

No. 22-1001

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IN THE  
**Supreme Court of the United States**

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NST GLOBAL, LLC, DBA SB TACTICAL,

*Petitioner,*

*v.*

SIG SAUER INC.,

*Respondent.*

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**ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

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**BRIEF OF SIG SAUER INC. IN OPPOSITION  
TO PETITION FOR CERTIORARI**

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## **QUESTIONS PRESENTED**

Whether the U.S. Patent Trial and Appeal Board (the “PTAB”) correctly found that the Preambles of the patents at issue were limiting and that NST Global, LLC (“NST”) had not addressed that issue, despite the PTAB’s prior notice.

Whether the PTAB correctly determined that NST had failed to show the nexus required to afford substantial weight to NST’s evidence of secondary considerations.

Whether NST has standing to challenge the Federal Circuit’s Rule 36 Affirmances without an opinion.

**RULE 29.6 CORPORATE  
DISCLOSURE STATEMENT**

Respondent SIG SAUER Inc. is a privately held corporation. SIG SAUER Inc.'s parent corporation is SIG SAUER US Holding LP, which in turn is owned by L&O Finance GmbH and SIG SAUER Management LLC. SIG SAUER Inc. is not a publicly held company, and neither its parent corporation nor the parent corporation's owners are publicly held companies.

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## INTRODUCTION

NST Global, LLC (“NST”) has petitioned this Court for a writ of *certiorari* in the hope that the Court will rescue NST from adverse and narrow factual and legal findings that were made by the U.S. Patent Trial and Appeal Board (the “PTAB”) based on well-settled law. Notwithstanding NST’s creative Questions Presented, NST’s Petition has not met the requirements for a grant of *certiorari* and its Petition should be denied.

As explained more fully below, NST’s Petition depends upon a flawed premise, *i.e.*, NST contends that the PTAB made a “*sua sponte*” ruling concerning whether the Preambles in the patents at issue were limiting. There was, however, no *sua sponte* ruling, nor did the PTAB consider itself to have made such a ruling.

During the two underlying *inter partes* review proceedings (“IPRs”) at the PTAB, NST never addressed SIG SAUER’s contentions that the Preambles of the patents at issue were limiting and met by *Forjot*, the primary prior art cited in the IPRs. The PTAB also early on and repeatedly notified NST that whether the Preambles were limiting was a live issue and indeed warned NST that it appeared that NST was waiving any objection to the Preambles being limiting.

Moreover, contrary to NST’s Petition, whether the Preambles are limiting is irrelevant. NST contends that if the Preambles are not limiting, the PTAB’s determination that secondary indicia failed to support non-obviousness of the claimed invention was in error. In so doing, however, NST misstates the record by pointing to only one of two

independently sufficient grounds the PTAB relied upon in declining to afford the secondary indicia much weight.

Under the second ground, the PTAB presumed for sake of argument that the Preambles were not limiting, and still found an insufficient nexus between the proffered secondary indicia and the claimed invention. Specifically, the PTAB determined that an unclaimed feature drove sales of NST's commercial embodiments, *i.e.*, the ability to use the claimed "forearm" support structure like a stock so that one could fire the weapon from a "shouldered" position as if it were a rifle. Because a finding in NST's favor as to the Preambles would not change the PTAB's decision, there is no compelling reason for *certiorari* to be granted.

NST has also expressed objections to the Federal Circuit's use of "Rule 36" summary affirmances. That issue, however, is not well presented by the facts underlying the Petition. Nor has NST explained how it has standing to make such a challenge.

## STATEMENT

SIG SAUER filed IPR Petitions against U.S. Patent Nos. 9,345,021 and 8,869,444 ("the '021 Patent" and "the '444 Patent" respectively, and collectively, the "Patents at Issue") following its denial of NST's allegations of infringement.<sup>1</sup> The PTAB issued Final Written Decisions finding certain claims of those patents unpatentable and

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1. Citations to "C.A. App." refer to the Appendix filed in the Federal Circuit appeals of the PTAB's Final Written Decisions. The Patents at Issue are at C.A. App.0151-0158 ('021 Patent) and C.A. App. 0142-0150 ('444 Patent), and the respective IPR Petitions are at C.A. App. 0195-0228 and C.A. App. 0159-0194.

other claims patentable. C.A. App. 0069-0135, 0001-0068.<sup>2</sup> SIG SAUER and NST each appealed certain adverse rulings. The Federal Circuit affirmed the PTAB's pertinent findings on appeal in a Fed. Cir. Rule 36 summary affirmance. Pet. App. 1a-2a. NST thereafter petitioned for a rehearing *en banc* despite the lack of a written decision to challenge which would contain actual precedent-setting questions, *see* Fed. Cir. R. 35(b)(2); The petition for rehearing was denied (Pet. App. 3a-4a), and NST subsequently filed the present Petition.

The following Sections are intended to address and correct certain misstatements made by NST within its Statement of the Case, as well as to provide additional, pertinent context for why the Court should deny the Petition.

## **I. Overview of the '021 & '444 Patents**

The Patents at Issue are each directed to a “forearm-gripping stabilizing attachment” that can be used for support when firing a pistol.

