

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.

IPR2024-00340
Patent 10,791,808 B2

Before WILLIAM V. SAINDON, JASON W. MELVIN, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background and Summary

Shenzhen Pincan Technology Co. Ltd. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–24 (the “challenged claims”) of U.S. Patent 10,791,808 B2 (Ex. 1001, “the ’808 patent”). Paper 1 (“Pet.”). Ridge Wallet, LLC (“Patent Owner”) filed a Preliminary Response. Paper 14 (“Prelim. Resp.”). After receiving authorization, Patent Owner filed a Motion for Additional Discovery (Paper 13, “Mot.” or “Motion”) and Petitioner filed an Opposition to the Motion (Paper 15, “Opp.”). Also with our authorization, Petitioner filed a Preliminary Reply (“Pet. Reply,” Paper 16), and Patent Owner filed a Preliminary Sur-reply (“PO Sur-reply,” Paper 17).

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a) (2020). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least [one] of the claims challenged in the petition.”

After considering the Petition, the Preliminary Response, and the evidence of record, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to at least one of the challenged claims. Accordingly, we institute an *inter partes* review of all challenged claims on all asserted grounds pursuant to 35 U.S.C. § 314. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–1360 (2018) (requiring

institution on all claims, if any); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide 64 (Nov. 2019) (“Trial Practice Guide”) (providing guidance in view of *SAS*).¹

B. Real Parties-in-Interest

Petitioner identifies Shenzhen Pincan Technology Co. Ltd. as the real-party-in interest. Pet. 2. Patent Owner identifies The Ridge Wallet LLC as the real party-in-interest. Paper 4, 1.

Patent Owner argues that the Petition should be dismissed, however, because Petitioner omitted an alleged RPI—Shenzhen Swztech Co. Ltd. (“Swztech”)—which demonstrates “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.” Prelim. Resp. 13. In addition, Patent Owner argues that the Petition is time barred because it was filed more than one year after another alleged RPI—Mosaic Brands Inc. d/b/a Storus (“Mosaic”)—was sued for infringement of the ’808 patent. *Id.* at 14. We disagree with Patent Owner’s arguments. We are persuaded that Petitioner correctly identifies itself as the only real party in interest in this proceeding (*see* Pet. 2), and we are persuaded that Mosaic is not an unnamed RPI of Petitioner. As a result, we do not deny institution due to these alleged real parties-in-interest or privies.

1. Summary of Applicable Law

A petitioner must “identif[y] all real parties in interest” in an *inter partes* review petition (37 C.F.R. § 312(a)(2)), and the petition must be filed no more than one year after “the date on which the petitioner, real party in

¹ Consolidated PTAB Trial Practice Guide (Nov. 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

interest, or privy of the petitioner is served with a complaint alleging infringement of the patent” (35 U.S.C. § 315(b)).

A petitioner’s identification of RPIs “should be accepted unless and until” a patent owner “produce[s] some evidence that tends to show that a particular third party should be named a real party in interest.” *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1243–44 (Fed. Cir. 2018). “A mere assertion that a third party is an unnamed real party in interest, without any support for that assertion, is insufficient to put the issue into dispute.” *Id.* Once the patent owner has sufficiently raised the issue, the “petitioner bears the burden of persuasion to demonstrate that its petitions are not time-barred under § 315(b) based on a complaint served on a real party in interest more than a year earlier.” *Id.* at 1242.

Determining whether a non-party is a “real party in interest” or “privy” is a highly fact-dependent inquiry that takes into consideration how courts have viewed these terms. Trial Practice Guide 13 (citing *Taylor v. Sturgell*, 553 U.S. 880, 895 (2008); Charles Alan Wright, Arthur R. Miller & Edward H. Cooper, Federal Practice & Procedure §§ 4449, 4451). This inquiry demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018) (“*AIT*”). Privy “is an equitable rule that takes into account the practical situation, and should extend to parties to transactions and other activities relating to the property in question.” *Id.* at 1349 (quotation and emphasis omitted). But the mere existence of some relationship between a petitioner and another entity is not

sufficient—that relationship must be related to the lawsuit and be sufficiently close that it can be fairly said the petitioner had a full and fair opportunity to litigate the validity of the patent in that lawsuit. *See WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1319 (Fed. Cir. 2018). As the Federal Circuit explains,

the inquiry has a dual-focus on preventing the petitioner from now lodging a successive attack for which it already had a first bite, thus, protecting the defending party from an unwarranted second attack, while also ensuring that the petitioner is not unfairly limited in its ability to lodge its challenges if it has not had a full and fair opportunity to do so already.

Uniloc 2017 LLC v. Facebook Inc., 989 F.3d 1018, 1028 (Fed. Cir. 2021); *see also AIT*, 897 F.3d at 1349–50. Depending upon the circumstances, a number of factors may be relevant to the RPI or privity analysis, and relevant considerations include:

(1) an agreement to be bound; (2) pre-existing substantive legal relationships between the person to be bound and a party to the judgment (e.g., “preceding and succeeding owners of property”); (3) adequate representation by someone with the same interests who was a party (e.g., “class actions” and “suits brought by trustees, guardians, and other fiduciaries”); (4) assumption of control over the litigation in which the judgment was rendered; (5) where the nonparty to an earlier litigation acts as a proxy for the named party to relitigate the same issues; and (6) a special statutory scheme expressly foreclosing successive litigation by nonlitigants.

WesternGeco, 889 F.3d at 1319 (citing *Taylor*, 553 U.S. at 894–95).

2. *Shenzhen Swztech Co. Ltd.* (“Swztech”)

According to Patent Owner, Swztech is an RPI, but was not properly named. Prelim. Resp. 13. Patent Owner reasons that Swztech is an

unnamed RPI because “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” and “Swztech’s counsel in the ITC Case was the same law firm as is representing the Petitioner here.” *Id.* (citing Exs. 1003, 2006). In response, Petitioner argues that even though “it shared a law firm and expert witness” with Swztech during the ITC phase, “the initiation of the ‘340 IPR was an independent action only by [Petitioner] itself and had no connection with Swztech and Mosaic’s instructions or control.” Pet. Reply 1.

We determine that we need not address whether Swztech is an unnamed RPI in this proceeding. As the Board explained in *SharkNinja*, it “better serves the interest of cost and efficiency” when the Board does not engage in the “extensive analysis” required to determine whether a party is an unnamed RPI if the result of that analysis has no material impact on the proceeding. *SharkNinja v. iRobot Corp.*, IPR2020-00734, Paper 11 at 19–20 (PTAB Oct. 6, 2020) (precedential). Here, it is undisputed that Petitioner could have named Swztech as an RPI in its Petition without triggering a statutory bar or estoppel under 35 U.S.C. § 315.

3. *Mosaic Brands Inc. d/b/a StorUs (“Mosaic”)*

Patent Owner contends that Mosaic is also an unnamed RPI of Petitioner. Prelim. Resp. 13; PO Sur-reply 1–2. Consequently, Patent Owner argues that the Petition is time barred under 35 U.S.C. § 315(b) because Mosaic sued Patent Owner in 2020 in the Central District of California (“California Litigation”)², and on November 12, 2020, Patent

² *The Ridge Wallet LLC v. Mosaic Brands, Inc.*, Case No. 2:20-cv-04556 (C.D. CA) (filed May 20, 2020; terminated Aug. 17, 2023).

Owner countersued Mosaic for infringement of the '808 patent. Prelim. Resp. 14 (citing Ex. 2005). We disagree with Patent Owner's contention.

On this record, there is essentially no evidence that Mosaic is an RPI of Petitioner. There is no evidence that Mosaic exercised any control over Petitioner's decision to file the Petition (or over the arguments included therein), and there is no indication that Mosaic had any authority to do so. The record does not suggest that Mosaic provided any funding for this *inter partes* review. Nothing in the record suggests that Petitioner is acting as an agent or proxy of Mosaic to challenge the '808 patent, or that the Petition was filed at Mosaic's behest. Rather, the evidence indicates that Petitioner, through its own counsel, filed the Petition seeking to assert its own interests wholly independently of Mosaic. Moreover, we discern no basis for inferring that Petitioner had an opportunity to litigate the validity of the '808 patent in the California Litigation. There is no evidence that Petitioner exercised any control over the defense of the California Litigation (or had any authority to do so), and there is no evidence that Petitioner had any involvement in—or even knowledge of—the California Litigation. On these points, Patent Owner does not argue otherwise.

