IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

NANOBEBE US INC. Plaintiff and Counterclaim Defendant, v. MAYBORN (UK) LIMITED, MAYBORN USA, INC., MAYBORN GROUP LIMITED, Defendants and Counterclaim Plaintiffs.	)))))))))))	C.A. No. 1:21-cv-08444-GHW **JURY TRIAL DEMANDED**

NANOBEBE US INC.'S INVALIDITY CONTENTIONS PURSUANT TO LOCAL PATENT RULE 7 (APRIL 14, 2022)

Plaintiff and Counter-Defendant Nanobebe US Inc. ("Nanobebe") hereby provides its Invalidity Contentions pursuant to Local Patent Rule 7 and the Court's Civil Case Management Plan and Scheduling Order (Dkt. 22).

I. ASSERTED PATENTS AND CLAIMS

Defendants-Counterclaim Plaintiffs Mayborn (UK) Limited, Mayborn USA, Inc., and Mayborn Group Limited (collectively "Mayborn") served their Disclosure of Asserted Claims and Infringement Contentions on February 28, 2022 ("infringement contentions") asserting infringement of the following claims ("Asserted Claims") of U.S. Patent Nos. 10,952,930 (the "'930 patent") and 11,207,244 (the "'244 patent") (collectively, the "Patents-In-Suit"):

Patent-In-Suit	Asserted Claim(s)	Invalidity Contention Exhibit	Invalidity Charts
10,952,930	14, 16, 17, 19	A	A-1 – A-7
11,207,244	21, 22, 23, 24, 26, 27	B	B-1 – B-12

As shown in the table above, Nanobebe provides its Invalidity Contentions for each of the Patents-In-Suit in Exhibits A and B. In addition, Nanobebe provides charts identifying examples

MAYBORN 2005
NANOBEBE v. MAYBORN
IPR2023-00467

of where each element in each Asserted Claim identified above is disclosed, described, or taught in the prior art. These contentions are subject to the Nanobebe's reservation of rights as set forth below.

II. RESERVATION OF RIGHTS

Nanobebe hereby provides its Invalidity Contentions pertaining to the Asserted Claims listed in the table above in a good faith effort to comply with Local Patent Rule 7. Nanobebe bases the Invalidity Contentions on its current knowledge and understanding of Mayborn's infringement contentions, the prior art, and other facts and information available as of the date of these contentions. Discovery is ongoing and Nanobebe has not yet completed its investigation, collection of information, discovery, or analysis relating to this action. Nanobebe reserves the right to supplement these contentions based on such discovery and to introduce and use such supplemental materials at trial.

The art cited in the claim charts is illustrative and not exhaustive. Further, the citations presented in the claim charts for a claim limitation are for exemplary purposes only and should not be deemed exhaustive. Other portions of the identified prior art may additionally, implicitly, expressly, or inherently, disclose one or more limitations of the Asserted Claims or render one or more limitations of the Asserted Claims obvious. Nanobebe reserves the right to rely on such uncited portions of the identified prior art to establish the invalidity of the Asserted Claims. Similarly, where Nanobebe cites to a patent figure in the charts, it incorporates the accompanying specification text describing that figure and vice-versa. Moreover, Nanobebe reserves the right to rely on uncited portions of the identified prior art, other prior art, or expert testimony to provide context to or aid in understanding the identified prior art.

To the extent that prior art identified by Nanobebe as anticipating is found not to anticipate, the prior art establishes that the claimed subject matter was obvious to a person of ordinary skill

in the art at the time of the alleged invention. To the extent not anticipated, no Asserted Claim goes beyond combining known elements to achieve predictable results or does more than choose between clear alternatives known to those of skill in the art.

Even if a particular claim element is not expressly found in one of the charted references, those charted references render the relevant Asserted Claims obvious without the need to combine with any other references, having in mind the information generally known to those skilled in the art, common sense, and/or routine innovation. Accordingly, Nanobebe discloses each of the references cited as rendering obvious the Asserted Claims as shown in the charts referenced above. In addition, the charted references in combination with one or more of the other charted references render obvious the Asserted Claims.

As explained in these Invalidity Contentions, it would have been obvious to a person of skill in the art at the time of the alleged invention of the Asserted Claims to combine the various references cited for one of the Patents-In-Suit so as to practice the Asserted Claims. In addition to the specific combinations of prior art and the specific combinations of groups of prior art disclosed, Nanobebe reserves the right to rely on any other combination of prior art references disclosed in these Invalidity Contentions. Nanobebe further reserves the right to rely upon combinations disclosed within the prosecution histories of the references cited in these Invalidity Contentions. These obviousness combinations reflect Nanobebe's present understanding of the potential scope of the claims that Mayborn appears to be advocating and should not be construed as Nanobebe's acquiescence to Mayborn's interpretation of the patent claims.

Any reference or combination of references that anticipates or makes obvious an asserted independent claim also makes obvious any Asserted Claim dependent on that independent claim because every element of each dependent claim was known by a person of ordinary skill at the

3

time of the alleged invention, and it would have been obvious to combine those known elements with the independent claims at least as a matter of common sense and routine innovation. Accordingly, Nanobebe contends that each Asserted Claim would have been obvious not only by the combinations explicitly defined in these contentions, but also by any combination of references that renders obvious an Asserted Claim.

Numerous prior art references, including those identified in the attachments hereto pursuant to Local Patent Rule 7 and in the claim charts, reflect common knowledge and the state of the art prior to the priority dates of the Patents-In-Suit. As it would be unduly burdensome to create detailed claim charts for the thousands of invalidating combinations, Nanobebe has provided illustrative examples of such invalidating combinations herein and/or in the charts attached hereto. For at least the reasons described herein, as well as in the attached claim charts, it would have been obvious to one of ordinary skill in the art to combine any of a number of prior art references, including any combination of those identified in the attached claim charts for one of the Patents-In-Suit, to meet the limitations of the Asserted Claims of that patent. As such, Nanobebe's inclusion of exemplary combinations does not preclude Nanobebe from identifying other invalidating combinations as appropriate.

