

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

2985 LLC, D/B/A MOUNTAIN VOYAGE COMPANCY, LLC

Petitioner,

v.

THE RIDGE WALLET LLC,

Patent Owner

U.S. Patent No. 10,791,808

Issued: October 6, 2020

Title: COMPACT WALLET

Inter Partes Review No. IPR2024-00692

**PETITION FOR INTER PARTES REVIEW
OF U.S. PATENT NO. 10,791,808**

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1003	Curriculum Vitae of James B. Babcock
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1005	Certified Copy of the File History of U.S. Patent Application No. 14/706,019.
1006	<i>The Ridge 2.0</i> , Kickstarter Campaign by Daniel Kane. Archived on September 3, 2013, by the Wayback Machine: https://web.archive.org/web/20130903204002/http://www.kickstarter.com:80/projects/124039987/the-ridgewallet-20
1007	U.S. Patent Publication No. 2014/0060712 to Beckley
1008	U.S. Patent No. 2,326,558 to Pelz
1009	U.S. Patent Publication No. 2009/0134223 to Matthews
1010	<i>Mechanisms and Mechanical Devices Sourcebook</i> . Nicholas P. Chironis. 1991. McGraw-Hill. Page 412.
1011	<i>More Americans are Joining the 'Cashless' Economy</i> . Michelle Faverio. 2022. Pew Research Center.
1012	International Application PCT/US16/031472
1013	Claim Construction Order in <i>Mosaic Brands, Inc. v. The Ridge Wallet LLC</i> , (2:20-cv-04556), District Court, Central District of California
1014	Claim Construction Order in <i>Certain Compact Wallets and Components Thereof</i> , Order No. 14 from ITC Inv. No. 337-1355.
1015	Defendant's Opening Claim Construction Brief, <i>The Ridge Wallet LLC v. 2985, LLC D/B/A Mountain Voyage Co.</i> , (1:23-CV-00407), District of Colorado.
1016	<i>McGraw-Hill Dictionary of Scientific and Technical Terms</i> . 2003. 6th ed. New York: McGraw-Hill. Page 1759.
1017	<i>The Merriam-Webster Dictionary</i> . 2016. Merriam-Webster, Incorporated. Pages 344 and 2221.
1018	Docket, <i>The Ridge Wallet, LLC. v. 2985 LLC.</i> , No. 1:23-cv-00407-CNS-SBP (D.C.COLO)

1019	Case Management and Scheduling Order, <i>The Ridge Wallet, LLC. v. 2985 LLC.</i> , No. 1:23-cv-00407-CNS-SBP (D.C.COLO), ECF No. 32, April 6, 2023
1020	District Court of Colorado, Judicial Caseload Profile, March 12, 2024
1021	Declaration of Daniel Kane
1022	Declaration of Jacob Busch

LISTING OF CHALLENGED CLAIMS

CLAIM 1	
1[a]	A compact wallet, comprising:
1[b]	at least two rigid plates interposed to sandwich card-like contents there between, each rigid plate having a longitudinal extent
1[c]	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
1[d]	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
1[e]	an auxiliary feature removably attached to at least one of the at least two rigid plates,
1[f]	the auxiliary feature having a tang insertable into a recess formed inside the at least two rigid plates,
1[g]	the tang having a hook,
1[h]	the hook extending at an angle to the tang,
1[i]	the hook engaging an undercut of the recess to prevent inadvertent dislodgement of the auxiliary feature from the recess,
1[j]	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.
CLAIM 2	
2[a]	The compact wallet of claim 1, wherein the channeling means is a longitudinal groove in a first lamina of a laminate construction of each rigid plate,
2[b]	the groove slidably receiving one part of the at least one encircling elastic band.
CLAIM 3	
3[a]	The compact wallet of claim 2, wherein a second lamina of the laminate constructions of each rigid plate is removably attached to the first lamina to hold the at least one elastic band in capture and provide a smooth surface for glide purposes.

CLAIM 4	
4[a]	The compact wallet of claim 3, wherein the second lamina is attached to the first lamina by screws.
CLAIM 5	
5[a]	The compact wallet of claim 3, wherein the second lamina is attached to the first lamina by pressure sensitive adhesive means.
CLAIM 6	
6[a]	The compact wallet of claim 1, wherein each rigid plate is comprised of metal for RFID protection.
CLAIM 7	
7[a]	The compact wallet of claim 1, wherein each rigid plate is metalized for RFID protection.
CLAIM 8	
8[a]	The compact wallet of claim 3, wherein at least one of the first or second lamina of each rigid plate is comprised of metal.
CLAIM 9	
9[a]	The compact wallet of claim 1, further comprising a first elastic strap positioned over the ends of the at least two rigid plates transverse to the longitudinal extents,
9[b]	the positioning functioning to retain the card-like contents from that end.
CLAIM 11	
11[a]	The compact wallet of claim 1, wherein the card-like contents comprise one or more of a credit card, a driver's license, an ID card, a business card, an affiliation card, a currency bill, a loyalty card, a coupon, a receipt or a personal paper.
CLAIM 12	
12[a]	The compact wallet of claim 1, further comprising aligned finger notches through proximal ends of the rigid plates to expose an edge of the card-like contents for the purpose of pushing the edge to elevate the contents into view through distal ends of the rigid plates,
12[b]	said edge providing a fulcrum to lever the proximal ends together for the purpose of fanning the distal ends apart in display of the contents.
CLAIM 13	
13[a]	The compact wallet of claim 1, wherein the encircling elastic band is comprised of woven elastic fabric.

CLAIM 14	
14[a]	A compact wallet, comprising:
14[b]	at least two rigid plates interposed to sandwich card-like contents there between, each rigid plate having a groove along a longitudinal extent thereof;
14[c]	at least one encircling elastic band slidably interposed in the grooves to bias the at least two rigid plates inwardly and securely hold the card-like contents while providing elastic volume there between for adding or removing contents,
14[d]	the grooves configured to 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
14[e]	a recess formed inside at least one of the at least two rigid plates,
14[f]	the recess operable to receive a tang of an auxiliary feature,
14[g]	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,
14[h]	the hook extending at an angle to the tang,
14[i]	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.
CLAIM 15	
15[a]	The compact wallet of claim 14, wherein the groove is in a first lamina of a laminate construction of each rigid plate,
15[b]	the groove slidably receiving one part of the at least one encircling elastic band.
CLAIM 16	
16[a]	The compact wallet of claim 15, wherein a second lamina of the laminate construction of each rigid plate is removably attached to the first lamina to capture the at least one elastic band and provide a smooth surface for glide.
CLAIM 17	
17[a]	The compact wallet of claim 16, wherein the second lamina is attached to the first lamina by screws.

CLAIM 18	
18[a]	The compact wallet of claim 1, wherein each rigid plate is comprised of metal for RFID protection.
CLAIM 19	
19[a]	A method of making a modular compact wallet, comprising the steps:
19[b]	providing at least two rigid plates interposed to sandwich card-like contents there between, each rigid plate having a groove along a longitudinal extent thereof;
19[c]	at least one encircling elastic band slidably interposed in the grooves to bias the at least two rigid plates inwardly and securely hold the card-like contents while providing elastic volume there between for adding or removing contents,
19[d]	the grooves configured to 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,
19[e]	at least one groove additionally having at least one recess positioned outbound of the elastic band;
19[f]	providing a first auxiliary feature having at least one tang;
19[g]	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;
19[h]	removing, selectively, the first auxiliary feature;
19[i]	providing, selectively, at least a second auxiliary feature having at least one tang; and
19[j]	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,
19[k]	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,
19[l]	the hook extending at an angle to the tang,
19[m]	the at least one recess receiving the tang being disposed inside at least one of the two rigid plates;

19[n]	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 positioned interiorly to the at least two rigid plates and providing additional functionality from at least one auxiliary feature positioned exteriorly thereto.
CLAIM 20	
20[a]	The method of claim 19, wherein the at least one recess has an undercut and the at least one tang has a hook,
20[b]	the hook and undercut interpositioned to secure the at least one auxiliary feature against inadvertent dislodgement.
CLAIM 21	
21[a]	The method of claim 20, wherein at least one of the auxiliary features is a money clip.

I. INTRODUCTION

2985 LLC d/b/a Mountain Voyage Co. (“Mountain Voyage” or “Petitioner”) requests *inter partes* review (“IPR”) of Claims 1-9 and 11-21 of U.S. Patent No. 10,791,808 (the “’808 Patent”) (Ex. 1001), currently assigned to The Ridge Wallet LLC (“PO”). The challenged claims should be found unpatentable and canceled.

II. MANDATORY NOTICES

A. Real Party-in-Interest

Mountain Voyage is the real party-in-interest.

B. Related Matters

The ’808 Patent has been asserted by PO against Petitioner in *The Ridge Wallet LLC v. 2985 LLC, d/b/a Mountain Voyage Co*, Case No. 1:23-cv-00407 (D. Colo. February 10, 2023) (“Parallel Litigation”) (Ex. 1018).

The ’808 Patent has been asserted by PO in:

- *The Ridge Wallet LLC v. Suzhou Niu Mo Wang Electronic Technology Co., Ltd. d/b/a Nimalist and Normest*, Case No. 24-cv-00241 (N.D.Ill. January 10, 2024).
- *The Ridge Wallet, LLC v. Shenzhen Pincan Technology Co. Ltd. d/b/a ARW-Wallet*, Case No. 23-cv-00392 (E.D. Tex. August 29, 2023).

- *The Ridge Wallet LLC v. Bemmo Inc.*, Case No. 23-cv-02091 (E.D.N.Y. March 17, 2023).
- *The Ridge Wallet LLC v. Shenzhen X-World Technology Co. Ltd.*, Case No. 2:24-cv-111 (E.D. Tex. February 19, 2024).
- *Certain Compact Wallets and Components Thereof*; Inv. No. 337-TA-1355 (ITC February 6, 2023).

One Petition for an IPR, IPR2024-00340, was filed January 2, 2024 referred to herein as the *Shenzen* IPR.

The following pending U.S. patent applications that claim priority, directly or indirectly, to the '808 Patent, may affect, or be affected by, a decision in this proceeding:

U.S. Application No. 29/813,614, filed October 29, 2021

U.S. Application No. 18/076,188, filed December 6, 2022

U.S. Application No. 29/894,998, filed June 15, 2023

U.S. Application No. 29/896,573, filed July 5, 2023

U.S. Application No. 29/896,575, filed July 5, 2023

U.S. Application No. 29/898,353, filed July 26, 2023

U.S. Application No. 29/898,354, filed July 26, 2023

U.S. Application No. 29/822,078, filed January 5, 2023

U.S. Application No. 29/882,878, filed January 19, 2023

U.S. Application No. 29/898,352, filed July 26, 2023

U.S. Application No. 29/898,361, filed July 26, 2023

U.S. Application No. 18/117,238, filed March 3, 2023

U.S. Application No. 29/919,216, filed December 1, 2023

U.S. Application No. 29/813,617, filed October 29, 2021

U.S. Application No. 29/813,628, filed October 29, 2021

U.S. Application No. 29/896,574, filed July 5, 2023

U.S. Application No. 29/919,214, filed December 1, 2023

U.S. Application No. 18/126,279, filed March 24, 2023

U.S. Application No. 18/241,741, filed September 1, 2023

U.S. Application No. 18/107,955, filed February 9, 2023

U.S. Application No. 29/898,360, filed July 26, 2024

U.S. Application No. 29/925,946, filed January 26, 2024

U.S. Application No. 18/126,336, filed March 24, 2023

U.S. Application No. 29/989,357, filed July 26, 2023

U.S. Application No. 29/919,218, filed December 1, 2023

C. Lead and Back-up Counsel

Petitioner provides the following designation of counsel:

Lead Counsel	Back-up Counsel
Jacob M. Busch Mountain Voyage Co.	Igor D. Ozeruga Vorys, Sater, Seymour and Pease LLP

3513 Patterson Cir. Richfield, OH 44286 Reg. No. 70,830 jake@mountainvoyageco.com Tel.: (330) 241-1800	50 S. Main St. Suite 1200 Akron, OH 44308 Reg. No. 72,399 idozeruga@vorys.com Tel.: (330) 208-1012
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D. Service Information

Petitioner consents to electronic service by email: 2985-RidgeWallet-IPR@vorys.com. Please address postal and hand carry correspondence to lead counsel at the above address.

III. PAYMENT OF FEES

The PTO is authorized to charge all fees due during this proceeding to Deposit Account No. 22-0585.

IV. THE '808 PATENT

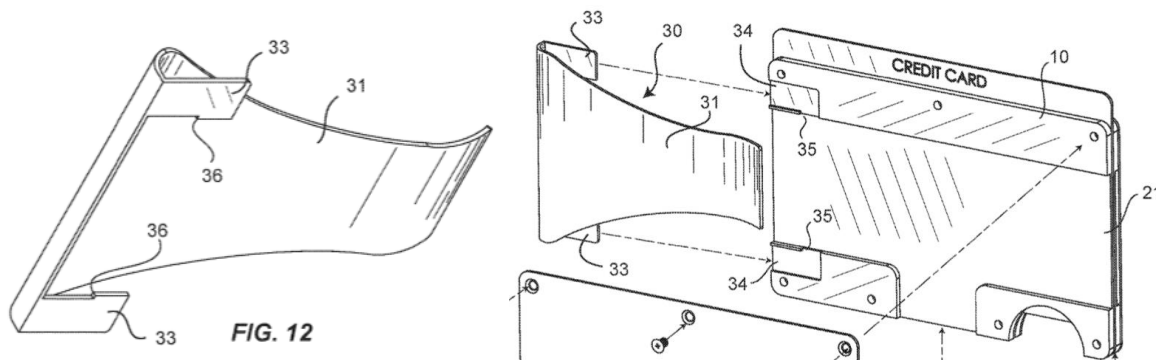
A. Scope and Content

The '808 Patent discloses compact card holders with a minimal silhouette and an auxiliary feature. (Ex. 1001, Abstract.) The “compact wallet **1** is comprised of at least two rigid plates **10**, serving as ‘book-ends’ as it were, with one or more card-like contents **2** sandwiched between them.” (*Id.* at 3:58-61.) An encircling elastic band **4** is held in place by a channeling means **20** (a longitudinal groove **21**) inside each of the rigid plates **10**. (*Id.* 4:14-15.) “The encircling elastic band **4** holds the

card-like contents **2** securely be means of compression,” by biasing the rigid plates **10** toward each other “while also expanding elastically to open space between the rigid plates **10**.” (*Id.* 3:62-65.)

Additionally, the compact wallet **1** may comprise an auxiliary feature **30** that “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**... In a particularity, the recess **34** has an undercut **35** and a 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 the compact wallet **1**.” (*Id.* 5:13, 5:23-31.)

For example:



(*Id.* FIGS. 12-13.)

B. Prosecution History

During prosecution, in response to the only Office Action issued, the Examiner allowed the claims over Kane (Kickstarter, the Ridge Wallet 2.0) indicating that referenced prior art allegedly lacks the amended feature “the

limitation of the recess having an undercut operable to engage a hook of the tang.”
(Ex. 1004.)

C. Critical Date Determination

Independent Claims 1, 14, and 19 recite a “recess,” “tang,” “hook,” and “undercut;” which were first introduced in the filing of U.S. Patent Application 15/421,596 on February 1, 2017 and added to the Challenged Claims by amendment. (Ex. 1004; Ex. 1005; Babcock¹ ¶ 57.) Thus, none of the Challenged Claims are supported by the Earlier-Filed Applications. (Babcock ¶¶ 56, 58-61.)

Therefore, the time before February 1, 2017, is the relevant time period for evaluating prior art. However, all prior art relied upon herein predates even the earliest alleged priority date of the ’808 Patent by more than a year.

V. SCOPE AND CONTENT OF THE PRIOR ART

A. The Ridge Wallet 2.0 by Daniel Kane (“Kane”)

Kane is titled “The Ridge Wallet 2.0”, published on kickstarter.com and constitutes prior art against the ’808 Patent under 35 U.S.C. § 102(a)(1) (post-AIA). A capture of Kane was archived by The Wayback Machine on September 3, 2013, and retrieved from the following URL on January 23, 2024:

¹ Declaration of Mr. Babcock (Ex. 1002), an expert in the field of the ’808 Patent. (Babcock ¶ 5.)

[https://web.archive.org/web/20130903204002/http://www.kickstarter.co](https://web.archive.org/web/20130903204002/http://www.kickstarter.com:80/projects/124039987/the-ridgewallet-20)
[m:80/projects/124039987/the-ridgewallet-20](https://web.archive.org/web/20130903204002/http://www.kickstarter.com:80/projects/124039987/the-ridgewallet-20)

(See Ex. 1021; Ex. 1022.) Kane is also available at:

<https://www.kickstarter.com/projects/124039987/the-ridge-wallet-20#>
(last updated January 27, 2014).

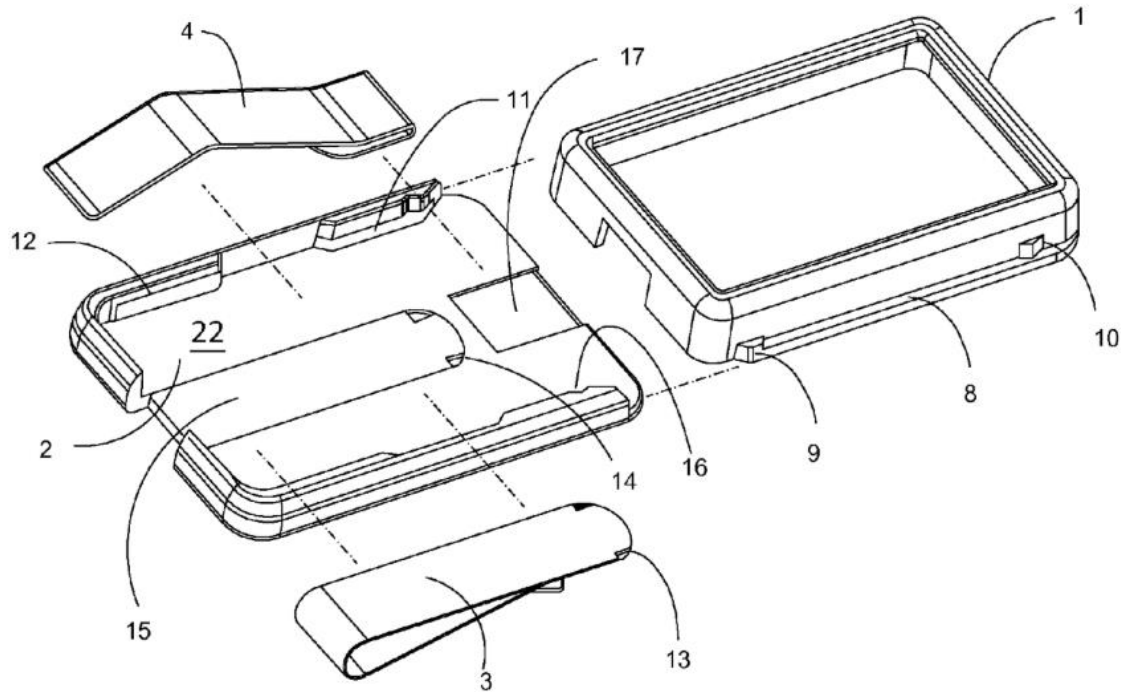
Daniel Kane, inventor of the '808 Patent and author of Ex. 1006, declared “[t]he Ridge Wallet conception began in late 2012, and culminated in two very public Kickstarter campaigns in 2013.” (Ex. 2021.) Ex. 1006 depicts a garnering of 730 backers as of September 3, 2013. (Ex. 1006 2.) Kane states the Kickstarter campaign continued until October 18, 2013, and “garnered 1,523 backers, pledging a total of \$126,873” in culmination. (Ex. 1021.)

Kane discloses a compact wallet that secures card-like contents between rigid plates that are bound by an encircling elastic band to provide elastic volume therebetween. (Ex. 1006 4-7, 9-15: photographs thereof.) Kane discloses the wallet “available with two different types of money clips or without a clip.” (Ex. 1006.)

B. U.S. Patent Application Pub. No. 2014/0060712 to Beckley (“Beckley”)

Beckley discloses a clip **3** (e.g., a money clip) that is removably attached to an outside face of the wallet **5**, as shown in FIG. 1 below. (Ex. 1007 ¶¶ [0004], [0034], [0038]-[0039], FIGS. 1-2B, 4A-5B, 6A-6B.) Beckley discloses a removable attachment of the clip **3** via an engagement between barbs **13** positioned on the clip’s

3 tang and cavities **14** positioned in a depression **15** formed in a base portion **2**. (Ex. 1007 ¶¶ [0038]-[0039], FIG. 1.)



