

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL APPEAL BOARD

CEVA SANTÉ ANIMALE S.A.,
EGG-CHICK AUTOMATED TECHNOLOGIES S.A.S, and
CEVA ANIMAL HEALTH, LLC
Petitioners,

v.

TARGAN, INC.,
Patent Owner.

Case IPR2024-00595
U.S. Patent No. 10,806,124

PATENT OWNER PRELIMINARY RESPONSE

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TABLE OF EXHIBITS

Ex	Description
1001	U.S. Patent No. 10,806,124 to Karimpour (the ‘124 Patent)
1002	Prosecution History of Application No. 15/775,706, resulting in U.S. Patent No. 10,806,124 (“File Wrapper”)
1003	Gershman, Yakov, “A simple way to determine the sex of one-day poultry chickens (Basic Principles),” May 2014. Available online at https://vixra.org/abs/1405.0016 . (“Gershman”)
1004	FR Patent Publication No. 2909836 to Pierre et al., with Certified English Translation (“Pierre”)
1005	U.S. Patent Publication No. 2001/0035370 to Yavnai et al. (“Yavnai”)
1006	U.S. Patent No. 6,396,938 to Tao et al. (“Tao”)
1007	U.S. Patent No. 3,994,292 to Goodwin (“Goodwin”)

I. Introduction

The Petition seeks to have this Board second guess the Examiner and reconsider references and arguments already considered and rejected. Such Petitions are unwarranted, waste the Board's time and resources, and may (and should) be discretionarily denied under 35 U.S.C. § 325(d).

In the original prosecution, the Examiner discussed each of the primary references upon which Petitioner relies for Grounds 1, 2, 4, 6, 7 and 8. Petitioner also cites the Pierre reference, but its teachings are merely cumulative of the references considered by the Examiner and discussed below. Pierre does nothing to cure the shortcomings of these previously considered references. Discretionary denial under § 325(d) is appropriate.

For Grounds 3 and 5, Petitioner relies on the Goodwin reference. However, while Goodwin was not relied upon for a specific rejection, it was of record and considered by the Examiner, including specific citations to the same portions relied upon in the Petition. Discretionary denial is thus appropriate for Grounds 3 and 5 as well.

Should the Board decline to exercise its discretion on Grounds 3 and 5, the Board should deny institution because the Petitioner has failed to demonstrate a reasonable likelihood that any claims of the 124 Patent are unpatentable. Goodwin

is a *manual* chick sexing system where persons are stationed to remove the chick from a trough and determine the sex through visual examination. Petitioner has provided no evidence that a skilled artisan would have any motivation to combine the layout of a manual sexing station—which is laid to permit persons to examine the chicks—with an automated system, nor that one would have any reasonable expectation of success.

While the Petition fails on the merits for numerous reasons, this Response primarily urges the Board to exercise its discretion and deny institution under 35 U.S.C. § 325(d). The deficiencies of the cited prior art are many, but the reality is that the Examiner already considered the core references for the elements purportedly disclosed and determined that the teachings proposed in the Petition are not disclosed, and that the 124 Patent claims are patentable. This is precisely the type of Petition for which the Board should exercise its discretion to deny institution.¹

¹ To streamline the issues for the Board, and because the overlap between the Petition and the prior art and arguments considered during prosecution is so significant, this Patent Owner Preliminary Response is directed solely to discretionary denial under § 325(d), except with respect to Grounds 3 and 5 as discussed above. Should the Board decide to institute the proceeding, Patent Owner reserves the right to provide substantive arguments and evidence (including expert testimony) on the merits to refute the contentions in the Petition.

II. Background

The invention disclosed in U.S. Patent No. 10,806,124 (“the 124 Patent”) is directed to a system for automatically determining the sex, health, and/or other characteristic of a chick *without manual intervention*. Utilizing a series of moving platforms for supporting an unrestrained chick (examples below), the system provides conditions to capture a suitable digital image of the chick for comparison to a database of images of, for example, male and female wing patterns (for determining sex), healthy and unhealthy chicks (for determining health), and/or images of some other predetermined feature of a chick.

