UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GODBERSEN-SMITH CONSTRUCTION COMPANY
d/b/a GOMACO CORPORATION,
Petitioner,

v.

GUNTERT & ZIMMERMAN CONST. DIV., INC.,
Patent Owner.

_____

Case PGR2024-00026
U.S. Patent No. 11,772,723

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

EXHIBIT NO.	DESCRIPTION
2001	Decision Denying Institution of *Inter Partes* Review, *Godbersen-Smith Construction Company d/b/a Gomaco Corp. v. Guntert & Zimmerman Const. Div., Inc.*, No. IPR2021-00135, Paper 11 (P.T.A.B. May 21, 2021)
2002	Petition for *Inter Partes* Review, *Godbersen-Smith Construction Company d/b/a Gomaco Corp. v. Guntert & Zimmerman Const. Div., Inc.*, No. IPR2021-00135, Paper 1 (P.T.A.B. Nov. 6, 2020)
2003	U.S. Patent Application Publication No. 2011/0236129 ("Guntert Application")
2004	Patent Owner's Preliminary Response, *Godbersen-Smith Construction Company d/b/a Gomaco Corp. v. Guntert & Zimmerman Const. Div., Inc.*, No. IPR2021-00135, Paper 8 (P.T.A.B. Feb. 25, 2021)

I. INTRODUCTION

Patent Owner respectfully requests that the Patent Trials and Appeals Board ("Board") deny institution because U.S. Patent No. 11,772,723 (Ex. 1001, "the '723 Patent") is not eligible for Post Grant Review ("PGR"). A patent is considered an AIA patent if it or any application in its priority chain contains a claim with an effective filing date later than March 16, 2013. Although Petitioner states that Claim 8 of U.S. Patent No. 9,908,571 (an ancestor of the '723 Patent) has an effective filing date of June 14, 2017, collateral estoppel bars Petitioner's attempt to raise this issue again because it was raised, actually litigated, and decided against Petitioner in IPR2021-00135. The Board's decision in IPR2021-00136 does not give rise to collateral estoppel because the issue was not actually litigated in that case. In the alternative, the Board should exercise its discretion to deny the Petition under 35 U.S.C. § 325(d) because the same argument has already been presented to the Office.

Further, although Petitioner alleges a written description defect, it does not rely on the alleged defect to establish a post-AIA effective filing date for the '723 Patent. Nor could it, because the allegedly unsupported limitation was added in an amendment during prosecution, and such amendments do not transform pre-AIA applications to AIA applications. Accordingly, the Board need not reach the written description ground raised in the Petition. Nevertheless, Petitioner's argument is

meritless because it focuses solely on the details of a preferred embodiment of the invention instead of the full scope of what the specification conveys to a POSITA. Petitioner's argument also relies on an unduly narrow interpretation of the term "disposed on" that is inconsistent with the intrinsic and extrinsic evidence and excludes the preferred embodiment.

II. OVERVIEW OF THE '723 PATENT

G&Z's '723 Patent discloses for concrete slipform paving machines a "propelling unit or tractor from which a paving kit is suspended with which a layer of concrete is shaped and finished over the underlying ground as the tractor travels along a road[.]" '723 Patent at 1:31-35. Each bolster swing leg is mounted on a hinge bracket secured to the front (or aft) ends of the side bolsters of the paving machine. *Id.* at 5:66-6:2. Figure 2 of the '723 Patent shows the pivotal swing leg. *Id.* at 8:1-3. Figure 2 further shows the bolster swing legs attached to the aft portion of the paving machine. *Id.* at 8:14-16.

