

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELTA POWER EQUIPMENT
CORPORATION; LOWE'S HOME CENTERS,
LLC; HOME DEPOT U.S.A., INC.,
Petitioners,

v.

P & F BROTHER INDUSTRIAL CORPORATION,
Patent Owner

**PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION
FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,475,622**

IPR2024-00347

Filed on behalf of Patent Owner by:

C. Matthew Rozier (Reg. No. 63,429)
1500 K Street, 2nd Floor
Washington, DC 20005
Email: matt@rhmttrial.com

James F. McDonough, III
659 Auburn Avenue NE, Unit 254
Atlanta, Georgia 30312
Email: jim@rhmttrial.com

ROZIER HARDT McDONOUGH PLLC

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37 C.F.R. § 42.65(a)	16

EXHIBIT LIST

Exhibit	Description
2001.	Complaint filed in <i>P & F Brother Industrial Corporation v. The Home Depot, Inc. and Home Depot U.S.A., Inc.</i> , E.D. Tex. No. 2:23-CV-00312-JRG (filed June 28, 2023; the “ <i>Home Depot</i> Litigation”)
2002.	Docket Control Order for <i>Home Depot</i> Litigation, {Dkt. No. 22 (Oct. 17, 2023)} (“ <i>Home Depot</i> DCO”)
2003.	Invalidity Contentions served in the <i>Home Depot</i> Litigation (Nov. 09, 2023)
2004.	Complaint filed in <i>P & F Brother Industrial Corporation v. Lowes Companies, Inc., Lowe’s Home Centers, LLC</i> , E.D. Tex. No. 2:23-CV-00313-JRG (filed June 28, 2023; the “ <i>Lowe’s</i> Litigation”)
2005.	Docket Control Order for <i>Lowe’s</i> Litigation, {Dkt. No. 21 (Oct. 17, 2023)} (“ <i>Lowe’s</i> DCO”)
2006.	Invalidity Contentions served in the <i>Lowe’s</i> Litigation (Nov. 09, 2023)
2007.	Consolidation Order filed in <i>P & F Brother Industrial Corporation v. Lowes Companies, Inc., Lowe’s Home Centers, LLC</i> , E.D. Tex. No. 2:23-CV-00313-JRG and <i>P & F Brother Industrial Corporation v. The Home Depot, Inc. and Home Depot U.S.A., Inc., LLC</i> , E.D. Tex. No. 2:23-CV-00312-JRG
2008.	P & F Brother Industrial Corporation Notice Letter to The Home Depot, Inc. and Home Depot U.S.A., Inc., dated November 2, 2022.

I. INTRODUCTION

P & F Brother Industrial Corporation (“Patent Owner”) respectfully submits this Preliminary Response (the “Response”) to Petition for *Inter Partes Review* No. IPR2024-00347 (Paper 1) (the “Petition” or “Pet.”) of U.S. Patent No. 7,475,622 (the “’622 patent”) filed by Delta Power Equipment Corporation (“Delta”), Lowe’s Home Centers, LLC (“Lowe’s”), and Home Depot U.S.A., Inc. (“Home Depot”) (collectively, “Petitioners”). The Petition identifies Delta, Lowe’s, and Home Depot as real parties-in-interest.

Institution should be denied because the Petition fails to demonstrate a reasonable likelihood that any claim of the ’622 patent is unpatentable at least because Petitioners ***have not and cannot*** meet its burden to show that the references applied by the Petition, taken alone or in combination, teach or suggest limitation [1.13] of independent claim 1. First, Petitioners ***have not*** met their burden because the Petition merely parrots the claim language in conclusory fashion, improperly leaving Patent Owner and the Board to figure out exactly how the prior art references could potentially map to certain features of limitation [1.13]. Second, Petitioners ***cannot*** meet their burden because the only reference relied upon by Petitioners to show limitation [1.13] actually teaches the opposite of limitation [1.13], as detailed herein. The other challenged claims each depend from and add limitations to claim

1, and the Petition therefore also fails to demonstrate a reasonable likelihood that those claims are unpatentable.

The Board should also exercise its discretionary power to deny institution under 35 U.S.C. § 314(a) because a jury trial in parallel litigations challenging the exact same claims on the exact prior art and grounds presented in the Petition will conclude before any Final Written Decision (“FWD”) would issue on the Petition. *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 15 at 13, 17 (PTAB May 13, 2020) (precedential) (“*Fintiv*”) (“denying institution where trial in parallel proceeding was scheduled to begin two months before final written decision”); *see* Exs. 2001, 2002, 2004, and 2005. Infringement and invalidity contentions¹ have already been exchanged by the parties in parallel litigations, and the exact same invalidity arguments will be tried to a jury in the *Home Depot* Litigation two months before the statutory date of June 6, 2025 for the issuance of any FWD on the Petition, and tried in the *Lowes* Litigation a month and a half before the statutory date. There is near total overlap between the parties here and in the parallel litigations. Instituting trial on this Petition will not serve as an “effective and efficient alternative” to litigation, frustrating a primary objective of the AIA. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sep. 6, 2017) (precedential).

¹ Exs. 2003 and 2006.

For these reasons, institution should be denied.

II. FACTUAL BACKGROUND

Patent Owner P & F Brother Industrial Corporation and its subsidiaries manufacture and sell a variety of power tools, including various types of power saws, and have done so since 1983. *See* <https://www.pandfbrother.com>; <https://www.pandfbrother.com/about.php>. For a period of years, a subsidiary of Patent Owner manufactured table saws that were eventually sold under a certain brand name by stores in the United States, including Home Depot. In 2014, Patent Owner ceased manufacturing table saws for the brand. Subsequently, Petitioner Delta was granted the contract to manufacture the brand's table saws, and at least some of those table saws included a clamping mechanism that infringed Patent Owners' '622 patent. Those table saws are and were sold by Petitioners Lowe's and Home Depot.

Patent Owner eventually discovered that table saws with infringing clamp mechanisms were being sold at Home Depot stores and sent a letter on November 2, 2022, notifying Home Depot of its infringement of the '622 patent. Ex. 2008. Patent Owner learned that Delta sold the table saws to Home Depot, and also learned that the same table saws were also being sold by Lowe's. The infringement did not cease, and Patent Owner initiated patent infringement litigations against Home Depot and Lowe's. *See* Petition, p. 1. Those litigations are ongoing.

