

IPR No. IPR2024-01163

Patent 10,834,974

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Tommy John, Inc., Petitioner,

v.

Pakage Apparel, Inc.,
Patent Owner.

Case No. IPR2024-01163

Patent 10,834,974

**PATENT OWNER PAKAGE APPAREL, INC.'S
PRELIMINARY RESPONSE**

October 10, 2024

TABLE OF CONTENTS

PATENT OWNER PACKAGE APPAREL, INC.’S PRELIMINARY RESPONSE	i
TABLE OF CONTENTS.....	ii
TABLE OF AUTHORITIES	iv
LIST OF EXHIBITS	vi
I. INTRODUCTION	1
II. BACKGROUND	3
III. CLAIM CONSTRUCTION.....	3
IV. THE BOARD SHOULD DENY INSTITUTION OF THE PETITION	4
A. Discretionary Denial is appropriate under 35 U.S.C. §325(d) and <i>Advanced Bionics</i>	6
1. All Three References Relied Upon by Petitioner Satisfy <i>Advanced Bionics</i> Step (1).	7
a. Prior Art Submitted During Prosecution of the ’030 Patent.....	9
b. Prior Art Submitted During Prosecution of the ’496 Patent.....	12
c. Prior Art Submitted During Prosecution of the ’974 Patent.....	14
2. Petitioner and Prior Art Fail to Satisfy <i>Advanced Bionics</i> Step (2)....	21
a. The Board Must Deny Institution Based on Ground 1 Because Kitsch in view of Brocks Fail to Teach or Make Obvious Claims 1-13 and 15-16.	23
b. The Board Must Deny Institution Based on Ground 2a Because Carrillo in view of Brocks Fails to Teach or Make Obvious Claims 1-9, 11, 13, 16.	30
c. The Board Must Deny Institution Based on Ground 2b Because Carrillo in View of Brocks and Kitsch Fails to Teach or Make Obvious Claims 10, 12 and 15.	41
B. The Board Should Deny Institution Under <i>Fintiv</i> and §314(A).	41

1. Factor 1: The District Court Only Recently Stayed the Concurrent Litigation.	42
2. Factor 2 is neutral or slightly favors denial of institution because the trial in the district court was to take place and may still occur before the Board’s projected statutory deadline.....	43
3. Factor 3 shows that the investment in the district court case weighs in favor of denying institution.	44
4. Factor 4 supports discretionary denial because of substantial overlap of critical issues.	45
5. Factor 5 supports denial because Petitioner is also the district court defendant.	49
6. Factor 6 supports discretionary denial because Petitioner raised the same art and arguments over which the challenged claims issued.	49
V. CONCLUSION.....	50
CERTIFICATION OF WORD COUNT UNDER 37 C.F.R. § 42.24(d).....	51
CERTIFICATE OF SERVICE.....	52

TABLE OF AUTHORITIES

Cases

<i>0912139 B.C., Ltd and Pakage Apparel, Inc. v. Rampion USA Inc. and Rampion Enterprises Ltd,</i> 2:18-CV-01464-JLR (W.D. Wash.)	2, 16, 17, 18
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (PTAB 2020)	<i>passim</i>
<i>Amazon.com, Inc. et al v. Freshub, Ltd.,</i> IPR2020-01145 (PTAB Jan. 11, 2021)	49
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 11 (Mar. 20, 2020)	<i>passim</i>
<i>Atrium Medical Corporation v. Bard Peripheral Vascular, Inc.,</i> IPR2021-01199, Paper 11 (PTAB Jan. 20, 2022)	8
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8 (PTAB 2017)	5, 6, 7
<i>BMW of North America LLC and Mercedes-Benz USA, LLC v. Stragent, LLC,</i> IPR2021-00419, Paper 14 (PTAB 2021)	4, 22
<i>Cisco Systems, Inc. v. Ramot at Tel Aviv University Ltd.,</i> IPR2020-00123 (PTAB May 15, 2020)	49
<i>Cuozzo Speed Techs., LLC v. Lee,</i> 136 S. Ct. 2131 (2016)	42
<i>Google LLC v. Ikorongo Technology LLC,</i> IPR2021-00204, Paper 13 (PTAB June 7, 2021)	44
<i>Google LLC v. Personalized Media Communications, LLC,</i> IPR2020-00719 (PTAB Nov. 5, 2020)	49
<i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.,</i> IPR2013-00324, Paper 19 (PTAB 2013)	5

IPR No. IPR2024-01163

Patent 10,834,974

<i>Medtronic, Inc. v. Nuvasive, Inc.</i> , IPR2014-00487, Paper 8 (PTAB 2014)	5
<i>Pakage Apparel, Inc. v. Tommy John, Inc.</i> , 1:24-cv-06371-LJL (S.D.N.Y.)	2, 42
<i>Palo Alto Networks, Inc. v. Centripetal Networks, Inc.</i> , IPR2021-01270, Paper 10 (PTAB Jan. 24, 2022)	8
<i>Snap v. SRK Tech</i> , IPR2020-00820, Paper 15 (PTAB Oct. 21, 2020)	43
<i>Supercell Oy v. Gree, Inc.</i> , IPR2020-01619, Paper 15 (PTAB Mar. 24, 2021)	49
<i>Unified Patents, Inc. v. Personal Web Technologies, LLC</i> , IPR2014-00702, Paper 13 (PTAB 2014)	5

Statutes

35 U.S.C. §103(a)	24
35 U.S.C. §325(e)	6, 21
35 U.S.C. 325(d)	<i>passim</i>

LIST OF EXHIBITS

Exhibit	Document
2001	U.S. Pat. No. 10,834,974 (“the ’974 Patent”) Certified File History
2002	U.S. Pat. No. 7,958,571 (Kitsch)
2003	U.S. Pub. No. 2009/0106874 (Shlush)
2004	U.S. Pat. No.10,034,496 (“the ’496 Patent”) Certified File History
2005	U.S. Pat. No.9,687,030 (“the ’030 Patent”) Certified File History
2006	Package Apparel May 16, 2024, Email Producing ’974 Patent Certified File History
2007	<i>Package Apparel v. Rampion Matter</i> Claim Construction Order
2008	Tommy John, Inc.’s Preliminary Invalidity Contentions
2009	<i>Package Apparel, Inc. v. Tommy John, Inc.</i> , Cause No. 4:23-cv-4337 (S.D. Tex.) Dkt. 29, Scheduling Order
2010	U.S. Pat. No. 7,958,571 (Kitsch) File History (uncertified)
2011	<i>Hammond Development International, Inc. v. Amazon.com, Inc. et al</i> , 20-CV-00342-ADA, Dkt. 45 (WD Tex. Oct. 28, 2019).

I. INTRODUCTION

Petitioner Tommy John, Inc. (“Petitioner”) relies on 3 references previously reviewed and considered by the Patent Office during examination of U.S. Pat. No. 10,834,974 (“’974 Patent”). Yet nowhere in the petition does Petitioner mention the Board’s precedential *Advanced Bionics* decision. Petitioner utterly fails to address its burden of proof under the two-step framework outlined in *Advanced Bionics*, likely because prosecution of the ’974 Patent was thorough. Petitioner’s glaring omission of *Advanced Bionics*, alone, warrants denial of the petition.

Even if Petitioner’s failure to abide by *Advanced Bionics* and subsequent precedential and informative decisions does not doom the petition, Petitioner’s omission of almost **1500 pages** from the file history of the ’974 Patent submitted as EX1002 should. *Compare* EX1002 *with* EX2001. On May 16, 2024, Patent Owner Pakage Apparel, Inc. (“Patent Owner”)¹ provided Petitioner with a certified copy of the ’974 Patent file history during the co-pending litigation between Petitioner and

¹ Patent Owner may also be referred to as “Applicant” when discussing the prosecution of the ’974 Patent and its predecessors discussed in note 3 below.

Patent Owner.² But Petitioner's purported '974 Patent file history submitted with its petition omitted significant prosecution documents, including an attorney declaration regarding prior art, preliminary invalidity contentions identifying Carrillo (EX1009) and Kitsch (EX1007) as allegedly invalidating prior art, and extensive invalidity claim charts.³ Petitioner's failure to be forthcoming with the entire prosecution should not be countenanced.

² *Pakage Apparel, Inc. v. Tommy John, Inc.*, Cause No. 24-cv-6371-LJL, in the United States District Court for the Southern District of New York (the "Litigation").

³ It is undisputed that the '974 Patent is a continuation of U.S. Pat. No. 10,034,496 ("'496 Patent") which is a continuation of U.S. Pat. No. 9,687,030 ("'030 Patent"), all of which claim priority to provisional application No. 61/429,065, filed on December 31, 2010. The '496 Patent and '030 Patent were both involved in litigation in the Western District of Washington, styled *0912139 B.C., Ltd and Pakage Apparel, Inc. v. Rampion USA Inc. and Rampion Enterprises Ltd*, 2:18-CV-01464-JLR (W.D. Wash.) (hereinafter, "*Pakage Apparel v. Rampion Matter*"). See EX1003 at 245, 246. The documents referred to here, and discussed further below, came from that litigation. According to the docket on PACER, the parties filed a Joint Stipulation of Dismissal with Prejudice on November 19, 2019.

While these two reasons alone warrant denial of the petition, at least four of the six *Fintiv* factors also weigh in favor of denial. Significantly, Petitioner asserts the exact same combinations of Carrillo, Kitsch, and Brocks in the Litigation as it does here. But Petitioner then also alleges that an additional 11 references, either alone or in combination with one another, render the '974 Patent obvious. All of Petitioner's alleged prior art should be addressed in one forum, the district court.

Accordingly, the Board should deny the petition for *Inter Partes* Review.

II. BACKGROUND

Relevant aspects of the '974 Patent and the file history of the '974 Patent are discussed below in the context of Petitioner's challenges. *See, e.g.*, Sections IV.A.1.a – IV.A.2.b.

III. CLAIM CONSTRUCTION

Denial of Petitioner's challenge to the validity of Claims 1-13 and 15-16 of the '974 Patent (the "Challenged Claims") does not require analysis under anything other than the plain and ordinary meaning of the claim terms, and for this reason, Patent Owner proposes ordinary and customary constructions of all terms of the Challenged Claims.⁴ Petitioner, however, failed to mention to the Board that the

⁴ Patent Owner reserves the right to present additional claim construction arguments in the concurrent litigation or this proceeding if necessary, and to opine

court in the *Pakage Apparel v. Rampion Matter* issued a claim construction order related to terms found in the claims of the '974 Patent. *See* EX2007.

Petitioner provides a definition for a person of ordinary skill in the art (POSITA). Pet. at 8. For the purposes of the petition and Patent Owner's Preliminary Response, Patent Owner does not object to Petitioner's definition.⁵

IV. THE BOARD SHOULD DENY INSTITUTION OF THE PETITION

The Board has issued numerous decisions (including precedential and informative decisions) putting Petitioner on notice that prior art submitted in an IPR that was previously presented to the Office will be scrutinized under 35 U.S.C. §325(d). Exemplar decisions include:

- *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 6-22 (PTAB 2020) (Precedential)
- *BMW of North America LLC and Mercedes-Benz USA, LLC v. Stragent, LLC*, IPR2021-00419, Paper 14 at 15 (PTAB 2021) (Informative)

on the scope of the plain and ordinary meaning of terms subject to claim construction.

