

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

ONE WORLD TECHNOLOGIES, INC., D/B/A TECHTRONIC
INDUSTRIES POWER EQUIPMENT,
Petitioner,

v.

CHERVON (HK) LIMITED,
Patent Owner.

Case IPR2020-00886
Patent 9,826,686

PATENT OWNER'S PRELIMINARY RESPONSE

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TABLE OF EXHIBITS

Exhibit No.	Description
2001	District Court Litigation Docket in the District Court Litigation ("District Court Litigation Docket")
2002	Scheduling Order in the District Court Litigation ("Scheduling Order")
2003	Petitioner's Initial Invalidity Contentions in the District Court Litigation ("Petitioner's Initial Invalidity Contentions")
2004	Declaration of Mike Clancy
2005	Techtronic 2019 Annual Report
2006	Defendants' Rule 7.1 Corporate Disclosure Statement in the District Court Litigation ("Defendants' Rule 7.1 Corporate Disclosure Statement")
2007	Defendants' Answer to Plaintiffs' Second Amended Complaint in the District Court Litigation ("Defendants' Answer to Plaintiffs' Second Amended Complaint")
2008	Techtronic and Petitioner's Objections and Responses to Patent Owner's Second Set of Interrogatories in the District Court Litigation ("Techtronic and Petitioner's Objections and Responses to Patent Owner's Second Set of Interrogatories")
2009	Reserved
2010	Reserved
2011	Reserved
2012	Reserved
2013	EP0903074 to Outils-Wolf
2014	U.S. Patent No. 3,659,170 to Burkett
2015	U.S. Patent Publication No. 2014/0331809 to Mikula
2016	U.S. Patent No. 3,942,604 to Black
2017	U.S. Patent Publication No. 2010/0162674A1 to Eaton
2018	U.S. Patent Publication No. 2014/0190141 to Edholm

Patent Owner Chervon (HK) Limited (“Patent Owner”) submits this Preliminary Response in accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107 in response to the Petition filed by One World Technologies, Inc., d/b/a Techtronic Industries Power Equipment (“Petitioner”) requesting inter partes review of Claims 1-20 (“Challenged Claims”) of U.S. Pat. No. 9,826,686 (“the ‘26686 patent”). Patent Owner timely filed this Preliminary Response under 37 C.F.R. § 42.107(b) within three months of the mailing date of the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response.

I. INTRODUCTION

The Petition seeks review of Claims 1-20 of the ‘26686 patent based on two different grounds. The Board should decline to institute an inter partes review here because Petitioner’s Petition suffers from numerous defects.

First, the Board should exercise this discretion and deny this Petition because the same or substantially the same prior art or arguments were previously presented to the Patent Office and are currently at issue in a parallel litigation.

Second, the references and combination of references fail to disclose several claim limitations.

Third, the Petition does not identify any reason, let alone a sufficient reason, why one having ordinary skill in the art would have been motivated to combine the asserted references to arrive at the inventions of the Challenged Claims.

Fourth, the Petition fails to identify two real parties in interest.

II. BACKGROUND

A. The '26686 Patent.

The application that resulted in the '26686 patent, Application No. 15/250,408 was filed on August 29, 2016. (EX1001, '26686 patent, at (22).) The '26686 patent is a continuation of Application No. 14/511,490, which was filed on October 10, 2014, and is now U.S. Patent No. 9,596,806.¹ (EX1001, '26686 patent, at (63).) The application also claims priority to two foreign applications, CN 2013 1 0468919, which was filed on October 10, 2013, and CN 2014 1 0167041, which was filed on April 23, 2014. (*Id.* at (30).) The '26686 patent is subject to the first to invent provisions of the AIA. Petitioner is not challenging the actual priority date in its Petition. (Paper 1 at 12.)

The '26686 patent, titled "Gardening Tool," is generally directed toward a gardening tool, such as a lawn mower, with certain performance and safety features. (EX1001, '26686 patent, at (54); (57).) The patented safety features protect a user from injury by controlling when power can be safely delivered to the mower while simultaneously permitting safe and easy storage of the tool through the use of

¹ Petitioner has filed an *Inter Partes* Review petition against U.S. Patent No. 9,596,806 as well. (*See* IPR2020-00884.)

rotating and telescopic handles. The safety features prevent activation of the mower when the mower is not in its proper operational position:

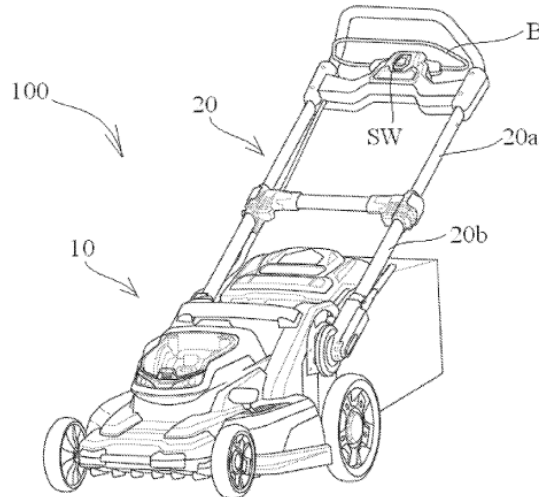


FIG.1

Independent claims 1 and 11 of the '26686 patent cover a gardening tool or lawn mower with: (1) an operation assembly for controlling the motor; (2) a control system comprising a first control device and a second control device, where the second control device is controlled according to the rotating position of the handle; and (3) a locking mechanism for locking the rotating position of the handle. The second control device can lock or unlock the first control device so that the first control device allows the motor to start. (EX1001, '26686 patent, at claims 1 and 11.) The independent claims are reproduced below:

1. A gardening tool, comprising:

a main body having at least a functional accessory and a motor for driving the functional accessory;

a handle, rotatably connected to the main body, having at least one operation assembly for being operated by a user to control the motor when the handle is in a secure position;

a locking mechanism for locking the rotating position of the handle;

a locking member configured to engage with the locking mechanism and providing at least a locking structure to cause the locking mechanism to keep the handle at an accommodating position relative to the main body when the gardening tool is not being used; and

a control system capable of preventing the motor from being controlled by the operation assembly and halting the motor when the handle is out of the secure position, the control system comprising:

a first control device configured to be controlled by the operation assembly; and

a second control device configured to be controlled according to the rotating position of the handle wherein, when the handle rotates to a designated position relative to the main body, the second control device unlocks the first control device so that the first control device allows starting of the motor, and, when the handle rotates to the accommodating position relative to the main body, the second control device locks the first device so that the first control device is not allowed to start the motor; and

wherein the second control device comprises at least one of a switch connected to the power supply circuit and a signal source device for sending a control signal to control the motor.

(*Id.* at claim 1.)

11. A mower, comprising:

a main body having at least a functional accessory and a motor for driving the functional accessory;

a handle, rotatably connected to the main body, having at least one operation assembly for being operated by a user to control the motor when the handle is in a secure position;

a locking mechanism for locking the rotating position of the handle;

a locking member configured to engage with the locking mechanism and providing at least a locking structure to cause the locking mechanism to keep the handle at an accommodating position relative to the main body when the mower is not being used; and

a control system capable of preventing the motor from being controlled by the operation assembly and halting the motor when the handle is out of the secure position, the control system comprising:

a first control device configured to be controlled by the operation assembly, and

a second control device configured to be controlled according to the rotating position of the handle wherein, when the handle rotates to a designated position relative to the main body, the second control device unlocks the first control device so that the first control device allows starting of the motor, and, when the handle rotates to the accommodating position relative to the main body, the second control device locks the first device so that the first control device is not allowed to start the motor, and

wherein the second control device comprises at least one of a switch connected to the power supply circuit and a signal source device for sending a control signal to control the motor.

(*Id.* at Claim 11.)

B. The Prosecution History Of The ‘26686 Patent.

During prosecution of the application resulting in the ‘26686 patent, Applicant’s first information disclosure statement listed a single reference—EP 0903074 to Outils. (EX1002, ‘26686 patent PH, at 267-292.) This reference is the European counterpart of the primary reference cited by Petitioner in this Petition, FR 2,768,300 to Outils. EP 0903074 and FR 2,768,300 share a virtually identical specification. (*Compare* EX2013, EP0903074 *with* EX1013, FR 2,768,300.) After reviewing this information disclosure statement, as well as another information disclosure statement submitted by Applicant, the Examiner issued a Notice of Allowance. (EX1002, ‘26686 patent PH, at 18-41.) The application issued as the ‘26686 patent on November 28, 2017. (*Id.* at 1.)

C. The Level Of Ordinary Skill In The Art.

For the purposes of this preliminary response only, Patent Owner adopts Petitioner’s proposed level of ordinary skill in the art.

III. LEGAL STANDARDS

“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable

likelihood that the petition would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

In an *Inter Partes* Review, the Petitioner bears the burden of persuasion to prove unpatentability by a preponderance of the evidence. *See Dynamic Drinkware, LLC v. Natl. Graphics, Inc.*, 800 F.3d 1375, 1379 (Fed. Cir. 2015). The Board “will not consider arguments and information that are not presented and developed in the Petition...” *See DIRECTV, LLC v. Qurio Holdings, Inc.*, IPR2015-02007, Paper No. 6 at 14 (PTAB April 4, 2016); *see also Valeo North America, Inc. v. Magna Electronics, Inc.*, IPR2014-01206, Paper No. 13 at 17 (PTAB Dec. 23, 2014) (“we will not consider an argument not made in the petition.”). “A reference qualifies as prior art for an obviousness determination only when it is analogous to the claimed invention.” *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1379 (Fed. Cir. 2019).

