

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN PINCAN TECHNOLOGY CO., LTD.,

Petitioner,

v.

RIDGE WALLET, LLC,

Patent Owner.

Case IPR2024-00340

Patent 10,791,808 B2

PETITIONER’S REPLY TO
PATENT OWNER’S PRELIMINARY RESPONSE

I. Issue related to real parties-in-interest

The Swztech, PINCAN, and Mosaic were all defendants in a 337 investigation initiated by the Patent Owner (PO) at the ITC. To respond to the investigation, Swztech and PINCAN jointly hired attorneys from GLACIER LAW LLP (“GLACIER”) as defense lawyers, and also together hired Dr. Cameron as an expert witness. All these actions were independent of Mosaic, as Dr. Cameron was engaged solely on the request of Swztech and PINCAN for tasks such as invalidity arguments. Even for Swztech, although it shared a law firm and expert witness with PINCAN during the ITC phase, the initiation of the ‘340 IPR was an independent action only by PINCAN itself and had no connection with Swztech and Mosaic’s instructions or control. The petitioner also lacks the ability to prove the PO’s purely speculative conclusion that “Swztech and/or Mosaic are also an RPI in the ‘340 IPR.

Additionally, the PO rashly speculates from a position of ignorance, concluding that Mosaic has collaborated with Dr. Cameron without ever hiring its own expert. This is unsubstantiated as Mosaic has never paid for Dr. Cameron's services as an expert witness in ITC and PTAB, nor has there been any communication with Mosaic, since, as previously mentioned, Dr. Cameron’s services were engaged solely at the behest of Swztech and PINCAN. No reasonable person, let alone the petitioner, would believe Dr. Cameron would have the inclination to work or collaborate with Mosaic, an entity that does not compensate him, or be under its control. These are merely conjectures from the PO.

II. Issue related to 35 U.S.C. § 325(d)

Firstly, the Patent Owner's ("PO") mere assertion that "Each and Every Primary Reference Was Previously Presented to the Patent Office" is meaningless in addressing the issue of Section 325(d) here. This is because merely claiming that the relevant references were submitted to the PTO, without linking them to the specific facts of the claims being rejected at the time of application prosecution, is of no significance. In fact, in the petition, the petitioner has provided some explanation on this issue. At the time of the '596 application submission, the drafted claims did not involve the auxiliary feature mainly composed of tang, recess, hook, undercut, etc. The examiner rejected all the claims based on references such as *Kane*, *Minn*, *Podwika*, and *Coates*. The PO then amended three independent claims to add the **auxiliary feature** mainly composed of "**tang, recess, hook, undercut**, etc", these limitations regarding the auxiliary feature were not present in the references considered by the examiner at that time, so after the PO added this **auxiliary feature** limitation, the examiner did not continue the prior art search on the auxiliary feature involving **tang, recess, hook, undercut**, etc., but hastily granted the approval of the '596 application. The statements made by the Patent Owner in the prosecution history of the '808 patent admitted these, with the Patent Owner stating: "In other words, the auxiliary feature has a tang that fits into a recess inside the rigidplate, where the tang includes a hook that engages an undercut formed in the recessApplicant submits that there is no such stucture described by the references."

However,the newly introduced references Beckley, Murphy, and Roman each specifically adn exactly disclose the limitations concerning the newly added auxiliary feature (**tang, recess, hook, undercut**, etc), thus addressing the examiner's oversight to a certain extent. And the

references Beckley, Murphy, and Roman, as new evidence, were never previously presented to the Patent Office and are not cumulative of any art previously presented to the Patent Office. Moreover, the specific combinations regarding the invalidity arguments formed by these references in conjunction with Kane and Minn were never meaningfully or substantively considered by the examiner. In fact, the first part of Advanced Bionics framework may not be met even when one piece of asserted art was previously presented to the Office. See *Thorne Research, Inc. v. Trustees of Dartmouth College*, IPR2021-00491, (declining to exercise its discretion to deny institution after finding that the combination of a reference cited during prosecution and two newly asserted references were not the same or substantially the same art previously presented to the Office). “[t]he fact that one piece of art from the combination was previously presented and/or argued to the Office alone is insufficient to satisfy the first prong of Advanced Bionics two-part test.” *Id.* at 8.

