neglect case allows one to save fuel because the load bank will only draw power from the generator when necessary to ***prevent wet stacking and soot build up.***

The generator will thus be allowed to operate in a sub-optimal state until such time as wet stacking and soot build up are likely to occur

(Ex. 1001, 2:50-64 -3:19, Emphasis Added).

For regeneration, the '651 Patent explains that "[r]egeneration involves a process in which the engine doses a DPF with diesel fuel and then ignites that diesel fuel to burn-off accumulated soot" (Ex. 1001, 1:43-45) and that "regeneration works better when an engine is operating with higher exhaust temperatures." (Ex. 1001, 1:55-56). Thus, for a "regeneration scenario" or "regeneration case," the '651 Patent explains:

In accordance with some embodiments of the disclosed technology, the generator controller is configured to signal the load bank controller to initiate the load bank when the engine control module initiates regeneration to clean the DPF. In such a "regeneration scenario" or "regeneration case," as it is referred to here, the generator controller will signal the load bank controller to initiate the load bank, thus providing a minimum load for the system in order to maintain an engine exhaust temperature necessary for the DPF regeneration to effectively clean the DPF.

(Ex. 1001, 3:34-43).

The claims also specify disconnecting the load bank in the case of a "load spike." Such disconnection is alternatively referred to in the specification as a "load

dump” and refers to load exceeding a predetermined value. As explained in ‘651 Patent,

The disclosed technology is operable to entirely disconnect, or “dump,” the load bank from the generator within a specified time, which may be necessary when the real load of the generator rapidly increases.

(Ex. 1001, 2:36-40).

In accordance with some embodiments of the disclosed technology, the generator controller may be configured with what is disclosed here as a “load dump” feature. In such a configuration, the generator controller signals the load bank controller to disconnect, or dump, the load bank if the generator controller and/or load bank recognizes a “load spike” of monitored load. Load spike, as used here, is a scenario in which the load connected to the engine-generator exceeds some pre-set value.

(Ex. 1001, 3:64-4:5). The load dump is also referenced in the discussion of the “neglect scenario” in the context of the desired window where the controller can engage in:

[D]isconnecting load step resistors as necessary to maintain the load within window. If the load rises above the window, the steps of the load bank are disconnected as necessary.

(Ex. 1001, 2:63-66)

The summarized features of Independent Claims 1 and 19 addressed in this Patent Owner Preliminary Response are seen in the below emphasized text. The

Challenged Claims specify many more features, as seen in the claims, which would need to be addressed if there were an institution.

Claims	
1. An engine-generator and load bank system comprising:	
an engine mechanically connected to and capable of driving an alternator;	
said engine having an engine control module and a particulate filter;	
said alternator in electrical communication with an output bus and a load bank bus;	
at least one load monitoring device in electrical communication with said output and load bank buses;	
a generator controller comprising a load dump output and a load enable output, said generator controller in electrical communication with said engine control module;	
a load bank controller comprising a load enable input, a load dump input, a load sensor, and at least one load step output;	
said load dump output in electrical communication with said load dump input;	
said load enable output in electrical communication with said load enable input;	
said load monitoring device in electrical communication with said load sensor;	
at least one load step contactor in electrical communication with said at least one load step output; and	
at least one load step resistor in electrical communication with said load bank bus by way of said at least one load step contactor;	
wherein said generator controller provides a control signal via said load enable output in at least one of the following cases neglect and regeneration; and	
wherein said generator controller provides a control signal via said load dump output in case of a load spike.	
19. An engine-generator and load bank system comprising:	
an engine mechanically connected to and capable of driving an alternator;	
said engine having an engine control module and a particulate filter;	
said alternator in electrical communication with an output bus and a load bank bus;	
a generator controller in electrical communication with said engine control	

module, said generator controller having at least one load step output;
at least one load step contactor in electrical communication with said at least one load step output; and
at least one load step resistor in electrical communication with said load bank bus by way of said at least one load step contactor;
wherein said generator controller is capable of operating said load step contactor to connect said load step resistor in at least one of the following cases neglect and regeneration; and
wherein said generator controller is capable of operating said load step contactor to disconnect said load step resistor in case of a load spike.

IV. LEGAL STANDARDS

The Petition must both “clearly point out the differences between the claimed invention and [the prior art]” and “explain why a person of ordinary skill in the art would have found the claimed subject matter obvious in spite of those differences.” *Synopsys, Inc. v. Mentor Graphics Corp.*, IPR2012-00041, Paper 16 at 14 (P.T.A.B. Feb. 22, 2013). Petitioner must specifically recite where the challenged limitation is found in the secondary reference(s) and explain why a POSITA would have modified the primary reference with the recited limitation from the secondary reference(s). *See Microsoft Corp. v. Secure Web Conf. Corp.*, IPR2014-00745, Paper 12 at 11-13 (P.T.A.B. Sept. 29, 2014). “[M]ere conclusory statements” are not sufficient. *Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 15 (P.T.A.B. April 8, 2013).

“To satisfy its burden of proving obviousness, a petitioner cannot employ merely conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380–81 (Fed. Cir. 2016). The “factual inquiry” into the reasons for “combin[ing] references must be thorough and searching, and the need for specificity pervades.” *In re NuVasive, Inc.*, 842 F.3d 1376, 1381–82 (Fed. Cir. 2016) (internal quotations and citations omitted). “An obviousness determination requires finding that a person of ordinary skill in the art would have been motivated to combine or modify the teachings in the prior art and would have had a reasonable expectation of success in doing so.” *Regents of University of California v. Broad Institute, Inc.*, 903 F.3d 1286, 1291 (Fed. Cir. 2018). It is Petitioners’ burden to prove that a POSITA would be motivated to combine and “to demonstrate that the skilled artisan would have had a reasonable expectation of success in combining references.” *KEYnetik, Inc. v. Samsung Electronics Co., Ltd.*, 841 Fed.App’x. 219, 227-228 (Fed. Cir. 2021) (internal citations omitted).

V. LEVEL OF ORDINARY SKILL IN THE ART

For purposes of this Patent Owner Preliminary Response, Patent Owner does not challenge the Petitioner’s proposed definition of a POSITA. *See* Pet. at 11.

Patent Owner reserves the right to further address the level of ordinary skill in the art if this proceeding is instituted.

VI. CLAIM CONSTRUCTION

A. Agreed Construction

Although not mentioned by Petitioner, in the Texas Litigation, Patent Owner and Petitioner agreed in a June 19, 2023 filing with the Court as to the following construction:

Claim Term	Agreed Construction
“regeneration” '651 patent, claims 1, 19	a process in which an engine doses a particulate filter with diesel fuel then ignites the diesel fuel to burn off accumulated soot

(Ex. 2001 at 1). Following claim construction briefing in the Texas Litigation, this construction was confirmed again in Patent Owner and Petitioner’s subsequent Court filing on September 11, 2023. Ex. 2002 at 4. The Court also adopted the agreed construction in its November 22, 2023, Claim Construction Order. (Ex. 2006 at 19).

