IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS

PAKAGE APPAREL, INC., *Plaintiff,* v. TOMMY JOHN, INC., *Defendant*.	Case No. 4:23-cv-04337 Judge Charles Eskridge **JURY TRIAL DEMANDED**

DEFENDANT'S PRELIMINARY INVALIDITY CONTENTIONS

I. Introduction

On November 17, 2023, Plaintiff Pakage Apparel, Inc. ("Pakage" or "Plaintiff") filed this lawsuit against Tommy John Inc. ("Tommy John" or "Defendant"), alleging infringement of U.S. Patent No. 10,834,974 (the "'974 Patent" or "Asserted Patent").

Pakage served its Preliminary Infringement Contentions pursuant to this Court's Patent Case Scheduling Order (Dkt. 29) (the "Order") on May 15, 2024, asserting claims 1-2, 6-13, and 15 of the '974 Patent against Defendant (the "Asserted Claims").

Now, pursuant to Rules of Practice for Patent Cases in the Southern District of Texas ("P.R.") 3-3 and 3-4 and the Order, Defendant hereby provides the following Preliminary Invalidity Contentions and accompanying document production.

II. Preliminary Statement and Reservation of Rights

These contentions are subject to the reservations stated herein and are subject to revision and amendment, including pursuant to Rule 26(e) of the Federal Rules of Civil Procedure and any local rules, orders, and the like of the Court or this District, including to the extent appropriate in light of, among other things, further investigation and discovery regarding the defenses asserted by Defendant; the Court's claim construction related to the Asserted Claims; analyses and opinions of Pakage or its expert witnesses concerning claim construction, infringement, invalidity, and unenforceability issues; and/or positions that Pakage may take concerning any of the foregoing.

Defendant provides these Preliminary Invalidity Contentions for only the Asserted Claims that Pakage has identified in its Preliminary Infringement Contentions. Defendant's exclusion from these Preliminary Invalidity Contentions of patent claims that Pakage has not asserted in its Preliminary Infringement Contentions is not an admission that those unasserted patent claims are valid. Defendant reserves the right to amend and supplement these Preliminary Invalidity

Contentions in the event Pakage later asserts any of those currently-unasserted claims by way of amendment or supplementation of its Infringement Contentions.

It is early in this action and Defendant's investigation of Pakage's claims and Defendant's defenses is ongoing. Defendant make these disclosures based on information currently available to it. Defendant may locate, discover, or otherwise learn of additional prior art, or other information, all of which Defendant reserves the right to rely on and amend, supplement, and otherwise modify these Preliminary Invalidity Contentions in view of. For example, Pakage (or its counsel) may be in possession of prior art, or other information (such as U.S. and foreign prosecution records), bearing on the invalidity of the Asserted Claims. As another example, Defendant has issued subpoenas to third parties including Saxx Underwear (USA) Co. ("Saxx"), Rampion USA Inc. ("Rampion), Jacques Moret, Inc. ("Jacques Moret"), Jockey International, Inc. ("Jockey"), and Ralph Lauren Corporation ("Ralph Lauren"), and expects to issue subpoenas or otherwise seek discovery from additional third parties, concerning the prior art identified herein and/or additional prior art, again bearing on the invalidity of the Asserted Claims. These third parties may further include, without limitation, the authors, inventors, and assignees of prior art identified in these Invalidity Contentions, as well as third parties that Pakage may be aware of but has not yet disclosed. Defendant further reserves the right to amend, supplement, and otherwise modify these contentions and its accompanying document production should Pakage provide any documents or information that it failed to provide in its disclosures or other discovery or should Pakage amend its disclosures in any way or provide additional discovery. Among other things, Pakage has failed to produce much, if not all, documents and information exchanged in past actions involving patents to which the Asserted Patent claims priority or is otherwise related, including, without limitation, *0912139 B.C. Ltd v. Rampion USA Inc*, 2:18-cv-01464-JLR (W.D. Wash.) and *Pakage Apparel, Inc. v. Saxx Apparel Ltd.*, Case no. VLC-S-S-127240 (Vancouver Law Courts, Filed October 17, 2012).

The Court has not yet construed any claim, term, or phrase of the ’974 Patent. These Preliminary Invalidity Contentions are based on the Defendant’s present understanding of the Asserted Claims and the apparent interpretations and constructions thereof by Plaintiff in its Preliminary Infringement Contentions. Defendant reserves the right to modify or supplement these Preliminary Invalidity Contentions in response to the Court’s construction of any claim, term, or phrase of the ’974 Patent.

Defendant’s Preliminary Invalidity Contentions, including the attached invalidity claim charts, may reflect alternative positions dependent upon claim construction and scope. These Preliminary Invalidity Contentions are not an admission by Defendant that the accused products, including any current or past or future versions of these products, are covered by or infringe the Asserted Claims. Furthermore, by including prior art that anticipates or renders obvious claims based on Plaintiff’s apparent claim construction(s), Defendant does not thereby adopt Plaintiff’s apparent claim construction(s). These Preliminary Invalidity Contentions do not represent an agreement with Plaintiff’s views as to the meaning, definiteness, written description support for, or enablement of any Asserted Claim.

Prior art not included in this disclosure may also become relevant. Defendant is currently unaware of the extent, if any, to which Plaintiff may contend that certain limitations of the Asserted Claims are not disclosed in the prior art identified by Defendant. Defendant reserves the right to identify other relevant prior art with respect to such allegedly missing limitation(s).

Defendant’s claim charts attached hereto as exhibits cite to particular portions, teachings, and disclosures of certain prior art references as applied to features of the Asserted Claims. Persons skilled in the art, however, may view an item of prior art in the context of other publications, literature, products, and understanding. The cited portions of prior art identified herein are

exemplary only. Defendant may rely on the entirety of the prior art references listed herein, including uncited portions of those prior art references, as well as additional information including products, documents, materials, and expert testimony.

Defendant further intends to rely on admissions concerning the scope of the prior art relevant to the ’974 Patent found in, inter alia: the patent prosecution history for the ’974 Patent and any related patents and/or patent applications, as well as any post-grant proceedings (including *inter partes* reviews) of the ’974 Patent; any deposition testimony of the named inventor(s) on the ’974 Patent and any related patents and/or patent applications in this action or any other action; and the papers filed and any evidence submitted by Plaintiff in connection with this action.

The references cited herein disclose the elements of the Asserted Claims explicitly or inherently, and they also demonstrate the state of the art in the relevant time frame. The suggested alternative obviousness combinations are provided in the alternative to Defendant’s anticipation contentions and are not to be interpreted to suggest that any reference included in the combinations is not by itself anticipatory. Further, the combinations listed herein are exemplary and not exhaustive. There are many possible invalidating combinations of the references listed herein, and it is not practical, at this early stage, to identify and list all potentially relevant combinations without the benefit of further factual investigation and prior to the claim construction proceedings.

In addition to the prior art identified below and in the accompanying invalidity claim charts, Defendant hereby incorporates by reference all invalidity positions, prior art, and claim charts that have been or will be disclosed in any other action related to the ’974 Patent or patents to which the ’974 Patent claims priority to, from, or through or is otherwise related, including U.S. Patent Nos. 10,034,496 and 9,687,030. Further, Defendant expressly incorporates by reference all invalidity claim charts served by Defendant in *0912139 B.C. Ltd v. Rampion USA Inc*, 2:18-cv-01464-JLR

(W.D. Wash.)—invalidity contentions and claim charts that Pakage has yet to produce in full.[1] Defendant's incorporation by reference also includes any *inter partes* review and *ex parte* reexamination proceedings that have been or may be filed at the U.S. Patent and Trademark Office related to the '974 Patent, including but not limited to IPR2024-01163 filed by Defendant.

