

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIG SAUER INC.,
Petitioner,

v.

LONE STAR FUTURE WEAPONS, INC.,
Patent Owner.

Case No. IPR2025-00410
U.S. Patent No. 8,919,238

**PETITIONER'S RESPONSE TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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1002	Prosecution History of U.S. Patent No. 8,919,238 (“Prosecution History”)
1003	Declaration of John Nixon, EUR ING
1004	Curriculum Vitae of John Nixon, EUR ING
1005	U.S. Patent No. 2,223,004 (“Holek”)
1006	U.S. Patent No. 6,343,536 (“Rossier”)
1007	George M. Chinn, <i>The Machine Gun</i> , Vol. 5 (1987)
1008	Declaration of Dr. Sylvia D. Hall-Ellis
1009	Curriculum Vitae of Dr. Sylvia D. Hall-Ellis
1010	Attachment 1A to Declaration of Dr. Sylvia D. Hall-Ellis - Library of Congress MARC Record for Chinn
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Pursuant to the Acting Director’s Memorandum titled “Interim Processes for PTAB Workload Management” (Mar. 26, 2025) (the “Guidance Memorandum”), Petitioner SIG Sauer Inc. (“Petitioner”) submits this brief opposing Patent Owner Lone Star Future Weapons, Inc.’s (“Patent Owner”) Brief on Discretionary Denial (“Brief” or “Br.”) (Paper No. 8).

I. INTRODUCTION

As explained herein, Patent Owner fails to show that discretionary denial is appropriate in the present proceeding. *First*, discretionary denial is not appropriate under 35 U.S.C. § 325(d) because two of the three prior art references relied upon in the Petition—Holek and Chinn—were not considered by the examiner during prosecution of the ’238 Patent. Although the third reference, Rossier, was considered during prosecution, as the Petition explained, the examiner misread the clear teachings of the reference. Further, Rossier is not cited in two of the five asserted grounds.

Second, Patent Owner identifies a hodgepodge of alleged additional considerations that it argues further support discretionary denial, but closer analysis of each demonstrates that discretionary denial is not appropriate under any of these alleged considerations. Patent Owner argues that “settled expectations of the parties” favors denial. However, Patent Owner has already engaged in foreign litigation on a foreign counterpart to the ’238 Patent and has engaged in actual and

threatened litigation in this country. As such, Patent Owners own activities establish that there are no such settled expectations between the parties. Patent Owner also criticizes the prior art as not substantively disclosing certain limitations, but these criticisms cherry-pick and ignore the clear teachings against Patent Owner's criticisms from the surrounding text of the prior art and from the '238 Patent. Patent Owner attempts to criticize the similarity between the evidence and argument in Petitioner's expert declaration and the Petition as being "conclusory," but Patent Owner fails to present even a single example of any argument that is unsupported or conclusory in the Petition. Patent Owner argues that the rising pendency *ex parte* appeals generally justifies discretionary denial, but there are no specific reasons cited by Patent Owner for discretionary denial in this proceeding beyond Patent Owner's erroneous criticisms of the prior art references. None of these alleged additional considerations justifies discretionary denial.

Third, Patent Owner argues that discretionary denial should be granted under 35 U.S.C. § 314(a) and under the six *Fintiv* factors. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*"). However, in the co-pending District Court litigation, validity of the '238 Patent is not presently at issue because only a declaratory judgment claim of non-infringement has been asserted in the co-pending litigation. In fact, the Patent

Owner has moved to dismiss Petitioner's claim in the District Court for lack of subject matter jurisdiction. Additionally, the co-pending litigation is still in early stages, and even if validity of the '238 Patent was eventually at issue in the District Court litigation, addition of invalidity to the case could potentially delay the District Court's schedule. The *Fintiv* factors, therefore, weigh strongly against discretionary denial for at least this reason.

Finally, at least one additional consideration weighs in favor of institution in this proceeding. The '238 Patent has not yet been subject to any challenge to validity, either in the Patent Office in an *inter partes* review or to an *ex parte* reexamination. Further, as already stated, validity is not at issue in the co-pending District Court litigation. As such, that the validity of the '238 Patent has not yet been challenged in any post-issuance proceeding weighs in favor of institution.

II. § 325(D) DOES NOT FAVOR DISCRETIONARY DENIAL OF INSTITUTION

Advanced Bionics provides a two-part framework for evaluating whether denial under Section 325(d) is warranted: (1) whether the same, or substantially the same, prior art or arguments were previously presented to the Office; and (2) if the first prong is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. *See, e.g., Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate Gmbh*, IPR2019-

01469, Paper 6 at 7–8 (PTAB Feb. 13, 2020). In making this factual inquiry, the Board weighs the six *Becton, Dickinson* factors:

- a) the similarities and material differences between the asserted prior art and the art from the earlier examinations;
- b) the cumulative nature of the asserted prior art and the art evaluated during the earlier examination;
- c) the extent to which the currently-asserted art was evaluated during the earlier examination;
- d) the extent of the overlap between arguments in the current and earlier proceedings;
- e) whether a petitioner has explained how the Patent Office erred when evaluating the art in the earlier proceeding; and
- f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the earlier-asserted art and arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017).

However, in the present case, neither the Holek reference nor the Chinn reference were considered by the examiner during prosecution of the '238 Patent. More specifically, Grounds 1 and 4 presented in the Petition, relating to

anticipation by the Holek alone (Ground 1) and to obviousness by the Holek combined with Chinn (Ground 4) do not involve any references that were considered by the examiner during prosecution of the '238 Patent. As such, there is no reason to move beyond the first step of *Advanced Bionics* because the Holek and Chinn references were not substantively considered during prosecution of the '238 Patent.

Second, although Rossier (cited only in Grounds 2, 3, and 5) was cited by the examiner during prosecution of the '238 patent, Petitioner explicitly explained in the Petition that the Board should consider Rossier in this proceeding for two reasons. Pet. at 8-9. During prosecution, the applicant argued that Rossier failed to disclose the limitation in the '238 Patent requiring that “the op-rod assembly and the bolt assembly [being] locked to the barrel extension during the firing condition.” EX1002 at 171. However, under a proper reading, Rossier describes a rotating bolt, which is rotated by the axial displacement, and closes the firing chamber before the shot is fired, thereby locking the op-rod assembly and the bolt assembly to the barrel extension during the firing condition. EX1006 at 5:31-46. Because the examiner during prosecution of the '238 Patent failed to consider this teaching in Rossier, the examiner “erred in a manner material to the patentability of the challenged claims.” *Medacta USA, Inc. v. RSB Spine, LLC*, IPR2020-00264, Paper 24 at 16 (PTAB May 22, 2020); Pet. at 9. Further, as noted in the Petition,

because Rossier was distinguished only on the basis of the addition of this one additional limitation in independent claim 13, Rossier should be considered for purposes of showing invalidity of other claim limitations, including the other limitations of claim 13, the limitations of claim 1, and the limitations in the dependent claims. *Id.*

A. The Examiner Did Not Consider the Same or Substantially the Same Art Asserted in Grounds 1 and 4 During Prosecution

Patent Owner does not argue that Holec (Grounds 1 and 4) or Chinn (Ground 4) were substantively considered by the examiner during prosecution of the '238 Patent. Nor does Patent Owner argue that these references were cited at any point during prosecution of the '238 Patent. Br. at 19-20, 25-26. Rather, Patent Owner asserts that Holec and Chinn are cumulative. Br. at 19-20, 25-26. However, as shown below, Patent Owner's assertion that Holec and Chinn are cumulative is incorrect.

