

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. 12,268,265
Case No. PGR2025-00080

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

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Table of Exhibits

New Exhibits Added in Italics

Exhibit	Description
Ex-1001	U.S. Patent No. 11,452,327 (“’327 Patent”)
Ex-1002	Declaration of Expert Dr. Per Reinhall
Ex-1003	<i>Curriculum Vitae</i> of Expert Dr. Per Reinhall
Ex-1004	Prosecution History of the application that led to the ‘327 Patent
Ex-1005	U.S. Provisional Application No. 62/622,472 (“’472 Provisional”)
Ex-1006	U.S. Provisional Application No. 62/645,491 (“’491 Provisional”)
Ex-1007	U.S. Patent Application No. 16/246,935 as filed January 14, 2019 (“’935 Application”)
Ex-1008	Comparison of the ’327 Patent and the ’935 Application
Ex-1009	Chinese Utility Model App. No. 201120014896.0 to Yan (“Yan-CN”)
Ex-1010	Klein Tools “Klein Tools’® New Hard Hats Designed for Pros—Safety, Comfort and Fit,” July 23, 2019 (“Klein News Release”)
Ex-1011	Certified Translation of Chinese Utility Model App. No. 201120014896.0 to Yan (“Yan”)
Ex-1012	U.S. Patent No. 9,993,043 to Daley (“Daley”)
Ex-1013	U.S. Patent No. 4,304,009 to Nesbitt et al. (“Nesbitt”)
Ex-1014	German Utility Model App. No. 2020-06007009 to Kiessler (“Kiessler-DE”)
Ex-1015	Certified Translation of German Utility Model App. No. 2020-06007009 to Kiessler (“Kiessler”)

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	Webpage printout at https://www.osha.gov/Publications/osh3151.pdf (Personal Protective Equipment) OSHA 3151-12R 2004.
Ex-1018	Internet Archive Declaration with exhibit
Ex-1019	U.S. Patent No. 12,268,265 (“’265 Patent”)
Ex-1020	Prosecution History of U.S. Patent Application 17/856,628 (“’628 Application”) that led to the ’265 Patent
Ex-1021	’628 Application as filed July 1, 2022
Ex-1022	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
Ex-1023	Exhibit 64 (Patent Owner’s “Exemplary Domestic Industry Claim Chart for U.S. Patent No. 12,268,265”) to the First Amended complaint, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, May 5, 2025
Ex-1024	<i>U.S. Patent Application No. 19/074,885 (“’885 Application”) as filed March 10, 2025</i>
Ex-1025	<i>“The U.S. International Trade Commission is open and has resumed operations,” November 12, 2025,</i> https://www.usitc.gov/press_room/2025_lapse_of_appropriations#

	<u>:~:text=It%20may%20take%20a%20week,Monday%2C%20November%2017%2C%202025.</u>
Ex-1026	<i>“Trump signs spending bill to end longest shutdown in US History,” November 12, 2025,</i> <u>https://www.bbc.com/news/articles/c891nvwvg2zo</u>
Ex-1027	<i>“ITC, Other IP Agencies Up and Running as Shutdown Ends,” November 13, 2025,</i> <u>https://www.law360.com/articles/2410817/itc-other-ip-agencies-up-and-running-as-shutdown-ends</u>
Ex-1028	<i>Order granting stay in the parallel district court case pending resolution of the ITC Investigation, Case No. 1:25-cv-00143-JLH, Dkt. No. 12</i>
Ex-1029	<i>INV. No. 337-TA-1409, Order No. 22</i>
Ex-1030	<i>INV. No. 337-TA-1409, Order No. 23</i>
Ex-1031	<i>INV. No. 337-TA-1409, December 16, 2025 Notice extending target date due to shutdown of the Federal Government</i>
Ex-1032	<i>“Senators brace for another possible shutdown in January” December 15, 2025, The Hill,</i> <u>https://thehill.com/homenews/senate/5647112-republicans-block-subsidy-extension/</u>
Ex-1033	<i>“A divided Congress returns for high-stakes battles over health care, federal spending and Venezuela” January 5, 2026, CNN Politics,</i> <u>https://www.cnn.com/2026/01/05/politics/congress-aca-subsidies-vote-shutdown-ukraine</u>
Ex-1034	<i>“Congress rolls out \$174B spending bill as Jan 30 shutdown fears grow,” January 5, 2026, Fox News,</i>

	<u>https://www.foxnews.com/politics/congress-rolls-out-174b-spending-bill-jan-30-shutdown-fears-grow</u>
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I. INTRODUCTION

Milwaukee Electric Tool Corp. (“Petitioner”) submits this brief in opposition to Patent Owner’s Discretionary Denial brief dated December 8, 2025. Discretionary denial is not appropriate for the reasons set forth below.

