

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBAL SHADE CORP.

Petitioner,

v.

WITH-U E-COMMERCE (SHANGHAI) CO., LTD.

Patent Owner.

IPR2023-00580

Patent 10,669,738 B2

Record of Oral Hearing

Held: June 13, 2024

Before PATRICK R. SCANLON, BARRY L. GROSSMAN, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE PETITIONER:

NATHAN REEVES, ESQ.
LOGAN YOUNG, ESQ.
of: KNOBBE MARTENS OLSON & BEAR LLP.
925 4th Ave STE. 2500
Seattle, WA 98104
(206) 405-2000
Nathan.reeves@knobbe.com
logan.young@knobbe.com

ON BEHALF OF THE PATENT OWNER:

JEFFREY W. JOHNSON, ESQ.
JARED L. DUJACK
SCHMEISER OLSEN & WATTS, LLP
18 E. UNIVERSITY DRIVE, STE 101,
Mesa, Arizona 85201
(480) 655-0073
Jjohnson@iplawusa.com
jdujack@iplawusa.com

The above-entitled matter came on for hearing Thursday, June 13, 2024, commencing at 9:11 a.m. EDT, at the U.S. Patent and Trademark Office, 300 River Pl S Ste 2900, Detroit, MI 48207 and via video-conference.

PROCEEDINGS

(9:11 a.m.)

JUDGE SCANLON: Okay. Good morning. Welcome to the Patent Trial and Appeal Board. We're here today for oral arguments in IPR2023-00580 between Petitioner Global Shade Corporation and Patent Owner With-U E-Commerce (Shanghai), involving Patent No. 10,669,738. I'm Judge Scanlon and joining me today remotely are Judge Grossman and Judge Hoskins.

And I notice -- is Judge Grossman with us? I don't see him on screen.

JUDGE GROSSMAN: I can hear you.

JUDGE SCANLON: Okay.

JUDGE GROSSMAN: And I can see.

JUDGE SCANLON: Okay. We can hear you. All right. Very good.

So before we get into appearances, I want to apologize for the warm temperature in the hearing room today. And it looks like the usher already said there's no breach of decorum to remove your jackets, and feel free to loosen your ties if you want to.

So, having said that, let's start with appearances. Who's here for Petitioner, please?

MR. REEVES: Your Honor, Nathan Reeves of Knobbe Martens Olson & Bear for Petitioner. With me is my associate Logan Young.

JUDGE SCANLON: I'm sorry.

MR. REEVES: With me is my associate Logan Young.

JUDGE SCANLON: Oh, okay. Very good. Welcome. Thank you.

And for Patent Owner?

1 MR. JOHNSON: Jeff Johnson for Patent Owner With-U E-
2 Commerce, and I'm joined by Jason Murphy, who is sitting in the back, and
3 also Jared Dujack.

4 JUDGE SCANLON: Okay. Very good. Thank you.

5 So, as set forth in the hearing order, each party is permitted 45
6 minutes to present their arguments. Because it bears the burden of
7 persuasion, Petitioner will go first and may reserve no more than half of its
8 time for rebuttal. Patent Owner will then have an opportunity to respond
9 and may also reserve time for a rebuttal. We've got a timing system here, so
10 I'll operate that and keep time. So, hopefully, you can see the amount of
11 time remaining.

12 I will ask each presenter to speak into the microphone so that
13 everyone will be able to hear you clearly. And also, I would ask, as you're
14 presenting, referring to any demonstrative slides, to refer by slide number.
15 That's not only helpful for the judges participating remotely, but it's also
16 helpful in creating a complete record.

17 So, with that, we'll start with Petitioner. And please let us know how
18 much time you would like to reserve for a rebuttal.

19 MR. REEVES: Would you like a copy of the demonstratives, or do
20 you --

21 JUDGE SCANLON: I have one on my computer screen, so we're all
22 set.

23 MR. REEVES: Okay. And I'd like to reserve 15 minutes.

24 JUDGE SCANLON: Fifteen minutes, okay. So begin when you are
25 ready.

26 PETITIONER ARGUMENT

1 MR. REEVES: Thank you and good morning, Your Honors. Nathan
2 Reeves for Petitioner Global Shade. I'd like to begin by just reviewing
3 quickly the grounds and references at issue in this petition.

4 So I'm looking at slide 2 of Petitioner's demonstratives, and that
5 shows that we have two grounds dealing with claims 1, 2, 4, 13, and 14.
6 Ground 1 features the references Rousselle and Tsai, whereas Ground 2 adds
7 Ohnishi. Each of these grounds is 103 obviousness ground.

8 We also have at issue here Patent Owner's revised Motion to Amend,
9 which deals with proposed Substitute Claims 15 through 19, and there are
10 several references at issue there, including Rousselle, Tsai, Ohnishi, Hooper,
11 and Seo.

12 Now, in this proceeding, the Patent Owner doesn't dispute what these
13 references disclose. Instead, the Patent Owner has argued that a person of
14 ordinary skill in the art would not have combined the references for various
15 reasons. And as I plan to show you today, and through our briefing, we've
16 shown that that is just not the case.

17 I'd like to begin on slide 10, as well, where I think there's a helpful
18 sort of distinction that the Panel may find useful. In our petition, we
19 provided two different ways of thinking about the combination in Ground 1
20 between Rousselle and Tsai. And the Patent Owner has labeled these the
21 primary modification and the alternative modification. And I'll be using that
22 terminology as well because I think it's what the parties have used
23 throughout the briefing, and I think it's useful to make the distinction.

24 So the primary modification begins with Rousselle's canopy and adds
25 structure from Tsai, including Tsai's outer retractable units. Whereas the

1 alternative modification begins with Tsai's canopy and adds structure from
2 Rousselle, for example, Rousselle's central block.

3 Both of these modifications would have been viable. Both of them
4 meet the limitations of the challenged claims, and a person of ordinary skill
5 in the art would have been motivated to make each of these modifications.

6 JUDGE HOSKINS: Mr. Reeves?

7 MR. REEVES: Yes.

8 JUDGE HOSKINS: This is Judge Hoskins. Can you walk me
9 through how the primary modification -- what's the result? How's that going
10 to work?

11 MR. REEVES: Sure. So, remaining on slide 10 for just a moment,
12 the primary modification begins with Rousselle's canopy. And it would
13 attach, to each of the legs of Rousselle, the outer retractable units from Tsai.
14 That's the sort of most simple form of that modification.

15 We also argued that you could use Tsai's inner retractable units
16 instead of Rousselle's, and that would also be part of the primary
17 modification. And the way that that will work really segues into the next
18 part of my presentation, which begins on slide 11.

19 Now, the Patent Owner has argued that this modification would be
20 inoperable. And really, I think what the crux of that argument is, is the way
21 that Rousselle's canopy goes from an assembled or unfolded state to a
22 collapsed or a folded state is that you separate the top and bottom cap, 400
23 and 600, and you pull them apart. And that collapses the canopy.

24 And then, Rousselle says you can fold the legs up to reach that
25 position seen in Figure 1(D), where the legs fold up at hinges 312. The thing

1 is, Rousselle doesn't say you have to do that. It just says you can do that.
2 And Patent Owner's expert recognized that on cross-examination.

3 And so, what we have said is instead of necessarily folding those legs
4 up, what one would do is simply just detach the top and bottom cap, the
5 canopy collapses, and then you're done. You've met the limitations of the
6 claim, and there's no need to fold those legs up, just --

7 JUDGE HOSKINS: So where are the outer retractable units that
8 you're taking from Tsai? Where are they going to attach to the --

9 MR. REEVES: Sure. So my --

10 JUDGE HOSKINS: -- Rousselle?

11 MR. REEVES: I believe what we've argued is that they would attach
12 just under that hinge 312.

13 JUDGE HOSKINS: So, in the coloring here on your slide, it would
14 be kind of on the purple side instead of the yellow side.

