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 RESPONSE

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I. INTRODUCTION

Petitioner One World Technologies, Inc., d/b/a Techtronic Industries Power Equipment ("Petitioner") has petitioned for *Inter Partes* Review of Claims 1-20 ("Challenged Claims") of U.S. Pat. No. 9,826,686 ("the '26686 patent"), which is owned Patent Owner Chervon (HK) Limited ("Patent Owner"). The Board should confirm the patentability of the Challenged Claims because Petitioner has failed to meet its burden of proving that the Challenged Claims are invalid as obvious.

First, Petitioner's asserted obviousness combinations fail to disclose, teach, or suggest multiple claim limitations of the Challenged Claims.

Second, Petitioner's reasons for combining the asserted references lack a rational underpinning, are conclusory and unsupported, and exhibit classic hindsight bias that the Federal Circuit has cautioned against. Indeed, in some instances Petitioner fails to identify any reason why a POSITA would have been motivated to combine the asserted references.

Accordingly, Patent Owner respectfully requests that the Board confirm the patentability of the Challenged Claims. Alternatively, Patent Owner requests that the Board dismiss this proceeding in view of Petitioner's failure to identify two real parties in interest.

II. BACKGROUND

A. The '26686 Patent And The Challenged Claims.

The '26686 patent, entitled "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 claimed performance and safety features of the '26686 patent include: (1) an operation assembly for controlling the motor; (2) a control system comprising a first control device and a second control device, wherein the second control device is controlled according to the rotating position of the handle and locks/unlocks the first control device based on the handle's position; and (3) a locking mechanism for locking the rotating position of the handle. (*Id*. at claims 1 and 11.)

Challenged Claim 1 of the '26686 patent is 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.)

The claimed performance and 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 rotating and telescopic handles. (*Id*. at Abstract, 1:42-62.) The claimed performance and safety features prevent activation of the mower when the mower is not in its proper operational position. (*Id*.)

B. The Level Of Ordinary Skill In The Art.

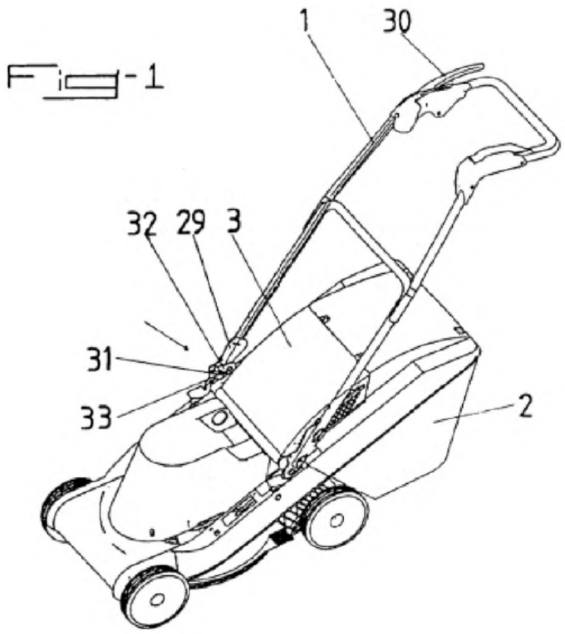
For the purposes of these proceedings only, Patent Owner adopts Petitioner's proposed level of ordinary skill in the art.

C. Petitioner's Asserted Prior Art References.

1. French Patent App. No. FR 2,768,300 ("Outils").

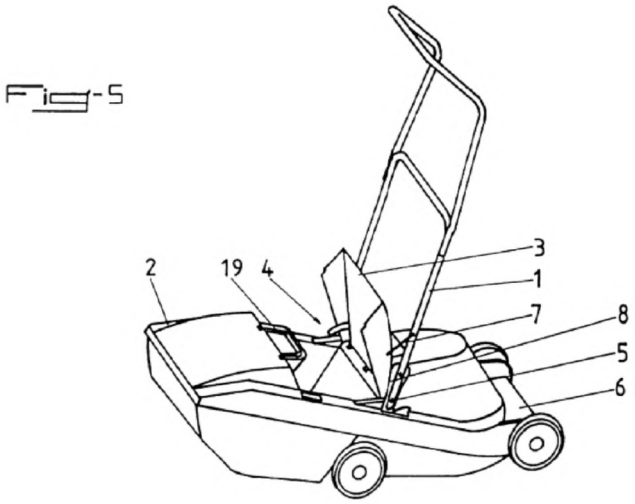
Outils discloses a lawnmower with a handlebar 1, a cut grass receptacle 2, and a "safety device" for preventing access to the rotating cutting blade. (EX1014, Outils, at Abstract, 3:25-33, claim 1.) Outils discloses several separate, distinct embodiments for its "safety device." (EX2027, Smith Decl., ¶¶ 58-61.)

In a first embodiment of the "safety device" (shown in FIG. 1 below), the safety device comprises a safety cover 3 and a means 28 for controlling rotation of the cutting blade. (EX1014, Outils, at 3:35-4:8, claims 2-3, FIGS. 1-4.) The means 28 comprises a remote control cable 29 which acts on a motor brake, a brake coupling, or an electrical supply contactor and is actuated by a hold-to-run control component 30. (*Id*.)



(*Id*. at FIG. 1.)

In a second embodiment of the "safety device" (shown in FIG. 5 below), the safety device comprises a safety cover 3 and a means 4 for controlling activation of the cutting blade. (*Id*. at 5:14-19, 8:22-29, FIGS. 5 and 10, claims 4-5 and 18.) The means 4 may take the form of an electrical, electromechanical, or mechanical activation actuator 23 that interacts with a cam 24 provided on the handlebar 1. (*Id*.)



(*Id*. at FIG. 5.)

Notably, as shown in FIG. 5 of Outils, the second embodiment of Outils' "safety device" does not have a remote control cable 29 or a hold-to-run control component 30 on the handlebar 1. (*Id*.)

2. U.S. Patent No. 4,753,062 ("Roelle").

Roelle discloses a lawnmower with a handle pivotally connected to main body and having means for alternately securing the position of the handle in a cutting position or in a vertical position. (EX1011, Roelle, at Abstract.) The lawnmower also includes a control system that stops the engine any time the cover to the cuttings container is opened. (*Id*.)

3. U.S. Patent No. 8,098,036 ("Matsunaga").

Matsunaga discloses a hand-held electric grass or hedge trimmer with an improved circuit design. (EX1006, Matsunaga, at FIGS. 1 and 3, Abstract.) The

circuit is designed such that, in the event of a short-circuit, current is prevented from continuing to flow to the motor. (*Id*. at 1:38-58.)

4. U.S. Patent No. 5,209,051 ("Langdon").

Langdon discloses a rotary lawnmower with a push handle assembly. (EX1012, Langdon, at Abstract.) The push handle assembly is comprised of telescopic members and is pivotally attached to the lawnmower deck such that the handle may be folded over for storage. (*Id*.)

5. International Patent Pub. No. WO 2013/122266 ("Nakano").

Nakano discloses an electric hand-held bush cutter comprising two telescopic pipes: a fixed pipe 40 and a movable pipe 80. (EX1015, Nakano, at 7:17-8:3, FIG. 1.) A handle unit 41 comprising a trigger lever 44 is attached to the fixed pipe 40. (*Id*. at 8:11-17, FIG. 1.) Nakano's bush cutter is designed to be operable only when the movable pipe 80 is at its fully extended length. (*Id*. at 9:15-16, FIG. 1, claim 12.) When the movable pipe 80 is not fully extended, or if the movable pipe 80 is accidentally retracted during operation, an extending detection unit prevents operation of the motor or causes the motor to automatically stop. (*Id*. at 9:16-22, FIG. 2, claim 12.)

III. LEGAL STANDARDS

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). 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). "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).

"Generally, a party seeking to invalidate a patent as obvious must demonstrate … that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so." *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Pat. Litig.,* 676 F.3d 1063, 1068-69 (Fed. Cir. 2012); *see also Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876

F.3d 1350, 1360-61 (Fed. Cir. 2017) ("[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.'"). The party must also persuasively explain how the references would be combined to arrive at the claimed invention. *See Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017).

IV. CLAIM CONSTRUCTION

Because the Petition was filed after November 13, 2018, the Challenged Claims are to be construed using the same standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). *See* 37 C.F.R. § 42.100(b). Under the *Phillips* standard, claim terms are generally given their ordinary and customary meaning as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history. *Phillips*, 415 F.3d at 1313.

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).

A. "power supply circuit."

Petitioner asserts that "power supply circuit" should be construed as "the electrical path between an electric power source and the claimed 'motor' taken by (high-power) current that drives the motor." (Paper 1 at 13-14.)

The District Court in the parties' related district court litigation rejected Petitioner's proposed construction. (EX2025, CC Opinion, at 8.) Nevertheless, Patent Owner believes that no construction is required for this term because the construction of this term is not relevant to the issues raised herein.

B. "locks" and "unlocks."

Petitioner asserts that the terms "locks" and "unlocks" should be construed as "electrically disabling" and "electrically enabling," respectively. (Paper 1 at 17.) The Board accepted Petitioner's proposed constructions in the Institution Decision. (Paper 21 at 37-39.) For the purposes of these proceedings only, Patent Owner does not dispute Petitioner's proposed constructions.

