

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Milwaukee Electric Tool Corporation,

Petitioner,

v.

Klein Tools, Inc.,
Patent Owner

U.S. PATENT NO. 12,268,265

Case No. PGR2025-00080

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

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<u>Exhibit</u>	<u>Description</u>
2001	Order No. 13: Rescheduling Evidentiary Hearing, <i>In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof</i> , Investigation No. 337-TA-1442, November 17, 2025
2002	Order No. 16: Amended Procedural Schedule, <i>In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof</i> , Investigation No. 337-TA-1442, November 20, 2025
2003	United States Patent and Trademark Office Memorandum re Interim Processes for PTAB Workload Management, March 26, 2025
2004	Excerpt from Klein Tools Inc.’ Pre Hearing Brief, <i>In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof</i> , Investigation No. 337-TA-1442, November 17, 2025 (Public Version)
2005	Excerpt from Second Supplemental Hard Hat Domestic Industry Claim Chart for U.S. Patent No. 12,268.265, <i>In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof</i> , Investigation No. 337-TA-1442
2006	Excerpt from Milwaukee Electric Tool Corporations First Supplemental Objections and Responses to Klein Tools Inc.’s First Set of Interrogatories (Nos. 1-18) <i>In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof</i> , Investigation No. 337-TA-1442, July 1, 2025
2007	Transcript of Markman Hearing, <i>In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof</i> , Investigation No. 337-TA-1442, July 23, 2025
2008	Techtronic Industries Group’s Annual Report 2024

<u>Exhibit</u>	<u>Description</u>
2009	Milwaukee Electronic Tools Corporation’s Power of Attorney, <i>Milwaukee Electronic Tool Corporation, et al. v. Irwin Industrial Tool Company</i> , IPR2015-01461, July 19, 2016
2010	Techtronic Industries Group’s Power of Attorney, <i>Milwaukee Electronic Tool Corporation, et al. v. Irwin Industrial Tool Company</i> , IPR2015-01461, August 22, 2016
2011	Milwaukee Electronic Tools Corporation’s Power of Attorney, <i>Milwaukee Electronic Tool Corporation, et al. v. Irwin Industrial Tool Company</i> , IPR2015-01462, July 19, 2016
2012	Techtronic Industries Group’s Power of Attorney, <i>Milwaukee Electronic Tool Corporation, et al. v. Irwin Industrial Tool Company</i> , IPR2015-01462, August 22, 2016
2013	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

Petitioner requests post-grant review of U.S. Patent No. 12,268,265 (“’265 Patent”) even though (1) a parallel ITC investigation will have completed its evidentiary hearing on identical claims and effectively identical grounds on the day Petitioner files its response to this brief (if any) and (2) the Director has already discretionarily denied institution of three earlier-filed petitions in view of this same parallel ITC investigation, including a petition for inter partes review (“IPR”) of parent patent, U.S. Patent No. 11,452,327 (“’327 Patent”). *Milwaukee Elec. Tool Corp. v. Klein Tools, Inc.*, IPR2025-00724, IPR2025-00892, PGR2025-00048, Paper 14 (P.T.A.B. Sep. 12, 2025) (collectively referred to as “*Milwaukee*”). The parallel ITC Investigation is scheduled to be complete more than **six months** before the PTAB would issue its final written decision in this post-grant review if instituted.

