

---

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

TRICAM INDUSTRIES, LLC  
Petitioner

v.

LITTLE GIANT LADDER SYSTEMS, LLC  
Patent Owner.

---

PGR2026-00044  
Patent No. 12,359,506

---

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

## TABLE OF CONTENTS

|                                                                       |                              |
|-----------------------------------------------------------------------|------------------------------|
| <b>TABLE OF CONTENTS</b> .....                                        | Error! Bookmark not defined. |
| <b>TABLE OF AUTHORITIES</b> .....                                     | ii                           |
| <b>PATENT OWNER’S EXHIBIT LIST</b> .....                              | iii                          |
| <b>INTRODUCTION</b> .....                                             | 1                            |
| <b>BACKGROUND</b> .....                                               | 2                            |
| <b>A. The ‘506 Patent</b> .....                                       | 2                            |
| <b>B. Prosecution History</b> .....                                   | 3                            |
| <b>ANALYSIS</b> .....                                                 | 4                            |
| <b>A. Ground 1: Obviousness</b> .....                                 | 4                            |
| 1. Same or Cumulative Art .....                                       | 5                            |
| 2. No Material Error .....                                            | 12                           |
| <b>B. Grounds 2 – 5: Indefiniteness and Written Description</b> ..... | 15                           |
| <b>CERTIFICATE OF SERVICE</b> .....                                   | 18                           |

## TABLE OF AUTHORITIES

|                                                                                                                                               |                |
|-----------------------------------------------------------------------------------------------------------------------------------------------|----------------|
| <b>CASES .....</b>                                                                                                                            | <b>PAGE(S)</b> |
| <i>Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH,</i><br>IPR2019-01469, Paper 6 at 8-9 (P.T.A.B. Feb. 13, 2020) .....       | 5, 11, 12      |
| <i>Dropworks, Inc. v. The University of Chicago,</i><br>IPR2021-00100, Paper 9 at 13-14 (P.T.A.B. May 14, 2021).....                          | 11             |
| <i>Ecto World, LLC et al. v. Rai Strategic Holdings, Inc.,</i><br>IPR2024-01280, Paper 13 at 5-6 (Director May 13, 2025) (precedential). .... | 12             |
| <i>Helena Labs. Corp. v. Sebia,</i><br>IPR2024-00801, Paper 10 at 10 (P.T.A.B. Oct. 23, 2024).....                                            | 11, 12         |
| <i>In re Gardner,</i><br>480 F.2d 879, 879-80 (C.C.P.A. 1973) .....                                                                           | 15             |
| <i>Liebel-Flarsheim Co. v. Medrad, Inc.,</i><br>358 F.3d 898, 911 (Fed. Cir. 2004).....                                                       | 16             |
| <i>Roku, Inc. v. Universal Electronics, Inc.,</i><br>IPR2019-01619, Paper 17 at 6 (P.T.A.B. May 25, 2021) .....                               | 12             |
| <i>Vovomart (HK) Enters. Co., Ltd. et al. v. Office Kick, Inc.,</i><br>PGR2022-00048, Paper 14 at 12-13 (P.T.A.B. Jan. 12, 2023) .....        | 10, 11         |
| <b>STATUTES .....</b>                                                                                                                         | <b>PAGE</b>    |
| 35 U.S.C. § 325(d) .....                                                                                                                      | 1              |
| <b>OTHER AUTHORITIES .....</b>                                                                                                                | <b>PAGE</b>    |
| MPEP 2103(IV).....                                                                                                                            | 17             |

## PATENT OWNER'S EXHIBIT LIST

| <b>Exhibit Number</b> | <b>Description</b>                     |
|-----------------------|----------------------------------------|
| 2001                  | U.S. Patent No. 5,054,170 (“Otrusina”) |
| 2002                  | U.S. Patent No. 6,142,892 (“Dennis”)   |

## INTRODUCTION

Pursuant to the Interim Process for PTAB Workload Management, Patent Owner Little Giant Ladder Systems, LLC (“Little Giant”) requests the Director exercise discretion to deny institution of Petitioner Tricam Industries, LLC’s (“Tricam”) Petition for Post Grant Review of U.S. Patent No. 12,359,506 (“the ‘506 Patent”).

