

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FLSMIDTH INC.,
Petitioner,

v.

METSO OUTOTEC (FINLAND) OY,
Patent Owner.

IPR2025-00985
Patent No. 9,518,604

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION
UNDER 35 U.S.C. § 314(a) AND/OR § 325(d)**

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I. INTRODUCTION

Patent Owner Metso Finland Oy (“Metso” or “Patent Owner”) submits this Request for Discretionary Denial of Institution.

The ’604 patent has been in force since 2016—nearly 9 years now. Its international priority application published even earlier: in 2014. Patent Owner has commercialized the patented technology for many years, without challenge, in globally deployed grinding mills since the patent issued. Petitioner, on the other hand, waited for years before bringing this challenge. And Petitioner had reason to act sooner, given that the parties are direct competitors in the same technology space and had litigated other patents in that same space. Because the Director routinely denies institution of petitions involving even more recently issued patents based on “settled expectations,” the facts here even more heavily favor denial under § 314(a).

Denial is also warranted under § 325(d). Every ground relies on art already considered during prosecution (in some cases, applied too). While the Petition also relies on other references in arguing its obviousness combinations, those references are undeniably cumulative of that already considered. Petitioner’s argument that the Examiner erred in not applying art to all pending claims amounts to nothing more than disagreement, as the Examiner reasonably determined to not apply that art against certain claims. Because Petitioner merely rehashes the same issues correctly resolved during prosecution, denial under § 325(d) is also appropriate.

II. THE '604 PATENT

A. Technology Background

Patent Owner is a global leader in the design and manufacture of grinding mills, with over a century of experience in the industry. Among its many innovations is its Polymer Hydrostatic Shoe Bearing (PHSB), which relates to the '604 patent. Ex. 2001 at 1 (“The Metso [PHSB] significantly improves radial and axial bearing reliability and longevity.”); Ex. 2002 at 2 (“Over the years, [Metso—which acquired Outotec in 2020] has continued to innovate and develop its [PHSB] technology.”).

The PHSB has been widely adopted for its improved performance and maintenance. Ex. 2001 at 2 (“With over 10 million hours of production, the [Metso] Polymer HSB system is a proven way to maximize mill availability.”); Ex. 2002 at 3 (Metso “has been supplying Polymer HSB systems” on grinding mills “since 2013.”). It significantly enhances bearing reliability, minimizes the risk of damage to critical components, and increases grinding mill uptime—each providing substantial benefits for large-scale grinding mills. Ex. 2001 at 1-2.

The PHSB supports rotating journals of grinding mills that weigh hundreds to thousands of tons. *See* Ex. 2003 at 3 (explaining that over the last 20 years, only Metso and FLSmidth have delivered 40 foot SAG mills—the largest in the world—underscoring the extreme scale and weight of the rotating mill bodies these bearings support). The PHSB was thus designed to withstand extreme loading conditions. *Id.*

If such a bearing fails, the resulting shutdown can cost a mill tens of millions of dollars per day. *See, e.g.*, Ex. 2002 at 3-4. This underscores the importance of the improved bearings disclosed and claimed by the '604 patent.

Importantly, the patent's disclosure has been publicly available for over a decade. Ex. 1001 at 2 (first published in 2014). During this time, Patent Owner has incorporated the patented technology into its bearings and deployed them globally. And even though the patent's bearing technology has been well known to those in the grinding-mill market—including Petitioner FLSmidth—the patent's claims have always remained unchallenged until now. This long period of commercialization and industry awareness has contributed to a strong foundation of settled expectations.

B. Patent Overview

The '604 patent discloses a polymer-based hydrostatic bearing assembly designed to support the rotating journal of large-scale grinding mills using fluid lubrication. Ex. 1001 at 1:37-41, 9:28-39. As the patent explains, the disclosed bearings can tolerate more oil loss and journal distortion, require less stringent machining tolerances, and reduce reliance on pressure accumulators. *Id.* at 1:65-2:67.

The disclosed polymer bearings also have other structural improvements. These include lubrication and mounting features. *E.g., id.* at 9:54-10:11. Also, the bearing pads are made from polymer materials, such as polyetheretherketone (PEEK), rather than bronze or white metal that are typically “spray welded or cast”

onto the base. *Id.* at 2:35-52, 4:14-19, 7:4-9, 17:26-31.

