

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Klein Tools, Inc.
Petitioner,

v.

Milwaukee Electric Tool Corporation,
Keter Home and Garden Products Ltd.,
Patent Owners.

Case IPR2024-01401
U.S. Patent No. 11,794,952 B2

**PATENT OWNERS'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 11,794,952**

TABLE OF EXHIBITS

Exhibit No.	Description
2001	File history for U.S. Patent No. 10,703,534
2002	File history for U.S. Patent No. 10,583,962
2003	File history for U.S. Patent No. 11,008,136
2004	File history for U.S. Patent No. 11,427,382
2005	“define”. <i>New Oxford American Dictionary</i> (2 nd Ed.), Oxford University Press, Inc., 2005, p. 444
2006	United States Patent Application Publication No. U.S. 2011/0139665 A1 (“ Madsen ”)
2007	Auer-Press, Ex. 1004 of 962-IPR
2008	“depressed”. <i>Webster's II New Riverside University Dictionary</i> , Houghton Mifflin Company, 1994, p. 364

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.107(a), Patent Owners respectfully submits this Preliminary Response to the Petition for *Inter Partes* Review of claims 1-23 (the “Challenged Claims”) of U.S. Patent No. 11,794,952 (the “’952 patent”).

Institution should be denied due to multiple, independently fatal deficiencies in the Petition.

First, the Board should exercise its discretion under 35 U.S.C. § 325(d) and deny institution of this IPR because the Petition relies on art that has already been thoroughly considered and rejected by the Office. In particular, the Petition relies primarily on the Burchia and Metabowerke references that were considered by the same Examiner during prosecution of the ’952 patent and numerous other patents in the ’952 family. Moreover, these references are cumulative of and suffer from the same deficiencies as art that was raised both during prosecution of patents in the ’952 family and in related IPR2021-00373 (concerning U.S. Patent No. 10,583,962, hereinafter “962-IPR”). The Board found in 962-IPR that similar and cumulative references (Madsen and Auer-Press) failed to teach limitations that are also present in the ’026 claims (namely, the “two sidewalls” limitation 1[c]). As detailed herein, the currently cited art fails to teach the 1[c] limitation, consistent with the Board's finding in the 962-IPR..

The Petition attempts to resuscitate Burchia and Metabowerke by ostensibly proposing various combinations of the two (with and without the addition of the non-analogous Lafragette reference and a Chen reference that does not cure the deficiencies of Burchia and Metabowerke). But Petitioner's attempt to repackage Burchia with Metabowerke in various combinations is a façade to sidestep the *Becton, Dickinson* factors, as the Petition contradictorily asserts that each reference alone teaches all limitations of the independent claim. Rather than presenting a coherent argument to meet its burden to show a reasonable likelihood of prevailing on a ground of unpatentability, the Petition relies on a “choose-your-own-adventure” approach recycling references already considered by the Office. Specifically, the Petition states that “Ground 1 relies primarily on Burchia as disclosing **all claim limitations**” (Pet. at 25), and “Ground 6 relies primarily on Metabowerke as disclosing **all claim limitations.**” Pet. At 102.¹ As such, the Petition seeks a “do over” of examination, without identifying any material error made by the Examiner.

Second, the Petition fails to demonstrate that the relied-upon prior art discloses or renders obvious multiple limitations of the claims. Specifically, the Petition fails to establish that the prior art discloses or renders obvious multiple

¹ All emphasis added throughout unless otherwise noted.

limitations, including limitations 1[c], 9[c], and 17[c] (the claimed “two sidewalls ... projecting above a depressed surface of the top face”) and limitation 1[n], 9[l], and 17[l] (the claimed “locking latch arresting location defined by one of the first container or the second container”). Importantly, the Petition relies solely on Burchia and Metabowerke as teaching “two sidewalls...projecting above a depressed surface of the top face,” despite the fact that in 962-IPR, the Board already declined institution when analogous limitations were addressed with similarly deficient cumulative art (Madsen and Auer-Press). If the Board agrees that Burchia and Metabowerke fail to teach or suggest this limitation, institution must be denied, as the Petition provides no other rationale that would render these limitations obvious. Similarly, and independently, if the Board agrees that neither Burchia nor Metabowerke teaches or suggests a “locking latch arresting location defined by one of the first container or the second container,” and that Lafragette is non-analogous art, the institution must be denied.

Finally, Petitioner's proposed motivations to combine are riddled with flaws, including (i) a failure to clearly specify which references are being relied upon for which elements, and (ii) proposed combinations rendering the primary reference unfit for its intended purpose.

Because these deficiencies are pervasive and impact all claims across all grounds, it is respectfully submitted that the Petition must be denied in its entirety.

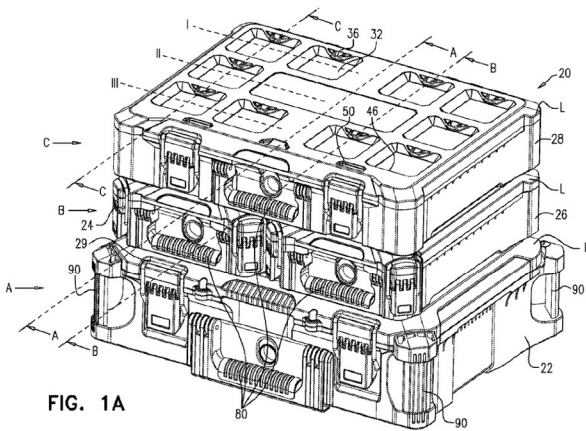
II. LEVEL OF SKILL IN THE ART

A person of ordinary skill in the art (“POSITA”) at the time of the invention would have possessed at least a bachelor’s degree in mechanical engineering, industrial engineering, industrial design, or a similar discipline with at least 1-2 years of professional engineering and/or industrial design work experience. Such a person would also qualify as a POSITA if s/he had some combination of (1) more formal education (i.e., an advanced degree in mechanical engineering, industrial engineering, industrial design, or a similar discipline) and less professional experience, or (2) less formal education and more professional experience.

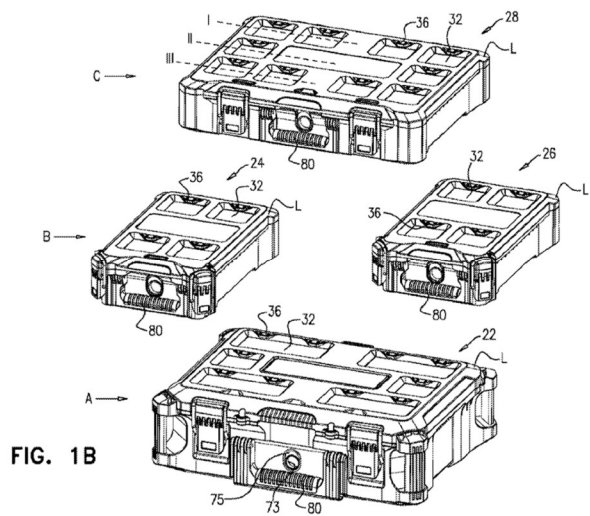
III. OVERVIEW OF THE ’952 PATENT

A. Prosecution History

U.S. Patent No. 11,794,952 is directed to a novel and non-obvious container assembly and coupling mechanism for the same. Ex. 1001 (’952 Patent) at 1:27-1:32. For ease of reference, Figures 1A and 1B of the ’952 patent are reproduced below:



Ex. 1001, Fig. 1A



Ex. 1001, Fig. 1B

As shown above, the container system comprises two or more detachable containers coupled via a coupling mechanism. *Id.* The coupling mechanism includes a first coupler on a face of one container and a second coupler on the other. *Id.* at 23:4-23:5, 23:16-23:17. The first coupler comprises two sidewalls, a back wall, and a rib, with the back wall located between the sidewalls, all projecting above a depressed surface, and the rib extending from it in a first direction. *Id.* at 23:5-23:10. The second coupler includes a tongue extending parallel to the bottom face in the opposite direction, engaging the rib and depressed surface. *Id.* at 23:16-23:23. A first corner bumper is located between the front and first side faces, and a second corner bumper is positioned similarly on the second side. *Id.* at 23:31-23:40. The assembly also includes a locking latch arresting

location on one container and a locking latch on the other, engageable to limit sliding displacement. *Id.* at 23:46-23:52. U.S. Patent Application No. 18/051,749 was filed in the United States on November 1, 2022, and titled “Utility Assembly and Coupling Mechanism.” Ex. 1002 at 498-504. During prosecution, the claims were only rejected under double patenting grounds, as the majority of the limitations were the same as earlier claims in the family where the Examiner already considered Burchia and Metabowerke multiple times. *Id.* at 278, 201, 251, 194.

