

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'S RESPONSE

April 16, 2025

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LIST OF EXHIBITS REFERENCED

Exhibit	Document
EX1001	U.S. Pat. No. 10,834,974 (“’974 Patent”)
EX1005	Declaration of Robin Wagner
EX1006	Curriculum Vitae of Robin Wagner
EX1007	U.S. Patent Application Publication 2008-0178369 (“Kitsch”)
EX1008	U.S. Patent No. 5,461,729 (“Brocks”)
EX1010	WO2001037687A1(English Translation of EX1009) (“Carrillo”)
EX2012	April 3, 2025, Deposition Transcript of Robin Wagner
EX2013	Expert Declaration of Bernard N. Kahn, AAS, BS, MOAM
EX2014	Curriculum Vitae of Bernard N. Kahn, AAS, BS, MOAM

I. INTRODUCTION

Underwear. Everyone wears it, but few talk openly about it. But when discussed, active men acknowledge that typical underwear fails to support, relieve pressure and prevent chafing during sports and activities.

Enter Pakage Apparel, Inc., a/k/a BN3TH (“Pakage” or “BN3TH” or “Patent Owner”). To the benefit of men everywhere, support and fashion finally arrived with BN3TH’s invention. Using their own bodies as test subjects, and one of their mothers as a seamstress, the inventors developed an innovative pouch to support their genitalia comfortably and securely during exercise.¹ With the advent of pouch undergarments, like briefs and underpants, swimsuits, and board shorts, came styles and colors. Support with fashion became the yardstick by which active men measured their undergarments. BN3TH has been manufacturing, promoting and selling undergarments for men since 2010.

BN3TH sells its innovative underwear online as well as in specialty retail locations and department stores throughout the United States and the world. BN3TH

¹ *Where BN3TH Began – BN3TH’s co-founders share the original story of pouch underwear*, <https://www.youtube.com/watch?v=lLyM3PfjYWY>.

has won numerous awards for its designs, including the 2021 iF Design Award, which has recognized symbols of outstanding design since its first award in 1954, and the 2022 ISPO Award, which awards innovative sports products and services.

See <https://www.bn3th.com/pages/innovation>; <https://ifdesign.com/en/>; and <https://www.ispo.com/en/awards/ispo-award> (each last accessed April 15, 2025).

To protect its innovative, comfortable, and supportive underwear, BN3TH filed its first U.S. patent application on December 31, 2010. BN3TH's patent portfolio now includes numerous U.S. patents and foreign patents for its undergarments, including United States Patent No. 10,834,974 titled *Garments for Men* (the "'974 Patent").

The success of the '974 Patent and its family of patents is demonstrated by BN3TH's success in the marketplace. Indeed, if imitation is the sincerest form of flattery, BN3TH's success has certainly led to its being flattered, and not just by Petitioner Tommy John, Inc. ("Petitioner"). BN3TH has resolved several patent infringement matters relating to its innovative undergarments with other competitors via confidential settlements and licensing agreements (that have been produced to Petitioner in the ongoing litigation). When Petitioner refused to enter such an agreement, BN3TH sued Petitioner in Cause No. 1:24-cv-06371-LJL, *Pakage*

Apparel, Inc. v. Tommy John, Inc., in the United States District Court for the Southern District of New York (the “District Court Lawsuit”). The District Court lawsuit is stayed pending the outcome of this IPR.

Instead of innovating like BN3TH, Petitioner seeks a shortcut by challenging BN3TH’s ’974 Patent. Petitioner does not dispute that the claims of the ’974 Patent are novel and not anticipated. Rather, Petitioner contends BN3TH’s claims would have been obvious to a person of ordinary skill, but only if that person combined multiple references.

As demonstrated below, Petitioner fails to carry its burden of showing the claims of the ’974 Patent are unpatentable. BN3TH requests that the Board enter a final written decision affirming the patentability of the challenged claims.

II. OVERVIEW OF THE ’974 PATENT

The Background section of the ’974 Patent provides that the invention relates to next-to-skin garments. Examples of embodiments of the invention include briefs, underpants, swimsuits, boarding shorts, cycling shorts, and the like. EX1001 at Col. 1:18-20. As identified in the ’974 Patent, next-to-skin clothing for men must comfortably accommodate the wearer's genitalia. Uncomfortable pressure and/or

chafing of the genital area are common especially for wearers who are performing sports or other activities. *Id.* at Col. 1:24-27.

Claim 1, the only independent claim of the '974 Patent, provides:

1[pre] A male garment comprising:

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

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

1[c] a stretch panel attached to the body inside the front portion, **1[d]** the stretch panel comprising a sheet of elastically resilient four-way stretch material having **1[e][i]** a top edge attached to the body at a top location, **1[e][ii]** a bottom edge attached to the body at a bottom location, **1[e][iii]** side edges attached to the body at side seams extending substantially continuously along either side of the front portion and **1[e][iv]** an opening for receiving a wearer's genitals;

1[f] 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, the stretch panel having **1[g] [i]** a length when unstretched smaller than a length measured along the front portion between the top and bottom locations and **1[g][ii]** a width when unstretched smaller than a width measured along the front

portion between the side seams such that **1[g][iii]** 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.

EX1001 at Col. 8:22-49 (emphasis added). Petitioner's designated expert Robin Wagner's declaration originally used the nomenclature of **1[pre]** through **1[g][iii]**, so Patent Owner uses it here for convenience. EX1005 at 16-18,20,22,23,29,31.

As disclosed in the '974 Patent, several existing garments were described in "Angheluta et al., U.S. Pat. No. 5,029,345; Cutlip, U.S. Pat. No. 7,676,853; Shlush, US patent publication No. 2009/0106874; and Kitsch et al., U.S. patent application Ser. No. 12/000,966." *Id.* at col. 1:28-31. The last reference mentioned, "Kitsch et al.", is one of the prior art references Petitioner relies upon in its petition. *See* EX1007 at 1 ("21 Appl. No.: 12/000,966").

Despite the existence of Kitsch and others, there remained a need for garments for men and boys that were more comfortable to wear than many existing garments, especially with regard to the genital area. EX1001 at Col. 1:31-34. The '974 Patent relates to garments for men that include a pouch to receive the wearer's genitalia and

a stretch panel. Garments which incorporate the disclosed stretch panel may be formed such that the garments are self-aligning with a wearer's genitalia, allowing the garment to be put on by a wearer without the wearer having to manually hold or position the pouch to receive his genitals. *Id.* at Col. 7:18-23. A stretch panel structured and incorporated as illustrated in the accompanying drawings can support and position a wearer's scrotum and penis away from both the wearer's thighs and perineum. The scrotum and penis may therefore be protected from pinching between the thighs or being sat upon, thereby enhancing comfort of the wearer and be separated from the body to reduce discomfort due to perspiration. *Id.* at Col. 7:23-30.

Figures and text of the '974 Patent describe the invention. As seen in FIG. 1 and FIG. 5, the undershorts 10 have an elastic waist band 12 supporting a fabric body 14. A front portion 18 of body 14 is shaped to include extra fabric so that front portion 18 is not pulled tightly against a wearer's body. EX1001, at Col. 2:33-47.

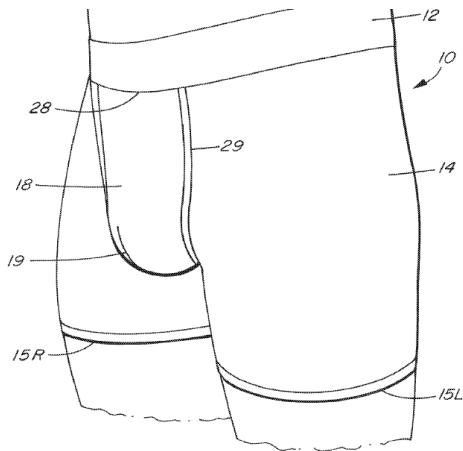


FIG. 1

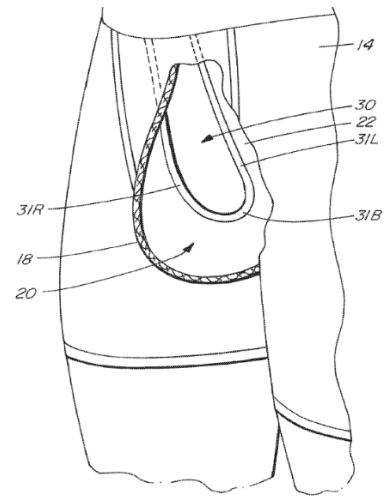


FIG. 5

The front portion 18 forms the front part of a three-dimensional pouch 20 that receives and gently supports a wearer's genitalia. *Id.* at FIG. 6. In the illustrated embodiment, front portion 18 includes a front seam or 'dart seam' 19 that is stitched along a bottom portion of the pouch and that extends centrally and part way along front portion 18 from the crotch of undershorts 10 toward waistband 12 thereby providing extra fabric in front portion 18. *Id.* This adds volume to pouch 20. *Id.*

The undershorts 10 include a stretch panel 22 that extends between waistband 12 and the crotch area 24 of undershorts 10. *Id.* at Col. 2:50-3:4. When undershorts 10 are held open as shown for example in FIG. 3 with waistband 12 under gentle tension and body 14 hanging freely, stretch panel 22 is contracted and pulled away from front area 18 so as to provide a three-dimensional pouch 20 between stretch

panel 22 and front portion 18. *Id.*; *see also* FIG. 3. The bias of stretch panel 22 to be contracted more than front portion 18 helps to cause opening 30 to be held open. Pouch 20 and opening 30 may be self-aligning with the penis and scrotum of a wearer as the wearer inserts his legs through leg openings 15. *Id.*

Stretch panel 22 includes an opening 30 to receive a wearer's genitalia. The opening 30 can be many different shapes (including U-shaped, tear-drop, oval, or elliptical), which have a softly-bound edge 31. EX1001, at Col. 3:5-19. Regardless of the particular shape of opening 30 stretch panel 22 is configured to define opening 30 and to provide support around and underneath the scrotum of the wearer in order to comfortably position the wearer's genitals forward into pouch 20. *Id.* Thus, the stretch panel 22 of the '974 Patent includes an opening and provides support around and underneath the scrotum of the wearer in order to comfortably position the wearer's genitals forward into pouch 20. *Id.*

When the undershorts 10 are held by a man so as to be in a ready-to-wear position (i.e. held in mid-air by the waistband), the weight of undershorts 10 holds stretch panel 22 so that opening 30 is open and clearly defined. *Id.* at Col. 3:26-36. The man's genitals are thus naturally guided through opening 30 and positioned forward into pouch 20 as a result of this bias. As undershorts 10 are pulled on, stretch

panel stretches. *Id.* This bias prevents the man's genitals from falling out of pouch 20 in use, such as during physical activity and other movement. *Id.*

