

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMI LEGEND CORPORATION,
Petitioner,

v.

MANEHU PRODUCT ALLIANCE, LLC,
Patent Owner.

Case No. PGR2024-00014

Patent No. 11,781,703

PATENT OWNER'S PRELIMINARY RESPONSE

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PETITIONER’S EXHIBITS

Exhibit No.	Description
Ex. 1001	U.S. Patent No. 11,781,703 to Massey (“’703 Patent”)
Ex. 1002	Excerpts of Prosecution History of Application No. 17/959,202 (“’703 application”)
Ex. 1003	Declaration of John D. Pratt (“Pratt”)
Ex. 1004	U.S. Patent Pub. No. US 2008/0237424 to Clary (“Clary”)
Ex. 1005	U.S. Patent Pub. No. US 2012/0061543 to Juan (“Juan”)
Ex. 1006	U.S. Patent Pub. No. US 2012/0033371 to Pankros et al. (“Pankros”)
Ex. 1007	U.S. Provisional App. No. 61/381,298 to Juan (“Juan Provisional”)
Ex. 1008	U.S. Provisional App. No. 61/370,945 to Pankros (“Pankros Provisional”)
Ex. 1009	U.S. Provisional App. No. 61/396,850 to Massey
Ex. 1010	U.S. Patent Application No. 13/118,297 to Massey
Ex. 1011	U.S. Patent Application No. 15/489,596 to Massey
Ex. 1012	U.S. Provisional App. No. 61/913,195 to Massey
Ex. 1013	U.S. Patent Application No. 14/563,842 to Massey
Ex. 1014	Curriculum Vitae of Dr. John D Pratt
Ex. 1015	Certified English Translation of Japanese Patent Publication No. 2009-14047
Ex. 1016	Japanese Patent Publication No. 2009-14047A to Tsuji

Exhibit No.	Description
Ex. 1017	Certified English Translation of Chinese Patent Publication No. 100411567C
Ex. 1018	Chinese Patent Publication No. 100411567C to Xu

PATENT OWNER'S EXHIBITS

Exhibit No.	Description
Ex. 2001	Excerpts of Prosecution History of the '703 application
Ex. 2002	Excerpts of Prosecution History of US Application No. 16/924,551 (issued as Patent No. 11,460,145) ("parent '551 application")
Ex. 2003	U.S. Patent No. 8,074,950 to Clary ("Clary Patent")
Ex. 2004	Declaration of Dr. Kirsten Carr
Ex. 2005	Dr. Kirsten Carr Curriculum Vitae
Ex. 2006	Declaration of Ramsey Al-Salam accompanying Pro Hac Vice motion

I. INTRODUCTION

Lumi Legend Corporation (“Petitioner”) filed a Petition (“Petition”) for Post Grant Review of claims 33-36 of U.S. Patent No. 11,781,703 (Ex. 1001, “the ’703 Patent”) on January 24, 2024.

Manehu Product Alliance, LLC, d/b/a MantelMount’s (“MantelMount” or “Patent Owner”) requests that the Petition be denied because Petitioner has failed to “demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable” under 35 U.S.C. § 324(a).

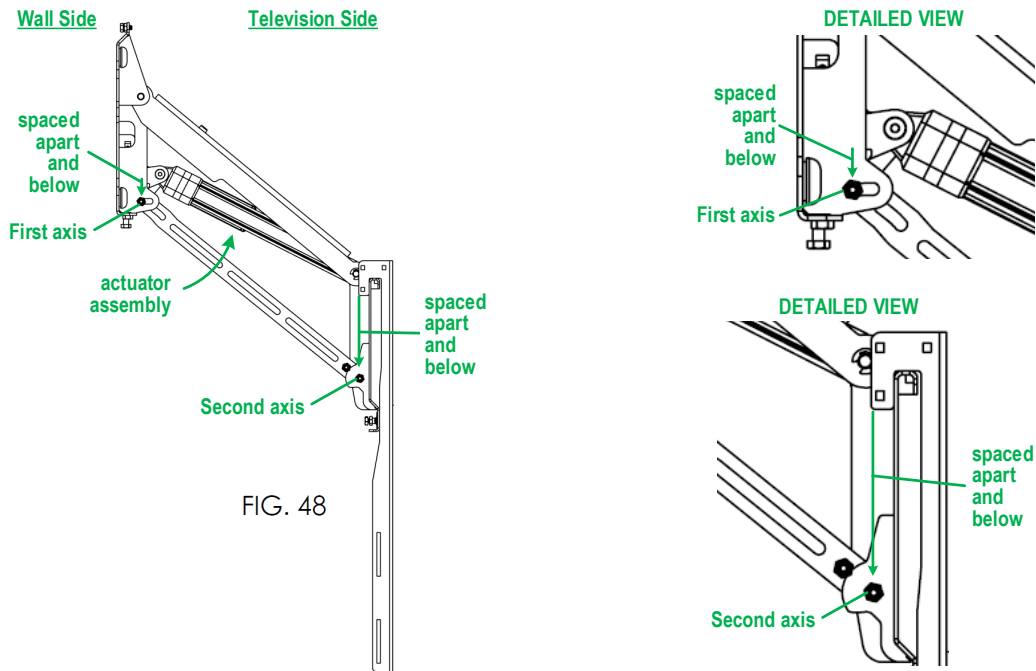
MantelMount is a leading designer and seller of television mounts and accessories. MantelMount has made significant investments in research and engineering to develop innovative wall-mountable television mounts and has obtained numerous patents covering those television mounts. The ’703 Patent and its claims relate to motorized television mounts installable above fireplace mantels and including motorized actuator assemblies operable to raise and lower televisions. In a raised stowed configuration, the motorized television mounts can hold the television near the wall and above fireplace mantels. In a lowered viewing configuration, the motorized television mounts can hold the television in front of fireplaces for optimal viewing when sitting. The motorized television mounts can be modified by the user to adjust contraction and extension of a linear actuator of the motorized actuator assembly to set the counterbalancing forces

provided by the motorized actuator assembly. These adjustments to the linear actuator can be made without changing a raised stowed position or a lowered viewing position of the television.

Petitioner is a China-based company that has repeatedly copied features of MantelMount's television mounts. MantelMount initiated Amazon.com, Inc.'s ("Amazon") Amazon Patent Evaluation Express (APEX) procedures against numerous infringing products manufactured by the Petitioner. This resulted in Amazon delisting a number of those products infringing Patent Owner's patent rights. One of the Amazon APEX delisting procedures was based on the '703 Patent to stop U.S. sales of infringing products.

Petitioner's alleged grounds in the Petition are fatally flawed and fail to establish that it is more likely than not that at least one of the claims of the '703 Patent is invalid. For example, Petitioner's Ground 1 alleges that dependent claim 36 is unpatentable for failing to satisfy the written description requirement. The '703 Patent, however, discloses all of the features of claim 36, including the claimed mount, arrangement of those claimed features, and illustrates the features in the claimed position, such that a person of ordinary skill in the art ("POSITA") would have understood that the inventor had possession of all of the limitations of claim 36 at the time of filing. Figure 48 (annotated by Patent Owner) of the '703 Patent also shows an example television mount configured to have "the first axis of

rotation and the second axis of rotation . . . spaced apart from and located below an extendable actuator of the motorized actuator assembly when the arm assembly is in the lowered configuration” of claim 36.



Ex. 1001, Fig. 48 (annotated). Accordingly, a POSITA would have recognized that the inventor had possession of the limitations as recited in challenged claim 36 under 35 U.S.C. § 112.

Petitioner’s Ground 2 alleges that claim 36 is indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor regards as the invention. However, Figures 43-48 of the ’703 Patent show how the features of claim 36 move relative to one another, and Figure 48 illustrates an embodiment positioned in the recited arrangements. Accordingly, the ’703 Patent meets the definiteness requirements of 35 U.S.C. § 112.

Petitioner's Grounds 3-4 alleging invalidity are fatally flawed. As for Ground 3, the primary reference Clary is listed on the face of the '703 Patent and indicated as considered by the USPTO during prosecution of the '703 application. Clary fails to disclose or suggest, for example, "a motorized actuator assembly having . . . a display bracket end rotatably coupled to the arm assembly" as recited in independent claim 33. The USPTO found in a related parent application that Clary failed to disclose a limitation similar to this limitation of claim 33. As for Ground 4, the secondary reference Tsuji fails to disclose the deficiencies of Clary and would not motivate a POSITA to modify Clary to arrive at independent claim 33. Accordingly, the art relied upon by the Petitioner fails to disclose or suggest the features of challenged claim 33-36.

Petitioner's Ground 5 relies on a primary reference Pankros listed on the face of the '703 Patent and indicated as considered by the examiner during prosecution of the '703 application. Pankros, among other shortcomings, fails to disclose or suggest, for example, that a portion of a motorized actuator assembly moves toward and past a portion of a lower arm when an arm assembly moves toward a raised configuration to position a display bracket at a raised position as recited in independent claim 33. In contrast, Pankros discloses balancing devices and an actuator that do not move past lower support arms. Accordingly, Petitioner

has failed to establish that it is more likely than not that challenged claims 33-36 are anticipated by Pankros.

Petitioner's Ground 6 is fatally flawed because not only does the cited art fail to teach or suggest features of the challenged claims, the alleged invalidity grounds also fail to render obvious the challenged claims. The primary reference Pankros and secondary reference Clary were already considered by the USPTO. Clary does not cure the deficiencies of Pankros, and a POSITA would not be motivated by the teachings of Clary to modify the art relied on by the Petitioner to arrive at claim 33-36. The Petitioner fails to establish why a person of ordinary skill in the art would have found it obvious to combine the references, or how those combinations would have worked. The Petition merely includes conclusory statements about already considered art to allege obviousness of challenged claims 33-36.

Finally, the Board should exercise its discretion to deny institution under 35 U.S.C. §325(d) because the Petition relies on references that were already considered by the Office, and the assertions of invalidity based on written description are meritless. In particular, in Grounds 3-6, Petitioner relies on primary references (Clary and Pankros) that were considered by the Examiner during prosecution. Therefore, the Board should exercise its discretion to deny institution under 35 U.S.C. §325(d). Because of these and other shortcomings

discussed below, the Petitioner fails to show that it is more likely than not that at least one of the claims of the '703 Patent is unpatentable, and thus the Board should not institute *a post grant* review.

II. THE '703 PATENT

The '703 Patent relates to television mounting systems that can be mounted to walls above fireplaces. Ex. 1001, 1:33-35. The television mounting systems can move televisions between a raised position and a lowered position. FIG. 2, reproduced below, shows an example television mounting system holding a television 110 in a raised, stowed position close to the wall 120:

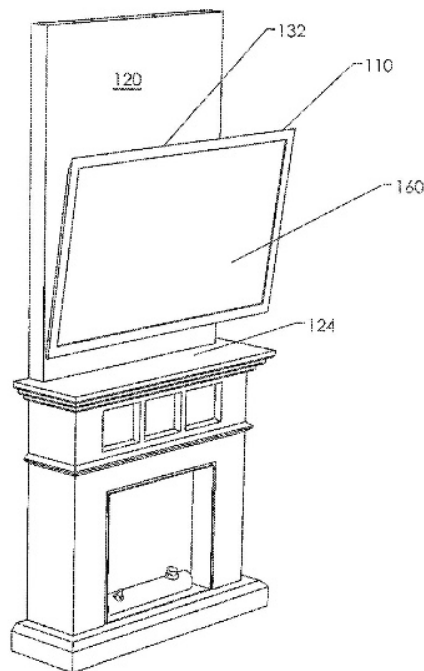


FIG. 2

Id. at 6:64-65.

FIG. 3, reproduced below, shows the television 110 in a lowered position in front of the fireplace.

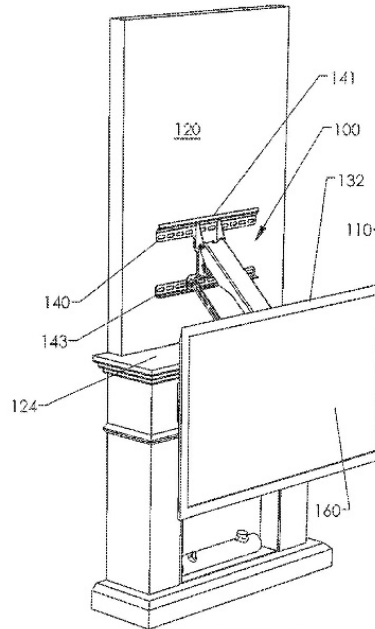
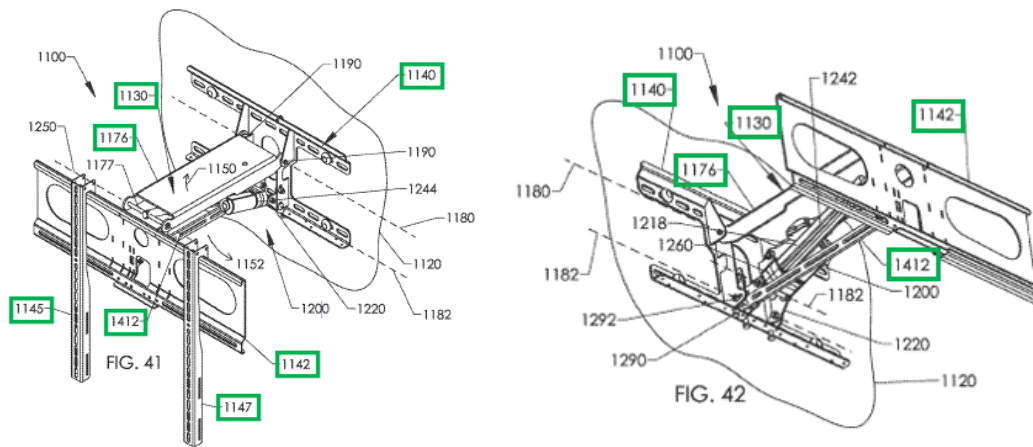


FIG. 3

Id. at 7:8-12. The lowered television 110 can be positioned in front of the fireplace such that the viewer's eyes can be generally level with the center of the screen. *Id.* After viewing, a motorized actuator assembly can automatically return the television to the raised stowed position. *Id.* at 7:18-19.

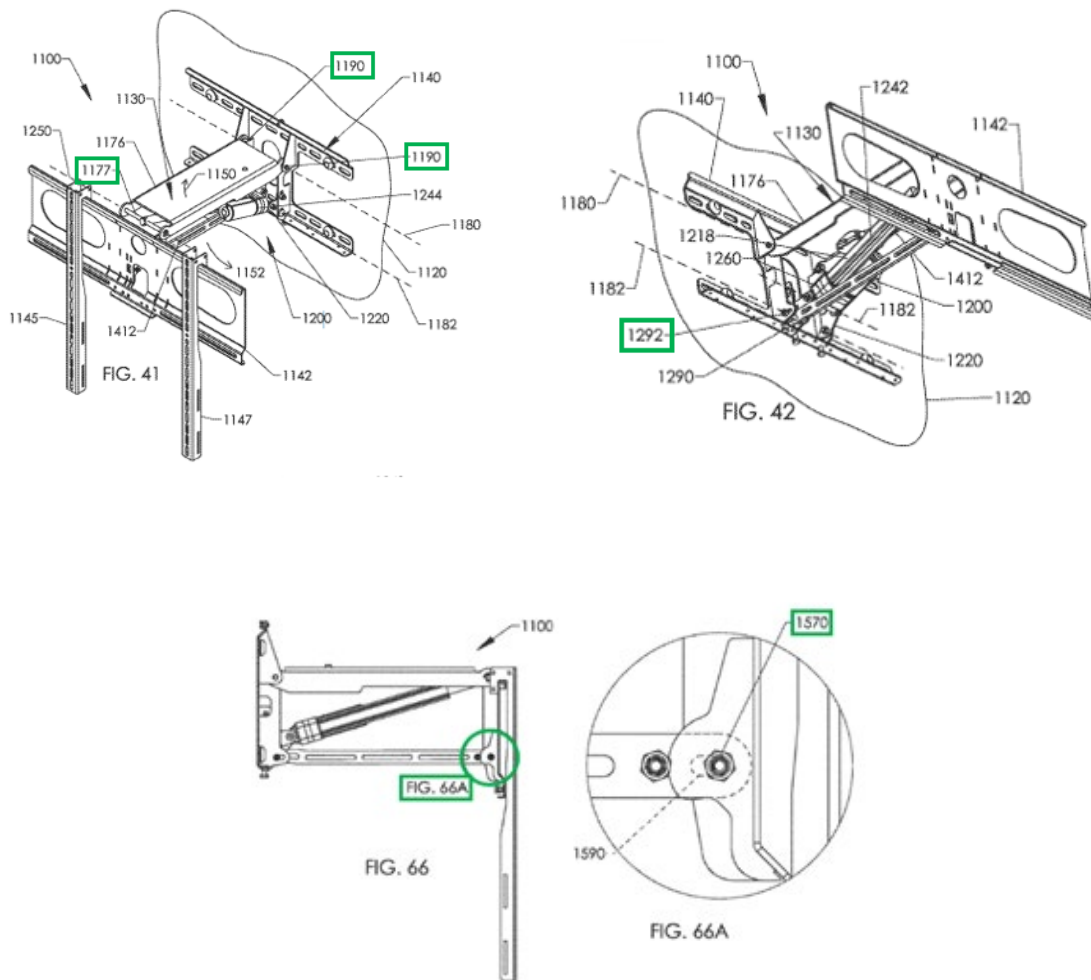
The television mounting system of the '703 Patent includes a support bracket mountable to a wall, a display bracket configured to hold a television, and an arm assembly pivotally coupled to the support bracket and the display bracket. For example, as shown in Figures 41 and 42, the '703 Patent discloses an arm assembly (e.g., linkage assembly 1130), a support bracket 1140, and a display bracket 1142. The arm assembly can include an upper arm, e.g., link 1176, and a

lower arm, e.g., link 1412. The display bracket 1142 includes a rail or main body 1510 (see Figure 63) and holders 1145, 1147 that hang on the rail or main body 1510. *Id.* at 17:23-27; see, e.g., *id.* at 9:8-13. These are illustrated below in annotated versions of Figures 41 and 42, which show different views of the same mounting system:



