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

PGR Trial No. PGR2026-00044
U.S. Patent No. 12,359,506

PETITIONER'S OPPOSITION BRIEF IN RESPONSE TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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PETITIONER'S EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 12,359,506 (the "'506 Patent")
1002	Prosecution history of U.S. Application No. 18/490,715 which led to the issuance of the '506 Patent
1003	Declaration of Jon Ver Halen
1004	Declaration of Joseph Foley
1005	Declaration of Ben Williams
1006	U.S. Patent No. 8,186,481 ("Moss '481")
1007	U.S. Patent No. 7,967,111 ("Meyers")
1008	Provisional Patent Application No. 63/382,174
1009	U.S. Patent No. 12,523,097
1010	U.S. Patent No. 4,407,045 ("Boothe")
1011	American National Standard for Ladders – Portable Metal – Safety Requirements ANSI-ASC A14.2-2007
1012	U.S. Patent No. 594,303
1013	U.S. Patent No. 3,811,151
1014	U.S. Patent No. 4,210,224
1015	U.S. Patent No. 4,216,844
1016	U.S. Patent No. 4,697,305
1017	U.S. Patent Publication No. 2018/0274296 A1
1018	Declaration Of David Smith, June 17, 2024
1019	Declaration Of N. Ryan Moss, June 24, 2024

Exhibit	Description
1020	Declaration Of Paul Junius, June 25, 2024
1021	Declaration Of N. Ryan Moss, November 25, 2024
1022	Declaration Of Paul Junius, November 26, 2024
1023	Declaration Of B. Scott Maxfield, November 27, 2024
1024	Declaration Of Brian Russell, December 3, 2024
1025	U.S. Design Patent No. D833,643
1026	U.S. Patent No. 11,191,373
1027	Meeting Notes and Sketches
1028	U.S. Patent No. 11,505,994
1029	Email chain of July 13, 2023
1030	*Little Giant Ladder Sys., LLC. V. Tricam Indus., Inc*., 2026 WL 305021 (Fed. Cir. Feb. 5, 2026)

A. Introduction

Patent Owner has requested that the Director deny institution of PGR under 35 U.S.C. § 325(d), claiming that the Petition presents "the same or substantially the same art" as was considered during prosecution of the '506 Patent. While Petitioner has conceded that Moss '481 resulted from the published application ("Moss '918") that was the primary reference asserted by the Examiner in rejections during prosecution and is therefore the "same art," Meyers was never cited or considered. Paper 2 at 108-109.

Patent Owner admits Meyers was not before the Examiner, but instead contends that two references found by the Examiner during searching - U.S. Patent No. 5,054,170 to Otrusina ("Otrusina") and U.S. Patent No. 6,142,892 to Dennis ("Dennis") - that were cited but not relied upon "have nearly the same structure as in Meyers." Paper 10 at 9. Under a newly manufactured taxonomy where mounts are classified as either "one-piece" or "two-piece," Patent Owner asserts that both references it identifies and Meyers are all "two-piece" mounts, and U.S. Patent No. 11,191,373 to Ng et al. ("Ng") which was applied in rejections by the Examiner is a "one-piece" mount. It urges that this is the reason the Examiner applied Ng instead of Otrusina or Dennis. And further, that because Meyers is classified under

its rubric as a "two-piece" mount, it provides no additional teachings not available to the Examiner during prosecution through Otrusina or Dennis.

Patent Owner's argument is mere sophistry. There is no evidence in the prosecution record supporting Patent Owner's "one-piece/two-piece" distinction, or that the Examiner employed such an analysis. Also, Ng would not even be a "one-piece" mount under Patent Owner's own proposed method of analysis.

In reality, Meyers provides a key teaching absent from Ng, Otrusina, and Dennis: Meyers discloses a mount that directly attaches an object, specifically a tool, to a ladder. And not even just to a ladder generally, but the *hinge portion of a ladder*. As such, Meyers is not the same as, or similar to, the references available to the Examiner during prosecution.

Patent Owner also attempts to downplay the impact of its defective declaration evidence of secondary considerations, that undeniably were a crucial basis of the Examiner's allowance of the '506 Patent claims. The Examiner's reliance on this flawed evidence was clear error.

