

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TROVE BRANDS, LLC,

Petitioner

v.

CAMELBAK PRODUCTS, LLC,

Patent Owner

IPR2024-01137

Patent 10,676,255 B2

**PATENT OWNER'S PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. § 42.107**

TABLE OF CONTENTS

I.	Introduction	1
II.	The '255 Patent	5
A.	Claims	5
B.	Specification.....	7
C.	Prosecution History.....	12
1.	Original Examination	14
2.	<i>Ex Parte</i> Reexamination	15
III.	Petitioner’s Grounds and Cited References	21
A.	Nakajima	22
B.	Ribarits	28
C.	Secondary References	34
IV.	Level of Ordinary Skill in the Art.....	35
V.	Claim Construction	35
A.	“Adapted to Resiliently Compress Responsive to Compressive Forces Applied to the Resilient Mouthpiece by a User’s Teeth”	36
VI.	Petitioner Has not Shown a Reasonable Likelihood of Prevailing on Any Claim.....	41
A.	Grounds 1 and 2 Fail Because Nakajima Does Not Disclose or Render Obvious a <i>Resilient Mouthpiece</i> Satisfying the <i>Pivotal Movement</i> Limitations of the Claims.....	41
1.	Nakajima Does Not Disclose a <i>Mouthpiece</i> with the <i>Pivotal Movement</i> That Is <i>with the Pivotal Mount</i> and <i>About an Axis Defined by the Lateral</i> <i>Projections</i> , as Required by the Claims.....	42
2.	Given the Deficiencies in Nakajima, Petitioner Cannot Prevail on Any Claim as to Grounds 1 and 2.....	50
B.	Grounds 3 and 4 Fail Because Ribarits Does Not Disclose or Render Obvious the <i>Resilient Mouthpiece</i> of the Claims That Is <i>Adapted to</i> <i>Resiliently Compress</i> from <i>Forces Applied</i> by a User’s Teeth or That Is <i>Removably Coupled to the Pivotal Mount</i>	50

1. The Alleged <i>Resilient Mouthpiece</i> in Ribarits Is Shielded from Any <i>Compressive Forces</i> from a <i>User’s Teeth</i> , Not <i>Adapted to Resiliently Compress</i> in Response to Such Forces	51
2. Petitioner Fails to Present Any Evidence or Argument That Ribarits Discloses or Renders Obvious a <i>Resilient Mouthpiece Removably Coupled to a Pivotal Mount</i>	57
3. Given the Deficiencies in Ribarits, Petitioner Cannot Prevail on Any Claim as to Grounds 3 and 4.....	63
VII. The Board should Exercise Discretion Under § 314(A) to Deny the Petition	64
A. <i>Factor 1: Likelihood of Stay</i>	66
B. <i>Factor 2: Trial Date Relative to Final Written Decision Due Date</i>	67
C. <i>Factor 3: Investment in Trial Court Proceedings</i>	68
D. <i>Factor 4: Overlap of Issues</i>	71
E. <i>Factor 5: Same Parties</i>	73
F. <i>Factor 6: Other Considerations</i>	74
G. Combined Factors	75
VIII. Conclusion	77

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>10x Genomics, Inc. v. President and Fellows of Harvard College</i> , IPR2023-01299, Paper 15 (P.T.A.B. Aug. 30, 2023).....	65
<i>Apple Inc. v. Fintiv Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	<i>passim</i>
<i>Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.</i> , 672 F.3d 1335 (Fed. Cir. 2012)	33, 37, 49
<i>CommScope Techs. LLC v. Dali Wireless, Inc.</i> , IPR2022-01242, Paper 23 (PTAB February 27, 2023)	69
<i>ERBE Elektromedizin GmbH v. Canady Tech. LLC</i> , 629 F.3d 1278 (Fed. Cir. 2010)	54
<i>Finjan, Inc. v. Blue Coat Sys., Inc.</i> , No. 5:15-cv-03295, 2016 WL 7732542 (N.D. Cal. July 25, 2016).....	62
<i>Finjan, Inc. v. FireEye, Inc.</i> , No. 4:13-cv-03133, 2017 WL 1150283 (N.D. Cal. Mar. 28, 2017).....	62
<i>Fintiv</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020)	69
<i>In re Giannelli</i> , 739 F.3d 1375 (Fed. Cir. 2014)	33, 34, 35, 37
<i>In re Man Mach. Interface Techs. LLC</i> , 822 F.3d 1282 (Fed. Cir. 2016)	33, 34, 37
<i>NHK Spring Co. Ltd. v. Intri-Plex Techs. Inc.</i> , IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018).....	61
<i>OpenSky Indus., LLC v. VLSI Tech. LLC</i> , IPR2021-01064, Paper 102 (PTAB Oct. 4, 2022).....	70

<i>SAS Inst., Inc. v. ComplementSoft, LLC</i> , 825 F.3d 1341 (Fed. Cir. 2016) (Newman, J., dissenting-in-part), <i>rev'd in part by SAS Inst., Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018).....	60
---	----

<i>Sotera</i> , IPR2020-01019, Paper 12.....	68, 69
---	--------

<i>Verizon Bus. Network</i> , IPR2020-01292, Paper 13.....	63
---	----

Statutes

35 U.S.C. § 312(a)(3).....	54
35 U.S.C. §§ 312(a)(3)(A) & 312(a)(5).....	20, 26
35 U.S.C § 314.....	4
35 U.S.C. § 314(a)	<i>passim</i>
35 U.S.C. § 314(b)	63
35 U.S.C. § 316(a)(11).....	63

Other Authorities

37 C.F.R. § 42.100(c).....	63
Request No. 90/015,192.....	12
U.S. Patent No. 4,485,963.....	20
U.S. Patent No. 6,070,767.....	19
U.S. Patent No. 6,523,711.....	20
U.S. Patent No. 7,533,783.....	12
U.S. Patent No. 10,676,255.....	<i>passim</i>
U.S. Patent. No. D547,607.....	13

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	File History of <i>Ex Parte</i> Reexamination Control No. 90/015,192
2002	August 2, 2024 Stipulation and Joint Motion to Amend the Case Schedule in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal.) at Dkt. 100
2003	Docket in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal.)
2004	Initial Infringement Contentions in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal.), served December 21, 2023
2005	Initial Invalidity Contentions in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal.), served January 22, 2024
2006	Amended Invalidity Contentions in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal.), served July 18, 2024
2007	Declaration of Ryan Schletzbaum
2008	U.S. Patent Application Publication No. 2005/0029271 to McDonough
2009	Japanese Patent App. Pub. No. 2001-294252 to Toudou
2010	File History of U.S. Patent No. 10,676,255
2011	U.S. Patent No. 6,116,458 to Dark
2012	U.S. Design Patent No. D547,607 to Forsman
2013	Appendix D1 (“Ribarits” Claim Chart) to Amended Invalidity Contentions in <i>Trove Brands LLC v. CamelBak Prods., LLC and Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal.), served April 12, 2024
2014	Appendix D3 (“Nakajima” Claim Chart) to Amended Invalidity Contentions in <i>Trove Brands LLC v. CamelBak Prods., LLC and</i>

	<i>Vista Outdoor Inc.</i> , No. 5:23-cv-4267 (N.D. Cal.), served April 12, 2024
2015	U.S. Patent Application Publication No. 2002/0166990 to Yang

I. INTRODUCTION

Petitioner Trove Brands, LLC challenges claims 1–7 and 9–23 of U.S. Patent No. 10,676,255 (“the ’255 patent”), asserting grounds of obviousness based on two primary references. The ’255 patent is generally directed to drink containers having a “cap assembly” that includes a resilient, bite-able mouthpiece coupled to a “pivotal mount.” During original prosecution and reexamination, the Examiner determined the following key features, among others, distinguished the ’255 patent from the prior art: i) the pivotal movement of both the mouthpiece and pivotal mount together about a common axis and ii) the removable coupling of the mouthpiece to the pivotal mount. The primary references on which Petitioner bases its grounds fail to disclose these key features. The Petition therefore fails to show a reasonable likelihood of prevailing on any claim, and the Board should therefore deny the Petition on the merits.

In addition, the issues presented in the Petition substantially overlap with issues Petitioner raises in parallel litigation, and that case is scheduled for trial months before the Board will be able to issue its final written decision here. The Board, therefore, should also deny institution in its discretion under 35 U.S.C. § 314(a) and *Fintiv*.

Specifically, the Board should deny institution for at least the following reasons:

First, Grounds 1 and 2 both rely on the same primary reference—Nakajima, a published Japanese patent application—whose express disclosure shows that it does not satisfy the claims. Every claim of the '255 patent requires that the “resilient mouthpiece” and “pivotal mount” be coupled such that the mouthpiece moves pivotally “with” the pivotal mount “about an axis defined by” a specified point of connection between the mount and a “cap assembly base.” Nakajima expressly discloses that its mouthpiece and the alleged pivotal mount do not pivot together nor do they both pivot about the same axis defined by the claim language. Specifically, to the extent Nakajima’s mouthpiece pivots, it does so around a different axis than the pivotal mount, not the axis required by the claim language. Nakajima’s mouthpiece also pivots in the opposite direction from the alleged pivotal mount, which is not “pivotal movement with the pivotal mount,” as claimed. Petitioner’s challenge to every claim challenged under Grounds 1 and 2 relies on Petitioner’s unsupported assertion that Nakajima discloses the claimed “pivotal movement” of the mouthpiece “with the” pivotal mount and about the same defined axis required by the claim language by both the mouthpiece and pivotal mount. Therefore, Petitioner cannot prevail on those Grounds as to any claim.

Second, Grounds 3 and 4 also fail. They both rely on Ribarits—a published PCT application—for the limitations of the “resilient mouthpiece,” including a requirement that it be “adapted to resiliently compress responsive to compressive forces applied to the resilient mouthpiece by a user’s teeth,” present in every claim. Properly construed, the phrase “adapted to” requires that the resilient mouthpiece be “designed or configured to” perform this specified purpose. Ribarits fails to disclose such a design or configuration. Instead, Ribarits discloses a flexible tube enclosed within a drinking spout, which spout prevents a user from biting the end portion of the tube that Petitioner identifies as the resilient mouthpiece. Thus, the alleged resilient mouthpiece is not “adapted to resiliently compress responsive to compressive forces applied to the resilient mouthpiece by a user’s teeth.”

In addition, Petitioner fails to address the limitation requiring that the alleged resilient mouthpiece in Ribarits be “removably coupled” (or “coupled” at all) to Ribarits’s drinking spout (the alleged pivotal mount), as all the claims require. In the absence of any argument that this limitation is met by Ribarits (let alone an explanation as to how), these grounds should be denied based on a failure of proof alone. Moreover, Ribarits depicts a tubular straw that merely passes through an opening in the alleged pivotal mount, just like the prior art found to be insufficient for teaching a mouthpiece “coupled” to a pivotal mount, during reexamination.

Petitioner thus fails to show that Ribarits’s alleged resilient mouthpiece is “coupled” to the alleged pivotal mount. Either of these two deficiencies alone is fatal to the grounds based on Ribarits, so Petitioner cannot prevail as to any claim on Grounds 3 and 4.

Third, using its discretion under § 314, the Board should deny the Petition because institution would needlessly multiply litigation. Petitioner waited more than ten months after filing its declaratory judgment lawsuit and nearly eight months after Patent Owner counterclaimed for infringement to file its Petition. Petitioner presents substantially the same grounds of invalidity in its district court case that it now presents here. Because of its delay, Petitioner’s suit will reach a jury trial well before any final written decision on its Petition. The parties and the district court have invested significantly in the related litigation—the parties have substantially completed document productions, exchanged infringement and invalidity contentions, resolved discovery disputes, fully briefed claim construction, and argued claim construction disputes at a *Markman* hearing. Before any institution decision, the district will likely issue a claim construction order, and fact discovery will be complete. Rather than address the concerns about substantial overlap between the proceedings, Petitioner suggests that it will (if the Board institutes) seek a partial stay, limited only to the ’255 patent. There is nothing to suggest the district

court would be receptive to such a request, though. Further, the weaknesses identified herein in Petitioner’s grounds demonstrate a lack of compelling merits. Thus, the balance of the *Fintiv* factors weigh in favor of denying institution under § 314.

For all these reasons, and as further explained below, Patent Owner Camelbak Products, LLC respectfully requests that the Board deny institution.

II. THE ’255 PATENT

The ’255 patent is titled “Drink Bottles” and is generally directed to drink bottles having resilient mouthpieces that a user is able to bite with the user’s teeth. Ex.1001 at Abstract, 1:30–32, 3:10–17; Ex.1002 at claims 1 & 20. The patent describes drink containers with removable cap assemblies that include a drink spout comprised of a pivotal mount having a removably coupled resilient mouthpiece. Ex.1001 at Abstract, 2:63–3:4, 3:18–21, Figs. 1–2; Ex.1002 at claim 1.

A. Claims

The ’255 patent has 23 claims. Ex.1001 at 19:65–21:20; Ex.1002 at 1:22–3:30. Petitioner challenges claims 1–7 and 9–23, with claims 1 and 20 being the only independent claims. Independent claim 1, as amended by the reexamination certificate, recites:

1. A drink container, comprising:

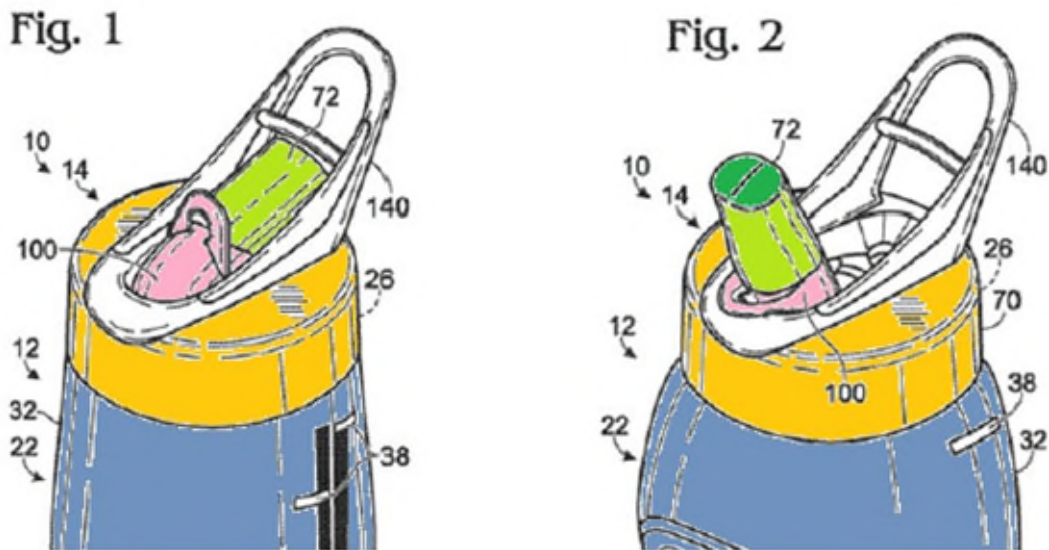
- a fluid container** having a neck with an opening and having an internal compartment sized to hold a volume of potable drink fluid;
- a cap assembly** removably coupled to the fluid container to cover the opening, wherein the cap assembly defines a fluid conduit for drink fluid to flow from the fluid container and through the cap assembly to a user, wherein the fluid conduit includes an inlet through which drink fluid from the fluid container may enter the fluid conduit, and a dispensing outlet through which drink fluid in the fluid conduit may be dispensed from the cap assembly to a user, and further wherein the cap assembly comprises:
 - a cap assembly base** removably coupled to the neck of the fluid container, wherein the cap assembly base is configured to be selectively and repeatedly decoupled from and re-coupled to the neck of the fluid container;
 - a pivotal mount** coupled to the cap assembly base for pivotal movement relative to the cap assembly base, *the pivotal mount comprising a mount outlet*, wherein the pivotal mount includes a pair of lateral projections, wherein the cap assembly base defines a pair of sockets into which the pair of lateral projections extend;
 - a resilient mouthpiece** *engaged with the mount outlet and removably* coupled to the pivotal mount for pivotal movement with the pivotal mount relative to the cap assembly base, wherein the resilient mouthpiece is pivotal about an axis defined by the pair of lateral projections as the pair of lateral projections rotate within the pair of sockets;
- wherein the resilient mouthpiece defines a portion of the fluid conduit, including the dispensing outlet;
- wherein the resilient mouthpiece and the pivotal mount are configured to be selectively pivoted between a stowed position and a dispensing position, and further in the dispensing position, the dispensing outlet is positioned further away from the cap assembly base than when the resilient mouthpiece and the pivotal mount are in the stowed position;
- wherein the resilient mouthpiece is adapted to resiliently compress responsive to compressive forces applied to the resilient mouthpiece by a user's teeth; and

a manual on/off valve having a closed configuration, in which the manual on/off valve obstructs the fluid conduit to restrict drink fluid from flowing between the inlet and the dispensing outlet, and an open configuration, in which the manual on/off valve permits drink fluid to flow through the fluid conduit from the inlet to the dispensing outlet; wherein the manual on/off valve includes a flexible tube that defines a portion of the fluid conduit; wherein when the manual on/off valve is in the closed configuration, the tube is crimped to obstruct the flow of drink fluid through the fluid conduit; and wherein when the manual on/off valve is in the open configuration, the tube is not crimped and does not obstruct the flow of drink fluid through the fluid conduit.

Ex.1002 at claim 1. Claim 20, which is also independent, recites the additional limitation of “a dust cover configured to at least partially cover the dispensing outlet when the mouthpiece and pivotal mount are in the stowed position, wherein the dust cover remains stationary when the mouthpiece and the pivotal mount are selectively pivoted between the stowed position and the dispensing position.” Ex.1002 at claim 20.

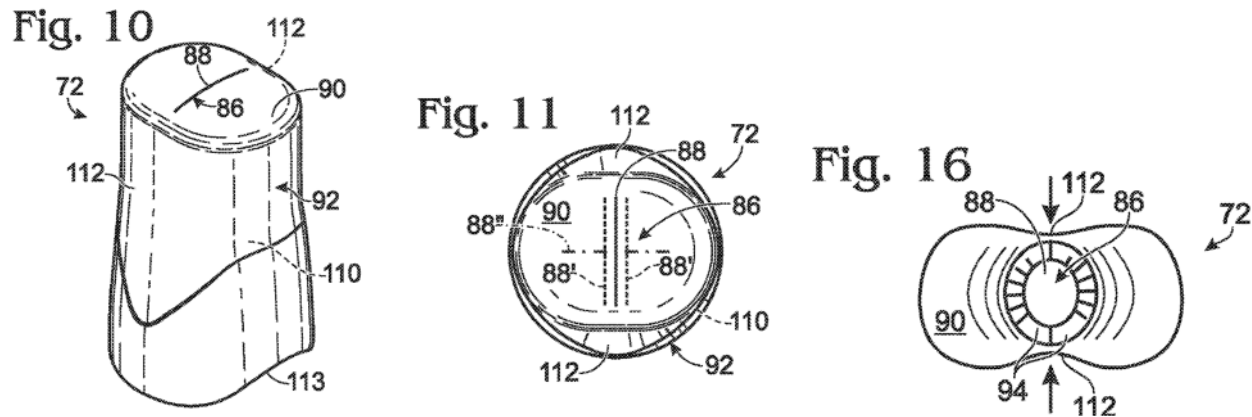
B. Specification

The '255 patent discloses various embodiments of drink containers. For example, the '255 patent describes a drink bottle 10 (blue) with a cap assembly 14 having a base 70 (orange) that includes a pivotal mount 100 (pink) having a removably coupled mouthpiece 70 (green) that a user can bite, as shown below. Ex.1001 at 2:63–67, 3:10–34, 7:1–11, 8:6–10, Figs. 1–2.