To the extent Mayborn challenges a combination of prior art with respect to a particular element, Nanobebe reserves all rights to supplement these contentions to further specify the motivation to combine the prior art. Nanobebe may rely on cited or uncited portions of the prior art, other documents, and/or expert testimony to establish that a person of ordinary skill in the art would have been motivated to modify or combine the prior art so as to render the claims invalid as obvious.

The identification of any patent or patent publication shall be deemed to include any counterpart patent or application filed, published, or issued anywhere in the world.

Nanobebe further relies on and incorporates all prior art references cited in and/or on the cover of the Patents-In-Suit and their respective prosecution histories, including for supporting the anticipation and/or obviousness of any Asserted Claim.

Nanobebe further relies on and incorporates by reference, as if originally set forth herein, all invalidity positions, and all associated prior art and claim charts, disclosed to Mayborn in the course of any lawsuits or legal proceedings involving any of the Patents-In-Suit, or by potential or actual licensees to any of the Patents-In-Suit. Nanobebe hereby discloses and identifies as if originally set forth herein, all prior art references listed and/or asserted above as invalidating prior art against each of the Asserted Claims.

Nanobebe reserves the right to identify additional prior art references including patents, non-patent publications, as well as non-patent and non-publication prior art systems that were sold, offered for sale, used, etc. prior to the priority dates of the Patents-In-Suit, to the extent any such prior art becomes known during discovery in this case.

Nanobebe reserves the right to modify, amend, or supplement its Invalidity Contentions to show the invalidity of any additional claims that the Court may allow Mayborn to later assert.

To the extent that these Invalidity Contentions reflect or otherwise embody particular constructions of terms or phrases in the Asserted Claims, Nanobebe is not proposing any such constructions as proper constructions of those terms or phrases. Various positions put forth in these Invalidity Contentions are predicated on Mayborn's incorrect and overbroad interpretation of its claims as evidenced by its infringement contentions provided to Nanobebe. These Invalidity Contentions are not intended to, and do not necessarily, reflect Nanobebe's interpretation of the

true and proper scope of the Asserted Claims. Nanobebe reserves the right to adopt claim construction positions that differ from or even conflict with positions put forth in these Invalidity Contentions. Also, Nanobebe objects to any attempt to infer any claim constructions from any identification of potential prior art. In those instances where Nanobebe asserts that the Asserted Claims are invalid under 35 U.S.C. § 112 (e.g., no written description, not enabled, and/or indefinite), Nanobebe has applied the prior art in accordance with its assumption that Mayborn contends such Asserted Claims (1) are definite, (2) have written description support, and (3) are enabled, as evidenced by Mayborn's infringement contentions. As such, Nanobebe's Invalidity Contentions do not represent its agreement or view as to the meaning, definiteness, written description support for, or enablement of any Asserted Claim. These Invalidity Contentions and accompanying documents are not intended to reflect Nanobebe's claim construction contentions, which will be disclosed in accordance with the Court's schedule.

Nanobebe's contentions may change depending on the Court's construction of the Asserted Claims, any findings as to the priority dates of the Asserted Claims, and/or positions that Mayborn or its experts may take concerning claim construction, infringement, and/or invalidity issues. Prior art not included in this disclosure, whether known or unknown to Nanobebe, may become relevant. In particular, Nanobebe is currently unaware of the extent, if any, to which Mayborn will contend that limitations of the Asserted Claims are not disclosed in the prior art identified by Nanobebe, or will contend that any of the identified references do not qualify as prior art. To the extent that such an issue arises, Nanobebe reserves the right to identify other references that, *inter alia*, would have made the addition of the allegedly missing limitation to the disclosed device or method obvious.

Nanobebe also reserves the right to challenge the patentability of the Asserted Claims under 35 U.S.C. § 102(f) in the event Nanobebe obtains evidence that the named inventors of the Patents-

6

In-Suit did not invent the subject matter claimed therein. Should Nanobebe obtain such evidence, it will provide the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived. Nanobebe further reserves the right to assert that the Patents-In-Suit are unenforceable due to inequitable conduct.

DATED: April 14, 2022

Respectfully submitted,

By: */s/Julie P. Bookbinder*

Julie P. Bookbinder
bookbinderj@gtlaw.com
Elana B. Araj
araje@gtlaw.com
GREENBERG TRAURIG, LLP
One Vanderbilt Avenue
New York, NY 10017
Telephone: 212.801.9200
Facsimile: 212.801.6400

Laurin Buettner (*pro hac vice*)
buettnerl@gtlaw.com
GREENBERG TRAURIG, LLP
500 Campus Drive, Suite 400
Florham Park, NJ 07932
Telephone: 973.360.7900
Facsimile: 973.301.8410

Attorneys for Plaintiff Nanobebe US Inc.

7

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on April 14, 2022, I caused the foregoing to be served on the following counsel of record by mail and transmission via electronic mail:

John S. Goetz
Fish & Richardson
7 Times Square, 20th Floor
New York, New York 10036
Telephone: 212-765-5070
Facsimile: 212-258-2291
goetz@fr.com

Matthew A. Colvin
Aaron P. Pirouznia
Fish & Richardson
1717 Main Street, Suite 5000
Dallas, Texas 75201
Telephone: 214-747-5070
Facsimile: 214-747-2091
colvin@fr.com
pirouznia@fr.com

Counsel for Defendants
Mayborn (UK) Limited,
Mayborn USA, Inc., and
Mayborn Group Limited

/s/ Julie P. Bookbinder
Julie P. Bookbinder

8

EXHIBIT A—U.S. PATENT NO. 10,952,930
INVALIDITY CONTENTIONS

I. IDENTIFICATION OF PRIOR ART PURSUANT TO LOCAL PATENT RULE 7

Pursuant to Local Patent Rule 7, and subject to Nanobebe's reservation of rights, Nanobebe identifies each item of prior art that anticipates and/or renders obvious one or more of the asserted claims.

