

THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KLEIN TOOLS, INC.,

Petitioner

v.

MILWAUKEE ELECTRIC TOOL CORPORATION

Patent Owner

Case No. IPR2026-00233

U.S. Patent No. 11,656,067

PETITION FOR *INTER PARTES* REVIEW OF

U.S. PATENT NO. 11,656,067

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I. PETITIONER’S EXHIBIT LIST PURSUANT TO 37 C.F.R § 42.63(E) & 42.104(B)(5)

Exhibit No.	Description¹
1001	Certified U.S. Patent No. 11,656,067
1002	Certified File History for U.S. Patent No. 11,656,067
1003	Declaration of Robert Giachetti
1004	Curriculum Vitae of Robert Giachetti
1005	U.S. Patent No. 7,096,596 (“Hernandez”)
1006	U.S. Patent No. 6,324,769 (“Murray”)
1007	U.S. Patent No. 6,367,161
1008	U.S. Patent No. 6,662,463
1009	U.S. Patent Application Publication No. 2004/0071869 (filed Oct. 10, 2002) (“Gilliam”)
1010	U.S. Patent No. 4,429,462
1011	U.S. Patent No. 6,243,964
1012	U.S. Patent No. 6,282,808
1013	U.S. Patent No. 6,643,947
1014	U.S. Patent No. 6,804,899

¹ Descriptions are for convenience only and are not admissions or evidence.

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Exhibit No.	Description¹
1015	Patent Owner’s Preliminary Response to Petition, <i>Apex Tool Group LLC v. Milwaukee Electric Tool Corp.</i> , PGR2020-00056, Paper No. 9.
1016	Milwaukee Tool Internal May 8, 2017 Presentation, titled “Wider tape standout issue[:] Root cause analysis and Rework”
1017	Milwaukee Tool Internal Standout Procedure Excel Spreadsheet
1018	Kat Eschner, <i>How Hoop Skirts Led to Tape Measures</i> , Smithsonian Magazine (July 14, 2017), https://www.smithsonianmag.com/smart-news/how-hoop-skirts-led-tape-measures-180963995/ (last visited Dec. 5, 2025).
1019	Tape (Chesterman), https://americanhistory.si.edu/collections/object/nmah_761653
1020	U.S. Patent No. 79,965
1021	U.S. Patent No. 1,402,589
1022	Dkt. 28. Report of the Parties’ Planning Meeting in <i>Milwaukee Electric Tools Corporation v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.).
1023	Dkt. 30. Order adopting Parties’ Proposed Case Management Schedule in <i>Milwaukee Electric Tools Corporation v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.).
1024	Dkt. 42. Order granting Joint Motion for Extension of Certain Dates in <i>Milwaukee Electric Tools Corporation v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.).
1025	Dkt. 53. Joint Motion to Extend Certain Deadlines in the Scheduling Order in <i>Milwaukee Electric Tools Corporation v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.).

II. LISTING OF THE CHALLENGED CLAIMS

The '067 Patent	
Limitation Identifier	Text of Claim
Independent Claim 1	
[1A]	“A tape measure comprising:”
[1B]	“a housing;”
[1C]	“a tape reel rotatably mounted within the housing;”
[1D]	“an elongate blade wound around the reel, the elongate blade comprising:”
[1E]	“an upper surface;”
[1F]	“a lower surface;”
[1G]	“an elongate metal core having a first thickness, T1, between 0.12 mm and 0.14 mm;”
[1H]	“a length between 15 feet and 40 feet;”
[1I]	“a flat width of 20 mm to 40 mm;”
[1J]	“a curved profile such that the upper surface of the elongate blade defines a concave surface and the lower surface defines a convex surface;
[1K]	“a curved width, wherein the curved width is less than the flat width; and”
[1L]	“a curved height between 8.5 mm and 9.5 mm;”
[1M]	“wherein a ratio of the curved width to the flat width is between 0.6 and 0.8;”
[1N]	“wherein a ratio of curved height to flat width is greater than 0.285;”

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The '067 Patent	
Limitation Identifier	Text of Claim
[1O]	“wherein a standout distance of the elongate blade from the housing is greater than 150 inches; and”
[1P]	“a retraction system coupled to the tape reel, wherein the retraction system drives rewinding of the elongate blade on to the tape reel.”
Dependent Claim 2	
	“The tape measure of claim 1,”
[2A]	“wherein the curved profile is located at a location along at least the first 132 inches of a length of the elongate blade.”
Dependent Claim 3	
	“The tape measure of claim 1,”
[3A]	“wherein the curved profile is located at a location between 5 feet and 15 feet along a length of the elongate blade measured from a hook located at an end of the tape blade.”
Dependent Claim 4	
	“The tape measure of claim 1,”
[4A]	“wherein the curved profile is located at a location between 6.5 feet and 13 feet along a length of the elongate blade measured from a hook located at an end of the tape blade.”
Dependent Claim 5	
	“The tape measure of claim 4,”
[5A]	“wherein the flat width is 25 mm to 32 mm.”

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The '067 Patent	
Limitation Identifier	Text of Claim
Dependent Claim 6	
	“The tape measure of claim 5,”
[6A]	“wherein the flat width is 32 mm.”
Dependent Claim 7	
	“The tape measure of claim 6,”
[7A]	“wherein the curved width is less than 26 mm.”
Dependent Claim 8	
	“The tape measure of claim 1,”
[8A]	“wherein the standout distance of the elongate blade from the housing is at least 156 inches.”
Dependent Claim 9	
	“The tape measure of claim 1,”
[9A]	“wherein, when the elongate blade is at a maximum standout length, the curved profile is located in a section of tape blade that extends 5 feet from the housing toward a hook located at the end of the tape blade.”
Dependent Claim 10	
	“The tape measure of claim 1, further comprising:”
[10A]	“an upper polymer coating coupled to an upper surface of the elongate metal core,”
[10B]	“the upper polymer having a second thickness, T2; and”

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The '067 Patent	
Limitation Identifier	Text of Claim
[10C]	“a lower polymer coating coupled to a lower surface of the elongate metal core,”
[10D]	“the lower polymer coating having a third thickness, T3;”
[10E]	“wherein T1+T2+T3 is between 0.15 mm and 0.5.”
Dependent Claim 11	
	“The tape measure of claim 1,”
[11A]	“wherein the ratio of the curved height to T1 is greater than 65.”
Dependent Claim 12	
	“The tape measure of claim 1,”
[12A]	“wherein the retraction system is a spring-based retraction system comprising a spring coupled to the tape reel,”
[12B]	“wherein, as the elongate blade is unwound from the tape reel to extend from the housing, the spring stores energy and the spring releases energy driving rewinding of the elongate blade on to the tape reel.”

III. INTRODUCTION

Klein Tools, Inc. (“Petitioner”) requests *inter partes* review (“IPR”) of claims 1-12 (the “Challenged Claims”) of Milwaukee Electric Tools Corporation’s (“Patent Owner”) U.S. Patent No. 11,656,067 (the “’067 patent”).

The ’067 patent purports to disclose a new tape measure with a curved cross-section, resulting in “standout” of more than 150 inches. Standout is the distance a tape measure’s blade can be extended before it buckles under its own weight. The problem for Patent Owner is (among other things) that the connection between curvature and standout was known for more than a decade before the earliest parent application to which the ’067 patent claims priority was filed. Indeed, the Hernandez reference—a reference not considered during prosecution of the ’067 patent—expressly or inherently discloses every limitation of 11 of the 12 Challenged Claims, thus anticipating those claims. And the last remaining claim simply adds a plastic coating on both sides of the tape—yet another common feature known for years prior to Patent Owner’s application—is nothing more than an obvious modification of Hernandez.

Indeed, that the claims of the ’067 patent should have never issued should be unsurprising to Patent Owner. The ’067 patent itself acknowledges that all but one limitation of claim 1 was present in the prior art. Ex-1001, 12:46-66, Tables 1-2. And that single allegedly novel feature—standout over 150 inches—was already

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well known in the art of tape measures by 2017. For example, Hernandez, which incorporates the Murray patent by reference, expressly discloses “blade stand out of up to approximately 13 feet [156 inches].” Ex-1006, 5:49-51. But worse still is that Patent Owner **knew** that the sole allegedly inventive feature of the Challenged Claims, i.e., stand out over 150 inches, already existed in the prior art. Indeed, Patent Owner tested tape measures from Stanley Black & Decker (“Stanley”)—the assignee of the Murray reference—prior to the earliest application and found that their stand out measurements exceeded 150 inches:

Sample Name	Model Number	Sample Number	Standout (ft)			
			Data	Avg	Min	Max
Stanley Fat Max 25ft	FMHT33502	1	13.25	13.36	13.25	13.58
		2	13.58			
		3	13.25			
Dewalt Tough Tape 16ft	DWHT33924	1	12.83	12.83	12.83	12.83
		2	12.83			
		3	12.83			

Ex-1017 (Patent Owner testing conducted before the '067 patent's earliest possible priority date showing the Stanley FatMax 33502 and Dewalt 33924 had stand out greater than 150 inches (12.5 feet)).

At bottom, Patent Owner patented what it knew others like Stanley had invented years before. Fortunately, the law does not permit Patent Owner to do this. Thus, Petitioner respectfully requests the Board institute IPR and cancel the Challenged Claims of the '067 patent.

IV. MANDATORY NOTICES

1. 37 C.F.R. § 42.8(b)(1): Real Parties-in-Interest

The real parties-in-interest are Klein Tools, Inc. and ZAH Group, Inc.

2. 37 C.F.R. § 42.8(b)(2): Related Matters

The '067 patent is at issue in the following case:

- *Milwaukee Electric Tools Corporation v. Klein Tools, Inc.*, No. 1:25-cv-04689 (N.D. Ill.), filed April 29, 2025 (the “Litigation”). Fact discovery is still in the early stages and no trial date is set for the Litigation. Ex-1022-1025.

3. 37 C.F.R. § 42.8(b)(3) & (4): Lead and Back-Up Counsel and Service Information

Lead Counsel	Back-Up Counsel
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	Facsimile: (212) 446-4900
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Petitioner concurrently submits a Power of Attorney pursuant to 37 C.F.R. § 42.10(b) and consents to electronic service by email directed to the email address: KleinTools_IPR@kirkland.com

4. 37 C.F.R. § 42.103: PAYMENT OF FEES

Petitioner requests IPR of 12 claims. Any fees in connection with this Petition may be charged to Deposit Account No. 506092.

5. 37 C.F.R. § 42.104(a): GROUNDS FOR STANDING

Petitioner certifies that the '067 patent is available for IPR and that Petitioner is not barred or estopped from requesting IPR of the '067 patent on the grounds identified herein. This Petition is being filed within one year of service of a complaint against Petitioner in the Litigation and more than nine months after the '067 patent's issuance at the USPTO.

V. IDENTIFICATION OF CHALLENGE AND RELIEF REQUESTED PURSUANT TO 37 C.F.R. § 42.104(B)

Petitioner requests cancellation of all Challenged Claims on the grounds below (37 C.F.R. §§ 42.104(b)(1)-(2)):

Ground	Claims	Basis
1	1-9, 11-12	Unpatentable pursuant to 35 U.S.C. § 102 over Hernandez

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Ground	Claims	Basis
2	1- 9, 11-12	Unpatentable pursuant to 35 U.S.C. § 103 over Hernandez alone, or in combination with Murray
3	10	Unpatentable pursuant to 35 U.S.C. § 103 over Hernandez in combination with Gilliam

Pursuant to 37 C.F.R. § 42.104(b)(4), an explanation of how the claims are unpatentable is provided herein.

VI. OVERVIEW OF TECHNOLOGY

1. Background

Tape measures have been known for centuries. For example, a tape measure having a steel tape was patented in Britian in 1829:



Ex-1018; Ex-1019. Even tape measures with a blade having a “concavo-convex cross section” similar to the ’067 patent have been known for over a century. Ex-1021, 1:7-15. It has also been long understood that a desirable feature of tape measures is increased blade standout. Ex-1003 ¶¶31-34, 42-43; Ex-1006, 1:10-12,

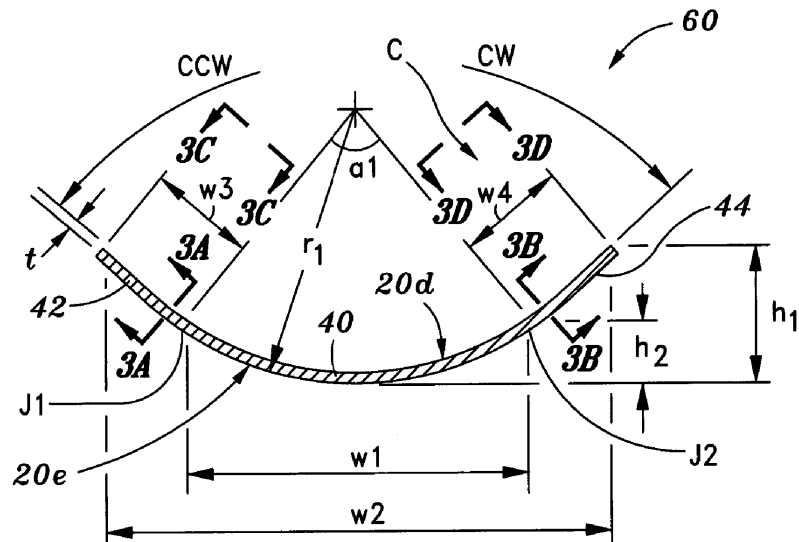
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1:33-36; Ex-1005, 1:29-31. And POSAs have long understood that blade standout could be increased (or decreased) by adjusting a blade's thickness, flat width, and curved profile, as the '067 patent admits. Ex-1021, 2:45-54 (tape measure patent filed in 1919 describing how "its concavo convex structure and its dimensions being such that when so extended and straightened, it possesses sufficient structural strength to prevent it from buckling."); Ex-1005, 1:29-41; Ex-1006, 2:7-8, 3:15-20, 5:10-65, Fig. 7.

