

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Milwaukee Electric Tool Corporation,

Petitioner,

v.

Klein Tools, Inc.,
Patent Owner

U.S. PATENT NO. 11,452,327

Case No. IPR2025-00724

PATENT OWNER'S PRELIMINARY RESPONSE

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LIST OF EXHIBITS

<u>Exhibit #</u>	<u>Description</u>
2001	United States Patent Application Publication No. 2019/0008228, Issued to Ramey, January 10, 2019
2002	United States Patent No. 6,497,493, Issued to Theisen, December 24, 2002
2003	Complaint for Patent Infringement, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, February 4, 2025, Docket No. 1
2004	Email between Counsel re Motion to Stay, dated between March 24-25, 2025
2005	Defendant's Unopposed Motion to Stay Pursuant to 28 U.S.C. § 1659 and for an Extension of Time to Respond to the Complaint, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, March 27, 2025, Docket No.11
2006	Order Granting Motion to Stay, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, March 28, 2025, Docket No. 12
2007	Order No. 7: Procedural Schedule, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, May 1, 2025
2008	United States Patent and Trademark Office Memorandum re Interim Processes for PTAB Workload Management, March 26, 2025
2009	First Amended Complaint under Section 337 of the Tariff Act of 1930, as Amended, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, May 5, 2025

<u>Exhibit #</u>	<u>Description</u>
2010	Excerpt from First Supplemental Hard Hat Domestic Industry Claim Chart for U.S. Patent No. 11,452,327, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442
2011	Excerpts from Respondents' Fifth Supplemental Objections and Responses to Complainant Klein Tools, Inc.'s First Set of Interrogatories, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, July 1, 2025
2012	United States Patent and Trademark Office FAQs for Interim Processes for PTAB Workload Management
2013	United States Patent and Trademark Office Memorandum re Guidance on USPTO's recession of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, March 24, 2025
2014	Transcript of Markman Hearing, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, July 23, 2025
2015	United States Patent and Trademark Office Memorandum re Enforcement and Non-Waiver of 37 C.R.F. § 42.104(B)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews, July 31, 2025

I. INTRODUCTION

The Petition should be denied on the merits.¹ Petitioner effectively concedes that the invention of the '327 Patent is novel as of its priority date by relying solely on obviousness grounds tied to that date. For the only remaining ground, Ground 4, Petitioner asserts anticipation, but does so by arguing that the '327 Patent is not entitled to the filing date of its non-provisional application and two provisional applications—thereby treating Patent Owner's own alleged intervening disclosure as prior art. There are at least two fundamental problems with this approach: (i) the Klein News Release is not available as prior art against the '327 Patent because it does not predate the latest possible priority date (the application date), and (ii) Petitioner's anticipation argument is contingent on a premise that Petitioner disputes—*i.e.*, that the products described in the Klein News Release practice the claims of '327 Patent—and Petitioner thus cannot satisfy its burden.

Grounds 1-3 are equally deficient. The Petition's rationale for combining Yan with Daley in Ground 1 is substantially the same as the rationale for combining Yan with Nesbitt in Ground 3. In both instances, the Petition asserts that the modification is a simple substitution or addition of a protruding nub to improve Yan's accessory retention. However, Petitioner has not articulated any

¹ It should also be denied for discretionary reasons as outlined in Paper 8.

