

2018-2282

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**United States Court of Appeals  
for the Federal Circuit**

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LOGGERHEAD TOOLS, LLC,

*Plaintiff – Appellant,*

v.

SEARS HOLDINGS CORPORATION, APEX TOOL GROUP, LLC,

*Defendants – Appellees.*

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*On Appeal from the United States District Court for the  
Northern District of Illinois, No. 1:12-cv-9033  
The Honorable Rebecca R. Pallmeyer*

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**APPELLANT LOGGERHEAD TOOLS, LLC'S PETITION FOR  
REHEARING *EN BANC***

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December 27, 2019

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**CERTIFICATE OF INTEREST**

Pursuant to Fed. Cir. R. 47.4, counsel for Appellant, LoggerHead Tools, LLC, certifies the following:

<b>1. Full Name of Party Represented by me</b>	<b>2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:</b>	<b>3. Parent corporations and publicly held companies that own 10% or more of stock in that party</b>
LoggerHead Tools, LLC	LoggerHead Tools, LLC	None.

4. The name of all law firms and the partners and associates that appeared for the party or amicus now represented by us in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

<b>Law Firm</b>	<b>Counsel</b>
Skiermont Derby LLP	Steven W. Hartsell, Steven J. Udick
Skiermont Puckett LLP (firm changed names)	Gordie Donald Puckett (no longer affiliated with Skiermont Derby LLP), Lenny Huang (no longer affiliated with Skiermont Derby LLP), Shellie Stephens (no longer affiliated with Skiermont Derby LLP), Wilhemina J. Tyler (no longer affiliated with Skiermont Derby LLP)
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5. The title and number of any case known to me to be pending in this or any other court or agency that will directly affect or be affected by this court's decision in the pending appeal are:

*LoggerHead Tools, LLC v. Sears Holdings Corporation, et al.*, C. A. No. 1:12-cv-09033.

Dated: December 27, 2019

Respectfully submitted,

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**TABLE OF ABBREVIATIONS**

Abbreviation	Full Term
'470 Patent	LoggerHead's U.S. Patent No. 7,992,470
'579 Patent	LoggerHead's U.S. Patent No. 6,889,579
Apex	Apex Tool Group, LLC
LoggerHead	LoggerHead Tools, LLC
LoggerHead's Patents	LoggerHead's U.S. Patent No. 7,992,470 and LoggerHead's U.S. Patent No. 6,889,579, collectively
MALW	"Max Axxess Locking Wrench" (the infringing device)
MSJ	"motion for summary judgment"
Sears	Sears Holdings Corporation
Blue Br.	Opening Brief for Appellant, filed February 22, 2019
Gray Br.	Reply Brief for Appellant, filed May 24, 2019

## I. STATEMENT OF COUNSEL

Based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting question of exceptional importance:

Does a patentee clearly and unmistakably surrender claim scope by argument-based prosecution history disclaimer under longstanding precedent of this Court where:

(a) the purportedly disclaiming statement responded to, but did not adopt, the Examiner's mapping of claims to a prior art patent, but instead distinguished that reference, without characterizing the scope or meaning of that claim element, by logical inference based on how the Examiner mapped the reference to the claim elements,

(b) during prosecution the patentee separately and successfully distinguished the same reference based on a different claim element than the one purportedly narrowed by argument,

(c) a district judge in the same case had considered and rejected the same alleged disclaimer argument and found, citing this Court's precedent, that patentee's arguments were not a clear and unmistakable disclaimer because they were amenable to multiple reasonable interpretations, one of which is consistent with the full scope of patentee's express definition of the claim element, and

(d) the disclaimer-based claim construction (i) excludes a preferred



embodiment, (ii) ignores claim differentiation, and (iii) the construction was based on and motivated by the accused device.