Petitioner diligently challenged U.S. Patent No. 12,268,265 (the ’265 Patent) via post-grant review (PGR). This PGR challenge was initiated less than six months after issuance of the ’265 patent (April 8, 2025), underscoring Petitioner’s commitment to timely addressing patentability issues. While there is a parallel action at the International Trade Commission (ITC) and in District Court, the District Court litigation is stayed, and the ITC action has already experienced several delays and might experience further delays due to ongoing funding uncertainty and associated backlog related to the recent government shutdown.

In addition to Petitioner’s quick PGR challenge to a young ’265 Patent and issues around the misleading examination that led to the ’265 Patent meriting the Board’s attention, 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 also continues to prosecute patentably-indistinct

claims that appear to rely on misleadingly added new figures and descriptive text for written-description support. *See* Ex-1024, claims 1-4 and pg. 56-60 (pending child application 19/074,885 with a rejection on the grounds of nonstatutory double patenting as being unpatentable over claims 1-4 of the parent U.S. Patent No. 12,452,327). Under 37 CFR 42.73(d), patent-owner estoppel is only invoked if the Board reaches a final decision. Expectations will remain unsettled until the Board resolves these issues as the Board 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 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. Petitioner has also submitted a voluntary search disclosure declaration to the Office explaining how previously unexamined art cited in this petition were identified, thereby assisting the Office and promoting patent quality. The speed of the challenge here to this young patent that experienced a material error during examination further 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. THE FIRST FIVE *FINTIV* FACTORS ARE OVERALL NEUTRAL OR SLIGHTLY AGAINST DENIAL

As an initial matter, and as explained in greater detail below, although there is a co-pending investigation at the ITC, a holistic assessment of the first five discretionary-denial factors shows that they are, at most, neutral or slightly against denial. When those factors are considered together with the additional circumstances discussed in §§ F, III, IV, V, VI and VI the overall discretionary-denial analysis weighs against denial.

While the Board has previously exercised discretionary denial in proceedings involving patents related to the '265 Patent, those decisions rested in significant part on the existence of an ITC target date (June 18, 2026) that, at the time, was before the projected final written decision date (FWD date). Since those decisions, however, the ITC schedule has changed more than once, and the target date has now been moved to September 21, 2026. *See* Ex-2002 (Order No. 16 from the ITC action, amending the procedural schedule); *see also* Ex-2001 (Order No. 13 from the ITC action, rescheduling the evidentiary hearing due to the “lapse in government appropriations”). These shifts resulted from the recent government shutdown, which halted ITC operations and created a backlog that continues to affect the agency’s ability to maintain reliable target dates. *See* Ex-1025 (statement from the ITC that “the Commission has tolled all statutory and other investigative

deadlines pending before it for 47 days to account for the shutdown and resumption of activities”). Although the ITC has since resumed operations, it is funded only through January 30, 2026 as part of a stopgap measure passed by Congress, creating continued scheduling uncertainty as Congress must again act to avoid further funding lapses. *See* Ex-1026. By contrast, the USPTO remained fully operational throughout the shutdown due to its reserve funding, and the Board is therefore better positioned to provide a timely, predictable, and authoritative resolution of the issues presented here. *See* Ex-1027. The considerations that previously supported discretionary denial in the related proceedings are significantly weakened.

A. Factor 1

The co-pending District Court litigation involving the '265 Patent has been stayed and that stay will remain in place until the completion of the co-pending ITC investigation. *See* Ex-1028 (Case No. 1:25-cv-00143-JLH, Dkt. No. 12).

While the co-pending ITC Investigation is not currently stayed, there is no assurance that it will reach a final determination before the Board issues the FWD in this proceeding. As explained above, the ITC’s target date has already been delayed multiple times, and the investigation remains subject to further potential delay given the likelihood of a second government shutdown when the stopgap measure funding ends on January 30, 2026. *See* Ex-1032 (“Senators in both parties

are bracing for another government shutdown next year [January 2026] after Republicans blocked a proposal to extend expiring health insurance subsidies, the issue that triggered the 43-day closure”); *see also* Ex-1033 (“As lawmakers ended America’s longest-ever government shutdown in the fall, they punted most of the decisions on funding to January 30...[a]nd Democrats don’t appear to be in the mood for dealmaking”); *see also* Ex-1034 (“The House Rules Committee is meeting to advance the [new spending bill] on Tuesday evening, with a final vote likely on Thursday. A subsequent procedural vote in the House, called a ‘rule vote,’ will need support from nearly all GOP lawmakers in order to advance”). Under these circumstances, the lack of a stay in the ITC proceeding cannot weigh in favor of discretionary denial under *Fintiv* factor 1.