Instead, Patent Owner argues that Mosaic is an unnamed RPI because “Mosaic and Petitioner were in a joint defense group, and participated together in activities in defense of the ITC Case before Mosaic settled out in the summer of 2023.” Mot. 1. According to Patent Owner, “Mosaic adopted Dr. Cameron's opinions, and that she became Mosaic's expert witness, at least during the claim construction hearing in the ITC.” PO Sur-reply 2 (citing Ex. 2004, 13:21–14:1). However, Patent Owner's arguments based on the sharing of trial counsel in the ITC case by a non-party to an

IPR accused of infringing the same patent as the petitioner is a common occurrence, and by itself it is insufficient to make that non-party a real party-in-interest. *See Adobe Inc. v. Rah Color Technologies LLC*, IPR2019-00629, Paper 35 at 12–13 (PTAB Sept. 4, 2019)). There is no specific evidence that the Petition was filed at Mosaic’s behest or to benefit Mosaic. To the contrary, Petitioner has its own, independent reason for filing its Petition as Patent Owner has sued Petitioner for allegedly infringing the ’808 patent. Pet. 3. In light of the particular facts before us, we agree with Petitioner that Mosaic is not an unnamed RPI.

C. Related Proceedings

The parties identify a number of proceedings in which the ’808 patent is asserted, including *Certain Compact Wallets and Components Thereof*; Inv. No. 337-TA-1355(USTIC) (“the ITC case”) and *The Ridge Wallet, LLC v. Shenzhen Pinan Technology Co. Ltd. d/b/a ARW-Wallet*, Case No. 23-cv-00392 (EDTX). Pet. 3; Paper 4, 3–4. Patent Owner also identifies that the ’808 patent is asserted in *The Ridge Wallet LLC, v. Mountain Voyage Company LLC*, Case No. 23-cv-00407 (DCO).

D. Overview of the ’808 Patent

The ’808 patent is titled “COMPACT WALLET.” Ex. 1001, code (54). The ’808 patent describes that “[t]he present invention utilizes bookend plates resiliently bound with an encircling elastic band to contain one or more credit card-sized objects in a wallet configuration.” *Id.* at 2:9–11. The ’808 patent identifies that “an object of the invention to provide a compact wallet substantially no larger than a credit card” and “a further object to maximize expandability of the wallet to accommodate multiple objects of substantially the same size.” *Id.* at 2:24–28.

Figure 11 of the '808 patent illustrates the compact wallet with an attached money clip, and is reproduced below.

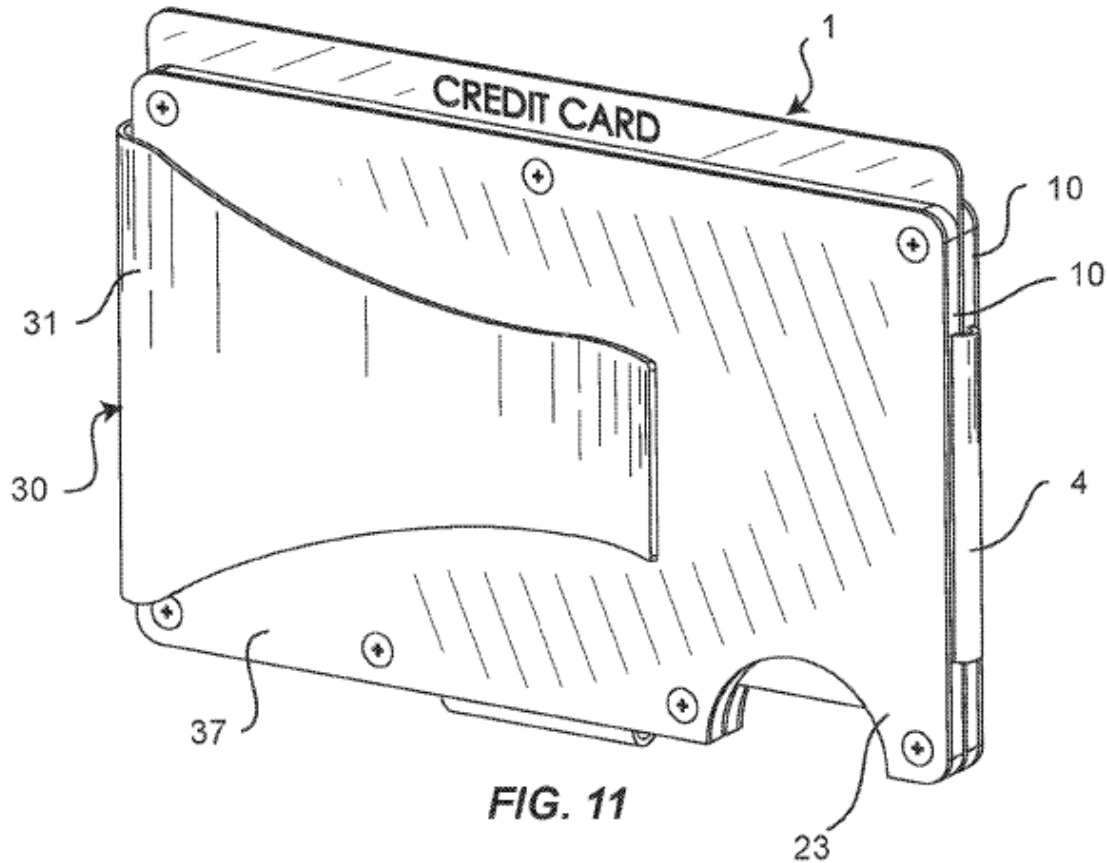


Figure 11 depicts a perspective view of the compact wallet 1 of the present invention. Ex. 1001, 3:30–31. More particularly, Figure 11 illustrates compact wallet 1

comprised of at least two rigid plates 10, serving as “bookends” as it were, with one or more card-like contents 2 sandwiched between them. The sandwiched composite is bound by at least one encircling elastic band 4. The encircling elastic band 4 holds the card-like contents 2 securely by means of compression, while also expanding elastically to open space between the rigid plates 10.

Id. at 3:58–65. Figure 11 also illustrates auxiliary feature 30, which encompasses money clip 31 that “is added to at least one of the rigid plates

10 to occupy a position on an outside surface 37 thereof.” *Id.* at 5:11–13.

The ’808 patent discloses that

auxiliary feature 30 is removably attached to at least one of the rigid plates 10 by means of a tang 33 inserted into a recess 34 in the groove 21 outboard of the elastic band 4. The outboard positioning prevents interference with the free operation of the elastic band. In a particularity, the recess 34 has an undercut 35 and the tang 33 has a hook 36 (FIG. 12). The hook 36 engages the undercut 35 to prevent inadvertent dislodgement of the auxiliary feature 30 when attached to 30 the compact wallet 1.

Id. at 5:23–31.

E. Illustrative Claim

Petitioner challenges claims 1–24 of the ’808 patent. Pet. 1.

Challenged claims 1, 14, and 19 are independent. Claim 1 is illustrative, and is reproduced below.

1. A compact wallet, comprising:

at least two rigid plates interposed to sandwich card-like contents there between, each rigid plate having a longitudinal extent;

at least one encircling elastic band interposed with the at least two rigid plates along longitudinal extents thereof to bias them inwardly and securely hold the card-like contents while providing elastic volume there between for adding or removing contents;

a channeling means configured to minimize the profile of the wallet and hold position of the at least one encircling elastic band with respect to each rigid plate while allowing freedom for the dynamic extension and contraction of the band over the entire running length thereof; and

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,

whereby, card-like contents may be carried with minimal silhouette on or with a person while allowing expandable capacity and ready access to individual contents from between the at least two rigid plates.

Ex. 1001, 6:40–65.

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–24 of the '808 patent are unpatentable on the following fourteen grounds (Pet. 5):

Claim(s) Challenged	35 U.S.C. §³	Reference(s)/Basis
1–9, 11–24	103	Kane ⁴ , Beckley ⁵
10	103	Kane, Beckley, Minn ⁶
13	103	Kane, Beckley, Preston-Hall ⁷
1–9, 11–24	102	Kane, Murphy ⁸
10	103	Kane, Murphy, Minn
13	103	Kane, Murphy, Preston-Hall
1–9, 11–24	103	Kane, Roman ⁹
10	103	Kane, Roman, Minn
13	103	Kane, Roman, Preston-Hall

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103 effective March 16, 2013. Because the '808 patent's earliest effective filing date is after the effective date of the AIA amendments to §§ 102 and 103, this decision refers to the AIA versions of §§ 102 and 103.

⁴ The Ridge Wallet 2.0 (Kickstarter), Retrieved from the Internet on Sept. 3, 2013, URL: <<https://www.kickstarter.com/projects/124039987/the-ridge-wallet-20/>>. (Ex. 1004, “Kane”).

⁵ US 9,125,465 B2, issued Sept. 8, 2015 (Ex. 1008, “Beckley”).

