

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ETN CAPITAL, LLC, d/b/a BEECH LANE,

Petitioner

v.

FBA OPERATING CO.,

Patent Owner

Case No. IPR2024-01445

Patent No. 10,890,925

PATENT OWNER'S PRELIMINARY RESPONSE

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

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1003	Prosecution History of the ‘925 Patent (App. No. 15/619,261)
1004	Declaration of James Grimes
1005	U.S. Patent Pub. No. 2008/0142768 (“Thorpe”)
1006	U.S. Patent No. 7,305,772 (“Clark”)
1007	U.S. Patent Pub. No. 2016/0075311 (“Garceau”)
1008	U.S. Provisional App. No. 62/050,590
1009	Bluetooth Specification, Version 4.0 (excerpts)
1010	U.S. Patent No. 5,456,014 (“Wilson”)
1011	U.S. Patent No. 5,136,784 (“Marantz”)
1012	U.S. Patent No. 7,786,883 (“Davison, III”)
1013	U.S. Patent Pub. No. 2013/0338848 (“Park”)
1014	Declaration of Nathaniel E. Frank-White
1015	Declaration of Vincent H. Lee
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	September 13, 2024. https://www.uscourts.gov/statistics/table/na/federal-court-management-statistics/2023/12/31-1 .
2001	Docket Sheet from FBA Operating Co. v. ETN Capital LLC, Civ. Case No. 5:23-cv-00505.

Patent Owner FBA Operating Corp. (“FBA” or “PO”) submits this Preliminary Response (“POPR”) to the Petition for *inter partes* review (“IPR”) of claims 1-20 of U.S. Patent No. 10,890,925 (“the ’925 Patent”) filed by Petitioner ETN Capital, LLC d/b/a Beech Lane (“Petitioner”). Paper 2 (“Petition”; “Pet”).

I. INTRODUCTION

A. The ’925 Patent

The ’925 Patent is entitled Vehicle leveling systems, devices and methods and computer program products for leveling vehicles using smart devices, and was issued by the United States Patent and Trademark Office on January 12, 2021. Ex. 1001. The ’925 Patent is directed toward a leveling system for sensing and adjusting the orientation of vehicles, such as recreational vehicles (“RVs”). Ex. 1001 at 18. Figure 5A, for example, depicts a display receiving and displaying information from a sensor device affixed to the RV to detect inclination or orientation in both the pitch and roll directions. Ex. 1001 at 7. The display, for example on a smart device, processes the data to provide users with measurements, including pitch and roll, and determines necessary height adjustments to level the RV in either or both pitch and roll directions. *Id.* at 20.

The system also includes software methods and processes, such as a smart phone app, enabling users to receive real-time feedback and adjustment recommendations for vehicle leveling. *Id.* In response to the sensor readings, the

system calculates and displays the exact amount of height correction required. *Id.* at 23. This ensures the RV can be leveled efficiently using smart device-guided adjustments. *Id.*

B. The Challenged Claims

Claims 1, 10, and 15 are the independent challenged claims. The dependent challenged claims include claims 2-9 depending from claim 1, dependent claims 11-14 depending from claim 10, and dependent claims 16-20 depending from claim 15.

II. ASSERTED GROUNDS OF UNPATENTABILITY

A. Person of Ordinary Skill in the Art

Petitioner failed to define a person of ordinary skill in the art (“POSITA”). Despite this, Petitioner repeatedly makes claims as to what the POSITA would know throughout their Petition. *See, e.g.*, Pet. 19, 20, 21, 27, 29, 30, 31, 32, 34, 38, 40. As an initial point, this failure to define the POSITA is a serious deficit in the IPR Petition as it constitutes an impermissible attempt to avoid having to set forth its full position in the Petition, and to instead shift its definition as to the level of knowledge and skill the POSITA has after having the benefit of reviewing PO’s arguments.

At the least, the Board should find that Petitioner has waived its arguments as to the level of knowledge and skill of the POSITA. *In the Matter of Certain Laser Imageable Lithographic Printing Plates*, USITC Inv. No. 337-TA-636 (Dec. 2010) (explaining that “Respondents’ shift in position has negatively affected both Presstek’s and Staff’s ability to respond [and] the Administrative Law Judge finds

that Respondents have waived their new arguments with respect to the claim language ‘the second layer also being partially transmissive to said radiation.’”). PO includes herewith an argument as to the POSITA, and reserves the right to modify its definition of the POSITA if the Board allows Petitioner to submit a competing definition of the POSITA despite its failure to do so in the Petition.

PO submits that a POSITA would have a Bachelor’s degree in engineering or computer science, or a related field, and 1 year of industry experience or academic research in commercial app development, including some experience with programming devices that can communicate with a display device. Additional education can compensate for less experience and vice versa.

B. Petitioner’s Proposed Claim Construction Should be Rejected

The claim terms should be given their “ordinary and customary meaning” as understood by a POSITA in view of the patent claims, specification, and prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-14 (Fed. Cir. 2005) (*en banc*); and 37 C.F.R. § 42.100(b). There is a “heavy presumption” that the ’925 Patent’s disputed claim terms “are to be given their ordinary and customary meaning.” *See Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1358 (Fed. Cir. 2017) (citation omitted). The ordinary meaning may be readily apparent to a POSITA and claim construction can involve merely accepting the meaning of commonly understood words. *Phillips*, 415 F.3d at 1314.

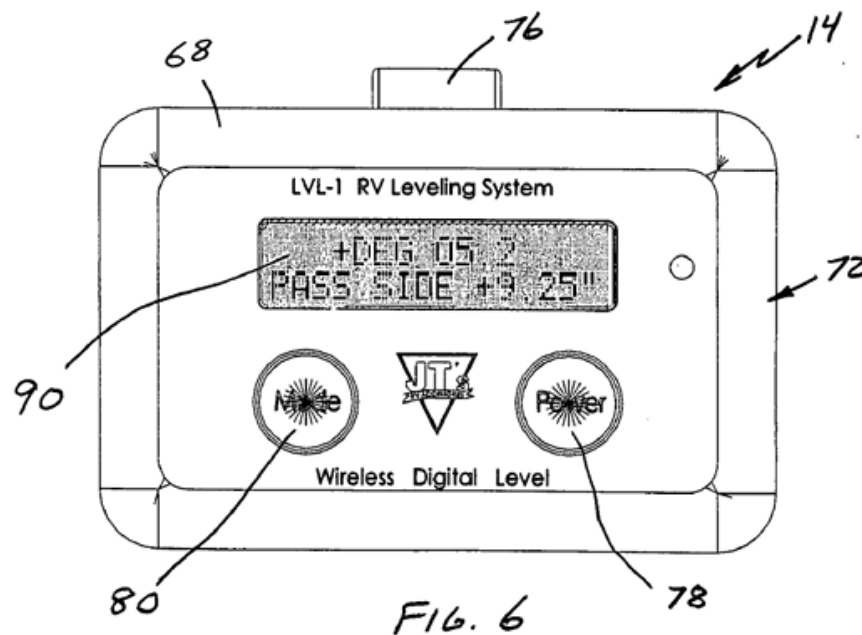
The Petitioner's constructions of the terms "adjustment pairs," "simultaneously display[ing] the height adjustment amount and corresponding adjustment direction of each adjustment pair," and "smart device" are not necessary to determine that the prior art in the IPR does not pass muster. "The patentee is free to choose a broad term and expect to obtain the full scope of its plain and ordinary meaning unless the patentee explicitly redefines the term or disavows its full scope." *Thorner v. Sony Computer Ent. Am. LLC*, 669 F.3d 1362, 1367 (Fed. Cir. 2012). Here, there is nothing in the disclosure of the '925 Patent indicating any disavowal of scope of the terms.

