

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Tommy John, Inc.,
Petitioner,

v.

Pakage Apparel Inc.,
Patent Owner.

Case IPR2024-01163
Patent 10,834,974

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

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I. INTRODUCTION

Patent Owner's Response ("POR") argues features not in the claims, and misapprehends the combinations of prior art presented in the Petition to try to create distinctions where there are none. As explained in the Petition and below, the prior art's disclosure is more than sufficient to invalidate the challenged claims.

II. PERSON OF ORDINARY SKILL IN THE ART

Patent Owner does not dispute Petitioner's POSITA definition, yet incorrectly suggests Petitioner has a higher burden than usual in establishing obviousness because the level of skill is allegedly "low." (POR, 20-21.) This is not the case. As Petitioner's expert, Ms. Wagner, testified, a specific and particular level of skill in apparel design, apparel manufacturing, textile science, or similar disciplines is required, which is gained through formal education, industry experience, or both. (EX1005, ¶31.) Moreover, Patent Owner's conclusory assertion that because the level of skill is supposedly "low," Petitioner cannot prove obviousness fails. Here, the challenged claims are obvious to a POSITA over combinations of Kitsch (EX1007), Carrillo (EX1010), and Brocks (EX1008). This cannot be negated simply because Patent Owner alleges a "low" skill level is required. *See, e.g., Innovention Toys, LLC v. MGA Ent., Inc.*, 637 F.3d 1314, 1323 (Fed. Cir. 2011) (stating "no reversal is necessary where a district court makes a determination that an invention would have been obvious to one having the lowest level of skill, *i.e.*, a layperson,

because what is obvious to a layperson is necessarily obvious to one with a higher level of skill in the field of the invention.”.)

III. PETITIONER’S EXPERT’S OPINIONS ARE WELL SUPPORTED

Patent Owner’s attacks on Ms. Wagner are baseless. (POR, 22-26.)

First, Ms. Wagner is not a “hired gun” simply because she has been “hired twice” in PTAB cases seeking to invalidate patents over her lengthy career as an apparel designer. (POR, 22; EX1006, 4-10.) Nor should Ms. Wagner’s opinions be given no weight because counsel created annotated figures *at her direction* after talking about it with her for inclusion in her declaration. (POR, 22; EX2012, 120:6-15.)

Second, Patent Owner mischaracterizes Ms. Wagner’s testimony regarding the ’974 and prior art. (POR, 22-24.) When asked about the ’974, Ms. Wagner was not “unable to answer questions” or describe the invention, but instead responded that it is directed to men’s underwear constructed in a “specific way ... [t]o hold a man’s genitals,” consistent with the ’974 itself. (POR, 22-23; EX2012, 21:20-22:7, 23:10-14; ’974, Abstract, 1:36-60.) On whether Kitsch discloses a stretch panel, Patent Owner acknowledged Kitsch uses the word “stretch.” Ms. Wagner further testified that “Kitsch cites that a material made of containing Spandex is in there, ... which means it would be stretch. And the panels are made of that fabric,” consistent with Kitsch. (EX2012, 52:15-19, EX1007, [0030].) On whether Kitsch discloses an

“opening,” Ms. Wagner testified that Kitsch’s Figure 8 shows the opening. (EX2012, 82:6-25.) Ms. Wagner relied on Brocks’s teaching to attach elastic material while stretched to gather fabric, and not on Brocks having the same side panels as Kitsch. (*Id.*, 90:3-14; EX1005, ¶¶63-72.) And, contrary to Patent Owner’s assertion that Ms. Wagner “testified she had no idea whether Carrillo included a pouch,” she testified, consistent with her declaration, that Carrillo discloses a pouch created when the elastic garment number 1 is “sewn to the underwear.” (EX2012, 105:7-23; EX1005, ¶¶112, 117-18, 133.)

Patent Owner also attempts to discredit Ms. Wagner regarding her testimony about the shape of Kitsch’s side panels. (POR, 24.) But, her testimony again was consistent with her declaration—when the side panels are “laid into the garment” they are, together, generally rectangular. (EX2012, 101:5-15; EX1005, ¶¶79-80.)¹

Third, Patent Owner’s suggestions Ms. Wagner tried to mislead the PTAB by “selectively deleting claim language” or using ellipses to “alter” references are false. (PO, 25-26.) While Ms. Wagner admitted she had a typo in the *heading* for Claim

¹ Patent Owner’s claim that Ms. Wagner was unable to understand the description in claim language without seeing the garment is another mischaracterization. (POR, 25.) That testimony was not about claim language, but rather specific embodiments described in the ’974. *See* EX2012, 58:23-59:13.

