

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Tommy John, Inc.,
Petitioner,

v.

Package Apparel Inc.,
Patent Owner.

Case IPR2024-01163
Patent 10,834,974

**PETITIONER'S PRELIMINARY REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

Filed on behalf of Petitioner:
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TABLE OF AUTHORITIES

Cases

<i>Advanced Bionics LLC v. Med-El Electromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020)	<i>passim</i>
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)	<i>passim</i>
<i>Apple Inc. v. Geoscope Technologies Pte. Ltd.,</i> IPR2024-0003, Paper 14 (P.T.A.B. May 10, 2024)	3
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Statutes

35 U.S.C. § 314(a)	<i>passim</i>
35 U.S.C. § 315(d)	5
35 U.S.C. § 325(d)	<i>passim</i>

As authorized by the Board (EX3001), Petitioner submits this Preliminary Reply to Patent Owner's Preliminary Response ("POPR") regarding whether discretionary denial is appropriate under 35 U.S.C. §§ 325(d) and 314(a). Under § 325(d), the record is clear the combinations of references were never substantively considered or used in a rejection of any claims. And, because the district court case is *already stayed* pending resolution of this IPR, discretionary denial under *Fintiv* is also inappropriate.

I. 35 U.S.C. § 325(D) AND *ADVANCED BIONICS*

The Board should not discretionarily deny review under *Advanced Bionics* because the prior art or arguments used in the IPR were not previously presented to the Office, and even if they were (which they were not), the Office erred in evaluating the art or arguments. *Advanced Bionics v. Med-El Electromedizinische Gerate*, IPR2019-01469, Paper 6 at 8-9 (P.T.A.B. Feb. 13, 2020) ("*Advanced Bionics*"). As set forth in the Petition, the combination of Kitsch's and Carrillo's elastic pouch-forming materials with Brocks's teachings of attaching elastic in a stretched state to gather material to form a pouch clearly demonstrate the claims are unpatentable. Nothing in the record suggests such a combination was considered.

First, the prior art (Kitsch, Brocks, and Carrillo) and specific combinations in the IPR are not the same as those previously presented to the Examiner. *Id.* at 9-11. (considering *Becton*, *Dickinson* factors (a)-(b), (d) in applying *Advanced Bionics*

step 1). While these references were cited in IDS submissions, nothing suggests that the Examiner substantively considered them. No office action rejecting the claims over any prior art was issued, as the '974 Patent was allowed after receiving only a double-patenting rejection. Even considering the prosecution of the '974 Patent's parents, neither the asserted references nor combinations in the IPR were substantively discussed or used as basis for rejection.¹ *Id.* at 9, n.10.

Moreover, the IPR references are materially different from those discussed by the Examiner during prosecution of the parents.² For example, Patent Owner argues Kitsch and Carrillo are the same as Shlush. (POPR, 17, 23-28, 30-34.) However, Shlush does not teach using elastic material inside of the garment to form a pouch

¹ Patent Owner suggests Petitioner “obfuscates the fact that Kitsch was before Examiner ... by citing to Kitsch’s U.S. Pub. No. 2008/0178369,” (POPR, 10), but Petitioner clearly stated that Kitsch was cited in an IDS. (Pet., 94.) Petitioner cites to the application publication because it is § 102(b) prior art.

² Further, prior art being discussed during the prosecution of the parent is inconsequential. *Sonos, Inc. v. Google LLC*, IPR2023-00118, Paper 9 at 23-24 (P.T.A.B. May 19, 2023) (finding factor (c) weighs in favor of finding material error where the asserted reference was not discussed during prosecution of the challenged patent, but was during prosecution of its parent).

supporting the genitals. (EX1004, 10-12.) In contrast, Kitsch and Carrillo use elastic material inside the garment to form the pouch and expressly state that these elastic materials support the genitals. Patent Owner also attempts to equate Carrillo with Gravette. (POPR, 35-41.) But Gravette, like Shlush, does not use elastic material, and Patent Owner even argued that Gravette’s front panel “is not gathered” and instead “lays flat ... and the pouch hangs loosely behind it.” (EX1004, 215.) Again, Carrillo is different—Carrillo’s U-shaped elastic garment when sewn to the underwear gathers the front portion to form a pouch. (Pet., 60-66.)