III. STATEMENT OF THE PRECISE RELIEF REQUESTED

Patent Owner requests that the Board deny institution of the Petition with respect to all challenged claims and all asserted grounds. A full statement of the reasons for the relief requested is set forth in Sections IV and V of this Response.

IV. THE PETITION SHOULD BE DENIED BECAUSE IT DOES NOT ESTABLISH A REASONABLE LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIM

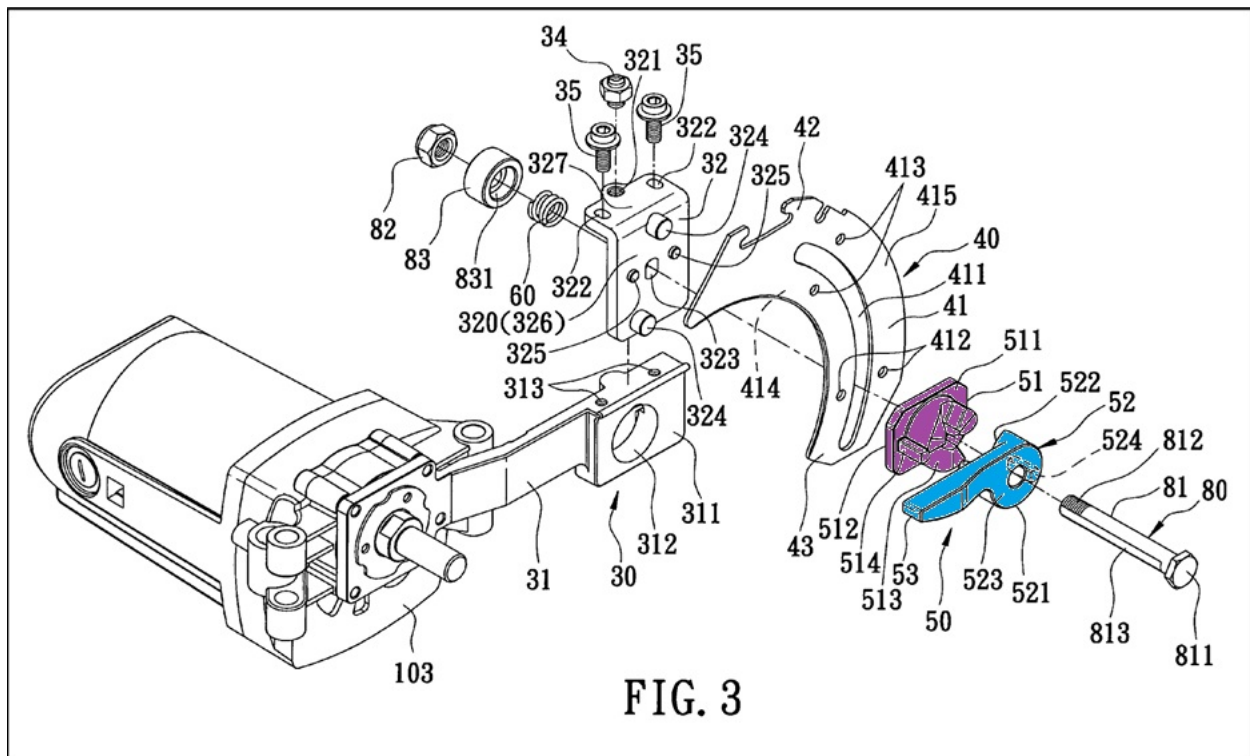
As detailed below, the Petition fails to demonstrate a reasonable likelihood that Petitioners would prevail with respect to any claim of the '622 patent. The Petition challenges independent claim 1 and dependent claims 2, 5, and 9 through five different §103 grounds, with further modifications based on the alleged knowledge of a person of ordinary skill in the art ("POSITA"). But the references and combinations thereof fail to disclose key limitations of each challenged claim. The Petition should not be instituted.

A. THE '622 PATENT

The '622 patent is directed towards a supporting device adapted for mounting a protective cover to shield a cutting blade of a cutting machine. Ex. 1001, at Abstract. The supporting device includes "a mount unit with a proximate tightening surface, a tightening bolt passing through the proximate tightening surface, a supporting frame adapted for holding the protective cover and having a guiding slot for passage of the tightening bolt so as to be movable between a position of use and a retreat position, a movable tightening member with a distal tightening surface and

a cam follower surface, a cam actuating member having a cam surface mating with the cam follower surface and turnable to tighten or loosen the supporting frame, and a biasing member disposed to keep the actuating body in a tightening position.” *Id.*

An exploded perspective view of a preferred embodiment of the claimed device is shown in Figure 3 of the '622 patent, reproduced and annotated below:

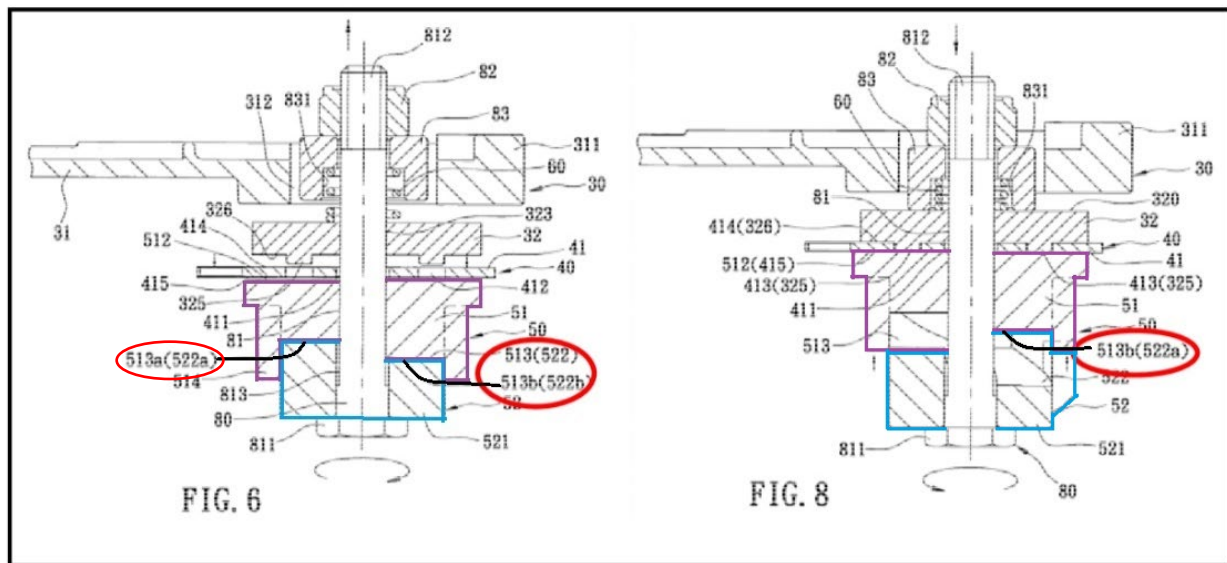


“[T]he cam follower surface (**513**) has first and second pressed areas (**513a**, **513b**) which are angularly displaced from each other about the tightening axis, and which are respectively proximate to and distal from the distal tightening surface **512** along the tightening axis.” Ex. 1001, at 5:3-7.

“The cam surface **522** is of a wedge shape.” *Id.* at 5:17. It “has first and second pressing spots (**522a**, **522b**) which are angularly displaced from each other

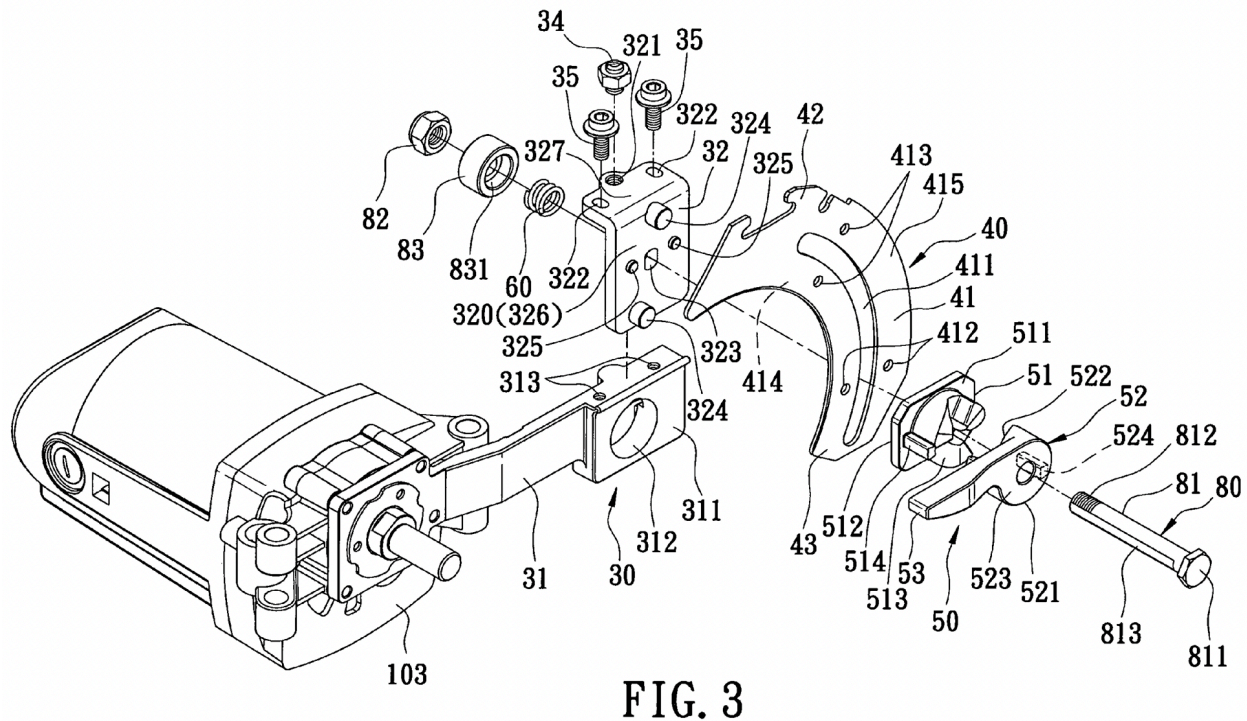
about the tightening axis such that, the first and second pressing spots (**522a**, **522b**) are brought into contact with the first and second pressed areas (**513a**, **513b**), respectively, when the cam surface **522** is brought to mate with the cam follower surface **513** in a loosened position (as shown in FIG. 6), and such that, when the actuating body **521** is turned about the tightening axis to a tightening position (as shown in FIG. 8), the first pressing spot (**522a**) is displaced to contact the second pressed area (**513b**) with an axial frictional force . . .” *Id.* at 5:18-29.

Figures 6 and 8 are reproduced and annotated below:



In these figures, the moveable tightening member (51) has been outlined in purple and the cam actuating member (522) has been outlined in blue. For ease of reference, the lines showing the locations of the first and second pressed areas (513a and 513b) and the first and second pressing spots (522a and 522b) have been darkened.

Fig. 3 discloses an exploded view of an embodiment of a clamping mechanism:



With reference to FIG. 3, the '622 patent discloses that:

The biasing member 60 is a coil spring 60 in this embodiment. The coil spring 60 is disposed to surround the shank 81, and has an end abutting against the major abutment wall 320, and an opposite end which is received in the accommodation chamber 831 in the flexible joint 83. Thus, *the coil spring 60 acquires a biasing force which urges the tightening bolt 80 and the movable tightening unit 50 rearwardly* so as to force the middle segment 41 of the supporting frame 40 to abut against the proximate tightening surface 326.