1[g] in her declaration (POR, 25), her detailed analysis describes how the references teach this limitation, using the entirety of the language from the claim including that the front panel is “gathered from side-to-side and top-to-bottom.” (EX1005, ¶¶72, 141.) And, Ms. Wagner’s use of ellipses when quoting Kitsch did not alter its meaning—they simply shortened the quoted language to what she needed for her point that Kitsch discloses “isolating the genitalia.” (POR, 26; EX1005, ¶50; EX2012, 56:20-22.) Similarly, Ms. Wagner did not mislead when quoting the ’974 by leaving out that pieces of fabric making up the stretch panel could be “seamed together.” (POR, 26.) She quoted the portion necessary to show a stretch panel need not be one piece. (EX1005, ¶50.) In any event, Ms. Wagner’s declaration in fact explains Kitsch’s side panels are “seamed together” by both being seamed to the waistband seam and common seam 30a. (*Id.*)

IV. KITSCH-BROCKS RENDERS OBVIOUS CLAIM 1

Patent Owner’s arguments that Kitsch/Brocks fails to render claim 1 obvious improperly read limitations into the claims that are not there, rely on misunderstandings of patent law, ignore the combination of Kitsch with Brocks as presented, improperly attack each reference individually, and contradict express teachings of the ’974 itself. As such, they fail.

A. Claim 1[c]

Patent Owner argues Kitsch does not disclose a stretch panel because (1)

Kitsch does not expressly use the term “stretch panel,” (2) Kitsch’s side panels are allegedly “structurally different than” the stretch panel of the ’974, and (3) they “perform significantly different functions.” (POR, 28-31.) These arguments misapprehend Kitsch’s disclosures and the ’974.

First, Patent Owner and its expert, Mr. Kahn, insinuate Kitsch does not disclose a “stretch panel” because it never uses the exact term “stretch panel.” (POR, 29, EX2013, ¶51; EX1011, 108:22-109:20 (Mr. Kahn confirming it is his understanding a reference must use the same term as the claim to disclose it, and that for a reference to disclose the “stretch panel” of claim 1[c], it would have to use the term “stretch panel” itself.)) This is a fundamental misunderstanding of patent law, as it is well-established that to invalidate challenged claims, “the prior art need not, however, use the same words as the claims.” *Neuvolution A/S v. Chemgene Holdings APS*, IPR2017-01599, Paper 46 at 25 (PTAB Jan. 9, 2019) (citing *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009). Here, Kitsch is clear its “side panels” are elastic and stretch, and as set forth in the Petition these side panels disclose the claimed “stretch panel.” (EX1007, [0030], Pet., 12-14.)

Second, Patent Owner argues Kitsch’s side panels cannot be the claimed “stretch panel” because they are allegedly structurally different from the “stretch

panel of the '974 Patent.” (POR, 29-30, 33.)² However, these alleged structural differences have nothing to do with the claim language, and are contradicted by the '974 itself. For example, Patent Owner argues “the side panels 12 in Kitsch are not seamed or stitched together to surround the genitals;” “[t]hey are parallel to each other” and “never meet.” (*Id.*, 28-30.) But, nothing in claim 1 requires the “stretch panel” be a single, congruous piece as Patent Owner suggests. And, as explained in the '974, the stretch panel may be formed from a plurality of pieces of fabric seamed together. ('974, 8:5-10, 7:58-63.) This is precisely what Kitsch discloses—its side panels are “seamed together” as they are both attached to the waistband seam and common seam 30a. (EX1007, [0026]-[0030], Figs. 3, 8; EX1005, ¶50; EX2012, 63:5-66:5, 67:7-68:4.) Moreover, Kitsch’s two side panels joined to seam 30a work together to isolate the genitals and support the scrotum. (EX1007, [0026]- [0030]; EX1005, ¶50.)

² The opinions of Mr. Kahn regarding alleged differences between Kitsch and the claimed invention should be given little weight. Mr. Kahn admitted in deposition that his opinions are based on his analysis of the Kitsch reference and *of a product that was represented to him as relating to Kitsch*. (EX1011, 91:13-93:1.) Any differences between this product (which there is no evidence of) and the claimed invention are irrelevant.

