

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Klein Tools, Inc.
Petitioner,

v.

Milwaukee Electric Tool Corporation,
Patent Owner.

IPR2026-00233
U.S. Patent No. 11,656,067

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION

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TABLE OF EXHIBITS

Exhibit No.	Description
2001	RESERVED
2002	RESERVED
2003	Counterclaims in <i>Milwaukee Electric Tool Corp. v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.), Dkt. 56, filed January 22, 2026 (excerpted)
2004	Klein Tool’s Local Patent Rule 2.3 Initial Non-Infringement, Unenforceability, and Invalidity Contentions in <i>Milwaukee Electric Tool Corp. v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.), served Aug. 19, 2025 (excerpted)
2005	Interim Processes for PTAB Workload Management Memorandum, dated March 26, 2025
2006	“Klein Tools Improves Tape Measure Performance and Durability with Updated Line,” dated Oct. 3, 2019
2007	WO 2019/040752

I. INTRODUCTION

Patent Owner Milwaukee Electric Tool Corporation (“Milwaukee” or “Patent Owner”) respectfully requests that the Board deny institution of the Petition for *inter partes* review filed by Klein Tools, Inc. (“Petitioner” or “Klein”) challenging claims 1-12 of U.S. Patent No. 11,656,067 (“the ’067 Patent”).

The Petition fails on numerous fronts.

First, the Petition suffers from a threshold defect that independently warrants denial. In district court, Petitioner argued that several of these same measurement-based limitations were indefinite. Here, Petitioner says no construction is needed. Attempting to address the recent Board guidance on inconsistent claim positions, Petitioner argues that the supposed uncertainty exists only in the infringement context, when Patent Owner applies the claims to accused products, and not in this IPR, where Petitioner applies the same terms to prior art. That distinction is illusory. Claim meaning does not change with the target. If the terms are too uncertain to apply with reasonable certainty in one forum, Petitioner cannot treat them as clear enough for precise prior-art mapping in another. Recent Board guidance rejects precisely this maneuver.

Second, Petitioner’s primary reference Hernandez fails to disclose *all* elements of sole independent claim 1. That alone is fatal to Petitioner’s anticipation analysis.

Petitioner attempts to sidestep this deficiency by arguing that disclosures in an entirely different patent, Murray, are incorporated by reference into Hernandez. However, Murray is *not* properly incorporated by reference and cannot be considered in the anticipation analysis. Further, even if considered, Petitioner's analysis still fails as a matter of law because it mixes elements from different tape measures from both Hernandez and Murray. Petitioner never identifies a single tape measure embodiment disclosing all claimed elements, as required to prove anticipation.

Third, Petitioner's obviousness argument fares no better. Ignoring that the invention must be viewed as a whole, Petitioner's analysis attacks the claim elements in isolation, repeatedly relying on a routine optimization argument in an attempt to support its obviousness attack. But this again ignores the interdependence of the claimed features. The claimed tape-measure standout depends on many interacting factors, and Petitioner cannot establish obviousness by conveniently selecting different factors from different embodiments to reconstruct the claims.

Finally, a major threshold defect exists in the Petition itself. Here, Petitioner advances a plain and ordinary claim-scope position that it was unwilling to live with in district court. In district court, Petitioner argued that several of these same measurement-based limitations were indefinite. The claims do not become definite when Petitioner wants to invalidate and indefinite when Petitioner wants to avoid

infringement. Recent Board guidance treats this kind of unexplained reversal as a serious institution defect.

Because Petitioner fails to demonstrate a reasonable likelihood of unpatentability, the Board should deny institution.

II. THE '067 PATENT

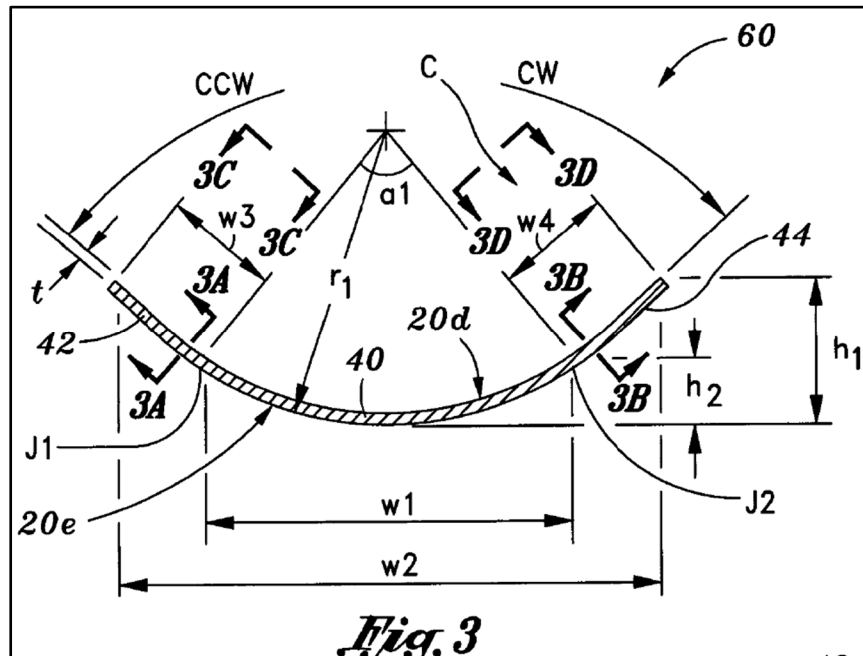
The '067 Patent is directed to a tape measure with specifically claimed tape blade characteristics resulting in an increased tape standout distance. Ex. 1001. The invention does not claim standout in the abstract. It is directed to a very particular blade configuration and set of dimensional relationships that, together, produce a practical tape measure with extended standout. That distinction matters because the Petition repeatedly isolates individual values or ranges from disparate references while never persuasively showing that the prior art discloses, or would have led a POSITA to select, the claimed combination as a whole in a single tape measure.

III. SUMMARY OF THE PRIOR ART

A. U.S. Patent No. 7,096,596 to Hernandez (“Hernandez”) (Ex. 1005)

Each ground in the Petition relies on Hernandez as the primary reference. Hernandez describes its invention as “providing a tape measure blade having a cross-sectional configuration that resists bending but avoids during manufacture the formation of flaws or incipient fractures.” Ex. 1005 at 1:58-60. As seen in Figure 3 below, Hernandez’s tape measure utilizes a specific cross-sectional curvature

comprising “an arcuate, concave-convex central section 40 and a pair of lateral, substantially flat planar end segments 42, 44 that straddle the concave-convex central section.” Ex. 1005 at 4:30-33.



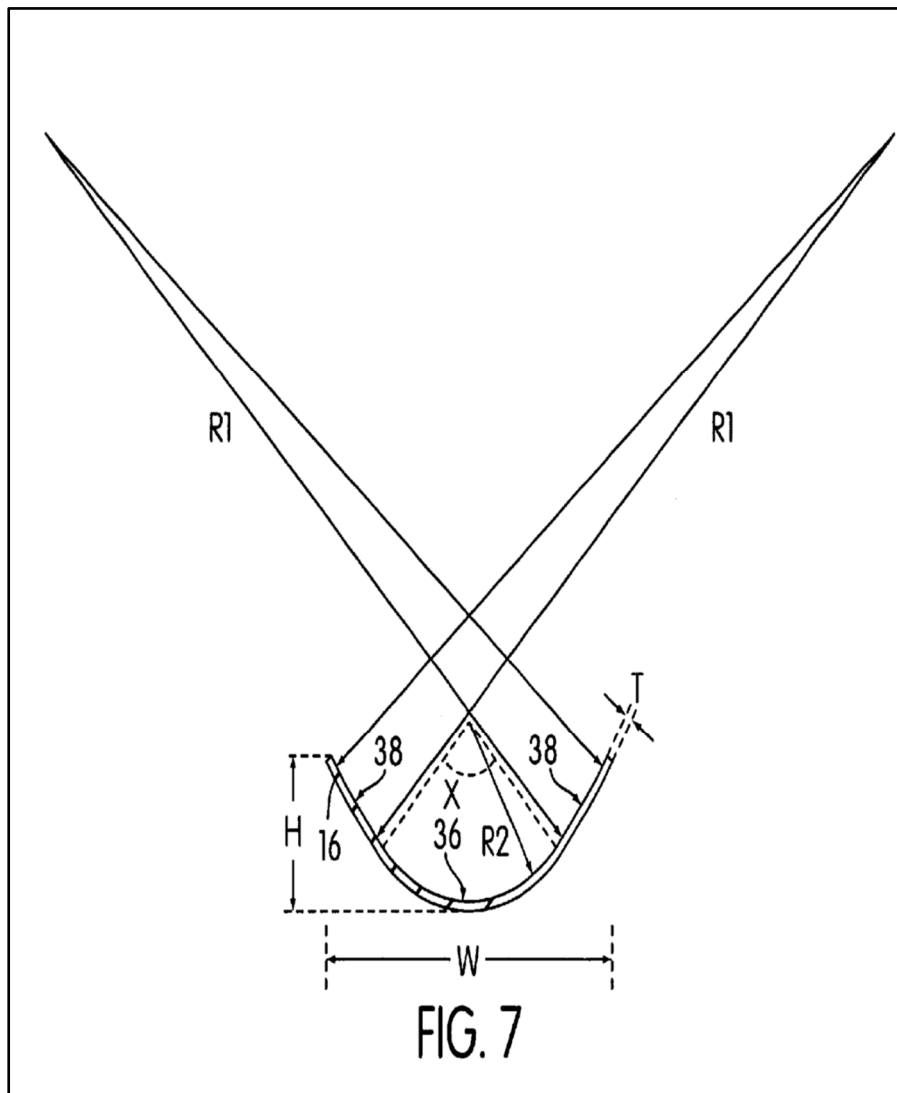
Ex. 1005 at Fig. 3.

Hernandez provides a wide range of potential dimensions for its blade, noting that the blade “may have a standout arcuate length of at least ten feet” but at no point provides an explanation as to optimal dimensions to actually achieve and disclose a desired standout. Ex. 1005 at 4:48; *see also id.* 4:19-50.

B. U.S. Patent No. 6,324,769 to Murray (“Murray”) (Ex. 1006)

Murray describes a tape measure utilizing a different blade geometry from Hernandez. Specifically, as seen in Figure 7 below, Murray teaches its blade as having a cross-section utilizing “an arcuate central section 36 and integral *arcuate*

end sections 38.” Ex. 1006 at 5:66-67¹; *see also id.* 5:65-6:5.



Murray also specifically distinguishes its geometry from other blades in the art that combine a curved center with “*straight (i.e. flat) sections at each transverse end,*” noting that blades constructed as such “are less stable during blade standout.” *Id.* at 6:24-32. As Murray further explains, “the length of blade standout *depends*

¹ Emphasis added unless otherwise noted.

on many factors, including (but not limited to) blade width . . .; the height of the blade [] in the concavo-convex configuration . . .; blade thickness . . .; and the geometry of the blade transverse cross-section.” Ex. 1006 at 5:21-30.

IV. PERSON OF ORDINARY SKILL IN THE ART

Petitioner proposes the following definition of a person of ordinary skill in the art (“POSA”):

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. Formal education in a relevant field, such as mechanical engineering, may compensate for less experience, and vice versa.

Pet. at 14.

Solely for the purposes of this Preliminary Response, Patent Owner does not dispute Petitioner’s proposed definition. Patent Owner reserves the right to present a different definition in the unlikely event that the Board grants institution.

V. CLAIM CONSTRUCTION IS A THRESHOLD DEFECT THAT INDEPENDENTLY WARRANTS DENIAL

The Petition should be denied at the threshold because Petitioner does not present a coherent claim-construction position. In this proceeding, Petitioner tells the Board that “[n]o express constructions are therefore required.” Pet. 17. But in district court, Petitioner affirmatively argued that several of these same

measurement-based limitations are indefinite, including the limitations directed to standout, curved width, curved height, and related ratios because a POSITA supposedly would not know, with reasonable certainty, how to determine or measure these dimensions. Ex. 2004 at 27-29. Petitioner thus took a position in district court that these limitations were too uncertain to apply with reasonable certainty but then tells this Board that not only is no construction needed for those same limitations because the meaning is well-settled, but that it understands the terms sufficiently here to apply prior art to the terms for its unpatentability analysis.

Recent Board guidance rejects precisely this maneuver. As *Tesla* explains, “when a petitioner advances different positions before the Board and a district court, that petitioner is required to explain why those different positions are warranted.” *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 at 3 (PTAB Nov. 5, 2025) (informative) (citing *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3-5 (Director Nov. 3, 2025) (precedential)). *Tesla* further holds that “Petitioner’s statement that it cannot raise indefiniteness challenges in an inter partes review is not a sufficient explanation.” *Id.* at 3. The same principle appears in *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 at 8-9 (PTAB Dec. 13, 2024) (informative).

That guidance squarely applies here. Petitioner did not merely preserve generic flexibility in district court. It affirmatively argued that these limitations were

indefinite because the claim scope allegedly turned on unresolved measurement methodology, measurement location, and variable results. Ex. 2004 at 27-29. Yet the Petition offers no real explanation for why those same limitations suddenly require no construction here. And the answer cannot be that indefiniteness is unavailable in IPR because *Tesla* rejects that rationale. Nor can Petitioner plausibly suggest that the problem arises only when Patent Owner applies the claims to accused products. Claim meaning does not change depending on whether Petitioner is resisting infringement in district court or asserting invalidity before the Board. The claims do not become indefinite when Petitioner wants to avoid infringement and definite when Petitioner wants to invalidate.

This unexplained reversal is not a minor pleading inconsistency. It goes to the sufficiency of the Petition itself. A petition must identify “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). Petitioner cannot satisfy that obligation by arguing in district court that these limitations are too uncertain to apply with reasonable certainty, while telling the Board that no construction is needed and proceeding as though the same terms can be mapped to prior art with precision. Recent Board guidance treats this sort of unexplained cross-forum reversal as a serious institution defect, and the Board should do so here as well.

Patent Owner agrees, for purposes of this Preliminary Response only, that the challenged claims can be evaluated under their plain and ordinary meaning, while

reserving the right to seek construction later if necessary. But even under that standard, the Petition fails for the independent reasons set forth below. The point here is more basic: Petitioner was required to present a coherent and candid claim-scope position. It did not. Respectfully, Petitioner's position appears to rest more on a shifting view of claim scope tailored to the forum, and the objective of the moment, than explaining how the challenged claims should be construed.

VI. GROUND 1: CLAIMS 1-9 AND 11-12 ARE NOT ANTICIPATED BY HERNANDEZ

Ground 1 fails for three independent reasons.

