

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KOHLER CO.,
Petitioner,

v.

DELTA FAUCET CO.,
Patent Owner.

Case No. IPR2024-00700
U.S. Patent No. 10,393,363

**Patent Owner's
Authorized Response to Director Review Request**

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I. INTRODUCTION

Director Review is not a vehicle for relitigating the record. All of the evidence Petitioner raises in its Request for Director Review (Paper 33, “Request”) was already before the Board, raised by the Petitioner, and considered by the Board. At the hearing, the Board asked the parties questions specific to the issues raised in the Request. In the Final Written Decision (Paper 32, “FWD”), the Board explained multiple times why it credited Patent Owner over Petitioner in reaching its conclusions regarding claims 10 and 19—because Petitioner presented nothing but attorney arguments.

The record is clear that the Board already considered whether some photons reaching the surface in the asserted reference Tseng (setting aside that Tseng never makes such a disclosure) teach the claimed outer illumination surface in claim 10. The Board also considered whether the asserted reference Tse’s “semi-transparent” cover, in view of the rest of Tse’s disclosure, teaches the claimed light pipe. The Board concluded that the record supports neither.

The Board did not abuse its discretion. It grounded its findings in the disclosures of the asserted references and the analyses offered by both parties’ experts. The Board credited Patent Owner’s expert, Dr. Klopp, for providing an independent analysis based on his extensive experience in optics. The Board

discounted Petitioner's expert, Mr. Cook, because his declaration merely parroted the Petition in places where the Board expected independent analysis, compounded by Mr. Cook's lack of experience in optics. The Board correctly understood that the disputed issues "directly relate[] to optical systems and methods." With the lack of independent analysis and corroborating evidence, the Board correctly concluded that Mr. Cook's declaration and the positions stated therein were "conclusory."

II. STANDARD OF REVIEW

A Request for Director Review of a Board's Final Written Decision is limited to decisions presenting an abuse of discretion, important issues of law or policy, erroneous findings of material fact, or erroneous conclusions of law. Director Review Process § II.B.¹ The Board's decision is an abuse of discretion only if it "(1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision." *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016). The Director does not need to review every decision of the PTAB.

¹ See <https://www.uspto.gov/patents/ptab/decisions/director-review-process>.

United States v. Arthrex, Inc., 594 U.S. 1, 27 (2021). In this case, Petitioner presents no issue requiring Director Review.

III. ARGUMENT

A. The Board Considered Petitioner’s Arguments And Confirmed Patentability of Claim 10

The Board correctly confirmed that claim 10 is patentable because Tseng does not teach at least an *outer illumination surface extending perpendicular to the longitudinal axis of the housing*, as recited in claim 10. FWD, 33. Instead, Tseng teaches an illumination surface only at the ***bottom*** of the housing. The Board also concluded that Petitioner failed to meet its burden to show that the side surface of Tseng’s annular protrusion 383 is the claimed outer illumination surface because Petitioner relied solely on attorney arguments repeated verbatim by its expert, Mr. Cook. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (PTAB Aug. 24, 2022) (expert declaration that “merely repeats, verbatim, the conclusory assertion for which it is offered to support” without citing “any additional supporting evidence or provide any technical reasoning to support” is entitled to little weight). The Board emphasized repeatedly that Mr. Cook’s declaration was conclusory. FWD, 34 (“Petitioner’s assertions [] consist solely of conclusory statements, supported only by citations to Mr. Cook’s declaration. Mr. Cook, however, simply repeats Petitioner’s conclusory statements, without providing sound technical reasoning

supported by objective evidence to explain and support his opinions”), 35 (“Petitioner again provides nothing more than conclusory statements in the Reply ... and Petitioner again cites the same conclusory opinions in the Cook declaration”), 38 (“Mr. Cook[] offered no testimony”), 39 (“Neither Petitioner nor Mr. Cook provides any explanation, beyond their conclusory assertions”).

Petitioner now argues that the Board abused its discretion regarding claim 10. Petitioner argues that the Board’s decision (1) ignores Patent Owner’s expert Dr. Klopp’s statements (Request, 5-7); (2) is inconsistent between claims 1 and 10 (Request, 7-9); (3) negates Tseng’s disclosures (Request, 10-13); and (4) effectively renders claim 10 meaningless (Request 13). Petitioner is incorrect. The analysis of the Board is well considered and amply supported by the record. None of Petitioner’s complaints identifies any reason to disturb the Board’s reasoned decision, let alone amounts to an abuse of discretion or a material factual error.

First, the Board did not ignore Dr. Klopp’s statements as the Petitioner alleges. The Board cited the evidence it found to be more credible, yet that does not mean the Board did not consider Petitioner’s less-credible evidence. *Novartis AG v. Torrent Pharms. Ltd.*, 853 F.3d 1316, 1328 (Fed. Cir. 2017) (“given that the Board cited to the relevant pages of Novartis’ Patent Owner Response, we find no reason to assume the Board failed to consider [negative evidence] simply because they were

not recited at length in the Board’s Final Written Decision”). Even the Request acknowledges that the Board considered Dr. Klopp’s statements that Petitioner incorrectly characterizes as admissions. *See* Request, 5-6 (citing Petitioner’s Reply (Paper 22, 7), Petitioner’s hearing demonstratives (Ex. 1016, 18) and oral argument (Paper 29, 17:8-20, 41:13-23)).