Id. at 5:41-49 (emphasis added). Furthermore, as shown in FIG. 8, “the coil spring 60 is being compressed to acquire an increment of the biasing force which can *bias the front end 811 of the shank 81 towards the supporting frame 40* so as to

counteract the axial frictional force to thereby keep the actuating body 521 in the tightening position”:

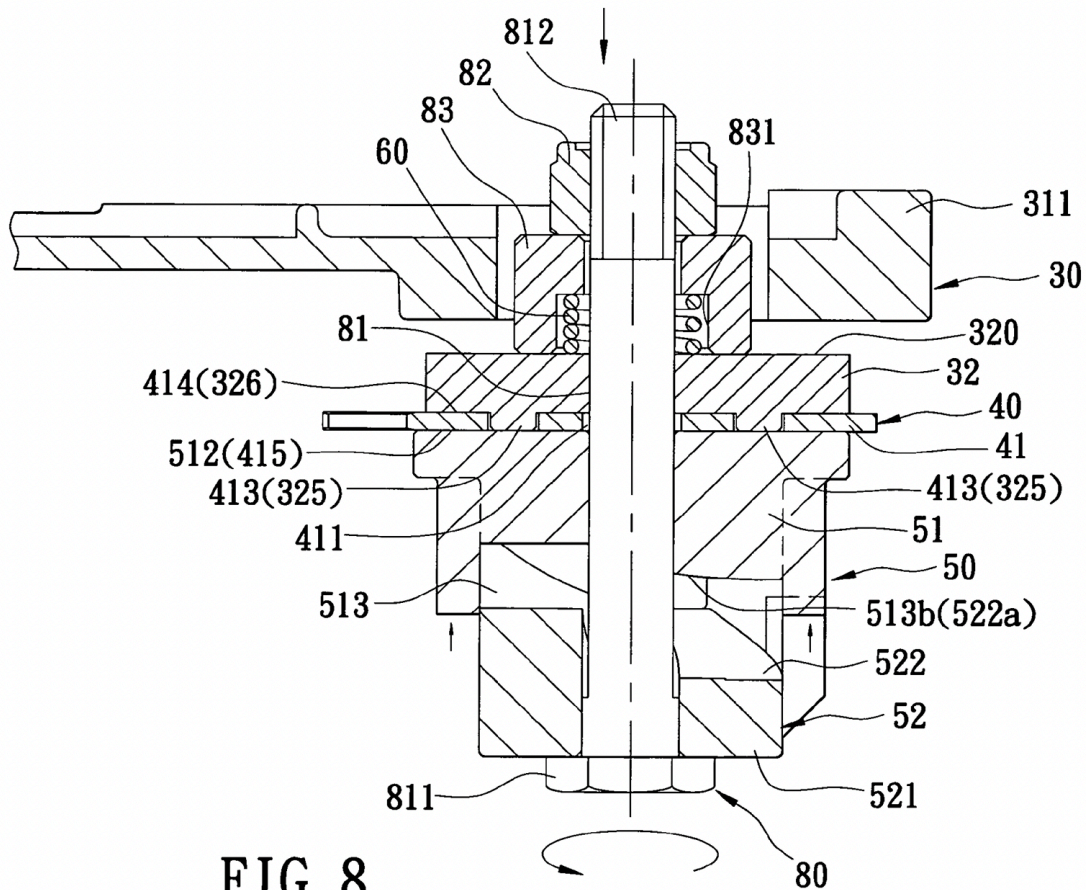


FIG. 8

Id. at 5:52-59.

B. LEVEL OF ORDINARY SKILL IN THE ART

A POSITA in the relevant field, as of the date of alleged invention of the '622 patent, would have earned at least an undergraduate degree in mechanical engineering, physics, or a similar field, or at least one year of experience working with cam devices or other components of power tools.

C. CLAIM CONSTRUCTION

Patent Owner agrees that the terms do not require construction for purposes of evaluating the Petition.

D. GROUND 1 – THE COMBINATION OF GASS AND AAPA DOES NOT RENDER OBVIOUS ANY OF CLAIMS 1, 3, 5, AND 9

The combination of Gass and AAPA (the “Ground 1 References”) does not render obvious any of claims 1, 2, 5, and 9.

1. Independent Claim 1

The Ground 1 References do not render obvious claim 1, at least because they do not teach or suggest limitation [1.13]. Specifically, the Ground 1 References, taken alone or in combination, do not teach or suggest a biasing member that, “as a result of displacement of said actuating body to the tightening position . . . acquires an increment of a biasing force which biases said front end of said shank *towards said supporting frame*,” as recited in limitation [1.13].

- i. [1.13] “as a result of displacement of said actuating body to the tightening position, said biasing member acquires an increment of a biasing force which biases said front end of said shank towards said supporting frame so as to counteract the axial frictional force to thereby keep said actuating body in the tightening position.”

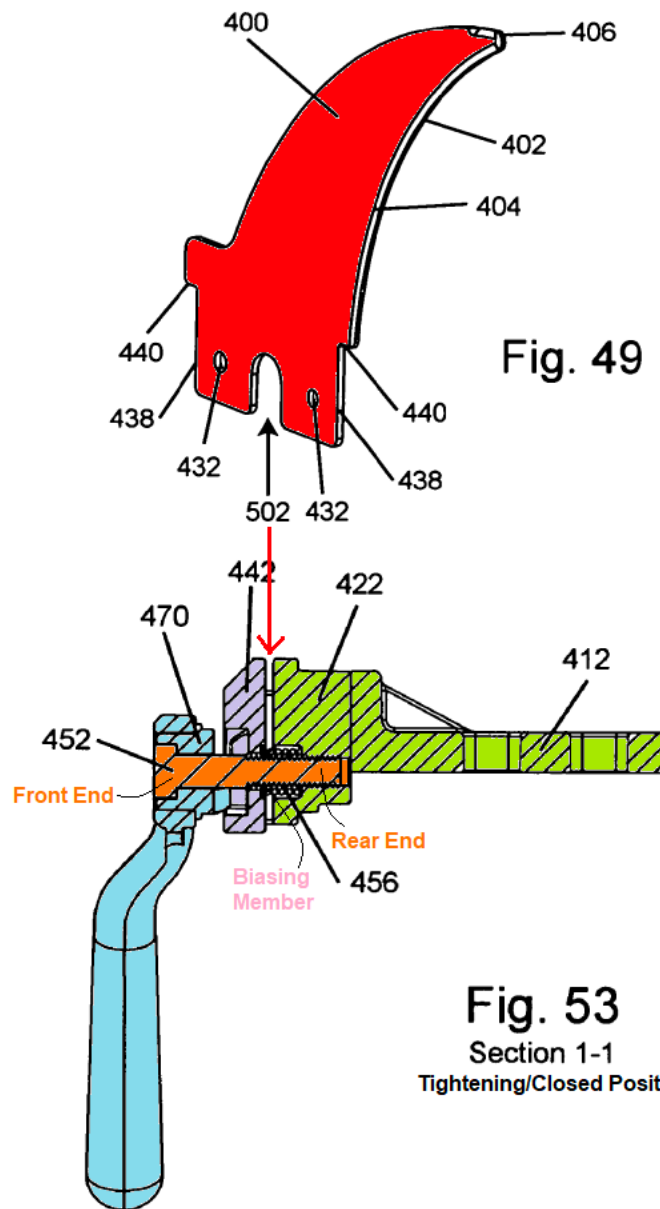
Claim [1.13] recites, among other things, a spring “which biases said front end of said shank *towards said supporting frame* so as to counteract the axial frictional force to thereby keep said actuating body in the tightening position.”

