

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 REPLY IN SUPPORT OF REQUEST FOR
DISCRETIONARY DENIAL**

Patent Owner submits this Reply in support of its Request for Discretionary Denial pursuant to the Director's authorization. Petitioner's Opposition significantly expands its material error allegations, now (1) invoking DE364, the '993 Publication, and "general knowledge," (2) extending its error theories to claim 21, and (3) even relying on select foreign prosecution records. Opp. at 40-57. Yet, even with these additions, Petitioner still fails to persuasively identify any teaching the Examiner misapprehended or overlooked in a manner material to patentability. The record shows the Examiner applied GB384 with the '993 Publication, considered DE364 as listed on the IDS, and made reasoned judgments. Claims 1 and 11 were deemed allowable as filed, while claim 21 was initially rejected and later allowed only after amendment. All this demonstrates consideration, not oversight. Nor does Petitioner's reliance on foreign prosecution establish error. U.S. law does not defer to outcomes abroad, particularly on different claim sets and under different legal standards.

I. CLAIMS 1 AND 11: EXPANDED ARGUMENTS SHOW NO OVERLOOKED TEACHING

The Opposition argues GB384 discloses all elements of claim 1 except "polymer," and that DE364 and general knowledge supply that missing feature. Opp. at 42-45. But the problem with these new arguments is that the Examiner already addressed this by rejecting original claims over GB384 and the '993 Publication. Ex. 1002 at 45-46. DE364 was considered by the Examiner too. It was one of only seven

documents listed on the IDS, which included the International Search Report from the corresponding PCT application and other references in the Petition. *Id.* at 58-59.

Independent claims 1 and 11, by contrast, were properly allowed. The Examiner found them allowable upon considering GB384, the '993 Publication, and DE364. *Id.* at 46. That decision demonstrates sound judgment, not oversight. At most, Petitioner disagrees with the Examiner's judgment, which is not material error. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8-9 (PTAB Feb. 13, 2020) ("If reasonable minds can disagree . . . it cannot be said that the Office erred in a manner material to patentability.").

The Opposition also argues GB384 discloses the "mounting element" and "self-adjusting" features. Opp. at 46-51. As explained in the Preliminary Response, GB384 does not disclose any structure that could possibly correspond to the claimed "mounting element," and nothing in GB384 suggests the claimed self-adjusting features. *See* Prelim. Resp. at 12-15. The Examiner, therefore, correctly concluded GB384 lacked at least these claimed features. Petitioner's disagreement cannot be recast as "error."

Finally, claim 11 differs from claim 1 in requiring a "fixedly mounted" base. The Petition had offered only a passing reference to general knowledge and no substantive discussion of that limitation in its material error section. Pet. at 44-45 (Ground 1), 80-82 (material error analysis). The Opposition now tries to develop a

new theory but still fails to identify any overlooked teaching. For at least the reasons discussed above with respect to claim 1, there is no material error in claim 11.

II. CLAIM 21: NEW ERROR THEORY STILL FAILS

The Petition expressly limited its material error allegation to “claims 1-20.” Pet. at 80. It said nothing about claim 21. Yet the Opposition devotes five pages to claim 21. Opp. at 53-57. Despite this, Petitioner faults Patent Owner for “not address[ing] claim 21” and asserts the Examiner overlooked DE364 and general knowledge when allowing claim 21. *Id.* This adds nothing persuasive.

Claim 21, originally claim 63, was initially rejected over GB384 and the ’993 Publication. Ex. 1002 at 45-46. Patent Owner then amended claim 21 to incorporate allowable fastening limitations. *Id.* at 28-29, 46. DE364, already of record, was considered and found insufficient to render the amended features obvious. *Id.* at 58-59. The Examiner allowed the claim only after those amendments, reflecting his judgment that the art of record did not render the amended limitations obvious.

To establish material error, Petitioner must identify a persuasive teaching the Examiner overlooked that would have changed the outcome. *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. The Opposition identifies no such teaching. It points to alleged fastening structures in DE364, which the Examiner had before him and considered, but found insufficient once the claims were amended. That conclusion cannot be recast as “overlooked.”

III. THE FOREIGN PROSECUTION PROVIDES NO ERROR HERE

The Opposition also invokes the International Preliminary Report on Patentability (“IPRP”) and the EPO record of a foreign counterpart application in an effort to bolster its expanded error theories. *See Opp.* at 49-50. Those materials do not establish that the U.S. Examiner misapprehended or overlooked anything.

First, U.S. law does not defer to foreign outcomes. The Federal Circuit cautions against “indiscriminate reliance” on foreign prosecution because “theories and laws of patentability vary from country to country, as do examination practices.” *AIA Eng’g Ltd. v. Magotteaux Int’l*, 657 F.3d 1264, 1279 (Fed. Cir. 2011); *see also Heidelberg Druckmaschinen AG v. Hantscho Com. Prods., Inc.*, 21 F.3d 1068, 1072 (Fed. Cir. 1994) (“Caution is required when applying the action of a foreign patent examiner . . . for international uniformity in theory and practice has not been achieved.”). The Board likewise has declined to treat European proceedings as determinative of U.S. outcomes. *Bose Corp. v. Koss Corp.*, IPR2021-00297, Paper 41 at 45-46 (PTAB May 31, 2022) (rejecting patent owner’s European prosecution statements as a “blatant admission” and non-dispositive).

Second, the foreign outcomes themselves were different. While Petitioner points to the EPO’s initial rejection of claims corresponding to U.S. claims 1 and 11, *Opp.* at 19, other offices reached a different result. For example, the Australian Patent Office initially adopted the IPRP’s reasoning against GB384, but eventually

agreed that GB384 teaches away from polymer pads and allowed the claims. Ex. 2009 at 118, 186-187, 259. That allowance predated the U.S. Office Action of April 27, 2016. Ex. 1002 at 45-46. Thus, even if foreign prosecution were probative, the Australian record was available at the time, and undercuts Petitioner's assertion that foreign outcomes show clear error.

Finally, Petitioner's suggestion that "even a cursory review" of the foreign record reveals material error is overstated. Opp. at 4. If that were true, Petitioner would have made that showing in its Petition. But it did not. And its belated reliance on the foreign record adds nothing to its burden to prove that the U.S. Examiner misapprehended or overlooked material prior art.

IV. Conclusion

The Opposition still identifies no persuasive teaching the Examiner misapprehended or overlooked in a manner material to patentability. Mere disagreement with reasoned judgments is not material error. Because Petitioner has not carried its burden, discretionary denial is warranted.

Respectfully submitted,

Dated: September 29, 2025

By: / Timothy J. May /
Timothy J. May, Reg. No. 41,538
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP

Lead Counsel for Patent Owner
Metso Finland Oy

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Patent Owner's Reply in Support of Request for Discretionary Denial** was served on September 29, 2025, via e-mail directed to counsel of record for the Petitioner at the following:

Jed H. Hansen
Kurtis Hendricks
THORPE NORTH & WESTERN, LLP
175 South Main Street, Suite 900
Salt Lake City, UT 84111
hansen@tnw.com
kurt.hendricks@tnw.com
tnw_litigation@tnw.com

Petitioner has consented to service by electronic mail.

Dated: September 29, 2025

/ William Esper /
William Esper
Senior Litigation Paralegal
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP