

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

2985, LLC d/b/a MOUNTAIN VOYAGE COMPANY, LLC
Petitioner

v.

Ridge Wallet, LLC
Patent Owner

U.S. Patent No. 10,791,808

Inter Partes Review No. IPR2024-01264

**PETITION FOR INTER PARTES REVIEW
OF U.S. PATENT NO. 10,791,808**

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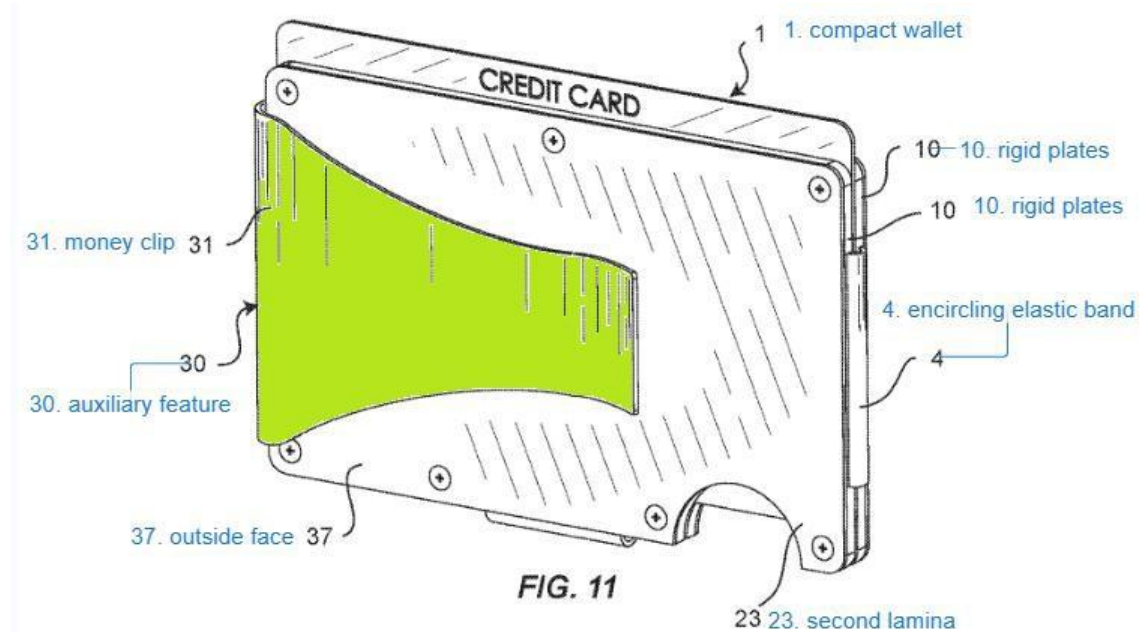
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EX1003	Declaration of Dr. Cameron
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EX1019	U.S. Patent Application Publication No. 2015/0059936 to SINGER (“SINGER”)

I. INTRODUCTION

2985, LLC d/b/a MOUNTAIN VOYAGE COMPANY, LLC (“Petitioner”) requests *inter partes* review (“IPR”) of claims 1-24 (“the challenged claims”) of U.S. Patent No. 10,791,808 (“the ‘808 patent”) (EX1001) in accordance with 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 et seq. According to USPTO records, the ‘808 patent is assigned to **Ridge Wallet, LLC**. (“Patent Owner”). For the reasons below, the challenged claims should be found unpatentable and cancelled.

The claims of the ‘808 patent are mainly directed to a kind of compact wallet. At the time the application for the ‘808 Patent was filed¹, compact wallet was a well-established technology. The inventors of the ‘808 Patent did not purport to invent compact wallet, but instead merely sought to improve the compact wallet, and the so-called improvement method is just to provide an ordinary auxiliary feature on the appearance of the compact wallet, further more, the purported auxiliary feature mainly came in the form of a “money clip,” best shown in the exploded view in Figure 11 of the ‘808 patent¹.

¹ In the reproduced images, The part about the money clip has been painted green.



EX1001,FIG 11

Such a money clip was long known in the field of compact wallets, however. The prior art showed various money clips that are identical to the money clip involved in the '808 patent, both in structure and function. Thus, the '808 patent was improvidently granted.

In the detailed analysis below, it is demonstrated that claims 1-24 of the '808 patent are unpatentable over the prior art, and that the Petitioner has a reasonable likelihood of prevailing with respect to the same.

II. MANDATORY NOTICES

A. Real Parties-in-Interest

Pursuant to 37 C.F.R. § 42.8(b)(1), Petitioner certifies that 2985, LLC d/b/a MOUNTAIN VOYAGE COMPANY, LLC is the real party-in interest.

B. Related Matters

The '808 Patent has been asserted by PO against Petitioner in *The Ridge Wallet LLC v. 2985 LLC, d/b/a Mountain Voyage Co*, Case No. 1:23-cv-00407 (D. Colo. February 10, 2023) (“Parallel Litigation”) (Ex. 1018).

The '808 Patent has been asserted by PO in:

- *The Ridge Wallet LLC v. Suzhou Niu Mo Wang Electronic Technology Co., Ltd. d/b/a Nimalist and Normest*, Case No. 24-cv-00241 (N.D.Ill. January 10, 2024).
- *The Ridge Wallet, LLC v. Shenzhen Pinan Technology Co. Ltd. d/b/a ARW-Wallet*, Case No. 23-cv-00392 (E.D. Tex. August 29, 2023).
- *The Ridge Wallet LLC v. Bemmo Inc.*, Case No. 23-cv-02091 (E.D.N.Y. March 17, 2023).
- *The Ridge Wallet LLC v. Shenzen X-World Technology Co. Ltd.*, Case No. 1:24-cv-03569 (N.D. Ill. May 2, 2024).
- *Certain Compact Wallets and Components Thereof*; Inv. No. 337-TA-1355 (ITC February 6, 2023).

The following petitions for IPR of the '808 Patent are pending with the Board: IPR2024-00340 (filed on January 2, 2024 and instituted on July 12, 2024), and IPR2024-00692 (filed on March 15, 2024 and pending institution).

The following pending U.S. patent applications that claim priority, directly or indirectly, to the '808 Patent, may affect, or be affected by, a decision in this proceeding:

U.S. Application No. 29/813,614, filed October 29, 2021

U.S. Application No. 18/076,188, filed December 6, 2022

U.S. Application No. 29/894,998, filed June 15, 2023

U.S. Application No. 29/896,573, filed July 5, 2023

U.S. Application No. 29/896,575, filed July 5, 2023

U.S. Application No. 29/898,353, filed July 26, 2023

U.S. Application No. 29/898,354, filed July 26, 2023

U.S. Application No. 29/822,078, filed January 5, 2023

U.S. Application No. 29/882,878, filed January 19, 2023

U.S. Application No. 29/898,352, filed July 26, 2023

U.S. Application No. 29/898,361, filed July 26, 2023

U.S. Application No. 18/117,238, filed March 3, 2023

U.S. Application No. 29/919,216, filed December 1, 2023

U.S. Application No. 29/813,617, filed October 29, 2021

U.S. Application No. 29/813,628, filed October 29, 2021

U.S. Application No. 29/896,574, filed July 5, 2023

U.S. Application No. 29/919,214, filed December 1, 2023

U.S. Application No. 18/126,279, filed March 24, 2023

U.S. Application No. 18/241,741, filed September 1, 2023

U.S. Application No. 18/107,955, filed February 9, 2023

U.S. Application No. 29/898,360, filed July 26, 2024

U.S. Application No. 29/925,946, filed January 26, 2024

U.S. Application No. 18/126,336, filed March 24, 2023

U.S. Application No. 29/989,357, filed July 26, 2023

U.S. Application No. 29/919,218, filed December 1, 2023

C. Counsel and Service Information

Pursuant to 37 C.F.R. § 42.8(b)(3), Petitioner provides the following designation of counsel:

Lead counsel – Jacob M. Busch (Reg. No. 70,830).

Backup counsel – Igor D. Ozeruga (Reg. No. 72,399).

D. Service Information

Pursuant to 37 C.F.R. § 42.8(b)(4), papers concerning this matter should be served in accordance with the following:

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Cleveland, OH 44113

Email: iozeruga@tarolli.com

Telephone: (216)452-6822

Petitioner consents to electronic filing.

III. PAYMENT OF FEES

Petitioner pays the fee for this petition as required by 37 C.F.R. § 42.15(a) contemporaneously with the filing of this petition.

IV. GROUNDS FOR STANDING

Pursuant to 37 C.F.R. § 42.104(a), Petitioner certifies that the '808 patent is available for IPR and Petitioner and the real parties-in-interest are not barred or estopped from requesting IPR on the grounds identified herein. The '808 patent has not been subject to a completed estoppel based proceeding of the AIA.

V. PRECISE RELIEF REQUESTED AND GROUNDS RAISED

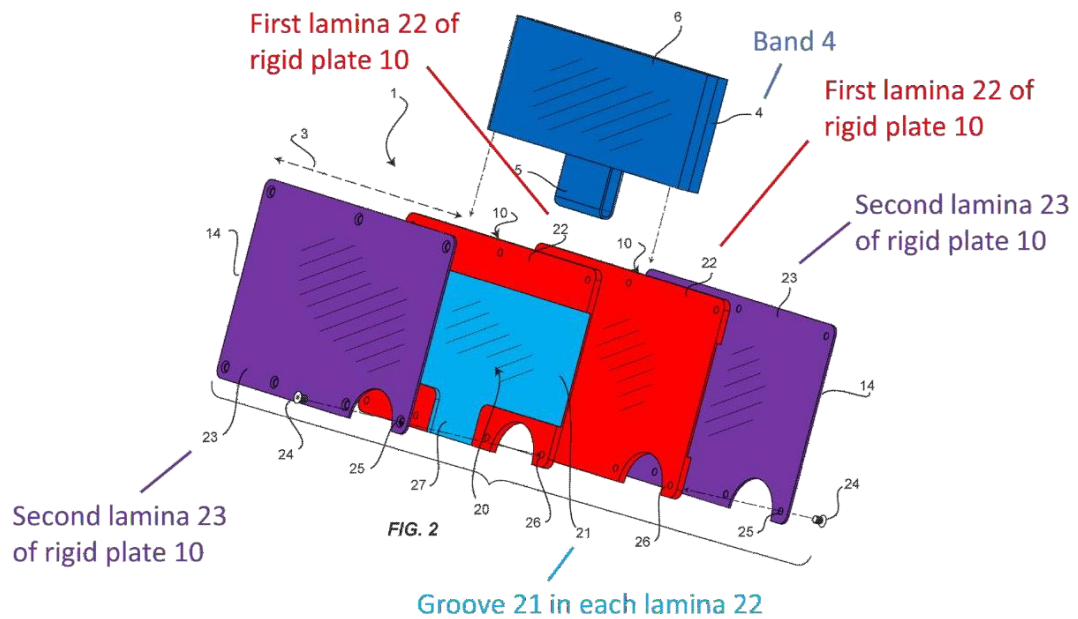
Pursuant to 37 C.F.R. § 42.22 (a)(1) and 37 C.F.R. § 42.104(b)(2), Petitioner requests cancellation of the Challenged Claims pursuant to the grounds below (listed in tabular form). Additional support is provided in the Declaration of Dr. Kimberly Cameron.

Ground	Claim(s)	35 U.S.C.§	Reference(s)/Basis
Ground 1A	1-9,11-24	103	Kane and Beckley
Ground 1B	10	103	Kane, Beckley, and Minn
Ground 1C	13	103	Kane, Beckley, and Preston-Hall
Ground 1D	1-9,11-24	103	Kane and Murphy
Ground 1E	10	103	Kane, Murphy, and Minn
Ground 1F	13	103	Kane, Murphy, and Preston-Hall
Ground 1G	1-9,11-24	103	Kane and Roman
Ground 1H	10	103	Kane, Roman, and Minn
Ground 1I	13	103	Kane, Roman, and Preston-Hall
Ground 2A	1-24	103	Minn, Podwika, Coates, and Beckley
Ground 2B	13	103	Minn, Podwika, Coates, Beckley, and Preston-Hall
Ground 2C	1-24	103	Minn, Podwika, Coates, and Murphy
Ground 2D	13	103	Minn, Podwika, Coates, Murphy, and Preston-Hall
Ground 3A	3,16	103	Kane, Beckley, and SINGER

VI. BACKGROUND

The '808 patent concerns compact wallets and methods for making them. Abstract, '808 Patent. At the time the application for the '808 Patent was filed, a compact wallet was a well-established technology. As shown in FIGs. 1-10 (annotated FIG. 2 is reproduced below), an exemplary wallet of the '808 Patent has two rigid plates (10) that hold cards (2) in between. EX1001, 3:58-61. As illustrated in annotated FIG. 2, lamina (22, red) and

(23, purple) are screwed together to make up the rigid plate (10) and the band (4, blue) is captured between (22, red) and (23, purple) in longitudinal groove (21, teal).



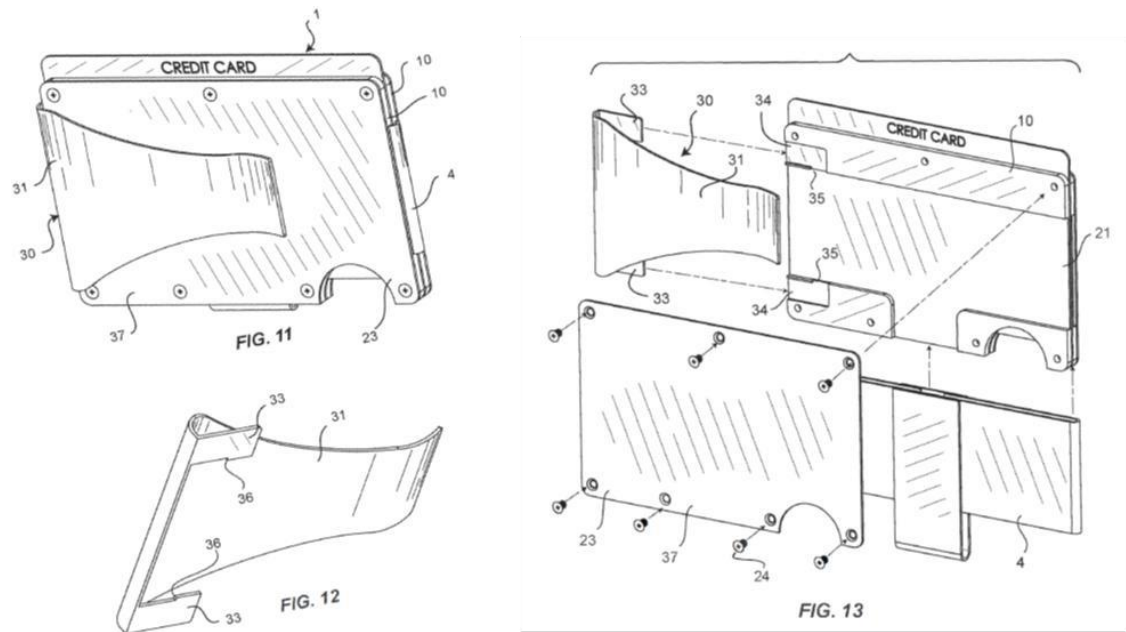
EX1001, FIGs. 11-13, annotations and color added.

The wallets of the independent claims of the '808 Patent have four main components: (1) two rigid plates to put cards between, (2) an elastic band that encircles the plates over the length, (3) channeling means to hold the band, and (4) a removable auxiliary feature attached to one plate with a tang insertable into a recess of the rigid plates with an undercut. Only FIGs. 11-13 of the '808 patent show an embodiment that includes the claimed auxiliary feature.

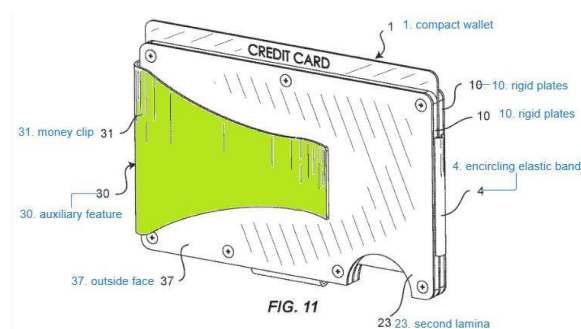
FIGs. 11-13 have been reproduced below and annotated FIG. 11 has the auxiliary feature (clip) highlighted. The auxiliary feature has tangs (33)

that are inserted between lamina (22) and (23) and engage a recess (34).

The tang has (33) has a hook (36) that engages an undercut 35 of the recess.



