

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEERE & COMPANY,

Petitioner

v.

DAVID'S DOZER V-LOC SYSTEM, INC.,

Patent Owner

Case No. IPR2024-01442

U.S. Patent No. 10,533,300

**AUTHORIZED RESPONSE TO DIRECTOR
REVIEW REQUEST**

TABLE OF AUTHORITIES

Cases

<i>DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.</i> , 567 F.3d 1314, 1327 (Fed.Cir.2009).....	1
<i>Galderma Labs</i> , 737 F.3d	2, 3
<i>Galderma Labs., L.P. v. Tolmar, Inc.</i> , 737 F.3d 731, 739 (Fed. Cir. 2013).....	1
<i>Idemitsu Kosan Co. v. SFC Co.</i> , 870 F.3d 1376, 1381–82 (Fed. Cir. 2017).....	4
<i>In re Mouttet</i> , 686 F.3d 1322, 1334 (Fed. Cir. 2012)	3
<i>Tec Air, Inc. v. Denso Mfg. Michigan Inc.</i> , 192 F.3d 1353 (Fed. Cir. 1999)	3

Other Authorities

USPTO’s	Director	Review	Process	website,
https://www.uspto.gov/patents/ptab/decisions/director-review-process#RIDRP ..				
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I. INTRODUCTION

Petitioner's Request for Director Review should be denied because it does not state valid grounds for director review of the Board's Decision Denying Institution of *Inter Partes* Review (Paper 10) (the "Decision"), misstates the law regarding motivation to combine, and reviewing the decision would be futile in view of Funk's express teachings and the Board's construction of the "timing limitation."

II. STANDARD

While the Director may review a Board's decision not to institute an *inter partes* review pursuant 37 CFR §42.75, a petitioner's request "shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law." *See* USPTO's Director Review Process website, <https://www.uspto.gov/patents/ptab/decisions/director-review-process#RIDRP>.

III. ARGUMENT

A. Petitioner Misstates the Law on Motivation to Combine

Petitioner cites to *Galderma Labs., L.P. v. Tolmar, Inc.*, 737 F.3d 731, 739 (Fed. Cir. 2013) (citing *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed.Cir.2009)) for the proposition that a reference must "criticize, discredit, or otherwise discourage investigation into the invention claimed." Petitioner's Request, at 6-8. However, the complete quote from the *Galderma Labs*

decision quoting *DePuy Spine* is as follows:

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not criticize, discredit, or otherwise discourage investigation into the invention claimed.

Id., at 738 (emphasis added). *Galderma Labs* concerned three scholarly articles used “to demonstrate that 0.1% was the standard or optimal concentration of adapalene for the treatment for acne,” and prior art merely establishing a standard feature did not teach away from a claimed invention. *Galderma Labs*, 737 F.3d at 739. That is completely inapplicable to the Board’s conclusion. Here, the Board properly found that moving the lift arm was **necessary** for the Funk system, and that therefore Funk taught away from restricting the lift force of the main arm. Decision, at 26-30. Petitioner ignores that Funk does not “merely expresses a general preference[,]” but expressly teaches that the ability to adjust the lift arm is **necessary**, which expressly “discourage[s] investigation into the invention claimed” in the ’300 Patent:

The controller 106 then calculates the **necessary** adjustment of the tilt angle of the digging bucket 22 **and** the height of the lift arm 14 based on the difference between $\alpha.1$ and $\alpha.0$ and ... between H.1 and H.0.

Id.; Ex. 1003, at ¶ 33 (emphasis added); *see also* Decision, at 26. Accordingly, “a

person of ordinary skill, upon reading [Funk] would be discouraged from following the path set out in [Lewis], [and] would be led in a direction divergent from the path that was taken by the applicant” restricting the lift arms. *Galderma Labs*, 737 F.3d at 738 (quoting *DePuy Spine*, 567 F.3d at 1327).

