

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Stanley Black & Decker, Inc.
Petitioner

v.

Howmet Aerospace Inc.
Patent Owner

IPR2025-01581
U.S. Patent No. 11,885,358

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

TABLE OF CONTENTS

I.	This IPR Should Be Instituted To Correct Errors The PTO Now Recognizes	3
A.	The PTO Erred By Not Rejecting The '358 Patent In View Of Brewer (Petitioner's Grounds A and C).....	4
B.	The PTO Erred By Not Rejecting The '358 Patent Over Corbett In View Of Brewer (Petitioner's Ground A).....	5
II.	35 U.S.C. § 325(d) Supports Institution Because Petitioner Raises New Prior Art, New Arguments, And PTO-Acknowledged Errors	6
A.	Ground A: § 325(d) Favors Institution Because Petitioner Raises Noncumulative New Art, New Arguments, And PTO Error.....	6
1.	<i>Advanced Bionics</i> Part 1 Favors Institution Because Corbett Is New And Highly Material	6
2.	<i>Advanced Bionics</i> Part 2 Favors Institution Because The PTO Erred By Not Rejecting Challenged Claims 1 and 16 Over Ground A (Corbett+Brewer).....	9
B.	Ground C: <i>Advanced Bionics</i> Part 2 Favors Institution Because Ground C (Kleinman+Brewer) Raises An Error The PTO Now Acknowledges	10
III.	<i>Fintiv</i> Strongly Favors Institution.....	11
A.	<i>Fintiv</i> Factor 1 Strongly Favors Institution Because A Stay Is Likely.....	11
B.	<i>Fintiv</i> Factor 2 Strongly Favors Institution Because A FWD Is Due Almost A Year Before The Likely <i>Delaware</i> Trial Date.....	12
C.	<i>Fintiv</i> Factor 3 Strongly Favors Institution Because There Has Been No Investment In The Recent <i>Delaware</i> Case.....	13
D.	<i>Fintiv</i> Factor 4 Strongly Favors Institution Because Petitioner's Strong <i>Sotera</i> + Stipulation Prevents Overlap Between The Proceedings	13
E.	<i>Fintiv</i> Factor 5 Favors Institution Because Petitioner's Stipulation Binds The <i>Delaware</i> Defendants.....	13
F.	<i>Fintiv</i> Factor 6 Strongly Favors Institution To Correct A PTO Error.....	14

IV.	Petitioner’s Settled Expectations Of Invalidity and Prompt Filing Of This IPR Against PO’s 2024 Patent Favor Institution	14
V.	Petitioner And The <i>Delaware</i> Defendants Have Not Pursued Inconsistent Constructions.....	15
VI.	Petitioner’s Reserved Indefiniteness Defenses Do Not Impact This IPR	15
A.	Petitioner’s Invalidity Grounds Satisfy The “Pull Region Compr[is]ing An Axial Length” Limitation Under Petitioner’s Proposed Construction Or PO’s Contradictory Constructions	16
B.	Petitioner’s Invalidity Grounds Satisfy The “Diameter” Limitation Under Any Feasible Construction.....	17
C.	Petitioner’s Invalidity Grounds Satisfy Dependent Claim 10’s “Generally Cylindrical” Limitation Under Any Feasible Construction	18
D.	Conclusion: Petitioner’s Reserved Indefiniteness Defenses Do Not Impact Petitioner’s Invalidity Grounds.....	18
VII.	PO’s Misrepresentation Of Petitioner’s Expert’s Opinions Cannot Support Discretionary Denial	18
VIII.	Petitioner’s Search Disclosure Declaration Favors Institution.....	19
IX.	Conclusion	19
	Certificate of Service	21

This is a textbook example of an IPR that should be instituted, not discretionarily denied.

