

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

2985, LLC d/b/a MOUNTAIN VOYAGE COMPANY, LLC,
Petitioner

v.

THE RIDGE WALLET LLC,
Patent Owner.

Case IPR2024-00692
Patent 10,791,808

**PETITIONER'S REPLY TO PATENT
OWNER'S PRELIMINARY RESPONSE**

Table of Contents

I. THE CIRCUMSTANCES WEIGH AGAINST DISCRETIONARY DENIAL...1

 A. The Petition’s Prior Art and Arguments are Materially Different than those Previously Presented to the Office.....1

 B. The Office Made a Material Error in Evaluating the Prior Art.....2

II. THERE IS NO EVIDENCE OF SECONDARY CONSIDERATIONS OF NON-OBVIOUSNESS.....3

 A. PO’s Interrogatory Statements are Insufficient Evidence of Secondary Considerations of Non-Obviousness.....4

III. CONCLUSION..... 5

Cases

<i>Advanced Bionics, LLC v. Med-El Electromedizinische Gerate Gmbh</i> , IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential)	1
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG</i> , IPR 2017-01586, Paper 8 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph)	1
<i>Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.</i> , 229 F.3d 1120, 1130 (Fed. Cir. 2000).....	4
<i>Fox Factory, Inc. v. SRAM, LLC</i> , 944 F.3d 1366, 1373–74 (Fed. Cir. 2019)	4
<i>In re GPAC</i> , 57 F.3d 1573, 1580 (Fed. Cir. 1995)	3
IPR2024-00340	3
<i>Leapfrog Enterprises Inc. v. Fisher-Price Inc.</i> , 485 F.3d 1157, 1162, 82 USPQ2d 1687, 1692 (Fed. Cir. 2007).....	5
<i>Oticon Medical AB v. Cochlear Ltd.</i> , No. IPR2019-00975, Paper 15 at 10-20 (P.T.A.B. Oct. 16, 2019).....	1
<i>Shenzhen Pinan Technology Co. Ltd.</i> , IPR2024-00340, Paper 18 at 42 (PTAB Jul. 12, 2024)	3
<i>Volvo Penta of the Ams. LLC v. Brunswick Corp.</i> , 81 F.4th 1202 (Fed. Circ. 2023)	4

Statutes

35 U.S.C. § 325(d)	1, 5
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I. THE CIRCUMSTANCES WEIGH AGAINST DISCRETIONARY DENIAL

In considering whether discretionary denial of an *inter partes review* (IPR) petition is appropriate under 35 U.S.C. § 325(d), a two-prong framework is employed: (1) whether the prior art and arguments presented in the petition are the same or substantially the same as those previously presented to the Office; and (2) if so, whether the petition has demonstrated a material error by the Office in its prior consideration of those prior art and arguments. *See Advanced Bionics, LLC v. Med-El Electromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). In applying the two-prong framework, a non-exclusive list of factors was set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR 2017-01586, Paper 8 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph).

A. The Petition's Prior Art and Arguments are Materially Different than those Previously Presented to the Office

Becton Dickinson factors (a), (b), and (d) weigh against discretionary denial. None of the secondary references were presented to the Office. Patent Owner ("PO") contends that Beckley, Pelz, and Matthews are cumulative of U.S. Patent No. 5,038,985 ("Chapin") and U.S. Patent No. 7,334,616 ("Kaminski"). However, each of the secondary references have different structures, that serve different purposes, than Chapin and/or Kaminski. *See e.g.*, Prelim. Resp. 24-28; *Oticon Medical AB v. Cochlear Ltd.*, No. IPR2019-00975, Paper 15 at 15 (P.T.A.B. Oct. 16, 2019)

(“different structures that serve different purposes” are not cumulative).

For example, Chapin regards a clip for an adjustable tape measure; whereas Beckley and Matthews disclose removable clips for cardholders, and Pelz discloses a removable clip for microphone hearing units. *See e.g.*, Chapin, Abstract; Petition, 7-10. Further, Chapin's clip is fixed to the adjustable tape measure via a screw. *See* Chapin, Abstract (“A mounting screw, which mounts the spring clip onto the tape measure....”). In contrast, Beckley, Pelz, and Matthews each teach removable clips mounted without the need for fasteners. *See e.g.*, Petition, 22-26, 53-57, 72-78.