Defendant reserves the right to assert that the Asserted Claims are invalid under 35 U.S.C. § 102(f) in the event Defendant obtains evidence that the inventor(s) named in the '974 Patent did not themselves invent the subject matter claimed in the respective patents, or that the '974 Patent otherwise fails to name the correct inventor(s). Should Defendant obtain such evidence, it will provide the name of any person from whom, and the circumstances under which, the alleged invention or any part of it was derived, or the name of any person who Defendant contends is inappropriately named or not named as an inventor. In fact, Defendant contends that, at least based on submissions and statements made during prosecution of the '974 Patent (including all filings in patent applications to which it claims priority), at least Glen Allan Kirk should have been named as an inventor on the '974 Patent based on his contributions to the Asserted Claims. (*See, e.g.*, BN3TH_TJ_00268 to BN3TH_TJ_000280; BN3TH_TJ_000890 to BN3TH_TJ_000892.) Defendant contends this is further evident at least from USD646462S1, filed January 5, 2011 and listing Shawn Robert Ellis and Glen Allan Kirk as inventors. Pakage has failed to produce documents regarding the conception and reduction to practice of the invention, and Defendant reserves the right to further supplement these contentions.

[1] Pakage has additionally not produced relevant documents from *Pakage Apparel, Inc. v. Saxx Apparel Ltd.*, Case no. VLC-S-S-127240 (Vancouver Law Courts, Filed October 17, 2012) to date, which may be relevant to, among other things, prior art, invalidity, inventorship, and ownership of the Asserted Patent.

Defendant also reserves the right to challenge any terms of any Asserted Claims under 35 U.S.C. § 112 beyond the grounds outlined herein, including by arguing that they are indefinite, not supported by the written description, or not enabled. Nothing stated herein shall be construed as a waiver of any argument available under 35 U.S.C. §§ 101, 102, 103, and/or 112.

III. P.R. 3-3(a) Identification of Prior Art

A. Priority Date

In its Preliminary Infringement Contentions, Pakage alleged that:

- The ’974 Patent claims priority to provisional patent application (No. 61/429,065) filed on December 31, 2010.
- The non-provisional patent application leading to the ’974 Patent (Appl. No. 16/030,769) was filed on July 9, 2018.
- The 16/030,769 application is a continuation of application No. 14/798,332, filed on July 13, 2015, now U.S. Patent No. 10,034,496, which is a continuation of application No. 13/193,584 filed on July 28, 2011, now U.S. Patent No. 9,687,030.

Pakage asserts that the ’974 Patent is entitled to a priority date of no later than December 31, 2010, the date of the provisional application.

Defendant does not agree, and disputes that the Asserted Claims are entitled to the December 31, 2010, priority date of the provisional application. The disclosure in the provisional application (No. 61/429,065) does not contain a sufficient description of numerous limitations in the asserted claims of the ’974 Patent, and therefore such claims should not be entitled to the December 31, 2010, filing date of the provisional application.

For example, the provisional application does not include written description sufficient to enable any person skilled in the art to make and use a male garment comprising a body, waistband,

and stretch panel, with "the stretch panel comprising a sheet of elastically resilient four-way stretch material having a top edge attached to the body at a top location, a bottom edge attached to the body at a bottom location, side edges attached to the body at side seams extending substantially continuously along either side of the front portion and an opening for receiving a wearer's genitals" as required by Claim 1 of the '974 Patent. Instead, the provisional application contains no disclosure of the stretch panel being, for example, "resilient four-way stretch material."

As another example, the provisional application does not include written description sufficient to enable any person skilled in the art to make and use a male garment comprising a body, waistband, and stretch panel, "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 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 the front portion for receiving the wearer's genitals and holding the wearer's genitals while the garment is being worn," as required by Claim 1 of the '974 Patent. The provisional application does not contain any such language, and further does not provide any description of lengths and widths of a stretch panel when unstretched as compared to lengths and widths measured along the front portion as is recited in the claim.

The Asserted Claims are therefore not entitled to the alleged priority date of December 31, 2010. Instead, the Asserted Claims should be entitled to, at most, a priority date of July 28, 2011, the filing date of what is now U.S. Patent No. 9,687,030.

Regardless of whether '974 Patent is entitled to the provisional priority date or not, it is subject to pre-AIA law.

B. Identification of Prior Art

Defendant identifies the following prior art that anticipates and/or renders obvious one or more Asserted Claims of the ’974 Patent. Defendant also incorporates by reference each and every prior art reference of record in the prosecution of the ’974 Patent, and patents or patent applications related to the ’974 Patent, including U.S. Patent Nos. 10,034,496 and 9,687,030, as well as the prior art referred to in the specification of the ’974 Patent and any prior art identified in any past lawsuits involving or otherwise relating to the ’974 Patent family (including the past lawsuit involving Rampion).

In these contentions, Defendant identifies each item of prior art, including: (1) each patent or patent application constituting prior art under pre-AIA 35 U.S.C. §§ 102(a), (b), and/or (e), by its patent or publication number, country of origin, and date of issue/publication; and (2) each non-patent publication constituting prior art under pre-AIA 35 U.S.C. §§ 102(a) and/or (b), by its title, date of publication, and, where feasible, author, and publisher.

Defendant further may rely on inventor admissions concerning the scope of the prior art relevant to the ’974 Patent found in, inter alia: the specification and figures of the ’974 Patent; the patent prosecution histories for the ’974 Patent and related patents, patent applications, and/or re-examinations, as well as any post-grant proceedings; any deposition testimony of the named inventor(s) on or otherwise relevant to the ’974 Patent family; and the papers and any evidence submitted by Plaintiff in this action.

Defendant identifies the following patents, patent applications, and non-patent publications as anticipating or rendering one or more of the Asserted Clams of the ’974 Patent obvious, either alone or in combination with one or more other prior art references, one or more Asserted Claims of the ’974 Patent under pre-AIA 35 U.S.C. § 103:

Country of Origin	Patent No./Publication No.	Filing/Publication/Issue Date	Prior Art Status (pre-AIA)
United States	US2008/0178369 ("Kitsch")	Filed December 19, 2007; Published July 31, 2008	102(a), (b), (e)
WIPO	WO 01/037687 ("Carrillo")	Filed November 16, 2000 (Priority to November 23, 1999); Published May 31, 2001	102(a), (b)
United States	US5,461,729 ("Brocks")	Filed September 12, 1994; Issued October 31, 1995	102(a), (b), (e)
United States	US5,029,345 ("Angheluta")	Filed February 9, 1990; Issued July 9, 1991	102(a), (b), (e)
Canada	CA133058 ("KE Imports")	Filed Nov. 26, 2009, Issued Jun. 17, 2010	102(a)
Australia	WO 98/39981 ("Hartley")	Filed Mar. 12, 1997, Pub. Sept. 17, 1998	102(a), (b)
United States	US6245036 ("McRoberts")	Filed Sept. 14, 1998, Iss. Jun. 12, 2001	102(a), (b), (e)
European Union	EP2100526A1 ("Iscla")	Filed Mar. 3, 2008, Pub. Sept. 16, 2009	102(a), (b)
United States	US5379462 ("Morgan")	Filed Aug. 9, 1993, Iss. Jan. 10, 1995	102(a), (b), (e)
Germany	DE3617021A1 ("Hummel")	Filed May 21, 1986, Pub. Nov. 26, 1987	102(a), (b)
United States	US2004/0025218 ("Huang")	Filed Aug. 12, 2002, Pub. Feb. 12, 2004	102(a), (b)

United States	US2007/027728 ("Gravette")	Filed May 16, 2007, Pub. Dec. 6, 2007	102(a), (b)
United States	US7631369 ("Geiwald")	Filed March 24, 2006, Issued Dec. 15, 2009	102(a), (b), (e)
United States	US2005/0229293 ("Miller")	Filed April 15, 2005, Pub. Oct. 20, 2005	102(a), (b), (e)
United States	US2010/0022165 (Silverman")	Filed July 22, 2009 (Priority to July 22, 2008), Pub. Jan. 28, 2010	102(a), (b), (e)

* Where a complete date is not provided the last date in the provided time period is assumed, but Defendant reserves the right to more accurately determine the date of any publication, including as discovery progresses.