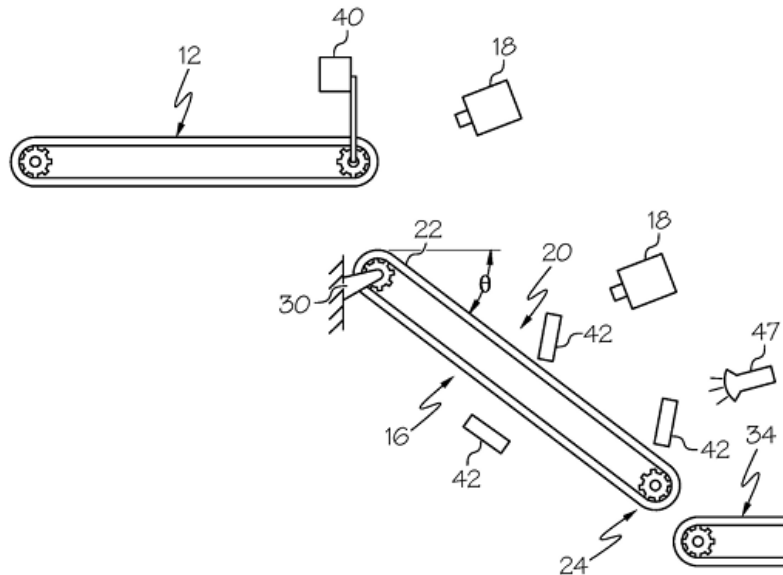


FIG. 8

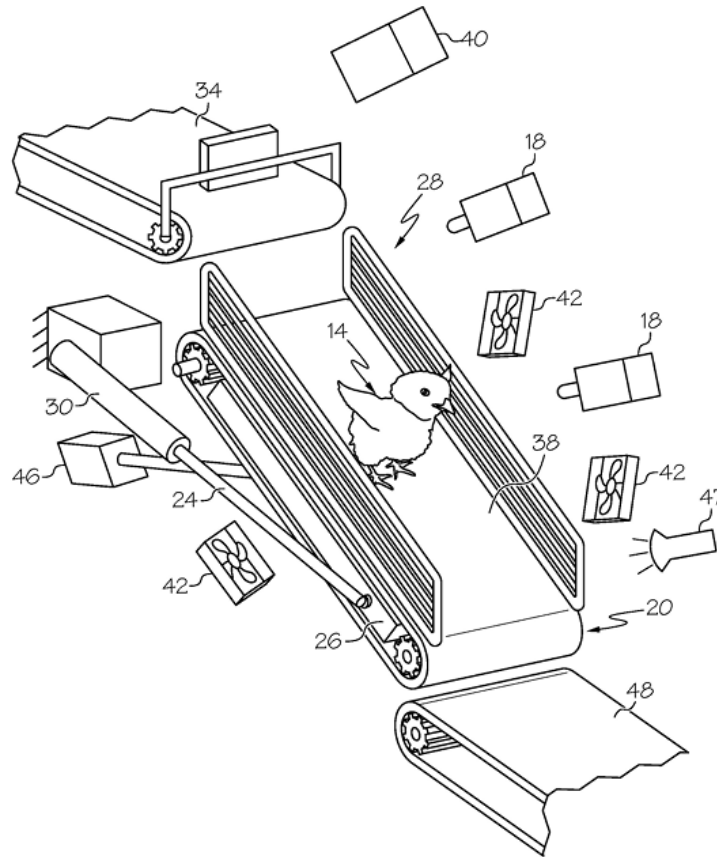


FIG. 6

In allowing the claims of the 124 Patent, the Examiner noted that the closest prior art references, namely Ex. 1003 (“Gershman”), Ex. 1005 (“Yavnai”), and Ex. 1006 (“Tao”), “do not disclose [among other things] a moving platform to support an unrestrained chick of a particular breed.” Ex. 1002, File Wrapper at 129-30. The Examiner also confirmed, by initialing the IDS, that he “considered” the Goodwin reference (Ex. 1007). *Id.* at 2. And not only was Goodwin considered, but the IDS identified the specific “relevant passage” for the Examiner—the same passage (and

associated Figures 1 & 2) relied upon by the Petition. *Id.* (citing Goodwin col. 2:18-46, discussing Figs. 1 & 2).