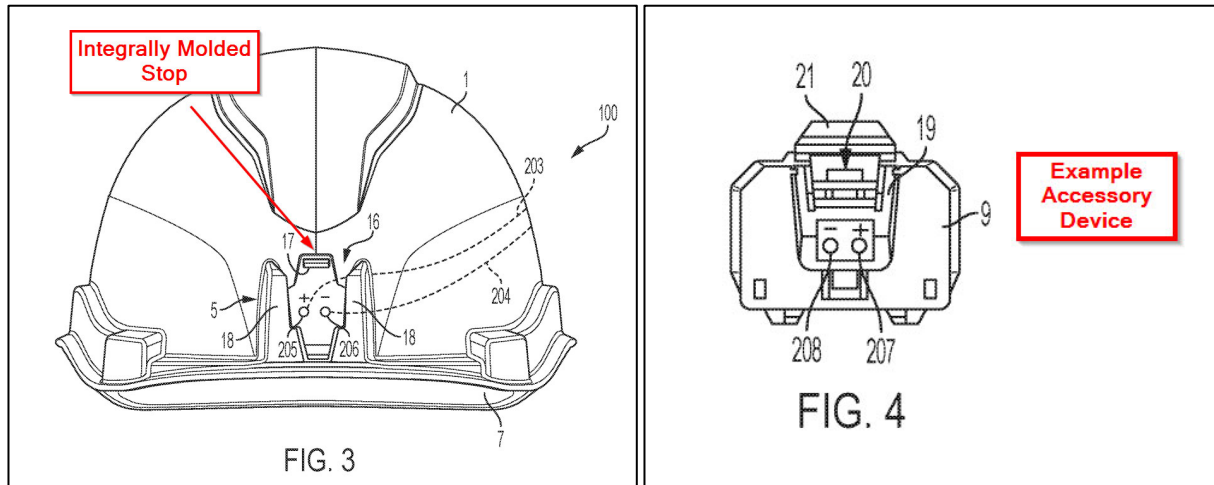
Patent Owner respectfully requests that the Director exercise his discretion and deny institution of this post grant review under 35 U.S.C. §§ 324(a) and 325(d).

I. BACKGROUND

A. The ’265 Patent

The ’265 Patent is related to safety helmets, commonly referred to as “hard hats.” EX-1019 at 1:15–18. The invention of the ’265 Patent relates to, among other things, safety helmet systems with an outer shell including a brim, a front receptacle, a rear receptacle, and accessory device(s) that are designed to be releasably mountable onto at least a portion of each of the front and rear receptacles. The

preferred embodiment is depicted below:



Id. at Fig. 3 (annotated); Fig. 4 (annotated).

B. Prosecution History of the '265 and '327 Patents

The sole independent claim of the '265 Patent, originally presented claim 23 (which depended from claim 21) was rejected for nonstatutory double patenting in view of the '327 Patent. *See* EX-1020 at 139–141. Thereafter, the applicant amended claim 23 to incorporate the limitations of originally presented claim 21, and filed a statutory terminal disclaimer to address the double patenting rejection. *Id.* at 150, 159. The Office then permitted the patent application to issue without any further rejections. *See id.* at 167–169.

Although the examiner did not enter any 35 U.S.C. § 112 rejections during prosecution of the '265 Patent, the same examiner entered written description rejections during examination of the '327 Patent. *See, e.g.,* EX-1004 at 122–25. Specifically, the examiner initially asserted that there was no support in the

originally filed disclosure for the “protruding nub being a unitary feature of the outer shell” and the “front receptacle being integral with the outer shell” limitations added during prosecution. *Id.* at 123–24. But after an interview with the applicant, considering the applicant’s response, and reviewing a Rule 1.132 declaration, the examiner withdrew the § 112 rejection and the ’327 Patent issued on May 12, 2022.

C. The Parallel, Fast-Moving ITC Investigation

Patent Owner and Petitioner are parties to a parallel proceeding concerning the ’265 Patent: ITC Investigation No. 337-TA-1442 (the “Parallel ITC Investigation”). *See* EX-1022. The Parallel ITC Investigation is nearly complete. The evidentiary hearing is scheduled to complete on the day Petitioner files its response (January 8, 2026). EX-2001. The Chief ALJ is slated to release his final initial determination on May 21, 2026, and the Commission is scheduled to complete its investigation by September 21, 2026. EX-2002 at 1.

D. This PGR’s Schedule

The Preliminary Patent Owner Response is due on January 8, 2026. *See* Paper 3 at 1–2. The Director’s decision on whether to institute post-grant review will therefore be due on April 8, 2026—just weeks before the Chief ALJ is set to complete his initial determination in the Parallel ITC Investigation. *See* EX-2006 at 1. Assuming post-grant review is instituted (it should not be), the Board’s final written decision would be due on April 8, 2027—*six whole months after* the

completion of the Parallel ITC Investigation. *See id.*

Additionally, Petitioner has an unexplained delay of 5 months as Petitioner acknowledged its awareness of the '265 Patent on April 18, 2025 (*i.e.*, the filing date of the '327 petition), Patent Owner asserted the '265 Patent on May 5, 2025, and yet Petitioner did not file until September 30, 2025.