In addition, the Defendant identifies the following actual and potential prior art products (or sources of the same):

- Ralph Lauren – On information and belief, Ralph Lauren, with offices in New York, may have designed, made, sold, or otherwise commercialized prior art underwear having a pouch to support the wearer's genitalia, or may have knowledge or be aware of such prior art underwear. Defendant has issued a subpoena to Ralph Lauren and will supplement its contentions as needed accordingly once it receives relevant documentation.
- Jacques Moret / 2(X)IST – On information and belief, Jacque Moret and 2(X)IST, both with offices in New York, may have designed, made, sold, or otherwise commercialized prior art underwear having a pouch to support the wearer's genitalia, or may have knowledge or be aware of such prior art underwear. Defendant has issued a subpoena to Jacques Moret and will supplement its contentions as needed accordingly once it receives relevant documentation.
- Jockey – On information and belief, Jockey International, with offices in New York, may have designed, made, sold, or otherwise commercialized prior art underwear having a pouch to support the wearer's genitalia, or may have knowledge or be aware

of such prior art underwear. Defendant has issued a subpoena to Jockey and will supplement its contentions as needed accordingly once it receives relevant documentation.

- Saxx – On information and belief, Saxx may have designed, made, sold, or otherwise commercialized prior art underwear having a pouch to support the wearer's genitalia, or may have knowledge or be aware of such prior art underwear. Defendant has issued a subpoena to Saxx and will supplement its contentions as needed accordingly once it receives relevant documentation.
- Andrew Christian – On information and belief, and as set forth in documents produced in by Pakage to date, Andrew Christian products with "Show-It" technology were described in printed publications, known and used by others, or sold within the United States in 2009. *See, e.g.*, BN3TH_TJ_001462-001468. Moreover, as set forth in the charts attached hereto, and in the invalidity charts citing to the Andrew Christian "Show-It" technology with respect to nearly identical limitations in the claims of related patents produced in *0912139 B.C. Ltd v. Rampion USA Inc*, 2:18-cv-01464-JLR (W.D. Wash.), the Asserted Claims are invalid as being anticipated and/or obvious in view of the Andrew Christian "Show-It" technology. Defendant reserves the right to supplement its contentions with respect to Andrew Christian's prior art products once Plaintiff and/or Andrew Christian provide complete discovery with respect to same. In this regard, as noted above, Plaintiff continues to withhold those prior art-related documents produced by Andrew Christian in the aforementioned past lawsuit involving Rampion.

Investigation into the foregoing and other actual and potential prior art products, as well as sources of the same is still ongoing, and Defendant reserves the right to provide more detailed contentions related to these products upon further discovery. In this respect, Defendant specifically notes that additional third-party companies may likewise be sources or have knowledge of relevant prior art pouch underwear, and Defendant expects to subpoena such third parties in due course. Defendant will supplement its contentions accordingly as needed with any information provided by any such third parties.

IV. P.R. 3-3(b) and (c): Anticipation, Obviousness, and Claim Charts

A. Anticipation Grounds

The references and systems in the tables above independently anticipate the Asserted Claims under 35 U.S.C. §§ 102(a), (b), (e), (f) and/or (g), as set forth in the charts attached as Exhibits 1-A through 14-A.

These charts, however, are exemplary. The claimed features are similarly described and suggested in other places (including in all of the documents cited during prosecution of each piece of prior art), and also were present when prior-art products practicing the described prior art were used before the application that ultimately led to the Asserted Patent. Thus, where patents or other printed materials are disclosed, Defendant reserves the right to also rely on those materials as descriptions of products, systems, devices, or methods referenced therein, publicly used, and/or on sale or known in the United States. Further, Defendant reserves the right to rely on other evidence of the prior art beyond merely the exemplary references cited in the charts attached as Exhibits. Moreover, to the extent that any of the Asserted Claims are not rendered invalid purely on anticipatory grounds, it would have been obvious to one of ordinary skill in the art, applying nothing more than their own or common industry knowledge, to modify or combine the above

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

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.

Defendant's assertion that the combinations above render the Asserted Claims obvious under pre-AIA 35 U.S.C. § 103 is in no way an admission or suggestion that a reference does not independently anticipate the Asserted Claims under pre-AIA 35 U.S.C. § 102. *See Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983) ("'[A]nticipation is the epitome of obviousness.'") (quoting *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982)). Nor does the inclusion of the exemplary combinations in the attached exhibits exclude other combinations of prior art disclosed in this or previous or subsequent sections (including, without limitation, Section IV.C).

All discussion of obviousness in these Preliminary Invalidity Contentions follows well-established precedent. The U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) ("*KSR*"), held that patents based on new combinations of elements or components already known in a technical field may be obvious. Specifically, the Court in *KSR* rejected a rigid application of the "teaching, suggestion, or motivation [to combine]" test. *Id.* at 418-19. "In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim." *Id.* at 420. "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* In particular, the Supreme Court emphasized the principle that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. A key inquiry is whether the "improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 401.

C. Exemplary Motivations to Combine

It would have been obvious to one of ordinary skill in the art to combine one or more of the prior art references listed above with each of the other references and/or nothing more than his or her own knowledge, education, experience and/or common sense to arrive at the alleged inventions of the Asserted Patent. As the Supreme Court emphasized in *KSR*, inventions arising from ordinary innovation, ordinary skill, or common sense are not patentable. *See Id.* at 406, 420-422.

The identified prior art references also use those familiar elements for their primary or well-known purposes in a manner well within the ordinary level of skill in the art. In addition, the identified prior art addresses the same or similar technical issues relating to, inter alia, design, manufacture, and/or use of garments, including men's underwear and other undergarments. Accordingly, common sense and the knowledge of the prior art render the Asserted Claims of the Asserted Patent invalid under § 103.

The Supreme Court has held that, "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.* at 417.

Finally, as further described in the exemplary combinations below, the motivation to combine the teachings of the prior art references disclosed herein is also found in the references themselves and in: (1) the nature of the problem being solved, (2) the express, implied, and inherent teachings of the prior art, including the admitted prior art of the Asserted Patent, (3) the knowledge

of persons of ordinary skill in the art, (4) the fact that the prior art is generally directed towards the same subject matter as the Asserted Patent, and/or (5) the predictable results obtained in combining the different elements of the prior art. One of ordinary skill in the art at the relevant time of the Asserted Patent would have been motivated and had a reasonable expectation of success to make one or more modifications or combinations of the prior art references cited in Exhibits 1-A through 14-A because, for example, each would have been merely: (a) a combination of prior art elements according to known methods to yield predictable results; (b) a simple substitution of one known element for another to obtain predictable results; (c) a use of a known technique to improve similar devices in the same way; (d) application of a known technique to a known device ready for improvement to yield predictable results; (e) obvious to try; and/or (f) known work in one field of endeavor prompting variations of it for use in either the same field or a different one based on design incentives or other market forces since the variations are predictable to one of ordinary skill in the art.