Little Giant’s request for discretionary denial is based on 35 U.S.C. § 325(d) and the fact that the same or substantially the same prior art on which Tricam relies had been previously presented to the Patent Office. The Petition relies on two prior art references: Moss and Meyers. As acknowledged by Tricam, the Examiner relied on Moss during prosecution of the ‘506 Patent to reject claims. [Petition at 108.] While Meyers was not before the Examiner, it is cumulative of art that was cited by the Examiner. Specifically, the Examiner cited two two-piece mounts during prosecution that are nearly identical to the mount in Meyers. Tricam’s Petition does not even acknowledge this fact, let alone establish that the Office should revisit the Examiner’s apparent conclusion that the two-piece mounts were not worthwhile to rely on in claim rejections.

The same is true for Tricam’s Grounds 2 – 5, which are based on alleged indefiniteness and lack of written description for two claim terms. Here again, Tricam does not offer any explanation for why the Office should revisit the

Examiner's apparent conclusion that the claims pass muster under § 112.

## **BACKGROUND**

Little Giant will file a separate Patent Owner Preliminary Response addressing the merits of the Petition. Here, Little Giant will provide some background information on the '506 Patent and prosecution history to inform the § 325(d) analysis.

### **A. The '506 Patent**

The '506 Patent is directed to a ladder with a multifunction adjustment button. The ladder is a combination ladder that can be configured as step ladder ("A"-configuration ladder that can stand on its own) or as a straight ladder (for leaning against a structure). Specifically, the ladder has a hinge mechanism that enables both configurations. A button on the hinge mechanism is part of a locking mechanism to keep the ladder in a desired configuration. The button of the '506 Patent also includes other features for holding objects at height while a person is working on the ladder.

In the '506 Patent claims, the button includes a second button body. One example second button body in the '506 Patent is a button plate. Shown below is an annotated Figure 5 of the '506 Patent, which is an embodiment of the multifunctional button. The button plate (blue) is attached to but spaced away from the button body (green) to form a gap (red). The gap can receive an item such as a

spatula, paper, or an end hook portion of a tape measure. [Ex. 1001, ‘506 Patent at 11:34-45.]

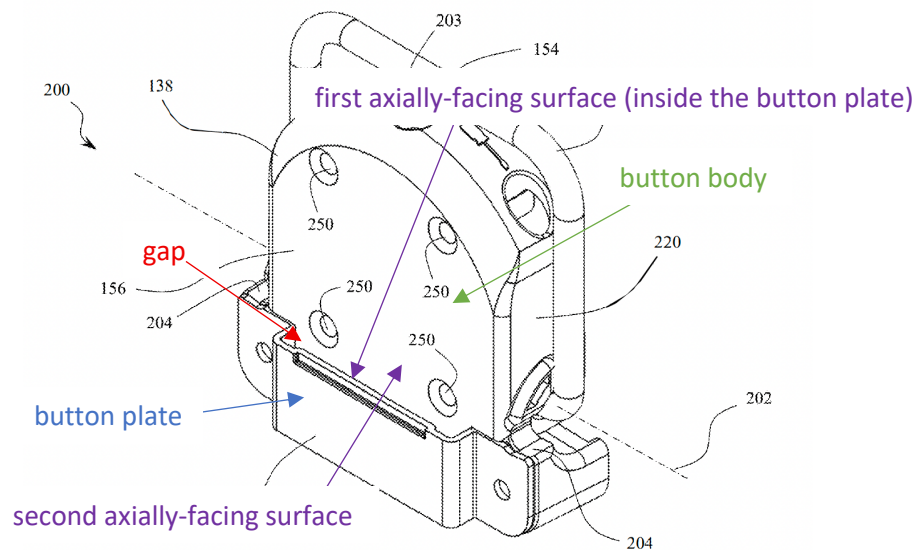


**FIG. 5**

More specifically, in the ‘506 Patent claims, the second button body has a first axially-facing surface partially spaced axially outward from a second axially-facing surface of the first button body by the gap. These first and second axially-facing surfaces are annotated on Figure 5 above in purple.

## **B. Prosecution History**

The ‘506 application survived a thorough prior art challenge. The application that became the ‘506 Patent was subject to several rounds of rejections from the Examiner. [Petition at 12-19.] The penultimate rejection was over Moss, Little Giant’s own prior art also relied on in the Petition, and Ng, a wall hanging mount. [Ex. 1002 at 185-206 (Non-Final Office Action of September 5, 2024).] At

first, the Examiner rejected the claims that ultimately issued. Specifically, the Examiner alleged that Moss taught all features of the claims except for the second button body. [*Id.* at 188-193.] The Examiner further alleged that one of skill in the art would have replaced a magnet provided on the button in Moss with the mount taught by Ng. [*Id.* at 192.]