⁵ Patent Owner reserves the right to present evidence of a POSITA if the Board should grant the petition.

- *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-28 (PTAB 2017) (Precedential for § III.C.5)
- *Medtronic, Inc. v. Nuvasive, Inc.*, IPR2014-00487, Paper 8 at 7 (PTAB 2014) (Informative);
- *Unified Patents, Inc. v. Personal Web Technologies, LLC*, IPR2014-00702, Paper 13 at 7-8 (PTAB 2014) (Informative); and
- *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, IPR2013-00324, Paper 19 at 4-7 (PTAB 2013) (Informative).

The continuing theme in these and other decisions is clear: petitions must articulate reasons why the Board should not deny institution where prior art was previously presented to the Office. Despite the Board’s warnings, Petitioner fails to make any attempt to follow the required two-step analysis of the Board’s precedential *Advanced Bionics* decision. Indeed, Petitioner fails to carry its burden at all, simply making a statement in a footnote in the penultimate paragraph in its petition that “Should Patent Owner raise a *Fintiv* or §325(d) challenge, petitioner intends to respond to any such arguments.” Pet. at 94 n.10.

Petitioner’s admission that it did not carry its burden in the Petition, but that it apparently instead intends to respond in a reply brief, dooms its petition. 35 U.S.C.

§325(e) (“In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”). There is no justification for the Board and Patent Owner’s time, effort, and resources to be expended on this petition under §325(d).

A. Discretionary Denial is appropriate under 35 U.S.C. §325(d) and *Advanced Bionics*.

35 U.S.C. §325(d) vests the Board with discretion to deny institution where “the same or substantially the same prior art or arguments previously were presented to the Office.” The Board’s discretion is guided by the two-step inquiry set forth in *Advanced Bionics LLC v. Med-El Electromedizinische Gerate GMBH*, IPR201901469, Paper 6 at 8-9 (Feb. 13, 2020) (“*Advanced Bionics*”) applying the factors enumerated in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”).

Becton, Dickinson identifies the following non-exclusive factors: (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during

examination and the manner in which petitioner relies on the prior art; (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments. *See Becton, Dickson*, Paper 8 at 17–18 (§ III.C.5, first paragraph).

Step (1) under *Advanced Bionics* evaluates *Becton, Dickinson* factors (a), (b), and (d), while Step (2) looks at factors (c), (e), and (f). *Advanced Bionics*, Paper 6 at 10. These factors are “to be read broadly . . . to apply to any situation in which a petition relies on the same or substantially the same art or arguments previously presented to the Office. . .”. *Id.* Significantly, when *Becton, Dickinson* factors (a) and (b) are met, the Step (1) analysis is satisfied and the Board “need not reach whether the ‘same or substantially the same arguments’ previously were presented” under factor (d). *Id.* at 20. Petitioner cannot get past Step (1), and Petitioner makes no arguments with respect to Step (2). Petitioner simply re-urges prior art reviewed and considered and arguments rejected by the Patent Office. Because Petitioner fails both Step (1) and Step (2), discretionary denial is warranted.

1. All Three References Relied Upon by Petitioner Satisfy *Advanced Bionics* Step (1).

Petitioner relies upon 3 references in its Petition: (1) U.S. Pub. No. US2008/0178369 (Kitsch) (EX1007); (2) U.S. Pat. No. 5,461,729 (Brocks)

(EX1008); and (3) PCT Pub. No. WO/67687 (Carrillo) (EX1009). Petitioner makes no argument that these references do not satisfy Step (1) of the *Advanced Bionics* test. Incredibly, Petitioner does not refer to *Advanced Bionics* at all in its petition, much less its burden of proof thereunder.

Petitioner admits that “Kitsch, Brocks, and Carrillo were cited, along with multitudes of other references, in extensive IDS submissions during prosecution....” Pet. at 94. It is beyond reasonable dispute that all the prior art references relied upon by Petitioner were previously presented to, and considered by, Examiner during prosecution. Section 325(d) provides that “[i]n determining whether to institute or order a proceeding ... the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. §325(d). “Previously presented art includes . . . art provided to the Office by an applicant, such as on an [IDS].” *See Advanced Bionics*, Paper 6 at 7–8; *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01270, Paper 10 at 13-14 (PTAB Jan. 24, 2022) (same); *Atrium Medical Corporation v. Bard Peripheral Vascular, Inc.*, IPR2021-01199, Paper 11 at 22-23, (PTAB Jan. 20, 2022) (“if the prior art asserted by Petitioner here was presented to the Office . . . during prosecution . . . *Advanced Bionics* requires us to consider *Becton, Dickinson’s* factors (a) and (b) as satisfied.”).

Substantive prosecution of the '974 Patent began with the filing of the application that matured into the '030 Patent. The '974 Patent is a continuation of the '496 Patent, which is a continuation of the '030 Patent.⁶

a. Prior Art Submitted During Prosecution of the '030 Patent

On July 28, 2011, Applicant filed the application which matured into the '030 Patent (“'030 Patent application”). It claims the benefit of provisional application No. 61/429,065 filed on December 31, 2010. *See, e.g.*, EX1004 at 331.

On April 15, 2013, 10 days before Examiner issued her First Office Action (EX1004 at 113), she signed off on all the prior art before her. Across the bottom, she typed,

“ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH /A.K./”

See EX1004 at 141-151. Included on the IDS were U.S. Pat. No. 5,461,729 (Brocks) at Cite No. 40 and U.S. Pat. No. 7,958,571 (Kitsch) (EX2002) at Cite No. 71. *Id.* at 144, 147.

⁶ *See* n.3, *supra*.

IPR No. IPR2024-01163
Patent 10,834,974

/A.K./

31

4870958

1989-10-03

WEBSTER

32

4955088

1990-09-11

TERJESEN

33

5029345

1999-07-09

ANGHELUTA et al.

34

5070869

1991-12-10

ZHANG

35

5157793

1992-10-27

MICHELS

36

5226179

1993-07-13

CHOI

37

5237706

1993-08-24

NALBANDIAN

38

5283912

1994-02-08

CHUNG

39

5379462

1995-01-10

MORGAN et al.

40

5461729

1995-10-31

BROCKS

/A.K./

41

5524298

1996-06-11

PLUNKETT

Tommy John EX1004
Page 144 of 375

/A.K./

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH

/A.K./

64

7017193

2006-03-28

AUGER

65

7024703

2006-04-11

DELLA RATTA

66

7065797

2006-06-27

CHEN

67

7178174

2007-02-20

SODERSTROM

68

7198688

2007-04-03

MORTELL et al.

69

7631369

2009-12-15

GEIWALD et al.

70

7676853

2010-03-16

CUTLIP

/A.K./

71

7958571

2011-06-14

KITSCH

U.S. PATENT APPLICATION PUBLICATIONS

Add

Remove

Examiner Initial*

Cite No

Publication Number

Kind Code*

Publication Date

Name of Patentee or Applicant of cited Document

Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear

/A.K./

1

20050268380

A1

2005-12-08

SOVELL

Tommy John EX1004
Page 147 of 375

/A.K./

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH

Examiner also placed her initials, “/A.K./”, by all of the prior art entries. *Id.* at 141-151. There is little doubt Examiner reviewed and considered Petitioner’s Brocks and Kitsch references.

Petitioner obfuscates the fact that Kitsch was before Examiner from the beginning of prosecution of the ’974 Patent by citing to Kitsch’s U.S. Pub. No. 2008/0178369 (EX1007) instead of the Kitsch issued ’571 Patent (EX2002). But the ’571 Patent clearly shows on its face, under Prior Publication Data, that U.S. Pub. No. 2008/0178369 is the same reference. *See* EX2002 at 1, (65) Prior Publication Data.

(12) United States Patent Kitsch et al.		(10) Patent No.: US 7,958,571 B2
		(45) Date of Patent: Jun. 14, 2011
(54) UNDERWEAR GARMENT FOR A MALE	2,652,053 A 9/1953 Dann 2,872,685 A 2/1959 Denbo 3,207,155 A 9/1965 Casey 3,220,410 A 11/1965 Sloan 3,283,545 A 11/1966 Simon 3,294,086 A * 12/1966 Nelkin 602/19 3,459,181 A * 8/1969 Mann 602/67 3,496,576 A * 2/1970 Artzt 2/402 3,499,442 A * 3/1970 Steinmetz 602/67 3,499,443 A 3/1970 Scheerer 3,511,234 A 5/1970 Larson 3,517,666 A * 6/1970 Atlee 602/68 3,621,846 A 11/1971 Lehman 4,009,495 A 3/1977 Faust 4,173,976 A 11/1979 Bloomquist et al. 4,195,630 A 4/1980 Connery et al. (Continued)	
(75) Inventors: William Trent Kitsch , Kelowna (CA); Craig Gollinowski , Calgary (CA)		
(73) Assignee: Saxx Apparel, Ltd. , Kelowna, BC (CA)		
(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 778 days.		
(21) Appl. No.: 12/000,966		
(22) Filed: Dec. 19, 2007		
(65) Prior Publication Data US 2008/0178369 A1 Jul. 31, 2008		
Related U.S. Application Data		
(60) Provisional application No. 60/886,545, filed on Jan. 25, 2007.		
(51) Int. Cl. A41B 9/02 (2006.01)		
(52) U.S. Cl. 2/403; 2/405		
(58) Field of Classification Search 2/400-405; 602/67, 68; 450/104 See application file for complete search history.		
(56) References Cited U.S. PATENT DOCUMENTS 2,033,551 A 3/1936 Rumery 2,254,863 A 9/1941 Weihe 2,328,953 A * 9/1943 Chatfield et al. 602/67 2,438,310 A * 3/1948 Ashe et al. 2/403 2,601,602 A 6/1952 Firshing, Sr. 2,623,210 A * 12/1952 Chatfield 450/104 2,624,336 A 1/1953 Hansley 2,641,257 A * 6/1953 Rutledge 602/67		
		<i>Primary Examiner</i> — Katherine Moran <i>Assistant Examiner</i> — Richale L. Quinn (74) <i>Attorney, Agent, or Firm</i> — Blakely, Sokoloff, Taylor & Zelman, LLP
		(57) ABSTRACT An underwear garment for use by a male, that is, a person having a penis and a scrotum, may be characterized as including a genital pouch and a pair of side panels collectively formed in a mid-section of a front wall depending from a waistband so as to bisect said front wall. The pouch may be pear-shaped when viewed from the front. A lower extremity of the pouch extends under and rearwardly of the front wall so as to form a perineum portion for covering rearwardly past the scrotum and to the perineum of the user. The pouch also has a phallus supporting portion extending forwardly of a plane generally containing the front wall and forming therein an apex portion for containing the head of the penis of the user when the penis is hanging at rest. The pouch also has a scrotum supporting portion extending from and between the phallus supporting portion and the perineum portion for containing at least a portion of the scrotum of the user. 11 Claims, 13 Drawing Sheets

It is unclear why Petitioner used the printed publication of Kitsch (EX1007) in its petition instead of the Kitsch patent (EX2002) found in the '030 Patent file history. As discussed below, the Kitsch printed publication (EX1007) shows up on the April 27, 2020, IDS during the prosecution of the '974 Patent.

