

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

DECLARATION OF THOMAS R. KURFESS PH.D., P.E.

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I, Dr. Thomas R. Kurfess, Ph.D., P.E., hereby declare as follows:

1. I am over the age of 18 and competent to issue this declaration.
2. I have been retained to on behalf of the Plaintiff, The Ridge Wallet LLC (“Ridge” or “Plaintiff”), to provide technical services and opinions relating to the subject matter of U.S. Patent No. 10,791,808 (which I sometimes refer to herein as the “‘808 Patent”). The opinions I have formulated during this assessment are based on observations and information available at the time I issued this declaration.
3. The findings presented herein are made to a reasonable degree of scientific certainty. I have made every effort to accurately and completely investigate all areas of concern identified during my investigation.
4. I reserve the right to supplement this declaration if and when new information becomes available after this declaration is signed, including, but not limited to, additional discovery or documents, opinions of the Board or any court, and opinions and testimony of other experts in this case. I reserve the right to respond to any opinions offered by other experts and to any testimony offered at any hearing in this matter. And, I reserve the right to create graphics or demonstratives to support my opinions if called to testify at a hearing.

I. BACKGROUND

5. In the paragraphs that follow, I explain my conclusions that Defendant 2985, LLC d/b/a Mountain Voyage Company’s (“Mountain Voyage” or

“Defendant”) expert, Mr. James Babcock, has not established that the asserted claims of U.S. Patent No. 10,791,808 are invalid. I further explain the evidence and analysis, and all the reasons, based upon which I have reached these conclusions.

6. In particular, I have been asked to respond to the opinions contained in an expert declaration submitted by Mr. James Babcock in connection with the filing of an *Inter Partes* Review proceeding filed on March 15, 2024.

7. I am being compensated for my time in connection with this proceeding at my standard consulting rate, which is \$650 per hour. My compensation is not contingent upon my findings, testimony rendered, or the outcome of this Investigation.

A. QUALIFICATIONS

8. I received my Ph.D. in 1989 from Massachusetts Institute of Technology (“MIT”) in Mechanical Engineering. Prior to that, I received dual S.M. degrees in Electrical Engineering & Computer Science and Mechanical Engineering. I received my S.B. in Mechanical Engineering in 1986, also from MIT.

9. I serve as the Chief Manufacturing Officer of the Georgia Institute of Technology, as well as the Executive Director of the Georgia Tech Manufacturing Institute. I was also a Professor of mechanical engineering and HUSCO/Ramirez Distinguished Chair in Fluid Power and Motion Control; I was recently promoted to Regents’ Professor.

10. I have extensive experience in academia, governmental organizations, and private industries.

11. My primary research areas include Manufacturing and Automation & Mechatronics, advanced automation, precision manufacturing, metrology, and technology policy.

12. I focus on the design and development of advanced systems targeting complex production and optimization of products. My focus spans a wide array of technologies, including high precision manufacturing and metrology systems, as well as national and international manufacturing policy.

13. I have worked on a variety of mechatronic and robotic systems in my career that include components and machines that are used in producing and assembling consumer products such as the wallets that are being considered. I have also authored several different book chapters and papers that discuss manufacturing and robotic systems and their implementation. I have taught engineering courses at both the undergraduate and graduate levels on the topics of mechanical design, control theory, robotics and advanced dynamics, and real-time signal processing and control, all of which are applicable to the manufacturing sector.

14. I began my academic career at Carnegie Mellon University where I rose to the rank of Associate Professor. In 1994, I moved to the Georgia Institute of Technology and was appointed Professor in the George W. Woodruff School of

Mechanical Engineering. In 2005, I was named Professor and BMW Chair of Manufacturing in the Department of Mechanical Engineering at Clemson University's International Center for Automotive Research. In 2012, I returned to Georgia Tech as a Professor of Mechanical Engineering and the HUSCO/Ramirez Distinguished Chair in Fluid Power and Motion Control. From 2019 to 2022, I was on a three-year leave of absence to serve as the Chief Manufacturing Officer for Oak Ridge National Laboratory (ORNL). My responsibility at ORNL was to develop and execute a long-range plan for advanced manufacturing as it applies to ORNL, national laboratories, and the United States of America.

15. Between 2012 and 2013, I took leave to serve as the Assistant Director for Advanced Manufacturing at the Office of Science and Technology Policy in the Executive Office of the President of the United States of America. In this position, I was responsible for engaging the Federal sector and the greater scientific community to identify possible areas for policy actions related to manufacturing. In this role, I also coordinated Federal advanced manufacturing R&D, addressing issues related to technology commercialization, identifying gaps in current Federal R&D in advanced manufacturing, and developing strategies to address these gaps.

16. Additionally, I have served as a special consultant of the United Nations to the Government of Malaysia in the area of applied mechatronics and manufacturing, and as a participating guest at the Lawrence Livermore National

Laboratory's Precision Engineering Program. I also served as President for the Society of Manufacturing Engineers in 2018.

17. Currently, I serve on the Board of Governors for the American Society of Mechanical Engineers, the National Center for Manufacturing Sciences, and the National Center for Defense Manufacturing and Machining, and on the Board of Trustees for the MT Connect Institute. I also served as the President of the American Society of Mechanical Engineers in 2023-2024.

18. I have significant experience in high precision manufacturing and metrology systems, which I bring to bear in this case.

19. I have received several awards identified on my *curriculum vitae*, which is being included in this proceeding as Ex. 2028. I am a Fellow of the American Association for the Advancement of Science, the Society of Manufacturing Engineers, and the American Society of Mechanical Engineers, and an elected member of the U.S. National Academy of Engineering.

B. MATERIALS CONSIDERED

20. In addition to my years of experience, I have considered at least the following materials in performing my analysis for this Declaration: (1) the materials listed in Mr. Babcock's March 15, 2024 declaration, (2) the transcript from Mr. Babcock's deposition in this matter, (3) the Declaration of Daniel R. Kane (Ex. 2020) and the exhibits referenced therein, which I understand are being submitted

concurrently with my declaration in this matter, and any other document referred to herein.

II. LEGAL STANDARDS

21. I am not a legal expert and offer no opinions on the law. In preparation for this declaration, counsel has informed me of certain legal standards as they relate to patent law, and in particular as to practice at the Patent Trial and Appeal Board (“Board”). A summary of the relevant legal standards I applied in my analysis appear below.

22. I understand that the person of ordinary skill in the art (“POSITA”) is a hypothetical person who is presumed to have known the relevant art at the time of the invention. I further understand that the factors that may be considered in determining the ordinary skill in the art include the following: the type of problems encountered in the art, prior art solutions to those problems, rapidity with which innovations are made, sophistication of the technology, and the educational level of workers in the field.

23. I understand that the claims within a patent set forth what the inventors have presented as their inventions. I understand that claims can be independent or in dependent form, meaning that they depend from the identified independent claim and add requirements to those claims.

24. I understand that claim construction is a matter of law for the arbiter of law to decide. I further understand that claim terms should be given their ordinary and customary meaning within the context of the patent in which the terms are used, i.e., the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention in light of what the patent teaches.

25. I understand that to determine how a person of ordinary skill would understand a claim term, one should look to those sources available that show what a person of skill in the art would have understood disputed claim language to mean. Such sources include the words of the claims themselves, the remainder of the patent's specification, the prosecution history of the patent (all considered "intrinsic" evidence), and "extrinsic" evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.

26. I understand that a person of ordinary skill in the art is deemed to read a claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. For this reason, the words of the claim must be interpreted in view of the entire specification. The specification is the primary basis for construing the claims and provides a safeguard such that correct constructions closely align with the specification.

27. I understand that claim terms must be construed in a manner consistent with the context of the intrinsic record. In addition to consulting the specification, one should also consider the patent's prosecution history.

28. I understand that in addition to the intrinsic record, the Board may also look to extrinsic evidence to construe claim terms. I understand that extrinsic evidence can be helpful in many ways, including to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history. However, any extrinsic evidence should be afforded less weight than the intrinsic evidence, as the intrinsic evidence is a better indicator of how the applicants understood their invention.

29. I understand that commonly, determining the ordinary and customary meaning of the claim requires examination of terms that have a particular meaning in a field of art. I understand that extrinsic evidence can educate the Board regarding the field of the invention and can help the Board determine what a person of ordinary skill in the art would understand claim terms to mean.

30. I understand that, unlike at the district court, patents subject to *inter partes* review at the Board are not presumed to be valid, such that a lower burden of proof is used to judge the patentability of challenged claims. Unlike the district court's "clear and convincing" burden, the applicable burden here is the "preponderance of the evidence."

III. LEVEL OF ORDINARY SKILL IN THE ART

31. I understand from counsel that the ‘808 Patent is analyzed from the viewpoint of a POSITA in and around February, 2017. My analysis and opinions below are given from the perspective of a POSITA in the technological field in the relevant time frame, unless stated otherwise.

32. In my opinion, the appropriate definition for a POSITA is as follows:

A person of ordinary skill in the art would have at least two years of product design experience and would have at least a high school education or equivalent certificate. Additional education could replace experience and vice versa.

I am qualified to offer opinions from the perspective of a POSITA having these qualifications.

33. Mr. Babcock proposes the following definition of a POSITA:

POSITA would have at least a bachelor’s degree in engineering (e.g., mechanical engineering) or a related field. Additionally, 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. 1002 at ¶ 31. I understand that the Board adopted this definition of a POSITA in its decision to institute review in this matter.

34. While I believe that Ridge’s proposed definition is more appropriate, I am also qualified to offer opinions from the perspective of a POSITA under Mr. Babcock’s proposed definition. I do so herein.

A. ANTICIPATION UNDER 35 U.S.C. § 102

35. I understand that, for a single prior art reference to be anticipating under 35 U.S.C. § 102, it must disclose each element of the claim, arranged as set forth in the claim. If a reference fails to expressly disclose one or more elements of the patent claim, the claim is anticipated only if the missing elements are disclosed inherently in the reference.

36. To establish such inherency, the evidence must make clear to a person of ordinary skill in the art that the missing claim element is necessarily present in the prior art reference or is the inevitable outcome of the process or thing that is explicitly described in the prior art reference. Inherency may not be established by a possibility, or even probability, that a certain result may arise from a given set of circumstances.

37. I understand that, to anticipate a patent claim, a prior art reference must have an enabling disclosure. That is; to anticipate a patent claim, the reference must provide sufficient information to allow one skilled in the art to practice what is required by the patent claim without undue experimentation.

38. Mountain Voyage is not asserting that any claim of the '808 Patent is anticipated.

B. OBVIOUSNESS UNDER 35 U.S.C. § 103

39. I understand that a patent claim can be invalid under 35 U.S.C. § 103 if the claimed subject matter as a whole would have been “obvious” to a POSITA as of the priority date of the patent based upon one or more prior art references.

40. I understand that an obviousness analysis should consider each of the following so-called “Graham factors”: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any (such as unexpected results, commercial success, long-felt but unsolved needs, failure of others, copying by others, licensing, and skepticism of experts).

41. I understand that a conclusion of obviousness may be based upon either a single prior art reference or a combination of prior art references. However, I understand that merely demonstrating that each of the claim elements was independently known in the prior art does not prove that a claim composed of several known elements is obvious. In other words, I have been informed that obviousness requires more than a mere showing that the prior art includes separate references covering each limitation in a claim. Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those elements in the normal course of research and development to yield the claimed invention.

42. Moreover, I understand that it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention requires.

43. I further understand that, to determine obviousness, the law instructs the Board to look to the interrelated teachings of multiple patents or other prior art references, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art.

44. I also understand that, in determining whether a combination of prior art references renders a claim obvious, it may be helpful to consider whether there is some teaching, suggestion, or motivation to combine the references and a reasonable expectation of success in doing so. I understand, however, that the teaching, suggestion, or motivation to combine inquiry is not required and may not be relied upon in lieu of the obviousness analysis outlined above.

45. I understand that the following exemplary rationales may lead to a conclusion of obviousness: the combination of prior art elements according to known methods to yield predictable results; the substitution of one known element for another to obtain predictable results; and the use of known techniques to improve similar devices in the same way.

46. However, a claim is not obvious if the improvement is more than the predictable use of prior art elements according to their established functions. Similarly, a claim is not obvious if the application of a known technique is beyond the level of ordinary skill in the art.

47. Further, when the prior art teaches away from combining certain known elements, discovery of successful means of combining them is not obvious. I understand that similar subject matter may not be sufficient motivation for a person of skill in the art to combine references if the references have conflicting elements.

48. I understand that, in order to be used in an obviousness combination, a prior art reference must be “analogous.” I understand that a prior art reference may be analogous if it is in the same field of endeavor as the other references with which it is combined, or if the reference is reasonably pertinent to solving the problems the inventors of the patent-at-issue sought to solve.

49. I understand that obviousness of a patent claim cannot properly be established through hindsight, and that elements from different prior art references, or different embodiments of a single prior art reference, cannot be selected to create the claimed invention using the invention itself as a roadmap. I understand that the claimed invention as a whole must be compared to the prior art as a whole, and the Board must avoid aggregating pieces of prior art through hindsight that would not have been combined absent the inventors’ insight.

50. I understand that obviousness is not established by simply combining previously known elements from the prior art. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. An invention is unpatentable as obvious if the differences between the patented subject matter and the prior art would have been obvious at the time of invention to a person of ordinary skill in the art.

51. I understand that obviousness of a patent cannot properly be established by mere conclusory statements. Instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. When an expert opines that all the elements of a claim disparately exist in the prior art, the expert should provide the rationale to combine the disparate references. A reason for combining disparate prior art references is a critical component of an obviousness analysis. The obviousness analysis should be made explicit and needs to provide an articulated reasoning with some rational underpinning to identify the reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention requires.

52. I also understand that 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. This is another

reason why merely pointing to the elements being known in the art in separate locations is not the end of the obviousness inquiry.

53. I understand that technical experts may testify to matters like the level of skill in the art at the time of the invention and what a skilled artisan might find obvious in light of the prior art without addressing objective indicia of non-obviousness. However, where an expert purports to testify not just to certain factual components underlying the obviousness inquiry, but to the ultimate question of obviousness, the expert must consider all factors relevant to that ultimate question, including all objective evidence of nonobviousness. Accordingly, I have undertaken such considerations here.

54. I understand that, to render obvious a patent claim, the prior art references must be enabling. That is, the references must provide sufficient information to allow one skilled in the art to practice what is required by the patent claim without undue experimentation. I understand that, while a prior art reference may support any finding apparent to a person of ordinary skill in the art, prior art references that address different problems may not, depending on the art and circumstances, support an inference that the skilled artisan would consult both of them simultaneously.

55. I also understand that obviousness does not exist where the prior art discourages or teaches away from the claimed invention.

56. I also understand that in evaluating whether patent claims are invalid as obvious, objective indicia of nonobviousness can be considered. Such objective indicia of nonobviousness can include:

- (a) long-felt and unmet need in the art that was satisfied by the invention of the patent;
- (b) failure of others to achieve the results of the invention;
- (c) commercial success or lack thereof of the products and processes covered by the invention;
- (d) deliberate copying of the invention by others in the field;
- (e) taking of licenses under the patent by others;
- (f) whether the invention was contrary to the accepted wisdom of the prior art;
- (g) expression of disbelief or skepticism by those skilled in the art upon learning of the invention;
- (h) unexpected results achieved by the invention;
- (i) praise of the invention by others skilled in the art; and
- (j) lack of contemporaneous and independent invention by others.

57. I understand that the obviousness analysis requires a comparison of the properly construed claim language to the prior art on a limitation-by-limitation basis.

C. AVOIDANCE OF IMPERMISSIBLE HINDSIGHT

58. It is my further understanding that although the “teaching, suggestion or motivation” test is not the sole test for judging whether art can be combined for the purposes of an obviousness assertion, the use of “impermissible hindsight” is still inappropriate when making such an assertion.

59. I understand that it is impermissible to use hindsight to arrive at the claimed invention. My understanding is that to preclude hindsight in the obviousness analysis, which I understand to be improper, there must be evidence, at the time of the invention, there was some rationale or reason to make the variation or combination. While this reason can come in the form of a teaching, suggestion, or motivation, such a rigid test is not required. Exemplary rationales that may support a conclusion of obviousness include:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

- (E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

60. I understand that this list is not exhaustive, but it is instructive as to the types of reasons that are acceptable. Regardless, there must be some sort of factual underpinning to the rationale to support a finding of obviousness, and these factual underpinnings are paramount to ensuring that hindsight bias does not impermissibly infect an obviousness opinion. For example, an invention composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. I understand that a conclusion of obviousness based on this reasoning would be improper because it is based on impermissible hindsight.

61. I understand that the phrase “blueprint” is sometimes used to describe a situation where an obviousness analysis improperly starts from the claims of a

patent, and works backward, using the claims as a “blueprint” to piece together the disclosures of prior art references where there is no proper rationale for combination.

D. REBUTTING ASSERTIONS OF INVALIDITY

62. Unlike proving infringement (where all elements of the asserted claims must be found in the accused product), to rebut an assertion of invalidity, it is my understanding that it is only necessary to show that at least one of the limitations of a patent claim is not found in the prior art. In the case of multiple reference obviousness combinations, I understand that a showing that the references would not be combined by a POSITA is also sufficient to defeat an assertion of unpatentability. That is what I have done herein. Moreover, my decision not to address certain elements of the ‘808 Patent’s claims should not be considered to be an admission that those other limitations are found in the art cited by Mr. Babcock or that any alleged combination is proper.

IV. RESPONSE TO MR. BABCOCK’S CRITICAL DATE ANALYSES

63. Mr. Babcock spends substantial time opining about the issue of a “critical date,” which I understand is the date used to determine whether certain items are, or are not, prior art. Ex. 1002 at ¶¶ 49-61. It is my understanding that none of the items Mr. Babcock relies on have dates that fall in between the earliest filing date of the family of the ‘808 Patent (i.e., May 7, 2015) and the filing date of the application that led to the ‘808 Patent itself (i.e., February 1, 2017). Accordingly,

at this point in time there is no reason to respond to Mr. Babcock's critical date commentary, as it is not germane to any dispute for the Board to resolve.

V. RESPONSE TO MR. BABCOCK'S PROSECUTION HISTORY SUMMARY

64. Mr. Babcock discusses the prosecution of the '808 Patent. Ex. 1002 at ¶¶ 62-68. The only item I would add to Mr. Babcock's analysis is that during examination, the Examiner rejected the pending claims as obvious over Kane in view of U.S. Patent No. 5,038,985 to Chapin ("Chapin"). Ex. 2005; Ex. 1004 at 70. In particular, the Examiner used Chapin (a reference that discloses an externally mounted clip mounted on the exterior of a non-expandable plastic housing) to reject claims that, at that time, recited nearly the identical limitations that were added to the claims to secure allowance:

20. The method of claim 19, wherein the at least one recess has an undercut and the at least one tang has a hook, the hook and undercut interpositioned to secure the at least one auxiliary feature against inadvertent dislodgement.

Ex. 1004 at 38. This confirms that the Examiner considered references like Beckley, Pelz, and Matthews in combination with Kane and nevertheless found the claimed subject matter to be patentable.

65. I note that Mr. Babcock omits this aspect of the prosecution history from his summary, but that it demonstrates the non-combinability of the references he relies on and the non-obviousness of the claims of the ‘808 Patent.