In response, Little Giant argued against the combination of Ng and Moss and also submitted evidence of objective indicia of non-obviousness. [*Id.* at 124-137 (Remarks filed December 18, 2024).] Specifically, Little Giant argued against the combination of Ng and Moss because Ng is non-analogous art to the field of ladders and Ng is not reasonably pertinent to the problem faced by the inventors of the '506 Patent. [*Id.* at 126-128.] Little Giant separately provided evidence of objective indicia of non-obviousness. [*Id.* at 128-136.] The Examiner was convinced by Little Giant's arguments and allowed the application. [*Id.* at 15-23 (Notice of Allowance).]

## **ANALYSIS**

### **A. Ground 1: Obviousness**

Discretionary denial under § 325(d) is evaluated under six *Becton, Dickinson* factors:

(a) the similarities and material differences between the asserted art and the prior art involved during examination;

- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

*Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 8-9 (P.T.A.B. Feb. 13, 2020) (precedential).

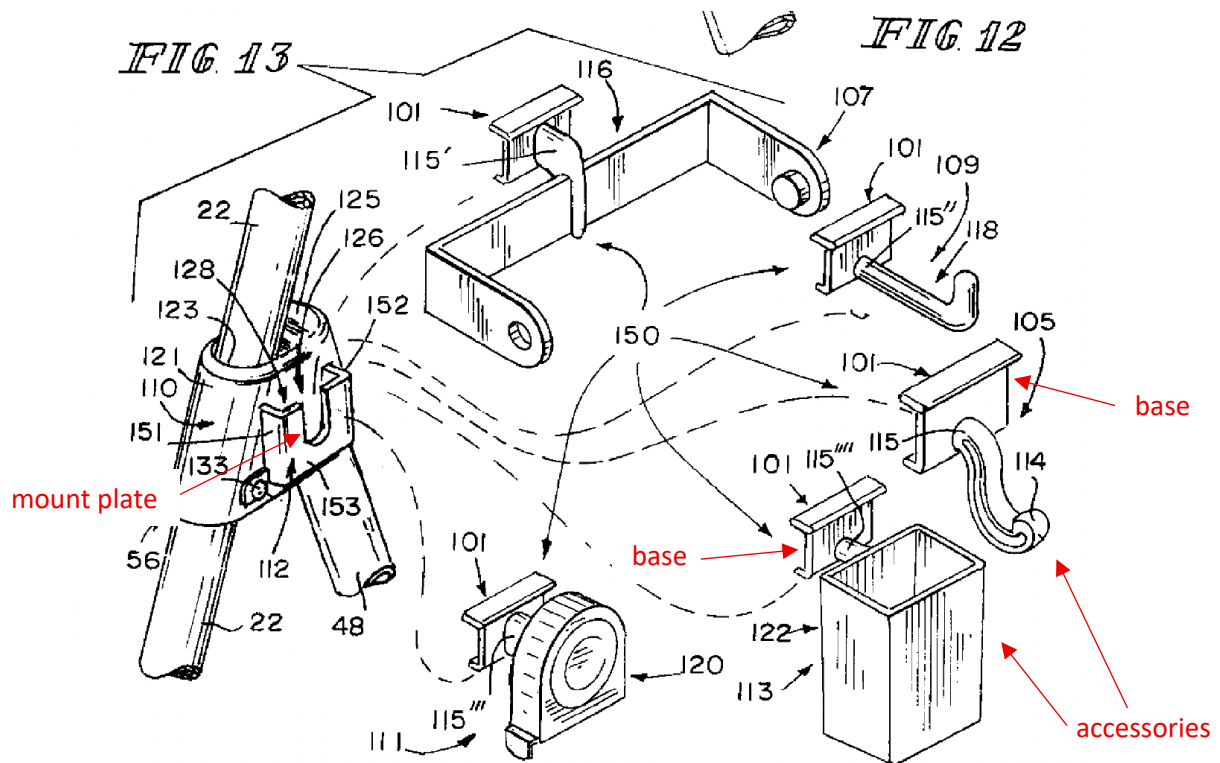
Factors (a), (b), and (d) are evaluated first to determine whether the same or substantially the same art or arguments previously were presented to the Office. *Id.* at 10. If that is the case, then factors (c), (e), and (f) are evaluated to determine whether petitioner demonstrated that the Office made a material error. *Id.* Below Little Giant will address each factor in turn.