B. Constructions in the Texas Litigation

Although not mentioned by Petitioner, claim construction briefing in the Texas Litigation was complete on August 24, 2023. *See* Exs. 2003, 2004, and 2005. In reconciling the disputed constructions, the Court rejected all of Petitioner’s proposals and adopted all of the Patent Owner’s proposals. Including the already

agreed “regeneration” construction, the Court adopted the following construction of terms:

Term	Court’s Construction
“regeneration” Claims 1, 19	a process in which an engine doses a particulate filter with diesel fuel then ignites the diesel fuel to burn off accumulated soot
“particulate filter” Claims 1, 19	component used to reduce particles or particulate matter from the exhaust stream of an engine
“electrical communication” Claims 1, 19	a direct or indirect electrical connection
“a generator controller comprising a load dump output and a load enable output” Claim 1	Plain and ordinary meaning
“a load bank controller comprising a load enable input, a load dump input, a load sensor” Claim 1	Plain and ordinary meaning
“load step resistor” Claims 1, 3–4, 10–11, 13– 14, 19, 22, 28–29, 31–32, 34–36	one of a group of electrical resistors in a load bank that can add or subtract a load step in an electric circuit
“neglect” Claims 1, 19	an operating condition of a generator in which its load for a preset duration of time drops below a preset level at which wet stacking and soot buildup will occur

(Ex. 2006 at 19-20).

C. New Constructions Not Introduced in Texas Litigation

Although not briefed by any party in the Texas Litigation, Petitioner suggests a construction for the term “load spike.” Patent Owner disagrees with Petitioner’s construction and application. While this term does not need to be expressly construed, Patent Owner explains below how Petitioner’s interpretation, which uses the identical level for cases of “neglect” and “load spike,” is incorrect.

VII. PETITIONER IS ESTOPPED FROM ARGUING FOR A DIFFERENT MEANING FOR THE PARTY-STIPULATED COURT-ADOPTED CONSTRUCTION FOR “REGENERATION”

Petitioner is estopped from arguing a different meaning for the party-stipulated Court-adopted construction of “regeneration.”

“Judicial estoppel applies just as much when one of the tribunals is an administrative agency as it does when both tribunals are courts.” *Trs. in Bankr. of N. Am. Rubber Thread Co. v. United States*, 593 F.3d 1346, 1354 (Fed. Cir. 2010). Judicial estoppel is also applied in inter-partes review proceedings. *See, e.g., Sonos, Inc. v. Implicit, LLC*, IPR2018-00766, Paper 60 (PTAB Sep. 19, 2023)(determining judicial estoppel applied). Three nonexclusive factors guide the decision on whether conflicting legal stances amount to judicial estoppel: (1) whether the “party’s later position [is] ‘clearly inconsistent’ with its earlier position”; (2) “whether the party has succeeded in persuading a court to accept that party’s earlier position, so that judicial acceptance of an inconsistent position in a later proceeding would create ‘the

perception that either the first or the second court was misled”; and (3) “whether the party seeking to assert an inconsistent position would derive an unfair advantage or impose an unfair detriment on the opposing party if not estopped.” *Hampshire v. Maine*, 532 U.S. 742, 749-50 (2001). “When an issue of fact or law is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, the determination is conclusive in a subsequent action between the parties, whether on the same or a different claim.” *Id.* (quoting *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 148 (2015)).

Here, judicial estoppel applies because: (1) Petitioner stipulated to a construction for “regeneration” in the Texas Litigation and now seeks a different interpretation for this term in this proceeding; (2) the Court in the Texas Litigation adopted the parties’ stipulated construction for “regeneration” in its claim construction order; and (3) by treating the construction of “regeneration” as a nose of wax (in one manner for the Texas Litigation and a different manner in this proceeding), Petitioner would derive an unfair advantage and impose an unfair advantage on Patent Owner.

First, as explained in detail above, Petitioner previously agreed to a specific construction for “regeneration” in a June 19, 2023 filing. Ex. 2001 at 1. That stipulation was confirmed again in a September 11, 2023 filing. Ex. 2002. The Court adopted that stipulated construction in its November 22, 2023, Claim Construction

Order. (Ex. 2006 at 19). Now, in the present proceeding, despite having a mandatory obligation² to inform the Board of the prior construction, Petitioner mentions nothing of the construction. Further, Petitioner proposes no construction for “regeneration” and alleges that references it cites as prior art disclose such regeneration without identifying any evidence corresponding to the party-stipulated, Court-adopted construction.

Second, based on this stipulation, the Court in the Texas Litigation adopted the agreed construction in its claim construction order. (Ex. 2006 at 19).

Third, Petitioner would derive an unfair advantage and impose an unfair advantage on Patent Owner if Petitioner is not estopped. In the Texas Litigation, the case proceeded with the party-stipulated, court-adopted construction. In such litigation, the party-stipulated, Court-adopted construction will apply for infringement purposes. Now, as if the claim term were a nose of wax, Petitioner disregards such construction to improperly bend it in a different direction for validity. *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001)(Noting patent may not be twisted like “a nose of wax” one way for infringement and another for invalidity).

² See Consolidated Trial Practice Guide November 2019 at 47 (Submission of a prior claim construction determination is **mandatory** under 37 C.F.R. § 42.51(b), if it is “relevant information that is inconsistent with a position advanced by the party during the proceeding.”) (emphasis added).

Even if judicial estoppel were determined not to apply, Petitioner's failure to apprise the Board of the party-stipulated, Court-adopted construction is improper. And Petitioner offers no evidence concerning how the references cited disclose such a party-stipulated, court-adopted construction for "regeneration."

VIII. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION CONSIDERING *FINTIV*

Institution of an inter partes review is discretionary. See 35 U.S.C. § 314(a) (authorizing institution of an inter partes review under particular circumstances, but not requiring institution under any circumstances); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion."); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) ("[Section] 314(a) invests the Director with discretion on the question whether to institute review" (emphasis omitted)); *Harmonic*, 815 F.3d at 1367 ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.").

