

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. IPR2026-00246

U.S. Patent No. 11,857,064

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

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1001	Certified U.S. Patent No. 11,857,064
1002	File History for U.S. Patent No. 11,857,064
1003	Declaration of Robert Giachetti
1004	<i>Curriculum Vitae</i> of Robert Giachetti
1005	DE9308896U1 (“Albrecht”)
1006	Albrecht Certified Translation
1007	Order Construing Disputed Claims of United States Patent No. 5,584,100 in <i>D&D Group Pty Ltd. et al. v. Nationwide Industries, Inc.</i> , Case No. 08-cv-236-MMA (POR), D.I. 26 (S.D. Cal. Mar. 23, 2009)
1008	U.S. Patent Publication No. 2005/0263552 (“Panosian”)
1009	U.S. Patent No. 8,919,622 (“Gabriel”)
1010	AT388448 (“Glock”)
1011	Glock Certified Translation
1012	U.S. Patent Publication No. 2016/0356304 (“Roberts”)
1013	File History for U.S. Patent No. 11,304,503
1014	U.S. Reissued Patent No. RE47,477

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

Exhibit No.	Description
1015	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.)
1016	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.)
1017	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.)
1018	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.)
1019	Excerpts from 2019 Merriam-Webster Dictionary
1020	Declaration of Nathaniel Louis DeLucia in Support of Admission <i>Pro Hac Vice</i>
1021	Declaration of Ryan Kane in Support of Admission <i>Pro Hac Vice</i>
1022	Dkt. 68, Joint Status Report in <i>Milwaukee Electric Tools Corporation v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.).
1023	Dkt. 70, Plaintiff's Opposed Motion for Voluntary Dismissal of Plaintiff's First Amended Complaint Without Prejudice and Dismissal of Defendant's Counterclaims Without Prejudice in <i>Milwaukee Electric Tools Corporation v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.).
1024	Dkt. 72, Memorandum in Support of Plaintiff's Opposed Motion for Voluntary Dismissal of Plaintiff's First Amended Complaint Without Prejudice and Dismissal of Defendant's Counterclaims Without Prejudice in <i>Milwaukee Electric Tools Corporation v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.).

Exhibit No.	Description
1025	Dkt. 76, Minute Entry Assigning Case Back to District Judge in <i>Milwaukee Electric Tools Corporation v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.).
1026	March 6, 2026 Response Letter from J. White to R. Kane in <i>Milwaukee Electric Tools Corporation v. Klein Tools, Inc.</i> , No. 1:25-cv-04689 (N.D. Ill.)
1027	<i>Case Study: Milwaukee Tool</i> , Tariff Integrity, https://www.tariffintegrity.org/tti/milwaukeeetool (last visited April 14, 2026)
1028	<i>Chinese-owned power tool company based in Wisconsin targeted by Trump administration for tariff evasion</i> , Washington Examiner (February 12, 2026), https://www.washingtonexaminer.com/news/white-house/4454169/trump-administration-action-chinese-owned-company-wisconsin/ (last visited April 29, 2026)
1029	<i>American Manufacturing</i> , Klein Tools, https://www.kleintools.com/content/american-manufacturing (last visited April 14, 2026)
1030	Techtronic Industries 2025 Annual Report (excerpted)

I. INTRODUCTION

In early May of 2025, Milwaukee Electric Tool (“Milwaukee”) filed an amended complaint against Klein Tools, Inc. (“Klein”) in the Northern District of Illinois, alleging among other things, that Klein infringes U.S. Patent No. 11,857,064 (“’064 Patent”).² The problem for Milwaukee is that it did not own—or even have any rights to—the ’064 Patent when it filed the amended complaint. Though Milwaukee buries that fact on *page 8* of its brief, the result is that Milwaukee was forced to move to dismiss its own case due to lack of standing (the “To-Be-Dismissed Case”) just three weeks before filing its discretionary denial brief.