Moreover, the attempt to construe these terms by Petitioner is obviously related to Petitioner's arguments with respect to non-infringement in the district Court litigation and appear to be directed to establishing constructions that will aid them in their non-infringement arguments in the district court case. Infringement is not an issue before the Board, and so the constructions should also be denied on these grounds. "[W]e need only construe terms 'that are in controversy, and only to the extent necessary to resolve the controversy.'" *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

The Board should summarily disregard Petitioner's constructions not only because they are not necessary, but also because claim construction without having defined the POSITA is untenable.

C. Thorpe

U.S. Patent Publication No. 20080142768A1 to Thorpe ("Thorpe") is directed to a beeper-like device referred to as a "control unit" that communicates with an electronic level mounted inside the RV. Ex. 1005 at 11. The control unit in Thorpe is shown in Figure 6:



Ex. 1005 at 4. With reference to the above, Thorpe describes how the device would be used:

To level a recreational vehicle 16 having leveling system 10 after parking recreational vehicle 16 where desired, the operator will typically level the side-to-side position first, usually while still hooked up to the truck or other tow vehicle with control unit 14 on the tow vehicle's visor. The operator first activates the control unit 14 by pushing the power button 78 to turn leveling system 10 to its on condition. In the preferred embodiment, it is not necessary to manually activate level unit 12, as it is configured to continuously cycle on and check for a signal from control unit 14. Once communication is established between the two units 12 and 14, the operator pushes the mode button 80 to display the roll data on display panel 90, such as shown in FIG. 6, showing the amount of degrees off level and the amount of distance to raise one side of recreational vehicle 16 to level recreational vehicle 16 in the side-to-side direction. The operator uses this information to engage the leveling mechanism(s) 18 to raise one side of recreational unit 16 the appropriate amount. Displaying the actual distance for side-to-side leveling can be easily accomplished due to the fact that recreational vehicles 16 are generally the same width. If recreational vehicle 16 used with leveling system 10 is not a standard width, then the operator must achieve the side-to-side leveling by adjusting the leveling mechanism 18 until the degree of roll tilt shows Zero. Once the side-to-side direction is level, the operator unhooks recreational vehicle 16 from the tow vehicle and pushes the mode button 80 again on control unit 14. The display panel 90 of control unit 14 displays the amount, in degrees, from level in the front-to-back direction to communicate to the operator the amount he or she must raise or lower the front or back of recreational vehicle 16 by utilizing leveling mechanism 18. The operator engages leveling mechanism 18 until the readout on display panel 90 goes to zero, indicating that recreational vehicle 16 is level in the front-to back direction and, therefore, at its level condition 20.

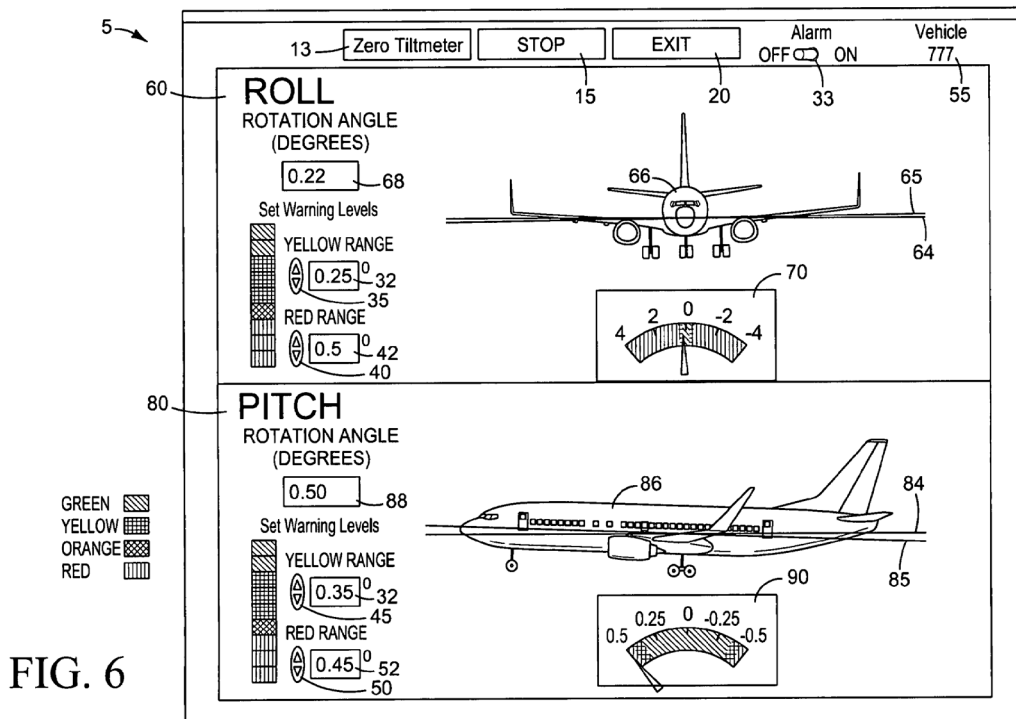
Ex. 1005 at 15.

In Thorpe, the user receives the adjustment information on the control unit and then uses the adjustment information to level the RV in a first direction, before the user then uses the control unit again, hitting the mode button a second time, to

receive the adjustment information needed so that the user can then level the RV in a second direction. *Id.* Thorpe describes unhooking the RV from the tow vehicle in between the two separate uses of the control unit. *Id.*

D. Clark

Clark is directed to displaying information related to the pitch and roll of an airplane in order to make the process of working on the airplane safer. For example, Clark describes how prior art “devices typically require that a human observer be located in a hazardous area, such as a wheel well, during jacking and positioning operations.” Ex. 1006 at 8.

