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.

Case IPR2024-01401
U.S. Patent No. 11,794,952

PATENT OWNERS' PRELIMINARY SUR REPLY FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 11,794,952

I. INTRODUCTION

Petitioner's arguments about the Examiner's consideration of Metabowerke fail to show how a full translation would have changed the outcome, improperly raise new arguments, and rely on unfounded IDS timing claims. Their attempts to challenge the combination of Burchia and Metabowerke are also unsupported.

A. Petitioner Fails to Show How a Full English Translation Would Have Changed the Examiner's Decision

Petitioner's Reply states that "Patent Owner's assumption that Metabowerke was 'thoroughly considered' during prosecution is flawed because the Examiner never had access to a full English translation." (Reply at 1). This argument rings hollow because Petitioner points to no specific part of a full English translation that would have changed the Examiner's decision.

The Petition's arguments regarding Metabowerke's disclosure rely primarily on its drawings. Where text is referenced, it consists of Petitioner's own annotations rather than translations of the original descriptions. (*See, e.g.,* Petition at 34-35, annotating Figure 1 of Metabowerke and citing to Petitioner's own Expert Report, Ex. 1003). In essence, the Petition depends on Petitioner's interpretation of the drawings; not on the original (let alone translated) written descriptions. Consequently, Petitioner fails to demonstrate how a full English translation would have provided the Examiner with any new or different

understanding of Metabowerke's teachings.

This is presumably why Petitioner's Reply fails to point to a single additional fact that was "lost in translation." There is no reference to any fact that would have been (1) evident from a complete English translation, and (2) relevant to the Examiner's analysis of Metabowerke. If Petitioner truly believed that Metabowerke's translation had information material to the Examiner's understanding, Petitioner could have identified that information and demonstrated how it would have impacted the patentability analysis. Instead, Petitioner relies solely on pointing out typos in the submitted abstract. Yet, the presence of typos in the abstract fails to prove that the Examiner's consideration of Metabowerke was flawed or incomplete. Thus, Petitioner's reliance on the absence of a full English translation is unconvincing because it fails to identify any specific, material information that would have impacted the Examiner's analysis of Metabowerke.

B. Petitioner's Argument that "Metabowerke Was Never Submitted in English, Preventing Any Meaningful Consideration" was Improperly Raised

"A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution." 37 C.F.R. 42.23(b). Petitioner states that "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." (Reply at 1).

The Petition, however, admits that "Metabowerke [was] included in an over 20-page IDS." (Pet. at 19). In doing so, the Petition drew no distinction between the version of Metabowerke that was cited in the IDS and a "full English translation." If Petitioner believed that there is a material difference between the two, Petitioner had every opportunity and motivation to raise this point in the Petition, if any such material difference would have been relevant to Petitioner's arguments concerning the discretionary factors. In short, regardless of what Patent Owner argued in response, Petitioner can and should have raised all of its arguments about Metabowerke in its Petition. In fact, by criticizing the placement of Metabowerke within the IDS, Petitioner apparently ***did*** anticipate Patent Owner's argument that Metabowerke was considered by the Examiner. (*See Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1378 (Fed. Cir. 2023) (where the Board properly rejected new arguments in Petitioner's Reply, noting Petitioner "knew how to put forward" those arguments in the Petition).

Patent Owners' Preliminary Response ("POPR") did not prompt Petitioner to distinguish between the two. Rather than "mischaracteriz[ing] Metabowerke," Patent Owner merely stated that the "Examiner considered both Burchia and Metabowerke during prosecution of the '952 Patent." (POPR at 10). This statement simply acknowledged and responded to the Petition's own admission that "Burchia

and Metabowerke were included in an … IDS" and initialed by the Examiner. (Pet. at 19). Given that the Petition unequivocally admitted that Metabowerke was included in an IDS but still challenged the extent of its consideration, the Board should find Petitioner's argument improperly raised.

Lastly, Patent Owner notes that Petitioner was granted leave to file a Reply without Patent Owner's opposition being considered. (Ex. 3001). The Board should therefore evaluate the propriety of Petitioner's reply arguments in light of Patent Owners' above remarks.

C. Petitioner's Timing Argument is Unavailing

Petitioner misleadingly argues that the timing of the IDS submission rendered it meaningless, when, in reality, (i) Metabowerke was disclosed before final allowance, and (ii) was considered during the prosecution history of related patents, which share substantially similar disclosures.

Petitioner argues that "[e]ven if the Examiner had intended to evaluate Metabowerke, the timing of its submission further undermines Patent Owner's argument." (Reply at 3). Petitioner contends that by the time the IDS citing Metabowerke was filed, "the Examiner had already issued multiple indications of allowance…. [after which] Applicant filed an RCE, and only thereafter submitted the German-language Metabowerke reference in an IDS." *Id*.

This argument is unconvincing because Petitioner hints, without explicitly

stating, that an IDS filed with an RCE after a notice of allowance carries less weight than one filed before. This proposition has no basis in law, and Petitioner offers no legal support for it. In addition, the assertion is illogical. The RCE filed after allowance ***reopened prosecution***, effectively providing the Examiner with a fresh opportunity to evaluate all submitted references, including Metabowerke. There is no logical reason (and Petitioner provides none) to suggest that the Examiner would be unable to fully consider an IDS filed with an RCE.

D. Petitioner's Argument that "A Fortiori The Combination of Burchia and Metabowerke Could Not Have Been Meaningfully Considered," Relies on the Same Flawed Argument Rebutted Above

Petitioner's Reply asserts that "[w]ithout the translation of Metabowerke, the Examiner obviously also could not have considered the combination of Burchia and Metabowerke" but fails to provide any explanation or support for this assertion. (*Id.* at 4). This argument merely repeats Petitioner's unsupported reasoning regarding the translation of Metabowerke and lacks any substantive analysis. Moreover, Petitioner introduces this argument for the first time in the Reply, thus improperly raises it for the reasons already discussed above. Petitioner's Reply also criticizes the timing of various IDS's. But this argument has no factual merit or legal basis, and Petitioner provides none.

Dated: February 26, 2025

Respectfully Submitted,
/ Dion M. Bregman /
Dion M. Bregman, Reg. No. 45,645

CERTIFICATION 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.

Dated: February 26, 2025

Respectfully Submitted,

/ Dion M. Bregman /
Dion M. Bregman, Reg. No. 45,645

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), lead counsel for Patent Owners hereby certifies that on February 26, 2025 a copy of this PRELIMINARY SUR-REPLY was served to the email correspondence address of record for Petitioner's counsel of record:

James M. Glass
jimglass@quinnemanuel.com
Joseph Milowic III
josephmilowic@quinnemanuel.com
Brianne M. Straka
briannestraka@quinnemanuel.com

Niki Edmonds (*pro hac vice* forthcoming)
nikiedmonds@quinnemanuel.com

Dated: February 26, 2025

Respectfully Submitted,

/ Dion M. Bregman /
Dion M. Bregman, Reg. No. 45,645