

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Milwaukee Electric Tool Corporation,
Petitioners,

v.

Klein Tools, Inc.,
Patent Owner.

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

**PETITIONER'S SUR-REPLY TO PATENT OWNER'S
DISCRETIONARY DENIAL REPLY BRIEF**

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	AN EARLY CHALLENGE FAVORS ROBUST PREDICTABLE PATENT RIGHTS AND WEIGHS AGAINST DISCRETIONARY DENIAL	2
III.	PATENT OWNER WAS NOT FORTHRIGHT IN MODIFYING FIGURE 8 DURING PROSECUTION	3
IV.	THE KNR ARGUMENTS ARE ANTICIPATION ARGUMENTS	4
V.	THIS IPR AND THE FORTHCOMING PGR OF A CHILD PATENT WILL STREAMLINE LITIGATION	5
VI.	CONCLUSION	5

Table of Exhibits

Exhibit	Description
Ex-1001	U.S. Patent No. 11,452,327 (“’327 Patent”)
Ex-1002	Declaration of Expert Dr. Per Reinhall
Ex-1003	<i>Curriculum Vitae</i> of Expert Dr. Per Reinhall
Ex-1004	Prosecution History of the application that led to the ‘327 Patent
Ex-1005	U.S. Provisional Application No. 62/622,472 (“’472 Provisional”)
Ex-1006	U.S. Provisional Application No. 62/645,491 (“’491 Provisional”)
Ex-1007	U.S. Patent Application No. 16/246,935 as filed January 14, 2019 (“’935 Application”)
Ex-1008	Comparison of the ’327 Patent and the ’935 Application
Ex-1009	Chinese Utility Model App. No. 201120014896.0 to Yan (“Yan-CN”)
Ex-1010	Klein Tools “Klein Tools’® New Hard Hats Designed for Pros—Safety, Comfort and Fit,” July 23, 2019 (“Klein News Release”)
Ex-1011	Certified Translation of Chinese Utility Model App. No. 201120014896.0 to Yan (“Yan”)
Ex-1012	U.S. Patent No. 9,993,043 to Daley (“Daley”)
Ex-1013	U.S. Patent No. 4,304,009 to Nesbitt et al. (“Nesbitt”)
Ex-1014	German Utility Model App. No. 2020-06007009 to Kiessler (“Kiessler-DE”)
Ex-1015	Certified Translation of German Utility Model App. No. 2020-06007009 to Kiessler (“Kiessler”)
Ex-1016	Complaint in International Trade Commission (ITC) investigation No. 337-TA-1442, titled <i>Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof</i> (“ITC Complaint”)

Ex-1017	Webpage printout at https://www.osha.gov/Publications/osha3151.pdf (Personal Protective Equipment) OSHA 3151-12R 2004.
Ex-1018	U.S. Patent No. 12,268,265 (“’265 Patent”)
Ex-1019	U.S. Patent Application No. 17/856,628 (“’628 Application”) as filed July 1, 2022, which that led to the ‘265 Patent
Ex-1020	Prosecution History of the ‘628 Application.
Ex-1021	U.S. Patent Application No. 19/074,885 (“’885 Application”) as filed March 10, 2025
Ex-1022	Declaration of Scott D. Sherwin in Support of Petitioner’s Notice of Intent to Designate Scott D. Sherwin as a Provisionally Recognized PTAB Attorney Eligible for Automatic Pro Hac Vice Admission as Back-Up Counsel
Ex-1023	INV. No. 337-TA-1409, Order No. 22
Ex-1024	INV. No. 337-TA-1409, Order No. 23

I. INTRODUCTION

Milwaukee Electric Tool Corp. (“Petitioner”) hereby submits this sur-reply to Patent Owner’s (“PO”) Discretionary Denial reply dated September 2, 2025. As a preliminary matter, Petitioner acknowledges that the validity of each of the claims of the ’327 patent is being challenged at the ITC. But uncertainty remains as to whether the ITC will address all claims, particularly in view of Patent Owner asserting infringement of only a subset of claims at the ITC.¹ However, notwithstanding the validity challenge to each of the claims, the ITC may not address the validity of all the claims. A narrower scope to the ITC decision could result, for example, from case narrowing or the ITC’s determination that the accused product does not infringe any of the asserted claims.

Importantly, the early challenge mounted against the young patent at issue here will allow the Board to correct a material error made during examination and—unlike the ITC—the Board’s review has the potential to invoke patent owner

¹ Petitioner acknowledges that the language used in Paper 11 concerning potential overlap with the ITC case was more definitive than it needed to be. For example, instead of “[t]he co-pending ITC Investigation does not have 100% overlap with the claims challenged,” Petitioner should have said “the co-pending ITC Investigation *might* not have 100% overlap with the claims challenged.” Paper 11, 19.

estoppel. Without that potential, Patent Owner has demonstrated its intent to continue to exploit the continuation process with patentably-indistinct claims that unfairly target competitors and undermine the integrity of the examination process, creating inefficiencies and duplicative processes in the future as these invalid claims continue to be litigated. *See* Ex-1023 (continuation application filed December 4, 2024). As the Director has reinforced in recent decisions, “[i]t is an appropriate use of Office resources to provide consistency and predictability to the public.” *POSCO Co., Ltd. v. Arcelormittal*, IPR2025-00370, -00371, Paper 10, 3 (P.T.A.B. June 25, 2025) (quoting 37 C.F.R. § 42.73(d)(3)) (addressing patent owner estoppel).