There is no doubt, however, that Examiner knew about Kitsch from the beginning as Kitsch is mentioned right in the text of the '974 Patent, in the BACKGROUND section of '974 Patent family of patents:

Some existing garments are described in; Angheluta et al., U.S. Pat. No. 5,029,345; Cutlip, U.S. Pat. No. 7,676,853; Shlush, US patent

publication No. 2009/0106874; and *Kitsch et al.*, *U.S. patent application Ser. No. 12/000,966*.

See, e.g., EX1001 at col. 1, ln 28-31 (emphasis added).

b. Prior Art Submitted During Prosecution of the '496 Patent

On July 13, 2015, Applicant filed the continuation application which matured into the '496 Patent ("'496 Patent application"). It also claims the benefit of provisional application No. 61/429,065 filed on December 31, 2010. EX1003 at 1-6.⁷

⁷ For consistency and completeness of the record, Patent Owner submits the certified file histories of the '496 Patent and '030 Patent as Exhibits 2004 and 2005, respectively. Unlike Petitioner's version of the '974 Patent's file history, Petitioner's versions of the '496 Patent and '030 Patent file histories appear substantively complete. *Compare* Petitioner's '496 Patent file history (EX1003) at 246 pages *with* certified file history (EX2004) at 301 pages; *compare* Petitioner's '030 Patent file history (EX1004) at 375 pages *with* certified file history (EX2005) at 396 pages. Accordingly, for simplicity, Patent Owner cites to Petitioner's EX1003 for the '496 Patent file history and EX1004 for the '030 Patent file history.

On July 27, 2015, Applicant filed an IDS, which included Brocks and Kitsch. Included on the IDS were U.S. Pat. No. 5,461,729 (Brocks) Cite No. 43 and U.S. Pat. No. 7,958,571 (Kitsch) Cite No. 75. *See* EX1003 at 47 and 50.

On December 1, 2015, Applicant filed an IDS. EX1003 at 90-91, 85-89. Like the previous IDS submitted during the prosecution of the '030 Patent and the IDS submitted during the prosecution of the '496 Patent, the IDS included reference to Brocks and Kitsch. *Id.* at 86 entries 43 and 76.

On November 9, 2017, Examiner signed off on all of the prior art before her. Across the bottom of all IDS pages, Examiner typed:

“ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH /A.K./”

See EX1003 at 97-111. Both Brocks and Kitsch were on the same page,

39.	5226179		1993-07-13	CHOI	
40.	5237706		1993-08-24	NALBANDIAN	
41.	5283912		1994-02-08	CHUNG	
42.	5379462		1995-01-10	MORGAN et al.	
43.	5461729		1995-10-31	BROCKS	
44.	5524298		1996-06-11	PLUNKETT	
45.	5547466		1996-08-20	MCREOBERTS et al.	
46.	5598587		1997-02-04	WADA	
47.	5647065		1997-07-15	RICHERSON	
48.	5718003		1998-02-17	GWINN	
49.	5807299		1998-09-15	MCREOBERTS et al.	
50.	5870779		1999-02-16	HERON	
51.	5875495		1999-03-02	THROWER	
52.	5029345		1999-07-09	ANGHELUTA et al.	
53.	5978971		1999-11-09	WALD	
54.	6026517		2000-02-22	KANG	
55.	6353940		2000-03-12	LYDEN	
56.	6038703		2000-03-21	CHUNG	
57.	6061840		2000-05-16	ALLIGATOR	
58.	6245036		2001-06-12	MCREOBERTS et al.	
59.	6289520		2001-09-18	PAGE	
60.	6295651		2001-10-02	KANG	
61.	6308342		2001-10-30	QI	
62.	6487728		2002-12-03	COOK	
63.	6662378	B2	2003-12	VARTANYAN, Philip A.	
64.	6799334		2004-10-05	YU	
65.	6820284		2004-11-23	HORIKOSHI et al.	
66.	6862746		2005-03-08	CYM et al.	
67.	6901607		2005-06-07	ELWELL	
68.	D509945		2005-09-27	OGLE	
69.	7017193		2006-03-28	AUGER	
70.	7024703		2006-04-11	DELLA RATTA	
71.	7065797		2006-06-27	CHEN	
72.	7178174		2007-02-20	SODERSTROM	
73.	7198688		2007-04-03	MORTELL et al.	
74.	7631369		2009-12-15	GEIWALD et al.	
75.	7676853		2010-03-16	CUTLIP	
76.	7958571		2011-06-14	KITSCH	
77.	D646462	S	2011-10	ELLIS et al.	
78.	D656708	S	2012-04	ELLIS, Shawn	
79.	8555422	B2	2013-10	STEELE, Tyrone	

KILPATRICK TOWNSEND 67979841 1

Tommy John EX1003

Page 98 of 246

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGHOUT
U.S. Patent No. 10,834,974

EX1003 at 98 (entries 43 and 76). As with the prosecution of the '030 Patent, Examiner once again considered Petitioner's Brocks and Kitsch references.

c. Prior Art Submitted During Prosecution of the '974 Patent

Petitioner **omitted 1482 pages** from the '974 Patent file history (EX1002) it submitted to the Board. The complete certified file history for the '974 Patent is 1677

IPR No. IPR2024-01163
Patent 10,834,974

pages. *See* EX2001. Yet, Petitioner only included 195 pages. EX1002. There is no excuse for Petitioner's omission.

There is no doubt that Petitioner had a copy of the certified, complete '974 Patent file history as early as May 16, 2024. Patent Owner produced to Petitioner's counsel of record here and in the Litigation a certified copy of the '974 Patent file history:

Subject: Package Apparel v Tommy John - Document Production
Date: Thursday, May 16, 2024 at 2:48:50 PM Central Daylight Time
From: Sara Bean
To: joseph.raffetto@hoganlovells.com, bruce.oakley@hoganlovells.com, scott.hughes@hoganlovells.com, jacob.felicetty@hoganlovells.com, anna.shaw@hoganlovells.com
CC: John F. Luman III, Heath A. Novosad, Tim Bond
Attachments: image001.png, image385935.jpg, image120923.png, image657693.png, image261718.png, image776180.png, image022714.png, image517234.png

Counsel,

Please find the certified prosecution history for the patent in suit at the link below.

 [2024.05.16 Production \(BN3TH_TJ_001042-002718\)](#)

Thank you,



Sara Bean
Paralegal | Daniels & Tredennick PLLC
6363 Woodway Dr., Suite 700, Houston, Texas 77057
P: 713.917.0024 | D: 713.275.1376

Attorneys Licensed in

See EX2006. As seen by the Bates number range, BN3TH_TJ_001042-002718, the '974 Patent file history provided to Petitioner is 1677 pages. Petitioner had the full file history but chose not to provide it to the Board.

The full file history of the '974 Patent includes an IDS and accompanying prior art and invalidity charts from the *Package Apparel v. Rampion Matter*, a patent case involving the '030 Patent and the '496 Patent.⁸ On April 27, 2020,⁹ Applicant submitted a six-page IDS¹⁰ to Examiner plus the entries identified in Cite Nos. 8-19. *See* EX2001 at 78-1592.¹¹ This IDS likewise included U.S. Pat. No. 7,958,571 (Kitsch) (EX2002) under Cite No. 1. *See* EX2001 at 78. This IDS also included Kitsch's U.S. Pub. No. 2008/0178369 (EX1007) under Cite No. 4. *See* EX2001 at 78.

⁸ *See* n.3, *supra*.

⁹ On July 9, 2018, Applicant filed a continuation application and Preliminary Amendment which matured into the '974 Patent ("974 Patent application"). On August 8, 2018, Applicant filed an IDS, which included Brocks and Kitsch. Included on the IDS were U.S. Pat. No. 5,461,729 (Brocks) Cite No. 44 and U.S. Pat. No. 7,958,571 (Kitsch) Cite No. 77. *See* EX1002 at 62 and 63.

¹⁰ The first two pages of the April 27, 2020, IDS are found at EX2001 at 148-149.

¹¹ Petitioner also did not include prior art that Applicant filed with a subsequent IDS on May 8, 2020, which included prior art videos produced in the *Package Apparel v. Rampion Matter*. *See* EX2001 at 1594-1608.

The IDS further identified Carrillo (EX1009) under Cite No. 8. *See* EX2001 at 78. The first reference Examiner saw after the IDS was Carrillo. *See* EX2001 at 88-97. As discussed below, contrary to Petitioner’s characterization of Carrillo, Carrillo is cumulative or substantially the same as Shlush, prior art previously before Examiner, thus warranting denial of institution. *See* 35 U.S.C. §325(d).

Under Cite No. 12 of the IDS, Applicant identified a Declaration of Erin C. Kolter from the *Package Apparel v. Rampion Matter*. *See* EX2001 at 79. The Kolter Declaration provided Examiner with a roadmap to the prior art submissions. *See* EX2001 at 150-157. Attached as Exhibit 5 to the Kolter Declaration was Defendant Rampion Enterprises Ltd.’s Third Supplemental Disclosure of Preliminary Invalidity Contentions. *See* EX2001 at 418-442. On page four, Rampion alleged, “The following prior art anticipates or renders obvious the claims asserted against Defendants under 35 U.S.C. §§102/103.” EX2001 at 420.

IPR No. IPR2024-01163
Patent 10,834,974

Case 2:18-cv-01464-JLR Document 61-5 Filed 08/15/19 Page 4 of 26

1 properly named as an inventor on the applications that issued as the Patents-In-Suit, there would

2 be no common inventor between the provisional application and the applications that issued as the

3 Patents-In-Suit.

4 Further, the applications that issued as the Patents-In-Suit are in the name of the wrong

5 inventive entity, and thus the Patents-In-Suit are invalid.

6 If Plaintiffs are permitted to modify any assertion or contention in their Infringement

7 Contentions, or present any new assertion or contention relevant to these Preliminary Invalidity

8 Contentions, Defendants will similarly seek leave to amend their Preliminary Invalidity

9 Contentions to address Plaintiffs’ new contentions.

10 Defendants’ contentions herein are not admissions, suggestions, or adoptions as to any

11 particular claim scope or construction. Similarly, Defendants’ contentions are not admissions,

12 suggestions, or adoptions as to any invention or priority date or as to any admission that any of

13 Defendants’ products or services, including those which Plaintiffs have accused of infringement,

14 infringe any of the asserted claims, either directly, indirectly, or under the doctrine of equivalents.

15 Further, these Preliminary Invalidity Contentions are made under a variety of alternative theories

16 and do not represent Defendants’ agreement or view as to, for example, the definiteness of, written

17 description support for, or enablement of, any asserted claim.