15 MR. REEVES: I believe that's correct, Your Honor.

16 JUDGE HOSKINS: So just under the hinge, right?

17 MR. REEVES: Correct.

18 JUDGE HOSKINS: And so, then, you're arguing about the legs not
19 needing to bend is the point is it wouldn't look like this Figure 1(D). Those
20 purple legs would be kind of pointing down instead of up.

21 MR. REEVES: That's correct, Your Honor. Yes.

22 JUDGE HOSKINS: Okay. Thank you.

23 MR. REEVES: Yes. And as Patent Owner's expert recognized,
24 there's nothing in the claims of the '738 patent that require those legs to point
25 upwards. They can point downwards. The canopy would still be in a
26 folded-up state. All the claim limitations would be met.

1 JUDGE SCANLON: I do have a follow-up question. So if what's
2 shown is the purple legs 310, if they're pointing directly downward, roughly
3 parallel to the yellow legs, is that what you're proposing?

4 MR. REEVES: I believe, if I understand you correctly, yes, Your
5 Honor.

6 JUDGE SCANLON: So I guess my question is, is that -- I mean, I
7 know it's collapsed because some of the elements are folded on themselves,
8 but with those legs sticking downward, isn't the overall length of the folded
9 unit now actually kind of longer? Because, before, the yellow and purple
10 legs were roughly perpendicular; now, if they're extended lengthwise, isn't
11 the overall length going to be even more than it was when unfolded?

12 MR. REEVES: I think it would be longer than what Rousselle's
13 canopy was previously, yes, Your Honor.

14 JUDGE SCANLON: Okay.

15 MR. REEVES: I don't know that it would be longer than, say, the
16 other prior art canopies.

17 JUDGE SCANLON: All right.

18 MR. REEVES: And I think that we have a case later on in our
19 presentation that speaks to this issue. And let me just see if I can find that
20 quickly in my notes here. Yeah, this is on slide 18.

21 JUDGE SCANLON: Okay.

22 MR. REEVES: This is *In re Urbanski*. And this says that, in some
23 cases, one of ordinary skill would have been motivated to pursue the
24 desirable properties taught by one reference, even if that meant foregoing the
25 benefit taught by another reference.

1 And so, it's our position that a person of ordinary skill in the art would
2 have been motivated to have the outer retractable units for the benefits they
3 provide, namely stability, even at the expense of foregoing some perhaps
4 collapsibility of Rousselle's canopy.

5 JUDGE SCANLON: Compactness, perhaps?

6 MR. REEVES: Correct.

7 JUDGE SCANLON: Okay. And the other question is, what do you
8 say to the argument that this is really a new argument? Is it supported any
9 where in the petition, the not inverting the legs 310?

10 MR. REEVES: Yeah, it's really not a new argument, Your Honor.
11 And the reason is that none of the structure that we're presenting here has
12 changed at all since the petition. We've merely pointed out a way that the
13 canopy could work without making any changes to the structure from what
14 we proposed in the petition, so it's not a new argument.

15 JUDGE SCANLON: All right. Thank you.

16 MR. REEVES: And just to point out on slide 12 as well, that this idea
17 is supported by Petitioner's expert and the testimony that Dr. Stein provided.

18 Moving on to slide 14, one of the other arguments that Patent Owner
19 has made is that Tsai teaches away from combination with Rousselle, and
20 that's just not the case because the case law shows us that a reference does
21 not teach away if it merely expresses a general preference for something
22 else. So if Tsai discloses a certain way of doing things, Rousselle discloses
23 a certain way of doing things, those don't teach away from each other merely
24 because they express different ways of doing things.

25 And as Dr. Stein testified, just because Tsai teaches that its canopy
26 may be unfolded by pulling out one of the legs, which is what Tsai teaches

1 for its canopy, would not discourage a skilled artisan from considering other
2 methods, like activating the canopy centrally as taught in Rousselle.

3 Turning now to slide 15, the Patent Owner argues a few other reasons
4 why one would not combine Tsai with Rousselle. One is that Tsai
5 sometimes suggests an extra person may be needed to set up a canopy. But
6 we've all recognized that Rousselle's canopy can be unfolded by a single
7 person. There's disclosure in Rousselle to that effect.

8 Patent Owner has also suggested that Tsai discloses that center strut
9 canopies, which Rousselle is really a center strut canopy, but to the extent it
10 is, that center strut canopies can reduce the headroom within the canopy.

11 But the canopies that Tsai is talking about are shown in Tsai's Figure
12 17, and those canopies have inner retractable units that are sort of parallel to
13 the ground, well below the level of the roof of the canopy. And as we
14 pointed out in the petition, that's not the case for either Tsai's main
15 embodiment or for Rousselle. So these are really not issues with the
16 combination.

17 JUDGE HOSKINS: Mr. Reeves?

18 MR. REEVES: Yes.

19 JUDGE HOSKINS: So, on your first point about one person, one of
20 the things that's kind of -- I think your colleague across the aisle is going to
21 talk about is the inside, the legs have the extended feature on the legs
22 themselves, and so, then there's the lock on the legs.

23 And so, one of the things I think you said is that is one option the
24 person of ordinary skill in the art could combine those two things, the center
25 lock from Rousselle, and then -- I'll refer to them as leg locks if I may --

1 from Tsai. In that specific combination, could you do that with one person,
2 or would you need two people?

3 MR. REEVES: I think in that combination, it's likely. I'm not sure
4 that we have testimony or evidence on the topic, but it's likely, I think, that
5 you would need more than one person in that situation.

6 But again, I would point out that there are potentially benefits to that
7 situation, including increased stability, increased security of the canopy that
8 it might lead a person of ordinary skill in the art to not be so worried about
9 requiring more than one person.

10 Moving along to slide 16, and I'm going to begin talking about the
11 alternative modification, which, as a reminder, is beginning with Tsai's
12 canopy and adding Rousselle's central lock.

13 The Patent Owner has argued that this modification would be
14 inoperable because Tsai's inner units are not strong enough to unfold the
15 canopy. But there's testimony from both experts that suggests that it would
16 have been well within a person of ordinary skill's skill to make any needed
17 basic changes to the canopy to allow it to do that.

18 So, Dr. Stein testified that that would be well within the skill of a
19 person of ordinary skill in the art. And Dr. Reffeor testified that that sort of
20 thing is what engineers do all the time, you know, making things stronger,
21 less strong, more flexible, less flexible.

22 Looking at slide 17, the Patent Owner has raised a number of other
23 issues with the alternative modification, but these issues are all essentially
24 contradicted by the references and by the record.

25 So, as we discussed, Tsai suggests an extra person is sometimes
26 needed for set up, but Rousselle's canopy of course can be unfolded by a

1 single person. Tsai allegedly suggests that unfolding the canopy is done
2 with the legs, but Rousselle discloses that central activation, using a central
3 lock, can be achieved. And as we've discussed, the leg locks in Tsai, but of
4 course, Rousselle's central lock came later and is not covered by Tsai's
5 statement that the leg locks are preferable to locks known heretofore.

6 What all these arguments have in common -- and I'm turning to slide
7 18 as I think about this -- is that they attack a single reference where there
8 are references in combination at issue. And that's contradicted by the case
9 law here, *In re Keller*, where one cannot show non-obviousness by attacking
10 references individually where there is combination at play.

11 I'd also like to briefly discuss Ground 2 by turning to slide 22. And
12 that's just to say that the Patent Owner hasn't made any particular arguments
13 with respect to Ground 2 that we've not covered with respect to Claim 1 and
14 Ground 1, and indeed, that's true of all the dependent claims. So, everything
15 in this case -- all of the disputes in this case rise and fall on Claim 1 and
16 Ground 1.