II. AN EARLY CHALLENGE FAVORS ROBUST PREDICTABLE PATENT RIGHTS AND WEIGHS AGAINST DISCRETIONARY DENIAL

The parallel ITC investigation does remain ongoing, but that is not dispositive. This case presents an early challenge to a young patent from a patent family that continues with open prosecution. The Acting Director has previously found that the recency of patents can outweigh the fact that a final written decision would be unlikely to issue before the occurrence of a district court trial. *Zhuhai Cosmx Battery Co., Ltd., v. Ningde Amperex Technology Limited*, IPR2025-00432, 00431, -00405, -00389, -00385, Paper 9, 2-3 (P.T.A.B. July 2, 2025) (“Although there may be some inefficiencies with two proceedings operating in parallel, the early challenges to the patents tip the balance against discretionary denial”).

IPRs were created to provide a lower-cost, higher-quality resolution of patent-validity disputes as compared to complex parallel proceedings in the ITC or district court. Here, Patent Owner has invoked a common litigation strategy of asserting numerous patents (four patents from two different patent families covering two completely distinct technologies, helmets and fish tape), even where most are weak, which drives up litigation costs and burdens the parties. Empowering defendants to resist that tactic by seeking IPR review helps to promote efficiency, reduce litigation costs, enable the possibility of invoking patent-owner estoppel, and allow the '327 Patent to be challenged before the Office, which is uniquely positioned to assess complex issues of claim validity.

Patent Owner's argument that allowing this proceeding would be opening the door to any challenges involving patents with continuation applications is simply not true. Paper 12, 5. Here, the '327 Patent is young, and the instant Petition was filed less than three years after the issue date. Ex-1004, 1. Further, as a matter of judicial efficiency, the Director's discretionary denial decision in this IPR should stand and fall with the same decision in the forthcoming related PGR.² Paper 11, 9-10. These are factors that strongly weigh against discretionary denial, and are not ubiquitous across all challenged patents with continuation applications.

III. PATENT OWNER WAS NOT FORTHRIGHT IN MODIFYING

² PGR2025-00080, which will challenge the '265 patent.

FIGURE 8 DURING PROSECUTION

Contrary to Patent Owner's assertion, the addition of a reference numeral and lead line to Figure 8 during prosecution was not "made openly." Paper 12, 3. There is no mention of the addition in the *Amendments to the Drawings* portion of the response, nor in the accompanying remarks concerning the *Amendments to the Specification and Drawings*. Rather, the remarks simply state that the figure was "pulled from [the provisional application]." Ex.1004, 170. Patent Owner unpersuasively clings to a later remark in the *Amendments to the Claims* section that merely states that an "enlarged detail view" of Figure 8 presented therein has an added reference numeral. *Id.*, 171.

IV. THE KNR ARGUMENTS ARE ANTICIPATION ARGUMENTS

Patent Owner argues the Klein News Release ("KNR") Ground boils down to an impermissible written-description challenge. That is incorrect.

The KNR Ground contends that claims 1-17 are invalid under 35 U.S.C. § 102. These anticipation arguments require first establishing that the prior art pre-dates the claims. Accordingly, the arguments include a preliminary discussion to show that the KNR was published before the introduction of the new matter on which the claims rely. The effective filing date of the claims is the "actual filing date" of the new matter claimed. *See* 35 U.S.C. § 100(i)(1)(A). Contrary to Patent Owner's assertion that the effective filing date cannot, under any circumstance, come after

the date on which an application is first filed, such circumstances do exist. *See, e.g.*, 37 C.F.R. § 1.53(e)(2); *see also* M.P.E.P. § 201.06(c)(II) (“If the examiner determines that ... [an] application contains new matter ..., the examiner should ... indicate that the application should be redesignated as a continuation-in-part.”).

V. THIS IPR AND THE FORTHCOMING PGR OF A CHILD PATENT WILL STREAMLINE LITIGATION

Patent Owner argues that the forthcoming PGR is irrelevant to the question of discretionary denial. That is wrong—it is an additional factor that the Board can and should carefully consider. The Board should institute this IPR along with the aforementioned PGR “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1.

VI. CONCLUSION

Although there is overlap, that is not dispositive. The Board should review this young patent and trigger the possibility of patent-owner estoppel, which only it can do. Discretionary denial is inappropriate here.

Dated: September 5, 2025

Respectfully Submitted,

/ Alexander B. Stein /

Alexander B. Stein, Reg. No. 71,397

CERTIFICATE OF COMPLIANCE

The undersigned certifies that the foregoing **PETITIONER’S SUR-
REPLY TO PATENT OWNER’S DISCRETIONARY DENIAL REPLY
BRIEF** is within the 5-page limit, exclusive of the parts exempted as provided in
37 C.F.R. § 42.24(a), and therefore complies with the type-volume limitations of
37 C.F.R. § 42.24(a).

Dated: September 5, 2025

Respectfully Submitted,

/ Alexander B. Stein /

Alexander B. Stein, Reg. No. 71,397

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), it is hereby certified that on September 5, 2025 an electronic copy of this PETITIONER'S SUR-REPLY TO PATENT OWNER'S DISCRETIONARY DENIAL REPLY BRIEF was served via email on Patent Owner's counsel of record in this proceeding:

W. Todd Baker (todd.baker@kirkland.com)
Alan M. Rabinowitz (alan.rabinowitz@kirkland.com)
KleinTools_IPR@kirkland.com

Dated:
September 5, 2025

Respectfully submitted,

/ Alexander B. Stein /
Alexander B. Stein, Reg. No. 71,397