

Filed on behalf of:

Patent Owner

By: Alison L. McCarthy (Lead Counsel)

Alison.McCarthy@Troutman.com

Joshua L. Jones (Back-up Counsel)

Joshua.L.Jones@Troutman.com

Paper No. _____

Date: January 12, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFTWERX USA INC.,
Petitioner,

v.

LIFTRA IP APS,
Patent Owner.

Case IPR2026-00102
Patent 12,104,578

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

LIST OF PATENT OWNER'S EXHIBITS

PO Exhibit Number	Description
	Filed and Served on January 12, 2026 with Patent Owner's Request for Discretionary Denial
2001	Complaint for Declaratory Judgment of Noninfringement filed October 23, 2025 in <i>LiftWrx USA Inc. v. Liftra IP ApS</i> , Case No. 2:25-cv-00679 (EDVA) ("EDVA Litigation") ("EDVA Complaint")
2002	Table C-5, U.S. District Courts, Civil Federal judicial Caseload Statistics (March 31, 2025), in Federal Judicial Caseload Statistics 2025 Tables , https://www.uscourts.gov/data-news/data-tables/2025/03/31/federal-judicial-caseload-statistics/c-5 (last updated March 31, 2025)
2003	Table C-5, U.S. District Courts, Civil Federal judicial Caseload Statistics (June 30, 2025), in Federal Judicial Caseload Statistics 2025 Tables , https://www.uscourts.gov/data-news/data-tables/2025/06/30/statistical-tables-federal-judiciary/c-5 (last updated June 30, 2025)
2004	Liftra IP APS's Answer, Affirmative Defenses, and Counterclaims filed January 9, 2026 in EDVA Litigation ("EDVA Answer")

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. THE CHALLENGED PATENT AND THE PROCEDURAL HISTORY	3
A. The ’578 Patent	3
B. The Procedural History	4
III. DISCRETIONARY DENIAL OF INSTITUTION UNDER 35 USC 314 IS MERITED	6
A. <i>Fintiv</i> Factor 1: No Stay or Effort to Secure a Stay	6
B. <i>Fintiv</i> Factor 2: Jury Trial will Conclude Months Before A FWD Here	7
C. <i>Fintiv</i> Factor 3: The Court and Parties will have Invested Considerable Resources in the EDVA Litigation	8
D. <i>Fintiv</i> Factor 4: There is Considerable Overlap Between this IPR and the EDVA Litigation	8
E. <i>Fintiv</i> Factor 5: Parties Are the Same Entities	9
F. <i>Fintiv</i> Factor 6	9
IV. DENIAL OF INSTITUTION UNDER 35 USC § 325(d) IS MERITED BECAUSE THE PETITION APPLIES THE PRIOR ART FROM THE EXAMINATION OF THE ’578 PATENT	9
V. CONCLUSION.....	19

TABLE OF AUTHORITIES

	Page
Cases	
<i>Antares Pharma, Inc. v. Medac Pharma Inc.</i> , 771 F.3d 1354 (Fed. Cir. 2014)	15
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB. Mar. 20, 2020) (precedential)	6, 7, 8, 9
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (designated informative Mar. 21, 2018)	10, 16, 17, 18
<i>Garmin Int’l, Inc. v. Koninklijke Philips N.V.</i> , IPR2020-00754, Paper 11 (PTAB Oct. 27, 2020).....	8
<i>In re Float’N’Grill LLC</i> , 72 F.4th 1347 (Fed. Cir. 2023)	15
<i>Juniper Networks, Inc. v. Mobile Telecomm’ns Techs., LLC</i> , IPR2017-00642, Paper 24 (PTAB July 27, 2017).....	passim
<i>Unified Patents Inc. v. Berman</i> , IPR2016-01571, Paper 10 (PTAB Dec. 14, 2016) (designated informative Oct. 24, 2017)	10, 16
Statutes and Other Authorities	
35 U.S.C. § 314	6
35 U.S.C. § 314(a)	2, 6
35 U.S.C. § 325(d)	2, 3, 9, 10

IPR2026-00102 (Patent 12,104,578)
Patent Owner’s Request for Discretionary Denial

Stewart, Coke Morgan. *Interim Processes for PTAB Workload Management*, U.S. Patent and Trademark Office (Mar. 26, 2025),
<https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf> (“Director’s March 26, 2025 Memo”) 6

Patent Owner Liftra IP ApS (“Liftra” or “Patent Owner”) submits its Brief Requesting Discretionary Denial of Petitioner LiftWrx USA Inc.’s (“Petitioner” or “LiftWrx”) Petition (Paper No. 1) (“Petition”) seeking inter partes review (“IPR”) of U.S. Patent No. 12,104,578 (“the ’578 Patent”). This filing is timely and in accordance with the Notice of Filing Date Accorded from the Board entered November 12, 2025 (Paper 3). The Director should deny institution.