VII. OVERVIEW OF THE ASSERTED PRIOR ART

1. Hernandez

Hernandez generally relates to a tape measure having an elongated blade. Ex-1005, 1:21-31. Hernandez discusses the desirability that the extended portion of the elongated blade be as linear as possible with increased standout. *Id.* Hernandez describes "[t]he extended portion 60 of the blade 20 ha[ving] a curved cross-section." Ex-1005, 4:19-20, Abstract, 1:39-41, 1:56-2:1, 4:63-66, 5:9-14. As shown below, the tape measure comprises a blade, wherein the extended portion of the blade has a curved cross-section:



Ex-1005, Fig. 3. Further, Hernandez discloses that the “extended portion of the elongated blade 60 of the elongated blade 20 may have a standout arcuate length of at least ten feet with a horizontal linear length greater than ninety-seven percent of the standout arcuate length.” Ex-1005, 4:47-50. To achieve this standout Hernandez discloses specific ranges of blade dimensions resulting in “a cross-sectional configuration that resists bending.” Ex-1005, 1:55-60, 4:19-46.

Hernandez also incorporates by reference U.S. Patent Nos. 6,324,769 (“Murray”); 6,367,161; and 6,662,463 as “[e]xamples of tape measures” disclosing that “it is desirable that an extended portion of the elongated blade be as linear as possible.” Ex-1005, 1:5-7, 1:28-48 (describing exemplifying embodiments relating to Murray, including an extended blade portion having a standout arcuate length of at least ten feet with a horizontal linear length greater than ninety-seven percent of

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the stand-out arcuate length). Hernandez and the incorporation by reference of the disclosure in Murray disclose tape measures with increased stand-out.

Hernandez is prior art to the '067 patent under at least 35 U.S.C. § 102(a)(2). Hernandez is a US patent, filed September 21, 2004, from U.S. Patent Application No. 10/945,679, and issued August 29, 2006, which is before the '067 patent's earliest possible priority date. *Infra* §VIII.3; Ex-1005, Cover.

2. Murray

Murray generally relates to a “retractable rule assembly” with increased blade stand-out. Ex-1006, Cover. Murray discusses the desirability that the extended portion of the elongated blade be as linear as possible, and characteristics and factors related thereto. *E.g.*, Ex-1006, 1:9-37, 2:19-20, 3:15-21, 5:6-65, 6:24-47, 7:14-24, 7:45-8:5, 11:6-10, 18:64-19:16, Fig. 9. For example, Murray discloses that “[o]ne of the most desirable characteristics commercial rule assemblies can possess is a relatively long blade stand-out,” which it illustrates in Figure 10:

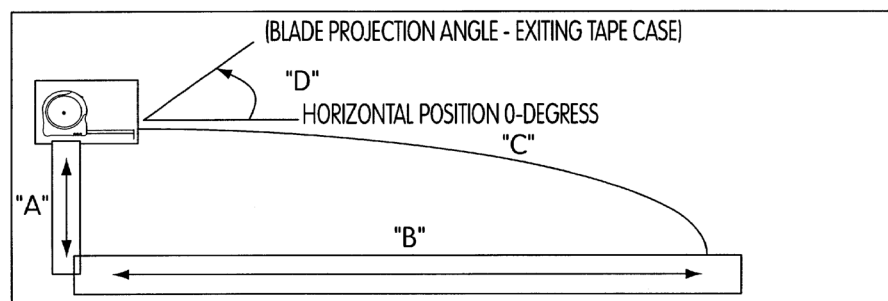
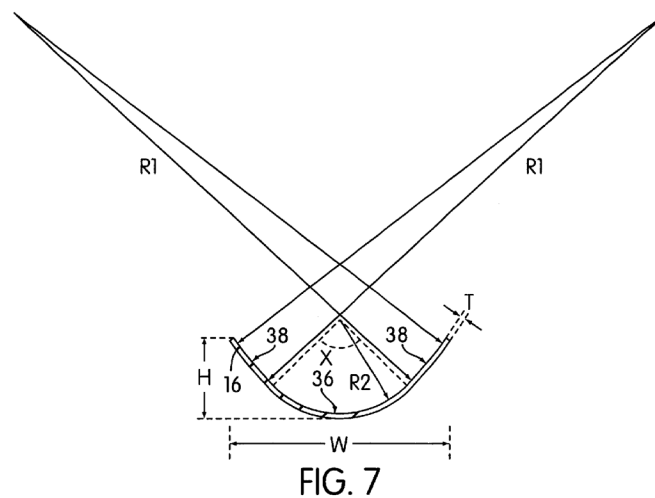


FIG. 10

Ex-1006, 1:10-12, Fig. 10.

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Murray also discloses that “[g]enerally, one skilled in the art will understand that the length of the blade standout depends on many factors, including (but not limited to) blade width (i.e. the transverse width of the blade measured when the blade is in its flattened condition ... the height of the blade 16 in the concavo-convex configuration (designated H in FIG. 7); blade thickness (designated T in FIG. 7); and the geometry of the blade transverse cross-section when the same is in its normal concavo-convex than configuration.”:



Ex-1006, Fig. 7, 5:21-30. Murray discloses that “the blade 16 has a blade width, thickness and height of concavo-convex curvature sufficient to enable the blade 16 to standout arcuately.” Ex-1006, 5:10-20, 2:7-8.

Murray is prior art to the '067 patent under at least 35 U.S.C. § 102(a)(2). The Murray reference is a US patent, filed August 4, 1999, from U.S. Patent Application

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No. 09/366,781, and issued December 4, 2001, which is before the '067 patent's earliest possible priority date. *Infra* §VIII.3; Ex-1006, Cover.

While Murray was before the Examiner during examination of the '067 patent, it was not cited or discussed as the basis for a rejection during prosecution, and it was not considered in combination with Hernandez or Gilliam. Notably, Murray was only one of dozens of references cited to in an Information Disclosure Statement by the applicant (i.e., not discussed by the Examiner). Ex-1002, 63. The Examiner therefore misapprehended and overlooked Murray during prosecution. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper No. 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential). To the extent the Examiner substantively considered Murray, the Examiner erred by overlooking its disclosures related to blade shape and standout. Petitioner reserves the right to provide additional explanation of why the Examiner erred, and why institution should not be denied, in response to any Patent Owner request for discretionary denial pursuant to 35 U.S.C. § 325(d).

3. Gilliam

Gilliam generally relates to tape measures, including coatings for such blades. Ex-1009, Cover. In one embodiment of the invention, Gilliam discloses a metallic tape blade, “substantially coated with a powder and then passed through an induction unit to heat the powder and form a coating on the blade, with the blade having a

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concavo-convex cross-section when passing through the induction unit.” *Id.* ¶7.

Figure 4 shows a process line for forming a coating on a tape blade having a concavo-convex tape blade:

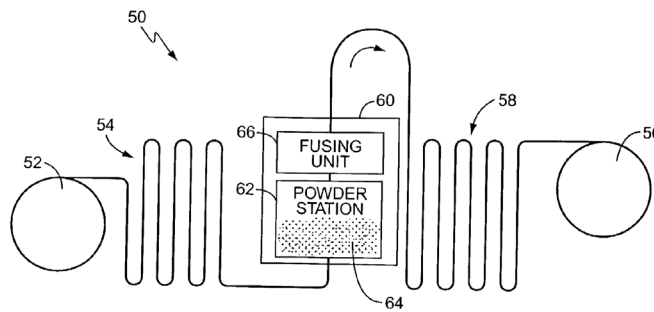


FIG. 4

Ex-1009, Fig. 4 (showing a coating station having a powder unit and a fusing unit), ¶¶11, 18. “One of the purposes of applying a coating 34 to the tape blade 12 is to increase the life of the blade 12.” *Id.* ¶¶23, 4.

Gilliam is prior art to the ’067 patent under at least 35 U.S.C. § 102(a)(2). Gilliam is a U.S. Patent Publication of Application No. 10/268,432, filed October 20, 2002, and issued April 15, 2004, which is before the ’067 patent’s earliest possible priority date. *Infra* §VIII.3; Ex-1009, Cover. Gilliam was not considered during prosecution of the ’067 patent.

VIII. THE ’067 PATENT

1. Prosecution History

The ’067 patent issued on May 23, 2023, from U.S. Application No. 17/328,388, which was filed May 24, 2021. Ex-1001, Cover. The application

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included 12 claims, all allowed without amendment. Ex-1002. During prosecution, the only rejection was an obviousness-type double patenting rejection against claims 1, 3, 4, 8-10 and 12 based on claims 1-5 and 8-9 of then-pending U.S. Patent No. 11,293,739, a continuation of the '067 patent. Ex-1002, 196-201. Patent Owner filed a terminal disclaimer, overcoming the sole rejection. Ex-1002, 268-71, 289. The prosecution history of the '067 patent's parents were similar: the Examiner never issued a rejection over the prior art for any member of the '067 patent's family.

2. Overview

The '067 patent relates generally to a tape measure with a blade profile with a curved shape that purportedly increases tape standout. Ex-1001, Cover. The purported advantage of the claimed invention is “by shaping the tape blade to a relatively aggressive or steep curved profile shape ... tape standout can be increased and tape droop can be decreased greatly[.]” Ex-1001, 4:34-39. The '067 patent acknowledges that it was “conventional tape blade design wisdom” that for a given tape blade thickness, “increasing width or increasing curved shape” “increase[es] standout.” Ex-1001, 14:62-15:1; Ex-1005, 1:37-43; Ex-1006, 2:7-8, 5:21-65, 7:14-24. The '067 patent further admits that virtually all of the blade dimensions claimed in the '067 patent (e.g., flat width, thickness, curved height, curved width, and associated ratios), were known in the prior art. Ex-1001, 12:46-66, Tables 1-2. The only alleged difference between the prior art and the claims is standout in excess of

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150 inches but Patent Owner knew even that was not novel. Ex-1017. Indeed, prior art like Hernandez and Murray have long taught tape measures with standouts over 150 inches. Ex-1005, 1:21-43; Ex-1006, 5:21-55.

Hernandez, Murray, and Gilliam are all directed toward tape measures, and anticipate, or render obvious all 12 claims of the '067 patent.

3. Earliest Possible Effective Priority Date

The '067 patent purports to be a continuation of U.S. Patent Application No. 11,022,416, filed on July 13, 2020, which purports to be a continuation of U.S. Patent Application No. 10,712,142, filed August 27, 2018, filed as application No. PCT/US2018/047759 on August 23, 2018, which claims the benefit of and priority to U.S. Provisional Application No. 62/702,575, filed on July 24, 2018, and U.S. Provisional Application No. 62/549,511, filed on August 24, 2017. Ex-1001, Cover. While Petitioner disputes that the '067 patent is entitled to an effective priority date as early as August 24, 2017, and expressly reserves the right to challenge the priority date in any proceeding, the Board need not reach the issue, as the prior art asserted herein is prior art under even the earliest possible priority date. The '067 patent is subject to the AIA provisions of Section 35 of the U.S. Code.

4. Hernandez, Murray, and Gilliam Are Analogous Art to the '067 Patent

“Prior art is analogous and can be applied in an obviousness combination if it either (1) ‘is from the same field of endeavor, regardless of the problem addressed’

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or (2) ‘is reasonably pertinent to the particular problem with which the inventor is involved.’” *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1000 (Fed. Cir. 2016) (citing *In re Clay*, 966 F.2d 656, 658-59 (Fed. Cir. 1992)). “To determine if art is analogous, we look to ‘the purposes of both the invention and the prior art.’” *Id.* at 1001 (citing *Clay*, 966 F.2d at 659). The ’067 patent, Hernandez, Murray, and Gilliam all relate to tape measures, and to improving aspects of tape measure blades, such as standout and durability. Ex-1001, Abstract, 1:21-24; Ex-1005, Abstract, 1:64-2:1; Ex-1006, Abstract, 5:63-65; Ex-1009 ¶¶1, 23.

Accordingly, Hernandez, Murray, and Gilliam are analogous art. *Unwired Planet*, 841 F.3d at 1000.

IX. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art (“POSA”) at the relevant time would have had a bachelor’s degree in engineering or at least 2 years of industry experience in equipment or tool design involving beam strength calculations. Ex-1003 ¶15. Formal education in a relevant field, such as mechanical engineering, may compensate for less experience, and vice versa. *Id.* Petitioner’s expert, Dr. Robert Giachetti, was a POSA as of the ’067 patent’s earliest possible priority date. *Id.* ¶16; §VIII.3.

X. CLAIM CONSTRUCTION

A petition must set forth how the challenged claims are to be construed. 37 C.F.R. § 42.104(b)(3). The Board need only construe terms if necessary to resolve

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the disputes between the parties. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

While petitioners may rely on claim constructions that a patent owner advanced in other proceedings, where a proposed construction in an IPR differs from a construction it has proposed in a different forum, petitioner should explain that difference. *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper No. 20 at 3-5 (Director Nov. 3, 2025) (precedential).

Although the parties have not yet exchanged claim construction positions in the Litigation, Petitioner contended the following terms were indefinite in its initial invalidity contentions, which Patent Owner disputes:

- 1) “wherein a **standout distance** of the elongate blade from the housing is greater than 150 inches”;
- 2) “wherein a ratio of the **curved width** to the flat width is between 0.6 and 0.8”;
- 3) “a **curved width**, wherein the **curved width** is less than the flat width”;
- 4) “a **curved height** between 8.5 and 9.5 mm”;
- 5) and “wherein a ratio of **curved height** to flat width is greater than 0.285.”

Petitioner’s position in the Litigation is based on Patent Owner’s application of these limitations to the accused products. With respect to “wherein a standout distance of the elongate blade from the housing is greater than 150 inches,” it is not

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clear how Patent Owner was purportedly measuring standout in the Litigation, and Petitioner's accused products' standout varies from use to use and user to user, and Patent Owner did not explain how it controlled for this in arriving at the alleged standout distance for each product. With respect to the "curved width" and "curved height" limitations, Petitioner's accused products have "curved widths" and "curved heights" that vary along the length of the blade. Patent Owner, however, identified only a single purported "curved height" and "curved width" for each accused product, without explanation of how it arrived at the accused values or why an accused infringer should know that those are the relevant values. Petitioner therefore contends in the Litigation that these limitations are indefinite as applied by Patent Owner because it would require "an artisan make a separate infringement determination for every set of circumstances ... and when such determinations are likely to result in differing outcomes (sometimes infringing and sometimes not), that construction is likely to be indefinite." *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008).

As the asserted art are not physical products, applying Patent Owner's plain and ordinary constructions to these limitations in this IPR does not result in the same ambiguity that is at issue in the Litigation. Specifically, notwithstanding the indefiniteness at the outer bounds of these terms, a POSA would understand that Petitioner's asserted art satisfies each of these limitations as the prior art clearly and

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unambiguously disclose standout, curved width, and curved height that meet these limitations. *E.g.*, *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 at 3-4 (Director Nov. 5, 2025); *Cochlear Bone Anchored Solutions AB v. Oticon Medical AB*, 958 F.3d 1348, 1360 (2020) (“indefiniteness of a claim does not always imply inability to conduct a prior-art analysis needed for an inter partes review.”) As such, for the purposes of this Petition only, Petitioner adopts Patent Owner’s plain and ordinary construction. No express constructions are therefore required for purposes of the issues raised in this IPR.

XI. THE LAW OF RANGES FOR ANTICIPATION AND OBVIOUSNESS

1. Anticipation

“A claim is anticipated if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference.” *Arbutus Biopharma Corp. v. ModernaTX, Inc.*, 65 F.4th 656, 662 (Fed. Cir. 2023). The “established framework for analyzing whether a prior art reference anticipates a claimed range[] ... depend[s] on whether the prior art discloses a point within the claimed range or discloses its own range that overlaps with the claimed range.” *UCB, Inc. v. Actavis Lab’ys UT, Inc.*, 65 F.4th 679, 687 (Fed. Cir. 2023) (citing *Ineos USA LLC v. Berry Plastics Corp.*, 783 F.3d 865, 869 (Fed. Cir. 2015)). “If the prior art discloses a point within the claimed range, the prior art anticipates the claim.” *Id.* “[W]here a prior art reference’s range ‘entirely encompasses, and does not

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significantly deviate from’ the claimed ranges, the range is anticipated.” *Arbutus*, 65 F.4th at 666 (quoting *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1377 (Fed. Cir. 2005)).

“A prior art reference that discloses an overlapping but different range than the claimed range can be anticipatory, even where the prior art range only partially or slightly overlaps with the claimed range.” *Id.* “Once the patent challenger has established, through overlapping ranges, its prima facie case of anticipation, ‘the court must evaluate whether the patentee has established that the claimed range is critical to the operability of the claimed invention.’” *UCB*, 65 F.4th at 687 (quoting *Genentech, Inc. v. Hospira, Inc.*, 946 F.3d 1333, 1338 (Fed. Cir. 2020)). Likewise, “‘where there is a range disclosed in the prior art, and the claimed invention falls within that range, the burden of production falls upon the patentee to come forward with evidence’ of ... criticality.” *Genentech*, 946 F.3d at 1338 (citing *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1008 (Fed. Cir. 2018); *Perricone*, 432 F.3d at 1377 (prior art “disclos[ing] a range of concentration ‘from 0.01 to 20% by weight’” “anticipates [asserted patent’s] particular claimed ‘effective amount’ ranges ... e.g., ‘up to 10% by weight,’ ... ‘from about 0.025% to about 5% by weight,’ ... ‘from about 0.025% to about 10% by weight’”). “Criticality has been found where only a narrow range of temperature enabled a process to operate as claimed, and problems occurred in practicing the invention below or above the

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claimed range.” *Hospira, Inc. v. Genentech, Inc.*, No. IPR2016-01837, 2018 WL 1187484, at *11 (P.T.A.B. Mar. 6, 2018), *aff’d*, 946 F.3d 1333 (Fed. Cir. 2020); *Application of Ornitz*, 351 F.2d 1013, 1017 (C.C.P.A. 1965) (affirming rejection of application, finding that “even assuming *arguendo* appellant to have discovered that ranges of some constituents are critical to certain properties, we are not convinced of novelty in the claimed range of compositions since [prior art reference] discloses those properties for substantially the same ranges of compositions.”).

2. Obviousness

“A *prima facie* case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art.” *In re Peterson*, 315 F.3d 1325, 1329 (Fed. Cir. 2003). “Such overlap itself provides sufficient motivation to optimize the ranges.” *In re Applied Materials, Inc.*, 692 F.3d 1289, 1295 (Fed. Cir. 2012); *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996) (affirming *prima facie* case of obviousness because, in light of the prior art reference’s teaching, “one of ordinary skill would logically infer that increasing the amount of the shock absorbing material (the polyurethane) would lead to an increase in the amount of shock absorption. Accordingly, one of ordinary skill would have experimented with various thicknesses to obtain an optimum range.”).

“In cases involving overlapping ranges, we and our predecessor court have consistently held that even a slight overlap in range establishes a *prima facie* case of

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obviousness.” *Peterson*, 315 F.3d at 1329. Additionally, “a *prima facie* case of obviousness exists when the claimed range and the prior range do not overlap but are close enough such that one skilled in the art would have expected them to have the same properties.” *Id.* (citing *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 783 (Fed.Cir.1985)). “Selecting a narrow range from *within* a somewhat broader range disclosed in a prior art reference is no less obvious than identifying a range that simply *overlaps* a disclosed range.” *Id.* at 1329-30.

“‘[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.’” *E.I. DuPont*, 904 F.3d at 1006 (quoting *In re Aller*, 220 F.2d 454, 456 (CCPA 1955)). “[B]ecause the prior art disclosed values overlapping the claimed ranges, the ‘general conditions’ of the claim are disclosed.” *Applied*, 692 F.3d at 1295.

“[T]he existence of overlapping or encompassing ranges shifts the burden to the [patent owner] to show that his invention would not have been obvious.” *Peterson*, 315 F.3d at 1330. This presumption can be overcome only if “the prior art teaches away from the claimed range ... the claimed range produces new and unexpected results, or other evidence demonstrates non-obviousness of the claimed range.” *UCB*, 65 F.4th at 690. Further, this presumption can be overcome if the claimed range is “not recognized as result-effective.” *E.I. DuPont*, 904 F.3d at 1006.

“A recognition in the prior art that a property is affected by the variable is sufficient to find the variable result-effective.” *Applied*, 692 F.3d at 1297.

XII. SPECIFIC GROUNDS FOR THE PETITION

1. Ground 1: Claims 1-9, 11-12 of the '067 Patent are Anticipated in View of Hernandez

a. Claim 1

1) “A tape measure comprising:” [1A]

To the extent the preamble is limiting, Hernandez discloses this limitation.

Hernandez discloses, “[a] tape measure”:

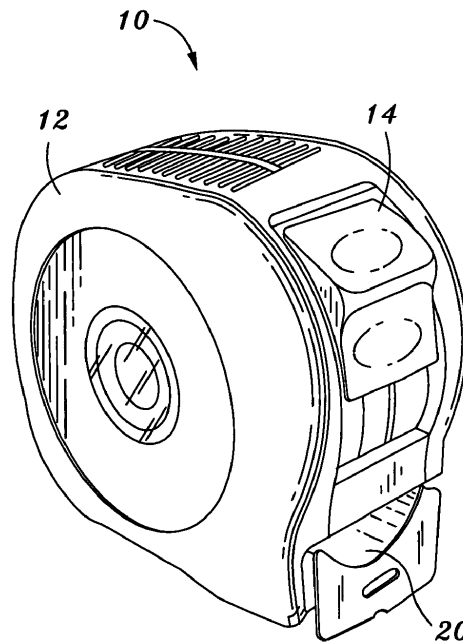


Fig. 1

Ex-1005, Cover, 1:21-31, 1:55-60, 1:64-2:1, 2:50-60, 3:10-20, Figs. 1, 2, 5.

2) “a housing;” [1B]

Hernandez discloses “a housing.” Ex-1005, 1:21-26, 3:17-48. Figure 1² of Hernandez illustrates the exterior of the housing:

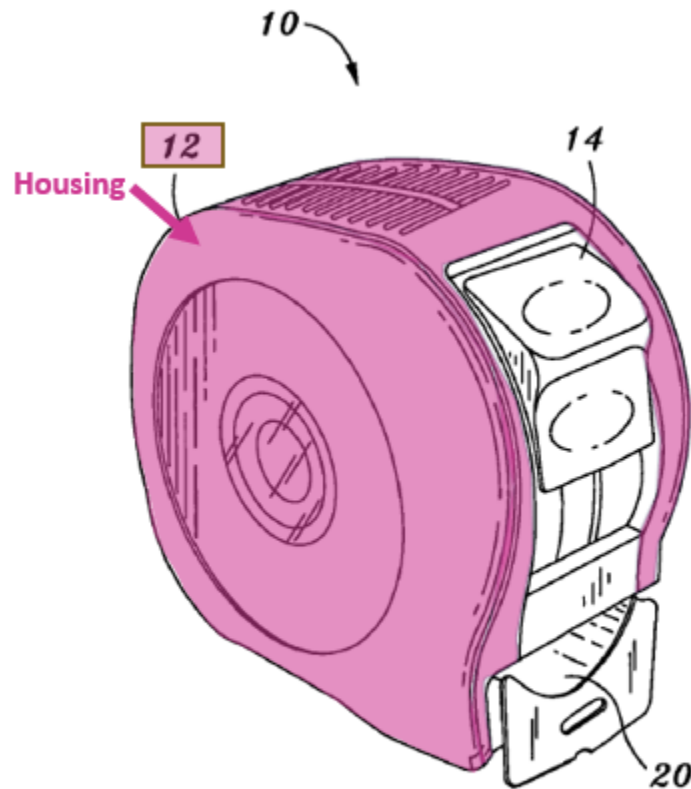


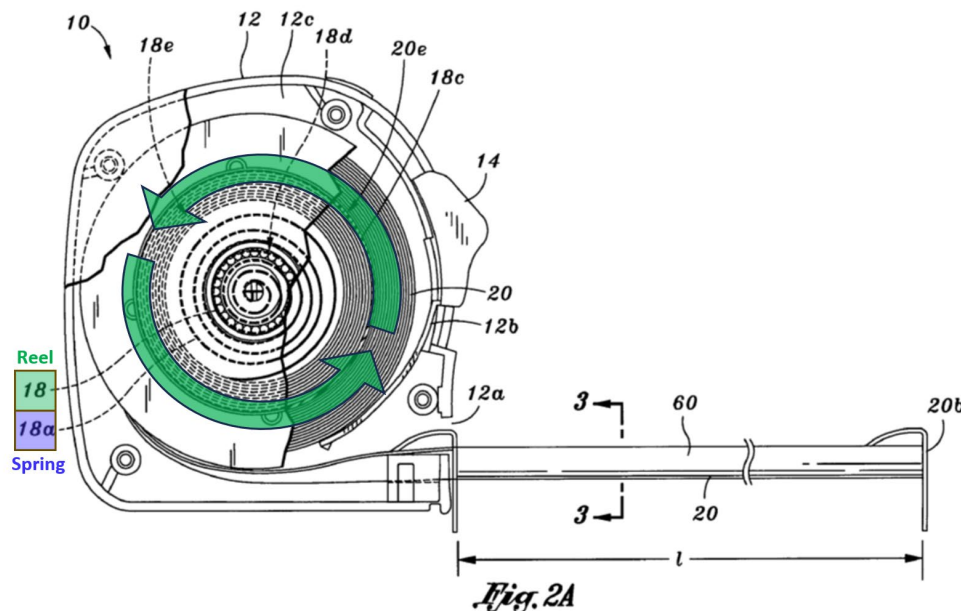
Fig. 1

Ex-1005, Fig. 1, 2-2A, 3:53-4:10.

² Petitioner applied the color annotations appearing throughout the Petition.

3) *“a tape reel rotatably mounted within the housing;”* [1C]

Hernandez discloses this limitation. Hernandez discloses a “[tape] **reel 18 ll** **mounted within the internal chamber 12c for rotation[,]**” wherein the tape reel, “includes a cylinder 18c, and a central shaft 18b **connected to the housing 12** **la]bout which the reel rotates.**” Ex-1005, 3:53-57. Hernandez also discloses that when a user pulls the tape measure out, “the **reel rotates** counter-clockwise as viewed in FIG. 2A,”:



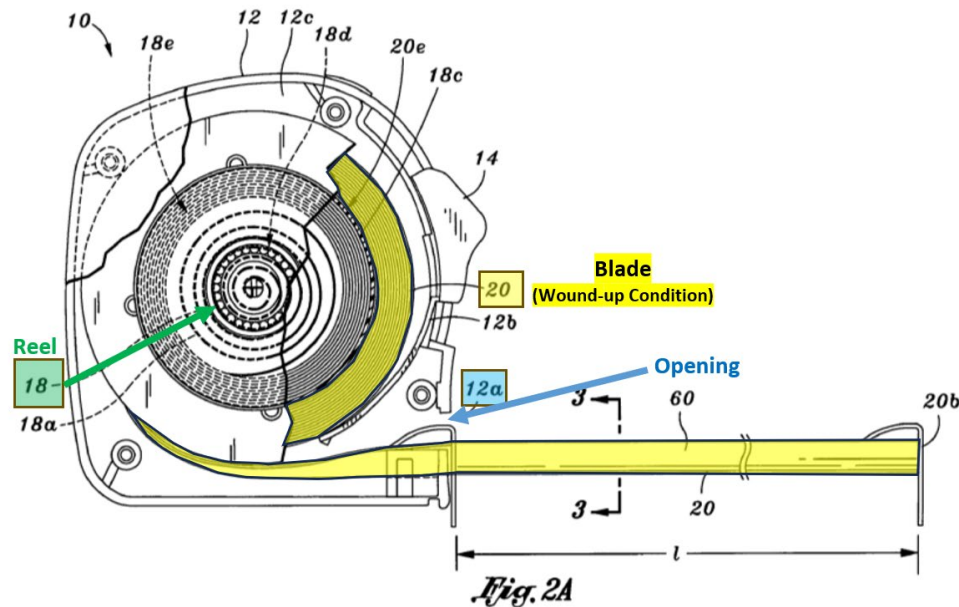
Ex-1005, Fig. 2A, 3:66-4:18 (describing a reel rotation method).

4) *“an elongate blade wound around the reel, the elongate blade comprising:” [1D]*

Hernandez discloses this limitation. Hernandez discloses “an elongated blade... stored in a wound-up condition in a blade holding assembly 14 mounted to a housing 12.” Ex-1005, 3:18-21. Hernandez explains that “[w]ithin the housing 12

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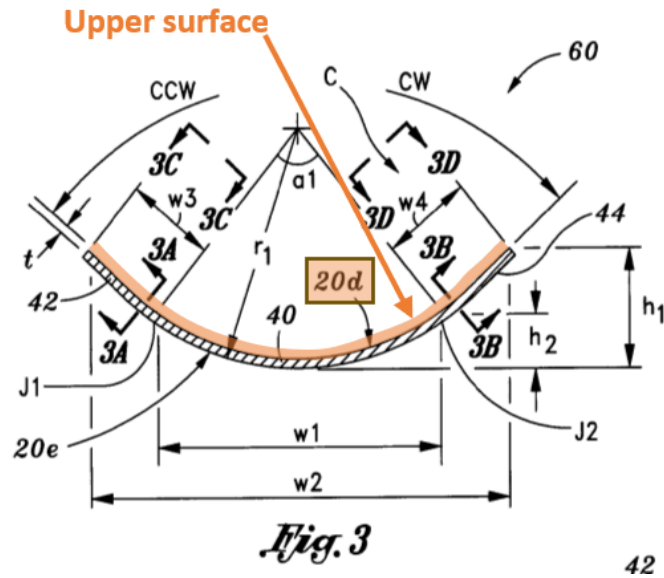
is an internal chamber 12c that receives a reel 18, a component of the blade holding assembly 14.” Ex-1005, 3:29-31. Hernandez also discloses that “[t]he blade 20 has an internal end 20c connected to the reel 18 and a free end 20b extending outwardly through an opening 12a in the housing 12.” Ex-1005, 3:31-33.



Ex-1005, Fig. 2A.

5) “an upper surface;” [1E]

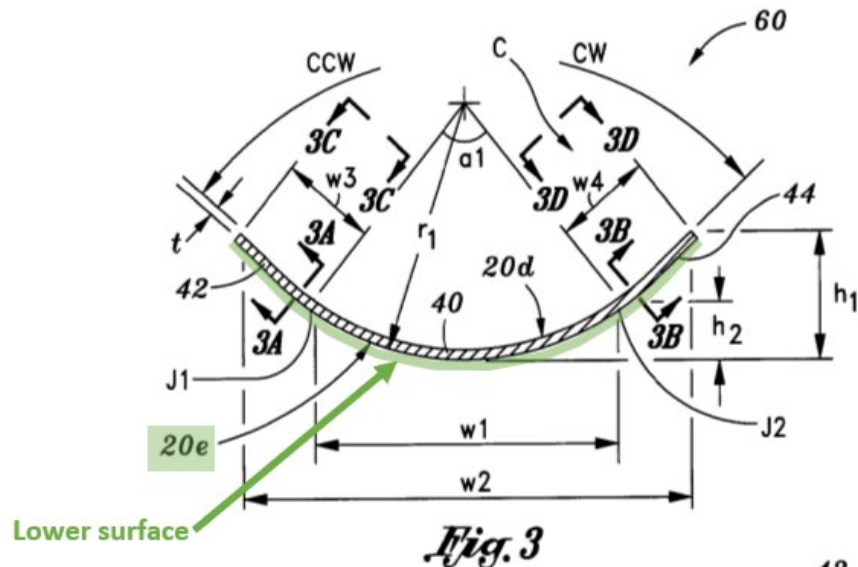
Hernandez discloses this limitation. Hernandez discloses that the “blade 20” has a “top side 20d”:



Ex-1005, 3:22-24, 4:20-23, Fig. 3.

6) “a lower surface;” [1F]

Hernandez discloses this limitation. Hernandez describes that “[t]he blade 20” has a “**bottom side** 20e”:



Ex-1005, 4:20-22, Fig. 3.

7) “an elongate metal core having a first thickness, *T*₁, between 0.12 mm and 0.14 mm;” [1G]

Hernandez discloses this limitation. Hernandez discloses an elongated blade “formed from a flat strip of metallic material.” Ex-1005, 4:59-60, 2:7-16. Hernandez discloses a thickness “*t*” for that core of “about 0.0045 inches [0.114 mm], for example from about 0.0030 [0.076 mm] to about 0.0060 inches [0.152 mm].” Ex-1005, 4:25-27, 2:32-34, Fig. 3.

Separately, Hernandez incorporates by reference Murray, which also discloses an elongated metal blade with a thickness, which can range from “approximately 0.0045 inch [0.114 mm] to approximately 0.0063 inch [0.160 mm][,]” more specifically from “approximately **0.005 inch [0.127 mm] to approximately 0.0056 inch [0.142 mm]**”—almost the precise range claimed by the ’067 patent. Ex-1006, 5:21-49. “[M]aterial not explicitly contained in the single, prior art document may still be considered for purposes of anticipation if that material is incorporated by reference into the document.” *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1346 (Fed. Cir. 2009) (citing *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000)) (internal citations omitted); *Arbutus*, 65 F.4th at 663. “The incorporation standard relies only on the reasonably skilled artisan and his or her ability to deduce from language, however imprecise, what a host document aims to incorporate.” *Husky Injection Molding Sys. Ltd. v. Athena Automation Ltd.*, 838 F.3d 1236, 1248 (Fed. Cir. 2016); *Harari v. Lee*,

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656 F.3d 1331, 1335 (Fed. Cir. 2011) (“the entire [] application disclosure [at-issue] was incorporated by the broad and unequivocal language: ‘The disclosures of the two applications are hereby incorporate[d] by reference.’”). Hernandez meets this standard, as it “incorporates herein by reference any and all U.S. patents, U.S. applications, and other documents cited or referred to in th[e] [Hernandez] application,” including Murray. Ex-1005, 1:5-7, 1:28-48 (citing and discussing Murray).

Hernandez therefore anticipates this limitation for at least two independent reasons. First, Hernandez anticipates this limitation given that Hernandez’s disclosed range of “approximately 0.005 inch [0.127 mm] to approximately 0.0056 inch [0.142 mm]” incorporated from Ex-1006, 5:44-46, “‘entirely encompasses, and does not significantly deviate from’ the claimed ranges.” *Arbutus*, 65 F.4th at 666; *supra* §XI.1. Second, Hernandez’s broadest disclosed range of “about 0.0030 [0.076 mm] to about 0.0060 inches [0.152 mm]” establishes a *prima facie* case of anticipation because it fully encompasses the claimed range and the burden shifts to Patent Owner to show that the claimed range is “critical to the operability of the claimed invention,” which it will not be able to show. *UCB*, 65 F.4th at 687; *supra* §XI.1. Indeed, the ’067 patent does not describe any of the blade dimensions as critical. And the ’067 patent’s allegedly novel embodiments **do not** have thicknesses within the claimed range. Ex-1001, 12:46-13:29, Table 1; *Hospira*, 2018 WL

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1187484, at *11 (finding claims anticipated in an IPR proceeding as “claimed range of ‘about 10°C to about 18°C’ cannot be critical to practicing the alleged invention if the sole alleged benefit is also achieved below the range, at temperatures disclosed in the prior art.”), *aff’d*, 946 F.3d 1333 (Fed. Cir. 2020). Further, the ’067 patent admits that prior art tape measures have thicknesses within the claimed range yet asserts that the prior art does not achieve the claimed standout. Ex-1001, 12:46-66, Table 1.

8) “a length between 15 feet and 40 feet;” [1H]

Hernandez discloses this limitation. Hernandez discloses an embodiment where “[t]he extended portion 60 of the elongated blade 20 may have a standout arcuate length of at least ten feet with a horizontal linear length greater than ninety-seven percent of the standout arcuate length.” Ex-1005, 4:47-50, 1:31-34. Hernandez therefore discloses, at a minimum, a tape measure having a length of at least 10 feet, which includes “a length between 15 feet and 40 feet.” *Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1581 (Fed. Cir. 1995) (holding “at least” means “as the minimum”).

Hernandez separately discloses this limitation through incorporation by reference of Murray. Ex-1005, 1:5-7, 1:28-29; *Arbutus*, 65 F.4th at 666. Murray discloses an embodiment where “the rule assembly 10,” i.e., tape measure, “is provided with a 33 foot long blade[.]” Ex-1006, 8:6-9, 11:6-21 (describing “a 33-

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foot long blade constructed according to the principles of the invention” that has “up to 13 feet of blade standout”).

Hernandez therefore anticipates this limitation for at least two independent reasons. First, Hernandez teaches a tape measure with a value that falls within the claimed range, a length of 33 feet. Ex-1006, 8:6-9, 11:6-21; *Ineos*, 783 F.3d at 869. Second, Hernandez anticipates this limitation given that Hernandez’s disclosed range of “at least ten feet[,]” Ex-1005, 4:47-50, 1:31-34, to “approximately 33 feet[,]” incorporated from Murray, Ex-1006, 8:18-23, 8:6-9, establishes a *prima facie* case of anticipation because it overlaps the claimed range and the burden shifts to Patent Owner to show that the claimed range is “critical to the operability of the claimed invention,” which it will not be able to show. *UCB*, 65 F.4th at 687; *supra* §XI.1.

9) “a flat width of 20 mm to 40 mm;” [11]

Hernandez discloses this limitation. Hernandez discloses that “the blade ... in the flattened condition may have a width of at least about 1 inch [25.400 mm]” up to “about 1.625 inches [41.275 mm].” Ex-1005, 4:23-25. Separately, Hernandez incorporates by reference Murray, which also discloses blade flat widths, which can range from about “approximately 1.10 inches [27.940 mm] to approximately 1.5 inches [38.100 mm][,]” more specifically from about “approximately 1.25 inches [31.750 mm] to approximately 1.39 inches [35.306 mm][,]” and further discloses an

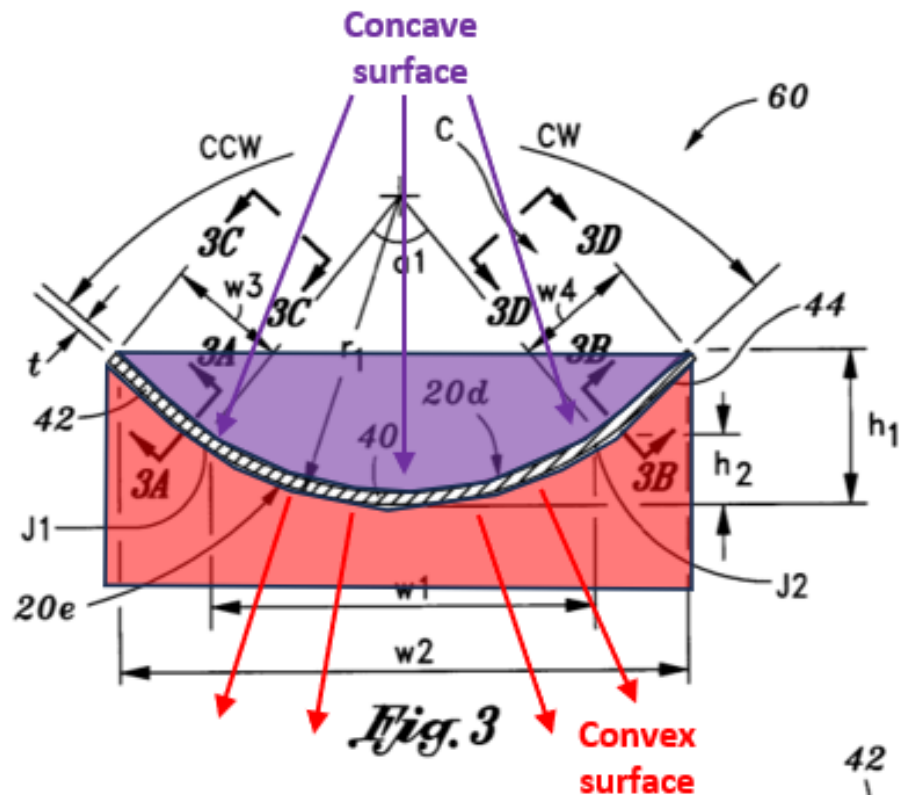
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embodiment wherein “the blade 16 width is approximately 1.25 inch [31.750 mm][.]” Ex-1006, 5:30-51.

Hernandez therefore anticipates this limitation for at least three independent reasons. First, Hernandez teaches a tape measure with a flat width with a value that falls within the claimed range, for example, a tape measure having a flat width of 31.75 mm. Ex-1006, 5:47-48; *Ineos*, 783 F.3d at 869. Second, Hernandez anticipates this limitation given that Hernandez’s disclosed range of “approximately 1.10 inches [27.940 mm] to approximately 1.5 inches [38.100 mm]” incorporated from Murray, Ex-1006, 5:30-33, and “about 1 inch [25.400 mm] ... to about 1.625 inches [41.275 mm][.]” Ex-1005, 4:23-25, “does not significantly deviate from the claimed ranges.” *Arbutus*, 65 F.4th at 666; *supra* §XI.1. Third, at a minimum, Hernandez’s overlapping ranges establish a *prima facie* case of anticipation and the burden shifts to Patent Owner to show that the claimed range is “critical to the operability of the claimed invention,” which it will not be able to show. *UCB*, 65 F.4th at 687; *supra* §XI.1. Indeed, the ’067 patent does not describe any of the blade dimensions as critical. And the ’067 patent admits that prior art tape measures have flat widths within the claimed range yet asserts that the prior art does not achieve the claimed standout. Ex-1001, 12:46-13:29, Table 1. *Hospira*, 2018 WL 1187484, at *11; *Ornitz*, 351 F.2d at 1017.

- 10) “a curved profile such that the upper surface of the elongate blade defines a concave surface and the lower surface defines a convex surface;” [1J]

Hernandez discloses this limitation. Hernandez discloses an elongated blade with an upper surface, §XII.1.a.5, a lower surface, §XII.1.a.6, and “when in extended position, has a predetermined cross-sectional curvature formed by a concave-convex segment[.]” Ex-1005, 1:64-2:1, 4:27-36, Fig. 2A. Figure 3 of Hernandez illustrates the “curved cross-section,” including the “concave” “upper surface” and “convex” “lower surface”:



Ex-1005, Fig. 3, 1:39-48.

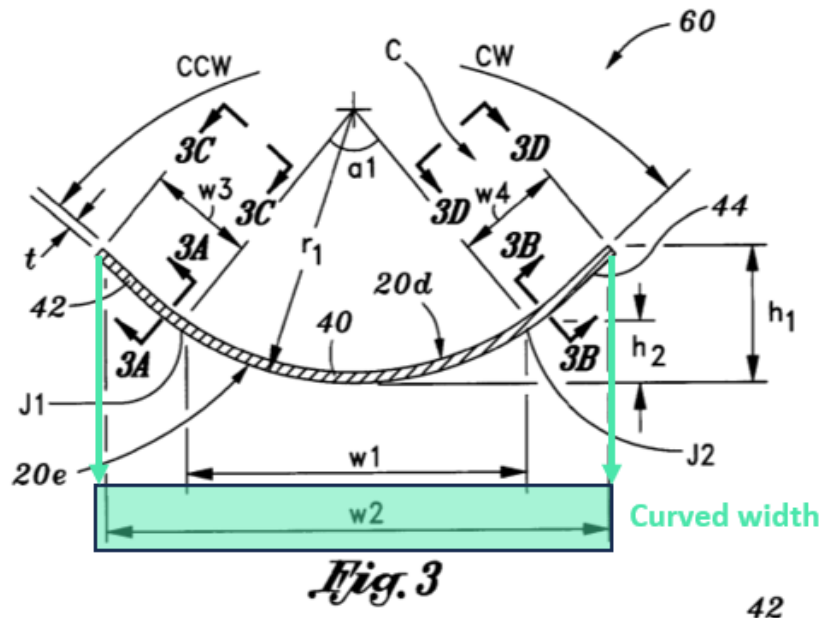
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Separately, Hernandez incorporates Murray, which discloses a “concavo-convex cross-section of the blade 16 has a unique geometry ... that increases in the stand-out ability,” and discloses “[t]he concavo-convex cross-sectional configuration of the blade 16 includes an arcuate central section 36 and integral arcuate end sections 38.” Ex-1006, 5:63-6:23, 2:7-18; §§XII.1.a.5, XII.1.a.6.

11) “*a curved width, wherein the curved width is less than the flat width; and*” [1K]

Hernandez discloses this limitation. Hernandez discloses that the extended blade may have a curved width with a range “from about 0.925 inch to [23.498 mm] to about 1.25 inch [31.750 mm][,]” Ex-1005, 4:41-43, and further discloses that the blade flat width should be “at least about 1 inch,” but could be up “to about 1.625 inches [41.275 mm].” Ex-1005, 4:23-25. In addition, Hernandez incorporates by reference Murray, which discloses a curved width with a value of “approximately 1.018 inches [25.857 mm]” when the “preferred 1.25 inch blade (flat width F) is in its concavo-convex cross-sectional configuration[.]” Ex-1006, 7:58-62; §XII.1.a.9.

Figure 3 of Hernandez illustrates the “curved width”:



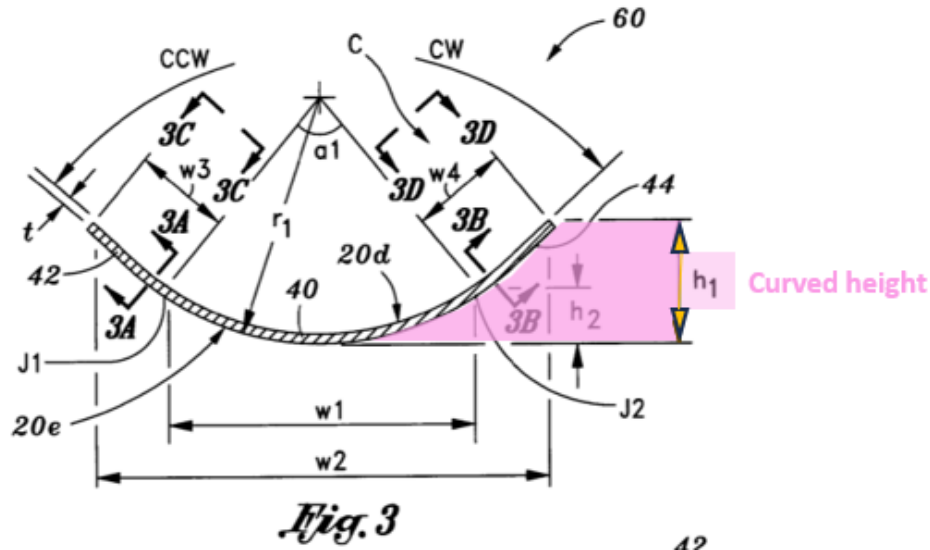
Ex-1005, Fig. 3.

Moreover, Hernandez inherently anticipates this limitation because a tape measure having a curved width less than the flat width is an inherent property, as any POSA would understand. Ex-1003 ¶¶48-50. When a given tape measure blade's cross-section is curved, the resulting width will necessarily be less than its flat width. *Id.* In other words, the arc length along the shape of a blade's cross-sectional curve will always exceed the flattened projection of the blade's curved segment. Thus, the curved width will always be less than the flat width for a given tape measure. *Id.*

12) “a curved height between 8.5 mm and 9.5 mm;” [1L]

Hernandez discloses this limitation. Hernandez discloses tape measures with a range of curved heights, “from about 0.125 inch [3.175 mm] to about 0.500 inch

[12.70 mm],” Ex-1005, 4:41-42. Figure 3 of Hernandez illustrates the “curved height”:



Ex-1005, Fig. 3.

Hernandez also incorporates by reference Murray, which also discloses curved heights, which can range from “approximately 0.25 inch [6.350 mm] to approximately 0.40 inch [10.160 mm][,]” and more specifically from “approximately 0.30 inch [7.620 mm] to approximately 0.35 inch [8.890 mm][.]”

Ex-1006, 5:30-46.

Hernandez therefore anticipates this limitation for at least two independent reasons. First, Hernandez anticipates this limitation given that Hernandez’s disclosed range of “approximately 0.25 inch [6.350 mm] to approximately 0.40 inch [10.160 mm]” incorporated from Ex-1006, 5:30-35, “entirely encompasses, and does not significantly deviate from the claimed ranges.” *Arbutus*, 65 F.4th 666; *supra*

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§XI.1. Second, at a minimum, Hernandez’s overlapping ranges establish a *prima facie* case of anticipation and the burden shifts to Patent Owner to show that the claimed range is “critical to the operability of the claimed invention,” which it will not be able to show. *UCB*, 65 F.4th at 687; *supra* §XI.1. Indeed, the ’067 patent does not describe any of the blade dimensions as critical. And the ’067 patent admitted that prior art tape measures had curved heights within the claimed range yet asserts that the prior art does not achieve the claimed standout. Ex-1001, 12:46-13:29, Table 1. *Hospira*, 2018 WL 1187484, at *11; *Ornitz*, 351 F.2d at 1017.

13) “wherein a ratio of the curved width to the flat width is between 0.6 and 0.8;” [IM]

Hernandez discloses this limitation. Hernandez teaches ranges of curved widths and flat widths that necessarily include the claimed ratio of curved width to flat width of 0.6 to 0.8. *Arbutus*, 65 F.4th at 664 (“To anticipate, the prior art need only meet the inherently disclosed limitation to the same extent as the patented invention.”); *In re Taylor*, 621 F. App’x 667, 669 (Fed. Cir. 2015) (affirming anticipation rejection of broadening reissue claim because the prior art “teach[] weight concentrations that arithmetically give ratios [within claimed range]”). Specifically, Hernandez discloses a range of curved widths, and a range of flat widths, that necessarily and inherently result in ratios that range from approximately 0.569 (0.925 in / 1.625 in) to 1 (e.g., 1 in / 1 in) at their broadest. §§XII.1.a.11, XII.1.a.9. Hernandez further discloses this limitation because it incorporates Murray,

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which also discloses a curved width, and a range of flat widths, that necessarily and inherently result in ratios that range from approximately 0.679 (1.018 in / 1.5 in) to 0.925 (1.018 in / 1.1 in). *Id.*

Hernandez therefore anticipates this limitation for at least two independent reasons. First, Hernandez's broadest disclosed range of 0.569 to 1 establishes a *prima facie* case of anticipation because it fully encompasses the claimed range, and the burden shifts to Patent Owner to show that the claimed ratio is "critical to the operability of the claimed invention," which it will not be able to show. *Supra* §XI.1. For at least the same reasons Patent Owner will be unable to show that the claimed ranges for curved widths and flat widths are not critical to the operability of the claimed invention, Patent Owner will not be able to show that the claimed ratio of the curved width to flat width is critical to the operability of the claimed invention. §§XII.1.a.9, XII.1.a.11. Indeed, the '067 patent admits prior art tape measures had the claimed ratio of curved width to flat width. Ex-1001, Table 2; *Hospira*, 2018 WL 1187484, at *11; *Ornitz*, 351 F.2d at 1017. Second, Hernandez anticipates this limitation given that Hernandez, as incorporated from Murray, discloses a range of 0.68 to 0.93, which does not significantly deviate from the claimed ranges. Ex-1006, 5:30-33, 7:58-62; *supra* §XI.1.

14) “wherein a ratio of curved height to flat width is greater than 0.285;” [1N]

Hernandez discloses this limitation. Hernandez discloses ranges of curved heights, and flat widths, that necessarily include and inherently result in ratios that range from approximately from 0.077 (3.175 mm / 41.275 mm) to 0.5 (12.7 mm / 25.4 mm). §§XII.1.a.12, XII.1.a.9; *Arbutus*, 65 F.4th at 664; *Genentech*, 946 F.3d at 1338; *Taylor*, 621 F. App’x at 669. Hernandez further discloses this limitation because it incorporates Murray, which also discloses ranges of curved heights, and flat widths, and further teaches a range of ratios of the curved heights to the flat widths, from 0.167 (6.35 mm / 38.1 mm) to 0.364 (10.16 mm / 27.94 mm). *Id.*

Hernandez therefore anticipates this limitation as it discloses ratios, both in its own specification (0.077 to 0.5) and as incorporated from Murray (0.167 to 0.364), that overlap with the claimed ratio and the burden shifts to Patent Owner to show that the claimed range is “critical to the operability of the claimed invention,” which it will not be able to show. *Supra* §XI.1. For at least the same reasons Patent Owner will be unable to show that the claimed ranges for curved widths and flat widths are critical to the operability of the claimed invention, Patent Owner will not be able to show that the claimed ratio of the curved height to flat width is critical to the operability of the claimed invention. §§XII.1.a.12, XII.1.a.9. Indeed, at least one of the ’067 patent’s allegedly novel embodiments **does not** have the claimed ratio of curved height to flat width, while the ’067 patent admits at least two prior art tape

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measures have the claimed ratio. Ex-1001 Table 2, Table 3; *Hospira*, 2018 WL 1187484, at *11.

15) “wherein a standout distance of the elongate blade from the housing is greater than 150 inches; and” [10]

Hernandez discloses this limitation. Hernandez discloses tape measures comprising “a standout arcuate length of at least ten feet.” Ex-1005, 4:47-50, 1:31-34; *Quantum*, 65 F.3d at 1581 (holding “at least” means “as the minimum”); *Applied*, 692 F.3d at 1295 (affirming “Board’s conclusion that the prior art discloses dimensional values [e.g., depth of “at least 0.02 inches”] overlapping the ranges claimed in [Asserted] Patents [e.g., “about” 0.02-0.05 inches].”). Hernandez also discloses this limitation through its incorporation by reference of Murray, which discloses a standout length of “up to approximately 13 feet [156 inches].” Ex-1006, 5:49-62, 11:6-10. Hernandez therefore anticipates this limitation as it discloses standout distances that overlap with the claimed distance and the burden shifts to Patent Owner to show that the claimed range is “critical to the operability of the claimed invention,” which it will not be able to show. *Supra* §XI.1.

16) “a retraction system coupled to the tape reel, wherein the retraction system drives rewinding of the elongate blade on to the tape reel.” [1P]

Hernandez discloses this limitation. Hernandez discloses a tape reel “mounted within the internal chamber 12c for rotation[,]” wherein the reel “includes a cylinder 18c, a coil spring 18a operatively disposed within the cylinder 18c, and a central

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shaft 18b connected to the housing 12 about which the reel rotates.” Ex-1005, 3:34-57; §XII.1.a.3. Hernandez explains that “**[t]he coil spring 18a has one end 18d attached to the central rod 18b and its other end 18e attached to the cylinder 18c.**” Ex-1005, 3:57-59. Hernandez further discloses, “[t]he coiled spring 18a is tightened as the blade 20 is manually pulled from the housing 12 **so that it may rewind the extended portion 60 of the blade onto the reel 18** upon manipulation of the button 14a to release the brake 12b.” Ex-1005, 3:59-62. Hernandez discloses, “[a]s the blade 20 is pulled from the housing 12, it extends tangentially to the cylinder 18c.” Ex-1005, 3:62-65. Hernandez further teaches, “**[d]ue to the action of the spring 18a, the reel rotates** counter-clockwise as viewed in FIG. 2A, **rewinding the blade 20 around the reel 18** to flatten the blade as it is wound about the reel.” Ex-1005, 4:12-15; §XII.1.a.3. Figure 2A of Hernandez shows the reel rotates counter-clockwise:



- Hernandez discloses this limitation. *Supra* §XII.1.a.

- Hernandez discloses this limitation. Hernandez discloses a tape measure with a “curved profile” that spans the entire extended portion of the blade. Ex-1005, 4:19-34; §XII.1.a.10. Hernandez discloses this limitation because it teaches a tape measure wherein the extended blade has a curved profile that is located “at a location along at least the first 132 inches.”

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1) *“The tape measure of claim 1,”*

Hernandez discloses this limitation. *Supra* §XII.1.a.

2) *“wherein the curved profile is located at a location between 5 feet and 15 feet along a length of the elongate blade measured from a hook located at an end of the tape blade.” [3A]*

Hernandez discloses this limitation. *Supra* §§XII.1.a.10, XII.1.b.2.

d. **Claim 4**

1) *“The tape measure of claim 1,”*

Hernandez discloses this limitation. *Supra* §XII.1.a.

2) *“wherein the curved profile is located at a location between 6.5 feet and 13 feet along a length of the elongate blade measured from a hook located at an end of the tape blade.” [4A]*

Hernandez discloses this limitation. *Supra* §§XII.1.a.10, XII.1.b.2.

e. **Claim 5**

1) *“The tape measure of claim 4,”*

Hernandez discloses this limitation. *Supra* §XII.1.d.

2) *“wherein the flat width is 25 mm to 32 mm.” [5A]*

Hernandez discloses this limitation. *Supra* §XII.1.a.9.

f. **Claim 6**

1) *“The tape measure of claim 5,”*

Hernandez discloses this limitation. *Supra* §XII.1.e.

2) “*wherein the flat width is 32 mm.*” [6A]

Hernandez discloses this limitation. *Supra* §XII.1.a.9.

g. Claim 7

1) “*The tape measure of claim 6,*”

Hernandez discloses this limitation. *Supra* §XII.1.f.

2) “*wherein the curved width is less than 26 mm.*” [7A]

Hernandez discloses this limitation. *Supra* §XII.1.a.11.

h. Claim 8

1) “*The tape measure of claim 1,*”

Hernandez discloses this limitation. *Supra* §XII.1.a.

2) “*wherein the standout distance of the elongate blade from the housing is at least 156 inches.*” [8A]

Hernandez discloses this limitation. *Supra* §XII.1.a.15.

i. Claim 9

1) “*The tape measure of claim 1,*”

Hernandez discloses this limitation. *Supra* §XII.1.a.

2) “*wherein, when the elongate blade is at a maximum standout length, the curved profile is located in a section of tape blade that extends 5 feet from the housing toward a hook located at the end of the tape blade.*” [9A]

Hernandez discloses this limitation. *Supra* §§XII.1.a.10, XII.1.b.2.

j. Claim 11

1) “*The tape measure of claim 1,*”

Hernandez discloses this limitation. *Supra* §XII.1.a.

2) “*wherein the ratio of the curved height to T1 is greater than 65.*” [11A]

Hernandez discloses this limitation. Hernandez discloses a range of curved heights, §XII.1.a.12, and blade thicknesses (T1), §XII.1.a.7, that necessarily and inherently result in ratios that range from 20.833 (0.125 in / 0.006 in) to 166.667 (0.5 in / 0.003 in). *Arbutus*, 65 F.4th at 664; *Genentech*, 946 F.3d at 1338; *Taylor*, 621 F. App’x at 669. Hernandez further discloses this limitation because it incorporates Murray, which also discloses a range of curved heights, §XII.1.a.12, and blade thicknesses, §XII.1.a.7, and further teaches a range of ratios of the curved heights to first thicknesses, from 39.683 (0.25 in / 0.0063 in) to 88.889 (0.4 in / 0.0045 in).

Hernandez therefore anticipates this limitation as it discloses ratios, both in its own specification (20.833 to 166.667) and as incorporated from Murray (39.683 to 88.889), that overlap with the claimed ratio and the burden shifts to Patent Owner to show that the claimed range is “critical to the operability of the claimed invention,” which it will not be able to show. *Supra* §XI.1. For at least the same reasons Patent Owner will be unable to show that the claimed ranges for curved height and thickness are not critical to the operability of the claimed invention, Patent Owner will not be able to show that the ratio that results as a matter of arithmetic from the

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curved height and thickness is critical to the operability of the claimed invention. §§XII.1.a.12, XII.1.a.7. Indeed, the '067 patent admits that prior art tape measures had the claimed ratio. KLEIN-1001, Table 1 (admitting prior art tape nos. 1 and 2 had ratios of the curved height to T1 greater than 65).

k. Claim 12

1) *“The tape measure of claim 1,”*

Hernandez discloses this limitation. *Supra* §XII.1.a.

2) *“wherein the retraction system is a spring-based retraction system comprising a spring coupled to the tape reel,” [12A]*

Hernandez discloses this limitation. *Supra* §XII.1.a.16.

3) *“wherein, as the elongate blade is unwound from the tape reel to extend from the housing, the spring stores energy and the spring releases energy driving rewinding of the elongate blade on to the tape reel.” [12B]*

Hernandez discloses this limitation. Hernandez discloses, [t]he blade 20 is unwound manually to extend outwardly from the opening 12a in the housing[.]” Ex-1005, 3:38-41. Hernandez further discloses “**[t]he coiled spring 18a is tightened as the blade 20 is manually pulled from the housing 12 so that it may rewind the extended portion 60 of the blade 20 onto the reel 18.**” Ex-1005, 3:59-61. Hernandez also discloses that “[d]ue to the action of the spring 18a, the reel rotates counter-clockwise as viewed in FIG. 2A, rewinding the blade 20 around the reel 18 to flatten the blade as it is wound about the reel.” Ex-1005, 4:12-15; §XII.1.a.16.

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Thus, as the elongate blade is unwound from the tape reel to extend from the housing, the spring stores energy and the spring releases energy driving rewinding of the elongate blade on to the tape reel.

Separately, Hernandez incorporates by reference Murray, which also discloses “that as the blade is unwound from the reel 14, the coil spring 32 is wound around the rigidly fixed spindle 15[,]” and further discloses that “[t]his winding of the spring around the spindle stores energy in the spring to provide spring powered rewinding of the blade 16 around the reel 15 when the extended blade is released.” Ex-1006, 4:43-49.

2. Ground 2: Claims 1-9, 11-12 of the '067 Patent are Obvious in View of Hernandez alone, or in Combination with Murray

As discussed above, Claims 1-9, 11-12 of the '067 patent are anticipated by Hernandez. Petitioner presents this alternative ground, however, to demonstrate that Claims 1-9, 11-12 would, at a minimum, still be unpatentable for obviousness under 35 U.S.C. § 103 in view of Hernandez alone, or in combination with Murray.

a. Claim 1

1) “A tape measure comprising:” [1A]

Hernandez alone, or in combination with Murray discloses or renders obvious this limitation. *Supra* §XII.1.a.1.

2) “a housing;” [1B]

Hernandez alone, or in combination with Murray discloses or renders obvious this limitation. *Supra* §XII.1.a.2.

3) “a tape reel rotatably mounted within the housing;” [1C]

Hernandez alone, or in combination with Murray discloses or renders obvious this limitation. *Supra* §XII.1.a.3.

4) “an elongate blade wound around the reel, the elongate blade comprising;” [1D]

Hernandez alone, or in combination with Murray discloses or renders obvious this limitation. *Supra* §XII.1.a.4.

5) “an upper surface;” [1E]

Hernandez alone, or in combination with Murray discloses or renders obvious this limitation. *Supra* §XII.1.a.5.

6) “a lower surface;” [1F]

Hernandez alone, or in combination with Murray discloses or renders obvious this limitation. *Supra* §XII.1.a.6.

7) “an elongate metal core having a first thickness, T_1 , between 0.12 mm and 0.14 mm;” [1G]

Hernandez at a minimum renders this limitation *prima facie* obvious, alone or combination with Murray, through its disclosure of overlapping and encompassing ranges. *UCB*, 65 F.4th at 689; §XII.1.a.7. Patent Owner will be unable to overcome this presumption. *Supra* §XI.2.

Neither Hernandez nor Murray teach away from claimed range. For example, Hernandez explains how the “benefits of [its] invention include, but are not limited to, providing a tape measure blade having a cross-sectional configuration that resists bending,” i.e., having greater standout. Ex-1005, 1:55-60, 1:28-35. Indeed, Murray explains that a “blade construction having dimensions within the broadest ranges” taught by Murray (and Hernandez)—which includes the claimed thickness range—“can have a blade standout in the preferred broad range of at least 10.5 feet to approximately 13 feet.” Ex-1006, 5:51-62.

There would be no unexpected results of the claimed range. The claimed range would do exactly what a POSA would expect, i.e., increasing standout as Hernandez and Murray expressly disclose. Ex-1003 ¶55.

The claimed range is result-effective. As Murray explains, “one skilled in the art will understand that the length of the blade standout depends on many factors, including (but not limited to) ... blade thickness.” Ex-1006, 5:20-65. A POSA would therefore have known that the ranges taught by Hernandez and Murray could be adjusted to adjust standout and would have known how to adjust the claimed range to increase standout. *Id.*; Ex-1003 ¶55-56.

There is a motivation to arrive at the claimed range. Even if Murray were not incorporated by reference into Hernandez (it is), Hernandez’s citation of Murray at a minimum would direct a POSA to look to Murray. *Commonwealth Sci. & Indus.*

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Rsch. Organisation v. Buffalo Tech. (USA), Inc., 542 F.3d 1363, 1372 (Fed. Cir. 2008) (“citation in [reference to other reference] could provide a justification for combining the references for obviousness purposes” even if not rising to level of incorporation); *Merck Serono S.A. v. Hopewell Pharma Ventures, Inc.*, 159 F.4th 10, at *29 (Fed. Cir. 2025) (holding “substantial evidence supports the Board’s finding of a reason to combine [reference and prior art incorporated by reference] with a reasonable expectation of success.”); Ex-1003 ¶¶42-43. Either way, the “overlap [taught by Hernandez and Murray,] itself provides sufficient motivation to optimize the ranges.” *Applied*, 692 F.3d at 1295. Moreover, a POSA having reviewed the teachings of Hernandez and Murray would have understood that the thickness could be adjusted, and such adjustments would have affected, and changed, the length of blade standout. Ex-1003 ¶¶53-55; *Applied*, 692 F.3d at 1295; *E.I. DuPont*, 904 F.3d at 1006. Indeed, a POSA would have been motivated to adjust the blade thickness so as to arrive at the claimed range by their desire to increase the standout of the blade. Ex-1003 ¶¶57, 98-101. Further, a POSA would have understood that altering the blade too thick could result in excessively increasing the size of the housing, which would negatively impact comfort and usability of the tape measure, causing flattening of the blade to be too difficult, or making the tape measure too heavy, which would also lead to discomfort and extra effort in the reeling or deployment of the blade, as expressly taught by Hernandez and Murray. Ex-1003 ¶¶56, 99-101; Ex-

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1005, 1:29-41; Ex-1006, 1:10-12, 1:34-37, 2:19-26, 3:16-20, 5:20-30, 8:6-23, 8:57-65, 11:6-22. A POSA would also have had a reasonable expectation of success, as Hernandez and Murray expressly refer to blade thicknesses for increasing standout in tape measures. Ex-1003 ¶¶58, 102. It was also well understood that a blade's transverse curvature and thickness affected standout, as well as how those parameters could be successfully adjusted, including how to adjust those parameters relative to each other, to achieve their desired standout (i.e., thickness is a results-effective variable), and the straightforward adjustments to those parameters would achieve a predictable result: adjusting standout. Ex-1003 ¶¶30-34, 55. Indeed, any remaining work to optimize the range is “the work of the skillful mechanic, not that of the inventor.” *Sakraida*, 425 U.S. at 282.

8) “a length between 15 feet and 40 feet;” [1H]

Hernandez and Murray disclose this limitation. *Supra* §XII.1.a.8 (Murray disclosing an embodiment with “a 33 foot long blade.”).

Alternatively, Hernandez at a minimum renders this limitation *prima facie* obvious, alone or in combination with Murray. *UCB*, 65 F.4th at 689; *Applied*, 692 F.3d at 1295. Patent Owner will be unable to overcome this presumption. *Supra* §XI.2. Hernandez discloses, at a minimum, a bottom endpoint of “at least ten feet” and Murray discloses an upper endpoint of “a 33-foot long blade,” i.e., an

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overlapping range of 10-33 feet of blade length. Ex-1005, 4:47-50; Ex-1006, 8:6-9, 11:6-21.

Neither Hernandez nor Murray teach away from claimed range.

Hernandez teaches a blade with standout of “at least 10 feet,” and Murray discloses an embodiment with “a 33-foot long blade,” squarely in the claimed range. Ex-1005, 4:47-50; Ex-1006, 8:6-9, 11:6-21.

There would be no unexpected results of the claimed range. Lengthening Hernandez’s blade would straightforwardly result in a longer blade. Ex-1003 ¶62.

There is a motivation to arrive at the claimed range. Even if Murray were not incorporated by reference into Hernandez (it is), Hernandez’s citation of Murray at a minimum would direct a POSA to look to Murray. *Commonwealth*, 542 F.3d at 1372; *Merck* at *29; Ex-1003 ¶¶42-43. Either way, the “overlap [taught by Hernandez and Murray] itself provides sufficient motivation to optimize the ranges.” *Applied*, 692 F.3d at 1295. Indeed, a POSA would have been motivated to adjust the length of the tape to arrive at the claimed range by their desire to increase the usability of the blade, i.e., to measure greater distances. Ex-1003 ¶¶63-64, 98-101; Ex-1005, 1:29-37. A POSA would have a reasonable expectation of success, as Hernandez and Murray expressly teach blade lengths, a POSA would have known how to successfully adjust the length of a blade, and these adjustments would be

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straightforward adjustments, which would achieve a predictable result: lengthening the blade. Ex-1003 ¶¶30-34, 65, 102; *Sakraida*, 425 U.S. at 282.

9) “a flat width of 20 mm to 40 mm;” [1I]

Hernandez at a minimum renders this limitation *prima facie* obvious, alone or in combination with Murray. *UCB*, 65 F.4th at 689; *Applied*, 692 F.3d at 1295. Patent Owner will be unable to overcome this presumption. *Supra* §XI.2.

Hernandez and Murray do not teach away from the claimed range.

Hernandez discloses, at a minimum, a bottom endpoint of “at least about 1 inch [25.400 mm],” and an upper endpoint “of about 1.625 inches [41.275 mm][,]” i.e., a nearly identical range of 25.4 mm-41.275 mm of flat widths. Ex-1005, 4:23-25. Murray also discloses a range of flat widths, *supra* §XII.1.a.9, and discloses an embodiment wherein “the blade 16 width is approximately 1.25 inch [31.750 mm],” squarely in the claimed range (and thus anticipatory). Ex-1006, 5:47-49.

There are no new or unexpected results from the claimed range. Murray discloses that “[g]reater degrees of standout with a comparable percentage of linear to arcuate length-out can be achieved by making the blade wider.” Ex-1006, 7:40-42. Murray also discloses a wider blade “allows the blade height H to be increased[.]” *Id.* at 7:45-50. Adjusting flat width thus yields predictable results: increasing flat width bolsters the curved height of the blade, affecting standout. Ex-1003 ¶69; Ex-1006, 5:10-30.

The claimed range is result-effective. It was well known that the flat width of a blade affects the length of the blade standout. Ex-1003 ¶¶30-34, 69, 72; Ex-1006, 7:40-50, 5:10-65. The adjusting of those parameters was a well-known, elementary concept familiar to a POSA. Ex-1003 ¶69.

There is a motivation to arrive at the claimed range. Even if Murray were not incorporated by reference into Hernandez (it is), Hernandez's citation of Murray at a minimum would direct a POSA to look to Murray. *Commonwealth*, 542 F.3d at 1372; *Merck* at *29; ¶¶42-43. Either way, the "overlap [taught by Hernandez and Murray] itself provides sufficient motivation to optimize the ranges." *Applied*, 692 F.3d at 1295. Indeed, POSA would have been motivated to adjust the flat width of the blade to arrive at the claimed range by their desire to increase the standout of the blade, as expressly taught by Hernandez and Murray. Ex-1003 ¶¶70-71, 98-100; Ex-1005, 1:28-31; Ex-1006, 1:34-37, 5:20-65. A POSA would have a reasonable expectation of success, as Hernandez and Murray expressly refer to blade flat widths for increasing standout in tape measures adjustments to a blade's curvature. Ex-1003 ¶¶67-70. At the same time, a POSA would have understood that altering the blade to be too wide could result in excessively increasing the size of the housing, which would negatively impact comfort and usability of the tape measure, causing flattening of the blade to be too difficult, or making the tape measure too heavy, which would also lead to discomfort and extra effort in the reeling or deployment of

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the blade, as expressly taught by Hernandez and Murray. Ex-1003 ¶¶70, 98-101; Ex-1005, 1:29-41; Ex-1006, 1:10-12, 1:34-37, 2:19-26, 3:16-20, 5:20-30, 7:40-42, 8:6-23, 8:57-65, 11:6-22. Further, a POSA would have known how a blade's curvature and flat width impacted standout and how to successfully adjust those parameters, including how to adjust those parameters relative to each other, to achieve their desired standout. Ex-1003 ¶¶30-34, 69-72, 99-100. These modifications would be straightforward and a POSA would have reasonably expected that tape measures with the claimed flat widths would achieve a predictable result: have an increased blade standout. Ex-1003 ¶¶72, 102; *Sakraida*, 425 U.S. at 282.

- 10) “a curved profile such that the upper surface of the elongate blade defines a concave surface and the lower surface defines a convex surface; [1J]**

Hernandez alone, or in combination with Murray discloses or renders obvious this limitation. *Supra* §XII.1.a.10.

- 11) “a curved width, wherein the curved width is less than the flat width; and” [1K]**

Hernandez alone, or in combination with Murray discloses or renders obvious this limitation. *Supra* §XII.1.a.11.

- 12) “a curved height between 8.5 mm and 9.5 mm;” [1L]**

Hernandez at a minimum renders this limitation *prima facie* obvious, alone or in combination with Murray. *UCB*, 65 F.4th at 689. Patent Owner will be unable to overcome this presumption. *Supra* §XI.2.

Hernandez and Murray do not teach away from the claimed range.

Hernandez explains how the “benefits of [its] invention include, but are not limited to, providing a tape measure blade having a cross-sectional configuration that resists bending,” i.e., having greater standout. Ex-1005, 1:55-60, 1:28-35. Murray explains that a “blade construction having dimensions within the broadest ranges” taught by Murray (and Hernandez)—which includes the claimed height range—“can have standout in the preferred broad range of at least 10.5 feet to approximately 13 feet.” Ex-1006, 5:51-62. Murray also explains “one skilled in the art will understand that the length of the blade standout depends on many factors, including (but not limited to) ... the height of the blade 16 in the concavo-convex configuration.” Ex-1006, 5:20-65.

There are no new or unexpected results from the claimed range. The claimed range would do exactly what a POSA would expect, i.e., increase standout as Hernandez and Murray expressly disclose. Ex-1003 ¶77.

The claimed range is result-effective. It was well known that the curved height of a blade affects the length of blade standout. Ex-1006, 5:20-30; Ex-1003 ¶¶30-34, 77.

There is a motivation to arrive at the claimed range. Even if Murray were not incorporated by reference into Hernandez (it is), Hernandez’s citation of Murray at a minimum would direct a POSA to look to Murray. *Commonwealth*, 542 F.3d at

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1372; *Merck* at *29; Ex-1003 ¶¶42-43. Either way, the “overlap [taught by Hernandez and Murray] itself provides sufficient motivation to optimize the ranges.” *Applied*, 692 F.3d at 1295. Indeed, a POSA would have been motivated to adjust the curved height of the blade to arrive at the claimed range by their desire to increase the standout of the blade, as expressly taught by Hernandez and Murray. Ex-1003 ¶¶78-79, 98-101; Ex-1005, 1:28-31; Ex-1006, 1:34-37, 5:20-38. A POSA would have a reasonable expectation of success, as Hernandez and Murray expressly refer to blade curved heights for increasing standout in tape measures. Ex-1003 ¶¶75-78, 102; Ex-1006, 7:45-50 (discussing that increasing the flat width of a blade, “allows the blade height H to be increased without increasing the overall blade curvature[.]”). POSAs had long known how a blade’s curvature, including curved height, affected standout and how to successfully adjust those parameters to achieve their desired standout. Ex-1003 ¶¶30-34, 80. These modifications would be straightforward to a POSA and would achieve a predictable result: have an increased blade standout. Ex-1003 ¶¶80, 102; *Sakraida*, 425 U.S. at 282.

13) “wherein a ratio of the curved width to the flat width is between 0.6 and 0.8;” [IM]

Hernandez renders this limitation *prima facie* obvious, alone or in combination with Murray. *UCB*, 65 F.4th at 689. Hernandez and Murray teach ranges of curved widths and flat widths that necessarily include the claimed ratio of curved width to flat width. §XII.1.a.13; *Arbutus*, 65 F.4th at 664; *Taylor*, 621 F.

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App'x at 669 (affirming anticipation rejection of broadening reissue claim because the prior art “teach[] weight concentrations that arithmetically give ratios [within claimed range]”). This case of *prima facie* obviousness can only be overcome if “the prior art teaches away from the claimed range,” “the claimed range produces new and unexpected results,” “or other evidence demonstrates nonobviousness of the claimed range.” *Supra* §XI.2. None is true here for the reasons stated above for curved width and flat width, or the ratios of same. §§XII.1.a.9, XII.1.a.13 (explaining that '067 patent admits the prior art had the claimed ratios).

14) “wherein a ratio of curved height to flat width is greater than 0.285;” [1N]

Hernandez renders this limitation *prima facie* obvious, alone or in combination with Murray. *UCB*, 65 F.4th at 689. Hernandez and Murray teach ranges of curved heights and flat widths that necessarily include the claimed ratio of curved height to flat width. §§XII.1.a.12, XII.2.a.9, XII.1.a.14; *Arbutus*, 65 F.4th at 664; *Taylor*, 621 F. App'x at 669. This *prima facie* obviousness can only be overcome if “the prior art teaches away from the claimed range,” “the claimed range produces new and unexpected results,” “or other evidence demonstrates nonobviousness of the claimed range.” *Supra* §XI.2. None is true here for the reasons stated above. §§XII.1.a.9, XII.1.a.14 (explaining that '067 patent admits the prior art had the claimed ratios and that an allegedly inventive tape measure did not).

15) “wherein a standout distance of the elongate blade from the housing is greater than 150 inches; and” [10]

Hernandez discloses this limitation through its teaching of a standout length of “at least ten feet” and Murray’s standout of “up to approximately 13 feet [156 inches].” §XII.1.a.15. Even if not anticipated by Hernandez (it is), Hernandez at a minimum renders this limitation *prima facie* obvious, alone or in combination with Murray. *UCB*, 65 F.4th at 689. Patent Owner will be unable to overcome this presumption. *Supra* §XI.2.

Hernandez and Murray do not teach away from the claimed range.

Hernandez explains how the “benefits of [its] invention include, but are not limited to, providing a tape measure blade having a cross-sectional configuration that resists bending,” i.e., having greater standout. Ex-1005, 1:55-60, 1:28-35. Murray discloses that “[o]ne of the most desirable characteristics commercial rule assemblies can possess is a relatively long blade standout.” Ex-1006, 1:10-12.

There are no new or unexpected results from the claimed range. Choosing a standout toward the upper end of the range taught by Murray would do exactly what a POSA would expect: increase standout. Ex-1003 ¶¶30-34, 82-83.

The claimed range is result-effective. POSAs have long understood that standout could be increased by adjusting a blade’s thickness, flat width, and curved profile. Ex-1021, 2:45-54; Ex-1005, 1:29-41; Ex-1006, 2:7-8, 3:16-20; 5:10-30; 5:63-65, Fig. 7; Ex-1003 ¶¶30-34, 84.

There is a motivation to arrive at the claimed range. Even if Murray were not incorporated by reference into Hernandez (it is), Hernandez's citation of Murray at a minimum would direct a POSA to look to Murray. *Commonwealth*, 542 F.3d at 1372; *Merck* at *29; Ex-1003 ¶¶42-43. Either way, the "overlap [taught by Hernandez and Murray] itself provides sufficient motivation to optimize the ranges." *Applied*, 692 F.3d at 1295. Indeed, a POSA would have been motivated to design a tape measure with standout toward the upper end taught by Murray (156 inches) as it is "[o]ne of the most desirable characteristics" a tape measure can have. Ex-1006, Cover, 1:10-37, 1:62-67, 2:7-8, 2:19-26, 3:16-20, 3:48-53, 5:6-30, 5:48-67, 6:28-47, 6:55-65, 7:9-13, 7:65-8:5, 11:6-10; Ex-1005, 1:28-60; Ex-1003 ¶¶83-84, 98-101. A POSA would have a reasonable expectation of success, as POSAs had long known how standout could be increased by adjusting a blade's thickness, flat width, and curved profile. Ex-1003 ¶¶30-34, 85, 98-100, 102. These adjustments would be straightforward and a POSA would have reasonably expected that tape measures with the claimed range would achieve a predictable result: have an increased blade standout. *Id.*; Ex-1006, 5:21-30; *Sakraida*, 425 U.S. at 282.

- 16) "a retraction system coupled to the tape reel, wherein the retraction system drives rewinding of the elongate blade on to the tape reel." [1P]**

Hernandez alone, or in combination with Murray, discloses this limitation. *Supra* §XII.1.a.16.

b. Claim 2

1) “*The tape measure of claim 1,*”

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.a.

2) “*wherein the curved profile is located at a location along at least the first 132 inches of a length of the elongate blade.*” [2A]

Hernandez alone, or in combination with Murray, discloses this limitation. *Supra* §§XII.1.a.10, XII.1.b.2.

c. Claim 3

1) “*The tape measure of claim 1,*”

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.a.

2) “*wherein the curved profile is located at a location between 5 feet and 15 feet along a length of the elongate blade measured from a hook located at an end of the tape blade.*” [3A]

Hernandez alone, or in combination with Murray, discloses this limitation. *Supra* §§XII.1.a.10, XII.1.b.2.

d. Claim 4

1) “*The tape measure of claim 1,*”

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.a.

- 2) “*wherein the curved profile is located at a location between 6.5 feet and 13 feet along a length of the elongate blade measured from a hook located at an end of the tape blade.*” [4A]

Hernandez alone, or in combination with Murray, discloses this limitation.

Supra §§XII.1.a.10, XII.1.b.2.

e. Claim 5

- 1) “*The tape measure of claim 4,*”

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.d.

- 2) “*wherein the flat width is 25 mm to 32 mm.*” [5A]

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.a.9.

f. Claim 6

- 1) “*The tape measure of claim 5,*”

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.e.

- 2) “*wherein the flat width is 32 mm.*” [6A]

Hernandez at a minimum renders this limitation *prima facie* obvious, alone or in combination with Murray. §XII.2.a.9; *UCB*, 65 F.4th at 689; *Applied*, 692 F.3d at 1295. Patent Owner will be unable to overcome this presumption. *Supra* §XI.2. Namely, Hernandez discloses a range of flat widths of 25.4 mm to 41.275 mm, which

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includes a flat width of 32 mm. §XII.2.a.9. Murray also discloses a range of flat widths of 27.94 mm to 38.1 mm, and a narrower range of 31.75 mm to 35.306 mm, both of which include a flat width of 32 mm. *Id.* It would have been obvious to a POSA to modify the flat width to arrive at the claimed value by their desire to increase the standout of the blade, as expressly taught by Hernandez and Murray. Ex-1003 ¶¶69-72, 87-89; Ex-1005, 1:28-31; Ex-1006, 1:34-37, 5:20-65. And modifying the flat width to arrive at the claimed value would be a matter of routine optimization. Ex-1003 ¶ 87.

Murray teaches a blade flat width of “approximately 1.25 inch [31.75 mm],” i.e., a nearly identical value of 32 mm. Ex-1006, 5:47-49. A POSA would have been motivated to adjust the flat width of the blade to arrive at the claimed value by their desire to increase the standout of the blade, as expressly taught by Hernandez and Murray. Ex-1003 ¶¶88-90, 98-101; Ex-1005, 1:28-41; Ex-1006, 1:10-12, 1:34-37, 2:19-26, 3:16-20, 5:20-30, 5:51-62. For example, Murray discloses that “[g]reater degrees of standout with a comparable percentage of linear to arcuate length-out can be achieved by making the blade wider.” *Id.* at 7:40-42.

A POSA would understand that the claimed value is in the broader range which Murray describes as achieving blade standout in the higher range, i.e., 13 feet. Ex-1003 ¶¶88-89, Ex-1006, 5:51-62. A POSA would have a reasonable expectation of success, as Hernandez and Murray expressly refer to blade flat widths for

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increasing standout in tape measures adjustments to a blade's curvature. Ex-1003 ¶¶30-34, 91, 100, 102. A POSA would have known how a blade's curvature and flat width impacted standout and how to successfully adjust those parameters, including how to adjust those parameters relative to each other, to achieve their desired standout. *Id.* At the same time, a POSA would have understood that altering the blade to be too wide could result in excessively increasing the size of the housing would negatively impact comfort and usability of the tape measure, as discussed above. §XI.2.a.9; Ex-1003 ¶88. These modifications would be straightforward and a POSA would have reasonably expected that tape measures with the claimed flat widths would achieve a predictable result: have an increased blade standout. Ex-1003 ¶¶91, 102; *Sakraida*, 425 U.S. at 282.

g. Claim 7

1) “*The tape measure of claim 6,*”

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.f.