### ***1. Same or Cumulative Art***

The first step in the *Becton, Dickinson* analysis is to determine whether the

same or substantially the same art or arguments were at issue during prosecution. Here, Tricam relies on Moss, which it admits was before the Examiner during prosecution. [Petition at 108.] Tricam also relies on Meyers instead of Ng for the claimed second button body. [Petition at 44-51.] Meyers itself was not before the Examiner, but as will be established in this section, Meyers is the same as other art that the Examiner did consider.

Meyers discloses a two-piece accessory mount for a ladder, shown below in annotated Figure 13 from Meyers. The mount includes a mount plate configured to receive a base. Bases are provided with unique accessories and can be interchanged in the mount plate. [Ex. 1007 at 8:50-9:20.] These features are annotated in red below.

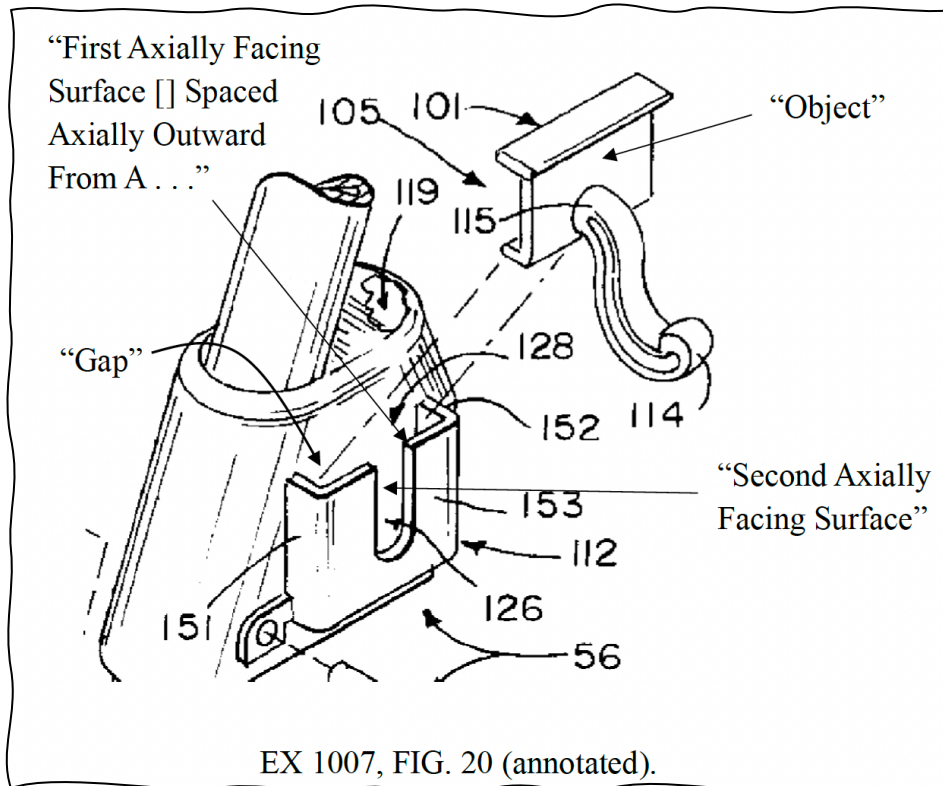


The Petition relies on the mount plate of Meyers for the second button body, the first and second axially-facing surfaces, and the gap.<sup>1</sup> [Petition at 44-46.]

