

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

Case IPR2024-00692
Patent 10,791,808

PATENT OWNER'S PRELIMINARY RESPONSE

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
Ex. 2001	Declaration of Gina A. Johnson in Support of Motion for Admission <i>Pro Hac Vice</i>
Ex. 2002	Final Initial Determination in ITC Investigation No. 337-TA-1355 dated March 15, 2024 (Public Version)
Ex. 2003	Declaration of Daniel Kane in ITC Investigation No. 337-TA-1355 dated September 25, 2023 (Redacted)
Ex. 2004	Mountain Voyage Final Invalidity Contentions in District of Colorado Case No. 23-cv-00407, dated June 11, 2024.
Ex. 2005	U.S. Patent No. 5,038,985 to Chapin.
Ex. 2006	U.S. Patent No. 7,334,616 to Kaminski
Ex. 2007	Non-Confidential Excerpts from Plaintiff The Ridge Wallet LLC's Responses and Objections to Defendant 2985, LLC d/b/a Mountain Voyage Company LLC's First Set of Interrogatories dated January 19, 2024

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I. INTRODUCTION

Petitioner 2985, LLC d/b/a Mountain Voyage Co. (“Petitioner” or “Mountain Voyage”) filed the Petition for *Inter Partes* Review (“Petition,” Paper 1) on the last day it was statutorily permitted to do so. It is therefore unsurprising that the Petition is deficient, and review should not be instituted, both because the Petition fails to meet the burden established by 35 U.S.C. § 314, and because it seeks to re-hash old arguments and thus deserves discretionary denial under 35 U.S.C. § 325(d). It also flaunts the Board’s rules regarding word count limits and incorporation by reference. 37 C.F.R. § 42.24.

U.S. Patent No. 10,791,808 (the “‘808 Patent”) is directed to a novel, non-obvious, modular money clip design that was an improvement over Applicant’s own prior work. The prior work, which the ‘808 Patent meaningfully improved, is the wallet described in the Kickstarter campaign the Petition refers to as “Kane” *See* Ex. 1006. It is a combination of Kane and Patent Owner The Ridge Wallet LLC’s (“Patent Owner” or “Ridge”) current design (as described in the ‘808 Patent) that has permitted Ridge to create the category for compact wallets having the silhouette the consuming public now universally associates with Ridge.

The modern version of the product described in Kane—the version described and claimed in the ‘808 Patent—launched Ridge from a humble, self-funded startup to a sophisticated company with domestic activities satisfying the

domestic industry requirement at the ITC (*See* Ex. 2002) and substantial yearly revenue derived from its best-selling wallets.

The Examiner was very well aware of the prior art and arguments that the Petitioner relies on here during prosecution of the ‘808 Patent. In particular, the Applicant submitted the Kane reference—the sole primary reference in each Ground in the Petition—during prosecution of the ‘808 Patent. The Examiner not only considered Kane, but used it to reject the claims. Ex. 1004 at 70. And of course the ‘808 Patent issued over those rejections due to the novel features added following the rejection over Kane.

The Petition itself contains only a cursory treatment of the issues of obviousness, and in particular with regard to the issues of claim construction and combinability. The massive amounts of incorporated-by-reference analysis from Petitioner’s expert, Mr. Michael Babcock, should be excluded and not considered. Because the Petition does not establish a reasonably likelihood of success as to any claim by virtue of failing to establish that any of the relied-on combinations is proper, the Petition should be denied on the merits. 35 U.S.C. § 314.

As noted, the concepts in the ‘808 Patent improved on the art, including Patent Owner’s own first-generation designs, in a meaningful and patentable way. Unsurprisingly given the nascent market when Patent Owner created its first version of the product, examination of the ‘808 Patent confirmed that this very

feature is patentable over precisely the prior art presented in the Petition. The putatively new secondary references (U.S. Patent Publication No. 2014/0060712 to Beckley (“Beckley”), Ex. 1007; U.S. Patent No. 2,326,558 to Pelz (“Pelz”), Ex. 1008; and U.S. Patent Publication No. 2009/0134223 to Matthews (“Mathews”), Ex. 1009) are redundant of references considered during examination and found not to teach the patentable features, and as such do not permit satisfy Petitioner’s burden under 35 U.S.C. § 314.

Beyond the patentable nature of the claims of the ‘808 Patent, the Petition should be discretionarily denied under 35 U.S.C. § 325(d) because it is a last-ditch effort to present an invalidity defense that merely rehashes arguments already considered (and soundly rejected) by the Examiner. The Board should not alter the Examiner’s (correct) prior determination that the auxiliary feature aspects of the claims of the ‘808 Patent render the claims patentably distinct over that same art. And it especially should not do where, as here, the Petitioner has essentially presented almost 75,000 words to outline its arguments in support of three (3) proposed invalidity Grounds.

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

A. Patent Owner’s Creation of the Compact Wallet Market Segment

In 2013, sole ‘808 Patent inventor Daniel Kane came up with the first

iteration of what would become the iconic Ridge Wallet. Ex. 2003 at Q1-Q3, Q95.

Mr. Kane wanted to avoid the bulk of a traditional folding wallet while still providing access to cards, IDs, and the like. *Id.* at Q4. So he came up with a way to integrate elastic into the overall exoskeleton and provide a secure storage while enabling a consumer to carry a wallet that took up as little space as possible. *Id.*

Initially, the Ridge Wallet had a money clip, but it was integrated into the face plates of the Ridge Wallet. *Id.* at Q5-Q6. That is, each plate was a single, integrated part with the money clip. *Id.* That meant that the clip could not be removed or replaced without replacing an entire plate from the wallet. *Id.* It is this product that is described in the reference described in the Petition as “Kane.”