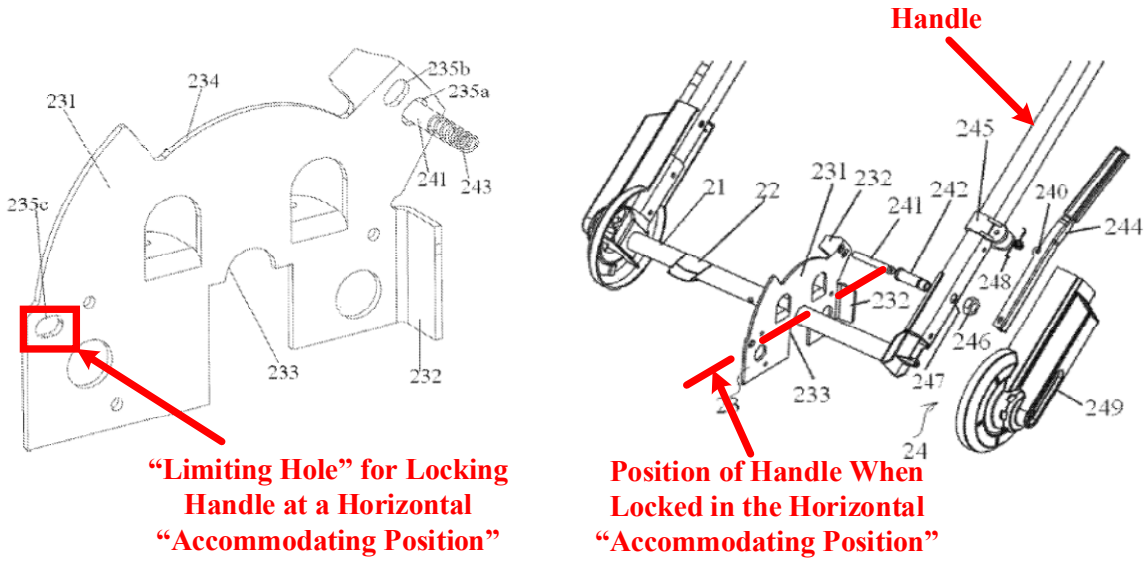
C. "accommodating position relative to the main body."

Consistent with the claims and specification of the '26686 patent, the Board should construe the term "accommodating position relative to the main body" in Challenged Claims 1 and 11 as a "horizontal position over the main body." (EX2027, Smith Decl., ¶ 75.)

First, the claims support Patent Owner's proposed construction. Challenged Claims 1 and 11 of the '26686 patent recite that the claimed "accommodating position" of the handle is a non-use position (*i.e.*, a horizontal storage position). (EX1001, '26686 patent, at claims 1 and 11 ("keep the handle at an accommodating position relative to the main body when the [gardening tool / mower] is not being

used"); *see also id*. (reciting that the motor cannot be started when the handle is rotated to the "accommodating position").) Challenged Claims 1 and 11 also recite a "locking mechanism" to keep the handle in the non-use, horizontal "accommodating position relative to the main body." (*Id*.)

Second, the specification supports Patent Owner's proposed construction. The specification of the '26686 patent discloses that the "handle 20 is provided with [a] locking mechanism 24 which is automatically snap fitted with a plurality of levels of [a] level changing member 23 so as to fix and adjust the handle 20. The level changing member 23 is used to set levels and cooperate with the locking mechanism to lock the levels." (*Id*. at 3:8-14.) The level changing member 23 includes a "limiting hole 235c" that is used to lock the handle at a horizontal "accommodating level for folding the handle upon accommodating the mower." (*Id*. at 5:9-20, FIG. 4.) A POSITA would understand that the horizontal "accommodating level" is the claimed "accommodating position relative to the main body." (EX2027, Smith Decl., ¶ 77.)



(EX1001, '26686 patent, at FIGS. 3-4 (annotated).)

Additionally, the specification of the '26686 patent states that the user of the disclosed lawnmower "may achieve accommodation by rotating the handle 20 to adjust an operation posture or reducing space occupied by the mower 100." (EX1001, '26668 patent, at 2:39-42.) In view of this disclosure, a POSITA would understand that the claimed "accommodating position relative to the main body"—which again is a non-use position, not an operation position—is a horizontal position over the main body used to reduce the space occupied by the claimed lawnmower. (EX2027, Smith Decl., ¶ 78.)

Third, Petitioner's expert, Mr. Reed, confirmed during his deposition that Patent Owner's proposed construction is correct:

> Q. In the context of the '26686 patent, what is an accommodating position relative to the main body?

A. It's a position that the consumer or the user would want it to be when it's not being used.

Q. **Is it a horizontal position?**

A. **Well, in the context with all that's being displayed and disclosed in this patent, yes, it would be a horizontal position over – over the mower.**

(EX2028, Reed Transcript, at 136:13-22 (emphasis added).)

Accordingly, the Board should construe the term "accommodating position relative to the main body" as a "horizontal position over the main body."

V. PETITIONER HAS FAILED TO SHOW THAT THE CHALLENGED CLAIMS OF THE '26686 PATENT ARE UNPATENTABLE AS OBVIOUS UNDER 35 U.S.C. § 103.

A. Ground 1: Petitioner Has Failed To Show That Outils In View Of Roelle And Matsunaga Renders Challenged Claims 1-7 And 11-17 Obvious.

1. Petitioner Has Failed To Show That Matsunaga Is Analogous Art To The Claimed Inventions Of The '26686 Patent.

(a) Petitioner Has Failed To Show That Matsunaga Is From The Same Field Of Endeavor As The '26686 Patent.

Petitioner has failed to show that Matsunaga is analogous art because Petitioner has failed to show 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*, IPR2015-02007, Paper No. 6 at 14 ("[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 performance and 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); EX2027, Smith Decl., ¶ 81.) 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; EX2027, Smith Decl., ¶ 82.) 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 have very different design considerations and requirements. (EX2027, Smith Decl., ¶ 83.) For example, 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.), are subject to different safety standards and safety considerations, and lawnmowers are heavier than hedge trimmers and require a lot more power than hedge trimmers because they are used to cut a larger area. (*Id*.) Thus, a POSITA designing a lawnmower would have had no reason to look to hand-held grass or hedge trimmers. (*Id*.)

Accordingly, Petitioner has failed to show that Matsunaga is from the same field of endeavor as the '26686 patent.

(b) Petitioner Has Failed To Show That Matsunaga Is Reasonably Pertinent To The Particular Problem The Inventor Of The '26686 Patent Was Trying To Solve.

Petitioner has also failed to show 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.)

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; EX2027, Smith Decl., ¶ 85.)

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; EX2027, Smith Decl., ¶ 86.) Matsunaga does not disclose and has nothing to do with lawnmowers or safety features for lawnmowers. (*Id*.) Thus, Matsunaga is directed to a different purpose than the '26686 patent. (EX2027, Smith Decl., ¶ 86.)

Accordingly, Petitioner has failed to show that Matsunaga is reasonably pertinent to the particular problem the inventor of the '26686 patent was trying to solve.

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

(a) Petitioner Has Failed to Show that Roelle Discloses, Teaches, Or Suggests "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 / mower] is not being used" ("Locking Member Limitation").

Petitioner has failed to show that Roelle discloses, teaches, or suggests the Locking Member Limitation of Challenged Claims 1 and 11.[1]

Under the Locking Member Limitation, the claimed "locking member" and the claimed "locking mechanism" must engage with each other to cause the locking mechanism to keep the handle at an "accommodating position" relative to the main body when the lawnmower is not in use. (EX1001, '26686 patent, at claims 1 and 11; EX2027, Smith Decl., ¶ 147.) As discussed above, the term "accommodating position relative to the main body" should be construed as a "horizontal position over the main body." (EX2027, Smith Decl., ¶ 147.)

[1] Petitioner relies solely on Roelle for the Locking Member Limitation. (Paper 1 at 36.)

Petitioner asserts that Roelle discloses a "locking structure" that locks Roelle's handle at a non-use ***vertical*** position when the lawnmower is not in use. (Paper 1 at 34 ("Roelle secures rotating handle 24 in its in-use position (Figures 1, 1A) but the locking structure including a locking mechanism (spring biased pin 68) also keeps the handle in an accommodating, vertical position when the mower is not in use (Figure 2)."); *see also id*. at 36.) But Roelle's non-use vertical position is not the claimed ***horizontal*** "accommodating position." Further, Roelle does not disclose, teach, or suggest locking the handle at a horizontal position over the main body. (*See generally* EX1011, Roelle; *see also* EX2027, Smith Decl., ¶ 148.)

Accordingly, Roelle does not disclose, teach, or suggest the Locking Member 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 wherein, … the second control device unlocks the first control device so that the first control device allows starting of the motor, and … the second control device locks 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.[2]

Under the Second Control Device Limitation, the claimed "second control device" of the control system must be configured to "unlock" (*i.e.*, electrically enable) the claimed "first control device" so that the first control device allows starting of the motor, and must be configured to "lock" (*i.e.*, electrically disable) 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; EX2027, Smith Decl., ¶ 150.)

