

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Milwaukee Electric Tool Corporation,
Petitioners,

v.

Klein Tools, Inc.,
Patent Owner.

U.S. Patent No. 12,187,573
Case No. PGR2025-00048

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	MATERIAL ERROR.....	3
III.	RAPID CHALLENGE AND LACK OF SETTLED EXPECTATIONS	5
IV.	THE PETITION IS STRONG AND SHOULD NOT BE DENIED UNDER 35 U.S.C. § 325(D).....	6
	A. Prior Art: Obviousness Grounds	7
	B. Indefiniteness and Written Description.....	10
	C. Expert Testimony	11
V.	COMPLEXITY AND DIVERSE TECHNOLOGY SCOPE OF ASSERTED PATENTS FAVORS INSTITUTION.....	11
VI.	THE FIRST FIVE <i>FINTIV</i> FACTORS ARE OVERALL NEUTRAL OR SLIGHTLY AGAINST DENIAL	13
	A. Factor 1	14
	B. Factor 2.....	15
	C. Factor 3	16
	D. Factor 4.....	17
	E. Factor 5.....	17
VII.	ADDITIONAL CIRCUMSTANCES (FACTOR 6) MOVE THE OVERALL WEIGHT OF THE <i>FINTIV</i> FACTORS OVERWHELMINGLY AGAINST DISCRETIONARY DENIAL	18
	A. Factor 6.....	18
VIII.	CONCLUSION	19

Table of Exhibits
(newly added exhibits in italics)

Exhibit	Description
Ex-1001	U.S. Patent No. 12,187,573 (“’573 Patent”)
Ex-1002	Prosecution History of the application that led to the ’573 Patent
Ex-1003	Declaration of Expert Witness, Dr. David J. Eby, Ph.D., P.E., CFEI.
Ex-1004	European Patent No. 1,391,412 (“Hartranft”)
Ex-1005	International Publication No. 1997/41626 (“Bruin”)
Ex-1006	U.S. Patent No. 5,505,432 (“Noonan”)
Ex-1007	CV of Expert Witness, David J. Eby, Ph.D., P.E., CFEI
Ex-1008	Klein Tools Fish Tape Publication (“KP1”)
Ex-1009	Southwire Glow in the Dark Fish Sticks Publication (“SP1”)
Ex-1010	Internet Archive Affidavits
Ex-1011	Laura, “A Brief History of Doughnuts,” Kitchen Kat Blog (January 26, 2008), https://kitchenkat.blogspot.com/2008/01/brief-history-of-doughnuts.html
Ex-1012	“donut”. <i>The American Heritage Dictionary of the English Language</i> (3 rd Ed.), Houghton Mifflin Company, 1996, p. 551
Ex-1013	Irving, Washington. (1809) <i>Knickerbocker’s History of New York</i> . Project Gutenberg. Retrieved April 14, 2025, from https://www.gutenberg.org/files/13042/13042-h/13042-h.htm#KNICKERBOCKERSI
Ex-1014	Klein Glow Fish Tape publication
Ex-1015	Prosecution History of the application that led to the 11,713,209 Patent (“’209 Patent”)

Ex-1016	Complaint in International Trade Commission (ITC) investigation No. 337-TA-1442, titled <i>Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof</i> (“ITC Complaint”)
Ex-1017	Sagon, Candy, “The Hole Story,” Washington Post (March 6, 2002), https://www.washingtonpost.com/archive/lifestyle/food/2002/03/06/the-hole-story/ce8a94e0-05c7-4639-8ff7-60c6fd46eeee/ . Wayback Machine. Archived August 25, 2018, from https://web.archive.org/web/20180825183723/https://www.washingtonpost.com/archive/lifestyle/food/2002/03/06/the-hole-story/ce8a94e0-05c7-4639-8ff7-60c6fd46eeee/?utm_term=.24e165d5cce3
Ex-1018	U.S. Patent No. 11,713,209 Patent (“’209 Patent”)
Ex-1019	“A Brief History of Fluorescence and Phosphorescence before the Emergence of Quantum Theory” by Benard Valuer and Mario N. Berberan-Santos, published in the Journal of Chemical Education.
Ex-1020	“Development of Illuminant Glow-in-the-Dark Cotton Fabric Coated by Luminescent Composite with Antimicrobial Activity and Ultraviolet Protection” by Tawfik A. Khattab, et al., published in the Journal of Fluorescence.
Ex-1021	Testimony history of Expert Witness, David J. Eby, Ph.D., P.E., CFEI
Ex-1022	<i>Declaration of Scott D. Sherwin in Support of Petitioner’s Notice of Intent to Designate Scott D. Sherwin as a Provisionally Recognized PTAB Attorney Eligible for Automatic Pro Hac Vice Admission as Back-Up Counsel</i>
Ex-1023	<i>U.S. Patent Application No. 18/968084 (“’084 Application”) as filed December 4, 2024</i>
Ex-1024	<i>Email from Milwaukee Tools Counsel regarding invalidity contentions, in the Matter of Certain Glow Fish Tape</i>
Ex-1025	<i>INV. No. 337-TA-1409, Order No. 22</i>
Ex-1026	<i>INV. No. 337-TA-1409, Order No. 23</i>

