

No. 2021-2241, 2021-2242, 2021-2247, 2021-2248

United States Court of Appeals
for the Federal Circuit

NST GLOBAL, LLC, DBA SB TACTICAL,
Plaintiff-Cross Appellant,

v.

SIG SAUER, INC.
Defendant-Appellant

On Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board, *Inter Partes* Review Nos. IPR2020-00423 and
IPR2020-00424

NST GLOBAL, LLC'S PETITION FOR REHEARING EN BANC

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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2021-2241, 2021-2242, 2021-2247, 2021-2248
Short Case Caption Sig Sauer Inc. v. NST Global, LLC, DBA SB Tactical
Filing Party/Entity NST Global, LLC, DBA SB Tactical

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I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 12/08/2022

Signature: /s/Brittany J. Maxey-Fisher

Name: Brittany J. Maxey-Fisher

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>
<p>NST Global, LLC, DBA SB Tactical</p>	<p>None.</p>	<p>None.</p>

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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Maxey-Fisher, PLLC	William R. Brees	Haviland M. M. Kebler
Stacey Lynn Turmel		

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NST Global, LLC v. Sig Sauer Inc.: 1:19-cv-00792-PB (D.N.H)		

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

<input checked="" type="checkbox"/> None/Not Applicable		Additional pages attached
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The '021 Patent	U.S. Patent Number 9,354,021
The '444 Patent	U.S. Patent Number 8,869,444
APA	Administrative Procedure Act, 5 U.S.C. §§ 551–559.
Appeal	Collective reference to Case Nos. 2021-2241, 2021-2242, 2021-2247, 2021-2248
Board	Patent Trial and Appeal Board
CTPG	Consolidated Trial Practice Guide November 2019, available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=
FWDs	Final Written Decisions issued by Board in IPR2020-00423 (Paper 49) and IPR2020-00424 (Paper 50)
IPR	<i>Inter partes</i> review
IPRs	Collective reference to Case Nos. IPR2020-00423 and IPR2020-00424
NST	Cross-Appellant NST Global, LLC dba SB Tactical
Panel	Federal Circuit Three-Member Panel for the Appeal
Parties	Collective reference to Appellant and Cross Appellant
Patent Owner	Cross-Appellant NST Global, LLC dba SB Tactical
Petitioner	Appellant Sig Sauer Inc.
The Patents	The '021 Patent and The '444 Patent

STATEMENT OF COUNSEL

Based on my professional judgment, I believe the panel decision is contrary to the following decision(s) of the Supreme Court of the United States and the precedent(s) of this Court:

- *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018);
- *VLSI Tech. LLC v. Intel Corp.*, Nos. 2021-1826, 2021-1827, 2021-1828, 2022 U.S. App. LEXIS 31482 (November 15, 2022);
- *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364 (Fed. Cir. 2016);
- *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015);
- *Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1301 (Fed. Cir. 2016);
- *EmeraChem Holdings, LLC v. Volkswagen Grp. Of Am., Inc.*, 859 F.3d 1341 (Fed. Cir. 2017);
- *In re NuVasive, Inc.*, 841 F.3d 966 (Fed. Cir. 2016);
- *Qualcomm Inc. v. Intel Corp.*, 6 F.4th 1256 (Fed. Cir. 2021);

Based on my professional judgment, I believe this Appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. Whether, in an *inter partes* review, the Petition controls or can the Board decide a claim construction not placed at issue by the Parties.

2. Whether, in an *inter partes* review, the Board violates the APA when it places at issue a claim construction during Oral Hearing, which it ultimately decides on.
3. Whether the standards provided for determining when a preamble is limiting uniformly align with the established claim construction process.

Dated: December 08, 2022

/s/ Brittany J. Maxey-Fisher
Brittany J. Maxey-Fisher

INTRODUCTION

This Court endorsed the Board's FWDs finding claims 1, 3-6, 8-10, 13, 14 of the '444 Patent and claim 1 of the '021 Patent unpatentable. Appx0067, Appx0134. The Panel's summary affirmance contravenes longstanding law which places the burden of unpatentability on Petitioner and deprives Patent Owner of due process under the APA. If uncorrected, the decision will defy current precedent, prevent uniformity, and enable an unrestrained Board. The decision presents questions of exceptional importance.