First and foremost, during prosecution of a continuation of the challenged '358 Patent, the PTO Examiner adopted and expressly “mirror[ed]” Petitioner’s Invalidity Ground A to reject continuation claims that are narrower than the challenged claims. Ground A combines the material new Corbett reference with a Brewer reference that teaches the exact L:D ratio limitation that was erroneously found to be missing from the prior art during prosecution of the '358 Patent. The Examiner agrees with Petitioner. This IPR should be instituted to (a) correct this PTO-acknowledged error, and (b) resolve the inconsistency between the PTO’s erroneous grant of PO’s '358 Patent and well-founded rejection of PO’s narrower continuation.

Second, this PTO-recognized error and Petitioner’s reliance on new art and arguments strongly counsel against discretionary denial under 35 U.S.C. § 325(d).

Third, *Fintiv* strongly favors institution instead of deferral to PO’s later-filed *Delaware* Case. The *Delaware* defendants’ pending motion to stay is likely to be granted. The Delaware Court routinely grants post-institution stays. The final written decision (“FWD”) here is due nearly a year before the likely *Delaware* trial date. And notably, the *Delaware* defendants have not yet filed an answer, instead seeking to dismiss key portions of the complaint. There remains no timeline for the

Delaware defendants to file their answer. As a result, there has been no schedule, Rule 26(f) scheduling conference, discovery, infringement/invalidity contentions, *Markman* proceeding, or court orders related to the '358 Patent, so there has been no investment in the *Delaware* case. Petitioner's strong *Sotera+* stipulation binds the *Delaware* defendants and prevents overlap between the invalidity grounds raised in these two proceedings.

Fourth, the parties' settled expectations support institution. The PTO's perpetual rejection of the narrower continuation claims settled Petitioner's expectation that the '358 Patent is invalid. PO has no contrary settled expectations as to its 2024 patent because Petitioner promptly filed this IPR in 2025.

Fifth, Petitioner and the *Delaware* defendants have not proposed inconsistent claim constructions and do not intend to do so. PO's speculation to the contrary is baseless.

Sixth, the indefiniteness issues raised by PO's inconsistent claim construction positions play no role in this IPR. Petitioner has shown how the challenged claims are unpatentable under Petitioner's best-effort proposed construction or any feasible alternative, including PO's contradictory patentability-driven and infringement-driven constructions.

Seventh, PO's misrepresentation of Petitioner's expert's opinions cannot support PO's request.

Eighth, Petitioner’s search disclosure declaration further favors institution.

These factors, as a whole, show that the Director should not discretionarily deny institution.

I. This IPR Should Be Instituted To Correct Errors The PTO Now Recognizes

The PTAB has a strong interest in instituting IPRs to correct “potential error[s]” where of-record or new prior art “appear[s] to disclose the claimed features that the patent examiner indicated were not taught by the prior art.” *Taiwan Semiconductor Mfg. Co. LTD. v. Marlin Semiconductor LTD.*, IPR2025-00847, Paper 11 at 4 (PTAB Sept. 3, 2025) (denying discretionary denial based on of-record art); *see also Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13 at 2 (PTAB June 25, 2025) (same); *Carbyne Inc. v. Tritech Software Sys.*, IPR2025-00959, Paper 11 at 2 (PTAB Oct. 3, 2025) (denying discretionary denial because “the Marr reference—cited on an IDS during prosecution—appears to disclose the purportedly missing claim limitations”); *Pradagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 3 (PTAB July 16, 2025) (“[T]he Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error.”) (designated informative); 3/26/25 Interim Processes for PTAB Workload Management Memo at 2 (“strength of the unpatentability challenge”).

The PTO effectively acknowledged that the ’358 Patent was granted in error

by rejecting narrower claims in a continuation (Ser. No. 18/404,525)

(“Continuation”) of the ’358 Patent over (A) of-record U.S.P.A.P.

2016/0215808A1 (Ex. 1004) (“Brewer”) and/or (B) new U.S.P.A.P.

2018/0111184A1 (Ex. 1003) (“Corbett”).