When determining whether to exercise discretion to deny institution in view of a parallel proceeding, we consider the following factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;

4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

See Apple Inc. v. Fintiv, Inc., IPR2020 00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* In evaluating the *Fintiv* factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review,” recognizing that “there is some overlap among these factors” and that “[s]ome facts may be relevant to more than one factor.” *Id.*

On June 21, 2022, the Director of the United States Patent and Trademark Office issued a Memorandum setting forth an “Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation.” Exhibit 1015 (“Guidance Memo”). The Guidance Memo states that “the PTAB will not rely on the *Fintiv* factors to discretionarily deny institution in view of parallel district court litigation where a petition presents compelling evidence of unpatentability.” *Id.* at 2. The “compelling merits” standard is a “higher standard than the standard for institution set by statute.” *Id.* “Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead

to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” *Id.* at 4.

A holistic view of the factors set forth in *Fintiv* reveals the present circumstances favor discretionary denial.

1. Whether a stay exists or evidence exists that one is likely to be granted if a proceeding is instituted

The first factor favors denial because no stay exists. Given the virtual certainty that the Texas Litigation will not be stayed (due to the advanced stage of the case), the first *Fintiv* factor favors denial. *See Fintiv*, Slip. Op. 6.

2. Proximity of the court’s trial date to the Board’s projected statutory deadline

The Board generally denies institution when the trial date is months before the projected statutory deadline of the PTAB’s final written decision (FWD). *Fintiv*, IPR2020- 00019, Paper 11 at 9) (“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution.”). Here, trial is set for October 14, 2024 (Ex. 2008), which would be more than seven months before the expected date of a final written decision (“FWD”): May 27, 2025.

This factor weighs heavily in favor of denial. The Board regularly finds that a period of time less than seven months between trial in the district court and the expected date of the FWD is a duration that supports denial. *See e.g., id.* (5-6

months based on the time-to-trial evidence); *Satco Products, Inc. v. The Regents of the University of California*, IPR2021-00794, Paper 14 at 19 (PTAB Nov. 10, 2021) (five months); *Maxlite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.*, IPR2020-00208, Paper 32 at 5 (PTAB Oct. 12, 2021) (four months); *Stanley Black & Decker, Inc., et al. v. Zircon Corp.*, IPR2020-01572, Paper 10 at 12 (PTAB April 19, 2021) (three months); *Next Caller, Inc. v. TrustID, Inc.*, IPR2019-00961, Paper 10 at 14-15 (PTAB Oct. 16, 2019) (three months); *E- One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6 (PTAB May 15, 2019) (one month).

Additionally, Petitioner has not explained the delay in filing its Petition. The complaint in the Texas Litigation was filed November 18, 2022. Ex. 2007. And, prior to filing, the Patent Owner notified the Petitioner of its infringement on February 10, 2022. *Id.* at ¶54. However, the instant Petition was not filed until nearly a year after the complaint, on November 17, 2023. This delay is particularly concerning given Petitioner served its invalidity contentions in parallel litigation on May 4, 2023. (Ex. 2009). Petitioner offered no explanation as to why it took more than seven months to file its Petition, which copies arguments from invalidity contentions served in litigation. *Id.*

For the foregoing reasons, the second factor favors denial.

3. Investment in the parallel proceeding by the court and parties

The third *Fintiv* factor favors denial because, at the time of the anticipated decision on institution, the investment in the co-pending litigation will already have been significant. In the parallel litigation, the parties have already exchanged infringement contentions and invalidity contentions in March and May of 2023, respectively. Claim construction briefing concluded on August 24, 2023 (Exs. 2003, 2004, 2005) and the Court construed the claims term on November 22, 2023. (Ex. 2006). Expert reports are due to be served on March 29, 2024 and Fact discovery is set to close on March 22, 2024. (Ex. 2008).

The above circumstances collectively add significant weight in favor of denial under this third *Fintiv* factor.

4. Overlap between issues raised in the petition and in the parallel proceeding

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, th[at] fact has favored denial.” *Fintiv*, IPR2020-00019, Paper 11 at 12. Petitioner challenges the same claims in its petition that it does in its invalidity contentions in the Texas Litigation. *See* Ex. 2009 at 1. In fact, Petitioner relies on the same principal references in the Petition as it does in the parallel litigation. *Id.* at 2-3 (identifying Van Niekerk, Sherman, and Egan). Thus, the Petition includes substantial overlap with the claims and evidence asserted in the parallel litigation.

Petitioner also does not address any discretionary factors under 314(a) and offers no stipulation concerning the desire to avoid parallel proceedings. Additionally, given the inconsistent approach to claim terms Petitioner has taken (where claims are interpreted one way for infringement in the Texas Litigation and another for this proceeding), no stipulation could be offered that would offer consistency between the proceedings and avoid treatment of the claim like a “nose of wax.”

The fourth *Fintiv* factor thus also favors denial.

5. Whether the petitioner and the defendant in the parallel proceeding are the same party

The fifth factor under *Fintiv* considers “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Slip. Op. 5–6, 13–14. This factor plainly weighs in favor of denial because ANA is both named as the defendant in the parallel litigation and as the Petitioner here.

6. Other circumstances that impact the Board’s exercise of discretion, including the merits

The sixth factor also favors denial. *Fintiv* states, “if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.” *Fintiv*, Slip. Op. 15 (citations omitted). As discussed below, the Petition is particularly weak, and institution would be an inefficient use of the Board’s resources.

IX. THE BOARD SHOULD NOT INSTITUTE INTER PARTES REVIEW ON THE MERITS

Each of Petitioner's Grounds 1-4 relies on the base Van Niekerk reference (Ex. 1004). Each of Petitioner's redundant Grounds 5-8 relies on the base combination of Egan (Ex. 1006) and Sherman (Ex. 1010).

Petitioner has the burden to demonstrate unpatentability by a preponderance of the evidence. However, Petitioner never identifies a single reference that discloses either the claimed regeneration or neglect scenarios recited in the independent claims.

With regard to the claimed regeneration scenario, Petitioner ignores its agreed construction of the term (which was subsequently also adopted by the District Court in the Texas Litigation) and simply looks for terms in references that say "regeneration" or "regen." However, Petitioner provides no evidence and does not explain how such features satisfy the agreed construction. Petitioner should be estopped from now attempting to pursue a broader construction.

Regarding the neglect scenario, the Petitioner similarly ignores the prior proposed constructions in the Texas Litigation (and corresponding specification discussion) and points to filter cleaning as allegedly corresponding to the limitations. However, such filter cleaning is a reactive scenario that cleans soot and does not seek to proactively prevent accumulation of soot as described in the specification with regard to neglect.

The Petitioner’s sparse reasoning to combine or modify references in these sets is no better. Regarding modifying Van Niekerk, Petitioner merely alleges that features are obvious. This is a quintessential example of conclusory statements deemed insufficient for obviousness. Regarding combinations based on Egan and Sherman, Petitioner similarly provides a list of generic reasons to combine without recognizing incompatible teachings from such references or specifically articulating why Egan and Sherman would be combined.