### **A. The Shared Specification**

Through their shared Specification, the '021 and '444 Patents each disclose a type of arm brace. C.A. App. 0151-158 and C.A. App. 0142-150, respectively. The arm brace “secures to the rearward end of a handgun” and grips a user's forearm via at least one (*see* claims of '021 Patent) or more (*see* claims of '444 Patent) resilient flap members.

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2. The Final Written Decisions are also included in NST's Petition's Appendix (“Pet. App.”) at 5a-165a.

C.A. App. 0156, 1:48-51; C.A. App. 0147, 1:45-49. The flap members allow a user to secure the arm brace to the user's forearm through "gripping force." C.A. App. 0156, 1:48-51; C.A. App. 0147, 1:45-49. The arm brace assists a user in holding the handgun steady and aligned, which is particularly advantageous for use by people who cannot use both arms when shooting. C.A. App. 0156, 1:24-31; C.A. App. 0147, 1:22-35.

An embodiment of the stabilizing attachment 10 is shown below in Figures 1 (side view) and 2 (cross-section):

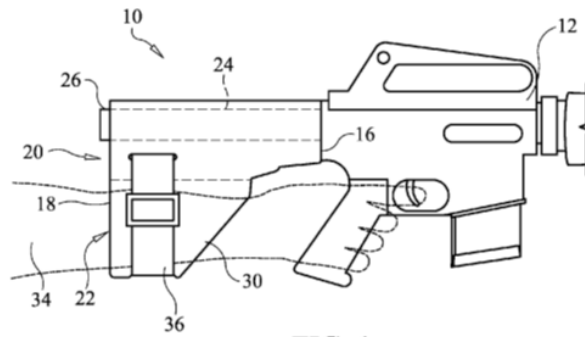


FIG. 1

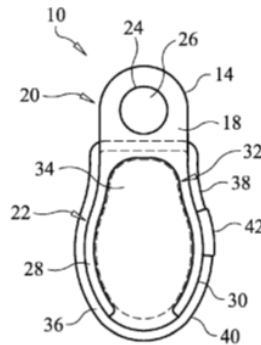


FIG. 2

C.A. App. 0153; C.A. App. 0144. The stabilizing attachment 10 includes a body 14 (*see* Fig. 2) which has a longitudinal passage 24 that extends therethrough. C.A. App. 0157, 3:54-56; C.A. App. 0148, 3:46-48. The longitudinal passage 24 is for receiving a support structure of the handgun 12, such as buffer tube 26. C.A. App. 0157, 3:59-64; C.A. App. 0148, 3:48-53.

Stabilizing attachment 10 also includes opposed flaps 28 and 30 for receiving a user's forearm. C.A. App. 0157, 4:7-17; C.A. App. 0148, 9-21. Flaps are made of a semi-rigid elastomeric material suitable for gripping the user's forearm. C.A. App. 0157, 4:12-18; C.A. App. 0148, 4:4-9.

In a preferred embodiment, body 14 is sized such that when the buffer tube 26 is fully inserted through passage 24, it partially extends outwardly from the passage and beyond the rearward end 18 of the body. C.A. App. 0157, 3:59-67; C.A. App. 0148, 3:51-59. This configuration is disclosed in the patents as being preferred for discouraging "improper use" of the claimed invention as a stock. C.A. App. 0157, 3:67-4:3; C.A. App. 0148, 3:59-62.

## **B. Claims**

### **1. The '021 Patent**

Independent claims 1, 3, and 5 in the '021 Patent are similar and, among other things, require a body with a passage, a flap, and a strap. C.A. App. 0158. Claims 3 and 5 also require a "buffer tube." *Id.* Of further note, dependent claims 2 and 4 state that the flap is constructed of an elastomeric material. Below is representative claim 1, divided into its limitations:

[1.0] 1. A forearm-gripping stabilizing attachment for a handgun, the handgun having a support structure extending rearwardly from the rear end of the handgun, the forearm-gripping stabilizing attachment, comprising:

[1.1] a body having a front end, a rear end, an upper portion, a lower portion, and a passage longitudinally extending within said upper portion and at least through said front end of said body, the support structure of the handgun being telescopically receivable by said passage;

[1.2] said lower portion having at least one flap extending from said upper portion;

[1.3] a strap connected to said body, said strap securing said at least one flap to a user's forearm when the stabilizing attachment is secured to a user's forearm; and

[1.4] wherein said passage extends entirely through said body between said front end and said rear end of said body.

## 2. The '444 Patent

Independent claims 1, 6, and 10 in the '444 Patent are similar and, among other things, recite three primary elements: a body with a passage, a pair of flaps, and a strap. C.A. App. 0149-150. The dependent claims include minor details related to these elements. *Id.* Representative claim 1 is below, divided into its limitations:



[1.0] 1. A forearm-gripping stabilizing attachment for a handgun, the handgun having a support structure extending rearwardly from the rear end of the handgun, the forearm-gripping stabilizing attachment, comprising:

[1.1] a body having a front end, a rear end, an upper portion, a lower portion, and a passage longitudinally extending within said upper portion and at least through said front end of said body, the support structure of the handgun being telescopically receivable by said passage;

[1.2] said lower portion being bifurcated so as to define a pair of spaced flaps between which a user's forearm is received when securing the stabilizing attachment to the user's forearm; and

[1.3] a strap connected to said body, said strap securing said spaced flaps to retain the user's forearm between said spaced flaps when the stabilizing attachment is secured to a user's forearm.