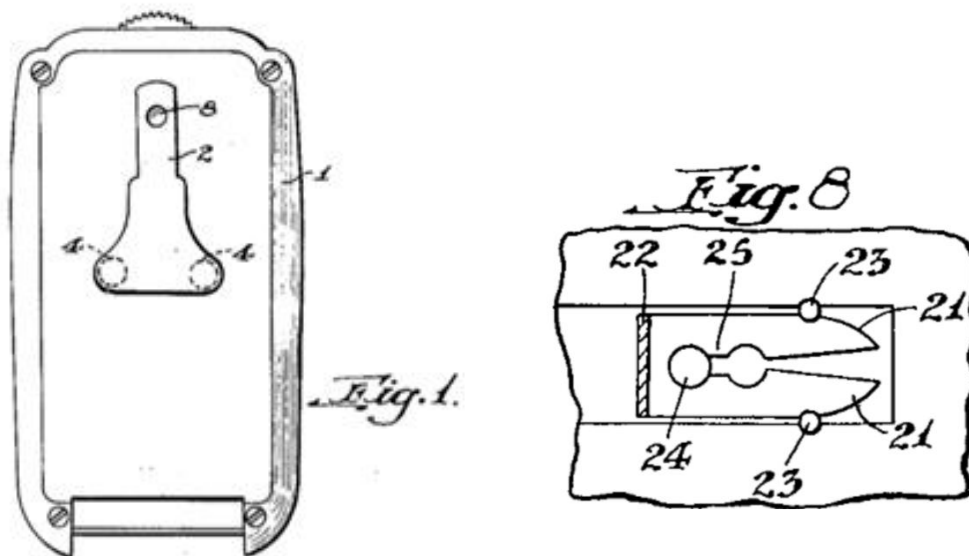
(Ex. 1007 FIG. 1.)

C. U.S. Patent No. 2,326,558 to Pelz (“Pelz”)

Pelz is titled “Spring Clip”, was filed March 9, 1943, and constitutes prior art against the ’808 Patent under 35 U.S.C. § 102(a)(1) (post-AIA).

Pelz discloses a removable clip for wearable devices. (Ex. 1008 1:20-27, FIGS. 1-2, 8.) Pelz discloses a leaf spring clip **2** held against a case by a stud **12/24** overlying a bifurcated case-engaging arm **10**. (Ex. 1008 1:35-37, 3:13-16, 3:60-66, FIG. 8.) While the clip **2** is positioned within a depression **19** in the case, laterally resilient fingers **21** of the case-engaging arm **10** are provided with side recesses that

engage integrally molded pins **23** to prevent inadvertent vertical movement of the clip **2**. (*Id.* 1:58-54, 3:15-4:15, FIG. 8.)

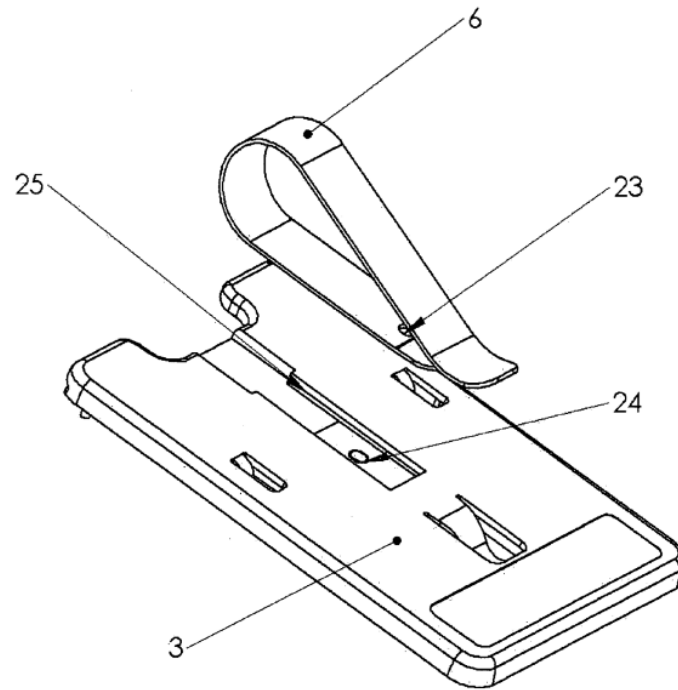


(*Id.* FIGS. 1, 8.)

D. U.S. Patent Application Pub. No. 2009/0134223 to Matthews (“Matthews”)

Matthews discloses a card holder comprising a front piece **2** and a back piece **3** that are joined together to hold wallet-sized cards (*e.g.*, credit cards) therebetween. (Ex. 1009 ¶ [0029], FIGS. 1-5.) A clip **6** is removably attached by inserting a tang of the clip **6** into a recess formed in the back piece **3**; whereupon “a hole on the clip **23** is pushed up over a protrusion **24** in the back piece for retention,” as shown in FIG. 4 below. (*Id.* ¶¶ [0029], [0033], [0041]: “the clip is removable, as it is retained by a small post on the back case part and a corresponding hole in the clip. This

combination provides sufficient retention force to retain the clip against common loads during normal use... but also for user assisted removal if desired.”)



(Ex. 1009 FIG. 4.)

VI. LEVEL OF SKILL IN THE ART

A person having ordinary skill in the art (“POSITA”) would have at least a bachelor’s degree in engineering (*e.g.*, mechanical engineering) or a related field. A POSITA at the time of the ’808 Patent would have work experience in analyzing, designing, or creating mechanical devices. Further education, or work experience, in the relevant field may compensate for a deficit in the qualifications outlined above. (Ex. 1014; Babcock ¶¶ 29-32.)

VII. REQUIREMENTS FOR *INTER PARTES* REVIEW

A. Grounds for Standing

Petitioner certifies that the '808 Patent is available for IPR, and Petitioner is not barred or estopped from requesting IPR on the grounds herein.

Claims 1-9 and 11-21 have not been the subject of a prior IPR review or district court litigation concluded on the merits.

B. Claims Challenged

Petitioner requests review and cancellation of Claims 1-9 and 11-21 ("Challenged Claims") of the '808 Patent.

C. Grounds

The Challenged Claims should be canceled as unpatentable based on the following obviousness (post-AIA) grounds:

Ground 1: Claims 1-9 and 11-21 are rendered obvious under 35 U.S.C. § 103 by Kane in view of Beckley.

Ground 2: Claims 1-9 and 11-21 are rendered obvious under 35 U.S.C. § 103 by Kane in view of Pelz.

Ground 3: Claims 1-9 and 11-21 are rendered obvious under 35 U.S.C. § 103 by Kane in view of Matthews.

D. Relevant Time Period

Petitioner assumes a Critical Date of February 1, 2017, when the application was first filed. *See* Section IV.C.

VIII. CLAIM CONSTRUCTION

Claims in this Petition are construed by Petitioner under Rule 42.100(b) and in accordance with the *Phillips* standard. In the Challenged Claims four terms require an express construction. (Babcock ¶¶ 69-71.) The below claims constructions, in the primary or alternative construction (as applicable) are consistent with the '808 Specification and the Challenged Claims are rendered obvious by the Grounds 1-3. (Babcock ¶¶ 77, 83, 89, 95.)

Petitioner reserves the right to propose alternative constructions in the event that PO proposes constructions for any terms that vary from the plain and ordinary meaning.

A. “Channeling Means”

The term “channeling means” in the Challenged Claims invokes a means-plus-function interpretation in which: (1) the function is to minimize the profile of the wallet and hold position of the at least one encircling 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 (2) the structure is a groove spanning

the extent of one or more of the rigid plates or a longitudinal bore through each rigid plate. (Ex. 1013 17-18; Ex. 1014 8-9; Babcock ¶¶ 73-74.)

This meaning was adopted in a prior claim construction determination related to the '808 Patent, set forth in *Mosaic Brands*. (Ex. 1013 17-18.) This meaning is consistent with the '808 Patent specification. (Ex. 1001 4:2-5, 4:9-17, 6:32-34, FIGS. 2, 8, 13; Babcock ¶¶ 76.)

B. “Recess”

Consistent with Petitioner’s construction proposed in the Parallel Litigation, the term “recess,” as used in the Challenged Claims, means “a groove with a sidewall that is adjacent to the longitudinally extending groove (*i.e.*, the ‘channeling means’).” (Ex. 1015; Babcock ¶¶ 78-81.) Should the above construction be found too narrow, Petitioner offers an alternative construction, where “recess” means “a surface groove or depression.” (Babcock ¶ 82.)

C. “Hook”

The term “hook” has been subject to a prior construction determination related to the '808 Patent, in which a plain and ordinary meaning construction was adopted. (Ex. 1013; Ex. 1014; Babcock ¶ 84.) However, this prior construction determinations did not offer an express meaning for what constitutes the plain and ordinary meaning of “hook,” in the Challenged Claims. (*Id.*)

Consistent with Petitioner’s construction proposed in the Parallel Litigation, the term “hook,” in the Challenged Claims means “a device that abruptly changes direction from a trunk section to define a ledge for catching or holding.” (Ex. 1015 14-15; Babcock ¶¶ 84-87.) Should the above construction be found too narrow, Petitioner offers an alternative construction, where “hook” means “a curved or bent device for catching or holding.” (Babcock ¶ 88.)

D. “Undercut”

The term “undercut” has been subject to a prior construction determination related to the ’808 Patent, in which a plain and ordinary meaning construction was adopted. (Ex. 1013; Ex. 1014; Babcock ¶ 90.) However, this prior construction determination did not offer an express meaning for what constitutes the plain and ordinary meaning of “undercut,” In the Challenged Claims. (*Id.*)

Consistent with Petitioner’s construction proposed in the Parallel Litigation, the term “undercut,” in the Challenged Claims, means “a cut away portion of the sidewall of the recess.” (Ex. 1015; Babcock ¶¶ 91-93.) Should the above construction be found too narrow, Petitioner offers an alternative construction, where “undercut” means “an underside recess that is either cut or molded into an object to at least partially define a lip or protuberance.” Babcock ¶ 94.)

IX. DETAILED EXPLANATION OF GROUNDS

A. Ground 1: Claims 1-9 and 11-21 are rendered obvious under 35 U.S.C. §103 by Kane in view of Beckley.

The Kane-Beckley combination renders Claims 1-9 and 11-21 obvious. (Babcock ¶¶ 120-468.)

1. The Kane-Beckley Combination

a. Motivation to Combine

A POSITA would have been motivated to configure a compact wallet, like that of Kane, with a clip that is removable, like that of Beckley, to allow a consumer to remove the clip when not needed in accordance with the minimalist preferences, personalization, adapted use, and/or maintenance/repair operations promoted by Kane, as well as provide a removable clip that allows the consumer to hold currency. (Ex. 1006 3: “turn the wallet into a ‘system’ that can be completely disassembled by the user to replace the elastic and exchange outer plates for greater personalization,” 6: “The Ridge 2 is available with two different types of money clips or without a clip,” 7-10: photographs thereof 15-16: “Our biggest challenge is conveying our idea and creating a product that is versatile enough to suit a wide range of people and preferences;” Ex. 1007 ¶¶ [0038]-[0039], FIG. 1; Babcock ¶¶ 166-167, 173-174, 181-182, 187-188, 195-196, 324, 326, 341-342, 347-348, 409, 421, 426, 435, 445.)

Moreover, a POSITA would have good reason to look to Beckley for guidance on how to configure a compact wallet of Kane, with a removable clip of Beckley. (Babcock ¶¶ 160, 276, 339, 397, 434.)

Both references disclose innovations in the field of card holders with external clips. (Ex. 1006 2, 6; Ex. 1007 ¶¶ [0008], [0010], [0033]-[0034], FIGS. 1-2B; Babcock ¶¶ 161, 163.) Both references identify bulkiness as a problem of existing wallet designs. (Ex. 1006 2: “The Ridge 2.0 [is] Designed to be an encompassing alternative to a bulky traditional leather wallet;” Ex. 1007 ¶ [0004]: “wallets are, in general, made from fabric and/or leather goods and sewn to form storage pockets... Each pocket adds a layer of material, increasing the wallet’s overall thickness... The result is that the wallet becomes bulky;” Babcock ¶ 162.)

Both references disclose structural limitations that, when combined, function in the same manner as each does separately to yield predictable results. In attaching a clip, like that of Beckley, to a rigid plate, like that of Kane, the combined clip and rigid plate function in the same manner as each does separately. (Ex. 1006 5: “[t]he Integrated Elastic Track can expand up to 12 cards and then immediately contract to hold a single card securely,” photographs thereof, 8: “top of the inner plates are tapered to let you easily slide additional cards into the wallet;” Ex. 1007 ¶¶ [0010]: “an exterior clip configured to receive and hold currency,” FIG. 2B; Babcock ¶ 164.)

The technique of configuring a compact wallet with a removable clip utilizing a barb and cavity engagement was within the realm of ordinary capabilities of a POSITA based upon the teachings of at least Beckley. (Ex. 1007 ¶¶ [0038]-[0039], FIG. 1; Babcock ¶¶ 165, 197, 340, 411.)

b. Reasonable Expectation of Success

A POSITA would have reasonably expected success incorporating the teachings of Beckley into Kane as described. A POSITA would have found it obvious to form a depression and cavity, like that of Beckley, into a rigid plate of a compact wallet, like that of Kane, to effectuate a removably attached clip as there are a finite number of locations at which to attach the clip. (Babcock ¶ 398.) Forming the depression into a rigid plate, like that of Kane, would be a mere continuation of routine milling operations used for producing the plates and thereby would not require additional machinery to manufacture and minimal additional costs. (Babcock ¶¶ 165, 173, 197, 340, 326, 411, 446.)

By incorporating the teachings of Beckley into Kane, such a person would be applying a known technique to a known device ready for improvement to yield predictable results. (Babcock ¶¶ 172, 180, 186, 194, 325, 346, 412, 444.)

2. Claim 1

a. Limitation 1[a]²

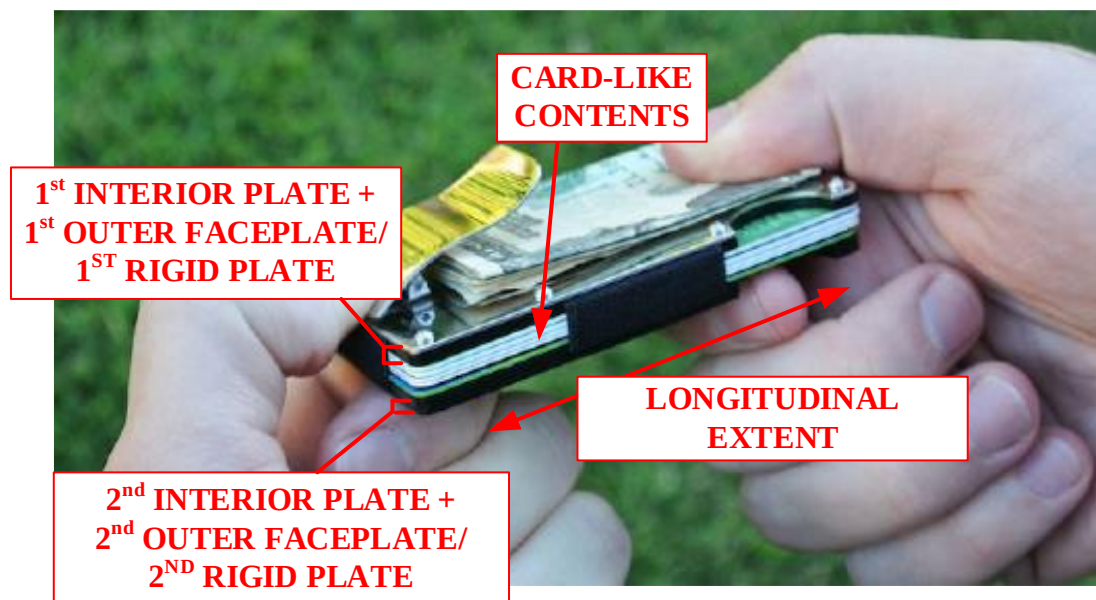
The preamble is not limiting, but if it were it is taught by both Kane and by Beckley. (Babcock ¶¶ 121-126.) Kane discloses a compact wallet with a “low profile to easily fit in your front pocket.” (Ex. 1006 2-5; Babcock ¶¶ 123-24.) Beckley

² See LISTING OF CHALLENGED CLAIMS

discloses a compact wallet that is “sized and adapted for use as a container for business cards.” (Ex. 1007 ¶ [0034], FIGS. 4A-4B; Babcock ¶ 125.)

b. Limitation 1[b]

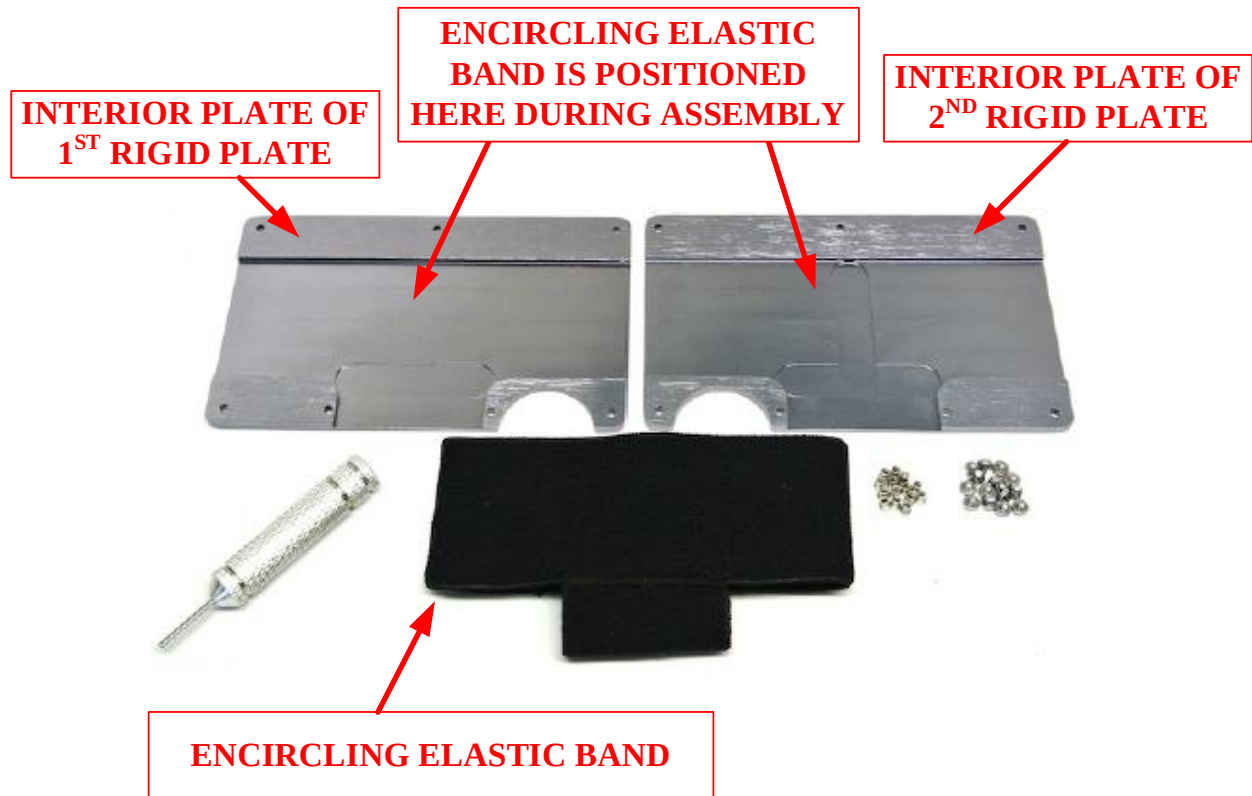
Kane discloses an interior plate secured to an outer faceplate, collectively referred to herein as a “rigid plate.” (Babcock ¶¶ 127-137.) Kane discloses a wallet with two rigid plates made of a rigid material (“anodized aircraft grade aluminum”) and interposed to sandwich card-like contents there between. (Ex. 1006 4-7; Babcock ¶¶ 128-129, 132-136.) Kane’s rigid plates are substantially rectangular in shape, with a longitudinal extent. (Ex. 1006 4-7; Babcock ¶¶ 130-131.)



(Ex. 1006 4 (*annotated*); Babcock ¶ 132.)

c. Limitation 1[c]

Kane discloses an encircling elastic band positioned within an integrated elastic track of each rigid plate, along the longitudinal extent thereof. (Ex. 1006 5-6; Babcock ¶¶ 138-140, 143-144.)



(Ex. 1006 5 (*annotated*); Babcock ¶ 139.)



(Ex. 1006 5 (*annotated*); Babcock ¶ 139.)