II. DISCRETIONARY DENIAL CONSIDERATIONS

On March 26, 2025, then Acting Director Coke Morgan Stewart issued a memorandum titled “Interim Processes for PTAB Workload Management” (the “March 26 Memo”). The March 26 Memo explains that for requests for discretionary denials the PTAB will consider *Fintiv* factors and other factors, such as “[t]he extent of the petition’s reliance on expert testimony” and “[s]ettled expectations of the parties.” *See* EX-2003 at 2.

III. ARGUMENT

A. All *Fintiv* Factors Weigh Strongly in Favor of Denial

1. Petitioner Has Not Requested a Stay from the ITC, and, in any event, the ITC Would Not Grant One

Petitioner has not requested a stay in the Parallel ITC Investigation. Even if the Director decided to institute trial on the Petition (April 8, 2026), it is highly unlikely that the ITC would issue a stay at that time because the evidentiary hearing would already be complete (January 8, 2026), and the ITC investigation would be just over five months away being entirely complete (September 21, 2026). EX-2001;

EX-2002 at 1. It is also extremely unlikely that an ITC proceeding will be stayed pending PGR because the ITC has a statutory mandate under 19 U.S.C. § 1337(b)(1) to conclude its investigation at “the earliest practicable time” and has refused requests, in essentially all instances, to stay investigations pending instituted PTO review. *See, e.g., In the Matter of Certain Automated Storage and Retrieval Systems, Robots, and Components Thereof*, Investigation No. 337-TA-1228, Order No. 6 (U.S.I.T.C. Mar. 9, 2021); *In the Matter of Certain Laser-Driven Light Sources, Subsystems Containing Laser-Driven Light Sources, and Products Containing Same*, Investigation No. 337-TA-983, Order No. 8 (U.S.I.T.C. Mar. 3, 2016).

The first factor thus weighs in favor of denying institution. *See Eunsung Global Corp. v. Hydrafacial LLC*, IPR2024-01491, Paper 17 at 11 (P.T.A.B. Apr. 11, 2025) (finding Factor 1 weighs in favor of discretionary denial when there is no evidence that ITC proceedings will be stayed despite stay of the parallel district court litigation); *Milwaukee Elec. Tool Corp. v. Klein Tools, Inc.*, IPR2025-00724, IPR2025-00892, PGR2025-00048, Paper 14 at 3 (P.T.A.B. Sep. 12, 2025) (denying institution where “there is insufficient evidence that the ITC is likely to stay its proceeding even if the Board were to institute trial”).

2. *Trial Will Be Complete Before the Institution Decision and the ITC’s Completion of Investigation is Six Months Before the PTAB’s FWD*

The ITC trial is scheduled to complete on the same day that Petitioner files its

response brief (January 8, 2026). *See* EX-2001. This situation thus presents an even stronger case for denial than did PGR2025-00048, where the Acting Director denied institution, in part, because “it is unlikely that a final written decision in these proceedings will issue before the ITC investigation is completed, resulting in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.” *Milwaukee Elec. Tool Corp. v. Klein Tools, Inc.*, IPR2025-00724, IPR2025-00892, PGR2025-00048, Paper 14 at 3 (P.T.A.B. Sep. 12, 2025).

Further, the six-month gap between the conclusion of the parallel proceeding (here, the ITC investigation, which is scheduled to finish on September 21, 2026) and the Board’s projected final written decision (“FWD”) date (April 8, 2027) is larger than in *Fintiv*, where this factor was found to weigh in favor of denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (P.T.A.B. May 13, 2020) (the district court trial was scheduled two months before a projected FWD). The six-month gap is also larger than the gap between the conclusion of an ITC investigation and the Board’s FWD in an IPR where the Board found that this factor favored denial. *Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc.*, IPR2020-00919, Paper 9 at 9 (P.T.A.B. Nov. 16, 2020) (considering a two-month gap). The second *Fintiv* factor therefore weighs strongly in favor of denial of institution.

3. *All Parties and the ITC Have Invested Heavily in the Parallel ITC Investigation*

The parties’ and the Commission’s investment in the Parallel ITC Investigation is substantial, and therefore this factor weighs heavily in favor of discretionary denial. The substantial work and investment by the parties and the Commission before the Director’s institution determination deadline is demonstrated by the following milestones that will be completed by April 8, 2026: all fact discovery, all expert discovery, summary determination, the evidentiary hearing (*i.e.*, trial), and all post-trial briefing. *See* EX-2002.