The Panel mistakenly summarily affirmed the Board on the basis Patent Owner was on notice a claim construction of the preamble limitation was at issue when neither party briefed the preamble constructions. Appx0021-0023, Appx0089-0091. The Board's zero-hour preamble constructions narrowed the Patents' scope without proper notice and opportunity. En banc consideration is necessary because the affirmance conflicts with established principle, that the Petitioner controls the scope of the IPR, and overlooks precedent under *SAS v. Iancu*, *VLSI*, *Magnum Oil*, and *Dynamic Drinkware*. Further, the Panel fails to analyze the Board's decision and overlooks the requirements for notice and opportunity under the APA and associated case law, including *Dell*, *EmeraChem*, *NuVasive*, and *Qualcomm*.

Summary affirmance leaves uncertainty for litigants. Without clarity from this Court, the Board will continue to overstep and control the IPR's scope, acting as

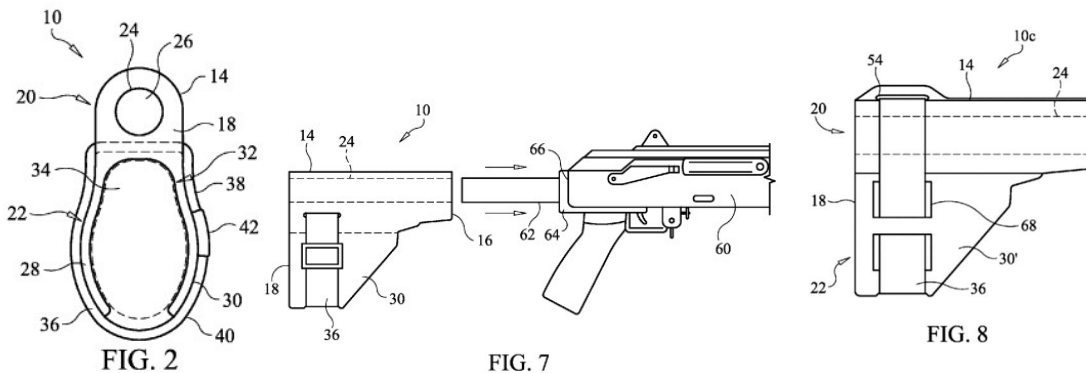
advocate rather than neutral. Patent owners will not receive sufficient notice of the scope of the Patent prior to a Board's finding of invalidity, denying patent owners' rights under the APA. This case is ripe for en banc review because:

- (1) The Panel failed to follow the Precedent set forth in *Dynamic Drinkware* that the Petitioner and the petition governs the scope of an IPR.
- (2) The Panel failed to follow the Precedent set forth in *Dell* that raising an issue at Oral Hearing violates Patent Owner's right to notice and an opportunity to be heard under the APA.
- (3) It presents a question of exceptional importance as to whether the Petition controls and can the Board decide a claim construction not placed at issue by the Parties.
- (4) It presents a question of exceptional importance as to what constitutes Notice under the APA for claim construction.
- (5) It presents a question of exceptional importance as to whether the standards provided for determining when a preamble is limiting uniformly align with the established claim construction process. OR Preamble Limitations

STATEMENT OF RELEVANT FACTS

I. Patents at Issue

The Patents are entitled “Forearm-gripping stabilizing attachment for a handgun.” Appx0142-150, Appx0151-0158. The Patents disclose and claim a stabilizing attachment which permits a user to handle a handgun without straining the arm, hand, or wrist, and contemplates use by individuals with physical limitations. Appx0142, Appx0151, Appx0148, Appx0157. This is particularly useful for handguns with weight located forwardly of the pistol grip causing strain to properly hold the handgun in correct firing position. Appx0148, Appx0157. The ‘444 Patent discloses a bifurcated flap system, whereas the ‘021 Patent discloses a system with at least one flap, both employing a strap for securement to the user’s forearm. Appx0142, Appx0151. Figures 2, 7, and 8, illustrate one embodiment:



II. Procedural History

Patent Owner filed an infringement action against Petitioner, Case No. 1:19-cv-00792-PB (D.N.H.). Petitioner filed Petitions for IPRs challenging all claims of

the Patents. The infringement lawsuit is stayed pending disposition of the IPRs. On June 22, 2021, the Board issued FWDs in both IPRs conducted under 35 U.S.C. § 311 et seq. Patent Owner and Petitioner appealed the FWDs, completed briefing, and presented Oral Argument on November 04, 2022.¹ The Panel issued a summary affirmance on November 08, 2022.

III. The Final Written Decisions

The FWDs present identical rationale and similar unpatentability determinations; finding all preambles limiting, notwithstanding the differences in the language between the preambles² narrowing Patent Owner's rights. Appx0021-0023, Appx0089-0091. Neither party put this construction at issue nor submitted evidence or argument. Appx0021-0023, Appx0089-0091. The Board on its own volition created the construction referencing no evidence from either party. Appx0021-0023, Appx0089-0091.

Relying on its own preamble constructions, the Board held Patent Owner failed to establish nexus for secondary considerations in its obviousness analysis, and faulted Patent Owner for failing to establish evidence commensurate with the claims as newly constructed and criticized Patent Owner for not establishing products sold in light of the not-at-issue preamble limitations. Appx0044-0048,

¹ See Oral Argument Recording, available at https://oralarguments.cafc.uscourts.gov/default.aspx?fl=21-2241_11042022.mp3.

² There are six preambles, four with distinct language. Appx0149-0150, Appx0158.

Appx0113-0118, Appx0045-0047, Appx0114-0117. Had the Board's constructions been at issue, Patent Owner would have supplied evidence commensurate them. The Board's violations render the obviousness determination inaccurate.

IV. Appeal, Oral Argument, and Panel's Summary Affirmance

Patent Owner appealed, arguing *inter alia* the Board violated the APA by construing the preambles as limiting, narrowing Patent Owner's rights without the requisite notice and opportunity under the APA. 5 U.S.C. §§ 551–559. The Panel issued a Rule 36 affirmance without opinion, denying relief on all appealed issues. See Fed. R. App. P. 36(a)(2).

REASONS FOR GRANTING REHEARING EN BANC

This Court may grant rehearing en banc when “the panel decision conflicts with a decision of” this Court or “the proceeding involves one or more questions of exceptional importance.” Fed. R. App. P. 35(b)(1). Here, the summary affirmation conflicts with Supreme Court and this Court's precedent as to requisite notice and opportunity under the APA and precedent that Petitioner controls the IPR's scope. This case also presents questions of exceptional importance regarding burdens in IPRs, the APA, and preamble constructions, requiring resolution by this Court en banc.

ARGUMENT

I. Rehearing is Warranted because the Issues Presented are Ripe for En Banc Review.

The Federal Circuit was designed to maintain a uniform body of Patent Law. *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC*, 967 F.3d 1285, 1319 (Fed. Cir. 2020)(Moore, J., dissenting)(“[O]ur mandate from Congress is to create a clear, uniform body of patent law.”). Rehearing is warranted because the Panel decision does not maintain uniformity, will cause confusion and waste resources, and is inconsistent with precedent.

Here, the Board’s predicate preamble constructions narrowed the Patents’ scope, shifted the burden to control the IPR’s scope from Petitioner to Board, prevented Patent Owner from supplying evidence and argument on a not-at-issue construction blindsiding it in its obviousness analysis. En banc consideration is necessary to resolve jurisprudential confusion, questions of exceptional importance, to protect this Court’s established law from *de facto* abrogation by a panel decision, and ensure the rights afforded under the APA are not denied to patent owners.

II. Rehearing Is Warranted Because This Court Must Address Whether The Burden Is On Petitioner Or The Board To Define The Scope Of The IPR.