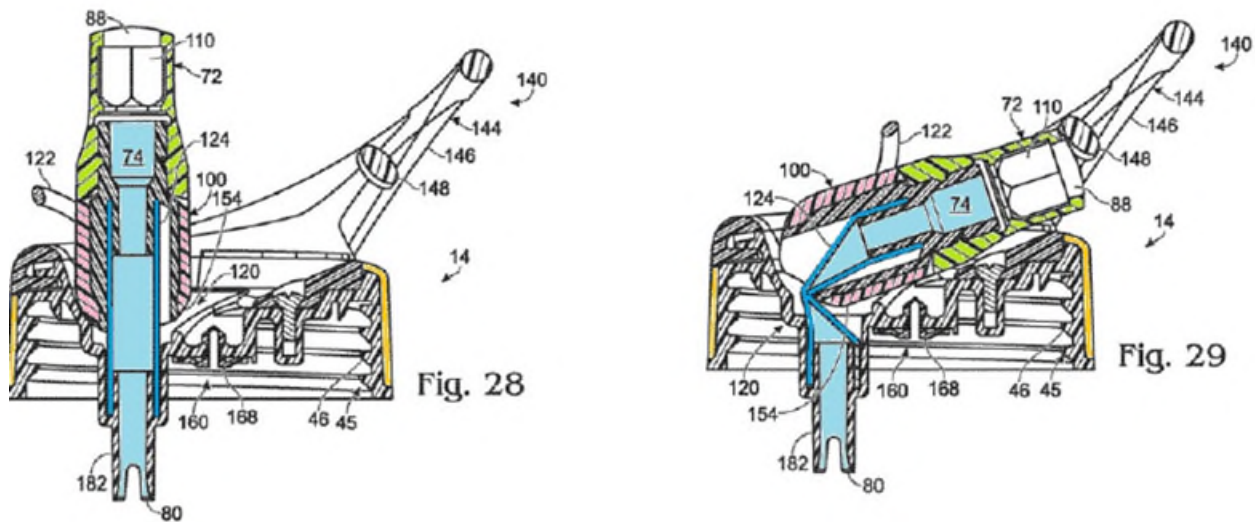
Ex.1001, Figs. 1–2 (annotated); Pet. at 12. The pivotal mount 100 and mouthpiece 72 can pivot together between: i) a stowed position (shown in Figure 1) in which the mouthpiece is not suitably positioned for a user to bite upon it, and ii) a dispensing position (shown in Figure 2) in which the mouthpiece is oriented in a suitable position for the user to bite upon the mouthpiece and drink fluid from the bottle.

Ex.1001 at 3:21–42, 7:25–48. In embodiments, the mouthpiece may have an opening, such as a slit, that is biased to a closed configuration but that may be opened to a dispensing configuration by a user biting on it to deform it so that fluid can flow through the opening. Ex.1001 at 8:14–22, 8:50–9:6, Figs. 10–16.



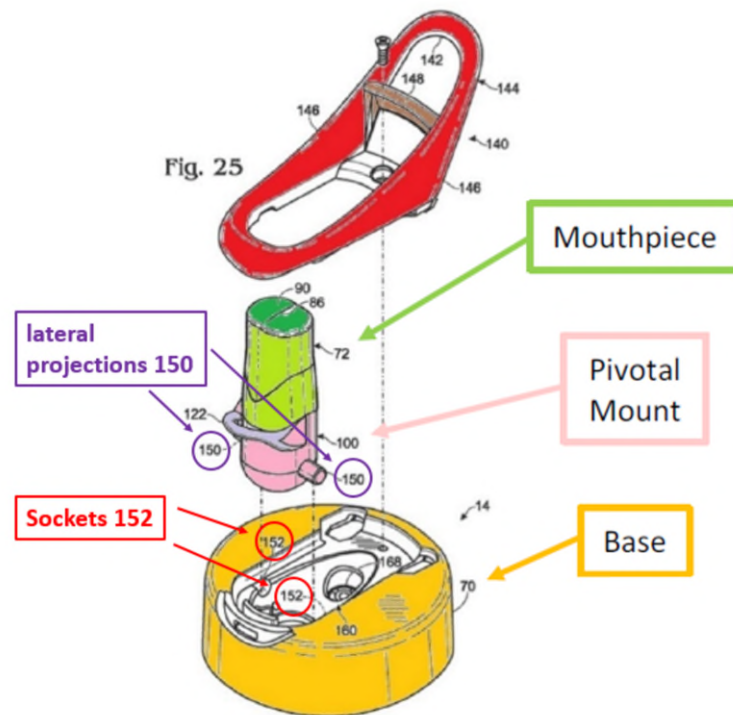
Ex.1001, Figs. 10, 11 & 16. A benefit of this mouthpiece, in certain embodiments, is that the bottle may be positioned to a desired drinking orientation without any fluid being dispensed until the user bites the mouthpiece. Ex.1001 at 10:9–27.

Some embodiments include a flow-restricting, on/off or shutoff valve in addition (or as an alternative) to such a mouthpiece. Ex.1001 at 10:27–51. This on/off valve can be selectively configured between: i) a closed configuration in which the fluid conduit is obstructed to prevent fluid from flowing from the fluid container to the face of the mouthpiece, and ii) an open configuration in which fluid flows to the face of the mouthpiece and may be selectively dispensed through the mouthpiece. Ex.1001 at 10:52–11:11, 11:38–41. The annotated versions of Figures 28 and 29 below illustrate this open configuration (left) and this closed configuration (right), respectively, of an on/off or shutoff valve implemented using a flexible tube 124 that is crimped when in the stowed configuration and reopened when in the dispensing configuration. Ex.1001 at 18:20–35, Figs. 28–29.



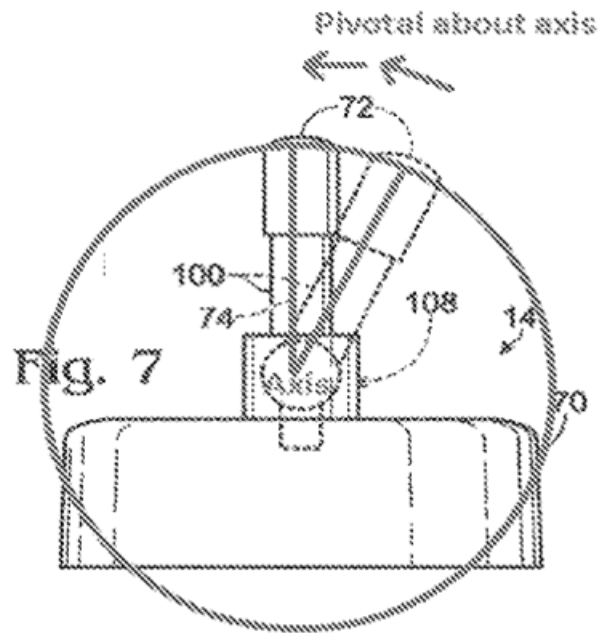
Ex.1001, Figs. 28–29 (annotated); Pet. at 13.

As shown in the annotated version of Figure 25 below, the pivotal mount 100 includes lateral projections 150 (circled purple) that are received into and rotatable within sockets 152 (circled red) defined within portions of the base 70. Ex.1001 at 16:57–67, Fig. 25.



Ex.1001, Fig. 25 (annotated); Pet. at 11. The lateral projections 150 function as rotatable supports, or axles, defining an axis about which the pivotal mount and its coupled mouthpiece can be pivotally moved together between a stowed configuration and a dispensing configuration. Ex.1001 at 16:61–67, claim 1.

Claims 1 and 20 each recite that “the resilient mouthpiece is pivotal about an axis defined by the pair of lateral projections as the pair of lateral projections rotate within the pair of sockets” and that the resilient mouthpiece is “removably coupled to the pivotal mount for pivotal movement *with the pivotal mount*.” The patentee stated during reexamination that this limitation is shown, for example, in Figure 7 of the ’255 patent and provided the below annotated version of Figure 7:



Ex.2001 at 637. In describing this figure, the patentee explained that “the mouthpiece 72 is pivotal about an axis defined by the pair of lateral projections as they rotate,” and (labeling the adjustable/pivotal joint 108 as the “axis”) illustrated how the mouthpiece 72 and pivotal mount 100 are pivotal together about this common axis. *Id.* (underline in original).

C. Prosecution History

The Petition provides no discussion of either the original examination or reexamination whatsoever. This omission—perhaps intentional—is particularly glaring because, as set forth below, Petitioner’s grounds fail to account for the key distinctions found between the claimed drink bottles of the ’255 patent and the prior art by the original Examiner and by the three Reexamination Specialists of the

Central Reexamination Unit. Specifically, Petitioner’s primary references lack the same key features as the prior art considered during examination and reexamination. Patent Owner, therefore, provides the below detailed discussion of these examinations.

The ’255 patent issued from U.S. Patent Application No. 16/035,418 (“the ’418 application”) and claims priority through a chain of continuation applications to the application that issued as U.S. Patent No. 7,533,783 and that was filed December 20, 2005; the ’255 patent also claims priority to both U.S. Provisional Application No. 60/706,700, filed August 8, 2005, and U.S. Provisional Application No. 60/670,828, filed April 11, 2005. Ex.1001 at (63), (60).

The ’255 patent was the subject of *Ex Parte* Reexamination Request No. 90/015,192 (“the ’192 reexamination”), which was filed January 18, 2023. Ex.1002. An *ex parte* reexamination certificate issued on November 20, 2023 that confirmed the patentability of claim 1, as amended therein, and dependent claims 3–8, 13, 14, 18, and 19, which depended from that amended claim. *Id.* at 1:15–17. The certificate also added new claims 20–23, which were determined to be patentable. *Id.* at 1:19–20. Claims 2, 9–12, and 15–17 were not reexamined. *Id.* at 1:21.

1. Original Examination

The '418 application that matured into the '255 patent was filed on July 13, 2018. Ex.1001 at (22). As-filed claims 1–3 and 19–20 were rejected as anticipated by Dark (U.S. Pat. No. 6,116,458) (Ex.2011), and claims 4–18 were rejected as obvious over Dark in view of Forsman (U.S. Patent. No. D547,607) (Ex.2012). Ex.1011 at 26–31. In response, the Applicant amended claim 1 (from which claims 2–20 depended) to require: i) that the pivotal mount “includes a pair of lateral projections,” ii) that the cap assembly “defines a pair of sockets into which the pair of lateral projections extend,” and iii) that the resilient mouthpiece “is pivotal about an axis defined by the pair of lateral projections as the pair of lateral projections rotate within the pair of sockets.” Ex.1011 at 10. The Applicant then argued that these amended limitations of claim 1 were not disclosed or suggested by Dark. Ex.1011 at 16. The Applicant’s summary of an interview with the Examiner indicates that the “[t]he Examiner agreed that Dark did not disclose at least the feature ‘wherein the pivotal mount includes a pair of lateral projections.’” Ex.1011 at 15. In response to the amendment, the Examiner issued a notice of allowance. Ex.1011 at 1–5.

2. *Ex Parte* Reexamination

The '192 reexamination of the '255 patent was ordered in response to a third-party reexamination request that was assigned a filing date of January 18, 2023. Ex.1002; Ex.2001 at 381–494, 545. The request relied on two primary references, McDonough¹ and Toudou², in asserting fifteen substantial new questions of patentability (“SNQs”). Ex.2001 at 411–413. In response to the request, reexamination was ordered as to all requested claims with regard to all SNQs. *Id.* at 551–561. A rejection of the claims subject to reexamination was issued. *Id.* at 585. The claims were rejected as being: i) either anticipated by McDonough or obvious over McDonough in view of other references, and ii) obvious over Toudou in view of other references. *Id.* at 587–623.

In response, the patentee amended claim 1 to require that the pivotal mount comprise “a mount outlet” and to require that the resilient mouthpiece be “engaged

¹ U.S. Patent App. Pub. No. 2005/0029271 to McDonough (Ex.2008).

² Japanese Patent App. Pub. No. 2001-294252 to Toudou. Ex.2009; *see also* Ex.2001 at 52–85.

with the mount outlet” and also be “removably coupled to” the pivotal mount, as shown by the underlined text in the claim amendment below:

a pivotal mount coupled to the cap assembly base for pivotal movement relative to the cap assembly base, the pivotal mount comprising a mount outlet, wherein the pivotal mount includes a pair of lateral projections, wherein the cap assembly base defines a pair of sockets into which the pair of lateral projections extend;

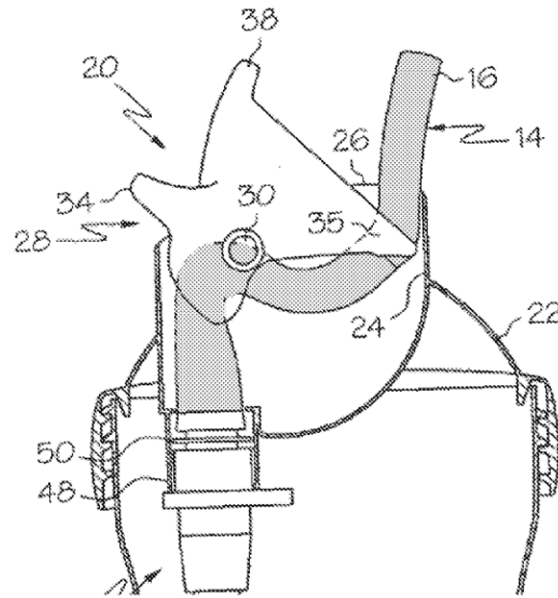
a resilient mouthpiece engaged with the mount outlet and removably coupled to the pivotal mount for pivotal movement with the pivotal mount relative to the cap assembly base, wherein the resilient mouthpiece is pivotal about an axis defined by the pair of lateral projections as the pair of lateral projections rotate within the pair of sockets;

Id. at 626. As discussed above, the patentee also added independent claim 20 with the same language, as well as the additional limitation directed to the “dust cover.” *Id.* at 630–631.

The patentee then distinguished McDonough from the amended claim language in two primary ways.

First, the patentee distinguished McDonough by arguing that it did not disclose a resilient mouthpiece that is engaged with a mount outlet of a pivotal mount or a resilient mouthpiece that is removably coupled to the pivotal mount, as required by the amended limitations. *Id.* at 634–637. The Examiner had mapped the claimed “pivotal mount” to the “straw positioning mechanism 20” of McDonough and had mapped the claimed “mouthpiece” to the first end 16 of the flexible straw 14 of

McDonough, which are each shown in the version of Figure 2, as annotated by the patentee (shown below). *Id.* at 635.



Ex.2008, Fig. 2 (annotated); see Ex.2001 at 636. The patentee argued that neither straw 14 nor its end 16 (the alleged mouthpiece) are coupled or removably coupled to the straw positioning mechanism 20 (the alleged pivotal mount), because the straw is merely inserted and “passes through the straw positioning mechanism 20,” rather than being coupled or removably coupled to it. Ex.2001 at 636. The patentee similarly argued that the end 16 of straw 14 is not “engaged with any outlet of the straw positioning mechanism 20,” and, thus, that McDonough failed to disclose a mouthpiece “engaged with a mount outlet” of the pivotal mount, as required by the amended claim language. *Id.*

Second, the patentee argued that McDonough also failed to disclose that the mouthpiece is “pivotal about an axis defined by the pair of lateral projections as the pair of lateral projections rotate within the pair of sockets.” Ex.2001 at 637–639. The Examiner had mapped the claimed “lateral projections” to the “axle projections 30” of McDonough about which the straw positioning mechanism 20 rotates. *Id.* at 588. As illustrated in the below annotated versions of Figure 2 and 3 provided by patentee during the reexamination, the straw’s end 16 (mapped to the mouthpiece) “is not pivotal about an axis defined by the pair of lateral projections” but instead is merely “pulled downwards” with the straw 14. *Id.* at 638 (emphasis in original).