A. The PTO Erred By Not Rejecting The ’358 Patent In View Of Brewer (Petitioner’s Grounds A and C)

During prosecution of the ’358 Patent, PO persuaded the PTO that the prior art lacked a “pull region compris[ing] an axial length no greater than **4 times** a diameter of the shank region” (“L:D Ratio Limitation”), “as recited in [challenged] claim[s] 1” and 16. Ex. 1011 at 2-5¹; Petition at 4.

The present IPR Petition showed this to be error because “Brewer’s **0.936** L:D ratio falls squarely within the ‘no greater than 4’ L:D [R]atio” Limitation. Petition at 9; *see also id.* at 4 (“Brewer already taught” the L:D Ratio Limitation.); Brewer (Ex. 1004) at ¶ [0076] (“L=0.936D”); *id.* at ¶¶ [0025], [0072], [0075], and FIG. 5b.

The PTO now agrees with Petitioner. Continuation claims 1, 25, and 35 are substantively similar to challenged claims 1 and 16, but narrow the L:D Ratio Limitation to no greater than “**3**,” “**1.5**,” or “**1**,” respectively. Ex. 1024 at 2, 4, 6; Ex. 1001 at claims 1, 16; Ex. 1029 (redline comparison of challenged claim 1 to

¹ Page citations are based on each document’s internal pagination.

Continuation claim 1). The Examiner has perpetually rejected the narrower Continuation claims, including twice over a less material reference (Makino (Ex. 1012)). Ex. 1007 at 5; Ex. 1013 at 2. Once this IPR highlighted Corbett's and Brewer's relevance, the Examiner expressly adopted and "mirror[ed]" Petitioner's Ground A (Corbett+Brewer) to reject the narrower Continuation claims. 12/05/25 Office Action (Ex. 1025) at 4, 5. The Examiner agreed that Brewer taught the L:D ratio whose alleged absence from the prior art resulted in the grant of the '358 Patent. Ex. 1025 at 4 ("Brewer discloses [that] the pull region has a length (L) less than 1 times a major shank diameter (D)[.]"). The Examiner also now agrees with Petitioner's Ground A that it was obvious to replace the pull region of Corbett's blind fastener "with a pull region a[s] disclosed in Brewer." *Id.*

This record also shows that the PTO erred by not similarly rejecting the challenged claims as obvious over another blind fastener (Kleinman (Ex. 1006)) in view of Brewer, as explained in Petitioner's Ground C.

B. The PTO Erred By Not Rejecting The '358 Patent Over Corbett In View Of Brewer (Petitioner's Ground A)

PO failed to cite Corbett during prosecution of the '358 Patent, despite Corbett being PO's own highly material prior art. Ex. 1001, cover sheet; Ex. 1026; Section II.A.1, below. The PTO uncovered Corbett during prosecution of the Continuation, and then rejected narrower Continuation claims as anticipated by Corbett, which highlights Corbett's materiality. Ex. 1025 at 3.

The PTAB should institute this IPR to correct the PTO's error in not rejecting the challenged claims over Corbett or Kleinman in view of Brewer, and to resolve the inconsistency between the PTO's grant of the '358 Patent and rejection of the narrower Continuation claims.

II. 35 U.S.C. § 325(d) Supports Institution Because Petitioner Raises New Prior Art, New Arguments, And PTO-Acknowledged Errors

The Board considers 35 U.S.C. § 325(d) using a “two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). This framework supports institution because Petitioner's Grounds A and C raise new art, new arguments, and/or PTO error.

A. Ground A: § 325(d) Favors Institution Because Petitioner Raises Noncumulative New Art, New Arguments, And PTO Error

Petitioner's Ground A (Corbett+Brewer) shows that § 325(d) discretionary denial is inappropriate under *Advanced Bionics* Parts 1 or 2.

1. Advanced Bionics Part 1 Favors Institution Because Corbett Is New And Highly Material

Corbett was not of record during prosecution of the '358 Patent, despite

being PO's own highly material prior art. Ex. 1001, cover sheet; Section I.B, above; Ex. 1026; Ex. 1025 at 3. PO tries to evade inequitable conduct by alleging that Corbett is cumulative to the of record Kleinman reference. Paper 9 at 13. The record refutes PO's position and proves Corbett's materiality in three ways.