Second, even if the combinations of Kitsch and Carrillo with Brocks were “previously presented,” the Office materially erred in evaluating the art. *Advanced Bionics*, at 9-11 (considering *Becton*, *Dickinson* factors (c), (e), and (f) in applying *Advanced Bionics* step 2). The Board routinely finds that when prior art references are initialed in an IDS but not otherwise substantively discussed, “a petitioner’s showing that the challenged claims are unpatentable over prior art may itself be evidence of material error by the Office.” *Apple v. Geoscope Technologies*, IPR2024-0003, Paper 14 at 22-23 (P.T.A.B. May 10, 2024); *see also Dexcom v. Abbott Diabetes Care*, IPR2023-01409, Paper 10 at 12-15 (P.T.A.B. Apr. 15, 2024).

Here, the asserted references were included in extensive IDS disclosures and

were never substantively discussed.³ The Examiner materially erred by overlooking the particular combinations of the asserted references as presented in the Petition. In particular, the Examiner did not consider the combination of using elasticized material inside the front portion of the garment as part of a pouch supporting the genitals (*i.e.*, Kitsch's side panels and Carrillo's U-shaped elastic garment) with Brocks's teaching of attaching elastic material in a stretched state to gather material to form a genital pouch. (*See* Pet., 20-27, 58-66.)

As explained, there are material differences between the asserted references and the prior art discussed during prosecution. The Examiner's failure to consider the teachings in the asserted references and absent from the discussed prior art, particularly in the combinations in the Petition, constitutes material error.⁴ Accordingly, discretionary denial is inappropriate under § 325(d) and *Advanced Bionics*.

³ Patent Owner's reference to materials, including invalidity contentions, from the *Rampion* proceeding are irrelevant (POPR, 16-20), as none contain the combinations of Kitsch, Carrillo and Brocks set forth in the Petition.

⁴ Additionally, Patent Owner's discussion of the prosecution of Kitsch is irrelevant to the '974 Patent's claims. (POPR, 28-30.)

II. *FINTIV* AND § 314(A)

Discretionary denial is also inappropriate under the *Fintiv* factors. In fact, as acknowledged by Patent Owner, the parallel district court case has already been stayed pending final resolution of this proceeding with no trial date in place. *Package Apparel, Inc. v. Tommy John, Inc.*, 1:24-cv-06371-LJL, Dkt. No. 50 (Sep. 9, 2024, S.D.N.Y.). Thus, factors 1, 2, and 5 weigh strongly in favor of institution. Factor 3 also favors institution. The SDNY stayed the case immediately upon transfer while the case was in its early stages. Before the stay, neither party had served any written discovery, and the parties had not yet briefed claim construction. Factor 4 likewise favors institution because the Petition challenges all the asserted claims in the related case. Petitioner also stipulates that if the Board institutes, it will not pursue in the related district court case “any ground that [Petitioner] raised or reasonably could have raised” during this proceeding, which removes any overlap. *Sotera Wireless v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020); 35 U.S.C. § 315(d). Finally, factor 6 favors institution because Petitioner’s combinations of references establish that the challenged claims are unpatentable, and as explained above, such combinations were not previously considered by the Office.

III. CONCLUSION

For the reasons stated in its Petition as well as those above, Petitioner respectfully requests that a Trial be instituted and the challenged claims be cancelled.

Dated: November 12, 2024

Respectfully submitted,

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Table of Exhibits

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

Certificate of Service

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, the foregoing **PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was served on November 12, 2024, electronically via e-mail upon the following parties:

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