Based on my professional judgment, I also believe the Panel decision is contrary to the following precedent of this Court: *EPOS Techs. Ltd. v. Pegasus Techs. Ltd.*, 766 F.3d 1338, 1343 (Fed. Cir. 2014); *Grober v. Mako Prod., Inc.*, 686 F.3d 1335, 1341–43 (Fed. Cir. 2012); *Elbex Video Ltd. v. Sensormatic Elecs. Corp.*, 508 F.3d 1366, 1372-73 (Fed. Cir. 2007); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005); *SanDisk Corp. v. Memorex Prod., Inc.*, 415 F.3d 1278, 1287 (Fed. Cir. 2005); *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1332-33 (Fed. Cir. 2004); *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 833 (Fed. Cir. 2003); *3M Innovative Properties Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1373-74 (Fed. Cir. 2003); *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368-70 (Fed. Cir. 2003); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1347 (Fed. Cir. 2001); *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1439 (Fed. Cir. 2000).

/s/ Paul J. Skiermont  
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## II. BACKGROUND

After more than a decade of development, Daniel Brown, Sr., President and founder of Appellant LoggerHead, invented a new hand tool. The commercial embodiment of Mr. Brown's invention, the Bionic Wrench®, is pictured below. It is a hybrid between an adjustable wrench and pliers, and has two handles that,



when squeezed together, cause six jaws to converge on all six flat sides of a nut or bolt. (Appx25529-25536.) The novel design garnered the two U.S. Patents at issue here (Nos. 6,889,579 and 7,992,470), industry recognition, awards, and accolades. (Appx25522-25538, Appx25562-25572, Appx30418, Appx30421-30425, Appx30427-30441.)

Claim 1 of the '579 patent claims:<sup>1</sup>

1. An adjustable gripping tool for engaging a workpiece to impart work thereto, the tool comprising:

a first element and a second element connected for relative angular movement which generates movement of at least one gripping element;

the first element including a gripping portion configured to engage the workpiece including a first opening, at least one guide extending from the first opening and the at least one gripping element;

each at least one gripping element including a body portion adapted for engaging the workpiece, an arm portion configured to engage one of said at least one guide and a force transfer element contiguous with the arm portion;

the second element including an actuation portion having a second opening concentric with the first opening and at least one slot disposed adjacent the second opening external thereto, each said at least one slot having a first section configured to engage the force transfer element of one said at least one gripping element, such that movement of the second element with respect to the first element actuates each at least one first section to contact and move each respective force transfer element thereby actuating each said at least one gripping element along respective said at least one guide.

(Appx00217-00218.)

LoggerHead began selling its Bionic Wrench® at Sears in 2009, and by 2011, it was Sears' best-selling hand-tool. (Appx25574-25577.) The next year, Sears partnered with its supplier Apex to create a copy of the Bionic Wrench®

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<sup>1</sup> The highlighted portion of claim 1 here is identical in all relevant claims.

called the MALW. (Appx25595-25598, Appx30636-30638, Appx00435 ¶54.).

LoggerHead sued for willful patent infringement. (Appx00258-00312.)

In 2014, the parties completed *Markman* briefing with respect to the term “arm portion”—the term relevant to this appeal—and Judge Darrah held a *Markman* hearing. (Appx01664-01839, Appx01945-01977, Appx02029-02054, Appx02152-02208.) On Judge Darrah’s order, the parties submitted additional briefing further addressing “arm portion.” (Appx02218-02225, Appx02231-02240.) Judge Darrah issued a thoroughly-reasoned *Markman* Order construing the term “arm portion” to mean the “portion of a gripping element(s) configured to engage one of the guides and contiguous with a force transfer element.” (Appx02418-02423.) Judge Darrah presided until he passed in February 2017, and the case proceeded to trial before Judge Pallmeyer in May 2017, where a jury unanimously found that Sears and Apex had willfully infringed LoggerHead’s patents. (Appx00081, Appx00126, Appx14325-14331.)

