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

U.S. Patent No. 9,826,686
Issue Date: November 28, 2017
Title: Gardening Tool

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO STRIKE

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I. INTRODUCTION

A Reply affords a petitioner the opportunity to "respond to arguments raised in the … patent owner response". 37 CFR 42.23(b). In this proceeding, each argument in Petitioner's Reply "only respond[s] to arguments raised" in Patent Owner's ("PO") Response ("POR"). *Id*. PO's Motion to Strike ("Motion") does not contend otherwise. Instead, the Motion takes the flawed position that a Reply may not elaborate on the existing record to address arguments raised for the first time in a POR. A petitioner ***is*** permitted to elaborate on its arguments, and can even submit new evidence if responsive to a POR. *Apple Inc. v. Andrea Elecs. Corp*., 949 F.3d 697, 705-706 (Fed. Cir. 2020) ("determining whether [petitioner's reply] appropriately advanced its arguments … we must consider: whether the petitioner's reply brief is responsive to arguments originally raised in its petition; ***or*** whether the reply arguments are responsive to arguments raised in the patent owner's response brief.") (emphasis added); *id*., 706-707 ("the petitioner in an inter partes review proceeding may introduce new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner.") (internal citation omitted). Here, the arguments in Petitioner's Reply squarely respond to POR to "help crystallize issues for decision". PTAB Consolidated Trial Practice Guide (Nov. 2019) ("TPG"), 80. The "rare" and "exceptional remedy" of striking the entirety or a portion of Petitioner's Reply is not justified. *Id*. Other

tribunals have held the striking of arguments to be an abuse of discretion when they are responsive to POR's arguments. *Apple*, 949 F.3d at 707; *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374, 1381 (Fed. Cir. 2018). The motion should be denied.

II. THE PETITION RELIES ON OUTILS' OPERATION ASSEMBLY (Hold-To-Run 30), FIRST CONTROL DEVICE (Electric Supply Contactor), AND SECOND CONTROL DEVICE (Actuator 23).

PO's Motion (III.B, III.C) mischaracterizes the Petition and Reply, suggesting that the Reply advances new theories because "[t]he Petition and Petitioner's supporting expert declaration relied on only Outils' Figure 1 embodiment … for multiple claim limitations." Motion, 3. Not so. The Petition relies on Outils' handle 1 as the claimed "handle"; handle 1 appears in *every* embodiment. Pet., 30-33; Ex.1014 (Outils), Figures 1-11. Petitioner's expert, Mr. Reed, testified that POSITA would have interpreted Outils' handle 1 to include hold-to-run component 30 without restriction to any particular embodiment or figure. Ex.1003, ¶¶70, 72, 82-83; *see infra*, IV. The Petition relies on Outils' hold-to-run component 30 as the claimed "operation assembly" mounted on handle 1. Pet., 31. Hold-to-run 30 pulls cable 29 to put "electrical supply contactor" into a motor-on position; the Petition relies on this contactor as the claimed "first control device." Pet., 40. What the Petition does ***not*** rely on is cable 29 ***acting as a Bowden cable***; the Petition never mentions the term or relies on cable 29 acting as

such. Importantly, cable 29 has ***two*** roles, and only one is relied upon in the Petition. First, it works in conjunction with hold-to-run 30 to put "electrical supply contactor" into the motor-on position. *See* Pet., 31 (citing Outils' 4:6-7, 4:14-17); Reply, 10 (citing Outils' 2:24 ("…rotation of the cutting blade is subordinated to a hold-to-run safety control…"). Second, it can be designed to act as a Bowden cable which becomes slack when handle 1 is raised, thereby forcing the "electrical supply contactor" into a motor-off position even if hold-to-run 30 is held in its 'on' position. *See* Outils' Figures 2-3. This role is *not* part of the Petition, yet POR suggests it is (for Ground 2). POR, 42. The Reply properly responds to POR, noting that cable 29's role as a Bowden cable (to kill the motor when handle 1 is rotated upward) is ***replaced*** in Figure 10 by actuator 23 and cam 24. Reply, 9. The Petition states "Outils' activation actuator 23 in Figure 10 is the claimed 'second control device.'") Pet., 40-41. The Reply properly responds to POR.