After a terminal disclaimer was filed, a Notice of Allowance issued on August 30, 2023, and the application issued on October 4, 2023 as the '952 patent. *Id.* at 15, 3.

IV. CLAIM CONSTRUCTION

The Board should apply the plain and ordinary meaning of the terms used throughout the claims.

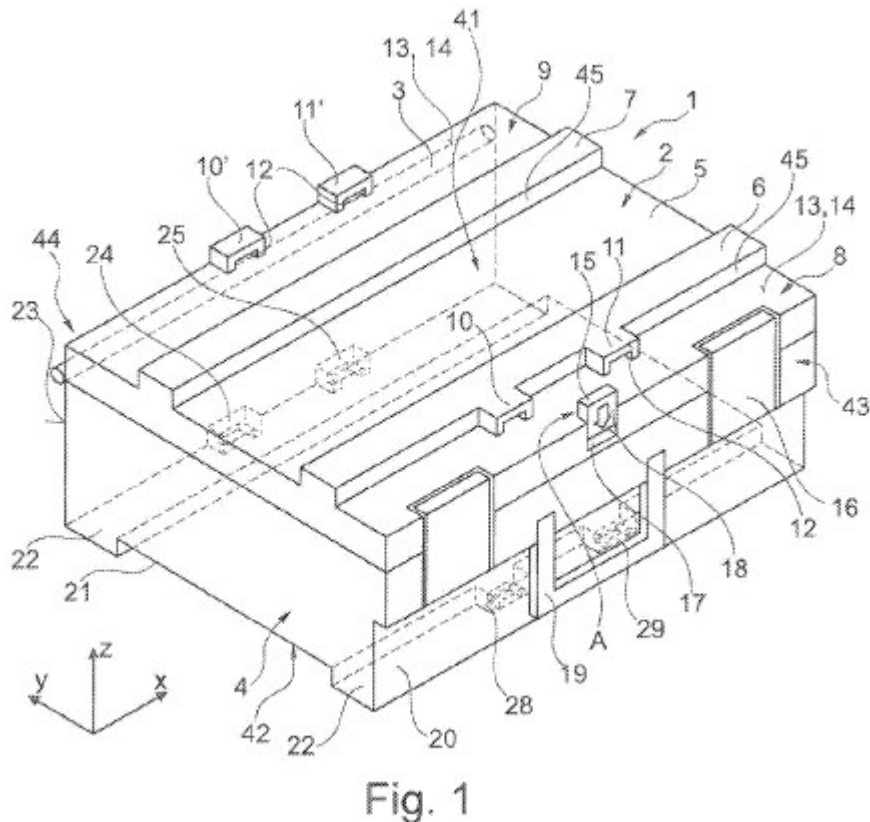
V. OVERVIEW OF THE PRIOR ART

This section provides a brief description of the prior art that is discussed in substance throughout this brief. Although the Petition relies on additional references (Lin and Bensman) to assert grounds of obviousness over certain dependent claims, as explained below, it is not necessary for the Board to consider

the substance of these references in order to deny institution of this IPR.

A. US 10,750,833 (“Burchia”) (Ex. 1004)

Burchia describes a “Stackable suitcase, arrangement comprising two suitcases stacked one above the other and method for stacking two suitcases.” Ex. 1004 (Burchia) at Title. As illustrated in Figure 1 of Burchia, Burchia discloses a “lid part 2” with “cross-ribs 6, 7, which are configured to be elevated.” *Id.* at 10:21-10:25.



Ex. 1004, FIG. 1

B. U.S. Pub. No. 2003/0139080 (“Lafragette”) (Ex. 1005)

Lafragette concerns an electro-mechanical “connection device for an electronic box.” Ex. 1005 (Lafragette) at ¶ 1. “The object of the invention is to provide **a connection device for an electronic box**, comprising **a connection module that can be wired before it is fitted onto the box** and which can be disconnected from the box simply and quickly, without any deterioration and without requiring to disconnect the conducting cables.” *Id.* at ¶ 5. “This connection is reversible as all that is required is to rock the resilient tab 18, for example **using a Screwdriver**, in order to disengage it from the recess 10, before moving the module 12 longitudinally in order to allow the returns 16 to escape from the lugs 9 on the box and to pull the module transversely in order to allow access to the box.” *Id.* at ¶ 33.

C. German Utility Model DE202014103695 U1 (“Metabowerke”) (Exs. 1006, 1020 (translation))

Metabowerke describes a “[s]tackable container.” Ex. 1020 (Metabowerke translation) at Title. “The stackable container (100) [of Metabowerke has] a base part (1) and a cover (2) pivotable about an axis A on the base part (1), wherein the base part (1) has at least one standing foot for placing the container on a surface or on a cover (2') of another, similar container (100'), and wherein the container (100) has at least one separate support element (11) that, upon placing the first container

(100) on the other container (100'), engages in an engagement structure of the other container (100') and thereby inhibits a displacement of the first container (100) relative to the second container (100') in at least one direction vertical to the stacking direction.” *Id.* at Main Claim.

Metabowerke provides limited views of the above features, including a perspective view (Ex. 1006 at FIG. 1) and a top down view. *Id.* at FIG. 5. As explained throughout this brief, Metabowerke is silent regarding aspects of these features that the Petition attempts to map to the language of the claims at issue.

D. U.S. Pub. No. 2014/0265440 (“Chen”) (Ex. 1024)

Chen concerns “carts having drawers.” Ex. 1024 (Chen) at ¶ 2. “One object of the invention is to provide a cart comprising a support body; two **side frames** being rectangular wherein each of the **side frames** includes two spaced vertical bumpers and two spaced horizontal cross rails.” *Id.* at ¶ 7. The carts are configured so that “an employee may hold the handle 32 to wheel the cart in work.” *Id.* at ¶ 16. The purpose of the “side frames” is to “absorb[] impact in case of collision of the cart and a foreign object,” and is meant to solve the problem where “[i]n a warehouse...carts collide due to close proximity.” *Id.* at ¶ 16, 5.

