

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DUKE MANUFACTURING CO.
Petitioner

v.

MARMON FOODSERVICE TECHNOLOGIES, INC.
Patent Owner

Case: IPR2026-00406
Patent No. 10,852,002

**PETITIONER'S OPPOSITION
TO MOTION FOR DISCRETIONARY DENIAL**

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1002	Prosecution History of the ’002 Patent
1003	Declaration of Glenn Vallee
1004	<i>Curriculum Vitae</i> of Glenn Vallee
1005	Infrared Heatsink Holding Unit Operators Manual (“IRHS Manual”)
1006	Infra Red Heat Sink Specifications (“IRHS Specifications”)
1007	bk.dukemfg.com (“Duke Website”)
1008	Infrared Heatsink Holding Unit Service Manual (“IRHS Service Manual”)
1009	Prince Castle Holding Bins (“Prince Castle”)
1010	U.S. Patent Publication No. 2010/0288748 (“Fortmann’748”)
1011	U.S. Patent Publication No. 2016/0073821 (“Shei’821”)
1012	U.S. Patent Publication No. 2007/0108178 (“Jones”)
1013	U.S. Patent Publication No. 2009/0126580 (“Hartfelder”)
1014	U.S. Patent No. 10,258,197 (“Fortmann’197”)
1015	U.S. Patent Publication No. 2008/0302778
1016	U.S. Patent Publication No. 2004/0069155 (“Shei’155”)
1017	U.S. Patent No. 6,175,099 (“Shei’099”)
1018	U.S. Patent No. 5,852,967 (“Fortmann’967”)

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1019	U.S. Patent No. 6,658,994 (“McMillan”)
1020	U.S. Patent Publication No. 2011/0114618
1021	U.S. Patent Publication No. 2011/0114624
1022	U.S. Patent Publication No. 2011/0252813 (“Veltrop”)
1023	U.S. Provisional Patent Application No. 62/193,992 (“the ’992 Provisional”)
1024	U.S. Patent No. 6,119,587
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1051	IRHS Sales History
1052	Flame Magazine
1053	E-mail (BK Vendor Training in Miami)
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1055	January 2016 BK Visit Presentation Materials
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I. INTRODUCTION

Marmon's Motion for Discretionary Denial rests on premises that are no longer true. Marmon argues that Duke abandoned its stated plan to seek IPR review of the asserted patents, that a single petition on one of nine asserted patents cannot simplify the parallel litigation, that the District Court will not stay the case, and that Duke has refused to limit its invalidity case through a *Sotera* stipulation.

Each of those premises has been overtaken by events. Duke has now filed petitions challenging every asserted utility patent, has moved the District Court for a stay, and has filed a *Sotera* stipulation.

Trial in the parallel litigation is set for April 24, 2028—after the projected Final Written Decision in this proceeding—and the litigation remains in its infancy. Every *Fintiv* factor therefore either favors institution or is neutral.

Marmon's remaining arguments fare no better. The breadth of the Petition is a direct consequence of Marmon's own lengthy, feature-laden claims. The Board's specialist judges are best suited to resolve the validity of a large, complex patent portfolio. And Marmon cannot claim settled expectations in a patent that issued less than six years ago, that was obtained without disclosure of Duke's IRHS product that Marmon and its named inventors knew well, and that is now asserted against products Duke has openly sold since 2016 and find roots in products Duke sold since 2013. The Director should decline to exercise discretion to deny

institution and refer the Petition to the merits panel.

II. INSTITUTING THE IPR WILL PROVIDE AN EFFICIENT ALTERNATIVE TO THE LITIGATION

Marmon premised much of its Motion for Discretionary Denial on arguments that Duke had abandoned its multi-IPR strategy and instead is proceeding with just the present IPR as an additional forum layered upon the District Court litigation. To the contrary, Duke has now filed petitions for IPR against each of the asserted utility patents. As such, this and the other proceedings before the Board provide an efficient alternative to costly and time-consuming district court litigation with respect to the utility patents.¹

Notably, Marmon is taking an inefficient brute-force litigation strategy in the District Court, asserting 198 claims across 7 utility patents and 2 patent families, while simultaneously resisting attempts to simplify the litigation through claim narrowing. EX1059; EX2002: 8. The asserted claims themselves reflect this same

