

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
Patent No. 9,157,232

PATENT OWNER'S SUR-REPLY

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Patent Owner Specified Technologies Inc. (“STI”) provides this sur-reply to Petitioner Hilti Aktiengesellschaft’s (“Hilti” or “Petitioner”) Reply to STI’s Patent Owner’s Preliminary Response (“POPR”) to Hilti’s Petition (“Pet.”).

I. STI DID NOT MISSTATE CLAIM CONSTRUCTION POSITIONS.

Contrary to Petitioner’s suggestion, (Reply at 1, 5), merely stating it “applie[d] the plain and ordinary meaning of the claim terms” does not provide notice, especially to this Board, of Petitioner’s claim construction positions. As explained in the POPR and below, Petitioner claims to apply the plain and ordinary meaning (“POM”) to claim terms, but in reality its claim construction position either (1) fails to actually construe any term and instead adds additional limitations and/or (2) construes a term in a way that is objectively not the POM. Either way, these constructions were not disclosed to the Board in the Petition. Petitioner’s attempt to now present these constructions and/or argue that the prior art reads on those limitations is untimely. Any consideration of those arguments is not only prejudicial to STI—permitting Petitioner to inject arguments into the Petition months after filing and in excess of the word limit—but it sets a dangerous precedent that rewards Petitioners who hide the eight ball in their Petition and, if called to account for any deception, allows them to simply and belatedly explain away what they meant by “POM.”

A. “at least one connecting strap positioned above the main track section of the ceiling track”

Petitioner either misstates or misunderstands STI’s arguments to wrongly claim STI misstated Petitioner’s position.¹ First, STI presented argument and evidence that despite applying the POM to all terms, “*Petitioner does not believe* the [POM] should be given to [this] claim term[.]” (POPR at 9-10 (emphasis added).) As repeatedly noted by Petitioner in the claim construction briefing, Petitioner only adopted STI’s construction “[t]o narrow issues for the Court” but has never conceded that STI’s position is correct or that Petitioner’s originally proposed construction was incorrect. (*See, e.g.*, Ex. 1018 at exhibit pages 161-164.)

Even if STI had misstated Petitioner’s interpretation of this term—which it did not—Petitioner still does not believe this term should be construed according to its POM. For example, in the December 22, 2023 response brief and April 1, 2024 Joint Claim Construction Brief, Petitioner took the position that (1) “positioned above” means “installed on,” (*see, e.g., id.* at 165-167), and (2) the connecting strap must be intact when the gasket, (addressed *infa* § I.C), is installed on the ceiling

¹ Contrary to Petitioner’s assertion, STI never took the position during the Parties’ meet and confer that it does “not have a duty to advise the Board of Patent Owner’s actual claim construction position.” (Reply at 1-2, n.1.) Putting aside the relevance of STI’s construction, the only thing STI stated that it did not have a duty to disclose to the Board was the fact that Petitioner submitted a *Sotera* stipulation, at least because this fact was noted in and filed with the Petition. (*See* Pet. at 77; Ex. 1015.)

track, (*id.*). Not only is “installed on” not the POM of “positioned above” but Petitioner does not disclose that it believes this term means that the gasket is installed on the ceiling track, much less provide any analysis thereof.

B. “spatially disposed”

Petitioner contends that it provided notice because it “indicated that it applies the [POM] of that term.” (Reply at 2.) But Petitioner does not construe the term “spatially disposed”; rather, it simply adds extra limitations to it. (*See* Ex. 2002 at 19 (contending “spatially disposed” means “spatially disposed from the entirety of the first and second side track sections”); Ex. 1018 at 171 (same).) Petitioner does not contest that this construction was not presented in its Petition, nor could it. (Reply at 2-3; *see generally* Pet.)

Speciously ignoring this fact, Petitioner erroneously claims it addressed this limitation because it explained that the gasket sections are adhered/adhesively joined to the ceiling track while the vertical sides or side panels of the L-shaped gaskets are free to move. (Reply at 2-3 (citing Pet. at 47, 67).) Nowhere in its Reply or Petition does Petitioner reference or explain that this term meant spatially disposed “from the entirety of the first and second side track sections” much less how (1) “free to move

means” spatially disposed from the entirety of the track section² or (2) how the prior art reads on this understanding. (*See* Reply at 2-3; Pet. at 47, 67.)

