

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 SUR-REPLY IN SUPPORT OF ITS PRELIMINARY
RESPONSE TO PETITION FOR INTER PARTES REVIEW OF U.S. PATENT
NO. 11,845,167

Case No. IPR2025-00264

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Kyocera Senco Industrial Tools Inc. (“Patent Owner”) hereby submits this sur-reply in response to the Reply of Petitioner, Koki Holdings America Ltd. (“Petitioner”) (ECF No. 8).

I. Petitioner’s Reply Implicitly Acknowledges the Failure of the Petition to Comply with 37 C.F.R. § 42.104(b)(3)

Petitioner failed to comply with the requirement that the Petition construe the claims terms on which its assertion of invalidity is based. *See* 37 C.F.R. § 42.104(b)(3).

Patent Owner did not offer its own claim constructions. Instead, Patent Owner showed how Petitioner’s arguments either *assumed* an unstated claim construction, or read the same claim term in conflicting or superfluous ways. (*See, e.g.,* Prel. Resp., ECF No. 7, pp. 15–21 (reading “lifter” on fundamentally different structures), 25–27 (applying an unstated construction of “not vented to the atmosphere” that permits some venting to the atmosphere), 21–25 (reading “removable top cap” and mutually exclusive structures), 27–28 (reading the “safety contact element” as the same element as a prior, different, claim limitation).

Petitioner’s insistence on filing a reply merely reinforces its failure. If the original Petition had properly included a claim construction, no reply would be necessary. Instead, however, Petitioner attacks Patent Owner’s criticism of Petitioner’s failure to construe the claims. That attack validates the very problem with the Petition: it contained no claim constructions. Petitioner’s Reply is an

implicit admission that it failed to comply with 37 C.F.R. § 42.104(b)(3), and supports Patent Owner's asserted grounds for denial.

II. Response to Petitioner's Arguments

A. "Lifter"

Patent Owner noted that, if "lifter" is subject to 35 U.S.C. § 112(f), then Petitioner must associate some element in the cited art with a structure in the specification, or state whether instead the element in the cited art is an equivalent to that structure. (ECF No. 7, Prel. Resp., 17–18.) Instead, Petitioner pointed to two different "lifters," Kondo and Lai, while saying that both are "essentially identical" to the "lifter" in the '007 Patent. Patent Owner showed, in its Preliminary Response, that Petitioner's argument could not be true. (*Id.*, 19–20 (comparing pictures of Lai and the '007 Patent).) Petitioner's Reply, however, does not address that inconsistency *at all*. It quotes two paragraphs of Lai, then merely concludes "Petition does likewise" for Kondo. (ECF No. 8, Koki Reply, 2.) But, identifying the structure in the prior art is the *second half* of the analysis. The *first half*, which Petitioner does not address, is to identify the structure in the specification, *i.e.*, to actually construe "lifter." It never does so.

B. "Not vented to the atmosphere"

Petitioner argues that Patent Owner's "construction is mistaken" because Patent Owner seeks to square the claim term with the fact that Kondo's gas leaks

amount to venting to the atmosphere. (ECF No. 8, Koki Reply, 3.) Petitioner then attempts to construe “not vented to the atmosphere” as differentiating between minor and significant leaks. (*Id.*) Petitioner’s attempt is too late. 37 C.F.R. § 42.104(b)(3) requires that construction to occur *in the Petition*, not after the failure to do so is pointed out.

C. “Removable top cap”

The “removable top cap” either refers to the whole air chamber, reading out any notion of a “cap” (in Haley, ECF No. 7, Prel. Resp., 22), or is some alternate, smaller and specific structure (in Saari/Enstrom, *id.* 24). Petitioner argues that since it pointed to a top cap in Haley, the term is not superfluous (ECF No. 8, Koki Reply, 3), missing the point that Petitioner’s argument is what *renders the claim term superfluous*. Petitioner also sees no “unstated construction” needing resolution. But, were Petitioner to concede the need for construction, it would admit it failed to comply 37 C.F.R. § 42.104(b)(3). If *some* construction reads “removable top cap” on both Haley *and* Saari/Enstrom, Petitioner must give it.

D. “Safety Contact Element”

Petitioner’s reply argues, Haley *has* a safety contact element (per some construction) (*id.* (“Haley’s safety contact element is at a front portion of the tool...”)), and Haley would need to be modified to include a safety contact element (*id.* (referring to the safety contact element of Lai).) It is not clear at all how Haley

can both have, and not have, a safety contact element, unless the one it does have is different from the phrase in the claim and the one in Lai is the same. Petitioner never explains, emphasizing its failure to comply with 37 C.F.R. § 42.104(b)(3).

III. Petitioner Must Be Bound by Its Editorial Choices

The Petition was 13,930 words, just shy of the 14,000 word limit. Petitioner *chose* not to provide the required claim constructions and to focus its arguments elsewhere. It must be bound by that choice. *Cf. Meta Platforms, Inc. v. VL Collective IP LLC*, IPR2023-00923, 2024 WL 4988333, at *38 n.13 (McKone, D., A.L.J., dissenting) (noting impropriety of allowing circumvention of word count because if Petitioner had originally included the argument, “it would have had to have foregone other arguments”).

IV. Conclusion

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

Date: April 1, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on April 1, 2025, PATENT OWNER'S SUR-REPLY IN SUPPORT OF ITS PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW was served by email on the following counsel for Petitioner:

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/s/ Daniel H. Shulman

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