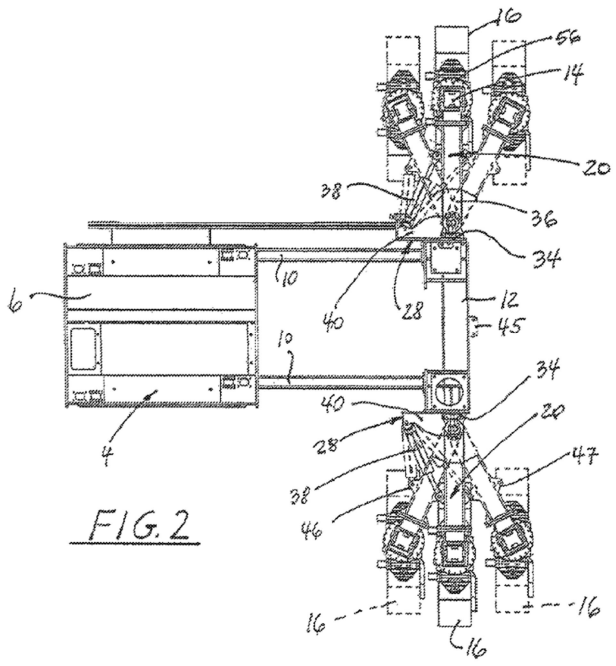


FIG. 2

Id. at Fig. 2. Figure 3 of the '723 Patent illustrates the hinge bracket for securing the swing leg to the paving machine.

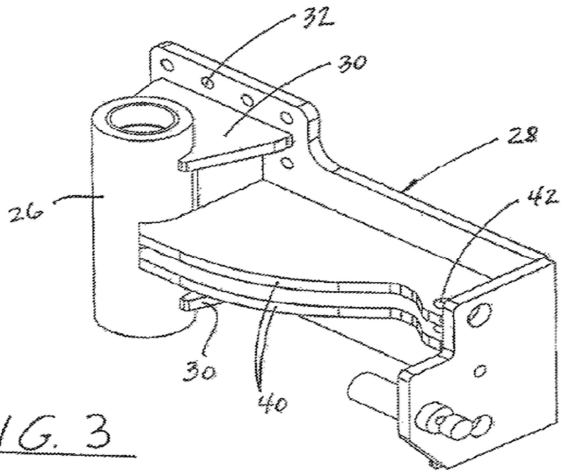


FIG. 3

Id. at Fig. 3. In this embodiment, the hinge bracket includes bearing bushing 26, which receives a swing leg pivot shaft that is directly coupled to, and rotates with, the rest of the swing leg. *Id*. at 9:50-56, 12:20-22 ("[P]ivot shaft 24 is rotationally fixed to the connector plate and duplicates the angular movements of swing leg 20 about the pivot shaft."). In an alternative embodiment, the hinge bracket includes a "fixed, upright pivot shaft" that the swing leg rotates around. *Id*. at 7:42-46.

The '723 Patent also provides for "angular position transducers at the pivot connection for the swing leg at the hinge bracket and another such transducer between the jacking column and the crawler track." *Id.* at 6:19-25. The angular position transducers measure the angular position between the swing leg and the modular frame and the angular position of the crawler track relative to the jacking column. *Id.*, Abstract. The bolster swing leg hydraulic actuator and the hydraulic rotary power drive, which pivot the crawler track relative to the jacking column, work with the position transducers to ensure that the crawler track is "held in a fixed location in relationship to the edge of the concrete." *Id.* at 6:38-43.

A benefit of this invention is that the crawler track positions can be changed while the machine is moving. *See id.* at 6:55-59. This invention also "eliminates the need to reposition the steering cylinder on the jacking columns" while the crawler tracks are under load without any mechanical adjustment or electronic resetting "when the crawler track is repositioned within the range of the swing leg cylinder

and [] allow[s] 90° steering without having to reposition[, repin, or reclock] the steering cylinder by employing a hydraulic motor driven rotary actuator . . . with an angular position transducer as the power drive between the crawler track and the jacking column." *Id.* at 7:1-8.

III. LEVEL OF ORDINARY SKILL IN THE ART

For the purpose of this preliminary response, G&Z applies Petitioner's definition of a person of ordinary skill in the art ("POSITA" or skilled artisan), as one who "would have had a bachelor's degree in mechanical engineering or a closely related field and at least two years of experience designing, developing, or operating heavy machinery, including their components and control systems." Pet. at 10. "Additional experience could substitute for a formal degree, and an advanced degree could substitute for experience." *Id.*

IV. THE '723 PATENT IS INELIGIBLE FOR POST-GRANT REVIEW

The '723 Patent is ineligible for post-grant review ("PGR") because it is a pre-AIA patent, and all patents in its priority chain enjoy an effective filing date of no later than March 26, 2010. *See* '723 Patent at Cover (63), 2 (60). As the Board found in No. IPR2021-00135, Claim 8 of U.S. Patent No. 9,908,571 enjoys written description support for the relevant limitations extending to the earliest patents in the priority chain, and collateral estoppel bars Petitioner from re-litigating this issue. Ex. 2001 at 11-12. Conversely, collateral estoppel does not arise from the Board's

contrary determination in No. IPR2021-00136 because the issue was not actually litigated in that proceeding.

