

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 IPR2024-01427
Patent 9,745,123

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

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Patent Owner's Preliminary Response relies on representations and arguments that contradict both the intrinsic evidence and the law. 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 56–58), 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 of the parent '940 patent, 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 58) 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 ’123 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. 1014 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 the Preamble Contradicts the Specification and the Law

Patent Owner argues (at 27–29) that the preamble is limiting because the ’123 patent supposedly “distinguishes a seed or grain tender from a planter,” but the patent does no such thing. Nothing in the patent distinguishes a seed or grain tender

from a planter. To the contrary, the patent *equates* a seed or grain tender with a planter by describing the claimed invention as a “*seeding* machine[]” or piece of “*seeding* equipment” (i.e., a planter). Ex. 1001 at 2:60–64 (emphasis added). Thus, the premise of Patent Owner’s argument is false.

Patent Owner’s argument is also wrong on the law. No court has ever held a preamble limiting merely because the patent distinguished the structure recited in the preamble from other structures. A preamble is limiting only if “it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.” *Shoes by Firebug LLC v. Stride Rite Children’s Grp., LLC*, 962 F.3d 1362, 1367 (Fed. Cir. 2020) (quotation marks and citation omitted). Patent Owner does not even contend—much less show—that the preamble satisfies this test. Nor does Patent Owner address the fact that the body of the claims “defines a structurally complete invention” and does not rely on the preamble for “antecedent basis”—two clear indicators that the preamble merely states a non-limiting “purpose or intended use for the invention.” *Id.* (citation omitted). Thus, the preamble is non-limiting.

Patent Owner cites *Piggy Pushers, LLC v. Skidders Footwear, Inc.*, 544 F. App’x 984 (Fed. Cir. 2013) (nonprecedential), but that case is inapt. *Piggy Pushers* held that “sock” in the preamble was limiting because the specification “uniformly describe[d]” that “when the elements recited in the body of the claims are combined as claimed, the result itself *must* be a sock.” *Id.* at 988–89 (emphasis added). Here,

by contrast, nothing in the '123 patent says that when the elements recited in the body of claim 10 are combined, the result must be a “seed or grain tender.” On the contrary, the specification states that the claimed invention “can be implemented with seed carrier or seeding machines.” Ex. 1001 at 2:60–62. This case is therefore nothing like *Piggy Pushers*.

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

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

Regarding factor (d), the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art, Patent Owner ***does not dispute*** that Petitioner presents new prior-art combinations and new motivations to combine that the examiner never considered. *See 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 94. Thus, factor (d) favors institution.

Patent Owner likewise gives short shrift to factor (a), the material differences

between the asserted art and the prior art involved during examination. For example, Patent Owner ignores that, unlike the asserted references: (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, 1005, 2019–22. Rather than engage with these material differences, Patent Owner (at 50) 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.

Regarding factor (c), the extent to which the asserted art was evaluated during examination, Patent Owner argues (at 47–49) that the examiner “considered” the Hiniker references because they are listed on an IDS, but mere consideration of a reference listed on an IDS does not satisfy this factor. *See DraftKings Inc. v. Interactive Games LLC*, IPR2020-01107, Paper 10 at 16 (PTAB Jan. 6, 2021) (finding examiner erred in overlooking reference because it was not the basis of a rejection, despite being listed on an IDS); *Fellowes, Inc. v. Treefrog Devs., Inc.*, No. IPR2020-01435, Paper 12 at 15 (PTAB Feb. 22, 2021) (same). 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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