EX1001, FIGs. 11-13

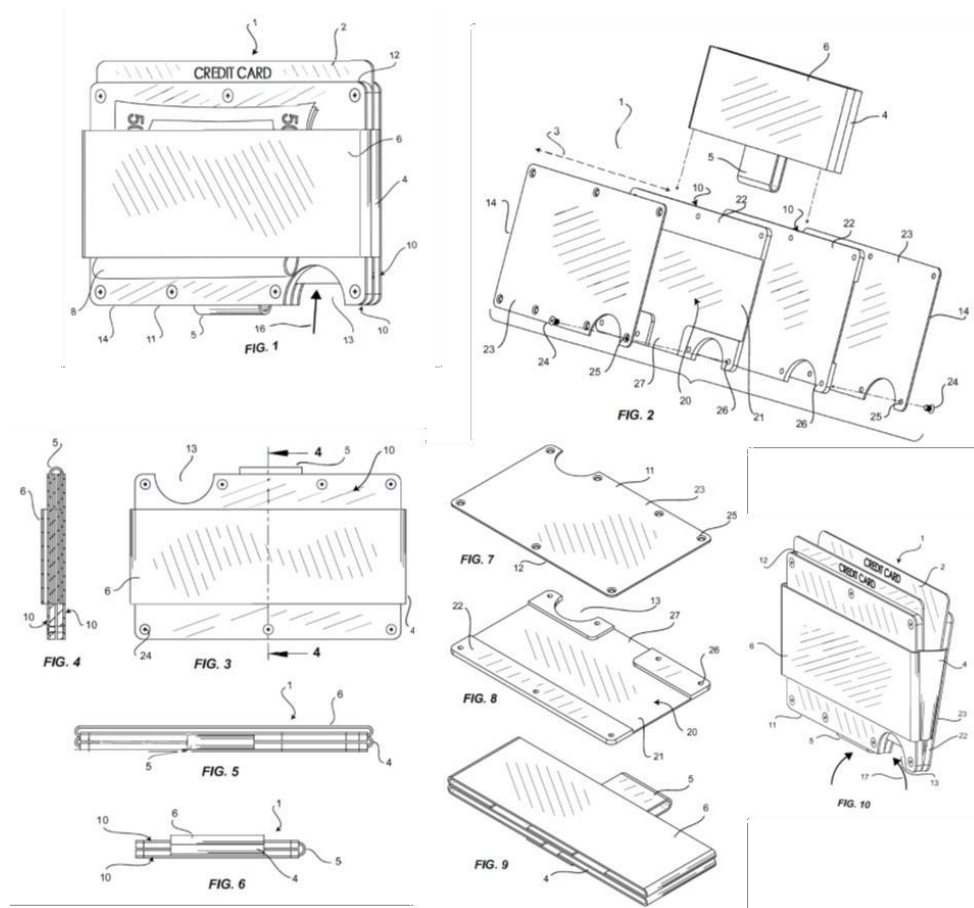


EX1001, FIG. 11 annotated

VII. Prosecution History

The '808 patent was filed as a continuation-in-part of Application No. 14/706,019 ("the '019 Application") (EX. 1002). The '019 Application

also involves a compact wallet, and the FIGs. of the '019 Application are reproduced below:

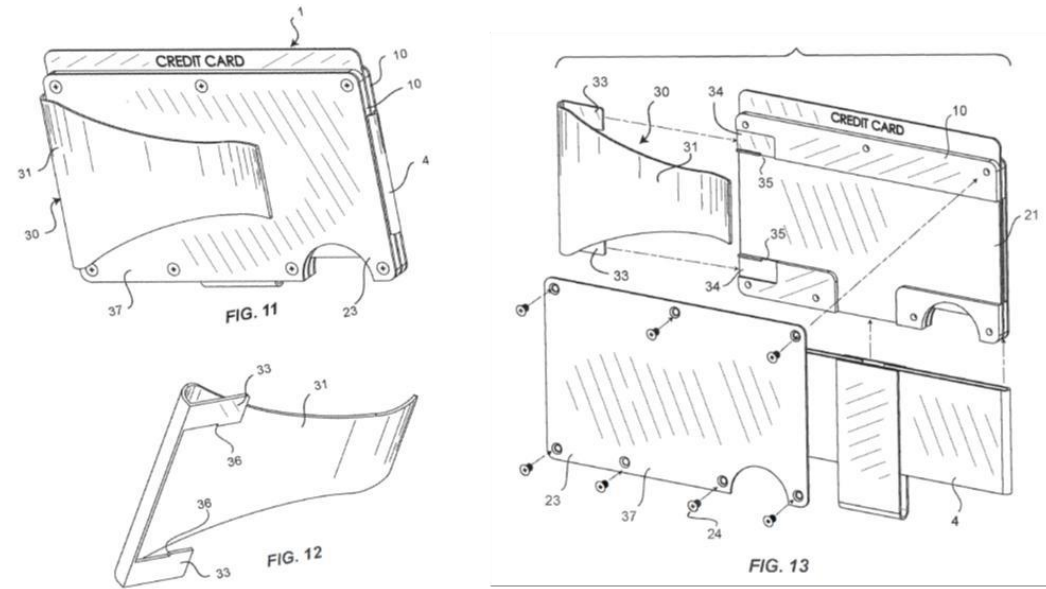


EX1002, FIGs. 1-10

Between 2017 and 2019, claims of the '019 Application were rejected five times and the application was eventually abandoned. EX1017, page 70 (August 7, 2017 Office Action), page 101 (January 16, 2018 Office Action), page 132 (May 31, 2018 Office Action), page 152 (December 18, 2018 Office Action), page 177 (July 25, 2019 Office Action), page 188 (April 1, 2020 Notice of Abandonment).

The application that led to the '808 Patent, U.S. Patent Application No. 15/421,596 ("the '596 application") (EX1013, pages 1-53) added an

auxiliary feature, which appears in the form of an ordinary money clip. The figures that were added to the continuation in part application are reproduced below.



EX1001 FIGs. 11-13

The initial claims in the '596 Application do not significantly differ from those that were rejected in the aforementioned '019 Application. Therefore, based on the same or similar grounds that led to the rejection of the claims of the '019 Application, the examiner also rejected the claims of the '596 Application. EX1013 (page 67, September 19, 2018 Office Action). In response to the rejection of the '596 Application, the applicant amended the independent claims of the '596 Application (claims 1, 14, and 19) as follows (EX1013, pages 80-85):

Independent claim 1 addition: “an auxiliary feature removably attached to at least one of the at least two rigid plates, the auxiliary feature

having a tang insertable into a recess formed inside the at least two rigid plates, the tang having a hook, the hook extending at an angle to the tang, the hook engaging an undercut of the recess to prevent inadvertent dislodgement of the auxiliary feature from the recess.”

Independent claim 14 addition: “a recess formed inside at least one of the at least two rigid plates, the recess operable to receive a tang of an auxiliary feature, the recess having an undercut operable to engage a hook of the tang to prevent inadvertent dislodgement of the auxiliary feature from the recess when the auxiliary feature is removably positioned in at least one of the at least two rigid plates, the hook extending at an angle to the tang.”

Independent claim 19 addition: “the at least one recess having an undercut operable to engage a hook of the tang to prevent inadvertent dislodgement of the second auxiliary feature from the at least one recess, the hook extending at an angle to the tang, the at least one recess receiving the tang being disposed inside at least one of the two rigid plates.”

Following this amendment, the claims issued without any further rejections and the examiner did not appear to search based on “tang,” or “clip” or other terms that would result in references that disclose the claimed auxiliary feature.

As will be discussed in more detail, references such as Beckley, Murphy and Roman that disclose the claimed auxiliary feature were not considered by the examiner.

VIII. Priority

Since all of the claims of the '808 Patent include the limitations related to the auxiliary feature which were not disclosed in the '019 application, the priority date for all of the claims is February 1, 2017.

IX. Claim Construction

Claim construction in *inter partes review* is governed by the same standard as it would be in a district court, and any prior claim construction determination concerning a term of the claim in a civil action, or a proceeding before the International Trade Commission (ITC), that is timely made of record in the *inter partes review* proceeding will be considered. 37 C.F.R. § 42.100(b). Terms should be interpreted in view of “their ordinary and accustomed meaning as understood by one of ordinary skill in the art.” *Dow Chem. Co. v. Sumitomo Chem. Co.*, 257 F.3d 1364, 1372 (*Fed. Cir.* 2001); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (*Fed. Cir.* 2005) (*en banc*).

In a related litigation (Inv. No. 337-TA-1355),

the ITC has issued an Order construing certain claim terms on August 21, 2023, which Petitioner have included as *EX1014* and shown in the table below.

Since filing Petitioner’s first IPR (IPR2024-00692), the District Court of Colorado held the same construction shown in the table below in the Parallel Litigation. *See* EX. 1020. For terms not specifically construed, Petitioner have used the plain and ordinary meaning of those terms in light of the specification, and contended that all the challenged claims are anticipated or obvious under any reasonable interpretation, to maintain consistency with the Parallel Litigation.

Construction in the Order issued by ITC about certain claim terms briefly shown as follows:

Claim Term	Construction
“channeling means”	Function: “to minimize the profile of the wallet and hold position of the at least one encircling elastic band with respect to each rigid plate while allowing freedom of the dynamic extension and contraction of the band over the entire running length thereof” Structure: “a groove spanning the extent of one or more of the rigid plates or a longitudinal bore through one or more of the rigid plates”
“auxiliary feature” (claim 1, 14)	Plain and ordinary meaning
“undercut” (claims 1, 14)	Plain and ordinary meaning
“hook” (claims 1, 14)	Plain and ordinary meaning

“interposed”	Plain and ordinary meaning
“minimal silhouette”	Plain and ordinary meaning
“minimize the profile”	Plain and ordinary meaning

X. PRIOR ART REFERENCES

A. Kickstarter Website: The Ridge Wallet 2.0 (“Kane”)

Kane is a Kickstarter website (EX1004) as evidenced by a web archive captured by the Internet Archive (www.archive.org) on Sep 3, 2013:

<https://web.archive.org/web/20130903204002/https://www.kickstarter.com/projects/124039987/the-ridge-wallet-20>

and this Kickstarter website (EX1004) has been authenticated by a records request processor at the Internet Archive. See EX1018 and EX1004. Kickstarter published more than one year before the earliest priority date of the ’808 patent and thus is prior art under 35 U.S.C. § 102(a)(1). The Ridge Wallet 2.0 is also described at

<https://www.kickstarter.com/projects/124039987/the-ridge-wallet-20>

(last updated January 27, 2014).

B. U.S. Patent No. 9,125,465 (“Beckley”)

Beckley (EX1008) issued on Sep 08, 2015 as U.S. Patent No. 9,125,465. Beckley is prior art under 35 U.S.C. § 102(a)(1). Beckley was not considered during the prosecution of the ’808 patent, nor is it cumulative of any prior art considered by the examiner.

C. U.S. Patent Publication No. 2006/0010661 (“Murphy”)

Murphy (EX1006) published Jan 19, 2006 as U.S. Patent Publication No. 2006/0010661. Murphy is prior art under 35 U.S.C. § 102(a)(1). Murphy was not considered during the prosecution of the ’808 patent, nor is it cumulative of any prior art considered by the examiner.

D. U.S. Patent No. 5,103,884 (“Roman”)

Roman (EX1012) issued on Apr 14, 1992 as U.S. Patent No. 5,103,884 to Roman. Roman is prior art under 35 U.S.C. § 102(a)(1). Roman was not considered during the prosecution of the ’808 patent, nor is it cumulative of any prior art considered by the examiner.

E. U.S. Patent No. 9,125,464 (“Minn”)

Minn (EX1005) issued on Sep 08, 2015 as U.S. Patent No. 9,125,464. Minn is prior art under 35 U.S.C. 102(a)(1).

F. U.S. Patent No. 5,944,080 (“Podwika”)

Podwika (EX1009) issued on Aug 31, 1999 as U.S. Patent No. 5,944,080. Podwika is prior art under 35 U.S.C. § 102(a)(1).

G. U.S. Patent No. 7,527,081 (“Coates”)

Coates (EX1011) issued on May 05, 2009 as U.S. Patent No. 7,527,081. Coates is prior art under 35 U.S.C. § 102(a)(1).

H. U.S. Patent No. 5,831,360 (“Preston-Hall”)

Preston-Hall (EX1010) issued on Feb 26, 2013 as U.S. Patent No. 8,381,360. Preston-Hall is prior art under 35 U.S.C. § 102(a)(1).

I. U.S. Patent Publication No. 2015/0059936 (“SINGER”)

US Patent Publication No. 2015/0059936 to SINGER (“SINGER”) (EX1019) published Mar 05, 2015. SINGER was published more than a year before the earliest priority date of the '808 patent and thus is prior art under 35 U.S.C. § 102(a)(1).

XI. LEVEL OF ORDINARY SKILL IN THE ART

A person of skill in the art in the field of compact wallets would have a technical degree (e.g., Bachelor of Science in engineering) with some experience in analyzing, designing, or creating mechanical devices such as wallets.

XII. PRIOR ART OVERVIEW

1. KickStarter The Ridge Wallet 2.0 (“Kane”)

Kane is a website describing The Ridge Wallet 2.0 :

<https://web.archive.org/web/20130903204002/https://www.kickstarter.com/projects/124039987/the-ridge-wallet-20>

Kane was also a **core reference** cited by the examiner when initially rejecting the claims of the '019 Application and '596 Application, See

EX1017, Pages 179-182; also see EX1013, pages 35, 61, 73. Below are several images from Kane that show the structure of the wallet and the expanding capacity of the wallet as the elastic band stretches over its length:



Kane (EX1004), page 5



(EX1004), page 5

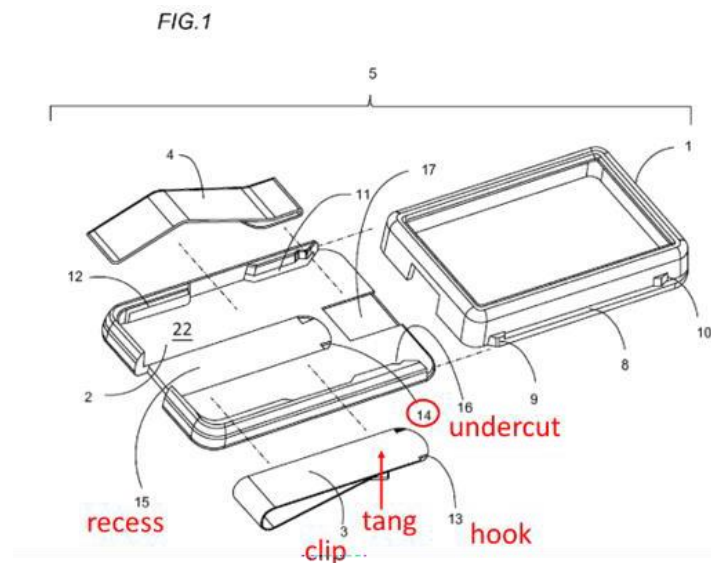
Kane shows and explains the internal construction of each rigid plate between which cards are held. Each rigid plate has an aluminum layer with a lengthwise groove for capturing the elastic band (shown in white in the top image and in black in the other images) with a faceplate screwed to it that is made of aluminum, titanium or carbon fiber.

Kane further explains that the design is “Low profile to easily fit in

your front pocket,” can “Block RFID-skimming devices (wireless identity theft),” has a “Singular Construction that won't let cards slip out the bottom” and an “Expandable track that can accommodate a various number of cards.” EX1004, page 4.

2. U.S. Patent 9,125,465 (“Beckley”)

Beckley shows an example of a money clip for a wallet that uses two tangs with a hook at an angle to engage an undercut of a recess as shown below in annotated Fig. 1 of Beckley.



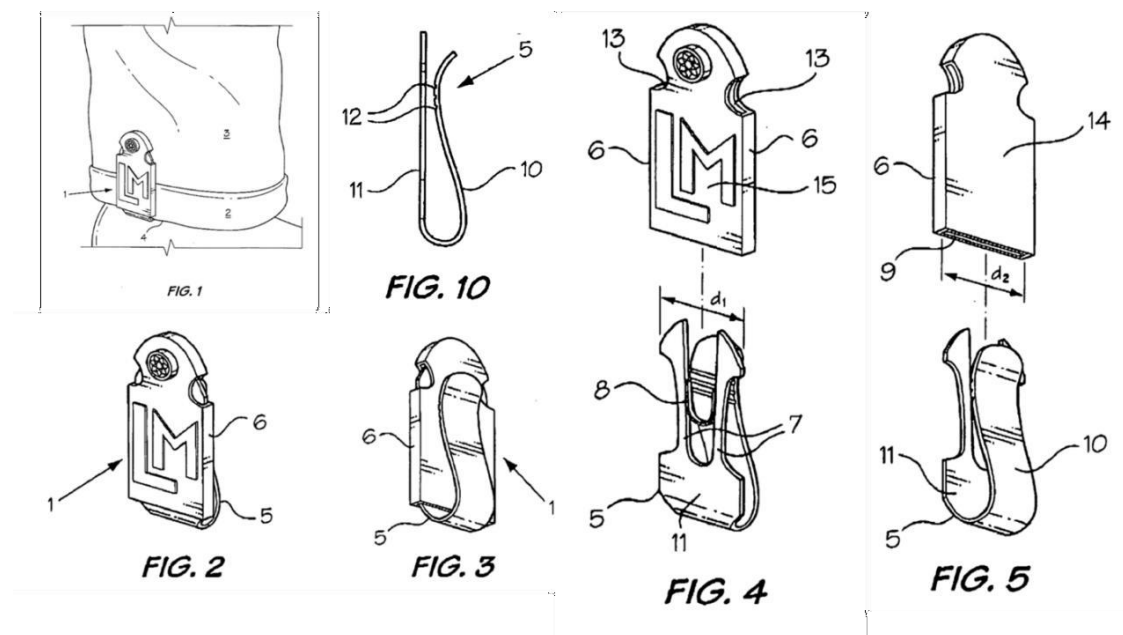
Beckley (EX1008), Fig 1, annotated in color.

“The clip 3 is assembled to the base 2 by inserting the clip 3 into a depression 15. It is held in place by a pair of barbs seen at 13 mated into a set of cavities 14 on the base 2. The retention spring 4 is assembled to the

base 2 by sliding it onto a pocket 17.” EX1008, 4:30-40. In this way, the clip 3 is removably engaged with a rigid plate of a compact wallet.

3. U.S. Patent Application Pub. 2006/0010661 (“Murphy”)

As shown in Figure 1, 2, 3, 4, 5 and 10 below, Murphy discloses a “device purposed to adjust the size or shape of a garment or other item, or to be worn itself as an accessory.” EX1006, page 1, Abstract. The removable clip of Murphy uses two tangs with a hook at an angle to engage a recess with an undercut.



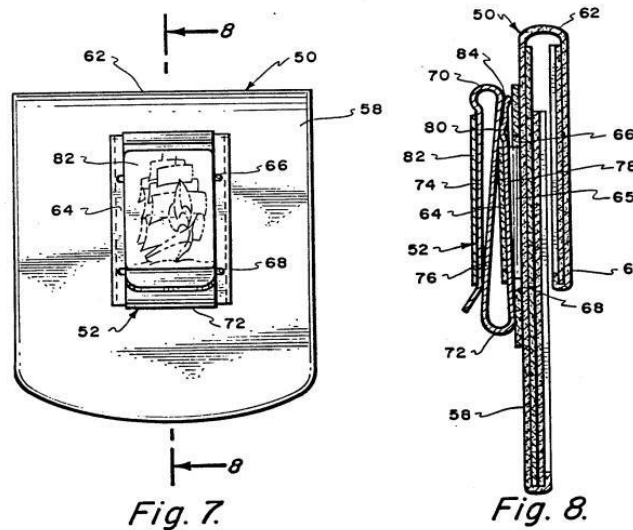
EX1006. Figs. 1-5, Fig 10

Murphy discusses the benefit of being able to exchange the display portion of the sleeve. As illustrated in FIG. 5, Murphy states: “the clip-member typically includes a grasping portion, as represented by the exterior clip portion (10), which grips the interior face of the pant leg (3),

and a display element engagement portion, such as interior clip portion (11), which is structured to receive the display element. As illustrated, the interior clip portion (11) is designed to match in size and geometry with a flexible clipping element engagement portion of the display element, such as the cavity (9) defined in sleeve (6).” EX1006, [0051].

4. U.S. Patent 5,103,884 (“Roman”)

As shown in Figure 7 and Figure 8, Roman discloses a wallet with a removable clip.



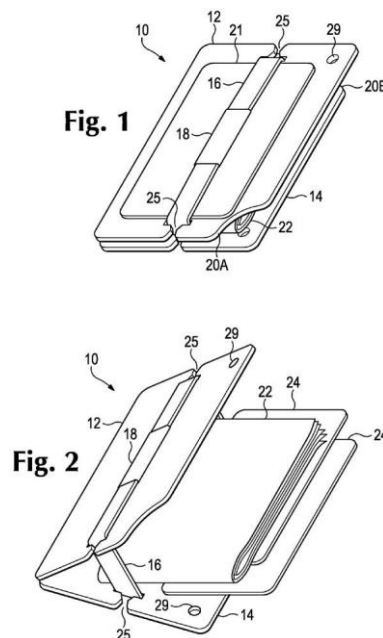
Roman (EX1012), Fig 7 and Fig 8

As explained in the background of the invention, an “object of the present invention is to provide a wallet, or device for carrying money and other valuables which has a removable clip which can be used in a normal fashion as a money clip, but also can be used to attach to the wallet to carry it in a concealed fashion. Still another object of the present invention is to

provide a unique wallet having a removable clip which is small and compact for carrying money and credit cards which and is easily accessible without removal from the clipped position.” EX1012, 1:54-64.

5. U.S. Patent 9,125,464 (“Minn”)

As shown below in Figure 1 and 2 below, Minn discloses a compact wallet.



EX1005, Fig. 1 and Fig. 2

Plates **12** and **14** are described as being made from metal and/or carbon fiber, which would make the plates rigid. EX1005 2:19-20. Strap **16** is elastic and holds the plates together. *Id.*, 2:20-21. Various combinations of money credit cards or other cards can be compressively held between the plates or be held outside of either plate **12** or **14**. *Id.*, 2:22-25.

6. U.S. Patent 5,944,080 (“Podwika”)

As shown below in FIG. 1 of Podwika, Podwika discloses a money and card holder with an integral retaining clip and an elastic retaining band.

Abstract, Podwika.

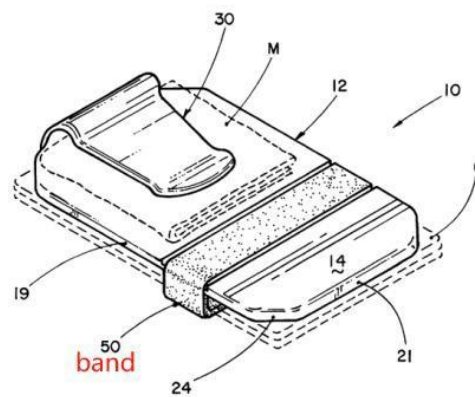


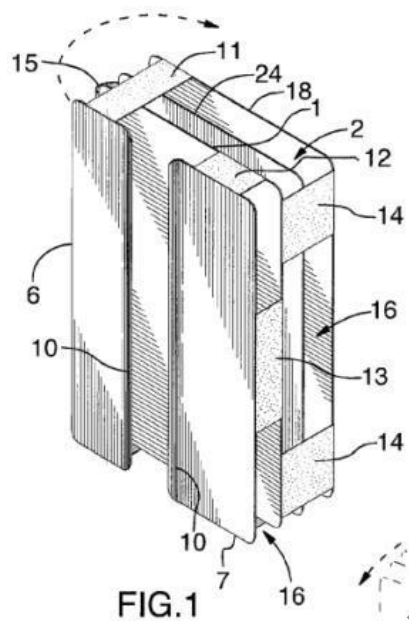
FIG. 1

EX1009, FIGs. 1 and 3

As shown in Figure 1, Podwika teaches how to position an elastic band (*band 50*) with a groove (*recess 26*). EX1009, FIG. 1.

7. U.S. Patent 7,527,081 (“Coates”)

As shown below in FIG. 1, Coates discloses a compact wallet with elastic bands between panels. The main panels 1 are the size of a credit card.



EX1011, FIG. 1

Coates explains that “[i]t is desirable to provide a wallet billfold or credit card holding device that it is of minimal size and weight while maintaining the ability to expand to accommodate a varying thickness of credit cards and currency.” EX1011, 1:22-25. Therefore, “[m]ain panels 1 (**1a**, **1b**, **1c**) in the example illustrated are of the size and shape of a conventional credit card.” EX1011, 2:59-61.

Coates also teaches enclosing an elastic band in a laminate structure with a groove as shown below in Figure 13 of Coates. In Figure 13, the lamina are **24a** and **24b** and the elastic band is **4**.

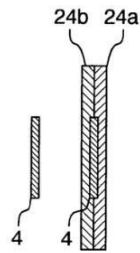


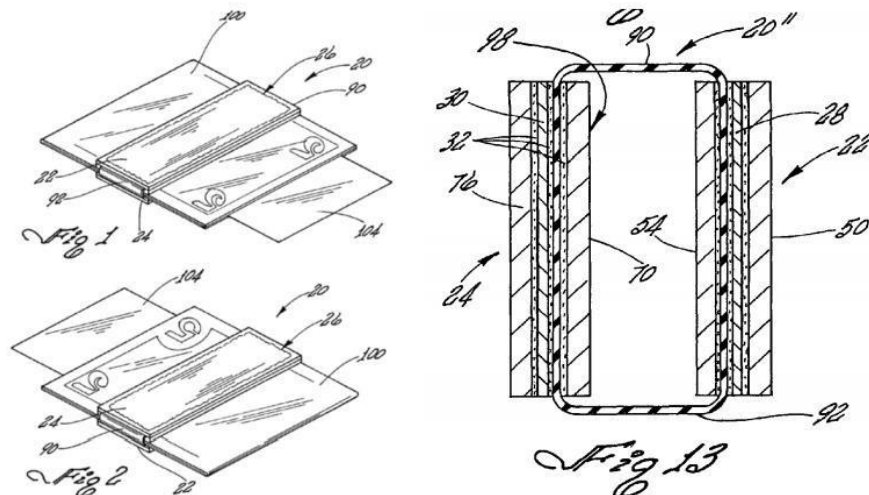
FIG. 13

EX1011, FIG. 13

8. U.S. Patent 8,381,360 (“Preston-Hall”)

As shown in Figs. 1, 2, and 13 of Preston-Hall below, Preston-Hall discloses a woven elastic band for use as an encircling elastic band. As explained in the specification: “An endless loop **96** of a woven, longitudinally extendable, elastic fabric material having a predetermined length is located between each of the inner planar support members **54** and **74** and its adjacent deflectable spring members **28** and **30**.”

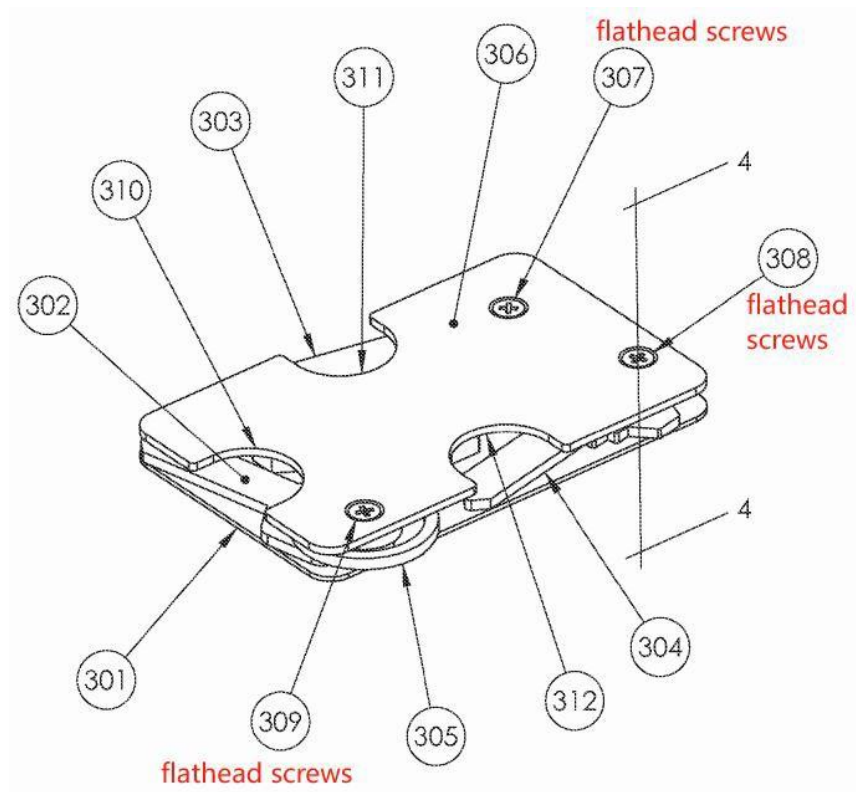
EX1010, 11:35-39.



EX1010, Fig 1-2 and 13

9. U.S. Patent Publication No. 2015/0059936 (“SINGER”)

SINGER’s invention involves: “Small form-factor apparatus and methods for holding, securing, and accessing personal items normally carried on a keychain or in a wallet including.” See EX1019,at [abstract].



EX1019,FIG 3.Annotated

XIII. DETAILED EXPLANATION OF GROUNDS

Ground 1A: Claims 1-9, 11-24 are unpatentable under 35 U.S.C. § 103 over Kane in view of Beckley.

1. Claim 1

a. Claim 1pre: A compact wallet, comprising

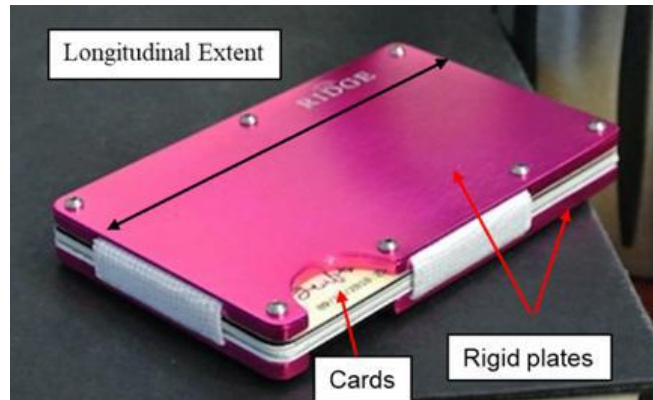
While the preamble is not necessarily limiting, Kane is a compact wallet. As stated in Kane: “More than a minimalist wallet,” EX1004, Page 3, and “With an integrated elastic track, The Ridge 2.0 can accommodate various numbers of cards without losing elasticity; providing an extremely thin wallet that isn't limited in its capacity.” *Id.* Page 3.



EX1004, page 5.

- b. Claim 1a:** at least two rigid plates interposed to sandwich card-like contents there between, each rigid plate having a longitudinal extent;

This limitation is present in Kane, as seen below. As described in Kane, “The Ridge 2.0 can accommodate various numbers of cards without losing elasticity; providing an extremely thin wallet that isn't limited in its capacity.” EX1004 Page 3.



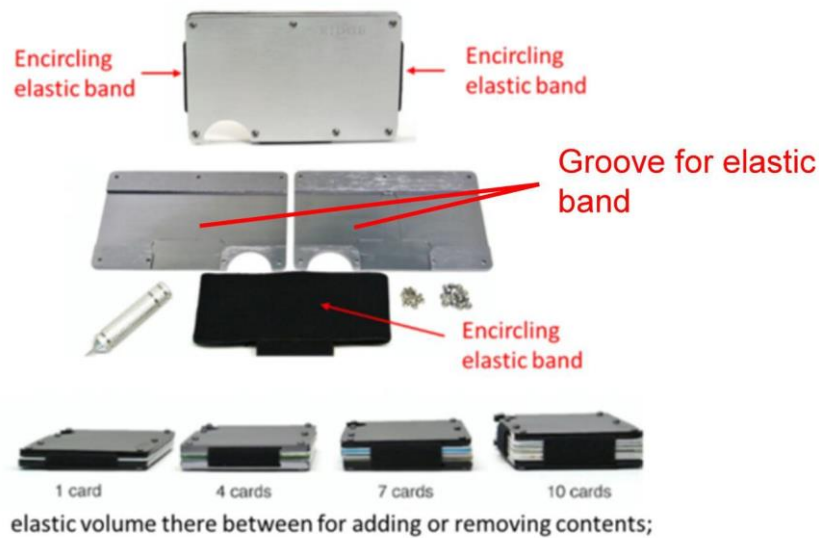
EX1004, page 5.

- c. **Claim 1b:** at least one encircling elastic band interposed with the at least two rigid plates along longitudinal extents thereof to bias them inwardly and securely hold the card-like contents while providing elastic volume there between for adding or removing contents;

Kane contains this limitation. The elastic band sits in a groove within each rigid plate and encircles the plates and cards. The band stretches to accommodate a variable number of cards. As explained in Kane, “With an integrated elastic track, The Ridge 2.0 can accommodate various numbers of cards without losing elasticity; providing an extremely thin wallet that isn't limited in its capacity.” EX1004, page 3.



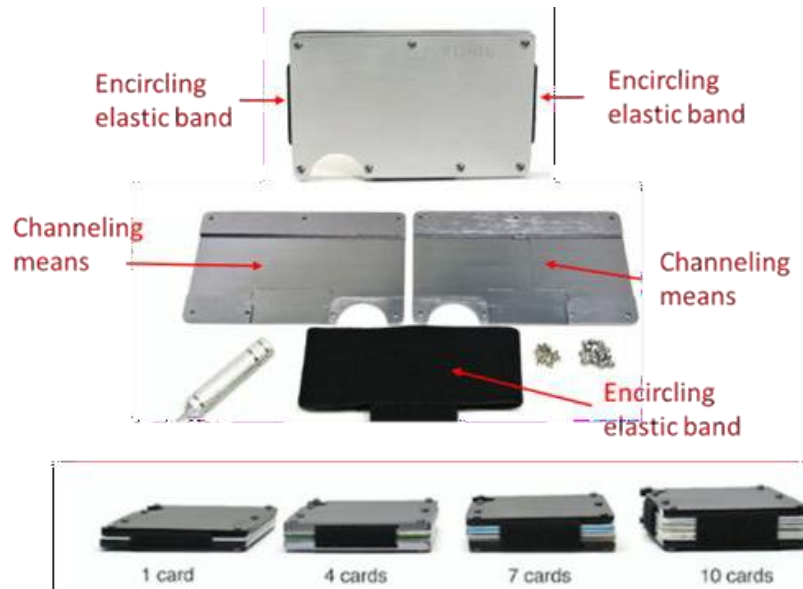
EX1004, page 5.



EX1004, pages 5,6, annotated in color.

- d. **Claim 1c:** a channeling means configured to minimize the profile of the wallet and hold position of the at least one encircling elastic band with respect to each rigid plate while allowing freedom for the dynamic extension and contraction of the band over the entire running length thereof; and

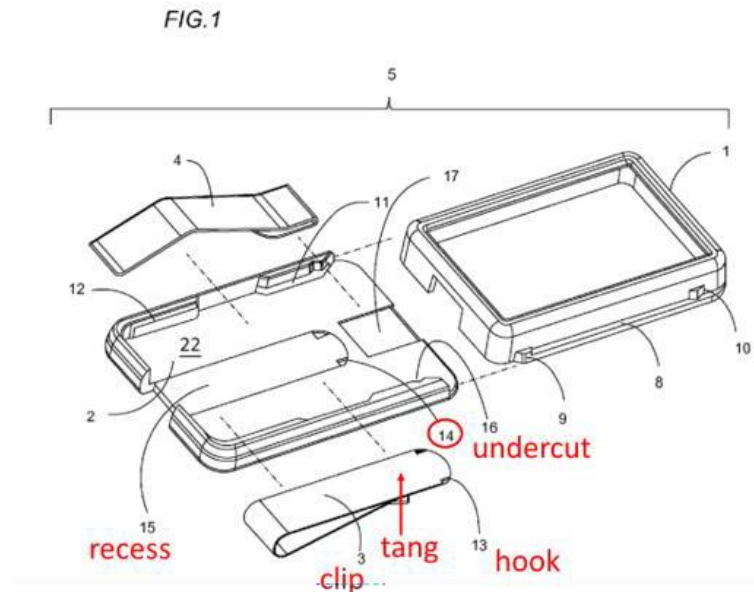
Kane contains this limitation. A groove in the rigid plate running along the length captures the elastic band. The band can stretch and contract and slide within the groove over the length of the band. As seen below, a first lamina of each rigid plate has a groove the width of the elastic band to capture the band without restricting the ability of the band to extend and contract over its entire length. This makes it easy to accommodate differing amounts of cards as seen in the series of images showing 1, 4, 7 and 10 cards.



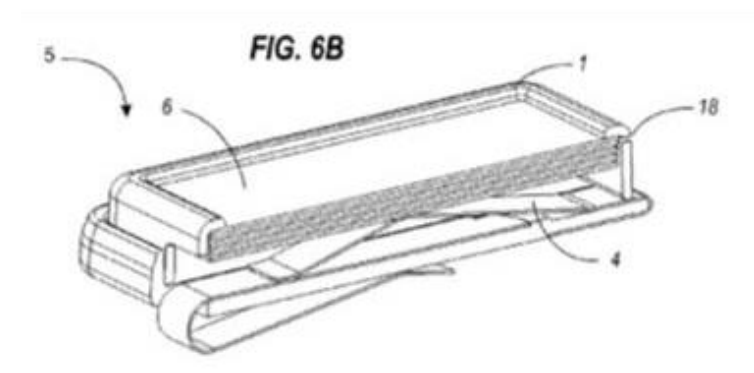
EX1004, pages 5,6.