A. Collateral Estoppel Bars Petitioner's Argument

The alleged statutory basis for this PGR—AIA § 3(n)(1)(B)'s provision that any patent claiming priority to an AIA Patent is an AIA Patent—fails because the '571 and '723 Patents are both pre-AIA Patents. *See* Pet. at 119. Collateral estoppel bars Petitioner's attempt to relitigate the issue of whether Claim 8 of the '571 Patent lacks written description because this exact issue was raised, litigated, resolved against Petitioner, and essential to Board's decision to deny institution in No. IPR2021-00135 (the "'0135 IPR") (Ex. 2001). *See Google LLC v. Hammond Dev. Int'l*, *Inc.*, 54 F.4th 1377, 1381 (Fed. Cir. 2022).

In the '0135 IPR, Petitioner argued that Claim 8 of the '571 Patent lacked written description support for the "laterally telescoping leg" and "linear position transducer" limitations. Ex. 2002 at 23. In the Preliminary Response, G&Z detailed where these two limitations were disclosed in *Guntert*, U.S. Patent Appl. Publ. No. 2011/0236129 (Ex. 2003, "Guntert Application"). Ex. 2004, '0135 IPR Prelim. Response at 28-32. Following G&Z's arguments, the Board determined that these

limitations were supported by *Guntert*.[1] In making this determination, the Board credited G&Z's arguments:

> In its Preliminary Response, Patent Owner details where and how Guntert discloses each of the limitations [*i.e.* "laterally telescoping leg" and "linear position transducer"] Petitioner lists. *See* Prelim. Resp. 25–32. Considering the absence of any explanation from Petitioner, we are satisfied that Patent Owner has demonstrated sufficient written description support for Petitioner's listed limitations.

Ex. 2001 at 11-12, 23.

Because the Board previously concluded that the Guntert Application provides written description support for Claim 8 of the '571 Patent following actual litigation of the issue, the Board should determine that the '571 and'723 Patents are pre-AIA patents with effective filing dates preceding March 16, 2013. *See* AIA § 3(n)(1)(B).

[1] The Guntert Application was filed on March 22, 2011, claiming priority to the provisional application filed on March 26, 2010. *See* Guntert Application at cover (60).

B. The Board Should Deny Institution Under 35 U.S.C. § 325(d)

To the extent that the Board determines that collateral estoppel does not apply for any reason, it should exercise its discretion to deny the Petition under 35 U.S.C. § 325(d) because the same argument has already been presented to the Office.

The Board "may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d). As the Board explained in *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH* ("*Advanced Bionics*"):

> [U]nder § 325(d), the Board uses the following two-part framework: (1) 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 (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.

No. IPR2019-01469, 2020 WL 740292, at *3 (P.T.A.B. Feb. 13, 2020) (precedential) (footnote omitted). "At bottom, this framework reflects a

commitment to defer to previous Office evaluations of the evidence of record unless material error is shown." *Id.*

As discussed in detail above, the "same arguments were previously presented to the Office." *See supra* Section IV.A. And far from showing any material error in Board's decision in IPR2021-00135, which rejected the very argument relied on here, Petitioner fails even to mention the decision in IPR2021-00135. On the other hand, the Board's analysis in IPR2021-00135, where the issue was actually litigated, shows material error in its determination in IPR2021-00136, where the issue was not actually litigated.