18 **II. Identification of Prior Art**

19 The following prior art anticipates or renders obvious the claims asserted against

20 Defendants under 35 U.S.C. §§102/103.

Reference	Publication or Filing Date
Pub. No. US 2004/0025218 A1 (Huang) (the “218 Publication”)	Published Feb. 12, 2004
WO 01/37687 A1 (Carrillo, et al.) (“WO 01/37687”)	Published May 31, 2001

DEFENDANTS’ PRELIMINARY INVALIDITY CONTENTIONS - 3
2:18-cv-1464-JLR

DORSEY & WHITNEY LLP
COLUMBIA CENTER
100 PIONEER SQUARE, SUITE 4000
SEATTLE, WASHINGTON 98101
PHONE: (206) 455-5000
FAX: (206) 455-4000
Package Apparel EX2001
Page 420 of 1677

Case 2:18-cv-01464-JLR Document 61-5 Filed 08/15/19 Page 5 of 26

1 U.S. Patent No. 7,958,571 (Kitsch, et al.) (the

2 “571 Patent”)

3 Filed Dec. 19, 2007
Published July 31, 2008
Issued June 14, 2011

4 Pub. No. US 2008/0178369 A1 (Kitsch, et al.)

5 Published July 31, 2008

6 Pub. No. US 2007/0277285 A1 (Gravette, et al.)

7 Published Dec. 6, 2007

8 (the “285 Publication”)

9 Pub. No. US 2009/0106874 A1 (Shlush)

10 Published April 30, 2009

11 (the “874 Publication”)

12 WO 98/39981 (Hartley)

13 Published Sept. 17, 1998

14 (the “981 Publication”)

15 European Patent Application No. EP 0 476 818 A1

16 Published March 25, 1992

17 (Dagg, et al.)

18 (“EP 0 476 818”)

19 Canadian Industrial Design Registration No. 133058 (KE Imports)

20 Registered and Published June 17, 2010

21 (the “058 Design”)

22 U.S. Patent No. 7,631,369 (Geiwald, et al.)

23 Issued Dec. 15, 2009

24 (the “369 Patent”)

25 Published Sept. 27, 2007 (Pub. No. US 2007/0220660 A1)

Pub. No. US 2007/0220660 A1 (Geiwald, et al.)

Published Sep. 27, 2007

AC1000091-AC1000092, titled Show-It 2009 Line Sheet (“Show-It 2009 Line Sheet”). The Show-It 2009 Line Sheet was produced by third-party Andrew Christian, Inc. on April 24, 2019 and produced to Plaintiffs on April 25, 2019. The front

DEFENDANTS’ PRELIMINARY INVALIDITY CONTENTIONS - 4
2:18-cv-1464-JLR

DORSEY & WHITNEY LLP
COLUMBIA CENTER
100 PIONEER SQUARE, SUITE 4000
SEATTLE, WASHINGTON 98101
PHONE: (206) 455-5000
FAX: (206) 455-4000
Package Apparel EX2001
Page 421 of 1677

See EX2001 at 420-421. The first three out of four entries under “II. Identification of Prior Art” identified for Examiner the same prior art Petitioner now relies on in its petition. Thus, Examiner was well aware of these references.

On June 26, 2020, 2 months after receiving the IDS and prior art submissions from the *Package Apparel v. Rampion Matter*, Examiner signed off on ALL the prior art before her. Across the top every IDS, Examiner identified the date the IDS was received and that all the references were considered. See EX2001 at 1618-1631. For example, Examiner typed across the 08/08/2018 IDS the following:

IPR No. IPR2024-01163
Patent 10,834,974

Receipt date: 08/08/2018

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /K.M.M./

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Field

PTO/GB/66a (01-10)

Approved for use through 07/31/2012, OMB 0551-0031
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	16/030,769
	Filing Date	July 9, 2018
	First Named Inventor	Dustin Douglas Bigney
	Art Unit	3765
	Examiner Name	Anna Kathryn Kinsaul
	Attorney Docket Number	098622-1095233

56	6038703	Mar 21, 2000	Chung
57	6061840	May 16, 2000	Alligator
58	6245036	Jun 12, 2001	Mcroberts et al
59	6289520	Sep 18, 2001	Page
60	6295651	Oct 2, 2001	Kang
61	6306342	Oct 30, 2001	Qi
62	6353940	Mar 12, 2002	Lyden
63	6487728	Dec 3, 2002	Cook
64	6662378	Dec 16, 2003	Vartanyan
65	6798334	Oct 5, 2004	Yu
66	6820284	Nov 23, 2004	Horikoshi et al.
67	6862746	Mar 8, 2005	Cym et al.
68	6901607	Jun 7, 2005	Elwell
69	D508945	Sep 27, 2005	Ogle
70	7017193	Mar 28, 2006	Auger
71	7024703	Apr 11, 2006	Della Ratta
72	7065797	Jun 27, 2006	Chen
73	7178174	Feb 20, 2007	Soederstrom
74	7198688	Apr 3, 2007	Mortell et al
75	7631369	Dec 15, 2009	Gehwald et al.
76	7676853	Mar 16, 2010	Cutlip
77	7958571	Jun 14, 2011	Kitsch et al.
78	D646462	Oct 11, 2011	Ellis et al.
79	D656708	Apr 3, 2012	Ellis
80	8555422	Oct 15, 2013	Steele
81	9687030	Jun 27, 2017	Bigney et al.
82	10034496	Jul 31, 2018	Bigney et al.

U.S. PATENT APPLICATION PUBLICATIONS

Pakage Apparel EX2001
Page 1620 of 1677

EX2001 at 1620 (“Receipt date: 08/08/2018 ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /K.M.M./”).

Similarly, on the April 27, 2020, IDS Examiner provided:

IPR No. IPR2024-01163
Patent 10,834,974

Receipt date: 04/27/2020 ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /K.M.M./

Doc code: IDS
Doc description: Information Disclosure Statement (IDS) Filed
Approved for use through 07/31/2012. OMB 0651-0021
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	16/030,769
	Filing Date	July 9, 2018
	First Named Inventor	Dustin Douglas Bigney
	Art Unit	3765
	Examiner Name	
	Attorney Docket Number	098622-1095233

U.S. PATENTS					
Examiner Initials*	Cite No	Patent Number	Kind Code	Issue Date	Name of Patentee or Applicant of cited Document
	1.	7,958,571	B2	2011-06-14	William Trent Kilch et al.
	2.	7,631,389	B2	2005-12-15	Paul Urban, Schmidt et al.

U.S. PATENT APPLICATION PUBLICATIONS					
Examiner Initials*	Cite No	Publication Number	Kind Code	Publication Date	Name of Patentee or Applicant of cited Document
	3.	2004/0025218	A1	Feb 12, 2004	Do-Li Huang
	4.	2006/0178369	A1	July 31, 2006	William Trent Kilch
	5.	2007/0272285	A1	Dec 6, 2007	Eugene S. Gravette et al.
	6.	2009/0106674	A1	April 30, 2009	Jacob Shkuts
	7.	2007/0220960	A1	Sept 27, 2007	Martin Roesch et al.

FOREIGN PATENT DOCUMENTS					
Examiner Initials*	Cite No	Foreign Document Number*	Country Code*	Kind Code*	Publication Date
/K.M.M./	8.	01/37687	WO	A1	May 31, 2001
/K.M.M./	9.	98/39981	WO		Sept 17, 1998
/K.M.M./	10.	EP 0 475 818	EP	A1	March 25, 1992
/K.M.M./	11.	133058	CA		June 17, 2010

3

Package Apparel EX2001
Page 1628 of 1677

Receipt date: 04/27/2020 ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /K.M.M./

Doc code: IDS
Doc description: Information Disclosure Statement (IDS) Filed
Approved for use through 07/31/2012. OMB 0651-0021
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	16/030,769
	Filing Date	July 9, 2018
	First Named Inventor	Dustin Douglas Bigney
	Art Unit	3765
	Examiner Name	
	Attorney Docket Number	098622-1095233

NON-PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	1*
/K.M.M./	12.	United States District Court for the Western District of Washington at Seattle DECLARATION OF ERIN C. KOLTER IN SUPPORT OF MOTION FOR LEAVE TO AMEND with Exhibits Civil Action No. 2:18-cv-1464-JLR, 09/12/19 B.C. LTD., a Canadian corporation and PARADISE APPAREL, INC., a Canadian corporation, Plaintiffs, v. RAMPCON USA INC., a Washington corporation, and RAMPCON ENTERPRISES LTD., a Canadian corporation, Defendants. Filed August 15, 2019. 1457 pages.	
/K.M.M./	13.	ANDREW CHRISTIAN 2009-2010 Collection Show-it with Show-it Technology 2.0 for Maximum Front Enhancement ("Show-it 2009-2010 Catalog"), allegedly available 2009-2010, 9 pages.	
/K.M.M./	14.	ANDREW CHRISTIAN, 9132 Show-it brief.jpg - allegedly metadata document properties show that the created date and last modified date are both February 6, 2009, 1 page.	
/K.M.M./	15.	ANDREW CHRISTIAN, 9133 Show-it Boxer F & B.jpg - allegedly metadata document properties show that the created date and last modified date are both February 6, 2009, 1 page.	
/K.M.M./	16.	UNDERWEAR NEWS BRIEFS, A MEN'S UNDERWEAR BLOG, "Andrew Christian Show-it Technology Brief Advertisement" products in Style No. 9132 and Style No. 9133, pulled from the internet on April 21, 2020 https://www.underwearnewsbriefs.com/2009/03/andrew-christian-show-it-technology-brief/ Allegedly on sale and/or publicly used or known at least as early as March 6, 2009, 4 pages.	
/K.M.M./	17.	UNDERWEAR NEWS BRIEFS, A MEN'S UNDERWEAR BLOG, "Andrew Christian Underwear of the Week- Andrew Christian 'Show-it' Line" Press Release - pulled from the internet on April 21, 2020 https://www.underwearnewsbriefs.com/2009/03/andrew-christian-underwear-of-the-week- allegedly on sale and/or publicly used or known at least as early as March 11, 2009, 4 pages.	

4

Package Apparel EX2001
Page 1629 of 1677

EX2001 at 1628-29 ("Receipt date: 04/27/2020 ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /K.M.M./").

To remove all doubt that Examiner reviewed and considered all of the art in the April 27, 2020, IDS, in addition to the statement across the top of the IDS, Examiner specifically initialed the references with "/K.M.M./" under FOREIGN PATENT DOCUMENTS and NON-PATENT LITERATURE DOCUMENTS. EX2001 at 1628-1630. Those references included Carrillo and the Declaration of Erin C. Kolter. EX2001 at 1628-1629.

*

*

*

As detailed above, not only were Petitioner’s prior art references submitted by Applicant on an IDS, but Examiner reviewed, considered, and signed off on all of them. Since “previously presented art includes . . . art provided to the Office by an applicant, such as on an [IDS],” Petitioner fails to overcome Step (1) of the *Advanced Bionics* framework. *See Advanced Bionics*, Paper 6 at 7–8.