The prior art references disclosed herein identify and address many of the same technical issues and suggest similar solutions to those issues as the Asserted Patent. The reasons or motivation to combine the prior art would thus include, for example, the fact that the prior art identified herein, as well as the prior art disclosed during prosecution of the Asserted Patent and related patents and applications, generally relate to the area of, inter alia, design, manufacture, and use of garments, including men's underwear. One of ordinary skill in the art would have been motivated to investigate the various related publications and/or patents, as well as actual and potential products and the like, identified in these Preliminary Invalidity Contentions to address the problems the Asserted Patent purport to address. Indeed, men's underwear garments, including those having a pouch for a wearer's genitals, were widely available and well known before the

claimed inventions of the Asserted Patent. Various related products and methods have been developed over the years to facilitate design and manufacture of men's underwear including a pouch for the wearer's genitals, all prior to the Asserted Patent. These products and methods share several similarities and employ the same basic concepts. The references disclosed herein are generally directed to the field of garment design, manufacturing, and use and seek to solve similar problems. Accordingly, a person of ordinary skill in the art would have been motivated to combine any number of the references because the references relate to analogous art and use common technology and methods in various applications related to garment design, manufacturing, and use. It would have been common sense to make such combinations.

Defendant believes that no showing of a specific motivation to combine the identified prior art references described herein and in the attached charts is required, as each combination of art would have no unexpected results and at most would simply represent a known alternative to one of ordinary skill in the art. *See KSR*, 550 U.S. at 414-18 (rejecting the Federal Circuit's "rigid" application of the teaching, suggestion, or motivation to combine test, instead espousing an "expansive and flexible" approach). Indeed, the Supreme Court held that a person of ordinary skill in the art is "a person of ordinary creativity, not an automaton" and "in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id*. at 421.

Nevertheless, in addition to the information contained in this section and elsewhere in these contentions, Defendant identifies additional motivations and reasons to combine the art.

1. *"the stretch panel comprising a sheet of elastically resilient four-way stretch material" or "the stretch panel being resiliently elastic both in a direction between the top edge and the bottom edge and in a direction between the side edges"* [Claim 1]

"wherein the elastically resilient four-way stretch material is comprised of a spandex blend" **[Claim 10]**

To the extent that any reference charted in Exhibits 1-A through 14-A does not disclose "the stretch panel comprising a sheet of elastically resilient four-way stretch material" or "the stretch panel being resiliently elastic both in a direction between the top edge and the bottom edge and in a direction between the side edges" [Claim 1] or "wherein the elastically resilient four-way stretch material is comprised of a spandex blend" [Claim 10], it would have been obvious to modify or combine such reference with the knowledge of a POSITA or another reference disclosing such limitations to render Claims 1 and 10 obvious. There would have been many reasons that a POSITA would have known to so modify or combine such reference.

For example, a POSITA would have recognized that an elastic panel attached to men's underwear 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. 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. Similarly, a POSITA would have understood an elastic panel would have at least some stretch in a direction perpendicular to the waistband, so 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. Moreover, a POSITA would have been motivated to use a four-way-stretch material to promote sufficient separation between the testicles and groin, reducing direct contact and friction, and helping with perspiration.

Additionally, a POSITA would have known that elastic material can either be "four-way" stretch or "two-way" stretch material, and 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. A POSITA would

have additionally 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. Further, using four-way stretch material would have provided the benefit of not causing the front part of the underwear to bunch or tear, as the four-way stretch material could accommodate movements and fabric shifts in all directions. 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.

For example, without limitation, a POSITA would have found it obvious to combine any of the charted references with Kitsch (US2008/0178369). 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." (Kitsch, [0030].) Kitsch discloses the "performance material used advantageously in the side panels of the present invention is a soft ***elasticized*** breathable mesh knit weave (in a so-called ***four-by-four stretch weave***) containing 80% Nylon™ and 20% Spandex™." (Kitsch, [0030] (emphasis added); *see also* [0001]-[0002], [0009], [0026]-[0029], Cl. 1.) *See also* Ex. 1-A. In addition to the reasons set forth above, a POSITA would have been motivated to combine any of the charted references with Kitsch in order to, for example, include a stretch panel that provides sufficient separation and support of the genitals while wicking away moisture and increasing comfort. And, a POSITA would have had a reasonable expectation of success in using a four-way stretch material, including a spandex blend, as disclosed in Kitsch, as this would have simply been

the use of a well-known material for its intended purpose, and at the very least it would have been obvious substitute the four-way stretch material in Kitsch for a similar elastic material in any of the charted references, as it would be the substitution of one known material used in men's undergarments for another.

As another example, also without limitation, it would have been obvious to combine any of the charted references with Miller (US2005/0229293), which discloses an underwear garment using four-way stretch material. (Miller, [0020].) Miller discloses men's underwear with a support panel and crotch panel, and discloses that "[p]referably the stretchable fabric for the support panel 8 and crotch panel 10 is made of a blend of a fiber selected from the group consisting of acetate, acrylic, lyocell, nylon, olefin, polyester and rayon fibers with more than 10% spandex fibers or other elastic fibers such as Lycra™ or rubber. The preferred fabric for support panel 8 and crotch panel 10 is a four-way stretch 85% nylon 15% spandex blend with 1×1 or 2×1 rib." (*Id.*) In addition to the reasons set forth above, a POSITA would have been motivated to combine any of the charted references with Miller in order to, for example, include a stretch panel that is both stretchable and that has sufficient strength such that it can hold the genitals in place. And, a POSITA would have had a reasonable expectation of success in using a four-way stretch material, including a spandex blend, as disclosed in Miller, as this would have simply been the use of a well-known material for its intended purpose, and at the very least it would have been obvious substitute the four-way stretch material in Miller for a similar elastic material in any of the charted references, as it would be the substitution of one known material used in men's undergarments for another.

Similarly, as additional non-limiting examples, Carrillo (Ex. 2-A), Brocks (Ex. 3-A), Andrew Christian (Ex. 13-A) and Saxx (Ex. 14-A) all disclose these elements and a POSITA

would have been motivated to combine such references with any other charted reference at least for the reasons given above.

2. ***"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 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 the front portion"*** **[Claim 1]**

To the extent that any reference charted in Exhibits 1-A through 14-A does not disclose "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 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 the front portion" [Claim 1], it would have been obvious to modify or combine such reference with the knowledge of a POSITA or another reference disclosing such limitation to render Claim 1 obvious. There would have been many reasons that a POSITA would have known to so modify or combine such reference.

For example, a POSITA would have understood that stretching an elastic material prior to attaching it to a piece of fabric, such that the length and width of the elastic material unstretched was smaller than a length and width measured along the fabric to which it attached when stretched, was a well-known method of gathering such fabric. This would have been nothing more than the use of a method in garment manufacturing to add desired volume and gathering of fabric, and it would have been well within the skill of a POSITA to implement such a known technique to gather a front portion of underwear and form a pouch. A POSITA would have also understood that attaching a stretch panel in a stretched state, rather than an unstretched state, would merely be the

simple substitution of one known method for another. 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 in order to obtain the benefits of the elastic material "gathering" the material to which it is attached to form the pouch.

For example, without limitation, a POSITA would have found it obvious to combine any of the charted references with Brocks (US5,461,729). Brocks, in the field of men's underwear, 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:

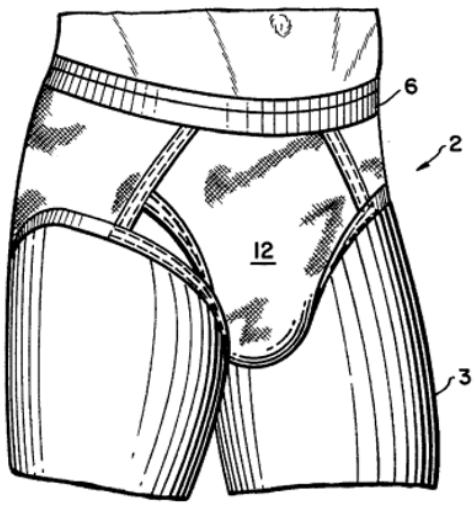

FIG.1

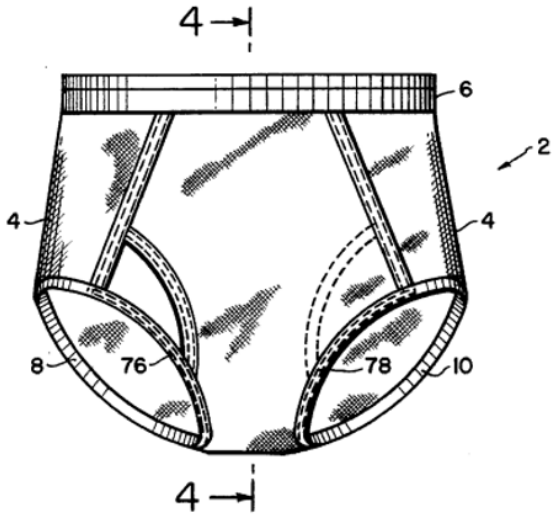

FIG.2

(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.) 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. (Brocks, 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).)