B. Holec Was Not Considered During Prosecution and is Non-Cumulative

Patent Owner's arguments that Holec is cumulative of U.S. Patent No. 4,475,438 ("Sullivan", EX2003) are conclusory and substantively unexplained. Br. at 19-20. Indeed, Petitioner's primary argument that Holec is cumulative is the collateral observation that Holec issued in 1940. However, Patent Owner cites no authority or evidence explaining why longstanding art such as Holec should be

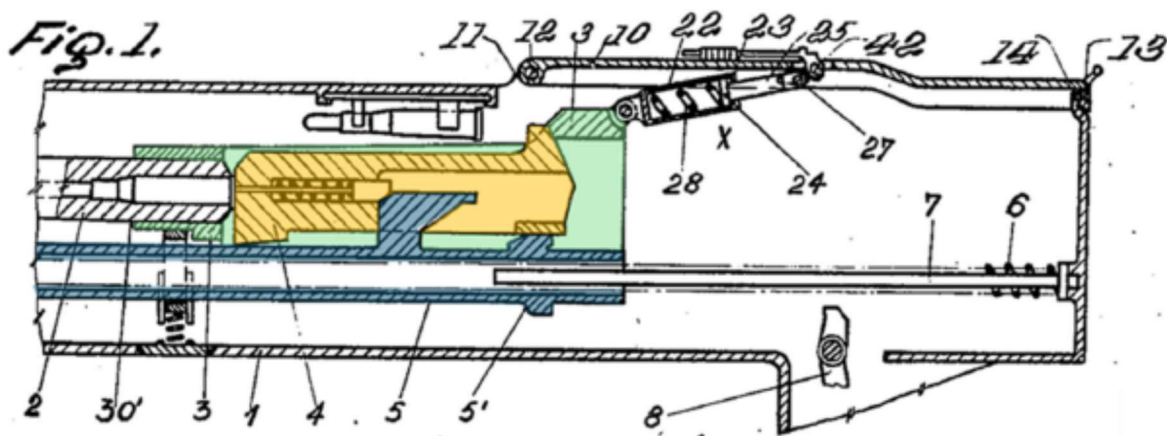
given less weight than other art. To the contrary, the Board has provided in some cases greater deference to ancient art than is given to newer art. *See, e.g., Arista Networks, Inc. v. Cisco Systems, Inc.*, IPR2016-00303, Paper 53 at 18 (PTAB May 25, 2017) (recognizing the hearsay exception for ancient documents and applying that exception to prior art having a copyright date greater than 20 years). Patent Owner also argues, conclusorily, that Holek is less relevant than Sullivan. Br. at 19-20. However, Patent Owner's citation of Sullivan identifies only a single element in the '238 Patent relating to the impulse of a fired round "stopping the forward momentum of the operating group." *Id.* Further, the Sullivan reference, although identified in an IDS, was not substantively discussed by the examiner during prosecution of the '238 Patent. EX1002 at 106. Additionally, even if the Board were to credit Patent Owner's argument, this argument in fact further illustrates the invalidity of the '238 Patent by further disclosing the limitation identified by Patent Owner within the prior art; that an element is ubiquitous in multiple prior art references points towards invalidity, not away.

In sum, Patent Owner's conclusory assertions that Sullivan, a reference not substantively discussed during prosecution of the '238 Patent, is cumulative of Holek, is incorrect and, if anything, Patent Owner's own argument further establishes invalidity of the '238 Patent.

C. Patent Owner's Arguments that Holek Fails to Teach Certain Limitations of the '238 Patent Misstates and Ignores the Teachings of Holek

Patent Owner attempts to improperly shoehorn its substantive arguments from Patent Owner's Preliminary Response that Holek fails to teach certain limitations of the '238 Patent into Patent Owner's discretionary denial brief. Br. at 20-24. However, proper consideration of the teachings of Holek and of the '238 Patent demonstrate that Patent Owner's arguments are without merit.

First, Patent Owner attempts to argue that Holek fails to disclose the limitation of claim 1 relating to the impulse of a fired round stopping the forward momentum of the casing 3, breech block 4, and breech-block carrier 5 depicted in Holek. Br. at 21-22.



EX1005, Fig. 1 (annotated)

Patent Owner essentially argues that Holek teaches that the forward movement of a fired round in Holek is not stopped because Holek teaches that “the

energy of the parts which are moving forward overcomes the energy of the recoil resulting from the firing.” Holek (EX1005), p. 2, col. 2, ll. 42-45; Br. at 22.

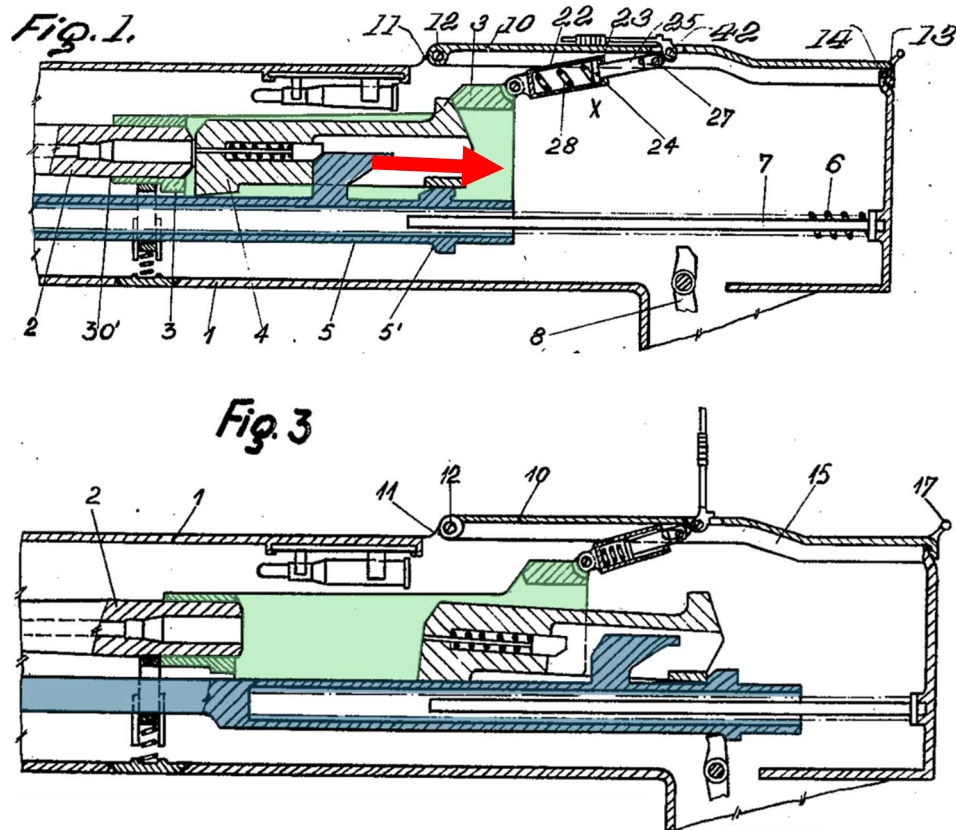
However, Patent Owner is inappropriately cherry-picking the explicit text of Holek, because the *very next sentence* recites that “[t]he barrel with the casing of the breech mechanism recoil *without reaching the foremost fixed stops*.” EX1005, p. 2, col. 2, ll. 45-47 (emphasis added). Plainly, Holek’s teaching that the barrel with the casing “recoil[s] without reaching the foremost fixed stops” necessarily teaches that the forward momentum of the barrel with the casing is at some point stopped prior to reaching the fixed stops by the impulse of the fired round. In other words, if Patent Owner’s argument that Holek does not teach that the forward momentum of the casing, breech block, and breech-block carrier is not stopped were true, then that group would *necessarily* make contact with the *foremost fixed stops*, contrary to Holek’s explicit teaching to the contrary. Patent Owner’s argument improperly attempts to read a single sentence from Holek in isolation and to misconstrue the teaching of the reference while ignoring the surrounding text which of Holek, which plainly discloses that Patent Owner’s argument is wholly incorrect.