As an initial matter, Petitioner takes Dr. Klopp’s statements (e.g., Ex. 1015, 37:14-15 (“no one could say that no photons at all would reach 383”)) out of context. Moreover, the Board considered, and discounted, Petitioner’s arguments that Dr. Klopp’s testimony should be considered an admission. Context matters, and the Board correctly considered context, i.e., that Dr. Klopp immediately followed up stating that “no meaningful light would reach 383, because that would defeat the enhanced illumination part” (Ex. 1015, 37:22-38:2). The record is clear, and the Board cited this follow-up statement along with Dr. Klopp’s analysis that Tseng’s annular protrusion 383 is for enlarging the bottom surface and not for illuminating the side surface. FWD, 33 (citing Ex. 1015, 37:22-38:2 and Ex. 2003 ¶ 101).

In contrast, and as the Board correctly noted, Mr. Cook had no analysis on this issue other than conclusory statements parroting attorney arguments. Petitioner did not even submit a reply declaration from Mr. Cook to rebut Dr. Klopp’s analysis

and testimony. Simply put, Petitioner has offered nothing to counter the Board's conclusion that the Patent Owner's expert was more credible on the disputed issue.

Petitioner alleges that the Board "overlook[ed] admissions from Patent Owner's expert." Request, 7. Not so. The Board demonstrated full awareness of the issue. At the hearing, the Board asked, "didn't [Dr. Klopp] also testify that at least some of the light will deflect reflect outwardly through that perpendicular surface?" and concluded that there is not enough light for the side surface of annular protrusion 383 in Tseng to be considered an outer illumination surface because "there's no angled surface or any other structure to reflect it outwardly [in Tseng]." Paper 29, 41:13-25.

Second, the Board's conclusions regarding claims 1 and 10 are not inconsistent as alleged by Petitioner. The Board addressed separate issues. The issue for claim 1 was whether a POSITA would consider the light conductors of Tseng's second and third embodiments to be made of the same translucent material as the light conductor of Tseng's first embodiment, despite the absence of such a disclosure in Tseng. The issue for claim 10 was whether, regardless of the material, Tseng teaches the claimed outer illumination surface.

As explained above, the Board agreed with the Patent Owner on claim 10 because there was nothing in the record from Petitioner other than conclusory

assertions to rebut Tseng’s clear disclosure of an “output face” only at the bottom of the housing. FWD, 35 (“Petitioner again provides nothing more than conclusory statements in the Reply to support its position that a POSITA would understand that light would be emitted from the side of protrusion 383 of Tseng’s light conductor 38”). The Board, of course, asked Petitioner about this issue. Paper 29, 13:7-10 (“So, they’re taking the position that Mr. Cook, who I take it is Petitioner’s expert, agreed that the light enters downward through input face 311 so that it’s a downward directional light emission, not a perpendicular or sideways transmission. What’s your response to that?”). Petitioner attempted to deflect by stating that there is no rebutting analysis from Mr. Cook because he was not asked about it, (Paper 29, 13:11-14:3), but the burden is on Petitioner. FWD, 40; 35 U.S.C. § 316(e); *In re Magnum Oil Tools Int’l Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016) (quoting *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015)).

Third, the Board’s decision does not contradict Tseng or other references. The Request attempts to relitigate issues the Board has already fully considered and rejected. Petitioner asserts that “Tseng would not have used the language it did—‘outwardly’ and ‘exposes outside’—if it intended light to only be emitted downward” (Request, 10) and “[t]here would be no reason to include outwardly

extending protrusion 383 if light is only to be emitted downward as Patent Owner argues” (Paper 29, 12:23-25). Again, the Board considered this exact argument. *See* FWD, 35-36 (“Petitioner argues that there would be no reason for annular protrusion 383 to extend outwardly if it were not intended to transmit light radially outwardly.”). Mr. Cook—setting aside his lack of experience in optics, as noted by the Board—“merely repeat[ed] Petitioner’s statements, without further explanation or elaboration.” FWD, 33. Therefore, the only credible evidence on the record was Dr. Klopp’s analysis that a POSITA would have understood the purpose of the annular protrusion was to enlarge the bottom output face. FWD, 33.

