

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Tommy John, Inc.,
Petitioner,

v.

0912139 B.C. LTD.
(Pakage Apparel, Inc.),
Patent Owner.

Case (To be assigned)
Patent 10,834,974

**PETITION FOR *INTER PARTES* REVIEW OF
OF U.S. PATENT NO. 10, 834,974
UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. §42.100 *et seq.***

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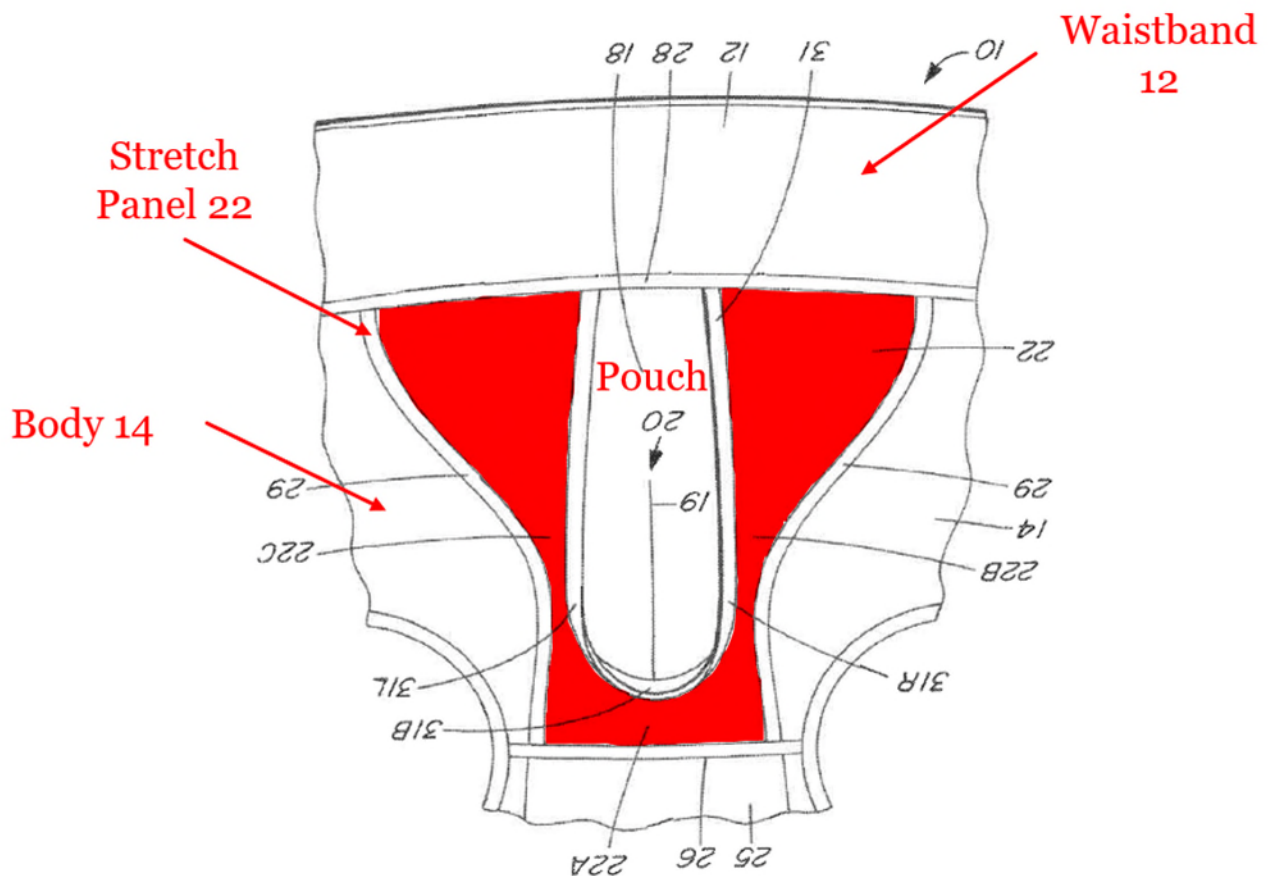
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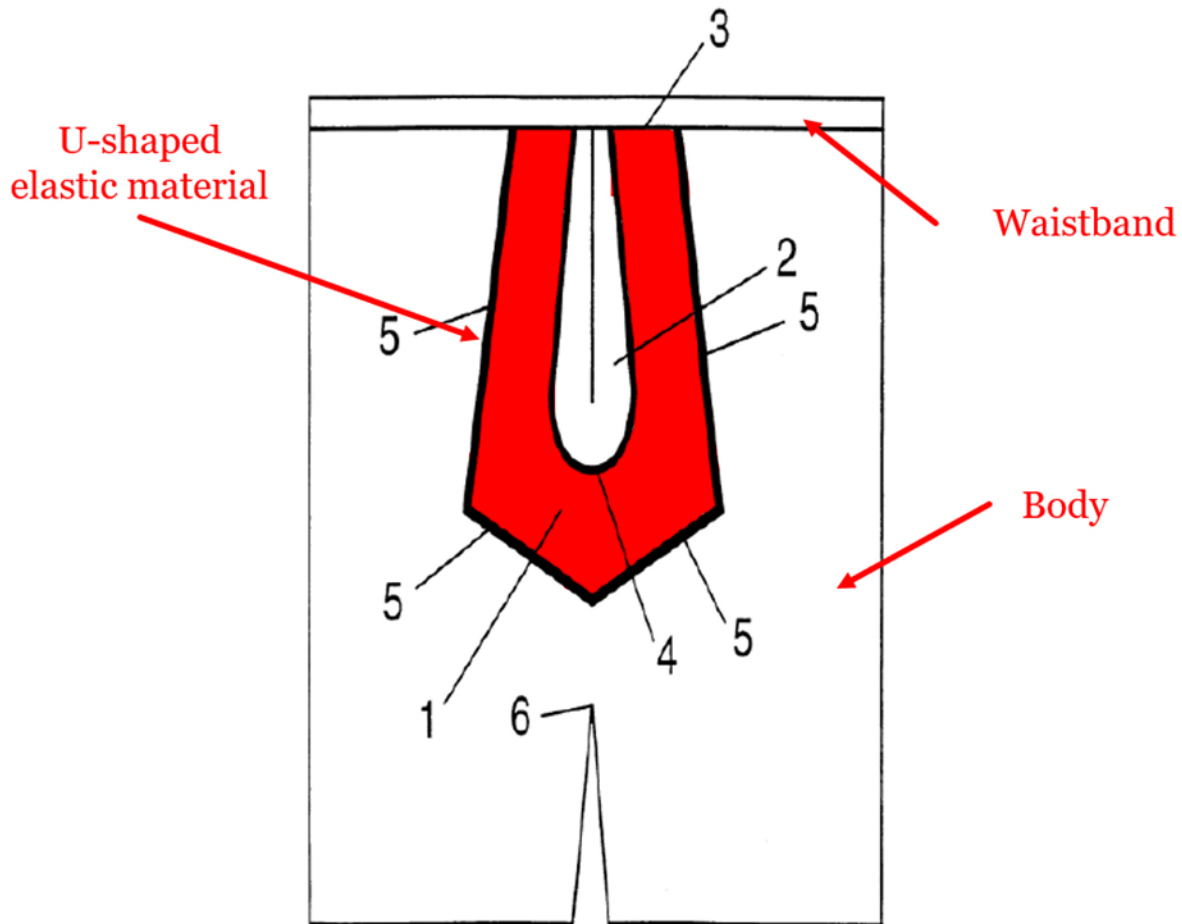
I. INTRODUCTION

Petitioner Tommy John, Inc. (“**Petitioner**”) challenges claims 1-13 and 15-16 of US10,834,974 (“**’974**”) (EX1001). The ’974 is directed to men’s underwear with a pouch to support genitalia. Its claims recite a garment having (a) a waistband 12, (b) a body 14, and (c) an elastic stretch panel 22 attached inside a front portion of the body that gathers the front portion into a pouch, with an opening to receive the wearer’s genitals in the pouch:



(’974, Fig. 4 (rotated and annotated).)

This is near indistinguishable from the prior art. For example, WO01/37687 (“**Carrillo**”) (EX1009; EX1010¹) is directed to a “hygienic *elastic* garment” in men’s underwear with a “*tear-shaped vertical opening*” to support the testicles:

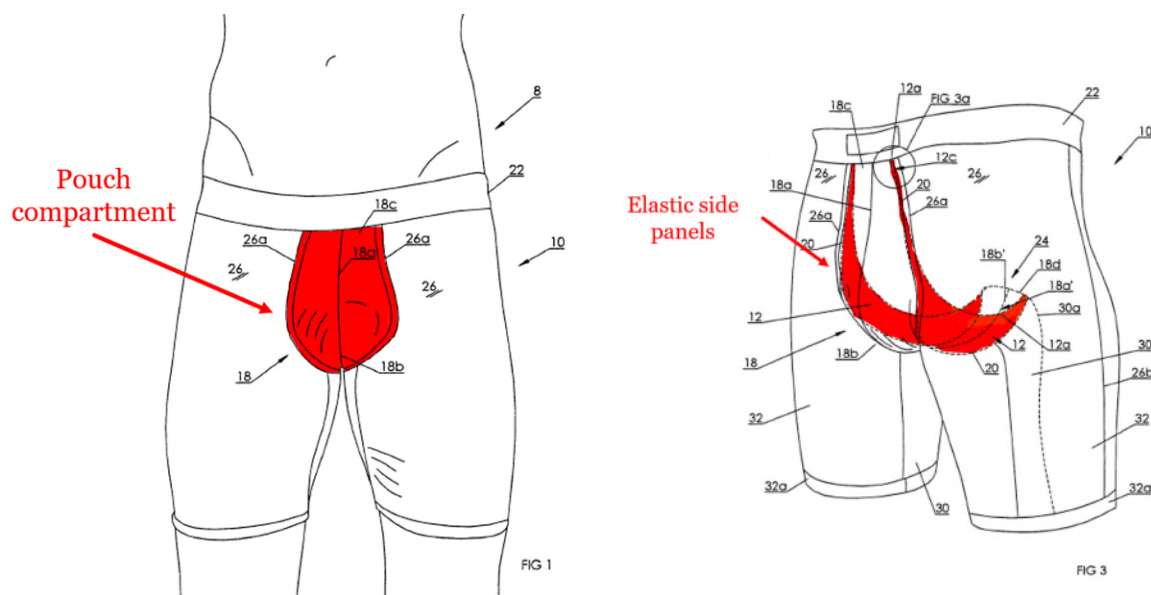


(Carrillo, Fig. (annotated).)

Similarly, US2008/0178369 (“**Kitsch**”) (EX1007) is directed to an “underwear garment for a male” that includes interior “side panels” 12 and pouch

¹ EX1010 is a certified translation of Carrillo. Citations herein are to this certified translation.

18, with the side panels being “elasticized” and “preferably formed so as to cup the genitalia”:



(Kitsch, Figs. 1, 3 (annotated), [0029].)

These references, in combination with additional prior art discussed below, render the challenged claims obvious.

II. MANDATORY NOTICES

A. Real Parties-in-Interest

The real party-in-interest is Petitioner Tommy John, Inc.

B. Related Matters

The '974 is the subject of the following civil action: *Pakage Apparel, Inc., v. Tommy John, Inc.*, Case No. 4:23-cv-4337 (S.D. Tex.), filed November 17, 2023.

C. Counsel and Service Information

Lead counsel is Joe Raffetto (Reg. No. 66,218). Backup counsel is Scott

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III. NOTICE OF FEES PAID

Fees are submitted herewith. If additional fees are due during the proceeding, the undersigned authorizes the Office to charge them to Deposit Account No. 50-1349.

IV. CERTIFICATION OF GROUNDS FOR STANDING

Petitioner certifies the '974 is available for *inter partes* review and that it is not barred or estopped from requesting this review.

V. PRECISE RELIEF REQUESTED

The relief requested is cancellation of the challenged claims, as follows:

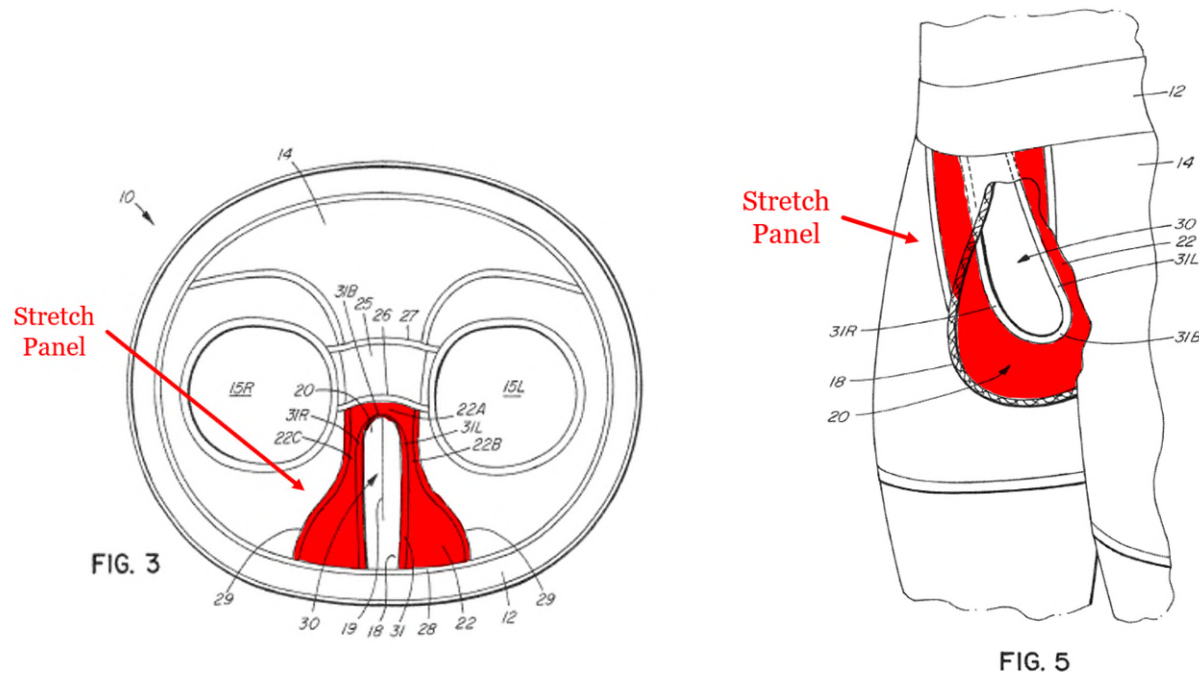
Ground	References	Claims²	Basis
1	Kitsch in view of Brocks	1-13, 15-16	103
2a	Carrillo in view of Brocks	1-9, 11, 13, 16	103
2b	Carrillo in view of Brocks and further in view of Kitsch	10, 12, 15	103

² Independent claims in bold.

VI. OVERVIEW OF THE '974

A. Subject Matter of the '974

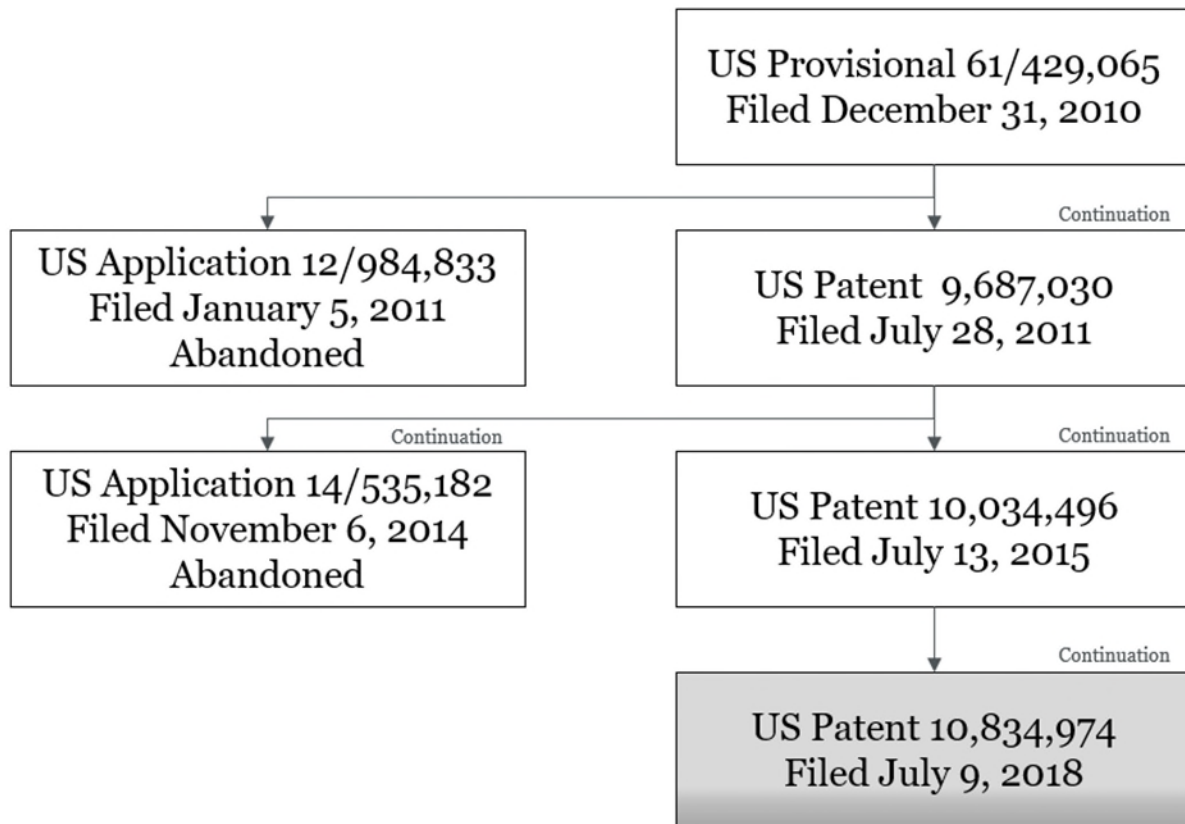
The '974 is directed to a garment for men and boys with a pouch “defined between [a] stretch panel and the front of the garment.” ('974, 1:40- 44.)



(*Id.*, Figs. 3, 5 (annotated).) The claims recite how the stretch panel, being elastic and attached inside a front portion of the garment at a top location (*e.g.*, near the waistband) and a bottom location, gathers the front portion from top to bottom and side to side to define a pouch that holds a wearer’s genitals. (*Id.*, Fig. 6, 1:38-60, 6:28-41, 8:28-49.)

B. Prosecution History of the '974

The '974 was filed July 9, 2018, and issued November 17, 2020. It is part of the following family:



During prosecution of the '974, only a single Office Action issued, rejecting the claims on double-patenting grounds over US10,034,496. (EX1002, '974 File History, 130-135 (Non-Final Office Action mailed June 26, 2020).) In response, Applicant filed a terminal disclaimer, and a Notice of Allowance issued. (*Id.*, 169-171 (Notice of Allowance mailed October 5, 2020).) US10,034,496 likewise only received a double-patenting rejecting and was terminally disclaimed back to its immediate parent, US9,687,030. (EX1003, '496 File History, 92-96 (Non-Final Office Action mailed November 9, 2017), 127-128 (Terminal Disclaimer filed February 6, 2018).)

During prosecution of US9,687,030 (the '974's ultimate parent patent), two Office Actions were issued rejecting the claims over multiple references directed to underwear having a pouch for a wearer's genitals, with Applicant consistently arguing its claimed invention is distinguishable because these references allegedly did not teach a stretch panel that "gathers" a front portion of the underwear to form a pouch, with the stretch panel having a length and width when unstretched smaller than a length and width measured along the front portion.

For example, in response to a Final Office Action rejecting the claims over US2007/02772852 ("**Gravette**") and certain other references, Applicant conceded Gravette discloses a "pouch ... on the front panel [*e.g.*, portion]" of underwear. (EX1004, '030 File History, 205-221 (RCE and Response to Final Office Action mailed July 8, 2014).) It argued Gravette did not disclose the claims because Gravette's front portion is not "gathered" by the stretch panel; instead, according to Applicant, Gravette's "pouch hangs loosely behind" the front portion. (*Id.*) Following an Examiner Interview and minor Examiner's Amendments, a Notice of Allowance mailed August 6, 2014. (*Id.*, 231-241 (Notice of Allowance.))

VII. CLAIM CONSTRUCTION AND POSITA DEFINITION

A. Claim Construction

Claims in an *inter partes* review "shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under

35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). Unless indicated otherwise, all claim terms herein are given such ordinary and customary meaning.

B. Definition of a Person of Ordinary Skill in the Art

A person of ordinary skill in the art (“**POSITA**”) in the field of the ’974 would have had an undergraduate degree in apparel design, apparel manufacturing, textile science, or similar disciplines, along with one year of experience working in apparel design or manufacturing or textile or fabric engineering. (Wagner Decl., ¶¶31-32.)³ The more education one has, the less experience needed to attain an ordinary level of skill. (*Id.*) Similarly, more experience in the field may serve as a substitute for formal education. (*Id.*)

VIII. ANALYSIS OF GROUNDS FOR UNPATENTABILITY

A. Ground 1: Kitsch in View of Brocks Renders Obvious Claims 1-13 and 15-16

Kitsch is US2008/0178369. Kitsch was filed December 19, 2007, and published July 31, 2008. Kitsch is prior art under pre-AIA § 102(b). Brocks

³ Ms. Robin Wagner is an expert in apparel design, among other things. Her declaration is attached as Exhibit 1005.

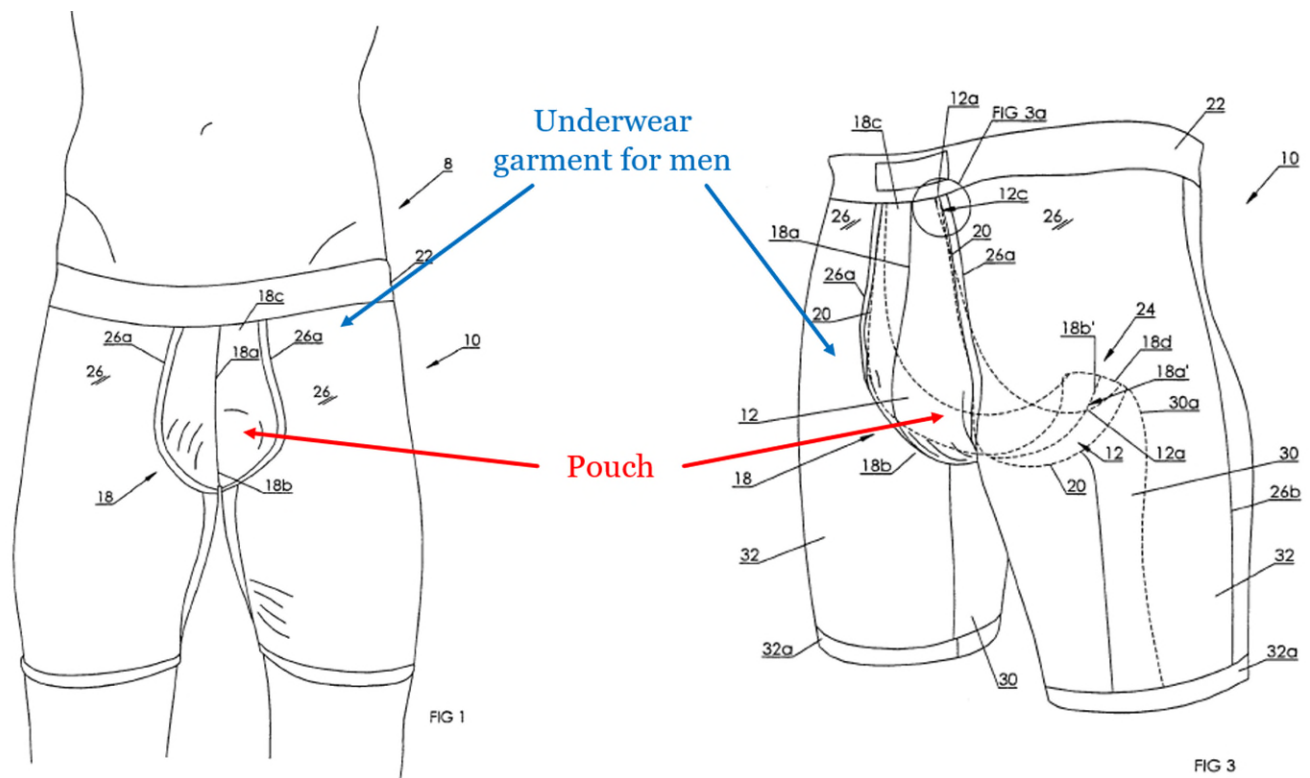
(EX1008) is US5,461,729. Brocks issued October 31, 1995, and is prior art under 35 U.S.C. § 102(b).

1. Independent Claim 1

Kitsch in view of Brocks renders obvious Claim 1. (Wagner Decl., ¶44.)

1[pre]: A male garment comprising:

To the extent limiting, Kitsch discloses Claim 1[pre]. (*Id.*, ¶45.) Kitsch discloses “[a]n underwear garment for use by a male[.]” (Kitsch, Abstract, [0001]-[0003], [0007].) This garment includes “a specifically shaped breathable pouch which includes elasticized breathable wicking mesh material side panels to isolate the scrotum and phallus from the legs and which wick away moisture and provides superior comfort.” (*Id.*, [0006]; *see also* Abstract, [0002], [0007]-[0008], [0026]-[0027], [0030]-0036].)

