

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HILTI AKTIENGESELLSCHAFT
Petitioner,

v.

SPECIFIED TECHNOLOGIES INC.,
Patent Owner.

Case No. IPR2024-00192
U.S. Patent No. 9,157,232

PETITIONER'S PRE-INSTITUTION REPLY

A. Patent Owner misstates Petitioner’s claim construction positions.

Patent Owner (“PO”) argues (at 8-11) that the Board should deny institution because Petitioner allegedly fails to provide notice of its proposed claim constructions. Yet, PO admits (at 9) that the Petition plainly states that “Petitioner applies the plain and ordinary meaning of the claim terms.” Despite admitting that the Petition does provide notice of Petitioner’s claim construction positions, PO accuses (at 8) Petitioner of taking inconsistent claim construction positions, arguing that “[t]he Petition fails to present for consideration, or apply in its analysis, the claim construction positions it has taken in the pending District Court case.” As explained below, Petitioner did no such thing. Instead, PO’s argument is premised on a misrepresentation of Petitioner’s claim construction positions.

PO first addresses (at 9-10) the term reciting “at least one connecting strap positioned above the main track section of the ceiling track” and represents that Petitioner’s proposed construction in the District Court requires “a connecting strap that is ‘removably detached’ from the gasket sections” While Petitioner had originally proposed a narrower construction, PO knew by the time it filed its Patent Owner’s Preliminary Response (“POPR”) that Petitioner had, in fact, **adopted and stipulated to** PO’s proposed ordinary meaning construction in the District Court.¹

¹ Despite this knowledge, PO took the position during the meet and confer that it did

That position was adopted in Petitioner’s December 22, 2023 Answering Claim Construction Brief and confirmed by email to PO on January 4, 2024, and is stipulated in the parties’ recently filed Joint Claim Construction Brief, which states: “The parties agree on the construction[] of the following term[]: ‘at least one connecting strap positioned above the main track section of the ceiling track.’” *See Hilti AG v. Specific Technologies, Inc.*, Civ. No. 22-cv-1248-CJB, Dkt. 175 (“Joint Claim Construction Brief”) at 1 (D. Del.).

PO also argues (at 11) that Petitioner failed to disclose its construction of “spatially disposed,” but, again, Petitioner clearly indicated that it applies the plain meaning of that term. PO takes its misplaced argument one step further to argue (at 11) “that there is no discussion in the Petition about how the prior art teaches . . . how the first and second side track sections are spatially disposed from the ‘entirety’ of each other.” But that is not what the relevant claim term recites. Instead, the claim recites that the first/second gasket side panels are “spatially disposed” ***from the first/second track side sections***. Ex. 1001, Claim 8. And Petitioner clearly addresses this limitation by explaining that: 1) “the L-shaped gasket sections are

not have a duty to advise the Board of Patent Owner’s actual claim construction position. Regardless of whether PO had a duty, the District Court record is clear that Petitioner is not seeking the construction PO presented to the Board.

adhered to the top of the ceiling track, leaving the vertical sides of the L-shaped gaskets free to move” (Ground 1A) and 2) “the upper panels of Pilz I’s L-shaped gasket section are adhesively joined to the ceiling track while the side panels of the L-shaped gasket sections are free to move.” (Ground 1B). *See* Pet. at 47, 67.

Next, PO argues (at 11) that, because Petitioner asserted that certain claim terms are indefinite, the Board should deny institution. But here again, PO misrepresents Petitioner’s claim construction positions. Specifically, PO (at 10) represents Petitioner’s position as follows:

“and attached to said first L-shaped gasket section and to said second L-shaped gasket section to limit spatial separation therebetween”	Indefinite. If not indefinite: “and attached to said first L-shaped gasket section and to said second L-shaped gasket section to limit special separation therebetween when the gasket is positioned on the track”
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But Petitioner did not argue that this term is indefinite during claim construction, as Ex. 2002 (at 18) clearly shows:

Hilti’s Proposed Construction
This term should be construed according to its plain meaning, as informed by the intrinsic record, which is “and attached to said first L-shaped gasket section and to said second L-shaped gasket section to limit spatial separation therebetween when the gasket is positioned on the track.”

As to the preamble, PO correctly notes that Petitioner has advanced an indefiniteness argument in District Court. But Petitioner does not argue that the term cannot be construed, and, in fact, expressly noted its argument in footnote 9 of the Petition and explained that Pilz I's gasket (the primary reference for both grounds) "can be used on a wall of any size, it can be used on a 'wider than standard' wall even assuming the scope of this term is capable of being understood with reasonable certainty." *See also* Ex. 1003, ¶¶ 67, 76, 110.

As to the "spatially disposed" term, PO again fails to advise the Board that Petitioner deferred its indefiniteness argument to a later stage of the District Court case because the argument is not that the term cannot be construed. *See* Joint Claim Construction Brief at 161, n.33. Indeed, the Board has acknowledged that "alternative pleading before a district court is common practice, especially where it concerns issues outside the scope of *inter partes* review," such as indefiniteness. *Target Corp. v. Proxicom Wireless, LLC*, IPR2020-00904, Paper 11 at 12 (PTAB Nov. 10, 2020).

Indeed, PO's indefiniteness argument is curious in citing (at 11) authority for the proposition that if the Board "cannot ascertain the scope of a claim with reasonable certainty for purposes of assessing patentability," it should "decline to institute the IPR." Presumably PO does not concede this point, although if the Board

does find that any terms are indefinite, then Petitioner agrees that the Board should so state and deny institution.