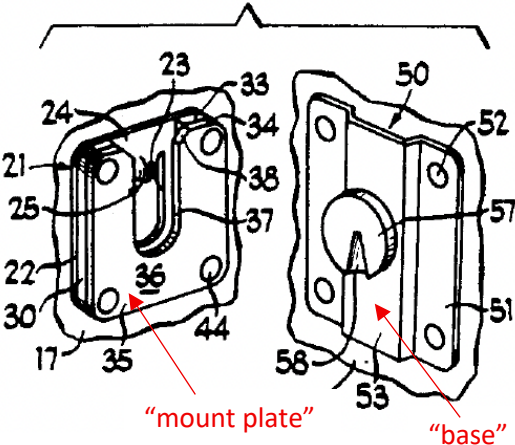
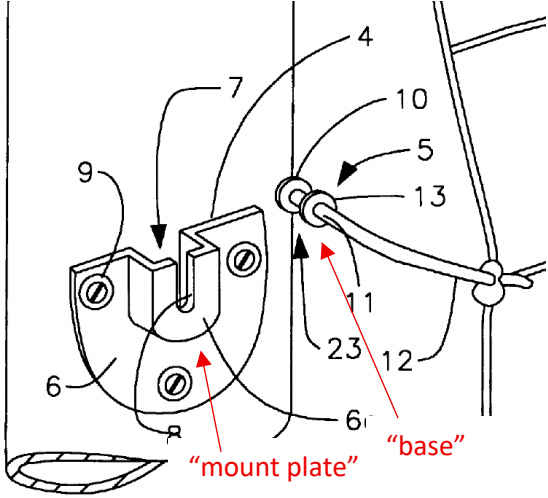
Shown below is an excerpt from the Petition at page 46 where Tricam has annotated Meyers to show the alleged first and second axially-facing surfaces and the alleged gap.

<sup>1</sup> The Petition ignores the base and the two-piece nature of the mount in Meyers.

This is a problem with the merits of the Petition that Little Giant will address in its Patent Owner Preliminary Response.



Two similar two-piece mounts were cited by the Examiner during prosecution of the ‘506 Patent as shown in the table below. In each exemplary figure, the mount plate and base corresponding to those in Meyers are annotated in red.

| Patent No.                                                     | Exemplary Figure                                                                                                                           | Cited By                      |
|----------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------|
| U.S. Patent<br>No. 5,054,170<br>(“Otrusina”)<br>[Exhibit 2001] | <p style="text-align: center;"><i><b>Fig 3</b></i></p>   | Examiner [Ex.<br>1002 at 494] |
| U.S. Patent<br>No. 6,142,892<br>(“Dennis”)<br>[Exhibit 2002]   |  <p style="text-align: center;">Excerpt from Fig. 1</p> | Examiner [Ex.<br>1002 at 405] |

Notably, the mount plates in Otrusina and Dennis have nearly the same structure as in Meyers, down to the “U”-shaped opening configured to receive the base. As such, each of these two-piece mounts has the same structures that Tricam alleges are first and second axially-facing surfaces and the same alleged gap as in

Meyers. So, the Petition does not point to any new structure that was not before the Examiner. Had the Examiner combined either of Otrusina or Dennis with Moss, the Examiner would have made essentially the same combination as Tricam did in the Petition. Where, as here, a petitioner relies on new art for the same teachings that were in the art before the Examiner, the first prong of the *Becton, Dickinson* analysis weighs in favor of discretionary denial. *See, e.g., Vovomart (HK) Enters. Co., Ltd. et al. v. Office Kick, Inc.*, PGR2022-00048, Paper 14 at 12-13 (P.T.A.B. Jan. 12, 2023) (new references found to be cumulative of references before the Examiner). Under *Becton, Dickinson* factors (a) and (b), the combination of Moss (before the Examiner) and Meyers (same as Otrusina and Dennis before the Examiner) weighs in favor of discretionary denial.

Although Tricam attempts to head off discretionary denial based on § 325(d), Tricam does not address Otrusina or Dennis in the Petition. [See Petition at 108-111.] Tricam may argue that Meyers is not “the same” as Otrusina and Dennis within *Becton, Dickinson* factors (a) and (b) because Meyers is from the ladder art but Otrusina and Dennis are not. But that argument does not address the fact that the Examiner found nearly the same structures that Tricam now proposes adding to Moss in the prior art and deemed those structures relevant enough to cite. Further, that argument does not address the fact that the two-piece mounts in Meyers, Otrusina, and Dennis are more different from the second button body in the ‘506

Patent than the single-piece mount of Ng (setting aside the other shortcomings of Ng that were addressed during prosecution). In *Dropworks, Inc. v. The University of Chicago*, the Board emphasized that § 325(d) analysis “does not require that the teachings be identical or entirely cumulative, only that they are substantially the same” and found *Becton, Dickinson* prong one was met. *Dropworks, Inc. v. The University of Chicago*, IPR2021-00100, Paper 9 at 13-14 (P.T.A.B. May 14, 2021). The Board based its decision in part on the fact that the newly cited references were even “further afield” from the base reference than previously-considered references. *Id.* at 13.

