

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. 11,713,209
Case No. IPR2025-00892

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	DISCRETIONARY DENIAL IN THIS IPR SHOULD STAND AND FALL WITH THE RELATED PGR.....	3
III.	RAPID CHALLENGE AND LACK OF SETTLED EXPECTATIONS.....	4
IV.	THE PETITION IS STRONG AND SHOULD NOT BE DENIED UNDER 35 U.S.C. § 325(D).....	5
	A. Prior Art: Obviousness Grounds	6
	B. Expert Testimony	8
V.	COMPLEXITY AND DIVERSE TECHNOLOGY SCOPE OF ASSERTED PATENTS FAVORS INSTITUTION.....	8
VI.	THE FIRST FIVE <i>FINTIV</i> FACTORS ARE OVERALL NEUTRAL OR SLIGHTLY AGAINST DENIAL.....	10
	A. Factor 1	11
	B. Factor 2.....	12
	C. Factor 3.....	13
	D. Factor 4.....	14
	E. Factor 5.....	15
VII.	ADDITIONAL CIRCUMSTANCES (FACTOR 6) MOVE THE OVERALL WEIGHT OF THE <i>FINTIV</i> FACTORS OVERWHELMINGLY AGAINST DISCRETIONARY DENIAL	15
	A. Factor 6.....	15
VIII.	CONCLUSION	16

Table of Exhibits

(newly added exhibits in italics)

Exhibit	Description
Ex-1001	U.S. Patent No. 11,713,209 Patent (“’209 Patent”)
Ex-1002	Prosecution History of the application that led to the 11,713,209 Patent (“’209 Patent”)
Ex-1003	Declaration of Expert Witness, Dr. David J. Eby, Ph.D., P.E., CFEI.
Ex-1004	European Patent No. 1,391,412 (“Hartranft”)
Ex-1005	International Publication No. 1997/41626 (“Bruin”)
Ex-1006	U.S. Patent No. 5,505,432 (“Noonan”)
Ex-1007	CV of Expert Witness, David J. Eby, Ph.D., P.E., CFEI
Ex-1008	Klein Tools Fish Tape Publication (“KP1”)
Ex-1009	Southwire Glow in the Dark Fish Sticks Publication (“SP1”)
Ex-1010	Internet Archive Affidavits
Ex-1011	Laura, “A Brief History of Doughnuts,” Kitchen Kat Blog (January 26, 2008), https://kitchenkat.blogspot.com/2008/01/brief-history-of-doughnuts.html
Ex-1012	“donut”. <i>The American Heritage Dictionary of the English Language</i> (3 rd Ed.), Houghton Mifflin Company, 1996, p. 551
Ex-1013	Irving, Washington. (1809) <i>Knickerbocker’s History of New York</i> . Project Gutenberg. Retrieved April 14, 2025, from https://www.gutenberg.org/files/13042/13042-h/13042-h.htm#KNICKERBOCKERSI
Ex-1014	Klein Glow Fish Tape publication
Ex-1015	Prosecution History of the application that led to the ’573 Patent

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	Sagon, Candy, “The Hole Story,” Washington Post (March 6, 2002), https://www.washingtonpost.com/archive/lifestyle/food/2002/03/06/the-hole-story/ce8a94e0-05c7-4639-8ff7-60c6fd46eeee/ . Wayback Machine. Archived August 25, 2018, from https://web.archive.org/web/20180825183723/https://www.washingtonpost.com/archive/lifestyle/food/2002/03/06/the-hole-story/ce8a94e0-05c7-4639-8ff7-60c6fd46eeee/?utm_term=.24e165d5cce3
Ex-1018	U.S. Patent No. 12,187,573 (“’573 Patent”)
Ex-1019	“A Brief History of Fluorescence and Phosphorescence before the Emergence of Quantum Theory” by Benard Valuer and Mario N. Berberan-Santos, published in the Journal of Chemical Education.
Ex-1020	“Development of Illuminant Glow-in-the-Dark Cotton Fabric Coated by Luminescent Composite with Antimicrobial Activity and Ultraviolet Protection” by Tawfik A. Khattab, et al., published in the Journal of Fluorescence.
Ex-1021	Testimony history of Expert Witness, David J. Eby, Ph.D., P.E., CFEI
Ex-1022	<i>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</i>
Ex-1023	<i>U.S. Patent Application No. 18/968084 (“’084 Application”) as filed December 4, 2024</i>
Ex-1024	<i>Email from Milwaukee Tools Counsel regarding invalidity contentions, in the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, August 21, 2025</i>
Ex-1025	<i>INV. No. 337-TA-1409, Order No. 22</i>
Ex-1026	<i>INV. No. 337-TA-1409, Order No. 23</i>