Following post-trial briefing, Judge Pallmeyer, *on her own motion*, issued an order changing Judge Darrah’s claim construction—upon which the case had been tried to verdict and ordered a new trial. (Appx00081-00116 (“NTO”).) This post-verdict construction held “that the term ‘arm portion,’ as used in [LoggerHead’s] Patents, must also be an identifiable structure that projects from the body portion of the gripping element.” (Appx00114.) Because this construction “adds at least

one independent requirement that is not inherent in the existing [trial] construction,” the Court *sua sponte* ordered a new trial. (Appx00097-00099, Appx00114-00115.) The parties filed cross-summary judgment motions on the issue of infringement based on the post-verdict construction (Appx23445-25109), and the court granted summary judgment of non-infringement. (Appx00110, Appx00117-00143 (“SJO”).) The Panel affirmed under Rule 36.

### **III. ARGUMENT FOR REHEARING EN BANC**

This Petition raises critically important issues to small companies that rely on the U.S. patent laws to compete against much larger competitors, and more specifically, this Petition raises important issues that arise in competitor patent infringement cases—including application of this Court’s legal standards that govern whether and how certain prosecution *arguments* do or do not result in unambiguous disavowal. The stakes could not be higher for a company like LoggerHead, who secured verdicts of willful patent infringement after nearly 5 years of hard-fought litigation—only to have the claim construction the parties had relied on for years get changed post-verdict—and without the benefit of any explanation from this Court as to why it affirmed decisions below containing numerous errors of law and fact.

The judgment below, affirmed under Rule 36, let stand a post-verdict change to the construction of “arm portion” that vacated a jury’s verdict of willful

infringement and resulted in summary judgment of non-infringement based on the post-verdict claim construction. The post-verdict construction is based on a purported finding of clear and unambiguous argument-based prosecution disclaimer, which is riddled with factual and legal errors, and is contrary to long-standing precedent of this Court that forecloses finding such a disclaimer where the context of the prosecution history as a whole is amenable to more than one reasonable interpretation, one of which is consistent with the full scope of the patentee's express definition of that term. That is precisely what Judge Darrah's *Markman* Order held in construing "arm portion" based on the specification, claims, and context of the prosecution history as a whole (Appx02418-23), in fealty to this Court's precedent, including *Phillips*, 415 F.3d at 1315; *Rexnord*, 274 F.3d at 1347; *3M Innovative*, 350 F.3d at 1373-74; and *Grober*, 686 F.3d at 1342. For this reason alone, this Court should grant rehearing *en banc*.

In addition, Judge Pallmeyer's post-verdict finding of unambiguous disclaimer was based on a misreading of an isolated exchange between LoggerHead and the Examiner in the child patent's prosecution history (BlueBr.25-31), even though Judge Darrah found the exact same prosecution exchanges did not disclaim the patentee's defined meaning of "arm portion" (BlueBr.21-22), and even though Judge Pallmeyer permitted Apex to show the prosecution history to the jury and argue non-infringement based on an isolated

and out of context statement that Buchanan does not disclose an arm portion, which the jury rejected when it found Apex willfully infringed every trial claim (GrayBr.19-23). All of this is dispositive evidence that—at a minimum—the prosecution history as a whole is amenable to more than one reasonable interpretation, including one consistent with the patent’s definition of the term.

The post-verdict construction of “arm portion” is based on additional clearly erroneous findings of fact and numerous legal errors, including the following (none of which apply to Judge Darrah’s vacated construction):

- It was specifically crafted to overcome the jury’s finding of MALW infringement, contrary to *Wilson Sporting Goods Company v. Hillerich & Bradsby Co.*, 442 F.3d 1322, 1330-31 (Fed. Cir. 2006), and *Neomagic Corporation v. Trident Microsystems, Inc.*, 287 F.3d 1062, 1074 (Fed. Cir. 2002), which hold it is reversible legal error to construe claims based on the accused device and to exclude or include it from the claim’s scope through claim construction (BlueBr.23-25);
- It was based on an assertion, without record citation, that the “arm and body portion...are at the heart of what differentiates [LoggerHead’s] Patents from the prior art.” (Appx00114.) **That finding is clearly wrong.** (GrayBr.2-3.) At trial, Apex’s expert (unlike the Examiner) correctly mapped Buchanan to the claim elements (identifying