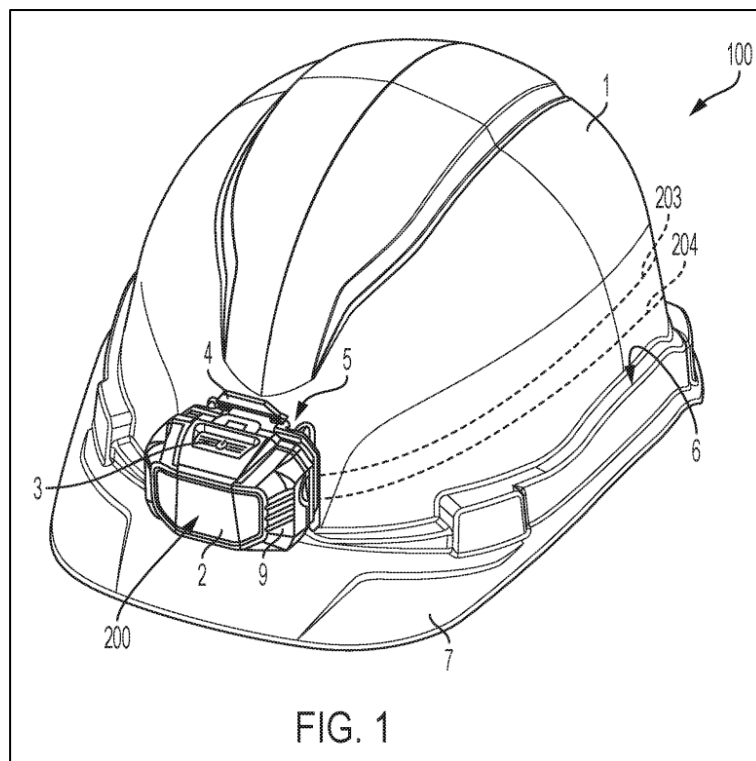
reason why Yan's existing retention mechanism is inadequate, nor has it explained why a POSA would have been motivated to substitute Daley's or Nesbitt's retention mechanism for Yan's solution. In other words, Petitioner provides no rationale for why a POSA would have sought to fix something that is not identified as broken, yet the law requires such a showing. *In re Anova Hearing Labs, Inc.*, 809 F. App'x 840, 843 (Fed. Cir. 2020) (reversing Board's finding of obviousness where "[t]he Board also does not explain why a person of ordinary skill in the art would be motivated to modify Brown, which already includes vents, to address occlusion effect. The Board does not explain why a person of skill in the art would conclude that Brown needed to be modified." (citation omitted)); *see also Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1369 (Fed. Cir. 2012) ("Because each device independently operates effectively, a person having ordinary skill in the art ... **would have no reason to combine the features of both devices into a single device.**"). Finally, Ground 2 depends on Ground 1 and fails for at least the same reasons.

Because Petition has not shown a "reasonable likelihood of success" that any of the challenged claims of the '327 Patent are unpatentable, the Board should not institute trial.

II. BACKGROUND

A. Technology Overview and the '327 Patent

The '327 Patent is directed to a safety helmet with receptacles on the front and rear of the helmet—receptacles for mounting accessories. *See* Ex-1001 at Abstract. Figure 1 of the '327 Patent, reproduced below, depicts a safety helmet with an accessory mounted to a front receptacle.



Ex-1001 at Fig. 1.

The '327 Patent recognizes that “[v]arious types of safety helmets are commonly used in [] several industries, many of which include mounted personal illumination devices commonly called headlamps.” Ex-1001 at 1:17-22. The '327 Patent recognizes that there are multiple methods of mounting headlamps (or other

accessories) to the safety helmet: permanently, a mounting bracket at the front of the helmet, and with an elastic band. *See id.* at 1:22-37. However, these methods each have their shortfalls. The permanent mount cannot be adjusted. *See id.* at 1:23-24 (“the headlamp is permanently mounted to the safety helmet in a fixed orientation at the front of the safety helmet”). The bracket mount cannot be moved to the back of a helmet if a user wishes to wear the helmet in reverse. *See id.* at 1:25-26 (“a mounting bracket is included at the front of the helmet to allow for a headlamp to be inserted”), 1:64-66 (“the outer shell is reversible such that one of the front side or the rear side is oriented above a face of the user when the outer shell is worn by the user”). And the elastic band easily falls off. *Id.* at 1:34-35 (“band-type mounting systems are prone to slipping off from the safety helmet”).

Thus, a better solution for mounting accessories was needed, and the '327 Patent provides that solution: a receptacle with a nub that is integrally molded with the outer shell of the hard hat. *See Ex-1001* at 3:65-15, 5:55-6:7. This protruding nub can interact with accessories, locking them in place. *See id.* Further, a receptacle is placed at the front **and** the back of the helmet to allow the user to reverse the direction of the helmet and still make use of accessories. *See id.* at 1:61-2:5 (“In one aspect ... [t]he safety helmet includes an outer shell adapted to be worn by a user. The outer shell has a front side and a rear side, wherein the outer shell is reversible such that one of the front side or the rear side is oriented

above a face of the user when the outer shell is worn by the user. ... An accessory device has a mating receptacle formed thereon, and is releasably mountable onto each of the front receptacle and the rear receptacle of the outer shell.”). Additionally, providing receptacles on both the front and back of the helmet permits additional accessories to be carried, used, and interchanged from back to front (even when the helmet is not worn in reverse), permitting users to tailor their hardhats and safety helmets to the job at hand. *Id.*