Next, Petitioner’s additional attempt to backfill its Petition with the non-asserted ’874 patent (Request, 11-12) was also considered and correctly rejected by the Board at the hearing. Paper 29, 58:17-61:7 (the Board asking why Petitioner is referring to the non-asserted ’874 patent and acknowledging that Petitioner is invoking the credibility of Dr. Klopp’s statements using the ’874 patent). But the Board concluded that Dr. Klopp’s statements about the ’874 patent did not undermine his credibility. FWD, 38-39 (“Dr. Klopp’s deposition testimony directed to [the ’874 patent’s] light guide outflow pipe 50 does not contradict these statements in paragraph 120 of Dr. Klopp’s declaration. Petitioner, therefore, does not show that Dr. Klopp’s testimony directed to [the ’874 patent’s] light guide outflow pipe

50 undermines Dr. Klopp’s credibility. Ex. 1015, 47:3-57:6”). And there is simply no analysis regarding the ’874 patent *from Petitioner’s expert*, who admitted he had never seen it before his deposition. FWD, 38; Paper 17 (Patent Owner’s Response (“POR”)), 48; Ex. 2005, 30:5-18 (“No, I have not reviewed [the ’874 patent] before now”).

Fourth, the Board’s decision does not render claim 10 meaningless. The Board carefully noted the differences in claim scope between claims 1 and 10. *See* FWD, 31 (emphasizing limitations). Claim 10 requires an outer illumination surface extending perpendicular to the longitudinal axis. Tseng does not teach such a surface. As the Board noted, Petitioner did not propose a construction of this limitation nor offered a persuasive explanation by Mr. Cook as to why Tseng would teach this limitation, especially in light of Tseng’s express disclosure and Mr. Cook’s own admissions that only the bottom surface is described as the output face. FWD, 39; *see also* Paper 17 (POR), 30-31; Paper 26 (Patent Owner’s Sur-reply), 3-4; Ex. 2005, 81:22-82:5 (“Q: Other than the bottom surface of Figure 35, no other surfaces are marked as output face 313, correct? A: That is correct, from what I see in Figures 35 and 36.”).

B. The Board Considered Petitioner’s Arguments And Confirmed Patentability of Claim 19

The Board correctly confirmed that claim 19 is patentable because Tse does not teach at least a *translucent light pipe*, as recited in claim 19. FWD, 57. Tse teaches a cover through which the light emitted by the light emitting means can be seen. Again, the Board concluded that Petitioner failed to meet its burden because its expert failed to provide any analysis. FWD, 57-58 (“Mr. Cook repeats Petitioner’s statements, without elaborating”), 59 (“Petitioner’s position that Tse’s semi-transparent cover (Ex. 1005, 6:23-29) is translucent consists solely of a conclusory assertion to that effect, supported only by Mr. Cook’s declaration. Pet. 58-59. Mr. Cook, however, simply repeats the Petition’s conclusory statements, without providing sound technical reasoning supported by objective evidence to explain and support his opinions. Ex. 2003 ¶¶ 355-356.”).

In its Request, Petitioner amplifies Patent Owner’s statement at the hearing to suggest it was dispositive of whether Tse renders the claim obvious. Specifically, at the hearing, the Board asked whether “there is no dispute that Tse’s disclosure of a semi-transparent material includes the translucent light pipe claim limitation.” Paper 29, 55:19-22. Patent Owner answered that it did not focus on that issue because it “was not necessary because Tse has plenty of other deficiencies [Patent Owner] did point out.” Paper 29, 55:23-56:2. The Board asked once more to confirm, and Patent

Owner answered, “it’s not in dispute that Tse describes a *semi-transparent material*.” Paper 29, 56:3-6. Yet the Board considered the discussion at the hearing and addressed it in its Decision. FWD, 58. Ultimately, however, the Board found that “Petitioner does not direct us to evidence sufficient to establish that Tse discloses or would have suggested such *a light pipe*.” FWD, 57. That is because, as Patent Owner briefed throughout the proceeding, Tse’s semi-transparent *cover* is “too thin to avoid hot spots and effectively *diffuse light* from the emitters.” See POR, 63 (citing Ex. 1005, 6:27-29, Fig. 4; Ex. 2003, ¶¶ 146-148). Petitioner appears to acknowledge that the Board’s decision was not only based on whether “semi-transparent” means translucent—it was also based on whether Tse’s cover, regardless of the material, was “thick enough to constitute the claimed ‘light pipe.’” Request, 15. The Board *did* answer this question. FWD, 58-59 (“Patent Owner contends in the Response that a ‘POSITA would have understood that Tse’s thin, transparent/semi-transparent cover is unlike a light pipe and instead is more like a window[.]’ ... Dr. Klopp states in the cited paragraphs that ‘Tse teaches away from using translucency for its cover—it instead encourages the light emitting means to be visible by making the cover of the groove . . of transparent or semi-transparent material so that the light emitted by the light emitting means can be seen.’”). The

Board rightly concluded, based on the record evidence, “Petitioner does not establish that Tse discloses or would have suggested a translucent light pipe.” FWD, 60.

IV. CONCLUSION

Director Review is not for Petitioner to merely relitigate the record. Petitioner mischaracterizes testimony taken out of context—testimony that was adequately considered and dismissed by the Board—but cannot escape the fact that the record is insufficient to support its assertions. For at least the reasons set forth above, the Director should deny Petitioner’s Request.

Dated: November 10, 2025

Respectfully submitted,

By: /David L. Cavanaugh/
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CERTIFICATE OF SERVICE

I hereby certify that, on November 10, 2025, I caused a true and correct copy of:

- Authorized Response to Director Review Request

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