

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APEX TOOL GROUP, LLC,
Petitioner,

v.

MILWAUKEE ELECTRIC TOOL CORPORATION,
Patent Owner.

Case No. PGR2020-00056
Patent 10,422,617

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
Ex. 2001	Declaration of Expert Witness Dr. Kimberly Cameron
Ex. 2002	Declaration of Inventor Abhijeet A. Khanagar
Ex. 2003	Canadian Woodworking & Home Improvement Website on Release of Certain of Milwaukee Electric Corporation's Canadian Wide Blade (CAWB) Tape Measures in Canada
Ex. 2004	Claim Construction Order from Case No. CDCA-8-03-cv-00655-60
Ex. 2005	Claim Construction Order from Case No. DMN-0-13-cv-01287-155
Ex. 2006	Dictionary Definition of "profile"
Ex. 2007	Dictionary Definition of "such that"
Ex. 2008	Patent Office Assignment Record for Gilliam reference of Ex. 1013
Ex. 2009	Milwaukee Tool Internal stand out issue analysis 8-May-2017
Ex. 2010	Dr. Kimberly Cameron's Curriculum Vitae (CV)
Ex. 2011	Dr. Kimberly Cameron's Testifying Experience
Ex. 2012	Dictionary Definition of "define"

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.107(a), Patent Owner Milwaukee Electric Tool Corporation (“Patent Owner” or “Patent Owner Milwaukee Tool”) submits this preliminary response to the petition (Paper 1, “Petition”) to demonstrate that institution is wholly unwarranted. The Petition is fatally flawed because its eight grounds fall well short of establishing a reasonable likelihood of success as to sole independent claim 1. The Petition’s deficiencies range from (i) relying on alleged AAPA that is not statutory prior art (Grounds 1-3); (ii) requiring claim construction positions that mischaracterize the intrinsic record to make the Craig reference relevant, when it clearly is not under proper constructions of the claim terms (Grounds 4-5); and (iii) proposing a modification to Murray that Murray teaches away from (Grounds 6-8).

In short, instituting would be a waste of the Board’s limited resources as the Petition cannot succeed in demonstrating unpatentability as to the sole independent claim, so there is no reasonable likelihood of success as to any of challenged claims 1-11.

II. OVERVIEW OF PETITIONER’S GROUNDS AND SUMMARY OF REASONS TO DENY INSTITUTION

Petitioner alleges the following eight grounds of unpatentability:

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