VI. RESPONSE TO MR. BABCOCK’S CLAIM CONSTRUCTION ANALYSIS

66. Mr. Babcock discusses the construction of certain claim terms of the ‘808 Patent. Ex. 1002 at ¶¶ 73-95.

67. With regard to the claim term “channeling means,” I apply the same definition Mr. Babcock applies, as follows:

Function: 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.

Structure: A groove spanning the extent of one or more of the rigid plates or a longitudinal bore through each rigid plate.

Ex. 1002 at ¶¶ 73-76.

68. Mr. Babcock also presents specific definitions he believes apply to the terms “recess,” “hook,” and “undercut.” Ex. 1002 at ¶¶ 78-95. The District of Colorado has since construed those terms to have their “plain and ordinary meaning.” In addition, I understand that since Mr. Babcock submitted his declaration, the Board has found that the terms “hook,” “undercut,” and “recess” require no specific construction, and thus should be accorded their “plain and ordinary meaning” to a POSITA. Ex. 1023. As such, I will use the same

construction (i.e., the “plain and ordinary meaning”) for the terms “hook,” “undercut,” and “recess” for purposes of my analysis here. Ex. 1023.

VII. PURPORTED PRIOR ART REFERENCES

A. KICKSTARTER – THE RIDGE WALLET 2.0 (“KANE”) (EX. 1006)

69. Kane, which is Ex. 1006 in this proceeding, is a Kickstarter page that illustrates various iterations of various wallet products that are predecessors to Ridge’s current product (and predecessors to the items illustrated and claimed in the ‘808 Patent).

70. Importantly, missing from each wallet shown and described in Kane is any kind of removable money clip (or other auxiliary component) that can be removed from one of the plates of the illustrated wallet. Instead, the money clip is always integrated with the rigid plates; in the event a change is desired, the entire outer plate would need to be removed and replated. This design approach is vastly different, and vastly simpler, than the one reflected in the device illustrated in the ‘808 Patent, which requires interaction between three very thin, rigid, plates to permit removability and reinstallation of an “auxiliary feature” without replacement of the plates of the wallet itself.

71. I understand from reading the declaration of Mr. Daniel Kane (Ex. 2020), that in designing the Kane reference, he did not contemplate a removable money clip. *Id.* at ¶¶7-8. Instead, given the tolerance issues and manufacturing

options available to him at the time, the modularity contemplated in the Kane reference involved removing entire plates and replacing them plate-at-a-time. *Id.* I also understand from Mr. Kane that Mr. Kane (and others of skill in the relevant art) were not thinking in terms of modularity on a feature-by-feature basis. *Id.* Moreover, I understand from Mr. Kane that he is not even aware of manufacturers or manufacturing techniques that could have created the modular money clips present in Ridge's wallets today (and described and claimed in the '808 Patent) in the time frame of the '808 Patent. *Id.* at ¶8.

72. Thus, it is my opinion that the differences between Kane and the '808 Patent's designs are substantial; this is borne out in the fact that the United States Patent and Trademark Office considered Kane, and allowed the '808 Patent anyway. It did so over references like U.S. Patent No. 5,038,985 to Chapin (Ex. 2005) and U.S. Patent No. 7,334,616 Kaminski (Ex. 2006), which each disclose money clips but which the Examiner did not consider to be combinable with Kane to render the claims of the '808 Patent obvious.

73. As an engineer, the design considerations that go into a mating arrangement like in the '808 Patent are a level far beyond the simple, unitary (sometimes welded) construction techniques that were used to make the products described in Kane. Appropriate metals, and metal bending techniques, to provide the requisite spring force while being removably mountable in a way to

accommodate the internal structure of Kane, were not trivial considerations and would have taken considerable engineering expertise, material selection expertise, and trial and error. Particularly if one did not have the benefit of starting from Mr. Kane's design in the '808 Patent (as Mr. Babcock impermissibly does), I do not believe a POSITA would not have found it obvious to incorporate a money clip into Kane that was removable from the plate-sandwich pairs for this reason.

74. The fact that the drastic success of the Ridge product coincided not with the initial Kickstarter, but with the timing of Mr. Kane's further innovation about a removable money clip, further demonstrates that the missing feature in the Kickstarter pages was not a coincidence: it was instead the case that the addition of the patented features was indeed a patentable improvement. Ex. 2020 at ¶25. And the fact that each of Beckley, Pelz, and Matthews predates Kane, (Ex. 1007 at 1; Ex. 1008 at 1; Ex. 1009 at 1) but yet was not actually incorporated into the device of Kane until Mr. Babcock did so with perfect hindsight, further confirms the non-obviousness of the proposed modifications to Kane.

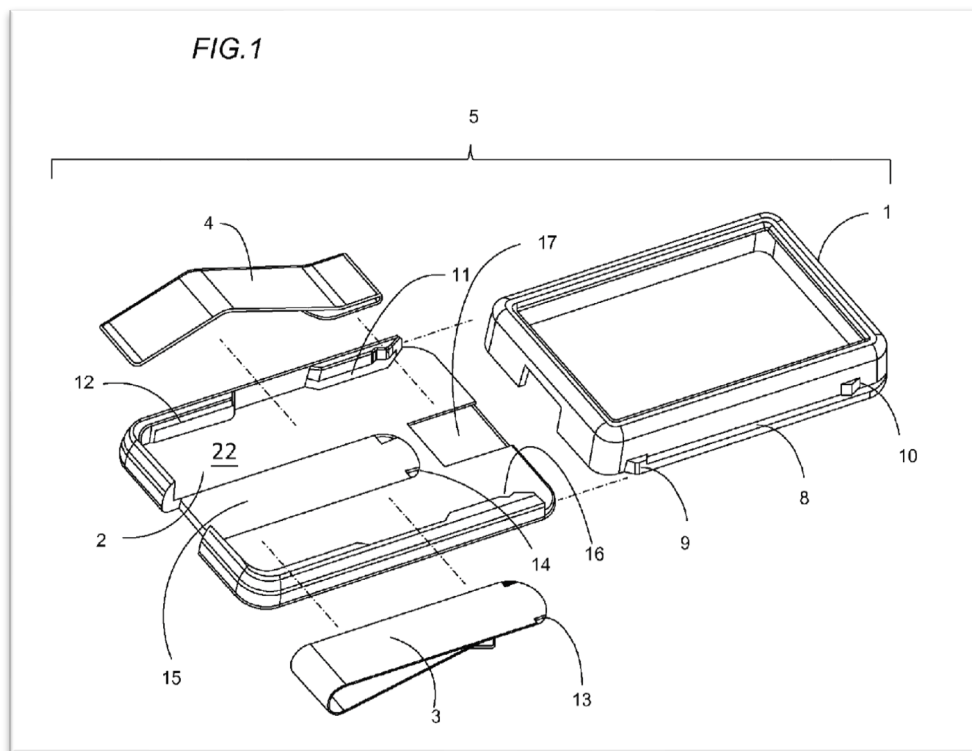
B. U.S. PATENT PUBLICATION NO. 2014/0060712 ("BECKLEY") (EX. 1007)

75. Beckley, which is Ex. 1007 in these proceedings, was not considered during examination of the '808 Patent. It is directed to a wallet-like device that works by a sliding arrangement between a cavity-having portion and a cover portion.

Ex. 1007 at ¶ 8. It relies on a retention spring inside of the “container portion” to retain items contained in that portion.

76. Beckley discloses that the outer structures of its devices are formed of rigid materials, like plastics or elastomers. Ex. 1007 at ¶ 33. It does not discuss the use of elastic, nor does it discuss an expandable item like that described in the ‘808 Patent. Instead, Beckley always has the same outer dimensions, and is not expandable in the same way as either Kane or as the claims of the ‘808 Patent.

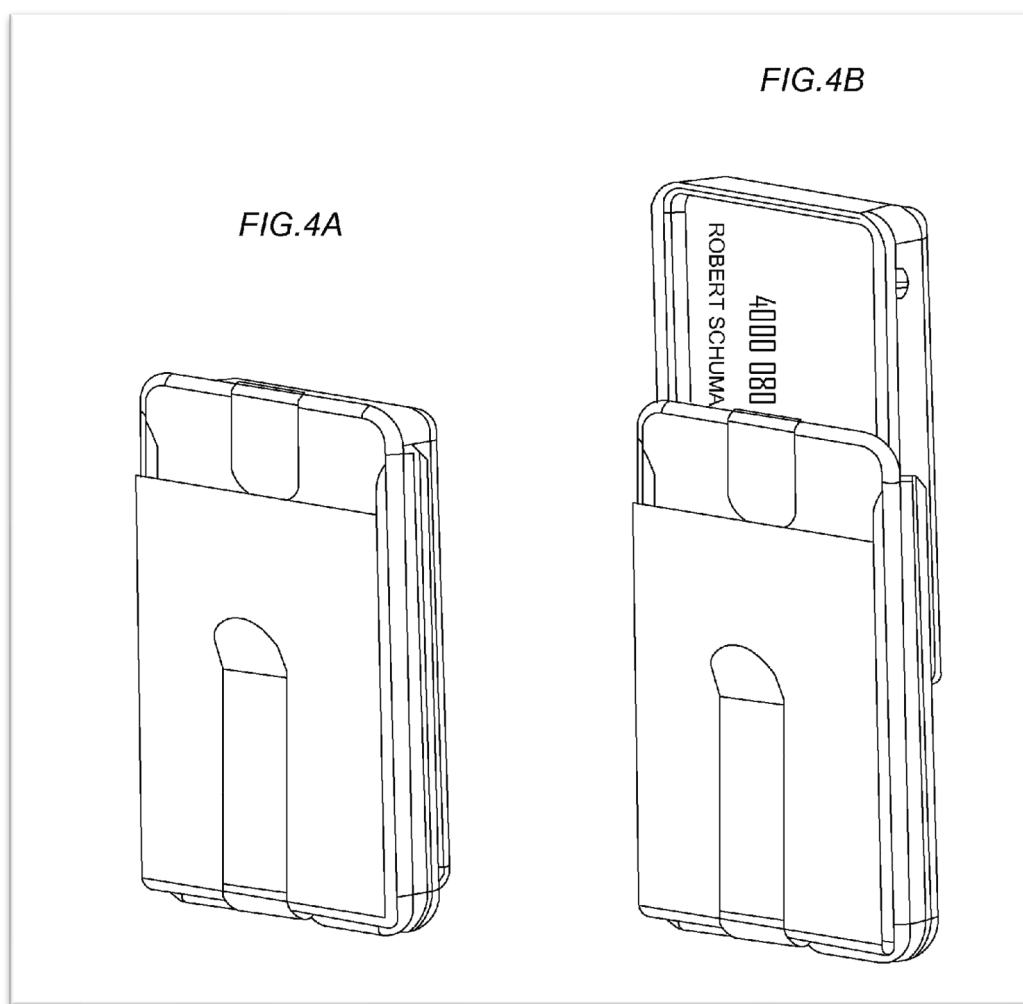
77. Figure 1 of Beckley is representative:



78. With regard to Figure 1, Beckley states as follows: “The clip 3 is assembled to the base 2 by inserting the clip 3 into a depression 15. It is held in place by a pair of barbs seen at 13 mated into a set of cavities 14 on the base 2. The

retention spring 4 is assembled to the base 2 by sliding it onto a pocket 17.” Ex. 1007 at ¶ 38. Notably, this is the only portion of Beckley that discusses items 13 (which Beckley refers to as “barbs”).

79. As I noted above, Beckley relies on a sliding relationship between rigid parts to secure contents (e.g., credit cards). That arrangement can be seen in Figures 4A and 4B, where the wallet is closed (left) and open (right):



80. Beckley does not rely on any “sandwich” construction, and it does not rely on expandable volume achieved using elastic. Indeed, the outer size and shape

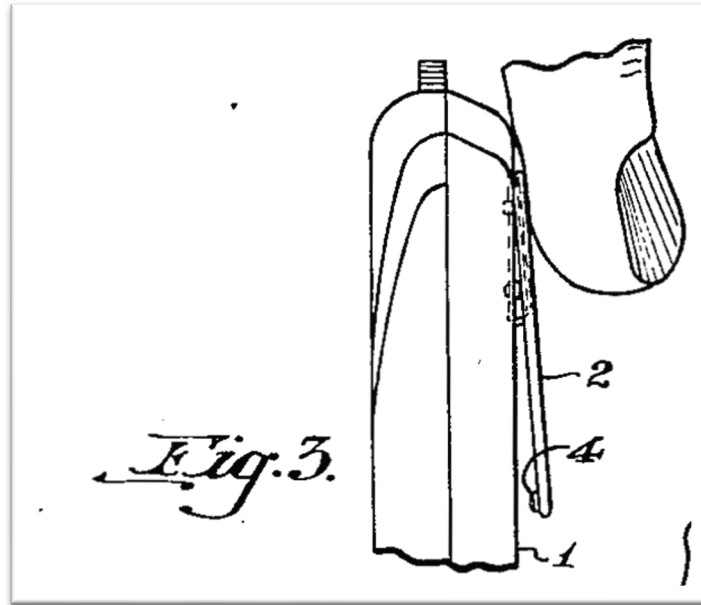
of Beckley's wallet appears to always be the same, regardless of the number of credit cards or other items held therein. Thus, the teachings of Beckley (and the mechanical design considerations that underly Beckley's design) are very different from those of Kane and the '808 Patent, where compactness based on an expandable design was paramount. Ex. 1006 at 2.

C. U.S. PATENT NO. 2,326,558 ("PELZ") (EX. 1008)

81. Pelz, which is Ex. 1008 in this proceeding, was not considered during examination of the '808 Patent. However, it is a very old reference (filed in 1943) directed to a case for holding electronics and as such, it is my opinion that it is particularly irrelevant to the '808 Patent. In general, if the techniques of Pelz had been applicable to the technology in the '808 Patent, they would have been reflected in Kane, and it would not be necessary to rely on a 70-year-old reference.

82. More particularly, Pelz is directed to a spring clip for a microphone unit for a hearing aid system. Ex. 1008 at 1:1-12. It is not directed to wallets at all; this is not surprising, as its teachings were inapplicable to wallets (or compact wallets) before the filing of the '808 Patent.

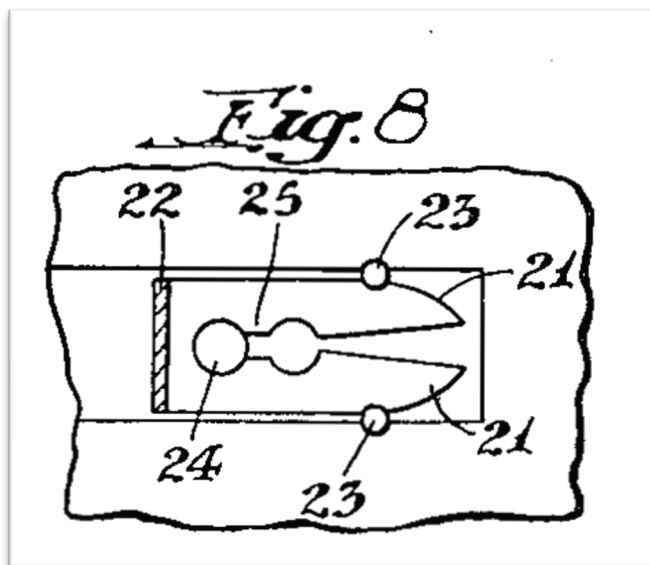
83. As can be seen in Figure 3, Pelz's device enables a user to push, with his or her thumb, to expand a clip to engage the fabric of the user's clothing:



84. In other words, the clip of Pelz relies on a fulcrum in the *middle* of the clip; it is important in the context of the hearing aid electronics device disclosed therein that a user can manually open and close the clip, to selectively fasten the clip to and remove the clip from his or her clothing. Ex. 1008 at 2:22-25.

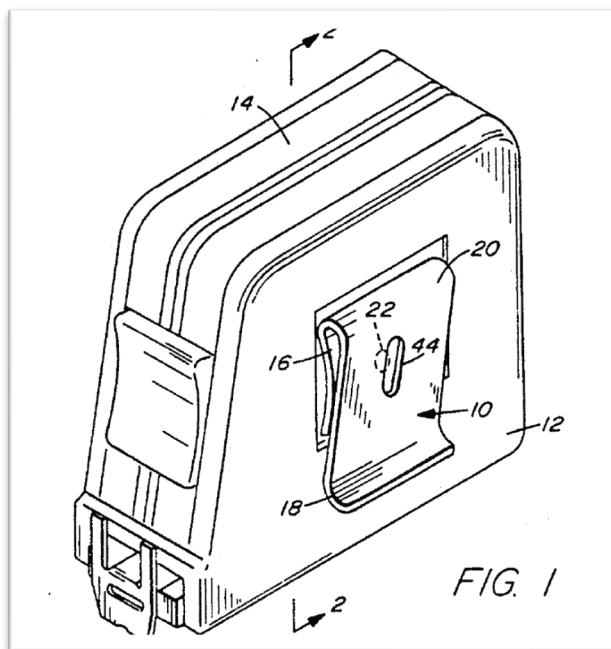
85. Given this particular mechanism, a POSITA would have been particularly unmotivated to apply Pelz's teachings to Kane; Kane already relies on a fulcrum design like Pelz, and the fact that the '808 Patent specifically moved away from that design indicates the inapplicability of such a design in the modular money clip context. Thus, it is my opinion that there would have been no reason to replace the functional item in Kane with the identical thing in Pelz.

86. Pelz uses various techniques to secure the fabric-engaging clip to its body, including (as in Figure 8) a pair of pins 23 that prevent the clip from being accidentally removed from the body of the microphone element:



87. In all embodiments of Pelz, Pelz's clip is mounted to the *outside* of the body of the item it clips; it is never inserted or installed between a pair of plates of a multi-plate device.

88. I note that Pelz is very much like the Chapin reference (U.S. Patent No. 5,038,985, Ex. 2005) which was considered during examination of the '808 Patent. That reference discloses a removable clip for a tape measure, and the design considerations of Chapin are very similar to those of Pelz:



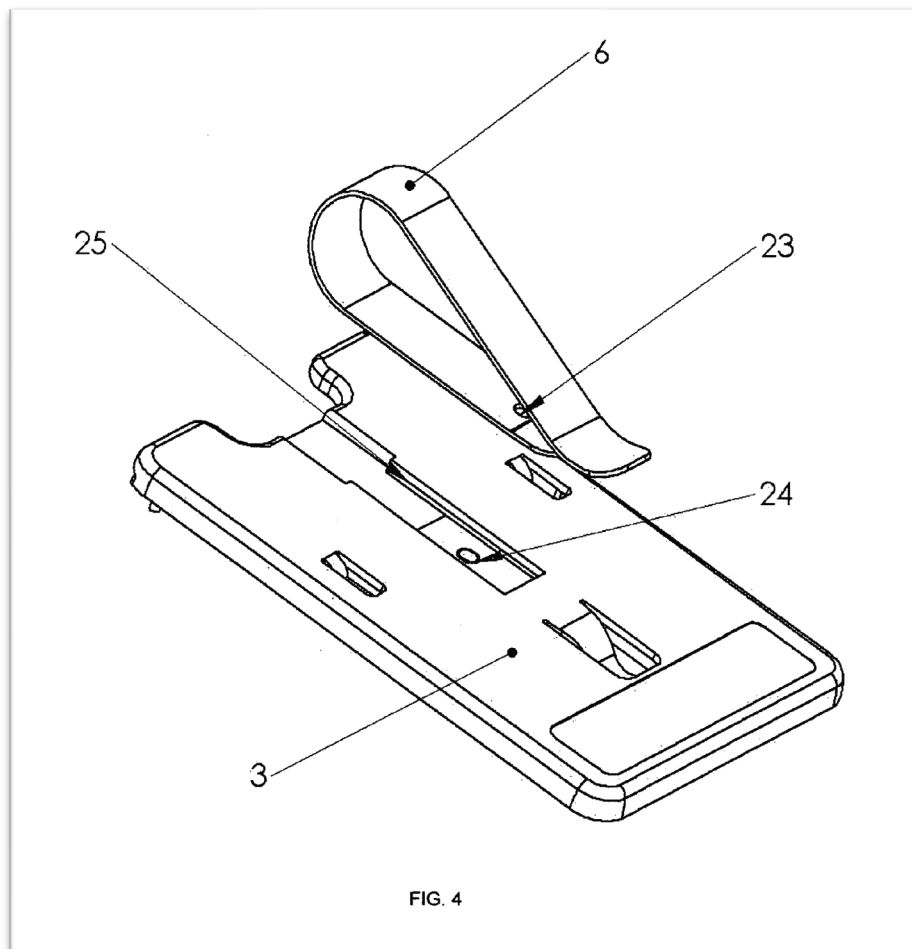
Ex. 2005 at Fig. 1.