Petitioner asserts that Outils' "activation actuator 23" is the claimed "second control device" (Paper 1 at 40), and that Outils' "electrical supply contactor" is the claimed "first control device" (*id*.). According to Petitioner, Outils' actuator 23 meets the Second Control Device Limitation because the actuator 23 purportedly

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

unlocks and locks Outils' electrical supply contactor based on the rotating position of Outils' handle 1. (*Id*. at 40-41 (citing EX1003, Reed Declaration, ¶ 86).)

Petitioner has failed to show that Outils discloses, teaches, or suggests the Second Control Device Limitation because at no point does Outils disclose, teach, or suggest that Outils' actuator 23 (*i.e.*, the alleged "second control device") interacts with Outils' electrical supply contactor (*i.e.*, the alleged "first control device") such that Outils' actuator 23 could unlock and lock Outils' electrical supply contactor as claimed.

At the outset, Outils' actuator 23 ***does not*** unlock/lock Outils' electrical supply contactor because the actuator 23 and the electrical supply contactor are components of ***separate, distinct embodiments*** of Outils' disclosed and claimed "safety device." (*See* Section II(C)(1), *supra*; *see also* EX2027, Smith Decl., ¶¶ 58-61, 153; EX2028, Reed Transcript, at 89:2-10.) Because they are components of separate, distinct embodiments, the actuator 23 and the electrical supply contactor do not interact with each other. Consistent with that fundamental problem with Petitioner's assertion regarding the Second Control Device Limitation, Petitioner and its expert fail to support their position that Outils' actuator 23 unlocks/locks Outils' electrical supply contactor with citations to Outils ***because no such disclosure, teaching, or suggestion exists***. (*See* Paper 1 at 40-41; EX1003, Reed Declaration, ¶ 86; EX2027, Smith Decl., ¶ 153.)

The Federal Circuit has held that multiple embodiments of a single prior art reference cannot be relied upon in combination without evidence of a motivation to combine and a reasonable expectation of success. *See In re Stepan Co.*, 868 F.3d 1342, 1346 n. 1 (Fed. Cir. 2017); *see also Unified Patents Inc. v. GE Video Compression, LLC*, IPR2019-00726, Paper 7 at 22 (PTAB Aug. 6, 2019); *Reactive Surfaces Ltd., LLP v. Toyota Motor Corp.*, IPR2019-00867, Paper 6 at 9 (PTAB Sept. 18, 2019).

Here, however, Petitioner does not propose combining Outils' embodiments together so that actuator 23 could unlock/lock the electrical supply contactor and provides no reasons why a POSITA would have made such a combination. (Paper 1 at 40-41.) To be sure, there would be no reason to include Outils' actuator 23 in the same lawnmower as Outils' hold-to-run component 30, remote control cable 29, and electrical supply contactor system because Outils' hold-to-run component 30, remote control cable 29, and electrical supply contactor system performs the same function as Outils' actuator 23: they stop the motor and prevent it from restarting when the handle is rotated out of position. (*See* EX1014, Outils, at 4:14-17, 4:24-27, 5:1-8, 8:22-29; EX2027, Smith Decl., ¶¶ 153, 155; EX2028, Reed Transcript, at 89:2-10.)

Even if Outils' actuator 23 and electrical supply contactor were part of the same embodiment of Outils' "safety device" (they are not), Petitioner has failed to

show that the actuator 23 electrically disables and enables (*i.e.*, locks and unlocks) the electrical supply contactor as claimed because Petitioner ***does not even assert*** that actuator 23 electrically disables and enables the electrical supply contactor. (Paper 1 at 40-41; EX2027, Smith Decl., ¶ 154.) Likewise, Petitioner provides no evidence that actuator 23 and the electrical supply contactor are electrically connected such that actuator 23 could electrically disable and enable the electrical supply contactor. (*Id*.; EX2028, Reed Transcript, at 83:17-22; EX2027, Smith Decl., ¶ 154.) Indeed, the only description of the electrical supply contactor that Outils provides is that it is "acted on" by the remote control cable 29. (EX1014, Outils, at 4:6-7, claim 3; EX2027, Smith Decl., ¶ 154.)

Additionally, even if Outils' actuator 23 and electrical supply contactor were part of the same embodiment of Outils' "safety device" (again, they are not), Petitioner has failed to show that Outils' actuator 23 "locks" the electrical supply contactor so that the electrical supply contactor "is not allowed to start the motor" as claimed because Petitioner provides no evidence to show that the electrical supply contactor functions to ***start*** the motor. (Paper 1 at 40-41.) At best, Outils discloses that the electrical supply contactor functions to ***disable*** the motor when the handle 1 is rotated out of position or when the hold-to-run component 30 is released. (EX1014, Outils, at 4:5-8, 4:14-17, 5:4-8, claim 3; EX2027, Smith Decl., ¶ 156.)

Notably, Outils does not disclose how the mower is started. (EX2027, Smith Decl., ¶ 156.)

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

3. Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Outils With Roelle And Matsunaga.

(a) Petitioner Does Not Assert That A POSITA Would Have Been Motivated To Combine Outils With Roelle And Matsunaga.

Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Roelle and Matsunaga because Petitioner does not assert that a POSITA would have been motivated to combine all three 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 Kinetic Concepts, Inc. v. Smith & Nephew, Inc*., 688 F.3d 1342, 1366 (Fed. Cir. 2012) ("[defendant] still needed to proffer evidence indicating why a person having ordinary skill in the art would combine the references to arrive at the claimed invention.").

Here, Petitioner does not even assert that a POSITA would have been motivated to combine Outils with Roelle ***and*** Matsunaga. (*See generally* Paper 1 at

28-51.) Rather, Petitioner at best argues that a POSITA would have combined Outils ***individually*** with Roelle or Matsunaga. (*Id*.)

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

(b) Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Outils With Roelle As Proposed.

Petitioner has failed to show that Outils in view of Roelle and Matsunaga renders Challenged Claims 1-7 and 11-17 obvious because Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Roelle as proposed.

Petitioner proposes providing Roelle's alleged "locking structure" (*i.e.*, pin 68 and plate 26) in Outils' lawnmower to lock handle 1 in the alleged "accommodating position" of Outils' Figure 7. (Paper 1 at 34-36.) Petitioner asserts that a POSITA would have been "motivated by safety" to make this modification because a POSITA "would have recognized that Outils' lock 12 could inadvertently *and dangerously* allow handle 1 to rotate from its accommodating position of Figure 7, *i.e.*, a position when the mower is not in use and/or the user is emptying the cut-grass receptacle, to its in-use position of Figure 6 (or at least closer to that position)." (*Id*. at 34.)

Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Roelle as proposed because Petitioner's generic recitation of

"safety" as the sole reason for combining Outils with Roelle is conclusory, unsupported, and without merit. *See ActiveVideo Networks, Inc. v. Verizon Communications, Inc*., 694 F.3d 1312, 1327-28 (Fed. Cir. 2012) (holding that an expert's "generic" recitation of efficiency and market demand as purported motivations to combine were insufficient).

At the outset, Petitioner and its expert fail to provide any analysis, evidence, or explanation as to why locking Outils' handle in a non-use position would promote "safety" or why Outils' handle inadvertently rotating from a non-use position to an in-use position would be "dangerous" (Paper 1 at 34; EX1003, Reed Declaration, ¶ 75), and thus Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Roelle as proposed for this reason alone. *See In re Magnum Oil Tools Int'l., Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Further, Outils expressly discloses that its "safety device" ***eliminates the risk of danger*** to the user when the user is emptying the cut-grass receptacle in the non-use position, which further confirms that Petitioner's conclusory and unsupported assertion that Outils' handle could "dangerously" rotate from a non-use position to an in-use position is without merit:

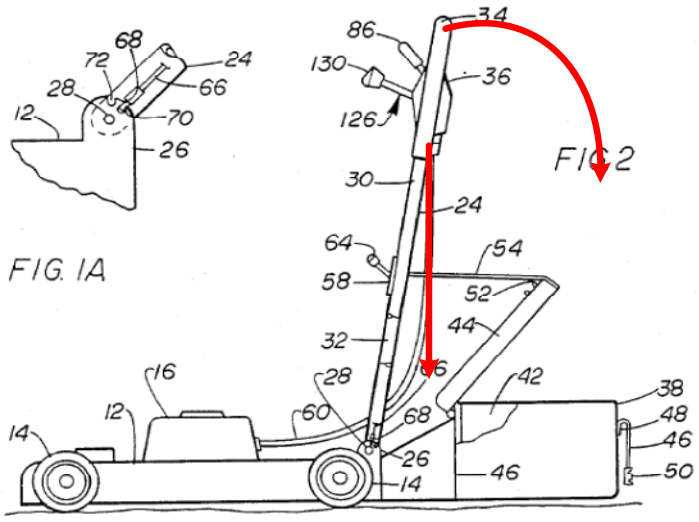
> Owing to the invention, it is possible to implement a safety device preventing access to the rotating cutting blade, for lawnmower of the push mower or self-propelled type, that makes it possible to carry out the cut-grass receiving receptacle hooking and unhooking operations only when the blade is stationary, and so ***without any danger to the***

> ***user***. Indeed, depending on the specific case, during these operations the device automatically shuts off the cutting blade or prevents the operation while the cutting blade is still rotating, such that ***any risk of accidental injury by an object being projected or entering the active area of said cutting blade is avoided***.