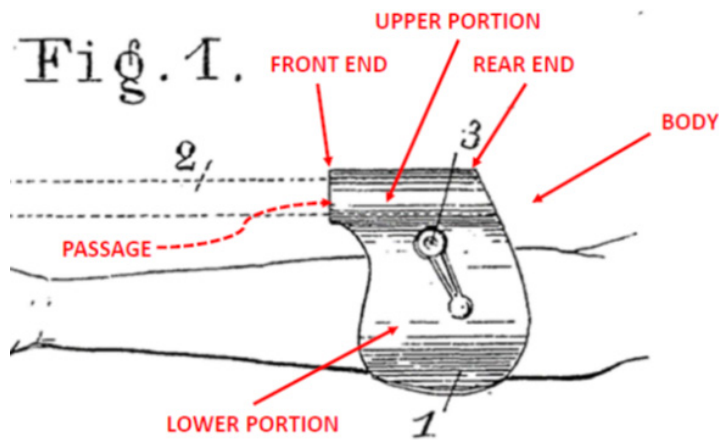
## II. Overview of the Key Prior Art

*Forjot*, French patent number 899,565, was published on June 5, 1945, and is prior art under pre-AIA 35 U.S.C. § 102(b). C.A. App. 0871-0875; C.A. App. 0876-0881.<sup>3</sup> As shown below in annotated Figure 1 below, *Forjot* discloses

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3. C.A. App. 0871-0875 is the patent in its original French. C.A. App. 0876-0881 is the certified English translation. In this Opposition Brief, SIG SAUER has cited to the certified translation.

a cuff 1 to grip the user's forearm. C.A. App. 0878-879. The cuff 1 is part of a body (*i.e.*, a stabilizing attachment) that attaches to a tube 2 extending from the rear of the pistol, *id.*:



### III. The Proceedings Below

Given the substantial similarity of the claims in the Patents at Issue and given that they share the same Specification, the Parties' respective arguments and the PTAB's Final Written Decisions in each of the two underlying proceedings are substantially similar to one another as well. Except where otherwise stated or evident from context, the PTAB's holdings described in the section below apply to both Patents at Issue, as also evidenced by the record citations to both decisions.

In its IPR Petitions, SIG SAUER contended that *Forjot* discloses the Preambles, *i.e.*, the preambles of the independent claims, *i.e.*, claims 1, 3, and 5 of the '021 Patent and claims 1, 6, and 10 of the '444 Patent (collectively, the "Preamble Limitations"). C.A. App. 0179-0180; C.A. App.

0214-0215. SIG SAUER's aforementioned contentions are referred to herein as the "Preamble Contentions." SIG SAUER did not propose a formal claim construction for the Preambles, as it did not anticipate there would be a dispute on the meaning of the Preambles.

The PTAB's decisions to institute IPRs as to both Patents at Issue confirm that the PTAB also treated the Preambles as limitations. For example, with respect to the '021 Patent, the PTAB's Institution Decision found:

The preamble of claim 1 recites "[a] forearm-gripping stabilizing attachment for a handgun, the handgun having a support structure extending rearwardly from the rear end of the handgun." Ex. 1001, 6:12-15. Petitioner contends that Forjot's cuff corresponds to the recited forearm-gripping stabilizing attachment and that Forjot's cuff is for a handgun. Pet. 15-16 (referencing Ex. 1008, 2:3-7, 2:51-52; Ex. 1002 ¶¶ 45, 46). Petitioner adds that Forjot's cuff is attached to a tube, corresponding to the recited support structure. *Id.* (referencing Ex. 1008, 2:9-11; Ex. 1002 ¶ 47); *see also* Ex. 1008, Fig. 1 (depicting tube 2 extending rearwardly from a gun).

We have reviewed Petitioner's contentions and determine that Petitioner has made a sufficient showing, at this stage of the proceeding, that Forjot discloses the subject matter of the preamble of claim 1. ***Patent Owner does not dispute Petitioner's contentions with respect to the preamble of claim 1 at this time.***

C.A. App. 1380-1381; *accord* C.A. App. 1342 (emphasis added). At no time during the IPR proceedings did NST dispute that the Preamble Limitations were limiting, nor dispute that those limitations were met by *Forjot*.

During the IPR Hearing (the “Hearing”), the PTAB specifically asked counsel for SIG SAUER whether it contended the Preambles were limiting. C.A. App. 3039, at 10:24-26. While counsel did not recall at that point in the Hearing whether the issue had been addressed in the briefing, he confirmed the issue would not impact the analysis either way. C.A. App. 3040, at 11:1-4. Later during the Hearing, counsel for SIG SAUER clarified his earlier response by stating that “the claimed invention requires a forearm-gripping stabilizing attachment, that’s the preamble.” C.A. App. 3086, at 57:1-2. NST was the last party to present argument at the Hearing and NST did not address whether the Preambles were limiting or met by *Forjot*.

