

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

DECENT ESPRESSO INTERNATIONAL LTD.,
Petitioner,

v.

DUVALL ESPRESSO IP ENFORCEMENT, LLC,
Patent Owner

Case IPR2025-00747

U.S. Patent No. 11,957,271

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

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This Reply addresses arguments in Patent Owner's ("PO") Preliminary Response (Paper No. 10, "POPR"), as permitted by the Board's email of July 30, 2025 (permitting a reply not exceeding 5 pages).

I. Buttiker's Prior Art Status

PO mischaracterizes the Petition as admitting that the Buttiker reference is not prior art. (POPR pp. 18-20). PO incorrectly states, "Petitioner admits that the '688 Application supports all claims in the '271 Patent..." POPR p. 18. But the opposite is true; Petitioner explicitly argued that the intervening '456 patent added new matter and thus the claims of the intervening '456 patent were only "entitled to an effective filing date no earlier than August 16, 2013." Petition p. 19.

Petitioner pointed to at least three specific elements claimed in the intervening '456 Patent that were not in the provisional '688 application. Petition p. 19. The '271 Patent claims benefit to and shares a common specification with the '456 Patent and thus likewise contains the same new matter added by PO to the '456 Patent. Ex. 1001. It is clear that the '688 application does not support all of the disclosures in '271 Patent specification. Thus, Petitioner provided *prima facie* evidence that the '271 Patent is only entitled to a priority date of no earlier than August 16, 2013 – the effective filing date of the '456 Patent. Petition p. 19.

Accordingly, as further explained below, the burden was on PO to show that the

688 provisional supported an earlier priority date. Yet PO did not.¹ And Buttiker predates the *prima facie* effective filing date.

The Petition explicitly showed that new matter was added to the non-provisional applications that claimed priority to the ‘688 application, including the application that led to the ‘271 patent. Petition p. 19. With this showing, it became PO’s responsibility to show that the 688 provisional supported an earlier priority date than August 16, 2013. “[W]hen a patent owner attempts to antedate an asserted prior art reference, the patent owner assumes a temporary burden of production.” *Parus v. Google*, 70 F.4th 1365, 1371 (Fed. Cir. 2023). Here, the POPR made zero attempts to show the presence of each element of the challenged claims in the ‘688 provisional application. Thus, the challenged claims are entitled to a priority date no earlier than August 16, 2013, and not entitled to the earlier filing date of the lesser disclosure in the ‘688 provisional application. The Buttiker reference was filed in 2012, published in July 2013, and is prior art. Ex. 1010-1. And, due to the inclusion of certain post-AIA disclosures in the claims of the ‘456 patent, PO is entitled only to AIA first-to-file invalidity provisions, limiting PO to

¹ PO’s argument regarding a statement that “Petitioner does not herein argue as to whether the 688 application adequately supports the claims of the ‘271 patent...” is a red herring. The statement is merely a reference to the fact that Petitioner was relying on the new matter and effective filing date of the ‘456 Patent do demonstrate that the effective filing date of ‘271 Patent is August 16, 2013, rather than extensive argument in a short space over every detail of every claim of the ‘271 Patent. But even a cursory comparison of the ‘688 provisional application with the ‘271 Patent claims confirms that claim terms such as “resulting solvent” are not found in the ‘688 provisional application.

a priority date no earlier than August 16, 2013. Petition p. 20.

II. Motivation to Combine

PO mischaracterizes the motivation to combine evidence and arguments in two key ways. (POPR pp. 26, 30, 40).

At POPR p. 26, PO misrepresents that this Petition is similar to a previous petition by Petitioner in which the Board found that a “general motivation to combine statement” was overly broad and insufficient. (POPR p. 26 (citing Ex. 2001), POPR p. 40). This misrepresents the current Petition in which, unlike the previous petition, Petitioner provided an almost six-page explanation of motivation to combine that explicitly explained why differing ambient temperature water supplies and greater delta-T would have led a person of ordinary skill to combine the references. (Petition pp. 27-32). In particular, the petition considered in Ex. 2001 included the equivalent of two full pages of discussion of general motivation to combine. *See* Petition in IPR2024-01483 at pp. 26-28. In the Petition in this proceeding, however, Petitioner included almost six pages of particularized discussion of motivation to combine. Petition pp. 27-32. Petitioner explained why a POSA would seek modifications to both Startz’s and Coccia’s systems, why the ambient water temperature variations in various regions, buildings, and outdoors, would have led to motivation to combine, why controlling delta-T would have been important, why similar or identical pumps would be advantageous, and why

particular prior art references would be combined. *Id.* The discussion and evidence of motivation to combine far exceeds what was presented in the petition considered in Ex. 2001 on which PO erroneously attempts to rely for a comparison.

PO also misrepresents Expert Witness Tinkler's testimony about motivation to combine as being limited to statements that a person of ordinary skill "could" have made a combination. (POPR pp. 15, 30). PO cites case law stating that an obviousness analysis should be based on whether a POSA "not only could have made but would have been motivated to make the combinations..." POPR p. 30. But PO misrepresents the expert testimony.

Contrary to PO's argument, at Ex. 1002 ¶¶50-58, Expert Witness Tinkler testified approximately 20 times about what a person of ordinary skill "would have" done. And even paragraph 55, cited at POPR p. 30, states that "a POSA **would have** known that in some instances the goals **would** better **be** accomplished and the problems **would** better **be** solved when a machine **could be** built with ..." Ex. 1002 ¶ 55 (emphasis added). It is clear that Expert Witness Tinkler based his analysis on what a POSA "would have" been motivated to do and that the "could have" language was used only within the broader statement regarding the "would have" framework. PO directly misrepresents Expert Witness Tinkler's testimony as employing an improper framework when the testimony directly tracked with the legal requirements. And this specific testimony is cited in the petition,

demonstrating that Petitioner adopted Expert Witness Tinkler's testimony in Petitioner's discussion of motivation to combine the various prior art references. *See* Petition pp. 27-32 (citing Ex. 1002 at pages 28 through 33 which contain paragraphs 50-58).

III. PO's Characterization of Claim 5

PO mischaracterizes the limitations of claim 5 by combining the limitations of claims 1 through 5 in manners that suggest limitations that are not present and that also suggest an ordering of the steps that is not present in the claim language. POPR pp. 17-18. PO's proposed combination of claims 1-5 suggests that the first pump and second pump are both upstream of the brewing chamber, but no claim language requires that limitation. *Id.* PO's proposed combination of claims 1-5 further erroneously suggests that the claim limitations must occur in an order in which the "electronically controlling" element is placed at a sequential location in the claim that is not supported by the claim language.

Petitioner notes that the claim language is more accurately read as presented in the issued patent, rather than trying to cobble it together in a manner that suggests limitations and ordering that are not present in the claim language.

IV. Conclusion

As set forth in the Petition and this reply, the IPR should be instituted on all requested grounds for all claims not disclaimed by PO.

Respectfully submitted,

By: /s/ Perry S. Clegg/

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CERTIFICATE OF SERVICE

I hereby certify that on August 7, 2025, I caused a true and correct copy of the foregoing materials:

- Petitioner's Reply to Patent Owner Preliminary Response

to be served via electronic mail on the following attorneys of record for Patent Owner:

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Respectfully submitted,

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