Petitioner thus fails to satisfy its burden. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (quoting 35 U.S.C. § 316(e)) (stating that “the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence’ . . . and that burden never shifts to the patentee”).

A. Grounds 1 and 3: Van Niekerk Does Not Anticipate or Render Obvious Independent Claims 1 and 19

1. Van Niekerk Neither Discloses Nor Renders Obvious the Claimed “Regeneration” Scenario

Before the filing of the present *inter-partes* review proceeding on November 17, 2023, Petitioner agreed in a June 19, 2023 joint filing with the Court in the Texas Litigation that the term “regeneration” in the ‘651 Patent means:

a process in which an engine doses a particulate filter with diesel fuel then ignites the diesel fuel to burn off accumulated soot.

(Ex. 2001 at 4). Petitioner confirmed this agreed construction *again* in its August 17, 2023 Claim Construction Response (Ex. 2004 at 1) and *again* in its Joint Claim

Construction Chart filing on September 11, 2023 (Ex. 2002 at 1). The Court also adopted the agreed construction in its November 22, 2023, Claim Construction Order. (Ex. 2006 at 19). However, Petitioner neither informs the Board of this construction³ nor offers any explanation to demonstrate how the reference meets such a construction. Petitioner should be estopped from now taking an alternative, broader construction for “regeneration.” Petitioner cannot simply point to a reference that mentions the term “regeneration” or “regen.” Rather, Petitioner must indicate how the reference satisfies the constructions it agreed to, namely “a process in which an engine doses a particulate filter with diesel fuel then ignites the diesel fuel to burn off accumulated soot.” Petitioner did not do that and, accordingly, has not satisfied its burden.

In alleging that Van Niekerk discloses the claimed “regeneration” feature and without specific comments as to reasons why, the Petitioner points to either Regen Mode 110 or Deep Clean Regen Mode 116. Pet. at 34. It’s not clear which of these

³ Patent Owner respectfully submits this violates Petitioner’s obligation to inform the Board of prior claim constructions. The Trial Practice Guide reminds practitioners that “[s]ubmission of a prior claim construction determination is mandatory under 37 C.F.R. § 42.51(b), if it is ‘relevant information that is inconsistent with a position advanced by the party during the proceeding.’ In such cases, the determination should be submitted ‘concurrent with the filing of the documents or things that contains the inconsistency.’ 37 C.F.R. § 42.51(b).” Consolidated Trial Practice Guide November 2019

<https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialPracticeGuideConsolidated>

modes are specifically being relied upon because the Petitioner alternatively points to the “Deep Clean Regen Mode 116” as allegedly disclosing the separate “neglect” features in the claim.

For both, while identifying the word “regen” in Van Niekerk, Petitioner does not explain or provide any evidence to explain how such “regen[s]” engage in “a process in which an engine doses a particulate filter with diesel fuel then ignites the diesel fuel to burn off accumulated soot.”

For at least this reason, Petitioner has not satisfied its burden in identifying the claimed regeneration scenario. Accordingly, Petitioner has not satisfied its burden.

2. Van Niekerk Neither Discloses Nor Renders Obvious the Claimed “Neglect” Feature

In alleging Van Niekerk discloses the claimed neglect feature, the following is the entirety of Petitioner’s allegations:

Van Niekerk discloses operation in the Deep Clean Regen Mode 116, which also meets the “neglect” case. As best a POSITA would understand from the ‘651 disclosure, in the neglect case the system is operated in such manner over sufficient time that wet stacking is likely to occur. Van Niekerk discloses that the Deep Clean Regen Mode is used when the system has been run through several cycles, until the system determines soot accumulation has occurred and the involved and lengthy Deep Clean regeneration process must be undertaken. (EX1004, ¶¶[0022]-[0023].) This is a “neglect” case as best understood

in the ‘651 patent. During this Deep Clean regeneration Van Niekerk discloses the load bank is engaged. (Id. ¶[0023].)

(Pet. at 35). Petitioner is incorrect. Patent Owner respectfully submits that a POSITA would not conclude that Van Niekerk’s deep cleaning mode, which is designed to *clean* a DPF filter, discloses the claimed neglect feature, because the neglect feature pro-actively obviates the need to clean.

As the Petitioner is aware, prior to filing its Petition, in the Texas Litigation, Patent Owner and Petitioner had completed a briefing on a competing set of definitions for “neglect.” The Court’s Claim Construction Order resolved that dispute by rejecting Petitioner’s construction and adopting Patent Owner’s construction.

Disputed Term	Multiquip’s Proposed Construction	ANA’s Proposed Construction	The Court’s Construction
“neglect” • ’651 patent, claims 1, 19	an operating condition of a generator in which its load for a preset duration of time drops below a preset level at which wet stacking and soot buildup will occur	Invalid as indefinite – but in the alternative: The engine is intentionally allowed to operate in a sub optimal state for more than a short duration until wet stacking and soot build up in the exhaust system will occur.	an operating condition of a generator in which its load for a preset duration of time drops below a preset level at which wet stacking and soot buildup will occur

(Exhibit 2006 at 18). In rejecting Petitioner’s proposal and adopting Patent Owner’s proposal, the Court noted:

The specification explains that, in certain embodiments, the generator and load bank controllers are configured to initiate the load bank when there is a “neglect scenario” or a “neglect case,” as follows:

The generator controller, via the load bank controller, monitors the load connected to the generator to ensure that the load is within a “window” or “load window” bounded by pre-set lower and upper load levels. If the load connected to the generator remains at or below some pre-set load condition—i.e., below the window—for a pre-set duration, the generator controller signals the load bank controller to initiate the load bank. The load bank controller then increases or decreases the total resistance of the load bank by connecting or disconnecting load step resistors as necessary to maintain the load within window. If the load rises above the window, the steps of the load bank are disconnected as necessary. In this way, the total load on the generator—i.e., the real load and the resistance of the load bank—remains within pre-set limits. The pre-set load corresponds to a power demand on the generator that provides for optimal operation, which minimizes wet stacking and soot build up.