⁶ US 9,125,464 B2, issued Sept. 8, 2015 (Ex. 1005, “Minn”).

⁷ US 8,381,360 B2, issued Feb. 26, 2013 (Ex. 1010, “Preston-Hall”).

⁸ US 2006/0010661 A1, published Jan. 19, 2006 (Ex. 1006, “Murphy”).

⁹ US 5,103,884, issued Apr. 14, 1992 (Ex. 1012, “Roman”).

Claim(s) Challenged	35 U.S.C. § ³	Reference(s)/Basis
1–24	103	Minn, Podwika ¹⁰ , Coates ¹¹ , Beckley
13	103	Minn, Podwika, Coates, Beckley, Preston-Hall
1–24	103	Minn, Podwika, Coates, Murphy
13	103	Minn, Podwika, Coates, Murphy, Preston-Hall
3, 16	103	Kane, Beckley, Singer ¹²

Petitioner also relies on the Declaration of Dr. Kimberly Cameron.

Ex. 1003; *see also* Ex. 1015 (Exhibit A of Cameron Declaration (Kane)); Ex. 1016 (Exhibit B of Cameron Declaration (Minn)).

II. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (2012) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)).

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which that subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406

¹⁰ US 5,944,080, issued Aug. 31, 1999 (Ex. 1009, “Podwika”).

¹¹ US 7,527,081, issued May 5, 2009 (Ex. 1011, “Coates”).

¹² US 2015/0059936 A1, published Mar. 5, 2015 (Ex. 1019, “Singer”).

(2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness when presented. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In analyzing the obviousness of a combination of prior art elements, it can be important to identify a reason that would have prompted one of skill in the art “to combine . . . known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418. A precise teaching directed to the specific subject matter of a challenged claim is not necessary to establish obviousness. *Id.* Rather, “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 420. Accordingly, a party who petitions the Board for a determination of unpatentability based on obviousness must show that “a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (citations omitted).

We analyze the challenges presented in the Petition in accordance with the above-stated principles.

B. Level of Ordinary Skill in the Art

We review the grounds of unpatentability in view of the understanding of a person of ordinary skill in the art at the time of invention.

Graham, 383 U.S. at 17. Factors pertinent to determining the level of ordinary skill in the art include (1) the educational level of the inventor; (2) the type of problems encountered in the art; (3) prior-art solutions to those problems; (4) the rapidity with which innovations are made; (5) the sophistication of the technology; and (6) the educational level of workers active in the field. *Env'tl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696–97 (Fed. Cir. 1983). Not all factors may exist in every case, and one or more of these or other factors may predominate in a particular case. *Id.* Moreover, these factors are not exhaustive, but merely a guide to determining the level of ordinary skill in the art. *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007). Further, the prior art itself may reflect an appropriate skill level. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

Petitioner asserts that one of ordinary skill in the art would have had “a technical degree (e.g., Bachelor of Science in engineering) with some experience in analyzing, designing, or creating mechanical devices such as wallets.” Pet. 15. At this stage of the proceeding, “Patent Owner does not dispute Petitioner’s proffered identification of [one of ordinary skill in the art]’s skill level.” Prelim. Resp. 14. Patent Owner notes, however, that “Dr. Cameron does not appear to offer an opinion” to support Petitioner’s assertion regarding the level of skill in the art. *Id.* (citing Ex. 1003).

On the current record, we determine that Petitioner’s definition of a person of ordinary skill in the art is consistent with the scope and content of the ’808 patent and the asserted prior art, and, at this stage, we apply Petitioner’s definition for purposes of this Decision.

C. Claim Construction

In an *inter partes* review, a patent claim shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b). This rule adopts the same claim construction standard used by Article III federal courts, which follow *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny.

Under that standard, the words of a claim are generally given their “ordinary and customary meaning,” which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *See Phillips*, 415 F.3d at 1312–13. “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

According to Petitioner, “the parties have fully briefed the constructions of all disputed terms, and Petitioner understands that the ITC has issued an Order construing certain claim terms.” Pet. 11–12 (citing Ex. 1014.). With the exception of the term “channeling means,” Petitioner contends that terms of the ’808 patent should be construed according to “the plain and ordinary meaning of those terms in light of the specification” and that “the challenged claims are anticipated or obvious under any reasonable interpretation.” *Id.* at 12. Patent Owner agrees with Petitioner’s assessment and adds that “the District Court for the District of Colorado issued another

order construing the claims of the ‘808 [p]atent consistent with the ITC’s Order (Ex. 1014).” Prelim. Resp. 14–15 (citing Ex. 2010).

However, Patent Owner points out that Dr. Cameron also served as the claim construction expert in the ITC case, and in the ITC case “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.” Prelim. Resp. 15 (citing Ex. 2006, 4). Patent Owner argues that Petitioner’s failure to reconcile “Dr. Cameron’s inconsistent positions . . . warrant[s] denial of the Petition.” *Id.* at 17. We disagree because indefiniteness “does not necessarily preclude the Board from addressing the patentability of the claims on section 102 and 103 grounds.” *Samsung Elecs. Am. Inc. v. Priusa Eng’g Corp.*, 948 F.3d 1342, 1355 (Fed. Cir. 2020); *see also Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 813 (Fed. Cir. 2021) (“The indefiniteness of a limitation . . . precludes a patentability determination only when the indefiniteness renders it logically impossible for the Board to reach such a decision.”).

We determine, at this stage, that no terms require explicit construction to resolve the issues presented by the arguments and evidence of record to reach a decision on institution. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (per curiam) (claim terms need to be construed “only to the extent necessary to resolve the controversy” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Summary of Asserted Prior Art References

1. Overview of Kane (Ex. 1004)

Kane is a webpage from Kickstarter describing The Ridge Wallet 2.0. Ex. 1004, 3. According to Kane, “The Ridge 2.0 can accommodate various numbers of cards without losing elasticity; providing an extremely thin wallet that isn't limited in it[s] capacity.” *Id.* A graphic depicting Kane’s wallet is reproduced below.



The graphic above depicts Kane’s wallet with cards disposed therein. *Id.* at 5. Kane discloses that its “Integrated Elastic Track can expand to hold up to 12 cards and then immediately contract to hold a single card securely.” *Id.* A graphic demonstrating the elasticity of Kane’s wallet is reproduced below.

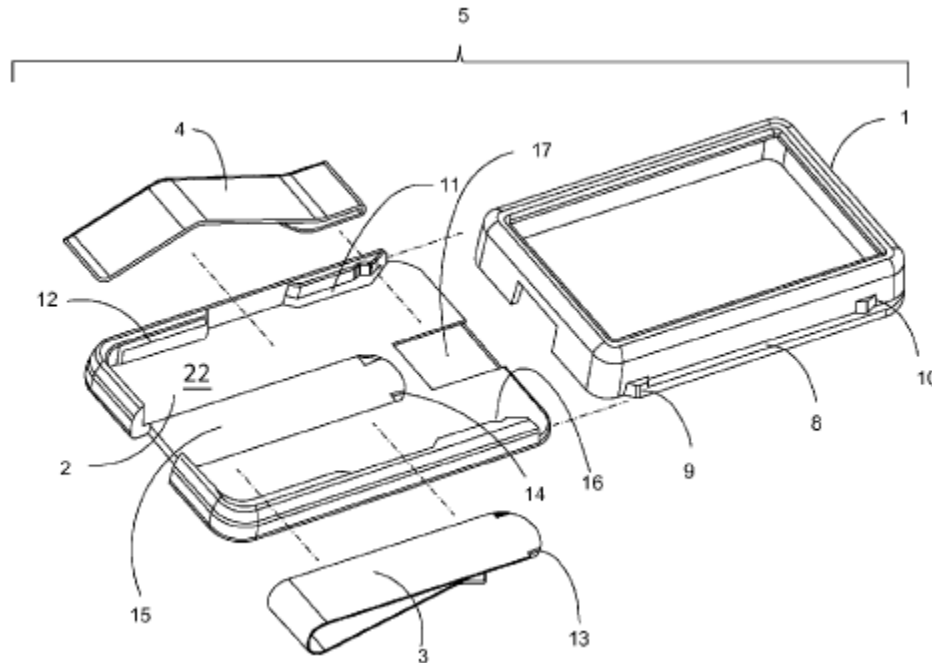


The graphic above depicts Kane’s wallet expanding to hold 1, 4, 7, and 10 cards. *Id.*

2. Overview of Beckley (Ex. 1008)

Beckley “relates in general to a wallet, and more particularly to a semi-rigid apparatus that securely contains items usually carried on one’s person such as identification cards, credit cards, currency, etc.” Ex. 1008,

1:12–15). An exemplary embodiment of wallet 5 is depicted in Beckley’s Figure 1, reproduced below.