17 And with that, unless the Panel has any further questions, I'd like to
18 turn to the Motion to Amend. So, again, in the Motion to Amend, once
19 again we're in a situation where there's no -- there doesn't seem to be any
20 dispute about what the references themselves disclose and that they disclose
21 each limitation of the proposed substitute claims. What's been disputed is,
22 first, whether one of the references is analogous art, and second, whether a
23 person of ordinary skill in the art would have been motivated to combine the
24 additional references that are at issue in the Motion to Amend.

25 So, I'll begin with the analogous art question. And of course, the test
26 for analogous art is that the reference must either be in the same field of

1 endeavor as the challenged patent, or it must deal with the same particular
2 problem that was faced by the inventors of the challenged patent. And in
3 this case, the Hooper reference, which is the one at issue here, satisfies both
4 tests, and it only needs to satisfy one.

5 So, looking at slide 28, the case law tells us that the field of endeavor
6 is not limited to the specific point of novelty, it's not limited to the narrowest
7 possible conception of the field or a particular focus within any given field,
8 and that there's generally an expansive view of what constitutes analogous
9 art. And here, that's clearly met because both experts agree that Hooper,
10 which discloses a jewelry clasp, is directed to a locking mechanism, and
11 that's one of the things as well that the '738 patent is directed to.

12 Looking at slide 29, Hooper also deals with the same particular
13 problem that faced the inventors of the '738 patent. And again, the case law
14 tells us that a person of ordinary skill in the art would not identify the
15 problem so narrowly as to rule out all the art outside of the field. Instead,
16 they would define that problem broadly.

17 Additionally, the reference must be reasonably pertinent only to one
18 or more of the particular problems faced by the inventors, so there could be
19 more than one problem faced by the inventors. And here, Petitioner's expert,
20 Dr. Stein, testified that Hooper is relevant to the problem of we need to use
21 reliable locking mechanisms, just like the '738 patent. So, the evidence
22 shows that that's the case.

23 JUDGE SCANLON: Excuse me. So how do you respond to the
24 arguments that Patent Owner made in its briefing that over the course of the
25 proceeding, you've moved the goalposts, so to speak, on how you define the

1 particular problem; it's changed in different iterations -- or different times of
2 the proceeding?

3 MR. REEVES: Well, for one thing, Your Honor, because the
4 reference must be reasonably pertinent only to one or more of the particular
5 problems, there's no issue with having a different particular problem for each
6 reference at issue. And so, that's one response that I have to that.

7 Another response is just to say, you know, I don't think we ever to
8 intended to sort of define the full scope of what the particular problem might
9 be. We simply said in the petition that we know that that's the same
10 particular problem because the problems feature X, Y, or Z. And that may
11 not be the entirety of what's encompassed by the particular problem, but we
12 know it's within the same particular problem because it deals with this issue.

13 And so, I don't think we've moved the goalposts at all. I think we've
14 simply just pointed out that there may be different aspects of the same
15 particular problem.

16 JUDGE SCANLON: Thank you.

17 MR. REEVES: So, again, Hooper only needs to meet one or the other
18 of these tests, and it meets both. So Hooper is analogous art and can be used
19 in an obviousness combination against the proposed substitute claims.

20 Looking at slide 30, the Patent Owner has also argued that a person of
21 ordinary skill would not have incorporated Hooper or would not have
22 combined it with the other references. And we can see from Dr. Stein's
23 testimony here, on slide 30, that there would've been reasons for a person of
24 ordinary skill in the art to make that combination. Not only it would've
25 made ease of manufacturing and maintenance more advantageous to have
26 easy access to insert and remove the locking piece in the locking

1 mechanism, and the arrangement shown in Hooper, with a two-piece cap
2 that separates at the locking piece, would have facilitated that ease of
3 manufacturing and maintenance.

4 Now, Patent Owner has relied on their expert testimony, which said,
5 essentially, that Dr. Reffeor couldn't think of any reason to combine the
6 references. And that's not a surprise because if we look at slide 33, Patent
7 Owner's expert did not review the Motion to Amend, did not review
8 Petitioner's opposition, did not review any of Dr. Stein's testimony on the
9 matter.

10 And so, this testimony from Dr. Stein, for example, talking about the
11 motivations to combine Hooper with the other references was just not in
12 front of Patent Owner's expert.

13 JUDGE SCANLON: I did have a question in your opposition about
14 this cap seat and cap cover configuration. It seems the opposition first
15 seemingly says to make the modification to Rousselle and Ohnishi based on
16 routine design changes. And then, after that, it talks about Hooper. And do
17 you rely on Hooper -- entirely rely on Hooper for this aspect, or is it more of
18 an alternative design choice, or rely on Hooper?

19 MR. REEVES: Thank you, Your Honor, for that question. I would
20 say Hooper is our primary argument here.

21 JUDGE SCANLON: Okay.

22 MR. REEVES: That said, I believe that a person of ordinary skill in
23 the art would have been able to make this modification as a routine design
24 choice without relying, necessarily, on any particular reference. That said,
25 given that we have a reference clearly discloses it and that a person of

1 ordinary skill in the art would've been motivated to combine, I don't see any
2 reason why we wouldn't rely on Hooper in this case.

3 JUDGE SCANLON: All right. Thank you.

4 MR. REEVES: Looking at slide 31 now, the other reference that is at
5 issue, particularly in the Motion to Amend, is the Seo reference, which
6 discloses a canopy and talks about, among other things, various ways of
7 connecting inner retractable units to a central locking mechanism. And a
8 person of ordinary skill in the art would have been motivated to incorporate
9 these teachings from Seo with the other references for the reasons that
10 Dr. Stein provided, for example, here, on slide 31, and on the next slide as
11 well.

12 So, here, we can see that the structure of Seo has these two connection
13 pieces 256, which extend out on either side of a connecting rod 201, and
14 they're attached via a pin connection. And Dr. Stein testified that this would
15 provide a sturdy, durable, easy-to-manufacture, and easy-to-maintain
16 connection with the connecting rods, so a person of ordinary skill would
17 have been motivated to make that combination.

18 And looking at slide 32, we can see that Seo has a locking mechanism
19 towards the bottom of its central structure, and those inner retractable units
20 are attached to the connection pieces above that locking mechanism, which
21 Dr. Stein testified would be advantageous because the user would be able to
22 operate the locking mechanism from below without the connecting rods
23 getting in the way.

24 So both Hooper and Seo, here, are available as prior art to the '738
25 patent, and a person of ordinary skill in the art would have been motivated to

1 use their disclosure to improve the combination of Rousselle, Tsai, and
2 Ohnishi.

3 If the Panel doesn't have any further questions on the Motion to
4 Amend, I'd like to briefly talk about the collateral estoppel arguments.

5 JUDGE SCANLON: Sure.

6 MR. REEVES: And so, the collateral estoppel arguments apply to the
7 original claims, Claims 1 and 4. And these are based on an earlier
8 proceeding that I think some of our Panel may remember quite well, in
9 which very similar claims in a patent owned by the same patent owner were
10 invalidated as obvious.

11 So, looking at slide 36, collateral estoppel applies in a patent
12 proceeding when these four factors apply. And the factor that's been
13 disputed here is factor number 1: whether the issue is identical to the one
14 decided in the first action.

15 Turning to slide 37, the case law tells us that collateral estoppel
16 applies so long as any differences between the claims at issue do not
17 materially alter the question of invalidity. And that is the case here, as we
18 explained in detail in the petition, and I won't go through each of those
19 limitations here now. But the upshot is the complete identity of the claims is
20 not required to satisfy this first factor where the issues must be the same.

21 And turning to slide 38, I'd like to just point out that one of the things
22 that the Patent Owner has argued, as far as why the issues are not the same,
23 is that there is this issue between the primary modification and the
24 alternative modification and that this wasn't presented as an issue in the first
25 case.

1 The problem with that argument is that what Petitioner argued in that
2 first case was, first of all, in Ground 1 of the original case, that a person of
3 ordinary skill in the art would have included Tsai's retractable units in
4 Rousselle's canopy, which is the same thing as the primary modification
5 being argued here.