Third, Patent Owner argues there are alleged “functional differences,” in that the ’974’s stretch panel “separates the genitalia from the body of the wearer” and “keeps the genitalia in an enclosed pouch separated from the body and keeps the scrotum from hanging below,” while Kitsch’s side panels allegedly do not. (POR, 31.) These alleged functional differences are irrelevant—nothing in claim 1 (or the ’974) requires the genitals be kept separate from the body. (EX1011, 98:8-100:4.) And, Kitsch’s side panels 12, like the ’974’s stretch panel, keep genitalia in an enclosed pouch separated from the body. (EX1007, [0006]-[0009], [0026]-[0030]; Pet., 14-15, 20-21.)³

B. Claim 1[d]

Patent Owner acknowledges Kitsch’s side panels are “a soft elasticized breathable mesh knit weave (in a so-called *four-by-four stretch weave*) containing 80% Nylon™ and 20% Spandex™,” and admits the side panels have at least a “limited amount of stretch in the length and width.” (POR, 33-34; EX1011, 104:3-5, 110:6-8, 113:2-5.) Thus, Kitsch’s stretch panels comprise “elastically resilient

³ Patent Owner’s criticism that Ms. Wagner misled the Board by providing a shortened quote from Kitsch regarding the side panels “isolating” the genitals into the pouch is without merit. (POR, 32.) Reading the full quote confirms the side panels “isolat[e] the genitalia” into the pouch. (EX1007, [0026]-[0027].)

four-way stretch material.” (Pet., 14-15.)

Patent Owner nonetheless alleges Kitsch does not disclose claim 1[d] by arguing features not in the claim, reading requirements into the '974 regarding the construction of the four-way stretch material that are not there, and arguing alleged differences between Kitsch and the '974 that are in fact similarities. (POR, 34.) Patent Owner argues Kitsch discloses only a “4x4 (box weave) woven fabric” for its side panels, whereas the '974's stretch panel is “constructed of 4-way stretch **knit** fabric which, due to its construction (**tricot** construction) stretches in length and width equally.” (POR, 34 (emphasis added); EX2013, ¶57.) This argument has no basis in the claim language nor the patent. Nowhere does claim 1, or the '974, indicate the stretch panel is made of “knit” fabric, much less that it has “tricot” construction. (EX1011, 120:4-123:13, 124:18-125:126:1.) And, Mr. Kahn's assertion that the claim term “four-way stretch material” identifies a “knit” fabric, which supposedly cannot be met by “woven” material like Kitsch's (Ex1011, 126:17-127:10) is contradicted by the '974 and cannot be correct. ('974, Cl. 1 (reciting that the stretch panel comprises “four-way stretch material”), Cl. 14 (reciting that the same stretch panel is a “piece of woven fabric”), 5:20-28.)

Patent Owner further argues Kitsch focuses on the fabric's breathability, whereas the '974 focuses on elasticity and comfort, and that the stretch in Kitsch's design is based on the content of SpandexTM rather than fabric construction. (POR,

34.) Again, Claim 1[d] does not include limitations directed to comfort, nor does it require specific fabric construction. These are also similarities, not differences. Kitsch, like the '974, discusses elasticity and comfort—its side panels are made from a “soft *elasticized* breathable” fabric and provide “improved comfort and support.” (Kitsch, [0030], [0006]; Pet., 3, 9, 12-13, 14-15, 20-21; EX1011, 129:8-131:22.) And the '974, like Kitsch, indicates its stretch panel can be “breathable” and include Spandex™ for stretch. ('974, 4:2-3, 5:20-28, Cl. 10; EX1011, 131:8-22.)

C. Claim 1[e]

Patent Owner argues Kitsch does not disclose a top edge, a bottom edge, and a side edge because “nowhere does Kitsch use the terms top edge and bottom edge to describe the attachment of the side panels to the body.” (POR, 34-35.) Again, “the prior art need not, however, use the same words as the claims.” *Neuvolution A/S*, IPR2017-01599, Paper 46 at 25. Kitsch discloses there are “upper ends 12c of side panels 12 where side panels 12 are stitched to the front walls 26 and waistband 22 of brief 10,” and thus Kitsch discloses a top edge. (Pet., 15-16; Kitsch, [0029].) Likewise, Kitsch’s side panels each have a “bottom edge” and “side edge” attached at seam 30a near the perineum area 24 and pouch seams 20, respectively. (Pet., 16-19.)