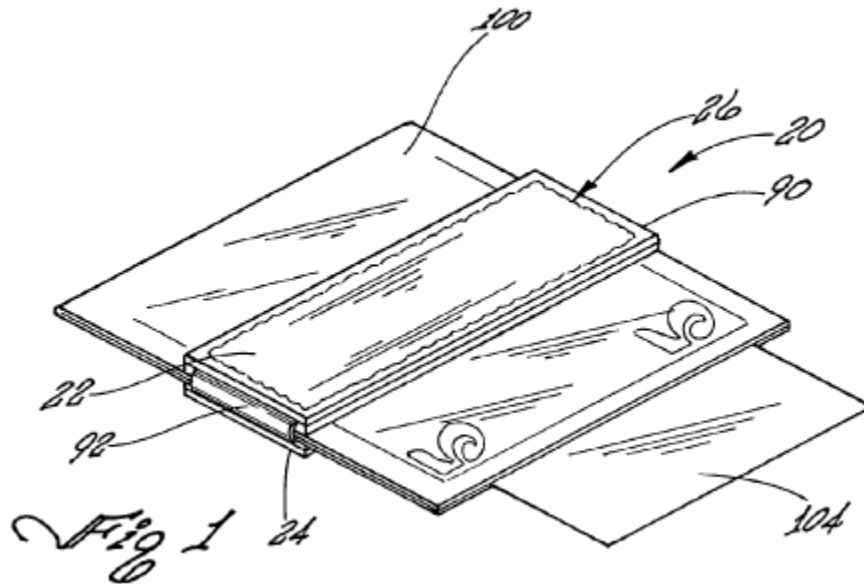


As shown in Figure 1, wallet 5 includes “four separate components including a container portion 1, a base portion 2, a spring clip 3 for holding currency and a retention spring 4 for card retention.” *Id.* at 3:57–61. More particularly, Beckley discloses that “clip 3 is assembled to the base 2 by inserting the clip 3 into a depression 15” and “held in place by a pair of barbs seen at 13 mated into a set of cavities 14 on the base 2” with retention spring 4 being “assembled to the base 2 by sliding it onto a pocket 17.” *Id.* at 4:32–36.

3. Overview of Preston-Hall (Ex. 1010)

Preston-Hall is directed to “a card and currency carrying device having a pair of spaced side members for holding and securing at least one item of folded currency and at least one card.” Ex. 1010, 1:22–25. An

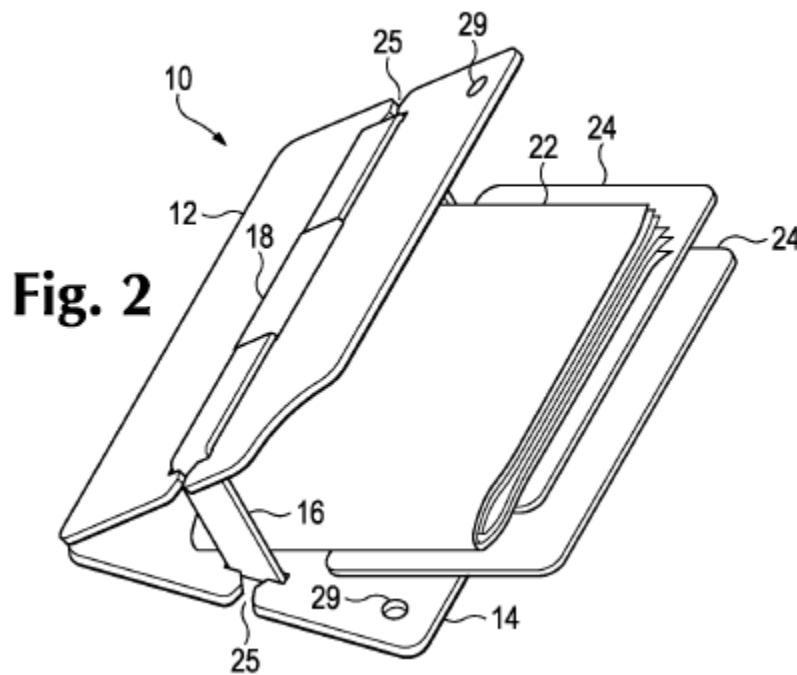
exemplary embodiment of Preston-Hall's card and currency carry device is depicted in Figure 1, reproduced below.



As shown in Figure 1, Preston-Hall's card and currency carry device includes "elastic fabric material is in the form of fabric material segments 90 and 92" with currency 100 and cards 104 "within the fold of the currency." *Id.* at 9:20–23. Preston-Hall describes that endless loop 90 is comprised "of a woven, longitudinally extendable, elastic fabric material having a predetermined length located between each of the outer planar support members 50, 54, 70 and 76 and its adjacent deflectable spring 28 and 30." *Id.* at 11:16–20.

4. Overview of Minn (Ex. 1005)

Minn is directed to a "low profile wallet" comprised of "two metal and/or carbon fiber plates 12 and 14 held together with an elastic strap 16." Ex. 1005, 2:19–21. Figure 2 depicts a perspective view showing Minn's low profile wallet in an open position, reproduced below. *Id.* at 1:35–36.



As shown in Figure 2, “[e]lastic strap 16 is connected at opposite ends by a relatively flat metal, plastic, leather or polyurethane leather clasp 18 and inserts into openings 25 formed in opposite ends of plates 12 and 14.” *Id.* at 2:26–29.

5. Overview of *Murphy* (Ex. 1006)

Mouhot is directed “to a clipping device useful for adjusting the size or shape of a garment.” Ex. 1006 ¶ 1. Figure 1 of *Murphy* depicts a front perspective view of an embodiment of the invention “showing the exterior face portion of the sleeve and an interior clip portion of the clip-member when the two parts are detached from each other,” reproduced below. *Id.* ¶ 36.

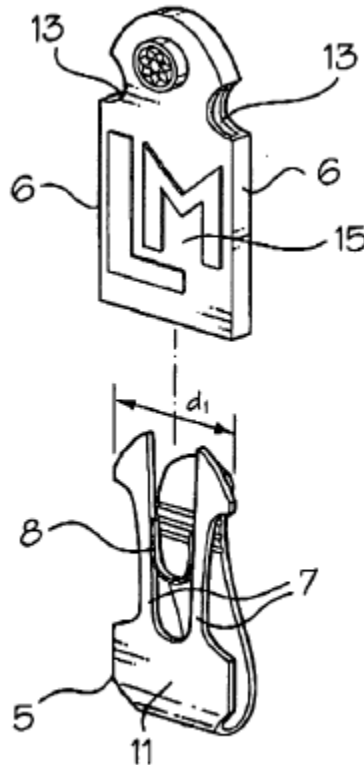


FIG. 4

As shown in Figure 4, sleeve (6) may be provided separately from the clip-member (5). *Id.* ¶ 54. Murphy discloses that

[t]he sleeve typically will have an Interior face portion (14), a display portion as illustrated by exterior face portion (15), an open bottom end, and define a cavity (9) therein, the cavity (9) having a geometry and depth sufficient to firmly contain the interior clip portion (11) of the clip-member (5). In order to coordinate with the arrow-shaped securement members (7) of the clip-member (5), the sleeve has two recessed openings formed on sides thereof.

Id.

Murphy also discloses that its “garment clip may also be used with any style of clothing, from casual to formal attire, or as a money clip, etc.”

Ex. 1006 ¶ 60.

6. Overview of Roman (Ex. 1012)

Roman is directed to a “wallet having a removable clip which is small and compact for carrying money and credit cards which and is easily accessible without removal from the clipped position.” Ex. 1012, 1:59–63. Figure 9 depicts “a perspective view illustrating the easy clip removal for separate use of the clip and wallet,” reproduced below. *Id.* at 2:44–45.

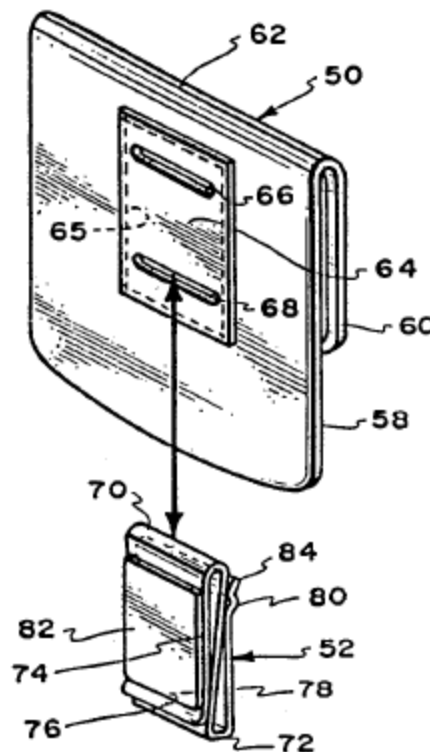


Fig. 9.