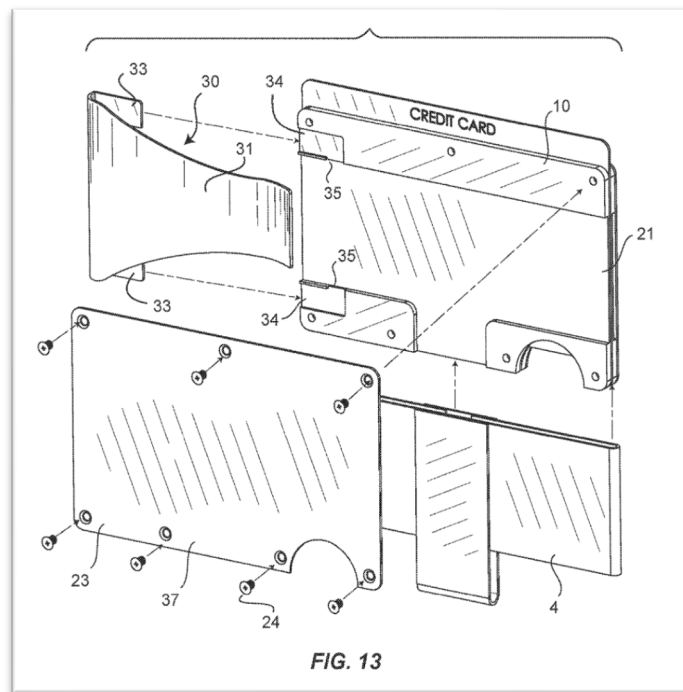
Mr. Kane continued to work to refine the technology following the Kickstarter activity. An important development in Patent Owner’s business was the invention of the technology that was disclosed in the ‘808 Patent. Ex. 2003 at Q7-Q12. In particular, Mr. Kane realized that while the money clip was a great feature, it was not perfect because welding the money clip to the outside of the wallet, or making it integrated into the outermost panel, was just not something that the customers loved. *Id.* at Q16. The product development process led to an invention in which the inner plates were redesigned to accommodate a removable money clip. *Id.* In the new design, the money clip in the new design was sandwiched between the outer plate and the inner plate, and there were interlocking

structures between the inner plate and the clip that would prevent the user from accidentally pulling the clip out of the wallet. *Id.*

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

B. The ‘808 Patent and Its Claims

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



Ex. 1001 at Fig. 13. In the parlance of the '808 Patent, there are a pair of structures marked as 33 that sit inside a portion 34 and engage a wall 35 so that when the wallet is assembled, the money clip cannot be pulled out of the wallet.

Ex. 1001 at 5:10-31. If, however, the user wishes to remove and/or replace the money clip, the screws can be removed and the money clip taken out of the wallet and replaced as is desired. *Id.*

In this manner, the '808 Patent provides for a compact wallet with a removable and re-attachable (i.e., modular) auxiliary feature in the form of a money clip. It does so while minimizing both the silhouette of the wallet (it is not much larger than an ANSI standard credit card) and the thickness of the wallet, while permitting the user to choose how many cards to carry. Without the

inventions described and claimed in the '808 Patent, users would be stuck with prior art solutions (like Kane) that did not serve these purposes.

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

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

Ex. 1001 at Claim 1 (emphasis added).

Claim 14 recites the following:

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

Ex. 1001 at Claim 14 (emphasis added).

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

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

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

removing, selectively, the first auxiliary feature;

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

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

Ex. 1001 at Claim 19 (emphasis added).

Accordingly, each of the challenged claims recites the feature that the Examiner has already found is lacking in the primary references used in the various Grounds in the Petition: Kane. Petition at 11; *see also* Ex. 1004 at 70 (rejection over Kane), 157 (Notice of Allowance).

III. PROSECUTION HISTORY SUMMARY

The application that led to the '808 Patent was filed on February 1, 2017, as a continuation in part of U.S. Application Serial No. 14/706,019. Ex. 1004 at 50.

During prosecution, the Examiner rejected the pending independent claims as obvious based on U.S. Patent No. 5,952,637 to Strunk in view of U.S. Patent No. 9,125,464 to Minn et al. or U.S. Patent No. 1,525,745 to Keefer. Ex. 1004 at 66. He also rejected the pending independent claims over U.S. Patent No.

D716,043 to Wilk in view of U.S. Patent No. 5,944,080 to Podwika. Ex. 1004 at 66-67. He rejected the pending independent claims as being obvious over Wilk in view of U.S. Patent No. 7,527,081 to Coates et al. Ex. 1004 at 67-68. He also rejected the pending independent claims as anticipated by and/or obvious in view of U.S. Patent No. 2,322,461 to Mariano. Ex. 1004 at 68-69. He rejected the pending independent claims as obvious over Minn in view of Coates and Podwika. Ex. 1004 at 69-70. Finally, he rejected the pending claims over the Kickstarter pages the Petition refers to as “Kane.” Ex. 1004 at 70.

In response, the Applicant added language to each pending claim that required an auxiliary feature removably attachable to the wallet (and the associated structural elements of the wallet itself). Ex. 1004 at 146-150. The Applicant also explained that NONE of the grounds of rejection included these elements, thus overcoming each of the prior rejections. Ex. 1004 at 134-145.

Of particular relevance here, the Applicant explained that Kane was deficient for lacking those modularity-enabling elements. Ex. 1004 at 143-144. Thus, the Applicant’s remarks explained why the primary reference in EACH of the Petition’s grounds was deficient. Petition at 11.

Responsive to Applicant’s arguments, and acknowledging the patentability of the claims over Kane, the Examiner allowed the claims on August 31, 2020. Ex. 1004 at 156-157. The Examiner in so doing noted that the prior art of record

(including Kane) did “not have the limitation of the recess having an undercut operable to engage a hook of the tang.” Ex. 1004 at 157.

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

IV. ARGUMENTS REGARDING CRITICAL DATE

Petitioner makes a series of arguments about the alleged critical date. Petition at 6. Petitioner, however, notes that “all prior art relied upon herein predates even the earliest alleged priority date of the ’808 Patent by more than a year “ Petition at 6. Because Petitioner admits that the critical date determination does not affect whether any of the submitted prior art is actually prior art, Patent Owner contends that the Board need not weigh in on the critical date at this time.

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

For purposes of this Preliminary Response only, Patent Owner does not dispute Petitioner’s proffered identification of a POSITA’s skill level. *See* Petition at 10. Petitioner does not agree that this proffered level of skill in the art is either the legally correct one to apply at trial in the District of Colorado, nor that it is the same as any of the proposed standards in other proceedings involving the ’808 Patent (e.g., in other IPR proceedings involving the ’808 Patent).