The disclosed polymer pads are mounted to a metal base having internal passages and fluid ports that supply pressurized oil to the bearing surface. *Id.* at 9:54-10:18; *see also id.* at 11:15-39 (disclosing that the mounting portion helps “lock” the pad, avoiding a “wipe” or delamination from frictional loads). Each pad has an outer surface that interfaces with the rotating journal. *Id.* at 10:12-18. These pads also have at least one recess for receiving and distributing oil and the mounting portion for securely attaching the pad to the base. *Id.* at 9:40-10:18, Figs. 4-8. The patent’s Fig. 6, reproduced below, shows an exemplary embodiment of the disclosed bearing.

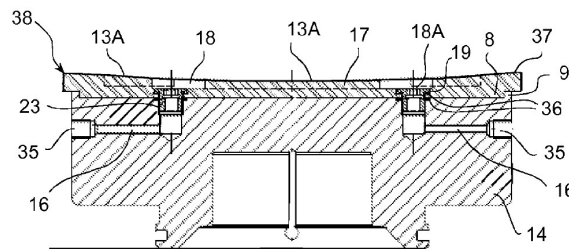


Fig. 6

As the '604 patent explains, the improved bearing assembly offers several significant advantages over conventional bearings:

- Self-Molding Behavior: The disclosed bearings conform to journal imperfections, allowing for more cost-effective machine tolerances. *Id.* at 12:33-47. This also reduces the need for self-aligning mechanisms, enabling more compact bearings. *Id.* at 13:25-37.
- Reduced Lubrication Requirements: The disclosed bearings enable reduced lubrication rates, permitting removal of complex accumulators.

Id. at 12:48-54, 13:39-51.

- Elastic Cushioning: The disclosed bearings have a lower modulus of elasticity, enabling an effective cushion for the journal while maintaining pressure. *Id.* at 12:55-61.
- Tolerance to Oil Loss: The disclosed bearings tolerate a temporary oil film loss without damaging the journal or base. *Id.* at 12:62-13:2.
- Shock Absorption: The disclosed bearings absorb shock loads, minimizing the risk of damage to critical components. *Id.* at 13:3-19.
- Contaminant Tolerance: The disclosed bearings also absorb fluid contaminants without disrupting operation. *Id.* at 13:20-24.

C. Prosecution of the '604 Patent

The '604 patent claims priority to Australian Patent Application 2012902770, filed June 28, 2012, and International Application PCT/IB2013/055305, filed June 28, 2013. Ex. 1001 at 2. The patent then issued on December 13, 2016. *Id.*

The Petition asserts several references already before the Examiner. *See* Pet. at 9-11. Some were applied in an Office Action, while others were considered by the Examiner. In fact, every reference that the Petition relies upon for an independent claim element was either before the Examiner or cumulative of art considered during prosecution. The Examiner found the claims patentable over all this art.

Specifically, in the April 27, 2016 Office Action, the Examiner expressly applied GB 1,508,384 (“GB384”) and U.S. Pub. 2012/0099993 (“the '993

Publication”) to reject original claims 63, 64, and 69. Ex. 1002 at 45-46. For *GB384*, it was applied for disclosing most limitations of claim 63 (now issued claim 21). The Examiner acknowledged, however, it “does not disclose . . . polymer.” *Id.* at 46. In an attempt to remedy the associated deficiencies, the Examiner applied the ’993 *Publication*, arguing one would have used a polymer pad in the *GB384* bearing. *Id.*

In that same Action, the Examiner indicated that independent claims 53 and 54 (issued claims 1 and 11) were allowed. *Id.* at 46. Unlike the rejected claim, these allowed claims recited a “bearing assembly for supporting a journal of a grinding mill body,” rather than a “multidirectional fluid bearing for a journal,” and included additional structural limitations, such as a particular “mounting element” for securing the polymer pad and multiple fluid bearings—each with its own base and polymer pad—rather than two pads mounted on a single base. *Id.* at 26-31. In response, Patent Owner amended claim 63 (now claim 21) to incorporate the allowable subject matter of dependent claim 67. *Id.* at 28-29. The Examiner then allowed all claims. *Id.* at 14.

The Petition also recycles other prior art from the prosecution. *See infra* Section IV.A (explaining each ground is based on the same or cumulative art and reasoning). In addition to *GB384* and the ’993 *Publication*, the Examiner also considered German Patent DE 102007039364 (“*DE364*”), relied upon in the Petition across Grounds 1-5. *DE364* was among only seven documents listed in the sole IDS, which the Examiner considered before the above Office Action. Ex. 1002 at 58-59.