IV. CLAIM CONSTRUCTION

The Federal Circuit has held that only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Here, Petitioner has proposed constructions for the terms “power supply circuit” and “locks/unlocks.” (Paper 1 at 12-17.) Patent Owner believes that no construction is required for these terms at this time because the construction of these terms is not relevant to the issues raised herein.

Nevertheless, should the Board decide to institute review of the '26686 patent, Patent Owner reserves the right to propose alternate constructions for the above terms and/or any additional terms of the Challenged Claims of the '26686 patent.

V. THE BOARD SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. 325 TO DENY INSTITUTION OF REVIEW.

The primary reference Petitioner uses in both grounds—Outils—has already been expressly considered by the United States Patent and Trademark Office (“PTO”) during prosecution of the '26686 patent. Accordingly, because Petitioner bases its grounds for institution on art that has been previously before the PTO and that is cumulative of art previously before the PTO, the Board should exercise its discretion and decline to institute review under 35 U.S.C. § 325(d).

“In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

The Board has adopted the following framework for the § 325(d) analysis:

(1) Whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review. 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. ***At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.***

Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH, IPR2019-01469, Paper 6 (Feb. 13, 2020) (footnote omitted; emphasis added). Applying the *Advanced Bionics* framework may benefit from reference to the *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.

Id. at 9 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017)). Factors (a), (b), and (d) relate to step (1) of the *Advanced Bionics* framework, and factors (c), (e), and (f) relate to step (2) of the *Advanced Bionics* framework. *Id.* at 10. Applying the *Advanced Bionics* framework should lead the Board to exercise its discretion and decline to institute review under 35 U.S.C. § 325(d).

A. *Advanced Bionics* (1): Petitioner Bases Its Challenges On The Same Or Substantially The Same Art Before The Examiner During Prosecution.

1. Petitioner's Alleged Grounds For Institution Rely Heavily On Outils.

Both of Petitioner's Grounds rely on Outils as a primary reference. Patent Owner disclosed Outils during prosecution of the application that led to the '26686 patent. Ground 1 relies on the combination of Outils in view of Roelle and Matsunaga to challenge independent claims 1 and 11 and dependent claims 2-6 and 12-17 of the '26686 patent. (Paper 1 at 27.) Notably, Petitioner relies *solely* on Outils to supply all but one of the elements of challenged independent claims 1 and 11:

- [1P] A gardening tool, comprising: / [11P] A mower, comprising:
- [1a] / [11a] a main body having at least a functional accessory and a motor for driving the functional accessory;
- [1b] / [11b] a handle rotatably connected to the main body, having at least one operation assembly for being operated by a user to control the motor when the handle is located in a secure position;
- [1e] / [11e] a control system capable of preventing the motor from being controlled by the operation assembly and halting the motor when the handle is out of the secure position, the control system comprising:
- [1f] / [11f] a first control device configured to be controlled by the operation assembly;
- [1g] / [11g] a second control device configured to be controlled according to the rotating position of the handle wherein, when the handle rotates to a designated position relative to the main body, the second control device unlocks the first control device so that the first control device allows starting

of the motor, and, when the handle rotates to the accommodating position relative to the main body, the second control device locks the first device so that the first control device is not allowed to start the motor;

(*Id.* at 27-40.) Petitioner relies on Outils in combination with Roelle or Matsunaga to supply the remaining three elements of challenged independent claims 1 and 11:

- [1c] / [11c] a locking mechanism for locking the rotating position of the handle (*id.* at 33-35);
- [1d] / [11d] a locking member configured to engage with the locking mechanism and providing at least a locking structure to cause the locking mechanism to keep the handle at an accommodating position relative to the main body when the gardening tool is not being used (*id.* at 36-37);
- [1h] / [11h] wherein the second control device comprises at least one of a switch connected to the power supply circuit and a signal source device for sending a control signal to control the motor (*id.* at 41-44)

(*Id.* at 37-40.) In sum, Petitioner relies on Outils alone to supply two-thirds of the elements of the challenged independent claims and on Outils in combination with a secondary reference(s) for the remaining elements.

Petitioner also relies heavily on Outils to challenge dependent claims 2-7 and 12-17 (of Ground 1) and dependent claims 8-10 and 18-20 (Ground 2)² because they depend from independent claims 1 and 11. (See *id.* at 44-67.)³

² Ground 2 relies on the combination of Outils in view of Roelle, Matsunaga, and in further view of Langdon and Nakano. (*Id.* at 51-67.)

³ Petitioner relies solely on Outils to supply the dependent limitations [2a] / [12a], [9a] / [19a], and [10a] / [20a]. (*Id.* at 44-45, 64.)

Petitioner's heavy reliance on Outils in its Petitions strongly supports denying institution under 35 U.S.C. § 325(d) because, as shown below, Outils and other references cumulative to the secondary references that Petitioner relies on here were disclosed during prosecution of the application that led to the '26686 patent.

2. The *Becton, Dickinson* Factors Confirm That Petitioner Has Presented The Same Or Substantially The Same Art Previously Presented To The Office In Its Petition.

Applying *Becton, Dickinson* factors (a) and (b)⁴ confirms that step (1) of the *Advanced Bionics* framework is satisfied, and the Board should hold that Petitioner has presented the same or substantially the same art previously presented to the Office in its Petition.

a. Factor (a): The primary asserted reference here, Outils, was disclosed during the prosecution of the '26686 patent application.

There is no dispute that Patent Owner disclosed Outils during examination. Outils is listed on the face of the '26686 patent. (EX1001, '26886 patent, at (56).) Specifically, during prosecution of the patent application that led to the '26686 patent, Patent Owner submitted an Information Disclosure Statement ("IDS") identifying *only* Outils by its patent number, publication date, and named inventor. (EX1002, '26686 patent PH, at 267-292.) The disclosed reference is the

⁴ Factor (d) relates to overlapping *arguments* as opposed to overlapping *art*.

European counterpart of the primary reference cited by Petitioner in this Petition, FR 2,768,300 to Outils. EP 0903074 and FR 2,768,300 share a virtually identical specification. (*Compare* EX2013, EP0903074, with EX1013, FR 2,768,300.) The Examiner attached a signed version of Patent Owner's IDS stating that "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH." (EX1002, '26686 patent PH, at 40.) The Examiner did not line through Outils. (*Id.*) Petitioner does not dispute that Patent Owner identified Outils during prosecution. (Paper 1 at 28.) Thus, there is no dispute that Outils—the primary reference upon which Petitioner relies in its Petition—was previously presented during examination, which strongly supports denying institution under § 325(d).

b. Factor (b): the secondary references are cumulative to the prior art evaluated during the prosecution of the '26686 patent application.

The remaining secondary references (*i.e.*, Roelle, Matsunaga, Langdon, and Nakano) are cumulative to prior art evaluated during examination. As shown below, each of the individual features for which Petitioner relies on its secondary references

are cumulative to features described by the prior art disclosed during examination of the '26686 patent.⁵

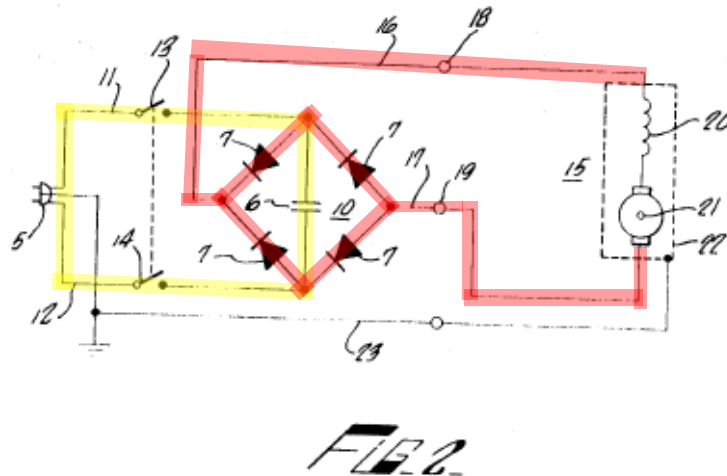
Roelle (lawnmower with rotating handle): Petitioner claims that Roelle teaches a walk-behind mower “similar to Outils” with a rotating handle and a locking mechanism for locking the handle in place. (Paper 1 at 34.) Roelle’s disclosure is cumulative of at least U.S. Patent Publication No. 2014/0331809 to Mikula (“Mikula”). Mikula discloses a walk-behind lawn mower that has an adjustable, rotating handle that folds over the mower body. (EX2015, Mikula, Abstract.) According to Mikula, “In operation, the operator holds the bail 190 in the first position (FIG. 4) against the user graspable portion 175 of the handle 135 while operating the lawnmower 110. When the bail 190 is released, the bail 190 returns to the neutral position (FIG. 3) and the engine 125 ceases to operate. If the operator wishes to fold the handle 135 into a storage position (*pivoted forward across the mower deck* 155) or if the operator wishes to adjust the height of the user-graspable

⁵ As shown in Section VII, *infra*, Patent Owner disagrees with Petitioner’s interpretation of the references upon which it relies, including with respect to whether they constitute analogous art and what they disclose. However, for purposes of this Section only, Patent Owner accepts Petitioner’s interpretations of the references to establish cumulativeness.

portion 175, the operator pushes the bail 190 into the second position (FIG. 5).” (EX2015, Mikula, at [0025] (emphasis added).) Mikula further teaches “a locking mechanism locking the user-graspable portion of the handle at a desired height, and an actuator incorporated into the control,” where the “the locking mechanism includes a receiving plate mounted to the frame and including at least one receiving aperture; wherein the locking mechanism further includes a retractable pin supported on the handle” in terms at least as clear as Roelle. (*Id.* at Abstract; [0022]; Claim 5.) Thus, Mikula explicitly discloses rotating handles and a locking mechanism in terms at least as clear as Roelle’s. For this reason, Roelle is cumulative of Mikula’s disclosure.

