

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN PINCAN TECHNOLOGY CO., LTD,
Petitioner

v.

THE RIDGE WALLET LLC
Patent Owner

Case IPR2024-00340
Patent 10,791,808

PATENT OWNER'S PRELIMINARY RESPONSE

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
Ex. 2001	Declaration of Gina A. Johnson
Ex. 2002	Deposition Transcript from Deposition of Chunmei Peng
Ex. 2003	Deposition Transcript from Deposition of Dr. Kimberly Cameron
Ex. 2004	Transcript from June 21, 2023 <i>Markman</i> hearing in USITC Case No. 337-TA-1355
Ex. 2005	Ridge's Answer and Affirmative Defenses to Mosaic's Second Amended Complaint and Counterclaim for Patent Infringement in Case No. 2:20-cv-04556-AB-JC in the Central District of California, dated November 12, 2020
Ex. 2006	Declaration of Dr. Kimberly K. Cameron Regarding Claim Construction of the '808 Patent in USITC Case No. 337-TA-1355
Ex. 2007	Patent Owner's Additional Discovery Requests
Ex. 2008	Expert Report of Kimberly K. Cameron, Ph. D. regarding Invalidity of U.S. Patent No. 10,791,808 in USITC Case No. 337-TA-1355
Ex. 2009	Joint Stipulations for Dismissal in Case No. 2:20-cv-04556-AB-JC in the Central District of California.
Ex. 2010	Order on Claim Construction in Case No. 23-cv-00407-CNS-SBP in the District of Colorado.
Ex. 2011	Final Initial Determination in USITC Case No. 337-TA-1355.
Ex. 2012	Declaration of Inventor Daniel Kane in USITC Case No. 337-TA-1355 (REDACTED).
Ex. 2013	U.S. Patent No. 5,038,985 to Chapin.
Ex. 2014	Rebuttal Expert Report of Thomas Kurfess in USITC Case No. 337-TA-1355.

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I. INTRODUCTION

The Petition for *Inter Partes* Review (“Petition,” Paper 1) is deficient, and review should not be instituted, both because the Petition fails to meet the burden established by 35 U.S.C. § 314, and because it seeks to re-hash old arguments and thus deserves discretionary denial under 35 U.S.C. § 325(d).

U.S. Patent No. 10,791,808 (the “‘808 Patent”) is directed to a novel, non-obvious, modular money clip design that was an improvement over Applicant’s own prior work. It was the wallet described in the Kickstarter campaign the Petition refers to as “Kane” (*See* Ex. 1004) that created the category for compact wallets having the silhouette the consuming public now associates with Patent Owner. Generation two of that product—the version described and claimed in the ‘808 Patent—launched Patent Owner from a humble, self-funded startup to a sophisticated company with domestic activities satisfying the domestic industry requirement at the ITC (*See* Ex. 2011) and substantial yearly revenue derived from its best-selling wallets.

The Examiner was very well aware of the prior art that the Petitioner relies on here during prosecution of the ‘808 Patent. Applicant submitted the pre-grant publication version of the Minn reference (Ex. 1013 at 62) and the Kane reference (Ex. 1013) during prosecution. The Examiner not only considered those references, but used them to reject the claims. Ex. 1013 at 69-75. And of course

the ‘808 Patent issued over those rejections.

The Petition’s cursory treatment of the issue of obviousness, particularly where the primary references of each proposed Ground have already been considered, is fatal to the Petition on the merits. Because the Petition does not establish a reasonably likelihood of success as to any claim by virtue of failing to establish that any of the relied-on combinations is proper, the Petition should be denied on the merits. 35 U.S.C. § 314

As noted, the concepts in the ‘808 Patent improved on the art, including Patent Owner’s own first-generation design, in a meaningful and patentable way. Unsurprisingly given the nascent market when Patent Owner created its first version of the product, examination of the ‘808 Patent confirmed that this very feature is patentable over precisely the prior art presented in the Petition. Both of the “sets” of primary references (i.e., Kane and the combination of U.S. Patent No. 9,125,464 to Minn (Ex. 1005), U.S. Patent No. 5,944,080 to Podwika (Ex. 1009), and U.S. Patent No. 7,527,081 to Coates (Ex. 1011)) were used to reject the claims of the ‘808 Patent during prosecution. Ex. 1013 at 67-75.

Beyond the patentable nature of the claims of the ‘808 Patent, the Petition should be discretionarily denied because it is a last-ditch effort to present an invalidity defense that (a) is inconsistent with Petitioner’s defenses (both presented and deemed waived as untimely) in ITC Investigation 337-TA-1355 (the “ITC

Case”) where a Final Initial Determination has already issued (*see* Ex. 2011) and the Administrative Law Judge (an ex-PTAB Judge) has found a violation and recommended General and Limited Exclusion Orders and (b) merely rehashes arguments already considered (and soundly rejected) by the Examiner. The Board should not alter the Examiner’s (correct) prior determination that the auxiliary feature aspects of the claims of the ‘808 Patent render the claims patentably distinct over that same art.

II. THE BACKGROUND OF THE TECHNOLOGY AND THE ‘808 PATENT

A. Patent Owner’s Creation of the compact wallet market segment

In 2013, sole ‘808 Patent inventor Daniel Kane came up with the first iteration of what would become the iconic Ridge Wallet. Ex. 2012 at Q1-Q3, Q95. Mr. Kane wanted to avoid the bulk of a traditional folding wallet while still providing access to cards, IDs, and the like. Ex. 1012 at Q4. So he came up with a way to integrate elastic into the overall exoskeleton and provide a secure storage while enabling a consumer to carry a wallet that took up as little space as possible. *Id.*

Initially, the Ridge Wallet had a money clip, but it was integrated into the face plates of the Ridge Wallet. *Id.* at Q5-Q6. That is, each plate was a single, integrated part with the money clip. *Id.* That meant that the clip could not be

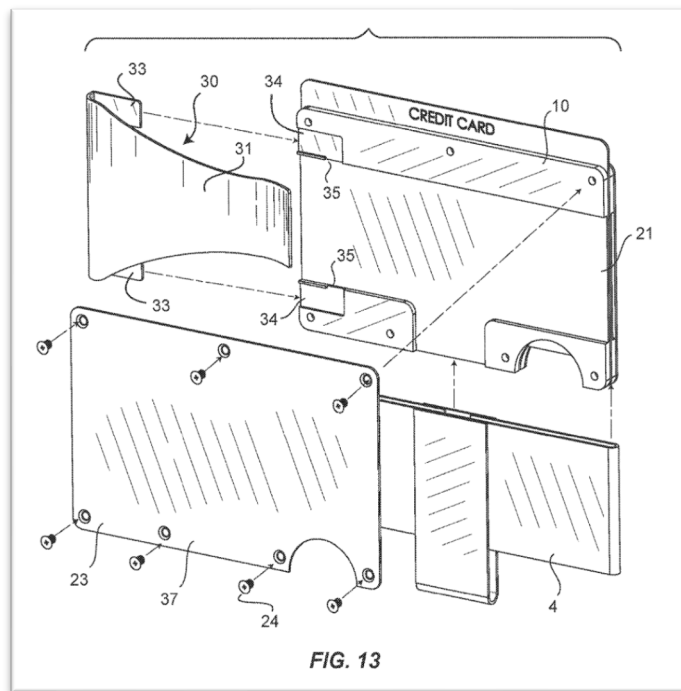
removed or replaced without replacing an entire plate from the wallet. *Id.* It is this product that is described in the reference described in the Petition as “Kane.”

