

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 No. 12,104,578

**PETITIONER'S RESPONSE TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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1017	U.S. Patent No. 8,556,591 (“Koronkiewicz”)
1018	European Patent No. 1,101,934 (“Weitkamp”) and Certified Translation
1019	“US Value Proposition,” Cooper Roller Bearings Company Limited, <i>available at</i>

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	https://web.archive.org/web/20130531010830/http://www.cooperbearings.com/downloads/English/Value%20Proposition.pdf (WayBack Machine capture from May 31, 2013) (“Cooper”)
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1022	U.S. Patent Application Publication No. 2012/0099993 (“Guerenbourg”)
1023	January 22, 2014 Press Release by Power Climber Wind
1024	“Power Climber Wind supplies over 1,000 nacelle davits in North America,” WindTech International (Jan. 23, 2014) <i>available at</i> https://web.archive.org/web/20140130072352/http://www.windtech-international.com:80/products-news/power-climber-wind-supplies-over-1-000-nacelle-davits-in-north-america (WayBack Machine capture from January 30, 2014).
1025	An Overview of the History of Wind Turbine Development: Part II-The 1970s Onward, Gipe and Mollerstrom, Wind Engineering 1-29, 2022.
1026	“Advertising Information,” WindTech International (<i>available at</i> https://www.windtech-international.com/advertising/advertising-information)
1027	Nacelle Davit Brochure, Power Climber Wind (Aug. 8, 2012)
1028	Wind Power Today – 1998 Wind Energy Program Highlights, Page 6, US Department of Energy, DOE/GO-10099-820, June 1998.

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1029	Wind Turbines - Designing With Maintenance In Mind, Power Engineering, Volume III, Issue 5, May 1, 2007 (<i>available at</i> https://www.power-eng.com/renewables/wind-energy/wind-turbines-designing-with-maintenance-in-mind/)
1030	WindPACT Turbine Design Scaling Studies Technical Area 2: Turbine, Rotor, and Blade Logistics, Kevin Smith, NREL/SR-500-29439, June 2001
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1034	International Patent Application No. PCT/DK2015/000040 (International Publication No. WO/2016/055065 A1)
1035	“US Value Proposition” document from Cooper Roller Bearings Company Limited (with metadata appended)
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1039	Press Release, Timken Acquires Wazee Companies, LLC; Expands Industrial Service Offerings, January 2, 2013, available at https://news.timken.com/2013-01-02-Timken-Acquires-Wazee-Companies-LLC-Expands-Industrial-Service-Offerings

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1050	<i>Ningbo Wentai Sports Equipment Co. v. EASEGO</i> , No. 2:25-cv-00417, Dkt. 60 (E.D. Va. Nov. 29, 2025) (Scheduling and Pretrial Order)
1051	<i>HL Klemove Corp. v Foras Techs. Ltd.</i> , No. 2:23-cv-00647, Dkt. 25 (E.D. Va. Apr. 19 2024) (Scheduling and Pretrial Order)

I. INTRODUCTION

This proceeding presents an exceptionally weak case for discretionary denial. U.S. Patent No. 12,104,578 (the “’578 Patent”) issued in October 2024, slightly more than a year before the Petition was filed. Patent Owner’s discretionary denial request avers no settled expectations in the ’578 Patent and, given its recent issuance, none exist. Petitioner’s co-pending district court action seeking a declaratory judgment of non-infringement of the ’578 Patent was served only a few weeks ago and is in its infancy: the pleadings are not yet closed, there is no scheduling order, the parties have exchanged no discovery, and there is no date set for *Markman* or trial. Further, Petitioner has provided a *Sotera* stipulation to avoid overlap of invalidity arguments, and intends to seek a stay of the district court case pending IPR.

Finally, important considerations of Office integrity strongly support institution of this case. The Petition presents compelling evidence of unpatentability, including seven references across Grounds 1-3, which were not considered by the Examiner. This includes Power Climber (Ex. 1023), which unambiguously teaches the singular element that Patent Owner argued in prosecution was not present in the Examiner-raised art. As the Petition explains, the Examiner did not locate Power Climber or other art disclosing this element because of an inappropriately narrow search strategy that included eighteen terms all linked with “AND.” Assessing the Examiner’s mistake and reviewing the recently issued ’578 Patent in the context of art never

before considered is an efficient and appropriate use of Office resources and consistent with the Office’s responsibility to maintain patent quality.

