

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APEX TOOL GROUP, LLC,  
Petitioner,

v.

MILWAIKEE ELECTRIC TOOL CORPORATION,  
Patent Owner.

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PGR2020-00056  
Patent 10,422,617 B1

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Before GRACE KARAFFA OBERMANN, JOHN A. HUDALLA, and  
AARON W. MOORE, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER

Authorizing Petitioner to File a Reply and  
Authorizing Patent Owner to File a Sur-Reply  
*37 C.F.R. §§ 42.5; 42.108(c)*

Petitioner challenges the patentability of Patent No. 10,422,617 B1 (“the ’617 patent”). *See generally* Paper 1 (“Petition”). On July 30, 2020, Petitioner submitted an email to the Board requesting authorization to file a five-page Reply to Patent Owner’s Preliminary Response (Paper 9) to the Petition. Ex. 3001, 2 (copy of email correspondence). On July 31, 2020, Patent Owner submitted an email opposing Petitioner’s request. *Id.* at 1–2. That same day, the Board granted Petitioner’s request via email. *Id.* at 1. This Order memorializes the terms and conditions of that grant. *See id.* (Board’s responsive email of July 31, 2020).

The stated purpose of the requested Reply is to respond to a solitary argument raised in Patent Owner’s Preliminary Response, namely, “that the ‘conventional tape measure blade design’ identified as ‘Prior Art 2’ in the [’617] patent’s specification is not prior art.” *Id.* at 2. The Board did not hold a telephonic conference call, but instead advised the parties that the panel, having considered Petitioner’s opposed request, determined that additional briefing “may be helpful to the Board.” *Id.* at 1. On that basis, we authorized Petitioner’s request. *Id.* We mitigated any concerns of fairness or prejudice by providing Patent Owner an opportunity to file a Sur-Reply commensurate in scope and length with the Reply. *Id.*

The Reply shall be strictly limited to responding to the solitary issue identified above. The Sur-Reply shall be limited to responding to issues raised in the Reply. No new evidence shall be filed in support of the Reply or Sur-Reply. We previously placed the parties on notice of the timing and length of the additional briefs (*id.*), the details of which we set forth below for the record.

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It is

ORDERED that we *grant* Petitioner's request for authorization to file a Reply to Patent Owner's Preliminary Response to the Petition;

FURTHER ORDERED that any Reply must be filed no later than August 7, 2020, may be up to five pages in length, and shall be strictly limited to responding to the solitary argument identified in Exhibit 3001; namely, that the "conventional tape measure blade design" identified as "Prior Art 2" in the '617 patent's specification is not prior art;

FURTHER ORDERED that Patent Owner is authorized to file a Sur-Reply if Petitioner files a Reply pursuant to the above authorization;

FURTHER ORDERED that, should Patent Owner elect to file a Sur-Reply pursuant to this grant of authorization, the Sur-Reply must be filed no later than August 14, 2020, may be up to five pages in length, and shall be limited to responding to issues raised in the Reply;

FURTHER ORDERED that no new evidence shall accompany the Reply and Sur-Reply; and

FURTHER ORDERED that no other briefing or relief is authorized at this time.

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PETITIONER:

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