Mr. Kane continued to work to refine the technology following the Kickstarter activity. An important development in Patent Owner’s business was the invention of the technology that was disclosed in the ‘808 Patent. Ex. 2012 at Q7-Q12. In particular, Mr. Kane realized that while the money clip was a great feature, it was not perfect because welding the money clip to the outside of the wallet, or making it integrated into the outermost panel, was just not something that the customers loved. Ex. 2012 at Q16. The product development process led to an invention in which the inner plates were redesigned to accommodate a removable money clip. *Id.* In the new design, the money clip in the new design was sandwiched between the outer plate and the inner plate, and there were interlocking structures between the inner plate and the clip that would prevent the user from accidentally pulling the clip out of the wallet. *Id.*

Mr. Kane describes that innovation as “lightning in a bottle”: Applicant had been doing reasonably well before the new design, but when Applicant went to the removable money clip variant, things really took off. *Id.* at Q17. It was at that point that Applicant started selling wallets at a pace that began to approximate the current-day sales volumes.

B. The '808 Patent and Its Claims

The '808 patent describes and claims a “compact wallet,” which in various embodiments minimizes the silhouette, or footprint, of a wallet while maximizing expandability. Ex. 1001 at Abstract. A pair of grooves, one in each plate, accommodates an elastic strap. *Id.* at 3:4-17. When a user inserts cards between the plates, the strap stretches in the groove to allow the wallet to expand. *Id.* at 2:56-60. Fig. 13 of the '808 Patent, reproduced below, illustrates a money clip with a pair of structures (33) that sit inside a portion 34 and engage a wall 35 so that when assembled, the money clip cannot be pulled out of the wallet. *Id.* at 5:23-31.



Ex. 1001 at Fig. 13. In the parlance of the '808 Patent, there are a pair of

structures marked as 33 that sit inside a portion 34 and engage a wall 35 so that when the wallet is assembled, the money clip cannot be pulled out of the wallet. Ex. 1001 at 5:10-31. If, however, the user wishes to remove and/or replace the money clip, the screws can be removed and the money clip taken out of the wallet and replaced as is desired. *Id.*

In this manner, the ‘808 Patent provides for a compact wallet with a removable and re-attachable (i.e., modular) auxiliary feature in the form of a money clip. It does so while minimizing both the silhouette of the wallet (it is not much larger than an ANSI standard credit card) and the thickness of the wallet, while permitting the user to choose how many cards to carry. Without the inventions described and claimed in the ‘808 Patent, users would be stuck with prior art solutions (like Kane and/or Minn) that did not serve these purposes.

Each of the independent claims recites elements directed to a modular auxiliary feature. For example, claim 1 recites the following:

an ***auxiliary feature removably*** attached to at least one of the at least two rigid plates, the auxiliary feature having a tang insertable into a recess formed inside the at least two rigid plates, the tang having a hook, the hook extending at an angle to the tang, the hook engaging an undercut of the recess to prevent inadvertent dislodgement of the auxiliary feature from the recess,

Ex. 1001 at Claim 1 (emphasis added).

Claim 14 recites the following:

a recess formed inside at least one of the at least two rigid plates, the recess operable to receive a tang of an ***auxiliary feature***, the recess having an undercut operable to engage a hook of the tang to prevent inadvertent dislodgement of the auxiliary feature from the recess when the ***auxiliary feature is removably positioned*** in at least one of the at least two rigid plates, the hook extending at an angle to the tang,

Ex. 1001 at Claim 14 (emphasis added).

And Claim 19, which is a method claim, recites the following:

providing a ***first auxiliary feature*** having at least one tang;

inserting, removably, the at least one tang of the ***first auxiliary feature*** into the at least one recess to make the first auxiliary feature available at an outside face of at least one of the two rigid plates;

removing, selectively, the first auxiliary feature;

providing, selectively, at least a second auxiliary feature having at least one tang; and

inserting, removably, the at least one tang of the second auxiliary feature into the at least one recess to make the second auxiliary feature available at an outside face of at least one of the two rigid plates, the at least one recess having an undercut operable to engage a hook of the tang to prevent inadvertent dislodgement of the second auxiliary feature from the at least one recess, the hook extending at an angle to the tang, the at least one recess receiving the tang being disposed inside at least one of the two rigid plates

Ex. 1001 at Claim 19 (emphasis added).

Accordingly, each of the challenged claims recites the feature that the

Examiner has already found is lacking in the primary references used in the various

Grounds in the Petition: Kane on the one hand, and the Minn/Podwika/Coates combination, on the other hand. Petition at 5.

III. PROSECUTION HISTORY SUMMARY

The application that led to the ‘808 Patent was filed on February 1, 2017, as a continuation in part of U.S. Application Serial No. 14/706,019. Ex. 1013 at 3.

During prosecution, the Examiner rejected the pending independent claims as obvious based on U.S. Patent NO. 5,952,637 to Strunk in view of U.S. Patent No. 9,125,464 to Minn et al. or U.S. Patent No. 1,525,745 to Keefer. Ex. 1013 at 69. He also rejected the pending independent. Claims over U.S. Patent No. D716,043 to Wilk in view of U.S. Patent No. 5,944,080 to Podwika. Ex. 1013 at 69. He rejected the pending independent claims as being obvious over Wilk in view of U.S. Patent No. 7,527,081 to Coates et al. Ex. 1013 at 70. He also rejected the pending independent claims as anticipated by and/or obvious in view of U.S. Patent No. 2,322,461 to Mariano. Ex. 1013 at 70-71. He rejected the pending independent claims as obvious over Minn in view of Coates and Podwika. Ex. 1013 at 73. Finally, he rejected the pending claims over the Kickstarter pages the Petition refers to as “Kane.” Ex. 1013 at 73.

In response, the Applicant added language to each pending claim adding the requirement for an auxiliary feature removably attachable to the wallet (and the associated structural elements of the wallet itself). Ex. 1013 at 81-85. The

Applicant also explained that NONE of the grounds of rejection included these elements, thus overcoming each of the prior rejections. Ex. 1013 at 97-106.