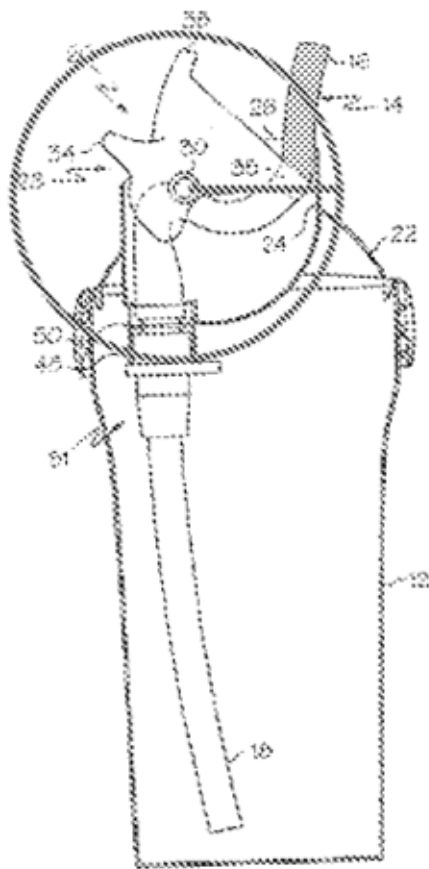


FIG. 2

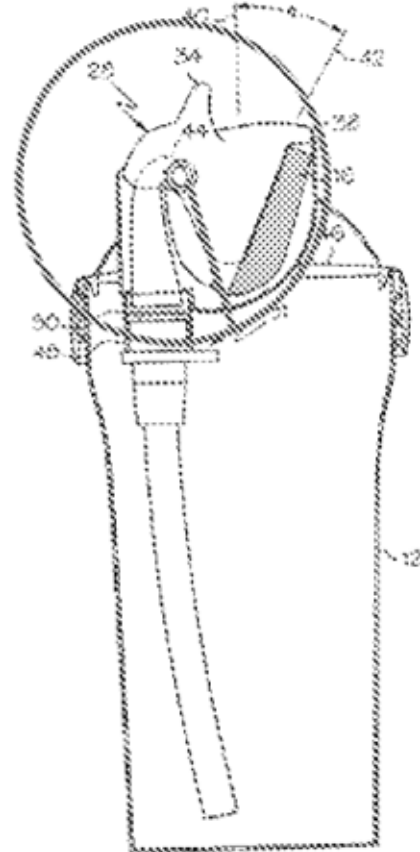
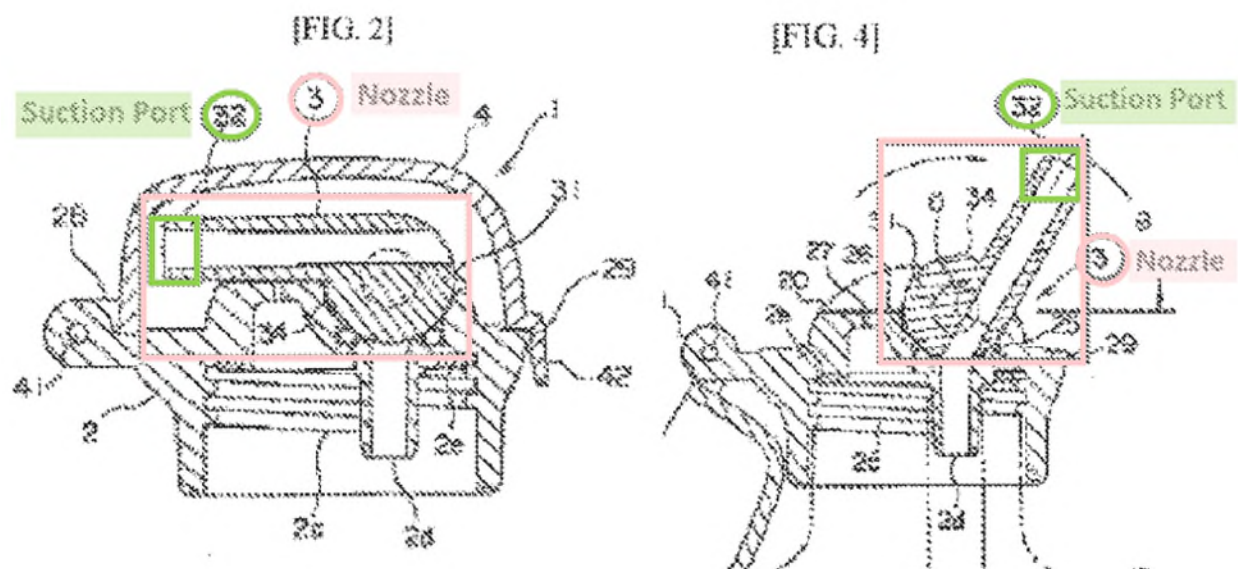


FIG. 3

Id. at 638.

The patentee then distinguished Toudou from the independent claims by arguing, *inter alia*, that it, too, failed to disclose the amended claim limitations. *Id.* at 641–643. The Examiner had mapped the claimed “pivotal mount” to Toudou’s pivoting nozzle 3 (pink below) and had mapped the “mouthpiece coupled to the pivotal mount” to the suction port 32 (green below) at the end of nozzle 3, as shown

in the below annotated versions of Figures 2 and 4 that patentee submitted during the reexamination.³ *Id.* at 641–642.



Id. at 642. The patentee then distinguished Toudou because the suction port 32 of Toudou is an integral part of its nozzle 3 that forms the end of the nozzle—specifically, the patentee argued that Toudou failed to disclose: i) any “mount outlet” of nozzle 3 that is distinct from the “mouthpiece” (mapped to suction port 32) itself, or ii) a “mouthpiece” (suction port 32) that is “engaged with a mount outlet” on the nozzle 3 and that is “removably coupled to” the nozzle 3 (pivotal mount), rather than

³ The annotated figures in the reexamination file history are in black-and-white but Patent Owner has overlaid color for clarity.

just a mouthpiece (suction port 32) that merely “forms an integral portion of the nozzle [i.e., pivotal mount].” *Id.* at 642.

The Examiner then issued a Notice of Intent to Issue Reexamination Certificate and explained in a “Statement of Reasons for Patentability and/or Confirmation” that the amendments made by patentee distinguished both McDonough and Toudou. *Id.* at 844. A reexamination certificate then issued. *Id.* at 855–857; Ex.1002.

III. PETITIONER’S GROUNDS AND CITED REFERENCES

Petitioner asserts that the challenged claims would have been obvious based on four (4) grounds—specifically, Petitioner argues that: claims 1, 3–5, 9–11, 13, 18, and 19 are obvious in view of Nakajima⁴ in view of the knowledge of a POSITA (Ground 1); claims 12 and 14–16 are obvious over Nakajima in view of Gardner⁵ (Ground 2); claims 1, 9, 11, 13, and 17–19 are obvious over Ribarits⁶ in view of the

⁴ Japanese Patent Publication No. 2002-211613 to Nakajima (Ex.1004).

⁵ U.S. Patent No. 6,070,767 to Gardner (Ex.1005).

⁶ International Publication No. WO 2004/063042 to Ribarits et al. (Ex.1006).

knowledge of a POSITA (Ground 3); and claims 2–7 and 20–23 are obvious over Ribarits in view of Panicci⁷ and/or Hughes⁸ (Ground 4).

A. Nakajima

Japanese Patent Publication No. 2002-211613 to Nakajima (Ex.1004) (“Nakajima”) was published on July 31, 2002.⁹ Nakajima is directed to a stopper for a liquid container, where the stopper includes a mouthpiece. Ex.1004 at Title, Abstract. The stopper includes a lid attached by a hinge to the stopper where the lid

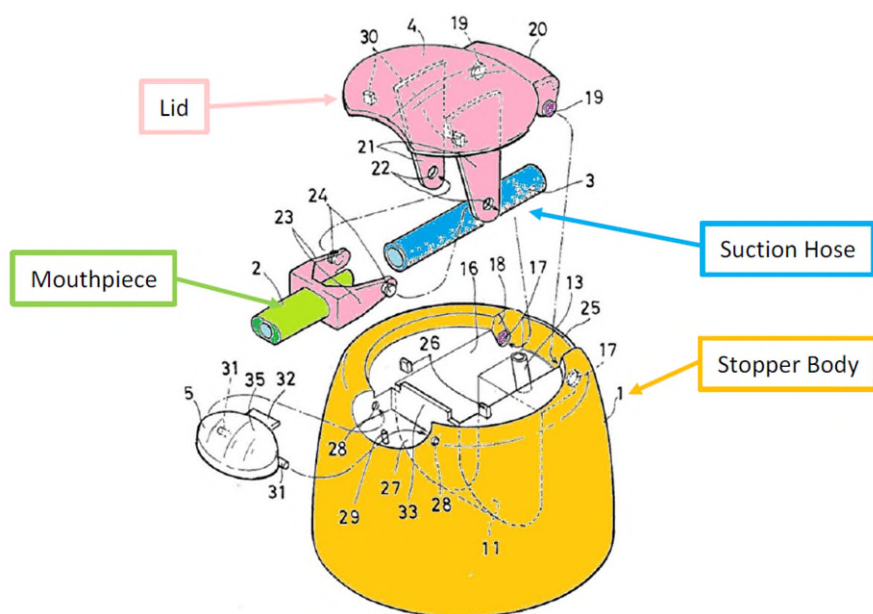
⁷ U.S. Patent No. 4,485,963 to Panicci (Ex.1007).

⁸ U.S. Patent No. 6,523,711 to Hughes (Ex.1010).

⁹ Patent Owner notes that Petitioner did not submit any copy of the original Japanese language version of Nakajima itself and, therefore, failed to comply with 35 U.S.C. §§ 312(a)(3)(A) & 312(a)(5) by failing to file or serve on Patent Owner copies of the actual prior art references Petitioner relies upon in support of the petition. As such, Petitioner’s grounds based on Nakajima should be denied on this basis alone. Nonetheless, without waiving its right to object, Patent Owner relies for purposes of this Preliminary Response on the English translation of Nakajima provided by Petitioner in Exhibit 1004.

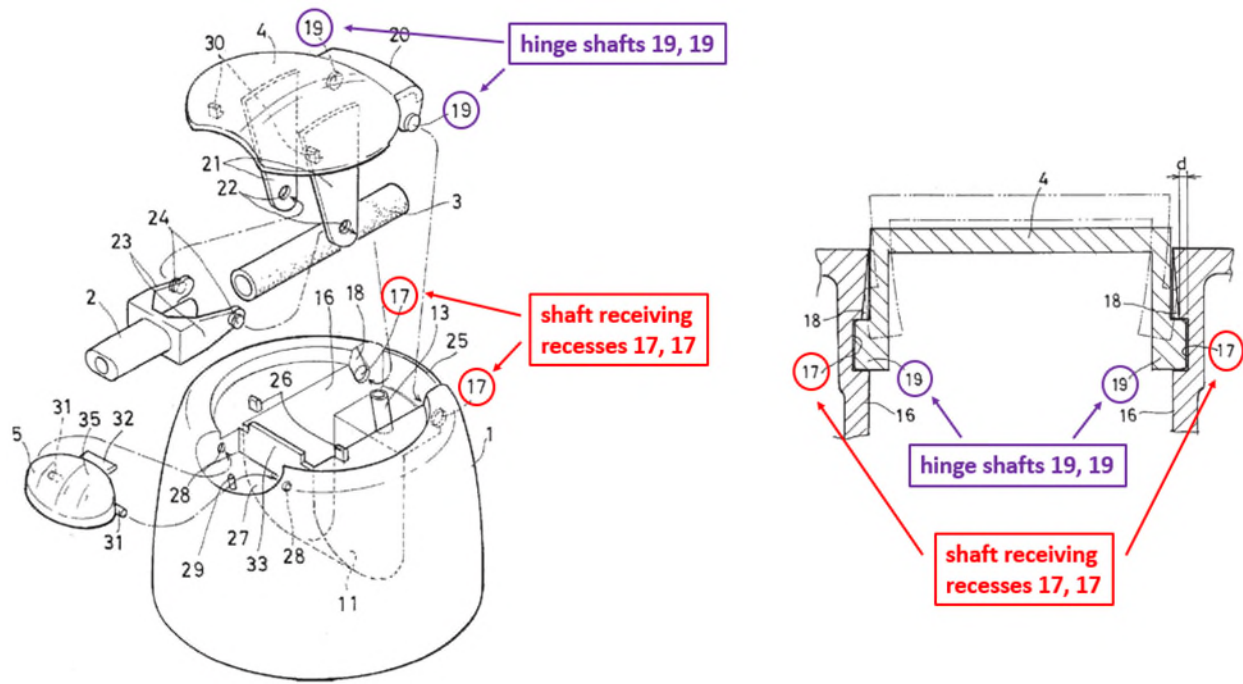
can be removed from the stopper to simplify the process of cleaning the lid. *Id.* at Abstract, [0025], [0028]. For example, the lid can be removed for cleaning by simply applying a slight bending force or horizontal twisting force to detach the lid at the hinge from the stopper. *Id.* ¶¶[0025], [0027]–[0028].

As shown in the below annotated version of Figure 1 of Nakajima from the Petition, Nakajima's stopper includes a stopper body 1 (orange), a mouthpiece 2 (green), a suction hose 3 (blue), a lid 4 (pink) having a hinge portion 20, and a button 5 that serves as a disengaging means (not colored). Ex.1004 ¶¶[0012], [0016], Fig. 1.

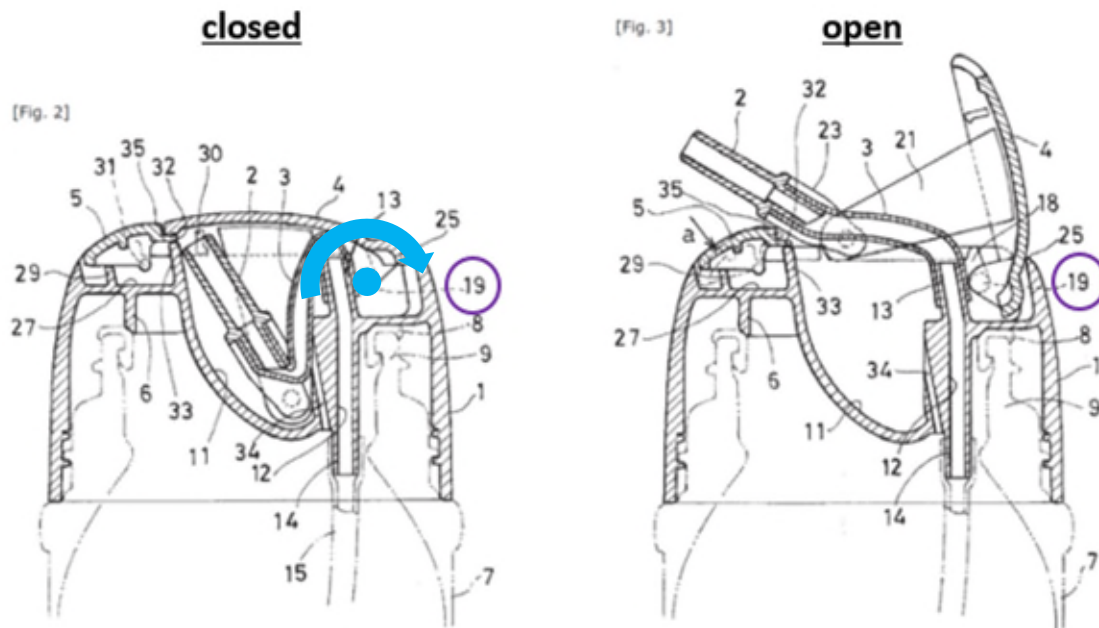


Pet. at 20 (citing and annotating Ex.1004, Fig. 1). The lid 4 is attached to the stopper body 1 via a hinge that is comprised of: i) the lid 4's hinge shafts 19, 19 (circled

purple below) that are “rotatably fitted into” ii) each of the shaft receiving recesses 17, 17 (circled red below) of the stopper body 1, as shown in the annotated version of Figures 1 and 4 below. Ex.1004 ¶¶[0015]–[0016], Fig. 1, Fig. 4.

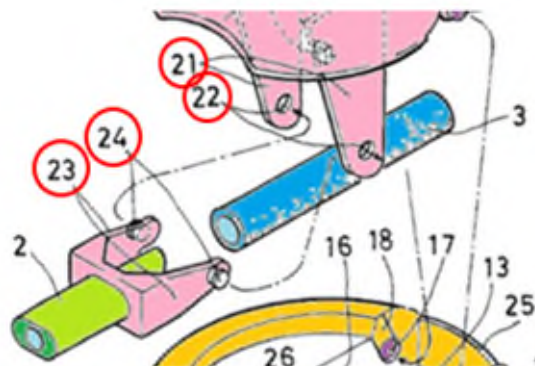


Ex.1004 at Fig. 1 (annotated), Fig. 4 (annotated). As can be seen in Figures 2 and 3 below, this hinge formed from the hinge shafts 19, 19 rotating within the shaft receiving recesses 17, 17 allows the lid 4 to close (Fig. 2, left, below) and open (Fig. 3, right, below) by pivoting about the axis defined by the hinge shafts 19, 19 (purple below) rotating within the shaft receiving recesses 17, 17. Ex.1004 ¶¶[0016]–[0018], [0020], [0022]–[0024], Figs. 1–3. This pivotal movement by the lid about the hinge shafts 19, 19 is shown by the blue arrow below.

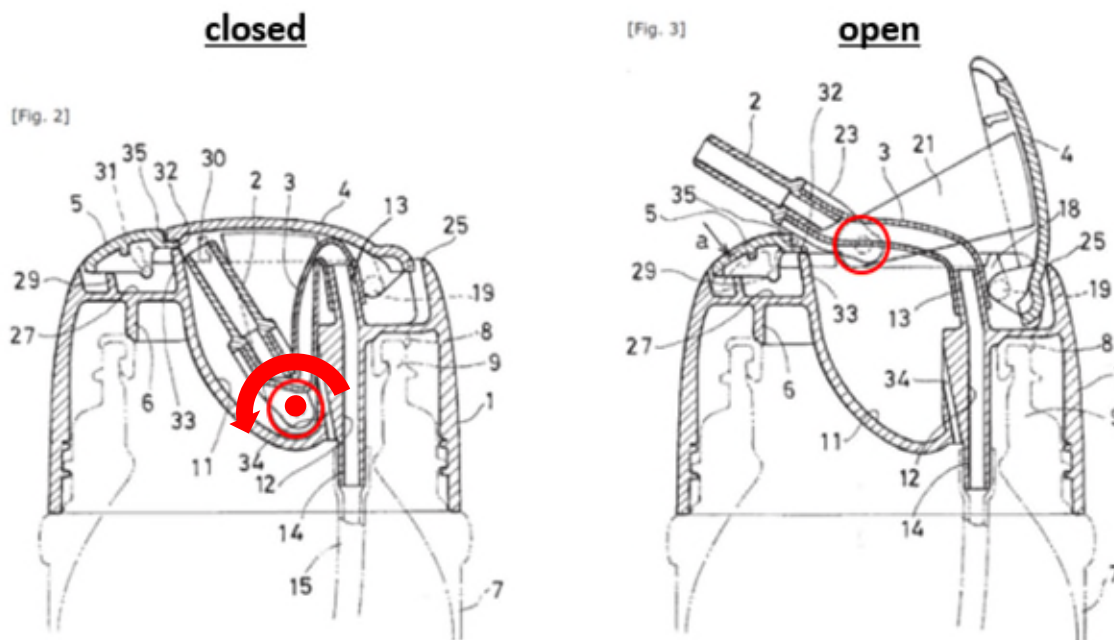


Ex.1004, Figs. 2–3 (annotated).

The mouthpiece 2 includes arms 23 having protrusions 24 that are “rotatably fitted into” holes 22 at the bottom of leg pieces 21 provided on the underside of the lid 4, as shown in the below annotated excerpt of Figure 1, with these components circled in red. Ex.1004 ¶[0016].