III. THE PETITION ASSERTS THAT POSITA KNEW RELEVANT FEDERAL REGULATIONS SUCH AS 16 CFR 1205.

PO's Motion (III.D) suggests the Reply attempts to add 16 CFR 1205 as an additional piece of prior art. PO is incorrect. The Petition defines persons of ordinary skill ("POSITA") to have, *inter alia*, "at least three years of relevant product design experience." Pet., 12 (citing Ex.1003, ¶44). The Petition and expert declaration also note that, by "2012, POSITA knew … U.S. federal regulations codified at 16 CFR 1205" and "would have been motivated to design lawnmowers

according to those regulations, and to make obvious modifications to turn noncomplying mowers in the prior art into compliant designs." Pet., 26-27; *see* Ex.1003, ¶62-63. Because POR and its expert – who admitted having no exposure to 16 CFR 1205 until his engagement in Spring 2019 (Reply, 3-4) – alleged that Outils merely "could have … a separate start switch" (Ex.2027, ¶156), the Reply repeated the Petition's position that POSITA *knew* regulations required the very design that Outils disclosed, *i.e.*, a hold-to-run component 30 atop handle 1. Reply, 9. Even if the Reply's reiteration of POSITA's knowledge is deemed to constitute new evidence – it is not – it would be permissible. *Anacor Pharm., Inc. v. Iancu*, 889 F.3d 1372, 1380–81 (Fed. Cir. 2018) (IPR petitioner may introduce new evidence after the petition "to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness." (internal citation omitted)). The Reply properly responds to arguments in POR.

IV. THE REPLY REITERATES THE PETITION'S AND PETITIONER'S EXPERT'S INTERPRETATION OF OUTILS.

Petitioner's expert, Mr. Reed, interpreted Outils from the perspective of a POSITA. Ex.1003, ¶17, ¶3 ("[I] have considered the viewpoint of a person having ordinary skill in the relevant art, as of 2012."). Mr. Reed testified that POSITA would have interpreted Outils' handle 1 to include a hold-to-run component 30 without restriction to any particular embodiment or figure. Pet., 30 (citing Ex.1003, ¶70 ("Outils' mower handle 1 is rotatably connected to the main body (casing 6).

Compare Figures 1 and 5; Figures 6 and 7; *see* handle positions in Figures 4, 10, 11.")); Pet., 31, (citing Ex.1003, ¶72 ("Outils' handle 1 has an operation assembly 30 which may be 'a handle, lever a bow or the like, provided on the handlebar 1[.]' TTI1014, 4:8.")); Pet., 38; Ex.1003, ¶¶82-83. POR seemingly interprets Outils differently, so the Reply responds, consistent with the Petition, that Outils' safety devices, including that of Figure 10, exist even though "the rotation of the cutting blade is subordinated to a hold-to-run safety control" because such controls still leave "risk of injury." Reply, 10 (citing Outils, 2:24-27). The Reply is proper.

V. THE REPLY PROPERLY RESPONDS TO POR'S ARGUMENT ON THE INADVERTANT ROTATION OF OUTILS' HANDLE.

The Motion (III.F.) complains that the Reply observed certain details of Outils' disclosure in response to the argument, raised in POR, that it would not be dangerous for Outils' handle to inadvertently rotate from a raised, non-use position to an in-use position. POR, 25; Reply, 11-12. These observations respond squarely "to arguments raised in the … patent owner response". 37 CFR 42.23(b).

