

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHUTTLESLIDE, LLC,
Petitioner,

v.

SEA SWIVEL INC.,
Patent Owner.

PGR2025-00089
Patent 12,258,111

**PATENT OWNER'S PRELIMINARY RESPONSE
PURSUANT TO 35 U.S.C. §323**

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Exhibit	Description
2001	Docket Sheet, <i>Sea Swivel Inc. v. Rhodan Marine Systems of Florida LLC et al.</i> , Case No. 1:25-cv-23581-RKA (S.D. Fla.)
2002	Complaint for Patent Infringement, <i>Sea Swivel Inc. v. Rhodan Marine Systems of Florida LLC et al.</i> , Case No. 1:25-cv-23581-RKA (S.D. Fla.)
2003	Sea Swivel's Motion for Preliminary Injunction with Exhibits, <i>Sea Swivel Inc. v. Rhodan Marine Systems of Florida LLC et al.</i> , Case No. 1:25-cv-23581-RKA (S.D. Fla.)
2004	Declaration of Mark Berta in Support of Sea Swivel's Motion for Preliminary Injunction with Exhibits, <i>Sea Swivel Inc. v. Rhodan Marine Systems of Florida LLC et al.</i> , Case No. 1:25-cv-23581-RKA (S.D. Fla.)
2005	Declaration of Andrew T. Oliver
2006	Docket Navigator Time-To-Trial Data for Patent Cases in the U.S. District Court for the District of Florida
2007	Docket Navigator Time-To-Trial Data for Patent Cases Before Judge Roy Altman
2008	U.S. District Courts - National Judicial Caseload Profile report – 2019 to 2024
2009	Declaration of Matthew S. Nelles
2010	Local Rules of Civil Procedure for the U.S. District Court for the Southern District of Florida
2011	"Interim Processes for PTAB Workload Management Memorandum," issued March 26, 2025, https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf .

Exhibit	Description
2012	Order re Stay and Leave to Re-Raise Motions After Stay Lifted
2013	March 31, 2025 Cease and Desist Letter to ShuttleSlide
2014	June 25, 2025 Cease and Desist Letter to ShuttleSlide
2015	Declaration of Mark Berta in Support of Discretionary Denial
2016	"Company" Webpage from Gulf Atlantic Marketing, Inc. Website at http://www.gulfatl.net/company.html , last accessed 12/08/2025
2017	"Home" Webpage from Gulf Atlantic Marketing, Inc. Website at http://www.gulfatl.net/home.html , last accessed 12/08/2025
2018	"Products" Webpage from Gulf Atlantic Marketing, Inc. Website at http://www.gulfatl.net/products.html , last accessed 12/08/2025
2019	Track 1 Examination Request for Patent Application re '111 Patent

Pursuant to 35 U.S.C. §323, Patent Owner Sea Swivel Inc. (“Patent Owner” or “Sea Swivel”) respectfully requests that the Director deny institution of the Petition filed by ShuttleSlide LLC (“Petitioner” or “ShuttleSlide”) challenging the patentability of claims 1-18 (“challenged claims”) of U.S. Patent No. 12,258,111 (“the ’111 Patent”) (Ex. 1001).

I. INTRODUCTION

For at least the reasons set forth herein, the Director should deny institution under 35 U.S.C. § 324(a) and other applicable law.

On September 26, 2025, the Petitioner purports¹ to have filed its Petition in the above-referenced proceeding, requesting Post Grant Review of claims 1-18 of the ’111 Patent. The Petition alleges multiple grounds of unpatentability. However, as shown herein, none of the grounds meets the statutory threshold for institution of a PGR.

Specifically, “The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. §324. In this proceeding, the information presented does not demonstrate that it is more likely than not that any claim is

¹ Patent Owner challenges the purported filing date herein.

unpatentable.

Petitioner employed a “shot-gun” approach to its petition, attempting to spray as many references as possible at the challenged claims. However, each of the alleged anticipatory references and each of the obviousness combinations fails. As set forth below, each of the alleged anticipatory references is facially missing at least one claim element of every challenged claim; often several elements are missing. And each of the alleged obviousness combinations fails for multiple reasons. First, the Petitioner (and its owner/purported expert) fail to submit any evidence or meaningful analysis of motivation to combine. Rather, the Petition merely makes conclusory statements that a person of ordinary skill in the art (“POSITA”) would have been motivated to combine references. In some instances, the Petition goes so far as to claim that a POSITA would have combined a swivel with a swivel, merely because both are allegedly in the same field, without any further explanation or support. Other alleged motivations to combine are similarly unsupported. Second, even if the references are combined, each combination still facially lacks at least one (sometimes more) claim elements.

The response below addresses these issues as well as various evidentiary and procedural issues. First, the response argues for claim construction of the term “mounting plate,” a term that Petitioner appears to disregard in its analysis, asserting that various non-mounting plates in the prior art can become a “mounting

plate” merely by deeming them as such. Second, the response addresses a procedural failing that should result in the Petition being deemed incomplete and statutorily losing its filing date until such time as Petitioner may decide to complete the filing. Specifically, Petitioner was required to submit copies of each prior art patent on which it relied, but did not. Instead, for two of the prior art patents, Petitioner provided modified copies that make the patents appear to include elements from the challenged claims. But Petitioner did not identify the evidence as modified, instead asserting that these patents are the statutorily required copies.

Following this, the response addresses problems with Petitioner's evidence. Petitioner's purported expert is its owner, Mr. Taylor. His testimony is unreliable, making assertions that are contradicted by their own evidence. Additionally, his testimony is conclusory and merely copied/pasted from the Petition. Mr. Taylor reproduces the arguments from the Petition verbatim, including typographical and grammatical errors that appear in the Petition. Mr. Taylor's testimony should be excluded or given very little weight.

Petitioner's second witness, Mr. Trombley, is a distributor of Petitioner's products. Mr. Trombley has a direct financial interest in this proceeding, but hid that interest in his declaration. Mr. Trombley's testimony should similarly be given little weight. Further, Mr. Trombley attempts to establish that a device is

prior art with corresponding testimony, and his testimony is not independently corroborated by any evidence; in fact, the evidence that is submitted suggests that the device did not exist before the priority date of the '111 Patent.

Likewise, certain of Petitioner's exhibits lack corroboration, i.e., Exhibits 1012 and 1014, which refer to two different devices that Petitioner attempts to assert as a single anticipatory reference. As addressed herein, even a minimal review of the devices reveals that they are structurally different and cannot together form a single anticipatory reference. But more importantly, Petitioner did not provide the required corroboration that these devices existed before the priority date of the '111 Patent.

Following this discussion, this Response addresses each of the grounds that could potentially result in institution of a PGR, and shows how Petitioner failed to meet its burden of persuasion on each ground. This response does not address every ground, but rather focused on the grounds challenging independent claims and the grounds raising allegations under 35 U.S.C. §112. By showing that Petitioner did not meet its burden to show anticipation or obviousness of any independent claim, this Response also disposes of the grounds related to the dependent claims. This is because each of the grounds related to dependent claims merely relies on Petitioner's assertions about the independent claims and adds additional references to attempt to show specific features claimed in the dependent

claims. Full discussion of those grounds is below.

Finally, this Response addresses the written description and indefiniteness grounds applied to three dependent claims. Notably, these grounds appear to be wholly frivolous, as the plain intrinsic evidence shows that they have no merit.

The Director should deny institution of this PGR, as Petitioner did not meet the statutory standard for institution with respect to any one or more of the grounds asserted in the Petition.

II. CLAIM CONSTRUCTION

A. Level of Ordinary Skill in the Art

In a PGR, claim terms are construed “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. §42.200. Thus, it is important to understand that level of skill. For purposes of this response only, Patent Owner does not challenge the level of skill set forth by Petitioner at Petition p. 15. Patent Owner reserves the right to make assertions regarding the level of ordinary skill in the art as it might be applied in any other portion of this proceeding or any other proceeding outside of the decision whether to institute.

B. Terms For Construction

a. "Mounting Plate"

The term "mounting plate" appears in claims 1 – 7 and 15 – 18 of the '111 Patent, all of which depend from independent claim 1. Claims 8 – 12 do not include the term "mounting plate."

Construction of the term "mounting plate" is important in consideration of the petition, because multiple of the proposed grounds include prior art that is either non-analogous or incomplete insofar as the prior art is not related to "mounting" objects, but rather to items not intended for mounting objects upon.

The terms "mounting" and "plate" are not given specific definitions within the '111 Patent and, thus, are defined by their usage in the '111 Patent and their ordinary use in the art.

The '111 Patent includes multiple statements demonstrating that the term "mounting" refers to attaching (or securing) an object to the claimed "swivel mount." These statements include the following (emphasis added):

- "[A]lthough the description of the swivel mounts provided herein emphasizes mounting on to [sic] flat surfaces and **having a flat surface onto which an object may be mounted...**" col. 4:62-65
- "[T]he swivel mounts described herein are designed to have enough

strength to counter the weight of **an attached trolling motor** as well as the forces it may incur in operation.” Col. 5:24-28

- “[T]he swivel mounts disclosed herein may be used for mounting an object to a [sic] underlying surface, particularly having ... such that **an object may be secured to the mounting member** at an elevation above the mounting surface to which the support member is fastened.” Col. 5:34-41.
- “In general, second portion 28 of **top plate 4 is configured to receive and secure an object** to swivel mount 20 and, thus, top plate 4 may serve as a mounting member of swivel mount 20.” Col. 10:60-64.
- “In general, the length of top plate 4 may vary depending on the distance or area to which **an object mounted thereon** is to be moved via swivel mount 20.” Col. 12:25-27.

Thus, based on the usage within the ‘111 Patent, the term “mounting plate” refers to a plate configured for receiving and securing or attaching an object thereon.

Patent Owner did not locate any statements in the prosecution history (Ex. 1002) that confirm or contradict the meaning set forth in the patent.

And the dictionary definition of “mount” confirms the meaning set forth above. The word “mount” has multiple meanings and can be used as a verb or

noun. But the meanings most related to the field of the invention refer to “an attachment for an accessory” or “a support ... on or in which something is, or is to be, mounted or fixed.” <<See <https://www.merriam-webster.com/dictionary/mount>>>; <<see also <https://www.dictionary.com/browse/mount> (“a support, backing, setting, or the like, on or in which something is, or is to be, mounted or fixed”)>>; <<see also <https://dictionary.cambridge.org/us/dictionary/english/mount> (“to attach something to something else so that it can be seen”)>>.

Both intrinsic and extrinsic evidence support construing the term “mounting plate” as “plate configured for receiving and securing or attaching an object thereon.”

III. EVIDENTIARY PROBLEMS

A. The Petition May Not Be Considered Under 35 U.S.C. §322(a)

The petition should be denied consideration under the controlling statute because the Petitioner submitted modified evidence and failed to submit the required, unadulterated evidence. Under §322, the petitioner must supply the Board and Patent Owner copies of the prior art patents, which Petitioner did not do here:

A petition filed under section 321 may be considered only if ...

(3) the petition identifies, in writing and with particularity ... the evidence that supports the grounds for the challenge to each claim, including—(A) copies of patents and printed publications that the petitioner relies upon in support of the petition ...; and

(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) ...

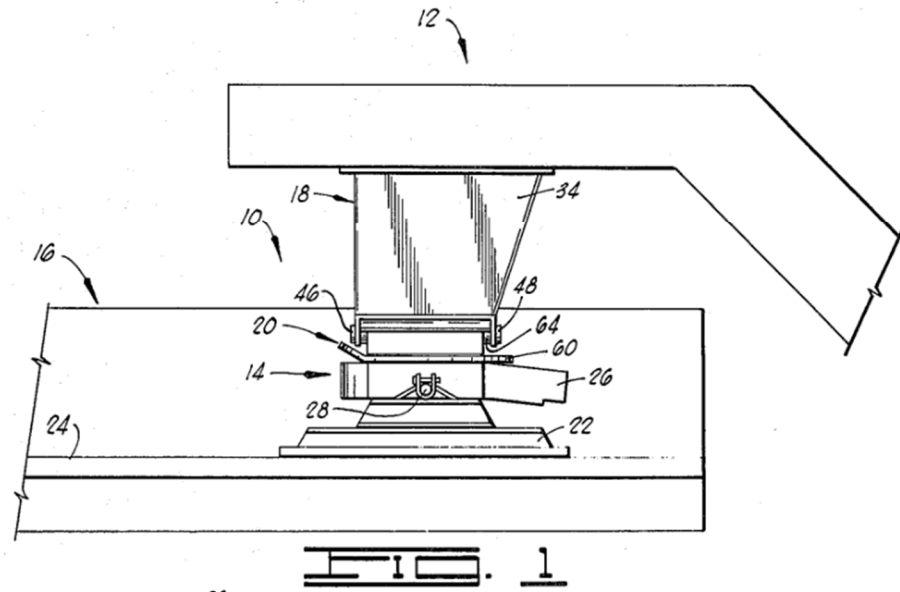
35 U.S.C. §322(a). Rather than supplying clean copies of the prior art patents on which the petition relies, Petitioner supplied modified information in two of the prior art patents. For this reason, the petition should be denied consideration.

Exhibit 1004 purports to be U.S. Pat. No. 3,897,086, but it is a modified version of that document, including information added by Petitioner to Fig. 1, in an effort to make it appear that the prior art included the elements of the '111 Patent and used the same terminology. A table showing the differences is below:

Original Fig. 1 from U.S. Pat. No. 3,897,086

PATENTED JUL 29 1975

3,897,086



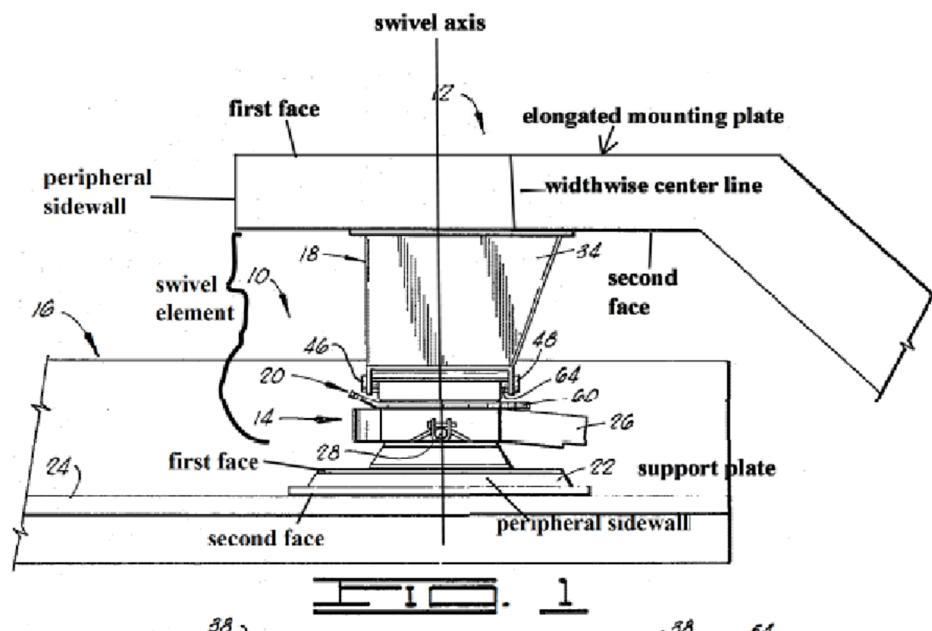
20

20

Modified Fig. 1 from Ex. 1004

PATENTED JUL 29 1975

3,897,086



3A

3A

2A

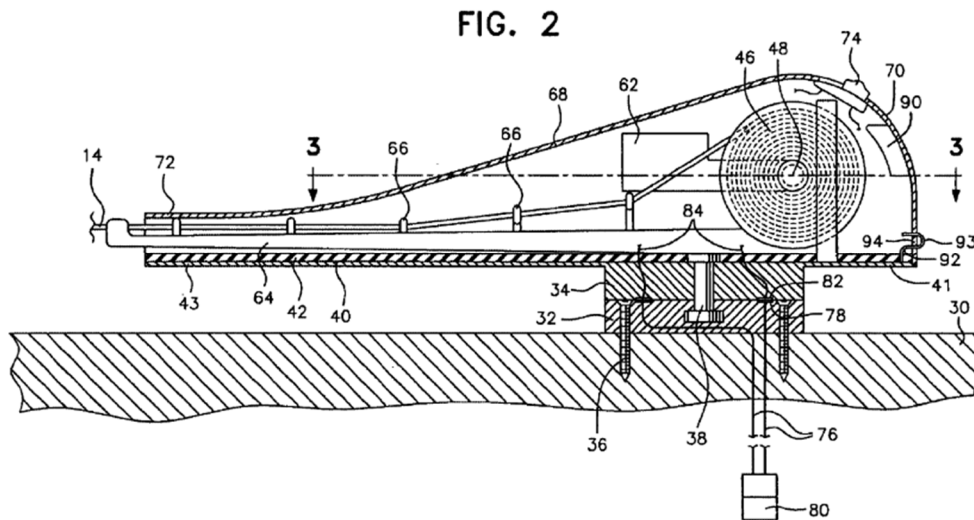
As can be seen, Petitioner added both lines and text that appear to be portions of the original document, but are not. Petitioner did not identify Ex. 1004 as an altered document, leading one to conclude that Petitioner intended to submit it as falsified evidence. And by submitting this falsified evidence, Petitioner failed to comply with 35 U.S.C. §322(a)(3) and (5), which both require “copies” of the documents, not altered / modified versions of the documents.