Petitioner asserts eight different grounds of unpatentability of the 124 Patent, but each ground relies principally on the prior art above that was already considered (and dismissed) by the Examiner: Gershman, Yavnai, Goodwin, and Tao. Indeed, *none* of the grounds demonstrate a reasonable likelihood that the 124 Patent is invalid.

III. The Board should exercise its discretion under 325(d) and deny institution.

Institution of an *inter partes* review is discretionary. *See Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (explaining that because 35 U.S.C. § 314 includes no mandate to institute review, “the agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (stating that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”). In determining whether to institute review, “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).

The Board employs a two-part framework for exercising discretion under § 325(d): (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 first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics, LLC v. Med-El Electromedizinische Geräte GmbH* (“*Advanced Bionics*”), IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential). Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Id.* at 7–8.

“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.* at 8–9. “This framework ‘reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.’” *Id.* at 9.

The Board in *Becton, Dickinson* set forth the following non-exhaustive list of factors in considering the § 325(d) framework:

- 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 (P.T.A.B. Dec. 15, 2017) (“*Becton, Dickinson*”). Factors (a), (b), and (d) relate to the first part of the *Advanced Bionics* framework (*i.e.*, whether the art presented in the Petition are the same or substantially the same as that previously presented to the Office), and factors (c), (e), and (f) relate to the second part (*i.e.*, “whether the petitioner has demonstrated a material error by the Office” in its prior consideration of the prior art or arguments).

Discretionary denial is appropriate here because Petitioner’s asserted art and arguments have already been considered and overcome during examination. Each of the eight asserted grounds rely on one or more of Gershman, Yavnai, Goodwin, and Tao—all of which were of record *and considered and relied upon during prosecution for the exact same teachings relied upon now*. And the addition of Pierre does nothing to cure the shortcomings of these previously considered

references. Indeed, Pierre lacks any teaching of, and is not relied upon for, “the moving platform to support an unrestrained chick” element for which the previous references are (again) cited. Each of the eight grounds in the Petition rely on the same four references for claim elements admittedly absent from Pierre, making discretionary denial appropriate.

A. Part One: Factors (a), (b), and (d) demonstrate that the cited prior art has been previously considered or is cumulative.

There can be no dispute about Part One. The Petition concedes—as it must—that there is “overlap between the prior art of record during examination and the prior art presented in the Petition.” Petition at 66.

Gershman, Yavnai, Goodwin, and Tao were each considered during prosecution. In fact, the Examiner relied explicitly on each of Tao, Yavnai, and Gershman for specific rejections, and the Patent Owner responded with arguments regarding these references, before the claims reached their final form. *See, e.g.*, Ex. 1002, File Wrapper at 217-28 (Office Action discussing each of the references). Moreover, while Goodwin was not relied upon for a specific rejection, it was of record and considered by the Examiner, *including specific citations to the same portions relied upon in the Petition*. *See id.* at 2 (IDS, citing “col. 2, lines 18-46,” with Examiner initialing Goodwin to confirm the “reference considered”). Part 1 of *Advanced Bionics* is therefore satisfied. *See, e.g., Biocon Pharma Ltd. v. Novartis*

Pharms. Corp., IPR2020-01263, Paper 12 at 9 (P.T.A.B. Feb. 16, 2021) (determining that the first part of the *Advanced Bionics* framework is satisfied when certain prior art was listed on an IDS and the Examiner signed the IDS with the statement “all references considered except where lined through”).

Appropriately, the Petition does not attempt to argue for purposes of the § 325 analysis that the new reference Pierre somehow presents novel considerations not considered by the Office. *See* Petition at 66-68 (discussing Part One factors (a), (b), and (d), and arguing only that “new” arguments relating to previously considered Gershman and Yavnai should be considered, not anything related to Pierre). Instead, the Petition asserts that elements admittedly absent from Pierre—*e.g.*, the “moving platform to support an unrestrained chick” element—are nevertheless disclosed in previously considered references. Petition at 66-67; 69. But once it is established that the Office considered the references at issue, the “same or substantially the same argument” prong of Part One need not be reached, and Part One is satisfied. *See, e.g., Adt LLC v. Vivint, Inc.*, IPR2022-00612, 2022 WL 3588570, at *10 (P.T.A.B. Aug. 22, 2022) (holding that factor (d)—extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art—need not be reached once it has been established that the “same or substantially the same prior art” was presented to the Office).

