

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ONE WORLD TECHNOLOGIES, INC.  
D/B/A TECHTRONIC INDUSTRIES POWER EQUIPMENT,  
Petitioner

v.

THE CHAMBERLAIN GROUP, INC.  
Patent Owner

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Case No. IPR2017-00432  
Patent No. 7,339,336

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## I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.107(a), the patent owner, The Chamberlain Group, Inc. (“Patent Owner”), hereby submits the following Preliminary Response in response to the Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 7,339,336 (“the ’336 patent”).

The ’336 patent, entitled “Movable Barrier Operator Auto-Force Setting Method and Apparatus,” contains 40 claims, of which claims 1, 7, 12, 15, 27, 34, 37, and 39 are independent. The Petition proposes the following three grounds of unpatentability with respect to claims 1, 7, 11-13, and 15 of the ’336 patent (hereinafter the “Challenged Claims”):

- **Ground 1:** Claims 1, 12, 13, and 15 as allegedly anticipated by Mullet;
- **Ground 2:** Claim 1 as allegedly obvious over Mullet; and
- **Ground 3:** Claims 7 and 11 allegedly obvious over Mullet in view of Murray.

For at least the reasons described herein, the Petition is deficient, and should be denied in whole.

## II. STATEMENT OF RELIEF REQUESTED

Patent Owner respectfully requests the Board to deny the Petition for the following reasons:

(1) Ground 1 is deficient as to all challenged claims, because Petitioner impermissibly combines two distinct embodiments from the Mullet reference. Such a showing is legally improper in supporting a finding of anticipation by Mullet. *See, e.g., Symantec Corp. v. RPost Communications Ltd.*, IPR2014-00357, Paper 14 at 20 (citing *In re Arkley*, 455 F.2d 586, 587-88 (CCPA 1972); *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008)). In addition, Ground 1 is deficient with respect to claim 1 of the '336 patent because Mullet does not teach the preamble limitation reciting “a movable barrier operator that has no user-initiable dedicated learning mode of operation.”

(2) Ground 2 is deficient with respect to claim 1 (the only claim challenged in the ground) because Petitioner impermissibly dismisses the preamble limitation reciting “a movable barrier operator that has no user-initiable dedicated learning mode of operation.” Petitioner states that modifying Mullet to meet this limitation would have been “a trivial change,” and thus would have been obvious to a POSITA. Petitioner cites no authority for the proposition that prior art references can be freely modified to teach patent claims merely because the change is allegedly “trivial,” and in fact no such authority exists. Further, Petitioner’s conclusory analysis fails to identify a “reason why” a POSITA would have been motivated to make such a change. Accordingly, Petitioner has not shown that claim 1 is obvious as alleged in Ground 2.

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