Of particular relevance here, the Applicant explained that Minn and the various references with which it was combined was deficient because it lacked those elements permitting modular auxiliary features to be removably attached. Ex. 1013 at 97-98, 99, 103-105. It similarly explained that Kane was deficient for lacking those modularity-enabling elements. Ex. 1013 at 105-106. Thus, the Applicant's remarks explained why EACH of the primary references in EACH of the Petition's grounds was deficient. Petition at 5.

Responsive to Applicant's arguments, and acknowledging the patentability of the claims over, among other art, Kane and Minn/Podwika/Coates, the Examiner allowed the claims on August 31, 2020. Ex. 1013 at 119. The Examiner in so doing noted that the prior art of record (including Kane and Minn/Podwika/Coates) did "not have the limitation of the recess having an undercut operable to engage a hook of the tang." Ex. 1013 at 124.

Accordingly, the prosecution history demonstrates that the Examiner considered the prior art that forms the primary basis for each ground of rejection presented herein, determined it to be deficient, and allowed the claims over that prior art.

IV. REAL PARTIES-IN-INTEREST

As described in Patent Owner's Motion for Additional Discovery (Paper 13), at least a company called Shenzhen Swztech Co. Ltd. ("Swztech") is a real party-in-interest here but is not properly named. Petitioner's expert, Dr. Kimberly Cameron, was retained by and wrote an expert declaration for Swztech in the ITC Case. Ex. 1003 (Cameron IPR Declaration); Ex. 2006 (Cameron Claim Construction Declaration in ITC Case). During her deposition on that declaration, Dr. Cameron testified that she was in the process of preparing an invalidity analysis based on prior art, but that at that time, she was not yet finished. Ex. 2003 at 21:11-20. When she submitted her expert report on invalidity in the ITC Case, she also did so on behalf of Swztech. Ex. 2006 at ¶ 4. Dr. Cameron's report in the ITC Case is very similar (and nearly identical in terms of theories) to the declaration she submitted in this case. Compare Ex. 1003 with Ex. 2006. And Swztech's counsel in the ITC Case was the same law firm as is representing the Petitioner here.

This indicates that Petitioner was not careful in identifying real parties in interest in the Petition, having failed to name at least Swztech as a real-party-in-interest. Patent submits that this would be a reason to dismiss the Petition, in the event Petitioner does not correct the deficiency. In addition, Patent Owner notes that it is currently seeking additional discovery to determine whether another party,

Mosaic Brands Inc. d/b/a Storus (“Mosaic”), is an un-named real party-in-interest.

Mosaic sued Ridge in 2020 in the Central District of California, and on November

12, 2020, Ridge countersued Mosaic for infringement of U.S. Patent No.

10,791,808 (“‘808 Patent”). *See* Ex. 2005. Thus, Mosaic became time barred from

filing an IPR challenging the validity of the ‘808 Patent as of November 13, 2021.

Should it be determined that Mosaic is an un-named real party-in-interest, the

Petition would be time-barred under 35 U.S.C. § 315(b).

V. PERSON OF ORDINARY SKILL IN THE ART (“POSITA”)

For purposes of this Preliminary Response only, Patent Owner does not dispute Petitioner’s proffered identification of a POSITA’s skill level. *See* Petition at 15. However, Patent Owner notes that Dr. Cameron does not appear to offer an opinion in that regard. Ex. 1003. This failing further highlights the problem, as discussed below, with the fact that Dr. Cameron previously opined that the claims of the ‘808 Patent are indefinite, and that she could not understand the metes and bounds of the claim scope. This failing warrants dismissal of the Petition as described below.

VI. CLAIM CONSTRUCTION

Petitioner rightly asserts that the only term in the claims of the ‘808 Patent that needs to be affirmatively construed is “channeling means,” as recited in claim 1 of the ‘808 Patent. Petition at 11-13. Patent Owner notes for the Board’s

convenience that on April 16, 2024, the District Court for the District of Colorado issued another order construing the claims of the ‘808 Patent consistent with the ITC’s Order (Ex. 1014). Patent Owner includes that claim construction order herewith as Exhibit 2010.

In the ITC Case, Dr. Cameron also served as the claim construction expert for the respondents that participated in the Investigation. She opined in connection with the claim construction process that three terms (“interposed,” “minimal silhouette,” and “minimize the profile”) are insolubly ambiguous and rendered the claims indefinite. Ex. 2006 at 4. That is, Dr. Cameron spent several pages in a declaration and in a deposition opining that she, an expert, could not understand what those three terms mean to a person of ordinary skill in the art. Ex. 2006; Ex. 2003.

With regard to “interposed,” she opined that “[t]he term interposed in the claim makes the bounds of the claims uncertain.” Ex. 2006 at 4-5. She opined that “It is unclear how the phrase ‘minimize the profile of the wallet’ should be evaluated or what the bounds of the term is.” Ex. 2006 at 5. She opined that “[l]ike the term ‘minimize the profile,’ the term ‘minimal silhouette’ does not provide guidance as to the meaning (width and length versus depth) or bounds, i.e., what is or is not considered a minimal silhouette.” Ex. 2006 at 7.

In stark contrast, and without addressing her prior opinions whatsoever, Dr.

Cameron opines here that “[i]n my opinion, all of the claim terms should be given their ordinary and customary meaning in the context of the ‘808 Patent. To the extent that Patent Owner proposes different constructions, I reserve the right to respond and provide further analysis of the claims.” Ex. 1003 at ¶76.

35 U.S.C. § 314 provides that *inter partes* review may not be instituted unless the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

37 C.F.R. § 42.104 sets forth the requirements for a compliant Petition. In particular, 37 C.F.R. § 42.104(b)(3) requires that a Petition must set forth “[h]ow the challenged claim is to be construed,” and 37 C.F.R. § 42.104(b)(4) requires that a Petition must explain “[h]ow the construed claim is unpatentable under the statutory grounds identified...”

The Board has previously held that where a petitioner does not explain how to reconcile inconsistencies between litigation claim construction positions and IPR claim construction positions, these sections of the rules are not satisfied and denial is appropriate under 35 U.S.C. § 314. *Orthopediatrics Corp. v. K2M, Inc.*, IPR2018-01546, Paper 10 at 10-12 (PTAB Feb. 14, 2019). Specifically, the Board panel in *Orthopediatrics* explained:

[O]ur rules place an affirmative burden on petitioners to “set forth:...How the challenged claim is to be construed.”
Medicines Co. v. Mylan, Inc., 853 F.3d 1296, 1308 (Fed. Cir.

2017); 37 C.F.R. § 42.104(b)(3). This burden continues by requiring petitioners to adequately explain “[h]ow the construed claim is unpatentable.” 37 C.F.R. § 42.104(b)(4) (emphasis added). As explained below, the Petition fails to identify how the challenged claims are to be construed and applied to the prior art, and Petitioner also takes conflicting positions between this proceeding and the related district court litigation.

