

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KOKI HOLDINGS AMERICA LTD.

Petitioner

v.

KYOCERA Senco Industrial Tools, Inc.

Patent Owner.

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION
FOR INTER PARTES REVIEW OF U.S. PATENT NO. 11,845,167

Case No. IPR2025-00264

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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Ex. 2002	U.S. Court of Appeals for the Federal Circuit Case Nos. 20-1046, 2050, ECF No. 61 (Kyocera responsive brief), pp. 31–34, 36–39
Ex. 2003	U.S. Court of Appeals for the Federal Circuit Case Nos. 20-1046, 2050, ECF No. 62 (Petitioner reply brief), pp. 21–25

SUMMARY OF DEFICIENCIES

Each of the challenged claims fails on every challenged ground for one of two reasons. Petitioner’s application of the art to the challenged claims, on every ground and for every claim, fails because either (or all) applications (1) require a construction of “storage chamber” that is irreconcilable with the Federal Circuit’s prior construction of the term in *Kyocera Senco Indus. Tools Inc. v. U.S. Int’l Trade Comm’n*, 22 F.4th 1369, 1383 (Fed. Cir. 2022); (2) require a construction of a limitation that is nowhere provided, and therefore fails to comply with 37 C.F.R. § 42.104(b)(3); or (3) rely on prior art that is not specified as one of the challenged grounds in violation of 37 C.F.R. § 42.104(b)(2) and 37 C.F.R. § 42.104(b)(4).

A summary of the deficiencies is shown in the below chart, where it is evident that every challenged claim (independent claims shown with a *) and every ground is legally insufficiently presented to merit institution:

<u>CLAIM</u>	<u>LIMITATION</u>	<u>COMPLIES WITH 37 C.F.R. § 42.104(b)?</u>	<u>FOLLOWS FEDERAL CIRCUIT OPINION?</u>	<u>APPLIES TO GROUND:</u>
1 *	“lifter”	No	--	1, 2, 3 and 4

<u>CLAIM</u>	<u>LIMITATION</u>	<u>COMPLIES WITH 37 C.F.R. § 42.104(b)?</u>	<u>FOLLOWS FEDERAL CIRCUIT OPINION?</u>	<u>APPLIES TO GROUND:</u>
	“removable top cap”	No	--	1 and 2
	“storage chamber”	Yes	No	2 and 4
2	“lifter”	No	--	1, 2, 3 and 4
	“removable top cap”	No	--	1 and 2
	“storage chamber”	Yes	No	2 and 4
3	“lifter”	No	--	1, 2, 3 and 4
	“removable top cap”	No	--	1 and 2
	“storage chamber”	Yes	No	2 and 4
4	“lifter”	No	--	1, 2, 3 and 4
	“removable top cap”	No	--	1 and 2
	“storage chamber”	Yes	No	2 and 4
5	“lifter”	No	--	1, 2, 3 and 4
	“removable top cap”	No	--	1 and 2
	“not vented to the atmosphere”	No	--	3
	“storage chamber”	Yes	No	2 and 4
6*	“lifter”	No	--	1, 2, 3 and 4
	“not vented to the atmosphere”	No	--	3
	“storage chamber”	Yes	No	2 and 4

<u>CLAIM</u>	<u>LIMITATION</u>	<u>COMPLIES WITH 37 C.F.R. § 42.104(b)?</u>	<u>FOLLOWS FEDERAL CIRCUIT OPINION?</u>	<u>APPLIES TO GROUND:</u>
7	“lifter”	No	--	1, 2, 3 and 4
	“not vented to the atmosphere”	No	--	3
	“storage chamber”	Yes	No	2 and 4
8	“lifter”	No	--	1, 2, 3 and 4
	“not vented to the atmosphere”	No	--	3
	“storage chamber”	Yes	No	2 and 4
9	“lifter”	No	--	1, 2, 3 and 4
	“not vented to the atmosphere”	No	--	3
	“storage chamber”	Yes	No	2 and 4
10*	“lifter”	No	--	1, 2, 3 and 4
	“storage chamber”	Yes	No	2 and 4
	“safety contact element”	No	--	1, 2, 3 and 4
11	“lifter”	No	--	1, 2, 3 and 4
	“storage chamber”	Yes	No	2 and 4
	“safety contact element”	No	--	1, 2, 3 and 4
12	“lifter”	No	--	1, 2, 3 and 4
	“storage chamber”	Yes	No	2 and 4
	“safety contact element”	No	--	1, 2, 3 and 4

<u>CLAIM</u>	<u>LIMITATION</u>	<u>COMPLIES WITH 37 C.F.R. § 42.104(b)?</u>	<u>FOLLOWS FEDERAL CIRCUIT OPINION?</u>	<u>APPLIES TO GROUND:</u>
13	“lifter”	No	--	1, 2, 3 and 4
	“storage chamber”	Yes	No	2 and 4
	“safety contact element”	No	--	1, 2, 3 and 4
14	“lifter”	No	--	1, 2, 3 and 4
	“storage chamber”	Yes	No	2 and 4
	“safety contact element”	No	--	1, 2, 3 and 4
15	“lifter”	No	--	1, 2, 3 and 4
	“storage chamber”	Yes	No	2 and 4
	“safety contact element”	No	--	1, 2, 3 and 4

ARGUMENT

I. Statement of Law Common to Several Grounds: Petitions Must Provide a Claim Construction for Any Essential Claim Terms

Several of Petitioner’s grounds (as shown in the chart above) must fail because the Petitioner has not provided a claim construction for some limitation essential to its analysis.

Each petition must:

(b) Identification of challenge. Provide a statement of the precise relief requested for each claim challenged. The statement must identify the following:

(3) How the challenged claim is to be construed. Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function[.]

37 C.F.R. § 42.104(b)(3). When the Petition fails to provide a claim construction, especially for a claim term in controversy, the Petition should be denied. *ams AG*, 2017 WL 1052498, at *5–6.