Matsunaga (string trimmer): Petitioner claims that Matsunaga discloses a separate circuit that powers the contact switches that control the power state of the motor to more safely control the flow of power through the power supply circuit to the motor. (Paper 1 at 41-44.) Matsunaga’s disclosure is cumulative of at least U.S. Patent No. 3,659,170 to Burkett (“Burkett”). Burkett discloses a plug-in electric lawnmower that uses a separate circuit that uses two switches connected to a rectifier circuit to completely disconnect the power source from the motor as a safety precaution. (EX2014, Burkett, at 3:25-30 (“The voltage is applied to rectifier circuit through switches 13 and 14 provided in lines 11 and 12, respectively. Two switches are provided so that the source of electricity is completely disconnected from the

motor as a further safety feature. However, a single switch in one line could also be employed.”.) Burkett’s Figure 2 (below) shows that the circuit containing the two contact switches (highlighted yellow) is wholly separate from the rectifier circuit 10 and the circuit that supplies power to the motor 15 (highlighted red):



(*Id.* at FIG. 2.) Thus, Matsunaga’s alleged disclosure of a separate circuit used to power the contact switches from the power supply circuit is cumulative of Burkett’s disclosure noted above.

Langdon (lawnmower with telescoping and rotating handles): Petitioner relies on Langdon for several handle-related features.

Petitioner claims that Langdon discloses a handle that rotates over the main body of a mower for storage purposes. (Paper 1 at 20-21, 52-53.) Langdon’s disclosure is cumulative of at least Mikula. Mikula discloses a walk-behind lawn mower that has an adjustable, rotating handle that folds over the mower body. (EX2015, Mikula, Abstract.) According to Mikula, “In operation, the operator holds

the bail 190 in the first position (FIG. 4) against the user graspable portion 175 of the handle 135 while operating the lawnmower 110. When the bail 190 is released, the bail 190 returns to the neutral position (FIG. 3) and the engine 125 ceases to operate. If the operator wishes to fold the handle 135 into a storage position (*pivoted forward across the mower deck* 155) or if the operator wishes to adjust the height of the user-graspable portion 175, the operator pushes the bail 190 into the second position (FIG. 5).” (EX2015, Mikula, at [0025] (emphasis added).) Mikula explicitly discloses pivoting the mower handle “across the mower deck” in terms at least as clear as Langdon. For this reason, Langdon is cumulative of Mikula’s disclosure.

Petitioner also claims that Langdon discloses a telescoping handle. (Paper 1 at 20-21, 52-53.) Langdon’s disclosure is cumulative of at least Chinese Patent No. CN102683052A. CN102683052A discloses telescoping members that incorporate a switch that can be opened or closed depending on the location of two or more telescoping members relative to one another. (EX1002, ‘22686 patent PH, CN 102683052, at 153-160 (Abstract).) Specifically, CN102683052A is directed to a switch that can be open or closed depending on the position of telescoping members

relative to one another. (*Id.*) Thus, the alleged telescoping handles of Langdon are cumulative to the system described in CN102683052A.⁶

Nakano (telescoping handle for a hand-held bush cutter): Petitioner claims that Nakano discloses a control device that operates in conjunction with telescoping handles. (Paper 1 at 25-26, 54-64.) Nakano's alleged disclosure is cumulative of at least Chinese Patent No. CN102683052A. CN102683052A discloses a control device that operates in conjunction with a telescoping handle. Specifically, CN102683052A is directed to a switch that can be open or closed depending on the

⁶ Petitioner also references Langdon's disclosure of a spring-biased pin used to adjust and lock handles. (Paper 1 at 21.) Notably the use of a spring-biased pin is not required by any of the challenged claims. Nevertheless, the use of spring-biased pins to lock rotating and telescoping handles was disclosed to the Examiner during the prosecution of the '26686 patent. (*See, e.g.*, EX2018, U.S. Pub. No. 2014/0190141 to Edholm ("Edholm") at FIGS. 3B, 5B, [0057], [0063]-[0066]; EX2015, Mikula at [0023]; EX1002, '26686 patent PH, at 158 (CN102683052 disclosing a switch that can be opened or closed depending on the position of telescoping members relative to one another), 159 (CN102683052 describing how an appropriately sized spherical contact can be pinned against an elastic telescoping member to lock members in place).)

position of telescoping members relative to one another. (EX1002, '26686 patent PH, at 153-160 (CN102683052, at Abstract.) Thus, the alleged control device that operates in conjunction with the telescoping handles of Nakano is cumulative to the system described in CN102683052A.

The Examiner fully considered Burkett, Mikula, and CN102683052A. The Examiner attached a signed version of Patent Owner's IDS disclosing Mikula and CN102683052A, stating that "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH." (EX1002, '26686 patent PH, at 28-29.) The Examiner did not line through Mikula or CN102683052A. (*Id.*) And the Examiner listed Burkett on a Notice of References Cited. (*Id.* at 27.)

Thus, all of Petitioner's secondary references, *i.e.*, Roelle, Matsunaga, Langdon, and Nakano, are cumulative to prior art evaluated during examination of the application that led to the '26686 patent, which further supports denying institution under § 325(d).

B. *Advanced Bionics* (2): Petitioner Has Failed To Demonstrate That The Patent Office Erred In A Manner Material To The Patentability Of The Challenged Claims.

Petitioner's relied-upon art is the same as, or is cumulative to, the art disclosed during prosecution. Thus, Petitioner bears the burden of establishing material error to avoid a denial of institution. *See Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 (Feb. 13,

2020). Incredibly, Petitioner did not even address 35 U.S.C. § 325(d) in its Petition despite acknowledging that the primary reference was disclosed during prosecution. Petitioner also does not address whether its secondary references are cumulative of the references disclosed during prosecution. They are. Ultimately, Petitioner fails to provide any record evidence that the Examiner made a material error with respect to patentability, and Petitioner has failed to carry its burden.

As with step (1) of the *Advanced Bionics* framework, applying the relevant *Becton, Dickinson* factors illustrates why the Board should deny institution under § 325(d).

1. Factor (c): The primary and secondary asserted references were fully considered during the prosecution of the ‘26686 patent application.

Petitioner states that Outils was cited during prosecution but to suggest that the Examiner did not consider Outils, Petitioner notes that Patent Owner submitted only a machine translation of Outils and no figures. (Paper 1 at 28.)⁷ Petitioner is wrong that the Examiner did not consider Outils.

⁷ Notably, Outils Figure 1 was disclosed during examination—it appears on the face of the patent in the abstract section. (EX1002, ‘26686 patent PH, at 272.) The European Patent Office requires that the most important figure(s) be included in the patent’s abstract. (See EPO Rule 47.)

First, the record evidence confirms that the Examiner had the opportunity to consider, and in fact considered, Outils. As noted above, the Examiner explicitly stated that he considered all references unless crossed out, and the Examiner did not cross out Outils.

Second, the fact that Patent Owner submitted a machine translation of Outils is immaterial. Submitting machine translations of foreign references is a routine practice, and Petitioner does not identify any error or violation committed by Patent Owner by submitting a machine translation. Even a cursory comparison between the machine translation submitted during prosecution and the certified translation submitted by Petitioner in support of its Petition confirms that the machine translation was of high quality, understandable by the Examiner, and not materially different than Petitioner's certified translation. (*Compare* EX1002, '26686 patent PH, Machine Translation, at 272-292 *with* EX1014.) And of course, the Examiner had Outils' figures at his fingertips through a quick Internet search at espacenet. In any event, Petitioner's reliance on several of Outils' figures is redundant of its reliance on Outil's specification and Outil's Figure 1, which Patent Owner disclosed during examination. (EX1002, '26686 patent PH, at 272.) For example, Petitioner

shows Outils Figure 5 (and Figure 1)⁸ to support its position that Outils discloses a lawnmower. Outils' title, *i.e.*, "Lawnmower Comprising Safety Device for Preventing Access to the Rotating Cutting Blade," which Petitioner relies on, confirms that Outils discloses a lawnmower. (*See, e.g.*, Paper 1 at 29.) Petitioner also includes Outils Figures 6 and 7 to attempt to illustrate the rotatable handle locking mechanism. Here again, the language of Outils, as opposed to the Figures, are what is important. Figures 6 and 7 do show a locking mechanism, but the features of the locking mechanism are too small and close together to enhance the description provided by the specification and cited by Petitioner. (*See id.* at 32-33.) And finally, Petitioner also shows Outils Figure 10 to show how rotating the handle can cause a cam to trigger a switch. But Figure 10 does not provide any additional information, or even a clear illustration, beyond what Petitioner cites from Outils' specification. (*See id.* at 38.) Ultimately, Petitioner relies almost exclusively on Outils' written disclosure, peppering in the figures in what appears to be an attempt to delicately convey to the Board that the Figures provide additional important disclosure. They do not.