These straightforward facts doom Milwaukee’s primary discretionary denial arguments, which are based on *Fintiv* and *Sotera*, as both doctrines are premised on the existence of a parallel district court litigation involving the challenged patent. Here, both *Fintiv* and *Sotera* are wholly inapplicable because Milwaukee’s case *will be dismissed*. The only issue remaining is whether the eventual dismissal will come with conditions or sanctions on Milwaukee due to its inadequate prefiling investigation and subsequent conduct. *See* Ex. 1025; *see also* Ex. 1022 at 4. And while Milwaukee indicates it intends to file a new case involving the ’064 Patent,

² Milwaukee’s original complaint, filed on April 29, 2025, alleged infringement of U.S. Patent No. 11,656,067 only.

the timing of such a filing is uncertain as Milwaukee has no control over when the district court will render its dismissal decision. As Milwaukee tacitly admits in its discretionary denial brief, there is no chance of a district court trial before the statutory deadline for the Board to issue a final written decision in this IPR. DD Br. at 9. The Board will therefore serve as an efficient alternative forum, not a duplicative one.

Apart from *Fintiv* and *Sotera*, Milwaukee briefly raises four other discretionary doctrines it contends weigh in favor of discretionary denial. They do not. **First**, Milwaukee seeks to rely on so-called “settled expectations” regarding the purported patentability of the ’064 Patent. But the ’064 Patent issued less than two and a half years ago, and Milwaukee raises no facts or authority that would support settled expectations for such a young patent. Indeed, Milwaukee took the opposite view when arguing against denial of its own IPR petition. **Second**, Milwaukee attempts to attack the merits of Klein’s Petition, but its criticisms largely focus on irrelevant duplication concerns and its disagreement with Klein’s claim construction positions, with the remainder boiling down to unsupported attorney argument. The strength of Klein’s Petition, which presents both anticipation and obviousness grounds, supports referral. **Third**, Milwaukee faults Klein for submitting the Expert Declaration of Robert Giachetti (“Giachetti Declaration”) in support of its Petition. Dr. Giachetti’s short declaration is entirely proper and provides targeted opinions on

a handful of claim limitations. Milwaukee’s characterization of the Petition as “rely[ing] extensively” on the Giachetti Declaration misrepresents both the scope of the declaration and its function in the Petition. Contrary to Milwaukee’s suggestion, Dr. Giachetti is not cited *at all* in Ground 1A. And his opinions on the remaining two grounds and Klein’s claim construction position are focused on “establishing the background knowledge possessed by a person of ordinary skill in the art,” including why a POSA would have had a “motivation to combine” the asserted references, which is “permissible evidence in an *inter partes* review.” *Qualcomm Incorporated v. Apple Inc.*, 24 F.4th 1367, 1375–76 (Fed. Cir. 2022).

Finally, Milwaukee raises the Director’s March 11, 2026 Memorandum on American manufacturing and insinuates that the factors described therein tip the scale in favor of discretionary denial. Milwaukee is wrong. None of these factors apply and therefore have no impact on institution. Milwaukee’s invocation of this memorandum is ironic given it is owned by Techtronic Industries, a Hong Kong conglomerate, and does not even make an allegedly practicing product *anywhere*. Ex. 1030 at 2–3; Ex. 1027 at 1, Ex. 1028 at 3. By contrast, Klein is an American company that has been family-owned since 1857. Ex. 1029 at 2. Klein’s research and development is almost entirely U.S.-based. And while Klein uses foreign sourcing for some products, such as for the accused products, it also has U.S. operations. It also continues to “insource some products to [its] USA plants” and

“has introduced many new US-manufactured products in recent years.” *Id.* This onshoring activity is exactly the type of American manufacturing the Director’s March 11, 2026 Memorandum was designed to encourage. *Id.*

Milwaukee’s request for discretionary denial should be denied, and this IPR should be referred to the Board for substantive assessment and institution.

II. *FINTIV* AND *SOTERA* DO NOT SUPPORT DISCRETIONARY DENIAL HERE

Despite moving to dismiss its own district court case, Milwaukee spends the bulk of its discretionary denial brief marching through the *Fintiv* factors. Milwaukee also criticizes Klein for foregoing a *Sotera* stipulation. But *Fintiv* and *Sotera* are only applicable when the parties to an IPR proceeding are litigating over the same patent in a parallel forum. Because Milwaukee’s case will be dismissed, its *Fintiv*- and *Sotera*-based arguments are completely irrelevant. In any event, even if the *Fintiv* factors are considered, they weigh strongly in favor of referral.