In its Final Written Decisions, the Board summarized SIG SAUER’s arguments from its Petitions for how *Forjot* meets the Preamble Limitations and the Board agreed that the Preambles were limiting and met by *Forjot*. C.A. App. 1342; C.A. App. 1380-1381. The Final Written Decisions also contain a detailed analysis explaining why the Preambles were limiting and how NST failed to oppose the issue. *See* C.A. App. 0021-0023; C.A. App. 0089-0091. NST did not appeal the PTAB’s finding that NST failed to oppose SIG SAUER’s contentions on the issue, neither in its appeal to the Federal Circuit, nor in its Petition to this Court. Instead, NST contends, incorrectly, that the PTAB’s ruling was *sua sponte*.

In the IPRs, NST submitted evidence that NST contended demonstrated the commercial success of NST's claimed commercial embodiment of its inventions, since such "secondary considerations" evidence can be considered as evidence of an invention's non-obviousness. There must, however, be a nexus between such evidence and the claimed invention. In the IPRs, the PTAB considered the secondary considerations evidence submitted by NST, and found that it did not tip the scales in favor of validity for at least two independently sufficient reasons. C.A. App. 0044-0049; C.A. App. 0113-0119.

First, the PTAB concluded that NST had failed to meet its burden of showing a nexus between the claimed inventions and the proffered evidence of secondary considerations. As noted, the PTAB had determined that the Preambles were limiting, meaning that the PTAB considered the claimed invention to consist of both "a handgun" and "a support structure extending rearwardly from the rear of the handgun." C.A. App. 0045-0046; C.A. App. 0115. Because NST's evidence of commercial sales focused on the attachments and not any sales of handguns, NST had failed to show how many commercial embodiments sold included both of those elements. C.A. App. 0045-46; C.A. App. 0115; *see* C.A. App. 3081-3082 (Hearing Transcript), 52:24-53:13. Nor could NST show that its commercial embodiments were coextensive with the claimed inventions. C.A. App. 0046; C.A. App. 0116.

The PTAB did not end its analysis at this point, however. As the PTAB stated, it "[n]onetheless" substantively weighed NST's evidence of secondary considerations, as if NST had shown the requisite nexus, *i.e.*, that NST's commercial embodiments were coextensive with the claimed inventions. In other words, the PTAB

proceeded with its analysis as if it had not found the Preambles limiting:

Nonetheless, considering the SB15 stabilizer used with a handgun and a support structure extending rearwardly from the rear of the handgun, [NST] has not sufficiently shown that the objective evidence of non-obviousness is the result of some aspect of the claim (not already in the prior art) or the claimed combination as a whole.

C.A. App. 0047; C.A. App. 0117.

After considering all of the evidence, the PTAB concluded that NST had failed to show that secondary considerations weighed significantly in favor of non-obviousness. *Id.* The PTAB found that the evidence did not support that the claimed inventions were responsible for any purported commercial success or acclaim. *Id.* Instead, the PTAB “agree[d] with Petitioner [SIG SAUER] that the evidence of record supports a finding that any commercial success is likely attributable, at least in large part, to the ability to shoulder an AR15 pistol using Patent Owner’s brace.” C.A. App. 0047; C.A. App. 0117.

After considering all of the evidence which supported that “shouldering,” rather than the claimed invention, was the most likely reason for any commercial success, the PTAB also specifically noted that its holding applied to the various models of NST’s products given that most of the news articles submitted by NST as evidence of secondary considerations only addressed NST’s products generally and without identifying specific models. C.A. App. 0048, n. 14; C.A. App. 0118, n. 14.

NST appealed to the Federal Circuit (as did SIG SAUER), and following oral argument, the Federal Circuit affirmed the PTAB's findings without an opinion under Federal Circuit Rule 36. *See* Pet. App. 1a-2a.

NST petitioned for a rehearing *en banc* despite that there was no written decision to challenge which contained any precedent-setting questions, *see* Fed. Cir. R. 35(b)(2). After the petition for rehearing was denied (Pet. App. 3a-4a), NST petitioned this Court for *certiorari*.

## **REASONS FOR DENYING THE PETITION.**

### **I. The Case Presents No Basis to Review The Board's *Sua Sponte* Powers.**

#### **A. The Board Did Not Rule *Sua Sponte*; It Agreed with SIG SAUER's Contentions.**

In its Petition to this Court, NST contends that the PTAB ruled, *sua sponte*, and without warning, that the Preambles were limiting. Pet. (i), 1-9, 22-27. The PTAB, however, never characterized any of its holdings in its Final Written Decisions as "*sua sponte*", nor has anyone since other than NST. In the PTAB's own words, it simply ruled on SIG SAUER's contentions:

We have reviewed [SIG SAUER]'s contentions and find, on the complete record, that [it] has demonstrated, by a preponderance of the evidence, that Forjot discloses the subject matter of the preamble[s]. [NST] does not dispute [SIG SAUER]'s contentions with respect to the subject matter of the preamble of claim 1.

C.A. App. 0026; C.A. App. 0094, internal record citations omitted.

Indeed, before reaching the rulings at issue, the PTAB had warned NST that it had not responded to SIG SAUER's related contentions in the Institution Decisions (as discussed in more detail below). Contrary to NST's contentions, the issue of whether the Preambles were limiting was a consistent issue in the IPR proceedings since SIG SAUER first raised that issue in its IPR Petitions.

It is worth noting that NST is now continuing to make the same arguments it did before the Federal Circuit concerning whether there was a *sua sponte* ruling, while never directly refuting any of SIG SAUER's evidence or argument.