I. INTRODUCTION

Milwaukee Electric Tool Corp. (“Petitioner”) submits this brief in opposition to the Patent Owner’s Discretionary Denial brief dated July 18, 2025. Discretionary denial is not appropriate for the reasons set forth below.

Petitioner has acted with diligence by using post-grant review (PGR) to challenge all claims of U.S. Patent No. 12,187,573 (“the ’573 Patent”). The Patent issued this year, with the instant Petition filed around three months after its issue date (January 7, 2025), and thus has not been subject to prior validity reviews, making it an ideal candidate for PGR. While there is a parallel action at the International Trade Commission (ITC) and in District Court, the District Court litigation is stayed, and Petitioner promptly filed this Petition just one month after the ITC investigation was instituted.

In addition to Petitioner’s quick challenge to a young ’573 Patent, the grounds for the PGR are robust and have not been previously presented to the Patent Office. All references relied on in the PGR petition are new and merit the Board's careful consideration in the interest of maintaining the integrity of the patent system.

Moreover, Patent Owner continues to file and prosecute continuation applications with patentably-indistinct claims that contain the same improperly broadened claim language as the ’573 Patent. *See* Ex-1024 (claims filed for child

application); *see also* Ex-1002 at 186 (terminal disclaimer filed by Patent Owner to obviate a double patenting rejection with respect to the parent '209 Patent, subject to the co-pending IPR2025-00892). A continuation application was filed on December 4, 2024 (Application 18/968,084). Under 37 CFR 42.73(d), patent-owner estoppel is only applicable if the PTAB reaches a final decision.

Expectations will remain unsettled until the PTAB resolves these issues as the PTAB is the sole adjudicative body capable of triggering 42.73(d) estoppel and thus is uniquely well-situated to resolve issues related not only to the already issued patent but also to appropriately constrain Patent Owner's ongoing attempts to secure patentably-indistinct claims.

As explained in detail below, Petitioner respectfully submits that these circumstances collectively warrant a thorough review and cancellation of the challenged claims. These circumstances also provide the Acting Director with an appropriate vehicle to provide clarity as to when a PGR should proceed despite the existence of a parallel ITC action. The speed of the challenge here to a young patent that experienced a material error during examination merits the Board's review—particularly since the Board's review will impact the open prosecution that continues to rehash similar issues and will help settle expectations for this patent family.

II. MATERIAL ERROR

A material error on the part of the Examiner, namely failing to consider the §112, written description issue raised in the Petition, counsels against discretionary denial. Claim 1 of '573 Patent recites the “sidewalls of the case” being “**configured** to allow the luminescent material to be energized,” even though neither the original specification of the '573 Patent nor that of its parent application (which is substantively identical) describes any way to energize the luminescent material other than a portion of the case being transparent. *See* Paper 2 (Petition) at 94-99. Thus, the '573 Patent does not evidence that patentee was in possession of any way to energize the luminescent material other than a transparent portion of the case.