VI. CLAIM CONSTRUCTION

Petitioner offers arguments under a pair of alternate constructions for each of the following claim terms: “recess,” “hook,” and “undercut.” Petition at 13-14. However, for each term, Petitioner proposes to use either the construction it advanced (unsuccessfully) in the case between Petitioner and Patent Owner in the District of Colorado (Case No. 23-cv-00407), or an alternate construction not before the District of Colorado (and never proposed by any party in connection with the ‘808 Patent). Ex. 1023.

For example, for the word “recess,” Petitioner’s alternate construction is “a surface groove or recession;” the District of Colorado construed that term as “plain and ordinary meaning.” Petition at 13; Ex. 1023 at 12. Petitioner’s alternate construction of “hook” is “a curved or bent device for catching or holding,” but the District of Colorado construed that term as “plain and ordinary meaning.” Petition at 14; Ex. 1023 at 14. And Petitioner’s alternate construction of “undercut” is “an underside recess that is either cut or molded into an object to at least partially define a lip or protuberance,” while the District of Colorado construed that term to have its plain and ordinary meaning. Petition at 14; Ex. 1023 at 15.

In each instance, Petitioner presented two constructions to the Board: Its proposed district court construction (which in all instances were soundly rejected in Colorado), and some other, alternate, construction that was never advocated to

the District of Colorado and of course was not adopted by the District of Colorado. Notably, Petitioner does not provide any rationale whatsoever in support of either construction. It instead incorporates by references its entire opening claim construction brief (Ex. 1015) and several paragraphs from its expert, Mr. Babcock, without further explanation. Petition at 13 (incorporating Ex. 1015; Babcock ¶¶ 78-82 for the term “recess”), Petition at 14 (incorporating Ex. 1015 14-15; Babcock ¶¶ 84-88 for the term “hook); Petition at 14 (incorporating Ex. 1015 14-15; Babcock ¶¶ 84-88 for the term “undercut”).

35 U.S.C. § 314 provides that *inter partes* review may not be instituted unless the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 37 C.F.R. § 42.104 sets forth the requirements for a compliant Petition. In particular, 37 C.F.R. § 42.104(b)(3) requires that a Petition must set forth “[h]ow the challenged claim is to be construed,” and 37 C.F.R. § 42.104(b)(4) requires that a Petition must explain “[h]ow the construed claim is unpatentable under the statutory grounds identified...”

The Board has previously held that where a petitioner does not explain how to reconcile inconsistencies between litigation claim construction positions and IPR claim construction positions, these sections of the rules are not satisfied and denial is appropriate under 35 U.S.C. § 314. *Orthopediatrics Corp. v. K2M, Inc.*,

IPR2018-01546, Paper 10 at 10-12 (PTAB Feb. 14, 2019). Specifically, the Board panel in *Orthopediatrics* explained:

[O]ur rules place an affirmative burden on petitioners to “set forth:...How the challenged claim is to be construed.” *Medicines Co. v. Mylan, Inc.*, 853 F.3d 1296, 1308 (Fed. Cir. 2017); 37 C.F.R. § 42.104(b)(3). This burden continues by requiring petitioners to adequately explain “[h]ow the construed claim is unpatentable.” 37 C.F.R. § 42.104(b)(4) (emphasis added). As explained below, the Petition fails to identify how the challenged claims are to be construed and applied to the prior art, and Petitioner also takes conflicting positions between this proceeding and the related district court litigation.

Id. at 10-11.

Patent Owner submits that Petitioner’s inconsistent positions (and, worse, Petitioner’s failure to address the same) warrant denial of the Petition. Petitioner does not provide the Board with any guidance whatsoever in how to reconcile the fact that the District of Colorado construed the claims in a proceeding in which Mountain Voyage was involved in a way not even explained to the Board. Particularly because the Petitioner here articulates different, third constructions of each of the three terms (“hook,” “recess,” and “undercut”), The Petition does not satisfy 37 C.F.R. § 42.104(b)(3)-(4) and should be denied.

In addition, the 2019 Consolidated Trial Practice Guide (“CTPG”) describes what is required of the Petitioner in a grantable petition for *inter partes* review:

If a petitioner believes that a claim term requires an express construction, the petitioner **must** include a statement identifying a

proposed construction of the particular term and where the intrinsic and/or extrinsic evidence supports that meaning.

CTPG at 44. This is not permissive language; where, as here, Petitioner wishes the Board to adopt an express construction, it must do something to provide support for that express construction. And even if the Board is inclined to give Petitioner the benefit of the doubt, and consider the arguments in its opening claim construction brief in a parallel litigation (the Board should not), it is notable that Petitioner did NOT advocate for its alternate constructions of the terms “hook,” “recess,” and “undercut” in the District of Colorado. Instead, Petitioner proposed its primary, narrow constructions, and Patent Owner proposed “plain and ordinary meaning.” Ex. 1015. Thus, Petitioner has provided the Board with no rationale whatsoever to adopt its alternate constructions, and the District of Colorado has already explained that Petitioner’s primary constructions are erroneous as a matter of law. Ex. 1023.

Petitioner has flatly failed to do what the CTPG requires, and for this additional reason has failed to meet its burden to present a grantable petition under 35 U.S.C. § 314.

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

When Mr. Babcock’s overlength declaration is properly excised from the record, and assuming the Board is nevertheless willing to consider the Petition

without that evidence, the Petition fails to articulate a proper rationale for obviousness under Board and Federal Circuit precedent. As is often the case, the Petitioner here has advocated that certain mechanical features from one device could be imparted on another device so as to result in the claims of the ‘808 Patent. But that approach is legally insufficient, and is wrought with impermissible hindsight bias.

The Board has articulated what is required to show obviousness in a number of situations; germane here is the articulation by the Board in the *Dropworks, Inc.*

v. Bio-Rad Laboratories, Inc. case:

To show obviousness, it is not enough to merely show that the prior art includes separate references covering each separate limitation in a challenged claim. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). “This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR [Int’l. v. Teleflex Inc.]*, 550 U.S. [398] at 418–419 [(2007)]. On the other hand, an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418; accord *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1259 (Fed. Cir. 2007). However, Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Instead, Petitioner must articulate a reason why a person of ordinary skill in the art would have combined or modified the

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

IPR2021-00212, Paper 7 at 6-7 (PTAB June 1, 2021). Each of the Grounds presented in the Petition here suffers from the infirmities articulated by the Board above, and as such denial of the Petition is warranted.