The same is true for Fig. 2 of Exhibit 1005:

U.S. Patent

Sheet 2 of 6

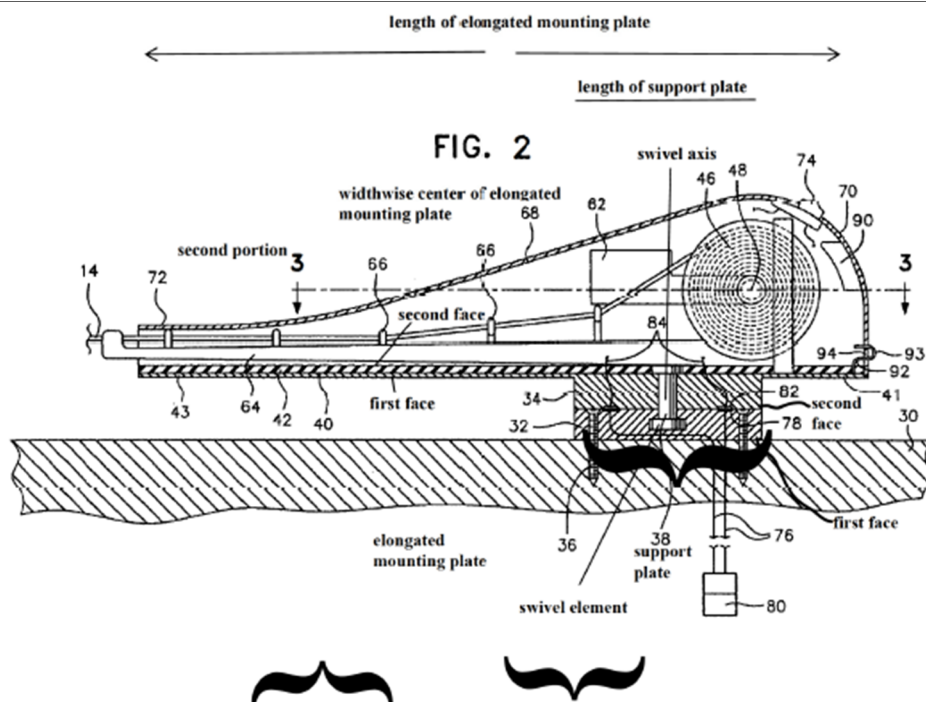
US 6,684,558 B1



U.S. Patent

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The modifications added by Petitioner appear in a similar color (i.e., black lines and lettering) and font size in a manner that is misleading and gives Petitioner's changes the false appearance of being original to the referenced art. This becomes even more misleading where Petitioner has included annotated Figures in the Petition and identified those Figures as being annotated, but in the case of the other references Petitioner provided unaltered copies in the Exhibits.²

Accordingly, under 35 U.S.C. §322, the Petition is incomplete and may not be considered or given a filing date until the date on which a complete Petition is submitted.

B. Petitioner's Witnesses Are Unreliable and Biased; Their Testimony Cannot Be Given Weight

Petitioner relies upon the testimony of two witnesses who are unreliable and biased as explained below. For these reasons, their testimony is entitled to little or no weight.

a. Petitioner's Purported Expert and Owner

The testimony of Petitioner's purported expert witness, Mr. Taylor, should

² It should also be noted that the annotated Figures provided by Petitioner in the Petition are also confusing and non-compliant because they too use a similar color (i.e., black lettering) and font size for annotations and modifications in a manner that is confusing and makes it difficult to distinguish between the original and Petitioner's additions.

be given little weight or excluded. Taylor's testimony (Ex. 1003) demonstrates bias, unreliability, copying of the Petition, lack of evidentiary support, and failure to follow the standards for opinion testimony.

First, Mr. Taylor shows bias and financial interest in the outcome of the proceeding. Mr. Taylor testifies, "I have been the owner ... of [Petitioner] since 2018." Ex. 1003 ¶3. This is an explicit statement of bias and financial interest. While this financial interest suggests that little weight should be given to Mr. Taylor's testimony, at least one court has found that such a direct ownership interest requires excluding the expert testimony entirely: "[I]t appears to this court that such exclusion of a proffered expert with such a direct financial stake in the litigation could be accomplished under Rule 702 and the standards set forth above, as such testimony could be deemed inherently unreliable." *Keystone Transp. Sols., LLC v. Nw. Hardwoods, Inc.*, Civil Action No. 5:18-cv-00039, 2019 U.S. Dist. LEXIS 67103, at *8 (W.D. Va. Apr. 19, 2019). Excluding Mr. Taylor's expert testimony would be appropriate here, where he stands to directly financially benefit from the outcome of this proceeding.

Second, Mr. Taylor's testimony should be excluded because he is unreliable. Recently, the *en banc* Federal Circuit stated that testimony "not based on sufficient facts or data" was "unreliable and therefore inadmissible under Rule 702." *EcoFactor, Inc. v. Google LLC*, 137 F.4th 1333, 1346 (Fed. Cir. 2025) (*en banc*).

Applied in this proceeding, Mr. Taylor compared two different devices and attempted to render an anticipation opinion (as if the two devices were a single reference). Mr. Taylor testifies, “The Grady-White trolling motor mount described in [Ex. 1014] is identical to the Grady-White Pivoting Trolling Motor Mount depicted in the images of [Ex.] 1012.” Ex. 1003 ¶15. However, this is not based on facts or data. And Petitioner's own evidence demonstrates that the opposite is true; the devices are not identical.

As can be seen in the marked-up image excerpts below, when the devices (circled in red below) are viewed at an angle that shows the “base” portion of the devices contacting the gunnel (Ex. 1012) or a white box on the gunnel (Ex. 1014) and the portion directly above the base (“central portion”) (indicated with orange/green arrows), the two central portions of each device are very different. In the Exhibit 1014 device, the central portion is wider than the base and appears to have a square or rectangular cross-section, while the central portion of the Exhibit 1012 device is narrower than the base and appears to have a combined circular and square cross-section:

Marked-Up Excerpt from Exhibit 1014 p. 11	Marked-Up Excerpt from Exhibit 1012 p. 1
	

The cross-section of the Exhibit 1012 device can be further confirmed by viewing Exhibit 1012 p. 2. However, the cross-section of the Exhibit 1014 device must be inferred by lighting and shadows, as Exhibit 1014 does not have any photographs or description that further clarifies the structure.

These devices are not “identical” and demonstrate the unreliability of Mr. Taylor’s testimony. This suggests either excluding or giving little weight to the testimony.

Third, Mr. Taylor’s testimony should be excluded because his testimony merely tracks counsel’s briefing. In a precedential opinion, the PTAB noted that testimony “is entitled to little weight” where it “merely repeats, verbatim, the conclusory assertion for which it is offered to assert.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624 (Paper No. 9 at p. 15), Aug. 24, 2022. Mr. Taylor’s testimony is not independent nor based on evidence or factual underpinnings. Mr.

Taylor even copies counsel's typographical errors in his declaration. For example, Ex. 1003 ¶¶17-21 refer to "annotated" figures "below," even though no figures appear in Ex. 1003, because the language was copied directly from the Petition. As another example, Ex. 1003 p. 5 copies the grammatical error "Claims 6 is unpatentable..." from the same grammatical error at Petition p. 12.

The table below demonstrates exemplary portions of counsel's briefing that Mr. Taylor copied verbatim:

Ex. 1003 (Taylor Declaration)	Petition
¶¶14-16	Copied verbatim from p. 18
¶¶17-24 (including references to non-existent annotated figures)	Copied verbatim from pp. 19-20
¶¶25-54 (including reference to non-existent annotated figures)	Copied verbatim from pp. 25-32
¶¶55-57	Copied verbatim from pp. 43 and 45
¶¶58-61	Copied verbatim from pp. 45-47
¶¶62-63	Copied verbatim from pp. 48, 50
¶¶64-65	Copied verbatim from pp. 55, 60
¶¶66-70	Copied verbatim from pp. 61, 64-67

It would become too tedious to list every example of copying, because the same verbatim copying continues throughout the entirety of Mr. Taylor's purported testimony in paragraphs 71 through 129. Mr. Taylor did not offer opinion

testimony; he merely copied portions of counsel's brief into a declaration. This testimony should be given little weight or excluded entirely.

Fourth, Mr. Taylor's opinions lack citation to evidentiary support, rendering them unreliable. "Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight." 37 C.F.R. §42.65. Mr. Taylor testifies that his opinions are "based on my education, experience, and background in the fields discussed above." Ex. 1003 ¶12. But he does not disclose nor cite the underlying facts and data on which he opines. Even when referring to prior art references, Mr. Taylor fails to cite pages, paragraphs, or lines, but merely refers to the inventors' names. *See generally* Ex. 1003. Mr. Taylor does not even identify what materials he is relying upon or drawing from. *Id.* Mr. Taylor's opinions should be given "little or no weight."

Finally, Mr. Taylor fails to follow even the basic standards for expert testimony. His declaration fails to state the "facts or data" or identify "reliable principles and methods" on which he allegedly relies. *See, e.g.*, Fed. R. Evid. 702. Mr. Taylor does not provide any of the information typically provided pursuant to Fed. R. Civ. P. 26(a)(2)(B), e.g., the basis and reasons for opinions, the facts or data considered, any exhibits that will be used to support the opinions, a list of authored publications, a list of cases within the past 4 years, or a statement of compensation. Mr. Taylor does not state the legal standards that he is applying.

And he does not make any statement about his understanding of the meaning of “obvious” or “common knowledge of one skilled in the art.” Mr. Taylor does not state that he reviewed the ‘111 Patent, the prosecution history, or the claims. Mr. Taylor does not state that he understands claim construction or how he construed the claims.

Importantly, Mr. Taylor does not state that he opines based on what a person of ordinary skill in the art (“POSITA”) would have understood at the time of the invention. Instead, Mr. Taylor states that his opinions are “technical opinions” (Ex. 1003 ¶2) and that they “are based on my education, experience, and background.” Ex. 1003 ¶12. Mr. Taylor claims to have a mechanical engineering degree and over 30 years of experience in the field. *Id.* ¶¶5-8. However, Petitioner argues that a POSITA “would have at least five (5) years’ [sic] experience designing marine accessories” and no requirement for any education. Petition p. 15. Thus, Mr. Taylor’s testimony about what references show based on his “education”, 30 years “experience”, and an engineering degree are grossly different than what a POSITA would see in the same references.

It was not appropriate for Mr. Taylor to consider patentability based on his own education, experience, and background. Rather,

[O]bviousness is measured objectively in light of the prior art, as viewed by a person of ordinary skill in the field of the invention.
“Those charged with determining compliance with 35 U.S.C. § 103

are required to place themselves in the minds of those of ordinary skill in the relevant art at the time the invention was made, to determine whether that which is now plainly at hand would have been obvious at such earlier time.”

Millennium Pharms., Inc. v. Sandoz Inc., 862 F.3d 1356, 1367 (Fed. Cir. 2017); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (“It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed.”). Because Mr. Taylor did not place himself in the mind of a POSITA, Mr. Taylor’s opinions should be wholly excluded.

b. Petitioner’s Other Witness – One of Petitioner’s Distributors

Petitioner’s second witness, Mr. Trombley, is also biased, with undisclosed financial ties to Petitioner. On this basis, Mr. Trombley’s testimony should be given little weight. It is unclear why Mr. Trombley failed to disclose that he has financial ties to Petitioner, but the fact of non-disclosure suggests that Mr. Trombley’s testimony should be given less weight.

As other testimony and evidence establishes, Mr. Trombley does have a financial interest in Petitioner succeeding in this proceeding. Ex. 2015 ¶¶5. Mr. Trombley is the president of a company that markets and distributes Petitioner’s trolling motor mount that is accused of infringement in the related district court case. Ex. 2015 ¶¶6-9; Exs. 2016-2018. A motion for preliminary injunction was

filed in that district court case. Ex. 2003. If the motion were granted, Mr. Trombley may be cut off from a source of income; and if Patent Owner is successful in asserting patent infringement, Mr. Trombley or his company might even be liable for some portion of the damages for patent infringement. Thus, Mr. Trombley appears to have a direct financial interest in the outcome of this proceeding, but he makes no mention of it in his declaration.

The weight of Mr. Trombley's testimony should be discounted significantly based on his undisclosed financial interest.

C. The Alleged “Grady-White” Documents, i.e., Exhibits 1012 and 1014 Are Not Corroborated as Prior Art

Petitioner's exhibits 1012 and 1014 should not be considered as prior art, because neither is sufficiently corroborated. “[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential). Petitioner did not meet this standard.

a. Ex. 1014

Petitioner's exhibit 1014 purports to be a screenshot of a website. Petitioner asserts that the information is dated in 2014, before the '111 Patent's priority date. However, Exhibit 1014 includes numerous details showing that it cannot be reliably dated earlier than 2025. First, it bears a copyright date of 2025. Ex. 1014 p. 14. Second, every page of Ex. 1014 bears the date "9/22/25, 9:22 AM." Third, Ex. 1014 includes numerous links to other articles dated no earlier than 2025. For example, on Ex. 1014 p. 13, includes links to an article titled "World Record Cobia Caught Off Australia" that is dated September 2025 << <https://www.sportfishingmag.com/news/world-record-cobia/>>>, an article titled "B.A.S.S. Set to Impose New Restrictions on Live Sonar in Tournament Events" that is dated September 2025 << <https://www.sportfishingmag.com/news/bass-set-to-impose-new-restrictions-on-live-sonar-in-tournament-events/>>>, and an article titled "Alabama Extends Red Snapper Season" that is dated September 2025 << <https://www.sportfishingmag.com/news/alabama-extends-red-snapper-season/>>>. Thus, it is apparent that Ex. 1014 includes information that post-dates the priority date of the '111 Patent, casting doubt on its reliability.

Similar documents were considered in *Louisiana-Pacific Corp. v. Huber Engineered Woods LLC*, IPR2020-00596 (Paper 12), Aug. 20, 2020. The Board noted, "The issue is whether the Petition identifies evidence sufficient to establish

that [certain references] qualify as printed publications [prior to the patent priority date] for purposes of this review.” *Id.* p. 14. The Board noted the inconsistent dates and information in the references, similar to what appears here in Ex. 1014, and held, “Petitioner has failed to meet its burden, as set forth in *Hulu*, of establishing a reasonable likelihood that [the references] qualify as prior art printed publications.” *Id.* at 16. The Board noted that the Petition did not reconcile the alleged publication date with the inconsistent copyright date. *Id.* And the Board noted, “the Petition does not submit any testimony to support a finding that either of these documents is a prior art printed publication.” *Id.* Importantly, the Board noted, “nothing in the record indicates that these screenshots were obtained from websites contemporaneously archived at the alleged time of publication, for example, by the Wayback Machine, which the Federal Circuit and the Board have relied on to validate websites as a source of prior art.” *Id.*

Exhibit 1014 suffers all of the same types of deficiencies (and more). And it lacks evidence to establish that it is prior art. (Notably, Petitioner did submit one unrelated exhibit (Ex. 1010) from the Wayback machine; the absence of Ex. 1014 on the Wayback Machine suggests that its age cannot be verified.)

Exhibit 1014 should not be considered as prior art.

b. Ex. 1012

Exhibit 1012 is similarly problematic, in that the exhibit does not establish that the photographs are of a device that existed before 2025. None of the photographs are dated. The testimony regarding the photographs states only that they are “copies of photographs that I took of the boat I purchased on April 22, 2023.” Ex. 1013. This testimony, however, is by a biased witness as set forth above. And the testimony does not establish or even attempt to establish that the trolling motor mount device was part of the boat prior to 2025. It does not state that the photos were taken before 2025. And it does not state that the device was part of the boat before 2025. Moreover, the purportedly corroborating bill of sale at Ex. 1015 is not signed and does not list the trolling motor mount device as part of the equipment that came with the boat.

