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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR-KAN COMPANY, LLC,
Petitioner,

v.

UNVERFERTH MANUFACTURING COMPANY, INC.,
Patent Owner

Case No. IPR2024-01426
U.S. Patent No. 8,967,940

**PRELIMINARY RESPONSE OF PATENT OWNER
UNVERFERTH MANUFACTURING COMPANY, INC.**

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Ex. No.	Description
2001	Declaration of Brian James Petersen
2002	Declaration of Shawn Gerdeman
2003	Unverferth Mfg. Co., Inc., Unverferth Bulk Seed Handling Marketing Material (2023)
2004	<i>Unverferth Mfg. Co., Inc. v. Par-Kan Co.</i> , Stipulation of Dismissal, 3:13-cv-00097, D.I. 85 (N.D. Ind., Sep. 17, 2014)
2005	<i>Unverferth Mfg. Co., Inc. v. Par-Kan Co.</i> , Complaint, 3:13-cv-00097, D.I. 1 (N.D. Ind., Feb. 7, 2013)
2006	<i>Unverferth Mfg. Co., Inc. v. Par-Kan Co., LLC</i> , Complaint with Exhibits, 3:23-cv-00653, D.I. 2 (N.D. Ind., Jul. 11, 2023)
2007	Meridian Manufacturing Group, Meridian Bulk Seed Tender, Operator's Manual, Seed Express 275 DX and 375 DX (Jan. 2012)
2008	<i>Unverferth Mfg. Co., Inc. v. Meridian Mfg. Group, Inc.</i> , Complaint with Exhibits, 3:12-cv-02248, D.I. 1 (N.D. Ohio, Sep. 5, 2012)
2009	<i>Unverferth Mfg. Co., Inc. v. Meridian Mfg., Inc.</i> , Complaint with Exhibits, 5:19-cv-4005, D.I. 1 (N.D. Iowa, Jan. 23, 2019)
2010	<i>Unverferth Mfg. Co., Inc. v. Norwood Sales Inc.</i> , Complaint with Exhibits, 3:18-cv-00053, D.I. 1 (D.N.D., Mar. 12, 2018)
2011	<i>Unverferth Mfg. Co., Inc. v. J&M Mfg. Co., Inc.</i> , Complaint with Exhibits, 16-cv-02282, D.I. 1 (N.D. Ohio, Sep. 13, 2016)
2012	J&M Mfg. Co., Inc., J&M Model 375 ST SpeedTender Seed Delivery System Marketing Material
2013	<i>Unverferth Mfg. Co., Inc. v. Meridian Mfg. Group, Inc.</i> , Notice of Dismissal, 3:12-cv-02248, D.I. 16 (N.D. Ohio, Feb. 5, 2013)
2014	<i>Unverferth Mfg. Co., Inc. v. Meridian Mfg., Inc.</i> , Stipulation of Dismissal, 5:19-cv-4005, D.I. 276 (N.D. Iowa, Jul. 6, 2022)
2015	<i>Unverferth Mfg. Co., Inc. v. Norwood Sales Inc.</i> , Order of Dismissal, 3:18-cv-00053, D.I. 55 (D.N.D., Jun. 5, 2019)
2016	<i>Unverferth Mfg. Co., Inc. v. J&M Mfg. Co., Inc.</i> , Stipulation of Dismissal, 16-cv-02282, D.I. 84 (N.D. Ohio, Nov. 15, 2017)
2017	U.S. Patent No. 6,120,233 to Adam

Ex. No.	Description
2018	U.S. Patent No. 5,484,249 to Klatt
2019	Great Plains Air Drill Cart Model ADC2220 Part's Manual (submitted during <i>Inter Partes</i> Reexamination of U.S. Patent No. 8,221,047 on September 14, 2012)
2020	U.S. Patent No. 5,718,556 to Forsyth
2021	U.S. Patent No. 5,520,495 to Sukup
2022	U.S. Patent No. 3,498,483 to Meharry
2023	<i>Unverferth Mfg. Co., Inc. v. Meridian Mfg., Inc.</i> , Claim Construction Order, 5:19-cv-4005, D.I. 70 (N.D. Iowa, Apr. 20, 2020)
2024	Prosecution History of U.S. Patent No. 9,745,123 (U.S. App. 14/606,794) (Ex. 1002 in IPR2024-01427)
2025	<i>Unverferth Mfg. Co., Inc. v. Par-Kan Co.</i> , Par-Kan Preliminary Invalidity Contentions, 3:13-cv-00097 (N.D. Ind., Jun. 17, 2013), submitted during prosecution of the '940 Patent
2026	<i>Unverferth Mfg. Co., Inc. v. Par-Kan Co.</i> , Par-Kan Final Invalidity Contentions, 3:13-cv-00097 (N.D. Ind., Oct. 25, 2013), submitted during prosecution of the '940 Patent
2027	Photographs of Seed Runner 3500 Prototype from 2006 National Farm Machinery Show
2028	Seed Runner 3500 Marketing Materials (2006)
2029	Unverferth Mfg. Co., Inc., Moment UM Publication (Spring 2006)
2030	Photographs of Seed Runner 3500 Prototype from Unverferth (Feb. 28, 2006)
2031	Photographs of Seed Runner 3500 Prototype at Farm (Holland, Michigan)
2032	Shawn Gerdeman, Field Travel Report (May 16, 2006)
2033	Annotated Photographs (Figures 1-5), Brian James Petersen Declaration
2034	Declaration of Shawn Gerdeman, submitted during prosecution of the '940 Patent (Sept. 18, 2014)
2035	Metadata for Ex. 2030 Photographs
2036	<i>Unverferth Mfg. Co., Inc. v. J&M Mfg. Co., Inc.</i> , Claim Construction Order, 16-cv-02282, D.I. 56 (N.D. Ohio, Jul. 7, 2017)

Ex. No.	Description
2037	<i>Unverferth Mfg. Co., Inc. v. Par-Kan Co., LLC</i> , Par-Kan's 4-1(b) Disclosures, 3:23-cv-00653 (N.D. Ind., Dec. 19, 2024)

Patent Owner Unverferth Manufacturing Company, Inc. (“Unverferth” or “Patent Owner”) respectfully submits this Preliminary Response pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107 in response to Par-Kan Company, LLC’s (“Par-Kan” or “Petitioner”)¹ request for *inter partes* review (“IPR”) of claims 16-23 of United States Patent No. 8,967,940 (the “’940 Patent,” Ex. 1001).

I. INTRODUCTION

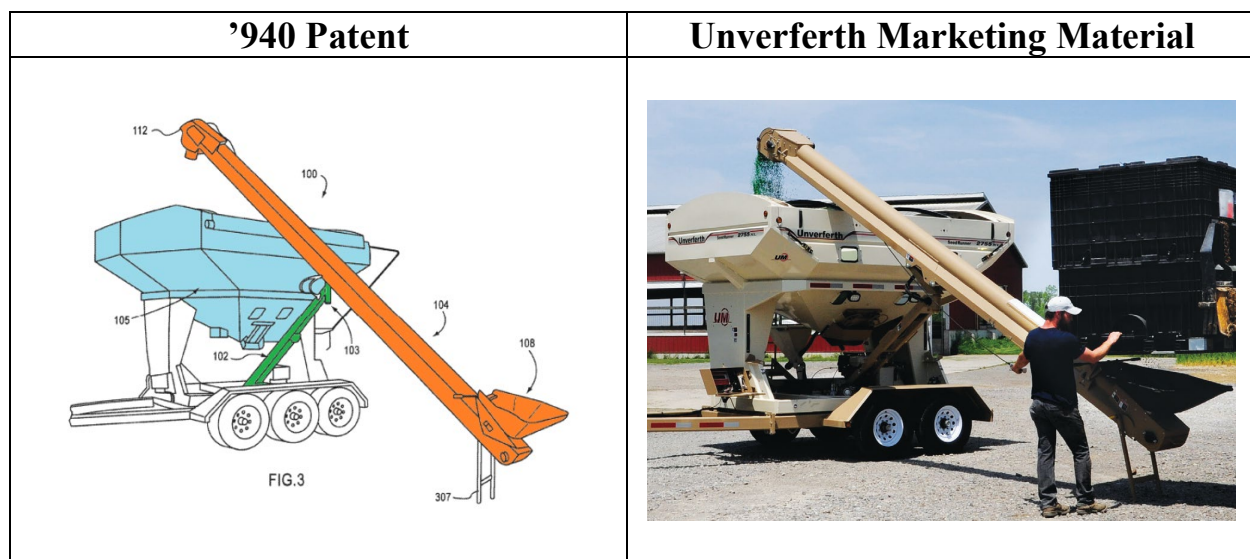
Petitioner’s request is the latest challenge to Unverferth’s patents covering its highly successful Seed Runner® seed tender product. Before challenging the ’940 Patent and its child, U.S. Patent No. 9,745,123 (the “’123 Patent”), Par-Kan previously unsuccessfully challenged the parent, U.S. Patent No. 8,221,047 (the “’047 Patent”) in an *inter partes* reexamination proceeding. Ex. 1013 at 46-60. Petitioner’s current petition relies on the same or substantially the same art—which clearly fails to teach or suggest the claimed invention—and it should meet the same fate.

Unverferth’s patents are directed to seed or grain tenders, which are used by farmers during the planting season to deliver seed or grain from its place of storage (*e.g.*, a storage box, bag, or silo) to planting machinery in the field (*e.g.*, an air drill

¹ “Par-Kan” as used herein includes Par-Kan’s predecessor-in-interest, Par-Kan Co.

cart, or planter). *See* Ex. 1001 at 1:43-58. The '940 Patent inventors developed a novel seed tender in which the conveyor could be used to both *load* seed or grain into the main hopper and *unload* seed or grain into a planting device in the field.

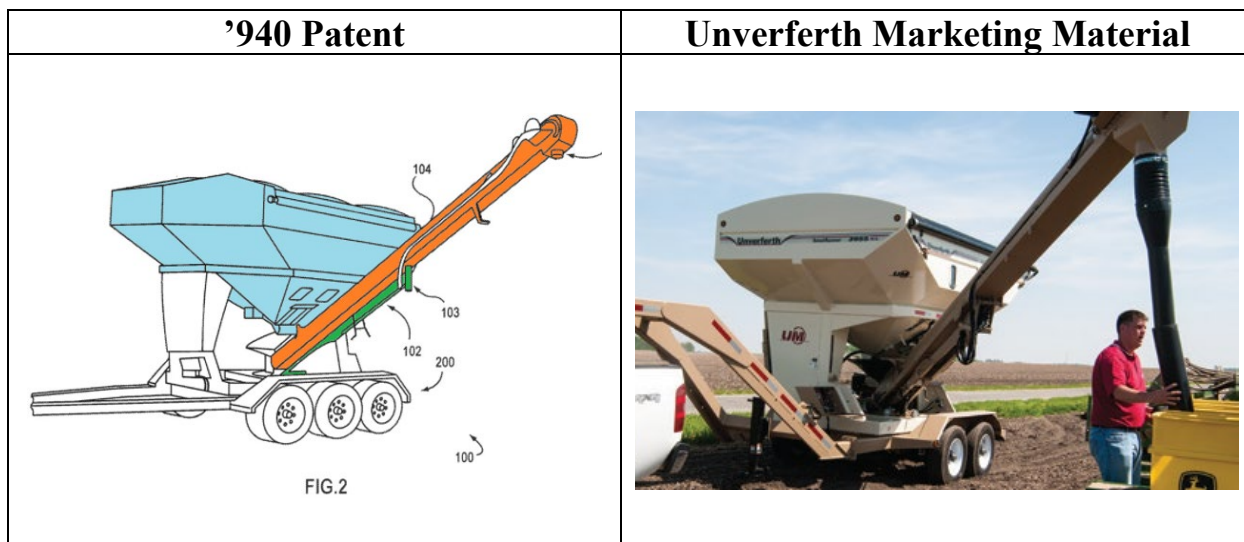
Loading position. Unverferth's innovative seed tender design utilized a support arm attached to the conveyor at one end and to the base via a first coupling *below* the main hopper on the other end. Due to the design of the seed tender, the conveyor can be easily rotated to the loading position (below) which enables a farmer to quickly, efficiently, and safely load seed or grain into the main hopper:



Compare Ex. 1001 at FIG. 3 (annotated) *with* Ex. 2003 at 1.

Unloading position. Due to the design of the seed tender, the conveyor of the seed tender can then be easily rotated to a transport position, and the seed tender is used to transport seed or grain to the field. Ex. 1001 at 2:8-14; *see also id.* at FIG 6. Once in the field, the conveyor can be easily rotated into the unloading position

(below) and the seed or grain is gravity-fed from the main hopper into the conveyor hopper, through the conveyor, through the main hopper discharge, and discharged into planting machinery:



Compare Ex. 1001 at FIG. 2 (annotated) with Ex. 2003 at 3.

The claimed invention also provides for the ability to easily and efficiently move the support arm and conveyor side-to-side, and up-and-down, in both the loading and unloading positions, allowing the farmer to position the conveyor for both receiving seed from a bulk source and discharging the seed into desired planting equipment. *See Ex. 1001 at 1:43-58.* The claimed seed or grain tender enables a farmer to quickly and easily deliver seed or grain to the planting device thereby greatly increasing planting efficiency.

The substantial success of Unverferth's patented Seed Runner® seed tender did not go unnoticed. Numerous Unverferth competitors, including Petitioner

(twice), have copied Unverferth's seed tender design, including a support arm connected to a base *below* the main hopper by a first coupling providing the claimed vertical and horizontal axes of rotation. *See* Exs. 2005 and 2006. Par-Kan copied Unverferth's patented Seed Runner in the 2012 time period as reflected below:

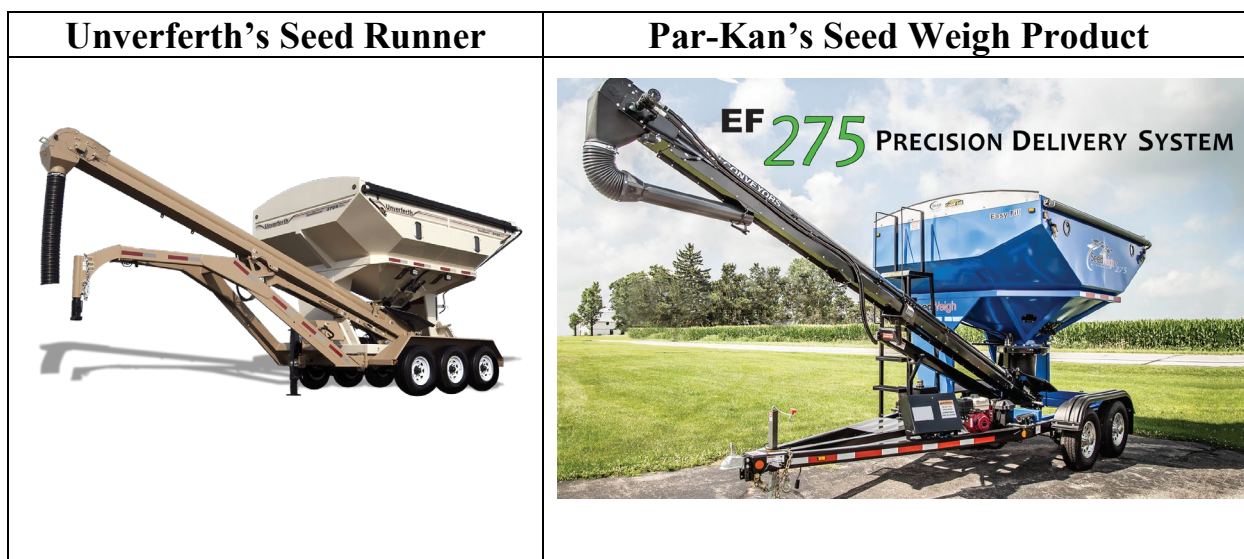
Unverferth's Seed Runner	Par-Kan's Seed Weigh Product
	

Compare Ex. 2003 at 1 *with* Ex. 1012 at 147.

After copying Unverferth's seed tender design, Par-Kan challenged the '047 Patent in an *inter partes* reexamination proceeding, relying on prior art that plainly failed to teach or suggest the claimed invention, including some of the same references that it relies on in this proceeding. Ex. 1013 at 49. For example, Par-Kan—then and now—fails to identify any reference that teaches or suggests a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. *See infra* section VI. After Par-Kan's request for *Inter Partes* Reexamination was denied, Ex. 1013 at 46-60, the lawsuit filed by Unverferth

was ultimately dismissed pursuant to a settlement, Ex. 2004, and Par-Kan withdrew its product from the market.

Several years later, after Petitioner launched a second seed tender, Unverferth again sued for patent infringement. Petitioner filed the instant request exactly one year after Unverferth served Petitioner with a complaint. Ex. 2006. Petitioner's second seed tender, just like the first, had a support arm connected to a base *below* the main hopper by a first coupling providing the claimed vertical and horizontal axes of rotation:



Ex. 2003 at 1; Ex. 2006 at 46 (without annotations).