The Board’s denial of the petition in *ams AG v. 511 Innovations, Inc.*, No. IPR2-16-01792 is squarely on point here. In that case, petitioner argued that the prior art disclosed a thickness less than a “minimal height.” *Id.* at *2. Petitioner, however, did not provide a construction of “minimal height” in its petition. *Id.* Instead, petitioner merely provided observations about the term by reciting a passage in the specification. *Id.* at *3. The petitioner never provided an explicit construction, however. *Id.*

The Board found the petitioner’s “observations” insufficient because, rather than provide a claim construction, it “improperly attempts to shift the burden of construing the claim term ‘minimal height’ to the Board.” *Id.* After considering the arguments about

“minimal height” in the petition and patent owner response, the Board denied the petition, stating:

As explained at the outset, Petitioner bears the burden of defining the claim terms, especially a claim term in controversy as it relates to the grounds, as is the case here. *See* 37 C.F.R. § 42.104(b)(3). As also explained above, challenged claims 3 and 11 depend directly or indirectly from claim 1 and therefore include the claimed “minimal distance.” In summary, Petitioner does not provide an explicit claim construction and does not show (or assert) that claim 1 in light of the ’096 patent Specification provides a plain and ordinary or implicit meaning for “minimal height.” Accordingly, under the circumstances discussed above, including that the parties disagree over whether the prior art discloses or suggests the claimed “minimal height,” Petitioner fails to meet its burden under 37 C.F.R. § 42.104(b)(3) of providing a claim construction for the term “minimal height.”

Therefore, we decline to institute an inter partes review of the challenged claims.

Id. at *5–6.

II. Issues Common to All Grounds: The Petition as to All Grounds Should Be Denied for Failure to Comply with 37 C.F.R. § 42.104(b)(3)

The Petition does not comply with the requirement to “identify ... how the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3).

First, *each and every* challenged claim contains the limitation “lifter.” Petitioner asserts that the term “lifter” in the ’167 Patent is

subject to 35 U.S.C. § 112(f), but fails to comply with the requirement of 37 C.F.R. § 42.104(b)(3) to specifically identify the structure in the specification associated with that element. As “lifter” is present in *every* challenged claim under all four grounds, Petitioner’s failure to provide a claim construction for “lifter” is fatal to its Petition.

Second, Grounds 1 and 3 cannot be sustained because Petitioner’s assertion that Haley and Saari/Enstrom each has a “removable top cap” is made without *any* argument as to how the structure identified is a “removable top cap.” In particular, Petitioner’s argument as to Haley is that the entire external structure is itself a “cap,” while at the same time a wholly *different* structure—a cylindrical column extending through the top portion of the external chamber structure—is the cap in Saari/Enstrom. To reconcile those assertions requires some construction of “removable top cap” that explains what that structure is and how it differs from the overall structure of the chamber, or else there is no principled way in which the structure identified could meet the limitation in both cases. Because a construction of what part of the chamber structure in Haley and Saari/Enstrom actually constitutes the “removable top cap” is essential to Petitioner’s arguments, the failure to

comply with 37 C.F.R. § 42.104(b)(3) alone merits denial of the Petition as to Grounds 1 and 3. *See Willis Elec. Co. v. Polygroup Macau Ltd.*, No. IPR2017-00330, 2017 WL 2304440, at *6 (P.T.A.B. May 25, 2017) (denying institution for failure to comply with 37 C.F.R. § 42.104(b)(3)); *ams AG v. 511 Innovations, Inc.*, No. IPR2-16-01792, 2017 WL 1052498, at *5–6 (P.T.A.B. Mar. 16, 2017) (same).

Third, Ground 3 fails as to certain claims because Petitioner contends that Kondo meets the limitation that the “pressurized gas is not vented to the atmosphere,” despite the fact that Kondo plainly states that its gas chamber must be refilled. Even if the required re-pressurization of the Kondo nailer is, as Petitioner suggests, necessary only after “use of the nailer for a long time” (Petition, p. 65), the fact remains that Kondo expressly states that pressure is decreasing, which Petitioner concedes implies that gas is (perhaps slowly) being vented to the atmosphere. (*Id.* (admitting that Kondo discloses gas venting through “minor leaks”).) To equate “minor leaks” and a dissipating gas, Petitioner must, somehow, align that feature of Kondo with a construction of the claim limitation “not vented to the atmosphere.” That requires a claim construction that Petitioner fails to provide.

Finally, Petitioner makes virtually no effort to identify the required “safety contact element” in the prior art, merely showing pictures of nailers in references that, one must assume, include a “safety contact element.” First, only Ground 1 even purports to show a “safety contact element,” but Petitioner equates the structure in the reference it claims is the “safety contact element” with a different claim limitation, the “guide body.” Petitioner fails to offer a claim construction that makes the rendering of that limitation superfluous, and therefore *again* ignores 37 C.F.R. § 42.104(b)(3). Second, Petitioner concedes—both expressly in Grounds 2, 3 and 4 and impliedly in Ground 1—that the references cited to meet its statutory obligations under 35 U.S.C. § 311(b) are “silent” as to a “safety contact element,” but nevertheless points to additional references, *not included in its stated grounds*, to supply that missing element. That is not permissible. Those failures merit denial of the Petition as well.

A. Issue Common to All Grounds: Every Ground Fails Because Each Relies on a § 112(f) Construction of “Lifter” that Petitioner Never Provides

The Petition should be denied because the Petition fails to adequately address the limitation “lifter” as required by law. First,

Petitioner assumes, based on a prior decision on a different patent, but with no further analysis, that every instance of “lifter” in the ’007 Patent and all related patents in the family (regardless of any differences in claim language) should be construed as a means-plus-function limitation. That analysis—or lack thereof—is insufficient. Second, if, as Petitioner asserts, “lifter” is a means-plus-function limitation, Petitioner has not complied with 37 C.F.R. § 42.104(b)(3) by failing to identify *any* structure in the ’007 Patent to perform the claimed function. Third, Petitioner compounds that failure by skipping directly to mapping lifter to various, wholly different, structures in the cited patents, obscuring the statutorily mandated analysis of whether the alleged prior art structure is identical to, or equivalent to, some structure in the specification of the ’007 Patent. That approach impermissibly reads “lifter” on *any* structure that performs the alleged function, eviscerating the very specific statutory limitations enshrined in 35 U.S.C. § 112(f). As Petitioner’s failure affects every Ground and every claim, the Petition should be denied for this reason alone.

