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

DECLARATION OF BERNARD KAHN, AAS, BS, MOAM IN SUPPORT OF PATENT OWNER'S RESPONSE

April 16, 2025

TABLE OF CONTENTS

TABLE OF CONTENTS ii
I. BACKGROUND, QUALIFICATIONS AND COMPENSATION 1
II. LEGAL STANDARDS OF NONOBVIOUSNESS 7
III. PERSON OF ORDINARY SKILL IN THE ART AND CLAIM CONSTRUCTION 10
IV. OVERVIEW OF THE '974 PATENT 10
V. CITED PRIOR ART 15
A. U.S. Patent Application Publication 2008-0178369 (Kitsch) 15
B. U.S. Patent No. 5,461,729 (Brocks) 18
C. WO2001037687A1_(Carrillo) 20
VI. CLAIMS 1-13 AND 15-16 ARE NOT OBVIOUS 22
A. Kitsch in view of Brocks Does Not Render Claim 1 Obvious. 22
1. Kitsch Does Not Disclose 1[c] 22
2. Kitsch Does Not Disclose 1[d] 27
3. Kitsch Does Not Disclose 1[e] 28
4. Kitsch Does Not Disclose 1[f] 33
5. Kitsch Does Not Disclose 1[g] 34
6. Combining Kitsch with Brocks does not Render the '974 Patent Obvious 35
B. Kitsch in view of Brocks Does Not Render Dependent Claims 2-13 and 15-16 Obvious. 38
1. Claim 2 39
2. Claim 3 39
3. Claims 4 and 5 40
4. Claims 6, 7, and 13 40
5. Claim 8 41
6. Claim 9 41
7. Claim 10 42

8. Claim 11 42
9. Claim 12 42
10. Claim 15 43
11. Claim 16 43
C. Carrillo in view of Brocks Does Not Render Claim 1 Obvious. 44
1. Carrillo Does Not Disclose 1[d] 44
2. Carrillo Does Not Disclose 1[g] 46
3. Combining Carrillo with Brocks does not Render the '974 Patent Obvious 49
D. Carrillo in view of Brocks Does Not Render Dependent Claims 2-9, 11, 13 and 16 Obvious. 52
1. Claim 2 53
2. Claim 3 53
3. Claims 4 and 5 53
4. Claims 6, 7 and 13 54
5. Claim 8 54
6. Claim 9 55
7. Claim 11 55
8. Claim 16 56
E. Carrillo in view of Brocks and Kitsch Does Not Render Dependent Claims 10, 12 and 15 Obvious. 56
1. Claim 10 57
2. Claim 12 57
3. Claim 15 58
VII. CERTIFICATION 58
APPENDIX A MATERIALS CONSIDERED 59

I, Bernard Kahn, AAS, BS, MOAM, declare as follows:

1. My name is Bernard Kahn. I am over the age of twenty-one. I am competent to make this Declaration, and the opinions and analysis set forth in this Declaration are based on my personal knowledge and on the documents identified herein.

I. BACKGROUND, QUALIFICATIONS AND COMPENSATION

2. I am currently an assistant adjunct Professor of Marketing in the Fashing Marketing Department at Parsons, the New Schol for Design, a position I have held since September 2004, and since September of 1980, I have served as an assistant adjunct professor in the Manufacturing Management Department of the Fashion Institute of Technology ("FIT"), both in New York City. I have also served as IT Manager/BPA/Non-Credit Blackboard Faculty Support at FIT since November 2004 and have been an independent industry consultant since July 1985.

3. I earned a Bachelor of Science in Production Management/Apparel from FIT in 1978, earning the "Excellence in Management Engineering Technology" Award.

4. I earned a Masters of Arts in Organizational Management from the University of Phoenix in 1999.

5. I earned my General Sewing Data Certification from the Methods Workshop U.K. in 1999. I am a current member of the American Society of Quality and a former member of the American Sewing Guild, the American Apparel & Footwear Association and National Retail Federation.

6. In 1977, I graduated Summa Cum Laude with an associate's degree from the Production Management Department of FIT with an Industrial Engineering degree in Apparel Manufacturing. In the following year, I was employed as a factory engineer for Yvonne Le Fleur, a Designer Collection Dress Manufacturer in a wide range of tasks from cutting analysis to garment engineering. I worked with the brand's factories to ensure that the products were manufactured correctly.

7. In the summer of 1977, I was the factory engineer for Churchtown Manufacturing, a blouse manufacturer doing work for a number of popular brands. My duties included garment engineering, analyzing garment construction to determine efficiencies, optimizing the selection of stitches and seams for optimal performance and cost, and performing time-study analysis. Over my career I have performed over 1,000 time study analyses for a wide variety of products including outerwear, sportswear, swimwear and underwear

and lingerie. Time studies require a depth of knowledge on sewing methods and sewing construction to be performed validly.

8. In 1978, I earned a bachelor's degree in production management, also from FIT (graduating Cum Laude). During that time, I prepared the foundation for a textbook titled, "Sewing Machine Automation Technology."

9. In that year, I was also employed as a factory engineer for a Reading, PA based sportswear manufacturer where I worked on production line improvements that included garment engineering and methods improvement.

10. In 1979 I was employed at Sussman Automatic Steam Products. For several years at that company, I was responsible for field engineering the company's pressing systems to meet the garment construction needs for a wide range of clothing manufacturers from furriers to suit manufacturers. This work furthered my knowledge of various product categories especially including the requirements for light weight fabrics such as swimwear and underwear, both men's and women's.

11. In 1980, I began as an adjunct instructor at the Fashion Institute of Technology in New York teaching for the Production Management department. The courses I have taught in the 45 years since then include Garment Construction, Methods Analysis, Time Study, Cutting and Sewing Room

Processes as well as Factory Optimization and Design. To support this work, in 1999, I developed the website, http://garmenco.org an internationally renowned resource for a wide range of fashion product development resources, and the only Web-Based guide to the ASTM D6193 Stitch and Seam Guide for Sewn Products Manufacturing.

12. My consulting career spans over 40 years and includes working with the Garment Industry Development Corporation in the 1990's to help domestic sewn product factories to compete with imports through re-engineering and training their staffs in Modular Manufacturing Techniques. In 1990, I wrote the only existing independent guide to Converting a Progressive Bundle Manufacturing factory to Modular Manufacturing. Clientele included Brooks Brothers' boxer shorts factories, Feldman Manufacturing, a swimwear factory working for J. Crew, Armstrong Manufacturing, a Bronx based underwear manufacturer Andmore, Inc, a Port Jervis, New York based performance men's and women's swimwear manufacturer, and many more. Each of these projects required me to evaluate and re-engineer the construction of their products, and to implement a worker training program to create team-based incentive manufacturing systems (the Modular approach).