A. *Fintiv* and *Sotera* Are Inapplicable Because No Valid Parallel Litigation Exists

Milwaukee filed the To-Be-Dismissed Case on April 29, 2025, and its amended complaint alleging infringement of the ’064 Patent on May 6, 2025. Nine months later Milwaukee purportedly discovered that it did not possess any rights to the ’064 Patent and indicated that it intended to move to dismiss the case for lack of standing. Ex. 1022. Milwaukee filed its motion to dismiss in March 2026. Ex. 1023.

Milwaukee's discretionary denial brief characterizes its motion to dismiss as merely procedural, and its discussion of the *Fintiv* factors implies that the proceedings in the refiled case will pick up where the dismissed case left off. *See* DD Br. at 9–16. But according to Milwaukee, it is not bound by its contentions or even the court orders that issued in the To-Be-Dismissed Case. Indeed, when the parties conferred on the scope of the refiled case prior to Milwaukee's motion to dismiss, Klein proposed that, should Milwaukee refile, the new case should have the same scope as the To-Be-Dismissed Case. Ex. 1022 at 3. Milwaukee rejected Klein's proposal. *Id.* at 3, n.1. Instead, Milwaukee stated that it intended to file additional claims in any new case and disagreed that the scope of the litigation would remain the same. *Id.* at 3–4.

Milwaukee's gamesmanship confirms the inapplicability of *Fintiv*. If Milwaukee has its way, any new case it files relating to the '064 Patent will bear little resemblance to the To-Be-Dismissed Case. Milwaukee has informed Klein that it intends to assert additional claims, accuse additional products, and add additional patents, Ex. 1026 at 2–3, meaning that the parties would need to propound new discovery and newly litigate the *entire* case.

Milwaukee's stated intent to change the scope of any new case also confirms why a *Sotera* stipulation makes no sense here. A stipulation saying that Klein will not pursue any invalidity theories in a case that will be dismissed is meaningless.

And Klein cannot meaningfully stipulate regarding a yet-to-be-filed case where the scope of any future litigation is entirely unknown. A yet-to-be-filed proceeding also does not give rise to the duplication concerns that *Fintiv* and *Sotera* are designed to address. Indeed, both take into account the timing of a *parallel* court action and potential for duplication. But here, there is no valid parallel litigation in which theories could even be pursued, making the risk of possible future duplication speculation. Further, whether Milwaukee will in fact proceed with a new district court case, and the scope of such yet-to-be-filed case, are unknowns given the prospect of conditions or sanctions on Milwaukee in the To-Be-Dismissed Case. The Director should not credit Milwaukee's reliance on a nonexistent litigation that Milwaukee has yet to file.

B. Even if Considered, the *Fintiv* Factors Weigh Strongly in Favor of Referral

Even if the Director sees fit to consider the *Fintiv* factors in assessing Milwaukee's request for discretionary denial, the application of the *Fintiv* factors to this case strongly supports referral.

Fintiv factors 1, 2, and 3—likelihood of a stay, proximity of the trial date, and investment in the proceedings—favor Klein. Milwaukee's statement that "[n]o stay has been entered," DD Br. at 9, is—to be charitable—misleading. As Milwaukee recently admitted, it "agreed to stay all deadlines and discovery due to th[e] standing issue," and the Court cancelled all discovery deadlines. Ex. 1024 at 8, n.4; Ex. 1025.

The parties are not actively litigating any issue pertaining to the validity of the '064 Patent, no trial date was ever set, and the timing of a trial in any new case is uncertain (though, at a minimum, years away). This means any IPR will proceed to conclusion faster than any new district court case. Milwaukee admits that even if it files a new lawsuit, it is highly unlikely that a district court trial would be scheduled before the Board issues its final written decision. DD Br. at 9. And although Milwaukee states that “substantive merits activity” such as “exchanging final contentions” and “claim construction activity” may occur before a final written decision, *id.* at 10, that is merely speculation. Indeed, elsewhere Milwaukee argued that in the To-Be-Dismissed Case “[d]iscovery is still in the early stages,” Ex. 1024 at 7, and that “Klein will now get a longer schedule” in any new case, Ex. 1026 at 2. Nothing in law or logic justifies using speculative scheduling dates in yet-to-be-filed litigation as a basis for discretionary denial, and Milwaukee cites no precedent in support of its position.