89. Chapin, too, is not analogous to the Kane reference or the '808 Patent; I simply mention it because the Patent Office has already considered something very similar to Pelz in allowing the '808 Patent. That is, the Patent Office already determining that an apparel clip on the outside of a plastic case of a non-wallet item is not relevant to (and would not be combined with) Kane to result in the claims of the '808 Patent.

**D. U.S. PATENT PUBLICATION NO. 2009/0134223
("MATTHEWS") (EX. 1009)**

90. Matthews, which is Ex. 1009 in the instant proceeding, was not considered during examination of the '808 Patent. It is directed to a completely different use-case than the '808 Patent: holding a single card for scanning, e.g., on

the visor of an automobile. Ex. 1009 at Abstract. It discloses that the primary purpose of the card holder is to access (e.g., display) information about the single card that is in the holder on some external electronics of the device. Ex. 1009 at ¶ 4. Matthews' construction is similar to that of Beckley (and thus, by extension, Kaminski); it is a two-piece plastic device which is not designed to expand as more items are added to it.



92. Matthews also provides the following detail of the purpose and operation of its disclosed clip:

[0041] The outer back face of the case provides a slot feature to attach a metal or plastic mounting clip. This clip, when present, allows the holder to be mounted conveniently in many different places. Furthermore, 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 can be overcome by a prying or transverse force (although one which may be applied with a person's hands) to allow the clip to be removed. This design allows for secure retention of the clip but also for user assisted removal if desired. If removed, the holder may be mounted in still further possible locations by the use of adhesives, tape, hook and loop fasteners, magnets or any other method of mounting which may be desired.

Ex. 1009 at ¶ 41.

93. In other words, the clip of Matthews mounts to the *outside* of the device, and is removable upon a prying or transverse force. What that means is that a user must *lift* the portion of the clip that engages the outside of the single card holder of Matthews to remove it. This lifting operation would not be possible if the clip of Matthews was inserted in between a pair of surfaces; as such, the Matthews clip design is very specific and limited to the device disclosed in Matthews. In my opinion, Matthews is directed to an entirely different application, and relies on entirely different mechanical engineering techniques, than those involved in inserting a modular money clip in between the sandwiched outer plates of Kane.

VIII. ALLEGED INVALIDITY OVER THE PRIOR ART

94. As a general matter, the combinations Mr. Babcock tries to make are based on a very similar rationale. In particular, in each combination, Mr. Babcock concedes that the same primary reference—Kane, Ex. 1006—is missing elements 1[f], 1[g], 1[h], and 1[i] (Ex. 1002 at ¶¶ 169-198 (Ground 1); Ex. 1002 at ¶¶ 499-528 (Ground 2); Ex. 1002 at ¶¶ 778-809 (Ground 3)), 14[e], 14[f], 14[g], and 14[h] (Ex. 1002 at ¶¶ 322-349 (Ground 1); Ex. 1002 at ¶¶ 599-631 (Ground 2); Ex. 1002 at ¶¶ 882-913 (Ground 3)), and 19[e], 19[g], 19[h], 19[j], 19[k], 19[l], and 19[m] (Ex. 1002 at ¶¶ 392-447 (Ground 1); Ex. 1002 at ¶¶ 668-721 (Ground 2); Ex. 1002 at ¶¶ 950-1015 (Ground 3)). He relies on the secondary references (Beckley, Ex. 1007, Ground 1), Pelz (Ex. 1008, Ground 2), and Matthews (Ex. 1009, Ground 3), in combination with Kane, to remedy those deficiencies. As such, and for ease of reference, I will refer to these limitations that Mr. Babcock acknowledges are not present in Kane, and which generally relate to the interrelationship between hooks, tangs, and recesses of a removable auxiliary feature, as the “Missing Kane Limitations.”

A. UNIVERSAL OBSERVATIONS REGARDING COMBINABILITY

95. As noted above, Mr. Babcock admits that Kane lacks certain important claim elements related to a removable auxiliary feature and its engagement with the body of the compact wallet, and essentially tries to “bolt on” several different

references to fill these gaps in Grounds 1 to 3 of his Declaration. In general, none of the rationale I understand need to be assessed to support a finding of combinability are satisfied for any of those Grounds; I provide additional, reference-specific analysis in the sections that follow where there are specific, unique problems with Mr. Babcock's analysis (e.g., where the non-Kane reference is non-analogous art).

96. I provided my understanding of the various combination factors as a legal matter above; I will address each, in turn, below.

(A) Combining prior art elements according to known methods to yield predictable results

97. None of the proposed combinations Mr. Babcock articulates are made according to "known methods." The Kane reference defines an industry-creating silhouette, and the sandwiched arrangement with elastic between plates was not something known before Kane. Indeed, it is this sandwiched arrangement that permits Kane to expand and contract as cards are added or removed, all while minimizing the overall dimensions of the compact wallet. Ex. 1006 at 2 (With an integrated elastic track, The Ridge 2.0 can accommodate various numbers of cards without losing elasticity; providing an extremely thin wallet that isn't limited in its [sic] capacity."). It further confirms this primary design consideration by illustrating this concept:



Ex. 1006 at 5.

98. The uniqueness of this design can be seen by the simple recognition that each of Beckley, Pelz, and Matthews are directed to devices (indeed, for Pelz and Matthews, not even wallets) that have fixed exterior dimensions. Ex. 1007 at Fig. 2A; Ex. 1008 at Fig. 2; Ex. 1009 at Fig. 1).

99. Thus, there were no “known methods” to modify something like Kane in the way that would be needed to result in the claims of the ‘808 Patent.

100. Mr. Kane’s testimony itself confirms this: he knew he wanted a money clip on the wallet, but the “known methods” he used to add those money clips were either to make it integral with the outer plate, or to weld it to the outer plate. Ex. 2020 at ¶30. Both proved to be unworkable, and it was the inventions described in the ‘808 Patent that permitted Mr. Kane (and Ridge’s product offering) to take off commercially. Ex. 2020 at ¶ 25.

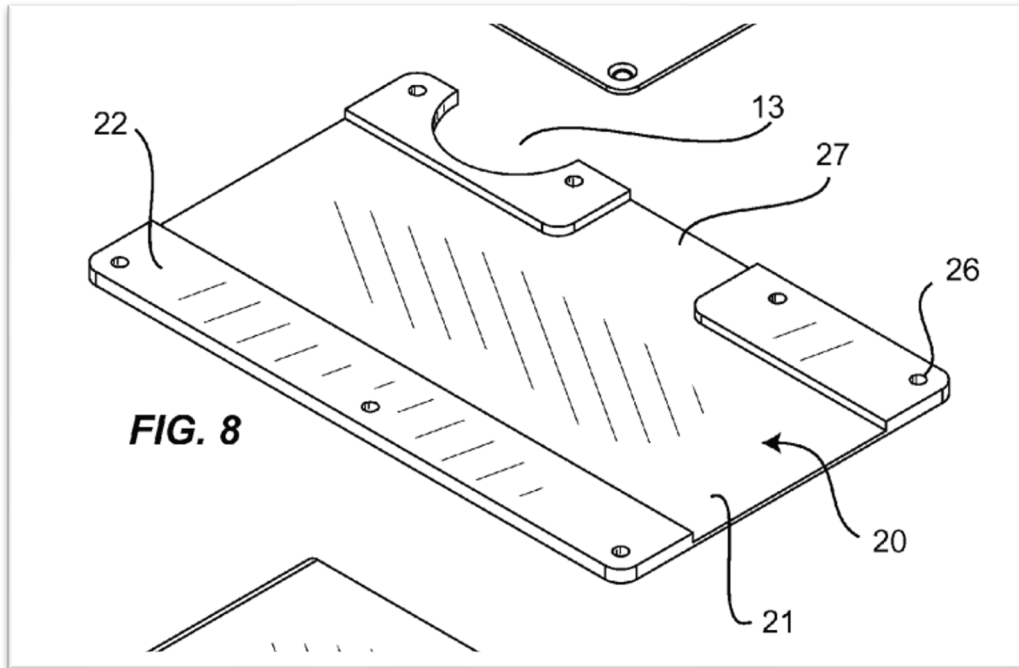
101. Thus, the combinations Mr. Babcock advocates are not examples of combining “known elements according to known methods to yield predictable results.” If anything, the results seem predictable today because of the astronomical

success Ridge has enjoyed since it introduced the ‘808 Patent technology, but almost a decade ago, they were not “known.”

(B) Simple substitution of one known element for another to obtain predictable results

102. Nor are the proposed combinations substitution of one known element for another. Mr. Babcock does not identify a single reference (in the wallet space or otherwise) where a money clip is insertable in between a sandwich of two other layers securely enough to reliably hold cash but not so permanently that it is not removable. In Beckley, the clip goes around a single plastic plate (Ex. 1007 at Fig. 1, and in Pelz and Matthews the clip mounts to the outside of a plastic case (Ex. 1008 at Fig. 1; Ex. 1009 at Fig. 4).

103. Thus, his proposed combinations do not involve the substitution of any “known element” for the corresponding element in Kane. To the contrary, it appears that Ridge’s offerings according to Kane reflected the “known methods” that would be usable with a design like the one described therein; the identification of the techniques later described and claimed in the ‘808 Patent were unknown methods until Mr. Kane developed them and filed the ‘808 Patent. The filing of the parent of the ‘808 Patent, which focuses on a “cash strap” alternative, confirms that even by the filing of the ultimate parent in 2015, the claimed arrangements were not “known methods.” Ex. 2011. The figures in that patent do not reflect any way to accommodate a removable money clip:



Ex. 2011 at Fig. 8. Mr. Kane’s testimony confirms that he did not envision a removable money clip that could interface between sandwiched plates at that time. Ex. 2020 at .

104. Any assertion to the contrary is clouded by the fact that the ‘808 Patent’s methods are now well known, and universally copied at mass scale by vendors who sell products to Mountain Voyage and others. *See, e.g.*, Ex. 2008; Ex. 2020 at ¶¶ 20-21.

(C) Use of known technique to improve similar devices (methods, or products) in the same way

105. For the same reasons I described above, the techniques Mr. Babcock articulates to fill the admitted holes in Kane are not “known techniques” to improve similar devices in the same way. The techniques Mr. Kane developed to provide a

removable auxiliary feature that was sufficiently secure to hold cash, but to be removed and changed as desired, while still preserving Kane’s desired expandability and contractability, are not known techniques. Ex. 2020 at ¶¶9-10. It is unsurprising that his technique is thus not described in any of the prior art Mr. Babcock tries to combine with Kane.

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results

106. For the same reasons I described above, the techniques Mr. Babcock articulates to fill the admitted holes in Kane are not “known techniques.” With regard to the instant factor, the techniques are not even applicable to a known device that is ready for improvement. The Kane wallets were functional and successful in their own right; the Kickstarter commitments to them confirm that fact. Ex. 1006 at 2). They were not wanting for improvement, and were not ready for improvement to function as a compact wallet.

107. It was Mr. Kane’s recognition that the inventions of the ‘808 Patent would be needed to scale his business that caused Ridge’s sales to rise, and caused the proliferation of copycat manufacturers and sellers such as Mountain Voyage and others like it. Ex. 2020 at ¶¶59-64. Thus, in my opinion, since the Kane devices were not “ready for improvement,” this factor does not support obviousness (or combinability).

(E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success

108. I do not believe that the proposed combinations constitute choosing from a finite number of identified, predictable solutions. To the contrary, the lack of *any* solution to the clip-between-two-plates approach that ultimately found its way into the ‘808 Patent means that the solution Mr. Kane arrived at was NOT one of a finite, identified number of solutions. As I mentioned above, each of the clips in the prior art cited by Mr. Babcock mounts to one side or the other of a single piece of material: Beckley mounts to the inside of a single piece of plastic (Ex. 1007 at Fig. 5A) and Pelz and Matthews to the outside (Ex. 1008 at Fig. 2; Ex. 1009 at Fig. 4).

109. The solutions in the secondary references Mr. Babcock relies on are generally in the same category: methods for affixing clips to a single planar outer surface of an article. Of course, Mr. Kane’s own work as shown in Kane provides two such options for doing just that. But none of the combination references is an example of a clip-between-two-plates approach at all. Thus, I do not believe the solution Mr. Kane ultimately arrived on was “obvious to try” as would be required for this factor to apply. There is simply no disclosure in the prior art of a mechanism for removably attaching a clip in a sandwich-plate arrangement like that in Kane.

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art

110. The art in several of the references (Pelz, and Matthews) is not from the field compact wallets at all and, as I note below, those references are not analogous to the Kane reference. Ex. 1008 at 1:1-4 (“hearing aid microphone units”); Ex. 1009 at Title (“Card Holder-Reader”). And while Beckley is arguably a wallet, it is not expandable as it has a consistent outer dimension regardless of what is inside. Ex. 1007 at Fig. 1.

111. However, the references do all have a common denominator that they relate to clips to hold one item to the outside of another. Thus, I do not believe any of the arguments Mr. Babcock makes fall into this category, where work from an entirely different field of endeavor is being tried, due to design incentives or market forces, in the compact wallet space.

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

112. I am not aware of any specific teaching, suggestion, or motivation that would lead one to modify Kane in any way, much less in the way Mr. Babcock articulates for Grounds 1 to 3. As best I can tell, the only such item Mr. Babcock identifies and relies on extensively is the following statement: “Kane discloses turning a wallet ‘into a ‘system’ that can be completely disassembled by the user to replace the elastic and exchange outer plates for greater personalization. *See, e.g.,*

Ex. 1002 at ¶¶ 167, 182, 188, 196, 324, 342, 348, 394, 409, 420, 421, 428, 434 (regarding Ground 1).

113. But this does not constitute a teaching, suggestion, or motivation to do anything different than what Kane already does; its device captures each of these features. Mr. Kane, in fact, confirms that this was not what he meant by the concept of a “system.” Ex. 2020 at ¶¶12-15. This is unsurprising, given that Kane is essentially a sales piece touting its benefits, and not identifying shortcomings.

114. In short, I am not aware of any specific teaching, suggestion, or motivation to modify Kane’s working device, and especially not by bolting on different, incompatible money clips from Kaminski, Beckley, Pelz, or Matthews.

115. For the reasons given above, none of the obviousness rationale I understand may be applicable is in fact applicable to the combinations Mr. Babcock presents here. As I describe in more detail below on a Ground-by-Ground basis, I do not believe any of the proposed combinations is proper.

B. GROUND 1 – KANE IN VIEW OF BECKLEY (OBVIOUSNESS)

1. Claim 1

116. Mr. Babcock admits that Kane (Ex. 1006) does not include the Missing Kane Limitations with respect to this claim in Ground 1. Ex. 1002 at ¶¶ 169-198. Mr. Babcock tries to plug the admitted holes (i.e., the Missing Kane Limitations) with Beckley. Ex. 1007. Mr. Babcock has both failed to show that the combination

of Kane and Beckley is proper, and has failed to that each of the above-noted Missing Kane Limitations is, in fact, obvious based on the combination of references in Ground 1.

117. Kane relies on a pair of sandwiches (Ex. 1006 at 5) to accommodate elastic in each of its two plates; Beckley, to the contrary, relies on single-piece plastic construction and permits slidable engagement between two non-expanding items (Ex. 1007 at Fig. 1). Thus, the mechanical engineering design concepts of Beckley are very different from those of Kane, and a POSITA would not have been motivated to combine those references. In particular, a POSITA looking at Kane and desiring to maintain Kane's overarching design goal of expandability while minimizing thickness would not have considered the teachings of Beckley, whose clip 3 merely encircles the single layer of the fixed outer structure of the device, as a potential modifying teaching. Given the presence of the elastic strap of Kane at either end (and the need for the money clip to be external to that elastic band), the modification proposed by Mr. Babcock is improper. *See* Ex. 1006 at 5. The elastic band does not permit the same arrangement as what is disclosed in Beckley.

118. I do not believe the proposed combination/modification is proper under what I understand to be the legal standard for this analysis.

- **Claim 1[e] - an auxiliary feature removably attached to at least one of the at least two rigid plates**

119. Mr. Babcock does not demonstrate that any combination of Kane and Beckley is permissible, and thus cannot demonstrate that the combination discloses the claimed removably attached auxiliary feature.

120. With regard to the money clip 3 of Beckley, that item does not need to mate with a multi-layer stack of structures; it instead slips around a single plastic layer, and does not need to accommodate other internal structures (e.g., an RFID-blocking plate or an elastic band). Ex. 1007 at Fig. 1. Thus, a POSITA would not have been motivated (or had any other reason) to combine Beckley with Kane to simply add the clip 3 without relying on improper hindsight reconstruction.

121. Mr. Babcock notably does not mention Beckley when discussing limitations of the claims that relate to the sandwich arrangement and its accommodation of the elastic band of Kane.. For example, while he opines that Beckley discloses a “wallet 5 that is compact” (Ex. 1002 at ¶ 125), he conspicuously fails to address it when discussing the requirement that “at least two rigid plates interposed to sandwich card-like contents there between, each rigid plate having a longitudinal extent” (Ex. 1002 at ¶¶ 127-137), an “encircling elastic band” (Ex. 1002 at ¶¶ 138-144), and a “channeling means” (Ex. 1002 at ¶¶ 145-153). Indeed, for elements 1[b], 1[c], and 1[d], he does not cite Beckley’s disclosure at all. *Id.* And in discussing Kane’s disclosure of an “auxiliary feature,” he concedes by omission that Kane does *not* include an “auxiliary feature” that is “removably attached to at

least one of the at least two rigid plates.” Ex. 1002 at ¶ 155. In paragraph 156, for example, Mr. Babcock includes a sentence in which he *omits* the word “removably”: “Kane discloses multiple photographs, such as the photograph below, of wallets having a money clip (‘auxiliary feature’) attached [but not removably attached] to at least one of the interior plate-outer faceplate pairs (‘rigid plates’).” Ex. 1002 at ¶ 156.