Restricting the load bank to operation in a neglect case allows one to save fuel because the load bank will only draw power from the generator when necessary to prevent wet stacking and soot build up. The generator will thus be

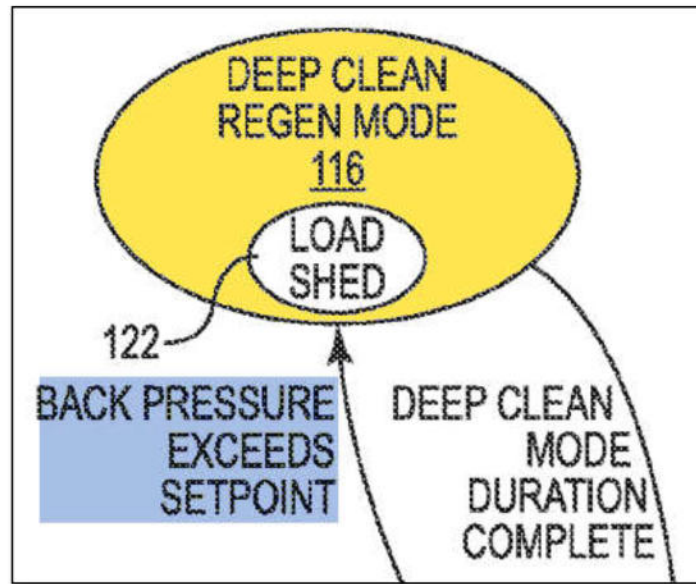
allowed to operate in a sub-optimal state until such time as wet stacking and soot build up are likely to occur. '651 patent, at 2:54–3:9.

(Ex. 2001 at 18, quoting '651 Patent at 2:54-3:9). While it is not clear what construction the Petitioner is advocating for “neglect” here (as it neither reflects the court’s construction nor the position Petitioner advocated in the Texas Litigation), it is clear that Van Niekerk’s “deep cleaning” does not disclose the neglect scenarios described in the specification or provided in the Court’s construction.

As noted in the court-cited notation of the '651 Patent, the “neglect scenario” or “neglect case” seeks to “*prevent* wet stacking and soot build up” by ensuring that the total load on the generator does not remain below a preset level for an excessive period of time (Emphasis added). The generator controller monitors said sub-level load and adds load from the load bank when necessary to raise the total generator load up to within the desired load window.

In contrast to this described *preventive* “neglect scenario”/“neglect” case” and the Court’s construction of the same, Van Niekerk’s “deep cleaning” mode *reacts* to soot buildup. This reactive cleaning mode seeks to provide a deeper level of cleaning than the regular cleaning mode when too much soot has been accumulated. Van Niekerk explains that this “deep cleaning” is initiated when there is “excessive soot loading of the DPF filter 24,” which causes a “monitored back pressure [to exceed]

a predetermined set point.” Ex. 1004, ¶ [0023].



(Ex. 1004, Figure 3 excerpt, color added).

Patent Owner respectfully submits that a POSITA would not equate a *proactive* scenario designed to prevent soot from being created in the first place to a *reactive* scenario that responds to the effects of soot clogging a filter (and yielding higher pressure from reduced flow through the filter). Moreover, Petitioner provides no evidence to suggest that a POSITA would equate these two different scenarios.

For at least this reason, Petitioner has not satisfied its burden in identifying a teaching of the claimed neglect scenario in any of the cited art. Accordingly, Petitioner has no reasonable likelihood of prevailing on the merits and the petition should be summarily dismissed.

3. The Petition Does Not Provide a Sufficient Reason to Allege the Claimed Regeneration and Neglect Scenarios are Obvious

For both the regeneration and neglect claim features, Petitioner summarily

concludes, “Van Niekerk therefor discloses this element by engaging the load bank in the regeneration case as well as in the neglect case, and is obvious. (*EX1003* ¶149-150).” Pet. at 35. Petitioner’s mere statement that the claim feature is obvious is deficient. The two cited paragraphs in Ex. 1003 do not help Petitioner and simply track the Petition’s language with the conclusory statement that the feature “is obvious.” It neither contains specificity nor evidence of obviousness.

For at least this reason, Petitioner has not satisfied its burden in proving obviousness.

B. Grounds 5 and 7: The Egan/Sherman Based Combinations Do Not Render Obvious Independent Claims 1 and 19

1. Neither Egan Nor Sherman Discloses nor Renders Obvious the Claimed “Regeneration” Feature

In a similar fashion to other grounds, Petitioner fails to explain how the Egan and Sherman references disclose the agreed construction of “regeneration,” which is “a process in which an engine doses a particulate filter with diesel fuel then ignites the diesel fuel to burn off accumulated soot.”

Rather, for both the “regeneration” and “neglect” allegations, the following is the entirety of Petitioner’s rationale:

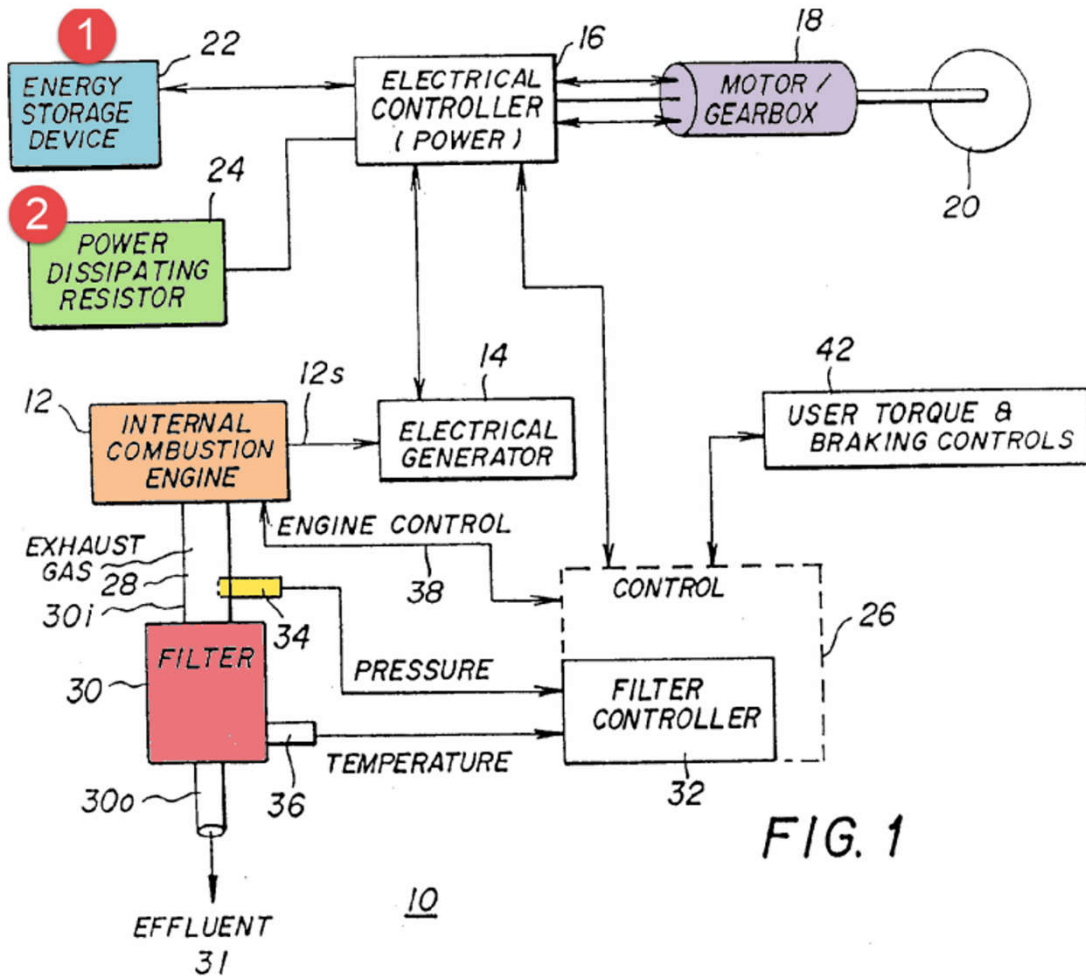
Egan discloses one or more of the heaters of load bank 118 is engaged in a neglect case to address carbon deposits. (*EX1006* ¶[0350].) Sherman discloses the addition of at least a portion of resistor/load bank 24 is applied to increase load to aid in regeneration, and thus discloses

