

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
Patent No. 10,143,868

PATENT OWNER'S SUR-REPLY

TABLE OF CONTENTS

	Page(s)
I. STI Did Not Misstate Claim Construction POSITIONS.....	1
A. “moveable relative to one another”	1
B. Limitations 1d & 9c.....	2
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.	5
A. Motivation to Modify Ramorino.....	5
III. Petitioner’s Stipulation.	8
CONCLUSION	8
CERTIFICATE OF WORD COUNT.....	11
CERTIFICATE OF SERVICE	12

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>DIRECTV, LLC v. Qurio Holdings Inc.</i> , IPR2015-02007, Paper 6 (PTAB Apr. 4, 2016)	4
<i>Hilti Aktiengesellschaft v. Specified Technologies Inc.</i> , C.A. No. 22-1248-CJB, Dkt. 148 (D. Del. Dec. 26, 2023)	8
<i>Samsung Elec’s Co. Ltd., v. Mojo Mobility, Inc.</i> , IPR2023-01094, Paper 11 (Feb. 9, 2024)	8
Other Authorities	
37 C.F.R. § 42.104	2
37 C.F.R. § 42.104(b)(3)	2
37 C.F.R. § 42.104(b)(4)	2

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, 4), 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 positions at the District Court that are referenced in the POPR fail to actually construe any term and instead simply add additional limitations. 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 explain away what they meant by “POM.”

A. “moveable relative to one another”

Contrary to Petitioner’s argument, (Reply at 1-2), adding limitations without

construing any of the actual claim terms is a proposed construction—and not simply the POM of a term—which should be presented in the Petition pursuant to Rule 104. *See* 37 C.F.R. §§ 42.104(b)(3)–(4); Consolidated Trial Practice Guide November 2019 at 44. Petitioner does not dispute that (1) it believes this claim element should be required to include an additional limitation, i.e., “in a defined relationship” or (2) that it failed to disclose this construction in its Petition. (*See id.*; *see also* Ex. 1024 at exhibit p. 182 (presenting same construction in District Court briefing filed April 1, 2024).) Instead, Petitioner attempts—for the first time in its Reply—to explain how the art purportedly reads on this previously undisclosed construction. First, there is no analysis for how the cited art discloses a “defined relationship,” a term not found in the Petition. (*See generally* Pet.) Second, raising this argument for the first time in Reply is improper. *See* U.S. Patent Trial and Appeal Board, Consolidated Trial Practice Guide Nov. 2019 at 73 (a petitioner “may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability”).¹

B. Limitations 1d & 9c

Next, Petitioner speciously states that it disclosed its constructions for “the

¹ STI reserves all rights to address whether the asserted art reads on these claims under any construction should the Board institute.

other two terms addressed in the [POPR].” (Reply at 2; *see also* POPR at 8-9 (disclosing limitations for claim 1 and 9 and Petitioner’s undisclosed constructions thereof).) This is false. Petitioner fails to cite to anything to support its purported disclosure of its construction in the Petition, (*see generally* Reply), because it cannot. Petitioner’s construction, consistent with its *modus operandi*, adds additional limitations to the claim terms, i.e., “while not completely detached” to Limitation 1d and “such that the opening in the house can be positioned about a sleeve, cables, or conduits and returned to the assembled condition” to Limitation 9d. There is no such disclosure in the Petition.

Petitioner then attempts to suggest—again for the first time in Reply—that the prior art reads on these claims under these previously undisclosed constructions. (Reply at 2-3.) First, this untimely attempt to remedy deficiencies in the Petition is improper. *See* U.S. Patent Trial and Appeal Board, Consolidated Trial Practice Guide Nov. 2019 at 7.

Second, in its belated attempt to remedy its defective Petition, Petitioner improperly cross-references to and relies on support for other Limitations. For instance, to purportedly show that the art discloses the “not completely detached” addition to Limitation 1d, Petitioner cites primarily to its arguments for Claim 9. (*See* Reply at 2-3 (citing Pet. at 66-67 and 85).) Pages 66-67 of the Petition relate to

Limitation 9b and page 85 relates to Limitation 9c. (*See* Pet. at 66-67 and 85.) Likewise, to purportedly show the art discloses the “such that the opening in the housing can be positioned about a sleeve, cables, or conduits and returned to the assembled condition” addition to Limitation 9d, Petitioner cites *only* to arguments related to Limitations 1d and 9c. (*See* Reply at 3-4 (citing Pet. at 57 (Limitation 1c) and 69 and 86 (cited disclosure are made in the context of Limitation 9c).) Petitioner should not be allowed to supplement its arguments by belatedly cross-referencing across claims. Indeed, the Board has already rejected attempts by others to cross-reference in the Petition. *See, e.g., DIRECTV, LLC v. Qurio Holdings Inc.*, IPR2015-02007, Paper 6 at 9 (PTAB Apr. 4, 2016) (denying institution where “[p]etition’s analysis of [cited] elements features internal cross-references to its discussion of other elements, with minimal—and often no—additional discussion specifically directed to the language of these claim elements”). Cross-referencing arguments to shore up a position for the first time *in Reply* should also be readily rejected.

Moreover, the cited support does not disclose Petitioner’s construction and provides no analysis as to why a POSITA would understand the disclosure to read upon these constructions.²

² *See supra* note 1.

Accordingly, Petitioner has not been forthcoming on what it believes are the correct constructions, nor has it included the proper analysis of these alternative constructions in the Petition. This warrants denial of institution.

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 5-7 (but not disputing that Puchovsky’s declaration is a verbatim recitation of the Petition).) However, 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.)

