

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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Milwaukee Electric Tool Corporation,

Petitioner,

v.

Klein Tools, Inc.,  
Patent Owner

**U.S. PATENT NO. 12,187,573**

Case No. PGR2025-00048

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**PATENT OWNER'S REPLY  
DISCRETIONARY DENIAL OF *POST-GRANT REVIEW***

## **TABLE OF CONTENTS**

|                                                                                                                 | <b><u>Page</u></b> |
|-----------------------------------------------------------------------------------------------------------------|--------------------|
| <b>I. There is Complete Overlap Between the Petition and ITC,<br/>Contrary to Petitioner’s Assertions .....</b> | <b>1</b>           |
| <b>II. The ITC is Well-Suited to Resolve Petitioner’s Validity<br/>Challenges Before Any FWD.....</b>           | <b>2</b>           |
| <b>III. An Early Challenge Does Not Outweigh Efficiencies And Fairness<br/>Concerns .....</b>                   | <b>3</b>           |
| <b>IV. There Was No Material Error By the PTO .....</b>                                                         | <b>4</b>           |
| <b>V. Petitioner’s Estoppel Argument Is Not Compelling.....</b>                                                 | <b>5</b>           |

## **TABLE OF AUTHORITIES**

### **Page(s)**

#### **Cases**

|                                                                                                              |      |
|--------------------------------------------------------------------------------------------------------------|------|
| <i>Bilstad v. Wakalopulos</i> ,<br>386 F.3d 1116 (Fed. Cir. 2004) .....                                      | 5    |
| <i>Klein Tools, Inc. v. Milwaukee Elec. Tool Corp.</i> ,<br>IPR2024-01400, Paper No. 22 (June 9, 2025) ..... | 3    |
| <i>Phison Elecs. Corp. v. Vervain LLC</i> ,<br>PGR2025-00010, Paper No. 14 (July 10, 2025) .....             | 3, 4 |
| <i>RingConn LLC v. Ouraring Inc.</i> ,<br>PGR2025-00018, Paper No. 11 (June 25, 2025) .....                  | 3    |
| <i>Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.</i> ,<br>IPR2025-00438, Paper 9 (July 9, 2025) .....   | 2    |
| <i>Tesla, Inc. v. Intell. Ventures II LLC</i> ,<br>IPR2025-00217, Paper 8 (May 27, 2025) .....               | 2    |

## **TABLE OF EXHIBITS**

| <b><u>Exhibit #</u></b> | <b><u>Description</u></b>                                                                                                                                                                                                                  |
|-------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2001                    | Complaint for Patent Infringement, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, February 4, 2025, Docket No. 1                                                                                        |
| 2002                    | Email between Counsel re Motion to Stay, dated between March 24-25, 2025                                                                                                                                                                   |
| 2003                    | Defendant’s Unopposed Motion to Stay Pursuant to 28 U.S.C. § 1659 and for an Extension of Time to Respond to the Complaint, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, March 27, 2025, Docket No.11 |
| 2004                    | Order Granting Motion to Stay, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, March 28, 2025, Docket No. 12                                                                                             |
| 2005                    | Order No. 7: Procedural Schedule, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, May 1, 2025                                                               |
| 2006                    | United States Patent and Trademark Office Memorandum re Interim Processes for PTAB Workload Management, March 26, 2025                                                                                                                     |
| 2007                    | First Amended Complaint under Section 337 of the Tariff Act of 1930, as Amended, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, May 5, 2025                |
| 2008                    | Excerpt of First Supplemental Domestic Industry Claim Chart for U.S. Patent No. 12,187,573, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442                  |
| 2009                    | Certified File History for United States Patent 11,713,209                                                                                                                                                                                 |