Under less extreme circumstances—where “fact discovery was complete, expert discovery was already underway, final invalidity and infringement contentions had been exchanged, and the district court had issued a *Markman* order” and “[n]early all substantive work ***other than trial itself*** will be complete by the time of th[e] institution decision date”—the Director held that the parties had “invested” “substantial time and effort” and that this “strongly favors discretionary denial.” *See Neogenomics Lab ’ys, Inc. v. Natera, Inc.*, IPR2025-00455, Paper 13 at 2 (P.T.A.B. June 12, 2025) (emphasis supplied, brackets in original); *see also Milwaukee Elec. Tool Corp. v. Klein Tools, Inc.*, IPR2025-00724, IPR2025-00892, PGR2025-00048, Paper 14 at 3 (P.T.A.B. Sep. 12, 2025) (“Furthermore, there has been meaningful investment in the parallel proceeding by the parties. ... [T]he ITC held a *Markman* hearing, fact discovery is complete, and expert discovery will have completed before a decision on institution is due.”).

The third *Fintiv* factor thus weighs in favor of denying institution. *See Eunsung*, Paper 17 at 12–13 (finding Factor 3 weighs in favor of discretionary denial where the parties have made substantial investments in view of trial scheduled before the institution decision).

4. *All of the Issues Raised by the PGR Are Present in the Parallel ITC Investigation*

Petitioner has raised in the Parallel ITC Investigation each and all of the grounds it raised here, as shown in the table below. Further, Petitioner has not filed any *Sotera* (or other) stipulation and duplication is guaranteed given trial in the ITC will be completed on the same claims and grounds.

PGR Ground	ITC Ground
Written Description & Enablement ¹ (“a stop...wherein the stop is integrally	Written Description (“protruding member,” “stop,” “common material,”

¹ To the extent Petitioner argues that the Parallel ITC Proceeding does not include all grounds raised by the Petition because the Parallel ITC Proceeding does not include an “enablement” argument, Petitioner’s argument is belied by its own decision to include “written description” together with “enablement” in Ground 1—indicating that they are so similar that they should not be treated as distinct grounds. *See* Pet. at 12–14.

PGR Ground	ITC Ground
molded,” and “the outer shell, the front receptacle [which includes the stop], and the rear receptacle [also includes the stop] are formed from a common material”)	and “integrally molded” allegedly lack written description)
Written Description (“pairs of external slots”)	Written Description (“first pair / second pair of external slots”)
§ 103 (Yan + Daley)	§ 103 (Yan + Daley)
§ 103 (Yan + Daley + Kiessler)	§ 103 (Yan + Daley + Kiessler)
§ 103 (Yan + Nesbitt)	§ 103 (Yan + Nesbitt)
§ 102 (Klein News Release)	§ 102 (Klein News Release)

See EX-2004 (pre-hearing brief listing all grounds); *Fintiv*, IPR2020-00019, Paper 11 at 12 (P.T.A.B. Mar. 20, 2020) (“[I]f the petition includes the same ***or substantially the same*** claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” (emphasis supplied)). Further, all the claims at issue in the ITC investigation are at issue here. See Pet. at 1; EX-2005 at 1. Accordingly, *Fintiv* Factor 4 weighs strongly in favor of denying institution.

5. *The Parties Are Identical*

The same parties involved in this proceeding—Milwaukee Electric Tool

Corporation and Klein Tools, Inc.—are also involved in the Parallel ITC Investigation. EX-1022 at 2; *see Fintiv*, IPR2020-00019, Paper 15 at 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”). *Fintiv* Factor 5 strongly favors denial.

6. *The Petitioner’s Patentability Challenge is Weak*

As will be detailed in the forthcoming Preliminary Response, each of the patentability grounds presented in the Petition is unpersuasive. Below, the Patent Owner explains why three exemplary Grounds are weak (all six will be addressed in the Preliminary Response), and why the Petition should be denied.