13. Through the early 2000's to 2020's my activities included many business development projects for startups and larger fashion companies. For each of the startups, my activities included evaluation of garment construction and costing, as well as sourcing acceptable production facilities and implementing manufacturing of their projects. In addition to my professional career, I have served as a Deacon at Saint Mary's Catholic Church in New Washingtonville, NY since 2017.

14. In 2007, I was instrumental in launching and growing the Bluffworks Brand line, manufactured domestically, which grew from a single style of men's work-to-leisure slacks to what is now a full line of men's and women's travel and leisure products. My work included garment engineering, specification development and quality analysis of the manufactured products, and prior to the pandemic, was preparing the line for overseas production. Bluffworks is now a multi-million-dollar enterprise.

15. Attached as Exhibit 2014 is a copy of my curriculum vitae setting forth my educational experience, employment history, and publications.

16. I have been retained by Pakage Apparel, Inc. I am being compensated for my time spent working in connection with this matter. I am

being compensated at $200 per hour for my time spent on the matter. My compensation is not dependent on the outcome of this case.

17. Counsel has informed me that I should consider these materials through the lens of one of ordinary skill in the art related to the '974 Patent, at the time of the earliest priority date of the '974 Patent, and I have done so during my review of these materials. I have been asked to assume, for purposes of this Declaration, that the '974 Patent has a priority date of December 31, 2010.

18. My analyses are based on my years of education, research, and work experience, as well as my investigation and study of relevant materials. In my analyses, I have considered the materials that I identify in this Declaration and those listed in Appendix A.

19. I may rely on these and additional materials to respond to arguments raised by Petitioner. I may also consider additional documents and information in further analyses—including documents that may not yet have been provided to me.

20. My review and assessment of the materials provided in this proceeding is ongoing, and I will continue to consider any new material as it is provided. I reserve the right to review, supplement, and amend my analyses

based on new information and on my continuing review of the materials already provided.

21. I understand that the U.S. Patent and Trademark Office Patent Trial and Appeal Board has instituted an inter partes review of the patentability of Claims 1-13 and 15-16 of U.S. Patent No. 10,834,974 (EX1001) (the "'974 Patent") based upon a petition filed by Tommy John, Inc. The following discussion and analyses provides my opinion as to why Claims 1-13 and 15-16 of the '974 Patent would have been nonobvious to a person of ordinary skill in the art in December 2010.

II. LEGAL STANDARDS OF NONOBVIOUSNESS

22. I am not a legal expert. I have not been asked to offer an opinion on the law, but I understand that I am obliged to follow existing law. Counsel for Pakage Apparel has informed me of the law and asked me to apply the legal principles summarized below in my analysis. I have applied these principles in reaching the conclusions and explaining the analysis detailed throughout this declaration.

23. I understand that, in these proceedings, Petitioner has argued that the claims of the '974 Patent are invalid as obvious, and that the Board instituted the proceedings only with respect to obviousness.

24. I understand that a claim is invalid if the invention recited in the claim would have been obvious to one of ordinary skill in the art at the time the invention was made. I understand this means that even if all the requirements of the claim cannot be found in a single prior art reference, a person of ordinary skill in the field of the invention knowledgeable of the prior art would have come up with the claimed invention. In considering whether a claim is obvious, I have been asked to consider (a) the level of skill in the art at the time of the claimed invention, (b) the scope and content of the prior art, (c) any differences between the prior art and the claims of the patent-in-suit, and (d) any "secondary factors" related to obviousness, including commercial success, long-felt but unresolved need, failure of others, copying, praise by others, unexpected results, and simultaneous invention by others.

25. I understand that a claim composed of several elements is not necessarily proved obvious merely by demonstrating that each of its elements was independently known in the prior art. I also understand that obviousness should not be analyzed using the benefit of hindsight. Instead, it must be analyzed from the standpoint of what was known and understood by a person of ordinary skill in the art at the time of the claimed invention. In evaluating whether a claimed combination would have been obvious, I understand that I

may consider whether there was a reason that would have prompted a person of ordinary skill in the field to combine the elements or concepts from the prior art in the same manner as claimed. I understand that, among other things, I can consider whether market forces or other design incentives might have prompted the particular combination claimed in the patent. I understand that I may also consider whether the combination simply achieved a predictable result by using prior art elements according to their known functions. I understand that I may consider whether there is some teaching, motivation, or suggestion in the prior art to make the claimed combination, although such a teaching, motivation, or suggestion is not a requirement of proving obviousness. I understand that teachings, suggestions, and motivations may also be found within the knowledge of a person with ordinary skill in the art, including inferences and creative steps that a person of ordinary skill in the art would employ.

26. Also, I understand that I should consider whether the claimed combination applies a known technique that had been used to improve similar devices in a similar way. I understand that I may also consider whether the claimed invention would have been obvious to try, meaning that the claimed innovation was one of a relatively small number of possible approaches to the problem with a reasonable expectation of success by those of ordinary skill in

the art. I understand that a single prior art reference, even though not anticipating, could be modified to produce the claimed invention and thus render a claim obvious. Further, I understand that each prior art reference must be considered as a whole, including disclosure in the reference that teaches away from the claimed invention or from a combination with another prior art reference.

III. PERSON OF ORDINARY SKILL IN THE ART AND CLAIM CONSTRUCTION

27. I understand Robin Wagner, Petitioner Tommy John's designated expert provided a definition for a person of ordinary skill in the art (POSITA). EX1005 ¶¶31-32. For my analyses below, Ms. Wagner's definition of POSITA is sufficient. Based on my experience, the level of skill in the art at the time of the '974 Patent was low, which is consistent with Ms. Wagner's definition of her POSITA.

28. In my opinion, the claim terms of Claims 1-13 and 15-16 of the '974 Patent do not require any claim construction. My analyses use the plain and ordinary meaning of the claim terms.

