

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UATP IP, LLC,
Petitioner,

v.

SLICK SLIDE LLC,
Patent Owner.

Case PGR2024-00054
U.S. Patent No. 11,998,854

PATENT OWNER'S SUR-REPLY

I. INTRODUCTION

A post-grant review shall not be instituted unless the information in the *petition* demonstrates that it is more likely than not that at least one of the claims is unpatentable. 37 C.F.R. §42.208(c). The *petition* must set forth “[h]ow the challenged claim is to be construed.” 37 C.F.R. §42.204(b)(3).

Through its Petition, Petitioner had its chance to present its challenge to the claims of the ‘854 patent, including with respect to claim construction. Despite the fact that the ‘854 patent defines claim terms “coefficient of friction” and “mesh layer” and those definitions were, as a direct result, foreseeable by Petitioner, Petitioner chose to base its Petition on the argument that “no formal construction is necessary in this proceeding.” (Doc. 2, at 10). Petitioner’s Reply, particularly with respect to the issue of claim construction, is tantamount to providing Petitioner additional pages for the Petition, which is improper. *See Hewlett-Packard*, IPR2015-01505, Paper 15 at 2.

Patent Owner also respectfully submits that the Board should not be persuaded by Petitioner’s suggestion that Patent Owner has argued something “new” in its Preliminary Response. *1964 Ears, LLC*, IPR2016-00494, Paper 20 at 4. By definition, the Preliminary Response is the first opportunity for Patent Owner to articulate anything with respect to the Petition. *See id.* Thus, the fact that Petitioner did not know about positions taken by Patent Owner in its Preliminary Response is nothing unexpected. *See id.* Simply, Petitioner failed to acknowledge, much less address substantively, the definitions of claim terms “coefficient of friction” and “mesh layer” provided in the ‘854 patent. As a result, Petitioner cannot now argue an alternative reason it would purportedly prevail, after strategically presenting its Petition on a different basis. *See Xactware Sols.*, IPR2016-00582, Paper 14 at 3 (“To the extent Petitioner seeks

to identify new citations or bolster arguments in the Petition, we are not required to allow Petitioner to do so.”).

In addition, as explained below, Petitioner is not correct when it argues Patent Owner’s claim constructions for the claim terms “coefficient of friction” and “mesh layer” are legally erroneous or ineffective at averting the Petition’s obviousness contentions. Both claim terms are defined in the ‘854 patent specification, and Patent Owner has done nothing more than propose that these claim terms be construed accordingly.

In truth, Petitioner’s Reply is an attempt to cure the fact that Petitioner could have reasonably anticipated Patent Owner would introduce the constructions of these claim terms. This is especially accurate because the Patent Owner predictably and correctly proposes that constructions be based directly on the definitions in the specification. Indeed, Patent Owners in their preliminary responses commonly seek constructions of terms that were not addressed by a Petitioner (*See Apple Inc.*, IPR2016-00616, Paper 11 at 2), especially those that are defined in the specification. Not only did Petitioner strategically elect to not propose constructions of these terms in the Petition, as it could and should have under 37 C.F.R. §42.204(b)(3), Petitioner also failed to mention or address the fact that these claim terms are defined by the specification of the very patent it challenges.

II. ARGUMENT

A. Patent Owner’s Proposed Claim Construction For “Coefficient Of Friction” Was Foreseeable And Is Correct

If the specification puts a POSITA on notice that the inventor intended to define a claim term, then that definition should be applied. *See Bell Atl. v. Covad Comms.*, 262 F.3d 1258, 1268 (Fed. Cir. 2001). All that is required is that the patentee’s lexicography appear “with reasonable clarity, deliberateness, and precision.” *Renishaw PLC v. Marposs Societa'*, 158 F.3d 1243, 1249

(Fed. Cir. 1998). Applied here, there can be no dispute that the specification of the ‘854 patent provides clear intent to impart a definition to the term “coefficient of friction.” Therefore, that definition should be applied. *See Elekta Instr. v. O.U.R. Sci.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000).

As is disclosed in the ‘854 patent and as is understood by POSITA, the coefficient of friction (or “CoF”) between the ride vehicle and the slide surface is the ratio of the frictional force between two surfaces to the normal force pressing the surfaces together. (Ex. 1001, at 4:38-46; Ex. 2026, ¶¶61; Ex. 2027, ¶¶75). That is, Coefficient of Friction (p)=Force of Friction (F)/Normal Force (N). *Id.* Further, a POSITA understands CoF is not an arbitrary value but a measured value that depends on test conditions, material composition, surface roughness, and environmental factors. Ex. 2026, ¶¶153. A POSITA understands that CoF represents force interactions determined under precise measurement conditions, rather than serving as a universally applicable value. Ex. 2026, ¶¶153-155.

The ‘854 patent specifies details regarding the claimed CoF, and the manner in which it is determined. In particular, the ‘854 patent specification discloses that the CoF is between surfaces of mesh material 46 and slide 18. (Ex. 1001, at Claims 1, 22, 25; Ex. 2026, ¶¶62). The ‘854 patent goes on to specify that the CoF is to be “determined using the American Society for Testing and Materials International 30 (ASTM) Coefficient of Friction ASTM D1894 standard test method (July, 2023).” (Ex. 1001, 11:31-44; Ex. 2026, ¶¶63-64; Ex. 2027, ¶¶76). The ‘854 patent also specifies that “[f]or the ASTM D1894 test, the material specimen is attached to a sled [which]...is pulled across another surface at a speed of 150 mm/minute.” *Id.*

Against this background, there can be no question that the ‘854 patent demonstrates the patentee’s intent to impart a meaning of “coefficient of friction.” The length and detail of the

disclosure alone is telling. Further, the patent specifically states how the “coefficient of friction” is to be determined.