I. INTRODUCTION

Milwaukee Electric Tool Corp. (“Petitioner”) submits this brief in opposition to the Patent Owner’s Discretionary Denial brief dated July 18, 2025. Discretionary denial is not appropriate for the reasons set forth below.

Petitioner has acted with diligence in challenging the claims of U.S. Patent No. 11,713,209 (“the ’209 Patent”). Petitioner initiated this challenge less than two years after the ’209 issuance (August 1, 2023), underscoring its commitment to addressing potential patentability issues in a timely manner. While there is a parallel action at the International Trade Commission (ITC) and in District Court, the District Court litigation is stayed, and Petitioner promptly filed this Petition just one month after the ITC investigation was instituted.

In addition to Petitioner’s quick challenge to a young ’209 Patent, the grounds for the IPR are robust and have not been previously presented to the Patent Office. All references relied on in the IPR petition are new and merit the Board’s careful consideration in the interest of maintaining the integrity of the patent system.

Moreover, Patent Owner continues to file and prosecute continuation applications with patentably-indistinct claims that are invalid for the same reasons as the claims of the ’209 Patent. *See* Ex-1023 (claims filed for child application);

see also Ex-1015 at 186 (terminal disclaimer filed by Patent Owner to obviate a double patenting rejection in the prosecution of a child application that issued as the '573 Patent). Another continuation application was filed recently as well (Application No. 18/968,084), with similarly patentably-indistinct claims. *See* Ex-1023. Under 37 CFR 42.73(d), patent-owner estoppel is only applicable if the PTAB reaches a final decision. Expectations will remain unsettled until the PTAB resolves these issues as the PTAB is the sole adjudicative body capable of triggering 42.73(d) estoppel and thus is uniquely well-situated to resolve issues related not only to the already issued patent but also to appropriately constrain Patent Owner's ongoing attempts to secure patentably-indistinct claims.

As explained in detail below, Petitioner respectfully submits that these circumstances collectively warrant a thorough review and cancellation of the challenged claims. These circumstances also provide the Acting Director with an appropriate vehicle to provide clarity as to when an IPR should proceed despite the existence of a parallel ITC action. The speed of the challenge here to a young patent that experienced a material error during examination merits the Board's review—particularly since the Board's review will impact the open prosecution that continues to rehash similar issues and will help settle expectations for this patent family.

II. DISCRETIONARY DENIAL IN THIS IPR SHOULD STAND AND FALL WITH THE RELATED PGR

As a matter of judicial efficiency, the Director's discretionary-denial decision in this IPR should stand and fall with the same decision in related PGR2025-00048. *See* 37 CFR 42.1 (stating that the rules of trial practice before the PTAB should "be construed to secure the just, speedy, and inexpensive resolution of every proceeding."). The claims at issue in this IPR, and those of the associated PGR, are not patentably distinct. Ex-1018, claims 1-18; Ex-1023, 186. The prior art grounds raised against the claims and the reasoning are substantially identical between the two petitions. The two cases should be decided together.

The associated PGR is, by definition, an early, diligent challenge to the patent at-issue. "Petitions for post-grant review are favored because they must be filed no later than nine months from the grant of the patent (35 U.S.C. § 321(c)), are close in time to examination, and occur before expectations in the patent rights are strongly." *Therabody, Inc. v. Datafeel Inc.*, PGR2025-00026, Paper 10 at 2. Moreover, as noted above, prosecution of the family remains open through U.S. App. No. 18/968,084, which is a continuation of the '573 Patent. Ex-1023. This IPR and the associated PGR thus present an early opportunity for the USPTO, and indeed, likely the same Examiner to course correct. These diligent and early challenges to the patents-at-issue would, if successful, further give rise to the

estoppel provisions of 37 CFR 42.73(d), precluding Patent Owner from taking action inconsistent with an adverse judgment, including obtaining any “claim that is not patentably distinct from a finally refused or canceled claim.” This relief, which is not available in the parallel ITC case, would prevent vexatious and unwarranted targeting of Petitioner’s product through overly-broad and invalid claims, thus promoting the fairness and efficiency, and reducing the expense, of the patent system and the broader litigation between the two parties.