VI. DISCRETIONARY FACTORS

A. 35 U.S.C. § 325(d) Favors Denial

The § 325(d) analysis uses a two-prong framework: (1) whether the arguments presented in the petition are the same or substantially the same as those previously presented to the Office; and (2) if so, whether the petitioner has demonstrated a material error by the Office in its prior consideration of those arguments. *Advanced Bionics, LLC v. Med-El Electromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (“*Advanced Bionics*”), (PTAB Feb. 13, 2020) (precedential). “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

i. Factor (a): The Similarities and Material Differences Between the Asserted Art and the Prior Art Involved During Examination

The Petition relies on various combination of Burchia, Metabowerke, Lafragette, and Chen in an attempt to establish obviousness of the independent claims of the '952 patent. The Examiner considered both Burchia and Metabowerke during prosecution of the '952 Patent, and Burchia and Metabowerke both appear on the cover page of the '952 patent. *See* Ex. 1002 at 292, Cite No. A164 and 301, Cite No. A443; Ex. 1001 at 3, 5; *see also Nespresso Usa, Inc. v. K-Fee Sys. GmbH*, No. IPR2021-01223, 2022 WL 214445, at *6

(P.T.A.B. Jan. 18, 2022) (finding that all references submitted in the IDS were considered except where lined through, regardless of placement within the sheet).

The Petition accurately although misleadingly notes that Burchia and Metabowerke were, respectively, the 164th and 443rd references out of over 500 total references disclosed in a 20-page IDS. Pet. at 19. The Petition, however, neglects to mention that the same Examiner previously considered Burchia and Metabowerke in numerous parent applications (four parent applications in the case of Burchia, and three in the case of Metabowerke). Ex. 1002 ('952 Patent File History) at 292, Cite No. A164 and 301, Cite No. A443; Ex. 2001 (10,703,534 Parent Patent File History) at 1521, Cite No. 16 and at 2784, Cite. No. 1; Ex. 2002 (10,583,962 Parent Patent File History) at 1818, Cite No. A68; Ex. 2003 (11,008,136 Parent Patent File History) at 29, Cite No. A15 and 502, Cite No. A8; Ex. 2004 (11,427,382 Parent Patent File History) at 302, Cite No. A21 and 656, Cite No. A215. When first cited within this patent family, Metabowerke was the first foreign patent document in an IDS filed in U.S. Patent No. 10,703,534 on May 19, 2020, and Burchia was listed as the 16th reference cited in an IDS filed in U.S. Patent No. 10,703,534 on May 7, 2019. Ex. 2001 at 2784, Cite. No. 1 and 1521, Cite No. 16.

Lafragette was not cited in the '952 patent as it is clearly non-analogous art, as described in section VIII.A.ii below.

Chen was not cited in the '952 patent but is relied on in the Petition as allegedly teaching only limitation 1[k] and 1[l] (the corner bumper limitations) of independent claim 1. Pet. at 95, 146. The arguments involving Chen share the same deficiencies as those presented in the Petition regarding the remaining limitations of the independent claims, which are based solely on Burchia, Metabowerke, and Lafragette.

The Petition relies on Lin and Bensman solely for allegedly addressing elements of certain dependent claims. Consequently, the arguments involving Lin and Bensman inherit the same deficiencies as those raised in the Petition against the independent claims, which are based exclusively on Burchia, Metabowerke, Lafragette, and Chen.

Thus, the fact that the only analogous art raised in the Petition was repeatedly considered by the Examiner in each of the '952 patent and its parents weighs strongly in favor of denial.

ii. *Factor (b): The Cumulative Nature of the Asserted Art and the Prior Art Evaluated During the Examination.*

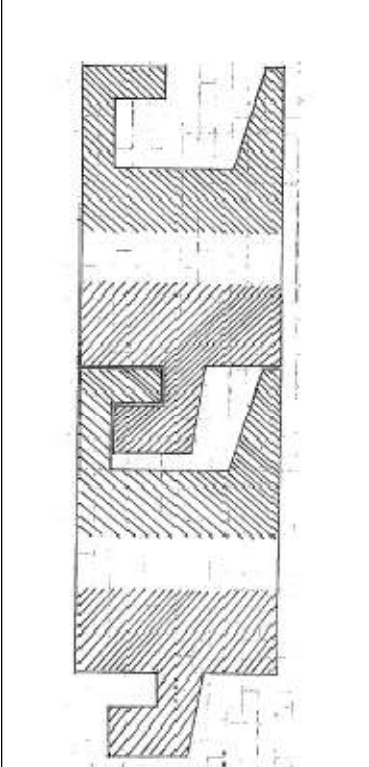
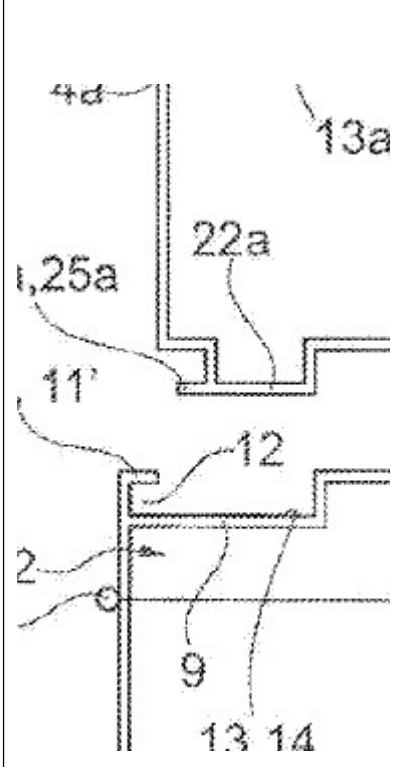
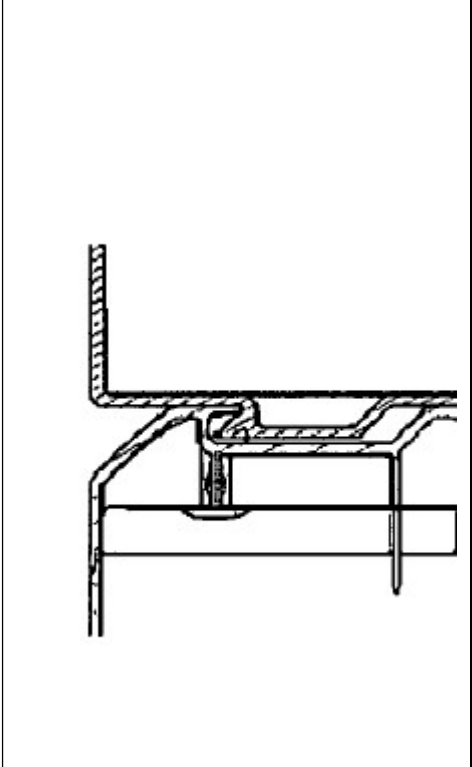
Burchia and Metabowerke are cumulative with respect to the prior art evaluated during examination, in particular, U.S. Publication No. 2011/0139665 ("Madsen") and the Auer-Press reference. These references were raised in the 962-IPR proceedings, as well as prosecution of the application that led to the '962

patent. *See, e.g.*, Ex. 2002 at 133,1830 (citing substantially similar reference Madsen during the '962 prosecution and substantially similar reference Auer-Press and Madsen in the 962-IPR).

The '952 patent and the '962 patent are related, as they are both continuations (through various intermediate applications) of PCT/IL2017/050481. Ex. 1002 at 501; Ex. 2002 at 6. The same Examiner examined each of the applications leading to the '952 patent and the '962 patent. Ex. 1002 at 272; Ex. 2001 at 529; Ex. 2002 at 128; Ex. 2003 at 429; Ex. 2004 at 585. During examination of the '962 patent, the Applicant overcame the Madsen reference by arguing that "Madsen's cavity is different than two sidewalls and a back wall projecting from a depressed surface of a first face, as recited in claim 1." Ex. 2002 at 221. The Examiner agreed with the Applicant's arguments, and the claims were allowed. *Id.* at 320. In denying institution of 962-IPR, the Board also found that Madsen failed to teach "two sidewalls...projecting from a depressed surface of a first face," and found that an additional reference, Auer-Press, failed for the same reason. *See id.* at 1848. During prosecution of the '952 patent, which is the subject of the instant Petition, the same Examiner considered the 962-IPR documents. *Id.* at 146-148.