Table 1 below identifies each prior art patent and patent application currently known to Nanobebe by its number, first named inventor, priority date, date of issue, and its short name. Table 2 identifies each prior art system currently known to Nanobebe. Nanobebe further identifies and incorporates by reference, as if originally set forth herein, all prior art references cited in and/or on the cover of the '930 Patent and its prosecution histories. Nanobebe reserves the right to identify additional prior art references including patents, non-patent publications, as well as non-patent and non-publication prior art systems that were sold, offered for sale, used, etc. prior to the priority date of the '930 Patent, to the extent any such prior art becomes known during discovery in this case. Charts A-1 – A-7 attached hereto identify examples of where each element in each asserted claim is disclosed, described, or taught in the prior art.

A. Identification of Prior Art for the '930 Patent

Table 1: Prior Art Patents and Applications

Asserted Claim(s)	Number	First Named Inventor / Applicant	Filing Date / Priority Date	Publication / Issue Date	Short Name
All	U.S. 6,645,228	Charles John Renz	11/13/2001	11/11/2003	Renz-228
All	U.S. 7,122,045	Ross Steven Randolph	11/13/2001	10/17/2006	Randolph-045
All	BR PI 9,604,688	Sami Michel Azar	12/13/1996	1/9/1998	Azar-688

Asserted Claim(s)	Number	First Named Inventor / Applicant	Filing Date / Priority Date	Publication / Issue Date	Short Name
All	CH118512	Delta Manufacture De Caoutc An	6/9/1926	1/3/1927	Delta-512
All	CH467068	Sergio Merlini Mario	12/29/1966	1/15/1969	Mario-068
All	CN1461636	Takamura Akira	5/31/2002	12/17/2003	Akira-636
All	CN2150869	Zhao Bichun	2/2/1993	12/29/1993	Bichun-869
All	CN2533853	Hu Gang	4/18/2002	2/5/2003	Gang-853
All	CN86204477	Wei Lin	6/30/1986	9/2/1987	Lin-477
All	CN207816326	Jiang Xuchu	3/6/2018	9/4/2018	Xuchu-326
All	U.S. 2,174,361	Bridget D. Condon	5/16/1936	9/26/1939	Condon-361
All	U.S. D479,606	Ross Steven Randolph	10/15/2002	9/9/2003	Randolph-606
All	DE860843	Werner C. F. Meyer	5/20/1949	12/29/1952	Meyer-843
All	DE7736290	Cannon Rubber Ltd London	11/29/1976	3/9/1978	Cannon-290
All	DE8131025	Milupa AG	10/23/1981	4/7/1983	Milupa-025
All	DE 202004005564	Bamed AG	4/29/2003	6/9/2004	Bamed-564
All	FR2205817	Bebe Confort	10/5/1972	5/31/1974	Confort-817
All	GB621245	Sidney Arthur Leader	2/10/1947	4/6/1949	Leader-245
All	GB639628	Frank Alan Middleton	1/21/1948	7/5/1950	Middleton-628
All	GB968698	Messines Developments Ltd	3/21/1960	9/2/1964	Messines-698
All	GB2015350	Bruno Morane	2/27/1978	6/16/1982	Morane-350
All	GB2066795	Yoichi Nakata	12/24/1979	5/31/1984	Nakata-795
All	JP1173123	Toru Todo	6/11/2002	5/19/2003	Todo-123
All	JP3090241	Yasuhiro Kuno	5/24/2002	11/29/2002	Kuno-241
All	JP3104866	Peter Lerich	4/29/2003	10/14/2004	Lerich-866
All	JP1986244360	Tan Kun Nii	4/18/1986	10/24/1987	Nii-360
All	JP1999347102	Hidehiko Omi	6/9/1998	12/21/1999	Omi-102
All	JP2000271193	Katsuyoshi Kobayashi	3/29/1999	10/3/2000	Kobayashi-193
All	JP2001009008	Ishikawa Hikari	10/20/1998	1/16/2001	Hikari-008
All	JP2001299877	Aki Ishimaru	4/24/2000	10/30/2001	Ishimaru-877
All	JP2002011076	Aki Ishimaru	4/24/2000	1/15/2002	Ishimaru-076
All	JP2004113549	Morifuji Yasuo	9/27/2002	4/15/2004	Yasuo-549