Par-Kan is not the only competitor that has copied the '940 Patent seed tender design. Competitor Meridian Manufacturing, Inc. (twice), J&M Manufacturing Company, Inc., and Norwood Sales, Inc. all marketed seed tenders having the '940

Patent's design, including a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation:

Meridian's Seed Express 375 DX  A white and blue seed tender with a large hopper and a long, angled discharge chute. It is mounted on a trailer with two axles. A label '275-51' is visible in the top right corner of the image.	Meridian's Seed Express 400 SLD  A white seed tender with a large hopper and a long, angled discharge chute. It is mounted on a trailer with three axles. A label 'MMG-00357' is visible in the bottom right corner of the image.
Norwood's Seed Shuttle Product  A green seed tender with a large hopper and a long, angled discharge chute. It is mounted on a trailer with three axles. The background shows a field of corn.	J&M's SpeedTender Product  A green seed tender with a large hopper and a long, angled discharge chute. It is mounted on a trailer with three axles.

Ex. 2007 at 39; Ex. 2009 at 131; Ex. 2010 at 85 (without annotations); Ex. 2012 at 1; *see also* Exs. 2008-2011.

Unverferth sued each competitor, and while each of these competitors challenged the validity of the '940 Patent in a district court proceeding, those cases

were ultimately dismissed. Exs. 2013-2016. Each of those competitor's copycat products is no longer on the market.

Par-Kan's Petition should be denied for at least three independent reasons:

First, the Petition fails to establish a reasonable likelihood that Petitioner will prevail on any Challenged Claim. None of the art cited by Petitioner teaches or suggests one of the many features copied by Par-Kan and numerous other competitors—that is, a support arm connected to a base *below* the main hopper by a first coupling providing the claimed horizontal and vertical axes of rotation.² Petitioner relies on two bases (Grounds I and IV) to challenge independent claim 16.³ In Ground I, Petitioner effectively ignores this limitation. Petition (“Pet.”) at 5-38 (“Pet.”). Petitioner identifies a purported base that is not below the main hopper, but rather far removed from the main hopper on the trailer tongue. *See id.* at 17-19. Petitioner fails to explain how the Hiniker Manual's purported base satisfies the

² While Patent Owner focuses on claim 16 for this Preliminary Response, it reserves the right to argue independent patentability of other elements in claim 16, as well as dependent claims, in the event that this IPR is instituted (which it should not be).

³ Thus, Grounds II and III suffer the same deficiency as Ground I, and Ground V suffers the same deficiency as Ground IV with respect to this feature of claim 16.

claim element and does not offer any motivation for moving the base below the main hopper. *See id.*

In Ground IV, Petitioner proposes substantial and significant modifications to the primary reference (Morris)—a planting device and not a seed tender—to arrive at a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. *See id.* at 52-80. However, Petitioner acknowledges that these significant modifications would render Morris unsatisfactory for its intended purpose. *See id.* Morris is an Air Cart—a planting device—with an intended purpose of having “a full range of products like Canola to peas *to be seeded* without having to change the metering wheels.” Ex. 1009 at 37 (emphasis added). Petitioner brazenly argues for modifications that would raise the hopper, remove the seed planting components, all in the name of a improper hindsight driven recreation to arrive at the claimed invention. In fact, Petitioner goes so far as to argue that “[a] skilled artisan would have been motivated to design a tender based on the Morris-Furrer combination, *but without the seed planting components.*” Pet. at 62 (emphasis added). Petitioner’s primary references (Morris and the Hiniker Manual) are planting devices, which have numerous complex constituent parts located under the hopper for carrying out the primary purpose of the device (*i.e.*, to plant seed) as shown below with respect to the Hiniker Manual:

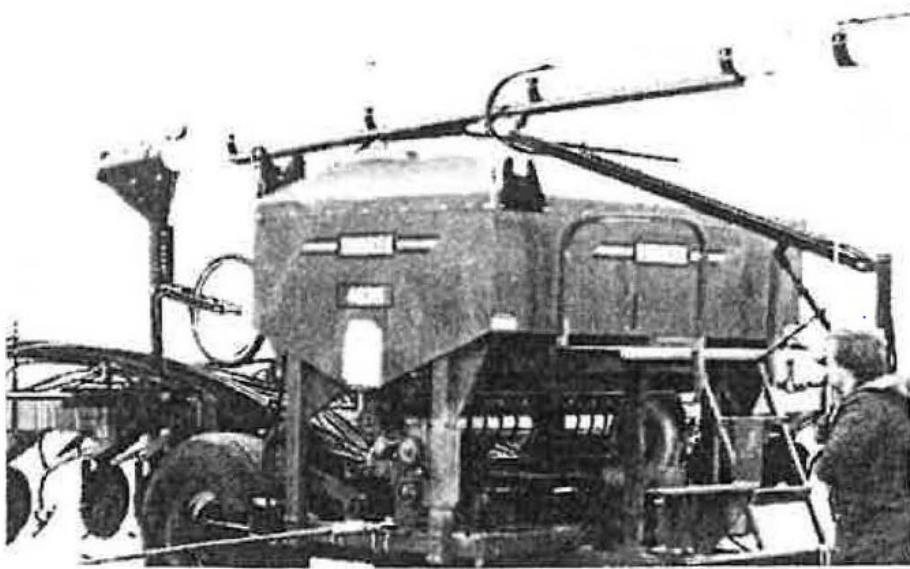


PHOTO NO. 4081

Ex. 1004 at 42 (Photo No. 4081); *see also* Ex. 1009 at 40, 71, 91-92, 143.

The base for the support arm could not have been relocated below the main hopper in these devices without removing critical planting components thereby rendering the devices unsatisfactory for their intended purpose.

Second, discretionary denial under 35 U.S.C. § 325(d) is appropriate because the Office considered the same or substantially the same prior art relied upon by Petitioner during prosecution for the '940 Patent and the '047 Patent. Two of the references, Baskerville and Furrer, relied on by Petitioner were considered, discussed, and/or relied upon by the Examiner during prosecution of the '940 Patent and the '047 Patent. Ex. 1002 at 11-17 (IDS listing Furrer and Baskerville); Ex. 1012 at 66-76, 102-110, 159-167, 187-193 (Office Actions discussing Furrer and

Baskerville). The remaining references are substantially similar to those considered by the Examiner. They are also substantially similar to those previously considered by the Board in connection with Petitioner's failed request for *inter partes* reexamination of the parent '047 Patent. *See infra* section VII. Each suffers from the same deficiency—none teaches or suggests a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation.

Recognizing this deficiency, Petitioner argues that its *own* prior challenge of the parent '047 Patent was deficient, and the present Petition identifies a purported *new* motivation to modify a planting device that they failed to mention in the first challenge. Pet. at 87-88. While Petitioner argues that it would have been obvious to modify the art to arrive at a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation, the reality is in stark contrast. The art relied on by Petitioner, just like the countless references previously considered by the Examiner and the Board, teach a different support arm structure. *See infra* section VII.

Third, Petitioner's Grounds for unpatentability are fundamentally premised on art under 35 U.S.C. § 102(a) that is not prior art. Patent Owner submits herewith indisputable evidence that the subject matter of claims 16-22 was reduced to practice before publication of the Morris and Hiniker Webpage references relied upon by Petitioner. *See* Ex. 2001 (Declaration of B. Petersen); Ex. 2002 (Declaration of S.

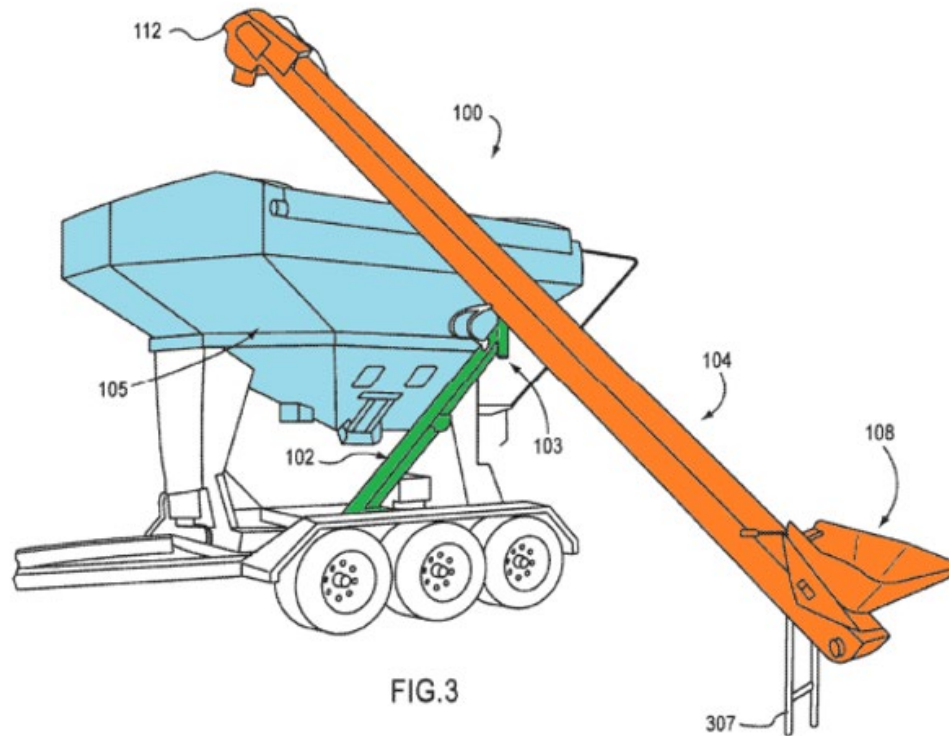
Gerdeman). Each ground relied upon by Petitioner relies on one of these two references. Pet. at 1-2. Thus, without these two references, Petitioner cannot establish a reasonable likelihood that it will prevail on the Challenged Claims for this separate and independent reason. *See infra* section VIII.

II. BACKGROUND

A. Overview of the '940 Patent

The '940 Patent was filed on July 3, 2012, and claims priority to Provisional Application No. 60/901,321 filed February 15, 2007. Ex. 1001 at 1. The '940 Patent is a continuation of Application No. 12/031,867, now the '047 Patent. *Id.*

The seed tender described in the '940 Patent comprises, *inter alia*, a main hopper (which holds the seed or grain), a rotating conveyor (which moves the seed or grain into the main hopper (loading position) and out of the main hopper (unloading position)), and a support arm (which runs from the base of the seed tender to the approximate center of gravity of the conveyor, and supports the conveyor). Ex. 1001 at FIGS 1-3. The support arm is connected to a base via a first coupling that is located below the main hopper and enables movement of the conveyor and the support arm about two distinct axes (horizontal and vertical), thus providing side-to-side and up and down movement. *Id.*



Pet. at 3 (depicting loading position).

Because the support arm is connected to a base located below the main hopper, the support arm provides structural support for the conveyor and allows an operator to pivot or rotate the conveyor in an easy, efficient, and safe manner to accomplish a number of versatile tasks. Ex. 1001 at 1:16-19, 2:1-4. For example, a farmer is able to load seed or grain into the main hopper, using the conveyor in its loading position (depicted above). *Id.* at 1:53-58, 3:35-37.

Once in the field, the conveyor can be safely and easily rotated into the unloading position and the seed or grain is gravity-fed from the main hopper into the

conveyor hopper, through the conveyor, through the main hopper discharge, and discharged into planting machinery. *Id.* at 1:47-52, 3:12-18.

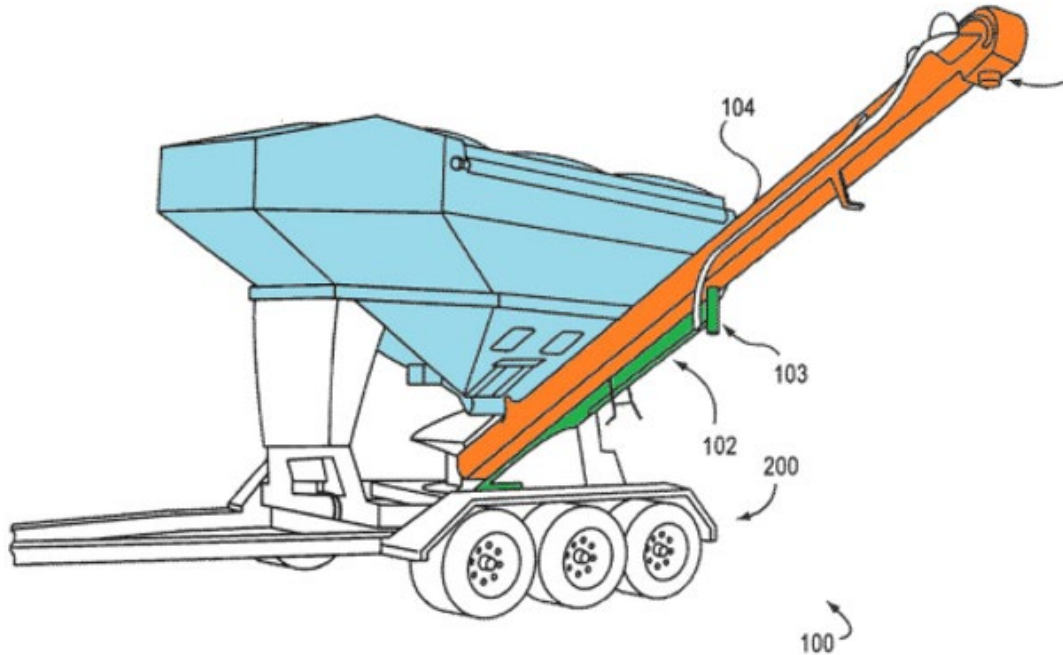


FIG. 2

Pet. at 4 (depicting unloading position).

The claimed invention provides for the ability to move the support arm and conveyor side-to-side, and up-and-down, in both the loading and unloading positions, allowing the farmer to easily position the conveyor for both receiving seed from a bulk source and discharging the seed into desired planting equipment. *See, e.g.,* Ex. 1001 at claim 16.

Unverferth's development of the self-fill seed tender disclosed in the '940 Patent (*i.e.*, Unverferth's Seed Runner® products) revolutionized how seed was transported and handled by farmers. Specifically, Unverferth's Seed Runner®

products allowed farmers to easily, efficiently, and safely load seed or grain from its source of origin into the main hopper, transport seed or grain to the planting device, and unload seed or grain into the planting device.

B. Relevant Prosecution History

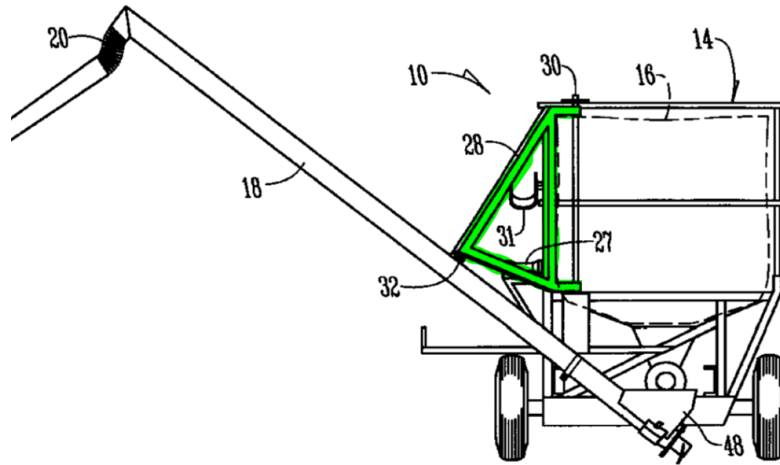
1. The '047 Patent (Parent)

The '047 Patent, Ex. 1013 at 106-121, issued on July 17, 2012. *Id.* at 106. The claims of the '047 Patent are similar to those of the '940 Patent as reflected by the following side-by-side comparison:

'047 Patent, Claim 1	'940 Patent, Claim 16
A seed or grain tender comprising:	A seed or grain tender comprising:
a frame;	
a main hopper mounted on said frame and having a main hopper discharge;	a main hopper having a main hopper discharge;
a base mounted on said frame below said main hopper discharge;	a base positioned below said main hopper;
a support arm having first and second ends;	a support arm having first and second ends;
a first coupling connecting said first end of said support arm with said base, said first coupling being rotatable in relation to said base about a first vertical axis of rotation, and said first end of said support arm being rotatable in relation to said first coupling about a first horizontal axis of rotation;	a first coupling connecting said first end of said support arm with said base, said first coupling being rotatable about a first vertical axis of rotation, and said first end of said support arm being rotatable about a first horizontal axis of rotation;
a conveyor having a longitudinal axis and first and second ends, a conveyor hopper at said first end, a conveyor discharge at said second end, and an internal elevator for moving seed or	a conveyor having a longitudinal axis and first and second ends, a conveyor hopper at said first end, and a conveyor discharge at said second end; and

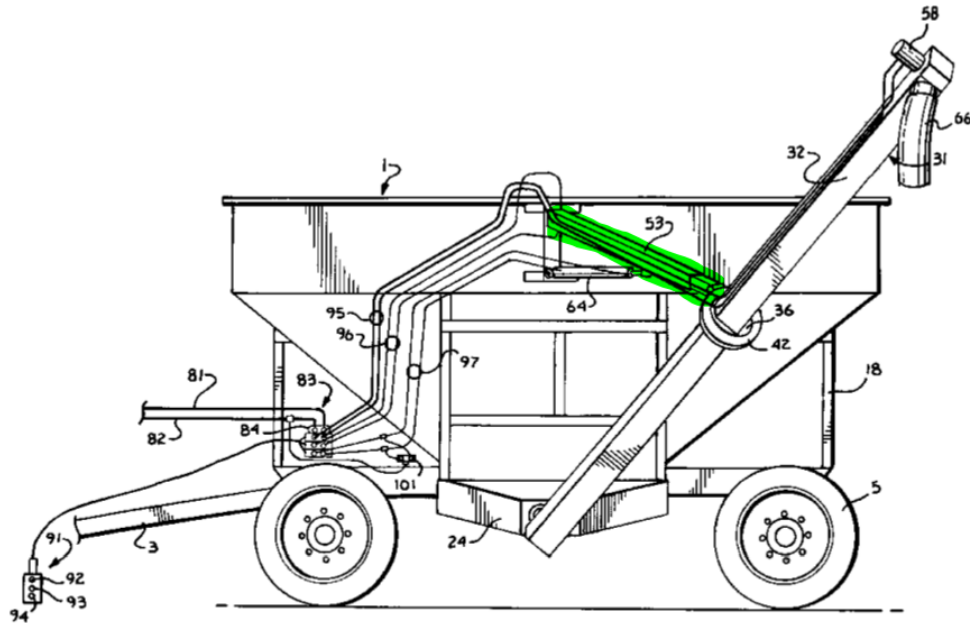
'047 Patent, Claim 1	'940 Patent, Claim 16
grain from said conveyor hopper to said conveyor discharge; and	
a second coupling connecting said second end of said support arm with said conveyor at an approximate center of gravity of said conveyor, said second coupling defining a second vertical axis of rotation that is not parallel to said conveyor longitudinal axis,	a second coupling connecting said second end of said support arm with said conveyor at an approximate center of gravity of said conveyor, said second coupling defining a first conveyor axis of rotation that is not parallel to said conveyor longitudinal axis,
and said conveyor being rotatable in relation to said second end of said support arm about said second vertical axis of rotation between an unloading position wherein said conveyor hopper is disposed below said main hopper discharge to receive agricultural product from said main hopper and a loading position wherein said conveyor discharge is disposed above said main hopper to dispense agricultural product into said main hopper.	and said conveyor being rotatable in relation to said second end of said support arm about said first conveyor axis of rotation between an unloading position wherein said conveyor hopper is disposed below said main hopper discharge to receive agricultural product from said main hopper and a loading position wherein said conveyor discharge is disposed above said main hopper to dispense agricultural product into said main hopper.