6 And then, in the first case in Ground 3, Petitioner argued that one
7 could start with Tsai's canopy and add Rousselle's center lock, which is, of
8 course, the same alternative modification that's been discussed here.

9 So there really was nothing stopping the Patent Owner from making
10 that argument in the first case. They merely chose not to. And this is
11 exactly the situation that the collateral estoppel doctrine is meant to prevent
12 where there could be a risk, for example, of inconsistent verdicts between
13 the two cases, simply because the Patent Owner decided to make different
14 arguments in the second case, taking a second bite at the apple, as opposed
15 to the first case where their arguments did not carry the day.

16 And with that, unless there are any further questions from the Panel,
17 that concludes my presentation.

18 JUDGE SCANLON: All right. Thank you. I have no further
19 questions.

20 MR. REEVES: Thank you.

21 JUDGE SCANLON: So, you have a little over 18 minutes remaining.

22 And so, Patent Owner, when you're ready, you can take the podium.
23 Do you know how much time you might want to reserve?

24 MR. JOHNSON: Thank you, Your Honor. I'd like to reserve eight
25 minutes.

26 JUDGE SCANLON: Okay. You can proceed when you're ready.

PATENT OWNER ARGUMENT

MR. REEVES: Okay. Before I get into -- excuse me; I'm going to adjust -- just a second. Before I get into my main presentation, I want to address three areas that Petitioner specifically focused on that has to do with our expert, it has to do with analogous art, and it has to do with motivation to combine because I think those three issues are important -- an underlying issue throughout the whole case.

So, first of all, with respect to our expert, Petitioner made some comments in the filings and today, at the podium, basically indicating that -- implying or stating that there's something wrong with our expert's testimony -- should be given little or no weight, I think is the terminology that was used in the actual papers. And the reason was that because they claim that Dr. Reffeor's entire understanding of Petitioner's prior art arguments came from counsel. So I want to point out a couple of things with respect to that.

First of all, we're not aware that Petitioner ever challenged Dr. Reffeor's, our expert's understanding of what Petitioner's prior art arguments were, or indicated that her doing that -- her understanding was correct. And certainly, they would have done that if that were the case, I believe.

But more importantly for the Board, Dr. Reffeor's task as an expert was to review the references and the claims and, using her position, expertise, knowledge, and status as a person of skill in the art to determine, based on those things, what a POSITA would do with that, whether they would make the combinations, whether the elements were present. She was supposed to offer that opinion based on those references and the claims, not

1 based on what someone else said or thought the claims or the prior art
2 should have indicated.

3 And the record shows that there are many areas where Dr. Reffeor's
4 testimony countered Dr. Stein's testimony, disagreed with it. And I think the
5 fact that she reached this conclusion based on her review of the references
6 and claims without having looked at Dr. Stein's arguments, Petitioner's
7 arguments, I think that strengthens, not weakens, the validity, the value of
8 her testimony as one skilled in the art.

9 So I would just ask the Board to consider that as they're -- it's up to
10 you to weigh the testimony, but I think that's something important to
11 consider. I think that's not a negative. I think it's a positive because she did
12 what she was asked to do. She gave an opinion based on the references and
13 based on the claims.

14 I also want to talk briefly about the motivation to combine, to
15 combine in hindsight. So, one thing you've seen throughout our papers is
16 that we have argued that there isn't a motivation to combine, that Petitioner
17 has used impermissible hindsight bias. And in order to avoid that -- one way
18 to avoid that is to have clearly articulated reasons supported by the evidence
19 as to why there is a motivation to combine references.

20 And in some cases, there's not only a motivation to combine that's
21 lacking, as we've argued in our papers, but in some cases, there are
22 suggestions in the references to go opposite the direction of where the
23 Petitioner wants the references to go. Now, they have argued that those
24 don't go so far as to be a teaching against, but I would remind the Board that
25 it's the burden of the Petitioner to prove a motivation to combine. It's not the
26 burden of the Patent Owner to disprove a motivation to combine.

1 But certainly, if something is in the reference that suggests or teaches
2 away from the direction or moves you in a direction away from where the
3 Petitioner wants to go, I would say that undermines their case that there is a
4 motivation to combine.

5 The other thing I want to mention is, there are a lot of citations in the
6 papers where Petitioner will say Patent Owner's expert said that something
7 could be done or that a reference said something that could be done. And I
8 think it's important to recognize a distinction here, a distinction between
9 could/might, which I don't believe indicates a motivation to do something or
10 would move something in a direction, and would or should.

11 So, a statement that just simply states something could be done
12 without any specifics or encouragement to do that, that's different than
13 encouraging someone to go in a specific direction. And certainly, if a
14 reference goes the other direction and says something that discourages you
15 from going a direction Petitioner wants to go, you certainly can't say that
16 that encourages or motivates someone to go in the direction that's
17 discouraged in the patent.

18 So, when we suggest -- and we do -- that the references teach away or
19 teach in a certain direction and the Petitioner argues that they don't teach
20 away, you still need, I believe, to evaluate that statement. If it doesn't go as
21 far as to teach away, at least it needs to be evaluated in the context of
22 whether the reference actually provides a motivation to go in the other
23 direction. And I would argue it does not.

24 And I also want to say that if a reference discourages going in a
25 certain direction, even if it doesn't constitute teaching away, if it goes against
26 the Petitioner stating that the reference provides a motivation to go in that

1 opposite direction. And I think it also calls into question expert testimony
2 that says it would be likely that the reference would be combined.

3 The expert has the references in front of them. The reference is
4 discouraging going in a certain direction. It's discouraging from going in the
5 Petitioner's direction. Then we would argue it's hard for an expert to
6 credibly say that those references should be combined if the reference is
7 suggesting you don't go in that direction.

8 And if the expert is going to go against what the reference is at least
9 suggesting, I would argue that they have to have strong, articulated
10 reasoning and evidence that would say where does that motivation come
11 from. And our position is that that's been lacking, and that's been pointed
12 out in our papers.

13 And lastly, a key part of what the Petitioner's burden is is to prove this
14 motivation to combine. And the issue is -- and there are cases that support
15 this -- it's whether a skilled artisan not only could have made but would have
16 been motivated to make the combinations or modifications. It's not enough
17 to just know it, say could. There must be a reason for combining that needs
18 to -- there has to be an existing reason to combine.

19 And one other final way to avoid impermissible hindsight is to make
20 sure that there's a meaningful boundary when you're talking about drawing a
21 line in terms of what is analogous art. Otherwise, the exercise just becomes
22 looking back. You have the patent in front of you that you're trying to knock
23 out. You need to find features. You just continue to draw that circle bigger
24 and bigger in terms of what's the problem to be solved; what is the field of
25 endeavor. You can't just have a moving target on the field of endeavor and

1 problems to be solved and continue to move it based on a need to invalidate
2 the patent.

3 And I submit that the more that you're getting references through that
4 process, that are from very varying fields, such as, for example, a structure
5 that's capable of housing people, like a tent, and a jewelry clasp, I think the
6 more you see that happening and the more references there are, the higher
7 the probability that there's improper hindsight being engaged in.

8 So that's the overall context. And now, I want to jump back to the
9 presentation.

10 I'm going to start with slide 2 of our demonstratives. Very quickly,
11 this just points out that the key elements of the patent for our perspective are
12 the legs, outer retractable units, inner retractable units, and the central lock.

13 You'd go to page 3 -- slide 3. This just shows, on the left-hand side,
14 this is the central lock that we're talking about. If you look at the second
15 middle figure, it shows the outer and inner retractable units. And then
16 finally -- and this is important -- if you look on the right-hand side, this
17 shows the folded state that is talked about in our patent.

18 Slide 4, obviously, our position is that the challenged claims are
19 patentable, and the substitute claims are patentable. I'm not going to go into
20 a lot of detail on this right now. I'm going to cover it on future slides.