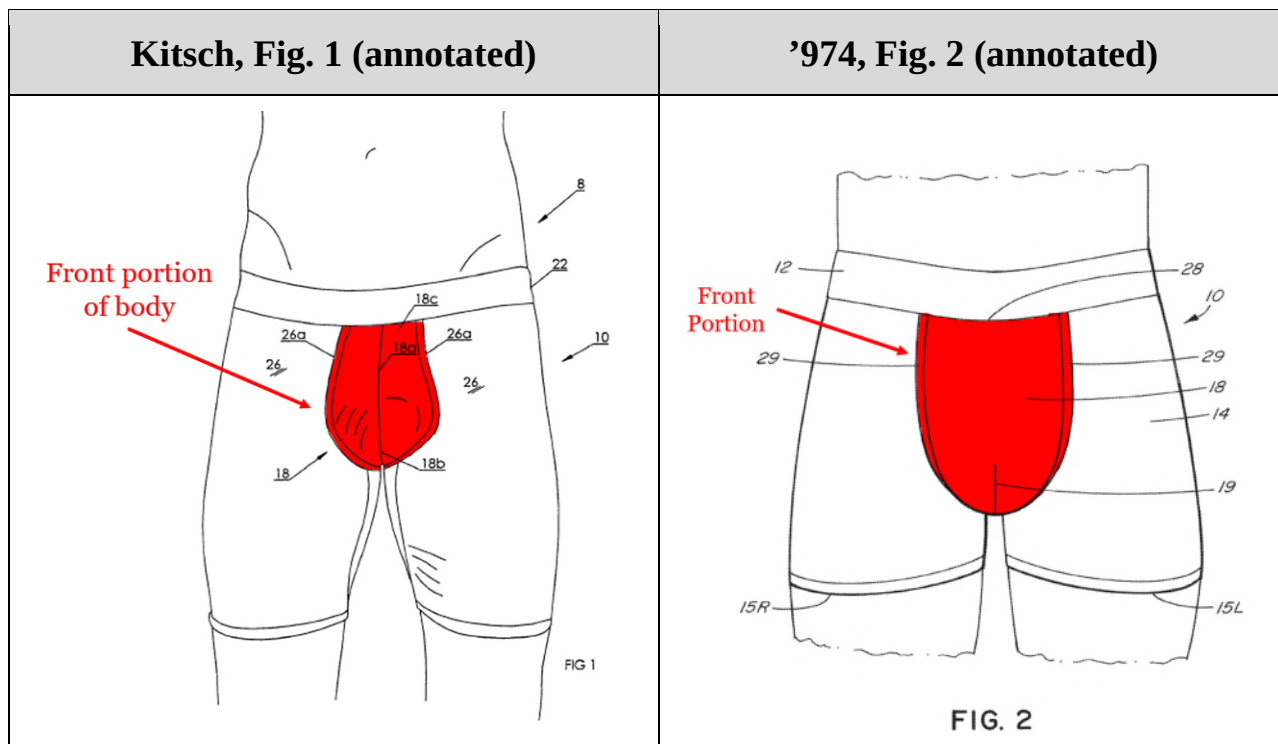


(*Id.*, Figs. 1, 3 (annotated).)

1[a]: a body including a front portion and having leg openings for a wearer's legs;

Kitsch discloses Claim 1[a]. (Wagner Decl., ¶¶46-48.) Kitsch's underwear includes a "body"—for example, "front walls/panels 26"; "pouch compartment 18" that has an inner layer of material 18' and an outer layer of material 18''; "rear panel 28"; "legs 32"; and "leg bands 32a." (Kitsch, [0006], [0029], [0035]-[0041]. Figs. 1-3, 6-7.)

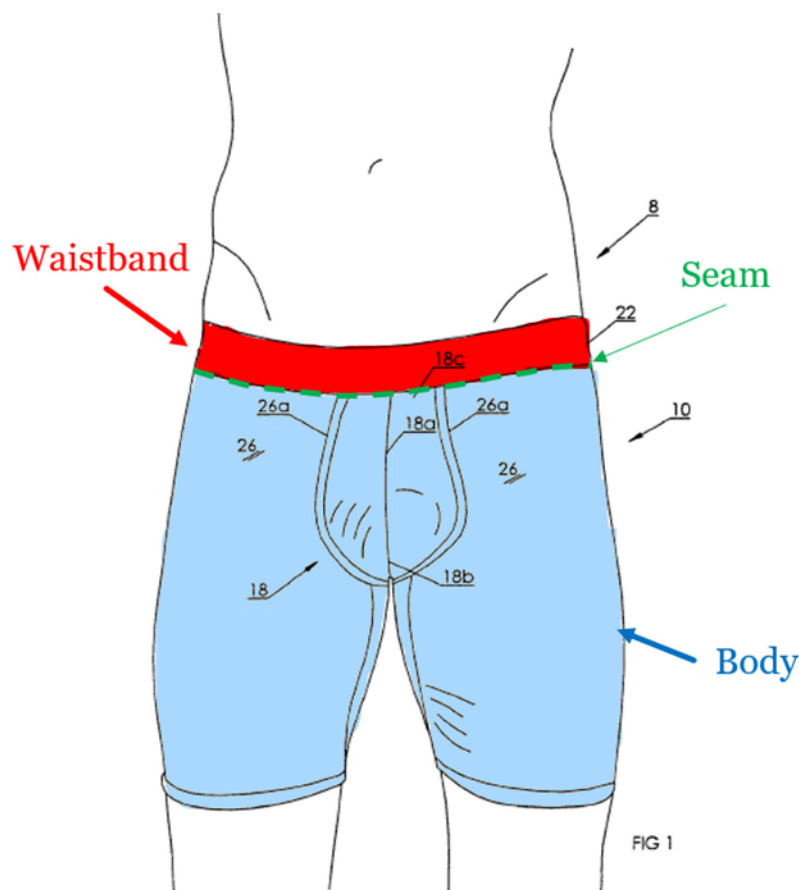
The body includes a "front portion" in form of pouch compartment 18 comprised of inner and outer fabric layers 18', 18''. (*Id.*, [0029]-[0030], [0035]-[0041], Figs. 1-3; *see also* [0007].) As shown below, the "front portion" of the body in Kitsch is strikingly similar to that of the '974:



Kitsch's body also has openings in "legs 32" surrounded by "legbands 32a" to receive the wearer's legs. (Kitsch, Figures 1-4, 7, [0006], [0041].)

1[b]: a waistband attached by a waistband seam at an upper edge of the body;

Kitsch discloses Claim 1[b]. (Wagner Decl., ¶49.) Kitsch discloses "waistband 22" attached to an upper edge of the body along a seam:



(Kitsch, Fig. 1 (annotated), [0006]-[0010], [0029], [0035], Cl. 1, Figs. 2-3, 7.) Kitsch further notes its underwear body has “a front wall depending from a waistband.” (*Id.*, [0006]-[0007], [0029], Figs. 7, 11-12.)

1[c]: a stretch panel attached to the body inside the front portion,

Kitsch discloses Claim 1[c]. (Wagner Decl., ¶¶50-51.) Kitsch discloses a stretch panel, in the form of “side **panels** 12,” which are “constructed of an **elasticized** breathable **mesh** fabric, for the purpose of isolating the genitalia... into the pouch compartment.” (Kitsch, [0026]-[0027]; *see also* [0007]; Cls. 1-4, 8.) The

side panels “provide the intended isolating function... and support for the scrotum.” (*Id.*, [0030].)

Kitsch’s side panels are attached to the body “inside the front portion,” as they “extend generally orthogonally inwardly from **the front of the brief**” and are “stitched to the front walls 26 and waistband 22 of brief 10.” (*Id.*, [0029].) Further, the “side panels 12 and the interior and exterior layers 18’ and 18” respectively of pouch compartment 18 advantageously may share the interior seams 20 which create the pouch shape that is, seams 20 and 26a are coincident,” allowing cooperation between the side panels and pouch. (*Id.*, [0037]-[0039], Fig. 3; *see also* [0026]-[0027].)

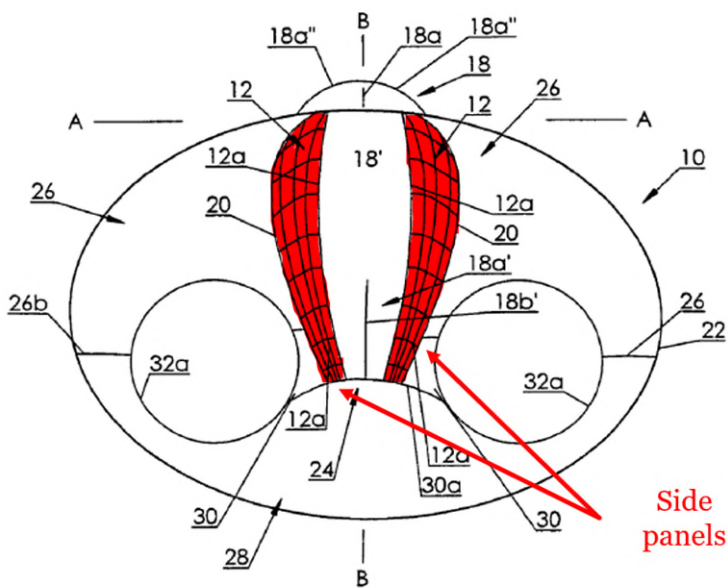


FIG 8

(*Id.*, Fig. 8 (annotated).)

four directions (that is, up and down and left and right). (Wagner Decl., ¶¶53-54.)

See also infra Claim 1[e].

1[e]: ...[i] *having a top edge attached to the body at a top location*, [ii] *a bottom edge attached to the body at a bottom location*, [iii] *side edges attached to the body at side seams extending substantially continuously along either side of the front portion* and [iv] *an opening for receiving a wearer's genitals*;

Kitsch discloses Claim 1[e]. (Wagner Decl., ¶55.)

First, Kitsch's side panels 12 have a "top edge" attached to the body at a "top location" (*e.g.*, at or near the waistband), as the side panels include "***upper ends 12c*** of side panels 12 where side panels 12 are stitched to the front walls 26 and waistband 22 of brief 10." (Kitsch, [0029]; *see also* [0008]-[0010], [0028], [0035]-[0039].)

Top edge of
side panels
attached to
body at a top
location

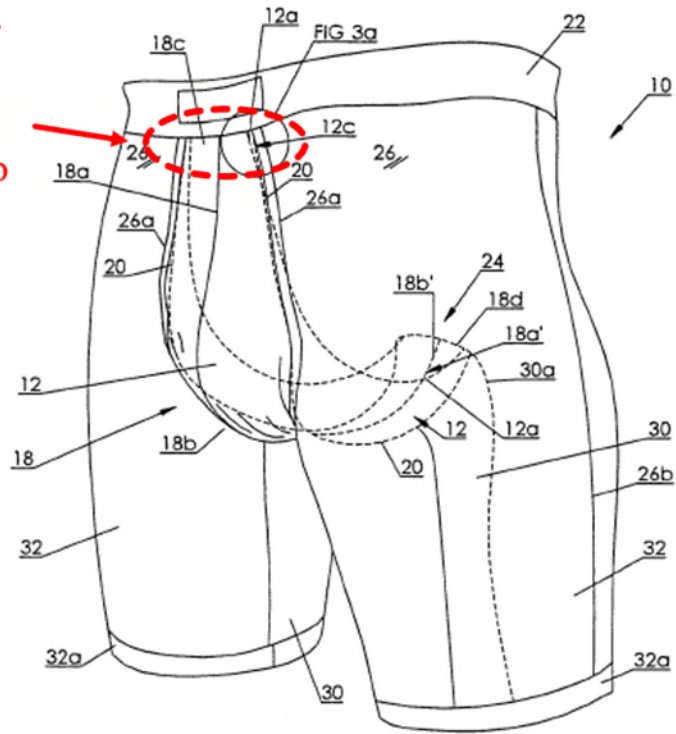


FIG 3

(*Id.*, Fig. 3 (annotated), [0029], Fig. 4; *see also* Wagner Decl., ¶56.)

Second, Kitsch’s side panels have a “bottom edge” attached to the body at a bottom location, as the panels’ bottom edges attach to the body around the “perineum area 24” at seam 30a, which is at the “rearmost end of pouch compartment 18”:

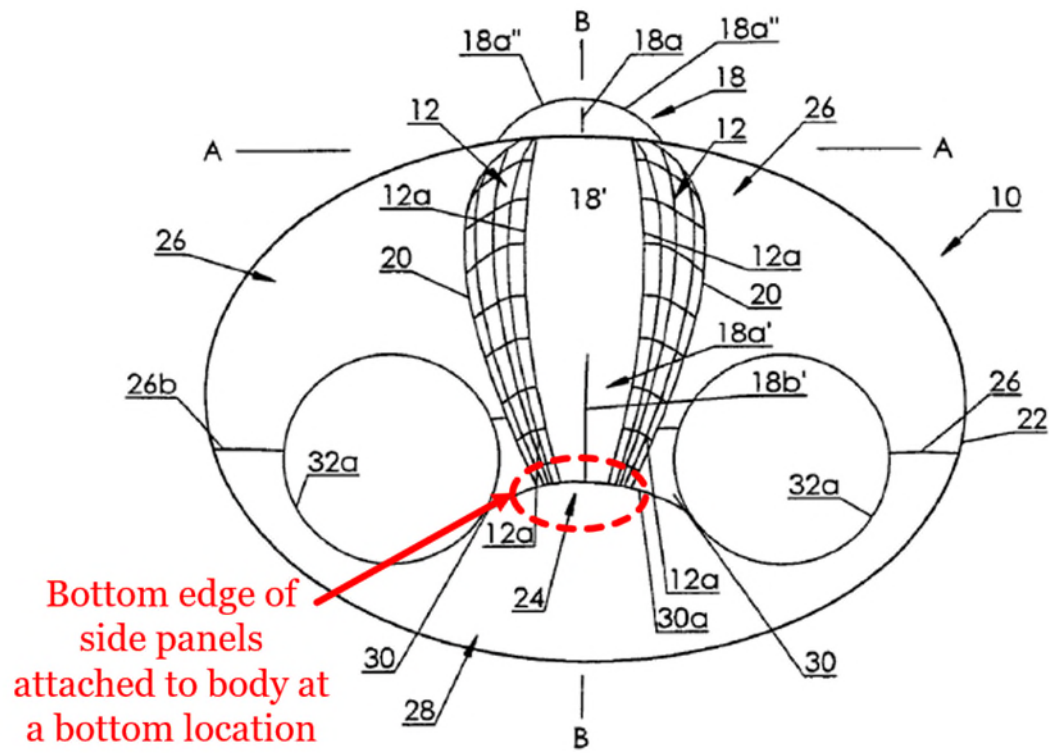
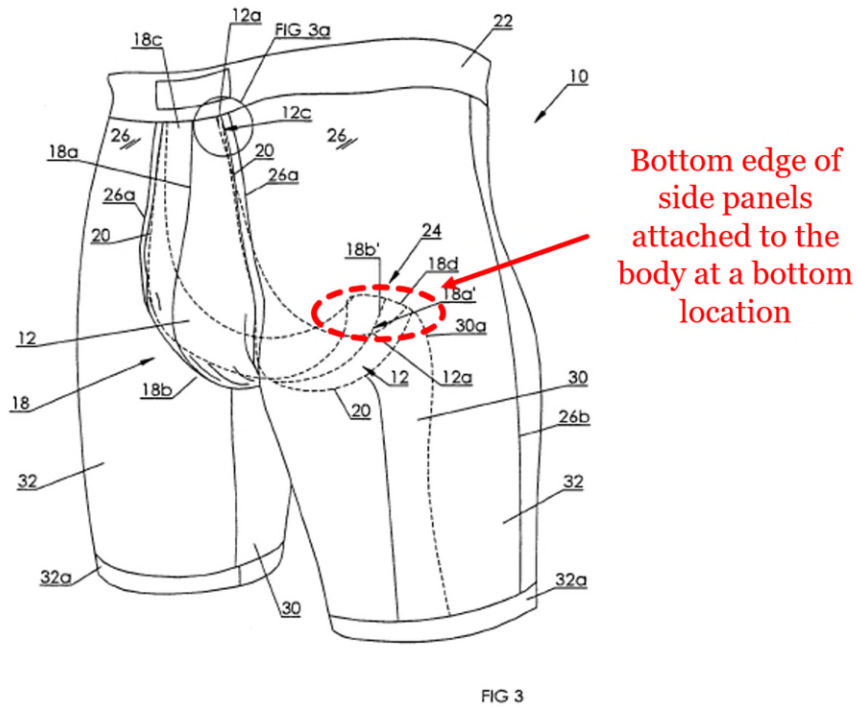


FIG 8

(Kitsch, Fig. 8 (annotated), [0008], [0041].) This can also be seen in Kitsch's Figure

3:



(*Id.*, Fig. 3 (annotated), Fig. 7; *see also* Wagner Decl., ¶57)

Third, Kitsch’s side panels have “side edges” attached to the body at side seams extending substantially continuously along either side of the front portion, as they have sides that attach to “laterally spaced apart pouch seams 20” (which may be coincident with seams 26a) connecting pouch material 18 to front walls 26:

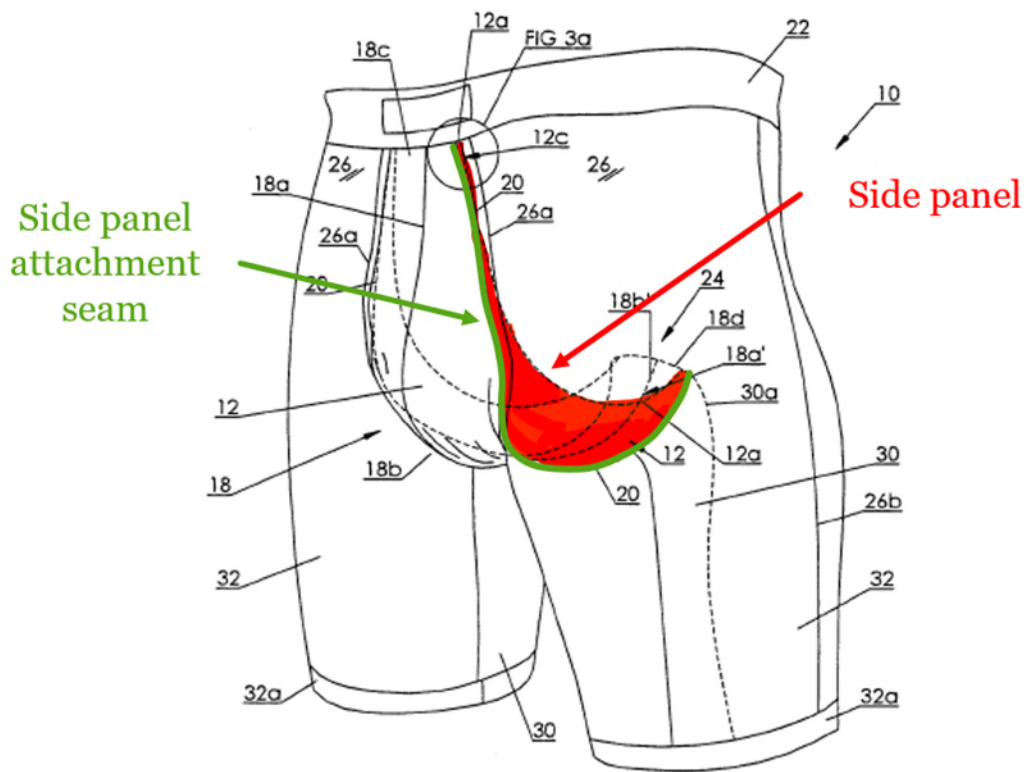


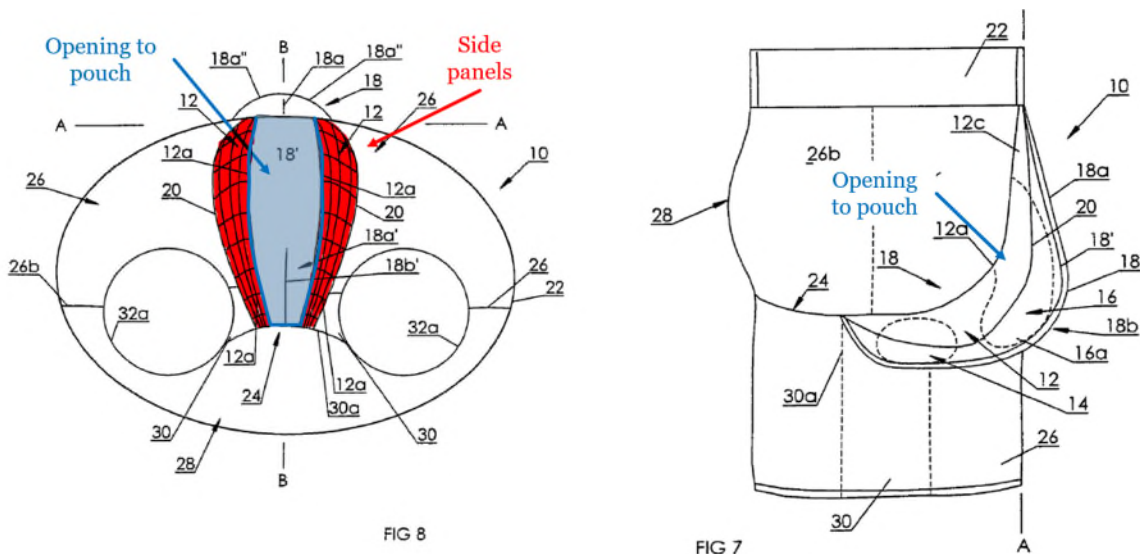
FIG 3

(*Id.*, Fig. 3 (annotated), [0027]-[0028], [0037]-[0039]; *see also* [0006]-[0009]; [0029], [0037].) As shown above, side seams 20/26a run continuously from around the perineum area (*i.e.*, near the bottom of the underwear), upwards along either side of pouch compartment 18, and attach around the waistband area (*i.e.*, near the top of the underwear). (*Id.*; *see also* Wagner Decl., ¶58.)

Fourth, Kitsch’s side panels include an “opening” for receiving a wearer’s genitals in “an anatomical pouch compartment[.]” (Kitsch, [0006].) In Kitsch, the side panels are “laterally spaced apart,” and the space between the panels forms an opening that receives the wearer’s genitalia to isolate “the genitalia, in particular

scrotum 14 and phallus 16... **into** pouch compartment 18, thereby isolating the genitalia from contacting the inner thigh and legs of the user 8 wearing the briefs.” (*Id.*, [0006]-[0009], [0026]-[0028].)

The opening for receiving the wearer’s genitals can be seen in Figures 7-8 of Kitsch:



(*Id.*, Figs. 7-8 (annotated), [0037]-[0039]; *see also* Fig. 3; Wagner Decl., ¶60.)

1[f]: *the stretch panel resiliently elastic both in a direction between the top edge and the bottom edge and in a direction between the side edges;*

Kitsch discloses Claim 1[f]. (*Id.*, ¶61.) Kitsch discloses its side panels (*e.g.*, “stretch panel”) are resiliently elastic in both a direction from top to bottom and side to side, as they are made from a nylon and spandex mesh knit in a four-by-four stretch weave. *See supra* Section VIII(A)(1) (Claim 1[d]-1[e]). (*See also* Kitsch, [0030].) For example, the four-by-four stretch weave allows the elasticized side panels to stretch up and down, between the top edge near the waistband and the

bottom edge near the perineum, and to stretch left and right, in a direction between the two side seams 20/26a. (*Id.*, [0029]-[0030]; *see also* [0006]-[0009], [0026]-[0030], cls. 5-6; Wagner Decl., ¶61.)

Moreover, Kitsch explains the “flexibility and elasticity of the mesh side panel material” allows it to “mould to gently conform to the shape of the scrotum 14 in particular and allow for resiliently supported relative movement of the scrotum relative to the pubis and perineum 24 of user 8, side panels 12 resiliently cradling and biasing the scrotum back into its naturally resting position.” (Kitsch., [0029].) With the side panels “resiliently” supporting, cradling, and biasing the scrotum, they are resiliently elastic in a direction between the top waistband location and bottom perineum area location, and between the two side seams 20, to react to the relative movement of the scrotum. (Wagner Decl., ¶62.) *See also supra* Section VIII(A)(1) Claim 1[c].

1[g]: the stretch panel having a length when unstretched smaller than a length measured along the front portion between the top and bottom locations and a width when unstretched smaller than a width measured along the front portion between the side seams such that front portion is gathered by the stretch panel and defines a three-dimensional pouch between the stretch panel and the front portion for receiving the wearer’s genitals and holding the wearer’s genitals while the garment is being worn.

Kitsch in view of Brocks renders obvious Claim 1[g]. (Wagner Decl., ¶63.) Kitsch discloses its side panels provide a pouch, formed between the panels and the front portion of the body, for receiving and supporting the wearer’s genitalia. *See*

supra Section VIII(A)(1) (Claims 1[a], 1[c], 1[e]). Kitsch further discloses the side panels are made from an **elasticized** breathable mesh knit weave and, thus, are stretchable.⁴ *See supra* Section VIII(A)(1) (Claim 1[c], 1[f]).