122. That is, Mr. Babcock recognizes that Kane’s auxiliary feature is not removable from any plate (as is required). This constitutes a recognition, by Mr. Babcock, of the substantial difference in structure between Kane and Beckley, and underscores that a POSITA would not have combined these references because of the substantial difference in the underlying structure of Kane (which is germane to the environment for the auxiliary feature recited in claim 1 of the ‘808 Patent) and Beckley.

123. Mr. Babcock spends several paragraphs trying to explain why he believes a POSITA would have incorporated Beckley’s teachings into Kane with respect to the claimed “auxiliary feature,” but he is not persuasive. Ex. 1002 at ¶¶ 160-167.

124. First, he is incorrect that Beckley sandwiches contents between two plates. Ex. 1002 at ¶ 163. The plates of Beckley are fixed differences apart, and rely on an internal spring to reduce movement of cards in the case. Ex. 1007 at Fig.

1, ¶ 8. Notably, this approach is completely different than the approach disclosed in Kane, where the wallet's external dimensions are as thin as possible given the contents being held therein. Ex. 1006 at 5. Thus, the design approach is completely different from that in Kane, and a POSITA would have found the two incompatible.

125. Second, while the clip of Beckley may indeed be designed to secure currency, Mr. Babcock's observations about RFID blocking in Kane do not bear on the non-combinability of Kane and Beckley. Ex. 1002 at ¶ 164. It is unclear why Mr. Beckley includes this observation in his declaration.

126. Mr. Babcock's remaining observations, at paragraphs 165-167, are aspirational observations of what a combination might look like, but the only actual *reason* to make a combination is to try to match the claims of the '808 Patent: quintessential impermissible hindsight. Ex. 1002 at ¶¶ 165-167. Notably absent from Mr. Babcock's explanation is how the incompatible disclosures of Kane and Beckley would fit together to result in this claim limitation. In my opinion, due to the difference in design approach, the designs are not compatible.

- **Claim 1[f] - the auxiliary feature having a tang insertable into a recess formed inside the at least two rigid plates**

127. Mr. Babcock opines that the combination of Kane and Beckley discloses this element. Ex. 1002 at ¶¶ 169-175. He is incorrect.

128. First, as I discussed above, the combination of Kane and Beckley is not proper. Mr. Babcock does not provide any rationale to support that proposed

combination other than using impermissible hindsight. And in my opinion, a POSITA would not have made the combination given the substantial design differences between Kane and Beckley (one is related to a pair of sandwiched items held together by elastic, where each “sandwich” must accommodate the elastic, and the other is a pair of rigid parts in slidable engagement with each other).

129. Mr. Babcock appears to agree that Beckley does not disclose a “recess formed inside a rigid plate.” Ex. 1002 at ¶ 172. He and I agree on this; the fact that Beckley is a single plate, and that the depressions 15 are in an outer surface of the single plate, means that Beckley cannot disclose a recess “inside” a rigid plate. Ex. 1007 at Fig. 1. He opines, however, that a POSITA would modify Beckley to form a recess *inside* of something. Ex. 1002 at ¶ 172. He gives no supportable rationale for that conclusion, other than his belief that the devices of Beckley and Kane are similar. *Id.* But that conclusion is based on an incorrect premise, as Kane is a design based on a pair of sandwiched plates where the outer dimensions change, and Beckley is based on single-layer plastic construction where the outside dimensions do not change. Ex. 1006 at 5; Ex. 1007 at Fig. 1. In addition, even if he is correct about similarity, that alone is not sufficient (to my understanding) to support a finding of obviousness. Mr. Babcock’s paragraph 172 analysis is only based on hindsight reconstruction: a goal of trying to piece the prior art together using the ‘808 Patent claims as a blueprint.

130. In addition, Mr. Babcock opines about a “continuation of one or more milling operations” from Kane as support for his proposed combination. But in particular with regard to Beckley, this is not true. Ex. 1002 at ¶ 173. The milling that would need to occur in Kane to result in the hindsight-reconstructed combination device is milling on the inner plate of the pair of plates disclosed in the preferred embodiment thereof. Ex. 1001 at Fig. 13. Instead, to my understanding, the process for forming the recesses 15 would need to occur for the plate to which the clip of Beckley attaches—that is, the outer surface of the device. Ex. 1007 at Fig. 1. Contrary to Mr. Babcock’s analysis about “continuation of milling operations,” then, the proposed combination would require an additional operation to modify a plate that, in Kane, is not modified (e.g., milled) at all.

131. My same analysis of Mr. Babcock’s prior combination analysis (e.g., regarding continuing milling steps) applies to his re-purposing of his prior analysis for this combination. Ex. 1002 at ¶ 174. The goal he identifies is “to provide a removably attachable money clip (‘auxiliary feature’) while minimizing the profile of the wallet” is based on hindsight reconstruction, not on any identifiable obviousness rationale. He is also incorrect about Kane’s disclosure; Kane does *not* articulate a desire for a money clip removably attachable from the plate of the wallet (Ex. 1006 at 6-7), and thus Mr. Babcock is incorrect in his analysis. Ex. 1002 at ¶ 174.

132. For all the reasons I have previously provided, Mr. Babcock's reliance on a functional reference (Kane) does not provide a reason to deviate from Kane's money clip approach, and certainly does not lead a POSITA to modifying Kane in view of Beckley to result in this claim limitation.

- **Claim 1[g] - The tang having a hook**

133. The item Mr. Babcock identifies as a tang does indeed have a hook; however, as discussed above and as detailed below, it is not the claimed hook.

134. Moreover, because (according to the claims) the tang is insertable in the recess, and the hook is a portion of the tang (and because of the engagement discussed below), the hook must be in the recess formed inside the at least two plates. Ex. 1001 at Claim 1. As I discussed in the prior limitation, there is no recess disclosed as claimed in Beckley, because it is merely a depression in a single piece of plastic. Thus, the item identified in Mr. Babcock's report may be *a* hook, but it is not the claimed hook.

135. In addition, reiterating my analysis of the prior limitation, there is no reason to modify Kane with Beckley to result in a hook as claimed. The structural differences between the two devices mean that Beckley's design is inapplicable to Kane's design; Mr. Babcock's analysis as to the combinability (Ex. 1002 at ¶¶ 180-182) is again solely based on impermissible hindsight reconstruction. He again seeks to create a Frankenstein's monster situation where features of which are

incompatible with the sandwich-plate design of Kane would nevertheless be added to Kane. There is simply no justifiable reason to make this modification.

- **Claim 1[h] - The hook extending at an angle to the tang**

136. The item Mr. Babcock identifies as a tang does indeed have a hook, and that hook does indeed extend at an angle to the tang. However, as I have already explained, the hook is not the claimed hook for various reasons. Mr. Babcock's analysis in this section does not change my prior analysis. Ex. 1002 at ¶¶ 186-188.

- **Claim 1[i] - The hook engaging an undercut of the recess to prevent inadvertent dislodgement of the auxiliary feature from the recess**

137. Finally with regard to the Missing Kane Limitations, I do not agree that Mr. Babcock has shown that it was obvious to modify Kane to result in a hook engaging an undercut of the recess to prevent inadvertent dislodgment of the auxiliary feature from the recess.

138. As I described above, there is no recess in a sandwich-plate environment in Beckley, and a POSITA would not have modified Kane to include a recess. As such, the item Mr. Babcock relies on as a "hook" does not engage an undercut of the claimed recess to prevent inadvertent dislodgment of the auxiliary feature from the recess.

139. Mr. Babcock's analysis in paragraphs 194-197 does not change the fact that the only basis for his proposed modifications via the combination of Kane and Beckley is hindsight reconstruction, which I understand is impermissible in an

obviousness analysis. Ex. 1002 at ¶¶ 194-197. Kane’s disclosure of wallets with outer plates that DO have money clips, and outer plates that DO NOT have money clips, is not a suggestion that it would be useful (or possible) to include a money clip that is removable from the outer plate itself. Ex. 1002 at ¶ 195. In fact, the failure to disclose a removable money clip indicates that compact wallet designers were not actually considering that modification at all. Ex. 2020 at ¶¶ 11-15.

140. Moreover, the fact that Kane advocates “personalization” in a “system” but does NOT include a removable money clip is indeed evidence that the proposed modification Mr. Babcock suggests is not proper. Ex. 1002 at ¶ 196. To the contrary, the fact that a system is provided where money clip preferences are only achievable with money clips that are non-removably mounted *only* to the exterior of the outer plate means that a POSITA would not have considered the proposed modification, which not only moves the money clip mount point to inside of the wallet, but requires forming recesses inside a pair of plates in a way not at all disclosed in Beckley. Ex. 1007 at Fig. 1.

141. In short, the proposed combination of Kane and Beckley is not proper, and even if it was, would no result in the arrangement recited in the Missing Kane Limitations where recesses *inside* outer plates engage with hooks of tangs as recited.

2. *Claims 2-9, 11-13, and 18*

142. These claims each depend from independent claim 1, and Mr. Babcock relies exclusively on the teachings of Kane for the additional requirements of dependent claims 2-9, 12, 13, and 18. Ex. 1002 at ¶¶ 203-216 (Claim 2); Ex. 1002 at ¶¶ 217-225 (Claim 3); Ex. 1002 at ¶¶ 226-232 (Claim 4); Ex. 1002 at ¶¶ 233-238 (Claim 5); Ex. 1002 at ¶¶ 239-244 (Claim 6); Ex. 1002 at ¶¶ 245-251 (Claim 7); Ex. 1002 at ¶¶ 252-258 (Claim 8); Ex. 1002 at ¶¶ 259-270 (Claim 9); Ex. 1002 at ¶¶ 278-287 (Claim 12); Ex. 1002 at ¶¶ 294-298 (Claim 13); Ex. 1002 at ¶¶ 374-377 (Claim 18). And while Mr. Babcock cites to Beckley as also holding credit cards with respect to Claim 11, he also relies on Kane for that analysis as well. Ex. 1002 at ¶¶ 271-277 (Claim 11).

143. Notably, Mr. Babcock provides no further combination analysis or rationale in his analysis of dependent claims 2-9, 11-13, or 18, meaning that my rebuttal to his combination analysis with respect to claim 1 is equally applicable to those claims.

144. Without conceding that the additional limitations of these dependent claims are present (particularly because the combination relied upon in Ground 1 is improper), at least the reasons given above with regard to claim 1 demonstrate Mr. Babcock's failure to show that these dependent claims are obvious.

3. *Claim 14*

145. Unlike independent claim 1, independent claim 14 does not affirmatively require the “auxiliary feature” to be a part of the claimed compact wallet. In other words, one could infringe claim 14 (or, in Ridge’s case, permissibly practice claim 14) by selling a wallet having the same internal structure required by claim 1, even if it is not sold with a money clip (the auxiliary feature) to engage those internal structures. Nevertheless, to show invalidity, Mr. Babcock would have to show a capability to interface with the requisite parts of a removable auxiliary feature. Nevertheless, Mr. Babcock admits that Kane does not disclose the Missing Kane Limitations of Claim 14 (i.e., claim elements 14[e], 14[f], 14[g], and 14[h]). Ex. 1002 at ¶¶ 322-349.

146. I hereby incorporate by reference my analysis of Claim 1 with respect to Ground 1 as if fully reproduced herein.

147. In particular, I incorporate my analysis of Claim 1[e] with respect to Mr. Babcock’s analysis of Claim 14[e]. Ex. 1002 at ¶¶ 322-327.

148. I incorporate my analysis of Claim 1[f] with respect to Mr. Babcock’s analysis of Claim 14[f]. Ex. 1002 at ¶¶ 328-333.

149. I incorporate my analysis of Claim 1[g] and Claim 1[i] with respect to Mr. Babcock’s analysis of Claim 14[g]. Ex. 1002 at ¶¶ 334-343.

150. I incorporate my analysis of Claim 1[h] with respect to Mr. Babcock's analysis of Claim 14[h]. Ex. 1002 at ¶¶ 344-349.

151. For the same reasons I gave with regard to claim 1, the limitations corresponding to the Missing Kane Limitations (i.e., Claim elements 14[e], 14[f], 14[g], and 14[h]) are not obvious in the form they show up in claim 14. For the same reasons I gave above with regard to claim 1, a POSITA would not have made the Kane-Beckley combination Mr. Babcock advocates for purposes of claim 14 without relying on impermissible hindsight bias and without using the claims of the '808 Patent as a blueprint to piece together the prior art as laid out in the claims. Because Mr. Babcock concedes Kane does not disclose all of the limitations of claim 14, if the combination fails, then his obviousness analysis also fails. Mr. Babcock's analysis of claim 14 is thus equally unavailing. Ex. 1002 at ¶¶ 322-349.

4. Claims 15-17

152. These claims depend from independent claim 14, and Mr. Babcock relies exclusively on the teachings of Kane with respect to the additional limitations of these dependent claims. Ex. 1002 at ¶¶ 358-363 (Claim 15); Ex. 1002 at ¶¶ 364-368 (Claim 16); Ex. 1002 at ¶¶ 369-373 (Claim 17).

153. Notably, Mr. Babcock provides no further combination analysis or rationale in his analysis of dependent claims 15-17, meaning that my rebuttal to his combination analysis with respect to claim 1 is equally applicable to those claims.

154. Without conceding that the additional limitations of these dependent claims are present (particularly because the combination relied upon in Ground 1 is improper), at least the reasons given above with regard to claim 1 demonstrate Mr. Babcock's failure to show that these dependent claims are obvious.

5. *Claim 19*

155. Claim 19 is essentially a method claim that corresponds to a method of using the device recited in Claim 1/Claim 14. That is, for example, independent claim 19 recites method steps such as “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.

156. However, Claim 19 also adds the requirement that the recesses be “outbound of the elastic band.” Ex. 1001 at Claim 19. Thus, in addition to showing the structures required inside the wallet by claims 1 and 14, Mr. Babcock would have to show that it would have additionally been obvious to position the recesses *outbound of the elastic band*.

157. In addition to his failings with respect to the Missing Kane Limitations (i.e., claim elements 19[e], 19[g], 19[h], 19[j], 19[k], 19[l], and 19[m]), Mr. Babcock also cannot show that it would have been obvious to provide the recesses in the requisite position.

158. Mr. Babcock admits that Kane does not disclose the Missing Kane Limitations of Claim 19 (i.e., claim elements 19[e], 19[g], 19[h], 19[j], 19[k], 19[l], and 19[m]). Ex. 1002 at ¶¶ 392-447.

159. I hereby incorporate by reference my analysis of Claim 1 with respect to Ground 1 as if fully reproduced herein.

160. In particular, I incorporate my analysis of Claim 1[e] and Claim 1[f] with respect to Mr. Babcock's analysis of Claim 19[e]. Ex. 1002 at ¶¶ 392-399.

161. I incorporate my analysis of Claim 1[i] and with respect to Mr. Babcock's analysis of Claim 19[g]. Ex. 1002 at ¶¶ 400-412.

162. I incorporate my analysis of Claim 1[i] and with respect to Mr. Babcock's analysis of Claim 19[h]. Ex. 1002 at ¶¶ 413-417.

163. I incorporate my analysis of Claim 1[g] and with respect to Mr. Babcock's analysis of Claim 19[j]. Ex. 1002 at ¶¶ 424-429.

164. I incorporate my analysis of Claim 1[g] and with respect to Mr. Babcock's analysis of Claim 19[k]. Ex. 1002 at ¶¶ 430-436.

165. I incorporate my analysis of Claim 1[h] and with respect to Mr. Babcock’s analysis of Claim 19[l]. Ex. 1002 at ¶¶ 437-440.

166. I incorporate my analysis of Claim 1[f] and with respect to Mr. Babcock’s analysis of Claim 19[m]. Ex. 1002 at ¶¶ 441-447.

167. For the same reasons I gave with regard to claim 1, the limitations corresponding to the Missing Kane Limitations (i.e., Claim elements 19[e], 19[g], 19[h], 19[j], 19[k], 19[l], and 19[m]) are not obvious in the form they show up in claim 19. For the same reasons I gave above with regard to claim 1, a POSITA would not have made the Kane-Beckley combination Mr. Babcock advocates for purposes of claim 19 without relying on impermissible hindsight bias and without using the claims of the ‘808 Patent as a blueprint to piece together the prior art as laid out in the claims. Because Mr. Babcock concedes Kane does not disclose all of the limitations of claim 19, if the combination fails, then his obviousness analysis also fails. Mr. Babcock’s analysis of claim 19 is thus equally unavailing. Ex. 1002 at ¶¶ 392-447.

168. In addition, as I noted, claim 19[e] requires “at least one groove additionally having at least one recess positioned outbound of the elastic band.” Ex. 1001 at Claim 19. This limitation is not explicitly present in the other independent claims. Mr. Babcock’s sole analysis of this limitation is as follows:

395. Moreover, a POSITA would have been motivated to form the depression (“recess”), like that disclosed by Beckley, in one or

more the interior plate-outer faceplate pairs (“rigid plates”), like that disclosed by Kane, outbound the encircling elastic band (“elastic band,” understood to reference the “at least one encircling elastic band”) to avoid interference between the function of the depression (“recess”) (e.g., to capture an auxiliary feature) and the function of the elastic band (e.g., to expand and contract while enabling the wallet to have elastic volume). (Ex. 1007 FIG. 1.)

396. For example, Beckley discloses the depression 15 (“recess”) as outbound a retention spring 4, where the retention spring serves to provide expansive/contractive volumetric capacity to the wallet similar to the elastic volume provided by the encircling elastic band of Kane. (Ex. 1007, FIG. 1.) A POSITA, reading Beckley, would have realized that the depression 15 (“recess”) is positioned outbound the retention spring 4 so as to avoid interference between the function of the depression 15 (“recess”) and the function of the retention spring 4. In doing so, such a POSITA would have been motivated to apply said teaching to the position of a depression (“recess”), like that disclosed by Beckley, in one or more of the interior plates; resulting in the depression (“recess”) being positioned outbound the encircling elastic band.

397. A POSITA would have looked to Beckley for guidance as to the outbound positioning of the depression (“recess”), like that disclosed by Beckley, in an interior plate-outer faceplate pair (“rigid plate”), like that disclosed by Kane, because Kane and Beckley are in the same technical field, address similar problems, utilize similar devices, and disclose methods that when combined function in the same manner as each does separately to yield predictable results, as set forth in Section IX.A.1.e; which is incorporated here. (Ex. 1006 at 2-5 and 8-9; Ex. 1007 at ¶¶ [0002], [0004], [0008], [0010], [0034], [0038]-[0039], and FIG. 1.)

398. In addition, A POSITA would have been motivated to form the depression (“recess”), like that disclosed by Beckley, in one or more the interior plate-outer faceplate pairs (“rigid plates”), like that disclosed by Kane, outbound the elastic band at least because said positioning is one of a finite number of identified, predictable positions, with a reasonable expectation of success. For example, there are a finite number of locations in the interior plate-outer

faceplate pairs (“rigid plates”), like that disclosed by Kane, where a depression (“recess”), like that disclosed by Beckley, could be positioned. Further, a POSITA would have reasonably predicted that positioning a depression (“recess”), like that disclosed by Beckley, outbound the encircling elastic band, like that disclosed by Kane, would result in successful operation of both the depression (“recess”) and the elastic band.

Ex. 1002 at ¶¶ 395-398. I disagree with Mr. Babcock’s analysis.