¹ Marmon is also asserting two design patents in the parallel litigation, creating yet additional complexity as design patents and utility patents involve fundamentally different claim construction methodologies, infringement analysis, and validity frameworks. Resolution of the utility patent claims through IPR would allow the District Court to streamline the remaining case around the distinct legal standards governing design patent disputes.

approach, cobbling together a laundry list of disparate features—*e.g.*, configuration of food holding compartments, heater placement, independent heating zones, lid holding shelves, user interface positioning and functions, materials of construction—into extraordinarily lengthy claims with an excessive number of limitations. The '002 Patent alone has 29 claims, 3 independent claims, and independent claims having more than 16 claim limitations or sub-limitations.

Marmon's piling of claim-upon-claim and limitation-upon-limitation has manufactured complexity where the underlying technology does not warrant it. The Board—with its specialist judges—is better positioned than the District Court to adjudicate the validity of Mamron's sprawling patents. Indeed, "[t]he large number and vast scope of the patents asserted in the district court litigation" has created precisely the circumstance in which the Board should decline to exercise its discretion to deny institution. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2–3 (June 13, 2025) (informative); *Shenzhen Tuozhu Technology Co., Ltd. v. Stratasy, Inc.*, IPR2025-00438, Paper 10 (July 17, 2025) ("the large number and vast scope of the patents . . . weighs against discretionary denial" where the parallel litigation involved 9 patents); *Harbor Freight Tools USA Inc. et al. v. Champion Power Equipment, Inc.*, IPR2025-00805, Paper 20 (Sept. 19, 2025) (finding that resolving the dispute at the Office "would be more efficient" where the parallel litigation involved 13 patents); *Apple Inc. v. Apex*

Beam Technologies LLC, IPR2025-00896, Paper 10 (Sept. 3, 2025) (confirming the Board’s role in managing high-volume patent validity challenges where the parallel litigation involved 17 patents).

III. THE *FINTIV* FACTORS FAVOR INSTITUTION

Marmon’s *Fintiv* analysis was built on a record that has since changed.

Each factor is addressed in turn below.

Factor 1: The Likelihood of a Stay Is Weighs Against Discretionary Denial as Each of the Utility Patents is Subject to a Pending IPR Petition and a Motion to Stay Is Pending.

Much of Marmon’s assertions regarding the application of the *Fintiv* factors was predicated on the premature assertions that Duke would not file IPRs on the remaining utility patents or a motion for stay in the corresponding litigation.

On September 30—less than a week after Marmon served its identification of asserted claims and preliminary infringement contentions—Duke filed PR2026-00479, IPR2026-00480, and IPR2026-00481. *See Quest Diagnostics Incorporated v. Ravgen, Inc.*, IPR2021-00791 Paper 20 (Oct. 19, 2021) (“To be clear, we are not suggesting that petitioners must or should file IPRs before even knowing what claims are asserted against them in order to show diligence. There may be good reasons to wait (e.g., on preliminary infringement contentions) before filing to increase efficiencies and avoid challenges to claims that are never truly in dispute between the parties.”). And on October 2, Duke filed IPR2026-00482, IPR2026-

00483, and IPR2026-00484. As such, each of the utility patents asserted in the parallel litigation is now subject to a pending petition for IPR.

Likewise—having filed the remaining petitions for IPR—Duke has also moved the District Court for a stay of the litigation. EX1060. Although Judge Bluestone (the presiding judge in the parallel litigation) has not previously ruled on a motion to stay pending IPR, the Eastern District of Missouri has routinely granted stays even prior to institution. *Amsted Rail Co., Inc. v. Hum Indus. Tech., Inc. et al.*, 4-22-cv-00445, 2023 WL 2864553 (E.D. Mo Apr. 10, 2023) (granting a motion to stay pending institution of IPR); *Ollnova Technologies Limited v. Copeland Comfort Control LP, et al.*, 4-22-cv-01387, 2023 WL 2784777 (E.D. Mo. Apr. 05, 2023) (same); *Zeavision, LLC v. Bausch & Lomb Inc.*, 4-21-cv-00739, 2022 WL 715013 (E.D. Mo. Mar. 10, 2022) (same); *Lineweight LLC et al v. FirstSpear, LLC*, 4-18-cv-00387, 2019 WL 4015824 (E.D. Mo. Aug. 26, 2019) (same); *Masa LLC v. Apple Inc.*, 4-15-cv-00889, 2016 WL 2622395 (E.D. Mo. May. 09, 2016) (same). Considering that Marmon is asserting 7 utility patents—each of which are subject to a pending petition for IPR—and 198 patent claims, the District Court will likely find the potential simplification of the issues warrants entering the requested stay.