⁸ Patent Owner disclosed Outils Figure 1 during examination. (EX1002, '26686 patent PH, at 272.)

Third, the Examiner never rejected Patent Owner's IDS. An Examiner has an obligation to review an IDS for compliance with 37 C.F.R. 1.97 and 1.98, which includes the requirement to include a copy of submitted foreign patents. MPEP 609.01. By not rejecting Patent Owner's IDS, the Examiner implicitly confirmed that he could and did fully consider Outils. Petitioner does not raise any evidence or argument to the contrary in its Petition.

Additionally, Burkett, Mikula, and CN102683052A were fully considered during examination for the reasons noted in Section V(A)(2), *supra*. Petitioner also does not identify any evidence in its Petition that the Examiner did not consider these references.

Accordingly, this factor supports the conclusion that the Examiner did not materially err in his prior art evaluation.

2. Factor (e): Petitioner has not explained how the examiner erred in its evaluation of the asserted prior art.

As noted above, despite noting that Outils was cited during prosecution, Petitioner incredibly does not address § 325(d) in its Petition. The Board “will not consider arguments and information that are not presented and developed in the Petition...” See *DIRECTV, LLC v. Qurio Holdings, Inc.*, IPR2015-02007, Paper No. 6 at 14 (PTAB April 4, 2016). Indeed, the Board has recently chastised petitioners for failing to address § 325(d) in their petitions when the grounds are based on art previously before the Office. See, e.g., *Microsoft Corp. v. IPA Tech. Inc.*, IPR2019-

00838, IPR2019-00839, IPR2019-00840, Paper 13, at 3 (Apr. 3, 2020) (denying request for rehearing on institution denial under § 325(d) and noting that “[d]espite substantial overlap between the prior art before the Examiner and the prior art relied upon in Petitioner’s challenges to the [] patent, Petitioner did not address 35 U.S.C. § 325(d) in the Petition. ... Because Petitioner fails to demonstrate that we overlooked an argument that was not made, we are not persuaded of error.”). Petitioner chose not to argue that the Examiner misevaluated Outils or any of the references that are cumulative to the secondary references cited in the Petition. Thus, this factor also favors Patent Owner’s position that the Board should exercise its discretion and decline to institute under § 325(d).⁹

VI. THE BOARD SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. 314(a) TO DENY INSTITUTION OF REVIEW.

The Board has discretion under § 314(a) to deny institution of review where institution would be an inefficient use of Board resources in light of a parallel district court action. *See, e.g., NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752,

⁹ With respect to *Becton, Dickinson* factor (f): the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments, none of Petitioner’s evidence and facts presented in its Petition warrants reconsideration of Outils or the other cumulative secondary references for the reasons discussed in Section VII, *infra*.

Paper 8 (PTAB Sept. 12, 2018); *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020). The *Fintiv* decision set forth the following factors for the Board to weigh when deciding whether to deny institution of review based upon a co-pending parallel district court action:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board's exercise of discretion, including the merits.

(*Id.* at 5-6.)

“[I]n evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” (*Id.* at 6 (citations omitted).) Here, the *Fintiv* factors favor denying institution to efficiently use Board resources because otherwise, the same parties would be proceeding with the same invalidity-related arguments at the same time before two separate tribunals.

First, Petitioner did not seek, and the District Court did not grant, a stay in the related case, *Chervon (HK) Limited, and Chervon North America, Inc. v. One World Tech., Inc., and Techtronic Indus. Co. Ltd., and Homelite Consumer Prods., Inc.*, Case No. 1:19-cv-01293-LPS (D. Del.) (the “District Court Litigation”). (See generally EX2001, District Court Litigation Docket.)

Second, the Board's statutory deadline for a final written decision in this action (November 11, 2021) is only several months before the anticipated trial date in the District Court Litigation, and the Court and the parties will have already invested substantial resources into the District Court Litigation by the time the Board is due to issue its final written decision. For example, the parties will have completed claim construction proceedings (briefing is currently complete), fact discovery, and expert discovery, and will have provided the Court with an estimated 250 pages worth of dispositive motions. (EX2002, District Court Litigation, Scheduling Order.)

Third, the issues raised in the Petition directly overlap with the invalidity arguments presented in the District Court Litigation. Petitioner identified every reference upon which it relies in the Petition as part of its Invalidity Contentions in the District Court Litigation. (EX2003, Petitioner's Initial Invalidity Contentions,

at 4-5.) Further, Petitioner identified Outils as a lead reference in its Initial Invalidity Contentions obviousness combinations for the '26686 patent. (*Id.* at 8.)¹⁰

Fourth, Petitioner is a named defendant in the District Court Litigation.

Fifth, the weakness of Petitioner's rehashed invalidity arguments (*see* Section VII, *infra*) also supports denying institution. In view of the above, the Board should deny institution to efficiently use Board resources in view of the parallel District Court Litigation.

VII. PETITIONER HAS FAILED TO SHOW THAT THERE IS A REASONABLE LIKELIHOOD THAT THE CHALLENGED CLAIMS OF THE '26686 PATENT ARE UNPATENTABLE.

A. Ground 1: Petitioner Has Failed To Show That There Is A Reasonable Likelihood That Claims 1-7 And 11-17 Are Obvious Over Outils In View Of Roelle, Matsunaga, and CFR 1205.05.¹¹

1. Petitioner Has Failed To Meet Its Burden Of Proving That Matsunaga Is Analogous Art To The Claimed Inventions Of The '26686 Patent.

¹⁰ Although there is some minor variation in the secondary references used in Petitioner's obviousness combinations in the parallel District Court Litigation, they are simply iterations of the secondary references identified in the Petition, *e.g.*, Matsunaga, Langdon, Nakano, and Roelle. (*Id.*)

¹¹ Petitioner identifies Ground 1 as Outils in view of Roelle and Matsunaga (Paper 1 at 4), but also cites to CFR 1205.05 in its actual Petition. (*See* Paper 1 at 39.)

Petitioner has failed to meet its burden of proving that Outils in view of Roelle and Matsunaga renders Challenged Claims 1-7 and 11-17 obvious because Petitioner has failed to meet its burden of proving that Matsunaga is analogous art to the claimed inventions of the '26686 patent.

“A reference qualifies as prior art for an obviousness determination only when it is analogous to the claimed invention.” *Airbus*, 941 F.3d at 1379; *In re Ethicon, Inc.*, 844 F.3d 1344, 1349 (Fed. Cir. 2017) (“Generally, a skilled artisan would only have been motivated to combine analogous art.”).

In an *Inter Partes* Review proceeding, the “***Petitioner bears the burden*** of showing by a preponderance of evidence that the asserted prior art references are analogous art and otherwise combinable.” *See SCHOTT Gemtron Corp. v. SSW Holding Company, Inc.*, IPR2014-00367, Paper 62 at 28 (PTAB May 26, 2015) (emphasis added). “Prior art is analogous if it is from the same field of endeavor or if it is reasonably pertinent to the particular problem the inventor is trying to solve.” *Circuit Check Inc. v. QXQ Inc.*, 795 F.3d 1331, 1335 (Fed. Cir. 2015).

Here, Petitioner has failed to show that Matsunaga is either from the same field of endeavor as the '26686 patent or is reasonably pertinent to the particular problem the inventor of the '26686 patent was trying to solve. Thus, Petitioner has

failed to meet its burden of proving that Matsunaga is analogous art to the claimed invention of the '26686 patent.¹²

a. Petitioner Has Failed To Meet Its Burden Of Proving That Matsunaga Is From The Same Field Of Endeavor As The '26686 Patent.

Petitioner has failed to meet its burden of proving that Matsunaga is from the same field of endeavor as the '26686 patent. The scope of the field of endeavor is a factual determination based on the scope of the application's written description and claims, including the structure and function of the invention. *In re Bigio*, 381 F.3d 1320, 1326 (Fed. Cir. 2004).

At the outset, neither Petitioner nor its expert asserts that Matsunaga is from the same field of endeavor as the '26686 patent, and thus Petitioner has failed to meet its burden of proof for this reason alone. (*See generally* Paper 1; EX1003, Reed Declaration; *see also DIRECTV, LLC v. Qurio Holdings, Inc.*, IPR2015-02007,

¹² *See e.g., Polygroup Ltd. MCO v. Willis Elec. Co.*, 758 Fed. Appx. 934, 941-42 (Fed. Cir. 2019) (affirming Board finding that reference was not analogous art); *Smith & Nephew, Inc. v. Hologic, Inc.*, 721 Fed. Appx. 943, 948-49 (Fed. Cir. 2017) (reversing Board's obviousness decision because it was based on an erroneous finding that a reference was analogous art).

Paper No. 6 at 14 (PTAB April 4, 2016) (“[The Board] will not consider arguments and information that are not presented and developed in the Petition...”)).

Moreover, Matsunaga is not from the same field of endeavor as the ‘26686 patent.