Patent Owner argues in its Request for Discretionary Denial that the specification discloses “exemplary materials that can be used for sidewalls, which a POSITA would recognize include not only transparent, but also translucent materials” such as “polycarbonate, polypropylene, and Acrylonitrile butadiene styrene (ABS).” Paper 8 at 18. There are numerous flaws in this argument. First, Patent Owner’s assertion that a POSITA would recognize these materials as translucent is wholly unsupported by any evidence on the record (in the form of scholarly text, expert testimony, or any other exhibit). Second, the specification of the '209 Patent never uses the word “translucent.” Rather, specification repeatedly

(and only) uses the word “transparent” in reference to this feature. Third, even assuming, *arguendo*, that a POSITA would understand these materials to be translucent, Patent Owner has not explained how the mere inclusion of exemplary materials cures the written description problem raised in the Petition. This is especially true given that “translucent” differs from “transparent” only in degree rather than kind. Even if taken as true, Patent Owner’s assertions fail to show that a person of ordinary skill in the art would understand that the patentee was in possession of the entire scope of the claim.

Patent Owner’s argument is further undermined by their own Preliminary Response. In that brief, Patent Owner “contests” the assertion that claim 1 requires “light to pass through the material that forms [the] sidewall.” Paper 10 at 15. This evidences Patent Owner’s belief that the term “configured” does not require any material whatsoever. Patent Owner’s attempt to cure the 112, written-description deficiency by pointing to different materials thus rings hollow because, under Patent Owner’s own construction, the full scope of the claim covers both material as well as a lack of material. Patent Owner does not even attempt to show written-description support for a lack of material. Paper 2 at 94.

While it is true that the Examiner never made a §112 rejection during prosecution of the ’573 Patent, this fact points to material error, not the absence of a §112 written-description problem. Patent Owner argues that the Examiner

“evaluated the pending patent claims for conformance with §112, as is required in all examinations, and therefore **necessarily** concluded the claims as written...met the requirements for patentability.” Paper 8 at 15. On this argument, Patent Owner cannot be correct because, otherwise, every 112(a) argument made in a PGR petition—regardless of whether there were any similar rejections made during prosecution, should be disregarded under the *Advanced Bionics* analysis. This is not the law and Patent Owner tellingly cites no authority to support such an unwarranted blanket assertion. The Board has already dismissed this sort of meritless argument, holding in a previous case that “the mere absence of a rejection does not reflect that the Examiner already considered the specific arguments presented in the Petition.” *Lifescan Glob. Corp. v. Ikeda Food Rsch., Ltd.*, PGR2019-00032, Paper 11 at 14 (P.T.A.B. Aug. 15, 2019).

It was material error to fail to specially consider the 112(a) issues and discuss those issues on the record—the Board can and should correct that.

III. RAPID CHALLENGE AND LACK OF SETTLED EXPECTATIONS

The '573 Patent is young. The Patent issued this year, with the instant Petition filed around three months after the Patent's issue date. Ex-1002 at 200. Thus, Petitioner has challenged the patent early on in its life and this favors “robust, predicable patent rights and weigh against discretionary denial.” *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, -00605, Paper 12 at 2

The Director has repeatedly found that a challenged patent issued as early as 2020 “has not been in force for a significant period of time” and thus the “Patent Owner has not developed strong settled expectations that favor discretionary denial.” *CSPC Megalith Biopharmaceutical Co., Ltd. v. Shanghai Miracogen Inc.*, IPR2025-00685, Paper 9 at 2; *see also Microsoft Corp. v. Edge Networking Systems, LLC*, IPR2025-00617, -00618, -00619, Paper 13 at 2 (finding issue dates of 2020, 2021, and 2023 to weigh against discretionarily denial); *Mim Software Inc. v. Progenics Pharmaceuticals, Inc.*, IPR2025-00630, -00725, -00726, Paper 12 at 2 (finding issue dates of 2020, 2022, and 2024 to weigh against discretionarily denial); *Revvo Technologies Inc. v. Tire Stickers LLC*, IPR2025-00631, Paper 12 at 2 (finding an issue date of 2021 to weigh against discretionarily denial).

This weighs strongly against denial. And as a post-grant review petition, it is favored for institution under the Director’s practices. *See Therabody, Inc. v. Datafeel Inc.*, PGR2025-00026, Paper 10 at 2 (finding “petitions for post-grant review are favored.”). Thus, this factor weighs against discretionary denial.

