

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 SUR-REPLY

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

I. INTRODUCTION

Petitioner's Preliminary Reply ("Reply," Paper 16) does not alter the correct outcome here: denial of the Petition (Paper 1) is appropriate.

While Petitioner was not permitted to respond to the substantive allegations in the Patent Owner Preliminary Response ("POPR," Paper 14), its statements regarding 35 U.S.C. §325(d) further undermine Dr. Cameron's credibility as a whole, and in particular as to her arguments regarding obviousness. The Reply discredits one of Dr. Cameron's prior opinions, stating that "Kaminski itself does not disclose the auxiliary feature involving the limitations of tang, recess, hook, and undercut..." Reply at 4-5. This stands in stark contrast to Dr. Cameron's prior opinions that Kaminski discloses these precise claim limitations. Ex. 2008 at 60-63 (Cameron expert report mapping these limitations to Kaminski).

The Reply focuses on real party-in-interest issues that will be fleshed out upon the requested additional discovery (*see* Paper 13), and provides unpersuasive arguments about 35 U.S.C. §325(d) that should have been included in the Petition, and which were waived as a result. Neither position is compelling, and neither alters the outcome Patent Owner advocated in its POPR.

II. REAL PARTIES-IN-INTEREST

Petitioner does not address the crux of the real party-in-interest inquiry as

detailed in the Patent Owner's Motion for Additional Discovery and as alluded to in the POPR: what ability to control the content of Dr. Cameron's report (which forms the basis of her opinions in this proceeding) did Shenzhen Swztech Co. Ltd. ("Swztech") and/or Mosaic Brands Inc. d/b/a Storus ("Mosaic") have during the time Dr. Cameron was working on the report?

The evidence already of record confirms that Dr. Cameron was working on her invalidity opinions at the time of her deposition on claim construction *on behalf of Swztech*. Ex. 2003 at 21:8-20 (working on, but not finished with, invalidity opinions) Ex. 2006 at ¶2 (confirming she was retained by Swztech). The evidence also shows that Mosaic adopted Dr. Cameron's opinions, and that she became Mosaic's expert witness, at least during the claim construction hearing in the ITC. Ex. 2004 at 13:21-14:1 (citation to ITC transcript pagination). The evidence at the very least indicates that Swztech is an unnamed real party-in-interest, and justifies discovery into whether Mosaic (a time-barred party under 35 U.S.C. § 315 (b)), is a real party-in-interest. *See* Paper 13.

III. THE PETITION SHOULD BE DISCRETIONARILY DENIED

The POPR noted that the Petition failed to address discretionary denial (POPR at 37); as such, the first time the Petitioner was heard on this issue was *after* the POPR was filed. Citing *Thorne Research, Inc. v. Trustees of Dartmouth*

College, IPR2021-00491, Paper 18 (PTAB Aug. 12, 2021), the Petitioner asserts that a lack of complete overlap between examination prior art references and IPR prior art references means that discretionary denial is *per se* inappropriate. Reply at 3. This, of course, cannot be the law; the precedential *Advanced Bionics* case recognizes that the test is whether the art is “the same or *substantially the same*.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7-8 (PTAB Feb. 13, 2020) (precedential) (emphasis added).

Petitioner argues that the POPR did not explain why the references it adds to the very same base references it admits were considered during examination were “basically the same” as materials considered by the Office during examination of the ‘808 Patent. Reply at 3-4. The POPR painstakingly detailed which references were considered and which were not, and went on to explain that the Petition failed to show any material error by the Examiner and why the new references in the Petition are cumulative of art actually considered by the Examiner (and previously used to Dr. Cameron in the ITC to assert invalidity). POPR at 36-41. The POPR also analyzed at least two references (Kaminski and Chapin) that are cumulative of the new references relied on in the Petition. POPR at 39-40. It used figures that Dr. Cameron herself annotated to map to the claim elements in the ITC, further demonstrating that even to Dr. Cameron, the references are cumulative. *Id.*

Specifically, Dr. Cameron previously opined in the ITC that Kaminski discloses the very elements (hook, tangs, recess, and undercut) that are the focus of Petitioner's Reply. Ex. 2008 at 60-61 (mapping Kaminski to claim element 1d). This analysis from the expert supporting the Petition confirms that at least Kaminski is cumulative of the references the Petitioner now relies upon for the hooks, tang, recess, and undercut portions of the claims of the '808 Patent.

The Reply does NOT identify any disclosure in the IPR references that is superior to, or even non-cumulative of, Kaminski and Chapin. To the extent that the Reply addressed the merits of the POPR's arguments about Chapin and Kaminski (which are dubious), Petitioner essentially appears to be arguing that because the '808 Patent is issued over Kaminski and Chapin, the IPR references cannot be cumulative of those references. But this position borders on the absurd: every patent issues over the references considered during its examination, so under Petitioner's worldview, it would be *impossible* for uncited prior art to be found cumulative of the of-record art. And the suggestion that "Kaminski was never substantively or meaningfully considered by the examiner..." or that "the examiner did not continue to discuss the impact of Chapin on the patentability..." (Reply at 4-5) does a substantial injustice to the work done by the Examiner during prosecution. It also runs afoul of the recognition by the PTAB in a precedential

opinion that “[p]reviously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics*, Paper 6 at 7-8. And of course, it is at odds with Dr. Cameron’s ITC opinions. Ex. 2008 at 60-61. The ‘808 Patent was allowed because the claims are patentable over Chapin and Kaminski. Ex. 1001 at cover. And the claims remain patentable over the cumulative references used to replace Chapin and Kaminski in the Petition.

Finally, Petitioner still does not demonstrate material error. *See Advanced Bionics*, Paper 6 at 8; *Ivantis, Inc. et al. v. Sight Sciences, Inc.*, IPR2022-01533, Paper 14 at 18-20 (PTAB Mar. 27, 2023) (failure to demonstrate material error by bare assertion that references were not applied during prosecution).

IV. CONCLUSION

Petitioner’s Reply does not alter the correct outcome here: Petition denial for substantive and/or discretionary reasons.

Date: June 4, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned certifies that on June 4, 2024, a complete and entire copy of this Patent Owner's Preliminary Sur-Reply was provided, via email, to the Petitioner by serving the correspondence address of record as follows:

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