During prosecution of the '047 Patent, the Examiner initially rejected the originally submitted claims, *inter alia*, as purportedly obvious over Klatt, Ex. 2018, in view of Adam, Ex. 2017. Ex. 1012 at 210-219. Adam is directed to a bulk seed bag carrier having a support arm connected to the conveyor. Ex. 2017 at Abstract. The support arm of Adam is connected to the side of the device—*i.e.*, it is not below the main hopper—as illustrated below (support arm annotated in green):



Id. at FIG 1 (annotated).

In the Final Office Action prior to allowance, the Examiner rejected the claims as purportedly obvious over two references relied upon by Petitioner: Furrer and Baskerville. Ex. 1012 at 66-76. Furrer is directed to a seed tender that is only capable of unloading seed, Ex. 1007 at Abstract, while Baskerville is directed to a load-unload seed tender with a support arm that is not attached to a base below the main hopper, Ex. 1008 at Abstract. The support arm of Baskerville is highlighted in green below:



Ex. 1008 at FIG 9 (annotated). Again, like those references relied upon in the Petition, the support arm is not connected to the base below the main hopper. *See id.*

In response to this rejection, Unverferth submitted new claims and the following remarks:

New claims 12-49 are submitted to be patentable over the prior art of record because none of the art, alone or in combination, teaches or suggests a seed or grain tender having, among other things, a first coupling connecting a first end of a support arm with a base below the hopper such that the coupling is rotatable in relation to the base about a first vertical axis of rotation and the support arm is rotatable in relation to the first coupling about a first horizontal axis of rotation. . .

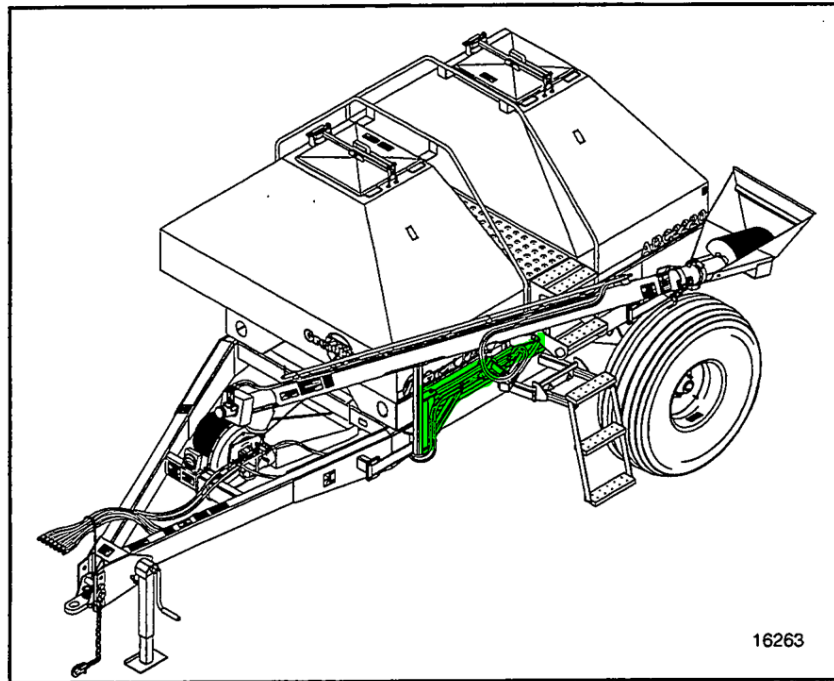
Ex. 1012 at 54.

The Examiner issued a Notice of Allowance on May 5, 2012, noting “the applicant’s arguments filed on April 5, 2012 as the basis for the allowance.” *Id.* at 19.

2. Petitioner’s Prior Challenge to the ’047 Patent

On September 14, 2012, Petitioner filed a request for *inter partes* reexamination for claims 1-34 for the ’047 Patent. Ex. 1013 at 79-100. Petitioner relied on a number of different invalidity theories under 35 U.S.C. §§ 102 and 103 based on several different prior art references, including: (1) a Great Plains Air Drill Cart (Model ADC2220); (2) a Convey-All product (“Convey-All”); (3) Baskerville; and (4) Adam. *See id.* at 79-80.

The primary reference relied upon in the reexamination was the Great Plains Air Drill Cart, Ex. 2019, which is a planting device used for planting seed in the field like the primary references relied on in this proceeding (*i.e.*, the Hiniker Manual and Morris). Ex. 1013 at 81-99. Again, like the references relied upon in the Petition, the Great Plains Air Drill Cart does not include a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation:



Ex. 2019 at 1 (annotated).

The reexamination proceeding was ultimately denied because “the information presented in the Request for *inter partes* reexamination fails to show that there is a reasonable likelihood that the Requestor would prevail with respect to the following proposed rejections of claims 1-34 of the '047 patent.” Ex. 1013 at 59. Petitioner filed a Petition for Reconsideration of Reexamination, *id.* at 9-26, 32-45, but it was denied as well, *id.* at 1-6, 27-31.

3. The '940 Patent

The '940 Patent issued from U.S. Application No. 13/541,553 on March 3, 2015. Ex. 1001 at 1. During prosecution, Applicant submitted the art considered during prosecution of the '047 patent and the '047 *inter partes* reexamination

proceeding, including Baskerville, Furrer, and the Great Plains Air Drill Cart. Ex. 1002 at 11-17; Ex. 1013 at 46-60. The Examiner also considered Par-Kan's preliminary and final invalidity contentions from the district court litigation involving the '047 patent. *Id.* at 16; *see also* Exs. 2025 and 2026.

The Office, however, did not raise any prior art rejections during prosecution of the '940 Patent. Ex. 1002 at 66-70, 96-100. In a Final Office Action mailed July 2, 2014, the Examiner provided a similar statement of reasons for the indication of allowable subject matters as set forth in the '047 Patent. *See id.* at 69. Moreover, the Examiner stated “[t]he prior art made of record and not relied upon is considered pertinent to applicant’s disclosure:

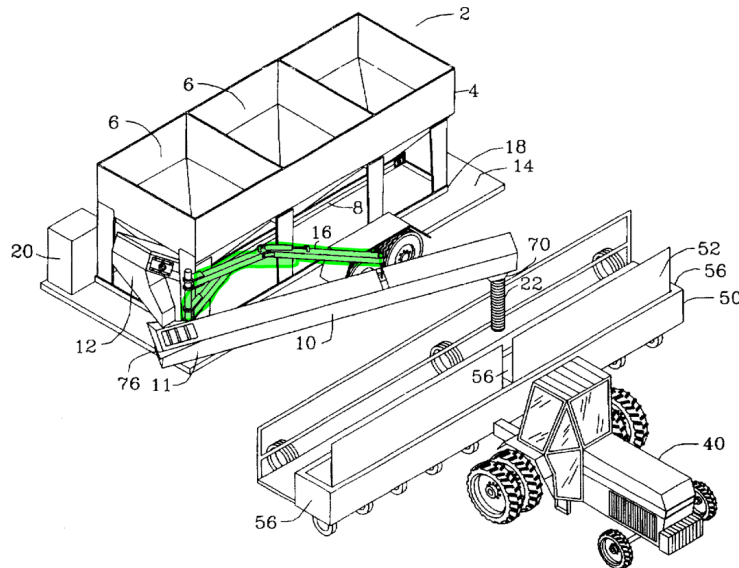
Adam	6,120,233
Forsyth	5,718,556
Sukup	5,520,495
Meharry	3,498,483
Boyer	1,905,434
Klatt	5,484,249”

Id.

The Examiner considered each of these references disclosing agricultural equipment with a different structure than the claimed structure and allowed the claims. The references considered by the Examiner have the same deficiency as the

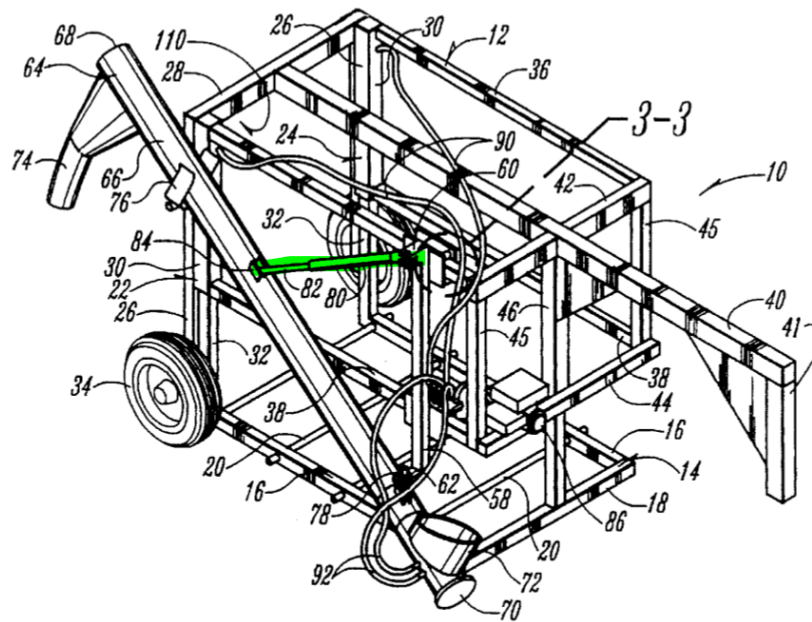
art relied on in this Petition. Namely, none of these references disclose an agricultural device having a support arm connected to a base *below* the main hopper by a first coupling providing the claimed horizontal and vertical axes of rotation. Adam is discussed above in the context of the '047 Patent. *See supra* at section II.B.1.

Forsyth is a bulk granular material transport system having a support arm highlighted in green below:



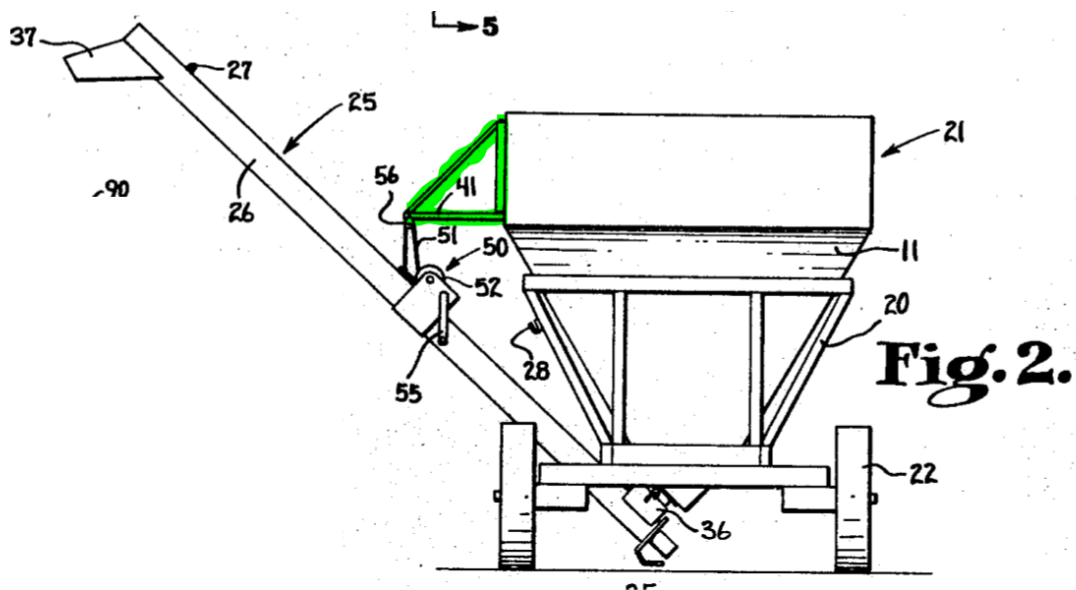
Ex. 2020 at FIG 1 (annotated).

Likewise, the Sukup device is reproduced below with its structure that is connected to the conveyor from the top of the device highlighted in green:



Ex. 2021 at FIG 1 (annotated).

Similarly, Meharry is provided below with its support arm structure highlighted in green:



Ex. 2022 at FIG 2 (annotated).

The Examiner considered but did not reject the claims over any of these references during prosecution of the '940 Patent. Ex. 1002 at 66-69. This is because, *inter alia*, each reference fails to show a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. *See id.*

III. LEGAL STANDARDS

A petition for IPR may only be granted when “the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.108(c). Petitioner has the burden of proof to show that the statutory threshold is satisfied. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012).

IPR institution is discretionary. *See SAS Inst. 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). “In exercising that discretion, [the Board is] guided by the statutory requirement, in promulgating regulations for *inter partes* review, to consider the effect of any regulations on ‘the efficient administration of the Office [and] the ability of the Office to timely complete proceedings,’ 35 U.S.C. § 316(b), as well as the requirement to construe [the PTAB’s] rules to ‘secure the just, speedy, and inexpensive resolution of every proceeding,’ 37 C.F.R. § 42.1(b).” *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310,

Paper 7 at 42 (P.T.A.B. Jan. 24, 2019) (informative). For example, “the Board may consider the number of claims and grounds that meet the reasonable likelihood standard when deciding whether to institute *inter partes* review under 35 U.S.C. § 314(a).” *Id.*

IV. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art (“POSA”) would have at least an undergraduate degree in mechanical engineering, agricultural engineering, or a closely related field. Additionally, a POSA would have at least two years of experience designing agricultural products or related machinery, either in industry or academia.

Petitioner proffers a similar level of ordinary skill in the art. Patent Owner does not believe that any of the arguments herein would change if the Board were to adopt Petitioner’s definition for the level of ordinary skill rather than Patent Owner’s.

V. CLAIM CONSTRUCTION

For purposes of *inter partes* review, disputed claim terms are construed to give them “the meaning that the term would have to a [POSA] in question at the time of the invention” *See* 83 Fed. Reg. 51340, 51341 (Oct. 11, 2018) (adopting the standard of *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005)). The proper construction is considered in the context of, and must be consistent with, the

specification—and the claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *See, e.g., Phillips*, 415 F.3d at 1313.

The Consolidated Trial Practice Guide (at 46-48) notes that in construing the claims “the Board may take into consideration statements made by a patent owner or petitioner about claim scope,” and that claim construction developments in district court may be considered in this proceeding when made of record by the parties. *Cf.* 37 C.F.R. § 42.100(b) (“Any prior claim construction determination concerning a term of the claim in a civil action . . . that is timely made of record in the *inter partes* review proceeding will be considered.”). Pursuant to Rule 42.100(b), Patent Owner requests the Board to consider and adopt certain relevant constructions previously given the following terms in *Unverferth v. Meridian*, Case No. 19-cv-4005-LTS (N.D. Iowa). Ex. 2023.

1. Petitioner’s Claim Construction Analysis is Deficient

As a preliminary matter, Petitioner sidesteps all issues of claim construction in its Petition, simply asserting that “the Board need not construe any claim terms to address the identified grounds.” Pet. at 4. In doing so, Petitioner’s position is inconsistent with the positions it is taking in the related district court action involving the Challenged Claims. *See e.g.,* Ex. 2037 at 4. The Petition also fails to account for the construction of claim terms that district courts have adopted relating to the

challenged patent as well as *its own proposed* claim constructions in the related district court litigation. *See* Exs. 2023, 2036, 2037.