Asserted Claim(s)	Number	First Named Inventor / Applicant	Filing Date / Priority Date	Publication / Issue Date	Short Name
All	JP2004129940	Uehara Hiroyuki	10/11/2002	4/30/2004	Hiroyuki-940
All	KR200309862	Junbin Son	1/17/2003	4/8/2003	Son-862
All	U.S. 2,093,730	Yervant H. Kurkjian	8/28/1935	9/21/1937	Kurkjian-730
All	U.S. 10,251,817	Peter Roehrig	4/29/2003	10/19/2017	Roehrig-817
All	U.S. 2004/0220618	Peter Roehrig	4/20/2004	11/4/2004	Roehrig-618
All	U.S. 3,082,770	Walter J Straub	12/12/1961	3/26/1963	Straub-770
All	U.S. 1,797,433	Mary McCrea	4/12/1927	3/24/1931	McCrea-433
All	U.S. 1,902,433	Franklin Brown	7/2/1931	3/21/1933	Brown-433
All	U.S. 1,919,537	Arthur J. Stock Jr.	6/14/1930	7/25/1933	Stock-537
All	U.S. 1,998,646	Harold A. Yager	7/31/1934	4/23/1935	Yager-646
All	U.S. 1,999,581	Harold A. Yager	11/21/1933	4/30/1935	Yager-581
All	U.S. 2,039,373	Marie Wittmann	12/8/1934	5/5/1936	Wittmann-373
All	U.S. 2,610,755	Joseph A. Gits	10/10/1949	9/16/1952	Gits-755
All	U.S. 2,812,092	Henry W. Witz	3/8/1954	11/5/1974	Witz-092
All	U.S. 3,113,569	Arthur C. Barr	8/3/1960	12/10/1963	Barr-569
All	U.S. 3,276,884	Herbert A. Barnby	6/12/1963	10/4/1966	Barnby-884
All	U.S. 3,495,993	Arthur C. Barr	7/27/1967	2/17/1970	Barr-993
All	U.S. 3,946,888	Shirley Lyford Tonkin	12/7/1972	3/30/1976	Tonkin-888
All	U.S. 5,295,597	Richard D. Green	1/21/1993	3/22/1994	Green-597
All	U.S. 5,593,052	Michael McGee	8/7/1995	1/14/1997	McGee-052
All	U.S. 6,092,680	Rodolfo Mario Pillado	11/30/1998	7/25/2000	Pillado-680
All	U.S. 6,176,380	Serge Glories	4/23/1993	1/23/2001	Glories-380
All	U.S. 6,601,720	Brenda J. Meyers	9/28/2000	2/6/2003	Meyers-720
All	U.S. 2003/0089676	Hiroyuki Uehara	11/9/2001	5/15/2003	Uehara-676
All	U.S. 2004/0035815	Ian Webb	9/12/2000	2/26/2004	Webb-815
All	U.S. 2010/0102019	Ross Steven Randolph	9/16/2003	4/29/2010	Randolph-019
All	U.S. D498,849	Ross Steven Randolph	10/15/2002	11/23/2004	Randolph-849
All	U.S. 1,510,571	Walter F. Ware	11/2/1923	10/7/1924	Ware-571
All	WO 02/074227	Christopher Mallet	3/15/2001	9/26/2002	Mallet-227

Asserted Claim(s)	Number	First Named Inventor / Applicant	Filing Date / Priority Date	Publication / Issue Date	Short Name
All	U.S. 2,588,069	Adda M Allen	12/27/1948	3/4/1969	Allen-069
All	U.S. 3,990,596	Moshe Hoftman	7/7/1975	11/9/1976	Hoftman-596
All	U.S. 4,193,588	Robert G. Doneaux	5/9/1977	3/18/1980	Doneaux-588
All	U.S. 4,238,040	William E. Fitzpatrick	8/9/1979	12/9/1999	Fitzpatrick-040
All	U.S. 4,339,046	Robert Coen	1/26/1981	7/13/1982	Coen-046
All	CN2557137	Xinghai Meng	8/6/2002	6/25/2003	Meng-137
All	GB934534	Shozaburo Yanase	6/23/1960	8/21/1963	Yanase-534
All	U.S. 2,803,250	Arthur C. Barr	10/19/1953	8/20/1957	Barr-250
All	JP2003144530	Hiroyuki Uehara	11/9/2001	5/20/2003	Uehara-530
All	WO 050510	Suzanne de Bégon de Larouziere	4/1/1999	1/17/2000	Larouziere-510
All	CH497894	Sergio Merlini Mario	1/17/1969	10/31/1970	Mario-894
All	U.S. 6,032,810	Brenda J. Meyers	7/17/1997	3/7/2000	Meyers-810
All	U.S. 2003/0141268	Michael Kerns	10/19/2001	7/31/2003	Kerns-268
All	U.S. 380,835	Walter F. Ware	4/14/1887	4/10/1888	Ware-835
All	U.S. 3,232,466	Fuad Turanciol	6/3/1963	2/1/1966	Turanciol-466
All	U.S. 1,146,639	Thomas W. Miller	4/27/1915	7/13/1915	Miller-639
All	U.S. 1,672,734	Clarence J. Reilly	3/17/1926	6/5/1928	Reilly-734
All	U.S. 4,586,621	José Dahan	2/1/1982	5/6/1986	Dahan-621
All	GB2250017	Fereidoun Sepehr	10/31/1990	5/27/1992	Sepehr-017
All	GB437822	Robert McClay	5/22/1934	11/6/1935	McClay-822
All	U.S. 2,426,927	Howard H. Ganson	6/23/1944	9/2/1964	Ganson-927
All	U.S. 1,202,740	Henry P. Kraft	3/21/1916	10/24/1916	Kraft-740
All	U.S. 3,790,017	William E. Fitzpatrick	8/8/1972	2/5/1974	Fitzpatrick-017
All	EP0536344	Alberto Signorini	2/28/1983	10/22/1997	Signorini-344
All	U.S. 2,517,457	Adda M. Allen	5/27/1946	8/1/1950	Allen-457
All	U.S. 2,688,326	Martin D. Lerman	3/28/1952	9/7/1954	Lerman-326