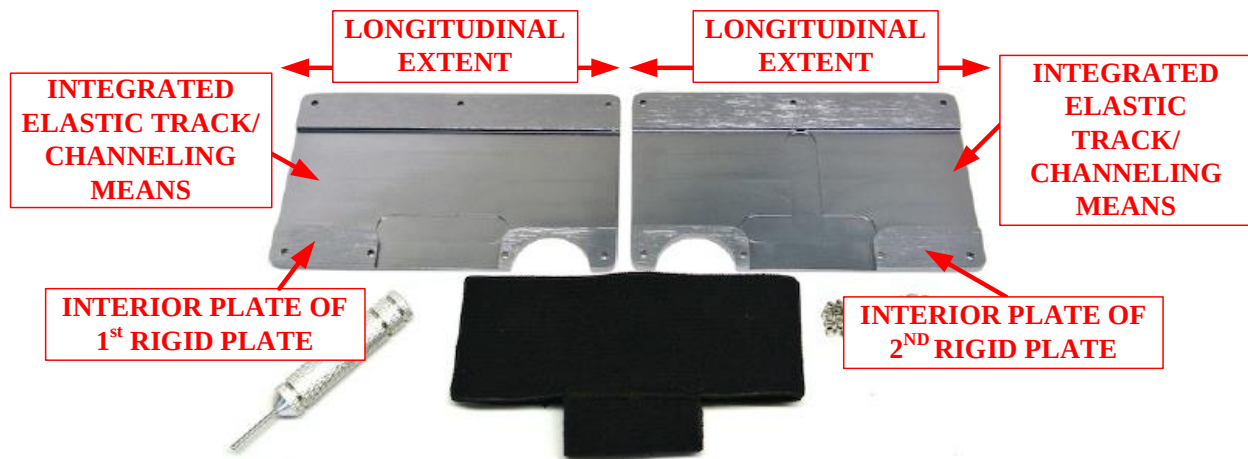
Kane discloses the encircling elastic band biasing the rigid plates towards each other (“inwardly”) to secure the card-like contents while expanding/contracting to provide elastic volume there between for adding/removing contents. (Ex. 1006 2, 5: “[t]he Integrated Elastic Track can expand to hold up to 12 cards and then immediately contract to hold a single card securely”; Babcock ¶¶ 141-142.)



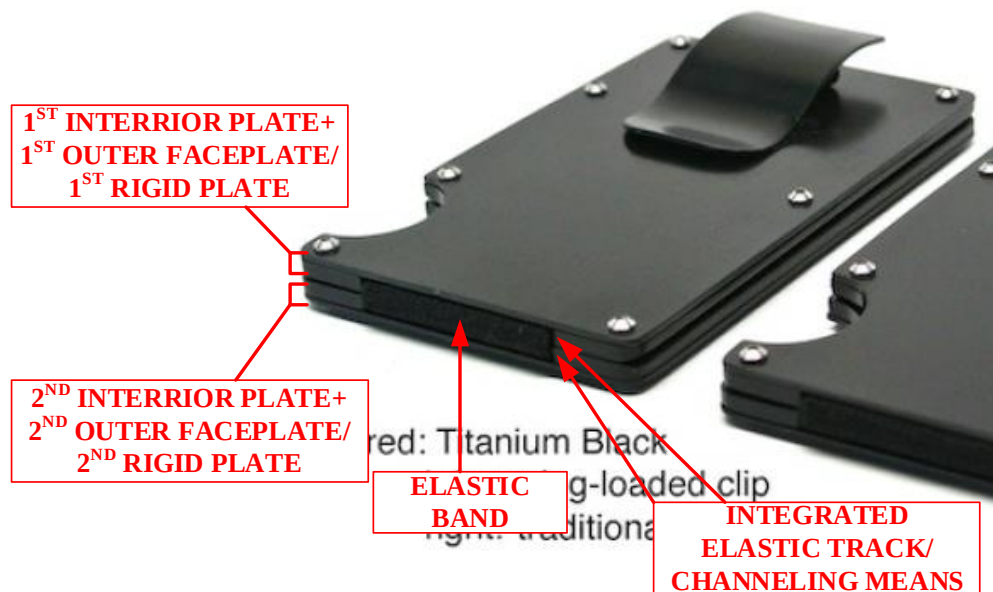
(Ex. 1006 5 (*annotated*); Babcock ¶ 142.)

d. Limitation 1[d]

Kane discloses an integrated elastic track (“channeling means”) within each rigid plate as a groove spanning the longitudinal extent of each rigid plate. (Ex. 1006 5; Babcock ¶¶ 145-153.)



(Ex. 1006 5 (*annotated*); Babcock ¶ 147.)



(Ex. 1006 7 (*annotated*); Babcock ¶ 149.)

The integrated elastic track (“channeling means”) functions to minimize the profile of the wallet and hold position of the 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. (Ex. 1006 5; Babcock ¶¶ 148-151.)



(Ex. 1006 5 (*annotated*); Babcock ¶ 151.)

Mr. Babcock opines, “a POSITA, reading Kane, would have understood the integrated elastic track to be identical, or at least equivalent to, the channeling means **20** depicted in FIG. 8 of the ’808 Patent.” (Babcock ¶ 152.)

e. Limitation 1[e]

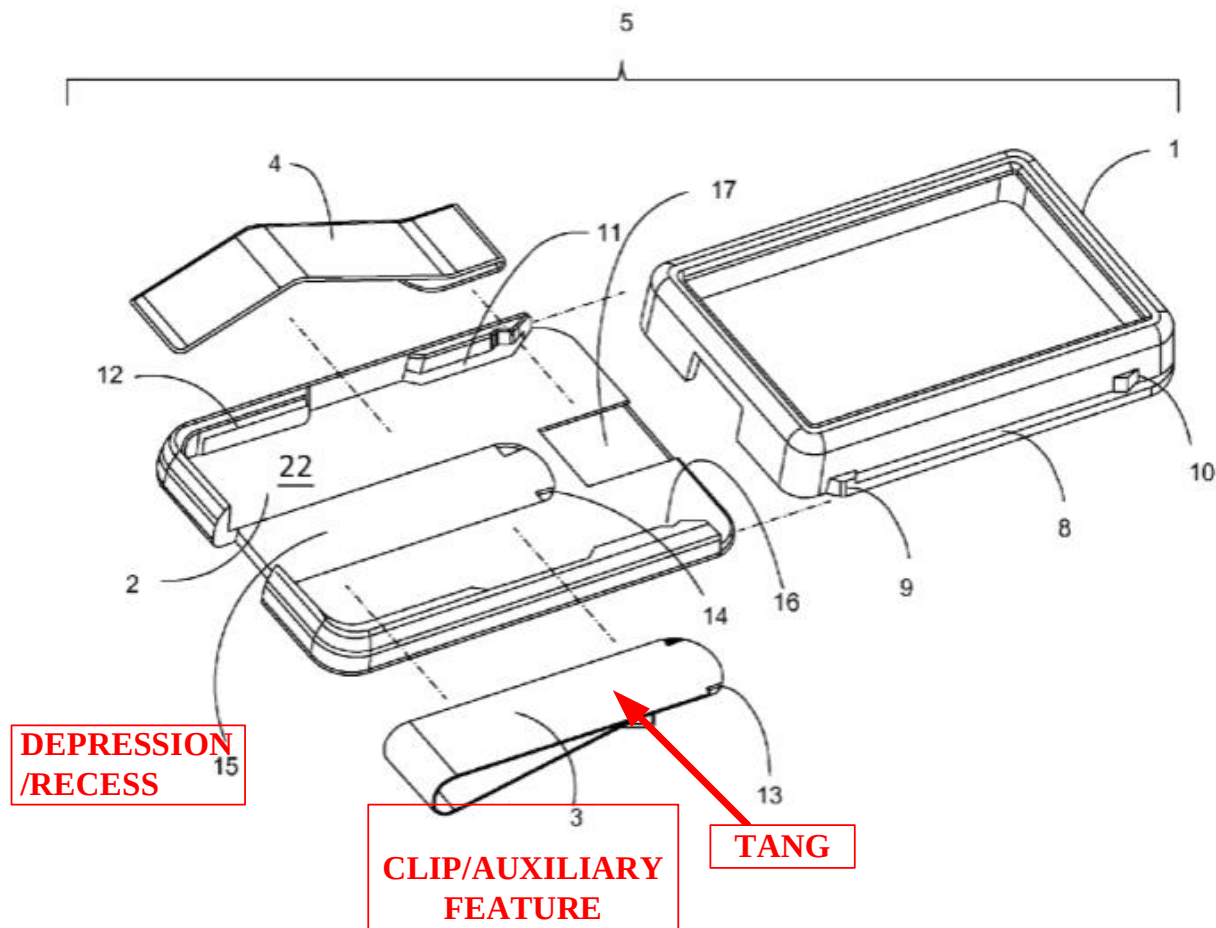
Beckley discloses a clip **3** (“auxiliary feature”) removably attached to the base portion **2** of the wallet via an engagement of barbs **13** on the clip **3** and cavities **14** in the base portion **2**. (Ex. 1007 ¶¶ [0038]-[0039], FIGS. 1, 2A-B, 4A-4B, 6A-6B; Babcock ¶¶ 154-159.)

A POSITA would have been motivated to combine Kane and Beckley with a reasonable expectation of success as set forth in Section IX.A.1, incorporated here.

f. Limitation 1[f]

Beckley discloses the clip **3** (“auxiliary feature”) having a tang insertable into a depression **15** (“recess”). (Ex. 1007 ¶¶ [0038]-[0039], FIG. 1; Babcock ¶¶ 169-175.) Beckley’s depression **15** teaches a recess, as properly construed, because it is a groove having a sidewall that is adjacent to a longitudinally extending groove (e.g., pocket **17**). (Babcock ¶ 171.) The depression **15** is a surface groove that defines an indentation occurring in a surface of the base **2**. (*Id.*)

FIG.1

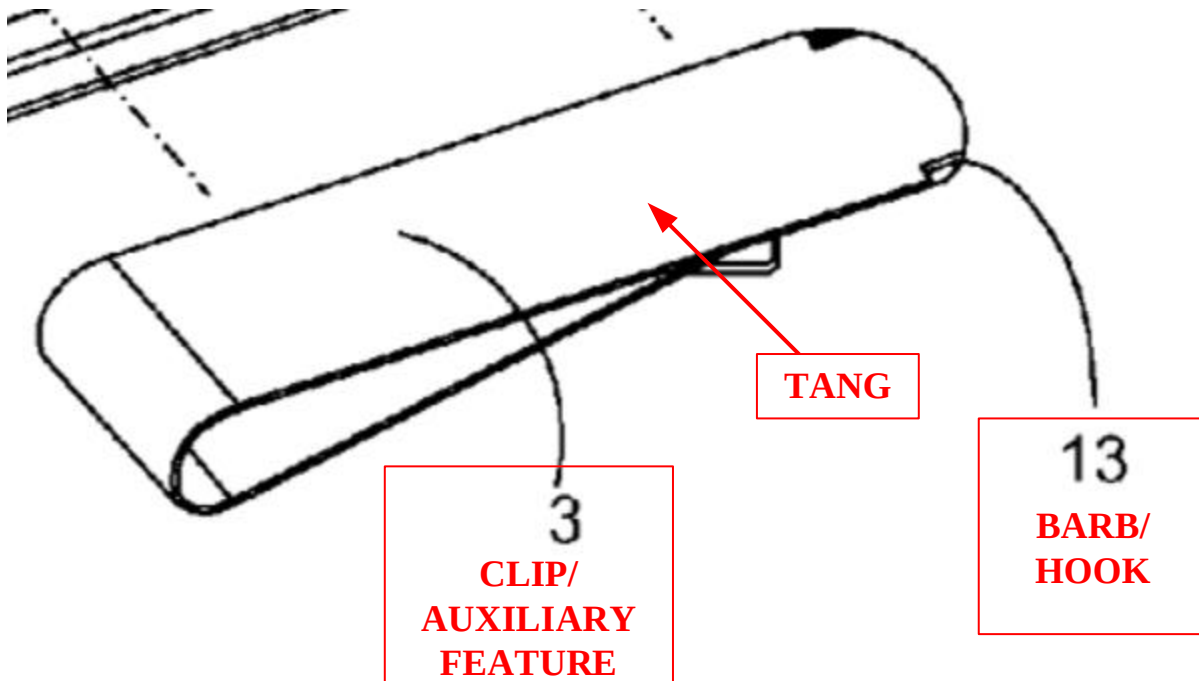


(Ex. 1007 FIG. 1 (*annotated*); Babcock ¶ 170.)

A POSITA would have been motivated to combine Kane and Beckley with a reasonable expectation of success as set forth in Section IX.A.1, incorporated here.

g. Limitation 1[g]

Beckley discloses the tang of the clip **3** having a barb **13** (“hook”). (Ex. 1007 ¶ [0038], FIG. 1; Babcock ¶¶ 176-183.) Beckley’s barb **13** teaches a hook, as properly construed, because the barb **13** abruptly changes direction from the trunk section of the clip **3** to define a ledge for catching or holding. (Ex. 1007 ¶ [0038], FIG. 1; Babcock ¶ 179.) The barb **13** is a curved or bent device for catching or holding. (*Id.*)

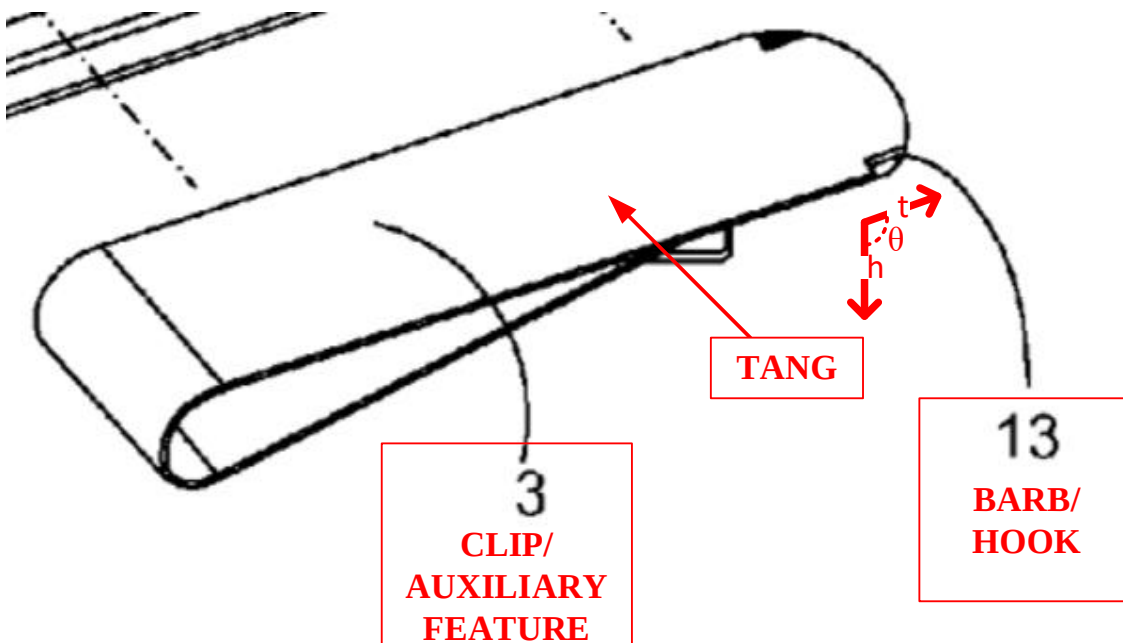


(Ex. 1007 FIG. 1 (*magnified, annotated*); Babcock ¶ 178.)

A POSITA would have been motivated to combine Kane and Beckley with a reasonable expectation of success as set forth in Section IX.A.1, incorporated here.

h. Limitation 1[h]

As shown below, Beckley depicts the tang extending in direction (t), the barb(s) **13** (“hook”) extending in direction (h), and the angle therebetween (θ). (Babcock ¶¶ 184-189.)



(Ex. 1007 FIG. 1 (*magnified, annotated*); Babcock ¶ 185.)

A POSITA would have been motivated to combine Kane and Beckley with a reasonable expectation of success as set forth in Section IX.A.1, incorporated here.

i. Limitation 1[i]

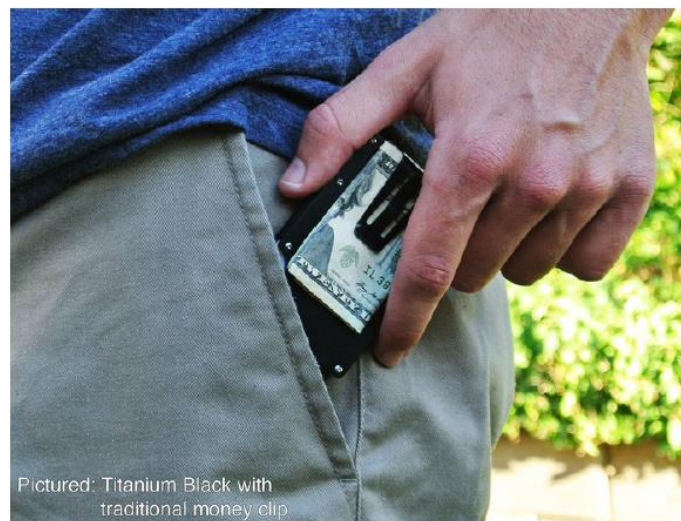
Beckley discloses cavities **14** that constitute, as properly construed, the claimed “undercut” because each cavity **14** defines a cut away portion from the bottom sidewall of the depression **15** (“recess”). (Ex. 1007 ¶¶ [0038]-[0039], FIG. 1; Babcock ¶¶ 190-193.) Each cavity **14** is an underside recess that is either cut or

molded into the depression **15** (“recess”) to define a lip or protuberance. (*Id.*) Moreover, Beckley discloses that the clip **3** “is held in place by a pair of barbs seen at **13** mated into a set of cavities **14** on the base **2**.” (*Id.*)

A POSITA would have been motivated to combine Kane and Beckley with a reasonable expectation of success as set forth in Section IX.A.1, incorporated here.

j. Limitation 1[j]

Kane discloses that card-like contents may be carried with minimal silhouette on or with a person. (Ex. 1006 2, 3: “Core design: Low profile to easily fit in your front pocket”; Babcock ¶¶ 199-202.)



(Ex. 1006 4.)

Kane discloses that “[t]he Ridge 2.0 can accommodate various numbers of cards without losing elasticity; providing an extremely thin wallet that isn’t limited

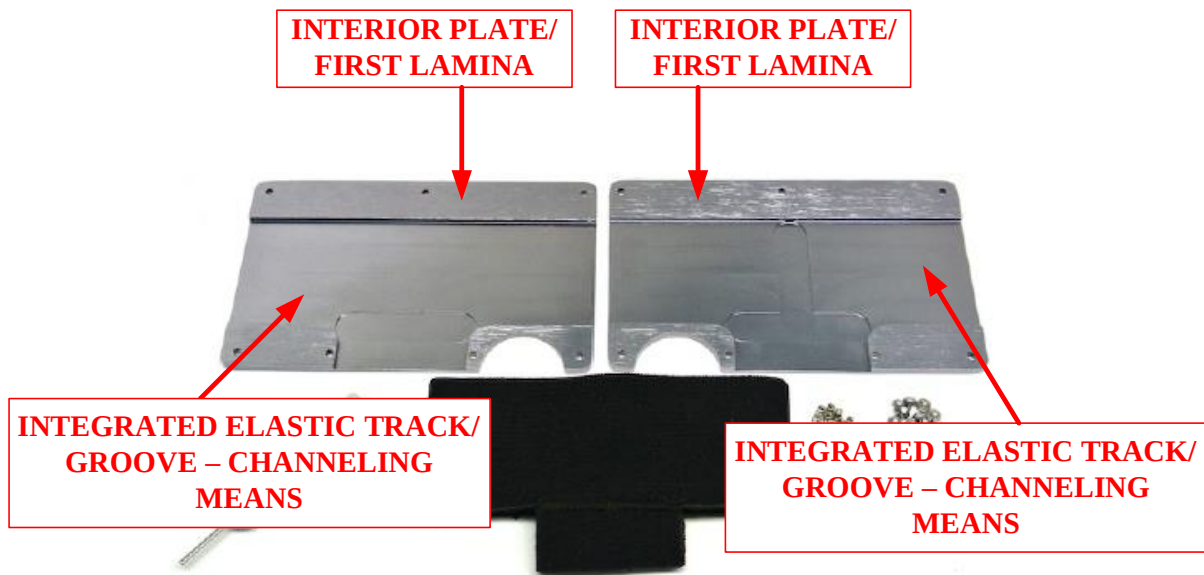
in its capacity.” (Ex. 1006 2; Babcock ¶ 200.) Kane discloses a wallet that “allow[s] easier access to the middle cards.” (Ex. 1006 3; Babcock ¶ 201.)