Second, Patent Owner attempts to argue that Holek does not disclose “an operating rod (op-rod) assembly at least partially housed and arranged to axially translate within the barrel extension in the charged condition,” as recited in claim 1

of the '238 Patent. Br. at 22-24. Patent Owner argues that Figure 3 of Holec depicts the charged condition. However, Patent Owner's interpretation is incorrect because Figure 3 illustrates the beginning of the firing condition, not the charged condition. More specifically, claim 1 of the '238 Patent recites "an operating group configured to operate the weapon system *through a charged condition*, a firing condition, and a recoil condition." EX1001, cl. 1 (emphasis added). As the text of claim 1 itself discloses, a charge condition represents a condition that the operating group moves through, *i.e.*, the condition in which in which the operating group is being charged.

This understanding that the charged condition represents the condition in which the operating group is being charged (*i.e.*, the process of retracting the operating group) is consistent with other portions of the '238 Patent. For example, the '238 Patent describes, "drive spring 670 ... engages and biases the op-rod assembly 370 forward such that the op-rod assembly 370 may be *translated in a rearward direction to charge the weapon system and initiate the firing cycle.*" EX1001 at 9:57-62. *See also id.* at 1:45-47 ("The weapon system includes a receiver and an operating group configured to operate the weapon system *through a charged condition*"); 8:4-7 ("The charging handle 371 enables an operator to translate the op-rod assembly 370 in a *rearward direction to charge the weapon system 10 in preparation for firing*").

The process of moving through the charging condition is illustrated in Holek with the operating group moving between the depictions in Holek Figure 1 to Holek Figure 3. The operating rod assembly of Holek (highlighted in blue in Fig. 1, below) moves axially within the barrel extension (highlighted in green) between the various operating states (loaded, firing, recoiling) as further illustrated in Figures 1 and 3.



Holek, Figs. 1, 3 (annotated)

More specifically, the axial movement of this operating rod assembly (blue) moves within the barrel extension (green), which is illustrated through the

comparison of Figure 1 to Figure 3. EX1005 at Figs. 1, 3. It is shown above that the upwardly projecting element of the operating rod assembly moves within the barrel extension as the operating rod moves through the charged condition. In other words, as the operating rod is being charged, this upwardly projecting element is moving through the barrel extension as Holek transitions through the charged condition to the firing condition.

Accordingly, Patent Owner's arguments that Holek fails to teach these elements is inconsistent with the teachings of Holek and the '238 Patent and is therefore substantively incorrect. Nor is there any indication that the examiner considered any such argument during prosecution of the '238 Patent, particularly since Holek was not considered by the examiner during prosecution of the '238 Patent.

D. Chinn Was Not Considered During Prosecution and is Non-Cumulative

Like Holek, Chinn was also not disclosed during prosecution of the '238 Patent. Patent Owner argues that both Chinn and Rossier disclose "rotatable locking bolts." Br. at 25. However, Patent Owner does not dispute that rotatable locking bolts were well-known before Chinn and the critical date of the '238 patent. *Id.* Rather, Patent Owner essentially argues that both Rossier and Chinn disclose such known rotatable locking bolts. *Id.* Nor does Patent Owner dispute

that a person of ordinary skill in the art would have been aware of such rotatable locking bolts. *Id.* at 26. Critically, Patent Owner does not dispute that a person of ordinary skill in the art would not have realized that Holek could have been modified to include such well-known rotatable locking bolts. Again, multiple prior art references dealing with nearly identical systems including the same element points away from patentability based upon that element.

Petitioner asserts, without citation, that the rotatable locking bolts in Rossier were considered by the examiner during prosecution. Br. at 26. However, during prosecution, there was no dispute regarding whether or not the prior art disclosed rotatable locking bolts. Further, the consideration during prosecution was not whether or not Rossier discloses rotatable locking bolts, but rather whether Rossier discloses the bolt assembly being locked to the barrel extension during firing. EX1002 at 170. The features addressed in Chinn, more specifically, relate to features described in dependent claims 5-13 and 17. Pet. at 60-66, 68-71. As such, there is no substantive dispute that rotatable locking bolts are well-known and, at minimum, the presence or absence of these elements from these dependent claims in the prior art was not considered during prosecution of the '238 Patent.

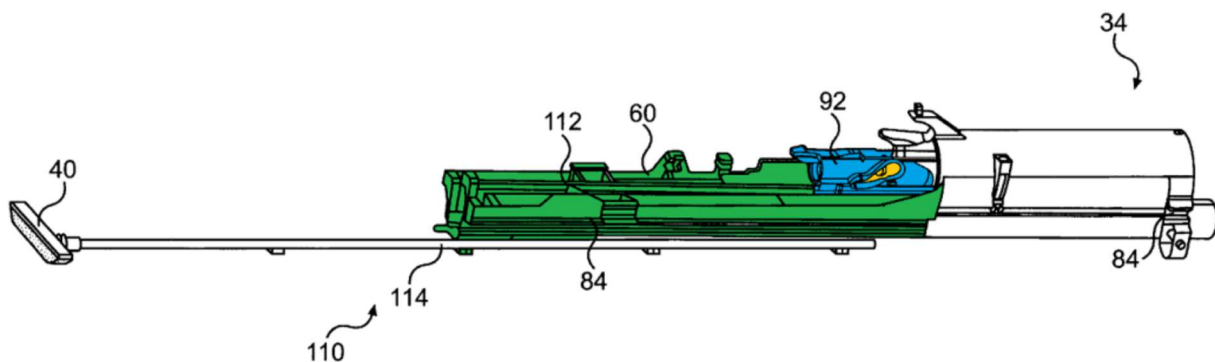
E. Rossier—Which Is Only Relevant to Grounds 2, 3, and 5--Was Considered During Prosecution but the Examiner Misread It

