

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

POPSOCKETS LLC,
Petitioner,

v.

FLYGRIP, INC.,
Patent Owner.

IPR2022-00937
Patent 10,800,024 B2

Before HYUN J. JUNG, BARRY L. GROSSMAN, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that PopSockets LLC (“Petitioner”) has shown by a preponderance of the evidence that claims 2 and 8 of U.S. Patent No. 10,800,024 B2 (Ex. 1001, “the ’024 patent”) are unpatentable.

A. Background and Summary

Petitioner filed a Petition (Paper 2, “Pet.”) requesting institution of an *inter partes* review of claims 2 and 8 of the ’024 patent. Flygrip, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7). Pursuant to 35 U.S.C. § 314, we instituted an *inter partes* review of the ’024 patent. Paper 8 (“Inst. Dec.”). In particular, we instituted review of claims 2 and 8 on all presented challenges. Inst. Dec. 2, 38, 39.

After institution, Patent Owner filed a Response (Paper 12, “PO Resp.”), to which Petitioner filed a Reply (Paper 16, “Pet. Reply”), and Patent Owner thereafter filed a Sur-reply (Paper 17, “PO Sur-reply”). Petitioner also filed a Motion to Strike Exhibits 2027–2035 and portions of Patent Owner’s Sur-reply (Paper 20), and Patent Owner filed an opposition to Petitioner’s motion (Paper 21).

Patent Owner further filed a Motion to Exclude Evidence (Paper 23), and Petitioner filed an Opposition to Patent Owner’s Motion to Exclude (Paper 24), to which Patent Owner filed a Reply in Support of its Motion (Paper 25). An oral hearing in this proceeding was held on August 3, 2023; a transcript of the hearing is included in the record. Paper 28 (“Tr.”).

B. Real Parties in Interest

Petitioner identifies PopSockets LLC, Otter Products LLC, and Amazon.com, Inc. as real parties in interest. Pet. 79. Patent Owner only identifies itself as a real party in interest. Paper 5, 2.

C. Related Matters

The parties identify *Otter Products LLC. v. Flygrip, Inc.*, 1:21-cv-03298 (D. Colo.), *PopSockets LLC. v. Flygrip, Inc.*, 1:21-cv-02900 (D. Colo.), *Flygrip, Inc. v. Walmart, Inc.*, 6:21-cv-01082 (W.D. Tex.), *Flygrip, Inc. v. Amazon.com, Inc.*, 6:21-cv-01081 (W.D. Tex.), and *Flygrip, Inc. v. Five Below, Inc.*, 6:21-cv-01080 (W.D. Tex.) as related matters. Pet. 79; Paper 5, 2.

The same claims of the '024 patent are also challenged in IPR2022-00938 (“the related proceeding”). See Pet. 1; Paper 3.

D. The '024 Patent (Ex. 1001)

The '024 patent issued on October 13, 2020, from an application filed on July 10, 2019, that is a continuation of an application filed on June 21, 2011, that, in turn, is a continuation-in-part of an application filed on October 26, 2010. Ex. 1001, codes (22), (45), (63), 1:6–11. That application was published as U.S. Patent Application Publication No. 2012/0042476 A1 on February 23, 2012. Ex. 1003 (“’476 Publication”). The '024 patent also claims priority to a provisional application filed on August 19, 2010 (Ex. 1010, “Provisional Application”). Ex. 1001, code (60), 1:11–13.

The '024 patent particularly “relates to a movable grip for holding handheld devices.” Ex. 1001, 1:19–22. The '024 patent “provides a finger grip apparatus for a handheld device” that “allows a user to securely hold a

handheld device with a single hand” and “with an increased range of motion compared with gripping the handheld device directly.” *Id.* at 2:13–19.

According to the “Summary of the Invention,” “[t]he apparatus includes a base for affixing the apparatus to a first surface of the handheld device; at least one extension extending from the base at a first end of the extension; and a grip extending from the at least one extension at a second end of the extension.” Ex. 1001, 2:20–26. In one embodiment, the grip moves “substantially perpendicular” to the base. *Id.* at 2:63–67, 6:3–41, Figs. 18, 19, 20a–c. Figure 20a of the ’024 patent is reproduced below.

FIG. 20a

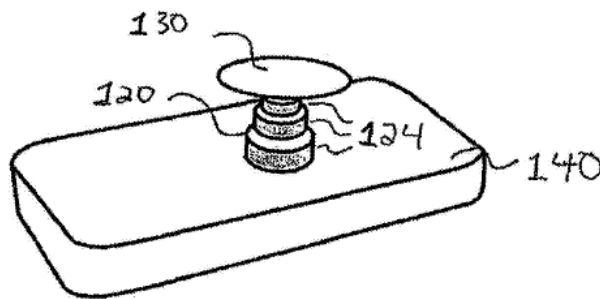


Figure 20a shows an embodiment of a grip device “where a grip of the grip device moves away from a base of the grip device in a path substantially perpendicular to the base” in the extended or open position. *Id.* at 2:63–3:3, 6:3–7.

The grip device includes base 110 (shown, e.g., in Figure 20b) to fasten the grip device to handheld device 140, extension 120, and grip 130. Ex. 1001, 4:32–47. “[E]xtension 120 may be formed such that it expands/collapses the grip device from the open position to the closed

position, such that the grip 130 moves directly towards the base 110 without rotating.” *Id.* at 6:8–11.

A spring or some other mechanism can be used to open and close the grip device. Ex. 1001, 6:11–13, 6:29–32, Fig. 18. The spring or other mechanism may be positioned between base 110 and grip 130 to hold the grip device opened or closed. *Id.* at 6:13–16, Fig. 19. If the spring or other mechanism holds the grip device open, then a latch or some other locking mechanism may be used to hold the grip device closed. *Id.* at 6:17–19. If the spring or other mechanism holds the grip device closed, then a locking device or user’s finger can be used to keep the grip device opened. *Id.* at 6:20–28.

“[E]xtension 120 may be constructed as a single piece or a series of telescopic pieces 124 that expand/collapse together as the grip device moves from the open to the closed position” by way of, for example, a spring. Ex. 1001, 6:35–41, Figs. 20a–c.

E. Challenged Claims

The ’024 patent includes claims 1–8, of which Petitioner challenges claims 2 and 8. The challenged claims are reproduced below with changes from a Certificate of Correction (Ex. 1001, 38–40).¹

2. A collapsing and expanding one hand gripping apparatus fastened to or built into the back of a handheld device or its case consisting essentially of,
 - a one hand gripping apparatus fastened to or built into the back of a handheld device
 - wherein a base is fastened to or built into, the back of the handheld device or its case

¹ Patent Owner’s counsel verified that the claim language shown in Petitioner’s claim listing correctly reflects the language of claims 2 and 8 as revised by the Certificate of Correction. Tr. 43:12–22.

wherein an extension extends perpendicular from the base consisting essentially of a single piece conical telescoping flexible tubular structure, consisting essentially of a plurality of graduated sections, more flexible between the sections, that flex and/or fold over and into one another, wherein the extension is moveable between a collapsed, closed position and an extended, open position,

on the opposite end of the extension from the base is a grip, wherein the grip is disc-shaped and mounted perpendicular to the end of the extension and has an outer perimeter that is not in contact with the extension when the one hand gripping apparatus is in an extended or retracted position, wherein the grip is attached to the extension, wherein the grip extends radially past the extension, and

wherein the one hand gripping apparatus in the collapsed position lies flat to the handheld device.

Ex. 1001, 9:6–28.

8. A method of using a collapsing and expanding one hand gripping apparatus and fastening the one hand gripping apparatus to the handheld device or handheld device's case, the method comprising the steps of:

obtaining a collapsing and expanding one hand gripping apparatus as recited in claim 2,

fastening or building the one hand gripping apparatus to the back of a handheld device or back of the handheld device's case in an expanded position perpendicular to the handheld device,

receiving two adjacent non-thumb fingers of a gripping hand inserted between the handheld device and the other end of the one hand gripping apparatus, each received finger straddling the sides of the one hand gripping apparatus, wherein a fingerprint side of the received fingers face the handheld device and are in contact with the one hand gripping apparatus and/or the back of the handheld device or the case of handheld device's case,

wherein a gripping hand's thumb and portion of palm wrap around to the front of the handheld device

wherein a step of a one hand gripping apparatus collapsing is removing the fingers of the gripping hand from the one hand

gripping apparatus such that the apparatus lies flat to the handheld device.

Id. at 10:19–40.

F. Asserted Prior Art and Proffered Testimonial Evidence

Petitioner identifies the following references as prior art in the asserted grounds of unpatentability:

Name	Reference	Exhibit
Hobbs	US 10,215,329, filed Feb. 27, 2018, issued Feb. 26, 2019	1021
Srouer	US 10,724,280, filed Mar. 15, 2019, issued July 28, 2020	1020
'476 Publication	US 2012/0042476 A1, published Feb. 23, 2012	1003
Provisional Application	Appl. 61/375,096, filed Aug. 19, 2010	1010

Pet. 10. Petitioner argues that the '476 Publication and the Provisional Application are prior art under § 102(a)(1), that Srouer is prior art under § 102(a)(2), and that Hobbs is prior art under §§ 102(a)(1) and 102(a)(2). *Id.*; *see also id.* at 17–41 (arguing that the Provisional Application and the parent applications, one of which was published as the '476 Publication, do not provide adequate written description support for all the limitations of claims 2 and 8, and so claims 2 and 8 are not entitled to claim priority earlier than July 10, 2019, the filing date of the '024 patent).

Petitioner also provides a Declaration of Dr. Kimberly Cameron (Ex. 1025) and a Supplemental Declaration of Dr. Kimberly Cameron (Ex. 1027). Patent Owner provides a Declaration of Nathan J. MacDonald. Ex. 2013. A deposition transcript for Mr. MacDonald (Ex. 1028) was filed.

G. Asserted Grounds

Petitioner asserts that claims 2 and 8 are unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
2, 8	103	'476 Publication, Srouer
2, 8	103	'476 Publication, Srouer, Provisional Application
2, 8	103	'476 Publication, Hobbs

Pet. 11.

II. ANALYSIS

A. Petitioner's Motion to Strike

Petitioner moves to strike Exhibits 2027–2035 because they were filed with Patent Owner's Sur-reply and do not correspond to a deposition transcript of Petitioner's declarant, in violation of our Rule 42.23(b) and Consolidated Trial Practice Guide² that states "[t]he sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." Paper 20. Petitioner, as the "moving party," "has the burden of proof to establish that it is entitled to the requested relief." 37 C.F.R. § 42.20(c).

Patent Owner responds that these exhibits "were actually or substantively previously of record." Paper 21, 1. Petitioner did not file a reply.

Exhibits 2027 and 2028 are the grandparent and parent applications, and Exhibit 2029 is the application that issued as the '024 patent. Exhibits 2030–2032 are Application Data Sheets for these applications, and Exhibits 2033–2035 are the publications of these same applications.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

We agree with Petitioner that Patent Owner may not submit new evidence with its Sur-reply, “other than deposition transcripts of the cross-examination of any reply witness,” but Petitioner does not explain adequately why these exhibits constitute “new evidence” to Petitioner, when they are, or should have been, the bases of its analysis regarding the asserted priority date of the challenged claims. *See* Pet. 17–41 (analyzing the asserted priority documents, the chain of priority to the Provisional Application, and the prosecution history of the ’024 patent). Some of the exhibits, such as Exhibits 2027 and 2028 (the as-filed grandparent and parent applications), should have already been included in the record.

Patent Owner also violates our Rule 42.6(d), which states that “[a] document already in the record of the proceeding must not be filed again, not even as an exhibit or an appendix, without express Board authorization.” If we granted Petitioner’s motion, then Patent Owner’s citations to some documents already of record, and filed by Petitioner, would become meaningless and would deprive us of the ability to analyze documents already properly filed in view of the parties’ arguments.

For the reasons above and on the facts of this proceeding, Petitioner does not satisfy its “burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c). We, therefore, deny Petitioner’s Motion to Strike.

B. Patent Owner’s Motion to Exclude Evidence

Patent Owner moves to exclude Exhibits 1004–1008 and 1012–1019 because they are unauthenticated, inaccessible to the interested public, and inadmissible as hearsay. Paper 23, 1. Patent Owner indicates that objections to these exhibits were previously filed. *Id.*; *see also* Paper 25 (citing Paper

10). Patent Owner, as the “moving party,” “has the burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c).

