

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. 11,713,209

Case No. IPR2025-00892

**PATENT OWNER'S REPLY TO REQUEST FOR
DISCRETIONARY DENIAL OF *INTER PARTES REVIEW***

TABLE OF CONTENTS

	<u>Page</u>
I. There is Complete Overlap Between the Petition and ITC, Contrary to Petitioner’s Assertions	1
II. The ITC is Well-Suited to Resolve Petitioner’s Validity Challenges Before Any FWD.....	2
III. An Early Challenge Does Not Outweigh Efficiencies And Fairness Concerns	2
IV. Petitioner’s Patentability Challenge is Weak.....	4
V. Petitioner’s Estoppel Argument Is Not Compelling.....	5

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Arm Ltd. v. Daedalus Prime LLC</i> , IPR2025-00207, Paper 10 (May 16, 2025).....	3
<i>Klein Tools, Inc. v. Milwaukee Elec. Tool Corp.</i> , IPR2024-01400 and -01401	3
<i>Phison Elecs. Corp. v. Vervain LLC</i> , PGR2025-00010, Paper No. 14 (July 10, 2025).....	3, 4
<i>Shenzhen Tuozy Tech. Co., Ltd. v. Stratasys, Inc.</i> , IPR2025-00438, Paper 9 (July 9, 2025)	2
<i>Tesla, Inc. v. Intell. Ventures II LLC</i> , IPR2025-00217, Paper 8 (May 27, 2025).....	2

TABLE OF EXHIBITS

<u>Exhibit #</u>	<u>Description</u>
2001	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
2002	Email between Counsel re Motion to Stay, dated between March 24-25, 2025
2003	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
2004	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
2005	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
2006	United States Patent and Trademark Office Memorandum re Interim Processes for PTAB Workload Management, March 26, 2025
2007	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
2008	Excerpt of First Supplemental Domestic Industry Claim Chart for U.S. Patent No. 11,713,209, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442
2009	Klein Tools New Glow Fish Tape Perfect for Low Light Applications, December 17, 2020

<u>Exhibit #</u>	<u>Description</u>
2010	Excerpts of Techtronic Industries Annual Report 2023
2011	United States Patent and Trademark Office FAQs for Interim Processes for PTAB Workload Management
2012	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
2013	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
2014	Respondent’s Opening Claim Construction Brief, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, June 30, 2025
2015	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
2016	Email from M. Doukas to Klein Tools Counsel, dated August 21, 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 '209 Patent.” *See* Opp. at 11 (§7.1 (Factor 1)), 13 (§7.2 (Factor 2), 13 §7.3 (Factor 3)), and 14 (§7.4 (Factor 4)). This is false. There is complete overlap between the claims at issue in both proceedings. Ex. 2015 at 84 (“Claims 1-4, 6, and 8-18 are obvious under 35 U.S.C. § 103 in view of European Patent No. 1,391,412 to Hartranft (‘Hartranft’) combined with International Publication No. 1997/41626 to Bruin (‘Bruin’)); *id.* (“Claims 5 and 7 are obvious under 35 U.S.C. § 103 in view of Hartranft, Bruin, and U.S. Patent No. 5,505,432 to Noonan (‘Noonan’)). *See, e.g.*, Paper 2 at 2 (“Claims 1-4, 6, and 8-18 are unpatentable ... in view of Hartranft and Bruin.”); *id.* (“Claims 5 and 7 are unpatentable ... in view of Hartranft, Bruin, and Noonan.”). This error infects Petitioner’s entire opposition and renders its *Fintiv* analysis fatally flawed.

Not only are the same claims at issue, but Petitioner is also asserting essentially the same grounds in the ITC.¹ *See* Ex. 2015. Petitioner has not removed

¹ Petitioner’s grounds were all included in its ITC contentions. Petitioner now suggests that it does not intend to pursue one ground at the ITC. Opp. at 11-12. But an email saying a party does not intend to address a combination in an opening expert report is no stipulation and does not stop cross-forum duplication. Ex-2016.

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 FWD, it is likely this date will be extended.” Opp. at 12 (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 ’209 Patent” due to the “complex[ity]” of the litigation. Opp. at 8-9. 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 Petitioner asserts the ’209 Patent and U.S. Patent No. 12,187,573 are “patentably indistinct.” Opp. at 1-2.