For example, as discussed in greater detail below, Petitioner fails to address the construction of “below,” which has been construed in a district court proceeding involving the challenged patent. *See* Ex. 2023 at 26-28. Additionally, Petitioner fails to address the construction of “base,” which it proposes should be construed to mean “a base mounted on the frame” in the related district court proceeding. Ex. 2037 at 4. Moreover, Petitioner fails to explain how the cited references would satisfy these constructions, and in several cases, they do not. This is a further basis for denial of the Petition. *See Resmed Corp. v. Cleveland Med. Devices Inc.*, No. IPR2023-00565, Paper 13 at 17 (P.T.A.B. Sept. 25, 2023) (“[By] providing inconsistent positions regarding the proper construction of the claims, Petitioner is not being transparent.”); *10X Genomics, Inc. v. President and Fellows of Harvard College*, IPR2023-01299, Paper 15 at 7-13 (P.T.A.B. Mar. 7, 2024) (denying institution based on Rule 104(b)(3) where petitioner argued to the Board that § 112(f) (means-plus-function) construction did not apply while arguing to (and persuading) the district court that § 112(f) construction did apply); *see also Facebook, Inc. v. Sound View Innovations, LLC*, No. IPR2017-00998, Paper 13 at 17-18 (P.T.A.B. Sept. 5, 2017).

2. “Below”

The term “below” appears twice in claim 16. In one instance, the term “below” is used to describe where the base is mounted (“below” the main hopper), and in the second instance, the term “below” is used to describe where the conveyor hopper is disposed in the unloading position (“below” the main hopper, to receive agricultural product from the main hopper). There is a legal presumption that the same term appearing twice in different portions of the claims should be given the same meaning. *Pods, Inc. v. Porta Stor, Inc.*, 484 F.3d 1359, 1366 (Fed. Cir. 2007) (quoting *Fin Control Sys. Pty., Ltd. v. OAM, Inc.*, 265 F.3d 1311, 1318 (Fed. Cir. 2001)).

The term “below” should be construed to mean “under.” Petitioner fails to construe this term but seeks to broaden the meaning of “below” in an attempt to render the Challenged Claims unpatentable with alleged prior art that teaches something entirely different. For example, the Petition alleges that a piece of farm equipment with a “base” mounted on a trailer tongue, far out in front of the main hopper, is “below” the main hopper. Pet. at 17-19.

The intrinsic record makes clear that in the context of the '940 Patent, “below” means “under.” *Grober v. Mako Prods., Inc.*, 686 F.3d 1335, 1341 (Fed. Cir. 2012) (the specification and prosecution history may shed light on the ordinary and customary meaning of a claim term).

Turning first to claim 16, the claim's second use of "below" ("said conveyor hopper is disposed *below* said main hopper to receive agricultural product from said main hopper") only makes sense if "below" means "under." This is because in the technology at issue, the seed or grain is fed from the main hopper to the conveyor hopper via gravity, and thus, for the main hopper discharge to "receive agricultural product from the main hopper," the conveyor hopper would have to be underneath the main hopper. *See, e.g., On Demand Mach. Corp. v. Ingram Indus.*, 442 F.3d 1331, 1337 (Fed. Cir. 2006) (claims should be construed "in the context of the particular technology" at issue); *ICU Med., Inc. v. Alaris Med. Sys.*, 558 F.3d 1368, 1375 (Fed. Cir. 2009) ("[I]t is entirely proper to consider the functions of an invention" during claim construction).

The disclosures in the intrinsic record also show that the patentee intended for "below" to mean "under" because these words are used interchangeably in referring to the position of the conveyor hopper vis-à-vis the main hopper discharge when in the unloading position. *See, e.g., EPOS Techs. Ltd. v. Pegasus Techs. Ltd.*, 766 F.3d 1338, 1345 (Fed. Cir. 2014) (finding the district court erred when it construed "marking implement" as an "implement that has a marker tip" because "the specification interchangeably refers to a 'marking implement' as a 'marker' and as a 'pen.'"); *Solvay S.A. v. Honeywell Int'l*, 622 F.3d 1367, 1380, 1382 (Fed. Cir. 2010) (agreeing with district court's claim construction that "isolating" means

“separating” because “the patent specification uses ‘isolate,’ ‘separate,’ and ‘to draw off’ interchangeably, as did the inventors during prosecution[.]”).

For example, in the specification, the patent discloses that “one end of the conveyor may be positioned *under* the discharge of the main hopper and coupled with a pivoting support arm,” Ex. 1001 at 1:48-50 (emphasis added); *see also id.* at 1:53-54 (“A pivot mechanism allows the conveyor to be rotated from under the box”), but later the specification discloses that the “conveyor hopper is positioned *below* a discharge of the main hopper.” *Id.* at 4:43-44 (emphasis added); *see also id.* at 3:12-14 (“The conveyor includes a conveyor hopper at its base, which is shown in the unloading position below the gravity discharge of the main hopper.”). Similarly, in the prosecution of the application that issued as the ’047 Patent, in response to the Office Actions mailed March 15, 2010, August 30, 2010, and April 4, 2011, the patentee used the words “below” and “under” interchangeably:

The seed or grain tender also includes a mechanism for detachably coupling the conveyor at a position where said conveyor hopper is positioned *below* said main hopper discharge. When the conveyor is decoupled from the position *under* the main hopper discharge, the conveyor can be rotated about the axis of the conveyor coupling to a position where the discharge of the conveyor is positioned *over* the main hopper.

Ex. 1012 at 81, 123, 181 (emphasis added).

Petitioner’s failure to properly consider this term in its Petition is particularly egregious because the term has been construed previously by a district court as

“under.” While not binding on the Board, in *Unverferth Mfg. Co., Inc. v. Meridian Mfg., Inc.*, Case No. 19-cv-4005-LTS (N.D. Iowa) the district court construed the term “below” as “under.” Ex. 2023 at 26-28. In reaching this construction the Court agreed with Patent Owner that “the claim language provides the relevant relational aspect of the base to other structures.” *Id.* at 27. Petitioner completely ignores this construction in its Petition.⁴

3. “Seed Tender”

The preamble of the Challenged Claims reciting a “seed or grain tender” is limiting. “A preamble limits the invention if it recites essential structure or steps, or is necessary to give life, meaning, and vitality to the claim.” *Acceleration Bay, LLC v. Activision Blizzard, Inc.*, 908 F.3d 765, 770 (Fed. Cir. 2018) (internal quotes and citations omitted); *see also* MPEP § 2111.01(I) (“Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.”) (citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989)). Again, the Petitioner fails to construe this term but

⁴ While Patent Owner previously proposed a construction of “below” to mean “lower than”—which was the construction adopted earlier by a district court in the 16-cv-2282 Ohio case—that construction was rejected by the Iowa district court, which construed “below” to mean “under.” *See* Ex. 2023 at 26-28; *see also* Ex. 2036 at 5.

instead argues that it is non-limiting when comparing the cited references to the claims. Pet. at 13-15.

Here, the preamble of the Challenged Claims limits the structure of the claimed invention to a “seed or grain tender.” A seed or grain tender is a specific type of agricultural equipment with certain structural features. As explained in the ’940 Patent, a seed tender is a device for “holding seed” with a conveyor for transferring seed to and from the device into another location “such as a [] planter, seeding unit, or the like.” Ex. 1001 at 1:50-52. Petitioner tries to equate a seed or grain tender with a planting device despite that the ’940 Patent clearly distinguishes a seed or grain tender from a planting device. *See id.* The Federal Circuit has previously held that a preamble is limiting when the preamble recites a structure and distinguishes other structures in the specification. *See, e.g., Piggy Pushers, LLC v. Skidders Footwear, Inc.*, 544 F. App’x 984, 989 (Fed. Cir. 2013) (“We therefore affirm the construction of the preambles as limiting to the extent necessary to express the idea that the claims each cover a sock, not a shoe or another article that may be derivative or partly made up of a sock but is not itself a sock.”). Given that the ’940 Patent distinguishes a seed or grain tender from a planter, the preamble should be construed as limiting and it is clear that the claims do not encompass a planter. *See id.*

Petitioner’s argument that a “seed or grain tender” is non-limiting is also inconsistent with the references it relies on. For example, as explained in *Furrer*, a seed tender “contain[s] seed in bulk form or stored in large, heavy containers, primarily for supplying agricultural row crop planters or grain drills or the like, with seed, although it may be used for other seed handling applications as well.” *Ex. 1007* at 1:15-19. The preamble of the present case is similar to the preamble in *In re Fought*, 941 F.3d 1175, 1178-79 (Fed. Cir. 2019), where the Federal Circuit overturned the Board’s finding that the preamble, “a travel trailer,” was not limiting. The Federal Circuit concluded that “a travel trailer” was limiting and distinguished prior art because, in part, “‘a travel trailer’ is a specific type of recreational vehicle and that this term is a structural limitation of the claims. . . . Just as one would not confuse a house with a warehouse, no one would confuse a travel trailer with a truck trailer.” *See id.* at 1179. The same is true here—a seed or grain tender is a specific type of agricultural equipment. No one would have confused a “seed tender,” such as the claimed invention, with a “planter,” such as the devices of Morris or Hiniker Manual. Thus, the preamble of the Challenged Claims is limiting and excludes a planter.

VI. THE BOARD SHOULD DENY INSTITUTION BECAUSE PETITIONER FAILS TO ESTABLISH A REASONABLE LIKELIHOOD OF PREVAILING FOR ANY CHALLENGED CLAIM

For an IPR to be instituted, Petitioner bears the burden to establish a reasonable likelihood of prevailing with respect to at least one Challenged Claim. 35 U.S.C. § 314(a). The Petition asserts five grounds of unpatentability, none of which establish a reasonable likelihood that Petitioner will prevail on any Challenged Claim. Thus, the Petition should not be instituted. In an IPR, “the burden of proving a proposition of unpatentability” is borne by (and always remains with) the Petitioner. 35 U.S.C. §§ 314(a), 316(e); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016).

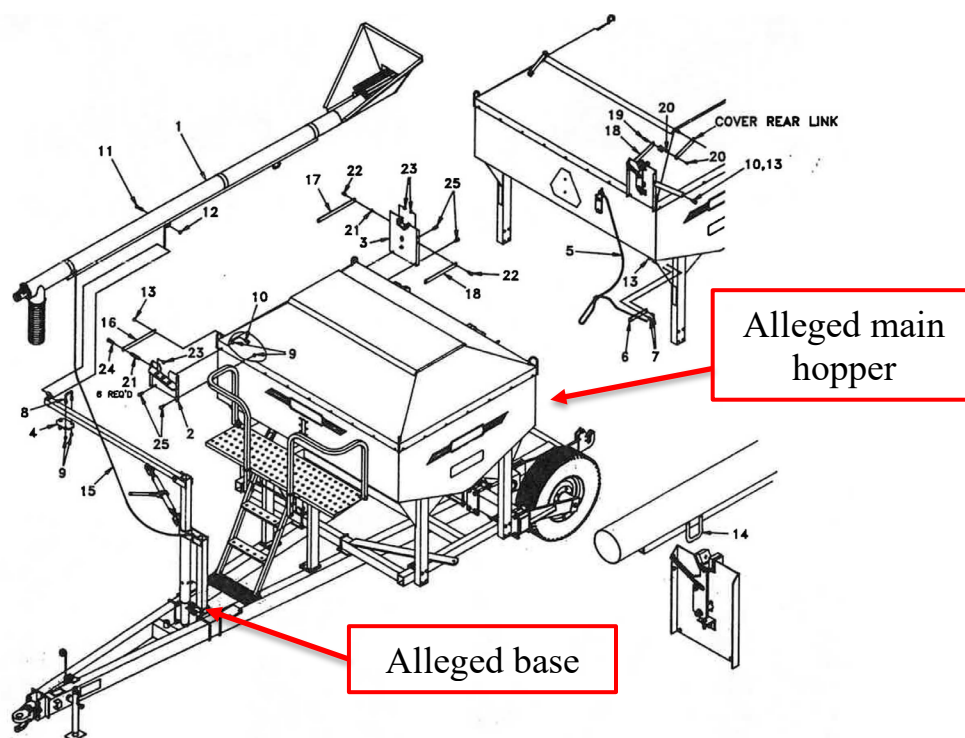
A. The Petition Fails to Explain How the Hiniker Manual Grounds (Grounds I-III) Purportedly Teach or Suggest a Support Arm Connected to a Base *Below* the Main Hopper by a First Coupling Providing the Claimed Axes of Rotation (They Do Not)

Petitioner challenges claims 16 and 18-21 by relying on the Hiniker Manual in view of the Hinker Webpage (and, if necessary, Johnson and/or Morris) (Ground I).⁵ None of the art cited by Petitioner teaches or suggests, *inter alia*, a support arm

⁵ Petitioner relies on additional references (Furrer and Baskerville) to challenge certain dependent claims in Grounds II and III. Petitioner cannot rely on the references in Grounds II and III to challenge claim 16, as the Petition does not rely

connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. Rather, Petitioner effectively ignores this limitation. Pet. at 17-19.

Petitioner identifies the base of the Hiniker Manual (which appears to depict the same device discussed in the Hiniker Webpage) as a “mounting plate” that is located on the trailer tongue of the device.



on these secondary references for claim 16. See *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019) (“Because of the expedited nature of IPR proceedings, it is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify with particularity the ‘evidence that supports the grounds for the challenge to each claim.’” (internal quotations and citations omitted)).

See Pet. at 17-19; Ex. 1004 at 39. Petitioner fails to explain how the alleged base or “mounting plate” is below the main hopper. *See* Pet. at 17-19. It is not. Rather, the identified structure is clearly located a substantial distance away from the main hopper and is not below the main hopper.

As set forth above in Section V.1, a proper construction of the claims requires a base below (or under) the main hopper. This construction is consistent with the construction adopted by a district court construing the same claims. *See* Ex. 2023 at 26-28. As explained by the district court, “[t]he word ‘below’ could account for the first two scenarios, but I find that one would not use the word below to describe the box in relation to the line in the third scenario:”



Id. at 27-28.

Petitioner identifies a purported base that is not below (or under) the main hopper but is rather far removed from the main hopper on the trailer tongue. *See* Pet. at 17-19; *see also* Ex. 1004 at 38-39. Petitioner fails to explain how the Hiniker Manual satisfies the claim element and does not offer any motivation for moving the base below (or under) the main hopper. *See* Pet. at 17-19. Thus, the Petition fails to establish a reasonable likelihood of success for challenging any challenged claim

under the grounds relying on the Hiniker Manual as a primary reference (Grounds I-III).⁶

B. Morris Fails to Teach or Suggest a Support Arm Connected to a Base *Below* the Main Hopper by a First Coupling Providing the Claimed Axes of Rotation, and a POSA Would Not Have Been Motivated to Arrive at Such a Feature in View of Furrer (Grounds IV and V)

Petitioner challenges claims 16-21 by relying on Morris in view of Furrer (Ground IV).⁷ Neither Morris nor Furrer teaches or suggests a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. Moreover, a POSA would not have been motivated to arrive at such a feature in view of the cited references.

1. Morris and Furrer Fail to Teach or Suggest a Support Arm Connected to a Base Below the Main Hopper by a First Coupling Providing the Claimed Axes of Rotation

⁶ To the extent that Petitioner tries to rely on Morris (an optional reference in Ground I), which is not discussed with respect to this feature, Morris is deficient for the same reasons discussed in section VI.B.

⁷ Petitioner relies on an additional reference (*e.g.*, Baskerville) for certain dependent claims in Ground V. Petitioner cannot rely on Baskerville in Ground IV to challenge claim 16, as the Petition does not rely on these secondary references for claim 16. *See Henny Penny Corp.*, 938 F.3d at 1330.

