

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR-KAN COMPANY, LLC,
Petitioner,

v.

UNVERFERTH MANUFACTURING COMPANY,
Patent Owner.

IPR2024-01426
Patent 8,967,940 B2

Before MEREDITH C. PETRAVICK, JAMES A. TARTAL, and
ERIC C. JESCHKE, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Par-Kan Company, LLC (“Petitioner”) filed a Petition requesting *inter partes* review of claims 16–23 (“challenged claims”) of U.S. Patent No. 8,967,940 B2 (Ex. 1001, “the ’940 patent”). Paper 2 (“Pet.”). Unverferth Manufacturing Company, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our prior authorization (Ex. 3001), Petitioner filed a Preliminary Reply to Patent Owner’s Preliminary Response (Paper 8 (“Prelim. Reply”)) and Patent Owner filed a Preliminary Sur-Reply (Paper 9 (“Prelim. Sur-Reply”)).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless 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.” After considering the Petition, the Preliminary Response, the Preliminary Reply, and Preliminary Sur-reply, and the evidence of record, for the reasons explained in our analysis below, we do not institute an *inter partes* review of claims 16–23 of the ’940 patent on the grounds asserted in the Petition.

B. *Real Parties-in-Interest*

Petitioners identifies “Par-Kan Company, LLC, and its parent corporation, RP Industries, Inc.” as the real parties-in-interest. Pet. 88. Patent Owner states that “[t]he ’940 patent is currently assigned to Unverferth Mfg. Co., Inc.” Paper 4, 2; Paper 7, 2.

C. *Related Matters*

The parties identify the following related court proceedings:

Unverferth Mfg. Co., Inc. v. Par-Kan Co., LLC, 3-23-cv-00653 (N.D. Ind.), filed July 11, 2023;

Unverferth Mfg. Co., Inc. v. Meridian Mfg., Inc., 5-19-cv-04005 (N.D. Iowa), filed January 23, 2019;

Unverferth Mfg. Co., Inc. v. Norwood Sales Inc., 3-18-cv-00053 (D.N.D.), filed March 12, 2018; and

Unverferth Mfg. Co., Inc. v. J&M Mfg. Co., Inc., 3-16-cv-02282 (N.D. Ohio), filed September 13, 2016.

In addition, we note that related U.S. Patent No. 9,745,123 B2 is the subject of IPR2024-01427.

D. The '940 Patent

The '940 patent is titled “Seed Carrier with Pivoting Conveyor” and issued from an application claiming priority to a provisional application filed on February 15, 2007. Ex. 1001, codes (54), (60).

The '940 patent discloses a conveyor system that includes “a novel pivot system that allows it to either load or unload a container by pivoting it into a loading or unloading position.” Ex. 1001, 1:17–19.

Figure 1, reproduced below, illustrates a seed carrier having a tube conveyor and a pivoting mechanism. *Id.* at 2:63–67.