21 The primary and secondary modifications on slide 5 were already
22 discussed, but we would point out -- and I'll point out a little bit farther down
23 -- that the pivoting motion of the leg of Rousselle is key. And there's
24 nothing in Rousselle that teaches another solution other than having a
25 pivoting leg. And again, I go back to the distinction between could and
26 would or should.

1 We believe the primary modification fails for at least two reasons. I'm
2 on slide 6. It's inoperable, and a POSITA would not combine Rousselle and
3 Tsai.

4 Referring to slide 7, there's no question that Rousselle uses pivoting or
5 inverting legs.

6 Slide 8, and this has been discussed earlier and extensively in the
7 papers. The primary modification can't unfold or pivot if you have, on slide
8 8, the X-shaped outer units connected to the legs, and that's what's required
9 in order to meet the claim elements. But if you do it, it does not function. It
10 does not go to the collapsed state.

11 JUDGE SCANLON: Excuse me.

12 MR. JOHNSON: Yes.

13 JUDGE SCANLON: How do you answer Petitioner's argument that
14 the legs 310 don't actually need to be inverted?

15 MR. JOHNSON: I would say, so first of all, again, we're talking
16 about what the references teach -- and I will point out in a slide or two --
17 there is absolutely nothing in Rousselle that would suggest anything other
18 than an inverting leg, so going to the motivation to do it.

19 The second thing is -- and this was picked up under earlier
20 questioning -- the point of this is a collapsible canopy. And the question
21 would be, if you have a canopy like Rousselle that collapses into the small
22 state that Rousselle collapses in -- and that's shown on slide 9 -- what is the
23 motivation to go away from that to an embodiment where the legs --
24 basically, you're not collapsing it all in the vertical direction, just looking at
25 this figure. You've got something that's at least twice as tall as what's shown
26 in the figure. If the point is to -- and the point is a collapsible structure, and

1 you already have one that goes all the way down, then there is no motivation
2 to go there.

3 I'd like to go to slide 11, and this is just support what I said earlier that
4 everything that is shown in Rousselle shows having these inverting legs.
5 And so, you can see Figure 18(A) from Rousselle. You can see Figure
6 19(B) from Rousselle. These all include inverting legs.

7 And if you go to slide 12, we're just pointing out the -- we're pointing
8 out the fact here that Rousselle is an umbrella tent, and it has flexible legs,
9 and that they have to be flexible. There's a quote in our papers from the
10 expert, from the deposition, that the structure can't be erected unless those
11 legs are flexible.

12 If you go to page 13, and this is another point in support of the fact
13 that Rousselle doesn't -- and this is to the point of would you take the X-
14 shaped external folding units and add them to Rousselle. These are the other
15 examples of tents that are shown in Rousselle, on the right-hand side of slide
16 13.

17 You'll note that none of them show any kind of a connection between
18 any of the legs. They're simple, lightweight, flexible structures. They don't
19 have those connections. And if you added the -- and again, going back to
20 the motivation, what is the motivation from taking a lightweight, collapsible
21 structure and adding external connections between the legs as you would
22 have to do if you added Tsai to Rousselle?

23 In fact, our expert stated that not only is there no need in Rousselle,
24 implying a need for additional support between the legs, she also notes that
25 Rousselle's structures, and similar structures, don't have connections
26 between the legs, and they wouldn't be desirable. So this goes to motivation

1 to not do it because of added weight, cost, and complications that the
2 connections would introduce. And again, what's the benefit?

3 And on page 14, I'm just --

4 JUDGE HOSKINS: Mr. Johnson?

5 MR. JOHNSON: Yes.

6 JUDGE HOSKINS: Petitioner points us to some disclosures in
7 Rousselle that talks about using with different kind of frame structures, so
8 why isn't that enough for Petitioner's motivation to add the X-members from
9 Tsai to give you a more stable frame structure when Rousselle specifically
10 says you can use frame structures other than what's disclosed in Rousselle?

11 MR. JOHNSON: So I'm going to have to -- my understanding of that
12 was that it was discussing using different leg structures, not necessarily --

13 PARTICIPANT: Slide 11.

14 MR. JOHNSON: Okay. And I'm sorry. Could you rephrase the
15 question or paraphrase it?

16 JUDGE SCANLON: You're on mute, Judge Hoskins.

17 MR. JOHNSON: Oh, I'm sorry. Never mind. So the question was if
18 Rousselle suggests that, again, I would go back to -- we're talking about a
19 motivation here to do this, and simply making a statement that structure A
20 could be used with other structures, I think that goes into the could, right?

21 I mean, there's no suggestion or motivation to do anything specific
22 there, if that is the statement -- if the statement that you made is accurate in
23 terms of what was in the record. There's no motivation there. I could do a
24 lot of things. The question is, for motivation, I need to articulate why it
25 would be a good idea to do it, and there's nothing that I can recall from

1 Rousselle that would motivate you or that states there is a motivation to use
2 this with, you know, connecting the legs.

3 JUDGE HOSKINS: But as I understand your argument -- am I still
4 on mute? Oh, okay. So, as I understand your argument, you're saying
5 Rousselle wants this kind of super collapsible structure that's easy to
6 assemble and disassemble. And in the petition, they point us to some
7 disclosures in Rousselle that says you can use other frame structures that are
8 -- than as what is actually shown in Rousselle.

9 So, when you put those two things together, I'm kind of wondering
10 why it is that a person of ordinary skill in the art would feel limited to the
11 kind of super flexible, super collapsible structure of Rousselle, when
12 Rousselle may have disclosures that say that its frame can have other
13 structures.

14 MR. JOHNSON: Well, I think, again, I think it's a could versus
15 would or should. The question would be is there anything in Rousselle that
16 says you would -- that would encourage you to go look for additional frame
17 structures?

18 Now, Rousselle shows -- again, on slide 13 -- shows a number of
19 different tent frame structures. And you know, my -- I mean, I don't know if
20 this is what Rousselle was referring to, but theoretically, this is what
21 Rousselle -- what the Rousselle lock could be used for, but I don't see
22 anything there, again, that shows cross members between the legs, and I
23 don't see a motivation anywhere in the reference to do it.

24 And again, we have expert testimony that says a POSITA would not
25 do that because it adds weight. It adds cost. It complicates things. So, I

1 mean, I guess that's all I can say on that one is I just don't see -- I don't see a
2 motivation. And again, a could versus would or should.

3 JUDGE HOSKINS: Thank you.

4 MR. JOHNSON: So, back on slide 14, just briefly, it shows Figure 1
5 of Tsai, and then talks about a couple of the features of Tsai, which includes
6 leg locks, the legs are connected, as we already discussed, activation is at the
7 legs. And I'm going to talk a little bit more about Tsai in detail in a few
8 slides, but this is just a summary. And Tsai disparages solutions that use a
9 center strut for at least a couple of reasons.

10 So, in summary, on the primary modification, our position is that a
11 POSITA would not combine Rousselle and Tsai. It would be inoperable,
12 and there's no rationale for combining them, given Tsai's teaching and
13 disparagement.

14 So, moving on to the alternative modification, which was already
15 discussed by Petitioner's counsel, which would basically be adding the lock
16 structure of Rousselle into Tsai, we -- our position is that fails for two
17 reasons. One, it would inoperable and non-functional. And two, a POSITA
18 would not combine those references.

19 First of all, referring to slide 17, our position is that Tsai can't be
20 driven by a center lock, which is a requirement of Rousselle. And the reason
21 is, there is canopy supporting rods. And these would be 3, which you see in
22 Figure 1 of slide 17. Those are disclosed as being flexible, arched members
23 to hold up canopy material. Our expert also supported that in that pointing
24 out that they're flexible rods.

25 JUDGE SCANLON: So, if I can ask a question, so the rods are
26 flexible, but is your argument that then they're -- because they're flexible,

1 they're not strong enough to transmit the force that would be required to
2 open the frame from a folded state?