Asserted Claim(s)	Number	First Named Inventor / Applicant	Filing Date / Priority Date	Publication / Issue Date	Short Name
All	U.S. 2,956,702	Clark W. Ransom	3/19/1956	10/18/1960	Ransom-702
All	U.S. 3,097,757	Harold J. Searer	7/25/1961	7/16/1963	Searer-757
All	U.S. 3,493,139	Edward M. Faddoul	8/18/1967	2/3/1970	Faddoul-139
All	U.S. 3,704,803	Charles L. Ponder	7/13/1971	12/5/1972	Ponder-803
All	U.S. 4,834,099	Rik Schrooten	8/29/1985	5/30/1989	Schrooten-099
All	U.S. 5,101,991	Yasuo Morifuji	12/15/1988	4/7/1992	Morifuji-991
All	U.S. 4,993,568	Yasuo Morifuji	12/15/1988	2/19/1991	Morifuji-568
All	U.S. 5,474,028	Leigh R. Larson	1/25/1994	12/12/1995	Larsom-028
All	U.S. 5,544,766	Steven B. Dunn	11/4/1994	8/13/1996	Dunn-766
All	U.S. D384,748	Steven B. Dunn	11/9/1995	10/7/1997	Dunn-748
All	U.S. 5,673,806	Marie-Claire Busnel	4/10/1995	10/7/1997	Busnel-806
All	U.S. 5,678,710	Miin-Tsang Sheu	7/12/1995	10/21/1997	Sheu-710
All	U.S. 5,706,973	Edward S. Robbins, III	1/30/1997	1/13/1998	Robbins-973
All	U.S. 5,784,999	Leigh R. Larson	1/25/1994	7/28/1998	Larson-999
All	U.S. D404,138	Brenda J. Meyers	7/17/1997	1/12/1999	Meyers-138
All	U.S. 5,862,927	Jason Tebeau	12/14/1995	1/26/1999	Tebeau-927
All	U.S. D405,530	Frank X. Manganiello	11/4/1997	2/9/1999	Manganiello-530
All	U.S. 5,881,893	Francis X. Manganiello	12/21/1996	3/16/1999	Manganiello-893
All	U.S. D412,582	Emanuel P. Morano	4/14/1997	8/3/1999	Morano-582
All	U.S. 6,003,698	Emanuel P. Morano	4/14/1997	12/21/1999	Morano-698
All	U.S. D421,306	Brenda J. Meyers	10/13/1998	2/29/2000	Meyers-306
All	U.S. D425,994	Nouri E. Hakim	5/21/1998	5/30/2000	Hakim-994
All	U.S. 6,161,710	Mary F. Dieringer	11/3/1997	12/19/2000	Dieringer-710
All	U.S. D441,870	Ross Steven Randolph	10/20/1999	5/8/2001	Randolph-870
All	U.S. D444,239	Katsuyoshi Kobayashi	11/12/1999	6/26/2001	Kobayashi-239
All	U.S. 6,241,110	Nouri E. Hakim	8/21/1998	6/5/2001	Hakim-110

Asserted Claim(s)	Number	First Named Inventor / Applicant	Filing Date / Priority Date	Publication / Issue Date	Short Name
All	U.S. 6,270,519	Lynne Marie Botts	4/12/1999	8/7/2001	Botts-519
All	U.S. 6,321,931	Nouri E. Hakim	8/21/1997	11/27/2001	Hakim-931
All	U.S. D454,642	Nouri E. Hakim	11/21/1997	3/19/2002	Hakim-642
All	U.S. 6,357,620	Nouri E. Hakim	8/21/1997	3/19/2002	Hakim-620
All	U.S. D459,815	Gregory Pastucha	11/20/2001	7/2/2002	Pastucha-815
All	U.S. 6,422,415	Francis X. Manganiello	2/6/1998	7/23/2002	Manganiello-415
All	U.S. D463,567	Emanuel P. Morano	8/20/2001	9/24/2002	Morano-567
All	U.S. D464,434	Emanuel P. Morano	8/20/2001	10/15/2002	Morano-434
All	U.S. D465,028	Charles J. Renz	10/29/2001	10/29/2002	Renz-028
All	U.S. D486,579	Steven B. Dunn	11/3/1994	2/10/2004	Dunn-579
All	U.S. D488,560	Charles J. Renz	10/29/2001	4/13/2004	Renz-560
All	U.S. 6,745,912	Hiroyuki Uehara	11/9/2001	6/8/2004	Uehara-912
All	U.S. 6,883,672	Steven B. Dunn	5/3/2002	4/26/2005	Dunn-672
All	U.S. D504,723	Ross Steven Randolph	10/15/2002	5/3/2005	Randolph-723
All	U.S. D504,724	Ross Steven Randolph	10/15/2002	5/3/2005	Randolph-724
All	U.S. D504,725	Ross Steven Randolph	10/15/2002	5/3/2005	Randolph-725
All	U.S. 6,959,827	Emanuel P. Morano	9/15/2003	11/1/2005	Morano-827
All	U.S. 6,981,962	Boyd J. Lenkersdorf	12/9/2003	1/3/2006	Lenkersdorf-962
All	U.S. 6,984,688	Jiren Gu	5/2/2003	1/10/2006	Gu-688
All	U.S. 6,994,225	Nouri E. Hakim	8/5/2002	2/7/2006	Hakim-225
All	U.S. D520,142	Christopher Mallet	3/15/2002	5/2/2006	Mallet-142
All	U.S. 7,108,676	James A. Loging	5/4/2004	9/19/2006	Loging-676
All	U.S. 7,134,564	Esther A. L. Verbovszky	10/16/2003	11/14/2006	Verbovszky-564
All	U.S. 7,150,370	Sung-Hwan Pyun	10/21/2002	12/19/2006	Pyun-370
All	U.S. 7,185,775	Diego L. Decal	7/8/2004	3/6/2007	Decal-775
All	U.S. D539,910	Alicia Ordonez	6/8/2006	4/3/2007	Ordonez-910
All	U.S. 7,204,386	Nouri E. Hakim	8/21/1997	4/17/2007	Hakim-386
All	U.S. 7,210,591	Edward J. Goldman	8/9/2001	5/1/2007	Goldman-591