III. THE PETITION SHOULD BE DENIED UNDER § 314(a)

In exercising its authority to deny institution, the Director considers the parties settled expectations, including “the length of time the claims have been in force.”

Interim Processes for PTAB Workload Management at 2-3 (USPTO Acting Director Mar. 26, 2025). This consideration weighs decisively against institution.

The '604 patent has been in force for nearly a decade without challenge. Ex. 1001 at 2. During this time, Patent Owner has actively commercialized the patented technology. Ex. 2001; Ex. 2002 at 3 (Patent Owner “has been supplying [PHSB] systems” on grinding mills “since 2013.”). And Petitioner—a direct competitor in this field—has had ample reason to know of the patent. *See* Ex. 2003 at 3 (noting all large mills over the last 20 years were manufactured by FLSmidth or Metso); Ex. 2004 at 3 (both were platinum sponsors of the industry’s leading conference).

The Director has emphasized that “the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2-3 (Director June 18, 2025) (exercising discretion to deny review for a patent in force for “almost eight years”). The patent here has been in force for over eight years—longer than the patent in *Dabico* and those in many other recent denials based on settled expectations. *Id.*; *see also Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, -00602, Paper 9 at 3 (Director July 24, 2025) (denying based on settled expectations for patents “in force for seven and six years”);

T-Mobile USA, Inc. v. Smart RF Inc., IPR2025-00692, Paper 13 at 2 (Director July 29, 2025) (same for 8-year old patent); *Kangxi Commc'ns Techs. (Shanghai) Co. v. Skyworks Sols., Inc.*, IPR2025-00372, Paper 10 at 2 (Director July 16, 2025) (same for 7-year old patent); *Coretronic Corp. v. Maxell, Ltd.*, IPR2025-00476, Paper 10 at 2 (Director July 10, 2025) (same for 8-year old patent); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00435, Paper 11 at 3 (Director June 27, 2025) (same for 7-year old patent).

Moreover, Petitioner has had notice of the '604 patent's family for over a decade. The corresponding PCT application published on January 3, 2014, and the U.S. national stage application published on December 3, 2015. Ex. 1001 at 2. Such publications "provide notice to the public, other inventors, competitors, and commercial interests." *Dabico*, IPR2025-00408, Paper 21 at 3.

Petitioner's awareness is further confirmed by its history of patent disputes with Patent Owner. As early as 2007, the two companies became embroiled in U.S. litigation on patents involving related technology. Ex. 2005; *see also* Ex. 2007 (April 2025 letter from Petitioner, sent on near eve of this Petition, offering to settle an Australian lawsuit involving unrelated patents by a license to the '604 patent family). Petitioner has also evidently monitored and opposed Patent Owner's patents. *E.g.*, Ex. 2006. These actions show Petitioner long had reasons to (and did) monitor Patent Owner's portfolio, including the '604 patent.

The Director has also emphasized that delayed challenges between competitors will strengthen settled expectations. In *Murata Mfg. Co. v. Georgia Tech Research Corp.*, the Director found it significant that “Petitioner was aware that Patent Owner was involved in the same technology space for a significant amount of time before filing its Petition,” concluding that “failure to seek early review of the patent favors denial and outweighs [other] considerations.” IPR2025-00383, Paper 14 at 2-3 (Director July 29, 2025). That rationale applies here with greater force.

Petitioner has been aware of Patent Owner’s activity in this technology space since at least 2007 (long before the ’604 patent), as shown by the prior disputes and the monitoring of Patent Owner’s portfolio. *E.g.*, Ex. 2005; Ex. 2006. That delay is particularly telling given Petitioner’s current assertion that the claims were obvious, while never itself adopting the polymer-based bearing it now deems so obvious.

This case also presents a stronger basis for denial than *Murata*, where the patent owner had “never commercialized the challenged patent.” IPR2025-00383, Paper 14 at 2. Here, Patent Owner has actively commercialized the technology for over a decade, successfully integrating it into bearing systems for grinding mills. Ex. 2002 at 2 (“Over the years, [Metso] has continued to innovate and develop its [PHSB] technology.”), 3 (Metso “has been supplying” the PHSB “since 2013.”). And, again, it has done so in systems that directly compete with those of Petitioner. Ex. 2008 at 1-2 (referring to the “hydrostatic lift” of FLSmidth’s bronze bearings);

Ex. 2003 at 3 (noting all large mills over the last 20 years were from FLSmidth or Metso). These facts reinforce that the settled expectations in this case are particularly strong. *See also Intel Corp. v. Proxense, LLC*, IPR2025-00327, Paper 12 at 2-3 (Director June 26, 2025) (explaining settled expectations are stronger for patents “commercialized . . . in a petitioner’s particular technology space”).