- e. **Claim 1d:** an auxiliary feature removably attached to at least one of the at least two rigid plates, the auxiliary feature having a tang insertable into a recess formed inside the at least two rigid plates, the tang having a hook, the hook extending at an angle to the tang, the hook engaging an undercut of the recess to prevent inadvertent dislodgement of the auxiliary feature from the recess,

Beckley teaches such a removable auxiliary feature(clip 3) that is used with a compact wallet as shown below:



EX1008, FIG. 1, annotated.



EX1008, FIG. 6B.

“The clip **3** is assembled to the base **2** by inserting the clip **3** into a depression **15**. It is held in place by a pair of barbs seen at **13** mated into a set of cavities **14** on the base **2**.” Beckley, 4:30-40. According to Beckley's teaching, Depression **15** is the recess. The hook **13** that extends at an angle to the tang engages the undercut (cavities **14** or wall of

cavities **14**) to hold the clip in place and prevent inadvertent dislodgement of the clip **3** (auxiliary feature) from the recess.

Dr. Cameron opines that, “A POSITA knew of the desirability of removable clips on a compact wallet and would be motivated to incorporate the removable clip of Beckley into the compact wallet of Kane and could easily do so. The recess would be between the lamina of the rigid plate of Kane and the undercut would be in one of the lamina.” EX1015 page 5. As taught by Beckley, the use of Beckley’s arrangements/structures (auxiliary feature, tang, hook, recess, undercut) with the wallet of Kane would have merely been the predictable result of using the elements of Beckley according to their known function. In addition, To employ Beckley’s auxiliary feature with the wallet of Kane, a POSITA will also understand that it would have been obvious to form/arrange the recess of Beckley inside the at least two rigid plates of Kane’s wallet, because this provides one of a finite number² of possible locations to form/arrange the recess.

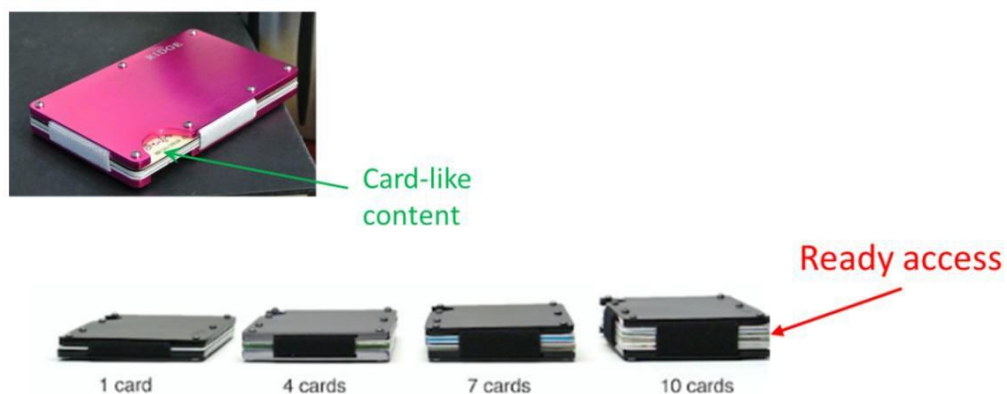
² “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). at 416. “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.” *Id.* at 421.

- f. **Claim 1e:** whereby, card-like contents may be carried with minimal silhouette on or with a person while allowing expandable capacity and ready access to individual contents from between the at least two rigid plates.

This limitation is shown in Kane. The expandable capacity is shown below with wallet holding an increasing number of cards. The silhouette is the size of a credit card.



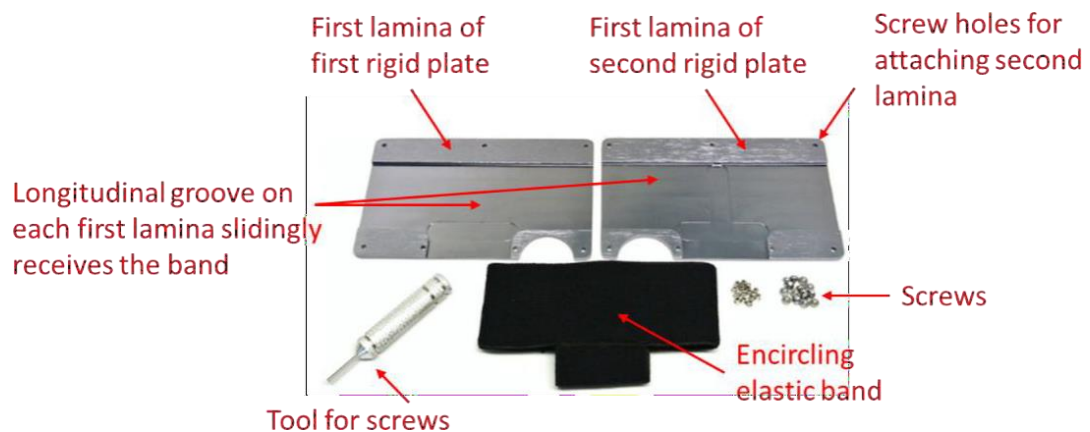
EX1004, page 4



EX1004, page 5, annotated.

2. **Claim 2:** The compact wallet of claim 1, wherein the channeling means is a longitudinal groove in a first lamina of a laminate construction of each rigid plate, the groove slidingly receiving one part of the at least one encircling elastic band.

The annotated picture below shows the channeling means is a groove along the length of the rigid plate in the first lamina. The second lamina (faceplate) is screwed to the first lamina in a laminate construction of the rigid plate. Both rigid plates have the same construction with the same longitudinal groove for slidingly receiving the encircling elastic band.

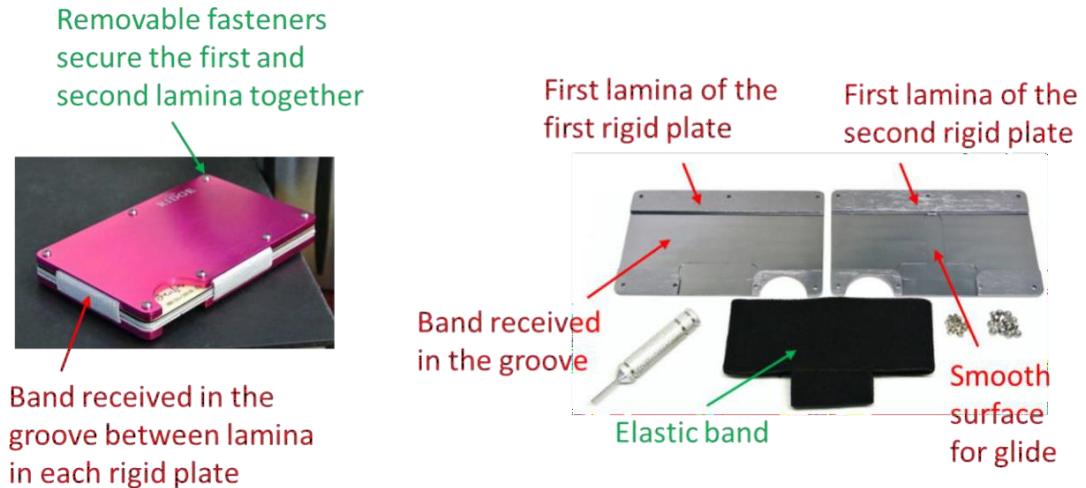


EX1004, pages 5-6, annotated.

3. **Claim 3:** The compact wallet of claim 2, wherein a second lamina of the laminate construction of each rigid plate is removably attached to the first lamina to hold the at least one elastic band in capture and provide a smooth surface for glide purposes.

Kane describes “interchangeable faceplates” that are joined by “custom hex screws” that allow the user to “swap materials and money clips.” EX1004, page 4. Faceplates are the second lamina and are removably attached to the first lamina with the custom hex screws. The groove (track) is located on the interior surface of the first lamina and the faceplate, and the elastic band is held between the laminae within the groove. As described by Kane, “the track runs along two hollow interior plates machined from anodized aircraft grade aluminum. The interior is hand-polished to prevent scratches and allow your cards to slide smoothly.” EX1004, page 5. The smooth aluminum surface of the track allows the band to glide.

Kane also explains that “[t]he interior plates have been . . . re-machined with threads for seven hex screws on either side that turn the wallet into a "system" that can be completely disassembled by the user to replace the elastic and exchange outer plates for greater personalization.” EX1004, page 4.



EX1004, pages 5-6, annotated.

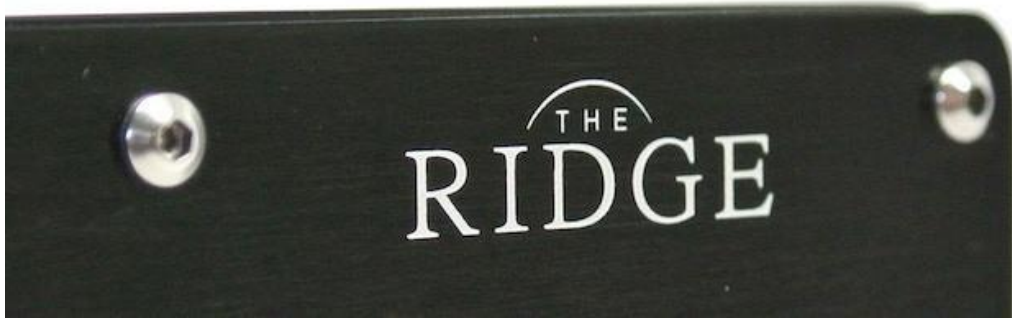
4. Claim 4: The compact wallet of claim 3, wherein the second lamina is attached to the first lamina by screws.

Kane describes “interchangeable faceplates” that are joined by “custom hex screws” that allow the user to “swap materials and money clips.” EX1004, page 4. The face plates have been removed in the image below. The laminas of each rigid plate are held together by seven screws.



EX1004, pages 5-6, annotated.

A zoomed in view of the hex screws is also shown in Kane.



EX1004, page 7, annotated.

5. **Claim 5:** The compact wallet of claim 3, wherein the second lamina is attached to the first lamina by pressure sensitive adhesive means.

While Kane uses custom hex screws to secure the faceplates, it would have been obvious to use pressure sensitive adhesive rather than screws as one of a limited number of options a POSITA would choose from to fasten the lamina of Kane together.

6. **Claim 6:** The compact wallet of claim 1, wherein each rigid plate is comprised of metal for RFID protection.

The plates of Kane are made of metal (aluminum) and provide RFID protection. As explained in Kane, “RFID blocking (wireless identity theft): Radio Frequency Identification is becoming an increasingly common feature on credit cards that allows the user to wirelessly "swipe" their card. However, the technology is inherently vulnerable as it lends itself to wireless identity theft. The Ridge’s aluminum interior plates block RFID, keeping your information safe.” EX1004, pages 7-8.

Kane further provides different RFID-blocking materials as options for the outer faceplates: “You can then choose between Titanium, Aluminum, or Carbon Fiber for the outer faceplates.” EX1004, page 6.

7. Claim 7: The compact wallet of claim 1, wherein each rigidplate is metalized for RFID protection.

It would have been obvious to use metalized plates instead of the metal plates of Kane as one of the well-known ways to provide RFID protection in a wallet.

Beckley also teaches using metalized plates for RFID protection: “Examples of suitable RFID shielding materials include metal-coated elastomers such as aluminized Mylar and copper-coated plastic sheets and films.” EX1008 6:6-10. A POSITA would know that a metallized plate is also rigid and protects against RFID signals and would be interchangeable with the plates of Kane. This could also have the benefit of weight savings.

8. Claim 8: The compact wallet of claim 3, wherein at least one of the first or second lamina of each rigid plate is comprised of metal.

This additional recitation is present in Kane, which explains that “[t]he track runs along two hollow interior plates machined from anodized aircraft grade aluminum.” EX1004, page 5.

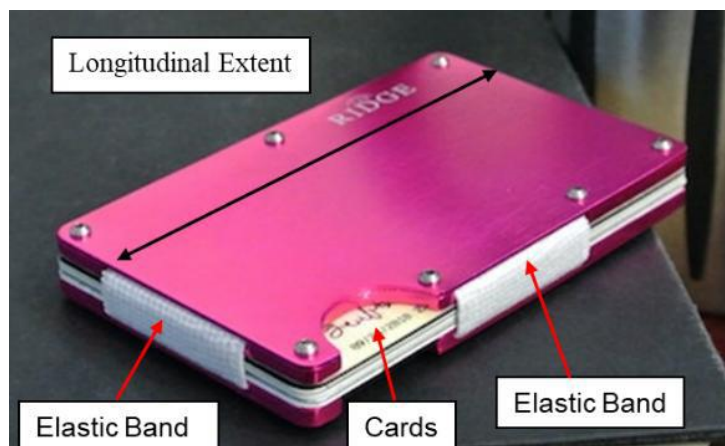
Each first lamina is aluminum (metal)



EX1004, page 5, annotated.

9. **Claim 9:** The compact wallet of claim 1, further comprising a first elastic strap positioned over the ends of the at least two rigid plates transverse to the longitudinal extents, the positioning functioning to retain the card-like contents from that end.

This additional recitation is present in Kane. It is unclear if “transverse to the longitudinal extents” modifies “ends” or “strap.” However, either way, this limitation is met. An elastic strap is positioned over both a short end and long end to retain cards, as shown in the annotated image.



EX1004, page 5, annotated.

10. **Claim 11:** The compact wallet of claim 1, wherein the card-like contents comprise one or more of a

credit card, a driver's license, an ID card, a business card, an affiliation card, a currency bill, a loyalty card, a coupon, a receipt or a personal paper.

This additional recitation is met in Kane. An ID card is shown in Kane and it would be obvious to put any one of those items in the wallet, as shown in the marked figured below.



Driver's license or
other ID card, etc.

EX1004, page 5, annotated.

11. **Claim 12:** The compact wallet of claim 1, further comprising aligned finger notches through proximal ends of the rigid plates to expose an edge of the card-like contents for the purpose of pushing the edge to elevate the contents into view through distal ends of the rigid plates, said edge providing a fulcrum to lever the proximal ends together for the purpose of fanning the distal ends apart in display of the contents.

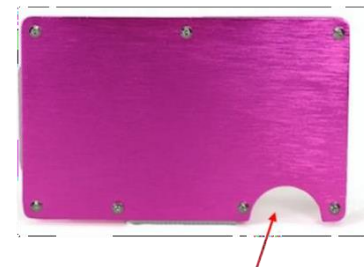
This additional recitation is present in Kane. Finger notches through the proximal ends of the rigid plates expose an edge of the cards for the

purpose of pushing the edge to elevate the contents into view and provide a fulcrum to lever the proximal ends.

Kane explains that “[t]he thumb indentation at the lower left of the wallet allows you to easily push your cards up and select the correct one.” EX1004, page 7.

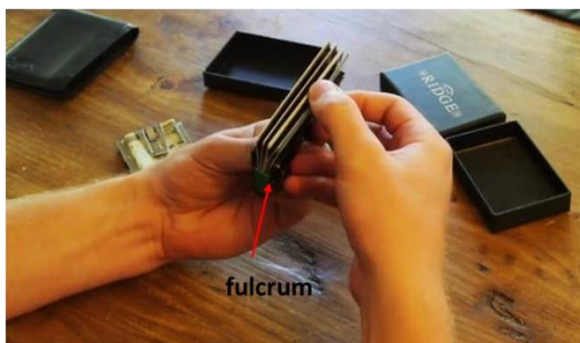
Kane also demonstrates this limitation in the marketing video as shown in the video frames below. This can be viewed in real time by visiting the aforementioned website about Kane.

1:44 still frame from video



Aligned finger notches

1:45 still frame from video



EX1004, page 3, annotated.

12. **Claim 13:** The compact wallet of claim 1, wherein the encircling elastic band is comprised of woven elastic fabric.

The images below showing a woven elastic band illustrate that this additional recitation is present in Kane.



EX1004, page 5.

Kane describes the band as elastic and explains how it can be replaced: “The Integrated Elastic Track can expand to hold up to 12 cards and then immediately contract to hold a single card securely. And should the elastic ever wear out, you can easily replace it.” EX1004, page 5.



EX1004, page 5, annotated.

Even if the woven elastic band were not visible in the images, it would have been obvious to make the elastic band from woven elastic fabric as known by a person of ordinary skill in the art. EX1015, page 15.

13. Claim 14

a. Claim 14pre: A compact wallet, comprising

While the preamble is not necessarily limiting, Kane is a compact wallet. See **Ground 1A, Claim 1pre**.

b. Claim 14a: at least two rigid plates interposed to sandwich card-like contents there between, each rigid plate having a groove along a longitudinal extent thereof;

Kane teaches such two rigid plates and a groove along a longitudinal extent thereof. See **Ground 1A, Claims 1a, 2**.

c. Claim 14b: at least one encircling elastic band slidingly interposed in the grooves to bias the at least two rigid plates inwardly and securely hold the card-like contents while providing elastic volume there between for adding or removing contents, the grooves configured to hold position of the at least one encircling elastic band with respect to each rigid plate while allowing freedom for the dynamic extension and contraction of the band over the entire running length thereof; and

Kane teaches all these limitations. See **Ground 1A, Claims 1b-1c, 2**.

d. Claim 14c: a recess formed inside at least one of the at least two rigid plates, the recess operable to receive a tang of an auxiliary feature, the recess having an undercut operable to engage a hook of the tang to prevent inadvertent dislodgement of the auxiliary feature from the recess when the auxiliary feature is removably positioned in at least one of the at least two rigid plates, the hook extending at an angle to the tang,

Beckley teaches these arrangements (auxiliary feature, tang, hook, recess, undercut), which can prevent inadvertent dislodgement of the auxiliary feature from the recess. See **Ground 1A, Claim 1d**.

e. Claim 14d: whereby, card-like contents may be carried with minimal silhouette on or with a person while allowing expandable capacity and ready access to individual contents from between the at least two rigid plates.

