

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 REPLY
DISCRETIONARY DENIAL OF *INTER PARTES REVIEW*

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<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. THERE IS COMPLETE OVERLAP BETWEEN THE PETITION AND ITC, CONTRARY TO PETITIONER’S ASSERTIONS

Petitioner repeatedly asserts that the ITC investigation “does not have 100% overlap with the claims challenged in the ’327 Patent.” *See* Opp. at 19 (§7.1 (Factor 1)), 20-21 (§7.2 (Factor 2) and §7.3 (Factor 3)), and 22 (§7.4 (Factor 4)). This is false. There is complete overlap between the claims at issue in both proceedings. In the co-pending ITC Investigation, Petitioner is asserting invalidity of *every* claim of the ’327 Patent. *See, e.g.*, Ex. 2011 at 72 (“[E]ach of the claims of the ’327 Patent is invalid under 35 U.S.C. § 102.”). The same is true in this proceeding. *See, e.g.*, Paper 2 at 3 (“Claims 1-17 are anticipated by [KNR]”). This error infects Petitioner’s entire discretionary denial opposition and renders its *Fintiv* analysis fatally flawed.

Moreover, Petitioner asserts *identical* grounds in the ITC. *See* Ex. 2011. Petitioner has not removed the overlap through any *Sotera* (or other) stipulation, demonstrating a complete disregard for any efficiency.

II. THE ITC IS WELL-SUITED TO RESOLVE PETITIONER’S VALIDITY CHALLENGES BEFORE ANY FWD

Petitioner speculates that, “[w]hile the co-pending ITC’s Target Date is currently scheduled in advance of the Board’s [final written decision] FWD, it is likely this date will be extended.” Opp. at 20 (discussing *Fintiv* factor 2). But the ITC has not given any indication the investigation will be extended and neither party has requested an extension. No weight should be given to Petitioner’s speculation.

Further, neither case Petitioner cites supports its contention that the “Board is best suited to consider the patentability of ’327 Patent” due to the “complex[ity]” of the litigation. Opp. at 17. In *Shenzhen*, the petitioner challenged nine patents from six different families. See *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 9 at 7 (July 9, 2025). Similarly, in *Tesla*, the parallel litigation involved eleven patents spanning nine different families. See *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 8 at 5–7 (May 27, 2025). These cases are not analogous, as this dispute involves only four patents across two families. This distinction is even more pronounced given that Petitioner asserts that U.S. Patent Nos. 11,713,209 and 12,187,573 are “patentably-indistinct.” Opp. at 17.

III. PATENT OWNER ACTED PROPERLY DURING PROSECUTION AND THERE WAS NO MATERIAL ERROR BY THE PTO

Petitioner characterizes Patent Owner’s prosecution of the ’327 Patent as misleading and as “compromising the examination’s transparency and fairness.” Opp. at 1-2. This is incorrect. Patent Owner’s prosecution was conducted transparently and in full accordance with PTO procedures, with no misleading actions taken. The question of whether the specification—including both the written description and drawings—adequately supports the “integrally molded projecting nub” limitation was thoroughly examined and discussed with the Examiner throughout prosecution, as reflected in multiple Office Actions, amendments, and

the declaration of James O. Hill. For example, in the October 2021 Response, Patent Owner identified support for the amendment to the specification and drawings in the original application. Ex-1004, 171 (identifying [0018] (“a protruding nub 17 extending from the surface of the hard outer shell 1 of the safety helmet 100”)).

Petitioner’s assertion that the addition of reference number 17 to Figure 8 was “misleading” and done “without notifying the Examiner” is unfounded. That amendment was made openly to ensure consistency with the specification. In fact, reference number 17 was *already shown* in original Figure 3, and its addition to Figure 8 was disclosed to the PTO in the October 2021 Response: “An enlarged detail view of FIG. 8, to which reference numeral 17 has been added for clarity over the original version of the provisional figure, is reproduced below for illustration.” *Id.* Thus, Petitioner’s assertion that Patent Owner “did this without ever informing the Examiner that it had amended the figures” is simply false. The Examiner properly found the written description sufficient and allowed the claims. *See* March 2022 Interview Summary and Notice of Allowance. *Id.*, 20-25 and 84.

IV. PATENT OWNER IMPERMISSIBLY RAISES §112 IN IPR

Though Petitioner’s assertions about the prosecution of the ’327 Patent are baseless (*see supra*), Petitioner’s argument boils down to a written description challenge to the claims under 35 U.S.C. § 112, which cannot be raised in an IPR. 35 U.S.C. §§ 311(b) and 312(a)(3). Petitioner contends that KNR qualifies as prior art

because it was publicly available before the asserted “effective” filing date of the challenged claims, which Petitioner alleges is October 21, 2021, the date of an amendment presented during prosecution. This is incorrect. KNR, 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.