169. The only “analysis” of why a POSITA would position recesses outbound of the channel is Mr. Babcock’s statement that such a modification would be made to “to avoid interference between the function of the depression (“recess”) (e.g., to capture an auxiliary feature) and the function of the elastic band.” Ex. 1002 at ¶¶ 395-396. This is the epitome of hindsight reconstruction. There is no grounding whatsoever in the prior art references; Mr. Babcock merely uses the claims as a blueprint to modify the proposed combination of Kane and Beckley without any reason whatsoever. This is particularly true given that Mr. Babcock relies on the functionality of the spring 4 of Beckley as being somehow germane to the “groove” aspect of claim 19. Yet, in his analysis of the claimed “groove” (Ex. 1002 at ¶¶ 382-385), Mr. Babcock relies solely on the disclosure of Kane as teaching the claimed “groove.”

170. In my opinion, the difference in structure between Beckley, which is a fixed-size device with a spring to push cards against the top surface, and Kane, which is expandable and relies on a pair of plates whose distance from each other changes,

is exacerbated by Mr. Babcock's analysis of this element. There is no reason whatsoever that a POSITA would have analyzed the relationship between the purported "recesses" and the spring 4 of Beckley to affect the arrangement of *anything* with respect to the grooves of Kane. This difference is emphasized by the fact that Claim element 1[j] recites (and thus requires) the expandability provided for by the elastic arrangement of the '808 Patent. Ex. 1001 at Element 1[j].

171. Mr. Babcock's analysis in this regard highlights the inapplicability of the structures of the two references, which I have already explained in detail above. In my opinion, a POSITA would not have had any reason to consider positioning any recess outbound of any groove, even if the proposed combination is proper. Thus, Mr. Babcock's analysis of the requirement that the recesses be outbound of the grooves is based even more on impermissible hindsight than the remainder of his analysis.

172. Mr. Babcock also opines that because there are a finite number of positions for the recesses, a POSITA would have found it obvious to position the recess outbound of the channel. Ex. 1002 at ¶ 398. For the same reasons given above, however, there is absolutely no reason to consider (a) combining Beckley with Kane and then (b) rearranging the position of the depressions 15 of Beckley to be outbound of any channel in Kane. That there are only three dimensions does not mean that a POSITA would have simply moved a feature along a different axis in

those three dimensions for any reason other than to arrive at the claims of the ‘808 Patent.

173. In short, Mr. Babcock’s analysis of Claim 19 is deficient, and underscores just how much he is trying to combine two un-combinable, incompatible references together in his Kane/Beckley combination.

6. *Claim 20*

174. Claim 20 depends from independent claim 19, which as I explained above is not obvious in view of Kane and Beckley. Claim 20 further recites aspects of the “hook,” “recess,” and “undercut,” so my analysis of the Missing Kane Limitations above applies equally to claim 20 as it did to independent claims 1, 14, and 19. I incorporate my analysis of the Missing Kane Limitations with respect to claim 1 as if set forth fully herein.

175. Accordingly, in my opinion, Mr. Babcock has not shown that this dependent claim is obvious. Ex. 1002 at ¶¶ 454-464.

7. *Claim 21*

176. Claim 21 depends from independent claim 19, which as I explained above is not obvious in view of Kane and Beckley. Without conceding that the additional limitations of this dependent claim are present (particularly because the combination relied upon is improper), I note that at least the reasons given above

with regard to claim 19 demonstrate Mr. Babcock's failure to show that this dependent claim is obvious.

C. GROUND 2 – KANE IN VIEW OF PELZ (OBVIOUSNESS)

177. Ground 2 is based on a combination of Kane (the predecessor to the '808 Patent) with Pelz, a reference about a clip on the *outside* of a hearing aid microphone unit designed to attach that unit to a user's clothing to help the unit hear what is going on around the unit for amplification in his or her ears.

178. Pelz is completely non-analogous art to the '808 Patent, and Mr. Babcock does not compellingly argue that a POSTIA (as in this case) would have looked to art like Pelz for any reason when considering obviousness of the '808 Patent. Where Kane relates to a device for removably holding something (credit cards), the electronics of Pelz appear to be immovable from the interior of the device. Ex. 1008 at 1:1-4.

179. What is more, the clips at issue in Kane and the '808 Patent are related to holding cash to a wallet; a metal structure used to clip a hearing aid microphone unit to a user's clothing is not at all relevant, by use case, to the technology at issue in the '808 Patent or in Kane. I note that each of the claims of Pelz is directed to a "hearing aid microphone unit." Ex. 1008 at Claims.

180. Mr. Babcock concedes the inapplicability of Pelz to Kane when he opines that "Kane and Pelz both disclose innovations in the field of compact devices

worn on one's person.” Ex. 1002 at ¶ 489. Mr. Babcock's assertion strains credibility, but is also incorrect because the compact wallet of Kane is not *worn on one's person*; it is carried, and the clip of Kane secures cash while the clip of Pelz secures the device to one's clothing.

181. Thus, I do not believe that Kane and Pelz are analogous disclosures, and I strongly disagree that a POSITA would have looked to Pelz to solve any problems encountered in the Kane's technology field.

1. Claim 1

182. Mr. Babcock again admits that Kane (Ex. 1006) does not include the Missing Kane Limitations with respect to this claim in Ground 1. Ex. 1002 at ¶¶ 484-528. Mr. Babcock tries to plug the admitted holes (i.e., the Missing Kane Limitations) with Pelz's hearing aid disclosures. Ex. 1008. Mr. Babcock has both failed to show that the combination of Kane and Pelz is proper, and has failed to that each of the above-noted Missing Kane Limitations is, in fact, obvious based on the combination of references in Ground 2.

183. First, Mr. Babcock does not establish that the combination of Kane with Pelz is proper or permissible. I do not believe it is.

184. Kane is a compact wallet reference; Pelz relates to a device for amplifying sounds. In my opinion, a POSITA would not have looked to Pelz to

solve any problems in Kane's field. I have already addressed this in my introductory remarks above.

185. In addition, to the extent we are looking at just structure, Kane relies on a pair of sandwiches (Ex. 1006 at 5) to accommodate elastic in each of its two plates; Pelz, to the contrary, relies on a clip that mounts to the outside of a box (Ex. 1008 at Figs. 1, 2). Thus, the mechanical engineering design concepts of Pelz are very different from those of Kane, and a POSITA would not have been motivated to combine those references. In particular, a POSITA looking at Kane and desiring to maintain Kane's overarching design goal of expandability while minimizing thickness would not have considered the teachings of Pelz, whose clip merely affixes to the exterior of a non-expandable box to permit fastening to a user's clothing. Given the presence of the elastic strap of Kane at either end (and the need for the money clip to be external to that elastic band), the modification proposed by Mr. Babcock is improper. *See* Ex. 1006 at 5. To modify Kane to accommodate an external money clip like in Pelz would require thickening the outer layer of Kane to a point where the appropriate indentation from Pelz could be created to accommodate a stud 12 and the other structures required. *See, e.g.,* Ex. 1008 Figs. 6 and 7. And, of course, the external-mounted money clip concept was already considered in Kane:



Ex. 1006 at 7.

186. Thus, a POSITA would not have considered attempting to integrate the clip style of Pelz into Kane. I do not believe the proposed combination/modification is proper under what I understand to be the legal standard for this analysis.

- **Claim 1[e] - an auxiliary feature removably attached to at least one of the at least two rigid plates**

187. Mr. Babcock does not demonstrate that any combination of Kane and Pelz is permissible, and thus cannot demonstrate that the combination discloses the claimed removably attached auxiliary feature.

188. In particular with regard to the clip of Pelz, that item does not need to mate with a multi-layer stack of structures; it instead mounts to the *outside* of an object whose internals are protected from access by its user. Ex. 1008 at Fig. 1, Fig. 2. Thus, a POSITA would not have been motivated to combine Kane with Pelz to simply add the clip without relying on improper hindsight reconstruction.

189. This is particularly apparent from the way Pelz's clip affixes to the outside of its device. Given the arrangement in Pelz, the clip **MUST** be pushed over the "head" of the stud 12:

This opening is adapted to receive the head of a stud 12 that projects from the back of the case. The inner end of the stud may originally be hollow so that it can be riveted to the case. As shown in Fig. 5, the head is formed by providing the opposite sides of the cylindrical body of the stud with slots 3 which reduce its width transversely of the case only to permit the stud to enter the narrow portion of the slot when the clip is slid upwardly on the case. The head of the stud will thus overlie the arm of the spring on the opposite sides of the slot and thereby hold the spring against the case. The pressure of the lower end of the clip against the case presses the lower end of the spring against the stud head and thereby presses the lower end of the spring against the stud head...

Ex. 1008 at 2:3-18. Because the clip of Pelz has to be pushed down over the head of the stud, its design is simply not compatible with the construction of the wallet in Kane. This is a further reason why Mr. Babcock's proposed combination is improper.

190. Mr. Babcock notably does not mention Pelz when discussing limitations of the claims that relate to the above. For example, while he opines that

Kane discloses a “compact wallet” (Ex. 1002 at ¶¶ 470-474), he conspicuously fails to mention Pelz because Pelz is not remotely related to a compact wallet. Ex. 1008 at Title. The same is true regarding “at least two rigid plates interposed to sandwich card-like contents there between, each rigid plate having a longitudinal extent” (Ex. 1002 at ¶¶ 475-477), an “encircling elastic band” (Ex. 1002 at ¶¶ 478-480), and a “channeling means” (Ex. 1002 at ¶¶ 481-483). Indeed, for elements 1[a], 1[b], 1[c], and 1[d], he does not cite Pelz’s disclosure at all. *Id.* And in discussing Kane’s disclosure of an “auxiliary feature,” he concedes by omission that Kane does *not* include an “auxiliary feature” that is “removably attached to at least one of the at least two rigid plates.” Ex. 1002 at ¶ 485. In paragraph 485, for example, Mr. Babcock includes a sentence in which he *omits* the word “removably”: “Kane discloses a money clip (“auxiliary feature”) attached [but not removably attached] to at least one of the interior plate-outer faceplate pairs (‘rigid plates’).” Ex. 1002 at ¶ 485.

191. That is, Mr. Babcock recognizes that Kane’s auxiliary feature is not removable from any plate (as is required). This constitutes a recognition, by Mr. Babcock, of the substantial difference in structure between Kane and Pelz, and underscores that a POSITA would not have combined these references because of the substantial difference in the underlying structure of Kane (which is germane to

the environment for the auxiliary feature recited in claim 1 of the ‘808 Patent) and Pelz.

192. Mr. Babcock spends several paragraphs trying to explain why he believes a POSITA would have incorporated Pelz’s teachings into Kane, but he is not persuasive. Ex. 1002 at ¶¶ 488-498. First, he is incorrect that “Pelz and Kane are in similar technical fields, address similar problems, utilize similar devices, and disclose structural features that, when combined, function in the same manner as each does separately to yield predictable results.” Ex. 1002 at 488. To the contrary, Kane and Pelz are completely different; one holds electronic equipment inside a plastic casing, and one expands and contracts to hold easily accessible everyday carry contents (such as credit cards) between two plates. Their size, and the fact that they are carried, does not change this fact. Ex. 1002 at ¶ 489.

193. Mr. Babcock’s comments about bulkiness are also incorrect. Ex. 1002 at ¶ 490. Kane’s disclosures relate to the expandability of a wallet; Pelz’s, on the other hand, relate to the bulk added by a clip (which, obviously, Kane already has). Indeed, the fact that Kane already includes a spring-loaded clip would lead a POSITA to conclude that Pelz’s disclosures are inapplicable to those of Kane. In this vein, I am unsure what “additional functionality” Mr. Babcock is talking about (Ex. 1002 at ¶¶ 491-492); in my opinion, the near identity of the clips in Kane and Pelz is actually a deterrent to modifying Kane based on Pelz.

194. Mr. Babcock’s opinions at Paragraphs 493-498 are reminiscent of the same hindsight-biased analysis as I have previously discussed in which he uses the claims of the ‘808 Patent as a blueprint to piece together the prior art to try to result in the claimed elements. I hereby incorporate my discussion of the reasons Kane is not modifiable to include a different, removable money clip as set forth with regard to claim element 1[e] for Ground 1. I do not believe combination is proper, and I believe that POSITA would not have found any reason to make the modification to Kane based on a reference about hearing aids.

195. Particularly where the proposed modification would require a thickening of the outer plate of Kane for future thinning to accommodate the stud and groove in Pelz, Mr. Babcock’s analysis is flawed.

- **Claim 1[f] - the auxiliary feature having a tang insertable into a recess formed inside the at least two rigid plates**

196. Mr. Babcock opines that the combination of Kane and Pelz discloses this element. Ex. 1002 at ¶¶ 499-506. He is incorrect.

197. First, as I discussed above, the combination of Kane and Pelz is not proper. Mr. Babcock does not provide any rationale to support that proposed combination other than using impermissible hindsight. And in my opinion, a POSITA would not have made the combination given the substantial design differences between Kane and Pelz (one is related to a pair of sandwiched items held together by elastic, where each “sandwich” must accommodate the elastic, and the

other is a reference related to a clip for a hearing aid that affixes to the outside of the device).

198. Even if Mr. Babcock is correct about the propriety of the combination (he is not), the combination still does not disclose this limitation. In particular, Mr. Babcock does not, and cannot, identify any “recess formed inside the at least two rigid plates.” He appears to rely on a depression in the outer surface of the planar item 1 of Pelz, but that does not constitute a “recess formed inside the at least two rigid plates,” as claimed.

199. Mr. Babcock knows this, and regurgitates the following hindsight-reconstruction-based “analysis”: “a POSITA would have been motivated to form a depression (“recess”), like that disclosed by Pelz, into an interior plate-outer faceplate pair (“rigid plate”), like that disclosed by Kane, to effectuate the removable attachment of a clip (“auxiliary feature”), like that disclosed by Pelz and discussed above, because Kane and Pelz are in the same technical field, address similar problems, utilize similar devices, and disclose methods that when combined function in the same manner as each does separately to yield predictable results. In doing so, the POSITA would apply a known technique to a known device ready for improvement to yield predictable results...” Ex. 1002 at ¶ 503, *see also* ¶ 504. But Mr. Babcock provides no actual reason for making this combination, and in my opinion a POSITA would not have modified Kane in view of Pelz to result in the

device Mr. Babcock is describing here, unless he or she was doing so with the sole purpose of reconstructing the claims of the ‘808 Patent. Such a modification would have involved *adding* structure to Pelz (e.g., by adding a sandwich-plate construction that is simply not present), and there is simply no reason to do so.

200. My same analysis of Mr. Babcock’s prior combination analysis (e.g., regarding continuing milling steps) applies to his re-purposing of his prior analysis for this combination. Ex. 1002 at ¶¶ 504-505. As with his prior analysis, the milling operation of Kane would not need merely to be “continued;” it appears that an additional milling step would need to be done on the exterior of the Kane device to accommodate Pelz’s external-mounted money clip design. There is no reason whatsoever to do this other than based on a hindsight bias toward constructing the claims of the ‘808 Patent.

201. For all the reasons I have previously provided, Mr. Babcock’s reliance on a functional reference (Kane) does not provide a reason to deviate from Kane’s money clip approach, and certainly does not lead a POSITA to modifying Kane in view of Pelz to result in this claim limitation.

- **Claim 1[g] - The tang having a hook**

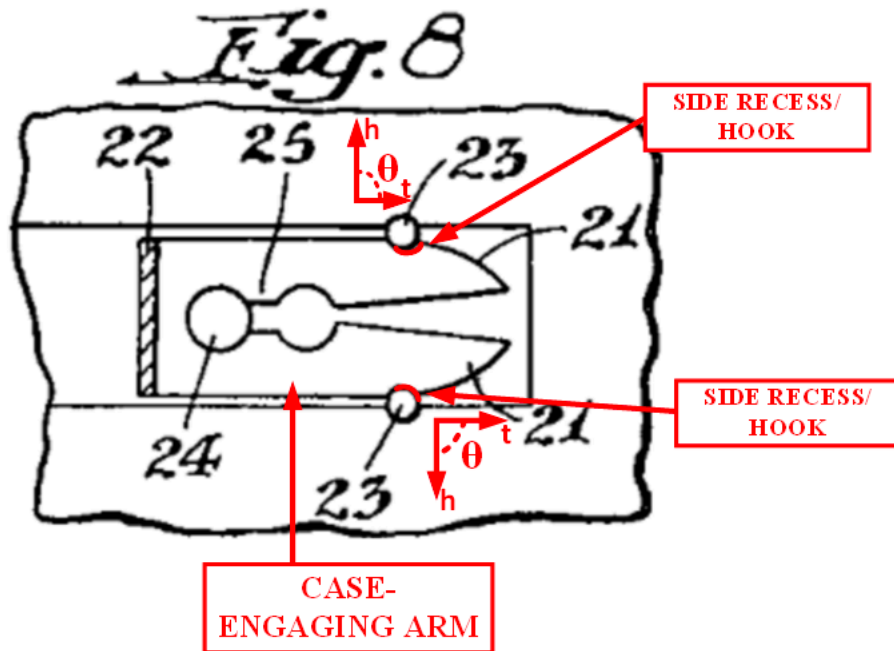
202. The item Mr. Babcock identifies as a tang does not have a hook; instead, a cutout in the so-called tang is identified, but is not a hook. Nothing actually extends from the “tang” in Mr. Babcock’s analysis. Moreover, because (according

to the claims) the tang is insertable in the recess, and the hook is a portion of the tang (and because of the engagement discussed below), the hook must be in the recess formed inside the at least two plates. There is no recess disclosed as claimed in Pelz, because the identified item is merely a depression in an outer plastic plate of a hearing aid device.

203. In addition, reiterating my analysis of the prior limitation, there is no reason to modify Kane with Pelz to result in a hook as claimed. The structural differences between the two devices mean that Pelz's design is inapplicable to Kane's design; Mr. Babcock's analysis as to the combinability (Ex. 1002 at ¶¶ 509-512) is again solely based on impermissible hindsight reconstruction. He again seeks to create a Frankenstein's monster situation where features of which are incompatible with the sandwich-plate design of Kane would nevertheless be added to Kane. There is simply no justifiable reason to make this modification.

- **Claim 1[h] the hook extending at an angle to the tang**

204. The item Mr. Babcock identifies as a tang does not have a hook, and that is all the more apparent when viewed in terms of the requirement for the hook to extend at an angle to the tang. For example, the following is not compelling:



Ex. 1002 at ¶ 515. The thing Mr. Babcock calls a hook does not *extend* at all, and thus cannot extend at an angle to anything. It is an indentation, not an extension, and this is not a hook that extends at an angle to the identified tang.

- **Claim 1[i] - The hook engaging an undercut of the recess to prevent inadvertent dislodgement of the auxiliary feature from the recess**

205. Finally with regard to the Missing Kane Limitations, I do not agree that Mr. Babcock has shown that it was obvious to modify Kane to result in a hook engaging an undercut of the recess to prevent inadvertent dislodgment of the auxiliary feature from the recess.

206. As I described above, there is no recess in a sandwich-plate environment in Pelz, and a POSITA would not have modified Kane to include a recess. As such, the item Mr. Babcock relies on as a “hook” does not engage an

undercut of the claimed recess to prevent inadvertent dislodgment of the auxiliary feature from the recess. And it of course is not a hook, and does not extend at an angle to the item identified as a tang.