Patent Owner further argues Kitsch does not disclose a stretch panel having the claimed “opening.” (POR, 36-39.) This is based on the incorrect assumption that

the two stretch panels in Kitsch, connected together at seam 30a, cannot be a stretch panel. *See supra* Section IV.A. The two side panels together form the stretch panel, and the space between the “laterally spaced apart” side panels forms an opening that receives the wearer’s genitalia to isolate “the genitalia, in particular scrotum 14 and phallus 16... **into pouch compartment 18**, thereby isolating the genitalia from contacting the inner thigh and legs of the user.” (Pet., 19-20; EX1005, ¶¶59-60; EX1007, [0006]-[0009], [0026]-[0028].)

D. Claim 1[f]

As explained with respect to Claim 1[e], Kitsch discloses a stretch panel with a top edge, a bottom edge, and side edges. *See supra* Section IV.C. (*See also*, Pet., 15-20.) Similarly, Kitsch’s side panels are four-way stretch material. *See supra* Section IV.B. (*See also*, Pet., 12-15, 20-21.) Thus, Kitsch’s side panels would stretch and recover (*i.e.*, be resiliently elastic) in four directions, including if they were stretched diagonally upwards and outwards. (Pet., 20-21; EX1005, ¶¶61-62.)

Further, Kitsch explains the “flexibility and elasticity” of the side panels allow them to “mould to gently conform to the shape of the scrotum 14 in particular and allow for resiliently supported relative movement of the scrotum relative to the pubis and perineum 24 of user 8, side panels 12 resiliently cradling and biasing the scrotum back into its naturally resting position.” (EX1007, [0029]; Pet., 20-21; EX1005, ¶62.) For the side panels to conform to the shape of the scrotum and provide resilient

support, they would need to stretch and resiliently contract in all directions. (EX1005, ¶62.)

E. Claim 1[g]

Patent Owner's arguments that Kitsch in view of Brocks does not render claim 1[g] obvious are easily dismissed. (POR, 42-46.) Patent Owner's arguments are based on the improper assumptions Petitioner relied on hindsight⁴ and that a POSITA would not be motivated to modify Kitsch with Brocks without the '974 as a "template" or "roadmap." (*Id.*) However, no hindsight is needed, and a POSITA need not look to the '974 for the concept of attaching an elastic material in a stretched state to the front of underwear to help gather fabric and form a supportive pouch. (Pet., 21-27) This is expressly taught in Brocks, and the motivations to combine Brocks with Kitsch come from the references and knowledge of a POSITA. (*Id.*; EX1008, 2:5-21, 3:23-4:14.) Moreover, Patent Owner's conclusory arguments

⁴ Patent Owner's expert, Mr. Kahn, was unable to provide a clear answer as to his understanding of hindsight (EX1011, 39:7-51:2), even suggesting that looking at prior art references in determining whether a claim of a patent may be obvious is improper hindsight, and that claims of a patent cannot be found obvious over a combination of references. (EX1011, 49:2-8, 49:15-51:2.) As such, Mr. Kahn's opinions regarding hindsight should be given little to no weight.

ignore the detailed discussions in the Petition and Ms. Wagner's declaration as to why a POSITA would have been motivated to combine Kitsch and Brocks. (Pet., 25-27; EX1005, ¶¶ 68-72.)

Patent Owner's additional arguments are also easily dismissed. Patent Owner argues a POSITA would not combine Kitsch with Brocks "because both references define a genital pouch as a portion of the garment that traps the genitals against the body" while the '974's design is to "surround the genitals" and "separate the genitals from the body and limit movement of the genitals for comfort." (POR, 44.) None of these things are required by Claim 1. ('974, Cl. 1; EX1011, 98:8-100:4.) And, they are incorrect as Kitsch's side panels 12 support the wearer's genitals in a pouch separated from the body. (Pet., 19-27, EX1007, [0006]-[0009], [0026]-[0032], [0036]; *see supra* Section IV.A.)

Patent Owner further argues a POSITA would not have been motivated to "modify Kitsch with Brocks at all," because Kitsch "uses side panels, and it already had a pouch." (POR, 44-45.) This misses the point. While Kitsch has a pouch partially formed by its side panels, a POSITA would have recognized that, for example, by attaching these side panels in a stretched state as taught by Brocks, the side panels would help gather the fabric and add to the "formation and supportive nature of the pouch." (Pet., 25-26; EX1005, ¶¶68-72.)

Patent Owner additionally argues combining Kitsch with Brocks would result

in “a version of Kitsch with Kitsch’s side panels and Brocks’ elastic strips around the legs.” (POR, 46.) The Petition never suggests taking Brocks’ elastic strips and adding them around Kitsch’s leg openings. (Pet., 21-27.) Rather, a POSITA would have taken Brocks’ teachings to attach elastic material while stretched to help gather fabric and form a pouch, and applied this to Kitsch such that Kitch’s elastic side panels were attached while stretched to create a supportive pouch with sufficient volume. (*Id.*; EX1005, ¶¶68-72; EX1008, 2:5-21, 3:23-4:14.)