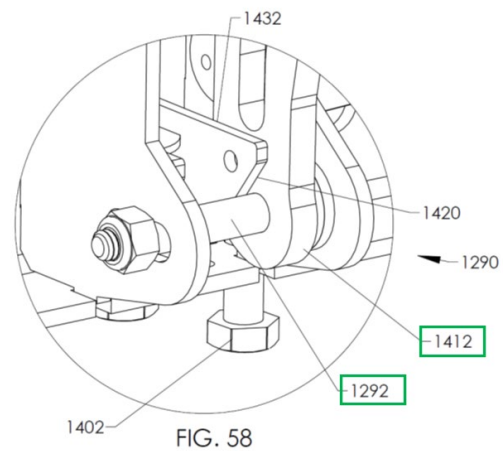
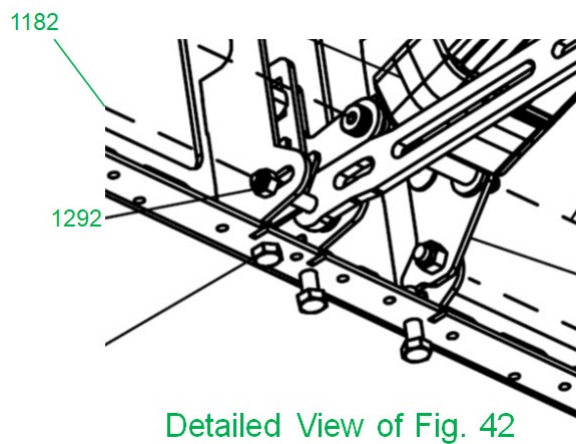
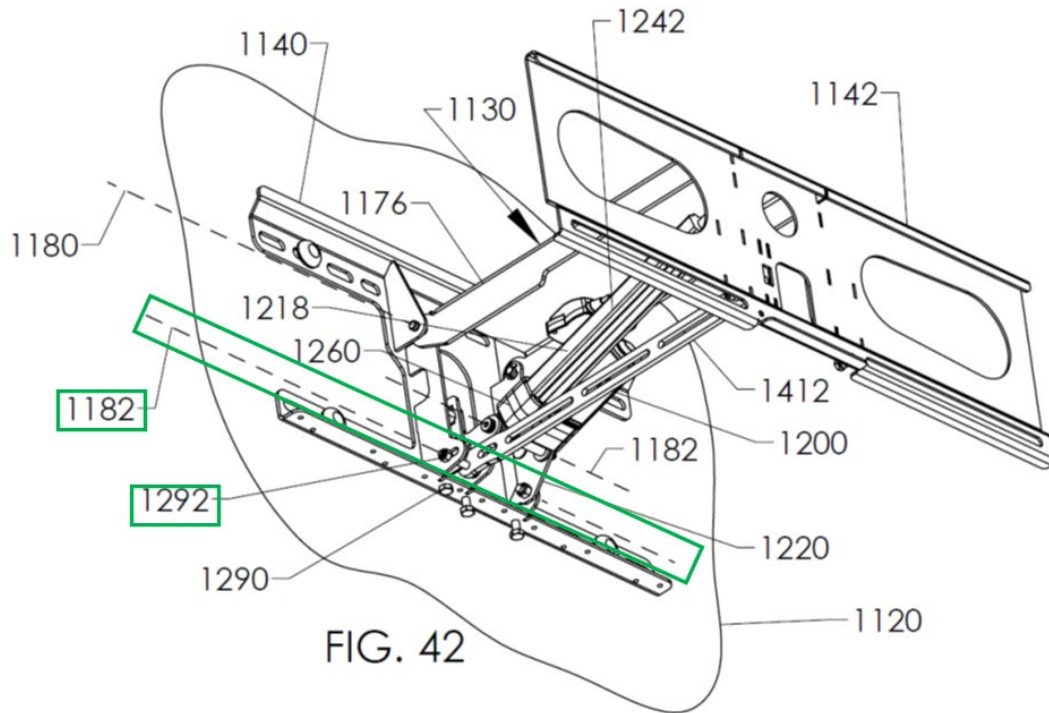
Id. Figs. 41 (annotated), 42 (annotated).

The arm assembly may be rotatably coupled to the support bracket via pivot points 1190 and 1292, and to the display bracket via pivot points 1177 and 1570. See, e.g., *id.* Figs. 41-42, 66, 66A; *id.* at 17:42-54, 20:25-53. Examples of these are illustrated in the annotated Figures 41, 42, 66 and 66A, below:



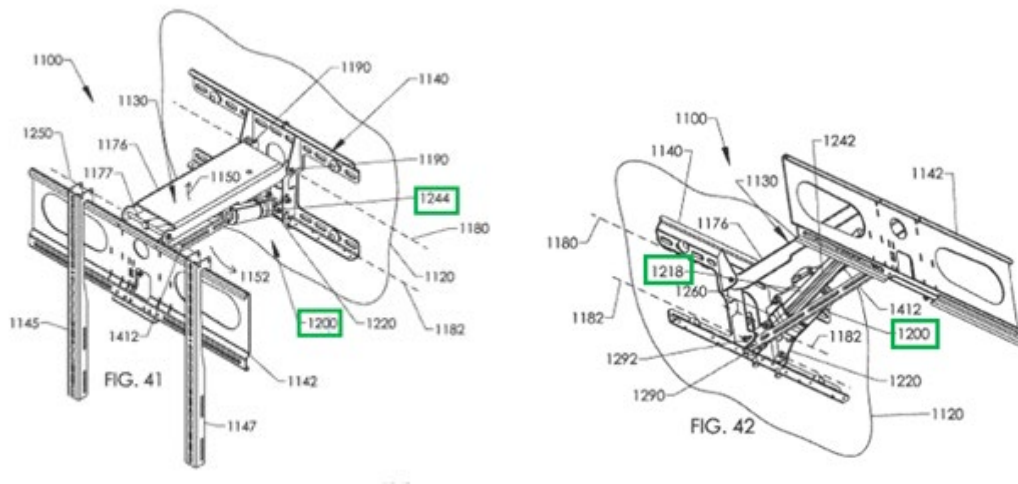
Id. Figs. 41 (annotated), 42 (annotated), 66 (annotated) and 66A (annotated).

Figure 42 shows the pivot 1292 defining the axis of rotation 1182 such that “[t]he lower link 1412 is rotatable about a lower axis of rotation 1182 defined by support pivot 1292 (FIG. 42).” *Id.* at 17:45-47.



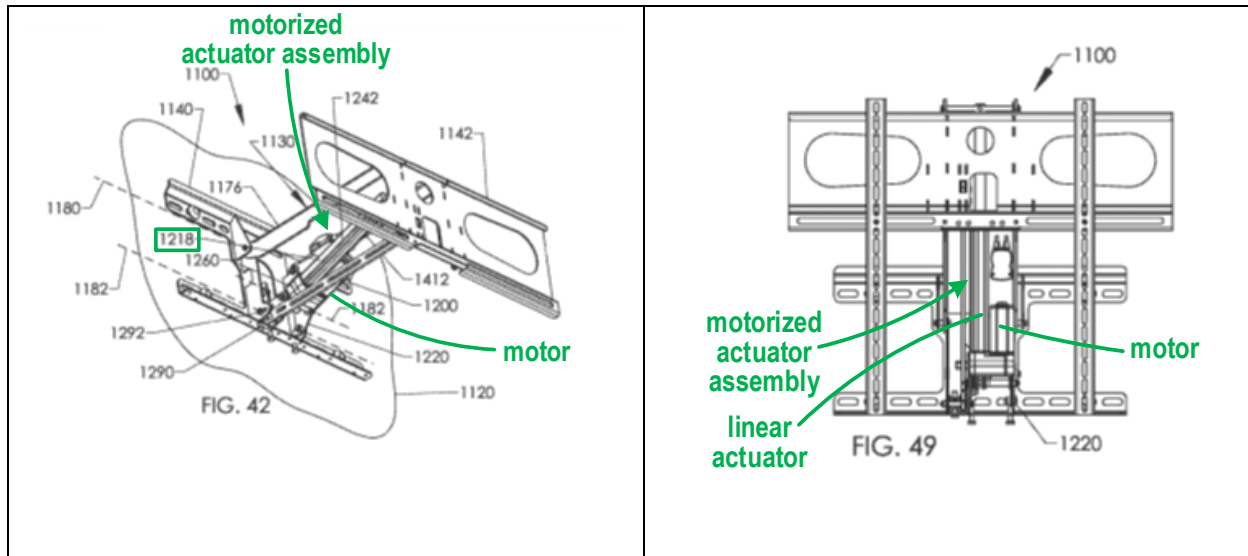
Id. Figs. 42 (annotated) and 58 (annotated).

The television mounting system can be motorized to automatically raise and lower the television. *See, e.g., id.* at 12:14-15, 17:55-67. The '703 Patent describes a motorized actuator assembly 1200, which can include “linear actuator 1218 and “motor 1244” (*id.* at 17:55-58), rotatably coupled to the support bracket 1140 and the display bracket 1142. *Id.* at 17:58-59. Examples are shown below in annotated versions of Figures 41 and 42:



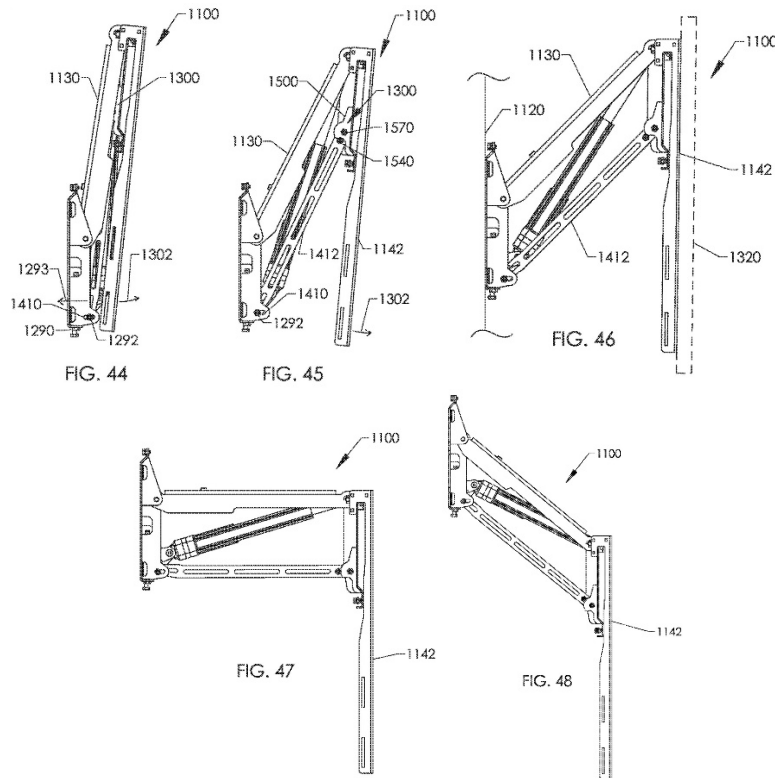
Id. Figs. 41 (annotated), 42 (annotated)

Figures 42 and 49 shows the motorized actuator assembly with the linear actuator and motor positioned in a side-by-side arrangement. *Id.* Fig. 42, 17:55-67, 18:1-12; *see also id.* Fig. 41. Patent Owner has annotated Figures 42 and 49 to illustrate this below:



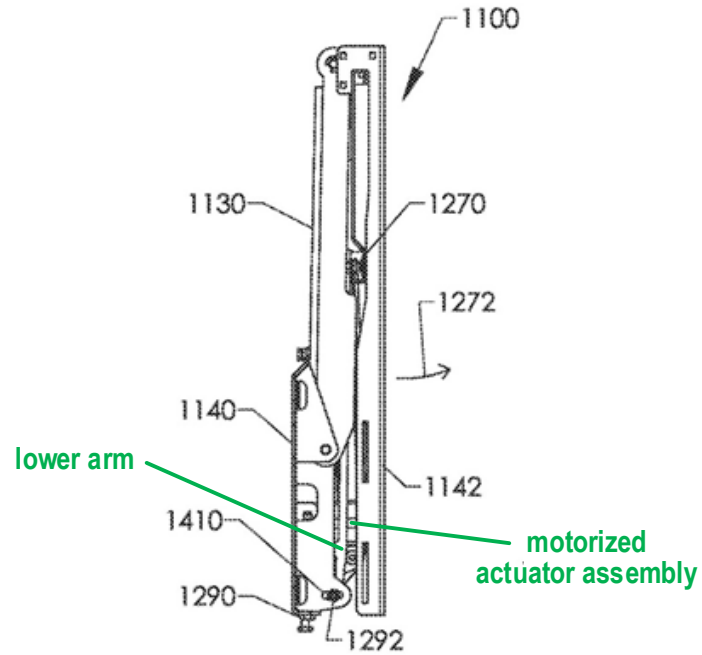
Id. Figs. 42 (annotated), 49 (annotated). The '703 Patent describes the television system having an actuator positioner 1220 (*see, e.g.*, Figures 42 and 49 above) that can be used to move an end of a linear actuator upwardly or downwardly to adjust the amount of force used to raise and/or lower the television. *Id.* at 18:1-12.

Figures 43-48 and 60-62 show movement of the motorized actuator relative to the arm assembly such that the motorized actuator assembly moves past a lower arm of the arm assembly when the television mounting system is moved toward the raised configuration. *See, e.g., id.* Figs. 43-48, 60-62; *id.* at 5:60-61, 6:13-14, 18:13-19:2.



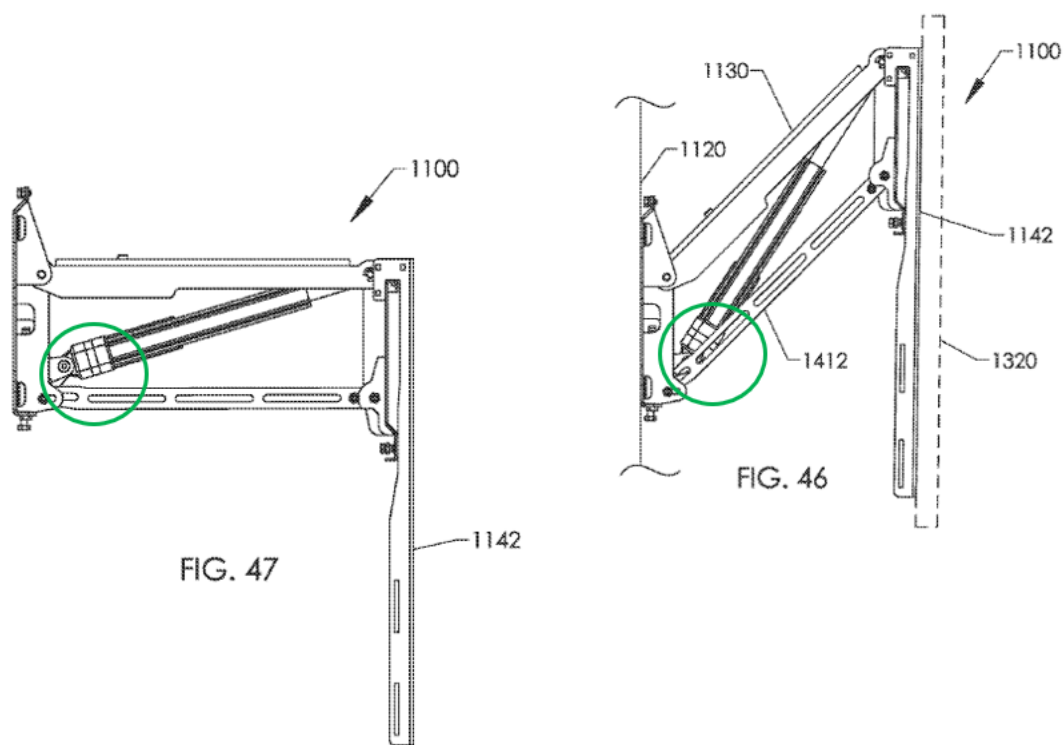
Id. Figs. 44-48.