The petitioner bears the burden of proving unpatentability of the challenged claims and the burden of persuasion never shifts to patent owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378, 1381 (Fed. Cir. 2015). The FWDs and affirmance represent a sharp departure from established precedent that petitioner controls the IPR’s scope. By affirmance, this Court created a new

standard allowing the Board to put at issue claim construction Petitioner never requested, advanced, or briefed. Accordingly, en banc review is requested to determine whether the Patent Owner is to assume the Board can bring infinite potential constructions, in addition to the grounds asserted by Petitioner on which IPR is instituted.

A. The Burden To Define The Scope Of The IPR Remains On Petitioner And The Board Should Not Be Allowed To Define The Scope Of The IPR.

“[I]t’s the petitioner, not the Director, who gets to define the contours of the proceeding.” *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018). Last month, this Court recognized “the petition defines the scope of the IPR proceeding and that the Board must base its decision on arguments that were advanced by a party and to which the opposing party was given a chance to respond.” *VLSI Tech. LLC v. Intel Corp.*, Nos. 2021-1826, 2021-1827, 2021-1828, 2022 U.S. App. LEXIS 31482, at *18-19 (Fed. Cir. Nov. 15, 2022) (citing *SAS*, 138 S. Ct. at 1356). *VLSI* reaffirmed “it is the petition, not the Board’s discretion, that defines the metes and bounds of an [IPR].” *Id.* at *18 (quoting *Koninklijkeprodu Philips N.V. v. Google LLC*, 948 F.3d 1330, 1336 (Fed. Cir. 2020)). Aligning with *VLSI*, Patent Owner recognizes the Board’s ability to adopt a construction of a *disputed term*, but not to place in dispute and adopt its own construction, absent proffered constructions, arguments advanced by parties, and opportunity to respond.

Here, the Board reached a conclusion on its *own* construction, never placed at issue by the Parties. Appx0021-0023, Appx0089-0091. Petitioner, not patent owner, bears the burden of production and persuasion. *Dynamic Drinkware*, 800 F.3d at 1378, 1381 (Fed. Cir. 2015) (patentee does “not have the burden of producing evidence” on an issue “until after” challenger has placed that issue in dispute). Requiring Patent Owner to establish a not-at-issue preamble is not limiting distorts the burden framework. Summary affirmation leaves the burden question unanswered and creates an unmanageable rule because litigants are compelled to contemplate every conceivable construction and present needless argument and evidence.

B. The Board Must Not Be Allowed To Shift Petitioner’s Burden to Itself.

“Claim construction is the single most important event in the course of a patent litigation. It . . . is often the difference between . . . validity and invalidity.” *Retractable Techs. v. Becton, Dickinson & Co.*, 659 F.3d 1369, 1370 (Fed. Cir. 2011) (Moore, J., dissenting). Determining whether a preamble is limiting is a claim construction matter and is built with safeguards for both Parties. *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 115 F. App’x 84, 87 (Fed. Cir. 2004).

“Generally, the preamble does not limit the claims.” *Allen Eng’g Corp v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002). A preamble is not limiting when the claim body describes a structurally complete invention. *Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358-59 (Fed. Cir. 2010). “Whether a preamble

stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.” *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1572-73 (Fed. Cir. 1996).

The onus is on the Parties to supply argument and evidence, whereas the Board determines the construction based on the “record of the proceeding.” CTPG at 46. “[T]he parties should point out the specific portions of the specification, prosecution history, and relevant extrinsic evidence they want considered, and explain the relevancy of any such evidence to the arguments they advance. Each party bears the burden of providing sufficient support.” *Id.* As evidenced by no references in the FWD, the record is devoid of evidence or argument where the parties point to specific portions as guided by the CTPG. Appx0021-0023, Appx0089-0091.

Instead on appeal Petitioner, *ex post facto* argued it placed the preamble constructions at issue referring to its statement the subject matter of the preamble was met. Appellant’s Reply Br. 23-29. Whether the subject matter is met is not claim construction but is distinct important legal analysis. *Shoes by Firebug LLC v. Stride Rite Children’s Grp., LLC*, 962 F.3d 1362, 1367 (Fed. Cir. 2020)(“Whether a claim

preamble is considered to be a limiting part of the claim matters, *inter alia*, because, if it is not, the scope of the claim is broader...”).

