

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BOYDSTUN EQUIPMENT MANUFACTURING, LLC,

Petitioner,

v.

COTTRELL, INC.,

Patent Owner.

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Case IPR2017-00962

Patent 7,585,140 B1

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**PATENT OWNER'S MOTION TO AMEND  
UNDER 37 CFR § 42.121**

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**EXHIBIT LIST**

- Ex. 2001 Declaration of Kyle M. Amborn in Support of Motion for Pro Hac Vice Admission
- Ex. 2002 Declaration of Kirsten M. Carr, Ph.D., PE
- Ex. 2003 Transcript for Deposition of George A. Clark, November 10, 2017
- Ex. 2004 USPTO File History for U.S. Patent No. 7,585,140 B1
- Ex. 2005 U.S. Patent No. 5,101,537 to Cummings
- Ex. 2006 Opinion and Order on Claim Constructions, Boydstun Equip. Mfg. v. Cottrell, No. 3:16-cv-790 (D. Or. Oct. 18, 2017).

## I. INTRODUCTION

As set forth in the Patent Owner Response, original claims 1-8 of U.S. Pat. No. 7,585,140 (the “140 patent”) recite a patentably distinguishable ratchet assembly. This Motion to Amend is provided with substitute claims 9-16 to replace claims 1-8 in the case that the Board finds claims 1-8 unpatentable.

The Petition works backwards from claim 1 to manufacture a ratchet gear and assembly that is not described in the art. Substitute claims 9-16 more narrowly claim the ratchet assembly recited by claim 1. Because Petitioner needed to manufacture gears in attempt to meet claim 1, the prior art naturally does not describe limitations that more narrowly describe the ratchet assembly.

Claims 9-16 are patently distinguishable and supported by the original disclosure. Amendments to independent claim 9 recite *inter alia* a ring to limit the intrusion of contaminants, a pin, and also narrow the ratchet gear and ratchet head; dependent claim 10 narrows the ring's position; dependent claim 12 further narrows the ring's position and also describes interconnection between the gear and head; and dependent claim 16 describes another interconnection technique. These features are not taught in the art of record and the best art known to Patent Owner.

In the case that the Board finds claims 1-8 invalid, Patent Owner requests that they be substituted by claims 9-16.

## **II. THE MOTION AND PROPOSED AMENDMENTS COMPLY WITH 37 C.F.R. § 42.121**

In compliance with the requirements of § 42.121(a), Patent Owner has conferred with the Board regarding the Motion to Amend on November 14, 2017. *See* Paper 9 at 4 and 9; *see also* § 42.121(a).<sup>1</sup> The Motion to Amend is timely filed. § 42.121(a)(1).

In accordance with 37 C.F.R. § 42.121(a)(2)(i), Patent Owner's amendments to substitute claims 9-16 are responsive to a ground of unpatentability. The Board instituted review of claims 1-8 over Ruan and Cottrell and Boice and Ruan based, in part, on the Petition's arguments regarding the ratchet head and gear as part of the ratchet assembly. *See* Paper 8 at 19 and 31. Patent Owner's amendments provide additional limitations to the ratchet assembly, including among others, a pin, a ring to limit the intrusion of contaminants, and narrowing limitations to the ratchet gear/head. Claims 10, 12, and 16 provide further narrowing limitations to the ratchet assembly and claims 11 and 13-15 change dependencies to depend on substitute claim 9. The amendments to claims 9-16 are thus responsive to a ground of patentability.

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<sup>1</sup> Patent Owner has also reviewed the Nov. 21, 2017 guidance, available at [https://www.uspto.gov/sites/default/files/documents/guidance\\_on\\_motions\\_to\\_amend\\_11\\_2017.pdf](https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf)

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