VI. THE REPLY'S ANNOTATED FIGURE ILLUSTRATES THE PETITION AND PETITIONER'S EXPERT'S DECLARATION.

To facilitate its response to POR's arguments directed to the combined circuitry of Outils and Matsunaga (POR, 29-33), the Reply illustrates the circuit described by its expert and set forth in the Petition. Reply, 13-14 (citing Ex.1003, ¶90). The illustration is based on the Petition: Outils' actuator 23 "can be an

electrical supply cut-off switch for an electric motor … of the all-or-nothing type." Pet., 38. "POSITA would have understood [that] activation actuator 23 can be a switch connected in the power supply circuit (*e.g.*, in series between the electric power source and the electric motor)." Pet., 41 (citing Ex.1003, ¶88). "[T]he second control device (activation actuator 23) unlocks the first control device (electrical supply contactor controlled by hold-to-run component 30) so that the first control device allows starting of the motor. When, instead, handle 1 and cam 24 rotate to an accommodating (non-use) position relative to the main body (casing 6), the second control device (activation actuator 23) locks the first device (electrical supply contactor controlled by hold-to-run component 30) so that the first control device is not allowed to start the motor." Pet., 40-41 (citing Ex.1003, ¶86). "POSITA would have found it obvious … to implement Outils' actuation activator 23 (a contact switch triggered by cam 24) as Matsunaga's contact switch 11 which meets the claimed 'switch connected to the power supply circuit.' Switch 11 also acts as the claimed signal source for sending a control signal to the power supply circuit, namely to semiconductor switch Q1 in the power supply circuit." Pet., 43 (citing Ex.1003, ¶90). The illustration contains no new theory of unpatentability. Notably, the Motion does not contend it is inconsistent with the Petition or Mr. Reed's declaration.

VII. THE REPLY'S FN.7 IS PETITIONER'S EXPERT'S OPINION.

PO's Motion (III.H) complains of the Reply's footnote 7, which identifies another obvious result of combining Outils and Matsunaga. The substance of n.7 is asserted in the Petition and Petitioner's expert's declaration. Pet., 45-46 (citing Mr. Reed's decl., ¶¶95-97) (¶95: "POSITA would have found it obvious to include both [of Matsunaga's] switches 11 and 12, using one in Outils' operation assembly 30 to control the 'electrical supply contactor' in the 'first control device.'"; ¶97: "POSITA would have found it obvious to include both [of Matsunaga's] switches Q1 and Q2, using one as Outils' 'electrical supply contactor' in the 'first control device.'"). The footnote asserts no new theory of unpatentability.

VIII. THE PETITION EXPLAINS THE DANGER OF HIGH CURRENTS.

PO's Motion (III.I.) alleges the Petition fails to mention "danger" associated with high current passing through contacts switches. But the Petition and expert say exactly that: "it is preferable to use smaller capacity contact switches (*id*.[Matsunaga], 1:15-16) and to avoid the thick wiring (*id*., 7:23-30) and associated danger of high current flowing through contact switches." Pet., 42 (citing Ex.1003, ¶88). The danger is generally known to be shock or fire due to an electric arc. The Motion also complains that the Reply responds to POR by observing details in Outils' drawings. It is Outils' Fig. 10, and not opinion or attorney argument, that shows "actuator 23 immediately adjacent the cut-grass chute." Reply, 15 (citing Ex.1014, Fig. 10). And it is generally known that a

user's hands will reach toward the grass-chute to clear cut grass. Reply, 15; *see* Ex.1014, 2:25 ("injury due to … accidental entry of a digit into the cutting zone"). The Reply responds to POR's refuting any need to minimize danger. POR, 31.

IX. THE REPLY PROPERLY RESPONDS TO POR'S INCORRECT ARGUMENT THAT MATSUNAGA IS NOT ANALOGOUS ART.

Despite the Board's initial determination that Matsunaga is analogous art (Inst. Dec., 51), POR repeated the allegation that Matsunaga is not analogous art, and the Motion (III.J) now criticizes the Reply's responsive observations of what Matsunaga discloses. Reply, 7 (citing Matsunaga). These observations respond directly to POR and cite facts germane to the analogous art issue. *See KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 420 (2007) ("any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed."); *Medtronic, Inc. v. Cardiac Pacemakers*, 721 F.2d 1563 (Fed. Cir. 1983) (reference was analogous art because POSITA would look to circuit solutions used by others facing similar problems); *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). The Reply properly responds to the arguments raised in POR.