There is no persuasive justification to disturb these settled expectations. Petitioner’s years of inaction—despite years of direct competition and apparent patent monitoring—only reinforces that the validity expectations have long since settled. Institution should be denied under § 314(a).

IV. THE PETITION SHOULD BE DENIED UNDER § 325(d)

Determining whether to deny under § 325(d) involves a two-part framework: (1) whether the “same or substantially the same” art or arguments were previously presented to the Office; and (2) if so, whether the “Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7-8 (PTAB Feb. 13, 2020). Six non-exclusive factors guide the analysis. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017). Under *Becton*, “factors (a), (b), and (d) relate to the first part of [that] framework,” and “factors (c), (e), and (f) relate to the second part.” *Autel Intelligent Tech. Corp. v. Orange Elec. Co.*, IPR2021-01545, Paper 8 at 13 (PTAB Apr. 8, 2022).

Part one of *Advanced Bionics* is met because each ground in the Petition relies on art that is either the same as, or cumulative of, art considered by the Examiner. For part two, Petitioner fails to demonstrate that the Office erred in its consideration of *GB384* and the '993 *Publication* when applying those in an Office Action.

A. The Petition's Art Overlaps With the Art Before the Examiner

Petitioner offers only a single, conclusory statement in an effort to distinguish its cited art from the prosecution record, asserting that “all of the grounds rely on combinations of art that were not analyzed by the Examiner during prosecution.” Pet. at 82. Petitioner here seems to equate “analyzed” with whether the Examiner applied a specific prior art combination in an Office Action. That is misleading, particularly where, as here, the Examiner considered art now asserted by Petitioner. The fact that the Examiner did not apply a specific combination of such art in an Office Action does not mean the art or arguments were not previously analyzed.

Petitioner's assertion is more fundamentally flawed too. The relevant inquiry under part one of *Advanced Bionics* is not whether a precise combination was “analyzed,” but whether the art or arguments are “the same or substantially the same” as those already “presented to the Office.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8-10. For the reasons explained below, that is the case here.

1. Ground 1: Based on Same Art and Cumulative Reasoning

Ground 1 relies on two references before the Examiner: *GB384* (Ex. 1003) as

the primary and *DE364* (Exs. 1004-1005) as the secondary. Pet. at 33-51.

GB384 was applied by the Examiner in the Office Action. Ex. 1002 at 45-46. Patent Owner amended the rejected claims to overcome that rejection, and the Examiner ultimately allowed all claims. Ex. 1002 at 32; *see supra* Section II.C. *GB384* is thus listed on the face of the '604 patent. Ex. 1001 at 3.

DE364 is no better. It was one of only seven references listed in the sole IDS that the Examiner considered. Ex. 1002 at 59. *DE364* is thus also listed on the face of the patent. Ex. 1001 at 2. The Petition attempts to sidestep these facts by asserting that the Examiner made “no written analysis” of *DE364*. Pet. at 11. At best, this is legally flawed. There is no requirement that the Examiner provide a written analysis. *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 4 (Director May 19, 2025) (finding part one of *Advanced Bionics* met with “prior art that was previously presented on an IDS”).

Moreover, the Petition’s reliance on *DE364* simply rehashes the Examiner’s own analysis. During prosecution, the Examiner relied on the '993 *Publication* (another reference regurgitated in the Petition) for the alleged teaching of using a “polymer” as a bearing pad. *See* Ex. 1002 at 46 (Examiner acknowledging *GB384* “does not disclose polymer” as a bearing pad, and citing the '993 *Publication* for that teaching). Petitioner’s reliance on *DE364* mimics that same logic, even retaining the same *GB384* primary reference. Petitioner simply substitutes *DE364* for

the *'993 Publication*, relying on one sentence mentioning the use of a variety of materials, including “polyether ketone (PEEK) polyamide-imide (PAI) or polyimide (PI)”—and then alleging that one would have used “polymer” in the bearing of the primary reference. Pet. at 36.

