

IPR No. IPR2024-01163

Patent 10,834,974

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Tommy John, Inc., Petitioner,

v.

Pakage Apparel, Inc.,
Patent Owner.

Case No. IPR2024-01163

Patent 10,834,974

**PATENT OWNER PAKAGE APPAREL, INC.'S
PRELIMINARY SUR-REPLY TO PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

November 19, 2024

Petitioner's Reply failed to cure the defects of its petition. Not only does Petitioner fail to carry its burdens under *Advanced Bionics*, but Petitioner also revises its petition arguments, misrepresents Board decisions, and misrepresents the prior art Petitioner relies upon. Petitioner's Reply also shamelessly ignores Petitioner's decision to leave out 1482 pages from the file history of U.S. Pat. No. 10,834,974 ("974 Patent"), not even mentioning—much less offering an explanation for not submitting—the complete file history of EX2004. As a result, the Board should deny the petition for *Inter Partes* Review.

A. *Advanced Bionics* – Step 1

Step (1) under *Advanced Bionics* evaluates *Becton, Dickinson* factors (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; and (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art. As detailed in Patent Owner's Preliminary Response, *Kitsch, Carrillo*, and *Brocks* were presented to, and considered by, Examiner during prosecution of the '974 Patent. Patent Owner's Preliminary Response ("POPR") at 6-21. *Atrium Medical Corporation v. Bard Peripheral Vascular, Inc.*, IPR2021-01199, Paper 11 at 22-23, (PTAB Jan. 20, 2022) ("if the prior art asserted by Petitioner here was

presented to the Office . . . during prosecution . . . *Advanced Bionics* requires us to consider *Becton, Dickinson's* factors (a) and (b) as satisfied.”).

As pointed out in POPR, Petitioner included a less-than fulsome discussion of the prosecution of the '974 Patent. *See* Pet. at 6-7. Despite the paucity of facts and misleading description of what happened during the prosecution of the '974 Patent, Petitioner at least recognized that prior art and argument presented during the prosecution of a parent patent affects later issued patents in the same family. In its Reply, however, Petitioner cites to *Sonos, Inc. v. Google LLC*, IPR2023-00118, Paper 9 at 23-24 (May 19, 2023) (Grossman, J.) for the purported proposition that “prior art being discussed during the prosecution of the parent is inconsequential.” Reply at 2 n.2. *Sonos* does not remotely stand for such a proposition. *Sonos* instead explains that if the Examiner does not substantively evaluate prior art, its mere inclusion as “considered” in a file history may be insufficient to overcome *Becton, Dickson* factor (c). IPR2023-00118, Paper 9 at 24.

Petitioner takes further liberties in citing *Apple v. Geoscope Technologies*, IPR2024-00031, Paper 14 at 22-23 (P.T.A.B. May 10, 2024) and *Dexcom v. Abbott Diabetes Care*, IPR2023-01409, Paper 10 at 12-15 (P.T.A.B. Apr. 15, 2024) for the proposition that a showing that challenged claims are unpatentable over prior art may be evidence of material error. *Apple*, like *Sonos*, only applies that exception “where the Office did not previously address the pertinent art in substance.” IPR

2024-0003, Paper 14 at 23. And *Dexcom* does not contain the quotation attributed to it and is further based on a “cursory” Examiner consideration of the petitioner’s cited references. IPR2023-01409, Paper 10 at 12-15. Misciting Board decisions should not be countenanced.

Patent Owner explained in detail how the prior art before Examiner rendered Petitioner’s arguments regarding Kitsch and Carrillo redundant, at best. POPR at 21-41. In response, Petitioner now states something found nowhere in Kitsch or Carrillo: they “expressly state that these elastic materials support the genitals.” Reply at 3. Neither reference provides such a statement because they do not support the genitals. *See* POPR at 21-41. Indeed, Petitioner provides no citation in these references whatsoever. Similarly, a couple of sentences later, Petitioner misrepresents Carrillo a second time by stating, “Carrillo’s U-Shaped elastic garment when sewn to the underwear gathers the front portion to form a pouch. (Pet., 60-6.)” Reply at 3. Nowhere in Carrillo is “gather[ing] the front portion to form a pouch” discussed. Petitioner does not provide citation because there is none. There is no justification for Petitioner to misrepresent the references it relies upon.