First, Corbett's pull-region-length-to-shank-diameter (L:D) ratio is clearly smaller than Kleinman's, making Corbett more material to the "no greater than 4" L:D Ratio Limitation in the challenged independent claims. *See* Petition at 2; Corbett (Ex. 1003) at FIG. 1; Kleinman (Ex. 1006) at FIG. 2A. The PTO highlighted Corbett's materiality by finding that Corbett anticipated the L:D ratio limitations in Continuation claims 1 and 3. Ex. 1025 at 3 (finding that Corbett's "pull region is clearly shown to have a length less than 2 times the major shank diameter (see Fig. 1)"); Ex. 1024 at 2-3.

Second, Corbett's explicit disclosure of the "collet" recited in challenged independent claim 16 makes Corbett more material than Kleinman's generic "jaws." *Compare* Petition at 42, *with, id.* at 72-73; Corbett (Ex. 1003), ¶ [0012]; Kleinman (Ex. 1006), ¶ [0031].

Third, PO's own arguments during prosecution show that Corbett's non-breakneck fastener is more material than Kleinman's breakneck fastener. For context, the fasteners in Kleinman and applied reference Jones have a breakneck that causes the pin/mandrel to break off during installation. Kleinman (Ex. 1006) at

FIGS. 1A, 5B-6B, ¶ [0020] (“breakneck 16”); Jones (Ex. 1010), ¶ [0025] (“[T]he installation force will break the pin ... at the nearest exposed groove[.]”); Petition at 59-60. During prosecution, the PTO rejected the challenged claims as obvious over Jones. Ex. 2005 at exhibit p. 39. PO responsively equated the L:D Ratio Limitation with the omission of a breakneck,² and distinguished Jones’ breakneck fastener on this basis. Ex. 1011 at 5 (“[T]he pull region of the fastener recited in claim 1 can remain intact after installation.... *Jones* does not teach this advantage.... *Jones* explicitly teaches that ‘the installation force will break the pin.’”); *id.* at 3 (“The pull region comprising an axial length no greater than 4 times a diameter of the shank region can enable the pull region to remain intact after installation[.]”); Paper 9 at 3 (PO emphasizing that the ’358 Patent’s fastener may be installed using “less than a force that can fracture the mandrel”).

Unlike Jones’ and Kleinman’s breakneck fasteners, Corbett’s fastener has no breakneck so Corbett’s “pull portion 28 remains as part of the shank 16 after installation.” Corbett, ¶ [0014]; Petition at 34. Corbett taught exactly what PO argued was missing from the prior art of record during prosecution of the ’358 Patent, and the Examiner handling the continuation agrees. *Id.*; Ex. 1025 at 3

² Petitioner disputes PO’s argument, but this dispute is immaterial because challenged claim 5 requires that the pin “not comprise a breakneck groove.”

(finding that Corbett has “no breakneck groove”). Under PO’s own prosecution argument (or when applied to the non-breakneck limitation in challenged claim 5), Corbett’s non-breakneck fastener is more material than Kleinman or Jones.

Compare Petition at 34, 45, *with, id.* at 59-60, 76.

Corbett is highly material and non-cumulative, so Ground A (Corbett+Brewer) does not rely on the same or substantially the same art or arguments previously presented to the Office. Discretionary denial is inappropriate under *Advanced Bionics* Part 1, and Part 2 need not be considered.

2. *Advanced Bionics* Part 2 Favors Institution Because The PTO Erred By Not Rejecting Challenged Claims 1 and 16 Over Ground A (Corbett+Brewer)

Even if Corbett was cumulative (it was not), *Advanced Bionics* Part 2 counsels against discretionary denial because the PTO erred by not rejecting the challenged claims over Ground A (Corbett+Brewer). The PTO now effectively acknowledges its error.