III. RAPID CHALLENGE AND LACK OF SETTLED EXPECTATIONS

The ’209 Patent is young. The Patent issued in 2023, with the instant Petition filed less than two years after the Patent’s issue date. Ex-1002 at 237. Thus, Petitioner has challenged the patent early on in its life and this favors “robust, predictable patent rights and weigh against discretionary denial.” *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, -00605, Paper 12 at 2.

The Director has repeatedly found that a challenged patent issued as early as 2020 “has not been in force for a significant period of time” and thus the “Patent Owner has not developed strong settled expectations that favor discretionary denial.” *CSPC Megalith Biopharmaceutical Co., Ltd. v. Shanghai Miracogen Inc.*, IPR2025-00685, Paper 9 at 2; *see also Microsoft Corp. v. Edge Networking Systems, LLC*, IPR2025-00617, -00618, -00619, Paper 13 at 2 (finding issue dates of 2020, 2021, and 2023 to weigh against discretionarily denial); *Mim Software*

Inc. v. Progenics Pharmaceuticals, Inc., IPR2025-00630, -00725, -00726, Paper 12 at 2 (finding issue dates of 2020, 2022, and 2024 to weigh against discretionarily denial); *Revvo Technologies Inc. v. Tire Stickers LLC*, IPR2025-00631, Paper 12 at 2 (finding an issue date of 2021 to weigh against discretionarily denial).

This weighs strongly against denial.

IV. THE PETITION IS STRONG AND SHOULD NOT BE DENIED UNDER 35 U.S.C. § 325(D).¹

The Advanced Bionics framework sets forth a two-part inquiry to determine whether a § 325(d) discretionary denial is warranted. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (designated precedential: Mar. 24, 2020).

None of the references or arguments in this Petition were previously considered during prosecution.

Moreover, the Examiner erred by not identifying Hartranft, Bruin, Noonan Klein Tools Fish Tape (KP1), and Southwire Glow in the Dark Fish Sticks (SP1). The Petition presenting “different prior art than the Office was aware of” constitutes error by the Office during prosecution. *Oticon Medical AB v. Cochlear Limited*, IPR2019-00975, Paper 15 at 19-20 (PTAB Oct. 16, 2019) (designated

¹ In Paper 8, Patent Owner erroneously refers to § 315(d), but appears to present arguments under § 325(d), which is what Petitioner addresses here.

precedential: Mar. 24, 2020).

A. Prior Art: Obviousness Grounds

The obviousness grounds of the Petition are strong. The references in the Petition and the arguments based thereon are not the same or substantially the same as previously presented to the Office. Moreover, multiple motivations to combine are provided and the combinations address the amendments and arguments that led to allowance of the '209 Patent.

Patent Owner first argues that the references fail to disclose “a fish tape having a length extending from a first end to a second end, the length of the fish tape comprising a luminescent material that emits light after being energized by exposure to a light source.” Paper 8 at 13. However, the Petition includes detailed grounds explaining how the references exactly teach such a limitation. Paper 2 at §§ 5.1.4.2, 5.1.8.1, 5.1.14.1, 5.3.4.2, 5.3.7.1. To the extent Patent Owner disagrees with these detailed grounds, this is the type of issue (fact-intensive question) that institution of the Petition would allow the Board to resolve.

