UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KOHLER CO.,

Petitioner,

v.

DELTA FAUCET CO.,

Patent Owner.

Case No. IPR2024-0700

U.S. Patent No. 10,393,363

PETITIONER'S BRIEF ON REMAND FROM DIRECTOR REVIEW

As requested by the Board in its January 28, 2026 Order (Paper 37), Petitioner Kohler Co. submits this brief addressing the Director's recent grant of its request for Director Review ("Director's Order," Paper 35).

The Director vacated the Board's final decision in part, finding the Board's reasons for determining that certain of the '363 patent's claims are patentable over the Tseng and Tse references to be contradicted by the factual record. In particular, the Director determined that: (1) Tseng does in fact teach a sprayhead that emits light from its sides, (2) the Board implicitly misconstrued claim 10, and (3) Patent Owner admitted at oral argument that Tse teaches the use of translucent material. The Director then remanded to the Board to address any remaining issues raised by his Order. *See* Director's Order, 2-4.

Petitioner respectfully submits that the Director's Order necessitates several changes to the Board's final decision. In particular, a finding that independent claim 10 is obvious is now required. The Board premised its original non-obviousness determination on its understanding that no light emits from the sides of Tseng's sprayhead. The Director held that this finding constituted error. Moreover, the Board based its non-obviousness finding regarding dependent claim 12 (and similar claim 3) on the very same erroneous interpretation of Tseng that the Director rejected in connection with claim 10. Thus, logic dictates that these claims must also be found obvious. Next, the Director vacated the Board's principle reason for finding claim 19 non-obvious. Contrary to the Board's final decision, Tse does in fact teach

translucent materials. Finally, Petitioner submits that the Director's findings regarding Tseng and Tse necessitate revisiting and re-evaluating the unpatentability of several additional, underlying dependent claims, including 4-5 (which depend on claim 3), 12-17 (which depend on claim 10), and 20-23 (which depend on claim 19).

I. Tseng Teaches a Sprayhead That Emits Light from Its Sides

Petitioner submits that the Director's finding that Tseng's sprayhead emits light from its sides requires re-evaluation of the Board's findings regarding Grounds 1, 2, and 3 (with the exception of its finding regarding claims 1, 2, and 9, which are not implicated by the Director's Order).

In its final decision ("FWD," Paper 32), the Board found independent claim 1 obvious in view of Tseng. *See id.*, 65. But it determined that another independent claim—claim 10—was not shown to be obvious. *Id.* Claim 1 is directed to a "sprayhead." This "sprayhead" includes an "illumination device" with a "light pipe" that "diffuse[s] light … outwardly away from the housing." '363 patent (Ex. 1001), 7:12-16. Claim 10 is directed to a "pull-down sprayhead." Like the "sprayhead" of claim 1, claim 10's "pull-down sprayhead" also includes an "illumination device" with a "light pipe." *Id.*, 7:54-61. But claim 10 uses slightly different language when discussing the pipe's operation: it must "diffuse light … outwardly to the outer illumination surface." *Id.*, 7:54-61.

Tseng indisputably teaches a sprayhead with an illumination device at its end. During the IPR, the parties presented the Board with two differing explanations

regarding Tseng's operation. Petitioner explained that Tseng's "light pipe" (which Tseng calls a "light conductor") includes not only a bottom output face 313, but also a "circular rib 371" or "annular protrusion 383" "expos[ing] outside" and "extending outwardly" from the bottom of the sprayhead to "enhance light transmission[.]" Petition (Paper 1), 30-31, 34-45 (*citing* Tseng, ¶¶ [0094], [0097]-[0098].) Tseng's "light conductor" is made from "translucent" material. Petition, 29 (*citing* Tseng, ¶ [0070]). The Petition—and Petitioner's expert—explained that both the material employed and the conductor's shape and design causes light to "uniformly diffuse" out of all uncovered, exposed portions of the light conductor including both the bottom and the sides. Petition, 31-32 (citing Ex. 1003, ¶¶ 173- 175).

