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UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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PRECISION PLANTING, LLC and AGCO CORP.  
Petitioners

v.

DEERE & COMPANY  
Patent Owner

Case Nos. IPR2019-01044, IPR2019-01046, IPR2019-01047, and IPR2019-01048

U.S. Patent Nos. 8,813,663, 9,480,199, 9,510,502, and 9,686,906

**REPLY TO PATENT OWNER PRELIMINARY RESPONSES**

**TABLE OF CONTENTS**

I. THERE IS NO ESTOPPEL PRECLUDING PETITIONERS’  
MOTIVATION TO COMBINE ARGUMENTS. ....2

II. THE PETITIONS DEMONSTRATE A MOTIVATION TO COMBINE  
THE ASSERTED REFERENCES.....6

III. THERE IS NO JUSTIFICATION FOR THE BOARD TO EXERCISE ITS  
DISCRETION TO DENY INSTITUTION. ....7

Patent Owner (“Deere”) filed four Patent Owner Preliminary Responses (“POPRs”) in IPR2019-01044, -01046, -01047, and -01048 arguing that the Board should deny institution. None of Deere’s arguments has merit.<sup>1</sup>

With much fanfare, Deere claims Petitioners have taken a “diametrically opposite” position about the Koning reference to one taken over 15 years ago in the prosecution of the Sauder patent (U.S. Patent No. 6,681,706). ’663 POPR, 2.<sup>2</sup> In so doing, Deere improperly assumes that the state of precision-planting art lay fallow for six years. Deere then compounds its error by misapplying the law and mischaracterizing the Sauder prosecution history.

Deere’s attorney argument that a POSITA would not have been motivated to combine the references’ teachings fares no better. Deere claims embodiments of the references must physically fit together like puzzle pieces. *Id.*, 20 (“Koning’s brush hairs are unlikely to fit....”); 12 (Hedderwick’s “much smaller seeds”); 20 (Koning’s brush hairs “are likely to be too stiff and too coarse”). But the relevant inquiry is whether a POSITA would have been motivated to combine *the teachings* of the references, not their physical parts. *Allied Erecting &*

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<sup>1</sup> This consolidated Reply addresses the arguments in all four POPRs. The Board authorized filing this Reply via email on September 13, 2019.

<sup>2</sup> Except as noted, Deere’s arguments for the ’663 patent are representative.

*Dismantling Co. v. Genesis Attachments*, 825 F.3d 1373, 1381 (Fed. Cir. 2016).

Finally, Deere claims that the existence of pending district court litigation involving the same patents justifies the Board's exercise of discretion to deny institution. Declining to institute on this flimsy showing would lead to declining to institute in almost every case, and should be rejected.

**I. THERE IS NO ESTOPPEL PRECLUDING PETITIONERS' MOTIVATION TO COMBINE ARGUMENTS.**

Judicial estoppel is rarely appropriate and may not be found unless all three of the following have been established: (1) the party's later position must be "clearly inconsistent" with its earlier one; (2) the party must have succeeded in persuading a court to adopt its earlier position; and (3) "the party seeking to assert an inconsistent position would derive an unfair advantage or impose an unfair detriment on the opposing party if not estopped." *New Hampshire v. Maine*, 532 U.S. 742, 749-51 (2001). Deere has failed to show these factors here.

*First*, Petitioners' evidence demonstrating a motivation to combine Koning with Hedderwick or Sauder is not "clearly inconsistent" with Precision's statements during the Sauder prosecution. Those statements were made in 2003, six years before the priority date of Deere's patents. Deere does not argue, nor could it, that the state of the art in precision planting remained unchanged from 2003 to 2009. This omission is critical, as the statements that Deere claims are inconsistent refer to the state of the art at two different times.

The evidentiary record before the Board shows that, by 2009, a POSITA would have known of techniques for planting “seed crops”—i.e., crops, such as corn kernels, that are planted as seeds—and would have recognized that features of those techniques could be applied to other planters. *See* ’663 Ex. 1002, ¶63 (“*Seed crop*’ is grown from seed and then itself used as seed. For example, corn seed can be used to grow corn and a kernel of corn can in turn be used to grow new corn. A [POSITA] would have known ... systems used to plant seed crop can be used to plant seed.... It is also common for farmers to plant both potatoes and other types of seed, such as corn or soybeans. As a result, a [POSITA] ... would understand that the teachings of Koning’s system could be applied to systems used to plant many different types of seeds.”); ’199 Ex. 1002, ¶68 (similar); ’502 Ex. 1002, ¶67 (similar); ’906 Ex. 1002, ¶53 (similar). These facts, established by sworn expert declaration, are entitled to more weight than Deere’s mere attorney argument. *See Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1379 (Fed. Cir. 2008) (“affidavits or declarations are held to a higher standard” than “mere attorney argument”). Deere itself considered Koning relevant enough to the subject matter of the ’663, ’199, and ’906 patents to submit it in an IDS during prosecution. ’663 Ex. 1022, 47; ’199 Ex. 1022, 87; ’906 Ex. 1022, 49.

Moreover, Precision’s arguments during the Sauder prosecution focused on whether there was a “suggestion, teaching, or motivation to combine the prior art

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