Buchanan’s plunger 24 as the “gripping element” rather than as the “body portion” per the Examiner), and thus LoggerHead did not argue at trial that Buchanan lacked an arm portion—it presented evidence and argument (as it also did during prosecution) that Buchanan lacks the claimed second element containing an actuation portion and at least one slot, and *that* claim element, together with the remaining elements, was the heart of the invention over the prior art, and the jury agreed when it found the patent not invalid and that Apex willfully infringed. (*Id.*) The post-verdict construction also ignores that the specification discloses the gripping elements may be varied in size or shape (Appx00256(18:14-15), contrary to *EPOS*, 766 F.3d at 1343.

- It excludes a preferred embodiment, Figures 18-19 (Appx00234), which contain gripping elements in a planar configuration (Appx00253(11:39-67), and thus has an arm portion as claimed (and without further including arms that project from body portion), which is excluded from the post-verdict construction, contrary to *Invitrogen*, 327 F.3d at 1368-1370.
- It violates claim differentiation—as Judge Darrah found (Appx02420-02421)—because unasserted claims differentiate both between an “arm” and “arm portion,” and between a structure “that projects from”



the “body portion” and one “that projects from” the “arm portion” (BlueBr.33-35)—and the post-verdict construction merges and conflates these distinctions contrary to *D.M.I., Inc. v. Deere Co.*, 755 F.2d 1570, 1574 (Fed. Cir. 1985).

These errors present a compelling case for rehearing *en banc*.

**A. LoggerHead’s Response to the Examiner’s Mapping of Claims to Buchanan Was Not a Disclaimer of Claim Scope.**

Two district court judges issued two different opinions construing the term “arm portion” in LoggerHead’s patents. Judge Darrah specifically considered and rejected Apex’s argument that, during prosecution, LoggerHead disavowed “arm portions” that were not an identifiable structure that projects from the body portion of the gripping element. (Appx02420-02422.) He held “it would be improper to read separate structure and projection limitations into the claim,” because, “applicant posited that the examiner’s characterization was incorrect as Buchanan identifies 24 as the entire plunger, while the examiner characterized it as the ‘body portion.’ Under the examiner’s logic, there could be no structure to identify as an ‘arm portion.’ Therefore, Plaintiff’s differentiation of the ’470 Patent from the Buchanan patent was not a clear and unmistakable prosecution disclaimer.” (Appx02422.)

Years later, after jury verdicts of willful infringement, Judge Pallmeyer reversed Judge Darrah’s construction (Appx00081-000116) and adopted the

argument Judge Darrah rejected—that LoggerHead disclaimed ‘arm portion[s]’ that were not “an identifiable structure that projects from the body portion of the gripping element.” (Appx00110-00114, Appx00139-00142.)

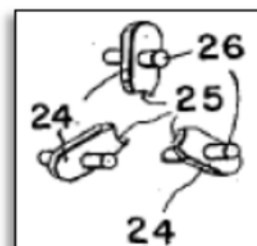
This Court has held that where a statement in a patent’s prosecution history “is amenable to multiple reasonable interpretations [] it therefore does not constitute a clear and unmistakable surrender[.]” *Cordis Corp. v. Medtronic Ave, Inc.*, 339 F.3d 1352, 1359 (Fed. Cir. 2003). Thus, this Court need only find that Judge Darrah’s interpretation of the prosecution history may be reasonable in order to grant rehearing *en banc*.

This Court should also grant rehearing because the facts here utterly fail to support clear and unambiguous disavowal under this Court’s precedent. Specifically, the outcome here is largely controlled by this Court’s precedential decision in *Grober*, 686 F.3d at 1341–43; *see also* Judge Darrah *Markman* Order at Appx02422 (applying *Grober* at 1342). The standard for argument-based disavowal of claim scope is exacting, because although “the prosecution history can inform whether the inventor limited the claim scope in the course of prosecution, it often produces ambiguities created by ongoing negotiations between the inventor and the PTO.” *Grober*, 686 F.3d at 1341–43. *Grober* reversed a finding of prosecution disclaimer because “the trial court erroneously inferred that [patentee’s] reference to the reexamination requestors’ arguments