Further, uniformity is lacking in the safeguards for when preambles may or may not be limiting. The case law standards are nebulous, at best. This Court has left claim construction litigants guessing when preambles may be limiting. Since 2010, members of this Court have called for uniformity. *Am. Med.*, 618 F.3d at 1364 (Dyk, T., dissent). Determination is case-by-case; there is no litmus test defining when a preamble limits the scope of a claim, preamble limitations are “resolved only on review of the entire[...]... patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Catalina Mktg. Int’l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002)(quoting *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989)).

Beyond this, the case law is circular, unworkable, and has gleaned numerous subtests. See e.g., *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003)(complete invention); *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951)(self-contained description); *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375 (Fed. Cir. 2001)(non-limiting preamble merely recited the purpose).

It is often quoted that “if the claim preamble is ***‘necessary to give life, meaning, and vitality’*** to the claim, then the claim preamble should be construed as

if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)(emphasis added). This abstruse language invites differing interpretations and an unworkable standard. The Board’s failure to follow established claim construction procedure, together with the impracticable preamble limitation tests requires en banc review.

C. The Board’s Zero-Hour Preamble Constructions Materially Impacted its Obviousness Analysis.

The Board’s preamble constructions materially impacted the obviousness analysis and ultimately the determination of invalidity. Objective evidence of nonobviousness (“secondary considerations”) is an indispensable part of obviousness. See *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966); *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1075-76 (Fed. Cir. 2012). Secondary considerations “constitute[] independent evidence of nonobviousness,” “can be the most probative evidence of nonobviousness in the record,” and guards against hindsight. *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1365 (Fed. Cir. 2008); *Crocs, Inc. v. Int’l Trade Comm’n*, 598 F.3d 1294, 1310 (Fed. Cir. 2010).

Under the secondary consideration framework, presumption of nexus is provided to patent owner when patent owner “shows that the asserted objective evidence is tied to a specific product and that product is the *invention disclosed and*

claimed in the patent.” *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1071 (Fed. Cir. 2018)(internal quotations omitted). Unlike District Courts, claims are construed concurrently with the validity analysis in IPRs.³ The scope of the patent must be *at issue* for patent owner to anticipate what the “invention disclosed and claimed” is. Here, Patent Owner was faulted by the Board for failing to establish numbers of products sold in contemplation of the preamble limitations. The Board’s unpatentability determination was based not on the scope as the Parties defined or put at issue, but, instead, on the Board’s *own* contemplation and ultimate construction.

“Requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence.” *Demaco Corp. v. F. Von Langsdorff Licensing, Ltd.*, 851 F.2d 1387, 1394 (Fed. Cir. 1988). Requiring patent owner to contemplate hypothetical claim limitations and prove up uncontested issues is unfairly burdensome and contrary to settled rules of evidence and claim construction.

Rather than rely on the Board’s zero-hour construction, the Panel should have remanded for further briefing. The Board’s too-late preamble constructions permeated the obviousness analysis and Patent Owner was faulted for its failure to provide evidence aligning with the *Board’s* construed claims. Though appearing

³ District Courts begin with claim construction, resolving patent scope first.

minor, applying the construction was prejudicial to the obviousness findings, completely discarded one *Graham* factor, and narrowed the patent scope for the IPRs and subsequent infringement analyses. See *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1366-67 (Fed. Cir. 2015)(the Court was “not prepared to find that the error we cannot rule out was non-prejudicial,” because “seemingly small differences might be significant.”).

III. The Board’s Preamble Constructions violate the APA and Due Process

The Board “must timely inform the patent owner of ‘the matters of fact and law asserted,’ give all interested parties the opportunity to submit and consider facts and arguments and allow a party ‘to submit rebuttal evidence...’” *EmeraChem Holdings, LLC v. Volkswagen Grp. Of Am., Inc.*, 859 F.3d 1341, 1348 (Fed. Cir. 2017)(quoting 5 U.S.C. § 554(b)–(d)); *Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1301 (Fed. Cir. 2016); accord *Dickinson v. Zurko*, U.S. 150, 162 (1999); *Qualcomm Inc. v. Intel Corp.*, 6 F.4th 1256, 1262 (Fed. Cir. 2021)(citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015)) (“A patent owner in an IPR is undoubtedly entitled to notice of and a fair opportunity”).