B. The First Prong Of The *Advanced Bionics* Analysis Weighs In Favor of Instituting PGR.

As already presented at length by the Parties, arguments for discretionary denial under 35 U.S.C. § 325(d) are evaluated under the two-part framework of *Advanced Bionics* using the six factors of *Becton, Dickinson*. Paper 2 at 106-108;

Paper 10 at 4-5; *Lyft, Inc. v. RideShare Displays, Inc*., IPR2021-01602, Paper 7 at 13 (PTAB April 11, 2022). *Becton, Dickinson* factors (a), (b), and (d) pertain to the first prong, while factors (c), (e), and (f) pertain to the second. *Advanced Energy Indus. v. Reno Techs.*, IPR2021-01397, Paper 7 at 6 (PTAB Feb. 16, 2022).

This is not a case where *all* the references relied upon in the Petition were before the Office in prosecution. Meyers was not before the Examiner, having not been presented in an IDS or found in the Examiner's searching. "The fact that one piece of art from [a] combination was previously presented and/or argued to the Office alone is insufficient to satisfy the first prong of *Advanced Bionics* two-part test." *Thorne Research, Inc. v. Trustees of Dartmouth College*, IPR2021-00491, Paper 18 at 8 (PTAB August 12, 2021). Patent Owner nevertheless asserts that Meyers should be considered the "same or substantially the same art" as Otrusina and Dennis under factors (a) and (b). Paper 10 at 1; EX2001, EX2002.

Permeating Patent Owner's argument is an invented distinction between "one-piece" and "two-piece" mounts. Patent Owner first characterizes Meyers as a "two-piece" mount, and then compares it to Otrusina and Dennis which it says are also "two-piece" mounts. Paper 10 at 6. Patent Owner speculates that the Examiner must have chosen the picture hanger disclosed in Ng for combination with Moss over either Otrusina or Dennis, because it is "one-piece" as opposed to "two-

piece." *Id.* at 13. And because the structure of the Meyers accessory mount 112 is superficially similar in shape to female member 21 of the Otrusina device or female member 4 of the Dennis device, Patent Owner argues the Examiner would not have applied Meyers either during prosecution. *Id.* at 13.

These stacked suppositions and inferences collapse under the weight Patent Owner places on them. First, there is nothing whatsoever in the record suggesting that the Examiner evaluated the mount references he found in his searching using Patent Owner's contrived "one-piece/two-piece" rubric. The Examiner never offered such an analysis and neither did Patent Owner during prosecution. In fact, the Examiner made clear that he was relying on Ng as a "teaching reference," solely for its "plate." EX1002, Final Office Action of March 25, 2024, pp. 22, 24. And the plate (bracket 10) of Ng does closely resemble the "second button body" of the '506 Patent, which is described as "button plate 140":

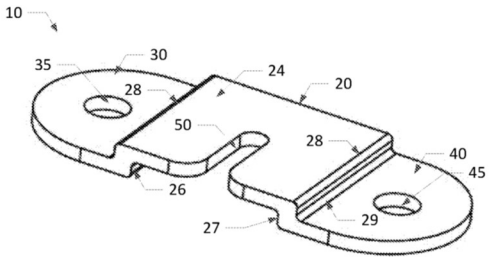
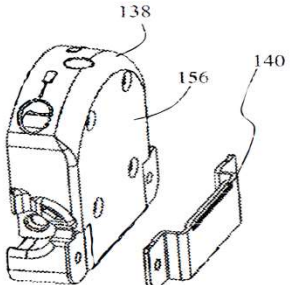
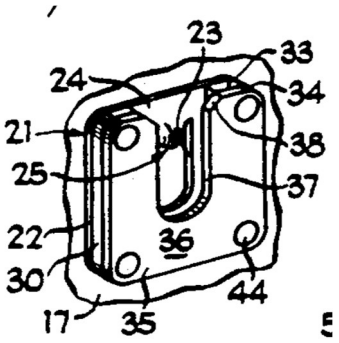