IV. THE PETITION IS STRONG AND SHOULD NOT BE DENIED UNDER 35 U.S.C. § 325(D).¹

The Advanced Bionics framework sets forth a two-part inquiry to determine

¹ In Paper 8, Patent Owner erroneously refers to § 315(d), but appears to present arguments under § 325(d), which is what Petitioner addresses here.

whether a § 325(d) discretionary denial is warranted. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (designated precedential: Mar. 24, 2020).

None of the references or arguments in this Petition were previously considered during prosecution.

Moreover, the Examiner erred by not identifying Hartranft, Bruin, Noonan Klein Tools Fish Tape (KP1), and Southwire Glow in the Dark Fish Sticks (SP1). The Petition presenting “different prior art than the Office was aware of” constitutes error by the Office during prosecution. *Oticon Medical AB v. Cochlear Limited*, IPR2019-00975, Paper 15 at 19-20 (PTAB Oct. 16, 2019) (designated precedential: Mar. 24, 2020). The Examiner further erred by allowing a broader claim scope than supported by the written description and in allowing an indefinite term in the claims.

A. Prior Art: Obviousness Grounds

The obviousness grounds of the Petition are strong. The references in the Petition and the arguments based thereon are not the same or substantially the same as previously presented to the Office. Moreover, multiple motivations to combine are provided and the combinations address the amendments and arguments that led to allowance of the '573 Patent.

Patent Owner first argues that the references fail to disclose “a fish tape

having a length extending from a first end to a second end, the length of the fish tape comprising a luminescent material that emits light after being energized by exposure to a light source.” Paper 8 at 19. However, the Petition includes detailed grounds explaining how the references exactly teach such a limitation. Paper 2 at §§ 6.1.4.2, 6.1.8.1, 6.1.14.1, 6.3.4.2, 6.3.16.1. To the extent Patent Owner disagrees with these detailed grounds, this is the type of issue (fact-intensive question) that institution of the Petition would allow the Board to resolve.

Patent Owner also argues that two of the references, Bruin and SP1, do not describe fish tape at all, but rather a cable catcher and fish sticks. Paper 8 at 19. As explained in the Petition, the Expert Declaration, and the Patent itself, fish tape is another name for a wire/cable puller, which is exactly what a cable catcher and fish sticks are as well. *See* Paper 2 at 2 (“fish tape pulls electrical wires and fiber optic cables through conduits or into enclosed wall spaces”); *see also* Ex-1003 at 13 (“the ’573 Patent relates to a luminescent fish tape system to pull electrical wires and fiber optic cable through conduits or into enclosed wall spaces; Ex-1001 at 1:29-1:30 (“[s]uch fish tapes are used to pull electrical wires and fiber optic cables through conduit or into enclosed wall space.”). In fact, Patent Owner’s own advertising materials state that the fish tape housed within their Klein Glow Fish Tape cases “also function as a super-flex glow rod.” Ex-1014 at 2. Thus, Patent Owner implicitly concedes that fish tape can go by different names, such as “a

super-flex glow rod.”

Patent Owner then argues first that the combination suffers from “improper hindsight reasoning” and second that the “proposed modification would render the devices of Hartranft and KP1 ‘inoperable for [their] intended purpose.’” Paper 8 at 20. For the first argument, the Petition includes multiple, detailed and reasoned rationales for combining the references. Paper 2 at 12-17, 58-66. These explanations go beyond mere conclusory assertions or allegations of hindsight bias. Again, to the extent that Patent Owner disagrees with the motivations, this is the type of issue (a fact-intensive question) that institution of the Petition would allow the Board to resolve.

The second argument, that placing the cable catcher and/or fish sticks into the fish tape case of Hartranft and/or KP1 would render them inoperable, similarly holds no merit as Patent Owner itself advertises that Klein Glow Fish Tape cases are “fully removable from case for wall cavity, drop ceiling, and conduit pass through feeding...allowing this fish tape to also function as a super-flex glow rod.” Ex-1014 at 2. They are essentially advertising that their Klein Glow Fish Tape takes “a super-flex glow rod” and combines it with their “case,” the same underlying logic behind the combinations proposed in the Petition. Thus, Patent Owner’s contorted positions only further confirm the Petition’s strong merits.