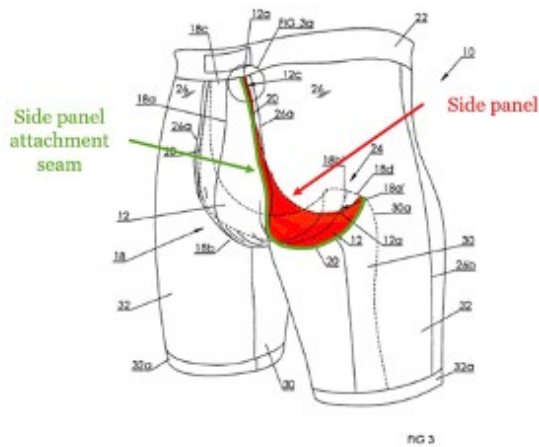
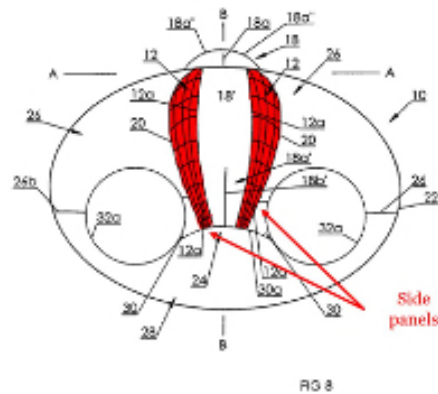
III. OVERVIEW OF PETITIONER'S CITED ART

A. EX1007: U.S. Patent Application Publication 2008-0178369 (Kitsch)

Kitsch discloses the addition of two fences to men's underwear to prevent the genitals from contacting the legs. Kitsch was before the examiner during the prosecution of the '974 Patent and is significantly different than the '974 Patent. Kitsch discloses his underwear garment "is designed using a specifically shaped breathable pouch which includes elasticized breathable wicking mesh material side panels to isolate the scrotum and phallus from the legs and which wick away moisture and provides superior comfort." EX1007 at [0006]. Kitsch's invention "includes an internal double side-panel containment system and an anatomical pouch compartment, and the use of light internal fabric and moisture control athletic performance fabrics." *Id.*

As described in the text and shown in FIG. 3 and 8 (annotated below by Petitioner), Kitsch provides separate "side panels." The "side panels 12 are formed

of two separate and substantially parallel pieces of mesh fabric attached to the laterally spaced apart pouch seams 20.” EX1007 at [0027].



into the fold line between the scrotum and inner thigh to thereby inhibit chaffing and to draw moisture away from where there would ordinarily be skin-to-skin contact and rubbing.” *Id.* “The two side panels 12 thus separate the scrotum 14 from contacting the inner thighs and legs of the user, such separation extending from the waistband 22 to the perineum area 24 which extends under the buttocks of user.” *Id.*; *see* FIG. 7.

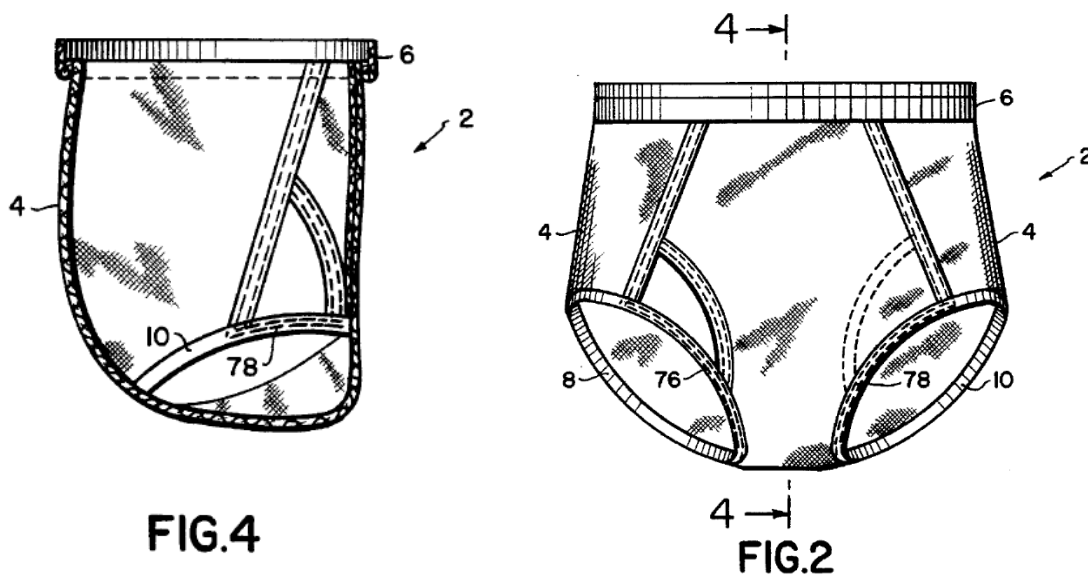
It is noteworthy that Petitioner’s purported expert, Ms. Wagner, summarized Kitsch as “...another specific invention to cradle men’s genitals.” EX2012, at 23:23–24:1. Of course, Ms. Wagner used the exact same language to describe the ‘974 Patent and the three references she was provided by Petitioner (Kitsch, Brocks and Carrillo). *Id.* at 23:10-24:1.

B. EX1008: U.S. Patent No. 5,461,729 (Brocks)

Brocks added elastic to the leg openings of men’s underwear to prevent the scrotum from coming out of the openings. Brocks “relates to men's knitted underwear briefs often referred to as ‘Jockey shorts’.” EX1008 at Col. 1:6-7. Brocks identified the problem with Jockey shorts as “often caus[ing] an annoying discomfort, discomfiture, and embarrassment by allowing the scrotal sack or any part thereof to slip through the band encircling the legs.” *Id.* at Col. 1:9-12. Brocks

pointed out that Jockey shorts construction does not include a pouch to accommodate the male genital organs. *Id.* at Col. 1:12-13. Brocks modified the construction of the front panel of the Jockey briefs by joining the panel plys to form a soft pouch or cage enveloping the male privates and genital area. *Id.* at Col. 1:13-17. Brocks added elastic sections to each hem along the curved edge of the leg opening portion of the inserted front panel plys to make a pouch and to secure the scrotal from slipping out the leg hole. *Id.* at Col. 1:5-21.

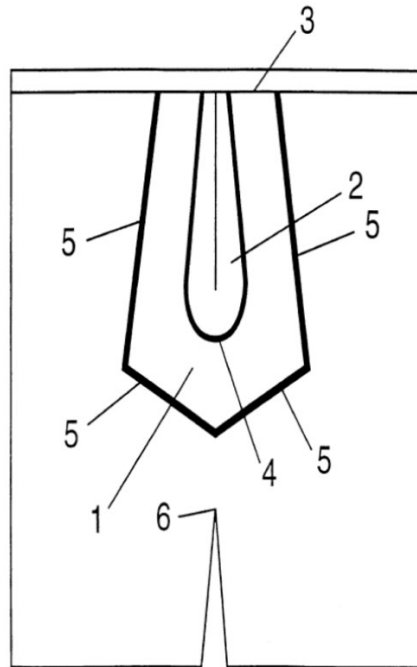
FIG. 4 and FIG. 2 show the Brocks underwear from side and front. As shown, the underwear is the typical Jockey short with a pouch now formed at the bottom due to the elastic strips 76 and 78.



Brocks' FIG. 9 shows the panel 12 with the elastic gathered into shirring form as indicated at 76E and 78E. *Id.* at Col. 4:2-3. The dashed lines indicate the stretched condition. The elastic in the finished panel 12 is restretched and the panel 12 stitched together with the rear section 4. *Id.* The cotton material used for the brief is generally stretchable along only the lateral axis and not the longitudinal axis. *Id.* The elastic strips create a gathering and shirring forming a secure enclosure pouch for the male genitals. *Id.*

C. EX1010: WO2001037687A1_(Carrillo English Translation)

Carrillo discloses a hygienic elastic garment for men's underwear, which forms part and is sewn to classic underpants. EX1010 at (57). The following is the only figure in Carrillo:



According to Carrillo, his garment includes an opening (2) in the shape of a vertical teardrop (2) from the elastic (3) of the waistband of the brief to a distance above the seam of the inseam (6) of the brief with the base of the opening (4) located between the testicles and the groin. EX1010 at 2. Carrillo provides no additional details as to how the “hygienic garment” is sewn to classic underpants, apart from saying that it is “sewn to the inner front part of underwear.” Other than calling it an elastic garment, Carrillo does not disclose the material of the elastic garment.

IV. STANDARDS

Petitioner has “the burden of proving a proposition of unpatentability by a preponderance of the evidence.” 35 U.S.C. § 316(e). “[T]here are two distinct burdens of proof: a burden of persuasion and a burden of production.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375–77 (Fed. Cir. 2016) (quoting *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015)). Both burdens are on Petitioner and never shift to Patent Owner. *Id.* at 1376 (rejecting argument that burdens shift to patent owner once Board institutes IPR).

A. Legal Standards of Obviousness

The Patent Act provides that “[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a).

If a single element of the claim is absent from the prior art, the claim is not obvious. *See CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (“Obviousness requires a suggestion of all limitations in a claim.”); *In re Rijckaert*, 9 F.3d 1531, 1533-34 (Fed. Cir. 1993) (reversing obviousness rejection where prior

art did not teach or suggest all claim limitations). Since the Supreme Court’s decision in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), the Federal Circuit has reiterated that all claim elements of an invention at issue must be found to exist in the prior art references before proceeding with an obviousness analysis. *See Abbott Labs. v. Sandoz, Inc.*, 554 F.3d 1341, 1351 (Fed. Cir. 2008).

Obviousness is a legal determination that is based on underlying factual considerations, including: (1) the level of ordinary skill in the art, (2) the scope and content of the prior art, (3) any differences between the claimed subject matter and the prior art, and (4) secondary considerations of non-obviousness. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966). Petitions for IPR “must address the Graham factors.” *Eizo Corp. v. Barco N.V.*, No. IPR2014-00358, Paper 11 at 29–30 (P.T.A.B. July 23, 2014) (citing *Graham*, 383 U.S. at 17–18). For example, the Board faulted the petitioner in *Eizo Corp.* for failing to identify the differences between the claimed subject matter and the prior art. *Id.* at 29–30. In particular, the Board found insufficient the petitioner’s “conclusory assertion” that “[t]o the extent [the first reference] may not explicitly teach” the limitation, the second reference “explicitly teaches this limitation.” *Id.* at 30. The Board explained that “such an assertion fails to resolve the exact differences sought to be derived from” the second

reference. *Id.* (finding that petitioner had not shown a reasonable likelihood of prevailing on that ground).