Figure 43 (annotated below) illustrates the mount in a stowed, or near stowed, position, which shows that the motorized actuator assembly is positioned next to and protruding past the lower arm 1412. It is noted that although lower link 1412 and motorized actuator assembly 1200 (with “linear actuator 1218” and “motor 1244”) are not labeled with their reference numbers in Fig. 43, their presence and position in this and other Figures is apparent based on the disclosures of the ’703 Patent, including the portions of the specification and figures discussed above.



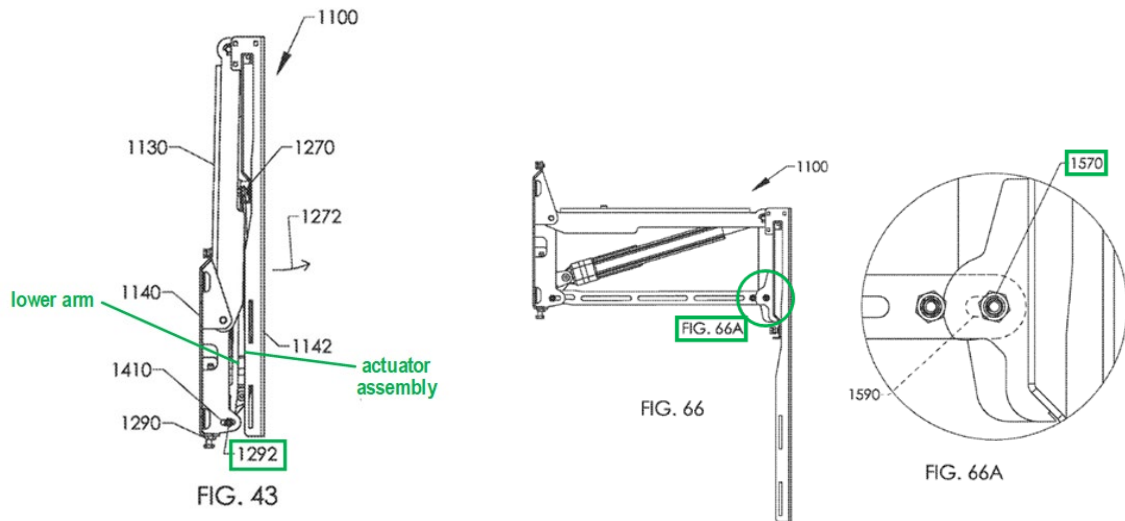
Id. Fig. 43 (annotated).

Figures 46 and 47 show that a portion of the motorized actuator assembly moves toward the lower arm 1412 when the arm assembly moves from a lowered position toward a raised position, as is highlighted in the annotated figures below:



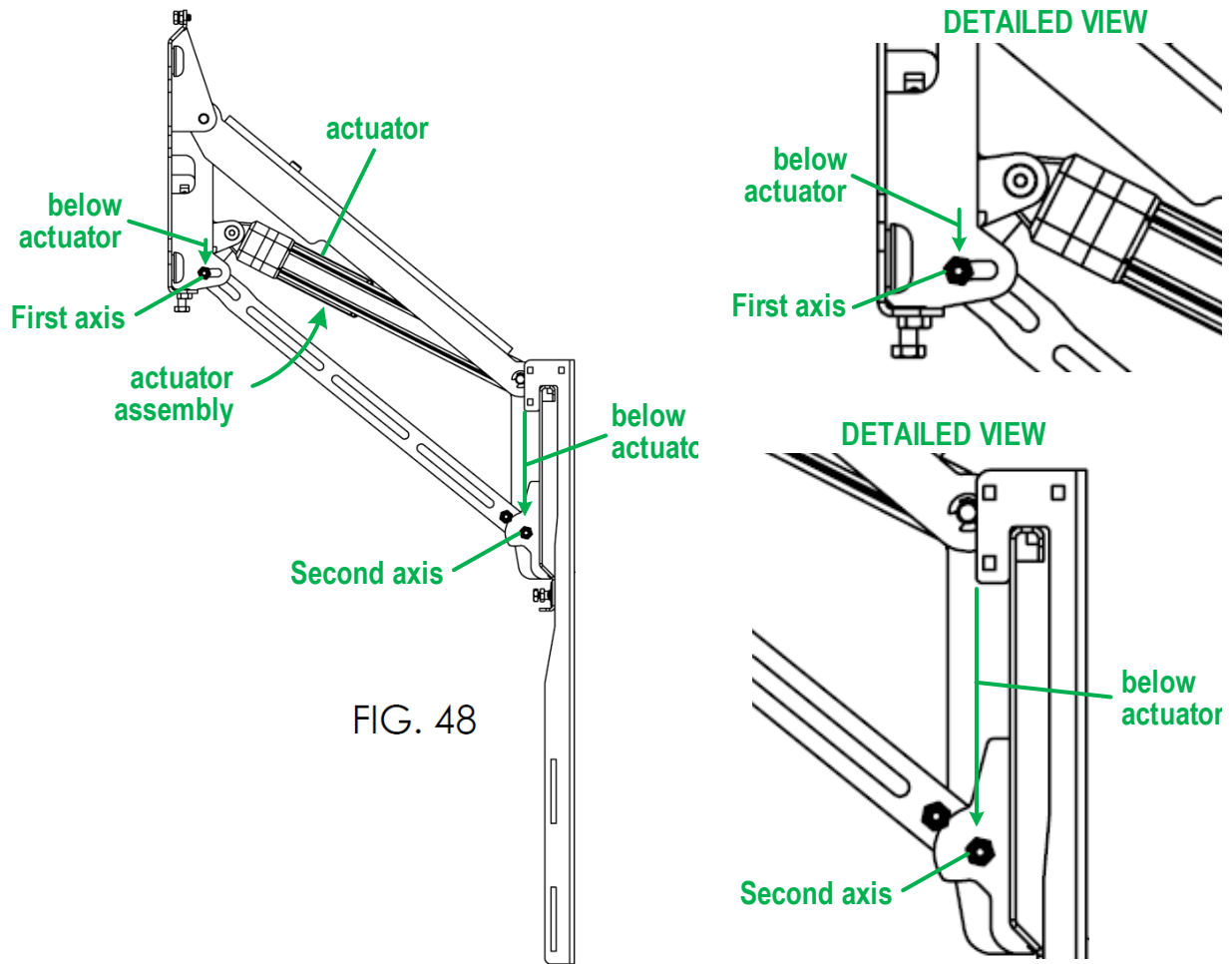
Id. Figs. 46 (annotated), 47 (annotated); *see also id.* Figs. 60-62.

Figures 43-45 show positions of the motorized actuator assembly after a portion of the motorized actuator assembly has moved past a portion of the lower arm 1412. Figure 43 shows the arm assembly in the raised configuration such that the portion of the motorized actuator assembly is positioned forward of the lower arm 1412 with the first axis of rotation defined by pivot 1292 (annotated) and second axis of rotation defined by pivot 1570 (annotated):



Id. at Figs. 43 (annotated), 66 (annotated), 66A (annotated).

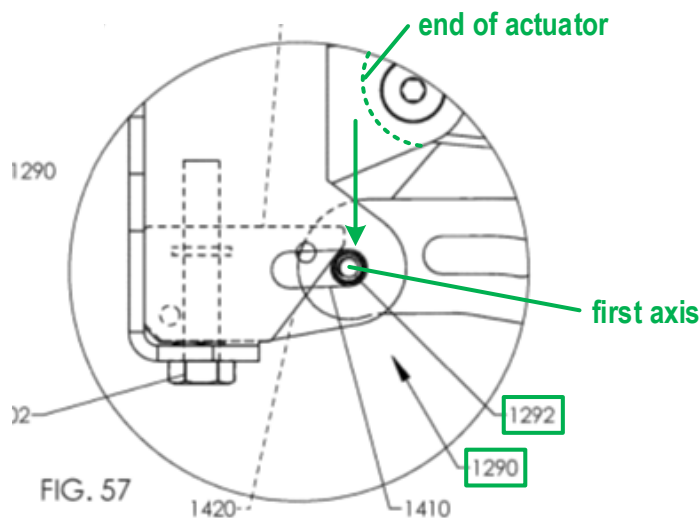
Figures 43-48 show how the motorized actuator assembly moves away from and is vertically spaced apart from the lower arm 1412 when the arm assembly is in the lowered configuration. For example, Figures 46-48 show the actuator assembly and lower arm 1412 moving away from each other as the arm assembly moves toward the lowered configuration while maintaining the vertical orientation of the television 1320. Figure 48 (annotated) shows a first axis of rotation movable along a slot positioned below the contracted linear actuator 1412:



Id. Fig. 48 (annotated and with enlarged detailed views); *see also id.* Fig. 62. Both the first axis of rotation and the second axis of rotation are spaced apart from and located below the contracted linear actuator 1412 when the arm assembly is in the illustrated lowered configuration.

The '703 Patent discloses multiple examples of tilt adjustment mechanisms for positioning the first axis of rotation below the linear actuator 1412. Figure 57 shows a tilt adjustment mechanism 1290 that includes an adjustment mechanism and a pivot 1292 movable along a slot 1410. *Id.* at 19:50-52 and 59-63. The pivot

1292 defines the first axis of rotation positioned below an end of the linear actuator 1218.



Id. Fig. 57 (annotated).

The first axis is spaced apart and positioned below the end of the actuator 1218. *Id.* at 19: 59-63. Figures 34 and 40 shows another embodiment of a tilt mechanism 770 for positioning a first axis of rotation at a front end (shown in Figure 34) of the slot 902 and below an end of a biasing mechanism 970. *Id.* at 14:28-54; 16: 6-12.

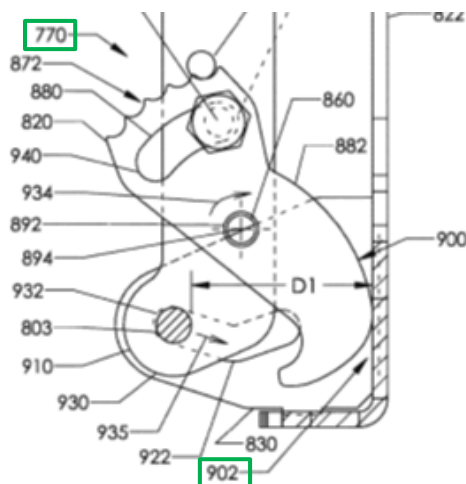


FIG. 34

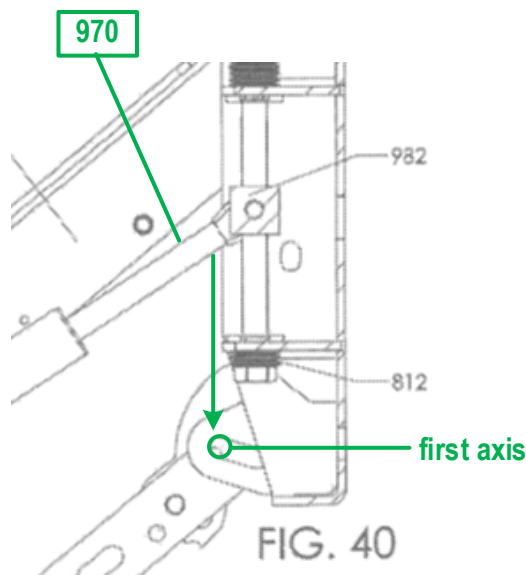


FIG. 40

The '703 Patent discloses the interchangeability of the tilt adjustment mechanisms and force generating components in the form biasing devices and/or actuators. *Id.* at 1:64 to 1: 5 and 2:41-45.

Figures 50-54 show the motorized actuator assembly and components for adjusting the position of the motorized actuator assembly. For example, the '703 Patent discloses the motorized actuator assembly can be rotatably coupled to a pin 1360. Figures 53 and 54 show the pin 1360 carried by a carriage 1330 at a raised position for raising the actuator assembly and a lowered position for lowering the actuator assembly, respectively. *See e.g., id.* Figs. 53, 54; *id.* at 19:38-46.

In the above-described television systems, the arm assembly and motorized actuator assembly cooperate to hold the television at different heights and orientations. For example, Figure 44 shows a vertically oriented television at a

raised close-to-wall position, Figure 45 shows a forward tilted orientation of the television, and Figure 48 shows a vertically oriented television at a fully lowered position. The motorized actuator assembly can be adjusted based on the weight of the television and target level of flexing of the mount without altering the orientation of the television.

The above summary discusses the subject matter of the challenged claims along with references to portions of the specification and drawings that provide a general description of this subject matter. The labelling of figures and other annotations by Patent Owner are exemplary only and are not intended to limit the challenged claims only to the exact embodiments shown and described in the specification and figures of the '703 Patent. The scope of the challenged claims are not to be construed by this summary.

III. PETITIONER'S CONTENTIONS FOR PGR ELIGIBILITY

Petitioner contends, among other things, priority dates of applications, support or lack of support of subject matter, the applicability of the Leahy-Smith America Invents Act ("AIA"), and the '703 Patent is eligible for PGR. Patent Owner does not address the Petitioner's contentions because Petitioner has failed to meet its burden to establish that it is more likely than not that at least one of the challenged claims 33-36 of the '703 Patent is invalid. Patent Owner reserves the right to respond to Petitioner's contentions in the event institution is not denied.

IV. CLAIM CONSTRUCTION AND LEVEL OF ORDINARY SKILL

Petitioner has proposed the level of ordinary skill in this case is “at least a bachelor’s degree in mechanical engineering, electrical engineering, or similar technical degree and at least 2 years of experience in the field of mechanical design or relevant product design experience.” Petition at 27. Patent Owner does not address the definition of a POSITA in this Preliminary Response because Petitioner has not shown that the claims are invalid to a POSITA in light of the level of skill proposed by Petitioner.

Petitioner has also proposed constructions of two claim terms, one for independent claim 33 and the other for dependent claim 36, but indicates its Petition is supported “under any reasonable construction” of these terms. Petition at 28-34. Patent Owner does not address claim construction in this Preliminary Response because no construction of any term is necessary in order to find that the Petitioner has failed to meet its burden to establish that it is more likely than not that any of the challenged claims 33-36 of the ’703 Patent are unpatentable. Moreover, Petitioner has not shown that the claims are invalid to a POSITA in light of its proposed constructions or “under any reasonable construction.”

Patent Owner reserves the right to propose or challenge the level of ordinary skill and claim constructions should the Board institute trial.

V. THE PETITION FAILS TO DEMONSTRATE THAT IT IS MORE LIKELY THAN NOT THAT ANY OF THE CHALLENGED CLAIMS OF THE '703 PATENT ARE UNPATENTABLE

The Petition fails to show that it is more likely than not that at least one of the challenged claims of the '703 Patent is unpatentable for at least the following reasons.

A. Ground 1: Petitioner Fails to Establish that Dependent Claim 36 Lacks Written Description

The '703 Patent describes all the limitations of dependent claim 36 in sufficient detail such that a POSITA would conclude that the inventor had possession of the claimed invention at the time of filing. Written description requires an application to “reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The test “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Id.* “It is not necessary that the exact terms of a claim be used *in haec verba* [in these words] in the specification.” *Nalpropion Pharms., Inc. v. Actavis Labs. FL, Inc.*, 934 F.3d 1344, 1350 (Fed. Cir. 2019).

When determining whether there is written description support, “[r]igidity should yield to flexible, sensible interpretation.” *Id.* at 1351. What matters is that “‘the essence of the original disclosure’ conveys the necessary information—

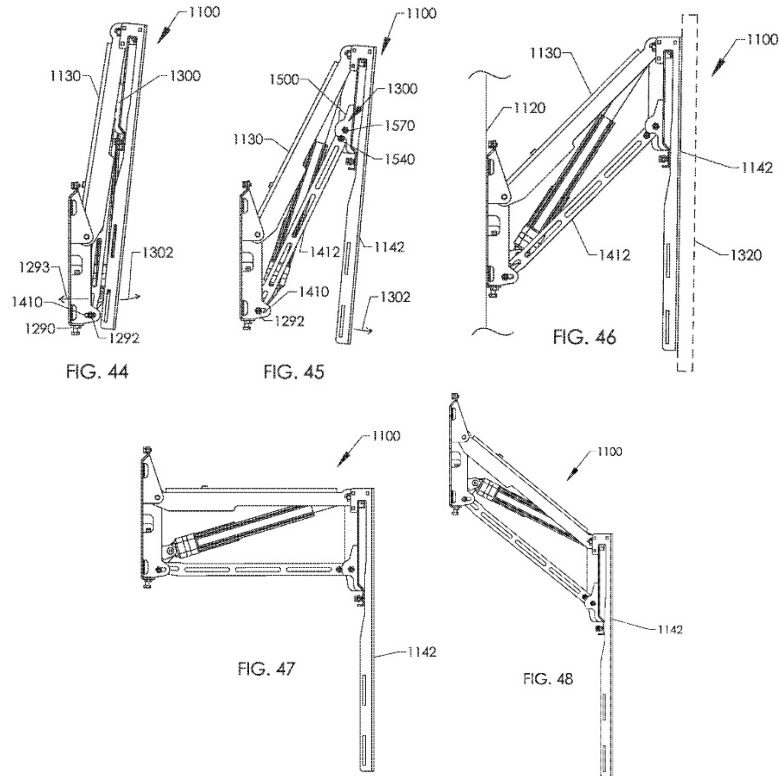
‘regardless of *how* it’ conveys such information and regardless of whether the disclosure’s ‘words [a]re open to different interpretation[s].’” *Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350, 1354 (Fed. Cir. 2015) (emphasis in original) (*quoting In re Wright*, 866 F.2d 422, 424-25 (Fed. Cir. 1989)).