And like the *'993 Publication* (which concerned wind turbines), *DE364* also concerned a different application (paper processing). Not only do both relate to entirely different applications, but they also disclose different bearings and pad structures,¹ not the claimed “a polymer bearing pad mounted to a base” in a “bearing assembly” for use in a high-load “grinding mill.” Ex. 1001 at cls. 1, 11. Grinding mills operate under loads an order of magnitude greater than those in *DE364* or the *'993 Publication*, requiring mounting features that prevent displacement of a polymer pad under extreme forces. *See, e.g.*, Ex. 1001 at 11:15-25.

Because the Examiner already considered the combination of *GB384* in view of a secondary reference like *DE364* that mentioned the use a “polymer” in very

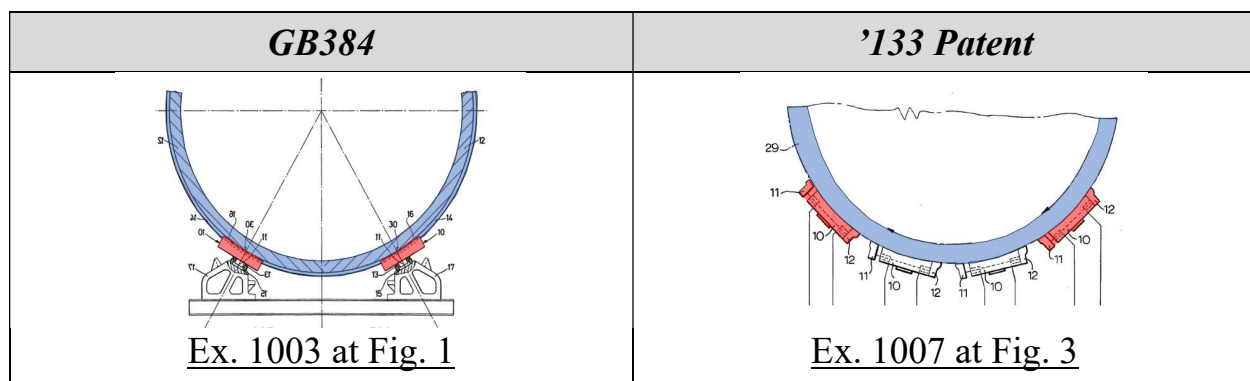
¹ The *'993 Publication* does not disclose a polymer bearing pad, only applying a polymer lining to a metal pad in a different type of bearing for another application. Ex. 1013 at [0029]-[0030]. Similarly, *DE364* has a sacrificial wear part unsuited for pads in grinding mills. Ex. 1005 at [0025]; Pet. at 44 (conceding wear part 30 will “wear out over time, or . . . designed to fail first”).

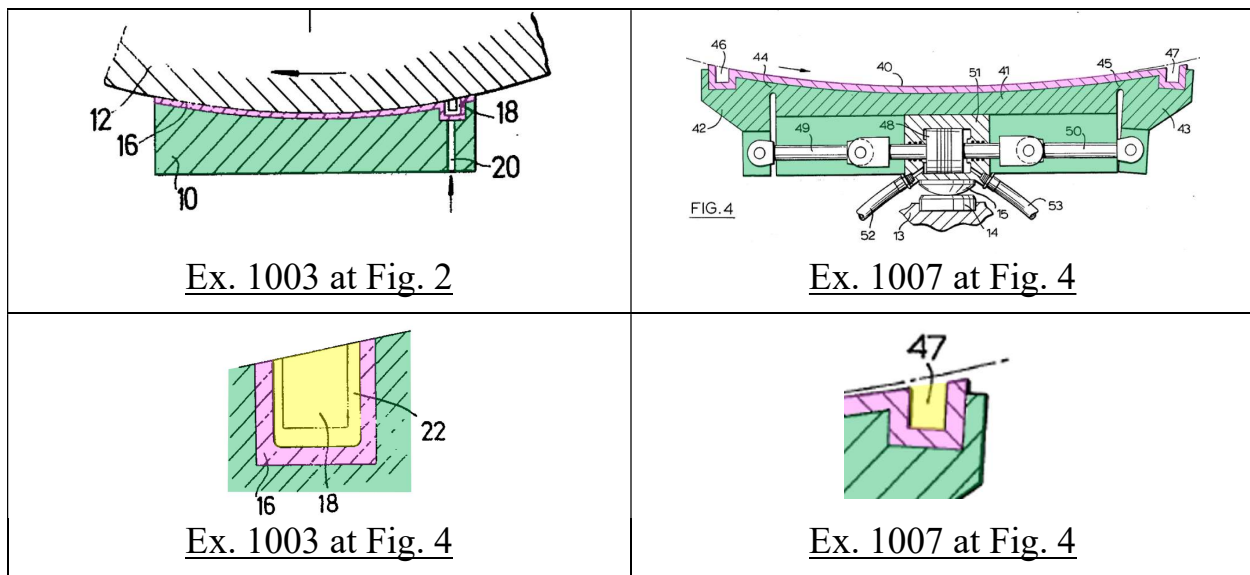
different types of bearings, and because *DE364* itself was also before the Examiner, Ground 1 presents no materially distinct art or argument that could justify institution here. Ground 1 thus satisfies the first prong of *Advanced Bionics*.