Petitioner only addresses Pierre in its § 325(d) analysis at the very end under factor (f): “new prior art [] Pierre [teaches] chick sex identification involving taking images of unrestrained chicks placed in a falling position.” Petition at 69 (citing combination with Goodwin in Ground 3). To that end, Ground 3 relies on Pierre for the unremarkable teaching of “causing a chick to fall so that the chick naturally deploys its wings” and “a camera to capture digital images.” Petition at 31 (Ground 3, independent claim 1, citing Pierre at 3 and claims 3 & 4); *see also, e.g., id.* at 37 (Ground 4, claim 1 (same)); *id.* at 40 (Ground 4, claim 6 (same)).

But these teachings are entirely cumulative to the prior art of record during prosecution. For example, Gershman teaches causing a chick to fall so that the chick naturally deploys its wings. *E.g.*, Petition at 22 (citing Gersham at 6). Likewise, Gershman, Yavnai, and Tao each teach use of a camera to capture digital images of a chick. *E.g.*, Petition at 23 (citing Gershman at 2); Petition at 27 (citing Yavnai at ¶ 38); Petition at 42 (citing Tao at col 5:36-38 & Fig. 1).

But the Petition does not (and cannot) contend that Pierre teaches the “moving platform to support an unrestrained chick” element—relying instead on a combination with the previously considered Goodwin and other known references, the deficiencies of which were before the Office, considered, and rejected, as discussed further below.

For these reasons, Part One of the *Advanced Bionics* framework is satisfied.

B. Part 2: Factors (c), (e), and (f) – Petitioner has failed to demonstrate that the Office erred in a manner material to patentability.

Petitioner has fallen short of its burden to show the Office erred in a manner material to patentability. *Advanced Bionics*, Paper 6 at 8; *Adt LLC*, 2022 WL 3588570, at *10 (“Petitioner must demonstrate that the examiner erred in the evaluation of the prior art”). “An example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Advanced Bionics*, Paper 6 at 8 n.9. But “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.” *Id.* at 9.

Where, as here, the same or substantially overlapping disclosures were before the Patent Office, it is incumbent on the Petitioner to offer a particularized explanation of how the Office erred. *See, e.g., Roku, Inc. v. Universal Elecs., Inc.*, IPR2019-01619, 2021 WL 2123912, at *5 (P.T.A.B. May 25, 2021) (denying institution where Petitioner “did not explain adequately why the Examiner’s treatment of [the prior art] was an error material to the patentability of claim 1”). The Petition fails to explain how the Examiner erred, and denial is therefore appropriate. *See, e.g., Nespresso USA, Inc. v. K-Fee Sys. GmbH*, No. IPR2021-

01222, 2022 WL 212376, at *10 (P.T.A.B. Jan. 18, 2022) (exercising discretion under 325(d) where Petition failed to explain how Examiner erred).

At bottom, the eight different Grounds of the Petition combine prior art references previously considered by the Examiner with the new Pierre reference. But in every ground, the same art previously considered and rejected by the Examiner, rather than Pierre or some other new reference, is relied upon for claim elements found to be allowable over the previously considered art and admittedly absent from Pierre. The Petitioner has not demonstrated how the Examiner materially erred, and therefore the Board should exercise discretion to deny institution. *Id.*

1. Grounds 1, 4, 6, and 7: Gershman does not disclose “a moving platform to support an unrestrained chick.”

The Petition contends that Gershman teaches “a moving platform to support an unrestrained chick.” Petition at 68-69 (factor (e)); *see also id.* at 21-22 (Ground 1, independent claim 1); *id.* at 36 (Ground 4, independent claim 1); *id.* at 39 (Ground 4, independent claim 6);² and *id.* at 46-47 (Ground 7, independent claim 9). For each of these grounds, the Petition relies on Gershman alone for the moving platform to support an unrestrained chick element.