B. Prosecution History of the '327 Patent

The Claims of the '327 Patent were subject to multiple office actions. *See* Ex-1004 (Prosecution History). In a November 24, 2021 Office Action (“November 2021 Office Action”), the Examiner rejected all then-pending claims (1-6, 13, 21, 23, and 25-32) as unpatentable over Ramey in view of Theisen. *See* Ex-1004 at 127-134. According to the Examiner, “Ramey teaches multiple attachment receptacles on a helmet that can be any device now known or later developed.” *Id.* at 132. In Ramey, these platforms are formed as separate pieces and attached to the helmet using fasteners (*e.g.*, rivets, screws), not as unitary or integral features of the helmet shell. *See id.* at 79. The Examiner stated that Theisen teaches a safety helmet with a receptacle (attachment bracket) that can be either attached to the already formed outer shell or molded into the outer shell, making the receptacle unitary with and formed from the shell. *See id.* at 132.

The Examiner then combined Ramey and Theisen to reject the claims, asserting that it would have been obvious to one of ordinary skill in the art to replace Ramey's separately attached mounting means with Theisen's molded, unitary attachment means, thereby providing a helmet that can securely attach accessories without compromising the helmet's integrity. *Id.* (Examiner stating that "[r]eplacing the attachment receptacles of Ramey with the molded attachment receptacles of Theisen creates a helmet with multiple integrally molded attachment receptacles that are located along the front and rear of the helmet above the brims and of identical construction.").

On March 29, 2022, the Applicant initiated an interview. *See id.* at 84. The interview summary reflects that the Applicant and Examiner discussed, in relevant part, "ways to overcome the 103 rejection of Ramey in view of Theisen by detailing that the outer shell and the nub are formed of the same unitary/integral material and that the nub is located at the upper portion of the receptacle." *Id.* at 84 (citations omitted).

In response to the office action and in light of the interview, on April 25, 2022 Applicant filed a response ("April 2022 Response") (i) amending the claims "for clarity" to replace the words "unitary feature" and "integral" with "integrally molded ... from the common material" or a "common material" for "clarity" and

(ii) submitting a Rule 1.132 declaration from James O. Hill (“Hill Declaration”) in support of its arguments, including evidence of non-obviousness. *Id.* at 42-81.

The Examiner allowed the application on May 12, 2022. *Id.* at 18-20.

III. CLAIM CONSTRUCTION

For this proceeding, Patent Owner agrees with Petitioner that “plain and ordinary meanings suffice[;] [n]o express constructions are required for purposes of this IPR.” Pet. at 9.

IV. NOT A SINGLE CLAIM OF THE ’327 PATENT IS EITHER OBVIOUS OR ANTICIPATED

Under 35 U.S.C. § 314, “[t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Petitioner cannot show that “there is a reasonable likelihood” of it prevailing on a single claim.

A. Grounds 1 and 3: Yan Does Not Render Obvious the Claims of the ’327 Patent Under 35 U.S.C. § 103 when Considered in View of Daley or Nesbitt

The Petition implicitly acknowledges that Yan fails to teach, among other things, a protruding nub. *See e.g.*, Pet. at §§ 5.1.1 and 5.1.3. In an attempt to address this deficiency, the Petition asserts in Ground 1 that Daley teaches a protrusion and contends that a POSA would have been motivated to modify Yan’s

safety helmet to include this feature. *Id.* at 5.1.3. Similarly, the Petition asserts in Ground 3 that Nesbitt teaches a nub and contends that a POSA would have been motivated to modify Yan’s safety helmet to include this feature. *Id.* at 5.3.2. As discussed below, Petitioner offers four arguments why a POSA would have modified Yan in view of Daley or Nesbitt (hereinafter referred to collectively as the “Secondary References”); however, each of these reasons is incorrect.

1. There is No Motivation to Modify Yan in View of the Secondary References

Petitioner first argues a POSA would have been motivated to modify Yan in view of the Secondary References because “Yan invites a POSA to seek out ‘equivalent structural modifications.’” *Id.* at 12-13 and 48 (quoting Ex-1011 at [0029]). Petitioner further contends that a POSA “would have been motivated to modify each of Yan’s snap-fit slot structures to be molded to the helmet body and include” Daley’s protrusion or Nesbitt’s nub. *Id.* at 13 and 48.