The exhibits include dictionary definitions of “flexible” (Exs. 1004–1008), a dictionary definition and descriptions of “spring,” (Exs. 1012–1014), dictionary definitions of “tubular” (Ex. 1015–1017), and dictionary definitions of “sliding” (Exs. 1018, 1019).

Petitioner responds that Patent Owner does not provide any arguments explaining why these exhibits are unauthenticated, inaccessible to the general public, or inadmissible as hearsay. Paper 24, 1. Petitioner argues that there is no supporting argument or facts for authenticity to be questioned and the exhibits’ authenticity can be easily confirmed. *Id.* at 2–3. Petitioner also argues that public availability applies to prior art publications and not evidence regarding the background in the art and knowledge of one of ordinary skill in the art, such as the meaning of claim terms. *Id.* at 4–5. Petitioner further argues that the exhibits and their copyright dates are not being offered for the truth of the matter asserted. *Id.* at 6. Petitioner additionally argues that the exhibits are direct evidence of the background knowledge in the art and the understanding that one of ordinary skill in the art would have as to meanings of particular claim terms. *Id.* at 6–7.

Patent Owner replies that there is no evidence to show that the exhibits would have been available to ordinarily skilled artisans, to describe when and where the exhibits were published, and to verify the exhibits are true and correct copies. Paper 25, 1. Patent Owner also argues that there is no evidence that the exhibits were available publicly, and that the copyright date is insufficient to establish availability. *Id.* at 2–3.

Patent Owner does not identify sufficiently why Exhibits 1004–1008 and 1012–1019 are not authentic. Paper 23, 1–2. Patent Owner also does

not argue sufficiently why these exhibits must be shown to be accessible to the interested public. Paper 23, 2–4. None of these exhibits are asserted to be a prior art publication or part of Petitioner’s grounds for challenging the claims. *See* Pet. 9–11.

Moreover, Petitioner’s declarant considered Exhibits 1004–1008 and 1012–1019, along with others, for the declaration filed with the Petition. Ex. 1025 ¶ 5. These exhibits show the basis for the testimony in the declaration, and an expert may rely on hearsay in forming an opinion under Federal Rules of Evidence 703. To the extent they are hearsay, we would limit their purpose to showing the basis for testimony.

Also, dictionary definitions are routinely considered extrinsic evidence that may shed light on the plain and ordinary meaning of a claim term. *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (en banc) (“Within the class of extrinsic evidence, the court has observed that dictionaries . . . can be useful in claim construction.”) (citation omitted). For the reasons explained by Petitioner (Paper 24, 6), the definitions were not offered for the truth of the matter asserted, and, thus, we do not consider these exhibits hearsay.

For the reasons above, Patent Owner does not satisfy its “burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c). We also do not rely on any of Exhibits 1004–1008 and 1012–1019 to reach our determination. In view of the above, Patent Owner’s Motion to Exclude Exhibits 1004–1008 and 1012–1019 is denied.

C. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent [claim] it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed.

Cir. 2016). This burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail in an *inter partes* review, the petitioner must support its challenges by a preponderance of the evidence. 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2021).

Petitioner contends that the challenged claims of the '024 patent are unpatentable under § 103. Pet. 11, 41–79. A claim is unpatentable under § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). When evaluating a combination of teachings, we must also “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

D. Level of Ordinary Skill in the Art

Petitioner asserts that one of ordinary skill in the art “would have had either (1) five years or more of experience in mechanical product design, or (2) a bachelor’s degree in Mechanical Engineering and one year or more of experience in mechanical product design.” Pet. 11 (citing Ex. 1025 ¶¶ 25–27). For the Institution Decision, we adopted Petitioner’s proposed level of ordinary skill in the art. Inst. Dec. 11.

Patent Owner responds that one of ordinary skill in the art “would have education and experience in mechanical design” and, for purposes of the Response, would have had a “bachelor’s degree in a technical field and at least 1 year of experience with product development, or a college degree in a non-technical field and at least 3 years of experience in product development.” PO Resp. 14 (citing Ex. 2013 ¶¶ 17–40). Patent Owner also contends that “[e]levated educational experience could take the place of a certain amount of experience, and vice-versa.” *Id.* (citing Ex. 2013 ¶¶ 17–40).

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation and internal quotation marks omitted).

Because Petitioner contends that one of ordinary skill in the art would have had “a bachelor’s degree in Mechanical Engineering and one year or more of experience in mechanical product design” (Pet. 11) and Patent Owner contends that one of ordinary skill in the art would have had a “bachelor’s degree in a technical field and at least 1 year of experience with product development” (PO Resp. 14), the parties substantially agree with respect to these aspects of their proposals for the level of ordinary skill.

Petitioner contends, in the alternative, that the ordinarily skilled artisan would have had “*five years or more* of experience in mechanical product design,” but Patent Owner alternatively contends that the ordinarily skilled artisan has “a college degree in a non-technical field and *at least 3 years* of experience in product development.” Pet. 11; PO Resp. 14

(emphases added). Petitioner’s alternate person of ordinary skill in the art requires more years of experience than Patent Owner’s alternate person of ordinary skill in the art. *See* Pet. 11; PO Resp. 14.

In view of the above, we see no reason to disturb our preliminary determination regarding the level of ordinary skill in the art. Thus, we maintain and reaffirm that one of ordinary skill in the art “would have had either (1) five years or more of experience in mechanical product design, or (2) a bachelor’s degree in Mechanical Engineering and one year or more of experience in mechanical product design.” Pet. 11 (citing Ex. 1025 ¶¶ 25–27). Based on the full record and for the reasons below, even if we adopted Patent Owner’s proposed level of ordinary skill, our determination would be the same.

E. Claim Construction

In an *inter partes* review, the claims are construed

using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.

37 C.F.R. § 42.100(b) (2021); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

1. “conical”

Petitioner does not propose an interpretation for “conical.” *See* Pet. 11–16. Patent Owner responds that one of ordinary skill in the art would have interpreted “conical” to have its plain and ordinary meaning, which is “that it pertains to the shape of a cone” with support from the record. PO Resp. 8–12. Petitioner replies that “[n]o issues in this

proceeding require construction of the term ‘conical.’” Pet. Reply 3. Patent Owner does not provide a response regarding the interpretation of “conical.” *See generally* PO Sur-reply.

We agree with Petitioner that, in this proceeding, “conical” does not require an express interpretation to resolve the parties’ disputes. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

In the related proceeding, we determined that one of ordinary skill in the art would understand that the term “conical” does not exclude cones with a pyramidal shape. *PopSockets LLC v. Flygrip, Inc.*, IPR2022-00938, Paper 29 at 19 (PTAB Oct. 30, 2023). To the extent any issue in this proceeding would implicate the interpretation of “conical,” we apply the same determination.

2. “telescoping”

“[F]or purposes of this Petition only,” Petitioner proposes interpreting “telescoping” to encompass “single-piece structures that extend and collapse” and “does not require separate pieces that slide/move over each other” with support from the Specification, the declaration, and Patent Owner’s apparent interpretation from related litigation. Pet. 14–16 (citing Ex. 1001, 5:15–17, 6:35–39, Fig. 20; Ex. 1009, 91, 102, 103; Ex. 1025 ¶¶ 35–38); *see also id.* at 17 n.7 (contending “under Patent Owner’s apparent interpretation of ‘telescoping,’ which does not require separate pieces that slide/move over each other”).

Patent Owner responds that “telescoping,” as used in the Specification, is consistent with its plain and ordinary meaning and argues

that “a telescoping arrangement generally consists of sections of material that slide or pass one another so as to extend or compress.” PO Resp. 3–5 (citing Ex. 2013 ¶¶ 71, 72). Patent Owner also argues that references cited during prosecution show example telescopic arrangements that “have sections of material that pass one another to extend or compress the arrangement.” *Id.* at 5–6 (citing Ex. 2013 ¶ 73).

Patent Owner further argues that the “telescoping action happens by allowing the material to flex and fold over itself” and other examples of telescopic arrangements include a conical spring or telescopic spring. PO Resp. 6–8 (citing Ex. 1010, 6; Ex. 1025, 35; Ex. 2013 ¶ 74). According to Patent Owner, one of ordinary skill in the art would have understood that “telescopic arrangements could be made in a wide variety of ways.” *Id.* at 8 (citing Ex. 2013 ¶ 75).

Petitioner replies that Patent Owner does not challenge its assertion that “telescoping” would include “single-piece structures that expand and collapse.” Pet. Reply 3 (citing Pet. 14–16; PO Resp. 3–8). Patent Owner does not respond regarding the interpretation of “telescoping.” *See generally* PO Sur-reply.

We do not need to interpret expressly “telescoping” to resolve the parties’ dispute because, as discussed below, Petitioner shows that claims 2 and 8 are not entitled to their asserted priority date and that the proposed combination of the ’476 Publication and Hobbs teaches or suggests “telescoping,” even under Patent Owner’s view that “a telescoping arrangement generally consists of sections of material that slide or pass one another so as to extend or compress,” “have sections of material that pass one another to extend or compress the arrangement” and allow “material to flex and fold over itself.” *Realtime Data*, 912 F.3d at 1375.

3. “flexible”

Petitioner proposes interpreting “flexible” to have its asserted plain and ordinary meaning of “capable of bending or being bent” with citations to the Specification, its declaration, and several dictionary definitions. Pet. 12–13 (citing Ex. 1001, 4:54–64; Ex. 1004; Ex. 1005; Ex. 1006; Ex. 1007; Ex. 1008; Ex. 1025 ¶¶ 28–33).

Patent Owner states that “[w]ithin the context of the challenged patent, [Petitioner’s proposed] definition is appropriate.” PO Resp. 12. Patent Owner also states that “[a]s used in the ’024 [patent] and consistent with the understanding of a [person of ordinary skill in the art], flexible describes a material that is capable of flexing that is, undergoing deformation without a permanent set” and “within the context of the ’024 [patent], ‘flexible’ has a more narrow scope than ‘bending.’” *Id.* at 12–13 (citing Ex. 1001, 4:54–64, 7:19–23; Ex. 2013 ¶ 81).

Patent Owner argues that “plain and ordinary meaning of ‘bending’ incorporates nonpermanent deformations as well as permanent deformations.” PO Resp. 13–14 (citing Ex. 2013 ¶ 82). According to Patent Owner, “[w]ithin the context of the ’024 [patent], flexible is not consistent with bending so as to create permanent deformation” and “a more appropriate construction for ‘flexible’ would be, ‘capable of bending repeatedly’ which is consistent with the plain and ordinary meaning of the word.” *Id.* at 14 (citing Ex. 2013 ¶ 83).

Petitioner replies that Patent Owner agrees with its interpretation but offers an alternative interpretation. Pet. Reply 3 (citing PO Resp. 12). According to Petitioner, “no issues in this proceeding require determining whether a ‘flexible’ device must be capable of bending repeatedly.” *Id.*

Patent Owner does not respond regarding the interpretation of “flexible.”
See generally PO Sur-reply.

Based on the full record, we determine that “flexible” does not require express interpretation to resolve the parties’ dispute. *Realtime Data*, 912 F.3d at 1375.

4. *Other Terms*

Based on the full record, we determine that no other terms require express interpretation. *Realtime Data*, 912 F.3d at 1375.

F. *Priority Date*

For a claim in a later-filed application to be entitled to the filing date of an earlier application, the earlier application must provide written description support for the claimed subject matter. *Anascape, Ltd. v. Nintendo of Am. Inc.*, 601 F.3d 1333, 1337 (Fed. Cir. 2010). The written description inquiry is a question of fact, context-specific, and determined on a case-by-case basis. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

The test for sufficiency of support is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). “One shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). In some instances, a patentee can rely on information that is well known in the art to satisfy the written description requirement. *Ariad Pharm.*, 598 F.3d at 1351 (“[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant

technology.”). Also, “drawings alone *may* be sufficient to provide the ‘written description of the invention’ required by § 112, first paragraph.” *Vas-Cath Inc.*, 935 F.2d at 1564. Still, “the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Ariad Pharms.*, 598 F.3d at 1351.

Based on what Petitioner asserts the Provisional Application and parent applications describe, Petitioner argues that these alleged priority documents do not show possession of the extension of claim 2. Pet. 25–26. In Petitioner’s view, “written description support must show the inventor was in possession of an extension that is movable between a collapsed, closed position and an extended, open position” and that the extension “(1) is made of a single-piece conical telescoping flexible tubular structure” and “(2) includes a plurality of graduated sections that (2a) are more flexible between the sections, and (2b) flex and/or fold over and into one another.” *Id.*

Petitioner argues that claims 2 and 8 are not entitled to claim priority to the Provisional Application and the parent applications, because the limitation “an extension . . . essentially of a single piece conical telescoping flexible tubular structure, consisting essentially of a plurality of graduated sections, more flexible between the sections, that flex and/or fold over and into one another” finds no support in any of the priority documents. Pet. 2, 5, 17. According to Petitioner, claims 2 and 8 are only entitled to the filing date of the application that issued as the ’024 patent and, thus, the

publications of the parent applications of the '024 patent would qualify as prior art to the challenged claims. *Id.* at 5, 17.