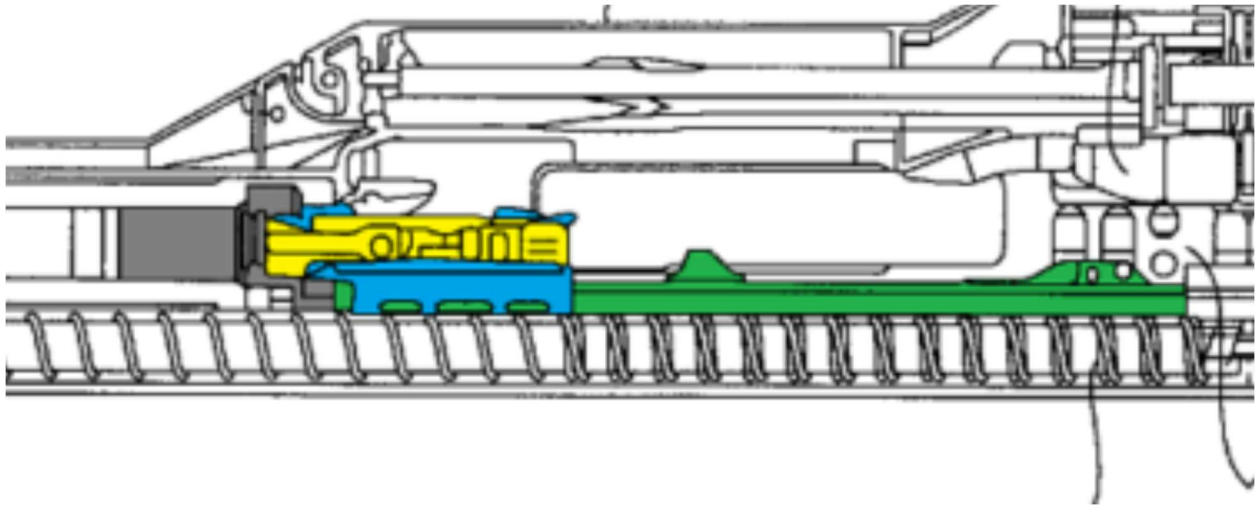
As previously discussed, although Rossier was cited by the examiner during prosecution of the '238 Patent, the Petition explains that the Board should consider Rossier in this proceeding for two reasons. Pet. at 8-9. First, during prosecution, the applicant argued that Rossier failed to disclose the limitation in the '238 Patent requiring that “the op-rod assembly and the bolt assembly [being] locked to the barrel extension during the firing condition.” EX1002 at 171. However, as explained in the Petition, Rossier describes a rotating bolt, which is rotated by the axial displacement, and closes the firing chamber before the shot is fired, thereby locking the op-rod assembly and the bolt assembly to the barrel extension during the firing condition. Pet. at 8 (citing EX1006 at 5:31-46). Because the examiner during prosecution of the '238 Patent failed to consider this teaching in Rossier, the examiner “erred in a manner material to the patentability of the challenged claims.” *Medacta USA, Inc. v. RSB Spine, LLC*, IPR2020-00264, Paper 24 at 16 (PTAB May 22, 2020); Pet. at 9.

Second, as also explained in the Petition, because Rossier was distinguished only on the basis of the addition of this one additional limitation in independent claim 13, Rossier should be considered for purposes of showing invalidity of other

claim limitations, including the other limitations of claim 13, the limitations of claim 1, and the limitations in the dependent claims. Pet. at 9.

Furthermore, Patent Owner actually concedes that the dispute during prosecution revolved around whether or not Rossier discloses that “the op-rod assembly and the bolt assembly are not locked to the barrel extension during the firing condition. Rossier fails to disclose any such locking mechanism.” Br. at 12 (quoting EX1002, 171). Patent Owner fails to overcome the fact that Rossier plainly discloses a bolt assembly (yellow in the figures below) and an op-rod assembly (blue in the figures below) depicted as being located within, and locked to, the barrel extension (green in the figures below). Br. at 12.

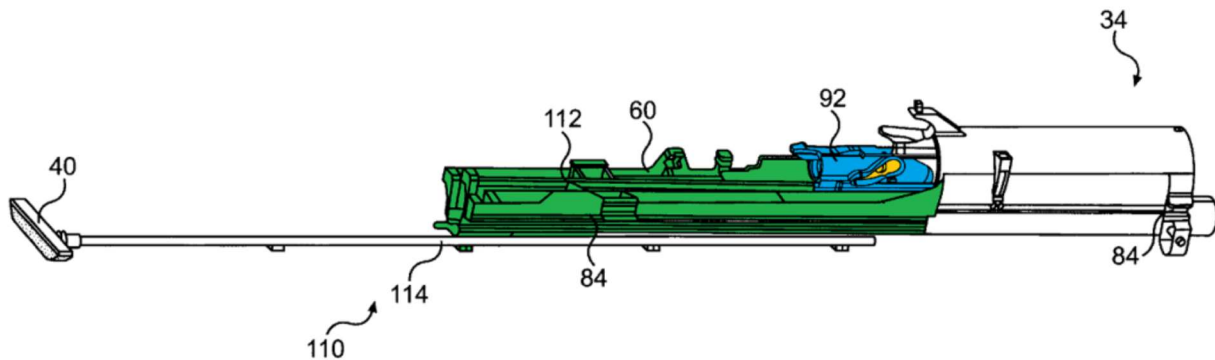




EX1006, FIGS. 6, 11 (annotated)

Patent Owner appears to re-construe this limitation as requiring that the front of the op-rod assembly and the bolt assembly contact the barrel extension directly, *i.e.*, at the front. However, there is no such requirement in the plain text of claim 1, which states “the op-rod assembly and bolt assembly are locked to the barrel extension” and does not specify that the locking be at the forward-most point of the op-rod assembly and the bolt assembly. Rather, as depicted in Fig. 11, these structures are explicitly locked to the barrel extension laterally, as explicitly illustrated in Fig. 11. The specification of Rossier further confirms this relationship, stating, in its description of Fig. 11, that “[t]he bolt assembly 42 is in its forward and locked position within the barrel extension 60.” EX1006 at 8:22-23. The teachings of Rossier substantively contradict Patent Owner’s attempted rewriting.

Still further, Patent Owner argues that Rossier does not disclose a bolt assembly “at least partially housed ... within [a] barrel extension.” Br. at 16. However, the depiction of Fig. 6, and indeed Patent Owner’s own description, concedes that the bolt assembly of Rossier “is housed within an op-rod assembly” and Patent Owner’s annotated Figure 6 depicts this bolt assembly (yellow) within the op-rod assembly (blue), which itself is depicted as being housed within the barrel extension (green).



EX1006, FIG. 6 (annotated)

There is, therefore, no dispute that the bolt assembly is housed within the barrel extension in Rossier. The only dispute is whether being housed within a structure which is, itself, housed within another structure is included. But the claims of the '238 Patent use open-ended transitional phrases and language indicating that the claim does not exclude additional elements or steps. *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, (Fed. Cir. 2004) (“like the term

‘comprising,’ the terms ‘containing’ and ‘mixture’ are open-ended.”). Moreover, the claims do not include any additional limiting language such as “housed directly” or “housed without any intermediate structure” that would indicate that indirect housing is not included within the claim language. As such, Patent Owner’s argument in fact further illustrates that the examiner misapplied Rossier during prosecution.

* * *

For all of these reasons, Patent Owner fails to show that § 325(d) is implicated for any of the references cited in the Petition, and the Director should deny Patent Owner’s request for discretionary denial on this basis.

III. PATENT OWNER FAILS TO IDENTIFY ADDITIONAL CONSIDERATIONS FAVORING DISCRETIONARY DENIAL

Patent Owner presents a hodgepodge of additional considerations that Patent Owner argues as supporting discretionary denial, but all are, in fact, without merit. First, Patent Owner argues that “settled expectations of the parties” favors denial, but ignores that Patent Owner has engaged in foreign litigation on a foreign counterpart to the ’238 Patent and has engaged in actual and threatened litigation in this country, demonstrating that the parties in fact have no such settled expectations. Second, Patent Owner attempts to criticize the references cited in the Petition, but these criticisms merely represent improper cherry-picking in isolation

from the references and ignore the clear teachings to the contrary from the references, as explained above for Holek and Rossier. Third, Patent Owner argues that the fact that Petitioner's expert's declaration and the Petition present the same arguments, and rely upon the same evidence, is improper. But Patent Owner fails to recognize that this is only improper when the opinions are conclusory, and Patent Owner identifies not even one specific argument which it contends to be unsupported or conclusory. Finally, Patent Owner argues that the backlog of *ex parte* appeals in the Patent Office justifies discretionary denial, but Patent Owner identifies nothing specific in the present proceeding to justify discretionary denial. As such, these arguments actually show that the present proceeding should be instituted.