According to Petitioner, a POSA would have been motivated to do so because “[m]odifying each of the snap-fit slots in this manner would [allegedly] keep the snap-fit slots identical and allow for accessories to be detachably mounted to either slot in an identical manner as taught by Yan.” *Id.* However, Petitioner’s rationale is flawed for several reasons.

First, Petitioner repeatedly relies on improper hindsight reasoning. Petitioner contends that claims 1–17 are rendered obvious by the so-called “Yan-Daley helmet” and “Yan-Nesbitt helmet,” and asserts that these hypothetical helmets “teach[]” various limitations of the claims. However, no “Yan-Daley helmet” or “Yan-Nesbitt helmet” exists in the prior art; rather, these constructs are a litigation-driven creation by Petitioner, assembled with the benefit of hindsight and using the claimed inventions of the ’327 Patent as a roadmap. As the Federal Circuit has cautioned, “hindsight analysis is inappropriate because obviousness must be assessed at the time the invention was made.” *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Pat. Litig.*, 676 F.3d 1063, 1073 (Fed. Cir. 2012); *see also Netflix, Inc. v. DivX, LLC*, 80 F.4th 1352, 1358 (Fed. Cir. 2023) (“[w]e analyze whether prior art is analogous with ‘the foresight of a person of ordinary skill, not with the hindsight of the inventor’s successful achievement.’”).

For example, Petitioner’s assertion that adding Daley’s protrusion or Nesbitt’s nub to an identical pair of “snap-fit slots” would keep them “identical” and “allow for accessories to be detachably mounted to either slot *in an identical manner* as taught by Yan” relies on improper hindsight reasoning. Pet. at 13 and 48. Yan’s snap-fit slots already enable a mining lamp to be detachably mounted to a helmet in either slot because the slots “have identical structures.” *See, e.g., Ex-*

1011 ¶¶ [0005], [0020]. Petitioner does not explain why an additional structure, such as a protrusion or nub, is necessary in addition to the snap-fit slots to allow for detachable mounting of accessories. This is particularly true since the additional structure would be redundant to the snap-fit slots already disclosed by Yan. Furthermore, Petitioner’s argument that adding a protrusion or nub to a corresponding snap-fit slots in order to keep them identical does not constitute a reasoned rationale since Yan’s snap-fit slots already have “identical structures.” *See Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1366 (Fed. Cir. 2017) (“In determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is insufficient to simply conclude the combination would have been obvious ***without identifying any reason why a person of skill in the art would have made the combination.***” (emphasis supplied)).

Second, Yan’s statement that “equivalent structural modifications” are “included in the scope” of Yan’s disclosure (Ex-1011 ¶ [0029]) is irrelevant to the obviousness analysis. Boilerplate language of this kind is commonly found in patent specifications to signal the applicant’s intent not to limit the scope of the “invention” to the specific embodiments described. However, such generic language does not provide any motivation—express or implied—to modify the disclosed embodiments when the patent specification is being considered as prior

art. *See Markforged Inc. v. Continuous Composites Inc.*, IPR2022-01220, Paper 8 at 21–23 (P.T.A.B. Jan. 11, 2023) (finding that “[a reference] disclos[ing] that combinations of the disclosed embodiments and features is proper does not constitute a reasoned explanation regarding why the skilled artisan would have combined” two aspects *of the same reference* (citations and quotations omitted)); *see also Metalcraft of Mayville*, 848 F.3d at 1366 (“In determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is insufficient to simply conclude the combination would have been obvious *without identifying any reason why a person of skill in the art would have made the combination.*” (emphasis supplied)).

Third, Petitioner contends that “integrally mold[ing] the receptacle ... with a protrusion ... using at least one common (same) material” “would have been cheaper, easier, and allowed for a reduced sales price.” *See* Pet. at 13. Petitioner’s only evidence in support of this assertion is the opinion of its Declarant, Dr. Reinhall. *See* Ex-1002 at ¶¶ 70 and 167 (“In my opinion, forming such features from a common material would have been cheaper, easier, and allowed for a reduced sales price....”). As Dr. Reinhall’s declaration provides a conclusory rationale that fails to address the practical complexities or the specific reasons a POSA would have made the proposed modification, and merely repeats, verbatim, the conclusory assertion for which it is offered to support, the testimony is entitled

to little or no weight. *See Xerox Corp. et al. v. Bytemark, Inc.*, IPR2022-00624, Paper No. 9 at 15 (P.T.A.B., Aug. 24, 2022) (precedential).