Brocks, in the same field as Kitsch, discloses a male undergarment brief that includes a “defined genital pouch.” (Brocks, Abstract.) Brocks’s underwear includes a “trunk or rear portion 4,” a “waist band 6,” “leg bands 7 and 11,” and a “front panel insert 12” defining a genital pouch:

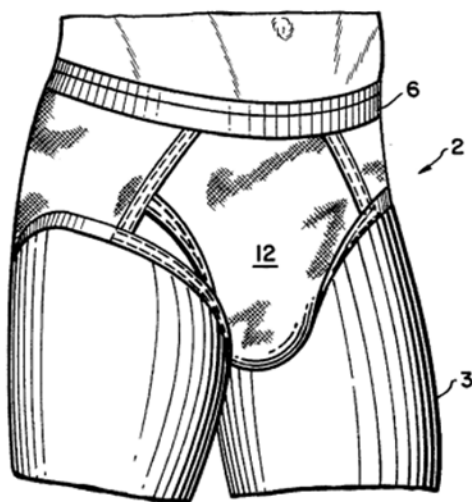


FIG. 1

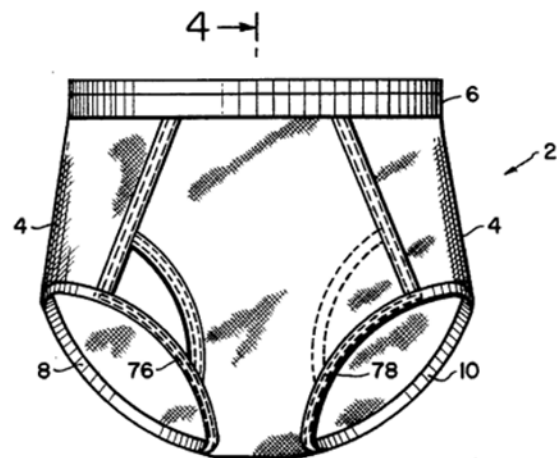


FIG. 2

⁴ When Kitsch’s elasticized material is stretched lengthwise, its length would increase, and when stretched widthwise, its width would increase. (Wagner Decl., ¶63.)

(Brocks, Figs. 1-2, 2:49-64, 4:2-14; *see also* Figs. 4-5.) Brock's two-layer "front panel insert 12," like that of Kitsch, is formed of an inner panel and an outer panel. (*Id.*, 2:60-3:27.)

Additionally, Brocks teaches its genital pouch is formed by attaching elastic strips to front fabric panels ***while in a stretched state***, such that when the strips contract a "shirring takes place on the panels forming a genital pouch." (*Id.*, 2:5-21, 3:23-4:14.) Brocks discloses the elastic material used to form the pouch can be attached in a stretch state (that is, the elastic in its unstretched state is smaller than when it is being attached), so as to "gather" fabric of the front portion and cause it to bunch and form the pouch. (*Id.*, 2:5-21 ("In assembling, the elastic strips are each stretched to the length of each of the concave leg opening arches of the front panel, causing the stitched material ***to be gathered together*** and thereby define a genital pouch in the form of shirring when the stretching force is released.") (emphasis added), 3:28-4:14 ("The elastic 78 in its ***non-stretched condition is approximately two thirds*** of the length of the leg opening arches running between point 56 of the underlying panel 16 and point 34 of the overlying panel 14, along the right leg opening, and similarly, the ***elastic 78 is stitched in its stretched condition*** along the arch 28 running between point 26 of under panel 16 and point 30 of the overlying panel 14... The elastic strips create a **gathering** and shirring forming a secure

enclosure pouch for the male genitals as generally indicated in FIGS. 1 and 3.”) (emphasis added); *see also* Wagner Decl., ¶¶65-66.)

As shown by the arrows in Brocks’s Figure 8, the elastic strips are stretched in a lengthwise and widthwise direction, as they are pulled upward and outward from the bottom corners 30 and 34 of the “outer panel 14” of the front panel 12 towards the outer edges 26 and 56,⁵ with the unstretched length and width of the strips being smaller than the length and width measured along the seams after attachment in a stretched state (as indicated by the dotted lines in Figure 9, showing strips in a stretched state when being attached):

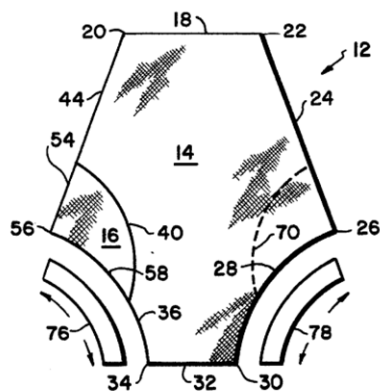


FIG.8

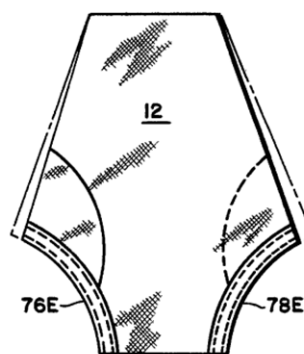


FIG.9

(Brocks, Figs. 8-9, 3:27-4:14; Wagner Decl., ¶67.)

⁵ The '974 Patent shows similar stretching in length and width as Brocks, illustrating in Figure 9, for example, how the stretch panel is stretched upwardly and outwardly. ('974, Fig. 9; Wagner Decl., ¶67.)

It would have been obvious to a POSITA to modify Kitsch to stitch Kitsch's elasticized side panels to front panel 18 in a stretched condition, as taught by Brocks, in order to create a “***gathering*** and shirring ***forming a secure*** enclosure ***pouch*** for the male genitals.” (Brocks, 3:27-4:14 (emphasis added); Wagner Decl., ¶68.) Kitsch's side panels are elastic, like the elastic strips in Brocks, and could be similarly stretched before being attached at seams 20. (Wagner Decl., ¶68.) Further, like the elastic strips in Brocks, Kitsch's side panels are joined with a front panel along seams to create a pouch to support and enclose the wearer's genitals, and attaching them in a stretched state would help further define the pouch with sufficient volume for the genitals. (Kitsch, [0006]-[0009], [0026]-[0030], [0037]-[0039].)

A POSITA would have recognized that, as taught by Brocks, when the elastic side panels of Kitsch are stitched to the seams in a stretched state, they would contract after being sewn and would assist in creating a “gathering” of the front panel fabric to which they are attached, helping to form or define the supportive genital pouch. (Wagner Decl., ¶69.) Such modification would not require any additional materials, Kitsch already discloses its side panels are elasticized material, and attaching this same material to seams in a stretched state would allow the panels to continue to perform their same functions of cupping the genitals, inhibiting skin to skin contact, and wicking moisture, while further aiding gathering of fabric to create the supportive pouch. (*Id.*)

A POSITA would have been motivated to modify Kitsch, as taught by Brocks, to attach the side panels along seams when in a stretched state, stretching them upwards and outwards (*e.g.*, in a lengthwise and widthwise direction), to help form the pouch. (*Id.*, ¶70.) Kitsch already teaches its side panels and pouch compartment fabric “cooperate” to form a pouch with cradle-like support that inhibits skin to skin contact. (Kitsch, [0037]-[0039].) Using Brocks’s teachings would further this cooperation in forming the pouch, as attaching side panels in a stretched state and allowing them to contract would add to the formation and supportive nature of the pouch. (Wagner Decl., ¶70.)

A POSITA would have also understood that attaching the side panels in a stretched state, rather than an unstretched state, would merely be the simple substitution of one known method for another. (*Id.*, ¶71.) A POSITA would have known that elastic can be sewn to other fabrics in either a stretched or an unstretched state, and would have been motivated to try attaching in a stretched state (*e.g.*, as taught by Brocks) in order to obtain the benefits of the elastic material “gathering” the material to which it is attached to form the pouch. (*Id.*, ¶71.)

Thus, in sum, Kitsch as modified by Brocks discloses the front portion is gathered from side-to-side and top-to-bottom by the stretch panel and defines a three-dimensional pouch between the stretch panel and front portion for receiving and holding the wearer’s genitals. (*Id.*, ¶72.) That is, by stretching the elastic side

panels upwardly and outwardly before attaching along seams 20 to pouch compartment, the elastic side panels would gather pouch compartment from top to bottom and side to side to assist in creating the volume. (*Id.*) This pouch would continue to receive and hold a wearer's genital in a supportive manner while the garment is being worn. (Kitsch, [0031]-[0039]; *see also* [0006]-[0009], [0026]-[0027], [0029]-[0030]; Wagner Decl., ¶72.)

2. Dependent Claim 2

A male garment according to claim 1 wherein the stretch panel has asymmetrical stretch characteristics such that the stretch panel stretches more easily in a direction parallel to the waistband and less easily in a direction at right angles to the waistband.

Kitsch in view of Brocks renders obvious Claim 2. (Wagner Decl., ¶73.) Brocks discloses materials used in men's underwear have asymmetrical stretch characteristics, such that they stretch more easily laterally (*i.e.*, parallel to the waistband) and less easily longitudinally (*i.e.*, at right angles to the waistband). (Brocks, 1:23-32 (noting "[t]he usual material employed [in men's briefs] is a cotton knitted material ***having stretch along the lateral axis and having very little stretch along the longitudinal or the vertical axis.***") (emphasis added), 4:2-13.)

It would have been obvious to apply this teaching of using material with asymmetrical stretch to the stretch panel of Kitsch. (Wagner Decl., ¶¶74-76.) For example, when a user stretches the waistband to pull on the underwear, the stretch panel would need to stretch in that direction at least as much as the waistband and

body of the underwear, or else the underwear would risk tearing. (*Id.*) And, as taught by Brocks, the material for the stretch panel would not need to stretch as much in a direction perpendicular to the waistband, as the fabric of the underwear itself does not stretch as much in that direction and there is less of a risk of tearing. (*Id.*)

A POSITA would have been motivated to modify Kitsch, as taught by Brocks and generally known in the art, to construct Kitsch's four-by-four stretch weave side panels such that they have asymmetrical stretch characteristics and would stretch more easily in a direction parallel to the waistband than at right angles to the waistband. (*Id.*, ¶77.) Doing so would, for example, help accommodate forces placed on the underwear during normal use, and would have ensured the stretch panel would not prevent the body material from stretching to accommodate the wearer's body. (*Id.*)

Additionally, it would have been obvious to for Kitsch's elastic side to have asymmetric stretch such that they stretch more in a direction parallel to the waistband. (*Id.*, ¶78.) A POSITA would have known that elastic material, such Kitsch's, must have either symmetrical stretch (*e.g.*, stretches the same in all directions) or asymmetrical stretch (*e.g.*, stretches more in one direction than another). (*Id.*) A POSITA would have found it obvious to try asymmetrical stretch material, as it would have been only one of two known options and it would have accounted for needing more stretch in the direction of the waistband when the

underwear is opened up to be put on. (*Id.*) Further, this would have been a simple, well-known way to implement or construct the four-by-four stretch weave side panels disclosed in Kitsch, which would continue to function as before, only now the wearer could stretch the underwear more in the lateral direction. (*Id.*)

3. Dependent Claim 3

A male garment according to claim 1 wherein the stretch panel is rectangular and the opening is U-shaped.

Kitsch in view of Brocks renders obvious Claim 4. (*Id.*, ¶¶79-80.) The '974 indicates that its stretch panel 22 can be “generally rectangular,” with a U-shaped opening, as shown, for example, in Figures 3 and 9. ('974, 4:47-48, Figures 3, 9.) Kitsch’s side panels 12 (*e.g.*, “stretch panel”) form a similar rectangular shape, with substantially parallel sides and top and bottom edges:

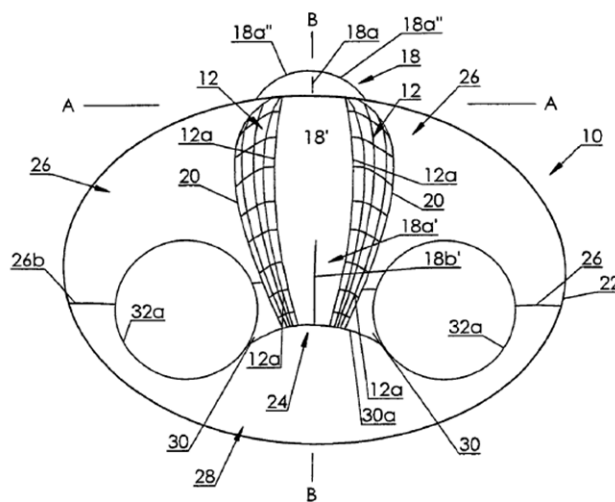
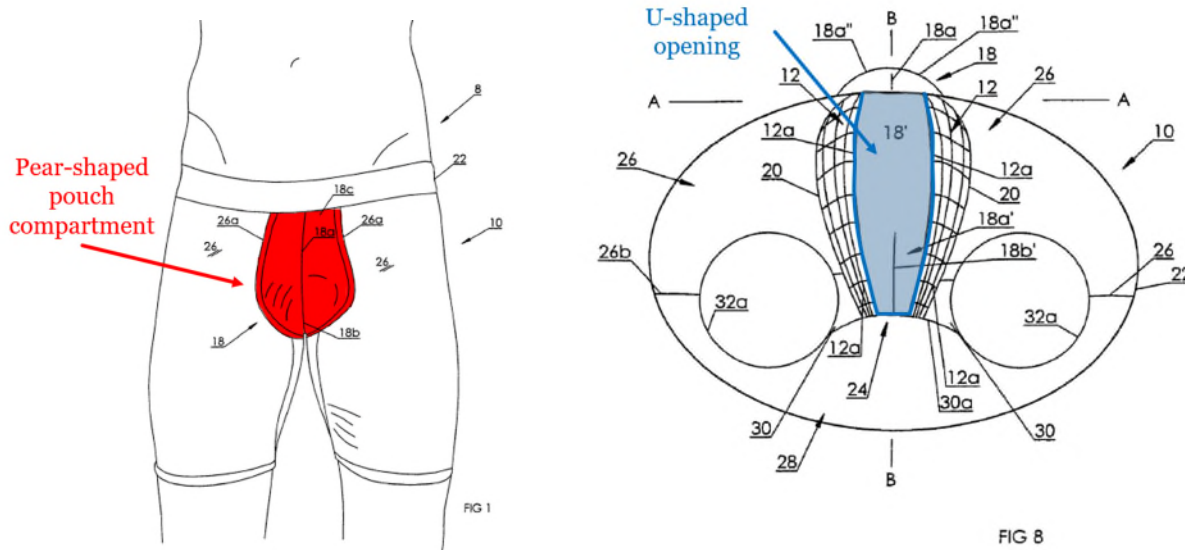


FIG 8

(Kitsch, Fig. 8; [0026]-[0028].) Moreover, the opening between side panels 12 is generally U-shaped, following the shape of front panel 18 along seams 26a that attach side panels 12 to “pear-shaped” pouch compartment 18:



(*Id.*, Figs. 1, 8 (annotated); see also Figs. 2-3, [0029], [0036]-[0039].)

4. Dependent Claim 4

A male garment according to claim 3 wherein the stretch panel comprises a fabric having a stretch of at least 30%.

Kitsch in view of Brocks renders obvious Claim 4. (Wagner Decl., ¶81.) As explained, it would have been obvious to modify Kitsch to attach elastic stretch panels 12 to front portion 18 in a ***stretched position***, as taught by Brocks, in order to, for example, gather fabric to form the supporting pouch. See *supra* Section VIII(A)(1) Claim 1[g].

Brocks further discloses that the elastic strips “in their unstretched condition are approximately two-thirds the length of each leg opening arch of the front panel.

In assembling, the elastic strips are each stretched to the length of the concave leg opening arches of the front panel, causing the stitched material to be gathered together and thereby define a genital pouch[.]” (Brocks, 2:5-13, Abstract, 3:24-4:14.) That is, the stretched length of the elastic strips in Brocks is 50% greater than the unstretched length (*i.e.*, $(100-66.\bar{6})/66.\bar{6} = 50\%$), indicating the elastic fabric can stretch by at least 30%. (’974, 5:28-45; Wagner Decl., ¶82.)

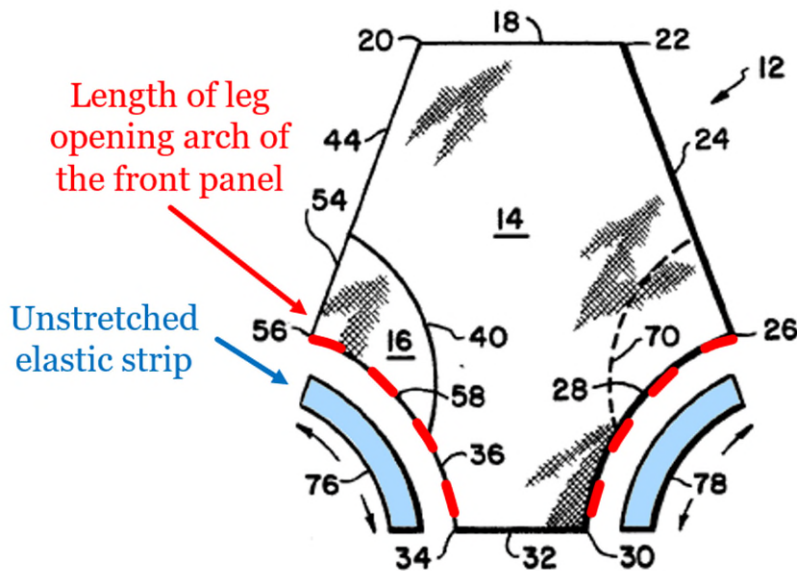


FIG. 8

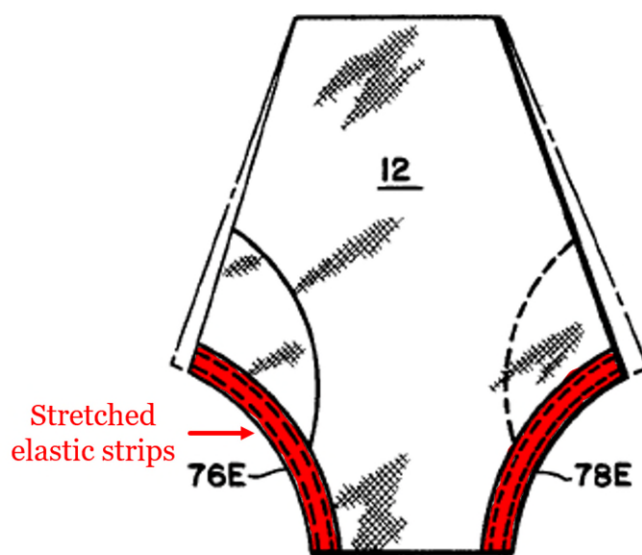


FIG.9

(Brocks, Figs. 8-9 (annotated).)

It would have been obvious to use a stretch panel having at least 30% stretch, as taught by Brocks, for the same reasons as set forth above. *See supra* Section VIII(A)(1) (Claim 1[g]). In addition, to ensure the elasticized side panels have sufficient elasticity to gather the fabric, a POSITA would have been motivated to use material with at least 30% stretch. (Brocks, 2:5-16, 3:23-4:14.) If the material did not have enough stretch, it be unable to “gather” enough fabric when released from the stretched state to an unstretched state to create a pouch with sufficient volume. (Wagner Decl., ¶83.)

5. Dependent Claim 5

A male garment according to claim 1 wherein the top location is the waistband seam and the bottom location is the first seam, and a length measured along

material of the front portion from the first seam to the waistband seam exceeds a length measured along the fabric of the stretch panel, when unstretched, by at least 30%.

Kitsch in view of Brocks renders obvious Claim 5. (*Id.*, ¶84.)

First, Kitsch discloses the top location of the body (to which the side panels attach) is the waistband seam, as the “upper ends 12c of side panels 12” are “stitched to the front walls 26 and **waistband 22 of brief 10.**” (Kitsch, [0029] (emphasis added), [0008]-[0010], [0036], Figs. 1-3, 7.) Similarly, Kitsch discloses the bottom location is at a “first seam,” as the bottom edge of the side panels are attached to seam 30a (located at the “rearmost end of pouch compartment 18”) around the perineum area 24, as shown, for example, in Figure 8:

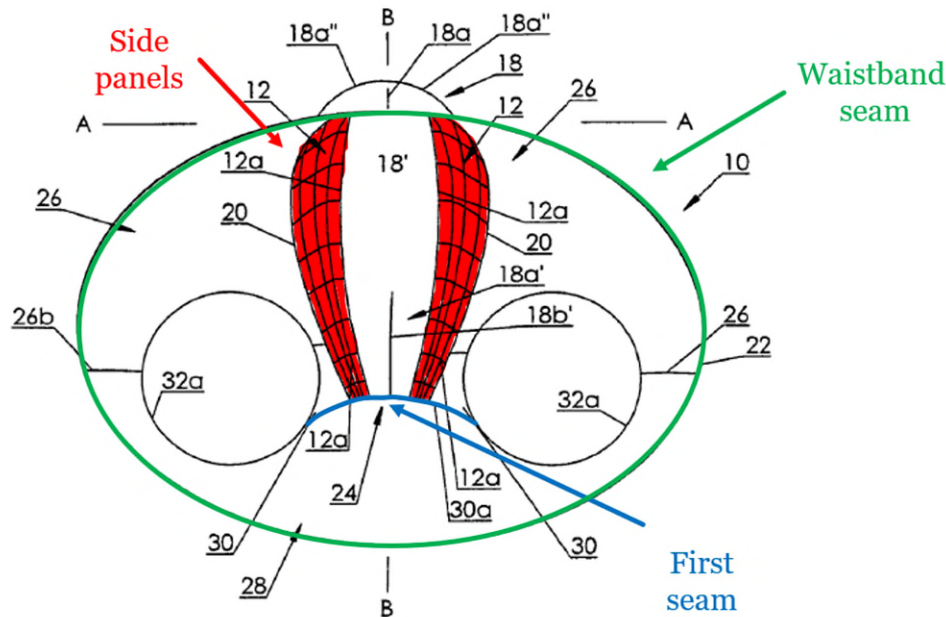


FIG 8

(Kitsch, Fig. 8 (annotated), Figs. 3, 7, [0028] (“side panels 12 thus separate the scrotum 14 from contacting the inner thighs and legs of the user, such separation extending from the waistband 22 to the perineum area 24 which extends under the buttocks of user.”), [0041].) *See also supra* Section VIII(A)(1) (Claim 1[e]).

Second, a POSITA would have understood the undergarment of Kitsch, as modified by Brocks, would have a length, as measured along the front portion material from the first seam to the waistband seam, exceeding a length measured along the fabric of the stretch panel, when unstretched, by at least 30%. *See supra* Section VIII(A)(1), (4) (Claims 1[g], 4). That is, because the unstretched length of each strip in Brocks is only 66% of the length of the front portion fabric to which it is attached in the stretched condition, a length measured along the front portion fabric is at least 30% greater than the length of each unstretched strip. (Brocks, 2:5-16, 3:24-4:14, Figs. 8-9; Wagner Decl., ¶87.)

For the reasons set forth above, it would have been obvious to modify Kitsch in view of Brocks to use elastic material stretched by at least 30% when attached to the front portion, pouch compartment 18, such that its elastic side panels gather the front portion into a pouch with sufficient volume. *See supra* Section VIII(A)(1), (4) (Claims 1[g], 4). Incorporating this teaching into Kitsch to form the pouch would result in side panels whose length unstretched is at least 30% less than the length of

a measurement along the material of the front portion to which side panels are attached in their stretched state. (Wagner Decl., ¶88.)

6. Dependent Claim 6

A male garment according to claim 1 wherein the garment is a pair of undershorts.

Kitsch in view of Brocks renders obvious Claim 6. (*Id.*, ¶89.) Kitsch's garment is "an underwear garment for use by a male." (Kitsch, Abstract, [0002], [0006]-[0007].)

7. Dependent Claim 7

A male garment according to claim 1 wherein the stretch panel comprises a fabric different from a fabric of the body.

Kitsch in view of Brocks renders obvious Claim 7. (Wagner Decl., ¶90.) Kitsch discloses, for example, that (a) the side panels forming the stretch panel may be made from material "containing 80% Nylon™ and 20% Spandex™" and (b) the body may be made of 82% polyester and 18% Spandex™, or a combination of 82% polyester/18% Spandex™ fabric and 92% cotton, 8% Spandex™ fabric. (Kitsch, [0025]-[0026].)

8. Dependent Claim 8

A male garment according to claim 1 wherein the opening has a width in excess of 2 cm.

Kitsch in view of Brocks renders obvious Claim 8. (Wagner Decl., ¶91.) Kitsch discloses and renders obvious the opening in the lateral spacing between the side panels 12 having a width in excess of 2 cm. (*Id.*) Kitsch depicts the opening in

Figures 3 and 8 as large enough to accommodate a phallus and scrotum into the pouch compartment, and in Figure 7 depicts a phallus and scrotum inserted into the opening of the pouch compartment. (Kitsch, Figs. 3, 7-8.) Moreover, Kitsch describes how the side panels receive and isolate the phallus and scrotum into the pouch compartment. (*Id.*, Abstract, [0006]-[0009], [0026]-[0027], [0036]-[0040].) A POSITA would thus have understood the opening between the side panels would have a width in excess of 2 cm. (Wagner Decl., ¶91.) If the opening were not at least 2 cm, a wearer would be unable to insert their genitals into the pouch. (*Id.*)⁶

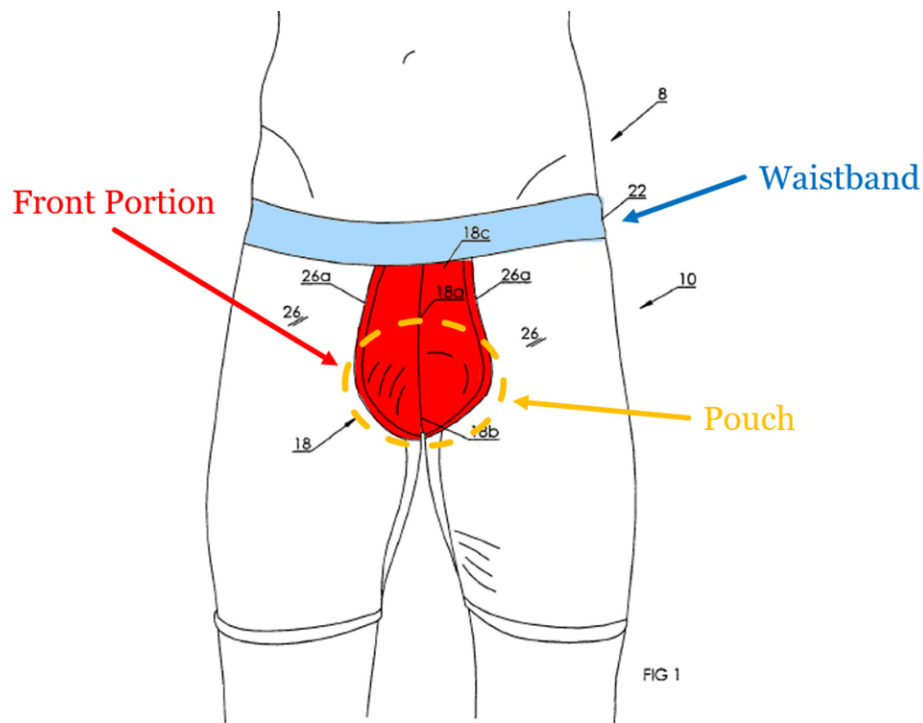
9. Dependent Claim 9

A male garment according to claim 1 wherein: [i] the front portion depends downwardly from the waistband and the front portion is formed to provide the pouch at a mid-section thereof; [ii] the stretch panel is positioned to be disposed forward of the wearer's perineum when the garment is worn, whereby, in use, a scrotum of the wearer of the garment is supported underneath by the stretch panel to contain the wearer's penis and scrotum in the pouch.