Finally, and while Petitioner did not take inconsistent positions as explained above, Petitioner notes that the Board's precedent does not preclude a petitioner from adopting a Patent Owner's broad district court constructions for purposes of IPR. *See, e.g., Western Digital Corp. v. SPEX Techs., Inc.*, IPR2018-00082, 2018 WL 1990246, at *5 (PTAB Apr. 25, 2018). Instead, Rule 104(b)(3) simply requires a Petitioner to identify the claim construction on which the Petition is based, and PO admits that Petitioner clearly stated that its Petition adopted the ordinary meaning of the claims. And notably, PO does not dispute that Petitioner, in fact, applied the plain meaning of the terms in its obviousness analysis, choosing instead to focus on a misplaced procedural argument.

B. Patent Owner's arguments concerning the Puchovsky declaration lack merit.

PO misapprehends the Board's precedent arguing (at 13) that the "Board regularly gives little to no probative weight to expert declarations that parrot the petition's arguments and, in turn, denies institution." However, the Board has been clear that "[v]erbatim duplication between a brief and a declaration does not require giving the declarant's testimony 'little or no weight' under *Xerox*." *Netflix, Inc. v. GoTV Streaming, LLC*, IPR2023-00757, Paper 11 at (PTAB Nov. 7, 2023)

(collecting relevant cases). Indeed, preparing an IPR petition is not an exercise in determining whether the same argument can be articulated using two different sets of words. Instead, “the critical inquiry [under *Xerox*] is whether a declaration is conclusory and unsupported and whether it discloses underlying facts or data on which the opinion is based.” *Hum Industrial Tech., Inc. v. Amsted Rail Co., Inc.*, IPR2023-00540, Paper 10 at 37 (PTAB Aug. 11, 2023).

As to the “critical inquiry,” PO asserts (at 19) that Mr. Puchovsky’s declaration is conclusory with respect to the preamble’s recitation of “. . . a first track side section defining a first lowermost edge thereof and a second side track section defining a second lowermost edge thereof . . .” This language simply recites that the ceiling track has side sections that include bottom edges, as does any ceiling track that has ever existed. Indeed, PO cannot credibly argue that the art did not disclose ceiling tracks that have bottom edges; like all objects, the ceiling track terminates at some point.

For this limitation, Mr. Puchovsky includes the annotated figure included in the POPR (at 19), which highlights the ceiling track in blue, points to the side track sections, and shows that the ceiling track—again like all ceiling tracks—has a bottom edge on either side. Contrary to PO’s argument (at 19), Mr. Puchovsky does more than “simply quote[] the claim language to say Pilz I discloses [this] limitation” as evidenced by the annotated figure included in the POPR. Because Puchovsky’s

testimony on this exceedingly well-known component is not conclusory, PO's cited authority is inapposite.

PO next argues (at 21-22) that the Petition relies on an alleged conclusory opinion from paragraph 87 of Mr. Puchovsky's declaration for the "connecting strap" limitation. To do so, PO omits (at 22) the majority of paragraph 87's analysis, quoting only a portion of it. When the entirety of paragraph 87 is reviewed, it is clear that Mr. Puchovsky supported his opinion, noting that "Pilz I explains that L-shaped gasket sections 120 can be adhered to ceiling track 114 (Ex. 1004, ¶0057) such that when the ceiling track 114 is attached to, pressed, and/or placed against the fire strap 116, the gasket or gaskets 120 can 'form a sound and/or air seal, inhibiting sound and/or air from moving from one side of the ceiling track to the other.' Ex. 1004, ¶0058. Alternatively, Pilz I discloses that fire strap 116 can be attached directly to the ceiling track. Id., ¶0059." Ex. 1003, ¶87. Puchovsky then includes an annotated figure to illustrate the structure described in Pilz I, which PO also failed to include in its POPR or otherwise address.

PO next argues (at 24) that paragraph 124 of Mr. Puchovsky's declaration is conclusory. But the POPR quotes Mr. Puchovsky's analysis explaining why a POSITA would identify the portion of the gasket identified in the figure at paragraph 123 (which is further explained at paragraphs 102-104 with reference to the disclosure of Pilz I) as a connecting strap. While PO clearly and unmistakably

believes that the structure annotated by Mr. Puchovsky is not a connecting strap as claimed (albeit without offering a construction of connecting strap that could aid the Board in making that determination at this stage), that does not make Mr. Puchovsky's declaration "conclusory."

Finally, PO takes issues (at 25) with Mr. Puchovsky's opinion "that the prior art disclosed that it was known to limit spatial separation between two objects through a strap like material," which opinion Mr. Puchovsky supports with reference to annotated figures. *See* Ex. 1003, ¶¶89-90, 126-127. Indeed, PO cannot credibly claim that it invented the concept of connecting two objects with a strap.

C. The Board should not deny institution under *Fintiv*.

PO devotes several pages to arguing the *Fintiv* factors. However, not once does PO address the fact that Petitioner submitted a *Sotera* stipulation. *See* Ex. 1015. Under the Director's Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation dated June 21, 2022 on which Petitioner relied, the Board "will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB." As such, the *Fintiv* factors do not provide a basis for denial.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing PETITIONER'S PRE-INSTITUTION REPLY was served in its entirety by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) as well as providing a courtesy copy via e-mail to the following attorneys of record for the Patent Owner listed below:

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