Marmon’s contrary contention relies on the district court’s Docket 38 order, but that order did not address a motion to stay pending IPR. It addressed only

whether Duke’s then-pending partial motion to dismiss and its stated intent to file IPR petitions warranted an “effective stay of the case” before any petition had been filed. EX2003. Nor does the court’s ruling on the partial motion to dismiss say anything about whether the court would stay the case once every asserted utility patent is pending PTAB review.

Factor 2: The Scheduled Trial Date Is Months After the FWD and Thus Strongly Weighs Against Discretionary Denial.

Trial in the parallel litigation is scheduled for April 24, 2028.² EX1061: 4. If instituted, the Final Written Decision in this proceeding will be issued on January 8, 2028—over three months before the scheduled start of trial. Because this proceeding will outpace the parallel litigation, there is a clear and present opportunity for the Board to be the true alternative validity forum that Congress intended. *See Google LLC v. Withrow Networks Inc.*, IPR2025-00775, Paper 10 at 2 (Aug. 14, 2025) (“likely that a final written decision in this proceeding will issue before the district court trial occurs, reducing the concern of inconsistent outcomes or significant duplication of efforts”).

² The District Court had already expressed that it would intentionally set the trial for *after* the prospective Final Written Decisions and asked the parties for their availability for commencing trial on April 24, 2028, in advance of Marmon’s motion for discretionary denial. EX1062.

Marmon's reliance on *Elong International USA Inc. v. Feit Electric Co.*, IPR2025-00258, Paper 16 (June 25, 2025), is therefore misplaced. There, denial rested on a trial expected to occur *before* the Final Written Decision, meaningful investment in the parallel case, and an insufficient showing that a stay would be granted. Here, each of those circumstances is reversed.

Factor 3: The Investment in Parallel Proceeding Weighs Against Discretionary Denial as Marmon Only Propounded Its First Amended Complaint on September 18 and Its Infringement Contentions on September 23.

Marmon's list of activity in the litigation—a partial motion to dismiss, a dispute over the initial pretrial conference, Rule 26 disclosures, and a joint scheduling plan—reflects ordinary pleading-stage case management, not investment in the merits of validity. None of that work concerns the invalidity issues presented in the petition, and none of it would be duplicated by institution.

In reality, there has been minimal investment in the parallel litigation and the case is still in its infancy. By virtue of Marmon having filed its First Amended Complaint on September 18, 2026, Duke will not be required to file an Answer or Counterclaims in the litigation until October 9. Marmon's disclosure of Asserted Claims and Preliminary Infringement Contentions were likewise only made on September 24, 2026. EX1061. Invalidity Contentions are not even due until December 21. *Id.* Moreover, the preliminary exchange of claim constructions is not due until January 28, 2027—after the institution decisions in this proceeding is

due. *Id.* Motions for claim construction are not due until April 15, 2027, and the Claim Construction Hearing is currently set for June 7, 2027—both dates falling after the anticipated institution decisions on the remainder of Duke’s IPRs. *Id.*

Factor 4: The Overlap Between the Petition and Parallel Proceeding Weighs Against Discretionary Denial Because Duke Has Submitted a *Sotera* Stipulation.

This factor weighs strongly against discretionary denial. Marmon’s principal factor 4 argument is that Duke had “failed to file a *Sotera* stipulation.” That argument is now moot. EX1063. Duke’s *Sotera* stipulation limits the potential overlap between this proceeding and the parallel litigation. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020 01019, Paper 12, 19 (Dec. 1, 2020); *see also BMW of North America, LLC v. NorthStar Systems LLC*, IPR2023-01017, Paper 12 (Dec. 8, 2023) (declining to disregard *Sotera* stipulations entered after the patent owner moves for discretionary denial).

Factor 5: Whether the Parties Are the Same Is Neutral.