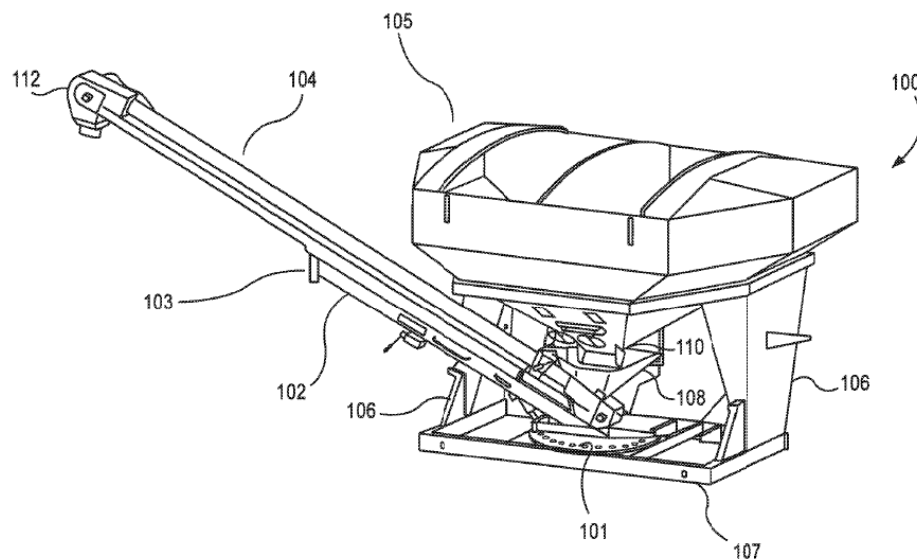


FIG. 1

As shown in Figure 1, “seed carrier 100 includes main hopper 105 coupled to frame 107 by legs 106.” *Id.* at 2:65–67. “[C]onveyor 104 is supported by support arm 102 coupled with pivoting mechanism 101 fixed to frame 107.” *Id.* at 2:66–3:1. “[C]onveyor 104 is pivotably coupled with the support arm by coupling 103 at a point that is preferably near or at the center of gravity of the conveyor 104.” *Id.* at 3:1–3. “Conveyor 104 is also coupled to support arm 102 by a latch (not shown) at the bottom of the conveyor.” *Id.* at 3:4–5. “The latch allows conveyor 104 to be uncoupled from support arm 102 at the bottom so that the conveyor is free to rotate about coupling 103.” *Id.* at 3:5–8. “By positioning the coupling 103 at or near the center of gravity of conveyor 104, the conveyor 104 balances on pivoting coupling 103 such that little effort is required to rotate conveyor 104.” *Id.* at 3:8–11.

E. Illustrative Claim

Petitioner challenges claims 16–23 of the ’940 patent. Of the challenged claims, claim 16 is the sole independent claim and claims 17–23 depend from claim 16. Claim 16 is reproduced below, with Petitioner’s labeling added (Pet. 13–36).

[16.pre] A seed or grain tender comprising:

[16.1] a main hopper having a main hopper discharge;

[16.2] a base positioned below said main hopper;

[16.3] a support arm having first and second ends;

[16.4] a first coupling connecting said first end of said support arm with said base,

[16.5] said first coupling being rotatable about a first vertical axis of rotation, and

[16.6] said first end of said support arm being rotatable about a first horizontal axis of rotation;

[16.7] 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

[16.8] 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

[16.9] 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 and a loading position wherein said conveyor discharge is disposed above said main hopper to dispense agricultural product into said main hopper.

Ex. 1001, 6:51–7:7.

F. Asserted Grounds

Petitioner asserts that claims 16–23 would have been unpatentable on the following grounds:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	16, 18–21	103	Hiniker Manual, ¹ Hiniker Webpage ² (“and, if necessary, Johnson and/or Morris”)
2	17	103	Hiniker Manual, Hiniker Webpage, Furrer ³

¹ Assembly Manual: Part Number 80504785 REV A, Hiniker Company, Jan. 2001 (“Hiniker Manual”) (Ex. 1004).

² Screen capture of the archived version of a Hiniker Company webpage captured by the Internet Archive on March 14, 2006, available at https://web.archive.org/web/20060314112127/http://www.hiniker.com/ag_products/4800features.htm (“Hiniker Webpage”) (Ex. 1005).

³ U.S. Patent No. 7,500,817 (“Furrer”) (Ex. 1007).

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
3	22, 23	103	Hiniker Manual, Hiniker Webpage, Baskerville ⁴
4	16–21	103	Morris, ⁵ Furrer
5	22, 23	103	Morris, Furrer, Baskerville

Petitioner relies on the Declaration of Douglas S. Prairie, P.E. Ex. 1003.

II. ANALYSIS

A. Claims 16–22

Patent Owner contends that Morris and Hiniker Webpage are not available as prior art because the invention covered by claims 16–22 was actually reduced to practice prior to the alleged publication dates of Morris and Hiniker Webpage. Prelim. Resp. 54–55.

Petitioner’s grounds all rely upon either Morris (Ex. 1009) or Hiniker Webpage (Ex. 1005) for claims 16–22. Pet. 1–2 (table summarizing grounds). Petitioner asserts that both Morris and Hiniker Webpage are available as prior art under pre-AIA 35 U.S.C. § 102(a). *Id.* at 2, 11–12, 54–55. Petitioner contends that Morris was published by August 13, 2006, and that Hiniker Webpage was published by March 14, 2006. *Id.*

1. Legal Standards

A patent owner may antedate a reference by proving an earlier reduction to practice. *Purdue Pharma L.P. v. Boehringer Ingelheim GmbH*, 237 F.3d 1359, 1365 (Fed. Cir. 2001); *see* 37 C.F.R. § 1.131. For an actual reduction to practice, a patent owner must show three things: (1) construction of an embodiment or performance of a process meeting all

⁴ U.S. Patent No. 5,888,044 (“Baskerville”) (Ex. 1008).