C. Collateral Estoppel Does Not Bar Patent Owner's Arguments

Although Petitioner cites the Board's determination in IPR2021-00136 to support its argument that the '571 Patent (and, by extension, the '723 Patent) are AIA Patents (*see* Ex. 1037, IPR2021-00136 FWD at 9-11; Pet. at 119), written description support for the disputed elements of claim 8 was not "actually litigated" in that case. *See Comair Rotron, Inc. v. Nippon Densan Corp.,* 49 F.3d 1535, 1537 (Fed. Cir. 1995) (collateral estoppel does not apply where "the issue was [not] actually litigated.").

The Restatement (Second) of Judgments (1982) explains that "[a]n issue is not actually litigated if . . . it is raised by a material allegation of a party's pleading but is admitted (explicitly or by virtue of a failure to deny) in a responsive pleading

. . . if it is the subject of a stipulation between the parties. . . . In the case of a judgment entered by confession, consent, or default, none of the issues is actually litigated." Restatement (Second) of Judgments § 27, cmt. E (1982). This Restatement guides the Federal Circuit's application of the principles of collateral estoppel. *Purdue Pharma L.P. v. Iancu,* 767 F. App'x 918, 922 (Fed. Cir. 2019) (citing *Voter Verified, Inc. v. Election Sys. & Software LLC*, 887 F.3d 1376, 1383 (Fed. Cir. 2018); *Jackson Jordan, Inc. v. Plasser Am. Corp.*, 747 F.2d 1567, 1575-76 (Fed. Cir. 1984) (citing cases); *see also Arizona v. California*, 530 U.S. 392, 414 (2000)).

Whether an issue was "actually litigated" in a prior proceeding depends on the level "adversarial engagement" over the issue. *See VirnetX Inc. v. Apple Inc.*, 792 F. App'x 796, 804 (Fed. Cir. 2019). On one end of the spectrum, as in this case, collateral estoppel does not attach when a party raises an issue in its pleadings and the opposing party admits or fails to deny the underlying allegation. *Jackson Jordan, Inc.*, 747 F.2d at 1576 n.8 (an issue is not "actually litigated if it is raised by a material allegation of a party's pleading but is admitted (explicitly or by virtue of a failure to deny) in a responsive pleading" (citing Restatement (Second) of Judgments Vol. 1 at 256–57)); *In re Corey*, 583 F.3d 1249, 1251-52 (10th Cir. 2009) (Because there are "many reasons why a party may choose not to raise an issue, or to contest an assertion, in a particular action," collateral estoppel does not apply to "unraised or uncontested issues."). Conversely, collateral estoppel will attach where the issue

was "extensively developed in discovery" and decided against the party bearing the burden (as occurred in the '0135 IPR). *See VirnetX Inc.*, 792 F. App'x at 803-04.

The Federal Circuit has thus also refused to apply collateral estoppel when one party made an assertion in the prior proceeding, and the other party did not contest it. *Voter Verified, Inc.*, 887 F.3d at 1382–83. Voter Verified sued Election Systems for patent infringement, and Election Systems counterclaimed that the patent was invalid under § 101. *Id*. at 1379. The district court subsequently granted Voter Verified's Motion for Summary Judgment of no invalidity under § 101 because Election Systems did not oppose the motion. *Id*. at 1379–80. Voter Verified later sued Election System again for infringing the same patent, and the district court refused to apply collateral estoppel to the prior summary judgment of no § 101 invalidity, holding that the parties did not actually litigate § 101 in the prior case because "Election Systems chose not to respond" despite having raised the issue in the first place. *Id.* at 1383.

Unlike in the -00135 IPR, written description support for the "laterally telescoping leg" and "linear position transducer" limitations was not "actually litigated" in the '00136 IPR because Patent Owner did not contest Petitioner's argument. *See* Ex. 1037 at 11 ("Patent Owner does not dispute Petitioner's arguments."); Pet. at 8. In these circumstances, collateral estoppel does not apply because the issue was not actually litigated. *Purdue Pharma L.P.*, 767 F. App'x at

922-23 (declining to apply collateral estoppel to an issue that could have been, but was not, raised because that is the standard for applying *res judicata*, not collateral estoppel).