1. Petitioner Fails to Identify a Corresponding Structure for “Lifter”

In its claim construction, Petitioner must identify a structure in the specification that aligns with the claimed “lifter,” describe its function, and demonstrate how it operates. Yet, Petitioner does not point to any specific structures in the specification of the ’167 Patent that correspond to the “lifter” or how it functions. Instead, under the claim construction section of its Petition, Petitioner merely notes that:

The Federal Circuit held that the term ‘lifter member’ in the related patents is a means-plus-function term subject to §112(f). Petitioner submits the term “lifter” in the claims of the ’167 patent is likewise a means-plus function term, because the ’167 patent claims also lack any “recital of structure, material, or acts in support thereof” for the “lifter” element. 35 U.S.C. §112(f). The “lifter” of the independent claims only describes a function and is not accompanied by any structural recitations.

(Petition at 6.)

Petitioner seriously mischaracterizes the Federal Circuit’s opinion, which in fact said the opposite. In the parties’ prior appeal to the Federal Circuit, the term “lifter” was considered in relation to only one patent—U.S. Patent No. 8,738,718. Recognizing that there were multiple patents in the family having differing claim language around “lifter,” the Federal Circuit considered only that the claimed “lifter

member” *in that patent* disclosed only function but no structure.

Kyocera Senco, 22 F.4th at 1380. But, with respect to *other patents* (and equally applicable to the ’167 Patent), the Federal Circuit pointedly noted:

Dr. Vallee’s¹ testimony is not to the contrary. See J.A. 1612 ¶ 91. That testimony related to the “lifter member” term in other asserted patents: the ’296, ’297, and ’722 patents. The claim language in each of those patents contains an extensive structural description of the lifter member. See ’296 patent claim 1(d). The ’718 patent lacks such structural claim language.

Id. at 1381 n.9. And ultimately, the Federal Circuit did not actually complete the task of claim construction, instead finding that because “the parties have not thoroughly briefed what structures correspond to the claimed ‘lifter member,’ we leave that question for the Commission on remand.” *Id.* at 1381.

Here, Petitioner has failed to do what Federal Circuit advised must be done and what 37 C.F.R. § 42.104(b)(3) requires, leaving the Patent Owner and the Board guessing as to what Petitioner contends is the proper construction of the term.

¹ Koki’s expert in that case and in this IPR.

The rules regarding the content of a petition, and what claim construction information must be included, are clear: “A petition must set forth “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). “Where the claim to be construed contains a means-plus-function or step-plus-function limitation as permitted under 35 U.S.C. [§] 112(f), the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each function.” *Id.* The Board’s rules go further. Where claim language may be construed according to 35 U.S.C. § 112(f), a petitioner *must provide* a construction that includes both the claimed function *and* the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function. As the Board’s Consolidated Trial Practice Guide (“CTPG”) says, “A petitioner who chooses not to address construction under § 112(f) risks failing to satisfy the requirement of 37 C.F.R. § 42.104(b)(3).” CTPG 45 (citing 37 C.F.R. § 42.104(b)(3)).

If these limitations are means-plus-function limitations, then petitioners are required to identify these corresponding structures in the specification of the challenged patent because whether the prior art

contains these means-plus-function limitations requires proof that these corresponding structures or their equivalents are found in the asserted prior art references. Instead, Petitioner fails to identify the corresponding structures in the specification of the '167 Patent for the “lifter” and simply alleges that the prior art includes some structures for performing the claimed functions (*i.e.*, moving the driver toward a ready position). That approach reduces the limitation to its function—in express contravention of the bargain ingrained in 35 U.S.C. § 112(f)—and therefore violates the Board’s requirement that the “petition must specify where each element of the claim is found in the prior art patents and printed publications relied upon.” 37 C.F.R. § 42.104(b)(4).

Petitioner’s failure here relates to every ground and every claim, and is fatal to its Petition. The Board regularly denies institution in these circumstances. *See e.g., SAS Inst., Inc. v. Complementsoft, LLC*, IPR2013-00226, 2013 WL 8595939, at *7 (P.T.A.B. Aug. 12, 2013) (“SAS does not identify what structure in the Specification it believes corresponds to the means-plus-function limitation of claim 11. This failure is fatal to SAS’s challenge of claims that include that limitation.”); *Clickbooth.com LLC v. Essociate, Inc.*, IPR2015-00464,

Paper 9 at 12 (P.T.A.B. July 9, 2015) (“As such, Petitioner fails to identify corresponding structure for any of the means-plus-function limitations and, therefore, fails to comply with 37 C.F.R. § 42.104(b)(3). Accordingly, we decline to institute inter partes review [of the challenged claims].”).

2. Petitioner’s Failure to Provide a Claim Construction Prevents Meaningful Comparison to Prior Art

The Petition fails to satisfy 37 C.F.R. § 42.104(b)(3) because it cannot be readily determined what specific construction Petitioner applies in its analysis comparing the limitation “lifter” in view of the prior art. A petition must apply its proposed claim construction in analyzing unpatentability. 37 C.F.R. § 42.104(b)(4) (“How the *construed claim* is unpatentable under the statutory grounds identified in paragraph (b)(2) of this section. The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”) (emphasis added). The purpose of these rules is not only to comply with the “particularity” requirement of 35 U.S.C. § 312(a)(3) but also to “provide the patent owner with a minimum level of notice as to the basis for the challenge to the claims.” 77 Fed. Reg.

48680, 48688. If a petitioner were free to proffer claim constructions and then ignore those claim constructions when analyzing unpatentability, such inconsistency would create confusion and uncertainty in the petitioner's unpatentability positions, depriving the patent owner of notice as to the specific basis for the challenge.

Here, Petitioner's failure to provide a claim construction in the first instance has the same effect, making it impossible to properly compare the prior art references to the '167 Patent. This lack of notice prejudices the Patent Owner because it places the Patent Owner in the untenable position of having to guess as to what constructions the Petitioner applied in its grounds of unpatentability and how precisely the Patent Owner should respond to Petitioner's challenges.