IV. OVERVIEW OF THE '974 PATENT

29. The '974 Patent is for a form of men's undergarment in which there is a 3-dimensional pouch that fully surrounds the male genitals isolating them

from the body and legs in a soft, stretch fabric area in the front of the body. This pouch is comprised of multiple layers of fabric on the outside of the garment, vertically stitched to an inner pouch panel that has a U-shaped opening to accept the male genitals and separates the genitals from the wearer's body in a comfortable 'sack' separating the genitals from the body and legs. This sack (pouch) surrounds the genitals on all sides softly limiting their movement side to side and from the body. The parameters of stretch and method of construction are detailed in the patent.

30. The '974 Patent relates to garments for men that include pouches 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. EX1001 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 (phallus) 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. *Id*. at col. 7:23-30.

31. 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.

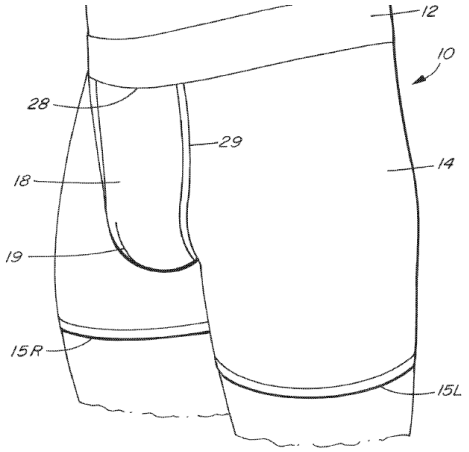


FIG. 1

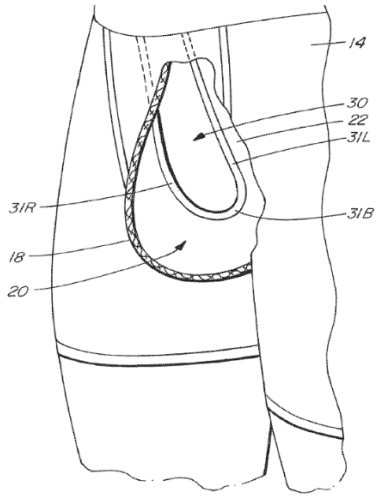


FIG. 5

32. The front portion 18 forms the front part of a 40 three-dimensional pouch 20 that receives and gently supports a wearer's genitalia. *See* FIG. 6. The 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. This adds volume to pouch 20**.**

33. The undershorts 10 include a stretch panel 22 that extends between waistband 12 and the crotch area 24 of undershorts 10. 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. 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.

34. Stretch panel 22 includes an opening 30 to receive a wearer's genitalia. The opening 30 can be U-shaped and have a softly-bound edge 31. The stretch panel 22 is configured to define opening 30 and to provide support around and underneath the scrotum of the wearer in order to comfortably position the wearer's genitals forward into pouch 20. EX1001 at Col. 3, lns. 5-19. 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.

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

36. At the end of the ’974 Patent are the list of claims. Claim 1 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.

37. For convenience, I used the same letters as Ms. Wagner did for breaking down the claim elements, 1[pre] through 1[g][iii].

V. CITED PRIOR ART

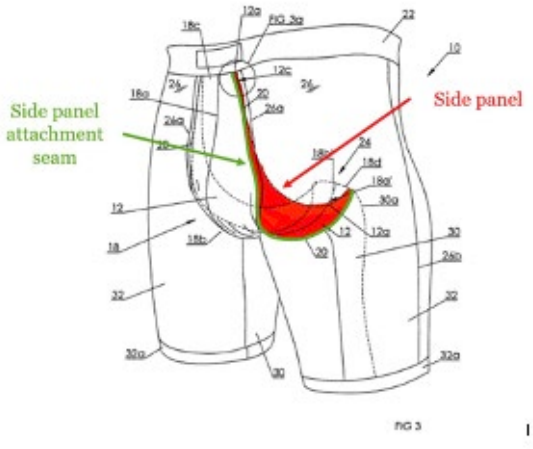
A. U.S. Patent Application Publication 2008-0178369 (Kitsch)

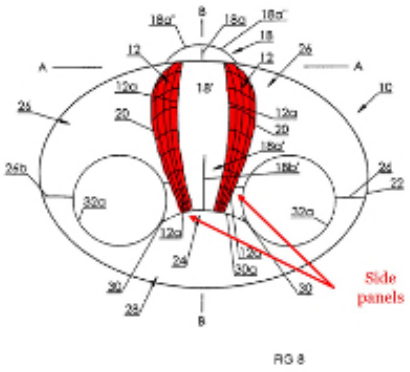
38. It is not obvious for a POSITA in viewing Kitsch's design to presume the design and function of the '974 patent based on the functional objectives and design features of this Kitsch. Kitsch's stated goal is to prevent the male genitals from contacting the wearer's thighs and legs. Kitsch accomplishes this with two parallel panels that are stitched to the inside front of the garment in the vertical length of the garment and are parallel to each other a distance apart. These panels contact the wearer's body from the waistband to the perineum (at the buttocks). The panels in Kitsch attempt to trap the genitals

against the body between said panels and the front of the garment. Similarly to Brocks, the genitals remain in constant contact with the wearer's body forming sweat and discomfort during activity. Although the panels are constructed of a mesh fabric, in practice, these panels are compressed between the front of the garment and the wearer's body providing little ventilation as claimed. The '974 Patent's functional objective is to surround all the genitals (phallus and scrotum), with a soft, flexible 360-degree encasing pouch that separates the genitals from the body, keeping them separated in the front center area of the body for comfort during rest or activity.

39. Kitsch discloses the addition of two fences to men's underwear to prevent the genitals from contacting the legs. Kitsch 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*.

40. As described in the text and shown in FIG. 3 and FIG. 8 (I used Petitioner's annotated figures below), 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].





41. "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].

42. "The side panels are preferably thin sheets of elasticized breathable wicking mesh knit, one sheet per panel and form a substantially parallel pair of

opposed wicking fences which are positioned unobstructively substantially completely up into the fold line between the scrotum and inner thigh to thereby inhibit chaffing and to draw moisture away from where there would ordinarily be skin-to-skin contact and rubbing." EX1007 at [0028]. "The two side panels 12 thus separate the scrotum 14 from contacting the inner thighs and legs of the user, such separation extending from the waistband 22 to the perineum area 24 which extends under the buttocks of user." EX1007 at [0028]; *see* FIG. 7.