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, 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):

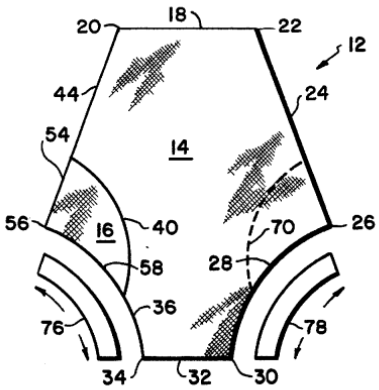

FIG.8

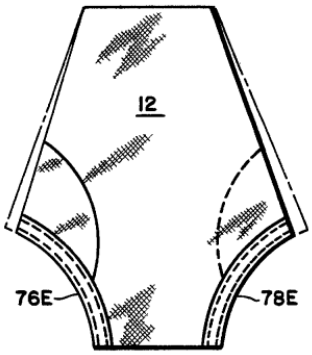

FIG.9

(Brocks, Figs. 8-9, 3:27-4:14.) *See also* Ex. 3-A.

It would have been obvious to a POSITA to modify the charted references to attach the stretch panel 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).) A POSITA would have recognized that, for example, as taught by Brocks, when stretch panels are stitched to seams in a stretched state, they would contract after being sewn and would assist in creating a "gathering" of any front fabric to which they are attached, helping to form or define the supportive genital pouch. A POSITA would have been motivated to apply the teachings of Brocks to attach the stretch 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. Such modification would not require any additional materials, and attaching this same material to seams in a stretched state would provide the benefits of the panels functioning to cup the genitals, inhibit skin to skin contact, and wick moisture, while further aiding gathering of fabric to create the supportive pouch.

As another example, and again without limitation, it would have been obvious to combine any of the charted references with Silverman (US2010/0022165), which discloses a bra underwear

garment with supportive cups formed by attaching elastic strips in the material of a garment while in a stretched condition. (Silverman, [0025]-[0030], [0038]-[0039], [0041]-[0049], Figs. 1-3B].) Silverman discloses that by stretching U-shaped elastic strips both lengthwise and widthwise, and attaching them in a stretched state "to the material of the garment," such that when "the tension forces are removed, the strips and the garment material revert to a gathered or puckered condition. This allows, for example, for cups similar to the pouches described in the charted references, to be formed which are "of an adequate size to comfortable [sic] receive the woman's breasts" that "exert upward and outward forces to the breasts, leaving the woman with a sense that her breast are buoyant." (*Id.*, [0038], *see also* [0025]-[0030], [0039], [0041]-[0049].) Silverman explains that this provides lifting support. (*Id.*) A POSITA would have been motivated to apply these teachings from Silverman to the underwear of the charted references in order to, for example, gather material to form the pouch portion that would have sufficient volume to be of adequate size while still providing lifting support to separate the genitals from the wearer's groin area. A POSITA would have understood this would have been the application of a known technique used in one area (forming a bra) to improve a similar product (men's underwear with a similar cup shaped pouch) in the same way. A POSITA would have understood that this would have been nothing more the routine application of Silverman's known technique of attaching stretched elastic material to fabric intended to be gathered, in order to yield the predictable result of the fabric being gathered to sufficient volume when the tension is released.

Similarly, as additional non-limiting examples, Angheluta (Ex. 4-A), CA133058 (Ex. 5-A), McRoberts (Ex, 7-A), Andrew Christian (Ex. 13-A), and Saxx (Ex. 14-A) all disclose this element and a POSITA would have been motivated to combine such references with any other charted reference at least for the reasons given above.

3. *"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"* **[Claim 2]**

To the extent that any reference charted in Exhibits 1-A through 14-A does not disclose "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" [Claim 2], it would have been obvious to modify or combine such reference with the knowledge of a POSITA or another reference disclosing such limitations to render Claim 1 obvious. There would have been many reasons that a POSITA would have known to so modify or combine such reference.

For example, a POSITA would have understood that 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. A POSITA would have known that elastic material, such used in the stretch panels of the charted references, 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). A POSITA would have found it at least 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. Further, this would have been a simple, well-known way to implement or construct underwear, using well-known techniques and materials. As such, a POSITA would have had a reasonable expectation of success in using asymmetrical stretch materials for the stretch panels of the charted references, which would continue to function as before, only now the wearer could stretch the underwear more in the lateral direction.

For example, without limitation, a POSITA would have found it obvious to combine any of the charted references with Brocks (US5,461,729). 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.) *See also* Ex. 3-A. It would have been obvious to apply this teaching of using material with asymmetrical stretch to the stretch panel of the references charted in Exhibits 1-A through 2-A and 4-A through 14-A. Again, 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. 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. A POSITA would have been motivated to modify the charted references, as taught by Brocks and generally known in the art, to construct the stretch 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. 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.

As another example, and again without limitation, Geiwald (US7631369) discloses it was known to use materials in men's underwear having asymmetrical stretch characteristics. (Geiwald, 2:9-3:10.) Geiwald discloses men's underwear including a pouch compartment formed from a

groin portion, and further discloses that the material used in forming the groin portion can be constructed from, for example, elastic spandex yarn in "a warp-knitted fabric." (*Id*.) Geiwald discloses that such a "warp knit, by virtue of having parallel strands 26 along the direction 27 of the fabric, is resistant to stretch in the direction 27 when compared to other knitted fabrics, which may undesirably stretch. Thus, the warp knit fabric stretches less along the direction 27 than along the direction 29," and that this allows for accommodation of wearers of different sizes while providing support. (*Id.*, 2:41-3:10.) In addition to the reasons set forth above, a POSITA would have been motivated to combine any of the charted references with Geiwald in order to, for example, construct the stretch panel with a material having asymmetric stretch such that it stretches more easily in the direction parallel to the waistband and less easily in a direction at right angles to the waistband, at least to be able to accommodate wearers of different sizes. And, a POSITA would have had a reasonable expectation of success in using asymmetric stretch material as disclosed in Geiwald, as this would have simply been the use of a well-known material for its intended purpose, and at the very least it would have been obvious substitute the asymmetric elastic stretch material in Geiwald for a similar elastic material in any of the charted references, as it would be the substitution of one known material used in men's undergarments for another.

Similarly, as additional non-limiting examples, Kitsch (Ex. 1-A), Andrew Christian (Ex. 13-A), and Saxx (Ex. 14-A) all disclose this element and a POSITA would have been motivated to combine such references with any other charted reference at least for the reasons given above.

4. *"wherein the opening has a width in excess of 2 cm"* [Claim 8]

To the extent that any reference charted in Exhibits 1-A through 14-A does not disclose "wherein the opening has a width in excess of 2 cm" [Claim 8], it would have been obvious to modify or combine such reference with the knowledge of a POSITA or another reference

disclosing such limitations to render Claim 8 obvious. There would have been many reasons that a POSITA would have known to so modify or combine such reference.