The PTO never applied Corbett, Brewer, or any substantially similar reference or argument during prosecution. Ex. 2005. This IPR Petition (at 4, 9, 16-31, 41-44) shows how Brewer taught the exact L:D Ratio Limitation that was erroneously found missing from the prior art during prosecution of the ’358 Patent, which proves that Brewer is more material than any reference applied during prosecution of the ’358 Patent. Ex. 1011 at 2-5; Ex. 2005; Section I.A., above. The

PTO's rejection of the narrower Continuation claims over Petitioner's Ground A (Corbett+Brewer) shows that the PTO erred in granting the broader challenged claims in the parent '358 Patent. *See* Section I.A., above; Ex. 1025 at 4. The PTO thus erred in a manner material to the patentability of the challenged claims, so *Advanced Bionics* Part 2 counsels against discretionary denial. These facts likewise show that *Becton Dickinson* factors (c), (d), and (f) favor institution.

B. Ground C: *Advanced Bionics* Part 2 Favors Institution Because Ground C (Kleinman+Brewer) Raises An Error The PTO Now Acknowledges

Counterparts of Kleinman and Brewer were cited during prosecution of the '358 Patent (a fact Petitioner neither hid nor disputed), so the § 325(d) analysis focuses on *Advanced Bionics* Part 2. Part 2 counsels against discretionary denial because the PTO erred by not rejecting challenged claims 1 and 16 over Ground C (Kleinman+Brewer), as analogously explained above in Section II.A.2. regarding similar Ground A (Corbett+Brewer).

The PTO never applied Kleinman, Brewer, or any substantially similar reference or argument during prosecution. Ex. 2005. The present IPR Petition (at 4, 9, 48-57, 71-76) showed how Brewer taught the exact L:D Limitation that was erroneously found missing from the prior art during prosecution of the '358 Patent, which proves that Brewer is more material than any reference applied during prosecution. Ex. 1011 at 2-5; Ex. 2005; Section I.A., above. This record shows that the PTO erred in a manner material to the patentability of the challenged claims, so

discretionary denial is inappropriate under § 325(d) and *Advanced Bionics* Part 2. For the same reasons, *Becton Dickinson* factors (c)-(f) strongly favor institution.

In sum, § 325(d) favors institution because Grounds A and C raise new prior art, new arguments, and/or PTO errors that the PTO now acknowledges.

III. Fintiv Strongly Favors Institution

PO filed its *Delaware* Case after and in response to this IPR Petition in a slow jurisdiction that routinely grants stays. Ex. 2007 at 32. All *Fintiv* factors favor referral/institution.

A. Fintiv Factor 1 Strongly Favors Institution Because A Stay Is Likely

A stay here is likely because Petitioner filed this IPR before PO filed suit. The *Delaware* defendants moved for a stay before even answering PO's complaint. Ex. 1028 at 2. That motion is likely to be granted because (1) Petitioner's *Sotera*+ stipulation ensures simplification, (2) the case is in its infancy, and (3) PO would not be prejudiced. Ex. 1028 at 4-14.

PO's assertion that Judge Hall "has denied pre-institution stays" (Paper 9 at 16) is misguided because *Fintiv* looks to whether a stay is likely "if a proceeding is instituted." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020). The Delaware Court routinely stays cases if an AIA proceeding is

instituted. *See* Exs. 1031-1034.³ PO's asserted 40+% denial rate is deceptively padded with inapplicable pre-institution decisions, motions that did not involve a parallel AIA proceeding, and cases involving non-estopped defendants. Paper 9 at 16; Ex. 2006 at 4-6. Here, Petitioner's *Sotera*+ estoppel stipulation (Paper 8) binds the *Delaware* defendants, making a stay all the more likely.

A post-institution stay here is very likely, so *Fintiv* Factor 1 strongly favors institution.