Prior decisions have found that uncertainty and inconsistency in a petitioner's proffered construction and applied claim constructions "is reason enough to deny the petition." *See Infinera Corp. v. Core Optical Tech., LLC*, IPR2018-01259, 2019 WL 189235, at *6 (P.T.A.B. Jan. 14, 2019). In *Infinera*, the petitioner identified potential constructions from a court in related litigation, similar to Petitioner's citation to the Federal Circuit here, but without proposing a specific construction for

the Board. *Id.* The Board found that Petitioner’s analysis of the prior art grounds revealed multiple implied proposed constructions for a term, but that Petitioner had failed to set forth explicitly *any* construction for the term in the Petition. *Id.* Based on the different constructions for the claim term explicitly and implicitly set forth by Petitioner, the Board held that Petitioner “failed to identify adequately its proposed construction applicable to its patentability challenges” under 37 C.F.R. § 42.104(b)(3), and that Petitioner’s failure to “tak[e] a definitive position” as to the construction of a term was “enough to deny the petition.” *Id.*

Petitioner’s failure to identify a claim construction that specifically points to structure *in the specification of the ’167 Patent* that is linked with proposed function is equivalent to proposing myriad constructions without taking a stand, just as in *Infinera*. The reason is that, without a stated construction, neither the Board nor the Patent Owner can determine whether the prior art structures cited by Petitioner meet the challenged limitation literally or by equivalents. 35 U.S.C. § 112(f) (“infringement of” covers the literal structure in the specification “and equivalents thereof”). That failure undermines any

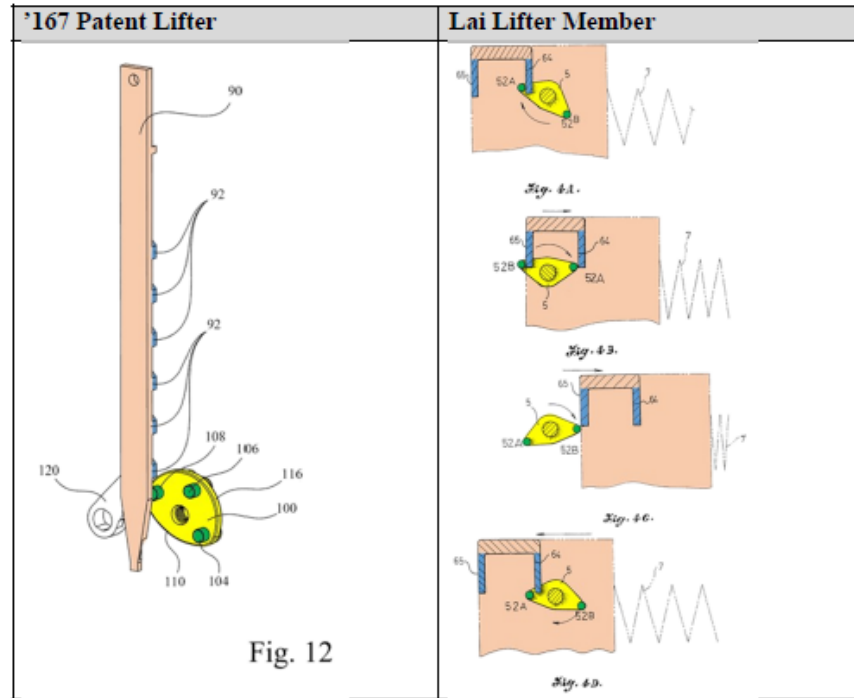
rational application of the prior art to the claims and puts the Board (and Patent Owner) in the position of not knowing *how* to evaluate the prior art structure, *e.g.*, whether to attack its literal identity, or to formulate arguments and take evidence on the way in which it performs the function and to what result. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997) (identifying the “function, way, result” test for equivalence).

Additionally, as in *Infinera*, Petitioner’s implied constructions are both broad and inconsistent with one another. For example, Petitioner merely recites passages from Lai (Ground 1) and Kondo (Ground 3), without any elaboration or explanation of the construction, along with conclusory statements that the references meet the claim element. With respect to Kondo (Ground 3), Petitioner states:

Kondo differs slightly from the ’167 patent in that the pins of the lifter member (crank pins 7a and 7b) engage protrusions on an *intermediate member* (protrusions 10a and 10b on an intermediate member 10) rather than protrusions on the driver blade itself. Dr. Vallee explains that a POSITA would consider this difference to be insignificant, because Kondo’s actual lifting structure is still the same as that of the “lifter” in the ’167 patent and the intermediate member simply channels the lifting force from that lifter member to the driver blade 15.

(Petition, pp. 67-68 (emphasis added).) At the same time, Petitioner states that the lifter in Lai (Ground 1) is “essentially identical” to the claimed lifter member. (Petition, p. 12.)

Petitioner has failed to articulate a structure in the specification which would make both statements true. At best, Petitioner might suggest that, whatever the corresponding structure is in the '167 Patent, Lai meets it literally and Kondo by equivalence. Without meeting the requirements of identifying that structure, though, neither the Board nor the Patent Owner can make that judgment. In fact, Petitioner's own statements suggest rather that *neither* Lai nor Kondo meets the literal structure of the specification, as Petitioner calls Lai “*essentially* identical.” (*Id.*) In fact, Petitioner reproduces a version of the lifter from the '167 Patent and from Lai, and they are decidedly *not* identical:



(*Id.*, p. 13.) Petitioner’s arguments merely beg the question.

Moreover, without a defined structure, Petitioner’s arguments about what a POSITA would consider to be a significant difference (*id.*, pp. 67-68) are speculative. Rather, because Petitioner has identified differences between the “lifters” that are allegedly disclosed in Lai and Kondo, Petitioner must acknowledge and address those differences instead of treating them interchangeably. Without an explicit claim construction, it is impossible for the Board to determine whether Petitioner has applied some unstated construction uniformly in Lai and Kondo.

Petitioner must state a claim construction and apply that same construction uniformly across prior art references. Where Petitioner reads an unstated construction on multiple different prior art structures, the Board should deny the Petition as violating 37 C.F.R. § 42.104(b)(3). Because Petitioner's failure affects every claim and every ground, its Petition should be denied.²

B. Grounds 1 and 2: The Petition Fails as to Claims 1 through 5 for Failure to Construe “Removable Top Cap”

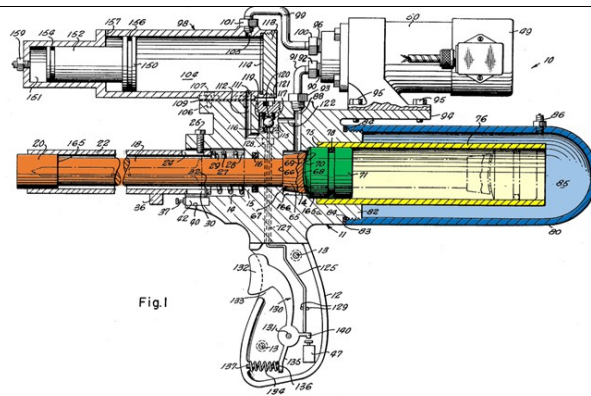
Petitioner's Grounds 1 and 2 identify two completely different, and mutually exclusive, structures of the “removable top cap.” Because the competing analyses in those grounds makes a consistent construction of “removable top cap” either impossible, or at least known only to Petitioner, the Petition was required under 37 C.F.R. § 42.104(b)(3) to define “removable top cap.” Because it did not, and because “removable top cap” is necessary to claims 1 through 5 for every ground, the Petition should be denied as to claims 1 and 5 on all grounds.