The parties to this proceeding and in the parallel District Court litigation are the same. This factor is neutral. *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 at 16 (Oct. 21, 2020).

Factor 6: The IPRs Advance the AIA’s Core Efficiency Objectives.

As addressed above, Duke has filed IPRs on the remaining utility patents asserted in the parallel litigation, moved for a stay of the parallel litigation, and filed a *Sotera* stipulation. Accordingly, institution of the IPRs would serve the

AIA’s intended role as an efficient alternative to litigation.

Marmon’s reliance on *Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 6, 8 (May 14, 2026) (precedential), is likewise misplaced.

Magnolia warned against petitioners who use AIA review as a litigation supplement to “gain litigation leverage” and expand validity disputes across multiple forums. Here, Duke has done the opposite. It has put the validity of every asserted utility patent before the Board, sought a stay so that validity is resolved in a single forum, and filed a *Sotera* stipulation.

IV. MARMON’S SPRAWLING CLAIMS ARE BETTER SUITED FOR REVIEW BY THE SPECIALIST JUDGES OF THE PTAB

Marmon argues that the Petition’s “voluminous twelve-ground matrix and sprawling prior art mosaic impose an impermissible administrative burden on the Board.” Of course, the volume of the Petition is a function of the “kitchen sink” approach that Marmon took by claiming scores of disparate features that were each well known in the prior art. Some of these features and the prior art that disclose them are charted below.

Claimed Feature	Prior Art Teaching Claimed Feature
At Least Two Food Holding Compartments	IRHS Documents, Fortmann’748
Multiple Temperature Zones per Compartment	IRHS Documents, Jones, Fortmann’197
Independently Controllable Top and Bottom Heaters per Zone	IRHS Documents, Fortmann’748, Jones, Fortmann’197, and McMillan
Heating Elements Comprising Resistive Wiring	IRHS, Veltrop, Poole

Comparative Energy Outputs of the Heating Elements	IRHS Documents, Prince Castle, Reese
Substantially Planar Surface Comprises Thermally Conductive Material/Aluminum	IRHS Documents, Veltrop, Shei'155
Dedicated Controls	IRHS Documents, Vaseloff, and McMillan
Timer Bar/Bezel	IRHS Documents, Fortmann'197, Hartfelder
Discrete Lids for Each Pan Holding Location	IRHS Documents, Jones, and Fortmann'197
Latches for Lids	Hartfelder, Shei'099
Insulation	IRHS Documents, Fortmann'967, Fortmann'197

Rather than hindsight reconstructions, the combinations and modifications of the prior art meet the higher teaching-suggestion-motivation standard from prior to *KSR*. The Petition includes thorough citations to prior art to address the wide-ranging features claimed, multiple reasons for combinations/modifications, and evidence supporting motivations to combine/modify. Ground 1 of the Petition is practically an anticipation ground relying on combining product literature for the same commercial product.

The length of the expert declaration is likewise a function of including the full text of the claim limitations—as compared to relegating the language to a claim listing—inclusion of block quotes for the prior art and source materials, and being structured to address each claim limitation separately.

Marmon’s authorities do not hold otherwise. In *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 (Mar. 6, 2019), the petition left the Board to decode which references were offered for which limitations. Here, by contrast, each ground identifies a primary reference and specific secondary references keyed to particular claim limitations, as the chart above illustrates, with explanations of how the combinations/modifications would be implemented. And *Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10-11 (Nov. 7, 2018), appears to be completely off point and instead pertains to whether to institute review where only the reasonable likelihood of prevailing was limited to a small subset of all of the claims challenged. Marmon also invokes 35 U.S.C. § 312(a)(3) but identifies no ground, limitation, or combination that lacks particularity.

Marmon’s hindsight and “conclusory expert testimony” arguments go to the merits, not to discretion. *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352 (Fed. Cir. 2019) , *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355 (Fed. Cir. 2016); and *In re Van Os*, 844 F.3d 1359 (Fed. Cir. 2017) concern whether evidence sufficed to support a final obviousness determination. None of them supports discretionary denial at the institution stage. Indeed, Marmon’s complaint that Dr. Vallee’s declaration is too detailed cannot be reconciled with its complaint that the Petition is conclusory. The merits panel is fully equipped to weigh that testimony.