Kitsch in view of Brocks renders obvious Claim 9. (*Id.*, ¶92.)

First, Kitsch discloses the front portion of the body, “pouch compartment 18,” depends downwardly from the waistband, with the genital pouch compartment 18 being formed into a pouch at a mid-section of the body below the waistband:

⁶ For these same reasons, it would have been obvious to a POSITA when implementing or constructing Kitsch to make the opening wider than 2 cm. (Wagner Decl., ¶91.)



(Kitsch, Figure 1 (annotated), Abstract (describing a “genital pouch and a pair of side panels collectively formed in a mid-section of a front wall depending from a waistband”); *see also* [0007], [0029], Cl. 1.)

Second, Kitsch explains the side panels, forming the stretch panel, are positioned to be disposed forward of the wearer’s perineum when the garment is worn, as they form, “upwardly from adjacent the perineum[,] generally vertical extending scrotum fences towards the waistband. The side panels are spaced so as to snugly engage sides of the scrotum and to substantially completely cover over and support the sides of the scrotum.” (*Id.*, [0008]-[0009]; *see also* [0027]-[0028].) That is, as shown in Figure 3, side panels start adjacent the perineum area and are

positioned to be disposed forward of this area, as they are connected along seams 20/26a to the waistband at the top of the front portion of the garment:

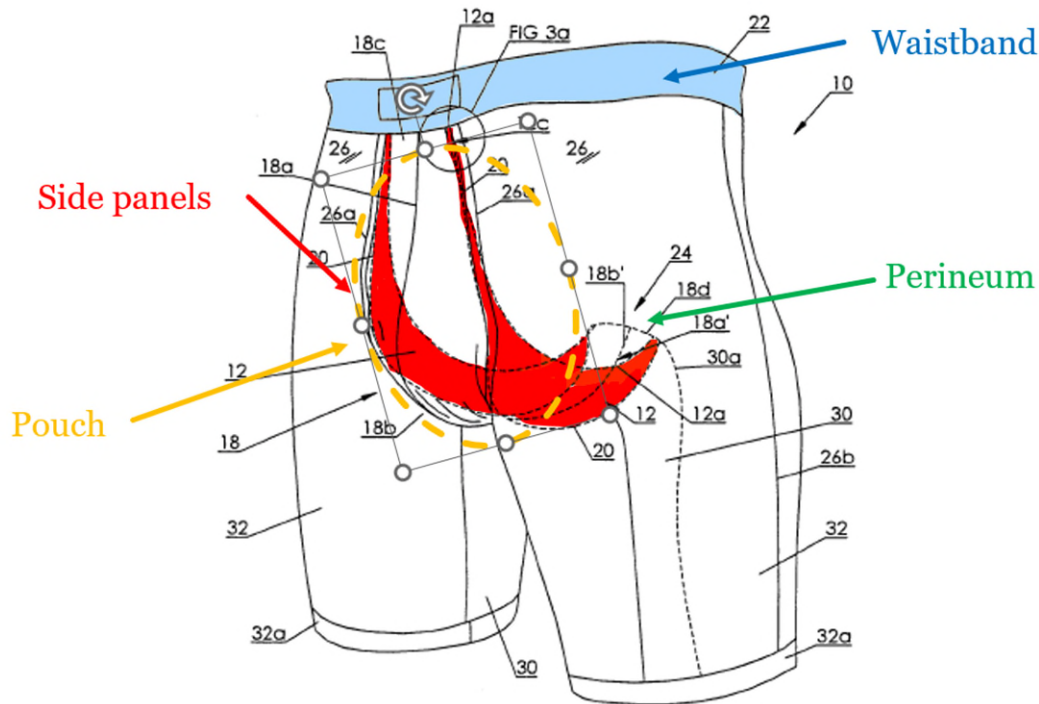


FIG 3

(*Id.*, Fig. 3 (annotated); *see also* Figs. 7-8.)

Kitsch further discloses that, with this configuration, the “pair of side panels 12 are preferably formed so as to cup the genitalia, that is, are formed so as to be cupped in laterally opposed facing relation to inhibit skin-to-skin contact between a user's thighs and scrotum,” and that they “resiliently cradl[e]” and bias the scrotum back to a natural resting position. (*Id.*, [0029]; *see also* Abstract, [0009], [0026]-[0031]-[0034], [0036]-[0041].) *See also supra* Section VIII(A)(1) (Claim 1[g]).

10. Dependent Claim 10

A male garment according to claim 1, wherein the elastically resilient four-way stretch material is comprised of a spandex blend.

Kitsch in view of Brocks renders obvious Claim 10. (Wagner Decl., ¶98.)

Kitsch discloses that side panel 12 elastically resilient four-way stretch material is a spandex blend “containing 80% Nylon™ and 20% Spandex™.” (Kitsch, [0030].)

See also supra Section VIII(A)(1) (Claim 1[c]).

11. Dependent Claim 11

A male garment according to claim 1, wherein the stretch panel is fastened to the front portion while in a pre-stretched condition while the front portion is less stretched, whereby the stretch panel is biased to hold the opening open while the garment is held in position to be put on.

Kitsch in view of Brocks renders obvious Claim 11. (Wagner Decl., ¶99.)

Kitsch, as modified by Brocks, includes a stretch panel (*e.g.*, side panels 12) fastened to a front portion 18 while in a pre-stretched condition, while the front portion is less stretched. *See supra* Section VIII(A)(1) (Claim 1[g]). Again, Brocks discloses stretching elastic material, which unstretched is shorter in length than the underwear front panel, and attaching the elastic material in a pre-stretched condition to an assembled front panel that is in a “less stretched” condition. *Id.* As is clear from Brocks, only the elastic material, and not the assembled front panel, is stretched when the elastic strips are stitched to the front panel. (Brocks, 1:64-2:16, 3:24-4:14; Wagner Decl., ¶¶100-101.) Thus, when attached and the stress force released, the

elastic causes the less stretched front portion material 18 to “be gathered together and thereby define a genital pouch,” as taught by Brocks. (Brocks, 2:5-21, 4:2-14.)

The elastic side panels, attached while stretched, would be biased to hold the opening open while the garment is held in position to be put on (*e.g.*, the stretched elastic side panels would maintain the lateral space between them that provides the opening into the pouch having sufficient volume to receive the genitals). (Wagner Decl., ¶102.) As shown in Kitch’s Figures 3 and 8, the stretched elastic side panels would be biased to hold the opening between them into the pouch open when a wearer puts the underwear on (*e.g.*, the stretch panels do not overlap each other or otherwise lay so they cover or block the opening into the pouch, but instead stretch and define the opening between them):

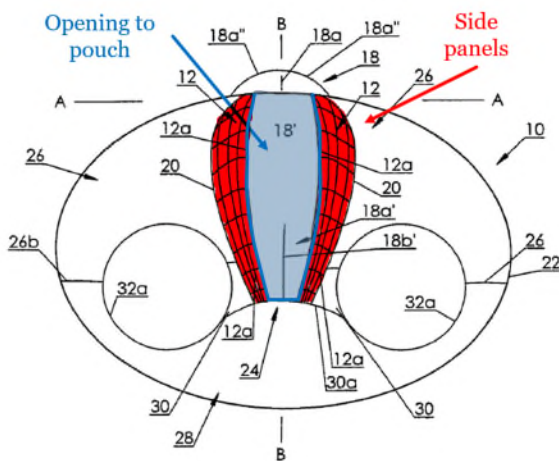


FIG 8

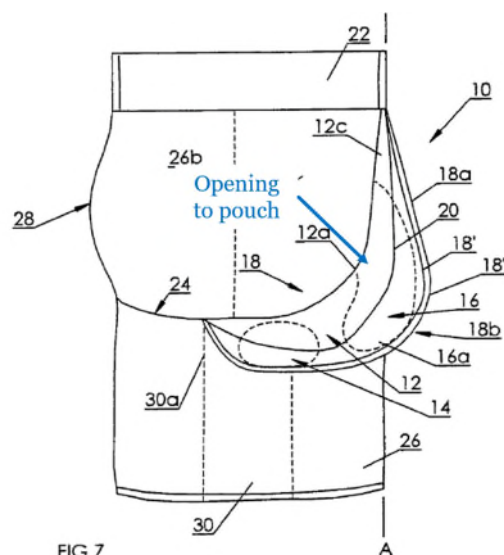


FIG 7

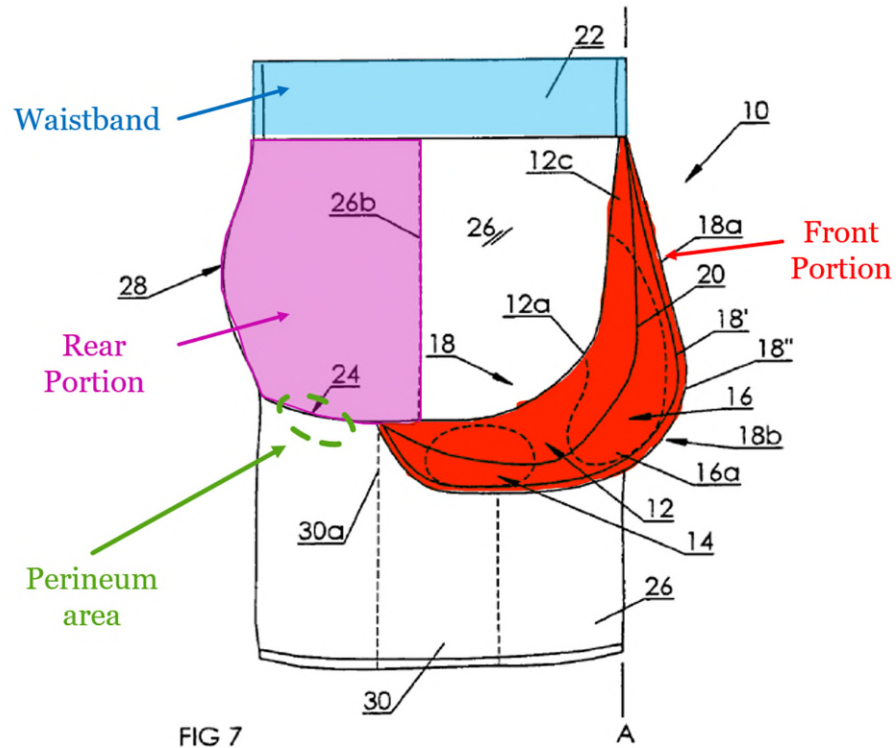
(*Id.*, Figs. 7-8 (annotated), [0026]-[0027] (noting the elasticized mesh side-panels 12 are added “for the purpose of isolating the genitalia, in particular scrotum 14 and phallus 16 (shown diagrammatically in dotted outline in FIG. 7), into the pouch compartment 18, thereby isolating the genitalia from contacting the inner thighs and legs of the user 8 wearing the briefs a user.”); *see also* [0037]-[0039], Fig. 3; Wagner Decl., ¶102.)

12. Dependent Claim 12

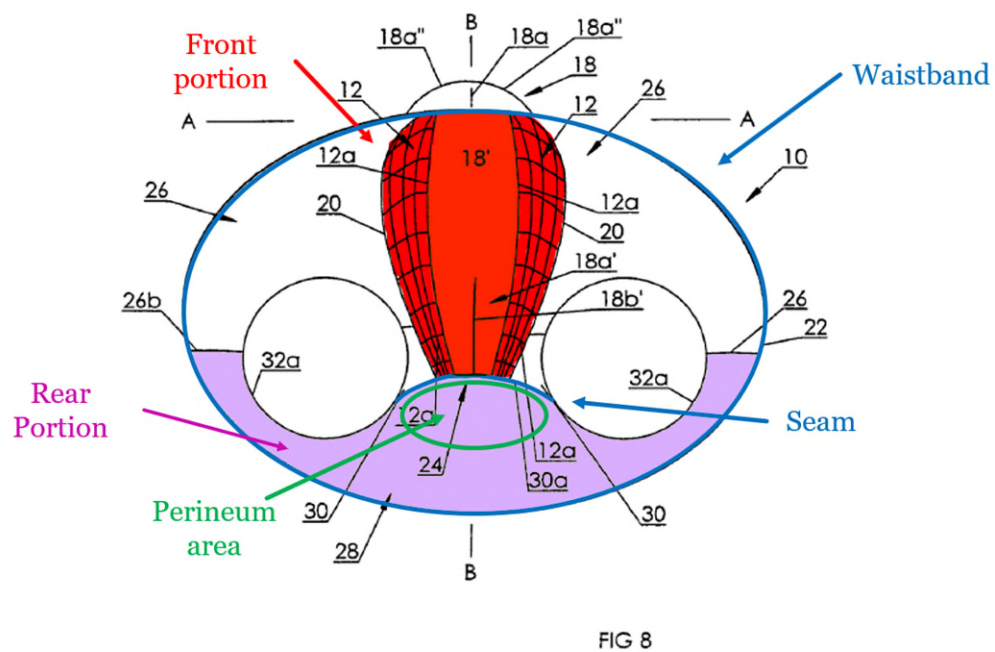
A male garment according to claim 11, wherein the front portion is attached to a rear portion of the body that depends from the waistband at a seam disposed forward of the perineum region of the wearer, and wherein a bottom edge of the stretch panel is fastened to the seam.

Kitsch in view of Brocks renders obvious Claim 11. (Wagner Decl., ¶103.)

Kitsch’s underwear includes a rear portion of the body, “rear panel 28,” that depends from the waistband 22:



(Kitsch, Fig. 7 (annotated), [0041].) The front portion, “pouch compartment 18,” is attached to “rear panel 28” at a seam 30a disposed forward of the perineum area 24:



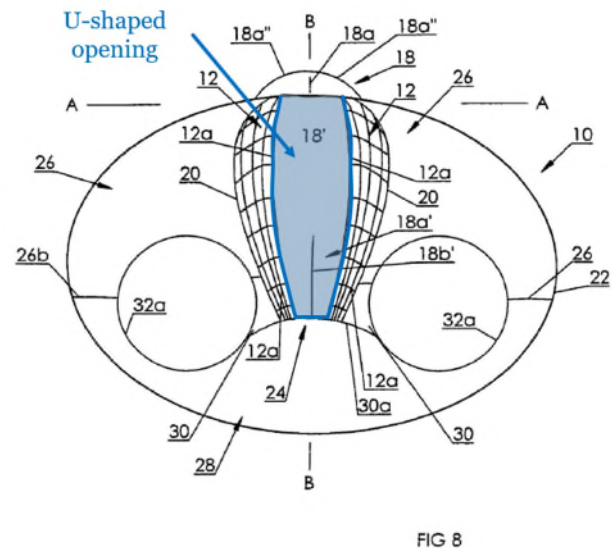
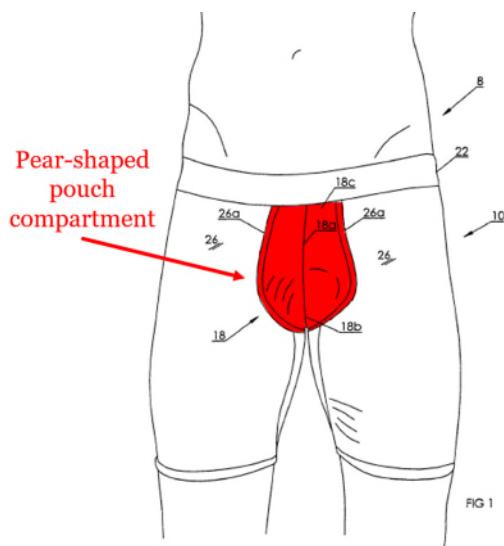
(*Id.*, Fig. 8 (annotated), [0041]; *see also* Figs. 3, 7 (annotated above), [0035]-[0040], Claim 1.) Further, Kitsch notes seam 30a is at “the rearmost end of pouch compartment 18,” where the pouch compartment joins the rear portion. (*Id.*, [0041], Fig. 8.) And, as shown in Figure 8, the bottom edge of side panels 12 (e.g., the bottom edge of the stretch panel) are fastened at the same seam 30a. (*Id.*, Fig. 8 (annotated); *see also* Figs. 3, 7, [0035]-[0041].) *See also supra* Section VIII(A)(1) (Claim 1[e][ii]).

13. Dependent Claim 13

A male garment according to claim 1 wherein the opening has a U-shape when the stretch panel is in a relaxed state.

Kitsch in view of Brocks renders obvious Claim 13. (Wagner Decl., ¶104.)

Again, the opening between side panels 12 into the pouch is generally U-shaped:



(*Id.*, Figs. 1, 8 (annotated), Fig. 3, [0029], [0036]-[0039].) *See also supra* Section VIII(A)(3) (Claim 3). The shape of the opening when the side panels are in a relaxed state (both before and after attachment) would be the same. (Wagner Decl., ¶104.)

14. Dependent Claim 15

A male garment according to claim 1 wherein the pouch comprises a dart seam stitched along a bottom portion of the pouch and centrally to provide extra volume in front of and underneath the genitals of the wearer.

Kitsch in view of Brocks renders obvious Claim 15. (Wagner Decl., ¶¶105-107.) Kitsch discloses that inner liner 18' of the pouch comprises a dart seam 18b' joining "a pair of divergent tails." (Kitsch, [0030], [0036], Figs. 3, 8-9.) Seam 18b' is stitched along a bottom portion of the pouch, and is centrally in the middle of the pouch compartment:

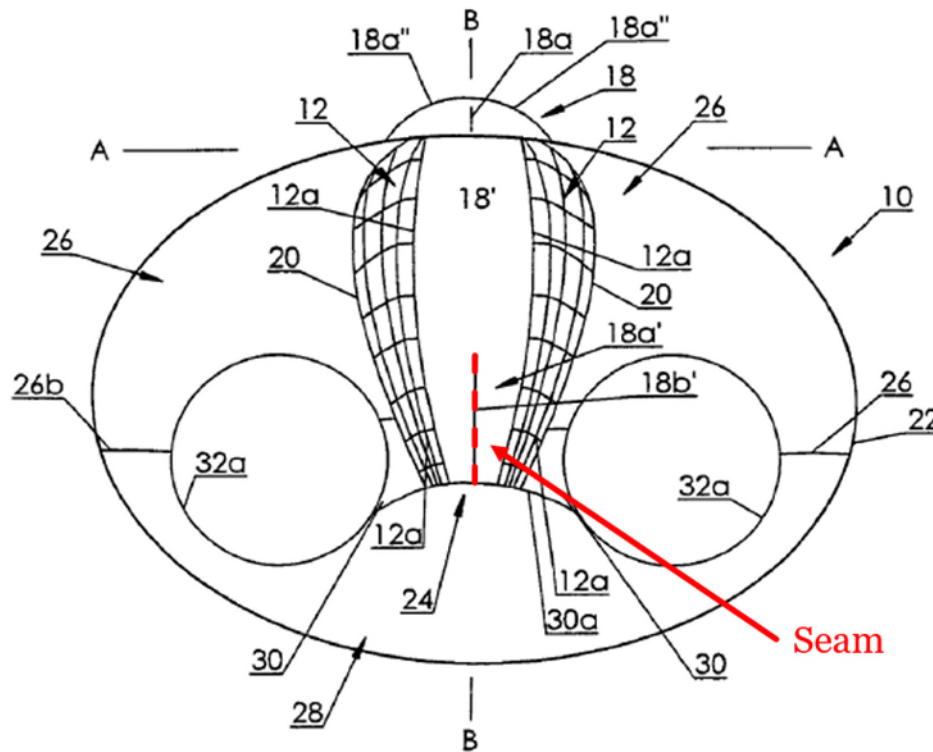


FIG 8

(*Id.*, Fig. 8 (annotated); see also Figs. 3, 9, [0030], [0036].) This seam creates extra volume in front of and underneath the wearer’s genitals, as it forms “a shelf-like tableau or plateau 18a’ cradling the underside of scrotum 14,” and, in combination with seams 26a, contributes to the pouch compartment’s pear shape creating “greater rear pouch volume.” (*Id.*, [0030]-[0036].)

15. Dependent Claim 16

A male garment according to claim 1 wherein the stretch panel is rectangular and the opening has a rounded bottom edge and opposing side edges that are spaced apart from one another on either side of the opening.

Kitsch in view of Brocks renders obvious Claim 16. (Wagner Decl., ¶108.)

Kitsch’s side panels 12 (*e.g.*, “stretch panel”) form a rectangular shape, with

substantially parallel, spaced apart opposing side edges on either side of the opening, a top edge, and a bottom edge along curved seam 30a:

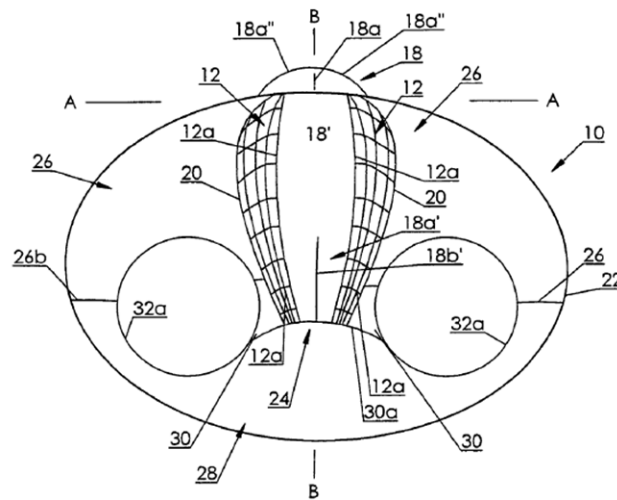


FIG 8

(Kitsch, Fig. 8, [0026]-[0028], Fig. 3.) *See also supra* Section VIII(A)(3) Claim 3.

The bottom of the opening between side panels 12 has a rounded bottom edge, following the curve of seam 30a:

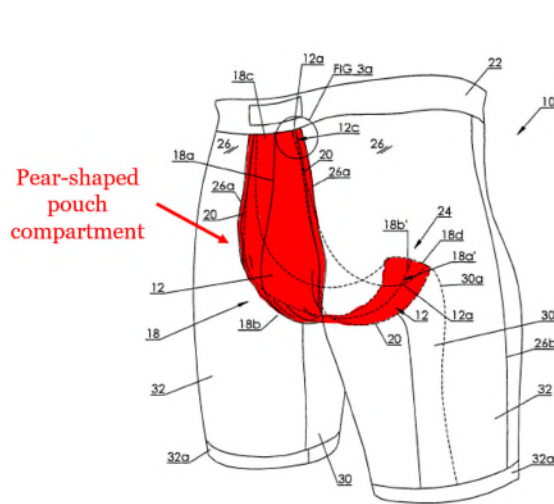


FIG 3

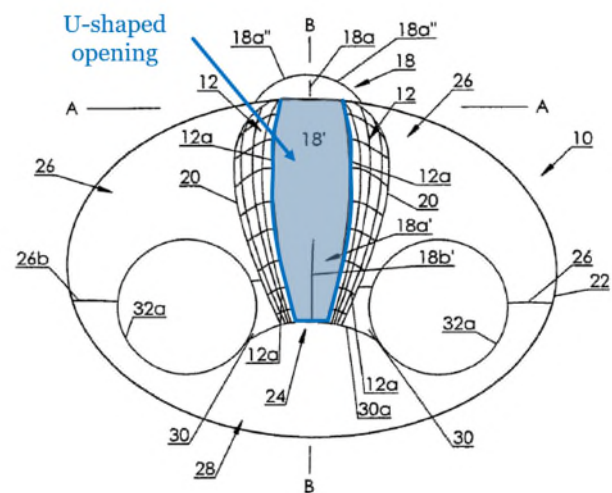


FIG 8

(*Id.*, Figs. 3, 8 (annotated); *see also* Figs. 2-3, [0029], [0036]-[0040].)