Plate ("Bracket 10") of Ng

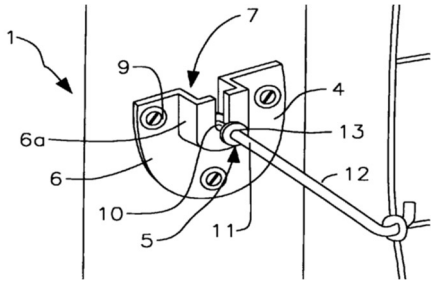


"Button Plate 140" of '506 Patent

EX 1026, FIG. 1; EX1001, FIG. 2. In fact, bracket 10 of Ng bears a far closer physical resemblance to button plate 140 of the '506 Patent than either female member 21 of Otrusina or female member 4 of Dennis:



"Female Member 21" of Otrusina

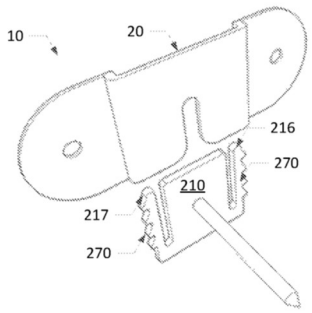


"Female Member 4" of Dennis

EX2001, FIG. 3; EX2002, FIG. 1. This closer physical resemblance alone suffices to explain why the Examiner may have chosen Ng over Otrusina or Dennis. It certainly is more plausible than Patent Owner's "one-piece/two-piece" rubric.

In any event, Patent Owner's attempted distinction falls apart when it is realized that Ng itself, when considered in its entirety, would be a "two-piece" mount under the "one-piece/two-piece" rubric. The device of Ng as disclosed has two parts: (1) bracket 10; and (2) a "fastener" which is defined as a "specially configured nail" or a "specially configured screw." EX1026, col. 6, ll. 20-39; FIGs. 5-15C, 18A and 18B. Indeed, Ng devotes a dozen figures and six columns to describe the special fastener. *Id*., FIGs. 5-15C, 18A and 18B; col. 6, ll. 20-64;

col. 8, l. 52 – col. 14, l. 9; col. 15, ll. 4-21. The two-piece nature of the Ng device, with its bracket and special fastener, is depicted in FIG. 18A, for example:



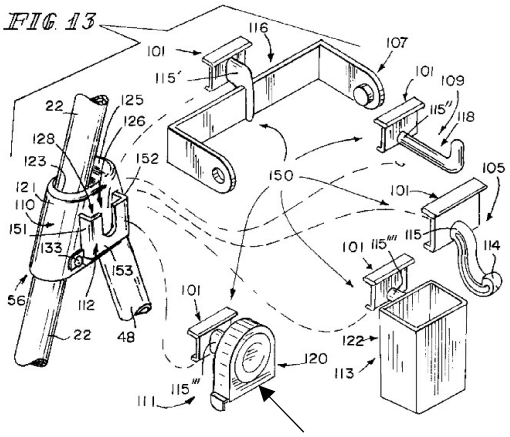
Therefore, since Ng is also a "two-piece" mount (a bracket and special fastener for picture-hanging), Patent Owner's theorized distinction cannot explain why the Examiner chose to apply it as the secondary reference in a rejection rather than the belt clip of Otrusina or the goal post net fastener of Dennis. Indeed, the Examiner even appears to have suggested that another "piece" might be used with the Ng bracket in attaching a tool to the ladder:

> One of ordinary skill in the art would find that having a hanging bracket such as the one taught by Ng would be useful to a worker on a ladder where he can use it to attach small tools, phone clip, **a clip attached to a tool**, ID card etc. as non-limiting examples.

EX1002, Office Action of September 5, 2024, p. 7 (emphasis added). A more likely explanation is that the Examiner found Otrusina and Dennis to be no better than Ng (and in fact less relevant) to apply in a rejection, because they

are all from fields other than ladders, and the Ng plate bears a closer physical resemblance.[1]

In contrast with Ng, Otrusina, and Dennis, Meyers provides a key teaching that is missing from all of them: Meyers discloses a mount that directly attaches an object, specifically a tool, to a ladder. And not just to a ladder generally, but the *hinge portion of a ladder*. As stated in the Petition and Ver Halen declaration, FIG. 13 of Meyers describes and depicts a tape measure (i.e., a tool), attached to the ladder using the "accessory mount 112":



Tape Measure

Paper 2 at 86; EX1003, ¶ 157; EX1007, FIG. 13, col. 9, ll. 15-17.