Kane teaches these limitations, see **Ground 1A, Claim 1e**.

14. Claim 15: The compact wallet of claim 14, wherein the groove is in a first lamina of a laminate construction of each rigid plate, the groove slidingly receiving one part of the at least one encircling elastic band.

Kane further disclosed these additional recitations, see **Ground 1A, Claim 2**.

15. Claim 16: The compact wallet of claim 15, wherein a second lamina of the laminate construction of each rigid plate is removably attached to the first lamina to capture the at least one elastic band and provide a smooth surface for glide.

Kane further disclosed this additional recitation as discussed above, see **Ground 1A, Claim 3**.

16. Claim 17: The compact wallet of claim 16, wherein the second lamina is attached to the first lamina by screws.

Kane further disclosed this additional recitation, see **Ground 1A, Claim 4**.

17. Claim 18: The compact wallet of claim 1, wherein each rigid plate is comprised of metal for RFID protection.

Kane further disclosed this additional recitation, see **Ground 1A**,
Claim 6.

18 Claim 19

a. Claim 19pre: A method of making a modular compact wallet, comprising the steps:

Kane disclosed this limitation of *Claim 19pre*, see **Ground 1A**, *Claims 1pre, 14pre*.

b. Claim 19a: providing at least two rigid plates interposed to sandwich card-like contents there between, each rigid plate having a groove along a longitudinal extent thereof;

Kane disclosed the limitations of *Claim 19a*, see **Ground 1A**, *Claim 14a*.

c. Claim 19b: at least one encircling elastic band slidingly interposed in the grooves to bias the at least two rigid plates inwardly and securely hold the card-like contents while providing elastic volume there between for adding or removing contents, the grooves configured to hold position of the at least one encircling elastic band with respect to each rigid plate while allowing freedom for the dynamic extension and contraction of the band over the entire running length thereof,

Kane disclosed these limitations of *Claim 19b*, see **Ground 1A**, *Claim 14b*.

d. Claim 19c: at least one groove additionally having at least one recess positioned outbound of the elastic band;

Kane disclosed the groove, see **Ground 1A**, *claim 2*, and Beckley disclosed the recess, see **Ground 1A**, *claim 1d*. Dr. Cameron opines: “This limitation is obvious over the discussed combination with the clip of

Beckley as it would be obvious to position the barbs of Beckley outbound of the elastic band to reduce the depth of the groove and improve the structural rigidity of the plate.” EX1015 page 27. Besides, a POSITA will also understand that the outboard positioning of Beckley’s recess provides one of a limited number of possible locations to form/arrange the recess.

e. Claim 19d: providing a first auxiliary feature having at least one tang;

The combination of Kane and Beckley disclosed this limitation of Claim 19d, see **Ground 1A**, Claims 1d, 14c.

f. Claim 19e: inserting, removably, the at least one tang of the first auxiliary feature into the at least one recess to make the first auxiliary feature available at an outside face of at least one of the two rigid plates;

The combination of Kane and Beckley disclosed this limitation of Claim 19e, see **Ground 1A**, Claims 1d, 14c. Dr. Cameron also opines, “In the combinations discussed (with either Beckley, Roman or Murphy) the clip is available at an outside face of one of the rigid plates.” EX1015, page 27. And for a POSITA, making clip available at an outside face of rigid plates is just a limited and predictable results when removably inserting a tang of the clip into a recess and was known to be convenient and desirable location for the clip.

g. Claim 19f: removing, selectively, the first auxiliary feature;

The combination of Kane and Beckley disclosed this limitation of Claim 19f, see **Ground 1A**, Claims 1d, 14c.

h. Claim 19g: providing, selectively, at least a second auxiliary feature having at least one tang; and inserting, removably, the at least one tang of the second auxiliary feature into the at least one recess to make the second auxiliary feature available at an outside face of at least one of the two rigid plates, the at least one recess having an undercut operable to engage a hook of the tang to prevent inadvertent dislodgement of the second auxiliary feature from the at least one recess, the hook extending at an angle to the tang, the at least one recess receiving the tang being disposed inside at least one of the two rigid plates;

The combination of Kane and Beckley disclosed the limitations of Claim 19g, see **Ground 1A**, Claims 1d, 14c. Dr. Cameron also opines, “For each of the combinations discussed, it would be obvious to include a second clip arranged the same way as the first but on the opposite rigid plate.” EX1015, page 28.

i. Claim 19h: whereby, card-like contents may be carried with minimal silhouette on or with a person while allowing expandable capacity and ready access to individual contents positioned interiorly to the at least two rigid plates and proving additional functionality from at least one auxiliary feature positioned exteriorly thereto.

Kane disclosed the limitations of Claim 19h, see **Ground 1A**, Claims 1e, 14d.

19. Claim 20: The method of claim 19, wherein the at least one recess has an undercut and the at least one tang has a hook, the hook and undercut interpositioned to secure the at least one auxiliary feature against inadvertent dislodgement.

The combination of Kane and Beckley disclosed these additional recitations, see **Ground 1A, Claims 1d, 14c**. Dr. Cameron also opines, “In each combination the hook and undercut are interpositioned to secure the tang.” EX1015, page 29.

20. Claim 21: The method of claim 20, wherein at least one of the auxiliary features is a money clip.

Beckley disclosed this additional recitation. See **Ground 1A, Claim 1d, 14c**. The clip in Beckley is already a money clip and it would have been obvious to a POSITA to implement a money clip because a money clip was a desirable often implemented feature of a compact wallet.

21. Claim 22: The method of claim 19, wherein the groove is in a first lamina of a laminate construction of each rigid plate and the at least one recess is in at least one of the first lamina.

The combination of Kane and Beckley disclosed these additional recitations as discussed above. See **Ground 1A, Claims 1d, 2, 14c and 15**.

22. Claim 23: The method of claim 22, wherein a second lamina of the laminate construction of each rigid plate captures the at least one elastic band and the at least one tang when removably attached to the first lamina and facilitates placement and removal of the at least one elastic band and the at least one tang when removed from the first lamina.

The combination of Kane and Beckley disclosed these additional recitations. See **Ground 1A, Claims 1d, 3, 14c and 16**. Dr. Cameron also explained: “As discussed, for all the combinations, a second lamina captures the band. The tang is placed similar to shown in Figure 1 and 6B

of Beckley. The band is lined up and placed on top of the tang in the groove and then the second lamina is attached.” EX1015 page 32.

23. Claim 24: The method of claim 23, wherein the second lamina is attached to the first lamina by screws.

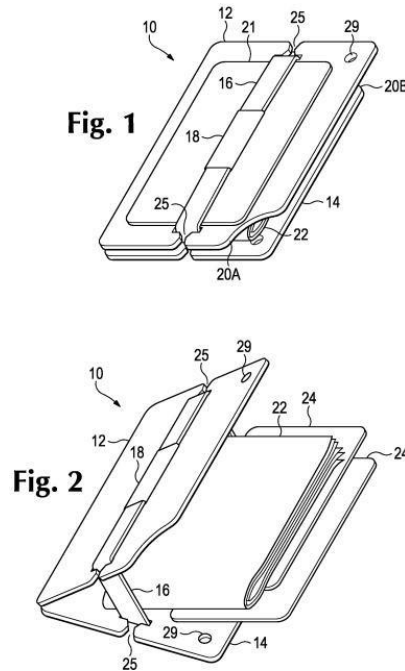
Kane disclosed this additional recitation, see **Ground 1A**, Claims 4, 17.

Ground 1B: Claim 10 is unpatentable under 35 U.S.C. § 103 over Kane in view of Beckley in further view of Minn.

1. Claim 10: The compact wallet of claim 1, further comprising a second elastic strap positioned over an outside surface of one of the at least two rigid plates to hold additional contents on the outside surface.

Kane and Beckley have disclosed claim 1. See **Ground 1A**, claim 1. Minn further disclosed an elastic strap positioned over an outside surface. A POSITA would have found it obvious to incorporate a second elastic strap over the outside of one of the rigid plates to hold additional contents as shown in Fig. 1 and Fig. 2 of Minn.

The strap could simply be fixed to the outside of the rigid plate. “Personal items, such as paper money 22, credit cards 24, driver's license, identification cards, membership cards, business cards, or the like, or any combination thereof may be compressively held in-between plates 12 and 14 or may be held outside of either plate 12 or 14.” Minn 2:21-25.



EX1005, Figs. 1-2.

Ground 1C: Claim 13 is unpatentable under 35 U.S.C. § 103 over Kane in view of Beckley in further view of Preston-Hall.

1. Claim 13: The compact wallet of claim 1, wherein the encircling elastic band is comprised of woven elastic fabric.

Kane and Beckley have disclosed claim 1. See **Ground 1A, claim 1**.

The images below showing a woven elastic band illustrate that this limitation is present in Kane.



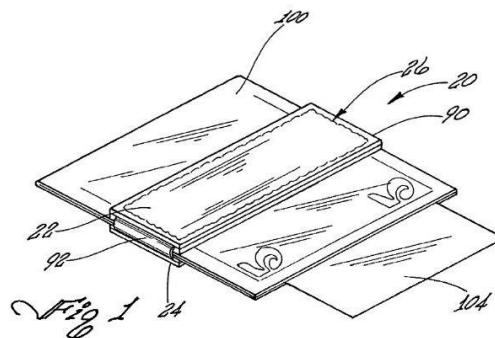
EX1004, page 5.

Kane describes the band as elastic and explains how it can be replaced:
“Integrated Elastic Track can expand to hold up to **12** cards and then immediately contract to hold a single card securely. And should the elastic ever wear out, you can easily replace it.” EX1004, page 5.



EX1004, pages 5-6, annotated.

Preston Hall discloses a kind of woven band (loop) which is used in a card and currency carrying device: “The first pair of planar support members **50** and **54** and a second pair of planar support members **70** and **76** are operatively connected on to each side of and enclosing the other of the pair of spaced, deflectable spring members **28** and **30** and includes an endless loop **90** of a **woven**, longitudinally extendable, elastic fabric material.” EX1010 at 11:15-18.



EX1010, Fig 1

Note:

To ensure conciseness, the detailed elements of each claim will not be explicitly wrote in the subsequent discussion. However, the detailed elements of each claim can still be found in EX1007 or found in the previous discussion, EX1007 provides a comprehensive listing of the claim elements of the '808 patent.

Ground 1D: Claims 1-9, and 11-24 are unpatentable under 35 U.S.C. § 103 over Kane in view of Murphy.

1. Claim 1

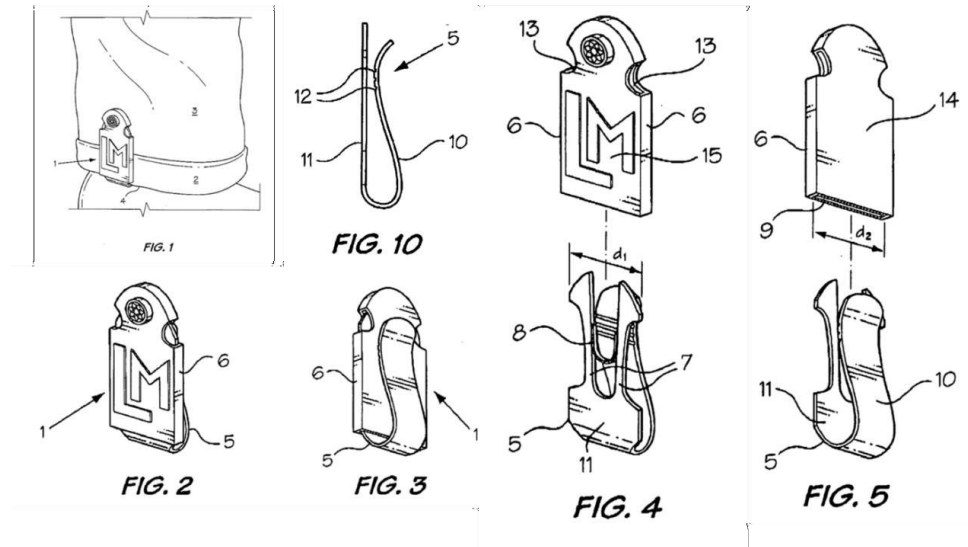
a. Claims 1pre-1c, 1e

Kane disclosed all limitations of claims 1pre-1c,1e, See above

Ground 1A, Claims 1pre-1c, and 1e.

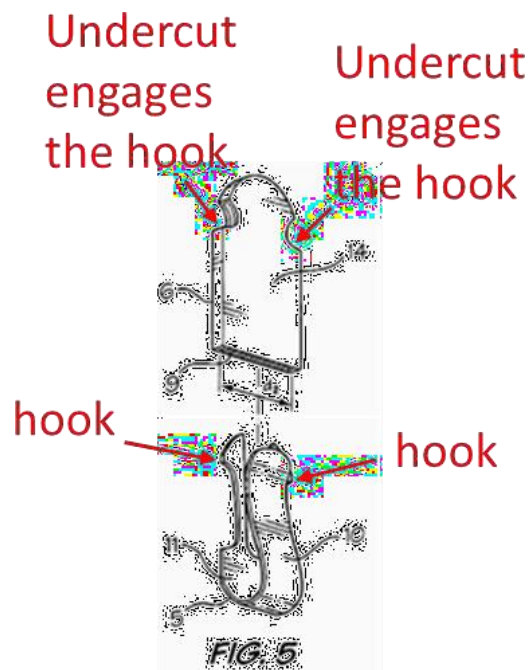
b. Claim 1d

Murphy discloses these elements of Claim 1d. Murphy discloses a sleeve (6) that “may be provided separately from the clip-member (5). The sleeve typically will have an interior face portion (14), a display portion as illustrated by exterior face portion (15), an open bottom end, and define a cavity (9) therein, the cavity (9) having a geometry and depth sufficient to firmly contain the interior clip portion (11) of the clip-member (5). In order to coordinate with the arrow-shaped securement members (7) of the clip-member (5), the sleeve has two recessed openings formed on sides thereof.” EX1006, [0054]. See below:



EX1006. Figs. 1-5, Fig 10

See from Murphy, there is a auxiliary feature (clip-member 5) using a tang (interior clip portion 11) with a hook (tip of the arrow-shaped securement members 7) at an angle to engage an undercut of a recess (cavity 9) , annotated as follows:



EX1006, FIG. 5

Murphy teaches that this removable clip-member 5 is used in a garment clip, but can also be used as a money clip. *See* EX1006 [0060]. Dr. Cameron also opines: “A POSITA would be motivated to incorporate a removable clip such as that of Murphy into the compact wallet of Kane. The recess would be between the two lamina and the undercut would be placed in one of the lamina..” EX1015, page 7.

The use of Murphy’s arrangements(clip,tang, hook, recess, undercut) with the wallet of Kane would have merely been the predictable result of using the elements of Murphy according to their known function. In addition, it would have been obvious to form/arrange the recess of Murphy inside the at least two rigid plates of Kane's wallet, because this provides one of a finite number of possible locations to form/arrange the recess.

2. Claims 2- 9

Kane disclosed all additional recitations of Claims 2-9. *See Ground 1A, Claims 2-9.*

3. Claims 11-13

Kane disclosed all additional recitations of Claims 11-13. *See Ground 1A, Claims 11-13.*

4. Claim 14

a. Claims 14pre-14b, 14d

Kane disclosed all these limitations of Claims 14pre-14b, 14d. See **Ground 1A**, Claims 14pre-14b, 14d.

b. Claim 14c

Murphy discloses these limitations of claim 14c. See **Ground 1D**, Claim 1d. A POSITA would know of the desirability of removable clips on a compact wallet and would be motivated to incorporate the removable clip of Murphy into one of the rigid plates of Kane.

5. Claims 15-18

Kane disclosed these additional recitations. See **Ground 1A**, Claims 15-18; also see **Ground 1D**, Claims 2-4,6.

6. Claim 19

a. Claims 19pre-19b

Kane disclosed these limitations of Claims 19pre-19b. See **Ground 1A**, Claims 19pre-19b.

b. Claim 19c

Kane disclosed the groove, see **Ground 1A**, claim 2, and Murphy disclosed the recess, see **Ground 1D**, claim 1d. Dr. Cameron opines, “to the extent outbound means outside of the elastic band, this limitation is present in the obviousness combination discussed with the clip of Murphy incorporated. The recess to receive the hook of the tang of Murphy is positioned outbound of the elastic band as the width of the tang minus the

hook of Murphy matches the width of the groove (which prevents side to side motion of the clip). ” See EX1015, page 26.

Besides, a POSITA will also understand that there are a finite number of locations to position/arrange the recess of Murphy for preventing interference with the free operation of the elastic band, that is, outboard positioning of Murphy’s recess provides one of a limited number of possible locations to form/arrange the recess.

c. Claim 19d

Murphy disclosed this limitation of Claim 19d. See **Ground 1D**, Claims 1d, 14c.

d. Claim 19e

The combination of Kane and Murphy disclosed this limitation of *Claim 19e*, see **Ground 1D**, *Claims 1d,14c*. Dr. Cameron also opines: “In the combinations discussed (with either Roman or Murphy) the clip is available at an outside face of one of the rigid plates.” EX1015 page 27. And for a POSITA, making clip available at an outside face of rigid plates is just a limited and predictable results when removably inserting a tang of the clip into a recess as taught by Murphy.

e. Claims 19f-19g

The combination of Kane and Murphy disclosed these limitations of *Claims 19f-19g*, see **Ground 1D**, *Claims 1d ,14c*. Dr. Cameron also opines: “For each of the combinations discussed, it would be obvious to include a

second clip arranged the same way as the first but on the opposite rigid plate.” EX1015 page 28.

f. Claims 19h

Kane disclosed this limitation of *Claim 19h*. See **Ground 1D**, Claims 1e, 14d.

7. Claim 20

The combination of Kane and Murphy disclosed this additional recitation of claim 20. See **Ground 1D**, Claims 1d, 14c.