Plainly, the Court cannot review the PTAB's *sua sponte* powers through this case if the PTAB never exercised such powers. NST's Petition should also be denied because, at best, it is appealing the factual issue of whether the PTAB correctly found *Forjot* met the Preamble Limitations and/or the issue of whether the PTAB misapplied the law concerning when preambles may be limiting. *See* Supreme Court Rule 10 (confirming that a petition for a writ of *certiorari* is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law).



**B. NST Failed to Dispute that the Preambles Were Limiting During the IPR Proceedings, Thereby Waving its Challenge.**

NST contends that it “was not given notice the Board was considering whether the language of a patent’s preamble was limiting...” Pet. (i); *see also id.*, 1-9, 22-27. At one point, NST even boldly speaks for SIG SAUER, and contrary to SIG SAUER’s express representation before the Federal Circuit: “A complete surprise to both parties, PTAB itself first raised a possible preamble limitation theory in a singular question to Sig at the IPRs’ Oral Hearing on March 23, 2021.” *Id.* at 6. NST’s contentions are plainly contradicted by the record and NST, of course, does not speak for SIG SAUER.

In the Initial Scheduling Orders, the PTAB “cautioned” NST “that any arguments not raised in [its] [Patent Owner R]esponse[s] may be deemed waived.” Scheduling Orders of June 25, 2020, in IPR2020-0423 and IPR2020-0424, Paper 11, at 8.<sup>4</sup> And as previously discussed, in its Final Written Decisions, the PTAB agreed with SIG SAUER that the Preamble Limitations were disclosed by *Forjot* and found that NST had failed to dispute those contentions. C.A. App. 0025-0026; C.A. App. 0093-94; Pet. App. 30a-32a; Pet. App. 110a-112a. Indeed, as SIG SAUER pointed out to NST during the appeal, the PTAB expressly stated the following in its Institution Decisions, which provided clear notice that NST needed to address the preamble limitation issue or risk waiver:

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4. This caution from the Board is standard in initial scheduling orders. *See* text for Due Date 1, when Patent Owner’s Response is due following an institution decision, in the *Patent Trial and Appeal Board Consolidated Trial Practice Guide* (Nov. 2019), Appendix A-1: Sample Scheduling Order, p. 100.

We have reviewed Petitioner’s contentions and determine that Petitioner has made a sufficient showing, at this stage of the proceeding, that Forjot discloses the subject matter of the preamble of claim 1. ***Patent Owner does not dispute Petitioner’s contentions with respect to the preamble of claim 1 at this time.***

C.A. App. 1380-1381; C.A. App. 1342 (emphasis added).

Having failed to challenge SIG SAUER’s contentions, or the PTAB’s preliminary findings, at any time during the IPR proceedings, including in its Patent Owner Responses (C.A. App. 1405-1469; 1470-1533), NST waived the right to challenge whether the Preambles were limiting for the first time on appeal. *Collabo Innovations, Inc. v. Sony Corp.*, 802 F. App’x 568, 571-72 (Fed. Cir. 2020) (finding waiver of arguments where neither the patent owner’s preliminary response nor its patent owner response challenged the opposing party’s related contention); *Finjan, Inc. v. Cisco Sys., Inc.*, 837 F. App’x 799, 809 n. 10 (Fed. Cir. 2020) (finding patent owner waived arguments omitted from its patent owner response, even though the patent owner made those arguments in its preliminary response); *In re NuVasive*, 842 F.3d 1376, 1380-81 (Fed. Cir. 2016) (same).

NST also waived its *sua sponte* arguments for purposes of the Federal Circuit appeal because those contentions, when properly framed, represent a new position on claim construction. “[A] party may not introduce new claim construction arguments on appeal or alter the scope of the claim construction positions it took below.” *Conoco, Inc. v. Energy & Env’tl. Int’l*,

*L.C.*, 460 F.3d 1349, 1358–59 (Fed. Cir. 2006). Before the PTAB, NST tacitly adopted SIG SAUER’s positions on the preambles by failing to dispute those positions during the proceedings. As a result, the fact that NST now tries to change the position it took with respect to the scope and nature of the Preamble Limitations provides another reason not to disturb the PTAB’s decision. *Finjan*, 837 F. App’x at 808 (“[T]o the extent Finjan tries to alter its proposed construction of “downloadable-information” on appeal ... its argument is waived.”), citing *Conoco*, 460 F.3d at 1358–59 (substantially similar); *Bos. Sci. SciMed, Inc. v. Iancu*, 811 F. App’x 618, 629 (Fed. Cir. 2020) (finding waiver where “Boston Scientific did not raise th[e] claim construction argument in its briefing before the PTAB.”).

NST also raises in its Petition a host of arguments concerning the purported turbulence caused by alleged confusion on the law of preambles. Pet. 16-21. These arguments are incorrect and there is no need for the Court to address that body of law, including because NST never presented these arguments in its opening brief to the Federal Circuit. *Collabo*, 802 F. App’x at 571-72; *Finjan*, 837 F. App’x at 809 n. 10; *In re NuVasive*, 842 F.3d at 1376.