First, Hernandez does not disclose each element of sole independent claim 1. That alone is fatal to anticipation. *Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1068 (Fed. Cir. 2017).

Second, Petitioner attempts to repair Hernandez's missing disclosures by invoking Hernandez's blanket incorporation-by-reference language and treating Murray as though its teachings were simply part of Hernandez. They are not. Hernandez's generic catchall language does not identify with particularity what Murray material is purportedly incorporated, where it is found, or how it fits into any specific Hernandez embodiment. As discussed below, that is legally insufficient.

Third, even assuming the Board finds that Murray is incorporated by reference

within Hernandez’s disclosure, the Petition nonetheless fails to demonstrate claim 1 is anticipated because Petitioner’s arguments improperly mix-and-match different embodiments within Hernandez and Murray such that no single embodiment discloses every element of independent claim 1 as required for anticipation. Petitioner never maps every limitation to one embodiment. This is hindsight reconstruction, not anticipation.

A. The Petition Fails to Demonstrate that Hernandez Itself Discloses Each Element of Sole Independent Claim 1

Independent claim 1 requires the elongate blade of the tape measure (i) have a length between 15 feet and 40 feet and (ii) a standout distance from the housing greater than 150 inches. Ex. 1001 at cl. 1. The Petition fails to point to any disclosure in Hernandez that teaches these limitations to support Petitioner’s anticipation ground.

1. Hernandez Does Not Disclose a “length between 15 feet and 40 feet” [1H]

The Petition asserts “Hernandez discloses this limitation.” Pet. at 28. Not so. The only Hernandez passage that Petitioner cites states that the “extended portion 60 of the elongate blade 20 may have a standout arcuate length of *at least ten feet.*” Pet. at 28 (citing Ex. 1005 at 4:47-50, 1:31-34). But “at least 10 feet” is not what is claimed. That is not a disclosure of the claimed blade length “between 15 feet and 40 feet.” At most, Hernandez teaches a lower bound with no upper limit . Because

anticipation requires “a prior art reference [to] ‘disclose all elements of the claim within the four corners of the document,’” Petitioner cannot demonstrate that Hernandez anticipates claim 1. *See Microsoft*, 878 F.3d at 1068.

Petitioner’s attempt to nonetheless argue anticipation by latching onto Hernandez’s use of the words “*at least*” ten feet to argue Hernandez “discloses, at a minimum, a tape measure having a length of at least ten feet, which includes ‘a length between 15 feet and 40 feet,’” Pet. at 28, likewise fails. That logic cannot be correct. A statement that something can do “at least X” tells you only one thing with certainty: it can do X or more. It does not tell you how much more. It does not identify any particular higher value. And it does not tell you whether the system remains operable, practical, or even the same design when performance increases far beyond X. By way of example, a blade length of 42 feet would be greater than the “minimum” ten feet noted by Hernandez but would not fall within the scope of claim 1 of the ’067 Patent.

Petitioner likewise cannot salvage the deficiency in Hernandez’s disclosure by recasting Hernandez’s open-ended minimum as an enabling disclosure of the later-claimed higher range. Anticipation requires more than the possibility that a skilled artisan might extrapolate beyond what the reference actually teaches. “Invalidity by anticipation requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or

inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation.” *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000).

Hernandez simply does not disclose a blade length between 15 and 40 feet. Nor does it teach any principle showing that the much higher region Petitioner invokes is actually part of Hernandez’s disclosure rather than merely a theoretical extrapolation. Petitioner’s theory thus depends not on what Hernandez teaches, but on speculation about how far “at least ten feet” might extend.

Thus, Hernandez does not disclose the elongate blade having a length of 15 feet to 40 feet as required by sole independent claim 1.

2. Hernandez Does Not Disclose “wherein a standout distance of the elongate blade from the housing is greater than 150 inches” [10]

The same flaw defeats Petitioner’s position on standout. Hernandez’s statement that the blade may have “a standout arcuate length of at least ten feet” discloses, at most, a minimum floor of 120 inches, not a standout “greater than 150 inches,” as claimed. Pet. at 38; Ex. 1005, 4:47-50, 1:31-34. Petitioner identifies no disclosure in Hernandez of any standout above 150 inches.

Again, Petitioner’s argument attempts to convert an open-ended minimum into disclosure of every higher value above that minimum. The law does not permit extrapolating a disclosure. A reference that says “at least ten feet” does not

anticipate a claim requiring standout greater than 150 inches for the same reason a reference describing a vehicle capable of traveling at least 120 mph would not anticipate a claim requiring a vehicle traveling at 180 to 240 mph because a minimum threshold is not a disclosure of every superior performance level above it. Nor does it enable those higher levels merely because they are conceptually higher. The supposed disclosure is not a disclosure but merely speculation.

Thus, Hernandez does not disclose the standout distance of the elongate blade from the housing is greater than 150 inches as required by sole independent claim 1.