Morris, like the countless other references considered by the Office, fails to teach or suggest a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. As alleged in the Petition, the support arm of Morris is attached to the corner of the air cart:



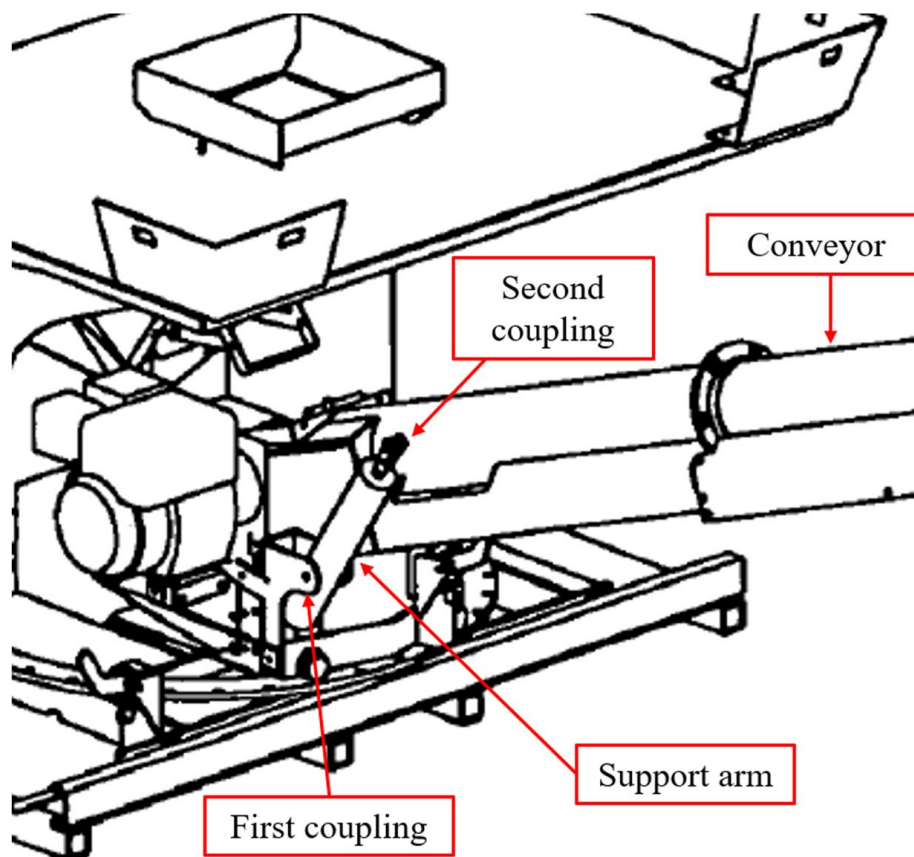
Pet. at 64; *see also* Ex. 1009 at 71. In fact, Petitioner acknowledges that Morris suffers from this deficiency. Pet. at 59 (“[I]n Morris, because the main hopper is not raised above the frame and the support arm is connected to the side of the main hopper, the conveyor cannot unload seed forwardly or rearwardly and has only one storage position (on the side).”). Moreover, the support arm of Morris cannot rotate about the claimed horizontal axis of rotation. Ex. 1009 at 71. In Morris, the support arm is affixed at that height and cannot be raised or lowered. *See id.*

Furrer fails to remedy the deficiency of Morris. Furrer does not teach a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. In fact, Furrer fails to teach a support arm. The Challenged Claims recite that the conveyor is coupled to the support arm such that the conveyor is able to rotate about the second coupling connecting the support arm to the conveyor. *See, e.g.*, Ex. 1001 at claim 16 (“a second coupling connecting said second end of said support arm with said conveyor at an approximate center of gravity of said conveyor, said second coupling defining a first conveyor axis of rotation that is not parallel to said conveyor longitudinal axis of rotation.”). The conveyor is thus able to rotate about the second end of the support arm between loading and unloading positions. *See id.*

Furrer does not teach or suggest the claimed support arm. In Furrer, there is no structure that is connected to the approximate center of gravity of the conveyor such that the conveyor can rotate about a first conveyor axis of rotation between the loading and unloading positions. Rather, in Furrer, the first end of the conveyor is affixed to the device and cannot rotate between a loading position and an unloading position. *See, e.g.*, Ex. 1007 at Figures. As a result, Furrer expressly and repeatedly characterizes the conveyor as “an unload conveyor.” *Id.* at Abstract, 3:21, 3:43, 3:64, 4:29, 5:8, 6:26-27. Thus, Furrer does not have a support arm for the conveyor, nor does Furrer have the claimed “second coupling connecting said second end of said

support arm with said conveyor at an approximate center of gravity of said conveyor, said second coupling defining a first conveyor axis of rotation” as required by the claims of the ’940 Patent. *See, e.g.*, Ex. 1001 at claim 16.

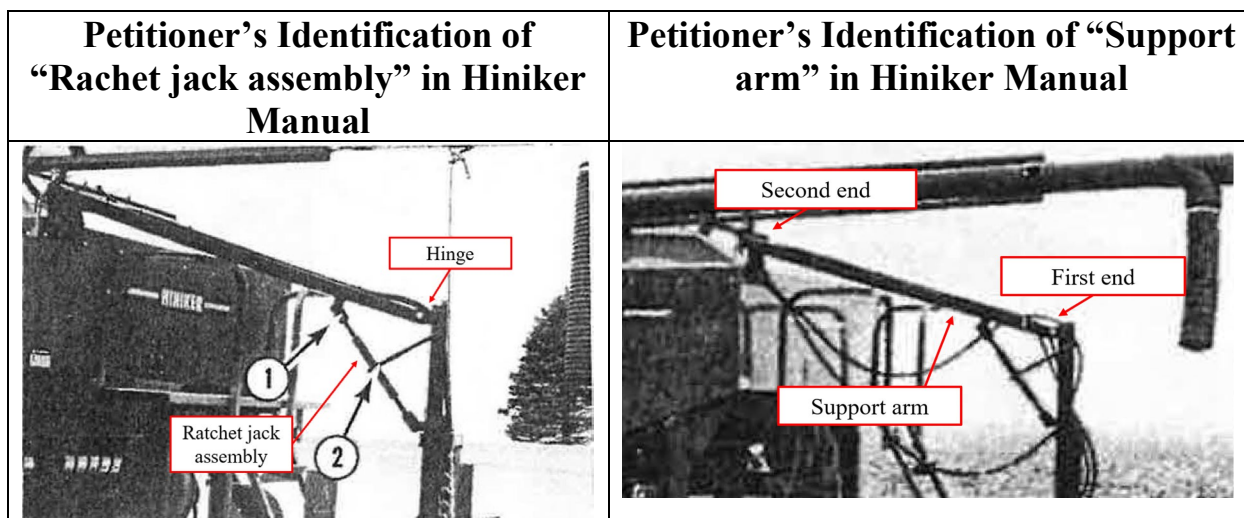
Petitioner incorrectly identifies the hydraulic piston in Furrer as the support arm:



Pet. at 41 (annotated version of Ex. 1007, FIG. 5). Petitioner fails to explain how the identified structure corresponds to the claimed support arm. It does not. The structure identified by Petitioner is a hydraulic piston that permits the conveyor to move up and down. This is a separate and distinct structure from the support arm as described

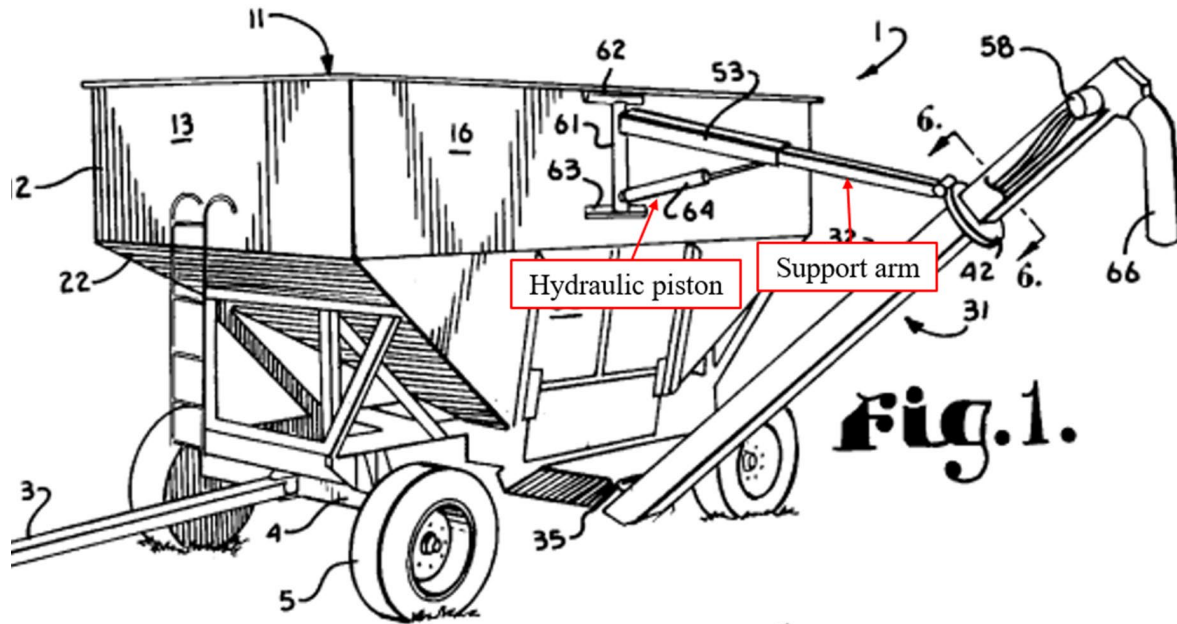
in the '940 Patent. Ex. 1001 at 3:51-53 (“Also shown, a hydraulic piston 405 is coupled with the support arm 102 for adjusting the height of the support arm 102.”).

On this point, the Petition is internally inconsistent. The “hydraulic piston” is a separately claimed component in the '940 Patent. *See, e.g.*, Ex. 1001, claim 22 (referring to a “hydraulic piston”). As Petitioner recognizes when discussing the other alleged prior art references, the support arm is distinguishable from the lift device used to adjust the height of the conveyor (*e.g.*, a ratchet jack or hydraulic cylinder). For example, when discussing the Hiniker Manual, Petitioner separately identifies the support arm, and the ratchet jack assembly used for raising and lowering the structure:



Pet. at 22, 20.

As another example, when discussing Baskerville, Petitioner separately identifies the support arm and hydraulic piston:



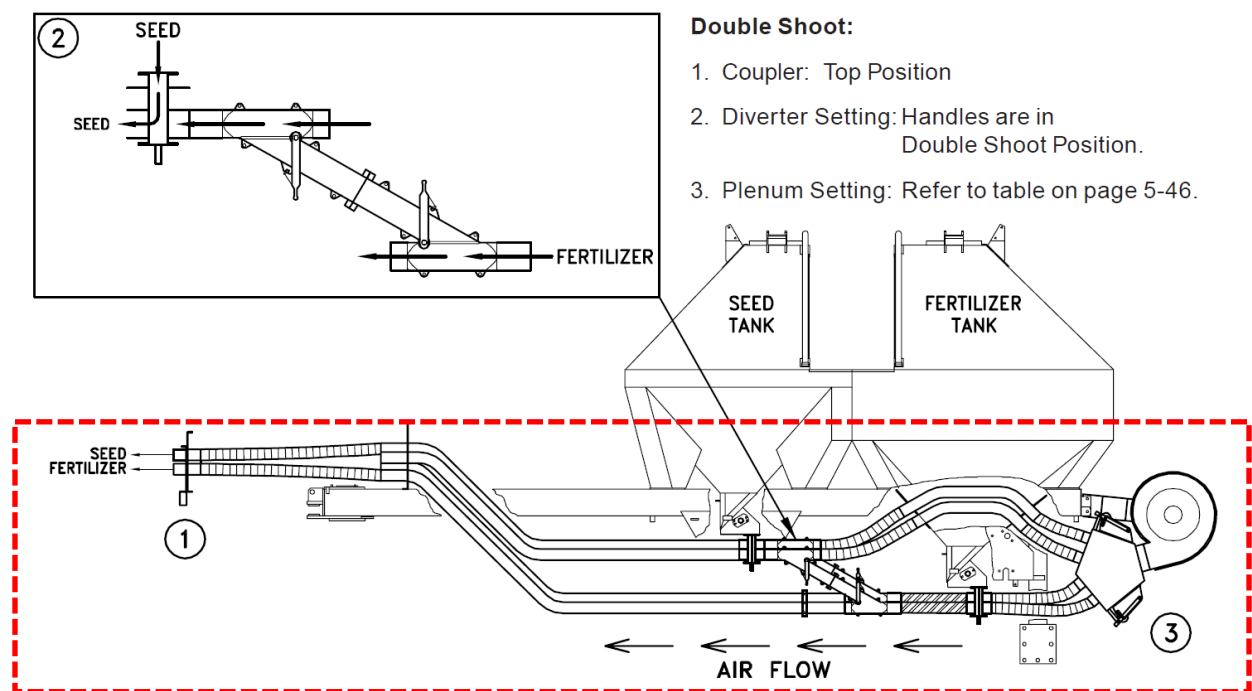
Id. at 47.

Furrer fails to remedy the deficiency of Morris and does not teach or suggest a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. Petitioner's misidentification of a support arm in Furrer is incorrect and internally inconsistent with the rest of its Petition. For this reason, among others, Petitioner's Grounds IV-V fail to establish a reasonable likelihood that Petitioner will prevail.

2. *A POSA Would Not Have Been Motivated to Modify Morris in View of Furrer to Arrive at a Support Arm Connected to a Base Below the Main Hopper by a First Coupling Providing the Claimed Axes of Rotation*

Even if Furrer did teach a support arm (it does not), a POSA would not have been motivated to modify Morris in view of Furrer. Morris (like the Hiniker Manual and Hiniker Webpage) is directed to a planting device. Specifically, Morris is an Air

Cart with an intended purpose of having “a full range of products like Canola to peas to be seeded without having to change the metering wheels.” Ex. 1009 at 37. To carry out Morris’ function (*i.e.*, planting seed), the device includes a series of components including hoses, blowers, and other structures located below the main hopper, which transport seed from the seed and fertilizer tank to the planting unit as illustrated in Morris:



Id. at 91 (annotated).

Petitioner proposes substantial and significant modifications to the primary reference (Morris) to arrive at a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. *See* Pet. at 57-62. Namely, Petitioner argues that “a skilled artisan would have been motivated to (1) raise the main hopper and create a space under it that is open on parts of three sides

(e.g., like Furrer does with its support module 12) and (2) add a rotatable base similar to Furrer's turret 28, with its vertical axis of rotation extending through the main hopper discharge, and connect the first end of the Morris support arm to that base" *Id.* at 57-58. Petitioner alleges that a POSA would have raised the hopper and removed the seed planting components, all in the name of an improper hindsight-driven recreation to arrive at the claimed invention. However, the base for the support arm could not have been relocated below the main hopper in these devices without removing critical planting components, which would render Morris unsatisfactory for its intended purpose. Ex. 1009 at 37. In fact, Petitioner goes so far in one instance to argue that "[a] skilled artisan would have been motivated to design a tender based on the Morris-Furrer combination, ***but without the seed planting components.***" Pet. at 62 (emphasis added). This is classic improper hindsight reconstruction.

Further, the Federal Circuit has repeatedly held that "[a] proposed modification [is] inappropriate for the obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose." *In re Fritch*, 972 F.2d 1260, 1265 n.12 (Fed. Cir. 1992); *see also Intel Corp. v. XMTT, Inc.*, IPR2020-00144, Paper 12 at 15 (P.T.A.B. May 20, 2020) (declining institution and stating "Petitioner provides no explanation as to why one of ordinary skill in the art would have been motivated to pick and choose portions of the teachings of

Nakamura while ignoring the primary focus (how to update the shared data registers).”); *Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 F. App’x 755, 760 (Fed. Cir. 2015) (“Because the Board did not err in finding that the prior art combinations would either alter Fukuta’s ‘principle of operation’ or render Jacobsen ‘inoperable for its intended purpose,’ we affirm the Board’s decision . . .”).

Moreover, Petitioner’s proposed modification is unsupported by the purported prior art as a whole. As discussed throughout, these references failed to teach or suggest a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. *See supra* sections VI to VI.B.1. The Federal Circuit has held that “[t]he factual inquiry whether to combine references must be thorough and searching,” and “[t]he need for specificity pervades [our] authority.” *In re Nuvasive, Inc.*, 842 F.3d 1376, 1381-82 (Fed. Cir. 2016) (*quoting In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002)). Petitioner’s allegations fall far short. Petitioner fails to identify any prior art teaching supporting its motivation. *See Pet.* at 57-61.

Instead, the basis for modifying the purported prior art to arrive at a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation is based on an impermissible attempt to recreate the claimed invention. However, “[t]o draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention

as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability.” *Sensionics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996). Ultimately, as Petitioner acknowledges, the planting devices disclosed in the Hiniker Manual and Morris are equipped with peripheral hardware for the purposes of *planting seed* that would have dissuaded a POSA from incorporating a support arm connected to a base below the main hopper. This is confirmed by the numerous references with a support arm attached to the side of the device, including those of Morris and Baskerville relied upon by Petitioner.

Thus, Petitioner fails to establish that the Morris-Furrer combination teaches or suggests a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. Moreover, the Petition fails to establish that a POSA would have been motivated to combine Morris and Furrer to arrive at the claimed design absent impermissible hindsight. For at least this reason, institution should be denied.

VII. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 325(D)

Discretionary denial under § 325(d) is appropriate where, as here, the Petition argues the “same or substantially the same art previously [] presented to the Office” and fails to demonstrate “that the Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics, LLC v. MED-EL*

Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential).

The Board uses a two-part framework for assessing discretionary denial under 35 U.S.C. § 325(d). *First*, the Board considers “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.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. *Second*, if the Board answers the first question in the affirmative, it then asks, “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.” *Id.* Here, both factors weigh in favor of discretionary denial.

The *Becton, Dickinson* factors provide insight for how to apply the *Advanced Bionics* two-part framework. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (P.T.A.B. Dec. 15, 2017) (precedential in relevant part). The *Becton, Dickinson* factors include: (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 prior art or arguments.

Id.

A. Institution Should Be Denied Because the Office Considered the Same and Substantially the Same Art (*Becton, Dickinson* Factors (a), (b), and (d))

Petitioner relies on six different references: (1) Hiniker Manual (Ex. 1004); (2) Hiniker Webpage (Ex. 1005); (3) Johnson (Ex. 1006); (4) Morris (Ex. 1009); (5) Furrer (Ex. 1007); and (6) Baskerville (Ex. 1008); Pet. at 1-2. Johnson is merely relied upon as an optional reference for teaching a belt conveyor is preferable to an auger. Pet. at 25-26. This teaching is cumulative to the same teaching in Furrer. *See, e.g.*, Ex. 1007 at 4:33-34 (“Although less desirable, the conveyor could be an auger.”). Of the remaining references, Baskerville and Furrer were cited and relied on by the Examiner. Ex. 1002 at 12-13. The remaining references are cumulative to those considered by the Examiner during prosecution of the ’940 Patent and parent ’047 Patent and the *inter partes* reexamination filed by Petitioner for the ’047 Patent.