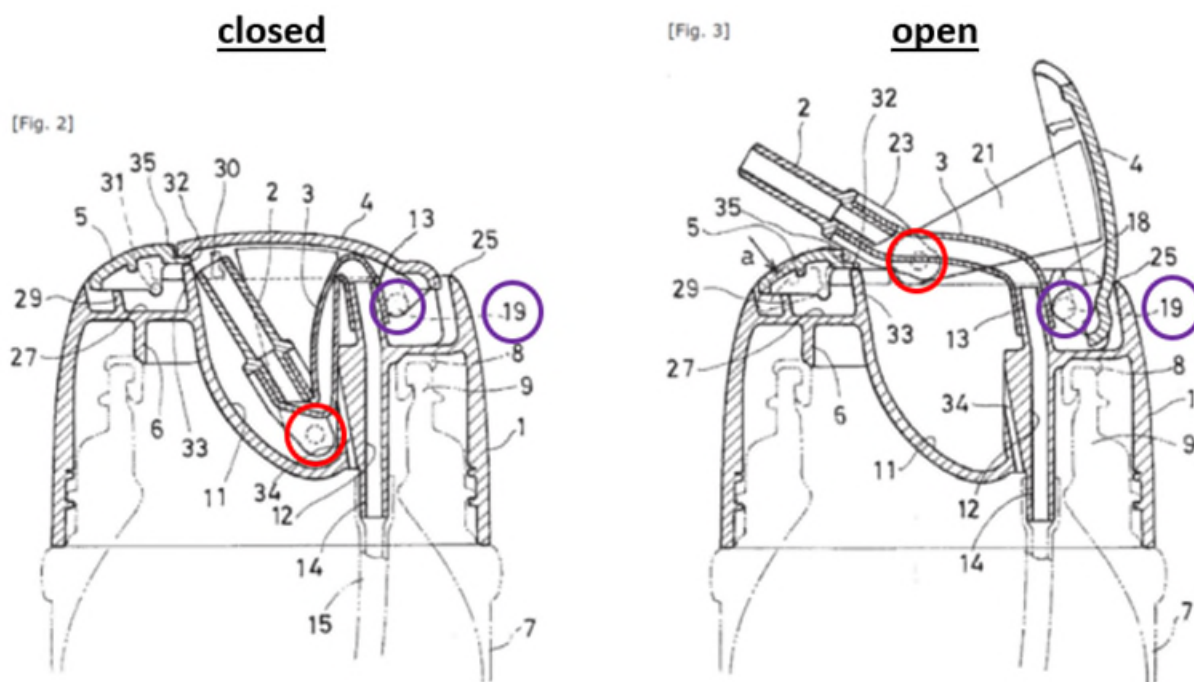


Ex.1004, Fig. 1 (annotated). This configuration causes the mouthpiece to pivot about the axis defined by the protrusions 24 (circled in red below) as they rotate within the holes 22 when the lid 4 is opened and closed—specifically, as shown in Figure 2 below, the mouthpiece pivots clockwise about this axis as the mouthpiece is “pulled in” and “folded into the storage recess 11” as the lid is closed, and, as shown in Figure 3 below, the mouthpiece pivots counterclockwise about this axis (shown by red arrow below) until the mouthpiece “protrudes above the button 5” when the lid is opened. Ex.1004 ¶¶[0018], [0022]–[0024], Figs. 2–3.



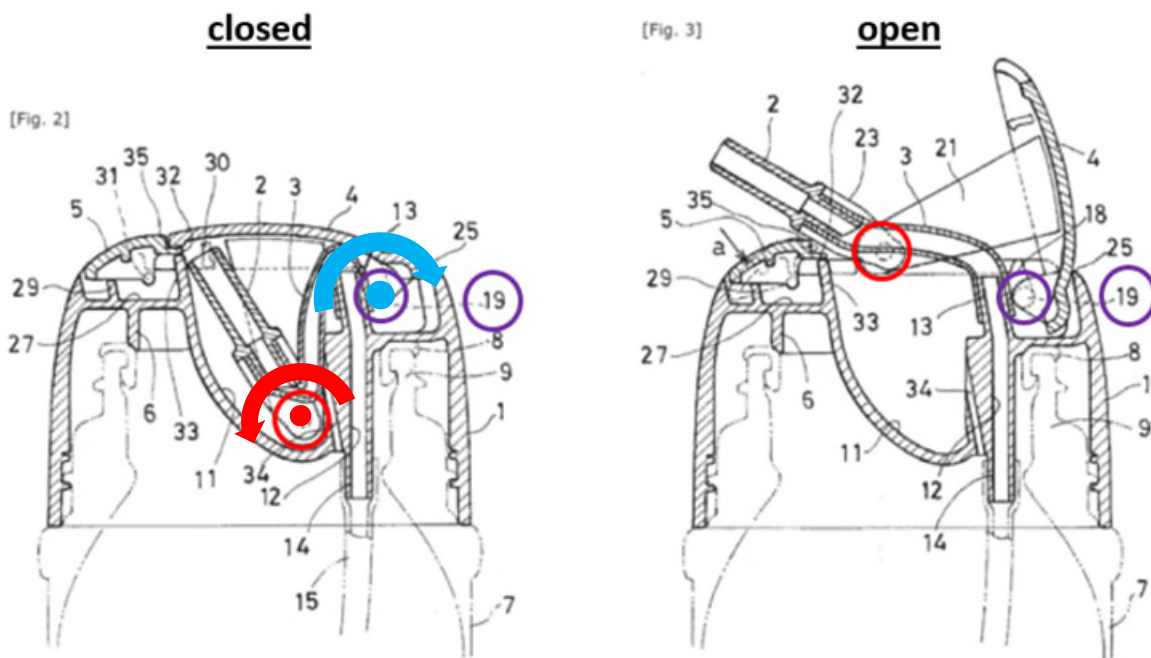
Ex.1004, Figs. 2–3 (annotated). As shown below, the mouthpiece 2 pivots about the axis defined by the protrusions 24 (circled in red), and does *not* pivot about the axis

defined by the hinge shafts 19 (circled in purple)—this is because the mouthpiece is in contact with the wall of the storage recess 11 during opening and closing and because the mouthpiece is only rotatably attached to the lid 4 and not rigidly attached, preventing the mouth piece from moving in alignment with the lid 4 and preventing it from pivoting about the same axis defined by the hinge shafts 19 about which the lid pivots. Ex.1004, Figs. 2–3.



Ex.1004, Figs. 2–3 (annotated). Further, as shown in the annotated versions of Figures 2 and 3 below, when the lid is moved, from the closed position to the open position, the lid moves pivotally in a clockwise direction about the axis defined by the hinge shafts 19 (shown by blue arrow below), but the mouthpiece moves

pivotally in a counterclockwise direction about a different axis defined by the protrusions 24 (shown by the red arrow below).



Ex.1004, Figs. 2–3 (annotated).

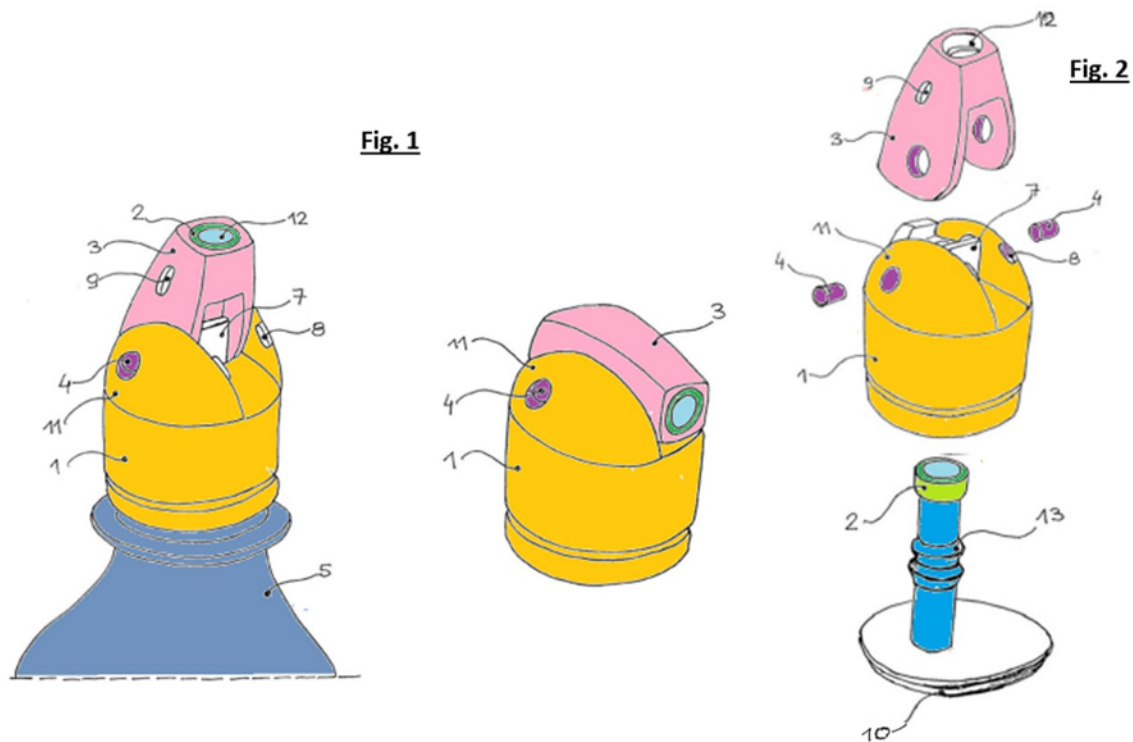
B. Ribarits

International Publication No. WO 2004/063042 to Ribarits et al. (“Ribarits”) was published on July 29, 2004.¹⁰ Ribarits is generally directed to a drinking device

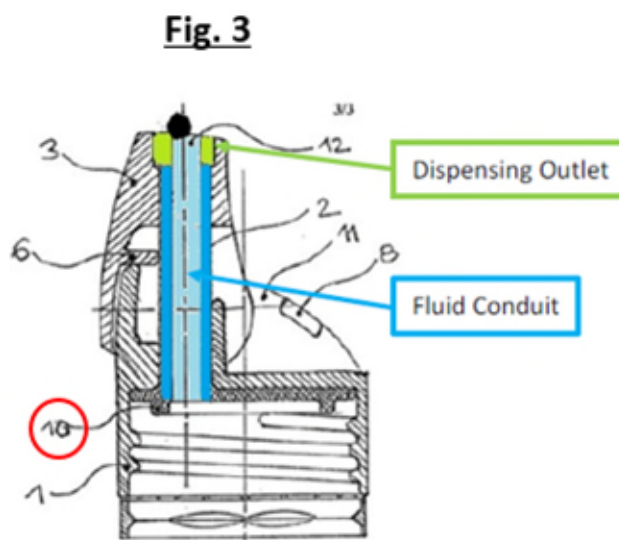
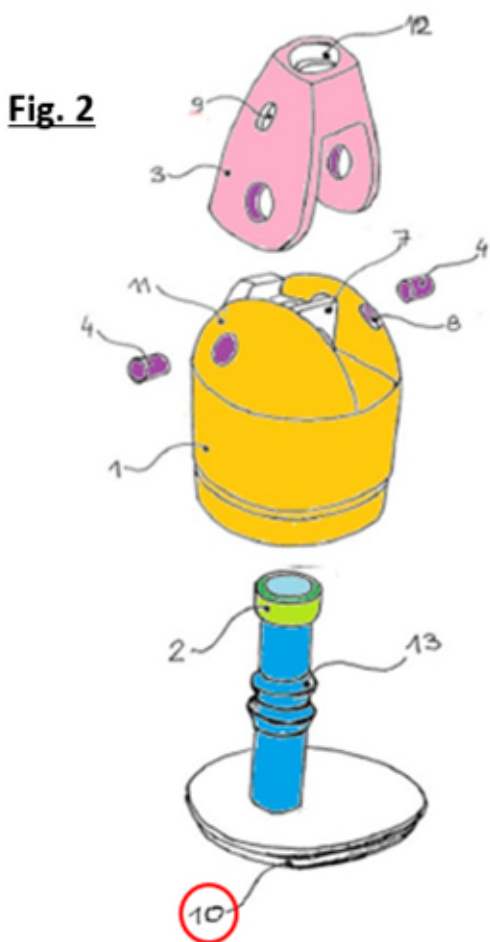
¹⁰ Patent Owner notes that Petitioner did not submit any copy of the original German language version of Ribarits itself and, therefore, failed to comply with 35 U.S.C. §§ 312(a)(3)(A) & 312(a)(5) by failing to file or serve on Patent Owner copies of

that is designed such that it can be opened and closed with one hand. Ex.1006 at Abstract, 2. The drinking device includes a closing cap 1 (orange), a drinking spout 3 (pink) that rotates about two axial pins 4 (purple), a bottle 5 (dark blue), and a tubular element 2 (light blue & green) that is “inserted into said cap” and also “inserted” in the drinking spout, as shown in the annotated versions of Figures 1 and 2 below. *Id.* at Abstract, 2, claim 1, Fig. 1.

the actual prior art references Petitioner relies upon in support of the petition. As such, Petitioner’s grounds based on Ribarits should be denied on this basis alone. Nonetheless, without waiving its right to object, Patent Owner relies for purposes of this Preliminary Response on the English translation of Ribarits provided by Petitioner in Exhibit 1006.



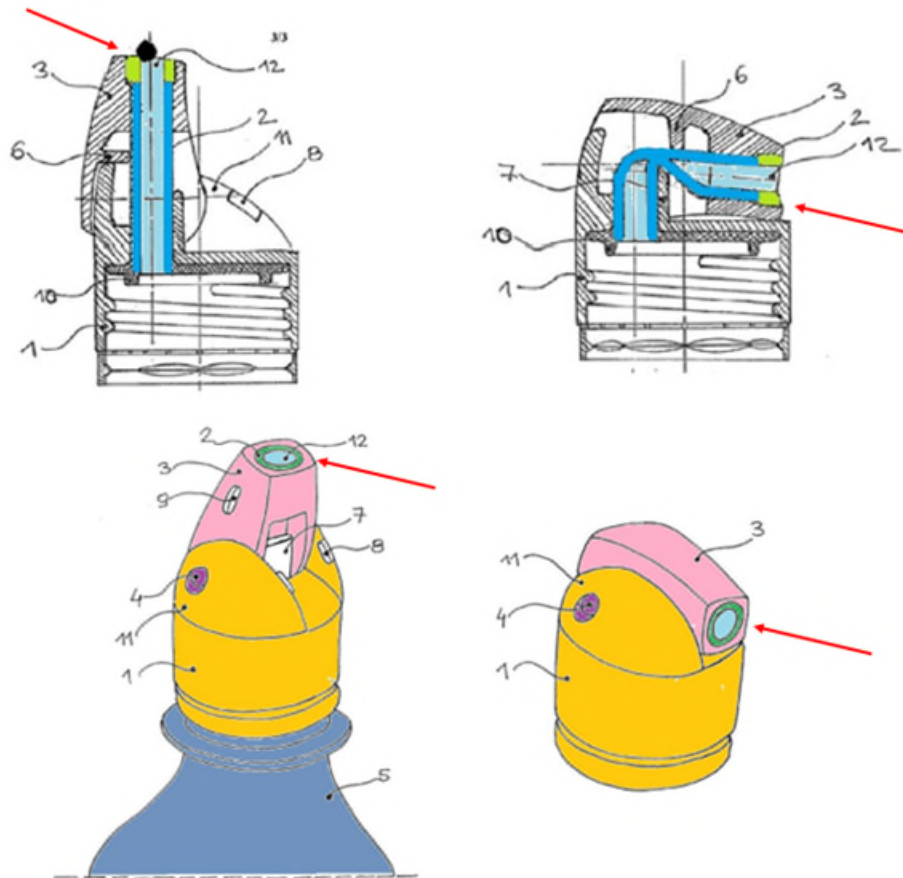
Ex.1006, Figs. 1–2 (annotated). As shown above, the drinking spout 3 can be in an open position (Fig. 1 at left) or in a closed position (Fig. 1 at right). Ex.1006 at 2, Fig. 1. As shown in the annotated version of Figure 2 below, the tubular element 2 is inserted into the cap 1 and drinking spout 3. Ex.1006 at Abstract, 2 (“[A] sealed tubular element of rubber or latex is inserted in both these parts When the drinking spout is pivoted open, the elastic tube inserted therein is straightened and the opening is thus released.”), claim 1 (“the sealed tubular element (2) is inserted into the drinking spout (3)”), Fig. 2.



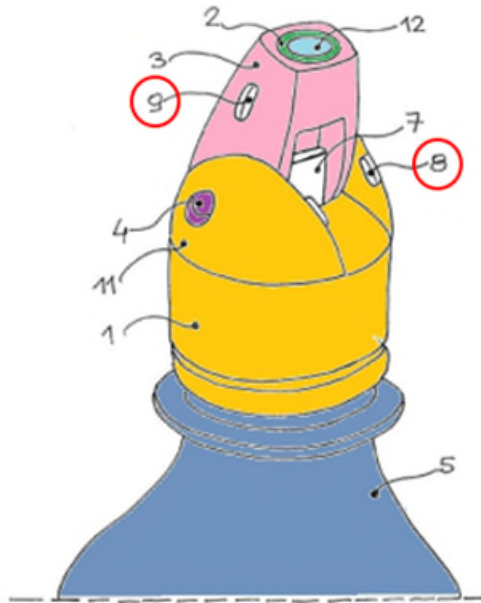
Ex.1006, Fig. 2 (annotated). As shown above, the tubular element 2 includes sealing rings 10 (red) that hold the inserted tubular element in place within the cap 1 and drinking spout 3 by screwing the neck of the bottle into the thread of the cap and tightening the sealing rings 10 in place. Ex.1006 at 2 (“the tightness is given by screwing the neck of the bottle onto the sealing part of this [tubular] element”); *id.* (“[the] common close cap [is] provided with a thread”), claim 1 (“when the closing cap (1) is screwed onto the bottle (5), the required tightness is obtained by means of

the sealing rings (10)”), claim 2 (“the sealed tubular element (2) has, in its broad sealing surface, one or several projecting sealing rings(10)”). The pressure of screwing the cap onto the bottle provides the required tightness to hold the inserted tubular element 2 in place. The tubular element can be made of “rubber, “latex,” or “plastics.” Ex.1006 at 2, claim 4.

As shown by the red arrows in the annotated versions of Figures 1 and 3 below, the opening (green) of the tubular element 2 is flush with and does not extend beyond the drinking spout 3; and, thus, because the drinking spout 3 shields the tubular element 2, a user is not able to apply force to the tubular element 2 using the user’s teeth. Ex.1006, Figs. 1 & 3.



Ex.1006, Figs. 1 & 3 (annotated). As shown below, the cap 1 also includes two knobs 8 that can snap into two recesses 9 on the sides of the drinking spout 3 when the spout is in the closed position as a “securing mechanism” to “prevent an accidental opening of the drinking spout.” Ex.1006 at Abstract, 2, claim 1, Figs. 1–2.



Ex.1006, Fig. 1 (excerpt) (annotated).

C. Secondary References

Petitioner also relies on the Gardner (Ex.1005), Panicci (Ex.1007), and Hughes (Ex.1008) references in its grounds of alleged unpatentability. Pet. at 17–18. However, these references are all asserted as secondary references in combination with either Nakajima or Ribarits as primary references. Because Patent Owner’s arguments herein identify deficiencies with regard to each of the primary references for each of the independent claims, and because Petitioner does not rely on any of these secondary references to cure any of those deficiencies, Patent Owner does not summarize or otherwise address these secondary references herein.