207. Mr. Babcock's analysis in paragraphs 525-527 does not change the fact that the only basis for his proposed modifications via the combination of Kane and Pelz is hindsight reconstruction, which I understand is impermissible in an obviousness analysis. Ex. 1002 at ¶¶ 525-527. Kane's disclosure of wallets with outer plates that DO have money clips, and outer plates that DO NOT have money clips, is not a suggestion that it would be useful (or possible) to include a money clip that is removable from the outer plate itself. Ex. 1002 at ¶ 526. In fact, the failure to disclose a removable money clip indicates that compact wallet designers were not actually considering that modification at all. Ex. 2020 at ¶¶ 11-15.

208. Moreover, the fact that Kane advocates "personalization" in a "system" but does NOT include a removable money clip is indeed evidence that the proposed modification Mr. Babcock suggests is not proper. Ex. 1002 at ¶ 527. To the contrary, the fact that a system is provided where money clip preferences are only achievable with money clips that are non-removably mounted *only* to the exterior of the outer plate means that a POSITA would not have considered the proposed modification, which not only moves the money clip mount point to inside of the

wallet, but requires forming recesses inside a pair of plates in a way not at all disclosed in Pelz. Ex. 1008 at Fig. 1.

209. In short, the proposed combination of Kane and Pelz is not proper, and even if it was, would no result in the arrangement recited in the Missing Kane Limitations where recesses *inside* outer plates engage with hooks of tangs as recited.

2. *Claims 2-9, 11-13, and 18*

210. These claims each depend from independent claim 1, and Mr. Babcock relies exclusively on the teachings of Kane for the additional requirements of dependent claims 2-13, and 18. Ex. 1002 at ¶¶ 532-539 (Claim 2); Ex. 1002 at ¶¶ 540-543 (Claim 3); Ex. 1002 at ¶¶ 544-547 (Claim 4); Ex. 1002 at ¶¶ 548-551 (Claim 5); Ex. 1002 at ¶¶ 553-555 (Claim 6); Ex. 1002 at ¶¶ 556-559 (Claim 7); Ex. 1002 at ¶¶ 560-563 (Claim 8); Ex. 1002 at ¶¶ 564-571 (Claim 9); Ex. 1002 at ¶¶ 572-575 (Claim 11); Ex. 1002 at ¶¶ 576-583 (Claim 12); Ex. 1002 at ¶¶ 584-587 (Claim 13); Ex. 1002 at ¶¶ 651-654 (Claim 18). Confirming that Pelz is non-analogous art (and in contrast with his analysis of Beckley), Mr. Babcock does not rely on Pelz for the disclosure of the items in Claim 11 relating to the type of “card-like contents” that can be held by the claimed compact wallet. Ex. 1002 at ¶¶ 572-575.

211. Notably, Mr. Babcock provides no further combination analysis or rationale in his analysis of dependent claims 2-9, 11-13, or 18, meaning that my

rebuttal to his combination analysis with respect to claim 1 is equally applicable to those claims.

212. Without conceding that the additional limitations of these dependent claims are present (particularly because the combination relied upon in Ground 2 is improper), at least the reasons given above with regard to claim 1 demonstrate Mr. Babcock's failure to show that these dependent claims are obvious.

3. *Claim 14*

213. Unlike independent claim 1, independent claim 14 does not affirmatively require the "auxiliary feature" to be a part of the claimed compact wallet. In other words, one could infringe claim 14 (or, in Ridge's case, permissibly practice claim 14) by selling a wallet having the same internal structure required by claim 1, even if it is not sold with a money clip (the auxiliary feature) to engage those internal structures. Nevertheless, to show invalidity, Mr. Babcock would have to show a capability to interface with the requisite parts of a removable auxiliary feature.

214. Nevertheless, Mr. Babcock admits that Kane does not disclose the Missing Kane Limitations of Claim 14 (i.e., claim elements 14[e], 14[f], 14[g], and 14[h]). Ex. 1002 at ¶¶ 599-631.

215. I hereby incorporate by reference my analysis of Claim 1 with respect to Ground 2 as if fully reproduced herein.

216. In particular, I incorporate my analysis of Claim 1[e] with respect to Mr. Babcock's analysis of Claim 14[e]. Ex. 1002 at ¶¶ 322-327.

217. I incorporate my analysis of Claim 1[f] with respect to Mr. Babcock's analysis of Claim 14[f]. Ex. 1002 at ¶¶ 599-607.

218. I incorporate my analysis of Claim 1[g] and Claim 1[i] with respect to Mr. Babcock's analysis of Claim 14[g]. Ex. 1002 at ¶¶ 616-624.

219. I incorporate my analysis of Claim 1[h] with respect to Mr. Babcock's analysis of Claim 14[h]. Ex. 1002 at ¶¶ 625-631.

220. For the same reasons I gave with regard to claim 1, the limitations corresponding to the Missing Kane Limitations (i.e., claim elements 14[e], 14[f], 14[g], and 14[h]) are not obvious in the form they show up in claim 14. For the same reasons I gave above with regard to claim 1, a POSITA would not have made the Kane-Pelz combination Mr. Babcock advocates for purposes of claim 14 without relying on impermissible hindsight bias and without using the claims of the '808 Patent as a blueprint to piece together the prior art as laid out in the claims. Because Mr. Babcock concedes Kane does not disclose all of the limitations of claim 14, if the combination fails, then his obviousness analysis also fails. Mr. Babcock's analysis of claim 14 is thus equally unavailing. Ex. 1002 at ¶¶ 588-634.

4. *Claims 15-17*

221. These claims depend from independent claim 14, and Mr. Babcock relies exclusively on the teachings of Kane with respect to the additional limitations of these dependent claims. Ex. 1002 at ¶¶ 635-642 (Claim 15); Ex. 1002 at ¶¶ 643-646 (Claim 16); Ex. 1002 at ¶¶ 647-650 (Claim 17).

222. Notably, Mr. Babcock provides no further combination analysis or rationale in his analysis of dependent claims 15-17, meaning that my rebuttal to his combination analysis with respect to claim 1 is equally applicable to those claims.

223. Without conceding that the additional limitations of these dependent claims are present (particularly because the combination relied upon in Ground 1 is improper), at least the reasons given above with regard to claim 1 demonstrate Mr. Babcock's failure to show that these dependent claims are obvious.

5. *Claim 19*

224. Claim 19 is essentially a method claim that corresponds to a method of using the device recited in Claim 1/Claim 14. That is, for example, independent claim 19 recites method steps such as “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.

225. However, Claim 19 also adds the requirement that the recesses be “outbound of the elastic band.” Ex. 1001 at Claim 1. Thus, in addition to showing the structures required inside the wallet by claims 1 and 14, Mr. Babcock would have to show that it would have additionally been obvious to position the recesses *outbound of the elastic band*.

226. In addition to his failings with respect to the Missing Kane Limitations (i.e., claim elements 19[e], 19[g], 19[h], 19[j], 19[k], 19[l], and 19[m]), Mr. Babcock also cannot show that it would have been obvious to provide the recesses in the requisite position.

227. Mr. Babcock admits that Kane does not disclose the Missing Kane Limitations of Claim 19 (i.e., claim elements 19[e], 19[g], 19[h], 19[j], 19[k], 19[l], and 19[m]). Ex. 1002 at ¶¶ 668-728.

228. I hereby incorporate by reference my analysis of Claim 1 with respect to Ground 1 as if fully reproduced herein.

229. In particular, I incorporate my analysis of Claim 1[e] and Claim 1[f] with respect to Mr. Babcock’s analysis of Claim 19[e]. Ex. 1002 at ¶¶ 668-674.

230. I incorporate my analysis of Claim 1[i] and with respect to Mr. Babcock’s analysis of Claim 19[g]. Ex. 1002 at ¶¶ 681-689.

231. I incorporate my analysis of Claim 1[i] and with respect to Mr. Babcock's analysis of Claim 19[h]. Ex. 1002 at ¶¶ 690-694.

232. I incorporate my analysis of Claim 1[g] and with respect to Mr. Babcock's analysis of Claim 19[j]. Ex. 1002 at ¶¶ 701-706.

233. I incorporate my analysis of Claim 1[g] and with respect to Mr. Babcock's analysis of Claim 19[k]. Ex. 1002 at ¶¶ 707-715.

234. I incorporate my analysis of Claim 1[h] and with respect to Mr. Babcock's analysis of Claim 19[l]. Ex. 1002 at ¶¶ 716-721.

235. I incorporate my analysis of Claim 1[f] and with respect to Mr. Babcock's analysis of Claim 19[m]. Ex. 1002 at ¶¶ 722-728.

236. For the same reasons I gave with regard to claim 1, the limitations corresponding to the Missing Kane Limitations (i.e., Claim elements 19[e], 19[g], 19[h], 19[j], 19[k], 19[l], and 19[m]) are not obvious in the form they show up in claim 19. For the same reasons I gave above with regard to claim 1, a POSITA would not have made the Kane-Beckley combination Mr. Babcock advocates for purposes of claim 19 without relying on impermissible hindsight bias and without using the claims of the '808 Patent as a blueprint to piece together the prior art as laid out in the claims. Because Mr. Babcock concedes Kane does not disclose all of the limitations of claim 19, if the combination fails, then his obviousness analysis

also fails. Mr. Babcock’s analysis of claim 19 is thus equally unavailing. Ex. 1002 at ¶¶ 668-728.

237. In addition, as I noted, claim 19 requires “at least one groove additionally having at least one recess positioned outbound of the elastic band.” Ex. 1001 at Claim 19. This limitation is not explicitly present in the other independent claims. Mr. Babcock’s sole analysis of this limitation is as follows:

671. Moreover, a POSITA would have been motivated to form the depression (“recess”), like that disclosed by Pelz, in one or more the interior plate outer faceplate pairs (“rigid plates”), like that disclosed by Kane, outbound the encircling elastic band (“elastic band,” understood to reference the “at least one encircling elastic band”) to avoid interference between the function of the depression (“recess”) (e.g., to capture an auxiliary feature) and the function of the elastic band (e.g., to expand and contract while enabling the wallet to have elastic volume).

672. A POSITA would have looked to Pelz for guidance as to the outbound positioning of the depression (“recess”), like that disclosed by Pelz, in one or more of the interior plate-outer faceplate pairs (“rigid plates”), like that disclosed by Kane, because Kane and Pelz are in similar technical fields, address similar problems, utilize similar devices, and disclose methods that when combined function in the same manner as each does separately to yield predictable results, as set forth in Section IX.B.1.e; which is incorporated here by reference. (Ex. 1006 at 2-3, 5, 7-8, 10-11, and photographs thereof; Ex. 1008 at 1:1-4, 1:6-12, 2:39-45, FIGS. 1-2 and 8.)

673. In addition, A POSITA would have been motivated to form the depression (“recess”), like that disclosed by Pelz, in one or more the interior plate-outer faceplate pairs (“rigid plates”), like that disclosed by Kane, outbound the elastic band at least because said positioning is one of a finite number of identified, predictable positions, with a reasonable expectation of success. For example, there are a finite number of locations in the interior plate-outer

faceplate pairs (“rigid plates”), like that disclosed by Kane, where a depression (“recess”), like that disclosed by Pelz, could be positioned. Further, a POSITA would have reasonably predicted that positioning a depression (“recess”), like that disclosed by Pelz, outbound the encircling elastic band, like that disclosed by Kane, would result in successful operation of both the depression (“recess”) and the elastic band.

Ex. 1002 at ¶¶ 671-673. I disagree with Mr. Babcock’s analysis.

238. The only “analysis” of why a POSITA would position recesses outbound of the channel is Mr. Babcock’s statement that such a modification would be made to “to avoid interference between the function of the depression (“recess”) (e.g., to capture an auxiliary feature) and the function of the elastic band.” Ex. 1002 at ¶¶ 671. This is the epitome of hindsight reconstruction. There is no grounding whatsoever in the prior art references; Mr. Babcock merely uses the claims as a blueprint to modify the proposed combination of Kane and Pelz without any reason whatsoever.

239. In my opinion, the difference in structure between Pelz, which is a fixed-size device with an exterior spring to clip an electronic device to a wearer’s clothes, and Kane, which is expandable and relies on a pair of plates whose distance from each other changes, is exacerbated by Mr. Babcock’s analysis of this element. There is no reason whatsoever that a POSITA would have analyzed the relationship between the purported “recesses” and *anything* with respect to the grooves of Kane. Mr. Babcock’s analysis in this regard highlights the inapplicability of the structures

of the two references, which I have already explained in detail above. In my opinion, a POSITA would not have had any reason to consider positioning any recess outbound of any groove, even if the proposed combination is proper. Thus, Mr. Babcock's analysis of the requirement that the recesses be outbound of the grooves is based even more on impermissible hindsight than the remainder of his analysis.

240. Mr. Babcock also opines that because there are a finite number of positions for the recesses, a POSITA would have found it obvious to position the recess outbound of the channel. Ex. 1002 at ¶ 398. For the same reasons given above, however, there is absolutely no reason to consider (a) combining Pelz with Kane and then (b) rearranging the position of depressions of Pelz to be outbound of any channel in Kane. That there are only three dimensions does not mean that a POSITA would have simply moved a feature along a different axis in those three dimensions for any reason other than to arrive at the claims of the '808 Patent.

241. In short, Mr. Babcock's analysis of Claim 19 is deficient, and underscores just how much he is trying to combine two un-combinable, incompatible references together in his Kane/Pelz combination.

6. Claim 20

242. Claim 20 depends from independent claim 19, which as I explained above is not obvious in view of Kane and Pelz. Claim 20 further recites aspects of the "hook," "recess," and "undercut," so my analysis of the Missing Kane

Limitations above applies equally to claim 20 as it did to independent claims 1, 14, and 19. I incorporate my analysis of the Missing Kane Limitations with respect to claim 1 as if set forth fully herein.

243. Accordingly, in my opinion, Mr. Babcock has not shown that this dependent claim is obvious. Ex. 1002 at ¶¶ 732-742.

7. *Claim 21*

244. Claim 21 depends from independent claim 19, which as I explained above is not obvious in view of Kane and Pelz. Without conceding that the additional limitations of this dependent claim are present (particularly because the combination relied upon is improper), I note that at least the reasons given above with regard to claim 19 demonstrate Mr. Babcock's failure to show that this dependent claim is obvious.

D. GROUND 3 – KANE IN VIEW OF MATTHEWS (OBVIOUSNESS)

245. Ground 3 is based on a combination of Kane (the predecessor to the '808 Patent) with Matthews, another reference about a clip on the *outside* of a device. In the case of Matthews, the device is a card holder, but it is a very specific card holder with electronics to enable a user to access data on a single, held card via outside the card holder. The clip of Matthews is not for holding cash, but rather for clipping the device to a user's clothing or a vehicle visor, for example.

246. While Matthews does describe a card holder, that nomenclature does not make it analogous art to the ‘808 Patent. Indeed, while each device holds a card, the ‘808 Patent is a wallet for carrying a user’s daily, needed cards, and it includes a clip for holding cash and the like. Matthews, to the contrary, holds ONLY a single card and the use case is not to provide a money clip or other cash attachment mechanism. Ex. 1009 at ¶ 4.

247. What is more, the clips at issue in Kane and the ‘808 Patent are related to holding cash to a wallet; a metal structure used to clip the Matthews device to a user’s clothes or a car visor is not relevant to Kane. The clip of Matthews is not designed to have its contents repeatedly accessed, and instead is designed to fasten the device to a base for some longer amount of time. The design considerations and tolerances are thus very different than in Kane, where the clip needs to be strong enough to hold paper (but not the weight of the device itself).

248. Mr. Babcock’s statement that “Kane and Matthews both disclose innovations in the field of card holders” is somewhat disingenuous for this reason. Ex. 1002 at ¶ 770. While both devices hold cards, Kane is directed to a compact wallet, while Matthews is directed to a single card holder that permits data access from the outside world. Ex. 1009 at ¶ 4. Indeed, Kane’s (and the ‘808 Patent’s) focus on RFID blocking demonstrates that materials, dimensions, and design

considerations for Kane and the ‘808 Patent are vastly different from Matthews, which discloses that RFID reading should be possible. Ex. 1009 at ¶ 43.

249. Mr. Babcock essentially concedes this non-analogousness in his analysis of Claim 1[j], which requires the device to “allow[] expandable capacity and ready access to individual contents from between the at least two rigid plates. Ex. 1002 at ¶¶ 810-811. He does not rely on Matthews at all for this limitation, in recognition of the fact that Matthews is not directed to a card holder that holds multiple cards and permits access to the same. *Id.*

250. Thus, I do not believe that Kane and Matthews are analogous disclosures, and I strongly disagree that a POSITA would have looked to Matthews to solve any problems encountered in the Kane’s technology field.

1. Claim 1

251. Mr. Babcock again admits that Kane (Ex. 1006) does not include the Missing Kane Limitations. Ex. 1002 at ¶¶ 767-809. Mr. Babcock tries to plug the admitted holes (i.e., the Missing Kane Limitations) with Matthews’ disclosures. Ex. 1009. Mr. Babcock has both failed to show that the combination of Kane and Matthews is proper, and has failed to establish that each of the above-noted Missing Kane Limitations is, in fact, obvious based on the combination of references in Ground 3.

252. First, Mr. Babcock does not establish that the combination of Kane with Matthews is proper or permissible. I do not believe it is.

253. Kane is a compact wallet reference; Matthews is a device for holding a single card while providing a mounting surface for electronics to interface with that card. In my opinion, a POSITA would not have looked to Matthews to solve any problems in Kane's field. I have already addressed this in my introductory remarks above.

254. In addition, to the extent we are looking at just structure, Kane relies on a pair of sandwiches (Ex. 1006 at 5) to accommodate elastic in each of its two plates; Matthews, to the contrary, relies on a clip that mounts to the outside of a box (Ex. 1009 at Fig. 2). Thus, the mechanical engineering design concepts of Matthews are very different from those of Kane, and a POSITA would not have been motivated to combine those references. In particular, a POSITA looking at Kane and desiring to maintain Kane's overarching design goal of expandability while minimizing thickness would not have considered the teachings of Matthews, whose clip merely affixes to the exterior of a non-expandable box to permit fastening to a car visor or a user's clothing. Given the presence of the elastic strap of Kane at either end (and the need for the money clip to be external to that elastic band), the modification proposed by Mr. Babcock is improper. *See* Ex. 1006 at 5. To modify Kane to accommodate an external money clip like in Matthews would require thickening the

outer layer of Kane to a point where the appropriate indentation from Pelz could be created to accommodate the structure of Matthews that are required to secure the money clip. *See, e.g.*, Ex. 1009 at Figs. 4 and 5. And, of course, the external-mounted money clip concept was already considered in Kane:



Ex. 1006 at 7.

255. Thus, a POSITA would not have considered attempting to integrate the clip style of Pelz into Kane. I do not believe the proposed combination/modification is proper under what I understand to be the legal standard for this analysis.

- **Claim 1[e] - an auxiliary feature removably attached to at least one of the at least two rigid plates**

256. Mr. Babcock does not demonstrate that any combination of Kane and Matthews is permissible, and thus cannot demonstrate that the combination discloses the claimed removably attached auxiliary feature.

257. In particular with regard to the clip of Matthews, that item does not need to mate with a multi-layer stack of structures; it instead mounts to the *outside* of an object whose internals are designed to be accessed infrequently, and certainly not repeatedly during the day, by its user. Ex. 1009 at Figs. 4, 5. Indeed, the device of Matthews is self-contained and the clip is merely there to hold the device to a more permanent location (relatively speaking), such as a car visor. Ex. 1009 at ¶¶ 4, 9. Thus, a POSITA would not have been motivated to combine Kane with Matthews to simply add the clip without relying on improper hindsight reconstruction.