II. PETITIONER’S EARLY CHALLENGE TO THE ’578 PATENT STRONGLY SUPPORTS INSTITUTION

Petitioner LiftWerx USA Inc. (“Petitioner”) filed its *inter partes* review (“IPR”) challenge of the ’578 Patent on November 4, 2025, just over one year after the ’578 Patent issued on October 1, 2024. In numerous decisions, the Director has declined to discretionarily deny IPR challenges of recently issued patents, explaining that “[e]arly challenges favor robust, predictable patent rights and weigh against discretionary denial.” *ResMed Corp. v. Cleveland Med. Devices, Inc.*, IPR2025-00246, IPR2025-00247, Paper 10 at 2 (PTAB June 12, 2025); *Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 9 at 2 (PTAB June 12, 2025); *Merck Sharp & Dohme LLC v. Halozyme, Inc.*, PGR2025-0006 Paper 29 (PTAB June 12, 2025); *Merck Sharp & Dohme LLC v. Halozyme, Inc.* PGR2025-0009, Paper 25 at 2 (PTAB June 12, 2025); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, IPR2025-00153, Paper 11 at 3 (PTAB June 11, 2025); *see also Embody, Inc. v. LifeNet Health*, IPR2025-00248, IPR2025-00249, Paper 13 at 2-3 (PTAB June 26, 2025); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, IPR2025-00436, Paper 11 at 2-3 (PTAB June 26, 2025); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00437, Paper 10 at 2-3 (PTAB June 26, 2025) (declining to deny institution based on “settled expectations” for patents issued

in 2019 and 2020); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 3-4 (PTAB July 16, 2025) (informative).

Patent Owner’s discretionary denial request rests heavily on the fact that LiftWerx recently filed a complaint seeking a declaratory judgement of non-infringement with respect to multiple Liftra patents, including the ’578 Patent. *See LiftWerx USA Inc. v. Liftra IP ApS*, Case No. 2:25-cv-00679, Dkt. 1 (E.D. Va. October 23, 2025) (the “EDVA Litigation”). But the EDVA Litigation is in its infancy. The case was not served until January 8, 2026; the pleadings are not yet closed; no scheduling order has been issued or even proposed; and neither party has served initial disclosures or discovery requests, produced even a single page of discovery, or scheduled any depositions. Since there is no scheduling order, the parties are months away from exchanging proposed terms for claim construction, briefing claim construction issues or serving expert disclosures. And there is no date set for *Markman*, much less trial, which, as discussed below in Section III.B, is unlikely to precede the Final Written Decision.

Patent Owner baldly represents that “Petitioner intentionally filed its declaratory judgment action in the Eastern District of Virginia to take full advantage of that jurisdiction’s ‘rocket docket.’” Paper 12, at 2. But Patent Owner’s assumption is incorrect. Patent Owner is a Danish company with its principal place of business in Denmark, and it failed to designate “a person residing in the United

States on whom may be served process or notice of proceedings affecting the patent or rights thereunder” with the PTO under 35 U.S.C. § 293. *See* Ex. 2004, at ¶ 6. Accordingly, venue for Petitioner’s declaratory judgment complaint was statutorily set in the EDVA. *See* 35 U.S.C. § 293. Moreover, as discussed below in Section III.A, Petitioner intends to move to stay the EDVA Litigation pre-institution and has asked Patent Owner to consent. Further, as discussed below in Section III.D, Petitioner has filed a *Sotera* stipulation. Regardless, the parties’ minimal investment in the EDVA Litigation to date is plainly “outweighed by the early challenge[]” to the ’578 Patent. *See, e.g., ResMed*, IPR2025-00246, IPR2025-00247, Paper 10 at 2 (PTAB June 12, 2025).

III. THE *FINTIV* FACTORS DO NOT SUPPORT DISCRETIONARY DENIAL

Here the *Fintiv* factors favor institution based on efficiency, fairness, and patent quality. *See Apple v. Fintiv*, IPR2020-00019, Paper 11 at 5 (PTAB Mar. 20, 2020) (“*Fintiv*”) (precedential).