As shown in Figure 9, clip 52 includes

a triple-fold band of metal having bends at 70 and 72 forming frontplate 74, middleplate 76 and backplate 78. Backplate 78 has a dimpled rib 80 providing a bight against middleplate 76 to help retain the clip in the pocket 65 formed by slot 66 and 68. The tri-fold clip is advantageous because it minimizes the possibility of being dislodged from pocket 65.

Id. at 4:11–18.

7. *Overview of Podwika (Ex. 1009)*

Podwika is directed “generally to money clips,” and more particularly, “to devices for holding money and cards.” Ex. 1009, 1:8–10. Figure 1 of Podwika depicts “a perspective view of a money and card holder according to one embodiment of the present invention, with a plurality of cards and a plurality of bills shown in phantom lines,” as reproduced below. *Id.* at 3:14–17.

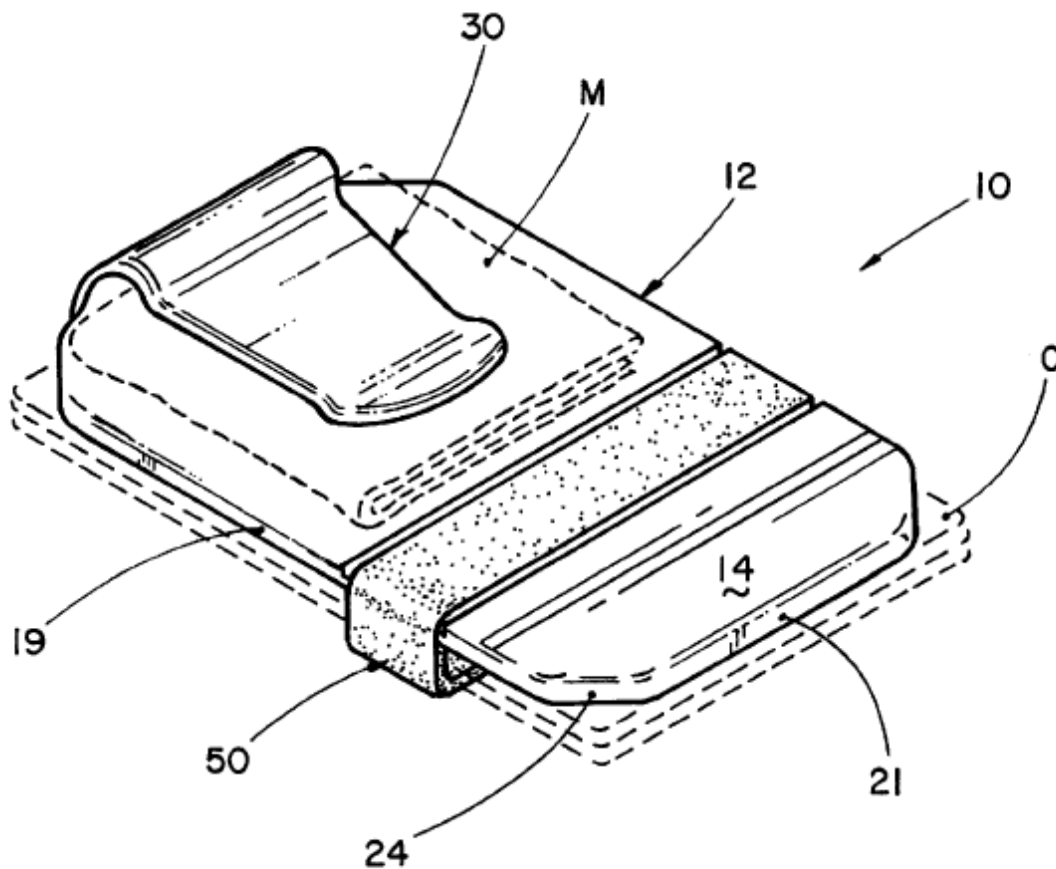


FIG. 1

As shown in Figure 1, money and card holder 10 “generally includes a base 12 with an integral retaining member (hereinafter referred to as a clip 30) and an elastic retaining band 50. The base 12 and clip 30 are integrally

formed, and preferably from any sturdy and lightweight material.” *Id.* at 3:30–38.

Figure 3 depicts a cross sectional view of Podwika’s money and card holder, as reproduced below. Ex. 1009, *Id.* at 3:20–22.

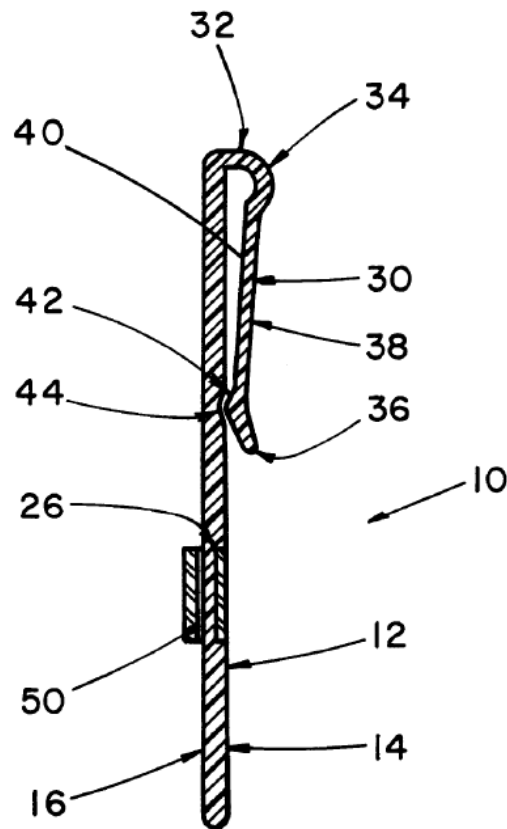


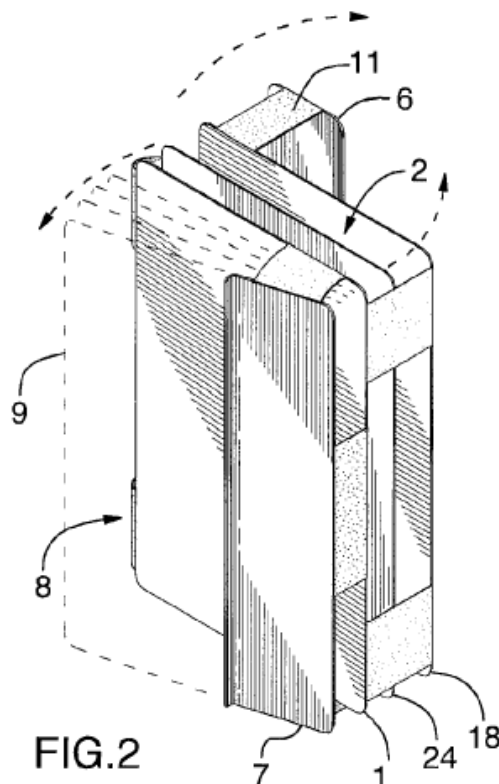
FIG. 3

As shown in Figure 3, “upper surface 14 of the base 12 also includes a recess 26” that “extends transversely between the longitudinally extending side edges 19, 20.” *Id.* at 4:17–19. Podwika discloses that “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.” *Id.* at 4:21–23.

8. *Overview of Coates (Ex. 1011)*

Coates is directed to a wallet “for holding flat items including various cards and folded paper currency bills having two or more of panels joined with resilient members.” Ex. 1011, 1:32–34. Figure 2 of Coates depicts a “perspective view of the device shown in an open position where the retention panel is withdrawn and a credit card pocket is open for insertion and removal of credit card items (shown in dashed outline) and showing the unfolding of the currency pocket with dashed arrows,” as reproduced below. *Id.* at 1:54–58.



As shown in Figure 2, “retention panel 6 resiliently encloses the card pocket 8 as well as the currency pocket 2 . . . and impedes the insertion and

extraction of items from the pockets such as the credit cards 9 or paper currency bill 5.” *Id.* at 3:22–26.

9. *Overview of Singer (Ex. 1019)*

Singer is directed to “a resilient spring-clip to retain items such as credit cards and also to contain devices such as keys as part of a thin laminate with devices held between the outside of the spring-clip and a cover plate.” Ex. 1019 ¶ 3. Figure 3 depicts a perspective view of Singer’s organizer according to certain embodiments, as reproduced below. *Id.* ¶ 11.