The Board must “actually provide[] the opportunities required by the APA and due process” before deprivation of patent rights. *In re NuVasive, Inc.*, 841 F.3d 966, 971 (Fed. Cir. 2016). “The critical question for compliance with the APA and due process is whether [patent owner] received ‘adequate notice of the issues that

would be considered, and ultimately resolved, at that hearing.” *FanDuel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1339-40 (Fed. Cir. 2020)(quoting *Genzyme Therapeutic Prods. Ltd. P’ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1367 (Fed. Cir. 2016)); see also *Nike, Inc. v. Adidas AG*, 955 F.3d 45, 54 (Fed. Cir. 2020).

The Board’s “authority is not so broad that it allows [it] to raise, address, and decide unpatentability theories never presented by the petitioner and not supported by record evidence.” *Magnum Oil*, 829 F.3d at 1381. The Board may not “adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner.” *Id.* “Instead, the [Board] must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.” *Id.*

The Board raised preamble constructions too late in the proceeding for notice and an opportunity to respond. “If the Board raises a claim construction issue on its own, both parties **will be afforded** an opportunity to respond before a final written decision is issued.” CTPG at 45 (emphasis added); see also *Hamilton Beach Brands, Inc. v. f’real Foods, LLC*, 908 F.3d 1328, 1339 (Fed. Cir. 2018)(citing *SAS Inst., Inc. v. ComplementSoft, LLC.*, 825 F.3d 1341, 1351 (Fed. Cir. 2016)(“it is unreasonable to expect parties to have briefed or argued, in the alternative, hypothetical constructions not asserted by their opponent.”)), *rev’d and remanded sub nom. on other grounds, SAS Inst., Inc. v. Iancu*, 548 U.S. ___, 138 S. Ct. 1348

(2018)). This Court has repeatedly held Oral Hearing is too late. See *Amazon.com, Inc. v. ZitoVault, LLC*, 754 F. App'x 965, 972 (Fed. Cir. 2018); *Dell*, 818 F.3d at 1301 (finding an APA violation when petitioner raised new argument at Oral Hearing relied on for unpatentability, stating “oral argument presented no opportunity for [patent owner] to supply evidence.”).

Petitioner did not seek any claim construction; the institution decisions were also silent regarding preamble constructions. Appx0159-0228, Appx1331-1404. The first mention of preamble constructions was during Oral Hearing when the Board asked if Petitioner “has a position as to whether the preamble of claim 1 that we see there on Slide 5 is limiting or not,” Appx3039. In accord with the facts, Petitioner responded, “I don’t believe that is an issue that [the parties] have addressed in the briefing.” Appx3040. The Board did not request Patent Owner address this hypothetical construction and waited until its FWDs to reveal its own critical and affective preamble constructions. Appx0021-0023, Appx0089-0091. Without notice the preamble constructions were at issue and without the opportunity to meaningfully respond, the Board violated the APA.

A. The Board Acted As An Advocate When It Put At Issue And Then Construed The Preambles.

Other than citation to the Patents, the FWDs are devoid of reference to Petitioner’s argument or evidence. Appx0021-0023, Appx0089-0091. A single

citation to Patent Owner's Response is used by the Board to support its *own* review of the Specifications.⁴ Appx0023, Appx0090-0091. At no place in either FWDs' preamble construction section does the Board use language like "Patent Owner argues," "Petitioner argues," or "we weigh," as was its pattern in the proper claim construction analysis for "buffer tube" and "elastomeric".⁵ Rather than address each Parties' argument and offer findings as to the weight of the evidence, the Board cites its own case law and repeatedly uses pronouns and phrases demonstrating the Board advocated for this issue itself. Appx0021-0023, Appx0089-0091.

