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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PAR-KAN COMPANY, LLC,
Petitioner,

v.

UNVERFERTH MANUFACTURING COMPANY, INC.,
Patent Owner

_____

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

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PATENT OWNER'S SUR-REPLY

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Pursuant to the Board's email of January 7, 2025 (Ex. 3001), Unverferth Mfg. Co., Inc. ("Patent Owner") submits this sur-reply. For the reasons set forth herein and in its Preliminary Response (Paper 6, "POPR"), institution should be denied.

I. There is No Inconsistency – Patent Owner's Statements Regarding Reduction to Practice are Consistent with the Prosecution History

Petitioner weaves together excerpted quotes from the prosecution history to try to paint a story that the evidence submitted by Patent Owner in support of its reduction to practice date is inconsistent with the prosecution history. *First*, Petitioner alleges that the declaration of Mr. Gerdeman submitted during prosecution of the '940 patent (the "'940 Declaration") is inconsistent with the POPR's statements regarding reduction to practice. Not so. As explained by Mr. Gerdeman in the '940 Declaration, Patent Owner's first seed tender prototype was completed "in February of 2006." Ex. 2034 ¶ 7. Mr. Gerdeman explained that this prototype was not offered for sale or sold prior to February 15, 2006. *E.g.*, *id.* ¶ 9 ("Exhibit A and Exhibit B do not reflect an offer for sale or sale of a seed tender unit prior to the February 15, 2006 critical date, and there were no offers for sale or sales of the seed tender unit prior to that date."). This is ***consistent with*** statements in this proceeding. Despite the clear statements in the prosecution history that a prototype was completed by February 2006, and its extensive knowledge of these events from a

prior litigation, Petitioner failed to address how the § 102(a) (pre-AIA) references from March and May 2006 it relies on qualify as prior art in the Petition.

Petitioner argues that the tracking invoices submitted with the '940 Declaration reflect "pre-critical date orders." Reply at 1. This is false and inconsistent with facts set forth in the '940 Declaration. That declaration makes clear that these "invoices" were shipping records—***generated in April 2006 months after the critical date***—used to track the prototypes placed with farmers for experimental testing. Ex. 2034 ¶¶ 9-13. It also states unequivocally that these invoices do not reflect offers for sale or sales. *Id.* These facts should come as no surprise to Par-Kan, who took extensive discovery on this issue in an earlier litigation. *See id.* ¶ 3.

The '940 Declaration also points out that, during experimental testing in May 2006, the "seed tender prototype units were not operating properly." *Id.* ¶ 11. This statement is in no way inconsistent with his declaration submitted in this proceeding where he states that the claimed invention worked for its intended purpose by February 2006. In his POPR declaration, Mr. Gerdeman explains the consistency of both statements:

> [T]he farmer encountered a minor issue where the cleats of the conveyor "belt [were] rubbing" against the bottom side of the housing of the conveyor. This was "causing cleats to bend back." The farmer stated that he clipped "the tops of the cleats off to provide appropriate clearance for the belt to operate." We installed a new belt with more

> clearance, which stopped the cleats from rubbing against the bottom of the conveyor housing. The belt would need to be modified before we commercialized the product. However despite this minor issue with the belt cleats, the machine was still operating for its intended purpose, as I personally witnessed and as shown in the photos discussed above.

Ex. 2002 ¶ 29. There are no inconsistencies.

Second, Petitioner attempts to manufacture a discrepancy where none exists by misleadingly excerpting a sentence from the prosecution of the parent '047 patent. Reply at 2. The complete sentence states, "***[t]he commercial embodiment*** of the above-referenced patent application was introduced in 2007, after the filing of the present application, as 'Seed Runner.'" Ex. 1012 at 131 (emphasis added; underlined portion omitted by Petitioner). In context, without excerpting "commercial embodiment", this sentence clearly relates to the sale of the commercial Seed Runner product—not to the prototype first displayed at a trade show. The examiner understood this context: Unverferth disclosed during the '940 patent's prosecution that the Seed Runner product was first shown at the National Farm Machinery Show on February 15, 2006 (after the critical date). Ex. 2034 ¶ 17.

In sum, Patent Owner's statements in its POPR are consistent with the prosecution history that the claimed invention was reduced to practice before the Morris and Hiniker Webpage references. In any event, as explained in the POPR, the Board need not address this issue to deny institution. POPR at 54.

II. Petitioner – Not Patent Owner – Fails to Consider Prior District Court *Markman* Orders Regarding the Claim Term "Below"

Petitioner makes the demonstrably false statement that Patent Owner did not disclose its previously proposed constructions for the term "below" that differed from its proposed construction here. Patent Owner expressly disclosed in its POPR that it previously pursued a construction of "lower than" for the term "below," which was adopted by the N.D. Ohio court, but later rejected by the N.D. Iowa court. *See* POPR at 30, n.4. Patent Owner also attached both claim construction orders as exhibits to its POPR. Ex. 2023; Ex. 2036. Petitioner inexplicably ignores these facts.

Despite these differing *Markman* orders, Petitioner completely failed to address the construction of "below" in its Petition. Pet. at 4. This is remarkable because in its Reply, Petitioner acknowledges that this construction may distinguish the prior art references it asserts in Grounds I-III (*i.e.*, the Hiniker Manual and Hiniker Webpage). Reply at 3. Moreover, Petitioner fails to set forth any substantive arguments as to why the Iowa court's claim construction of "below" as "under" is wrong. Instead, Petitioner makes yet another demonstrably false statement that Patent Owner's proposed construction of "below" is "***directly*** under." The word "directly" does not appear in Patent Owner's proposed construction. It proposes "under" not "directly under." POPR at 27. Patent Owner's proposed construction

should be adopted for the reasons set forth in its POPR (POPR at 27-30) and by the N.D. Iowa, which Petitioner ignored (and continues to ignore).

III. Petitioner Did Not Ignore *Becton, Dickinson* Factors (a) and (d)

Petitioner incorrectly asserts that Patent Owner ignored *Becton, Dickinson* factors (a) and (d). Again, not so. In its POPR at pages 47-54, Patent Owner considered each of the *Becton* factors. In fact, it is Petitioner who failed to address factor (a) completely in its Petition. Petitioner did not identify *any* of the alleged "material differences" it raises now for the first time on reply. Pet. at 84-88; Reply at 5. The so-called "material difference" identified for four of the references—the inability of the support arm to pivot up and down—is also a deficiency for Morris. Reply at 5. That is, Morris' support arm does not pivot up and down at its first end, just like the devices in Adam, Great Plains Air Drill Cart, Forsyth, and Meharry. *Id.* Petitioner also does not dispute that ***none*** of its references, or the references relied on during examination, teach a first end of the support arm below the main hopper.

With respect to factor (d), while Patent Owner does not dispute that the specific combinations presented in the Petition are different, they are cumulative to those relied upon and considered by the Examiner during prosecution. *See* POPR at 48-53. Thus, the cases cited in Petitioner's reply are distinguishable (Reply at 4), and the cases addressing "cumulative" art cited in the POPR are most applicable. POPR at 48-51. Thus, the Board should deny the Petition under §314(d).

Date: January 29, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **PATENT OWNER'S SUR-REPLY** was served on January 29, 2025, to the following counsel for Petitioner via electronic mail:

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