Fintiv factor 4—existence of overlapping issues between the IPR and a parallel district court proceeding—similarly favors Klein because there is no valid parallel district court proceeding. Nonetheless, Milwaukee baldly asserts that Klein’s “initial invalidity contentions and counterclaim for declaratory judgment of invalidity of all claims of the '064 Patent also raise overlapping arguments with those in the Petition.” DD Br. at 11. Not so. Milwaukee fails to mention that Klein

only pursued invalidity of the asserted claims of the '064 Patent in district court and that Milwaukee has also sought to have those claims dismissed without prejudice due to Milwaukee's same prefiling investigation failures. Moreover, given the uncertainty with respect to the timeline in the To-Be-Dismissed Case and the timing of any new case, institution of Klein's Petition could very well save the parties the time and expense of another district court litigation entirely.

Fintiv factor 5—identity of the parties—is neutral at best. Identity of the parties is not dispositive in a *Fintiv* analysis. *See, e.g., Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at 2–3 (June 26, 2025).

Fintiv factor 6—other considerations—also favors Klein. Milwaukee attempts to fault Klein for filing its Petition within the one-year deadline provided by 35 U.S.C. § 315(b), arguing that Klein “waited nearly 9 months after Patent Owner filed its first amended complaint and five months after serving its initial invalidity contentions to file its Petition.” DD Br. at 12. As an initial matter, the deadline provided by 35 U.S.C. § 315(b) does not apply here because Milwaukee did not have any rights to the '064 Patent when it filed in district court, meaning that the deadline was never triggered. *Hamilton Beach Brands, Inc. v. f'real Foods, LLC*, IPR2016-01107, Paper 10 at 10 (Nov. 30, 2016) (finding that complaint dismissed for lack of standing “was not a proper federal pleading and did not trigger the one-year time period under 35 U.S.C. § 315(b)”). If anything, Klein's Petition was filed ***before***

service of any valid parallel district court complaint, not “9 months after.” And even if § 315(b) applied, nine months is an unremarkable timeline—well within the one-year statutory window—particularly if the parties are involved in parallel litigation. *See, e.g., Software Rights Archive, LLC v. Facebook, Inc.*, 2013 WL 5225522, at *6 (N.D. Cal. Sept. 17, 2013) (finding that “[a]lthough defendants did wait nearly a year to file the IPR petitions, they properly filed the petitions within the statutory time frame”). Penalizing Klein for complying with the one-year statutory time limit would turn § 315(b) on its head and unfairly prejudice Klein.

Accordingly, the *Fintiv* factors favor referral of Klein’s Petition.

III. MILWAUKEE’S ADDITIONAL ARGUMENTS ARE MERITLESS AND DO NOT SUPPORT DISCRETIONARY DENIAL

Adopting a kitchen sink approach, Milwaukee raises short, conclusory arguments under four additional discretionary doctrines. None of these doctrines favor discretionary denial, and in fact, one of these doctrines (the strength of Klein’s Petition) supports referral. Milwaukee’s arguments should be rejected.

A. Milwaukee’s Unsupported “Settled Expectations” Argument Does Not Favor Discretionary Denial

The ’064 Patent issued on January 2, 2024, only about two years before this Petition was filed. A patent owner is rarely justified in claiming “settled expectations” regarding the enforceability of such a young patent. *See, e.g., Milwaukee Electric Tool Corp. v. Klein Tools Inc.*, IPR2025-00724, -00892, PGR2025-00048, Paper 14

at 2 (Sept. 12, 2025) (“[T]he challenged patents have not been in force for a significant period of time (issued in 2022, 2022, and 2025). Accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial as to these patents.”). Instead, post-grant challenges to recently issued patents are consistently characterized as “early,” “favor[ing] robust, predictable patent rights[,] and weigh[ing] against discretionary denial.” *Micron Tech., Inc. v. Yangtze Memory Techs. Co. Ltd.*, IPR2025-00190, Paper 21 at 3 (June 25, 2025).