V. CARRILLO-BROCKS RENDERS OBVIOUS CLAIM 1

A. Claim 1[d]

Patent Owner’s argument that Carrillo “provides no description for the material of his elastic garment,” and thus a POSITA would not have understood Carrillo’s elastic material to be four-way stretch material, is meritless.⁵ (POR, 47-

⁵ Patent Owner and its expert claim that Nylon-Spandex blends are entirely hydrophobic fiber fabrics, which “do not have moisture wicking characteristics, are not breathable, and are therefore less comfortable than hydrophilic fiber fabrics.” (POR, 47.) Neither provide any support for such conclusory statements. Moreover, this has nothing to do with whether Carrillo renders obvious using “elastically resilient four-way stretch material.” Nor does it preclude Spandex blends from being used in Carrillo’s underwear.

49.) While Carrillo may not specify a particular fabric, Carrillo clearly states it's U-shaped garment is *elastic*. (*Id.*, 47.) A POSITA would also have understood the U-shaped elastic garment would be four-way stretch material. (Pet., 51-52; EX1005, ¶¶121-122.) For example, a POSITA would have understood that underwear stretched top-to-bottom and left-to-right to accommodate wearers of different sizes and shapes, and the elastic garment sewn to the front of the underwear would do the same to accommodate the wearer's movements. (Pet., 51-52; EX1005, ¶¶121-122.)

Moreover, it would have been obvious to a POSITA for the U-shaped elastic garment to be four-way stretch material. (Pet., 53-54.) For example, a POSITA would have understood the *elastic* garment must be either four-way stretch or two-way stretch (that is, the garment must stretch top-to-bottom and left-to-right or in only way of these directions). (*Id.*) Patent Owner argues that if Carrillo's accessory was stitched to the waistband, it would not need to stretch at all because the elastic waistband itself would adequately stretch for a wearer to pull the underwear on. (PO, 48.) This is incorrect, because if the U-shaped garment did not stretch, it would prevent the waistband to which it is attached from stretching open enough, or would cause uncomfortable bunching. (Pet., 52-54; EX1005, ¶¶121-23.)

B. Claim 1[g]

As clearly set forth in the Petition, it is Carrillo *in combination with Brocks* that renders obvious Claim 1[g]. (Pet., 60-66.) While Patent Owner first presents

alleged deficiencies in Carrillo alone, none of these criticisms has merit. (POR, 49-51.) First, Patent Owner argues Carrillo does not have a pouch because Carrillo’s U-shaped garment is “essentially congruent” with the inside of the body of the underwear, and forms a “pocket” but somehow not a “pouch.” (POR, 49.) But, Carrillo never describes its U-shaped garment as “essentially congruent” to the underwear body nor does it use the term “pocket.” (POR, 49; EX2013, ¶102.) Instead, the U-shaped garment is “sewn to the inner front part” of underwear and allows the wearer to “introduc[e] the intimate parts” through an opening and into what a POSITA would understand is a pouch between the U-shaped garment and front of the underwear, creating “sufficient separation” between the genitals and the body. (Pet., 49-51; EX1010, 2 (noting the U-shaped garment causes the genitals to be “pulled forward” into the area between the garment and front of the underwear), EX1005, ¶133.)

Second, Patent Owner argues Carrillo does not disclose supporting the genitals from underneath. (POR, 49-50.) But, claim 1 does not require supporting genitals from underneath, and the argument is nonetheless flawed. In Carrillo, when the genitals are introduced through the opening, the U-shaped elastic garment “gently pull[s] them forward.” (Pet., 49-51, 77-79, 91-93.) Stated differently, the U-shaped elastic garment supports the genitals from underneath to create separation between the genitals and the wearer’s body. (*Id.*; *see also* EX1010, 2-3.)

Third, Patent Owner's arguments Carrillo does not disclose gathering the front portion to form a pouch nor the claimed lengths of the stretch panel relative to the front portion are irrelevant—the Petition relies on Carrillo in view of Brocks for this, not Carrillo alone. (POR, 50-51; Pet. 60-66.) Moreover, Patent Owner's assertions Carrillo's figure suggests its front panel “lays flat” or that its stretch panel “is at best baggy” when sewn to the underwear are baseless. (POR, 50-51.) In fact, if Carrillo's U-shaped garment were “baggy,” it would not perform its stated function to “gently pull [the genitals] forward” to separate them from the wearer's body. (EX1010, 2-3; EX1005, ¶¶137-41; Pet., 64-66.)