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

43. It is not obvious for a POSITA in viewing Brocks to presume the design and function of the '974 Patent based on the functional objectives of the design features of this patent design. Brocks is essentially a conventional men's brief, utilizes elastic sewn into the leg openings to create a cup-like area behind the front panels of the garment to trap the male genitals in this area between the legs and body of the wearer. The goal of this design is to prevent the genitals of the wearer from coming out of the leg holes of the brief and trap the genitals in the general front area of the body. The '974 Patent's functional objective is to surround the genitals (phallus and scrotum), with a soft, flexible 360-degree encasing pouch that separates the genitals from the body, keeping them separated in the front center area of the body for comfort during rest or activity.

44. Brocks added elastic to the leg openings of men's underwear to prevent the scrotum from coming out of the openings. 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 12-17. 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. EX1008 at col. 1:5-21.

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

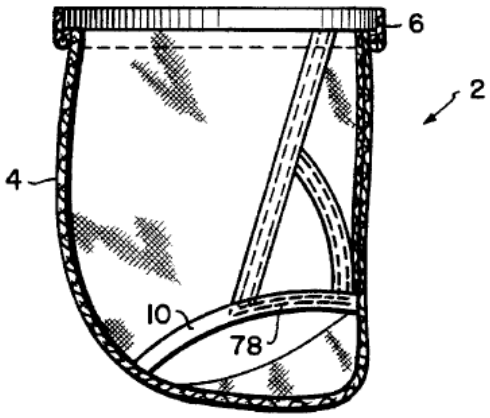


FIG.4

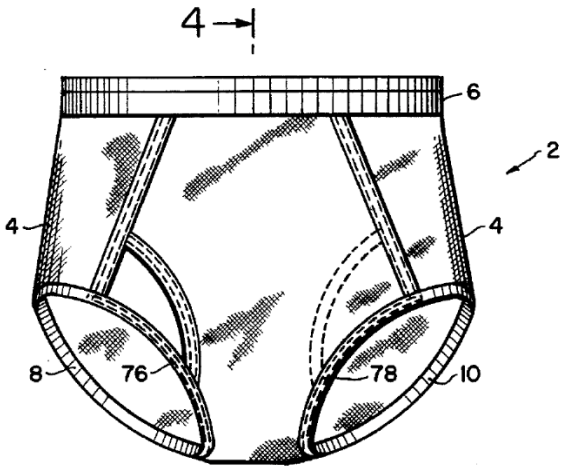


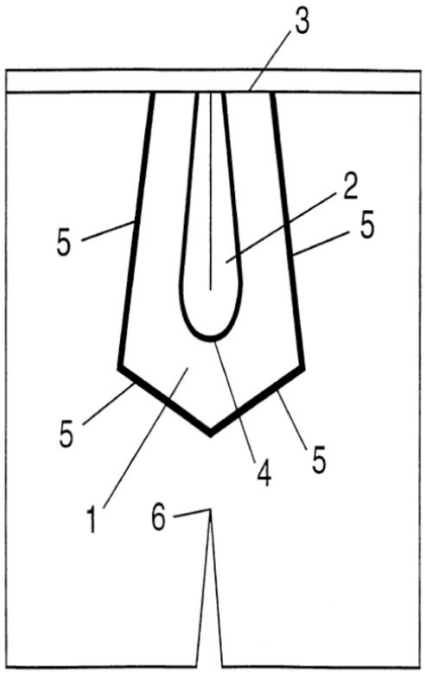
FIG.2

46. 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. The cotton material used for the brief is generally stretchable along only the lateral axis and not the longitudinal axis. The elastic strips create a gathering and shirring forming a secure enclosure pouch for the male genitals *Id*. at col. 4:2-13.

C. WO2001037687A1_(Carrillo)

47. It is not obvious for a POSITA in viewing Carrillo to presume the design and function of the '974 Patent based on the functional objective and the design features of Carrillo's elastic accessory. Carrillo's functional objective is to pull the wearer's testicles away from the groin area. Carrillo does not include a pouch for support, nor does the elastic garment provide support. Carrillo's garment forms a pocket when sewn to conventional underpants. The '974 Patent's functional objective is to surround all the genitals (phallus and scrotum), with a soft, flexible 360-degree encasing pouch that separates and supports the genitals, keeping them separated in the front center area of the body for comfort during rest or activity.

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



49. Carrillo 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 what material the elastic garment is made of.

VI. CLAIMS 1-13 AND 15-16 ARE NOT OBVIOUS

A. Kitsch in view of Brocks Does Not Render Claim 1 Obvious.

1. Kitsch Does Not Disclose 1[c]

50. The ’974 Patent discloses and claims a “stretch panel” 22 that extends between waistband 12 and the crotch area 24 of undershorts 10. 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. EX1001.