(equating the prior art structures with the claim elements) in effect adopted those arguments as his definition of his invention. At no point, however, does [patentee] adopt those arguments as an accurate description of his invention. [Patentee] distinguished the arguments but did not admit that they properly characterized the invention.” *Id.*

Judge Darrah’s citation to *Grober* to find no deliberate and unmistakable evidence of disclaimer was correct. Like *Grober*, LoggerHead responded to the Examiner’s characterization of Buchanan’s entire plunger 24 as the body portion—but did not adopt that characterization as an accurate mapping of Buchanan to the claim elements—and instead simply argued that the Examiner did not identify Buchanan’s arm portion, and further argued that Buchanan does not have an arm portion as claimed *based on the Examiner’s identification of plunger 24 as the body portion*—because if plunger 24 is the body portion, that means Buchanan’s pin 26 (the force transfer element) is contiguous with that body portion, whereas the claim requires the force transfer element to be contiguous with the arm portion rather than the body portion. (Appx24654; Appx24755.) Below are relevant portions of Buchanan, identifying the entire plunger as “24”:

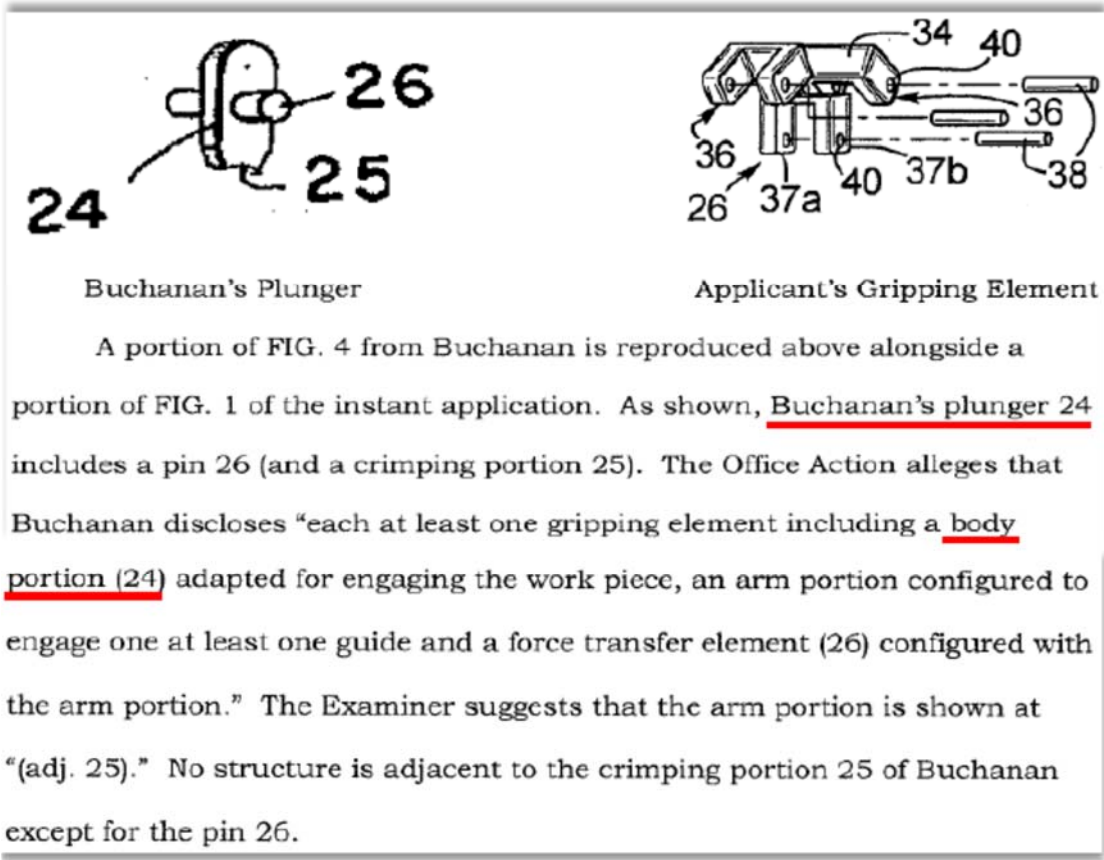
Three plungers 24 are provided, each of them having a crimping portion 25 which is a concave depression at one end of the plunger and a cam engaging pin 26 extending on either side of the faces of the plungers. These plungers 24 are of a size to slidably engage with the slots 19 of the central cam plate.