(emphasis added). The Petition relies solely on Gass for this limitation, and argues that Gass discloses that:

. . . as a result of displacement of the actuating body 470 (blue below) to the tightening (closed) position, the biasing member 456 acquires an increment of a biasing force which biases the front end (annotated in orange below) of the shank 452 (orange) towards the supporting frame 400 (red) to keep the actuating body in the tightening (closed) position.

Petition, p. 36. But Gass discloses no such thing. In fact, Gass teaches a system that is arranged to achieve the opposite bias, i.e., the biasing member of Gass biases the front end of the shank *away from* said supporting frame.

The relevant components of Gass are shown in the Petition's annotated version of FIG. 53 of Gass (the relevant components have been color coded by Petitioners):



Petition, p. 37. The specification of Gass discloses that “[s]pring biases **clamping plate 442 away from positioning plate 422** to help open the clamp. . . . In this manner, the spring biases the clamping plate out so that the mounting system opens when handle 490 [blue] is raised.” Petition, at pp. 36-37 (citing Ex. 1003, 20:60-61; 22:18-23) (coloring and bracketed notes added here).

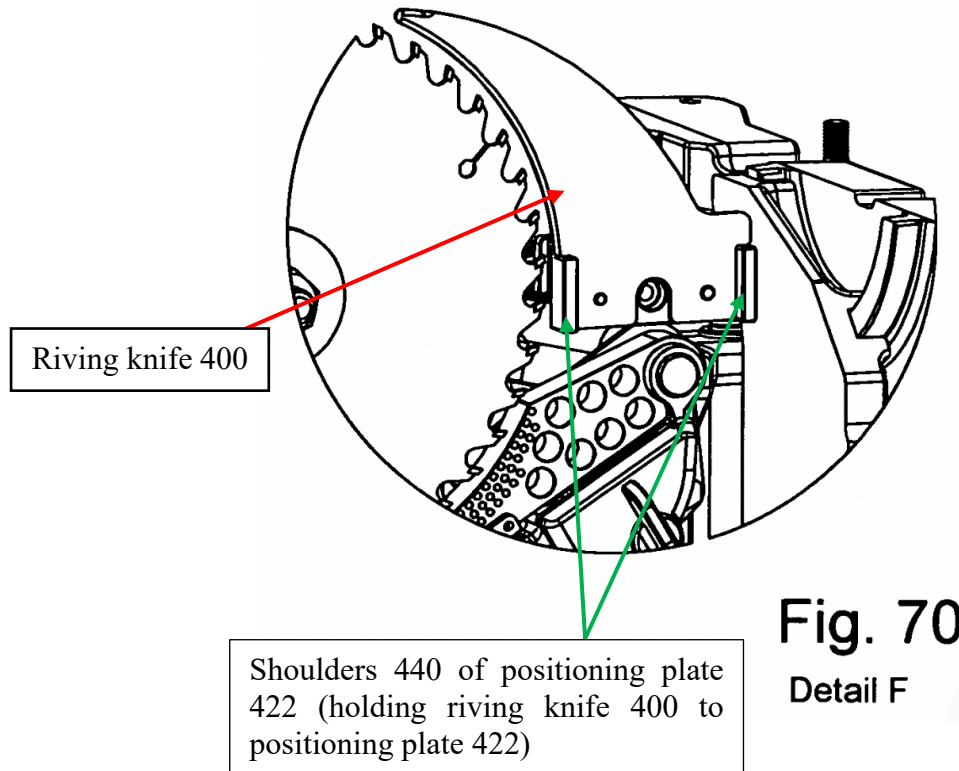
The Petition itself provides no explanation of how these passages of Gass disclose any biasing force whatsoever on the front end of bolt 452, much less a biasing force that biases the front end of bolt 452 *towards* riving knife 400, which the Petition refers to as the claimed supporting frame. *See, generally*, Petition, pp. 36-38. Indeed, the Petition mentions bolt 452 of Gass only once—in a sentence that merely parrots the language of limitation [1.13] with no further explanation or analysis. *See* Petition, p. 36. The Petition should be denied for this reason alone.

It is Petitioners' burden to "specify where each element of the claim is found in the prior art patents or printed publications relied upon." 37 C.F.R. § 42.104(b)(4)–(5) (2012); *see also* *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) ("It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify 'with particularity' the 'evidence that supports the grounds for the challenge to each claim.'" (quoting 35 U.S.C. § 312(a)(3) (2012))). Petitioners have not met that burden here, and the Petition should be denied for that reason alone. The task of fleshing out Petitioners' potential arguments should not be left to Patent Owner or the PTAB.

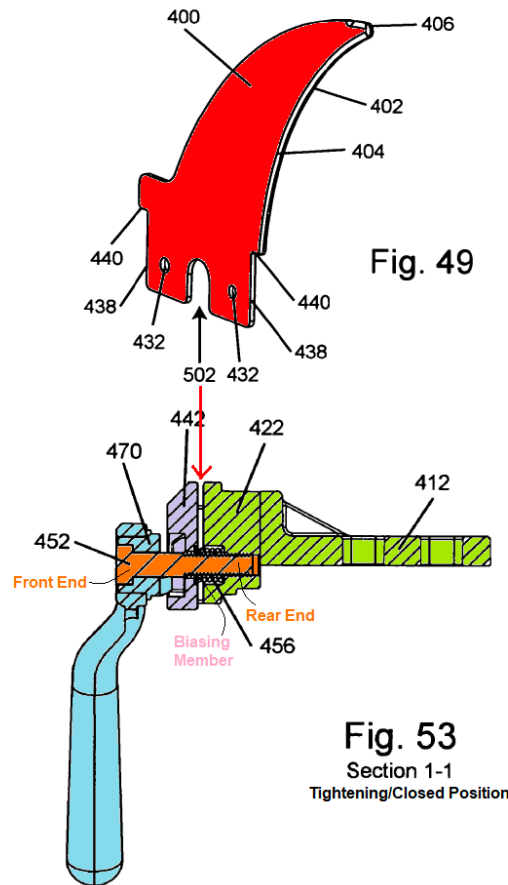
That said, Patent Owner notes that FIG. 53 of Gass appears to show that clamping plate 442 is slidably engaged on bolt 452 and that clamping plate 442 contacts cam bushing 470. Cam bushing 470, in turn, could potentially be