[1] Patent Owner criticizes Petitioner for not analyzing Meyers, Otrusina, and Dennis under its "one-piece/two-piece" rubric. Paper 10 at 10-11, 13. Such a comparison would have been pointless because Patent Owner's invented dichotomy is an invalid basis for comparison, and Ng is not "one-piece" as Patent Owner claims.

Patent Owner carefully avoids noting that one of the accessories depicted in Meyers is a tape measure – it is depicted, but not annotated in Patent Owner's brief. Paper 10 at 7. If Patent Owner had discussed this teaching at all, it would have undoubtedly attempted to dismiss it, based on the tape measure being depicted as having "base 101," which makes it part of a "two-piece" mount. As the Examiner noted, however, measuring tapes often already have clips. *See* EX1002, Office Action of March 25, 2024, pp. 22-23 (" a person of ordinary skill in the art would see the notched opening 50 of Ng holding object 120 (nail) and find that it would be useful to hold similar objects such as a head of a flathead nail, paper clip, **measuring tape clip** etc.") (emphasis added). It would be no great leap for one of ordinary skill to deduce that base 101 would be unnecessary to attach tape measure 111 to accessory mount 112 if it already had a clip. Therefore, Meyers teaches a device for attaching a tool directly to the hinge portion of a ladder – a teaching absent from Ng, Otrusina, and Dennis. It is unimaginable that the Examiner would not have applied Meyers instead of Ng, Otrusina, or Dennis if armed with that teaching.

Hence, under factor (a) [the similarities and material differences between the asserted art and the prior art involved during examination], Meyers is materially different from Ng, Otrusina, and Dennis. All of them are from other fields. None of

them teach a device specifically or attaching a tool to a ladder. But Meyers does. There is no need with Meyers to analogize or explain how its bracket could be used with a ladder or why one of ordinary skill in the art ("POSITA") would have consulted it, because Meyers pertains to ladders and the bracket is used to hang tools from a ladder. Under factor (b) ["the cumulative nature of the asserted art and the prior art evaluated during examination"], Meyers cannot be considered cumulative because it provides that important teaching which is absent in Ng, Otrusina, and Dennis.

Turning to factor (d) [the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art], it is important to note that Patent Owner argued repeatedly during prosecution that Ng was not at all relevant because picture-hanging brackets are non-analogous art to ladders, would not be pertinent to solving the problem of attaching tools to ladders, and such a reference would not be consulted by a POSITA. See EX1002, Amendment of March 12, 2024, 18-19; Amendment of December 18, 2024, 10-12; EX1018, ¶¶ 6-8; EX1023, ¶ 7. However, Otrusina is a device for attaching items to a belt, and Dennis is a device for attaching a net to a goal post, making them also non-analogous art. Had either

been applied, Patent Owner could have, and almost certainly would have, argued as it did with Ng that they are not relevant.

Petitioner has pointed out in the Petition and supporting evidence that Meyers *is* analogous art, being from the field of ladders. Paper 2 at 31-32, 109; EX1003, ¶¶ 60, 81, 148. If Meyers had been cited and applied by the Examiner during prosecution, Patent Owner's non-analogous art line of argumentation would have been unavailing.

It is true that the Petition proposes to modify Moss '481 by substituting the bracket of Meyers for the magnet. Paper 2 at 46-50, 82-85; EX1003, ¶¶ 83-90, 149-156. And this reasoning is similar to the Examiner's proposal to modify Moss '918 by substituting Ng for the magnet. EX1002, Office Action of September 5, 2024, at 6-8, 14-16. During prosecution, however, the Patent Owner did not argue that the structure of the Moss/Ng combination differed from the claimed invention – rather, it argued that Ng was not analogous art that could not be combined with the ladder of Moss '481. Moreover, it asserted that declaration evidence it provided of purported secondary considerations showed its invention is non-obvious. EX1002, Amendment of December 18, 2024, p. 9. The Examiner ultimately erred by crediting Patent Owner's faulty secondary consideration evidence and by accepting Patent Owner's argument that "[a] designer would not have turned to any

picture frame brackets for inspiration in modifying a hinge button. Picture frame brackets are placed on a small object (e.g., a picture frame) to support it on a larger object (e.g., a wall)." Together, these convinced the Examiner to allow the '506 Patent claims. EX1002, Notice of Allowance of April 16, 2025, p. 3.