Even if the witness had offered testimony to attempt to establish the date of the trolling motor mount device, that testimony alone would be insufficient. Rather, the Federal Circuit requires corroboration of a single witness's testimony used to prove invalidity. “The law has long looked with disfavor upon invalidating patents on the basis of mere testimonial evidence absent other evidence that corroborates that testimony.” *Finnigan Corp. v. United States Int'l Trade Comm'n*, 180 F.3d 1354, 1366 (Fed. Cir. 1999). “[T]he need for corroboration exists regardless whether the party testifying concerning the invalidating activity is

interested in the outcome of the litigation (e.g., because that party is the accused infringer) or is uninterested but testifying on behalf of an interested party. That corroboration is required in the former circumstance cannot be debated.” *Id.* at 1367. “[T]he need for corroboration takes on special force when an otherwise uninterested witness shows some reason to be biased in favor of the interested party.” *Id.* at 1368.

And the witness's photographs do not corroborate the assertion that the trolling motor mount device predates the '111 Patent. “[U]ncorroborated testimony cannot be corroborated by uncorroborated evidence.” *Philip Morris Prods. S.A. v. Int'l Trade Comm'n*, 63 F.4th 1328, 1355 (Fed. Cir. 2023). The witness, Mr. Trombley, is the only person who attempted to corroborate his own photos. Nothing in the photos establishes the existence of the trolling motor mount device before the '111 Patent priority date.

Because the date of the device shown in Ex. 1012 is uncorroborated, it does not constitute prior art to the '111 Patent.

IV. Grady-White – Ground 1 – Claims 1, 2, 4, 5, 8, 10, and 11

Petitioner incorrectly asserts that claims 1, 2, 4, 5, 8, 10, and 11 are unpatentable as anticipated by a combination of two different references (Exs. 1012 and 1014), colloquially referred to by Petitioner as “Grady-White.” These two references disclose two different devices, and do not anticipate the identified claims.

The available information related to these two exhibits is very limited and does not teach or enable the claimed functions, but is detailed enough to show that the two devices in these two exhibits are different from each other. As can be seen in the marked-up image excerpts below, when the devices (circled in red below) are viewed at an angle that shows the “base” portion of the devices contacting the gunnel (Ex. 1012) or a white box on the gunnel (Ex. 1014) and the portion directly above the base (“central portion”) (indicated with orange/green arrows), the two central portions of each device are very different. In the Exhibit 1014 device, the central portion is wider than the base and appears to have a square or rectangular cross-section, while the central portion of the Exhibit 1012 device is narrower than the base and appears to have a combined circular and square cross-section:

Marked-Up Excerpt from Exhibit 1014 p. 11	Marked-Up Excerpt from Exhibit 1012 p. 1
 A color photograph of a boat's outboard motor. A red oval highlights a black component on the side of the motor. A green arrow with a black outline points to this component. The word "MotorGuide" is visible on the motor's cowling.	 A close-up photograph of a motor component. A red oval highlights a black component. A green arrow with a black outline points to this component. The text "MINN KOTA" and "ULTRA" are visible on the component.

The cross-section of the Exhibit 1012 device can be further confirmed by viewing Exhibit 1012 p. 2. However, the cross-section of the Exhibit 1014 device must be inferred by lighting and shadows, as Exhibit 1014 does not have any photographs or description that further clarifies the structure.

Because these are two different devices in two different references, they must be treated as separate references, not as a single anticipatory reference under 35 U.S.C. §102.

D. The Exhibit 1014 Device

The Exhibit 1014 “Grady-White” reference is unreliable, has not been properly authenticated, and does not disclose most of the elements of the challenged claims.

First, as explained more fully (above), Exhibit 1014 bears the date “9/22/25” (i.e., September 22, 2025) on each page. And Exhibit 1014 includes information

related to events that occurred in 2025. Ex. 1014 p. 13. Petitioner made no showing that the information in Exhibit 1014 existed before 2025, which is after the September 2024 filing date of the application that led to the '111 Patent. Ex. 1001 p. 1 ("Filed: Sep. 26, 2024"). Thus, Petitioner did not demonstrate or establish that Exhibit 1014 device is prior art to the '111 Patent.

Mr. Taylor, the owner of Petitioner, makes an uncorroborated statement that "Grady-White Pivoting Trolling Motor Mounts were publicly available at least as early as May 15, 2014, the date of the Sport Fishing Magazine Article." Ex. 1003 ¶16. This statement does not specifically refer to any particular form of motor mount, and is not tied to the Exhibit 1014 device. Moreover, the statement is not corroborated by any evidence. And in the preceding paragraph (i.e., Ex. 1003 ¶15), Mr. Taylor demonstrates that his testimony is unreliable and inaccurate, stating, "The Grady-White trolling motor mount described in [Exhibit 1014] is identical to the Grady-White Pivoting Trolling Motor Mount depicted in the images of [Exhibit 1012]." Ex. 1003 ¶15. But this statement is indisputably wrong as can be seen from the various images of the devices shown in Exhibit 1012 and Exhibit 1014 respectively, and discussed in the immediately preceding section, The two devices are not identical and, in fact, have many differences. Thus, Mr. Taylor's vague, uncorroborated, unreliable, and biased statement about the alleged prior art does not establish that the Exhibit 1014 device was publicly known prior

to the application for the '111 Patent.

Additionally, Exhibit 1014 does not teach, disclose, nor infer many of the elements of challenged independent claims 1 or 8 (or their challenged dependent claims). Nor does Petitioner allege that Exhibit 1014 includes these elements. Petitioner alleges only that Exhibit 1014 includes the claim 1 preamble, i.e., “a swivel mount” (Petition p. 25), and discloses claim 1’s “the swivel element is arranged such that the elongated mounting plate is able to swivel about an axis that is perpendicular to and passing through the first face of the elongated mounting plate at a point spaced from a widthwise center line of the elongated mounting plate.” (Petition p. 27).

Aside from the claim 1 preamble and a single claim 1 element, Petitioner did not allege that Exhibit 1014 discloses any element of any of the challenged claims. Petitioner does not allege that Exhibit 1014 discloses (and Exhibit 1014 does not disclose):

- Claim 1: the “elongated mounting plate”;
- Claim 1: the “support plate ... [having] a length less than or equal to half a length of the elongated mounting plate”;
- Claim 1: “a swivel element”;
- Claim 1: “the first faces of the support plate and the elongated mounting plate are parallel”;

- Claim 1: “the swivel element, the support plate, and the elongated mounting plate at least partially overlap each other”;
- Claim 8: “a swivel mount disposed above an upward facing surface of the gunnel such that a mounting member of the swivel mount is able to swivel about an axis that is perpendicular to and passes through the upward facing surface of the gunnel”;
- Claim 8: “wherein the swivel mount comprises a support member fastened to the upward facing surface of the gunnel via one or more bolts or screws through the upward facing surface of the gunnel”; and
- Claim 8: “a trolling motor mounting bracket coupled to an upward facing surface of the mounting member.”

All of these elements are missing from Petitioner's allegations about the Exhibit 1014 device. *See, e.g.*, Petition pp. 25-31 (citing Ex. 1014 in only two columns of the claim charts on Petition pp. 25 and 27).

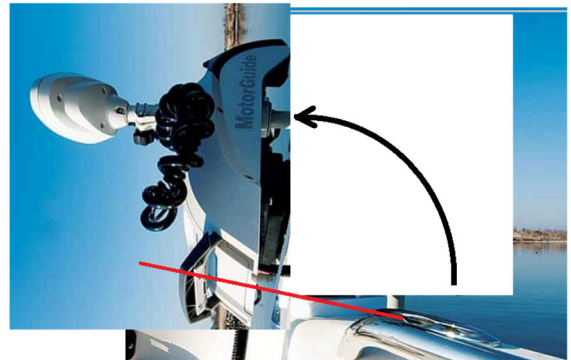
And Petitioner did not provide evidence supporting Petitioner's allegation regarding the final claim 1 element, i.e., that “the swivel element is arranged such that the elongated mounting plate is able to swivel about an axis that is perpendicular to and passing through the first face of the elongated mounting plate at a point spaced from a widthwise center line of the elongated mounting plate.”

Exhibit 1014 says nothing about (a) the orientation or existence of any axis of

rotation, (b) whether any mounting plate is present or, if present, whether it is elongated, or (c) whether any axis is “spaced from a widthwise center line of the elongated mounting plate.” *See generally* Petition.

The only evidence about the alleged swiveling of the Exhibit 1014 device are two unremarkable statements in Exhibit 1014 referring, without detail, to swiveling. At page 3, Exhibit 1014 states “the trolling motor bolts to a swiveling downrigger base attached to a quick-release bracket in the gunwale, aft of the ladder.” And at page 11, Exhibit 1014 states, “The trolling motor mounts to a swivel base to keep it from impeding the bow ladder.” Neither statement refers to whether the device has a single axis of rotation or multiple/adjustable axes of rotation, nor whether the axis of rotation is horizontal or vertical. A device as pictured could have any of these configurations, none of which would anticipate the claimed axis.

For example, the pictured device might swivel about a horizontal axis that would not pass through any face of any alleged plate or through the gunnel, as depicted in the modified images below:

Excerpt from Ex. 1014 p. 11, with potential axis of rotation marked using red line	Excerpt from Ex. 1014 p. 11, showing potential rotation of motor 90 degrees (indicated by black arrow) about a horizontal axis of rotation (red line)
	

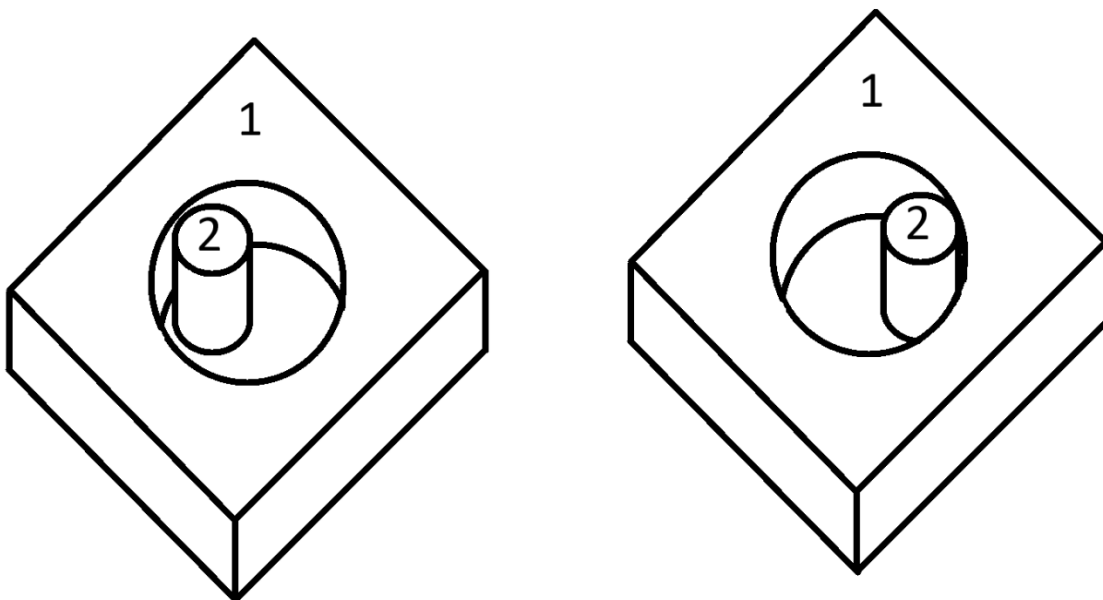
As can be seen, the Exhibit 1014 device might have swiveled about a horizontal axis (similar to the hinge 10 shown in FIG. 2 of Ex. 1009). But Exhibit 1014 offers no disclosure regarding an axis of rotation. Based on the description in Exhibit 1014, a POSITA would not have any meaningful guidance regarding the alleged axis of rotation.

Similarly, because Exhibit 1014 provides no evidence regarding whether the swivel device is above, within, or below the gunnel, one might hypothetically assume that the square/rectangular portion above the gunnel (indicated by red

rectangle below) contained the swivel:



The swivel might be configured to swivel about multiple axes or a constantly varying axis. For example, the swivel might have the structure below, with an opening larger than the shaft, allowing the axis of rotation of the block to “float” to different points, resulting in multiple different axes of rotation:



In the above structure, block 1 might move freely from side to side with respect to shaft 2, as indicated in the two images. Block 1 might rotate about the walls of shaft 2 as shaft 2's wall contacts block 1's wall. Or block 1 might rotate freely without contact between the walls of block 1 and shaft 2, either while stationary or while moving laterally. Neither Exhibit 1012 nor Exhibit 1014 disclose any information regarding the how the two different disclosed devices may or may not rotate or swivel.

It is possible that such a structure is enclosed in the square / rectangular portion of the Exhibit 1014 device, indicated by the red square above. But one does not know, because Exhibit 1014 does not provide any enabling detail regarding its device. Exhibit 1014 does not contain any disclosure that one of ordinary skill in the art could consider as an enabling disclosure of the inventions of claims 1 or 8.

In *First Solar, Inc. v. Rovshan Sade*, IPR2023-00827 (Paper No. 13 at pp. 19-21), Nov. 16, 2023, the Board considered the difficulty of attempting to ascertain the specifics of an imprecise prior art reference. The Board noted, "Without more explanation from Petitioner, we find this insufficient to meet Petitioner's burden to show [the prior art] discloses this limitation." *Id.* at 21. The same issue is present here. Petitioner did not meet its burden to show that the prior art discloses the elements of the challenged claims.

With respect to claim 8 specifically, it is also possible that any swivel in the Exhibit 1014 device is below the white box and gunnel. This would not meet the claim 8 element directed to “a swivel mount disposed above an upward facing surface of the gunnel...”

And Exhibit 1014 does not show any means for attachment of a swivel mount to the gunnel, as claimed in claim 8: “a support member fastened to the upward facing surface of the gunnel via one or more bolts or screws through the upward facing surface of the gunnel.” Exhibit 1014 merely shows a white box placed adjacent to gunnel sections with a black device above the white box:



(Excerpt of Exhibit 1014 at p. 11). One cannot ascertain from Exhibit 1014

whether the white box is part of the gunnel or part of the swivel device, whether the white box is attached to the gunnel or placed in a hole cut into the gunnel, or whether “one or more bolts or screws” are used. Exhibit 1014 does not provide sufficient disclosure.

Finally, Exhibit 1014 does not disclose “a trolling motor mounting bracket coupled to an upward facing surface of the mounting member.” As noted above, Exhibit 1014 does not even disclose a “mounting member,” so it is unsurprising that Exhibit 1014 does not disclose a “trolling motor mounting bracket” or the mounting of such a bracket.

Again, it is not possible to know what elements the device of Exhibit 1014 may or may not include, due to the insufficient disclosure of Exhibit 1014. Thus, Exhibit 1014 does not anticipate either of independent claims 1 or 8 or any of the claims that depend from claim 1 or claim 8.

E. The Exhibit 1012 Device

As noted above, the Exhibit 1012 device is different than the Exhibit 1014 device, so the two different devices do not properly form a single reference for anticipation under 35 U.S.C. §102. For example, the Exhibit 1012 device has a central portion that appears to have a circular cross-section and is narrower than the base portion, while the Exhibit 1014 device's central portion appears to be

square/rectangular and is wider than the base portion. Additionally, the Exhibit 1012 device appears to have a release pin not present on the Exhibit 1014 device. And the black portion of the Exhibit 1012 device appears to be adjacent to the gunnel, while the black portion of the Exhibit 1014 device appears to be adjacent to a white box that is not part of the gunnel.

Moreover, Petitioner relies entirely on the unreliable testimony of biased witnesses to explain the disclosure of the Exhibit 1012 device, which lacks any reliable independent corroboration and otherwise provides no useful disclosure. Both of Petitioner's declarants have direct financial ties to Petitioner, and one declarant did not reveal such ties. Petitioner's purported expert witness, Mr. Taylor, is not an independent witness, but states, "I have been the owner and Chief Technical Officer of Shuttleslide LLC since 2018." Ex. 1003 ¶3. And Petitioner's fact witness, Mr. Trombley, completely omitted his financial ties to Petitioner. *See generally* Ex. 1013; *see also* Ex. 2015 ¶4.

However, as other testimony and evidence establishes, Mr. Trombley does have a financial interest in Petitioner succeeding in this proceeding. Ex. 2015 ¶5. Mr. Trombley is the president of a company that markets and distributes Petitioner's trolling motor mount that is accused of infringement in the related district court case. Ex. 2015 ¶¶6-9; Exs. 2016-2018. A motion for preliminary injunction was filed in that district court case. Ex. 2003. If the motion were

granted, Mr. Trombley may be cut off from a source of income; and if Patent Owner is successful in asserting patent infringement, Mr. Trombley might even be liable for some portion of the damages for patent infringement. Thus, Mr. Trombley appears to have a direct financial interest in the outcome of this proceeding, but he makes no mention of it in his declaration.