For example, a POSITA would have understood from the figures and descriptions of the charted references that the openings for a wearer's genitals described therein would have a width in excess of 2cm. The charted references depict such openings being large enough to accommodate a phallus and/or scrotum into a pouch compartment of underwear. A POSITA would have understood that with an opening that is too small, for example on the order of 1 or 1.5 cm wide, a wearer would have their genitals uncomfortably pinched by the stretch panel or pushed back against the groin area, or would not be able to insert their genitals through the opening at all. Thus, a POSITA would have understood that the openings between the side panels would have a width in excess of 2 cm, and it would have been well within the skill of a POSITA to manufacture a variety of sized openings. Further, it would have been obvious to a POSITA to at least try an opening with a width in excess of 2 cm as part of discovering an optimum or workable range of openings to use, and such would have involved only routine skill. At the very least it would have been obvious to a POSITA try different sized openings, including greater than 2 cm, to accommodate genitals of different sizes.

5. *"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"* [Claim 11]

To the extent that any reference charted in Exhibits 1-A through 14-A does not disclose "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" [Claim 11], it would have been obvious to

modify or combine such reference with the knowledge of a POSITA or another reference disclosing such limitations to render to render Claim 11 obvious. There would have been many reasons that a POSITA would have known to so modify or combine such reference. Again, a POSITA would have understood, from their own knowledge and/or the teachings of the prior art, to attach elastic material to fabric while in a pre-stretched condition while the fabric is less stretched in order to ensure sufficient gathering to create sufficient volume when the tension is released. Moreover, a POSITA would have understood that by attaching elastic fabric in a stretched condition, when the garment is held to be put on, the elastic material would stretch and bias the opening to be open. *See, e.g., supra* Section IV.C.ii.

6. *"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"* [Claim 12]

To the extent that any reference charted in Exhibits 1-A through 14-A does not disclose "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" [Claim 12], it would have been obvious to modify or combine such reference with the knowledge of a POSITA or another reference disclosing such limitations to render Claim 12 obvious. There would have been many reasons that a POSITA would have known to so modify or combine such reference.

For example, a POSITA would have understood that the body could include both a front portion and a rear portion, constructed from, for example, separate pieces of fabric cut from desired patterns. Such was a typical and well-known method of constructing underwear briefs; in fact, it was routine for a POSITA to create underwear using front and back portions joined together. This

would have required nothing more than the use of known fabric patterns joined by known methods, *e.g.*, seams. Similarly, a POSITA would have understood that the stretch panel could be disposed forward of the perineum, with its bottom edge being attached at a seam forward of such area that joins the front and back portions. This would have been the implementation of a well-known method of attachment, *e.g.*, by connecting the panel to a common seam, and a POSITA would have had a reasonable expectation of success in sewing the bottom edge of the panel at the seam joining the front and back portions. A POSITA would have been motivated to do this because by making the seam that attaches the rear and front portions coincident with the seam that attaches the stretch panel to the body, the construction of the garment would reduce the number of seams necessary. Further, having the seam and stretch panel forward of the perineum would ensure the stretch panel extends far enough back to separate and isolate the testicles from the legs and groin area.

For example, without limitation, a POSITA would have found it obvious to combine any of the charted references with Kitsch. Kitsch's underwear may include a "rear panel 28" that forms a rear portion of the body and that depends from the waistband 22. (Kitsch, Fig. 7 (annotated), [0041].) Further, its front portion, *e.g.*, "pouch compartment 18," may be attached to the "rear panel 28" at a seam 30a disposed forward of the perineum area 24. (Kitsch, Fig. 8 (annotated), [0041]; *see also* Figs. 3, 7 (annotated above), [0035]-[0040], Cl. 1.) The bottom edge of Kitsch's stretch panel (*e.g.*, side panels 12) may be fastened at the same seam. (*Id.*, Fig. 8 (annotated); see also Figs. 3, 7, [0035]-[0041].) *See also* Ex. 1-A. In addition to the reasons set forth above, a POSITA would have been motivated to combine any of the charted references with Kitsch in order to, for example, construct the stretch panel from separate front and rear portions, as well as join the two together with the bottom of the stretch panel at a seam forward of the perineum area. Constructing a body from separate front and back portions would have been a typical, well-known

method of constructing underwear briefs, and the prior art, as modified, would thus still have a body with both a front portion and a back portion, as well as a stretch panel. A POSITA would have had a reasonable expectation of success to construct the prior art in this way, as well as join the front portion, back portion, and bottom of the stretch panel at a seam forward of the perineum area, as the body and panel would continue to provide the same functionality as before, only now simply being joined by a well-known seam. Using this approach from Kitsch would provide a single, strong seam for attachment, reduce the number of seams necessary, and thereby reduce potential itching, friction, and irritation which may occur at a seam. Moreover, a POSITA would have understood that applying this teaching from Kitsch, *e.g.*, extending the stretch panel material to a common seam forward of the perineum area, ensures that the stretch panel material, in cooperation with the front portion (and back portion) to which it attaches, closely resembles the "natural setting of the genitals" for isolation and support that will be positioned to cradle the underside of the scrotum.

Similarly, as additional non-limiting examples, Angheluta (Ex. 4-A), CA133058 (Ex. 5-A), Andrew Christian (Ex. 13-A), and Saxx (Ex. 14-A) all disclose this element and a POSITA would have been motivated to combine such references with any other charted reference at least for the reasons given above.

7. *"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"* [Claim 15]

To the extent that any reference charted in Exhibits 1-A through 14-A does not disclose "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" [Claim 15], it would have been obvious to modify or combine such reference with the knowledge of a

POSITA or another reference disclosing such limitations to render Claim 15 obvious. There would have been many reasons that a POSITA would have known to so modify or combine such reference.

For example, a POSITA would have known that a dart seam is a well-known sewing technique in which a dart is formed by removing a wedge of material and folding the fabric onto itself. The fabric is then sewn along the dart sewing line and then unfold-ed, allowing a 2-dimensional pattern piece of fabric to be made into a 3-dimensional shape. A POSITA would have understood that including such a well-known seam along the bottom of the pouch would have provided extra volume in the pouch area, creating more space for a wearer's genitals. This would have been mothing more than using a well-known technique for its intended purpose.

For example, without limitation, a POSITA would have found it obvious to combine any of the charted references with Kitsch or Morgan. Kitsch discloses that its pouch comprises a dart seam 18b' that joins "a pair of divergent tails" to form "a shelf-like tableau or plateau 18a' cradling the underside of scrotum 14." (Kitsch, [0030], [0036], Figs. 3, 8-9.) *See also* Ex. 1-A. Similarly, Morgan discloses converting a planar panel into a genital "support pouch or cup" by sewing the panel together along V-cutout edges (i.e., f-g-h). (Morgan, 2:47-56, Fig. 1-3.) *See also* Ex. 9-A. In addition to the reasons set forth above, a POSITA would have been motivated to combine any of the charted references with these teachings from Kitsch or Morgan in order to, for example, include a well-known dart seam along the portion along the bottom of the front portion of the underwear, in front of the opening, so as to provide greater pouch volume" and more dimensionality, and ensure there is room for the front portion material to receive the genitals when they are introduced through the opening. Further, a POSITA would have been motivated to use such a pouch seam so as to support the genitals and assist in having the genitals separated from the groin and leg to

eliminate contact, thereby reducing friction and improving positioning. A POSITA would have had a reasonable expectation of success in implementing such a dart seam, as such a seam was a common, well-known method to join portions of a piece of fabric to create a three-dimensional shape and add additional volume.

Similarly, as additional non-limiting examples, CA133058 (Ex. 5-A), Andrew Christian (Ex. 13-A), and Saxx (Ex. 14-A) all disclose this element and a POSITA would have been motivated to combine such references with any other charted reference at least for the reasons given above.