Patent Owner's arguments with respect to the combination of Carrillo with Brocks fail, largely for the same reasons discussed above with respect to Kitsch/Brocks. Again, the Petition did not rely on hindsight, but rather the express teachings in Brocks for the concept of attaching elastic material when stretched in order to gather fabric and create a pouch, and applying this to Carrillo's U-shaped elastic garment. (POR, 52; Pet., 60-66.) And again, whether Brocks “traps the genitals against the body” is irrelevant to the limitations actually in Claim 1. (POR, 52.)

Patent Owner suggests a POSITA would not have been motivated to modify Carrillo with Brocks because their objectives are allegedly different, and that a combination of Carrillo and Brocks would result a pair of underpants that “include

an elastic garment (Carrillo) and a pouch created by elastic material surrounding leg openings (Brocks).” (POR, 53-54.) These arguments distort the combination as presented. For example, the Petition never suggests directly incorporating Brocks’ elastic strips around the leg openings in Carrillo’s underwear in addition to the U-shaped elastic garment. (Pet., 60-66.) Rather, the Petition explains a POSITA would have taken Brocks’ teaching of attaching elastic material while stretched such that the elastic contracts and causes a gathering to form a pouch, and applied this to Carrillo so its U-shaped elastic garment is attached while stretched such that it gathers the front of the underwear to form a pouch with sufficient volume to receive the genitals when they are pulled forward, and that keeps them separated from the body. (Pet., 60-66; EX1005, ¶¶133-141, EX1008, 2:5-21, 3:23-4:14.)

VI. DEPENDENT CLAIMS

Patent Owner argues each challenged dependent claim is patentable because all depend from allegedly patentable Claim 1. (POR, 56-57.) Patent Owner is incorrect, and Claim 1 is unpatentable over Kitsch in view of Brocks and Carrillo in view of Brocks.⁶ *See supra* Sections IV-V.

⁶ Similarly, Patent Owner argues Petitioner failed to demonstrate why a POSITA would combine the prior art for the same reasons discussed for Claim 1. This argument also fails for the reasons discussed above with respect to Claim 1.

A. Claim 2

Patent Owner argues neither Kitsch nor Carrillo disclose an asymmetrical stretch characteristic, and thus neither Kitsch nor Carrillo in view of Brocks renders Claim 2 obvious. (POR, 57.) But, the Petition did not rely on Kitsch or Carrillo alone. Rather, it relied on teachings from Brocks to explain why a POSITA would have found it obvious to use a material with asymmetric stretch for Kitsch's side panels and Carrillo's U-shaped elastic garment. (Pet., 27-29, 66-69 (noting Brocks discloses materials used in men's underwear have asymmetrical stretch characteristics, with greater stretch laterally than vertically.) It would have been obvious to a POSITA to use a material with asymmetrical stretch characteristics for Kitsch's side panels or Carrillo's U-shaped garment because these are already elastic, and underwear often is stretched more in the lateral direction (*i.e.*, parallel to the waistband) during normal use such as when it is put on. (*Id.*)

B. Claim 3

Patent Owner concedes its only argument that Claim 3 is not obvious over Carrillo/Brocks is that the combination does not render Claim 1 obvious. (POR, 58.) This is wrong. *See supra* Section V.

With respect to Kitsch, Patent Owner argues Kitsch's side panels are boomerang shaped, and not rectangular. (POR, 57-58.) However, this improperly looks at each side panel individually, and not as installed together in the underwear.

When the two side panels are viewed after being attached to the underwear at the waistband seam and seam 30a, forming the stretch panel, they have a generally rectangular shape. (Pet. 29-30; EX1005, ¶¶79-80.) Patent Owner’s argument that Kitsch does not disclose a “U-shaped opening” because Kitsch’s side panels do not have any opening also fails because, as discussed, there is an opening between the two side panels. *See Supra* Section IV.C. Moreover, the side panels form a “pear-shaped” pouch compartment, and define a U-shaped opening into that pouch. (Pet., 29-30; EX1007, Figs. 1-3, 8, [0029], [0036]-[0039].)