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

The Petition relies solely on U.S. Patent Publication 2014/0060712 to Beckley (“Beckley”) to teach claim elements 1[e]-1[i] in connection with its first Ground. Petition at 22-26. It does over the span of three pages in the Petition, but incorporates by reference paragraphs 154-159 and 169-193 of Mr. Babcock’s report, spanning pages 70-73 and 77-87, to address these limitations. This inequity in treatment demonstrates the cursory nature of the Petition, and its improper

reliance on incorporated-by-reference material.

With regard to the “Motivation to Combine” analysis in the Petition, the first paragraph is nothing but a statement that a POSITA “would have been motivated” to make the desired combination. Petition at 15. Excluding Mr. Babcock’s testimony, the only evidence the Petition cites for this proposition are statements, in Kane and Beckley, that accommodating user preferences is desirable. However, since Kane was considered during examination, the Examiner already considered this teaching and found the claims patentable; the Petition does not alter that correct conclusion.

The next paragraph cites only to Mr. Babcock, and thus amounts to nothing more than attorney argument when his five paragraphs of incorporated-by-reference testimony are excluded. Petition at 15.

The next two paragraphs merely summarize similarities in the prior art references, and do not support a finding of combinability in and of themselves. What is more, in the discussions of the similarity of the references, the Petition do not take into account that the Beckley money clip is attached to the underlying structure in a completely different way, using completely different structures. They instead cherry pick common features without delving into the drastic differences in structure between Kane and Beckley.

Petitioner asserts that “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.” Petition at 16. But the citations to Beckley in this paragraph do not support the statement; they merely describe the configuration of Beckley’s device, and do not support a finding that a POSITA would have modified Kane in view of Beckley.

Finally, the Petition’s entire section regarding a “Reasonable Expectation of Success” can be ignored as mere attorney argument; the only citations in that section are to fifteen (15) different paragraphs from Mr. Babcock’s declaration.

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

B. The Petition Does Not Establish Combinability of Kane and Pelz

The Petition relies solely on U.S. Patent No. 2,326,558 to Pelz (“Pelz”) to teach claim elements 1[e]-1[i] in connection with its first Ground. Petition at 53-58. It does over the span of five pages in the Petition, but incorporates by reference paragraphs 484-487, 500-502, 508-509, 515-516, and 523-524 of Mr. Babcock’s declaration to address these limitations, demonstrating the cursory nature of the Petition’s treatment of obviousness.

With regard to the “Motivation to Combine” analysis in the Petition, the first paragraph is nothing but a statement that a POSITA “would have been motivated” to make the desired combination. Petition at 49. Excluding Mr. Babcock’s

testimony, the only evidence the Petition cites for this proposition is the statements, in Kane, that accommodating user preferences is desirable. However, since Kane was considered during examination, the Examiner already considered this teaching and found the claims patentable; the Petition does not alter that correct conclusion.

The next paragraph contains no citations to the evidence, and thus amounts to nothing more than attorney argument. Petition at 49.

The next three paragraphs merely summarize similarities in the prior art references, and do not support a finding of combinability. And they certainly do not address the drastic difference in timing of the references: Pelz dates back to 1943, and Kane is a Kickstarter campaign from 2014. Ex. 1008; Ex. 1006. Petitioner does not even attempt to explain why a POSITA in 2017 would have looked to archaic teachings from more than 70 years earlier, and certainly does not explain the fact that in that 70 years nobody other than the ‘808 Patent’s inventor actually made that combination.

In the paragraph spanning pages 50-51, the Petition impermissibly uses the ‘808 Patent as a blueprint to piece together the prior art: it cites to the background of that patent in support of alleged combinability.

Petitioner asserts that “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.”

Petition at 51. But the citations to Pelz in this paragraph do not support the statement; they merely describe the configuration of Pelz’s device, and do not support a finding that a POSITA would have modified Kane in view of Pelz.

Finally, the Petition’s entire section regarding a “Reasonable Expectation of Success” can be ignored as mere attorney argument; the only citations in that section are to twenty-eight (28) different paragraphs from Mr. Babcock’s declaration.

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

C. The Petition Does Not Establish Combinability of Kane and Matthews

The Petition relies solely on U.S. Patent Publication No. 2009/0134223 to Matthews et al. (“Matthews”) to teach claim elements 1[e]-1[i] in connection with its first Ground. Petition at 72-78. It does over the span of six pages in the Petition, but incorporates by reference paragraphs 767-768, 778-780, 786-789, 795-797, and 802-805 to address these limitations, demonstrating the cursory nature of the Petition’s treatment of obviousness.

With regard to the “Motivation to Combine” analysis in the Petition, the first paragraph is nothing but a statement that a POSITA “would have been motivated”

to make the desired combination. Petition at 67. Excluding Mr. Babcock's testimony, the only evidence the Petition cites for this proposition is the statements, in Kane, that accommodating user preferences is desirable. However, since Kane was considered during examination, the Examiner already considered this teaching and found the claims patentable; the Petition does not alter that correct conclusion.

The next paragraph cites to no evidence, and thus amounts to nothing more than attorney argument. Petition at 67.

The next three paragraphs merely summarize similarities in the prior art references, and do not support a finding of combinability.

Petitioner asserts that "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." Petition at 68-69. But the citations to Matthews in this paragraph do not support the statement; they merely describe the configuration of Matthews' device, and do not support a finding that a POSITA would have modified Kane in view of Matthews.

Finally, the Petition's entire section regarding a "Reasonable Expectation of Success" can be ignored as mere attorney argument; the only citations in that section are to eighteen (18) different paragraphs from Mr. Babcock's declaration.

The Petition does not establish a reasonable likelihood of success on the merits for Ground 3, and should be denied. 35 U.S.C. § 314(a).