I. INTRODUCTION

Petitioner filed an action on October 23, 2025 seeking a declaratory judgment of non-infringement of U.S. Patent No. 10,378,518 (“the ’518 Patent”) and the ’578 Patent, case captioned *LiftWrx USA Inc. v. Liftra IP ApS*, Case No. 2:25-cv-00679 (“EDVA Litigation”). See EX2001 (EDVA Complaint). The EDVA litigation was filed in response to a European Seizure Proceeding filed in September of 2024 and a Canadian Infringement Proceeding filed in July of 2025 by Patent Owner against Petitioner asserting foreign counterparts to the ’578 Patent. See EX2001 (EDVA Complaint) at 4-7. About two weeks after filing the EDVA Litigation, on November 4, 2025, Petitioner filed this Petition challenging the ’578 Patent. Patent Owner filed its Answer and Counterclaims in the EDVA Litigation on January 9, 2026 asserting infringement of the ’578 Patent, the ’518 Patent, as well as U.S. Patent No. 12,473,179. See EX2004 (EDVA Answer) Patent Owner expects that Petitioner will respond with an affirmative defense of

invalidity, squarely placing the validity of the '578 Patent at issue in the EDVA Litigation. In fact, Petitioner filed a Sotera stipulation on January 8, 2026 (Paper 11) in which it asserts that it will pursue a challenge to the validity of the '578 Patent in the EDVA Litigation unless this Petition is instituted. That proposed stipulation acknowledges that Petitioner intends to pursue validity challenges to the '578 Patent in the EDVA Litigation. All of the '578 Patent validity challenges, which likely overlap with validity challenges to the related '518 Patent, are best considered in the EDVA Litigation initiated by Petitioner.

Petitioner intentionally filed its declaratory judgment action in the Eastern District of Virginia to take full advantage of that jurisdiction's "rocket docket" – and with that choice, the case is expected to be completely through trial in approximately sixteen (16) months from filing, or less. The Director should deny the Petition under 35 U.S.C. § 314(a) on all grounds, as the validity of the patent at issue will be decided in the parallel litigation before the conclusion of this proceeding.

The Petition should also be denied institution under 35 U.S.C. § 325(d), which explicitly authorizes denial of institution based on prior consideration of art or arguments by the U.S. Patent and Trademark Office ("USPTO" or "Patent Office"). That is precisely the case here, where Petitioner has presented the same two primary references that were applied in a rejection by the Examiner,

extensively considered, and overcome by Patent Owner during prosecution of the application resulting in the '578 Patent. Petitioner applies these identical references in the same way for the same purpose as the Examiner, who ultimately allowed the claims. Petitioner claims that the Examiner materially erred by conducting an “unreasonably narrow” search for prior art, but Petitioner did not identify any new material art. Instead, Petitioner applies the exact same combination of primary references and admits that its allegedly “new” secondary references are merely “fallback” arguments and entirely cumulative of the art applied by the Examiner and overcome during prosecution. The Petition simply repackages arguments carefully considered by the Examiner and overcome during prosecution of the application that led to the grant of the '578 Patent. Institution of this Petition merits denial under 35 U.S.C. 325(d).

II. THE CHALLENGED PATENT AND THE PROCEDURAL HISTORY

A. The '578 Patent

The '578 Patent issued on October 1, 2024 from U.S. Patent Application Serial No. 18/420,859, filed January 24, 2024; which is a Continuation of U.S. Patent Application Serial No. 16/452,617, filed June 26, 2019, now abandoned; which is a Division of U.S. Patent Application Serial No. 15/517,288, filed April 6, 2017, which issued as the '518 Patent on August 13, 2019; which is a National Stage Entry of PCT/DK2015/000040, filed October 6, 2015, published as WO

2016/055065 A1 on April 14, 2016; which claims priority from DK PA 2014 00573 filed October 7, 2014 and DK PA 2015 00527 filed September 4, 2015. *See* EX1001, cover, page 2. Petitioner has been aware of the '578 Patent since at least as early as its issue date of October 1, 2014. *See* EX1001 at cover. The '518 and '578 Patents are asserted in the EDVA Litigation.