A. Fintiv Factor 1: Petitioner Will Move to Stay the EDVA Litigation

Patent Owner’s argument regarding this factor is based on the erroneous assumption that it “does not seem likely that Petitioner will seek a stay of the EDVA Litigation.” Paper 12 at 6-7. Patent Owner is mistaken. As stated above, Petitioner *will* promptly move for a pre-institution stay of the EDVA litigation. Indeed,

Petitioner asked Patent Owner whether it would consent to such a stay and offered to meet and confer on this issue. Petitioner is awaiting Patent Owner's response.

Importantly, unlike other districts where stays are often granted only after institution, EDVA "does not disfavor stays before IPR is instituted, and ... has granted a stay in many such instances." *Sharpe Innovations, Inc. v. T-Mobile USA, Inc.*, No. 2:17-CV-351, 2018 WL 11198604, at *3 (E.D. Va. Jan. 10, 2018) (collecting cases).

In addition, a stay of the EDVA Litigation is warranted. In EDVA, "[w]hen resolving a motion to stay patent litigation pending administrative proceedings, district courts consider three factors: (i) the stage of the litigation, including whether discovery is complete and a trial date is scheduled, (ii) whether a stay would simplify the matters at issue, and (iii) whether a stay would unduly prejudice or clearly disadvantage the non-moving party." *Centripetal Networks, LLC v. Keysight Techs., Inc.*, No. 2:22-CV-00002, 2023 WL 5127163, at *3 (E.D. Va. Mar. 20, 2023) (Hanes, J.) (hereafter, *Keysight*).

First, and as discussed above and below with respect to *Fintiv* Factor 3, the EDVA Litigation is in its earliest stages. The EDVA complaint was served less than a month ago, and Petitioner has not yet answered Patent Owner's counterclaims (currently due February 13, 2026). There is no scheduling order, and neither party has served initial disclosures, discovery requests or infringement or invalidity

contentions, made productions, or scheduled depositions. The claim construction process has not begun, no expert disclosures have been made, and no dates have been set for *Markman* or trial. As the EDVA has recognized, “[t]he stage of litigation weighs in favor of a stay when the motion is filed early in the proceedings—before a trial date or *Markman* hearing is set—and discovery has not been substantially completed.” *Keysight*, 2023 WL 5127163, at *4 (collecting cases).

Second, a stay will significantly simplify the EDVA Litigation. Although there are three patents at issue in the EDVA Litigation and only the ’578 Patent is challenged in this Petition, the majority of claims in U.S. Patent No. 10,378,518 (the “’518 Patent”)—the parent of the ’578 Patent—contain numerous overlapping elements with the challenged claims. Further, although the ’578 Patent purports to claim priority to the ’518 Patent, Ground 4 of the IPR challenges whether there is sufficient support in the ’518 Patent disclosure for the claims of the ’578 Patent. Resolving the priority issue early will help crystallize issues in the EDVA Litigation.

The third asserted patent in the EDVA Litigation, U.S. Patent No. 12,473,179, is in the same technological field as the ’578 Patent (uptower repair and maintenance of wind turbines), shares the same, single inventor, and also has overlapping claim elements. Finally, EDVA courts have consistently issued stays when even a subset of asserted patents are subject to administrative proceedings, recognizing that there can still be significant simplification of issues. *See, e.g., Centripetal Networks, Inc. v.*

Palo Alto Networks, Inc., No. 2:21-CV-137 (RCY), 2022 WL 610176 (E.D. Va. Mar. 1, 2022) (hereafter *PANW*) (granting stay and noting that “[e]ven if the PTAB were to only review the five petitions currently instituted, it would still simplify the issues in this action.”); *PANW*, Dkt. 317 (Ex. 1048) at 3 (denying motion to lift stay because the “PTAB’s findings during IPR proceedings of the instituted patents may assist the Court when construing claims in a *Markman* hearing on related non-instituted patents.”).