X. THE REPLY PROPERLY RESPONDS TO POR'S INCORRECT ARGUMENT THAT NAKANO IS NOT ANALOGOUS ART.

As it does for Matsunaga, PO's Motion (III.K.) criticizes the Reply's observations of what Nakano discloses. Reply, 17 (citing Nakano's disclosure). As

with Matsunaga, these observations respond directly to POR's arguments and cite facts germane to the analogous art issue. Moreover, the Petition was filed before PO's expert's deposition testimony, cited in the Reply, on the topic of Nakano being analogous art. Reply, 17-18 (citing Ex.1040 (Smith Tr.), 49:13-50:1).

XI. THE REPLY'S ANNOTATED FIGURES ILLUSTRATE THE PETITION AND PETITIONER'S EXPERT'S DECLARATION.

To facilitate its response to POR's arguments on Nakano's control devices used with other prior art (POR, 39-40), the Reply annotates Nakano's circuit to reflect the Petition's arguments, consistent with Mr. Reed's opinions. Reply, 21-22 (citing Pet., 51-67). "The claimed 'switch' is met by Outils' 'electrical supply contactor' triggered by [the] operation assembly". Pet., 65. "When [Nakano's] pipes 40, 80 are extended to their operational state … power [is allowed] to pass through switch 245 (Fig. 7)". Pet. 59. Outils' "actuator 23 can be a switch connected in the power supply circuit (e.g., in series between the electric power source and the electric motor)." Pet., 41. "POSITA would have found it obvious … to implement Outils' actuation activator 23 … as Matsunaga's contact switch 11 … sending a control signal to the power supply circuit, namely to semiconductor switch Q1 in the power supply circuit." Pet., 43. "POSITA would have found it obvious to include *both* switches Q1 and Q2, using one as Outils' 'electrical supply contactor' in the 'first control device.'" Pet., 46. *See also* VI., *supra*. The annotations contain no new theory. Notably, PO's Motion does not

contend they are inconsistent with the Petition or Mr. Reed's declaration.

XII. THE REPLY REITERATES THE MOTIVATIONS TO COMBINE OUTILS, ROELLE, MATSUNAGA, LANGDON, AND NAKANO.

PO's Motion (III.M) incorrectly contends the Petition "said nothing" about Nakano's "convenient storage" or "added safety," or about the obviousness of adding Nakano's advantages into Outils modified device. The Petition (Ground 2) says precisely that: "POSITA would have been motivated by the collapsibility of Langdon's telescopic handle … to use that feature in Outils' lawnmower." Pet., 53. "Like Outils and Langdon, Nakano teaches a telescoping handle on a grass cutting tool. Nakano shares Langdon's goal of collapsing the handle 'to realize a compact electric bush cutter capable of reducing a **storage** space thereof' (TTI1015, 3:3-4), but provides **added safety** where, 'if retraction of a rod [*i.e.*, collapse of the telescoping handle] by a certain cause is detected while a work is performed in an extended state of the rod, a motor is immediately braked, thereby **improving** a **safety** thereof.' *Id*., 4:2-4." Pet., 54-55 (bold added). "Each of these components [Nakano's safety devices 55, 56, 211], when incorporated into Outils' modified system, sends a signal to the power supply circuit to disable activation of the motor when one of the telescopic members 40, 80 moves away from the predetermined in-use position relative to the other telescopic member." Pet., 65. The Reply reiterates these facts and cites the supporting deposition testimony from PO's own expert. Reply, 24-25. The Reply adds no new theories of unpatentability.

Respectfully submitted,

Dated: June 30, 2021

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CERTIFICATE OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b) on the Patent Owner by electronic copy of this **PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO STRIKE** and supporting materials (if any).

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