Id. at 10-11.

Patent Owner submits that Dr. Cameron’s inconsistent positions (and, worse, Petitioner’s failure to address the same) warrant denial of the Petition. Petitioner does not provide the Board with any guidance whatsoever in how to reconcile the fact that its expert, in the summer of 2023, could not make heads or tails of the claim scope, but here appears to be able to understand the claim scope with such certainty that she need not even address the differences. The Petition therefore does not satisfy 37 C.F.R. § 42.104(b)(3)-(4).

In addition, Dr. Cameron’s failure to address her inconsistent positions (and her apparent malleability in offering opinions that fit the need of her employer) cast doubt on her substantive opinions regarding obviousness. This perhaps begins to explain the cursory nature of her obviousness opinions, and buttresses the arguments below about why the Petition (based on Dr. Cameron’s opinions) cannot satisfy the burden imposed by 35 U.S.C. § 314 to demonstrate a reasonable likelihood that the Petitioner could succeed.

VII. THE PETITION’S GROUNDS DO NOT RENDER THE CHALLENGED CLAIMS OBVIOUS

The Petition presents a classic case of a Petitioner relying on conclusory statements about combinability and therefore, under Board and Federal Circuit precedent, failing to articulate any rationale for obviousness based on multiple references. As is often the case, the Petitioner here has advocated that certain mechanical features from one device could be imparted on another device so as to result in the claims of the ‘808 Patent. But that approach is legally insufficient, and is wrought with impermissible hindsight bias.

The Board has articulated what is required to show obviousness in a number of situations; germane here is the articulation by the Board in the *Dropworks, Inc. v. Bio-Rad Laboratories, Inc.* case:

To show obviousness, it is not enough to merely show that the prior art includes separate references covering each separate limitation in a challenged claim. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). “This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR [Int’l. v. Teleflex Inc.]*, 550 U.S. [398] at 418–419 [(2007)]. On the other hand, an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418; *accord In re Translogic Tech., Inc.*, 504 F.3d 1249, 1259 (Fed. Cir. 2007). However, Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re*

Magnum Oil Tools Int’l, Ltd., 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Instead, Petitioner must articulate a reason why a person of ordinary skill in the art would have combined or modified the prior art references. *In re NuVasive, Inc.*, 842 F.3d 1376, 1382 (Fed. Cir. 2016); *see also Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1366 (Fed. Cir. 2017) (“In determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is insufficient to simply conclude the combination would have been obvious without identifying any reason why a person of skill in the art would have made the combination.”); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.”) (citing *InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014)). In addition, the law also “requires that the skilled artisan would have perceived a reasonable expectation of success in making the invention in light of the prior art.” *Amgen v. F. Hoffman-La Roche Ltd.*, 580 F.3d 1340, 1362 (Fed. Cir. 2009) (citing *In re Kubin*, 561 F.3d 1351, 1360 (Fed. Cir. 2009)).

IPR2021-00212, Paper 7 at 6-7 (PTAB June 1, 2021). Each of the Grounds

presented in the Petition here suffers from the infirmities articulated by the Board above, and as such denial of the Petition is warranted.

A. The Kane-Based Grounds (Grounds 1A-II and Ground 3A) Do Not Render Obvious the Challenged Claims

i. The Petition Does Not Establish Combinability of Kane and Beckley

The Petition relies solely on U.S. Patent No. 9,125,465 to Beckley

(“Beckley”) to teach claim element 1d in connection with Ground 1A. Petition at 28-30. The sum-total of the Petition’s “analysis” of combinability regarding Ground 1A, omitting a footnote that quotes a portion of *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), is as follows:

Dr. Cameron opines that, “A POSITA knew of the desirability of removable clips on a compact wallet and would be motivated to incorporate the removable clip of Beckley into the compact wallet of Kane and could easily do so. The recess would be between the lamina of the rigid plate of Kane and the undercut would be in one of the lamina.” EX1015 page 5. As taught by Beckley, the use of Beckley’s arrangements/structures (auxiliary feature, tang, hook, recess, undercut) with the wallet of Kane would have merely been the predictable result of using the elements of Beckley according to their known function. In addition, To employ Beckley’s auxiliary feature with the wallet of Kane, a POSITA will also understand that it would have been obvious to form/arrange the recess of Beckley inside the at least two rigid plates of Kane’s wallet, because this provides one of a finite number of possible locations to form/arrange the recess.

Petition at 30. This is precisely the “conclusory” analysis the Board (and the Federal Circuit) have warned against. The Petition does not identify any reason *why* a person of ordinary skill would have made the combination. At best, the Petition relies on Dr. Cameron for the conclusion that a combination *could* have been made, but is devoid of any articulation of a reason for that combination. It is also devoid of any description of what the combination would look like; while referencing a finite number of possible locations, it does not describe how the

combination would actually work.

Particularly where the intrinsic record (Ex. 1013) indicates that the Examiner found that a person of ordinary skill in the art would not have modified Kane to include element 1d, the cursory treatment of the issue of combinability is fatal to the Petition.

The analysis of combinability for the corresponding limitations of claims 14 and 19 (i.e., claim element 14c and claim elements 19c-19g) merely refers back to the “analysis” of combinability for claim 1d. Petition at 41-42, 43-45. Thus, the same infirmities that doom Ground 1A’s analysis of claim 1 also dooms Ground 1A’s analysis of claims 14 and 19 (and thus dependent claims 2-9, 11-13, 15-18, and 20-24).

The Petition does not establish a reasonable likelihood of success on the merits for Ground 1A, and should be denied. 35 U.S.C. § 314(a).

Grounds 1B and 1C merely attempt to use additional references to address the limitations of claims 10 and 13. They do not further address combinability of Kane with Beckley. As such, Grounds 1B and 1C should be denied. 35 U.S.C. § 314(a).

Ground 3A attempts to use an additional reference beyond the references in Ground 1A to further address the limitations of claims 3 and 16. It does not further address combinability. As such, Ground 3A should be denied. 35 U.S.C. § 314(a).

ii. The Petition Does Not Establish Combinability of Kane and Murphy

The Petition relies solely on the Murphy reference to teach claim element 1d in connection with Ground 1D. Petition at 50-52. The sum-total of the Petition's "analysis" of combinability regarding Ground 1D is as follows:

Murphy teaches that this removable clip-member 5 is used in a garmet [sic] clip, but can also be used as a money clip. See EX1006 [0060]. Dr. Cameron also opines: "A POSITA would be motivated to incorporate a removable clip such as that of Murphy into the compact wallet of Kane. The recess would be between the two lamina and the undercut would be placed in one of the lamina.. [sic]" EX1015, page 7.