B. The Procedural History

Patent Owner Liftra develops and manufactures standard and custom-made solutions for transportation, installation and maintenance of wind turbines worldwide. Petitioner is a specialized wind energy contractor offering lifting solutions for major component replacements in wind turbines.

Petitioner was originally a customer of Patent Owner. Petitioner LiftWerks purchased an LT1000 crane including a main shaft fixture from Patent Owner in 2016 and purchased a second such crane and fixture from a Liftra customer before 2021. *See* EX2001 at 50 of 110. These Liftra products are protected by, inter alia, the '578 Patent.

LiftWerks thereafter created infringing copies of the Liftra main shaft fixture, and on September 20, 2024 Patent Owner made a Request to the District Court of the Hague for permission to seize evidence of alleged infringement of European Patent No. 3,204,639 B1 (the "EP 639 Patent"). *See* EX2001 at 4 of 110. The seizure of evidence was executed in November of 2024, and subsequent

European Access Proceedings and European Infringement Proceedings were filed.

See EX2001 at 5-6 of 110. A patent infringement complaint asserting Canadian Patent No. 2,963,016 (“the CA 016 Patent”) was also filed on July 18, 2025. *See* EX2001 at 6 of 110. The EP 639 Patent and the CA 016 Patent are foreign counterparts to the '518 Patent, and LiftWerks has alleged that the EP 639 and CA 016 Patents are “closely related” to the '578 Patent. *See* EX2001 at 7-11 of 110.

On October 23, 2025, Petitioner filed the EDVA Litigation seeking a declaratory judgment of non-infringement against the '518 Patent and the '578 Patent related to main shaft fixture technology, the same technology at issue in Europe and Canada. *See* EX2001 (EDVA Complaint). Petitioner alleged, inter alia, that Patent Owner's claims of infringement in Europe and Canada “threaten actual and imminent injury to [Petitioner] ... and that injury is of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.” EX2001 at 12 of 110, ¶51. Patent Owner counterclaimed on January 9, 2026, asserting infringement of the '518 Patent and the '578 Patent, as well as U.S. Patent No. 12,473,179. *See* EX2004 (EDVA Answer).

III. DISCRETIONARY DENIAL OF INSTITUTION UNDER 35 USC 314 IS MERITED

The Petition should be denied pursuant to 35 U.S.C. § 314. Section 314(a) states that the “Director *may not* authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (emphasis added).

In determining whether to exercise discretionary power under § 314(a), the Director balances the six factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (Precedential) and may consider the non-exhaustive considerations enumerated in the Director's March 26, 2025 Memo. The Board takes a “holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, IPR2020-00019, Paper 11 at 6. Here, all six *Fintiv* factors weigh against institution and are addressed in turn below.

A. *Fintiv* Factor 1: No Stay or Effort to Secure a Stay

First, discretionary denial may not be appropriate if the Court or other tribunal granted a stay or evidence exists that one may be granted if the IPR proceeding is instituted. Here, no stay has been requested or granted. Nor does it seem likely that Petitioner will seek a stay of the EDVA Litigation, given that

Petitioner opted to file its case in a judicial district known for its expedient time from filing to trial, particularly in view of Petitioner's claim of "immediacy" in that action. This factor therefore favors denial of institution.

B. *Fintiv* Factor 2: Jury Trial will Conclude Months Before A FWD Here

Petitioner filed its EDVA Litigation on October 23, 2025. Patent Owner has now answered and counterclaimed. On average, in the Eastern District of Virginia, for the 12-month period ending March 31, 2025, the median time between filing and disposition for a civil case was 5.3 months, and between filing and trial was 13.5 months. See EX2002 ([Table C-5—U.S. District Courts—Civil Federal Judicial Caseload Statistics \(March 31, 2025\)](#) at 2 of 5. For the 12-month period ending June 30, 2025, the median time between filing and disposition for a civil case in the Eastern District of Virginia was 5.4 months, and between filing and trial was 11.9 months. See EX2003 ([Table C-5—U.S. District Courts—Civil Statistical Tables For The Federal Judiciary \(June 30, 2025\)](#) at 2 of 5. Assuming the lengthiest time to trial given recent statistics, the EDVA Litigation will go to trial approximately fourteen (14) months after filing, around December 2026. The Board's projected statutory deadline for a FWD here is May 12, 2027, five months after a trial will have concluded.