Third, a stay would not unduly prejudice or clearly disadvantage Patent Owner. Notably, it was Petitioner that filed the EDVA Litigation. Indeed, as Patent Owner admits, although Patent Owner initiated a global dispute between the parties, it did not take any action in the U.S. Paper 12 at 1. If prompt resolution of its U.S. patent rights were important to Patent Owner, it could have done so. Patent Owner ***never*** initiated an infringement suit in the U.S. and so any assertion of prejudice due to the EDVA Litigation being stayed pending IPR is meritless.

B. *Fintiv* Factor 2: No Trial is Expected Prior to a Final Written Decision in IPR

No trial date has been set in the EDVA. Instead, Patent Owner engages in pure speculation regarding a trial date. See Paper 12 at 7-8. Because the district court has not set a trial date, Factor 2 weighs against discretionary denial. *NortonLifeLock v. Kajeet*, IPR2022-00001, Paper 20 at 9-10 (PTAB Apr. 21, 2022); accord *Illumina v.*

Ravgen, IPR2021-01271, Paper 12 at 33 (PTAB Jan. 26, 2022) (without a trial date any Factor 2 comparison is “speculative”).

Patent Owner provides general EDVA time to trial statistics in civil cases but omits data specific to patent cases or to the presiding judge, Judge Hanes. Petitioner has identified three scheduling orders that Judge Hanes has set in patent cases, only one of which reached trial. In Judge Hanes’ two most recent initial patent scheduling orders, each of which came approximately 4.5 months after the complaint was filed, Judge Hanes did not set a trial date. *See Ningbo Wentai Sports Equipment Co. v. EASEGO*, No. 2:25-cv-00417, Dkt. No. 60 (Ex. 1050), at 1 (E.D. Va. Nov. 29, 2025), *id.* at 2, 6 (no *Markman* date set), *id.* at 4 (close of discovery more than 10 months after complaint was filed); *HL Klemove Corp. v Foras Techs. Ltd.*, No. 2:23-cv-00647, Dkt. No. 25 (Ex. 1051), at 3 (E.D. Va. Apr. 19 2024) (no trial date; *Markman* and close of fact discovery set for 10 and 11.5 months, respectively, after complaint was filed).

Finally, in *PANW* Judge Hanes set a trial date only after the IPRs concluded and the stay pending IPR was lifted. *See PANW*, No. 2:21-cv-00137, Dkt. 353 (Ex. 1049) (E.D. Va. Jun. 28, 2023). In *PANW* the case had proceeded for about 11.5 months pre-stay. *See PANW* Dkt. 23 (complaint served March 19, 2021); *PANW*, 2022 WL 610176, at 11 (stay ordered Mar 1, 2022). And trial was set for 7 months after the stay was lifted, Ex. 1045 at 1-3 (stay lifted June 28, 2023, trial set for

January 22, 2024), for a total of 18.5 months of discovery and pre-trial proceedings between service of the complaint and trial. Here, the EDVA Litigation Complaint was served on January 8, 2026. If a similar schedule is entered by the EDVA, trial is not expected until late July 2027, two months *after* the projected statutory deadline for a Final Written Decision on the Petition.

Thus, even if a stay pending IPR is not granted in the EDVA Litigation, Judge Hanes' scheduling orders in patent cases reflect that the time to trial would not be nearly as fast as Petitioner suggests. A trial date may not even be set for months, and, if a trial date is even set, there is no reason to expect that it would be set for a date prior to the expected Final Written Decision in this IPR. In any event, because no trial is currently scheduled, Factor 2 weighs against discretionary denial. *Fintiv*, IPR2020-00019, Paper 11 at 9.

C. *Fintiv* Factor 3: The EDVA Litigation Is Still at an Early Stage and Petitioner Was Diligent in Filing this IPR

Petitioner's diligence also weighs against discretionary denial. The instant Petition was filed roughly 2.5 months ***before*** Petitioner served its initial complaint for a declaratory judgment of non-infringement and ***before*** Patent Owner ever alleged infringement of the '578 Patent. *See* EDVA Litigation, Dkt. 13. *See also Apple v. Seven Networks*, IPR2020-00156, Paper 10 (PTAB June 15, 2020) at 11-12 (quoting *Fintiv*, Paper 15 at 11); *Amperex Tech. v. Maxell*, IPR2021-01442, Paper 16 at 10-11 (PTAB Apr. 12, 2022). Moreover, as described *supra* in Section III.A, the EDVA

Litigation has barely begun: no substantive or scheduling orders have issued, the case has not progressed beyond the pleading stage, and the parties have made minimal investment in it.