2. Ground 5: Also Based on Overlapping Art and Reasoning

Ground 5 relies on the *'133 Patent* (Ex. 1007) as the primary and *DE364* as the secondary. Pet. at 64-74. As explained, *DE364* was already considered. As to the *'133 Patent*, it is plainly cumulative of *GB384* for the reasons below. And neither reference, alone or in combination, offers any new material teachings.

In substance, Ground 5 essentially duplicates Ground 1. Both rely on a primary reference disclosing a fluid bearing with a non-polymer lining. See Pet. at 33-51, 64-74. Ground 5 substitutes the *'133 Patent* for *GB384*. The differences between these two references are immaterial, however. As illustrated below, both disclose a **rotating journal** supported by **mounted bearing shoes** including a **base portion** and **anti-friction lining** including a **transverse oil channel** on its surface.





This overlap is substantive given the claim language and the Examiner’s analysis. *See* Ex. 1003 at 1:9-13, 1:59-63, 2:39-45; Ex. 1007 at Abstract, 2:20-31.

Indeed, neither primary reference discloses a “polymer” pad or the structural adaptations necessary to support the claimed pads. *See* Pet. at 35 (“GB384 does not identify the composition of its bearing pad”), 65 (“[The] ’133 [Patent] does not identify the composition of the liner 40.”). So, like Ground 1, the Petition again relies on *DE364* in Ground 5 for the alleged teaching of a “polymer” bearing pad for use in the bearing assembly of the primary reference. *Id.* at 65.

But *DE364* was considered by the Examiner, and the Petition relies upon it for essentially the same reasoning the Examiner used in applying the ’993 *Publication*. Ex. 1002 at 59; *see supra* Section IV.A.1 (explaining the Petition’s reliance on *DE364* rehashes the Examiner’s reliance on the ’993 *Publication*).

In short, Ground 5 presents substantially the same prior art and arguments

already considered by the Examiner. The structural concepts Petitioner relies upon in the '133 *Patent* are cumulative of those disclosed in *GB384*, and *DE364* (like the '993 *Publication*) was expressly considered and used in substantially the same way. Ground 5 thus merely rehashes the same issues overcome during prosecution. The first prong of the *Advanced Bionics* framework is thus met here.

3. Ground 6: Based Again on Overlapping Art and Reasoning—While *Trygg* Adds Nothing New

Ground 6 relies on the *Metso Brochure* (Ex. 1006) as the primary, in combination with the '993 *Publication* (Ex. 1013) and *Trygg* (Ex. 1009). Pet. at 75-80. As explained below, this ground rehashes the earlier prosecution too.

The *Metso Brochure*, in fact, corresponds to the '604 patent's own "Background" section. The Petition itself admits this. Pet. at 7-8 (acknowledging that the patent's "Background" discloses "aspects of hydrostatic bearing pads that were 'currently in use'" and the *Metso Brochure* is "[a]n example of this") (citing Ex. 1001 at 1:65-2:13). Indeed, Petitioner relies on a single passage of the *Metso Brochure* that overlaps with the patent's "Background." Compare Ex. 1006 at 5 (describing "Hydrostatic lubrication systems for bearings"), with Ex. 1001 at 1:65-2:2 (describing "applicant developed [] hydrostatic pad bearing system").

While Petitioner says the *Metso Brochure* "is not admitted prior art," Petitioner confusingly describes it as a "visual reference to assist the Board in

understanding the admitted prior art.” Pet. at 8 n.1. Petitioner also discusses this reference in the Petition’s “Admitted Prior Art” section. *Id.* at 8. Regardless, as Petitioner acknowledges, the *Metso Brochure*’s relevant disclosure was before the Examiner during prosecution.