A. Settled Expectations of the Parties, If Any, Do Not Warrant Discretionary Denial

Patent Owner cites the Acting Director's Guidance Memorandum and argues, because the '238 Patent issued just slightly over ten years ago at the time the Petition was filed, that the settled expectations of the parties favors discretionary denial. Br. 28-29. However, Patent Owner has only recently asserted a foreign counterpart of the '238 Patent in Germany, arguing infringement of the foreign counterpart involving similar claim language as found in the '238 Patent, but with some differences in scope as the '238 Patent. EX2004 at 17 (SIG

Sauer Answer and Counterclaim). Consequently, the potential assertion of the '238 Patent by Patent Owner has only recently been put at issue by Patent Owner, who has quietly slept on the '238 Patent for the majority of the '238 Patent's life. Patent Owner's dalliance in assertion of the '238 Patent is therefore the cause of any delay in the Petition for this proceeding, if any.

Furthermore, Patent Owner concedes that the lead inventor of the '238 Patent has been employed at SIG Sauer for nearly the entire period that the '238 Patent has been in force. Br. at 28. However, Patent Owner has only recently attempted to use actual and threatened lawsuits against SIG Sauer to unfairly compete against SIG Sauer for government contracts and other business. EX2004 at 17. Again, Patent Owner's dalliance is the entire source of any delay in bringing the Petition involved in the present proceeding, and the delay does not show any settled expectation between the parties. Still further, Patent Owner concedes that Petitioner is proactively seeking the present challenge because the Petition was filed even *before* Patent Owner has yet asserted the '238 Patent affirmatively in this country. Br. at 29. This further demonstrates the lack of any settled expectations between the parties.

Finally, Patent Owner presents a tangled argument that a second IPR recently filed by Petitioner against another patent owned by Patent Owner supports Patent Owner's "settled expectations" theory. Br. at 30. However, Patent Owner's

recent activities formed the impetus for Petitioner to investigate this second patent, which led Petitioner to learn of the low quality of the patent (U.S. Patent No. 8,561,543) involved in this second proceeding (IPR2025-00861). As such, this second proceeding also demonstrates the lack of any alleged “settled expectations” by the parties.

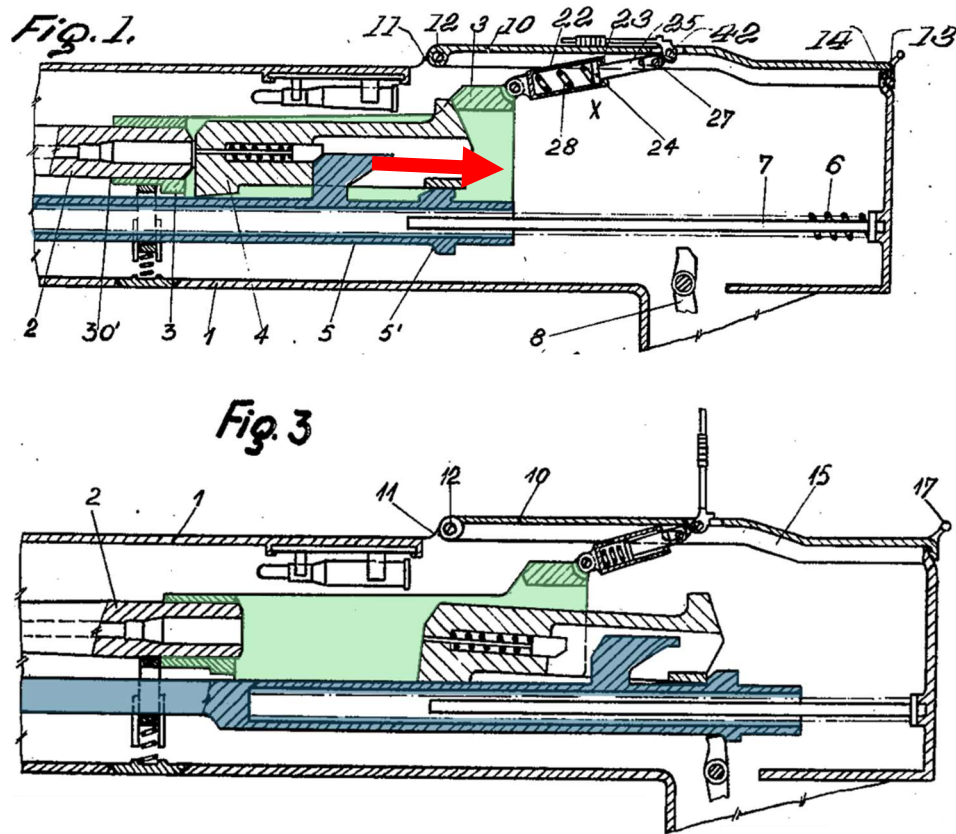
B. The Strength of Petitioner’s Patentability Challenges Supports Institution, Not Discretionary Denial

The grounds presented in the Petition are based upon three references which involve straightforward readings of references in the mechanical arts, more specifically, references involving automatic weapons. In the petition, Petitioner relies upon both anticipation and obviousness combinations, especially based upon the previously uncited Holek prior art reference as well as the Rossier prior art reference. Patent Owner attempts to substantively challenge the teachings of these references, repeating arguments from Patent Owner’s preliminary response, but these challenges to the technical teachings of the references fail for the reasons stated above. *Supra* at II.C and II.E.

Patent Owner first argues that Holek fails to disclose an “impulse of the fired round stops the forward momentum of the operating group,” as recited in the ’238 Patent. Br. at 31-32. However, as explained above in Section II.C, which is briefly reiterated again here but which is presented more fully above, Patent Owner

inappropriately cherry-picks from Holek because Holek recites that “[t]he barrel with the casing of the breech mechanism recoil *without reaching the foremost fixed stops.*” EX1005, p. 2, col. 2, ll. 45-47 (emphasis added). Holek’s teaching that the barrel with the casing “recoil[s] without reaching the foremost fixed stops” explicitly teaches that the forward momentum of the barrel with the casing is at some point stopped prior to reaching the fixed stops by the impulse of the fired round, contrary to Patent Owner’s flawed theory. Patent Owner’s purported validity argument is thus explicitly contradicted by the surrounding text in Holek from the very text Patent Owner relies upon in presenting its deficient argument.

Patent Owner also argues that Holek does not disclose “an operating rod (op-rod) assembly at least partially housed and arranged to axially translate within the barrel extension in the charge[d] condition,” as recited in the ’238 Patent. Br. at 32. Not so. As also explained above in Section II.C, which is also briefly reiterated again here but which is presented more fully above, Patent Owner’s argument is incorrect because Figure 3 of Holek, relied upon by Patent Owner, illustrates the beginning of the firing condition, not the charged condition. Rather, as illustrated in Holek, a “charge condition” represents the condition that the operating group moves though as it moves between the illustration in Holek Figure 1 and Holek Figure 3, *i.e.*, the condition in which in which the operating group is being charged.



Holek, Figs. 1, 3 (annotated)

As illustrated in the transition between the above figures, the movement of the operating rod assembly (blue) moves within the barrel extension (green). EX1005 at Figs. 1, 3. As shown, the upwardly projecting element of the operating rod assembly moves within the barrel extension as the operating rod moves through the charged condition. Patent Owner's argument is therefore inconsistent with Holek and is incorrect.

