

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HILTI AKTIENGESELLSCHAFT

Petitioner,

v.

SPECIFIED TECHNOLOGIES INC.,

Patent Owner.

Case No. IPR2024-00193

U.S. Patent No. 10,143,868

PETITIONER'S PRE-INSTITUTION REPLY

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

Patent Owner (“PO”) argues (at 7-9) that the Board should deny institution because Petitioner allegedly fails to provide notice of its proposed claim constructions. Yet, PO admits (at 8) 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 Petitioner of taking inconsistent claim construction positions, arguing (at 7) 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.

PO first addresses (at 8) the term reciting “moveable relative to one another” with reference to the below chart.

Claims 1 & 9: “moveable relative to one another”	“moveable in a defined relationship to one another”
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But that chart does not fully state Petitioner’s claim construction. Instead, Petitioner has been clear in its position that this term should be construed according to its ordinary meaning. Indeed, in the District Court, Petitioner clearly argued that “that this term should be construed according to its plain meaning to mean that the housing members are ‘moveable in a defined relationship to one another.’” *See Hilti AG v. Specific Technologies, Inc.*, Civ. No. 22-cv-1248-CJB, Dkt. 175 at 169 (D.

Del.). PO disagrees with Petitioner’s articulation of the plain meaning, but that does not mean that the Petition did not apply the plain meaning as understood by Petitioner. And contrary to PO’s assertion, the Petition clearly identifies prior art structure that meets the plain meaning of this term. *See* Pet. at 56 (“Ramorino discloses that elements 5 are ‘hinged to each other by way of a hinge, or a specific mechanical folding system 6 allowing the elements 5 to rotate about an axis parallel to the axis A.’”); 66-67 (same); 85 (Feil discloses that “sleeve 20 comprises first and second elongated parts 36 and 37 that are hingedly connected by hinge 33, and that comprise respective edges that can be at least closely abutted against each other (e.g., can be contacted with each other) when parts 36 and 37 are closed together clamshell-style to form sleeve 20.”). Notably, PO does *not* argue that the prior art does not disclose housing members that move relative to one another in a defined relationship consistent with Petitioner’s articulation of the plain meaning.

As to the other two terms addressed in the Patent Owner’s Preliminary Response (“POPR”), PO is incorrect in asserting that Petitioner did not disclose its claim construction as explained above. Moreover, even if Petitioner’s District Court constructions differ from the plain meaning of those terms (which they do not), PO is incorrect in implying that the prior art does not disclose the claims under the construction Petitioner identifies. For example, with respect to Grounds 1A and 1B, the Petition explains that “Ramorino discloses that elements 5 are ‘hinged to each

other by way of a hinge, or a specific mechanical folding system 6 allowing the elements 5 to rotate about an axis parallel to the axis A.” Pet. at 56, 66-67; *see also* 85 (“Feil discloses that ‘sleeve 20 comprises first and second elongated parts 36 and 37 that are hingedly connected by hinge 33, and that comprise respective edges that can be at least closely abutted against each other (e.g., can be contacted with each other) when parts 36 and 37 are closed together clamshell-style to form sleeve 20.”). These structures allow the housing members to move relative to one another while not completely detached. And again, PO notably does **not** argue that the prior art does not disclose Petitioner’s articulation of the plain meaning.

Similarly, the Petition identifies disclosures to demonstrate that the opening in the housing can be positioned about a sleeve, cables, or conduits and returned to the assembled condition. *See* Pet. at 57 (“The ‘open condition’ is present when the elements 5 [] rotate about an axis parallel to the axis A,” (e.g., as the device is placed around a conduit) which, when not closed, would result in an opening in the side of the internal chamber. Ex. 1004 at 12:28- 13:4; 17:28-30 (“In use, the device 1 is assembled on a pipe, arranged through a wall or floor W, in the initial configuration shown in figures 1 and 2 and in the left part of figure 3”); 69 (same); 86 (“In Feil, the ‘open condition’ exists when the housing parts 36 and 37 are opened (e.g., to fit around a cable) and the ‘assembled condition’ exists “when parts 36 and 37 are closed together clamshell-style to form sleeve 20.” Ex. 1005 at 13:4- 18; Ex. 1003,

¶152.”). Again, PO does not argue that the prior art fails to disclose this element or otherwise offer a construction under which the Board could 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 11) 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 12-13) that Mr. Puchovsky’s declaration is conclusory with respect to the motivation to combine. However, Mr. Puchovsky’s declaration includes seven paragraphs spanning several pages identifying numerous motivations to combine. Ex. 1003, ¶¶77-83. Despite this, PO focuses on paragraph 80 of Mr. Puchovskys’ declaration while failing to note the preceding paragraphs, which explain in detail the benefits of a detachable hinged arrangement. For example, paragraph 79 explains: “As discussed by Feil, in that situation, it would be advantageous to completely separate the two housing members so that each housing member can be separately placed around a conduit prior to closing the device. For example, if there is insufficient clearance (e.g., due to a ceiling or wall) to rotate the device around its axis to the necessary width while the housing members were connected, it would be advantageous to place each housing member separately.” Ex. 1003, ¶79.

PO also alleges that Paragraph 81 of the Puchovsky declaration is conclusory, but that paragraph plainly supports Mr. Puchovsky's opinion that cost savings would motivate a POSITA by identifying how the combination would avoid the cost and complexity of a separate component—a common sense point that fewer components will reduce cost and complexity. Similarly, PO attacks paragraph 82 as conclusory, but that paragraph includes substantial detail on the motivation including with quotes from the combined references. PO's attack on paragraph 83 as conclusory is equally lacking in merit because Mr. Puchovsky supports his obvious design choice opinion by identifying the finite design choices that are available, including with citation to paragraphs 71-76 addressing background references.

Simply put, Mr. Puchovsky's detailed motivation to combine analysis is not of the kind and character to which the Board has declined to assign weight, making PO's cited authority inapposite. PO's true quibble appears to be with the merits of the Petition's numerous motivations to combine, but that factual issue will be addressed after institution and through (presumably) expert testimony from PO.

PO also argues (at 16) that Mr. Puchovsky's discussion of the appropriate construction of the term "panel" is conclusory. As an initial matter, Mr. Puchovsky testifies that his opinion is that the term "panel" would be understood according to its plain meaning. The portion of his opinion PO cites is addressing **PO's own** strained district court construction, which PO notably does **not** apply in its POPR,

making this issue irrelevant for present purposes. Ex. 1003, ¶88. Moreover, Puchovsky’s opinion is not conclusory and instead relies on his experience to make the common sense point that “panel” is a broad term that includes separate panels, integral panels, curved panels, and flat panels.

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. 1021. 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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