² Ground 6 is directed only to claim 8, which depends from independent claim 6, relying on Ground 4’s discussion of Gershman and independent claim 6. In view of this reliance, Ground 6 therefore rises and falls with Ground 4.

But the Examiner’s Notice of Allowability speaks directly to this issue: Gershman does ***not*** “disclose, teach or suggest, a moving platform to support an unrestrained chick.” Ex. 1002, File Wrapper at 129-30 (stating same for each of the allowed independent claims 1, 6, and 9).³ This alone demonstrates that the Examiner considered—and rejected—the notion that Gershman teaches the “moving platform to support an unrestrained chick” limitation of independent claims 1, 6, and 9. *See, e.g., Adt LLC*, 2022 WL 3588570, at *10 (rejecting similar argument by a Petitioner where the Notice of Allowance stated the prior art of record “fails to describe and/or suggest” the element allegedly disclosed).

More importantly, the Petition fails to identify how the Examiner erred in the evaluation of Gershman. First, under factor (c), the Petition complains that “the chick moving structures of Gershman were not discussed in the office actions or amendments.” Petition at 66. But although this factor considers the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection, “the lack of a rejection itself is not dispositive of whether there was material error.” *Microsoft Corp. v. Throughputer, Inc.*, IPR2022-00757,

³ Independent claim 6 recites the element in a slightly different way—“a moving platform upon which an unrestrained chick is supported”—but as the Examiner confirms, the meaning and scope of the claim element is the same. File Wrapper at 129-30.

2022 WL 16625414, at *8 (P.T.A.B. Nov. 1, 2022) (citing *Becton, Dickinson*, Paper 8 at 17).

Instead, the Petition contends, in conclusory, unsupported fashion, that “Gershman in fact clearly does disclose a moving platform to support an unrestrained chick.” Petition at 68 (citing only Gershman’s Fig. 3, copied below). But that image, pasted repeatedly throughout the Petition for support, was in front of the Examiner during examination, yet the Examiner allowed the claim and found no teaching of “a moving platform to support an unrestrained chick.” File Wrapper at 129. The Petition proffers no other argument or evidence beyond attorney argument and the image. There is therefore no need for the Board to second guess the Examiner’s conclusion. *See, e.g., Advanced Bionics*, Paper 6 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.”).



Gershman Fig. 3

The Examiner's conclusion is not surprising. Under a complete reading, the claims require "a moving platform *to support* an unrestrained chick." But the only time the plate "supports" a chick in Gershman is when the plate is *stationary*. See Gershman, Fig. 3 (above). When the plate is moved downwardly to cause the chick to free fall, the plate no longer supports the chick as the chick's feet no longer touch the plate. See, e.g., Gershman at 3 (teaching downward movement of the plate such that "legs should lose support faster than they can move down").

Accordingly, Gershman has either a vertically dropping plate to cause a free fall (*i.e.*, no support), or a *stationary* plate to support the chick—but not both. Thus, Gershman does not teach or suggest "a moving platform *to support* an unrestrained chick of a particular breed," as required by claims 1, 6 and 9.

Institution of at least Grounds 1, 4, 6, and 7 should be discretionally denied. See *Nespresso*, 2022 WL 212376, at *10 (exercising discretion to deny institution and holding that "this is a case where reasonable minds can differ, and the paucity of analysis provided by Petitioner in the Petition tips the scales in favor of a discretionary denial.").

2. Grounds 2 & 8: Yavnai does not teach "a moving platform to support an unrestrained chick."

The Petition next contends that Yavnai teaches "a moving platform to support an unrestrained chick." Petition at 67-69; see also *id.* at 25-27 (Ground 2,

independent claim 1); *id.* at 57-58 (Ground 8, independent claim 9). But Yavnai's shortcomings with respect to this claim element were also specifically argued during examination, and the Examiner accepted Patent Owner's arguments. File Wrapper at 129 (Notice of Allowance: "Yavnai does **not** "disclose, teach or suggest, a moving platform to support an unrestrained chick of a particular breed."); *see also id.* at 196 (Patent Owner's arguments, discussed *infra*). There is no reason to disturb the Examiner's reasoned conclusion.