D. Secondary Considerations Evidence Known to Petitioner Supports Non-Obviousness

The Petition is completely devoid of any argument or evidence about secondary considerations relating to the issue of obviousness. It simply states that “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.” Petition at 88.

Months before the Petition was filed, on January 19, 2024, Ridge provided the following response to the following interrogatory *Mountain Voyage served on Ridge*:

Subject to and without waiving these objections, Ridge responds that the astronomical success of Ridge’s patented products, which only occurred when those products started to incorporate features like those disclosed and claimed in the ’808 Patent (and thus has nexus to the ’808 Patent), is a secondary consideration of non-obviousness. In addition, the extensive copying of Ridge’s domestic patent products (including the patented features of the products), including by Mountain Voyage (and the dozens, if not hundreds of sellers on e-commerce marketplaces, such as Amazon, Alibaba, eBay, TEMU, Tiktok Shop, etc.) constitutes a secondary consideration of non-obviousness. This fact pattern establishes that the ’808 Patent satisfies a long-felt, but unresolved need in the industry, and is reflective of commercial success. As to the alleged Mosaic prior art, the fact that Mosaic was not commercially successful is evidence that the purported Mosaic prior art is not, in fact, prior art. For at least these reasons, Ridge responds that there are substantial secondary

considerations of non-obviousness.

Ex. 2007 at 11.

Mountain Voyage simply failed to address the evidence of which it was aware, and as a result cannot meet its burden to demonstrate a likelihood of success, and yet another reason institution of *inter partes* review should be denied. 35 U.S.C. § 314.

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

The Board addresses discretionary denial under 35 U.S.C. § 325(d) using a two-part framework:

1. Whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office
2. If either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims

See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 7-8 (PTAB Feb. 13, 2020) (precedential). As explained below, discretionary denial of the Petition under 35 U.S.C. § 325(d) is warranted because (1) the Petition advances proposed Grounds that rely on the same or cumulative prior art references (and predominately Patent Owner's own, cited and considered prior art) that were previously presented to and considered by

the Examiner during prosecution and (2) Petitioner has not demonstrated that the Office erred in a manner material to the patentability of the Challenged Claims. *Id.*

A. The Sole Primary Reference Is Attributable to PO, Was Submitted During Examination, and Was Used To Reject the Claims Prior to Amendment During Examination

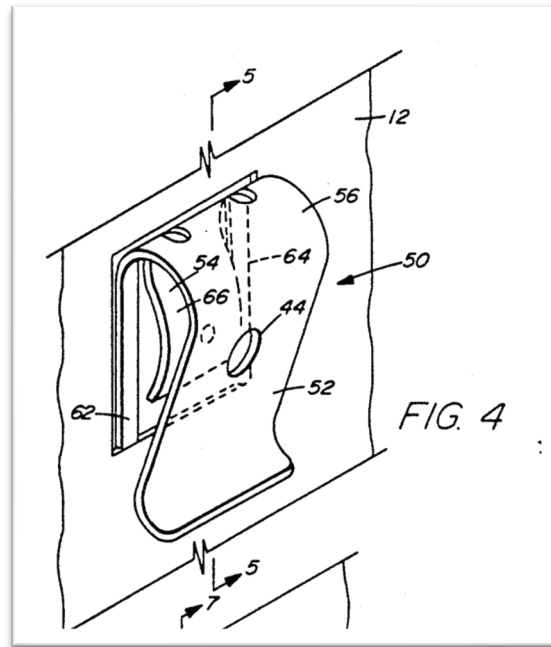
The first part of the *Advanced Bionics* framework is satisfied because each of the Grounds in the Petition relies, for nearly all of the claim elements, on Kane as the primary reference. Kane was of course presented to the Office during prosecution of the ‘808 Patent; it is the ‘808 Patent inventor’s own prior work. *See generally* Ex. 1004.

Applicant submitted that reference in an IDS dated January 30, 2017. Ex. 1004 at 3. The Office used Kane to reject the claims in the sole substantive rejection during prosecution of the ‘808 Patent, on September 19, 2018. Ex. 1004 at 70. And the Applicant argued over Kane (successfully) in the response dated May 27, 2020. Ex. 1004 at 143-144.

Accordingly, the “base” reference for each of the Grounds presented herein were already considered by the Examiner during prosecution of the ‘808 Patent, and is not “new” under the *Advanced Bionics* framework. *Advanced Bionics*, Paper 6 at 7-8.

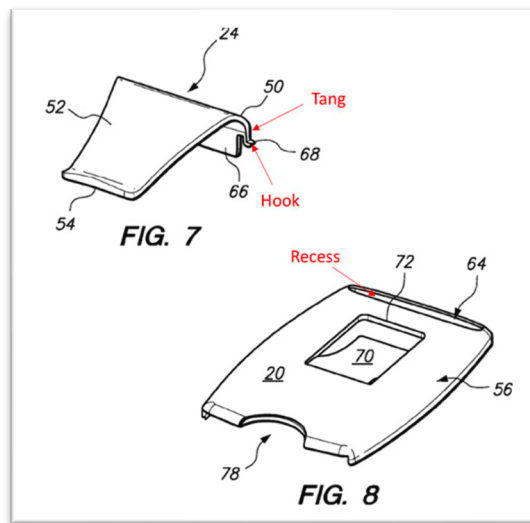
With regard to the references the Petition relies on in combination with Kane (i.e., Beckley, Pelz, and Matthews), those references are substantially the same art

as references used during examination, and the arguments Petitioner makes are substantially the same as arguments made during examination. Numerous references that were before the examiner, such as U.S. Patent No. 5,038,985 to Chapin (Ex. 2005) illustrate money clips of varying designs:



Ex. 2005 at Fig. 4. Indeed, the Chapin reference was used *in combination with Kane* to reject the claims during examination. Ex. 1004 at 70. Applicant's arguments overcame that rejection (Ex. 1004 at 144), meaning that combinations of Kane with money clip references (like Beckley, Pelz, and Matthews) have already been considered, and the claims of the '808 Patent allowed, in prosecution.