The use of Murphy's arrangements (clip, tang, hook, recess, undercut) with the wallet of Kane would have merely been the predictable result of using the elements of Murphy according to their known function. In addition, it would have been obvious to form/arrange the recess of Murphy inside the at least two rigid plates of Kane's wallet, because this provides one of a finite number of possible locations to form/arrange the recess.

Petition at 52. This analysis is even more deficient than the Petition's analysis in Ground 1A. The Petition does not identify any reason *why* a person of ordinary skill would have made the combination. At best, the Petition relies on Dr. Cameron for the conclusion that a combination *could* have been made, but is devoid of any articulation of a reason for that combination. It is also devoid of any description of what the combination would look like; while referencing a finite number of possible locations, it does not describe how the combination would

actually work.

Particularly where the intrinsic record (Ex. 1013) indicates that the Examiner found that a person of ordinary skill in the art would not have modified Kane to include element 1d, the cursory treatment of the issue of combinability is fatal to the Petition.

The analysis of combinability for the corresponding limitations of claims 14 and 19 (i.e., claim 14c and claim 19c-19g) merely refers back to the “analysis” of combinability for claim 1d. Petition at 53, 53-55. Thus, the same infirmities that doom Ground 1D’s analysis of claim 1 also dooms Ground 1D’s analysis of claims 14 and 19 (and thus dependent claims 2-9, 11-13, 15-18, and 20-24).

The Petition does not establish a reasonable likelihood of success on the merits for Ground 1D, and should be denied. 35 U.S.C. § 314(a).

Grounds 1E and 1F merely attempt to use additional references to address the limitations of claims 10 and 13. They do not further address combinability. As such, Grounds 1E and 1F should be denied. 35 U.S.C. § 314(a).

iii. The Petition Does Not Establish Combinability of Kane and Roman

The Petition relies solely on the Roman reference to teach claim element 1d in connection with Ground 1G. Petition at 56-58. The sum-total of the Petition’s “analysis” of combinability regarding Ground 1G is as follows:

Dr. Cameron opines that “A POSITA knew of the desirability of removable clips on a compact wallet as taught by Roman and would be motivated to incorporate the removable clip of Roman into the compact wallet of Kane and could easily do so. The recess would be between the two lamina of the rigid plate of Kane and the undercut would be in one of the lamina.” EX1015, page 6.

In addition, a POSITA will also understand that it would have been obvious to form/arrange the recess of Roman inside the at least two rigid plates of Kane’s wallet, because this provides one of a finite number of possible locations to form/arrange the recess.

Petition at 52. This analysis is even more deficient than the Petition’s analysis in Grounds 1A and 1D. The Petition does not identify any reason *why* a person of ordinary skill would have made the combination. At best, the Petition relies on Dr. Cameron for the conclusion that a combination *could* have been made, but is devoid of any articulation of a reason for that combination. It is also devoid of any description of what the combination would look like; while referencing a finite number of possible locations, it does not describe how the combination would actually work.

Particularly where the intrinsic record (Ex. 1013) indicates that the Examiner found that a person of ordinary skill in the art would not have modified Kane to include element 1d, the cursory treatment of the issue of combinability is fatal to the Petition.

The analysis of combinability for the corresponding limitations of claims 14

and 19 (i.e., claim 14c and claim 19c-19g) merely refers back to the “analysis” of combinability for claim 1d. Petition at 58-60. Thus, the same infirmities that doom Ground 1G’s analysis of claim 1 also dooms Ground 1G’s analysis of claims 14 and 19 (and thus dependent claims 2-9, 11-13, 15-18, and 20-24).

The Petition does not establish a reasonable likelihood of success on the merits for Ground 1G, and should be denied. 35 U.S.C. § 314(a).

Grounds 1H and 1I merely attempt to use additional references to address the limitations of claims 10 and 13. They do not further address combinability. As such, Grounds 1H and 1I should be denied. 35 U.S.C. § 314(a).

iv. Dr. Kurfess Previously Identified Deficiencies in Dr. Cameron’s Combination Analysis Where Kane is the Base Reference

In the ITC Case, Dr. Thomas Kurfess submitted an expert report on Patent Owner’s behalf responsive to the report submitted in the ITC Case by Petitioner’s expert, Dr. Cameron. Ex. 2014. While the secondary references Dr. Cameron relies on here are partially different (e.g., she relies on Buckley, Roman, and Murphy here, and relied on a referenced called Kaminski along with Roman and Murphy in the ITC Case), her combination analysis was equally deficient. In connection with Dr. Cameron’s analysis in the ITC Case, Dr. Kurfess provided his rebuttal analysis regarding combinations based on Kane as a primary reference:

Importantly, Dr. Cameron’s cobbled-together combination fails

to take account for the substantial issues around providing a wallet with a channeling means to accommodate elastic bands as claimed, while also providing for a removable auxiliary feature. She seems to suggest that the prior art clips could be “incorporated,” without actually dealing with the fact that the inventors of the ‘808 Patent actually had to overcome several problems related to how to incorporate a removable money clip while still permitting the pair of rigid plates with channeling means/grooves therethrough to provide for the expanding and contracting construction with the recited minimizing of profile/silhouette recited in this claim.

In short, Dr. Cameron’s analysis amount hindsight reconstruction; merely using the claims as a blueprint to piece together multiple pieces of prior art. There is no rationale to do so, and even if I assume she is correct that a combination can be made, there are several missing components in the combination (e.g., a recess inside something, an undercut). I disagree with her analysis of this claim element. Her opinions are unsupportable when the reliance on hindsight reconstruction is removed.

Ex. 2014 at 45. Dr. Kurfess also observed more generally that he “[does] not believe Dr. Cameron has articulated any rational basis to make the combinations she articulates, and instead believe[s] that the sheer number of references, as well as her ‘pick and choose’ approach to combination, indicates that in fact the combination she proposes is based on improper hindsight reconstruction.” Ex. 2014 at 41.

Dr. Kurfess’ prior expert opinions, of which Dr. Cameron and the Petitioner were aware prior to the submission of the Petition in this case, detail some of the deficiencies that persist in Dr. Cameron’s (and the Petitioner’s) current analysis in

the Petition. This is further evidence that the Petition should be dismissed on the merits.

B. The Minn-Based Grounds (Grounds 2A-2D) Do Not Render the Challenged Claims Obvious

- i. The Petition Does Not Establish Combinability of Minn, Podwika, and Coates (referred to hereinafter as the “Minn Base Combination”), Which Underlies Grounds 2A-2D

Grounds 2A to 2D essentially replace Kane’s disclosure from Grounds 1A to 1I with the proposed three-reference combination of Minn, Podwika, and Coates. Patent Owner refers to this putative combination as the “Minn Base Combination.” Notably, each of those references that makes up the Minn Base Combination was considered during examination; in fact, each reference was used to reject the pending claims of the application that issued as the ‘808 Patent. *See infra* at Section III.