As described in further detail throughout this Brief, Burchia and Metabowerke are cumulative of, and suffer from at least the same deficiencies as,

Madsen.² As with Madsen, Burchia and Metabowerke each disclose a coupler, as shown in the comparison below:

		
Ex. 2006 (Madsen), FIG. 1 (cropped and mirrored)	Ex. 1004 (Burchia), FIG. 3 (cropped)	Ex. 1006 (Metabowerke), FIG. 4 (cropped)

² Burchia and Metabowerke are also cumulative with Auer Press which shares the same deficiencies as Madsen as discussed in section VII.A.ii. The Auer-Press reference was also in front of the Examiner, via the Examiner's consideration of the proceedings in IPR'962.

Like Madsen, as described in Section VII.A.ii.a, Burchia does not disclose “the two sidewalls and the back wall projecting above a depressed surface of the top face.” And like Madsen, as described in Section VII.A.ii.a, the Petition fails to present persuasive evidence that Metabowerke discloses the claimed side walls.

These are the only references that the Petition alleges teach the claimed “two sidewalls ... projecting above a depressed surface of the top face.” Thus, Burchia and Metabowerke constitute “substantially the same art” that was previously presented to the Office.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 15 (holding that two references which disclose substantially the same shape and configuration disclose substantially the same information and thus are substantially the same art).

From these facts, and given that the Examiner rejected the '952 patent only under double patenting grounds, an inference can be drawn that the Examiner regarded the references Burchia and Metabowerke as cumulative of art already considered. As numerous panels held after *Advanced Bionics*, there is no requirement for the previously considered art to have been the basis of rejection or other explicit, written analysis. *E.g.*, *Nespresso USA, Inc. v. K-Fee Sys. GmbH*, No. IPR2021-01223, 2022 WL 214445, at *6 (P.T.A.B. Jan. 18, 2022); *Roku, Inc. v. Universal Elecs., Inc.*, No. IPR2019-01619, 2021 WL 2123912, at *3 (P.T.A.B. May 25, 2021); *Sony Interactive Ent. LLC v. Terminal Reality, Inc.*, No. IPR2020-

00710, 2020 WL 6065186, at *4–5 (P.T.A.B. Oct. 13, 2020). Thus, not only were Burchia and Metabowerke themselves considered during prosecution of the '952 patent (as well as considered numerous times by the same Examiner during prosecution of parent applications), but cumulative references to Burchia and Metabowerke (i.e., Madsen and Auer Press) were likewise considered by the Examiner during prosecution of the '952 patent.

The Petition states that “The examiner did not consider Lafragette, Lin or Chen.” Pet. at 20. As discussed further in section VIII.A.ii, Lafragette, clearly is non-analogous art, so there is no surprise that the examiner didn't locate it during a search. Moreover, Lafragette is not relied upon in the Petition as teaching “two sidewalls and the back wall projecting above a depressed surface of the top face,” and thus would not cure the deficiencies of Burchia and Metabowerke.

Lin and Bensman are relied upon only for teaching features of dependent claims, and thus do not cure the deficiencies in the Petition with respect to the independent claims.

Chen is relied upon only for teaching limitations 1[k] and 1[l] of independent claim one and analogous limitations in dependent claim 10 and dependent claim 18 and thus does not cure the deficiencies in the Petition with respect to the rest of the limitations in the independent claims.

The Petition asserts that “[i]t was material error not to reject the claims based on the art presented herein.” Pet. at 20. But the Petition provides *no analysis or reasoning* in support of this conclusion or an explanation as to why Burchia and Metabowerke are not cumulative of Madsen and Auer Press. Moreover, because Petitioner is expected to have reviewed the prosecution history of the related applications and the 962-IPR, Petitioner should not be allowed a Reply on this point.

iii. Factor(d): Overlap of Arguments

Given the cumulative nature of the Burchia and Metabowerke references over the references already considered by the Office, there is substantial overlap in the arguments presented in the Petition and the arguments considered during prosecution of the '952 patent. As such, factor (d) favors denial.

iv. Factor(c): The Extent to Which the Art Was Considered During Examination.

The Petition notes that “Burchia and Metabowerke played no substantive role during the prosecution.” Pet. at 20. However, as discussed above, the record makes clear that the same Examiner specifically considered Burchia and Metabowerke numerous times throughout the prosecution of the '952 patent family. Ex. 1002 at 292, Cite No. A164 and 301; Ex. 2001 at 1521, Cite No. 16 and at 2784, Cite. No. 1; Ex. 2002 at 1818, Cite No. A68; Ex. 2003 at 29, Cite No.

A15 and 502, Cite No. A8; Ex. 2004 at 302, Cite No. A21 and 656, Cite No. A215. Further, the same Examiner rejected the claims of the corresponding application of the '962 patent over Madsen, and then allowed the same because Madsen fails to teach the "two sidewalls" limitation that is also present in the instant patent. Ex. 2002 at 133; *id.* at 221; *id.* at 320. The Petition does nothing to distinguish Metabowerke and Burchia from these cumulative references applied during prosecution of related applications.

Rather than an error or mistake, there was careful and repeated consideration of both references, and an ultimate conclusion that Burchia and Metabowerke did not render the claims unpatentable.

v. *Factor(e): Whether the Petition Has Sufficiently Pointed Out How the Examiner Erred.*

The Petition fails to point to any errors committed by the Office during prosecution of the '952 Patent family. Rather, the Petition argues, in a conclusory manner, that the Examiner did not "identify Lafragette. Lin, and Chen" and "did not *appear* to give [Burchia and Metabowerke] due consideration." Pet at 23. As discussed above, incorporated here, the Examiner gave these references due consideration in multiple related applications in the family. The Examiner thus clearly understood this art to be either cumulative of other art applied during prosecution or lacking the requisite disclosures.

vi. *Factor(f): The Extent to Which Other Facts and Evidence Have Been Presented.*

The Petition has not offered any additional evidence or facts that would change the analysis of Burchia, Metabowerke, Lafragette, and Chen.

While the Petition refers to the declaration of Dr. Collins, the Board has denied institution where “[t]he only evidence presented by Petitioner that was not before the Office during reexamination is the Declaration of [petitioner’s expert].”

Integrated Global Concepts, Inc. v. Advanced Messaging Techs., Inc., No. IPR2014-01027, 2014 WL 7330580, at *5–6 (P.T.A.B. Dec. 22, 2014).

The Board should do the same here. Dr. Collins does not provide any new analysis or insight relating to Burchia, Metabowerke, Lafragette, Chen or the prior art of record that would have been unavailable to the Office, and the Petition does not assert otherwise. Dr. Collins merely repeats the same incorrect conclusions from the Petition: that Burchia and Metabowerke disclose the claim limitations, without showing how the Examiner erred when the two references were considered during prosecution. Pet. at 29. Dr. Collins fails to even mention the cumulative references, let alone distinguish them. Accordingly, this factor also weighs towards denying institution.

vii. *Applying the Two-Part Framework for Balancing the Becton, Dickinson factors.*

The Board should exercise its discretion and deny institution.

The first Advanced Bionics prong is met because the primary references (Burchia and Metabowerke) raised in the Petition against the independent claims were previously considered by the Office. Moreover, the relied upon references are cumulative of the references considered and/or applied many times by the Office, and the Petition fails to show that “the prior art cited in the Petition differs in any specific, substantial way from the prior art” applied during prosecution. *Autel Intelligent Tech. Corp., Ltd. v. Orange Elec. Co., Ltd.*, No. IPR2021-01545, 2022 WL 1094028, at *9 (P.T.A.B. Apr. 8, 2022); *see also Advanced Bionics*, IPR2019-01469, Paper 6 at 8. “Previously presented art includes...art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Id.* at 7-8; *see also Abs Glob., Inc. v. Cytonome/st, LLC*, No. IPR2021-00306, 2021 WL 2350052, at *4 (P.T.A.B. June 7, 2021).