258. In discussing Kane’s disclosure of an “auxiliary feature,” Mr. Babcock concedes by omission that Kane does *not* include an “auxiliary feature” that is “removably attached to at least one of the at least two rigid plates.” Ex. 1002 at ¶ 768. Indeed, in that paragraph, Mr. Babcock does not even mention Kane with respect to the requirement for an “auxiliary feature.” *Id.* That is, Mr. Babcock recognizes that Kane’s auxiliary feature is not removable from any plate (as is required). This constitutes a recognition, by Mr. Babcock, of the substantial difference in structure between Kane and Matthews, and underscores that a POSITA

would not have combined these references because of the substantial difference in the underlying structure of Kane (which is germane to the environment for the auxiliary feature recited in claim 1 of the ‘808 Patent) and Matthews.

259. Mr. Babcock spends several paragraphs trying to explain why he believes a POSITA would have incorporated Matthews teachings into Kane, but he is not persuasive. Ex. 1002 at 769-777. First, he is incorrect that “Matthews and Kane are in the same technical field (compact card holders” and that “Kane and Matthews both disclose innovations in the field of card holders.” Ex. 1002 at ¶¶ 769, 770. Kane is directed to a compact wallet, and Matthews is directed to a device that holds a single card in a more permanent way so as to permit access to data on that card via the device; to call them both “card holders” is far too broad an analysis and is done for self-serving purposes. Likewise, his statement that “Kane and Matthews both address problems of regarding [sic] the operation of previously known card holder designs” is self-servingly broad, as the devices are directed to very different purposes. Ex. 1002 at ¶ 771; Ex. 1006 at 2 (credit card holder for use as a wallet); Ex. 1009 at ¶ 4 (card holder for permitting external device access to data on stored cards).

260. Mr. Babcock’s observations about the clips for “additional functionality” also demonstrate the impropriety of his combination analysis. Ex. 1002 at ¶ 772. Again, what he says is technically true, but a POSITA analyzing

Kane, which already had a money clip for holding cash (in several different designs), would not have looked to Matthews' visor clip for teachings as to how to change an otherwise functional device in Kane.

261. Mr. Babcock's comments about the outer plates does not seem to make any sense. Ex. 1002 at ¶ 773. If he is saying both devices are made out of hard material on their outer surfaces, that is true. But that is where the similarities stop. Kane is a metal wallet made of a pair of sandwich structures, designed to prevent RFID skimming of cards held therein. Ex. 1006. It is designed to expand and contract by use of elastic banding, and its design accommodates those bands while providing the other functionalities of a slim wallet. Ex. 1006 at 5. Matthews, on the other hand, is made of rigid plastic, does not expand, and does not accommodate different numbers of cards. *See generally* Ex. 1009. Its outer structure is a single piece of plastic (or other rigid material), the outer surfaces are not made in a sandwiched arrangement, and thus the attachment of a money clip (or other structure) to the exterior of Matthews comes with completely different design considerations. Ex. 1009 at Fig. 3. Just as I have discussed before, the incorporation of a clip on the outside of a rigid, consistently sized device is not applicable to design considerations of the expandable compact wallet in Kane. And, of course, Matthews is designed to *permit* RFID reading, not to prevent it. Ex. 1009 at ¶ 43.

262. Mr. Babcock's opinions at Paragraphs 774-776 are reminiscent of the same hindsight-biased analysis as I have previously discussed in which he uses the claims of the '808 Patent as a blueprint to piece together the prior art to try to result in the claimed elements. I hereby incorporate my discussion of the reasons Kane is not modifiable to include a different, removable money clip as set forth with regard to claim element 1[e] for Ground 1. I do not believe combination is proper, and I believe that POSITA would not have found any reason to make the modification to Kane based on a rigidly sized card holder that permits reading of cards therein from the outside.

263. Particularly where the proposed modification would require a thickening of the outer plate of Kane for future thinning to accommodate the mounting arrangement of Matthews, Mr. Babcock's analysis is flawed.

- **Claim 1[f] - the auxiliary feature having a tang insertable into a recess formed inside the at least two rigid plates**

264. Mr. Babcock opines that the combination of Kane and Matthews discloses this element. Ex. 1002 at ¶¶ 778-783. He is incorrect.

265. First, as I discussed above, the combination of Kane and Matthews is not proper. Mr. Babcock does not provide any rationale to support that proposed combination other than using impermissible hindsight. And in my opinion, a POSITA would not have made the combination given the substantial design differences between Kane and Matthews (one is related to a pair of sandwiched items

held together by elastic, where each “sandwich” must accommodate the elastic, and the other is a reference related to a clip for clipping a single card holder to the visor of a car).

266. Even if Mr. Babcock is correct about the propriety of the combination (he is not), the combination still does not disclose this limitation. In particular, Mr. Babcock does not, and cannot, identify any “recess formed inside the at least two rigid plates.” He appears to rely on a depression in the outer surface of the planar item 3 of Matthews, but that does not constitute a “recess formed inside the at least two rigid plates,” as claimed.

267. Mr. Babcock knows this, and regurgitates the following hindsight-reconstruction-based “analysis”: “a POSITA would have been motivated to form a recess, like that disclosed by Matthews, inside one or more of the interior plate-outer faceplate pairs (“rigid plates”), like that disclosed by Kane, to effectuate the removable attachment of a clip (“auxiliary feature”), like that disclosed by Matthews and discussed above, because Kane and Matthews are in the same technical field (e.g., compact card holders), address similar problems, utilize similar devices, and disclose methods that when combined function in the same manner as each does separately to yield predictable results...” Ex. 1002 at ¶ 781. But Mr. Babcock provides no actual reason for making this combination, and in my opinion a POSITA would not have modified Kane in view of Matthews to result in the device Mr.

Babcock is describing here, unless he or she was doing so with the sole purpose of reconstructing the claims of the ‘808 Patent. Such a modification would have involved *adding* structure to Matthews (e.g., by adding a sandwich-plate construction that is simply not present), and there is simply no reason to do so.

268. My same analysis of Mr. Babcock’s prior combination analysis (e.g., regarding continuing milling steps) applies to his re-purposing of his prior analysis for this combination. Ex. 1002 at ¶¶ 782-783. For all the reasons I have previously provided, Mr. Babcock’s reliance on a functional reference (Kane) does not provide a reason to deviate from Kane’s money clip approach, and certainly does not lead a POSITA to modifying Kane in view of Matthews to result in this claim limitation. This is particularly true because as best I can tell, the milling operation would be on the *outside* of Kane (after the outer plate is thickened), not on the plates inside of Kane’s sandwich that have been milled or otherwise machined to accommodate the strap. Ex. 1006 at 5. Mr. Babcock’s analysis about a POSITA’s modification to “effectuate the removable attachment of a clip...to a compact wallet” is based on nothing but hindsight reconstruction. Ex. 1002 at ¶ 782. Kane does not disclose removable money clips. Ex. 1006. And Matthews’ only removable clip is mounted to the outside, not using a recess inside a rigid plate. Thus, the paragraph 782 analysis is purely based on hindsight.

269. For all the reasons I have previously provided, Mr. Babcock’s reliance on a functional reference (Kane) does not provide a reason to deviate from Kane’s money clip approach, and certainly does not lead a POSITA to modifying Kane in view of Matthews to result in this claim limitation.

- **Claim 1[g] - The tang having a hook**

270. The item Mr. Babcock identifies as a tang does not have a hook; instead, he identifies a protrusion on the body of the rigid case as somehow satisfying the requirement that the tang has a hook. Nothing actually extends from the “tang” in Mr. Babcock’s analysis, and he admits it by trying to arbitrarily flip the position of the protrusion to the clip of Matthews. Ex. 1002 at ¶¶ 788-789.

271. This analysis is completely baseless. Mr. Babcock opines that, for no reason at all, a POSITA would have swapped the position of the post and the hole in Matthews. Ex. 1002 at ¶¶ 788-789. Mr. Babcock does not provide any reason for that swap other than to result in the claims of the ‘808 Patent (an impermissible purpose) and does not describe the difference in manufacturing approach that would be needed to effectuate that swap. His analysis simply does not find a basis in the law as I understand it—it’s an arbitrary modification being made solely for the purpose of trying to invalidate a patent claim.

272. Mr. Babcock opines that his modification would “achieve an equivalent apparatus, and thereby be within the scope of Matthew’s invention.” Ex. 1002 at ¶

789. I am not familiar with any tenets of obviousness that stand for that proposition, and in any case I do not agree that Matthews teaches the modification that Mr. Babcock aspires to make. There is simply no justifiable reason to make this modification (other than to try to invalidate the '808 Patent), and in my opinion the same is improper from a technical perspective.

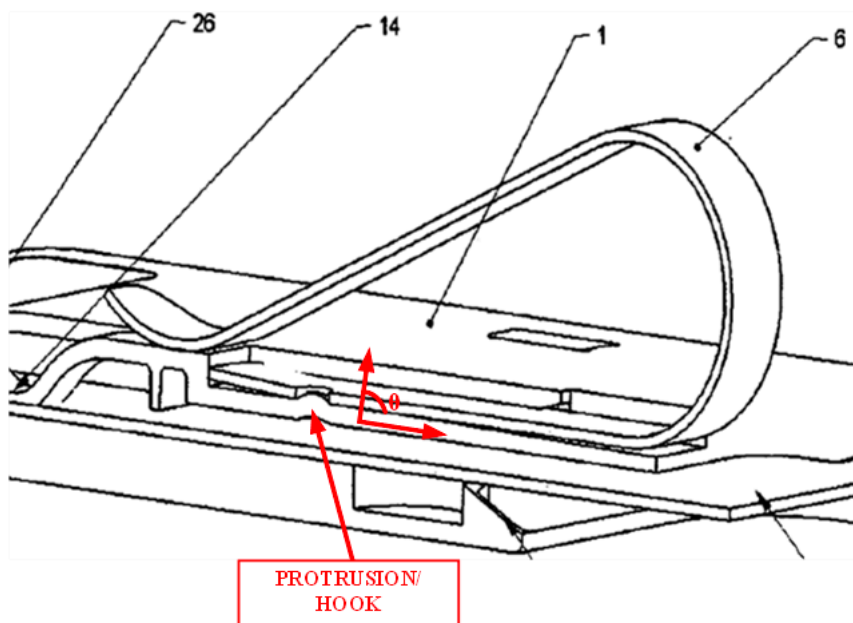
273. Moreover, because (according to the claims) the tang is insertable in the recess, and the hook is a portion of the tang (and because of the engagement discussed below), the hook must be in the recess formed inside the at least two plates. There is no recess disclosed as claimed in Matthews, because the identified item is merely a depression in an outer plastic plate.

274. In addition, reiterating my analysis of the prior limitation, there is no reason to modify Kane with Matthews to result in a hook as claimed. The structural differences between the two devices mean that Matthews' design is inapplicable to Kane's design; Mr. Babcock's analysis as to the combinability (Ex. 1002 at ¶¶ 790-792) is again solely based on impermissible hindsight reconstruction. He again seeks to create a Frankenstein's monster situation where features of which are incompatible with the sandwich-plate design of Kane would nevertheless be added to Kane. Worse than before, his analysis here incorrectly states that Matthews actually discloses a tang having a hook (it does not). Ex. 1002 at ¶ 791.

275. Mr. Babcock admits that a combination between Kane and Matthews does not include a tang having a hook, and his “analysis” as to why to arbitrarily move features around on those references is not based on sound bases for modification.

- **Claim 1[h] - the hook extending at an angle to the tang**

276. The item Mr. Babcock identifies as a tang does not have a hook, and that is all the more apparent when viewed in terms of the requirement for the hook to extend at an angle to the tang. For example, the following is not compelling:



Ex. 1002 at ¶ 795. It is not even clear what angle he is talking about here. What is clear, however, is that the thing he identifies as a tang in Matthews does not have a hook extending at an angle thereto. The only item that extends from anything

extends from the case itself, and into an opening (a hole) *in the thing Mr. Babcock identifies as a Tang*.

277. Moreover, as I have already explained, the hook is not the claimed hook for various reasons. Mr. Babcock’s analysis in Paragraphs 798-800 does not change my prior analysis; it is the same type of unsupported, aspirational, hindsight-driven analysis Mr. Babcock engages in throughout the entirety of his declaration. Ex. 1002 at ¶¶ 798-800.

- **Claim 1[i] - the hook engaging an undercut of the recess to prevent inadvertent dislodgement of the auxiliary feature from the recess**

278. Finally with regard to the Missing Kane Limitations, I do not agree that Mr. Babcock has shown that it was obvious to modify Kane to result in a hook engaging an undercut of the recess to prevent inadvertent dislodgment of the auxiliary feature from the recess.

279. As I described above, there is no recess in a sandwich-plate environment in Matthews, and a POSITA would not have modified Kane to include a recess. As such, the item Mr. Babcock relies on as a “hook” is (1) not a part of the tang, (2) does not extend at an angle to the thing identified as a tang, and (3) does not engage an undercut of the claimed recess to prevent inadvertent dislodgment of the auxiliary feature from the recess.

280. Incredibly, in the identified combination, Mr. Babcock identifies an undercut *in the tang* and a purported hook *in the body of the device*:

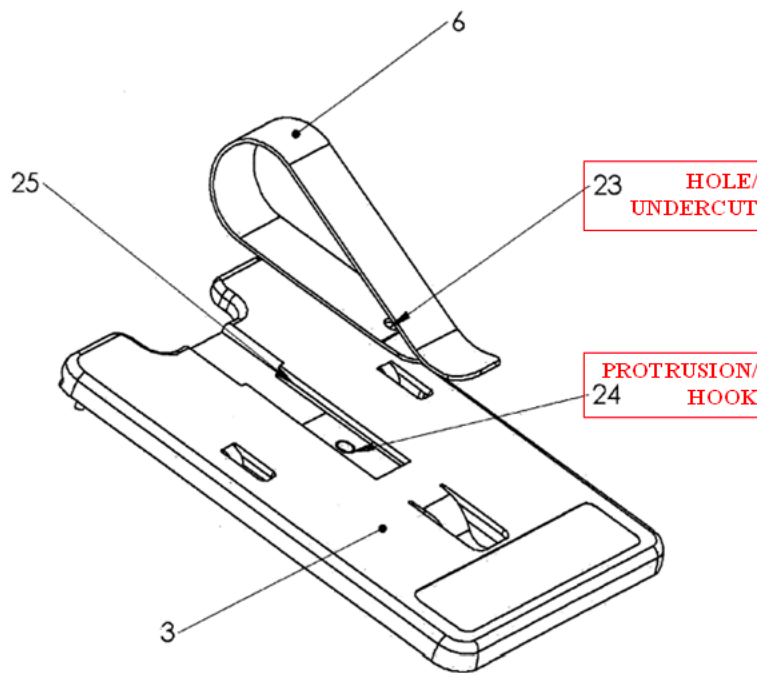


FIG. 4

Ex. 1002 at ¶ 803. This, of course, is backward from the way the claims are written, and is inapplicable and irrelevant to the claims.

281. Mr. Babcock knows how fractured his analysis is, and again tries to “rearrange” (really, to arbitrarily flip) the positions of items in Matthews’ disclosure. Ex. 1002 at ¶ 804. So in addition to modifying Kane with an inapplicable reference in Matthews, he wants to arbitrarily flip parts around within Matthews. Aside from a complete lack of a reason to do so, Mr. Babcock does not do any analysis as to the manufacturing differences in this arrangement; there are many. He also does not explain how the arbitrary “rearrang[ing]” of parts in Matthews would apply when that rearranged Matthews disclosure is incorporated into Kane. *Id.*

282. A POSITA both would not have modified Kane in view of Matthews, and also would not have rearranged the features of Matthews in the way Mr. Babcock proposes. I believe Mr. Babcock's opinions about the combination of Kane and Matthews are incorrect, and are wholly driven by hindsight bias; they represent perhaps the most egregious attempt in his entire declaration to piece together the references by using the '808 Patent as a guide.

2. *Claims 2-9, 11-13, and 18*

283. These claims each depend from independent claim 1, and Mr. Babcock relies exclusively on the teachings of Kane for the additional requirements of dependent claims 2-9, 12, 13, and 18. Ex. 1002 at ¶¶ 812-819 (Claim 2); Ex. 1002 at ¶¶ 820-823 (Claim 3); Ex. 1002 at ¶¶ 824-827 (Claim 4); Ex. 1002 at ¶¶ 828-831 (Claim 5); Ex. 1002 at ¶¶ 832-835 (Claim 6); Ex. 1002 at ¶¶ 836-839 (Claim 7); Ex. 1002 at ¶¶ 840-843 (Claim 8); Ex. 1002 at ¶¶ 844-847 (Claim 9); Ex. 1002 at ¶¶ 858-865 (Claim 12); Ex. 1002 at ¶¶ 866-869 (Claim 13); Ex. 1002 at ¶¶ 933-936 (Claim 18). And while Mr. Babcock cites to Matthews as also holding credit cards with respect to Claim 11, he also relies on Kane for that analysis as well. Ex. 1002 at ¶¶ 852-857 (Claim 11).

284. Notably, Mr. Babcock provides no further combination analysis or rationale in his analysis of dependent claims 2-9, 11-13, or 18, meaning that my

rebuttal to his combination analysis with respect to claim 1 is equally applicable to those claims.

285. Without conceding that the additional limitations of these dependent claims are present (particularly because the combination relied upon in Ground 1 is improper), at least the reasons given above with regard to claim 1 demonstrate Mr. Babcock's failure to show that these dependent claims are obvious.

3. *Claim 14*

286. Unlike independent claim 1, independent claim 14 does not affirmatively require the "auxiliary feature" to be a part of the claimed compact wallet. In other words, one could infringe claim 14 (or, in Ridge's case, permissibly practice claim 14) by selling a wallet having the same internal structure required by claim 1, even if it is not sold with a money clip (the auxiliary feature) to engage those internal structures. Nevertheless, to show invalidity, Mr. Babcock would have to show a capability to interface with the requisite parts of a removable auxiliary feature.

287. Nevertheless, Mr. Babcock admits that Kane does not disclose the Missing Kane Limitations of Claim 14 (i.e., claim elements 14[e], 14[f], 14[g], and 14[h]). Ex. 1002 at ¶¶ 882-913.

288. I hereby incorporate by reference my analysis of Claim 1 with respect to Ground 1 as if fully reproduced herein.

289. In particular, I incorporate my analysis of Claim 1[e] with respect to Mr. Babcock's analysis of Claim 14[e]. Ex. 1002 at ¶¶ 882-890.

290. I incorporate my analysis of Claim 1[f] with respect to Mr. Babcock's analysis of Claim 14[f]. Ex. 1002 at ¶¶ 891-896.

291. I incorporate my analysis of Claim 1[g] and Claim 1[i] with respect to Mr. Babcock's analysis of Claim 14[g]. Ex. 1002 at ¶¶ 897-904.

292. I incorporate my analysis of Claim 1[h] with respect to Mr. Babcock's analysis of Claim 14[h]. Ex. 1002 at ¶¶ 906-913.