Petitioner clearly wished to avail itself of the beneficial timeline for time to disposition of a case in the EDVA. To institute this Petition would be a duplication

of efforts in determining the status of the patent at issue. This factor favors denial of institution. *See Garmin Int'l, Inc. v. Koninklijke Philips N.V.*, IPR2020-00754, Paper 11 at 9-12 (PTAB Oct. 27, 2020).

C. *Fintiv* Factor 3: The Court and Parties will have Invested Considerable Resources in the EDVA Litigation

The parties and the Court in the EDVA Litigation will invest significant resources in the coming months to be ready for a trial likely to occur within twelve to sixteen (12-16) months.

D. *Fintiv* Factor 4: There is Considerable Overlap Between this IPR and the EDVA Litigation

The issues raised in the Petition are encompassed in the EDVA Litigation. With the Patent Owner's counterclaims, the EDVA Litigation is situated to consider all issues of infringement and validity of the '578 Patent in one trial. Further, this Petition fails to present a meaningful challenge to validity of the '578 Patent because the art asserted in this Petition has already been considered by the Patent Office. The policies behind *Fintiv*, including reducing the potential for duplicative efforts and inconsistent results, thus favor discretionary denial. There can be no doubt that in filing the EDVA Litigation before this IPR, Petitioner knew it was commencing a case in which validity would be at issue. That Petitioner has now filed a Sotera stipulation acknowledges that Petitioner expects to address validity in its EDVA Litigation. Petitioner should be held to its initial choice of the

EDVA as the venue for decision on the merits of this action. This factor therefore favors denial of institution.

E. *Fintiv* Factor 5: Parties Are the Same Entities

The parties are the same across all tribunals. Petitioner is the declaratory judgment plaintiff in the EDVA Litigation, and Patent Owner is the declaratory judgment defendant. Thus, this factor favors denial of institution.

F. *Fintiv* Factor 6

Even if all the *Fintiv* factors did not already weigh in favor of denial, institution should also be denied because of the weak merits of the invalidity challenge. There is very little likelihood that the Petitioner will prevail with respect to any of the claims challenged in the Petition at least because Petitioner has asserted in this Petition the exact same art applied by the Examiner at the Patent Office. That art was overcome during prosecution and will be no more successful invalidating the '578 Patent now. This factor is specifically addressed in detail in Section IV., below, and favors denial.

IV. DENIAL OF INSTITUTION UNDER 35 USC § 325(d) IS MERITED BECAUSE THE PETITION APPLIES THE PRIOR ART FROM THE EXAMINATION OF THE '578 PATENT

35 U.S.C. § 325(d) explicitly authorizes denial of institution based on prior consideration of art or arguments by the USPTO: "In determining whether to institute or order [*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.” 35

U.S.C. § 325(d). Thus, the Director has discretion to refuse to institute *Inter Partes* Review where the “the same or substantially the same prior art or arguments were previously presented to the Office” during prosecution. *Unified Patents Inc. v. Berman*, IPR2016-01571, Paper 10 at 9 (PTAB Dec. 14, 2016) (designated informative Oct. 24, 2017); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (designated informative Mar. 21, 2018). Here, Petitioner bases its unpatentability arguments on the same prior art considered in detail by the Patent Office. Petitioner only adds additional obviousness references that are cumulative of prior art and there is no new issue of patentability presented.

Patent Owner will analyze 35 U.S.C. § 325(d) under the 6-factor *Juniper Networks* framework. When evaluating whether to deny institution under 35 U.S.C. § 325(d), the Director should consider the following factors:

- 1) The similarity of the asserted art and the prior art involved during examination;
- 2) The extent to which the asserted art was considered during examination, including whether the prior art was the basis for rejection;
- 3) The cumulative nature of the asserted art and the prior art considered during examination;
- 4) Whether Petitioner has pointed out sufficiently how the Examiner erred in its consideration of the asserted prior art;
- 5) The extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or the applicant's arguments during examination; and
- 6) The

extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art.