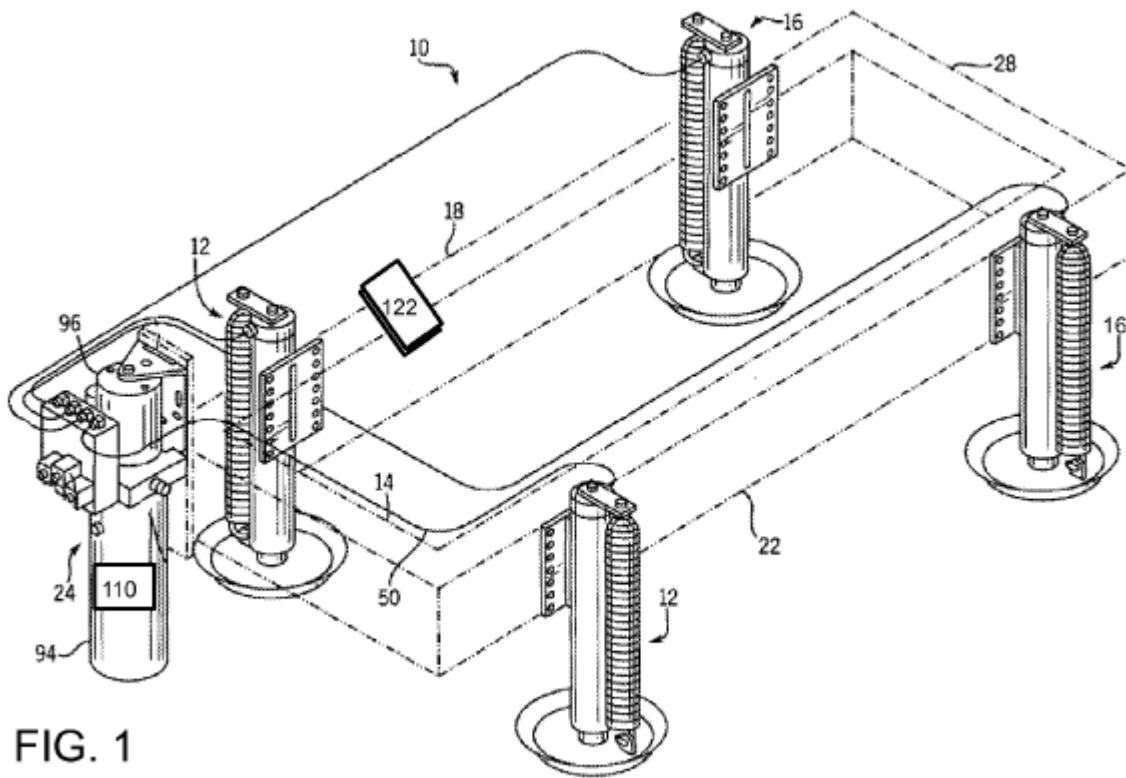


Ex. 1006 at 7.

As shown and described, Clark relates to the use of a clinometer connected to a computer, where the computer receives signals from the clinometer and displays them on a display. *Id.* at 8.

E. Garceau

In Garceau, a “plurality of jacks connected to the frame of [a] structure are provided, which extend or retract to raise, lower, and adjust the attitude of the structure. Solutions for automatic vehicle” Ex. 1007 at 7.



The system of Garceau is automatic, as it describes both measurement and adjustment processes in tandem. “A control system actuates leveling jacks attached to or in contact with the platform or structure using feedback from a multi axis digital sensor.” Ex. 1007 at 7.

F. TealLevel

TealLevel is a palm pilot application. *See* Ex. 1018 at 7 (“TealLevel is available exclusively through the Palm webOS App catalog.”). The device and app worked in a simple manner where the user is directed to “[s]imply lay the phone flat in a vehicle and it will calculate how high the three lower wheels must be raised.” *Id* at 3.



Id.

TealLevel shows information displayed to a user, an example of which can be found in the figure above from page 3 of the reference. *Id.* This information relates to adjustment to each of the four corners of the vehicle. *Id.*

G. Grounds

The six grounds set forth in Petitioner’s Petition for IPR are set forth in the chart below:

Ground	References	Claims	Statute
1	Thorpe + Clark + Garceau	1 -3, 6, 8-11, 13, 15, 16, and 19	35 U.S.C. 103
2	Thorpe + TealLevel + Garceau	1-6, 8-13, and 15-19	35 U.S.C. 103
3	Thorpe + Clark + Garceau + common knowledge	7, 14, and 20	35 U.S.C. 103
4	Thorpe + TealLevel + Garceau + common knowledge	7, 14, and 20	35 U.S.C. 103
5	Garceau + TealLevel	10-13 and 15-19	35 U.S.C. 103
6	Garceau + TealLevel Common knowledge	1-9, 14, and 20	35 U.S.C. 103

As can be readily appreciated in analyzing the chart, Ground 5 mirrors Ground 2 but eliminates Thorpe, and Ground 6 mirrors Ground 4 but eliminates Thorpe.

III. THE PETITION SHOULD BE DENIED BECAUSE THE PRIMARY REFERENCE PETITIONER RELIES UPON IN THE IPR PETITION IS THE SAME THAT THE EXAMINER RELIED UPON DURING PROSECUTION OF THE PATENT, AND THE PRIOR ART

REFERENCES FAIL TO ESTABLISH THAT ANY OF THE CLAIMS ARE OBVIOUS IN VIEW OF THE PRIOR ART

The Petition filed by ETN Capital, LLC relies on the very same reference that was relied upon by the USPTO during prosecution of the challenged patent—Thorpe. The combinations created using Thorpe mirror those asserted by the Examiner during prosecution. For this reason, and the woeful deficiencies of the prior art, the petition should not be instituted.

A. The Board Should Deny Institution on the Basis of Its Discretion Pursuant to § 325(d)

The Board should deny institution on the basis of its discretion pursuant to § 325(d) because the prior art combinations in grounds 1-6, and particularly grounds 1-4 relying on Thorpe as the primary reference, mirror those asserted by the Examiner during prosecution. As such, there are no new issues presented to the Board in this IPR Petition.