This Court should not visit any of the constitutional and/or administrative issues NST attempts to argue in its Petition given NST lacks any right to raise those issues. *Engel Indus., Inc. v. Lockformer Co.*, 166 F.3d 1379, 1383 (Fed. Cir. 1999) (“An issue that falls within the scope of the judgment appealed from but is not raised by the appellant in its opening brief on appeal [to this circuit] is necessarily waived.”); *U.S. v. Ardley*, 273 F.3d 991, 992 (11th Cir. 2001) (denying petition for rehearing *en banc* following finding that, despite remand from the Supreme

Court, a party had waived an argument due to its earlier failure to include argument in its opening brief to the Eleventh Circuit), *cert. denied sub nom. Ardley v. U.S.*, 535 U.S. 979 (2002). *Accord Skilling v. United States*, 561 U.S. 358, 446 n. 9 (2010) (Sotomayor, J., concurring in part) (observing, in criminal context, that defendant had likely waived argument because, among other things, the defendant failed to present the issue in its opening brief to Fifth Circuit).

## **II. Even if the PTAB Ruled “*Sua Sponte*,” The Specific Facts of this Case Limit its Reach and Counsel Against Review.**

NST contends the PTAB made a “*sua sponte*” decision which deprived NST of the “due process” it was owed under the Administrative Procedure Act (“APA”) and the United States Constitution, because NST purportedly was not provided with notice and an opportunity to be heard. Pet. 28-32. Even if NST was correct that the PTAB construed the Preambles *sua sponte* (which plainly was not what occurred as discussed above), NST’s arguments would still fail to raise an issue of significant importance for this Court given that NST is simply appealing the PTAB’s conclusions of fact and law that were premised upon indisputable fact and settled law.

### **A. NST Had Notice and Opportunity.**

There is no *per se* law prohibiting the PTAB from reaching an issue *sua sponte*. *See TQ Delta, LLC v. DISH Network LLC*, 929 F.3d 1350, 1355 (Fed. Cir. 2019) (finding no violation of APA where Board presented a “*sua sponte*” construction involving an issue that patent owner

could have addressed in briefing or at the hearing); *see also Intellectual Ventures II LLC v. Ericsson Inc.*, 686 F. App'x 900, 906 (Fed. Cir. 2017) (explaining that the patent owner's APA and due process arguments were meritless because it was on notice of the at-issue construction before the final written decisions).

The question of whether the PTAB had the power *sua sponte* to find the Preambles limiting turns on whether NST had sufficient notice and an opportunity to address the underlying issue during the IPR proceedings. *See TQ Delta*, 929 F.3d at 1355; *Intellectual Ventures*, 686 F. App'x at 906; *accord Day v. McDonough*, 547 U.S. 198, 199 (2006) (“Before acting *sua sponte*, a court must accord the parties fair notice and an opportunity to present their positions.”)

This appears to be a well-settled standard, and NST has not identified any disputes among different panels of the Federal Circuit on the issue. In addition, that standard appears to be fully consistent with all of the caselaw cited by NST in connection with its arguments as to what due process is required under the U.S. Constitution and APA. *See* Pet. 22-27.

During both IPRs, NST had both notice and an opportunity to respond to SIG SAUER's arguments or otherwise be heard, even if the PTAB had acted *sua sponte*:

- NST could have addressed whether the Preambles were limiting in its Patent Owner Preliminary Responses given that the Petitions addressed and identified the Preambles as limiting and met by *Forjot*.

- NST could have addressed whether the Preambles were limiting in its Patent Owner Responses given SIG SAUER's related contentions in the Petitions, as well as the PTAB's agreement with those contentions and notification in the Institution Decisions (C.A. App. 1342; C.A. App. 1380-1381) that NST had not stated whether it was challenging that the Preamble Contentions were limiting and met by *Forjot*.
- NST could have raised the issue of whether the Preambles were limiting in its Patent Owner Sur-Replies.
- NST could have disputed that the Preambles were limiting at the Hearing in response to the PTAB raising that issue or in response to counsel for SIG SAUER's statement confirming that a term in the Preambles was limiting as it was part of the claimed invention.
- After reviewing the PTAB's Final Written Decisions, NST could have petitioned for a rehearing.

In sum, NST had notice that both SIG SAUER and the PTAB considered the Preambles to be limiting and met by *Forjot* from the outset of the IPR proceedings, and NST had repeated opportunities to refute those positions. The Federal Circuit has held that similar types of notice and opportunities to respond prevent a finding that a *sua sponte* ruling violated the APA. *TQ Delta*, 929 F.3d at 1355 (finding party had notice of the PTAB's

understanding of a claim term before it was construed *sua sponte* as limitation was at issue in the briefing and during hearing); *Intellectual Ventures*, 686 F. App'x at 906 (“Given the continuous focus on [the limitation] before and during oral arguments and Intellectual Ventures’ opportunity to seek a sur-reply or rehearing, we find no due process violation”).

In a similar vein, the Federal Circuit has cautioned patent owners, like NST, about the risks of failing to directly respond to the Patent Office’s rejections during prosecution using a rationale that seems apt to consider in connection with NST’s current contentions:

Once an examiner has made a prima facie case for rejecting the application claims, the applicant is provided with an opportunity to submit any saving claim construction it believes may be grounds for reversing the rejection.... An applicant who does not take those opportunities and is then further disappointed by a Board claim construction should be encouraged to avoid waste of appellate resources ...