To this end, the written description requirement can be satisfied based on figures alone and the specification. See, *e.g.*, M.P.E.P. §2163; *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (“written description” requirement may be satisfied by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention”); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991) (“drawings alone may provide a ‘written description’ of an invention as required by § 112”).

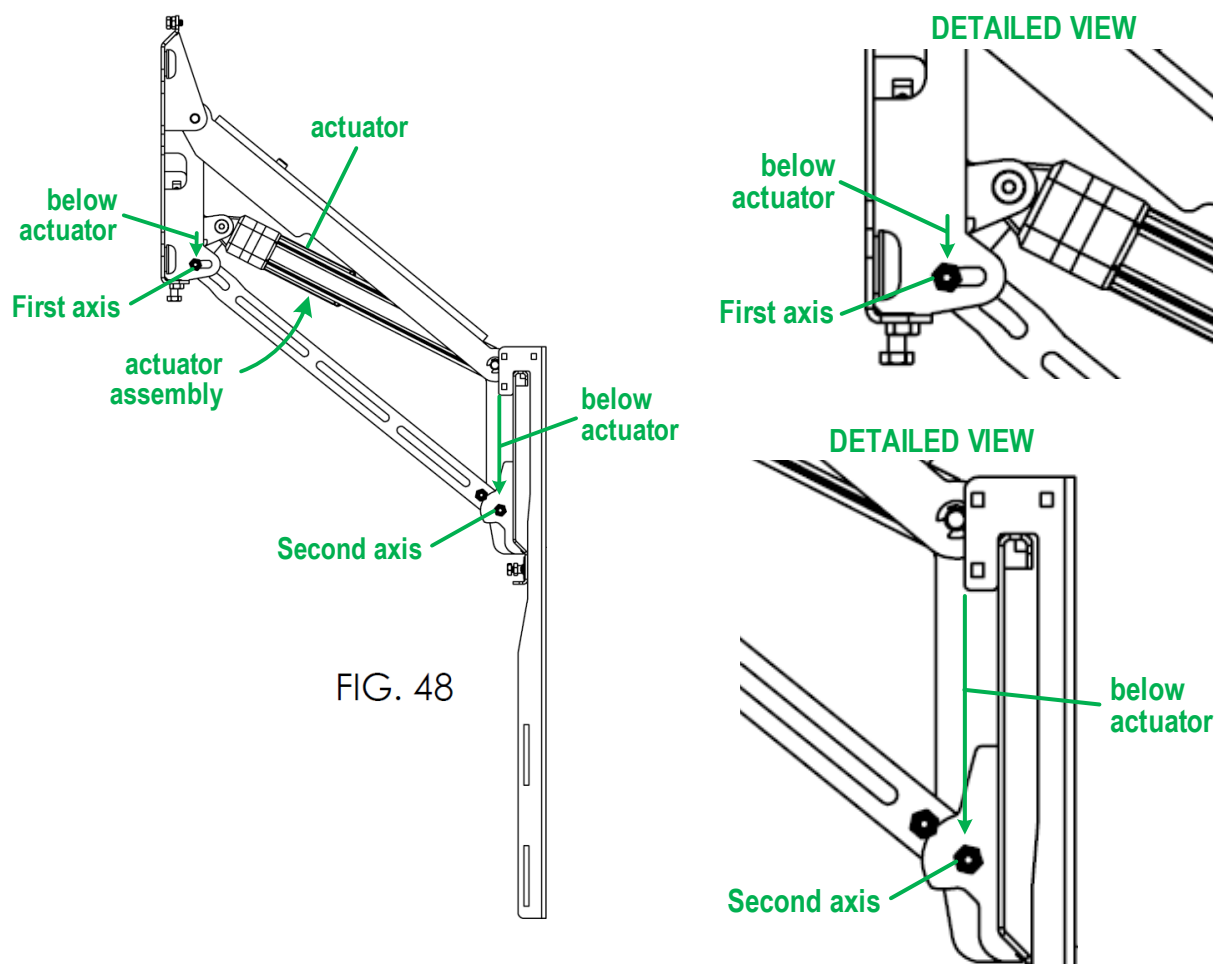
During prosecution of the ’703 Patent, the Examiner issued a restriction dated February 17, 2023, identifying species 6 shown in Figures 41-55. Ex. 2001 at 38. Applicant elected species 6 (Figures 41-55) and pointed out that claims 27-36 and 38-62 were readable on species 6. *Id.* at 33. In the Office Action dated June 8, 2023, the Examiner examined and allowed claims 27-62 directed to the elected species 6. *Id.* at 13. Allowed claims 50-53 issued as claims 33-36 of the ’703 Patent. In the Notice of Allowance dated August 31, 2023, the Examiner stated that the restriction was evaluated “in view of the allowability of claims to

the elected invention.” *Id.* at 6. Accordingly, the prosecution history evidences that at least Figures 41-55 provided written description support for challenged claim 36.

Petitioner alleges lack of written description for “the first axis of rotation and the second axis of rotation are spaced apart from and located below an extendable actuator of the motorized actuator assembly when the arm assembly is in the lowered configuration” as recited in claim 36. Petition at 51. The ’703 Patent describes how the motorized actuator assembly is rotatably coupled to the support bracket and the arm assembly. Figures 44-48 show, reproduced below, how the motorized actuator assembly moves away from and becomes vertically spaced apart from the lower arm 1412.



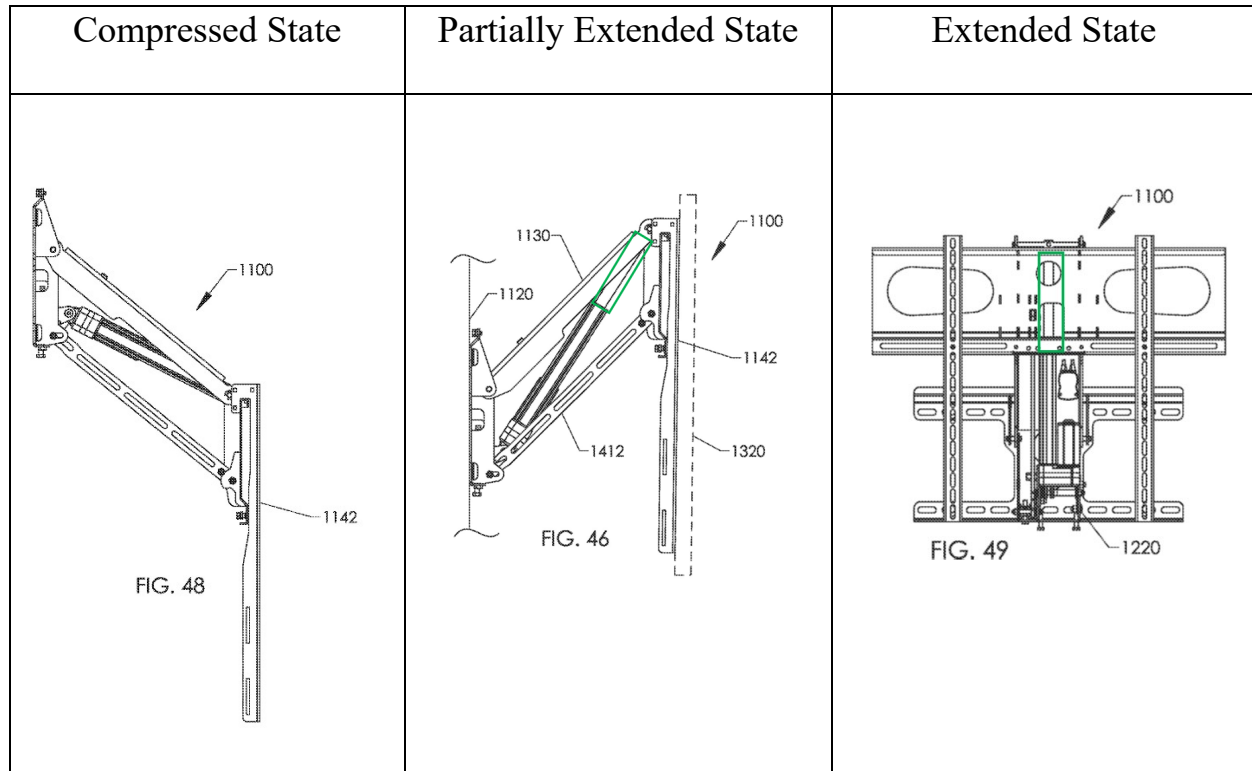
Id. Figs. 44-48; Ex. 2004 ¶¶ 35-38. Figure 48 (annotated) shows the television mount 1100 positioned such that the first axis of rotation and the second axis of rotation are spaced apart from and located below the contracted linear actuator when the arm assembly is in the lowered configuration.



Ex. 1001 Figs. 48 (annotated and with enlarged detailed views); *see also id.* Fig. 62; Ex. 2004 ¶ 39. Accordingly, a POSITA would conclude that the Applicant had possession of the claimed invention at the time of filing. *See also* Ex. 2004 ¶¶ 32-40.

Petitioner contends that “specification for these applications does not mention or describe an ‘extendable actuator.’” Petition at 52. Figures 43-48 and 60-62 show an extendable linear actuator 1218 in a compressed state in Figure 48,

a partially extended state in Figure 45, and an extended state in Figure 49, as shown below.



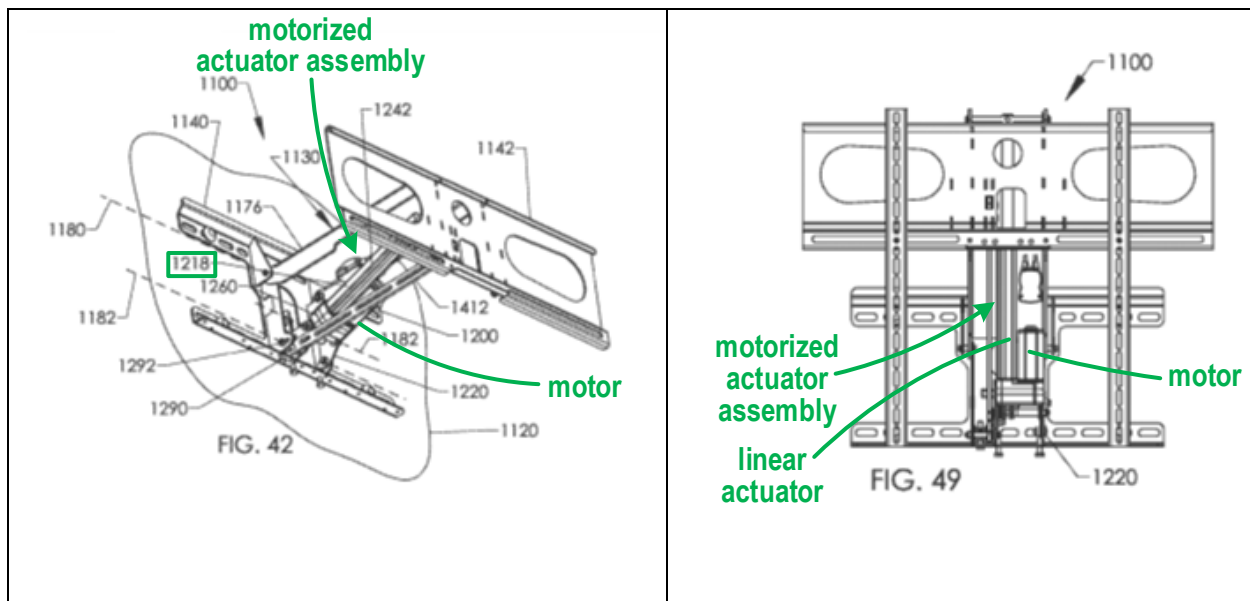
Ex. 1001, Figs. 48, 46, and 49 (annotated to indicate extended portion); Ex. 2004

¶¶ 41-42.

The '703 Patent further discloses how to cause extension of the linear actuator 1218. The '703 Patent discloses a motor mounted to the linear actuator 1218, and that motor can be a drive motor or stepper motor controlled by a control device, and the actuator can **extend** or **contract** for raising, lowering, tilting, or otherwise moving the display bracket. Ex. 1001 at 17:58-63 (“motor 1244 (FIG. 41) can include one or more drive motors, stepper motors, or the like that are mounted on the linear actuator 1218”); 21:45-47 (“actuators 2310, 2312 can extend

or contract to raise, lower, tilt, or otherwise move the display bracket 2306”); *see also id.* At 12:12 to 13:21; 17:58-65; Ex. 2004 ¶¶ 41-42. Accordingly, the ’703 Patent discloses and describes extendable linear actuators to meet the written description requirements under 35 U.S.C. § 112.

Petitioner contends that the “specification for these applications does not mention or describe ... extendable actuator that is part of a motorized actuator assembly.” Petition at page 52. But the ’703 Patent discloses that the motorized actuator assembly shown in Figures 41-48 includes the linear actuator 1218 and the motor 1244. Ex. 1001 at 17:59-63; Ex. 2004 ¶¶ 36-37, 41-42. Figures 42 and 49 show the linear actuator 1218 and motor 1244 positioned in the side-by-side arrangement. Ex. 1001 Fig. 42, 17:55-67, 18:1-12; *see also id.* Fig. 41.



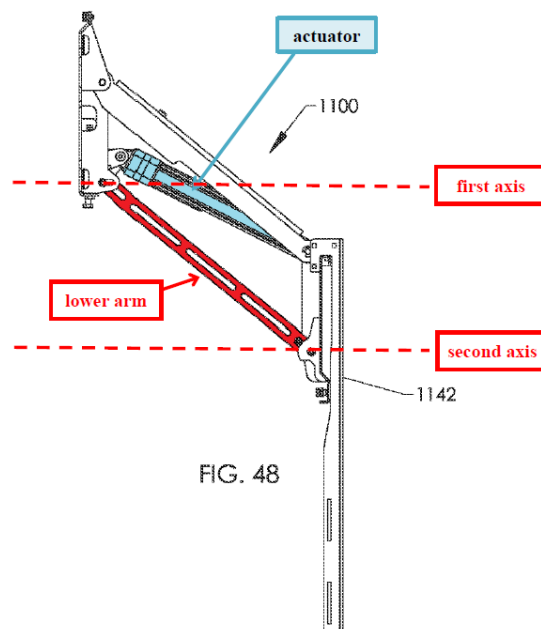
Again, the ’703 Patent discloses that the motor can be mounted to the linear actuator 1218, describes motors, and describes actuators driven by the motors. *Id.*

at 17:58-63 (“motor 1244 (FIG. 41) can include one or more drive motors, stepper motors, or the like that are mounted on the linear actuator 1218”) 21:45-47

(“actuators 2310, 2312 can extend or contract to raise, lower, tilt, or otherwise move the display bracket 2306”); *see also Id.* at 12:12 to 13:21; 17:58-65.

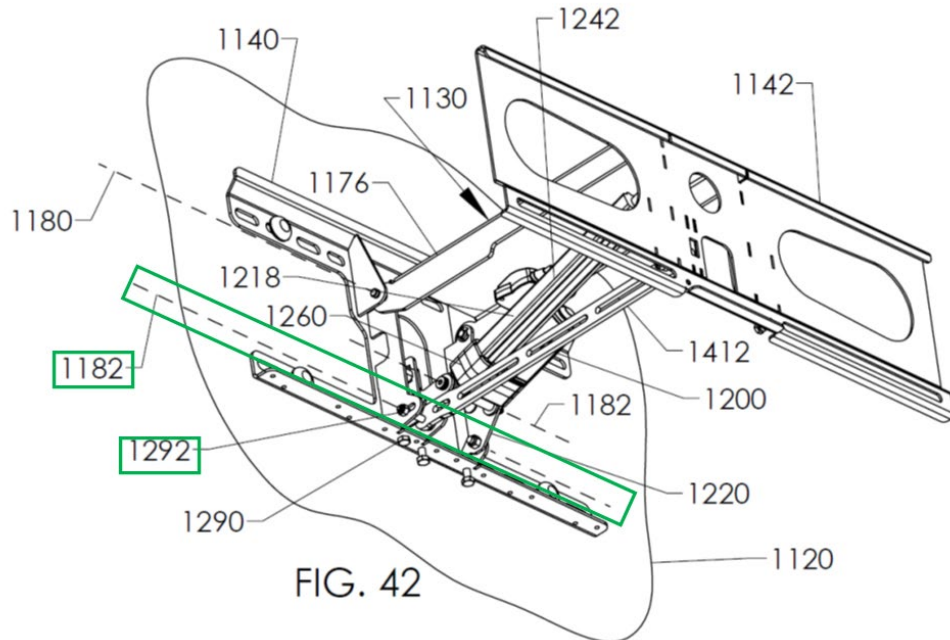
Accordingly, a POSITA would conclude that the ’703 Patent describes how an actuator can be part of the illustrated motorized actuator assembly to meet the written description requirements under 35 U.S.C. § 112. Ex. 2004 ¶¶ 36-37, 41-42.