The field of endeavor of the ‘26686 patent is electric walk-behind lawn mowers and associated safety features (*See, e.g.* EX1001, ‘26686 patent, at Abstract, 1:14-15, 1:19-35; Paper 1 at 4-5; *id.* at 17-27 (Petitioner discussing only lawnmowers in its technological background section).) Matsunaga’s field of endeavor, on the other hand, is circuits for hand-held grass and hedge trimmers. (*See, e.g.*, EX1006, Matsunaga, at FIGS. 1 and 3, 1:5-34, 6:3-25.) Notably, Matsunaga is not directed to a lawnmower and does not disclose a lawnmower of any kind. (*See generally id.*) Moreover, lawnmowers and hand-held grass and hedge trimmers are entirely different devices (*e.g.*, a lawnmower is pushed from behind whereas a grass or hedge trimmer is held in the user’s hands, a lawnmower has a blade encased in a main body whereas a grass or hedge trimmer has an exposed blade, etc.) and are subject to different safety standards. Thus, lawnmowers and hand-held grass or hedge trimmers have very different design considerations and requirements.

Accordingly, Matsunaga is not from the same field of endeavor as the '26686 patent, and Petitioner has failed to meet its burden of proving that Matsunaga is analogous art.

b. Petitioner Has Failed To Meet Its Burden Of Proving That Matsunaga Is Reasonably Pertinent To The Particular Problem The Inventor Of The '26686 Patent Was Trying To Solve.

Petitioner has also failed to meet its burden of proving that Matsunaga is reasonably pertinent to the particular problem the inventor of the '26686 patent was trying to solve. A reference is not reasonably pertinent to the problem of the claimed invention if it is directed to a different purpose. *See In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) ("If [a reference] is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.").

At the outset, neither Petitioner nor its expert asserts that Matsunaga is reasonably pertinent to the particular problem the inventor of the '26686 patent was trying to solve, and thus Petitioner has failed to meet its burden of proof for this reason alone. (*See generally* Paper 1; EX1003, Reed Declaration; *see also DIRECTV, LLC v. Qurio Holdings, Inc.*, IPR2015-02007, Paper 6 at 14 (PTAB April 4, 2016).)

Moreover, Matsunaga is not reasonably pertinent to the problem of the '26686 patent because Matsunaga and the '26686 patent have different purposes.

The '26686 patent is concerned with providing a lawnmower and providing a control system for disabling a lawnmower when the lawnmower's handle is moved from a designated use position. (*See* EX1001, '26686 patent, at 1:18-35, 1:42-62, claims 1 and 11; *see also* Paper 1 at 4-5.)

- “Currently danger is usually avoided by providing a longer handle to try and keep the operator far away from the main body. However, in order to conveniently receive the mower, the handle is received in a manner such as folding or rotating. In this way, it is possible that when the handle is in a received state and the user is too close to the main body, the user misoperates the switch and thereby starts the mower, whereupon the operator may place themselves into danger by getting too close to the main body.” (EX1001, '26686 patent, at 1:27-35.)
- “The gardening tool, particularly a mower according to the present disclosure can control the motor and the functional accessory comprehensively according to the rotation position of the handle and the instant operation state of the handle. When the handle is in a state of abnormal use, even if the operation assembly on the handle for normally starting operation of the tool is misoperated, the motor and the functional accessory are not driven, and thereby ensure the user's safety and prevent occurrence of danger.” (*Id.* at 1:54-62.)

Matsunaga, on the other hand, is concerned with short-circuit faults in semiconductor switches located in hand-held grass and hedge trimmers. (*See, e.g.*, EX1006, Matsunaga, at Figs. 1 and 3, 1:7-25, 1:38-43.) Matsunaga does not disclose and has nothing to do with lawnmowers or safety features for lawnmowers. (*See generally id.*) Thus, Matsunaga is directed to a different purpose than the '26686 patent.

Accordingly, Matsunaga is not reasonably pertinent to the particular problem the inventor of the '26686 patent was trying to solve, and Petitioner has failed to meet its burden of proving that Matsunaga is analogous art for this additional reason.

2. Petitioner Has Failed To Show That The Combination Of Outils, Roelle, Matsunaga, and CFR 1205.05 Discloses, Teaches, Or Suggests Every Element Of Contested Claims 1-7 And 11-17.

a. Petitioner Has Failed to Show that Outils Discloses, Teaches, Or Suggests “a first control device configured to be controlled by the operation assembly” (“First Control Device Limitation”).

Petitioner has failed to show that Outils discloses, teaches, or suggests the First Control Device Limitation of Challenged Claims 1 and 11.¹³

Under the First Control Device Limitation, the claimed “first control device” of the control system must be configured to be controlled by the claimed “operation assembly.” (EX1001, '26686 patent, at claims 1 and 11.)

Petitioner asserts that Outils “describes” its hold-to-run component 30 (*i.e.*, the alleged “operation assembly”) as controlling an “electrical supply contactor” (*i.e.*, the alleged “first control device”). (Paper 1 at 40 (citing EX1014, Outils, at 4:5-12).) But the cited passage from Outils does not disclose that the hold-to-run

¹³ Petitioner relies solely on Outils for the First Control Device Limitation. (Paper 1 at 40.)

component 30 controls the electrical supply contactor. Rather, the cited passage from Outils states that the hold-to-run component 30 actuates a “remote control cable 29.” (EX1014, Outils, at 4:5-8 (“The means 28 for controlling the activation or rotation of the cutting blade is advantageously provided in the form of a remote control cable 29, which ... is actuated by means of a hold-to-run control component 30”).)

Thus, Petitioner has failed to show that Outils discloses, teaches, or suggests the First Control Device Limitation.

- b. Petitioner Has Failed To Show That Outils Discloses, Teaches, Or Suggests “a second control device configured to be controlled according to the rotating position of the handle [to] ... unlock[] the first control device so that the first control device allows starting of the motor, and ... lock[] the first device so that the first control device is not allowed to start the motor” (“Second Control Device Limitation”).**

Petitioner has failed to show that Outils discloses, teaches, or suggests the Second Control Device Limitation of Challenged Claims 1 and 11.¹⁴

Under the Second Control Device Limitation, the claimed “second control device” of the control system must be configured to “unlock” the claimed “first control device” so that the first control device can allow the motor to start, and must

¹⁴ Petitioner relies solely on Outils for the Second Control Device Limitation. (Paper 1 at 40-41.)

be configured to “lock” the first control device so that the first control device is not allowed to start the motor. (EX1001, ‘26686 patent, at claims 1 and 11.)

Petitioner asserts that Outils discloses an “activation actuator 23” (*i.e.*, the alleged “second control device”) that purportedly unlocks or locks Outils’ electrical supply contactor (*i.e.*, the alleged “first control device”) based on the rotating position of Outils’ handle 1. (Paper 1 at 40-41.) But Petitioner bases this assertion solely on the *ipse dixit* of its expert (*see* Paper 1 at 40-41 (citing EX1003, Reed Declaration, ¶ 86); EX1003, Reed Declaration, ¶ 86 (Petitioner’s expert failing to provide any evidence or analysis to show that Outils’ activation actuator 23 locks/unlocks the electrical supply contactor).) It is well-settled that “conclusory statements cannot satisfy the petitioner’s burden of demonstrating obviousness.” *See In re Magnum Oil Tools Int’l., Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).¹⁵ Indeed, Outils is silent as to what interaction (if any) Outils’ activation actuator 23 has with Outils’ electrical supply contactor. (EX1014, Outils, at 4:5-12, 8:22-29, claim 3.)

¹⁵ Notably, Petitioner does not even apply its own proposed construction of the terms “unlocks” and “locks” (*i.e.*, that the unlocking and locking must be “electrically enabling” and “electrically disabling,” respectively). (Paper 1 at 40-41.)

Thus, Petitioner has failed to show that Outils discloses, teaches, or suggests the Second Control Device Limitation.

c. Petitioner Has Failed To Show That Outils Or Matsunaga Discloses, Teaches, Or Suggests “wherein the second control device comprises at least one of a switch connected to the power supply circuit and a signal source device for sending a control signal to control the motor” (“Switch/Signal Source Limitation”).

Petitioner has failed to show that Outils or Matsunaga discloses, teaches, or suggests the Switch/Signal Source Limitation of Challenged Claims 1 and 11.¹⁶

Under the Switch/Signal Source Limitation, the claimed second control device—which, again, must be configured to be controlled according to the rotating position of the handle—must comprise at least (i) a switch connected to a power supply circuit or (ii) a signal source device for sending a control signal to control the motor. (EX1001, ‘26686 patent, at claims 1 and 11.)

First, Petitioner has failed to show that Outils discloses, teaches, or suggests the Switch/Signal Source Limitation.

Petitioner asserts—without citation to expert testimony—that a POSITA would have understood Outils’ activation actuator 23 (*i.e.*, the alleged “second

¹⁶ Petitioner only points to Outils and Matsunaga for the Switch/Signal Source Limitation. (Paper 1 at 41-42.)

control device”) to “be a switch connected in the power supply circuit (*e.g.*, in series between the electric power source and the electric motor).” (Paper 1 at 41 (citing EX1014, Outils, at 7:25, 9:10).) Petitioner’s conclusory and unsupported argument is insufficient to show that Outils discloses, teaches, or suggests the Switch/Signal Source Limitation. *See In re Magnum Oil*, 829 F.3d at 1380.