interpreted as engaging the front end of bolt 452. Ex. 1003, FIG. 53. Petitioners therefore may potentially have argued that, because Gass discloses that the spring 456 biases clamping plate 442 away from positioning plate 422 (EX. 1003, 20:60-61) and FIG. 53 of Gass appears to show that clamping plate 442 pushes on cam bushing 470, which in turn pushes on the front end of bolt 452, Gass could be read to suggest that a biasing force is applied to the front end of bolt 452. Again, the specification of Gass does not discuss any bias applied to the bolt 452, Petitioners do not agree that FIG. 53 alone sufficiently discloses such a bias, and the Petition did not make this argument.

But, even if FIG. 53 of Gass could be interpreted to suggest that the front end of bolt 452 experiences a biasing force from spring 456, any such biasing force would necessarily bias the front end of bolt 452 *away from* riving knife 400. Gass discloses that riving knife 400 is positioned on the positioning plate 422, with “[h]oles 432 in the riving knife fitting around pins 430 on the positioning plate and shoulders 440 on the riving knife resting on shoulders 436 of the positioning plate.” Ex. 1003, 22:24-28. This is shown in FIG. 70 of Gass:



Ex. 1003, FIG. 70 (annotations added). “The base of the riving knife 400 includes a cut-out 502 to provide clearance for bolt 452 and spring 456”:



Id., 22:24-28; FIGS. 49 and 53 (as annotated in Petition). Therefore, Gass discloses that riving knife 400 is attached to positioning plate 422. As discussed above Gass discloses that “[s]pring 456 biases **clamping plate 442 away from positioning plate 422** to help open the clamp.” Ex. 1003, 20:60-61; FIG. 53. Thus, even if Petitioners had argued that spring 456 applied a biasing force on the front end of bolt 452 through clamping plate 442 and cam bushing 470, any such biasing force would bias the front end of bolt 452 **away from** riving knife 400. This is because the riving knife 400 is attached to the positioning plate 422 such that biasing the clamping plate 442 away from positioning plate 422 would also bias the front end of bolt 452 away

from the riving knife. This is the exact opposite of limitation [1.13], which recites a spring that “biases said front end of said shank *towards said supporting frame.*” Thus, even if Petitioners had met their burden to explain how Gass discloses a biasing force on bolt 452, and they have not, Gass does not teach or suggest limitation [1.13].

The declaration of Mr. Main adds little, if anything, to the Petition’s barebones analysis. In relevant part, Mr. Bain repeats the exact passage that appears in the Petition without providing any analysis or explanation to support his alleged conclusion that “the biasing member 456 acquires an increment of a biasing force which biases the front end (annotated in orange below) of the shank 452 (orange) towards the supporting frame 400 (red).” *Compare* Ex. 1004, ¶ 235 *with* Petition, pp. 36-37. For at least that reason, Mr. Bain’s testimony should be rejected. 37 C.F.R. § 42.65(a), “[e]xpert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight;” *see also* *Skky, Inc. v. MindGeek s.a.r.l.*, 859 F.3d 1014, 1022 (Fed. Cir. 2017) (affirming the Board’s rejection of conclusory expert testimony in holding that “the Board is not required to credit [Petitioners’] expert evidence simply because [Petitioners] offered it.”). The other paragraphs of Mr. Bain’s declaration opine only that a POSITA, which Mr. Bain declares himself to be, would “struggle to understand limitation [1.13],” and that the spring creates an axial force. Ex. 1004, ¶¶ 232-234.

For at least these reasons, Gass does not teach or suggest limitation [1.13].

AAPA does not remedy the deficiencies of Gass with respect to claim element [1.13], and the Petition does not so assert. Thus, the Ground 1 References, whether taken alone or in combination, do not teach or suggest claim element [1.13].

2. Dependent Claims 2, 5, and 9

Claims 2, 5, and 9 depend from and add limitations to claim 1. As noted above, the Ground 1 References, alone or in combination, do not teach or suggest the limitations of claim 1, and therefore do not render obvious claims 2, 5, and 9. AAPA does not cure the deficiencies of Gass with respect to claim 1, and the Petition does not so assert. For at least that reason, the Ground 1 References do not render obvious claims 2, 5, and 9. Claims 2, 5, and 9 are, therefore, patentable for at least the same reasons as Claim 1.

E. GROUND 2 – THE COMBINATION OF BURKE AND GASS DOES NOT RENDER OBVIOUS ANY OF CLAIMS 1, 3, 5, AND 9

The combination of Burke and Gass (the “Ground 2 References”) does not render obvious any of claims 1, 2, 5, and 9.

1. Independent Claim 1

The Ground 2 References do not render obvious claim 1, at least because they do not teach or suggest limitation [1.13] of claim 1.

- i. **[1.13] “as a result of displacement of said actuating body to the tightening position, said biasing member acquires an increment of a biasing force which biases said front end of said shank towards said supporting frame so as to counteract the axial frictional force to thereby keep said actuating body in the tightening position.”**

For at least the reasons detailed above in Section III(D)(1)(i), Gass does not disclose or suggest claim element [1.13]. Burke does not remedy the deficiencies of Gass with respect to claim element [1.13], and the Petition does not so assert. For at least that reason, the Ground 2 References, taken alone or in combination, do not teach or suggest claim element [1.13].

