### UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_

## BEFORE THE PATENT TRIAL AND APPEAL BOARD

JOHN CRANE, INC., JOHN CRANE PRODUCTION SOLUTIONS, INC. & JOHN CRANE GROUP CORP., Petitioners,

v.

FINALROD IP, LLC, Patent Owner.

\_\_\_\_\_

Case IPR2016-01786 TITLE: SUCKER ROD APPARATUS AND METHOD Patent 9,045,951

PATENT OWNER'S PRELIMINARY RESPONSE

**UNDER 37 C.F.R. § 42.107** 



## TABLE OF CONTENTS

I.		Introduction	1
II.		Overview of U.S. Patent No. 9,045,951	2
III.		THE ASSERTED GROUNDS	8
IV.		Overview of the Asserted Prior Art	8
A.		Rutledge '431	9
В.		Iwasaki	.14
C.		McKay	.14
D.		Anderson	
V.		CLAIM CONSTRUCTION	.15
A.		Definition of A Person Having Ordinary Skill In the Art	.17
В.		Disputed Claim Terms	.18
	1.	"define a distribution of force"	.18
	2.	"such that"	.20
VI.		Petitioner Failed to Show A Reasonable Likelihood The Petitioner Would Prevail	.22
Α.		Petitioner is Attempting to Shift the Burden to Patent Owner to	,
110		Prove Patentability	2.2.
В.		Petitioner Fails to Provide a Rationale to Combine the Asserted	,
ъ.			.24
	1.		
	1.	Art and the Claimed Invention of the '951 Patent	.27
	2	Petitioner Has Not Provided Motivation to Modify Rutledge '431	
	3.	•	
		McKay is Addressed by Rutledge '431	
C.		Rutledge '431 Teaches Away From the Claim Invention of the '951	
		Patent	.35



D.		The Petition Should Be Denied Because the Same Prior Art Asserted
		in the Petition Was Previously Presented to the USPTO36
E.		Claims 4, 6-8, 14-15, 17, 21-22, 35, 47, 52, and 65-68 are not
		Unpatentable as obvious over Rutledge '431 in view of Iwasaki and
		McKay39
		All Claim Limitations Should Be Given Full Weight39
	2.	The Combination of Rutledge '431, Iwasaki, and McKay Fail to
	:	Disclose, Suggest, or Teach At Least the Following Claim Limitations: 43
F.		Claims 50, 57, and 59 are not Unpatentable as obvious over Rutledge
		'431 in view of Iwasaki, McKay, and Anderson52
VII.		CONCLUSION AND RELIEF REQUESTED53



## TABLE OF AUTHORITIES

## **Cases**

7, 48, 53
47
19
47
40
33
43
35
37
25



Hitzeman v. Rutter,	
243 F.3d 1345 (Fed. Cir. 2001)	47
In re Cuozzo Speed Techs.,	
793 F.3d 1268 (Fed. Cir. 2015)	15
In re Fulton,	
391 F.3d 1195 (Fed. Cir. 2004)	35
In re Gordon,	
733 F.2d 900 (Fed. Cir. 1984)	31
In re Hiok Nam Tay,	
579 Fed.Appx. 999 (Fed. Cir. 2014)	19
In re Janski,	
508 Fed.Appx. 950 (Fed. Cir. 2013)	42
In Re Kahn,	
441 F.3d 977 (Fed. Cir. 2006)	25
In re Magnum Oil Tools Int'l, Ltd.,	
829 F.3d 1364 (Fed. Cir. 2016)	23
In re Nuvasive, Inc.,	
– F.3d – (Fed. Cir. December 7, 2016), 2016 WL 7118526	28
In re Ratti,	
270 F.2d 810, 123 USPQ 349 (CCPA 1959)	31
In re Robertson,	
160 F 3d 7//3 (Fed. Cir. 1000)	16



# DOCKET A L A R M

# Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

# **Real-Time Litigation Alerts**



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

# **Advanced Docket Research**



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

# **Analytics At Your Fingertips**



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

#### API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

#### **LAW FIRMS**

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

#### **FINANCIAL INSTITUTIONS**

Litigation and bankruptcy checks for companies and debtors.

### **E-DISCOVERY AND LEGAL VENDORS**

Sync your system to PACER to automate legal marketing.