1. Provisional Application

Petitioner provides its understanding of what the Provisional Application discloses, and notes that it refers to a “stem,” but not an “extension.” Pet. 20–22 (citing Ex. 1010, 4–7; Ex. 1025 ¶¶ 41–44, 46). Petitioner argues that, even if one of ordinary skill in the art understood “stem” relates to the claimed “extension,” the Provisional Application fails to support the extension recited by claim 2. *Id.* at 20.

a) “an extension . . . essentially of a single piece conical telescoping flexible tubular structure”

Petitioner argues that none of the priority documents discloses an extension of “single piece conical telescoping flexible tubular structure.” Pet. 26. Petitioner also argues that the recited extension “is squarely outside of the scope of each of the disclosed ‘extension’ embodiments of the '024 patent.” *Id.* at 26–27. According to Petitioner, the only conical structure is made of “telescoping pieces 124,” not a single piece, and other single-piece embodiments are neither conical nor telescopic. *Id.* at 27–28 (citing Ex. 1010, 5; Ex. 1011, Figs. 1–12, 20, 21).

Petitioner contends that the Provisional Application would be understood to disclose a tubular spring, because the spring is helical. Pet. 29 (citing Ex. 1025 ¶¶ 57–59). Petitioner points out that claim 4 of the '024 patent depends from claim 2 and recites that “the extension has a spring force for pushing within the extension.” *Id.* Because of claim 4’s recitation, Petitioner argues that the extension of claim 2 must be broader than a spring under the doctrine of claim differentiation. *Id.* (citing Ex. 1025 ¶ 57).

In Petitioner’s view, because the alleged priority documents disclose single-piece extensions that are not conical and telescoping and separately describe conical, telescoping pieces 124 and helical springs, they cannot provide written description support for an extension “that is ***both*** a ‘single piece’ ***and*** a ‘conical telescoping flexible tubular structure.’” Pet. 29–30 (citing Ex. 1025 ¶ 60) (alterations in original).

b) *“an extension . . . consisting essentially of a plurality of graduated sections, more flexible between the sections”*

Turning to “a plurality of graduated sections, more flexible between the sections,” Petitioner contends that the term “graduated sections” is not in any alleged priority document. Pet. 30. Petitioner also contends that, even if telescoping pieces 124 were graduated sections, no disclosure supports the limitation “more flexible between the sections.” *Id.* at 30–31 (citing Ex. 1025 ¶¶ 61–63). Petitioner further contends that the embodiment with a spring extension does not support the “graduated sections” limitation because it is not made of graduated sections, has uniform flexibility along its length, is not more flexible in some places, and the extension of claim 2 is broader than a spring because of claim 4’s further limitations. *Id.* at 31 (citing Ex. 1025 ¶¶ 64–65).

c) *“a plurality of graduated sections . . . that flex and/or fold over and into one another”*

For “a plurality of graduated sections . . . that flex and/or fold over and into one another,” Petitioner argues that there is no support because telescoping pieces 124 slide over each other, not “flex and/or fold over and into one another.” Pet. 32 (citing Ex. 1011, 6:10–13; Ex. 1025 ¶¶ 67–70). Petitioner also argues that the two approaches would be understood to be different and distinct. *Id.* at 32–33 (citing Ex. 1001, claims 1, 2; Ex. 1025

¶¶ 68–69). Petitioner further argues that telescoping pieces 124 do not show that the inventor possessed an embodiment with “graduated sections . . . that flex and/or fold over and into one another.” *Id.* at 33. Petitioner additionally refers to a previous Board decision that found no explanation why the telescoping structure of the ’476 Publication would be considered an accordion. *Id.* at 33–34 (citing Ex. 1024, 76–77).

d) Patent Owner’s Response

Patent Owner responds that one of ordinary skill in the art would have read the ’024 patent along with the Provisional Application. PO Resp. 34 (citing Ex. 2013 ¶ 97). Patent Owner argues that the Provisional Application “includes a brief description of a new and novel apparatus that would allow a user to hold a ‘hand-held device HDD’ such as a ‘cell phone, pda, smart phone, tablet, . . . ’ while providing for a ‘greater range of motion’ for the user[’]s thumb ‘to operate the front of the HDD.’” *Id.* at 34–35 (citing Ex. 1010, 4; Ex. 2013 ¶ 97).

Patent Owner also argues that the Provisional Application “includes a series of drawings which depict a novel arrangement in several embodiments which are attached to a handheld device” that “generally fall into the ‘flip method,’ the ‘button method,’ and the ‘fixed position method.’” PO Resp. 35 (citing Ex. 1010, 5–7; Ex. 2013 ¶ 98). According to Patent Owner, “the flip method is depicted being mounted to a handheld device and is capable of toggling between a stowed position and a deployed position.” *Id.* at 36 (citing Ex. 2013 ¶ 99). Patent Owner also states that “[i]n the stowed position the flip method device is sleek and compact allowing for storage of the handheld device, for instance, in a pocket or the like,” and “[i]n the deployed position the user may straddle the flip bar between their fingers.” *Id.* at 36–37 (citing Ex. 1010, 9; Ex. 2013 ¶ 99). Patent Owner further notes

that “[t]he flip method sketches include an example that matches what Flygrip sells today.” *Id.* at 37 (citing Ex. 2013 ¶ 99).

Patent Owner argues that “[t]he button method was illustrated with a sketch showing how it could be constructed.” PO Resp. 37–38 (citing Ex. 2013 ¶ 100). Patent Owner also compares the button method of the Provisional Application to concept drawings of a PopSockets design. *Id.* at 38–39 (citing Ex. 2013 ¶ 101). Patent Owner argues that the Provisional Application and the PopSockets concept drawings show “the same thing.” *Id.* at 40 (citing Ex. 2013 ¶ 102). According to Patent Owner, the PopSockets concept drawing would be recognized as related to the PopSockets physical embodiment, and similarly, one of ordinary skill in the art would have recognized that the Provisional Application depicts a “compliant telescoping arrangement.” *Id.* (citing Ex. 2013 ¶ 102).

Patent Owner further compares the button method of the Provisional Application to Petitioner’s proposed combinations of references in the related proceeding and argues that the proposed combinations “bear a striking resemblance” to what the Provisional Application and the ’024 patent disclose. PO Resp. 40–41 (citing Ex. 1001, Fig. 20b; Ex. 1010, 6; Ex. 1032, 32; Ex. 2013 ¶ 103). Patent Owner also argues that the proposed combinations “do not show a conical arrangement” and, instead, show a “rectangular” embodiment. *Id.* at 41–43 (citing Ex. 2013 ¶¶ 104, 105).

Patent Owner argues that one of ordinary skill in the art would have understood that the Applicant was in possession of the claimed invention at the time the Provisional Application was filed and, thus, the references asserted in Petitioner’s obviousness combinations do not predate the filing of the Provisional Application. PO Resp. 64–65. Patent Owner addresses whether one of ordinary skill in the art reading the Provisional Application

would combine the listed structures for the stem. *Id.* at 65–66 (citing Inst. Dec. 22–23; Ex. 2013 ¶ 117). According to Patent Owner, “there is no description of a stem that is both a rubber/silicone material tube AND a helical spring at the same time” and that one of ordinary skill in the art “would understand that rubber springs are not designed in that manner.” *Id.* at 66–67 (citing Ex. 2013 ¶ 119). Patent Owner argues that “[m]ore typically, rubber springs are designed to take advantage of the bulk elasticity of the material itself” and contends that a Timbren spring is an example of such a rubber spring. *Id.* at 67 (citing Ex. 2013 ¶ 119).

Patent Owner also argues that one of ordinary skill in the art “would understand that a stem being composed of a ‘rubber/silicon [sic] material tube or spring[’] would include a stem made of rubber or silicone material that is in the shape of a tube or a rubber/silicone spring” and “wouldn’t understand the disclosure of the provisional application to mean either a conically shaped rubber tube or a helical spring.” PO Resp. 67–68 (citing Ex. 2013 ¶ 120).

Patent Owner argues that the Provisional Application “states that the stem can be produced out of ‘rubber/silicon material tube or spring’ and also that it can be a ‘spring (conical) to allow for deep compression (can be plastic or metal),” and that one of ordinary skill in the art “would have understood this to mean a telescoping rubber/silicone tubular material.” PO Resp. 44 (citing Ex. 2013 ¶ 108).

Patent Owner provides three different conical arrangements that were “modeled and 3D printed” and argues that one of those “exhibits telescoping behavior as expected and is consistent with the disclosure of the provisional application as well as the disclosure of the ’024 [patent] and its parent patent

documents and applications.” PO Resp. 43–47 (citing Ex. 2013 ¶¶ 109, 110).

e) Petitioner’s Reply

Petitioner replies that Patent Owner’s clarification of the Provisional Application “highlights that there is no written description support for the extension in the challenged claims.” Pet. Reply 21 (citing PO Resp. 65–68). Petitioner also argues that Patent Owner seemingly agrees with the preliminary determination that the inventor was not in possession of a stem that combined characteristics of the listed structures. *Id.* at 22 (citing Inst. Dec. 22–23; PO Resp. 65).

Petitioner further argues that Patent Owner’s example of a rubber spring does not support Patent Owner’s contention that the listed structures for the stem can be combined and Patent Owner does not explain how the Timbren spring relates to extensions for handheld devices or how it would suggest that the listed structures can be combined. Pet. Reply 22 (citing PO Resp. 67–68; Ex. 1027 ¶¶ 20–22; Ex. 1032). Petitioner additionally argues that the ’024 patent makes no reference to rubber springs and, instead, states that “the grip can be ‘constructed of various materials including hard and flexible materials, such as various metals, plastics, or textiles,’ dropping any and all reference to rubber or silicone.” *Id.* (citing Ex. 1001, 4:55–56). Petitioner also argues that “Figure 18 shows a non-conical spring” but “[i]t does not look like a Timbren rubber spring at all.” *Id.* at 22–23 (citing Ex. 1027 ¶ 23).

Regarding the PopSockets concept sketches, Petitioner replies that they are irrelevant. Pet. Reply 11. Petitioner also argues that they also provide evidence against one of ordinary skill in the art interpreting the

Provisional Application as showing the claimed telescoping mechanism. *Id.* at 11–12 (citing PO Resp. 39 n.70; Ex. 1025 ¶¶ 52–70).

Regarding the proposed obviousness combinations from the related proceeding, Petitioner replies that a proposed combination from last year does not rebut evidence that one of ordinary skill in the art would not have understood the inventor to have possession based on the Provisional Application’s figure from 2010. Pet. Reply 12 (citing PO Resp. 40–41; Ex. 1027 ¶¶ 11–12). Petitioner also argues that the arguments about Grinfas’s rectangular extension should have been presented in the related proceeding, and the same argument undermines Patent Owner’s analogy of the Provisional Application’s figure and the proposed combination. *Id.* (citing PO Resp. 40–43). Petitioner further argues that “it is irrelevant how similar the Provisional Application/’024 Patent’s figures are to a figure created for use in an IPR Petition twelve years after the purported priority date.” *Id.* at 12.

As for the 3D printed test models, Petitioner replies that Patent Owner does not establish that one of ordinary skill in the art would have viewed the Provisional Application’s depiction and assumed it depicted one of the three cones, which, as admitted by Patent Owner’s declarant, do not represent all possibilities. Pet. Reply 13–14 (citing PO Resp. 44–47; Ex. 1027 ¶¶ 13–14; Ex. 1028, 82:2–8). Petitioner also argues that Patent Owner never establishes that one of ordinary skill in the art “would have assumed that the image depicted in the Provisional Application must have used the exact structure of the 3D components” or the material used for those components. *Id.* at 14 (citing Ex. 1028, 84:14–20). Petitioner further argues that the origin of the cones’ design is unclear, that there is no indication that one of ordinary skill in the art would have thought of cone 2, and that the models

ignore the possibility that the Provisional Application shows a plastic or metal conical spring. *Id.* at 14–15 (citing Ex. 1010, 6; Ex. 1027 ¶¶ 14, 15; Ex. 1028, 98:24–101:1).