The conclusion of obviousness based on a combination of references must also be supported with explicit analysis of a reason to combine those references. *KSR*, 550 U.S. at 418. The Federal Circuit has stated that such reasons must be more than “mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *accord Innogenetics, N.V. v. Abbott Lab’y*, 512 F.3d 1363, 1374 (Fed. Cir. 2008) (agreeing with the district court’s reasoning that “some kind of motivation must be shown from some source, so that the jury can understand why a person of ordinary skill would have thought of either combining two or more references or modifying one to achieve the patented method”); *see also LG Elecs., Inc. v. Cellular Commc’ns Equip. LLC*, No. IPR2016-00197, Paper 7 at 7–11 (P.T.A.B. Apr. 29, 2016) (faulting a petition’s obviousness analysis for lack of sufficient articulated reasons with rational underpinnings for modifying references to achieve particular elements required in the claims).

Additionally, reliance on “common sense” as a basis for adjusting existing technology without any substantiated evidence adds nothing to the obviousness

inquiry. *See Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1377 (Fed. Cir. 2012) (“Within the statutory test to determine if a claimed invention has advanced its technical art field enough to warrant an exclusive right, ‘common sense’ is a shorthand label for knowledge so basic that it certainly lies within the skill set of an ordinary artisan. With little more than an invocation of the words ‘common sense’ . . . the district court overreached in its determination of obviousness.”).

Reliance on hindsight bias is impermissible to support an obviousness finding, as it may not be “the thread that stitches together prior art patches into something that is the claimed invention.” *Metalcraft of Mayville, Inc. v. Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017). Where the necessary reasoning to modify an existing reference is conclusory or absent, “it is especially important to guard against the dangers of hindsight bias” and not simply “assume that ‘an ordinary artisan would be awakened to modify prior art in such a way as to lead to an obviousness rejection.’” *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354 (Fed. Cir. 2013).

B. Claim Construction

Petitioner’s obviousness challenge to the validity of Claims 1-13 and 15-16 of the ’974 Patent (the “Challenged Claims”) does not require analysis under anything other than the plain and ordinary meaning of the claim terms. For this

reason, Patent Owner proposes ordinary and customary constructions of all terms of the Challenged Claims.

C. Person Of Ordinary Skill In The Art (“POSITA”)

A determination of obviousness requires a finding of the level of ordinary skill in the art at the time of the invention. *Graham*, 383 U.S. at 17. The “level of skill in the art is a prism or lens through which ... the Board views the prior art and the claimed invention.” *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). This reference point prevents a factfinder from using its “own insight or, worse yet, hindsight, to gauge obviousness.” *Id.*

To determine the level of ordinary skill, the Board considers various factors, including “1) the types of problems encountered in the art; 2) the prior art solutions to those problems; 3) the rapidity with which innovations are made; 4) the sophistication of the technology; and 5) the educational level of active workers in the field.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666–67 (Fed. Cir. 2000) (citing *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)); *Wangs Alliance Corp. v. Koninklijke Philips N.V.*, No. IPR2015-01290, Paper 63, 13-16 (Nov. 23, 2016). It is more difficult to establish obviousness under

a lower level of ordinary skill. *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1366 (Fed. Cir. 2012).

Petitioner fails to analyze the Board’s factors or any other factors for determining the level of ordinary skill. Pet. at 8. Petitioner instead provides a conclusory description of what it contends is the level of ordinary skill. *Id.*; Ex. 1005 at ¶¶31-32. According to Petitioner, a POSITA may have (1) “*an undergraduate degree in apparel design, apparel manufacturing, textile science, or similar disciplines, along with one year of experience working in apparel design or manufacturing, or textile or fabric engineering,*” or (2) “*more experience in the field may serve as a substitute for formal education.*” *Id.* (emphasis added.) Petitioner provides no further description or analysis on a POSITA. As a result, Petitioner concedes the level of ordinary skill was low with someone becoming a POSITA with just a few years’ experience without any formal education. *Id.*

Ms. Wagner confirmed during her cross-examination that a person with just an undergraduate degree “in design or product development in apparel and about (a year of) experience or, you know, some balance (of) that. Maybe a little bit less education and more experience” would qualify as a POSITA. EX 2012 at 41:7-14.

Ms. Wagner admitted she does not know the criteria courts consider for a person of ordinary skill. At one point, she says that they look for someone “with the minimum amount of experience and education,” and at other times, she claims that the POSITA is not low-level or high-level, but “is the average,” which she then turns around and calls “the minimum qualifications for somebody.” *Id.* at 40:24 – 41:20. This confusing definition is not based on any actual standards, but only because Ms. Wagner claims that she was a POSITA at some point in time and, because she calls herself an expert, she just knows what the definition is. *Id.* at 40:7-23,43:8-16. In sum, the level of ordinary skill in the art at the time of the ’974 Patent was low.

BN3TH offers the expert declaration of Bernard N. Kahn, AAS, BS, MOAM as EX2013 in support of this response. Mr. Kahn is an expert in the field of clothing design and construction and specifically has expertise in men’s undergarments. Mr. Kahn’s qualifications are described in detail in EX2013, at ¶¶2-21 and EX2014. Mr. Kahn agrees that the level of skill in the art at the time of the ’974 Patent was low. EX2013, at ¶27. It is more difficult, therefore, for Petitioner to establish obviousness, and Petitioner cannot overcome that more difficult hurdle as discussed below.

D. Petitioner's Expert Declaration Should Be Given No Weight

Not only did Ms. Wagner use the exact same language to describe the '974 Patent and the three references she was provided by Petitioner to try to invalidate the '974 Patent, EX2012, at 23:10-24:1, Ms. Wagner made several other fatal errors that preclude any weight being given to her declaration.

Ms. Wagner is a hired gun to invalidate patents – she has been hired twice on cases before the PTAB, both times seeking to invalidate patents. EX2012, at 39:11-23. So it is unsurprising that after initially testifying that the only assumptions provided by Petitioner were some boilerplate legal standards in paragraphs 30 and 33-37 of her report, EX2012, at 47:6 – 48:19, and the three references she used to try to invalidate the '974 Patent (which she also called “boilerplate”), *id.* at 13:12–14:15, Petitioner also provided her with all of the colorized figures in her declaration that she/Petitioner misleadingly use to try and show obviousness. *Id.* at 123:5-8 The declaration should be given no weight for this reason alone. *See, e.g., InfoBionic, Inc. v. Braemar Manufacturing, LLC*, IPR2015-01704, Paper 11.

Ms. Wagner testified that she spent 10-15 hours over 2 different days preparing for her deposition, which was focused on a report evaluating just 3 references (provided by counsel). EX2012, at 19:5-14. But Ms. Wagner was unable

to answer basic questions about the patent, the prior art, and her declaration. For example, Ms. Wagner's first response when asked what the '974 Patent covered was, "A specific invention concerning men's underwear." *Id.* at 21:14-19. With prompting, this was "narrowed" to "men's underwear that's constructed a specific way...[t]o hold a man's genitals." *Id.* at 21:20–22:7.

As discussed above, other than being a garment to cradle men's genitals, Ms. Wagner could not otherwise generally describe the inventions in the '974 Patent or the 3 references she was provided by Petitioner to try and invalidate the '974 Patent. *Id.* at 23:10-24:1. Even with prompting during the deposition, Ms. Wagner could not recall basic facts about Petitioner's references. For example, she did not know if Kitsch disclosed a stretch panel—a key component of the '974 Patent that is nowhere to be found in Kitsch. EX2012, at 52:10-14. And after being shown that a search of the term "stretch" only results in a single use of the word to describe a "stretch weave," Ms. Wagner refused to accept that this was the only reference to "stretch" in Kitsch. *Id.* at 53:22–55:6. She also did not know if Kitsch disclosed an "opening." *Id.* at 79:2–84:13. Ms. Wagner also testified that did not know if Brocks included side panels. *Id.* at 90:1-6. Ms. Wagner also testified that she had no idea whether Carrillo included a pouch. *Id.* at 105:7-9. These are key features of the '974 Patent

that Ms. Wagner could not recall from the references Petitioner provided her – and guided her through the use of misleading colorization.

The mental gymnastics Ms. Wagner used to try to invalidate the '974 Patent is nowhere clearer than in her testimony about the shape of Figure 14 in Kitsch:

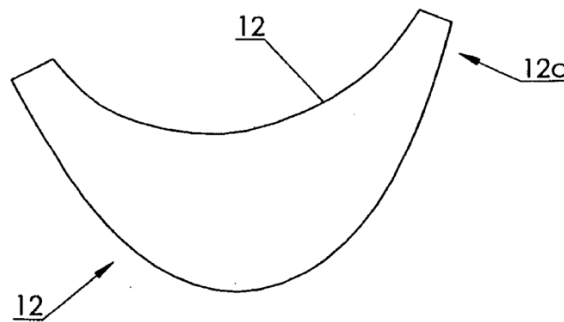


FIG 14

In discussing this Figure 14 in the context of claim 3 of the '974 Patent, Ms. Wagner was asked “Is that shape rectangle?” and her response was “It’s generally rectangular when it’s laid into the garment. It’s rectangularly.” *Id.* at 101:12-14. She claimed this was rectangular or generally rectangular – apparently insinuating at one point that there are multiple definitions of “rectangular” – no fewer than five times over three pages of testimony, before finally agreeing that it looks like a boomerang. *Id.* at 99:21–102:9.

At one point, Ms. Wagner testified that she was unable to understand the description in claim language without seeing the garment. *Id.* at 58:23–59:13. While having a garment may be helpful, obviousness must be determined based on the language in the patents.

But most damaging to Ms. Wagner’s credibility, even more so than her rectangle testimony, is her selective deletion of claim language in her analyses. Ms. Wagner used the copy-and-paste function to draft portions of her declaration. *Id.* at 96:20-24. But Ms. Wagner somehow failed to include the complete claim language found in 1[g][iii], instead choosing to drop “from side-to-side and top-to-bottom”. *Id.* at 95:21–97:4; EX1005, at 31; *see also* Pet. at 21 (as discussed below, Ms. Wagner apparently knows how to use ellipses, she just chose not to do so here). The outline numbering for claim 1, 1[pre]-1[g][iii] is taken from Ms. Wagner’s declaration, EX1005, at 31. Ms. Wagner subsequently dropped the 1[g][i]-[g][iii] outlining later in her declaration when analyzing Carrillo. *Id.* at 83. Petitioner chose not to include any outline nomenclature for 1[g][1]-1[g][iii] in the petition, and Petitioner also deleted 1[g][iii]’s “from side-to-side and top-to-bottom” language in Claim 1. Pet., at 21,60. When asked why the language was not in her quoted claim language, Ms. Wagner said “I summarized it.” EX 2012, at 96:10-12.