III. AN EARLY CHALLENGE DOES NOT OUTWEIGH EFFICIENCIES AND FAIRNESS CONCERNS

A central factor in the discretionary denial analysis is the relative timing of the parallel ITC proceeding and the PTAB’s projected FWD. Here, the ITC trial is scheduled to conclude one year before the PTAB’s FWD, and the ITC’s entire investigation will be completed five months before the PTAB’s FWD deadline. *See* Patent Owner’s Discretionary Denial brief at 8–9. This timing weighs heavily in favor of discretionary denial, as recognized in multiple recent decisions by the Director. For example, in *Arm Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper 10 at 2 (May 16, 2025), the Director granted discretionary denial where the ITC’s evidentiary hearing and initial determination would be completed well before the PTAB’s FWD. Similarly, in an inter partes review involving the same parties here—but in opposite roles—the Director reversed institution where the ITC was scheduled to issue a final determination six months before the PTAB’s FWD, finding that the advanced stage and timing of the ITC proceeding strongly favored denial. *Klein Tools, Inc. v. Milwaukee Elec. Tool Corp.*, IPR2024-01400, Paper No. 22 at 2-3 (June 9, 2025).

In addition to efficiency, discretionary denial is appropriate to avoid duplicative proceedings, conserve resources, and prevent inconsistent outcomes regardless of whether the proceeding is an IPR or PGR. *See Phison Elecs. Corp. v. Vervain LLC*, PGR2025-00010, Paper No. 14 (July 10, 2025). Further, the “absence of [] a stipulation tips the balance in favor of discretionary denial.” *Id.* at

3. As noted above, Petitioner failed to execute any *Sotera* (or other) stipulation here. Accordingly, while the perceived lack of “settled expectations” is a factor, it does not outweigh the efficiency concerns present here.

IV. PETITIONER’S PATENTABILITY CHALLENGE IS WEAK

Petitioner contends that the Examiner erred by not identifying Hartranft, KP1, and SP1 during examination, apparently in response to an argument that institution should be denied under 35 U.S.C. § 325(d). However, Patent Owner never presented a section 325(d) argument in its Discretionary Denial brief. *See* Patent Owner’s Discretionary Denial brief. Instead, Patent Owner argues that the *Fintiv* factors strongly favor denying institution, and the weakness of the Petition supports discretionary denial. *Id.* at 13-14. The weakness of the Petition is evidenced by the fact that none of the applied references discloses a key limitation that appears in every Challenged Claim, *i.e.*, “luminescent” “fish tape.” *Id.*

In an attempt to back fill, Petitioner contends that fish tape and fish sticks are both wire/cable pullers and newly contends that Patent Owner’s “advertising materials” confirm that “the fish tape housed within their Klein Glow Fish Tape cases ‘also function as a super-flex glow rod.’” *Opp.* at 6-7 (citing Ex-1014). Petitioner’s reliance on Exhibit 1014, which is a commercial embodiment of a glow fish tape, is improper at least because (i) Petitioner expressly acknowledges that this product was introduced “after the filing date” of the ’209 Patent and

therefore does not qualify as prior art under 35 U.S.C. § 102, Pet. at 60, and (ii) Petitioner did not include this argument in its Petition. Arguments or evidence based on a product that post-dates the effective filing date of the challenged patent cannot be used to demonstrate obviousness or anticipation, nor can they be used in an IPR to support the contention that the claimed invention was known or obvious at the effective filing date of the '209 patent.

V. 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. Furthermore, under § 42.73(d), patent owner estoppel only attaches once a claim is finally refused or canceled in a PGR, which does not occur until a PGR certificate issues under 37 C.F.R. § 42.80. This finality is only reached after appeals are exhausted—a lengthy, uncertain, and speculative process. 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.

Case No. IPR2025-00892
U.S. Patent No. 11,713,209

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
Joyce Guo
Morgan, Lewis & Bockius LLP
1400 Page Mill Road
Palo Alto, CA 94304
Email: alexander.stein@morganlewis.com
Email: joyce.guo@morganlewis.com

David P. Bernstein
Morgan, Lewis & Bockius LLP
1301 Second Avenue, Suite 3000
Seattle, WA 98101
Email: david.p.bernstein@morganlewis.com

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

Email: GlowFish-Metco-Klein-PTAB@morganlewis.com

Date: September 2, 2025

/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