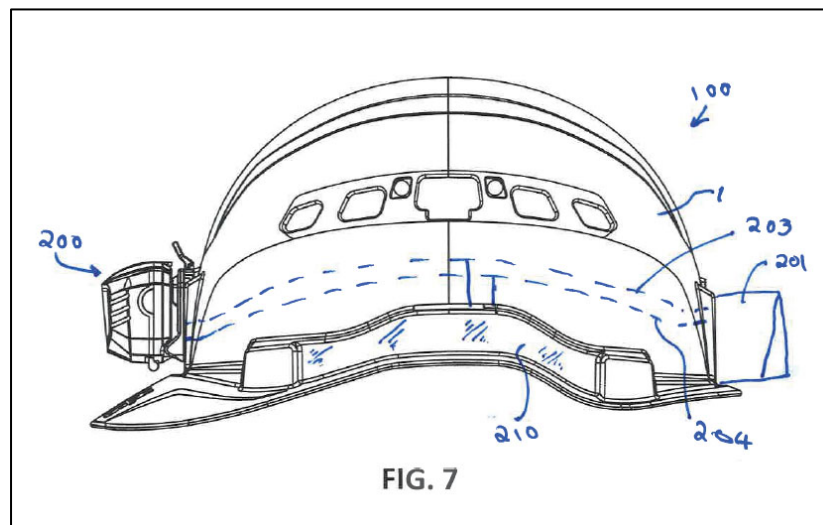
a. Written Description (Grounds 1 and 2)

Petitioner’s argument that the limitations “a stop...wherein the stop is integrally molded” (Ground 1), “the outer shell, the front receptacle [which includes the stop], and the rear receptacle [also includes the stop] are formed from a common material,” (Ground 1), and “first [and second] pair of external slots” (Ground 2) lack written description support is weak. “[I]n order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.” *Pozen Inc. v. Par Pharm., Inc.*, 696 F.3d 1151, 1167 (Fed. Cir. 2012). Rather, the specification must “reasonably convey[] to those skilled in the art that the inventor had possession of the claimed

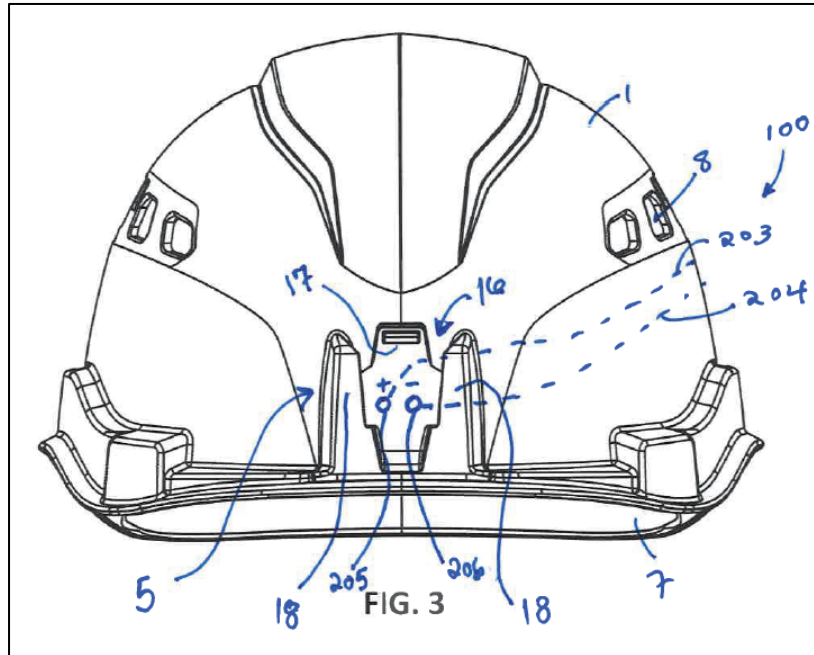
subject matter as of the filing date.” *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 682 (Fed. Cir. 2015).

To start, Petitioner ignores that the PTO already considered two out of three of these § 112 grounds during the prosecution of the '327 Patent and determined sufficient support was included in the specification. The '327 Patent and '265 Patent share a common specification, and Petitioner provides no explanation for why the examiner supposedly erred.