Ms. Wagner did not limit her misleading descriptions to just the '974 Patent. She also used selective ellipses to fundamentally alter the nature of Petitioner's references. In describing Kitsch, for example, Ms. Wagner ends her quotation with "isolating the genitalia..." EX1005, at 20. These ellipses cut off an important descriptor in Kitsch: "...isolating the genitalia **from contacting the inner thighs and legs of the user wearing the briefs.**" EX1007, at 2. When asked about this, Ms. Wagner said she "chose" not to include the explanation "[b]ecause I didn't want to." EX2012, at 56:20–57:6. Another time she left out that two pieces of fabric could be "seamed together" to meet because the stretch panel of the '974 Patent, which she left out because, "[a]t the time that's what I needed to talk about..." *Id.* at 61:1-15.

In sum, during cross-examination, Ms. Wagner was unable to answer basic questions about her declaration, the patent at issue, and the prior art. She also admitted to summarizing and selectively quoting the '974 Patent and Petitioner's references. Ms. Wagner did nothing more than rehash Petitioner's arguments using the references and colorized figures provided by Petitioner. Ms. Wagner's declaration is not helpful, and it should be given no weight.

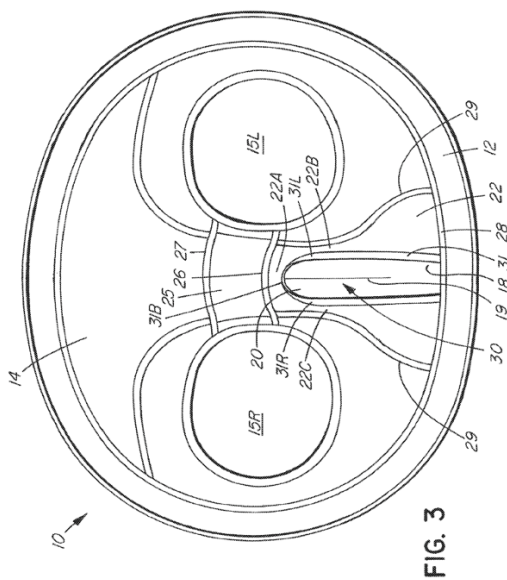
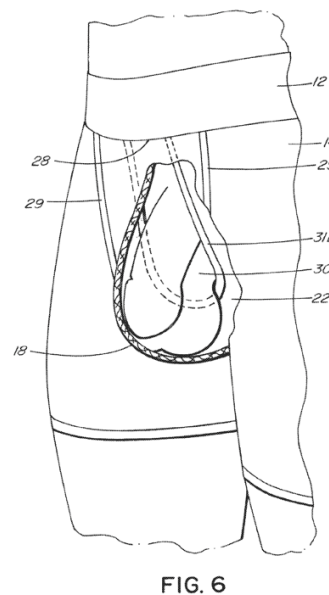
**V. PETITIONER FAILS TO CARRY ITS BURDEN
OF PROVING CLAIMS 1-13 AND 15-16 ARE UNPATENTABLE**

A. Petitioner Fails to Prove Kitsch in View of Brocks Renders Claim 1 Obvious

All relevant teachings of a cited reference must be considered in determining what it fairly teaches to one having ordinary skill in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986) (“It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.”) (quoting *Application of Wesslau*, 353 F.2d 238, 241 (C.C.P.A. 1965)). Petitioner picks and chooses from Kitsch to the exclusion of what Kitsch actually discloses and then alleges a POSITA would understand Kitsch the same way Petitioner wants. Petitioner does the same with Brocks. Petitioner’s purported analyses do not provide the Board with fulsome, accurate appreciations of what Kitsch and Brocks disclose, and Petitioner has failed to meet its burden of proving that Kitsch in view of Brocks renders Claim 1 obvious.

1. Kitsch Does Not Disclose 1[c]

As detailed above in Section II, the '974 Patent discloses a “stretch panel 22 that extends between waistband 12 and the crotch area 24 of undershorts 10.” EX1001, at Col. 2:50-52. FIG. 3 and FIG. 6 show how the stretch panel 22 works with the front portion 18 to create a three-dimensional pouch 20 for the wearer’s genitalia:



Id. at Col. 2:62-66, FIG.3, FIG.6; *see also* EX2013, at ¶50. Stretch panel 22 includes an opening 30 to receive a wearer's genitalia (penis and scrotum) with the opening 30 providing support around and underneath the scrotum of the wearer in order to

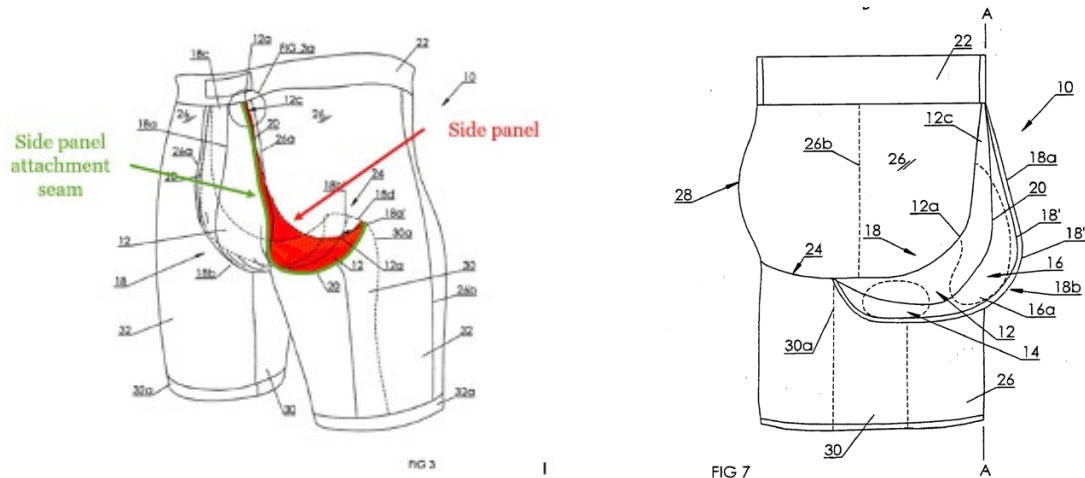
comfortably position the wearer's genitals forward into pouch 20. EX1001, at Col. 3:5-19. Claim element 1[c] claims “a stretch panel...” *Id.* at Col. 8:23-49.

By contrast, and contrary to Petitioner’s assertion and Ms. Wagner’s opinion, Pet. at 12, EX1005 at ¶20, Kitsch does not disclose a stretch panel. EX2013, at ¶51. Indeed, the only instance of the word “stretch” in Kitsch is found describing a material. *Id.*; EX1007 at [0030](“a so-called four-by-four stretch weave”).

Rather, as detailed above in Section III.A., Kitsch discloses “side panels.” The “side panels 12 are formed of two separate and substantially parallel pieces of mesh fabric attached to the laterally spaced apart pouch seams 20.” EX1007, at [0027] and FIG. 3; EX2013, at ¶52. “The side panels 12 form a pair of generally parallel fences which extend upwardly from, and along, seams 20 so as to extend their uppermost edges 12 a upwardly substantially completely into the crack or fold between the laterally outer sides of scrotum 14 and the top of the inner thighs, that is, along the fold of skin where the top of the inner thighs join the top of the scrotum along a lower-most aspect of the abdomen of user 8.” EX1007, at [0028]; EX2013, at ¶52.

By contrast to the stretch panel of the ’974 Patent, the side panels of Kitsch are attached orthogonally from the pouch. EX1007, at [0029]; EX2013, at ¶52. The

side panels 12 in Kitsch are not seamed or stitched together to surround the genitals. They are parallel to each other. They never meet. EX2013, at ¶52.



As can be seen in Kitsch FIG. 3 and 7, the side panels 12 isolate the scrotum 14 and phallus 16 (shown diagrammatically in dotted outline in FIG. 7) from contacting the inner thighs and legs of the user wearing the briefs. EX1007, at [0026]. As shown in red in the annotated FIG. 3 above, the “two side panels 12 separate the scrotum 14 from contacting the inner thighs and legs of the user, such separation extending from the waistband 22 to the perineum area 24 which extends under the buttocks of user.” EX1007, at [0028]; EX2013, at ¶53.

Not only is the stretch panel 22 of the '974 Patent structurally different than the two parallel side panels 12 of Kitsch, the stretch panel and side panels perform

significantly different functions. EX2013, at ¶54. Indeed, a simple comparison of the wearer figure of the '974 Patent with the wearer figure of Kitsch shows the difference in wearer support. *Id.* As shown in FIG. 6 of the '974 Patent (below), the stretch panel separates the genitalia from the body of the wearer, while FIG. 7 of Kitsch (below) shows the genitalia pushed against the body of the wearer. *Id.*

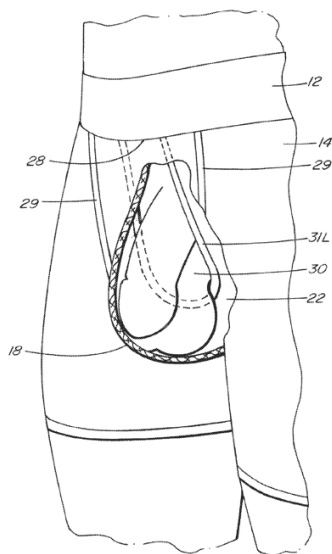


FIG. 6

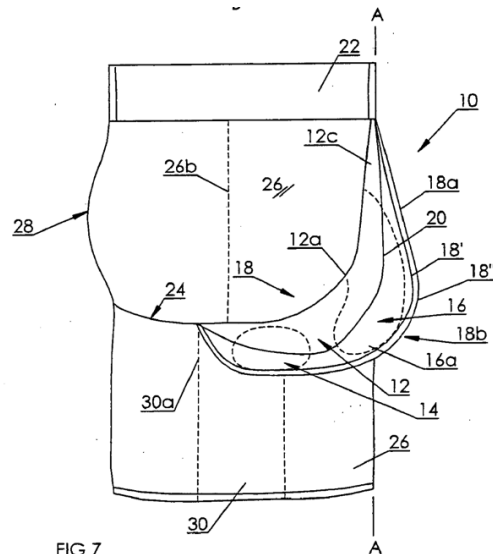


FIG 7

While the side panels of Kitsch may separate the genitalia from contacting the inner thigh and legs (a lateral direction), Kitsch puts the genitalia in harm's way when the wearer sits or rides a bike. *Id.* The scrotum 14 hangs below. *Id.* By contrast, the stretch panel of the '974 Patent keeps the genitalia in an enclosed pouch separated from the body and keeps the scrotum from hanging below. *Id.*

As detailed above in Section IV.D, Ms. Wagner’s declaration included many false and misleading statements. For example, in ¶50 of her declaration, she misleadingly quoted a portion of Kitsch, omitting text to give a false impression that the side panels 12 of Kitsch perform the same function as the stretch panel 22 of the ’974 Patent. Specifically, Ms. Wagner provided the Board with this shortened quote: “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.)” EX1005, at ¶50; *see* Pet. at 12. This leaves the Board with the impression that the side panels isolate the genitalia into a pouch, which is intended to cause confusion with the stretch panel of the ’974 Patent. The complete quote provides, “interior side-panels 12, preferably constructed of an elasticized breathable mesh fabric, for the purpose of isolating the genitalia, in particular scrotum 14 and phallus 16 (shown diagrammatically in dotted outline in FIG. 7), into the pouch compartment 18, thereby isolating the genitalia from contacting the inner thighs and legs of the user 8 wearing the briefs.” EX1007, at [0026](underlining showing removed text). By removing the underlined language, Ms. Wagner and Petitioner diverted attention away from FIG. 7 of Kitsch (discussed above) and away from the function of Kitsch’s side panels 12. EX2013, at ¶55.