Having to address such false statements is unfair to the Board and Patent Owner, and the Board should exercise its discretion and deny the petition.

B. *Advanced Bionics* – Step 2

In the second part of the *Advanced Bionics* framework, Petitioner must show that the Office erred in a manner material to patentability. Such errors may include misapprehending or overlooking specific material teachings or relevant prior art or misapplying the law in a material way. *Sonos*, IPR2023-00118, Paper 9 at 22. Step (2) under *Advanced Bionics* evaluates *Becton, Dickinson* factors (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments. Petitioner failed to demonstrate any of these factors.

In fact, Petitioner failed to demonstrate how Examiner erred at all. Petitioner never even discussed the substance of the '974 Patent file history, so there is no discussion of how Examiner erred with the prior art. Petitioner does now admit that Kitsch is simply side panels (Reply at 4, “i.e., Kitsch’s side panels”), and Examiner clearly knew of Kitsch’s side panels due to Kitsch’s citation in the '974 Patent specification and on numerous IDSs. Petitioner similarly fails to identify how Examiner erred when Carrillo did not bring anything new to the table over Shlush, Gravette and Miller, all of which were considered in detail by Examiner. POPR at

30-41. Petitioner's constant drumbeat that Examiner failed to consider references with elasticized material is simply noise, as Examiner stated the following:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used four-way stretch material in the underwear garment of Gravette as taught by Miller; because Miler teaches that it is known in the art to use four-way stretch material in undergarments and it is beneficial because it provides support and retains its original shape after being stretched, worn, or repeatedly washed (Para. [0020]).

POPR at 36. Examiner had all of Petitioner's art and arguments before her. There simply is no evidence Examiner erred during the prosecution of the '974 Patent.

As detailed here and in Patent Owner's Preliminary Response, there is no justification for the Board and Patent Owner's time, effort, and resources to be expended on this petition under §325(d).

C. Fintiv Factors

In Patent Owner's Preliminary Response, Patent Owner demonstrated with facts why the Board should also deny institution under *Fintiv*. Four of the six *Fintiv* factors favor denial of institution. Petitioner's conclusory, one paragraph response did nothing to change that analysis. As a result, the Board should deny institution under the discretionary factors of *Fintiv*.

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Patent 10,834,974

Date: November 19, 2024

Respectfully submitted,

DANIELS & TREDENNICK, PLLC

/s/ John F. Luman, III

John F. Luman III

USPTO Reg. No. 43,763

Email: luman@dtlawyers.com

Timothy E. Bond

USPTO Reg.: *Pro Hac Vice*

Email: Tim@dtlawyers.com

Daniels & Tredennick, PLLC

6363 Woodway, Ste 700

Houston, Texas 77057

T: 713-917-0024

F: 713-917-0026

Attorneys for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PRELIMINARY SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** is being served electronically on November 19, 2024, to the e-mail addresses shown below:

Joseph Raffetto USPTO Reg. No. 66,218 joseph.raffetto@hoganlovells.com HOGAN LOVELLS US LLP 555 13 th Street, N.W. Washington, DC 20004 T: 202-637-5600 F: 202-637-5910	Scott Hughes USPTO Reg. No. 68,385 scott.hughes@hoganlovells.com HOGAN LOVELLS US LLP 555 13 th Street, N.W. Washington, DC 20004 T: 202-637-5600 F: 202-637-5910
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Date: November 19, 2024

/s/ John F. Luman, III
John F. Luman III
USPTO Reg. No. 43,763
Email: luman@dtlawyers.com
Timothy E. Bond
USPTO Reg.: *Pro Hac Vice*
Email: Tim@dtlawyers.com
Daniels & Tredennick, PLLC
6363 Woodway, Ste 700
Houston, Texas 77057
T: 713-917-0024
F: 713-917-0026

Attorneys for Patent Owner