Milwaukee nonetheless contends, without support, that it developed strong settled expectations regarding the '064 Patent because Klein “should have been aware” that the '064 Patent belongs to a broader family of patents claiming priority to 2019 that are “directed to materially similar disk-and-pin tool-attachment systems.” DD Br. at 18. Milwaukee’s reliance on older parent patents to create settled expectations for a two-year-old patent is misplaced. The Director assesses settled expectations on a patent-by-patent basis, and a patent owner cannot artificially bolster settled expectations by pointing to a patent’s purported priority date. Indeed, when Milwaukee was opposing discretionary denial, it argued that Klein had “not developed strong settled expectations that favor discretionary denial” because the challenged patent had issued “less than three years before the filing of the Petition” and was therefore “young,” despite the challenged patent claiming priority back to January 2018, over seven years before that petition was filed. *Milwaukee Electric*

Tool Corp. v. Klein Tools Inc., IPR2025-00724, Paper 11 at 11 (Aug. 21, 2025).

The Director’s decision in *Zimmer Biomet Holdings, Inc. v. Lifenet Health* is instructive on this point. IPR2025-00248, -00249, Paper 13 at 2–3 (June 26, 2025). In that proceeding, one challenged patent issued in 2022, and the other challenged patent was a parent of the first. *Id.* The Director denied the patent owner’s request for discretionary denial for both challenged patents, reasoning that “Patent Owner has not developed strong settled expectations that favor discretionary denial as to the first patent, and it is an efficient use of Board resources to address the related patent.” *Id.* *Zimmer* clearly shows that the priority date is irrelevant in assessing settled expectations for a young patent, and in fact, a strong validity challenge to a younger patent may outweigh settled expectations for its older parent.

By contrast, *Dabico Airport Solutions Inc. v. AXA Power ApS* is inapposite, as there the challenged patent “ha[d] been in force almost eight years, creating settled expectations.” IPR2025-00408, Paper No. 21, at 3 (June 18, 2025). And, in any event, the Director’s numerous discretionary denial decisions make clear that the settled expectations analysis is anchored to the post-issuance period during which the patent owner can actually enforce its patent claims, not the time during which competitors could theoretically have located an application in the public record. *E.g., Intel Corp. v. Advanced Cluster Sys., Inc.*, IPR2025-00913, Paper 13 at 2–3 (Sept. 19, 2025); *Suzhou Mojawa Intelligent Elec. Co., Ltd. v. Shenzhen Shokz Co., Ltd.*, IPR2025-

00842, Paper 14 at 2–3 (Sept. 19, 2025).

Milwaukee’s failure to present any facts or law substantiating its settled expectations argument confirms that application of the doctrine to the ’064 Patent is unwarranted. *See Apple Inc. v. Apex Beam Techs. LLC*, IPR2025-00896, Paper 10 (Sept. 3, 2025).

B. The Strength of Klein’s Petition Strongly Favors Referral

Milwaukee also raises the strength of Klein’s Petition and asserts that “nothing in the Petition appears so compelling as to outweigh” the “parallel-litigation inefficiencies.” DD Br. at 12, 17. As explained in Section II, there are no risks of inefficiencies because no valid parallel litigation exists. To the contrary, institution of the Petition is likely to save the parties the time and expense of litigating in district court. Apart from pretextual parallel litigation concerns, and disagreeing with Klein’s proposed claim construction, Milwaukee does not seriously challenge the strength of Klein’s Petition, and for good reason: the grounds presented in Klein’s Petition strongly favor referral.

1. Klein’s Claim Construction Positions Are Strong

Milwaukee’s primary argument is that Klein’s claim construction positions under § 112(f) for “locking mechanism” and “mating structure” undermine the strength of the Petition. Not so. As Klein expressly explained in the Petition, “even if the Board finds that the terms do not invoke § 112(f), the prior art still discloses

or renders obvious all Challenged Claims for the same reasons presented” in the Petition. Pet. at 18, n.1. In other words, while the terms should be construed as means-plus-function, the arguments presented in the Petition apply irrespective of whether “locking mechanism” and “mating structure” are construed as means-plus-function terms. That is hardly surprising: if the terms are not found to invoke § 112(f), then their scope would be *at least* as broad as the means-plus-function construction. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1347 (Fed. Cir. 2015) (when a patentee uses a means-plus-function term, it is “restricting the scope of coverage to only the structure, materials, or acts described in the specification as corresponding to the claimed function and equivalents thereof.”). Indeed, Milwaukee does not (and cannot) argue that the means-plus-function scope proposed by Klein would be *excluded* from any alternative plain meaning proposal (though Milwaukee noticeably does not even disclose what it believes such a construction would be).