Even more deceptive is Ms. Wagner’s attempt to make the construction of the ’974 Patent’s stretch panel sound like the two side panels of Kitsch. EX1005 at ¶50. As detailed above, Kitsch has two side panels 12. EX1007, at [0027]. In an effort to have the stretch panel sound like two side panels, Ms. Wagner misleadingly states, “As explained in the ’974 Patent, the stretch panel may be formed from a single piece of fabric or, like in Kitsch, ‘from a plurality of pieces of fabric[.]’ (’974, 8:5-10; *see also* cl. 14.)” EX1005 at ¶50. But the Kitsch side panels are not seamed or stitched together—they are parallel, and they never meet. EX1007, at [0027]; EX2013, at ¶56. If Ms. Wagner used the complete quote from the ’974 Patent it would be clear there is a lone stretch panel, “Stretch panel **22** may optionally be formed from a plurality of pieces of fabric seamed together.” EX1001, at 8:5-6. If Kitsch actually disclosed a stretch panel, Ms. Wagner and Petitioner would not need to misleadingly quote Kitsch and the ’974 Patent.

2. Kitsch Does Not Disclose 1[d]

The ’974 Patent claims “the stretch panel comprising a sheet of elastically resilient four-way stretch material...” EX1001, at Col. 8:29-30. Kitsch, on the other hand, 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% NylonTM and 20% SpandexTM.” EX1007, at [0030]. Kitsch does not disclose a four-way stretch material. EX2013, at ¶57.

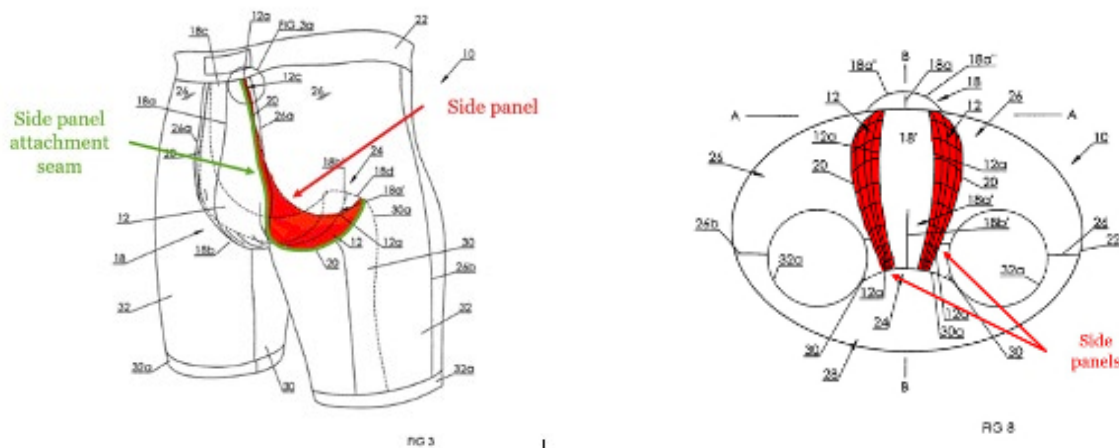
Kitsch thus calls for its side panels to be made of mesh knit weave in a 4x4 (box weave) woven fabric with a limited amount of stretch in the length and width, whereas the '974 Patent's stretch panel is constructed of 4-way stretch knit fabric which, due to its construction (tricot construction), stretches in the length and width equally. *Id.* The two serve very different purposes: where Kitsch focuses on the fabric's breathability, the '974 Patent calls for elasticity and comfort. *Id.* For the Kitsch design, stretch is based on the content of Spandex, whereas, the '974 Patent choice of a 4-way stretch knitted fabric yields stretch via the fabric construction and can be further enhanced by utilizing Spandex in the yarns of the fabric. *Id.*

3. Kitsch Does Not Disclose 1[e]

Petitioner manipulates the claim language of the '974 Patent to cherry pick from Kitsch the installation of the side panels to the exclusion of other parts of Kitsch that are necessary to understand what Kitsch fairly suggests to one skilled in the art. *See Bausch & Lomb, Inc.*, 796 F.2d at 448. Contrary to Petitioner's argument, Kitsch does not disclose a top edge, a bottom edge, and a side edge as described in the '974

Patent. *See* Claim 1[c], Section II, above. In fact, nowhere does Kitsch use the terms top edge and bottom edge to describe the attachment of the side panels to the body. *Compare* EX1005, at ¶¶56-57 and Pet. at 15-18 *with* EX1007 and EX2013, at ¶58.

In fact, as shown in FIG. 3 and 8 (annotated below), the two side panels 12 form “a pair of generally parallel fences which extend upwardly from, and along, seams 20 so as to extend their uppermost edges 12a upwardly substantially completely into the crack or fold between the laterally outer sides of scrotum 14 and the top of the inner thighs,” EX1007, at [0028]:



The side panels 12 extend “from the waistband 22 to the perineum area 24 which extends under the buttocks of user.” EX1007, at [0028]; EX2013, at ¶59.

Kitsch’s side panel installation is significantly different than the ’974 Patent’s stretch panels. *See* Section V.A.1, above; EX2013, at ¶60. There is nothing about the installation of the two side panels of Kitsch that would render the stretch panel installation in the ’974 Patent obvious to a POSITA. There is simply nothing about Kitsch’s side panel construction and function that would motivate a POSITA to arrive at the stretch panel of the ’974 Patent. *Id.*

The Kitsch side panels are not seamed or stitched together—they are parallel, and they never meet, so they do not include any opening. EX2013, at ¶61. Despite these facts, Petitioner states “Kitsch’s side panels include an ‘opening’ for receiving the wearer’s genitals in ‘an anatomical pouch compartment[.]’ (Kitsch, [0006].)” Pet. at 19. At best, this argument is misleading.

The word “opening” is nowhere found in the description of Kitsch’s invention. Kitsch did describe the prior art reference Angheluta as having an opening, but nowhere else is “opening” used. EX2013, at ¶62. If Kitsch’s invention actually included an opening in the side panels, Kitsch would have disclosed it, as he knew what an opening was within a panel as evidenced by his description of Angheluta.

Rather than point to an actual opening in Kitsch, Petitioner contrives an argument that the space between the two parallel side panels 12 is an opening. EX1005, at ¶¶ 59-60; Pet. at 19-20. But Ms. Wagner admitted the Kitsch side panels did not include an opening. EX2012, at 80:24-82:5. She also admitted that the side panels are not stitched together to create a stretch panel as disclosed in the '974 Patent, but instead are “seamed” together because, even though there is a space between them, they are both connected to seam 24. EX2012, at 62:25-68:6. This tortured explanation is like saying that the uprights of a football goalpost are seamed together because, even though they are parallel like the side panels in Kitsch, they are both attached to the crossbar. That is not what the '974 Patent discloses as its stretch panel. EX2013, at ¶63.

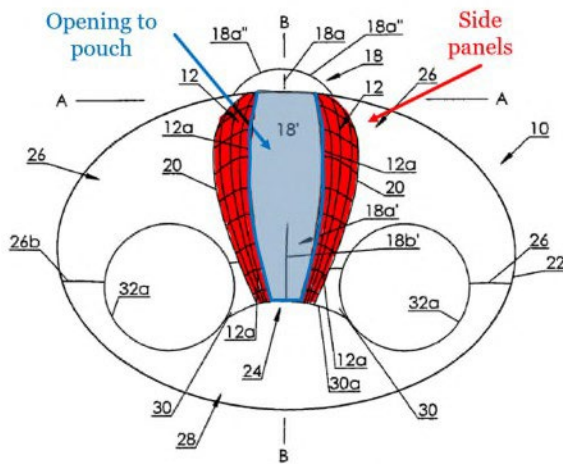


FIG 8

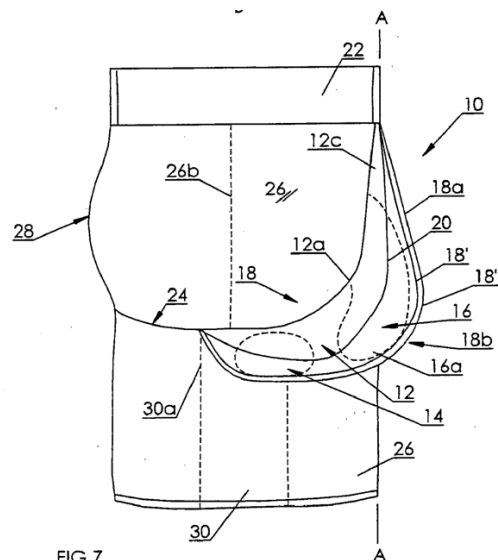


FIG 7

When asked about annotated FIG. 8, Ms. Wagner said the area between the two side panels (in blue) is the opening found in claim 1[e][iv]. EX2012, at 79:21-80:3. The coloring of the FIG. 8 and “opening to pouch” provided to Ms. Wagner by Petitioner’s counsel, is very misleading. The blue and text “opening to the pouch” simply point to inner liner 18’ which is shown clearly in FIG. 7 above. EX1007; EX2013, at ¶64. In fact, Kitsch describes the construction as

[0036] The pear-shape of pouch compartment 18, as viewed from the front and defined by seams 26a, which start at the waistband 22 and end near to the posterior perineum, create greater rear pouch volume in pouch compartment 18, increasing the depth and resulting in more area for the scro- tum to hang naturally, while providing the cradle-like support on the shelf-like tableau 18’ formed by the closing of seam 18b’ of inner liner 18’. The width from the lateral exterior seams 26a to the center seam 18a optimizes a maximal volume while maintaining support. The apex 18b is situated to most fully accommodate the head 16a of the phallus 16.

EX1007, at [0036], EX2013, at ¶64. The side panels have nothing to do with creating the pouch nor providing access to the pouch. EX2013, at ¶64.

