

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MILWAUKEE ELECTRIC TOOL CORPORATION,
TECHTRONIC INDUSTRIES CO. LTD., TECHTRONIC INDUSTRIES
NORTH AMERICA, INC., and ONE WORLD TECHNOLOGIES, INC.,
Petitioners,

v.

IRWIN INDUSTRIAL TOOL COMPANY,
Patent Owner.

Case IPR2015-01461
Patent 8,579,554 B2

PETITIONERS' NOTICE OF APPEAL

In accordance with 35 U.S.C. § 142 and 37 C.F.R. § 90.2, Petitioners Milwaukee Electric Tool Corporation, Techtronic Industries Company Limited, Techtronic Industries North America Incorporated, and One World Technologies Incorporated (“Petitioners”) provide notice that they intend to appeal to the United States Court of Appeals for the Federal Circuit from the final written decision of the Patent Trial and Appeal Board (the “Board”) entered on September 29, 2016 (Paper 39), and from all underlying orders, decisions, rulings, and opinions related to the final written decision.

For the limited purpose of providing the Director of the United States Patent and Trademark Office with the information requested under 37 C.F.R. § 90.2(a)(3)(ii), Petitioners anticipate that the issues on appeal may include, but are not limited to:

1. Whether the Board erred by requiring that the prior art must disclose drive structure elements absent from the claims to establish anticipation;
2. Whether the Board erred by requiring that the prior art must disclose, suggest, or provide motivation to add drive structure elements absent from the claims to establish obviousness;
3. Whether the Board erred by failing to identify the applicable level of ordinary skill in the art and by relying on opinion evidence from an expert who

applied an unreasonably low level of ordinary skill in the art in forming those opinions supporting nonobviousness;

4. Whether the Board erred in holding that the pin 54 disclosed in U.S. Patent 7,237,291 (Ex. 1003 or “Redford”) would prevent use of portions of the disclosed S-shaped channel 56 as fulcrums;

5. Whether the Board erred in holding that a person of ordinary skill in the art would not have combined Redford with prior art U.S. Patent 2,473,077 (Ex. 1004 or “Starbuck”); and

6. Whether the Board erred in determining that Petitioners failed to establish by a preponderance of the evidence that claims 1–37 of U.S. Patent 8,579,554 (“the ’554 patent”) are unpatentable.

Petitioners further reserve the right to challenge any finding or determination supporting or relating to issues listed above and to challenge any other issues decided against Petitioners in the final written decision. Copies of this Notice of Appeal are being submitted simultaneously to the Director of the United States Patent and Trademark Office, the Board, and the Clerk of the United States Court of Appeals for the Federal Circuit.

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Patent 8,579,554

Dated: November 14, 2016

Respectfully submitted,

/s/ Kevin P. Moran

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Attorneys for Petitioners

CERTIFICATE OF SERVICE

On behalf of Petitioners, I certify that the original version of the foregoing Notice of Appeal was filed electronically through the Patent Trial and Appeal Board's End to End (PTAB E2E) system under 37 C.F.R. §§ 90.2(a)(1) and 42.6(b), and that the original version of the foregoing Notice of Appeal was filed by hand under 37 C.F.R. §§ 90.2(a)(1) and 104.2(b) with the Director of the United States Patent and Trademark Office on November 14, 2016, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
Madison Building East, 10B20
600 Dulany Street
Alexandria, VA 22314-5793

I further certify that, under 37 C.F.R. § 90.2(a)(2) and Federal Circuit Rule 15(a), a copy of the foregoing Notice of Appeal was filed on November 14, 2016, with the Clerk of the United States Court of Appeals for the Federal Circuit at the following address:

Hon. Peter R. Marksteiner, Circuit Executive and Clerk of Court
United States Court of Appeals for the Federal Circuit
717 Madison Place NW, Suite 401
Washington, D.C. 20439

IPR2015-01461
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Under 37 C.F.R. § 42.6(e) and by agreement of counsel, I certify that on November 14, 2016, a copy of the foregoing Notice of Appeal was served by e-mail on the counsel of record for Patent Owner listed below:

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Dated: November 14, 2016

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