In the Petition, Petitioner has misleadingly labeled Figure 48 the ’703 Patent as follows:

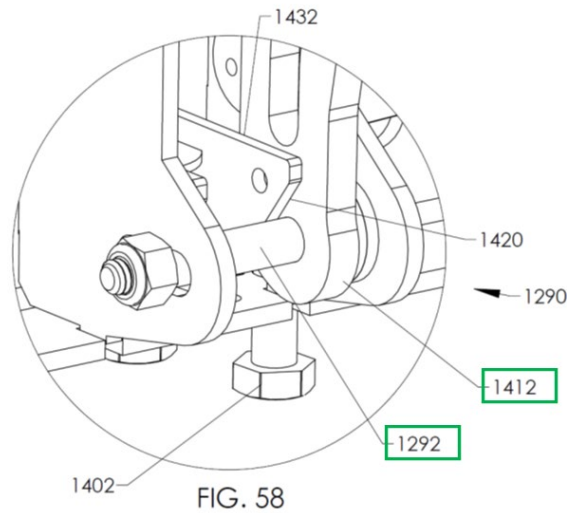


Petition at page 53 (Fig. 48 annotated by Petitioner). This labelling, however, is completely misleading and incorrect because the indicated dotted axes as drawn by the Petitioner are not oriented orthogonal to the plane of the page, which would be

the understood orientation. Ex. 2004 ¶ 40. For example, Figure 42 of the '703 Patent shows the pivot 1292 defining the example axis of rotation 1182 such that “[t]he lower link 1412 is rotatable about a lower axis of rotation 1182 defined by support pivot 1292 (FIG. 42).” Ex. 1001 at 17:45-47; Ex. 2004 ¶ 39.



Ex. 1001 Figs. 42, 51 (annotated). The '703 Patent also discloses details of pivots. For example, Figure 58 shows the pivot 1292 and a portion of the lower link 1412.



Id. Fig. 58 (annotated).

Accordingly, the Petitioner’s labelling of Figure 48 is misleading and incorrect.

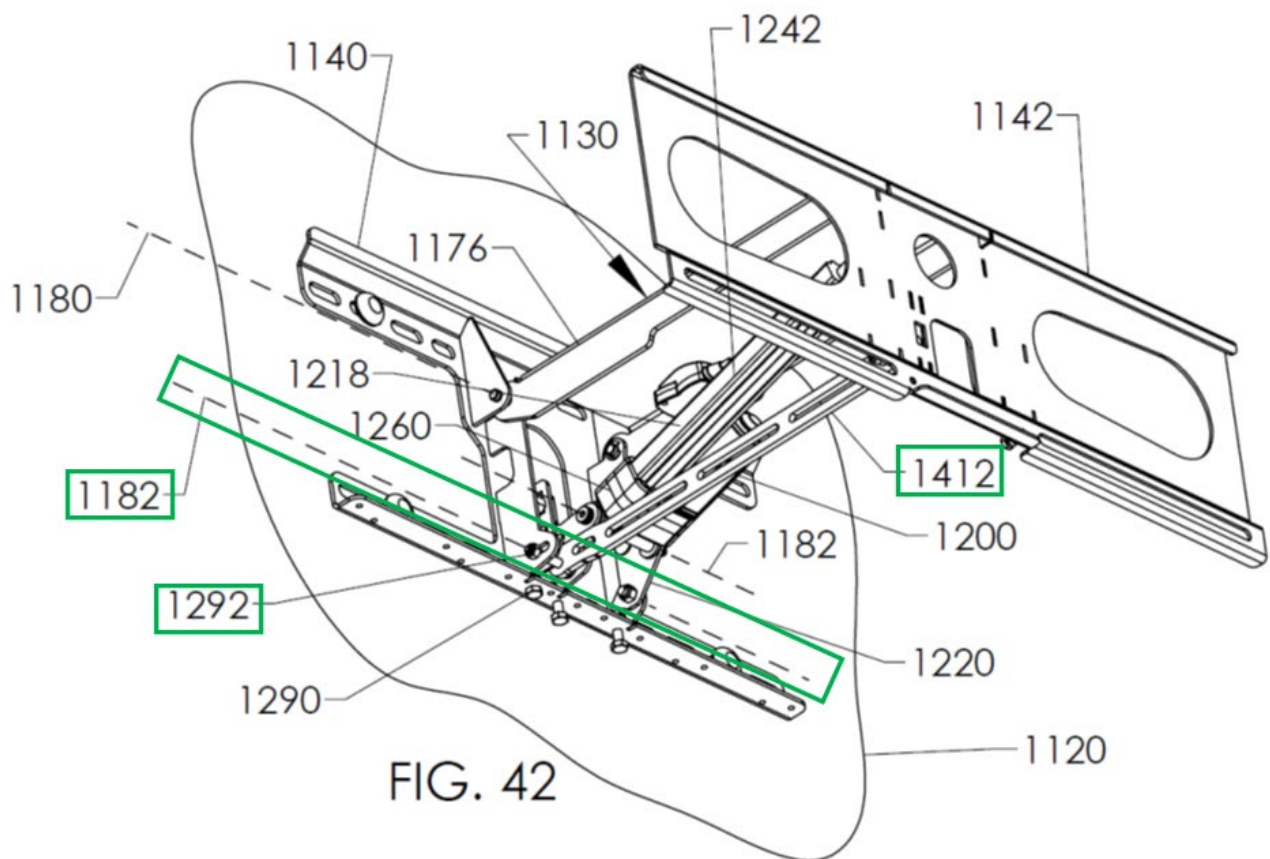
When the disclosure of the ‘703 Patent is properly considered, a POSITA would conclude that the ‘703 Patent describes the features of claim 36 to meet the written description requirements under 35 U.S.C. § 112. Ex. 2004 ¶¶ 32-43.

B. Ground 2: Petitioner Fails to Establish that Dependent Claim 36 is Indefinite

Petitioner has failed to establish that the ‘703 Patent fails to particularly point out and distinctly claim the subject matter which the named inventor regards as the invention recited in claim 36. Petitioner alleges that the limitation of the first and second axes being “spaced apart from and located below an extendable actuator of the motorized assembly when the arm assembly is in a lower configuration” recited in dependent claim 36 is indefinite because the ‘703 Patent specification purportedly fails to provide clarity for the “extendable actuator” and

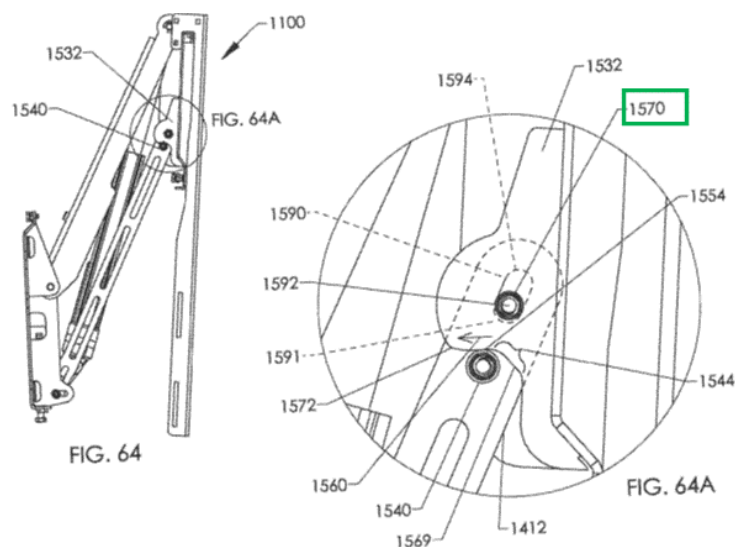
the “spaced apart and below” feature. Petition at 54-56, citing Ex. 1003 ¶¶99-100. However, as discussed below, the ’703 Patent clearly discloses these claimed aspects.

Under *Nautilus*, the claims should “inform those skilled in the art about the scope of the invention with reasonable certainty,” when “viewed in light of the specification and prosecution history.” *Nautilus, Inc. v. Biosig Instr., Inc.*, 572 U.S. 898, 910 (2014). Here, Figure 42 shows the pivot 1292 and a corresponding first axis of rotation 1182 of the lower arm, linkage 1412.



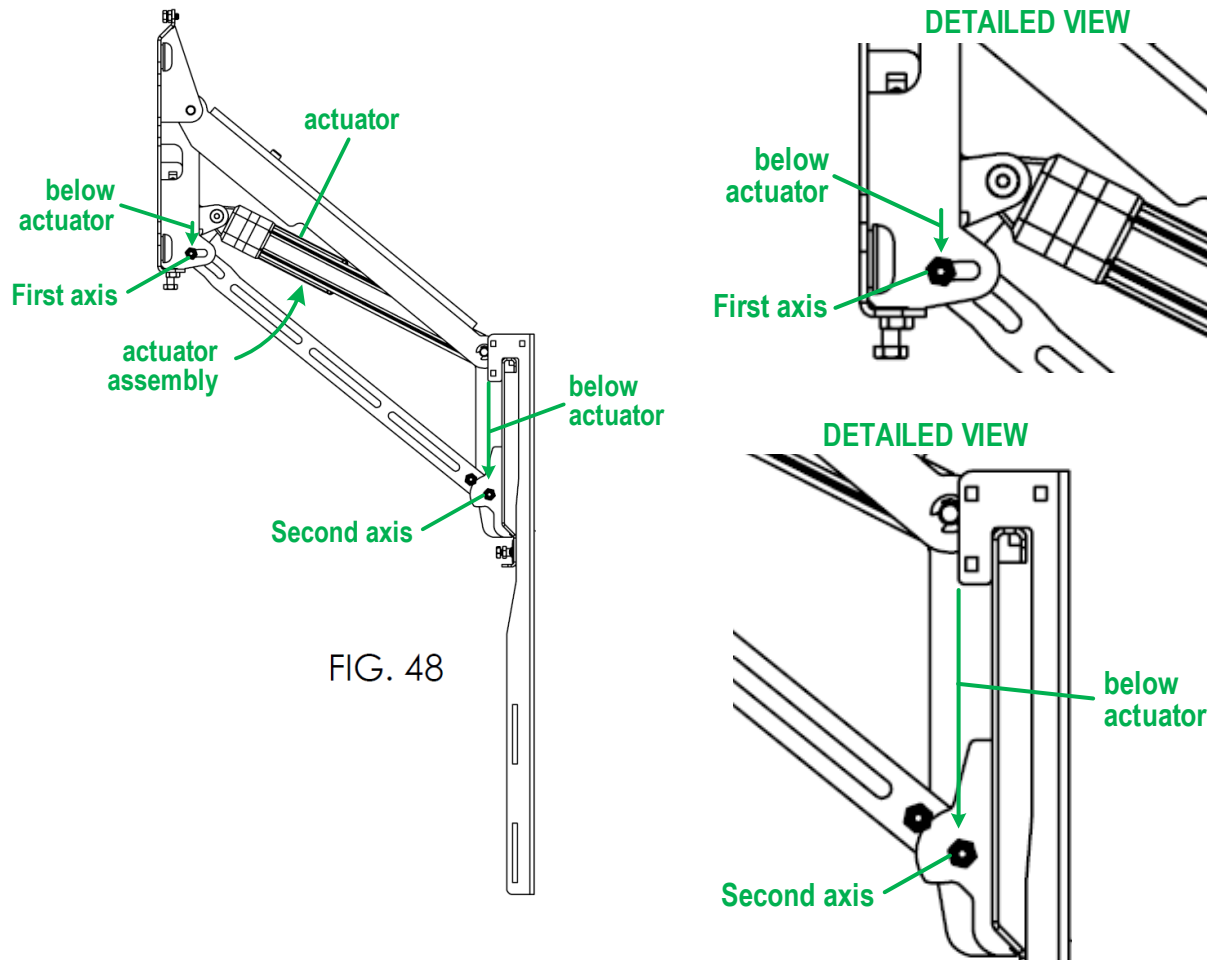
Ex. 1001 Fig. 42 (annotated); *See also* Ex. 2004 ¶¶ 38-39, 46.

Figures 64 and 64A show the pivot 1570 of the television mount 1100 defining the second axis of rotation of the television mount 1100.



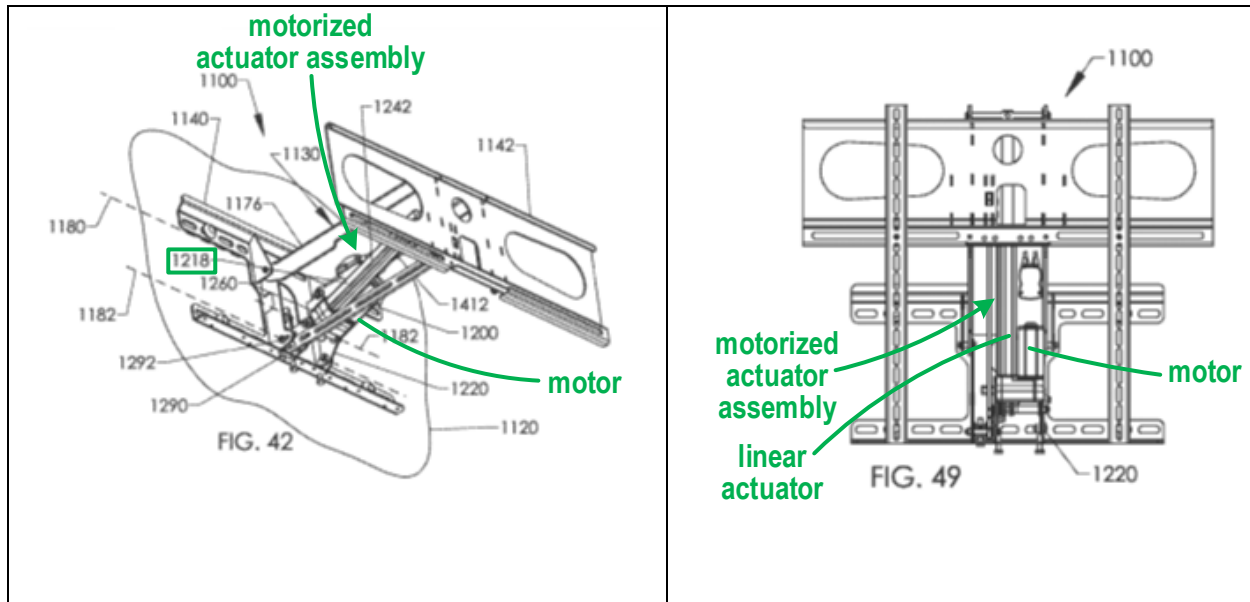
Ex. 1001 Figs. 64 and 64A (annotated); *see also* Ex. 2004 ¶¶ 38-39, 46.

Figure 48 shows an embodiment having the first axis of rotation and the second axis of rotation spaced apart from and below the linear actuator 1218.



Ex. 1001 at 48 (annotated); Ex. 2004 ¶¶ 37-39, 46. Accordingly, the '703 Patent clearly discloses first and second axes of rotation spaced apart from and located below an extendable actuator as recited in dependent claim 36.