Nowhere in Kitsch does it mention the side panels obstructing access to the pouch such that an opening through or between the side panels is needed. Indeed,

Kitsch describes the added side panels as being orthogonal to the pouch, on either side of the pouch:

The pair of side panels 12 are preferably formed so as to cup the genitalia, that is, are formed so as to be cupped in laterally opposed facing relation to inhibit skin-to-skin contact between a user's thighs and scrotum. Although positioned to extend generally orthogonally inwardly from the front of the brief, for example where the front of the brief is defined by plane A which generally contains the pair of pouch seams 20, the laterally outward curvature of the side panels may be described as convex, for example as seen in the cross-section of FIG. 5.

EX1007, at [0029]; EX2013, at ¶65. Thus, the side panels 12 do not need an opening, nor do they create one for the phallus and scrotum to access the pouch. EX2013, at ¶65.

Petitioner's tortured argument that the open area between the side panels creates an opening to the pouch is shown by simply removing the side panels. *Id.* at ¶66. If there are no side panels, Kitsch is just another pair of common pouch underwear waiting to receive men's genitalia. *Id.* Under Petitioner's theory of "opening" the area between the leg openings in Kitsch would now be Petitioner's opening to the pouch. *Id.*

4. Kitsch Does Not Disclose 1[f]

As discussed above, Kitsch does not disclose a top edge, a bottom edge, or a side edge as described in the '974 Patent. Rather, the side panels 12 of Kitsch extend “from the waistband 22 to the perineum area 24 which extends under the buttocks of user.” EX1007, at [0028]; EX2013, at ¶68. Kitsch’s side panel installation is significantly different than the '974 Patent’s stretch panels. *See* Section V.A.3, above; EX2013, at ¶68.

Other than Petitioner stating that the side panels of Kitsch are made from nylon and Spandex, EX1005, at ¶61, Petitioner fails to show how the Kitsch side panels are directionally resilient between a top edge and a bottom edge and a direction between the side edges. EX2013, at ¶69. Ms. Wagner claimed top and bottom edges in ¶¶56-57, but Petitioner fails to explain how the side panel is resiliently elastic in those directions when one is attached to the waistband and the other to an area behind the perineum. *Id.*

More problematic for Ms. Wagner and Petitioner is how their purported stretch panel (Kitsch’s side panel) is resiliently elastic ... in a direction between the side edges since by Ms. Wagner’s definition of a side edge is the location where the side panel attached to the body. Ms. Wagner originally argued the two parallel side

panels have side edges attached to the body at seams 20 and 26. EX1005, at ¶50. In other words, Ms. Wagner's position is one side panel has a side edge attached to the body, but the other is not. The other "side edge 12a" is described by Kitsch as extending upwardly "substantially completely into the crack or fold between the laterally outer sides of scrotum 14 and the top of the inner thighs." EX1007, at [0028]. If one side of the Kitsch's side edge is in the crack or fold, there is no means for the side panel to be "resiliently elastic ... in a direction between the side edges" as Petitioner argues. EX2013, at ¶70.

5. Kitsch Does Not Disclose 1[g]

Kitsch does not disclose claim element 1[g][i], stretched and unstretched lengths from top to bottom of its *side panels*. EX2013, at ¶71. Kitsch does not disclose claim element 1[g][i], stretched and unstretched lengths across the width in the front portion of the body. *Id.* In fact, such a discussion is meaningless in Kitsch because the side panels do not pull across the front. The side panels are fences. *Id.* Kitsch also does not disclose gathering at all. *See* EX1001, at Col. 8:44-48; EX2013, at ¶71. There is no discussion about the front portion being gathered from side-to-side and top-to-bottom by the stretch panel to define a three-dimensional pouch between the stretch panel and the front portion. EX2013, at ¶71. In fact, the side

panels in Kitsch do not pull together fabric in any direction to create a pouch. The side panels are orthogonal to the pouch so there is no means by which to gather with the material of the side panels. EX1007; EX2013, at ¶71.

6. Combining Kitsch with Brocks does not Render the '974 Patent Obvious

As a result of Kitsch alone not teaching the elements of Claim 1, Petitioner argued that the combination of Kitsch and Brocks renders Claim 1 obvious. It does not. EX2013, at ¶72.

An obviousness determination requires “more than a mere showing that the prior art includes separate references covering each separate limitation in a claim.” *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011) (citing *KSR*, 550 U.S. at 418). It requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined the prior art elements in the normal course of research and development to yield the claimed invention. *Id.*

Petitioner’s combination looks at the prior art with the benefit of hindsight, attempting to use the '974 Patent “as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered

obvious.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); accord *Winner Int’l Royalty Corp. v. Wang*, 11 F.Supp.2d 18, 24 (D.D.C. 1998) (“The standard of obviousness is not whether in hindsight, it seems elementary that someone would have combined ... certain elements in the prior art to form the invention in question.”), *aff’d*, 202 F.3d 1340 (Fed. Cir. 2000) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983)). Even with the benefit of the ’974 Patent as a template, Petitioner’s combination fails to render obvious Claim 1 of the ’974 Patent.

Brocks “relates to men's knitted underwear briefs often referred to as ‘Jockey shorts’.” EX1008, at Col. 1:6-7; *see also* Section III.B, above. Petitioner must demonstrate that a person of ordinary skill in the art would have been motivated to combine the teachings of Kitsch and Brocks to derive the claimed subject matter with a reasonable expectation of success. *Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009); *Apotex Inc. v. Wyeth LLC*, No. IPR2014-00115, Paper 94 (Apr. 20, 2015). Mere “conclusory statements” are insufficient; “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418. Petitioner fails to make this required showing.

A POSITA would not combine Kitsch and Brocks even with the hindsight reconstruction Ms. Wagner attempts, because both references define a genital pouch as a portion of the garment that traps the genitals against the body. By clearer definition, these two garment designs create a “cup-like” or “pouch-like” portion of the garment to trap the genitals against the body, limiting the movement of the genitals to one extent or another. Neither design surrounds the genitals as the ’974 Patent design to separate the genitals from the body and limit the movement of the genitals for comfort. EX2013, at ¶75.

Petitioner fails to show *why* a POSITA would have been motivated to combine Kitsch and Brocks. Petitioner’s alleged rationale for combining Kitsch and Brocks is premised on a handful of conclusory assertions rather than articulated reasoning with rational underpinnings. Pet. at 25-27. First, Petitioner argues that “[i]t would have been obvious to a POSITA to modify Kitsch to stitch Kitsch’s elasticized side panels to front panel 18 in a stretched condition, as taught by Brocks, in order to create a ‘gathering and shirring forming a secure enclosure pouch for the male genitals.’” Pet. at 25. But, without the ’974 Patent as a roadmap, a POSITA would not be motivated to modify Kitsch with Brocks at all. Kitsch uses side panels, and it already had a pouch. EX2013, at ¶¶76-77. “Under no circumstances would a

POSITA studying Kitsch conclude that the two side panels whose purpose is preventing the genitals from touching the thighs or legs, should be joined together.” *Id.* at ¶77. Petitioner fails to explain why a POSITA would be motivated to modify Kitsch to stitch Kitsch’s elasticized side panels to front panel 18 in a stretched condition. Rather, a POSITA would recognize that the Kitsch pouch still traps the genitals against the body of the wearer. *Id.*

Second, Petitioner argues that “[a] POSITA would have been motivated to modify Kitsch, as taught by Brocks, to attach the side panels along seams when in a stretched state, stretching them upwards and outwards (*e.g.*, in a lengthwise and widthwise direction), to help form the pouch. (*Id.*, ¶70.)” Pet. at 26. But, again, Petitioner fails to provide *why* a POSITA would have been motivated to combine the references unless they were looking at the ’974 Patent. Nothing in Kitsch nor Brocks suggests such a combination. EX2013, at ¶78.

Third, Petitioner argues that “[a] POSITA would have also understood that attaching the side panels in a stretched state, rather than an unstretched state, would merely be the simple substitution of one known method for another. (*Id.*, ¶71.)” Pet. at 26. That is not correct. Even if it was correct, Petitioner fails to identify why a POSITA would make such a change. Unless, of course, like here, the POSITA is

looking at the '974 Patent as a roadmap to find various elements in the prior art. EX2013, at ¶79.

Contrary to Petitioner's lengthy discussion on how Petitioner would come up with the '974 Patent, if a POSITA combined Kitsch with Brocks, the result would simply be a version of Kitsch with Kitsch's side panels and Brocks' elastic strips around the legs. EX2013, at ¶80. Kitsch already has a pouch, so a POSITA would not need Brocks' pouch or its elastic strips because the fences of Kitsch are intended to keep the genitals from contacting the legs or thighs. *Id.* Brocks does not add anything to Kitsch that Kitsch does not already do. *Id.*

Petitioner fails to prove Kitsch in view of Brocks renders Claim 1 of the '974 Patent obvious because neither Kitsch nor Brocks, either alone or in combination with each other, disclose all of the elements of independent Claim 1. Indeed, Petitioner's expert Ms. Wagner fails to find many of the elements in the prior art references, instead alleging incredible theories of where her POSITA might find some of the elements. Moreover, Petitioner fails to demonstrate any motivation to combine Kitsch and Brocks. Simply stated, even though Petitioner improperly looks at the prior art with the benefit of hindsight from the '974 Patent, Petitioner's prior art fails to render the claimed invention obvious.

B. Petitioner Fails to Prove Carrillo in View of Brocks Renders Claim 1 Obvious

Petitioner fails to prove Carrillo in view of Brocks renders claim 1 of the '974 Patent obvious because neither Carrillo nor Brocks, either alone or in combination with each other, disclose all of the elements of independent claim 1.

1. Carrillo Does Not Disclose 1[d]

Carrillo's invention "consists of a U-shaped elastic garment (1)sewn to the inner front part of standard briefs..." EX1010, at 2; *see* Section III.C, above. Carrillo provides no description for the material of his elastic garment. EX2013, at ¶96. A POSITA would actually likely have concluded that the fabric of Carrillo needed to be compatible with the fabric of the garments to which Carrillo's garment is sewn, which most likely would have consisted of hydrophilic fiber fabrics, not Nylon-Spandex blend and polyester-Spandex blend. *Id.*

Nylon-Spandex and Polyester-Spandex blends of any percentage are entirely hydrophobic fiber fabrics. *Id.* at ¶97. Hydrophobic fibers are moisture-repelling, not moisture-attracting fibers, which means they do not have moisture wicking characteristics, are not 'breathable', and are therefore less comfortable than

hydrophilic fiber fabrics. *Id.* There is no reason a POSITA would have understood Carrillo taught a hydrophobic fabric for its insert. *Id.*

Because Carrillo does not describe the material for his garment insert, Petitioner hypothesizes that the elastic material must be “four-way stretch material” and claims a POSITA would know this. Pet. at 51; EX1005 at 121-126. Of course, Petitioner is using improper hindsight reconstruction again to arrive at the answer of four-way-stretch material, because there is no basis in Carrillo for this assumption. EX2013, at ¶98. The fact that Carrillo discloses something to be stitched to the front of a garment would not lead a POSITA to assume anything about the stretch characteristics of such material. *Id.* A POSITA would know that the fabric need only stretch moderately, and in only one direction, to function. *Id.* Petitioner improperly presumes direction of stretch in the Carrillo patent to establish a ground of contention to the '974 Patent. *Id.*

If Carrillo’s accessory was stitched to the waistband as shown in his figure, it would not need to stretch at all, as it is only connected for only several inches along the waistband. The elastic waistband itself would stretch more than adequately for a wearer to pull the underwear on comfortably, which negates the necessity for any particular amount of horizontal stretch in the Carrillo accessory. EX2013, at ¶99.