2. Dependent Claims 2, 5, and 9

Claims 2, 5, and 9 depend from and add limitations to claim 1. As noted above, the Ground 2 References, alone or in combination, do not teach or suggest the limitations of claim 1, and therefore do not render obvious claims 2, 5, and 9. Gass does not cure the deficiencies of Burke with respect to claim 1, and the Petition does not so assert. For at least that reason, the Ground 2 References do not render obvious claims 2, 5, and 9. Claims 2, 5, and 9 are, therefore, patentable for at least the same reasons as Claim 1.

F. GROUND 3 – THE COMBINATION OF AAPA AND GASS DOES NOT RENDER OBVIOUS ANY OF CLAIMS 1, 3, 5, AND 9

The combination of AAPA and Gass (the “Ground 3 References”) does not render obvious any of claims 1, 2, 5, and 9.

1. Independent Claim 1

The Ground 3 References do not render obvious claim 1, at least because they do not teach or suggest limitation [1.13] of claim 1.

- i. **[1.13] “as a result of displacement of said actuating body to the tightening position, said biasing member acquires an increment of a biasing force which biases said front end of said shank towards said supporting frame so as to counteract the axial frictional force to thereby keep said actuating body in the tightening position.”**

For at least the reasons detailed above in Section III(D)(1)(i), Gass does not disclose or suggest claim element [1.13]. AAPA does not remedy the deficiencies of Gass with respect to claim element [1.13], and the Petition does not so assert. For at least that reason, the Ground 3 References, taken alone or in combination, do not teach or suggest claim element [1.13].

2. Dependent Claims 2, 5, and 9

Claims 2, 5, and 9 depend from and add limitations to claim 1. As noted above, the Ground 3 References, alone or in combination, do not teach or suggest the limitations of claim 1, and therefore do not render obvious claims 2, 5, and 9. Gass does not cure the deficiencies of AAPA with respect to claim 1, and the Petition does not so assert. For at least that reason, the Ground 3 References do not render obvious claims 2, 5, and 9. Claims 2, 5, and 9 are, therefore, patentable for at least the same reasons as Claim 1.

**G. GROUND 4 – THE COMBINATION OF GASS AND BURKE DOES NOT
RENDER OBVIOUS ANY OF CLAIMS 1, 3, 5, AND 9**

The combination of Gass and Burke (the “Ground 4 References”) does not render obvious any of claims 1, 2, 5, and 9.

1. Independent Claim 1

The Ground 4 References do not render obvious claim 1, at least because they do not teach or suggest limitation [1.13] of claim 1.

- i. **[1.13] “as a result of displacement of said actuating body to the tightening position, said biasing member acquires an increment of a biasing force which biases said front end of said shank towards said supporting frame so as to counteract the axial frictional force to thereby keep said actuating body in the tightening position.”**

For at least the reasons detailed above in Section III(D)(1)(i), Gass does not disclose or suggest claim element [1.13]. Burke does not remedy the deficiencies of Gass with respect to claim element [1.13], and the Petition does not so assert. For at least that reason, the Ground 4 References, taken alone or in combination, do not teach or suggest claim element [1.13].

2. Dependent Claims 2, 5, and 9

Claims 2, 5, and 9 depend from and add limitations to claim 1. As noted above, the Ground 4 References, alone or in combination, do not teach or suggest the limitations of claim 1, and therefore do not render obvious claims 2, 5, and 9.

Gass does not cure the deficiencies of Burke with respect to claim 1, and the Petition does not so assert. For at least that reason, the Ground 4 References do not render obvious claims 2, 5, and 9. Claims 2, 5, and 9 are, therefore, patentable for at least the same reasons as Claim 1.

H. GROUND 5 – THE COMBINATION OF GASS AND GARCIA DOES NOT RENDER OBVIOUS ANY OF CLAIMS 1, 3, 5, AND 9

The combination of Gass and Garcia (the “Ground 5 References”) does not render obvious any of claims 1, 2, 5, and 9.

1. Independent Claim 1

The Ground 5 References do not render obvious claim 1, at least because they do not teach or suggest limitation [1.13] of claim 1.

- i. [1.13] “as a result of displacement of said actuating body to the tightening position, said biasing member acquires an increment of a biasing force which biases said front end of said shank towards said supporting frame so as to counteract the axial frictional force to thereby keep said actuating body in the tightening position.”**

For at least the reasons detailed above in Section III(D)(1)(i), Gass does not disclose or suggest claim element [1.13]. Garcia does not remedy the deficiencies of Gass with respect to claim element [1.13], and the Petition does not so assert. For at least that reason, the Ground 5 References, taken alone or in combination, do not teach or suggest claim element [1.13].

2. Dependent Claims 2, 5, and 9

Claims 2, 5, and 9 depend from and add limitations to claim 1. As noted above, the Ground 5 References, alone or in combination, do not teach or suggest the limitations of claim 1, and therefore do not render obvious claims 2, 5, and 9. Garcia does not cure the deficiencies of Gass with respect to claim 1, and the Petition does not so assert. For at least that reason, the Ground 5 References do not render obvious claims 2, 5, and 9. Claims 2, 5, and 9 are, therefore, patentable for at least the same reasons as Claim 1.

V. THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 314(a)

The Board should exercise its discretion to deny the Petition pursuant to 35 U.S.C. § 314(a) because each of the six *Fintiv* factors favors denial.² Petitioners Home Depot and Lowe’s are separately challenging the exact same claims in two separate parallel district court litigations³ asserting, among other references, the *exact combinations of references and invalidity grounds* presented by this Petition. The *Home Depot* and *Lowe’s* Litigations are pending separately before the same

² See *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 2020 Pat. App. LEXIS 13179, 2020 WL 2126495 (PTAB. Mar. 20, 2020) (setting out and applying the six factors; designated precedential on May 5, 2020) (“*Fintiv*”)

³ in *P & F Brother Industrial Corporation v. The Home Depot, Inc. and Home Depot U.S.A., Inc.*, E.D. Tex. No. 2:23-CV-00312-JRG (filed June 28, 2023; the “*Home Depot* Litigation”) and *P & F Brother Industrial Corporation v. Lowes Companies, Inc., Lowe’s Home Centers, LLC*, E.D. Tex. No. 2:23-CV-00313-JRG (filed June 28, 2023; the “*Lowes* Litigation”).

court, and that court is highly unlikely to stay the litigation under the current case posture. In an effort to move things along quickly and efficiently, the court has already coordinated schedules in both cases. Ex. 2007. Moreover, despite filing this Petition on February 6, 2024, neither defendant has filed a Motion to Stay pending a decision on this Petition.