B. Ground 2a: Carrillo in View of Brocks Renders Obvious Claims 1-9, 11, 13, and 16

1. Independent Claim 1

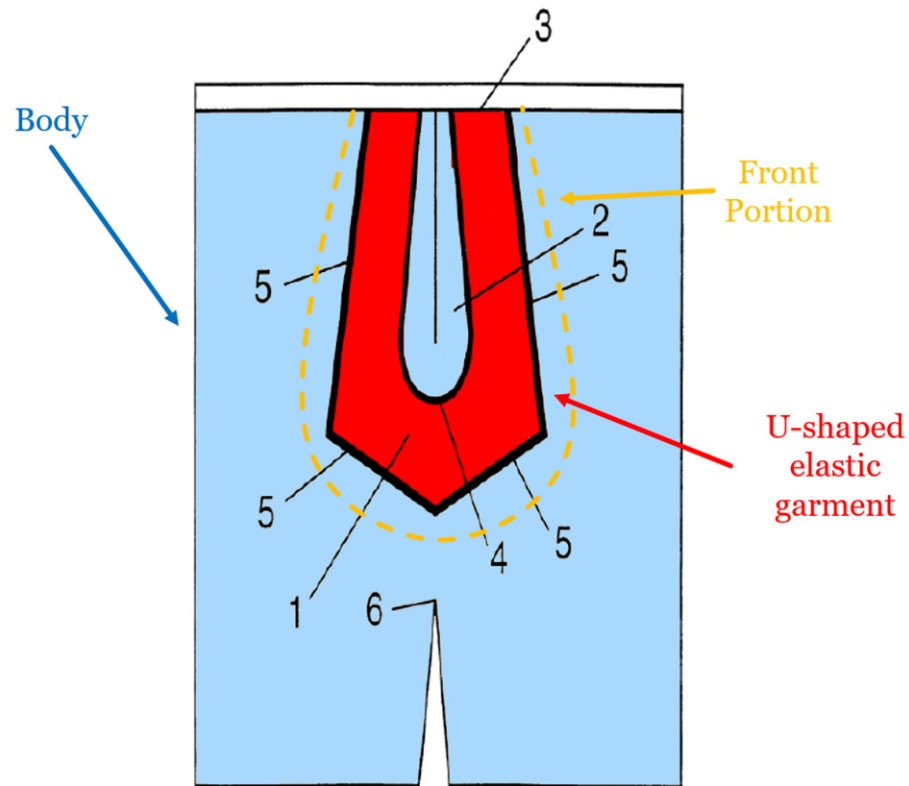
Carrillo in view of Brocks renders obvious Claim 1. (Wagner Decl., ¶113.)

1[pre]: A male garment comprising:

To the extent limiting, Carrillo discloses Claim 1[pre]. (*Id.*, ¶114.) Carrillo discloses underwear “made for men.” (Carrillo, Title, 1, 2; *see also* Abstract, 3.)

1[a]: a body including a front portion and having leg openings for a wearer’s legs;

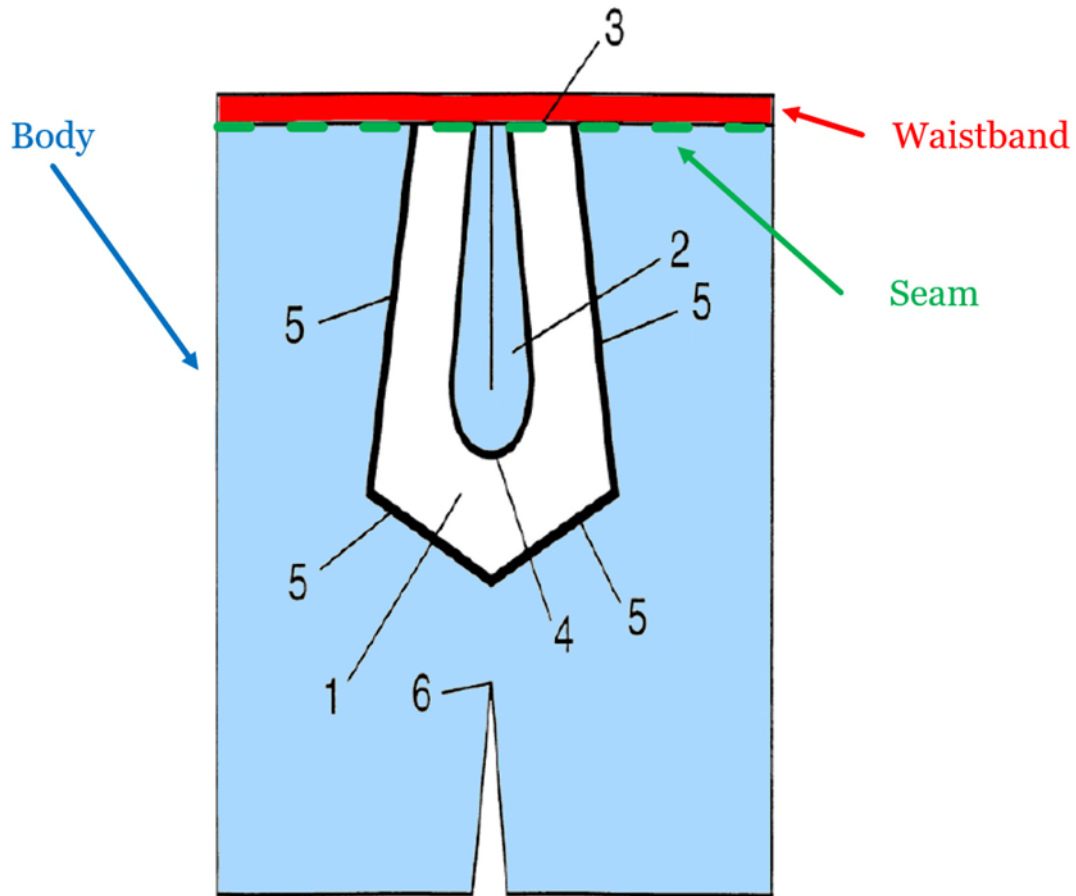
Carrillo discloses Claim 1[a]. (Wagner Decl., ¶115) Carrillo discloses a body of “classic underpants” such as “classic briefs.” (Carrillo, Abstract, 2; *see also* 1-3; Wagner Decl., ¶115.) The underwear body has a front portion, as it has an “inner front part of the underwear” to which an elastic garment 1 is sewn. (Carrillo, Abstract, 2-3.) The body further includes leg openings for the wearer’s legs. (Carrillo, Fig., Abstract, 1-3; Wagner Decl., ¶115.) The body of Carrillo’s underwear, including the front portion and leg openings, is shown below:



(Carrillo, Fig. (annotated), Abstract, 1-3.)

1[b]: a waistband attached by a waistband seam at an upper edge of the body;

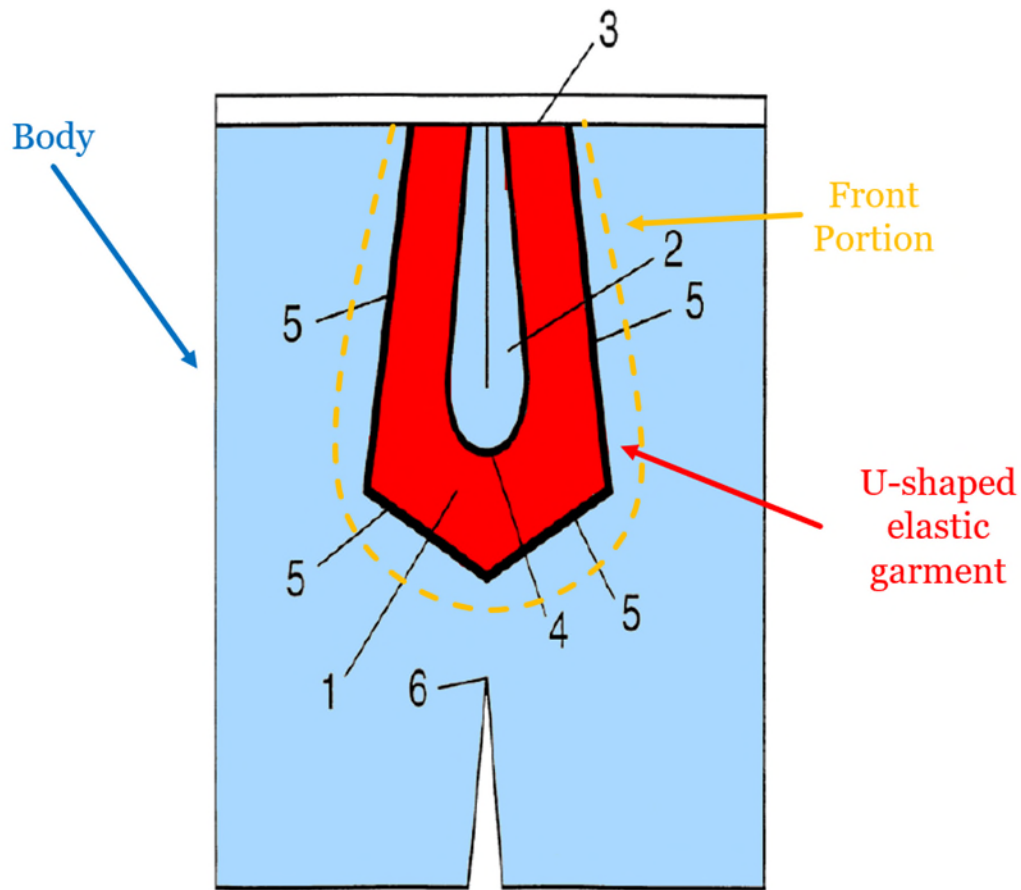
Carrillo discloses Claim 1[b]. (Wagner Decl., ¶116.) Carrillo discloses an elastic “waistband (3) of the brief,” and shows this waistband attached by a waistband seam at an upper edge of the underwear body:



(Carrillo, Fig. (annotated), Abstract, 2-3; *see also* Wagner Decl., ¶116.)

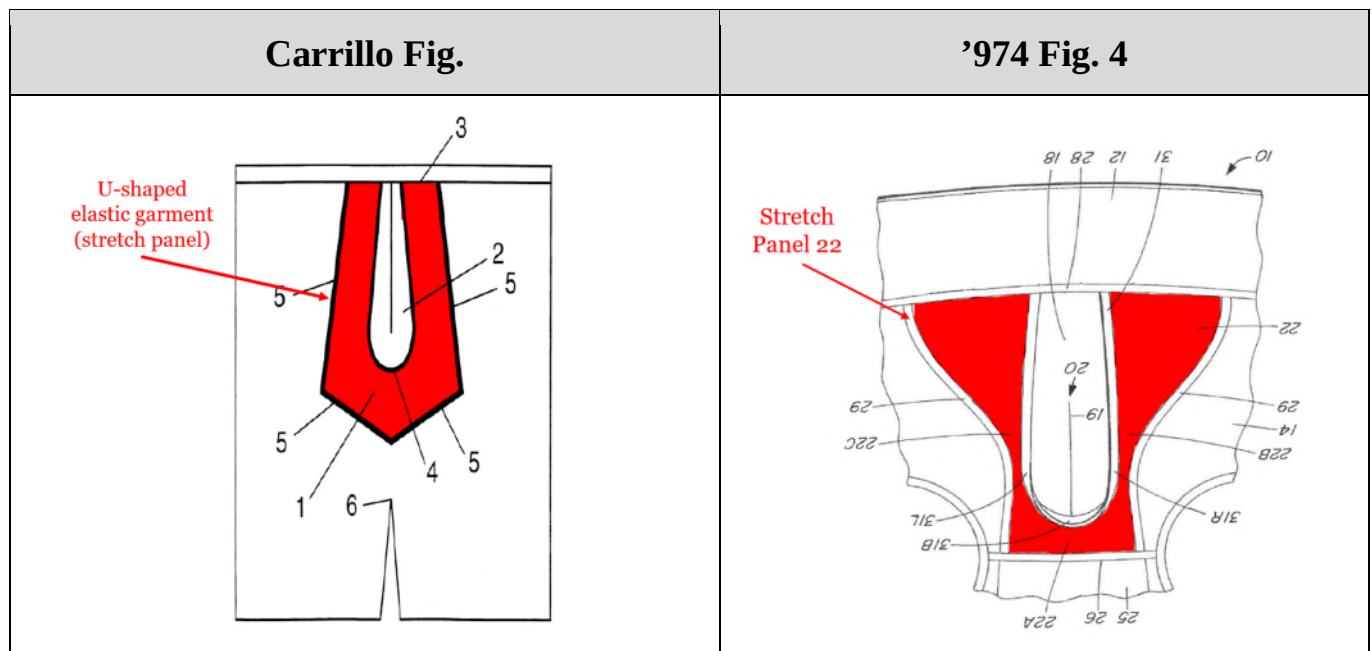
1[c]: a stretch panel attached to the body inside the front portion,

Carrillo discloses Claim 1[c]. (Wagner Decl., ¶117-118.) Carrillo discloses a stretch panel attached to the body inside the front portion, in the form of “a U-shaped elastic garment (1) sewn to the inner front part of the standard briefs[.]” (Carrillo, 2; *see also* Abstract, 3.)



(*Id.*, Fig. (annotated), 2-3.) The U-shaped elastic garment includes an “opening (2),” and “when sewn to the inner front part of the underwear,” gently pulls a wearer’s “intimate parts” forward through the opening to achieve “sufficient separation” and “reduce continuous direct contact and friction.” (*Id.*, 2-3.)

Carrillo’s U-shaped elastic stretch panel is strikingly similar to the ’974’s stretch panel:



(Compare Carrillo, Fig. (annotated) with '974, Fig. 4 (rotated and annotated).) See also *infra* Section VIII(B)(1) (Claim 1[d]).

1[d]: the stretch panel comprising a sheet of elastically resilient four-way stretch material...

Carrillo discloses and renders obvious Claim 1[d]. (Wagner Decl., ¶119-120.) Carrillo's stretch panel comprises a sheet of elastically resilient material, as the elastic garment is: described as being made of elastic material; "U-shaped"; shown as a single sheet of material; sewn to the front part of the underwear and attached to the elastic of the waistband; and provided to "gently pull [the intimate parts] forward." (Carrillo, 2, Fig.; see also Abstract, 3.)

A POSITA would have understood, both from Carrillo and the knowledge of a POSITA at the time of the alleged invention, that this elastic material is a "four way stretch" material. (Wagner Decl., ¶121.) Again, the U-shaped elastic garment is

“sewn to” the body and attached to the “elastic (3) of the waistband.” (Carrillo, (2-3.) A POSITA would have recognized that because the elastic garment is “sewn to” the front of the underwear, it would stretch in all directions (up and down, left and right) to accommodate wearers of different sizes and shapes, and the wearer’s movements. (Wagner Decl., ¶121.) For example, because the elastic garment is sewn to underwear that a user will stretch open at the waistband to put on, a POSITA would recognize it must stretch at least in the same direction as the waistband; otherwise, it would prevent the waistband from stretching when a wearer pulls on the underwear. (*Id.*, ¶¶121-122) If the elastic did not stretch in this direction, it could potentially prevent the waistband from opening enough for the underwear to be put on, and could cause uncomfortable and detrimental bunching of the waistband where it is attached to the elastic garment. (*Id.*) Similarly, a POSITA would have understood the elastic material would have at least some stretch in a direction perpendicular to the waistband, such that it would not cause the underwear to rip or bunch as the front material stretches or is put under tension as the wearer moves. (*Id.*)

Moreover, a POSITA would have understood that for Carrillo’s “elastic garment” to achieve its purposes of providing sufficient separation between the testicles and groin, reducing direct contact and friction, and helping with perspiration (Carrillo, 1-3), it would have four-way stretch. (Wagner Decl., ¶123.) If it were just

two-way stretch material, it could pinch the “intimate parts” in the opening rather than gently pull them forward as intended. (Carrillo, 2; Wagner Decl., ¶123.)

Additionally, it would have been obvious to a POSITA for the “U-shaped elastic garment” to be made of four-way elastic material (that is, to be able to stretch both up and down and left and right). (Wagner Decl., ¶124) A POSITA would have known that elastic material can either be “four-way” stretch or “two-way” stretch material (stretch left and right but not up and down, or vice versa). (*Id.*) A POSITA would have therefore found it obvious to try four-way stretch material, as it would have been only one of two known options. (*Id.*)

A POSITA would have been motivated to use four-way stretch material to provide greater flexibility in all directions, so the elastic garment could more easily move and adjust with the underwear as a wearer moves. (*Id.*, ¶125) Further, using four-way stretch material would have provided the benefit of not causing the front part of the underwear to which the U-shaped garment is attached from bunching or tearing, as the four-way stretch material could accommodate movements and fabric shifts in all directions. (*Id.*)

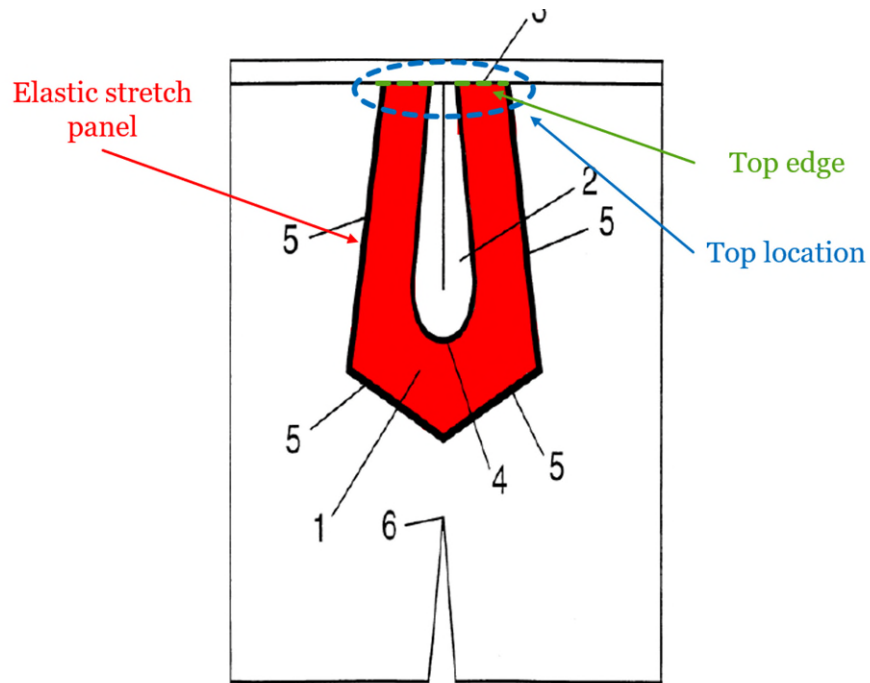
A POSITA would have had a reasonable expectation of success in using four-way stretch material for the elastic garment, as four-way stretch materials, like Nylon-Spandex and polyester-Spandex blends, were well-known and commonly used in men’s underwear at the time for their moisture-wicking abilities,

breathability, and comfort. (*Id.*) Because the U-shaped elastic garment is intended to address the problem of “very little ventilation and a lot of humidity” by “eliminat[ing] direct contact between the testicles and the groin, avoiding continuous friction or poor positioning of the testicles between the legs, substantially improving the perspiration of the area” (Carrillo, 1), a POSITA would have had a reasonable expectation of success that using four-way stretch material would accomplish this. (Wagner Decl., ¶126.)

1[e]: ...[i] having a top edge attached to the body at a top location, [ii] a bottom edge attached to the body at a bottom location, [iii] side edges attached to the body at side seams extending substantially continuously along either side of the front portion and [iv] an opening for receiving a wearer’s genitals;

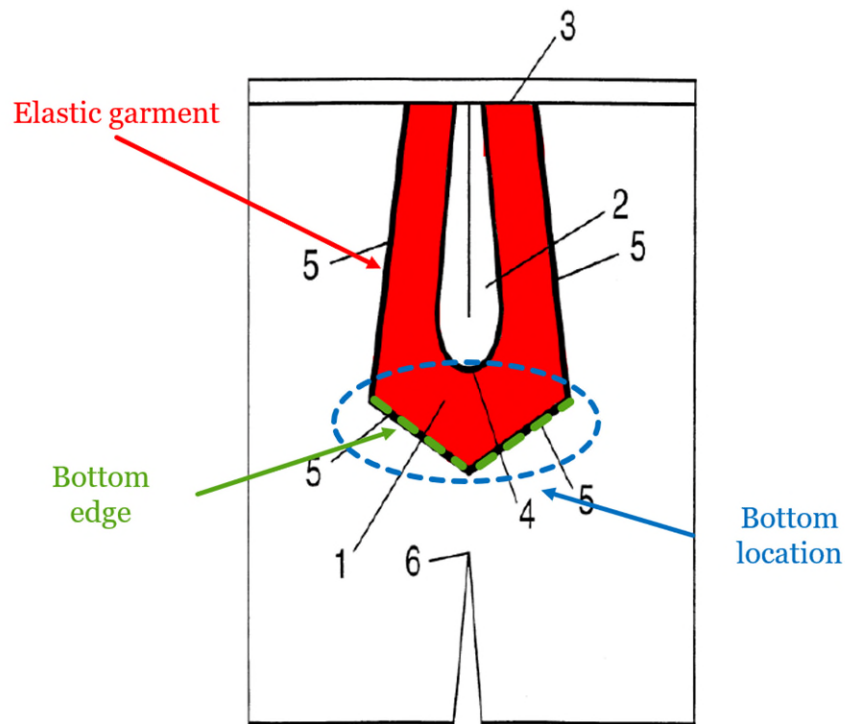
Carrillo discloses Claim 1[e]. (Wagner Decl., ¶127.)

First, Carrillo’s stretch panel has a top edge attached to the body at a top location (*e.g.*, at or near the waistband), as it is “sewn to the inner front” of the underwear with its top edge connected at the waistband:



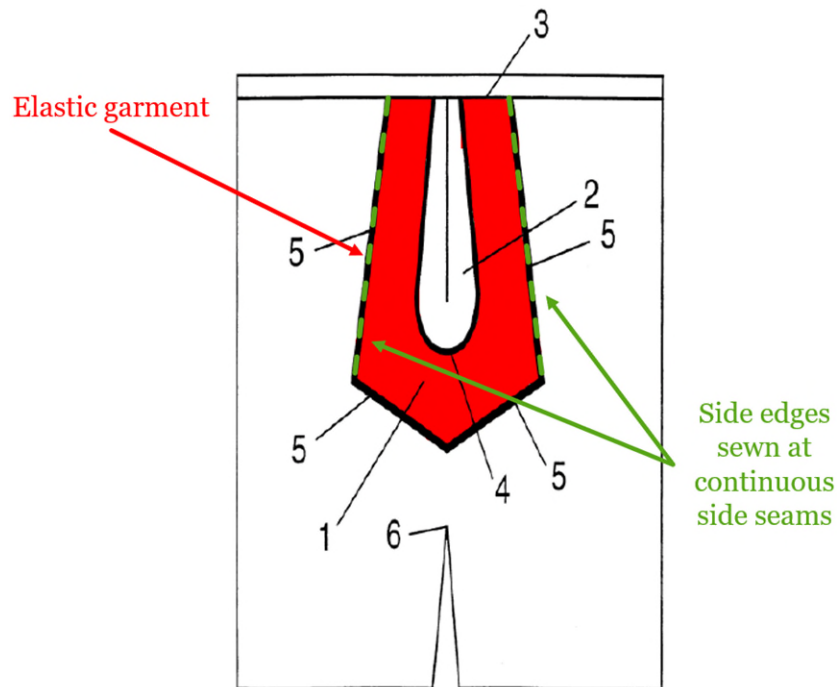
(Carrillo, Fig. (annotated), Abstract, 2 (noting the elastic garment’s opening extends “from the elastic (3) of the waistband”), 3; Wagner Decl., ¶128.)

Second, Carrillo’s stretch panel has a bottom edge attached to the body at a bottom location, as the elastic garment is “sewn to the inner front” of the underwear, with a bottom edge attached at a “distance above the seam of the inseam (6) of the brief” (*e.g.*, a “bottom location”):



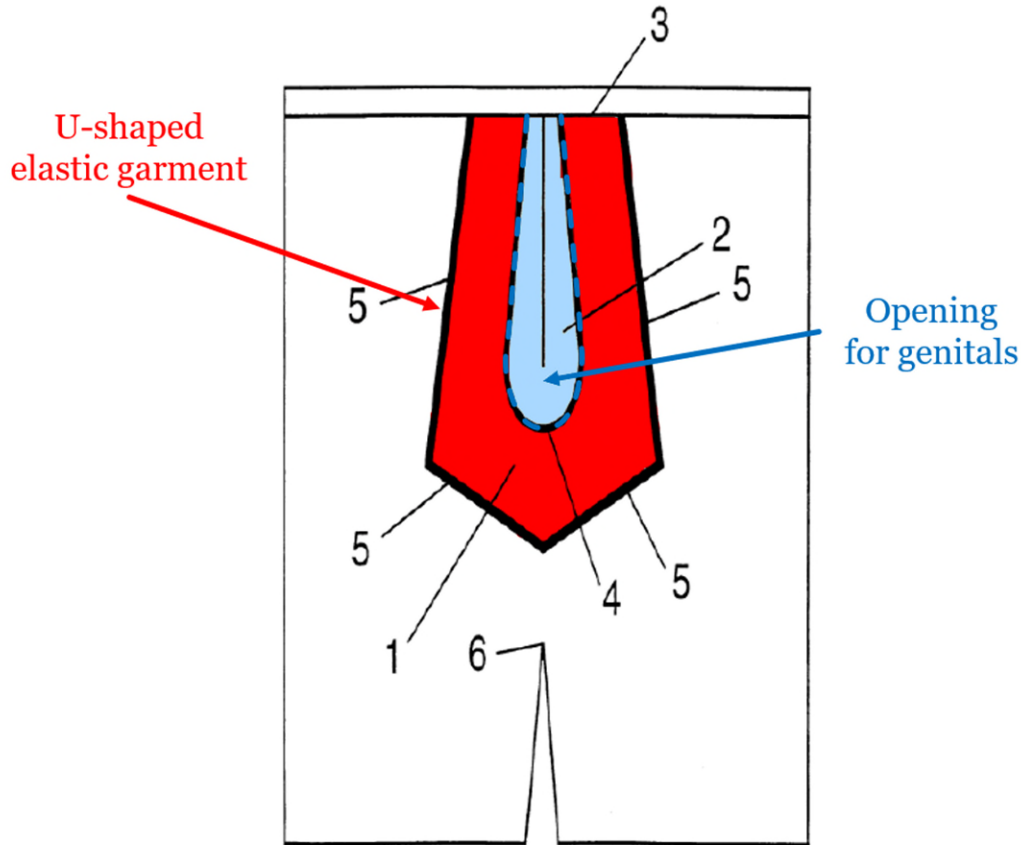
(*Id.*, Fig. (annotated), Abstract, 2-3; Wagner Decl., ¶129.)