And there is no basis for Ms. Wagner's contentions regarding the pinching of "the intimate parts" resulting from stretch characteristics instead of fabric construction and fiber content. EX1005, at ¶ 123; EX2013, at ¶99.

In sum, there is no disclosure of elastically resilient four-way stretch material in Carrillo, and a POSITA would not have understood Carrillo's elastic material to be four-way stretch material.

2. Carrillo Does Not Disclose 1[g]

Carrillo does not disclose or teach a POSITA element 1[g]. Carrillo discloses a men's garment that is sewn to the inner part of underwear and once sewn, creates a vertical hole through which male genitalia can be passed. *See* Section III.C, above. The Carrillo garment and the inside of the underwear are "essentially congruent", and the Carrillo garment is stitched to the underwear around the garment's edges, thereby creating an internal "pocket" between them that may receive the wearer's testicles. Carrillo does not have a pouch. Nor is one implied as Carrillo discloses and shows "classic underpants." EX1010, at 3; EX2013, at ¶102.

Carrillo does not disclose "the scrotum of a wearer of the garment is supported underneath by the stretch panel" like the '974 Patent. *See* EX1001, at Col. 3:14-19. Carrillo simply teaches an opening through which the wearer's testicles may be

inserted but does not teach any mechanism by which the genitalia are supported by the stretch panel. The opening taught by Carrillo is not suited to supporting the wearer's testicles, as it provides no supporting surface underneath the genitalia. EX2013, at ¶103.

Carrillo fails to disclose several of the features recited by Claim 1. In particular, as is clearly visible in the Carrillo figure, the front of the classic underpants shown in Carrillo is not gathered by the pocket created by the Carrillo garment. *See* EX1010. To the contrary, Carrillo discloses the opposite configuration - the front of the underpants lays flat as in a conventional set of men's undergarments, and neither Carrillo nor the classic underpants include a pouch. EX2013, at ¶104.

Claim 1 of the '974 Patent, by contrast, recites that the front portion is gathered from side-to-side and top-to-bottom by the stretch panel. *See* Section II, above. This provides a pouch which is naturally held open to receive a wearer's genitals as illustrated, for example, in Figures 3, and 8 of the '974 Patent. *Id.*; EX2013, at ¶105.

Carrillo 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 1[g][ii] width when unstretched smaller than a width measured along

the front portion between the side seams" as recited in Claim 1. Carrillo does not include such feature. EX2013, at ¶106.

A difference in structure can be clearly seen in the Figure of Carrillo, which shows that the pocket of Carrillo is at best baggy when sewn to the underpants. This difference is significant. A wearer of Carrillo's undergarment will need to physically manipulate his testicles, the pocket, or both in order to insert his testicles into the pocket through opening 2, due at least in part to the bagginess of the pocket and also due in part to the structure of opening 2. Claim 1 of the '974 Patent, however, recites "the stretch panel having a length when unstretched . . . and a width when unstretched . . . such that the 1[g][iii] front portion is gathered from side-to-side and top-to-bottom by the stretch panel and defines a three-dimensional pouch for receiving the wearer's genitals while the garment is being worn." EX1001, at Col. 8:39-49. As further recited by Claim 11, this can cause the pouch to be held open to receive a wearer's genitals while the garment is held in position to be put on. *Id.* at Col. 9:18-22; EX2013, at ¶107.

3. Combining Carrillo with Brocks does not Render the '974 Patent Obvious

Because Carrillo does not render Claim 1 obvious, Petitioner provided Ms. Wagner with Brocks to argue that the combination of Carrillo with Brocks renders Claim 1 obvious. As it did with Kitsch, Petitioner is attempting to use hindsight reconstruction, and a reconstruction of Carrillo, to arrive at element Claim [1e]. *See* Section V.A.3, above; EX2013, at ¶108. A POSITA would not combine Carrillo with Brocks to come up with the '974 Patent as there is no motivation to combine the two references. EX2013, at ¶108.

As discussed above, Brocks modified the construction of the front panel of the Jockey briefs by joining the panel plys to form a soft pouch or cage enveloping the male privates and genital area. EX1008, at Col. 1:13-17. Brocks added elastic sections to each hem along the curved edge of the leg opening portion of the inserted front panel plys to make a pouch and to secure the scrotum from slipping out the leg hole. *Id.* at Col. 1:5-21. Section III.B, above. Brocks traps the genitals against the body. *See* Section III.B, above; EX2013, at ¶109.

As detailed above, FIG. 4 and FIG. 2 show the Brocks underwear from side and front. The pouch created by Brocks is at the bottom of the underwear which

makes sense since the elastic around the leg holes is to keep the genitals from falling out the leg holes. EX2013, at ¶110.

Despite the clear disclosure of Brocks, Petitioner alleges a POSITA would use the gathering and shirring created by elastics strips 76 and 78 around the legs with Carrillo to create the gathering in element Claim 1[c]. There simply is no motivation or disclosure to make such garment without using hindsight reconstruction. EX2013, at ¶111.

Petitioner must demonstrate that a person of ordinary skill in the art would have been motivated to combine the teachings of Carrillo and Brocks to derive the claimed subject matter with a reasonable expectation of success. *Procter & Gamble Co.*, 566 F.3d at 994 (Fed. Cir. 2009). Mere “conclusory statements” are insufficient. *KSR*, 550 U.S. at 418. Petitioner fails to make this required showing.

Like with Kitsch and Brocks, Petitioner fails to show *why* a person of ordinary skill in the art would have been motivated to modify Carrillo into the claimed invention of the '974 Patent after reviewing Brocks. *See* Pet. at 83-89. As discussed above, Brocks' invention is to prevent men's genitalia from sliding out of the leg holes of the wearer. EX1008, at Col. 1:9-12. By contrast, Carrillo's elastic garment is to “to eliminate direct contact between the testicles and the groin.” EX1010 at 1.

The objectives of the two prior art references are different, and neither suggests the other's objective is necessary for their respective inventions. EX2013, at ¶113.

Carrillo does provide that his elastic garment may be attached to classic underpants. EX1010, at (57). But if Carrillo was attached to Brocks, which is a modified version of classic Jockey shorts, the Carrillo-Brocks combination would not yield nor render obvious '974 Patent. Indeed, in such combination a pair of underpants would include an elastic garment (Carrillo) and a pouch created by elastic material surrounding leg openings (Brocks). EX2013, at ¶114. There is nothing in either Carrillo or Brocks that teaches or suggests element 1[g] of Claim 1:

the stretch panel having 1[g][i] a length when unstretched smaller than a length measured along the front portion between the top and bottom locations and 1[g][ii] a width when unstretched smaller than a width measured along the front portion between the side seams such that 1[g][iii] 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.

Petitioner not only fails to articulate why a POSITA would be motivated to combine the two references, but how the two references would be combined to arrive at the claimed invention. Petitioner's only purported motivation is

A POSITA would have been motivated to modify Carrillo, as taught by Brocks, to sew the U-shaped elastic garment to the front part of the underwear when in a stretched state, stretching it upwards and outwards (e.g., in a lengthwise and widthwise direction), to aid in pouch formation.

Pet. at 65. That is not motivation. That is reconstructing the '974 Patent. EX2013, at ¶115. Brocks already has a pouch formed by elastic bands around the leg holes. Why would a POSITA looking at Carrillo and Brocks need to modify Carrillo to include a different style of pouch from Brocks? Indeed, Carrillo even states the elastic garment is sewn to classic underpants. If so, a POSITA would not need to modify Carrillo at all. *Id.* Petitioner fails to explain or suggest why a person of ordinary skill in the art would have combined elements from Carrillo and Brocks in the way the claimed invention does. *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012); *Volkswagen Grp. Of Am., Inc. v. Velocity Pat. LLC*, No. IPR2015-00276, 2015 WL 3543109, at *6 (PTAB, June 1, 2015).

Petitioner not only fails to show *why* a person of ordinary skill in the art would have been motivated to combine Carrillo and Brocks, but Petitioner also fails to show *how* a person of ordinary skill in the art would have combined elements from Carrillo and Brocks in the way the claimed invention does. *ActiveVideo Networks*, 694 F.3d at 1328. That is, absent from Petitioner's argument is any explanation of how the teachings of Carrillo and Brocks might actually be combined to arrive at the claimed invention. Pet. 60-66. Rather, Petitioner spends a lot of time reconstructing Carrillo into the '974 Patent. Pet. 60-66. EX2013, at ¶116.

C. Petitioner Fails to Prove Kitsch in View of Brocks Renders Dependent Claims 2-13 and 15-16 Obvious or that Carrillo in view of Brocks Renders Dependent Claims 2-9, 11, 13 and 16 Obvious.

Neither Kitsch nor Brocks, either alone or in combination with each other, disclose all of the elements of Dependent Claims 2-13 and 15-16, nor render them obvious. Indeed, as discussed in the context of Claim 1, a Petitioner failed to demonstrate why a POSITA would even combine Kitsch and Brocks. *See* Section V.A.6, above.

Likewise, neither Carrillo nor Brocks, either alone or in combination with each other, disclose all of the elements of Dependent Claims 2-9, 11, 13 16, nor render them obvious. Indeed, as discussed in the context of Claim 1, a Petitioner

failed to demonstrate why and how a POSITA would even combine Carrillo and Brocks. *See* Section V.B.2, above.

Because the remaining Challenged Claims all depend from Claim 1, and Petitioner failed to render obvious Claim 1, all of the dependent claims are patentable. Patent Owner addresses briefly the dependent claims below.

1. Claim 2

Dependent Claim 2 further claims “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.” Pet. at 27-29 (Kitsch/Brocks); 66-69 (Carrillo/Brocks). Kitsch does not disclose an asymmetrical stretch characteristic. Also, Kitsch does not stretch parallel to the waistband because the side panels are orthogonal to the waistband. The side panels are fences. EX2013, at ¶82. Similarly, Carrillo does not disclose an asymmetrical stretch characteristic. EX2013, at ¶118. Therefore, neither Kitsch nor Carrillo in view of Brocks renders Claim 2 obvious. EX2013, at ¶¶81-82, 117-118.