8. Claim 21

Murphy disclosed this additional recitation of claim 21. See **Ground 1D**, Claims 1d, 14c.

9. Claim 22

The combination of Kane and Murphy disclosed this additional recitation, See **Ground 1D**, Claims 1d, 2, 14c and 15.

10. Claims 23

The combination of Kane and Murphy disclosed this additional recitation of claim 23, See **Ground 1D**, Claims 1d, 3, 14c and 16.

11. Claims 24

Kane disclosed this additional recitation of claim 24. See **Ground 1D**, Claims 4, 17.

Ground 1E: Claim 10 is unpatentable under 35 U.S.C. § 103 over Kane in view of Murphy in further view of Minn.

1. Claim 10

Kane and Murphy have disclosed claim 1, *see* **Ground 1D**, claim 1. Minn further discloses a elastic strap positioned over an outside surface. As Dr. Cameron also opines: “Adding a second elastic strap outside of the plates of Kane as done in Minn would have been obvious.” *See EX1015 page 13.*

Ground 1F: Claim 13 is unpatentable under 35 U.S.C. § 103 over Kane in view of Murphy in further view of Preston-Hall.

1. Claim 13

Kane and Murphy have disclosed claim 1. *See* Ground 1D, claim 1. Kane shows a woven elastic fabric for the band but to the extent it is argued that it does not. Preston-Hall further discloses a kind of woven elastic fabric. Similar analysis can also be found in Ground 1A, claim 13.

Ground 1G: Claims 1-9 and 11-24 are unpatentable under 35 U.S.C. § 103 over Kane in view of Roman.

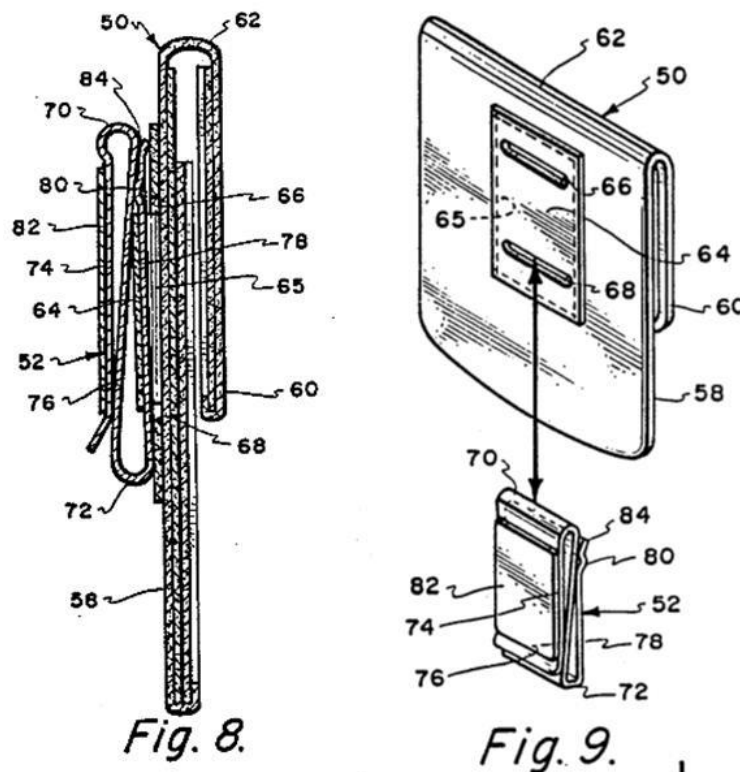
1. Claim 1

a. Claims 1pre-1c, 1e

Kane disclosed all limitations of claims 1pre-1c,1e. *See* **Ground 1A**, Claims 1pre-1c, and 1e.

b. Claim 1d

Roman disclosed these limitations, Roman disclosed a kind of removably attached money clip, as shown in Fig. 9 from Roman.



EX1012, Figs. 8-9

As explained in Roman, an “object of the present invention is to provide a wallet, or device for carrying money and other valuables which has a removable clip which can be used in a normal fashion as a money clip, but also can be used to attach to the wallet to carry it in a concealed fashion. Still another object of the present invention is to provide a unique wallet having a removable clip which is small and compact for carrying money and credit cards which and is easily accessible without removal from the clipped position.” EX1012, 1:54-64. In particular, Roman states that “backplate **78** [tang] has a dimpled rib **80** providing a bight [hook] against middleplate **76** to help retain the clip [auxiliary

feature] in the pocket **65** [recess] formed by slot **66** [undercut] and **68**,”
EX1012, 4:14-17.

Dr. Cameron opines that “A POSITA knew of the desirability of removable clips on a compact wallet as taught by Roman and would be motivated to incorporate the removable clip of Roman into the compact wallet of Kane and could easily do so. The recess would be between the two lamina of the rigid plate of Kane and the undercut would be in one of the lamina.” EX1015, page 6.

In addition, a POSITA will also understand that it would have been obvious to form/arrange the recess of Roman inside the at least two rigid plates of Kane's wallet, because this provides one of a finite number of possible locations to form/arrange the recess.

2. Claims 2-9, 11-13

Kane disclosed all additional recitations of Claims 2-9, 11-13. See **Ground 1A**, Claims 2-9,11-13; also see **Ground 1D**, Claims 2-9,11-13.

3. Claim 14

a. Claims 14pre-14b, 14d

Kane disclosed the limitations of Claims 14pre-14b,14d. See **Ground 1A**, Claims 14pre-14b,14d.

b. Claim 14c

Roman discloses these limitations of claim 14c, which can prevent inadvertent dislodgement of the auxiliary feature from recess. See **Ground 1G**, Claim 1d. Dr.

4. Claims 15-18

Kane disclosed these additional recitations of Claims 15-18, See **Ground 1A**, Claims 15-18.

5. Claim 19

a. Claims 19pre-19b

Kane disclosed these limitations of Claims 19pre-19b. See **Ground 1A**, Claims 19pre-19b.

b. Claim 19c

Kane disclosed the groove, see **Ground 1A**, claim 2, and Roman disclosed the recess, see **Ground 1G**, claim 1d. Dr. Cameron explained that “[t]his limitation is obvious over the discussed combination with the clip of Roman as it would be desirable to place the hook/dimpled rib of Roman outbound of the elastic band as is common to reduce the overall depth.” EX1015, page 28. Besides, a POSITA will also understand that there are a finite number of locations to position/arrange the recess of Roman for preventing interference with the free operation of the elastic band, that is, outboard positioning of Roman’s recess provides one of a limited number of possible locations to form/arrange the recess.

c. Claim 19d

Roman disclosed this limitation of Claim 19d. See **Ground 1G**, Claims 1d, 14c.

*d. **Claim 19e***

The combination of Kane and Roman disclosed this limitation of Claim 19e. See **Ground 1G**, Claims 1d, 14c. Dr. Cameron also opines: “In the combinations discussed (with either Roman or Murphy) the clip is available at an outside face of one of the rigid plates.” EX1015 page 27. And for a POSITA, making the clip available at an outside face of rigid plates is just a limited and predictable results when removably inserting a tang of the clip into a recess as taught by Roman.

*e. **Claims 19f-19g***

The combination of Kane and Roman disclosed these limitations of Claims 19f-19g, see **Ground 1G**, Claims 1d ,14c. Dr. Cameron also opines, “For each of the combinations discussed, it would be obvious to include a second clip arranged the same way as the first but on the opposite rigid plate.” EX1015 page 28.

*f. **Claims 19h***

Kane disclosed this limitation of Claim 19h, see **Ground 1A**, Claims 1e,14d.

*6. **Claim 20***

The combination of Kane and Roman disclosed this additional recitation of claim 20. See **Ground 1G**, Claims 1d, 14c.

*7. **Claim 21***

Roman disclosed this additional recitation of claim 21. See **Ground 1G**, Claims 1d ,14c.

8. Claim 22

The combination of Kane and Roman disclosed this additional recitation of claim 22. See **Ground 1G**, Claims 1d, 2, 14c and 15.

9. Claims 23

The combination of Kane and Roman disclosed this additional recitation of claim 23, see **Ground 1G**, Claims 1d, 3, 14c,16.

10. Claims 24

Kane disclosed this additional recitation of claim 24, see **Ground 1A**, Claims 4, 17.

Ground 1H: Claim 10 is unpatentable under 35 U.S.C. § 103 over Kane in view of Roman in further view of Minn.

1. Claim 10

Kane and Roman have disclosed claim 1. See **Ground 1G**, claim 1. And Minn further discloses such an elastic strap positioned over an outside surface. Dr. Cameron also opines: “Adding a second elastic strap outside of the plates of Kane as done in Minn would have been obvious.” EX1015 page 12.

Ground 1I: Claim 13 is unpatentable under 35 U.S.C. § 103 over Kane in view of Roman in further view of Preston-Hall.

1. Claim 13

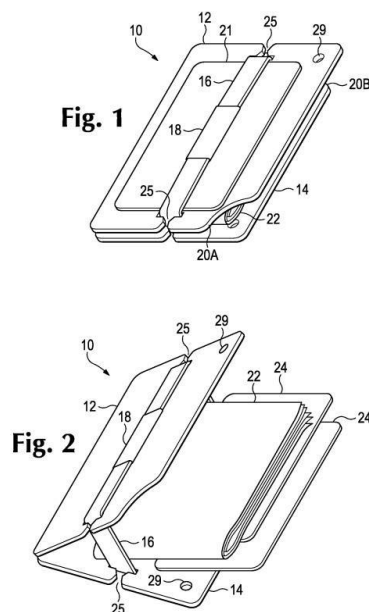
Kane and Roman have disclosed claim 1. Ground 1G, claim 1. Kane shows a woven elastic fabric for the band but to the extent it is argued that it does not, Preston-Hall further discloses a kind of woven elastic fabric, it would have been obvious to make the encircling elastic band comprised of woven elastic fabric either in view of the knowledge of a POSITA or Preston-Hall.

Ground 2A: Claims 1-24 are unpatentable under 35 U.S.C. § 103 over Minn in view of Podwika in further view of Coates in further view of Beckley.

1. Claim 1

a. Claim 1pre

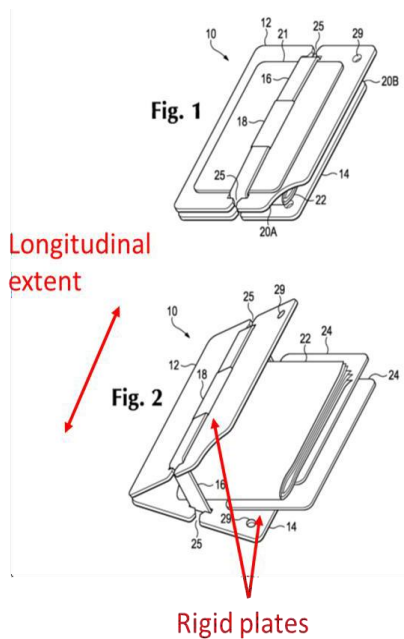
While the preamble is not necessarily limiting, Minn discloses a compact wallet, as shown in Figures 1 and 2.



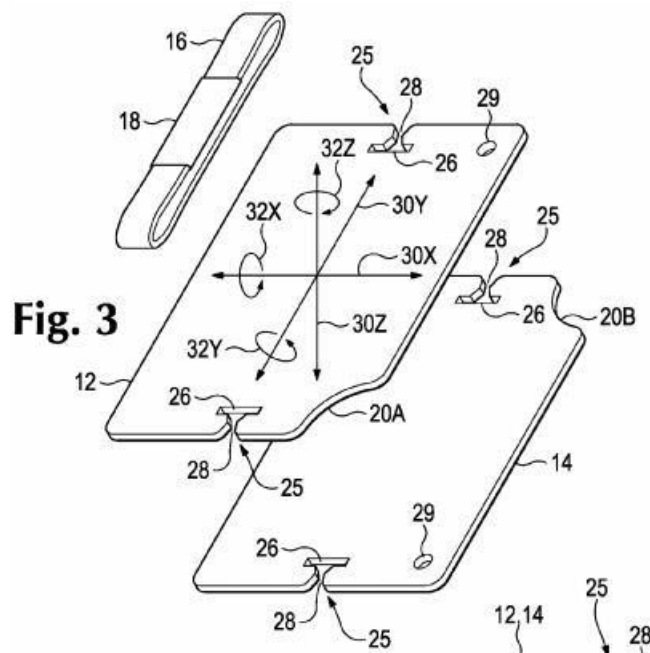
EX1005, Figs. 1-2

b. Claim 1a

Minn contains this limitation. Minn discloses two rigid plates with longitudinal extents to sandwich card-like contents, as illustrated in annotated Fig. 1, annotated Fig. 2 and Fig. 3.



EX1005,Figs. 1-2, annotated

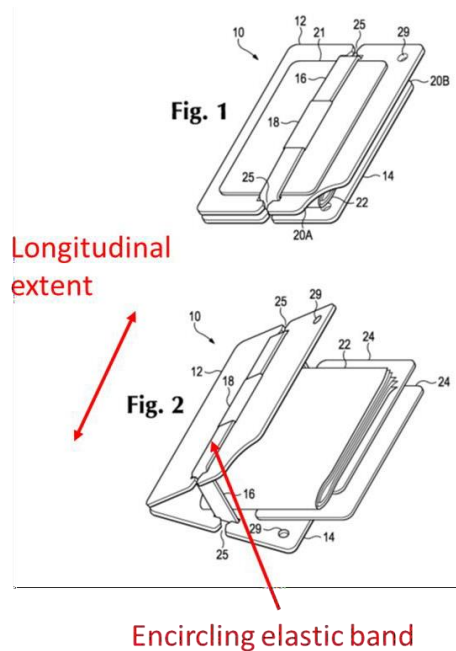


EX1005, Fig. 3

Minn describes a low-profile wallet **10** that “comprises two metal and/or carbon fiber plates **12** and **14** held together with an elastic strap **16**. Personal items, such as paper money **22**, credit cards **24**, driver's license, identification cards, membership cards, business cards, or the like, or any combination thereof maybe compressively held in-between plates **12** and **14**.” EX1005, 2:19-25.

c. Claim 1b

Minn discloses this limitation, as shown in annotated Figs. 1 and 2 and detailed in the description of EX1005.



EX1005, Figs., 1-2, annotated

As noted above, Minn describes a low-profile wallet **10** that comprises two metal and/or carbon fiber plates **12** and **14** (rigid plates) held together with an elastic strap **16** (encircling elastic band). Personal items, such as paper money **22**, credit cards **24**, driver's license,

identification cards, membership cards, business cards, or the like, or any combination thereof maybe compressively held in-between plates **12** and

14. EX1005, 2:19-25.

d. Claim 1c

Podwika discloses a channeling means (recess 26) or groove (recess 26), Podwika's groove is shown below in FIG. 1 and 3 of Podwika.

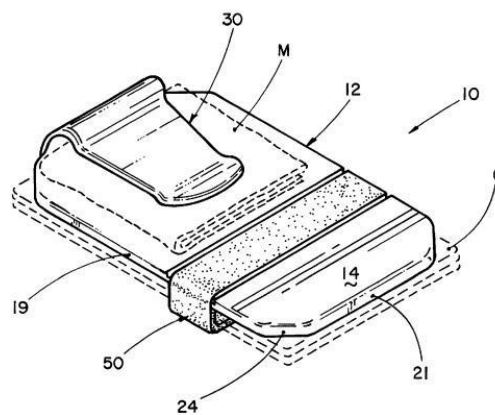
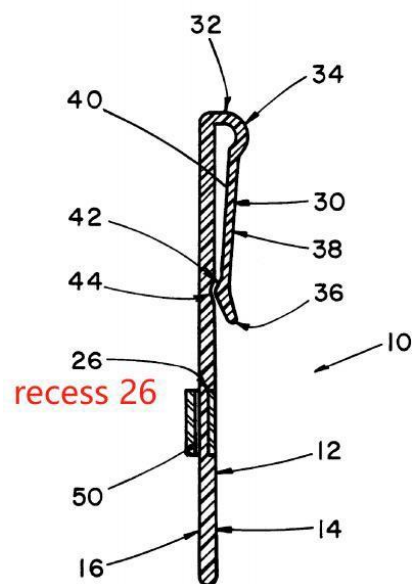


FIG. 1

EX1009, FIG.1

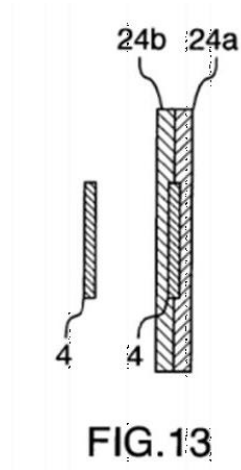


EX1009, FIG.3

Dr. Cameron opines: “Minn modified with the groove of Podwika discloses a channeling means. FIG. 1 of Podwika illustrates that the longitudinal elastic band of Minn can be captured by a longitudinal groove in each plate instead of by slots **25** and notches **28** taught in Minn. This would be desirable to minimize the profile of the wallet. Like Minn and Podwika, the combination of Minn and Podwika also allows freedom for the dynamic extension and contraction of the band over the entire running length.” EX1016, page 6.

As explained in Podwika, “the recess **26** is sized and configured to receive a portion of an elastic retaining band **50**. The elastic retaining band **50** is formed into a continuous loop that encircles the base **12**.” EX1009,4:21-23. Dr. Cameron further opines: “A POSITA would be motivated to utilize this recess over the longitudinal extent of the rigid plates of Minn in place of slots **25** and notches **28** of Minn.” EX1016, page 6.