D. The '723 Patent is Not PGR Eligible Based on the Alleged Lack of Written Description Support for an Angular Position Transducer

Although Petitioner argues that the '723 Patent lacks written description for a first angular position transducer disposed on the modular frame or swing leg, the Board need not reach this issue because even granting Petitioner's argument, the '723 Patent remains ineligible for PGR. Nevertheless, Petitioner's argument is meritless for the reasons discussed in § V below.

Petitioner does not argue that the '723 Patent is eligible for PGR based on this alleged written description defect. Pet. at 118-119. Nor could it. As Petitioner acknowledges, this claim limitation was added during prosecution of the '723 Patent. *Id*. at 109. As explained in the Manual of Patent Examining Procedure ("MPEP") § 2159, amendments—other than preliminary amendments filed on the same day as the application—lacking written description support in the originally-filed application, do not transform the application from a pre-AIA application to an AIA application:

> As 35 U.S.C. [§] 132(a) prohibits the introduction of new matter into the disclosure, an application may not contain a claim to a claimed invention that does not have support under 35 U.S.C.

> [§] 112(a) in the application (that is directed to new matter). **Thus, an application cannot "contain" a claim to a claimed invention that is directed to new matter for purposes of determining whether the application ever contained a claim to a claimed invention having an effective filing date on or after March 16, 2013**. . . . Therefore, an amendment (other than a preliminary amendment filed on the same day as such application) seeking to add a claim to a claimed invention that is directed to new matter in an application filed on or after March 16, 2013, that, as originally filed, discloses and claims only subject matter also disclosed in an earlier application filed before March 16, 2013 to which the application filed on or after March 16, 2013, is entitled to priority or benefit under 35 U.S.C. [§§] 119, 120, 121, or 365, **would not change the application from a pre-AIA application into an AIA application**.

MPEP § 2159.02 (emphasis added). Accordingly, because the alleged written description defect stemmed from an amendment introduced after the '723 Patent's filing date, that amendment could not transform the '723 Patent into an AIA Patent.

* * *

The '723 Patent is, therefore, not eligible for PGR because it is not an AIA patent and does not claim priority to an AIA Patent. Patent Owner respectfully requests, therefore, that the Board decline to institute post-grant review of the '723 Patent.

V. THE '723 PATENT IS VALID UNDER 35 U.S.C. § 112

The '723 Patent provides written description for the term, "a first angular position transducer is disposed on the modular frame or the swing leg." *Cf.* Pet. at 5, 108-111. Petitioner's written description argument fails because it focuses narrowly on implementation details of a single embodiment rather than what the specification "reasonably conveys" to a POSITA. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (To provide written description, the specification must "reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date."). Petitioner's argument also depends on an overly narrow interpretation of the term "disposed on" that is inconsistent with the intrinsic and extrinsic record.

A. The '723 Patent Discloses an Angular Position Transducer Disposed on the Swing Leg or Module Frame

The '723 Patent discloses two sets of angular position transducers. One set, not at issue here, measures the angle between the crawler track and the jacking column. '723 Patent at 11:64-12:14. The other set of angular position transducers measures the angle between each swing leg and the module frame. *Id*. at 12:15-45, Abstract. Each transducer is located "at the pivot connection for the swing leg at the hinge bracket." *Id*. at 6:22-23. The hinge bracket is fixed directly to the module frame. *Id*. at 5:66-6:2 ("[E]ach bolster swing leg is pivotally mounted on a hinge

bracket that is secured to the front (or aft) ends of the side bolsters of the paving machine.").

This arrangement, with hinge bracket 28 fixed to side bolster 12 of modular frame 4 and engaging swing leg 20, is illustrated in Figure 2:

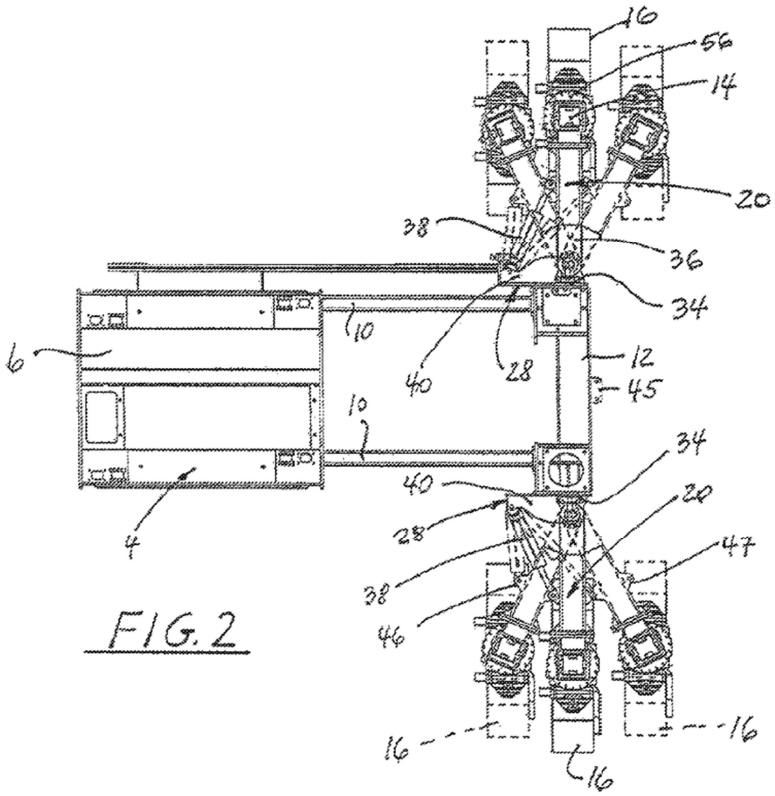


FIG. 2

'723 Patent at Fig. 2; *see also id.* at 2:27-35, 9:40-43 ("The hinge bracket has appropriately positioned fastening holes 32 for securing it to respective end surfaces 34 of side bolsters 12 with conventional bolt and nut fasteners 23 as shown, for example, in FIG. 7."). Because the angular position transducer is located at the pivot

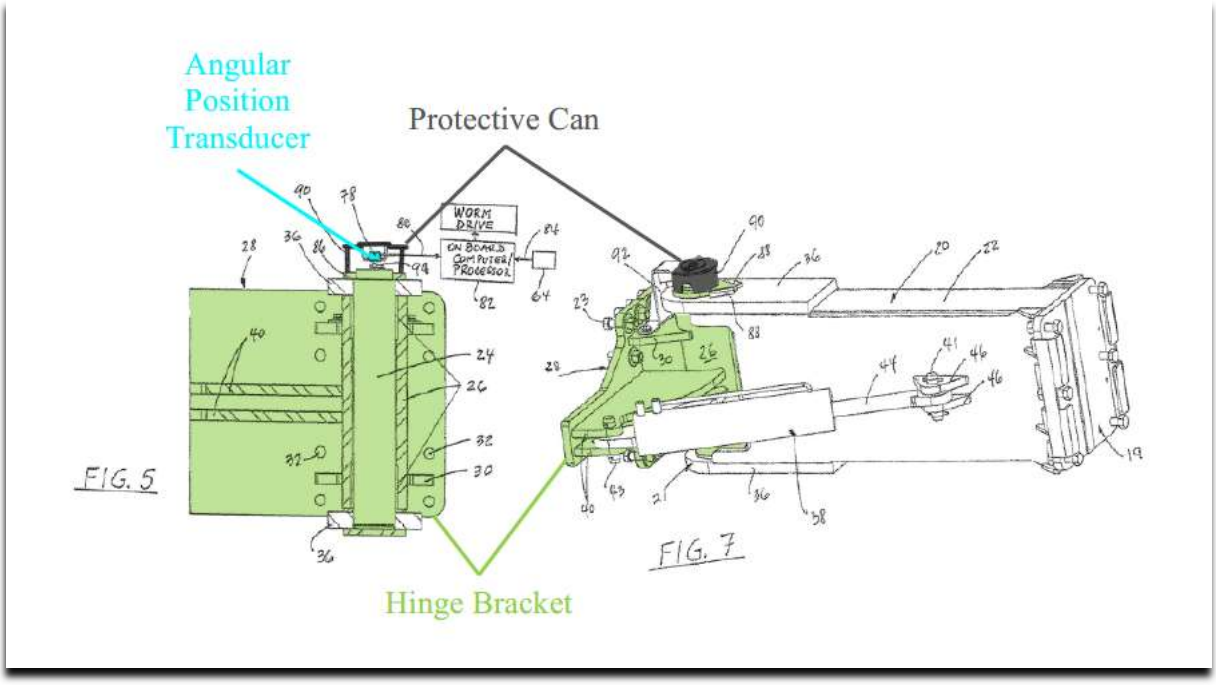
point, it can measure the angular difference between the swing leg and mounting frame as the swing leg rotates about the swing leg pivot shaft. *Id*. at 12:31-38.