The *Home Depot* Litigation will be tried to a jury two months before any FWD would issue here, and the *Lowe's* Litigation will be tried a month and a half before a FWD. In the *Home Depot* Litigation, by the time a FWD decision would be issued here, the court will have already determined the meaning of the claims, fact and expert discovery will have been completed for five and a half months, and the parties' dispositive motions filed five months previously. Ex. 2002. The same is true for the *Lowe's* Litigation, except for a slight difference of approximately two weeks for those deadlines. Ex. 2005. Institution of *inter partes* review would only ensure duplicitous parallel litigation before the PTAB and in two separate parallel district court litigations and cause all parties to expend vast resources unnecessarily.

The Petition also fails on the merits because the cited references do not disclose or suggest key limitations of the challenged claims.

A. *FINTIV* FACTOR #1 (LIKELIHOOD OF STAY)

This factor does not favor institution. The Petitioners have not filed for a stay pending the Board's decision on the Petition. Any subsequent request for a stay is

highly unlikely to be granted. It has been three months since the filing of this Petition, and a Motion for Stay Pending a Decision on this Petition has not been filed in either litigation.

A stay is also especially unlikely where, as here, both the *Home Depot* Litigation and the *Lowe's* Litigation will be concluded by the time of any FWD issues—on or around June 6, 2025. The *Home Depot* Litigation is set for trial on April 7, 2025, and the *Lowe's* Litigation is set for trial on April 21, 2025. Ex. 2002 and 2005. Opening dispositive motions are due in the *Home Depot* Litigation on December 30, 2024, and in the *Lowe's* Litigation on January 13, 2025. The court presiding over the *Home Depot* and *Lowe's* Litigations routinely denies motions to stay under such circumstances. *See, e.g., Solas OLED Ltd. v. Samsung Display Co.*, No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973, *7 (E.D. Tex. 2020) (denying motion to stay in part because, where fact discovery and expert discovery had closed, “due to the extremely advanced stage of this case, the Court finds that this factor weighs against granting a stay.”).

This factor weighs in favor of discretionary denial because instituting *inter partes* review will only serve to guarantee that all parties incur increased costs from litigating parallel IPR and district court litigation proceedings.

B. *FINTIV* FACTORS #2 AND #3 (TRIAL DATE PROXIMITY TO FWD AND INVESTMENT IN PARALLEL PROCEEDINGS)

As detailed above in Section V(A), the schedule for the Petition is far behind the schedules for both the *Home Depot* Litigation and the *Lowe's* Litigation. Any FWD stemming from the Petition would be unlikely to issue before April 2025, the month that both litigations are set to go to trial (*see* 35 U.S.C. § 314(b)(1); 37 C.F.R. § 42.100(c)); Ex. 2002, 2005.

C. *FINTIV* FACTOR #4 (ISSUE OVERLAP)

The Petition's exact challenges to the '622 patent are being advanced in both the *Home Depot* litigation and the *Lowe's* Litigation. All three primary references asserted in the Petition, *i.e.*, Gass, Burke and AAPA, are asserted in obviousness combinations in the invalidity contentions served in the *Home Depot* Litigation (served November 9, 2023; *see* Exhibit 2003) and the *Lowe's* Litigation (served November 9, 2023; *see* Exhibit 2006), and those references are also asserted in the same combinations with the same secondary references asserted in the Petition against the same claims. *See* Petition, at §§ VI – VII. The Petition admits that the prior art cited in the Petition is also being used in the litigations. Petition, at § VIII (B)(4). Put simply, every claim challenged in the Petition is also being challenged in not one, but two, district court litigations in view of the exact same references and combinations of references presented in the Petition.

Fintiv Factor #4 weighs heavily in favor of denial.

D. *FINTIV* FACTOR # 5 (IDENTITY OF PARTIES)

Real parties-in-interest Home Depot and Lowe's are parties in co-pending litigations in which they are challenging the validity of the '622 patent.⁴ Petitioner Delta supplies the products accused of infringement in the litigations.⁵ The interests of Delta, Home Depot, and Lowe's are also fully aligned, and they are functionally the same parties for the purposes of this Petition.

This factor weighs heavily in favor of denial.

E. *FINTIV* FACTOR #6 (MERITS AND OTHER CIRCUMSTANCES)

As detailed above, the Petition does not disclose or suggest a key limitation of each of the challenged claims, as the sole anticipatory reference asserted against each independent claim and numerous obvious combinations do not disclose limitation [1.13] recited by each of those claims. The Petition therefore does not establish a reasonable likelihood that Petitioners would prevail with respect to at least one of the claims challenged in the Petition. The Board should exercise its discretionary power to deny the Petition.

VI. CONCLUSION

Patent Owner requests that the Board deny institution of the Petition.

⁴ *The Home Depot* Litigation and *Lowe's* Litigation. *See also*, Petition, at § XIII.B; Patent Owner's Mandatory Notices at ¶ 2.

⁵ *See* Accused Products, Ex. 2001, at pp. 3-4; *See* Accused Products, Ex. 2004, at pp. 3-45

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I hereby certify that the foregoing Patent Owner's Preliminary Response contains 5245 words as measured by the word processing software used to prepare the document, excluding the cover page, signature block, and portions exempted under 37 C.F.R. § 42.24(a) or (b).

DATED: May 14, 2024

Respectfully submitted,

By: /C. Matthew Rozier/
C. Matthew Rozier
Registration No. 63,429
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that May 14, 2024, the foregoing document was served on counsel of record for Petitioners by filing this document through the End-to-End System, as well as *via* electronic mail to counsel of record for Petitioners at the following address:

Timothy D. St.Clair	timstclair@parkerpoe.com
Tasneem A. Dharamsi	tasneemdharamsi@parkerpoe.com
Amy E. Allen Hinson	amyhinson@parkerpoe.com
Alison L. Lamb	alisonlamb@parkerpoe.com

DATED: May 14, 2024

Respectfully submitted,

By: /C. Matthew Rozier/
C. Matthew Rozier
Registration No. 63,429
Counsel for Patent Owner