The Exhibit 1012 disclosure is also problematic in that it cannot be dated before the '111 Patent. While Mr. Trombley claims to have taken the photographs that appear in Exhibit 1012 (*see* Ex. 1013 ¶4), he does not make any allegations or statements about the age of the Exhibit 1012 device or the age of the photos. Nor does he provide any evidence that corroborates the age of the Exhibit 1012 device. Mr. Trombley states, that Exhibit 1012 contains “copies of photographs that I took of the boat I purchased on April 22, 2023.” Ex. 1013 ¶4. Notably, this paragraph does not claim that the photographs were taken any time before the priority date of the '111 Patent. And this paragraph does not state that the Exhibit 1012 device was present on the boat before the priority date. The paragraph is very specific in mentioning that it is “photographs that I took of the boat”, but does **not** include language that would confirm the mount was present at the time he purchased the boat, such as “photographs that I took of the *trolling motor mount that was attached to the* boat when I purchased it ...” It is possible that the device was

installed and the photos taken on the day that Mr. Trombley signed his declaration.

Mr. Trombley never claims that the trolling motor mount was part of the boat at the time of purchase. *See generally* Ex. 1013. And the purported bill of sale provided as Exhibit 1015 does not make any mention of the trolling motor mount, despite making specific mention of several other devices including: “Minn Kota Ulterra 72” Trolling Motor”, “Dual 10’ Power Poles on Jack Plate”, “Bow Casting Platform”, “Underwater Lights”, etc. Ex. 1015.

The purported expert Mr. Taylor makes no claim to have had knowledge of the Exhibit 1012 device prior to the priority date of the ‘111 Patent.

As discussed above, corroboration is required of testimony of a witness who claims to be providing prior art. And the photos do not corroborate a date. Thus, corroboration of the date of the device in Ex. 1012 is absent.

Petitioner did not provide sufficient evidence to establish that the Exhibit 1012 device was publicly known before the priority date of the ‘111 Patent.

Turning to the substantive disclosures of the Exhibit 1012 device, even if the device were sufficiently corroborated and if the device predated the priority date of the ‘111 Patent, the evidence does not show that the Exhibit 1012 device anticipates the challenged claims of the ‘111 Patent including independent claims 1 and 8 and their challenged dependent claims.

Exhibit 1012 does not show or otherwise disclose the claimed second “opposing face” on either the claimed “elongated mounting plate” or the claimed “support plate” of claim 1. In the annotated figures provided in the Petition, Petitioner denotes a “first opposing face” on Petition p. 22 and two “first opposing face[s]” on Petition p. 23, but does not ever indicate a “second opposing face. It is not apparent from these images (or any evidence of the Exhibit 1012 device) whether the alleged “support plate” has a “second opposing face” or whether it merely extends into a hole cut into the gunnel. Similarly, it is not apparent whether the alleged “elongated mounting plate” has a “second opposing face” or whether it extends into a hole in the black portion of the trolling motor. As is shown at Petition p. 22, the trolling motor has at least one hole cut into its black surface and might have another behind the alleged “elongated mounting plate.” Mr. Trombley does not address this in his testimony. *See generally* Ex. 1013.

And purported expert Taylor does not provide any basis for testifying as to this aspect of the device. Mr. Taylor does not allege any familiarity with the Exhibit 1012 device outside of the photos. *See generally* Ex. 1003. Yet, Mr. Taylor erroneously opines that “As shown above in Annotated Fig. 2 of Exhibit Shuttleslide 1012 an elongated mounting plate comprising first and second opposing faces spaced apart by one or more peripheral sidewalls is disclosed...” Ex. 1003 ¶26. Notably, neither “Annotated Fig. 2” nor any figure appears in Ex.

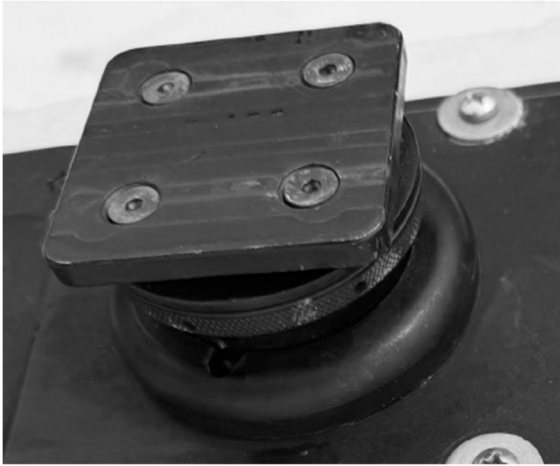
1003. It appears that Mr. Taylor's purported opinion testimony on this issue was merely copied and pasted from the Petition; an annotated Fig. 2 appears at Petition p. 22 and Mr. Taylor's ¶26 is identical to the first sentence that appears in the upper-right box on Petition p. 26. Mr. Taylor merely copied his opinion from the Petition. The same is true for Mr. Taylor's paragraphs 27, 28, and 29 that address the "second opposing face" on the plates; these opinions are all copied directly from the Petition at p. 26.

Mr. Taylor does not offer any facts or data on which he bases the opinions about the "second opposing face[s]." He merely parrots the Petition without explaining why someone would infer that a face that is not visible nor suggested by the photographs is present. For this reason, the opinion testimony about the "second opposing face[s]" is "entitled to little or no weight." 37 C.F.R. §42.65.

No evidence nor testimony entitled to weight establishes that it is more likely that the plates have second opposing faces rather than merely extending into holes or cutouts in the adjacent structures.

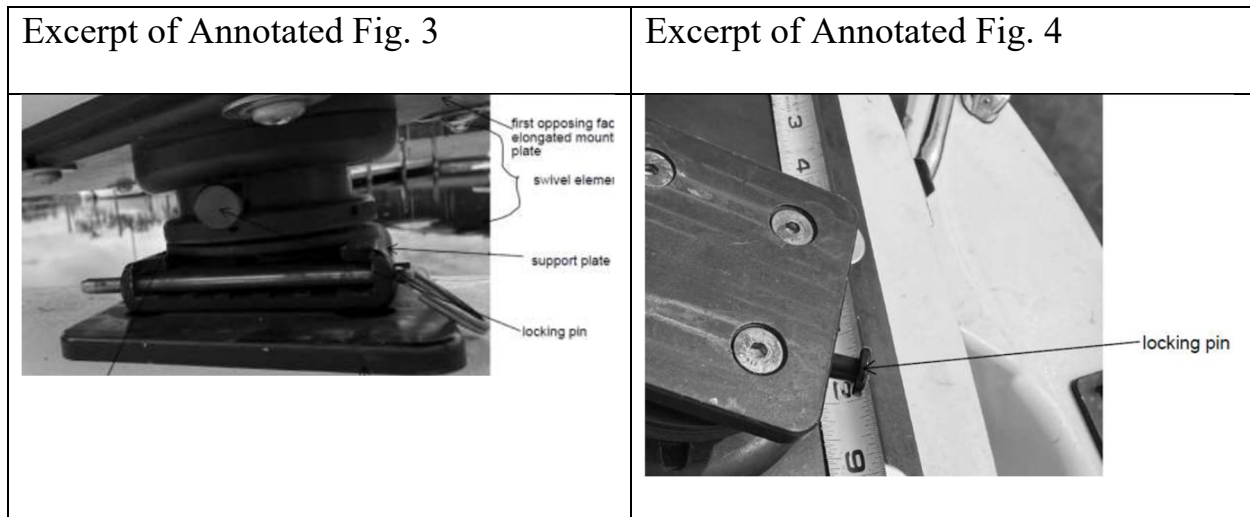
Similarly, Exhibit 1012 does not show or disclose claim 1's "swivel element ... arranged such that the elongated mounting plate is able to swivel about an axis..." or claim 8's "a swivel mount disposed ... such that a mounting member of the swivel mount is able to swivel about an axis..." Neither the photos in Exhibit

1012 nor the fact-based testimony establish that a swiveling element is present in the Exhibit 1012 device. Rather, the device includes an apparently square plate (see excerpt of Fig. 2 below) that can apparently be removed and remounted in four different orthogonal orientations in a base (see excerpt from FIG. 5 below):

Excerpt of Ex. 1012 Fig. 2	Excerpt of Ex. 1012 Fig. 5
	

Ex. 1012 pp. 2, 5. The Exhibit 1012 device also has an element identified by Petitioner as a “locking pin”, suggesting the cylindrical portion can be unscrewed or otherwise detached from the square plate (above) and then reattached in a different orientation and locked into place. The “locking pin” is identified by

Petitioner in annotated Figs. 3 and 4, excerpts of which are reproduced below:



Petition pp. 23, 24.

Mr. Trombley does not testify or suggest that the device swivels. *See generally* Ex. 1013. And purported expert Mr. Taylor does not claim to have any familiarity with the device outside of the photos. *See generally* Ex. 1003. Again, Mr. Taylor's alleged opinion about the swivel element is merely copied from the petition and is totally unsupported. *Compare* Ex. 1013 ¶¶33, 40 to identical text copied from Petition pp. 27, 28.

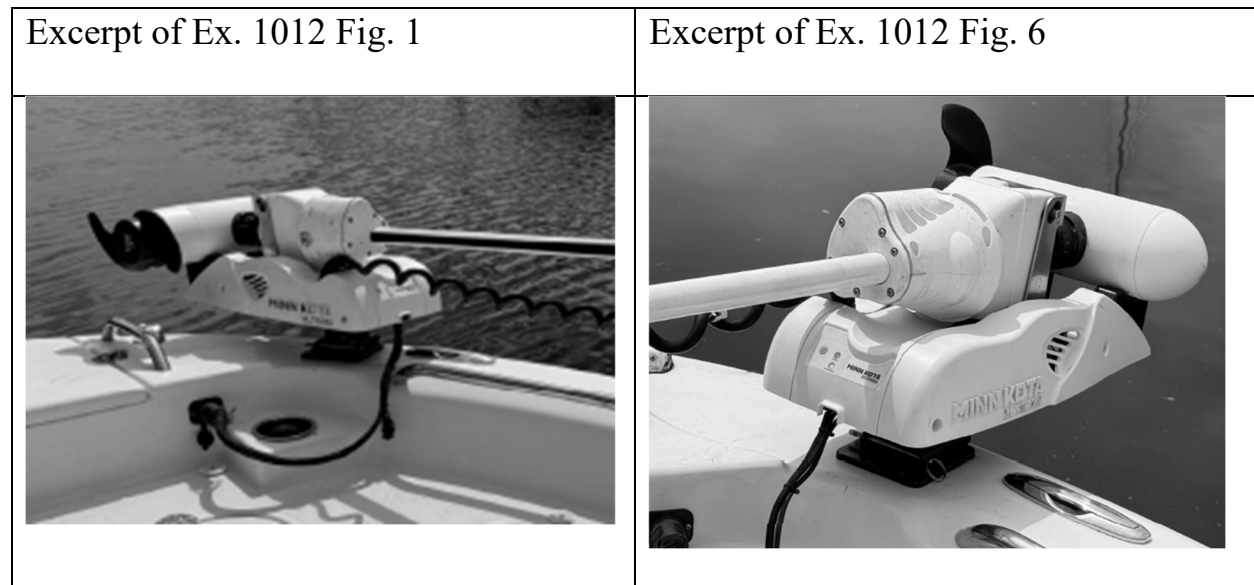
Mr. Taylor does not offer any facts or data on which he bases the opinions about the swiveling. He merely parrots the Petition without explaining why someone would infer that swiveling that is not visible nor suggested by the photographs is present. For this reason, the opinion testimony about the "second opposing face[s]" is "entitled to little or no weight." 37 C.F.R. §42.65.

Further, Mr. Taylor copies language from Petition p. 27 into his opinion

paragraphs 36 and 37, referencing Ex. 1012 Figs. 1 and 6, to suggest that showing the motor in a first position and second position suggests swiveling. But Mr.

Taylor does not state that a POSITA would understand that swiveling was present nor how a POSITA would make such an inference from the photos presented.

Rather, as can be seen in the referenced photos (below), the motor is merely arranged at 90-degree orthogonal angles in the two photos:

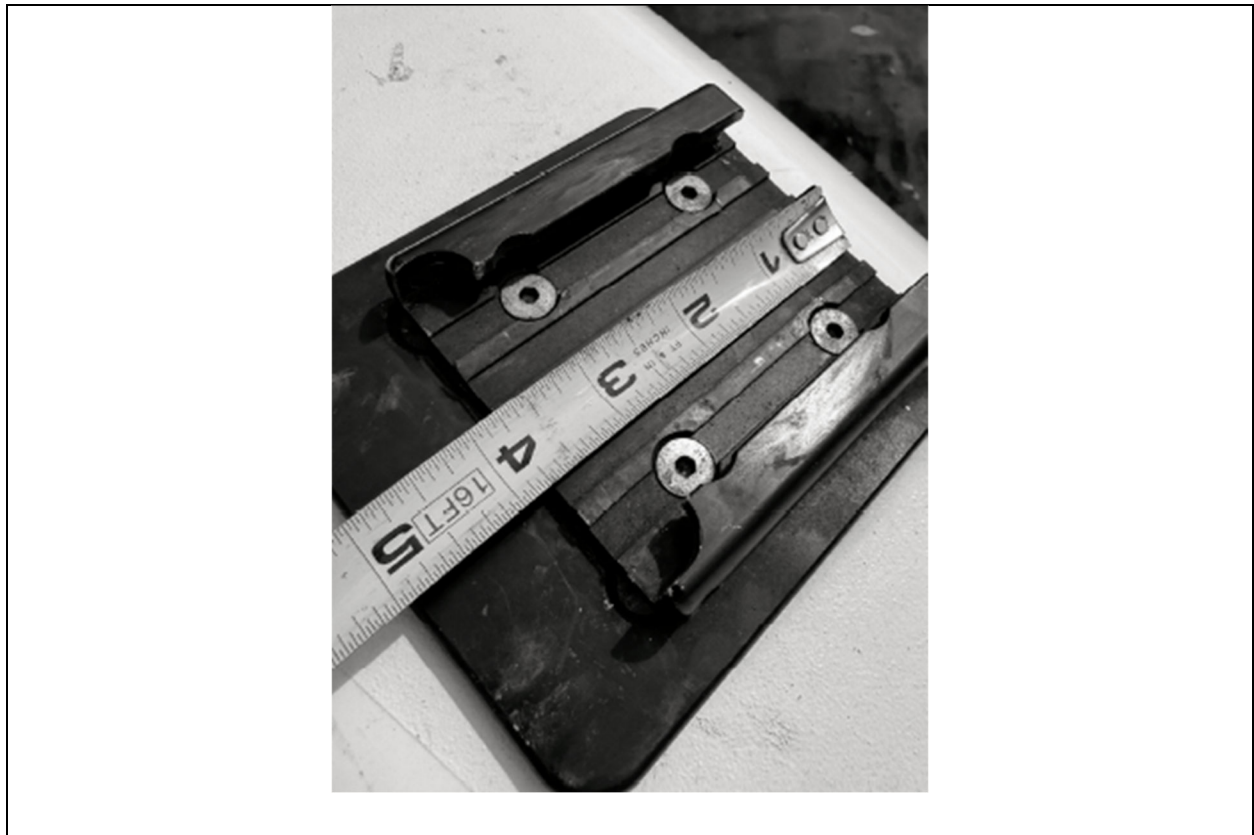


Ex. 1012 pp. 1, 6.

Arranging the motor at two 90-degree orthogonal angles does not disclose nor suggest swiveling any more than it suggests removing the square plate from the base and replacing the square plate in the base at a 90-degree angle.

No evidence nor testimony entitled to any weight establishes that it is more likely that the Exhibit 1012 device swivels than that the device is repositioned by removing the square plate from the base and repositioning it.

Similarly, Exhibit 1012 does not show “a support member fastened to the upward facing surface of the gunnel via one or more bolts or screws through the upward facing surface of the gunnel.” At Fig. 5, Exhibit 1012 shows circular objects that might (or might not) be bolts or screws:



Excerpt of Ex. 1012 p. 5, Fig. 5.

But there is no disclosure regarding whether these objects are actually bolts or screws (versus another type of circular metal object) nor whether these objects extend “through the upward facing surface of the gunnel.” Indeed, it is possible, and likely, that these objects connect the two black portions of the Exhibit 1012

device that are shown in Fig. 5 and that they do not extend through the gunnel surface.

Mr. Trombley does not testify nor suggest that these items are bolts or screws or that they extend through the gunnel surface. *See generally* Ex. 1013. And purported expert Mr. Taylor does not claim to have any familiarity with the device outside of the photos. *See generally* Ex. 1003. Mr. Taylor's alleged opinion about the "bolts or screws through the upward facing surface of the gunnel" is merely copied from the petition and totally unsupported. *Compare* Ex. 1013 ¶51 to identical text copied from Petition p. 31.

Mr. Taylor does not offer any facts or data on which he bases the opinions about the bolts or nuts. He merely parrots the Petition without explaining why someone would infer that "bolts or screw through the upward facing surface of the gunnel" that is not visible nor suggested by the photographs is present. For this reason, the opinion testimony about the "second opposing face[s]" is "entitled to little or no weight." 37 C.F.R. §42.65.

