UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRECISION PLANTING LLC, AGCO CORPORATION,
Petitioners,

v.

DEERE & COMPANY,
Patent Owner

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

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PRELIMINARY RESPONSES

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Precision Planting, LLC and AGCO Corporation ("Petitioners") were masters of their jointly-filed Petitions.[1] Petitioners in each case chose to assert a single ground that required the combination of Koning (a potato planter) with a row crop planter for small seeds (Hedderwick or Sauder). Yet Petitioner Precision Planting had already told the Office that Koning was "directed to a completely different field of art" from, and thus should not be combined with, a similar row crop planter for small seeds (Walters). IPR2019-01044 POPR 3 ("'663 POPR"). Precision Planting benefitted from this representation, which led directly to the issuance of the Sauder patent. The joint petitioners should be estopped from taking the completely opposite position here.

Petitioners also misconstrue Patent Owner's arguments on the merits, which is not that the physical elements of Petitioner's disparate pieces of prior art cannot be combined. Rather, the significant differences in the purpose and principles of operation of these references would discourage a POSA from combining them. This is the opposite of a motivation of combine.

Finally, the precedential force of *NHK* favors discretionary denial here.

I. JUDICIAL ESTOPPEL WARRANTS DENYING THE PETITIONS

Events from 2003 to 2009 do not diminish the estoppel effect of Precision's

[1] This Sur-Reply was authorized by the Board via email on September 13, 2019.

statements: Petitioners observe that six years elapsed between Precision Planting's statements to the Examiner about potato planters and small seed row crop planters in 2003 and the 2009 priority date of the challenged claims. But Petitioners identify nothing that occurred in that interval that would diminish the significance of those statements. Petitioners point only to the conclusory observations of their experts that (1) some crops, such as corn kernels, are themselves used as seed and thus "systems used to plant seed crop can be used to plant seed"; and (2) some farmers plant both corn or soybeans and potatoes. Reply 3. The experts cite no technical authority, but instead refer to their own alleged "experience" (which was actually confined to *small* seeds/seed crops, *i.e.*, wheat, soybean, sorghum, corn seed, and corn kernels, *see id.*).

None of this explains why the technology purportedly evolved to such an extent between 2003 and 2009 that a POSA would suddenly look to potato planters for insight into planting small seed row crops—the exact opposite of what Precision Planting told the Examiner. Petitioners suggest the Board ignore the prior inconsistent argument made by Precision Planting through its attorney, even though the Sauder patent would not have been allowed but for those arguments. It would make no sense to allow a party to avoid the estoppel effect of its prior statements to an administrative tribunal simply by hiring an expert to later contradict those

statements in another proceeding.[2]

The estoppel effect of Precision Planting's prior statements is also not diminished by any change in law. Reply 3-4. *KSR Intern. Co. v. Teleflex, Inc.* did not eliminate the teaching, suggestion, motivation test, but it did hold that a motivation to combine analysis "should be made explicit." 550 U.S. 398, 418 (2007); *See also In re Nuvasive, Inc.*, 842 F.3d 1376, 1382 (Fed. Cir. 2016). An obviousness combination may still fail if one of the references is not reasonably pertinent to the problem at issue—just as Precision said about Koning in 2003. *See In re Klein*, 647 F.3d 1343, 1347-52 (Fed. Cir. 2011). Finally, the citation of Koning in an IDS in certain challenged patents is not an admission of materiality, 37 C.F.R. §1.97(h), and does not undermine the estoppel effects of Precision's detailed and explicit arguments that Koning is non-analogous art.

Patent Owner did not mischaracterize the Sauder prosecution: Petitioners point out that Precision's remarks about Koning were accompanied by claim

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[2] The Board should also consider that Petitioners' two experts provided a substantially identical description of Koning and, coincidentally, both experts purport to "have used systems that were used to [plant] wheat, soybean, or grain sorghum to design systems used to plant corn [seed]." *Compare* '663 Ex. 1002, ¶63 & '199 Ex. 1002, ¶68 (Prairie Declarations) with '906 Ex. 1002, ¶53 & '502 Ex. 1002, ¶67 (Taylor Declarations).

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