2. Petitioner and Prior Art Fail to Satisfy *Advanced Bionics* Step (2).

As detailed in Step (1), there is no question Petitioner’s prior art was before Examiner during prosecution, warranting denial of the petition. But Petitioner utterly fails to address Step (2) of the *Advanced Bionics* framework, instead attempting to lie in wait to see what Patent Owner argues.¹² It is not Patent Owner’s burden to disprove Step (2) of the *Advanced Bionics* framework. Neither Petitioner nor its expert address the *Advanced Bionics* Step (2) factors. Petitioner provides no

¹² Petitioner seems to acknowledge its burden under *Advanced Bionics* but attempts to burden shift in its petition as evidenced by this statement, “Should Patent Owner raise a *Fintiv* or §325(d) challenge, petitioner intends to respond to any such arguments.” Pet. at 94 n.10. Under 35 U.S.C. §325(e), Petitioner always carries the burden of proof.

argument nor facts supporting *Becton, Dickinson* factors (c), (e), and (f). As a result, the Board must deny the petition under Step (2).

Not surprisingly, Petitioner fails to provide a fulsome accounting of the detailed prosecution history of '974 Patent family. In fact, Petitioner mentions no substantive details whatsoever. Pet. at 6-7. In so doing, of course, Petitioner necessarily fails Step (2)'s factor (e), "whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art." Nowhere does Petitioner even mention examiner error. The petition is equally devoid of support for factors (c) and (f).

Notwithstanding Petitioner's failures, Patent Owner addresses Petitioner's prior art to remove all doubt that the Board should deny the petition.

Petitioner's prior art was not "merely listed on an IDS;" instead, there is clear evidence that Examiner thoroughly analyzed Petitioner's prior art. *See BMW of North America LLC and Mercedes-Benz USA, LLC v. Stragent, LLC*, IPR2021-00419, Paper 14 at 15 (PTAB 2021) (Informative) (denying institution of an IPR where the patent owner submitted evidence that a petitioner's prior art was not "merely listed on an IDS" but instead was subject to extensive discussions between the patent owner and the examiner). As discussed in Section IV.A.1.c above, during the prosecution of the '974 Patent, Applicant submitted an IDS with a Declaration of Erin C. Kolter, which provided Examiner with a detailed description of prior art

(including that cited by Petitioner here) and an adverse litigant's invalidity contentions and claim charts as to how that prior art allegedly rendered the '974 Patent invalid. *See* EX2001 at 79, 150-157, 418-442. There can be no doubt that Examiner, who signed off on all prior art before her, was well-educated – including by an adverse litigant – on Petitioner's prior art.

a. The Board Must Deny Institution Based on Ground 1 Because Kitsch in view of Brocks Fail to Teach or Make Obvious Claims 1-13 and 15-16.

Petitioner impermissibly uses the '974 Patent as a roadmap to arrive at its invalidity destination. In the process, Petitioner attempts to morph Kitsch into something it is not. Petitioner also fails to demonstrate any motivation to combine Kitsch and Brocks, other than they are both underwear. But, in the end, Brocks is of no moment because Kitsch fails to teach the “stretch panel” of the '974 Patent.

From the outset, Petitioner focuses on form over substance in its petition by coloring the pouch of Kitsch and the pouch of the '974 Patent the same color, then saying “the ‘front portion’ of Kitsch looks strikingly similar to that of the '974 Patent.” Pet. at 10. Of course, that demonstrates nothing. Indeed, Examiner cited to many prior art references with pouches, including U.S. Pub. No. 2009/0106874 (Shlush) (EX2003). Shlush, cited by Examiner during prosecution of the '030 Patent, includes a pouch figure (Figure 3) similar in look to Figure 7 of the '974 Patent.

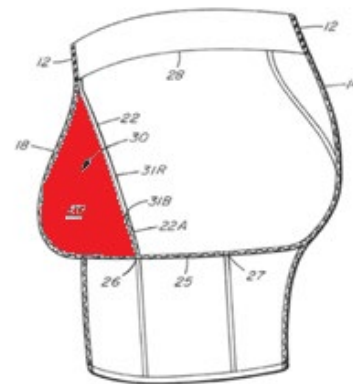
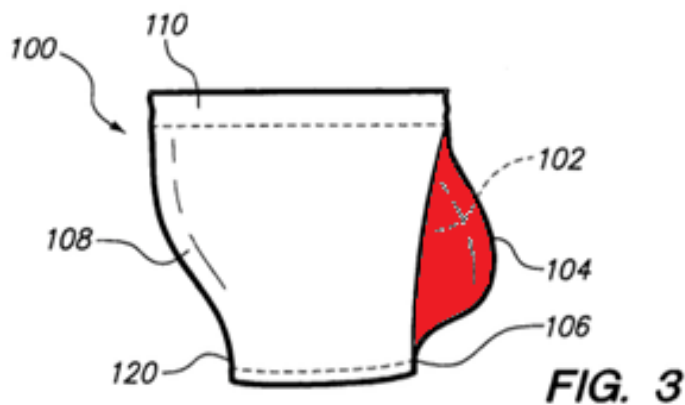


FIG. 7

Compare EX1007 FIG. 3 with EX1001 FIG. 7. In fact, in the First Office Action in the '030 Patent prosecution, Examiner rejected claims as obviousness under 35 U.S.C. §103(a) due to Shlush:

Shlush discloses a men's garment (Figs. 1-3) comprising: a waistband (110); a front portion (104) depending downwardly from the waistband (Fig. 3), the front portion formed to provide a pouch at a mid-section thereof (Figs. 1 and 3), the pouch shaped to contain a wearer's penis and scrotum when the garment is worn (Paras. [0011, 0025, and 0037]); a stretch panel (114) attached behind the pouch (Para. 0024) and defining an opening (116) into the pouch (Paras. 0025 and 0026), the stretch panel having a bottom portion (Fig. 2) connecting opposing side portions (120) and whereby, in use, the scrotum of a wearer of the garment is supported underneath by the stretch panel to contain a wearer's penis and scrotum in the pouch (Paras. [0010, 0011, and 0025]; the stretch panel's opening at least supports the scrotum by providing access to the pouch which holds the genitalia providing comfort).

EX1004 at 121 (emphasis added). Thus, Kitsch (EX1007) brought nothing new to Examiner with respect to pouches and purported stretch panels.

Petitioner becomes its own lexicographer and purportedly identified a “stretch panel” in Kitsch. With respect to Petitioner’s element “**1[c]: a stretch panel attached to the body inside the front portion,**” Petitioner completely ignores the design and purpose of the ’974 Patent’s stretch panel 22 when making up its contrived “stretch panel,” and alleges that a pair of separate side panels in Kitsch should be interpreted as a single “stretch panel” within the meaning of that term in the ’974 Patent. The ’974 Patent provides:

Stretch panel 22 includes an opening 30 to receive a wearer's genitalia.

In the illustrated embodiment, opening 30 is U-shaped and has a softly-bound edge 31. Alternatively, stretch panel 22 may be shaped such that the free inner edges 31A and 31B along the sides of opening 30 become closer together in their parts near waistband 11 such that opening 30 is more tear-drop shaped. In yet other embodiments, the upper parts of edges 31A and 31B may be adjacent each other, or joined together such that opening 30 has an oval or elliptical shape (not shown). *Regardless of the particular shape of opening 30 stretch panel 22 is configured to define opening 30 and to provide support around and underneath the scrotum of the wearer in order to comfortably position the wearer's genitals forward into pouch 20.*

EX1001 at Col. 3, lns. 5-19 (emphasis added). Thus, the stretch panel 22 of the '974 Patent includes an opening and provides support around and underneath the scrotum of the wearer in order to comfortably position the wearer's genitals forward into pouch 20.

Kitsch has no such stretch panel. In contrast, Kitsch provides separate “side panels.” The “side panels 12 are formed of two separate and substantially parallel pieces of mesh fabric attached to the laterally spaced apart pouch seams 20.”

EX1007 at [0027]. As for function, Kitsch provides:

The side panels 12 form a pair of generally parallel fences which extend upwardly from, and along, seams 20 so as to extend their uppermost edges 12 a upwardly substantially completely into the crack or fold between the laterally outer sides of scrotum 14 and the top of the inner thighs, that is, along the fold of skin where the top of the inner thighs join the top of the scrotum along a lower-most aspect of the abdomen of user 8. This joint, where the inner thighs and scrotum join along a fold line, is defined generally by both the shape and the location when worn of the upper-most arcuate edges 12 a of side panels 12. The side panels are preferably thin sheets of elasticized breathable wicking mesh knit, one sheet per panel and form a substantially parallel pair of opposed wicking fences which are positioned unobstructively substantially completely up into the fold line between the scrotum and inner thigh to thereby inhibit chaffing and to draw moisture away from where there would ordinarily be skin-to-skin contact and rubbing. Side panels 12 provide for an enlarged moisture evaporation surface area on

the wicking material as relative movement between the thighs and scrotum, for example due to athletic activity, draws cooler air upwardly into the brief or otherwise through the brief material so as to flow over the wicking material, evaporating moisture wicked from the fold and thereby providing cooling or the sensation of cooling. The two 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.

EX1007 at [0028] (emphasis added). As Kitsch states, the side panels are parallel fences. Kitsch does not have any sort of stretch panel like the '974 Patent. The stretch panel in the '974 Patent is a single stretch panel that lifts and supports a scrotum, while Kitsch merely has side panels that separate a scrotum from the inner thighs. There is nothing in the '974 Patent to disclose or suggest that the “stretch panel” defined therein includes embodiments where the “stretch panel” is actually multiple panels. Nor is there anything in Kitsch to disclose or suggest that the side panels defined therein could be a single stretch panel. The invention claimed in the '974 Patent, having a single stretch panel instead of multiple side panels, is inventive and offers clear advantages over the embodiments described in Kitsch.

Petitioner's arguments for Kitsch having a stretch panel become even more attenuated with respect to Petitioner's elements 1[d]-1[g], all of which require a stretch panel. For example, in Petitioner's element 1[e][iv] *[the stretch panel*

having] “*an opening for receiving a wearer’s genitals,*” Petitioner claims Kitsch’s “stretch panel” meets this element because “Kitsch’s side panels include an ‘opening’ for receiving a wearer’s genitals” due to the fact that “the side panels are ‘laterally spaced apart,’ and the space between the panels forms an opening....” Pet. at 19. Simply stated, Petitioner’s argument is the space between a pair of laterally spaced apart, separate and substantially parallel fabrics is an opening. Nowhere in Kitsch is such a statement made about its side panels.

While not shown on the Printed Publication of Kitsch (EX1007), during prosecution of Kitsch’s ’571 Patent, Kitsch amended claim 1 by adding “a pair of laterally spaced apart, separate and substantially parallel side panels” to traverse Examiner’s rejection based on Stankowski.¹³ *See* EX2010 at 20-27, 21 (underline in original); *compare* EX2002 Claim 1 *with* EX1007 Claim 1. Specifically, Kitsch stated this about his invention when distinguishing it from Stankowski:

Most significantly, Stankowski does not *disclose* a pair of laterally spaced apart, separate and substantially parallel side panels. What the Examiner characterized as the Stankowski “panels,” element 23 of Figure 3, appears to be part of a unitary piece of fabric looping under

¹³ Stankowski *et al.*, U.S. Pub. No. 2006/0162052, was on the original IDS filed in the ’030 Patent prosecution. As discussed above, like all references submitted to Examiner, she considered it and initialed next to it. *See* EX1004 at 148.

the scrotum. In contrast, claim 1 recites separate, vertical and substantially parallel side panels that are distinct from the pouch and distinct and separate from one another. In this respect, claim 1 has been amended to emphasize the unconnected aspect of the panels by specifying that they are "separate."