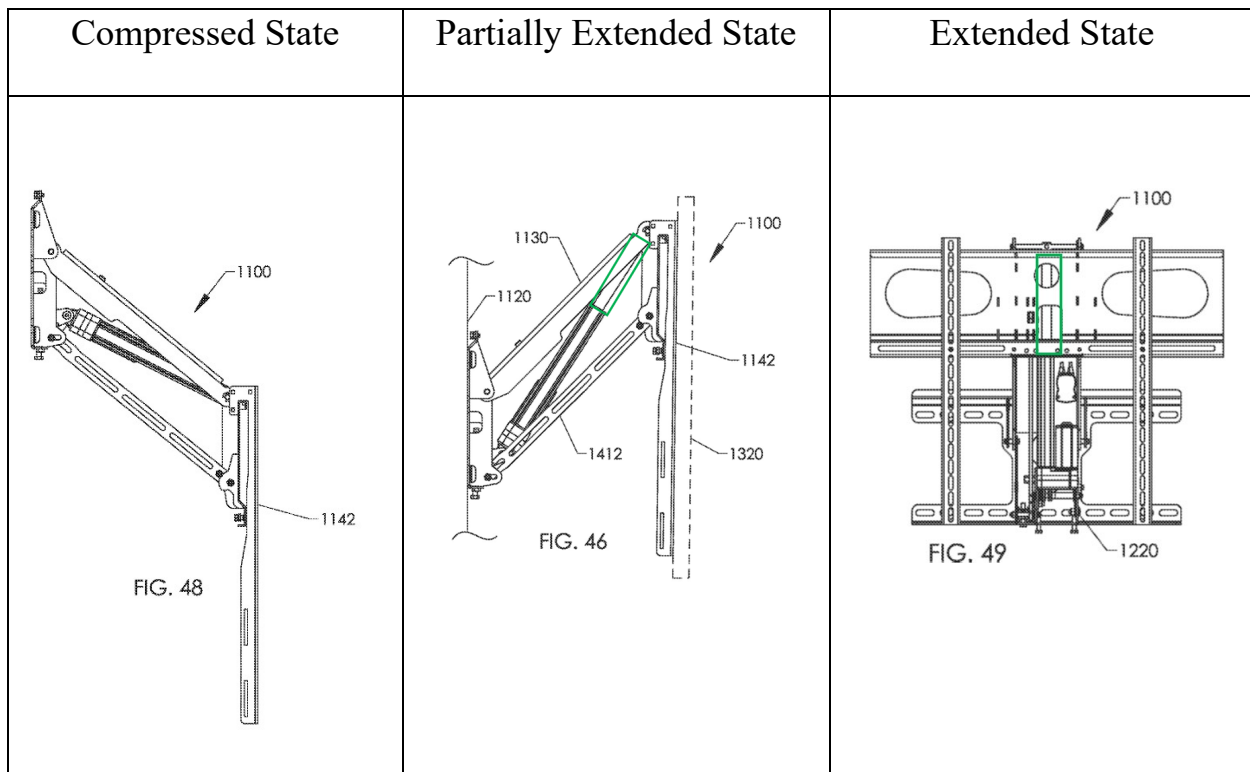
The '703 Patent describes the motorized actuator assembly of dependent claim 36. Figures 41-49 show the example motorized actuator assembly including the linear actuator 1218 and motor 1244. *See, e.g.*, Ex. 1001 at 17:59-63; *See also* Ex. 2004 ¶¶ 36-37, 46.



Ex. 1001 Figs. 42 (annotated) and 49 (annotated).

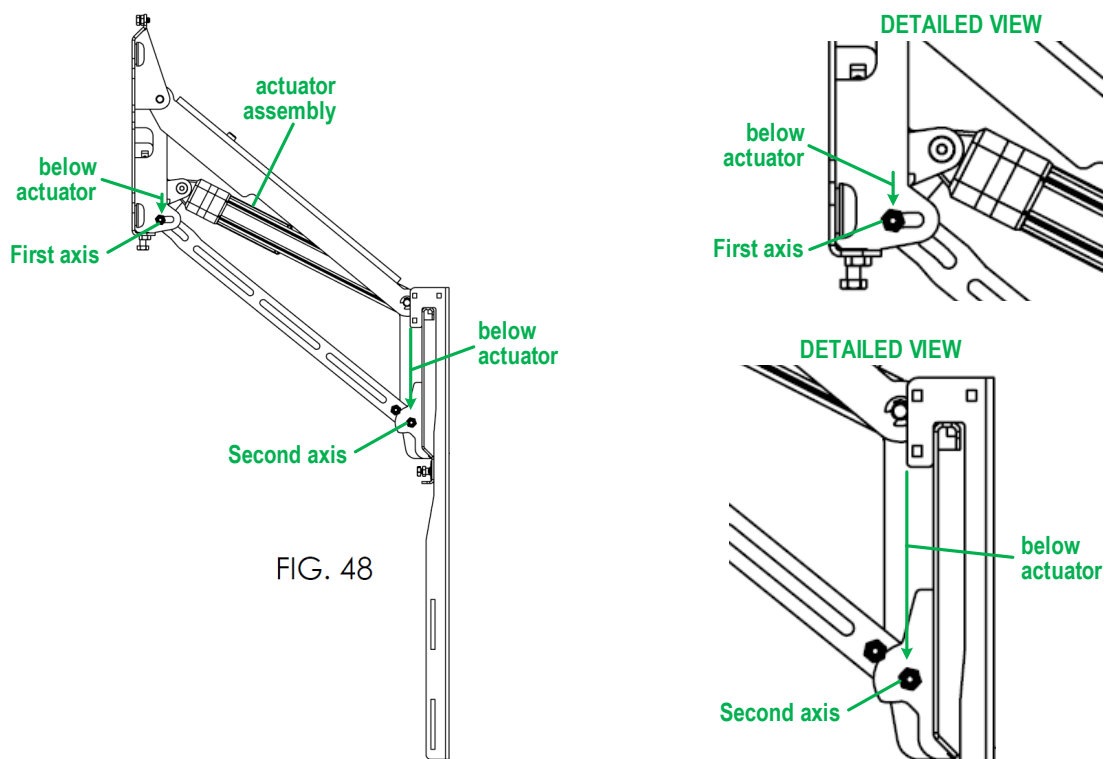
The '703 patent discloses that the motorized actuator assembly can be controlled by a control device, types of motors (e.g., drive motors, stepper motors), and how linear actuators can extend or contract to raise, lower, tilt, or otherwise move the display bracket. *Id.* at 12:12-13:21; 17:58-65 (“motor 1244 . . . can include one or more drive motors, stepper motors, or the like that are mounted on the linear actuator 1218”); 21:45-47 (“The actuators 2310, 2312 can extend or contract to raise, lower, tilt, or otherwise move the display bracket 2306.”). Ex. 2004 ¶¶ 36-37, 46. Accordingly, the ‘703 patent discloses how the motorized actuator assembly is connected to the arm assembly, components of the motorized actuator assembly, and operation of the motorized actuator assembly, thus meeting the definiteness requirement under 35 U.S.C. § 112. *See also* Ex. 2004 ¶¶ 35-39, 42, 46.

Petitioner fails to establish that it is more likely than not that the definiteness requirement of “extendable actuator” has not been met. Again, Figures 43-48 and 60-62 show extendable linear actuator 1218 in a compressed state in Figure 48, a partially extended state in Figure 45, and an extended state of Figure 49, as shown below.



Ex. 1001 Figs. 48, 46, and 49 (annotated to identify extended portion); Ex. 2004 ¶¶ 42, 46. The ‘703 patent also shows and describes numerous extendable actuators, such as motorized actuator 730 of Figure 28, linear actuator 1218 of Figure 42, and actuators 2310, 2320 of Figure 71. Accordingly, the ‘703 patent meets the definiteness requirement for the “extendable actuator” of claim 36 under 35 U.S.C. § 112. Ex. 2004 ¶¶ 41-42, 46.

Petitioner fails to establish that it is more likely than not that the definiteness requirement of “spaced apart and below” of claim 36 is not met. Figure 48 shows an embodiment having the first axis of rotation and the second axis of rotation spaced apart and below the linear actuator 1218.



Ex. 1001 Figs. 48 (annotated and with enlarged detailed views); *see also id.* Fig. 62; Ex. 2004 ¶¶ 38-39, 46.

Accordingly, the '703 patent discloses positioning axes of rotation spaced apart and below actuators and meets the definiteness requirement under 35 U.S.C. § 112 for these features. *See also* Ex. 2004 ¶¶ 44-47.

C. Ground 3: Petitioner Fails to Establish that Clary Anticipates Claims 33-36

The Petition fails to establish that it is more likely than not that Clary anticipates challenged claims 33-36 for at least the following reasons.

1. Clary was Already Considered by the Patent Office During Prosecution

Clary and Clary Patent are both listed on the face of the '703 Patent. Ex. 1001 at page 2, Section References Cited. (Clary Patent issued from US App. No. 12/078,082, which published as Clary now relied upon by Petitioner.) During prosecution of the '703 application, the Examiner signed and initialed the applicant's Information Disclosure Statement (and did not draw a line through the Clary or Clary Patent) indicating that he considered both Clary and Clary Patent. Ex. 2001, pages 17, 19, 22. The IDS form the examiner initialed specifically instructs "EXAMINER: Initial if reference considered.... Draw line through citation if not in conformance and not considered." *Id.* at page 22. Thus, Clary and Clary Patent were "considered" by the examiner during prosecution, and Petitioner's use of Clary is redundant and cumulative over the existing record.

The prosecution record of the '703 patent family further bolsters Patent Owner's contention that the Patent Office was well aware of the Clary reference and had substantively considered the teachings of Clary. Notably, the same examiner examined both the '703 Patent and parent patent 11,460,145 ('145

Patent) and allowed limitations in the '145 Patent similar to the limitations at issue of presently challenged claim 33 after discussing the Clary reference on the record. In particular, during prosecution of parent '551 application that led to the '145 Patent, Examiner (1) applied Clary Patent and a secondary reference against claims 64-82, (2) allowed claims 56 and 58-63, and (3) stated dependent claim 68 was directed to allowable subject matter. Exhibit 2002 at 20 and 25. The Examiner stated that **“Clary does not disclose a motorized actuator coupled to a linkage assembly.”** Ex. 2002 at page 20 (emphasis added). The Examiner ultimately found that a POSITA would not be motivated to modify the mount of Clary to both (1) couple the motorized actuator to a linkage assembly and (2) have “at least a portion of the motorized actuator assembly extend[ing] outwardly past the lower arm in a direction toward the display bracket when the linkage assembly moves toward the raised configuration to collapse the television mounting system,” as recited in allowed claim 56 of the parent '551 application. Ex. 2002; pages 10-11. Accordingly, the USPTO already found that Clary failed to disclose features that the Petitioner now alleges Clary discloses.

2. Clary Fails to Disclose a Motorized Actuator Assembly having a Display Bracket End Rotatably Coupled to an Arm Assembly

Independent claim 33 recites “a motorized actuator assembly having a support bracket end rotatably coupled to the support bracket and a display bracket

end rotatably coupled to the arm assembly.” In contrast, Clary discloses a display mount with a first frame assembly 1 secured to a wall, a second frame assembly 3 connected to a flat panel display 4, and links 5, 6 between the first and second frames 1, 3. Ex. 1004 at paragraphs [0012], [0015].

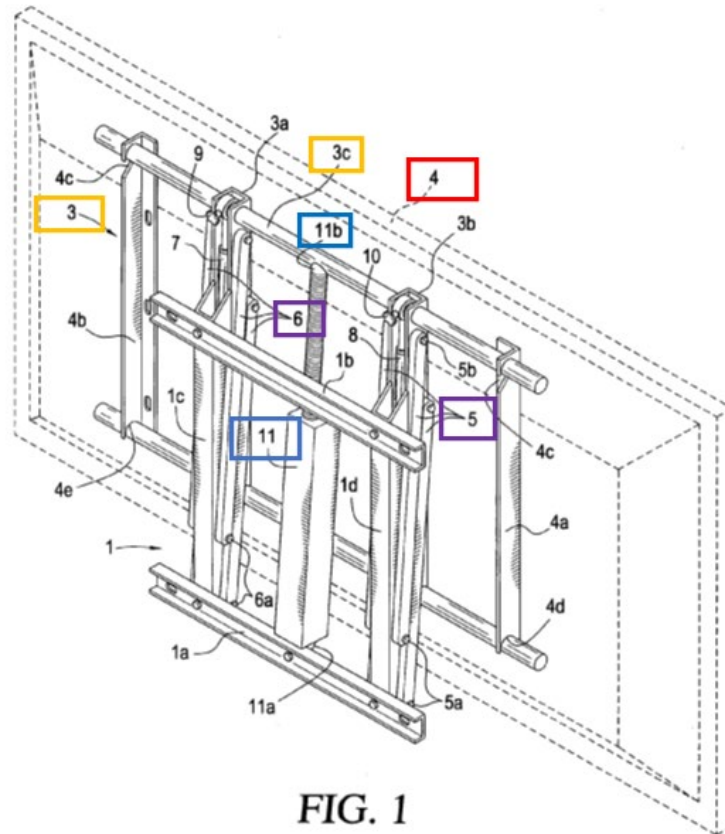


FIG. 1

Id. at Figure 1 (annotated). Clary discloses that the second frame assembly 3 holds the flat panel display 4 and “comprises” an “upper tube 3c.” Ex. 1004 at paragraph [0014]; Fig. 1. The Petitioner maps the arm assembly of claim 33 to the links 5, 6. As shown in Figure 1 of Clary, an actuator 11 has an end 11b connected to a tube 3c of the second frame assembly 3, **not** links 5, 6 of the “arm assembly.” Ex. 1004

at paragraph [0017]. Accordingly, Clary fails to disclose a motorized actuator assembly having a display bracket end rotatably coupled to an arm assembly. This is consistent with the USPTO’s finding that “Clary does not disclose a motorized actuator coupled to a linkage assembly” as stated by the Examiner in the parent ’551 application, as discussed above. Ex. 2002 at page 20. In conclusion, Clary fails to disclose “a motorized actuator assembly having . . . a display bracket end rotatably coupled to the arm assembly” as recited in independent claim 33.

(i) Petitioner’s Mapping of Claim Elements Contradicts Teaching of Clary

Petitioner attempts to map the motorized actuator as recited in independent claim 33 onto both the actuator 11 and tube 3c of Clary. To do this, Petitioner first maps the “display bracket configured to hold a television” of claim 33 to the second frame assembly 3 of Clary:

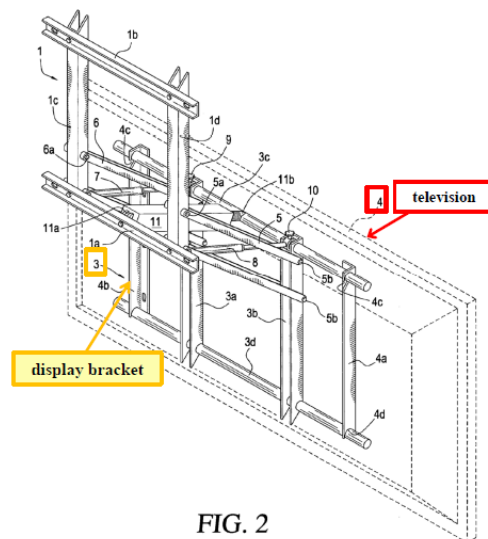
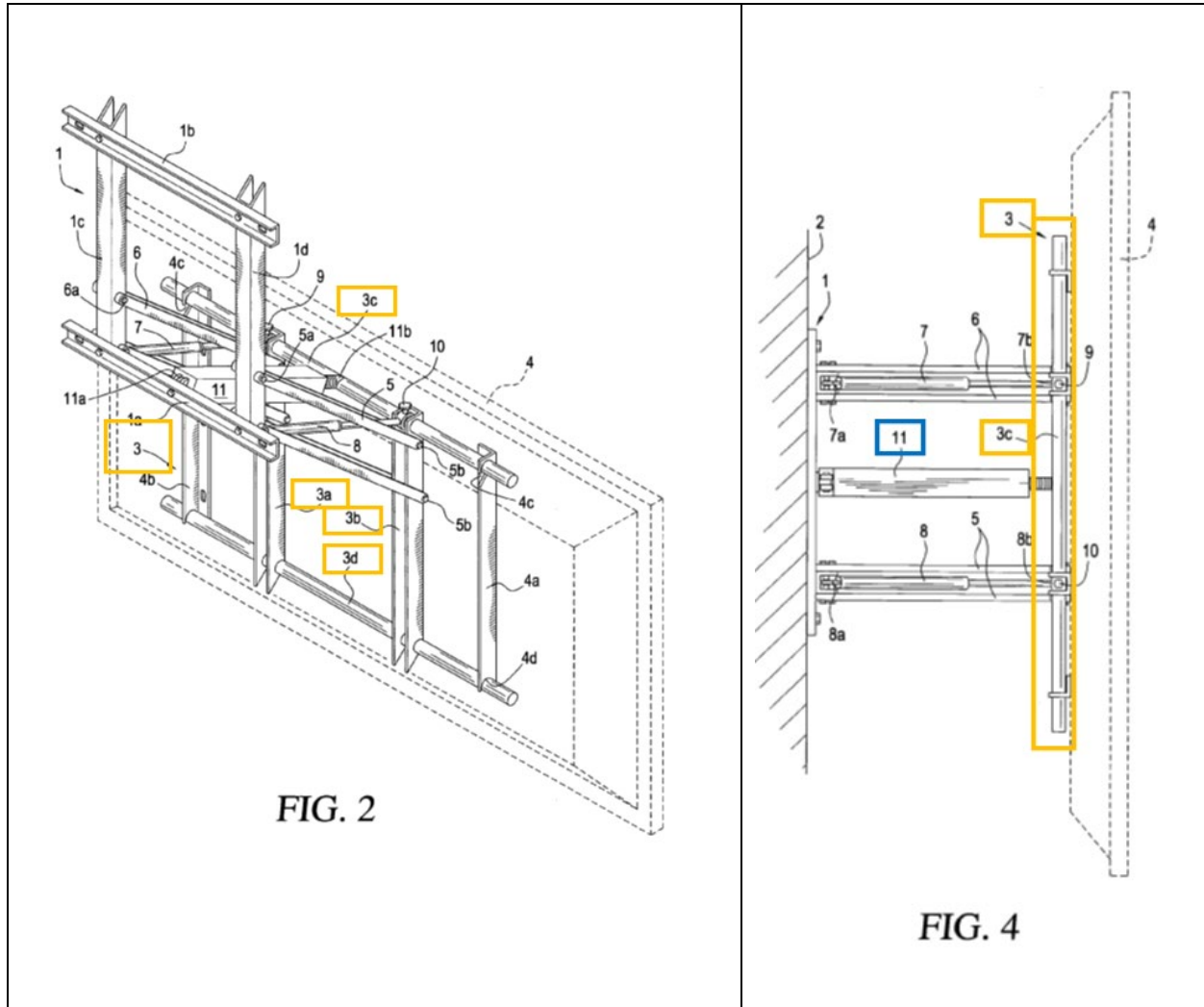


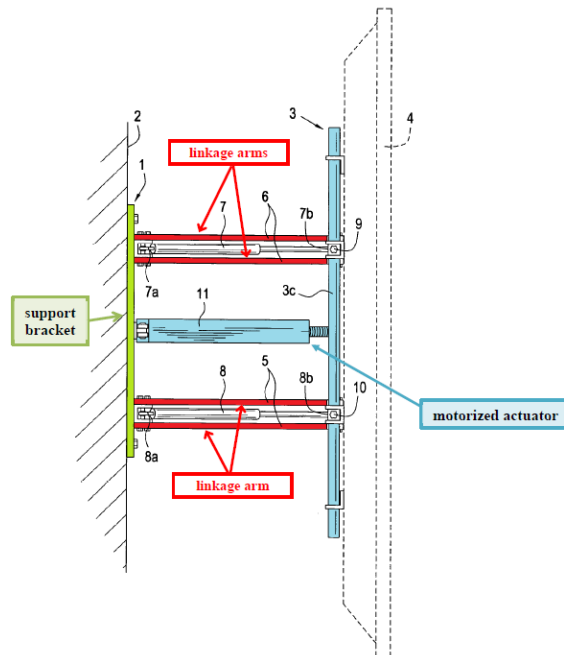
FIG. 2

Petition at 62 (Figure 2 of Clary as annotated by Petitioner). Figures 2 and 4 of Clary show features of the second frame assembly 3 annotated below:



Id. Figs. 2, 4 (annotated). Clary specifically teaches that the tube 3c is part of the display-holding second frame assembly 3.