Asserted Claim(s)	Number	First Named Inventor / Applicant	Filing Date / Priority Date	Publication / Issue Date	Short Name
All	U.S. D547,874	Kazumi Horie	12/21/2005	7/31/2007	Horie-874
All	U.S. 7,243,814	Nouri E. Hakim	8/21/1997	7/17/2007	Hakim-814
All	U.S. 7,252,676	Lillie Williams	3/15/2005	8/7/2007	Williams-676
All	U.S. 7,320,678	Anthony M. Ruth	3/31/2003	1/22/2008	Ruth-678
All	U.S. 7,395,941	Suk-Chu Hong	7/26/2002	7/8/2008	Hong-941
All	U.S. 7,481,324	Gina M. Almonte	7/18/2005	1/27/2009	Almonte-324
All	U.S. D599,028	Paul Schofield	3/3/2008	8/25/2009	Schofield-028
All	U.S. D620,125	Arnold Rees	6/29/2004	7/20/2010	Rees-125
All	U.S. D626,246	Arnold Rees	6/29/2004	10/26/2010	Rees-246
All	U.S. 7,828,821	Charles J. Renz	11/13/2001	11/9/2010	Renz-821
All	U.S. 8,708,174	Eckhard Itzek	3/4/2011	4/29/2014	Itzek-174
All	U.S. 2002/0030029	Nouri E. Hakim	8/21/1998	3/14/2002	Hakim-029
All	U.S. 2002/0063103	Kathleen Kiernan	12/13/1999	5/30/2002	Kiernan-103
All	U.S. 2003/0032984	Nouri E. Hakim	8/21/1998	2/13/2003	Hakim-984
All	U.S. 2003/0093120	Charles J. Renz	11/13/2001	5/15/2003	Renz-120
All	U.S. 2003/0106872	Hung-Hsiu-Hua Lin	12/10/2001	6/12/2003	Lin-872
All	U.S. 2004/0026351	Steven B. Dunn	5/3/2002	2/12/2004	Dunn-351
All	U.S. 2004/0124168	Brian H. Silver	11/8/2002	7/1/2004	Silver-168
All	U.S. 2004/0188373	Julie Lewis	3/25/2003	9/30/2004	Lewis-373
All	U.S. 2004/0226906	Johan Peterson	5/12/2003	11/18/2004	Peterson-906
All	U.S. 2004/0256345	Jon Lundquist	6/20/2003	12/23/2004	Lundquist-345
All	U.S. 2005/0035078	Joshua Lieberman	12/10/1998	2/17/2005	Lieberman-078
All	U.S. 2005/0056611	Nouri E. Hakim	11/21/1997	3/17/2005	Hakim-611
All	U.S. 2005/0184022	Steven B. Dunn	5/3/2002	8/25/2005	Dunn-022
All	U.S. 2005/0224444	Takashi Akihiro	4/7/2004	10/13/2005	Akihiro-444

Asserted Claim(s)	Number	First Named Inventor / Applicant	Filing Date / Priority Date	Publication / Issue Date	Short Name
All	U.S. 2005/0247658	Charles J. Renz	11/13/2001	11/10/2005	Renz-658
All	U.S. 2005/0247719	James Loging	5/4/2004	11/10/2005	Loging-719
All	U.S. 2005/0252875	Miin-Tsang Sheu	5/14/2004	11/17/2005	Sheu-875
All	U.S. 2005/0258123	Brian H. Silver	5/7/2004	11/24/2005	Silver-123
All	U.S. 2005/0277987	Ross Steven Randolph	11/13/2001	12/15/2005	Randolph-987
All	U.S. 2005/0288712	Nouri E. Hakim	8/21/1998	12/29/2005	Hakim-712
All	U.S. 2006/0011571	Brian H. Silver	11/8/2002	1/19/2006	Silver-571
All	U.S. 2007/0021782	Masaharu Inoue	4/20/2004	1/25/2007	Inoue-782
All	U.S. 2007/0045214	James Jennings	7/27/2004	3/1/2007	Jennings-214
All	U.S. 2007/0095778	Morris Catton	11/3/2005	5/3/2007	Catton-778
All	U.S. 2007/0102388	Julie Lewis	10/28/2005	5/10/2007	Lewis-388
All	U.S. 2007/0131637	Yasuo Tamura	12/8/2005	6/14/2007	Tamura-637
All	U.S. 2007/0138121	Robert Stribling	11/16/2005	6/21/2007	Stribling-121
All	U.S. 2007/0138709	Luvina Sabree	3/11/2005	6/21/2007	Sabree-709
All	U.S. 2007/0163983	Shen-Kwang Hsu	1/17/2006	7/19/2007	Hsu-983
All	U.S. 2007/0187419	Nouri E. Hakim	8/21/1997	8/16/2007	Hakim-419
All	U.S. 2007/0221604	Nouri E. Hakim	8/5/2002	9/27/2007	Hakim-604
All	U.S. 2007/0272645	Kazumasa Ito	7/29/2004	11/29/2007	Ito-645
All	U.S. 2007/0278172	Nouri E. Hakim	11/21/1997	12/6/2007	Hakim-172
All	U.S. 2007/0283666	Daniel Py	4/10/2006	12/13/2007	Py-666
All	U.S. 2008/0128379	Gilad Hen	12/5/2006	6/5/2008	Hen-379