3. Claim 2

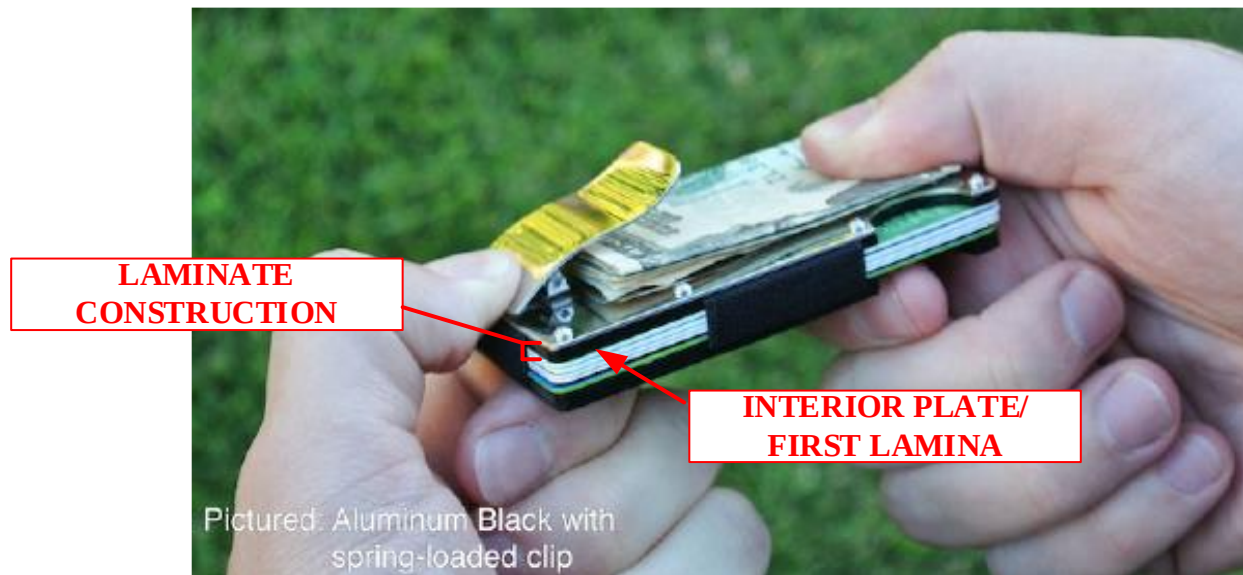
The discussion of Claim 1 is incorporated here.

a. Limitation 2[a]

Kane discloses this limitation (*e.g.*, in the same, or equivalent, manner as depicted in FIGS. 7-9 of the ’808 Patent). (Ex. 1006 4-5; Babcock ¶¶ 203-210.)



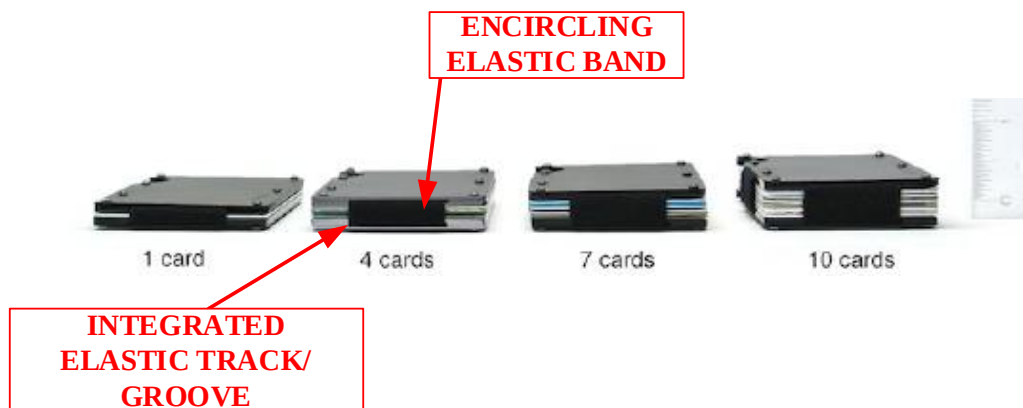
(Ex. 1006 5 (*annotated*); Babcock ¶ 207.)



(Ex. 1006 4 (*annotated*); Babcock ¶ 208.)

b. Limitation 2[b]

Kane discloses this limitation (*e.g.*, in the same, or equivalent manner, as shown in FIGS. 7-9 of the '808 Patent). (Ex. 1006 5, 7; Babcock ¶¶ 211-216.)



(Ex. 1006 5 (*annotated*); Babcock ¶ 214.)

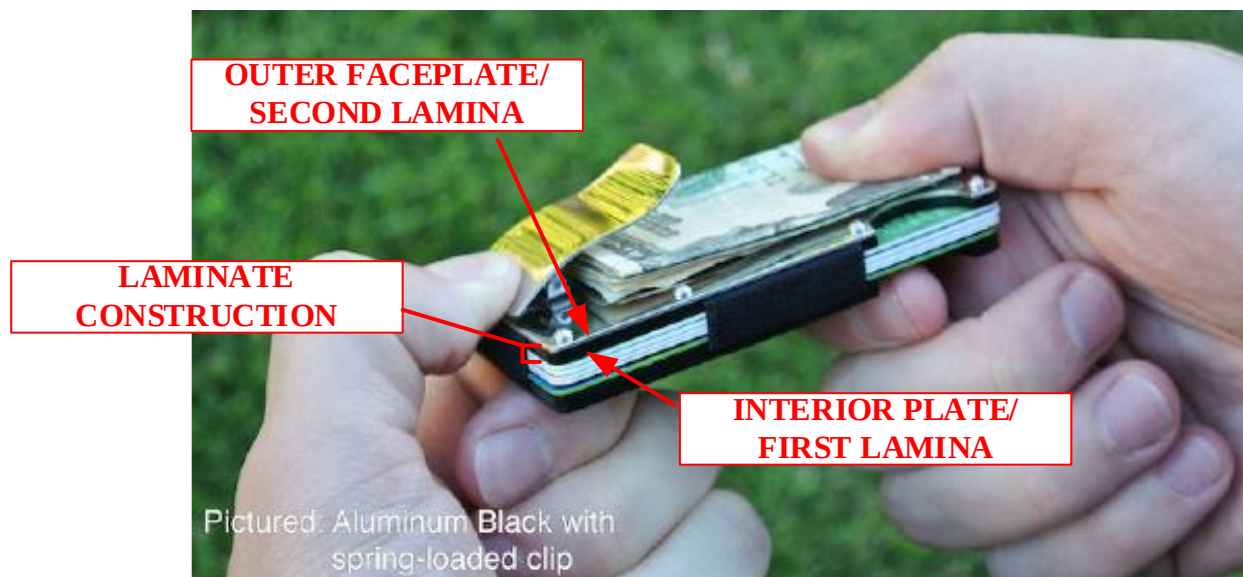
Mr. Babcock’s opines, “a POSITA would have expected the elastic band to slide against the machined aluminum material during expansion/contraction of the elastic.” (Babcock ¶ 213.)

4. Claim 3

The discussions of Claims 1-2 are incorporated here.

a. Limitation 3[a]

Kane discloses this limitation (*e.g.*, in the same, or equivalent, manner as depicted in FIG. 2 of the ’808 Patent). (Ex. 1006 3-6, 7: “Seven hex screws... secure the inner and outer plates,” 8; Babcock ¶¶ 217-225.)



(Ex. 1006 4 (*annotated*); Babcock ¶ 220.)



(Ex. 1006 7 (*annotated*); Babcock ¶ 222.)

Mr. Babcock opines, “a POSITA, reading Kane, would have reasonably expected an aluminum outer faceplate (“second lamina”) to provide a smooth surface for gliding....” (Babcock ¶ 223.)

5. Claim 4

The discussions of Claims 1-3 are incorporated here.

a. Limitation 4[a]

Kane discloses “Seven hex screws... secure the inner and outer plates.” (Ex. 1006 7; Babcock ¶¶ 226-232.)

6. Claim 5

The discussions of Claims 1-3 are incorporated here.

a. Limitation 5[a]

Mr. Babcock opines, “[u]sing pressure sensitive adhesive to attach the lamina together would amount to a simple substitution of one known element (pressure sensitive adhesive) for another (screws) to obtain a predicable result (attaching the outer faceplate to the interior plate).” (Babcock ¶ 237.)

7. Claim 6

The discussion of Claim 1 is incorporated here.

a. Limitation 6[a]

Kane discloses rigid plates made of aluminum and/or titanium. (Ex. 1006 5-6; Babcock ¶¶ 241-243.)

Aluminum options:



Titanium options:



(Ex. 1006 7.)

Kane discloses that “the Ridge’s aluminum interior plates block RFID, keeping your information safe.” (Ex. 1006 8; Babcock ¶ 243.)

8. Claim 7

The discussion of Claim 1 is incorporated here.

a. Limitation 7[a]

Kane discloses this limitation as set forth in Section IX.A.7.a, incorporated here. (Babcock ¶¶ 245-251.)

9. Claim 8

The discussions of Claims 1-3 are incorporated here.

a. Limitation 8[a]

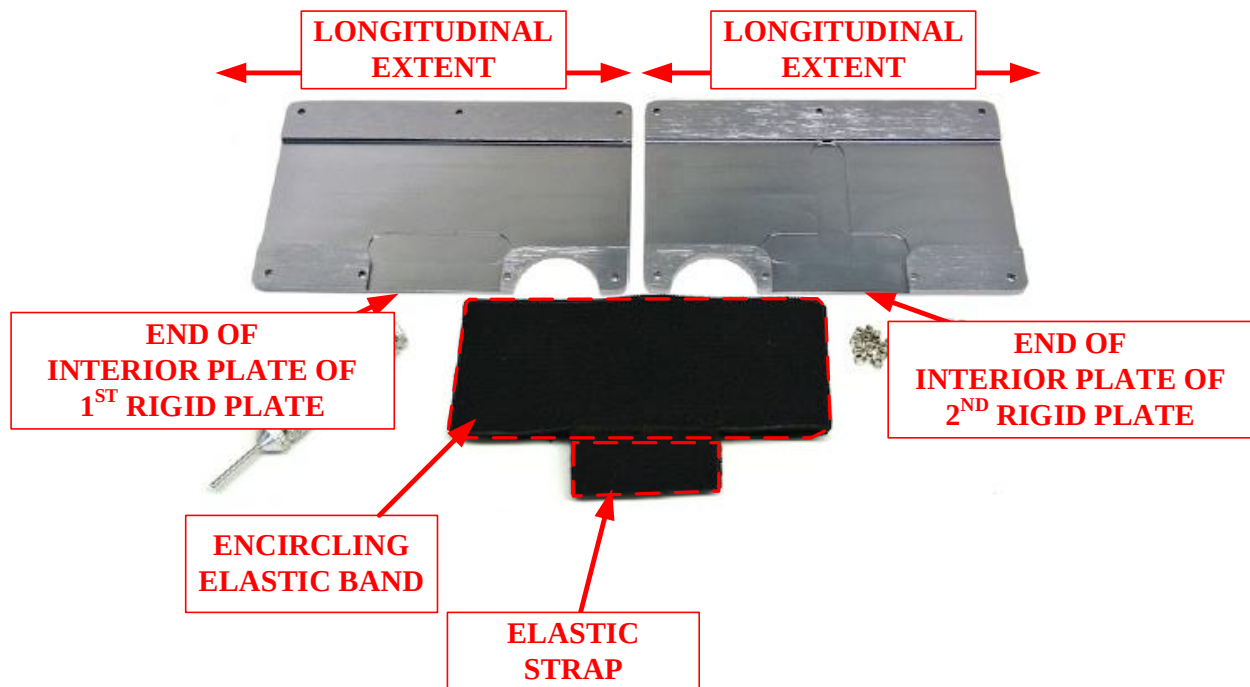
Kane discloses this limitation as set forth in Section IX.A.7.a, incorporated here. (Babcock ¶¶ 252-258.)

10. Claim 9

The discussion of Claim 1 is incorporated here.

a. Limitation 9[a]

Kane discloses this limitation (*e.g.*, in the same, or equivalent, manner as depicted in FIGS. 7-9 of the '808 Patent). (Ex. 1006 4-7; Babcock ¶¶ 259-264.)



(Ex. 1006 5 (*annotated*); Babcock ¶ 262.)

b. Limitation 9[b]

Kane depicts the elastic strap retaining the card-like contents from that end at which it is located (*e.g.*, in the same, or equivalent, manner as depicted in FIG. 1 of the '808 Patent). (Ex. 1006 3: “Singular Construction that won’t let cards slip out the bottom,” 4-7; Babcock ¶¶ 265-270.)

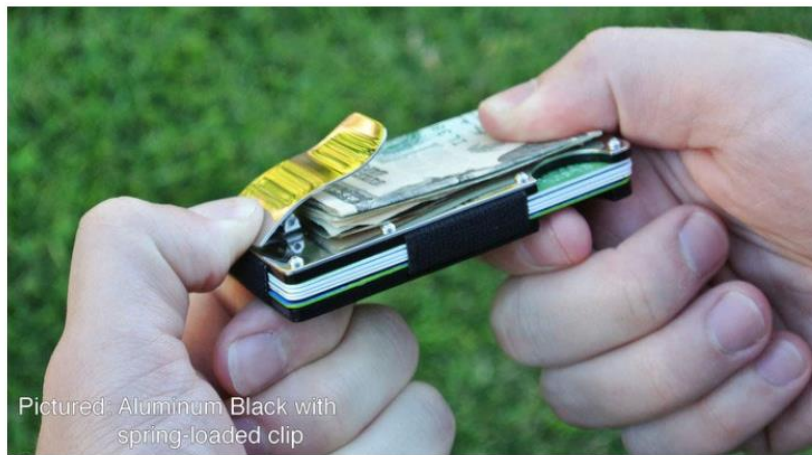
11. Claim 11

The discussion of Claim 1 is incorporated here.

a. Limitation 11[a]

Kane describes an RFID blocking feature of the wallet in the context of credit card technology; thereby implicitly describing a credit card to be included in the card-like contents secured within the wallet. (Ex. 1006 8; Babcock ¶¶ 271-277.)

Mr. Babcock opines, “a POSITA would have understood the stack of cards disclosed in the photographs of Kane... to include one or more credit cards since it has been well known (at and/or before the Critical Date), to carry credit cards in one’s wallet.” (Babcock ¶ 274.)



(Ex. 1006 4.)

Beckley discloses that “the wallet 5 may be used for securing financial instruments, organizing and carrying currency, credit cards, identification cards.” (Ex. 1007 ¶ [0034], FIGS. 2A-2B, 4B, 5A-5B, 6A-6B; Babcock ¶ 275.)

12. Claim 12

The discussion of Claim 1 is incorporated here.

a. Limitation 12[a]

Kane discloses “[t]humb indentation[s] at the lower left of the wallet allows you to easily push your cards up and select the correct one.” (Ex. 1006 at 8; Babcock ¶¶ 278-287.) Mr. Babcock opines, “a POSITA, reading Kane, would have understood the thumb indentations to constitute the claimed ‘finger notches.’ For example, POSITA would have understood a notch to be a type of indentation, and that an indentation shaped to accommodate a thumb would readily accommodate a finger as well.” (Babcock ¶¶ 281-283.)



(Ex. 1006 7 (*annotated*); Babcock ¶ 285.)

Mr. Babcock opines that Kane's thumb indentations, and operation thereof, are "identical, or at least equivalent, to the finger notches **13** depicted in FIGS. 1 and 10 of the '808 Patent...." (Babcock ¶ 286.)

b. Limitation 12[b]

Kane discloses a card edge and proximal ends of the rigid plates that are identical to the configuration shown in FIG. 10 of the '808 Patent as set forth in Section IX.A.12a, incorporated here. (Babcock ¶¶ 288-291.)

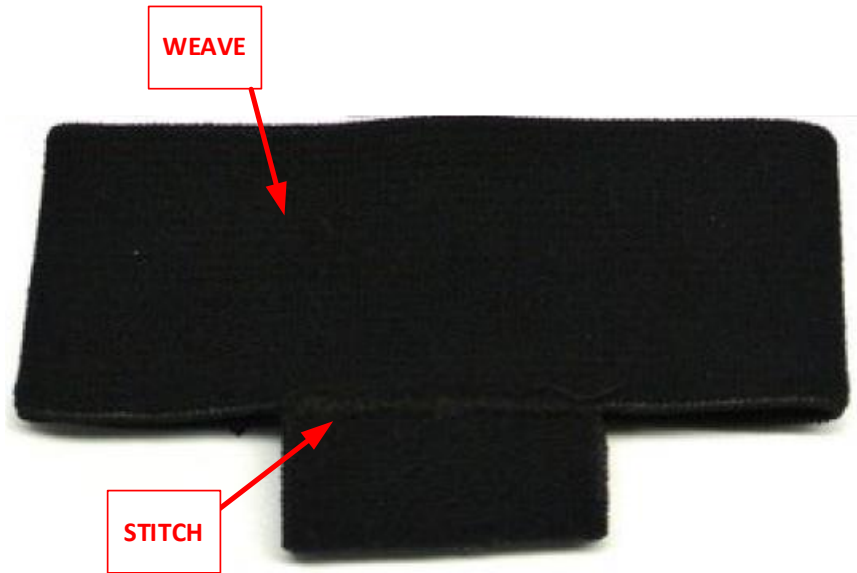
Mr. Babcock opines, "a POSITA would reasonably presume that wallets with identical structural features would perform identical functions." (Babcock ¶ 292.) As such, Kane discloses this limitation.

13. Claim 13

The discussion of Claim 1 is incorporated here.

a. Limitation 13[a]

Kane discloses the following photograph of the encircling elastic band:



(Ex. 1006 5 (*magnified, annotated*); Babcock ¶ 297.)

Mr. Babcock opines, “a POSITA would have understood the photograph to be depicting a woven elastic fabric.” (Babcock ¶ 296.)

14. Claim 14

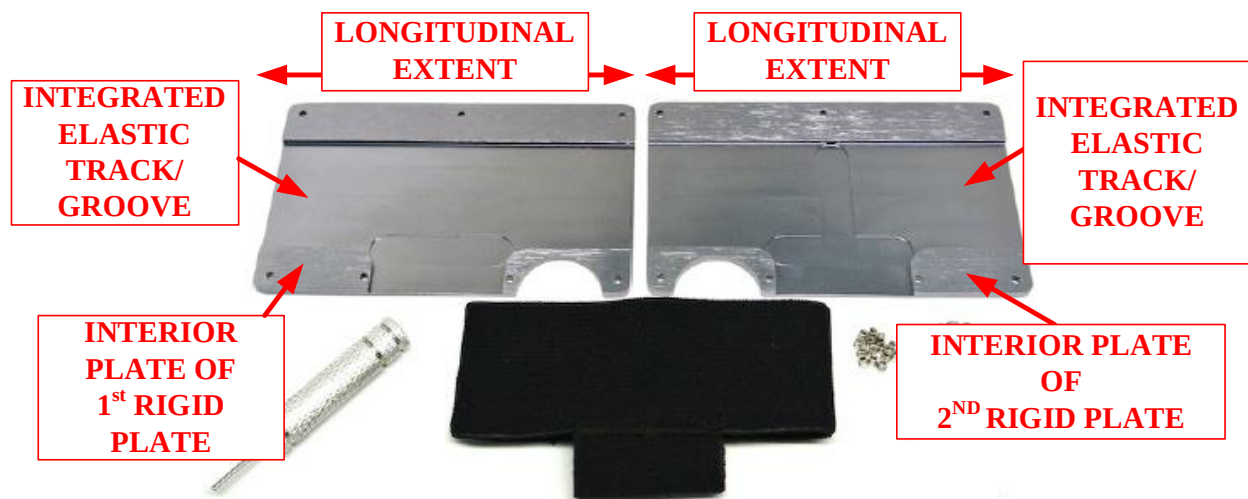
a. Limitation 14[a]

To the extent the preamble is limiting, both Kane and Beckley each disclose this limitation as set forth in Section IX.A.2.a. (Babcock ¶¶ 299-300.)

b. Limitation 14[b]

Kane discloses two rigid plates that meet this limitation as set forth in Section IX.A.2.b, incorporated here. (Babcock ¶ 302.)

Kane discloses an integrated elastic track (“groove”) within each rigid plate along the longitudinal extent thereof. (Ex. 1006 5; Babcock ¶¶ 303-306).



(Ex. 1006 5 (*annotated*); Babcock ¶ 303.)

c. Limitation 14[c]

A POSITA would understand “the grooves” to constitute each “groove” of the at least two rigid plates.

Kane discloses an encircling elastic band that meets this limitation as set forth in Section IX.A.2.c., incorporated here. (Babcock ¶¶ 307-309.) The encircling elastic band is slidingly interposed in the integrated elastic track (“grooves”) as set forth in Section IX.A.3.a, incorporated here. (Babcock ¶¶ 310-314.)

d. Limitation 14[d]

Kane discloses an integrated elastic track (“grooves”) that meets this limitation as set forth in Section IX.A.2.d, incorporated here. (Babcock ¶¶ 315-321.)

e. Limitation 14[e]

Beckley discloses a depression **15** (“recess”) that meets this limitation as set forth in Section IX.A.2.f, incorporated here. (Babcock ¶¶ 322-327.)

f. Limitation 14[f]

Beckley discloses this limitation as set forth in Sections IX.A.2.f and IX.A.2.e, which are incorporated here. (Babcock ¶¶ 328-333.)

g. Limitation 14[g]

Beckley discloses a barb **13** (“hook”) that meets this limitation as set forth in Section IX.A.2.g, incorporated here. (Babcock ¶¶ 334-338.)

Beckley discloses a cavity (“undercut”) that meets this limitation as set forth in Section IX.A.2.i, incorporated here. (*Id.*)

Beckley discloses the clip **3** (“auxiliary feature”) removably positioned in the depression **15**, which a POSITA would be motivated to form in a rigid plate, like that of Kane (*see* Section IX.A.1, incorporated here), that meets this limitation as set forth in Sections IX.A.2.e and IX.A.2.f, which are incorporated here. (Babcock ¶¶ 339-343.)