B. *Fintiv* Factor 2 Strongly Favors Institution Because A FWD Is Due Almost A Year Before The Likely *Delaware* Trial Date

The *Delaware* Case was filed after this Petition, and the *Delaware* defendants have not even filed their answer, so there is no schedule or trial date. Ex. 1030. Accordingly, not only is there no schedule or trial date, but there is no present timeline by which the *Delaware* defendants must file an answer. PO admits that "if the *Delaware* Case proceeds according to [Delaware] median statistics, the trial for the *Delaware* Case would be in March of 2028." Paper 9 at 16-17. Even assuming PO's timeline is correct, which is dubious at best given there is currently no schedule at all, that date is still nearly a year after the April 28, 2027 deadline for the FWD in this IPR. This factor therefore strongly favors institution.

³ The denials in *Rotolight* and *RideShare* were pre-institution. Exs. 1032, 1033.

C. *Fintiv* Factor 3 Strongly Favors Institution Because There Has Been No Investment In The Recent *Delaware* Case

There has been no investment in the *Delaware* Case besides defendants' motions to stay and dismiss. Ex. 1030. There has been no answer, schedule, Rule 26(f) scheduling conference, discovery, infringement/invalidity contentions, *Markman* proceeding, or court orders related to the '358 Patent. Ex. 1028 at 3, 8; Ex. 1030. As a result, there will be very little investment in the *Delaware* Case before the April 28, 2026 institution deadline in this IPR, so this factor strongly favors institution.

D. *Fintiv* Factor 4 Strongly Favors Institution Because Petitioner's Strong *Sotera*+ Stipulation Prevents Overlap Between The Proceedings

Petitioner's strong *Sotera*+ Stipulation (Paper 8) favors institution and prevents overlap between this IPR and the *Delaware* Case by conditionally agreeing not to raise in the *Delaware* Case any prior art invalidity defense that "includes system art ... corresponding to any reference in the invalidity grounds raised in IPR2025-01581." Paper 8 at 2.

E. *Fintiv* Factor 5 Favors Institution Because Petitioner's Stipulation Binds The *Delaware* Defendants

Petitioner's *Sotera*+ stipulation binds the *Delaware* defendants as Petitioner's RPIs, and ensures that the *Delaware* Case will not involve the same or substantially the same issues as this IPR. This factor favors institution.

F. *Fintiv* Factor 6 Strongly Favors Institution To Correct A PTO Error

The PTO effectively acknowledged that it granted the '358 Patent in error, which shows the “particularly strong” merits of this IPR and favors institution.

Fintiv at 14; *see also* Section I, above.

The *Delaware* defendants “have not sold the Accused Product” in the U.S.,⁴ which suggests that PO responsively filed the *Delaware* Case as a pretext to evade institution. Ex. 1028 at 11; *see also* 90 Fed. Reg. 48335, 48341 (Oct. 17, 2025) (proposing that institution is appropriate where a parallel proceeding was “initiated in bad faith”). This favors institution to avoid rewarding such gamesmanship.

In sum, the *Fintiv* factors, as a whole, strongly support institution.

IV. Petitioner’s Settled Expectations Of Invalidity and Prompt Filing Of This IPR Against PO’s 2024 Patent Favor Institution

The PTO’s perpetual rejection of narrower Continuation claims gives Petitioner a settled expectation that the '358 Patent is invalid. *See* Ex. 1007 at 5; Ex. 1013 at 2; Ex. 1025 at 3-5; *Posco Co., LTD. v. Arcelormittal*, IPR2025-00370, Paper 10 at 2-3 (PTAB June 25, 2025) (denying discretionary denial because invalidation of a parent renders the challenged patent “highly vulnerable to invalidation”); 3/26/25 Interim Processes Memo at 2 (“Settled expectations”).

⁴ Petitioner and/or certain of its RPIs intend to sell the accused product in the U.S. in the future, but conservatively opted to file this IPR first to clear the deck.