According to Petitioner, “[t]here is no basis to believe that the circumferential lines show possession of a specific structure comprised of graduated sections separated by thinner material that is more flexible between the sections, where the graduated sections flex/fold over when compressed, as recited in claim 2.” Pet. Reply 15 (citing Ex. 1027 ¶ 16). Petitioner also contends that “nowhere does the Provisional Application disclose graduated sections separated by thinner material which flex/fold over each other when compressed,” as shown by Patent Owner’s testing, because the same testing shows “conical rubber/silicone tubes” do not achieve deep compression. *Id.* at 15–16 (citing Ex. 2013 ¶¶ 108–110). Petitioner, thus, contends that one of ordinary skill in the art would have realized that the stem embodiments are not combinable. *Id.* at 16 (citing PO Resp. 44; Ex. 1027 ¶ 17).

Petitioner also replies that the Provisional Application shows alternative stem designs, not combinations of different designs, and that Patent Owner does not address directly the same preliminary determination. Pet. Reply 16–17 (citing Inst. Dec. 21–23; PO Resp. 67; Ex. 1027 ¶ 17; Ex. 1028, 93:7–94:1). Petitioner, thus, contends that the Provisional Application does not disclose any telescoping structure. *Id.* (citing PO Resp. 44). According to Petitioner, one of ordinary skill in the art would not have understood that a rubber/silicone tube could achieve deep compression or that deep compression refers to a collapsing, telescopic structure as opposed to a spring. *Id.* at 17–18 (citing Ex. 1027 ¶¶ 18, 19).

f) Patent Owner's Sur-reply

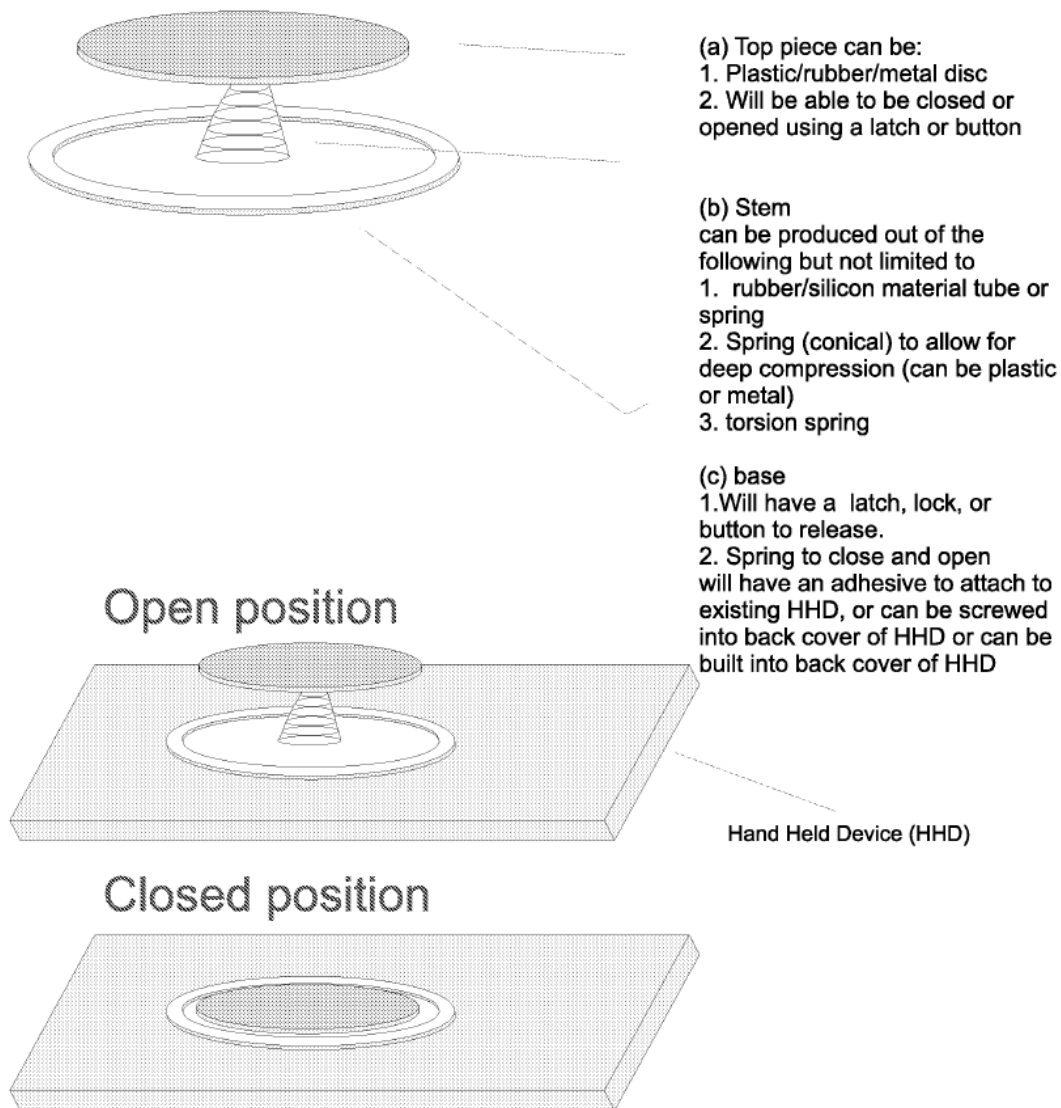
Patent Owner replies that Petitioner fails to rebut Patent Owner's testimonial evidence. PO Sur-reply 1–2 (citing Pet. 17–41; PO Resp. 50–52, 67–68; Pet. Reply 4–13). Patent Owner argues that the only rebuttal is conclusory testimony. *Id.* at 4 (citing Ex. 1027 ¶ 14).

Patent Owner also argues that “Petitioner does not and cannot rely on any testing of its own because it did not perform any, preferring instead to rely on conclusory statements and argument.” PO Sur-reply 2. Regarding its testing, Patent Owner argues that the Provisional Application states “rubber/silicon material tube or spring,” and its “Cone 2 design was ‘in concert with the other design aspects of what’s shown here, that is in accordance with what’s shown in the provisional application, that’s one of the things that make it behave in this telescoping fashion.’” *Id.* at 3–4 (citing Pet. Reply 14, 15; Ex. 1010, 6; Ex. 1028, 100:9–13, 101:10–15, 379:1–13, 380:7–9). Patent Owner further argues that it “proffered evidence that a [person of ordinary skill in the art] would understand the Provisional Application to disclose a ‘telescoping’ structure.” *Id.* at 5 (citing Ex. 1028, 81:16–18, 83:15–18, 98:14–22).

g) Petitioner Shows that the Provisional Application does not Provide Written Description Support for the Claimed “Extension”

A figure from the Provisional Application showing the “Button Method” is reproduced below.

Button Method



The figure, reproduced above, shows a “Button Method” with descriptions for the “Top piece,” “Stem,” and “base” and the same embodiment with a “Hand Held Device (HHD)” in an “Open position” and “Closed position.” Ex. 1010, 6.

As shown above, the figure states that the “[s]tem can be produced out of the following but not limited to 1. rubber/silicon material tube or spring[,]
2. [s]pring (conical) to allow for deep compression (can be plastic or metal[,]
and] 3. torsion spring.” Ex. 1010, 6. There is no express description of a

stem that is “essentially of a single piece conical telescoping flexible tubular structure,” “consisting essentially of a plurality of graduated sections, more flexible between the sections,” or “a plurality of graduated sections . . . that flex and/or fold over and into one another,” in this figure. *See id.*

Because the figure describes that the stem “can be produced” from different, and non-overlapping, materials (a “rubber/silicon material . . . spring” or a “plastic or metal” conical spring) and have different, and incompatible, configurations (tube, conical spring, or “torsion spring”), the figure does not indicate that the listed structures can be combined. Ex. 1010, 6. Patent Owner agrees. *See* PO Resp. 66–67 (stating that “there is no description of a stem that is both a rubber/silicone material tube AND a helical spring at the same time” and that one of ordinary skill in the art “would understand that rubber springs are not designed in that manner”); Ex. 2013 ¶ 119 (opining similarly).

Based on these findings, Petitioner persuades us that the Provisional Application does not convey to one of ordinary skill in the art that the inventor was in possession of a stem that combined characteristics of the listed structures or the recited “extension.” Pet. 29–30; Ex. 1025 ¶¶ 57–60.

The Provisional Application’s brief description and other figures of also lack a description of a stem that is “essentially of a single piece conical telescoping flexible tubular structure,” “consisting essentially of a plurality of graduated sections, more flexible between the sections,” or “a plurality of graduated sections . . . that flex and/or fold over and into one another.” *See id.* at 4, 5 (figure showing the “Flip method”), 7 (figure showing the “Fixed position Method”), 8 (“Sketches of Disc/Button Method”), 9 (“Sketches of Flip bar method”).

Patent Owner's responsive arguments based on comparisons to a PopSockets design do not address how the description and figures of the Provisional Application would convey that the inventor was in possession of a stem that provides support for the recited "extension" of claim 2. *See* PO Resp. 38–41; Ex. 2013 ¶¶ 101, 102. At best, the comparison confirms what is shown in the Provisional Application for the "Button Method," but does not address further how the "Button Method" provides written description support for the claimed "extension" of claims 2 and 8.

As for Patent Owner's responsive arguments based on comparisons to Petitioner's proposed combinations of references from the related proceeding, these arguments, as Petitioner argues, undermine that one of ordinary skill in the art would have understood that the Provisional Application provides support of the claimed extension, because Patent Owner contends that Grinfas does not show a conical arrangement. *See* PO Resp. 40–43; Pet. Reply 12.

Patent Owner's arguments based on 3D printed models presumes that the Provisional Application describes a cone with "a series of graduated sections which fold over each other and are more flexible between the sections." Ex. 2013 ¶ 109; *see also* PO Resp. 43–47; Ex. 2013 ¶ 110. As discussed above, Petitioner shows that the Provisional Application does not convey to one of ordinary skill in the art that the inventor was in possession of the claimed "extension" and one of ordinary skill in the art would not have combined the listed embodiments of the stem. *See* PO Resp. 66–67; Ex. 2013 ¶ 119. We further agree with Petitioner that Patent Owner insufficiently establishes how the Provisional Application leads to the modeled cones for the reasons stated in the Reply. *See* Pet. Reply 13–15.

For the reasons above, based on the full record, Petitioner persuades us that the Provisional Application does not convey to one of ordinary skill in the art that the inventor was in possession of “an extension . . . consisting essentially of a single piece conical telescoping flexible tubular structure, consisting essentially of a plurality of graduated sections, more flexible between the sections, that flex and/or fold over and into one another.”