B. Indefiniteness and Written Description

On Petitioner's indefiniteness ground, Patent Owner argues that "Petitioner does not truly grapple with the best intrinsic record" on the term "donut shaped." Paper 8 at 13. Yet Patent Owner also fails to produce any "intrinsic record" that "donut shaped" is "generally circular with a hole in the middle" as alleged by Patent Owner. *Id.* at 14. All Patent Owner points to is three figures from the '573 Patent; however, just three figures (same embodiment), without any other specification support, does not inform those skilled in the art about the scope of the invention with reasonable certainty. Patent Owner then points to examples of commercially available cases cited in the specification; however, as shown in the Petition, all these cases have differing shapes of holes and thus Patent Owner has not shown how commercially available cases, all with different shaped holes, can provide an objective measure of the metes and bounds of the shape of a donut. Paper 2 at 102-106. Finally, Patent Owner points out that Petitioner uses the term "donut shaped" in their own patents, but the examples they identify use that term in the specification and **not** in any claims. That comparison is inapt, lacks relevance, and fails to save the way Patent Owner used the term in an indefinite fashion in the patent at issue here.

On Petitioner's written-description ground, Patent Owner has also failed to identify any evidence from the '573 Patent that adequately shows patentee was in

possession of any way to energize the luminescent material other than a transparent portion of the case, thus. *See* § II. Thus, once again, Patent Owner's Request only further confirms the strength of the merits of the Petition and the need for institution.

C. Expert Testimony

Patent Owner further argues in their Request that the Petition is over-reliant on expert testimony. Not so. "Patent Owner does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art." *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, -00436, -00437, Paper 11 at 2. Thus, Petitioner's detailed expert declaration is not a basis for discretionary denial, especially as Petitioner was "merely complying with regulations requiring disclosure of 'underlying facts or data.'" *GD Energy Products, LLC v. Kerr Machine Company*, PGR2025-00031, Paper 11 at 2.

V. COMPLEXITY AND DIVERSE TECHNOLOGY SCOPE OF ASSERTED PATENTS FAVORS INSTITUTION

The Board is best suited to consider the patentability of '573 Patent. As with the multi-patent litigation at issue in *Shenzhen Tuozhu Technology Co., Ltd. v. Stratasys, Inc.*, and *Tesla, Inc. v. Intellectual Ventures II LLC*, the '573 Patent at issue here is part of "complex and diverse" multi-patent litigation spanning multiple patent families, numerous diverse technologies, and multiple jurisdictions.

IPR2025-00438, Paper 10 (July 17, 2025), IPR2025-00217, Paper 9 (Jun. 13, 2025).

The ITC case involves four patents from two different patent families that span different technologies (safety helmets and glow tape). Patent Owner has amended the ITC since the filing of the Petition to include the most recently granted patent on safety-helmet aspects. Ex-2009. In each patent family, Patent Owner continues to prosecute continuation applications with patentably-indistinct claims. *See* Ex-1023 (claims filed for child application); *see also* Ex-1015 at 186 (terminal disclaimer filed by Patent Owner, which confirms patentable indistinctness with respect to the '209 Patent). This further favors institution as, per 37 CFR 42.73(d), patent-owner estoppel is only applicable if the Board reaches a final decision, and, as explained above, this leaves the Board uniquely well-situated to resolve issues related not only to the already issued patent but also to appropriately constrain Patent Owner's ongoing attempts to secure patentably-indistinct claims. Institution in the present proceeding is thus warranted.

Further, the co-pending litigations (the ITC investigation and the District Court Case) involve four different patents of diverse subject matter. Ex-2003; Ex-2009. The large number and broad scope of the patents asserted weighs against discretionary denial, as the Board is uniquely situated to deal with the complexity that such a large number of patents with diverse multiple subject matter presents.

See Shenzhen Tuozhu Technology Co., Ltd. v. Stratasy, Inc., IPR2025-00438, -00531, -00532, -00585, -00511, Paper 10 at 3. Thus, this additional circumstance weighs against discretionary denial.