V. MARMON IS NOT ENTITLED TO SETTLED EXPECTATIONS IN THE '002 PATENT

As an initial matter, the '002 Patent issued December 1, 2020—less than six years ago. While Duke believes Marmon is not entitled to settled expectations as to any of the challenged patents, if the Director were inclined to find that Marmon is entitled to settled expectations in its older patents, the more recently issued patents should still be eligible for referral to the merits panel. *See TankLogix, LLC v. SitePro, Inc.*, IPR2025-00647, Paper 10 (July 31, 2025) (denying institution as to patents issued in 2014, 2016, 2018; referring to the merits panel for patents issued in 2019, 2021, 2022, 2023); *compare Cambridge, Indus. USA, Inc. v. Applied Optoelects., Inc.*, IPR2025-00433, Paper 12 (June 27, 2025) (denying institution as to patents issued in 2016, 2018), *with Cambridge Indus. USA, Inc. v. Applied Optoelects., Inc.*, IPR2025-00434, Paper 11 (June 26, 2025) (referring to the merits panel for patents issued in 2019, 2020).

A. Marmon Failed to Disclose the IRHS During Prosecution

Not only are Duke's IRHS products the subject of the non-patent literature (Exhibits 1005-1008) forming the basis of invalidity grounds 1-8, but Marmon and its inventors almost certainly were aware of the IRHS and failed to disclose it while prosecuting the '002 Patent.

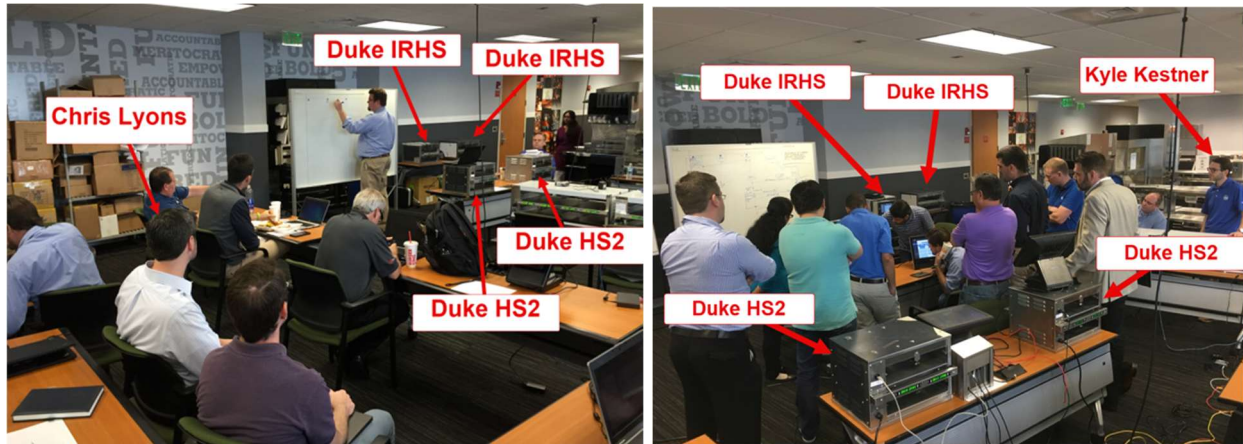
Duke and Marmon (and its predecessor—Prince Castle) are long-standing competitors with a common customer—Burger King—for their food holding

products. EX2001: ¶¶37-41. In April 2013, Burger King issued a requirement for new food holding units to have at least 2x4 and 3x4 configuration options, with each food holding compartment including two temperature zones each sized for two pans. EX1049. The IRHS was designed and introduced to meet this requirement later that year. EX1058: ¶¶8-11.

The IRHS was heavily marketed and commercially successful, such that Marmon/Prince Castle surely was aware of the product and its features. EX1058: ¶¶14-26. The IRHS was advertised in Flame magazine (a publication in which Marmon/Prince Castle has also advertised its EHB), prominently featured on the Duke-BK website (which was publicly available), and vigorously featured in several trade shows that Marmon/Prince Castle would have attended starting in the Fall of 2013. EX1058: ¶¶17-24; EX1035: 5; 1052: 75; EX1007. For example, Duke presented its Product Holding Unit (*i.e.*, the IRHS) at the same March 2025 Burger King training session where Kyle Kestner—one of Marmon’s named inventors—also presented. EX1058: ¶¶21-24; EX1053; EX1054.