In contrast, Mr. Hill’s declaration, submitted as 37 C.F.R. 1.132 evidence during prosecution of the ’327 Patent—and previously accepted by the Patent Office—provides a well-supported and thoroughly explained account of the challenges involved in molding parts to a helmet. His sworn statements are grounded in specific, technical details about the injection molding process, are corroborated by his extensive professional experience, and were persuasive to the Examiner during prosecution. Ex-1004 at 42-47.

Fourth, Petitioner asserts that adding a protrusion or nub as allegedly taught by the Secondary References would have made the connection between an accessory and a helmet more secure—but Petitioner fails to articulate (1) why a more secure connection was needed or desired, (2) why Yan’s “snap-fit slot structures” provided an insufficiently robust connection or, relatedly, (3) any suggestion to a POSA that a protrusion or nub could be used in a compatible fashion with the “snap fit slot structure” of Yan. Specifically, Petitioner asserts regarding Ground 1 that:

Including the protrusion feature with the snap-fit slot structures and the bracket with detent in the accessories would create a more robust securing of the accessories in the snap-fit slot structures and thus would have been a desirable structural modification. A more robust

securing would have made the Yan-Daley helmet more attractive to potential purchasers, thereby further motivating the combination as a matter of commercial desirability.

Pet. at 14 (citations omitted).² Again, Dr. Reinhall's declaration parrots the Petition on this point:

In my opinion, including the protrusion feature with the snap-fit slot structures and the bracket with detent in the accessories would create a more robust securing of the accessories in the snap-fit slot structures and thus would have been a desirable structural modification. In my opinion, having a more robust securing would have made the Yan-Daley helmet more attractive to potential purchasers, thereby further motivating the combination as a matter of commercial desirability.

Ex-1002 at ¶72.³ Because Dr. Reinhall's declaration again simply repeats the conclusory assertion it is intended to support, without citing any evidence or authority in support of his opinion, his testimony is entitled to little or no weight. *See Xerox Corp.*, IPR2022-00624, Paper No. 9 at 15.

² Petitioner makes a substantially similar argument regarding Ground 3. *Id.* at 49.

³ Dr. Reinhall provides a substantially similar opinion regarding Ground 3. *Id.* at ¶168.

In addition to Petitioner’s obviousness rationale being conclusory, adding Daley’s protrusion or Nesbitt’s nub feature to Yan’s “snap-fit slot structures” would have been redundant, as those structures are already described as functioning to secure an accessory to a helmet. Critically, Petitioner has not identified any deficiency in the securing mechanism used by either Yan or the Secondary References. *S.-Tek Sys., LLC v. Engineered Corrosion Sols., LLC*, 748 F. App’x 1003, 1006-07 (Fed. Cir. 2018) (affirming the Board’s finding that “[g]iven the **redundant** functions of Viking’s drum drip and Wood’s condensate drain, ... a person of ordinary skill would not have been motivated to add a condensate drain to Viking in addition to the system’s drum drip drain.” (emphasis supplied)); *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1369 (Fed. Cir. 2012) (“In addition, both of these references independently accomplish similar functions, namely, draining fluids. Because each device independently operates effectively, a person having ordinary skill in the art, who was merely seeking to create a better device to drain fluids from a wound, **would have no reason to combine the features of both devices into a single device.**”); *Johnson & Johnson Surgical Vision, Inc. v. Alcon Inc.*, IPR2021-01003, Paper 14 at 17 (P.T.A.B. Nov. 23, 2021) (“Petitioner argues that a person of ordinary skill in the art would have implemented a DMA-controlled FIFO in Ustun because it would significantly improve data speeds. But as Patent Owner points out, Ustun’s design

specifically addresses the speed of the data transfer as ‘sufficient.’” (citation omitted)); *see also In re Anova Hearing Labs, Inc.*, 809 F. App’x 840, 843 (Fed. Cir. 2020) (reversing Board’s finding of obviousness where “[t]he Board also does not explain why a person of ordinary skill in the art would be motivated to modify Brown, which already includes vents, to address occlusion effect. The Board does not explain why a person of skill in the art would conclude that Brown needed to be modified.” (citation omitted)). Thus, “[b]ecause each device independently operates effectively, a person having ordinary skill in the art, who was merely seeking to create a better device ... **would have no reason to combine the features of both devices into a single device.**” *Kinetic Concepts*, 688 F.3d at 1369.