² To the extent Petitioner responds by assigning its failure to the patent specification's lack of structure, that tactic would merely amount to a stealth invalidity attack on grounds (indefiniteness) not permitted for review in an IPR. 35 U.S.C. § 311(b); *Samsung Elec. Am., Inc. v. Prisia Eng'g Corp.*, 948 F.3d 1342 (Fed. Cir. 2020).

First, in respect of Ground 1 (Haley), Petitioner identifies an entire exterior structure of a chamber as itself being a “removable top cap,” thereby violating the canon of claim construction that one should not make a claim term superfluous. *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1362 (Fed. Cir. 2008). If Petitioner’s analysis necessitated a construction that would make a limitation meaningless, it was obligated, at a minimum under 37 C.F.R. § 42.104(b)(3), to provide such a construction. It did not do so. Second, in respect of Ground 2 (Saari/Enstrom), it identified a columnar insert into the exterior wall structure of the chamber as the top cap. In essence, however, the Petition argues the case, the “removable top cap” must apparently be construed as a top cap capable of being an insert in a top cap. That redundant and non-sensical approach required a consistent claim construction Petitioner never provided.

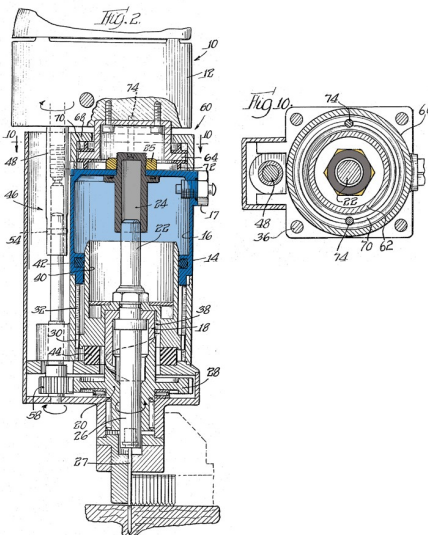
Claims 1 through 5 of the ’167 Patent require that “said removable top cap include[s] a removable top cap at a location proximal to said first end of said hollow cylinder.” (Ex. 1001, ’167 Patent, claim 1, 39:16–18.) Petitioner asserts that Haley and Saari/Enstrom meet that limitation with the following illustrations:

HALEY (GROUND 1)



“Haley’s ‘elongate accumulator shell 83’ (blue) is a removable top cap ‘threaded on the rearward extension 82 of the body’ proximal to the first end (right in Fig. 1) of the hollow cylinder 76.” (Petition, p. 21.)

SAARI/ENSTROM (GROUND 2)



“Saari/Enstrom’s removable top cap (blue) has a top cap (sleeve 24, grey), which is removably attached by a nut 25 (yellow).” (Petition, p. 48.)

On the one hand (Haley), the “top cap” comprises the *entire* exterior structure of the removable top cap. This much is clear from the

Petition, which uses the same drawing to identify the blue section cabined by the “shell” as the removable top cap 85, saying

Haley discloses “said removable top cap being in fluidic communication with a first end of said hollow cylinder.” Haley’s main removable top cap 85 (blue) is in fluidic communication with the first end of hollow cylinder 76 (yellow), which is shown in Figure 1, where the first end of cylinder 76 (right) is open to chamber 85.

(Petition, p. 20.) Thus, per Petitioner, the *entire* outer structure of the removable top cap is the “removable top cap.”

Saari/Enstrom, on the other hand, discloses an exterior wall structure of the chamber that is *separate* from the asserted “removable top cap.” Per Petitioner, the same blue removable top cap is surrounded by a dark blue shell, but in Saari/Enstrom, the structure that would have constituted the “removable top cap” in Haley is no longer the “removable top cap.” Instead, the “removable top cap” is the grey sleeve that is inserted into that exterior shell. (Petition, p. 48.)

Petitioner cannot have it both ways, at least not without explaining to the Board how to arrive at a construction of “removable top cap” that encompasses both embodiments. *See Infinera Corp. v. Core Optical Tech., LLC*, IPR2018-01259, 2019 WL 189235, at *6 (P.T.A.B. Jan. 14, 2019) (holding that petitioner’s failure to “tak[e] a definitive

position” as to the construction of a terms was “enough to deny the petition”). Doing so “improperly attempts to shift the burden of construing the claim term [‘removable top cap’] to the Board.” *ams AG*, 2017 WL 1052498, at *3. Petitioner’s failure to comply with 37 C.F.R. § 42.104(b)(3) as to “removable top cap” requires that the Petition be denied as to Grounds 1 and 2.

C. Petitioner’s Ground 3 Relies on an Unstated Claim Construction of “Not Exhausted to Atmosphere” in Respect of Claims 6 through 9

Petitioner’s application of Kondo (Ground 3) to claims 6 through 9 necessitates a specific—but unstated—construction of “not exhausted to atmosphere” to accommodate Petitioner’s admission that the pressure system of Kondo does, in fact, need replenishment because of “minor leaks” to the atmosphere. (Petition, p. 65 (admitting that Kondo discloses gas venting through “minor leaks”).)

Kondo expressly discloses a gas replenishment system to replace gas exhausted to atmosphere:

Further, since the air replenishing device 30 is provided on the nailer of this embodiment, the compressed air is replenished from the air replenishing tank 19 when the pressure within the air chamber 14 has been reduced to have a value lower than the predetermined value during the use

of the nailer for a long time, so that the air within the air chamber 14 can be compressed to have a constant pressure.

(Petition Ex. 1008, Kondo, 7:62–8:1.) That description of Kondo has only one interpretation—gas is exhausted to the atmosphere.