2. *Parent Applications*

Regarding the parent applications that issued as U.S. Patent Nos. 8,844,098 (Ex. 1011) and 10,406,671, Petitioner argues that “all disclosures relating to the structure and function of the ‘extension’ are the same” and their figures depict embodiments disclosed in the Provisional Application. Pet. 22–23 (citing Ex. 1011, Figs. 11, 12, 18; Ex. 1025 ¶¶ 47–51); *see also id.* at 23 n.10 (citing only to the earliest issued patent “for brevity”); Ex. 1001, code (63). Petitioner also argues that the patents that issued from the parent applications describe extensions that move directly towards a base without rotating, may include a spring or “other mechanism,” such as “a slidable bar,” and “may be constructed as a single piece or a series of telescopic pieces.” *Id.* at 23–25 (citing Ex. 1011, 5:54–58, 6:4–13, 6:50–53, Fig. 20). Petitioner further argues that they describe without a figure that a spring “may be used in conjunction with a single piece sliding bar or the series of telescopic pieces.” *Id.* at 25 (citing Ex. 1011, 6:39–41).

a) *“an extension . . . essentially of a single piece conical telescoping flexible tubular structure”*

Petitioner argues that the patents that issued from the parent applications expressly contrast single-piece extensions with extensions having telescoping pieces 124. Pet. 28 (citing Ex. 1011, 4:55–57, 6:4–16, Figs. 18, 20; Ex. 1025 ¶ 56). Petitioner, thus, argues that the claimed

“extension” is “entirely outside the scope of the recited single-piece extension.” *Id.* at 27 (citing Ex. 1025 ¶¶ 54–55).

b) *“an extension . . . consisting essentially of a plurality of graduated sections, more flexible between the sections”*

Petitioner contends that the term “graduated sections” is not in any alleged priority document. Pet. 30. Petitioner also contends that, even if telescoping pieces 124 were graduated sections, no disclosure supports the limitation “more flexible between the sections.” *Id.* at 30–31 (citing Ex. 1025 ¶¶ 61–63). Petitioner further contends that the embodiment with a spring extension does not support the “graduated sections” limitation because it is not made of graduated sections, has uniform flexibility along its length, is not more flexible in some places, and the extension of claim 2 is broader than a spring because of claim 4’s further limitations. *Id.* at 31 (citing Ex. 1025 ¶¶ 64–65).

c) *“a plurality of graduated sections . . . that flex and/or fold over and into one another”*

For “a plurality of graduated sections . . . that flex and/or fold over and into one another,” Petitioner argues that there is no support because telescoping pieces 124 slide over each other, not “flex and/or fold over and into one another.” Pet. 32 (citing Ex. 1011, 6:10–13; Ex. 1025 ¶¶ 67–70). Petitioner also argues that the two approaches would be understood to be different and distinct. *Id.* at 32–33 (citing Ex. 1001, claims 1, 2; Ex. 1025 ¶¶ 68–69). Petitioner further argues that telescoping pieces 124 do not show that the inventor possessed an embodiment with “graduated sections . . . that flex and/or fold over and into one another.” *Id.* at 33. Petitioner additionally refers to a previous Board decision that found no explanation why the

telescoping structure of the '476 Publication would be considered an accordion. *Id.* at 33–34 (citing Ex. 1024, 76–77).

d) Prosecution History of the '024 Patent

Petitioner also argues that there was an attempt during prosecution of the application that issued as the '024 patent to add support for the extension of claim 2, but the Examiner determined the additions would be new matter. Pet. 3–4, 7–9, 17, 34–40 (citing Ex. 1002, 73–74, 127–171, 245–253). According to Petitioner, figures would have been added that show the extension of claim 2. *Id.* at 35–38 (citing Ex. 1002, 156–160). Petitioner also asserts that the “Applicant chose to cancel the new matter, rather than attempt to point the examiner’s attention to any alleged disclosure in the Priority Documents supporting the new drawings.” *Id.* at 40–41.

e) Patent Owner’s Response

Patent Owner responds that the '024 patent is entitled to claim priority, at least, to the filing date of its parent application, June 21, 2011, because the description regarding Figures 18–20 of the parent application is identical to description for Figures 18–20 of the grandparent application. PO Resp. 27 (citing Ex. 2013 ¶ 86). Patent Owner contends that the '024 patent “would have a priority date of October 26, 2010 for all disclosure first present in the non-provisional application” and for any new matter in a continuation-in-part application, “would be given the priority date of June 21, 2011.” *Id.* at 16–17 (citing Ex. 2013 ¶ 56); *see also id.* at 68 (arguing the priority date should be Oct. 26, 2010) (citing Ex. 2013 ¶ 114). According to Patent Owner, “the challenged content should be given *at least* a priority date of June 21, 2011 but since there is no new content disclosed regarding the challenged material, it should rightly be given the priority date of August 19, 2010.” *Id.* at 17 (citing Ex. 2013 ¶ 57).

Patent Owner argues that one of ordinary skill in the art would have read the same disclosure from the grandparent application, the parent application, and the '024 patent. PO Resp. 27–28 (citing Ex. 2013 ¶ 86). Patent Owner argues that the additional disclosure of the parent application making it a continuation-in-part application relates to Figures 27–34, which “describe features which allow the prop functionality to be implemented at a variety of angles.” *Id.* (citing Ex. 2013 ¶ 86).

Patent Owner describes that the Examiner found patentably distinct species, but according to Patent Owner, the identified species “were actually distinct non-obvious species.” PO Resp. 18–23 (citing Ex. 1032, 13–14; Ex. 2013 ¶¶ 63–65). Patent Owner contends that the Applicant needed to make an election with traverse. *Id.* at 23–24 (citing Ex. 2013 ¶ 65). Patent Owner also contends that the Examiner initiated an interview and the language of the claims were amended to overcome Grinfas. *Id.* at 24 (citing Ex. 1032, 14; Ex. 2013 ¶ 66).

Patent Owner further contends that the Examiner rejected amendments to the figures based on new matter, but the “alleged new matter provided a much clearer depiction of several proposed latching mechanisms which are mentioned in the specification of the '024 but are unartfully described.” PO Resp. 24–25; *see also id.* at 32 (arguing that Petitioner’s argument lack sufficient evidence) (citing Ex. 1025, 32; Ex. 2013 ¶ 94). According to Patent Owner, the Applicant submitted revised amended drawings for only Figures 20b and 20c and canceled other proposed amendments to the figures and Specification. *Id.* at 25–26 (citing Ex. 2013 ¶ 67). Patent Owner also contends that the revised amended figures were argued to contain no new matter and the Examiner agreed because new

Figures 20b and 20c were accepted. *Id.* at 26 (citing Ex. 2013 ¶ 68); *see also id.* at 28 (arguing the same) (citing Ex. 2013 ¶ 87).

Patent Owner also responds that Petitioner’s declarant agrees that the conically shaped telescoping structure is made of separate telescopic pieces and that Figure 20a shows graduated sections similar to Grinfas that flex and fold over each other. PO Resp. 28–29 (citing Ex. 1032, 50; Ex. 2013 ¶¶ 88, 89). Patent Owner argues that Grinfas and a reference cited in prosecution similarly use separate lead lines for telescoping pieces that are not physically separate bodies. *Id.* at 29–30 (citing Ex. 1025, 28–29; Ex. 2013 ¶¶ 90, 91). Patent Owner also argues that “movement of what is traditionally multiple pieces” can be “implemented with a single piece,” such as a common living hinge. *Id.* at 30–32 (citing Ex. 2013 ¶¶ 92, 93). Patent Owner further contends that one of ordinary skill in the art would have understood that “the telescopic pieces could be molded from a single piece of compliant material” and the grip can be adjusted to an “intermediate position.” *Id.* at 33–34 (citing Ex. 1030; Ex. 2013 ¶¶ 95, 96).

Patent Owner also responds that proposed obviousness combinations asserted in the related proceeding “are similar to what was already disclosed by the Flygrip patents and was before the examiner during the prosecution of the ’024 [patent].” PO Resp. 43 (citing Ex. 2013 ¶ 107).

Patent Owner also provides a chart of where the disclosures of the ’024 patent and its parent applications provide support for the elements of claims 2 and 8. PO Resp. 47–64.

Patent Owner further responds that paragraphs 37, 44, and 47 and Figure 20 of the grandparent application were cited as support for a single piece conical telescoping structure. PO Resp. 68–70 (citing Ex. 2013 ¶ 115), 70–71 (citing Ex. 1002, 150–151). Patent Owner contends that the cited

support was sufficient for written description because claim 2 was allowed to issue. *Id.* at 70 (citing Ex. 2013 ¶ 116).

f) Petitioner's Reply

Petitioner replies that “later-added claims are not entitled to any given priority date absent written description support from that date.” Pet.

Reply 4. Petitioner also replies that a reference cited during prosecution does not provide written description support, because support must come from the Specification. *Id.* at 5–6 (citing PO Resp. 17–18; Ex. 1030).

Petitioner further replies that later added figures cannot provide written description support because the figures were absent in the alleged priority documents, their acceptance by the Examiner does not imply a finding of written description support, and even if the record supported that the Examiner found written description support, the Examiner’s determination is not binding. Pet. Reply 6–7. Petitioner also argues that Patent Owner does not argue that paragraphs 44 or 47 support the figures or the challenged claims. *Id.* at 7 (citing PO Resp. 23–24; Ex. 1002, 150).

Petitioner also replies that the description of “telescopic pieces” is an express description that they are not a single-piece structure. Pet. Reply 7–8 (citing PO Resp. 28–29; Ex. 1027 ¶¶ 4–10; Ex. 1031). Petitioner contends that the use of separate lead lines also supports its testimonial evidence. *Id.* at 8 (citing PO Resp. 29–30; Ex. 1025 ¶ 54; Ex. 1027 ¶ 4). Petitioner also contends that manufacturing as a single piece does not relate clearly to written description support. *Id.* (citing PO Resp. 30–32; Ex. 1028, 183:19–184:3). According to Petitioner, if Patent Owner is making an obviousness argument, then such an argument cannot satisfy the written description support requirement. *Id.* at 8–9. Petitioner argues that, by arguing telescopic pieces could have been made as a single-piece structure, Patent

Owner “implicitly acknowledges that there is no express disclosure of a single-piece structure.” *Id.* at 9 (citing PO Resp. 34; Ex. 2013 ¶ 96).

Regarding figures rejected during prosecution, Petitioner replies that they cannot provide written description support. Pet. Reply 10 (citing PO Resp. 32; Ex. 1028, 338:13–21). Petitioner also argues that not all of the rejected figures showed a latch mechanism. *Id.* (citing Ex. 1002, 296–298, 303, 309–319). Petitioner further contrasts the mentioning of latch mechanism 150 with the lack of description for a single-piece, conical, telescoping, tubular structure. *Id.* (citing Ex. 1001, 5:52–6:2, Figs. 14–17).

Petitioner argues that the record is not clear as to why the Examiner accepted Figures 20b and 20c, but Petitioner supposes it was because these figures show what appear to be multiple telescoping pieces. Pet. Reply 10. In Petitioner’s view, the rejection of figures that clearly show single-piece telescoping pieces supports its supposition. *Id.* at 10–11 (citing Ex. 1027 ¶ 12).

Petitioner replies that disclosure for the claimed extension is not present in the parent applications and that “a lack of continuing support in any intervening application” would undermine Patent Owner’s priority claim. Pet. Reply 18. Petitioner argues that any relied-on disclosures from the Provisional Application, such as the “Button Method,” stem embodiments, and conical spring, are not in any of the parent applications. *Id.* at 19. Petitioner also argues that a “list of possible grip materials includes only ‘metals, plastics, or textiles’” and the only “spring” embodiment is shown in Figure 18. *Id.* at 19–20 (citing Ex. 1003 ¶ 33).

In Petitioner’s view, the parent applications focused on the “Flip Method” of the Provisional Application. Pet. Reply 20 (citing Ex. 1001, Figs. 2–17, 21–34). Petitioner argues that they also include an embodiment

based on the conical spring and a new, “telescoping pieces” embodiment. *Id.* (citing Ex. 1001, Figs. 18, 20).

Petitioner also argues that Patent Owner’s cited paragraphs from the grandparent application “do not, as a substantive matter, provide written description support for the challenged claims” and Patent Owner “must show continuing support for the claims in each application in the priority chain.” Pet. Reply 23 (citing Pet. 22–34). Petitioner further argues that “there is absolutely no indication in the record that the Examiner paid specific attention to challenged claim 2, as opposed to claim 1, which claims the ‘annular pieces’ embodiment actually shown in Figure 20a.” *Id.* at 24 (citing PO Resp. 70).

g) Patent Owner’s Sur-reply

Patent Owner replies that the grandparent application “expressly incorporates the Provisional Application in its entirety by reference” and so does the parent application. PO Sur-reply 5–6 (citing Ex. 1003, 2033; Ex. 2027, 1:5–8; Ex. 2028, 1:5–9; Ex. 2030; Ex. 2031; Ex. 2032; Ex. 2034). Patent Owner also replies that the parent application and the application that issued as the ’024 patent “share essentially the same disclosure.” *Id.* at 6 (citing Ex. 2013 ¶ 86; Ex. 2028; Ex. 2029; Ex. 2034; Ex. 2035). According to Patent Owner, essentially the same disclosure and specific reference to earlier-filed applications can provide continuity of disclosure and entitlement to an earlier priority date. *Id.* at 7 (citing Ex. 1001, 1:6–14, 38).

Patent Owner further replies that the Examiner reviewed and determined that the grandparent application had adequate written description. Pet. Reply 8 (citing PO Resp. 68–70; Ex. 2013 ¶ 115; Ex. 2018). According to Patent Owner, Petitioner does not dispute the adequate written description of paragraph 37 for the limitation “a plurality of

graduated sections, more flexible between the sections, that flex and/or fold over and into one another.” *Id.* at 8–9 (citing PO Resp. 68–70; Ex. 2013 ¶ 115). Patent Owner contends that it “has established an adequate chain of disclosure.” *Id.* at 9 (citing PO Resp. 68–71; Pet. Reply 23–24). Patent Owner also contends that there is adequate written description support in the grandparent application. *Id.* (citing Ex. 1003; Ex. 2013 ¶ 114).

h) Petitioner Shows that the Parent Applications do not Provide Written Description Support for the Claimed “Extension”

Petitioner points to portions of the patent that issued from the grandparent application that state “[a]lthough the extension 120 illustrated in FIGS. 7A, 7B, 7C, 8A, 8B, and 8C is a single piece, the extension 120 may include a spring and/or telescoping pieces,” and “extension 120 may be constructed as a single piece or a series of telescopic pieces 124.” Pet. 28; Ex. 1011, 4:55–57, 6:4–16. Petitioner also points us to Figures 18 and 20, reproduced below, of the same patent. Pet. 28.