3 MR. JOHNSON: Correct. I mean, the analogy would be pushing on
4 a rope. It's not quite a rope.

5 JUDGE SCANLON: Yeah.

6 MR. JOHNSON: But the analogy is that -- I mean, the fact is they are
7 shown as being bowed, for example. And you can see that from the figure.
8 I believe Tsai talks about one of the reasons they're bowed is being that they
9 need to be bowed so that they can better support the canopy.

10 And so, you have a continuum of something that's stiff versus flexible.
11 And going down that continuum to the flexible members like these, and if
12 you're talking about Tsai, if you look at the Tsai structure -- and I believe
13 this was also in our papers as well -- those are substantial -- if you look at
14 back on Figure 17, if you look at the legs, for example, you look at the outer
15 X-shaped members, for example, those all are substantial in the figures.

16 And so, now, you are driving the outward motion of setting up this
17 canopy from the center through these flexible members. You're driving
18 members that are substantial. And our position is that that's not going to
19 work. And that's the position of our expert as well.

20 JUDGE SCANLON: Okay. So what about Petitioner's argument that
21 one of skill in the art -- ordinary skill in the art would know how to
22 overcome that issue? If the rods 3 were too flexible, one of ordinary skill in
23 the art could figure out how to overcome that issue. And I think, and tell me
24 if this is wrong, but Petitioners said that your expert has more or less agreed
25 with that. And I'm referencing Petitioner's slide 16, where they cite Exhibit
26 1101, page 41.

1 MR. JOHNSON: So I don't think our expert disagreed that, you
2 know, one of skill in the art can figure out how to make things stiffer or, you
3 know, more flexible. Again, I think the issue is the why. Why would you
4 do that? What is the motivation to do that? And I don't think Petitioner has
5 provided motivation for doing that.

6 And again, that's going to come at a trade-off because Tsai, if I'm
7 recalling correctly, said the reason we have that is because we need that to
8 be able to support against the canopy. So, obviously, there's a trade-off.
9 The stiffer you make it, the less it's going to be able to perform the function
10 that Tsai says it has to perform.

11 JUDGE SCANLON: Well, why would making it stiffer prevent it
12 from supporting the fabric of the canopy?

13 MR. JOHNSON: So, my assumption is, from looking at Tsai, that
14 you have a canopy that is flexible. Obviously, it's going to collapse down
15 with the structure. So you need to be able to put some pressure on it. And I
16 guess it -- I don't know. It's implicit to me that you would need to have
17 some flexibility in order to have that member putting pressure on it. But
18 again, that's me talking, attorney argument.

19 JUDGE SCANLON: All right.

20 MR. JOHNSON: I think the expert is on the record as saying that you
21 wouldn't do it and the reasons for that, so --

22 JUDGE SCANLON: All right. Thank you.

23 JUDGE GROSSMAN: Before we leave that topic -- this is Judge
24 Grossman. I just want to -- we've been talking a lot about the prior art and
25 what the experts say without a lot of focus on actually what's in your claims.
26 Where is the -- the references talk about a tent canopy material, and the

1 objective of all tents are to hold the canopy up so that people can get inside
2 or under the tent. And you say that the references are too flexible; they're
3 arched, and they need to hold up the canopy material.

4 Where's the language in your claim that gives you a distinction over a
5 flexible, arched member to hold up canopy material? Because your tent
6 also, the objective at the end of the day is to make sure that the canopy
7 material is held in place when it's erected.

8 MR. JOHNSON: Yes. If I'm understanding your question correctly, I
9 think the issue isn't whether we claim that feature. What we're arguing is
10 that if you have a POSITA looking at the two references and looking at what
11 Tsai teaches and what Rousselle teaches, because of those things, they
12 would not be motivated to combine those references.

13 So not -- it's not directed to our claims per se. It's more directed to
14 why would they combine or not combine the references. And that's not the
15 only -- the stiffness or flexibility of those members isn't the only reason that
16 we say that it would be combined, but that would be my answer to your
17 question.

18 JUDGE GROSSMAN: Now, what about the level of skill -- and
19 we've been talking a lot about what would or would not have been obvious
20 to a person of ordinary skill and what would be the motivation to combine
21 things. The level of ordinary skill is a degreed engineer. I think we talked
22 about mechanical engineering or the relevant technology like that, with some
23 experience.

24 And doesn't an engineer going to pick the right amount of flexibility
25 for the size of the tent, the right amount of arch, the right amount of
26 stiffness, the size, the trade-off of benefits of how compact should it be

1 folded? Can it be long when it's folded, or should it be short when it's
2 folded? Should it be thin when it's folded, or can it be wider when it's
3 folded? Aren't those all just simple design objectives that a degreed
4 engineer with a couple of years of experience would choose the right tool for
5 the job?

6 If it's a big, heavy tent, it might be a little less flexible. If it's a small
7 light tent for one person, it could be a little more flexible. Aren't those just
8 normal trade-offs that any engineer would make in designing a product?

9 MR. JOHNSON: I think engineers certainly are capable of making
10 trade-offs like that. I guess I'd go back, again, to the question of where is the
11 motivation to do it? Where is the motivation to combine the references?
12 And we don't see that motivation in the references themselves; that's our
13 argument.

14 And we don't see an articulated evidence-supported basis for making
15 those combinations either. So that would be our point. Not that engineers
16 aren't capable of making design trade-offs like that, but you know, the
17 question is these references and whether they would be combined and why
18 they would be combined, I guess, the motivation to do that, if that makes
19 sense.

20 JUDGE GROSSMAN: I understand. Thank you.

21 MR. JOHNSON: Okay. I'm going to move fairly quickly to slide 18.
22 Another reason for not combining Tsai with Rousselle in the primary
23 modification is to -- is because Tsai clearly teaches activation at the legs, not
24 at the center. So, again, and if you look at slide 18, there's support there in
25 the specification. Again, that's another reason to consider as to why would
26 you do this. You have activation at the legs.

1 If you go onto slide 19, Tsai specifically disparages the use of center
2 strut -- central strut solutions. It gives a couple of reasons there: requiring an
3 extra person.

4 And I'm going to go on to 20. Tsai teaches away from manual
5 pushing. If you look at the very last quote on the right-hand side, bottom of
6 that slide, need not be manually pushed to its unfolded orientation. And
7 again, even if --

8 JUDGE SCANLON: I'm sorry to interrupt you, but I did -- in your
9 introductory remarks, you talked about teaching away. And are you kind of
10 shifting off of that argument? It sort of sounded like you weren't necessarily
11 asserting any longer that Tsai teaches away. Although, here, you are saying
12 it teaches away. So I thought --

13 MR. JOHNSON: What I'd say is, if it doesn't teach away, it certainly
14 can't be taken for the opposite side of that argument, which is encouraging or
15 motivating somebody to do it. So what my point was, and I think Petitioner
16 has argued, that you know -- and on a number of cases, this doesn't teach
17 away. This doesn't teach away. Okay.

18 Well, if it doesn't teach away, if the Board finds it doesn't teach away,
19 there is a space between teaching and motivating for someone and teaching
20 away, and I think they need to be in the position of being able to point to
21 things that encourage you to do something if you're going to say there's a
22 motivation to do it.

23 And I think, again, the motivation to combine is key. Otherwise,
24 we're going to see of taking claims that are out there and then backward-
25 looking, finding patents that have them, and then there's -- they're there. So,

1 therefore, it would be done, and it's obvious. And we know that's not the
2 case. And that's our point on that.

3 JUDGE SCANLON: So it's more of an alternate argument and not
4 really abandoning teaching away arguments.

5 MR. JOHNSON: Correct. Correct. Yep.

6 JUDGE SCANLON: All right. Very good. Thank you.

7 MR. JOHNSON: In terms of, again, why Tsai would not be
8 combined with Rousselle, if you look at slide 21, Tsai uses the leg locks.
9 And Tsai says that those leg locks are better than other locking assemblies.