2. Claim 3

Dependent Claim 3 further claims “wherein the stretch panel is rectangular and the opening is U-shaped.” Pet. at 29-30 (Kitsch/Brocks); 69-70

(Carrillo/Brocks). Kitsch does not disclose a stretch panel. While Kitsch does disclose side panels, they are not rectangular. EX2013, at ¶83. As shown in FIG. 14 of Kitsch, the side panels are sort of boomerang shaped. *Id.* There is no opening of any kind in the side panels of Kitsch, so there necessarily is no U-Shaped opening. *Id.* As discussed above, in Section IV.D, originally Ms. Wagner steadfastly held to the untenable position that side panel in FIG. 14 was rectangular, she ultimately had to agree it was boomerang shaped. EX2012, at 102:8-9. For the forgoing reasons, Kitsch in view of Brocks does not render Claim 3 obvious. EX2013, at ¶¶81,83. Moreover, because Carrillo in view of Brocks does not render Claim 1 obvious, so too do they fail to render Claim 3 obvious. EX2013, at ¶119.

3. Claims 4 and 5

Dependent Claim 4 depends from Claim 3 and further claims, “wherein the stretch panel comprises a fabric having a stretch of at least 30%.” Pet. at 30-32 (Kitsch/Brocks); 70-72 (Carrillo/Brocks). Claim 5 depends from Claim 1. It claims, “wherein the top location is the waistband seam and the bottom location is the first seam, and a length measured along material of the front portion from the first seam to the waistband seam exceeds a length measured along the fabric of the stretch

panel, when unstretched, by at least 30%.” Pet. at 32-35 (Kitsch/Brocks); 73-75 (Carrillo/Brocks).

As mentioned above, neither Kitsch nor Carrillo disclose stretch characteristics of the side panels (Kitsch) or elastic garment (Carrillo). Petitioner urges a theory of stretch for the elastic strips in Brocks, but other than using the claim language of 30% stretch, there is no disclosure in Brocks indicating to a POSITA that a fabric should have at least 30% stretch. EX2013, at ¶85; EX1001 at Col. 5:29-45. Therefore, neither Kitsch nor Carrillo in view of Brocks render Claim 4 or Claim 5 obvious. EX2013, at ¶81,85,117,121.

4. Claims 6, 7 and 13

Claim 6 depends from Claim 1 and further claims “wherein the garment is a pair of undershorts.” Pet. at 35 (Kitsch/Brocks); 75 (Carrillo/Brocks). Claim 7 depends from Claim 1 and further claims “wherein the stretch panel comprises a fabric different from a fabric of the body.” Pet. at 35 (Kitsch/Brocks); 75-76 (Carrillo/Brocks). Claim 13 depends from Claim 1 and claims “wherein the opening has a U-shape when the stretch panel is in a relaxed state.” Pet. at 43-44 (Kitsch/Brocks); 81-82 (Carrillo/Brocks).

Kitsch and Brocks fail to render obvious Claim 1, so they fail to render Claim 6, Claim 7 or Claim 13 obvious. EX2013, at ¶¶81,86; *see also* Section V.A, above. And Carrillo and Brocks fail to render obvious Claim 1, so they fail to render Claim 6, Claim 7 or Claim 13 obvious. EX2013, at ¶¶117,123; *see also* Section V.B, above.

5. Claim 8

Claim 8 depends from Claim 1 and claims, “wherein the opening has a width in excess of 2 cm.” Pet. at 35-36 (Kitsch/Brocks); 76-77 (Carrillo/Brocks). There is no stretch panel with an opening disclosed in Kitsch. EX2013, at ¶88. A POSITA looking at Kitsch would not think about an opening and thus would not arrive at a 2 cm width for a non-disclosed opening. *Id.* As a result, there is no disclosure in Kitsch of a width of an opening for the male genitalia to go through. *Id.* Similarly, Carrillo does not disclose the width of its opening. The ’974 Patent discloses the width of the opening, which of course is how Petitioner arrives at 2 cm or more. As a result, neither Kitsch nor Carrillo in view of Brocks renders Claim 8 obvious. EX2013, at ¶¶81,88,117,124.

6. Claim 9

Claim 9 depends from Claim 1 and claims “the front portion depends downwardly from the waistband and the front portion is formed to provide the pouch

at a mid-section thereof; the stretch panel is positioned to be disposed forward of the wearer's perineum when the garment is worn, whereby, in use, a scrotum of the wearer of the garment is supported underneath by the stretch panel to contain the wearer's penis and scrotum in the pouch.” Pet. at 36-38 (Kitsch/Brocks); 77-79 (Carrillo/Brocks). As detailed in Claim 1, Kitsch discloses side panels. *See* Sections III.A and V.A.1, above. Kitsch does not disclose a stretch panel as disclosed and claimed in the '974 Patent. *See* Section V.A.1, above.

Carrillo does not include a pouch. As discussed above, the garment sewn to the inner part of the classic underpants creates a pocket. *See* Section V.B.2, above. Carrillo simply teaches an opening through which the wearer's genitalia may be inserted but does not teach any mechanism by which the genitalia are supported by the stretch panel. *Id.* The opening taught by Carrillo is not suited to supporting the wearer's genitalia, as it provides no supporting surface underneath the genitalia. *Id.* As a result, neither Kitsch nor Carrillo in view of Brocks renders Claim 9 obvious. EX2013, at ¶¶ 81,89,117,125.

7. Claim 10

Claim 10 depends from Claim 1, and further claims “wherein the elastically resilient four-way stretch material is comprised of a spandex blend.” Pet. at 39

(Kitsch/Brocks); 83-85 (Kitsch/Carrillo/Brocks). While Kitsch discloses Spandex, Kitsch and Brocks fail to render obvious Claim 1, so they fail to render Claim 10 obvious. EX2013, at ¶90; *see also* Section V.A, above. As discussed with respect to Claim 1, a POSITA would not use a Spandex blend with Carrillo. *See* Section V.B.1, above; EX2013, at ¶129. Other than impermissibly using the '974 Patent as a roadmap, Petitioner fails to articulate why Kitsch, Carrillo and Brocks should be combined. In fact, as discussed above, there is no basis for combining Carrillo with Brocks or Kitsch with Brocks. *See* Sections V.A.6 and V.B.3, above. As a result, neither Kitsch in view of Brocks, nor Carrillo in view of Brocks, and Kitsch renders Claim 10 obvious. EX2013, at ¶¶81,90,117,129.

8. Claim 11

Claim 11 depends from Claim 1, and further claims “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.” Pet. at 39-41 (Kitsch/Brocks); 79-81 (Carrillo/Brocks). Brocks does not disclose a stretch panel, nor does Brocks disclose an opening. *See* Section III.B, above. Therefore, Brocks does not disclose biasing the stretch panel to hold the opening open. Similarly, Kitsch does not

disclose a stretch panel with an opening. *See* Section V.A.1, above. As a result, there is no biasing the stretch panel to hold the opening open. *See* Section V.A.5, above. And unlike the '974 Patent, where the pouch is designed to be open while putting the garment on, a wearer of Carrillo's undergarment will need to physically manipulate his phallus, the pocket, or both in order to insert his phallus into the pocket through opening 2, due at least in part to the bagginess of the pocket and also due in part to the structure of opening 2. *See* Section V.B.2, above. There is no biasing in Carrillo. *Id.*; EX2013, at ¶126. As a result, neither Kitsch nor Carrillo in view of Brocks renders Claim 11 obvious. EX2013, at ¶¶81,91,117,126.

9. Claim 12

Claim 12 depends from Claim 11, and claims "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." Pet. at 41-43 (Kitsch/Brocks); 85-90 (Kitsch/Carrillo/Brocks). As detailed in Claim 1, Kitsch discloses side panels. *See* Section V.A.1, above. There is no stretch panel as disclosed and claimed in the '974 Patent. *Id.* Carrillo does not disclose anything about the perineum or a perineum seam. *See* EX1010; EX2013, at ¶130. Other than impermissibly using the '974

Patent as a roadmap, Petitioner fails to articulate why Kitsch, Carrillo and Brocks should be combined. In fact, as discussed above, there is no basis for combining Carrillo with Brocks or Kitsch with Brocks. *See* Sections V.A.6 and V.B.3, above. As a result, neither Kitsch in view of Brocks, nor Carrillo in view of Brocks and Kitsch, renders Claim 12 obvious. EX2013, at ¶¶81,92,117,130.

10. Claim 15

Claim 15 depends from Claim 1 and claims “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.” Pet. at 44-45 (Kitsch/Brocks); 91-93 (Kitsch/Carrillo/Brocks). While Kitsch may disclose a dart seam, Kitsch and Brocks fail to render obvious Claim 1, so they fail to render Claim 15 obvious. EX2013, at ¶93. Other than impermissibly using the ’974 Patent as a roadmap, Petitioner fails to articulate why Kitsch, Carrillo and Brocks should be combined. In fact, as discussed above, there is no basis for combining Carrillo with Brocks or Kitsch with Brocks. *See* Sections V.A.6 and V.B.3, above. As a result, neither Kitsch in view of Brocks, nor Carrillo in view of Brocks and Kitsch, renders Claim 15 obvious. EX2013, at ¶¶81,93,117,131.

11. Claim 16

Claim 16 depends from Claim 1 and claims “wherein the stretch panel is rectangular and the opening has a rounded bottom edge and opposing side edges that are spaced apart from one another on either side of the opening.” Pet. at 45-47 (Kitsch/Brocks); 82-83 (Carrillo/Brocks). As discussed above, while Kitsch does disclose side panels, they are not rectangular. *See* Section V.C.2, above; EX2013, at ¶¶94. As shown in FIG. 14 of Kitsch, the side panels boomerang shaped, and there is no opening of any kind in the side panels of Kitsch, so there necessarily is no opening with a rounded bottom edge. *See* Section V.A.1, above; EX2013, at ¶¶94. Kitsch and Brocks fail to render obvious Claim 16. EX2013, at ¶¶81,94. Carrillo and Brocks fail to render obvious Claim 1, so they fail to render Claim 16 obvious. EX2013, at ¶¶117,127.

VI. CONCLUSION

As demonstrated above, Petitioner’s prior art does not render obvious any claim of the ’974 Patent, the only grounds Petitioner asserts. As a result, the Challenged Claims of the ’974 Patent are all patentable and the Board should confirm the patentability of claims 1-13 and 15-16.

Date: April 16, 2025

Respectfully submitted,

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

Under the provisions of 37 C.F.R. § 42.24(a), (b), and (d) the undersigned hereby certifies that the word count for the foregoing Patent Owner's Response totals 13,155 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)-(b). Accordingly, this Petition is under the word count limit of 14,000 words. This word count was made by using the built-in word count function tool in the Microsoft Word software used to prepare the document.

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER'S RESPONSE** is being served electronically on April 16, 2025, to the e-mail addresses shown below:

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