These descriptions do not limit the placement of the angular position transducer beyond the requirement that it be located at the pivot point between the swing leg and module frame, so Petitioner's attempt to limit the scope of the disclosure to the specific implementation details of one illustrative embodiment (Pet. at 109-110) should be rejected. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) ("[W]e have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.").

Patent specifications are written for POSITA, and "[i]t is well-established that a patent specification need not re-describe known prior art concepts." *Immunex Corp. v. Sandoz, Inc.*, 964 F.3d 1049, 1064 (Fed. Cir. 2020). As Dr. Singhose acknowledges, a POSITA "understand[s]. . . rotary encoders and how to position them to measure relative rotation . . . ." Ex. 1002 at ¶ 116. Thus, Dr. Singhose admits, based on the teachings in the prior art, "a POSITA would have understood that the rotary encoder would need to be connected to both a reference point and a pivot point to measure the angular position of the swing leg relative to the modular frame." *Id.* at ¶ 117. Because a POSITA brings knowledge of this prior art concept to reading the specification, the POSITA recognizes that an angular position

transducer located at a pivot connection may be coupled to *either* the reference point or the pivot point so long as it connects to both. *Id*. at ¶¶ 117-118.

In accordance with this well-known principle, the exemplary embodiment of the '723 Patent illustrates one of these two possible arrangements, with an "angular position transducer 78 . . . placed on top of **swing leg pivot shaft 24**" and "mounted inside a downwardly open protective can 90 . . . which is bolted to **hinge bracket 28**":



'723 Patent at 12:15-17, 12:28-30 (emphasis added); Pet. at 6 (citing '723 Patent at Figs. 5, 7) (annotated)).

In this embodiment, the angular transducer is disposed on the mounting frame because it is fixed to a protective can 90 and bolted onto the hinge bracket, which is fixed to (and cannot rotate with respect to) the module frame. '723 Patent at 9:40-

43 (disclosing securing the hinge bracket to the frame); 10:15-16; 12:28-38. In Dr. Singhose's parlance, this embodiment teaches an angular position sensor disposed on a *reference point* (the hinge bracket and, by extension the modular frame) and connects to the *pivot point* via "a trigger pin 94 [that] projects upwardly from the top surface of pivot shaft 24 and cooperates with angular position transducer 78 to generate an angular position signal which reflects the angular inclination between the pivot shaft [that rotates with the swing leg] and the hinge bracket." '723 Patent at 12:31-35.

This arrangement is consistent with one of the "routine way[s] to implement" an angular transducer, which Dr. Singhose describes in paragraph 117 of his declaration because the transducer is fixed with respect to the modular frame (*i.e.* at a *reference point*) and measures the rotation of the swing leg pivot shaft 24 within bearing bushing 26 of the hinge bracket (*i.e.* a *pivot point*). '723 Patent at 9:50-56. The swing leg pivot shaft is fixedly coupled to, and rotates with, the rest of the swing leg. *Id*. at 12:17-22

Another embodiment of the '723 Patent discloses the other "routine way" to implement an angular position transducer to measure the relative angular position between a swing leg and modular frame. Ex. 1002 at ¶ 116. In this alternative embodiment, the hinge bracket includes "a fixed, upright pivot shaft" instead of a bushing bearing that receives a rotating swing leg pivot shaft. '723 Patent at 7:42-

46. In this case, a POSITA would recognize that the angular position transducer would be disposed on the swing leg (*i.e.* the pivot point) and would connect to the unmoving *reference point* formed by the "fixed, upright pivot shaft" because, as Dr. Singhose argues, a POSITA knows "how to position [an angular position transducer] to measure relative rotation." *Id*.; Ex. 1002 at ¶ 116.