operating the load step contactor in at least one case - regeneration. (EX1010 Col. 1:61-67, 5:19-29, 5:42-49, 7:4-16.), Sherman also discloses adding a portion of resistor/load bank 24 in one case - neglect. (X1010 Col. 4:33-5:17; Figure 2.) Both address soot accumulation. In view of Sherman it would be obvious to try and have the generator controller of Egan be capable of operating a contactor to connect a load bank in both the regeneration and neglect cases. (EX1003 ¶¶247-249.)

(Pet. at 60).

Other than providing a string cite of portions of Sherman, the Petitioner does not explain why such portions of Sherman disclose the claimed “regeneration,” which again is “a process in which an engine doses a particulate filter with diesel fuel then ignites the diesel fuel to burn off accumulated soot.”

Sherman is directed to a process for cleaning a regenerative filter in a hybrid vehicle. With reference to Figure 1 of Sherman, energy is ordinarily provided from engine 12 to motor/gearbox 18. However, “stop-and-go operating regimes,” (Ex. 1010, 3:45-50) can result in intermittent loads on engine 18, which causes clogging in filter 30. Thus, sensor 34 measures a backpressure of filter 30. A higher pressure indicates that filter 30 is clogged. A particular high pressure (e.g., P_2 of Figure 3) triggers the loading of engine 12. *See e.g.*, box 228 of Figure 3.



(Ex. 1010, Fig. 1, color annotations added). To free the clogging, the temperature of the exhaust gas needs to increase. Accordingly, engine 12 can be loaded by supplying generated energy to (1) the hybrid vehicle's energy storage device 22 (e.g., a battery that is charged), and (2) the power dissipating device 24 (resistor that dissipates energy as heat). (Ex. 1010, 5:2-3; see, also, box 232 and 234 of Figure 2).

Nothing in the Petitioner's cited portion for this process in Sherman relates to "a process in which an engine doses a particulate filter with diesel fuel then ignites the diesel fuel to burn off accumulated soot." And Petitioner provides no evidence

that Sherman engages in such a process.

For at least this reason, Petitioner has not satisfied its burden in identifying the claimed regeneration scenario. Accordingly, Petitioner has no reasonable likelihood of prevailing on the merits and the petition should be summarily dismissed.

2. Neither Egan Nor Sherman Discloses nor Renders Obvious the Claimed “Neglect” Feature

Similar to its arguments concerning Van Niekerk, Petitioner ignores the prior proposed construction of neglect (which the Court in the Texas Litigation adopted) and specification to argue that a periodic *cleaning* of a manifold based on a schedule discloses the neglect scenario. It does not.

Egan discloses a power generator for a cellular base station. Egan discloses that the engine has a maximum power of 13.5 kW. Ex. 1010, ¶55; FIG. 2 (below).

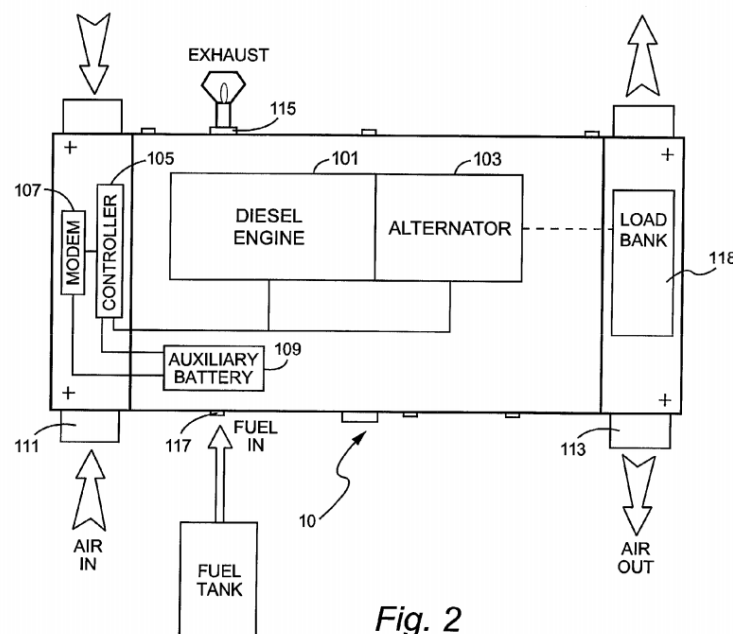


Fig. 2

Egan's substantive description of the functionality of the load bank 118 is set forth in a single paragraph:

As illustrated in FIG. 2, generator **10** includes a load bank **118**. In order to avoid carbon deposits inside the exhaust manifold **115** on the engine in case of continuous no load or almost no load operation, the load bank **118** has been designed to automatically load generator **10** with for example a 5 kW ventilated resistive load for 15 minutes every 3 hours when the output is less than 4 kW. When the requested load is more than 4 kW the load bank is automatically disconnected. Accordingly, load bank **118** may be connected/disconnected to receive an output originating from alternator **103** to impose a load on generator **10**. Load bank **118** may be formed by, for example, one or more heaters, and may be controlled through load bank controls **1056** (FIG. 10). Data related to the automatic loading by load bank **118** may be transmitted to processing system **20**.