Here, Petitioner has provided Meyers, which is analogous art, and has explained in detail with testimony of Jon Ver Halen (a POSITA) why and how a POSITA would have modified Moss '481 with the ladder accessory mount of Meyers, dispensing with the need to explain why a POSITA would have consulted unrelated prior art as the Examiner was forced to do. Moreover, Petitioner has shown that Patent Owner's secondary consideration evidence is fatally flawed and the Examiner erred in crediting it. Petitioner's arguments and evidence clearly do not "overlap" with those presented during prosecution to any significant degree.

For as much as Patent Owner tries to minimize or ignore its import, Meyers provides a teaching that none of Ng, Otrusina, and Dennis do. While Moss '481 is the "same art" considered in prosecution, Meyers is not. Factors (a), (b), and (d) all support institution, and discretionary denial should not be exercised.

C. The Second Prong Of The *Advanced Bionics* Analysis Also Weighs In Favor of Instituting PGR.

"Only if the Board determines that the same or substantially the same art or arguments were previously presented to the Office does the Board then consider

the second part of the *Advanced Bionics* framework — whether the petitioner has demonstrated material error by the Office." *Wolfspeed, Inc., v. Trustees of Purdue Univ.,* IPR2022-00761, Paper 13 at 7 (Director, March 30, 2023). Therefore, since it has been demonstrated above that the Petition does not involve the "same or substantially the same art or arguments," the Director need not reach the second prong of *Advanced Bionics*. Nonetheless, Petitioner offers the following comments to demonstrate that the Office materially erred in granting the '506 Patent.

First, Patent Owner asserts that "factor (c) [the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection] weighs in favor of denial, or at worst, is neutral," and cites *Ecto World, LLC et al. v. Rai Strategic Holdings, Inc.* in support. Paper 10 at 13. Patent Owner's reference to *Ecto World* is materially misleading – on remand, the Board in fact *declined* to exercise its discretion to deny institution under § 325(d), and instead denied institution under § 314(a) because of pending litigation. *Ecto World, LLC et al. v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 16 at 26 (PTAB June 25, 2025). *Ecto World* simply does not support Patent Owner's argument that factor (c) weighs in favor of denial or is neutral.

Otrusina and Dennis were found by the Examiner in searching but never applied in any rejection.[2] The face of the '506 Patent lists 72 references considered by the Examiner. USPTO statistics indicate that 87% of applications cite fewer than 50 references, and 77% cite fewer than 25. Setting and Adjusting Patent Fees During Fiscal Year 2025, 89 Fed. Reg, 91898, 91924 (November 20, 2024). This places the '506 Patent application well above an average application in terms of the number of references reviewed. Also, the '506 Patent application was filed as a Track One Prioritized Examination application under 37 C.F.R. § 1.102. EX1002, Track One Request of October 19, 2023. This means that the application was taken up special ahead of other applications on the docket, and facing the Examiner with a compressed timeline for searching, evaluation of references, and examination.

Based on these facts, a more analogous case is *Samsung Elecs. Co., Ltd. et al. v. Power2B, Inc*. In *Samsung*, a certain reference relied upon in an IPR petition was cited in an IDS late in prosecution along with 46 others. Noting that the record was silent as to any evaluation by the Examiner of the reference cited in the

[2] Otrusina was cited by the Examiner along with 43 other references including Ng. Dennis was cited by the Examiner along with 8 other references. EX1002, List of References Cited By Examiner, December 12, 2023 and March 25, 2024.

petition, the Board declined to find that factor (c) was met, such as would warrant denial of institution. *Samsung Elecs. Co., Ltd. et al. v. Power2B, Inc*., IPR2021-01190, Paper 11 at 19 (PTAB Jan. 6, 2022). Certainly, the present case where 72 references had to be evaluated by the Examiner under a compressed timeline presents an even more compelling case for finding that factor (c) favors the Director declining to exercise discretionary denial.