B. Murray is Not Properly Incorporated by Reference Into Hernandez to Support Petitioner's Anticipation Argument

Petitioner also alleges that Hernandez discloses the (i) elongate blade length of 15 feet to 40 feet and (ii) standout distance greater than 150 inches through its incorporation by reference of Murray. Pet. at 28-29, 38. But, contrary to Petitioner's argument, Murray is not properly incorporated by reference, so its teachings should *not* be considered for purposes of anticipation.

As the Federal Circuit has explained, “[t]o incorporate matter by reference, a host document must contain language ‘*clearly identifying the subject matter which is incorporated and where it is to be found*’; a ‘mere reference to another application, or patent, or publication is not an *incorporation* of anything therein....’ Put differently, ‘the host document must identify with *detailed particularity* what

specific material it incorporates and clearly indicate where that material is found in the various documents.’” *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1346 (Fed. Cir. 2009) (internal citations omitted).

Hernandez does not identify with detailed particularity what specific material from Murray it incorporates, nor does it indicate where in Murray that material may be found to meet the incorporation by reference standard. Instead, Hernandez merely includes a blanket statement that the “inventor incorporates herein by reference any and all U.S. patents, U.S. patent applications, and other documents cited or referred to in this application.” Ex. 1005 at 1:5-7. Hernandez then identifies Murray as one of many patents describing “[e]xamples of tape measures,” but cites to nothing specific from Murray that it contends should be incorporated into its invention, let alone any particular embodiment. *Id.* at 1:28-31. That is precisely the kind of generic reference Callaway holds insufficient.

Because Hernandez does not incorporate Murray with the required particularity, Murray remains a separate reference. Petitioner therefore cannot cure Hernandez’s failure to disclose the claimed length and standout limitations by selectively importing Murray’s teachings and still maintaining that Hernandez alone anticipates.. *See Microsoft*, 878 F.3d at 1068 (noting anticipation requires “a prior art reference [to] ‘disclose all elements of the claim within the four corners of the document’”).

Because Murray is not properly considered part of Hernandez's disclosure, Hernandez's failure to disclose at least the claimed elongate blade length of 15 feet to 40 feet and standout distance greater than 150 inches, as discussed in Section VI.A.1-2, *supra*, renders the Petition's anticipatory ground 1 fatally deficient.

C. The Petition Improperly Combines Embodiments of Hernandez and Murray with No Single Embodiment Disclosing Every Element of Claim 1

Even if Murray were somehow deemed incorporated, the anticipation ground still fails because Petitioner does not identify one coherent disclosure teaching all limitations arranged as claimed. Anticipation requires not merely that the limitations appear somewhere in the reference, but that the reference disclose "all of the limitations *arranged or combined in the same way* as recited in the claim." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). And "it is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention." *Id.*

Multiple, distinct teachings, however, are precisely what Petitioner relies on to argue Hernandez anticipates independent claim 1. There can be no dispute that Murray and Hernandez disclose *entirely different embodiments*, if not entirely different tape measures. The tape measures of Murray and Hernandez are from

different patents, with different inventors and assignees. Ex. 1005 at 1; Ex. 1006 at 1.

Critically, Murray's blade features, such as a 15-to-40-foot foot blade length or a 13-foot standout, cannot simply be transplanted into Hernandez's tape measure to form an anticipatory disclosure. Indeed, such a mix-and-match exercise ignores Murray's express disclosure that "the length of blade standout *depends on many factors*, including (but not limited to) blade width . . .; the height of the blade [] in the concavo-convex configuration . . .; blade thickness . . .; and the *geometry of the blade transverse cross-section*." Ex. 1006 at 5:21-30. While one embodiment in Murray may achieve a 13-foot standout, this standout cannot be viewed in isolation as something that can be plucked out and dropped into Hernandez's disclosure of a different tape measure with different features and still support an anticipation argument.

Further underscoring Petitioner's deficient analysis, Petitioner not only mixes and matches embodiments between Hernandez and Murray, but it also mixes embodiments within Murray itself. While Petitioner points to Murray's disclosure that one of its blades may reach a standout of 13-feet to purportedly satisfy the claim limitation requiring greater than 150 inch standout, Pet. at 38 (citing Ex. 1006 at 5:49-62, 11:6-10), when addressing the curved width limitations ([1K] and [1M]), it points to an entirely different embodiment of Murray. Pet. at 32-33 (citing Ex. 1006

at 7:58-62), Pet. at 35-36. Critically, the Murray embodiment that Petitioner relies on to meet the curved width limitations achieves only a 132 inch (11-foot) standout, not the requisite greater than 150 inch standout. Ex. 1006 at 7:58-8:5 (describing the blade of this embodiment as achieving “approximately 11 feet of standout”), Fig. 9.

Petitioner’s anticipation argument thus amounts to nothing more than a facially deficient improper mix-and-match exercise that pulls disclosures from disparate embodiments (and references) in an attempt to match the claim elements without showing where the elements are arranged or combined in the same way as recited in the claim. *See NetMoneyIn*, 545 F.3d at 1371. It must be rejected.