Tricam may also argue that *Becton, Dickinson* factor (d) weighs against discretionary denial because the Petition presents different arguments than were before the Examiner, perhaps relating to the rationale for combining Meyers with Moss being based on the fact that Meyers is from the ladder art. [*Id.*, see also 48-51.] However, if the **art** is the same as was before the Examiner for purposes of factor (a) and (b) analysis, the Board need not decide whether the same or substantially the same **arguments** were previously presented to the Office.

*Advanced Bionics*, Paper 6 at 20; see also *Helena Labs. Corp. v. Sebia*, IPR2024-00801, Paper 10 at 10 (P.T.A.B. Oct. 23, 2024) (“Because we determine that the same or substantially the same art was before the Examiner during examination, we need not consider *Becton, Dickinson* factor (d)”); *Vovomart (HK) Enters.*,

Paper 16 at 5 (Decision Denying Petitioner’s Request for Rehearing) (rejecting argument that the petition presents a “fundamentally different argument” as was made to the Examiner because reliance on the same or substantially the same art is enough on its own to meet *Becton, Dickinson* prong one).

Finally, Tricam may argue that neither of Otrusina and Dennis were relied on by the Examiner in a claim rejection. But that does not matter for *Becton, Dickinson* prong one—so long as the art was before the Examiner, it qualifies as prior art previously presented to the Office under prong one. *See, e.g., Helena Labs.*, Paper 10 at 10; *Roku, Inc. v. Universal Electronics, Inc.*, IPR2019-01619, Paper 17 at 6 (P.T.A.B. May 25, 2021).

## ***2. No Material Error***

Having established that Tricam’s petition relies on the same or substantially the same art as was before the Examiner during prosecution of the ‘506 Patent, the next question is whether the Examiner made a material error in allowing the ‘506 Patent. For this question “if reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Advanced Bionics*, Paper 6 at 9. Notably, the burden is on the petitioner to explain **in the petition** why a material error was made. *See Ecto World, LLC et al. v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5-6 (Director May 13, 2025) (precedential).

The material error issue is evaluated based on *Becton, Dickinson* factors (c), (e), and (f). Little Giant submits that factor (c) weighs in favor of denial, or at worst, is neutral. While as noted above neither of Otrusina or Dennis was relied on by the Examiner in a claim rejection, this is not a case where Otrusina and Dennis were cited by Little Giant in a voluminous Information Disclosure Statement as in *Ecto World*. Rather, the Examiner found Otrusina and Dennis during his search, and determined that each one was relevant enough to cite on the face of the patent that eventually issued as the ‘506 Patent.

Factors (e) and (f) also weigh against institution. The Petition and accompanying declarations are silent as to Otrusina and Dennis and therefore do not explain how the Examiner erred in evaluating these references. Nor does the Petition provide any facts establishing that two-piece mounts should be reconsidered. In any case, it was reasonable for the Examiner to consider the two-piece mounts in Otrusina and Dennis and ultimately decide that the single-piece mount in Ng was the “closest reference.” [Ex. 1002 at 22.]

Indeed, in its Patent Owner Preliminary Response Little Giant will explain problems that one of ordinary skill in the art would immediately recognize with combining a two-piece mount with a hinge assembly for a combination ladder like the one in Moss as the Petition proposes. For example, a worker would not want to be fumbling with extra pieces and interchangeable accessories while many feet in

the air. This is not a concern in Meyers, which describes a two-step ladder only a few feet high in total, with the accessory mount just above the second step. [*See generally* Ex. 1007.] The Examiner may have recognized this problem and declined to combine Otrusina and Dennis with Moss.

Finally, Tricam asserts that the Examiner erred in considering Little Giant's evidence of objective indicia of non-obviousness and the Board should take this opportunity to correct this error. [Petition at 110-111.] However, the Petition does not establish any error. As for commercial success and long-felt need, Tricam offers only attorney argument about alleged shortcomings of Little Giant's declaration evidence. [Petition at 98-100.] Tricam does not offer any new facts not before the Examiner for the Board to consider.

On the issue of copying, Little Giant established during prosecution that Little Giant developed the secondary button idea around March 2022 and on June 12, 2022, sent prints to a manufacturer, PICA, also used by Tricam. [Ex. 1002 at 117 (Declaration of Brian B. Russell at ¶ 6).] Tricam does offer its own declarations asserting Tricam independently developed the same secondary button idea at a "team brainstorming session" on June 29, 2022, 17 days later. [*See* Ex. 1004, Declaration of Joseph P. Foley at ¶ 7.] While Mr. Foley's declaration was not before the Examiner, it does not on its own warrant institution of this PGR.