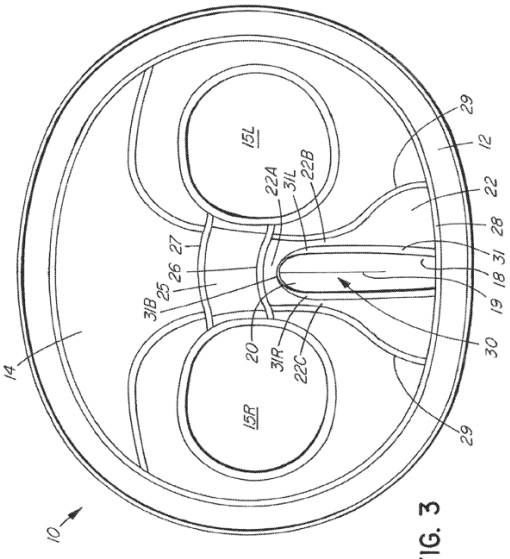


FIG. 3

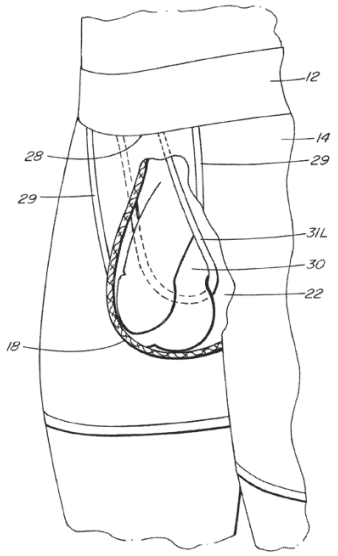


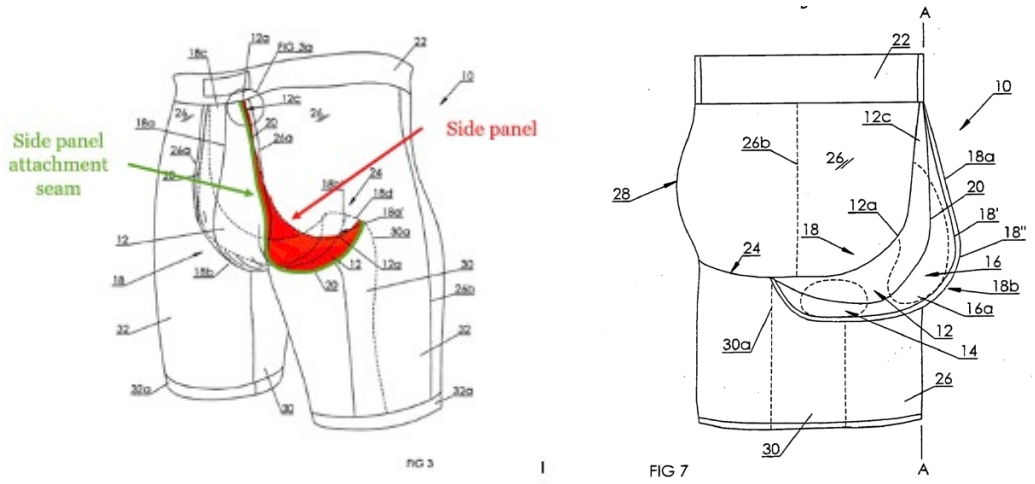
FIG. 6

The 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, lns. 5-19.

51. By contrast, Kitsch does not disclose a stretch panel. *See* Pet. at 12. In fact, Kitsch does not use the term "stretch panel" anywhere in the disclosure. The only instance of the word "stretch" in Kitsch is found describing a material. EX1007 at [0030]("a so-called four-by-four stretch weave).

52. Kitsch actually discloses "side panels", not a stretch panel. 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. "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]. Unlike the stretch panel of the '974 Patent, the side panels of Kitsch are attached orthogonally from the pouch. EX1007 at [0029]. The side panels 12 in Kitsch are not seamed or stitched together to surround the genitals. They are parallel. They never meet.



53. In Kitsch FIG. 3 and FIG. 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].

54. 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. A simple comparison of the wearer figure of the '974 Patent with the wearer figure of Kitsch shows the difference in wearer support. 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.

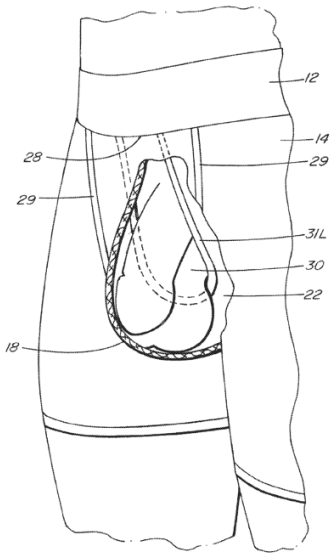


FIG. 6

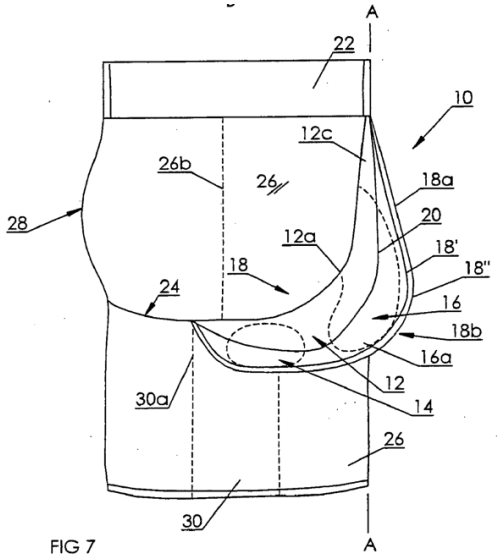


FIG 7

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. The scrotum 14 hangs below. 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.

55. Ms. Wagner's declaration discussing the side panels of Kitsch did not accurately describe Kitsch. For example, in ¶50 of her declaration, she quoted only a portion of Kitsch, and by omitting the remainder of the quote left the wrong impression that the side panels 12 of Kitsch perform the same function as the stretch panel 22 of the '974 Patent. EX1005, ¶50. Specifically,

Ms. Wagner provided this shortened quote from Kitsch: "'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 impression that the side panels isolate the genitalia into a pouch. 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 the side panels 12.

56. Ms. Wagner also attempted to make the construction of the '974 Patent's stretch panel sound like the two side panels of Kitsch. EX1005 at ¶50. Kitsch has two parallel side panels 12. EX1007, at [0027]. But to make the stretch panel sound like two side panels, Ms. Wagner misleading 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. They never meet. 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.

2. Kitsch Does Not Disclose 1[d]

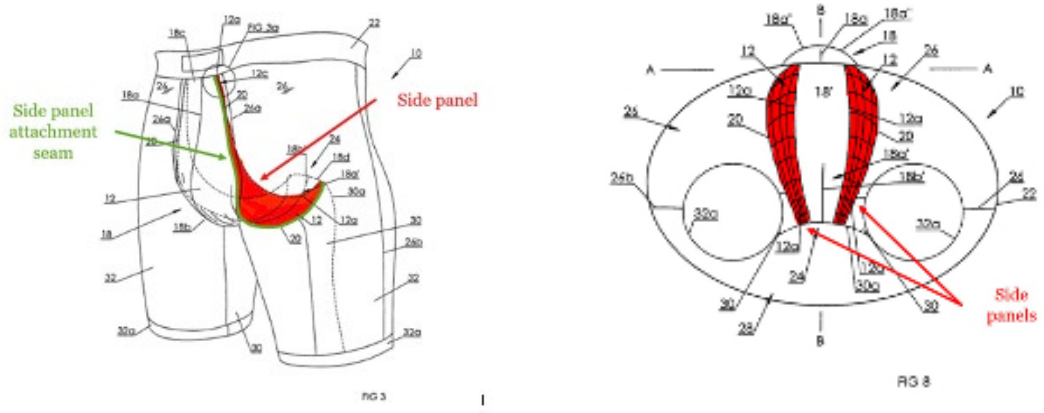
57. The ’974 Patent claims “the stretch panel comprising a sheet of elastically resilient four-way stretch material…” EX1001, at Col. 8:29-30. But Kitsch discloses “The performance material used advantageously in the side panels of the present invention is a soft elasticized breathable mesh knit weave (in a so-called four-by-four stretch weave) containing 80% Nylon™ and 20% Spandex™.” EX1007, at [0030]. Kitsch does not disclose a four-way stretch material. Kitsch 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. The two serve very different purposes: where Kitsch focuses on the fabric’s breathability, the ’974 Patent calls for elasticity and comfort. For the Kitsch design, stretch is based on the content of spandex, but

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.