| <b><u>Exhibit #</u></b> | <b><u>Description</u></b>                                                                                                                                                                                                                                                           |
|-------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2010                    | United States Patent No. 9,787,159, Issued to Beyerl, October 10, 2017                                                                                                                                                                                                              |
| 2011                    | United States Patent No. 9,774,229, Issued to Mergener, et al., September 26, 2017                                                                                                                                                                                                  |
| 2012                    | United States Patent Application Publication No. 2024/0072311, Issued to Elfering, et al., February 29, 2024                                                                                                                                                                        |
| 2013                    | Klein Tools New Glow Fish Tape Perfect for Low Light Applications, December 17, 2020                                                                                                                                                                                                |
| 2014                    | Excerpts of Techtronic Industries Annual Report 2023                                                                                                                                                                                                                                |
| 2015                    | United States Patent and Trademark Office FAQs for Interim Processes for PTAB Workload Management                                                                                                                                                                                   |
| 2016                    | United States Patent and Trademark Office Memorandum re Guidance on USPTO’s recession of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, March 24, 2025                                                         |
| 2017                    | Respondent’s Opening Claim Construction Brief, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, June 30, 2025                                                                                         |
| 2018                    | Excerpts from Respondents’ Fifth Supplemental Objections and Responses to Complainant Klein Tools, Inc.’s First Set of Interrogatories, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, July 1, 2025 |
| 2019                    | Email from M. Doukas to Klein Tools Counsel, dated August 21, 2025                                                                                                                                                                                                                  |

**I. THERE IS COMPLETE OVERLAP BETWEEN THE PETITION AND ITC, CONTRARY TO PETITIONER’S ASSERTIONS**

Petitioner repeatedly asserts that the ITC investigation “does not have 100% overlap with the claims challenged in the ’573 Patent.” *See* Opp. at 14 (§7.1 (Factor 1)), 16 (§7.2 (Factor 2), 16-17 §7.3 (Factor 3)), and 17 (§7.4 (Factor 4)). This is false. There is complete overlap between the claims at issue in both proceedings. *See, e.g.*, Ex-2018 at 88 (“Claims 1-4, 6-12, and 14-18 are obvious under 35 U.S.C. § 103 in view of Hartranft combined with Bruin”); *id.* (“Claims 5 and 13 are obvious under 35 U.S.C. § 103 in view of Hartranft, Bruin, and Noonan”). *See, e.g.*, Paper 2 at 3 (“Claims 1-4, 6-12, and 14-18 are unpatentable ... in view of Hartranft and Bruin.”); *id.* (“Claims 5 and 13 are unpatentable ... in view of Hartranft, Bruin, and Noonan.”). This error infects Petitioner’s entire opposition and renders its *Fintiv* analysis fatally flawed.

Not only are the same claims at issue, but Petitioner is also asserting essentially the same grounds in the ITC.<sup>1</sup> *See* Ex-2018. Petitioner has not removed

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<sup>1</sup> Petitioner’s grounds were all included in its ITC contentions. Petitioner now suggests that it does not intend to pursue one ground at the ITC. Opp. at 14. But an email saying a party does not intend to address a combination in an opening expert report is not a stipulation, nor is it broad enough to eliminate duplication across

the overlap through any *Sotera* (or other) stipulation, demonstrating a complete disregard for any efficiency.

## **II. THE ITC IS WELL-SUITED TO RESOLVE PETITIONER’S VALIDITY CHALLENGES BEFORE ANY FWD**

Petitioner speculates that, “[w]hile 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.” Opp. at 15 (discussing *Fintiv* factor 2). But the ITC has not given any indication the investigation will be extended and neither party has requested an extension. No weight should be given to Petitioner’s speculation.

Further, neither case Petitioner cites supports its contention that the “Board is best suited to consider the patentability of ’573 Patent” due to the “complex[ity]” of the litigation. Opp. at 11. In *Shenzhen*, the petitioner challenged nine patents from six different families. *See Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 9 at 7 (July 9, 2025). Similarly, in *Tesla*, the parallel litigation involved eleven patents spanning nine different families. *See Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 8 at 5–7 (May 27, 2025). These cases are not analogous, as this dispute involves only four patents across two families. This distinction is even more pronounced given Petitioner asserts that the ’573 Patent and

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forums. *See* Ex-2019.

U.S. Patent No. 11,713,209 are “patentably indistinct.” Opp. at 12.