IV. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner fails to show a reasonable likelihood of prevailing on any claim, even under the level of ordinary skill in the art Petitioner sets forth. Accordingly, for the purpose of this Preliminary Response only, Patent Owner applies the level of ordinary skill in the art set forth in the Petition. Patent Owner reserves the right to present evidence and argument in support of a different position on this issue in other proceedings or later in this proceeding, in the event necessary.

V. CLAIM CONSTRUCTION

Petitioner does not propose constructions in the Petition for any claim terms in the '255 patent. Pet. at 19. Nevertheless, as shown below, the Petition relies on an improperly broad understanding of “adapted to” in the context of the phrase “wherein the resilient mouthpiece is adapted to resiliently compress responsive to compressive forces applied to the resilient mouthpiece by a user’s teeth.” Patent Owner, therefore, provides the proper construction for this term below.

Patent Owner reserves the right to address the proper construction of additional claim terms in the future, as needed. By reserving such arguments at this stage, Patent Owner does not concede that the Petition uses claim language consistent with its proper construction(s).

A. “Adapted to Resiliently Compress Responsive to Compressive Forces Applied to the Resilient Mouthpiece by a User’s Teeth”

Patent Owner submits that the correct construction for the term “adapted to” in this limitation is “designed or configured to” and is not satisfied by mere hypothetical capability for the following reasons.

Both independent claims of the ’255 patent recite “wherein the resilient mouthpiece is adapted to resiliently compress responsive to compressive forces applied to the resilient mouthpiece by a user’s teeth.” Ex.1002 at 1:64–66, 2:57–59. The use of the words “adapted to” in this limitation (which Petitioner calls “1[b][3][iv],” *see* Pet. at 15) requires more than a mere theoretical capability of the mouthpiece. *See, e.g., Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012) (construing “adapted to” as requiring claim elements be “designed or configured to accomplish the specified objective, *not simply that they can be made to serve that purpose*”) (italics added).

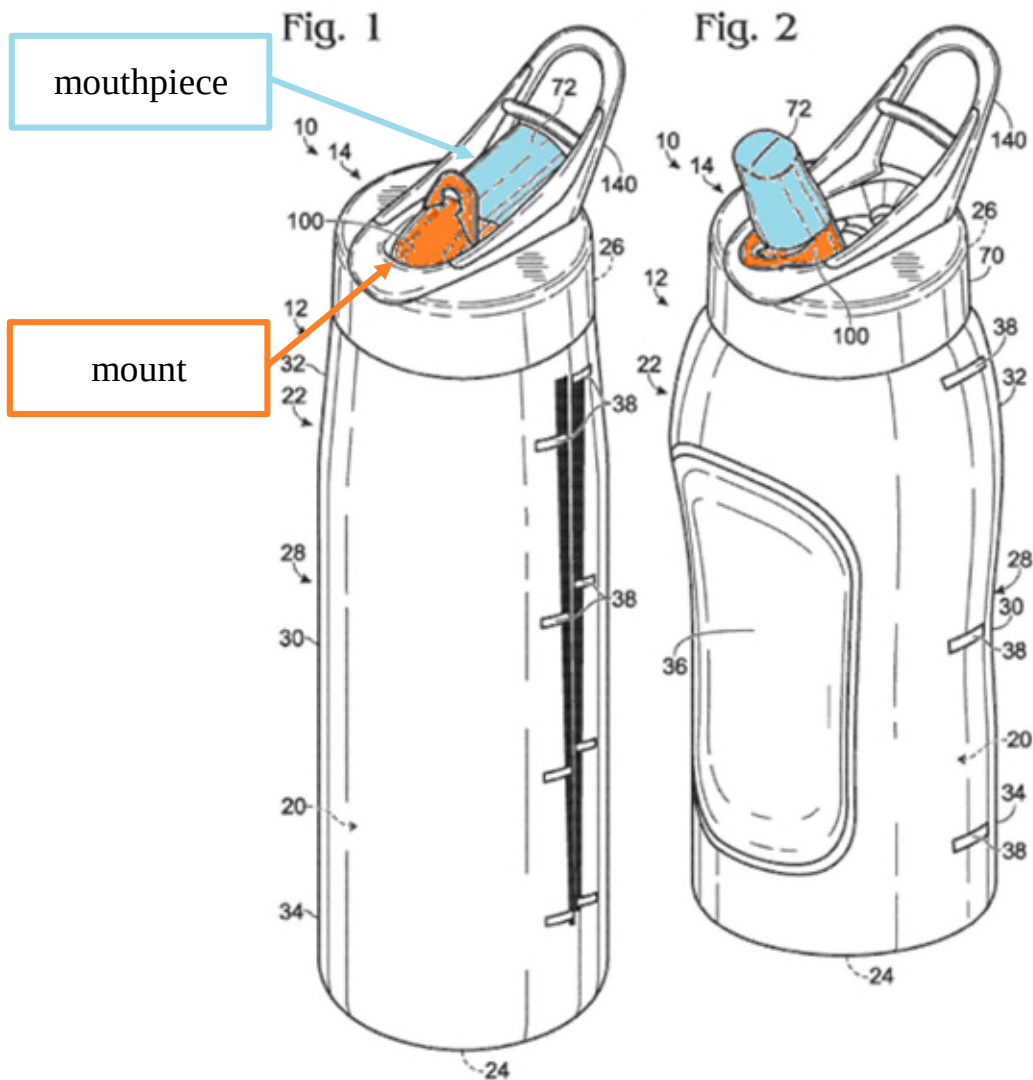
The ’255 patent uses the phrase “adapted to” consistent with its generally understood meaning of “made to,” “designed to,” or “configured to,” as established by Federal Circuit case law. *See In re Man Mach. Interface Techs. LLC*, 822 F.3d 1282, 1286 (Fed. Cir. 2016) (“We have noted that the phrase ‘adapted to’ generally means ‘made to,’ ‘designed to,’ or ‘configured to,’ . . .”); *In re Giannelli*, 739 F.3d

1375, 1379 (Fed. Cir. 2014) (similar); *Aspex Eyewear*, 672 F.3d at 1349 (similar). This stands in contrast with broader alternative meanings, like “capable of” or “suitable for.” *See, e.g., In re Man Mach.*, 822 F.3d at 1286.

The narrower construction of “adapted to” applies where (as here) the specification describes embodiments having structural features that make the claimed element “adapted to” the specified purpose set forth in the claim language. For example, in *In re Giannelli*, the Federal Circuit reversed the Board’s decision affirming rejections of claims that recited a rowing machine including “a first handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion.” 739 F.3d at 1376, 1381. The prior art relied on for the rejection disclosed a “chest press machine,” which was structured to allow a pushing movement, but the Board reasoned that the claims “only require[d] an exercise machine with handles that *can* be pulled.” *Id.* at 1379. The Federal Circuit, however, construed the “adapted to” phrase of the claim to require “that the claimed machine is designed or constructed to be used as a rowing machine whereby a pulling force is exerted on the handles.” *Id.* The court relied on the written description, which showed that the relative position of the handles to other elements of the disclosed rowing machine enabled the performance of the rowing motion recited in the claim. *Id.* at 1379–80.

In the same way, the intrinsic evidence in the '255 patent shows that the “adapted to” phrase in claims 1 and 20 requires that the *resilient mouthpiece* be designed or configured to “resiliently compress responsive to compressive forces applied to the resilient mouthpiece by a user’s teeth.” A user must therefore be permitted by the design and configuration of the claimed drink bottle to bite down on the *resilient mouthpiece*.

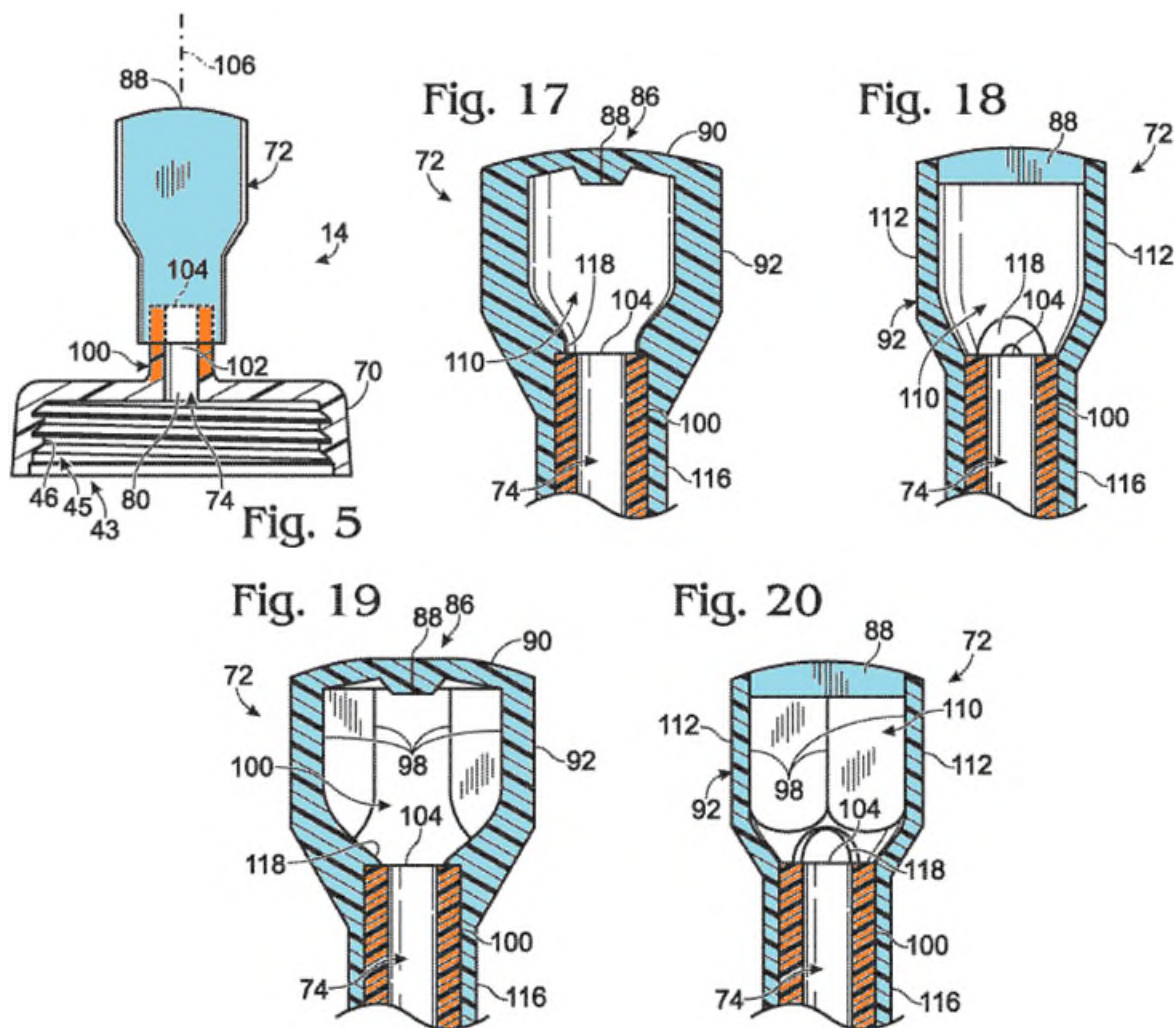
The intrinsic support for narrowly construing “adapted to” is abundant. The '255 patent’s written description—including in several of the Figures—describes “structural attributes that enable[]” a user to resiliently compress the mouthpiece by biting, indicating that “adapted to” has its narrower meaning in this case. *See Giannelli*, 739 F.3d at 1380. The arrangement of elements in the *cap assembly* of the '255 patent claims contributes to the *resilient mouthpiece* being “adapted to” resiliently compress when a user bites on it. When the mount (item 100) of an embodiment is in a stowed configuration, as shown in Figure 1 below, “the mouthpiece [item 72] is not suitably positioned for a user to bite upon the mouthpiece.” Ex.1001 at 3:27–34, Fig. 1. But the dispensing configuration (illustrated in Figure 2, below) allows the user to drink from the bottle by biting the mouthpiece. *See id.* at 3:21–27, Fig. 2.



Ex.1001, Figs. 1–2 (annotated).

As Figures 1–2 above also show, the **mouthpiece** (72) of this embodiment extends beyond the **pivotal mount** (100). This exposes the mouthpiece so that “compressive forces” can be “applied to the resilient mouthpiece by a user’s teeth,” as the claims require. Numerous other figures in the ’255 patent (reproduced below

with similar annotations) likewise show configurations that share this feature of an exposed mouthpiece that a user can bite.



Ex.1001, Figs. 5, 17–20.

The description of bite-able mouthpieces in the disclosure supports construing the phrase “adapted to” to mean “designed or configured to” and not merely “capable of.” See *Giannelli*, 739 F.3d at 1379–80. The specification and drawings therefore confirm that the phrase “adapted to” must be given its narrower meaning of

“designed or configured to” and is not satisfied by mere hypothetical capability. See *Giannelli*, 739 F.3d at 1379–80; see also *In re Man Machine*, 822 F.3d at 1286; *Aspex Eyewear*, 672 F.3d at 1349.

VI. PETITIONER HAS NOT SHOWN A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CLAIM

Contrary to Petitioner’s assertions, neither of the primary references—*Nakajima* (for Grounds 1 and 2) and *Ribarits* (for Grounds 3 and 4)—discloses all the limitations of the resilient mouthpiece recited by both independent claims (claims 1 and 20). Indeed, these references suffer from the same deficiencies found in the prior art by the Examiner during the original examination and by the Central Reexamination Unit during reexamination of the ’255 patent. Because Petitioner fails to show a reasonable likelihood of prevailing on any claim, institution should be denied. See 35 U.S.C. § 314(a).

A. Grounds 1 and 2 Fail Because *Nakajima* Does Not Disclose or Render Obvious a *Resilient Mouthpiece* Satisfying the *Pivotal Movement* Limitations of the Claims

Petitioner cannot prevail on Grounds 1 and 2 as to any claim of the ’255 patent because *Nakajima*—the primary reference for both of these grounds—does not disclose or render obvious a *resilient mouthpiece* meeting all the limitations of the claims.

As shown below, the alleged *mouthpiece* in Nakajima does not have the necessary “pivotal movement with the pivotal mount” and is not “pivotal about an axis defined by the pair of lateral projections [of the pivotal mount] as the pair of lateral projections rotate within the pair of sockets [of the cap assembly],” as claim 1 requires.¹¹ Every claim challenged under Grounds 1 and 2 is dependent from claim 1, and Petitioner relies solely on Nakajima to disclose these requirements. *See* Pet. at 17, 28–35; Ex.1001 at 19:65–21:20. Because Nakajima does not disclose these limitations (and Petitioner does not contend they would have been obvious), Grounds 1 and 2 must fail.

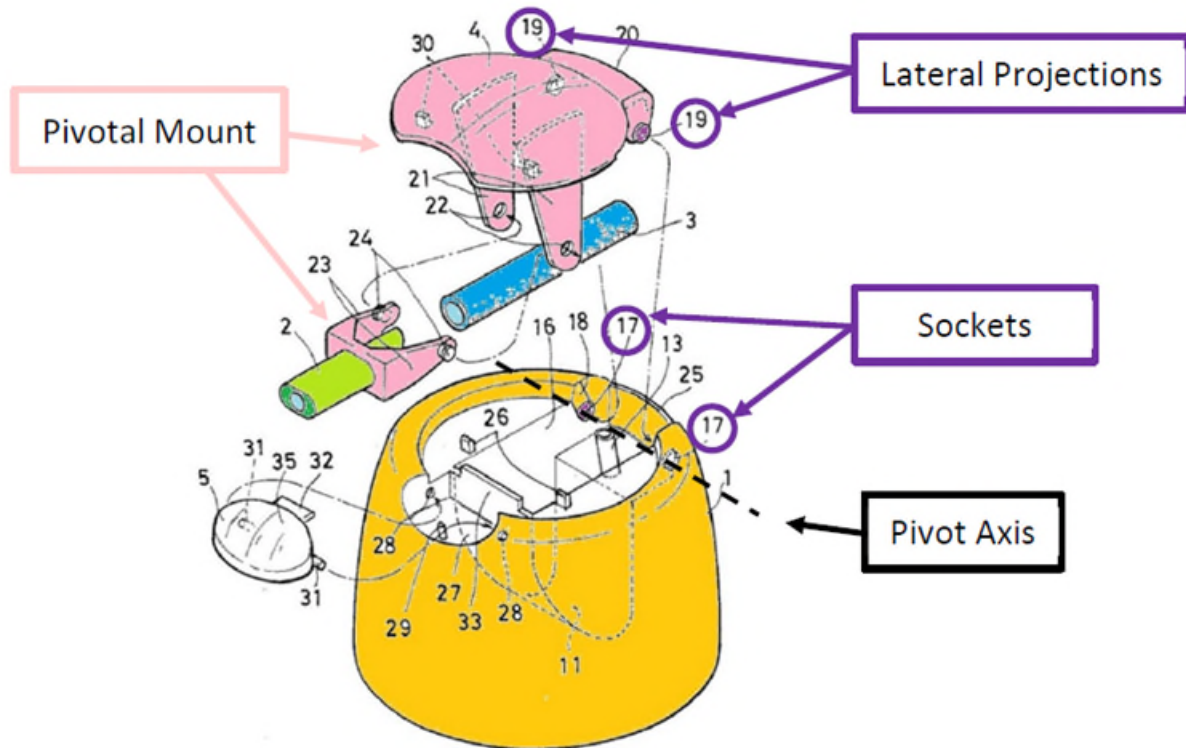
1. Nakajima Does Not Disclose a *Mouthpiece* with the *Pivotal Movement* That Is *with the Pivotal Mount* and *About an Axis Defined by the Lateral Projections*, as Required by the Claims

Petitioner fails to show that the alleged *resilient mouthpiece* of Nakajima exhibits the pivotal movement required by claim 1. Specifically, claim 1 recites, in part, “a resilient mouthpiece . . . coupled to the pivotal mount for pivotal movement with the pivotal mount” and “wherein the resilient mouthpiece is pivotal about an axis defined by the pair of lateral projections as the pair of lateral projections rotate

¹¹ Claim 1 is the only independent claim challenged under Grounds 1 and 2.

within the pair of sockets.” Ex.1002 at 1:48–54 (emphasis added). The “pair of lateral projections” are part of the “pivotal mount,” and they extend into “a pair of sockets” in the “cap assembly base.” *Id.* at 1:44–45. Petitioner cannot show that Nakajima discloses this limitation because Nakajima expressly discloses the alleged *mouthpiece* does not pivot with the alleged *pivotal mount*. Moreover, if Nakajima’s mouthpiece can be described as “pivotal,” it is not pivotal about the axis mapped to the recited “axis defined by the pair of lateral projections as the pair of lateral projections rotate within the pair of sockets.” Petitioner’s evidence does support any other conclusion.