Also, the structure and function taught by Kaminski is substantially different than that of Beckley, Pelz, and Matthews. For example, unlike Kaminski, removing the clips taught by Pelz and Matthews can be accomplished without disassembling the unit body. *See e.g.*, Kaminski, FIG. 13; Ex. 1008, FIGS 2, 8; Ex. 1009, FIG. 4. In another example, the clip structure disclosed by Beckley advantageously facilitates a sliding interposition of the wallet body halves, which in turn facilitates removal of the clip; whereas Kaminski's clip interfaces with both plates of the wallet body. *See e.g.*, Ex. 1007, FIG. 1; Kaminski, FIGS. 4, 7-8, and 13.

B. The Office Made a Material Error in Evaluating the Prior Art

Becton Dickinson factors (c), (e), and (f) also weigh against discretionary denial. Notably, Kaminski was not the basis of a rejection during prosecution; rather, Kaminski was disclosed by PO two years after issuance of the sole office action. *See*

Ex. 1004, 196-197. Further, in another IPR against the Challenged Claims, the Board recently held “that the Examiner overlooked teachings that are relevant to the limitations that were the basis for allowing the challenged claims.” *Shenzhen Pincan Technology Co. Ltd.*, IPR2024-00340, Paper 18 at 42 (PTAB Jul. 12, 2024) (the “’340 IPR”).

Like the ’340 IPR, the Petition establishes that the combination of Kane with Beckley, Pelz, or Matthews discloses or suggests a “recess having an undercut operable to engage a hook of the tang,” which was the reason for allowance specified by the Examiner. *See e.g.*, Ex. 1004, 157; Petition, 22-26, 53-57, 72-78. Also, like the ’340 IPR, PO does not dispute that the combination of Kane and the secondary references teaches the limitations that were the basis for allowing the Challenged Claims; rather PO rests on the assertion that it would not have been obvious to combine the references. *See e.g.*, Prelim. Resp. 16-21; IPR2024-00340, Paper 18 at 43. Thereby, Beckley, Pelz, and Matthews address an oversight during prosecution that was material to the patentability of the Challenged Claims.

II. THERE IS NO EVIDENCE OF SECONDARY CONSIDERATIONS OF NON-OBVIOUSNESS

For objective evidence of secondary considerations to be relevant, there must be a nexus between the claimed invention and the objective evidence. *See In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). This nexus can be established in two

ways: (1) via a presumption of nexus when the evidence is linked to a product that embodies and is coextensive with the claimed features (*Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000)), or (2) via a showing that the evidence is a direct result of the unique characteristics of the claimed invention (*Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373–74 (Fed. Cir. 2019)).

A. PO's Interrogatory Statements are Insufficient Evidence of Secondary Considerations of Non-Obviousness

PO's interrogatory statements are insufficient evidence of secondary considerations at least due to their conclusory nature.¹ PO is not entitled to a presumption of nexus, has failed to independently demonstrate nexus, or show that the claimed features coextensive with its commercial product. PO's statements on secondary considerations—such as success, copying by others, failure of others, and long-felt but unsolved need—are unsupported allegations. The Federal Circuit deemed such conclusory statements insufficient to show a presumption of nexus. *See Volvo Penta of the Ams. LLC v. Brunswick Corp.*, 81 F.4th 1202 (Fed. Cir. 2023).

Moreover, PO has not identified any unique characteristics of the claimed invention that warrant secondary consideration. PO has not demonstrated that the

¹ PO's interrogatory statements were marked Highly Confidential, and disclosing said statements in the Petition would have been a violation of the protective order in the parallel district court litigation.

claimed "recess," "hook, and "undercut" resulted in the alleged "astronomical success," drove others to copy, or addressed a long-felt but unsolved need. Also, PO's unsupported allegations are inadequate when compared to the strength of the Petition's case for obviousness. *See Leapfrog Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157, 1162, 82 USPQ2d 1687, 1692 (Fed. Cir. 2007) ("given the strength of the *prima facie* obviousness showing, the evidence on secondary considerations was inadequate..."). Thus, PO's arguments are conclusory and fail to provide objective evidence of secondary considerations for non-obviousness.

III. CONCLUSION

Accordingly, the Petition should not be denied under 35 U.S.C. § 325(d) as the prior art and arguments presented are materially different those previously considered, and the Office made a material error in evaluating the prior art. Furthermore, PO's interrogatory statements are conclusory and fail to demonstrate a nexus between the claimed invention and any alleged secondary considerations. Therefore, discretionary denial is unwarranted, and the Petition should be instituted.

Dated: August 2, 2024

Respectfully Submitted

/s/ /Jacob Busch /

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Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on counsel for Patent Owner a true and correct copy of the foregoing Petitioner's Preliminary Reply to Patent Owner's Preliminary Response on August 2, 2024, by email on the following counsel of record for the Patent Owner:

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Dated: August 2, 2024

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