(EX1014, Outils at 10:22-29 (emphases added).)

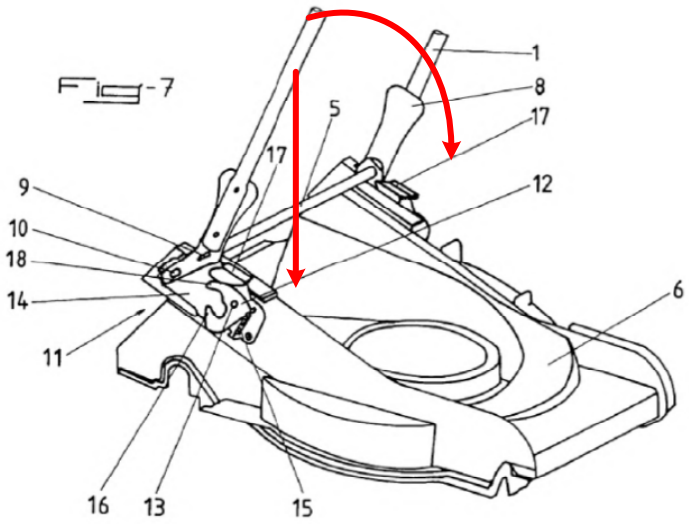
Additionally, Petitioner has failed to present any evidence that a POSITA at the time of the invention of the Challenged Claims would have been motivated to add safety features to Outils ***beyond*** those required by the relevant lawnmower industry safety standards and regulations (*i.e.*, the ANSI B71.1 lawnmower standard and 16 CFR 1205). (Paper 1 at 27 (citing EX1003, Reed Declaration, ¶ 62).) Rather, Petitioner asserts that a POSITA would have been motivated to design lawnmowers ***according to*** the ANSI B71.1 lawnmower standard and 16 CFR 1205. (*Id*.) Indeed, Petitioner's expert testified during his deposition that whether a lawnmower is reasonably "safe" depends on whether it complies with the ANSI B71.1 lawnmower standard and 16 CFR 1205. (EX2028, Reed Transcript, at 59:9-20, 62:3-6, 77:4-14, 77:17-20.) However, neither the ANSI B71.1 lawnmower standard nor 16 CFR 1205 discloses or requires a locking mechanism for locking the handle in a non-use position. (EX2027, Smith Decl., ¶ 161; EX1011, Roelle, at 3:38-43, 3:67-4:5; EX1030, ANSI B71.1, at 16-17 (10.7.2.1-2) (requiring only that the handle lock in the "operating position"); *see generally* EX1008, 16 CFR 1205 (failing to even mention a lock or locking system).)

Moreover, a POSITA would have understood that the reason why Roelle's pin 68 and plate 26 locking system is included in Roelle's lawnmower is ***inapplicable*** to Outils' lawnmower, and thus a POSITA would have had no reason to add Roelle's pin 68 and plate 26 locking system to Outils. In Roelle, the center-of-mass of the handle 24 is located behind the lawnmower main body 12 when the handle 24 is in the alleged "accommodating position" of Figure 2, and thus gravity would cause Roelle's handle 24 to automatically and undesirably ***rotate back to the in-use position*** of Figure 1 if there were no locking mechanism present. (EX2027, Smith Decl., ¶ 163.) Accordingly, as shown below, Roelle adopted a pin 68 and plate 26 locking system to prevent gravity from rotating the handle 24 back into the in-use position so that the user could access the grass cuttings container 38 (*id.*):



(EX1011, Roelle, at FIG. 2 (annotated).)

In Outils, however, the center-of-mass of the handle 1 is located over the lawnmower main body 6 when the handle 1 is in the alleged "accommodating position" of Figure 7, and thus gravity would cause Outils' handle 1 to ***"lock" in the non-use position*** of Figure 7 regardless of whether there is a mechanical locking mechanism present. (EX2027, Smith Decl., ¶ 164.) Thus, a POSITA would have known that there is no reason to add a locking mechanism to Outils to lock the handle in the non-use position. (*Id*., ¶¶ 164-165.)



(EX1014, Outils, at FIG. 7 (annotated).)

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

(c) Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Outils With Matsunaga As Proposed.

Petitioner has likewise failed to show that Outils in view of Roelle and Matsunaga renders Challenged Claims 1-7 and 11-17 obvious because Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Matsunaga as proposed.

Petitioner proposes implementing Outils' actuator 23 using Matsunaga's contact switches 11 or 12. (Paper 1 at 43-44; EX2028, Reed Transcript, at 122:2-7.) Petitioner asserts that a POSITA would have been motivated to make this modification "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." (*Id*. at 41-42.)

At the outset, Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Matsunaga because Matsunaga's teachings are ***irrelevant*** to Outils' lawnmower. Matsunaga expressly relates to improvements to "conventional motor-operated electric power tool[s] [that] use[] a ***semiconductor switch*** for closing/interrupting a current path from a power source to a motor" by addressing issues that may arise if the ***semiconductor switch*** short-circuits.

(EX1006, Matsunaga, at 1:7-25; EX2027, Smith Decl., ¶ 111.) Outils' lawnmower, however, does not have a semiconductor switch (*see generally* EX1014, Outils; Paper 1 (Petitioner failing to assert that a POSITA would have understood Outils' lawnmower to have a semiconductor switch)), and thus Matsunaga's teachings are irrelevant to Outils' semiconductor-less lawnmower. (EX2027, Smith Decl., ¶ 111.) Accordingly, a POSITA considering Outils' semiconductor-less lawnmower would have had no reason to look to Matsunaga. (*Id*.)

Additionally, Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Matsunaga as proposed because each of Petitioner's alleged reasons for combining Outils with Matsunaga is unsupported.

First, Petitioner's assertion that Matsunaga discloses that it is not desirable to pass high current through contact switches is unsupported and contradicted by Matsunaga. In fact, Matsunaga expressly discloses that it is desirable to pass high current through a contact switch because the "[r]eliability of the tool is ***improved***" in such designs. (EX1006, Matsunaga, at 1:38-43 (emphasis added); EX2027, Smith Decl., ¶ 104.) Moreover, Matsunaga expressly discloses that designs where high current ***does not*** pass through a contact switch can have significant ***drawbacks***. Specifically, a short-circuit of the semiconductor switch that controls the current path between the power source and the motor may cause the motor to continuously

operate even after the user releases the contact switch. (EX1006, Matsunaga, at 1:17-25, 2:17-23, 2:38-58, 9:24-39, 12:9-25; EX2027, Smith Decl., ¶ 105.)

While Matsunaga discloses that contact switches with "large contact capacity" sufficient for carrying high current are larger and more expensive than contact switches with "small contact capacity" (EX1006, Matsunaga, at 1:44-48, 9:56-67), a POSITA would have known that any size or cost savings realized from replacing Outils' actuator 23 with Matsunaga's "small contact capacity" contact switches 11 or 12 would be far outweighed by the numerous ***additional and costly components*** (*i.e.*, at least two semiconductor switches, a CPU, a gate, wiring to connect these components to each other and to the motor, and hardware for mounting these components in the lawnmower) that would need to be ***added*** to Outils to implement Matsunaga's contact switches 11 or 12. (EX2027, Smith Decl., ¶ 106; *see also* EX1006, Matsunaga, at FIG. 2, FIGS. 6-7, 7:37-8:31; Paper 1 at 43-44; Paper 21 at 54.)

Second, Petitioner's assertion that it is "dangerous" for high current to flow through a contact switch is unsupported. At no point does Matsunaga disclose that it is "dangerous" for high current to flow through a contact switch. (*See generally* EX1006, Matsunaga; EX2027, Smith Decl., ¶ 107.) Indeed, the terms "danger" and "dangerous" do not appear anywhere in Matsunaga. (*Id*.) Simply put, Petitioner has failed to offer any evidence that it is "dangerous" to pass high current through a

contact switch. (Paper 1 at 42.) Nevertheless, even if Petitioner had demonstrated that it is "undesirable" or "dangerous" to pass high current through a contact switch (it has not), Outils expressly discloses that actuator 23 can be "mechanical" instead of "electrical." (EX1014, Outils, at 8:22-24.) Consequently, simply implementing Outils' actuator 23 as a mechanical component instead of an electrical component would solve any purported issues associated with passing high current through actuator 23 and would thus negate each of Petitioner's asserted reasons for combining Outils with Matsunaga. (EX2027, Smith Decl., ¶ 108.)