Petitioner, however, states that if one simply removed the gas replenishment system of Kondo, Kondo would somehow meet the limitation that the gas is “*not* exhausted to atmosphere” (emphasis added). But Petitioner never explains how this could be so. As Kondo itself makes clear, and as Petitioner readily admits, Kondo continues to exhaust gas to the atmosphere through “minor leaks” that occur after extended use of the nailer. (Petition, p. 65.) Removing the gas replenishment system does not magically make Kondo stop exhausting gas to the atmosphere; it merely means that the gas is never replenished.

To remove the gas replenishment system, as Petitioner states is obvious to do, would leave a nailer that *still* does not meet the limitations of the claim, even after Petitioner’s so-called “obvious” modification. To bridge that gap, even after its proposed modification, Petitioner must provide the Board with some claim construction that equates “not exhausted” to “exhausted only a little after prolonged use.”

Notably, Petitioner has not pointed to *anything* in the '167 Patent to suggest the inventors acted as their own lexicographer to give a common word, “not,” an uncommon meaning, *e.g.*, “sometimes” or “slowly.” *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (“Where an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner within the patent disclosure’ so as to give one of ordinary skill in the art notice of the change.”) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387–88 (Fed. Cir. 1992)).

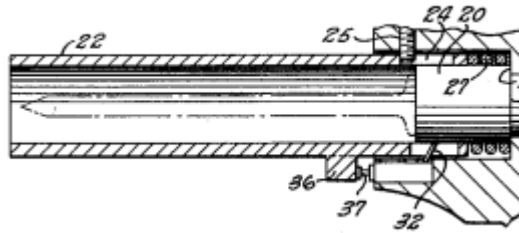
Petitioner’s failure constitutes fatal non-compliance with 37 C.F.R. § 42.104(b)(3), and therefore Ground 3 cannot be sustained as to claims 6 through 9.

D. Additional Issue with Respect to Ground 1: Petitioner Fails to Define “Safety Contact Element” in Respect of Claims 10 through 15

Petitioner’s Ground 1 challenge to claims 10 through 15 must be denied because Petitioner has not complied with 37 C.F.R.

§ 42.104(b)(3) with respect to the term “safety contact element.”

Petitioner locates the “safety contact element” as element 22 of Haley, shown here:



(Petition, p. 36 (citing Haley, Fig. 3).) Petitioner notes that “Haley’s safety contact element is at the front portion of the tool *but is integrated with the guide body.*” (*Id.*, p. 37.) In fact, Petitioner identifies element 22 of Haley as the “guide body.” (*Id.*, p. 26 (identifying the “guide body” element as “guide barrel 22”).)

Petitioner’s approach of reading the same element in the prior art on two distinct claim limitations necessitates some claim construction to avoid rendering one of the claim limitations superfluous. *Ortho-McNeil*, 520 F.3d at 1362 (stating that claim limitations should not be construed to be superfluous). At a minimum, Petitioner must identify some construction of “safety contact element” that differentiates the guide body from the safety contact element, either by some structural distinction, or by some functional distinction. Petitioner’s leaving to the Board the work of identifying a claim construction that would avoid making the safety contact element superfluous is impermissible. *ams AG*, 2017 WL 1052498, at *3.

III. Additional Issues Common to Grounds 2 and 4: Petitioner Cannot Sustain Either of Grounds 2 or 4 Based on Its Erroneous “Storage Chamber” Construction

Grounds 2 and 4 each require this Board to interpret the “storage chamber” to be the same structure as the hollow cylinder. The Federal Circuit, considering both parties’ claim construction arguments, rejected that construction. The storage chamber and the cylinder must be “*distinct* structures.” Because the structures highlighted in Grounds 2 and 4 are the *same* structure, those Grounds must be rejected.

A. Petitioner’s Construction of “Storage Chamber” as Coextensive with the Hollow Cylinder Cannot Be Correct Because the “Storage chamber” Must Be a “Distinct Structure” from the Hollow Cylinder

In the parties’ prior appeal of related patents, the Federal Circuit considered and rejected Petitioner’s proposed construction of the “storage chamber,” saying explicitly

the claims *require two distinct structures*, the main storage volume and a smaller “hollow cylinder” contained within the main storage volume. The agreed-upon construction confirms that requirement, noting the “main storage chamber” must be “distinct from the volume of the cylinder, i.e., the hollow cylinder.”

Kyocera Senco Indus. Tools Inc. v. U.S. Int’l Trade Comm’n, 22 F.4th 1369, 1383 (Fed. Cir. 2022) (emphasis added).

Petitioner attempts to side-step that clear construction of the claims (*i.e.*, the court stated expressly “the claims require...”) by instead characterizing the court’s discussion as a mere “deferential clear error” review. (Petition, p. 7.) That characterization is inaccurate. The court *first* confirmed the claim construction in the passage above, and only then applied that construction to the cited art (Pedicini). The second step—application of the claim construction to Pedicini—was done under the “substantial evidence” standard. *Kyocera*, 22 F.4th at 1383.

In any event, even if not binding here, the Board should still adopt the Federal Circuit’s clear requirement that the storage chamber and the hollow cylinder be “distinct structures.” Nothing in the court’s prior analysis indicates any reason to depart from that requirement. In fact, in arriving at that conclusion, the court cited to the same intrinsic evidence that would inform the Board, *i.e.*, the patent specification itself. *Id.* (citing the sister patent).