3. Kitsch Does Not Disclose 1[e]

58. Kitsch does not disclose a top edge, a bottom edge, and a side edge as described in the ’974 Patent. Nowhere does Kitsch use the terms top edge and bottom edge to describe the attachment of the side panels to the body. EX1005, at ¶¶56-57 and Pet. at 15-18.

59. 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 [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].

60. Kitsch's side panel installation is significantly different than the '974 Patent's stretch panels. There is nothing about the installation of the two side panels of Kitsch that would render obvious the stretch panel installation in the '974 Patent 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.

61. The Kitsch side panels are not seamed or stitched together—they are parallel, and they never meet, so they do not include any opening. Kitsch is clear on that. But 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. This is not accurate.

62. 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. Kitsch's side panels do not include an opening.

63. Rather than point to an actual opening in Kitsch, Petitioner comes up with an argument that the space between the two parallel side panels 12 is an

opening. EX1005, at ¶¶ 59-60; Pet. at 19-20. I understand Ms. Wagner's position is the two 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. This 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.

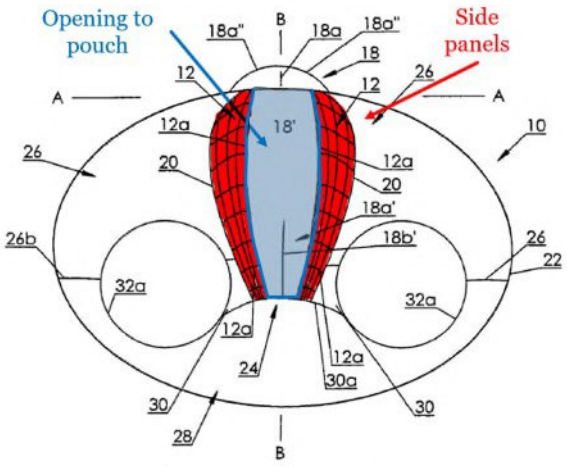


FIG 8

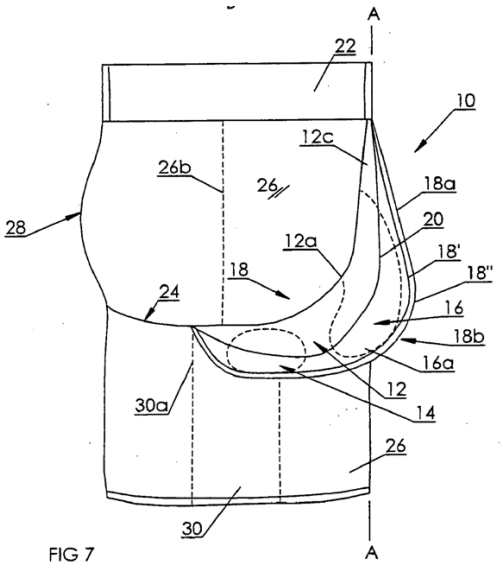


FIG 7

64. Petitioner and Ms. Wagner argue the area between the two side panels (in blue in FIG. 8) is the opening found in claim 1[e][iv]. EX1005 at ¶60; Pet. at 20. The coloring of the FIG. 8 and "opening to pouch" 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; 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 vol- ume while maintaining support. The apex 18b is situated to most fully accommodate the head 16a of the phallus 16.

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

65. 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. 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, [0029]. The side panels 12 do not need an opening, nor do they create one for the phallus and scrotum to access the pouch.

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

67. Kitsch does not disclose nor render obvious a stretch panel 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" in claim 1 of '974 Patent.

4. Kitsch Does Not Disclose 1[f]

68. Kitsch does not disclose a top edge, a bottom edge, and 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]. Kitsch's side panel installation is significantly different than the '974 Patent's stretch panels.

69. Other than Petitioner and Ms. Wagner stating that the side panels of Kitsch made from nylon and Spandex, EX1005, at ¶61, Petitioner does not show how the Kitsch side panels are directionally resilient between a top edge and a bottom edge and a direction between the side edges. Ms. Wagner used top and bottom edges. *Id*. at ¶¶56-57. Petitioner and Ms. Wagner fail to explain how the side panel is resiliently elastic in those directions when one is attached to the waistband and the other to the perineum.

70. Petitioner does not explain 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, 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 [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. Petitioner fails to demonstrate Kitsch discloses or render obvious 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" in Claim 1 of '974 Patent.

5. Kitsch Does Not Disclose 1[g]

71. Kitsch does not disclose claim element 1[g][i], stretched and unstretched lengths from top to bottom of its side panels**.** Kitsch does not disclose claim element 1[g][i], stretched and unstretched lengths across the width in the front portion of the body. In fact, such a discussion is meaningless in Kitsch because the side panels do not pull across the front. The side panels are fences. Kitsch also does not disclose gathering that is in element 1[g][iii] of Claim 1. There is no discussion about the front portion being 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. 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.

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

72. Petitioner’s combination looks at the prior art with the benefit of hindsight, attempting to use the ’974 Patent as an instruction manual to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Even with the benefit of the ’974 Patent as a template, Petitioner’s combination fails to render obvious Claim 1 of the ’974 Patent.

73. As I described above, Brocks “relates to men's knitted underwear briefs often referred to a ‘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 9-12. Brocks pointed out that Jockey shorts construction does not include a pouch to accommodate the male genital organs. *Id*. at 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 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. *See id*. at col. 1:5-21.

74. Petitioner has not demonstrated that a POSITA would have been motivated to combine the teachings of Kitsch and Brocks to derive the claimed subject matter of the ’974 Patent.

75. 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 like the ’974 Patent design to separate the genitals from the body and limit the movement of the genitals for comfort.

76. Petitioner does not 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. 25-27.

77. Petitioner states 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. Under no circumstances would a POSITA studying Kitch conclude that the two side panels whose purpose is preventing the genitals from touching the thighs or legs, should be joined together. 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. A POSITA would recognize that the Kitsch pouch still traps the genitals against the body of the wearer.