And as explained, the ‘993 *Publication* was considered by the Examiner, applied in an Office Action, and even relied upon during prosecution for the same purpose the Petition does so now. Ex. 1002 at 45-46, 58-59 (applying the ‘993 *Publication* for alleged disclosure of “polymer” pad features); Pet. at 75-76 (same).

While Ground 6 also refers to *Trygg*, this reference is not applied for any particular claim limitation. The Petition only refers to it for motivation. Pet. at 79-80 (stating a “POSITA would have known from *Trygg* (as well as general knowledge in the art) of the benefits . . .”). And as Petitioner implicitly recognizes here, these alleged “benefits” attributed to *Trygg* were already known to the Examiner. *Id.*

Ground 6 thus relies on the same or substantially the same prior art and arguments that were already before the Office. The first prong of the *Advanced Bionics* framework is thus met for this ground too.

4. Grounds 2-4: The Other Art Cited For These Dependent Claims Do Not Change the Result

Grounds 2-4 repeat the same *GB384* / *DE364* combination from Ground 1, adding only a single tertiary reference in each ground for an additional dependent

claim limitation. Pet. at 51-63. But adding an additional reference for a few dependent claims does not avoid the first prong of *Advanced Bionics. Kayak Software Corp. v. IBM*, CBM2016-00075, Paper 16 at 10 (PTAB Dec. 15, 2016) (holding Petitioners' citation of a reference not previously considered by the Examiner solely for "additional subject matter of certain dependent claims[] is insufficient"). The first prong of *Advanced Bionics* is still satisfied.

B. Petitioner Fails to Demonstrate Any Material Error

As shown above, each asserted ground relies on prior art and arguments already before the Examiner or on art flatly cumulative of those. To overcome this, Petitioner seeks to manufacture an alleged "error" by the Office. Pet. at 81-82. But under *Becton* factors (c), (e), and (f), Petitioner must explain "how the Examiner erred in overlooking the prior art." *Ecto World*, IPR2024-01280, Paper 13 at 5-6. And where, as here, the Examiner applied the same or substantially the same art during examination, Petitioner must still show both that the art "teaches" the claimed limitations and that "no reasonable examiner could have found otherwise." *Id.*

Further, where (as here) the alleged error amounts to nothing more than a "disagreement with a specific finding of record by the Office," Petitioner (who bears the burden) ordinarily must "persuasively" prove that there was an error. *Advanced Bionics*, IPR2019-01469, Paper 6 at 10-11. It is not enough if "reasonable minds can disagree." *Id.* at 9. Petitioner utterly fails to satisfy that burden here.

1. Petitioner's One "Error" Wrongly Assumes the Examiner Failed to Appreciate a Reference Applied During Prosecution

For *Becton* factor (c), Petitioner focuses exclusively on the Examiner's treatment of *GB384*. Pet. at 81 (arguing the "Examiner's failure to substantively rely on *GB384* with respect to claims 1-20 was a material error."). The Examiner, however, substantively evaluated and applied *GB384* during prosecution. Ex. 1002 at 45-46. While Petitioner also briefly mentions the '993 *Publication* in its § 325(d) arguments, Pet. at 81, the Examiner applied that reference too. *See* Ex. 1002 at 45-46. Even Petitioner recognizes this. *Id.* at 9-11.

As discussed, both references formed the Examiner's basis for rejecting original claims 63, 64, and 69, and the Examiner found the remaining claims allowable. *See supra* Section II.C. Given the differences between these claims and the limited number of references of record, Ex. 1001 at 2-3, it is highly implausible that the Examiner failed to properly consider either *GB384* or the '993 *Publication*.²

As for the Petition's other asserted references, Petitioner does not provide any analysis about how the Examiner evaluated them or whether they differed materially from art the Examiner did consider. To illustrate, *DE364* was among only seven

² The Patent Owner Preliminary Response will further explain the deficiencies of *GB384* and/or the '933 *Publication* with respect to the claim language.

documents listed in the sole IDS. Ex. 1002 at 58-59. For such art, the Board has said a petitioner must provide an analysis under prong two of *Advanced Bionics*, and Petitioner cannot rely solely on its alleged unpatentability grounds. *See Ecto World*, IPR2024-01280, Paper 13 at 5. Petitioner has wholly failed to do that here.