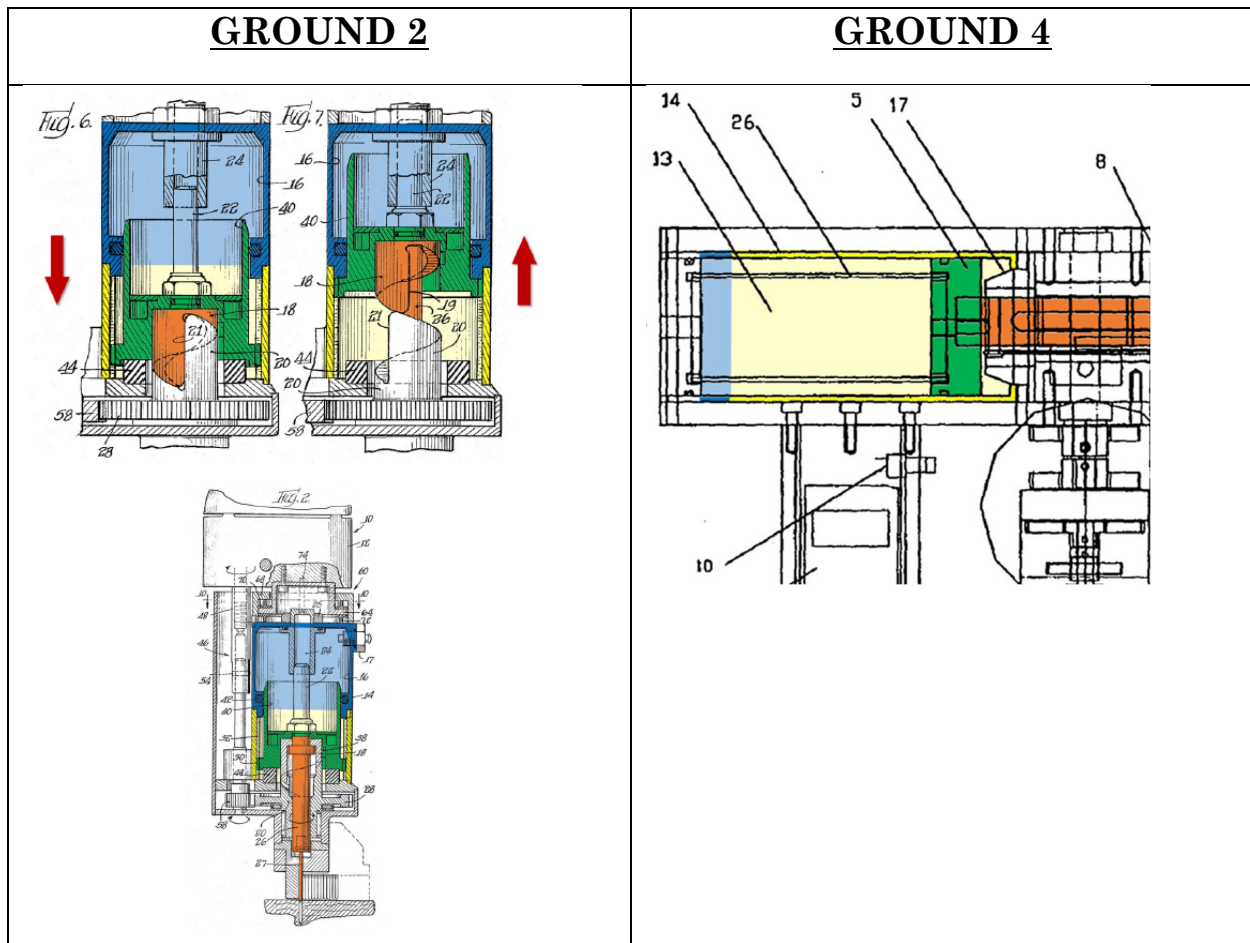
To institute an IPR, the Petitioner must show a “reasonable likelihood” that the claims at issue are unpatentable. 35 U.S.C. § 314(a). It is not at all reasonably likely that the construction of “storage chamber” would so plainly contradict the construction of the

Federal Circuit, even if that construction occurred in the context of an ITC action and is not binding here. *Cf. Tandon Corp. v. U.S. Int’l Trade Comm’n*, 831 F.2d 1017, 1019 (Fed. Cir. 1987) (“[O]ur appellate treatment of decisions of the Commission does not estop fresh consideration by other tribunals.”). The Federal Circuit was briefed on this issue—by both parties—as a matter of claim construction, arguing based on intrinsic evidence for the proper construction of “storage chamber” and whether it must be “distinct” from the hollow cylinder. (See Exhibit 2001, ECF No. 50 (Petitioner’s opening brief), Case Nos. 20-1046, 2050, pp. 78–80 (arguing claim construction of “storage chamber”); Exhibit 2002, ECF No. 61 (Kyocera responsive brief), Case Nos. 20-1046, 2050, pp. 31–34, 36–39 (arguing claim construction of “storage chamber”); Exhibit 2003, ECF No. 62 (Petitioner reply brief), Case Nos. 20-1046, 2050, pp. 21–25.) Given that the Federal Circuit considered the best arguments both sides had on the proper claim construction, there is little to no chance that the court (on review of this Board or otherwise) would consider those *same* arguments and reach a *different* conclusion. *Toshiba Am. Elecrtonic [sic] Components, Inc. v. Monument Peak Ventures, LLC*, Case IPR2021-00330, 2022 WL 128793,

at *7 (P.T.A.B. Jan. 14, 2022) (denying petition based on the “low probability” that the Federal Circuit’s decision would be overturned). Without at least a “substantial chance” of that happening, there is no “reasonable likelihood.” *See Statista, Inc. v. Christopher*, 102 F.3d 1577, 1582 (Fed. Cir. 1996) (identifying “reasonable likelihood” standard as “substantial chance”) (citing *Data Gen. Corp. v. Johnson*, 78 F.3d 1556, 1562–63 (Fed. Cir. 1996)).

B. Grounds 2 and 4 Require the Storage Chamber and Cylinder to Be the Same, Not Distinct, Structures

Petitioner’s Petition should be denied because its Grounds 2 and 4 both require the Board to find the storage chamber and the cylinder to be the *same*, rather than *distinct* structures. Petitioner’s depiction of those elements is an act of arbitrary color-coding rather than an identification of “distinct structures”:



(Petition, pp. 42–44 (Ground 2), 86 (Ground 4).) This is precisely the approach the Federal Circuit rejected. *Kyocera*, 22 F.4th at 1383 (“The Pedicini figure upon which Koki relies shows a single structure”)
(rejecting argument for invalidity based on Pedicini, referring to the same annotated version of Figure 1 of Pedicini shown above).

Because the “storage chamber” element is found in every independent claim, and each of Petitioner’s Grounds 2 and 4 requires its erroneous construction, Petitioner’s Grounds 2 and 4 cannot be

sustained for *any* of the challenged claims. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.”).

IV. Additional Issues Common to All Grounds: Petitioner Relies on Art Not Included in Its Stated Grounds to Teach the “Safety Contact Element” in Claims 10 through 15

In each of Petitioner’s grounds for challenging claims 10 through 15, Petitioner relies on a combination of references to teach the “safety contact element” that are not part of its stated grounds. That tactic violates the requirement in 37 C.F.R. § 42.104(b)(2) and (b)(4) that Petitioner must identify, for each ground, “the patents or printed publications relied upon for each ground” and “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)(2) and (b)(4).