The most resource intensive stages of the EDVA case still lie well in the future. *Fintiv*, IPR2020-00019, Paper 11 at 9-10. Thus, this factor weighs strongly against discretionary denial.

D. *Fintiv* Factor 4: There is No Likelihood of Issue Overlap

Petitioner filed a *Sotera* stipulation on January 8, 2026, Paper No. 11, pledging that if this Petition is instituted, it will *not* pursue challenges to the validity of the '578 Patent in the EDVA Litigation that were or reasonably could have been brought in this proceeding. Curiously, Patent Owner attempts to re-frame Petitioner's *Sotera* stipulation as favoring discretionary denial because it demonstrates an "inten[t] to pursuer validity challenges ... in the EDVA Litigation." Paper 12 at 2. Rather, the effect of a *Sotera* stipulation is exactly the opposite. Petitioner's *Sotera* stipulation is "highly relevant" and weighs ***against*** discretionary denial by minimizing potential overlap between the IPR and litigation. See March 24, 2025 Memorandum of Chief Administrative Patent Judge Scott Boalick.

Finally, Patent Owner's assertion that "the art asserted in this Petition has already been considered by the Patent Office," Paper 12 at 8, is demonstrably incorrect. Power Climber (Ex. 1023, Grounds 1-3), Holloway (Ex. 1010, Grounds 1-

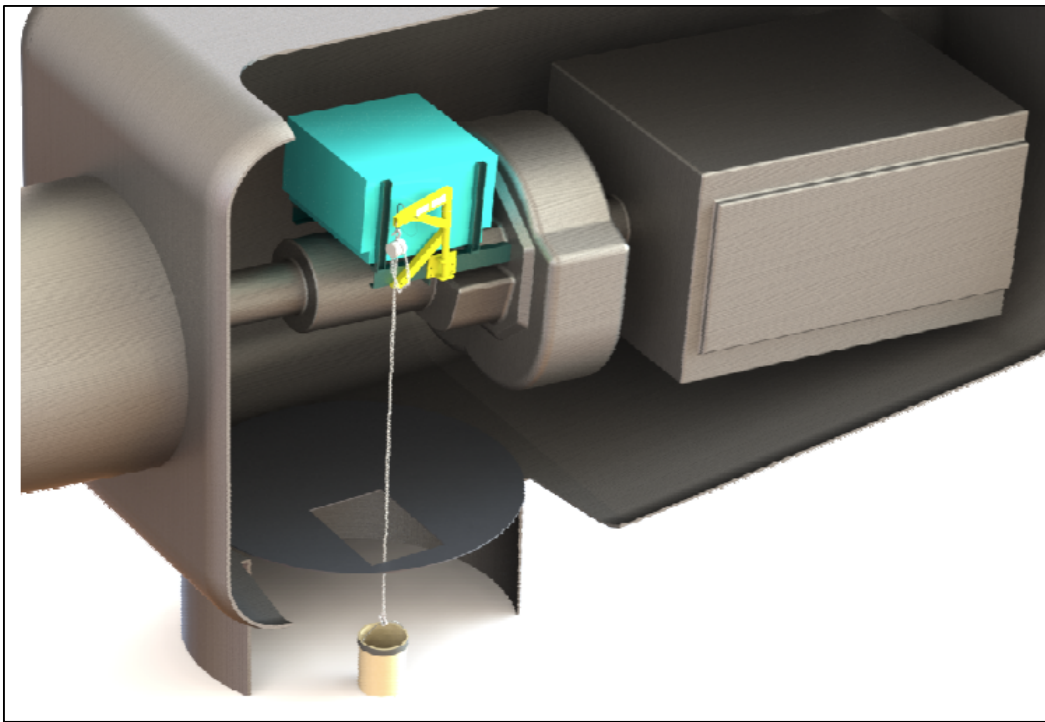
3), Hanxing (Ex. 1014, Ground 2), Schulz (Ex. 1013, Ground 2), Cooper (Ex. 1019, Ground 3), Shaeffler (Ex. 1020, Ground 3), and Guerenbourg (Ex. 1022, Ground 3) were **not** before the PTO during prosecution of the '578 Patent or its parent, the '518 Patent. As the Petition explains, Power Climber, which is relied on in each of Grounds 1-3, demonstrates that the singular element of '578 Patent claim 1 that the Patent Owner focused on in arguing for allowance of the claims—"mounting facilities adapted for anchoring a crane on/in a nacelle of a wind turbine"—was, in fact, well known in the art at the time. Ex. 1002 at 73-74. Patent Owner does not address the substance of Power Climber *at all* in its discretionary denial request. Finally, with regard to Ground 4, there is no indication that the Examiner gave the '518 Patent *any* consideration as anticipatory prior art in the prosecution of the '578 Patent.