Underscoring its knowledge of the IRHS, Marmon’s named inventors—Chris Lyons and Kyle Kestner—participated in a series of intimate in-person meetings at Burger King with Duke regarding interoperability of Duke’s holding units—including the IRHS—and Marmon/Prince Castle’s holding units. EX1058: ¶25. In fact, Chris Lyons and Kyle Kestner are in photographs showing the IRHS

was present in the room. EX1058: ¶25. This series of meetings spanned from December 2015 to May 2016, and, notably, the photographs were taken in May 2016—only a couple of weeks after Chris Lyons and Kyle Kestner signed their 37 C.F.R. § 1.63 declarations. EX1058: ¶25; EX1002: 168, 169.



Marmon/Prince Castle introduced its Extended Holding Bin (EHB) product—the commercial embodiment of the '002 Patent—in 2015 and did so specifically for Burger King. EX2001: ¶¶40-41. In other words, the IRHS—which had already sold thousands of units—was “the” established product which Marmon/Prince Castle was attempting to displace/compete head-to-head with. It strains credulity that Marmon/Prince Castle and its inventors were not aware of the IRHS, its status as prior art, or its materiality (demonstrated by the Petition). Yet Marmon never disclosed the IRHS while prosecuting the '002 Patent.

The Director has recognized that a Patent Owner’s failure to disclose material prior art to the Patent Office cuts against its settled expectations:

The Office has a commitment to issuing reliable and durable patent rights resulting from high-quality examination. A patent applicant's failure to provide prior art that it owns cuts against its settled expectations and weighs against discretionary denial.

Microsoft Corp. v. Sandpiper CDN, LLC, IPR2026-00180, Paper 15 at 3 (May 6, 2026).

B. The Examiner's Allowance of the '002 Patent Hinged on Erroneous Examination of Added Dependent-Claim Limitations

The examiner of the '002 patent—Examiner Pelham (the “Examiner”)—never found its core concept patentable. Every independent claim recites food holding zones, each with “independently controllable” top and bottom heating elements. The Examiner rejected that subject matter over U.S. Pub. No. 2011/0114618 (“Chung”). EX1002: 111-113.

1. The Examiner rejected the shared subject matter of Chung and allowance was based on dependent claims.

The Examiner rejected original claim 1 as anticipated by Chung, finding that Chung discloses “a first food holding zone” in “a first food holding compartment” with “independently controllable first ... and second heating element[s] disposed [respectively at] top ... and ... bottom portion[s] of the first food holding compartment.” EX1002: 111–112. He did not reject application claims 4 or 21 over any art. EX1002: 108–113. Marmon's/Prince Castle's only response was that “[t]here is no teaching, express or implied, that upper and lower heating elements within a single zone are independently controllable.” EX1002: 104. The

Examiner found that argument “not persuasive,” maintained the rejection, and stated, without explanation, that “[c]laims 4, 5 and 21-27 are allowed.” EX1002: 43–47. Marmon/Prince Castle then cancelled the rejected claims “[w]ithout acquiescing” and rebuilt on the allowed claims. EX1002: 29–40. Application claims 4 and 21 became issued claims 1 and 14. EX1002: 19.

- **Application claim 4/issued claim 1 added:** “a first bezel is set forward from the shelf by a space.” EX1002: 89-90.
- **Application claim 21/issued claim 14 added:** “the first independently controllable heating element is adapted to output more heat energy than the second heating element.” EX1002: 94-95.

2. The added limitations are the only possible basis for allowance.

The Examiner did not state reasons for allowance. EX1002: 13, 46, 108-113. Because the Examiner found the heater limitations in Chung, they cannot have supplied the reason for allowance. EX1002: 43-47. Allowance must have rested on the added limitations: the spaced bezel (issued claim 1) and the higher-output upper heater (issued claim 14). EX1002: 46. The Examiner’s (unexplained) conclusion that they were patentable was material error. *See Taiwan Semiconductor Mfg. Co. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3–4 (Sept. 3, 2025) (material error where the elements on which allowance rested were in the art).