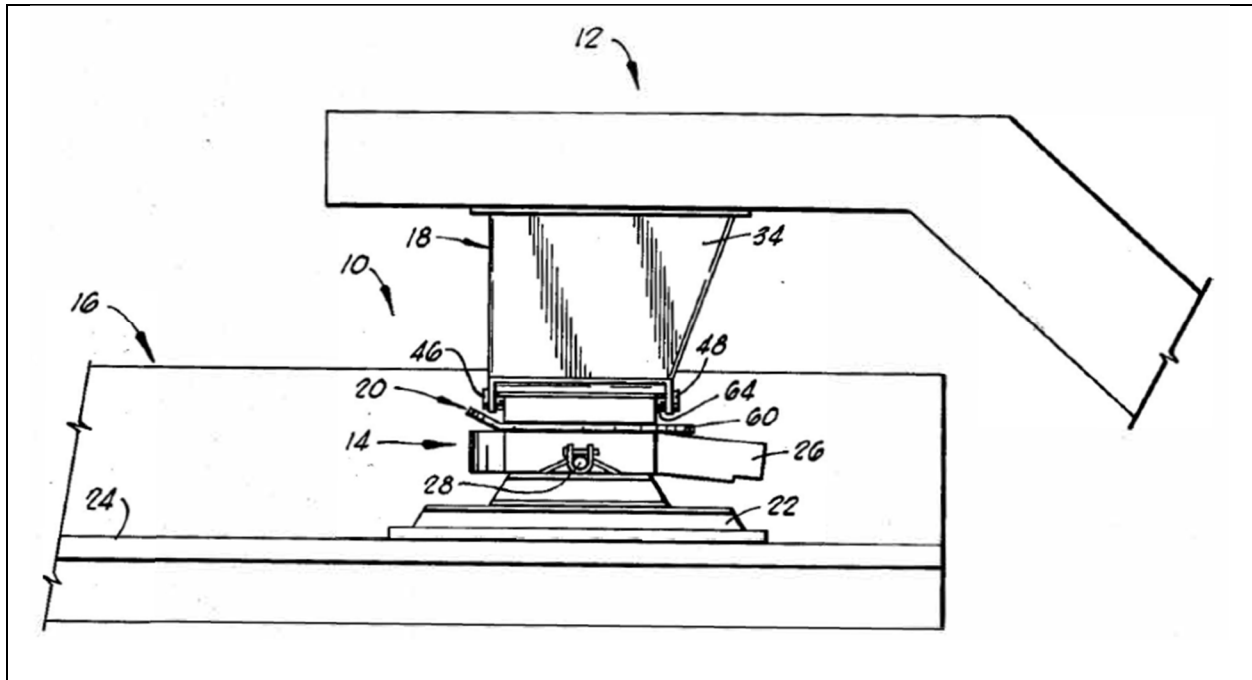
It is not possible to know what elements the device of Exhibit 1012 may or may not include due to the insufficient disclosure of Exhibit 1012. Thus, Exhibit 1012 does not anticipate either of independent claims 1 or 8 or any of the claims that depend from claim 1 or claim 8.

Accordingly, Petitioner's ground 1 does not provide a basis for instituting a PGR.

V. Breford – Ground 2 – Claim 1

Petitioner incorrectly asserts that claim 1 is unpatentable as anticipated by Breford (Ex. 1004). Breford does not anticipate claim 1 for at least two reasons. First, Breford is non-analogous art, in that it describes a “tractor-trailer connector” rather than a device for mounting objects on a boat. Ex. 1004 p. 1. Second, Breford lacks at least three elements required by claim 1.

Breford discloses a “tongue portion of a trailer 12” having a “pin box structure [10]” attached to it (see from Ex. 1004 cover, below). The pin box 10 includes a horizontally-oriented “shaft 65” extending between “shaft support members 46 and 48” that allow the tongue portion 12 to rotate about an axis that is parallel to both the tongue portion 12 and the frame structure 22. *See, e.g.*, Ex. 1004 col. 3:49-4:16. “Preferably, the upper member 18 is constructed such that it will pivot to the side approximately 45° from the vertical in both directions.” *Id.* at 4:14-16.



Breford's device was designed to avoid the use of a "ball and socket" trailer hitch (Ex. 1004 col. 1:5-34) while allowing "the trailer to be coupled with the tractor vehicle when the two vehicles are on an uneven terrain and when there is an angular displacement between the two vehicles." *Id.* col. 4:30-35.

Breford is in an entirely different field of use, is unrelated to attaching motors to boats, and is unrelated to mounting devices having a mounting plate. Breford is non-analogous art.

Moreover, Breford is missing at least three required elements of claim 1. However, "a prior art reference must provide every element of the claimed invention arranged as in the claim in order to anticipate." *Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1069 (Fed. Cir. 2017). In this instance, Breford lacks

(1) “an elongated mounting plate...”, (2) “a swivel element, wherein ... the first faces of the support plate and the elongated mounting plate are parallel...”, and (3) “the elongated mounting plate is able to swivel about an axis that is perpendicular to and passing through the first face of the elongated mounting plate...”

First, Breford is missing the claimed “elongated mounting plate.” Petitioner alleges that Breford’s trailer “tongue portion 12” is the “elongated mounting plate.” Petition p. 34. However, Breford makes no suggestion that a trolling motor (nor any other device) can be received and secured or attached on the tongue portion 12. Rather, the tongue portion of a trailer is merely an extension of the trailer that can be hitched to a tractor vehicle. And neither Petitioner nor Petitioner’s purported expert alleges that Breford’s tongue portion 12 is configured for receiving and securing/attaching an external device. Thus, Breford is missing the “elongated mounting plate.”

Second, Breford’s device is specifically designed to take the faces of the trailer tongue portion 12 out of a parallel arrangement with frame 22. Petitioner alleges that Breford’s tongue portion 12 is the claimed “elongated mounting plate” and that Breford’s frame structure 22 is the claimed “support plate.” Petition pp. 34 and 35. Petitioner continues, alleging that frame structure 22 and tongue portion 12 “are parallel.” However, as noted above, Breford’s shaft 65 is specifically and intentionally designed by Breford to pivot the face of the trailer

tongue 12 out of a parallel relationship with the face of the frame structure 22.

Breford is designed “to allow free side to side pivoting motion of the trailer relative to the towing vehicle...” and to “provide for pivoting motion between the trailer and the fifth wheel trailer hitch pivotable about an axis generally aligning longitudinally with the trailer to permit side to side pivoting of the trailer relative to the towing vehicle.” Ex. 1004 col. 1:45-58. Thus, Breford lacks the claimed “first faces of the support plate and the elongated mounting plate are parallel.”

Finally, Breford lacks the swiveling of the mounting plate about an axis perpendicular to and passing through the first face of the elongated mounting plate. While Patent Owner asserts that the mounting plate is entirely missing, this element is missing even if one assumes (for the sake of argument) that tongue portion 12 is a mounting plate. As noted, above, Breford's shaft 65 is specifically designed to pivot the face of tongue portion 12 from side to side about the axis of shaft 65. Thus, the alleged “swivel axis” identified by Petitioner at Petition p. 34 will not be perpendicular to the face of tongue portion 12.

The absence of any one claim element in a prior art reference removes that reference from being an anticipatory reference. Here, three elements of claim 1 are missing from Breford's disclosure. Thus, Breford does not anticipate claim 1. Accordingly, Petitioner's ground 2 does not provide a basis for instituting a PGR.

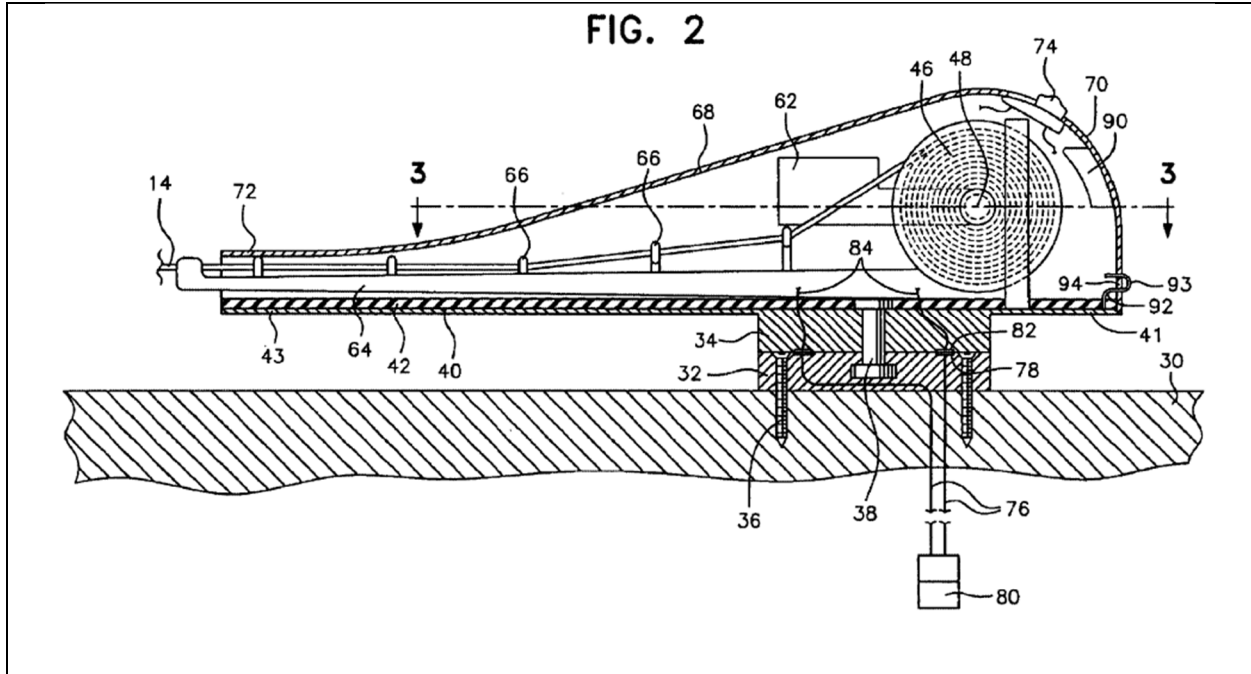
VI. Gillespie – Ground 3 – Claims 1-4

Petitioner incorrectly asserts that independent claim 1 and its dependent claims 2-4 are unpatentable as anticipated by Gillespie (Ex. 1005). Gillespie does not anticipate claim 1 (or its dependent claims) for at least two reasons. First, Gillespie is non-analogous art, in that it describes a “downrigger” rather than a device for mounting objects. Ex. 1005 p. 1. Second, Gillespie lacks the “mounting plate” element required by claim 1.

But, “a prior art reference must provide every element of the claimed invention arranged as in the claim in order to anticipate.” *Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1069 (Fed. Cir. 2017). In this instance, Gillespie lacks the claimed “mounting plate” of claim 1.

As illustrated in Gillespie's Fig. 2 (reproduced below), Gillespie discloses a downrigger assembly that includes a pivoting feature for attachment to a gunnel and pivoting about a vertical axis. Ex. 1005 col. 4:4-21. Gillespie's downrigger

comprises several parts, including a reel 46, a downrigger line 14, guides 66, and a cover 68, among others. *Id.* col. 4:31-67.



U.S. Pat. No. 6,684,558 Fig. 2.

Gillespie is unrelated to mounting trolling motors on a boat. Gillespie discloses an assembly for deep-sea fishing. Gillespie's downrigger is a device for deploying a weighted line that is designed to hold a fishing line deep underwater. The purpose is entirely different from the purpose of a trolling motor. A trolling motor is designed to apply force to a boat to push (or pull) it through the water. The considerations of design in these two, entirely-different applications render them unrelated.

Importantly, Gillespie makes no suggestion that his disclosure provides any type of "mounting plate" or other mounting device. A mounting plate is

specifically configured for receiving and securing an object thereon. Gillespie does not teach nor suggest mounting any devices on his outrigger.

Petitioner provides no basis for suggesting that Gillespie's plate 34 would be considered to be a "mounting plate" by a POSITA. Notably, Petitioner's purported expert witness did not testify that a POSITA would have considered Gillespie's plate to be a "mounting plate." *See generally* Ex. 1003.

Petitioner alleges without evidence, "Gillespie discloses an elongated mounting plate, which is referred to as the upper plate 34." Petition p. 39. However, Gillespie does not suggest that "upper plate 34" is a "mounting plate." And Petitioner's alleged expert gave no testimony suggesting that a POSITA would have considered "upper plate 34" to be a "mounting plate." Rather, "upper plate 34" is nothing more than a portion of Gillespie's downrigger.

Additionally, Petitioner's assertions regarding "undue experimentation" are not supported by evidence, but are merely attorney argument.

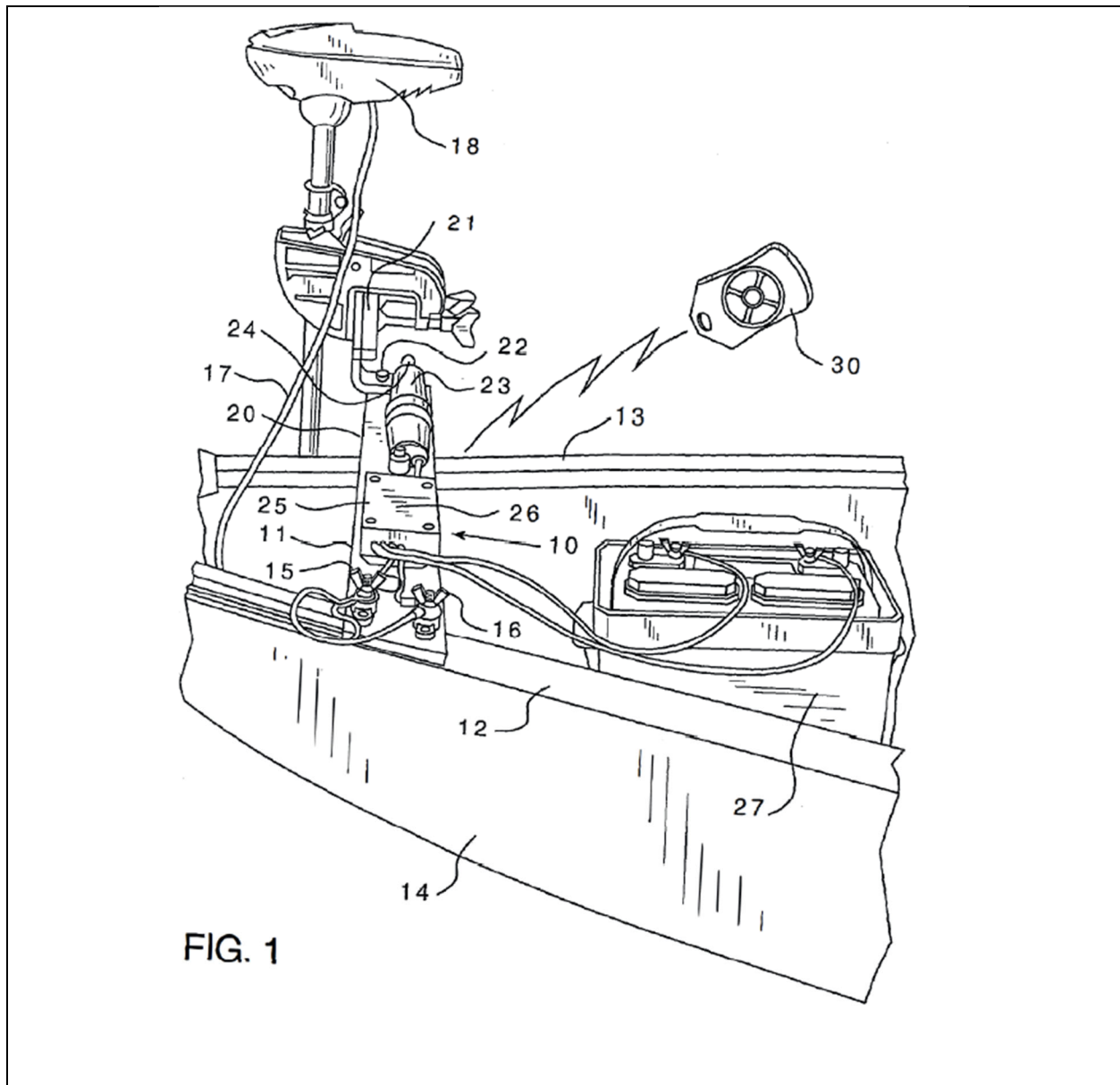
Petitioner did not carry its burden to put forward evidence that Gillespie discloses all elements of challenged independent claim 1 or any of its dependent claims 2-4. The absence of any one claim element in a prior art reference removes that reference from being an anticipatory reference. Here, the "mounting plate" element of claim 1 is missing from Gillespie's disclosure. Thus, Gillespie does not anticipate claim 1, and for the same reason does not anticipate dependent claims 2-