A POSITA would have been motivated to combine Kane and Beckley with a reasonable expectation of success as set forth in Section IX.A.1, incorporated here.

h. Limitation 14[h]

Beckley discloses this limitation as set forth in Section IX.A.2.h, incorporated here. (Babcock ¶¶ 344-349.)

i. Limitation 14[i]

Kane discloses this limitation as set forth in Section IX.A.2.j, incorporated here. (Babcock ¶¶ 350-352.)

15. Claim 15

The discussion of Claim 14 is incorporated here.

a. Limitation 15[a]

Kane discloses this limitation as set forth in Section IX.A.3.a, incorporated here. (Babcock ¶¶ 353-357.)

b. Limitation 15[b]

Kane discloses this limitation as set forth in Section IX.A.3.b, incorporated here. (Babcock ¶¶ 358-363.)

16. Claim 16

The discussion of Claim 15 is incorporated here.

a. Limitation 16[a]

Kane discloses this limitation as set forth in Section IX.A.4.a, incorporated here. (Babcock ¶¶ 364-368.)

17. Claim 17

The discussion of Claim 16 is incorporated here.

a. Limitation 17[a]

Kane discloses this limitation as set forth in Section IX.A.5.a, incorporated here. (Babcock ¶¶ 369-373.)

18. Claim 18

The discussion of Claim 18 is incorporated here.

a. Limitation 18[a]

Claim 18 is duplicative of Claim 6. Kane discloses this limitation (regardless of whether it depends from Claim 1 or 14) as set forth in Section IX.A.7.a, incorporated here. (Babcock ¶¶ 374-377.)

19. Claim 19

a. Limitation 19[a]

Both Kane and Beckley each disclose methods of making a modular compact wallet. (Ex. 1006 3: “turn the wallet into a ‘system’ that can be completely disassembled by the user to replace the elastic and exchange outer plates for greater personalization... low profile to easily fit in your front pocket;” Ex. 1007 ¶ [0034]: “the size and shape of the container [sic] may be adapted for use for particular articles;” Babcock ¶¶ 378-381.)

b. Limitation 19[b]

Kane discloses this limitation as set forth in Section IX.A.14.b, incorporated here. (Babcock ¶ 387.)

c. Limitation 19[c]

A POSITA would understand “the grooves” to constitute each “groove” of the “at least two rigid plates.” (*Id.*)

Kane discloses this limitation as set forth in Section IX.A.14.c, incorporated here. (Babcock ¶¶ 386-388.)

d. Limitation 19[d]

Kane discloses this limitation as set forth in Section IX.A.14.d, incorporated here. (Babcock ¶¶ 389-391.)

e. Limitation 19[e]

Beckley discloses a depression **15** (“recess”) as set forth in Section IX.A.2.f, incorporated here. (Babcock ¶¶ 392-394.)

A POSITA would understand “at least one groove” to be at least one groove of the grooves, and the “elastic band” to be the “at least one encircling elastic band.” (Babcock ¶¶ 393, 395.)

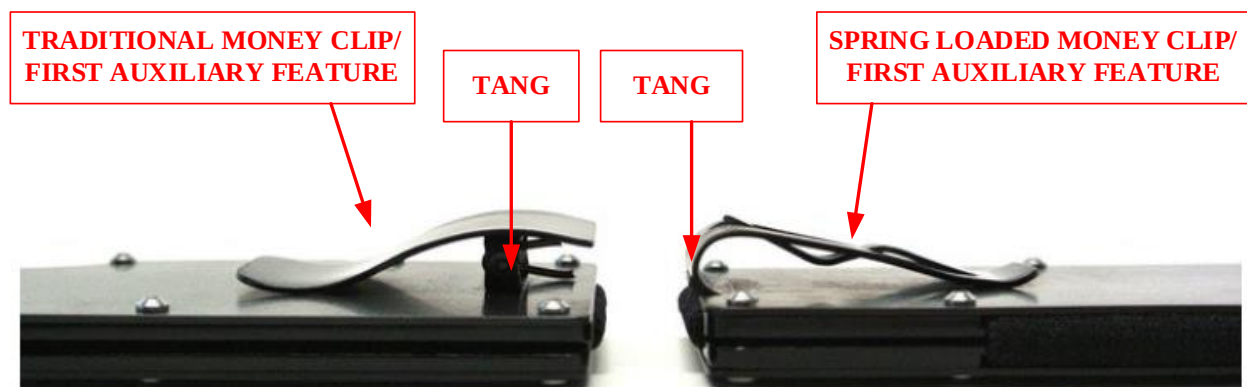
A POSITA would be motivated to form a depression (“recess”), like that of Beckley, in addition to the integrated elastic track (“groove”) and outbound the elastic band of a compact wallet, like that of Kane, to configure the wallet with a

removably attachable clip (“auxiliary feature”) without interfering with the function of the depression (“recess”) (*e.g.*, to capture the clip) or the elastic band (*e.g.*, to provide the wallet with elastic volume). (Babcock ¶¶ 395-396.)

Moreover, forming a depression (“recess”), like that of Beckley, outbound of a compact wallet’s elastic band, like that of Kane, would be an obvious configuration from a finite number of identified, predictable positions, with a reasonable expectation of success (*e.g.*, there are finite number of locations in the rigid plate to position the depression without interfering in the operation of the depression and/or the elastic band). (Babcock ¶ 398.)

f. Limitation 19[f]

Kane discloses “[t]he Ridge 2 is available with two different types of money clips,” each of which have a tang and constitute the claimed “first auxiliary feature.” (Ex. 1006 6; Babcock ¶¶ 403-404.)



(Ex. 1006 6 (*annotated*); Babcock ¶ 403.)

Beckley discloses a clip **3** (“auxiliary feature”) having a tang as set forth in Section IX.A.14.f, incorporated here. (Babcock ¶¶ 400-402.)

g. Limitation 19[g]

Beckley discloses inserting the tang of the clip **3** (“auxiliary feature”) into the depression **15** (“recess”) as set forth in Section IX.A.14.f, incorporated here. (Babcock ¶ 406-409.)

In incorporating the teachings of Beckley into Kane, the clip (“auxiliary feature”) would be rendered available to an outside face of the wallet, and thereby the rigid plate, in accordance with the teachings of Beckley. (Ex. 1007 FIGS. 4A-4B; Babcock ¶ 410.)

h. Limitation 19[h]

A POSITA would find it obvious, reading Beckley, to selectively remove a removably attached clip (“first auxiliary feature”), like that of Beckley; as doing so would be an exercise of the clip’s intended function (*i.e.*, the clip is removably attached so that it can be removed). (Ex. 1007 ¶¶ [0038]-[0039], FIG. 1; Babcock ¶ 414.)

A POSITA would have been motivated to combine Kane and Beckley with a reasonable expectation of success as set forth in Section IX.A.1, incorporated here.

i. Limitation 19[i]

Beckley discloses this limitation as set forth above in Section IX.A.19.f, incorporated here. (Babcock ¶ 419.) A POSITA would be motivated to exchange an initial clip (“first auxiliary feature”) with a substitute clip (“second auxiliary feature”) to personalize the wallet (*e.g.*, choose a different color clip), adapt the wallet to a given use preference, and/or perform a maintenance/repair operation (*e.g.*, replace a damaged clip), as suggested by Kane. (Ex. 1006 3: “turn the wallet into a ‘system’... to replace the elastic and exchange the outer plates for greater personalization,” 15-16: “Our biggest challenge is conveying our idea and creating a product that is versatile enough to suit a wide range of people and preferences; Babcock ¶ 420.)

In doing so, providing the substitute clip (“second auxiliary feature”) would be a mere duplication of parts and assembly steps without any new or unexpected results³. (Babcock ¶¶ 421-422.)

j. Limitation 19[j]

Beckley discloses this limitation as set forth above in Section IX.A.19.g, incorporated here. (Babcock ¶¶ 425-426.)

³ *In reHarza*, 274 F.2d 669, 124 U.S.P.Q. 378 (CCPA 1960) (“It is well settled that a mere duplication of parts has no patentable significance unless a new and unexpected result is produced....”)

A POSITA would be motivated to exchange an initial clip (“first auxiliary feature”) with a substitute clip (“second auxiliary feature”) as set forth above in Section IX.A.19.i, incorporated here. (Babcock ¶ 427.) In doing so, inserting the substitute clip (“second auxiliary feature”) into the depression (“recession”), like that of Beckley, would constitute an obvious duplication of parts and assembly steps without any new or unexpected results. (Babcock ¶ 428.)

k. Limitation 19[k]

Beckley discloses this limitation as set forth in Section IX.A.14.g, incorporated here. (Babcock ¶¶ 430-436.)

l. Limitation 19[l]

Beckley discloses this limitation as set forth in Section IX.A.2.h, incorporated here. (Babcock ¶¶ 437-440.)

m. Limitation 19[m]

Beckley discloses this limitation as set forth in Section IX.A.2.f, incorporated here. (Babcock ¶¶ 441-447.)

n. Limitation 19[n]

Kane discloses this limitation as set forth in Section IX.A.2.j, incorporated here. (Babcock ¶ 449.)

A POSITA would understand “proving” to be a grammatical error, where this limitation intends to recite “providing additional functionality.” (Babcock ¶ 450.)

Kane depicts the money clip providing functionality by securing currency to the outside of the wallet. (Ex. 1006 4; Babcock ¶ 451.)



(Ex. 1006 4.)

20. Claim 20

The discussion of Claim 19 is incorporated here.

a. Limitation 20[a]

Beckley discloses the depression **15** (“recess”) having a cavity **14** (“undercut”) as set forth in Section IX.A.2.i, incorporated here. (Babcock ¶ 458.)

A POSITA would understand the tang of this limitation to be the tang of the first auxiliary feature. (Babcock ¶¶ 456-457.)

Beckley discloses a tang having a barb **13** (“hook”) as set forth in Section IX.A.2.g, incorporated here. A POSITA would have found it obvious to utilize an initial clip (“first auxiliary clip”) with a tang and barb (“hook”) same as the substitute

clip (“second auxiliary clip”) as doing so would be a mere duplication parts without any new or unexpected results. (Babcock ¶ 459.)

b. Limitation 20[b]

A POSITA would understand “the hook” to be the hook of the first auxiliary feature. (Babcock ¶ 462.)

Beckley discloses a barb **13** (“hook”) and cavity **14** (“undercut”) engagement as set forth in Section IX.A.2.i, incorporated here. A POSITA would have found it obvious to utilize the same barb (“hook”) and cavity (“undercut”) engagement for both an initial clip (“first auxiliary feature”) and substitute clip (“second auxiliary feature”) as doing so would constitute a mere duplication of parts and assembly steps without any new or unexpected results. (Babcock ¶ 463.)

21. Claim 21

The discussions of Claims 19 and 20 are incorporated here.

a. Limitation 21[a]

Kane discloses: “[t]he Ridge 2 is available with two different types of money clips or without a clip.” (Ex. 1006 6; Babcock ¶¶ 465-468.)

B. Ground 2: Claims 1-9 and 11-21 are rendered obvious under 35 U.S.C. §103 by Kane in view of Pelz.

The Kane-Pelz combination renders Claims 1-9 and 11-21 obvious.
(Babcock ¶¶ 469-747.)

1. The Kane-Pelz Combination

a. Motivation to Combine

A POSITA would have been motivated to configure a compact wallet, like that of Kane, with a clip that is removable, like that of Pelz, to allow a consumer to remove the clip when not needed in accordance with the minimalist preferences, personalization, adapted use, and/or maintenance/repair operations promoted by Kane. (Ex. 1006 3: “turn the wallet into a ‘system’ that can be completely disassembled by the user to replace the elastic and exchange outer plates for greater personalization,” 6: “The Ridge 2 is available with two different types of money clips or without a clip,” 7-10: photographs thereof, 15-16: “Our biggest challenge is conveying our idea and creating a product that is versatile enough to suit a wide range of people and preferences;” Babcock ¶¶ 496-497, 504-505, 511-512, 518-519, 526-527, 602, 605-606, 612, 622-623, 629-630, 670, 683, 692-693, 697, 702, 704, 711-713, 725.)

Moreover, a POSITA would have good reason to look to Pelz for guidance on how to configure a compact wallet of Kane, with a clip that is removable.

Both references disclose innovations in the field of compact wearable devices. (Ex. 1006 2; Ex. 1008 1:6-8; Babcock ¶ 489.) Both references identify bulkiness as a problem attributable to existing compact devices. (Ex. 1006 2: “The Ridge 2.0 [is] Designed to be an encompassing alternative to a bulky traditional leather wallet;”

Ex. 1008 1:9-12: “clips often project a considerable distance from the case and therefore add undesirably to the thickness of the unit or press uncomfortably against the wearer;” Babcock ¶ 490.)

Both references utilize spring-operable auxiliary clips. (Ex. 1006 3: “money clip with an internal spring (spring-loaded),” 6-7: photographs thereof; Ex. 1008 2:39-42: “The upper end of the clip is spaced from the case by a U-shaped leaf spring that presses the contact buttons against the case, as shown in FIG. 2; Babcock ¶¶ 491-492.)

Both references disclose structural limitations that, when combined, function in the same manner as each does separately to yield predictable results. In attaching a clip, like that of Pelz, to a rigid plate, like that of Kane, the combined clip and rigid plate function in the same manner as each does separately. (Ex. 1006 5: “[t]he Integrated Elastic Track can expand up to 12 cards and then immediately contract to hold a single card securely,” photographs thereof, 8: “top of the inner plates are tapered to let you easily slide additional cards into the wallet;” Ex. 1008 1:6-8: “a clip attached to its case for holding it in position in a pocket or in some other location on the clothing of the user of the instrument;” Babcock ¶ 493.)

Moreover, a POSITA would have found the teachings of Pelz reasonably pertinent to problems faced by the inventor of the '808 Patent, which describes that an objective of the inventor was to provide a compact wallet with an auxiliary feature

that can be modularly exchanged. (Ex. 1001 2:37-40.) Pertinent to this objective, Pelz discloses “[i]t is among the objects of this invention to provide... a clip that lies close to the case... and which is readily detachable from the case.” (Ex. 1008 1:20-27; Babcock ¶¶ 494, 613, 620, 628, 686, 711, 720.) The ’808 Patent identifies an “unfulfilled need” for “a compact wallet which would be minimally dimensioned to the prototypical credit card profile. Such a compact wallet would be void of any potentially snagging structural appendages...” (Ex. 1001 2:1-5.) Pertinent to this “unfulfilled need,” Pelz discloses a clip 2 that “lies close to the case, which has little tendency to catch on the clothing.” (Ex. 1008 1:22-23; Babcock ¶¶ 494, 613, 620, 628, 686, 711, 720.)

The technique of configuring a compact wearable device with a removable clip utilizing a hook (defined by a side recess of the finger) and an undercut (defined by a sidewall of a pin) engagement was within the realm of ordinary capabilities of a POSITA based upon the teachings of Pelz. (Ex. 1008 1:20-27, 2:25-28, 3:72-4:15, FIGS. 1-2, 8; Babcock ¶¶ 495, 621, 687, 710.)

b. Reasonable Expectation of Success

A POSITA would have reasonably expected success incorporating the teachings of Pelz into Kane as described. (Babcock ¶¶ 503, 512, 517, 519, 527, 606, 623, 630, 713, 724.) A POSITA would have found it obvious to form a depression and with pins, like that of Pelz, into a rigid plate of a compact wallet, like that of

Kane, to effectuate a removably attached clip as there are a finite number of locations at which to attach the clip. (Babcock ¶¶ 503-505, 601-605, 670, 673, 724-726.) Forming the depression, like that of Pelz, into a rigid plate, like that of Kane, would be a mere continuation of routine milling operations used for producing the plates and thereby would not require additional machinery to manufacture and minimal additional costs. (Babcock ¶¶ 504, 604, 726.)

By incorporating the teachings of Pelz into Kane, such a person would be applying a known technique to a known device ready for improvement to yield predictable results. (Babcock ¶¶ 495, 503, 510, 517, 525, 601, 621, 685, 687, 711, 724.)

2. Claim 1

a. Limitation 1[a]

Kane discloses this limitation as set forth in Section IX.A.2.a, incorporated here. (Babcock ¶¶ 470-474.)

b. Limitation 1[b]

Kane discloses this limitation as set forth in Section IX.A.2.b, incorporated here. (Babcock ¶¶ 475-477.)

c. Limitation 1[c]

Kane discloses this limitation as set forth in Section IX.A.2.c, incorporated here. (Babcock ¶¶ 478-480.)

d. Limitation 1[d]

Kane discloses this limitation as set forth in Section IX.A.2.d, incorporated here. (Babcock ¶¶ 481-483.)

e. Limitation 1[e]

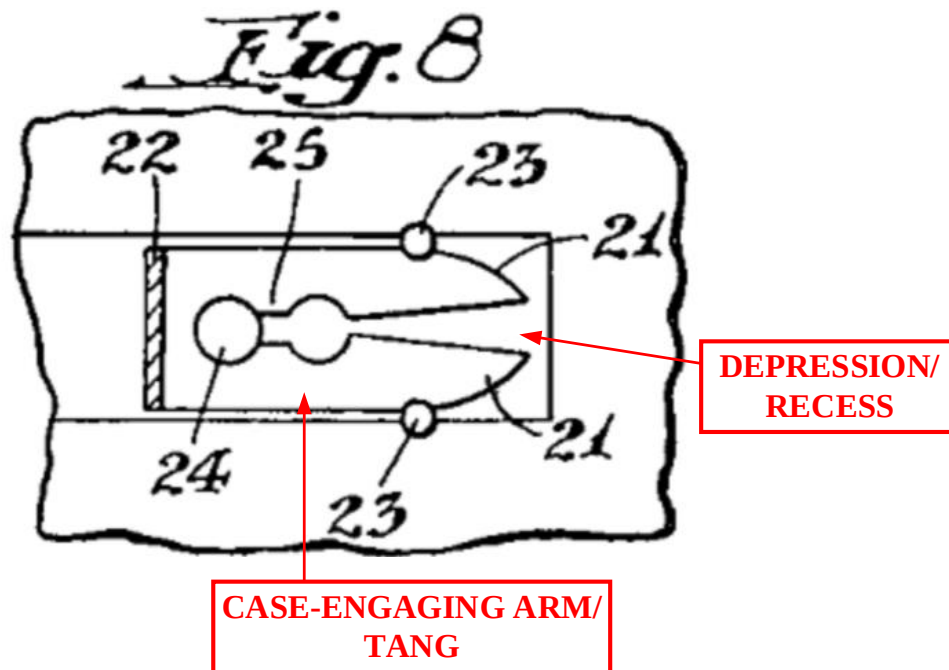
Pelz discloses “a clip that lies close to the case... and which is readily detachable from the case.” (Ex. 1008 1:22-27, 1:41-43, 2:54-3:3, 3:73-4:15, FIGS. 1-2, 8; Babcock ¶¶ 484-487.)

A POSITA would have been motivated to combine Kane and Pelz with a reasonable expectation of success as set forth in Section IX.B.1, incorporated here.

f. Limitation 1[f]

Pelz discloses the clip **2** (“auxiliary feature”) having a case-engaging arm **10** (“tang”) insertable into a depression **19** (“recess”) to detachably connect the clip **2** to the case **1**. (Ex. 1008 2:54-3:3, 3:61-66, FIG. 8; Babcock ¶ 500-501.)

Pelz’s depression **19** teaches a recess, as properly construed, because it is a groove having a sidewall that is adjacent to a longitudinally extending groove (*e.g.*, an interior cavity of the case **1**). (Babcock ¶ 502.) The depression **19** is a surface groove that defines an indentation occurring in a surface of the case **1**. (*Id.*)

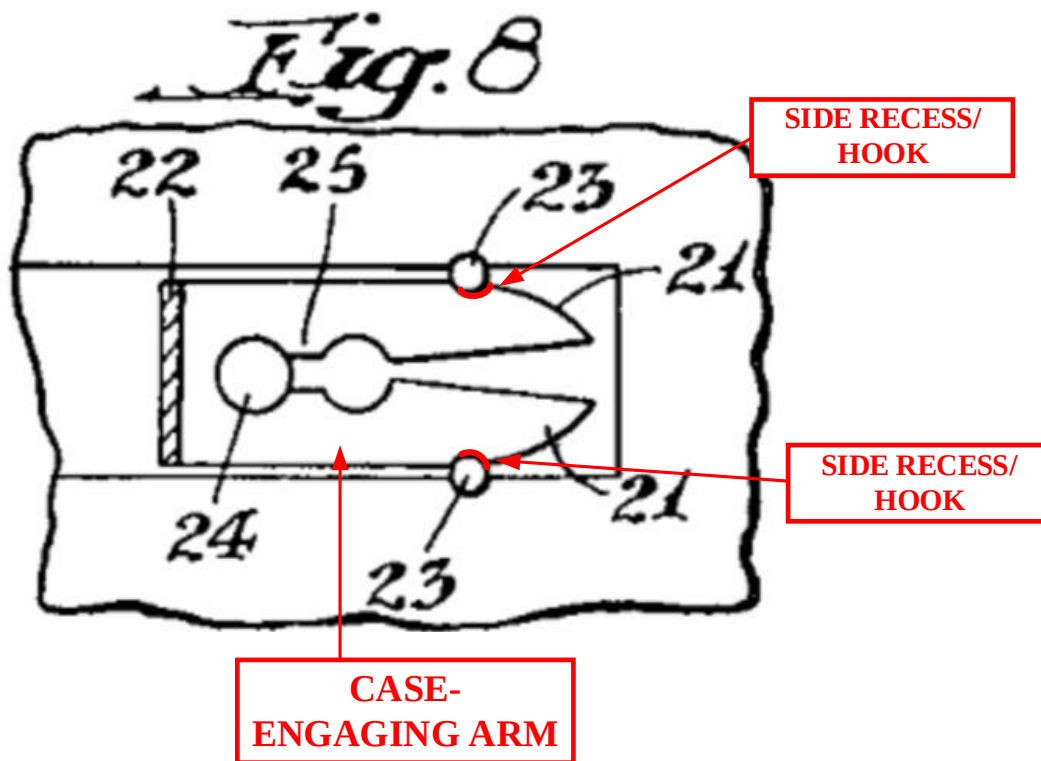


(Ex. 1008 FIG. 8 (*annotated*); Babcock ¶ 501.)