Conversely, PO has alleged no settled expectations of its own. The '358 Patent (Ex. 1001) issued in 2024, and Petitioner promptly filed this IPR in 2025. *See, e.g., Resmed Corp. v. Cleveland Med. Devices, Inc.*, IPR2025-00246, Paper 10 at 2 (PTAB June 12, 2025) (finding that a 2025 IPR challenging a 2024 patent provided an “[e]arly challenge[] favor[ing] robust, predictable patent rights and weigh[ed] against discretionary denial”).

Petitioner’s settled expectation that the '358 Patent is invalid and Petitioner’s prompt filing of this IPR both favor institution.

V. Petitioner And The *Delaware* Defendants Have Not Pursued Inconsistent Constructions

PO baselessly alleges that Petitioner “attempt[s] to pursue inconsistent claim construction positions” here and in the *Delaware* Case. Paper 9 at 7. The *Delaware* defendants (Petitioner’s RPIs) have not even filed an answer, and have taken no claim construction positions, much less any inconsistent positions. Ex. 1030. PO’s speculation about positions the defendants might take has no basis in fact.

Petitioner has no reason to believe the defendants’ future claim construction positions will be at odds in any way with Petitioner’s positions in this IPR.

VI. Petitioner’s Reserved Indefiniteness Defenses Do Not Impact This IPR

Petitioner has shown how the challenged claims are obvious under Petitioner’s best-effort proposed construction or any feasible alternative, including PO’s contradictory patentability-driven and infringement-driven constructions. As

shown below, Petitioner's reserved indefiniteness defenses do not impact this IPR.

A. Petitioner's Invalidity Grounds Satisfy The "Pull Region Compris[ing] An Axial Length" Limitation Under Petitioner's Proposed Construction Or PO's Contradictory Constructions

Challenged claims 1 and 16 recite a "pull region compris[ing] an axial length." The ambiguous intrinsic record, PO's prosecution arguments, and U.S.⁵ claim construction law suggests that this limitation means "a region configured to be engaged by an installation tool," so that is Petitioner's proposed construction. *See* Petition at 11-15. PO's infringement contentions contradict its prosecution arguments by instead construing this limitation to mean "the pin protrusion," i.e., the portion of the pin/mandrel standing out from the collar (a.k.a. "standout"). Ex. 1027 at 6; *see also* Petition at 11-15. In an abundance of caution, Petitioner showed how Grounds A-D satisfy this limitation under Petitioner's best-effort proposed construction or PO's infringement-driven "standout" construction. *See* Petition at 27-28, 54. During prosecution of the Continuation, the PTO agreed that Ground A satisfies this limitation. Ex. 1025 at 4-5. The Board can and should invalidate the challenged claims without addressing Petitioner's reserved indefiniteness defense.

⁵ A different construction may be appropriate for PO's European counterpart patent, including because it is a different patent with different claims and based on differences between U.S. and European claim construction law.

B. Petitioner's Invalidity Grounds Satisfy The "Diameter" Limitation Under Any Feasible Construction

Challenged claims 1 and 16 recite that the claimed shank region has "a diameter." The '358 Patent offers contradictory definitions, so this term is indefinite as to which shank "diameter" is claimed. Petition at 26 n.3. Despite indefiniteness around the edges, Petitioner has proposed that "diameter" at least encompasses a major diameter because the '358 Patent identifies this major diameter d_3 as exemplary of the claimed "diameter." *Id.* at 26, 28-29; Ex. 1001 at 4:31-32 and FIG. 1. PO now implicitly agrees that the claimed "diameter" encompasses at least this major shank "diameter, d_3 ." Paper 9 at 2. Petitioner demonstrated how the prior art taught the same major shank diameter as disclosed in the '358 Patent, so Petitioner's Grounds fall squarely within the claimed "diameter." Petition at 28-29, 55; Brewer (Ex. 1004) at ¶ [0072] ("major diameter D"); Ex. 1001, 4:38 (" d_3 ... can be the major diameter"). The PTO agrees with Petitioner. Ex. 1025 at 3-4 (PTO finding that Corbett and Brewer each teach a shank with a "major ... diameter" that satisfies this "diameter" limitation). In an abundance of caution, Petitioner also demonstrated invalidity if "diameter" encompasses the "maximum diameter of the shank." *Id.* at 29, 55-56. The Board can and should invalidate the challenged claims without addressing Petitioner's reserved indefiniteness defense.