FIG. 18

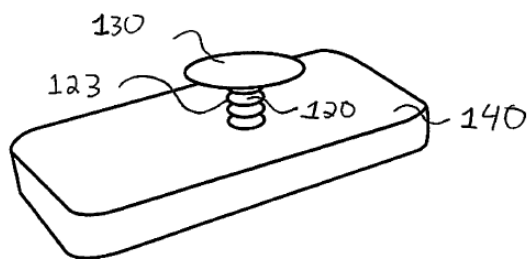
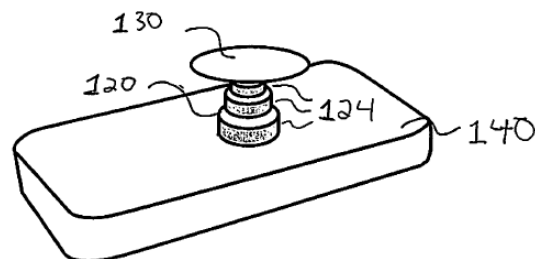


FIG. 20



Figures 18 and 20, reproduced above, show “a grip device according to other embodiments of the present invention, where a grip of the grip

device moves away from a base of the grip device in a path substantially perpendicular to the base.” Ex. 1011, 2:49–52.

These cited portions expressly contrast the “single piece” from “telescopic pieces.” Ex. 1011, 4:55–57, 6:4–16, Figs. 18, 20. We credit Petitioner’s testimonial evidence that “single piece” is contrasted with “telescopic pieces” because the record supports it. Ex. 1025 ¶ 56; Ex. 1011, 4:55–57, 6:4–16, Figs. 18, 20.

We agree with Petitioner, and find, that “graduated sections” is not used in any of the asserted priority documents. Pet. 30. As Petitioner argues, the “telescopic pieces” may have “graduated sections,” and, if so, we would find that there is no description of such sections being “more flexible between the sections.” *Id.* at 30–31; *see generally* Ex. 1011. We credit Petitioner’s testimonial evidence regarding “graduated sections, more flexible between the section” because the record supports it. Ex. 1025 ¶¶ 61–65.

Because there is no express description of “graduated sections,” Petitioner persuades us, and we find, that there is no express description of “a plurality of graduated sections . . . that flex and/or fold over and into one another.” Pet. 32. If the “telescopic pieces” were to have “graduated sections,” we would find that there is no express description of those sections being able to “flex and/or fold over and into each other.”

Even under Patent Owner’s understanding of the term “telescoping,” the asserted priority documents would convey that the “telescopic pieces” would be “a telescoping arrangement [that] generally consists of sections of material that slide or pass one another so as to extend or compress” and “pass one another to extend or compress the arrangement.” PO Resp. 3–8; Ex. 1010, 6; Ex. 1025, 35; Ex. 2013 ¶¶ 71, 72, 74.

Patent Owner's contention that "telescoping action happens by allowing the material to flex and fold over itself" uses, as examples, a conical spring or telescopic spring. PO Resp. 6–8. Petitioner points to a portion of the patent that issued from the grandparent application that states "a spring (e.g., such as the spring 123 of FIG. 18) may be used in conjunction with a single piece sliding bar or the series of telescopic pieces 124 in FIG. 20." Pet. 28; Ex. 1011, 6:13–16. This description makes clear that the telescopic pieces are not a "telescopic spring" that can "allow[] the material to flex and fold over itself," as argued by Patent Owner. *See* PO Resp. 6–8.

As argued by Petitioner, the prosecution history of the '024 patent also supports our determination that the priority documents lack written description support for the claimed "extension" because the proposed amendments that were rejected would have supported the extension. Pet. 3–4, 7–9, 17, 34–40; Pet. Reply 10; Ex. 1002, 73–74, 127–171, 245–253. Petitioner persuades us that not all of the rejected figures showed a latch mechanism, that Patent Owner contends was the reason for the new matter rejection. PO Resp. 24–26; Pet. Reply 10; Ex. 1002, 296–298, 303, 309–319.

In summary, based on our findings discussed above, Petitioner persuades us that the grandparent application (1) expressly contrasts single-piece extensions with extensions having telescoping pieces 124, (2) lacks any express description of "graduated sections," (3) lacks any description that the "telescopic pieces" embodiment are "more flexible between sections, (4) lacks any description that the "telescopic pieces" embodiment would flex and fold over itself, and (5) expressly distinguishes "telescopic pieces" from a spring. Pet. 28, 30–31; Ex. 1011, 4:55–57, 6:4–16, Figs. 18,

20; Ex. 1025 ¶ 56, 61–65, 71, 72, 74. We, thus, find that the grandparent application does not provide sufficient written description support for “an extension . . . consisting essentially of a single piece conical telescoping flexible tubular structure, consisting essentially of a plurality of graduated sections, more flexible between the sections, that flex and/or fold over and into one another.”

Because Patent Owner argues that one of ordinary skill in the art would have read the same disclosure from the grandparent application, the parent application, and the '024 patent (PO Resp. 27; Ex. 2013 ¶ 86), we determine that none of the asserted priority documents provides written description support for claims 2 and 8 because none would convey to one of ordinary skill in the art that the inventor had possession of the claimed extension.

Based on the full record, Petitioner persuades us that the limitation “an extension . . . consisting essentially of a single piece conical telescoping flexible tubular structure, consisting essentially of a plurality of graduated sections, more flexible between the sections, that flex and/or fold over and into one another” lacks adequate written description support in the asserted priority documents.

G. Asserted Obviousness Based on the '476 Publication and Hobbs

1. The '476 Publication (Ex. 1003)

The '024 patent issued from a continuation application that is a continuation-in-part of an application that published as the '476 Publication. Ex. 1001, code (63). *See also* Pet. 41 (“The '476 Publication issued as the '098 patent.”). Figure 20 of the '476 Publication is reproduced below.

FIG. 20

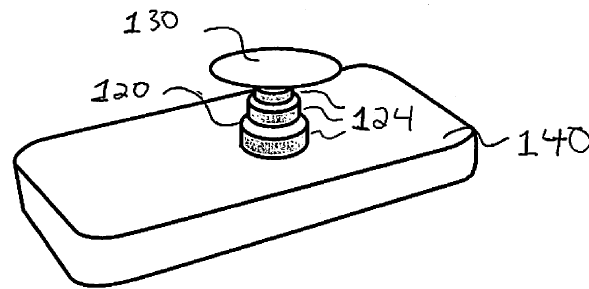


Figure 20, reproduced above, shows “a grip device . . . where a grip of the grip device moves away from a base of the grip device in a path substantially perpendicular to the base.” Ex. 1003 ¶ 20. According to the ’476 Publication, “other mechanisms may be used to open/close the handheld device, such that the grip 130 moves directly towards the base 110” (shown in Figure 2), such as “extension 120 may be formed as a slidable bar that slides into a recess of the base 110, the grip 130, and/or the handheld device 140.” *Id.* ¶ 43. “[E]xtension 120 may be constructed as a single piece or a series of telescopic pieces 124 that expand/collapse together as the grip device moves from the open to the closed position,” and “a spring (e.g., such as the spring 123 of FIG. 18) may be used in conjunction with a single piece sliding bar or the series of telescopic pieces 124 in FIG. 20.” *Id.*

2. *Hobbs* (Ex. 1021)

Hobbs particularly relates to “expandable sockets . . . that can be attached to portable media players (e.g., smart phones, MP3 players) or portable media player cases and used as grips.” Ex. 1021, 1:21–24.

Figure 2 of Hobbs is reproduced below.

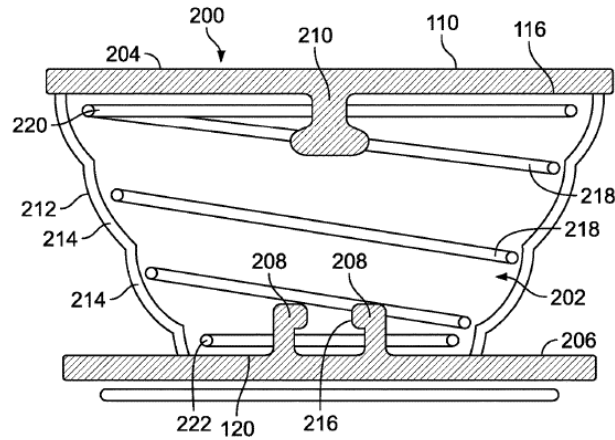


FIG. 2

Figure 2, reproduced above, shows an example of an expandable socket in an expanded configuration. Ex. 1021, 1:51–54, 4:35–37. Expandable socket 200 includes button 204, base 206, collapsible or expandable mechanism 202 coupled to and between button 204 and base 206, and deformable cover 212 coupled to button 204 and base 206. *Id.* at 4:37–41.

Cover 212 “surrounds and houses the collapsible mechanism 202 for safety and comfort.” Ex. 1021, 4:40–43; *see also id.* at 5:6–7 (stating that “cover 212 surrounds and houses (e.g., protects) the coil spring 218”). Cover 212 also can include folding sections 214 connected to each other and “form or define a tapered conical shape that looks like an accordion.” *Id.* at 4:51–58; *see also id.* at 5:14–15 (stating that “coil spring 218 illustrated in FIG. 2 has a conical or tapered shape”).

3. Claim 2

- a) “A collapsing and expanding one hand gripping apparatus fastened to or built into the back of a handheld device or its case consisting essentially of,”

Petitioner refers to previous arguments presented in challenges based on the ’476 Publication with Srour to contend that the ’476 Publication discloses the preamble, to the extent that it is considered limiting. Pet. 75;

see also id. at ix (labeling the preamble “2(pre)”). In those arguments, according to Petitioner, the ’476 Publication discloses a “collapsing and expanding one hand gripping apparatus fastened or built into to the back of a handheld device or its case.” *Id.* at 48–50 (citing Ex. 1003, Abstract, ¶¶ 11, 12, 24, 27, 29, 30, 32, 41, 49, Figs. 2, 4, 18, 26). Petitioner also argues that one of ordinary skill in the art would have understood that grip 130 is fastened to the back of handheld device 140 “or that it would have been obvious to do to avoid blocking a display of device.” *Id.* at 51 (citing Ex. 1025 ¶¶ 90–94).

The relied-upon portions of the ’476 Publication describe “a finger grip apparatus for a handheld device” that “allows a user to securely hold a handheld device with a single hand” (Ex. 1003 ¶ 11), the “grip device includes a base 110, an extension 120, and a grip 130” (*id.* ¶ 26), “extension 120 may be formed such that it expands/collapses the grip device from the open position to the closed position” (*id.* ¶ 41), “base 110 may be . . . removably or permanently affixed to the handled device,” “integrated into the body of the handheld device 140, or integrated into removable components of the handheld device 140,” such as “a removable protective case,” and “partially covers a back and at least one other side of the handheld device” (*id.* ¶¶ 29, 30).

We credit Petitioner’s testimonial evidence that one of ordinary skill in the art would have understood that grip 130 is fastened to the back of handheld device 140 “or that it would have been obvious to do to avoid blocking a display of device” because the ’476 Publication supports it. Ex. 1003, Fig. 26; Ex. 1025 ¶¶ 90–94.

As discussed below, for this challenge, Patent Owner responds that the priority claim to the Provisional Application or a prior non-provisional

application is proper. PO Resp. 74. Patent Owner does not present a responsive argument that the '476 Publication fails to teach or suggest the preamble. *See id.*

Based on the full record, because the '476 Publication teaches an apparatus that expands and collapses and that is affixed or integrated into the back of a handheld device or a removable protective case, Petitioner persuades us by a preponderance of the evidence, and we find, that the '476 Publication teaches or suggests the preamble, “[a] collapsing and expanding one hand gripping apparatus fastened to or built into the back of a handheld device or its case,” to the extent it is limiting.

b) *“a one hand gripping apparatus fastened to or built into the back of a handheld device wherein”*

For the limitation quoted above, Petitioner refers to arguments presented in challenges based on the '476 Publication with Srouer, and those arguments, in turn, refer to arguments for the preamble. Pet. 51 (citing also Ex. 1025 ¶¶ 95–96), 75; *see also id.* at ix (labeling the limitation “2(a)”).