Asserted Claim(s)	Number	First Named Inventor / Applicant	Filing Date / Priority Date	Publication / Issue Date	Short Name
All	U.S. 2008/0173654	Nouri E. Hakim	8/21/1997	7/24/2008	Hakim-654
All	U.S. 2008/0188894	Nouri E. Hakim	8/21/1998	8/7/2008	Hakim-894
All	U.S. 2008/0210655	Arnold Rees	6/29/2004	9/4/2008	Rees-655
All	U.S. 2008/0314776	Terry M. Cooke	6/22/2007	12/25/2008	Cooke-776
All	U.S. 2009/0005811	Alexander DuChesne	1/7/2006	1/1/2009	DuChesne-811
All	U.S. 2009/0039046	Gunter Marr	9/12/2005	2/12/2009	Marr-046
All	DE19716535	Joachim Stromski	4/23/1996	11/6/1997	Stromski-535
All	DE19849271	Herbert Willmann	10/26/1998	4/27/2000	Willmann-271
All	DE20210121	Miin Tsang Sheu	6/29/2002	10/2/2002	Sheu-121
All	EP0151862	Edward Atkin	2/1/1984	10/18/1989	Atkin-862
All	EP0845971	Craig I. Brown	8/4/1995	10/24/2001	Brown-971
All	EP1297814	Graham Tulett	9/28/2001	1/14/2015	Tulett-814
All	EP1310230	Hiroyuki Uehara	11/9/2001	5/14/2008	Uehara-230
All	GB0004210	Mead Corp.	2/23/2000	4/12/2000	Mead-210
All	GB2139903	Byong Wha Suh	4/8/1983	11/21/1984	Suh-903
All	GB2154451	Edward Atkin	2/1/1984	4/27/1988	Atkin-451
All	GB2167735	Khung Ngee Tan	11/21/1984	6/4/1986	Tan-735
All	GB2351729	Shu-E Ho	7/13/1998	1/10/2001	Ho-729
All	GB2402347	Peter Roehrig	4/29/2003	6/8/2005	Roehrig-347
All	GB2412114	Ilan Zadik Samson	3/19/2004	9/21/2005	Samson-114
All	JP01313056	Zenichi Onuki	6/13/1988	12/18/1989	Onuki-056
All	JP02144065	Keiko Aoki	11/28/1988	6/1/1990	Aoki-065
All	JP05084279	Keiko Kobayashi	9/30/1991	4/6/1993	Kobayashi-279
All	JP05115535	Keiko Kobayashi	10/30/1991	5/14/1993	Kobayashi-535
All	JP2000000288	Ryotaro Sato	6/16/1998	1/7/2000	Sato-288
All	JP2000135270	Hikari Ishikawa	12/16/1999	5/16/2000	Ishikawa-270
All	JP2000189496	Hikari Ishikawa	10/20/1998	7/11/2000	Ishikawa-496
All	JP2001187117	Katsuyoshi Kobayashi	12/28/1999	7/10/2001	Kobayashi-117
All	JP2001299878	Aki Ishimaru	4/27/2000	10/30/2001	Ishimaru-878
All	JP2002200144	Aki Ishimaru	12/28/2000	7/16/2002	Ishimaru-144

Asserted Claim(s)	Number	First Named Inventor / Applicant	Filing Date / Priority Date	Publication / Issue Date	Short Name
All	JP2003144529	Hiroyuki Uehara	11/9/2001	5/20/2003	Uehara-529
All	JP2003205018	Hiroyuki Uehara	11/9/2001	7/22/2003	Uehara-018
All	JP2002306572	Soji Konno	4/11/2001	10/22/2002	Konno-572
All	JP2006006809	Mitsuo Tashiro	6/29/2004	1/12/2006	Tashiro-809
All	JP2006068360	Kazumasa Ito	9/3/2004	3/16/2006	Ito-360
All	WO 9825571	Francis X. Manganiello	12/11/1996	6/18/1998	Manganiello-571
All	WO 2000054726	John G. Prentiss	3/17/1999	9/21/2000	Prentiss-726
All	WO 2003092577	Steven B. Dunn	5/3/2002	11/13/2003	Dunn-577
All	WO 2004039304	Ross Steven Randolph	10/16/2002	9/30/2004	Randolph-304
All	WO 2004043325	Brian H. Silver	11/8/2002	5/27/2004	Silver-325
All	WO 2004064578	Peter Roehrig	1/20/2003	8/5/2004	Roehrig-578
All	WO 2004065247	Peter Roehrig	1/20/2003	8/5/2004	Roehrig-247
All	WO 2005041851	Peter Roehrig	10/23/2003	8/11/2005	Roehrig-851
All	WO 2006011573	Kazumasa Ito	7/29/2004	5/1/2008	Ito-573
All	AT006721	Bamed AG	4/29/2003	3/25/2004	Bamed-721
All	AT007456	Bamed AG	4/29/2003	4/25/2005	Bamed-456

Table 2: Prior Art Systems

Asserted Claim(s)	System / Service	Earliest Public Use and/or Offer for Sale
All	Playtex NaturaLatch Nipple	2004
All	Gerber First Essential with Latex Nipple	2003
All	Playtex Natural Action Nipple	1961
All	Avent Anti-Colic Nipple	2000
All	Gerber Three-Holed Ribbed Nipples	2003
All	NUK First Choice Nipple	2003
All	The First Years Inc. Breastflow Nipple	2004
All	Evenflo Classic Sensitive Response Nipple	2003
All	Evenflo Elite Sensitive Response Wide Nipple Nurser	2003
All	Evenflo Ultra Sensitive Response Wide Nipple Nurser	2003
All	Gerber The New Traditions Nipple System	2002
All	Playtex Insulator Latch-On Nipple	2005
All	Gerber First Essentials Nipples	2003
All	Playtex Natural Shape Nipple	1998
All	Mizpah Valve Nipple	1902

II. INVALIDITY UNDER 35 U.S.C. §§ 102 & 103 PURSUANT TO LOCAL PATENT RULE 7

One or more combinations of the prior art references identified in the attached claim charts would have been obvious because these references would have been combined using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or a teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining the prior art references identified above because there were only a finite number of predictable solutions and/or because known work in one field of endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. In addition, the combination of the prior art references identified in the attached claim charts would have been obvious because the combination represents the known potential options with a reasonable expectation of success.

Additional evidence that there would have been a motivation to combine the prior art references identified above includes the interrelated teachings of multiple prior art references; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the asserted claims; the existence of a known need or problem in the field of the endeavor at the time of the invention(s); and the background knowledge that would have been possessed by a person having ordinary skill in the art.