Having amended the complaint to include the newly issued child patent, the '265 Patent, Patent Owner argues that "Petitioner has only requested review of three of [the four asserted] patents" in the parallel ITC Investigation. Paper 8 at 25. This argument is moot as a PGR petition is forthcoming to challenge the '265 Patent, which was added to the ITC case via an amended complaint. *Compare* Ex-1016 (original complaint asserting just three patents, filed February 11, 2025) with Ex-2009 (amended complaint asserting an additional fourth patent).

Due to the multi-patent litigation spanning multiple jurisdictions and the diverse technology, discretionary denial is inappropriate.

VI. THE FIRST FIVE *FINTIV* FACTORS ARE OVERALL NEUTRAL OR SLIGHTLY AGAINST DENIAL

While there is a co-pending ITC investigation, when viewed holistically, as detailed below, the first five factors are overall neutral or slightly against denial. When viewed against the remaining circumstances highlighted above, the overall discretionary-denial analysis is against denial (*infra* Section VII). A discussion of the first five factors follows next.

A. Factor 1

The co-pending district court litigation involving the '573 Patent has been stayed and that stay will remain in place until the completion of the co-pending ITC investigation. *See* Case No. 1:25-cv-00143-JLH, Dkt. No. 12.

While the co-pending ITC Investigation is not currently stayed, Patent Owner's characterization that "virtually all of the issues raised by the PGR are present in the parallel ITC investigation" is misleading and incomplete. Paper 8 at 11. The co-pending ITC Investigation does **not** have 100% overlap with the claims challenged in the '573 Patent. While the instant Petition covers all the claims of the '573 Patent (claims 1-18), PO has only asserted claims 1-2, 4, 6-8, 10, and 14-17 in the ITC Investigation. That's a *minimum* of seven claims that would only be addressed by the Board, and likely more given the nature of claim narrowing at the ITC, and it is therefore only through this PGR proceeding that Petitioner can obtain complete relief.

Further, the invalidity grounds asserted in the ITC do not overlap 100% with the invalidity grounds outlined in the instant Petition. Unlike the ITC, this Petition relies on Klein Tools Fish Tape in view of Southwire Glow in the Dark Fish Sticks. *See* Ex-1024. Thus, that ground at issue in this PGR will likely never be considered by the ITC.

B. Factor 2

The district court action is currently stayed and the stay, as explained in § A, will remain in place until at least June 18, 2026, which is the current ITC's Target Date. Thus, the district court action will unlikely be tried before the Board's projected deadline of November 21, 2026 for a Final Written Decision ("FWD").

While the co-pending ITC's Target Date is currently scheduled in advance of the Board's FWD, it is likely this date will be extended. As was seen in a different proceeding between the same parties, the ITC extended the Target Date not once but twice due to "complexity of the issues raised" and "current constraints on judicial resources." *See* Ex-1025, EX-1026. As the co-pending Investigation is currently covering four different patents and very diverse subject matter (Helmets and Glow Tape) and the parties are the same, it is likely the Target Date will have to be extended as well, closing the gap between the Board's FWD and the ITC's Target Date.

Further, Petitioner filed its petition on April 21, 2025, a month from when the ITC investigation was instituted on March 19, 2025, an exceptionally prompt filing timetable. Institution would thus directly serve the Congressional goal of post-grant proceedings under the America Invents Act ("AIA") to provide "a quick, inexpensive, and reliable alternative to district court litigation to resolve questions of patent validity." S. REP. NO. 110-259, at 20 (2008).

Further, as explained in §A, the ITC's final determination will not address all the claims challenged in the instant Petition and may not address any invalidity contentions at all. Nor can the ITC trigger the patent-owner estoppel of 42.73(d), because only the Board can do that and help settle expectations around the open prosecution for this patent family.

Even if the ITC did address 100% of the issues present in the instant Petition, a decision in the ITC has no preclusive effect. *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1570 (Fed. Cir. 1996); *Ingevity Corp. v. Int'l Trade Comm'n*, No. 2020-1800, 2021 WL 3440786, at *6 (Fed. Cir. July 21, 2021). Ultimately, the ITC cannot provide Petitioner with complete relief.

