

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 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.	PETITIONER’S PATENTABILITY CHALLENGE IS STRONG.....	4
IV.	CONCLUSION	5

Table of Exhibits

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	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	U.S. Patent Application No. 18/968084 (“’084 Application”) as filed December 4, 2024
Ex-1024	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
Ex-1025	INV. No. 337-TA-1409, Order No. 22
Ex-1026	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 ’209 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

¹Petitioner 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 at 11.

and—unlike the ITC—the Board’s review has the potential to invoke patent-owner estoppel. Without that potential, PO 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 stated, “[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 at 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 (issued in 2024, 2023, and 2021—the instant Patent issued in 2023) can outweigh the fact that a final written decision would be unlikely to issue before occurrence of a district court trial. *Zhuhai Cosmx Battery Co., Ltd., v. Ningde Amperex Technology Limited*, IPR2025-00432, 00431, -00405, -00389, -00385, Paper 9 at 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”).

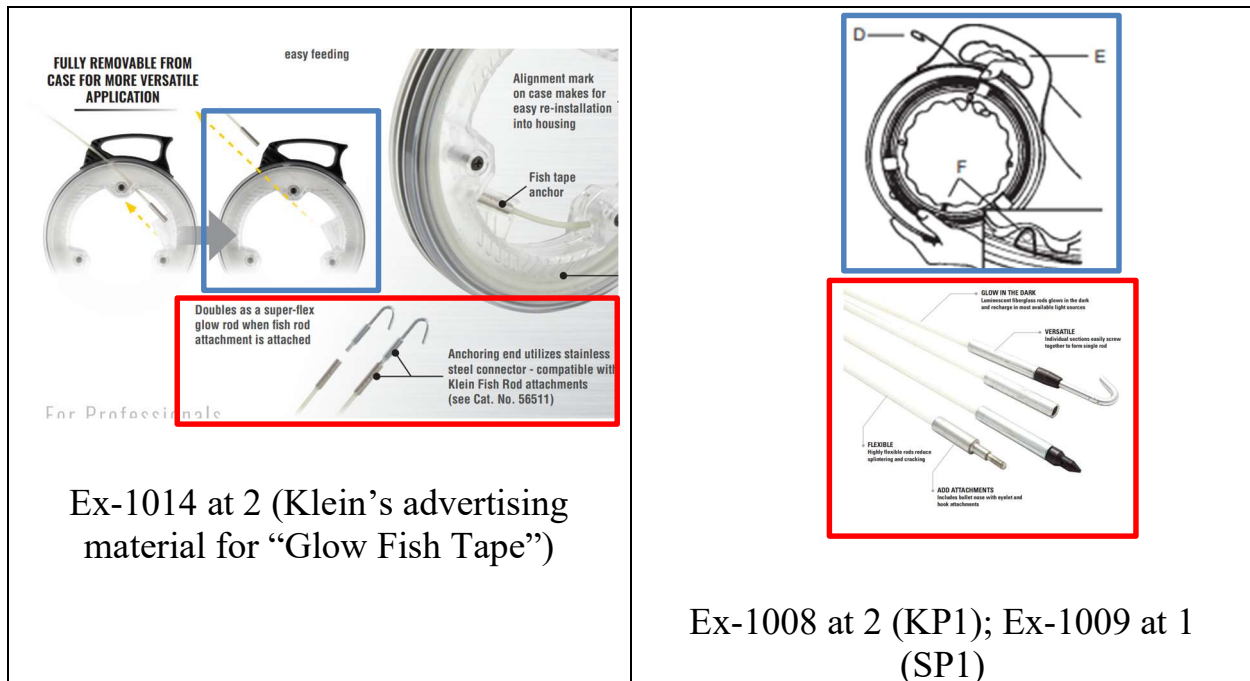
IPRs were created to provide a lower-cost, higher-quality resolution of patent-validity disputes as compared to complex parallel proceedings in the ITC or district court. Here, PO has invoked a common litigation strategy of asserting numerous patents (four patents from two different patent families covering 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 Patent at issue to be challenged before the Office, which is uniquely positioned to assess complex issues of claim validity.

While PO argues that allowing this proceeding would be opening the door to any challenges involving patents with continuation applications, this is simply not true. Paper 12 at 5. Here, the Patent at issue is young. It issued in 2023, and the instant Petition was filed less than two years after the issue date. Ex-1002 at 237. 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 related PGR2025-00048, another early, diligent challenge to a young patent in the same family. Paper 11 at 3-4. These are factors that strongly weigh against discretionary

denial and are not ubiquitous across all challenged patents with continuation applications.

III. PETITIONER'S PATENTABILITY CHALLENGE IS STRONG

PO reiterates an argument that fish tape and fish sticks are not both wire/cable pullers, but also adds an allegation that Petitioner has improperly relied on PO's advertising materials because (allegedly) such materials do not qualify as prior art. Not so. The advertising materials show that PO has been inconsistent in how its claimed invention is to be understood. *See* Ex-2007 at 13, 45 (First Amended Complaint in the parallel ITC proceeding, Investigation No. 337-TA-1442, in which PO contends that the very same "Glow Fish Tape" advertised in Ex-2014 embody the Asserted Patents). As shown in the annotated images below, on the left PO advertises that its "Glow Fish Tape" can double as a "super-flex *glow rod*" (annotated in red) that is "fully removable from case" (annotated in blue). Yet, here, PO argues that SP1's fish sticks (annotated in red) "are not interchangeable with fish tape" and "could not be stored in, deployed from, or reloaded" into KP1's fish tape case (annotated in blue). Paper 8 at 14. As demonstrated by PO's own advertising material below, it refers to fish tape as something that can double as a glow "rod" thus undermining its assertions as to fish sticks.



IV. CONCLUSION

Although there is overlap of the claims and some of the invalidity grounds, that is not dispositive. The PTAB 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 /

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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)
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Dated:
September 5, 2025

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