Third, Carrillo's elastic garment stretch panel has side edges attached to the body at side seams extending substantially continuously along either side of the front portion:



(*Id.*, Fig. (annotated); Wagner Decl., ¶130.) Again, “[U-shaped elastic] garment is sewn (5) to the inner front part of the brief,” and thus is attached to the front portion of the body along the sewing seams (5) on either side of the front portion as shown above. (Carrillo, Abstract, 2, 3.)

Fourth, Carrillo’s elastic garment stretch panel has “an opening for receiving a wearer’s genitals.” (Wagner Decl., ¶131.) U-shaped elastic garment “has an opening (2) in the shape of a vertical teardrop,” through which the wearer “introduce[es] the intimate parts”:

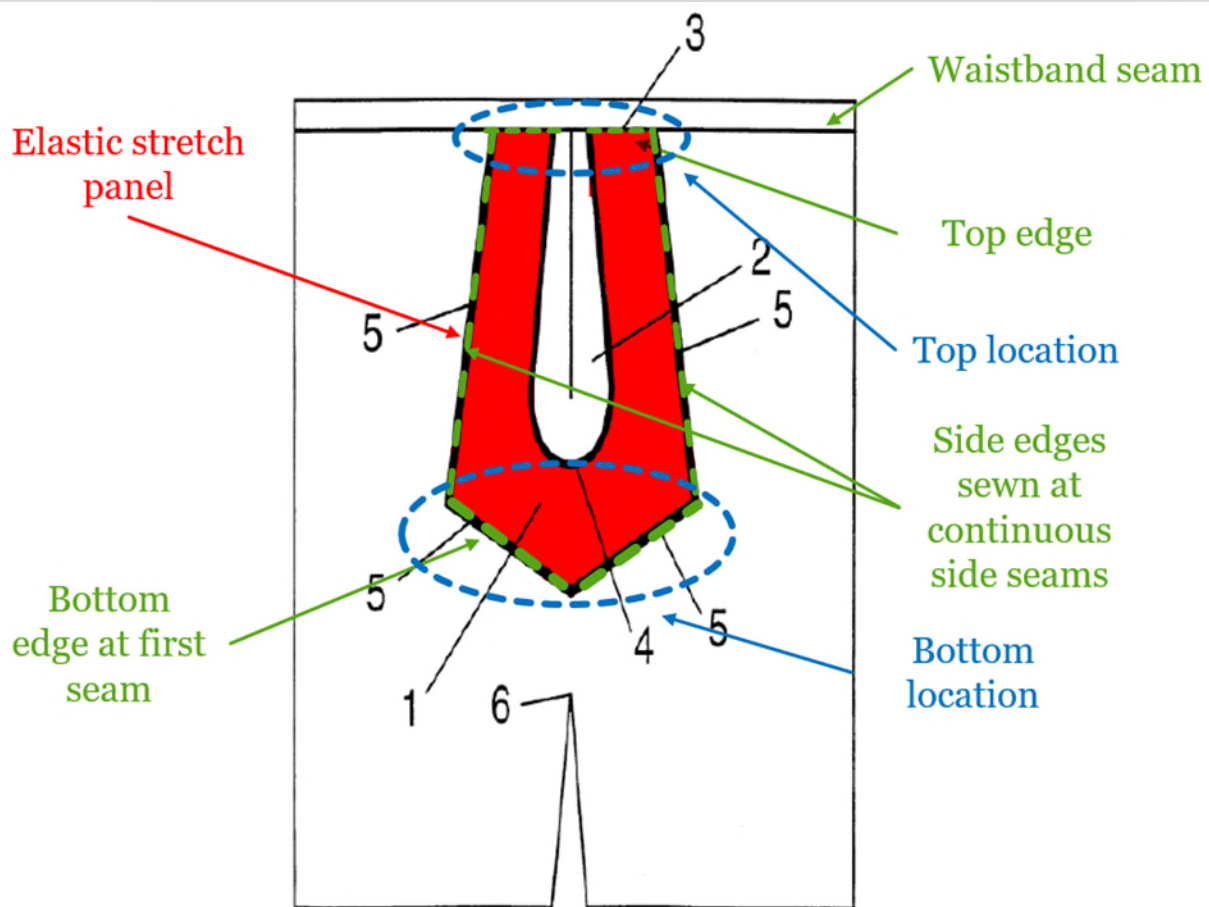


(Carrillo, Fig. (annotated), 2-3.) The opening (2) receives the wearer’s genitals such that U-shaped elastic garment gently pulls a wearer’s “intimate parts” forward through the opening to achieve “sufficient separation” and reduce “direct contact and friction.” (*Id.*, 2-3.)

1[f]: the stretch panel resiliently elastic both in a direction between the top edge and the bottom edge and in a direction between the side edges;

Carrillo discloses and renders obvious Claim 1[f]. (Wagner Decl., ¶132.) Again, Carrillo discloses and renders obvious using a four way stretch material for the U-shaped elastic garment. *See supra* Section VIII(B)(1) (Claim 1[d]). Carrillo further discloses the U-shaped elastic garment is sewn to the front of the underwear,

with a top edge attached to the waistband, a bottom edge attached at a seam above the in-seam, and side edges. *See supra* Section VIII(B)(1) (Claim 1[e]). Thus, when U-shaped elastic garment stretches, it can do so from side to side or from top to bottom between the top edge and bottom edge. (Wagner Decl., ¶132.) Therefore, A POSITA would have understood U-shaped elastic garment is resiliently elastic in a direction between the top edge attached at the top waistband location and the bottom edge where it is sewn “above the inseam (6)” and in a direction between the two side edges on either side of the opening:



(Carrillo, Fig. (annotated), 1-3; Wagner Decl., ¶132.) *See also supra* Section VIII(B)(1) (Claims 1[c]-[e]).

1[g]: the stretch panel having a length when unstretched smaller than a length measured along the front portion between the top and bottom locations and a width when unstretched smaller than a width measured along the front portion between the side seams such that front portion is gathered by the stretch panel and defines a three-dimensional pouch between the stretch panel and the front portion for receiving the wearer's genitals and holding the wearer's genitals while the garment is being worn;

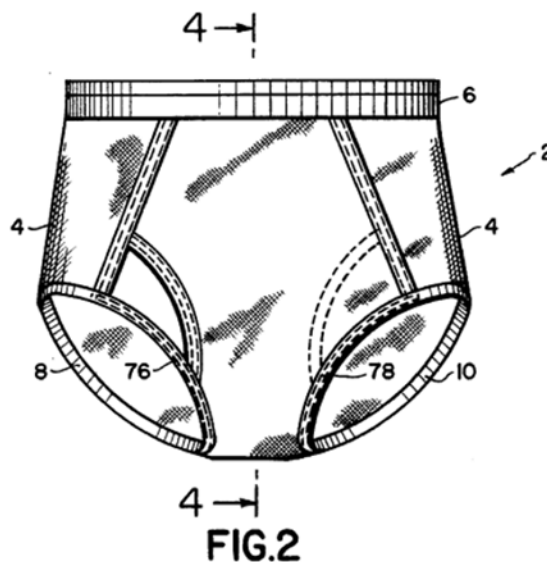
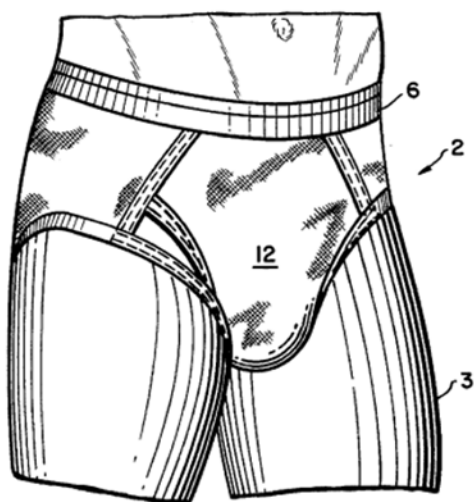
Carrillo in view of Brocks renders obvious Claim 1[g]. (Wagner Decl., ¶133.)

Carrillo's elastic garment includes an opening into a pouch area, and allows a user to insert their genitals into the opening and have them "pulled forward" into the pouch area to be supported and separated from the groin area. *See supra* Section VIII(B)(1) (Claims 1[a], 1[c], 1[e]). (*See also* Carrillo, Abstract, 2-3.) Further, Carrillo's elastic garment stretch panel is made from ***elastic*** and, thus, is stretchable. *See supra* Section VIII(B)(1) (Claim 1[c], 1[f]). (*See also* Carrillo, Abstract, 2-3.)⁷

Brocks, in the same field as Carrillo, discloses a male undergarment brief that includes a "defined genital pouch." (Brocks, Abstract.) Brocks's underwear includes

⁷ When Carrillo's elastic garment 1 is stretched lengthwise, its length would increase, and when stretched widthwise, its width would increase. (Wagner Decl., ¶133.)

a “trunk or rear portion 4,” a “waist band 6,” “leg bands 7 and 11,” and a “front panel insert 12” that defines a genital pouch:



(Brocks, Figs. 1-2, 2:49-64, 4:2-14; *see also* Figs. 4-5.) Brock’s two-layer “front panel insert 12” is formed of an inner panel and an outer panel. (*Id.*, 2:60-3:27.)

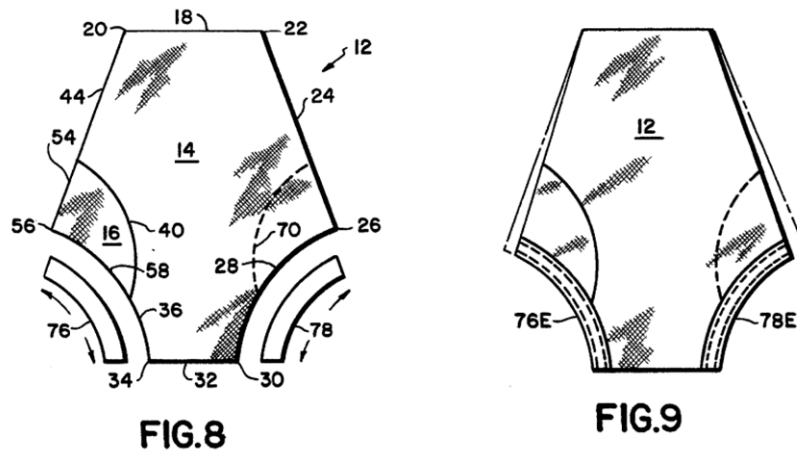
Brocks teaches its genital pouch is formed by attaching elastic strips to the front fabric panels while in a stretched state, such that when the strips contract a “shirring takes place on the panels forming a genital pouch.” (*Id.*, 2:5-21, 3:23-4:14.) In particular, Brocks discloses the elastic material used to form the pouch can be attached in a stretch state (that is, the elastic in its unstretched state is smaller than when it is being attached) so as to “gather” the front portion fabric and cause it to bunch and form the pouch. (*Id.*, 2:5-21 (“In assembling, the elastic strips are each stretched to the length of each of the concave leg opening arches of the front panel,

causing the stitched material *to be gathered together* and thereby define a genital pouch in the form of shirring when the stretching force is released.”) (emphasis added), 3:28-4:14 (“The elastic 78 in its *non-stretched condition is approximately two thirds* of the length of the leg opening arches running between point 56 of the underlying panel 16 and point 34 of the overlying panel 14, along the right leg opening, and similarly, the *elastic 78 is stitched in its stretched condition* along the arch 28 running between point 26 of under panel 16 and point 30 of the overlying panel 14... The elastic strips create a gathering and shirring forming a secure enclosure pouch for the male genitals as generally indicated in FIGS. 1 and 3.”) (emphasis added); see also Wagner Decl., ¶¶134-135.)

As shown by the arrows in Brocks’s Figure 8, the elastic strips are stretched in a lengthwise and widthwise direction, as they are pulled upward and outward from bottom corners 30 and 34 of “outer panel 14” of front panel 12 towards outer edges 26 and 56,⁸ with the unstretched length and width of the strips being smaller than the length and width measured along the seams after attachment in a stretched state (as

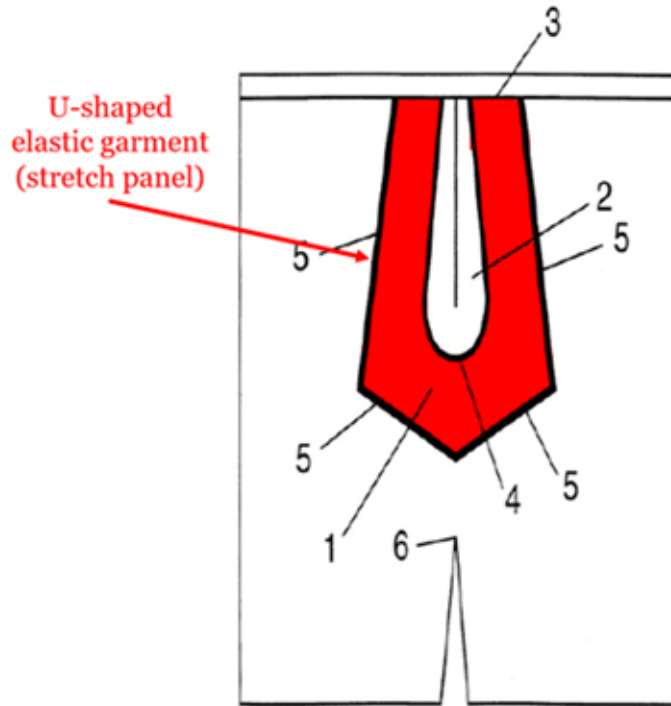
⁸ The ’974 shows similar stretching in length and width as Brocks, illustrating in Figure 9, for example, how the stretch panel is stretched upwardly and outwardly. (’974, Fig. 9; Wagner Decl., ¶67.)

indicated by the dotted lines in Figure 9, which shows the strips in a stretched state when being attached):



(*Id.*, Figs. 8-9, 3:27-4:14; Wagner Decl., ¶136.)

It would have been obvious to a POSITA to modify Carrillo to first stretch its U-shaped elastic garment and then sew it to the front part of the underwear in a stretched condition, as taught by Brocks, to create a “gathering and shirring *forming a secure enclosure pouch* for the male genitals.” (Brocks, 3:27-4:14 (emphasis added); Wagner Decl., ¶137.) Carrillo’s U-shaped elastic garment is elastic, like the elastic strips in Brocks, and could be similarly stretched before being sewn to the front part of the underwear along lines (5) as shown in the Figure:



(Carrillo, Fig. (annotated), 2-3; Wagner Decl., ¶137.) Further, like the elastic strips in Brocks, Carrillo’s U-shaped elastic garment is joined with a front part of underwear along sewn seams to create a pouch to support and enclose the wearer’s genitals, and attaching it in a stretched state would help further define the pouch with sufficient volume for the wearer’s genitals. (Carrillo, Abstract, 2-3.)

A POSITA would have recognized that, as taught by Brocks, when Carrillo’s U-shaped elastic garment is stitched to the front part in a stretched state, it would contract after being sewn and would assist in “gathering” the front panel fabric to which it is attached, helping to form the supportive genital pouch. (Wagner Decl., ¶138.) Such a modification would not require any additional materials, as Carrillo already discloses its U-shaped elastic garment is an elastic material, and attaching

this same material in a stretched state would allow U-shaped elastic garment to continue to perform its functions of pulling the genitals forward into the front part pouch, reducing contact and friction with the groin area, and assisting with perspiration, while also further adding to the gathering of fabric to create the supportive pouch. (*Id.*)

A POSITA would have been motivated to modify Carrillo, as taught by Brocks, to sew the U-shaped elastic garment to the front part of the underwear when in a stretched state, stretching it upwards and outwards (*e.g.*, in a lengthwise and widthwise direction), to aid in pouch formation. (*Id.*, ¶139.) Carrillo already teaches attaching U-shaped elastic garment to the front portion allows a user to insert their genitals into the opening and have them be “pulled forward” into the front portion, separating them from the groin area. (Carrillo, Abstract, 2-3.) Using Brocks’s teachings would simply further this cooperation of the elastic garment and front part of the underwear providing a pouch space into which the genitals can be pulled forward, as the elastic garment being attached in a stretched state and then being allowed to contract would add to the formation and supportive nature of the pouch. (Wagner Decl., ¶139.)

A POSITA would have also understood that attaching the elastic garment in a stretched state, rather than an unstretched state, would merely be the simple substitution of one known method for another. (*Id.*, ¶140.) A POSITA would have

known that elastic can be sewn to other fabrics in either a stretched state or an unstretched state, and would have been motivated to try attaching in a stretched state (*e.g.*, as taught by Brocks) so the elastic material assists in “gathering” material to form the pouch. (*Id.*)

Thus, in sum, Carrillo as modified by Brocks discloses the front portion is gathered from side-to-side and top-to-bottom by the stretch panel and defines a three-dimensional pouch between the stretch panel and front portion for receiving and holding the wearer’s genitals. (*Id.*, ¶141.) By stretching U-shaped elastic garment upwardly and outwardly before sewing along lines (5) to the front part of the underwear, U-shaped elastic garment would gather front part from top to bottom and side to side to assist in creating volume of the pouch. (*Id.*) This pouch, formed between the U-shaped elastic garment and front portion, would continue to receive the wearer’s genitals, supporting them and separating them from the groin area, thus reducing contact and friction. (Carrillo, Abstract, 2-3; Wagner Decl., ¶141.)

2. Dependent Claim 2

A male garment according to claim 1 wherein the stretch panel has asymmetrical stretch characteristics such that the stretch panel stretches more easily in a direction parallel to the waistband and less easily in a direction at right angles to the waistband.

Carrillo in view of Brocks renders obvious Claim 2. (Wagner Decl., ¶142.)

Brocks discloses that materials used in men’s underwear have asymmetrical stretch characteristics, such that they stretch more easily laterally (*i.e.*, parallel to the

waistband) and stretch less easily longitudinally (*i.e.*, at right angles to the waistband). (Brocks, 1:23-32 (noting “[t]he usual material employed [in men’s briefs] is a cotton knitted material ***having stretch along the lateral axis and having very little stretch along the longitudinal or the vertical axis.***”) (emphasis added), 4:2-13.)

It would have been obvious to apply this teaching of using material with asymmetrical stretch to the stretch panel of Carrillo. (Wagner Decl., ¶144.) For example, when a user stretches the waistband to pull on the underwear, the stretch panel would need to stretch in that direction as least as much as the waistband and body of the underwear, or else the underwear would risk tearing. (*Id.*, ¶145.) And, as taught by Brocks, the stretch panel material would not need to stretch as much in a direction perpendicular to the waistband, as the underwear body fabric does not stretch as much in that direction and there is less of a risk of, for example, tearing. (*Id.*, ¶¶145-146.)

A POSITA would have also been motivated to modify Carrillo, as taught by Brocks and generally known in the art, to construct U-shaped elastic garment such that it has asymmetrical stretch characteristics and would stretch more easily in a direction parallel to the waistband than at right angles to the waistband. (*Id.*, ¶147) Doing so would help accommodate forces placed on the underwear during normal

use, and would have ensured the stretch panel would not prevent the body material from stretching to accommodate the wearer's body. (*Id.*)

Additionally, it would have been obvious to a POSITA for Carrillo's U-shaped elastic garment to have asymmetric stretch such it stretches more in, for example, a direction parallel to the waistband. (Wagner Decl., ¶148.) A POSITA would have known that elastic material, such as Carrillo's, must have either symmetrical stretch (*e.g.*, stretches the same in all directions) or asymmetrical stretch (*e.g.*, stretches more in one direction than another). (*Id.*) A POSITA would have therefore found it obvious to try asymmetrical stretch material, as it would have been only one of two known options and would have accounted for needing more stretch in the direction of the waistband when the underwear is opened up to be put on by a wearer. (*Id.*) Further, applying this would have been a simple, well-known way to implement or construct Carrillo's U-shaped elastic garment, which would continue to function as before, only now the wearer could stretch the underwear more in the lateral direction. (*Id.*)

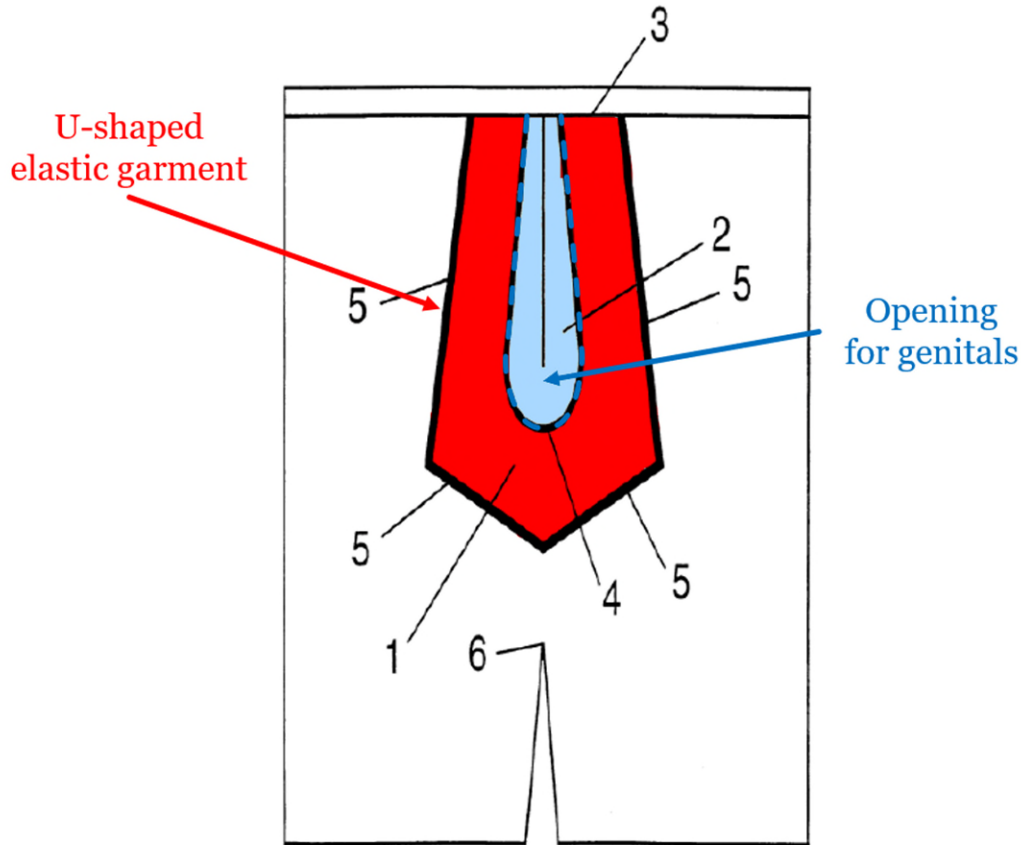
Moreover, Carrillo contemplates U-shaped elastic garment being attached to underwear "models already existing on the market." (Carrillo, 2.) Many of these models, especially those attempting to address friction, excessive moisture, and testicle positioning like Carrillo, are performance underwear that already use material with asymmetrical stretch for the aforementioned reasons. (Wagner Decl.,

¶149.) A POSITA would have been motivated to construct Carrillo's U-shaped elastic garment from a material with similar characteristics, lest the benefits of using such material for the rest of the underwear be diminished. (*Id.*)

3. Dependent Claim 3

A male garment according to claim 1 wherein the stretch panel is rectangular and the opening is U-shaped.

Carrillo in view of Brocks renders obvious Claim 3. (*Id.*, ¶150.) The '974 indicates its stretch panel 22 can be "generally rectangular," with a U-shaped opening, as seen, for example, in Figures 3 and 9. ('974, 4:47-48, Figures 3, 9.) Carrillo's "U-shaped elastic garment" has a similar rectangular shape and "opening (2) in the shape of a vertical teardrop":



(Carrillo, Fig. (annotated), 2; *see also* Abstract, 3; Wagner Decl., ¶¶150-151.)

Carrillo's elastic garment has a shape and opening that is strikingly similar to the '974's stretch panel (*e.g.*, in Figures 3 and 9), with a rectangular shape bounded by a top edge, two substantially parallel side edges, and a bottom edge, and with a U-shaped opening in the middle. (*Id.*)

4. Dependent Claim 4

A male garment according to claim 3 wherein the stretch panel comprises a fabric having a stretch of at least 30%.

Carrillo in view of Brocks renders obvious Claim 4. (Wagner Decl., ¶152.)

Again, it would have been obvious to modify Carrillo to attach the U-shaped elastic

garment to the front of the underwear in a stretched condition, as taught by Brocks, to gather fabric to form the supporting and separating pouch. *See supra* Section VIII(B)(1) (Claim 1[g]).

Brocks further discloses the elastic strips “in their unstretched condition are approximately **two-thirds** the length of each leg opening arch of the front panel. In assembling, the elastic strips are each stretched to the length of the concave leg opening arches of the front panel, causing the stitched material to be gathered together and thereby define a genital pouch[.]” (Brocks, 2:5-13 (emphasis added), Abstract, 3:24-4:14.) That is, the stretched length of the elastic strips in Brocks is 50% greater than the unstretched length (i.e., $(100-66.\bar{6})/66.\bar{6} = 50\%$), indicating the elastic fabric can stretch by at least 30%. ('974, 5:28-45; Wagner Decl., ¶153.)