For example, Outils does not disclose that activation actuator 23 is a “switch” or that it is connected in any way to Outils’ motor. (*See generally* EX1014, Outils.) At best, Outils discloses that activation actuator 23 may be “electrical, electromechanical, or mechanical”—not that it is a switch. (*Id.* at 8:23-24, claim 18.)¹⁷

Second, Petitioner has failed to show that Matsunaga discloses, teaches, or suggests the Switch/Signal Source Limitation.

Petitioner asserts that Matsunaga “includes a contact switch (11 or 12) acting as a signal source device for sending a control signal to the power supply circuit.”

¹⁷ While Outils discloses that a ***different component***—activation actuator 20—can be an electrical supply cut-off switch (*id.* at 7:25-26), and that activation actuator 23 may provide similar advantages to activation actuator 20 (*id.* at 9:10), Petitioner fails to explain where Outils discloses that activation actuator 23 is ***also*** an electrical supply cut-off switch (*see* Paper 1 at 41-42.)

(Paper 1 at 42.) Matsunaga's contact switches 11/12 cannot be the claimed "second control device" because the claimed second control device must be configured to be controlled according to the rotating position of the handle. (See EX1001, '26686 patent, at claims 1 and 11.) Matsunaga's contact switches 11/12, on the other hand, are *user-controlled*. (See, e.g., EX1006, Matsunaga, at 6:64-7:22 ("The user can turn ON the respective switches 11, 12, for example, by depressing the lock-off switch 11 with a thumb and drawing the trigger switch 12 with an index finger...").)

Thus, Petitioner has failed to show that Outils or Matsunaga discloses, teaches, or suggests the Switch/Signal Source Limitation.

3. Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Outils With Roelle, Matsunaga, and CFR 1205.05 As Proposed.

Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, and CFR 1205.05 as proposed.

Petitioner proposes implementing Outils' actuation activator 23 using Matsunaga's contact switch 11 or contact switch 12. (Paper 1 at 41-42.) Petitioner asserts that a POSITA would have been motivated to make this modification because a "POSITA would have understood from the disclosure of Matsunaga that it is not desirable to pass the high current needed to power a lawn mowing motor through contact switches," and that it is instead "preferable to use smaller capacity contact

switches ... and to avoid the thick wiring ... and associated danger of high current flowing through contact switches.” (Paper 1 at 41-42.)

At the outset, Petitioner's motivation for combining Outils with Matsunaga is based on the incorrect, conclusory, and unsupported premise that Outils' activation actuator 23 is a switch connected in series with Outils' motor and thus has the “high current needed to power the motor” passing through it. (Paper 1 at 41-42.) As discussed above, Outils does not disclose that activation actuator 23 is a “switch” connected to Outils' motor. (*See, e.g.,* EX1014, Outils, at 8:23-24, claim 8 (disclosing only that activation actuator 23 may be “electrical, electromechanical, or mechanical”).) Thus, the entire premise of Petitioner's purported motivation to combine Outils with Roelle, Matsunaga, and CFR 1205.05 is without merit.

Additionally, Matsunaga expressly discloses that its contact switches 11, 12 are used in conjunction with semiconductor switches to prevent motor activation when the semiconductor switches in a hedge trimmer fail due to a short circuit. (*See, e.g.,* EX1006, Matsunaga, at 1:17-25, 1:38-43, 7:63-8:15.) But Petitioner has failed to explain why Matsunaga's concerns with semiconductor switches and short-circuits would have had any application or relevance to Outils' lawnmower. (*See* Paper 1 at 41-44.) Indeed, Outils does not even mention semiconductor switches or concerns regarding short-circuits. (*See generally* EX1014, Outils.)

Moreover, while Petitioner alleges that a POSITA would have been motivated to implement Outils' actuation activator 23 as Matsunaga's contact switches 11 or 12, Petitioner does not assert that a POSITA would have also incorporated Matsunaga's semiconductor switches into Outils' lawn mower. (Paper 1 at 41-44.) But Matsunaga expressly discloses that the only purpose of the contact switches 11, 12 is to improve motor reliability if Matsunaga's semiconductor switches fail. (*See, e.g.,* EX1006, Matsunaga, at 2:23-26, 2:49-58.) Accordingly, Petitioner's assertion that a POSITA would have simply added Matsunaga's contact switches 11, 12 to Outils' lawnmower without also adding Matsunaga's semiconductor switches is nonsensical. (Paper 1 at 41-44.) Taking the contact switches of Matsunaga from Matsunaga without adding the semiconductor switches as well would change the basic principle of operation of Matsunaga.

Petitioner also proposes that a POSITA would additionally be motivated to modify Outils due to "federal regulations that required a walk-behind lawnmower's blade control system to halt the blade's motion "within 3 seconds after release of the control." (Paper 1 at 39 (citing EX1008, CFR 1205.05(a)(iii)).) But Petitioner's Grounds for Institution (Paper 1 at 4) do not reference CFR 1205.05(a)(iii), nor does Petitioner explicitly identify this as a prior art reference in Ground 1. (Paper 1 at 27.) Petitioner thus has failed to show that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, and CFR 1205.05 for this reason as well.

Petitioner has also failed to show that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, and CFR 1205.05 as proposed because Petitioner does not assert that a POSITA would have been motivated to combine all four references.

“When an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references.” *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *see also VIZIO, Inc. v. Nichia Corp.*, IPR2017-01608, Paper 72 at 38-39 (PTAB Jan. 9, 2019) (holding that showing a motivation to combine Park ‘697 individually with each of Park ‘486 and Oshio did not show a motivation to combine Park ‘697 with Park ‘486 *and* Oshio).

Here, Petitioner does not even assert that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, *and* CFR 1205.05. (*See generally* Paper 1 at 27-51.) Rather, Petitioner at best argues that a POSITA would have combined Outils *individually* with Roelle, Matsunaga, or CFR 1205.05. (*Id.*)

Thus, Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, and CFR 1205.05 for this reason alone.

4. Petitioner Does Not Assert That A POSITA Would Have Had A Reasonable Expectation Of Success In Combining Outils With Roelle, Matsunaga, and CFR 1205.05.

Petitioner has failed to show that there is a reasonable likelihood that Outils in view of Matsunaga, Roelle, and CFR 1205.05 renders Challenged Claims 1-7 and 11-17 obvious because Petitioner has failed to show that a POSITA would have had a reasonable expectation of success in combining Outils with these three references.

“[W]here a party argues a skilled artisan would have been motivated to combine references, it must show the artisan ‘would have had a reasonable expectation of success from doing so.’” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360-61 (Fed. Cir. 2017).

Here, Petitioner and its expert ***do not assert*** that a POSITA would have had a reasonable expectation of success in combining Outils with Roelle or CFR 1205.05 as proposed.¹⁸ (*See generally* Paper 1 at 27-51; EX1003, Reed Declaration, ¶¶ 64-110.) Thus, Petitioner has failed to show that a POSITA would have had a reasonable expectation of success in combining Outils with Roelle, Matsunaga, ***and*** CFR 1205.05.

B. Ground 2: Petitioner Has Failed To Show That There Is A Reasonable Likelihood That Claims 8-10 and 18-20 Are Obvious

¹⁸ In contrast, Petitioner and its expert ***do*** say that a POSITA would have a reasonable expectation of success in combining Outils with Matsunaga. (Paper 1 at 46-47, 49; EX1003, Reed Declaration, ¶¶ 98, 100, 103.)

Over Outils In View Of Roelle, Matsunaga, Langdon, Nakano, and CFR 1205.05.¹⁹

Petitioner has failed to meet its burden of proving that Outils in combination with Roelle, Matsunaga, Langdon, Nakano, and CFR 1205.05 renders Challenged Claims 8-10 and 18-20 obvious. Challenged Claims 8-10 depend from Challenged Claim 1, and thus incorporate each and every limitation of Challenged Claim 1. *See* 35 U.S.C. § 112(d). Similarly, Challenged Claims 18-20 depend from Challenged Claim 11, and thus incorporate each and every limitation of Challenged Claim 11. *Id.* As discussed above, Petitioner has failed to meet its burden of proving that Outils in combination with Roelle, Matsunaga, and CFR 1205.05 renders Challenged Claims 1 or 11 obvious. Thus, Petitioner likewise has failed to meet its burden of proving that Outils in combination with Roelle, Matsunaga, Langdon, Nakano, and CFR 1205.05 renders Challenged Claims 8-10 or 18-20 obvious.

¹⁹ Petitioner identifies Ground 1 as Outils in view of Roelle and Matsunaga (Paper 1 at 4), but also cites to CFR 1205.05 in its actual Petition. (*See* Paper 1 at 39.) Petitioner does not identify CFR 1205.05 as one of the prior art references in its Grounds for Institution. (Paper 1 at 4.) Nevertheless, out of an abundance of caution, Chervon is addressing this reference as well with respect to Ground 2 as Ground 2 addresses certain dependent Challenged Claims that depend on claims addressed in Ground 1.

1. Petitioner Has Failed To Meet Its Burden of Proving That Nakano Is Analogous Art To The Claimed Invention Of The '26686 Patent.

a. Petitioner Has Failed To Meet Its Burden Of Proving That Nakano Is From The Same Field Of Endeavor As The '26686 Patent.