Petitioner fails to meet its burden to show a material error required by the second Advanced Bionics prong. Because the first *Advanced Bionics* prong is satisfied, Petitioner must demonstrate how the Examiner erred. *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. But the Petition addresses the second *Advanced Bionics* prong with only conclusory statements that do not demonstrate **how** the Office erred in a manner material to the patentability of the challenged claims. Pet. at 20. Additionally, the Petition does not explain what if any “additional evidence

and facts presented in the Petition warrant reconsideration of the prior art or arguments” *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 18 (“*Becton, Dickinson*”) (PTAB Dec. 15, 2017) (informative). Indeed, the Petition merely asks the Office to consider whether Burchia, Metabowerke, Lafragette, and Chen render the challenged claims obvious, something the Office has already done with respect to Burchia and Metabowerke, the two references relied upon for the majority of the limitations, several times throughout the prosecution history of the '952 Patent family. Because Petitioner “bears the burden of showing that the Office erred,” and it has failed to establish that the asserted references are not cumulative, the Board should exercise its discretion under §325(d) and deny institution, as it is inequitable to have the Patent Owners repeatedly defend itself against the same references over and over again. *Nespresso*, IPR2021-01223, 2022 WL 214445 at 13.

VII. GROUND 1: BURCHIA AND METABOWERKE FAIL TO RENDER OBVIOUS CLAIMS 1-23

A. Claim 1

- i. The Petition Fails to Establish the Graham Factors By Not Identifying the Differences Between the Claimed Subject Matter and the Prior Art*

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art, (2) any

differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where present, so-called secondary considerations. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18, 86 S. Ct. 684, 694, 15 L. Ed. 2d 545 (1966).

Petitioner asserts that ***Burchia* discloses each and every element of the independent claims**. Pet. at 25 (“Ground 1 relies primarily on *Burchia* as disclosing **all claim limitations**.”). Petitioner’s assertion that the *Burchia* reference discloses all claim elements does not provide Patent Owners or the Board with the required specificity as to what claim element(s) are purportedly missing from one reference and disclosed by another.

Petitioner, therefore, fails to comply with at least the second *Graham* factor because Petitioner has not identified the differences between the ’952 patent and the proposed combination of *Burchia* and *Metabowerke*. The Board has denied institution in similar cases where a Petitioner “place[s] the burden on [the Board] to sift through the information presented by Petitioners...and identify any differences between the claimed subject matter and the teachings of [the prior art].” *Google Inc. & Twitter, Inc. v. Everymd.com LLC.*, No. IPR2014-00347, 2014 WL 2175007, at *11 (P.T.A.B. May 22, 2014) (denying institution and noting that Petitioner “d[id] not address meaningfully the scope and content of the prior art, and any differences between the claimed subject matter and the prior art”); *see*

also, e.g., *Moses Lake Indus., Inc. v. Enthone, Inc.*, No. IPR2014-00246, 2014 WL 2810485, at *9 (P.T.A.B. June 18, 2014) (denying institution and explaining that “[a]t least one of the Graham factors discussed above, namely explaining any differences between the claimed subject matter and the prior art, is not discussed in [the] Petition”); *Microsoft Corp. v. Secure Web Conf. Corp.*, No. IPR2014-00745, 2014 WL 4925718, at *6 (P.T.A.B. Sept. 29, 2014) (“Petitioner’s general contention that if anything is missing from Crowley it may be found in Morris leaves us to speculate how the references are combined.”).

The Board should deny institution for Petitioner’s failure to address the *Graham* factors by failing to identify what claim elements are missing from the primary Burchia reference.

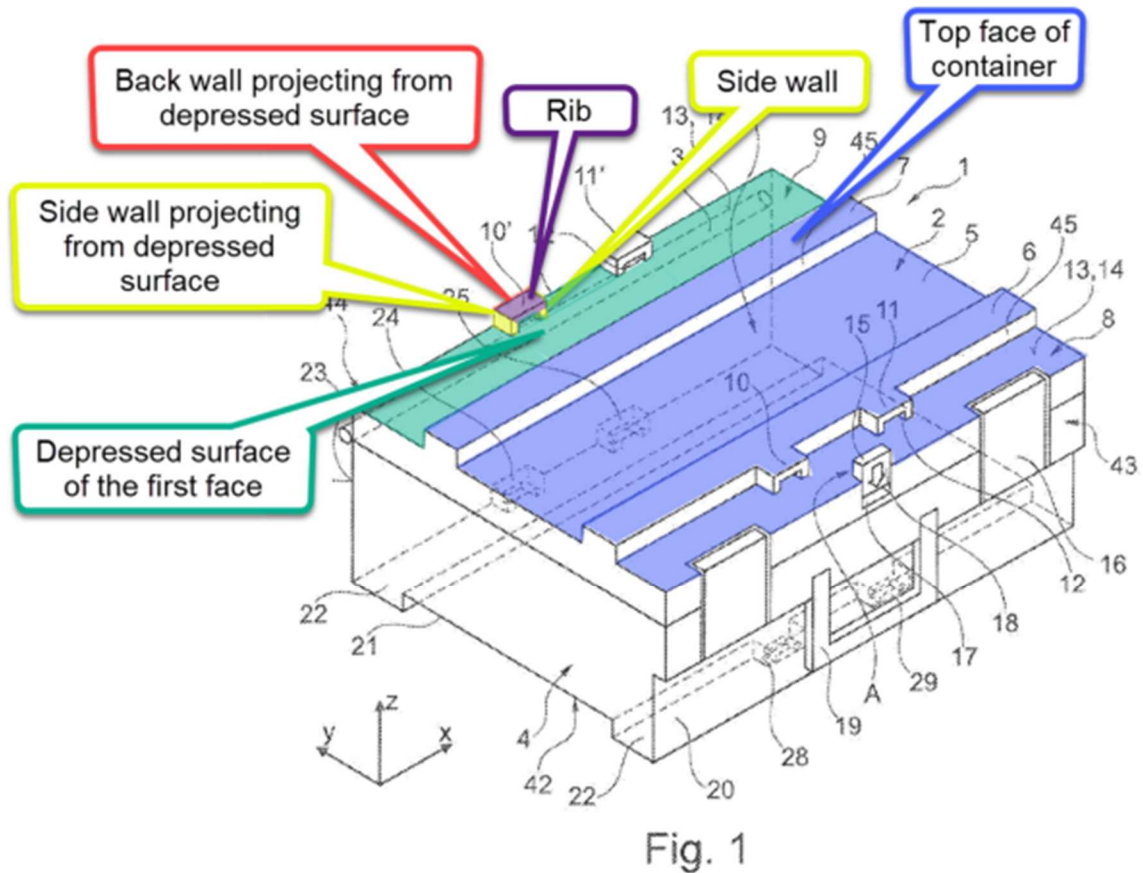
ii. *The Petition Fails to Show that Burchia in View of Metabowerke Renders Obvious the Claimed “first coupler comprising two sidewalls...projecting above a depressed surface of the top face.”*

Claim 1 recites “the two sidewalls...projecting above a depressed surface of the top face.” Petitioner fails to show that Burchia, Metabowerke, or a combination thereof discloses or otherwise renders obvious “the two sidewalls... projecting above a depressed surface of the first face.” See *Arendi v. Apple*, 832 F.3d 1355, 1363, 119 USPQ2d 1822, 1827 (Fed. Cir. 2016) (stating that “to supply a

limitation missing from the prior art, [an obviousness rationale] must still be supported by evidence and a reasoned explanation”).