C. Claims 4 and 5

Claims 4 and 5 recite that the stretch panel has “at least 30%” stretch. (’974, Cls. 4-5, POR, 58-59.) Patent Owner confusingly argues that “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.” (POR, 59.) It is unclear what Patent Owner means by this, but Brocks discloses its elastic material stretches by at least 30%. (Pet., 30-35, 70-75; EX1008, 2:5-13, 3:24-4:14; EX1005, ¶¶81-88, 152-158; EX1011, 144:10-145:15.) It would have been obvious to use a stretch panel having at least 30% stretch as taught by Brocks for Kitsch’s side panels or Carrillo’s U-shaped garment in order to gather the fabric to form a pouch with sufficient volume. (Pet., 30-35, 70-75; EX1005, ¶¶81-88, 152-158.)

D. Claims 6, 7, 13

Patent Owner's sole argument is that these claims depend from claim 1, which Patent Owner argues is allegedly patentable. (POR, 59-60.) This is incorrect. *See supra* Sections IV-V.

E. Claims 8

Patent Owner's arguments that neither Kitsch/Brocks nor Carrillo/Brocks renders obvious a stretch panel with an opening having a "width in excess of 2cm" fail. (POR, 60.) First, Kitsch does disclose an opening between its two side panels into the pouch. *See Supra* Section IV.C. And, while neither Kitsch nor Carrillo specifically recites an opening width, the Petition set forth substantial rationale as to why a POSITA would understand these openings are at least 2cm to accommodate a phallus and scrotum into a pouch compartment. (Pet., 35-36, 76-77; EX1005, ¶¶91, 161.) Patent Owner provides no substantive argument refuting this.

F. Claim 9

Patent Owner repeats its argument that Kitsch does not disclose "a stretch panel as disclosed and claimed in the '974 Patent," and thus, Kitsch/Brocks does not render Claim 9 obvious. (POR, 60-61.) But, Kitsch in view of Brocks discloses the claimed stretch panel, and thus Patent Owner's arguments with respect to claim 9 also fail. *See supra* Section IV.A.

With respect to Carrillo/Brocks, Patent Owner again argues that Carrillo teaches a pocket and not a pouch. (POR, 61.) This is incorrect. *See supra* Section

V.B. Patent Owner next argues “[t]he opening taught by Carrillo is not suited to supporting the wearer’s genitalia, as it provides no supporting surface underneath the genitalia,” and thus Carrillo does not teach a stretch panel that supports the scrotum to contain the wearer’s penis and scrotum in a pouch as required by Claim 9. (POR, 60-61.) This is a mischaracterization of Carrillo, which discloses the U-shaped garment is attached to the front of the underwear to form a pouch, and that “the normal tendency of the [U-shaped] elastic garment, when sewn to the inner front part of the underwear, is to gently ***pull forward*** [the genitals], achieving, with this garment, a sufficient separation to reduce the continuous direct contact and friction[.]” (EX1010, 2-3 (emphasis added); Pet., 78; EX1005, ¶¶163-64.) That is, the front of the underwear and U-shaped elastic garment form a pouch, and the genitals are supported underneath by the U-shaped elastic garment as it pulls the genitals forward into the pouch. (EX1005, ¶164.)

G. Claim 10

With respect to Kitsch/Brocks, Patent Owner argues that Kitsch and Brocks fail to render Claim 10 obvious because they fail to render obvious Claim 1. (POR, 62.) This is incorrect. *See supra* Section IV.

Patent Owner’s arguments with respect to Carrillo/Brocks/Kitsch similarly fail. Despite Patent Owner’s conclusory assertions otherwise, the Petition sets forth numerous reasons why a POSITA would have used the Spandex blend taught in

Kitsch for Carrillo’s U-shaped elastic garment. (POR, 62, Pet., 83-85.) Carrillo discloses that its U-shaped garment is generally “elastic” and is intended to “improv[e] the perspiration of the [genital] area” by “eliminat[ing] direct contact between the testicles and the groin, avoiding continuous friction or poor positioning of the testicles between the legs.” (EX1010, 1.) Kitsch discloses Spandex blend side panels serving the same purpose, explaining these side panels “wick away moisture and provid[e] superior comfort,” and allow for “resiliently supported relative movement of the scrotum.” (EX1007, [0006], [0029]; *see also* [0002], [0008], [0022]-[0024], [0030]-[0036].) It would have been obvious to a POSITA to use Kitsch’s Spandex blend for Carrillo’s U-shaped elastic garment to achieve comfortable genital separation and support while wicking away moisture. (Pet., 83-85; EX1005, ¶¶170-173.)

H. Claim 11

Patents Owner’s arguments regarding Claim 11 fail.