Accordingly, the '723 Patent discloses disposing an angular position on the module frame or the swing leg. In fact, the '723 Patent explicitly discloses the two different embodiments (*i.e.* a pivot shaft that is fixed with respect to the module frame and a swing leg pivot shaft that is fixed with respect to the swing leg) that Dr. Singhose argues would be required to reach this limitation. Ex. 1002 at ¶¶ 117-118.

B. The Term "Disposed On" Includes Direct and Indirect Dispositions

The Board should also reject Petitioner's written description argument because it would require rewriting the term "disposed on" to mean *disposed directly on*. *See* Pet. at 109-110 (arguing that a transducer mounted on the hinge bracket, which is fixed to the module frame, cannot be "disposed on" the module frame because it is allegedly a "separate component"). Petitioner has not argued that this interpretation is consistent with the one that a POSITA would reach, which is its burden under 37 C.F.R. § 42.204(b)(4). In fact, Petitioner's tacit interpretation is inconsistent with the intrinsic record and the plain and ordinary meaning of the term. The Board should construe the term "disposed on" to include direct and indirect

disposition. These definitions are in concert with the specifications use of the term and do not imply the type of direct coupling necessary to support Petitioner's written description argument.

Petitioner's tacit interpretation of the term admittedly excludes the preferred embodiment of the invention. *See* Pet. at 109-110 (adopting an overly narrow interpretation of the term "disposed on" and then using that narrow interpretation to exclude the preferred embodiment). Such a construction would require "persuasive evidentiary support," and Petitioner provides none. *See SynQor, Inc. v. Artesyn Techs., Inc.*, 709 F.3d 1365, 1378-79 (Fed. Cir. 2013) ("A claim construction that 'excludes the preferred embodiment is rarely, if ever, correct and would require highly persuasive evidentiary support.'") (citation omitted). In the exemplary embodiment, the angular position transducer is *directly* mounted to a portion of the hinge bracket and *indirectly* disposed on the module frame because the hinge bracket is fixed to the frame. '723 Patent at 9:40-43; 10:15-16; 12:31-38. The Board should reject Petitioner's tacit claim construction argument, therefore, because its unduly narrow interpretation excludes this arrangement without any, let alone "persuasive evidentiary support." *SynQor, Inc.*, 709 F.3d at 1378-79.

The Board has previously construed the term "disposed on" to include indirect placement via intervening elements. *See Current Lighting Sols., LLC v. Jiaxing Super Lighting Elec. Appliance Co.,* No. IPR2023-00271, Paper 18 at 18 (P.T.A.B.

Aug. 16, 2023) (finding that "an element that is disposed 'on' another element does not preclude the presence of one or more intervening elements and the elements need not be directly touching"); *TPK Am., LLC v. Wintek Corp.*, No. IPR2013-00436, Paper 10 at 9-10 (P.T.A.B. Jan. 14, 2014) (construing "disposed on" as "allow[ing] intermediate layers to be interposed between the recited layers").

Based on the foregoing, Petitioner fails to show a reasonable likelihood that any claim of the '723 Patent lacks written description support.

VI. CONCLUSION

Patent Owner respectfully requests that the Board deny institution because the '723 Patent is not PGR-eligible. *See Concert Pharms., Inc. v. Incyte Corp.,* No. PGR2017-00034, Paper 9 at 6, 13 (P.T.A.B. Jan. 11, 2018) (declining to consider the petition's anticipation ground because the petitioner failed to demonstrate that the patent was PGR-eligible).

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

This paper complies with the type-volume limitation of 37 C.F.R. § 42.24. The paper includes 4,356 words, excluding the parts of the paper exempted by § 42.24(a).

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(ii) and the type style requirements of § 42.6(a)(iii)&(iv).

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the Patent Trial and Appeal Case Tracking System (P-TACTS) constitutes electronic service, that service was made on the Petitioner as detailed below.

Date of service	August 26, 2024
Manner of service	Electronic Filing with the Board
Documents served	PATENT OWNER'S PRELIMINARY RESPONSE
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