1. Baskerville and Furrer Were Considered by the Office

Baskerville and Furrer were previously considered by the Office. *First*, contrary to Petitioner’s contention that “the examiner did not substantively evaluate, or base any rejections on, [Baskerville and Furrer] during prosecution of the ’940

Patent,” Pet. at 85, Applicant submitted an information disclosure statement identifying both Baskerville and Furrer. Ex. 1002 at 12-13. The Examiner considered all the prior art references and filings identified in the information disclosure statement. *Id.* at 9.

Second, during prosecution for the parent ’047 Patent, the Examiner rejected the claims over Furrer and Baskerville. Ex. 1012 at 68, 104, 162, 190. Patent Owner successfully overcame these references during prosecution, and the Examiner relied on Patent Owner’s arguments as a bases for allowance. *Id.* at 19. Thus, the Office has already expressly considered Furrer and Baskerville.

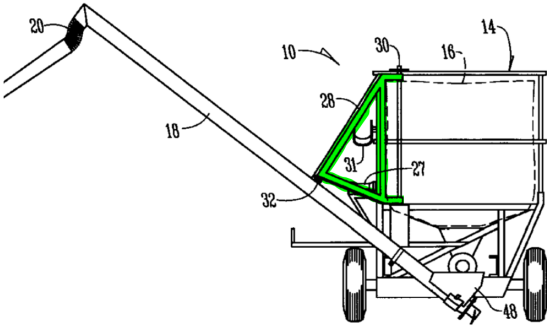
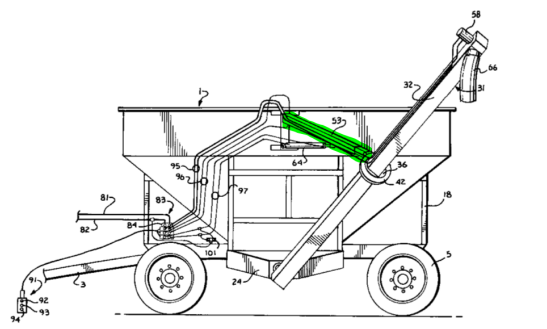
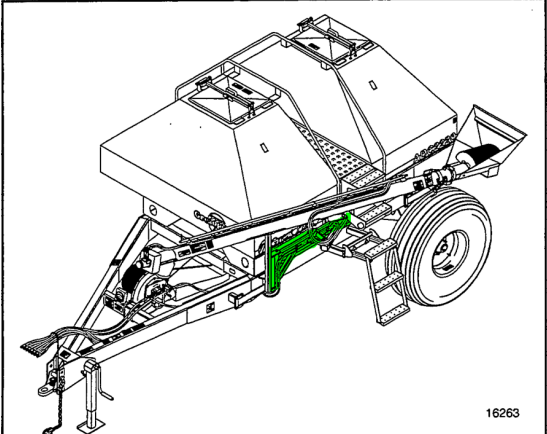
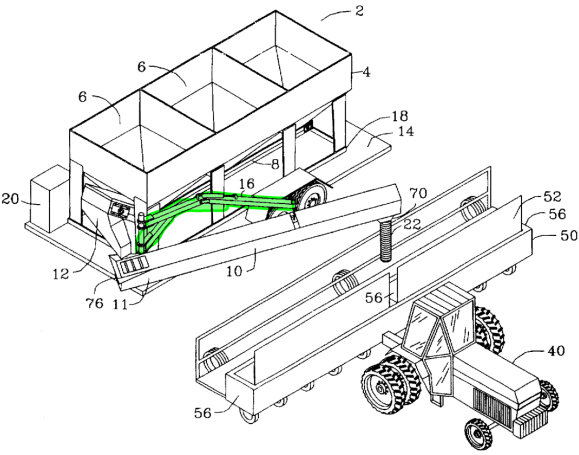
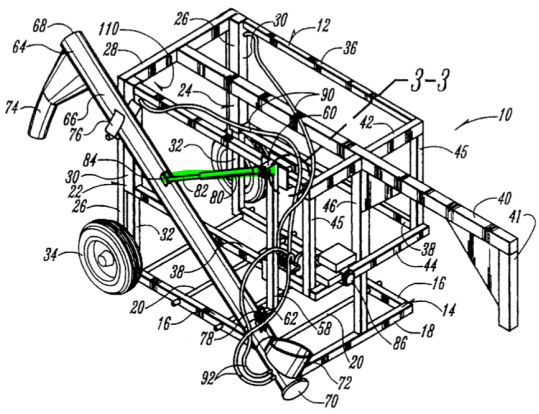
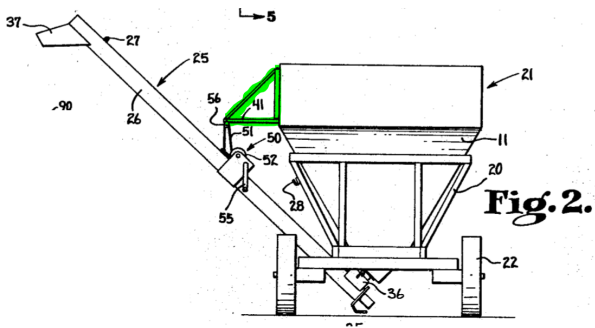
2. The Hiniker Manual, Hiniker Webpage, and Morris are Cumulative to Art Considered by the Office

While the Hiniker Manual and Hiniker Webpage, which both relate to the same device, and Morris were not expressly considered by the Office during prosecution of the ’940 Patent, these references are cumulative of art previously considered by the Office. Moreover, a prior version of the Hiniker Manual and other documents relating to the Hiniker Air Seeder were considered by the Examiner during prosecution of the child ’123 Patent. *See* Ex. 2024 at 151-406.

Newly asserted art is “cumulative” when the art’s relevant teachings provide nothing more than what was taught by previously presented prior art. *See Gardner Denver v. Utex Industries, Inc.*, IPR2020-00333, Paper 12 at 13-14 (P.T.A.B. Aug. 5, 2020) (denying institution upon finding that newly asserted references Kalsi and

Kohl are no more relevant than references that were presented during prosecution); *Roku, Inc. v. Universal Elecs., Inc.*, IPR2019-01619, Paper 11 at 16-17 (P.T.A.B. April 2, 2020) (denying institution upon finding that newly applied Zetts was cumulative to previously presented Kim); *Evapco Dry Cooling, Inc., v. SPG Dry Cooling USA*, IPR2021-00687, Paper 11 at 24-25 (P.T.A.B. Sep. 24, 2021) (finding a newly asserted reference not cited during prosecution as being substantially the same as the references that were before the Examiner during prosecution).

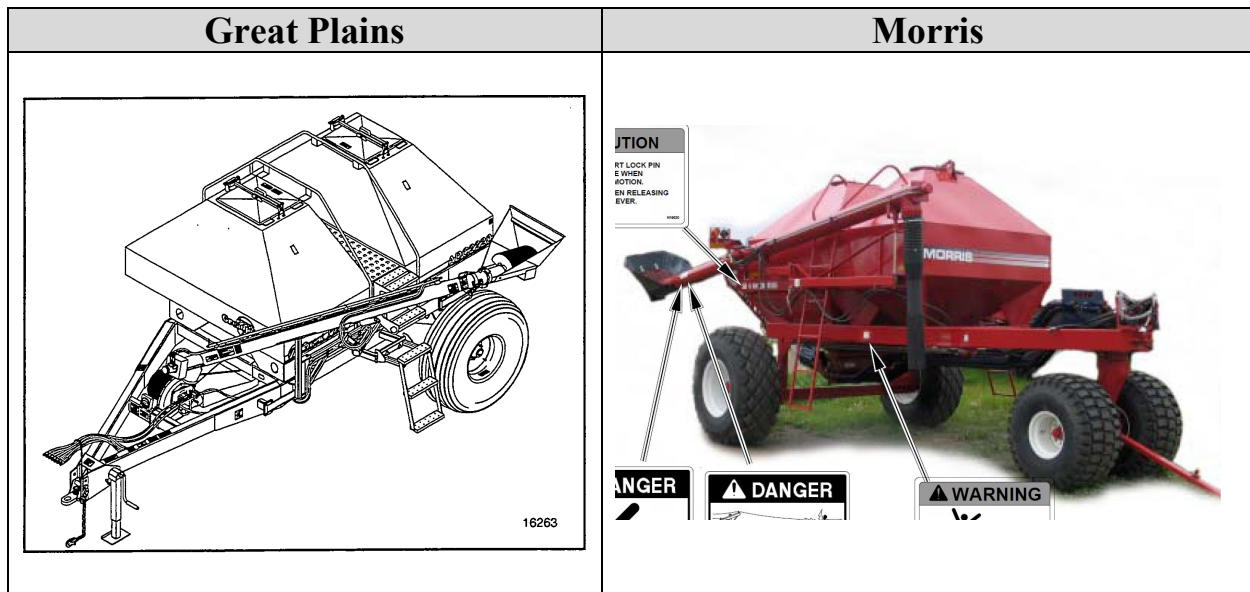
The Hiniker Manual, Hiniker Webpage, and Morris are substantially the same as the numerous other references considered by the Office during prosecution of the '940 Patent. Each of these references, like those references previously considered by the Office (*e.g.*, Adam (Ex. 2017), Baskerville (Ex. 1008), Great Plains Air Drill Cart (Ex. 2019), Forsyth (Ex. 2020), Sukup (Ex. 2021), and Meharry (Ex. 2022)), teaches an agricultural device having a conveyor attached to the side of a piece of agricultural equipment. Each of these references fails to teach or suggest a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation as illustrated below. *See also infra* section VI.

Adam	Baskerville
	
Great Plains	Forsyth
	
Sukup	Meharry
	 Fig. 2.

Ex. 2017, FIG. 1; Ex. 1008, FIG. 9; Ex. 2019, 1; Ex. 2020, FIG. 1; Ex. 2021, FIG. 1; Ex. 2022, FIG. 2 (all annotated).

Indeed, Petitioner fails to identify any material differences between the references relied upon in its Petition and the references previously considered by the Office, and instead relies solely on the fact that they were not “before the examiner.” Pet. at 85. In similar cases, the Board has found references “structured substantially identically to those previously considered by the Office” as previously considered art. *Dropworks, Inc. v. The University of Chicago*, IPR2021-00100, Paper 9 at 13-14 (P.T.A.B. May 14, 2021).

The references relied upon in the instant challenge are also substantially the same as those previously relied upon by Petitioner in its failed challenge to the parent ’047 Patent. In that prior *inter partes* reexamination, Petitioner relied on the Great Plains Air Drill Cart (called “GPM-2000” in that proceeding) as a primary reference. Ex. 1013 at 79-100; *see also id.* at 46-60. A side-by-side comparison of the Great Plains Air Drill Cart and Morris air drill cart are provided below:



Compare Ex. 2019 at 1 with Ex. 1009 at 18. The Great Plains Air Drill Cart, like Morris and the Hiniker Manual device, are planting devices, not seed tenders. Additionally, each of these references fails to teach or suggest a support arm connected to a base *below* the main hopper by a first coupling providing the claimed axes of rotation. Petitioner appears to tacitly acknowledge that the references it relies on now (e.g., Hiniker Manual, Hiniker Webpage, and Morris) are cumulative to those that it relied on in the prior reexamination proceeding. Pet. at 85-88. Petitioner emphasizes the deficiencies in the arguments that *it* previously submitted in the failed *inter partes* reexamination. Pet. at 87-88.

Accordingly, the teachings in Hiniker Manual, Hiniker Webpage, and Morris are cumulative to the art previously considered by the Office during prosecution of the '940 Patent, parent '047 Patent, and Par-Kan's failed prior *inter partes* reexamination challenge of the '047 Patent. For example, Great Plains

Manufacturing, Baskerville, Adam, Sukup and Meharry are substantially the same as the teachings in Hiniker Manual, Hiniker Webpage, and Morris upon which Petitioner now relies.

B. Petitioner Failed to Show that the Office Materially Erred (*Becton, Dickinson* Factors (c), (e), and (f))

Because substantially the same art was previously presented to the Office, Petitioner must show that the Office erred in a manner material to the patentability of the Challenged Claims. “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*, IPR2019-01469, Paper 6 at 8 n.9.

The Petition fails to sufficiently identify any error material to the patentability of the challenged claims. In fact, Petitioner appears to concede that it agrees with the Examiner’s interpretation of the prior art. Pet. at 87-88. To the extent the Petition addresses any material error, it refers to its own prior error. Namely, Petitioner points to its prior failure to sufficiently articulate a motivation to modify the references in the prior *inter partes* reexamination proceeding. *Id.* (“unlike the request for *inter partes* reexamination, which the examiner faulted for not explaining why or how a skilled artisan would have modified the primary references in view of Baskerville, this petition explains for each ground why and how a skilled artisan would have

modified the primary reference in view of the secondary reference.”). Petitioner should not get a second bite at the apple, and moreover, the articulated motivations remain clearly deficient in the instant Petition. *See supra* section VI.

Patent Owner respectfully submits that the Office did not commit any error during prosecution of the '940 Patent or parent '047 Patent, during the prior *inter partes* reexamination of the '047 Patent, or during prosecution of the '123 Patent. Accordingly, the Board should discretionarily deny institution under 35 U.S.C. § 325(d).

VIII. MORRIS AND THE HINIKER WEBPAGE ARE NOT PRIOR ART TO CHALLENGED CLAIMS 16-22 OF THE '940 PATENT

Patent Owner respectfully submits that institution should be denied for the numerous reasons set forth above. However, a separate and independent basis exists for denying institution: the Petition relies on references that are not prior art to the claims of the '940 Patent. Grounds I-III each rely on the Hiniker Webpage for teaching, *inter alia*, the unloading limitation in all Challenged Claims as part of the *prima facie* obviousness case for claim 16. *See e.g.*, Pet. at 1, 32-33. Additionally, the Petition relies on Morris as an alternative reference for teaching the unloading limitation in Ground I. *See* Pet. at 33-36. Petitioner's challenges under Grounds I-III are fatally flawed, because neither the Hiniker Webpage nor Morris is prior art to claims 16-22. The Petition alleges that the Hiniker Webpage was publicly available

on March 14, 2006. *Id.* at 2, 11. Additionally, the Petition alleges Morris was publicly available August 13, 2006. Pet. at 1-2, 54. As discussed in this Section and the Declarations of Mr. Brian James Petersen, Ex. 2001, and Mr. Shawn Gerdeman, Ex. 2002, the invention covered by claims 16-22 was actually reduced to practice prior to the alleged publication date of the Hiniker Webpage and Morris (*i.e.*, prior to March 14, 2006). Ex. 2001; Ex. 2002. Since neither the Hiniker Webpage nor Morris is prior art, the challenges to claims 16-22 in Grounds I-III fail.

Additionally, Grounds IV-V rely on Morris, which the Petition alleges was publicly available August 13, 2006. Pet. at 1-2, 54. As discussed in this Section and the Declarations of Mr. Petersen and Mr. Gerdeman, the invention covered by claims 16-22 was actually reduced to practice prior to the alleged publication date of Morris (*i.e.*, August 13, 2006). Ex. 2001; Ex. 2002. Since Morris is not prior art, the challenges to claims 16-22 in Grounds IV and V fail.

Petitioner fails to explain how the Hiniker Webpage and Morris are prior art despite being aware of Unverferth's development of an embodiment of the claims prior to the alleged publication dates of these references. In a prior litigation, Petitioner challenged the related '047 Patent and alleged that the claims were invalid for prior public use, offer for sale or sale. Ex. 2034 ¶ 3. In fact, the '940 Patent prosecution history addresses these allegations and discusses the first public display of the unit at the National Farm Machinery Show in Louisville, Kentucky on

February 15, 2006 (the “Louisville Show”). *See id.* ¶ 17. The ’940 Patent prosecution history further discusses the testing of two prototype units at farms in April 2006. *See id.* at ¶¶ 4-13.

A patent owner may disqualify a patent reference as prior art by demonstrating a date of invention prior to the reference’s filing date (or priority date, if earlier). 37 C.F.R. § 1.131(a); MPEP § 715. A prior date of invention may be established by “actual reduction to practice” prior to the reference’s filing date or by “conception” prior to the reference’s effective date and “diligence” in reducing the conceived invention to practice. 37 C.F.R. § 1.131(b); MPEP § 715. To establish prior invention by actual reduction to practice, a patent owner must show: (1) the existence of a physical embodiment meeting all limitations of the challenged claims; (2) that the invention would work for its intended purpose; and (3) sufficient evidence to corroborate the inventor’s testimony. *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1169 (Fed. Cir. 2006).

“In order to establish an actual reduction to practice, an inventor’s testimony must be corroborated by independent evidence.” *Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998). “Sufficiency of corroboration is determined by using a ‘rule of reason’ analysis, under which all pertinent evidence is examined when determining the credibility of an inventor’s testimony.” *Medichem*, 437 F.3d at 1170. “Independent corroboration may consist of testimony of a witness, other than the

inventor, to the actual reduction to practice or it may consist of evidence of surrounding facts and circumstances independent of information received from the inventor.” *Id.*

As set forth below, the subject matter of claims 16-22 was actually reduced to practice (i) before February 15, 2006; (ii) no later than February 18, 2006; (iii) no later than February 28, 2006; and (iv) no later than May 16, 2006.