B. Factor 2

The District Court action is currently stayed and the stay, as explained in § A, will remain in place until at least September 21, 2026, which is the current ITC’s Target Date. Thus, trial in the District Court action is unlikely to occur before the Board’s projected deadline of April 8, 2027 for the FWD.

And as discussed above, the ITC schedule has already changed multiple times and remains subject to further uncertainty, and thus there is no assurance that the ITC will reach resolution before the Board’s FWD.

Consistent with the forgoing timing uncertainty, the co-pending ITC’s target

date is likely to be extended not only due to ongoing government funding constraints, but also because of the complexity of the issues presented in the investigation. In a different proceeding between the same parties, the ITC extended the Target Date two times due to “complexity of the issues raised” and “current constraints on judicial resources.” *See* Ex-1029 and Ex-1030 (INV. No. 337-TA-1409, Order No. 22 and Order No 23); *see also* Ex-1031 (INV. No. 337-TA-1409, Notice extending the target date for the investigation a third time due to the shutdown of the Federal Government). As the co-pending Investigation is currently covering four different patents and 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. Institution would thus directly serve the Congressional goal for PGRs 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, the ITC’s coverage of the issues present in the instant Petition should not hold much weight since 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, regardless of the outcome in the ITC, Petitioner and Patent Owner will still have to subsequently litigate in 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 District Court litigation is likely to exceed the costs for the ITC investigation or the PGR. Therefore, the PTAB route would be a more efficient use of party and PTAB resources than District Court litigation.

D. Factor 4

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

While there is overlap of invalidity grounds between the ITC and the Petition, that should not weigh heavily in favor of discretionary denial, given that the ITC’s decision has no preclusive effect, as explained in § B.

E. Factor 5

The parties involved in the District Court litigation and the PGR are the same. Thus, Factor 5 is neutral or slightly favoring denial.

Overall, the first five factors are neutral or slightly against denial. As will be explained next, when viewed holistically alongside the other circumstances detailed in §§ F, III, IV, V, VI, and VI the overall discretionary-denial analysis is pushed overwhelmingly against denial.

F. Additional circumstances (Factor 6) move the overall weight of the *Fintiv* Factors overwhelmingly against discretionary denial

1. Factor 6

As described below in §§ III, IV, V, VI, and VI numerous other factors are against discretionary denial, such as that the '265 Patent is young and this challenge is a prompt PGR challenge (§ III), the Petition is strong (§ IV), the ability to invoke patent-owner estoppel (§ V), and the filing of a voluntary search disclosure to aid the Office in more effectively identifying relevant prior art (§ VI).

When viewed holistically, these factors, and the issues described as to the other *Fintiv* Factors, such as (i) uncertainty as to the ITC schedule due to funding constraints, (ii) an ITC decision lacking preclusive effect, and (iii) the parallel District Court litigation remaining stayed in its infancy, the efficiency and integrity of the PGR process and Congressional intent of the AIA is best served by instituting review.

III. RAPID CHALLENGE AND LACK OF SETTLED EXPECTATIONS

The '265 Patent is young as it issued very recently in April of 2025, with the instant Petition filed less than six months after its issue date. *See* Ex-1020 at 189.

The Office 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 discretionary denial.

IV. THE PETITION IS STRONG

The grounds presented in this Petition are strong on the merits, relying exclusively on prior art that was not previously considered during prosecution of the challenged claims.

Moreover, the Examiner erred by not identifying the relied-upon references. 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 erroneously accepting a flawed showing of support for the addition of new subject matter, which attributed an unwarranted priority date to the claims and prevented a proper search for prior art. *See* Petition at §§ 5.3, 6.6.1. As the Office has 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).

Although Patent Owner argues in its Request for Discretionary Denial that the Petition’s grounds lack merit, those arguments raise fact-intensive disputes that are properly resolved through institution and full briefing, rather than at the discretionary-denial stage.

A. Patent Owner has failed to provide sufficient evidence that Petitioner has failed to identify any RPI

Patent Owner contends that the Petition is defective because Petitioner allegedly failed to identify all real parties-in-interest, asserting that Techtronic

Industries Co. Ltd. (“TTI”) should have been named as an RPI.

However, the applicable standard is that: “[a] patent owner challenging a petitioner’s RPI disclosure must provide sufficient evidence to show the disclosure is inadequate.” *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, -00441, -00736, Paper 68 at 13 (PTAB Aug. 18, 2015) (citing *Intellectual Ventures Mgmt., LLC v. Xilinx, Inc.*, IPR2012-00018, Paper 12 at 3 (PTAB Jan. 24, 2013)).