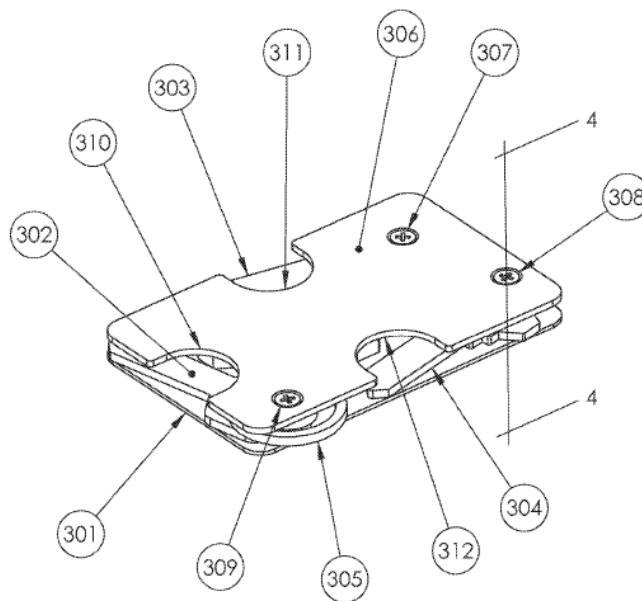


FIG. 3

As shown in Figure 3, “cover 306 is held in place by more than one screw, so it cannot rotate and loosen screws 307, 308 and 309 when keys or tools, such as a USB flash drive, are rotated in and out of the organizer.” *Id.* ¶ 41.

E. *Alleged Obviousness over Kane and Roman (Ground 1G)*

Petitioner asserts that claims 1–9 and 11–24 are unpatentable as obvious over Kane and Roman. Pet. 56–61. Petitioner also relies on the testimony of Dr. Cameron to support its arguments. *Id.* (citing Exs. 1003,

1015). Patent Owner presents arguments disputing Petitioner's assertions. See Prelim. Resp. 23–27.

1. Analysis of Claim 1

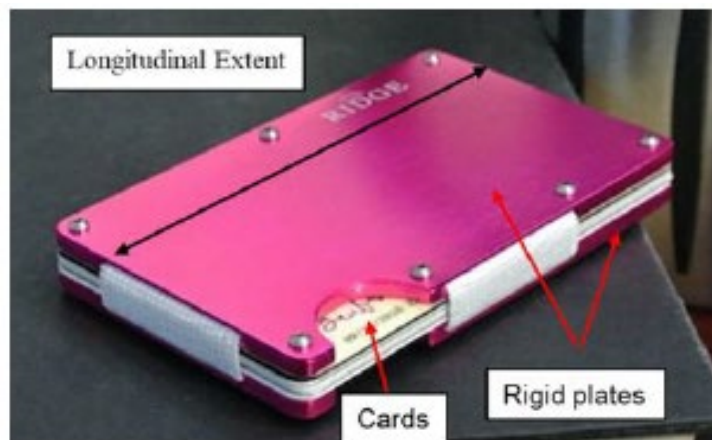
Petitioner asserts that claim 1 is unpatentable as obvious over Kane and Roman. Pet. 56–61 (citing Exs. 1003, 1004, 1012, 1015; Pet. 24–27, 31). We use Petitioner's notations to identify the claim elements.

a) Claim 1pre: A compact wallet, comprising

Petitioner argues that if the preamble limiting, Kane discloses a compact wallet. Pet. 56 (citing *id.* at 24–25 (citing Ex. 1004, 3)).

b) Claim 1a: at least two rigid plates interposed to sandwich card-like contents there between, each rigid plate having a longitudinal extent;

Petitioner asserts that Kane discloses this limitation. Pet. 56 (citing *id.* at 25). Petitioner provides the following annotated copy of a figure found on page 5 of Kane. *Id.* at 26 (citing Ex. 1004, 5).



EX1004, page 5.

The wallet shown in Petitioner's annotated figure depicts card-like contents sandwiched between two rigid plates having a longitudinal extent identified

by Petitioner's arrow, annotated in black. *Id.* at 25–26 (citing Ex. 1004, 3, 5).

- c) *Claim 1b: at least one encircling elastic band interposed with the at least two rigid plates along longitudinal extents thereof to bias them inwardly and securely hold the card-like contents while providing elastic volume there between for adding or removing contents;*

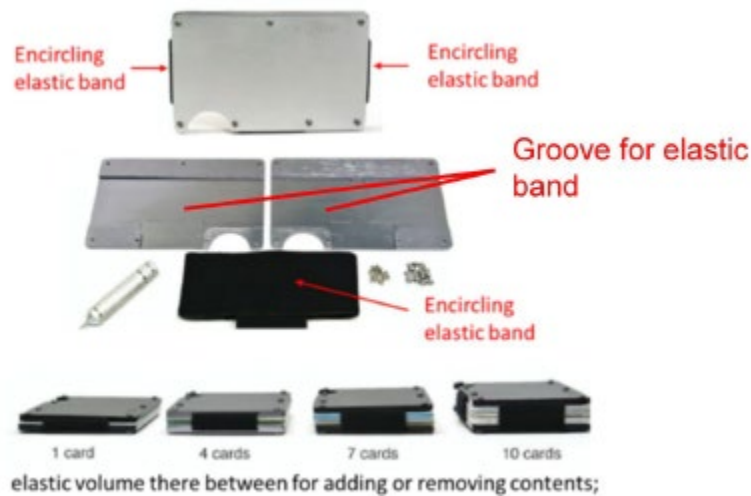
Petitioner asserts that Kane discloses this limitation. Pet. 56 (citing *id.* at 26–27). Petitioner provides the following copy of a figure found on page 5 of Kane. *Id.* at 26 (citing Ex. 1004, 5).



EX1004, page 5.

The wallet shown in the figure reproduced by Petitioner depicts an elastic band that sits in a groove within each rigid plate encircles the plates and cards. *Id.* at 26 (citing Ex. 1004, 3). Petitioner asserts that Kane discloses that “[w]ith an integrated elastic track, The Ridge 2.0 can accommodate various numbers of cards without losing elasticity; providing an extremely thin wallet that isn’t limited in its capacity.” *Id.* (citing Ex. 1004, 3).

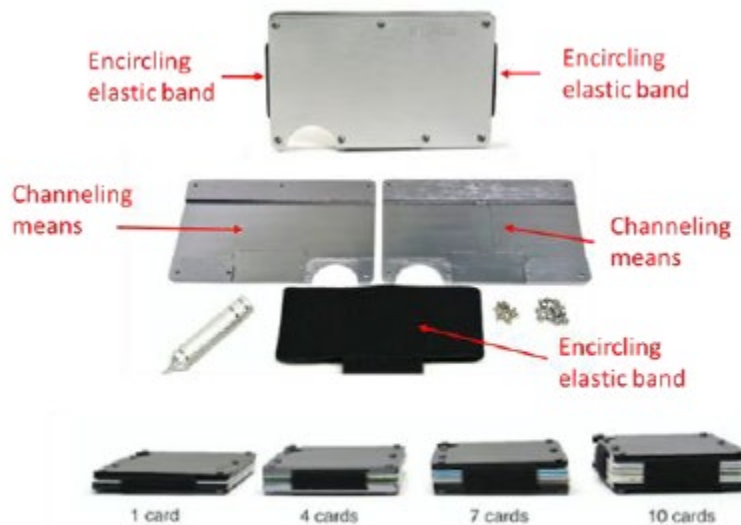
Petitioner also provides the following annotated copy combining two of the figures found on pages 5 and 6 of Kane. Pet. 27 (citing Ex. 1004, 5–6).



The wallet shown in Petitioner's annotated figure depicts Kane's encircling elastic band along with grooves in Kane's rigid plates for the elastic band. *Id.* (citing Ex. 1004, 5–6); *see also* Ex. 1004, 5 (“The track runs along two hollow interior plates machined from anodized aircraft grade aluminum.”). Petitioner's annotated figure also depicts Kane's wallet expanding to accommodate a varying number of cards from 1 to 10. Pet. 27 (citing Ex. 1004, 5–6); *see also* Ex. 1004, 5 (“The Integrated Elastic Track can expand to hold up to 12 cards and then immediately contract to hold a single card securely.”).

- d) *Claim 1c: a channeling means configured to minimize the profile of the wallet and hold position of the at least one encircling elastic band with respect to each rigid plate while allowing freedom for the dynamic extension and contraction of the band over the entire running length thereof; and*

Petitioner asserts that Kane discloses this limitation. Pet. 56 (citing *id.* at 27–28). Petitioner provides the following annotated copy combining two of the figures found on pages 5 and 6 of Kane. *Id.* at 28 (citing Ex. 1004, 5–6).