2) “*wherein the curved width is less than 26 mm.*” [7A]

Hernandez at a minimum renders this limitation *prima facie* obvious, alone or in combination with Murray. *UCB*, 65 F.4th at 689; *Applied*, 692 F.3d at 1295; §XII.1.a.11. Patent Owner will be unable to overcome this presumption. *Supra* §XI.2. Namely, Hernandez discloses a range of curved widths of 23.498 mm to

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31.750 mm, which includes curved widths of less than 26 mm. §XII.1.a.11. A POSA would have been motivated to adjust the blade curvature and flat width so as to arrive at the claimed value by their desire to increase the standout of the blade. *Id.*; Ex-1005, 1:28-31; Ex-1006, 1:34-37, 5:20-65, 7:45-50, Ex-1003 ¶¶30-34, 98-101.

Additionally, it would have been obvious to a POSA to modify the curved width to have a width of less than 26 mm when the flat width is 32 mm by their desire to increase the standout of the blade, as expressly taught by Hernandez and Murray. Ex-1003 ¶¶93-94; Ex-1005, 1:28-31; Ex-1006, 1:34-37, 5:20-30. At a minimum, Hernandez and Murray both teach curved widths of less than 26 mm. More specifically, Murray teaches an embodiment wherein “the curved or arcuate width W is approximately 1.018 inches [25.857 mm][,]” i.e., less than 26 mm, “[w]hen the preferred 1.25 inch [31.75 mm] blade (flat width F) is in its concavo-convex cross-sectional configuration[.]” Ex-1006, 7:58-62. A POSA would know how to increase the flat width to 32 mm, §§XII.2.f.2, XII.2.a.9, XII.2.a.12, without the need to increase the curved width by, for example, increasing the curved height, which would have the added benefit of further increasing standout. Ex-1003 ¶¶30-34, 97. For example, Murray teaches that “[i]t can be understood by one skilled in the art that the 1.25 inch [31.75 mm] blade width of a preferred embodiment of the assembly 10 allows the blade height H to be increased without increasing the overall blade curvature[.]” Ex-1006, 7:45-50.

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A POSA would have understood that curvature, including curved width, and flat width affect blade standout, and that the claimed value is in the broadest range which Murray describes as achieving blade standout in the higher range, i.e., 13 feet. Ex-1003 ¶¶95; *E.g.*, Ex-1006, 5:20-65. A POSA would have a reasonable expectation of success, as Hernandez and Murray expressly refer to blade curvature and flat width for increasing standout in tape measures adjustments to a blade's curvature. §§XII.2.f.2, XII.2.a.9, XII.2.a.12; Ex-1003 ¶¶30-34, 93-97. Further, a POSA would have known how a blade's curvature and flat width impacted standout and how to successfully adjust those parameters, including how to adjust those parameters relative to each other, to achieve their desired standout. *Id.*; Ex-1003 ¶¶98-101. These modifications would be straightforward and a POSA would have reasonably expected that tape measures with a curved width of "less than 26 mm" would achieve a predictable result: have an increased blade standout. Ex-1003 ¶¶97, 102; *Sakraida*, 425 U.S. at 282.

h. Claim 8

1) "The tape measure of claim 1,"

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.a.

- 2) ***“wherein the standout distance of the elongate blade from the housing is at least 156 inches.” [8A]***

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.a.15.

i. Claim 9

- 1) ***“The tape measure of claim 1,”***

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.a.

- 2) ***“wherein, when the elongate blade is at a maximum standout length, the curved profile is located in a section of tape blade that extends 5 feet from the housing toward a hook located at the end of the tape blade.” [9A]***

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §§XII.1.a.10, XII.1.b.2.

j. Claim 11

- 1) ***“The tape measure of claim 1,”***

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.a.

- 2) ***“wherein the ratio of the curved height to T1 is greater than 65.” [11A]***

Hernandez renders this limitation *prima facie* obvious, alone or in combination with Murray. *UCB*, 65 F.4th at 689. As explained above, Hernandez and Murray teach ranges of curved heights and thicknesses that necessarily include

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the claimed ratio of curved height to thickness. §XII.1.j.2; *Arbutus*, 65 F.4th at 664; *Taylor*, 621 F. App'x at 669. This case of *prima facie* obviousness can only be overcome if “the prior art teaches away from the claimed range,” “the claimed range produces new and unexpected results,” “or other evidence demonstrates nonobviousness of the claimed range.” *Supra* §XI.2. None is true here for the reasons stated above. §§XII.2.a.12, XII.2.a.7, XII.1.j.2 (explaining that '067 patent admits the prior art had the claimed ratios).

k. Claim 12

1) “*The tape measure of claim 1,*”

Hernandez alone, or in combination with Murray, discloses or renders obvious this limitation. *Supra* §XII.2.a.

2) “*wherein the retraction system is a spring-based retraction system comprising a spring coupled to the tape reel,*” [12A]

Hernandez alone, or in combination with Murray, discloses this limitation. *Supra* §XII.1.a.16.

3) “*wherein, as the elongate blade is unwound from the tape reel to extend from the housing, the spring stores energy and the spring releases energy driving rewinding of the elongate blade on to the tape reel.*” [12B]

Hernandez alone, or in combination with Murray, discloses this limitation. *Supra* §XII.1.k.3.

3. Ground 3: Claim 10 of the '067 Patent is Obvious over Hernandez in View of Gilliam

a. Claim 10

1) “The tape measure of claim 1, further comprising:”

Hernandez discloses or renders this limitation obvious for the reasons described above. *Supra* §§XII.1.a, XII.2.a.

2) “*an upper polymer coating coupled to an upper surface of the elongate metal core,*” [10A]

Hernandez discloses an elongate metal blade, with a top side. §§XII.1.a.7, XII.1.a.5. Hernandez also incorporates by reference Murray, which discloses that a plastic material (i.e., polymer) coating should be applied to the upper surface of the blade to protect the markings and blade. Ex-1006, 2:27-29, 14:4-52, 18:30-32. Hernandez therefore discloses the use of a polymer coating on the upper surface.

Gilliam also teaches coating tape measure blades with a polymer coating. Ex-1009 ¶3. Gilliam discloses that the polymer coating “increase[s] abrasion resistance and/or to provide a low friction surface to aid in coiling the blade 12.” *Id.* ¶7, Abstract, ¶¶3-4, 15, 23. Gilliam discloses an embodiment wherein “a metallic tape blade is substantially coated with a powder and then passed through an induction unit to heat the powder and form a coating on the blade, with the blade having a concavo-convex cross-section when passing through the induction unit.” *Id.* ¶7, Abstract, ¶¶20-22.

3) *“the upper polymer having a second thickness, T₂; and”*
[10B]

Gilliam discloses a polymer coating applied to the metallic tape blade on both sides having a “thickness of not more than about 0.001 inches [0.025 mm] or less per side.” Ex-1009 Abstract, ¶¶7, 20.

4) *“a lower polymer coating coupled to a lower surface of the elongate metal core,”* [10C]

Gilliam discloses a polymer coating applied to the metallic tape blade having a “thickness of not more than about 0.001 inches [0.025 mm] or less per side.” *Id.* Gilliam therefore discloses a polymer coating “coupled to a lower surface of the elongate metal core.”

5) *“the lower polymer coating having a third thickness, T₃,”* [10D]

Gilliam teaches that the lower polymer coating would have a thickness “on the order of 0.001 inches [0.025 mm] or less.” *Id.*

6) *“wherein T₁+T₂+T₃ is between 0.15 mm and 0.5.”* [10E]

Hernandez teaches the first thicknesses (T₁) can range “from about 0.0030 inch [0.076 mm] to 0.0060 inch [0.152 mm].” §§XII.1.a.7, XII.2.a.7. Gilliam discloses that the second (T₂) and third (T₃) thicknesses should be “on the order of 0.001 inches [0.025 mm] or less.” Ex-1009 ¶20, ¶7. As a result, Hernandez in combination with Gilliam teaches ranges for the sum of “T₁+T₂+T₃” that overlaps the claimed range: 0.126 mm [0.076 mm + 0.025 mm + 0.025 mm] to 0.202 mm

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[0.152 mm + 0.025 mm + 0.025 mm]. Hernandez in combination with Gilliam therefore renders this limitation *prima facie* obvious. *UCB*, 65 F.4th at 689; *supra* §XI.2. Patent Owner will be unable to overcome this presumption.

Hernandez and Gilliam do not teach away from the claimed range.

Hernandez, through its incorporation of Murray, discloses that applying a coating to the tape blade would increase the life of the blade (e.g., improve abrasion resistance and/or reduce friction). Ex-1006, 2:27-29, 14:4-52, 18:30-32. However, Murray only expressly discloses coating one side of the blade. *Id.* While Murray discloses a thicker coating than Gilliam, this does not teach away from using the thicknesses taught by Gilliam because it would have been obvious to a POSA to choose the thinner thickness taught by Gilliam when applying the coating to **both sides** of the blade to avoid the need to increase the size of the housing to accommodate a thicker tape. Ex-1006, 8:55-65, 9:30-35 (noting the importance of having “the footprint of the housing assembly to be made small to be comfortably grippable using one hand.”); Ex-1003 ¶107.

There are no new or unexpected results from the claimed range. Applying coatings with thicknesses within the claimed range would do exactly what a POSA would expect: “increase[s] abrasion resistance,” i.e., protect the blade, “and/or to provide a low friction surface to aid in coiling the blade.” Ex-1009 ¶7, Abstract, ¶¶3-4, 15, 23; Ex-1006, 2:27-29, 14:4-52, 18:30-32; Ex-1003 ¶¶105, 109-114. Indeed,

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coating a tape blade is not a novel idea: Gilliam discloses, “[w]hile the base material of the blade is typically metal, the surface of the blade material is rarely bare metal.” Ex-1009 ¶3. Gilliam further discloses a “conventional technique of applying the polymer coating to the blade material.” *Id.*, ¶5. And Gilliam discloses that “the blade material is typically painted, printed with length indicia, and then coated with a polymer coating to improve abrasion resistance and/or reduce friction.” *Id.*, ¶3.

There is a motivation to combine. One advantage of the tape measure coating taught by Gilliam is that it “increase[s] the life of the blade,” while another is “provid[ing] a low friction surface to aid in coiling the blade 12.” Ex-1009 ¶¶15, 23; Ex-1006, 2:27-29, 14:4-52, 18:30-32 (Murray describing similar advantages). An advantage of Hernandez’s tape measure is that it has increased standout. Ex-1005, 1:55-60, 1:28-35; Ex-1006, 1:10-12 (“[o]ne of the most desirable characteristics commercial rule assemblies can possess is a relatively long blade standout.”). As a result, there is motivation to apply the polymer coating from Gilliam to the tape measure with taught by Hernandez to achieve the benefits of a tape measure with increased standout, a longer life, and easier coiling. Ex-1003 ¶105, 108-112. Commercially relevant market forces would also have led a POSA to combine prior art reference teachings to arrive at the claimed invention. Ex-1003 ¶113. A POSA would have understood that a tape measure with an increased

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standout length and increase life would be desired by a customer. Ex-1006, 1:10-12; Ex-1003 ¶113.

A POSA would also have a reasonable expectation of success in combining Hernandez and Gilliam. Ex-1003 ¶114. Both describe a tape measure. Both also disclose using a polymer coating on the tape measure. There is nothing novel about the combination. The combination of Hernandez and Gilliam represents the integration of known elements, each performing the function it had been known to produce predictable results. *Id.* The combination does not change the key aspects of either reference; each reference would work in combination just as they did apart. *Id.* And any remaining work to apply Gilliam’s teachings to Hernandez is “the work of the skillful mechanic, not that of the inventor.” *Sakraida*, 425 U.S. at 282; Ex-1003 ¶114.

XIII. SECONDARY CONSIDERATIONS

Petitioner is unaware of any secondary considerations that have a nexus to the claimed inventions that would overcome the Petition’s showing of obviousness. Indeed, the sheer number of “[i]ndependently made, simultaneous inventions, made within a comparatively short space of time, are persuasive” “indicia of **obviousness**.” *Geo. M. Martin Co. v. Alliance Machine Sys. Int’l LLC*, 618 F.3d 1294, 1304-1305 (Fed. Cir. 2010) (quotations omitted).

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As demonstrated Sections VI-VII, the prior art is saturated with tape measures with cross-sectional shapes achieving increased blade standout, making the alleged invention of the '067 patent hardly “born of necessity.” If Patent Owner identifies any evidence of secondary considerations, Petitioner reserves the right to respond.

XIV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that IPR be instituted and that all Challenged Claims be cancelled.

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Date: January 26, 2026

Respectfully submitted,

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XV. CERTIFICATE OF COMPLIANCE

Under the provisions of 37 C.F.R. § 42.24(a), the undersigned hereby certifies that the word count for the foregoing Petition for *Inter Partes* Review totals 13,991 words, which is less than the 14,000 allowed under 37 C.F.R. § 42.24(a)(1)(i). The word count excludes the table of contents, table of authorities, mandatory notices under 37 C.F.R. § 42.8, certificate of service, certificate of word count, or appendix of exhibits or claim listing. Counsel has relied upon the word count feature provided by Microsoft Word.

W. Todd Baker

W. Todd Baker

XVI. CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e)(4) and 42.105, lead counsel for Petitioner hereby certifies that on January 26, 2026, copies of this Petition and all supporting exhibits were sent via Federal Express® to the correspondence address of record for the '067 Patent:

Reinhart Boemer Van Deuren s.c.
Attn: Travis McDonnell
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Milwaukee, WI 53202

Courtesy copies have also been served by electronic mail on Patent Owner's counsel of record in the following related matter:

Milwaukee Electric Tools Corporation v. Klein Tools, Inc.,
No. 1:25-cv-04689 (N.D. Ill.)

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