Section 325(d) provides that in determining whether to institute an inter partes review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

As set forth in *Advanced Bionics*, the Board uses a two-part framework in determining whether to exercise its discretion under § 325(d), specifically:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same

arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

See Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020). In applying the two-part framework, the Board considers several nonexclusive factors:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Id. at 9–11 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph)); *see also Juniper Networks, Inc. v. Mobile Telecommunications Techs., LLC*, No. IPR2017-00642, 2017 WL 3209154, at *3 (P.T.A.B. July 27, 2017) (applying six “non-exclusive” factors similar to the *Advanced Bionics* factors). “If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then [we

consider] factors (c), (e), and (f), [which] relate to whether the petitioner has demonstrated a material error by the Office.” *Advanced Bionics* at 10.

The PTAB has previously denied petitions to institute IPR, notwithstanding that the prior art references cited in the petition differ from those in the patent’s prosecution history. See *Samsung Sdi Co., Ltd. v. Ube Indus., Inc.*, No. IPR2017-02115, 2018 WL 1308500, at *6 (P.T.A.B. Mar. 12, 2018). Said denials have rested on the determination that the newly cited prior art references are “substantially the same as those that were presented to the Office.” *Id.* (cleaned up).

1. The Main reference Relied Upon, Thorpe, Is the Same

The main reference relied upon for grounds 1-4 is Thorpe, which is the same primary reference as relied upon by the USPTO during prosecution of the patent application¹. Petitioner uses Thorpe in the same way as the Examiner did during prosecution as the main reference, and in a very similar way to what the Examiner did, modifies Thorpe using references that are similar to those used during prosecution. In sum, Petitioner mirrors the Examiner’s rejections.

¹ The first Office Action dated 12/28/2018 included a 102 rejection on the basis of Thorpe and a 103 rejection on the basis of Thorpe in view of US Pat. No. 4,935,883 to Hulsing (“Hulsing”); the second office action dated 6/21/2019 included a 103 rejection based on Thorpe in view of US App. No. 2012/0197587 to Luk (“Luk”), further in view of US Pat. No. 8,239,162 to Tanenhaus et al (“Tanenhaus”); the third office action dated 11/18/2019 maintained the 103 rejection 103 rejection based on Thorpe in view of Luk and Tanenhaus; the fourth office action dated 4/28/2020 included a 103 rejection based on Thorpe in view of Luk, and further in view of US Pat No. 10,086,954 to Zhong et al (“Zhong”).

2. The Disclosure of Clark is Substantially Similar to Zhong, Which Was Previously Presented to and Considered by the USPTO During Prosecution of the '925 Patent.

“Institution of *inter partes* review is discretionary. Our discretion on whether to institute is guided by 35 U.S.C. § 325(d), which states that ‘the Director may take into account whether, and reject the petition or request because, **the same or substantially the same prior art or arguments previously were presented to the Office.**’” *Samsung Sdi Co., Ltd. v. Ube Indus., Inc.*, No. IPR2017-02115, 2018 WL 1308500, at *3 (P.T.A.B. Mar. 12, 2018) (emphasis added).

Presently, Clark, which Petitioner relies upon in Grounds 1 and 3 of the Petition, is substantially the same as Zhong, which was previously considered by the Office during prosecution of the '925 Patent.² Indeed, in the Final Office Action issued on April 28, 2020 (the “Second FOA”), the Examiner stated, “Zhong teaches wherein the smart device is configured to display at least one image representative of the vehicle on the display screen.” Second FOA p. 11. As support for such an assertion, the Examiner quoted Zhong, providing, “[t]he user interface control can include an icon representing the UAV and the additional information includes a three-dimensional (3D) depiction of the UAV’s spatial orientation relative to the remote terminal.” Zhong col. 4, lines 31-34.

² The Board has held where a newly submitted reference is substantially similar to one which was previously presented and considered by the USPTO and is relied upon in substantially the same manner in a petition for *Inter Partes Review*, may be grounds for denial of said petition. See *Samsung Sdi Co., Ltd.*, 2018 WL 1308500, at *8.

Hereto, Petitioner proffers substantially the same argument but merely substitutes Zhong for Clark. Particularly, Petitioner recites, “[b]oth Clark and TealLevel disclose a vehicle leveling system with a graphical display that displays an image of the vehicle.” Petition p. 26. Petitioner subsequently concludes, “[t]he graphical displays in Clark and TealLevel provide an image representative of the vehicle as recited in Element [1.5].” *Id.* Thus, Petitioner relies on Clark in substantially the same manner as Zhong to raise substantially the same argument proposed by the Examiner during prosecution of the ’925 Patent.

Moreover, Petitioner further states, “[t]he graphical interface in Clark simultaneously displays the roll indicators (top half of display) and pitch indicators (bottom half of display) adjacent respective sections of a vehicle as shown in Figure 4 below.” *Id.* p. 27. Petitioner ultimately concludes that, “[s]imultaneously displaying the adjustment pairs as taught in Clark or TealLevel would have been obvious to a PHOSITA as of the Critical Date to enable the user of the vehicle leveling system to see the adjustments for all ground contact points at the same time.” *Id.* p. 29.

Notwithstanding the above, the USPTO has previously stated, “Zhong teaches . . . wherein the smart device is further configured to simultaneously display a plurality of adjustment indicators based on the height adjustment amounts on the display screen.” Second FOA pp. 11-12. Accordingly, Petitioner substitutes Zhong

with Clark to provide the same argument previously considered by the USPTO during prosecution of the '925 Patent.

Furthermore, Petitioner concedes, “Thorpe does not explicitly state that the display is updated in real time, but the description suggests that the display is updated in real time while the user is engaging the leveling mechanism to level the vehicle.” Petition p. 29. Petitioner then alleges, “[u]pdating the display in real time is nothing more than the use of a known technique disclosed in both Clark and TealLevel to improve the vehicle leveling system disclosed in Thorpe.” *Id.* p. 30.