The application that issued as the ’327 Patent was filed on January 14, 2019, and claims priority to two provisional applications. The effective filing date for the ’327 Patent cannot, under any circumstance, be later than its January 14, 2019 filing date, 35 U.S.C. § 100(i)(1)(A)-(B), and KNR does not qualify as prior art against it, regardless of the written description challenge raised by Petitioner. Paper 10 at 21–22. Because Petitioner’s rationale for raising a priority issue is legally incorrect, the alleged error Petitioner attributes to the Office’s evaluation of the ’327 Patent’s written description is irrelevant and thus not a proper basis to raise in an IPR.

V. PETITIONER’S SPECULATIVE PGR IS INCONSEQUENTIAL

Petitioner asserts it intends to file a post-grant review (PGR) against a different, though related, patent. But the mere possibility of a PGR on a different patent—one that has not even been filed and would not have a FWD until (at best) **March 2027**—does not alter the analysis or justify institution of the present IPR. Discretionary denial under 35 U.S.C. § 314(a) is a case-specific inquiry, guided by the *Fintiv* factors and other relevant considerations, such as the status of parallel

proceedings, the investment of the parties and tribunal, and the overlap of issues. *See, e.g., Neogenomics Lab'ys, Inc. v. Natera, Inc.*, IPR2025-00455, Paper 13 at 2 (June 12, 2025). Petitioner's future PGR on a different patent does not change the key facts: there is a parallel, fast-moving ITC investigation on all four patents, there has been substantial investment in that forum, and that parallel litigation will finish long before this IPR or Petitioner's hypothetical PGR could reach FWD.

VI. PETITIONER'S ESTOPPEL ARGUMENT IS NOT COMPELLING

Petitioner's argument that institution is warranted because Patent Owner continues to prosecute continuation applications with allegedly patentably-indistinct claims is not a basis for instituting trial. Such a rationale would apply to nearly every multi-patent portfolio, as it is common practice to pursue continuations and related applications. If accepted, Petitioner's reasoning would undermine the Director's discretion and lead to institution in virtually all cases involving patent families with open applications, regardless of the circumstances. Further, under § 42.73(d), estoppel against the patent owner only attaches once a claim is finally refused or canceled in an IPR, which does not occur until an IPR certificate issues under 37 C.F.R. § 42.80. Finality is only reached after all appeals are exhausted—a process that is lengthy, inherently uncertain, and speculative. *See id.* The mere possibility of future estoppel does not justify institution where the *Fintiv* factors, including the advanced status of the ITC proceeding, otherwise support discretionary denial.

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U.S. Patent No. 11,452,327

Date: September 2, 2025

Respectfully submitted,

/s/ W. Todd Baker

W. Todd Baker
KIRKLAND & ELLIS LLP
1301 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: (202) 389-5000
Facsimile: (202) 389-5200
Email: KleinTools_IPR@kirkland.com

Ryan Kane (*pro hac vice* forthcoming)
Alan Rabinowitz
KIRKLAND & ELLIS LLP
601 Lexington Avenue
New York, NY 10022
Telephone: (212) 446-4800
Facsimile: (212) 446-4900
Email: KleinTools_IPR@kirkland.com

*Attorneys for Patent Owner
Klein Tools, Inc.*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a complete copy of the foregoing document was served on September 2, 2025 on counsel of record for the Petitioner via email to the following addresses:

Alexander B. Stein
Morgan, Lewis & Bockius LLP
1400 Page Mill Road
Palo Alto, CA 94304
Email: alexander.stein@morganlewis.com

Matthew Walker
Morgan, Lewis & Bockius LLP
1301 Second Avenue, Suite 3000
Seattle, WA 98101
Email: matthew.walker@morganlewis.com

Peter Loderup
Morgan, Lewis & Bockius LLP
600 Anton Blvd, Suite 1800
Costa Mesa, CA 92626
Email: peter.loderup@morganlewis.com

Scott Sherwin
Morgan, Lewis & Bockius LLP
110 North Wacker Drive
Chicago, IL 60606
Email: scott.sherwin@morganlewis.com

Email: 327Patent-Metco-Klein-IPR@morganlewis.com

Date: September 2, 2025

/s/ W. Todd Baker
W. Todd Baker
KIRKLAND & ELLIS LLP

Case No. IPR2025-00724
U.S. Patent No. 11,452,327

1301 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: (202) 389-5000
Facsimile: (202) 389-5200
Email: KleinTools_IPR@kirkland.com