C. Petitioner’s Invalidity Grounds Satisfy Dependent Claim 10’s “Generally Cylindrical” Limitation Under Any Feasible Construction

Challenged dependent claim 10 requires the sleeve and mandrel to be “generally cylindrical.” The Petition notes that the term “generally” is indefinite, but nonetheless “interprets this limitation as best Petitioner can” and demonstrates invalidity under any construction that encompasses the ’358 Patent’s own disclosed embodiment. Petition at 37, 66-67. Even though the “generally” limitation is indefinite around the edges, Petitioner’s cited prior art falls safely within the scope of any feasible construction because the prior art’s sleeve and mandrel “are as ‘generally cylindrical’ as the ’358 Patent’s sleeve 102 and mandrel 112.” *Id.* The Board can and should invalidate challenged dependent claim 10 without addressing Petitioner’s reserved indefiniteness defense.

D. Conclusion: Petitioner’s Reserved Indefiniteness Defenses Do Not Impact Petitioner’s Invalidity Grounds

PO should not be able to dodge institution by propounding contradictory constructions to bolster its patentability and infringement arguments. Nor should Petitioner be penalized for explicitly reserving and disclosing non-IPR-eligible indefiniteness grounds. This is particularly true here because Petitioner has conservatively demonstrated prior art invalidity under any feasible construction.

VII. PO’s Misrepresentation Of Petitioner’s Expert’s Opinions Cannot Support Discretionary Denial

PO premises its discretionary denial request on a mistaken assertion that

Petitioner's expert, Dr. Cameron, "adopted Petitioner's counsel's positions on indefiniteness." Paper 9 at 7; *see also id.* at 18-19. Dr. Cameron was "informed" of Petitioner's indefiniteness position, but did not adopt Petitioner's position. *Id.* at 7-8 (quoting Ex. 1002, ¶¶ 81, 118, 149). Dr. Cameron and Petitioner never rely on Petitioner's reserved indefiniteness positions to support this IPR. In each instance, Dr. Cameron explained how she interpreted these limitations as best she could based on her independent analysis and pinpoint cites to the intrinsic record. Ex. 1002, ¶¶ 81-88, 118-121, 149; *see also* Section VI, above. PO's misrepresentation of Dr. Cameron's opinion is no ground for discretionary denial.

VIII. Petitioner's Search Disclosure Declaration Favors Institution

Petitioner's search disclosure declaration (Ex. 1022) favors institution.

IX. Conclusion

The *Fintiv*, § 325(d), and other pertinent factors strongly favor denying PO's request for discretionary denial. Institution is warranted to correct the PTO's effectively admitted error in granting the '358 Patent.

Respectfully submitted,

January 28, 2026

/Jack S. Barufka/
Jack S. Barufka (Reg. 37,087)
PILLSBURY WINTHROP
SHAW PITTMAN LLP
7900 Tysons One Place, Suite 500
McLean, Virginia 22102
Telephone: 703.770.7712
Facsimile: 703.770.7901

jack.barufka@pillsburylaw.com

Counsel for Petitioner

Certificate of Service

Pursuant to 37 CFR §§ 42.6(e)(1), the undersigned certifies that on January 28, 2026, the attached PETITIONER’S OPPOSITION TO PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL was served by email on the following counsel for Patent Owner:

- Heath J. Briggs: BriggsH@gtlaw.com
- Scott Bornstein: Scott.Bornstein@gtlaw.com
- Trenton A. Ward: Trenton.Ward@gtlaw.com
- Joseph Agostino: Joseph.Agostino@gtlaw.com
- howmet-iprs@gtlaw.com

January 28, 2026

/Benjamin L. Kiersz/
Benjamin L. Kiersz (Reg. 51,875)