The Petition’s “analysis” of why the Minn Base Combination is proper is as follow:

Dr. Cameron opines: “Minn modified with the groove of Podwika discloses a channeling means. FIG. 1 of Podwika illustrates that the longitudinal elastic band of Minn can be captured by a longitudinal groove in each plate instead of by slots 25 and notches 28 taught in Minn. This would be desirable to minimize the profile of the wallet. Like Minn and Podwika, the combination of Minn and Podwika also allows freedom for the dynamic extension and contraction of the band over the entire running length.” EX1016, page 6.

As explained in Podwika, “the recess 26 is sized and configured to receive a portion of an elastic retaining band 50. The elastic retaining band 50 is formed into a continuous loop that encircles the base 12.” EX1009,4:21-23. Dr. Cameron further opines: “A POSITA would be motivated to utilize this recess over the longitudinal extent of the rigid plates of Minn in place of slots 25 and notches 28 of Minn.” EX1016, page 6.

Petition at 66. The Petition is completely silent with regard to any analysis of the reason a person of skill in the art would have combined Coates with Minn and Podwika. Petition at 66-67.

This is precisely the “conclusory” analysis the Board (and the Federal Circuit) have warned against. The Petition does not identify any reason *why* a person of ordinary skill would have made the combination. At best, the Petition relies on Dr. Cameron for the conclusion that a combination *could* have been made as to Minn and Podwika, but is devoid of any articulation of a reason for that combination. It is also devoid of any description of what the combination would look like; while referencing a finite number of possible locations, it does not describe how the combination would actually work. And where the design of the devices in these two reference varies wildly, the only apparent basis for the combination is impermissible hindsight having read the ‘808 Patent claims. Incredibly, there is no analysis whatsoever (or citation to Dr. Cameron’s opinions) as far as the reasons why a combination with Coates is supportable

Particularly where the intrinsic record (*see* Ex. 1013) indicates that the

Examiner used all three of the references that make up the Minn Base Combination, and was convinced that the combination as proposed did not render the claims obvious, the cursory treatment of the issue of combinability is fatal to the Petition as it pertains to Grounds 2A-2D.

ii. The Petition Does Not Establish Combinability of the Minn Base References with Beckley

The Petition relies solely on the Beckley reference to teach claim element 1d in connection with Ground 2A. Petition at 67-69. The sum-total of the Petition's "analysis" of combinability regarding Ground 1D is as follows:

Dr. Cameron opines: "A POSITA knew of the desirability of removable clips on a compact wallet and would be motivated to incorporate the removable clip of Beckley into the compact wallet (and this would be an additional reason to use screws rather than glue or welding to attach the lamina together in addition to being able to replace the outer lamina and or band) and could easily do so. The recess would be between the lamina of the rigid plate of the modified wallet of Minn and the undercut would be in one of the lamina." EX1016 page 8.

A POSITA will also understand that it would have been obvious to form/arrange the Beckley's recess inside the at least two rigid plates of Minn's wallet, because this provides one of a finite number of possible locations to form/arrange the recess.

Petition at 68-69. This "analysis" parrots back the analysis of Beckley with regard to Ground 1A, but even worse, does not even attempt to address the fact that Beckley would be combined with not just Minn, but with the Minn Base Combination. Since Beckley is being combined with an ethereal, undescribed,

combination of three references, the Petition's analysis of Beckley in Ground 2A is even more deficient than it is in Ground 1A.

In addition, as with Ground 1A, this is precisely the “conclusory” analysis the Board (and the Federal Circuit) have warned against. The Petition does not identify any reason *why* a person of ordinary skill would have made the combination. At best, the Petition relies on Dr. Cameron for the conclusion that a combination *could* have been made, but is devoid of any articulation of a reason for that combination. It is also devoid of any description of what the combination would look like; while referencing a finite number of possible locations, it does not describe how the combination would actually work.

Particularly where the intrinsic record (Ex. 1013) indicates that the Examiner found that a person of ordinary skill in the art would not have combined Minn, Podwika, and Coats, and further found that the claims of the '808 Patent are not obvious in view of that combination, the cursory treatment of the issue of combinability is fatal to the Petition.

The analysis of combinability for the corresponding limitations of claims 14 and 19 (i.e., claim 14c and claim 19c-19g) merely refers back to the “analysis” of combinability for claim 1d. Petition at 78, 80-81. Thus, the same infirmities that doom Ground 2A's analysis of claim 1 (as it pertains to the addition of Beckley to the Minn Base Combination) also dooms Ground 2A's analysis of claims 14 and

19 (and thus dependent claims 2-9, 11-13, 15-18, and 20-24).

The Petition does not establish a reasonable likelihood of success on the merits for Ground 2A, and should be denied. 35 U.S.C. § 314(a).

Ground 2B merely attempts to use additional references to address the limitations of claim 13. It does not further address combinability. As such, Ground 2B should be denied. 35 U.S.C. § 314(a).

iii. The Petition Does Not Establish Combinability of The Minn Base Combination with Murphy

The Petition relies solely on the Murphy reference to teach claim element 1d in connection with Ground 2C. Petition at 82-84. The sum-total of the Petition's "analysis" of combinability of Murphy with the Minn Base Combination for Ground 2C is as follows:

Dr. Cameron opines: "While the clip of Murphy is shown as clipping to the cuff of a pant leg (that can have variable thickness), the clip 10 is similar to that used for a money clip or a clip that could attach a wallet to a belt for example. A POSITA would also be motivated to use the tang and hook arrangement to secure a removable clip or accessory to the wallet (the combination described above)." EX1016 page 9.

In addition, a POSITA will understand that it would have been obvious to form/arrange the recess of Murphy inside the at least two rigid plates of Minn's wallet (modified with Podwika and Coates), because this provide one of a finite number of possible locations to form/arrange the recess.

Petition at 85. This analysis is even more deficient than the Petition's analysis in

Ground 2A. The Petition does not identify any reason *why* a person of ordinary skill would have made the combination. At best, the Petition relies on Dr.

Cameron for the conclusion that a combination *could* have been made, but is devoid of any articulation of a reason for that combination. It is also devoid of any description of what the combination would look like; while referencing a finite number of possible locations, it does not describe how the combination would actually work. And it certainly does not do anything to remedy the deficiency in Ground 2A as it pertains to the Minn Base Combination.

Particularly where the intrinsic record (Ex. 1013) indicates that the Examiner found that a person of ordinary skill in the art would not have combined Minn, Podwika, and Coats, nor would have modified anything to include element 1d, the cursory treatment of the issue of combinability is fatal to the Petition.

The analysis of combinability for the corresponding limitations of claims 14 and 19 (i.e., claim 14c and claim 19c-19g) merely refers back to the “analysis” of combinability for claim 1d. Petition at 85-86. Thus, the same infirmities that doom Ground 2C’s analysis of claim 1 also dooms Ground 2C’s analysis of claims 14 and 19 (and thus dependent claims 2-9, 11-13, 15-18, and 20-24).