Patent Owner made four main arguments in response. First, despite the fact that the only light conductor material discussed in Tseng is "translucent" material, Patent Owner argued that Tseng's light conductor would for some reason have been understood by a POSITA to be transparent. Response (Paper 17), 17-24. Second, Patent Owner argued that Tseng does not emit light out the sides of its sprayhead as claim 10 requires (and as also required by similar dependent claims 3 and 12). *Id.*, 25. According to Patent Owner, the light emitted by the sprayhead's LEDs will not scatter, is only transmitted "downward," and thus somehow bypasses Tseng's outwardly extending, sideways facing, and uncovered translucent protrusion 383. *Id.*, 31. When addressing claims 3 and 12, Patent Owner simply referred to this claim 10 argument. *See id.*, 37. It identified no other, separate factual basis for

finding these claims non-obvious. *See id.* Third, Patent Owner argued that Tseng purportedly will not "diffuse light … outwardly" from its housing at all as all of the '363 patent's claims require. *Id.*, 39-42. Instead, only perfectly non-diffused light would be emitted like a directional flashlight. *Id.* Fourth, Patent Owner faulted the Petition for supposedly failing to "articulate" a "motivation to modify Tseng." *Id.*, 43-45.

In its final decision, the Board rejected Patent Owner's first, third, and fourth arguments in their entirety. The Board explained that Patent Owner's arguments regarding Tseng's use of "translucent material" and its disclosure of "outwardly" diffused light were "inconsistent with Tseng's disclosure and the evidence of record." FWD, 19. According to the Board, Tseng not only teaches a "translucent light pipe," but explains that this pipe operates to "diffuse[] and transmit[] light from Tseng's LED elements to the exterior of Tseng's spray head…." *Id.*, 20. The Board also rejected Patent Owner's argument attacking motivation to combine, finding that "Petitioner's showing is not based on … combining the light conductors of Tseng's embodiments. Rather, Petitioner's showing is based on Tseng's disclosures as a whole as they reasonably would have been interpreted." *Id.*, 27. Patent Owner has presented no reason for the Board to arrive at any different conclusion regarding these issues.

The Board, however, determined that claim 10 was not obvious because "Tseng does not disclose or teach that light is emitted through the side surface of

annular protrusion 383." FWD, 34. In support of this finding, the Board recognized that "Petitioner and Patent Owner—and their respective witnesses—offer differing explanations" of the purpose of "annular protrusion 383." *Id.*, 36. But because the Board determined that "Dr. Klopp … has greater experience with the technology at issue[,]" the Board "accorded more weight to Dr. Klopp's opinion" and concluded that no light will exit from the sides of Tseng's sprayhead. *Id.*, 36. The Board arrived at the same conclusion with respect to dependent claim 12 (and similar dependent claims 3). In particular, and once again relying on Dr. Klopp's opinion regarding Tseng's operation, it agreed with Patent Owner's position that the claims are not satisfied because "Tseng does not disclose that light emits from the sides" of Tseng's sprayhead. *Id.*, 41-42.

The Director vacated the Board's findings. The Director held that the Board erred by "implicitly determin[ing] that" claim 10 "requires a 'meaningful' amount of light to be emitted in the required direction." Director's Order, 3. Instead, the Director explained that the claim is "satisfied by *any* amount of light emitted from the side surface" of a sprayhead. *Id.* And the Director recognized that "Dr. Klopp … admitted during cross examination that some light would, in fact be emitted" "in a direction perpendicular to the longitudinal axis of the housing" of Tseng's sprayhead. *Id.*

Again, Petitioner submits that these holdings mandate a finding that Tseng renders claim 10 obvious. The Board already rejected Patent Owner's arguments

regarding Tseng's use of translucent material, its teaching of diffusion and outward light emission, and the supposedly missing motivation to combine. As noted, Patent Owner has presented nothing that would require disturbing these determinations. Thus, the only argument that remains is Patent Owner's contention that Tseng does not emit light out the sides of its sprayhead. But the Director found that (1) ***any*** amount of light emission from the sides is sufficient and (2) Dr. Klopp ***admitted*** that at least some light will emit from Tseng's sides. In view of this, no dispute remains: claim 10 must be obvious.