Fifth, Petitioner asserts that “modifying Yan’s safety helmet to include Daley’s [or Nesbitt’s] integrally molded mounting features would have been obvious to try... and/or a simple substitution of one element... for another... to obtain predictable results....” Pet. at 15 and 50. However, to establish obviousness based on an “obvious to try” theory, it is not sufficient to merely identify a finite number of possible solutions, Petitioner must also demonstrate a motivation to combine—such as a recognized design need or market pressure to address a specific problem. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“**When there is a design need or market pressure to solve a problem** and there are a finite number of identified, predictable solutions, a person of ordinary skill has good

reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.”) (emphasis added).

Here, Petitioner has not identified any such design need, market pressure, or problem in the prior art that would have prompted a POSA to pursue the proposed combination. Instead, Petitioner relies on conclusory statements about routine modifications and predictable results, without providing evidence of any unmet need or benefit that would motivate the combination. In the absence of any showing that the applied art left a problem unsolved or that the combination would yield a particular advantage, Petitioner’s “obvious to try” rationale is deficient and cannot support a finding of obviousness.

Sixth, and finally, Petitioner’s obviousness rationale improperly attributes to the “Yan-Daley helmet” and “Yan-Nesbitt helmet” features that are not disclosed in either Yan or the Secondary References. For example, as discussed below in Section IV.A.2, Petitioner asserts that “[t]he Yan-Daley helmet is capable of being worn in reverse on a user’s head as desired,” yet cites no relevant disclosure in either reference, as neither describes a helmet designed for both forward and reverse orientations. Pet. at 20. Lacking any support in the asserted art, Petitioner further alleges that “it would have been an obvious modification to make the Yan-

Daley helmet reversible to capture more sales from users wanting reversible helmets.” *Id* at 21. These assertions are not grounded in the applied references, but rather reflect an improper attempt to reconstruct the invention with knowledge of the claims, which is precisely the type of hindsight reasoning the law forbids. *See In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Pat. Litig.*, 676 F.3d at 1073.

2. Neither Yan nor the Secondary References Discloses the Claimed Reversibility Feature

Petitioner does not argue that Yan or the Secondary References discloses “wherein the outer shell is reversible such that one of the front side or the rear side is oriented above a face of the user when the outer shell is worn by the user,” as required by independent claims 1 and 8. Pet. at 20-21; *see also id.* at 55. Instead, Petitioner asserts that this feature is inherently present in all safety helmets, contending that “Patent Owner has not claimed any helmet structure that differentiates a ‘reversible’ helmet from any other safety helmets.” *Id.*

However, Petitioner’s inherency argument is inconsistent with positions taken during the claim construction hearing at the ITC and disregards the Federal Circuit’s clear mandate that every claim limitation must be given effect. *Key Mfg. Grp., Inc. v. Microdot, Inc.*, 925 F.2d 1444, 1447 (Fed. Cir. 1991) (“claim limitations cannot be ignored” (quotations omitted)). Moreover, Petitioner has not

met the high bar required to prevail on an inherency argument. *Roland Corp. v. InMusic Brands, Inc.*, IPR2018-00335, Paper 14 at 17 (P.T.A.B. July 2, 2018) (declining to institute where petitioner failed to support its inherency argument with adequate explanation); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (“Inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”).

During the claim construction hearing, Petitioner expressly acknowledged that not all safety helmets are reversible and discussed the distinction between helmets that are designed to be reversible and those that are not, confirming that certain safety helmets—such as those with a brim and an extended rear—are not reversible. Ex-2014 (Hr’g Tr.) at 127:15-12-129:7.

Petitioner, anticipating that its inherency argument may not withstand scrutiny, contends that it would have been an obvious modification “to make the Yan-Daley [or Yan-Nesbitt] helmet reversible to capture more sales from users wanting reversible helmets.” Pet. at 21 and 55. Petitioner’s only evidence in support of this assertion is the opinion of its Declarant, Dr. Reinhall. *See* Ex-1002 at ¶¶ 89 and 183. As Dr. Reinhall’s declaration again merely repeats, verbatim, the conclusory assertion for which it is offered to support, the testimony is entitled to little or no weight. *See Xerox Corp.*, IPR2022-00624, Paper No. 9 at 15.