### **III. AN EARLY CHALLENGE DOES NOT OUTWEIGH EFFICIENCIES AND FAIRNESS CONCERNS**

A central factor in the discretionary denial analysis is the relative timing of the parallel ITC proceeding and the PTAB’s projected FWD. Here, the ITC trial is scheduled to conclude one year before the PTAB’s FWD, and the ITC’s investigation will be completed five months before the PTAB’s FWD deadline. *See* Patent Owner’s Discretionary Denial brief at 8–9. This timing weighs heavily in favor of discretionary denial, as recognized in recent decisions by the Director. For example, in *RingConn LLC v. Ouraring Inc.*, PGR2025-00018, Paper No. 11 (June 25, 2025) the Director granted discretionary denial where the ITC’s evidentiary hearing and initial determination would be completed well before the PTAB’s FWD. Similarly, in an IPR involving the same parties here, the Director reversed institution where the ITC was scheduled to issue a final determination six months before the PTAB’s FWD, finding that the advanced stage and timing of the ITC proceeding strongly favored denial. *Klein Tools, Inc. v. Milwaukee Elec. Tool Corp.*, IPR2024-01400, Paper No. 22 at 2-3 (June 9, 2025).

In addition to efficiency, discretionary denial is appropriate to avoid duplicative proceedings, conserve resources, and prevent inconsistent outcomes regardless of whether the proceeding is an IPR or PGR. *See Phison Elecs. Corp. v.*

*Vervain LLC*, PGR2025-00010, Paper No. 14 (July 10, 2025). Further, the “absence of [] a stipulation tips the balance in favor of discretionary denial.” *Id.* at 3. As noted above, Petitioner failed to execute any *Sotera* (or other) stipulation here. Accordingly, while the perceived lack of “settled expectations” is a factor, it does not outweigh the efficiency concerns present here.

#### **IV. THERE WAS NO MATERIAL ERROR BY THE PTO**

Petitioner contends that the ’573 Patent fails to provide written description support for claim 1’s “sidewalls of the case” being “configured to allow the luminescent material to be energized” and that it was material error for the Examiner “to fail to specifically consider the 112(a) issues and discuss those issues on the record.” *Opp.* at 3, 5. According to PTO examination procedure, the Examiner evaluated the pending patent claims for compliance with § 112, as is required in all examinations, and therefore necessarily determined that the claims as written—including the limitation “configured to allow the luminescent material to be energized”—satisfied the requirements for patentability. *See* Paper 10 at 26-29. In allowing the ’573 claims, the Examiner did not commit a material error.

Petitioner argues that “neither the original specification of the ’573 Patent nor its parent application ... describes ... any way to energize the luminescent material other than a [] portion of the case [being transparent].” Paper 2 at 94-99. In so doing, Petitioner concedes the specification discloses transparent sidewalls that *are*

*configured* to allow the luminescent material to be energized, which is all that is necessary to support the challenged claims. *See, e.g., Bilstad v. Wakalopulos*, 386 F.3d 1116, 1124 (Fed. Cir. 2004) (“disclosure of a species may be sufficient written description support for a later claimed genus including that species”). In any event, the claims have sufficient § 112 support, as explained in Patent Owner’s Preliminary Response. Paper 10 at 27-29.

## **V. PETITIONER’S ESTOPPEL ARGUMENT IS NOT COMPELLING**

Petitioner’s argument that institution is warranted because Patent Owner continues to prosecute continuation applications with allegedly patentably-indistinct claims is not a basis for instituting trial. *See* Opp. at 12. Such a rationale would apply to nearly every multi-patent portfolio, as it is common practice to pursue continuations and related applications. If accepted, Petitioner’s reasoning would undermine the Director’s discretion and lead to institution in virtually all cases involving patent families with open applications, regardless of the circumstances. Furthermore, under § 42.73(d), patent owner estoppel only attaches once a claim is finally refused or canceled in a PGR, which does not occur until a PGR certificate issues per 37 C.F.R. § 42.80. This finality is only reached after appeals are exhausted—a lengthy, uncertain, and speculative process. The mere possibility of future estoppel does not justify institution where the *Fintiv* factors, including the advanced status of the ITC proceeding, otherwise support discretionary denial.

Date: September 2, 2025

Respectfully submitted,

*/s/ W. Todd Baker*

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a complete copy of the foregoing document was served on September 2, 2025 on counsel of record for the Petitioner via email to the following addresses:

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