Indeed, the Board has routinely denied institution on anticipation grounds that pick and choose from the elements of different embodiments within a prior art reference as Petitioner has done. *See, e.g., Vista Outdoor Operations LLC v. Liberty Ammunition, LLC*, IPR2016-00539, Paper 9 at 12-13 (PTAB Aug. 3, 2016) (petitioner improperly “cherry-picked elements across various distinct embodiments” of reference related to jacketed bullets); *Panasonic Corporation v. Optical Devices, LLC*, IPR2014-00302, Paper 9 at 13-15 (PTAB July 11, 2014) (petitioner improperly relied on different embodiments in reference related to optical system with lens and reflective surface).

Accordingly, claim 1 is not anticipated by Hernandez as the Petition contends.

Because claims 2-9 and 11-12 depend from claim 1, they are also not anticipated for at least the same reasons.

VII. GROUND 2: CLAIMS 1-9 AND 11-12 ARE NOT OBVIOUS OVER HERNANDEZ ALONE, OR IN COMBINATION WITH MURRAY

Ground 2 likewise fails for at least four related, but independent reasons.

First, Petitioner never analyzes claim 1 as a whole. Instead, Petitioner improperly treats blade thickness, flat width, curved height, curved width, length, and standout as though they are independent variables that can be adjusted one at a time without affecting the other features, to arrive at the claimed invention. Murray explicitly rejects this approach. Murray teaches that standout “depends on many factors, including (but not limited to) blade width...; the height of the blade [] in the concavo-convex configuration...; blade thickness...; and the geometry of the blade transverse cross-section.” Ex. 1006, 5:21-30.

The Petition nevertheless (i) identifies thickness, flat width, and curved height as variables to be optimized individually, (ii) pulls curved width from an entirely different embodiment that fails to achieve the greater than 150 inch standout, (iii) invokes a separate Murray embodiment for a 33-foot blade, and (iv) then assumes the claimed performance would follow from that assembled set of values. That is not what Murray teaches. Murray teaches that standout depends on the interaction of those features, not on plucking them out of different embodiments one

by one.

Second, Petitioner fails, as required for obviousness, to provide (i) a legally sufficient motivation-to-combine, and (ii) reasonable-expectation-of-success rationale, for selecting the particular dimensions, ranges, and performance teachings on which the Petition relies, in the particular combination Petitioner proposes. Petitioner and its expert nonetheless select dimensions, ranges, and performance teachings *à la carte*, without explaining why a POSITA would have chosen those particular values together or expected them to produce the claimed result. That is not a proper obviousness analysis grounded in the prior art. It is hindsight reconstruction.

Third, Petitioner's asserted motivation to combine and reasonable expectation of success are undermined by Hernandez's and Murray's materially different blade geometries. Murray does not treat its improved standout as a performance characteristic that can simply be divorced from the blade geometry that produces it and transferred to any other tape-measure blade. It ties that performance to its own "unique geometry," while Hernandez uses materially different, substantially flat planar end segments. That structural mismatch is legally significant because it cuts directly against both a reason to combine and any expectation that the selected teachings would work together to produce the claimed performance.

Fourth, Petitioner never provides a persuasive, non-hindsight reason for

selecting the claimed blade-length range. Petitioner's blade-length theory fails because Petitioner never explains why a POSITA would have selected the claimed 15-to-40-foot range in particular. Hernandez discloses only "at least ten feet," and Murray discloses a 33-foot blade in one embodiment. Even assuming those disclosures are numerically broad enough to encompass the claimed range or include a point within it, that still does not explain why a POSITA would have chosen the claimed sub-range rather than some other higher length. If Petitioner's theory is merely that longer blades are desirable, that rationale does not explain why the claimed range was selected rather than some still greater length.

Petitioner's obviousness theory therefore fails unless it explains why a POSITA would have selected the particular teachings Petitioner assembles to reach claim 1 and would have had a reasonable expectation of success of them working together to produce the claimed performance.

A. Petitioner Fails to Analyze the Claimed Invention as a Whole

The simple fact is that no single tape measure embodiment discloses all elements of claim 1. *See* Section VI, *supra*. Thus, Petitioner bears the burden of explaining why a POSITA would have been motivated to combine disparate disclosures from different embodiments and had a reasonable expectation of success in making such a combination. *See In re Stepan Co.*, 868 F.3d 1342, 1346, n.1 (Fed. Cir. 2017) ("Whether a rejection is based on combining disclosures from multiple

references, *combining multiple embodiments from a single reference*, or selecting from large lists of elements in a single reference, there *must be a motivation* to make the combination and a *reasonable expectation* that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.”).

As discussed in Section VI.A.2, Hernandez does not disclose a tape measure achieving a standout of greater than 150 inches. Petitioner therefore turns to Murray to supply this missing limitation. Pet. at 57. But Petitioner’s analysis ignores that standout distance cannot be viewed in isolation but instead, as Murray states, “*depends on many factors*, including (but not limited to) blade width . . .; the height of the blade [] in the concavo-convex configuration . . .; blade thickness . . .; and the geometry of the blade transverse cross-section.” Ex. 1006 at 5:21-30. Murray thus teaches that these blade characteristics work in combination to affect standout. Petitioner therefore cannot treat them as separate dials and assume the claimed result would follow from selecting values one by one.