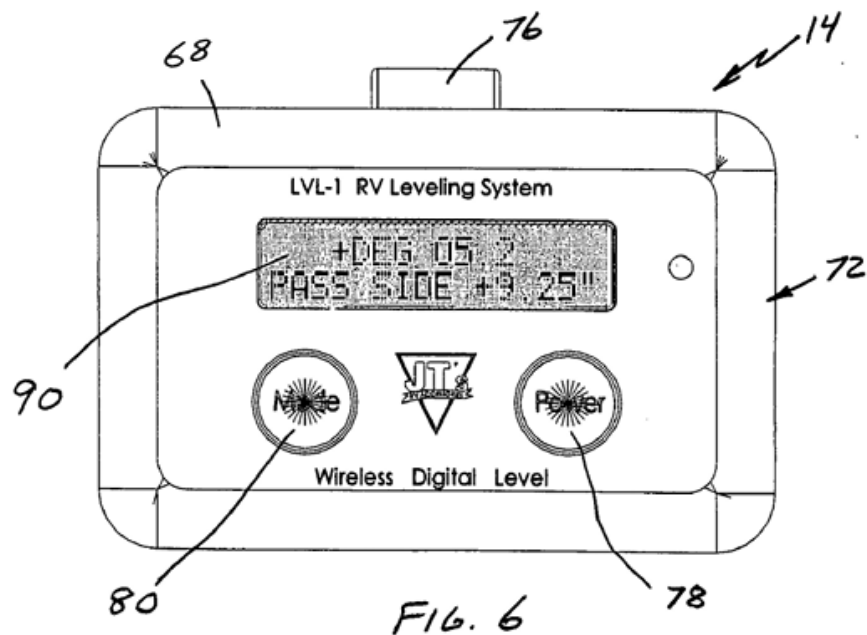
Again, Petitioner's argument mirrors that of the USPTO during prosecution of the '925 Patent. In the Second FOA, the Examiner argued that Zhong disclosed, “wherein the smart device is further configured to update the display screen, substantially in real time.” Second FOA p. 12. Petitioner now argues such a limitation “is nothing more than the use of a known technique.” Petition p. 30. Yet, Petitioner relies upon Clark in substantially the same manner as the USPTO relied upon Zhong during prosecution of the '925 Patent. That is, the USPTO has previously considered the aforesaid argument and ultimately granted an allowance resulting in issuance of the '925 Patent.

Therefore, for the foregoing reasons, the Board should exercise its discretion under 35 U.S.C. § 325(d) and deny institution of the Petition.

B. Grounds 1-6 Should Not Be Instituted Because Thorpe Teaches Away from the Proposed Modifications

Grounds 1-4 all rely on Thorpe as the primary reference, but Thorpe teaches away from being modified as suggested by the Petitioner. "It is improper to combine references where the references teach away from their combination." MPEP §2145 (subheading X.D.2., entitled "References Cannot Be Combined Where Reference Teaches Away from Their Combination" and citing *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983)).

Thorpe is directed toward a beeper-like device referred to as a "control unit" that communicates with an electronic level mounted inside the RV. The control unit in Thorpe is clearly shown in Figure 6:



With reference to the above, Thorpe describes how the device would be used.

To level a recreational vehicle 16 having leveling system 10 after parking recreational vehicle 16 where desired, the operator will typically **level the side-to-side position first**, usually while still hooked up to the truck or other tow vehicle with control unit 14 on the tow vehicle's visor. The operator first activates the control unit 14 by pushing the power button 78 to turn leveling system 10 to its on condition. In the preferred embodiment, it is not necessary to manually activate level unit 12, as it is configured to continuously cycle on and check for a signal from control unit 14. Once communication is established between the two units 12 and 14, the operator pushes the mode button 80 to display the roll data on display panel 90, such as shown in FIG. 6, showing the amount of degrees off level and the amount of distance to raise one side of recreational vehicle 16 to level recreational vehicle 16 in the side-to-side direction. The operator uses this information to engage the leveling mechanism(s) 18 to raise one side of recreational unit 16 the appropriate amount. Displaying the actual distance for side-to-side leveling can be easily accomplished due to the fact that recreational vehicles 16 are generally the same width. If recreational vehicle 16 used with leveling system 10 is not a standard width, then the operator must achieve the side-to-side leveling by adjusting the leveling mechanism 18 until the degree of roll tilt shows Zero. **Once the side-to-side direction is level, the operator unhooks recreational vehicle 16 from the tow vehicle and pushes the mode button 80 again on control unit 14.** The display panel 90 of control unit 14 displays the amount, in degrees, from level in the front-to-back direction to communicate to the operator the amount he or she must raise or lower the front or back of recreational vehicle 16 by utilizing leveling mechanism 18. The operator engages leveling mechanism 18 until the readout on display panel 90 goes to zero, indicating that recreational vehicle 16 is level in the front-to back direction and, therefore, at its level condition 20.

Thorpe, ¶ 44 (emphasis added).

As reflected in the highlighted portions above, in Thorpe, the user receives the adjustment information on the control unit and then uses the adjustment

information to level the RV in a first direction, before the user then uses the control unit again, hitting the mode button a second time, to receive the adjustment information needed so that the user can then level the RV in a second direction. Thorpe even describes unhooking the RV from the tow vehicle in between the two separate uses of the control unit. *Id.*

As is clear from the cited portions of Thorpe, modifications to Thorpe that would require adjustments to the RV and feedback to the display device in Thorpe that occur in real time are directly at odds with how Thorpe describes the use of its device, and therefore, Thorpe teaches away from any such modifications. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 (Fed. Cir. 1987) (“among legal standards for determining scope and content of the prior art, for example, are: a prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention in suit.”); *see also In re Grasselli*, 713 F.2d at 743.

Despite Thorpe’s teachings to the contrary, all of the modifications to Thorpe set forth in the IPR Petitioner do just that—require real time feedback and simultaneous adjustments. For example, the modifications to independent claims 1, 10, and 15 as set forth in the IPR on pages 27-27, 38-40, 44-46, all involve making the device in Thorpe something that would operate in real time and allow for adjustments of pitch and roll on the RV in real time. Thus, at the core of grounds 1-

4, the Petition suggests a modification of Thorpe that the reference itself teaches away from. For this reason, the Board should deny institution of the IPR of the ’925 Patent.

C. Grounds 1 and 3 Should Not Be Instituted Because Clark is Not Analogous Art

Clark is not analogous art because it pertains to airplane technology. Ex. 1006 at 7-8. In contrast, the claimed invention relates to a different field entirely—adjustment mechanisms for recreational vehicles (RVs). Ex. 1001 at 18. Clark’s context and purpose are distinct and unrelated to the claimed invention, and it would not have reasonably been considered by a POSITA when attempting to solve the problem to which the technology of the ’925 Patent is directed.

As a preliminary point, PO notes that this argument—that airplane-related technology is not analogous—was successfully advanced during prosecution with respect to Zhong. Ex. 1003 at 468, 495-497, and 511. While the record does not explicitly state the reasoning behind the allowance of claims following these arguments, the allowance suggests that the Examiner found this reasoning persuasive.

“Art that is ‘too remote’ from the patents being attacked cannot be treated as prior art.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1004 (Fed. Cir. 2023). The IPR Petition relies heavily on Clark in ground 1. For example, the Petition states “Clark and TealLevel both disclose graphical displays for vehicle leveling systems

that display an image of the vehicle and simultaneously display pitch and roll measurements for leveling the vehicle.” Pet. at 19. Clark is relied on for the display features that appear in all three independent claims 1, 10, and 15. Pet. at 27-27, 38-40, 44-46. But, as demonstrated below, as technology utilized in the context of an airplane, Clark would have no relevance to a POSITA and would not have been reasonably combined with the other cited references, namely Thorpe.

