UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Klein Tools, Inc.
Petitioner

v.

Milwaukee Electric Tool Corporation
Keter Home and Garden Products Ltd.
Patent Owners

IPR2024-01400
Patent 11,365,026

PRELIMINARY REPLY

I. INTRODUCTION

Patent Owner invokes 35 U.S.C. § 325(d) to argue for discretionary denial, asserting that Metabowerke and Burchia were "***thoroughly considered and rejected***" during prosecution. POPR at 1 (emphasis added). Patent Owner further asserts that Petitioner "***misleadingly***" points out that the prior art was submitted with nearly 500 other references—even though it indisputably was—and argues instead that its disclosure in related patents is what matters. *Id.* at 12 (emphasis added).

But Petitioner's statement was accurate and not misleading. In fact, Petitioner could not have anticipated that Patent Owner would mischaracterize Metabowerke as "thoroughly considered and rejected" when, in reality, the Examiner never reviewed a complete English translation—only an error-riddled abstract.

A. Metabowerke Was Never Submitted In English, Preventing Any Meaningful Consideration

Patent Owner's assumption that Metabowerke was "thoroughly considered" during prosecution is flawed because the Examiner never had access to a full English translation. This is particularly relevant because, as the Federal Circuit has explained, "the examiner's understanding of a foreign reference is generally limited to that which he or she can glean from the applicant's concise statement." *See Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1377 (Fed. Cir. 2000) (affirming finding of inequitable conduct where patent owner

"effectively failed to disclose Canon reference to the PTO by providing a one-page, partial translation of the entire 29-page application. By submitting the entire untranslated Canon reference to the PTO along with a one-page, partial translation focusing on less material portions and a concise statement directed to these less material portions, SEL left the examiner with the impression that the examiner did not need to conduct any further translation or investigation.")

The Board has likewise recognized that a full English translation of a reference is not "the same or substantially the same art" as an untranslated version submitted during prosecution. *See Champion Labs., Inc. v. Hengst SE,* IPR2024-00603, Paper 9 at 10-11 (PTAB Sept. 18, 2024) (non-precedential) (holding that an English-translated prior art reference contained more readily discernible information than its previously submitted non-English version, making it new prior art).

Here, Metabowerke was never available in full English translation during prosecution, and the English abstract—submitted only in a parent case—was riddled with typographical and grammatical errors that made parts of it incomprehensible. For example, it states: "the *base* part (1) having at least one *base* for projecting the container has a *base or on a cover* (2 ') of a further, similar container"—which is unintelligible. These errors alone weaken Patent Owner's assertion that the Examiner had the opportunity to meaningfully assess Metabowerke.

Even if the Examiner had intended to evaluate Metabowerke, the timing of its submission further undermines Patent Owner's argument. The reference was first submitted in the patent family in an IDS dated May 1, 2020—but by then, the Examiner had already issued multiple indications of allowance, including a Notice of Allowance dated April 17, 2020. Ex. 2001 at 2513.[1] One week later, Applicant filed an RCE, and only thereafter submitted the German-language Metabowerke reference in an IDS, along with the error-riddled abstract.

37 C.F.R. § 1.98(a)(3)(i) requires "a concise explanation of the relevance" of references listed that are "not in the English language." The abstract was insufficient as it failed to disclose key teachings of the reference such as the "recess" on the cover that receives the "foot" on the bottom of the second container. *See Semiconductor Energy Laboratory Co.*, 204 F.3d at 1376 ("MPEP Section 609[] allows the applicant some discretion in the manner in which it phrases its concise explanation, but it nowhere authorizes the applicant to intentionally omit altogether key teachings of the reference.").

[1] Patent Owner's Ex. 2001 appears to inadvertently omit portions of the file history, including the cited page 2513. Petitioner will work with Patent Owner to correct this.

Without a full English translation, the Examiner could not have meaningfully assessed Metabowerke's disclosures—let alone "thoroughly considered and rejected" them.

B. A Fortiori The Combination of Burchia and Metabowerke Could Not Have Been Meaningfully Considered

Without the translation of Metabowerke, the Examiner obviously also could not have considered the combination of Burchia and Metabowerke. Nor could Petitioner have anticipated Patent Owner's claim that Burchia was "thoroughly considered and rejected" in the prosecution of related patents—each of which had different claims and different circumstances.

The timing of Burchia's submission further undermines Patent Owner's arguments. As with Metabowerke, the first submission in the patent family (in an IDS dated April 17, 2019), a publication of the Burchia application was submitted ***only after*** the Examiner had already indicated allowance of the claims (NOA dated March 11, 2019, Ex. 2001 at 873).[2] And, in the '962 patent prosecution (the claims underlying the Examiner's double patenting rejection of the '026 claims), Applicant

[2] Thereafter, Applicant filed an RCE and IDS on April 17, 2019 (*id.* at 927, 1413-20), and the Examiner issued another NOA on May 7, 2019 (*id.* at 1504), followed by numerous RCE's, IDS's and NOAs.

inexplicably waited until December 5, 2019 to submit the Burchia publication (Ex. 2002 at 1114), only after the Examiner had indicated allowability of the claims on September 11, 2019 (*id.* at 386)—when Patent Owner clearly was aware of Burchia months earlier (at least by April 17, 2019).[3]

Thus, the record provides no basis for Patent Owner's claim that the Examiner "thoroughly considered and rejected" Burchia—let alone in combination with an English translation of Metabowerke, which was never before the Examiner. If anything, the delayed submissions of Burchia and Metabowerke suggest a failure to ensure timely and full disclosure.

Date: February 12, 2025

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[3] Thereafter, Applicant filed an RCE and IDS on December 5, 2019 (*id.* at 448), and the Examiner issued another NOA on January 8, 2020 (*id.* at 1492), followed by an RCE, IDS and NOA on January 27, 2020 (*id.*, 1563-66, 1753).

CERTIFICATE OF LENGTH (37 C.F.R. §§ 42.24(D))

The undersigned hereby certifies that this document is 5 pages and thus complies with the applicable page limit.

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CERTIFICATE OF SERVICE (37 C.F.R. §§ 42.6(E), 42.105(A))

The undersigned hereby certifies that on February 12, 2025 this Preliminary Reply was served on counsel of record at Patent Owner's consented to e-mail service address below, understood to include at least lead counsel Dion M. Bregman, and back-up counsel Jason C. White, Scott D. Sherwin, and David P. Bernstein, Ph.D.:

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