10 So, again, going to the motivation to even make this combination, if
11 you have a solution that has allegedly better -- a better locking system that
12 provides more structural support because it has leg locks on the four legs,
13 why do you make this combination? And we just don't think there's a
14 motivation to do it.

15 So, in summary, with respect to combining Tsai and Rousselle, slide
16 22, Tsai teaches a person of skill in the art to unfold it at the legs, not at a
17 central mechanism, to lock it at the legs, not centrally, not to use the center
18 strut/lock/activation -- in other words, not to unfold it from the center -- and
19 not to push it at the canopy's center.

20 So I'd like to quickly move on to the substitute claims. Slide 24, first
21 of all, we have --

22 JUDGE HOSKINS: Mr. Johnson, just a quick question before you
23 move on.

24 MR. JOHNSON: Sure.

25 JUDGE HOSKINS: I think one of the things Petitioner said with
26 respect to your Ground 2 -- with respect to Petitioner's Ground 2 in the

1 petition is that you didn't make any separate arguments versus Ground 1 in
2 the petition. Is that correct?

3 MR. JOHNSON: I believe our primary argument has been Ground 1
4 and not Ground 2.

5 JUDGE HOSKINS: Okay. Thank you.

6 MR. JOHNSON: So, with respect to substitute claims, the key
7 elements of these are, one, there's a structure of a center bottom cap that is
8 spelled out. It's two pieces: a bottom cap seat, a bottom cap cover, with the
9 bottom cap seat being between the bottom cap cover and the top cap. So
10 that's a specific -- summarizing specific language that was added in the
11 substitute claims.

12 Number two, a connecting rod that is hinged at the bottom cap seat, so
13 there are very specific locations and functions that are called out here. And
14 number three, specifically reciting the movement to the unfolded state by
15 pushing the center bottom cap up to drive it to unfolding. So that's the gist
16 of the substitute claims. And our focus right now is on Claim 15.

17 If you look at slide 28, what we want to point out here is we have five
18 references that are involved in getting to an alleged Ground of Rejection for
19 these revised claims. We have Rousselle, which is a shelter tent. We have
20 Tsai, which is a shelter frame. Then we had a baby carriage, Ohnishi. Then
21 we go to a jewelry clasp, Hooper. And then we go to Seo, back to a
22 collapsible canopy to get a final element.

23 And if you go to slide 32 -- actually, I'm sorry. Go back. Let's go to
24 slide 29. The point here being Rousselle and Tsai alone don't teach all --
25 don't invalidate any of the claims.

1 Slide 30, if you add the baby carriage, you still aren't invalidating any
2 of the substitute claims, in terms of having the required elements.

3 If you go to slide 31, adding the jewelry clasp of Hooper, you're still
4 not there.

5 And finally, when you add Seo, is the first time that Petitioner is even
6 able to present a proposed Ground of Rejection. So the point of this being --
7 and I talked about this earlier in terms of analogous art and how big do you
8 draw the problem statement and how big do you draw the field of endeavor
9 -- this is a pretty wide range, all the way up from a small, tiny jewelry clasp,
10 all the way up to a habitable structure.

11 Our point being that when you're seeing things like that, I think we
12 need to be aware that perhaps the patent is being used, the claims are being
13 used, and hindsight bias is being used to just go pick references and then
14 change the field of endeavor and the problem statement so that you can get
15 what you need to invalidate the patent.

16 Moving on to slide 34, our argument is that Hooper is not analogous
17 art. And that just basically states from the MPEP what the standard is for
18 analogous art. Our point is that Hooper is not from the same field of
19 endeavor. Hooper is directed to a jewelry clasp.

20 And we believe Petitioner has moved the goal post on the field of
21 endeavor, starting out from collapsible tents or canopies or locking
22 mechanisms for collapsible structures, and that was from their petition and
23 also from their expert's declaration. Hooper is not directed to those fields.
24 So then it was recharacterized to be simply locking mechanisms, a very,
25 very broad category.

1 We would further argue that it's not pertinent to the problem being
2 faced by the inventor. And if you go to slide 37, we have the same issue
3 where there was kind of a sliding scale on whether it's pertinent or not, and
4 we disagree. And we show you on that slide how they moved from
5 something involving canopies and collapsible structures simply to locking
6 mechanisms.

7 And I see that I have gone over my time. So I'll stop now.

8 JUDGE SCANLON: All right.

9 MR. JOHNSON: Unless you have other questions. I'll go ahead and
10 take any questions that you have.

11 (Simultaneous speaking.)

12 JUDGE SCANLON: -- rebuttal time, but --

13 MR. JOHNSON: So our point on that would be that Hooper is not
14 analogous art. And we have a statement on slide 38 from our expert that
15 goes into detail as to why that is the case that Hooper is not analogous.

16 And we also have additional conclusions on 39 as to why a POSITA
17 wouldn't combine those references. They're not analogous. There's no
18 benefit for a collapsible canopy.

19 And then, on slide 40, with respect to Seo, we would point out -- and
20 again, Tsai had disparaged canopies that had a center strut solution because
21 of the decreased headroom and for other reasons. And we would just point
22 out that, in slide 40, that Seo has the same type of canopy. So, for the same
23 reasons, you wouldn't add Seo into the combination. And we have expert
24 testimony that also supports that.

1 One final point on Seo, Seo, again, like Tsai, talks about activating or
2 deploying the canopy using the legs. I'm on page 43 now. And it has leg
3 locks, but those leg locks are independent from any central mechanism.

4 And so, the bottom line is you could still have the leg locks locked
5 and fold or unfold the tent. So, therefore, it can't be -- the tent can't be
6 collapsed or erected from a central location because it's completely
7 independent of the leg movement as described in Seo.

8 And then, on slide 45, we also argue that -- so Seo teaches a single-
9 component design for the lower central hub. All of the cited canopy
10 references -- this is slide 45 -- all of the cited canopy references teach a
11 single component with a center bottom cap structure. And only Hooper, out
12 of all the references, suggests a separated design.

13 So, basically, they went out, realized they needed a lower unit that
14 was separated and found Hooper, which is a jewelry clasp -- which, again,
15 we argue is not analogous -- and use that to separate out the structure. And
16 we just think that's a bridge too far again, in terms of what art is analogous
17 and using hindsight to go out and find references to get what you need.

18 Going to slide 46, and again, our claims talk about --

19 JUDGE GROSSMAN: Before we switch to slide 46 -- this is Judge
20 Grossman.

21 MR. JOHNSON: Sure.

22 JUDGE GROSSMAN: I want to go back and ask a question about the
23 non analogous art and scavenger hunt argument about choosing references
24 from tents to baby carriages to jewelry clasps. And if you know -- it'll be in
25 the record, but I don't know off the top of my head. Is there any overlap in
26 the patent classifications or the examiner's search classifications among the

1 various references, specifically Ohnishi and Hooper's, the jewelry clasp and
2 baby carriage? Are they classified in -- with the examiner's search for cover
3 classifications of those references which overlap with classifications of the
4 collapsible canopy/tent-type references?

5 MR. JOHNSON: And I have to apologize. I do not know the answer
6 to that.

7 JUDGE GROSSMAN: Oh, there's no apology. It's I was starting to
8 look it up, and it was taking too much time. And I thought, well, maybe you
9 might know the answer off the top of your head. Because the searches of all
10 those various references were -- the initial classifications were
11 straightforward, but the examiner's searches were more detailed, but thank
12 you.

13 MR. JOHNSON: Okay.

14 JUDGE GROSSMAN: You don't need to apologize for not knowing
15 that detail.

16 MR. JOHNSON: Oh, you're welcome. I'm going to stop right now,
17 and just, for the record, just because I didn't get to certain arguments or
18 certain slides, we're not waiving any of the arguments we made in any of the
19 papers. So I will stop now and reserve the rest of my time.