U.S. Patent No. 7,334,616 to Kaminski ("Kaminski") likewise discloses a clip, and in that case it is for a card-carrying device:



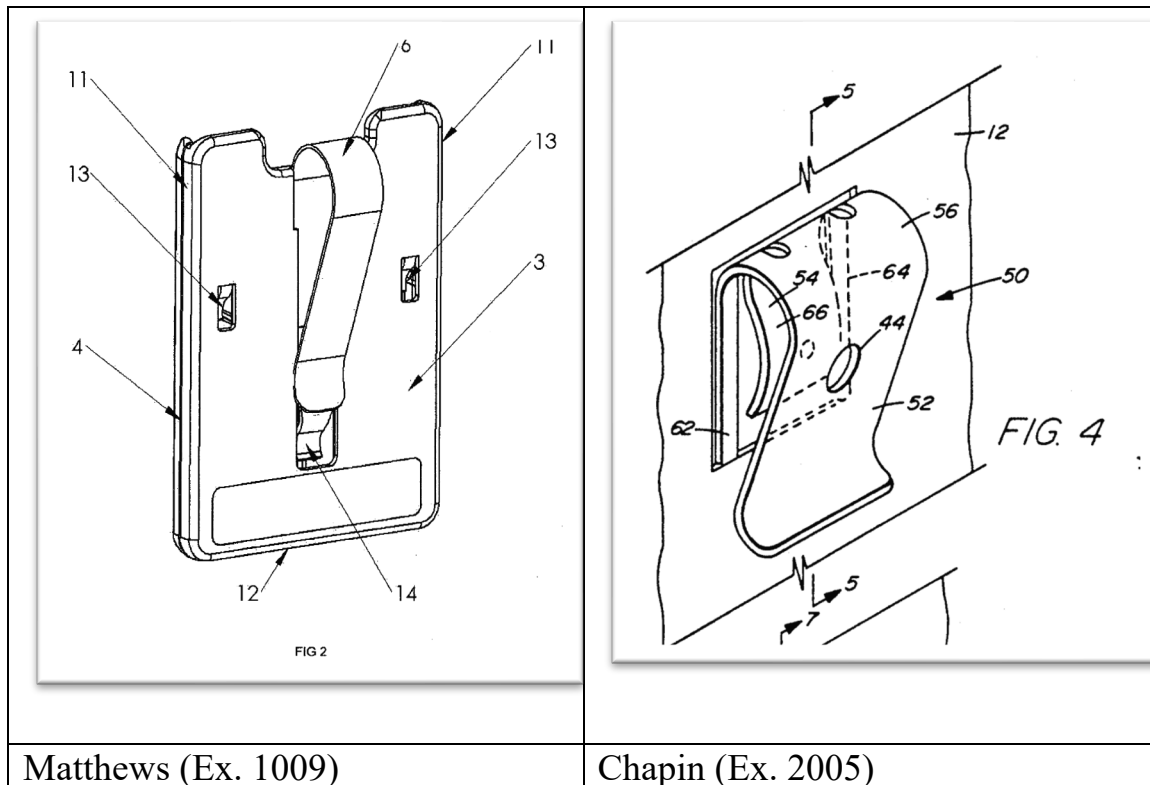
Ex. 2006 at 35. Kaminski was also considered during examination of the ‘808 Patent; the Patent Owner submitted it as the sole referenced on an Information Disclosure Statement filed along with the response in which it argued over Kane and Chapin. Ex. 1004 at 122. Kaminski likewise demonstrates that the art and arguments in the Petition are substantially the same as the arguments made during prosecution.

Mountain Voyage knows this: it is presently asserting, in its District Court Invalidity Contentions, that Kaminski’s clip teaches the very same limitations it relies on Beckley, Pelz, and Matthews for in this proceeding. Ex. 2004 at 82. Incredibly, it is asserting Kaminski *in combination with the very same primary reference it uses here: Kane. Id.* Thus, by Mountain Voyage’s own Rule 11-certified submissions in the District Court Case, it is conceding that Beckley, Pelz, and Matthews are cumulative of art (and specific combinations) actually

considered during examination.

With regard to Beckley, Mountain Voyage acknowledges that the very same reference, in the very same combination, was used in the IPR2024-00340 (the “ARW IPR”). Petition at 92. The instant Petition is thus unquestionably a second attempt to invalidate the ‘808 Patent over the combination of Kane and Beckley, and supports denial under 35 U.S.C. § 325(d).

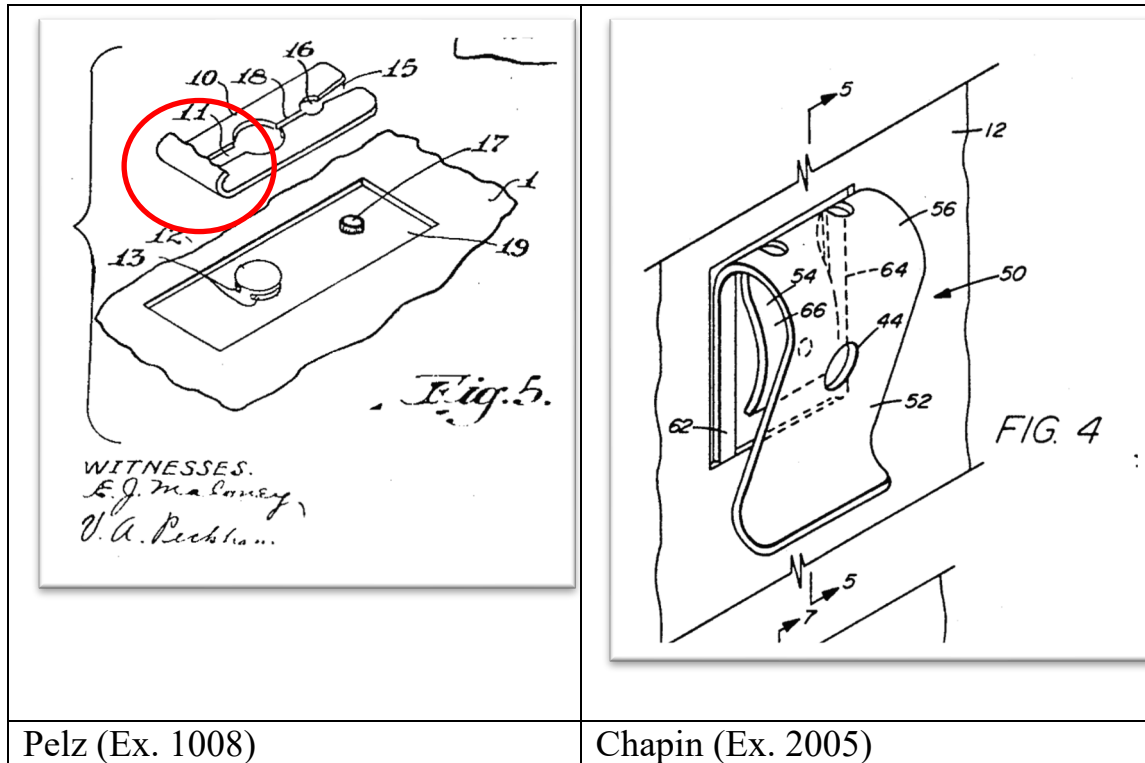
Pelz and Matthews are devices whose designs are not materially different from other prior art that was considered during examination. For example, Matthews is nearly identical to the Chapin reference mentioned above:



While there is no corresponding perspective image in Pelz, that reference is also

duplicative of Chapin based on the sliding insertion/removal of the money clip in

Pelz:



In the image above, the wavy line circled in red indicates that the clip portion of the Pelz money clip has been excluded for visibility. Ex. 1008 at 2:15-16 (“fragmentary view”).

The only attempt Mountain Voyage makes to address the plain cumulative nature of these prior art references is the statement that “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. Petition at 92. Mountain Voyage does not even present evidence from its expert, despite his more than 60,000-word declaration, in support of this statement.

Accordingly, the Grounds presented in the instant Petition rely on the same or substantially the same art, and present the same or substantially the same arguments, as have already been presented in examination and in the ARW IPR.

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

Petitioner did not even attempt to demonstrate material error by the Office, so discretionary denial is appropriate *See Advanced Bionics LLC*, Paper 6 at 8. While Petitioner relies on a handful of references for the putative teachings of the “auxiliary member” and associated requirements, Petitioner does not attempt to say that the failure to apply such references constituted material error. *Ivantis, Inc. et al. v. Sight Sciences, Inc.*, IPR2022-01533, Paper 14 at 18-20 (PTAB Mar. 27, 2023) (finding that Petitioner failed to demonstrate material error in view of Petitioner’s bare assertion that references were not applied during prosecution);

Google LLC v. Kewazinga Corp., IPR2021-00527, Paper 16 at 18-19 (PTAB Aug. 24, 2021) (denying institution where Petitioner did not “identify any specific teaching in any reference that the Examiner misapprehended or overlooked” and did not point out how the Examiner erred in evaluating the references); *Roku, Inc. v. Universal Elecs., Inc.*, IPR2019-01619, Paper 11 at 11, 19 (PTAB Apr. 2, 2020) (denying institution where Petition’s relied upon reference was disclosed in an IDS during prosecution but did not adequately explain how the Examiner erred materially).

Further demonstrative of the lack of material error by the Examiner is the fact that Mountain Voyage is asserting Kaminski, a reference the Office considered during examination, as disclosing the claim elements it contends Beckley, Pelz, and Matthews disclose here. Ex. 2004 at 82. It is doing so only in the District Court Case; the word “Kaminski” conspicuously does not appear in the Petition. *See generally* Petition. But the fact that Mountain Voyage is asserting, under Rule 11, that an of-record reference discloses those limitations is evidence that the Office did not err in a material way such that the Board should revisit patent validity based on Kane and a “clip reference.”

Discretionary denial under 35 U.S.C. § 325(d) is warranted here given that the same art was previously presented to the Patent Office and Petitioner has failed to show any material error. *See Google LLC v. Valtrus Innovations Ltd.*, IPR2022-

01197, Paper 18 at 19-24, 28- 29 (PTAB June 13, 2023) (exercising discretion to deny grounds under 35 U.S.C. § 325(d); finding that Petitioner failed to demonstrate material error “with specificity”).

C. The Instant Petition is a Serial Petition Written with Specific Knowledge of the ARW Petition

While the Petitioner itself may not have filed more than one petition under *General Plastics*, the instant Petition is unquestionably a second bite at the ‘808 Patent apple by defendants in cases brought by Ridge. The fact that the instant Petition relies on the identical primary reference, and one of the three identical secondary references, demonstrates that Petitioner is seeking to use the Board’s rationales and rulings in the ARW IPR to its advantage here. And while the discretionary denial permitted by 35 U.S.C. § 314(a) (*e.g., under General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357 (PTAB Sept. 6, 2017)) may not be applicable here, the use of the same primary reference and overlapping secondary references demonstrates that discretionary denial under 35 U.S.C. § 325(d) is appropriate.

IX. THE PETITION SHOULD BE DENIED FOR FLAUNTING THE BOARD’S WORD COUNT LIMITS UNDER 37 C.F.R. § 42.24

The Petition contains a certification 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).” Petition at
CERTIFICATE OF COMPLIANCE.

Even if that is true, Mountain Voyage’s IPR initiating documents warrant denying institution because they blatantly flaunt the Rules regarding word count. In particular, Mountain Voyage’s Petition improperly incorporates by reference a 350 page expert declaration which, by Ridge’s count contains more than 60,000 words. And Mountain Voyage does so without any explanation or request to exceed the word count limits of 37 C.F.R. § 42.24. It also incorporates by reference Mountain Voyage’s opening claim construction brief in the parties’ ongoing District of Colorado case, adding another ~3,300 words to the already nearly overlength petition. Because each of these incorporated by reference items is critical to a grantable petition, denial is appropriate here.

37 C.F.R. § 42.24(a)(2) states that “Petitions to institute a trial must comply with the stated word counts but may be accompanied by a motion to waive the word counts.” Here, no such motion has been submitted.