Patent Owner also argues that two of the references, Bruin and SP1, do not describe fish tape at all, but rather a cable catcher and fish sticks. Paper 8 at 13. As explained in the Petition, the Expert Declaration, and the Patent itself, fish tape is another name for a wire/cable puller, which is exactly what a cable catcher and fish sticks are as well. *See* Paper 2 at 3 (“fish tape system to pull electrical wires and

fiber optic cables through conduits or into enclosed wall spaces”); *see also* Ex-1003 at 12 (“the ’209 Patent relates to a luminescent fish tape system to pull electrical wires and fiber optic cable through conduits or into enclosed wall spaces; Ex-1001 at 1:26-1:27 (“[s]uch fish tapes are used to pull electrical wires and fiber optic cables through conduit or into enclosed wall space.”). In fact, Patent Owner’s advertising materials state that the fish tape housed within their Klein Glow Fish Tape cases “also function as a super-flex glow rod.” Ex-1014 at 2. Thus, Patent Owner implicitly concedes that fish tape can go by different names, such as “a super-flex glow rod.”

Patent Owner then argues first that the combination suffers from “improper hindsight reasoning” and second that the “proposed modification would render the devices of Hartranft and KP1 ‘inoperable for [their] intended purpose.’” Paper 8 at 14. For the first argument, the Petition includes multiple, detailed and reasoned rationales for combining the references. Paper 2 at 12-17, 58-66. These explanations go beyond mere conclusory assertions or allegations of hindsight bias. Again, to the extent that Patent Owner disagrees with the motivations, this is the type of issue (a fact-intensive question) that institution of the Petition would allow the Board to resolve.

The second argument, that placing the cable catcher and/or fish sticks into the fish tape case of Hartranft and/or KP1 would render them inoperable, similarly

holds no merit as Patent Owner itself advertises that Klein Glow Fish Tape cases are “fully removable from case for wall cavity, drop ceiling, and conduit pass through feeding...allowing this fish tape to also function as a super-flex glow rod.” Ex-1014 at 2. They are essentially advertising that their Klein Glow Fish Tape takes “a super-flex glow rod” and combines it with their “case,” the same underlying logic behind the combinations proposed in the Petition. Thus, Patent Owner’s contorted positions only further confirm the Petition’s strong merits.

B. Expert Testimony

Patent Owner further argues in their Request that the Petition is over-reliant on expert testimony. Not so. “Patent Owner does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art.” *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, -00436, -00437, Paper 11 at 2. Thus, Petitioner’s detailed expert declaration is not a basis for discretionary denial, especially as Petitioner was “merely complying with regulations requiring disclosure of ‘underlying facts or data.’” *GD Energy Products, LLC v. Kerr Machine Company*, PGR2025-00031, Paper 11 at 2.

V. COMPLEXITY AND DIVERSE TECHNOLOGY SCOPE OF ASSERTED PATENTS FAVORS INSTITUTION

The Board is best suited to consider the patentability of ’209 Patent. As with the multi-patent litigation at issue in *Shenzhen Tuozhu Technology Co., Ltd. v.*

Stratasys, Inc., and Tesla, Inc. v. Intellectual Ventures II LLC, the '209 Patent at issue here is part of “complex and diverse” multi-patent litigation spanning multiple patent families, numerous diverse technologies, and multiple jurisdictions. IPR2025-00438, Paper 10 (July 17, 2025), IPR2025-00217, Paper 9 (Jun. 13, 2025).

The ITC case involves four patents from two different patent families that span different technologies (safety helmets and glow tape). Patent Owner has amended the ITC since the filing of the Petition to include the most recently granted patent on safety-helmet aspects. Ex-2009. In each patent family, Patent Owner continues to prosecute continuation applications with patentably-indistinct claims. *See* Ex-1023 (claims filed for child application); *see also* Ex-1015 at 186 (terminal disclaimer filed by Patent Owner, which confirms patentable indistinctness of the child application that issued as the '573 Patent). This further favors institution as, per 37 CFR 42.73(d), patent-owner estoppel is only applicable if the Board reaches a final decision, and, as explained above, this leaves the Board uniquely well-situated to resolve issues related not only to the already issued patent but also to appropriately constrain Patent Owner's ongoing attempts to secure patentably-indistinct claims. Institution in the present proceeding is thus warranted.