Third, Petitioner's assertion that a POSITA would have combined Outils with Matsunaga to avoid the thick wiring purportedly associated with large capacity contact switches is unsupported. Matsunaga expressly states that, "***depending on a region in the tool where the contact switch is disposed***, a thick wiring line through which a large current flows may have to be installed over a long distance." (EX1006, Matsunaga, at 1:49-52 (emphasis added).) Matsunaga also states that in its disclosed trimmer "there is a ***physically large distance*** from the operation switches operated by the user to the motor" and thus the "wiring lines from the respective switches to the motor and the power supplier become ***long***." (*Id*. at 5:4-8 (emphases added); *see also id*. at 9:44-54, FIG. 1.) In Outils, however, the distance between actuator 23 and the motor is ***short*** because actuator 23 is installed directly on the mower casing 6. (EX1014, Outils, at FIG. 10; EX2027, Smith Decl., ¶ 109.) Thus, Matsunaga's

concern of thick wiring being installed over a long distance is ***inapplicable*** to Outils. (EX2027, Smith Decl., ¶ 109.) Indeed, Matsunaga does not identify any issues with thick wiring in its second embodiment depicted in FIG. 3 where contact switches 31 and 32 are positioned close to the motor 25. (*See generally* EX1006, Matsunaga, at 10:6-12:44.)

Further, as noted above, any size or cost savings attributable to connecting Outils' actuator 23 to the motor using thin instead of thick wires would be far outweighed by the numerous additional and costly components (*i.e.*, at least two semiconductor switches, a CPU, a gate, wiring to connect these components to each other and to the motor, and hardware for mounting these components in the lawnmower) that would need to be added to Outils to implement Matsunaga's contact switches 11 or 12. (EX2027, Smith Decl., ¶ 110.)

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

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

Petitioner has failed to show that Outils in view of Matsunaga and Roelle renders Challenged Claims 1-7 and 11-17 obvious because Petitioner and its expert ***do not assert*** that a POSITA would have had a reasonable expectation of success in

combining Outils with Roelle as proposed. (*See generally* Paper 1 at 27-51; EX1003, Reed Declaration, ¶¶ 64-110.)

B. Ground 2: Petitioner Has Failed To Show That Outils In View Of Roelle, Matsunaga, Langdon, And Nakano Renders Challenged Claims 8-10 And 18-20 Obvious.

Petitioner has failed to show that Outils in combination with Roelle, Matsunaga, Langdon, and Nakano renders Challenged Claims 8-10 and 18-20 obvious in view of their dependency on Challenged Claims 1 and 11. 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*. Because Petitioner has failed to show that Outils in combination with Roelle and Matsunaga renders Challenged Claims 1 and 11 obvious, Petitioner has likewise failed to show that Outils in combination with Roelle, Matsunaga, Langdon, and Nakano renders Challenged Claims 8-10 and 18-20 obvious.

1. Petitioner Has Failed To Show That Nakano Is Analogous Art To The Claimed Invention Of The '26686 Patent.

(a) Petitioner Has Failed To Show That Nakano Is From The Same Field Of Endeavor As The '26686 Patent.

Petitioner has failed to show 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.)

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 performance and 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); EX2027, Smith Decl., ¶ 87.) 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; EX2027, Smith Decl., ¶ 88.) 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 have very different design considerations and requirements. (EX2027, Smith Decl., ¶ 89.) For example, 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.), are subject to different safety standards and safety considerations, and lawnmowers are heavier than bush cutters and require a lot more power than bush cutters because they are used to cut a larger area. (*Id*.) Thus, a

POSITA designing a lawnmower would have had no reason to look to hand-held bush cutters. (*Id*.)

Accordingly, Petitioner has failed to show that Nakano is from the same field of endeavor as the '26686 patent.

(b) Petitioner Has Failed To Show That Nakano Is Reasonably Pertinent To The Particular Problem The Inventor Of The '26686 Patent Was Trying To Solve.

Petitioner has also failed to show 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.)

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, 1:54-62, claims 1 and 11; *see also* Paper 1 at 5; EX2027, Smith Decl., ¶ 91.)

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; EX2027, Smith Decl., ¶ 92.) Nakano does not disclose and has nothing to do with safety features for lawnmowers, and thus Nakano is directed to a different purpose than the '26686 patent. (*Id*.)

Accordingly, Petitioner has failed to show that Nakano is reasonably pertinent to the particular problem the inventor of the '26686 patent was trying to solve.

2. Petitioner Has Failed To Show That The Combination Of Outils, Roelle, Matsunaga, Langdon, And Nakano Discloses, Teaches, Or Suggests Every Limitation Of Challenged Claims 8-10 And 18-20.

(a) Petitioner Has Failed To Show That Nakano Discloses, Teaches, Or Suggests "wherein the handle comprises a plurality of telescopic members for connecting the operation assembly to the main body, and wherein, when a one of the plurality of telescopic members extends to the designated position relative to another of the plurality of telescopic members, a third control device unlocks the first control device so that the first control device is capable of starting the motor, and, when the one of the plurality of telescopic members is in a positoin other then the designated positoin, the third control locks the first control device so that the first control device is not capable of starting the motor" ("Third Control Device Limitation").

Petitioner has failed to show that Nakano discloses, teaches, or suggests the Third Control Device Limitation of Challenged Claims 8 and 18.[3]

[3] Petitioner relies solely on Nakano for the Third Control Device Limitation. (Paper 1 at 54-64.)

Under the Third Control Device Limitation, the claimed "third control device" of the control system must be configured to be controlled by the telescopic action of the telescopic handle, must be configured to "unlock" (*i.e.*, electrically enable) the claimed "first control device" so that the first control device is capable of starting the motor, and must be configured to "lock" (*i.e.*, electrically disable) the first control device so that the first control device is not capable of starting the motor. (EX1001, '26686 patent, at claims 8 and 18; EX2027, Smith Decl., ¶ 172.)

Petitioner asserts that Nakano discloses a telescoping handle that purportedly includes a "pipe 40," a "pipe 80," and a "handle unit 41." (Paper 1 at 55.) Petitioner also asserts that Nakano discloses several "control devices" that purportedly meet the Third Control Device Limitation. (*Id*. at 57.)

First, Petitioner cannot show that any of Nakano's "control devices" are the claimed "third control device" configured to be controlled by the telescopic action of a telescopic handle because Nakano ***does not disclose, teach, or suggest a telescopic handle***.

A POSITA would understand a "handle" to be a part by which a thing is held or controlled. (EX2027, Smith Decl., ¶ 117.) A POSITA also would have understood Nakano's "handle unit 41" to be Nakano's "handle" because it is the part by which Nakano's bush cutter is held and controlled. (*Id*.; *see also* EX1015, Nakano, at 8, FIGS. 1-2, FIG. 17 (Nakano disclosing a "handle unit 41" that

comprises a U-shaped handle pipe 42 that has two grip portions 43 attached to both ends of the handle pipe 42); *id*. at 35 (Nakano further disclosing that a user controls Nakano's bush cutter by moving the handle pipe 42 while gripping the grip portions 43).) Notably, Nakano ***does not*** disclose, teach, or suggest that its handle (*i.e.*, "handle unit 41") is telescopic. (EX2027, Smith Decl., ¶ 117; *see generally* EX1015, Nakano.)

While Petitioner asserts that Nakano's handle is also comprised of telescopically-coupled pipes 40 and 80 (Paper 1 at 55), Nakano's pipes 40 and 80 are not part of Nakano's handle because Nakano does not disclose, teach, or suggest that Nakano's bush cutter is held or controlled by pipes 40 or 80 (EX2027, Smith Decl., ¶ 118; *see generally* EX1015, Nakano). Rather, Nakano discloses that pipes 40 and 80 comprise the main "contracting rod" that connects the "operation unit 10" to the "driving unit 151." (EX2027, Smith Decl., ¶ 118; EX1015, Nakano, at 7-8, FIGS. 1-2.) Accordingly, Nakano does not disclose, teach, or suggest a telescopic handle, and thus Nakano does not disclose, teach, or suggest the claimed "third control device" configured to be controlled by the telescopic action of a telescopic handle.

Second, Petitioner has failed to show that Nakano discloses, teaches, or suggests the Third Control Device Limitation because Petitioner ***does not even assert*** that Nakano's "control devices" unlock or lock any alleged "first control

device" as claimed. (*See generally* Paper 1 at 54-64.) Rather, Petitioner merely asserts that Nakano's "control devices" enable or disable Nakano's alleged "operation assembly." (*Id*. at 57, 63.)

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

3. Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Outils With Roelle, Matsunaga, Langdon, And Nakano.

(a) Petitioner Does Not Assert That A POSITA Would Have Been Motivated To Combine Outils With Roelle, Matsunaga, Langdon, And Nakano.

Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, Langdon, and Nakano because Petitioner ***does not assert*** that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, Langdon, ***and*** Nakano. (*See generally* Paper 1 at 51-67.) Rather, Petitioner at best asserts that a POSITA would have combined Outils ***individually*** with Roelle, Matsunaga, Langdon, or Nakano. (*Id*.) Thus, Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Roelle, Matsunaga, Langdon, and Nakano for this reason alone.

(b) Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Outils With Langdon As Proposed.

Petitioner has failed to show that Outils in view of Roelle, Matsunaga, Langdon, and Nakano renders Challenged Claims 8-10 and 18-20 obvious because

Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Langdon as proposed.