First, the Petition cites Brocks for teaching attaching elastic material while pre-stretched to gather fabric, not for disclosing a stretch panel or opening, and Patent Owner’s argument that Brocks does not disclose these is irrelevant. (POR, 62; Pet. 39-41, 79-81.)

Second, Patent Owner’s arguments that Kitsch does not disclose a stretch panel with an opening are incorrect, as explained above. (POR, 62-63; *see supra* Sections IV.A, IV.C, IV.E.)

Third, Patent Owner’s arguments regarding “physical manipulation” allegedly required in Carrillo are unrelated to the limitations in the claim—nowhere does the claim exclude physical manipulation as long as the opening is biased open. (POR, 63.)⁷ Carrillo discloses a U-shaped elastic garment, and as explained in the petition, this elastic garment would be biased to hold open the opening when attached in a pre-stretched condition as taught by Brocks. (Pet., 79-81.)

Fourth, Patent Owner only attacks the references individually, and does not address the combinations as presented—that Kitsch and Carrillo as modified by Brocks (to attach the stretch panels while pre-stretched) include stretch panels biased to hold the openings open. (Pet., 39-41, 79-81.)

I. Claim 12

Patent Owner argues Kitsch/Brocks does not disclose Claim 12 because they allegedly do not disclose Claim 1. (POR, 63.) This is again wrong. *See supra* Section IV. With respect to Carrillo/Brocks/Kitsch, Patent Owner argues “Carrillo does not

⁷ Patent Owner’s arguments that Carrillo’s elastic garment is “baggy” are also incorrect. *See supra* Section V.B.

disclose anything about the perineum or a perineum seam,” and that the Petition fails to provide a basis for why a POSITA would combine Carrillo with Brocks and Kitsch. (POR, 63-64.) This is untrue. While Patent Owner offers a conclusory statement that Petitioner fails to articulate why Carrillo, Brocks and Kitsch should be combined, the Petition in fact provides numerous reasons, including to connect the elastic garment at a common seam forward of the perineum, to reduce the number of seams necessary and reduce itching, friction and irritation, and to ensure the elastic garment extends far enough backward to be able to pull the genitals forward and separate them from the legs and groin. (Pet., 85-90; EX1005, ¶¶174-79.)

J. Claim 15

Patent Owner admits Kitsch discloses a dart seam, but argues Claim 15 is patentable over Kitsch/Brocks because Kitsch and Brocks fail to render obvious Claim 1. (POR, 64.) Further, Patent Owner argues Claim 15 is patentable over Carrillo/Brocks/Kitsch because the Petition allegedly does not articulate why Kitsch, Carrillo, and Brocks should be combined. (POR, 64.) As with Claim 12 above, both arguments fail. Kitsch/Brocks renders Claim 1 obvious, and the Petition includes numerous, unrebutted examples why a POSITA would have been motivated to make the combination. (Pet., 44-45, 91-93; EX1005, ¶¶105-07, 180-83; *see supra* Section IV.)

K. Claims 16

With respect to Kitsch/Brocks, Patent Owner merely repeats that Kitsch discloses side panels which are not rectangular, and that it does not have an opening. (POR, 65.) As discussed above, these arguments fail and so Patent Owner's arguments with respect to Claim 16 also fail. *See supra* Section IV.C, VI.B.

With respect to Carrillo/Brocks, Patent Owner only argues they fail to disclose Claim 1. (POR, 65.) This is incorrect. *See supra* Section V.

VII. CONCLUSION

For the reasons stated above and in the Petition, the Board should find the challenged claims unpatentable.

Dated: July 23, 2025

Respectfully submitted,

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PETITIONER’S EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 10,834,974 (“’974”)
1002	File History for the ’974 Patent
1003	File History for U.S. Patent No. 10,034,496
1004	File History for U.S. Patent No. 9,687,030
1005	Declaration of Robin Wagner
1006	Curriculum Vitae of Robin Wagner
1007	U.S. Patent Application Publication 2008-0178369 (Kitsch)
1008	U.S. Patent No. 5,461,729 (Brocks)
1009	WO 01/67687 (Carrillo)
1010	WO 01/67687 (Carrillo) - English Translation with Certification
1011	Deposition Transcript of Mr. Bernard Kahn

Certificate of Word Count

The undersigned certifies, in accordance with 37 C.F.R. § 42.24(d), that the foregoing **PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE** complies with the type-volume limitation of 5,600 words, comprising 5488 words, excluding the parts exempted by § 42.24(c).

Dated: July 23, 2025

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Certificate of Service

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, the foregoing **PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE** was served on July 23, 2025, electronically via e-mail upon the following parties:

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