Milwaukee’s argument also ignores the strength of Klein’s claim construction positions for these two terms. Indeed, Milwaukee admits in its discretionary denial brief that the ’064 Patent describes a “disk-and-pin tool-attachment system[],” DD Br. at 18, which is exactly how Klein contends “locking mechanism” and “mating structure” should be interpreted in light of the specification. Pet. at 18–25. And while Milwaukee is correct that the claims do not use the word “means,” and there is thus a rebuttable presumption that they do not invoke § 112(f), this presumption is not

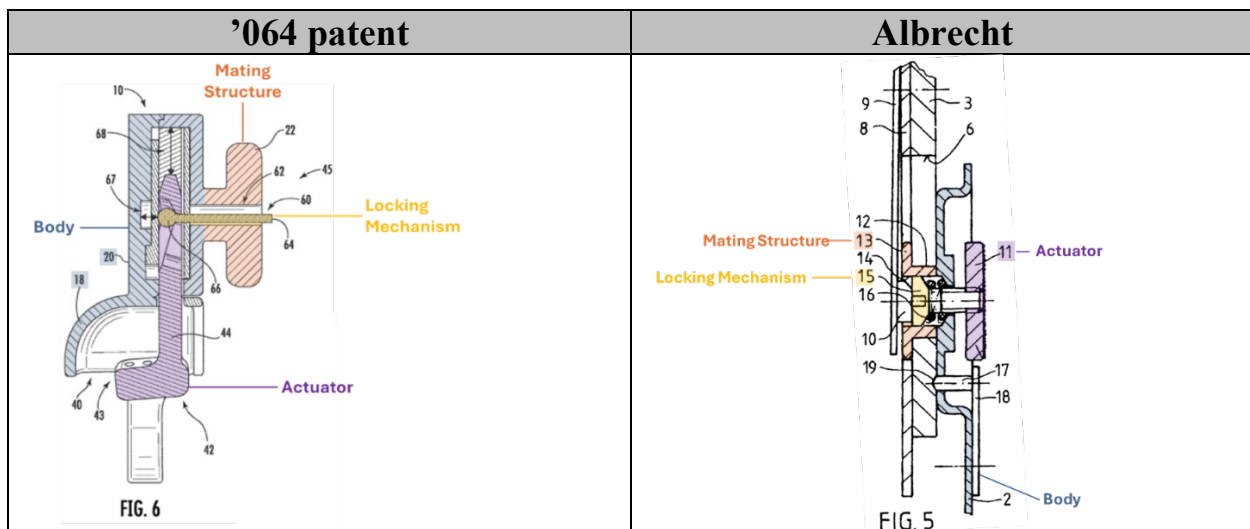
“strong” and is overcome by showing either “that the claim term fails to recite sufficiently definite structure or else [that the claim] recites function without reciting sufficient structure for performing that function.” *Williamson*, 792 F.3d at 1349 (Fed. Cir. 2015). Here, the presumption is easily overcome because the ’064 Patent’s claims recite the functions of “locking mechanism” and “mating structure” without reciting the structure to perform those functions. *See* Pet. at 18–25.

Milwaukee’s cited case, *Zeroclick*, is not to the contrary. *See* DD Br. at 16. That case involved two patents directed to interfaces for computers and mobile phones, which bear no relation to the technology or claim terms at issue here. *Zeroclick, LLC v. Apple Inc.*, 891 F.3d 1003, 1006 (Fed. Cir. 2018). Moreover, the district court’s § 112(f) analysis “pointed to no record evidence that support[ed] its ultimate conclusion.” *Id.* at 1008. Here, Klein has pointed to significant intrinsic and extrinsic evidence confirming that “locking mechanism” and “mating structure” should be construed under § 112(f). *See* Pet. at 18–25. By contrast, Milwaukee fails to identify even a single structural feature for either term. Milwaukee points only to the “locking mechanism’s” “structural setting,” tacitly admitting that there is no description of the “locking mechanism” *itself*. *Trove Brands, LLC v. CamelBak Prods., LLC*, 756 F. Supp. 3d 760, 769 (N.D. Cal. 2024). And Klein is not proposing that “disk mating structure”—the term in claim 1—is subject to § 112(f), as Milwaukee incorrectly implies. DD Br. at 15. As explained in the Petition, it is the

structural recitation of a “*disk* mating structure” that sets claims 1 and 16 apart and in fact illustrates the lack of structure for “mating structure” when the term used alone, as it is in claim 16. Pet. at 22.