78. 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.

79. Last, 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. While that may or may not be true, 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.

80. 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. 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. Brocks does not add anything to Kitsch that Kitsch does not already do.

B. Kitsch in view of Brocks Does Not Render Dependent Claims 2-13 and 15-16 Obvious.

81. 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. As discussed in the context of Claim 1, Petitioner failed to demonstrate why a POSITA would even combine Kitsch and Brocks. Because

the remaining claims all depend from Claim 1, and Petitioner failed to render obvious Claim 1, all of the dependent claims are nonobvious.

1. Claim 2

82. 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 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.

2. Claim 3

83. Dependent Claim 3 further claims "wherein the stretch panel is rectangular and the opening is U-shaped." Pet. at 29-30. Kitsch does not disclose a stretch panel. While Kitsch does disclose side panels, they are not rectangular. As shown in FIG. 14 of Kitsch, the side panels are sort of boomerang shaped. There is no opening of any kind in the side panels of Kitsch, so there necessarily is no U-Shaped opening. I understand Ms. Wagner agrees it is boomerang shaped.

3. Claims 4 and 5

84. 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. 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.

85. As mentioned above, Kitsch does not disclose stretch characteristics of the side panels. Petitioner urges a theory of stretch for the elastic strips in Brooks, 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. EX1001 at Col. 5:29-45. Therefore, Kitsch in view of Brocks does not render Claim 4 or Claim 5 obvious.

4. Claims 6, 7, and 13

86. Claim 6 depends from Claim 1 and further claims "wherein the garment is a pair of undershorts." Pet. at 35. 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. 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.

87. Kitsch and Brocks fail to render obvious Claim 1, so they fail to render Claim 6, Claim 7 or Claim 13 obvious.

5. Claim 8

88. Claim 8 depends from Claim 1 and claims, "wherein the opening has a width in excess of 2 cm." Pet. at 35-36. There is no stretch panel with an opening disclosed in Kitsch. A POSITA looking at Kitsch would not think about an opening and thus would not arrive at a 2 cm width for a nondisclosed opening. As a result, there is no disclosure in Kitsch of a width of an opening for the male genitalia to go through. Kitsch does not render Claim 8 obvious.

6. Claim 9

89. 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. As detailed in Claim 1, Kitsch discloses side panels. Kitsch has no stretch

panel as disclosed and claimed in the ’974 Patent. Kitsch in view of Brocks does not render Claim 9 obvious.

7. Claim 10

90. 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. While Kitsch discloses spandex, Kitsch and Brocks fail to render obvious Claim 1, so they fail to render Claim 10 obvious.

8. Claim 11

91. 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. Brocks does not disclose a stretch panel, nor does Brocks disclose an opening. 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. As a result, there is no biasing the stretch panel to hold the opening open.

9. Claim 12

92. 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. As detailed in Claim 1, Kitsch discloses side panels. There is no stretch panel as disclosed and claimed in the '974 Patent. Kitsch in view of Brocks does not render Claim 12 obvious.

10. Claim 15

93. 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. While Kitsch may disclose a dart seam, Kitsch and Brocks fail to render obvious Claim 1, so they fail to render Claim 15 obvious.

11. Claim 16

94. 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. As discussed above, while Kitsch does disclose side panels, they are not rectangular. 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. Kitsch and Brocks fail to render obvious Claim 16.

C. Carrillo in view of Brocks Does Not Render Claim 1 Obvious.

95. 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]

96. Carrillo's invention "consists of a U-shaped elastic garment (1)sewn to the inner front part of standard briefs…" EX1010, at 2. Carrillo provides no description for the material of his elastic garment. 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.

97. Ms. Wagner's statement that a POSITA would choose a Nylon-Spandex blend and polyester-Spandex blend "for their moisture-wicking abilities, breathability, and comfort" is not accurate. EX1005 ¶126. Nylon-Spandex and Polyester-Spandex blends of percentages are entirely hydrophobic fiber fabrics. Hydrophobic fibers are, by definition, are moisture-repelling, not moisture attracting fibers. These fibers do not absorb moisture (aka perspiration), do not have moisture wicking characteristics, are not 'breathable', and therefore less comfortable than hydrophilic fiber fabrics. These fabrics are often chosen for performance garments for their low cost, and low coefficient of

abrasion. There is no reason a POSITA would have believed Carrillo taught a hydrophobic fabric for its insert.

98. 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. Petitioner is using improper hindsight reconstruction to arrive at the answer of four-way-stretch material, because there is no basis in Carrillo for this assumption. 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. A POSITA would know that the fabric need only stretch moderately, and in only one direction, to function. Ms. Wagner improperly presumes direction of stretch in the Carrillo patent to establish a ground of contention to the '974 Patent.

99. 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 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. 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.

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

2. Carrillo Does Not Disclose 1[g]

101. Carrillo does not disclose or teach a POSITA element 1[g] which claims "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.

102. Carrillo discloses a men's garment that is sewn to the inner part of underwear and once sewn, create a vertical hole through which male genitalia can be passed. 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.

103. Carrillo does not disclose "the scrotum of a wearer of the garment is supported underneath by the stretch panel" like the '974 Patent. 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.

104. 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. 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.

105. 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. 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.

106. Carrillo does not disclose "the stretch panel having a length when unstretched smaller than a length measured along the front panel between the first seam and the waistband and a width when unstretched smaller than a length measured along the front panel between the side seams" as recited in Claim 1. Carrillo does not include such feature.

107. 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 front portion is gathered from side-to-side and top-to-bottom by the stretch panel whereby a three-dimensional pouch for receiving the wearer's genitals and holding the wearer's genitals while the garment is being worn." 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.

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

108. Because Carrillo does not render Claim 1 obvious, Petitioner turns to Brocks to argue that the combination of Carrillo with Brocks renders Claim 1 obvious. Like discussed above with Kitsch, Petitioner is attempting to use hindsight reconstruction and a reconstruction of Brocks to arrive at element Claim [1e]. 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.

109. 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. *Id*. at 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. *See id*. at col. 1:5-21. Brocks traps the genitals against the body.

110. 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.

111. 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.

112. I understand from counsel that Petitioner must demonstrate that a POSITA would have been motivated to combine the teachings of Carrillo and Brocks to derive the claimed subject matter with a reasonable expectation of success.