Contrary to Petitioner's argument, Yavnai's system is specifically designed to restrain a chick, and Patent Owner highlighted this point during prosecution. Patent Owner explained that Yavnai "teaches restraining a chick through the use of poles 64 or cups 40 to restrain the chick in order to cause the chick to open its wings." File Wrapper at 196. As illustrated in Yavnai at Figs. 5A and 5B (reproduced below), "poles 64 support the spread wings while light 46 shines on the wing tips of chick 10 and camera 48 photographs the wings tips of chick 10." Yavnai ¶ 0042.

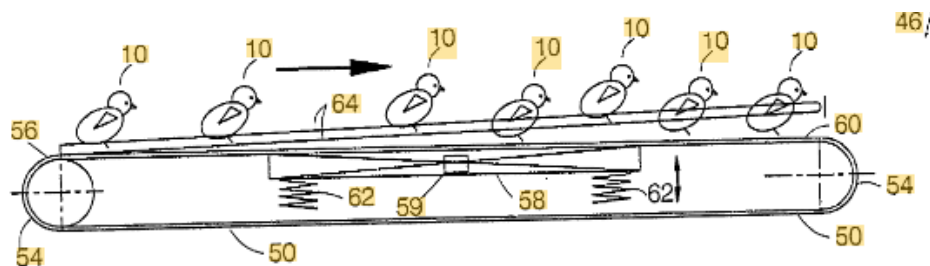
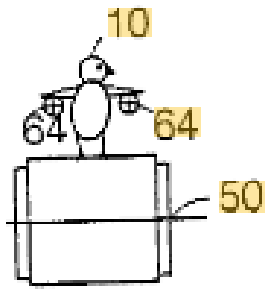


FIGURE 5A



Patent Owner presented the argument to demonstrate, among other things, both how Yavnai discloses restraining a chick (in contradiction to the claim), and “teaches away” from use of “a moving platform to support an unrestrained chick,” thereby defeating the obviousness rejection. *See id.* at 195 (citing *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1326 (Fed. Cir. 2009) (holding that obviousness may be defeated if the prior art indicates that the invention would not have worked for its intended purpose)). Indeed, as argued to the Examiner, a “reference teaches away ‘when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken’ in the claim.” *Id.* (citing *Galderma Labs, L.P. v. Tolmar, Inc.*, 737 F.3d 731, 738 (Fed. Cir. 2013)). Here, Yavnai requires poles 64 to “support the spread wings” while the wings are photographed. Yavnai at ¶ 0042. The Examiner properly considered this argument and concluded (appropriately) that Yavnai does not teach or suggest “a moving platform to support an unrestrained chick.” File Wrapper at 129.

The Petition acknowledges, as it must, that this argument was both presented and accepted. Petition at 67. Nevertheless, Petitioner now asks this Board to rule that Yavnai was considered “incorrectly” by the Examiner. Petition at 66. The Petition argues that the poles 64 do not “restrain the chick, especially its wings,” on “*part* of the conveyor,” and therefore Yavnai must disclose the “moving platform to support an unrestrained chick element.” Petition at 68. But the Petitioner offers no new evidence, such as an expert opinion or other facts, to support such a reading of Yavnai, despite the Petitioner’s burden to do so. *Adt LLC*, 2022 WL 3588570, at *10; *Nespresso*, 2022 WL 212376, at *11. Indeed, Figure 5A of Yavnai shows the bottom portion of at least the chick between the poles throughout the conveyor and Petitioner offers nothing but attorney argument that the chicks are unrestrained at that point.

The Board should not second guess the Examiner’s conclusion that Yavnai does not “disclose, teach or suggest, a moving platform to support an unrestrained chick.” File Wrapper at 129. The Board should therefore exercise its discretion to decline institution of Grounds 2 and 8 relying on Yavnai. *See Nespresso*, 2022 WL 212376, at *10.