Furthermore, Coates also discloses a way to help minimize the profile of the wallet, based on Coates, instead of being exposed, the groove could be made between two lamina to protect the band as seen in Figure 13 of EX1011, where **24a** and **24b** are the lamina of the rigid plate and 4 is the elastic band:

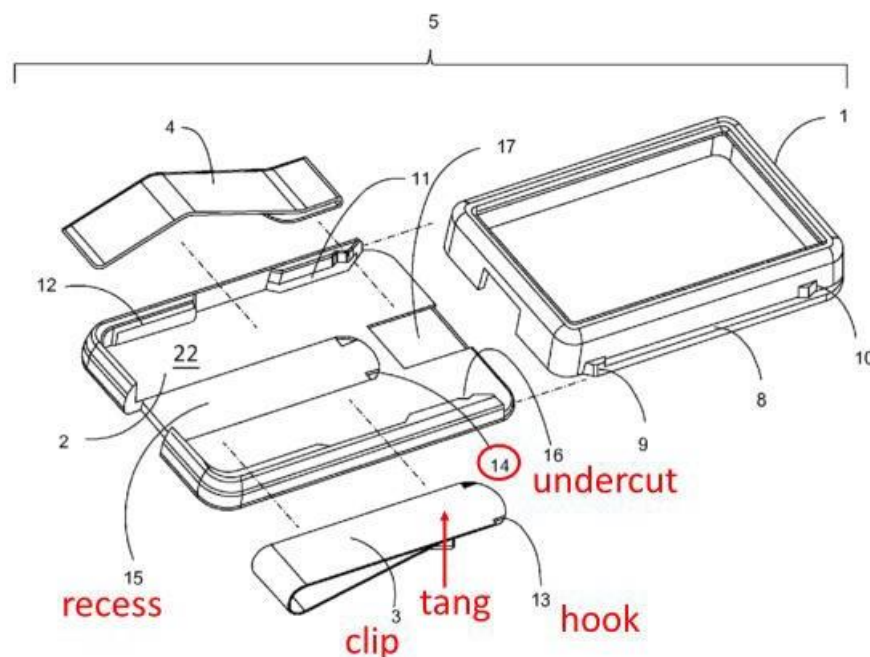


EX1011, FIG. 13

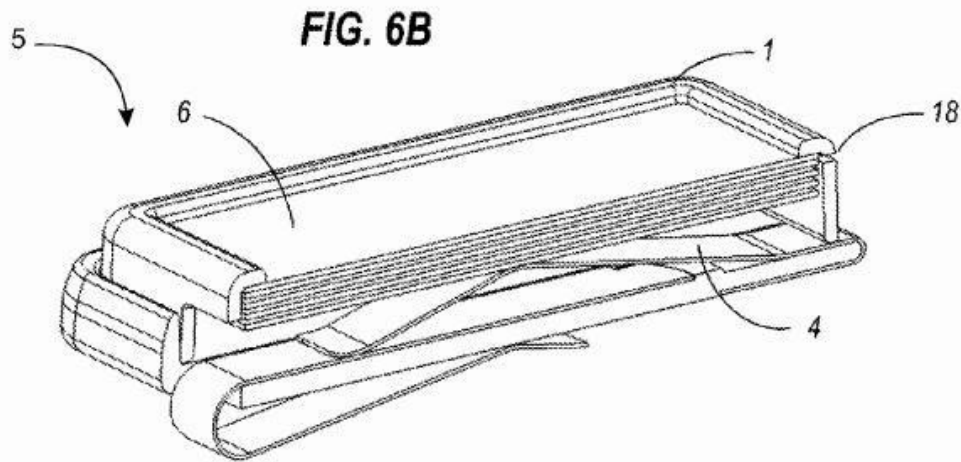
For a POSITA, Using Coates and Podwika to modify Minn to meet the limitation of *claim 1c* would have merely been the predictable result of using the elements of Coates and Podwika according to their known function.

e. Claim 1d

Beckley discloses a removable clip (auxiliary feature) that is used with a compact wallet as shown in Figure 1 and 6B below.



EX1008, FIG. 1 annotated



EX1008, Fig, 6B,annotated

Beckley states: “The clip **3** is assembled to the base **2** by inserting the clip **3** into a depression **15**. It is held in place by a pair of barbs seen at **13** mated into a set of cavities **14** on the base **2**.” EX1008, 4:30-40. *In Beckley*, Depression 15 is the recess. The hook(barbs) that extends at an angle to the tang engages the undercut (**14** or wall of **14**) to hold the clip in place and prevent inadvertent dislodgement of the clip **3** (auxiliary feature) from the recess.

Dr. Cameron opines:“A POSITA knew of the desirability of removable clips on a compact wallet and would be motivated to incorporate the removable clip of Beckley into the compact wallet (and this would be an additional reason to use screws rather than glue or welding to attach the lamina together in addition to being able to replace the outer lamina and or band) and could easily do so. The recess would be between

the lamina of the rigid plate of the modified wallet of Minn and the undercut would be in one of the lamina.” EX1016 page 8.

A POSITA will also understand that it would have been obvious to form/arrange the Beckley’s recess inside the at least two rigid plates of Minn's wallet, because this provides one of a finite number of possible locations to form/arrange the recess.

f. Claim 1e

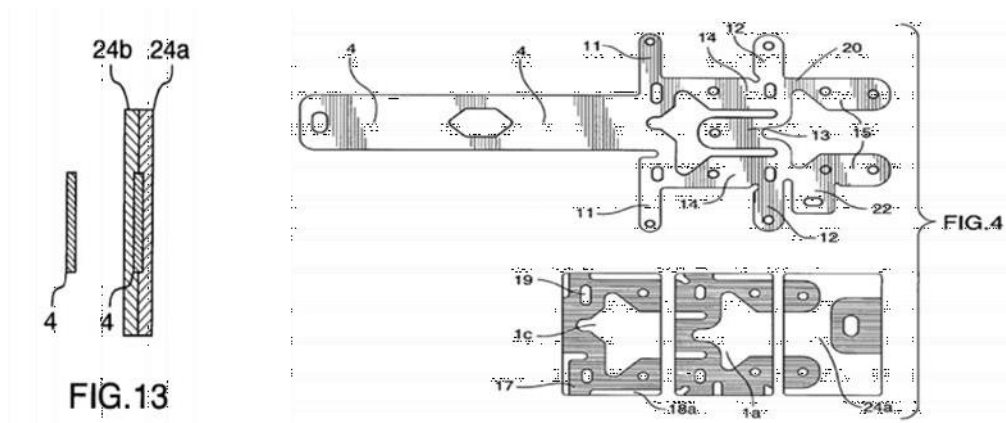
Dr. Cameron opines: “The combination discussed results in this limitation. The groove of Podwika minimized the silhouette and does not adversely affect the already present expandable capacity and ready access of Minn.” EX1016, page 10.

As explained by Podwika, “[i]t is another object of the invention to provide a holder for cards and paper money which is compact when filled with varying amounts of cards and money. It is a further object of the invention to provide a holder for cards which can retain a plurality of cards equally as well as it can retain a single card.” EX1009, 2:27-33.

2. Claim 2

The combination of Pokwika and Coates disclose this additional recitation. Dr. Cameron opines: “As discussed, the combination that utilizes the groove of Pokwika with the laminate construction of Coates (attached with screws rather than adhesive) contains this element.”

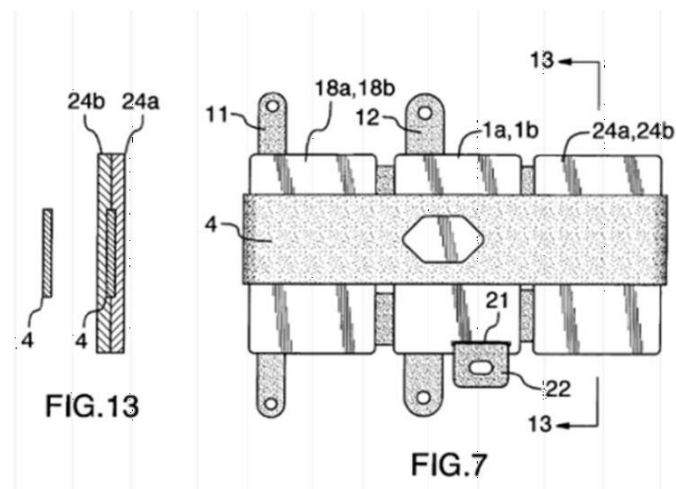
EX1016, page 10. The elastic band is shown in FIG. 13 and FIG. 4, the band is **4** and the lamina are **24a** and **24b**.



EX1011, FIG. 4 and FIG. 13

3. Claim 3

Dr. Cameron opines: “As discussed, a POSITA would use screws in the combination discussed to attach the lamina in order to allow replacement of the elastic band or outer lamina (for example for damage or simply for changing the appearance). The second lamina holds the band in place and provides a smooth glide surface.” EX1016 page 11.



EX1011, FIG. 7 and FIG. 13

4. Claim 4

As also noted by the Patent Office, “Coates teaches other fasteners, it would have been obvious to one of ordinary skill in the art to provide screws or adhesive attaching the two plates.” EX1013, page 71.

5. Claim 5

As discussed, Coates teaches this additional recitation of attaching the lamina. Coates states:

“It will be apparent that other means of attaching the panels **1, 3, 6, 7, 18** and **24** to the resilient members **11-15** include directly connecting with adhesives.” EX1011, 4:14-17.

6. Claim 6

This additional recitation is disclosed in Minn and in the modification of Minn discussed.

Minn describes a “low-profile wallet **10**” that “comprises two metal and/or carbon fiber plates **12**.” EX1005, 2:19-20. It also provides that the materials comprising the plates may block RFID signals, noting that “[w]allet **10** may use a metal material for plates **12** and **14**, such as aluminum or steel.” EX1005, 4:46-51.

7. Claim 7

Dr. Cameron opines: “This additional recitation is obvious based on Minn and in the modification of Minn discussed.” EX1016 page 13.

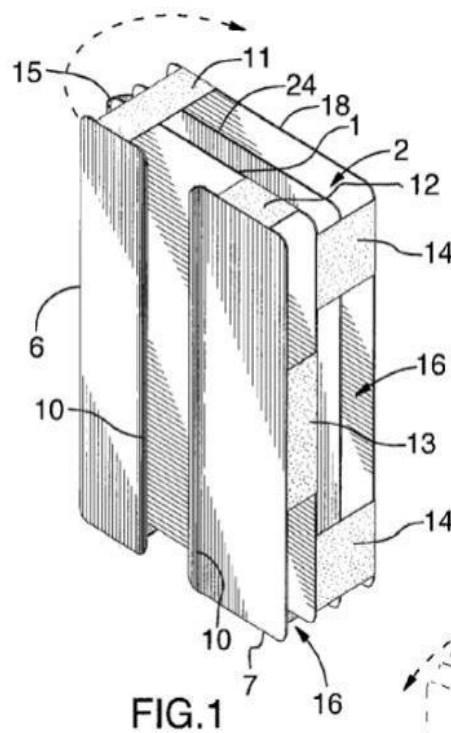
8. Claim 8

As discussed in **Ground 2A**, Claims 6-7, this limitation is obvious over the combination of Minn described.

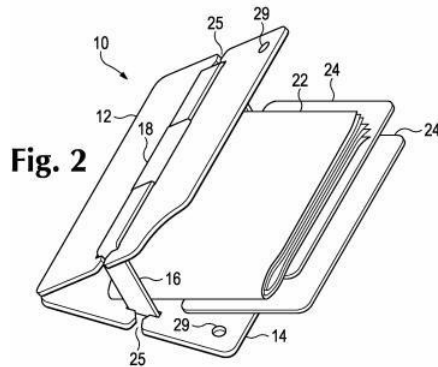
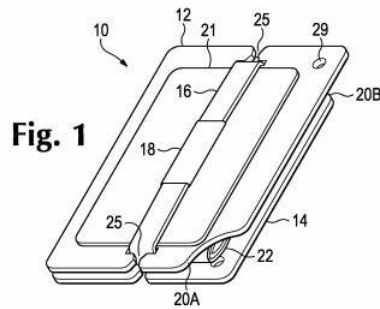
9. Claim 9

Dr. Cameron opines, “It is unclear if “transverse to the longitudinal extents” modifies “ends” or “strap.” However, either way, this limitation is met.” EX1016, page 14.

If “traverse to the longitudinal extents” modifies “ends,” Min and Coates show the location and width of the elastic strap serves to retain the card-like contents from the short end. The combination described where the strap of Minn is enclosed in a groove between laminates also contains this limitation. This is demonstrated in Fig. 1 of Coates and Figs. 1 and 2 of Minn, below.

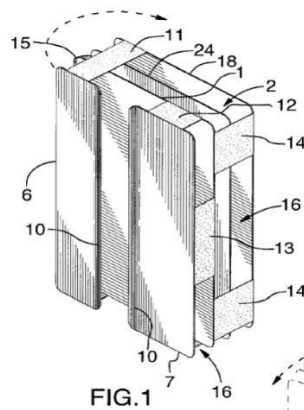


EX1011, FIG. 1



EX1005, Figs.1-2

If “traverse to the longitudinal extents” modifies “strap,” it would have been obvious to utilize an additional elastic strap over a long end of the plates to prevent cards from escaping in that direction. This can be seen in Fig. 1 of Coates and Fig. 1 of Podwika, as shown below, and would be easy to implement in the wallet of Minn.



EX1011, FIG. 1

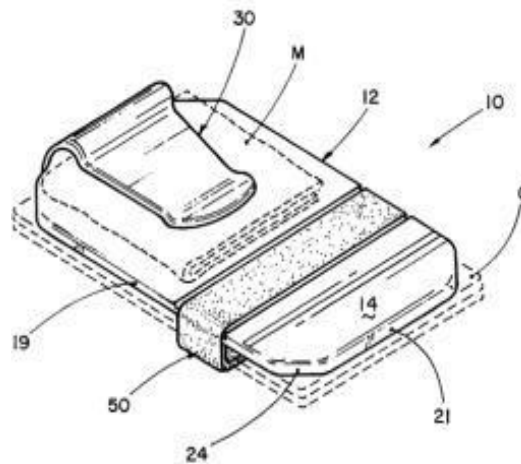


FIG. 1

EX1009, FIG. 1

10. **Claim 10**

Dr. Cameron opines: “A POSITA would have found it obvious to incorporate a second elastic strap over the outside of one of the rigid plates to hold additional contents as shown in Fig. 1 and Fig. 2 of Minn, below, and in Podwika. The strap could simply be fixed to the outside of the rigid plate.” EX1016 page 17.

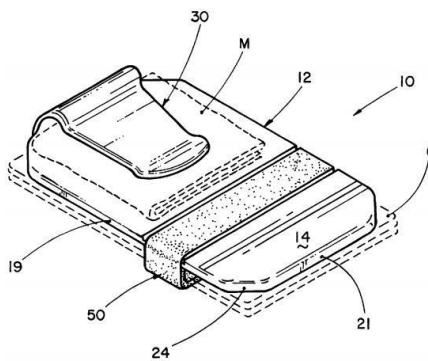
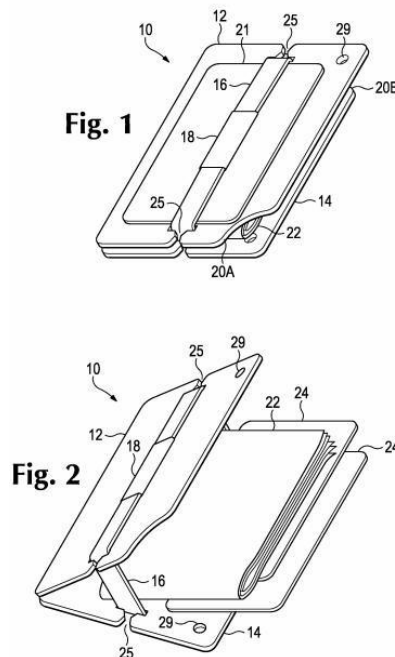


FIG. 1

p

EX1009, FIG. 1



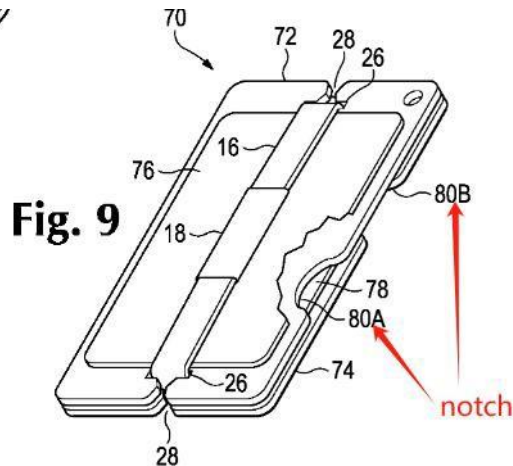
EX1005, Figs. 1-2

11. Claim 11

Minn disclosed these limitations, he explains that “[p]ersonal items, such as paper money **22**, credit cards **24**, driver's license, identification cards, membership cards, business cards, or the like, or any combination thereof may be compressively held in-between plates **12** and **14** or may be held outside of either plate 12 or 14.” EX1005, 2:21-25.

12. Claim 12

As Dr. Cameron opines: “Minn has aligned notches and meets the first part of the claim. The other part of the claim is an intended use and is not limiting. In addition, it was known that aligned notches can be used in this manner.” EX1016, page 18. Minn disclosed such a notch:



EX1005, Fig. 9, annotated

13. **Claim 13**

As Dr. Cameron opines: “A POSITA would have known that the elastic band of Minn could be woven elastic fabric and would be an obvious choice.” EX1016, page 19.

14. **Claim 14**

a. **Claim 14pre**

Minn, Podwika & Coates are all compact wallets. See **Ground 2A**, Claim 1pre.

b. **Claim 14a**

Minn discloses two rigid plates with longitudinal extents interposed to sandwich cardlike contents. See **Ground 2A**, Claim 1a. Podwika discloses a groove that can be used for the elastic band of Minn. See **Ground 2A**, Claim 1c.

Dr. Cameron opines: “Minn modified with the groove of Podwika discloses this limitation. FIG. 1 of Podwika illustrates that the longitudinal elastic band can be captured by a longitudinal groove in each plate instead of by slots 25 and notches 28 taught in Minn. This would be desirable to minimize the profile of the wallet. Like Minn and Podwika, the combination of Minn and Podwika also allow freedom for the dynamic extension and contraction of the band over the entire running length.”

EX1016 page 21.

