

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

LIFTWERX USA INC.,
Petitioner,

v.

LIFTRA IP APS,
Patent Owner.

IPR2026-00102
Patent 12,104,578 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review

LiftWerx USA Inc. (“Petitioner”) filed a petition requesting *inter partes* review of claims 1–17 of U.S. Patent No. 12,104,578 B2 (“the ’578 patent,” Ex. 1001). Paper 1 (“Petition” or “Pet.”). Liftra IP ApS (“Patent Owner”) filed a preliminary response. Paper 13 (“Prelim. Resp.”). On April 14, 2026, after considering the parties’ arguments and the record, and in view of all relevant considerations, I issued a Notice indicating that institution was denied in this proceeding. *See* Paper 17 (“Notice”), 2. This determination was based on the totality of the evidence and arguments presented, and I highlight the following reasons. *See id.*

The challenged claims relate to a main shaft fixture for use during installation and repair of a wind turbine that includes, *inter alia*, “adjustable pressure mandrels with tap shoes.” *See, e.g.,* Ex. 1001, 7:2–15. Petitioner raises three obviousness grounds based on a combination of Signore and Weaver with other references. *See* Pet. 38–97. Petitioner notes that during prosecution of the ’578 patent and its parent patent, U.S. Patent No. 10,378,518 (“the ’518 patent,” Ex. 1005), the patent examiner rejected claims directed to “radially displaceable pressure mandrels with tap shoes” as being obvious over the combination of Signore and Weaver. *See id.* at 8–10. As explained below, Petitioner’s analysis is deficient even though it relies on the patent examiner’s findings.

Petitioner is required to show how the construed claim is unpatentable under the asserted grounds by “specify[ing] where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). Here, Petitioner fails to specify where in the prior art each claim element is found. For example, Petitioner’s analysis based on Signore and Weaver includes a statement that each reference “discloses

pressure mandrels with tap shoes,” with quotations from the references and colorized figures. *See* Pet. 49–51. Yet Petitioner does not explain why Signore’s “plurality of torque clamps” teach “tap shoes,” and Petitioner’s highlighting of a figure from Weaver does not elucidate which elements from Weaver that Petitioner regards as “tap shoes.” *See id.* As such, I find Petitioner’s showing to be insufficient for institution. “It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)).

Petitioner also relies on the patent examiner’s findings during prosecution and the fact that the applicant did not dispute them. *See id.* at 51 (citing Ex. 1002, 88). But merely pointing to the examiner’s findings is insufficient to satisfy Petitioner’s requirement to explain where each element of the claim is found in the prior art under Rule 42.104(b)(4). If that were the case, a petitioner could simply point to an examiner’s findings to, for example, circumvent a petition’s word count limit. *See* 37 C.F.R. § 42.24(a)(1)(i).

Further, to the extent Petitioner is suggesting that Patent Owner is bound by the applicant’s failure to dispute the patent examiner’s findings during prosecution, I disagree. Patent applicants are not required to traverse every finding before the patent claims are allowed.

Accordingly, it is

ORDERED that that the Petition is denied and no *inter partes* review is instituted.

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