- a. *Burchia Fails to Disclose “a first coupler extending from a top face of the first container, the first coupler comprising . . . the two sidewalls and the back wall projecting above a depressed surface of the top face . . .”*

The Petition asserts that Burchia discloses the claimed first coupler extending from a top face of the first container with the first coupler comprising two sidewalls, a back wall, and a rib, the back wall located between the two sidewalls. Pet. at 28-32. Claim 1 further requires that the “two sidewalls and the back wall project[] above a depressed surface of the top face.” Ex. 1001 at cl. 1. The Petition provides the below annotated image of Figure 1 of Burchia to assert that these limitations are met. Pet. at 33.



Ex. 1004, FIG. 1, as modified in the Petition at page 33.

The portion of Burchia labeled a “depressed surface of the first face,” however, is not a depressed surface at all.³ A POSITA would have understood that

³ The Petition labels the green section as “depressed surface of the first face,” which is not recited in the claim. For the purposes of this response, Patent Owners assumes that the Petition intended to refer to the claimed “depressed surface of the top face.”

a depressed surface of the top face is a surface that is situated lower than the general surface and thus should form a depression **relative to the surrounding** surface. *See* Ex. 2008 (Webster's II) at 3 (providing the plain and ordinary meaning of *Depressed* (adj): "Sunk below the surrounding region."). Burchia simply does not disclose this.

As seen in the annotated figure, Petitioner identifies "receiving region 9" (green) as the claimed depressed surface of the first face. Ex. 1004 at 10:48-10:54. This "receiving region 9," however, runs across the entire edge in the x-direction of the suitcase in Burchia and resides at the same height as the general surface of the suitcase. *Id.* Indeed, as Burchia explains, the "stackable suitcase," includes a "lid part 2 [that] has an essentially flat part on its top side, which part has the cross-groove 5 in its center region and is delimited laterally by the **cross-ribs 6, 7, which are configured to be elevated,**" *Id.* at 8:28-8:29, 10:22-10:25. Just as an elevated railway does not render the city street below a "depressed surface," the addition of "elevated" "cross-ribs" 6 and 7 does not render the "lid part 2" of Burchia's "stackable suitcase" a "depressed surface." *Id.*

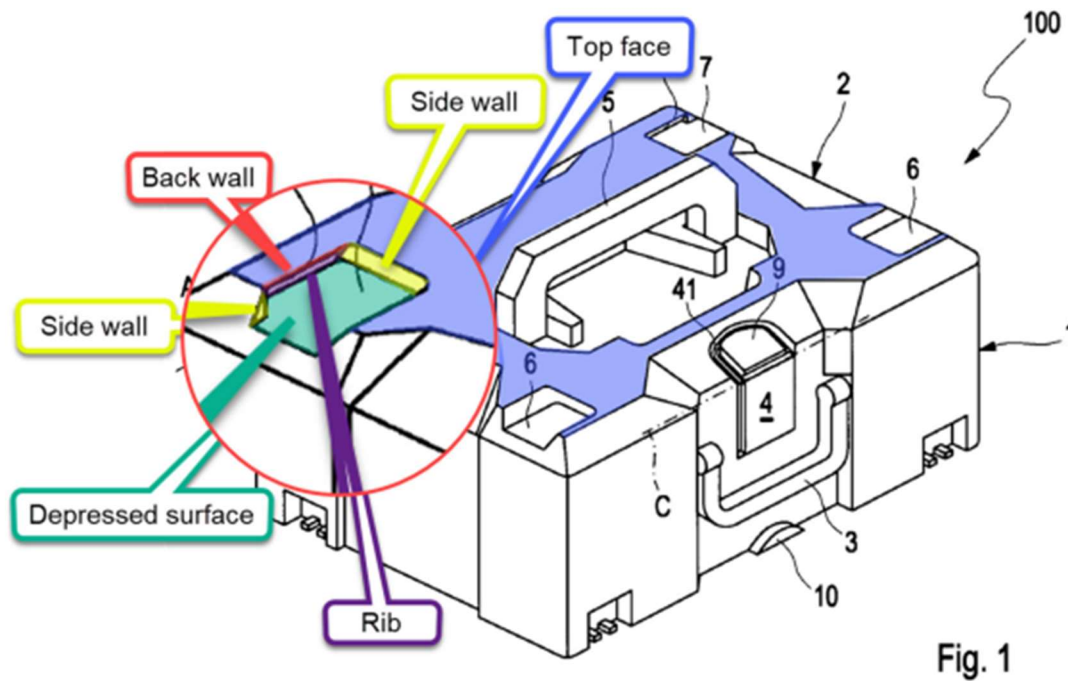
As such, Burchia fails to disclose the claimed first **coupler comprising**, in relevant part, two sidewalls and the back wall **projecting above a depressed surface** of the top face.

Despite claiming that Burchia discloses a depressed surface, Petitioner no doubt recognizes this fatal deficiency, so turns to Metabowerke in an attempt to remedy Burchia's shortcomings.

- a. Petitioner Fails to Prove that Metabowerke Discloses "first coupler comprising two sidewalls...projecting above a depressed surface of the top face."
 - (1) At best, the Petition Demonstrates that Metabowerke Teaches a Single Sidewall.

The Petition reproduces Figures 1 and 4 of Metabowerke and concludes that Metabowerke's "rear recesses" disclose the claimed "sidewalls and the backwall projecting above a depressed surface of the top face." 1020 at ¶ 41; Pet. at 34. The Petitioner, in the labeled figures, refers to the "undercuts" of the "rear recesses" as disclosing a backwall and two sidewalls. 1020 at ¶ 41; Pet. at 34. However, there is insufficient evidence that Metabowerke discloses the claimed "two sidewalls."

Petitioner has highlighted, in yellow, one side wall and a second triangle region also annotated in yellow. Pet at 35.



Ex. 1006, FIG. 1, as modified in the Petition at page 35

There is insufficient evidence that the smaller yellow triangle region is a sidewall, as it is not possible to ascertain that this region, which is unlabeled and not textually described by Metabowerke, constitutes a “side wall” as claimed. Just like in the prior 962-IPR, at the level of detail provided in Metabowerke Figure 1, this region is “featureless and not amenable to meaningful interpretation.” Ex. 2002 at 1837. While the yellow triangle region could be an angled or flat plane, it could equally be an undercut, a hollow region, or not intended to depict any feature at all, let alone a sidewall projecting above a depressed surface of the top face and