Thus, the motivation to combine the teachings of the prior art references disclosed herein is found in the references themselves and: (1) the nature of the problem being solved, (2) the express, implied, and inherent teachings of the prior art, (3) the knowledge of persons of ordinary skill in the art, and (4) the predictable results obtained in combining the different elements of the

prior art. Additionally, one would be motivated to address at least the alleged problems or achieve the purported objectives identified in the description of the ’930 Patent.

A. Identification of Combinations of Prior Art Rendering the Asserted Claims Obvious:

The asserted claims are rendered obvious by single references when combined with the knowledge of a person of ordinary skill in the art, combinations of references, and combinations of references when combined with the knowledge of a person of ordinary skill in the art as explained above.

B. Motivations to Combine:

In *KSR*, the Supreme Court emphasized that an idea that is the result of ordinary innovation, ordinary skill, or common sense should not be patentable. *See KSR Int’l Co. v. Teleflex Inc*., 550 U.S. 398 (2007). The Supreme Court held that a person of ordinary skill in the art is “a person of ordinary creativity, not an automaton” and “in many cases a person of ordinary skill in the art will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 420-21. Although a patent challenger is not required to show that one of ordinary skill in the art would have had a specific motivation to combine prior art references, such a showing may be helpful to the obviousness analysis. *Id.* at 418; *see also id.* at 402.

One of skill in the art would have been motivated to combine the references identified herein because, for example, the identified combinations fall into one or more of the following categories:

- A combination of elements known in the prior art according to known methods to yield a predictable result;
- A combination that is a simple substitution of one or more known elements for another to obtain a predictable result;
- A combination that involves using a known technique to improve a similar device or method in the same way;

- A combination that involves applying a known technique to a known device or method ready for improvement to yield a predictable result;
- A combination that results from a finite number of identified, predictable solutions with a reasonable expectation of success, such that the solution was one which was "obvious to try";
- A combination that results from known work in one field of endeavor prompting variations of it for use either in the same field or a different field based on design incentives or other market forces in which the variations were predictable to one of ordinary skill in the art; and
- A teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to modify the prior art reference or to combine the teachings of various prior art references to arrive at the claimed invention.

Further, the Federal Circuit has held that a motivation to combine references may be implicit for patents claiming an "improvement":

> [A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the "improvement" is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal—and even commonsensical—we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him capable of combining the prior art references.

DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2006). The prior art references identified herein explicitly or implicitly refer to other prior art references, share common authors or inventors, and/or were developed at common companies, schools, or organizations, all of which would motivate one of skill in the art to combine them. These references are also within the fields of the '930 Patent and are directed to similar subject matter within those fields. Additionally, any products, devices, or processes described in the references existed and/or were invented before or during the period in which the claimed inventions were developed, providing further motivation to combine them.

Thus, the motivation to combine the teachings of the prior art references disclosed herein is found in the references themselves and: (1) the nature of the problem(s) being solved, (2) the express, implied, and inherent teachings of the prior art, (3) the knowledge of persons of ordinary skill in the art, (4) the fact that the prior art is generally directed toward a device for feeding a baby, including baby bottles and/or teats, and (5) the predictable results obtained in combining the different elements of the prior art. Additionally, one would be motivated to address at least the alleged problems or achieve the purported objectives identified in the descriptions of the '930 Patent.

III. INVALIDITY UNDER 35 U.S.C. § 112 PURSUANT TO LOCAL PATENT RULE 7

The Invalidity Contentions set forth below pursuant to L.P.R. 7 are subject to revision and amendment pursuant to Federal Rule of Civil Procedure 26(e) and the Orders of record in this matter to the extent appropriate in light of further investigation and discovery regarding the defenses below, the Court's construction of the claims at issue, and/or the review and analysis of expert witnesses.

A. Lack of Written Description Under 35 U.S.C. § 112, ¶ 1

The written description requirement of 35 U.S.C. § 112, ¶ 1 demands that the patent specification allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed and describe the invention with all of its claimed limitations. *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998). Claims directed to a distinct invention from that disclosed in the specification do not satisfy the written description requirement. *Id.*

Written Description Contentions for the '930 Patent:

The Asserted Claims lack written description because the specification of the '930 Patent fails to reasonably convey to those skilled in the art that the inventors had possession of the full scope of the claimed invention as of the filing date. For example, and without limitation:

- Claim 14: "capturing the flange of the nipple between the collar and the open top of the vessel."

B. Lack of Enablement Under 35 U.S.C. § 112, ¶ 1

The enablement requirement of 35 U.S.C. § 112, ¶ 1 demands that the patent specification enable "those skilled in the art to make and use the full scope of the claimed invention without 'undue experimentation.'" *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993)). "[T]he scope of the claims must be less than or equal to the scope of the enablement." *Nat'l Recovery Tech., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1196 (Fed. Cir. 1999).

Enablement Contentions for the '930 Patent:

The Asserted Claims lack enablement because the specification of the '930 Patent fails to enable those skilled in the art to make and use the full scope of the claimed invention without undue experimentation. For example, and without limitation:

- Claim 14: "capturing the flange of the nipple between the collar and the open top of the vessel."

C. Indefiniteness Under 35 U.S.C. § 112, ¶ 2

Claims are indefinite under 35 U.S.C. § 112, ¶ 2 when they "fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014).

Indefiniteness Contentions for the '930 Patent:

The Asserted Claims are indefinite because the specification of the '930 Patent fails to inform those skilled in the art about the scope of the invention with reasonable certainty. For example, and without limitation:

Claim 14 is indefinite because the specification provides no standard for evaluating a one-way air inlet valve is disposed "at least partially inwardly" from the collar.