Patent Owner also asserts that factors (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] favor denial of institution. Patent Owner's arguments misapply the factors, faulting Petitioner for not addressing the "one-piece/two-piece" rubric and improperly raise its not-yet-filed Preliminary Response. Paper 10 at 13-14. But factor (f) requires examination of "additional evidence and facts *presented in the Petition*," not analysis of Patent Owner's after-the-fact arguments. Patent Owner also ignores the new evidence provided by Petitioner and downplays the effect of its arguments during prosecution.

The prosecution record establishes two explicit reasons why the Examiner allowed the '506 Patent claims: (1) Patent Owner convinced the Examiner that a

POSITA "would not glean over to a wall mounting bracket, especially to introduce it onto a push activation button on a hinge of a ladder intended to be pressed for activation, where the bracket would permanently be mounted even when there are no tools hanging, and that indeed it would hinder or at least apply uncomfortable pressure to the palm of the user"; and (2) "[t]he long-felt need and commercial success proven by the state of the art, 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." EX1002, Notice of Allowance of April 16, 2025, p. 3. Given the Examiner's words, it is beyond dispute that Patent Owner's declaration evidence played a crucial role in obtaining allowance of the '506 Patent. The Examiner, however, should have recognized that this evidence was defective. His reliance on it was error. Paper 2 at 93-101, 110-111.

Patent Owner's claim that Petitioner "does not offer any new facts not before the Examiner for the Board to consider" on the issue of "long-felt need" is mistaken. The declaration of Jon Ver Halen provides detailed testimony from a POSITA pointing out the self-contradictory nature and oversimplification of Patent Owner's expert declarations – declarations that the Examiner erroneously credited in allowing the '506 Patent claims. EX1003, ¶¶ 175-177. In particular, Ver Halen

explains that giving up on a new design because it requires 50-80 hours of design effort in no way supports a finding of long-felt but unmet need. EX1003, ¶ 177

Patent Owner also dismisses the Petition arguments contesting the defective "commercial success" declaration evidence as "only attorney argument." However, it does not explain how another party could possibly offer evidence to counter Patent Owner's claims of commercial success – that information is known only to Patent Owner. Regardless, Patent Owner misapprehends Petitioner's argument. Namely, that Patent Owner failed to prove a nexus to the claimed invention for its "19% improvement in sales volume." Therefore, Patent Owner's commercial success evidence is *prima facie* insufficient as a *matter of law*, and the Examiner erred in giving it any weight. Paper 2 at 97-98. That is a legal, not a factual issue, and as such it is appropriately addressed with attorney argument.

As to copying, Patent Owner's "evidence" amounts to supposition, assumed bad motive, and cannot be properly viewed as expert testimony. As such, the Examiner should have viewed the assertion of copying with skepticism. Regardless, Petitioner offered sworn declarations from two employees who attested to independent design and no access to Patent Owner's design, as well as seven pages of internal 2022 Tricam design sketches and notes to support that testimony. Paper 2 at 94-96, EX1004, EX1005, EX1027. Patent Owner addresses neither the

second declaration nor the sketches, stating that a single declaration "does not on its own warrant institution." Paper 2 at 14. Again, Patent Owner simply ignores the extensive "additional evidence and facts" that "warrant reconsideration" of Patent Owner's "copying" claims. And as argued in the Petition, contemporaneous invention is evidence of *obviousness*, not non-obviousness. Paper 2 at 95.

Petitioner has presented evidence that Examiner error caused allowance of the '506 Patent. Factor (e) favors institution. Further, the Petition has presented additional evidence and facts that warrant reconsideration of the prior art or arguments. Thus, factor (f) also favors institution.

D. The Section 112 Grounds Alleged In The Petition Demonstrate Examiner Error.

Finally, with respect to Grounds 2-5 alleging invalidity under 35 U.S.C. § 112 ("§ 112"), Petitioner notes that the *Advanced Bionics* framework focuses on challenges involving prior art only, perhaps because it arose in the context of IPRs where § 112 challenges are not allowed. Since PGR explicitly authorizes challenges on § 112 grounds, PGR must be possible, even if no prior art challenge is presented. 35 U.S.C. § 321(b).