The Board then used its own construction in the secondary considerations analysis, finding Patent Owner failed to establish nexus (or its presumption) because Patent Owner did not establish the number of products sold with the limiting components in the preamble. Appx0044-0048, Appx0113-0118. Appx0045-0047, Appx0114-0117. Based on its own constructed patent scope, the Board wrongly dismissed evidence of commercial success and did not afford Patent Owner the opportunity to provide evidence comporting with the newly-narrowed Patents.

⁴ "The '444 [p]atent discloses and claims a stabilizing attachment for a handgun that has a support structure extending rearwardly from the rear end of the handgun."

⁵ Patent Owner requested claim construction, parties submitted briefing then analyzed, weighed, and included in the FWD's factual findings. Appx0016-0022, Appx0080-0089.

Given the Board put preamble constructions at issue during the Oral Hearing, without opportunity to respond, the Board exceeded its statutory authority by acting as an advocate, placing the constructions at issue, supplying its own rationale, and ultimately holding on its own constructions. The Board violated the APA, narrowing the Patents' scope without notice and opportunity to respond.

IV. The Panel Violated §144, The APA, And Patent Owner's Due Process When It Summarily Affirmed The Board's Decision Predicated On Board Error.

Under Rule 36, the Court may only summarily affirm when the decision: is based on findings not clearly erroneous; warrants affirmance under the standard of review; or was entered without an error of law. Fed. Cir. R. 36(a)(1), (4)-(5). This Court "review[s] the PTAB's factual findings for substantial evidence and its legal conclusions de novo." *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 449 (Fed. Cir. 2015). Members of this Court acknowledge summary affirmance prevents meaningful review. See *Memorylink Corp. v. Motorola, Inc.*, 676 F.3d 1051, 1051-53 (Fed. Cir. 2012) (O'Malley, J. dissenting). Because the FWDs were predicated on determinations made in Board error for not-at-issue preamble constructions and violating the APA, summary affirmation is not proper because an opinion must be issued in IPR appeals under 35 U.S.C. §144. Affirmation of the Board's failure to follow established precedent that the Petition controls the IPR's scope and preamble construction process creates a *de facto* new standard: the

Petition no longer governs an IPR, the Board need not weigh parties' evidence, and may rule on not-at-issue preamble constructions. Such an interference necessitates a different result in this case and re-evaluation of summary affirmation.

V. CONCLUSION

Accordingly, this case presents questions of exceptional importance, fails to follow precedent and should be considered en banc.

Dated: December 08, 2022

Respectfully submitted,

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CERTIFICATE OF SERVICE AND FILING

I hereby certify that a true and correct copy of the foregoing has been filed using the Court's CM/ECF system. All counsel of record will be served via CM/ECF on the 8th day of December, 2022.

Dated: December 08, 2022

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**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
LIMITATIONS**

I certify that this combined motion and petition for rehearing complies with the type-volume limitations of Federal Rules of Appellate Procedure 27(d)(2)(A) and 35(b)(2)(A). The combined motion and petition for rehearing contains 3,858 words, excluding the parts of the document exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b)(2). This motion has been prepared in a proportionally spaced typeface using Microsoft Word in Times New Roman, 14 Point.

Dated: December 08, 2022

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ADDENDUM

NOTE: This disposition is nonprecedential.

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

SIG SAUER INC.,
Appellant

v.

NST GLOBAL, LLC, DBA SB TACTICAL,
Cross-Appellant

2021-2241, 2021-2242, 2021-2247, 2021-2248

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2020-00423, IPR2020-00424.

JUDGMENT

ERIC G.J. KAVIAR, Burns & Levinson LLP, Boston, MA, argued for appellant. Also represented by LAURA CARROLL, JOSEPH M. MARAIA.

BRITTANY J. MAXEY-FISHER, Maxey-Fisher, PLLC, St. Petersburg, FL, argued for cross-appellant. Also represented by STACEY TURMEL.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (REYNA, SCHALL, and CHEN, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

November 8, 2022
Date

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