As discussed above, Petitioner cites to portions the '476 Publication that describe “a finger grip apparatus for a handheld device” that “allows a user to securely hold a handheld device with a single hand” (Ex. 1003 ¶ 11), the “grip device includes a base 110, an extension 120, and a grip 130” (*id.* ¶ 26), and base 110 can be “integrated into the body of the handheld device 140” and “partially covers a back and at least one other side of the handheld device” (*id.* ¶ 30). We further credit Petitioner’s testimonial evidence because the '476 Publication supports it. Ex. 1025 ¶¶ 95–96.

Patent Owner’s only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO

Resp. 74. Patent Owner does not present a responsive argument that the '476 Publication fails to teach or suggest this limitation. *See id.*

Based on the full record, Petitioner persuades us by a preponderance of the evidence, and we find, that the '476 Publication teaches or suggests “a one hand gripping apparatus fastened to or built into the back of a handheld device.”

c) *“a base is fastened to or built into the back of the handheld device or its case wherein”*

For limitation quoted above, Petitioner refers to arguments presented in challenges based on the '476 Publication with Srouer. Pet. 75 *see also id.* at ix (labeling the limitation “2(b)”). In the referred to arguments, Petitioner contends that the '476 Publication discloses “a base for affixing the apparatus” and base 110 fastened to handheld device 140, a protective case, or integrated into a body of a handheld device. *Id.* at 51 (citing Ex. 1003, Abstract, ¶¶ 27, 29, 30). Petitioner also contends that it would have been obvious to integrate grip 130 into the body of handheld device 140 and it “would inherently have a ‘base’ formed by one end of the ‘extension 120’ proximate to the ‘handheld mobile device 140.’” *Id.* (citing Ex. 1003, Fig. 18; Ex. 1025 ¶ 97). Petitioner further contends that one of ordinary skill in the art would have understood that the end of grip 130 closest to device 140 fastens grip 130 to device 140 or it would have been obvious to configure grip 120 with a separate base “to provide a more stable connection between grip 130 and handheld device 140.” *Id.* at 52 (citing Ex. 1025 ¶ 98).

The relied-upon portions of the '476 Publication describe that “a grip device includes a base 110, an extension 120, and a grip 130” (Ex. 1003 ¶ 26), and “base 110 may be . . . removably or permanently affixed to the

handled device,” “integrated into the body of the handheld device 140, or integrated into removable components of the handheld device 140,” such as “a removable protective case” and “partially covers a back and at least one other side of the handheld device” (*id.* ¶¶ 29, 30). We credit Petitioner’s testimonial evidence regarding the base because the ’476 Publication supports it. Ex. 1003, Fig. 18; Ex. 1025 ¶¶ 97, 98.

Patent Owner’s only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74. Patent Owner does not present a responsive argument that the ’476 Publication fails to teach or suggest this limitation. *See id.*

Based on the full record, because the ’476 Publication teaches an apparatus with a base that is affixed or integrated to a handheld device or a removable protective case so as to cover at least the back, Petitioner persuades us by a preponderance of the evidence, and we find, that the ’476 Publication teaches or suggest “a base is fastened to or built into the back of the handheld device or its case.”

d) “an extension extends perpendicular from the base . . . , wherein the extension is movable between a collapsed, closed position and an extended, open position,”

For the limitation quoted above, Petitioner argues that the ’476 Publication discloses extension 120 that can be spring 123 that extends perpendicularly from a base and is movable between a closed, collapsed position and an open, expanded position. Pet. 53–54 (citing Ex. 1003 ¶¶ 41, 43, Figs. 18, 19); 76 (referring to previous arguments); *see also id.* at ix (labeling the limitation “2(c)”).

The cited portions of the ’476 Publication describe and depict that “extension 120 may be formed such that it expands/collapses the grip device

from the open position to the closed position” and the extension is perpendicular to the base. Ex. 1003 ¶¶ 41, 43, Figs. 18, 19.

Patent Owner’s only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74. Patent Owner does not present a responsive argument that the ’476 Publication fails to teach or suggest this limitation. *See id.*

Based on the full record, Petitioner persuades us by a preponderance of the evidence, and we find, that the ’476 Publication teaches “an extension [that] extends perpendicular from the base . . . , wherein the extension is movable between a collapsed, closed position and an extended, open position.”

- e) *“the base consisting essentially of a single piece conical telescoping flexible tubular structure, consisting essentially of a plurality of graduated sections, more flexible between the sections, that flex and/or fold over and into one-another*

For “an extension . . . consisting essentially of a single piece conical telescoping flexible tubular structure” with “graduated sections more flexible between the sections, that flex and/or fold over and into one another,” Petitioner states that the ’476 Publication does not disclose these limitations and relies on Hobbs for teaching such limitations. Pet. 25-41, 54, 76–77 (citing Ex. 1021, 4:51–58, 5:47–56; Ex. 1025 ¶¶ 170–173); *see also id.* at ix (labeling the limitation “2(c)”).

Petitioner argues that “Hobbs discloses a spring arranged within a cover between the base and the button” and the “cover in Hobbs is preferably ‘an elastomeric skin (made of an elastomeric material),’ and includes ‘a plurality of folding sections 214 connected to one another.’” Pet. 76 (citing Ex. 1021, 4:51–54). Petitioner also argues that “[t]he folding sections may be arranged in ‘a tapered conical shape that looks like an

accordion” and “[w]hen the socket is compressed, and the ‘button 204 and the cover 212 are moved toward the platform 206 in this manner, the plurality of folding sections 214 fold onto one another.’” *Id.* (citing Ex. 1021, 4:55–58, 5:47–56).

According to Petitioner, one of ordinary skill in the art would have understood that “the ‘sections’ in Hobbs can ‘fold onto one another’ due to the cover being more flexible between the sections” because “the ‘folding sections 214’ of Hobbs are ‘connected to one another’ and are shown as connected along angled folding lines” that “necessarily provides a more flexible cover between the ‘folding sections 214’ as compared to along the section.” Pet. 76–77 (citing Ex. 1025 ¶¶ 170–173). Petitioner contends that “claim 2 does not require the sections to be inflexible, or otherwise preclude some flexing or folding along the sections, so long as the structure ‘is *more* flexible between the sections.’” *Id.* at 77.

Petitioner also argues that the ’476 Publication discloses conically shaped extensions. Pet. 56 (citing Ex. 1002, Figs. 20a–20c). Petitioner also argues that such shapes were known in the art and applied to a collapsible cover for a spring. *Id.* at 56–57 (citing Ex. 1010, 6; Ex. 1021, 4:55–60, 5:2–7, Fig. 2). Petitioner, thus, argues that “the particular shape of the cover and spring of the proposed combination is a design choice” and it was “known that such designs can be conical.” *Id.* at 57 (citing Ex. 1025 ¶¶ 107–109). Petitioner further argues that a conical shape would be more comfortable, better able to accommodate different sized fingers, and inspired by the ’476 Publication’s telescopic pieces having a conical shape. *Id.* at 57–58 (citing Ex. 1002, 6:39–41, Fig. 20; Ex. 1025 ¶¶ 110–113).

A relied-upon portion of Hobbs describes that “cover 212 is generally coupled to and disposed between the button 204 and the base 206” and

“preferably takes the form of an elastomeric skin (made of an elastomeric material) that includes a plurality of folding sections 214 connected to one another.” Ex. 1021, 4:50–54. Hobbs also describes that “folding sections 214 are arranged so as to form or a define a tapered conical shape that looks like an accordion.” *Id.* at 4:56–58.

Another relied-upon portion of Hobbs describes that “expandable socket 200 may be moved from this expanded configuration to the collapsed configuration by overcoming the biasing force applied by the coil spring 218” via “grabbing or grasping the button 204 and/or the cover 212 and moving (e.g., pushing) the button 204 and the cover 212 toward the platform 206 along a longitudinal axis 224” so that “the plurality of folding sections 214 fold onto one another.” Ex. 1021, 5:47–56.

We credit Petitioner’s testimonial evidence that conically-shaped extensions were known because the ’476 Publication and Hobbs support it. Ex. 1003, Figs. 20a–20c; Ex. 1025, 4:55–60, 5:2–7, Fig. 2; Ex. 1025 ¶¶ 107–108. We, therefore, credit Petitioner’s testimonial evidence that, because conical shapes for extensions were known, one of ordinary skill in the art would have understood that “the particular shape of the cover and spring of the proposed combination is a design choice.” Ex. 1025 ¶ 109.

We also credit Petitioner’s declarant testimony regarding the advantages of a conical shape because the ’476 Publication supports it. Ex. 1003, 6:39–41, Fig. 20; Ex. 1025 ¶¶ 110–113. We further credit Petitioner’s testimonial evidence regarding the teachings of Hobbs and how one of ordinary skill in the art would have understood that the sections of Hobbs fold onto one another due to flexibility between the sections because Hobbs supports that testimony. Ex. 1021, 4:51–58, 5:47–56, Fig. 2; Ex. 1025 ¶¶ 170–173.

Patent Owner's only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74. Patent Owner does not present a responsive argument that Hobbs fails to teach or suggest this limitation. *See id.*

Based on the full record, Petitioner persuades us by a preponderance of the evidence, and we find, that Hobbs teaches “an extension . . . consisting essentially of a single piece conical telescoping flexible tubular structure, consisting essentially of a plurality of graduated sections, more flexible between the sections, that flex and/or fold over and into one-another.”

f) *“on the opposite end of the extension from the base is a grip, wherein the grip is disc-shaped and mounted perpendicular to the end of the extension and has an outer perimeter that is not in contact with the extension when the one hand gripping apparatus is in an extended or retracted position, wherein the grip is attached to the extension, wherein the grip extends radially past the extension, and wherein”*

For the limitation quoted above, Petitioner refers to arguments presented in challenges based on the '476 Publication with Srour. Pet. 78; *see also id.* at ix (labeling the limitation “2(d)”). In those arguments, Petitioner contends, with declarant support, that the '476 Publication describes and depicts a grip opposite the base (Pet. 58 (citing Ex. 1003 ¶ 32, Figs. 2, 3, 7–11, 18, 20, 21)), a circle-shaped, circular, or disc-shaped grip (*id.* at 59 (citing Ex. 1003 ¶ 32, Figs. 18–20)), and a grip with a perimeter that does not contact the extension and extends radially beyond the extension (*id.* at 60 (citing Ex. 1003 ¶ 41, Fig. 19)). *See also* Ex. 1025 ¶¶ 114–119.

A cited portion of the '476 Publication describes that grip 130 can have “a rectangular shape” or “various other shapes, such as a circle, ellipse, or other regular or irregular shapes, including ergonomic shapes designed to

comfortably fit over a user's fingers." Ex. 1003 ¶ 32, Figs. 2, 4–6. Another cited portion teaches that "grip 130 moves directly towards the base 110 without rotating." *Id.* ¶ 41, Fig. 18. The cited figures of the '476 Publication show a grip mounted and attached perpendicularly at an end of an extension and the grip's outer perimeter extends radially past the extension and is not in contact with the extension in an extended or retracted position. *Id.* Figs. 2, 3, 7–11, 18–21. We also credit Petitioner's declarant testimony regarding the recited grip because the '476 Publication supports it. Ex. 1025 ¶¶ 114–119, 175.

Patent Owner's only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74. Patent Owner does not present a responsive argument that the '476 Publication fails to teach or suggest this limitation. *See id.*

Based on the full record, Petitioner persuades us by a preponderance of the evidence, and we find, that the '476 Publication teaches or suggests:

on the opposite end of the extension from the base is a grip, wherein the grip is disc-shaped and mounted perpendicular to the end of the extension and has an outer perimeter that is not in contact with the extension when the one hand gripping apparatus is in an extended or retracted position, wherein the grip is attached to the extension, wherein the grip extends radially past the extension.

g) "the one hand gripping apparatus in the collapsed position lies flat to the handheld device"

For the limitation quoted above, Petitioner refers to arguments presented in challenges based on the '476 Publication with Srour. Pet. 78; *see also id.* at ix (labeling the limitation "2(e)"). In the referenced arguments, Petitioner contends that the '476 Publication teaches the final

limitation of claim 1. Pet. 60–61 (citing Ex. 1003 ¶¶ 31, 33, 41, Figs. 7, 8, 13–17, 19, 22, 24; Ex. 1025 ¶¶ 120–123).