Petitioner also ignores that figures and images from applications are part of the specification and provide written description for “first [and second] pair of external slots.” For example, Figure 7 of U.S. Provisional Application No. 62/645,491 depicts a front and rear mounting point:



EX-1006 at Fig. 7. And Fig. 3 of the same shows that each mount contains a pair of external slots:



Id. at Fig. 3.

The specification, including the images above, makes clear that the helmet provides at least a first and second pair of external slots—one pair at the front and one pair at the rear—each capable of receiving and mounting accessories.

b. Klein News Release (Ground 6)

Petitioner’s argument that the Klein News Release is prior art falls with its written description argument. In other words, if there is written description for the claims, then 35 U.S.C. § 120 is satisfied and the Klein News Release is not prior art, thus sinking Ground 6 too. Petitioner’s anticipation argument is also contingent on a premise Petitioner disputes, *i.e.*, that the products described in the Klein News Release practice the claims of the ’265 Patent. Petitioner characterizes the Klein News Release as “Patent Owner’s own news release describing its ***allegedly*** patent-

practicing helmet” (Pet. at 3 (emphasis added)), but Petitioner disputes this allegation in the Parallel ITC Investigation. EX-2006 at 94 (“*If* ... the DI Products satisfy the technical prong [(i.e., practice one or more claims of the ’265 Patent)] as Klein contends, then each of the claims of the ’265 Patent is invalid under 35 U.S.C. § 102.” (emphasis supplied)). Moreover, during the claim construction hearing, Petitioner argued that “Klein’s helmets actually include a recess that extends inwardly toward the interior of the helmet and does not protrude or extend out at all.” EX-2007 (Hr’g Tr.) at 144:15-24. Indeed, Petitioner fails to allege that the Klein News Release discloses a stop comprising “a protruding member,” despite that element being required by every one of the Challenged Claims. Petitioner cannot possibly meet its burden on a Ground that it simultaneously disputes at the ITC.

7. *This Case Presents More Compelling Facts Than Milwaukee*

As mentioned above, in *Milwaukee*, which presented circumstances less compelling than the ones present here, the Acting Director exercised her discretion to deny institution of two requests for *inter partes* review and one request for post grant review in view of the same Parallel ITC Investigation. *Milwaukee Elec. Tool Corp. v. Klein Tools, Inc.*, IPR2025-00724, IPR2025-00892, PGR2025-00048, Paper 14 at 2-3 (P.T.A.B. Sep. 12, 2025), concluding that:

[I]t is unlikely that a final written decision in these proceedings will issue before the ITC investigation is completed, resulting in significant

duplication of effort, additional expense for the parties, and a risk of inconsistent decisions. Additionally, there is insufficient evidence that the ITC is likely to stay its proceeding even if the Board were to institute trial. ...Furthermore, there has been meaningful investment in the parallel proceeding by the parties.... For example, the ITC held a *Markman* hearing, fact discovery is complete, and expert discovery will have completed before a decision on institution is due.

Id. at 3. Indeed, the Acting Director noted that the importance of an early challenge did not outweigh all the facts above. *See id.* at 2 (noting the request for post-grant review counsels against discretionary denial). The same should be true here. Indeed, the only meaningful difference between this case and *Milwaukee* is that in *Milwaukee*, the Director’s deadline to decide on institution fell on the last day of the Parallel ITC Investigation trial—here it falls three months later. *See id.* Thus, this request for discretionary denial is stronger than the request in *Milwaukee*.

B. Additional Factors Collectively Weigh Against Institution

1. Milwaukee’s Failure to Identify Techtronic Industries as an RPI Weighs in Favor of Denial

Under 35 U.S.C. § 322(a)(2), a petition for PGR may be considered “only if—the petition identifies all real parties in interest.” The PTAB’s Trial Practice Guide and controlling case law make clear that the RPI inquiry is “highly fact-dependent,”

focusing on whether a non-named party “exercised or could have exercised control over a party’s participation in a proceeding,” as well as whether the non-party funded or directed the proceeding, or otherwise had a significant relationship to the petition or the petitioner. *See Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 at 14–15 (P.T.A.B., August 18, 2015) (precedential).

The PTAB’s decision in *Corning* is instructive. There, the Board terminated the IPRs because the petitioner failed to name its parent and a closely related affiliate as RPIs, finding that both entities had the opportunity to control the IPR proceedings, and that the parent funded the proceedings. The Board emphasized that the lines of corporate separation were “sufficiently blurred” such that insiders and outsiders could not easily distinguish where one entity ended and another began.