After mapping the display bracket of claim 33 to the second frame assembly 3 of Clary, the Petitioner then alleges that the tube 3c of the second frame assembly 3 should now be considered part of the “motorized actuator” as shown in Petitioner labelled Figure 4 of Clary below.



Petition at 71 (Figure 4 of Clary as annotated by Petitioner). However, such a mapping is incorrect and contradicts the teachings of Clary and common sense. A POSITA would understand that the actuator 11 and tube 3c are not a “motorized actuator” as asserted by the Petitioner because Clary states that the tube 3c is part of the second frame assembly 3. Ex. 1004 at [0014] (“The second frame assembly 3 comprises . . . vertically spaced tubes 3c, 3d”); Ex. 2004 ¶¶ 48-49. Accordingly, the Petitioner’s mapping of a motorized actuator onto both the actuator 11 and tube 3c is contrary to the disclosure of Clary.

Additionally, a POSITA would recognize that the second frame assembly 3 without the tube 3c would not be “a display bracket configured to hold a television” as recited in claim 33. Ex. 2004 ¶¶ 50-51. This is because the second

frame assembly 3 relies on the tube 3c connecting the angle irons 4a, 4b to the channels 3a, 3b, and thus part of a display bracket configured to hold a television. Ex. 1004 at [0014]; Ex. 2004 ¶¶ 50-51. Indeed, the Petitioner has failed to explain, absent the tube 3c, how the second frame assembly 3 can hold a television. Accordingly, the Petitioner's mapping of claim elements contradicts teachings of Clary and does not support anticipation of claim 33.

3. Clary Fails to Anticipate Dependent Claims 34-36

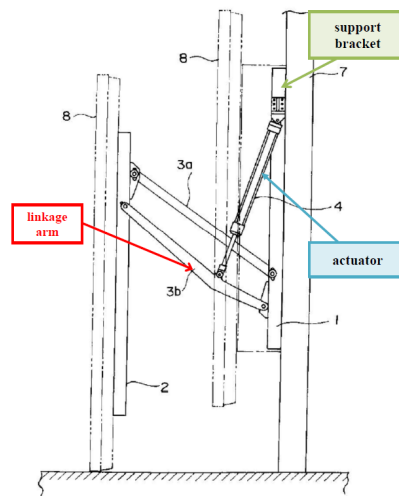
Claims 34-36 depend directly or indirectly from claim 33 and are patentable over Clary for at least the reasons that base claim 33 is patentable as discussed above, and for the additional features of these claims.

D. Ground 4: Petitioner Fails to Establish that Clary in View of Tsuji and the General Knowledge Renders Claims 33-36 Obvious

The Petition fails to establish that Clary in view of Tsuji and the general knowledge render claims 33-36 obvious for at least the following reasons.

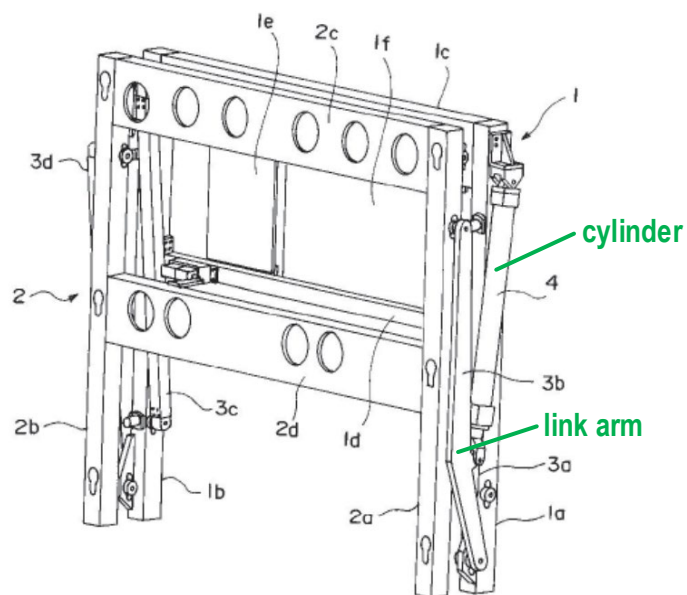
The Petitioner states that it would be obvious to use the hydraulic cylinder 4 of Tsuji shown below to modify Clary.

[Fig. 4]



Petition at 95 (Fig. 4 annotated by Petitioner). However, Tsuji discloses the hydraulic cylinder 4 is positioned **behind** a link arm 3b when the support device is closed, as shown below.

[Fig. 2]



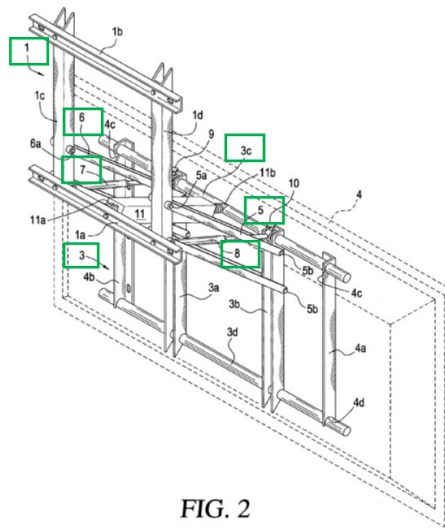
Ex. 1015 Fig. 2 (annotated). A POSITA would not be motivated to modify Clary based on Tsuji to arrive at claims 33-36 because coupling Clary's actuator 11 to link 5 or 6 of Clary in a manner similar to Tsuji's hydraulic cylinder 4 (i.e., extending upward from a lower arm to an upper end of a frame 1) would place the actuator 11 in the same plane of motion as the lower arm link, resulting in the link blocking the actuator from passing, and vice versa, when moving the arm assembly toward a raised position. Ex. 2004 ¶¶ 52-54. A POSITA would recognize that this would prevent the flat panel display screen from being "positioned flat against the wall frame 1" as shown in Figure 3 of Clary. *Id.*; see Ex. 1004, [0018].

A POSITA would also recognize that the pivoting links 5 or 6 are designed for tensile loading such that coupling Clary's actuator 11 to links 5 or 6 in a manner similar to Tsuji's hydraulic cylinder 4 would cause those links to experience moments significantly different from the intended tensile loads. Ex. 2004 ¶¶ 55-58. A POSITA would not be motivated to modify the Clary mount to experience moments significantly different from the intended tensile loads for which the links 5 and 6 are designed. Accordingly, the Petitioner has failed to establish that a POSITA would be motivated to modify Clary to arrive at claims 33-36.

Assuming *arguendo* that the Clary actuator 11 is coupled to the links 5 or 6 of Clary in a manner similar to Tsuji (i.e., extending upwardly from a lower arm to

an upper end of a frame 1), a POSITA would recognize that the modified Clary mount would not have at least a portion of a motorized actuator assembly that moves toward and past a portion of a lower arm when the arm assembly moves toward a raised configuration as recited in independent claim 33. Ex. 2004 ¶¶ 52-54. Once again, Tsuji relies on the hydraulic cylinder 4 being positioned behind the lower link and the modified Clary mount would include the claimed features. Accordingly, the Petitioner has failed to establish that the modified Clary mount would include the features of claims 33-36.

A POSITA would not be motivated based on Tsuji and general knowledge of a POSITA to modify the Clary mount to arrive at claims 33-36 because Clary teaches that the pneumatic springs 7, 8 shown below connect between a first frame 1 and a second frame 3 and “provide an offsetting force to the gravitational downward pull by the weight of the flat panel display 4 ...” Ex. 1004, [0016].



Ex. 1004, Fig. 2 (annotated). The illustrated pneumatic springs 7, 8 connect to the upper tube 3c of the second frame 3. Clary also teaches that the links 5, 6 provide mobility, describing the travel of the display from a raised position flat against the wall to an extended position the full length of the linkage arms to a lowered position flat against the wall frame. Ex. 1004, [0018]. A POSITA would recognize that coupling Clary's actuator 11 to the link 5 or 6 in a manner similar to Tsuji's hydraulic cylinder 4 would change that link to be a primary load bearing component, thus fundamentally changing how the Clary mount is designed to bear loads and creating significant design challenges. Ex. 2004 ¶ 57. In conclusion, Petitioner merely asserts conclusory statements of invalidity based on Clary and Tsuji, ignores real-world problems that could be encountered by a POSITA, ignores missing features from the proposed combination of art, and then fails to establish why a person of ordinary skill in the art would have found it obvious to combine the Clary and Tsuji in view of those problems, or how those combinations would have worked to arrive at claims 33-36.

Petitioner also points to Juan, which fails to cure the deficiencies of Clary and Tsuji. For example, Juan fails to disclose a motorized actuator assembly having a support bracket end rotatably coupled to a support bracket as recited in independent claim 33. In contrast, Juan discloses a linear actuator 810, shown in

Figure 8 below and annotated by Petitioner, connected to a four-bar linkage and a **front** mount 604. See Petition at 96; Ex. 1005 at paragraph [0066].

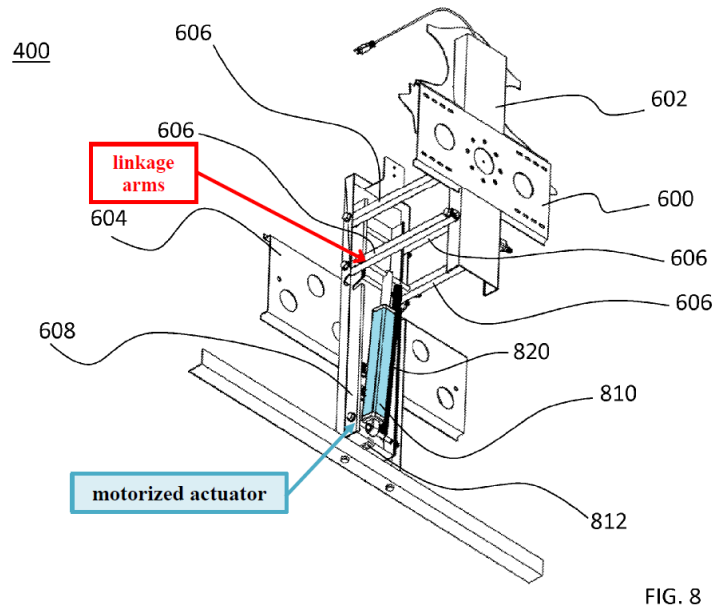


Figure 8 of Juan Annotated by Petitioner

Accordingly, Juan does not disclose or suggest deficiencies of Clary and Tsuji.

The Petition also summarily contends that “it would have been obvious for a POSITA to modify Clary such that the actuator assembly is directly coupled to an arm of the arm assembly.” Petition at 94. Once again, a POSITA would not be motivated to modify the Clary mount to experience moments significantly different from the intended tensile loads for which the links 5 and 6 are designed. Ex. 2004 ¶¶ 55-57. Accordingly, claims 33-36 are non-obvious over Clary in view of Tsuji and the general knowledge render because a POSITA would not modify the art to arrive at claims 33-36.

E. Ground 5: Petitioner Fails to Establish that Pankros Anticipates Claims 33-36

The Petition fails to establish that it is more likely than not that Pankros anticipates claims 33-36 for at least the following reasons.¹

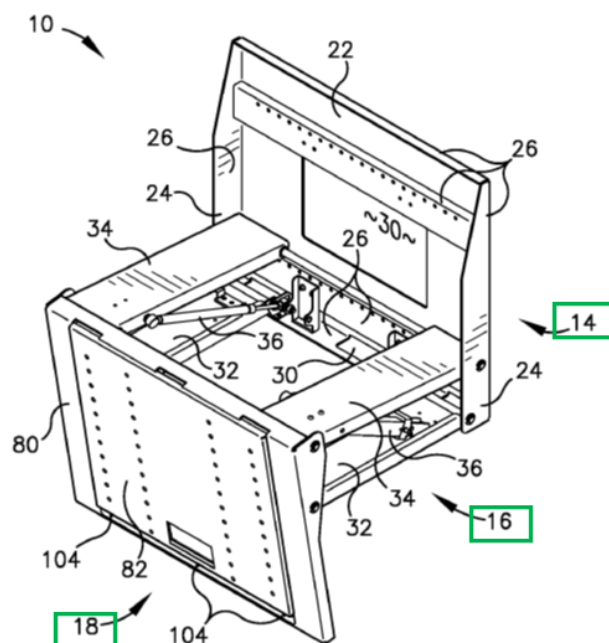
1. Independent Claim 33: Pankros Fails to Disclose a Motorized Actuator Assembly that Moves Toward and Past a Portion of a Lower Arm When An Arm Assembly Moves Toward a Raised Configuration

Pankros fails to disclose all the limitations of independent claim 33. Claim 33 recites, in part:

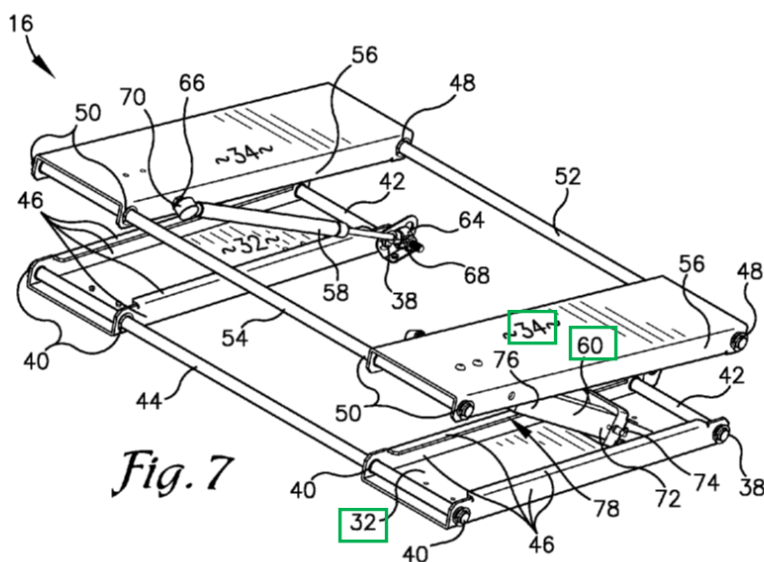
a motorized actuator assembly having a support bracket end rotatably coupled to the support bracket . . . wherein at least a portion of the motorized actuator assembly moves toward and past a portion of the lower arm when the arm assembly moves toward the raised configuration.

Figure 2 of Pankros shows a display mounting apparatus 10 including a wall mount 14, a support mechanism 16, and a display support 18. Ex. 1006, paragraph [0041].

¹ Pankros was “considered” by the USPTO during prosecution as it is listed at page 2, Section References Cited of the ’703 Patent.