2. Petitioner’s One Alleged “Error” is Also Wrong

Regarding *Becton* factor (e), Petitioner’s alleged “error” is that the “Examiner failed to consider *GB384* substantively during prosecution and/or *GB384* was misapprehended.” Pet. at 81-82. According to Petitioner, “[b]ased on the Examiner’s own analysis of *GB384*, the Examiner erred in allowing Claim[s] 1 and 11” because they “recite all of the elements the Examiner stated were present” when rejecting application claim 63, “except for a ‘mounting element’ and functional language regarding a self-adjusting or fixed bearing.” *Id.* This characterization is wrong.

As discussed above, claim 21 resulted from application claim 63 amended to incorporate dependent claim 67. Ex. 1002 at 28-29, 45-46. The Examiner ultimately agreed *GB384* and other art did not disclose the resulting claim 21. The Examiner did not also reject claims 1 and 11 because their claims are different in scope:

(1) Claims 1 and 11 require “a frame” and that “said base is mounted to said frame,” a structural feature absent from claim 63, which recites only “a base.” *Compare* Ex. 1001, cls. 1, 11, *with* Ex. 1002 at 28-29.

(2) Claims 1 and 11 concern a “bearing assembly for . . . a grinding mill body,” while claim 63 concerned a “multidirectional fluid bearing for a journal.” *Id.*

(3) Claim 1 requires “fluid bearings [that] self adjust to changes in the angular position of the journal during operation of said grinding mill body,” and claim 11 requires the “base is fixedly mounted to said frame;” claim 63 did not. *Id.*

(4) Claims 1 and 11 require “a mounting element for securely mounting said polymer bearing pad to said base;” claim 63 did not. *Id.*

These additional limitations—especially when viewed collectively—explain why the Examiner did not apply *GB384* to claims 1 and 11. The Examiner did not overlook or misapprehend *GB384* in evaluating the features in these claims.

As an example, for the “mounting element” limitations of claims 1 and 11, Petitioner merely relies upon the top surface of shoe 10 in *GB384*. Pet. at 37 (stating “shoe 10 has a surface (i.e., mounting element)”). But the surfaces of the shoe 10 in *GB384*, which are simply “covered with a lining 16,” does not equate to the claimed “mounting element for securely mounting said polymer bearing pad to said base.” Ex. 1003 at 2:69-47. In fact, nothing in *GB384* discloses any type of mounting element, let alone one that would work for “securely mounting” a “polymer bearing pad” or the associated claimed structural limitations. The ‘604 patent itself explains the import of these claim elements. *See, e.g.*, Ex. 1001 at 11:15-25 (explaining

“mounting portion 8” helps lock the pad in place so “frictional loads . . . do not forcibly remove or ‘wipe’” it from the base).

Moreover, Petitioner appears to concede *GB384*’s shortcomings here by relying on a different reference, *DE364*, for these claim elements. Pet. at 37-38. As discussed above, *DE364*, like the *'993 Publication*, was before the Examiner, and neither remedies *GB384*’s deficiencies. *See supra* Section IV.A.1.

At bottom, the record reflects that the Examiner properly considered *GB384* together with the other art and reasonably concluded that no proper combination taught claims 1 and 11. Petitioner’s disagreement falls far short of any error here. *Becton* factor (e) thus favors denial.

3. Petitioner Offers No Additional Evidence to Justify Reconsideration—And None Exists

Regarding *Becton* factor (f), Petitioner identifies no additional evidence or facts that would justify a different outcome. At best, the Petition relies on the same or cumulative prior art already substantively evaluated during prosecution, with Petitioner merely disagreeing with the Examiner’s earlier findings. Pet. at 80-81. Under *Advanced Bionics*, this absence of new evidence weighs heavily against institution. IPR2019-01469, Paper 6 at 9. *Becton* factor (f) thus also favors denial.

V. CONCLUSION

For these reasons, the Director should exercise its discretion and deny institution under 35 U.S.C. § 314(a) and/or 35 U.S.C. § 325(d).

Respectfully submitted,

Dated: August 18, 2025

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I, Timothy J. May, certify that **Patent Owner's Request for Discretionary Denial of Institution** contains 5,108 words, excluding those portions identified in 37 C.F.R. § 42.24(a), as measured by the word-processing system used to prepare this paper.

Dated: August 18, 2025

By: / Timothy J. May /
Timothy J. May,
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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Patent Owner's Request for Discretionary Denial of Institution** was served on August 18, 2025, via e-mail directed to counsel of record for the Petitioner at the following:

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