(Appx41054-41055.)

Specifically, the Examiner twice issued rejections that purported to map Buchanan's device to elements of LoggerHead's pending claims—but in both rejections failed to specifically identify where Buchanan teaches the claimed arm portion. In response to the first Buchanan rejection (Appx24640), LoggerHead argued that based on the Examiner's mapping, Buchanan does not contain an arm portion (Appx24654), and further argued that Buchanan also does not contain a second element with an actuation portion and at least one slot as claimed in limitation "(d)" (Appx24655). The examiner withdrew the rejection.

In response to the second Buchanan rejection (Appx24740), that also identified the entire Buchanan plunger as the "body portion," leaving no remaining structure left to be the "arm portion," one of several reasons LoggerHead raised for claim allowance is shown below:



(Appx24754-24755.)

LoggerHead's argument was based on the Examiner's identification of 24 as the body portion, when Buchanan itself defines 24 as *the entirety of plunger*. And if the entire plunger 24 is the body portion per the Examiner, that necessarily means there is no other remaining structure adjacent to the crimping portion 25 to serve as the arm portion, except for the pin 26, which is the force transfer element. Judge Darrah's reasoned *Markman* decision held this fact in high regard, stating:

Further, "given the examiner's obligation to confer the broadest reasonable interpretation on 'portion,' if the examiner wanted to hinge patentability upon one portion being structurally separate from another portion, he would have said so, and required a specific amendment to reflect separate structures." However, the examiner did

not require a specific amendment to reflect separate arm and body structures.

(Appx02419-02420.) (quoting *Rexnord*, 274 F.3d at 1347) (holding that the examiner’s rejection that “as a technical matter, if the ‘cantilevered portion’ was ‘extending laterally from’ the ‘link module portion,’ it could not be simultaneously *a part of* the ‘link module portion’” did not “compel the conclusion that the examiner must have viewed ‘the cantilevered portion as *a separate part* of the chain link”).

Faced with similar facts in *Grober*, this Court held that the patentee’s “statements during reexamination do not unambiguously focus on the characteristics of the ‘payload platform’” but instead “refer to the placement of the prior art sensors *in relation to the element identified by the examiner as the ‘payload platform’*” without “address[ing] the characteristics of the claimed ‘payload platform’ limitation. Thus, these ambiguous statements do not disavow or even clearly describe the structure of the claimed ‘payload platform.’” *Grober*, 686 F.3d at 1342. Similarly, here, LoggerHead’s statements during prosecution refer to the arm portion “in relation to the element identified by the examiner” in the prior art as the “body portion.” *See id.* Importantly, *Grober* noted the trial court erred when it “inferred that [patentee’s] reference to the reexamination requestors’ arguments (equating the prior art structures with the claim elements) in effect adopted those arguments as his definition of his invention” when in fact

“[patentee] distinguished the arguments but did not admit that they properly characterized the invention.” *Id.* As in *Grober*, LoggerHead also referred to the examiner’s “arguments (equating the prior art structures with the claim elements)” but never “admit[ted] that they properly characterized the invention.” *See id.* For these reasons, this Court’s conclusion in *Grober* that “the district court’s claim construction misread the context of the [ ]examination process and improperly emphasized a general statement out of context to limit the disputed claim term” applies equally to the Panel’s affirmance of the district court’s erroneous limitation of “arm portion” here. *See id.* at 1343.