A POSITA would have been motivated to combine Kane and Pelz with a reasonable expectation of success as set forth in Section IX.B.1, incorporated here.

g. Limitation 1[g]

Pelz discloses the case-engaging arm **10** (“tang”) having side recesses that define hooks. (Ex. 1008 1:48-52, 3:72-4:15, FIG. 8; Babcock ¶ 508.) Pelz’s side recess defines a hook, as properly construed, because the portion of the case-engaging arm **10** defined by the side recess abruptly changes direction from a trunk section to define a ledge for catching or holding. (Ex. 1008 1:48-52, 3:72-4:15, FIG. 8; Babcock ¶ 509.) Each side recess defines a curved or bent device for catching or holding, as shown in *annotated* FIG. 8 below. (Ex. 1008 1:48-52, 3:72-4:15, FIG. 8; Babcock ¶ 509.)

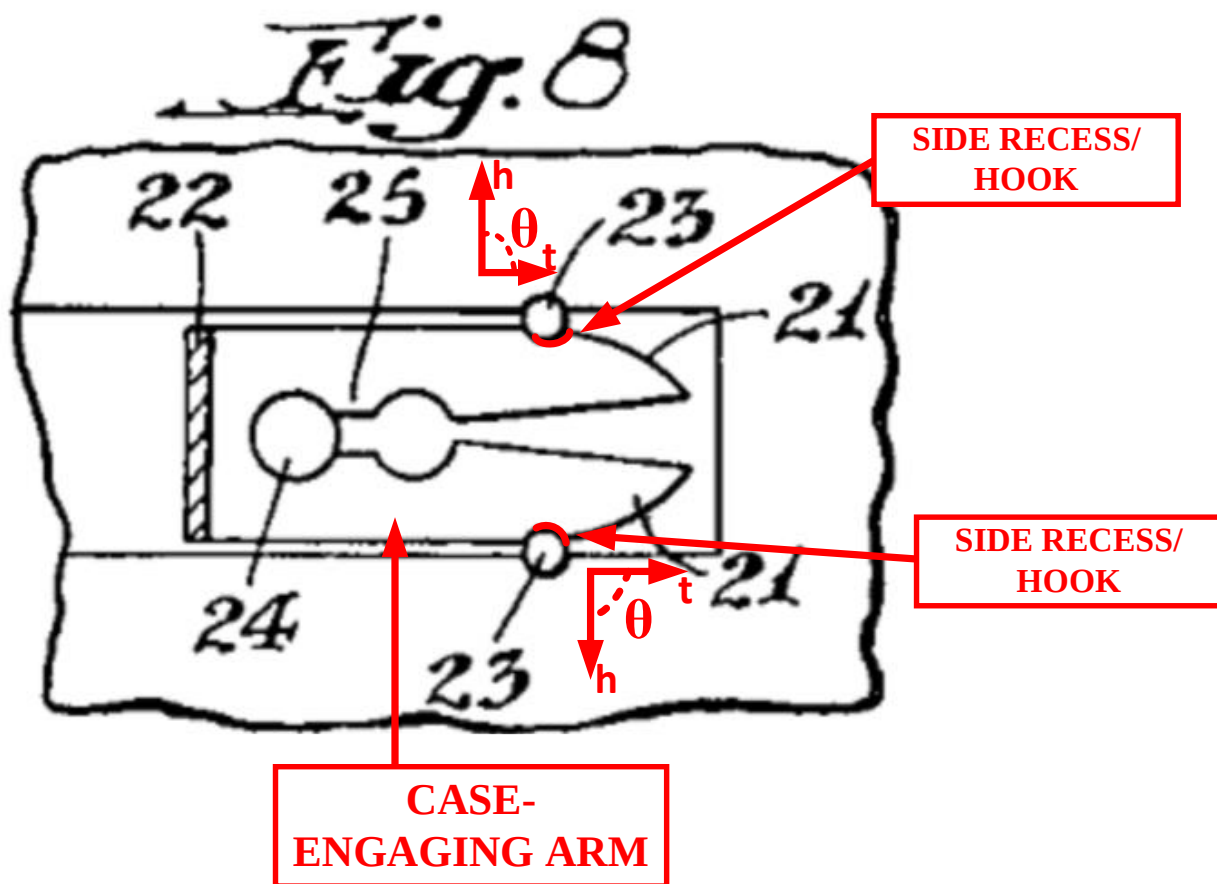


(Ex. 1008 FIG. 8 (*annotated*); Babcock ¶ 508.)

A POSITA would have been motivated to combine Kane and Pelz with a reasonable expectation of success as set forth in Section IX.B.1, incorporated here.

h. Limitation 1[h]

Provided below is a magnified portion of FIG. 8 of Pelz, annotated in red to delineate the direction at which the case-engaging arm **10** (“tang”) extends (t), the direction at which the hooks extend (h), and the angle therebetween (θ).



(Ex. 1008 FIG. 8 (*annotated*); Babcock ¶ 515.)

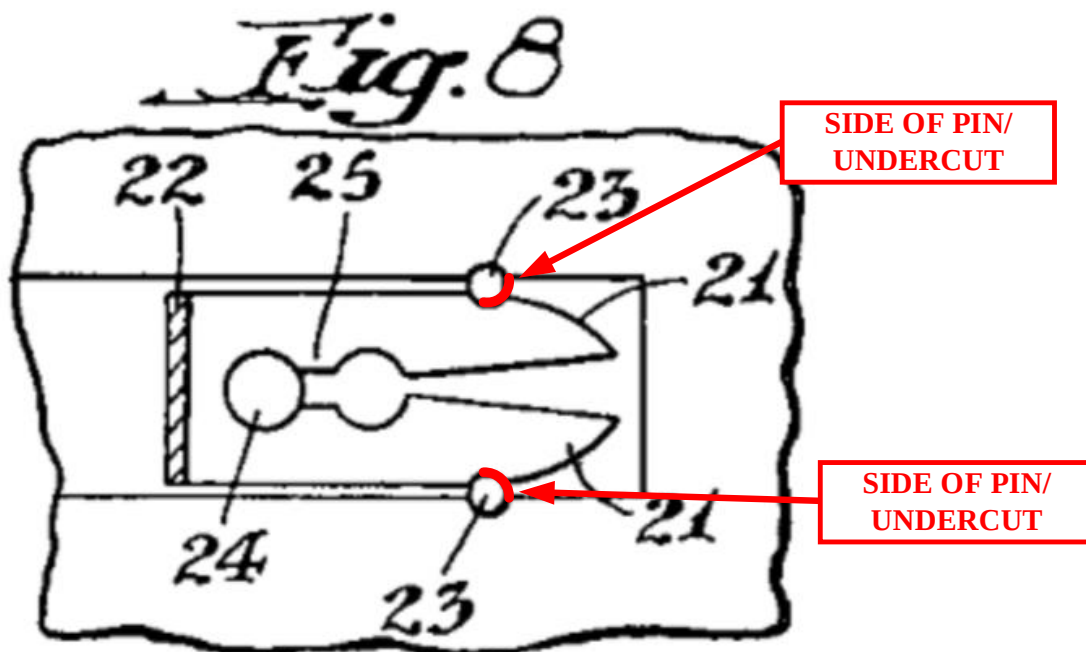
Mr. Babcock opines “to the extent that the hooks are found not to extend at the nearly perpendicular angle shown above, a POSITA would have understood that a degree to the ‘angle’ is not recited....” (Babcock ¶ 516.)

A POSITA would have been motivated to combine Kane and Pelz with a reasonable expectation of success as set forth in Section IX.B.1, incorporated here.

i. Limitation 1[i]

Pelz discloses a pin **23** that can be “molded projections integral with the case,” where the sides of the pins **23** extent into the depression **19** opposite the side recesses

that define the hooks. (Ex. 1008 4:3-8, FIG. 8; Babcock ¶¶ 523-524.) The sides of the pins 23 constitute, as properly construed, the claimed “undercut” because they define a cut away portion from the sides of the depression 19 (“recess”). (*Id.*) The sides of the pins 23 define an underside recess that is molded into the depression 19 (“recess”) to define a lip or protuberance. (*Id.*)



(Ex. 1008 FIG. 8 (*annotated*); Babcock ¶ 523.)

Pelz discloses the hooks (defined by the side recess of the case-engaging arm 10) engaging the undercuts (defined by the sides of the pins 23) to prevent the clip 2 from inadvertently dislodging from the depression 19 (“recess”). (Ex. 1008 1:48-52: “The laterally resilient fingers are provided with side recesses for receiving

means projecting from the case to normally hold the spring against movement downwardly thereon,” 3:72-4:15, FIG. 8; Babcock ¶ 522.)

A POSITA would have been motivated to combine Kane and Pelz with a reasonable expectation of success as set forth in Section IX.B.1, incorporated here.

j. Limitation 1[j]

Kane discloses this limitation as set forth in Section IX.A.2.j, incorporated here. (Babcock ¶ 530.)

3. Claims 2-9 and 11-13

The Kane-Pelz combination discloses all the limitations of Claim 1 as set forth in Section IX.B.2, incorporated here.

Kane discloses all the limitations of Claims 2-9 and 11-13 as set forth in Section IX.A.3 to Section IX.A.13.a of Ground 1, which are incorporated here. (Babcock ¶¶ 532-587.)

4. Claim 14

a. Limitation 14[a]

To the extent the preamble is limiting, Kane discloses this limitation as set forth in Section IX.A.2.a, which is incorporated here. (Babcock ¶¶ 588-589.)

b. Limitation 14[b]

Kane discloses this limitation as set forth in Section IX.A.14.b, incorporated here. (Babcock ¶¶ 590-592.)

c. Limitation 14[c]

Kane discloses this limitation as set forth in Section IX.A.14.c, incorporated here. (Babcock ¶¶ 593-595.)

d. Limitation 14[d]

Kane discloses this limitation as set forth in Section IX.A.14.d, incorporated here. (Babcock ¶¶ 596-598.)

e. Limitation 14[e]

Pelz discloses a depression **19** (“recess”) that meets this limitation as set forth in Section IX.B.2.f, incorporated here. (Babcock ¶¶ 599-607.)

f. Limitation 14[f]

Pelz discloses this limitation as set forth in Sections IX.B.2.f and IX.B.2.e, which are incorporated here. (Babcock ¶¶ 608-611.)

g. Limitation 14[g]

Pelz discloses a hook that meets this limitation as set forth in Section IX.B.2.g, incorporated here. (Babcock ¶ 617.)

Pelz discloses an undercut that meets this limitation as set forth in Section IX.B.2.i, incorporated here. (*Id.*)

Pelz discloses the clip **2** (“auxiliary feature”) removably positioned in the depression **19** (“recess”), which a POSITA would be motivated to form in a rigid plate, like that of Kane (*see* Section IX.B.1, incorporated here), that meets this

limitation as set forth in Sections IX.B.2.e and IX.B.2.f, which are incorporated here. (Babcock ¶ 618.)

h. Limitation 14[h]

Pelz discloses this limitation as set forth in Section IX.B.2.h, incorporated here. (Babcock ¶ 626.)

i. Limitation 14[i]

Kane discloses this limitation as set forth in Section IX.A.2.j, incorporated here. (Babcock ¶¶ 632-634.)

5. Claims 15-18

The Kane-Pelz combination discloses all the limitations of Claim 14 as set forth in Section IX.B.4, incorporated here.

Kane discloses all the limitations of Claims 15-18 as set forth in Section IX.A.15 to Section IX.A.18 of Ground 1, which are incorporated here. (Babcock ¶¶ 635-654.)

6. Claim 19

a. Limitation 19[a]

To the extent the preamble is limiting, Kane discloses this limitation as set forth in Section IX.A.19.a, incorporated here. (Babcock ¶¶ 655-658.)

b. Limitation 19[b]

Kane discloses this limitation as set forth in Section IX.A.14.b, incorporated here. (Babcock ¶¶ 659-661.)

c. Limitation 19[c]

Kane discloses this limitation as set forth in Section IX.A.19.c, incorporated here. (Babcock ¶¶ 662-664.)

d. Limitation 19[d]

Kane discloses this limitation as set forth in Section IX.A.14.d, incorporated here. (Babcock ¶¶ 665-667.)

e. Limitation 19[e]

Pelz discloses a depression **19** (“recess”) as set forth in Section IX.B.2.f, incorporated here. (Babcock ¶ 670.)

A POSITA would understand “at least one groove” to be at least one groove of the grooves, and the “elastic band” to be the “at least one encircling elastic band.” (Babcock ¶ 669.)

A POSITA would be motivated to form a depression (“recess”), like that of Pelz, in addition to the integrated elastic track (“groove”) and outbound the elastic band of a compact wallet, as that of Kane, to configure the wallet with a removably attachable clip (“auxiliary feature”) without interfering with the function of the

depression (“recess”) (*e.g.*, to capture the clip) or the elastic band (*e.g.*, to provide the wallet with elastic volume). (Ex. 1008: 3:60-66; Babcock ¶ 671.)

Moreover, forming a depression (“recess”), like that of Pelz, outbound of a compact wallet’s elastic band, like that that of Kane, would be an obvious configuration from a finite number of identified, predictable positions, with a reasonable expectation of success (*e.g.*, there are finite number of locations in the rigid plate to position the depression without interfering in the operation of the depression and/or the elastic band). (Babcock ¶ 673.)

f. Limitation 19[f]

Kane discloses this limitation as set forth in Section IX.A.19.f, incorporated here. (Babcock ¶¶ 678-679.)

Pelz discloses this limitation as set forth in Section IX.B.14.f, incorporated here. (Babcock ¶¶ 676-677.)

g. Limitation 19[g]

Pelz discloses this limitation as set forth in Section IX.B.14.f, incorporated here. (Babcock ¶¶ 682, 688.)

Incorporating the teachings of Pelz into Kane, the clip (“auxiliary feature”) would be rendered available to an outside face of the wallet, and thereby the rigid plate, in accordance with the teachings of Pelz. (Ex. 1008 FIG. 1; Babcock ¶¶ 683-684.)

h. Limitation 19[h]

A POSITA would find it obvious, reading Pelz, to selectively remove a removably attached clip (“first auxiliary feature”), like that of Pelz; as doing so would be an exercise of the clip’s intended function (*i.e.*, the clip is removably attached so that it can be removed). (Ex. 1008 1:12-14: “[i]t generally is desirable to make the clips detachable so that the case can be used without them;” Babcock ¶ 691.)

A POSITA would have been motivated to combine Kane and Pelz with a reasonable expectation of success as set forth in Section IX.B.1, incorporated here.

i. Limitation 19[i]

Pelz discloses this limitation as set forth above in Section IX.B.19.f, which is incorporated here. (Babcock ¶¶ 695-696, 699.) A POSITA would be motivated to exchange an initial clip (“first auxiliary feature”) with a substitute clip (“second auxiliary feature”) to personalize the wallet (*e.g.*, choose a different color clip), adapt the wallet to a given use preference, and/or perform a maintenance/repair operation (*e.g.*, replace a damaged clip), as suggested by Kane. (Ex. 1006 3: “turn the wallet into a ‘system’... to replace the elastic and exchange the outer plates for greater personalization,” 15-16: “Our biggest challenge is conveying our idea and creating a product that is versatile enough to suit a wide range of people and preferences;” Babcock ¶ 697.)

In doing so, providing the substitute clip (“second auxiliary feature”) would be a mere duplication of parts and assembly steps without any new or unexpected results. (Babcock ¶ 698.)

j. Limitation 19[j]

Pelz discloses this limitation as set forth above in Section IX.B.19.g, incorporated here. (Babcock ¶¶ 702-703.)

A POSITA would be motivated to exchange an initial clip (“first auxiliary feature”) with a substitute clip (“second auxiliary feature”) as set forth above in Section IX.B.19.i, incorporated here. (Babcock ¶¶ 704-705.) In doing so, inserting the substitute clip (“second auxiliary feature”) into the depression (“recession”), like that of Pelz, would constitute an obvious duplication of parts and assembly steps without any new or unexpected results. (*Id.*)

k. Limitation 19[k]

Pelz discloses this limitation as set forth in Section IX.B.14.g, incorporated here. (Babcock ¶¶ 708-709.)

l. Limitation 19[l]

Pelz discloses this limitation as set forth in Section IX.B.2.h, incorporated here. (Babcock ¶¶ 717-718.)

m. Limitation 19[m]

Pelz discloses this limitation as set forth in Section IX.B.2.f, incorporated here. (Babcock ¶ 723.)

n. Limitation 19[n]

Kane discloses this limitation as set forth in Section IX.A.19.n, incorporated here. (Babcock ¶¶ 729-731.)

7. Claim 20

The discussion of Claim 19 is incorporated here.

a. Limitation 20[a]

Pelz discloses the depression **19** (“recess”) having an undercut as set forth in Section IX.B.2.i, incorporated here. (Babcock ¶ 734.)

A POSITA would understand the tang of this limitation to be the tang of the first auxiliary feature. (Babcock ¶ 735.)

Pelz discloses a case-engaging arm **10** (“tang”) having a hook as set forth in Sections IX.B.2.g, incorporated here. A POSITA would have found it obvious to utilize an initial clip (“first auxiliary clip”) with a case-engaging arm and hook same as the substitute clip (“second auxiliary clip”) as doing so would be a mere duplication parts without any new or unexpected results. (Babcock ¶¶ 736-737.)

b. Limitation 20[b]

A POSITA would understand “the hook” to be the hook of the first auxiliary feature. (Babcock ¶ 740.)

Pelz discloses a hook and undercut engagement as set forth in Sections IX.B.2.i, incorporated here. A POSITA would have found it obvious to utilize the same hook and undercut engagement for both an initial clip (“first auxiliary feature”) and substitute clip (“second auxiliary feature”) as doing so would constitute a mere duplication of parts and assembly steps without any new or unexpected results. (Babcock ¶¶ 741.)

8. Claim 21

The discussions of Claims 19 and 20 are incorporated here.

a. Limitation 21[a]

Kane discloses this limitation as set forth in Section IX.A.21.a, incorporated here. (Babcock ¶¶ 743-747.)

C. Ground 3: Claims 1-9 and 11-21 are rendered obvious under 35 U.S.C. §103 by Kane in view of Matthews.

The Kane-Matthews combination renders Claims 1-9 and 11-21 of the ’808 Patent obvious. (Babcock ¶¶ 748-1035.)

1. The Kane-Matthews Combination.

a. Motivation to Combine

A POSITA would have been motivated to configure a compact wallet, like that of Kane, with a clip that is removable, like that of Matthews, to allow a consumer to remove the clip when not needed in accordance with the minimalist preferences, personalization, adapted use, and/or maintenance/repair operations promoted by Kane. (Ex. 1006 3: “turn the wallet into a ‘system’ that can be completely disassembled by the user to replace the elastic and exchange outer plates for greater personalization,” 6: “The Ridge 2 is available with two different types of money clips or without a clip,” 7-10: photographs thereof, 15-16: “Our biggest challenge is conveying our idea and creating a product that is versatile enough to suit a wide range of people and preferences;” (Babcock ¶¶ 769, 775-776, 791-792, 799-800, 807-808, 888-889, 895, 903-904, 911-912, 954, 968, 975-976, 980, 986, 988, 998-999.)

Moreover, a POSITA would have good reason to look to Matthews for guidance on how to configure a compact wallet of Kane, with a removable clip.

Both references disclose innovations in the field of card holders with external clips. (Ex. 1006 2, 6; Ex. 1009 ¶ [0019], [0029], [0033], [0041], FIGS. 1-5; Babcock ¶ 772.)

Both references address a problem of known card holder designs. (Ex. 1006 2: “alternative to a bulky traditional leather wallet and a dedicated minimalist wallet that can only hold a few cards,” 8: “[t]he Thumb indentation at the lower left of the wallet allows you to easily push your cards up and select the correct one... the inner plates are tapered to let you easily slide the additional cards into the wallet;” Ex. 1009 ¶ [0006]: “there are many different methods of storing and locating wallet sized cards. However, most storage devices are not designed for fast, easy, convenient access;” (Babcock ¶ 771.)