Further, the co-pending litigations (the ITC investigation and the District Court Case) involve four different patents of diverse subject matter. Ex-2003; Ex-

2009. The large number and broad scope of the patents asserted weighs against discretionary denial, as the Board is uniquely situated to deal with the complexity that such a large number of patents with diverse multiple subject matter presents. *See Shenzhen Tuozhu Technology Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, -00531, -00532, -00585, -00511, Paper 10 at 3. Thus, this additional circumstance weighs against discretionary denial.

Having amended the complaint to include the newly issued child patent, the '265 Patent, Patent Owner argues that "Petitioner has only requested review of three of [the four asserted] patents" in the parallel ITC Investigation. Paper 8 at 25. This argument is moot as a PGR petition is forthcoming to challenge the '265 Patent, which was added to the ITC case via an amended complaint. *Compare* Ex-1016 (original complaint asserting just three patents, filed February 11, 2025) with Ex-2009 (amended complaint asserting an additional fourth patent).

Due to the multi-patent litigation spanning multiple jurisdictions and the diverse technology, discretionary denial is inappropriate.

VI. THE FIRST FIVE *FINTIV* FACTORS ARE OVERALL NEUTRAL OR SLIGHTLY AGAINST DENIAL

While there is a co-pending ITC investigation, when viewed holistically, as detailed below, the first five factors are overall neutral or slightly against denial. When viewed against the remaining circumstances highlighted above, the overall

discretionary-denial analysis is against denial (*infra* Section VII). A discussion of the first five factors follows next.

A. Factor 1

The co-pending district court litigation involving the '209 Patent has been stayed and that stay will remain in place until the completion of the co-pending ITC investigation. *See* Case No. 1:25-cv-00143-JLH, Dkt. No. 12.

While the co-pending ITC Investigation is not currently stayed, Patent Owner's characterization that "all of the issues raised by the IPR are present in the parallel ITC investigation" is misleading and incomplete. Paper 8 at 11. The co-pending ITC Investigation does **not** have 100% overlap with the claims challenged in the '209 Patent. While the instant Petition covers all the claims of the '209 Patent (claims 1-18), Patent Owner has only asserted claims 6, 8-9, 11, 14-17 in the ITC Investigation. That's a *minimum* of ten claims that would only be addressed by the Board, and likely more given the nature of claim narrowing at the ITC, and it is therefore only through this IPR proceeding that Petitioner can obtain complete relief.

Further, the invalidity grounds asserted in the ITC do not overlap 100% with the invalidity grounds outlined in the instant Petition. Unlike the ITC, this Petition relies on Klein Tools Fish Tape in view of Southwire Glow in the Dark Fish Sticks. *See* Ex-1024. Thus, that ground at issue in this PGR will likely never be

considered by the ITC.

B. Factor 2

The district court action is currently stayed and the stay, as explained in §A, will remain in place until at least June 18, 2026, which is the current ITC's Target Date. Thus, the district court action will unlikely be tried before the Board's projected deadline of November 21, 2026 for a Final Written Decision ("FWD").

While the co-pending ITC's Target Date is currently scheduled in advance of the Board's FWD, it is likely this date will be extended. As was seen in a different proceeding between the same parties, the ITC extended the Target Date not once but twice due to "complexity of the issues raised" and "current constraints on judicial resources." *See* Ex-1025, Ex-1026. As the co-pending Investigation is currently covering four different patents and very diverse subject matter (Helmets and Glow Tape) and the parties are the same, it is likely the Target Date will have to be extended as well, closing the gap between the Board's FWD and the ITC's Target Date.

Further, Petitioner filed its petition on April 21, 2025, a month from when the ITC investigation was instituted on March 19, 2025, an exceptionally prompt filing timetable. Institution would thus directly serve the Congressional goal of the IPR procedure under the America Invents Act ("AIA") to provide "a quick, inexpensive, and reliable alternative to district court litigation to resolve questions

of patent validity.” S. REP. NO. 110-259, at 20 (2008).

Further, as explained in §A, the ITC’s final determination will not address all the claims challenged in the instant Petition and may not address any invalidity contentions at all. Nor can the ITC trigger the patent-owner estoppel of 42.73(d), because only the Board can do that and help settle expectations around the open prosecution for this patent family.