(Ex. 1010, ¶350). Thus, Egan teaches (A) loading the generator with a “resistive load for 15 minutes every 3 hours *when* the output is less [than] 4 kW” and also (B) automatically disconnecting the load bank *when* “requested load” on the generator exceeds 4 kW. *Id.* (emphases added). Taken together, these instructions tell the skilled artisan to engage the load bank 118 for 15 minutes immediately upon detection of an underloaded condition, and to disconnect the load bank either when the requested load rises again to 4 kW or when 15 minutes have elapsed. What is not clear is how Egan's system operates after the 15-minute connection of the load

bank during a continuing underloaded condition. In that scenario, the load bank is disconnected at the 15-minute mark, and the system is programmed to reconnect the load bank after another 2.75 hours have elapsed. During those 2.75 hours, if one or more momentary instances occur whereby requested load exceeds 4 kW while the load bank is *already disconnected*, what action does the system take? Does it ignore the program for 15-minutes-of-resistive-load-every-3-hours or does restoration of a 4 kW requested load cause the program to reset? Egan's teachings in this scenario are unclear and incomplete.

What is clear is that Egan does not teach a system that takes action in a "neglect" scenario as that term has been construed by the Texas court, i.e., when generator "load for a preset duration of time drops below a preset level." In deciding whether to add load from the load bank, Egan's system monitors a *single* condition: whether the requested load is below a certain threshold. If so, Egan's system reacts immediately without monitoring the duration of that condition, and as a result, it is not clear how the system should react to intermittent occurrences of underloaded demand during Egan's 3-hour window.

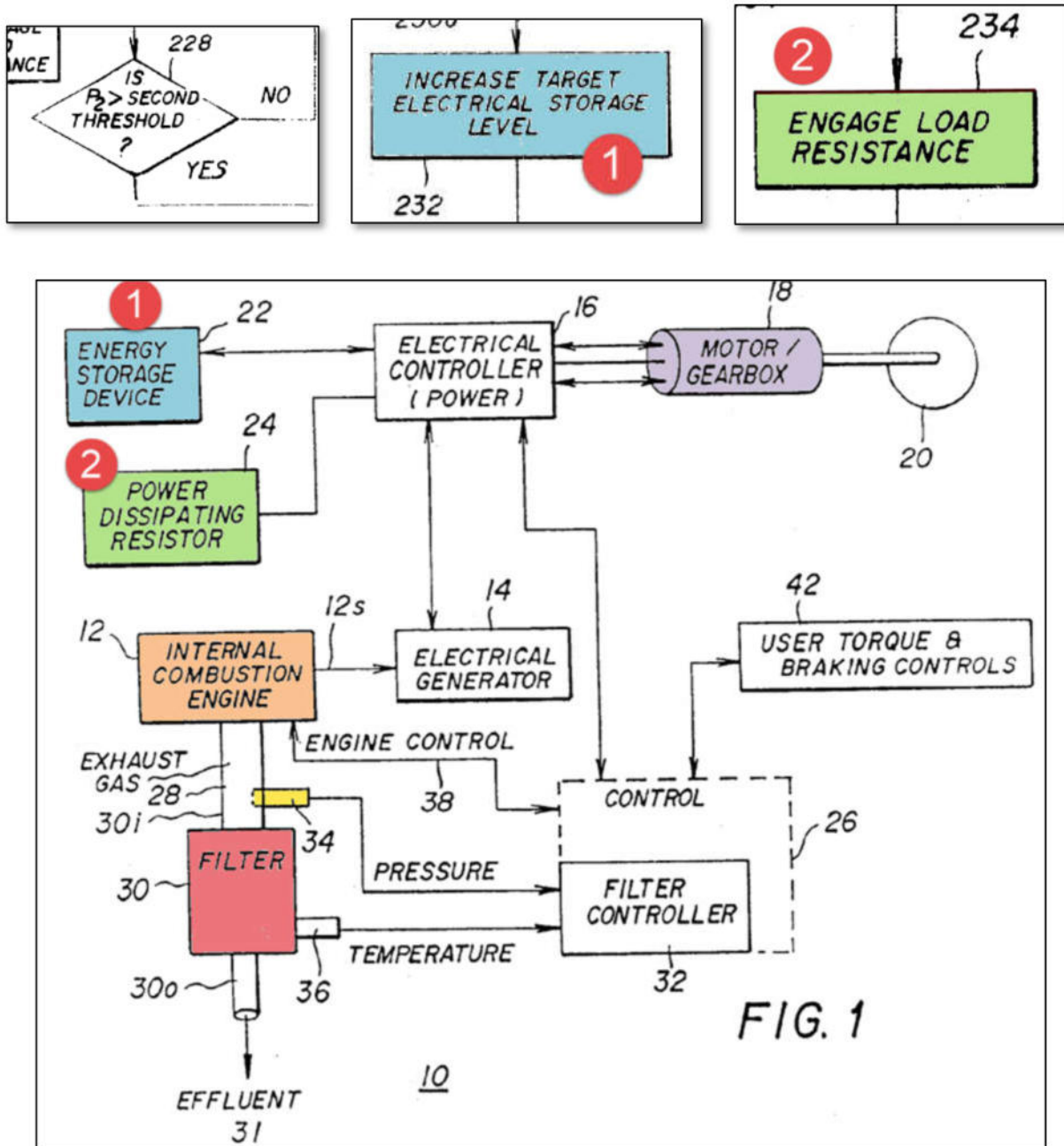
In contrast, no such uncertainty arises in a "neglect" scenario as claimed in the '651 patent, because the "neglect" scenario occurs only when *two* conditions are met: "load (1) *for a preset duration of time* (2) *drops below a preset level.*" As a result, the generator controller of the '651 Patent is immune to low-level loads

having a duration less than the preset duration of time. The generator controller takes action, only when both conditions are met, to add load from the load bank, and later, to disconnect that load “in case of a load spike”. Ex. 1001, claims 1 and 19. Egan, however, by monitoring only a single condition neither teaches nor suggests the “neglect” scenario as claimed.

Further, Petitioner identifies the same 4 kW level in paragraph 350 as simultaneously corresponding to both a “neglect” level and a “spike” level in the claims. As discussed *infra*, the ‘651 Patent specification describes the load bank being engaged with a lower level of “neglect” and disengaged at the higher levels of “load spike.” (Ex. 1001, 2:50-64). Petitioner provides no evidence that a POSITA would interpret both the high and lower levels as being the same. Accordingly, Petitioner’s attempt to equate them is technically inaccurate.

Petitioner alternatively points to Sherman to disclose the claimed neglect scenario. However, Petitioner does not explain how its cited column of text in Sherman discloses the claimed “neglect.” The petitioner cited Column 4:33-5:17, which discusses a response to the backpressure of a filter exceeding a threshold level and the corresponding response to increasing the exhaust gas temperature for cleaning the filter. More particularly, as discussed *infra*, when a pressure (e.g., P_2) increases beyond a level, engine 12 can be loaded by supplying generated energy to (1) the hybrid vehicle’s energy storage device 22 (e.g., a battery that is charged), and

(2) the power dissipating device 24 (resistor that dissipates energy as heat). (Ex. 1010, 5:2-3; see, also, boxes 228, 232 and 234 of Figure 2).