Petitioner fails to make any argument as to how Clark is analogous art to Thorpe. However, the Petition on pages 73-74 argues that “[t]he references relied upon in this Petition [i.e., Clark] are in the same field of endeavor . . . [as] Zhong.” Zhong, the reference relied upon by the Examiner during prosecution, is not in the field of RV leveling—it is an unmanned aerial vehicle patent. *See, e.g.* Ex. 1071 at 15 (“[p]rovided herein are systems and methods for providing flight information of UAVs to a remote display”). Thus, Petitioner essentially admits that Clark is not in the same field of endeavor.

As argued at length below, (1) a POSITA would not have looked to Clark to solve the problem at hand in the ’925 Patent and (2) Clark is not properly within the field of endeavor of the ’925 Patent because Unmanned Aerial Vehicle (“UAV”) systems are not in the same field of endeavor as RV leveling.

a) A POSITA Would Not Have Looked to Clark to Solve the Problem at Hand

“This test for analogous art requires the PTO to determine the appropriate field of endeavor by reference to explanations of the invention’s subject matter in the patent application, including the embodiments, function, and structure of the claimed invention.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Regarding the field of endeavor, “it is necessary to consider ‘the reality of the circumstances’ . . . —in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

The challenged claims show the ’925 Patent to be directed towards an innovative and elegant system for allowing an RV owner to quickly and accurately level his or her RV. Ex. 1001 at 18. As any RV owner knows, the need to have a level RV to make the RV experience more comfortable has been long felt in the art, and prior systems were generally less efficient. *See, e.g.* Ex. 1005 at 15 (describing the slow iterative process of using the beeper device of Thorpe to level an RV). The ’925 Patent describes through both its figures and specification that it is intended for use in recreational vehicles. Ex. 1001 at 3-13 and 18. Moreover, the uses described all clearly relate to typical RV comfort issues.

Whether in a storage or use state, a recreational vehicle (RV) should be leveled for both practical and technical reasons. Practical reasons include a **level floor, proper door swings, stove and sink** use, as well

as many others. Technical reasons include proper operation of the ammonia based 30 refrigerator, level holding tanks for proper level detection by electronic means and for the proper operation of the plumbing and various other systems.

Id. at 18 (emphasis added).

The problem addressed in Clark has nothing to do with making an RV—or anything—level for a comfortable camping experience. Clark is a safety device:

The roll and pitch of vehicles and other objects have previously been monitored during jacking procedures by using clinometers such as plum bobs, spirit levels, or digital levels with direct-reading numerical displays. **These devices typically require that a human observer be located in a hazardous area**, such as a wheel well, during jacking and positioning operations.

Ex. 1006 at 8.

Despite this, Petitioner does not argue that Clark solves the problems related to comfort while camping addressed by the ’925 Patent.

b) Clark is Not in the Same “Field of Endeavor” as the ’925 Patent

In addition to Clark solving a different problem than those addressed in the ’925 Patent, the Petition also fails to establish that Clark is in the same field of endeavor as the ’925 Patent. The mere fact that both Clark and the ’925 Patent both generally relate to leveling carries little weight in view of the fact that the ’925 Patent relates to RVs and Clark relates to airplanes, and this proposition has been rejected by the Federal Circuit. *See In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (finding

that a reference cannot be considered within the disputed patent’s field of endeavor merely because both generally relate to the same industry).

This principle has been applied uniformly by other panels. *See, e.g., Ex Parte Malloy*, No. 2018-008189, 2019 WL 2369854, at *2 (P.T.A.B. May 28, 2019) (finding that a reference disclosing a sanitary napkin wrapper with an impervious barrier and an adhesive fastener was not in the same field of endeavor as an invention concerning wrappable protective sleeves having a separate fastener, despite both generally pertaining to wrappers with protective barriers); *Ex Parte Lee*, No. 2017-005938, 2018 WL 1621804, at *3 (P.T.A.B. Mar. 28, 2018) (reference disclosing an imaging process using a phase changing ink not within the same field of endeavor as a method for manufacturing an aluminum electrode using a solution product, despite both pertaining to a process to provide for precise pattern coatings”); *Ex Parte Ellis*, No. 2017-003864, 2018 WL 2059617, at *3 (P.T.A.B. Apr. 24, 2018) (reference disclosing a tow cable with a high strength to diameter ratio is not within the field of endeavor as invention directed to a system for approximating tissue comprising a flexible and resiliency biased cable, despite both generally pertaining to cables).

The field of endeavor test “is the narrower of the tests” for analogous art, *Ex Parte Chris Brough*, No. 2022-001819, 2022 WL 16861406, at *3 (P.T.A.B. Nov. 10, 2022). So it is improper to construe the field of endeavor relevant to the ’925

Patent so broadly as to encompass publications unrelated to RV leveling or leveling done in the context of camping. Petitioner ostensibly suggests that all software or devices related to leveling of any kind are in the same field of endeavor—but this cannot be the case. Thus, Clark is not in the same field of endeavor as the '925 Patent.

D. Grounds 2 and 4 Should Not Be Instituted for the Same Reasons as set Forth in Section III. B

Thorpe teaches away from the proposed combinations set forth in Grounds 2 and 4 for the same reasons as set forth in Section III. B, *supra*.

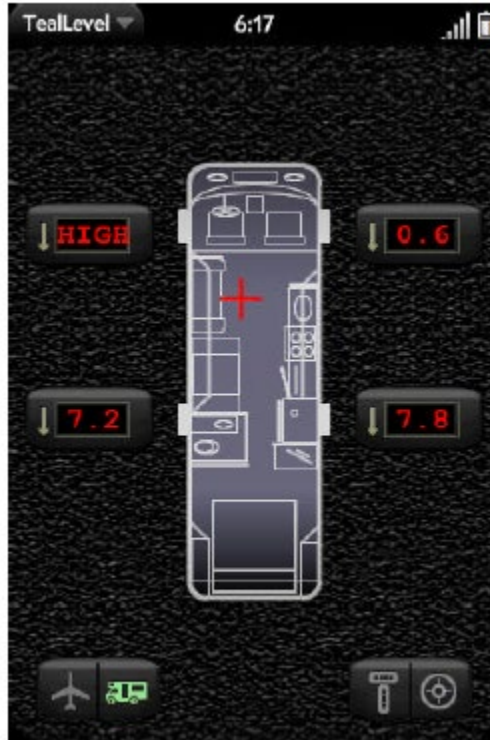
E. Grounds 2 and 4-6 Should Not Be Instituted Because TealLevel Teaches Away From the Combinations

Independent claims 1, 10, and 15 all recite claim language relating to adjustments of pitch and roll. Ex. 1001 29-30. TealLevel does not teach adjustments of pitch and roll. TealLevel describes adjustments made at each of the four corners of the vehicle, which correspond to shifts in the suspension rather than the pitch and roll adjustments claimed in the '925 Patent. Because TealLevel utilizes this fundamentally different mechanism of adjustment, TealLevel teaches away from the various modifications incorporating this reference set forth in Grounds 2 and 4-6.