4. Accordingly, Petitioner's ground 3 does not provide a basis for instituting a PGR.

VII. Leiss – Ground 7 – Claim 8

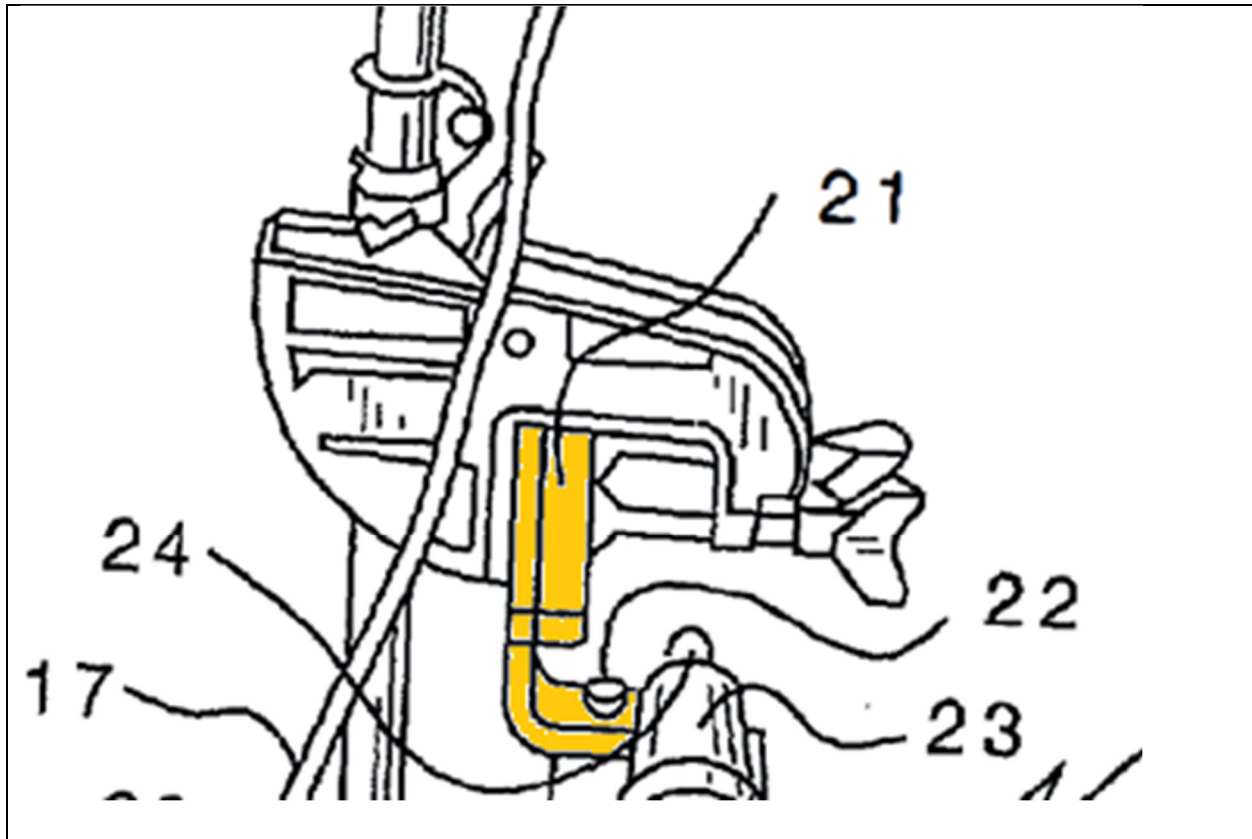
Petitioner incorrectly asserts that independent claim 8 is unpatentable as anticipated by Leiss (Ex. 1006). Leiss does not anticipate claim 8 because Leiss is missing multiple claimed elements.

Leiss discloses a trolling motor mount for a small boat or canoe. Ex. 1006 ¶0016. As depicted in FIG. 1 (reproduced below), Leiss's motor mount comprises a plank 11 attached across the gunnels 12 and 13. A motor mount bracket 21 is rotatable about a vertical axis 22 for steering trolling motor 18. In Fig. 1, it is apparent that the vertical axis 22 overhangs the water outside of the boat and does not pass through the gunnel.



Ex. 1006 Fig. 1.

An excerpt of Fig. 1, showing a close-up view of Leiss's motor mount bracket 21 is set forth below. In this excerpt, motor mount bracket 21 has been highlighted with color. It is apparent that bracket 21 is L-shaped and that trolling motor 18 is attached to a sideways-facing surface of bracket 21.



Leiss does not anticipate claim 8 because Leiss is missing at least three elements of claim 8.

First, Leiss does not disclose “a swivel mount disposed above an upward facing surface of the gunnel such that a mounting member of the swivel mount is able to swivel about an axis that is perpendicular to and passes through the upward facing surface of the gunnel.” As can be seen in Leiss Fig. 1, Leiss’s plank overhangs a side of the boat such that axis 22 is over water, not over a gunnel. This is confirmed by Leiss’s claim 1 as well. Leiss’s claim is directed to “plank means having ... a portion of said plank means overhanging a side of the boat”

and “said overhanging portion of said plank means having a motor mount bracket secured thereto ...” Ex. 1006 claim 1. Nothing in Leiss discloses swiveling about an axis that passes through the upward facing surface of the gunnel.

Second, Leiss does not disclose both the claimed “mounting member” and the claimed “trolling motor mounting bracket coupled to an upward facing surface of the mounting member” of ‘111 Patent claim 8. Leiss discloses only a “motor mount bracket 21,” rather than disclosing two elements. Ex. 1006 ¶0018. Some care should be used here to understand how certain terms are used in Leiss. For example, Leiss uses the term “motor mount bracket” to describe a component that functions similar to the ‘111 Patent claim 8’s “mounting member”, even though Leiss uses terminology that sounds like claim 8’s “trolling motor mounting bracket.” However, as can be seen in the excerpt of Leiss Fig. 1, above, Leiss’s motor mount bracket 21 is an L-shaped item through which the axis of rotation passes, such that Leiss’s motor mount bracket “is able to swivel about an axis” similar to the ‘111 Patent claim 8’s “mounting member.” This is functionally and structurally different from the term “motor mount bracket” as used in claim 8 of the ‘111 Patent.

Claim 8 includes a distinct and separate element called a “trolling motor mounting bracket” that is “coupled to ... the mounting member.” Thus, it is clear from the claim language that both items would need to be present to anticipate the

claim. The '111 Patent specification confirms this as well: "The boat further includes a trolling motor mounting bracket coupled to an upward facing surface of the mounting member." Ex. 1001 col. 2:32-35. It further states, "In some cases, a trolling motor mounting bracket (such as but not limited to a quick-release trolling motor mounting puck and/or a trolling motor deploy/stow mechanism) may be coupled to the swivel mount. In addition or alternatively, a trolling motor may be coupled to the swivel mount. In yet further embodiments, the swivel mount (with or without the trolling motor mount and/or trolling motor) may be ..." Ex. 1001 col. 4:30-39. And the specification states, "As shown in FIG. 12, top plate 66 is elongated, offering an extended platform on which to secure an object, such as but not limited to a trolling motor mounting bracket." Ex. 1001 col. 14:27-30.

Thus, based on the quoted language in the preceding paragraph, it is clear that claim 8's "mounting member" and "trolling motor mounting bracket" are different elements that can be coupled together. It is also clear that the "trolling motor mounting bracket" and the "trolling motor" are different items; for example, the specification states "the trolling motor mount and/or trolling motor." And the specification refers to "a trolling motor mounting bracket (such as ... a quick-release trolling motor mounting puck...)" before stating, "In addition or alternatively a trolling motor may be coupled ..."

Despite this clear differentiation, the disclosure of Leiss shows only a

trolling motor 18 being attached to Leiss's element 21. And Petitioner attempts to assert that both the "mounting member" and the "trolling motor mounting bracket coupled to ... the mounting member", which are two independent components, are somehow disclosed by the same single item in Leiss, i.e., bracket 21. Bracket 21, however, is a single continuous L-shaped item that does not include the function or structure of both the claim items. Only a trolling motor is attached or "coupled" to bracket 21, without any "trolling motor mounting bracket." Leiss does not disclose both elements.

Third, claim 8 requires that the trolling motor mounting bracket be "coupled to an upward facing surface of the mounting member." Leiss does not disclose anything coupled to an upward facing surface of the mounting member. Rather, as can be seen in FIG. 1, Leiss's bracket 21 is L-shaped and Leiss's trolling motor 18 is coupled to a sideways facing surface of bracket 21. This is not described in the text, but is apparent from the depiction in Leiss's FIG. 1.

Thus, Leiss is missing at least three elements of '111 Patent claim 8. Accordingly, Petitioner's ground 7 does not provide a basis for instituting a PGR.

VIII. Gratsch in view of Leiss – Ground 8 – Claim 8

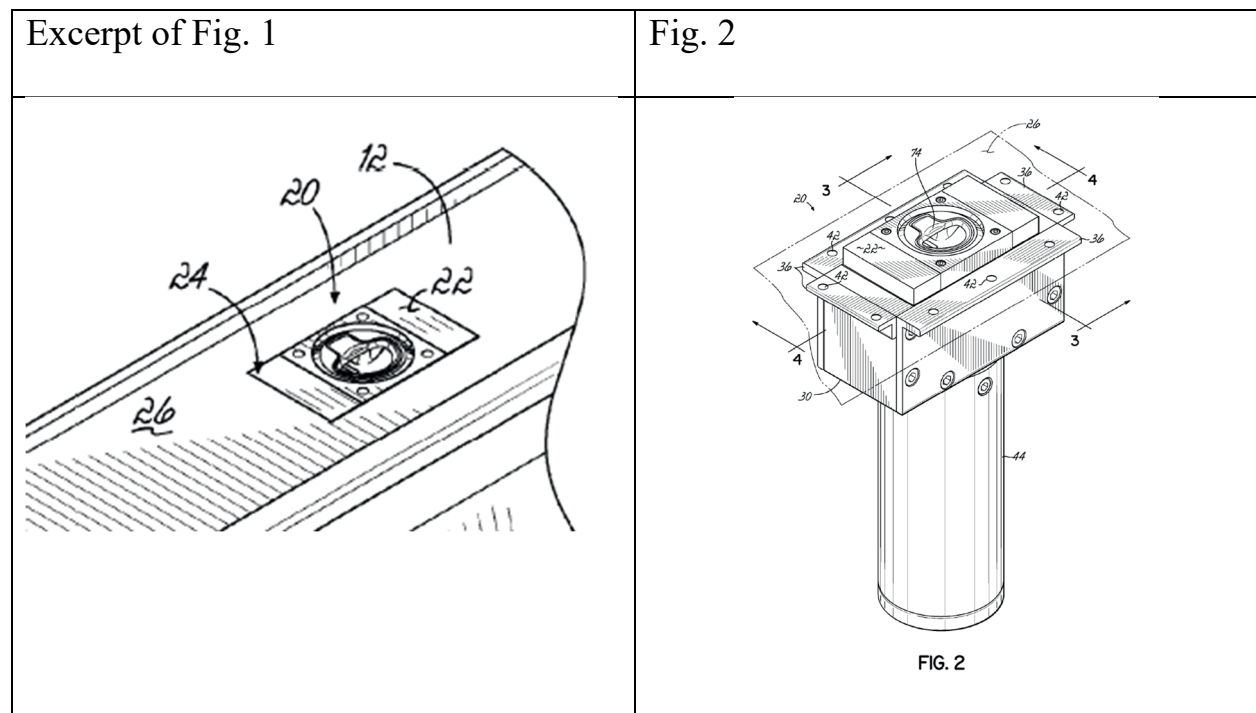
Petitioner incorrectly asserts that claim 8 is unpatentable as obvious over Gratsch (Ex. 1007) in view of Leiss (Ex. 1006). This combination does not render claim 8 unpatentable for at least two reasons. First, Petitioner does not set forth

any meaningful analysis of an alleged motivation to combine the references.

Second, the combination lacks elements required by claim 8.

As discussed above, Leiss is directed to a trolling motor mount for a canoe or small boat. Gratsch, however, is directed to an under-gunnel modular mount for a boat that is large enough to have room under the gunnel.

As shown in an excerpt of Gratsch's Fig. 1 and Fig. 2 (both reproduced below), Gratsch discloses a mounting apparatus 20. The top face 22 is "substantially flush with an exposed, accessible top surface 26 of the gunnel." Ex. 1007 ¶0025. And "One or more flanges 36 extend laterally from the housing 30 to permit coupling of the apparatus 20 to an underside 12a of the gunnel 12..." Ex. 1007 ¶0026.



Ex. 1007 at Figs. 1, 2

Neither Petitioner nor its purported expert witness provide any evidence or adequate analysis that a POSITA would have been motivated to combine Gratsch and Leiss. As the Federal Circuit has explained, “[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (emphasis added). In a recent opinion reversing a finding of motivation to combine, the Federal Circuit clarified,

The mere fact that these possible arrangements existed in the prior art does not provide a reason that a skilled artisan would have substituted [the system in one prior art reference] with the [other system in a second prior art reference]. There was no argument in the petition regarding why a skilled artisan would make this substitution—other than that the two different [systems] were "known to be used." The petition does not argue [that the second prior art reference] articulates any reason to substitute one for another or any advantages that would flow from doing so. Nor does [Petitioner's] expert, articulate any reason why a skilled artisan would combine these references.

Virtek Vision Int'l ULC v. Assembly Guidance Sys., 97 F.4th 882, 887 (Fed. Cir. 2024) (internal citation omitted). Here, similar to *Virtek*, the Petitioner's purported expert made the same omission; Mr. Taylor did not articulate any reason why a POSITA would combine Gratsch and Leiss. Mr. Taylor's entire analysis of motivation to combine is: “A person having ordinary skill in the art reading

Gratsch would have been motivated to follow the teachings of Leiss to secure the swivel mount of Gratsch to the top of the gunnel. It would have been obvious at the time of the invention to combine the plank means and bolts of Leiss with the swivel mount of Gratsch.” Ex. 1003 ¶¶64-65. This analysis is entirely insufficient and does not provide any basis for finding a motivation to combine. Mr. Taylor does not explain why a POSITA would have combined a top-mounted plank-based system for small boats or canoes with an underside-mounted, flush system for larger boats. Mr. Taylor did not provide any reason to substitute one for the other.

And the Petition similarly fails. At Petition p. 55, Petitioner states only that “There would have been a motivation to combine Gratsch and Leiss with a reasonable expectation of success because Gratsch and Leiss both describe mounting marine accessories to gunnels.” This statement provides even less reasoning for the combination than the rationale identified in *Virtek* at 97 F.4th at 887.

The combination of Gratsch and Leiss should be rejected because neither Petitioner nor Petitioner's purported expert could provide any explanation of why a POSITA would have been motivated to combine the references.

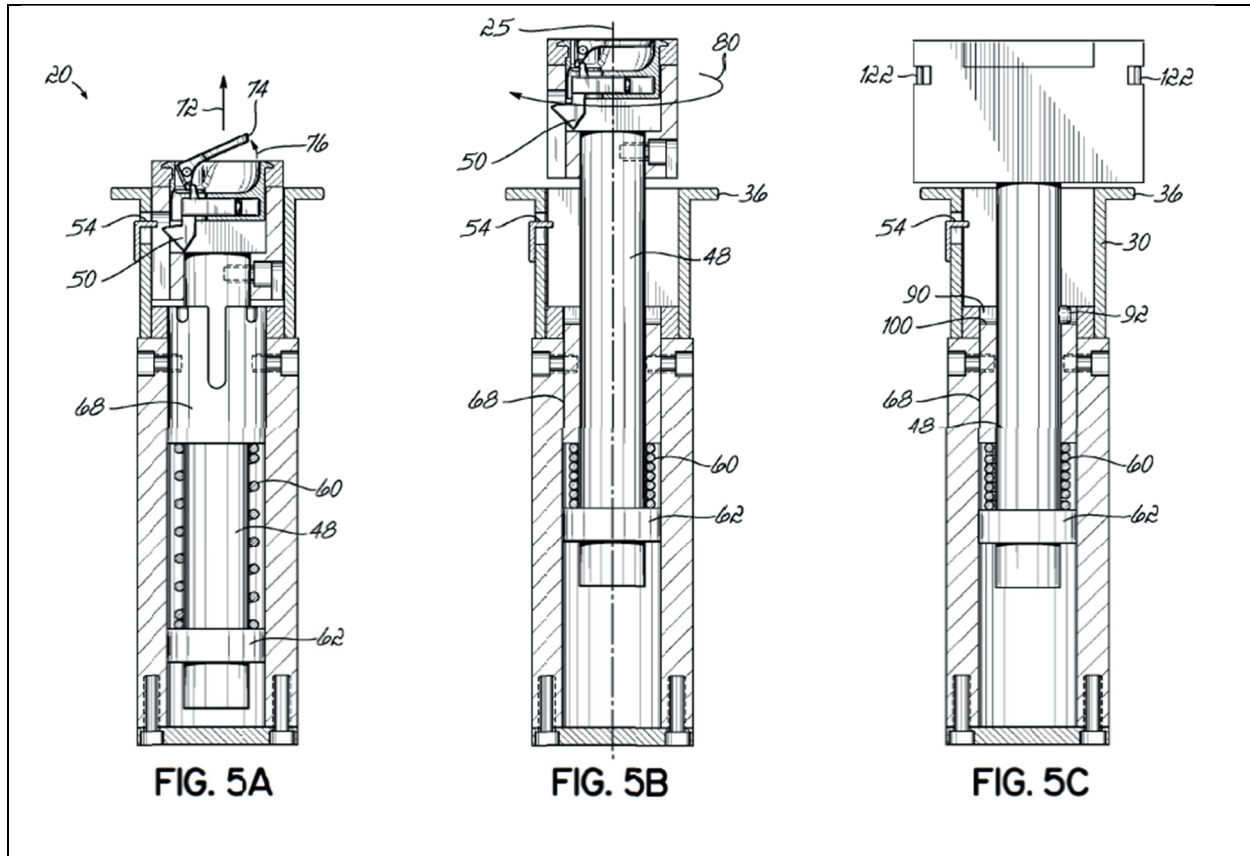
In addition, even if Gratsch and Leiss were combined, the combination would fail to disclose or suggest multiple elements of claim 8. As noted in the previous discussion of anticipation by Leiss, the Leiss disclosure fails to disclose at

least (a) “the swivel mount is able to swivel about an axis that ... passes through the upward facing surface of the gunnel”, (b) both “a mounting member” and “a trolling motor mounting bracket coupled to ... the mounting member”, and (c) the bracket being “coupled to an upward facing surface.”