The Petition identifies metal core thickness, blade flat width, and blade curved height as separate “result-effective variables”² and argues that each could be

² Patent Owner does not concede that these are result-effective variables as Petitioner contends.

optimized routinely. Pet. at 46-49, 51-56. But that analysis never grapples with the interdependence of those variables or how adjusting one would affect the claimed invention as a whole.

This is precisely the type of analysis the Board rejected in *Moderna Therapeutics, Inc. v. Arbutus Biopharma Corp.*, 2020 WL 4237232, at *15 (P.T.A.B. July 23, 2020). In *Moderna*, the claims were directed to a composition including various interrelated components. While the Board noted that Petitioner identified reasons to adjust the components individually, it found “Petitioner’s optimization argument does not take into account the interdependence” of the claimed components or “how the adjustments would affect the [invention] as a whole.” *Id.*

In short, Petitioner does not analyze the claimed invention as a whole. It isolates selected variables, labels some of them “result-effective,” and then assumes the claimed performance would follow from adjusting them one by one. But Murray teaches that standout depends on the interaction of multiple blade characteristics, and the Petition never explains why a POSITA would have expected Petitioner’s piecemeal adjustments to produce the claimed result. Ground 2 therefore fails for the same reason the Board rejected the obviousness theory in *Moderna*: Petitioner’s analysis ignores how the claimed features work together as an integrated whole.

B. Petitioner Fails to Adequately Explain Why a POSITA Would Have Selected and Combined the Particular Teachings on Which It Relies

Further compounding Petitioner's deficient analysis, when identifying where the prior art discloses the curved width limitations ([1K] and [1M]), Petitioner points only to (i) a curved width range from Hernandez, which does not achieve the 150 inch standout (Section VI.A.2), and (ii) a specific curved width used in an embodiment of Murray that only achieves an 11-foot standout. Pet. at 53, 55-56; Ex. 1006 7:58-8:5. Petitioner fails to address why a POSITA would have been motivated to use curved width values that achieve less than the claimed 150 inch standout, let alone why a POSITA would have had a reasonable expectation of success that using this curved width would have resulted in the claimed invention when combined with the other claimed blade dimensions.³

³ Petitioner does not assert that the curved width is a result-effective variable. Pet. at 53, 55-56. Thus, any attempt by Petitioner to later rely on the body of case law discussing the optimization of "result-effective variables" is waived. *See Intel Corp. v. Ericsson*, No. IPR2024-01009, 2024 WL 5160788, at *4 (P.T.A.B. Dec. 18, 2024) (denying institution, including noting Petitioner's burden to demonstrate unpatentability and Petitioner's failure to explain how claim elements were result-effective variables)

More broadly, Petitioner and its expert select dimensions, ranges, and performance teachings *à la carte* without adequately explaining why a POSITA would have selected those particular teachings, in that particular combination, or had a reasonable expectation that they would produce the claimed result. That is not a proper obviousness analysis grounded in the prior art but instead hindsight reconstruction.

C. Murray’s Materially Different Blade Geometry Undermines Both Motivation to Combine and Reasonable Expectation of Success

Petitioner’s analysis also ignores the disparate teachings between Hernandez and Murray regarding the geometry of the blade used in the tape measure. Murray not only identifies the blade geometry as one factor contributing to standout, Ex. 1006 at 5:21-30, but it expressly notes that the concavo-convex cross-section of its blade “has a *unique geometry* (shown in FIG. 7) that *increases in the standout ability*.” Ex. 1006 at 5:63-65. This unique geometry “includes an arcuate central section 36 and integral *arcuate end sections 38*.” Ex. 1006 at 5:66-67; *see id.* 5:65-6:5.

Murray also specifically distinguishes the geometry in its blades from other blades in the art that combine a curved center with “*straight (i.e. flat) sections at each transverse end*,” noting that blades constructed as such “are less stable during blade standout.” *Id.* at 6:24-32. But a straight (flat) section is precisely what

Hernandez uses in its blade design. As Hernandez explains, its blade has “an arcuate, concave-convex central section 40 and a pair of *lateral, substantially flat planar end segments* 42, 44. Ex. 1005 at 4:30-36.

Petitioner’s analysis ignores these distinct blade geometries and Murray’s express teaching that its geometry with the arcuate end sections contributes to the increased standout ability. Murray therefore does not treat its improved standout as a result independent of the blade geometry that produces it. It ties that performance to its own “unique geometry,” while Hernandez uses materially different, substantially flat planar end segments. That structural mismatch further confirms why Petitioner’s asserted combination lacks an adequate reasoned basis in the prior art and why Petitioner never shows that a POSITA would have had a reasonable expectation of success of its selected teachings working together to produce the claimed performance.