2. Klein’s Anticipation and Obviousness Grounds Are Strong

Klein’s Petition presents two grounds based on Albrecht, Gabriel, and Glock. As Klein’s Ground 1A makes clear, Albrecht (Exs. 1005, 1006) discloses every limitation of Claims 1, 2, and 12 of the ’064 Patent, anticipating those claims. Pet. at 27–42. While Milwaukee attempts to fault the Petition for asserting that Albrecht anticipates “only” claims 1, 2, and 12, this alone warrants referral, as the Board could (and should) institute the Petition on this basis alone. *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 365 (2018); *Bright Data Ltd. v. Oxylabs, UAB*, IPR2023-00185, Paper 9 at 29–31 (July 18, 2023). For example, Albrecht discloses each limitation of claim 1 of the ’064 Patent, including a body, locking mechanism, mating structure, and actuator, as illustrated in the Petition and reproduced below:



E.g., Ex. 1006 at 5:9–10, 6:5–16, Figs. 3–5; Pet. at 3, 27–39.

Grounds 1B and 2 are similarly strong. Ground 1B presents an obviousness case based on Albrecht in combination with Gabriel for claims 3–9 and 16–20. Pet. at 42–68. Specifically, Klein relies on only one element from Gabriel—a locking member—to modify the push button of Albrecht. *E.g.*, Pet. at 42–50. Ground 2 presents an obviousness case based on Albrecht in combination with Glock and Gabriel for all Challenged Claims, which is an alternative invalidity ground. Pet. at 68–105. Again, Ground 2 relies on Gabriel’s “locking member” to modify Albrecht’s push button, and Glock’s opening to modify Albrecht’s bolt and leaf spring mechanism. Pet. at 69–71, 80–87. The Board has repeatedly held that strong obviousness challenges support referral and institution. *See, e.g., SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13 at 12–13 (Apr. 7, 2025); *Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00985, Paper 11 at 19–25 (Dec. 12, 2024); *BioNTech SE v. ModernaTX, Inc.*, IPR2023-01359, Paper 20 at 77 (Mar. 19, 2024). That is exactly the case here, and Milwaukee’s unsupported attorney argument cannot support its request for discretionary denial. *See Twitch Interactive, Inc. v. Razdog Holdings LLC*, IPR2025-00307, -00308, Paper 19 at 3 (May 16, 2025) (denying request for discretionary denial where “alleged weaknesses of the Petition,” among other allegations, are not “sufficiently explained”).

C. The Giachetti Declaration Is the Type of Targeted Expert Evidence Described by the Director’s March 26, 2025 Memorandum

Milwaukee next cites the Director’s March 26, 2025 Memorandum to argue that the Petition should be discretionarily denied for supposed overreliance on the Giachetti Declaration. DD Br. at 16–17. The Director’s guidance on expert reliance is directed at petitions where the expert, not the prior art, is doing the substantive work of proving unpatentability; petitions where generalized principles and expert advocacy substitute for disclosures in the references. That is not the case here.

Even a short review of Klein’s Petition and the Giachetti Declaration reveals that Milwaukee’s criticisms do not pass muster. The Giachetti Declaration is a short, targeted declaration focusing on limited aspects of prior art. *See generally* Ex. 1003. Albrecht, Glock, and Gabriel expressly disclose every limitation of the Challenged Claims. *See, e.g.*, Ex. 1006 at 1:5–15, 3:9–19, 5:9–34, 6:1–7:18, Figs. 1–6; Ex. 1009 at 1:28–54, 3:38–4:5, Figs. 1, 6–11; Ex. 1011 at 2:1–20, 3:19–30, 4:4–11, Figs. 1–4; Pet. at 27–105. As Milwaukee itself previously argued to the Director, where an expert is not used “to fill gaps in the prior art,” an “expert declaration is not a basis for discretionary denial.” *Milwaukee Electric Tool Corp. v. Klein Tools Inc.*, IPR2025-00724, Paper 11 at 16-17 (Aug. 21, 2025). That is the case here.