E. *Fintiv* Factor 5: Litigation Parties

This Petition involves the same parties as the EDVA Litigation, so this factor "depend[s] on which tribunal [is] likely to address the challenged patent first." *Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, Paper 9 at 20-21 (PTAB Oct. 21, 2020). As discussed above with regard to *Fintiv* factor 2, the Board will likely address the '578 Patent before trial in the EDVA Litigation, regardless of whether the litigation is stayed. *Supra* § III.B. This factor therefore disfavors discretionary denial.

F. *Fintiv* Factor 6: Evidence of Strong Merits Support Institution

The Petition includes four grounds for invalidity of the Challenged Claims, as obvious or anticipated, including over the parent '518 Patent. As explained in the Petition, during prosecution Patent Owner disputed that only ***one*** element of independent claim 1 could be found in the Examiner-cited art—crane mounting facilities comprised in the main shaft fixture, Ex. 1002 at 73-74—precisely the element that Power Climber discloses. *See, e.g.*, Petition at 56-64. *See* Power Climber (disclosing a main shaft fixture-mountable crane, yellow).



Power Climber (***not*** before Examiner)

Further, ***each*** of the four grounds in the Petition relies on prior art ***not*** before the PTO during prosecution of the '578 Patent (Power Climber, Holloway, Hanxing,

Schulz, Cooper, Shaeffler, and Guerenbourg) or, in the case of the '518 Patent, art that was not considered by the Examiner as anticipatory art. Further, the Petition is supported by a detailed, 269-page Declaration of John Bosche, who analyzed the prior art and the claims of the '578 Patent and found them each anticipated or obvious. The “strong showing on the merits” presented here weighs against denial. *See Seven Networks*, Paper 10 at 20.

For the foregoing reasons, the *Fintiv* factors conclusively weigh against discretionary denial in this case.

IV. SECTION 325(D) - THE PETITION RAISES ART AND ARGUMENTS NOT CONSIDERED BY THE EXAMINER

As an initial matter, Patent Owner’s § 325(d) analysis improperly relies on *Juniper Networks, Inc. v. Mobile Telecomm’ns Techs., LLC*, IPR2017-00642, Paper 24, at 8-9 (PTAB July 27, 2017), *see* Paper 12 at 10-11, a non-precedential opinion describing a superseded standard. Discretionary denial under 35 U.S.C. § 325(d) is properly analyzed based on the two-part *Advanced Bionics* framework, which incorporates the factors set out in *Becton, Dickinson. Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at 8-11 (PTAB Feb. 13, 2020) (precedential) (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential as to §III.C.5, first paragraph)).

Advanced Bionics Part One analyzes whether the same or substantially the same art or arguments previously were presented to the PTO, based on *Becton, Dickinson* factors (a), (b), and (d): (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; and (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art. *Advanced Bionics*, IPR2019-01469, Paper 6 at 8, 10. Only if it is determined that the same or substantially the same art or arguments were previously were presented to the Office, does the analysis then move on to *Advanced Bionics* Part Two, which analyzes whether the Office materially erred, based on *Becton, Dickinson* factors (c), (e), and (f): (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments. *Id.* at 8-10.

Here, denial of institution under § 325(d) is unwarranted because (1) the same or substantially the same art or arguments were not previously presented to the PTO and/or properly considered—thus, the analysis should stop at *Advanced Bionics* Part

One; and (2) if the Board reaches *Advanced Bionics* Part Two, the Petition demonstrates that the Office materially erred during prosecution.