Petitioner has failed to meet its burden of proving that Nakano is from the same field of endeavor as the '26686 patent.

At the outset, neither Petitioner nor its expert asserts that Nakano is from the same field of endeavor as the '26686 patent, and thus Petitioner has failed to meet its burden of proof for this reason alone. (*See generally* Paper 1; EX1003, Reed Declaration; *see also DIRECTV, LLC v. Qurio Holdings, Inc.*, IPR2015-02007, Paper 6 at 14 (PTAB April 4, 2016) (“[The Board] will not consider arguments and information that are not presented and developed in the Petition...”)).

Moreover, Nakano is not from the same field of endeavor as the '26686 patent. The field of endeavor of the '26686 patent is electric walk-behind lawn mowers and associated safety features. (*See, e.g.* EX1001, '26686 patent, at Abstract, 1:14-15, 1:19-35; Paper 1 at 5; *id.* at 17-27 (Petitioner discussing only lawnmowers in its technological background section).) Nakano's field of endeavor, on the other hand, is hand-held bush cutters. (*See, e.g.*, EX1015, Nakano, at 1:10-11, 2:18-23, FIGS. 1-2.) Notably, Nakano is not directed to a lawnmower and does not disclose a lawnmower of any kind. (*See generally id.*) Moreover, lawnmowers and hand-held

bush cutters are entirely different devices (*e.g.*, a lawnmower is pushed from behind whereas a bush cutter is held in the user's hands, a lawnmower has a blade encased in a main body whereas a bush cutter has an exposed blade, etc.) and are subject to different safety standards. Thus, lawnmowers and hand-held bush cutters have very different design considerations and requirements.

Accordingly, Nakano is not from the same field of endeavor as the '26686 patent, and Petitioner has failed to meet its burden of proving that Nakano is analogous art.

b. Petitioner Has Failed To Meet Its Burden Of Proving That Nakano Is Reasonably Pertinent To The Particular Problem The Inventor Of The '26686 Patent Was Trying To Solve.

Petitioner has also failed to meet its burden of proving that Nakano is reasonably pertinent to the particular problem the inventor of the '26686 patent was trying to solve.

At the outset, neither Petitioner nor its expert asserts that Nakano is reasonably pertinent to the particular problem the inventor of the '26686 patent was trying to solve, and thus Petitioner has failed to meet its burden of proof for this reason alone. (*See generally* Paper 1; EX1003, Reed Declaration; *see also DIRECTV, LLC v. Qurio Holdings, Inc.*, IPR2015-02007, Paper 6 at 14 (PTAB April 4, 2016).)

Moreover, Nakano is not reasonably pertinent to the problem of the '26686 patent because Nakano and the '26686 patent have different purposes.

The '26686 patent is concerned with a lawnmower and providing a control system for disabling a lawnmower when the lawnmower's handle is moved from a designated use position. (See EX1001, '26686 patent, at 1:18-35, claims 1 and 11; *see also* Paper 1 at 5.)

- “Currently danger is usually avoided by providing a longer handle to try and keep the operator far away from the main body. However, in order to conveniently receive the mower, the handle is received in a manner such as folding or rotating. In this way, it is possible that when the handle is in a received state and the user is too close to the main body, the user misoperates the switch and thereby starts the mower, whereupon the operator may place themselves into danger by getting too close to the main body.” (EX1001, '26686 patent, at 1:27-35.)
- “The gardening tool, particularly a mower according to the present disclosure can control the motor and the functional accessory comprehensively according to the rotation position of the handle and the instant operation state of the handle. When the handle is in a state of abnormal use, even if the operation assembly on the handle for normally starting operation of the tool is misoperated, the motor and the functional accessory are not driven, and thereby ensure the user's safety and prevent occurrence of danger.” (*Id.* at 1:54-62.)

Nakano, on the other hand, is concerned with providing a hand-held electric bush cutter that is easy to use, easy to store, and has a brake to stop the motor. (See EX1015, Nakano, at 2:17-3:11.) Nakano does not disclose and has nothing to do with safety features for lawnmowers (*see generally id.*), and thus Nakano is directed to a different purpose than the '26686 patent.

Accordingly, Nakano is not reasonably pertinent to the particular problem the inventor of the '26686 patent was trying to solve, and Petitioner has failed to meet its burden of proving that Nakano is analogous art for this additional reason.

2. Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Outils, Roelle, Matsunaga, Langdon, Nakano, and CFR 1205.05 As Proposed.

As explained above in Section VII(A)(1) *supra* and immediately above, Petitioner has failed to show that Matsunaga and Nakano are analogous art to the '26686 patent. As also explained above in Section VII(A)(3) *supra*, Petitioner has failed to show that it would have been obvious for a POSITA to combine Outils, Roelle, Matsunaga, and CFR 1205.05. Thus, for all of the same reasons, Petitioner has failed to meet its burden of proving that the combination of Outils in view of Matsunaga, Langdon, Nakano, and CFR 1205.05 renders Challenged Claims 8-10 and 18-20 obvious. (Paper 1 at 51-67.)

Petitioner has also failed to show that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, Langdon, Nakano, and CFR 1205.05 as proposed because Petitioner does not assert that a POSITA would have been motivated to combine all these references.

“When an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references.” *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d

1359, 1368 (Fed. Cir. 2016); *see also VIZIO, Inc. v. Nichia Corp.*, IPR2017-01608, Paper 72 at 38-39 (PTAB Jan. 9, 2019) (holding that showing a motivation to combine Park ‘697 individually with each of Park ‘486 and Oshio did not show a motivation to combine Park ‘697 with Park ‘486 *and* Oshio).

Here, Petitioner does not even assert that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, Langdon, Nakano, *and* CFR 1205.05. (*See generally* Paper 1 at 51-67.) Rather, Petitioner at best argues that a POSITA would have combined Outils *individually* with Roelle, Matsunaga, Langdon, Nakano, or CFR 1205.05. (*Id.*)

Thus, Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, Langdon, Nakano, and CFR 1205.05 for this reason alone.

3. Petitioner Does Not Assert That A POSITA Would Have Had A Reasonable Expectation Of Success In Combining Outils With Roelle, Matsunaga, Langdon, Nakano, and CFR 1205.05.

Petitioner has failed to show that there is a reasonable likelihood that Outils in view of Roelle, Matsunaga, Langdon, Nakano, and CFR 1205.05 renders Challenged Claims 8-10 and 18-20 obvious because Petitioner has failed to show that a POSITA would have had a reasonable expectation of success in combining these references.

“[W]here a party argues a skilled artisan would have been motivated to combine references, it must show the artisan ‘would have had a reasonable expectation of success from doing so.’” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360-61 (Fed. Cir. 2017).

Here, Petitioner and its expert ***do not assert*** that a POSITA would have had a reasonable expectation of success in combining Outils with Roelle, Matsunaga, Langdon, Nakano, and CFR 1205.05 as proposed. (*See generally* Paper 1 at 51-67; EX1003, Reed Declaration, ¶¶ 111-131.) Rather, Petitioner at best argues that a POSITA would have combined Outils ***individually*** with the other references. (*Id.*)

Thus, Petitioner has failed to show that a POSITA would have had a reasonable expectation of success in combining these references.

VIII. THE BOARD SHOULD DECLINE TO INSTITUTE BECAUSE PETITIONER FAILED TO MEET ITS BURDEN TO IDENTIFY ALL REAL PARTIES IN INTEREST.

The Board should deny institution because Petitioner has failed to identify Techtronic Industries Co. Ltd. (“Techtronic”) and Homelite Consumer Products, Inc. (“Homelite”) as real parties in interest. A petitioner must identify all real parties in interest in an IPR petition. 35 U.S.C. § 312(a)(2). “An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” *Id.* at § 315(b).

The Board generally accepts a petitioner's identification of real parties in interest unless the patent owner presents some evidence that at least one real party in interest was omitted. *See Agilent Tech., Inc. Waters Tech. Corp.*, IPR2019-01131, Paper 12, at 5 (Dec. 3. 2019) (citing *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018)). Petitioner bears the burden of demonstrating that it has complied with the real party in interest requirement. (*Id.* at 6.) The Board (applying Federal Circuit law) uses a “‘flexible approach’ for the real party in interest inquiry, which turns on ‘equitable and practical considerations’ bearing on whether an unnamed entity has ‘a preexisting, established relationship with the petitioner.’” (*Id.* (quoting *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018))).) Here, Petitioner failed to identify two real parties in interest, namely, Techtronic and Homelite, and the Board should decline to institute for this reason too.

A. Petitioner Failed To Name Techtronic Industries Co. Ltd As A Real Party In Interest.

Petitioner failed to meet its burden to identify all real parties in interest by omitting Techtronic from its mandatory notices. Techtronic is a real party in interest because it has a pre-existing, established relationship with Petitioner, and controlled Petitioner's conduct with respect to the filing of this Petition. “A common consideration [in the RPI analysis] is whether the non-party exercised or could have exercised control over a party's participation in a proceeding.” Office Patent Trial

Practice Guide, 77 Fed. Reg. at 48760, 48761 (citations omitted); *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018); *Aceto Agricultural Chem. Corp. v. Gowan Co.*, IPR2015-01016, Paper 15, at 4 (PTAB Oct. 2, 2015). “The concept of control generally means that ‘the nonparty has the actual measure of control or opportunity to control that might reasonably be expected between two formal parties.’” *Id.* (citations omitted).