What Petitioner did here was to submit a 350 page declaration of Mr. James B. Babcock in support of its nearly-14,000 word Petition. Using the Adobe Acrobat “Export to Word” feature, Mr. Babcock’s declaration (excluding tables of contents and the like) includes a whopping 61,656 words (according to Microsoft Word’s word count tool). Even assuming that the 13,933 words in the Petition are

a complete overlap with the same number of words in Mr. Babcock's declaration (they are not), Mr. Babcock still adds at least 47,723 words above and beyond the word count limit required in 37 C.F.R. § 42.24. This flagrant disregard for the Board's rules should not be countenanced; the Petition should be denied.

Unsurprisingly, the Petition is replete with incorporation-by-reference of a large swaths of Mr. Babcock's declaration. A simple search for "Babcock" (the word-saving shorthand Petitioner uses approximately 300 times throughout the Petition) reveals many instances of conduct like this:

- Babcock ¶¶ 120-468 (Petition at 15)
- Babcock ¶¶ 166-167, 173-174, 181-182, 187-188, 195-196, 324, 326, 341-342, 347-348, 409, 421, 426, 435, 445 (Petition at 15)
- Babcock ¶¶ 165, 173, 197, 340, 326, 411, 446) (Petition at 17)
- Babcock ¶¶ 172, 180, 186, 194, 325, 346, 412, 444 (Petition at 17)
- Babcock ¶¶ 469-747 (Petition at 48)
- 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 (Petition at 49)
- Babcock ¶¶ 494, 613, 620, 628, 686, 711, 720 (Petition at 51)
- Babcock ¶¶ 503, 512, 517, 519, 527, 606, 623, 630, 713, 724 (Petition

at 51)

- Babcock ¶¶ 503-505, 601-605, 670, 673, 724-726 (Petition at 52)
- Babcock ¶¶ 495, 503, 510, 517, 525, 601, 621, 685, 687, 711, 724
(Petition at 52)
- Babcock ¶¶ 748-1035 (Petition at 66)
- 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
(Petition at 67)
- Babcock ¶¶ 776, 792, 800, 808 (Petition at 69)
- Babcock ¶¶ 781-782, 885, 886, 954, 1011-1012 (Petition at 69)
- Babcock ¶¶ 781, 790, 798, 885, 910, 1011 (Petition at 69)

Thus, simply reading through the Petition’s analysis of combinability for Ground 1, it can be seen that Petitioner incorporates massive swaths of Mr. Babcock’s testimony by reference, in impermissible string citation format.

As recognized by the Board, Petitioner’s attempt to rely on exhibits reveals it failed to provide the required “particularity” within the Petition itself. *See, e.g., Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, 2019 WL 1084284, at *9 (P.T.A.B. Mar. 6, 2019) (informative) (“The extent to which these additional documents may be relied upon to fill gaps ... increases our concern that the Petition lacks the

required particularity”). In the event the Board decides not to strike the Petition, at the very least it should not consider Mr. Babcock’s testimony throughout the remainder of this Petition. As the CTPG notes: parties that incorporate expert testimony by reference in their petitions, motions, or replies without providing explanation of such testimony risk having the testimony not considered by the Board. *See Cisco Systems, Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454 (PTAB Aug. 29, 2014) (Paper 12) (informative).” CTPG at 35-36. Petitioner relies extensively on incorporated-by-reference testimony of Mr. Babcock, and provides no explanation whatsoever of the extensively incorporated-by-reference testimony. Under the Board’s precedent and the governing CTPG, proceeding to the institution decision without Mr. Babcock’s testimony as part of the evidence of record is the only equitable way to proceed.

Separate from the incorporation by reference of Mr. Babcock’s voluminous declaration, the only arguable support Mountain Voyage has for having presented any claim construction arguments whatsoever is an incorporation-by-reference of its opening claim construction brief in the District of Colorado case between Petitioner and Patent Owner. Petition at 13-14 (citing Ex. 1015 without pin citations). As discussed above, this does not satisfy what the CTPG says petitioners **must** do, and for that reason denial is appropriate. But in addition, and being as charitable as possible to Petitioner, the incorporation by reference of the

opening claim construction brief adds 3,386 words to the Petition's 13,933 words. Thus, even ignoring the blatant incorporation-by-reference of swaths of Mr. Babcock's declaration, the Petition itself (if it can satisfy the CTPG's requirements for claim construction arguments and evidence) exceeds the word count limit by 3,319 words. The nearly 24% overlength petition (even excluding the incorporation by reference of Mr. Babcock's testimony) should not be entertained, and denial is warranted.

Patent Owner is cognizant of the Board's reluctance to deny institution of petitions solely because of abuses of word count limitations. However, in Patent Owner's research, it did not locate a case whose abuses were as pronounced as Mountain Voyage's abuses are here. And the fact that on critical issues, like claim construction and secondary considerations, the Petition *still* does not adequately support institution under 35 U.S.C. § 314, demonstrates that this case warrants denial of institution on Mountain Voyage's word count abuses. Had Petitioner not waited until the last day it was statutorily able to file its Petition, these errors may have been correctable. Here, though, a combination of Petitioner's decision to ignore the Board's rules and to make its filing on the last day of its statutory time for filing support a finding that it may not avail itself of the Patent Trial and Appeal Board to dispute the validity of the '808 Patent. The fact that the Petition merely seeks to re-hash arguments the Patent and Trademark Office has already

considered further supports this outcome.

X. CONCLUSION

For the foregoing reasons, Patent Owner requests denial of institution, either because Petitioner has not shown it is reasonably likely to succeed on at least one claim (35 U.S.C. § 314), because the same or substantially the same arguments have already been presented to the Office on a number of occasions (35 U.S.C. § 325(d)), or because of the Petitioner's flagrant disregard for the Board's rules regarding the contents of the Petition and word count limitations associated therewith.

Date: July 10, 2024

Respectfully Submitted,

/s/ Benjamin E. Weed

Benjamin E. Weed

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

Under the provisions of 37 C.F.R. §42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Preliminary Response to Petition totals 8,081, which is less than the 14,000 allowed under 37 C.F.R. §42.24(b)(1).

Respectfully submitted,

Date: July 10, 2024

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

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on July 10, 2024, a complete and entire copy of this Patent Owner's Preliminary Response was provided, via email, to the Petitioner by serving the correspondence address of record as follows:

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