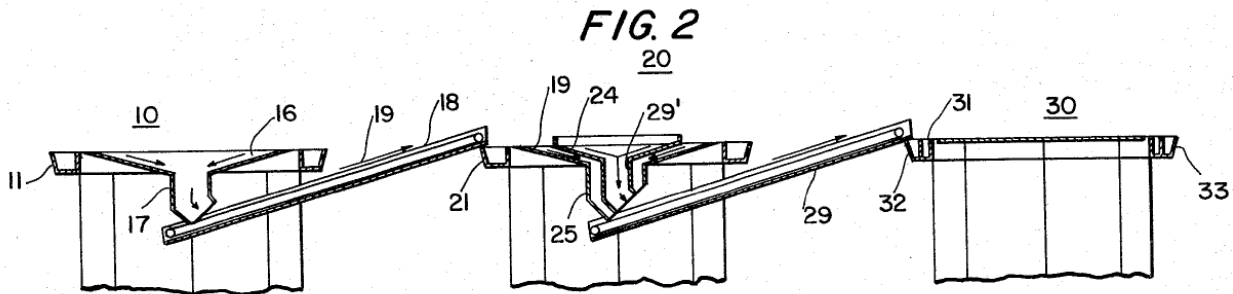
3. Grounds 3 & 5: The *automated* sexing system of Pierre is incompatible with the *manual* system disclosed in Goodwin.

Once again, it is the Petitioner’s burden to “demonstrate that the examiner erred in the evaluation of the prior art.” *Adt LLC*, 2022 WL 3588570, at *10; *Nespresso*, 2022 WL 212376, at *11. Despite this burden, the Petition’s discussion of factors (e) and (f) offer nothing more than conclusory allegations; for example, that Goodwin “clearly” shows “angled conveyors with no discussion of chick restraints delivering chicks to a chick gender identification area.” Petition at 69. No “additional evidence or facts” are presented to demonstrate any material error by the Examiner, as required. *Advanced Bionics*, at 8.

Further complicating the Petitioner’s position, Goodwin was of record and considered by the Examiner. File Wrapper at 2 (signed and initialed by Examiner, indicating “reference considered”). And not only did the Patent Owner identify Goodwin for the Examiner in the IDS, but Patent Owner identified the exact paragraph in Goodwin relied upon by Petitioner now. *Id.* (IDS identifying “Col. 2, lines 18-46” as having “relevant passages”—initialed by Examiner).

The Examiner’s decision not to cite Goodwin was not an error, but a proper determination that Goodwin is incompatible with the claimed invention. Referring to Ground 3, the only significant discussion of Goodwin, Petitioner contends Goodwin teaches a conveyor that “drops” chicks into a sexing station 20. Petition at

30 (citing Goodwin Fig. 2, element 18 – excerpted below).⁴ According to the Petition, it would have been obvious to replace the chick sexing station 20 of Goodwin with the automated system of Pierre. *Id.*



But the chick sexing station 20 of Goodwin is a **manual** chick sexing system. *E.g.*, Col 2, lines 22-29 (“A sexing **operator** removes a chick from trough 21, determines the sex of the chick and, depending on the sex of the chick, drops it into either conical trough 23 . . . or nested conical trough 24”). As the 124 Patent explains, manual sexing methods “are considered to be unfriendly to chicks based on the manual handling of the chicks, and increase the seven-day mortality of sexed chicks.” 124 Patent, col. 2:10-12; *accord* col. 2:16-20 (“increases chick’s chances for disease and injury”; “likely to cause repetitive injuries to the workers over time”). A person of ordinary skill in the art (“POSA”) seeking to avoid the many problems

⁴ This same argument is incorporated by reference and relied upon to support Petitioner’s challenge in Ground 5 to claim 2 (which depends from claim 1). Petition at 42. Ground 5 thus rises and falls with Ground 3.

associated with manual sexing techniques would **not** have looked to a manual sexing system like Goodwin to fill the gaps in Pierre. *See, e.g., Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1069 (Fed. Cir. 2018) (“[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.”). Indeed, the Petitioner provides no facts or evidence to support such a combination, despite having the burden to do so.

More fundamentally, there is no discussion in Goodwin that the chicks experience a free fall or any other stimulus to cause the chicks to open its wings. In fact, there is no discussion in Goodwin whatsoever of the chick opening its wings, other than forcibly through the undesirable manual inspection methods the 124 Patent seeks to avoid.