The relied-upon portions of the ’476 Publication describe that “the base may be affixed to a recess in an upper surface of the handheld device 140 such that an exposed surface of the base 110 may be flush with an exposed surface of the handheld device 140” (Ex. 1003 ¶ 31, Fig. 2) and that “extension 120 may be fixedly connected to the base 110 and the grip 130” (*id.* ¶ 33) and “may be formed such that it expands/collapses the grip device from the open position to the closed position” (*id.* ¶ 41, Figs. 18, 19). The cited figures show a gripping apparatus lying flat to a handheld device in a collapsed position. *Id.* Figs. 7, 8, 13–17, 19, 22, 24. We also credit Petitioner’s declarant testimony regarding the final recitation because the ’476 Publication supports it. Ex. 1025 ¶¶ 120, 176, 177.

Patent Owner’s only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74. Patent Owner does not present a responsive argument that the ’476 Publication fails to teach or suggest this limitation. *See id.*

Based on the full record, Petitioner persuades us by a preponderance of the evidence, and we find, that the ’476 Publication teaches or suggests “wherein the one hand gripping apparatus in the collapsed position lies flat to the handheld device.”

4. Claim 8

Petitioner refers to its previous arguments for the challenge based on the ’476 Publication and Srour, because the structure and function of the proposed combination of the ’476 Publication and Hobbs are substantially the same as that proposed combination of the ’476 Publication and Srour. Pet. 78–79 (citing Pet. § VIII.E.; Ex. 1025 ¶¶ 178–180).

- a) *“A method of using a collapsing and expanding one hand gripping apparatus and fastening the one hand gripping apparatus to the handheld device or handheld device’s case, the method comprising the steps of:”*

Petitioner argues that the ’476 Publication discloses, to the extent it is limiting, the preamble of claim 8. Pet. 62 (citing Ex. 1003 ¶¶ 27, 32, 33, 39, 48–51, Figs. 4–6, 25, 26).

The cited portions of the ’476 Publication describe the preamble. Ex. 1003 ¶¶ 27, 32, 33, 39, 48–51, Figs. 4–6, 25, 26. Patent Owner’s only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74.

Based on the full record, Petitioner persuades us by a preponderance of the evidence, and we find, that the ’476 Publication teaches or suggests the preamble, to the extent it is limiting.

- b) *“obtaining a collapsing and expanding one hand gripping apparatus as recited in claim 2,”*

Petitioner refers to its arguments for claim 2 to contend that the ’476 Publication discloses the “obtaining” step of claim 8. Pet. 62.

For the reasons discussed above for claim 2, we find that the ’476 Publication and Hobbs teach or suggest the limitations of claim 2. Patent Owner’s only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74.

Based on the full record, Petitioner persuades us by a preponderance of the evidence that the ’476 Publication and Hobbes teach, suggest, and would have rendered obvious the above-quoted step.

- c) *“fastening or building the one hand gripping apparatus to the back of a handheld device or back of the handheld device’s case in an expanded position perpendicular to the handheld device,”*

By referring to arguments for the preamble and the one hand gripping apparatus of claim 2, Petitioner contends that the ’476 Publication teaches the “fastening or building” step of claim 8. Pet. 62–63 (citing Ex. 1003 ¶¶ 11, 27, 49, Fig. 18; Ex. 1025 ¶ 126).

As discussed above, we find that the ’476 Publication and Hobbs teach or suggest the limitations of claim 2. The cited portions of the ’476 Publication additionally describe the above-quoted step. Ex. 1003 ¶¶ 11, 27, 49, Fig. 18. We also credit Petitioner’s testimonial evidence regarding this step, because the record supports it. Ex. 1025 ¶¶ 126, 178–180. Patent Owner’s only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74.

Based on the full record, Petitioner persuades us by a preponderance of the evidence that the ’476 Publication and Hobbes teach, suggest, or would have rendered obvious the above-quoted step.

- d) *“receiving two adjacent non-thumb fingers of a gripping hand inserted between the handheld device and the other end of the one hand gripping apparatus, each received finger straddling the sides of the one hand gripping apparatus, wherein a fingerprint side of the received fingers face the handheld device and are in contact with the one hand gripping apparatus and/or the back of the handheld device or the handheld device’s case,”*

Petitioner also argues that the ’476 Publication discloses the “receiving” step of claim 8. Pet. 63–64 (citing Ex. 1003 ¶¶ 27, 32, 42, 49, 50, Figs. 4–6, 26, claim 2; Ex. 1025 ¶¶ 127–128).

The cited portions of the '476 Publication describe the above-quoted step. Ex. 1003 ¶¶ 27, 32, 42, 49, 50, Figs. 4–6, 26, claim 2. We also credit Petitioner's testimonial evidence regarding this step, because the record supports it. Ex. 1025 ¶¶ 127–128, 178–180. Patent Owner's only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74.

Based on the full record, Petitioner persuades us by a preponderance of the evidence, and we find, that the '476 Publication teaches or suggests the above-quoted step.

e) *“wherein a gripping hand's thumb and portion of palm wrap around to the front of the handheld device,”*

For the wherein clause quoted above, Petitioner relies on the '476 Publication and contends that one of ordinary skill in the art would have understood that a user's thumb and palm would wrap around to the front of a device. Pet. 64–65 (citing Ex. 1003 ¶ 27, Figs. 4–6; Ex. 1025 ¶¶ 129–130).

The cited portions of the '476 Publication describe the above-quoted wherein clause. Ex. 1003 ¶ 27, Figs. 4–6. We also credit Petitioner's testimonial evidence regarding the wherein clause, because the record supports it. Ex. 1025 ¶¶ 129–130, 178–180. Patent Owner's only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74.

Based on the full record, Petitioner persuades us by a preponderance of the evidence, and we find, that the '476 Publication teaches or suggests “wherein a gripping hand's thumb and portion of palm wrap around to the front of the handheld device.”

- f) *“wherein a step of a one hand gripping apparatus collapsing is removing the fingers of the gripping hand from the one hand gripping apparatus such that the one hand gripping apparatus lies flat to the handheld device”*

For the final wherein clause of claim 8, Petitioner argues that the ’476 Publication expressly teaches removing fingers to move its grip device from the open position to the closed position, and that one of ordinary skill in the art would have understood that the gripping apparatus of the ’476 Publication as modified would move substantially the same. Pet. 65 (citing Ex. 1003 ¶ 42; Ex. 1025 ¶ 132).

The cited portion of the ’476 Publication describes the above-quoted wherein clause. Ex. 1003 ¶ 42. We also credit Petitioner’s testimonial evidence regarding the wherein clause, because the record supports it. Ex. 1025 ¶¶ 125, 178–180. Patent Owner’s only response is that the priority claim to the Provisional Application or a prior non-provisional application is proper. PO Resp. 74.

Based on the full record, Petitioner persuades us by a preponderance of the evidence that the ’476 Publication teaches, suggests, and would have rendered obvious “wherein a step of a one hand gripping apparatus collapsing is removing the fingers of the gripping hand from the one hand gripping apparatus such that the one hand gripping apparatus lies flat to the handheld device.”

5. *Asserted Motivation to Combine*

According to Petitioner, one of ordinary skill in the art would have been motivated to combine the ’476 Publication with Hobbs to substitute spring 123 of the ’476 Publication with the conically-shaped cover 212 and spring 218 of Hobbs for comfort, safety, and durability. Pet. 73–74 (citing Pet. §§ VIII.C., VIII.D., X.A; Ex. 1003 ¶ 5; Ex. 1021, 4:40–43; Ex. 1025

¶¶ 110–111, 157–161), 75 (citing Ex. 1025 ¶¶ 157–164), 76, 78; *see also id.* at 72–73 (asserting that the ’476 Publication and Hobbs are analogous art) (citing Ex. 1003 ¶¶ 3, 37, 41; Ex. 1021, 1:20–25).

Petitioner also argues that (1) one of ordinary skill in the art would have had a reasonable expectation of success in making the proposed combination, (2) the cover and spring of Hobbs would still be used in the same way in the proposed combination, and (3) any additional cost or complexity would not have deterred the ordinary skilled artisan in making the combination. Pet. 74–75 (citing Ex. 1025 ¶¶ 162, 163).

We credit Petitioner’s testimonial evidence that one of ordinary skill in the art would have been motivated to substitute spring 123 of the ’476 Publication with the conically-shaped cover 212 and spring 218 of Hobbs with a reasonable expectation of success, because the cited portions of the record support the testimony. Ex. 1003 ¶¶ 3, 5, 37, 41; Ex. 1021, 1:20–25, 4:40–43 (describing “deformable cover 212 that is coupled to the button 204 and/or the base 206 in a manner that surrounds and houses the collapsible mechanism 202 for safety and comfort”); Ex. 1025 ¶¶ 110–111, 157–164.

6. *Patent Owner’s Response*

Patent Owner responds that the priority claim to the Provisional Application is proper. PO Resp. 74. Patent Owner alternatively argues that the priority claim to a prior non-provisional application is proper. *Id.*

7. *Reply Arguments*

Petitioner replies that Patent Owner solely argues that the asserted references are not prior art, and that claims 2 and 8 are not entitled to an earlier priority date. Pet. Reply 26 (citing Pet. 70–79; Inst. Dec. 36–38; PO Resp. 74). Patent Owner replies that “the proffered references do not pre-

date the priority date of the challenged claims,” and that it “primarily rests on its Response arguments.” PO Sur-reply 10 (citing PO Resp. 74).

8. *Petitioner Shows Unpatentability by a Preponderance of the Evidence*

“Once all relevant facts are found, the ultimate legal determination [of obviousness] involves weighing of the fact findings to conclude whether the claimed combination would have been obvious to an ordinary artisan.”

Arctic Cat Inc. v. Bombardier Recreational Prods. Inc., 876 F.3d 1350, 1361 (Fed. Cir. 2017) (quoting *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1068–69 (Fed. Cir. 2012)).

Based on full record before us, we provide our factual findings regarding (1) the level of ordinary skill in the art, (2) the scope and content of the prior art, (3) any differences between the claimed subject matter and the prior art, and (4) objective evidence of nonobviousness.

For the reasons stated above in Section II.F. and on the full record, Petitioner shows that claims 2 and 8 are not entitled to priority date of the Provisional Application or any of the parent applications. *See* Pet. 25–41. The ’476 Publication and Hobbs, therefore, are prior art for claims 2 and 8.

We find that (1) Petitioner’s proposed level of ordinary skill in the art is consistent with the prior art of record, (2) the ’476 Publication and Hobbs teach or suggest all the limitations of claims 2 and 8, (3) one of ordinary skill in the art would have combined the ’476 Publication and Hobbs with a reasonable expectation of success, and (4) no objective evidence of nonobviousness has been presented in relation to claims 2 and 8. As summarized above, there is no dispute about the teachings of the asserted references and the asserted motivation to combine the references.

Weighing these underlying factual determinations, a preponderance of the evidence persuades us that claims 2 and 8 of the '024 patent are unpatentable over the '476 Publication and Hobbs. *Arctic Cat*, 876 F.3d at 1361.

H. Remaining Challenges

Having determined that all of the challenged claims are unpatentable over the '476 Publication and Hobbs, we need not reach Petitioner's argument that those same claims are also unpatentable over (1) the '476 Publication and Srouer and (2) the '476 Publication, Srouer, and the Provisional Application. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding that a petitioner "is entitled to a final written decision addressing all of the claims it has challenged"); *Bos. Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App'x 984, 990 (Fed. Cir. 2020) (non-precedential) (recognizing that the "Board need not address issues that are not necessary to the resolution of the proceeding" and, thus, agreeing that the Board has "discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims"). Accordingly, we do not reach the other grounds.

III. CONCLUSION³

In summary:

Claims	35 U.S.C. §	References/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
2, 8	103	'476 Publication, Srour ⁴		
2, 8	103	'476 Publication, Srour, Provisional Application ⁵		
2, 8	103	'476 Publication, Hobbs	2, 8	
Overall Outcome			2, 8	

³ Should Patent Owner wish to pursue amendment of the challenged claim in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

⁴ As explained in Section II.H, we do not reach this ground.

⁵ As explained in Section II.H, we do not reach this ground.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 2 and 8 of U.S. Patent No. 10,800,024 B2 have been shown, by a preponderance of the evidence, to be unpatentable;

FURTHER ORDERED that Petitioner's Motion to Strike (Paper 20) is denied;

FURTHER ORDERED that Patent Owner's Motion to Exclude Evidence (Paper 23) is denied; and

FURTHER ORDERED that, because this is a Final Written Decision, the parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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