Juniper Networks, Inc. v. Mobile Telecomm'ns Techs., LLC, IPR2017-00642, Paper 24, at 8-9 (PTAB July 27, 2017). As will be demonstrated below, all these factors support denying the petition.

For *Juniper* Factor 1, similarity of the asserted art and the prior art involved during examination, Petitioner has presented four grounds challenging the claims of the '578 Patent in this petition.

Ground	Claims	Basis AIA §	References in Petition
1	1-4, 6-8, 10, and 13-14	103	Signore and Weaver in view of Power Climber, Holloway and/or Stegemann
2	2, 5, and 15	103	Signore and Weaver in view of Power Climber, Holloway, and/or Stegemann, further in view of Hanxing and/or Schulz
3	9, 11-12, and 16-17	103	Signore and Weaver in view of Power Climber, Holloway, and/or Stegemann, further in view of Cooper, Schaeffler, and/or Guerenbourg
4	1 and 3-17	102	'518 Patent

See Petition at 4 (independent claims emphasized).

Grounds 1-3 each present obviousness arguments primarily over Signore and Weaver, each of which was the basis for rejections and extensively considered by

the Examiner during prosecution of the '578 Patent as well as the parent '518 Patent.

Specifically, the application resulting in the '578 Patent was subject to a single office action. That non-final office action dated April 26, 2024 ("Office Action") rejected claims 1-4, 6-8, 10, and 13-14 under 35 USC 103 as being unpatentable over Signore (US 2012/0141292) in view of Weaver (EP 1748182). *See* EX1002 at 87 of 177. Signore (EX1007) and Weaver (EX1008) are the same references relied upon in the Petition, shown above, for the obviousness combination.

The Examiner's rejections in the Office Action were overcome by Patent Owner in its response, dated July 26, 2024 ("Response"). *See* EX1002 at 66-76 of 177. Patent Owner explicitly argued that the Signore and Weaver art fail to disclose the claim 1 limitation "that the main shaft fixture further comprises mounting facilities adapted for anchoring a crane on/in a nacelle of a wind turbine." EX1002 at 73-74 of 177. The Examiner then conducted another search. *See* EX1002 at 28-32, 34-62 of 177. Finding no additional material art, the Examiner issued a Notice of Allowance on August 15, 2024. *See* EX1002 at 21-27 of 177. The Reasons for Allowance set forth by the Examiner include that the cited art – Signore and Weaver – "does not teach the main shaft fixture further having

mounting facilities adapted for anchoring a crane on or in a nacelle of a wind turbine.” EX1002 at 26 of 177.

The application resulting in the '518 Patent, the parent of the '578 Patent, was also rejected over Signore in combination with Weaver, and those rejections were ultimately overcome. EX1006 (OA dated 6/29/2018) at 98 of 349 and EX1006 (OA dated 1/31/2019) at 41 of 349 (both rejecting the claims under 35 USC § 103 as being unpatentable over Signore in view of Weaver). The Signore and Weaver art was therefore considered in great detail in the prosecution of both the '518 Patent and the '578 Patent.

Ground 4 of the Petition asserts that the '578 Patent is anticipated by its parent patent, the '518 Patent. *See* Petition at 97-109. The Examiner was aware that the '578 Patent claimed priority to the '518 Patent but properly concluded that the '518 Patent is not prior art to the '578 Patent. *See* EX1002 ('578 Patent OA dated 4/26/2024) at 91 of 177, ('578 Patent Reply dated 7/26/2024) at 74 of 117, ('578 Patent Notice of Allowance) at 26 of 177.