EX1004, pages 5,6.

The wallet shown in Petitioner’s annotated figure depicts Kane’s encircling elastic band along with grooves in Kane’s rigid plates for the elastic band. *Id.* (citing Ex. 1004, 5–6). According to Petitioner, “[a] groove in the rigid plate running along the length captures the elastic band. The band can stretch and contract and slide within the groove over the length of the band.” *Id.* at 27. And, relying on the annotated figure above, Petitioner asserts that Kane discloses

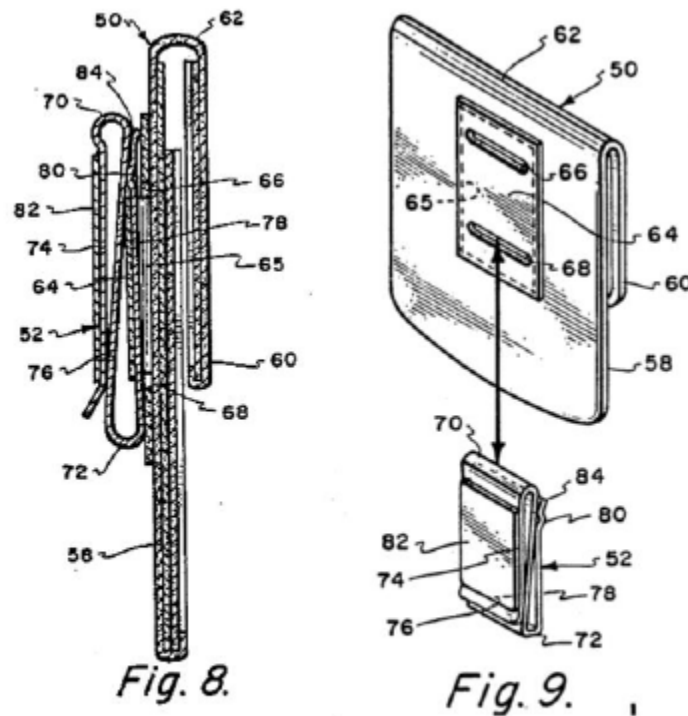
a first lamina of each rigid plate has a groove the width of the elastic band to capture the band without restricting the ability of the band to extend and contract over its entire length. This makes it easy to accommodate differing amounts of cards as seen in the series of images showing 1, 4, 7 and 10 cards.

Id. (citing Ex. 1004, 5–6).

- e) *Claim 1d: 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,

Petitioner asserts that Roman discloses this limitation. Pet. 56–58 (citing Ex. 1015, 6). Petitioner reproduces the following figure combining Figures 8 and 9 of Roman. *Id.* at 57 (citing Ex. 1012, Figs. 8, 9).



EX1012, Figs. 8-9

Figure 8 is a sectional view of Roman’s compact wallet construction and Figure 9 is “a perspective view illustrating the easy clip removal for separate use of the clip and wallet.” Ex. 1012, 2:43–45. With reference to Figures 8 and 9, Petitioner asserts that Roman discloses “that ‘backplate **78** [tang] has a dimpled rib **80** providing a bight [hook] against middleplate **76** to help retain the clip [auxiliary feature] in the pocket **65** [recess] formed by slot **66** [undercut] and **68**.’” Pet. 57–58 (citing Ex. 1012, 4:14–17) (modification in

original). Relying on the declaration testimony of Dr. Cameron, Petitioner asserts that one of ordinary skill in the art would have known

“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.”

Id. at 58 (quoting Ex. 1015, 6). Petitioner adds that one of ordinary skill in the art would “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.” *Id.*

f) Claim 1e: whereby, card-like contents may be carried with minimal silhouette on or with a person while allowing expandable capacity and ready access to individual contents from between the at least two rigid plates.

Petitioner asserts that Kane discloses this limitation. Pet. 56 (citing *id.* at 31). Petitioner provides the following annotated copy combining three of the figures found on pages 4 and 5 of Kane. *Id.* (citing Ex. 1004, 4–5).



EX1004, page 4



EX1004, page 5, annotated.

Petitioner's annotated figure depicts various features of Kane's wallet. According to Petitioner, the figure above demonstrates that Kane's wallet has an "expandable capacity" that provides "ready access" to between one and ten cards, and may be carried with a "silhouette [that] is the size of a credit card." *Id.*

2. Patent Owner's Contentions Regarding Claim 1

Patent Owner contends that Petitioner's ground of unpatentability based on Kane and Roman is deficient. *See* Prelim. Resp. 23–27. More

particularly, Patent Owner argues that Petitioner’s analysis is conclusory and “devoid of any articulation of a reason” as to why one of ordinary skill in the art would have combined Kane and Roman. *Id.* at 23–24.

3. *Discussion of Claim 1*

Having considered the conflicting positions of the parties, we conclude that, at this stage of the proceeding, Petitioner has shown a reasonable likelihood that it would prevail in challenging the patentability of independent claim 1. In our view, Petitioner’s analysis, on this record, adequately identifies where all the elements of claim 1 are found in Kane and Roman. We also determine that Petitioner provides sufficient arguments and evidence, at this stage of the proceeding, to support its reasoning that a person having ordinary skill in the art would have been motivated to modify Kane’s compact wallet to incorporate the removable clip taught by Roman, as Petitioner proposes.

While we acknowledge Patent Owner’s argument that Petitioner’s analysis is “devoid of any articulation of a reason for that combination” (Prelim. Resp. 24), this does not overcome Petitioner’s evidence that Roman teaches that the desirability of removable clips on compact wallets. *See* Pet. 57 (citing Ex. 1012, 1:54–64). For example, Dr. Cameron’s opines that one of ordinary skill in the art would have known “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.” Prelim. Resp. 24 (citing Ex. 1015, 6). On the current record, we find Dr. Cameron’s opinion to be adequately supported by Roman’s disclosure that an object of its “invention is to provide a unique wallet having a removable clip which is small and compact for carrying

money and credit cards . . . and is easily accessible without removal from the clipped position.” Ex. 1012, 1:59–64. Thus, at this stage, we credit Dr. Cameron’s declaration testimony opining that one of ordinary skill in the art would have been “motivated to incorporate the removable clip of Roman into the compact wallet of Kane.” Pet. 58 (quoting Ex. 1015, 6).

We also are not persuaded by Patent Owner’s argument that Petitioner’s analysis is “devoid of any description of what the combination would look like.” Prelim. Resp. 24. Here, Dr. Cameron identifies that “[t]he recess would be between the two lamina of the rigid plate of Kane and the undercut would be in one of the lamina” (Pet. 58 (quoting Ex. 1015, 6)), and suggests that it would have been obvious to one of ordinary skill in the art “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.” *Id.* On the current record and at this stage of the proceeding, Patent Owner does not argue, and we see no reason to believe, that such a modification is not within the ability of one of skill in the art. *See KSR Int’l Co.*, 550 at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Accordingly, on the current record, we determine that Petitioner has provided sufficient arguments and evidence to support its assertion that one of ordinary skill in the art would have been motivated to combine Kane and Roman. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”).

4. *Conclusion for Ground 1G*

After our review of Petitioner's assertions with respect to claim 1 and the supporting evidence (as summarized above), we determine that Petitioner has shown, sufficiently at this stage, that Kane, in combination with Roman, teaches all the limitations of claim 1, and that a person of ordinary skill in the art would have had reason to combine the features of each reference, Petitioner proposes. We therefore determine that Petitioner is reasonably likely to prevail in showing that claim 1 is unpatentable under § 103(a) as obvious over Kane and Roman.

We have also reviewed the arguments and evidence of record for claims 2–9 and 11–24 in Ground 1G, and similarly find that for purposes of institution, Petitioner has demonstrated a reasonable likelihood that Kane and Roman would have rendered these claims obvious. *See* Pet. 58–61 (citing *id.* at 32–47).

On this basis, we institute *inter partes* review of all challenged claims on all grounds in the Petition. *See SAS Institute Inc.*, 138 S. Ct. at 1358; 37 C.F.R. § 42.108(a).