Indeed, prior to this case, this Court has consistently held that an applicant’s statement “distinguishing their invention from [the] prior art” is not “a clear and unambiguous disavowal of claim scope as required to depart from the meaning of the term provided by the written description.” *Storage Tech.*, 329 F.3d at 833; *see also SanDisk*, 415 F.3d at 1287 (finding prosecution history amenable to more than one reasonable interpretation, and finding public reliance function not advanced where an apparent disclaimer is amenable to multiple reasonable interpretations, one of which is consistent with a claim term’s plain meaning in view of the specification, claims, and prosecution history as a whole); *Golight*, 355 F.3d at 1332-33 (same).

There is no way to reconcile the district court’s new limiting construction of

“arm portion” with the precedent of this Court, such that the Panel’s affirmance of the trial court’s departure from the law requires rehearing *en banc*.

**B. LoggerHead Unmistakably Argued During Prosecution that Buchanan Does Not Disclose the Claimed “Second Element.”**

LoggerHead also separately argued during prosecution that Buchanan does not disclose “that the second element includes an actuation portion having at least one slot, as required, for example, in claim 1...[because] the alleged actuation portion (really ‘inner handle 10,’ as per Buchanan) and slot 21 are on the element that the Office Action has defined as the first element 16, not the second element 12. Thus, it is clear that Buchanan does not teach the same structure as claimed[.]” (Appx24655.) The Examiner considered the arguments persuasive and withdrew the rejection. (Appx24661.) When the Examiner issued a second Buchanan rejection (in error) years later, LoggerHead argued it had already overcome a rejection based on Buchanan and also expressly incorporated the above previously successful argument by incorporation into its response (Appx24753) and the Examiner withdrew the rejection again (Appx24761).

LoggerHead’s prosecution argument that Buchanan does not disclose the claimed second element is consistent with the specification and claim language, *see, e.g.*, Appx00249(4:51-59)—whereas its purported disclaimer statement regarding arm portion, on the other hand, is not consistent with the broad and *express definition* of arm portion in the specification and asserted claims (i.e., the



portion of the gripping element configured to engage one said at least one guide and contiguous with the gripping element's force transfer element (Appx00256(18:44-47))—and is not consistent with the specification's definitive statements that *the shape* of the gripping element is not the point of novelty because “[i]t will also be recognized that the gripping elements may be formed *in any other suitable manner as desired to achieve any intended purpose or function*. Examples of such other configurations or formations will be disclosed below, but *shall not be considered limiting in any sense*” (*Id.*(5:31-36), and the “gripping elements themselves *may be varied in size [or] shape*” (Appx00256(18:14-15). This argument successfully establishing during prosecution that Buchanan does not disclose the required second element containing the actuation portion of the novel tool as claimed in claim 1 further establishes that LoggerHead's isolated statement that Buchanan does not contain an “arm portion”—which was in response to the Examiner's misidentification of Buchanan's entire plunger 24 as the “body portion”—does not and cannot establish a clear and unmistakable disclaimer that is only amenable to one reasonable interpretation—as this Court's long-standing precedents require.

Here, there are at least two reasonable interpretations of the prosecution history consistent with Judge Darrah's construction of “arm portion” provided to the jury: (1) Judge Darrah's interpretation of the prosecution history was

reasonable (for all of the reasons recited above); and (2) another reasonable interpretation of the prosecution is LoggerHead raised a second, different distinction over Buchanan, and essentially argued that *even if* Buchanan discloses the claimed arm portion, Buchanan separately does not disclose the claimed “second element including an actuation portion (10) having at least one slot (21) therein.” (Appx24655) LoggerHead specifically argued:

Furthermore, however, Applicant also respectfully notes that ... the alleged actuation portion (really ‘inner handle 10,’ as per Buchanan) and slot 21 are on...[Buchanan’s] first element 16, not the second element 12. Thus, it is clear that Buchanan does not reach the same structure as claimed, and as such, the claims are in condition for allowance.”

(Appx24655.)