Petitioner is trying to claim Murray’s result without Murray’s design. Murray does not say its standout improvement comes for free. It says that improvement comes from Murray’s “unique geometry.” Petitioner never explains why a POSITA would expect Hernandez’s materially different blade geometry to deliver the same performance. That omission is fatal to Petitioner’s combination theory.

D. Petitioner Offers No Persuasive, Non-Hindsight Reason for Selecting the Claimed 15-to-40-Foot Range [1H]

The Petition also fails to demonstrate that the claims are obvious because Petitioner fails to explain why a POSITA would have been motivated to use a blade having the claimed 15-to-40-foot length in Hernandez.

Petitioner asserts that “Hernandez and Murray disclose this limitation.” Pet. at 49. But as discussed in Section VI.A.1, Hernandez does not disclose the claimed blade length of between 15 feet and 40 feet. While Murray discloses a tape blade embodiment with a 33-foot long blade, even if it is considered part of Hernandez’s disclosure (which Patent Owner contests, Section VI.B), Petitioner must still explain why a POSITA would have been motivated to combine Murray’s embodiment with the embodiments disclosed in Hernandez to arrive at the claimed invention and had a reasonable expectation of success in doing so. *In re Stepan*, 868 F.3d at 1346, n.1 (“Whether a rejection is based on combining disclosures from multiple references, ***combining multiple embodiments from a single reference***, or selecting from large lists of elements in a single reference, there ***must be a motivation*** to make the combination and a ***reasonable expectation*** that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.”).

First, Petitioner asserts that “Hernandez at a minimum renders this limitation

prima facie obvious, alone or in combination with Murray.” Pet. at 49. Petitioner’s argument, however, relies on case law finding a presumption of obviousness exists when the prior art discloses ***overlapping ranges*** with the claim. *Id.* (citing §XI.2). But such case law is not enough to carry Petitioner’s burden here. Even assuming Hernandez’s “at least ten feet” disclosure and Murray’s 33-foot embodiment are numerically broad enough to encompass the claimed range or include a point within it, Petitioner still never explains why a POSITA would have selected the claimed 15-to-40-foot range in particular.

Second, Petitioner argues that “the ‘overlap [taught by Hernandez and Murray] itself provides sufficient motivation to optimize the ranges.” Pet. at 50. But again, that still does not explain why a POSITA would have chosen the claimed sub-range rather than some other higher length.⁴

⁴ Petitioner does not assert that the blade length is a result-effective variable. Pet. at 49-51. Thus, any attempt by Petitioner to later rely on the body of case law discussing the optimization of “result-effective variables” is waived. *See Intel Corp.*, 2024 WL 5160788, at *4 (denying institution, including noting Petitioner’s burden to demonstrate unpatentability and Petitioner’s failure to explain how claim elements were result-effective variables).

Finally, Petitioner’s assertion that “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” also fails. Pet. at 50-51. Specifically, even assuming a desire to measure greater distances exists, Petitioner fails to explain why a POSITA **would have been motivated** to select the 33-foot blade length of Murray instead of, for example, selecting an even longer blade length (i.e., 41 feet) that falls outside the claim. It is not enough to state that a POSITA **could** have modified the references, but instead, the case law requires Petitioner to show that a POSITA **would have been motivated** to do so. *See InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014). Petitioner’s selection of Murray’s 33-foot blade length reeks of impermissible hindsight using the claim as a roadmap to recreate the invention.

For at least these reasons, Petitioner fails to demonstrate that Hernandez alone or in combination with Murray renders “a length between 15 feet and 40 feet” obvious to support its obviousness argument in Ground 2.

Accordingly, claim 1 is not obvious in view of Hernandez alone or in combination with Murray as the Petition contends. Because claims 2-9 and 11-12 depend from claim 1, they are also not obvious for at least the same reasons.

VIII. GROUND 3: CLAIM 10 IS NOT OBVIOUS OVER HERNANDEZ IN COMBINATION WITH GILLIAM

Claim 10 depends from independent claim 1. For the same reasons as discussed above, Petitioner fails to demonstrate that claim 1 is anticipated and/or obvious. Petitioner's reliance on Gilliam does not resolve these deficiencies such that claim 10 is not obvious over Hernandez in combination with Gilliam.

IX. SECONDARY CONSIDERATIONS OF NON-OBVIOUSNESS

Patent Owner reserves the right to present evidence of secondary considerations of non-obviousness should the Board grant institution.

X. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests the Board deny institution.

Dated: April 29, 2026

Respectfully Submitted,

/ Dion M. Bregman /
Dion M. Bregman, Reg. No. 45,645

CERTIFICATION OF LENGTH (37 C.F.R. § 42.24(D))

The undersigned hereby certifies that this document is limited to 14,000 words and thus complies with the applicable word limit.

Dated: April 29, 2026

Respectfully Submitted,

/ Dion M. Bregman /
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. Section 42.6(e)(4), lead counsel for Patent Owner hereby certifies that on April 29, 2026 a copy of this Patent Owner's Preliminary Response to Petition was served on Petitioner's counsel of record at the email correspondence address of record:

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