⁵ Operator’s Manual, 7000 Series Air Cart, Morris, Sept. 2004 (“Morris”) (Ex. 1009).

limitations in the challenged claims; (2) “that the invention would work for its intended purpose”; and (3) “sufficient evidence to corroborate inventor testimony regarding these events.” *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1169 (Fed. Cir. 2006).

If a patent owner attempts to antedate a reference in an *inter partes* review, the patent owner bears the burden of producing evidence supporting an invention date before the reference’s effective date. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1379–80 (Fed. Cir. 2015). At the institution stage of an *inter partes* review, the statutory “reasonable likelihood” standard for institution applies to the issue whether a reference qualifies as prior art. *Cf. Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 12 (precedential) (citing 35 U.S.C. § 314(a)).

“The essential inquiry here is whether the advance in the art represented by the invention . . . was embodied in a workable device that demonstrated that it could do what it was claimed to be capable of doing.” *Scott v. Finney*, 34 F.3d 1058, 1063 (Fed. Cir. 1994) (quoting *Farrand Optical Co. v. United States*, 325 F.2d 328, 333 (2d Cir. 1963)).

“In order to establish an actual reduction to practice, an inventor’s testimony must be corroborated by independent evidence. [A] ‘rule of reason’ analysis is applied to determine whether an inventor’s testimony regarding reduction to practice has been sufficiently corroborated.” *Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998); *see also Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996) (corroboration requirement “arose out of a concern that inventors testifying in patent infringement cases would be tempted to remember facts favorable to their case by the lure of protecting their patent or defeating another’s patent”).

The sufficiency of corroboration is determined according to a “rule of reason.” *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993). This, however, does not dispense with the requirement that some independent evidence provide corroboration. *Coleman v. Dines*, 754 F.2d 353, 360 (Fed. Cir. 1985). The requirement of “independent” corroboration requires evidence other than the inventor’s testimony. *In re NTP, Inc.*, 654 F.3d 1279, 1291–92 (Fed. Cir. 2011).

2. *Analysis of Patent Owner’s Argument and Evidence*

Based on its Seed Runner 3500 prototype, Patent Owner argues: “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.” *Id.* at 57.

To support its arguments, Patent Owner provides the testimony of inventor Brian Petersen. Ex. 2001. Mr. Petersen testifies that the Seed Runner 3500 prototype was conceived by November 2005 and manufactured no later than February 15, 2006 and before the National Farm Machinery Show in Louisville, Kentucky (“the Louisville Show”), which took place February 15–18, 2006. *Id.* ¶¶ 12–13, 15. Mr. Petersen also testifies that the Seed Runner 3500 prototype was operated and demonstrated to the public during the Louisville Show. *Id.* ¶¶ 19–20.

To corroborate Mr. Petersen’s testimony, Patent Owner provides the testimony of Shawn Gerdeman, who assisted in building the Seed Runner 3500 prototype. Ex. 2002 ¶¶ 11–12. In addition to Mr. Gerdeman’s testimony, Patent Owner provides photographs of the Seed Runner 3500 prototype at the Louisville Show (Ex. 2027), marketing material of the Seed Runner 3500 prototype that was distributed at the Louisville Show (Ex.

2028), and a report of the display of the Seed Runner 3500 at the Louisville Show (Ex. 2029). Prelim. Resp. 57–58.

Mr. Petersen next testifies that the Seed Runner 3500 prototype was reduced to practice no later than February 28, 2006. Ex. 2001 ¶¶ 24–28. To corroborate Mr. Petersen’s testimony, in addition to the corroborating testimony of Mr. Gerdeman (Ex. 2002 ¶¶ 16–20), Patent Owner provides photographs of the prototype on the lot at Patent Owner’s facility, which photographs were uploaded to Patent Owner’s computer systems on February 28, 2006. Exs. 2030, 2035. Mr. Petersen and Mr. Gerdeman testify that seed was run through the conveyor in both the load and unload configurations. Ex. 2001 ¶ 24; Ex. 2002 ¶ 16. The photographs show seed dust remnants on the conveyor discharge and in the flap below the main hopper discharge, confirming that seed was run through the device. Ex. 2030, 9–13; Ex. 2001 ¶ 24; Ex. 2002 ¶ 16.