The very word “review” presupposes that a litigant’s arguments have been raised and considered in the tribunal... To abandon that principle is to encourage the practice of “sandbagging”: suggesting or permitting, for strategic reasons, that the [lower tribunal] pursue a certain course, and later—if the outcome is unfavorable—claiming that the course followed was reversible error. We decline to ... encourage litigants to engage in more of this type of behavior.

*In re Google Tech. Holdings LLC*, 980 F.3d 858, 863-64 (Fed. Cir. 2020) (internal citations and quotation marks omitted).

**B. NST Failed to Challenge a Second and Independently Sufficient Ground the PTAB Cited to Support its Findings.**

It should be noted that the basis for NST's appeal of the Preamble limitation ruling is not that NST disputes whether *Forjot* meets that limitation. NST appears to have even conceded as much. Instead, NST contends that the Preamble limitation caused the Federal Circuit to give little weight to NST's evidence for secondary indicia of non-obviousness. As demonstrated above, however, the PTAB gave NST's evidence of secondary considerations little weight for at least two independently sufficient reasons.

The first reason is the one which NST has appealed, and when properly framed, could be stated as follows: "Whether there was substantial evidence to support the PTAB's determination that NST failed to show the nexus required to give that evidence weight." The PTAB concluded that NST failed to meet its burden of showing a nexus between the claimed invention and the proffered evidence of secondary considerations because the PTAB found that the claimed invention consisted of both "a handgun" and "a support structure extending rearwardly from the rear of the handgun." C.A. App. 0045-0046; C.A. App. 0115. NST's evidence of sales focused on the attachments, and not handguns, so NST could not show how many commercial embodiments sold included both major elements of the claimed invention. *Id.*; see C.A. App.



3081-3082 (Hearing Transcript), 52:24-53:13. In other words, the PTAB found that any evidence of commercial success provided by NST could not be attributed to the claimed invention based on the evidence presented.

Significantly, even if NST had been able to demonstrate commercial success of the claimed invention (*i.e.*, show sales of handguns and support structures extending from handguns), NST would still be unable to reverse the PTAB's determinations concerning secondary considerations. That is because NST failed to appeal the PTAB's substantive holding, which presumed for sake of argument that NST had succeeded in meeting that first gating issue. C.A. App. 0047; C.A. App. 0117.

As is evident in the PTAB's Final Written Decisions, the PTAB closely examined the merits of NST's evidence of secondary considerations. C.A. App. 0043-0049; C.A. App. 0112-0119. The evidence showed that any commercial success was due to an unclaimed feature of the commercial embodiments. C.A. App. 0047-0049; C.A. App. 0117-0119. Specifically, most customers were buying NST's products not for use as the claimed forearm supports, but for misuse as stocks that would allow a customer to "shoulder" a pistol as if it were a rifle. C.A. App. 0047-0049; C.A. App. 0117-0119.

NST did not challenge the PTAB's substantive holding that any commercial success was due to an unclaimed feature before the Federal Circuit, nor has NST raised the issue in its Petition to this Court. While SIG SAUER expressly raised this issue in the Federal Circuit appeal, NST still has failed to explain how NST's hoped-for reversal on the preamble issue could impact, let alone undo

that second substantive holding by the PTAB. Nor could it. The issue of whether the claimed invention is a handgun and forearm support, as recited in the Preambles, or just a forearm support, as asserted by NST, is irrelevant to the PTAB's subsequent and subsuming holding.

As a result, even if this Court were to grant NST's Petition, and find the PTAB did err in holding that NST failed to prove a "nexus" between its purported commercial embodiments and its evidence of commercial success, the Court should still leave the PTAB's ultimate ruling undisturbed, which presumed such a nexus had been shown. The PTAB provided separate and independently sufficient bases to sustain its rulings on secondary considerations, meaning the ruling adverse to NST would still stand and any error would be rendered harmless. *Jacobsen v. Dep't of Justice*, 500 F.3d 1376, 1381 (Fed. Cir. 2007) (finding error harmless where second ground upheld outcome); *Tech. Coll. of the Low Country v. United States*, 145 Fed. Cl. 408, 429 (2019) (error was harmless where a second, independently sufficient basis supported a holding).

### **III. This Case is Not an Appropriate Vehicle to Address Issues of Summary Affirmance under Federal Circuit Rule 36.**

#### **A. The Presence or Absence of a Written Decision Has No Impact on NST's Appeal.**

In its Petition, NST challenges the fact that the Federal Circuit issued only a summary affirmance without opinion under Fed. Cir. Rule 36. Pet. 28-38. This is not a case, however, where the presence or absence of a Federal Circuit written decision would have made any difference.

As shown above, in the Federal Circuit appeal NST did not dispute the evidence showing that during the IPRs, NST had repeated notices and opportunities to respond to SIG SAUER's contentions that the Preambles were limiting and met by *Forjot*.

There also does not appear to be any dispute concerning the standards governing when the PTAB can make *sua sponte* determinations concerning claim construction, or whether those standards are consistent with constitutional or administrative standards concerning due process.