Secondly, if a previously presented reference is combined with new art, further analysis is needed before proceeding to the second part of the Advanced Bionics framework. That is, must determine whether the asserted art is “substantially the same” as art or arguments previously presented to the Office. This highly factual inquiry may be informed by evaluating Becton, Dickinson factors (a), (b), and (d). See *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, –IPR2017-01586, Paper 8, 17-18 (P.T.A.B. Dec. 15, 2017) (explaining factors: (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including

whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which a Petitioner relies on the prior art or a Patent Owner distinguishes the prior art). In fact, the PO did not evaluate whether the references Beckley, Murphy, and Roman were "basically the same" as the previously submitted art or arguments according to any of the Becton, Dickinson factors (a), (b), and (d). Instead, the PO simply and blindly emphasized that other references combined with Beckley, Murphy, and Roman (such as Kane and Minn) had already been submitted to the Office, which, as previously discussed, is meaningless.

Thirdly, the PO mentioned that Kaminski was used in Dr. Cameron's expert report at the ITC to assert invalidity. However, this remains meaningless, as the PO is still avoiding the discussion of whether the relevant references are "basically the same" as the previously submitted art or arguments based on Becton, Dickinson factors (a), (b), and (d). First, during the examination of the '808 Patent, Kaminski merely appeared in the IDS and was never substantively or meaningfully considered by the examiner to evaluate the patentability of any claim of the '808 Patent and the '596 application. Second, the fact that Dr. Cameron used Kaminski in his expert report at the ITC is irrelevant to the issue under 325(d) being discussed here, because Dr. Cameron is merely an expert and does not represent the judgment of a PTO examiner. No matter how Dr. Cameron used Kaminski in his ITC report to support his invalidity assertion, it does not change the fact that Kaminski was never substantively or meaningfully considered by the examiner to evaluate the patentability of any claim of the '808 Patent and the '596 application. And Kaminski itself does not disclose the auxiliary feature involving the

limitations of tang, recess, hook, and undercut as Beckley, Murphy, and Roman do. Therefore, Dr. Cameron have recognized the substantial deficiencies of Kaminski after the ITC proceeding and subsequently relied on the art of Beckley, Murphy, and Roman in the IPR proceeding to strengthen her invalidity arguments/combinations.

Finally, the PO also mentioned Chapin. When seeing Chapin, the petitioner found it quite absurd because the PO itself has admitted that Chapin at least does not disclose features such as "**recess, hook, undercut**, etc." The PO added these features to the claims precisely because the examiner used the combination of Kane and Chapin to reject the claims in its application, and the PO wanted to avoid a final rejection by including these features. *See* EX1013, Page 106. Furthermore, after the PO amended the claims, the examiner did not continue to discuss the impact of Chapin on the patentability of the claims modified with auxiliary feature characteristics. In other words, the examiner never substantively considered Chapin's impact on the patentability of the currently amended claims of the '808 patent.

III. CONCLUSION

For the foregoing reasons, the Petition should be instituted/granted.

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Respectfully submitted

/s/ Xiaofang Zhong

Xiaofang Zhong

Lead Counsel for Petitioner

Registration No.: 65747

Email: xzhong@zhonglaws.com

244 Fifth Avenue, Suite V284

New York, N.Y. 10001

Telephone: (646)785-1788

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. § 42.6(e) and § 42.105 that on May 27, 2024, a true and correct copy of the foregoing was served via electronic mail upon counsel of record for the Patent Owner at the following email addresses:

Benjamin E. Weed
Reg. No. 65,939
104 Main Street, Suite 2C
Park Ridge, Illinois 60068
Telephone: (708) 303-8872
Email: ben@ridge.com

Gina A. Johnson
104 Main Street, Suite 2C
Park Ridge, Illinois 60068
Telephone: (708) 303-8872
Email: gina@ridge.com

Dated: May 27, 2024

/s/ Xiaofang Zhong
Xiaofang Zhong
Counsel for Petitioner
Registration No.: 65747
Email: xzhong@zhonglaws.com
Law Office of Xiaofang Zhong, PLLC
244 Fifth Avenue, Suite V284
New York, N.Y. 10001
Telephone: (646)785-1788