Notably, no other alternatives are provided; rather, there is only a single disclosure regarding how “coefficient of friction” is to be determined. And, it is a principle in construction that when a thing is expressly mentioned, others not mentioned are excluded, *e.g., expressio unius est exclusio alterius*, the explicit mention of one thing is the exclusion of another. Indeed, it is a maxim of interpretation that the expression of one thing is the exclusion of another. *Black's Law Dictionary* 521 (5th ed. 1979).

The disclosure in the ‘854 patent also demonstrates that Patent Owner’s proposed construction of “coefficient of friction” is correct. That is because Patent Owner’s proposed construction tracks the definition disclosed in the ‘854 patent. For this reason and as demonstrated through evidence by Patent Owner supporting its Preliminary Response, a POSITA would understand that the coefficient of friction is to be “determined using the American Society for Testing and Materials International (ASTM) Coefficient of Friction ASTM D1894 standard test method (July, 2023).” (Ex. 2026, ¶¶61-68). In this regard, “[a] patent’s specification, together with its prosecution history, constitutes intrinsic evidence to which the PTAB gives priority when it construes claims.” *Knowles v. Cirrus*, 883 F.3d 1358, 1362 (Fed. Cir. 2018); *V-Formation v. Benetton*, 401 F.3d 1307, 1310 (Fed. Cir. 2005) (intrinsic record “usually provides the technological and temporal context to enable the court to ascertain the meaning of the claim”).

Finally, it is notable that, despite the fact that the ‘854 patent demonstrates the patentee’s intent to impart a meaning to “coefficient of friction,” neither the Petition nor Petitioner’s Reply offers any competing meaning otherwise. Left undisputed then is that none of the references purportedly showing frictional coefficients between various materials relied upon by Petitioner

comply with any standard, much less the ASTM D1894 standard specified in the ‘854 patent. (Ex. 2026, ¶¶69). The examples do not disclose or specify the specified normal force, specified area of materials, morphology, or test conditions, and a POSITA would not rely upon them. *Id.*

B. Patent Owner’s Proposed Claim Construction For “Mesh Layer” Was Foreseeable And Is Correct

The ‘854 patent also defines the claim term “mesh layer.” “In another aspect, the mesh layer includes a plurality of interstitial openings that define an open area of the mesh layer.” (Ex. 1001, 2:50-51, Claim 22; Ex. 2027, ¶¶77). This definition of “mesh layer” is consistent with the definition understood by a POSITA. (Ex. 2027, ¶¶77). For example, as Patent Owner properly demonstrated in its Preliminary Response with supporting evidence, the accepted industry resource *The Fairchild Books Dictionary of Textiles* defines “mesh” as proposed by Patent Owner. (Ex. 2027, ¶¶77; Ex. 2006).

The intrinsic definition in the ‘854 patent specification, in combination with the extrinsic evidence of expert testimony and accepted industry resources presented by Patent Owner, demonstrates that Petitioner should have foreseen the construction of “mesh layer” proposed by Patent Owner, and that the construction is correct. *See V-Formation*, 401 F.3d at 1310. That construction is also consistent with accepted resources in the industry, further demonstrated by the evidence provided by Patent Owner. *See Nexstep v. Comcast Cable*, 119 F.4th 1355, 1364 (Fed. Cir. 2024) (“extrinsic evidence takes on particular importance when construing a term that skilled artisans recognized as a term of art”); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (“Because dictionaries, and especially technical dictionaries, endeavor to collect the accepted meanings of terms used in various fields of science and technology, those resources have been properly recognized as among the many tools that can assist the court in determining the meaning of particular terminology...”).

Against this backdrop, Petitioner spends much time presenting new arguments that the references it relies upon disclose the claimed mesh layer. (Doc. 6, at 5). Not only are Petitioner's new arguments improper and much too late, Patent Owner already demonstrated that these arguments are wrong. For example, Patent Owner already demonstrated that the materials listed by Phillips are not a "mesh layer" because they are uniformly described as "sheeting." (Ex. 2026, ¶¶71, 104-119; Ex. 2027, ¶¶89-108). "Sheeting" is not a mesh layer and is not characterized by open spaces, and a POSITA would not consider the sheeting material disclosed as forming the bottom surface of the ride vehicle as a mesh layer claimed in Claim 1 of the '854 patent. *Id.*

C. Petitioner's Arguments Regarding Discretionary Denial Under §325(d) Should Have Been Addressed In Its Petition And Are Wrong

In the Petition, Petitioner failed to mention much less address substantively the cumulative nature of its cited references. One of the references (Fallgatter) was thoroughly considered by the Examiner. Another reference (Phillips '779) is so similar to a reference the Examiner considered (Phillips '879) that it is cumulative. Given their nearly identical disclosures and the same sole inventor, Petitioner should have recognized Phillips '879 as cumulative but failed to do so. Patent Owner, however, identified this redundancy and demonstrated the substantial similarity between the two Phillips disclosures. (Doc. 5, 27-30: detailed charts demonstrating that all relevant material of '779 Phillips was considered via '879 Phillips and Fallgatter). Indeed, '779 Phillips is not materially different from '879 Phillips, which was considered by the Office. The relevant portions of their disclosures are the same, if not identical, and presented in the same context—sliding. Finally, the WN0400 reference is offered by Petitioner for nearly identical reasons as the Fallgatter reference, which the Examiner thoroughly considered. Again, Patent Owner demonstrated that WN0400 is cumulative. *Id.* at 29-30.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on March 10, 2025, a complete and entire copy of this Patent Owner's Sur-Reply was provided via email, to the Petitioner by serving the email correspondence addresses of record as follows:

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