V. P.R. 3-3(d): Invalidity based on 35 U.S.C. § 112

Defendant contends that the Asserted Claims are invalid under pre-AIA 35 U.S.C. § 112 because: (1) the claims are indefinite; (2) the claims are not enabled; and/or (3) the claims lack adequate written description. Defendant's contentions that the following claims are invalid under pre-AIA 35 U.S.C. § 112 are made in the alternative, and do not constitute, and should not be interpreted as, admissions regarding the construction or scope of the claims of the Asserted Patent, or that any of the claims of the Asserted Patent are not anticipated or rendered obvious by any prior art.

These contentions are based on Defendant's current understanding of the Asserted Patent and Plaintiff's Preliminary Infringement Contentions. To the extent Plaintiff contends that the prior art references identified above would not enable a person of ordinary skill to make or use the elements of the Asserted Claims against which they are cited, and to the extent Plaintiff contends that the Asserted Claims cover something different from what Defendant understand them to cover, the Asserted Claims may not comply with the enablement, written description, and/or definiteness requirements of 35 U.S.C. § 112 ¶¶ 1-2. Because compliance with the requirements

of 35 U.S.C. § 112 ¶¶ 1-2 depends on the construction of those phrases—and no claim construction positions have been exchanged, no claim construction order has issued, and no expert discovery has been undertaken—Defendant's positions on written description, enablement, and/or indefiniteness are necessarily preliminary at this early stage of the case. Defendant reserves all rights to amend or further revise these contentions based on further developments in the case.

The written description and enablement requirements are analyzed by comparing the claims with the disclosure in the specification. If the claimed invention does not appear in the specification, the claim fails regardless of whether one of skill in the art could make or use the claimed invention. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1348 (Fed. Cir. 2010). To satisfy the written description requirement, the patentee must convey to those skilled in the art that, as of the filing date, the applicant was in possession of the invention, and demonstrate that possession by disclosing the invention in the specification. *Id.* at 1352. To satisfy the enablement requirement, a patentee must "describe the manner and process of making and using the invention so as to enable a person of skill in the art to make and use the full scope of the invention without undue experimentation." *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1344-45 (Fed. Cir. 2005).

A patent must also be precise enough to afford clear notice to what is claimed. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 899 (2014). A patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention. *Id.* at 898-99. The standard for assessing if a patent claim is sufficiently definite to satisfy the statutory requirement is whether "one skilled in the art would understand the bounds of the claim when read

in light of the specification." *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1358 (Fed. Cir. 2003).

A claim term can be indefinite based on multiple grounds ranging from substantive concerns to unresolvable drafting errors, all of which can be fatal to the validity of the claims as a matter of law. For example, the Federal Circuit has repeatedly held that apparatus claims that contain method claim limitations are indefinite because it is impossible to determine when direct infringement occurs. *See, e.g., Rembrandt Data Techs., LP v. AOL, LLC*, 641 F.3d 1331, 1339-40 (Fed. Cir. 2011) (an independent claim that recited both an apparatus and a method of using that apparatus was indefinite, as was its dependent claims); *IPXL Holdings v. Amazon.com*, 430 F.3d 1377, 1384 (Fed. Cir. 2005); *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1318 (Fed. Cir. 2011) (mixed claims "create confusion as to when direct infringement occurs because they are directed both to systems and to actions performed by" users).

Claim terms that lack antecedent basis are indefinite. *See, e.g., Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1348-49 (Fed. Cir. 2002) (claim ending in the middle of a claim limitation was indefinite because it was "impossible to discern the scope of such a truncated limitation"). Furthermore, means plus function claims, which invoke 35 U.S.C. § 112 ¶ 6, may be invalid as indefinite where a patent owner has failed to disclose adequate corresponding structure linked to the recited claim functionality. *Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1311-12 (Fed. Cir. 2012).

In *Nautilus, Inc. v. Biosig Instruments, Inc.*, the Supreme Court clarified that a patent is invalid "for indefiniteness if its claims read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." 572 U.S. at 898-99. "It cannot be sufficient that a court can ascribe some

meaning to a patent's claim; the definiteness inquiry trains on the understanding of a skilled artisan at the time of the patent application, not that of a court viewing matters post hoc." *Id.* at 911 (emphasis in original). The Asserted Claims fail the enablement, written description, and/or definiteness requirements in view of at least the following claim terms and phrases.

A. Failure to Satisfy the Written Description Requirement

The Asserted Claims of the '974 Patent are invalid because the specification of the '974 Patent does not provide an adequate written description to support the scope of the claims sought by Plaintiff in furtherance of its infringement theories. 35 U.S.C. § 112 ¶ 1 requires a patent specification to contain "a written description of the invention." The written description "must do more than merely disclose that which would render the claimed invention obvious." *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1377 (Fed. Cir. 2009). The written description must "clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed" by the time of the application filing date. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). To satisfy the written description requirement, "the applicant must 'convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention,' and demonstrate that by disclosure in the specification of the patent." *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991)). "[E]nough [of the invention] must be included to convince a person of skill in the art that the inventor possessed the invention." *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005).

Defendant's investigation of grounds of invalidity based upon failure to meet the written description requirement is ongoing, and Defendant reserves the right to supplement these Preliminary Invalidity Contentions.

The asserted claims of the '974 Patent, at least under Plaintiff's actual and/or apparent application of the claims, are invalid under 35 U.S.C. § 112 ¶ 1 because the specification fails to describe claim terms in sufficient detail such that one skilled in the art could reasonably conclude that the inventors had possession of the claimed subject matter. Based on the information currently available, the Asserted Claims of the '974 Patent are invalid for lack of written description under § 112 ¶ 1 due to at least the following phrases and limitations being deficient:

- "the stretch panel having a length when unstretched smaller than a length measured along the front portion between the top and bottom locations" – Claim 1

For example, with respect the claim limitation "the stretch panel having a length when unstretched smaller than a length measured along the front portion between the top and bottom locations" recited in Claim 1, the specification fails to provide sufficient details and provides inadequate description regarding how such measurements are to be made, including where to measure and under what conditions the measurements should be made.

- "the stretch panel having … a width when unstretched smaller than a width measured along the front portion between the side seams" – Claim 1

For example, with respect the claim limitation "the stretch panel having … a width when unstretched smaller than a width measured along the front portion between the side seams" recited in Claim 1, the specification fails to provide sufficient details and provides inadequate description regarding how such measurements are to be made, including where to measure and under what conditions the measurements should be made.

- "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 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 the front portion" – Claim 1

For example, with respect the claim limitation "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 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 the front portion" recited in Claim 1, the specification fails to provide sufficient details and provides inadequate description regarding how such measurements are to be made for the recited length and width as discussed above, including where to measure and under what conditions the measurements should be made. Further, as another example, the specification fails to provide sufficient details regarding where and how the front portion is gathered to define a pouch (including based on the dimensions of the stretch panel).

For at least these reasons, independent Claim 1 and all claims dependent upon Claim 1 are invalid because they do not satisfy the written description requirement.

B. Lack of Enablement

The Asserted Claims of the '974 Patent are invalid due to lack of enablement under 35 U.S.C. § 112 ¶ 1. "To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation." *Trs.*

of Bos. Univ. v. Everlight Elecs. Co., 896 F.3d 1357, 1362 (Fed. Cir. 2018); *id.* at 1365 ("[I]f BU wanted to exclude others from what it regarded as its invention, its patent needed to teach the public how to make and use that invention.").

For example, the Asserted Claims of the '974 Patent fail to satisfy the enablement requirement because the specification fails to teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation, in view of at least the following clause from Claim 1: "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 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 the front portion."

