
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROLIME AGRICULTURAL, LLC and
CAUDILL SEED AND WAREHOUSE CO., INC.
Petitioners

v.

SUL4R-PLUS, LLC
Patent Owner.

Inter Partes Review No. IPR2024-00236
Patent No. 9,873,638

**PETITIONERS' REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

In Patent Owner Sulr4-Plus, LLC's ("Sul4r") Preliminary Response, it asks the Board to deny institution of this IPR based on the status of co-pending district court litigation ("the Michigan case") concerning the same patent. Specifically, Sul4r devotes a significant portion of its POPR to application of the six-factor analysis set forth in *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). [POPR at 38-43.] Petitioners are submitting this Reply to address three of the *Fintiv* factors.

First, with respect to Fator 4, Petitioner Prolime Agricultural LLC ("Prolime"), sole defendant in the Michigan case, is submitting with this Reply a stipulation that if this IPR is instituted, it will not raise in the Michigan case any ground that it raised or reasonably could have been raised during this IPR pursuant to the Board's decision in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020). [Exhibit 1019.] Prolime is prepared to file the same stipulation on the Court's docket in the Michigan case if this IPR is instituted. Under the Interim Procedures for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation of June 21, 2022, the Board will not discretionarily deny institution of an IPR in view of co-pending litigation when such a stipulation is made by the Petitioner. *See also, e.g., BMW of North America LLC v. Northstar Systems LLC*, IPR2023-01017, Paper 12 (PTAB

Dec. 8, 2023) (considering *Sotera* stipulation filed with Petitioner’s preliminary reply and granting institution of IPR).

In addition, on April 8, 2024, the District Court for the Eastern District of Michigan issued a Scheduling Order in the Michigan case. The Scheduling Order is being filed with this Reply as Exhibit 1020 and bears on Factors 2 and 3. In short, there is nothing about the status of the Michigan case that indicates discretionary denial is warranted here.

Factor 2 is: the proximity of the court’s trial date to the expected date of any final written decision. The projected statutory deadline for the final written decision in this case is the end of June 2025. While the District Court has not yet set a trial date, pretrial materials (motions in limine, witness lists, and a joint final pretrial order) are not due until August 1, 2025. [Ex. 1020.] Trial will begin sometime after that date, following at least a few months behind the final written decision. Under these circumstances Factor 2 is neutral, and Factor 3 is implicated. *See Fintiv*, Paper 11 at 9.

Factor 3 is: investment in the parallel proceeding by the court and parties. Here the concern is whether the District Court in the parallel proceeding has issued any substantive orders related to the patent at issue. *Id.* at 9-10. “If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weights against [institution].” *Id.* That is the case here

and Factor 3 weighs against discretionary denial of this petition for IPR. Sul4r does not even address this point in its discussion of Factor 3. [POPR at 40-41.] The parties decided to forego claim construction in the Michigan case, so no claim construction orders will be issued by the Court. Dispositive motions are not due until January 24, 2025 and any order on a dispositive motion will not issue until the statutory deadline for the final written in this case is approaching or has passed. [Ex. 1020.]

Instead of addressing the lack of any substantive orders by the District Court in the Michigan case, Sul4r argues that resources for expert discovery and dispositive and Daubert briefing will be expended prior to the institution decision in this case. [POPR at 41.] That is not correct. As noted above, dispositive motions are not due in the Michigan case nine months from now, in January 2025. [Ex. 1020.] Likewise initial expert reports are not due until October 18, 2024. [*Id.*] If this IPR is instituted, it will be well underway by the time significant resources are expended for expert discovery and dispositive motions in the Michigan case.

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Dated: April 19, 2024

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.105, I hereby certify that a true and correct copy of the foregoing Petitioners' Reply to Patent Owner's Preliminary Response was served on counsel of record by filing this document through P-TACTS and via email to the following addresses:

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