A. The Seed Runner 3500 Prototype Was Designed, Manufactured, and Confirmed to Work for Its Intended Purpose Before February 15, 2006

Mr. Brian Petersen and Mr. Dave Smith, the inventors of the '940 Patent, conceived of the design for a new seed tender that would become the subject matter of the '940 patent no later than November 2005. Ex. 2001 ¶ 12. Mr. Petersen worked with the Unverferth in-house Prototype Department to construct a prototype of the Unverferth Seed Runner 3500 prototype between November 2005 and early February 2006. *See id.* ¶ 14. Mr. Shawn Gerdeman, an Unverferth employee who was the Project Manager for the new seed tender product, corroborates Mr. Petersen's testimony that the prototype was reduced to practice in early February 2006. Ex. 2002 ¶ 8. The Seed Runner 3500 prototype was completed shortly before the Louisville Show, which took place from February 15-18, 2006. Ex. 2001 ¶ 15; Ex. 2002 ¶ 8.

Prior to the shipment of the prototype unit to the Louisville Show (*i.e.*, shortly before February 15, 2006), Mr. Petersen and Mr. Gerdeman confirmed that the Seed Runner 3500 prototype worked properly for its intended purpose. Ex. 2001 ¶ 15; Ex. 2002 ¶ 8. Both individuals' testimony confirms that they operated the device to ensure that the Seed Runner 3500 prototype would work for demonstrations during the Louisville Show. Ex. 2001 ¶¶ 16-17; Ex. 2002 ¶¶ 8-9. It was important that Mr. Gerdeman knew how the prototype functioned before the Louisville Show so that he could demonstrate it to attendees and answer any questions he might receive. Ex. 2001 ¶ 17; Ex. 2002 ¶ 8. As such, prior to the shipment of the prototype to the show, Mr. Petersen and Mr. Gerdeman operated the device and moved the support arm and conveyor up-and-down and side-to-side. Ex. 2001 ¶¶ 16-17; Ex. 2002 ¶ 9. Mr. Petersen and Mr. Gerdeman also ran the conveyor belt to ensure that the conveyor belt would work. Ex. 2001 ¶¶ 16-17; Ex. 2002 ¶ 9. Additionally, Mr. Petersen and Mr. Gerdeman moved the conveyor from the unloading position to the loading position as described in the '940 Patent claims. Ex. 2001 ¶¶ 16-17; Ex. 2002 ¶ 9. Mr. Petersen and Mr. Gerdeman also confirmed that the wheel handle mechanism was operational and able to open the main hopper discharge doors, which holds and releases seed into the conveyor hopper. Ex. 2001 ¶¶ 16-17; Ex. 2002 ¶ 9.

B. The Seed Runner 3500 Prototype Was Designed, Manufactured, and Confirmed to Work for Its Intended Purpose No Later Than February 18, 2006

Mr. Petersen and Mr. Gerdeman also both provide testimony that the device was first publicly displayed at the Louisville Show, which they both attended. Ex. 2001 ¶ 19; Ex. 2002 ¶ 11. During the show held between February 15 and 18, 2006, Mr. Petersen and Mr. Gerdeman confirm that the Seed Runner 3500 prototype was operated and demonstrated to the public. Ex. 2001 ¶¶ 19-20; Ex. 2002 ¶¶ 11-12. During the demonstrations, the support arm and conveyor were moved side-to-side and up-and-down, and the conveyor was positioned between loading and unloading positions. Ex. 2001 ¶ 20; Ex. 2002 ¶ 12.

Ex. 2027 contains photographs of the Seed Runner 3500 at the Louisville Show in 2006. Mr. Petersen and Mr. Gerdeman confirm that the Seed Runner 3500 was shown at this event and that the photographs accurately depict the first prototype as it was shown at this event. Ex. 2001 ¶ 19; Ex. 2002 ¶ 11. As illustrated in the photographs, the conveyor was capable of being moved from a loading position to an unloading position. Ex. 2001 ¶ 20; Ex. 2002 ¶ 12.

Ex. 2028 is marketing material for the Seed Runner 3500 that was prepared and distributed at the 2006 Louisville Show. The marketing material includes photographs of the Seed Runner 3500 in different positions showing its operability. Ex. 2001 ¶ 21; Ex. 2002 ¶ 13. Mr. Petersen and Mr. Gerdeman confirm that these

photographs depict the Seed Runner 3500 in positions similar to those that they tested prior to February 15, 2006. Ex. 2001 ¶ 21; Ex. 2002 ¶ 13. Moreover, Mr. Gerdeman testified that he distributed the marketing material to the public at the Louisville Show. Ex. 2002 ¶ 13.

Ex. 2029 is a publication distributed to employees of Patent Owner and friends of the company. Ex. 2029 reports on the successful display of the Seed Runner 3500 at the Louisville Show in February 2006. Mr. Petersen and Mr. Gerdeman testified that the publication is a true and accurate publication. Ex. 2001 ¶ 22; Ex. 2002 ¶ 14.

C. The Prototype Was Further Tested at Unverferth's Facility in Kalida, Ohio and Confirmed to Work for Its Intended Purpose No Later Than February 28, 2006

After the Louisville Show, the Seed Runner 3500 prototype was returned to Unverferth's facility in Kalida, Ohio. Ex. 2001 ¶ 24; Ex. 2002 ¶ 16. Mr. Petersen and Mr. Gerdeman conducted additional testing, including running seed through the conveyor in both the load and unload configurations. Ex. 2001 ¶ 24; Ex. 2002 ¶ 16. Ex. 2030 are true and accurate photographs of the prototype on the lot at Unverferth's facility, which were uploaded to Unverferth's computer systems on February 28, 2006. Ex. 2001 ¶ 24; Ex. 2002 ¶ 16. Ex. 2035 are true and accurate screenshots of the metadata showing the photographs in Ex. 2030 were uploaded to Unverferth's computer systems on February 28, 2006. Ex. 2035; Ex. 2001 ¶ 24. Certain photographs show seed dust remanence on the conveyor discharge and in

the flap below the main hopper discharge. Ex. 2001 ¶ 24; Ex. 2002 ¶ 16 (discussing Ex. 2030 at 9-13). These photographs confirm that seed had been run through the device. Ex. 2001 ¶ 24; Ex. 2002 ¶ 16; Ex. 2030 at 9-13. Additionally, certain photos show corn in the conveyor hopper, again confirming that corn had been run through the machine by February 28, 2006. Ex. 2001 ¶ 25; Ex. 2002 ¶ 17 (discussing Ex. 2030 at 14-15). These photographs further depict Mr. Petersen operating the device, including moving the support arm between various positions. Ex. 2001 ¶ 26; Ex. 2002 ¶ 18; Ex. 2030 at 2-8.

Further, Mr. Petersen and Mr. Gerdeman testified that the first prototype, as shown in Exs. 2027, 2028, and 2029, had a metal conveyor hopper. Ex. 2001 ¶ 27; Ex. 2002 ¶ 19. The first prototype was the only Seed Runner unit that Unverferth manufactured with a metal conveyor hopper. Ex. 2001 ¶ 27; Ex. 2002 ¶ 19. The metal conveyor hopper was eventually replaced with a vinyl version (*see* Ex. 2031 at 6), which was the version used for large scale testing at two farms in April and May 2016, as discussed below. Ex. 2001 ¶ 27; Ex. 2002 ¶ 19. This testimony further confirms that the photographs in Ex. 2030 were of the first prototype that was completed in early February 2006. Ex. 2001 ¶ 27; Ex. 2002 ¶ 19.

Thus, Mr. Petersen and Mr. Gerdeman's testimony confirms that further testing was conducted no later than February 28, 2006, which further demonstrated

that the Seed Runner 3500 worked for its intended purpose. Ex. 2001 ¶ 28; Ex. 2002 ¶ 20.

D. The Seed Runner 3500 Was Confirmed to Work For its Intended Purpose on a Farm No Later Than May 16, 2006

By April 2006, Unverferth manufactured a second Seed Runner 3500 prototype. Ex. 2001 ¶ 29; Ex. 2002 ¶ 21. The two Seed Runner 3500 prototypes were shipped to two farms: (1) a farm located in Holland, Michigan; and (2) a farm located in Dixon, Illinois. Ex. 2001 ¶ 30; Ex. 2002 ¶¶ 22, 24. Mr. Gerdeman provides testimony regarding shipping records that confirm the shipment of these two prototype units to farms on April 13, 2006 and April 19, 2006, and these units are further discussed in the Gerdeman declaration submitted to the USPTO during prosecution of the '940 Patent. Ex. 2002 ¶ 23; Ex. 2034 ¶¶ 4-13; *id.* at 8, 10. Mr. Petersen and Mr. Gerdeman travelled to both of these farms in May 2006 to observe the operation of the Seed Runner 3500 prototypes on a large scale farm. Ex. 2001 ¶ 31; Ex. 2002 ¶ 25.

In May 2006, Mr. Petersen and Mr. Gerdeman travelled to the farm in Michigan to see the device being operated on a large-scale farm. Ex. 2001 ¶ 31; Ex. 2002 ¶ 25. Ex. 2031 contains photographs of the Seed Runner 3500 prototype in operation at the farm in Michigan. Ex. 2001 ¶ 32; Ex. 2002 ¶ 26. Mr. Petersen and Mr. Gerdeman provide testimony, and the photographs confirm, that the prototype was operating for its intended purpose, including loading seed into the unit in the

loading position and unloading seed from the unit in the unloading position. Ex. 2001 ¶ 33; Ex. 2002 ¶¶ 27-28. These photographs also show the support arm and the conveyor at different horizontal and vertical positions in both the loading and unloading positions. Ex. 2031 at 1, 2, 4; Ex. 2001 ¶ 33; Ex. 2002 ¶ 28.

On May 16, 2006, Mr. Petersen and Mr. Gerdeman travelled to the farm in Dixon, Illinois. Ex. 2001 ¶¶ 31, 34; Ex. 2002 ¶¶ 25, 29. Mr. Petersen and Mr. Gerdeman provide testimony that they observed the Seed Runner 3500 unit working for its intended purpose including loading and unloading seed from the device at the farm in Dixon, Illinois. Ex. 2001 ¶ 34; Ex. 2002 ¶ 29. Mr. Gerdeman wrote a report discussing his visit with Mr. Petersen on May 16, 2006. As stated in the report, the “[c]ustomer used SeedRunner on 6000 acres of corn.”⁸ Ex. 2032 at 1; Ex. 2001 ¶ 34; Ex. 2002 ¶ 29.

⁸ As Mr. Petersen and Mr. Gerdeman discuss in their declarations, a farmer encountered an issue where the cleats of the conveyor belt were rubbing against the bottom side of the housing of the conveyor. Ex. 2001 ¶ 34; Ex. 2002 ¶ 29. This issue was easily remedied (the farmer clipped the cleats to gain clearance) by modifying the belt before commercialization. Ex. 2001 ¶ 34; Ex. 2002 ¶ 29. However, the machine was still operating for its intended purpose at and before testing on the farms despite this issue. Ex. 2001 ¶ 34; Ex. 2002 ¶ 29; *see Loral Fairchild Corp. v.*

Thus, Mr. Petersen and Mr. Gerdeman confirm that the Seed Runner 3500 prototypes worked for their intended purpose no later than May 16, 2006. Ex. 2001 ¶ 35; Ex. 2002 ¶ 31.

E. The Seed Runner 3500 Prototype Was an Embodiment of Claims 16-22

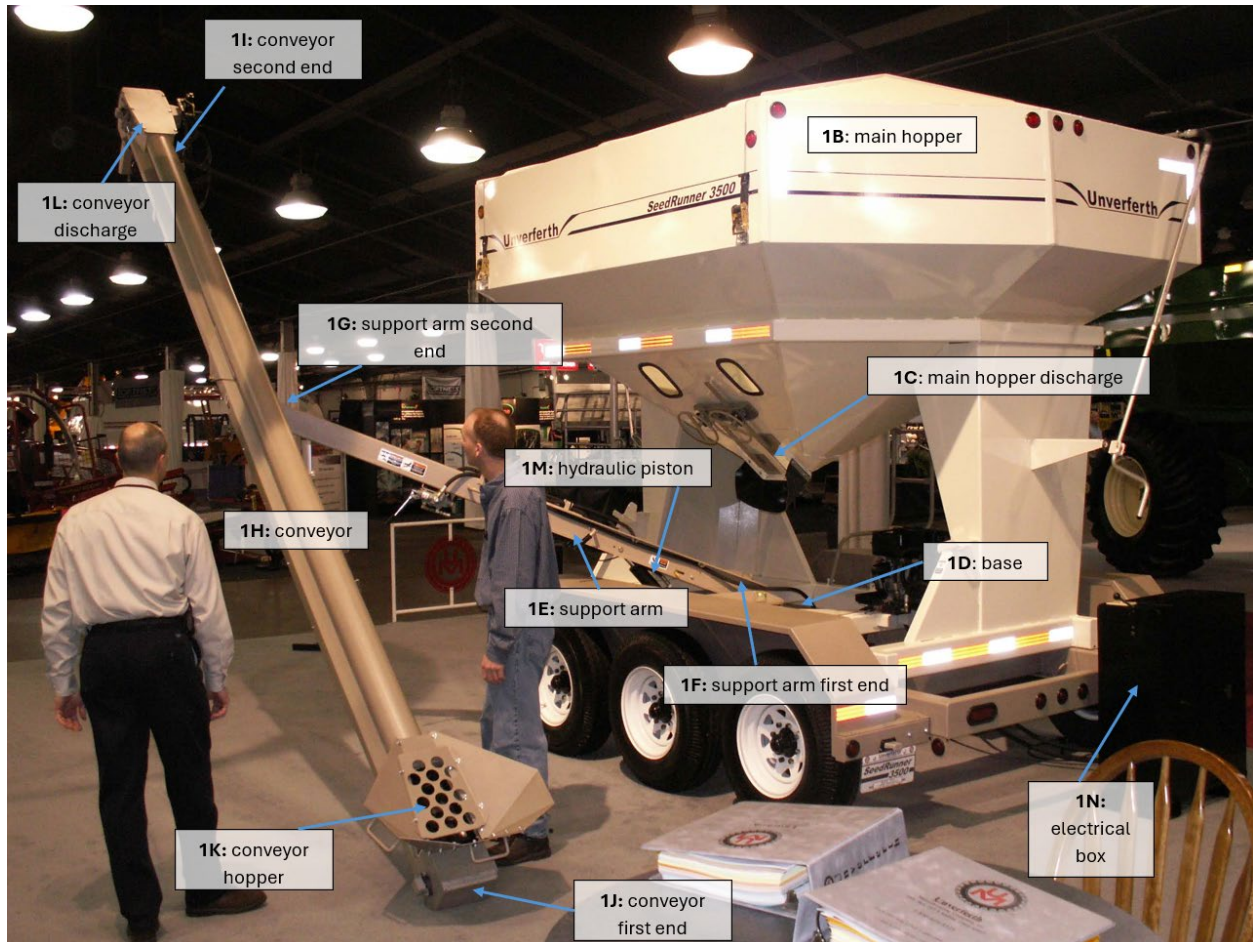
Mr. Petersen provides testimony that the Seed Runner 3500 prototype incorporated all of the features of claims 16-22 of the '940 Patent. Ex. 2001 ¶ 36. This is further corroborated by annotated photographs of the Seed Runner 3500 prototype at the Louisville Show on February 15-18, 2006 and photographs of the device from February 28, 2006. Ex. 2033 (annotated photographs from Exs. 2027 and 2030). An explanation of each claim feature as it relates to the Seed Runner 3500 is provided below.

Matsushita Elec., 266 F.3d 1358, 1362-63 (Fed. Cir. 2001) (“Once the invention has been shown to work for its intended purpose, reduction to practice is complete. Further efforts to commercialize the invention are simply not relevant to determining whether a reference qualifies as prior art against the patented invention.”); M.P.E.P. § 2138.05 at II (“For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development.”) (*citing Scott v. Finney*, 34 F.3d 1058, 1062 (Fed. Cir. 1994)).

1. Claim 16

“A seed or grain tender”: The Seed Runner 3500 prototype was a seed or grain tender, as shown below in Figure 1. Ex. 2001 ¶ 39.