C. “and attached to said first L-shaped gasket section and to said second L-shaped gasket section to limit spatial separation therebetween”

Similar to Petitioner’s position with “spatially disposed,” Petitioner claims to give the above term its POM but again fails to construe any aspect of the term and instead adds a limitation to it, i.e., “therebetween when the gasket is positioned on the track.” (*See* POPR at 10; Reply at 3.) Petitioner does not contest that it believes this construction to be correct, that it failed to include the construction in its Petition, or that it failed to analyze how the prior art reads on the claim under this construction.³ (*See generally* Pet.; Reply.)

D. Preamble of Claim 6

Petitioner does not contest that it believes its construction is correct, that it failed to include the construction in its Petition, or that it failed to analyze how the prior art reads on the claim under this construction. (*See generally* Pet.; Reply.)

² Notably, “moveable” is another limitation of claim 8. (*See* Ex. 1001 at 14:16-25.)

³ STI mistakenly identified this term as one that Petitioner claimed was indefinite, which Petitioner correctly notes. (*See* Reply at 3.) That does not, however, negate the fact that Petitioner failed to present or apply its construction in this proceeding.

E. Indefiniteness

Contrary to Petitioner’s suggestions, the Board cannot “exceed its statutorily limited authority” and rule on indefiniteness but may only “decline to institute the IPR” or “conclude that it could not reach a decision on the merits.” *Samsung Elecs. Am., Inc. v. Prisia Eng’g Corp.*, 948 F.3d 1342, 1353 (Fed. Cir. 2020). Because Petitioner has taken inconsistent positions, arguing that the claims are indefinite or should be construed in a way it failed to disclose to the Board, the Board should merely decline institution.

Accordingly, Petitioner hasn’t disclosed (or applied) its constructions in the Petition, denial of institution is warranted.

II. PETITIONER’S ARGUMENTS REGARDING THE PUCHOVSKY DECLARATION’S WEIGHT AND THE PETITION’S FAILURE TO SHOW ALL CLAIMED LIMITATIONS IN THE ART IS SIMPLY MISDIRECTION.

Rather than address STI’s arguments, Petitioner baselessly argues that because Puchovsky provides support for certain findings, all of his opinions are supported. (Reply at 5-8.) Not true. As outlined in STI’s Response and below, neither the Petition nor Puchovsky provide anything more than conclusory statements regarding various critical limitations. (*See* POPR at 12-26.)

Notably, Petitioner does not dispute that Puchovsky’s declaration is a verbatim recitation of the Petition or that it fails to cite supporting evidence or

provide technical reasoning to support the alleged motivation to combine arguments or the limitation-by-limitation analyses for multiple limitations. (*Compare* POPR at 14-17 (providing numerous examples of verbatim and unsupported testimony in Section II(A) and explaining why this should be given no weight) *with* Reply at 5-8 (not disputing Section II(A) and responding only to arguments that Petitioner failed to show the limitations were found in the prior art, Section II(B).) To the extent Petitioner did address STI's arguments, Petitioner's rebuttal lacks merit.

A. Limitation 6pre.

Contrary to Petitioner's argument, the Petition and Puchovsky declaration *do* simply quote the claim language of Limitation 6pre to assert that Pilz I purportedly discloses this limitation. (POPR at 18-20.) As previously explained, the annotated figure that Petitioner now relies upon does not disclose each limitation. Indeed, Petitioner does not dispute that the annotated figure does not explain where or how the prior art discloses "a first lower most edge" or "a second lower most edge." (*Compare id.* at 19-20 with Reply at 6-7.) This alone should be dispositive.

B. Limitation 6e.

First, Petitioner's arguments with respect to the "connecting strap" limitation, Limitation 6e, Petitioner continues its game of misdirection. (Reply at 7.) Petitioner ignores STI's arguments and instead points to a portion of paragraph 87 to claim

Puchovsky's opinion is not conclusory. However, as previously outlined, the Petition explains that both the gasket sections and the strap are connected to the ceiling track, which is what is being stated in the portion of paragraph 87 now cited by Petitioner. (Compare POPR at 22 with Reply at 7.) But what STI argued is unsupported is how the Petition or Puchovsky make the conclusory leap that this disclosure from Pilz I shows that (1) the strap is attached to a gasket section or (2) the strap limits spatial separation between the gasket sections. (POPR at 22.) Petitioner does not address or dispute that the analysis for these limitations for Ground 1A is conclusory and unsupported. (*See generally* Reply.)

Second, Petitioner confusingly states that paragraph 124 of Puchovsky's declaration is not conclusory and unsupported because the analysis and explanation are found in paragraph 123 and explained at paragraphs 102-104. (Reply at 7-8.) Paragraph 123 is merely a recitation of the claim language and an annotated figure which appears to assert, without support or analysis, that the intumescent material discloses two gasket sections attached to a strap that limits spatial separation therebetween. (Ex. 1003 at ¶ 123.) Moreover, neither the Petition nor Puchovsky's declaration cite paragraphs 102-104 for limitation 6e. (*See id.*; Pet. at 62-66.)