As shown in its annotations to Nakajima’s Figure 1 (below), Petitioner maps the *pivotal mount* of the claims primarily to Nakajima’s lid 4, identifying the hinge shafts 19 as the *lateral projections* and the shaft receiving recesses 17 as the *sockets*. And Petitioner maps the claimed *axis* to the axis defined by the hinge shafts 19 rotating within the recesses 17.

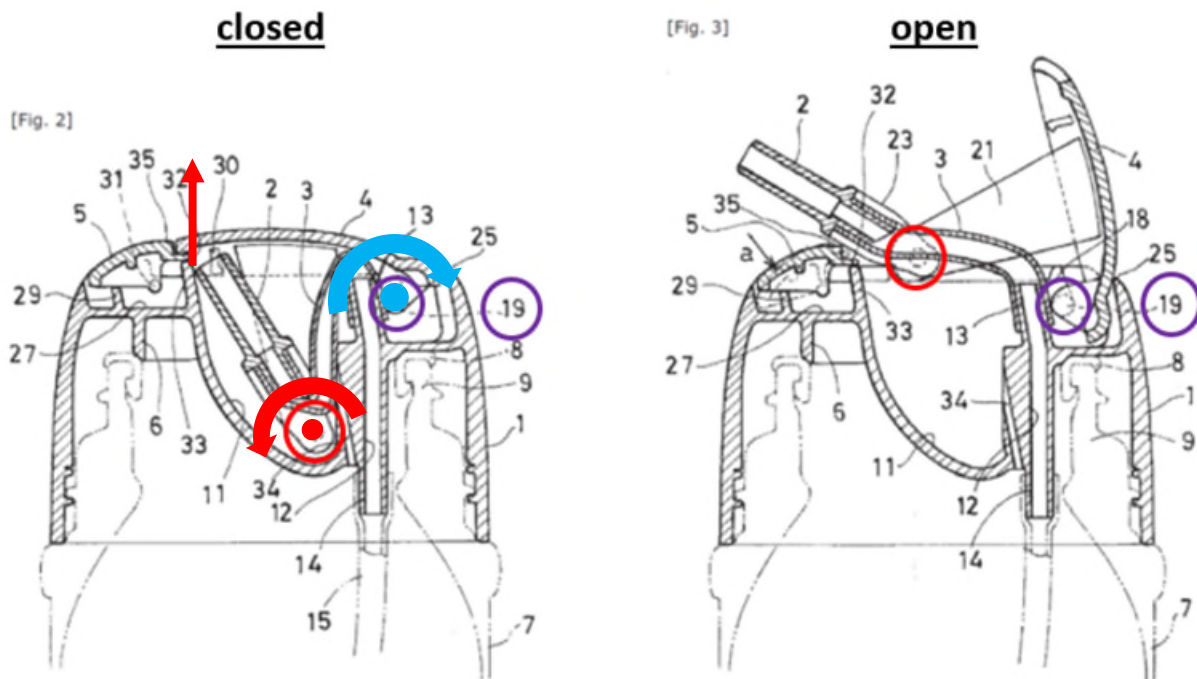


Pet. at 27. The Petition includes arms 23 and protrusions 24—which Nakajima describes as part of mouthpiece 2, Ex.1004 ¶16—in Petitioner’s mapping for the *pivotal mount*. *E.g.*, Pet. at 26. Petitioner maps the rest of mouthpiece 2 to the *mouthpiece* of the claim. *Id.* at 28–29.

As discussed in the summary of Nakajima above (*see* Sec. III.A), Nakajima’s lid 4 (the alleged *pivotal mount*) pivots in a clockwise direction about the axis defined by the hinge shafts 19 (the alleged *axis*) when it opens, but the alleged *resilient mouthpiece* does not pivot with the alleged *pivotal mount* about this axis, as required by the claims. Instead, the *mouthpiece* moves up, and then forward, and

any pivoting by the mouthpiece is about a different axis entirely—defined by the protrusions 24, *not* the hinge shafts 19. Moreover, that pivoting is not *with the pivotal mount* because it is in a counter-clockwise direction—the opposite direction from the lid's (*i.e., the pivotal mount's*) pivotal movement.

These differences are illustrated in the below annotated versions Figures 2 and 3. The **red** annotations indicate the mouthpiece's movement as the lid opens, including the mouthpiece's counterclockwise movement about the axis defined by the protrusions 24 rotating in holes 22. The **blue** annotations indicate the lid's clockwise movement about the different axis defined by the hinge shafts 19.



Ex.1004, Figs. 2–3 (annotated).

The plain language of the claims requires that the *mouthpiece* and the *pivotal mount* move together (i.e., “a resilient mouthpiece . . . for pivotal movement with the pivotal mount”). And the plain claim language similarly requires the “axis” about which the *mouthpiece* must pivot is defined by the lateral projection-socket mating between the *pivotal mount* and the *cap assembly base*.

Nakajima therefore does not disclose either of these limitations, and Petitioner’s arguments fail to show otherwise. The Petition directly quotes Nakajima’s disclosure that “[the mouthpiece] moves up and down in conjunction with the opening and closing of the lid.” Pet. at 35 (quoting Ex.1004 ¶3). Nakajima’s up-and-down movement is not “pivotal movement about” the axis defined by the lateral projections, as claimed, nor does Petitioner identify any evidence to suggest that it is.

To the contrary, Petitioner’s mapping of Nakajima parallels the Reexamination Specialists’ mapping of McDonough during reexamination, and it fails for the same reason. In overcoming the rejection of claim 1 over McDonough during reexamination, the patentee distinguished up-and-down movement from the pivotal movement required by the claims. See Ex.1012 at 16–18; see also *id.* at 30–35 (setting forth ground of rejection for claim 1); Ex.2001 at 845–846 (agreeing with patentee’s arguments). Referring to the annotated figures (below) from McDonough,

the patentee argued that “portion 16 of the straw” of McDonough—mapped to the resilient mouthpiece by the Specialist and highlighted by the patentee’s annotations—“is not pivotal about an axis defined by the pair of lateral projections.” Ex.1012 at 17. Rather, “when the straw positioning member 20 is pivoted about a pivotal axis, the portion 16 of straw 14 is pulled downwards.” *Id.* (underline added).

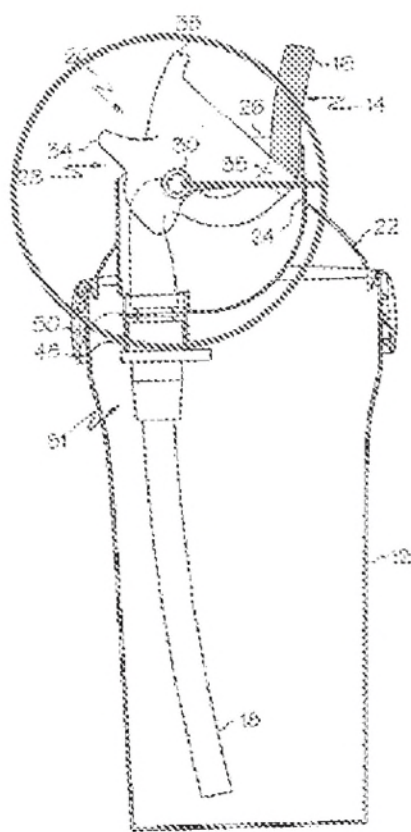


FIG. 2

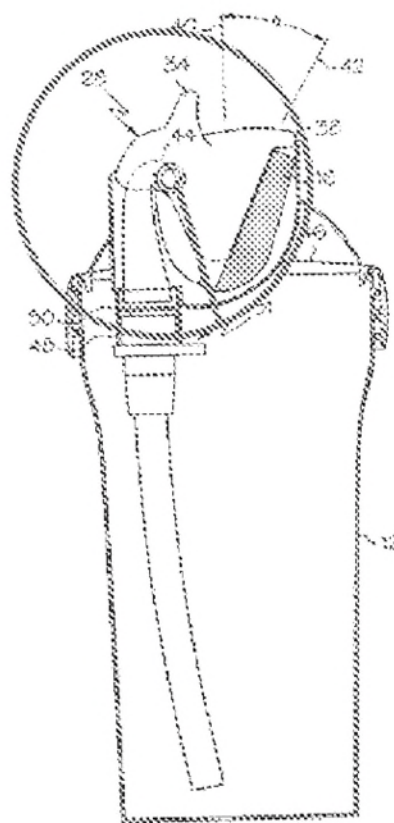


FIG. 3

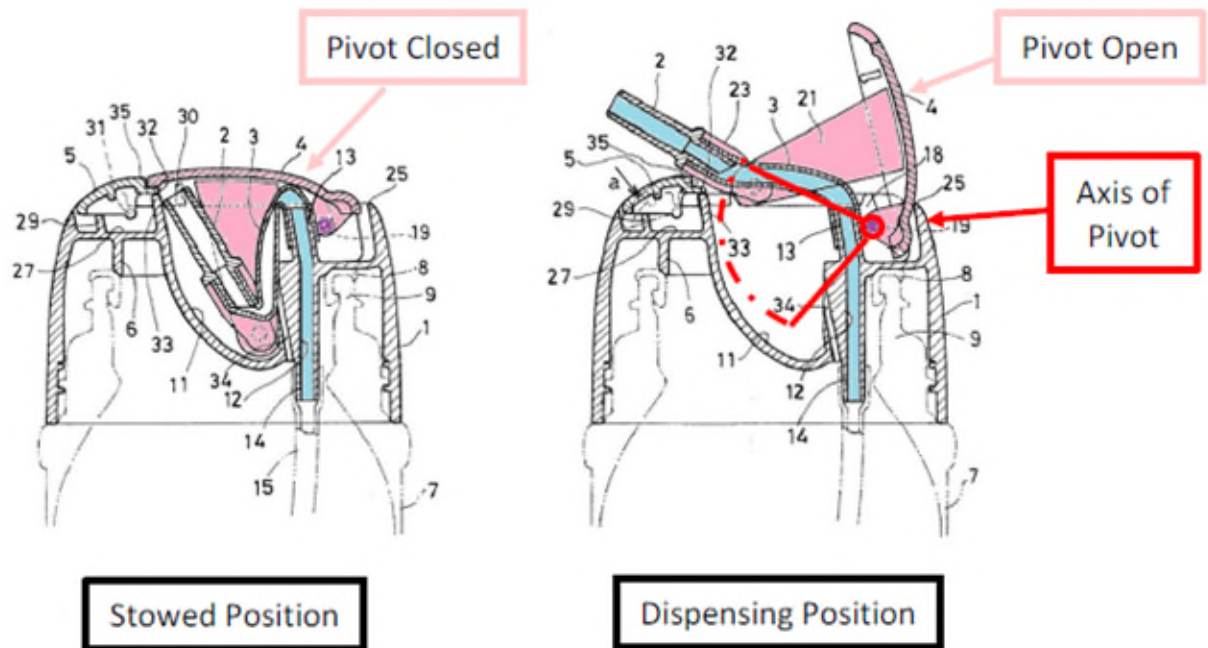
Ex.1012 at 17; see Ex.2008, Figs. 2–3.

Like McDonough, Nakajima’s “mouthpiece” moves “up and down” when the lid (mapped by Petitioner to the *pivotal mount*) opens and closes. Ex.1004 ¶3.

Petitioner even acknowledges this fact. *See* Pet. at 29, 35. But Petitioner then asserts (without explanation) that Nakajima’s up-and-down movement constitutes “pivot[ing] about the axis defined by the lateral projections.” *Id.* at 35. Neither Petitioner nor its declarant, Dr. Vallee, offer any support for the conclusion that the up-and-down movement expressly described by Nakajima constitutes the pivotal movement recited by the claim. *See id.* at 29–30, 35; Ex.1003 ¶¶89, 103. And the record from the reexamination (discussed above) shows that up-and-down movement is not, in fact, “pivotal movement.”

Petitioner also attempts to show the *pivotal movement* about the required *axis* using annotations unsupported by any disclosure, but such attempts are doomed to fail. In the annotated figures below, Petitioner’s annotated dashed red line appears to show the path of protrusion 24, which Petitioner maps as part of the alleged *pivotal mount*, not part of the alleged *mouthpiece*. *See* Pet. at 27. The alleged *mouthpiece* is already in contact with the front wall of storage recess 11, which prevents the alleged *mouthpiece* from following the same path as protrusion 24 and thereby prevents the *mouthpiece* from pivoting about the identified “axis of pivot” defined by hinge shaft 19 as it moves from the labeled “Dispensing Position” (on the right) to the “Stowed Position” (on the left)—instead the *mouthpiece* pivots about the axis defined by the

rotating protrusions 24, *not* the axis defined by the rotating hinge shafts 19 (the alleged *lateral protrusions*).



Pet. at 27.

Petitioner, therefore, fails to show that the alleged *resilient mouthpiece* exhibits “pivotal movement with the pivotal mount” or that this pivotal movement “is pivotal about an axis defined by the pair of lateral projections as the pair of lateral projections rotate within the pair of sockets.”

Petitioner therefore cannot prevail on Ground 1 as to independent claim 1.

2. Given the Deficiencies in Nakajima, Petitioner Cannot Prevail on Any Claim as to Grounds 1 and 2

For all the dependent claims challenged under both Grounds 1 and 2, Petitioner relies on and incorporates the deficient arguments directed to claim 1 under Ground 1. Pet. at 39–64. Petitioner does not assert that any obviousness combination cures the deficiencies of Nakajima. *See generally id.* Accordingly, for the same reasons Petitioner cannot prevail on claim 1, it cannot prevail on either Ground 1 or 2 as to any of the challenged claims.

B. Grounds 3 and 4 Fail Because Ribarits Does Not Disclose or Render Obvious the *Resilient Mouthpiece* of the Claims That Is *Adapted to Resiliently Compress* from *Forces Applied by a User's Teeth* or That Is *Removably Coupled to the Pivotal Mount*

Petitioner cannot prevail on Grounds 3 and 4 as to any claim of the '255 patent. Independent claims 1 and 20 both recite “a resilient mouthpiece” that is “removably coupled to the pivotal mount” and that is “adapted to resiliently compress responsive to compressive forces applied to the resilient mouthpiece by a user’s teeth.” Ex.1002 at 1:48–49, 1:64–66, 2:41–42, 2:57–59. As shown below, Ribarits does not disclose either of these limitations. First, Petitioner implicitly applies an overbroad construction of “adapted to” as meaning merely “capable of,” contrary to the case law and intrinsic evidence. Second, the Petition does not even mention the requirement that the *resilient mouthpiece* must be *removably coupled to*

the pivotal mount in its arguments regarding these Grounds, much less provide any explanation as to how it is met—resulting in a failure of proof. Pet. at 71–73, 97–98; *see id.* at 15 (including the “removably coupled” limitation as part of Limitation “1[b][3]”). And, in any event, Ribarits does not satisfy this limitation for the same reasons as the art distinguished during reexamination. Further, Petitioner does not acknowledge either of these deficiencies in Ribarits, nor does it contend that either would have been obvious, such as in combination with a secondary reference, to attempt to cure either deficiency.

Because both of these limitations—required by both independent claims of the ’255 patent—are missing from the asserted art, Grounds 3 and 4 must fail.

1. The Alleged *Resilient Mouthpiece* in Ribarits Is Shielded from Any *Compressive Forces* from a *User’s Teeth*, Not *Adapted to Resiliently Compress* in Response to Such Forces

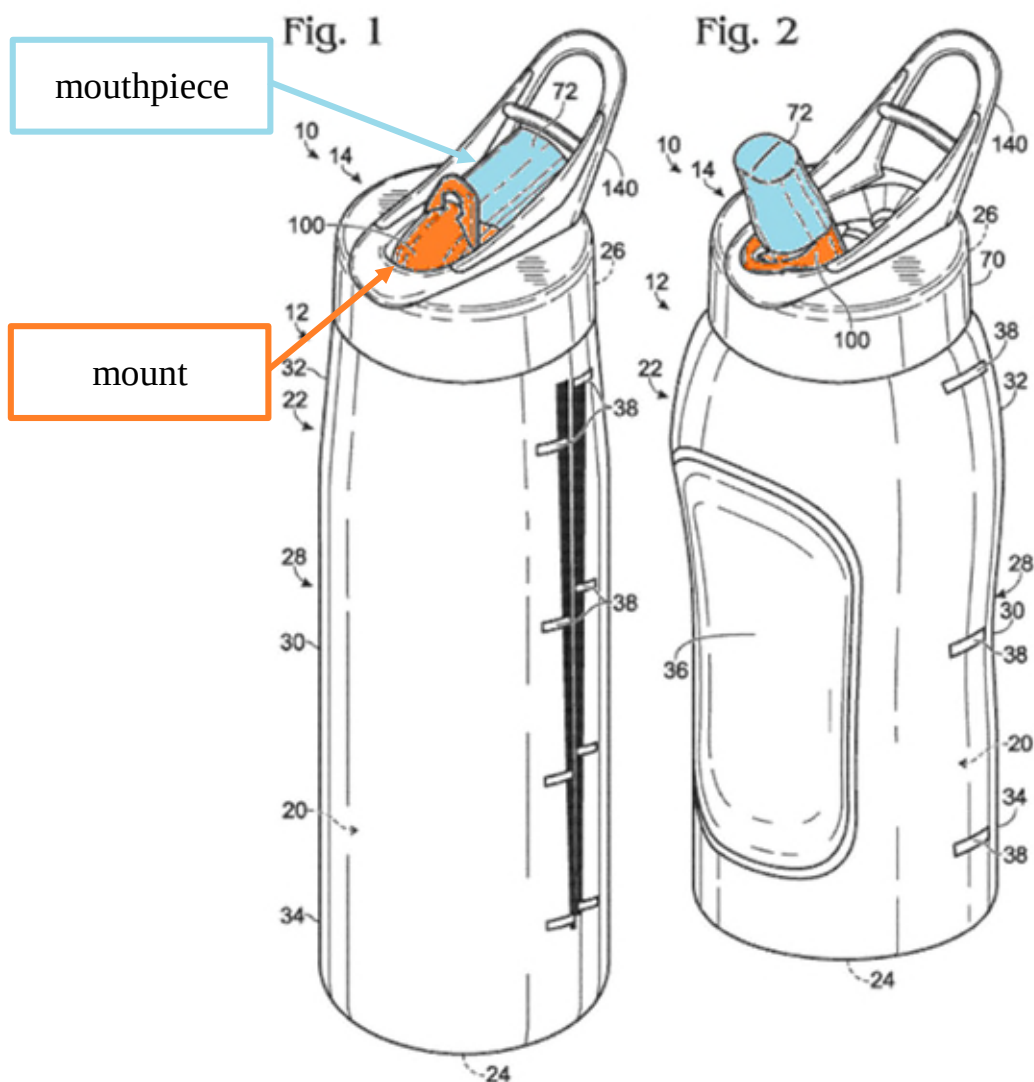
The Petition fails to show that the alleged *mouthpiece* in Ribarits is “adapted to resiliently compress responsive to compressive forces applied to the resilient mouthpiece by a user’s teeth,” as required by the claims. *See* Pet. at 76. Here, the phrase “adapted to” means the mouthpiece must be “designed or configured to” perform the specified function, not merely “capable of” it, for the reasons discussed above. *See, supra*, § V.A. Petitioner does not address this requirement of the

properly construed claim. And Ribarits itself refutes any suggestion that this “adapted to” limitation is met.