B. Preventing Lift Forces on the Main Arm Destroys Funk's Purpose

Both the '300 Patent and Funk are dedicated to improvements of automatic grading systems, whose operability hinges on the precision and accuracy to achieve a smooth grade. *See* Decision, at 26-27; Ex. 1001, at 4:9-12. Petitioner argues that the ability to engage in automatic grading must be destroyed. Petitioner's Request, at 9. This defies reason. Petitioner's Request relies on *In re Mouttet*, which merely supports what the Board concluded – that proposed modification of Funk “should not or cannot” occur. *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) (emphasis added). As discussed above, Funk teaches that the ability to adjust the height of the lift arm is *necessary*, not merely advantageous. Restricting Funk's ability to make the necessary lift arm adjustments destroys the benefit conferred by Funk, which is “antithetical to Funk's operation.” Decision, at 29. The Board correctly recognized that this situation was similar to *Tec Air, Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353 (Fed. Cir. 1999) because the proposed combination “would immobilize Funk's main arm and its associated hydraulic cylinder 18, leaving just one of Funk's two adjustment mechanism – blade tilt – available for grade control, thereby decreasing

the system's accuracy, and negating the very technique that Funk relies upon to achieve its stated goal." Decision, at 28. Modifying Funk, as Petitioner proposed, cannot occur or at minimum should not occur. *Mouffet*, 686 F.3d at 1334.

C. Funk's Teaching Away is Commensurate with the '300 Patent

Petitioner's arguments regarding the scope of the claims again ignore the context under which both Funk and the claims of the '300 Patent present their solutions. Petitioner's Request, at 11-12. Again, both Funk and the '300 Patent are directed to improvements to the accuracy of automatic grading systems. Funk achieves its accuracy improvements by making necessary adjustments to the main lift arm and tilt, while the '300 Patent presents a diametrically opposed solution to improve accuracy by claiming "preventing the ability of the main arm from providing any lifting force." Ex. 1003, at ¶ 33, Ex. 1001, at claim 1. Under *Idemitsu Kosan Co. v. SFC Co.*, 870 F.3d 1376, 1381–82 (Fed. Cir. 2017) the solutions of Funk and the '300 Patent's claims are commensurate in scope – both seek to improve the accuracy of automatic grading systems – and the '300 Patent claims a limitation (restricting the lifting force of the main arm) where Funk teaches that the opposite (adjusting the height of the main arm) is necessary. This is textbook teaching away.

D. Petitioner Ignores the Teachings of Funk in Arguing an Immaterial Factual Mistake

Petitioner argues that the Board Panel made a factual mistake by finding that Funk teaches that adjusting the arm height is necessary to correct lateral tilt.

Petitioner relies on a sentence in paragraph 33 of Funk that states that “[t]he controller **106** is configured for generating a control signal based on the height signal, the tilt angle signal *and the lateral tilt signal*... to adjust at least one of a height of the lift arms 14 and the tilt angle of the work attachment mounting structure 20 such that the grading edge 26 is maintained[.]” Ex. 1003, at ¶ 33. Petitioner then claims that “[n]ot once does Funk suggest that lateral tilt is corrected by moving the lift arms.” Request, at p. 13. Petitioner’s own citation suggests that height can be adjusted to correct for a lateral tilt signal. But even assuming *arguendo* that this is a factual error, it is immaterial because the last sentence of Funk’s paragraph 33 supports the Board’s Decision by expressly teaching that adjusting to the lift arm is necessary to Funk, as discussed above at length. Decision, at 27-29, Ex. 1003, ¶ 33.

E. The Panel’s Conclusion that Funk Teaches Away is Dispositive and Director Review is Futile

The Board properly found that it is dispositive that Funk’s teaching that the ability to adjust the main lift arm is necessary teaches away from the ’300 Patent’s claim limitation of “preventing the ability of the main arm from providing any lifting force[.]” The solutions are diametrically opposed, which also negate Petitioner’s reasons to combine the references. *See* Decision, at 30, n.9. The Board’s decision was correct, and certainly not erroneous. Review is further futile because additionally, the Funk-Lewis combination fails to disclose the “timing limitation,” whose construction was not challenged by Petitioner. Decision, at 15-19.

PO's Authorized Response to Petitioner's Director Review Request

DATED: April 25, 2025

Respectfully submitted,

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IV. CERTIFICATE OF SERVICE

I certify that on April 25, 2025 the foregoing document was served on counsel for Petitioner as provided in 37 C.F.R. § 42.6(e) via electronic mail:

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