(Ex. 1010, Fig. 1, color annotations added).

Just like Van Niekerk's disclosure, Sherman's process here is reactive in

nature and does not teach or suggest the *preventive* neglect case.

For at least this reason, Petitioner has not satisfied its burden in identifying the claimed neglect scenario. Accordingly, Petitioner has no reasonable likelihood of prevailing on the merits and the petition should be summarily dismissed.

3. Neither Egan Nor Sherman Disclose or Render Obvious the Claimed Load Spike

In alleging the Egan/Sherman combination discloses the claimed feature surrounding load spike, the Petitioner contends:

Egan discloses that the entire load bank 20 is disconnected in the event a load spike is detected. When the requested load (actual load) is more than 4 kW load bank 20 is automatically disconnected. (EX1006 ¶[0350].) Sherman discloses the circuitry by which controller 26 controls the operation of switches of power controller 16 to deactivate resistor/load bank 24. (EX1010 Col. 2:57-3:6, 5:1-18; Figure 2.) In view of Sherman it would be obvious to utilize the generator controller of Egan to issue signals to disconnect the load bank in the event of a load spike, in order to prevent overload damage. (EX1003 ¶250-251.)

(Pet. at 61). While Petitioner did not allege that the term “load spike” needed to be construed in the Texas Action, the Court in construing the term “neglect,” specifically identified the specification’s use of a lower threshold, which corresponded to “neglect.”

The generator controller, via the load bank controller, monitors

the load connected to the generator to ensure that the load is within a “window” or “load window” bounded by pre-set *lower* and *upper load levels*. If the load connected to the generator remains at or below some pre-set load condition—i.e., below the window—for a pre-set duration, the generator controller signals the load bank controller to initiate the load bank. The load bank controller then increases or decreases the total resistance of the load bank by connecting or disconnecting load step resistors as necessary to maintain the load within window. If the load rises above the window, the steps of the load bank are disconnected as necessary.

(Ex. 2001 at 18, quoting ‘651 Patent at 2:54-3:9, emphasis added). The same recitation also provides an upper load level that corresponds to the “load spike.” (Ex. 1001, 2:36-40, 3:64-4:5).

Here, without rendering a specific construction of the term “load spike,” the Board can quickly reject Petitioner’s argument. Petitioner already identified the same 4 kW level of Egan as corresponding to the lower level for neglect. Petitioner provides no evidence that a POSITA would consider both the lower threshold and the higher threshold the same level for satisfying both the “neglect” and “load spike” levels. In fact, the same level cannot satisfy both the “neglect” and “load spike” levels. The neglect level causes the load bank to be engaged. The load spike level causes the load bank to be disengaged. According to Petitioner, reaching the same

level would simultaneously engage and disengage the load bank. That is an inoperative system that would serve no purpose. Adopting a construction that contravenes the teaching of the specification and the claims is incorrect.

4. The Petition Does Not Provide a Sufficient Reason to Allege the Claimed Regeneration, Neglect, and Load Spike Features are Obvious over Sherman and Egan

For both the regeneration and neglect claim features, Petitioner summarily concludes:

Both address soot accumulation. In view of Sherman it would be obvious to try and have the generator controller of Egan be capable of operating a contactor to connect a load bank in both the regeneration and neglect cases. (EX1003 ¶¶247-249.).

Pet. at 60. For both the load spike claim features, Petitioner summarily concludes:

It would be obvious in view of Sherman for the generator controller of Egan to be capable of operating a contactor to connect a portion of the load bank in a selected case and complete the feed-back as part of monitoring and control. (EX1003 ¶¶246.)

Pet. at 60. Additionally, Petitioner provides a general section discussing alleged reasons to combine Egan and Sharman, such as (1) “similar structures,” (2) predictable operation, (3) and a simple substitution of elements. These reasons are insufficient and fail to consider the references as a whole.

Sherman’s disclosure is focused on increasing the exhaust temperature in a

hybrid vehicle engine to facilitate cleaning of soot in a filter, for example, due to “stop-and-go” traffic scenarios that place the engine under light load conditions. In sharp contrast, Egan is directed to an engine that is used at a base station of a cell tower that undergoes periodic artificial loading of the engine when it is not used. Sherman’s triggering condition for loading is increased pressure at a filter; however, Egan discloses no filter. Other than conclusory reasons (which can be used with nearly any combination of references), Petitioner provides no evidence why a skilled artisan would be interested in taking Sherman’s more complex engine loading design, which includes loading due to a battery charging and resistive loading (and, also considering return energy from regenerative braking) to supplant Egan’s simple logic of periodically loading the engine. Egan’s stationary design does not encounter the same problems presented by Sherman’s mobile vehicle (e.g., stop-and-go traffic, regenerative braking, and the need to charge a battery).

For at least this reason, Petitioner has not satisfied its burden in identifying the claimed neglect scenario. Accordingly, Petitioner has no reasonable likelihood of prevailing on the merits and the petition should be summarily dismissed.

C. Grounds 2 and 4 Recite Feature from Dependent Claims and Fail Because Grounds 1 and 3 Fail

Petitioner’s Grounds 2 and 4 recite features from dependent claims and are dependent upon Grounds 1 and 3. Because the Petitioner fails to meet its burden for

Grounds 1 and 3, Grounds 2 and 4 also fail. Patent Owner reserves the right to address these grounds further if this proceeding is instituted.

D. Grounds 6 and 8 Recite Feature from Dependent Claims and Fail Because Grounds 5 and 7 Fail

Petitioner's Grounds 6 and 8 recite features from dependent claims and are dependent upon Grounds 5 and 7. Because the Petitioner fails to meet its burden for Grounds 5 and 7, Grounds 6 and 8 also fail. Patent Owner reserves the right to address these grounds further if this proceeding is instituted.

X. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Petition be denied in its entirety.⁴

Date: February 23, 2024

Respectfully submitted,

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⁴ Patent Owner does not concede, and specifically denies, that there is any legitimacy to any arguments in the Petition that are not specifically addressed herein.

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Preliminary Response to Petition complies with the type-volume limitation of 37 C.F.R. § 42.24(b)(1) because it contains fewer than the limit of 14,000 words, as determined by the word-processing program used to prepare the brief, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1).

Date: February 23, 2024

By: /Sean D. Burdick /
Sean D. Burdick, Reg. No. 51,513
Attorney for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that an electronic copy of the preceding Patent Owner Preliminary Response was served, along with any accompanying exhibits filed via the PTAB E2E system, to Petitioner's counsel at the following addresses identified in the Petition's consent to electronic service:

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