

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXTGEN TOYS, LLC.,
Petitioner,

v.

ZIPSTRING, LLC,
Patent Owner.

Case IPR2024-01213

Patent 11,674,774

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S CONTINGENT MOTION TO ADD SUBSTITUTE
CLAIMS 21-26 AND 28**

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I. INTRODUCTION

Patent Owner has proposed substitute claims that incorporate limitations to the existing independent claims. Dr Janét, who meets Petitioner's requirements of a POSITA, did not evaluate the prior art in a vacuum but in view of not just the claims, but the teachings of the intrinsic evidence provided by the specification, and consequently conducted an evaluation consistent with how a POSITA would understand the claims in view of the specification. The patentability of the claims at issue are discussed in the Patent Owner's Response and Dr. Janét's Opinion. The prior art relied upon by the Petitioner does not teach the same loading slot features as claimed in the '774 Patent or provide the motivation that a POSITA would rely upon to combine the references to arrive at the Patent Owner's claimed invention. Instead, the Petitioner relies heavily upon Dr. Kudrowitz conclusory opinions regarding how a POSITA would evaluate the prior art references in order to come to the conclusion that claims are rendered obvious.

II. PATENTABILITY ARGUMENTS

A. Substitute Claims 21-26 and 28 are not rendered Obvious Over Wagner in View of Yeany and Scorch (Grounds 3 and 4 in the Petition)

- 1. Substitute Claim 21 - "wherein the housing covers, at least partially, the pair of wheels, and wherein the housing defines a loading slot therein through which the string is loaded from between the pair of wheels"**

2. Substitute Claim 25 – “including a loading slot ... wherein said loading slot provides a mechanism to load and unload said looped string”

Dr. Janét made a reasoned analysis pointing out specifically why the combination of the prior art cited by Petitioner would not be considered by a POSITA and why it would not yield the claimed invention. Dr. Janét opined that Dr. Kudrowitz’s proposed combination of Wagner in view of Yeany and Scorch results in a housing design that is impractical, unsuitable for a kinetic device, unsafe and unnecessarily complicated to use, including string loop installation and removal. Dr. Kudrowitz’s modification of Wagner actually results in a worse design than if Wagner was left as-is. Dr. Janét identifies these design deficiencies in evaluating how a POSITA would not be motivated to combine the references in the conclusory manner advanced by Dr. Kudrowitz. Dr. Kudrowitz fails to articulate why a skilled artisan would be motivated to combine the references of Wagner, Yeany and Scorch, which results in the Petitioner failing to meet its burden.

In an *inter partes* review, the burden of proof always rests on the Petitioner to articulate this reasoning; the burden never shifts to the Patent Owner to prove the absence of a motivation to combine. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Accordingly, Patent Owner respectfully

requests that the Board acknowledge that proposed substitute claim 21 and 25 and claims 22- 24, 26 and 28 which depend therefrom in the '774 Patent are patentable.

B. Substitute Claims 25, 26 and 28 are not rendered Obvious over Abello in view of Yeany (Ground 2 in the Petition)

1. Substitute Claim 25 - “including a loading slot... wherein said loading slot provides a mechanism to load and unload said looped string”

As Dr. Janét opined in reviewing the context of the prior art, a POSITA would identify that neither Yeany nor Abello include a housing between a pair of wheels as disclosed in the '774 patent. *See* Exhibit 2002 ¶ 117. Substitute claim 25 includes “ receiving a looped string into a housing including a loading slot between a pair of wheels, wherein said loading slot provides a mechanism to load and unload said looped string”.

Accordingly, it would be impossible to include the limitation of loading slot to a housing that neither Yeany nor Abello discloses. Throughout the record, Dr. Kudrowitz has provided unsupported conclusory arguments and has failed to articulate why a POSITA would be motivated to combine these references.

In an *inter partes* review, the burden of proof always rests on the Petitioner to articulate this reasoning; the burden never shifts to the Patent Owner to prove the absence of a motivation to combine. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Accordingly, Patent Owner respectfully

requests that the Board acknowledge that proposed substitute claim 25 and claims 26 and 28 which depend therefrom of the '774 Patent are patentable.

III. DEFINITENESS OF SUBSTITUTE CLAIM 25

Patent Owner contends that the Petitioner has not met the burden of demonstrating the proposed substitute claim 25 is indefinite. The limitation requiring a “loading slot” that “provides a mechanism to load and unload said looped string” would be clear to a person of ordinary skill in the art when read in context of the specification and drawings, where support is found for this limitation. ‘774 Patent Col. 10 lines 42-44. Accordingly, Patent owner requests that the Board reject the argument of the Petitioner that substitute claim 25 is indefinite.

IV. CONCLUSION

Substitute Claims 21-26 and 28 of the ‘774 patent are patentable for the reasons provided in Patent Owner Responses as further addressed in this Sur-Reply.

Respectfully submitted,

Dated October 14, 2025

EPSTEIN DRANGEL LLP

/s/ Kenneth W. Cohen

Kenneth W. Cohen (Reg. No. 69,686)

Jodi-Ann McLane (Reg. No. 36,215)

60 East 42nd Street, Suite 1250

New York, NY 10165

(305) 978-9914

Kcohen@ipcounselors.com

CERTIFICATE OF COMPLIANCE WITH PAGE LIMITS

Pursuant to 37 C.F.R., § 42.24(d), I certify that this Sur-Reply to Petitioner's Opposition to Patent Owners Motion to Amend complies with the page limit requirements of 37 C.F.R. § 42.24 (c)(3) because it contains less than 12 pages, excluding the parts that are exempted.

CERTIFICATE OF SERVICE

I hereby certify that on October 14, 2025 a copy of the foregoing document was served via email on the following:

Email: jpmurphy@polsinielli.com

jkuo@polsinelli.com

Dated: October 14, 2025

/s/ Kenneth W. Cohen

Kenneth W. Cohen (Reg. No. 69,686)

EPSTEIN DRANGEL LLP

60 East 42nd Street, Suite 1250

New York, NY 10165

(305) 978-9914

Kcohen@ipcounselors.com

Jmclane@ipcounselors.com

mail@ipcounselors.com