The Petition does not establish a reasonable likelihood of success on the merits for Ground 2C, and should be denied. 35 U.S.C. § 314(a).

Ground 2D merely attempts to use additional references to address the

limitations of claim 13. It does not further address combinability. As such, Ground 2D should be denied. 35 U.S.C. § 314(a).

iv. Dr. Kurfess Previously Identified Deficiencies in Dr. Cameron's Combination Analysis Regarding Minn, Podwika, and Coates

Dr. Kurfess' expert report in the ITC Case also addressed combinations based on Minn, and provided his expert opinions as to why those combinations were not properly supported. Ex. 2014. While the secondary references Dr. Cameron relies on here are partially different (e.g., she relies on Buckley and Murphy here, and relied on Kaminski and Murphy in the ITC Case), her combination analysis is equally deficient here as it was in the ITC case. In connection with Dr. Cameron's analysis in the ITC Case, Dr. Kurfess provided his rebuttal analysis regarding combinations based on Minn, Podwika, and Coates as forming a "primary reference":

Importantly, Dr. Cameron's cobbled-together combination fails to take account for the substantial issues around providing a wallet with a channeling means to accommodate elastic bands as claimed, while also providing for a removable auxiliary feature. She seems to suggest that the prior art clips could be "incorporated," without actually dealing with the fact that the inventors of the '808 Patent actually had to overcome several problems related to how to incorporate a removable money clip while still permitting the pair of rigid plates with channeling means/grooves therethrough to provide for the expanding and contracting construction with the recited minimizing of profile/silhouette recited in this claim.

In short, Dr. Cameron's analysis amount hindsight reconstruction; merely using the claims as a blueprint to piece together multiple pieces of prior art. There is no rationale to do so, and even if I assume she is correct that a combination can be made, there are several missing components in the combination (e.g., a recess inside something, an undercut). I disagree with her analysis of this claim element.

Ex. 2014 at 36-37. He expressed his opinion that the Minn, Coates, and Podwika combination is improper. Ex. 2014 at 34-35. Dr. Kurfess also observed more generally that "I do not believe Dr. Cameron has articulated any rational basis to make the combinations she articulates, and instead believe that the sheer number of references, as well as her 'pick and choose' approach to combination, indicates that in fact the combination she proposes is based on improper hindsight reconstruction." Ex. 2014 at 32.

Dr. Kurfess' prior expert opinions, of which Dr. Cameron and the Petitioner were aware prior to the filing of the Petition in this case, detail some of the deficiencies that persist in Dr. Cameron's (and the Petitioner's) current analysis in the Petition. This is further evidence that the Petition should be dismissed on the merits.

C. Secondary Considerations Evidence Supports Non-Obviousness

Finally, the Petition is completely devoid of any argument or evidence about secondary considerations relating to the issue of obviousness. It does not even mention the doctrine of "secondary considerations." It is so presented despite the

fact that the rebuttal expert from Dr. Kurfess in the ITC Case (dated on September 13, 2023) contains an explanation and analysis of secondary considerations of *non-obviousness*. Dr. Kurfess notes that in the ITC Case, Ridge served discovery responses outlining the following theories about secondary considerations of non-obviousness:

Nevertheless, Ridge states as follows with regard to substantial secondary considerations evidence of non-obviousness. The astronomical success of Ridge's domestic patent products, which only occurred when those products started to incorporate features like those disclosed and claimed in the '808 Patent (and thus has nexus to the '808 Patent), is a secondary consideration of non-obviousness. In addition, the extensive copying of Ridge's domestic patent products (including the patented features of the products), including by SWZA, ARW, Mosaic, and the non-responding Respondents, constitutes a secondary consideration of nonobviousness. This fact pattern establishes that the '808 Patent satisfies a long-felt, but unresolved need in the industry, and is reflective of commercial success. In particular, Respondent Mosaic's commercial failings are evidence of secondary considerations of non-obviousness. For all these reasons, Ridge asserts that there are substantial secondary considerations of non-obviousness

Ex. 2014 at ¶ 103. Dr. Kurfess provided at least the following opinions relating to secondary considerations:

I...believe that these theories (and the evidence underlying the same) supports that the claims of the '808 Patent are non-obvious. Particularly since I understand that Ridge's sales history ties temporally to its inventions embodied in the '808 Patent (as compared to earlier iterations of its products), there is a nexus between the success Ridge had in the marketplace and the claims of the '808 Patent, demonstrating that the claims are

non-obvious. I also note that the depositions of SWZA's and ARW's corporate representatives, which I discussed in my opening report, indicate that those entities bought products from factories that were copying Ridge's designs in bulk in 2020 (but not before), further demonstrating that it was the '808 Patent's claimed technology that drives the success not just of Ridge's products but also of the factories abroad that permit infringers like SWZA and ARW to infringe.

[] In addition, I understand that Ridge has had success in convincing certain infringers to cease and desist further sales of infringing wallets, which suggests that those third parties recognize the validity of the '808 Patent. I also understand that Mosaic, a prior respondent in this Investigation, agreed to cease and desist from making the product that was accused of infringement as a part of its settlement with Ridge. These types of agreements are secondary considerations evidence that further support a conclusion that the '808 Patent claims are not obvious.

Ex. 2014 at ¶¶ 103-104. Dr. Cameron's silence in the face of Dr. Kurfess' prior expert opinions, which were served on Petitioner's counsel in September, 2013, means that the only evidence of record in this proceeding is Dr. Kurfess' opinion that secondary considerations support non-obviousness of the claims of the '808 Patent. This is yet another reason that Petitioner cannot meet its burden to demonstrate a likelihood of success, and yet another reason institution of *inter partes* review should be denied. 35 U.S.C. § 314.

VIII. THE PETITION SHOULD BE DISCRETIONARILY DENIED UNDER 35 U.S.C. § 325(d)

As explained below, discretionary denial of the Petition under 35 U.S.C. §

325(d) is warranted because (1) the Petition advances proposed Grounds that rely on the same prior art references (and predominately Patent Owner's own, cited art) that were previously presented to and considered by the Examiner during prosecution and (2) Petitioner has not demonstrated that the Office erred in a manner material to the patentability of the Challenged Claims. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7-8 (PTAB Feb. 13, 2020) (precedential).

Notably, the Petition does not address discretionary denial at all, and does not refer to 35 U.S.C. § 325(d). Accordingly, since the only arguments before the Board with regard to discretionary denial demonstrate that the Examiner considered the primary references (and several of the secondary references), and since there are no arguments that the Examiner erred in a manner material to the patentability of the challenged claims, discretionary denial is warranted.