3. The Examiner failed to carry forward his own prior findings.

Issued Claim 14: In the application that issued as parent U.S. Patent No. 9,976,750 (“the ’750 Patent”), the same Examiner twice rejected this limitation (original claim 6 in the ’750 Patent). He found that U.S. Patent No. 7,905,173 (“Sus”) “discloses the first heating element to generate more power than the second.” EX1064: 359. He then found, over U.S. Patent No. 8,522,675 (“Veltrop”) and U.S. Patent No. 7,385,160 (“Jones”), that “[i]t would have been obvious to use a higher power rating, or setting, for the upper heater depending strictly and routinely on the type of food in the tray.” EX1064: 72-73. Prince Castle never contested that finding.

Yet in the ’002 Patent, the Examiner allowed application claim 21/issued claim 14, which differed from rejected application claim 1 only by that limitation. EX1002: 32-33, 46, 94-95, 185. The Examiner’s eve-of-allowance searches targeted this very feature. EX1002: 20-21. Nothing explains why a limitation obvious in the ’750 Patent became patentable here. EX1002: 46. *See Harbor Freight Tools*, IPR2025-00805, Paper 20 at 2–3 (material error where art applied to similar limitations in a parent was not applied to the challenged patent).

4. The Examiner failed to appreciate the significance of prior art already of record.

Issued Claim 14: The Examiner initialed Prince Castle’s IDS listing the operation manual for its own DHB3PT-33DD holding bin on April 8, 2020.

EX1002: 52. Five days later, the Examiner allowed issued claim 14 (application claim 21) without comment. EX1002: 46. That manual discloses factory presets, for breaded chicken and other products, of 250°F for upper heaters and 200°F for lower heaters. EX1065: 14. That is the claimed higher-output upper heater. *See Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2–3 (July 17, 2025) (material error where an IDS reference taught the allowable limitation). The Petition applies Prince Castle manuals disclosing factory-default higher top heat than bottom heat. Petition: 129-130, 299-300; EX1009: 22, 40 (factory presets 225°F/195°F for upper/lower heaters).

Issued Claim 1: U.S. Pub. No. 2009/0126580 (“Hartfelder”) (EX1013), a Prince Castle publication naming ’002 Patent co-inventor Charles Hartfelder, is cited on the face of the ’002 Patent. It teaches a control “interface bar 76” spaced in front of the shelf. EX1013: ¶[0039], Figs. 3, 4, 9; EX1003, ¶¶667–668. The Petition relies on it for this limitation. Petition: 193–94, 239-40. The Examiner erroneously never applied any reference to the bezel limitation. *See Eunsung Global Corp. v. Hydrafacial LLC*, IPR2025-00445, Paper 14 at 3 (July 10, 2015) (allowable features found in references cited on the patent’s face).

The Office’s own examination confirms the error. Months earlier in the same art unit, Examiner Fuqua examined the Carter-Hoffmann application that issued as U.S. Patent No. 10,258,197 (“Fortmann’197”) (EX1014). She rejected

claims reciting control-bearing end walls (bezels) “spaced outboard” with “an air gap” as anticipated by another Prince Castle publication, U.S. Pub. No. 2009/0199725 (“Veltrop’725”). EX1066: 44-45. She allowed them only after unrelated amendments, treating the spaced bezel as old. *Cf. Harbor Freight*, IPR2025-00805, Paper 20 at 2–3 (examination of similar claims resulted in rejection over art not applied to the challenged claims).

5. The Examiner failed to locate highly material prior art that a reasonable search would have found.

Issued Claim 1: Fortmann’197 teaches control-bearing bezels spaced from the plates by “an air gap.” It issued before the ’002 Patent’s examination and shares its A47J 39/006 classification. Yet the Examiner’s “bezel” searches were confined to a narrow set of prior hits. EX1002: 20-21. A reasonable class search would have found it. *See Taiwan Semiconductor Mfg. Co. v. Marlin Semiconductor Ltd.*, IPR2025-01082, Paper 10 (Dec. 18, 2025) (referring petition that showed the examiner’s text and classification searches were too narrow to capture relevant art), *referring* Paper 7 at 2–11 The Petition applies Fortmann’197 for this limitation. Petition, 183–96, 239–40.