Applying the *Corning* analysis to Milwaukee Tool and its parent, Techtronic Industries Co. Ltd. (“TTI”), the following facts support the conclusion that TTI should have been identified as an RPI:

- Milwaukee Tool identified TTI as an RPI in IPR2015-01461 and IPR2015-01462. Notably, in the parallel district court proceeding, *Irwin Industrial Tool Company v. Milwaukee Electric Tool Corporation*, No. 3:15-cv-30005 (D. Mass.), TTI was not a named party. Nevertheless, Milwaukee Tool identified TTI as an RPI and as a petitioner in the IPRs.
- TTI operates as a multinational group headquartered in Hong Kong with a

portfolio of groups (*i.e.*, subsidiaries) including Milwaukee Tool, Ryobi, and Hoover. EX-2008 at 9.

- Steven Richman has served as CEO of TTI since May 2024. Prior to his promotion to CEO, Richman served as Senior Group President of Milwaukee Tool. Milwaukee Tool’s current leadership answer directly to Steven Richman. EX-2008 at 60, 69 (the roles of the CEO comprise “direct[ing] and monitor[ing] the global management team in the Group’s daily operations”).
- TTI, as the parent company, is likely to fund or reimburse significant litigation and patent-related expenses for Milwaukee Tool. TTI’s 2024 financial results reflect “[t]otal operating expenses for the year amounted to US\$4,642 million,” which are reported on a consolidated basis. These expenses include TTI’s “strategic investments in new products and technologies.” EX-2008 at 56.
- TTI’s legal and intellectual property departments are responsible for managing and coordinating global IP strategy, including litigation and post-grant proceedings, for all subsidiaries, including Milwaukee Tool. EXS-2009–2012.
- According to TTI’s 2024 annual report, Milwaukee Tool is not operationally independent but “[o]ur flagship MILWAUKEE business,” which “has continued to maintain its dominant market leadership position” and is described as being “at the forefront of TTI’s professional tool portfolio.” *See* EX-2008 at 1, 4, 6.
- TTI, as the parent, is the primary economic beneficiary of any successful

challenge to a competitor’s patent by Milwaukee Tool. Again, TTI’s financial results are reported on a consolidated basis, with “[p]rofit attributable to Owners of the Company” and “[t]he Group’s revenue for the year amounted to US\$14.6 billion,” reflecting that all economic gains and losses from Milwaukee Tool’s activities—including any successful challenge to a competitor’s patent—are “attributable to Owners of the Company.” *See* EX-2008 at 56.

A petition that fails to name all RPIs is “incomplete and... may not be considered,” and any attempt to correct the petition would result in a new filing date, potentially triggering time bars under 35 U.S.C. § 315(b). *Corning*, IPR2014-00440, Paper 68 at 14–15. Even if the Director were to determine that the RPI issue is not dispositive under 35 U.S.C. § 315(b)—since the one-year bar date has not yet passed—the Director retains broad discretionary authority to deny institution under 35 U.S.C. § 314(a) and related regulations. The failure to name TTI—a multinational group headquartered in Hong Kong—as an RPI undermines the integrity of the proceeding, frustrates the statutory purpose of transparency, and prejudices the Patent Owner’s ability to assess estoppel, conflicts, and time bars.

2. *The Relatively Early Challenge of the ’265 Patent is not a Significant Factor*

Consistent with the Director’s approach in *NeoGenomics Laboratories, Inc. v. Natera, Inc.*, IPR2025-00455, Paper 13 (P.T.A.B. June 12, 2025) (denying a

petition challenging U.S. Patent No. 11,319,596, issued May 3, 2022), the relatively recent issuance of U.S. Patent No. 12,268,265, April 8, 2025, does not constitute a significant factor in the discretionary denial analysis where as here: (i) trial in the parallel proceeding will occur well before the PTAB's final written decision; (ii) the parties and the tribunal have already made substantial investments in the parallel proceeding; (iii) there is no indication that the parallel proceeding will be stayed in favor of the PGR; and (iv) Milwaukee was on notice of the application leading to the '265 Patent since at least March 18, 2025, yet delayed in filing this PGR until September 30, 2025.