Both references disclose structural limitations that, when combined, function in the same manner as each does separately to yield predictable results. In attaching a clip, like that of Matthews, to a rigid plate, like that of Kane, the combined clip and rigid plate function in the same manner as each does separately. (Ex. 1006 5: “[t]he Integrated Elastic Track can expand up to 12 cards and then immediately contract to hold a single card securely,” photographs thereof, 8: “top of the inner plates are tapered to let you easily slide additional cards into the wallet;” Ex. 1009 ¶ [0041]: “This clip, when present, allows the holder to be mounted conveniently in many different places;” Babcock ¶ 773, 902.)

The technique of configuring a compact wallet with a removable clip utilizing a protrusion and hole engagement was within the realm of ordinary capabilities of a

POSITA based upon the teachings of at least Matthews. (Ex. 1009 ¶¶ [0033], [0041], FIGS. 4-5; Babcock ¶¶ 774.)

b. Reasonable Expectation of Success

A POSITA would have reasonably expected success incorporating the teachings of Matthews into Kane as described. (Babcock ¶¶ 776, 792, 800, 808.) A POSITA would have found it obvious to form a recess and hole, like that of Matthews, into a rigid plate of a compact wallet, like that of Kane, to effectuate a removably attached clip as there are a finite number of locations at which to attach the clip. (Babcock ¶¶ 781-782, 885, 886, 954, 1011-1012.) Forming the recess into a rigid plate, like that of Kane, would be a mere continuation of routine milling operations for producing the plates and thereby would not require additional machinery to manufacture and minimal additional costs. (Babcock ¶¶ 783, 887, 1013.)

Thus, by incorporating the teachings of Matthews into Kane, such a person would be applying a known technique to a known device ready for improvement to yield predictable results. (Babcock ¶¶ 781, 790, 798, 885, 910, 1011.)

2. Claim 1

a. Limitation 1[a]

To the extent that the preamble is limiting, Kane discloses the subject matter of Claim 1(a) as set forth in Section IX.A.1.a, incorporated here. (Babcock ¶¶ 749-752.)

Also, Matthews discloses that an “objective is to provide a holder with the functionality... [that] is compact... the invention generally provides a compact, convenient device designed primarily for the storage of a wallet-sized card....” (Ex. 1009 ¶¶ [0017], [0019]; Babcock ¶¶ 753-754.)

b. Limitation 1[b]

Kane discloses this limitation as set forth in Section IX.A.2.b, incorporated here. (Babcock ¶¶ 755-757.)

Also, Matthews discloses a compact card holder having a “case 1 [that] includes a front piece 2 and a back piece 3,” which may be made of aluminum and serve to sandwich credit cards therebetween.” (Ex. 1009 ¶¶ [0029], [0037], FIG. 5; Babcock ¶¶ 758-759.) A POSITA, reading Matthews, would have understood the front piece 2 and the back piece 3 to constitute the claimed “rigid plates.” (Babcock ¶¶ 758-759.)

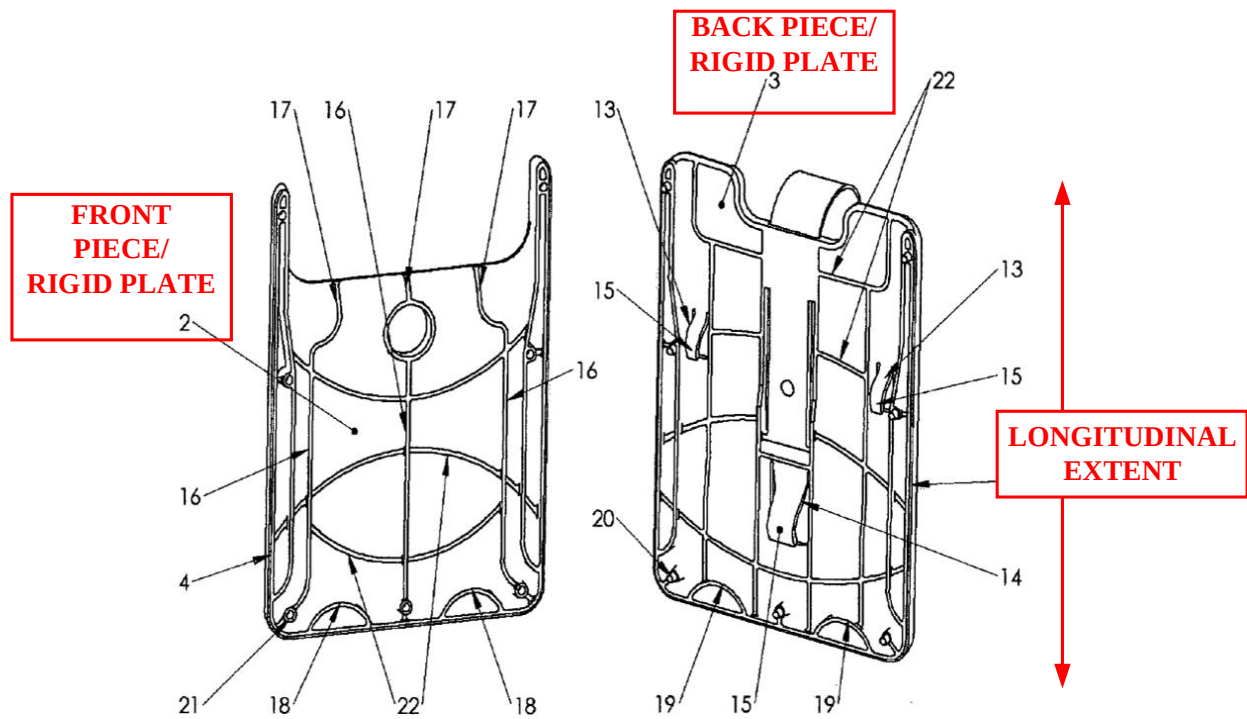


FIG 3

(Ex. 1009 FIG. 3 (*annotated*); (Babcock ¶ 759.)

c. Limitation 1[c]

Kane discloses this limitation as set forth in Section IX.A.2.c, incorporated here. (Babcock ¶¶ 761-763.)

d. Limitation 1[d]

Kane discloses this limitation as set forth in Section IX.A.2.d, incorporated here. (Babcock ¶¶ 764-766.)

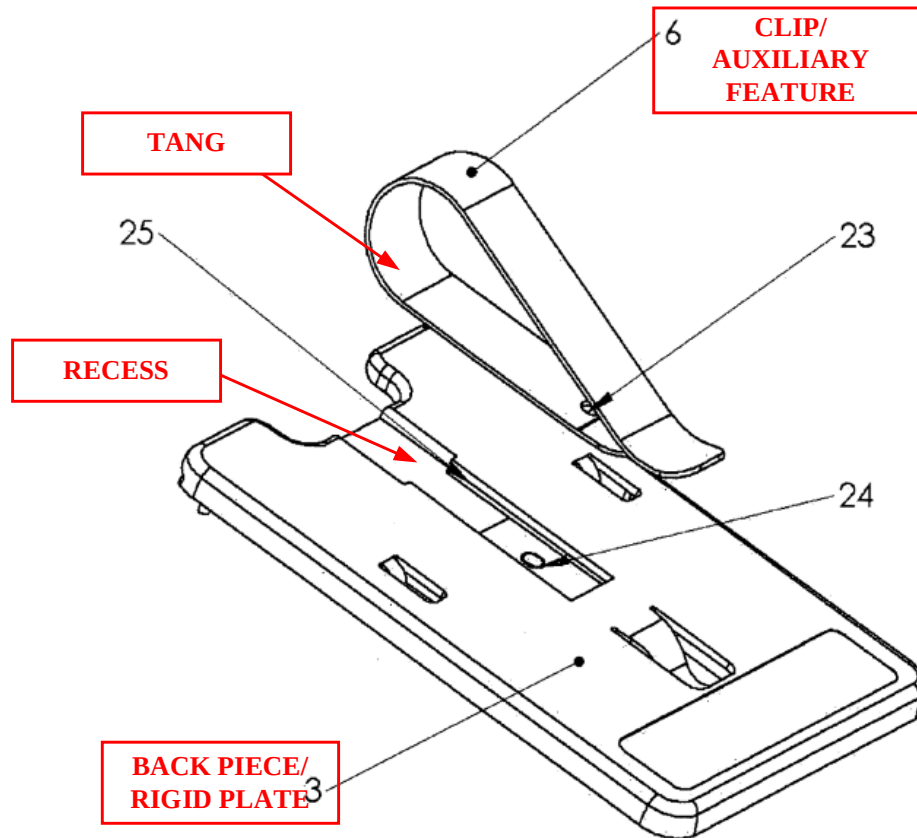
e. Limitation 1[e]

Matthew discloses “a removable clip mounted on the case;” where a POSITA, reading Matthews, would have understood the clip **6** to constitute the claimed “auxiliary feature.” (Ex. 1009 ¶¶ [0029], [0041], Abstract, Claim 2, FIGS. 1-5; Babcock ¶¶ 767-768.)

A POSITA would have been motivated to combine Kane and Matthews with a reasonable expectation of success as set forth in Section IX.C.1, incorporated here.

f. Limitation 1[f]

Matthew depicts the clip **6** (“auxiliary feature”) having a tang insertable into a recess formed inside the back piece **3** (“rigid plate”), as shown in *annotated* FIG. 4 below. (Ex. 1009 ¶ [0033], FIGS. 1-5; Babcock ¶¶ 778-779.)



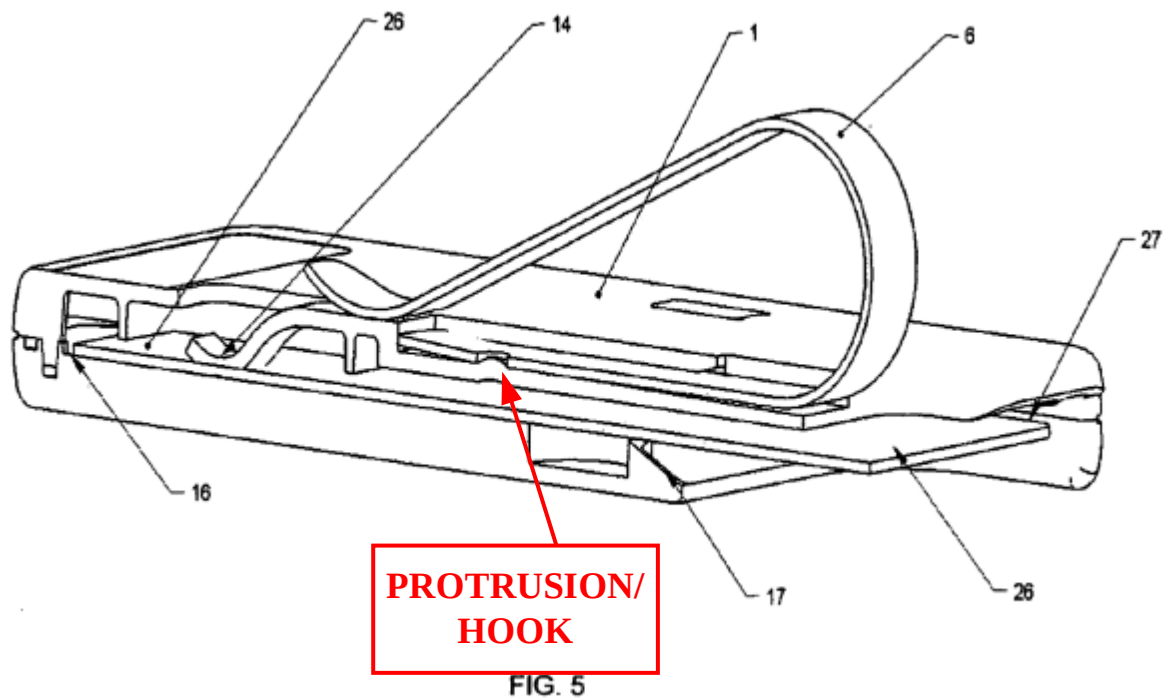
(Ex. 1009 FIG. 4 (*annotated*); (Babcock ¶ 779.)

Matthews teaches a recess, as properly construed, by disclosing a groove having a sidewall that is adjacent to a longitudinally extending groove (*e.g.*, an interior cavity for holding a card). (Babcock ¶ 780.) The recess is a surface groove that defines an indentation occurring in a surface of the back piece **3**. (*Id.*)

A POSITA would have been motivated to combine Kane and Matthews with a reasonable expectation of success as set forth in Section IX.C.1, incorporated here.

g. Limitation 1[g]

Matthew discloses “the clip is removable, as it is retained by a small post [aka protrusion **24**] on the back case part and a corresponding hole in the clip.” (Ex. 1009 ¶¶ [0033]-[0041]; (Babcock ¶ 786.)



(Ex. 1009 FIG. 5 (*annotated*); (Babcock ¶ 786.)

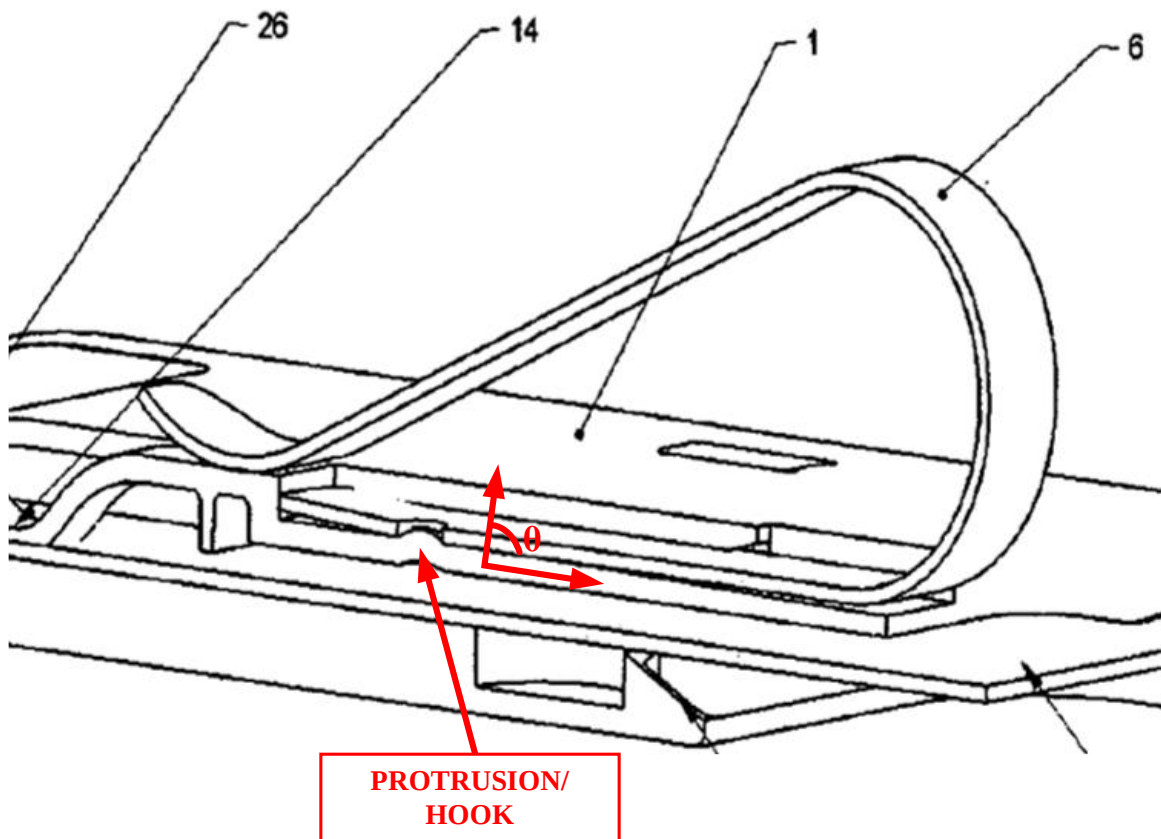
The protrusion **24**, as properly construed constitutes the claimed “hook” as it abruptly changes direction from the trunk section from which it extends to define a ledge for catching or holding. (Ex. 1009 FIG. 4-5; Babcock ¶ 787.) The protrusion **24** constitutes a curved or bent device for catching or holding. (*Id.*)

A POSITA, reading Matthews, would have understood re-locating the protrusion **24** to the tang of the clip **6** and the corresponding hole **23** to the back piece **3** to be an obvious rearrangement of parts with a reasonable, predictable expectation of success. (Babcock ¶¶ 788-789.) The protrusion **24** and corresponding hole **23** function the same as the claimed hook and undercut, whether positioned as illustrated in Matthews or as recited in the Challenged Claims. (Ex. 1001 5:29-31: “The hook **36** engages the undercut **35** to prevent inadvertent dislodgement of the auxiliary feature **30** when attached to the compact wallet **1**,” Ex. 1009 ¶¶ [0041]: “[t]his combination provides sufficient retention force to retain the clip against common loads during normal use,” [0038]: “departures can be made therefrom within the scope of the invention... to embrace any and all equivalent apparatus and procedures;” (Babcock ¶¶ 788-789.)

A POSITA would have been motivated to combine Kane and Matthews with a reasonable expectation of success as set forth in Section IX.C.1, incorporated here.

h. Limitation 1[h]

Matthews discloses the protrusion **24** (“hook”) extending an angle (θ) from the tang. (Babcock ¶ 795.)



(Ex. 1009 FIG. 5 (*magnified, annotated*); Babcock ¶ 795.)

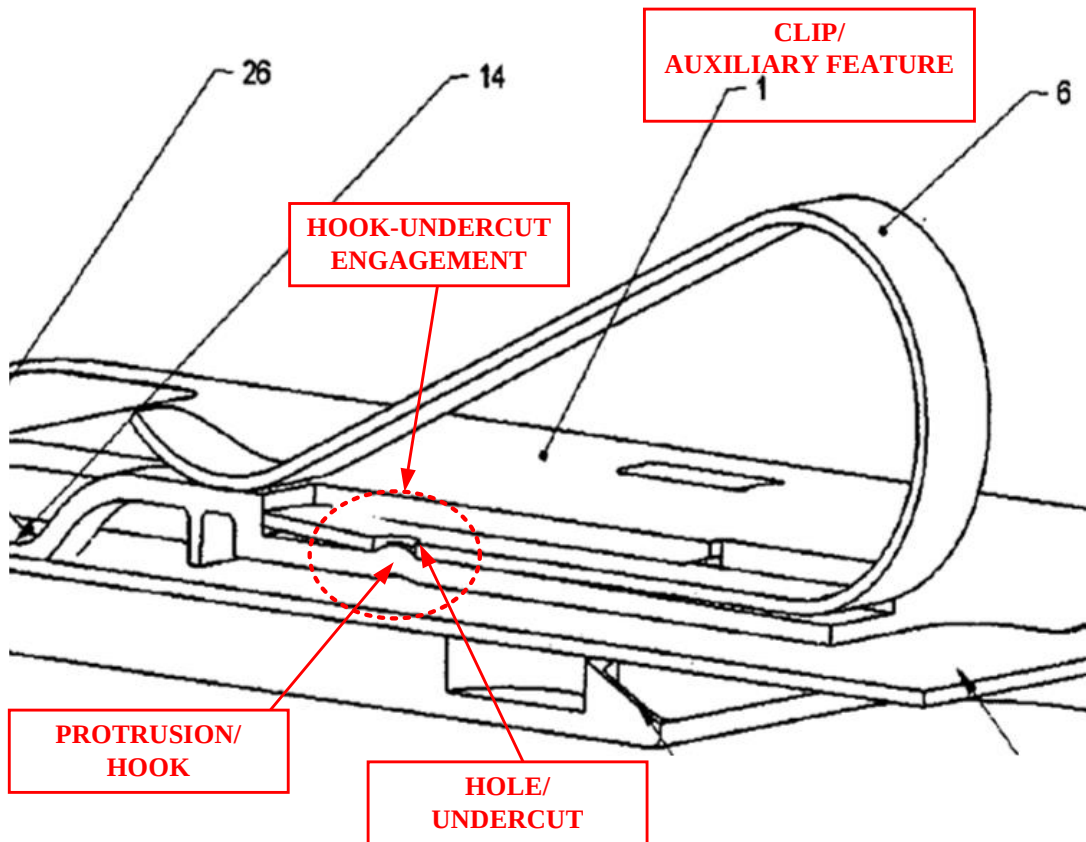
Relocating the protrusion **24** (“hook”) would result in it extending from the tang an angle in the same manner as the protrusion **24** is depicted extending angle from the back piece **3**. (Babcock ¶¶ 796-797.)

A POSITA would have been motivated to combine Kane and Matthews with a reasonable expectation of success as set forth in Section IX.C.1, incorporated here.

i. Limitation 1[i]

Matthew discloses the claimed hook and undercut engagement by describing: “the clip is removable, as it is retained by a small post on the back case

part and a corresponding hole in the clip. This combination provides sufficient retention force to retain the clip against common loads during normal use.” (Ex. 1009 ¶¶ [0033], [0041]; (Babcock ¶¶ 802-803.)



(Ex. 1009 FIG. 5 (*magnified, annotated*); Babcock ¶ 803.)

A POSITA would find relocating the hole into the recess of the back piece 3 to be an obvious rearrangement of parts amounting to a design choice that maintains the same functionality with a reasonable expectation of success, as set forth in Section IX.C.2.g, incorporated here. (Babcock ¶ 804.)