Contrary to Petitioner’s assertion, being made of “rubber or latex” does not mean that any portion of Ribarits’s flexible tube is “adapted to resiliently compress responsive to compressive forces applied to the resilient mouthpiece by a user’s teeth” merely because such materials can be made to be capable of the same—if Ribarits is designed or configured such that this rubber or latex tube is not accessible for serving such a purpose without modification and disassembly of the cap assembly structure, then Ribarits’s mouthpiece is not “adapted to” serve this purpose. Pet. at 76. Petitioner does not propose any construction for the phrase “adapted to.” *Id.* at 19. And it relies on the same disclosed composition to support its argument that the alleged *mouthpiece* is “resilient.” *Id.* at 72 (“A POSA would have understood rubber and latex to be examples of resilient materials commonly used for the mouthpieces of drinking devices at the time of invention of the ’255 patent.”). Not every *resilient mouthpiece* is “designed or configured to” resiliently compress in response to a user’s bite, however. The limitation is not met by merely using resilient material that “can be made to serve that purpose”; the *mouthpiece* must be “designed or configured to” perform that function in order to satisfy the “adapted to” requirement of the claim language. *See Aspex Eyewear*, 672 F.3d at

1349. Indeed, Petitioner implicitly reads a limitation out of the claims by suggesting that any resilient material will automatically also satisfy the “adapted to” clause, rather than requiring that it be designed or configured in a manner that specifically allows a user to apply compressive forces with the user’s teeth. *See* Pet. at 71–73, 76.

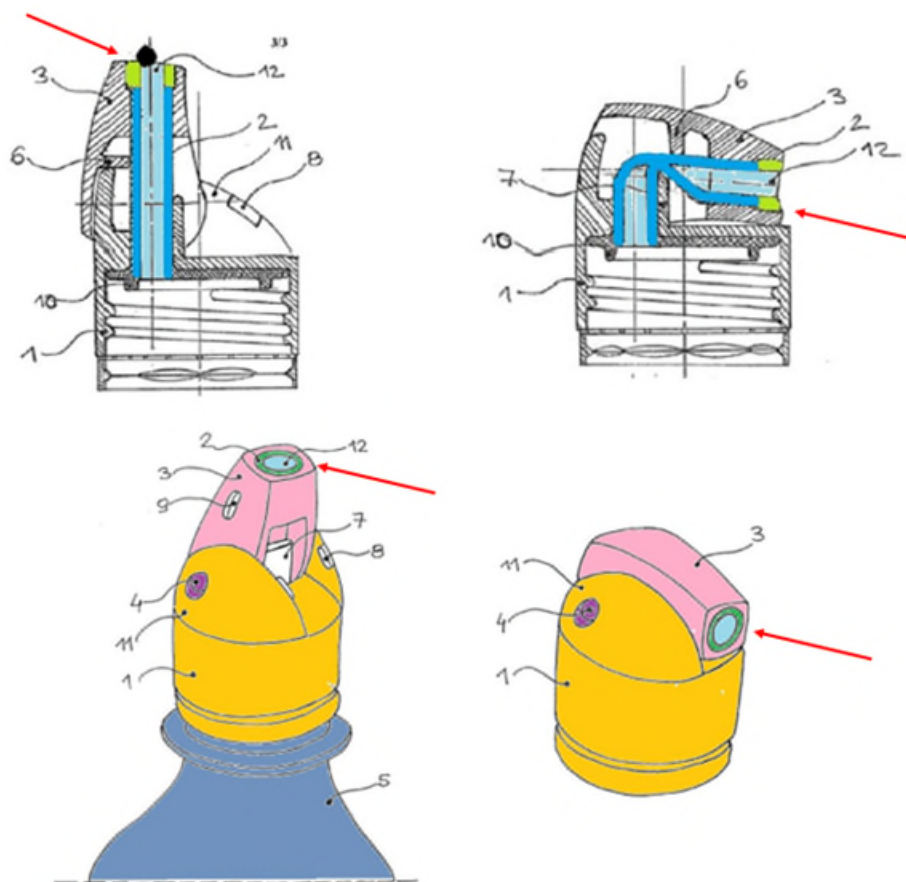
As shown above, the specification and figures of the ’255 patent preclude such a reading of the claims. *See* Sec. V.A, *supra*. For example, the mouthpiece, in embodiments, is designed with a dispensing configuration, in which its position relative to other components exposes the mouthpiece to a user’s bite, as shown in Figure 2 below. *E.g.*, Ex.1001 at 3:21–34, Figs. 1–2.



Ex.1001, Figs. 1–2 (annotated).

In contrast, the end portion of Ribarits’s “sealed tubular element 2,” which Petitioner identifies as the *resilient mouthpiece* and annotates green, is positioned such that other components prevent a user from biting it. As shown by Petitioner’s annotations below, the alleged *resilient mouthpiece* (the green-highlighted portion of tubular element 2) is entirely surrounded by Ribarits’s “drinking spout” (the

alleged *pivotal mount*, highlight in pink). That is, the drinking spout 3 surrounds the full circumference of the green-highlighted end portion of tubular element 2, which Petitioner maps to the *resilient mouthpiece*. And the end of the tubular element 2 (annotated green by Petitioner) is flush with and does not extend past the drinking spout 3, as shown by the red arrows added by Patent Owner.



Pet. at 65–66 (annotated labels omitted); see Ex.1006, Figs. 1 & 3.

Ribarits is thus not configured or designed in a way that allows a user to apply “compressive forces” with the user’s teeth to the green portion of tubular element 2

mapped to the *resilient mouthpiece* by Petitioner. To the contrary, the surrounding drinking spout 3, which Petitioner maps to the *pivotal mount*, shields the tubular element from being bitten by the user. The design of Ribarits's drink bottle therefore prevents a user from applying a bite force to the alleged *resilient mouthpiece*. A *mouthpiece* cannot be "adapted to resiliently compress responsive to compressive forces applied to the resilient mouthpiece by a user's teeth" if it is not even adapted to receive those "compressive forces" in the first place.

Further, as discussed in the claim construction section above, it is insufficient that Ribarits's tubular element 2 might be capable of being removed from the drinking spout 3 and cap 1 and then bitten down upon so as to be capable of being made to serve that purpose. See § V.A., *supra*. That is insufficient to satisfy the properly construed "adapted to" language, because Ribarits's drinking device, as assembled, is not configured or designed to serve that purpose without modification or deconstruction of the alleged drink container. Petitioner offers no obviousness theory based on any such modification. And if one did deconstruct the container, there would be no *cap assembly* comprising a *resilient mouthpiece*, as required by the claims.

Ribarits, therefore, fails to disclose "wherein the resilient mouthpiece is adapted to resiliently compress responsive to compressive forces applied to the

resilient mouthpiece by a user's teeth.” And Petitioner advances no obviousness theory for this limitation. This deficiency, therefore, is dispositive, and Petitioner cannot prevail on Grounds 3 or 4 as to any claim.

2. Petitioner Fails to Present Any Evidence or Argument That Ribarits Discloses or Renders Obvious a *Resilient Mouthpiece Removably Coupled to a Pivotal Mount*

Grounds 3 and 4 also fail because Petitioner fails to show that Ribarits discloses a *resilient mouthpiece* that is *removably coupled* (or *coupled* at all) *to the pivotal mount*, as required by the claims. *See, e.g.,* claim 1 (“a resilient mouthpiece . . . removably coupled to the pivotal mount”).

First, Petitioner fails to discuss this limitation requiring that the mouthpiece be coupled to the pivotal mount whatsoever in the Petition. *See* Pet. at 71–73. Much less does Petitioner provide any explanation or analysis as to how the alleged mouthpiece in Ribarits is coupled to its alleged pivotal mount. *See id.* Petitioner merely asserts that the alleged *mouthpiece* “is inserted through the cap assembly base and engaged with the mount outlet at the dispensing outlet.” Pet. at 72 (underline added). The claims, however, require that the *mouthpiece* be both the “engaged with the mount outlet and removably coupled to the pivotal mount.” Ex.1002 at 1:48–50, 2:41–43. The ’255 patent does not treat these terms as interchangeable. *Compare, e.g.,* Ex.1001 at 21:9–12 (claim 17 reciting “wherein the

projecting flange provides a lever arm that is configured to be engaged by a user's finger to pivot the pivotal mount") *with id.* at 14:65–15:1 (“As used herein, ‘removably,’ ‘removably coupled,’ and ‘removably attached’ refer to structures that are designed to be repeatedly connected and disconnected without destruction of the corresponding structures.”).

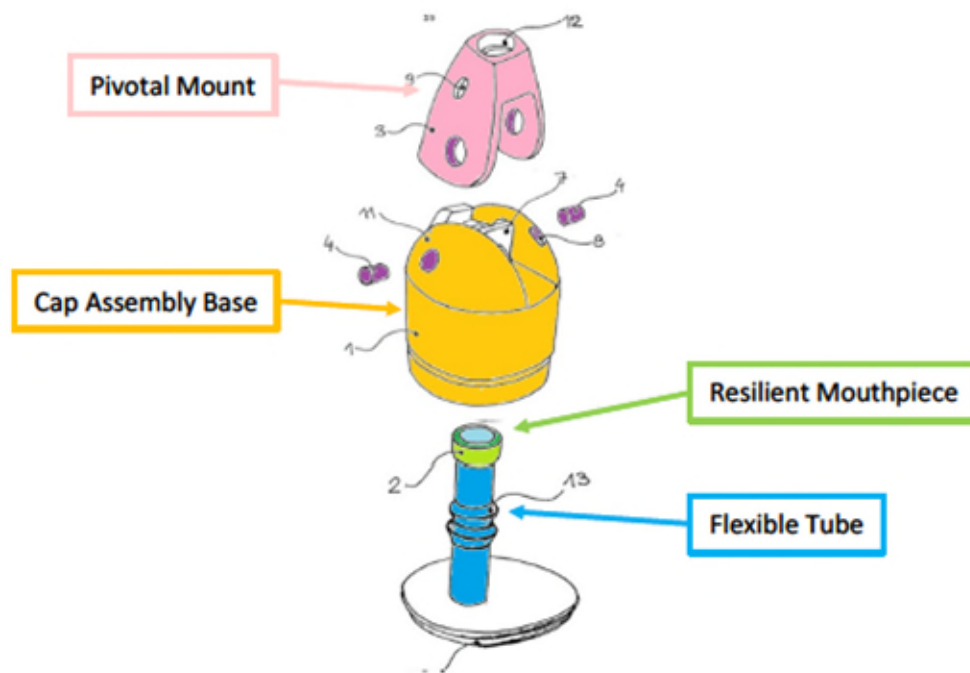
By addressing only the *engaged with* limitation and not the *removably coupled* limitation, Petitioner fails to make an essential element of its proof. *ERBE Elektromedizin GmbH v. Canady Tech. LLC*, 629 F.3d 1278, 1286 (Fed. Cir. 2010) (“Generally, all the limitations of a claim must be considered meaningful.”) (internal quotation marks and alteration omitted). This failure alone is fatal to Grounds 3 and 4, which can be denied for a failure of proof. *See* 35 U.S.C. § 312(a)(3) (grounds and evidence for a challenge must be identified “with particularity”).

Second, even if Petitioner had attempted to address the “coupled” limitation, Ribarits teaches that its tubular element 2 (including its end portion highlighted green and alleged to be the *mouthpiece* by Petitioner) merely passes through its drink spout 3, the alleged *pivotal mount*. During reexamination, the patentee distinguished structures like the one in Ribarits—a rubber tube or straw merely inserted into and passing through an opening in a mount—from the limitation requiring the

mouthpiece be *coupled* to the mount. Ex.1012 at 15.¹² As noted, the Petition ignores the reexamination history.

As illustrated by Petitioner’s annotations to Ribarits’s Figure 2 below, Petitioner alleges an end portion of Ribarits’s “sealed tubular element (2)” is a *resilient mouthpiece*. Pet. at 71–72. But Ribarits discloses only that “sealed tubular element (2)” is “inserted into [the closing cap (1)],” and “inserted into the drinking spout (3).” Ex.1006 at Abstract, 3 (claim 1); *see id.* at 2 (similar); Pet. at 72 (“Ribarits’ resilient mouthpiece is inserted through the cap assembly base.”). Ribarits does not state that the “sealed tubular element (2)” is coupled to the “drinking spout (3).”

¹² Citations to Exhibit 1012 use the page number of the pdf, as filed. For example, page 15 corresponds to page 12 of the Response to Office Action in Ex Parte Reexamination dated August 28, 2023. *See* Ex.1012 at 4–24.

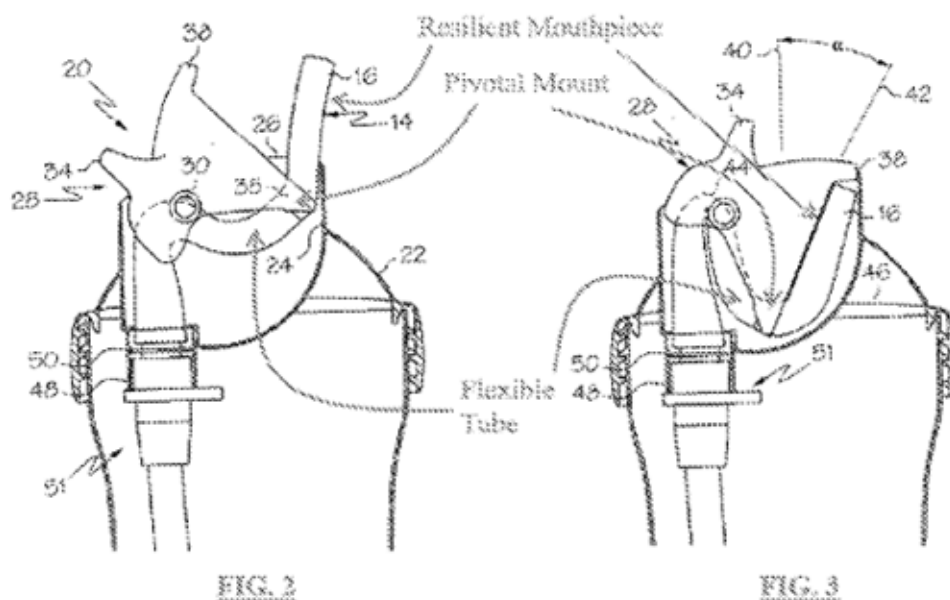


Pet. at 72; see Ex.1006, Fig. 2.

Merely inserting the tubular element into the drinking spout (as Ribarits teaches) might result in the tubular element passing through the drinking spout. But Petitioner does not explain how that, by itself, is enough to constitute being coupled to the drinking spout, as demonstrated by the reexamination history. See Ex.1012 at 15 (patentee’s argument during reexamination); see also Ex.1001 at 14:65–15:5 (defining, *e.g.*, “removably coupled” and “permanently coupled”).

During the reexamination, the Specialist initially rejected, *inter alia*, claim 1 over McDonough, citing the embodiment disclosed in Figures 2 and 3 of McDonough and their accompanying description. See Ex.1012 at 12, 30–35. More

particularly, the Specialist identified McDonough’s “straw positioning mechanism 20 . . . embodied as a straw positioning member 28” as the *pivotal mount*. *Id.* at 31 (quoting Ex.2008 ¶[0021]). Using the third-party requestor’s mapping (shown below), the Specialist identified the “drinking end 16” of “flexible straw 14” as the *resilient mouthpiece*. *Id.* at 32 (citing Ex.2008 ¶[0025]); see Ex.1012 at 102–03, 107; Ex.2008 ¶[0022].

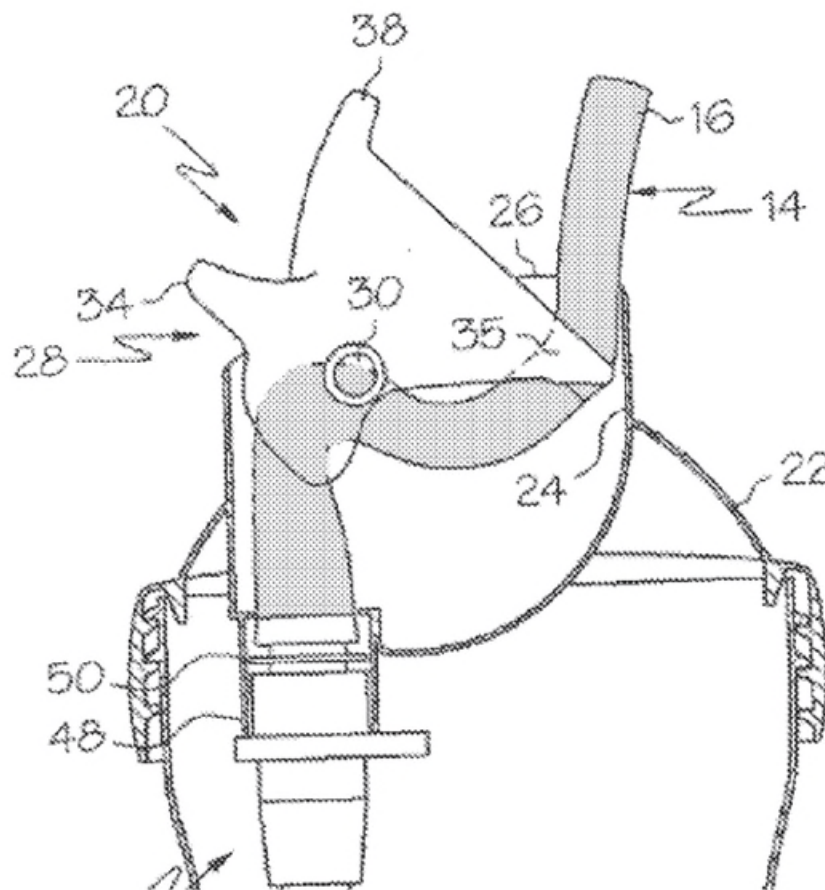


Ex.1012 at 107.