Even if the ITC did address 100% of the issues present in the instant Petition, a decision in the ITC has no preclusive effect. *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1570 (Fed. Cir. 1996); *Ingevity Corp. v. Int’l Trade Comm’n*, No. 2020-1800, 2021 WL 3440786, at *6 (Fed. Cir. July 21, 2021). Ultimately, the ITC cannot provide Petitioner with complete relief.

C. Factor 3

Petitioner moved to stay the co-pending district court case—which was unopposed and granted—at the start of the case, and thus there was no investment in that parallel proceeding as the entirety of the case had yet to begin.

And while the ITC investigation has proceeded along further than the district court litigation, as explained in §A, it does not cover all the claims of the ’209 Patent like the Petition here does. Given that Petitioner is likely to have to narrow further in the ITC proceeding, institution of this IPR is both appropriate and necessary.

Additionally, Petitioner and Patent Owner are currently before the District of Delaware in the stayed, co-pending District of Delaware case. Regardless of the outcome of the ITC, Petitioner and Patent Owner will still have to subsequently litigate the matter in federal district court both because an ITC determination has no preclusive effect and because the ITC's remedies are limited to exclusion orders and cease and desist orders. The cost of the District Court litigation far exceeds the costs compared to an IPR. Therefore, the PTAB route would be a more efficient use of party, judicial, and Board resources (particularly given the Board's unique ability to invoke 42.73(d) estoppel, which no other forum can do) than resorting to District Court litigation.

D. Factor 4

Because the co-pending district court case, as explained in §A, is stayed and will likely remain stayed until at least the Board's statutory deadline for a FWD in the instant proceedings, there is no overlap of issues in the two proceedings due to the estoppel provision of 35 U.S.C. § 315(e)(2).

With respect to the co-pending ITC investigation, as explained in §A, there is limited overlap in claims and invalidity contentions. Further, because the ITC's decision cannot invalidate a patent, no matter what the resolution is in the ITC, Petitioner will still need to seek relief at the Board.

E. Factor 5

Petitioner agrees that the parties involved in the noted litigation and present IPR are the same. Thus, Factor 5 is neutral or slightly favoring denial.

Overall, the first five factors are neutral or slightly against denial. As explained next, when viewed holistically alongside the other circumstances detailed at the beginning of this brief, the overall discretionary-denial analysis is pushed overwhelmingly against denial.

VII. ADDITIONAL CIRCUMSTANCES (FACTOR 6) MOVE THE OVERALL WEIGHT OF THE *FINTIV* FACTORS OVERWHELMINGLY AGAINST DISCRETIONARY DENIAL

A. Factor 6

As described in Sections II-V, numerous other factors counsel against discretionary denial of the Petition, that the '209 Patent is young and this challenge is prompt (§III), the Petition is strong (§IV), and the litigation is complex with diverse technology (§V).

When viewed holistically, these factors, and the issues described in the *Fintiv* Factors, such as (i) uncertainty as to whether the ITC will reach the invalidity issue, (ii) the ITC's inability to preclude prior art invalidity litigation in District Court litigation, and (iii) the parallel District Court litigation remains stayed in its infancy and thus is far behind the Board schedule, the efficiency and

integrity of the IPR process and the Congressional intent of the AIA is best served by instituting review. In particular, as the Director has recently explained, evidence of material error by the Office can outweigh other factors. *Padagis US LLC v. Neuraelis, Inc.*, IPR2025-00464, Paper 12 (July 16, 2025). *See also, Microsoft Corp. v. Partec Cluster Competence Center GMBH*, IPR2025-00318, Paper No. 9 (June 12, 2025).

VIII. CONCLUSION

For the reasons set forth above, discretionary denial of the Petition is inappropriate. Institution of *inter-partes* review is the appropriate result in view of the overall circumstances here.

Dated: August 21, 2025

Respectfully Submitted,

/ Alexander B. Stein /

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

CERTIFICATE OF COMPLIANCE

The undersigned certifies that the foregoing **PETITIONER’S
OPPOSITION TO PATENT OWNER’S DISCRETIONARY DENIAL
BRIEF** contains 4085 words, 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: August 21, 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 August 21, 2025 an electronic copy of this PETITIONER'S OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL 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: August 21, 2025

Respectfully submitted,

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