Gratsch does not cure these deficiencies. Petitioner does not identify any disclosure in Gratsch of both a “mounting member” and a “trolling motor mounting bracket.” Petition p. 60. Rather, Petitioner cites only to text in Gratsch stating that “a trolling motor” may be attached to Gratsch’s device. *Id.* (citing Ex. 1007 ¶36). As noted in the discussion of Leiss (above), the ‘111 Patent clearly distinguishes between trolling motors and their mounting brackets, and the ‘111 Patent clearly requires both a “mounting member” and a separate “trolling motor mounting bracket.” Gratsch does not cure this deficiency of Leiss.

Moreover, Gratsch does not cure Leiss’s deficiency related claim 8’s “swivel mount disposed above an upward facing surface of the gunnel such that a mounting member ... is able to swivel about an axis that ... passes through the upward facing surface of the gunnel...” As noted above, Leiss’s “mounting member” is on a portion of the Leiss device that overhangs the water such that axis does not pass through the surface of the gunnel. Gratsch does not cure this element, because Gratsch does not disclose a “swivel mount disposed above an upward facing surface of the gunnel.” Rather, as can be seen in Gratsch’s FIGS. 5A, 5B, and 5C

(reproduced below), even when Gratsch's device is fully extended, the vast majority of Gratsch's device remains below, not above, the upward facing surface of the gunnel:



Ex. 1007 FIGS. 5A, 5B, 5C.

Because Petitioner did not show motivation to combine Gratsch and Leiss, and because even the combination of Gratsch and Leiss is missing elements of claim 8, these prior art references do not render claim 8 obvious. Accordingly, Petitioner's ground 8 does not provide a basis for instituting a PGR.

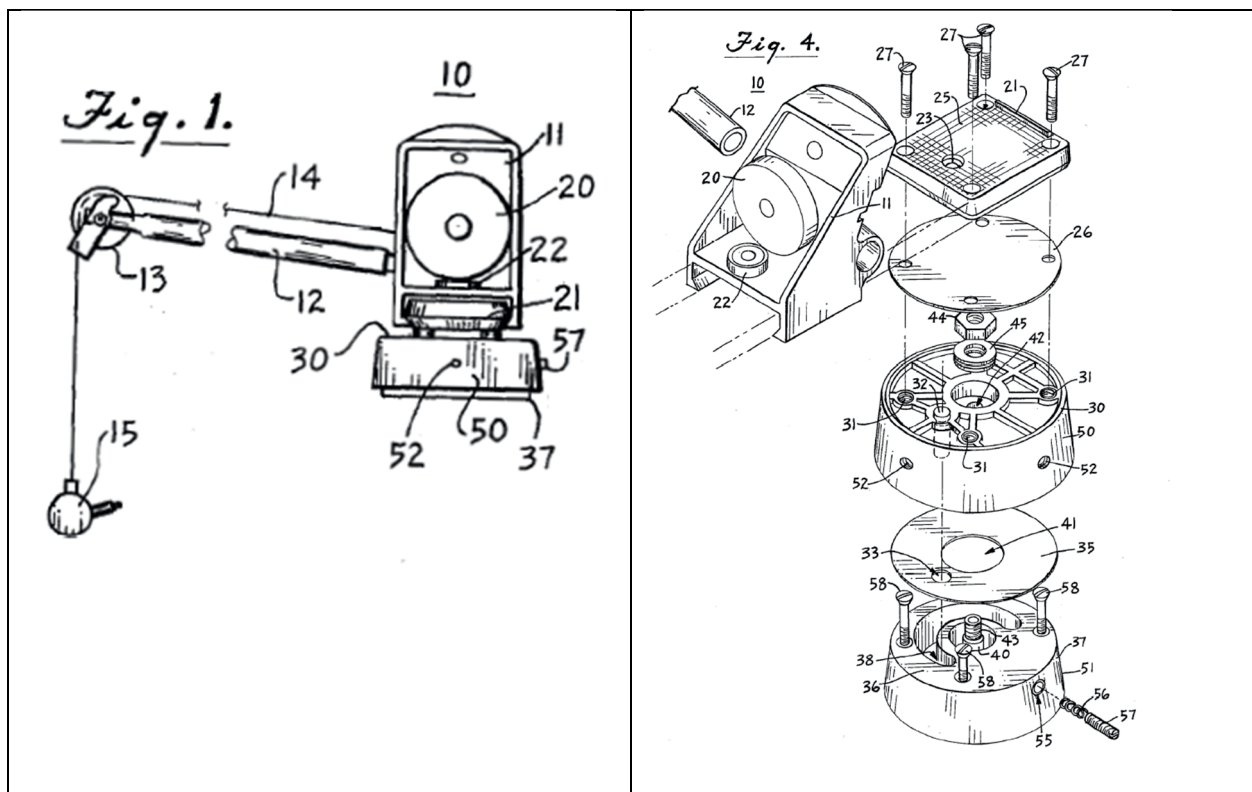
IX. Henze in view of Leiss – Ground 9 – Claim 8

Petitioner incorrectly asserts that claim 8 is unpatentable as obvious over

Henze (Ex. 1008) in view of Leiss (Ex. 1006). This combination does not render claim 8 unpatentable for at least two reasons. First, Petitioner does not set forth any meaningful analysis of an alleged motivation to combine the references. Second, the combination lacks elements required by claim 8.

As discussed above, Leiss is directed to a trolling motor mount for a canoe or small boat. Henze, however, is directed to a device for deploying a fishing line.

As shown in Henze's Fig. 1 and Fig. 2 (both reproduced below), Henze discloses a "trolling apparatus 10 for fishing includes a frame 11 which carries a boom 12 ... with a line 14 carried by the pulley 13. The line 14 has trolling weights 15 thereon..." Ex. 1008 col. 2:35-45.



Ex. 1007 at Figs. 1, 2

Henze is related to mounting a fishing line on a boat large enough to have a “deck or transom” (Ex. 1008 Abstract), while Leiss is related to mounting a trolling motor on a small boat or canoe. As shown in Henze’s Fig. 1, Henze’s device includes a lengthy boom that extends out beyond the edge of the boat. But this boom is designed for holding a fishing line that will be pulled behind the boat; it is not designed to hold a motor that will be applying significant force to the boat. This art is non-analogous, and a POSITA would not have combined the two references from different fields.

Further, neither Petitioner nor its purported expert witness provide any evidence or adequate analysis that a POSITA would have been motivated to combine Henze and Leiss. As the Federal Circuit has explained, “[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (emphasis added). As discussed above, in a recent opinion reversing a finding of motivation to combine, the Federal Circuit clarified,

The mere fact that these possible arrangements existed in the prior art does not provide a reason that a skilled artisan would have substituted [the system in one prior art reference] with the [other system in a second prior art reference]. There was no argument in the petition regarding why a skilled artisan would make this substitution—other than that the two different [systems] were “known to be used.” The petition does not argue [that the second prior art reference] articulates

any reason to substitute one for another or any advantages that would flow from doing so. Nor does [Petitioner's] expert, articulate any reason why a skilled artisan would combine these references.

Virtek Vision Int'l ULC v. Assembly Guidance Sys., 97 F.4th 882, 887 (Fed. Cir. 2024) (internal citation omitted). Here, similar to *Virtek*, the Petitioner's purported expert made the same omission; Mr. Taylor did not articulate any reason why a POSITA would combine the Henze and Leiss. Mr. Taylor's entire analysis of motivation to combine is: "A person having ordinary skill in the art reading Henze would have been motivated to follow the teachings of Leiss to secure the trolling motor mount of Leiss to the swivel mount on top of the gunnel disclosed by Henze." Ex. 1003 ¶66. This analysis is entirely insufficient and does not provide any basis for finding a motivation to combine. Mr. Taylor does not explain why a POSITA would have combined a top-mounted plank-based system for small boats or canoes with Henze's swivel base. Mr. Taylor did not provide any reason to substitute one for the other. And a brief consideration of the references demonstrates that there would have been no reason to combine them. First, Leiss already included a swivel strong enough for and configured for a trolling motor at vertical axis 22. So a POSITA would not need to add Henze's swivel base to Leiss's device. Second, the combination of Leiss's bracket 21 / vertical axis 22 with Henze's position on the deck or transom of a boat would have been impractical, because the vertical shaft of the trolling motor would need to extend

downward through the transom (or deck) and hull of the boat in such a configuration. Such a device would not be practical or useful, because one would not make a hole in the hull for deploying the trolling motor. Rather, the inventive solution of the '111 Patent proposes a cantilevered / extended upper mounting member that will swing out over the water so that the trolling motor's shaft can be extended. To avoid the unworkable solution proposed by Petitioner, it would have been necessary to attach the trolling motor to the end of Henze's fishing boom 12, so that the trolling motor could be extended over the water and the vertical shaft of the trolling motor would be separated from the boat's hull. This too would be impractical. But Petitioner does not suggest adopting Henze's boom; rather, Petitioner suggests, without explanation, something even more impractical: only that one would "follow the teachings of Leiss to secure the trolling motor mount of Leiss to the swivel mount on top of the gunnel disclosed by Henze." Petition p. 61. As noted, this would not be practical or useful.

And the Petition similarly fails to identify a motivation to combine. At Petition p. 61, Petitioner states only that "There would have been a motivation to combine Henze and Leiss with a reasonable expectation of success because Henze and Leiss both describe mounting marine accessories to gunnels. Leiss discloses securing a trolling motor mount to the upward facing surface of a gunnel.." This statement provides even less reasoning for the combination than the rationale

identified in *Virtek* at 97 F.4th at 887.

The combination of Henze and Leiss should be rejected because neither Petitioner nor Petitioner's purported expert could provide any explanation of why a POSITA would have been motivated to combine the references.

In addition, even if Henze and Leiss were combined, the combination would fail to disclose or suggest multiple elements of claim 8. As noted in the previous discussion of anticipation by Leiss, the Leiss disclosure fails to disclose at least (a) "the swivel mount is able to swivel about an axis that ... passes through the upward facing surface of the gunnel", (b) both "a mounting member" and "a trolling motor mounting bracket coupled to ... the mounting member", and (c) the bracket being "coupled to an upward facing surface."

Henze does not cure these deficiencies. Petitioner admits, "Henze does not disclose a trolling motor mounting bracket, coupled to an upward facing surface of the mounting member." Petition p. 67.

Moreover, Henze does not cure Leiss's deficiency related claim 8's "swivel mount disposed above an upward facing surface of the gunnel such that a mounting member ... is able to swivel about an axis that ... passes through the upward facing surface of the gunnel..." As noted above, Leiss's "mounting member" is on a portion of the Leiss device that overhangs the water such that axis does not pass through the surface of the gunnel. Henze does not cure this element, because

Henze does not disclose a “swivel mount disposed above an upward facing surface of the gunnel.” Rather, Henze states, “The swivel base is fastened to the deck or transom of the boat...” Neither the deck nor the transom are “a gunnel”; they are distinct elements of a boat. Thus, Henze does not disclose devices on gunnels.

Finally, as noted above in the analysis of Leiss, Leiss does not disclose that the trolling motor mounting bracket is coupled to “an upward facing surface.” Rather, Leiss’s trolling motor is mounted directly to a sideways facing surface. Henze does not make any suggestion of coupling anything to “an upward facing surface of the mounting member.” Thus, Henze does not cure the deficiencies of Leiss.

Because Petitioner did not show motivation to combine Henze and Leiss, and because even the combination of Henze and Leiss is missing elements of claim 8, these prior art references do not render claim 8 obvious. Accordingly, Petitioner’s ground 9 does not provide a basis for instituting a PGR.

X. Henze in view of Gratsch – Ground 10 – Claim 8

Petitioner incorrectly asserts that claim 8 is unpatentable as obvious over Henze (Ex. 1008) in view of Gratsch (Ex. 1007). This combination does not render claim 8 unpatentable for at least two reasons. First, Petitioner does not set forth any meaningful analysis of an alleged motivation to combine the references.

Second, the combination lacks elements required by claim 8.

As discussed above, Henze is directed to a device for deploying a fishing line. Gratsch, however, is directed to an under-gunnel modular mount.

Neither Petitioner nor its purported expert witness provide any evidence or adequate analysis that a POSITA would have been motivated to combine Gratsch and Henze. As the Federal Circuit has explained, “[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (emphasis added). As discussed above, in a recent opinion reversing a finding of motivation to combine, the Federal Circuit clarified,

The mere fact that these possible arrangements existed in the prior art does not provide a reason that a skilled artisan would have substituted [the system in one prior art reference] with the [other system in a second prior art reference]. There was no argument in the petition regarding why a skilled artisan would make this substitution—other than that the two different [systems] were "known to be used." The petition does not argue [that the second prior art reference] articulates any reason to substitute one for another or any advantages that would flow from doing so. Nor does [Petitioner's] expert, articulate any reason why a skilled artisan would combine these references.

Virtek Vision Int'l ULC v. Assembly Guidance Sys., 97 F.4th 882, 887 (Fed. Cir. 2024) (internal citation omitted). Here, similar to *Virtek*, the Petitioner's purported expert made the same omission; Mr. Taylor did not articulate any reason why a

POSITA would combine the Gratsch and Leiss. Mr. Taylor's entire analysis of motivation to combine is: "A person having ordinary skill in the art reading Henze would have been motivated to follow the teachings of Gratsch to secure the trolling motor mount of Gratsch to the swivel mount on top of the gunnel disclosed by Henze." Ex. 1003 ¶71. This analysis is entirely insufficient and does not provide any basis for finding a motivation to combine. Mr. Taylor does not explain why a POSITA would have combined a device for deploying a fishing line with an underside-mounted connection system. Mr. Taylor did not provide any reason to substitute one for the other. And as explained further below, the structures of the respectively disclosed devices would suggest otherwise.

The Petition similarly fails. At Petition p. 68, Petitioner states only that "There would have been a motivation to combine Henze and Gratsch with a reasonable expectation of success because Henze and Gratsch both describe mounting marine accessories to gunnels." This statement provides even less reasoning for the combination than the rationale identified in *Virtek* at 97 F.4th at 887.

The combination of Gratsch and Henze should be rejected because neither Petitioner nor Petitioner's purported expert could provide any explanation of why a POSITA would have been motivated to combine the references.