A. Advanced Bionics—Part One

1. Power Climber’s Absence from the Prosecution History Ends the § 325(d) Analysis

Patent Owner’s § 325(d) arguments hang precariously on the mistaken notion that the Petition relies solely on art previously presented to the Examiner, or that is merely cumulative. This is incorrect. **None** of Power Climber, Holloway, Hanxing, Schulz, Cooper, Shaeffler, and Guerenbourg were before the PTO at any time during prosecution of the ’578 Patent (or the parent ’518 Patent). Nor does Patent Owner demonstrate that they are “substantially the same” as the prior art considered by the Examiner. *Advanced Bionics*, Paper 6 at 13-19. In addition, with regard to Ground 4, there is **no** indication that the Examiner gave the ’518 Patent any consideration as anticipatory art in prosecution of the ’578 Patent.

Power Climber *alone* is reason enough to reject discretionary denial. Power Climber is relied upon in three of the four grounds raised in the Petition, and its absence from the prosecution history is dispositive and should end the § 325(d) analysis. *See Samsung Elecs. Co., Ltd. v. G+ Commc’ns, LLC*, IPR2023-00441, Paper 10, at 15-17 (PTAB Aug. 3, 2023). Patent Owner does not address the substance of Power Climber at all, and simply includes it in the table of references and then ignores it entirely. *See* Paper 12 at 11.

2. No Overlap Exists Between Petitioner’s New Art and the Arguments Made During Examination

Patent Owner cites no art or argument from prosecution of the '578 Patent that has any similarity to or overlap with Power Climber, Holloway, Hanxing, Schulz, Cooper, Shaeffler, or Guerenbourg, or the manner in which the Petition relies on those references. Patent Owner instead argues that it overcame *other* references in prosecution, Signore and Weaver, by “argu[ing] that [they] fail to disclose the claim 1 limitation” of “mounting facilities adapted for anchoring a crane,” and that after conducting an additional search, the Examiner found “no additional material art.” Paper 12 at 12. But that is precisely the problem. Patent Owner argued over Signore and Weaver on the basis that they “fail to disclose or suggest, *inter alia*, ‘that the main shaft fixture further comprises mounting facilities adapted for anchoring a crane on/in a nacelle of a wind turbine,’ as recited in independent claim 1.” Ex. 1002, at 73-74. The Examiner credited this argument by allowing the claims. *See id.* at 21-23. The Petition now relies on Power Climber and/or Holloway as teaching the element of “mounting facilities adapted for anchoring a crane” in the context of the main shaft fixture of claim 1—the very limitation Patent Owner *admits* the Examiner did not find in the art considered. There is no reason to move beyond *Advanced Bionics* Part One.

B. Advanced Bionics—Part Two: Material Errors in Overlooking the Petition’s Unpatentability Grounds

Even if the Board were to consider Part Two of *Advanced Bionics*—which it need not, for the reasons set forth above—*Becton, Dickinson* factors (c), (e), and (f) weigh strongly against discretionary denial.

1. The Record Provides No Indication that the New References Relied Upon Were Considered

With respect to *Becton, Dickinson* factor (c), focusing on Grounds 1-3, the Examiner never considered Power Climber, Holloway, Hanxing, Schulz, Cooper, Shaeffler, or Guerenbourg, let alone in the combinations asserted in the Petition. *Amazon.com, Inc. v. M2M Sols. LLC*, IPR2019-01205, Paper 14 at 16 (PTAB Jan. 27, 2020) (“a reference that ‘was neither applied against the claims nor discussed by the Examiner’ does not weigh in favor of exercising the Board’s discretion under § 325(d) to deny a petition”); *St. Jude Med., LLC v. Snyders Heart Valve LLC*, IPR2018-00105, Paper 15 at 12 (PTAB May 3, 2018) (instituting where “evidence of record does not demonstrate that the Examiner considered the references in the combinations relied upon by Petitioner or addressed arguments similar to those Petitioner now presents”).