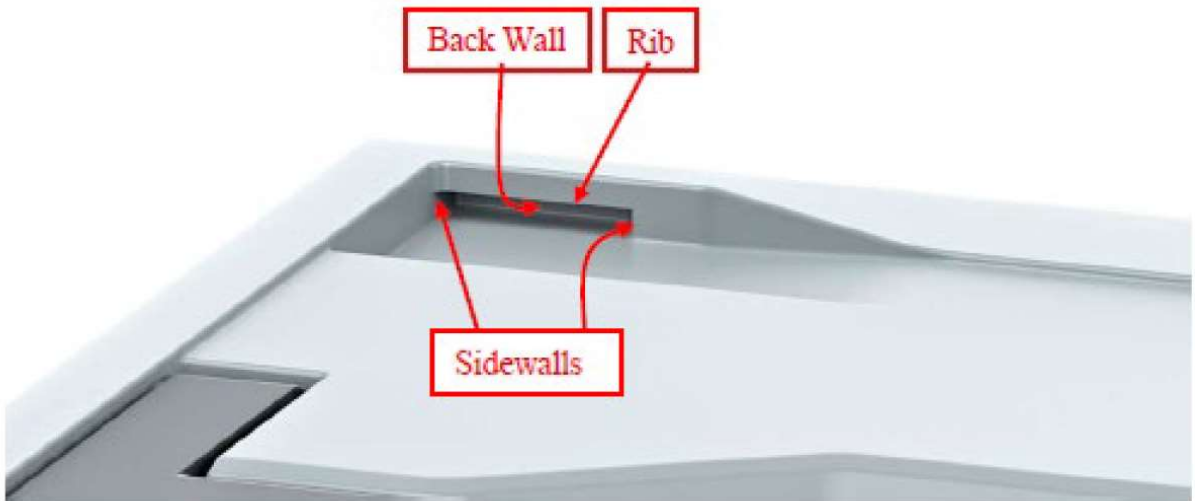
located at a side of a backwall. Metabowerke’s specification offers no description of this triangle region. The Petition offers a conclusory assertion, devoid of evidence, that Figure 1 of Metabowerke includes two sidewalls. This flaw—a complete lack of detail in Metabowerke—is fatal to the Petition’s reasoning on this ground, as a rationale for obviousness may not “resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”

In re Warner, 379 F.2d 1011, 1017 (C.C.P.A. 1967)

- (2) *The Petition’s argument that Metabowerke teaches a first coupler comprising two sidewalls suffers from the same deficiency that was rejected by the Board in 962-IPR.*

In fact, the Board denied institution in the related IPR for a nearly identical reason. In 962-IPR, the Board considered whether the Auer-Press and Madsen references “disclose[] with sufficient specificity a back wall, a rib, and **two sidewalls.**” Ex. 2002 (962-IPR denying institution decision) at 1836. With respect to the Auer Press reference, the Board stated:

We reproduce below a representative example of the images advanced by Petitioner and its witnesses:



Pet. at 15. The above image is a cropped and annotated version of an image reproduced from Auer-Press. See Ex. 1004, 18 (original image, without cropping or annotations supplied by Petitioner). Petitioner crops the image to emphasize a darkened rectangle located in the upper left-hand corner of a top surface of a toolbox or storage container system. Petitioner annotates the image to identify an asserted back wall, rib, and two sidewalls organized in precise relationship as specified in the challenged claims.

The darkened rectangular shape, upon which Petitioner relies, quite plainly, is **featureless and not amenable to meaningful interpretation**. See, e.g., Pet. 15 (attempting to map specified features to the darkened rectangular shape). Against that backdrop, **we cannot reasonably credit the declaration testimony** of [Petitioner's experts], **purporting to discern from this image** the specified features of **two sidewalls**, a rib, and a back wall **in the precise spatial or directional relationship** required by the claims.

Id. at 17-18.

Similarly, in considering the Madsen reference, the Board concluded that the “Petition does not show sufficiently that Madsen discloses two sidewalls, a rib, and a back wall in the specified spatial and directional relationship,” finding that the Petitioner relied on drawings of Madsen that provides inadequate information from which to discern two sidewalls in the claimed relationship. *Id.* at 21. To that end, the Board stated:

Petitioner directs us to no persuasive evidence that Madsen's Figures 9 and 17, which illustrate a front face of a stack of Madsen's containers, demonstrate the presence of sidewalls, a rib, and a back wall in the specified configuration. Instead, **Petitioner argues, with minimal objective support, that these figures disclose sidewalls** because Madsen illustrates the stack as a solid surface. Pet. 103–104. Petitioner reads into those figures a disclosure that is not there.

...

Petitioner's own annotation, characterizing that line as a sidewall, is ineffective because no disclosure in the asserted reference supports adequately that characterization.

Id. at 21-22.

Metabowerke suffers from the same fundamental shortcoming. The Petition in this case relies on annotated views of Metabowerke, but there is no disclosure in Metabowerke that adequately supports Petitioner's characterization. By relying on a similarly annotated image, unsupported by Metabowerke's own description, the

Petition makes the same error. The annotated small yellow triangle is “quite plainly...featureless and not amenable to meaningful interpretation.” *Id.* at 1837.

Thus, the Petition fails to meet its burden with respect to this element.

b. *Petitioner Fails to Prove that Burchia in view of Metabowerke Discloses this Limitation.*

As discussed above, Petitioner does not explain how either Burchia or Metabowerke, both of which were considered by the Examiner in this application and numerous related applications, discloses “the two sidewalls and the back wall projecting above a depressed surface of the top face.”

As such, Petitioner has failed to demonstrate that there is a reasonable likelihood that Burchia in view of Metabowerke discloses or otherwise renders obvious the claimed “two sidewalls...projecting above a depressed surface of the top face.”

iii. *The Petition Fails to Show that Burchia Discloses the Claimed Toggle Locking Latches*

Claim 1 requires each of the first and second containers have a **toggle locking latch** configured to latch the lid of each respective container in a closed position. Ex. 1001 at cl. 1. The Petition identifies closure elements 16 in Burchia as the claimed toggle locking latches and asserts that a “POSITA would understand

that ‘closure latches’ are a broader category which includes ‘toggle-locking latches.’” Pet. at 40-41, 52-53.

Burchia, however, in no way describes its closure latches 16 as toggle locking latches. Instead, Burchia merely states that “closure elements 16, such as closure latches, for example, can be provided.” Ex. 1004 at 9:12-15. Moreover, it is evident from Figure 1 that the closure elements 16 are not toggle locking latches at all. Claim 1 specifically requires toggle locking latches, not generic closure latches, on each of the first and second container. Burchia simply fails to disclose this.

Realizing this omission, Petitioner argues that it “would have been obvious to a POSITA to use toggle locking latches” and that a “POSITA would understand that **they are the same**” and then cites to a portion of the file history, including the Bensman reference. Pet. at 41-42. Petitioner continues, noting that a “POSITA would have been motivated to include Bensman’s toggle locking latches to enable the user to secure the lid in a closed position and easily open the lid by toggling the latch.” *Id.* at 43. First, Bensman is not included as a reference in this ground, and Petitioner has failed to explain how and why a POSITA would combine Bensman with the other references in this ground (e.g., no analogous art or even reasonable expectation of success assertions). Second, even if toggle locking latches were known in the art, Petitioner fails to provide an adequate explanation as to why a

POSITA would have been motivated to substitute the closure elements 16 in Burchia with a toggle locking latch, such as in Bensman, as Burchia already “enable[d] the user to secure the lid in a closed position and easily open the lid” *Id.* In particular, Burchia explains that its closure elements 16 secure the lid “to prevent unintentional opening relative to the lower part 4,” i.e., Petitioner provides no motivation why a POSITA would need to replace Burchia’s existing closure elements with a toggle locking latch, and instead resorts to ex-post facto reasoning. Ex. 1004 at 9:13-9:16. This lack of evidence cannot be remedied.

iv. *The Petition Suffers from a Complete Lack of Evidence That it Would Have Been Obvious to Modify Burchia with a “...first corner bumper...and...a second corner bumper”*

The Petition admits that Burchia does not teach corner bumpers, but asserts that “[i]t would have been obvious to a POSITA to include a first corner bumper, as such a bumper would provide additional protection to the corner of the container and was an obvious design option.” Pet. at 54. The Petition then cites the prosecution of the ‘952 patent, and, more specifically, a non-statutory double patenting rejection in which the Examiner stated it would have been obvious for a POSITA to “modify **the container of the U.S. Patent No. 11365026** with the corner bumpers of Welsh.” (Emphasis added) Ex. 1002 at 281.