Instead, Goodwin teaches only that chicks “drop off” into the “rotary annular conveyor trough 21.” Petition at 30 (citing Goodwin Fig. 2, and col 2:13-20). The Petitioner has cited no teaching in Goodwin or other evidence that a drop into this trough would facilitate the chick opening its wings. *See* Goodwin, Fig. 2. Indeed, the trough would even **obstruct** the opening of wings. Moreover, the Petitioner points to no disclosure in Goodwin as to how or where or why one would mount any imaging system, such as Pierre’s system, relative to the narrow and shallow trough 21 of Goodwin. Nor does Petitioner provide any expert opinion on this issue.

Thus, the Petition has fallen short of its burden. *Advanced Bionics*, Paper 6 at 8; *Adt LLC*, 2022 WL 3588570, at *10. The Petition fails to establish how the Examiner materially erred in not citing Goodwin for the “moving platform to support an unrestrained chick” element of independent claims 1 and 6, despite being specifically directed to such disclosure. Notably, the Petitioner also submits no facts or evidence that a POSA would have been motivated to consider the **manual** system of Goodwin to combine with the teachings of an automated system, especially when the inventor was setting out to avoid the disadvantages associated with manual sexing system (injury, disease, etc.). *See* 124 Patent at col. 2:6-20. And a POSA certainly would not have sought to combine Pierre with a system that drops the chick into a narrow trough that obstructs, rather than facilitates, the opening of the chick’s wings.

Therefore, the Examiner’s conclusions were correct and should be left undisturbed; institution of Grounds 3 and 5 should be discretionally denied. *See Nespresso*, 2022 WL 212376, at *10.

Alternatively, should the Board decline to exercise its discretion on Grounds 3 and 5, these same arguments demonstrate that the Petitioner has failed to demonstrate a reasonable likelihood that independent claims 1 and 6 are unpatentable. 37 C.F.R. § 42.108; *ActiveVideo Networks, Inc. v. Verizon Commc’ns*,

Inc., 694 F.3d 1312, 1327-28 (Fed. Cir. 2012) (a petition challenging a claim on grounds of obviousness must sufficiently explain (1) “how specific references could be combined,” (2) “which combination(s) of elements in specific references would yield a predictable result,” and (3) “how any specific combination would operate or read on” the claims”). The Petitioner may not remedy these deficiencies in a reply brief. *Wasica Finance GMBH v. Continental Auto. Systems*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (“Rather than explaining how its original petition was correct, Continental’s subsequent arguments amount to an entirely new theory of *prima facie* obviousness absent from the petition. Shifting arguments in this fashion is foreclosed by statute, our precedent, and Board guidelines.”).

This Petition is precisely the type that § 325(d) was designed to weed out—one that relies on previously considered and cumulative art and asks the Board to second-guess the Examiner’s decision on patentability without any showing of error. Where, as here, the first part of the *Advanced Bionics* framework has been satisfied, “the Board’s decisions [require] a showing that the Office erred in evaluating the art,” and it is Petitioner’s burden to make such a showing. *Advanced Bionics*, at 8. That showing has not been made, and the Board should therefore exercise its discretion under § 325(d) to deny institution on all Grounds. *Id.*

IV. Conclusion

Patent Owner respectfully requests that the Board exercise its discretion under § 325(d) and deny institution of the Petition on all grounds. Alternatively, to the extent the Board declines to exercise discretion with respect to Grounds 3 and 5, denial of institution is warranted by Petitioner's failure to demonstrate a reasonable likelihood that independent claims 1 and 6 are unpatentable over Pierre in view of Goodwin.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that I caused to be served this 22nd day of May, 2024, a true and correct copy of the foregoing *Patent Owner Preliminary Response* and accompanying exhibits and other supporting materials via electronic delivery to:

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WORD COUNT CERTIFICATION

I hereby certify that the foregoing *PATENT OWNER PRELIMINARY RESPONSE*, exclusive of table of contents, table of authorities, certificate of service, word count certification, and the appendix of exhibits and claim listing, contains fewer than 14,000 words and therefor complies with the type-volume limitations set forth in 37 C.F.R. § 42.24(a)(1).

I further certify that this brief complies with the typeface requirements of 37 CFR § 42.6(a)(2)(ii) and typestyle requirements of 37 CFR § 42.6(a)(2)(iii). This brief has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in Times New Roman 14-point font.

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