Furthermore, as discussed *supra* regarding Part One of *Advanced Bionics*, Power Climber and Holloway in particular are significant because they teach the singular element the Examiner did not find in Signore and Weaver. See Grounds 1-3,

Elements 1[d]. Indeed, Patent Owner substantively ignores Power Climber in its discretionary denial brief, does not allege that Power Climber bears any similarity to the art before the Examiner, and presents no evidence of overlap between the arguments made during examination and the manner in which the Petition now relies on Power Climber. *See Becton, Dickinson*, at 17-18 (factors (a), (b), (d)).

Finally, with respect to Ground 4, although the '518 Patent was of record during prosecution of the '578 Patent, there is no indication that the Examiner gave the '518 Patent *any* consideration as anticipatory art. Patent Owner cites a double patenting rejection and Patent Owner response. *See* Paper 12 at 13 (citing Ex. 1002 at 91, 74, and 26). But neither citation demonstrates that the Examiner recognized or considered “the same or substantially the same...arguments” now presented in the Petition—that the '518 Patent lacks written description support for **two** adjustable pressure mandrels; that as a consequence of Patent Owner’s broadening amendment during prosecution of the '578 Patent, the '578 Patent claims are not entitled to the filing date of the '518 Patent; and therefore that the '578 Patent claims, which are broad enough to include fixtures having three or more pressure mandrels as well, are anticipated by the '518 Patent. 35 U.S.C. § 325(d); *see also, Microsoft Corp. v. SurfCast, Inc.*, IPR2022-00590, Paper 9 at 15 (PTAB Oct. 7, 2022) (instituting where cited art “was not extensively evaluated during examination and was not the basis for a rejection”).

2. The Petition Shows that the Examiner Materially Erred in Failing to Consider, or Properly Search for, the Asserted Art

The Petition demonstrates that the Examiner committed several material errors during prosecution. Where, as here, “[p]etitioner appears to show a material error by the Office, ... it is an appropriate use of Office resources to review the potential error.” *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 3 (July 16, 2025) (Informative).

First, as the Petition explains, the Examiner conducted just **one** overly narrow search for prior art mounting facilities adapted for anchoring a crane before allowance, constructing a search for the term “crane” among **eighteen** separate terms all connected by “AND.” Ex. 1002 at 48-49. As a consequence, the Examiner did not locate or consider Power Climber or similar art, which discloses at least element 1[d] of independent claim 1.

Second, the Examiner failed to consider that the challenged ’578 Patent is not entitled to its claimed October 7, 2014 priority date, and is instead entitled to a priority date no earlier than its January 24, 2024 filing date, and, in so doing, failed to consider the parent ’518 Patent as anticipatory art.

Patent Owner attempts to deflect this issue by re-framing it as a general “lack of written description in the originally filed application of the ‘adjustable pressure mandrels’ claim element,” without addressing the *number* of mandrels. Paper 12 at 13. But as the Petition explains in detail at 96-101, disclosure of **at least three**

adjustable pressure mandrels in the '518 Patent does not provide written description support for **only two** adjustable pressure mandrels. Petitioner agrees that the scope of a child patent may “include claims extending to the full scope of the subject matter described in the original specification [of the parent].” *Id.* at 15. But here, the '578 Patent claims include scope *beyond* what was described in the '518 specification, which Patent Owner tacitly admitted by taking the unusual step of deleting “**at least three**” from the common specification during prosecution.

Because numerous arguments in the Petition, including Power Climber, Holloway and the '518 Patent were not previously presented and/or properly considered during prosecution, denial of institution under § 325(d) is unwarranted.

C. Conclusion

Patent Owner has not identified any legitimate basis for the Board to deny institution based on discretionary factors. The early challenge of the '578 Patent and the appropriate use of Office resources to review material errors by the Examiner further support institution of this proceeding.

Respectfully submitted,

Dated: February 12, 2026

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CERTIFICATE OF SERVICE

I certify that today in:

LiftWerx USA Inc. v. Liftra IP ApS, IPR2026-00102 (U.S. Patent 12,104,578)

I caused to be served a copy of:

**PETITIONER’S RESPONSE TO PATENT OWNER’S REQUEST FOR
DISCRETIONARY DENIAL**

upon:

Alison L. McCarthy – Alison.McCarthy@Troutman.com

Joshua L. Jones - Joshua.L.Jones@Troutman.com

via:

E-Mail

Dated: February 12, 2026

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