F. *Remaining Grounds*

Petitioner additionally contends that claim 10 is unpatentable as obvious over Kane, Roman, and Minn (Ground 1H) and claim 13 is unpatentable as obvious over Kane, Roman, and Preston-Hall (Ground 1I). Pet. 61–62. Petitioner alternatively contends that claims 1–9 and 11–24 are unpatentable as obvious over Kane and Beckley (Ground 1A), claim 10 is unpatentable as obvious over Kane, Beckley, and Minn (Ground 1B), claim 13 is unpatentable as obvious over Kane, Beckley, and Preston-Hall (Ground 1C), claims 1–9 and 11–24 are unpatentable as obvious over Kane and

Murphy (Ground 1D), claim 10 is unpatentable as obvious over Kane, Murphy, and Minn (Ground 1E), claim 13 is unpatentable as obvious over Kane, Murphy, and Preston-Hall (Ground 1F). Pet. 24–50. In addition, Petitioner alternatively contends that claims 1–24 are unpatentable as obvious over Minn, Podwika, Coates, and Beckley (Ground 2A), claim 13 is unpatentable as obvious over Minn, Podwika, Coates, Beckley, and Preston-Hall (Ground 2B), claims 1–24 are unpatentable as obvious over Minn, Podwika, Coates, and Murphy (Ground 2C), claim 13 is unpatentable as obvious over Minn, Podwika, Coates, Murphy, and Preston-Hall (Ground 2D), and claims 3 and 16 are unpatentable as obvious over Kane, Beckley, and Singer (Ground 3A). Pet. 62–89.

Because we have determined above that, at this stage of the proceeding and on the present record, the information presented in the Petition and Preliminary Response shows that there is a reasonable likelihood that Petitioner will prevail with respect to at least one claim based on the alleged obviousness over Kane and Roman (Ground 1G), we need not address Petitioner’s additional challenges at this time. *See* 35 U.S.C. § 314(a).

III. DISCRETION UNDER 35 U.S.C. § 325(D)

Patent Owner argues we should exercise discretion under § 325(d) and deny institution because “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 the “Petitioner has not demonstrated that the Office erred in a manner material to the patentability of the Challenged Claims.”

Prelim. Resp. 37. For the reasons discussed below, we do not invoke our discretion to deny institution under § 325(d).

1. Legal Standards

Under § 325(d), in determining whether to institute an inter partes review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”¹³ Our § 325(d) analysis employs a two-prong framework: (1) whether the prior art and arguments presented in the petition are the same or substantially the same as those previously presented to the Office; and (2) if so, whether the petitioner has demonstrated a material error by the Office in its prior consideration of those prior art and arguments. *Advanced Bionics, LLC v. Med-El Electromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (“*Advanced Bionics*”), 8 (PTAB Feb. 13, 2020) (precedential).

We consider several non-exclusive factors as set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”), which “provide useful insight into how to apply the framework” under § 325(d). *Advanced Bionics*, 9. These non-exclusive factors include:

- (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;

¹³ The Board institutes trial on behalf of the Director. 37 C.F.R. § 42.4(a).

- (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 Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, 17–18 (formatting added). “If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Office.” *Advanced Bionics*, 10.

2. Relevant Prosecution History

In this proceeding, as discussed above, Petitioner challenges claims 1–24 of the ’808 patent with fourteen grounds, which rely on combinations of Kane, Minn, Podwika, Coates, Preston-Hall, Beckley, Murphy, Roman, and Singer. A discussion about what these prior art references describe can be found above. *See supra* § II.D.

During prosecution, the Office rejected claims 1–24 based on different combinations of Kane, Minn, Podwika, Coates, and Preston-Hall along with several other references. Ex. 1013, 69–73. Relevant to our analysis here, the Office rejected independent claim 19 as obvious over Kane and Chapin¹⁴. Ex. 1013, 73. The Examiner reasoned

Kane teaches a wallet with elastic band interposed between the two plates, finger notches, and a clip (traditional) which goes

¹⁴ US 5,038,985, issued August 13, 1991 (Ex. 2013, “Chapin”).

over the edges of the outside wall. It would have been obvious to one of ordinary skill in the art to provide a clip with the two tangs (protrusions), as taught by Chapin, note portion 109, fig. 11, to provide an alternative clip structure.

Id.

In response to the Examiner's rejection, Applicant amended claim 19 as follows:

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.

Id. at 84–85 (newly added claim language underlined).¹⁵ In addition, Applicant argued that

The Examiner relies on Chapin for a teaching of tangs on a clip structure. In Kane and in Chapin, a clip is mounted on an exterior surface. There is no teaching or fair suggestion to have a tang of an auxiliary feature that is disposed inside a recess formed in the plate, where the recess has an undercut receiving a hook of the tang to keep the auxiliary feature in place.

Id. at 106. In addition, Applicant argued that “there is no such structure described by the references, nor is there any reason to modify a compact wallet to include such a feature, absent hindsight reconstruction of Applicant's claim.” *Id.* The Applicant made similar arguments with respect to independent claims 1 and 14. *Id.* at 97–105.

¹⁵ Applicant amended claims 1 and 14 to add what Petitioner refers to as limitation 1d. *See* § II.E.1.e.; *see also* Ex. 1013, 81, 83 (claim amendments).

In response, the Examiner entered the amendments to independent claims 1, 14 and 19 that led to allowance, and the Examiner cited these amendments in the reasons for allowance. *See* Ex. 1013, 124 (“Note the disclosure NPL (09/19/2018). This disclosure does not have the limitation of the recess having an undercut operable to engage a hook of the tang.”).¹⁶

3. *Whether the Prior Art and Arguments are the Same or Substantially the Same*

Under the first part of the *Advanced Bionics* framework, we consider “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” *Advanced Bionics*, Paper 6 at 8. Patent Owner argues that Petitioner relies on art that is the same as, or cumulative of, art previously presented to the Office. Prelim. Resp. 36–38; Sur-reply 1–5. For purposes of this Decision, we need not decide whether the same or substantially the same art previously was presented to the Office. As discussed below, even if we assume that the first part of the *Advanced Bionics* framework is satisfied, Petitioner demonstrates that the Office erred in a manner material to the patentability of the challenged claims in the second part of the framework.

4. *Whether Petitioner has Demonstrated Material Error*

Under the second part of the *Advanced Bionics* framework, we consider “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced*

¹⁶ We understand the Examiner’s reference to the disclosure of “NPL (09/19/2018)” to refer to the Kane reference as it is the only Non-Patent Literature (NPL) reference relied upon in the Office Action, mailed on 9/19/2018.

Bionics, Paper 6 at 8. Petitioner asserts that “the newly introduced references Beckley, Murphy, and Roman each specifically [and] exactly disclose the limitations concerning the newly added auxiliary feature (tang, recess, hook, undercut, etc), thus addressing the [E]xaminer’s oversight to a certain extent.” Pet. Reply 2. Patent Owner argues that “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).” Prelim. Resp. 41; Sur-reply 5.

On this record, we agree with Petitioner. During examination of the ’808 patent, the Examiner allowed claims 1–24, based on the newly added claim language discussed above, because none of the prior art of record disclosed “the limitation of the recess having an undercut operable to engage a hook of the tang.” Ex. 1013, 124. Even if we assume that Beckley, Murphy, and Roman are cumulative to Chapin, and the Examiner considered references cumulative to Chapin, on this record, Petitioner demonstrates that the Examiner overlooked teachings that are relevant to the limitations that were the basis for allowing the challenged claims. Therefore, on this preliminary record, we agree that there is sufficient evidence of material error to avoid discretionary denial in this case. Specifically, as discussed above, we find that Petitioner has set forth a reasonable likelihood that the challenged claims are unpatentable over Kane and Roman, which also leads us to conclude that the Office’s prior failure to apply these references against the pending claims was an error that was material to the patentability of these claims. That is, on the current record Petitioner’s evidence indicates that, at least, the combination of Kane and Roman discloses or suggests a

“recess having an undercut operable to engage a hook of the tang.” Pet. 57–58; Ex. 1012, 1:54–64, 4:14–17, Figs. 8–9; Ex. 1015, 6. And, at this stage of the proceeding, Patent Owner does not dispute that the combination of Kane and Roman teaches the limitation that was the basis for allowing the claims. Instead, Patent Owner argues that it would not have been obvious to combine the references. *See, e.g.*, Prelim. Resp. 23 (“The Petition Does Not Establish Combinability of Kane and Roman.”).

As a result, on this record, Petitioner demonstrates that the Office erred in a manner material to the patentability of challenged claims.

5. Conclusion

For the foregoing reasons, we decline to exercise discretion to deny institution under § 325(d).

IV. CONCLUSION

We determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in challenging at least one claim of the ’808 patent, and we decline to deny institution under 35 U.S.C. § 325(d). Based on the foregoing, we institute *inter partes* review of all challenged claims on all grounds raised in the Petition. *See* 37 C.F.R. § 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). At this stage of the proceeding, we have not made a final determination with respect to the patentability of any of the challenged claims or the construction of any claim term.

V. ORDER

In consideration of the foregoing, it is hereby:

IPR2024-00340
Patent 10,791,808 B2

ORDERED that *inter partes* review of claims 1–24 of the '808 patent is instituted on the grounds asserted in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

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