A. Each and Every Primary Reference Was Previously Presented to the Patent Office.

Grounds 1A-1I and 3A each relies on Kane as the primary reference. Kane was of course presented to the Office during prosecution of the '808 Patent. Applicant submitted that reference in an IDS dated January 30, 2017. Ex. 1013 at 23. The Office used Kane to reject the claims in the sole substantive rejection during prosecution of the '808 Patent, on September 19, 2018. Ex. 1013 at 79.

And the Applicant argued over Kane (successfully) in the response dated May 27, 2020. Ex. 1013 at 105-106.

Likewise, Minn, Podwika, and Coates were cited by the Examiner in the Office Action dated September 19, 2018. Ex. 1013 at 61. Indeed, the Examiner used these three references to reject the claims in various combinations, *including in the way used in the Petition*. Ex. 1013 at 69-73. The Applicant argued (successfully) over the combination of Minn, Podwika, and Coates in the response dated May 27, 2020. Ex. 1013 at 104-105.

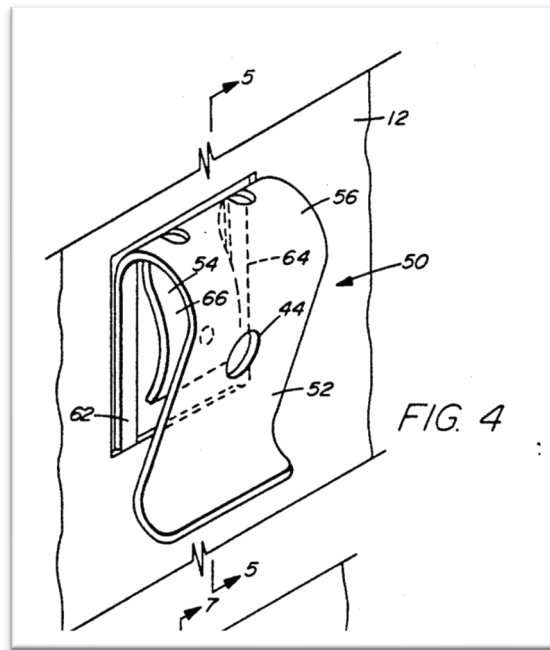
Accordingly, the references that form the “base” reference for each of the Grounds presented herein were already considered by the Examiner during prosecution of the ‘808. *See Peloton Interactive, Inc. v. iFit, Inc.*, IPR2022-00029, Paper 13 at 13 (PTAB Apr. 22, 2022) (references cited on an IDS that are expressly considered by the examiner constitute as previously presented art under the *Advanced Bionics* framework); *Advanced Bionics*, Paper 6 at 7-8.

B. Petitioner Has Failed to Show Material Error by the Office

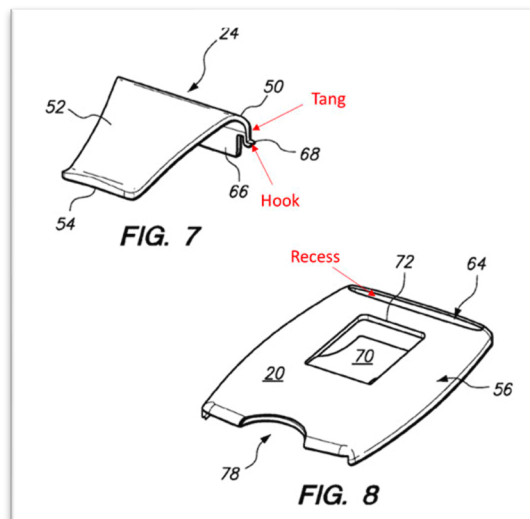
Petitioner did not even attempt to demonstrate material error by the Office. *See Advanced Bionics LLC*, Paper 6 at 8. While Petitioner relies on a handful of references for the putative teachings of the “auxiliary member” and associated requirements, Petitioner does not attempt to say that the failure to apply such references constituted material error. *Ivantis, Inc. et al. v. Sight Sciences, Inc.*,

IPR2022-01533, Paper 14 at 18-20 (PTAB Mar. 27, 2023) (finding that Petitioner failed to demonstrate material error in view of Petitioner's bare assertion that references were not applied during prosecution); *Google LLC v. Kewazinga Corp.*, IPR2021-00527, Paper 16 at 18-19 (PTAB Aug. 24, 2021) (denying institution where Petitioner did not "identify any specific teaching in any reference that the Examiner misapprehended or overlooked" and did not point out how the Examiner erred in evaluating the references); *Roku, Inc. v. Universal Elecs., Inc.*, IPR2019-01619, Paper 11 at 11, 19 (PTAB Apr. 2, 2020) (denying institution where Petitioner's relied upon reference was disclosed in an IDS during prosecution but did not adequately explain how the Examiner erred materially).

Indeed, numerous references that were before the examiner, such as U.S. Patent No. 5,038,985 to Chapin (Ex. 2013) illustrate clips of varying designs:



Ex. 2013 at Fig. 4. Kaminski, which Dr. Cameron relied on in her ITC expert report (*see, e.g.*, Ex. 2008 at 37-39), likewise discloses a clip, and in that case it is for a card-carrying device:



Ex. 2008 at 35.

Accordingly, Petitioner has not identified, and cannot identify, any material error in failing to cite Beckley, Murphy, or Roman (which are the references Petitioner relies on to teach the “auxiliary member” and related elements of the challenged claims).

Discretionary denial under 325(d) is warranted here given that the same art was previously presented to the Patent Office and Petitioner has failed to show any material error. *See Google LLC v. Valtrus Innovations Ltd.*, IPR2022-01197, Paper 18 at 19-24, 28- 29 (PTAB June 13, 2023) (exercising discretion to deny a subset of petitioned grounds under §325(d); finding that Petitioner failed to demonstrate material error “with specificity”). Indeed, Petitioner has not even attempted to show material error, nor has it addressed the 325(d) issues at all.

IX. CONCLUSION

For the foregoing reasons, Patent Owner requests denial of institution, either because Petitioner has not shown it is reasonably likely to succeed on at least one claim (35 U.S.C. § 314), or because the same or substantially the same arguments have already been presented to the Office (35 U.S.C. § 325(d)).

Date: April 18, 2024

Respectfully Submitted,

/s/ Benjamin E. Weed

Benjamin E. Weed

Reg. No. 65,939

CASE NO. IPR2024-00340
PO PRELIMINARY RESPONSE

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CERTIFICATION UNDER 37 C.F.R. §42.24(d)

Under the provisions of 37 C.F.R. §42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Preliminary Response to Petition totals 9,112, which is less than the 14,000 allowed under 37 C.F.R. §42.24(b)(1).

Respectfully submitted,

Date: 4/18/2024

/Benjamin E. Weed/
Benjamin E. Weed
Reg. No. 65,939
Attorney for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on April 18, 2024, a complete and entire copy of this Patent Owner's Preliminary Response was provided, via email, to the Petitioner by serving the correspondence address of record as follows:

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