Based on this argument (also incorporated by reference at Appx24753 in response to the second Buchanan rejection that was issued in error), the prosecution history as a whole reasonably supports an interpretation that LoggerHead’s claims issued over Buchanan **because Buchanan fails to teach or a disclose the claimed second element with an actuation portion having at least one slot therein**—and this view of the prosecution does not require any departure from the patent’s definition of “arm portion” that was provided to the jury. Thus, this reasonable interpretation of a prosecution history that is, at a minimum, ambiguous and amenable to more than one reasonable interpretation, requires

rehearing *en banc* based on numerous precedents of this Court. *See IMS Tech.*, 206 F.3d at 1439 (“In light of the ambiguity of the patentee’s statements ***and the subject matter actually disclosed in the references***, we cannot say that the patentee clearly disavowed coverage of absolute positioning systems during reexamination.”); *Storage Tech.*, 329 F.3d at 832-834 (holding no disavowal where meaning of a term is defined in the patent and remarks made to distinguish claims from the prior art are broader than necessary); *3M Innovative*, 350 F.3d at 1373-74 (“[w]hen the patentee has expressly defined a term in the specification and remarks made to distinguish claims from the prior art are broader than necessary to distinguish over the prior art, the full breadth of the remark is not a clear and unmistakable disavowal of claim scope”); *Elbex Video*, 508 F.3d at 1372-73 (reversing disclaimer because even where isolated statement appears to disclaim scope, it was not so clear in light of ambiguities from the ongoing negotiation between patentee and examiner).

## CONCLUSION

For the foregoing reasons, LoggerHead requests this Court grant its Petition for Rehearing *En Banc*.

Dated: December 27, 2019

Respectfully submitted,

/s/ Paul J. Skiermont

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# **ADDENDUM**

NOTE: This disposition is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

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**LOGGERHEAD TOOLS, LLC,**  
*Plaintiff-Appellant*

v.

**SEARS HOLDINGS CORPORATION, APEX TOOL  
GROUP, LLC,**  
*Defendants-Appellees*

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2018-2282

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Appeal from the United States District Court for the Northern District of Illinois in No. 1:12-cv-09033, Judge Rebecca R. Pallmeyer.

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**JUDGMENT**

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PAUL SKIERMONT, Skiermont Derby LLP, Dallas, TX, argued for plaintiff-appellant. Also represented by SADAF R. ABDULLAH, SARAH ELIZABETH SPIRES; MIEKE K. MALMBERG, Los Angeles, CA.

MARCUS EDWARD SERNEL, Kirkland & Ellis LLP, Chicago, IL, argued for defendant-appellee Apex Tool Group, LLC. Also represented by ERIC DAVID HAYES, MEREDITH ZINANNI.

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THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (DYK, TARANTO, and CHEN, *Circuit Judges*).

**The judgment with respect to Apex Tool Group  
is AFFIRMED. See Fed. Cir. R. 36.**

ENTERED BY ORDER OF THE COURT

November 13, 2019  
Date

/s/ Peter R. Marksteiner  
Peter R. Marksteiner  
Clerk of Court

## CERTIFICATE OF SERVICE

I, Julian Hadiz, being duly sworn according to law and being over the age of 18, upon my oath deposes and states that:

Counsel Press was retained by Skiermont Derby LLP for Appellant LoggerHead Tools, LLC to print this document. I am an employee of Counsel Press.

On December 27, 2019, Skiermont Derby LLP authorized me to electronically file the foregoing Petition of Appellant LoggerHead Tools, LLC with the Clerk of the Federal Circuit using the CM/ECF System, which will serve e-mail notice of such filing on the following attorneys:

Marcus E. Sernel  
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I will cause eighteen paper copies of the petition to be filed with the Court, via Federal Express, within the time provided in the Court's rules.

/s/ Julian Hadiz  
Counsel Press



## CERTIFICATE OF COMPLIANCE

This Petition complies with the type-volume limitation of Federal Circuit Rule 32(a). It contains 3,794 words, excluding the parts exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b).

This Petition complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). This Brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in 14-point Times New Roman.

Dated: December 27, 2019

Respectfully submitted,

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