Moreover, since the Board employed the same type of logic and facts when finding dependent claim 12 (and similar claim 3) non-obvious, the Director's decision also mandates a finding that these dependent claims are unpatentable as obvious. As it did when addressing claim 10, the Board determined that claims 3 and 12 were non-obvious because "Tseng does not disclose that light emits from" its sprayhead's "sides." FWD, 41-42. Patent Owner likewise tied its claim 3 and 12 arguments to its no-light-emission-out-the-sides position expressed in connection with claim 10. *See* Response, 37. Because the Director held that Tseng does in fact disclose the emission of light out the sides of its sprayhead, the Board's claim 12 (and claim 3) finding is now premised on an interpretation of the evidence that the Director rejected and found erroneous. It follows that these claims ***must also*** now be held unpatentable as obvious. Ruling otherwise would produce an illogical, factually unsupported, and internally inconsistent result. There is no longer a factual

basis in the record for the conclusion the Board reached. Put another way, because Tseng emits light out the sides of its sprayhead, it can no longer be the case that claims 3 and 12 are patentable due to Tseng's purported failure to disclose emission of light out of its sprayhead's sides. Failing to treat claims 3 and 12 similarly to claim 10—despite the fact that the Board's decision regarding these claims are premised on the same facts—would improperly allow a set of proven invalid claims to remain in force.

Finally, because the Board's treatment of a number of dependent claims relied on its erroneous decisions regarding claims 3, 10, and 12, these dependent claims must also be revisited and re-evaluated. This includes claims 4-5 (depending on claim 3) and 12-18 (depending on claim 10).

II. The Director Found That Tse Admittedly Teaches "Translucent" Materials

Petitioner submits that the Director's finding that Tse teaches "translucent" material also requires reversal of certain aspects of the Board's decision along with re-evaluation of its overall findings regarding Grounds 4, 5, and 6.

The Board's final decision did address—at least in part—the parties' arguments regarding the Tse reference. *See* FWD, 55-64. Here the Board determined that Tse's "semi-transparent cover" is not "translucent" as the '363 patent's claims require. *Id.*, 57-60. It also held that Carter does not "cure" this supposed disclosure deficiency. *Id.*, 60-64. The Board identified no other reason—

besides the purportedly missing "translucent" material—supporting its finding the Tse (or the combination of Tse and Carter) does not render the claims obvious.

The Director, however, determined that "Patent Owner's counsel admitted at the hearing" that Tse teaches the use of translucent material. Director's Order, 4. Given this finding, the Board must revisit its final decision and determine if Tse's admittedly translucent light cover is sized, dimensioned, and shaped in a way that allows it to qualify as a "light pipe" as claimed. As explained in both the Petition and Petitioner's reply, Tse's cover is analogous to that employed in Figure 11 of the '363 patent. As a result, in light of the admission of Patent Owner's counsel, there can be no real dispute that Tse satisfies the claims. *See* Petition, 60-61; Reply (Paper 22), 17-19. Next, even if Tse's cover is not sufficiently thick to be a "light pipe," the Board must assess whether it would have been obvious to form Tse's admittedly translucent cover as an integrally molded light pipe as taught by Carter. Again, both the Petition and the Reply explained why this combination would have been highly obvious to one of ordinary skill in the art. *See* Petition, 70-74; Reply, 21-23.

In addition to the claimed "light pipe" for "diffuse[ing] light," Patent Owner also pointed to an additional claim 19 limit purportedly missing from Tse. In particular, it challenged whether Tse's "light pipe" "surround[s]" its "water outlet." According to Patent Owner, claim 19 somehow requires that all of Tse's water outlets to be surrounded by its cover for the claim to be satisfied. *See* Response, 64. Petitioner explained in its Reply that the claim requires only that "a water outlet" (a

single water outlet) be surrounded. *See* Reply, 19-20. While this Patent Owner argument is not meritorious, it is yet another dispute that will need to be addressed now that the Director has remanded. Finally, the Director's holding regarding claim 19 requires revisiting and re-assessment of any remaining disputes between the parties regarding claims depending on claim 19, including claims 20-23.

III. Conclusion

For the reasons outlined above, Petitioner respectfully requests that the Board enter final decision finding claims 10 and 19 (and the dependent claims discussed above) unpatentable as obvious.

Respectfully submitted,

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Dated: February 4, 2026

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CERTIFICATE OF SERVICE

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