“Under s 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Graham v. John Deere Co.*

of Kansas City, 383 U.S. 1, 17 (1966); *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001) (explaining that “[i]n a rejection for obviousness, the burden is on the USPTO to establish that all of the limitations of the claimed invention are taught in the prior art; if the prior art relied on does not teach all the limitations, the obviousness rejection must fall”). If the art does not disclose the recited features of the patent then it is not an invalidating prior art reference. *See, e.g., In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991) (explaining that “[t]he prior art simply does not disclose or suggest the expression in cyanobacteria of a chimeric gene encoding an insecticidally active protein, or convey to those of ordinary skill a reasonable expectation of success in doing so”). Here, not only does TealLevel not disclose adjustments to pitch and roll, but the adjustments it does teach are directly at odds with adjustments to pitch and roll, and so TealLevel actually teaches away from the proposed modification of Thorpe in view of TealLevel.

In TealLevel, adjustments are made to each of the four corners of the vehicle:



Ex. 1018 at 3.

In contrast, the '925 Patent relates to adjustments to the pitch and roll:

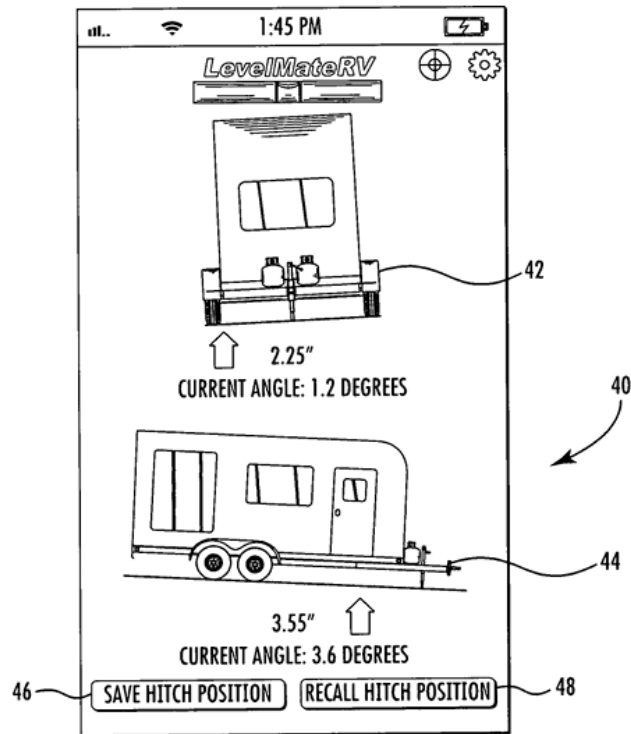


FIG. 5A

Ex. 1001 at 7.

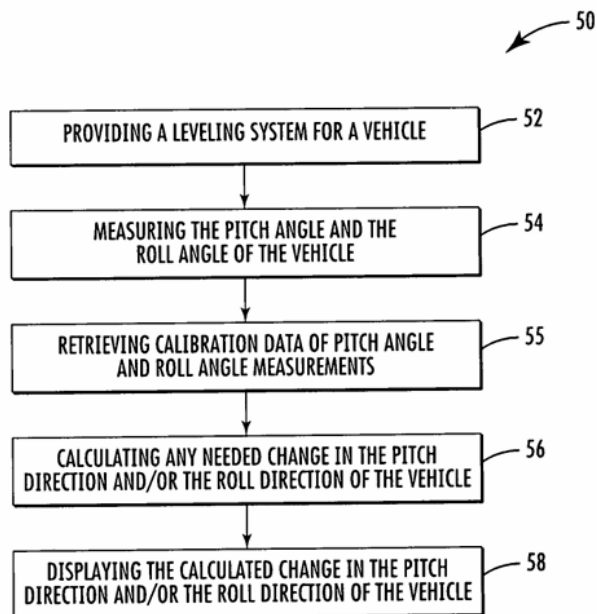


FIG. 9

Ex. 1001 at 14.

In some embodiments, the smart device 24 can be a smartphone capable of storing and executing software applications. These calculations can be based off of the determination of the pitch and roll angles using the calibration data to determine the pitch angle measurements and the roll angle measurements.

Ex. 1001 at 21.

This is also reflected in the language of the claims themselves. Claim 1 recites “a digital accelerometer that permits calculation in both the pitch direction and roll direction”; claim 10 recites “sensing an inclination of the recreational vehicle in both a pitch direction and a roll direction when the recreational vehicle is parked on an uneven surface of the ground”; and claim 15 recites “receiving a pitch angle measurement and a roll angle measurement of a vehicle from a sensor device secured to the vehicle when the vehicle is parked on an uneven surface of the ground.” Ex. 1001 at 29-30.

The difference between the adjustments of the four corners of the vehicle in TealLevel compared to the axes as claimed and described in the '925 patent are mathematically incompatible. Therefore, TealLevel does not disclose and to the contrary teaches away from such a modification. *Vaeck*, 947 F.2d at 493.

F. Grounds 2 and 4-6 Should Also Not Be Instituted Because TealLevel teaches away from Being Modified by Garceau

TealLevel's technology is centered around a single device (a Palm Pilot), and its utility lies in the fact that leveling can be achieved entirely with that device alone.

Ex. 1018 at 3. This standalone functionality underscores its design philosophy and technical appeal—a design that teaches away from use of two separate devices for sensing and displaying as in the ‘925 Patent. *Id.* For this reason, a POSITA would not have combined TealLevel with another device, as doing so would contradict its intended purpose.

The Petition does not provide any compelling reason why a POSITA would modify TealLevel to function in conjunction with additional devices, Pet. at 38, nor does it explain how such a modification would yield the claimed invention. Consequently, reliance on TealLevel to meet the limitations of the claims is both unsupported and unreasonable.

This argument applies to Grounds 2, 4, 5, and 6 because TealLevel is relied upon in all four grounds.

IV. THE BOARD SHOULD ALSO EXERCISE DISCRETION UNDER 35 U.S.C. § 314 TO DENY INSTITUTION

Institution of inter partes review is always discretionary. 35 U.S.C. § 314(a). The Board should exercise its discretion under § 314(a) to deny institution here.

