

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

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IPR2025-00747  
Patent No. 11,957,271

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**PATENT OWNER’S PRELIMINARY SUR-REPLY**

Pursuant to the Board’s authority, Petitioner was given up to five pages to address purported issues raised in its email dated July 30, 2025 (“Pet. Email”) concerning Patent Owner’s (“PO”) preliminary response “POPR”, wherein PO was also given up to five pages to file a sur-reply thereto.

## **I. Alleged Mischaracterization of the Buttiker Reference**

Petitioner asserts in the Pet. Email that PO “mischaracterizes the Petition as admitting that the Buttiker reference is prior art”, but in its Reply states that PO “mischaracterizes the Petition as admitting that the Buttiker reference is not prior art.” Paper 11 (“Reply”), at 2 (emphasis added) (citing to pages 18-20 of the POPR). Not only are these statements contradicting, but, more importantly, these statements are also completely false and not what Petitioner has even briefed in its Reply. Specifically, there is nothing PO has mischaracterized regarding Buttiker; rather, based on the POPR, it appears Petitioner has now realized Buttiker is not prior art under § 102 and thus its entire argument has failed. Rather than attempt to argue why Buttiker *is* prior art, Petitioner is now asserting and attempting to provide evidence, for the first time, that the pending claims 5-6 and 9-10 of the ’271 Patent are not supported by the effective filing date of August 16, 2012. This argument and purported evidence is moot considering Petitioner’s admission that “Petitioner does not herein argue as to whether the 688 application adequately supports the claims of the ’271 patent, but merely that the claims of the ’271 patent are not entitled to pre-AIA treatment.” POPR, at 3, 18–19 (“POPR”); Paper 1 (“Pet.”), at 20.

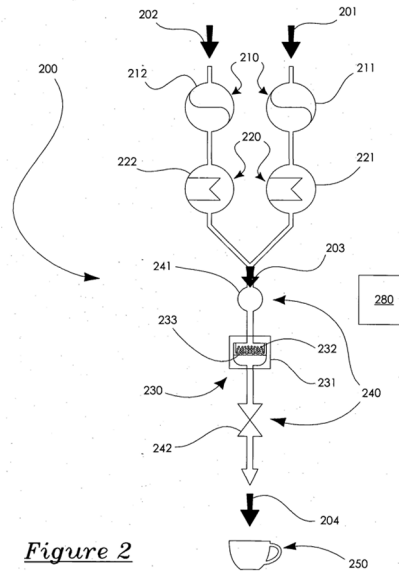
Buttressing its admission, Petitioner’s entire analysis appears to be premised on the ’271 Patent’s effective filing date August 12, 2012. *See* Pet., at 5, 6, 14, 27, 28, 31 (“Expert witness Tinkler worked for Keurig and collaborated with numerous

coffee machine companies during the period from 2005-2015, surrounding the filing dates of the 271 patent's earliest provisional and non-provisional applications, in 2012 and 2013"), ("Expert Tinkler confirms that numerous control systems of the type claimed in the 271 patent were known by August 2012") ("Numerous such controls systems and their components were known to a POSA as of August 2012") ("he and the POSAs working for him designed and assisted with the design of over 60 machines or systems, many of which were publicly known before August 2012"), ("Many other coffee machine systems that would be within the knowledge of a POSA (in August 2012)").

The Petition only asserted that another patent in the chain of priority, i.e., U.S. Patent No. 10,772,456, claimed matter not disclosed in the provisional application, not that the '271 Patent did not have support from the provisional patent application and Petitioner has provided no case law or authority that the effective filing date of the '271 Patent is not the provisional application (regardless if another patent in the chain did not) provided that claims 5-6 and 9-10 have support under 35 U.S.C. § 112. *See* MPEP § 2152.01. Because the Petition did not contest the support in the provisional application for claims 5-6 and 9-10 of the '271 Patent, the Petitioner has not satisfied its burden to show Buttiker is prior art.