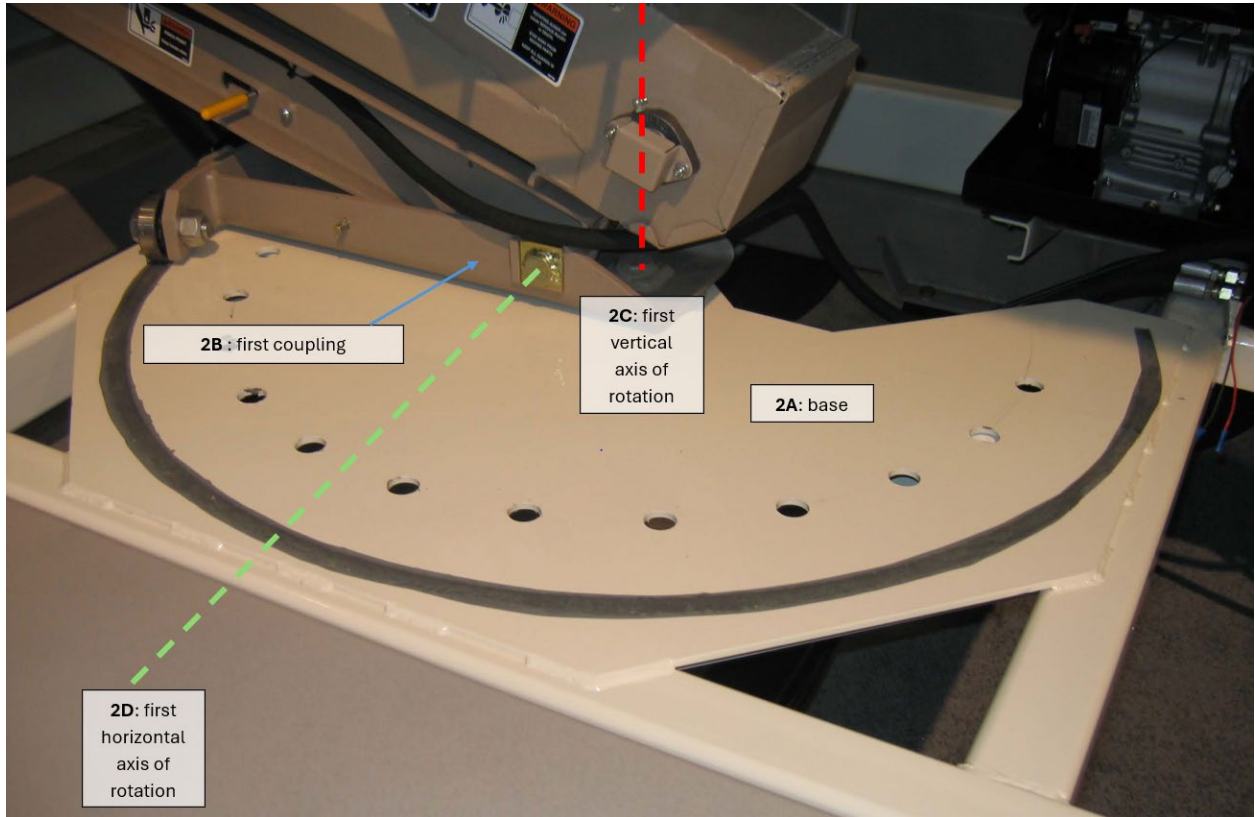
FIGURE 1 (Ex. 2033 at 1)



“comprising: a main hopper having a main hopper discharge”: The Seed Runner 3500 prototype comprised a main hopper as shown in Figure 1 at 1B (*see also* Figure 4 at 4D and Figure 5 at 5B) with a main hopper discharge located at its bottom, as shown in Figure 1 at 1C (*see also* Figure 4 at 4C). Ex. 2001 ¶ 40.

“a base positioned below said main hopper”: The Seed Runner 3500 prototype comprised a base positioned below the main hopper, as shown in Figure 1 at 1D (*see also* Figure 2 at 2A). Ex. 2001 ¶ 41.

FIGURE 2 (Ex. 2033 at 2)



“a support arm having first and second ends”: The Seed Runner 3500 prototype comprised a support arm as shown in Figure 1 at 1E (*see also* Figure 3 at 3D). The support arm also had a first and second end, as shown in Figure 1 at 1F and 1G respectively. Ex. 2001 ¶ 42.

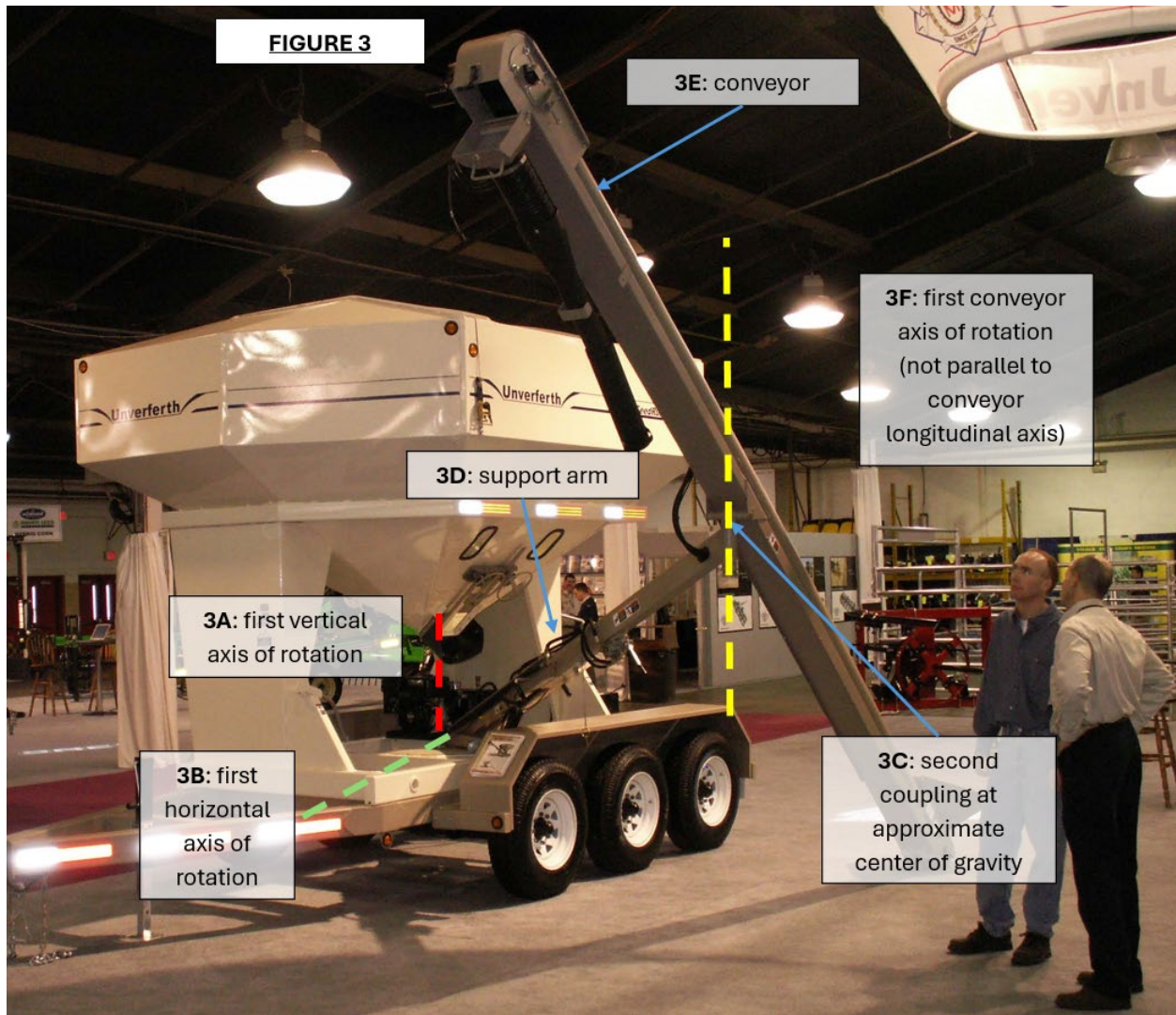
“a first coupling connecting said first end of said support arm with said base”: The Seed Runner 3500 prototype comprised a support arm where a first coupling

connected the first end of the support arm with the base, as shown in Figure 2 at 2B.

Ex. 2001 ¶ 43.

“said first coupling being rotatable about a first vertical axis of rotation, and said first end of said support arm being rotatable about a first horizontal axis of rotation”: The Seed Runner 3500 prototype had a first coupling that was rotatable around a first vertical axis of rotation, as shown by the dashed red line in Figure 2 at 2C and Figure 3 at 3A. Further, the prototype comprised a support arm that was rotatable around a horizontal axis of rotation, as shown by the dashed green line in Figure 2 at 2D and Figure 3 at 3B. Ex. 2001 ¶ 44.

FIGURE 3 (Ex. 2033 at 3)



“a conveyor having a longitudinal axis and first and second ends, a conveyor hopper at said first end, and a conveyor discharge at said second end”: The Seed Runner 3500 prototype had a conveyor with a longitudinal axis, as shown in Figure 1 at 1H (see also Figure 3 at 3E). Further, the conveyor had first and second ends, as shown in Figure 1 at 1I and 1J. The conveyor also had a conveyor hopper at the first end, as shown in Figure 1 at 1K (see also Figure 4 at 4B). Finally, the conveyor

had a conveyor discharge at the second end, as shown in Figure 1 at 1L. Ex. 2001 ¶ 45.

“a second coupling connecting said second end of said support arm with said conveyor at an approximate center of gravity of said conveyor”: The Seed Runner 3500 prototype had a second coupling (as shown in Figure 3 at 3C) connecting the second end of the support arm (as shown in Figure 3 at 3D) with the conveyor (as shown in Figure 3 at 3E) at the approximate center of gravity of the conveyor (as shown in Figure 3 at 3C). Ex. 2001 ¶ 46.

“said second coupling defining a first conveyor axis of rotation that is not parallel to said conveyor longitudinal axis”: The Seed Runner 3500 prototype had a second coupling that made for an axis of rotation of the conveyor that was not parallel to its longitudinal axis, as shown by the dashed yellow line in Figure 3 at 3F. Ex. 2001 ¶ 47.

“and said conveyor being rotatable about said first conveyor axis of rotation between an unloading position wherein said conveyor hopper is disposed below said main hopper discharge to receive agricultural product from said main hopper”: The Seed Runner 3500 prototype had a conveyor that was rotatable about the first conveyor axis of rotation, as shown by comparing Figure 3 at 3F to Figure 4 at 4A. Further the conveyor was capable of rotating to an unloading position (as shown in Figure 4 generally) where the conveyor hopper (as shown in Figure 4 at 4B) is

disposed below the main hopper discharge (as shown in Figure 4 at 4C) to receive agricultural product from the main hopper (as shown in Figure 4 at 4D). Ex. 2001 ¶ 48.

FIGURE 4 (Ex. 2033 at 4)

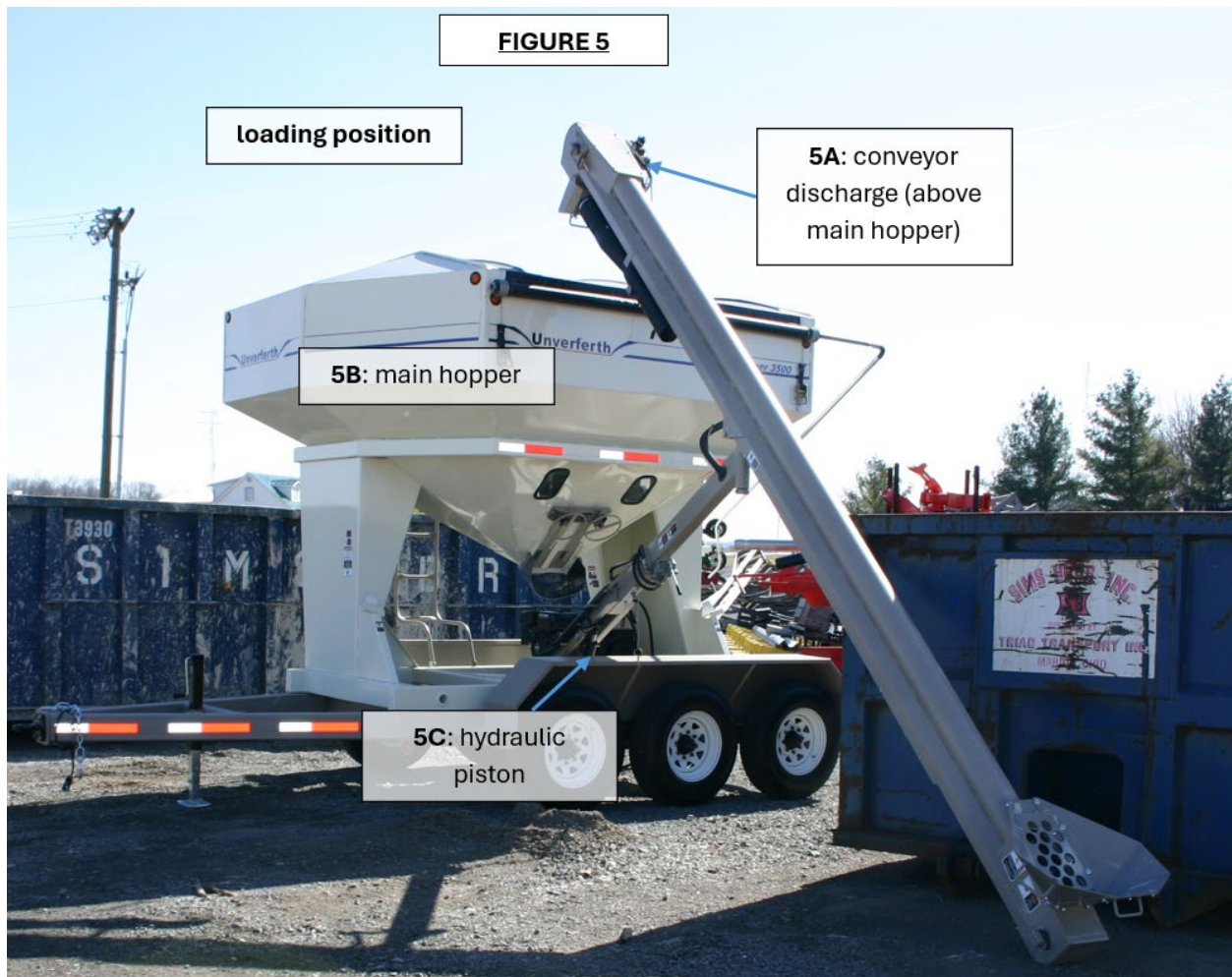


Figures 1 and 3 also show that the prototype was capable of rotating about the first conveyor axis of rotation to an unloading position, when the conveyor at the position as shown in Figures 1 and 3 is rotated further counterclockwise. Ex. 2001 ¶ 48.

“and a loading position wherein said conveyor discharge is disposed above said main hopper to dispense agricultural product into said main hopper”: The Seed Runner 3500 prototype was also capable of rotating about the first conveyor axis of

rotation to a loading position (as shown in Figure 5 generally) where the conveyor discharge (as shown in Figure 5 at 5A) is disposed above the main hopper (as shown in Figure 5 at 5B) to dispense agricultural product, such as seed, into the main hopper. Ex. 2001 ¶ 49.

FIGURE 5 (Ex. 2033 at 5)



Figures 1 and 3 also show that the prototype was capable of rotating about the first conveyor axis of rotation to a loading position, when the conveyor at the position as shown in Figures 1 and 3 is rotated further clockwise. Ex. 2001 ¶ 49.

2. Claim 17

The Seed Runner 3500 prototype had a first vertical axis of rotation that extended through the main hopper discharge, as shown by the red dashed line in Figure 3 at 3A. Ex. 2001 ¶ 50.

3. Claim 18

The Seed Runner 3500 prototype had a conveyor with an axis of rotation that extended through the approximate center of gravity of the conveyor, as shown by the yellow dashed line in Figure 3 at 3F. Ex. 2001 ¶ 51.

4. Claim 19

The Seed Runner 3500 prototype had a first horizontal axis that extended through the first end of the support arm, as shown by the green dashed line in Figure 2 at 2D and in Figure 3 at 3B. Ex. 2001 ¶ 52.

5. Claim 20

The Seed Runner 3500 prototype had a second end of the support arm that terminated at the second coupling, as shown in Figure 1 at 1G. Ex. 2001 ¶ 53.

6. Claim 21

The Seed Runner 3500 prototype had an internal elevator (which is housed inside the conveyor) for moving seed or grain from the conveyor hopper to the conveyor discharge, as represented by the dashed purple arrow in Figure 4 at 4E. Ex. 2001 ¶ 54.

7. Claim 22

The Seed Runner 3500 prototype had a hydraulic piston extending at an acute angle relative to a horizontal plane to connect with a portion of the support arm spaced from the first horizontal axis of rotation, as shown in Figure 1 at 1M and Figure 4 at 4F, and Figure 5 at 5C. Ex. 2001 ¶ 55.

Therefore, the Seed Runner 3500 prototype includes all of the features of Challenged Claims 16-22 of the '940 Patent. Ex. 2001 ¶ 56.

IX. PETITIONER FAILS TO CHALLENGE ALL ASSERTED CLAIMS IN THE RELATED DISTRICT COURT PROCEEDING

While Patent Owner acknowledges that Petitioner submitted a stipulation pursuant to *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020), Patent Owner notes that Petitioner has only challenged a subset of the claims asserted in the related district court proceeding. Specifically, in *Unverferth Mfg. Co., Inc. v. Par-Kan Co., LLC*, No. 23-cv-00653 (N.D. Ind.), Patent Owner has asserted claims 1-23 of the '940 Patent, while Petitioner only challenges claims 16-23 in the instant proceeding. Moreover, Petitioner is time barred from challenging any additional claims of that patent in an IPR proceeding. Accordingly, if instituted, the IPR proceeding would not resolve all claims at issue in the district court proceeding. As such, there are limited efficiencies to be gained through the subject proceeding.

X. CONCLUSION

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

Date: December 23, 2024

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this Patent Owner Preliminary Response (“POPR”) complies with the type-volume limitations of 37 C.F.R. § 42.24(a)(1)(i). This POPR (including figure labels and annotations) contains 13,979 words as calculated by the Word Count features of Microsoft Word and Microsoft PowerPoint, the word processing programs used to create it.

The undersigned further certifies that this POPR complies with the typeface requirements of 37 C.F.R. § 42.6(a)(2)(ii) and typestyle requirements of 37 C.F.R. § 42.6(a)(2)(iii). This POPR has been prepared in a proportionally spaced typeface using Microsoft Word in Times New Roman 14-point font.

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **PRELIMINARY RESPONSE OF PATENT OWNER UNVERFERTH MANUFACTURING COMPANY, INC. and EXHIBITS 2001-2037** were served on December 23, 2024, to the following counsel for Petitioner via FTP:

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