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

---

# PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

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

Petitioner's Reply does not salvage its deeply flawed Petition. Petitioner still fails to demonstrate a reasonable likelihood that any of the challenged claims of the '238 patent are unpatentable. The Reply arguments not only fail to redress the Petition's shortcomings, but further highlight the Petition's deficiencies.

## I. PETITIONER'S REPLY DEMONSTRATES ITS CONTINUED AND FUNDAMENTAL MISUNDERSTANDING OF HOLEK.

Petitioner argues that "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 and casing stop[] . . . due to the impulse of the fired round." Reply, 1 (quoting EX1005, p. 2, col. 2, ll. 45-47). But Petitioner misinterprets Holek, as the cited passage pertains to dampening the *rearward* momentum of its barrel and casing—not the *forward* momentum, as the claims recite.

In Holek, the disclosed "stops" refer to "stops 23" of "device x," a recoil "damping and returning device" hingedly connected to the barrel's casing. EX1005, p. 2, col. 1, ll. 12-18, 27; *id.*, p. 2., col. 2, ll. 56-58 (noting device x is for "the accumulation of energy and for braking the components that recoil back"). Holek consistently uses "stops" in the plural only when referring to device x's stops 23. *See* EX1005, p. 2, col. 1, ll. 25-31, 68; *id.*, p. 2, col. 2, ll. 45-47. Contextually, "stops" in the cited passage can only mean stops 23, as the

subsequent sentence discusses device x, and Holek's purported novelty centers on this device. EX1005, p. 2, col. 2, ll. 47-58; *id.*, p. 1, col. 1, ll. 30-40.

Accordingly, when Holek states that "[t]he barrel with the casing . . . recoil without reaching the foremost fixed stops," it means these components, linked to device x, recoil without causing parts like piston 24 and spring 28 to bottom-out against device x's stops 23. EX1005, p. 2, col. 2, ll. 45-47; *id.*, p. 2, col. 1, ll. 12-18, 25-31. This aligns with the *very next sentence*, which explains that the "recoil energy" avoids "harmful blows" because "spring 28 of the device x is sufficient for the accumulation of energy and for braking the components that recoil back." EX1005, p. 2, col. 2, ll. 47-58.

Petitioner's mischaracterization of Holek's disclosure reflects a fundamental misunderstanding of its teachings. Holek does not disclose that the forward momentum of the barrel and casing stop due to the impulse of the fired round. Thus, Petitioner's Holek grounds fail.

## II. PETITIONER'S REPLY INTRODUCES A FLAWED, IMPERMISSIBLE, AND SELF-CONTRADICTING CLAIM CONSTRUCTION.

In its Reply, Petitioner argues *for the first time* that the "charged condition" in claim 1 of the '238 patent "represents a condition that the operating group moves through, i.e., the condition in which the operating group is being charged."

Reply, 2. This new claim construction is flawed, impermissible, and internally inconsistent for the following reasons.

*First*, claim 1 of the ’238 patent itself plainly defines the “charged condition” as a static condition where “the op-rod assembly and the bolt assembly are retracted against the drive spring.” EX1001, 17:31-32. This definition is consistently reinforced throughout the specification. *See, e.g.*, EX1001, 1:62-63 (“In the charged condition, the op-rod assembly and the bolt assembly are retracted against the drive spring.”), 10:44-45 (“The position depicted in FIG. 18B may be considered a charged condition.”), 16:3-4 (“The gas accelerator should supply enough energy to return the op-rod to a charged position.”). Even Petitioner’s own citations confirm that the charged condition is static, as they describe translating the op-rod to *charge* the weapon system to the *charged condition*. *See* Reply, 2.

*Second*, Petitioner’s contention that “through” in the phrase “through a charged condition, a firing condition, and a recoil condition” modifies only the “charged condition” distorts the plain and ordinary meaning of claim 1. *See* Reply, 2. If “through” applied only to the “charged condition,” the “firing condition” and “recoil condition” would have no operative meaning within claim 1.

*Third*, Petitioner’s newly-provided construction creates an impermissible overlap between the “recoil condition” and the “charged condition,” as both would involve rearward movement of the operating group. *See* EX1001, 17:41-47. Thus,

Petitioner's interpretation violates established claim construction principles, exemplified by the Federal Circuit's repeated caution against rendering claim language superfluous. *See, e.g.*, *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 810 (Fed. Cir. 2021) ("It is highly disfavored to construe terms in a way that renders them void, meaningless, or superfluous.")

Petitioner's new construction also contradicts its earlier interpretation in this proceeding, where both Petitioner and its declarant Mr. Nixon equated the "charged condition" with a static "loaded" state (i.e., where the trigger can be pulled to initiate firing) and relied on the op-rod and bolt assemblies being statically retracted against the drive spring in all asserted Grounds. Pet., 14-15 ("The operating rod assembly of Holek . . . is configured to move axially within the barrel extension . . . between the various operating states (loaded, firing, recoiling)."), 20, 43 ("Rossier discloses a charged condition in which the bolt assembly and the operating rod assembly are retracted against a drive spring"); EX1003, ¶48.

Finally, by introducing a proposed construction for the first time in its Reply, Petitioner impermissibly ignores the Board's established rules of procedure. *See* PTAB Consolidated Trial Practice Guide, p. 45, USPTO (Nov. 2019) (Petitioner "cannot raise new claim construction issues that were not previously raised in its petition.").

## III. PETITIONER'S REPLY REHASHES UNSUCCESSFUL ARGUMENTS FROM PROSECUTION REGARDING ROSSIER.

Petitioner alleges that Patent Owner has re-construed the '238 patent's requirement that "the op-rod assembly and the bolt [being] locked to the barrel extension during the firing condition" to mean that "the front of the op-rod assembly and the bolt assembly contact the barrel extension directly." Reply, 4. Additionally, Petitioner frames the dispute over the claim limitation that the bolt assembly be "at least partially housed . . . within the barrel extension," as whether this covers a structure housed within another structure. Reply, 5. Petitioner's incorrect assertions merely rephrase arguments previously raised and rejected during prosecution.

*First*, Patent Owner has not re-construed the claim, but has responded to Petitioner's erroneous assertion that the front of Rossier's bolt body 96 locks to barrel extension 60 via barrel lugs 89. *See* Pet., 44; *but see* POPR, 19-22. As shown in Patent Owner's annotations of Rossier's Figure 11, *no part* of bolt body 96 contacts the barrel extension 60. POPR, 21. Therefore, bolt body 96 cannot be *locked to* Rossier's barrel extension, as the claims recite.

*Second*, Petitioner mischaracterizes the dispute over the "housed" limitation. Reply, 5. Rossier's bolt body 96 lies entirely outside of the volume of barrel extension 60 and, therefore, cannot be said to be "housed" within it, as the claims recite. EX1001, 17:21-23; POPR, 22-24.

Respectfully submitted,
STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason A. Fitzsimmons/

Date: June 13, 2025

Jason A. Fitzsimmons
Registration No. 65,367
Lead Attorney for Patent Owner

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing **PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was served electronically via e-mail on June 13, 2025, in its entirety on the following counsel of record for Petitioner:

Steven R. Daniels (Lead Counsel)
Bryan D. Atkinson (Back-up Counsel)
DICKINSON WRIGHT PLLC
sdaniels@dickinsonwright.com
batkinson@dickinsonwright.com

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason A. Fitzsimmons/

Jason A. Fitzsimmons
Registration No. 65,367
Lead Attorney for Patent Owner

Date: June 13, 2025

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600