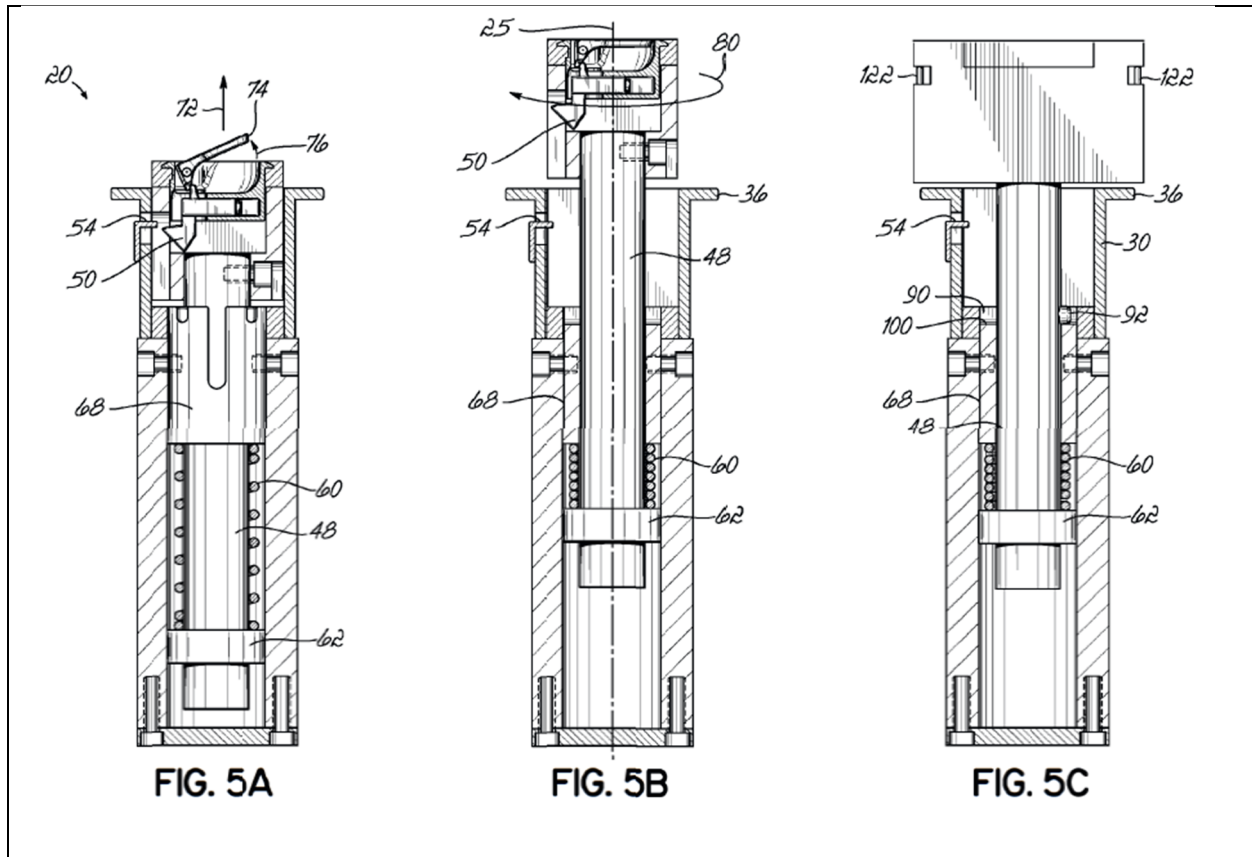
In addition, even if Gratsch and Henze were combined, the combination

would fail to disclose or suggest multiple elements of claim 8. As noted in the previous discussion of Henze, the Henze disclosure fails to disclose at least (a) “a swivel mount disposed above an upward facing surface of the gunnel”, (b) both “a mounting member” and “a trolling motor mounting bracket coupled to ... the mounting member”, and (c) the bracket being “coupled to an upward facing surface.”

Gratsch does not cure these deficiencies. Petitioner does not identify any disclosure in Gratsch of both a “mounting member” and a “trolling motor mounting bracket.” Petition p. 60. Rather, Petitioner cites only to text in Gratsch stating that “a trolling motor” may be attached to Gratsch’s device. *Id.* (citing Ex. 1007 ¶36). As noted in the discussion of Leiss (above), the ‘111 Patent clearly distinguishes between trolling motors and their mounting brackets, and the ‘111 Patent clearly requires both a “mounting member” and a separate “trolling motor mounting bracket.” Gratsch does not cure this deficiency of Henze.

Moreover, Gratsch does not cure Henze’s deficiency related to claim 8’s “swivel mount disposed above an upward facing surface of the gunnel such that a mounting member ... is able to swivel about an axis that ... passes through the upward facing surface of the gunnel...” As noted above, Henze’s device is “fastened to the deck or transom,” not the gunnel. Ex. 1008 Abstract. Gratsch does not cure this element, because Gratsch does not disclose a “swivel mount

disposed above an upward facing surface of the gunnel.” Rather, as can be seen in Gratsch’s FIGS. 5A, 5B, and 5C (reproduced below), even when Gratsch’s device is fully extended, the vast majority of Gratsch’s device remains below, not above, the upward facing surface of the gunnel:



Ex. 1007 FIGS. 5A, 5B, 5C.

Because Petitioner did not show motivation to combine Gratsch and Henze, and because even the combination of Gratsch and Henze is missing elements of claim 8, these prior art references do not render claim 8 obvious. Accordingly, Petitioner’s ground 10 does not provide a basis for instituting a PGR.

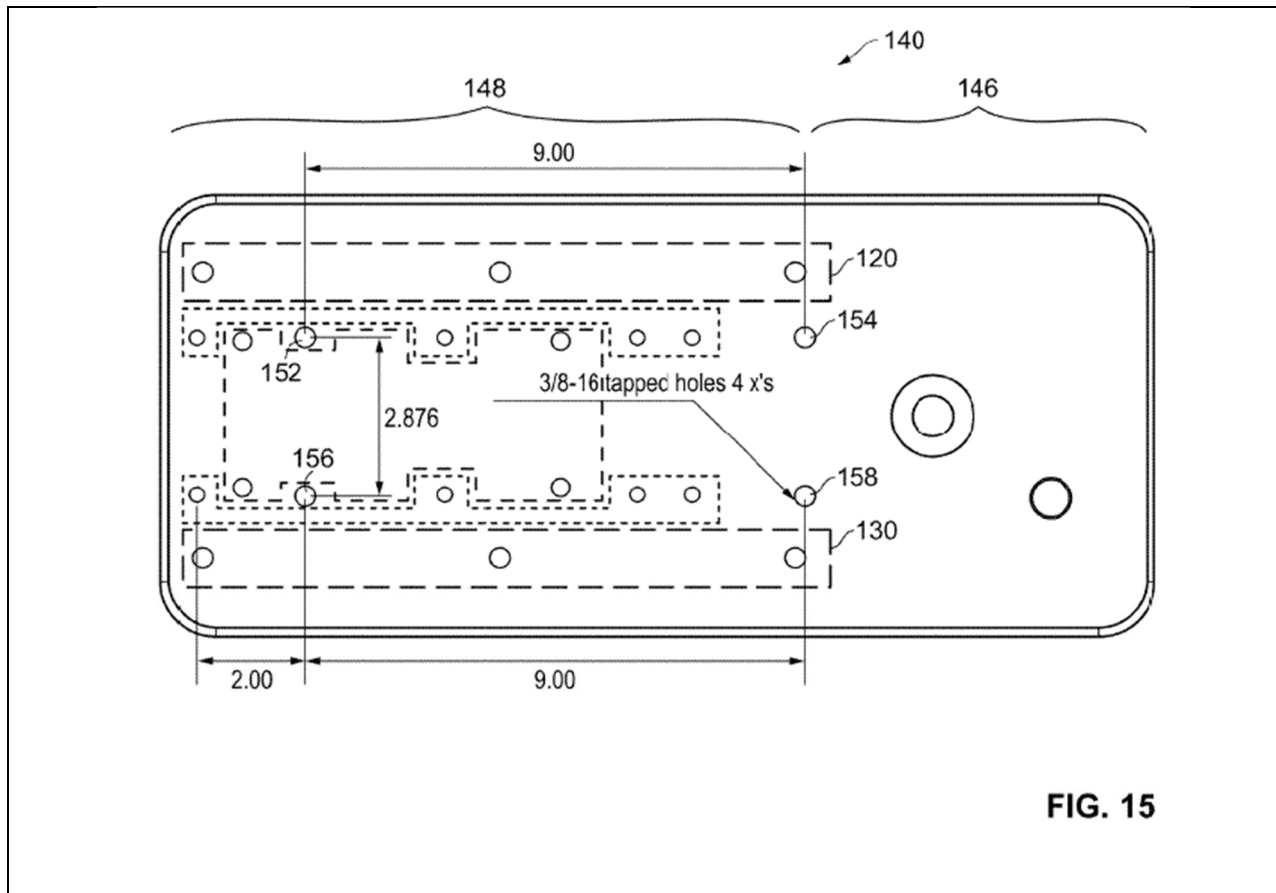
XI. Indefiniteness – Ground 24 – Claim 6

Petitioner incorrectly argues that claim 6 is indefinite because the claim states “a number and arrangement of the plurality of holes are such that different types of trolling motor mounting brackets may be secured to the second portion of the elongated mounting plate via a plurality of bolts,” and the specification allegedly fails to inform a POSITA what this means. Petition p. 101.

No evidence supports this allegation. Petitioner's alleged expert does not offer any opinion that this claim language would have been indefinite to a POSITA. *See generally* Ex. 1003. The alleged expert merely copied the bare statement “Claims 6 [sic] is unpatentable under 35 U.S.C. §112 as indefinite” from the statement of grounds at Petition p. 12 into his declaration. Ex. 1003 p. 5. It is apparent that the alleged expert merely copied the Petition as an opinion, because he did not even correct the grammatical error after copying the statement.

Contrary to the lack of evidence of indefiniteness, there is a significant amount of intrinsic evidence demonstrating that the claim would have been understood by a POSITA. The inventor dedicated over three columns of text and multiple figures in the '111 Patent to the discussion of the number and arrangement of holes and the various types of mounting brackets that could be secured. *See, e.g.,* Ex. 1001 col. 14:42-18:60, FIGS. 13, 14, 15.





The abstract states, “Mounting members have a hole pattern to accommodate different types of trolling motors...” Ex. 1001 Abstract. The specification confirms, “[T]he number and arrangement of through holes 29 may be configured to accommodate different models of trolling motors or different models of trolling motor mount brackets. FIGS. 1 and 2 illustrate an example layout of through holes 29 which may serve such a purpose, but other arrangements may be considered to achieve such an objective as described in reference to FIGS. 14 and 15.” *Id.* col 11:17-24. The specification later continues, “In general, the number and

arrangement of through holes in top plate 66 may vary depending on the object which will be mounted to the swivel mount and, in some cases, may be configured to accommodate a plurality of different types of objects or different models of the same type of object.” *Id.* col. 14:45-50. The inventor states, “FIGS. 13-15 illustrate mounting brackets having other through hole arrangements which may be considered...” *Id.* col. 14:64-66.

In describing FIG. 13, the inventor taught about holes configured for mounting “quick release pucks or inner plates for” multiple types of trolling motors, including motors by Garmin, Power Pole, Minn Kota, and Rhodan. *Id.* col. 15:25-52, 16:13-59. In describing FIG. 14, the inventor taught about holes configured for mounting “quick release pucks or inner plates” of a different type of trolling motors from Minn Kota. *Id.* col. 16:60-17:17. In describing FIG. 15, the inventor taught about holes configured for mounting “quick release pucks or inner plates” of another type of trolling motor from Power Pole. *Id.* col. 17:38-60.

In view of the clarity of the terms and extensive discussion of the terms in the specification, coupled with the lack of evidence of indefiniteness, Petitioner is incorrect in arguing that a POSITA would not understand the claim term: “a number and arrangement of the plurality of holes are such that different types of trolling motor mounting brackets may be secured to the second portion of the elongated mounting plate via a plurality of bolts.” Rather, the cited portions of the

specification describe exactly how to understand this claim term and provide multiple specific examples that demonstrate how to understand this claim term.

Accordingly, Petitioner's ground 24 does not provide a basis for instituting a PGR.

XII. Written Description – Ground 25 – Claims 10 and 13

Petitioner incorrectly argues that claim 10 lacks written description due to inclusion of the “base member” and claim 13 lacks written description because it states that the “trolling motor mounting bracket comprises a trolling motor deploy/stow mechanism.” Petition pp. 102-103.

No evidence supports this allegation. Petitioner's alleged expert does not offer any opinion that this claim language was not possessed by the inventor at the time of filing. *See generally* Ex. 1003. The alleged expert merely copied the bare statement “Claims 10 and 13 are unpatentable under 35 U.S.C. §112 as lacking an adequate written description” from the statement of grounds at Petition p. 12 into his declaration. Ex. 1003 p. 5. Without a factual basis, this summary opinion is not entitled to any weight.

The originally filed claims of the application for the '111 Patent included the language challenged by Petitioner. The originally filed claims are part of the specification, so this creates a presumption that the inventor possessed the inventions and provided adequate written description in the specification when the

application was filed. *Crown Packaging Tech., Inc. v. Ball Metal Bev. Container Corp.*, 635 F.3d 1373, 1380 (Fed. Cir. 2011) (“Original claims are part of the specification and in many cases will satisfy the written description requirement.”). The language of originally filed claim 12 (Ex. 1002 p. 43) is identical to the language of issued claim 10 (Ex. 1001 p. 22), except that the claims were renumbered prior to issuance. And the language of originally filed claim 15 (Ex. 1002 p. 43) is identical to the language of issued claim 13 (Ex. 1001 p. 22), except that the claims were renumbered prior to issuance. This creates a presumption that the written description requirement was met for each claim; Petitioner did not offer any evidence to overcome this presumption.

Moreover, the specification further demonstrates that the written description requirement was met for both terms.

Regarding claim 10, the specification uses the term “base plate” at least ten times to describe the function of the base member. “Base plate” is an adequate description, as the Federal Circuit has stated, “The central tenet of our written description jurisprudence—that the disclosure must be read from the perspective of a person of skill in the art—further recognizes that the disclosure need not describe a limitation in haec verba.” *Novartis Pharms. Corp. v. Accord Healthcare, Inc.*, 38 F.4th 1013, 1023 (Fed. Cir. 2022). For example, the specification states, “swivel mount 40 includes a nut for securing base plate 42 against a mounting surface ...

base plate 42 may include corner holes for further affixing it to a mounting surface” and “base plate 62 may include corner holes for further affixing it to a mounting surface, such as but not limited to a boat gunnel.” Ex. 1001 col. 13:48-54, 14:35-38. Petitioner does not suggest that a POSITA would not understand the term “base plate” to be a reference to a “base member”; to the contrary, a POSITA would have been likely to understand that “base plate” and “base member” could be used for similar purposes in the ‘111 Patent.

Regarding claim 13, in addition to the originally filed claims, the specification uses the term “deploy/stow mechanism” to explain that the “trolling motor mounting bracket” can comprise a “deploy/stow mechanism.” The inventor stated, “In some cases, a trolling motor mount bracket (such as but not limited to a quick-release trolling motor mounting puck and/or a trolling motor deploy/stow mechanism) may be coupled to the swivel mount.” Ex. 1001 col. 4:30-35. This is a plain language disclosure that the “trolling motor mount bracket” may include the “deploy/stow mechanism.” Petitioner does not challenge this. Petitioner makes attorney argument, but does not offer any expert testimony or any other evidence that a POSITA would not understand that the inventor possessed the invention at the time of filing. Petitioner did not carry its burden to establish a lack of written description where both the original claims and the other specification text show that the claimed invention was possessed by the inventor at the time of

filing the patent application.

Accordingly, Petitioner's ground 25 does not provide a basis for instituting a PGR.

XII. All Remaining Grounds – Directed to Dependent Claims

All of the remaining grounds in the Petition are directed to dependent claims and rely upon the same prior art combinations addressed above (in this Response) with respect to the independent claims. Because the grounds regarding the independent claims (discussed above in this Response) all fail, the grounds relating to their dependent claims also fail. Each of the dependent claims includes every element of the independent claim from which it depends. *See Alcon Research, LTD. v. Apotex Inc.*, 687 F.3d 1362, 1367 (Fed. Cir. 2012) (“It is axiomatic that a dependent claim cannot be broader than the claim from which it depends.”). And because the prior art does not disclose all of the elements of the independent claims, the prior art by definition cannot disclose all of the elements of the dependent claims.

Accordingly, none of the other grounds (directed to dependent claims) provides a basis for instituting a PGR.

V. CONCLUSION

Accordingly, Patent Owner respectfully requests that the Director deny institution of the Petition filed by ShuttleSlide LLC challenging the patentability of claims 1-18 of the '111 Patent.

Respectfully submitted,

Date: January 8, 2025

By: /Perry S. Clegg/

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CERTIFICATE OF SERVICE

I certify that the above-captioned **PATENT OWNER'S PRELIMINARY RESPONSE PURSUANT TO 35 U.S.C. §323** was served in its entirety on January 8, 2025, upon the following parties via electronic mail:

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By: /s/ Perry S. Clegg/

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CERTIFICATION OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), the undersigned certifies that the word count feature of Microsoft Word indicates that the word count of the foregoing document is less than 18,700 words, the limit set by 37 C.F.R. §42.24(a)(1)(ii) and (b)(1), not including the case caption/heading, Table of Contents, Table of Authorities, Certificate of Service, Certificate of Word Count, and List of Exhibits.

/s Perry S. Clegg/

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