Techtronic substantially controls Petitioner such that Techtronic is an RPI, because Techtronic ***actually controlled whether Petitioner filed this Petition.*** With respect to the RPI inquiry, “the two questions lying at its heart are whether a non-party “desires review of the patent” and ***whether a petition has been filed at a nonparty's “behest.”*** *Applications in Internet Time*, 897 F.3d at 1351 (citing Office Patent Trial Practice Guide, 77 Fed. Reg. at 48759) (emphasis added). In April 2020, Lee Sowell, President of the Outdoor Products Division of Techtronic, emailed Mike Clancy, CEO of Chervon North America Inc. (the exclusive licensee of the challenged patent) with an invitation to discuss settlement of the parallel District Court Litigation. (EX2004, Declaration of Mike Clancy, ¶¶ 2-3.) Messrs. Sowell and Clancy had a phone conversation on or around April 20, 2020, to discuss

settlement. (*Id.*) Mr. Sowell advised Mr. Clancy that “TTI”²⁰ has prepared and will soon be filing a series of IPR petitions to challenge the validity of the claims of the patents at issue in the District Court Litigation. (*Id.* at ¶ 4.) Mr. Sowell proposed that “TTI” would not file any IPR Petitions against the patents at issue in the District Court Litigation if Patent Owner agrees to dismiss the litigation claims against all of the named defendants in the District Court Litigation, *i.e.*, Techtronic, Petitioner, and Homelite. (*Id.*) Mr. Sowell made it clear that he, on behalf of “TTI,” controlled whether any and all of Techtronic, Petitioner, and/or Homelite would file IPR Petitions against the patents at issue in the District Court Litigation. (*Id.* at ¶ 5.) Although Patent Owner rejected Techtronic’s settlement offer, Mr. Clancy understood that Mr. Sowell had the authority to negotiate, and indeed negotiated, on behalf of Techtronic, Petitioner, and Homelite. (*Id.*)

Mr. Sowell and Techtronic controlled whether Petitioner filed this IPR Petition, and Petitioner ultimately filed this IPR Petition at Techtronic’s behest. This fact singularly confirms that Techtronic is an RPI.

²⁰ “TTI” stands for Techtronic Industries Co. Ltd., referred to herein as “Techtronic,” the ultimate 100% owner of Petitioner. (EX2005, Techtronic 2019 Annual Report at 1 (“Company Profile Techtronic Industries Company Limited (the “Company”, the “Group” or “TTI”) is a fast-growing world leader in...”)).)

Nevertheless, there are additional aspects of the relationship between Techtronic and Petitioner that further support the Board holding that Techtronic is an unnamed RPI. For example, the Board has held that “‘an involved and controlling parent corporation’ may indeed be an RPI.” *Id.* at 5 (quoting *ZOLL Lifecor Corp. v. Philips Elec. N. Am. Corp.*, IPR 2013-00606, Paper 13, at 10 (PTAB Mar. 20, 2014)). According to the *Aceto* Board, “the Board has on several occasions held that [a] petitioner’s parent corporation should have been named as an RPI where “the relationship between a nonparty parent corporation and the subsidiary petitioner blurred the lines of corporate separation such that the parent could control conduct of the *inter partes* review.” *Id.*²¹ Here, Techtronic is a real party in interest because Techtronic owns Petitioner, and Techtronic and Petitioner have blurred the lines of corporate separation between them for at least the following reasons:

- Techtronic is a publicly-traded Hong Kong entity that ultimately owns 100% of Petitioner. (EX2006, District Court Litigation, Defendants’ Rule 7.1 Corporate Disclosure Statement.)

²¹ (citing *See Reflectix, Inc. v. Promethean Insulation Tech. LLC*, Case IPR2015-00039, slip op. at 9 (PTAB Apr. 24, 2015) (Paper 18); *see also Galderma*, Paper 14, slip op. at 9–13; *Zerto, Inc. v. EMC Corp.*, Case IPR2014-01254, slip op. at 10–14 (PTAB Feb. 12, 2015) (Paper 32); *Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.*, Case IPR2013-00453, slip op. at 2–6 (PTAB Jan. 6, 2015) (Paper 88); *Zoll*, Paper 13, slip op. at 8–11.

- Techtronic and Petitioner collectively answered the Complaint in the District Court Litigation. (EX2007, District Court Litigation, Defendants' Answer to Plaintiffs' Second Amended Complaint.)
- Techtronic and Petitioner share counsel in the parallel District Court Litigation. (*See, e.g., id.*; EX2008, District Court Litigation, Techtronic and Petitioner's Objections and Responses to Patent Owner's Second Set of Interrogatories, at 7-8.)
- Techtronic and Petitioner have answered discovery collectively. (*See id.* at 1.)
- Techtronic admits that its and Petitioner's financial performance are intertwined. Specifically, Techtronic has stated that Petitioner, "in the opinions of [Techtronic's] directors, principally affected the results or assets of [Techtronic]" in 2019. (EX2005, Techtronic's 2019 Annual Report, § 52 ("Particulars of Principal Subsidiaries."))²² Indeed, Techtronic's 2019 annual report devotes more than 3 pages highlighting the products accused of infringement in the District Court Litigation, *i.e.*, Ryobi cordless mowers. (*Id.* at 20, 21, 36.)

These considerations coupled with Petitioner's filing of the Petition at Techtronic's behest confirms that Techtronic is an unnamed RPI. The Board should decline institution for Petitioner's failure to include Techtronic as an RPI.

B. Petitioner Failed To Name Homelite Consumer Products, Inc. As A Real Party In Interest.

Petitioner failed to meet its burden to identify all real parties in interest by omitting Techtronic from its mandatory notices. Homelite is a real party in interest

²² Techtronic's 2019 annual report identifies 86 subsidiaries that, unlike Petitioner, did not principally affect the financial results or assets of Techtronic. (*Id.*)

because it is a clear beneficiary of Petitioner's filing of this Petition.²³ The PTAB conducts the RPI analysis "'with an eye toward determining whether the non-party is a *clear beneficiary* that has a preexisting, established relationship with the petitioner.'" *Ventex Co., Ltd. v. Columbia Sportswear North Am., Inc.*, IPR2017-00651, Paper 148, at 6 (Jan. 24, 2019) (quoting *Applications in Internet Time*, 897 F.3d at 1351) (emphasis added)). When a party receives a "direct benefit of a finding of unpatentability," as opposed to a "merely generalized benefit," that party is likely an RPI. *See id.* at 10 (finding that petitioner's customer was an RPI where petitioner and customer had an exclusive relationship and part of the reason that Petitioner filed the petition was to protect its customers.).

Here, "[a]ll of the Accused Products are imported and distributed by Homelite Consumer Products, Inc." according to Petitioner (and Techtronic) in the parallel District Court Litigation. (EX2008, District Court Litigation, Techtronic and Petitioner's Objections and Responses to Patent Owner's Second Set of Interrogatories, at 6.) To the extent that the Accused Products infringe the '26686 patent (as Patent Owner has alleged in the District Court Litigation), Petitioner (and Techtronic) have admitted that Homelite has committed multiple infringing acts.

²³ Notably, Petitioner failed to identify Homelite as a defendant in the District Court Litigation in its Notice of Related Matters in its Petition.

(*Id.*) Thus, Homelite does not merely have a generalized interest in invalidating the challenged claims of the '26686 patent, it would receive a direct benefit that renders it an RPI. Indeed, as noted in Section VIII(A), *supra*, Techtronic represented itself, Petitioner, and Homelite in settlement negotiations in which this Petition was dangled as a threat to Patent Owner in the instance that Patent Owner would not dismiss the parallel District Court proceeding against Techtronic, Petitioner, and *Homelite*. (EX2004, Declaration of Mike Clancy, ¶¶ 4-5.) Thus, Homelite is an unnamed RPI.

The Board should decline to institute due to Petitioner's failure to name Techtronic and Homelite as real parties in interest.

IX. THIS PROCEEDING SHOULD BE DISMISSED AS UNCONSTITUTIONAL

This proceeding should be dismissed because the assigned Administrative Patent Judges are principal officers of the United States and yet were not appointed by the President and confirmed by the Senate as required by the Appointments Clause of the United States Constitution. U.S. Const. art. 2, § 2, cl. 2. Although *Arthrex, Inc. v. Smith and Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019) purported to sever a statute to address such problems in that case, the purported severance was ineffective and, in any event, inapplicable to the present panel or proceeding.

X. CONCLUSION

Accordingly, for at least the foregoing reasons, Patent Owner respectfully requests that the Board refuse to institute an *inter partes* review because Petitioner has failed to establish a reasonable likelihood that any of the Challenged Claims of the '26686 patent will be found unpatentable.

Respectfully submitted,

Dated: August 10, 2020

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CERTIFICATE OF COMPLIANCE

This paper complies with the requirements of 37 C.F.R. § 42.24 and contains 12,760 words (exclusive of the table of contents, the table of authorities, the table of exhibits, the certificate of service, and this certification).

This paper complies with the typeface requirements of 37 C.F.R. § 42.6 and has been prepared in 14 point Times New Roman proportionally spaced typeface with normal spacing.

Respectfully submitted,

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The undersigned hereby certifies that on the below date, I caused the forgoing to be served by electronic mail to the following:

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