6. Each error was material to patentability.

Each error goes to a limitation on which allowance necessarily rested. Carrying forward the Examiner’s own ’750 Patent finding, or applying Prince Castle’s own manual, would have led to rejection of issued claim 14/application

claim 21 (heater output limitation). Applying Hartfelder—as Examiner Fuqua applied Veltrop ’725—or finding Fortmann’197 would have led to rejection of issued claim 1/application claim 4 (set forward bezel limitation). The Petition relies on this same art. Accordingly, review would correct material error, serve the integrity of the patent system, and make good use of Office resources. *See Magnolia Med. Techs.*, IPR2026-00097, Paper 17 at 6, 8.

C. Duke Is Entitled to Its Own Settled Expectations

While settled expectations is typically invoked in the context of patent owners’ settled expectations, petitioners may also be entitled to settled expectations. *Apple Inc. v. Ferid Allani*, IPR2025-00856, -00857, Paper 10 at 3 (Sept. 4, 2025) (informative) (crediting petitioner’s belief it would not be sued where it used the technology for over eleven years without being sued); *Home Depot USA Inc. v. H2 Intellect LLC*, IPR2025-00480 Paper 11 at 2-3 (Sept. 4, 2025) (informative) (crediting petitioner’s settled expectations where the challenged patent had not previously been applied in the industry).

Here, Duke has its own long-established domestic investment in the accused products and predecessor IRHS that is being threatened by Marmon’s enforcement of a potentially invalid patent. Duke is a privately held company based in St. Louis, Missouri. Although it distributes and sells its food service equipment around the world, Duke primarily manufactures its products in the United States

with manufacturing facilities in Sedalia, Missouri and Houston, Texas.

Marmon is asserting that Duke's HS2 and ReadyFlex food holding units infringe the '002 Patent and other asserted patents in the related litigation. Duke's HS2 and ReadyFlex food holding products were both designed and developed by Duke employees in the United States and manufactured exclusively in Sedalia, Missouri.

Notably, functionality of the HS2 and ReadyFlex food holding products traces back to their predecessor product—the IRHS—which debuted years before Marmon's earliest April 20, 2016 priority date. EX1058: ¶¶11, 27. In fact, the HS2 itself predated Marmon's April 20, 2016 priority date—having been disclosed to Burger King in January 2016 and already in field testing prior to the priority date. EX1058: ¶¶27-30; EX1055; EX1056. Notably, the HS2 was even present in the May 2016 photographs with Chris Lyons and Kyle Kestner above. EX1058: ¶25.

Duke's settled expectations predate the '002 Patent's priority to the IRHS—with revenues exceeding [REDACTED]—from 2013 to present. EX1058: ¶14; EX1051. Duke has sold in excess of [REDACTED] units of the HS2—with revenues exceeding [REDACTED]—from 2016 to present, and in excess of [REDACTED] units of the ReadyFlex—with revenues exceeding [REDACTED]—from 2021 to present. EX1058: ¶¶ 31, 33; EX1057.

Despite the accused HS2 and ReadyFlex products having been on the market since 2016 and 2021 respectively, Marmon never notified Duke that these products were allegedly infringing any Marmon patent prior to Marmon filing suit against Duke in October 2025. EX1058: ¶¶ 12, 31, 33. Nor did Duke suspect that features it had been practicing since 2013 would be accused of infringing patents that did not issue until nearly half a decade later.

Marmon's own evidence underscores the point. Marmon admits that Duke launched the HS2 in 2016, yet it waited roughly nine years to sue. Marmon acted only after it lost additional market share following the ReadyFlex launch.

EX2005: ¶¶ 15, 17. A patent owner that tolerates a competitor's open sales for nearly a decade should not be permitted to invoke its own delay as a basis for shielding the patent from review.

VI. CONCLUSION

For the reasons above, Duke respectfully requests that the Director deny Marmon's Motion for Discretionary Denial and refer the Petition to the merits panel for an institution decision.

Dated: October 6, 2026

Respectfully submitted,
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CERTIFICATE OF SERVICE

Under 37 C.F.R. § 42.6(e), the undersigned certifies that on October 6, 2026,
a copy of the PETITIONER'S OPPOSITION TO MOTION FOR
DISCRETIONARY DENIAL and EXHIBITS 1049 and 1051-1066 were served
via email on the following:

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CERTIFICATE OF COMPLIANCE

By permission granted in Exhibit 3001, this Opposition is extended page limit at 22 pages.

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