A. The Board should exercise its discretion to deny institution of this Petition

The Board should deny institution under § 314(a) in view of its precedential decisions in *NHK Spring* and *Fintiv* because the district court and the parties have already expended substantial time and resources, ETN’s motion to stay has been challenged and a decision is forthcoming, and a final written decision (“FWD”) in

this proceeding is expected no earlier than March 2026, which could be well after the jury trial begins in the district court case. *NHK Spring Co., Ltd., v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sep. 12, 2018) (precedential); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (“*Fintiv*”) (precedential).

Notably, Petitioner has provided no *Sotera* stipulation resulting in an overlap of invalidity issues. Duplicating the district court’s efforts would not be an efficient use of the Board’s resources and would not serve to fulfill the primary purpose of AIA proceedings: to provide a practical and efficient alternative to district court litigation.

In *NHK Spring*, the Board denied institution primarily because the related district court case was nearing its final stages and would resolve all the issues before the Board. *NHK Spring*, Paper 8 at 20; *see also id.*, 11-18 (applying discretion under 35 U.S.C. §325(d)). Other cases—relying on *NHK Spring*—have also denied institution. For example, in *E-One, Inc. v. Oshkosh Corp.*, the Board applied *NHK Spring*’s analysis under 35 U.S.C. § 314(a) to deny institution. IPR2019-00161, Paper 16 (PTAB May 15, 2019). In *E-One*, the Board reasoned:

[i]n the § 314(a) portion of its analysis, [NHK Spring] noted that a district court proceeding involving the same patent was scheduled to go to trial before a final decision would have been due in the Board proceeding, and the Board proceeding would involve the same claim construction standard, the same prior art references, and the same arguments as in the district court.

Id., 6. In both *NHK Spring* and *E-One*, factors warranting a denial of institution included: the district court investing considerable time and resources to handle the same issues presented in the IPR, and trials that were scheduled to be completed prior to a Board’s FWD. The facts here warrant denial just as in *NHK Spring* and *E-One*. Further, the Petition will not serve as an “effective and efficient alternative” to litigation, frustrating a primary objective of the AIA. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential).

In *Fintiv*, the Board emphasized six factors to consider under *NHK Spring* which are discussed below. *See Fintiv*, Paper 11 at 5-16. The Board stated that “[t]hese factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. Here, each of these factors favors denial of institution of this Petition. Because the overall balance of factors favors denial of institution, the Board should apply its discretion under 35 U.S.C. § 314(a) to deny institution of the requested proceeding.

1. The First *Fintiv* Factor Weighs Against Institution Because The District Court Case is not Stayed

The parallel district court proceeding has not been stayed. Despite filing a motion for a stay, no order has issued and ETN has not yet stayed the action in the

district court litigation. Ex. 2001. Because the district court proceeding has not been stayed, this factor favors a discretionary denial.

2. The Second *Fintiv* Factor Weighs Against Institution Because Trial Will Likely Occur in the District Court Prior to the Final Written Decision Deadline in the IPR

Trials regularly occur within three years of a complaint being filed in the Eastern District of North Carolina. “The data shows that, on average, it takes nearly three years (35 months) from the filing of a civil case until trial in a federal court in North Carolina.” Are We There Yet? The Journey to Lawsuit Resolution in North Carolina Federal Courts, law.com, published May 01, 2024 by Mike Mitchell, Ed Roche, and Shameka Rolla (*available at* <https://www.law.com/2024/05/01/are-we-there-yet-the-journey-to-lawsuit-resolution-in-north-carolina-federal-courts/?slreturn=20241224-34848>). Because trial is likely to occur prior to a FWD, this factor favors a discretionary denial.

3. The Third *Fintiv* Factor Weighs Against Institution Because The Parties Have Invested and Will Continue to Invest Significant Time and Resources in the Parallel Proceeding

Both ETN and FBA have, to date, put a significant amount of work into the district court litigation. Ex. 2001. The district court case has been pending for over a year. *Id.* Plaintiff has made good faith efforts to advance the district court case. *Id.* The parties briefed and the district judge ruled on a TRO. *Id.* After that, the complaint was amended and there was a fully briefed Motion to Dismiss decided by

the district court judge. *Id.* There was then a subsequent amendment to the complaint, and another fully briefed motion to dismiss addressing different legal issues related to infringement. *Id.* After that, ETN filed a motion to stay, which is still pending. *Id.*

The substantial briefing performed by the parties on the claims and significant amendments to the complaint all have developed the parties' positions with respect to claim construction and further clarified the issues with respect to infringement related thereto. In view of the work that has been performed in the district court litigation, FBA respectfully submits that this *Fintiv* factor weighs in favor of the Board denying institution.

4. The Fourth *Fintiv* Factor Weighs Against Institution Because the Issues and Parties are the Same

The dispute in this proceeding and the district court case involve the exact same parties. FBA is the only Plaintiff in the district court litigation and ETN is the sole Defendant. Therefore, this factor weighs against institution.

5. The Fifth *Fintiv* Factor Weighs Against Institution Because the Issues are the Same

In the context of a district court litigation the validity of a patent can be challenged on any grounds brought forth in a post-grant proceeding before the PTAB. Therefore, all issues of validity in the present IPR are subsumed by the issues in the district court proceeding.

6. The Sixth *Fintiv* Factor Weighs Against Institution Because the IPR is Demonstrably Weak

In addition, the sixth and final *Fintiv* factor weighs against institution. For all the reasons set forth above in Section III, including that this IPR Petition is based on the same main reference that the Examiner relied on in prosecution, ETN is unlikely to succeed on the merits in this IPR. For that reason, the sixth factor also weighs against institution.

V. CONCLUSION

For the foregoing reasons, institution of this IPR should be denied.

Dated: December 30, 2024

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned hereby confirms that the foregoing Patent Owner Preliminary Response complies with the type-volume limitation of 37 C.F.R. § 42.24(a). Excluding the items listed in 37 C.F.R. § 42.24(a), the Patent Owner Preliminary Response contains 7416 words, calculated by the word-processing system used to prepare it.

Dated: December 30, 2024

By: /Paul L. Fraulo/
Paul L. Fraulo (Reg. No. 72,121)
Attorney for FBA Operating Co.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a true copy of the foregoing Patent Owner Preliminary Response was served on David E. Bennett (dbennett@coatsandbennett.com), David D. Kalish (dkalish@coatsandbennett.com), and Katsiaryna Fox (kfox@coatsandbennett.com), by e-mail.

Petitioner has consented to service by electronic means.

Respectfully submitted,

Dated: December 30, 2024

By: /Paul L. Fraulo/
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