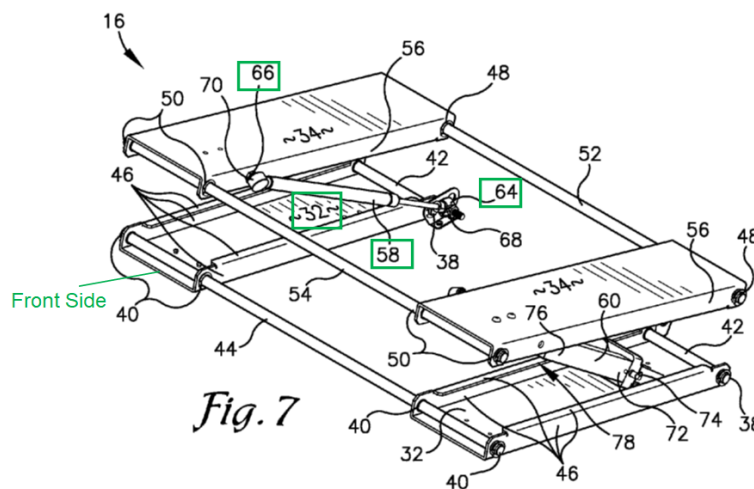
Id. Fig. 2 (annotated). Figure 7 of Pankros below shows the support mechanism 16, a weight balancing device 58 connected to an upper support arm 34, and an actuator 60 connected to lower and upper support arms 32, 34. *Id.* paragraphs [0051], [0052] and [0055].



Id. Fig. 7 (annotated). Neither the balancing device 58 nor the actuator 60 moves toward and **past** a portion of a lower arm, as detailed below.

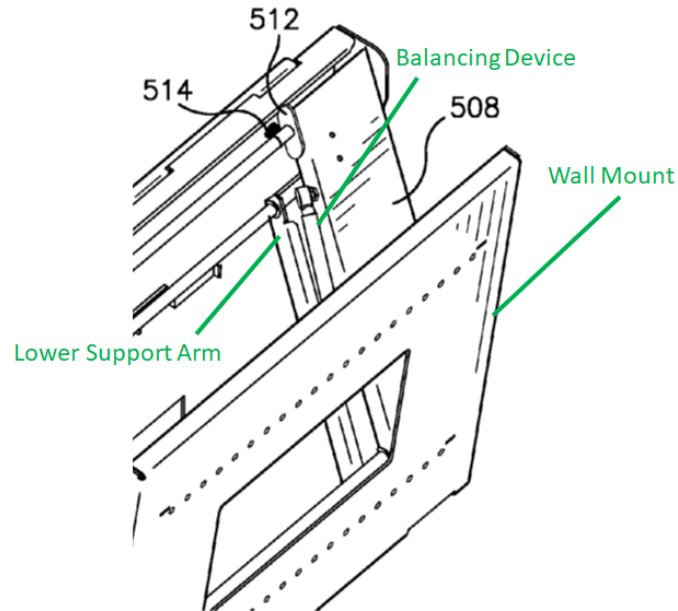
(a) Balancing Device 58 of Pankros

The balancing device 58 of Pankros is connected to a first attached point 64 and a second attachment point 66 along the upper support arm 34 such that the balancing device 58 is positioned above a front side of the lowered lower support arm 32, as shown below in the annotated Figure 7. See *id.* paragraphs [0041], [0050], [0052].

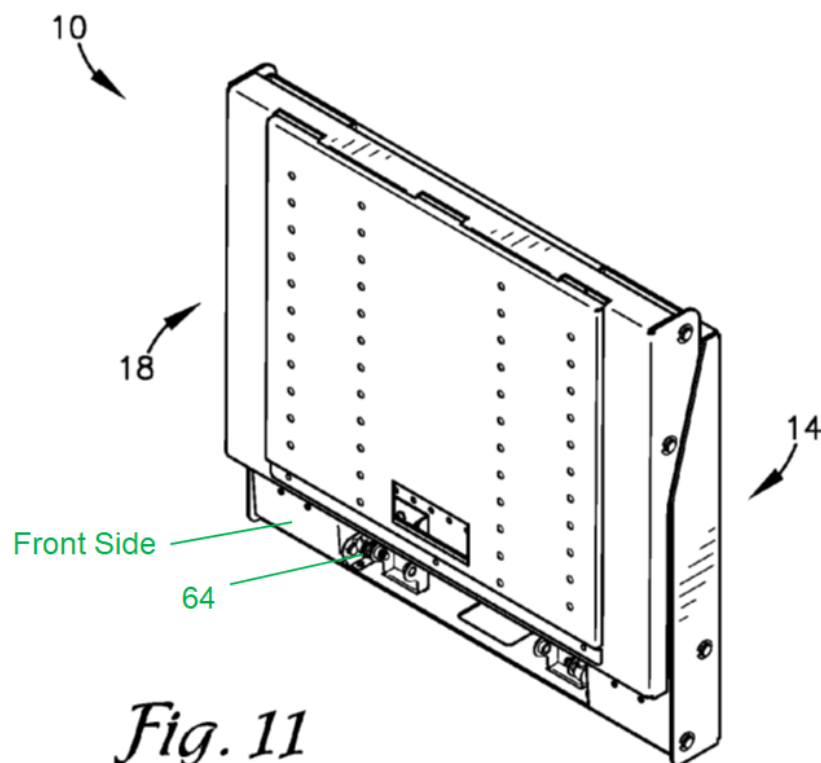


Id. Fig. 7 (annotated).

Figure 7 illustrates the lower and upper support arms 32, 34 with generally U-shaped channels, as shown above. Figure 19 (portion reproduced below) of Pankros shows how balancing device 58 remains **behind** the front side of the lower support arm 32 when the display mounting apparatus 10 is in an almost fully retracted position:



Id. Fig. 19 (annotated). Figure 11 of Pankros shows the display mounting apparatus 10 in fully retracted position and the attachment point 64 positioned rearwardly of the front side of the lower arm 32.



Id. Fig. 11 (annotated). Figure 11 of Pankros fails to disclose at least a portion of the balancing device 58 moves toward and past a portion of the lower support arm 32. Accordingly, Pankros fails to disclose at least a portion of the balancing device 58 moves toward and past a portion of a lower arm when an arm assembly moves toward a raised configuration as recited in claim 33.

In addition to the Petitioner failing to establish that Pankros explicitly discloses at least a portion of the balancing device 58 moves toward and past a portion of the lower support arm 32, the Petitioner has failed to conduct an inherency analysis. Pankros fails to inherently disclose that the weight balancing device 58, whether in the form of a linear actuator or another component,

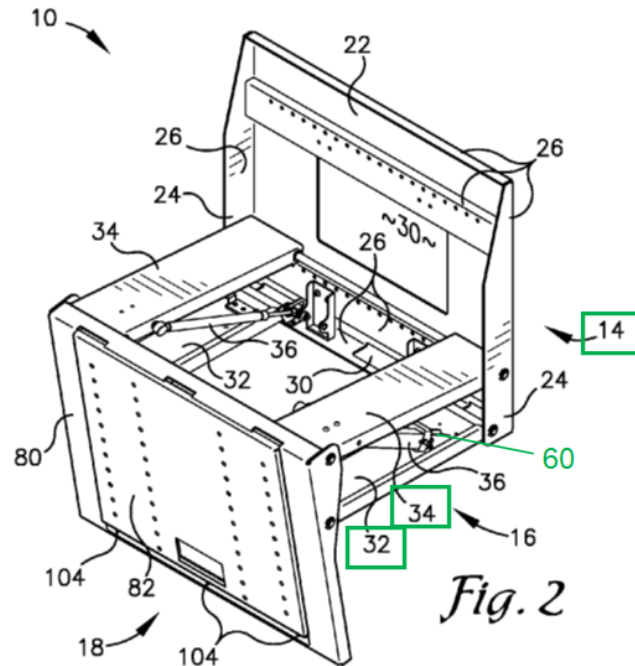
necessarily moves toward and past a portion of a lower arm when an arm assembly moves toward a raised configuration. To the contrary, a POSITA would recognize that the weight balancing device 58 of Pankros extends upwardly and rearwardly from the attachment point 64 to the attachment point 66 along the upper support arm 34 when the display mounting apparatus 10 is in the fully retracted position such that weight balancing device 58 would **not** move toward and past a portion of the lower support arm 32. Ex. 2004 ¶¶ 59-61. Accordingly, Pankros fails to disclose explicitly or inherently that at least a portion of the balancing device 58 moves toward and past a portion of the lower support arm 32.

(b) Actuator 60 of Pankros

Pankros fails to disclose that at least a portion of the actuator 60 “**moves toward and past a portion** of the lower arm when the arm assembly moves toward the raised configuration” as recited in independent claim 33. In contrast, the front wall of the lower support arm 32 prevents the actuator 60 from moving past the lower support arm 32. A POSITA would understand that the actuator 60 would be positioned along the illustrated channels of the upper and lower arms 32, 34 when the display mounting apparatus 10 is in the retracted position. Ex. 2004 ¶¶ 59-61.

Claim 33 also recites the “motorized actuator assembly having a support bracket end rotatably coupled to the support bracket.” As shown in Figure 2 of

Pankros, the actuator 60 of Pankros is coupled to arms 32, 34, **not** the wall mount 14.



Id. Fig. 2 (annotated). Accordingly, Pankros fails to disclose both (1) the actuator 60 has a support bracket end rotatably coupled to a support bracket and (2) at least a portion of the actuator 60 moves toward and past a portion of the lower arm when the arm assembly moves toward the raised configuration.

The Petition summarily contends that the Pankros “figures illustrate the movement of the arm assembly and the actuator assemblies from the lower configuration (Fig. 13) to the raised configuration (Fig. 11).” Petition, page 130. Once again, the Petitioner fails to point to any features of the balancing device 58

or the actuator 60 that have moved past a lower arm. Accordingly, the Petitioner has failed to establish that Pankros teaches or suggest the limitations of claim 33.

2. Pankros Does not Anticipate Dependent Claims 34-36

Claims 34-36 depend from claim 33 and are patentable over Pankros for at least the reasons that base claim 33 is patentable as discussed above, and for the additional features of these claims. Patent Owner reserves the right to raise additional arguments as to these claims in the event that the Petition is not denied.

F. Ground 6: Pankros in View of Clary and General Knowledge of a POSITA Fail to Render Obvious Claims 33-36

The Petitioner relies on art that, whether considered alone or in combination, fails to disclose the features claims 33-36. Both Pankros and Clary were already considered by the USPTO, as discussed for Grounds 3 and 5, and both Pankros and Clary fail to disclose “at least a portion of the motorized actuator assembly [rotatably coupled to the arm assembly and a support bracket] that moves toward and past a portion of the lower arm when the arm assembly moves toward the raised configuration” as recited in claim 33. Pankros and Clary, whether considered alone or in combination, also fail to disclose the features dependent claims 34-36.

The Petitioner states that “[m]odifying Pankros’ actuator 60 such that the actuator assembly directly couples to the support bracket . . . provides a

configuration in which a portion of the motorized actuator assembly still gets closer to and past a portion of the lower arm when the arm assembly moves toward the raised configuration.” Petition at 147. As discussed above, the actuator 60 of Pankros is positioned along the illustrated U-shaped channels of the lower arm 32 and upper arm 34 when the display mounting apparatus 10 is in the fully retracted position. The front wall of the lower support arm 32 prevents the actuator 60 from moving past the lower support arm 32, so the actuator 60 would not move toward and past a portion of a lower arm when an arm assembly moves toward a raised configuration as recited in claim 33. Ex. 2004 ¶¶ 59-60. Accordingly, the Petitioner’s asserted modified display mounting apparatus 10 fails to include all the features recited in claim 33.

In addition, Petitioner asserts general knowledge and proposes a laundry list of high-level modifications to the balancing devices 58 and actuator 60 based on Clary and general knowledge that improperly disregards the design of the support mechanism 16 and lower and upper arms 32, 34 and Pankros positions of the weight balancing devices 58 and the actuator 60. For example, a POSITA would not be motivated to replace a weight balancing device 58 with an actuator 60 because Pankros teaches that the “weight balancing device 58 exerts a force on the support mechanism that substantially offsets a force of gravity exerted on the display support 18 by a flat panel display 12.” Ex. 1006, [0058]. Pankros further

teaches that “because the weight balancing device 58 supports the weight of the display 12, the actuator is operable to change the position of the display mounting apparatus 10 using only a minimal amount of force.” *Id.* [0067]. A POSITA would recognize that replacing a weight balancing device 58 with an actuator 60 would increase the amount of force required from the actuator to move the display mount. Ex. 2004 ¶¶ 62-64. This increased force requirement is contrary to Pankros disclosing using a minimal amount of force from the actuator. *Id.*

Pankros also teaches that display mount motion to include “accelerate to a faster speed” or “decelerate to a slow speed” as a motion-controlled subsystem 112 is directed to extend or retract, respectively, the actuator 60. Ex. 1006, [0067]. Pankros discloses the importance of moving slowly when at a substantially vertical position near the wall. *Id.* A POSITA would recognize that replacing a weight balancing device 58 with an actuator 60 would increase the amount of force required from the actuator and impair the ability of the actuator to respond in a timely manner to the motion-control subsystem so to control accelerations and decelerations of the display mount motion. Ex. 2004 ¶¶ 62-64.

Accordingly, the Petitioner has failed establish that a POSITA would disregard the design of the Pankros components and be motivated to perform the those proposed modifications, much less motivated to perform modifications to arrive at claim 33.

Patent Owner does not address all the various potential combinations of art and alleged general knowledge this Preliminary Response because Petitioner has not shown numerous limitations in the art. Patent Owner reserves the address additional grounds of validity should the Board institute trial.

VI. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY THE PETITION.

The Board may deny institution under 35 U.S.C. §325(d) when a petition presents “the same or substantially the same prior art or arguments” as were previously presented to the USPTO. 35 U.S.C. §325(d). The Board applies a two-part inquiry:

whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and

if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6, 7-8 (Feb. 13, 2020) (precedential). As to the second part of the framework, the Board elaborated: “If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.* at 9.

In making these determinations, the Board considers the following non-exclusive factors:

- (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;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (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 9 n.10 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17-18 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph)).

The Board should exercise its discretion to deny institution under 35 U.S.C. §325(d) because Petitioner relies on some of the very same references that were already considered by the examiner, and Petitioner's assertion of a lack of written description and indefiniteness of dependent claim 36 in Grounds 1 and 2 are meritless. Notably, the '703 Patent describes the features of claim 36, the

arrangement of those claimed features, and illustrates the features in the arrangement recited in claim 36.

Further, Grounds 3-6 are based on primary references Clary and Pankros were considered by the examiner during prosecution. Not only those references were part an IDS that was considered and initialed by the Examiner, Clary was substantively used by the same examiner that reviewed and ultimately allowed the claims of the parent '145 patent, with claim limitations similar to the challenged claims. Ex. 1001 at page 2, Section References Cited; see Section, V.C.1, *supra*; V.E.1, *supra*. In particular, the Examiner found that Clary failed to disclose features that the Petitioner now alleges Clary discloses. *Id.* In addition, the secondary references Tsuji and Xu are cumulative of the art of record or do not cure the deficiencies of the already considered art.

Instead of addressing the above noted *Advanced Bionics* factors, the Petitioner summarily argues that “the prior art cited herein was not applied by the Examiner in any rejections during prosecution of the '703 patent.” Petition, 156. But as explained above, the same issues and references were previously considered by the Patent Office. As the Board has explained, previously presented art includes “art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics*, IPR2019-01469, Paper 6, 7-8;

see also Risen (Suzhou) Pharma Tech Co. v. Alzheon, Inc., IPR2022-01200, Paper 14, 23 (Jan. 9, 2023) (denying institution under §325(d), noting that “references considered in an IDS are considered presented to the Office”); *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7, 14 (July 11, 2023) (denying institution under §325(d), noting that a reference was previously presented where it was “listed in an information disclosure statement (IDS),” “appears on the face of the ... patent” and “[t]he examiner also certified that he considered all references listed in the IDS ‘except where lined through,’ and [the reference] [was] not lined through.”).

As Petitioner has failed to show that the USPTO erred in a manner material to the patentability of challenged claims, the Board should exercise its discretion and decline institution of this Petition under 35 U.S.C. §325(d).

VII. CONCLUSION

For the reasons set forth above, Petitioner cannot meet its burden of establishing that at least one challenged claim is unpatentable, and the Board should exercise its discretion to deny institution. Patent Owner respectfully requests that the Board deny institution of this Petition for all challenged claims of the ’703 Patent.

Dated: May 8, 2024

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 CFR § 42.24(d)

Under 37 C.F.R. § 42.24(d), the undersigned certifies that the word count for this Patent Owner's Preliminary Response to the Petition for post grant review totals 9,424, excluding the parts exempted by 37 C.F.R. § 42.24(a). The word count was made using the built-in word count function in the Microsoft® Word software used to prepare this document.

Dated: May 8, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served a true and correct copy of the foregoing: PATENT OWNER'S PRELIMINARY RESPONSE and accompanying exhibits by email to the electronic service addresses for Petitioner on the date indicated below:

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