The Petition claims that the '578 Patent is not entitled to its priority date of October 7, 2014 based on an alleged lack of written description in the originally filed application of the “adjustable pressure mandrels” claim element. *See* Petition at 97-109. The '518 Patent parent patent claims “at least three radially displaceable pressure mandrels” (EX1005 at 6:55-56 (claim 1), 7:20-21 (claim 2)), while the

'578 Patent independent claims include “adjustable pressure mandrels...” (*see* EX1001 at claims at 7:2-9:17) without the “at least three” language. The '578 Patent specification discloses “a main shaft fixture 10 of the given type that comprises adjustable pressure mandrels 18 with tap shoes 20....” EX1001 at 6:56-57. This same disclosure appears in the Abstract of the '578 Patent. EX1001 at Abstract. The '578 Patent further discloses that, in Figure 2, there are “in total four pressure mandrels 18 symmetrically placed around the main shaft 2, with tap shoes 20 that are engaged onto the main shaft 4 in order to fix it in place.” EX1001 at 5:27-30. This very same disclosure related to the pressure mandrels appears identically in all the applications to which the '578 Patent claims priority. *See* EX1005 at 5:9-12, 6:36-37, Abstract; EX1006 (DK PA 2014 00573) at 166 of 349; EX1006 (DK PA 2015 00527) at 313 of 349.

Both of the applications resulting in the '518 and '578 Patents were thoroughly examined. Notably, the Examiners in each respective prosecution did make certain rejections under 35 USC § 112, indicating that 112 requirements were carefully considered by the Examiner when evaluating patentability. Specifically, during prosecution of the parent '518 Patent, the Examiner rejected claim 9 for indefiniteness, and this rejection was overcome. *See* EX1006 (OA dated 6/29/2018) at 96-97 of 349. During prosecution of the '578 Patent, the Examiner rejected claims 1-14 under 35 USC § 112(b) as being indefinite. EX1002 (OA

dated 4/26/2024) at 85-87 of 177. These 112 rejections were also successfully overcome.

Petitioner's argument focuses on the removal of the language "at least three" from the claims of the '578 Patent. This changed language was apparent to the Examiner who found that "pressure mandrels" are fully enabled and described in the '578 Patent and its predecessors. It is well established Federal Circuit law that claim scope in continuation applications need not be commensurate with parent applications. "An applicant is free to seek an expanded scope of coverage beyond that originally sought by filing a continuation or divisional application during the pendency of a parent application and may therein include claims extending to the full scope of the subject matter described in the original specification under 35 U.S.C. § 112(a)." *In re Float'N'Grill LLC*, 72 F.4th 1347, 1350 (Fed. Cir. 2023) (citing *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1354, 1358 (Fed. Cir. 2014)). In the present case, Patent Owner was intentional in obtaining claims in the '578 Patent that addressed novel aspects of its invention. That these claims differ from the claims in the parent application was squarely before the Examiner. Thus, in Ground 4, Petitioner has not – and cannot – establish that the '518 Patent is prior art to the '578 Patent. No new questions of patentability are raised in Ground 4 of the Petition.

It is well established that the similarity – here the exact same reference combination – of the asserted art and the prior art involved during prosecution (*Juniper* Factor 1) counsels strongly in favor of denial of the Petition. *See Kayak Software Corp. v. Int'l Bus. Mach. Corp.*, CBM2016-00075, Paper 16 at 9 (Dec. 15, 2016) (designated informative Mar. 21, 2018) (declining institution where references were considered in substantive rejections during prosecution, and explaining “that instituting review solely because the exact combination of [references] advanced by Petitioner was not set forth in the prosecution history would exalt form over substance”); *Unified Patents*, IPR2016-01571, Paper 10 at 9-10, 12 (finding that a reference was substantially considered by the Examiner when reference was addressed for similar claimed subject matter).

Juniper Factor 2, the extent to which the asserted art was considered during examination, including whether the prior art was the basis for rejection, also weighs strongly in favor of denial of the Petition. Here, as detailed above, Signore and Weaver were the bases for all prior art rejections during prosecution. *See Becton, Dickinson & Co.*, IPR2017-01586, Paper 8 at 23 (declining institution on all but one ground despite slightly different structure of rejections, because “this is not a case where the prior art was simply listed in an IDS during prosecution” but rather the Petition “advanc[es] essentially the same positions raised by the Examiner during prosecution of the parent application”).