By April 2006, Patent Owner manufactured a second Seed Runner 3500 prototype. Prelim. Resp. 61 (citing Ex. 2001 ¶ 29; Ex. 2002 ¶ 21).

Both Mr. Petersen and Mr. Gerdeman testify that the Seed Runner 3500 prototype was reduced to practice no later than May 16, 2006. Ex. 2001 ¶¶ 29–35; Ex. 2002 ¶¶ 21–31. Patent Owner provides shipping records that show that a Seed Runner 2500 prototype was shipped to a farm in Holland, Michigan on April 13, 2006 and to a farm in Dixon, Illinois on April 19, 2006. Prelim. Resp. 62 (citing Ex. 2034 ¶¶ 4–13). In May 2006, Mr. Petersen and Mr. Gerdeman travelled to both the Michigan and Illinois farms to observe operation of the prototypes on a large-scale farm. Ex. 2001 ¶ 31; Ex. 2002 ¶ 25; Ex. 2034 ¶¶ 4–13. Patent Owner provides photographs of the Seed Runner 3500 prototype in operation at the Michigan farm (Ex. 2031) and Mr. Gerdeman’s reports concerning the operation of the Seed

Runner 3500 prototype at the Illinois farm (Ex. 2032). Both Mr. Petersen and Mr. Gerdeman testify that they observed the Seed Runner 3500 prototype working for its intended purpose. Ex. 2001 ¶ 35; Ex. 2002 ¶ 31.

Patent Owner contends, and Petitioner does not dispute, that the Seed Runner 3500 prototype is an embodiment that meets all of the limitations of claims 1–20. Prelim. Resp. 64–73; *see generally* Prelim. Reply. Patent Owner sufficiently maps the Seed Runner 3500 prototype to each of the limitations of claims 10–20. Prelim. Resp. 64–73. For example, for claim 1, Patent Owner annotates Figure 1 of Exhibit 2033, which is reproduced below.

FIGURE 1 (Ex. 2033 at 1)



Annotated Figure 1 of Exhibit 2033 is a photograph of the Seed Runner 3500 prototype at the Louisville Show, with labels added to show how the Seed Runner 3500 prototype meets all of the limitations of claim 1.

Patent Owner's evidence and arguments concerning the Seed Runner 3500 persuaded us that Petitioner, as explained below, has not produced sufficient evidence to show a reasonable likelihood in refuting that 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.

Accordingly, Patent Owner persuaded us that Petitioner has not shown a reasonable likelihood in establishing that either Morris, which published by August 13, 2006, or Hiniker Webpage, which published by March 14, 2006, are prior art to claims 16–22 of the '940 patent.

3. *Petitioner's Arguments*

First, Petitioner disputes that the Seed Runner 3500 prototype worked for its intended purpose because of an alleged inconsistency between the testimony of Mr. Gerdeman submitted during prosecution of parent U.S. Patent No. 8,967,940 (Ex. 2034) and submitted during this proceeding (Ex. 2002), Prelim. Reply 1–2.

During prosecution of related U.S. Patent No. 8,967,940, Mr. Gerdeman testified that the Michigan and Illinois farmers' uses of the Seed Runner 3500 prototype were for experimental testing in order to avoid an on-sale bar. *See* Ex. 2034. As part of that testimony, Mr. Gerdeman stated:

While the units were being tested by the two farmers, I along with other Unverferth employees went to the farm locations to observe the testing of the prototype seed tender units. In both instances, *the seed tender prototype units were not*

operating properly. Based on these observations, Unverferth redesigned various aspects of future seed tender products.

Ex. 2034 ¶ 11 (emphasis added). Petitioner argues that Mr. Gerdeman's statement that "the seed tender prototype units were not operating properly" is inconsistent with Mr. Gerdeman's testimony in this proceeding that the Seed Runner 3500 prototype works for its intended purpose. Prelim. Reply 1–2 (citing Ex. 2002 ¶¶ 8, 29).