First, no enabling disclosure exists in the '974 Patent for the following claim language: "the stretch panel having a length when unstretched smaller than a length measured along the front portion between the top and bottom locations." To the extent a person of ordinary skill in the art could make and use the claimed invention, it would require undue experimentation, as the specification provides insufficient details regarding how and where such measurements should be performed. For example, a person of ordinary skill in the art would not know whether to measure the stretch panel when unstretched and not yet attached or when unstretched but attached, and would further not know where and how to measure along the front portion. Second, no enabling disclosure exists for "a width when unstretched smaller than a width measured along the front portion between the side seams." As discussed above with respect to length, the specification of the '974 Patent fails to disclose sufficient details regarding where and how such measurements are to be made. For example, it is unclear whether the width is measured along the bottom of the

stretch panel, the top of the stretch panel, or from top to bottom along the entirety of the stretch panel. As the specification gives no indications as to how this width is to be measured, and as the figures of the '974 Patent show the width changing from top to bottom (*see, e.g.* Figs. 3-4), the specification fails to teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. Third, the specification fails to teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation because it does not provide sufficient details regarding the limitation "such that 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 the front portion."

For at least these reasons, independent Claim 1 and all claims dependent upon Claim 1 are invalid because they do not satisfy the enablement requirement.

C. Indefiniteness

The Asserted Claims of the '974 Patent are invalid because they fail to meet the definiteness requirement of 35 U.S.C. § 112 ¶ 2. Defendant identifies the following grounds of invalidity under 35 U.S.C. § 112 ¶ 2, which requires that a patent claim "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention." "[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instrs., Inc.*, 572 U.S. 898, 901 (2014). Further, "a patent must be precise enough to afford clear notice of what is claimed, thereby apprising the public of what is still open to them." *Id.* at 909-10 ("Otherwise there would be a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims."). "The Supreme Court explained that a patent does not satisfy the definiteness requirement of § 112

merely because 'a court can ascribe *some* meaning to a patent's claims.' The claims, when read in light of the specification and the prosecution history, must provide objective boundaries for those of skill in the art." *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370-71 (Fed. Cir. 2014). "[A] claim may be invalid as indefinite when (1) different known methods exist for calculating a claimed parameter, (2) nothing in the record suggests using one method in particular, and (3) application of the different methods result in materially different outcomes for the claim's scope." *Saso Golf, Inc. v. Nike, Inc.*, 843 F. App'x 291, 296 (Fed. Cir. 2021).

Defendant contends that at least the following terms in the Asserted Claims are indefinite:

- "side edges attached to the body at side seams extending substantially continuously along either side of the front portion" – Claim 1
- "the stretch panel having a length when unstretched smaller than a length measured along the front portion between the top and bottom locations" – Claim 1
- "the stretch panel having … a width when unstretched smaller than a width measured along the front portion between the side seams" – Claim 1
- "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 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 the front portion" – Claim 1
- "wherein the opening has a U-shape when the stretch panel is in a relaxed state" – Claim 13

For example, Claim 1 fails to satisfy the requirements of 35 U.S.C. § 112 ¶ 2 because the claim term "substantially continuously" fails to inform, with reasonably certainty, those of ordinary skill in the art about the scope of the claimed invention. To the extent "substantially continuously" is a term of degree, the specification and prosecution history do not sufficiently explain how continuous this must be with enough certainty or guidance to one of skill in the art to provide objective boundaries for the claim term. Neither the public nor a person of ordinary skill in the art would be able to determine with reasonable certainty, in light of the '974 Patent specification and prosecution history, the proper scope of Claim 1, including whether a given stretch panel with side edges attached to a body at side seams extending only partially along either side of the front portion is or is not within the scope of the claimed "side edges attached to the body at side seams extending substantially continuously along either side of the front portion."

As another example, the specification and prosecution history do not provide sufficient guidance to one of skill in the art to provide objective boundaries for the claimed "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 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 the front portion" recited in Claim 1. Neither the public nor a person of ordinary skill in the art would be able to determine with reasonable certainty, in light of the '974 Patent specification and prosecution history, the proper scope of this limitation, including which method to use to perform the measurements, or how and where the measurements should be performed. Moreover, neither the public nor a person of ordinary skill in the art would be able to determine with reasonable certainty, in light of the '974 Patent specification and prosecution history, the

proper scope of Claim 1, including whether, for a given stretch panel, "the front portion is gathered from side-to-side and top-to-bottom by the stretch panel."

As an additional example, Claim 13 fails to satisfy the requirements of 35 U.S.C. § 112 ¶ 2 because the claim term "wherein the opening has a U-shape when the stretch panel is in a relaxed state" fails to inform, with reasonably certainty, those of ordinary skill in the art about the scope of the claimed invention. To the extent "U-shape" is a term of degree, the specification and prosecution history do not sufficiently explain how close to a "U" this must be with enough certainty or guidance to one of skill in the art to provide objective boundaries for the claim term. Neither the public nor a person of ordinary skill in the art would be able to determine with reasonable certainty, in light of the '974 Patent specification and prosecution history, the proper scope of Claim 13, including whether a given stretch panel with an opening that is attached to underwear is or is not within the scope of the claimed "wherein the opening has a U-shape when the stretch panel is in a relaxed state."

For at least these reasons, independent Claim 1 is invalid, because it does not satisfy the definiteness requirement. Further, all claims which depend either directly or indirectly from independent claim 1 are invalid for at least the same reasons. And, Claim 13 is additionally independently invalid because it does not satisfy the definiteness requirement.

VI. P.R. 3-4: Accompanying Document Production

Pursuant to P.R. 3.4, Defendant produces documents bearing bates numbers TOMMYJOHN_0000001 - TOMMYJOHN_0000281. The production includes prior art references that are cited in and support the accompanying invalidity claim charts, and are evidence of the state of the art at the time of the alleged invention(s) (although it may not include references that appear in the file histories of the '974 Patent, as contemplated under the Local Patent Rules).

The production also includes additional prior art references, not cited in the accompanying invalidity contentions, which evidence the state of the art at the time of the alleged invention(s). For certain foreign references, Defendant has obtained and provided translations to give Plaintiff fair notice of the art. Defendant reserves the right to supplement these contentions to rely on further content from certified translations of those same references.

Defendant's search for prior art references, additional documentation, and/or corroborating evidence concerning prior art products and the like is ongoing, as explained above. Defendant reserves the right to continue to supplement their production as Defendant obtains additional prior art references, documentation, and/or corroborating evidence concerning invalidity during the course of discovery. Without limitation, Defendant will promptly produce any prior art-related documentation or other evidence received in response to any third-party subpoenas it has served or may serve, and will supplement its contentions accordingly.

DATED: July 17, 2024

Sincerely,

/s/ *Joseph J. Raffetto*

Joseph J. Raffetto (admitted pro hac vice)
Anna Shaw (admitted pro hac vice)
Scott A. Hughes (admitted pro hac vice)
Jacob Felicetty (admitted pro hac vice)
Of counsels
Hogan Lovells US LLP
555 Thirteenth St, NW
Washington, DC 2004
Tel.: (202) 637-5600
Fax: (202) 637-5910

Bruce D. Oakley
Attorney-in-charge
Texas State Bar No. 15156900
Hogan Lovells US LLP
609 Main Street, Ste 4200
Houston, TX 77002
Tel.: (713) 632-1400
Fax: (713) 632-1401

Attorneys for Defendant Tommy John, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above document was served on July 17, 2024 to counsel of record for Plaintiff via email at the following address:

heath@dtlawyers.com
tim@dtlawyers.com
luman@dtlawyers.com
Heath Aaron Novosad
Timothy Earl Bond , Jr.
John F Luman , III
Daniels & Tredennick, LLP
6363 Woodway Dr., Suite 700
Houston, TX 77057

/s/ Joseph J. Raffetto
Joseph J. Raffetto