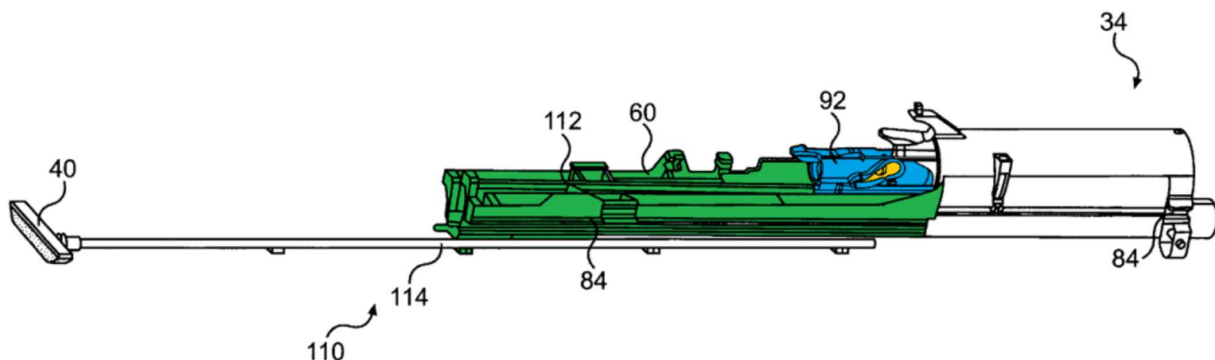
Patent Owner also argues that Rossier does not disclose an "op-rod assembly and bolt assembly [being locked/secured] to the barrel extension" during the

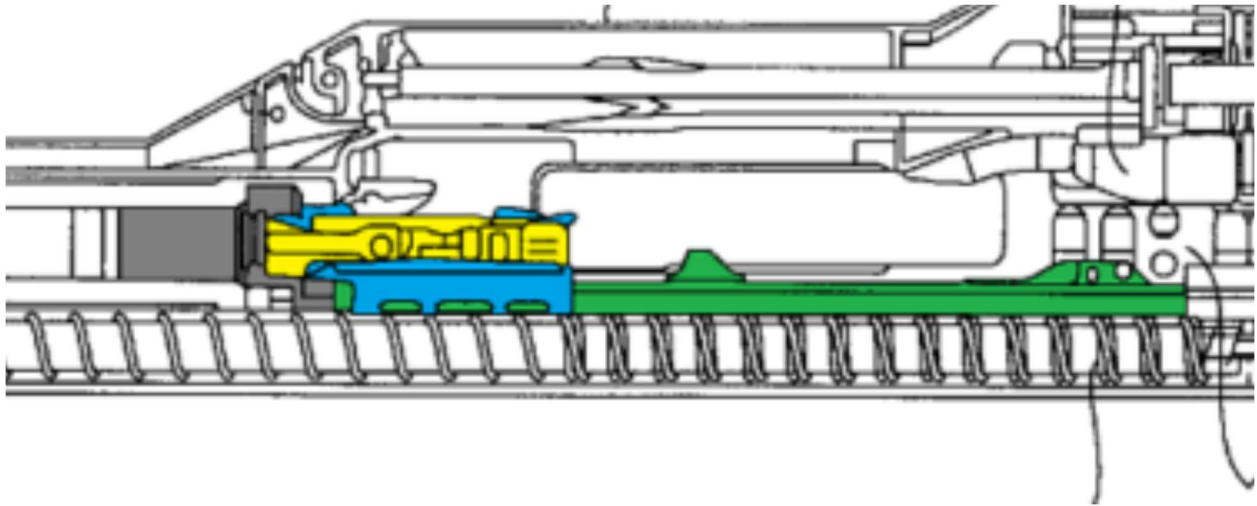
“firing condition,” as recited by the claims as recited in the ’238 Patent. Br. at 32.

However, as explained above in Section II.E, which is further briefly reiterated again here but which is presented more fully above, Patent Owner’s argument is incorrect because Patent Owner’s argument is premised upon re-construing this limitation as requiring that the front of the op-rod assembly and the bolt assembly contact the barrel extension directly, *i.e.*, at the front. The ’238 Patent does not require that the recited locking to the barrel extension (green) be at the forward-most point of the op-rod assembly (blue) and the bolt assembly (yellow). Rather, as depicted below, these structures are locked to the barrel extension laterally.

Rossier’s specification confirms this relationship, explaining that “[t]he bolt assembly 42 is in its forward and locked position within the barrel extension 60.”

EX1006 at 8:22-23.





EX1006, FIGS. 6, 11 (annotated)

Finally, Patent Owner argues that the Petition fails to show a reasonable expectation of success for its obviousness combinations. Br. at 34-35. However, Patent Owner does not dispute that all references are explicitly directed to automatic weapons existing in the predictable field of the mechanical arts. Nor does Patent Owner dispute that the three references include substantially similar structures representing, for example, operating rod assemblies, barrel extensions, and bolt assemblies. *Id.* Most importantly, Patent Owner does not actually identify any specific differences in the systems depicted and described in the Holek, Rossier, and Chinn references which would present any significant difficulties in making any of the identified combinations, nor any specific reason why a skilled artisan would not have a reasonable expectation of success,

especially given that the references are directed to an area within the predictable mechanical arts field of technology.

C. The Petition was Drafted Contemporaneous with, and in Reliance upon, Mr. Nixon’s Expert Declaration, and the Similarities between the Documents Reflects the Straightforward Technology of the References and the Support Presented for the Underlying Arguments

Patent Owner argues, because Mr. Nixon’s declaration and the Petition present the same evidence and arguments that are presented in the Petition, that the Petition and declaration are therefore somehow deficient. However, Patent Owner’s argument ignores that the regulations require that “[a]rguments must not be incorporated by reference from one document into another document.” 37 CFR § 42.6(a)(3). Consequently, the fact that Mr. Nixon’s declaration and the Petition present the same arguments and underlying evidence is not surprising given that the Petition and Mr. Nixon’s declaration are meant to present the same arguments and explain the same evidence cited from the underlying references to the Board in order to fully explain the challenges presented in the Petition. Nor are any such similarities surprising given that the Petition was prepared based upon Mr. Nixon’s declaration and in consultation with Mr. Nixon, also during the preparation of his declaration.

The prior *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (P.T.A.B. Aug. 24, 2022) (precedential) decision cited by Patent Owner (Br. at 35-

36) is readily distinguishable because although, as stated, the Petition and Mr. Nixon's declaration present the same arguments and explanations, critically, these arguments and explanations are *not conclusory* but instead provide *detailed citations and explanations* of the underlying references. Further, Patent Owner identifies no *specific* arguments within either the Petition or Mr. Nixon's declaration that are unsupported or conclusory. Indeed, in *Xerox*, the Board substantively considered the underlying reference, but determined that the reference substantively failed to disclose the challenged limitation. *Xerox*, Paper 9 at 13-15. Because Patent Owner fails to show or explain how either the Petition or Mr. Nixon's declaration rely upon unsupported or conclusory opinion without providing the underlying evidence and argument, Patent Owner's argument is without merit.

D. The Board's Resources Are Properly Spent on Challenges Presenting Compelling Arguments Like Those in the Petition

Patent Owner argues that the Board's resources should be spent on *ex parte* appeals as opposed to the present proceeding. Br. at 37-39. Although Patent Owner does not dispute that keeping *ex parte* appeal times low is a worthy goal, that goal must also be balanced against the legislative intent underlying the creation of the *Inter Partes* Review procedure, which identified "a growing sense that questionable patents are too easily obtained and are too difficult to challenge."