Thus, Stankowski fails to disclose a pair of laterally spaced apart, separate and substantially parallel side panels, or any motivation to provide such separate panels. In fact, although Stankowski discloses several embodiments of their invention, none of those embodiments includes these aspects recited in claim 1. Therefore, Stankowski does not teach each of the elements of claim 1. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 1 are requested.

EX2010 at 24 (emphasis in original); *see* EX2010 at 20-27. If there was ever any doubt, Kitsch clearly discloses a pair of laterally spaced apart, separate and substantially parallel side panels. *Id.* Kitsch does not disclose a stretch panel as disclosed in the '974 Patent.

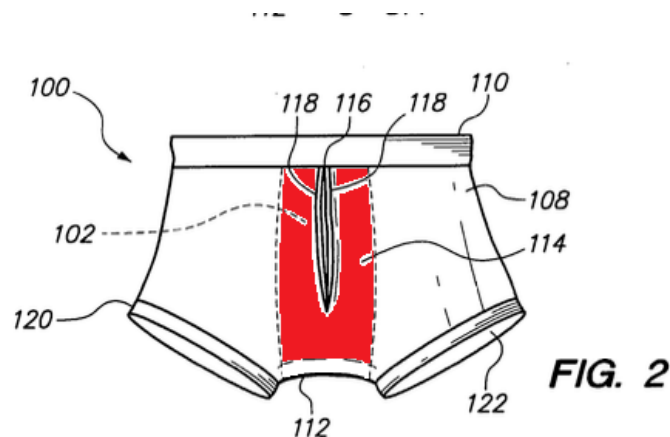
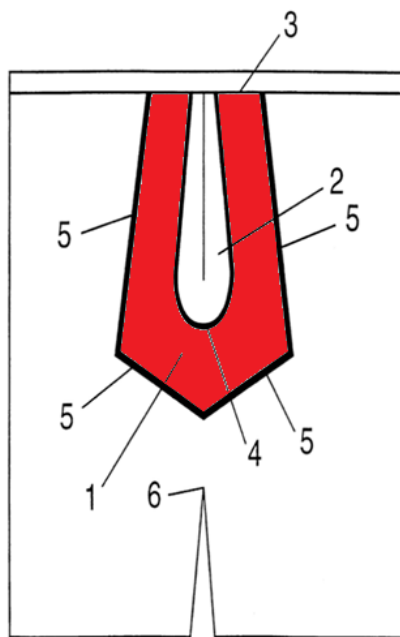
There is nothing in Brocks that addresses this clear shortcoming of the Kitsch reference, nor anything that renders it obvious. As a result, combining it with Kitsch does not render the '974 Patent obvious because Kitsch does not include a stretch panel.

For the foregoing reasons, Kitsch does not include the "stretch panel" of Claim 1. Claims 2-13 and 15-16 all depend from Claim 1. As a result, Kitsch

(EX1007) in view of Brocks (EX1008) fails to teach or make obvious, either alone or in combination with Brocks, Claims 1-13 and 15-16 of the '974 Patent.

b. The Board Must Deny Institution Based on Ground 2a Because Carrillo in view of Brocks Fails to Teach or Make Obvious Claims 1-9, 11, 13, 16.

Petitioner tries the splash approach again by coloring the Carrillo Fig. and '974 Patent Fig. 4 in red and stating "Carrillo's U-Shaped elastic stretch panel is strikingly similar to the '974's stretch panel." Pet. at 50. Of course, that is not the standard for obviousness. Almost identical prior art was cited by Examiner during the prosecution of the '030 Patent. Indeed, when you compare the figure of Carrillo with Fig. 2 of Shlush, which Examiner cited, they look very similar:



Compare Carrillo Fig (EX1009) with Shlush Fig. 2 (EX2003). But the similarities do not stop there. Carrillo's stated invention and purpose included:

(57) Abstract: The invention relates to a hygienic elastic garment for men's underwear, which forms part and is sewn to classic underpants. It has a tear-shaped vertical opening extending from the elastic on the waistband of the underpants up to a given distance above the sewing in the top block depending on the model. By introducing the testicles through said opening, the base of said opening is located between the testicles and the groin. 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, thereby reducing contact and direct friction between the testicles and the groin. Said garment can provide relief for many individuals who suffer from itching, eczema, rash. etc. caused by perspiration and friction.

EX1009. Shlush (EX2003) described his garment in similar fashion:

[0008] Briefly, and in general terms, the present invention provides a new and improved article of clothing comprising boxer-brief type underwear having an internal pocket and an external pouch for use by men and boys. The internal pocket and the external pouch of the boxer-brief type underwear are formed inside of the front panel of the boxer-brief type underwear for capturing and separating the male scrotum and genitalia from the male body. This clothing article design incorporating the internal pocket and the external pouch functions to provide adequate space and comfort, to minimize perspiration and irritation in the scrotum area, to absorb accidental leakage of fluid body waste, and to eliminate stains and exposure of the body to the fluid body waste resulting from the accidental leakage within the inventive underwear.

Thus, the personal hygiene of the person wearing the inventive boxer-brief type underwear is improved.

EX2003 at [0008]. Like Kitsch, Examiner knew about Shlush from the beginning, as Shlush is mentioned in the BACKGROUND section of '974 Patent family of patents:

Some existing garments are described in; Angheluta et al., U.S. Pat. No. 5,029,345; Cutlip, U.S. Pat. No. 7,676,853; *Shlush, US patent publication No. 2009/0106874*; and Kitsch et al., U.S. patent application Ser. No. 12/000,966.

See, e.g., EX1001 at col. 1, ln 28-31 (emphasis added); Section IV.A.1.a, *supra*.

According to Carrillo, his garment includes an opening (2) in the shape of a vertical teardrop (2) from the elastic (3) of the waistband of the brief to a distance above the seam of the inseam (6) of the brief with the base of the opening (4) located between the testicles and the groin. *See* EX1009 and EX1010 at 2. Carrillo provides no additional details as to how the “hygienic garment” is sewn to classic underpants, apart from saying that it is “sewn to the inner front part of underwear.”

On October 25, 2013, Examiner issued an extensive First Office Action during the prosecution of the '030 Patent. EX1004 at 113-130. Examiner rejected all originally filed claims in the '030 Patent application due to obviousness under 35 U.S.C. §103(a). The original claims included two independent claims, 1 and 9. Examiner rejected claim 1 under Section 103(a) as being unpatentable over U.S. Pat.

No. 2,235,849 (Reis I) in view of U.S. Pat. Pub. 2006/000008 (Chong). With respect to claim 9, Examiner rejected it under Section 103(a) as being unpatentable over U.S. Pat. Pub. 2009/0106874 (Shlush). Shlush looked remarkably like Petitioner's asserted Carrillo reference. With respect to Shlush, Examiner described Shlush like Carrillo described his garment (above):

Shlush discloses a men's garment (Figs. 1-3) comprising: a waistband (110); *a front portion (104) depending downwardly from the waistband (Fig. 3), the front portion formed to provide a pouch at a mid-section thereof (Figs. 1 and 3), the pouch shaped to contain a wearer's penis and scrotum when the garment is worn* (Paras. [0011, 0025, and 0037]); a stretch panel (114) attached behind the pouch (Para. 0024]) and defining an opening (116) into the pouch (Paras. 0025 and 0026]), the stretch panel having a bottom portion (Fig. 2) connecting opposing side portions (120) and whereby, in use, the scrotum of a wearer of the garment is supported underneath by the stretch panel to contain a wearer's penis and scrotum in the pouch (Paras. [0010, 0011, and 0025]; the stretch panel's opening at least supports the scrotum by providing access to the pouch which holds the genitalia providing comfort).

EX1004 at 121 (emphasis added); *compare with* EX1010 at 2. According to Examiner's summary of Shlush, the disclosure of Shlush was substantively the same as Carrillo. Thus, Carrillo, through the disclosure of Shlush, was reviewed and considered during examination and was the basis for rejection by Examiner during

prosecution of the '030 Patent. Carrillo is substantially the same as Shlush, warranting denial of institution by the Board. 35 U.S.C. §325(d).

On October 22, 2013, Examiner conducted a video conference during which the applicant showed the undergarment of the claimed invention. EX1004 at 172. Applicant and Examiner discussed prior art references Reis and Chong. *Id.*

On October 25, 2013, Applicant responded to the first office action by amending claim 9 to be dependent from claim 1 and amended claim 1. Claim 9 recited "in use, the scrotum of a wearer of the garment is supported underneath by the stretch panel." EX1004 at 161. Applicant responded to Examiner's rejection by stating the following about Shlush:

Shlush, as understood, discloses men's underwear with a front panel and a rear panel. The rear panel is attached to the back of the front panel and has a vertical slit through which male genitalia can be passed (see para. [0025]). The front panel and rear panel are "essentially congruent" (at para. [0024]) and are stitched together around the edges, thereby creating an internal "pocket" between them that may receive the wearer's genitalia (see paras. [0024]). A shaped pouch can be attached to the front panel of the underwear to provide more room for the genitalia.

Shlush does not disclose "the scrotum of a wearer of the garment is supported underneath by the stretch panel". Shlush teaches a slit through which the wearer's genitalia may be inserted, but does not

teach any mechanism by which the genitalia are supported by the stretch panel. The "slit-shape" (at para. [0025]) taught by Shlush is not suited to supporting the wearer's genitalia, as it provides no supporting surface underneath the genitalia.

Further, Shlush fails to disclose the features not disclosed by Reis and Chong, discussed above in connection with claim 1.

EX1004 at 162.

On January 9, 2014, in response Applicant's arguments from October 25, 2013, Examiner rejected all pending claims based on new prior art. *See* EX1004 at 177-78. Examiner rejected all pending claims of in the '030 Patent application due to obviousness under 35 U.S.C. §103(a). EX1004 at 174-192. Examiner rejected claim 1, the only independent claim, under Section 103(a) as being unpatentable over U.S. Pub. No. 2007/0277285 (Gravette) in view of U.S. Pat. Pub. 2005/0229293 (Miller). EX1004 at 181. Referring to figures 7-11, and with reference to the added color in figure 8 (below), Examiner stated,

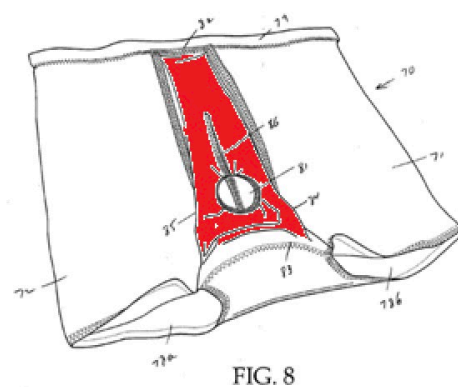
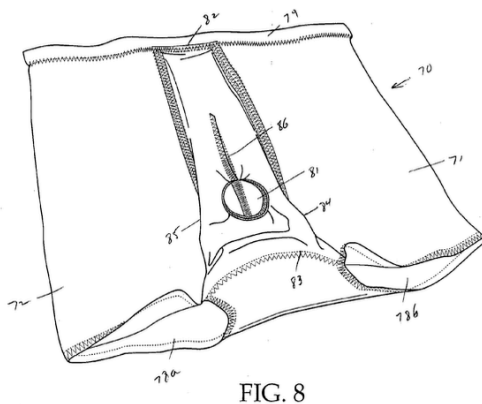
Regarding Claim 1, Gravette discloses a male garment (Figs. 7-11) comprising: a body including a front portion (Fig. 7) and having leg openings (78a, 78b) for a wearer's legs, the body including a crotch panel (73) extending between the leg openings and joined to the front portion along a first seam (77); a waistband attached at an upper edge of the body (79); a stretch panel (Fig. 8) attached to the body inside the front portion, the stretch panel comprising a sheet of material (Para.

