

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 10,852,002

**PATENT OWNER'S REPLY IN SUPPORT OF
DISCRETIONARY DENIAL**

I. Introduction

Petitioner Duke Manufacturing Co.’s (“Duke”) Opposition (Paper 12) confirms that institution should be denied under 35 U.S.C. §§ 314(a) and 325(d). Rather than streamlining this dispute, the intervening procedural events demonstrate that institution would multiply proceedings, duplicate efforts across multiple forums, and burden limited Office resources. Indeed, Duke waited until the eve of the statutory bar to flood the Board with six additional petitions, now challenging seven patents with sprawling, redundant grounds containing up to seventeen references each. Because Duke’s petitions cannot resolve the parallel litigation, duplicate identical invalidity theories across forums, and merely rehash art considered during prosecution, discretionary denial is warranted under 35 U.S.C. §§ 314(a) and 325(d).

II. Intervening Events Confirm Institution Would Undermine Efficiency and Burden Office Resources

A. Duke’s Seven-Petition Flood Multiplies Proceedings While Leaving the District Court Action Active

First, Duke’s petitions cannot resolve or dispose of the district court action. Marmon asserts two design patents (U.S. Design Patent Nos. D1,020,455 and D1,064,814) in the Eastern District of Missouri. Duke did not—and now cannot—challenge those design patents before the PTAB. Duke expressly acknowledges this fatal flaw, conceding that “Marmon is also asserting two design patents in the parallel litigation . . . as design patents and utility patents involve fundamentally different claim construction methodologies, infringement analysis, and validity

frameworks.” Paper 12 at 2 n.1. Instituting review here guarantees duplicate proceedings, duplicate trials, and piecemeal litigation.

Second, Duke’s procedural tactics impose an administrative drag on Office resources. Between September 30 and October 2, 2026, Duke filed six new IPR petitions (IPR2026-00479 through IPR2026-00484). Across the now seven petitions, Duke recycles the exact same reconstructed “IRHS” prior-art theory and identical secondary references. And far from a streamlined challenge, Duke deploys between 8 and 16 grounds per petition, including massive combinations cobbling together as many as 17 references to challenge a single claim. Duke’s cited cases involved unrelated patents across distinct technologies; here, Duke itself manufactured the volume across seven related patents directed to a single bin architecture.

B. Duke’s Pre-Institution Stay Motion and Evasive Stipulation Guarantee Duplication

With respect to *Fintiv* Factor 1, the stay motion is speculative and premature. *See, e.g., Omni MedSci, Inc. v. WHOOP, Inc.*, No. 25-140, 2025 WL 3719630, at *2 (D. Del. Dec. 23, 2025) (“[S]tays are almost never granted before such [IPR] review is instituted.”). Here, no institution decision has issued, substantial issues remain outside PTAB review, and Petitioner’s stipulation preserves significant invalidity defenses for district-court adjudication.

The institution decisions for Duke’s six newly filed petitions will not issue until late April or May 2027. Where institution decisions have not yet issued, a party can claim only a potential for simplification, and whether meaningful simplification will occur depends on uncertain future events. The district court will not likely freeze its actively managed schedule on the speculative hope that the PTAB might institute review. Indeed, on October 7, 2026, the district court expedited briefing on Duke’s stay motion and expressly mandated that “[t]he parties must comply with existing deadlines while the stay request is under advisement.”

For *Fintiv* Factor 2, Duke emphasizes that trial is scheduled for April 24, 2028—months after a projected Final Written Decision in this single proceeding. But that comparison ignores Duke’s six newly filed petitions. Those proceedings will extend well into mid-2028, completely erasing any timing advantage. Because the district court will resolve all seven utility patents, both design patents, and damages in a single unified trial in April 2028, allowing the district court to proceed is vastly superior to splintering the dispute across seven separate PTAB trials and an ongoing parallel litigation.

With respect to *Fintiv* Factor 4, Duke characterizes its stipulation as a *Sotera* stipulation (Ex. 1063), but it is not. Duke expressly reserved the right to assert in district court “any ground that could not have been reasonably raised in an IPR (*e.g.*, invalidity under 35 U.S.C. § 112 or §§ 102 or 103 on the basis of prior art that did

not qualify as a prior art patent or printed publication).” Ex. 1063 at 7. This reservation is a calculated loophole. In the district court, Duke may argue that its physical IRHS units were “on sale” before the priority date. Because physical devices cannot be raised in an IPR under 35 U.S.C. § 311(b), Duke remains free to challenge the same IRHS technology before the Board through alleged printed publications while simultaneously challenging the same technology in district court through public-use and on-sale theories. The resulting overlap is precisely the type of duplication that broad *Sotera* stipulations are designed to eliminate.

III. Duke’s Opposition Concedes That Its Petition Merely Rehashes Art Considered by the Examiner

In devoting six pages to asserting “Examiner error” (Paper 12 at 15–20), Duke proves Prong 1 of *Advanced Bionics*: every material technical concept in its Petition was already before the Office. Duke admits that the higher-output heater limitation (issued claim 14) was disclosed in Prince Castle’s DHB3PT-33DD manual (Ex. 1065)—which the Examiner initialed in an IDS five days before allowance—and was evaluated in the parent ’750 prosecution. Duke likewise concedes that the spaced bezel interface (issued claim 1) was disclosed in Hartfelder (Ex. 1013), cited directly on the face of the ’002 patent. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential).

Duke fails Prong 2 because it shows no objective error or misapprehension of law. The Examiner considered Chung, evaluated Hartfelder, initialed Prince Castle's manual, and made a reasoned decision to allow the claims. Duke's petition merely invites the Board to second-guess that considered judgment.

IV. Duke's Baseless "Concealment" Allegations Cannot Rescue Its Deficient Petition

Duke's attempt to defeat settled expectations by alleging prior-art concealment (Paper 12 at 12–14) fails chronologically. Patent Owner publicly disclosed the substance of the '002 patent on April 21, 2015, when the first units embodying the invention were installed in Burger King locations. Ex. 2039, ¶¶ 9-30. The commercial rollout of the EHB product line subsequently followed in 2015. Ex. 2005, ¶¶ 5-7. The '002 patent's priority date is April 20, 2016. The Burger King meeting relied upon by Duke (Ex. 1058) occurred in May 2016, over a year after Patent Owners' original public disclosure and after the priority date. Duke cites no evidence that Patent Owner withheld IRHS information from the Office, and the record confirms that the named inventors were publicly deploying and testing their own next-generation system before Fortmann's asserted filing date. Duke cannot substitute post-filing innuendo for statutory prior-art proof.

V. Conclusion

Patent Owner respectfully requests that the Director exercise discretion under 35 U.S.C. §§ 314(a) and 325(d) to deny institution of IPR2026-00406.

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CERTIFICATE OF COMPLIANCE WITH PAGE LIMIT

Pursuant to the Director's authorization to file this reply, I certify that this **PATENT OWNER'S REPLY BRIEF IN SUPPORT OF DISCRETIONARY DENIAL** complies with the page limit set forth therein because it is limited to five (5) pages, excluding the parts of the Brief that are exempted by 37 C.F.R. § 42.24(a).

/Christopher R. Liro/

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CERTIFICATE OF SERVICE

I hereby certify that on October 15, 2026, I electronically filed the foregoing using the Patent Trial and Appeal Case Tracking System (P-TACTS) and served an email copy upon counsel of record for Petitioner, as follows:

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