H.R. Rep. No. 112-98 at 39. Moreover, the legislative intent further identified a goal of “providing a more efficient system for challenging patents that should not have issued; and reducing unwarranted litigation costs and inconsistent damage awards.” *Id.* at 39-40.

The present proceeding illustrates the need for such procedure. As explained above, Patent Owner has brought lawsuits asserting a foreign counterpart to the '238 Patent in Germany and has threatened and actually instituted a lawsuit against SIG Sauer domestically. EX2004 at 17. The present proceeding therefore represents Congress's desire to efficiently test the quality of the '238 Patent, as expressed in the legislative intent. This is particularly true where, as explained further below, the validity of the '238 Patent is not presently at issue in the co-pending District Court litigation between Petitioner and Patent Owner. *See infra* at IV. Patent Owner's only justification for declining institution is a vague, unexplained reference by Patent Owner to the Petition allegedly being “fundamentally flawed.” Br. at 39. However, as explained above, to the extent this refers to Patent Owner's technical criticisms of the prior art, these criticisms of Holek and Rossier represent improper cherry-picking in isolation from the references and ignore the clear teachings to the contrary from the references, which are actually consistent with the '238 Patent. *Supra* at II.C and II.E. There is, therefore, no specific reason the present Petition should be discretionarily denied

and, in fact, demonstrates that it should be instituted in order to resolve validity of the '238 Patent efficiently without the expense of full District Court litigation on the issue.

IV. *FINTIV* ANALYSIS DEMONSTRATES THAT DISCRETIONARY DENIAL IS NOT APPROPRIATE BECAUSE PATENT OWNER CONCEDES THAT PATENT OWNER HAS NOT ASSERTED THE '238 IN THE DISTRICT COURT LITIGATION

Under the Guidance Memorandum, the factors enumerated in the Board's precedential *Fintiv* decision form part of "all relevant considerations" that the Director and Board considers in determining whether to grant a request for discretionary denial. Guidance Memorandum at 2. Patent Owner argues that the *Fintiv* factors weigh in favor of a discretionary denial. As explained below, however, Patent Owner's *Fintiv* analysis fails to address all relevant considerations. In particular, Patent Owner's *Fintiv* analysis attempts to obfuscate that Patent Owner has not yet asserted the '238 Patent in the co-pending District Court litigation. Furthermore, taking account of the details of the pending District Court litigation, the progress of discovery, and the "other circumstances" enumerated above, a proper *Fintiv* analysis would not favor discretionary denial.

More specifically, in the co-pending District Court litigation, Petitioner filed a counterclaim asserting non-infringement of the '238 Patent. EX2004 at 16-26.¹ However, Petitioner has not presently asserted counterclaims of invalidity in the co-pending District Court litigation. Further, Patent Owner has not affirmatively asserted a claim of infringement of the '238 Patent in the co-pending District Court litigation. As such, the validity of the '238 Patent is not presently at issue in the co-pending District Court litigation. Consequently, the issues in the co-pending

¹ In the co-pending District Court litigation, Patent Owner has filed a motion to dismiss Petitioner's non-infringement counterclaim. In the event Patent Owner's motion to dismiss was granted by the District Court, then there would no longer be any co-pending proceeding at all concerning the '238 Patent. Patent Owner has therefore taken inconsistent positions by arguing to the District Court that Petitioner's counterclaim regarding non-infringement of the '238 Patent should be dismissed. However, in the present proceeding, Patent Owner attempts to utilize the current pendency of Petitioner's counterclaim, which Patent Owner seeks to dismiss, in order to argue that the Board should discretionarily deny institution of the present Petition. The District Court has not yet ruled upon Patent Owner's motion to dismiss Petitioner's non-infringement counterclaim.

District Court litigation are completely distinct at this point from the issues implicated in the present Petition.

A. Factor 1: Likelihood of a District Court Stay

Patent Owner asserts that no motion to stay has been filed in the co-pending District Court litigation. Br. at 40-41. However, a stay would not yet be appropriate in the co-pending District Court litigation because neither Petitioner nor Patent Owner has yet put the validity of the '238 Patent at issue in the co-pending District Court litigation. If and when validity becomes an issue in the co-pending District Court litigation, Petitioner would at that point determine whether or not to request a stay of the litigation. But, since validity of the '238 Patent is not yet at issue in the co-pending District Court litigation, a request for a stay would therefore be premature at this stage. Furthermore, in similar proceedings, the Board has declined to speculate whether a district court would grant a stay if the proceeding were instituted. *Ericsson Inc. v. Koninklijke KPN NV*, IPR2023-00581, Paper 8 at 9 (PTAB, Sep. 7, 2023) (“[n]either party identifies any statements by the District Court or other evidence that specifically address a stay of the District Court Litigation.... We decline to speculate based on the record in this case whether the District Court would grant a stay of the District Court Litigation”). In total, the fact that validity of the '238 Patent is not yet at issue in the co-pending

District Court litigation should weigh against discretionary denial in the present case, and, at minimum, the lack of a stay is no more than a neutral factor.

B. Factor 2: Proximity of Trial Date to the Projected Statutory Deadline

Patent Owner asserts that the trial in the co-pending District Court litigation weighs in favor of discretionary denial because the District Court's scheduling order has the co-pending litigation set to be ready for trial prior to the projected statutory deadline for issuing a Final Written Decision in this proceeding. Br. at 41. However, in *Fintiv* the Board stated that the reason the respective trial date and statutory deadlines would be relevant is because the institution decision would implicate "the resources that have been invested in the parallel proceeding." *Fintiv*, Paper 11 at 9. Since validity of the '238 Patent is not yet at issue in the co-pending District Court litigation, there is no reason at present to believe that any overlap in resources would be invested in the parallel proceedings. Additionally, the District Court's scheduling order has been issued based on the present composition of the co-pending District Court litigation, in which validity of the '238 Patent has not yet been put in issue by either party. If either party were to put validity of the '238 Patent at issue in the co-pending District Court litigation, the additional consideration of validity would assuredly implicate additional discovery and would almost certainly result in the co-pending District Court litigation being

ready for trial at a date later than the date currently set in the District Court's current scheduling order. As such, since validity of the '238 Patent is not yet at issue in the co-pending District Court litigation, the present proximity of any trial date to the projected statutory deadline actually weighs against discretionary denial in the present case, or, at most, is no more than a neutral factor.

C. Factor 3: Investment in the Parallel Proceeding

If, at the time of the institution decision, the district court has issued substantive orders related to the challenged patent, such as a claim construction order, this fact weighs in favor of denial. *See Fintiv*, Paper 11 at 10. In the co-pending District Court litigation, the District Court has not even set a date for any claim construction hearing for the '238 Patent. EX2009. Nor does Patent Owner identify any other decisions in the co-pending District Court litigation which Patent Owner asserts to be a substantive order related to the '238 Patent.

Instead, Patent Owner merely posits that the District Court's scheduling order provides for discovery deadlines, including the close of fact discovery, interrogatories, requests for production, requests for production, and fact witness depositions be completed near an anticipated institution decision in the current proceeding. Br. at 42. However, Patent Owner ignores that, because the co-pending District Court litigation presently does not involve validity of the '238 Patent, this discovery activity would at best only tangentially overlap with any

issue in the present proceeding. As such, Patent Owner's speculative invocation of discovery activity in the co-pending District Court litigation would not overlap with the issues involved in the present proceeding involving the validity of the '238 Patent. Indeed, Patent Owner concedes that "[b]ecause the validity of the '238 patent is not yet at issue in the district court, the parties have not yet exchanged any validity contentions." Br. at 42.