For *Juniper* Factor 3, the cumulative nature of the asserted art and the prior art considered during examination, the primary references are the same and the additional eight (8) references cited across Grounds 1-3 in the Petition are cumulative, presented for the same purpose, and applied in the same fashion as *Signore* and *Weaver* were applied by the Examiner during prosecution. Petitioner appears to add the “new” references only to address the “crane mounting facilities” limitations. See Petition at 56-63. But Petitioner themselves argue that *Signore* meets this claim limitation, that the Examiner also found that *Signore* discloses this element, and that “to the extent that *Signore* does not disclose this element, *Weaver* provides sufficient mounting facilities for a crane...” Petition at 56-57. Only then does Petitioner go on to add the admittedly cumulative additional art as allegedly disclosing this element in the same manner as *Signore* and *Weaver*. Petition at 57-63. In other words, the Petitioner admits that the “new” art is cumulative of the prior art considered during prosecution (*Juniper* Factor 3) and the Board should exercise its discretion to deny institution. See *Becton, Dickinson & Co.*, IPR2017-01586, Paper 8 at 22 (declining institution on a reference where “Petitioner’s rearrangement of previously considered prior art presents little, if any, persuasive new evidence of unpatentability.”).

For *Juniper* Factor 4, whether Petitioner has pointed out sufficiently how the Examiner erred in its consideration of the asserted prior art, there is no such

justification. Petitioner invents several Examiner errors: a purported too-narrow search for additional art; failure to reject certain claims over any prior art; and alleged lack of written description support in the parent priority applications (discussed *supra*). First, while Petitioner criticizes the Examiner's prior art search for additional art relevant to wind turbine cranes, Petitioner relies on the exact same primary art in the Petition. Petitioner then adds no fewer than eight (8) additional obviousness references (in addition to background art that is described but not relied upon in the Grounds) but does not explain how this art is not cumulative to the references considered by the Examiner. This supports that the Examiner conducted a thorough search, and that the art applied during prosecution was the best art available for consideration over all pending claims.

Juniper Factor 4 thus weighs strongly against institution. *See Becton, Dickinson & Co.*, IPR2017-01586, Paper 8 at 24 (declining institution on a reference where “we find little if any, different argument then [sic] that considered previously by the Office”).

For *Juniper* Factor 5, the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or the applicant's arguments during examination, as detailed above, Petitioner applies identical art in the same manner as during the original examination. This factor also strongly supports denial of the petition.

For *Juniper* Factor 6, the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art, as detailed above, Petitioner does not present any additional evidence or facts that would warrant reconsideration of the prior art already considered by the Examiner. Petitioner applies the same art in the same manner as it was applied by the Examiner. There is nothing to suggest that the Examiner erred in his consideration of the asserted prior art. The Petition should be discretionarily denied.

V. CONCLUSION

For the reasons set forth above, Patent Owner respectfully requests that the Director exercise discretion and deny institution of the Petition in its entirety.

Respectfully submitted,

Date: January 12, 2026

/Alison L. McCarthy/
Alison L. McCarthy (Lead Counsel)
Registration No. 51,998

Troutman Pepper Locke LLP
111 Huntington Avenue, 9th Floor
Boston, MA 02199
Tel: (617) 204-5109
Fax: (617) 204-5150
E-mail: Alison.McCarthy@Troutman.com

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), this is to certify that on this 12th day of January, 2026, I caused to be served a true and correct copy of the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL (with EX2001-2004)** by e-mail on the following counsel of record (as identified in the Petition and Updated Mandatory Notices):

Blaine M. Hackman (Reg. No.
67,479)
(Lead Counsel)
DECHERT LLP
Three Bryant Park
1095 Avenue of the Americas
New York, NY 10036
Tel.: (212) 698-3500
Fax: (212) 698-3599
blaine.hackman@dechert.com
LiftWerx-IPR@dechert.com

Lead Counsel for Petitioner

Noah M. Leibowitz (*pro hac vice*)
Gregory T. Chuebon (*pro hac vice*)
(Back-Up Counsel)
DECHERT LLP
Three Bryant Park
1095 Avenue of the Americas
New York, NY 10036
Tel.: (212) 698-3500
noah.leibowitz@dechert.com
greg.chuebon@dechert.com

Michael H. Joshi (*pro hac vice*)
DECHERT LLP
45 Fremont Street, 26th Floor
San Francisco, CA 94105
Tel.: (212) 698-3500
michael.joshi@dechert.com

Back-up Counsel for Petitioner

/Alison L. McCarthy/
Alison L. McCarthy (Lead Counsel)
Registration No. 51,998