113. 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 the leg holes of the wearer. 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.

114. Carrillo does provide that his elastic garment may be attached to classic underpants. 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. In such combination a pair of underpants

would include an elastic garment (Carrillo) and a pouch created by elastic material surrounding leg openings (Brocks). 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.

115. 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. But, that is not motivation. That's reconstructing the '974 Patent. 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 pouch from Brocks? Carrillo even states the elastic garment is sewn to classic underpants. If so, a POSITA would not need to modify Carrillo at all.

116. 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. 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.

D. Carrillo in view of Brocks Does Not Render Dependent Claims 2-9, 11, 13 and 16 Obvious.

117. 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. As discussed in the context of Claim 1, Petitioner failed to demonstrate why and how a POSITA would even combine Carrillo and Brocks.

Because the remaining claims depend from Claim 1, and Petitioner failed to render obvious Claim 1, all of the dependent claims are nonobvious.

1. Claim 2

118. 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 66-69. Carrillo does not disclose an asymmetrical stretch characteristic. Therefore, Carrillo in view of Brocks does not render Claim 2 obvious.

2. Claim 3

119. Dependent Claim 3 further claims "wherein the stretch panel is rectangular and the opening is U-shaped." Pet. at 69-70. Carrillo and Brocks fail to render obvious Claim 1, so they fail to render Claim 3 obvious.

3. Claims 4 and 5

120. 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 70-72. 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 73-75.

121. As mentioned above, Carrillo does not disclose stretch characteristics of the elastic garment. Petitioner urges a theory of stretch for the elastic strips in Brooks, 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. EX1001 at Col. 5:29-45. Therefore, Carrillo in view of Brocks does not render Claim 4 or Claim 5 obvious.

4. Claims 6, 7 and 13

122. Claim 6 depends from Claim 1 and further claims "wherein the garment is a pair of undershorts." Pet. at 75. 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 75-76. 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 81-82.

123. Carrillo and Brocks fail to render obvious Claim 1, so they fail to render Claim 6, Claim 7 or Claim 13 obvious.

5. Claim 8

124. Claim 8 depends from Claim 1 and claims, "wherein the opening has a width in excess of 2 cm." Pet. at 76-77. Carrillo does not disclose the width

of its opening. The ’974 Patent discloses the width of the opening, which how Petitioner arrives at 2 cm or more. Carrillo in view of Brocks does not render Claim 8 obvious.

6. Claim 9

125. 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 77-79. Carrillo does not include a pouch. As discussed above, the garment sewn to the inner part of the classic underpants creates a pocket. 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 garment. The opening taught by Carrillo is not suited to supporting the wearer’s genitalia, as it provides no supporting surface underneath the genitalia. Carrillo in view of Brocks does not render Claim 9 obvious.

7. Claim 11

126. 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 79-81. Brocks does not disclose biasing the stretch panel to hold the opening open. 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 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. There is no biasing in Carrillo. Carrillo in view of Brocks does not render Claim 11 obvious.

8. Claim 16

127. 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 82-83. Carrillo and Brocks fail to render obvious Claim 1, so they fail to render Claim 16 obvious.

E. Carrillo in view of Brocks and Kitsch Does Not Render Dependent Claims 10, 12 and 15 Obvious.

128. Neither Carrillo, Kitsch nor Brocks, either alone or in combination with each other, disclose all of the elements of Dependent Claims 10, 12 and 15, nor render them obvious.

1. Claim 10

129. 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 83-85. As discussed with respect to Claim 1, a POSITA would not use a Spandex blend with Carrillo. 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. As a result, neither Kitsch in view of Brocks nor Carrillo in view of Brocks and Kitsch renders Claim 10 obvious.

2. Claim 12

130. 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 85-90. Other than impermissibly using the '974 Patent as a roadmap, Petitioner fails to articulate why Kitsch, Carrillo and Brocks should be combined. Carrillo does not disclose anything about the perineum or a perineum seam. EX1010. In fact, as discussed above, there is no basis for combining Carrillo with Brocks or Kitsch with Brocks. As a result, neither Kitsch in view of Brocks nor Carrillo in view of Brocks and Kitsch renders Claim 12 obvious.

3. Claim 15

131. 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 91-93. 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. As a result, neither Kitsch in view of Brocks nor Carrillo in view of Brocks and Kitsch renders Claim 15 obvious.

VII. CERTIFICATION

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and, further, that these statements were made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both, under Section 1001 of Title 18 of the U.S. Code.

By: 
Bernard Kahn AAS, BS, MOAM

Date: 4/16/25

APPENDIX A

MATERIALS CONSIDERED

Exhibit	Document
1001	U.S. Patent No. 10,834,974 ("'974 Patent")
1002	File History for the '974 Patent
1003	File History for U.S. Patent No. 10,034,496
1004	File History for U.S. Patent No. 9,687,030
1005	Declaration of Robin Wagner
1006	Curriculum Vitae of Robin Wagner
1007	U.S. Patent Application Publication 2008-0178369 (Kitsch)
1008	U.S. Patent No. 5,461,729 ("Brocks")
1009	WO 01/37687 ("Carrillo")
1010	WO 01/37687 ("Carrillo") – English Translation with Certification
2001	U.S. Pat. No. 10,834,974 ("the '974 Patent") Certified File History
2002	U.S. Pat. No. 7,958,571 (Kitsch)
2003	U.S. Pub. No. 2009/0106874 (Shlush)
2004	U.S. Pat. No.10,034,496 ("the '496 Patent") Certified File History
2005	U.S. Pat. No.9,687,030 ("the '030 Patent") Certified File History
2006	Pakage Apparel May 16, 2024, Email Producing '974 Patent Certified File History
2007	*Pakage Apparel v. Rampion Matter* Claim Construction Order

2008	Tommy John, Inc.'s Preliminary Invalidity Contentions
2009	*Pakage Apparel, Inc. v. Tommy John, Inc.*, Cause No. 4:23-cv-4337 (S.D. Tex.) Dkt. 29, Scheduling Order
2010	U.S. Pat. No. 7,958,571 (Kitsch) File History (uncertified)
2011	*Hammond Development International, Inc. v. Amazon.com, Inc. et al*, 20-CV-00342-ADA, Dkt. 45 (WD Tex. Oct. 28, 2019).

Pakage Apparel EX2013
IPR2024-01163