Contrary to Milwaukee’s suggestions, the Giachetti Declaration does not “bridge gaps [or] carry the final analytical step from the cited references to the

challenged claims.” DD Br. at 17. In fact, Dr. Giachetti is not cited *at all* in Ground 1A. Even when Dr. Giachetti provides targeted opinions related to Klein’s obviousness grounds, he does so based on well-established principles: that a POSA would have understood how the relevant features of these detachable tool pouches function and could be combined or exchanged, and why a POSA would have been motivated to do so. Ex. 1003 ¶¶ 32–38, 45–46, 53–65, 71–74, 79–82, 85–90, 92–103, 105–06, 108–09, 111–12. Indeed, even in its example purporting to demonstrate the Petition’s reliance on Dr. Giachetti, Milwaukee admits that the Petition “us[es] Gabriel,” *i.e., the prior art*, “to justify relocating Albrecht’s actuator below the mating structure,” with Dr. Giachetti merely explaining why “a POSA would have expected success.” DD Br. at 17. Explaining what a person of ordinary skill in the art would have understood from the prior art is the precise role expert testimony is supposed to play. *Qualcomm*, 24 F.4th at 1376.

Milwaukee’s suggestion that the Petition “turns repeatedly to expert opinion for claim construction,” is also incorrect. DD Br. at 16. Rather, Dr. Giachetti provides a total of *three* substantive paragraphs related to Klein’s claim construction positions. Ex. 1003 ¶¶ 32–34. And in those paragraphs, Dr. Giachetti provides targeted opinions regarding why a POSA would not consider “mating structure” or “locking mechanism” terms of art, and what a POSA would understand the function of those features to be. *Id.* This is entirely appropriate. *Bradium Techs. LLC v. Iancu*,

923 F.3d 1032, 1043 (Fed. Cir. 2019) (“[t]he Board may properly rely on expert testimony to explain terms of art, and the state of the art,” in construing claims).

D. The Director’s March 11, 2026 Memorandum Regarding American Manufacturing Does Not Impact This Petition

On March 11, 2026, the Director issued a memorandum identifying three additional factors he will consider in determining whether to institute IPR proceedings:

- (1) the extent to which any products accused of infringement in a parallel proceeding are manufactured in the United States or are related to investments in American manufacturing operations;
- (2) the extent to which any products made, sold, or licensed by the patent owner that compete with the accused products are manufactured in the United States; and
- (3) whether the petitioner is a small business that has been sued for infringement of the patent at issue.

Although Milwaukee invokes the Director’s March 11, 2026 Memorandum, Milwaukee fails to address *any* of these factors and does not state any conclusion as to whether the memorandum favors or disfavors referral. DD Br. at 19. That makes sense as none of the factors are applicable here. To start, there is no valid “parallel proceeding.” Klein is not a small business, and even if the To-Be-Dismissed Case counted, Milwaukee does not make an allegedly practicing product. By contrast, Klein has significant U.S. investments in design, development, marketing, sales, warehousing, and supply chain activity relating to its tool pouches, as well as many other products. Indeed, Klein continues to “insource some products to [its] USA

plants” and “has introduced many new US-manufactured products in recent years.”

Ex. 1029 at 3. To the extent these types of activities are deemed relevant to the discretionary denial calculus, they favor Klein, not Milwaukee.

IV. CONCLUSION

Milwaukee’s request for discretionary denial does not present circumstances that warrant denial under Board and Director precedent. The Petition should proceed to referral for substantive assessment of the merits.

Date: May 11, 2026

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

This Opposition to Patent Owner's Request for Discretionary Denial complies with the 20-page limitation as mandated by the Interim Director Discretionary Process III.C.

/s/ W. Todd Baker

W. Todd Baker

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document and supporting exhibit was served on May 11, 2026 on counsel of record for the Patent

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