Challenged Claims 8 and 18 recite that "the handle comprises a plurality of telescopic members for connecting the operation assembly to the main body." (EX1001, '26686 patent, at claims 8 and 18.) Petitioner concedes that Outils does not disclose a handle comprising a plurality of telescopic members, but asserts that it would have been obvious to use Langdon's telescopic handle in Outils' mower. (Paper 1 at 52-54.) Petitioner asserts that a "POSITA would have been motivated by the collapsibility of Langdon's telescopic handle, and by the fact that it does not have to be removed from the lawnmower body," and that a "POSITA would have recognized the advantage of collapsing Outils' handle to make the lawnmower easier to ship and store." (*Id*. at 53.)

As shown below, a POSITA would not have been motivated to use Langdon's telescopic handle in Outils' lawnmower because: (i) Outils' lawnmower is incompatible with a telescopic handle; and (ii) Outils already suggests that its handle is collapsible.

First, a POSITA would not have been motivated to use Langdon's telescopic handle in Outils' lawnmower because a POSITA would have known that Outils' lawnmower is incompatible with a telescopic handle. *See In re Fritch*, 972 F.2d 1260, 1266 n. 12 (Fed. Cir. 1992) (holding that a proposed modification is

inappropriate for an obviousness inquiry when the modification would render the prior art reference inoperable for its intended purpose).

Petitioner asserts that the alleged "first control device configured to be controlled by [an] operation assembly" of Outils is an electrical supply contactor controlled by a remote control cable 29 that is actuated by a hold-to-run component 30 located at the end of the handle 1. (Paper 1 at 31, 40.) Outils' remote control cable 29 runs in a straight line along the inside of the handle 1 from one end to the other. (EX1014, Outils, at FIGS. 1-4; EX2027, Smith Decl., ¶ 124; EX2028, Reed Transcript, at 85:2-8.) A POSITA would have understood Outils' remote control cable 29 to be a Bowden cable. (EX2027, Smith Decl., ¶ 125; EX2028, Reed Transcript, at 141:1-4 (Petitioner's expert testifying that Outils' remote control cable 29 is a Bowden cable).) A POSITA also would have known that a Bowden cable is incompressible. (EX2027, Smith Decl., ¶ 126; EX2028, Reed Transcript, at 141:5-7 (Petitioner's expert testifying that Bowden cables are incompressible).)

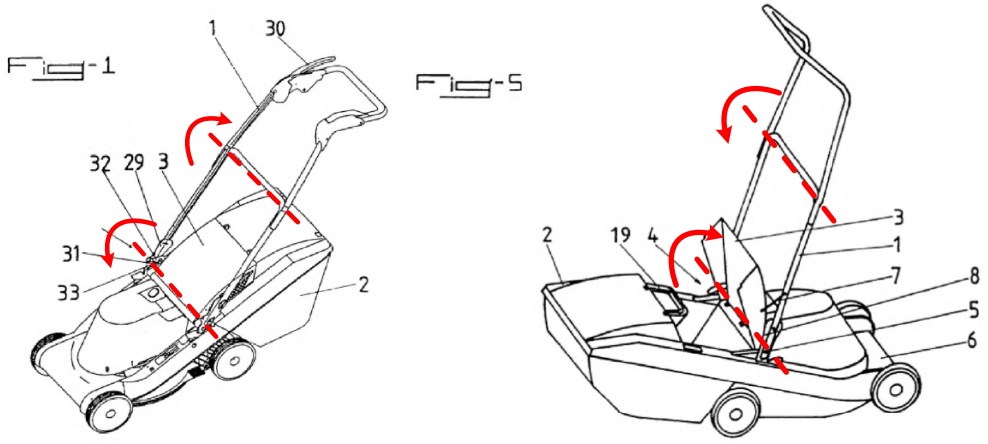
Because Outils' remote control cable 29 would need to be capable of compression to accommodate changes in length of a telescopic handle, but a POSITA would have understood that Outils' remote control cable 29 is incapable of compression because it is a Bowden cable, a POSITA would have known that Outils' lawnmower is incompatible with a telescopic handle such as Langdon's. (EX2027, Smith Decl., ¶ 127.)

Further, even if Outils' cable 29 were compressible, a POSITA would have known that if Outils' lawnmower were modified to have a telescopic handle then Outils' cable 29 would kink inside the handle every time the handle is shortened. (EX2027, Smith Decl., ¶ 128.) Over time, this kinking would cause damage to the cable 29. (*Id*.) After enough repetitions the cable 29 would break, rendering Outils' lawnmower inoperable. (*Id*.; *see also* EX1014, Outils, at 4:14-17 (disclosing that Outils' motor is inoperable unless remote control cable 29 is tensioned).)

Second, a POSITA would not have been motivated to use Langdon's telescopic handle in Outils' lawnmower because Outils already suggests that its handle is collapsible. The Federal Circuit has held that there is no motivation to modify a prior art reference to address a given problem when the reference already addresses the problem. *See, e.g., Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1332 (Fed. Cir. 2019) (affirming the Board's finding that a POSITA would not have been motivated to add the claimed cooking oil quality sensor to a prior art system where the prior art system already taught a cooking oil quality sensor); *In re Anova Hrg. Labs, Inc.*, 2019-1507, 2020 WL 1685552, at *3 (Fed. Cir. Apr. 7, 2020) (vacating the Board's finding of obviousness where the Board failed to explain why a POSITA would have been motivated to modify a prior art reference to address the problem of occlusion effect in hearing aids when the reference already included vents to address the problem); *Sony Corp. v. Fujifilm Corp.*, IPR2018-01751, Paper

No. 14 at 11 (PTAB April 12, 2019) ("Petitioner does not explain adequately why modifying Ejiri in view of the teachings of Hokkyo and Chen would have been an improvement on what Ejiri already provides…").

As Petitioner notes, Outils discloses a U-shaped handle. (Paper 1 at 52; EX1014, Outils, at FIGS. 1 and 5.) A POSITA would have recognized that Outils' U-shaped handle resembles a U-shaped lawnmower handle that is designed to fold in half and rotate over the main body to a compact storage position. (EX2027, Smith Decl., ¶¶ 130-132; EX2028, Reed Transcript, at 138:16-139:5 ()Petitioner's expert testifying that Outils' handle is foldable).) Such folding U-shaped lawnmower handles were well-known and widely available ***decades*** before the invention of the Challenged Claims. (EX2027, Smith Decl., ¶¶ 130-132; EX2028, Reed Transcript, at 138:16-139:1.) In view of the visual and structural similarity between Outils' U-shaped handle and common prior art folding U-shaped lawnmower handles, Outils' figures would have suggested to a POSITA that the handle can be folded to a compact storage position along the axes shown below (EX2027, Smith Decl., ¶ 133; EX2028, Reed Transcript, at 138:16-139:5):



(EX1014, Outils, at FIGS. 1 and 5 (annotated).)

Accordingly, Outils suggests that its handle already addresses Petitioner's sole reason for combining Outils with Langdon (*i.e.*, the collapsibility of Langdon's handle) (*see* Paper 1 at 53), and thus a POSITA would not have been motivated to combine Outils with Langdon. (EX2027, Smith Decl., ¶ 135.)

Accordingly, Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Langdon as proposed.

(c) Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Outils With Nakano As Proposed.

Petitioner has likewise failed to show that Outils in view of Roelle, Matsunaga, Langdon, and Nakano renders Challenged Claims 8-10 and 18-20 obvious because Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Nakano as proposed.

Petitioner proposes "incorporating" Nakano's alleged "control devices" in Outils' "modified" lawnmower (*i.e.*, Outils' lawnmower with a telescopic handle). (Paper 1 at 65.)

Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Nakano as proposed because Petitioner provides no reasons ***why*** a POSITA would have combined Outils' modified lawnmower with Nakano and ***does not even assert*** that a POSITA would have been motivated to combine Outils' modified lawnmower with Nakano. (*See generally* Paper 1 at 54-67.) Similarly, Petitioner fails to explain ***how*** Outils' modified lawnmower would be combined with Nakano to arrive at the claimed invention of Challenged Claims 8 and 18. For example, Challenged Claims 8 and 18 recite that the claimed "third control device" must be configured to "unlock" and "lock" the claimed "first control device." (EX1001, '26686 patent, at claims 8 and 18.) But Petitioner ***does not even assert*** that Nakano's alleged "control devices" would unlock or lock Outils' electrical supply contactor (*i.e.*, the alleged "first control device") as claimed. (*See generally* Paper 1 at 54-64.)

Petitioner states in the Petition that Nakano purportedly "improves safety of a telescoping handle by detecting whether it has partially collapsed, and braking/disabling the grass cutter's motor accordingly." (Paper 1 at 55.) Even if the Board considers this statement a purported motivation to combine (it should not),

Petitioner's statement is factually unsupported because, as discussed above, Nakano does not disclose, teach, or suggest a telescopic handle. (EX2027, Smith Decl., ¶ 118.)