In each of the grounds, Petitioner identifies a “safety contact element” in references that were not identified in its grounds for challenge. With respect to grounds 2, 3 and 4, Petitioner concedes that the “safety contact element” is not found in any of the references that constitute the asserted grounds. (Petition, pp. 60 (ground 2,

“Saari/Enstrom is silent about a safety contact element”), 83 (ground 3, “Kondo is silent about a safety contact element”), 106 (ground 4, “Pedicini is silent about a safety contact element”).) To supplement those failures, Petitioner cites to its expert’s statement that the “safety contact element” was nevertheless known in the art, citing additional references U.S. Pub. No. 2005/0217875 (Ex. 1015, “Forster”), U.S. Pub. No. 2008/0067213 (Ex. 1016, “Shima”), and the Senco 41 Nailer Operating Instructions (Ex. 1017, “Senco”). (Petition, pp. 37 (ground 1), 60–61 (ground 2), 83 (ground 3), 106 (ground 4).)

Petitioner, however, specified the references constituting its challenged grounds as follows:

Ground	Claims	Basis For Rejection
1	1–15	Obvious based on U.S. Patent No. 3,150,488 (“Haley”) in view of U.S. Patent No. 5,503,319 (“Lai”)
2	1–15	Obvious based on U.S. Patent Nos. 3,924,692 (“Saari”) and 3,913,685 (“Enstrom”) in view of U.S. Patent No. 5,503,319 (“Lai”)
3	1–15	Obvious based on U.S. Patent No. 5,720,423 (“Kondo”)
4	1–15	Obvious based on U.S. Patent Publication No. 2006/0180631 (“Pedicini”)

(Petition, p. 4.)

While Petitioner is permitted to supplement the cited references by referring to declaration evidence of what may have been known in the art, that declaration must still tie that testimony to the references cited as part of the ground. For example, in *Global Tel*Link Corp. v. Securus Techs., Inc.*, the Board denied a petition because the expert declaration did not tie testimony to art that was part of the challenged grounds. *Global Tel*Link Corp. v. Securus Techs., Inc.*, IPR2015-01222, 2017 WL 2983336, at *2 (P.T.A.B. July 12, 2017). The Petitioner argued that the Federal Circuit had expressly permitted a declarant to testify as to “common sense,” but the Board noted instead that in the cited decision, *Arendi S.A.R.L. v. Apple, Inc.*, 832 F.3d 1355 (Fed. Cir. 2016), the “declarant’s testimony and the arguments raised were considered explicitly in the context of the single prior art reference *considered in the ground of unpatentability.*” *Global Tel*Link*, 2017 WL 2983336, at *2 (emphasis added). The Board noted that to allow reliance on references outside those identified in the ground “would obviate the statutory requirement” of 35 U.S.C. § 311(b). *Id.*; see also *Costco Wholesale Corp. v. Robert Bosch LLC*, IPR2016-00034, 2016 WL

2865732, at *5 (P.T.A.B. Apr. 25, 2016) (refusing to institute IPR where it was unclear what references constituted the challenged ground).

Gen. Elec. Co. v. United Techs. Corp., IPR2016-00533, 2016 WL 5220000 (P.T.A.B. June 30, 2016) is distinguishable. There, the secondary references not cited in the specific grounds were used by the expert to interpret the disclosure of an element actually shown in one of the references relied upon, not to supply a missing element. *Gen. Elec.*, 2016 WL 5220000 (referring to references outside the grounds to interpret the relied upon reference as disclosing the claimed “core nacelle”). Though the Board there noted that it was not improper for an expert to refer to references not specifically relied upon in the proposed ground, the circumstance was different than here, where the declarant is using the uncited references to identify a missing element, not interpret one found in the properly cited patents.³

³ Even as to Ground 1, Petitioner seeks to supplement, rather than explain, the “safety contact element,” as evidenced by the fact that it has provided no claim construction to differentiate what it cites as the “safety contact element” from the “guide body.” *See supra* Section II.D. Petitioner concedes as much when it states, “a POSITA would be motivated to incorporate such a safety contact element into Haley based on design choice and market forces, because that was the conventional design taught by [the prior art references not included in the grounds].”

Because every ground relies on an improper use of prior art not made part of the grounds to meet the “safety contact element” of claims 10 through 15, the Petition should be denied.

V. The Board Should Exercise Its Discretion to Deny Institution in Light of the Petition’s Many Deficiencies

Institution of an IPR is discretionary. *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 366 (2018). At the same time, once instituted, the Board lacks discretion as to which challenged claims to review; the Board must review *all of them*. *Id.* As the Supreme Court noted,

[W]hile § 314(a) invests the Director with discretion on the question *whether* to institute review, it doesn’t follow that the statute affords him discretion regarding *what* claims that review will encompass. The text says only that the Director can decide “whether” to institute the requested review—not “whether *and to what extent*” review should proceed.

Id. (emphasis in original).

Here, even if arguments as to a few claims might have been properly presented in the Petition, a decision to institute here would require the Board to address—for the first time and with no Petitioner input—critical claim construction issues affecting nearly every claim

(Petition, p. 37.) If Haley already included a “safety contact element,” there would be no need to look to other prior art to provide element.

and every ground. *See supra*, Summary of Deficiencies. That task would undermine the requirements of 37 C.F.R. § 42.104(b)(3) (requiring the Petitioner to provide claim constructions) as well as the Board's stated position that it is "improper[]" to "shift the burden of construing the claim term ... to the Board." *ams AG*, 2017 WL 1052498, at *3.

To institute on this Petition would set a dangerous precedent. A Petitioner could argue a single claim, with appropriate claim construction arguments under 37 C.F.R. § 42.104(b)(3), and consciously avoid the effort and cost of doing the required claim construction for every other challenged claim. Were the Board to permit such gamesmanship, it would eviscerate the Board's regulations to the contrary.

Institution would impose an impermissible burden on the Board and reward Petitioner's minimalist and insufficient Petition. The Board should not condone that type of gamesmanship and instead, deny the Petition.

CONCLUSION

For all of the foregoing reasons, the Petition should be denied in its entirety.

Date: March 13, 2025

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Preliminary Patent Owner Response totals 7,236 words, which is less than the 14,000 allowed under 37 C.F.R. § 42.24(b)(1).

Date: March 13, 2025

Respectfully submitted,

/s/ Daniel H. Shulman

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