Third, Petitioner does not dispute (1) that the cited art does not reference a "strap," (2) the nature of the materials that Petitioner has identified as straps, or (3)

that there is no claim a POSITA would be motivated to modify Pilz I based on these disclosures. (*Compare* POPR at 24-25 *with* Reply at 8.)

Because the Petition is unsupported and fails to show how each limitation is met, institution should be denied.

III. PETITIONER’S STIPULATION.

Petitioner’s stipulation relates to *Fintiv* Factor 4, the overlap of issues in different proceedings. *See, e.g., Samsung Elec’s Co. Ltd., v. Mojo Mobility, Inc.*, IPR2023-01094, Paper 11 at 10-13, 29 (Feb. 9, 2024) (discretionarily denying institution and finding stipulation that limited but still allowed petitioner to raise similar arguments in district court weighs only slightly against discretionary denial for factor 4). Here, Petitioner has stated “Factor 4 weighs in favor of discretionary denial.” (Pet. at 79.) STI relied on this and believes this to be true because Petitioner has asserted various prior art products in District Court that will duplicate the efforts of the parties even if this IPR is instituted. For this reason, and the other reasons expressed in its Response, (*see* POPR at 28-33), discretionary denial is appropriate.

CONCLUSION

For the reasons stated herein and in Patent Owner’s Preliminary Response, the Board should not institute *inter partes* review of the ’232 Patent.

Dated: April 11, 2024

By: /s/ Lukas Toft
Lukas Toft
Reg. No. 75,311
Fox Rothschild LLP
33 South Sixth Street, Suite 3600
Minneapolis, MN 55402
Tel: 612.607.7336
Fax: 612.607.7100
ltoft@foxrothschild.com

Jeff E. Schwartz
Reg. No. 39,019
Fox Rothschild LLP
2020 K Street N.W., Suite 500
Washington, DC 20006
Tel: 202.696.1470
Fax: 202.461.3102
jeschwartz@foxrothschild.com

Carol E. Thorstad-Forsyth
Reg. No. 56,455
Fox Rothschild LLP
777 South Flagler Drive, Suite 1700
West Palm Beach, FL 33401
Tel: 561.804.4438
Fax: 561.835.9602
cforsyth@foxrothschild.com

Ryan North Miller
Reg. No. 68,262
Fox Rothschild LLP
2000 Market Street, 20th Floor
Philadelphia, PA 19103
Tel: 215.299.2901
Fax: 215.299.2150
rmiller@foxrothschild.com

P. Marshall Ticer
Reg. No. 74,653
Fox Rothschild LLP
2020 K Street N.W., Suite 500
Washington, DC 20006
Tel: 202.794.1237
Fax: 202.461.3102
mticer@foxrothschild.com

Bradley T. Edgington
Reg. No. 77,575
Fox Rothschild LLP
500 Grant Street, Suite 2500
Pittsburgh, PA 15219
Tel: 419.394.5597
Fax: 412.391.6984
bedgington@foxrothschild.com

John Edwin Ryan R. Guerrero
Reg. No. 82,155
Fox Rothschild LLP
2501 N. Harwood Street, Suite 1800
Dallas, TX 75201
Tel: 214.231.5741
Fax: 972.404.0516
jguerrero@foxrothschild.com

**Counsel for Patent Owner
Specified Technologies Inc.**

CERTIFICATE OF WORD COUNT

Pursuant to 37 CFR § 42.24(d), the undersigned hereby certifies that the foregoing Patent Owner's Sur-Reply contains 1,670 words using the word count feature of Microsoft Word.

Dated: April 11, 2024

/s/ Lukas Toft

Lukas Toft

Reg. No. 75,311

Counsel for Patent Owner

Specified Technologies Inc.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I certify that on this 11th day of April, 2024, a copy of PATENT OWNER’S SUR-REPLY was served by electronic mail on Petitioner’s counsel, lead and back-up, as follows:

Lead Counsel

Michael A. Dorfman, Reg. No. 46,669
mdorfman@gardellagrace.com

Back-up Counsel

Natalie J. Grace, Reg. No. 65,803
ngrace@gardellagrace.com

Counsel for Petitioner has consented to service of all documents via electronic email. *See* Petition, Paper 2 at 81.

Dated: April 11, 2024

/s/ Lukas Toft

Lukas Toft
Reg. No. 75,311
Counsel for Patent Owner
Specified Technologies Inc.