Further, Petitioner's statement is insufficient to prove that the Challenged Claims are obvious because Petitioner has failed to explain why "safety" would have prompted a POSITA to "incorporate" Nakano's alleged "control devices" in Outils' modified lawnmower. *See ActiveVideo*, 694 F.3d at 1327-28 (holding that an expert's "generic" recitation of efficiency and market demand as purported motivations to combine were insufficient); *Purdue Pharma L.P. v. Depomed, Inc.*, 643 Fed. Appx. 960, 966 (Fed. Cir. 2016) (holding that petitioner improperly relied on hindsight where petitioner relied on the problem to be solved to supply the reason to combine the prior art and failed to demonstrate that the problem was known in the art).

First, Petitioner has failed to present any evidence that a POSITA at the time of the invention of the Challenged Claims would have been motivated to add safety features to Outils ***beyond*** those required by the relevant lawnmower industry safety standards and regulations (*i.e.*, the ANSI B71.1 lawnmower standard and 16 CFR 1205). (Paper 1 at 27 (citing EX1003, Reed Declaration, ¶ 62).) Rather, Petitioner asserts that a POSITA would have been motivated to design a lawnmower ***according to*** the ANSI B71.1 lawnmower standard and 16 CFR 1205. (*Id*.) Indeed, Petitioner's

expert testified during his deposition that whether a lawnmower is reasonably "safe" depends on whether it complies with the ANSI B71.1 lawnmower standard and 16 CFR 1205. (EX2028, Reed Transcript, at 59:9-20, 62:3-6, 77:4-14, 77:17-20.) However, neither the ANSI B71.1 lawnmower standard nor 16 CFR 1205 discloses or requires—and Petitioner does not assert that the ANSI B71.1 lawnmower standard or 16 CFR 1205 discloses or requires—a safety feature like Nakano's alleged "control devices" that are purportedly controlled according to the sliding position of Nakano's telescoping tubes. (EX2027, Smith Decl., ¶ 217; *see also* Paper 1 at 54-64.)

Second, "incorporating" Nakano's alleged "control devices" in Outils' modified lawnmower would not have "improved the safety" of Outils' modified lawnmower—assuming a POSITA could have and would have modified Outils' lawnmower to have a telescopic handle in the first place (as discussed above, they could not have and would not have done so)—because Outils' modified lawnmower would already have included a system for braking/disabling the motor when the handle is partially collapsed.

As noted above, Petitioner relies on Outils' electrical supply contactor controlled by remote control cable 29 and hold-to-run component 30 for the claimed "first control device configured to be controlled by [an] operation assembly." (Paper 1 at 31, 40.) According to Outils, the motor can operate only when remote control

cable 29 is tensioned by hold-to-run control component 30. (EX1014, Outils, at 4:29-5:8; EX2027, Smith Decl., ¶ 141.) The motor will stop and will be unable to resume operation if there is slack on remote control cable 29—regardless of whether hold-to-run control component 30 is actuated. (EX1014, Outils, at 4:24-27, 5:1-8; EX2027, Smith Decl., ¶ 141; EX2028, Reed Transcript, at 87:17-19, 88:20-89:1.) Assuming that a POSITA would have and could have modified Outils to have a telescopic handle (as discussed above, they could not have and would not have done so), partially collapsing the handle would introduce slack on remote control cable 29 due to the decreased distance between the end of the handle (where one end of the cable 29 is connected) and the mower body (where the other end of cable 29 is connected). (EX2027, Smith Decl., ¶ 141.) Consequently, partially collapsing the handle would cause Outils' remote control cable 29 to stop and disable the motor, and thus adding Nakano's alleged "control devices" to Outils' modified lawnmower would have done nothing to improve the safety of Outils' lawnmower. (EX2027, Smith Decl., ¶¶ 140-141, 182.)

Petitioner also states in the Petition that a "POSITA would [] have found [Outils' and Nakano's] designs to [be] compatible for obvious combination." (Paper 1 at 57.) To the extent the Board considers this statement a purported motivation to combine (it should not), the statement is without merit because it is conclusory, unsupported, and insufficient as a matter of law.

First, Petitioner's only support for its assertion that Outils' and Nakano's designs are allegedly "compatible for combination" is that both references purportedly teach a motor within a main body. (Paper 1 at 57.) But even a cursory review of Outils and Nakano demonstrates that Outils' and Nakano's designs are ***very dissimilar and not compatible***. (EX2027, Smith Decl., ¶ 183.) For example, (i) Outils discloses a lawnmower, whereas Nakano discloses a bush cutter; (ii) Outils' lawnmower is pushed from behind, whereas Nakano's bush cutter is hand-held; and (iii) Outils' cutting blade is covered by a casing, whereas Nakano's cutting blade is exposed. (*See, e.g.,* EX1014, Outils, at FIGS. 1 and 5; EX1015, Nakano, at FIG. 1.) Outils' lawnmower and Nakano's bush cutter are also subject to different safety standards. (EX2027, Smith Decl., ¶ 183.) Thus, Petitioner's assertion that Outils' and Nakano's designs are "compatible for combination" is conclusory, factually unsupported, and wrong.

Second, it is well-settled in the Federal Circuit that whether a POSITA ***could*** combine certain prior art references does not demonstrate that a POSITA ***would*** have been motivated to do so. *See InTouch Techs., Inc. v. VGO Commun., Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014). Thus, whether Outils' and Nakano's designs are allegedly "compatible for combination" has no legal bearing on whether a POSITA would have combined Outils with Nakano.

Accordingly, Petitioner has failed to show that a POSITA would have been motivated to combine Outils with Nakano as proposed.

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

Petitioner has failed to show that Outils in view of Roelle, Matsunaga, Langdon, and Nakano renders Challenged Claims 8-10 and 18-20 obvious because 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, or Nakano as proposed. (*See generally* Paper 1 at 51-67; EX1003, Reed Declaration, ¶¶ 111-131.)

VI. PETITIONER FAILED TO IDENTIFY ALL REAL PARTIES IN INTEREST.

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, applying Federal Circuit law, 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) (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.). "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.* (emphasis added). Here, Petitioner failed to identify two real parties in interest, namely, Techtronic and Homelite, and the Board should dismiss this proceeding.

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 (i) controls or has the opportunity to exercise control over Petitioner and (ii) is a clear beneficiary of a Board finding of unpatentability.

Techtronic controls, or at least has the opportunity to control, Petitioner. The Board has held that "an involved and controlling parent corporation" may indeed be an RPI. *ZOLL Lifecor Corp. v. Philips Elec. N. Am. Corp.*, IPR 2013-00606, Paper 13, at 10 (PTAB Mar. 20, 2014). Here, Techtronic is a real party in interest because Techtronic is the indirect, 100% owner of Petitioner and therefore controls or could have exercised control over Petitioner with respect to this proceeding. (*See* EX2006, District Court Litigation, Defendants' Rule 7.1 Corporate Disclosure Statement; EX2029, Sowell Transcript, 60:2-61:1.) Lee Sowell, Petitioner's Group President for Outdoor Power Equipment (EX2029, Sowell Transcript, 11:5-7), testified that his boss is the CEO of Techtronic (*id.* at 76:20-77:10). And when asked what he discussed with his boss at Techtronic, Mr. Sowell testified that he discussed primarily operations reviews and reporting financial results. (*Id.* at 76:7-14.) And when asked about the regularity of his discussions with Techtronic's CEO, Mr. Sowell explained that he spoke with him frequently, anywhere from once a day to once a week. (*Id.* at 77:11-13.) Mr. Sowell's testimony confirms what is already apparent from the 100% ownership relationship between Techtronic and Petitioner: Techtronic controls or can control—indeed on at least a weekly basis—Petitioner's operations. These facts, alone, demonstrate that Techtronic is an unnamed RPI.

Techtronic is also an unnamed RPI because it had a pre-existing relationship with Petitioner and stands to clearly benefit if the Board finds the challenged claims unpatentable. *See Ventex*, IPR2017-00651, Paper 148. For example:

Pre-existing Relationship

- Techtronic and Petitioner collectively answered the Complaint in the District Court Litigation. (EX2007.)
- Techtronic and Petitioner share counsel in the parallel District Court Litigation. (*See, e.g., id.*; EX2008 at 7-8.)
- Techtronic and Petitioner have answered discovery collectively in the District Court Litigation. (*Id.* at 1.)
- Techtronic and Petitioner engaged in joint settlement negotiations in the District Court Litigation. (EX2004, Declaration of Mike Clancy, ¶¶ 4-5; EX2029, Sowell Transcript, at 74:18-75:18.)
- Petitioner's former President, Michael Farrah, testifying in another proceeding, stated during a deposition that he could not distinguish between the Petitioner and Techtronic (and another related TTi entity), and that they are all really part of the same company. (EX2024 at 2-3.)

Clear Beneficiary

- Techtronic admits that its and Petitioner's financial performance are intertwined. (EX2005, § 52 ("Particulars of Principal Subsidiaries.").)[4] 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.)

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

- Petitioner's CEO admitted that Techtronic and Petitioner both stood to benefit from a finding of unpatentability. (EX20209, Sowell Transcript, at 81:18-83:9.)