Here, Petitioner has presented analysis, accompanied by sworn testimony from a POSITA, showing that a POSITA would find the claims of the '506 Patent incomprehensible. Paper 2 at 26-30, 101-105; EX1003, ¶¶ 55-56. Patent Owner

attempts to dismiss this challenge, arguing first that original claims are essentially immune from § 112 written description challenge, and second that the Examiner thoroughly examined the claims and therefore there can be no errors. Paper 10 at 15-17. These arguments are specious and should be discounted.

First, there are limits to the truism stated in *In re Gardner* cited by Patent Owner that original claims are self-supporting. Paper 10 at 15-16; *In re Gardner*, 480 F.2d 879, 879-80 (C.C.P.A. 1973). As explained in the *Ariad* opinion, an original claim directed to "a perpetual motion machine," for example, is not necessarily self-supporting. *Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1349 (Fed. Cir. 2010) (en banc). "Although many original claims will satisfy the written description requirement, certain claims may not." *Id.*

Here, Petitioner's argument is that the '506 Patent claims literally recite structures and operations that are *physically impossible*. Paper 2 at 103-105; EX1003, ¶¶ 55-56. As such, they *cannot* be supported by written description and must be indefinite. *Id.*

Patent Owner counters that Petitioner has proposed a claim construction that will "cure the alleged indefiniteness and written description issues in the claims." Paper 10 at 16. This mischaracterizes Petitioner's arguments in the Petition. Petitioner's discussion of claim construction was an attempt to parse the meaning

of incomprehensible limitations to enable prior art analysis, not a suggestion for the Board to rewrite the claims. Paper 2 at 28, 30. "[C]ourts should not rewrite claims to preserve validity." *Nazomi Commc'ns, Inc. v. Arm Holdings, PLC,* 403 F.3d 1364, 1368 (Fed. Cir. 2005).

Patent Owner complains that finding claims 1-13 invalid under § 112 would be "drastic." Paper 10 at 16. A harsh result perhaps, but "if the only claim construction that is consistent with the claim's language and the written description renders the claim invalid, then the axiom [that claims should be construed to preserve validity, if possible] does not apply and the claim is simply invalid." *Rhine v. Casio*, 182 F.3d 1342, 1345 (Fed. Cir. 1999). In any event, Patent Owner can move to amend its claims if PGR is instituted. 35 U.S.C. § 326(d).

Patent Owner also argues its claims should not be scrutinized under § 112 because they have already been examined and issued. Paper 10 at 17. If that were the case, no PGR could ever be instituted on § 112 grounds, because *every* patent claim is examined for § 112 compliance. Like all humans though, Examiners make mistakes. The errors contained in the '506 Patent claims are explained in detail in the Petition, and it is clear the Examiner overlooked them. Paper 2 at 101-105.

E. Trial Should Be Instituted According To USPTO Policy Favoring PGRs.

Petitions for post-grant review are favored because they must be filed no later than nine months from the patent grant (35 U.S.C. § 321(c)), are close in time to examination, and occur before expectations in the patent rights are strongly settled. *Multi-Color Corporation v. Brook & Whittle Ltd.*, PGR2025-00025, Paper 10 at 2-3 (Director, July 16, 2025) (precedential). Petitioner respectfully submits it has presented persuasive reasoning, supported by evidence, that discretionary denial under 35 U.S.C. § 325(d) is improper. Therefore, as in *Multi-Color*, the Director should deny Patent Owner's request and institute PGR for the '506 Patent.

F. Conclusion.

In summary, the PGR Petition in this case presents Meyers, new prior art with a critical new teaching that was not considered in prosecution of the '506 Patent, and that in combination with Moss '481, renders claims 1-13 of the '506 Patent invalid. The arguments presented are different because Meyer is analogous art, unlike the references considered in prosecution. Petitioner has also demonstrated in the Petition that the Examiner erred in allowing the '506 Patent claims based on defective declaration evidence of secondary considerations. And Petitioner has presented new facts and evidence not available during prosecution. For these reasons, discretionary denial is not warranted.

Dated: July 21, 2026

Respectfully submitted,

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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:

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