Patent Owner responds that Mr. Gerdeman's testimony is consistent and provides additional testimony from Mr. Gerdeman, explaining what he meant when he said that "the seed tender prototype units were not operating properly," during prosecution of U.S. Patent No. 8,967,940. Prelim.

Sur-reply 1–21; *see also* Prelim. Resp. 63 n.7. Mr. Gerdeman explains:

The 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; *see also* Ex. 2001 ¶ 34 (testimony of Mr. Petersen). We find Mr. Gerdeman's explanation sufficient to show that there is no inconsistency between Mr. Gerdeman's testimony here and during prosecution of U.S. Patent No. 8,967,940.

We additionally note that Patent Owner provides other evidence in addition to Mr. Gerdeman's testimony, sufficient to show that the Seed Runner 3500 prototype worked for its intended purpose. For example,

Patent Owner provides photographs of the Seed Runner 3500 prototype from February 28, 2006 that show seed dust remnants on the conveyer discharge and in the flap below the main hopper discharge, confirming that seed was run through the device. Ex. 2030, 9–13; Ex. 2001 ¶ 24; Ex. 2002 ¶ 16.

Petitioner’s first argument is unpersuasive.

Second, Petitioner disputes that the Seed Runner 3500 prototype was first introduced at the Louisville Show in 2006. Prelim. Reply 2. Petitioner alleges that “[d]uring prosecution of the parent [U.S. Patent No. 8,221,047], however, Patent Owner repeatedly represented to the Office that the Seed Runner ‘was introduced in 2007, after the filing of the [provisional] application.’” *Id.* (quoting Ex. 1012, 131).

Patent Owner responds that “Petitioner alleges a discrepancy by misleadingly excerpting a sentence from the ’047 patent prosecution history” and that the complete sentence references *commercial* embodiments as being introduced in 2007 and not the Seed Runner 3500 prototype. Prelim. Sur-reply 2–3.

We agree with the Patent Owner. Petitioner cites to testimony given by Daniel Fanger during the prosecution of parent U.S. Patent No. 8,221,047 and concerning the commercial success of the Seed Runner, a commercial embodiment. Ex. 1012, 125, 130–134. The cited testimony states: “The *commercial embodiment* of the above-reference patent application was introduced in 2007, after the filing of the present application, as ‘Seed Runner.’” Ex. 1012, 131 (emphasis added).

Petitioner’s second argument is unpersuasive.

4. Conclusion

Petitioner's grounds all rely upon either Morris (Ex. 1009) or Hiniker Webpage (Ex. 1005) with respect to claims 16–22 of the '940 patent. Pet. 1. Because Petitioner fails to sufficiently show a reasonable likelihood of establishing that either Morris or Hiniker Webpage are prior art to claims 16–22, we determine that Petitioner fails to show a reasonable likelihood that claims 16–22 are unpatentable.

B. Claim 23

Unlike the challenged claims discussed above, Patent Owner does not contend that Morris and Hiniker Webpage are not available as prior art with regard of claim 23 because Patent Owner does not contend the invention of claim 23 was actually reduced to practice prior to the alleged publication dates of Morris and Hiniker Webpage. Nevertheless, even assuming a reasonable likelihood of prevailing was shown by Petitioner with respect to claim 23, we still consider whether we should exercise discretion to deny the Petition. That is because even when a petitioner demonstrates a reasonable likelihood of prevailing with respect to one or more claims, , institution of review remains discretionary. *SAS Inst. Inc. 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)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

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). See *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10–11 (PTAB Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at

41–43, (PTAB Jan. 24, 2019) (informative); Consolidated Trial Practice Guide⁶, 64.

Even if we were to assume that the Petition demonstrates that dependent claim 23 is unpatentable, Petitioner would at most demonstrate a reasonable likelihood of prevailing with respect to one dependent claim out of a total of eight challenged claims. On this record, instituting a trial with respect to all eight claims based on evidence and arguments directed to dependent claim 23 is not an efficient use of the Board’s time and resources. We, thus, do not institute an *inter partes* review based on claim 23.

III. CONCLUSION

We do not institute an *inter partes* review of claims 16–23 of the ’940 patent on the grounds asserted in the Petition.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is denied and no *inter partes* review is instituted.

⁶ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialsPracticeGuideConsolidated>.

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