C. Factor 3

Petitioner moved to stay the co-pending district court case—which was unopposed and granted—at the start of the case, and thus there was no investment in that parallel proceeding as the entirety of the case had yet to begin.

And while the ITC investigation has proceeded along further than the district court litigation, as explained in §A, it does not cover all the claims of the '573 Patent like the Petition here does. Given that Petitioner is likely to have to narrow further in the ITC proceeding, institution of this PGR is both appropriate and necessary.

Additionally, Petitioner and Patent Owner are currently before the District of

Delaware in the stayed, co-pending District of Delaware case. Regardless of the outcome of the ITC, Petitioner and Patent Owner will still have to subsequently litigate the matter in federal district court both because an ITC determination has no preclusive effect and because the ITC's remedies are limited to exclusion orders and cease and desist orders. The cost of the District Court litigation far exceeds the costs compared to an IPR. Therefore, the PTAB route would be a more efficient use of party, judicial, and Board resources (particularly given the Board's unique ability to invoke 42.73(d) estoppel, which no other forum can do) than resorting to District Court litigation.

D. Factor 4

Because the co-pending district court case, as explained in §A, is stayed and will likely remain stayed until at least the Board's statutory deadline for a FWD in the instant proceedings, there is no overlap of issues in the two proceedings due to the estoppel provision of 35 U.S.C. § 315(e)(2).

With respect to the co-pending ITC investigation, as explained in §A, there is limited overlap in claims and invalidity contentions. Further, because the ITC's decision cannot invalidate a patent, no matter what the resolution is in the ITC, Petitioner will still need to seek relief at the Board.

E. Factor 5

Petitioner agrees that the parties involved in the noted litigation and present

PGR are the same.

Overall, the first five factors are neutral or slightly against denial. As explained next, when viewed holistically alongside the other circumstances detailed at the beginning of this brief, the overall discretionary-denial analysis is pushed overwhelmingly against denial.

**VII. ADDITIONAL CIRCUMSTANCES (FACTOR 6) MOVE THE
OVERALL WEIGHT OF THE *FINTIV* FACTORS
OVERWHELMINGLY AGAINST DISCRETIONARY DENIAL**

A. Factor 6

As described in Sections II-V, numerous other factors counsel against discretionary denial of the Petition, including a examination that led to material Office error (§II), that the '573 Patent is young and this challenge is a prompt post-grant review challenge (§III), the Petition is strong (§IV), and the litigation is complex with diverse technology (§V).

When viewed holistically, these factors, and the issues described in the *Fintiv* Factors, such as (i) uncertainty as to whether the ITC will reach the invalidity issue, (ii) the ITC's inability to preclude prior art invalidity litigation in District Court litigation, and (iii) the parallel District Court litigation remains stayed in its infancy and thus is far behind the Board schedule, the efficiency and integrity of the PGR process and the Congressional intent of the AIA is best served by instituting review. In particular, as the Director has recently explained, evidence

of material error by the Office can outweigh other factors. *Padagis US LLC v. Neuraelis, Inc.*, IPR2025-00464, Paper 12 (July 16, 2025). *See also, Microsoft Corp. v. Partec Cluster Competence Center GMBH*, IPR2025-00318, Paper No. 9 (June 12, 2025).

VIII. CONCLUSION

For the reasons set forth above, discretionary denial of the Petition is inappropriate. Institution of post-grant review is the appropriate result in view of the overall circumstances here.

Dated: August 21, 2025

Respectfully Submitted,

/ Alexander B. Stein /
Alexander B. Stein, Reg. No. 71,397

CERTIFICATE OF COMPLIANCE

The undersigned certifies that the foregoing **PETITIONER’S
OPPOSITION TO PATENT OWNER’S DISCRETIONARY DENIAL
BRIEF** contains 4763 words, exclusive of the parts exempted as provided in 37
C.F.R. § 42.24(a), and therefore complies with the type-volume limitations of 37
C.F.R. § 42.24(a).

Dated: August 21, 2025

Respectfully Submitted,

/ Alexander B. Stein /

Alexander B. Stein, Reg. No. 71,397

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), it is hereby certified that on August 21, 2025 an electronic copy of this PETITIONER'S OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF was served via email on Patent Owner's counsel of record in this proceeding:

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