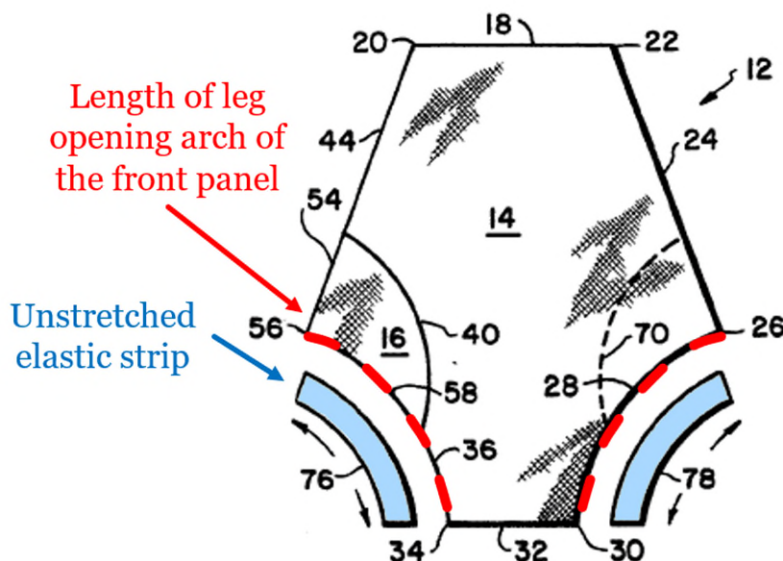


FIG. 8

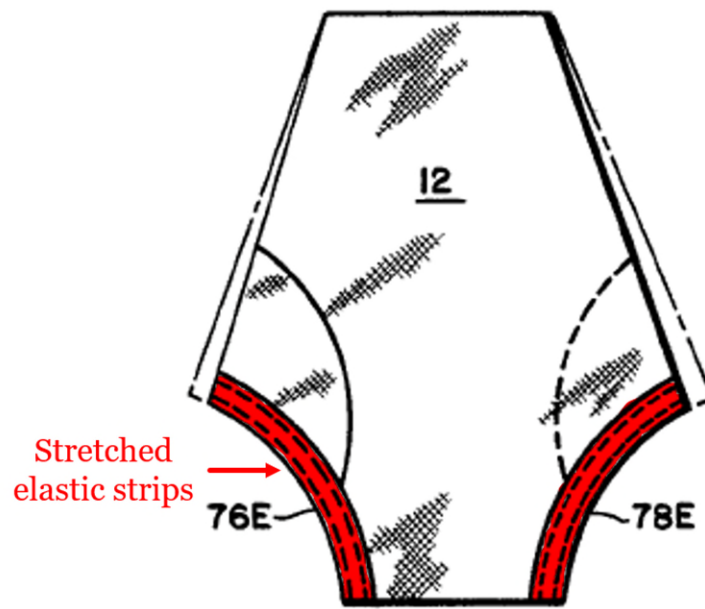


FIG.9

(Brocks, Figs. 8-9 (annotated).)

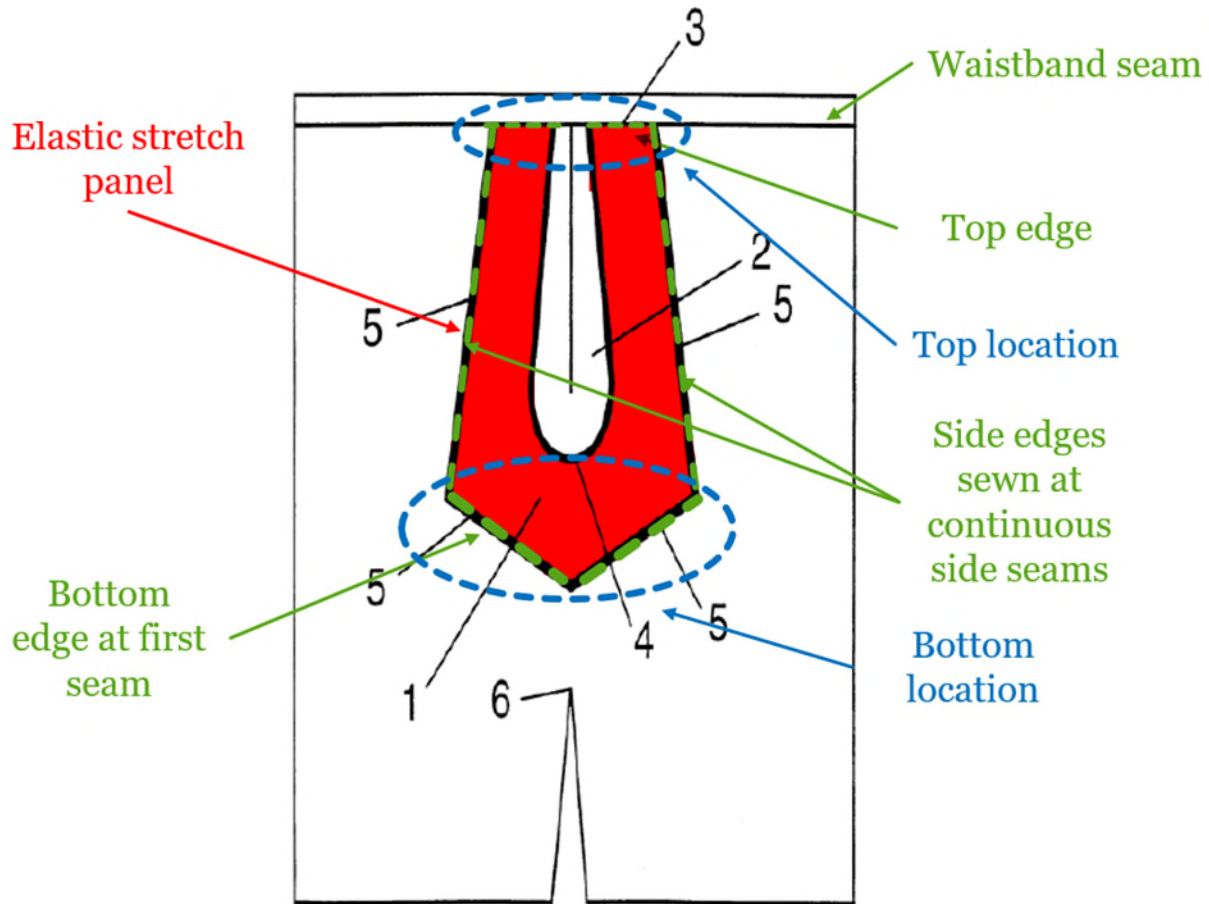
For the reasons set forth above, it would have been obvious to use a stretch panel having at least 30% stretch, as taught by Brocks. *See supra* Section VIII(B)(1) (Claim 1[g]). In addition, to ensure Carrillo’s U-shaped elastic garment has sufficient elasticity to gather the fabric, a POSITA would have been motivated to use elastic material with at least 30% stretch. (Brocks, 2:5-16, 3:23-4:14; Wagner Decl., ¶154.) If the material did not have enough stretch, it would be unable to “gather” enough fabric when released from the stretched to the unstretched state to create a pouch with sufficient volume. (Wagner Decl., ¶154.)

5. Dependent Claim 5

A male garment according to claim 1 wherein the top location is the waistband seam and the bottom location is the first seam, and a length measured along material of the front portion from the first seam to the waistband seam exceeds a length measured along the fabric of the stretch panel, when unstretched, by at least 30%.

Carrillo in view of Brocks renders obvious Claim 5. (Wagner Decl., ¶¶155.)

First, Carrillo discloses the top location is the waistband seam, as the U-shaped elastic garment depends “from the elastic (3) of the waistband.” (Carrillo, 2; *see also* Abstract, 3.) Similarly, Carrillo discloses the bottom edge of the U-shaped elastic garment is attached at a bottom location at a first seam. (Carrillo, 3 (indicating the elastic “garment is sewn (5) to the inner front part of the brief,” and thus having a seam formed at the bottom location where the bottom edge is sewn); Wagner Decl., ¶156.) For example, the elastic garment can be sewn to the front part at a location a “certain distance above the inseam of the brief (6).” (*Id.*)



(*Id.*, Fig. (annotated).) See also *supra* Section VIII(B)(1) (Claim 1[e]).

Second, a POSITA would have understood Carrillo's undergarment, as modified by Brocks, would have a length, measured along the front portion material from the first seam to the waistband seam, exceeding a length measured along the fabric of the stretch panel, when unstretched, by at least 30%. See *supra* Sections VIII(B)(1), (4) (Claims 1[g], 4). That is, because the unstretched length of each strip in Brocks is only 66% the length of the front portion fabric to which it is attached while stretched, a length measured along the front portion fabric is at least 30%

greater than that of each unstretched strip. (Brocks, 2:5-16, 3:24-4:14, Figs. 8-9; Wagner Decl., ¶157.)

As discussed, it would have been obvious modify Carrillo in view of Brocks to use elastic material stretched by at least 30% when attached to the front portion, such that the U-shaped elastic garment gathers the front material into a pouch with sufficient volume, for the same reasons as set forth above. *See supra* Sections VIII(B)(1), (4) (Claims 1[g], 4). Incorporating this teaching into Carrillo to form the pouch would result in a U-shaped elastic garment whose length unstretched is at least 30% less than the length of a measurement along the material of the front panel to which it is attached in a stretched state. (Wagner Decl., ¶158.)

6. Dependent Claim 6

A male garment according to claim 1 wherein the garment is a pair of undershorts.

Carrillo discloses Claim 6. (Wagner Decl., ¶159.) Carrillo discloses “a hygienic elastic garment for men’s underwear.” (Carrillo, Title, Abstract; *see also* 1-3.)

7. Dependent Claim 7

A male garment according to claim 1 wherein the stretch panel comprises a fabric different from a fabric of the body.

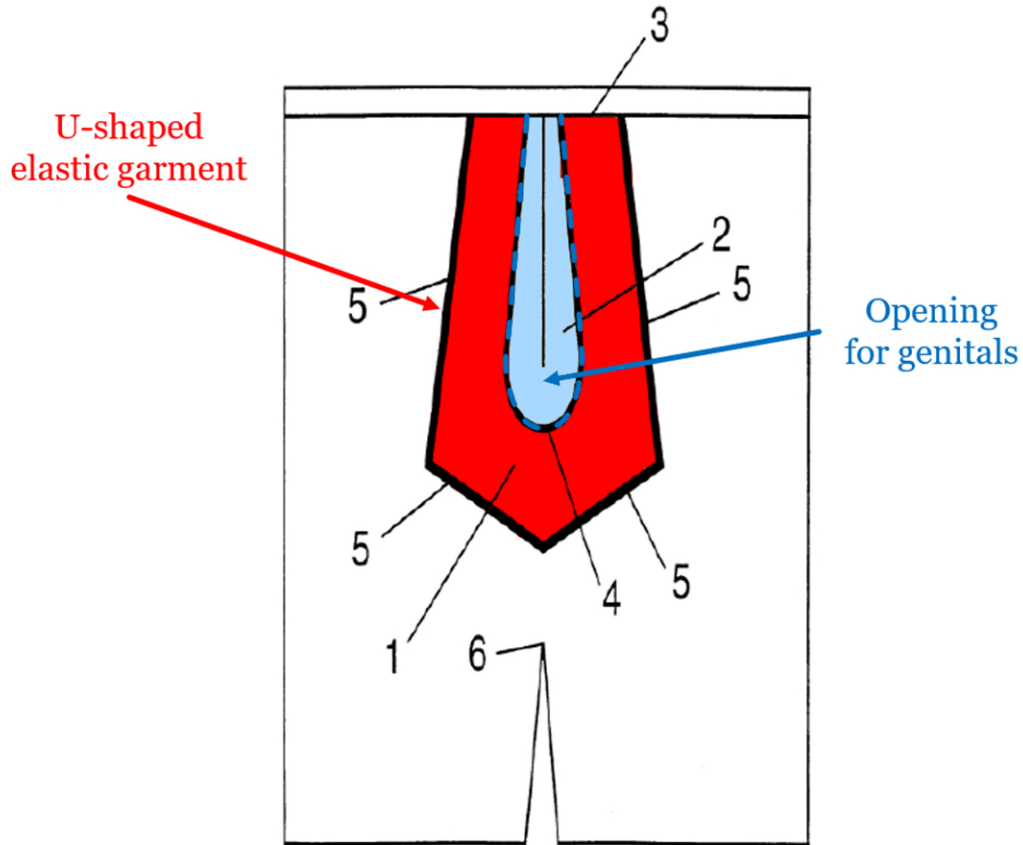
Carrillo in view of Brocks renders obvious Claim 7. (Wagner Decl., ¶160.) Carrillo discloses a stretch panel in the form of a U-shaped ***elastic*** garment. (Carrillo, Abstract, 1-3.) Carrillo further discloses the U-shaped elastic garment is “sewn to

classic underpants.” (*Id.*, Abstract, 2 (“U-shaped elastic garment (1) sewn to the inner front part of standard briefs.”).) Thus, underwear body is material for classic underpants or briefs, and the stretch panel is made from a different, elastic material. (Wagner Decl., ¶160.)

8. Dependent Claim 8

A male garment according to claim 1 wherein the opening has a width in excess of 2 cm.

Carrillo in view of Brocks renders obvious Claim 8. (Wagner Decl., ¶161.) Carrillo discloses and renders obvious the opening of U-shaped elastic garment having a width exceeding 2 cm. (Carrillo, Fig.) For example, as seen in the figure, and based the description that the wearer introduces “the intimate parts through the opening (2)” so the elastic garment “gently pull[s] them forward” to separate the testicles from the groin area, a POSITA would have understood the opening has a width exceeding 2 cm:



(Carrillo, Fig. (annotated), 2; *see also* Abstract, 3.) If the opening (2) in elastic garment (1) were not at least 2 cm, a wearer would be unable to insert their genitals. (Wagner Decl., ¶161.)⁹

9. Dependent Claim 9

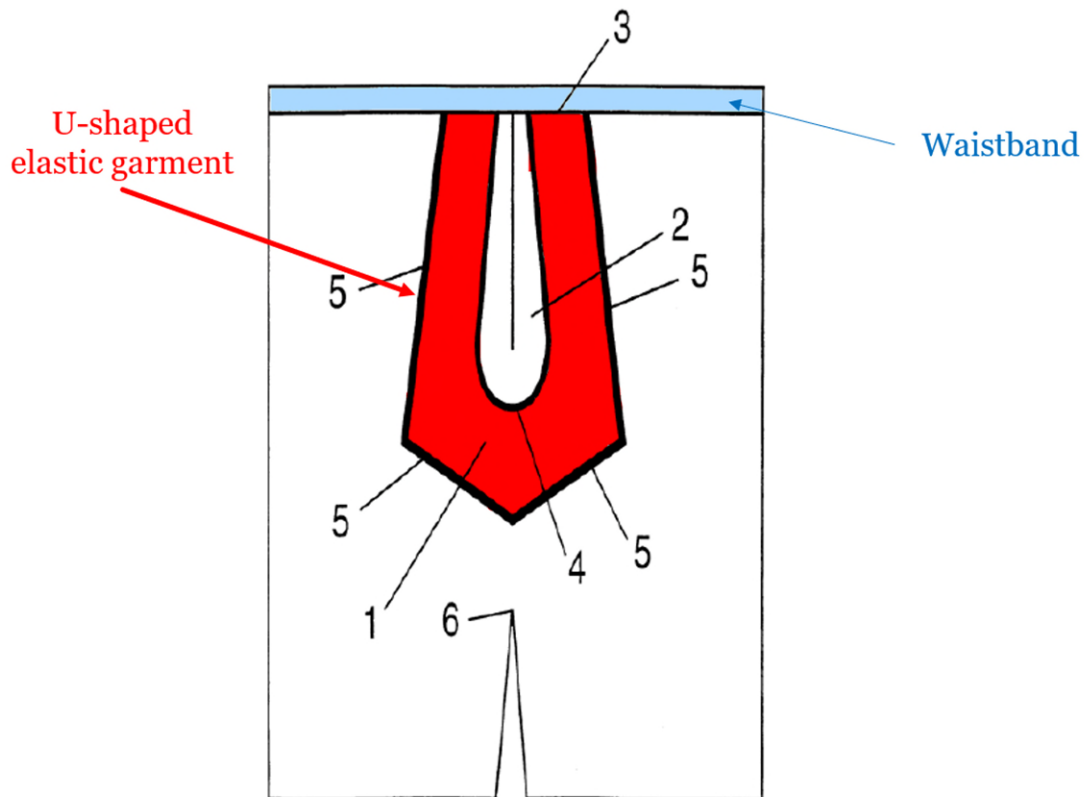
A male garment according to claim 1 wherein: the front portion depends downwardly from the waistband and the front portion is formed to provide the pouch at a mid-section thereof; the stretch panel is positioned to be disposed forward of the wearer's perineum when the garment is worn, whereby, in use, a

⁹ For these same reasons, it would have been obvious to a POSITA when constructing Carrillo's underwear to make the opening wider than 2 cm. (Wagner Decl., ¶161.)

scrotum of the wearer of the garment is supported underneath by the stretch panel to contain the wearer's penis and scrotum in the pouch.

Carrillo discloses Claim 9. (Wagner Decl., ¶162.)

First, the front portion of Carrillo's garment is shown to depend downwardly from the waistband:



(Carrillo, Fig., (annotated.) As shown, U-shaped elastic garment forms a pouch at a midsection of the front portion of the body, below the waistband, to isolate a wearer's genitals. (*Id.*, Fig., Abstract, 2-3; see also Wagner Decl., ¶163.)

Second, Carrillo discloses the U-shaped elastic garment, forming the stretch panel, is positioned to be disposed forward of the wearer's perineum when the underwear is worn, explaining the U-shaped elastic garment is attached to the **inner**

front portion of the garment, so “the normal tendency of the [U-shaped] elastic garment, when sewn to the inner front part of the underwear, is to gently **pull forward** [the genitals], achieving, with this garment, a sufficient separation to reduce the continuous direct contact and friction[.]” (Carrillo, 2-3 (emphasis added), Fig.) Thus, in use, a scrotum of the wearer is supported underneath by U-shaped elastic garment to contain the wearer’s penis and scrotum in the pouch. (Wagner Decl., ¶164.) *See also supra* Section VIII(B)(1) (Claim 1[g]).

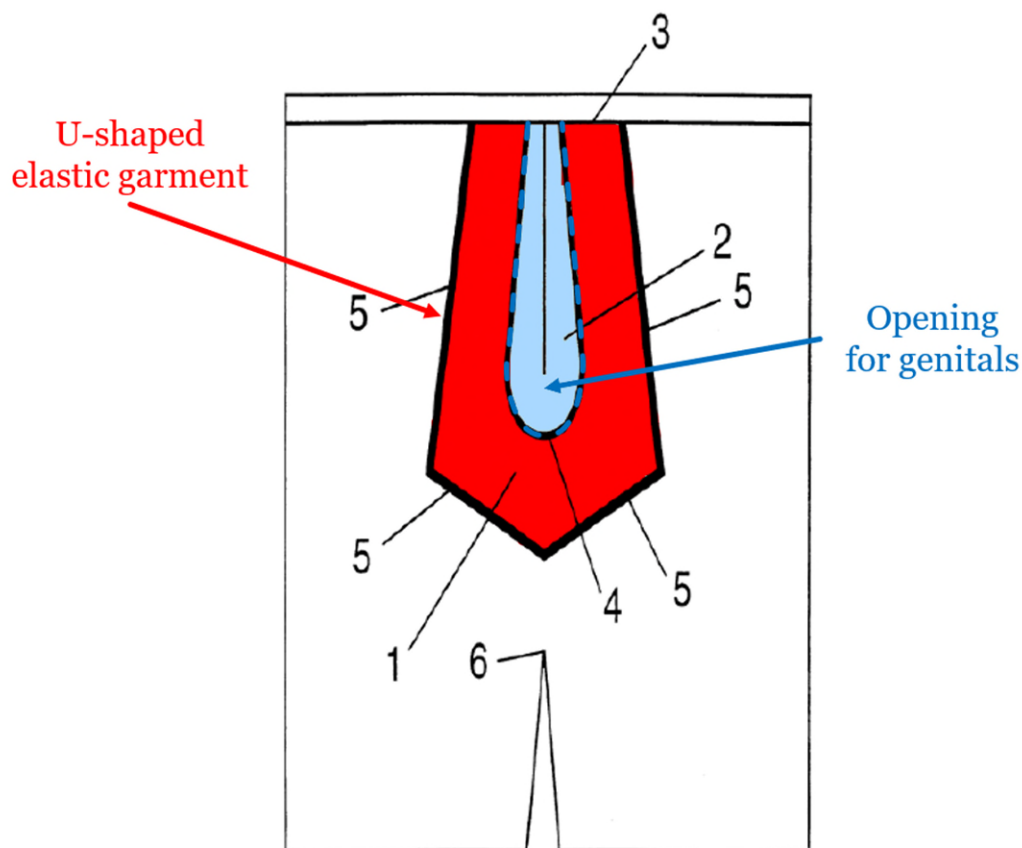
10. Dependent Claim 11

A male garment according to claim 1, wherein the stretch panel is fastened to the front portion while in a pre-stretched condition while the front portion is less stretched, whereby the stretch panel is biased to hold the opening open while the garment is held in position to be put on.

Carrillo in view of Brocks renders obvious Claim 11. (Wagner Decl., ¶165.) Carrillo, as modified by Brocks, includes a stretch panel (*e.g.*, U-shaped elastic garment) sewn to an inner front part of the underwear while in a pre-stretched condition while the front portion is less stretched. *See supra* Section VIII(B)(1), (Claim 1[g]). Again, Brocks discloses stretching elastic material, which in its unstretched state is shorter in length than a front panel, and attaching the elastic material in a pre-stretched condition to a front panel that is in a “less stretched” condition. *Id.* In particular, as is clear from Brocks, only the elastic material, and not the front panel, is stretched when the elastic strips are stitched to the front panel. (Brocks, 1:64-2:16, 3:24-4:14; Wagner Decl., ¶166.) Thus, when attached and the

stress force released, elastic garment (1) would cause the less stretched front portion material to “be gathered together and thereby define a genital pouch,” as taught by Brocks. (Brocks, 2:5-21, 4:2-14.)

Further, Carrillo’s elastic garment (1), attached in a stretched condition as taught by Brocks, would be biased to hold opening (2) open while the garment is held in position to be put on. (Wagner Decl., ¶167.) With the panel stretched, the opening would remain open, rather than the two sides folding over or covering the opening, when the user pulls open the underwear to put them on:

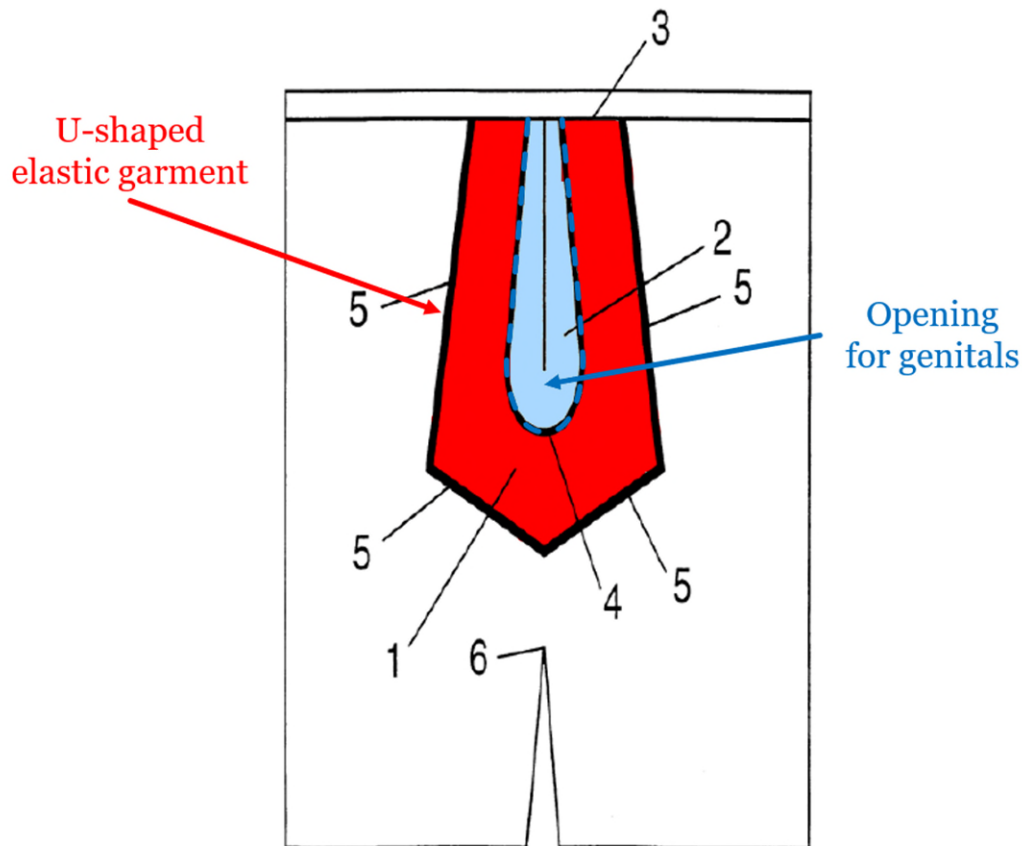


(Carrillo, Fig. (annotated).) Moreover, this is how Carrillo's describes its pouch functioning, with the wearer "introducing the intimate parts through the opening (2)" of the elastic garment, after which it "gently pull[s] them forward" when "the brief is worn as it normally is." (Carrillo, 2.)

11. Dependent Claim 13

A male garment according to claim 1 wherein the opening has a U-shape when the stretch panel is in a relaxed state.