293. For the same reasons I gave with regard to claim 1, the limitations corresponding to the Missing Kane Limitations (i.e., Claim elements 14[e], 14[f], 14[g], and 14[h]) are not obvious in the form they show up in claim 14. For the same reasons I gave above with regard to claim 1, a POSITA would not have made the Kane-Beckley combination Mr. Babcock advocates for purposes of claim 14 without relying on impermissible hindsight bias and without using the claims of the '808 Patent as a blueprint to piece together the prior art as laid out in the claims. Because Mr. Babcock concedes Kane does not disclose all of the limitations of claim 14, if the combination fails, then his obviousness analysis also fails. Mr. Babcock's analysis of claim 14 is thus equally unavailing. Ex. 1002 at ¶¶ 882-913.

1. Claims 15-17

294. These claims depend from independent claim 14, and Mr. Babcock relies exclusively on the teachings of Kane with respect to the additional limitations of these dependent claims. Ex. 1002 at ¶¶ 917-924 (Claim 15); Ex. 1002 at ¶¶ 925-928 (Claim 16); Ex. 1002 at ¶¶ 929-932 (Claim 17).

295. Notably, Mr. Babcock provides no further combination analysis or rationale in his analysis of dependent claims 15-17, meaning that my rebuttal to his combination analysis with respect to claim 1 is equally applicable to those claims.

296. Without conceding that the additional limitations of these dependent claims are present (particularly because the combination relied upon in Ground 1 is improper), at least the reasons given above with regard to claim 1 demonstrate Mr. Babcock's failure to show that these dependent claims are obvious.

2. Claim 19

297. Claim 19 is essentially a method claim that corresponds to a method of using the device recited in Claim 1/Claim 14. That is, for example, independent claim 19 recites method steps such as "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.

298. However, Claim 19 also adds the requirement that the recesses be “outbound of the elastic band.” Ex. 1001 at Claim 1. Thus, in addition to showing the structures required inside the wallet by claims 1 and 14, Mr. Babcock would have to show that it would have additionally been obvious to position the recesses *outbound of the elastic band*.

299. In addition to his failings with respect to the Missing Kane Limitations (i.e., claim elements 19[e], 19[g], 19[h], 19[j], 19[k], 19[l], and 19[m]), Mr. Babcock also cannot show that it would have been obvious to provide the recesses in the requisite position.

300. Mr. Babcock admits that Kane does not disclose the Missing Kane Limitations of Claim 19 (i.e., claim elements 19[e], 19[g], 19[h], 19[j], 19[k], 19[l], and 19[m]). Ex. 1002 at ¶¶ 950-1015.

301. I hereby incorporate by reference my analysis of Claim 1 with respect to Ground 1 as if fully reproduced herein.

302. In particular, I incorporate my analysis of Claim 1[e] and Claim 1[f] with respect to Mr. Babcock’s analysis of Claim 19[e]. Ex. 1002 at ¶¶ 958-964.

303. I incorporate my analysis of Claim 1[i] and with respect to Mr. Babcock’s analysis of Claim 19[g]. Ex. 1002 at ¶¶ 965-971.

304. I incorporate my analysis of Claim 1[i] and with respect to Mr. Babcock's analysis of Claim 19[h]. Ex. 1002 at ¶¶ 972-977.

305. I incorporate my analysis of Claim 1[g] and with respect to Mr. Babcock's analysis of Claim 19[j]. Ex. 1002 at ¶¶ 984-991.

306. I incorporate my analysis of Claim 1[g] and with respect to Mr. Babcock's analysis of Claim 19[k]. Ex. 1002 at ¶¶ 992-1001.

307. I incorporate my analysis of Claim 1[h] and with respect to Mr. Babcock's analysis of Claim 19[l]. Ex. 1002 at ¶¶ 1002-1008.

308. I incorporate my analysis of Claim 1[f] and with respect to Mr. Babcock's analysis of Claim 19[m]. Ex. 1002 at ¶¶ 1009-1015.

309. For the same reasons I gave with regard to claim 1, the limitations corresponding to the Missing Kane Limitations (i.e., Claim elements 19[e], 19[g], 19[h], 19[j], 19[k], 19[l], and 19[m]) are not obvious in the form they show up in claim 19. For the same reasons I gave above with regard to claim 1, a POSITA would not have made the Kane-Matthews combination Mr. Babcock advocates for purposes of claim 19 without relying on impermissible hindsight bias and without using the claims of the '808 Patent as a blueprint to piece together the prior art as laid out in the claims. Because Mr. Babcock concedes Kane does not disclose all of the limitations of claim 19, if the combination fails, then his obviousness analysis

also fails. Mr. Babcock’s analysis of claim 19 is thus equally unavailing. Ex. 1002 at ¶¶ 392-447.

310. In addition, claim 19 requires “at least one groove additionally having at least one recess positioned outbound of the elastic band.” Ex. 1001 at Claim 19. This limitation is not explicitly present in the other independent claims. Mr. Babcock’s sole analysis of this limitation is as follows:

955. Moreover, a POSITA would have been motivated to form the recess, like that disclosed by Matthews, in one or more the interior plate-outer faceplate pairs (“rigid plates”), like that disclosed by Kane, outbound the encircling elastic band (“elastic band,” understood to reference the “at least one encircling elastic band”) to avoid interference between the function of the recess (e.g., to capture an auxiliary feature) and the function of the elastic band (e.g., to expand and contract while enabling the wallet to have elastic volume).

956. In addition, A POSITA would have been motivated to form the recess, like that disclosed by Matthews, in one or more the interior plate-outer faceplate pairs (“rigid plates”), like that disclosed by Kane, outbound the elastic band at least because said positioning is one of a finite number of identified, predictable positions, with a reasonable expectation of success. For example, there are a finite number of locations in the interior plate-outer faceplate pairs (“rigid plates”), like that disclosed by Kane, where a recess, like that disclosed by Matthews, could be positioned. In my opinion, a POSITA would have reasonably predicted that positioning a recess, like that disclosed by Matthews, outbound the encircling elastic band, like that disclosed by Kane, would result in successful operation of both the insertion opening (“recess”) and the elastic band.

Ex. 1002 at ¶¶ 955-956. I disagree with Mr. Babcock’s analysis.

311. The only “analysis” of why a POSITA would position recesses outbound of the channel is Mr. Babcock’s statement that such a modification would

be made to “to avoid interference between the function of the recess (e.g., to capture an auxiliary feature) and the function of the elastic band.” Ex. 1002 at ¶ 955. This is the epitome of hindsight reconstruction. There is no grounding whatsoever in the prior art references; Mr. Babcock merely uses the claims as a blueprint to modify the proposed combination of Kane and Matthews without any reason whatsoever. Moreover, since Mr. Babcock has already proposed baselessly swapping the position of the item he relies on as the “hook” and the item he relies on as the “recess,” this additional, unsupported modification is inadequate. He does not explain how the combined device would function, and certainly does not address the fact that adding outbound recesses (after flipping the recess and the hook) would result in a totally differently shaped device than in either Kane, Matthews, or the proposed combination.

312. Mr. Babcock also opines that because there are a finite number of positions for the recesses, a POSITA would have found it obvious to position the recess outbound of the channel. Ex. 1002 at ¶ 956. For the same reasons given above, however, there is absolutely no reason to first flip the position of the two items in Matthews and to second position the recess (which is now on the body of the device) outbound of the purported channel.

313. In short, Mr. Babcock’s analysis of Claim 19 is deficient, and underscores just how much he is trying to combine two un-combinable, incompatible references together in his Kane/Matthews combination.

3. *Claim 20*

314. Claim 20 depends from independent claim 19, which as I explained above is not obvious in view of Kane and Matthews. Claim 20 further recites aspects of the “hook,” “recess,” and “undercut,” so my analysis of the Missing Kane Limitations above applies equally to claim 20 as it did to independent claims 1, 14, and 19. I incorporate my analysis of the Missing Kane Limitations with respect to claim 1 as if set forth fully herein.

315. Accordingly, in my opinion, Mr. Babcock has not shown that this dependent claim is obvious. Ex. 1002 at ¶¶ 1019-1026.

4. *Claim 21*

316. Claim 21 depends from independent claim 19, which as I explained above is not obvious in view of Kane and Matthews. Without conceding that the additional limitations of this dependent claim are present (particularly because the combination relied upon is improper), I note that at least the reasons given above with regard to claim 19 demonstrate Mr. Babcock’s failure to show that this dependent claim is obvious.

IX. SECONDARY CONSIDERATIONS OF NON-OBVIOUSNESS

317. Mr. Babcock does not present any opinions as to secondary considerations of non-obviousness, though he does acknowledge that such evidence, when present, is relevant to the obviousness inquiry. *See generally* Ex. 1002 (not addressing secondary considerations); Ex. 1002 at ¶ 10 (acknowledging requirement to analyze secondary considerations).

A. SECONDARY CONSIDERATION EVIDENCE

318. I understand that Mr. Babcock chose to ignore certain theories of which he was aware (or should have been aware). In particular, I understand that Ridge has asserted certain secondary considerations of non-obviousness in its discovery responses in the pending District Court case in Colorado between the parties. Ex. 2007 at 11-12.

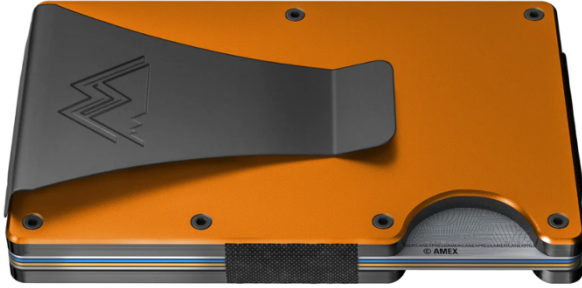
319. I have reviewed Ridge's discovery responses, which include the statement that:

[T]he 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 nonobviousness. 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.

320. I agree with the above statement, and believe that these facts (and the testimonial and documentary evidence underlying the same) supports a conclusion that the claims of the ‘808 Patent are non-obvious.

321. I am also familiar with an article in which an interviewer interviewed Mountain Voyage’s founder, Joseph Reeves. Ex. 2008. That article includes the statement from Mr. Reeves that he essentially copied Ridge’s product (he uses the word “emulated”) when he decided to get into business selling competitive compact wallets. *Id.* This is unsurprising, as Mountain Voyage’s products look nearly identical to Ridge’s products (albeit at a noticeably lower quality):

 A photograph of a Ridge Orange Wallet. The wallet is orange with a black flap and a black strap. It is shown open, revealing a US dollar bill and a credit card. The credit card has the number 9010 1234 5678 9010 and the name "Customer service phone: 1-800-123-4567".	 A photograph of a Mountain Voyage Orange Wallet. The wallet is orange with a black flap and a black strap. It is shown closed, with a black strap across the front. The strap has a logo that looks like a stylized 'M' or 'V'. The wallet has a textured surface and a small metal clasp at the bottom.
Ex. 2025 (Ridge Orange Wallet)	Ex. 2026 (Mountain Voyage Orange Wallet)

Thus, to the extent that Mountain Voyage does not admit that it copied *Ridge*, it certainly seems at least to have copied a Ridge wallet (even if copied from another, intervening, copyist).

322. This copying, by Mr. Reeves himself, indicates that the claimed inventions of the '808 Patent are NOT obvious. He had no business before Ridge, and his business after Ridge is selling Ridge clones.

323. That same article also discusses the fact that in 2021, Mr. Reeves was able to emulate Ridge's silhouette merely by going on Alibaba.com and finding a Chinese seller willing to apply his logo and import the products into the USA for fulfillment by Amazon.com. This indicates that not only did Mr. Reeves (and Mountain Voyage) copy the Ridge product, but by that time the copyist market had developed sufficiently that Chinese manufacturers were selling the Ridge wallet knockoffs, in bulk, to customers all over the world. In my experience, this means that the volume of production coming out of China was substantial—for low margin products like these, substantial volume is required to make it worth the manufacturers' while. Thus, copying by the manufacturers had begun long before Mr. Reeves entered the picture, as the investment by such manufacturers would have to be substantial to produce Ridge wallet clones on a large scale.

324. The above indicates that there has been and continues to be substantial copying of Ridge's invention both by Chinese factories making products abroad, and

by domestic infringers (such as Mountain Voyage) who buy products from those Chinese factories and drop ship them to customers via Amazon.com and other online marketplace platforms.

325. Consistent with the above, I was involved in a case as Ridge's technical expert at the United States International Trade Commission ("ITC") which I understand resulted in the ITC issuing a General Exclusion Order banning importation of ANY infringing product, regardless of the importer of record. *See* Ex. 2009. This recognition of the value of the '808 Patent (especially given the severity and breadth of the remedy) is a further secondary indicator of the non-obviousness of that patent.

326. In connection with that order, I understand that Ridge persuasively argued that infringing entities started knocking off Ridge's products in bulk starting in 2019 or 2020, further demonstrating that it is the '808 Patent's claimed technology that drives the success not just of Ridge's products but also of the factories abroad that permit infringers like Mountain Voyage to infringe.

327. I understand that Ridge currently has an Order from a Court in Illinois that bars one of the factories that was historically the biggest source of infringing products from infringing the '808 Patent. Ex. 2022. I understand that Order was obtained, in part, because the factory (X-World) chose not to show up and defend

itself. Ex. 2020 at ¶¶61. This buttresses my observations above with regard to the General Exclusion Order, namely, that a Chinese factory would rather stop selling

328. I also understand that Mosaic, a respondent in the ITC case I referenced above, agreed to cease and desist from making the product that was accused of infringement as a part of its settlement with Ridge, rather than continuing to fight. Ex. 2020 at ¶69. These types of agreements are secondary considerations evidence that further support a conclusion that the ‘808 Patent claims are not obvious.

329. I understand that even outside of litigation, Ridge has had success in convincing certain infringers to cease and desist further sales of infringing wallets, which suggests that those third parties recognize the validity of the ‘808 Patent. Ex. 2020 at ¶70.

330. The approach by third-party infringers to Ridge’s ‘808 Patent (both inside and outside the context of litigation) indicates that the secondary consideration related to licensing activities by others (and, indeed, the fact that others are willing to cease and desist selling rather than fighting against the ‘808 Patent) is present here.

331. I understand that there really were no competitors for Ridge until the late 2010’s or early 2020’s. Ex. 2020 at ¶¶50-52. That is so despite the fact that Mr. Kane introduced his first iteration of the wallet in 2013. In addition, Mr. Kane’s own publication is the primary piece of prior art on which Mr. Babcock (and

Mountain Voyage) relies. The fact that Mr. Kane's own work needs to be modified, but was not actually modified as claimed in the '808 Patent until such time as Mr. Kane filed the application that led to the '808 Patent, indicates that his invention was against conventional wisdom. This indicates that at least the recognized secondary considerations related to long-felt, but unmet need, failure of others, the invention being contrary to the accepted wisdom of the prior art (that is, Mr. Kane's own wisdom as the prior artisan), and lack of contemporaneous and independent invention by others are present in this situation.

332. Finally, Mr. Kane testifies about the commercial success of Ridge as a company post-introduction of the designs claimed in the '808 Patent. Ex. 2020 at ¶¶57-58. This success, which is temporally tied to the filing of the '808 Patent, indicates that the secondary considerations related to long-felt and unmet need, commercial success, unexpected results, and praise of the invention by others are present here.

333. Based on my understanding of the law, I believe that each of the facts outlined above constitutes objective evidence of non-obviousness, and supports my conclusion that it would not have been obvious to a POSITA to have modified Kane as Mr. Babcock suggests. It also confirms that Mr. Babcock's arguments are made only with the benefit of hindsight.

B. NEXUS

334. I understand that in order for secondary considerations evidence to be relevant to the obviousness inquiry, there must be a “nexus” between the secondary considerations evidence and the claimed invention. I also understand that the Board has held that a patentee is entitled to a presumption of nexus when the patentee shows that the asserted objective evidence is tied to a specific product and that product embodies the claimed features, and is coextensive with them. I understand that the purpose of the co-extensiveness requirement is to ensure that nexus is only presumed when the product tied to the evidence of secondary considerations is the invention disclosed and claimed.

335. Attached as Ex. 2019 is an excerpt from a witness statement I provided in the ITC in which I mapped the Ridge products that have been on the market since mid-2016 against claims 1, 2, and 14 of the ‘808 Patent. My mapping is based on photographs that either I took of Ridge products, or that I directed Ridge’s counsel to take of Ridge’s products. I did that as part of the ITC case in support of the so-called the “technical prong” of the domestic industry requirement, which I understand the Commission ultimately found that Ridge satisfied. I incorporate that analysis from my prior, sworn witness statement herein. I also note that the design I opined about at the ITC is nearly identical to the Figures (in particular, Figure 13) of the ‘808 Patent.

336. I also note that I offered similar opinions (i.e., that Ridge’s products practice the ‘808 Patent) in support of a damages argument in the District of Colorado case; Mr. Babcock filed a rebuttal report to my opinions, but did not take issue with my conclusion that Ridge’s products practice the ‘808 Patent. Thus, I believe Mr. Babcock agrees that Ridge’s products practice the ‘808 Patent; this is unsurprising, as the products look almost exactly like Figs. 12-14 of the ‘808 Patent, whose disclosures support the claims of the ‘808 Patent.

337. Per the analysis I did in the ITC and incorporated by reference herein (Ex. 2019), I believe that the “co-extensiveness” requirement is met and that Ridge is entitled to a presumption of nexus. Ridge’s products embody the claimed features, and they are coextensive with the claimed features because the claims essentially recite all aspects of the Ridge wallet products post-summer 2016. And, as I noted at the ITC, Ridge’s products embody the claims of the ‘808 Patent even if they are sold with a cash strap, and not a money clip, due to the internal structure of each wallet being *able* to receive a money clip.

338. In addition, the evidence Mr. Kane discusses in his declaration pertains to the models of Ridge products that were sold after mid-2016, and thus relates to the products that were the “domestic industry” products at the ITC. Ex. 2020 at ¶41. Thus, it is my opinion that the data and testimony Mr. Kane provides all does indeed

have a nexus to the inventions of the ‘808 Patent, and particularly to the aspects of the wallets referenced as the “Missing Kane Limitations” in this declaration.

339. Accordingly, based on information I myself am familiar with, based on my opinions previously at the ITC, and based on my review of Mr. Kane’s declaration in this matter, it is my opinion that secondary considerations evidence with a nexus to the inventions claimed in the ‘808 Patent supports a finding that the claims are not obvious.

340. I reserve the right to further address any actual theories Mr. Babcock presents, if he is permitted to present them, on the issue of secondary considerations in the future.

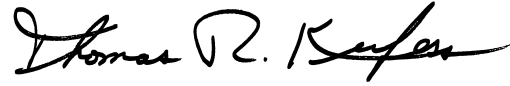
X. CONCLUSION

341. For the reasons outlined above, I disagree with Mr. Babcock’s opinions about patent invalidity. To the contrary, the claims of the ‘808 Patent, which were allowed over much of the prior art Mr. Babcock relies on (most notably, Ridge’s own work in the form of Kane), are patentable under my understanding of the law. That conclusion is buttressed by the objective evidence I have seen from Ridge, which, in my opinion, has the requisite nexus to the claims of the ‘808 Patent.

342. I declare that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true, and that these statements were made with the knowledge that willful false statements and the

like are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code.

Respectfully Submitted,

A handwritten signature in black ink, reading "Thomas R. Kurfess". The signature is written in a cursive style with a large, stylized "T" and "K".

Dr. Thomas R. Kurfess, Ph.D. P.E.