Thereby, the hole **23** constitutes, as properly construed, the claimed “undercut” as it is a cut away portion from the sides of the recess. (Babcock ¶ 805.) The hole **23** defines an underside recess that is molded into recess to define a lip or protuberance. (*Id.*)

A POSITA would have been motivated to combine Kane and Matthews with a reasonable expectation of success as set forth in Section IX.C.1, incorporated here.

j. Limitation 1[j]

Kane discloses this limitation as set forth in Section IX.A.2.j, incorporated here. (Babcock ¶¶ 810-811.)

3. Claims 2-9 and 11-13

The Kane-Matthews combination discloses all the limitations of Claim 1 as set forth in Section IX.C.2, incorporated here.

Kane discloses all the limitations of Claims 2-9 and 11-13 as set forth in Section IX.A.3 to Section IX.A.13.a of Ground 1, which are incorporated here. (Babcock ¶¶ 812-869.)

4. Claim 14

a. Limitation 14[a]

To the extent the preamble is limiting, both Kane and Matthews disclose this limitation as set forth in Section IX.C.2.a, incorporated here. (Babcock ¶¶ 870-871.)

b. Limitation 14[b]

Kane discloses this limitation as set forth in Section IX.A.14.b., incorporated here. (Babcock ¶¶ 872-875.)

c. Limitation 14[c]

Kane discloses this limitation as set forth in Section IX.A.14.c., incorporated here. (Babcock ¶¶ 876-878.)

d. Limitation 14[d]

Kane discloses this limitation as set forth in Section IX.A.14.d., incorporated here. (Babcock ¶¶ 879-881.)

e. Limitation 14[e]

Matthews discloses a recess that meets this limitation as set forth in Section IX.C.2.f, incorporated here. (Babcock ¶¶ 882-884.)

f. Limitation 14[f]

Matthews discloses this limitation as set forth in Sections IX.C.2.f and IX.C.2.e, which are incorporated here. (Babcock ¶¶ 891-894.)

g. Limitation 14[g]

Matthews discloses a protrusion **24** (“hook”) that meets this limitation as set forth in Section IX.C.2.g, incorporated here. (Babcock ¶¶ 897-899.)

Matthews discloses a hole **23** (“undercut”) that meets this limitation as set forth in Section IX.C.2.i, incorporated here. (*Id.*)

Matthews discloses the clip 6 (“auxiliary feature”) removably positioned in the recess, which a POSITA would be motivated to form in a rigid plate, like that of Kane (*see* Section IX.C.1, incorporated here) that meets this limitation as set forth in Sections IX.C.2.e and IX.C.2.f, which are incorporated here. (Babcock ¶¶ 898, 900.)

h. Limitation 14[h]

Matthews discloses this limitation as set forth in Section IX.C.2.h, incorporated here. (Babcock ¶¶ 906-909.)

i. Limitation 14[i]

Kane discloses this limitation as set forth in Section IX.A.1.j., incorporated here. (Babcock ¶¶ 914-916.)

5. Claims 15-18

The Kane-Matthews combination discloses all the limitations of Claim 14 as set forth in Section IX.C.4, incorporated here.

Kane discloses all the limitations of Claims 15-18 as set forth in Section IX.A.15 to Section IX.A.18 of Ground 1, which are incorporated here. (Babcock ¶¶ 917-936.)

6. Claim 19

a. Limitation 19[a]

To the extent the preamble is limiting, Kane discloses this limitation as set forth in Section IX.A.19.a, incorporated here. (Babcock ¶¶ 937-940.)

Also, Matthews discloses “a compact, convenient device designed primarily for the storage of a wallet-sized card,” having a removable clip. (Ex. 1009 ¶ [0019], Abstract, FIGS. 1-5; Babcock ¶¶ 937-940.)

b. Limitation 19[b]

Kane discloses this limitation as set forth in Section IX.A.14.b, incorporated here. (Babcock ¶¶ 941-943.)

c. Limitation 19[c]

Kane discloses this limitation as set forth in Section IX.A.19.c, incorporated here. (Babcock ¶¶ 944-946.)

d. Limitation 19[d]

Kane discloses this limitation as set forth in Section IX.A.14.d, incorporated here. (Babcock ¶¶ 947-949.)

e. Limitation 19[e]

Matthews discloses a recess as set forth in Section IX.C.2.f, incorporated here. (Babcock ¶¶ 952-953.)

A POSITA would understand “at least one groove” to be least one groove of the grooves, and the “elastic band” to be the “at least one encircling elastic band.” (Babcock ¶ 951.)

A POSITA would be motivated to form a recess, like that of Matthews, in addition to the integrated elastic track (“groove”) and outbound the elastic band of a compact wallet, as disclosed by Kane, to configure the wallet with a removably attachable clip (“auxiliary feature”) without interfering with the function of the depression (“recess”) (*e.g.*, to capture the clip) or the elastic band (*e.g.*, to provide the wallet with elastic volume). (Babcock ¶¶ 954-955.)

Moreover, forming a recess, like that of Matthews, outbound of a compact wallet’s elastic band, like that of Kane, would be an obvious configuration from a finite number of identified, predictable positions, with a reasonable expectation of success (*e.g.*, there are finite number of locations in the rigid plate to position the depression without interfering in the operation of the depression and/or the elastic band). (Babcock ¶ 956.)

f. Limitation 19[f]

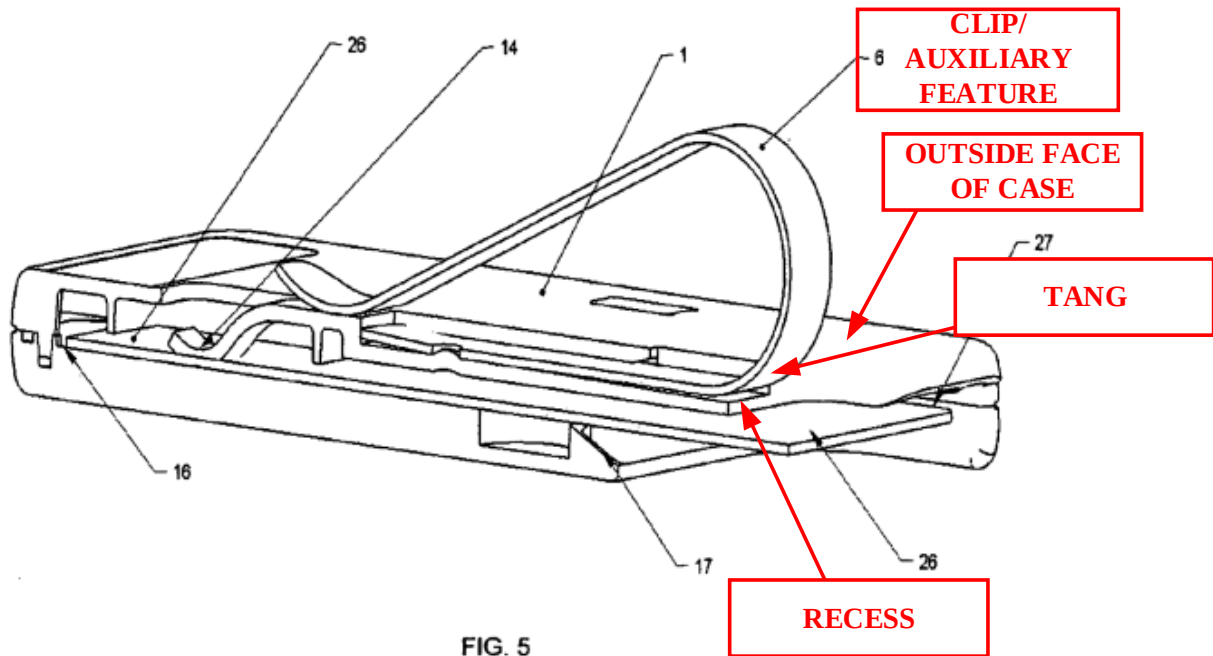
Kane discloses this limitation as set forth in Section IX.A.19.f, incorporated here. (Babcock ¶¶ 962-963.)

Matthews discloses this limitation as set forth in Section IX.C.14.f, incorporated here. (Babcock ¶¶ 959, 961.)

g. Limitation 19[g]

Matthews discloses this limitation as set forth in Section IX.C.14.f, incorporated here. (Babcock ¶¶ 966-967.)

Incorporating the teachings of Matthews into Kane, the clip (“auxiliary feature”) would be rendered available to an outside face of the wallet, and thereby the rigid plate, in accordance with the teachings of Matthews, as shown in *annotated* FIG. 5 below. (Babcock ¶ 966, 969.)



(Ex. 1009 FIG. 5 (*annotated*); Babcock ¶ 966.)

h. Limitation 19[h]

A POSITA would find it obvious, reading Matthews, to selectively remove a removably attached clip (“first auxiliary feature”), like that of Matthews; as doing

so would be an exercise of the clip's intended function (*i.e.*, the clip is removably attached so that it can be removed). (Ex. 1009 ¶ [0041]: "[t]his design allows for secure retention of the clip but also for user assisted removal;" Babcock ¶¶ 972-974.)

A POSITA would have been motivated to combine Kane and Matthews with a reasonable expectation of success as set forth in Section IX.C.1, incorporated here.

i. Limitation 19[i]

Matthews discloses this limitation as set forth above in Section IX.C.19.f, which is incorporated here. (Babcock ¶ 978-979.) A POSITA would be motivated to exchange an initial clip ("first auxiliary feature") with a substitute clip ("second auxiliary feature") to personalize the wallet (*e.g.*, choose a different color clip), adapt the wallet to a given use preference, and/or perform a maintenance/repair operation (*e.g.*, replace a damaged clip), as suggested by Kane. (Ex. 1006 3: "turn the wallet into a 'system'... to replace the elastic and exchange the outer plates for greater personalization," 15-16: "[o]ur biggest challenge is conveying our idea and creating a product that is versatile enough to suit a wide range of people and preferences; Babcock ¶ 980.)

In doing so, providing the substitute clip ("second auxiliary feature") would be a mere duplication of parts and assembly steps without any new or unexpected results. (Babcock ¶¶ 981-982.)

j. Limitation 19[j]

Matthews discloses this limitation as set forth above in Section IX.C.19.g, incorporated here. (Babcock ¶¶ 985, 987.)

A POSITA would be motivated to exchange an initial clip (“first auxiliary feature”) with a substitute clip (“second auxiliary feature”) as set forth above in Section IX.C.19.i, incorporated here. (Babcock ¶ 986.) In doing so, inserting the substitute clip (“second auxiliary feature”) into the depression (“recession”), like that of Matthews, would constitute an obvious duplication of parts and assembly steps without any new or unexpected results. (Babcock ¶¶ 988-989.)

k. Limitation 19[k]

Matthews discloses this limitation as set forth in Section IX.C.14.g, incorporated here. (Babcock ¶¶ 992-1001.)

l. Limitation 19[l]

Matthews discloses this limitation as set forth in Section IX.C.2.h, incorporated here. (Babcock ¶¶ 1002-1008.)

m. Limitation 19[m]

Matthews discloses this limitation as set forth in Section IX.C.2.f, incorporated here. (Babcock ¶¶ 1009-1015.)

n. Limitation 19[n]

Kane discloses this limitation as set forth in Section IX.A.19.n, incorporated here. (Babcock ¶¶ 1016-1018.)

7. Claim 20

The discussion of Claim 19 is incorporated here.

a. Limitation 20[a]

Matthews discloses a hole **23** (“undercut”), the rearrangement of which into the recession would be an obvious design choice as set forth in Section IX.C.2.i, incorporated here. (Babcock ¶¶ 1020-1021.)

A POSITA would understand the tang of this limitation to be the tang of the first auxiliary feature. (Babcock ¶ 1021-1022.)

Matthews discloses a protrusion **24** (“hook”), the rearrangement of which to the tang of the clip **6** would be an obvious design choice as set forth in Section IX.C.2.g, incorporated here. (Babcock ¶ 1023-1024.) A POSITA would have found it obvious to utilize an initial clip (“first auxiliary clip”) with a protrusion (“hook”) and hole (“undercut”) same as the substitute clip (“second auxiliary clip”) as doing so would be a mere duplication parts without any new or unexpected results. (Babcock ¶ 1025.)

b. Limitation 20[b]

A POSITA would understand “the hook” to be the hook of the first auxiliary feature. (Babcock ¶ 1028.)

Matthews discloses a protrusion **24** (“hook”) and hole **23** (“undercut”) engagement as set forth in Section IX.C.2.i, incorporated here. A POSITA would have found it obvious to utilize the same hook and undercut engagement for both an initial clip (“first auxiliary feature”) and substitute clip (“second auxiliary feature”) as doing so would constitute a mere duplication of parts and assembly steps without any new or unexpected results. (Babcock ¶¶ 1029-1030.)

8. Claim 21

The discussion of Claim 20 is incorporated here.

a. Limitation 21[a]

Kane discloses this limitation as set forth in Section IX.A.21.a, incorporated here. (Babcock ¶¶ 1031-1035.)

X. SECONDARY CONSIDERATIONS

Petitioner is not required to predict which arguments PO might make, if any, about secondary considerations. *Cf. Petroleum Geo-Services Inc. v. Western Geco LLC*, IPR2014-1477, Paper No. 18 32 (P.T.A.B. March 17, 215) (finding “at the time of filing the present Petition, no evidence of secondary indicia of non-obviousness

in the record of this proceeding” and “the evidence of secondary indicia of non-obviousness must be first developed in this proceeding by [PO]”).

Petitioner is unaware of secondary considerations, including commercial success and industry praise, purportedly attributed to the claimed invention, rather than the features of the prior art.

Petitioner reserves the right to supplement its positions regarding secondary considerations to respond to PO’s potential allegations of non-obviousness.

XI. TRIAL SHOULD BE INSTITUTED

A. The *Fintiv* Factors Weigh Against Discretionary Denial

The *Fintiv* factors as a whole favor institution. *See Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper No. 11 (P.T.A.B. Mar. 20, 2020). This Petition presents compelling evidence of unpatentability. With respect to the concurrent proceeding, Petitioner agrees to a *Sotera*-like stipulation and will not pursue the same grounds or any grounds that have could have been reasonably raised.

The first *Fintiv* factor favors institution. Petitioner plans to promptly seek a stay after filing this IPR, which challenges at least the asserted claims in the related litigation.

The second *Fintiv* factor is neutral. The Court has not set a trial date. The median time-to-trial in the District Court of Colorado is 28.9 months. (Ex. 1020

(time-to-trial for the time period of December 2022-2023).) Thus, any trial in the related litigation likely will occur on or about the same time the Board’s likely final written decision. *See Crowdstrike, Inc. v. Webroot, Inc.*, No. IPR2023-00126, Paper No. 9 at 17 (P.T.A.B. May 5, 2023) (the Board declining to exercise discretion under 35 U.S.C. § 314(a) even when the trial date was scheduled for seven months before the statutory date for the final written decision).

The third *Fintiv* factor weighs in favor of institution. While the Markman hearing is scheduled for early April 2024 and the parties have completed some work, for example, serving preliminary infringement and invalidity contentions, responding to requests to each other’s documents and interrogatories, and exchanged proposed claim terms for claim construction, fact and expert discovery is not over and much remains to be completed in advance of trial, as evidenced by the scheduling order (Ex. 1019). The Court’s investment in the related litigation is minimal as the parties have not submitted briefing of any dispositive issue, nor has the District Court made any determination on the merits. *See PEAG LLC v. VARTA Microbattery Gmbh*, No. IPR2020-01212, Paper No. 8 at 17 (P.T.A.B. Jan. 6, 2021) (the Board finding that the District Court had not issued any substantive orders although the parties have completed “some work”, and that no briefing on any dispositive issue, or District Court determination on the merits have been made); *also see Crowdstrike*, No. IPR2023-00126, Paper No. 9 at 10 (the Board finding that

while a Markman hearing had recently taken place and fact discovery has been ongoing “[t]he parties have not otherwise invested a great deal in the related litigation”). Petitioner has filed this Petition before the one-year petition window. Because the Petitioner has acted diligently, and the parties and courts investment has been minimal, discretionary denial is not warranted. *See Vudu, Inc. v. Ideahub, Inc.*, No. IPR2020-01688, Paper No. 16 at 12-13 (P.T.A.B. Apr. 19, 2021) .

The fourth *Fintiv* factors strongly weighs against denial. This Petition challenges all claims asserted in the related litigations (including those PO has asserted against others). Institution here promotes efficiency, because this Petition is the only venue in which certain invalidity challenges will be adjudicated.

Moreover, if trial is instituted, Petitioner stipulates that it will not argue the invalidity of the asserted claims in the case before the District Court on the same grounds as in the Petition or on any grounds that could have been reasonably raised in the Petition. As the Board found in *Sotera*, this stipulation strongly weighs in favor of not exercising discretion under 35 U.S.C. § 314(a). *See Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, Paper No. 12 at 18-19 (P.T.A.B. Dec. 1, 2020) (precedential as to § II.A); Interim Procedure Memorandum issued by Director Vidal on June 21, 2022 (“the PTAB will not deny institution of an IPR or PGR under *Fintiv*... (iii) where a petitioner stipulates not to pursue in a parallel district court

proceeding the same grounds as the petition or any grounds that could have reasonably been raised in the petition.”)

The fifth *Fintiv* factor weighs against denial. Petitioner and PO are the same parties in the district court case. The ’808 Patent was previously found to be anticipated by a public sale in *Mosaic Brands*, but that case was settled without a final verdict, and Petitioner is not related to the Defendant in *Mosaic Brands*, and is relying on different grounds for invalidity than those in that proceeding. Other parallel court proceedings involving the ’808 Patent are ongoing, early in their infancy, and Petitioner is not related to those defendants; initiating this petition would not duplicate previous efforts.

The sixth *Fintiv* factor weighs strongly against denial. The merits are compelling here. Moreover, because there are numerous separate litigations proceeding in different courts (*see* Section II.B), it would be more efficient for the PTAB to adjudicate these challenges.

Taken together, *Fintiv* factors favor institution, and that discretionary denial of this Petition would be neither appropriate nor equitable under 35 U.S.C. § 314(a).

B. The Circumstances Weigh Against Discretionary Denial

This is the only IPR petition filed against the Challenged Claims by Petitioner and is not a serial petition under any of the factors in *General Plastic. General Plastic Indus. Co., Ltd. v. Canon Kabushiki*, No. IPR2016-01357, Paper No. 19

(P.T.A.B. Sept. 6, 2017). The petitioner's grounds rely on prior art not previously considered or applied by the Office, including the Examiner, and do not present the same or substantially the same arguments presented earlier to the Office. The Board should decline to exercise its discretion to deny review under 35 U.S.C. § 325(d).

Beckley, Pelz, and Matthews are not cumulative prior art references because these references were never considered by the Examiner during prosecution, and the Examiner never considered the teachings of these references in addressing the shortcomings of Kane (*e.g.*, see NOA identifying the recess/hook/undercut combination as a deficiency in Kane; and Beckley, Pelz, and Matthews addresses said deficiency). Nor are Pelz and Matthews cumulative prior art references in view of the *Shenzhen* IPR. Pelz and Matthews are not presented in the *Shenzhen* IPR, and these prior art references disclose different structures and/or functions than the references presented in that IPR. See *Oticon Medical AB v. Cochlear Ltd.*, No. IPR2019-00975, Paper 15 at 10-20 (P.T.A.B. Oct. 16, 2019).

While the prior art of Ground 1 has recently been presented to the Board in the *Shenzhen* IPR for which no institution decision has been rendered; said IPR was filed by a different, entirely unrelated petitioner. See *Frontier Therapeutics, LLC v. Medac Gesellschaft Für Klinische Spezialpräparate mbH*, No. IPR2016-00649, Paper 10 at 7 (P.T.A.B. Sept. 1, 2016).

Petitioner is not expected to anticipate 35 U.S.C. § 325(d) arguments that can be raised by PO and reserves its right to rebut any such arguments. *See Google LLC v. Valtrus Innovations Limited*, No. IPR2022-01197, Paper 12 at 5 (P.T.A.B. Mar. 29, 2023).

XII. CONCLUSION

For the above reasons, Claims 1-9 and 11-21 of the '808 Patent should be found unpatentable, and Petitioner requests review of these claims.

Respectfully submitted,

Dated: March 15, 2024

/s/ Jacob Busch
Jacob Busch (Reg. No. 70,830)
Lead Counsel for Petitioner

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I hereby certify that the foregoing “Petition for *Inter Partes* Review of U.S. Patent No. 10,791,808” contains 13,933 words as measured by the word processing software used to prepare the document, excluding the parts of the document exempted by 37 C.F.R. § 42.24(a)(1).

/s/ Jacob Busch
Jacob M. Busch (Reg. No. 70,830)
Lead Counsel for Petitioner

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned “Petition for *Inter Partes* Review of U.S. Patent No. 10,791,808” including its supporting evidence (Exhibits 1001-1021), was served on March 15, 2024, upon the following two addresses via FedEx:

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MOUNTAIN VOYAGE

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Jacob M. Busch

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