Notwithstanding the Petition's clear deficiencies, claims 5-6 and 9-10 (and their dependent claims by reference) had support in the provisional patent

application. As discussed in the POPR, the method of electronically controlling both pumps with a controller to generate a desired flow rate and one or both of the thermal modulators to generate selectively desired temperatures upstream of the brewing chamber into a resulting solvent for infusing a solute and discharging the infused beverage through an outlet was entirely disclosed in the provisional application. *Compare* POPR, at 16–18, 35–37, to Ex. 1012, at 12–15 (“For example, if desired infusion flow rate is 1 cc/sec, pump 211 may pump at 0.7 cc/sec and pump 212 may pump at 0.3 cc/sec. SFMS 210 may be independently controlled or coupled to control system 280 which modulates pumps 211 and 212 to achieve a required flow rate of solvents 201 and 202, respectively, based on total desired flow rate of solvent 203 and desired infusion temperature as explained below.”) (“STMS 220 may be connected to control system 280 which may modulate and/or monitor temperature of the respective solvents as necessary. Solvent temperatures may be utilized by control system 280 to modulate performance of SFMS to achieve desired infusion temperature and flow rate during an infusion.”). FIG. 2 of the provisional patent application is also reproduced below for convenience and depicts said claimed subject matter, thereby making Petitioner’s new arguments moot and/or overcome.



## II. Alleged Mischaracterization of the Motivation to Combine

Petitioner next asserts in the Pet. Email the POPR mischaracterized evidence concerning motivation to combine because it “misrepresents that this Petition is similar to a previous petition” and because “PO also misrepresents the expert’s testimony about motivation to combine as being limited to statements that a person of ordinary skill ‘could’ have made a combination.” *See also* Reply, at 4–5 (citing to POPR, at 26, 30, 40). Petitioner again misconstrues the POPR. Pages 26 and 40 simply argue, based on the prior discussions therein concerning the lack of specificity, the Board should similarly find, like it did the in the prior petitions filed by Petitioner, that broad assertions do not meet the standard for showing motivation to combine. Furthermore, the reference on page 30 to a quote from Petitioner’s expert concerning what a POSITA “could” have done comes directly from its expert declaration, so while Petitioner may not like what its expert has written, there is also

nothing mischaracterized from his quote and the POPR speaks for itself describing Petitioner's purported expert's lack of specificity and articulation concerning motivation to combine.

### **III. Alleged Mischaracterization of Claim 5**

Petitioner also asserts in the Pet. Email that the POPR “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.”<sup>1</sup> *See also* Reply, at 6 (citing to pages 17-18 of the POPR). Namely, Petitioner takes issue with the suggestion that “the first pump and second pump are both upstream of the brewing chamber”, but this clearly was supported by claim 4 with reference to inducing the solvents in the first and second solvent conduit (which claim 1 requires be “upstream of the brewing chamber”) with the first and second pumps, respectively. *See* Ex. 1001, at 16:17–24, 42–46. The Petitioner also takes issue with the “electronically controlling” language placement, but PO submits regardless the placement, claim 5 still requires electronic control of the first and second pumps, which are also claimed as being upstream of the brewing chamber. *Id.* at 16:47–51. As such, PO has misconstrued nothing with its recitation of the claims and Petition should again be denied.

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<sup>1</sup> Interestingly, Petitioner does not take issue with the similar methodology utilized by PO with respect claim 9, claim 8, and claim 1. *See* POPR, at 35–37.

Respectfully submitted,

Dated: August 18, 2025

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e)(4), I hereby certify that the foregoing document was served on March 12, 2025, via email to counsel for Petitioner, i.e., Perry S. Clegg ([perry.clegg@johnsonmartinlaw.com](mailto:perry.clegg@johnsonmartinlaw.com)), Matthew S. Nelles ([matt.nelles@johnsonmartinlaw.com](mailto:matt.nelles@johnsonmartinlaw.com)), and James David Johnson ([david.johnson@johnsonmartinlaw.com](mailto:david.johnson@johnsonmartinlaw.com)).

Respectfully submitted,

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