In order for this Court to reach the issue of whether the Federal Circuit must issue written opinions in all U.S. Patent Office Appeals, as NST contends, this Court would need to ignore all of the issues above despite the fact that the case is easily resolved by those grounds (and even if the Preambles are not limiting). Granting *certiorari* under such a posture would almost certainly result in an advisory opinion, which is disfavored. *Cf. California v. Texas*, 141 S. Ct. 2104, 2108 (2021) (“To find standing to attack an unenforceable statutory provision would allow a federal court to issue what would amount to an advisory opinion without the possibility of an Article III remedy.”); *Muskrat v. United States*, 219 U.S. 346, 361 (1911) (“This attempt to obtain a judicial declaration of the validity of the act of Congress is not presented in a ‘case’ or ‘controversy,’ to which, under the Constitution of the United States, the judicial power alone extends”).

Stretching in this case to reach the issue of whether Rule 36 summary affirmances are appropriate would also be an inefficient use of judicial resources given how easily NST's appeal is dismissed on other grounds. *See Babcock v. Kijakazi*, 142 S. Ct. 641, 645 n. 3 (2022) (“We need not

reach this question to decide the case and express no view of the Government's alternative argument, which was neither pressed nor passed upon below."); *Federal Communication Commission v. Prometheus Radio Project*, 141 S. Ct. 1150, 1160 (2021).

**B. NST Has Not Shown It Has Standing to Challenge Federal Circuit Rule 36 Affirmances.**

The issue of whether Rule 36 Summary Affirmances should exist as a docket management tool for the Federal Circuit is not a new one, nor is the Petition even the first *certiorari* petition to raise the issue this year and would unlikely be the last, if/when denied.

Indeed, the Court appears to routinely receive and reject petitions that take aim at the propriety of Rule 36 Summary Affirmances, *see NVS Techs., Inc. v. Dep't of Homeland Sec.*, *cert. denied*, 142 S. Ct. 1441 (2022) (denying petition which involved challenged to Rule 36); *Manivannan v. Dep't of Energy*, *cert. denied*, 143 S. Ct. 307 (2022) (substantially same); *Ultratec, Inc. v. CaptionCall, LLC*, *cert. denied*, 142 S. Ct. 460 (2021) (substantially same); *Chestnut Hill Sound Inc. v. Apple Inc.*, *cert. denied*, 140 S. Ct. 850 (2020) (seeking review of Federal Circuit's Rule 36 affirmation practice); *SPIP Litig. Group, LLC v. Apple, Inc.*, *cert. denied*, 140 S. Ct. 520 (2019) (same); *Power Analytics Corp. v. Operation Tech., Inc.*, *cert. denied*, 140 S. Ct. 910 (2020) (same); *Senju Pharm. Co. v. Akorn, Inc.*, *cert. denied*, 140 S. Ct. 116 (2019) (same); *Capella Photonics, Inc. v. Cisco Systems, Inc.*, *cert. denied*, 139 S. Ct. 462 (2018) (same); *Stambler v. Mastercard Int'l Inc.*, *cert. denied*, 139 S. Ct. 54 (2018) (same); *Security People, Inc. v. Ojmar US, LLC*, *cert. denied*, 138 S. Ct. 2681 (2018) (same).

It seems notable that none of these recent petitions, including NST's, appear to have adequately grappled with the more complicated and underlying issue of who has standing to bring such a challenge to an appellate court rule, and in what posture. NST has not attempted to show how it would have standing to challenge Federal Circuit Rule 36, nor did NST challenge the rule before the Federal Circuit used that rule to affirm.

As a threshold matter, NST has failed to show how it has suffered a "personal" injury where any error on its appeal would have been harmless in view of, at least, NST's waiver of issues as well as because any litigant before the Federal Circuit that receives such a ruling would be considered to have received an equivalent injury. *See Warth v. Seldin*, 422 U.S. 490, 499 (1975) ("[T]he Court has held that when the asserted harm is a 'generalized grievance' shared in substantially equal measure by all or a large class of citizens, that harm alone normally does not warrant exercise of jurisdiction."), citing, *e.g.*, *Schlesinger v. Reservists Comm. to Stop the War*, 418 U.S. 208, 222 (1974); *United States v. Richardson*, 418 U.S. 166, 188-197 (1974).

It would also appear that NST has the wrong party on the other side of the dispute if it wants to address the issue of standing. As a cross-appellant at the Federal Circuit, SIG SAUER was "damaged" by that Court's Rule 36 summary affirmance at least to the same extent as NST, since a decision in NST's favor on the matter should also result in the Federal Circuit issuing a written opinion with respect to SIG SAUER's cross-appeal.

In addition, SIG SAUER did not cause the harm complained of and cannot provide the relief NST wants;

namely, to strike down an Appellate Court Rule. *Cf. California*, 141 S. Ct. at 2108 (“Plaintiffs do not have standing to challenge § 5000A(a)’s minimum essential coverage provision because they have not shown a past or future injury fairly traceable to defendants’ conduct enforcing the specific statutory provision they attack as unconstitutional.”); *see also Clinton v. City of New York*, 524 U.S. 417, 432-433 (1998) (plaintiffs have standing once it is determined they are harmed by defendant and harm will likely be redressed by favorable decision); *cf. America West Airlines, Inc. v. National Mediation Bd.*, 119 F.3d 772, 777 (9th Cir. 1997) (appellant did not have standing where asserted injury was not traceable to defendant’s conduct).

## CONCLUSION

For the above stated reasons, NST’s Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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