Carrillo in view of Brocks renders obvious Claim 13. (Wagner Decl., ¶168.) Again, the elastic garment's opening has a "U-shape," as it is "an opening (2) in the shape of a vertical teardrop":

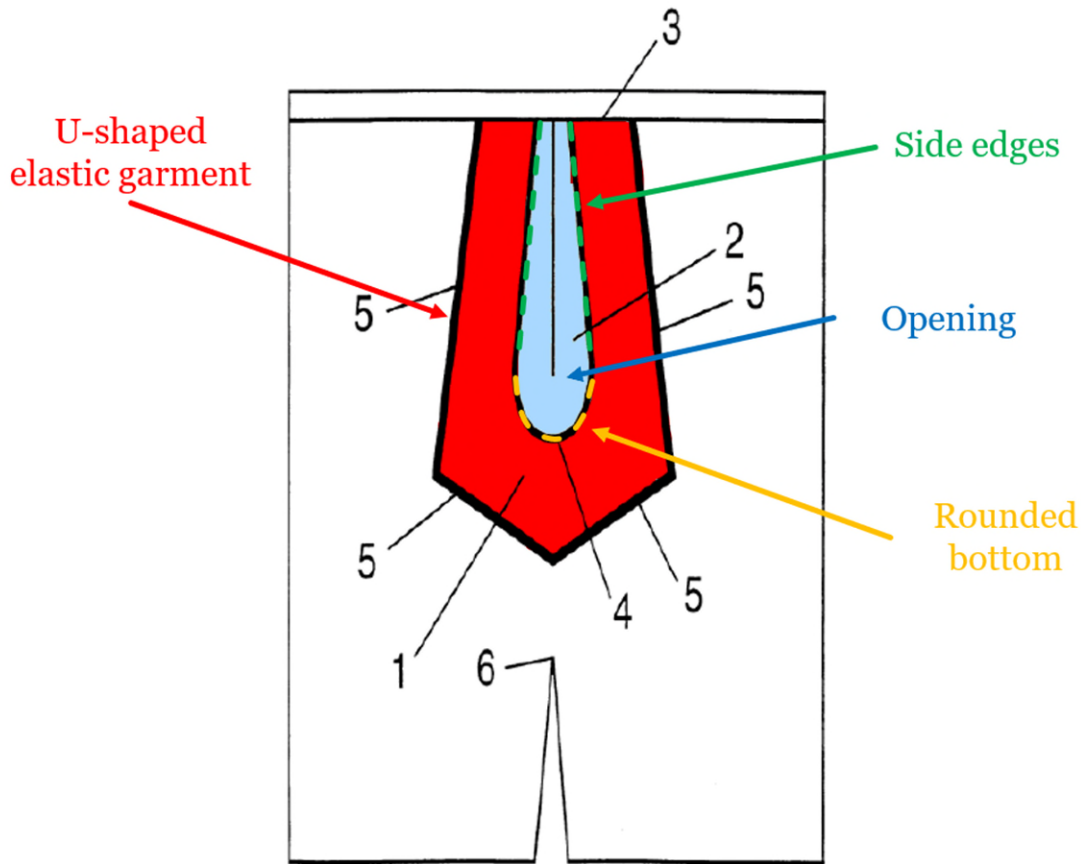


(Carrillo, Fig. (annotated), 2; *see also* Abstract, 3.) *See also supra* Section VIII(B)(3) (Claim 3). The opening's shape when the elastic garment is in a relaxed state (both before and after attachment) would be the same. (Wagner Decl., ¶168.)

12. Dependent Claim 16

A male garment according to claim 1 wherein the stretch panel is rectangular and the opening has a rounded bottom edge and opposing side edges that are spaced apart from one another on either side of the opening.

Carrillo in view of Brocks renders obvious Claim 16. (Wagner Decl., ¶169.) Carrillo discloses a generally rectangular “U-shaped elastic garment” (*e.g.*, stretch panel) with “an opening (2) in the shape of a vertical teardrop.” (Carrillo, 2; *see also* Abstract, 3.) *See also supra* Section VIII(B)(3) (Claim 3). Further, the teardrop-shaped opening has a rounded bottom edge and opposing side edges spaced apart from one another on either side of the opening:



(Carrillo, Fig. (annotated), Wagner Decl., ¶169.)

C. Ground 2b: Carrillo in View of Brocks and Kitsch Renders Obvious Claims 10, 12 and 15

1. Dependent Claim 10

A male garment according to claim 1, wherein the elastically resilient four-way stretch material is comprised of a spandex blend.

Carrillo (as modified by Brocks) in view of Kitsch renders obvious Claim 10.

(Wagner Decl., ¶170.) Carrillo discloses a stretch panel comprised of a U-shaped elastic garment. (Carrillo, Abstract, 1-3.) *See also supra* Sections VIII(B)(1), (2) (Claims 1[c]-[d], 2).

Kitsch, in the same field as Carrillo, discloses “[a]n underwear garment for use by a male” with “a genital pouch[.]” (Kitsch, Abstract.) The pouch “includes elasticized breathable wicking mesh material side panels to isolate the scrotum and phallus from the legs and which wick away moisture and provides superior comfort.” (*Id.*, [0006]; *see also* [0002], [0007]-[0008], [0030]-[0036].) Kitsch further discloses the side panels are made from “a soft elasticized breathable mesh knit (in a so-called four-by-four stretch weave) containing 80% Nylon™ and 20% Spandex™.” (*Id.*, [0030].) *See also supra* Section VIII(A)(10) (Claim 10).

It would have been obvious to a POSITA to use Kitsch’s 80% Nylon and 20% Spandex blend for Carrillo’s U-shaped elastic garment. (Wagner Decl., ¶¶171-172.) Carrillo and Kitsch are analogous art; both disclose men’s underwear with an elastic genital pouch isolating and supporting the genitals while reducing discomfort from excess moisture. (*Compare* Carrillo, 1-3 *with* Kitsch, [0006].) Carrillo discloses its U-shaped garment is generally “elastic” and intended to “improv[e] the perspiration of the [genital] area” by “eliminat[ing] direct contact between the testicles and the groin, avoiding continuous friction or poor positioning of the testicles between the legs.” (Carrillo, 1.) Kitsch discloses spandex blend side panels for the same purpose, explaining these side panels “wick away moisture and provide[] superior comfort” and that “the flexibility and elasticity of the mesh side panel material, mould[s] to gently conform to the shape of the scrotum 14 in particular and allow for resiliently

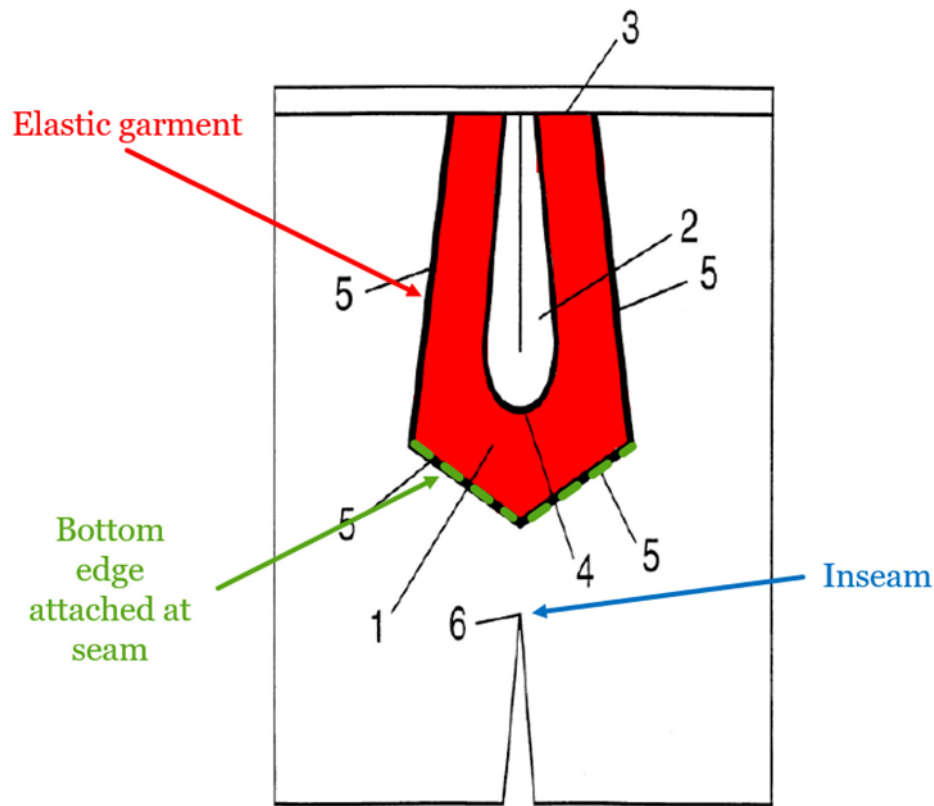
supported relative movement of the scrotum,” (Kitsch, [0006], [0029]; *see also* [0002], [0008], [0022]-[0024], [0030]-[0036].) Thus, it would have been obvious to a POSITA to use Kitsch’s spandex blend as the material of Carrillo’s U-shaped elastic garment to achieve the same comfortable genital separation and support while wicking away moisture. (Wagner Decl., ¶¶171-172.)

A POSITA would have understood that using Kitsch’s spandex blend to construct Carrillo’s U-shaped elastic garment would be the normal use of a well-known material for its intended purpose. (*Id.*, ¶173.) As Kitsch uses the spandex blend for the same function, a POSITA would have had a reasonable expectation of success using it to achieve Carrillo’s desired separation and isolation of the genitals. (*Id.*, ¶173.)

2. Dependent Claim 12

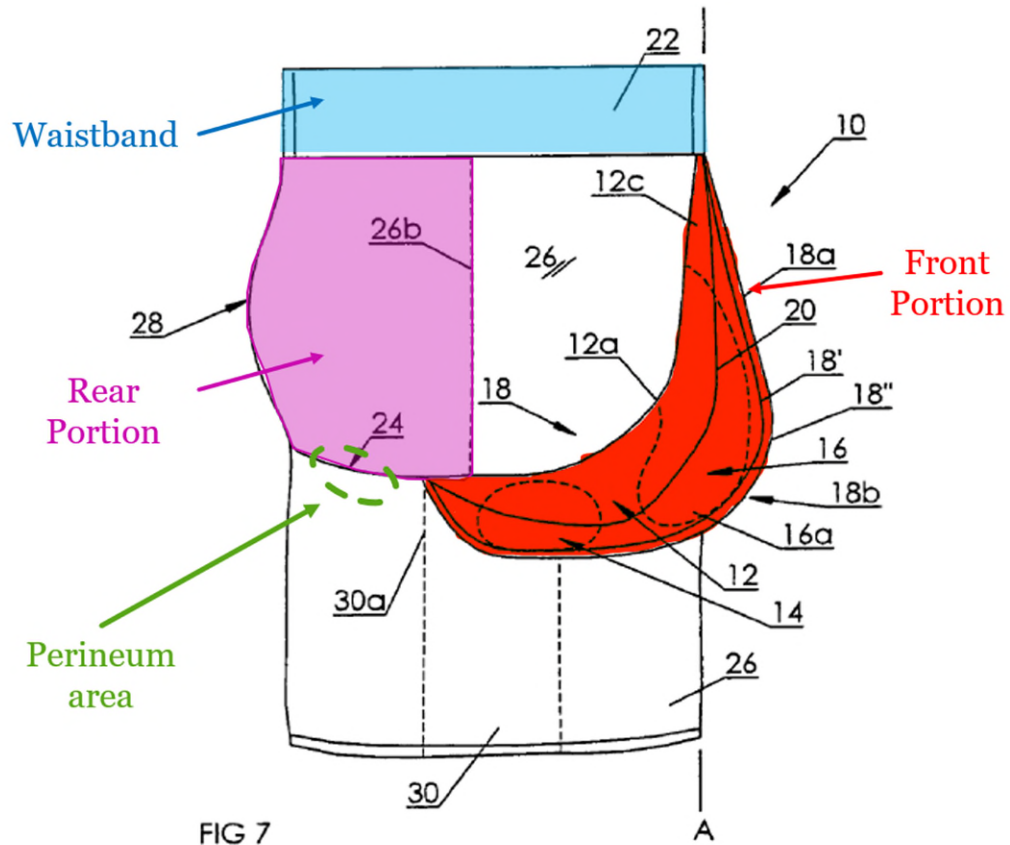
A male garment according to claim 11, wherein the front portion is attached to a rear portion of the body that depends from the waistband at a seam disposed forward of the perineum region of the wearer, and wherein a bottom edge of the stretch panel is fastened to the seam.

Carrillo (as modified by Brocks) in view of Kitsch renders obvious Claim 12. (Wagner Decl., ¶174.) Carrillo’s stretch panel, U-shaped elastic garment 1, is “sewn to the inner front part of standard briefs.” (Carrillo, 2, 3.) *See also supra* Section VIII(B)(1) (Claim 1[c]). In particular, U-shaped elastic garment has a bottom edge fastened to the body at a seam 5 just above inseam 6:



(Carrillo, Fig. (annotated).)

Kitsch, in the same field as Carrillo (*see supra* Section VIII(A)), similarly discloses a “conventional pair” of “boxer style briefs” that have elastic fabric attached to a front inside portion thereof for the same purpose of isolating the genitalia and preventing contact with the inner thighs and legs. (Kitsch, [0026]-[0027]; Carrillo, 1-2.) As explained above, Kitsch discloses these “conventional” boxer briefs include a front portion 18 and a rear portion of the body (“rear panel 28”) that depends from the waistband 22:



(Kitsch, Fig. 7 (annotated), [0041].) The front portion, “pouch compartment 18,” is attached to “rear panel 28” at a seam 30a disposed forward of perineum area 24:

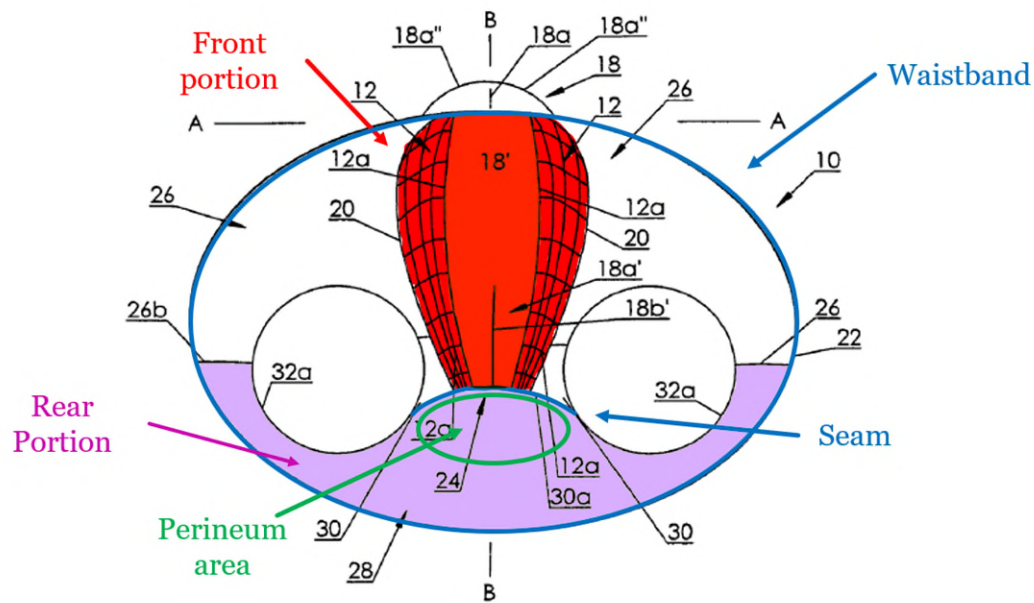


FIG 8

(*Id.*, Fig. 8 (annotated), [0041]; *see also* Figs. 3, 7 (annotated above), [0035]-[0040], Claim 1.) Kitsch notes seam 30a is at “the rearmost end of pouch compartment 18,” which is where pouch compartment joins the rear portion. (*Id.*, Fig. 9, [0041].) Moreover, as shown in Figure 8, the bottom edge of Kitsch’s side panels 12 (*e.g.*, the bottom edge of its stretch panel) are fastened at the same seam 30a. (*Id.*, Fig. 8 (annotated); *see also* Figs. 3, 7, [0035]-[0041].) *See also supra* Section VIII(A)(1), (12) (Claims 1[e][ii], 12).

It would have been obvious to a POSITA that Carrillo’s “standard briefs” would have a front portion and a back portion, like the “conventional” briefs disclosed in Kitsch. (Wagner Decl., ¶¶175-176.) For example, a POSITA would have understood from Kitsch that constructing “standard briefs” using a front portion

and back portion, both depending from Carrillo's waistband, would have been a typical and well-known method of constructing underwear. (*Id.*) This would have required nothing more than the use of known fabric patterns joined by known methods, such as the common types of seams disclosed in Kitsch. (*Id.*) A POSITA would have had a reasonable expectation of success in constructing Carrillo's briefs in this manner, as it would result in boxer briefs as shown in Carrillo that still have the "front portion" to which the U-shaped elastic garment is attached. (Carrillo, Fig., 2-3; Wagner Decl., ¶¶175-176.)

Moreover, it would have been obvious to sew the bottom edge of Carrillo's U-shaped elastic garment at a seam joining the front portion to the back portion at a position forward of the perineum area as taught by Kitsch. (Wagner Decl., ¶177.) This would have been implementing a well-known method of attachment, by connecting to a common seam, as taught by Kitsch, and a POSITA would have had a reasonable expectation of success in sewing the bottom edge of the U-shaped garment at the seam joining the front and back portions. In doing so, the U-shaped garment would continue to be attached to the body of the underwear by sewing, and would be joined along a stronger seam. (Wagner Decl., ¶177.) A POSITA would have also been motivated to do so because making the seam attaching the rear and front portions coincident with the seam attaching the U-shaped elastic garment to the body would reduce the number of seams necessary. Having fewer seams also

further Carrillo's goal of addressing itching, friction, and irritation. (*Id.*; see also Carrillo, Abstract, 1-3.)

A POSITA would have further been motivated to attach Carrillo's U-shaped garment to a back portion of its briefs at a seam forward of the perineum, as taught by Kitsch, in order to ensure the elastic material extends far enough back to separate and isolate the testicles from the legs and groin area. (Carrillo, 1-2; Kitsch, Abstract, [0002], [0006]-[0008], [0026]-[0027], [0030]-[0036]; Wagner Decl., ¶179.) This is a stated purpose of both Carrillo and Kitsch (*id.*), and a POSITA would have understood from Kitsch that extending the elastic stretch panel material to such a seam ensures the stretch panel, in cooperation with the front portion, closely resembles the "natural setting of the genitals" for isolation and support. (Kitsch, [0008], [0026]-[0027], [0030]-[0039].)

Furthermore, having the seam, and therefore the bottom edge of U-shaped elastic garment, forward of the wearer's perineum region allows U-shaped elastic garment to "gently pull [the wearer's testicles] forward, achieving ... sufficient separation to reduce direct contact and friction." (Wagner Decl., ¶179; Carrillo, 2.) If the seam was not forward of the wearer's perineum, U-shaped elastic garment would not be in as advantageous of a position to pull the wearer's genitals forward. (Wagner Decl., ¶179.)

3. Dependent Claim 15

A male garment according to claim 1 wherein the pouch comprises a dart seam stitched along a bottom portion of the pouch and centrally to provide extra volume in front of and underneath the genitals of the wearer.

Carrillo (as modified by Brocks) in view of Kitsch renders obvious Claim 15. (Wagner Decl., ¶180.) Carrillo discloses the base of the U-shaped elastic garment's opening "is located between the testicles and the groin" so the "testicles tend to be separated towards the front due to the fact that the garment is sewn to the inner front part of the underpants." (Carrillo, Abstract, 1-2.)

Kitsch, in the same field as Carrillo (*see supra* Section VIII(C)(1) (Claim 10)), discloses a pouch compartment formed between a front portion of underwear and elastic panels, like the front portion and U-shaped elastic garment in Carrillo. *See supra* Section VIII(A)(1) (Claim 1). Kitsch further discloses the front portion forming its pouch comprises a dart seam 18b' joining "a pair of divergent tails." (Kitsch, [0030], [0036], Figs. 3, 8-9.) Seam 18b' is stitched along a bottom portion of the pouch, and is centrally in the middle of the pouch compartment:

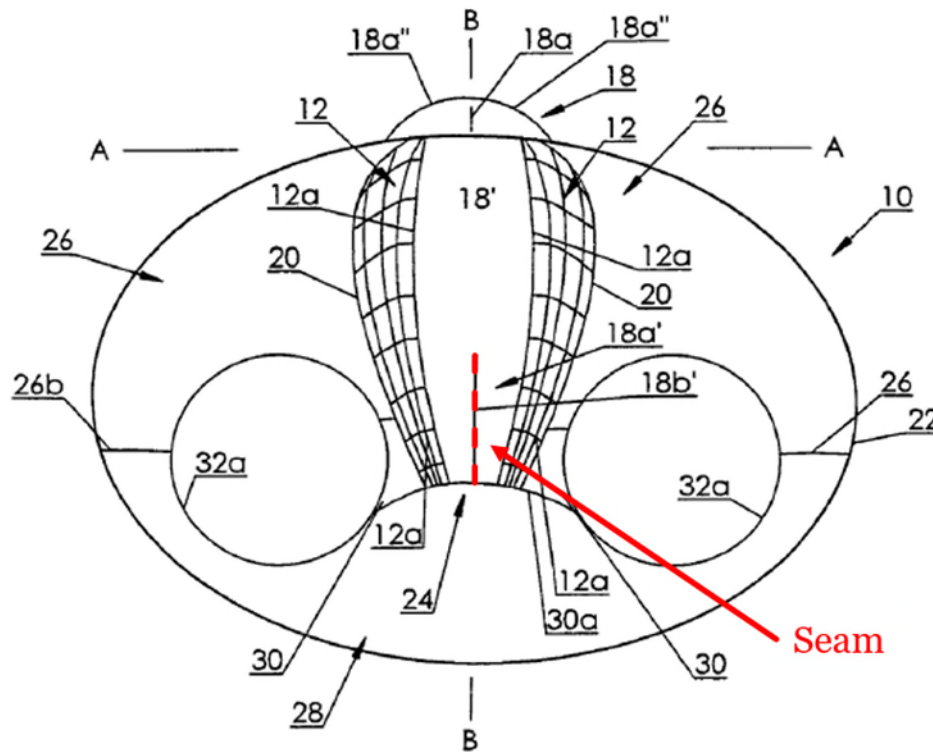


FIG 8

(*Id.*, Fig. 8 (annotated); *see also* Figs. 3, 9, [0030], [0036].) This seam creates extra volume in front of and underneath a wearer’s genitals, forming “a shelf-like tableau or plateau 18a’ cradling the underside of scrotum 14,” and, in combination with seams 26a, contributes to the pear shape of the pouch compartment, creating “greater rear pouch volume.” (*Id.*, [0030]-0036].)

It would have been obvious to a POSITA to include such a dart seam along the bottom of the front portion of Carrillo’s underwear, in front of the opening, so as to provide “greater pouch volume” and ensure there is room for the front portion to receive genitals introduced through the opening. (Wagner Decl., ¶183.) Further, a

POSITA would have been motivated to use such a dart seam to form the “plateau” described in Kitsch, as this would support the genitals and assist in achieving Carrillo’s goals separating the genitals from the groin and leg to eliminate contact, thereby reducing friction and improving positioning. (*Id.*; Carrillo, Abstract, 1-2.) A POSITA would have had a reasonable expectation of success in implementing such a dart seam in Carrillo, as a dart seam was a common and well-known method to join portions of a piece of fabric to create additional volume. (Wagner Decl., ¶183.) This would have been nothing more than using a well-known technique for its intended purpose, and would have helped to achieve Carrillo’s goals of having a separate space for the genitals. (*Id.*)

IX. TRIAL SHOULD BE INSTITUTED

A. *Fintiv* Factors

The Board should institute review because Petitioner has been diligent in filing its Petition, and the circumstances surrounding the parallel district court case do not warrant discretionary denial under § 314(a). *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 11-21 (Dec. 1, 2020) (precedential) (citing *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar 20, 2020) (precedential)). That case is in its early stages: fact discovery is in its infancy, and no *Markman* or other substantive proceedings have taken place, other than a hearing on a motion to transfer filed by Petitioner.

B. 35 U.S.C. § 325(d)

The Board should decline to exercise discretion under § 325(d). While Kitsch, Brocks, and Carrillo were cited, along with multitudes of other references, in extensive IDS submissions during prosecution, they were not relied on in any rejections made in any Office Actions during prosecution of the '974 or its parent applications. Moreover, nothing in the record suggests the Examiner considered these references in combination as presented herein.¹⁰ Thus, the Grounds presented herein have not been previously considered, and discretionary denial under § 325(d) is not warranted.

X. CONCLUSION

Petitioner respectfully requests a Trial be instituted. Claims 1-13 and 15-16 of the '974 should be cancelled as obvious over the prior art.

¹⁰ Should Patent Owner raise a *Fintiv* or § 325(d) challenge, Petitioner intends to respond to any such arguments.

Dated: July 12, 2024

Respectfully submitted,

/s/ Joseph J. Raffetto

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Table of Exhibits

Exhibit No.	Description
1001	U.S. Patent No. 10,834,974 (“’974 Patent”)
1002	File History for the ’974 Patent
1003	File History for U.S. Patent No. 10,034,496
1004	File History for U.S. Patent No. 9,687,030
1005	Declaration of Robin Wagner
1006	Curriculum Vitae of Robin Wagner
1007	U.S. Patent Application Publication 2008-0178369 (Kitsch)
1008	U.S. Patent No. 5,461,729 (Brocks)
1009	WO 01/67687 (Carrillo)
1010	WO 01/67687 (Carrillo) - English Translation with Certification

Certificate of Word Count

I certify that, in accordance with 37 C.F.R. § 42.24(d), the word count for the foregoing Petition totals 13,968 words. This is less than the permitted total under the 37 C.F.R. 42.24(a)(1)(i).

/s/ Joseph J. Raffetto

Joseph J. Raffetto (Reg. No. 66,218)
Counsel for Petitioner

Certificate of Service

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, the foregoing Petition for Inter Partes Review, and Exhibits 1001 through 1010 were served on July 12, 2024, by Overnight Courier at the following address of record for the '974 Patent and addresses known to Petitioner as likely to effect service:

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