Further, Patent Owner argues, without evidence, that there is no indication that the District Court's schedule would change if invalidity were added to the District Court litigation. *Id.* However, given that Patent Owner has not asserted the '238 Patent in the co-pending District Court litigation and that validity of the '238 Patent is not presently at issue in the litigation, adding validity of the '238 Patent to the co-pending District Court litigation would likely impact the District Court's discovery deadlines as well as impact the District Court's ultimate trial date, particularly given upcoming discovery deadlines in the litigation.

Finally, Patent Owner does not contest that Petitioner acted diligently in preparing the Petition for the '238 Patent and in submitting it to the Patent Office. *See Fintiv*, Paper 11 at 11 ("If the evidence shows that the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution under *NHK*."). Indeed, Petitioner has acted promptly in submitting the Petition

expeditiously in the present case before being affirmatively accused of infringement in litigation.

In sum, the fact that validity of the '238 Patent is not yet at issue in the co-pending District Court litigation, combined with the early stage of proceedings in the litigation as well as Petitioner's promptness in submitting the present petition combine to weigh heavily against discretionary denial in the present case.

D. Factor 4: Overlap of Issues

There is no substantial overlap of issues in the present litigation and in the co-pending District Court litigation. *Fintiv* states, "if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial." *Fintiv*, Paper 11 at 12. "Conversely, if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution under *NHK*." *Id.* at 12–13. However, in the present case, there is no overlap of issues in the parallel proceedings. Rather, Petitioner has asserted a counterclaim in the co-pending District Court litigation seeking a declaratory judgment of non-infringement of the '238 Patent. EX2004 at 16-26 (SIG Sauer Answer and Counterclaim). Patent Owner has not yet affirmatively asserted the '238 Patent in the co-pending District Court litigation. Consequently, the issues involved in the present proceeding,

relating to the *validity* of the '238 Patent, are completely distinct from the issues involved in the parallel District Court proceeding, which includes a declaratory judgment counterclaim for *non-infringement* of the '238 Patent.

Moreover, even if there were overlap of issues, Petitioner would be allowed to file a *Sotera* stipulation in order to “mitigate[] any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential in relevant part). However, such a potential stipulation is not implicated at present because validity of the '238 Patent has not been put at issue by either party in the co-pending District Court litigation. If, in the future, validity of the '238 Patent was put in issue in the co-pending District Court litigation, Petitioner could then consider whether to file a *Sotera* stipulation to remove any potential overlap of issues for this factor. However, at present, such a stipulation is not necessary because determinatively there is no contemporaneous overlap between this proceeding and the co-pending District Court litigation on the issue of validity of the '238 Patent.

Because validity of the '238 Patent is not presently at issue in the co-pending District Court litigation, there is no overlap of issues in the present proceeding and the District Court litigation, which therefore weighs heavily against discretionary denial in the present case.

E. Factor 5: Whether Petitioner and the Defendant in the Parallel Proceeding are the Same Parties

“If a petitioner is unrelated to a defendant in an earlier court proceeding,” this may weigh against exercising discretion to deny institution. *Fintiv*, Paper 11 at 13–14. In the present proceeding, Petitioner is the defendant in the co-pending District Court litigation. However, Patent Owner is only one of several plaintiffs named in the co-pending litigation. But, in any event, as noted above, validity of the ’238 Patent is not presently at issue in the co-pending District Court litigation. As such, because validity is not at issue in the co-pending District Court litigation, this factor should still weigh against exercising discretion to deny institution or, at most, should be considered neutral.

F. Factor 6: Other Considerations, Including the Merits

As explained above and in the Petition, other circumstances favor institution, including the strength of the arguments and art presented in the Petition. *Supra* at Section II.C and II.E. Petitioner submits that such considerations should also weigh against exercising discretion to deny institution. *See Fintiv*, Paper 20 at 14.

V. VALIDITY OF THE ’238 PATENT HAS NOT BEEN PREVIOUSLY ADJUDICATED

The Acting Director’s Guidance Memorandum identifies another factor indicating that discretionary denial is not appropriate in the present proceeding because neither “the PTAB [n]or another forum has already adjudicated the

validity or patentability of the challenged patent claims.” Guidance Memorandum at 2. In the present proceeding, the ’238 Patent has not yet been subject to any challenge to validity, either in an *inter partes* review or in an *ex parte* reexamination. Moreover, although the parties are engaged in co-pending District Court litigation, validity of the ’238 Patent is not presently at issue in that litigation. *Supra* at IV. As such, there is no prior or contemporaneous challenge to validity of the ’238 Patent, which favors institution.

VI. CONCLUSION

For the foregoing reasons, Petitioner respectfully submits that the Board should deny the Patent Owner’s request for discretionary denial of institution.

Respectfully submitted,

DICKINSON WRIGHT PLLC

Dated: May 28, 2025

/ Steven R. Daniels /
Steven R. Daniels, Registration No. 45,345
Attorneys for Petitioner
SIG Sauer Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 28, 2025 true and correct copies of the foregoing PETITIONER’S RESPONSE TO PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL, and all associated exhibits, were served electronically on Patent Owner’s lead and backup counsel at PTAB@sternekessler.com and at the following addresses:

Jason A. Fitzsimmons (Reg. No. 65,367)
jfitzsimmons-PTAB@sternekessler.com
STERNE, KESSLER, GOLDSTEIN
& FOX PLLC
1101 K Street, NW, 10th Floor
Washington, DC 20005

Alexander V. Alfano (Reg. No. 74,298)
aalfano-PTAB@sternekessler.com
STERNE, KESSLER, GOLDSTEIN
& FOX PLLC
1101 K Street, NW, 10th Floor
Washington, DC 20005

Carson S. Smith (Reg. No. 81,053)
csmith-PTAB@sternekessler.com
STERNE, KESSLER, GOLDSTEIN
& FOX PLLC
1101 K Street, NW, 10th Floor
Washington, DC 20005

Jennifer Meyer Chagnon (Reg. No. 55,440)
jchagnon-PTAB@sternekessler.com
STERNE, KESSLER, GOLDSTEIN
& FOX PLLC
1101 K Street, NW, 10th Floor
Washington, DC 20005

Scott S. Maynard (Reg. No. 51,223)
scott@stecklerlaw.com
STECKLER WAYNE & LOVE
2720 Hillcrest Road
Dallas, Texas 75230

Gregory P. Love
(pro hac vice motion to be filed)
greg@stecklerlaw.com
STECKLER WAYNE & LOVE
107 E Main Street
Henderson, Texas 75652

Sean D. Burdick (Reg. No. 51,513)
BURDICK PATENTS
300 N. 6th Street, Suite 200
Boise, Idaho 83702
sean@burdickpatents.com

Dated: May 28, 2025

DICKINSON WRIGHT PLLC

/ Steven R. Daniels /

Steven R. Daniels, Registration No. 45,345
Attorneys for Petitioner
SIG Sauer Inc.

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION

This Response complies with the type-volume limitation in 37 C.F.R. § 42.24, and the Director's March 2025 Memorandum on Interim Processes for PTAB Workload Management. The Response contains 7,689 words, excluding the parts of the Response exempted from the type-volume limitation, as measured by the word processing software used to prepare the document.

This Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft Word in 14-point Times New Roman.

Dated: May 28, 2025

DICKINSON WRIGHT PLLC

/ Steven R. Daniels /

Steven R. Daniels, Registration No. 45,345
Attorneys for Petitioner
SIG Sauer Inc.