[0035]) having a top edge attached to the body at the waistband (82), a bottom edge attached at the first seam (83), side edges attached to the body at side seams (Fig. 8) extending substantially continuously along either side of the front portion from the first seam to the waistband (Fig. 8) and an opening (81) for receiving the wearer's genitals, the opening having a rounded bottom edge (Figs. 8-10) and opposing side edges that are spaced apart from one another on either side of the opening (Figs. 8-10); such that the front portion is gathered from side-to-side and top-to-bottom by the stretch panel (Figs. 8 and 10) whereby a three-dimensional pouch (Fig. 11) for receiving the wearer's genitals and holding the wearer's genitals while the garment is being worn is defined between the stretch panel and the front portion (Fig. 11). Gravette does not disclose where the stretch panel is a four-way stretch material (stretchable top to bottom and left to right). However, Miller teaches an underwear garment utilizing four-way stretch material (Para. [0020]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used four-way stretch material in the underwear garment of Gravette as taught by Miller; because Miler teaches that it is known in the art to use four-way stretch material in undergarments and it is beneficial because it provides support and retains its original shape after being stretched, worn, or repeatedly washed (Para. [0020]). Furthermore, it has been held that it to be within the skill of one of ordinary skill to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Gravette/Miller disclose the invention as claimed above. They do not disclose where the stretch panel has an unstretched length smaller than a length measured along the front panel between the first seam and the waistband and an unstretched width smaller than a length measured along the front panel between the side seams. However, since the previous structure of the claim has been met by the prior art, the structure must also have the same characteristics of the stretch panel having an unstretched length smaller than a length measured along the front panel between the first seam and the waistband and an unstretched width smaller than a length measured along the front panel between the side seams.

EX1004 at 181-182. The following is an annotated version of figure 8,



On July 8, 2014, Applicant filed a Request for Continued Examination (RCE).

EX1004 at 205-221. Applicant amended claim 1 to clarify the stretch panel is four-

way material. EX1004 at 209. Applicant's Remarks explained several reasons why the prior art did not render the invention obvious, including:

Gravette fails to disclose several of the features recited by claim 1. In particular, as is clearly visible in Figs. 8 and 1, the front panel of the undergarment shown in Gravette is not gathered by the pouch. To the contrary, Gravette discloses the opposite configuration - the front panel lays flat as in a conventional set of men's undergarments, and the pouch hangs loosely behind it.

Claim 1, by contrast, recites that the front portion is gathered from side-to-side and top-to-bottom by the stretch panel. This provides a pouch which is naturally held open to receive a wearer's genitals as illustrated, for example, in Figures 9 and 14 of the present application.

The Examiner concedes that Gravette and Miller do not disclose "the stretch panel having a length when unstretched smaller than a length measured along the front panel between the first seam and the waistband and a width when unstretched smaller than a length measured along the front panel between the side seams" (hereinafter the "recited lengths"), as recited in claim 1. However, the Examiner expresses the view that this feature can be presumed to be obvious because the structure shown in the prior art is allegedly the same as the structure recited in claim 1.

In the present case, a difference in structure can be clearly seen in Figure 8 of Gravette, which shows that the pouch of Gravette is baggy while the front panel is flat. This difference is significant. A wearer of Gravette's undergarment will need to physically manipulate his penis, the pouch, or both in order to insert his penis into the pouch through opening 81, due at least in part to the bagginess of the pouch (and also due in part to the structure of opening 81 - see below remarks). Claim 1 in the present application, however, recites "the stretch panel having a length when unstretched . . . and a width when unstretched . . . such that the front portion is gathered from side-to-side and top-to-bottom by the stretch panel whereby a three-dimensional pouch for receiving the wearer's genitals and holding the wearer's genitals while the garment is being worn is defined". As further recited by claim 12, this can cause the pouch to be held open to receive a wearer's genitals while the garment is held in position to be put on.

EX1004 at 215-216.

On July 30, 2014, after receiving Applicant's RCE, Examiner held a telephonic interview with the Applicant and issued a Notice of Allowability.

EX1004 at 235-242. Under REASONS FOR ALLOWANCE, Examiner stated,

The following is an examiner's statement of reasons for allowance: *the prior art of record does not render obvious, nor anticipate the combination of claimed elements*, including the limitations of "the stretch panel having a length when unstretched smaller than a length measured along the front portion between the first seam and the

waistband seam and a width when unstretched smaller than a width measured along the front portion between the side seams" in combination with leg openings, a crotch panel and the stretch panel being of four-way stretch material as claimed in independent claim 1. Claims 2-9, 11, 12, 14, 15, 17, and 18 are allowed by virtue of their dependencies on claim 1.

EX1004 at 239-40 (emphasis added). Carrillo is substantively the same as Shlush, which was considered very early on during the prosecution of the '974 Patent family. By the time Carrillo was submitted to Examiner on April 27, 2020, its substance had already been vetted via Shlush. Carrillo, particularly in view of its simplistic description of the garment depicted therein (which includes no details as to how the garment described therein is "sewn to classic underpants"), brings nothing new to the table over Shlush. Carrillo also brings nothing new over Gravette and Miller, all of which were considered in detail by Examiner.

Additionally, with the '974 Patent as its roadmap, Petitioner attempts hindsight construction with Carrillo and Brocks. But Petitioner fails articulate a reason to combine Carrillo with Brocks, other than the references are in the men's underwear space.

For the foregoing reasons, Carrillo (EX1009) fails to teach or make obvious, either alone or in combination with Brocks (EX1008), Claim 1 of the '974 Patent. Claims 2-9, 11, 13, and 16 all depend from Claim 1. Therefore, Carrillo in view of

Brocks fails to teach or render obvious, either alone or in combination with Brocks Claims 2-9, 11, 13, 16 of the '974 Patent.

c. The Board Must Deny Institution Based on Ground 2b Because Carrillo in View of Brocks and Kitsch Fails to Teach or Make Obvious Claims 10, 12 and 15.

As explained above in Sections A.2.a and A.2.b, Carrillo (EX1009) fails to teach or make obvious, either alone or in combination with Brocks, Claim 1 of the '974 Patent. Claims 10, 12 and 15 all depend from the only independent Claim 1. Carrillo fails to teach or make obvious, either alone or in combination with Brocks and Kitsch, Claims 10, 12 and 15 of the '974 Patent.

As detailed in Section A.1 above, Petitioner failed to carry its burden under Step (1) of the *Advanced Bionics* framework. That alone is sufficient for the Board to deny institution of the petition. But, even if Petitioner satisfied Step (1), it did not meet its burden under Step (2). As a result, there is no justification for the Board and Patent Owner's time, effort, and resources to be expended on this petition under 35 U.S.C. §325(d).

B. The Board Should Deny Institution Under *Fintiv* and §314(A).

The Board should also deny institution under the discretionary factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (Mar. 20, 2020) ("*Fintiv*"). The Supreme Court has explained that because 35 U.S.C. §314 includes no mandate to institute review, "the agency's decision to deny a petition is a matter

committed to the Patent Office’s discretion.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016). “[I]n evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, Paper 11 at 6.

For the reasons discussed below, this proceeding would be highly duplicative of the related district court case involving the same parties and the same patent.

1. Factor 1: The District Court Only Recently Stayed the Concurrent Litigation.

The first *Fintiv* factor is “whether a stay exists or is likely to be granted if a proceeding is instituted.” *Fintiv*, Paper 11 at 6. On November 17, 2023, Patent Owner filed a complaint alleging Petitioner Tommy John infringed the ’974 Patent. *Pakage Apparel, Inc. v. Tommy John, Inc.*, Cause No. 4:23-cv-4337 (S.D. Tex.). On August 22, 2024, the Texas court granted Petitioner’s motion to transfer venue to New York, where the cause number is now *Pakage Apparel, Inc. v. Tommy John, Inc.*, 1:24-cv-06371-LJL (S.D.N.Y.). On September 9, 2024, the New York court granted Petitioner’s motion to stay the case until the decision by the Board as to whether to institute Petitioner’s IPR request. The Court has ordered the parties to file a status report within seven days of the Board’s institution decision. The stay is in place until the earlier of a decision by the Board not to institute an IPR or a final written decision on the IPR.

Given the posture of the case, this *non-dispositive factor* slightly favors institution. *See, e.g., Snap v SRK Tech*, IPR2020-00820, Paper 15 at 19 (PTAB Oct. 21, 2020) (Precedential) (“no single factor is determinative of whether we exercise our discretion to deny institution under § 314(a)”).

2. Factor 2 is neutral or slightly favors denial of institution because the trial in the district court was to take place and may still occur before the Board’s projected statutory deadline.

Under the original scheduling order in the Southern District of Texas, the parties’ final pretrial conference was set for November 18, 2025, meaning that an anticipated seven-day jury trial would be held as much as two months earlier than the Board’s statutory deadline for a final written decision, which would be in January 2026. *See* EX2009 at 5. The New York Court adjourned all the dates on that scheduling order pending a decision on the IPR.

Due to the Court’s recent stay order, the trial date may be delayed by an unknown amount of time. Nevertheless, the district court has asked for quarterly updates regarding the IPR petition and will lift the stay if the Petition is not instituted, allowing for a jury to resolve the invalidity issues petitioned for here in about the same period of time or an even quicker a period of time than the Board, if it elects not to institute. Accordingly, this factor is neutral or slightly in favor of denying institution.

3. Factor 3 shows that the investment in the district court case weighs in favor of denying institution.

Factor 3 considers “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. “This investment factor is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Id.* at 10.