In such circumstances, the efficiency, avoidance of duplicative proceedings, and respect for the investment in the parallel forum are paramount. The recency of the patent, standing alone, does not outweigh these considerations and should not preclude discretionary denial of institution. *See Milwaukee Elec. Tool Corp. v. Klein Tools, Inc.*, IPR2025-00724, IPR2025-00892, PGR2025-00048, Paper 14 at 2-3 (P.T.A.B. Sep. 12, 2025) (discretionarily denying institution of post-grant review).

3. *That an ITC Invalidity Ruling Would Not Bind the Office or the Courts Does Not Weigh Against Denying Institution*

As *Fintiv* noted, “as a practical matter, it is difficult to maintain a district court proceeding on patent claims determined to be invalid at the ITC.” *Fintiv*, IPR2020-00019, Paper 11 at 9. Despite awareness of the well-known, non-binding nature of

ITC invalidity rulings, the Board has found that a parallel ITC case can be the basis for discretionary denial. *Id.*; *see also* EX-2013 (March 24, 2025 memorandum from Chief Judge Boalick); *Milwaukee Elec. Tool Corp. v. Klein Tools, Inc.*, IPR2025-00724, IPR2025-00892, PGR2025-00048, Paper 14 at 2-3 (P.T.A.B. Sep. 12, 2025) (discretionarily denying institution of post-grant review in view of ITC investigation); *Intel Corp. v. Koninklijke Philips N.V.*, IPR2021-00328, Paper 16 at 6–7 (P.T.A.B. Mar. 29, 2022) (“non-binding effect of the ITC’s decision” did not “turn[]” *Fintiv* factor 6 to “*strongly* weighing” in favor of institution) (emphasis in original); *supra* § III (collecting cases where institution was discretionarily denied based on a parallel ITC investigation).

4. *The Settled Expectations Factor Should Tip in Favor of Denial of Institution*

The March 26 Memo states that one factor for consideration is “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” EX-2003 at 2. However, the Acting Director held that this factor favors denial where a Petitioner challenges a recently issued patent (2024) but “has not offered a stipulation to address concerns of duplicative efforts and potentially conflicting decisions in view of a significantly earlier trial date in a co-pending case that is unlikely to be stayed.” *Phison Electronics Corporation v. Vervain, LLC*, PGR2025-00011, Paper 14 at 3 (P.T.A.B. Jul. 10, 2025). The same circumstances are present

here. Accordingly, as in *Phison*, this factor should “tip[] ... in favor of discretionary denial.” *See id.*

Further, as described above, Milwaukee has been on notice of the ’265 Patent and Klein Tools’ intent to assert the ’265 Patent since before it issued and has been prepared to file this request for post-grant review since at least a month before Milwaukee actually filed the Petition. *See Milwaukee Elec. Tool Corp. v. Klein Tools, Inc.*, IPR2025-00724, Paper 13, at n. 2 (P.T.A.B. Sep. 5, 2025) (Milwaukee stating “PGR2025-00080 ... will challenge the ’265 patent”).

IV. CONCLUSION

It would be a highly inefficient waste of the limited resources of the Board and the parties to institute a trial that would not be completed until well after the Parallel ITC Investigation has ended. Moreover, many of Petitioner’s arguments were already considered and rejected by the Office, but Petitioner has not established that the Office erred in any material way. Institution should be denied under 35 U.S.C. §§ 314(a) and 325(d), *Fintiv*, *Advanced Bionics*, and the March 26 Memo.²

Date: December 8, 2025

Respectfully submitted,

/s/ W. Todd Baker

² Patent Owner notes that Petitioner has filed a purported Search Disclosure Declaration (“SDD”). This should not tip the scales against discretionary denial.

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CERTIFICATION UNDER 37 C.F.R. § 42.24(D)

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Request for Discretionary Denial of *Post-Grant Review* totals 20 pages as counted by Microsoft Word 365, which is the limit provided by the Director's Discretionary Process, exclusive of caption page, the table of contents, the table of authorities, the certificates of service and of word count, and the table of exhibits.

Date: December 8, 2025

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Case No. PGR2025-00080
U.S. Patent No. 12,268,265

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a complete copy of the foregoing document was served on December 8, 2025 on counsel of record for the Petitioner via email to the following addresses:

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