The third-party requestor had argued that “[s]traw 14 is ‘coupled to’¹³ straw positioning member 28 (straw positioning [mechanism] 20) by being received within

¹³ The word “removably” had not yet been added by amendment. See Ex.1012 at 5.

its recess 36.” Ex.1012 at 102 (citing Ex.2008 ¶[0021]). In response to the Specialist’s rejection based on the requestor’s grounds, the patentee argued (in part), “as shown [below], the straw 14 in McDonough passes through the straw positioning mechanism 20, but it is not coupled . . . to the straw positioning mechanism 20.” *Id.* at 15 (underline added). Following this Response, the Specialist concluded that amended claim 1 and new claim 20 were patentable over the prior art, citing this among the limitations missing from McDonough. Ex.2001 at 845–846.



Ex.1012 at 15 (excerpting and annotating Ex.2008, Fig. 2).

Despite being aware of the reexamination history—Petitioner prepared excerpts and filed them as an Exhibit—Petitioner never addresses the patentee’s argument distinguishing McDonough based on the *coupled* limitation. *See* Pet. at 71–73. In fact, as noted, the Petition fails even to assert whether or how any part of Ribarits’s sealed tubular element is *coupled* to the drinking spout identified as the *pivotal mount*. *See id.* (argument regarding limitation “1[b][3]”); *see also id.* at 14 (using “1[b][3]” to refer to the portion of claim 1 that includes the *coupled* limitation).

Petitioner therefore fails to show that Ribarits discloses a *resilient mouthpiece* that is *coupled* to a *pivotal mount*, and Ribarits therefore suffers from the same deficiency as the McDonough art that was overcome during reexamination. Petitioner does not advance any theory of obviousness in an attempt to address this deficiency. Further, in challenging claim 20 under Ground 4, Petitioner relies on and incorporates the same deficient arguments directed to claim 1 under Ground 3. Pet. at 97–98. Thus, both Grounds 3 and 4 fail for this additional reason.

3. Given the Deficiencies in Ribarits, Petitioner Cannot Prevail on Any Claim as to Grounds 3 and 4

For every one of the dependent claims challenged under both Grounds 3 and 4, Petitioner relies on and incorporates the same deficient arguments it makes

regarding Ribarits for claims 1 and 20. *Id.* at 78–96, 98–99. Petitioner does not assert that any obviousness combination cures these deficiencies of Ribarits. *See generally id.* at 78–99. Accordingly, for the same reasons Petitioner cannot prevail on claims 1 or 20, it also cannot prevail on either Ground 3 or 4 as to any of the challenged claims.

VII. THE BOARD SHOULD EXERCISE DISCRETION UNDER § 314(A) TO DENY THE PETITION

Petitioner waited nearly eight months to file its Petition after Patent Owner asserted infringement counterclaims for the '255 patent against Petitioner in the Northern District of California and over ten months after Petitioner first filed suit against Patent Owner.¹⁴ Meanwhile, the district court scheduled a jury trial for September 22, 2025 and set a scheduling order with deadlines premised on that trial date. Petitioner's unwarranted delay makes it almost certain that trial in the district court will conclude before the Board would have the opportunity to reach a final written decision should institution be granted here. Instituting IPR on this Petition,

¹⁴ Petitioner filed suit against Patent Owner asserting claims seeking declaratory judgment of non-infringement of the '255 patent on August 21, 2023. Patent Owner counterclaimed for infringement of the '255 patent on November 8, 2023.

despite considerable investment by the parties and the trial court in the co-pending litigation, would frustrate Congress’s intent that IPRs serve as a faster, less costly alternative to litigation on the issue of invalidity. *See, e.g., SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341, 1357–58 (Fed. Cir. 2016) (Newman, J., dissenting-in-part) (collecting evidence of legislative intent regarding § 315 estoppel), *rev’d in part by SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

The Board has recognized the importance of honoring this goal and laid out factors to guide how courts exercise their discretion on whether to institute trial on a petition. *See NHK Spring Co. Ltd. v. Intri-Plex Techs. Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential); *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 5–16 (PTAB Mar. 20, 2020) (precedential). Applying the *Fintiv* factors (as further clarified in the Director’s Memorandum¹⁵ dated June 21, 2022)

¹⁵ Director Vidal’s Memorandum to Members of the Board re: Interim Procedure for Discretionary Denials in AIA Postgrant Proceedings with Parallel District Court Litigation (available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf) (hereinafter “Director’s Memorandum”).

establishes that the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution in this proceeding.

A. Factor 1: Likelihood of Stay

Petitioner has not moved for a stay in the district court proceeding. *See generally* Ex. 2003. Petitioner asserts its intention to “move to stay the district court action ***as it pertains to the ’255 patent pending resolution of this IPR.***” Pet. at 100 (emphasis added). It does not make any showing that its potential request is likely to be granted, especially given that Petitioner’s anticipated stay request would only address one of the eight patents at issue in the district court case. *See id.*; *see also Finjan, Inc. v. FireEye, Inc.*, No. 4:13-cv-03133, 2017 WL 1150283, at *3 (N.D. Cal. Mar. 28, 2017) (institution of IPR on only of only one out of seven asserted patents weighs against stay); *Finjan, Inc. v. Blue Coat Sys., Inc.*, No. 5:15-cv-03295, 2016 WL 7732542, at *4 (N.D. Cal. July 25, 2016) (institution of IPR on only three of ten asserted patents weighs against stay).

Should Petitioner request a stay of the district court proceeding, and should this Petition be instituted, it is unlikely the district court will grant the motion given the significant investment made by the district court, the proximity of trial, and the fact that seven additional patents are at issue in the district court litigation. Together,

these facts make it likely that any motion to stay the district court litigation will be denied.

For these reasons, factor 1 weighs in favor of exercising discretion to deny the petition.

B. *Factor 2: Trial Date Relative to Final Written Decision Due Date*

Trial in the district court is scheduled to begin September 22, 2025. Ex. 2002. If this IPR is instituted, the Board’s deadline to reach a final written decision is likely to fall in late January 2026—well after the September 2025 district court trial. *See* 35 U.S.C. §§ 314(b), 316(a)(11); 37 C.F.R. § 42.100(c). Accordingly, trial is set to occur almost four months before the Board is likely to issue a final written decision in this proceeding. Further, Petitioner has offered no justification for its substantial delay in requesting IPR, especially where all of its asserted primary prior art references were the same or substantially the same as the prior art that was already publicly available and known to Petitioner when it first filed suit over ten months before filing its Petition. This weighs in favor of exercising discretion to deny the Petition, especially because Petitioner has offered no justification for its substantial delay in requesting IPR. *See Fintiv*, IPR2020-00019, Paper 11 at 9.

C. Factor 3: Investment in Trial Court Proceedings

By the institution deadline, the parties will have invested substantial time and effort in the co-pending litigation (as shown below), and Petitioner's lack of diligence is a contributing cause of this. Accordingly, factor 3 weighs heavily in favor of discretionary denial.

This factor is evaluated based on the date of the Board's decision on institution—not the filing date of the Petition as Petitioner suggests. *See Verizon Bus. Network*, IPR2020-01292, Paper 13 at 14 (“[T]he appropriate time to evaluate the investment of the parties in the Parallel Proceeding is at the time of the institution decision and not at the time of the filing of the petition.”). Petitioner cites the incomplete claim construction process and close of fact discovery as reasons Petitioner contends this factor does not warrant denial. Pet. at 101. However, the Court already held its claim construction hearing on September 24, 2024, and the parties, therefore, anticipate the claim construction order issuing in the near future. Ex. 2003 at Dkt. 106. The district court, therefore, is likely to issue a claim construction order before the deadline for the decision on institution, and Patent Owner will (if authorized) notify the Board when that order issues.

Moreover, fact discovery closes in December 2024, before the Board is expected to make its institution decision in January 2025. Ex.2002. The parties have

exchanged multiple rounds of infringement and invalidity contentions, including Patent Owner's Amended Infringement Contentions (served May 8, 2024), and Petitioner's Amended Invalidity Contentions (served July 18, 2024). *See* Ex.2004; Ex.2003 at Dkt. 73; Ex.2006 at 1 (referencing prior disclosures on January 22, 2024; February 16, 2024; and April 12, 2024). Fact discovery closes in about two months (on December 20, 2024) (Ex. 2002), the parties have already served extensive written discovery on the merits, including third-party discovery, and have taken depositions of two party-employee witnesses and one inventor. *See* Ex.2007 ¶7. The production of documents is already substantially complete. *See id.*; Ex.2003 at Dkt. 49. And the district court has already invested considerable time and resources in the litigation, including holding a claim construction hearing and presiding over discovery disputes requiring two hearings. Ex.2003 at Dkts. 44, 49, 77, 86, 87, 106; Ex.2007 ¶7.

This investment is similar to that in *10x Genomics, Inc. v. President and Fellows of Harvard College*, which the Board determined “weighs in favor of exercising our discretion to deny institution.” IPR2023-01299, Paper 15 at 17–18 (PTAB Aug. 30, 2023). In that case, like here, at the time of the institution decision, the district court had issued substantive orders related to the challenged patent, the parties had exchanged initial and supplemental infringement and invalidity

contentions, the parties had completed claim construction briefing and held a claim construction hearing, the parties had substantially completed document production, and the court had resolved substantive discovery disputes. *Id.*

Further, like the petitioner in *10x Genomics, Inc.*, Petitioner in this proceeding did not diligently prepare and file its Petition after Patent Owner identified the asserted claims in the co-pending litigation. *Id.* On December 21, 2023, Patent Owner served its Disclosure of Asserted Claims and Infringement Contentions, in which it identified claims 1, 3–5, 9, 11–13, and 19 as the asserted claims of the '255 patent. Ex.1013 at 3. Petitioner served Invalidity Contentions listing Nakajima, Ribarits, and Panicci among the prior art with its disclosures of January 22, 2024 and continues to assert grounds based on these references. Ex.2005 at 5–6; Ex.2006 at 5–6. The other two references—Gardner and Hughes—are both listed on the face of the '255 patent itself. *See* Ex.1001 (56) (page 2).

Despite this, Petitioner waited to file its Petition challenging the same claims asserted based on prior art from its contentions until July 1, 2024—almost a year after filing suit and more than six months after first serving its invalidity contentions. Petitioner offers no explanation for this delay. Petitioner's lack of diligence further increases this factor's weight in favor of discretionary denial. *See Fintiv*, IPR2020-00019, Paper 11 at 11 (“If, however, the evidence shows that the petitioner did not

file the petition expeditiously . . . or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.”).

For these reasons, factor 3 weighs heavily in favor of exercising discretion to deny the petition.

D. Factor 4: Overlap of Issues

The issues in this proceeding overlap substantially with the claims in the district court, and Petitioner does not offer any stipulation to mitigate that overlap. Accordingly, factor 4 weighs in favor of discretionary denial.

First, all of the claims asserted in the district court—claims 1, 3–5, 9, 11–13, and 19—are challenged in the Petition. *Compare* Ex.1013 at 3 *with* Pet. at 17. While the Petition also challenges claims that are not at issue in the district court, it would “still be inefficient to proceed because the district court may resolve validity of enough overlapping claims to resolve key issues in the petition.” *Fintiv*, IPR2020-00019, Paper 11 at 13. This is particularly true here because the additional claims challenged in the Petition are similar in scope with the claims in the district court. As Petitioner noted, claim 20 “is identical to claim 1,” but for one additional element, Pet. at 16, and every other claim depends from one of those two independent claims. *See generally* Ex.1001 (claims 2–19 all depend from claim 1); Ex.1002 (claims 21–23 all depend from claim 20). The nondisclosure and/or nonobviousness of any

feature recited in claim 1 is therefore dispositive of every claim under the asserted grounds and will be key issues in both the IPR and the district court.

Second, the art and evidence presented in the Petition on those key issues has also been presented in the district court. In its most recent invalidity contentions, Petitioner asserts invalidity based on “Ribarits alone or in view of” one or more of a several listed references (including “Panicci”). Ex.2006 at 25 (row “D1”); *see also* Ex.2013 (asserting grounds based on Ribarits). Petitioner similarly asserts grounds based on Nakajima “alone or in view of” one or more other references. *Id.* (row “D3”); *see also* Ex.2014 (asserting grounds based on Nakajima). The key issues in the Petition have also been presented in the district court.

The use of Gardner and Hughes in the Petition does not significantly alter the weight this factor should receive because neither is relevant to any of the key issues addressed herein. For example, Petitioner’s challenge to claim 12 in the district court may not rely on Gardner, but the cited disclosure of that reference is similar to Gardner’s. *Compare* Ex.2014 at 34–36 *with* Pet. at 53–61. *See generally* Ex.2015; Ex.1005. And Hughes is likely not asserted in the district court because its alleged relevance is limited to dependent claims 2, 6, 7, and 21, none of which are at issue in the district court. *See* Pet. at 85–88, 94–96, 98–99.

Petitioner offers no credible argument that this factor should favor institution. No weight should be given to the fact that Petitioner raises additional grounds in the district court that are not raised in the Petition. *See* Pet. at 102. Weight is only given when the petition presents “grounds, arguments, and/or evidence” that are different “than those presented in the district court.” *Fintiv*, IPR2020-00019, Paper 11 at 12–13. In this instance, substantially the same grounds are presented in both proceedings for the claims that are challenged in both venues.

Furthermore, Petitioner does not offer any kind of stipulation, such as a *Sotera* stipulation, to mitigate the concern about overlapping issues, suggesting instead that a partial stay of the litigation “as to the ’255 patent” will do so. Pet. at 102. The extent to which that may be the case is properly considered under factor 1, not factor 4, and (as discussed above) Petitioner offered no evidence that such a stay would be likely.

Because the overlap of issues is substantial, this factor weighs at least slightly in favor of discretionary denial.

E. *Factor 5: Same Parties*

The parties in this IPR and the parties in the co-pending litigation are identical, so this factor weighs in favor of discretionary denial. *Sotera*, IPR2020-01019, Paper 12 at 19 (precedential); *Fintiv*, IPR2020-00019, Paper 15 at 15 (PTAB May 13,

2020) (informative). Petitioner does not dispute the weight of this factor, instead only arguing it “is not determinative.” Pet. at 102. It may not warrant denial on its own, but it certainly weighs in favor of denial. *See Sotera*, IPR2020-01019, Paper 12 at 19 (precedential) (“[T]his factor supports denying institution.”); *Fintiv*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (informative) (“[T]his factor weighs in favor of discretionary denial.”).

Factor 5 weighs in favor of discretionary denial.

F. *Factor 6: Other Considerations*

Under Board precedent, the Board should only consider the compelling merits standard under factor 6 if the first five factors favor denial. *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4–5 (PTAB February 27, 2023) (precedential). Here, factors 1–5 all weigh in favor (some heavily) of exercising discretion to deny institution. Thus, because consideration of the first five factors favors denial, the Board should consider the compelling merits standard under factor 6 here.

The compelling merits standard is only met when “the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Director’s Memorandum at 4 (underline added). A challenge can only meet this standard “if it is highly likely that the

petitioner would prevail with respect to at least one challenged claim.” *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (PTAB Oct. 4, 2022) (precedential). The Petition presents no compelling merits that weigh against discretionary denial. For the reasons explained above, the merits of the Petition’s grounds are weak and independently warrant denying institution. Because the evidence does not even meet the “reasonable likelihood” threshold for institution, it certainly does not meet the even higher “highly likely” threshold or “plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.”

Therefore, consideration of the compelling merits factor weighs strongly in favor of discretionary denial.

G. Combined Factors

When combined, the *Fintiv* factors strongly favor discretionary denial under § 314(a). All six factors weigh in favor (some heavily) of exercising discretion to deny institution. Viewing the factors holistically, discretionary denial is the outcome that best serves the “efficiency and integrity of the system.” Far from being the *alternative* to district court litigation that Congress envisioned, Petitioner has turned this proceeding into a bonus round. Patent Owner and the Board will pay the cost.

The facts bear this out. Petitioner offers no justification for its lengthy delay in filing its Petition, despite relying on prior art known for more than six months and (in some instances) cited on the face of the '255 patent itself. Because of this delay, the co-pending litigation advanced so far that claim construction and fact discovery will both be complete before the Board decides whether to institute. The parties will have borne all the expense of fact discovery and related depositions. Trial, including on invalidity, is all but certain to happen before the Board issues a final written decision in this case. That trial will involve claims challenged in this case, and Petitioner will not be subject to estoppel under § 315(e) and may try to assert art and grounds similar to those in the Petition, whether based on the same or slightly different art. Even if trial ends in a judgment for Patent Owner, Petitioner would still have the option to maintain this proceeding as a second bite at the apple.

Hence, whether by design or unintentional delay, the timing of the Petition gives Petitioner two chances to litigate invalidity and obtain its preferred outcome. This does not serve the efficiency of the system, which already expends considerable public resources to litigate invalidity once. In addition, the possibility of inconsistent results compromises the patent system's integrity. This is the archetypal case that justifies discretionary denial under § 314(a), and the Board should deny institution at least on that basis.

VIII. CONCLUSION

For at least the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition.

Dated: October 30, 2024

Respectfully submitted,

By: /Ryan J. Schletzbaum/

Ryan J. Schletzbaum (Reg. No. 70,850)
Lead Counsel for Patent Owner
SHOOK HARDY & BACON LLP
2555 Grand Blvd
Kansas City, MO 64108
Tel: 816.474.6550
Fax: 816.421.5547
rschletzbaum@shb.com

Jason R. Mudd (Reg. No. 57,700)
Backup Counsel for Patent Owner
SHOOK HARDY & BACON LLP
2555 Grand Blvd
Kansas City, MO 64108
Tel: 816.474.6550
Fax: 816.421.5547
jmudd@shb.com

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE, according to the word-processing system used to prepare the paper and not including those parts excluded by § 42.24(a)(1), has 13,017 words, which is within the type-volume limit set by § 42.24.

By: /Ryan J. Schletzbaum/
Ryan J. Schletzbaum
Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on October 30, 2024, a complete and entire copy of the foregoing Patent Owner's Preliminary Response and Exhibits 2001–2015 were provided via email to Petitioner's counsel of record as follows:

Ali S. Razai (Reg. No. 60,771)
Joseph F. Jennings (Reg. No. 40,664)
Cheryl T. Burgess (Reg. No. 55,030)
Nathan D. Reeves (Reg. No. 77,806)
Email: BoxTrove1@knobbe.com
KNOBBE MARTENS OLSON & BEAR, LLP

By: /Ryan J. Schletzbaum/
Ryan J. Schletzbaum
Lead Counsel for Patent Owner