

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 IPR2024-01426
Patent 8,967,940

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

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Patent Owner's Preliminary Response is riddled with statements and arguments that contradict Patent Owner's prior positions during prosecution and litigation. These inconsistencies demand further exploration and discovery. The Board should institute IPR.

I. Patent Owner's Statements Regarding Reduction to Practice Contradict Statements Made During Prosecution

In its POPR (at 57–58), Patent Owner tries to disqualify some of Petitioner's prior art (but only as to some challenged claims) by arguing that it reduced the claimed invention to practice in February 2006 by building a prototype that worked as intended. Patent Owner cites a declaration from one of its employees, Shawn Gerdeman, claiming that he tested the prototype and “personally confirmed that the device was working properly” in February 2006, and that it was “still operating for its intended purpose” after field testing in May 2006. Ex. 2002 ¶¶ 8, 29.

During prosecution, however, Mr. Gerdeman submitted a declaration stating the exact opposite: this same prototype was “*not* operating properly” in May 2006, which forced Patent Owner to “redesign[] various aspects.” Ex. 2034 ¶ 11 (emphasis added); *see also id.* ¶ 7. Mr. Gerdeman made this statement to explain away pre-critical date orders of the prototype and thus avoid the on-sale bar. *See id.* ¶¶ 3–13. He asserted that because the prototype was “not operating properly,” those orders were merely “for experimental testing” and thus not invalidating. *Id.* ¶¶ 3, 11, 13.

Had Mr. Gerdeman instead disclosed, as he does now, that the prototype “was working properly” before the critical date, the examiner would have had justification to reject the claims under the on-sale bar. Ex. 2002 ¶ 8; *Cargill, Inc. v. Canbra Foods, Ltd.*, 476 F.3d 1359, 1371–72 (Fed. Cir. 2007) (invalidating claims because patentee “knew of the general utility of” and sold claimed product pre-critical date).

Patent Owner also asserts (at 59) that it publicly introduced its “Seed Runner” device at a trade show in 2006, before the filing date of the provisional application to which the ’940 patent claims priority. During prosecution of the parent ’047 patent, however, Patent Owner repeatedly represented to the Office that the Seed Runner “was introduced in **2007**, *after* the filing of the [provisional] application.” Ex. 1012 at 131 (emphasis added); *see also id.* at 86, 95, 125.

These discrepancies raise questions about whether and when Patent Owner actually reduced the claimed invention to practice, yet neither Patent Owner nor its declarants address them. The Board should institute IPR to allow Petitioner to probe Patent Owner’s inconsistent representations.

II. Patent Owner’s Proposed Construction of “Below” Contradicts Its Arguments and Admission in Prior Litigation

Patent Owner argues (at 35) that “below” means “under,” but it *admitted* in prior litigation that “below” simply means “lower than.” In its lawsuit against J&M Manufacturing, Patent Owner initially proposed the same construction it seeks here

but then “**conceded** that ‘below’ means ‘lower than.’” Ex. 2036 at 5 (emphasis added). Despite its duty of candor, Patent Owner omits this material fact from its POPR. The Board should hold Patent Owner to its prior concession and construe “below” as “lower than,” as the court did. *See id.*

Moreover, in a subsequent lawsuit against Meridian Manufacturing, Patent Owner argued **against** the claim construction it now proposes (directly “under”) and instead urged the court to construe “below” as “lower than.” Ex. 2023 at 26–28; POPR at 35 (distinguishing Hiniker’s base because it is “far removed,” not directly under, the main hopper). Although the court ultimately construed the term as “under,” it agreed with Patent Owner that adding “the modifier ‘directly’ is not supported by the intrinsic evidence.” Ex. 2023 at 27. Having persuaded a court to reject that modifier, Patent Owner cannot now argue the opposite. *See New Hampshire v. Maine*, 532 U.S. 742, 749 (2001). Yet that is precisely what Patent Owner attempts here. *See, e.g.*, POPR at 35.

The Board should therefore reject Patent Owner’s new construction of “below.” And, because Patent Owner’s attempts to distinguish the asserted prior art rely on that construction, the Board should institute IPR.

III. Patent Owner’s *Fintiv* Argument Ignores Binding Authority

Patent Owner (at 73) urges discretionary denial because Petitioner challenges only a subset of the claims asserted in the related litigation, but that is immaterial

under “binding agency guidance” precluding discretionary denial where, as here, the petitioner provides a *Sotera* stipulation. Ex. 1014 at 7; Ex. 1016. Moreover, Patent Owner omits that it did not assert the unchallenged claims until *after* this Petition.

IV. Patent Owner Ignores *Becton, Dickinson* Factors (a) and (d)

Patent Owner’s arguments regarding the *Becton, Dickinson* factors fail because they ignore factors (a) and (d). Discretionary denial is thus inappropriate.

Factor (d) is “the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art,” but Patent Owner ***does not dispute*** that Petitioner presents new prior-art combinations and new motivations to combine that the examiner never considered. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017); *Netflix Inc. v. Divx, LLC*, No. IPR2020-00646, Paper 12 at 54–56 (PTAB Sept. 15, 2020) (instituting IPR where petitioner presented new motivation to combine references); *Bowtech Inc. v. MCP IP, LLC*, IPR2019-00383, Paper 14 at 4–5 (PTAB Aug. 6, 2019) (instituting IPR where petitioner presented new combinations). Nor does Patent Owner dispute that the examiner relied on different combinations of Furrer and Baskerville to address different claim limitations absent from the challenged claims. *See* Pet. at 86. Thus, factor (d) favors institution.

Patent Owner likewise gives short shrift to factor (a), which considers the “material differences between the asserted art and the prior art involved during

examination.” *Becton*, IPR2017-01586, Paper 8 at 17. For example, Patent Owner ignores the following material differences between the asserted and examined art: (i) Adam lacks a loading position and its support arm does not pivot up and down; (ii) Baskerville’s conveyor does not rotate about a vertical axis; (iii) Great Plains Air Drill Cart’s support arm does not pivot up and down; (iv) Forsyth’s support arm does not pivot up and down at its first end; (v) Sukup’s conveyor neither swings side to side nor has a loading position; and (vi) Meharry’s support arm does not pivot up and down. *See* Exs. 2017, 1008, 2019–22. By contrast, the asserted references disclose these limitations. *See, e.g.*, Pet. at 21–23, 28–32, 52–53, 71–74.

Rather than engage with these material differences, Patent Owner merely caricaturizes the references and then calls those caricatures “substantially the same.” POPR at 49. Patent Owner reduces each reference to teaching “an agricultural device having a conveyor attached to the side of a piece of agricultural equipment,” but at that exospheric level of abstraction almost no petition would survive discretionary denial. *Id.* Indeed, Patent Owner’s oversimplification ignores even the differences that Patent Owner itself acknowledges. *See, e.g., id.* at 35 (arguing Hiniker’s base is “far removed from the main hopper on the trailer tongue”); *id.* at 37 (arguing Morris’s support arm is “attached to the corner of the air cart”). The Board should therefore reject Patent Owner’s *Becton*, *Dickinson* arguments and institute IPR.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e), the undersigned certifies that on January 17, 2025, a complete and entire copy of this Petitioner's Reply to Patent Owner's Preliminary Response was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows:

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