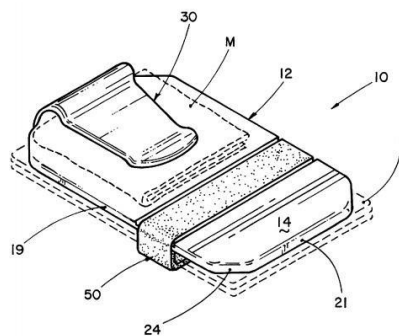


FIG. 1
EX1009, Fig. 1

EX1009, Fig. 1

c. Claim 14b

Podwika discloses a groove that can be used for the elastic band of Minn. See **Ground 2A, Claim 1c**; also see *EX1009 Fig.1*. Dr. Cameron opines, “Minn modified with the groove of Podwika discloses this limitation. FIG. 1 of Podwika below illustrates that the elastic band can be captured by a longitudinal groove in each plate instead of by slots 25 and notches 28 taught in Minn. This would be desirable to minimize the

profile of the wallet. Like Minn and Podwika, the combination of Minn and Podwika also allow freedom for the dynamic extension and contraction of the band over the entire running length.” *EX1016, page 23*; also see **Ground 2A, Claim 1c**.

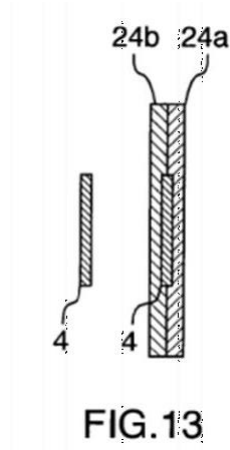
d. Claim 14c

Beckley teaches a removable clip (auxiliary feature) that is used with a compact wallet. See **Ground 2A, Claim 1d**. Dr. Cameron opines: “The clip of Beckley discloses this element, and it would be obvious to use the clip of Beckley in the modified wallet of Minn,” and “[i]t was well known in the art to use a removable clip in conjunction with a compact wallet.” *EX1016, page 25*; also see **Ground 2A, Claim 1d**.

e. Claim 14d

Dr. Cameron opines: “The combination discussed results in this limitation. The groove of Podwika minimized the silhouette and does not adversely affect the already present expandable capacity and ready access of Minn.” *EX1016, page 28*.

Furthermore, Coates also discloses a way to help minimize the profile of the wallet, based on Coates, instead of being exposed, the groove could be made between two lamina to protect the band as seen in Figure 13 of *EX1011*, where 24a and 24b are the lamina of the rigid plate and 4 is the elastic band:



EX1011, FIG. 13

For a POSITA, Using Beckley, Coates, and Podwika to modify Minn to meet the limitation of claim 14d would have merely been the predictable result of using the elements of Beckley, Coates, and Podwika according to their known function.

15. Claim 15

The combination of Pokwika and Coates disclose this additional recitation as discussed in **Ground 2A, Claim 2**.

16. Claim 16

Dr. Cameron opines: “As discussed, a POSITA would use screws in the combination discussed to attach the lamina in order to allow replacement of the elastic band or outer lamina (for example for damage or simply for changing the appearance). The second lamina holds the band in place and provides a smooth glide surface.” EX1016 page 30.

17. Claim 17

As discussed in **Ground 2A, Claim 4**, it is obvious to make second lamina attached to the first lamina by screws.

18. Claim 18

As discussed in **Ground 2A, Claim 6**, it is obvious to make each rigid plate comprised of metal for RFID protection.

19. Claim 19

a. Claim 19pre

Minn disclosed this limitation of Claim 19pre. **Ground 2A, Claims 1pre, 14pre.**

b. Claim 19a

The combination of Minn and Podwika disclose this limitation. See **Ground 2A, Claim 14a.**

c. Claim 19b

The combination of Minn and Podwika disclose this limitation. See **Ground 2A, Claim 14b.**

d. Claim 19c

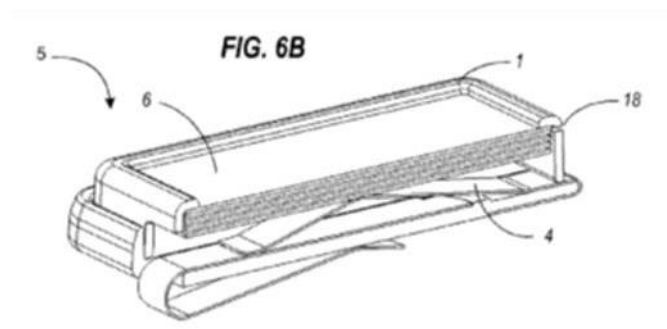
Podwika disclosed the groove, see **Ground 2A, claim 1c**, which can be used with the recess of Beckley, see **Ground 2A, claim 1d**. A POSITA will understand that outboard positioning of Beckley's recess provides one of a limited number of possible locations to form/arrange the recess.

e. Claim 19d

This limitation has been disclosed as discussed in **Ground 2A, claims 1d, 14c.**

f. Claim 19e

See **Ground 2A**, Claims 1d, 14c. In the combination discussed with Beckley, the clip is available at an outside face of one of the rigid plates as shown in Fig. 6B of Beckley. For a POSITA, making the clip available at an outside face of rigid plates is just a limited and predictable result when removably inserting a tang of the clip into a recess.



EX1008, FIG. 6B

g. Claim 19f

This limitation has been disclosed as discussed in **Ground 2A**, claims 1d, 14c.

h. Claim 19g

See **Ground 2A**, Claims 1d, 14c. As Dr. Cameron explains: “For each of the combinations discussed, it would be obvious to include a second accessory arranged the same way as the first but on the opposite rigid plate.” See EX1016 page 34.

i. Claim 19h

This limitation has been disclosed as discussed in **Ground 2A**, Claims 1e, 14d.

20. Claim 20

See **Ground 2A**, Claims 1d, 14c. Dr. Cameron also opines: “In each combination the hook and undercut are interpositioned to secure the tang.”
EX1016 page 35.

21. Claim 21

In each of the combinations, it was obvious to implement the auxiliary feature as a money clip. The clip of Beckley is a money clip.

22. Claim 22

This additional limitation is present as discussed in **Ground 2A**, *Claims 1c, 1d, 14c, 15*. The laminate structure from Coates has been incorporated into the wallet of Minn modified by Podwika with the recess of Beckley.

23. Claim 23

This additional limitation is present, as discussed in **Ground 2A**, *Claims 1d, 3, 14c and 16*.

Dr. Cameron also explained: “for all the combinations, a second lamina captures the band as shown in Figure 13 of Coates.”

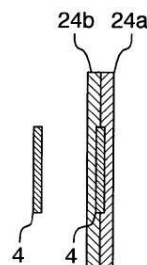
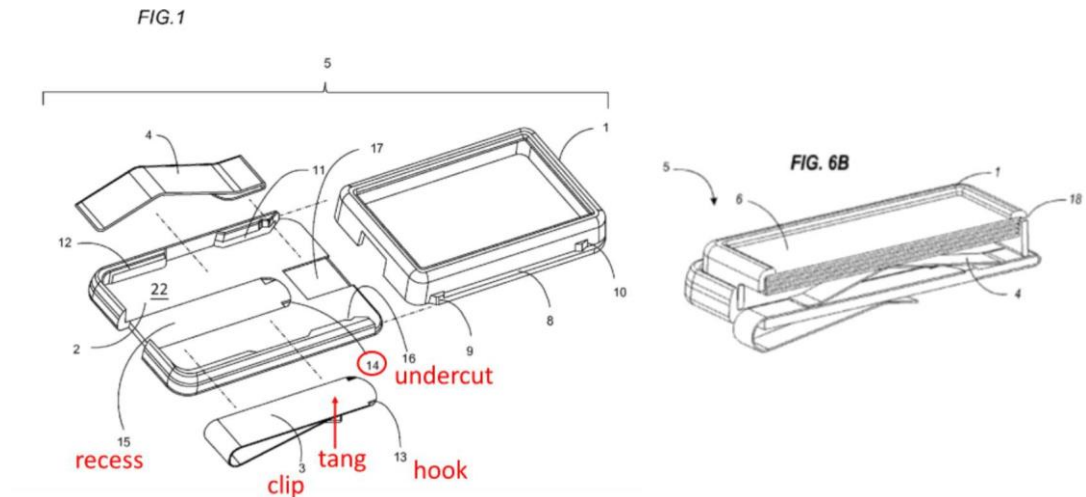


FIG.13

EX1011, FIG. 13

“The tang is placed similar to shown in Figure 1 and 6B of Beckley but as discussed in connection with the modified wallet of Minn for Claim 19:



The band is lined up and placed on top of the tang in the groove and then the second lamina is attached.” EX1016, page 36.

24. Claim 24

This additional limitation is present as discussed in **Ground 2A**, *Claims 4, 17, and 1c*.

Ground 2B: Claim 13 is unpatentable under 35 U.S.C. § 103 over Minn in view of Podwika in further view of Coates in further view of Beckley, in further view of Preston-Hall.

1. Claim 13

Preston Hall discloses a kind of woven band (loop) which is used in a card and currency carrying device. See **Ground 1A**, claim 13. It would have been obvious to make the encircling elastic band woven elastic fabric.

Ground 2C: Claims 1-24 are unpatentable under 35 U.S.C. § 103 over Minn in view of Podwika in further view of Coates in further view of Murphy.

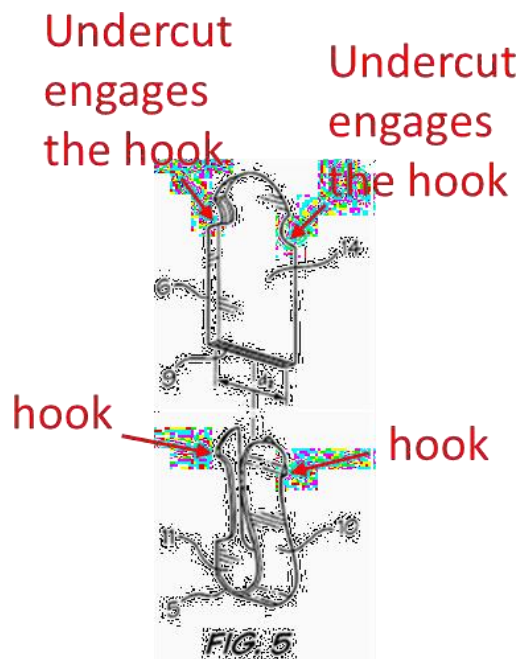
1. Claim 1

a. Claims 1pre-1c, 1e

Minn, Podwika, and Coates disclosed all limitations of claims 1pre-1c,1e. See **Ground 2A**, Claims 1pre-1c, and 1e.

b. Claim 1d

Murphy discloses this element of Claim 1d. Murphy disclosed a auxiliary feature (clip-member 5) using a tang (interior clip portion 11) with a hook (tip of the arrow-shaped securement members 7) at an angle to engage an undercut of a recess (cavity 9) , annotated as follows:



EX1006, FIG. 5

In Murphy, the arrow-shaped securement members (7) of the clip-member (5) engages the recessed openings to hold the clip in place

and prevent inadvertent dislodgement of the clip-member (5) (auxiliary feature) from the recess.

Dr. Cameron opines: “While the clip of Murphy is shown as clipping to the cuff of a pant leg (that can have variable thickness), the clip 10 is similar to that used for a money clip or a clip that could attach a wallet to a belt for example. A POSITA would also be motivated to use the tang and hook arrangement to secure a removable clip or accessory to the wallet (the combination described above).” EX1016 page 9.

In addition, a POSITA will understand that it would have been obvious to form/arrange the recess of Murphy inside the at least two rigid plates of Minn's wallet (modified with Podwika and Coates), because this provide one of a finite number of possible locations to form/arrange the recess.

2. Claims 2-14b

These limitations have been disclosed as discussed in **Ground 2A**, *Claims 2-14b*.

3. Claim 14c

Murphy teaches these arrangements (auxiliary feature, tang, hook, recess, undercut) which can prevent inadvertent dislodgement of the auxiliary feature from the recess. *See Ground 2C*, Claim 1d.

Dr. Cameron further opines: “A POSITA would be motivated to incorporate a removable clip such as that of Murphy into the compact

wallet (and this would be an additional reason to use screws rather than glue or welding to attach the lamina together in addition to being able to replace the outer lamina and or band).” EX1016 page 26.

4. Claims 14d-19b

These limitations have been disclosed as discussed in **Ground 2A**, *Claims 14d-19b*.

5. Claim 19c

As discussed above, Outboard positioning of Murphy’s recess provides one of a limited number of possible locations to form/arrange the recess.

6. Claim 19d

This limitation has been disclosed as discussed in **Ground 2A**, Claim 19d.

7. Claim 19e

This limitation is disclosed in Murphy and the combination as discussed in **Ground 2C**, Claims 1d, 14c. For a POSITA, making clip available at an outside face of rigid plates is just a limited and predictable results when removably inserting a tang of the clip into a recess as taught by Murphy.

8. Claims 19f-20

These limitations are disclosed as discussed in **Ground 2A**, Claims 19f-20.

9. Claim 21

This additional limitation is disclosed. It would have been obvious to implement Murphy as a money clip, a common, desirable feature of a compact wallet.

10. Claim 22

This additional limitation is present as discussed in **Ground 2C**, Claims 1c, 1d, 14c, 15. The laminate structure from Coates has been incorporated into the wallet of Minn modified by Podwika with a recess as taught in Murphy.

11. Claims 23.

This additional limitation is disclosed as discussed in **Ground 2C**, Claims 1c, 1d ,3,14c and 16.

12. Claim 24

This additional limitation is disclosed as discussed in **Ground 2A**, Claim 24.

Ground 2D: Claim 13 is unpatentable under 35 U.S.C. § 103 over Minn in view of Podwika in further view of Coates in further view of Murphy, in further view of Preston-Hall.

1. Claim 13

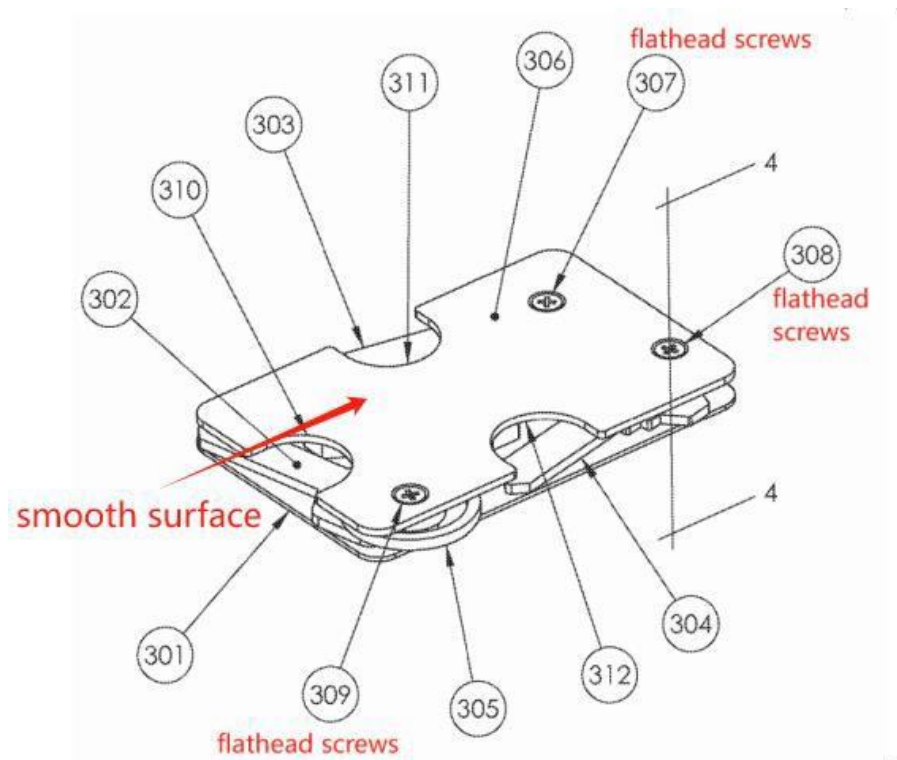
Preston Hall discloses a kind of woven band (loop) which is used in a card and currency carrying device. See **Ground 1A**, claim 13. It would have been obvious to make the encircling elastic band woven elastic fabric.

Ground 3A: Claim 3 and claim 16 are unpatentable under 35 U.S.C. § 103 over Kane in view of Beckley in further view of SINGER.

1. **Claim 3**

Kane and Beckley disclosed all the limitations of claim 2 as discussed above, and SINGER further disclosed a “Small form-factor apparatus and methods for holding, securing, and accessing personal items normally carried on a keychain or in a wallet including.” See EX1019, at [abstract].

SINGER describes : “Keys **302**, **303** and **304** are shown in the retracted, or closed position, and the cover **306**, key ring **305** and spacer, or spacers (not shown), are held in place by **flathead screws 307, 308 and 309.**” See EX1019, ¶ [0041]. As shown below:



EX1019, FIG 3. Annotated

Based on the teaching of SINGER, it is obvious for a POSITA to employ a kind of flat-heading crews (flathead crews) on wallet to provide such a smooth surface for the user.

2. Claim 16

Kane and Beckley disclosed all the limitations of claim 15 as discussed above, and SINGER further disclosed a kind of flathead screw to provide such a smooth surface on wallet for the user as discussed above, *see Ground 3A, Claim 3*.

XIV. CONCLUSION

For the reasons given above, each of the claims 1-24 of the '808 patent is rendered obvious by at least one or more prior art references. Petitioner has thus established that there is a reasonable likelihood that one or more of the claims are unpatentable. Petitioner therefore requests institution of IPR for claims 1-24 of the '808 patent based on each of the grounds specified in this petition.

Dated: August 6, 2024

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*Petition for **Inter Partes Review***
U.S. Patent No. 10,791,808

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CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the word count for the above
Petition for *inter partes* review is 13,500¹, which is less than the 14,000
allowed under 37 CFR § 42.24(a)(1)(i).

Dated: August 6, 2024

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¹ Petitioner notes a word count discrepancy with the Shenzhen petition in IPR2024-00340. The Shenzhen petition certified its word count as 13,965. However, this count includes the petition cover page and table of contents.

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. § 42.6(e) and § 42.105 that on August 6, 2024, a true and correct copy of the foregoing was served via Federal Express on the Patent Owner at the following correspondence address of record as listed on PAIR:

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