20 JUDGE SCANLON: All right. Thank you. And I think we did have
21 a lot of questions, so if Petitioner doesn't object, I think we'll give Patent
22 Owner five minutes for rebuttal.

23 If you need some extra time in your rebuttal, you're entitled to it as
24 well.

25 MR. REEVES: No objection.

1 JUDGE SCANLON: So, right now, you have a little over 18 minutes,
2 and just proceed when you are ready.

3 PETITIONER REBUTTAL ARGUMENT

4 MR. REEVES: Thanks, Your Honor. I'd like to begin by talking
5 about the original claims. And I think that this case becomes really simple,
6 with respect to the original claims.

7 So we heard Patent Owner ask -- I lost count of how many times --
8 where is the motivation, where is the motivation? And the motivation is
9 stability, and it comes from Tsai. So Tsai has that motivation on page 2,
10 lines 26 through 32, when it says that adding those outer retractable units
11 increases the stability of the canopy. That's all the person of ordinary skill in
12 the art needs. That's the motivation. Everything else is just basic
13 engineering that a person of ordinary skill in the art would have been well
14 equipped to do.

15 And I think that's really -- I think that's really all we need to get at the
16 original claims and why they are obvious, but I'll address a few other things
17 that the Patent Owner brought up as well.

18 So, if we turn to Petitioner's slide 13, the Patent Owner suggested that
19 inverting the legs in Rousselle is somehow key to the way that Rousselle
20 works, and that's just not the case. For one thing, as Rousselle says, as
21 Patent Owner's expert admitted, as I think both experts agree in this case,
22 Rousselle's structure itself of the canopy is not critical to how the central
23 lock works.

24 So you can see Dr. Reffeor testified that you could use Rousselle's
25 central lock in a canopy that doesn't have the same structural design as any
26 of Rousselle's embodiments. And Rousselle discloses, at column 15, lines

1 59 through 63, that it can be used with other frame structures. And that's not
2 limited to just the legs. That's the entire canopy.

3 And as Dr. Stein testified at Exhibit 1102 paragraph 11, Rousselle's
4 focus is on the central lock. And the modifications that the Petitioner has
5 proposed maintain that function and that structure of the central lock exactly.

6 So, really, the structure is all there. And the motivation is there. And so,
7 there's nothing missing that the claims would have been obvious to a person
8 of ordinary skill in the art.

9 We heard some discussion about the weight and the flexibility and
10 whether certain pieces of the canopy would have been too heavy or too
11 flexible to unfold. And that too is well within the skill of a person of
12 ordinary skill in the art to adjust.

13 Patent Owner's expert testified -- we heard that the inner units in Tsai
14 would be incapable of unfolding the canopy because the canopy is too
15 heavy. But Patent Owner's expert admitted on cross-examination, at Exhibit
16 1101 -- that's page 67, lines 5 through 13 -- that she didn't consider the
17 weight of Tsai's outer retractable units at all when forming her opinion.

18 And Dr. Stein testified -- Exhibit 1102, paragraph 20 -- that a person
19 of ordinary skill in the art would have been able to adjust that weight, adjust
20 the materials as needed to provide a flexible canopy if it was needed, to
21 provide a strong canopy if it was needed to make it all work.

22 I also want to address a few arguments that were made about the
23 proposed substitute claims and this idea of, you know, a scavenger hunt or
24 references that are not analogous. Patent Owner suggests that we, in using
25 five references, some of which are canopies and some of which are not, that
26 this poses some kind of a problem.

1 The reality is that there are well-established tests and case law for
2 figuring out whether these sorts of things are hindsight or not. That's the
3 analogous art test, which we've shown that Hooper meets. That's providing
4 a motivation to combine and a reasonable expectation of success. And
5 we've done that for each of these references.

6 You'll find that in Dr. Stein's testimony. You'll find that in Petitioner's
7 opposition. Each of the references has a motivation to combine. Each of the
8 references has -- a person of skill in the art would have had a reasonable
9 expectation of success in combining them. And that's really the end of an
10 inquiry. That's what the tests say that Petitioner needs to show, and we have
11 done that.

12 And lastly, just briefly, Patent Owner addressed some various features
13 of the Seo references, talking about it having a center strut or having leg
14 locks, those sorts of things. Petitioner hasn't relied on that structure in Seo,
15 and that structure isn't relevant to the teaching in Seo that Petitioner is
16 relying on, which is how to connect those connecting rods to a central
17 locking mechanism, and where they would be connected. So those
18 disclosures in Seo wouldn't pose any problem for a person of ordinary skill
19 in the art.

20 That concludes my presentation unless the Panel has any questions for
21 me.

22 JUDGE SCANLON: No, no further questions, so thank you.

23 So we added a little bit of time.

24 PATENT OWNER REBUTTAL ARGUMENT

25 MR. JOHNSON: Thank you, Your Honors. I just have a few follow-
26 up points to what Petitioner's counsel just talked about.

1 So Petitioner's counsel mentioned that adding outer units would add
2 stability to Tsai. I would just reiterate that our position has been that if you
3 look at the references holistically -- so there's been discussion in the papers
4 that Patent Owner is allegedly just taking -- you know, treating each
5 reference individually. We think we've treated them holistically and looked
6 at how they would or wouldn't work together and shown -- and we think our
7 experts also shown -- that those combinations wouldn't be made.

8 But we would also make the same point in terms of looking at the
9 references holistically in the sense that you could look at a reference of Tsai,
10 and you can find something that you need and that you think would work in
11 a combination with Rousselle or other things, but you have to look at the
12 whole reference. And again, there are multiple places in Tsai where if they
13 don't teach against, they still would not encourage one to go in a direction
14 that Petitioner is proposing. So I think you need to look at the reference
15 holistically to decide is this something that a POSITA would look at, would
16 use, would want to try to use to combine.

17 Secondly, there was discussion about the statement that Rousselle
18 suggests alternate frames, and that has been used as a basis to say, well, we
19 could use Rousselle with these other frames. What I would point out is that
20 when Rousselle mentions that it could be used with alternate frames, it then
21 points specifically to Figures 18 and 19, which is our slide 11, as examples
22 of what it's talking about.

23 And again, I point out that in those figures, there are no cross
24 members that are connecting the legs. And indeed, in Rousselle, there are
25 no examples of, to my knowledge, of prior art or any other configurations
26 that have those connections between the legs.

1 Counsel also mentioned that their expert provided opinions that
2 supported their claims and arguments that a POSITA would combine the
3 references, and I would just point out that we have expert testimony -- and
4 again, that's expert testimony that was focused on the references themselves
5 and the claims -- that directly contradicts Dr. Stein's testimony.

6 So, and I just would say, obviously, it's up to the Board to determine
7 the weight that it's going to give to various expert testimony. But that's not
8 -- it's not as though Dr. Stein made -- staked-out positions, and they weren't
9 countered. They were countered, but they were countered by the expert
10 looking at the references and the claims and using her knowledge to counter
11 them.

12 And I don't believe that I have anything else at this point unless there
13 are any other questions.

14 JUDGE SCANLON: No questions and thank you.

15 So, okay. Very good. So that concludes the hearing. Thank you,
16 Counsel, for the helpful presentations on both sides. And we are adjourned.

17 And let's go off the record.

18 (Whereupon, the above-entitled matter went off the record at 10:35 a.m.)

PETITIONER:

Marko Zoretic
Nathan Reeves
KNOBBE, MARTENS, OLSON & BEAR, LLP
marko.zoretic@knobbe.com
2ndr@knobbe.com

PATENT OWNER:

Jeffrey Johnson
Jason Murphy
Jared DuJack
SCHMEISER, OLSEN & WATTS LLP
jjohnson@iplawusa.com
jmurphy@iplawusa.com
jdujack@iplawusa.com