The Examiner allowed the '506 Patent based on a combination of multiple

reasons: Little Giant’s arguments that one of skill in the art would not have combined Ng with Moss; the long-felt need for an invention like the one of the ‘506 Patent; the commercial success of Little Giant’s product embodying the ‘506 Patent; and “the decelerations [sic] of the four experts in the field in combination with the copying of competitors when the current inventors developed and implemented the design.” [Ex. 1002 at 21-22.] There is no indication in the prosecution history, nor does Tricam even argue, that the Examiner would not have allowed the ‘506 Patent absent evidence of copying.

#### **B. Grounds 2 – 5: Indefiniteness and Written Description**

For its Grounds 2 – 5, Tricam alleges that two claim terms in the ‘506 Patent are indefinite and lack written description support. The first term, appearing in claims 1 and 12, is: “wherein the first pair of hinge portions and the second pair of hinge portions are pivotally coupled to each other to form a pair of hinges rotatable about a pivot axis.” The second term, appearing in claim 2, is “the pair of hinge button assemblies is movable between a first axial position along the pivot axis and a second axial position along the pivot axis.”

First, Grounds 2 and 4 concerning written description fail because both terms were in the originally-filed claims, and thus can provide the requisite written description for themselves. [Ex. 1002 at 610-611.] *See In re Gardner*, 480 F.2d 879, 879-80 (C.C.P.A. 1973) (“we consider the original claim in itself adequate

‘written description’ of the claimed invention.”). The Petition overlooks that written description support can come from original claims, and wrongly focuses only on the Specification of the ‘506 Patent for written description support (which is also present, as will be addressed in Little Giant’s Patent Owner Preliminary Response). [Petition at 103-105.]

Second, it should be noted that Tricam only presents the § 112-based Grounds in the alternative to a claim construction that Tricam alleges will cure the alleged indefiniteness and written description issues in the claims. [Petition at 26-30.] So, the Board would only need to reach Grounds 2 – 5 if it decided that the claims of the ‘506 Patent could not be construed to preserve validity. While Tricam urges such a finding, it never explains why such a drastic measure is warranted here. [*Id.* at 28, 38.] Claims are construed to preserve validity unless, “after applying all the available tools of claim construction... the claim is still ambiguous.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 911 (Fed. Cir. 2004). That is not the case here, as even Tricam was able to construe the claims in a manner it concedes resolved any alleged ambiguities. [Petition at 26-30.]

Little Giant will reserve the rest of its merits argument for its Patent Owner Preliminary Response. For now, Little Giant will address the reasons why discretionary denial is appropriate for Grounds 2 – 5 (concerning both indefiniteness and written description) together with Ground 1, discussed above.

Since both claim terms at issue were in the originally-filed claims, they were examined by the Examiner for § 112 compliance three times. Twice during prosecution the Examiner issued § 112 rejections, but neither one relates to the claim terms that Tricam now complains of. [Ex. 1002 at 466 (Non-Final Office Action of December 12, 2023); 380-381 (Final Office Action of March 25, 2024).] Therefore, the Examiner engaged with § 112 analysis multiple times, engaged with the claim terms now complained of by Tricam multiple times, and ultimately found both terms are compliant with § 112. *See, e.g.*, MPEP 2103(IV) (Examiners must evaluate claims for compliance with § 112). Tricam never explains why the Office should now revisit this finding. Discretionary denial is appropriate because the Office already adjudicated the very issue Tricam now asks it to decide.

**EVIA LAW PLC**

/Jessica Fleetham /

Jessica Fleetham, Registration No. 70,951  
Steven Susser (*pro hac vice* admission pending)  
231 S Old Woodward Suite 220  
Birmingham, MI 48009  
248.243.1201

Dated: June 22, 2026

## **CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.6(e), I hereby certify that a true and correct copy of the foregoing document was served on counsel of record via email to the following addresses:

Bradley Thorson, [bjt@dewittllp.com](mailto:bjt@dewittllp.com)

Eric Chadwick, [ehc@dewittllp.com](mailto:ehc@dewittllp.com)

### **EVIA LAW PLC**

/Jessica Fleetham /

Jessica Fleetham  
Registration No. 70,951  
231 S Old Woodward Suite 220  
Birmingham, MI 48009  
248.243.1201

Dated: June 22, 2026