Ultimately, a Board holding of unpatentability could improve Techtronic's financial results and could lead to a better result for Techtronic as a named defendant in the co-pending District Court Litigation. All of these considerations demonstrate that Techtronic and Petitioner had a pre-existing established relationship and that Techtronic is a clear beneficiary should the Board conclude that the challenged claims are invalid.

Accordingly, the Board should dismiss this proceeding 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 Homelite from its mandatory notices. Homelite is a real party in interest because it is a clear beneficiary of Petitioner's filing of this Petition that had a preexisting relationship with Petitioner.[5]

Homelite is a clear beneficiary of Petitioner's filing of this proceeding because it has committed multiple infringing acts of the Challenged Claims. According to

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

Petitioner, Techtronic, and Homelite in the parallel District Court Litigation, "[a]ll of the Accused Products are imported and distributed by Homelite Consumer Products, Inc." (EX2008 at 6.) To the extent that the Accused Products infringe the Challenged Claims (as Patent Owner has alleged in the District Court Litigation), Petitioner, Techtronic, and Homelite have admitted that Homelite has committed multiple infringing acts. (*See id.*) Thus, Homelite does not merely have a generalized interest in invalidating the Challenged Claims, it would receive a direct benefit that renders it an RPI. Moreover, Petitioner's CEO admitted that Homelite stood to benefit from a finding of unpatentability. (EX20209, Sowell Transcript, at 81:18-83:9.)

Homelite is also an RPI in view of its pre-existing, established relationship with Petitioner. *See Ventex*, IPR2017-00651, Paper 148. Homelite does not have any employees and their entire operation depends on its relationship with Petitioner. (EX20209, Sowell Transcript, at 65:13-66:1, 66:6-22, 67:4-11, 68:20-69:3.) Simply, Homelite cannot operate without Petitioner.

Additional facts also demonstrate a pre-existing, established relationship between Petitioner and Homelite. Homelite and Petitioner share a principal place of business: 100 Innovation Way, Anderson, South Carolina 29621. (EX2007 at 2; EX2029, Sowell Transcript, 38:1-17.) Homelite is Petitioner's sole vendor of record to the Home Depot for outdoor power equipment, including lawnmowers. (*Id.* at

39:7-16, 54:5-14.) Homelite and Petitioner (and Techtronic) share counsel in the Litigation; (*See, e.g.,* EX2007.) Techtronic, Petitioner, and Homelite all engaged in joint settlement negotiations in which this proceeding was used as leverage to attempt (unsuccessfully) to secure a dismissal of the parallel District Court proceeding against Techtronic, Petitioner, and ***Homelite***. (EX2004, Declaration of Mike Clancy, ¶¶ 4-5; EX2029, Sowell Transcript, 74:18-75:18.) The strength of the pre-existing relationship between Homelite and Petitioner confirms that Homelite is an unnamed RPI.

Accordingly, the Board should dismiss this proceeding for Petitioner's failure to include Homelite as an RPI.

C. The Board Should Not Allow Petitioner To Update Its RPIs And Maintain Its Original Filing Date.

The Board considers the following factors to determine whether to allow a Petitioner to amend its mandatory notices to include unnamed RPIs: whether there has been … bad faith by the petitioner, … or … gamesmanship by the petitioner. *Elekta, Inc. v. Varian Medical Systems, Inc.*, Case IPR2015-01401, Paper 19 (PTAB Dec. 31, 2015); *see also Proppant Express Investments v. Oren Techs.*, IPR2017-01917, Paper 86 (precedential); *see also Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1355 (Fed. Cir. 2018) (noting that a party cannot use willful blindness to circumvent the RPI disclosure requirements). Here, Petitioner had full knowledge that it failed to name Techtronic and Homelite as RPIs

when it made the ultimate decision to file its Petition, and the only inference to draw from Petitioner's actions is that Petitioner has engaged in gamesmanship and acted in bad faith.

1. Petitioner Chose Not To Name Techtronic and Homelite in the Petition Knowing That They Both Had Pre-Existing Relationships With Petitioner And Were Clear Beneficiaries Of This Proceeding.

At the time it filed the Petition, Petitioner made the conscious decision not to name Techtronic and Homelite. Mr. Sowell, Petitioner's Group President for Outdoor Power Equipment, made the ultimate decision to file the Petition in this proceeding (EX2029, Sowell Transcript, 27:13-16) [6] and therefore had final authority over who to name as the petitioner and who to name as the real parties in interest. And Mr. Sowell chose not name Techtronic or Homelite knowing, as CEO of the Outdoor Power Equipment Group of Petitioner, of the extensive relationships between the entities, and the benefits Techtronic and Homelite stand to gain if the Board issues a ruling of unpatentability detailed in the preceding section. (*See* Sections A. & B., *supra*.) Moreover, Mr. Sowell knew the following facts at the time he authorized the filing of the Petition:

[6] Other than in-house counsel for Petitioner, Mr. Sowell did not consult with anyone else about the Petition before filing. (*Id.* at 27:17-28:1, 35:15-37:18.)

- Homelite was the vendor of record for Home Depot for outdoor power equipment (which includes lawn mowers) for Petitioner. (*Id.*, 39:7-16, 58:18-59:4.)

- Homelite did not have any employees. (*Id.*, 78:21-79:2.)

- Homelite depended entirely on Petitioner to manage its business relating to lawnmowers. (*Id.*, 79:3-13.)

- Techtronic and Homelite were named defendants in the parallel District Court Litigation. (*Id.*, 73:15-75:18.)

- Petitioner, Techtronic, and Homelite's interests were aligned in the District Court Litigation. (*Id.*, 79:22-80:15.)

- Petitioner, Techtronic, and Homelite all stood to benefit from a finding of unpatentability. (*Id.*, 81:18-83:9.)

Under these circumstances, the only conclusion to reach is that Petitioner knew that it failed to name several RPIs when it filed its Petition.

2. Petitioner Has Engaged In Gamesmanship And Failed To Identify The Unnamed RPIs In Bad Faith.

Here, Petitioner's failure to name Techtronic and Homelite as RPIs when it filed its Petition was in bad faith given the circumstances of Petitioner's omission, or, at the very least, constitutes gamesmanship. As demonstrated in Sections A.-C.a., *supra*, Petitioner knew of the close relationship between itself and the unnamed RPIs when it filed the Petition. Petitioner also knew when it filed the Petition that the unnamed RPIs are clear beneficiaries if the Board concludes that the challenged claims are unpatentable. Ultimately, Petitioner knew when it filed its Petition that all of the unnamed RPIs stood to directly benefit if the Board invalidates the claims

of the challenged patents in this proceeding. And the Board need look no further for evidence of bad faith and gamesmanship than Petitioner's attempt to deprive the Board of the opportunity to evaluate Petitioner's earlier Motion to Amend its Mandatory Notices on a complete record (*see* EX2019, ¶¶ 5-12) and Petitioner's counsel's "improper" and "inappropriate" instructions that Mr. Sowell not answer questions during his deposition on the basis of relevance and scope.

As explained in Patent Owner's Opposition to Petitioner's Motion to Amend its Mandatory Notices, Petitioner has not offered a *mea culpa* to the Board and claim that its failure to include the unnamed RPIs was mere inadvertence or mistake. Rather, Petitioner sticks to its guns that the unnamed RPIs are not RPIs at all as a basis for its good faith. (Paper 13 at 3-6.) At best, Petitioner is continuing to be willfully blind to the well-established relationships between it and the unnamed RPIs as they relate to this proceeding and the Litigation, knowing full well that if it were caught, it could simply move to amend its mandatory notices while retaining its original filing date, as it has now done. At worst, Petitioner intentionally concealed the unnamed RPIs in bad faith. Regardless, there is no basis for the Board to conclude under these circumstances that Petitioner reasonably believed that the unnamed RPIs were not actually RPIs. The Board should not permit Petitioner to update its mandatory notices and retain its filing date.

3. The Board Should Not Allow Petitioner To Circumvent § 312 Without Consequence.

When a petitioner fails to identify all RPIs at the time of filing, ***the Board may not consider an IPR petition***. *Id.* at § 312(a)(1)-(2). Permitting amendments to mandatory disclosures, upon cursory proclamations of good faith "effectively nullifies the requirement set forth in 312 that all real parties in interest must be identified for a petition to be considered." *See Toshiba Memory Corp. v. Anza Tech. Inc.*, IPR 2018-01597, Paper 35 at 2-3 (PTAB June 6, 2019) (BEST, A.P.J., concurring). Here, there is no dispute that Petitioner failed to meet its burden to name three RPIs. (*See* Sections A.-C.b., *supra*.) Petitioner must bear the consequence of its omission, and the Board should not permit Petitioner to retain its filing date.

VII. 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.

VIII. CONCLUSION

Accordingly, for at least the foregoing reasons, Patent Owner respectfully requests that the Board confirm the patentability of the Challenged Claims.

Respectfully submitted,

Dated: January 29, 2021

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CERTIFICATE OF COMPLIANCE

This paper complies with the requirements of 37 C.F.R. § 42.24 and contains 13,201 words (exclusive of the table of contents, 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,

Dated: January 29, 2021

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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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