Patent Owner has not met its burden here. Rather than identifying evidence showing that TTI exercised control over this proceeding or was the true party in interest, Patent Owner relies solely on the existence of a corporate relationship between Petitioner and TTI to allege that TTI is an RPI to the proceeding. Board precedent makes clear, however, that a corporate affiliation alone is insufficient to establish real party-in-interest status. *See Corning Optical*, Paper 68 at 14 (citation omitted) (“[a] party does not become an RPI merely through association with another party in an endeavor unrelated to the IPR proceeding”).

Patent Owner’s reliance on two prior IPRs in which TTI was identified as an RPI is likewise unavailing. Those proceedings involved different patents and subject matter, specifically hole saw technology. In those proceedings, TTI was involved in that product space.

This proceeding, by contrast, concerns helmet technology, an unrelated field,

and Patent Owner identifies no evidence that TTI plays any role analogous to those prior cases. Nor has Patent Owner pointed to evidence suggesting, as the PTAB's Trial Practice Guide explains, that TTI "desires review of the patent" or that this Petition was filed at TTI's "behest." USPTO Trial Practice Guide at § I.D.1. At most, Patent Owner has only shown a generic corporate relationship, which is insufficient to show Petitioner's disclosure was inadequate. *See Corning Optical* Paper 68 at 15 (citations omitted) ("[w]e may also consider whether Petitioner's actions 'have blurred sufficiently the lines of corporate separation with [an unnamed related entity], such that [the entity] could have controlled the filing and participation of the IPRs'"); *cf. Galderam S.A. v. Allergan Industrie, SAS*, Case IPR2014-01422, slip op. at 12 (PTAB Mar. 5, 2015) (Paper 14) (same person serving as President and CEO of both parent and subsidiary determined to have "a significant degree of effective control over the present matter").

To the extent that any factual issues remain as to additional RPIs in this PGR, these are fact-intensive matters that, if necessary, can be addressed after institution and after the panel receives the parties' positions on this issue.

V. THE ABILITY TO INVOKE PATENT OWNER ESTOPPEL FAVORS INSTITUTION

In the '265 Patent family, Patent Owner continues to prosecute patentability-indistinct claims. *See* Ex-1024, claims 1-4 and pg. 56-60 (pending child application

19/074,885 with a rejection on the grounds of nonstatutory double patenting as being unpatentable over claims 1-4 of the parent U.S. Patent No. 12,452,327). This further favors institution as, per 37 CFR 42.73(d), patent-owner estoppel is only applicable if the PTAB reaches a final decision. The PTAB remains the sole adjudicative body capable of triggering the 42.73(d) estoppel, thereby providing a more definitive resolution to the ongoing disputes as compared to the relief available at the ITC and District Court.

Institution in the present proceeding is thus warranted.

**VI. PETITIONER’S FILED VOLUNTARY SEARCH DISCLOSURE
DECLARATION WEIGHS IN FAVOR OF INSTITUTION**

Petitioner’s filing of a Voluntary Search Disclosure Declaration further supports institution. *See* Paper 6. The disclosure explains how previously unconsidered prior art, cited in the present petition, was identified through new and underutilized search pathways relevant to Office search practice. By proactively bringing this information to the Office’s attention, Petitioner assisted the Board and the Office in understanding how relevant art was located and how similar art can be found in future prosecution matters. The Director has recognized that such voluntary disclosures, particularly those that illuminate gaps in prior examination and aid the Office in improving patent quality, weigh in favor of institution. *See* USPTO Director Squires Memo (Nov. 17, 2025) at 2 (“voluntary submission of an

SDD will be considered as a non-exclusive, non-dispositive **favorable discretionary factor supporting institution**”).

VII. CONCLUSION

For the reasons set forth above, the Petition should not be denied on a discretionary basis, and a post-grant review should be instituted on each of the Grounds.

Dated: January 8, 2026

Respectfully Submitted,

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

CERTIFICATE OF COMPLIANCE

The undersigned certifies that the foregoing **PETITIONER'S
RESPONSE TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**
contains 14 pages, exclusive of the parts exempted as provided in 37 C.F.R. §
42.24(a), and therefore complies with the 20 page limit.

Dated: January 8, 2026

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 January 8, 2026 an electronic copy of this PETITIONER'S RESPONSE TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF and Exhibits 1024-1034 were served via email on Patent Owner's counsel of record in this proceeding:

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Dated: January 8, 2026

Respectfully submitted,

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