In addition to being conclusory, Dr. Reinhall's testimony impermissibly attempts to fill gaps in the disclosures of Yan and the Secondary References. 37 C.F.R. 42.104(b)(4) requires a petition to "specify where each element of the claim is found in the prior art patents or printed publications relied upon."⁴ However, Petitioner fails to specify where any one of the alleged prior art references relied on in the obviousness grounds discloses an outer shell that "is reversible such that one of the front side or the rear side is oriented above a face of the user when the outer shell is worn by the user" as recited in elements 1[a] and 8[a]. *See Stara S.A.-Industria De Implementos Agricolas v. Agco Corp.*, IPR2024-01459, Paper 12 at 32-33 (P.T.A.B., Mar. 25, 2025) (citing 37 C.F.R. 42.104(b)(4) and concluding that "Petitioner has not made sufficiently clear how Poettinger teaches this

⁴ Notably, Director Stewart published a memorandum on July 31, 2025 titled "Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews," applicable to petitions filed after September 1, 2025, which states that "Rule 104(b)(4) means that applicant admitted prior art (AAPA), expert testimony, common sense, and other evidence that is not 'prior art consisting of patents or printed publications' (collectively, 'general knowledge') may not be used to supply a missing claim limitation." Ex-2015 at 1.

limitation. Petitioner cites to its expert in support that Poettinger teaches rotation ... [b]ut these portions of the expert's declaration merely *conclude* that arrangements in Poettinger rotate but don't *explain* how the arrangement of Poettinger could rotate").

B. Ground 2: Claims 2, 4, 9, and 12 Further Limit Independent Claims 1 and 8 and Thus the Petition Fails to Meet its Burden for at Least the Same Reasons Ground 1 Fails

Claims 2 and 4 depend from independent claim 1, while claims 9 and 12 depend from independent claim 8. Claims 2, 4, 9, and 12 are each narrower in scope than the independent claims from which they depend, as they require, among other things, a clip feature that is not required by the independent claims. Because the Petition fails to meet its burden with respect to Ground 1, it likewise fails to meet its burden for Ground 2. If trial is instituted (which it should not be), Patent Owner reserves the right to argue the patentability of the dependent claims separately.

C. Ground 4: The Klein News Release Is Not Prior Art, and Petitioner's Anticipation Arguments are Inconsistent with its Position at the ITC

The application which issued as the '327 Patent was filed on January 14, 2019 pursuant to 35 U.S.C. §111(a)(4). Furthermore, under 35 U.S.C. §119(e), the '327 Patent claims priority to two provisional applications filed on January 26, 2018 and March 20, 2018, respectively. The Klein News Release is dated July 23,

2019. Therefore, on its face, the Klein News Release does not qualify as prior art against the '327 Patent.

However, Petitioner contends that the Klein News Release qualifies as prior art under 35 U.S.C. § 102(a)(1) because it was publicly available before the asserted “effective” filing date of the challenged claims, which Petitioner alleges is October 21, 2021. This is incorrect. The Klein Tools News Release, dated July 23, 2019, is not available as prior art against the '327 Patent because it was published after the effective filing date of the '327 Patent.

Under 35 U.S.C. § 102(a)(1), a reference is only prior art if it was “patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.” Here, the application that issued as the '327 patent was filed on January 14, 2019, and claims priority under 35 U.S.C. § 119(e) to two provisional applications filed on January 26, 2018 and March 20, 2018, respectively. The Patent Act defines the “effective filing date” as:

(1) The term “effective filing date” for a claimed invention in a patent or application for patent means— (A) if subparagraph (B) does not apply, *the actual filing date of the patent or the application for the patent containing a claim to the invention*; or (B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119 , 365(a) ,

365(b) , 386(a) , or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c).

35 USC § 100(i)(1). Thus, the earliest possible effective filing date for the '327 patent is January 26, 2018, and under no circumstance can the effective filing date be later than January 14, 2019 filing date.

Because the Klein Tools News Release was published on July 23, 2019—well after both the non-provisional and provisional filing dates—it cannot qualify as prior art under § 102(a)(1). As confirmed by the statutory language and by *Westphal v. Fawzi*, the critical date for determining whether a reference is prior art is the effective filing date of the patent application. Only disclosures made before that date can be considered prior art. *See Westphal v. Fawzi*, 666 F.2d 575, 578 (C.C.P.A. 1981). The court in *Westphal* affirmed that a reference cannot be used as prior art if it was not publicly available before the filing date of the non-provisional application.