A. Motivation to Modify Ramorino.

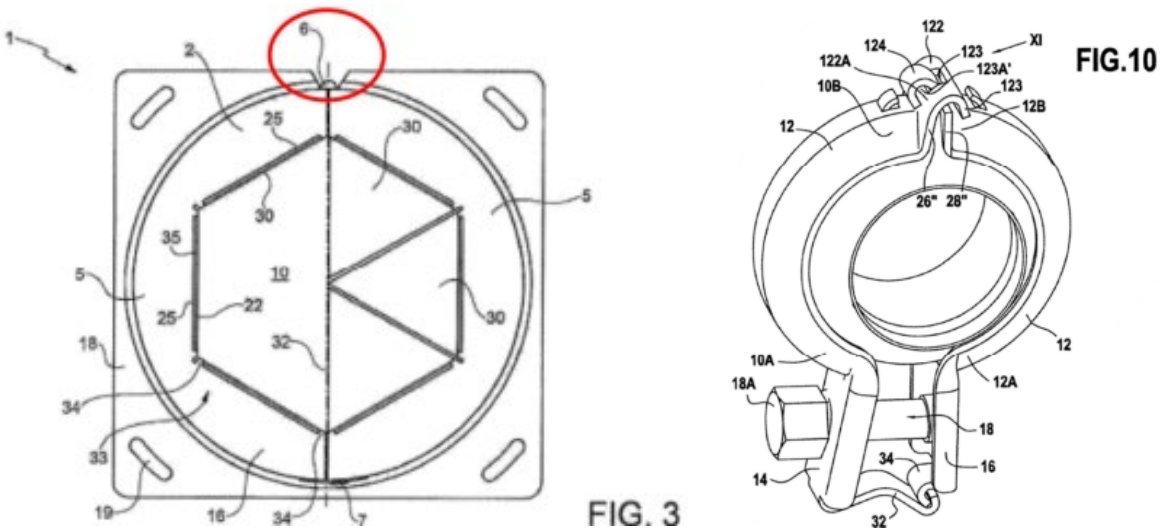
Contrary to Petitioner’s argument, (Reply at 5), the Petition and Puchovsky declaration *do not* provide support for why a POSITA would modify Ramorino. (POPR at 12-15.) Petitioner argues that STI was myopic in focusing on only paragraph 80 of Puchovsky’s declaration—which it did not do (*see id.* (taking issue with multiple paragraphs including paragraphs 80-83))—and should look at paragraphs 77-83 of Puchovsky’s declaration and more particularly paragraphs 79 and 82-83. (Reply at 5-6.) Notably, the Puchovsky declaration provides limited

support for only a couple statements related to Feil (Ex. 1005) in paragraphs 78, 80, and 82, and paragraph 83 only cross references other paragraphs discussing (non-asserted) art. (*See* Ex. 1003 at ¶¶77-83.) There is no other cited support for any statement made in these paragraphs. (*Id.*)

In addition, and as previously explained, Petitioner and Puchovsky state that a POSITA would understand Feil’s “interlocking teeth” to refer to the “simple hinge” of Rigollet and thus a POSITA would understand it would be advantageous to implement Rigollet’s hinge in Ramorino consistent with Feil’s disclosures. (*See* POPR at 12 (citing Pet. at 43-44; Ex. 1003 ¶ 80).) In reply, Petitioner cites to paragraph 79 to explain purported advantages of Feil. (Reply at 5.) However, there is still no explanation for (1) why a POSITA would understand Feil’s interlocking teeth” to refer to the “simple hinge” of Rigollet or (2) why a POSITA looking at Feil would forgo Feil’s “interlocking teeth,” look to Rigollet, and then implement Rigollet’s hinge in Ramorino. (*See* Reply at 5.) These logical leaps remain conclusory and steeped in hindsight.

Petitioner also baselessly claims Paragraphs 81-83 are not conclusory. (Reply at 6.) As explained above, Puchovsky fails to provide any cited support for a single statement in Paragraphs 81-82. For example, there is no explanation or analysis as to how or why manufacturing the complex hooked hinge arrangement of Rigollet

(right) saves money over the simple hinge (circled in red) of Ramorino (left) or what either option might cost, or how such conclusions were derived.



(See Pet. at 24, 35 (citing Ex. 1004, FIG. 3, Ex. 1013, FIG. 10); Ex. 1003 at ¶ 80.)

Next, Petitioner contends that Puchovsky’s “opinion is not conclusory,” despite not referencing any aspect of his alleged experience or providing a single citation in support of his opinion on the plain meaning of “panel.” (Reply at 6-7.) That is, Puchovsky does not provide any bounds or definition for what a POSITA would understand a panel to be but only that the definition is not limited in any way, i.e., a panel can be physically separate or integrated, a flat surface or curved. (Ex. 1003 at ¶ 80 (not even including a citation to the specification).) Then, without more, Puchovsky declares that Ramorino’s walls 15, 16 are “plainly” a panel. If expert opinions not supported by citation to evidence or explanation are not conclusory, then is anything?

Because the Petition is unsupported and fails to explain why the proposed combination should be made, 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 asserted various prior art products in District Court that will duplicate the efforts of the parties even if this IPR is instituted. *See, e.g., Hilti Aktiengesellschaft v. Specified Technologies Inc.*, C.A. No. 22-1248-CJB, Dkt. 148 at 54-62 (D. Del. Dec. 26, 2023) (identifying a 3M product later asserted, with others, in non-public infringement contentions). For this reason, and the other reasons expressed in its Response, (*see* POPR at 21-26), STI believes discretionary denial is still appropriate.

CONCLUSION

For the reasons stated herein and in Patent Owner's Preliminary Response, the Board should not institute *inter partes* review of the '868 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 1,677 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.