As the Board has explained, “[t]he time for evaluating investment in the proceeding is the time when institution would occur in this IPR.” *See Google LLC v. Ikorongo Technology LLC*, IPR2021-00204 (PTAB June 7, 2021) Paper 13 at 8. Here, the institution decision is expected in mid-January 2025, and the court issued its stay in early September 2024. Prior to the stay in the Litigation, the parties exchanged initial disclosures, the parties produced documents, Petitioner issued third-party subpoenas seeking prior art to Hanesbrands, Inc., Jacques Moret, Inc., Jockey International, Inc., Mack Weldon, Inc., Ralph Lauren Corp., Rampion USA Inc., and Saxx Underwear (USA) Co., Patent Owner provided detailed infringement contentions, Petitioner provided extensive invalidity contentions (EX2008), and the parties exchanged ’974 Patent claim terms for construction by the Court and proposed claim constructions for those terms. The court stayed the case just prior to

the parties submitting claim construction briefing. *See* EX2009. Petitioner could have instituted this petition at any time, and yet waited until the parties had invested substantial time and resources in the parallel litigation.

Because the parties have invested substantial resources to date, this factor weighs in favor of denying institution.

4. Factor 4 supports discretionary denial because of substantial overlap of critical issues.

“If the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv*, Paper 11 at 12.

As detailed above, Petitioner asserts three grounds of obviousness on prior art previously before the Patent Office. As shown below, Petitioner asserts the exact same combinations in the same manner in the Litigation.

references (together, or with their general knowledge) to arrive at that which is recited in the Asserted Claims.

Where patents or other printed materials are disclosed, Defendant reserves the right to also rely on those materials as descriptions of systems, devices, or methods referenced therein, publicly used, and/or on sale or known in the United States. Defendant reserves the right to also use those references to invalidate the claim under 35 U.S.C. § 103.

B. Obviousness Grounds

Each of the Asserted Claims of the '974 Patent is obvious in view of one or more items of the prior art identified above in Section III, alone or in combination. Pursuant to P.R. 3-3(b) and the Order, Defendant further provides exemplary, non-limiting grounds of invalidity based on obviousness below:

Base Reference	Secondary Source(s) / Reference(s)
Kitsch	Kitsch alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Carrillo, Brocks, Angheluta, KE Imports, Hartley, McRoberts, Iscla, Morgan, Hummel, Huang, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman
Carrillo	Carrillo alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Brocks, Angheluta, KE Imports, Hartley, McRoberts, Iscla, Morgan, Hummel, Huang, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman
Brocks	Brocks alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Angheluta, KE Imports, Hartley, McRoberts, Iscla, Morgan, Hummel, Huang, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman
Angheluta	Angheluta alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, KE Imports, Hartley, McRoberts, Iscla, Morgan, Hummel, Huang, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman

EX2008 at 14. The first three entries under Obviousness Grounds in Petitioner's Preliminary Invalidity Contentions include Kitsch, Carrillo and Brocks. *Id.* Not only

that, but the obviousness combinations which result from those three and Petitioner's Secondary Sources is 196,605.¹⁴

Kitsch, Carrillo, and Brocks notwithstanding, Petitioner asserts 11 additional obviousness references in the Litigation.

¹⁴ To determine the number of obvious combinations asserted by Petitioner for each entry in its invalidity contentions, the following formula is used: $OC = \frac{n!}{[r!(n-r)!]}$ where n is the number of references and r the number in each combination. For example, in Petitioner's Litigation Invalidity chart, if Petitioner combines Kitsch with each of the 16 different references identified in the Secondary Source(s)/Reference(s), without combining with a third reference, results in 16 obvious combinations. $OC = \frac{16!}{[1!(16-1)!]}$. But Petitioner includes an and/or at the end of its obviousness combinations, which results in a whopping 65,535 combinations when Kitsch is combined with multiple references. $OC = \sum_1^{16} n!/[r!(n-r)!]$. The same math applies to each entry in Petitioner's table. So, for the 3 references of Kitsch, Carrillo, and Brocks, the total is approximately 3 times 65,535 or 196,605 combinations. See EX2011 at 5 n.3.

KE Imports	KE Imports alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, Angheluta, Hartley, McRoberts, Iscla, Morgan, Hummel, Huang, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman
Hartley	Hartley alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, Angheluta, KE Imports, McRoberts, Iscla, Morgan, Hummel, Huang, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman
McRoberts	McRoberts alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, Angheluta, KE Imports, Hartley, Iscla, Morgan, Hummel, Huang, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman
Iscla	Iscla alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, Angheluta, KE Imports, Hartley, McRoberts, Morgan, Hummel, Huang, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman
Morgan	Morgan alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, Angheluta, KE Imports, Hartley, McRoberts, Iscla, Hummel, Huang, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman
Hummel	Hummel alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, Angheluta, KE Imports, Hartley, McRoberts, Iscla, Morgan, Huang, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman
Huang	Huang alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, Angheluta, KE Imports, Hartley, McRoberts, Iscla, Morgan, Hummel, Gravette, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman
Gravette	Gravette alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, Angheluta, KE Imports, Hartley, McRoberts, Iscla, Morgan, Hummel, Huang, Andrew Christian, Saxx, Geiwald, Miller, and/or Silverman

Andrew Christian	Andrew Christian alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, Angheluta, KE Imports, Hartley, McRoberts, Iscla, Morgan, Hummel, Huang, Gravette, Saxx, Geiwald, Miller, and/or Silverman
Saxx	Saxx alone, or in combination with the knowledge of a person of ordinary skill in the art and/or one or more of: Kitsch, Carrillo, Brocks, Angheluta, KE Imports, Hartley, McRoberts, Iscla, Morgan, Hummel, Huang, Gravette, Andrew Christian, Geiwald, Miller, and/or Silverman

Defendant reserves the right to amend, supplement, and otherwise modify the obviousness arguments listed below using any references identified and any other references including those that may become known or that may become known to be relevant during the course of discovery. Defendant further reserves the right to rely upon combinations of references disclosed within the prosecution history of the '974 Patent family with the references cited herein.

Much of the art identified in these contentions reflects common knowledge and the state of the art prior to the filing or asserted priority date of the Asserted Patent. As such, the obviousness combinations in these contentions are intended to be exemplary. There are many possible combinations of the disclosed prior art, and the inclusion of certain exemplary combinations does not exclude other combinations. For example, where a particular contention calls for combining references, any of a number of references can be combined.

Pursuant to P.R. 3-3(c), the accompanying invalidity claim charts (Exhibits 1-A through 14-A) set forth the example bases for obviousness, identifying where each reference discloses, alone or in combination with other references, each element of each Asserted Claim on a limitation-by-limitation basis. Section IV.C below further provides exemplary combinations and obviousness rationale. Defendant's claim charts and Section IV.C below are exemplary and are not intended to be exhaustive.

-15-

-16-

EX2008 at 15-16. These 11 additional references in combination with Petitioner's Secondary references results in approximately 720,885 combinations.¹⁵

Moreover, as seen on the first page of both EX2002 and EX1007, the assignee of the Kitsch patent is SAXX Apparel, Ltd. As mentioned under Factor 3, Petitioner subpoenaed SAXX in the Litigation. Petitioner listed SAXX separately from Kitsch in its Preliminary Invalidity Contentions, Kitsch being listed first and SAXX being listed two pages later, last. *See* Factor 4, *supra*. Petitioner's list is not alphabetical.

¹⁵ Using the same formulas as above and approximating the total by multiplying 11 times the 65,535 combinations, results in 720,885 combinations.

Petitioner clearly intends to litigate Kitsch in the Litigation as well as here. Petitioner should not get two more bites at the core of an apple already eaten by Examiner.

Patent Owner should not have to fight the same prior art in two forums. Moreover, Petitioner's extensive list of additional prior art will be litigated in the Litigation. It will be more efficient for the parties and a single forum, the district court, to analyze all prior art at once. Piecemeal litigation benefits no one. This factor heavily favors denial of institution.

5. Factor 5 supports denial because Petitioner is also the district court defendant.

Because Tommy John is the Petitioner and the accused infringer in the Litigation, factor 5 favors denying institution. *Supercell Oy v. Gree, Inc.*, IPR2020-01619, Paper 15 at 14 (PTAB Mar. 24, 2021); *Cisco Systems, Inc. v. Ramot at Tel Aviv University Ltd.*, IPR2020-00123 (PTAB May 15, 2020); *Google LLC v. Personalized Media Communications, LLC*, IPR2020-00719 (PTAB Nov. 5, 2020); *Amazon.com, Inc. et al v. Freshub, Ltd.*, IPR2020-01145 (PTAB Jan. 11, 2021).

6. Factor 6 supports discretionary denial because Petitioner raised the same art and arguments over which the challenged claims issued.

Under this factor, the Board engages in “a balanced assessment of all the relevant circumstances in the case.” *Fintiv*, Paper 11 at 14. This factor weighs in favor of discretionary denial because, as discussed *supra* in Sections IV.A-B, the application that issued as the '974 Patent was subject to detailed examination, and

the challenged claims issued over the same art and arguments to those presented in the Petition. Accordingly, *inter partes* review would result in a duplicative process imposing undue burdens on Patent Owner.

V. CONCLUSION

As demonstrated above, Petitioner fails to address the two-step framework of *Advanced Bionics*. Petitioner's prior art was reviewed and considered by the Patent Office. Petitioner's prior art does not render obvious any claim of the '974 Patent (the only grounds Petitioner asserts), the Patent Office did not err in a manner material to patentability, and the district court should evaluate all of the prior art allegations together in one proceeding. In view of the foregoing, Patent Owner respectfully requests the Board DENY institution of the Petition.

Date: October 10, 2024

Respectfully submitted,

DANIELS & TREDENNICK, PLLC

/s/ John F. Luman, III

John F. Luman III

USPTO Reg. No. 43,763

Email: luman@dtlawyers.com

Timothy E. Bond

USPTO Reg.: *Pro Hac Vice*

Email: Tim@dtlawyers.com

Daniels & Tredennick, PLLC

6363 Woodway, Ste 700

Houston, Texas 77057

T: 713-917-0024

F: 713-917-0026

Attorneys for Patent Owner

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

Under the provisions of 37 C.F.R. § 42.24(a), (b), and (d) the undersigned hereby certifies that the word count for the foregoing Patent Owner's Preliminary Response totals 9,589 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)-(b). Accordingly, this Petition is under the word count limit of 14,000 words. This word count was made by using the built-in word count function tool in the Microsoft Word software used to prepare the document.

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER'S PRELIMINARY RESPONSE** is being served electronically on October 10, 2024, to the e-mail addresses shown below:

Joseph Raffetto USPTO Reg. No. 66,218 joseph.raffetto@hoganlovells.com HOGAN LOVELLS US LLP 555 13 th Street, N.W. Washington, DC 20004 T: 202-637-5600 F: 202-637-5910	Scott Hughes USPTO Reg. No. 68,385 scott.hughes@hoganlovells.com HOGAN LOVELLS US LLP 555 13 th Street, N.W. Washington, DC 20004 T: 202-637-5600 F: 202-637-5910
---	---

Date: October 10, 2024

/s/ John F. Luman, III

John F. Luman III

USPTO Reg. No. 43,763

Email: luman@dtlawyers.com

Timothy E. Bond

USPTO Reg.: *Pro Hac Vice*

Email: Tim@dtlawyers.com

Daniels & Tredennick, PLLC

6363 Woodway, Ste 700

Houston, Texas 77057

T: 713-917-0024

F: 713-917-0026

Attorneys for Patent Owner