Furthermore, Petitioner's anticipation argument is contingent on a premise Petitioner disputes, *i.e.*, that the products described in the Klein News Release practice the claims of '327 Patent. Petitioner characterizes the Klein News Release as "Patent Owner's own news release describing its *allegedly* patent-practicing helmet" (Pet. at 3 (emphasis added)), but Petitioner disputes this allegation in the parallel ITC investigation. Ex-2011 at 72 ("*If* ... the DI Products satisfy the

technical prong [(i.e., practice one or more claims of the '327 Patent)] as Klein contends, then each of the claims of the '327 Patent is invalid under 35 U.S.C. § 102.” (emphasis supplied)). Moreover, during the claim construction hearing, Petitioner argued that “Klein’s helmets actually include a recess that extends inwardly toward the interior of the helmet and does not protrude or extend out at all.” Ex-2014 (Hr’g Tr.) at 144:15-24. Consistent with its position at the ITC, Petitioner fails to allege that the Klein News Release discloses a “protruding nub,” despite that element being required by every one of the Challenged Claims.

This glaring—and no doubt intentional—omission can be seen in multiple claim elements. *See* Pet. at 78 (addressing element 1[b]), 80-82 (addressing claims 2 and 4), 83 (addressing element 8[b]), 84 (addressing claims 9 and 12), 86 (addressing elements 17[b] and 17[c]). For example, in addressing element 1[b]—which recites “a front receptacle being integrally molded with the outer shell and having an external slot extending upwardly along the front side on the exterior surface of the outer shell above the brim *and a protruding nub, wherein the protruding nub is integrally molded with the outer shell from the common material and is disposed centrally relative to the external slot and directly onto the exterior surface of the outer shell*”—Petitioner merely refers to “the claimed front receptacle” and makes no mention whatsoever of a “protruding nub”:

5.4.3.3 Element 1[b]

According to KNR, these mounts implement patent-pending technology for holding headlamps without straps or zip-ties. §5.4.2; Ex-1010, 1.



Ex-1010, Image 1 (Excerpt)

Thus, as would be apparent to a POSA reviewing KNR's images, KNR discloses the claimed front receptacle. Ex-1002, ¶260.

Id. at 78. Indeed, despite providing multiple excerpted images from the Klein News Release with annotations indicating various features that map to claimed elements, Petitioner never once identifies the “protruding nub.” *See id.* at 76–81.

While the phrase “protruding nub” appears once—and only once—in the section of the Petition that purports to map the Klein News Release to the Challenged Claims, even there, Petitioner fails to allege that the Klein News Release discloses a protruding nub. Addressing the portion of element 16[b] that recites “the outer shell forms the protruding nub from a same material as the outer shell,” Petitioner merely states that “[t]his feature would have been apparent to a POSA reviewing KNR”:

5.4.15.2 Element 16[b]

16[b] is similar to 1[b], distinguished by reciting “the outer shell forms the protruding nub from a same material as the outer shell.” This feature would have been apparent to a POSA reviewing KNR. Ex-1002, ¶284.

Pet. at 85. Petitioner cites the declaration of its expert in support of this vague allegation, but Dr. Reinhall does not opine that the Klein News Release discloses a protruding nub, nor does he identify the relevant feature in the images from the Klein News Release. Ex-1002, ¶284. At most, Dr. Reinhall opines that this feature supposedly would have been obvious, as he states that “it would have been apparent to a POSA reviewing the Klein News Release’s images to form a protruding nub from a same material as the outer shell.” *Id.* Petitioner, however, has not presented any obviousness grounds based on the Klein News Release.

Having failed to allege in its Petition that every element of each of the Challenged Claims is disclosed by the Klein News Release, Petitioner cannot satisfy its burden to prove that the Challenged Claims are anticipated. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (“A single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim.”).

V. CONCLUSION

Petitioner has failed to meet the “reasonable likelihood of success” standard that any of the challenged claims of the ’327 Patent is unpatentable under any of

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the grounds raised in its Petition. Accordingly, Patent Owner respectfully requests that that Board deny institution of Inter Partes Review of claims 1-17 of the '327 Patent.

Date: August 21, 2025

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

This Petition complies with the type-volume limitations as mandated in 37 C.F.R. § 42.24, totaling 5,667 words. Counsel has relied upon the word count feature provided by Microsoft Word.

/s/ *W. Todd Baker*
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a complete copy of the foregoing document was served on August 21, 2025 on counsel of record for the Petitioner via email to the following addresses:

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