This rationale suffers from a complete lack of evidence to support a conclusion that it would have been obvious, based on the references relied upon in

Ground 1, to modify Burchia with a "...first corner bumper...and...a second corner bumper." "[O]bviousness grounds cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Simply put, if the Petitioner believed that the Welsh reference rendered this limitation obvious in combination with Burchia and Metabowerke, Petitioner should have included Welsh in the ground by applying the *Graham* framework and articulating a rationale for why it would have been obvious to modify Burchia and Metabowerke with the alleged corner bumpers in Welsh. Petitioner has failed to do so.

Instead, Petitioner improperly takes the Examiner's double patenting rejection (which is factually and legally distinct from obviousness in view of Burchia) as evidence that it would have been obvious to modify *any* container with the corner bumpers of Welsh, and offers no evidence as to why the obviousness analysis for the '026 patent would hold true for Burchia here. Obviousness cannot be established by mere conclusory statements, "this analysis should be made explicit....there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 127 S. Ct. 1727, 1741, 167 L. Ed. 2d 705 (2007). Petitioners has failed to go through the requisite analysis needed to establish

obviousness in combining Burchia and Welsh, and thus the Board should deny this ground. *See Wells Fargo Bank, N.A. v. United Servs. Auto. Ass'n*, No. IPR2019-01082, 2020 WL 6937381, at *16 (P.T.A.B. Nov. 24, 2020) (holding that Petitioner's failure to articulate "a reasoned explanation why a relevant artisan would have been motivated" to combine two references does not meet the burden to establish obviousness).

Petitioner also states, in a footnote, that, "numerous references identified in Ex. 1003, ¶¶101-102 (Exs. 1025-1028) show the obviousness of adding corner bumpers to modular toolboxes." Pet. at 55. Again, these statements are conclusory and fall well short of the articulated reasoning needed to support a finding of obviousness, including a reasoned explanation of why a POSITA would have been motivated to modify Petitioner's combined references to additionally add yet other references and that such a combination, of all of these references, would lead to a reasonable expectation of success. Petitioner thus failed to meet its burden.

The Petitioner's expert declaration does nothing to cure these deficiencies, but instead parrots the conclusion, concluding that each of the references cited in the footnote also discloses corner bumpers, and that the limitation would have been obvious. Ex. 1003 (Expert Decl.) at 58, 59. These portions of the declaration, however, rely on the Petition's own annotations characterizing portions of the references as "corner bumpers," rather than teachings in the references

themselves. *Id.* at 60-63. And even if these portions could be considered corner bumpers, the declaration does nothing to articulate why a POSITA would have been motivated to modify the combination of Burchia and Metabowerke to further include the claimed corner bumpers. Further, the Petition fails to show how this overall combination of Burchia, Metabowerke, and each of the “numerous references” would have a reasonable expectation of success. Pet. at 55. Rather, the declaration states “it would have been obvious to a POSITA to look to [the references] for motivation to include and examples of corner bumpers in modular toolbox assemblies to protect said corners.” Ex. 1003 at 59. However, this conclusion relies on an improperly phrased standard (“obvious to a POSITA to look...for motivation” as opposed to articulating why “the claimed invention as a whole would have been obvious”) and does nothing to make up for the fact that these references have not been included in Ground 1, and that Petitioner has failed to even attempt to meet its burden. MPEP § 2141.02.

Thus, the Petition has not demonstrated by a preponderance of evidence that it would have been obvious to modify Burchia with a “...first corner bumper...and...a second corner bumper.”

- v. *The Petition Fails to Show that Burchia in view of Metabowerke Teaches or Suggests “a locking latch arresting location defined by one of the first container or the second container.”*

Claim 1 recites “a locking latch arresting location defined by one of the first container or the second container.” Per claim 1, the claimed container assembly also includes “a locking latch coupled to the other of the first container or the second container, the locking latch [i] positionable in a locked position engaging the locking latch arresting location [ii] thereby limiting sliding displacement of the first container with respect to the second container.”

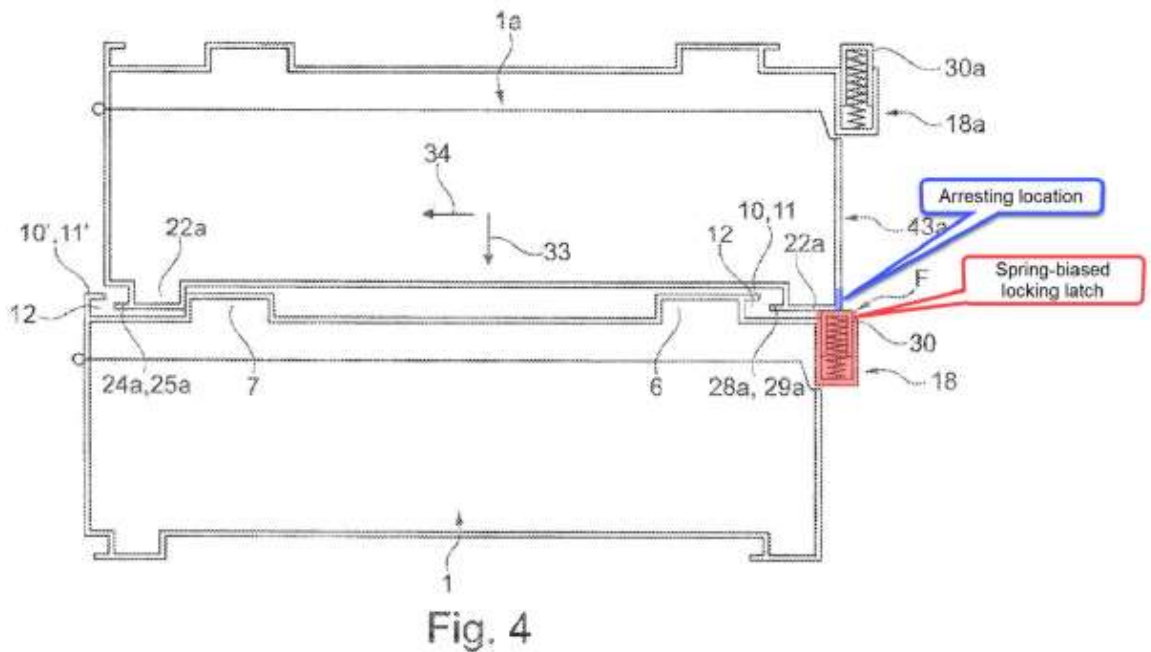
Ground 1 of the Petition relies exclusively on Burchia as teaching “a locking latch arresting location defined by one of the first container or the second container.” (Pet. at 58).

- a. *Petitioner Fails to Prove that Burchia Discloses “a locking latch arresting location **defined** by one of the first container or the second container.”*

Claim 1 requires that the container “define” the locking latch arresting location. *See* Ex. 2005 (New Oxford American Dictionary) at 3 (providing the plain and ordinary meaning of *Define* (verb) as: mark out the boundary or limits of; *Defined* (adj.) as: make clear the outline of; delineate).

The Petition reproduces Figure 4 of Burchia and incorrectly concludes that Burchia’s “locking element for securing the plug-in connection to prevent release”

discloses “a locking latch arresting location.” Pet. at 58. The modified version of Burchia reproduced in the Petition is shown below.



Ex. 1004, FIG. 4, as modified in the Petition at 59

But, it is self-evident from Petitioner's annotated figure that Burchia fails to *define* any location in the top container for arresting the locking latch. Petitioner's annotated blue region is nothing more than a portion of the face of Burchia's container, *i.e.*, the container fails to *define* any location for arresting the locking latch. As such, Burchia's container fails to *define* any location for arresting the locking latch, as required by the claim.

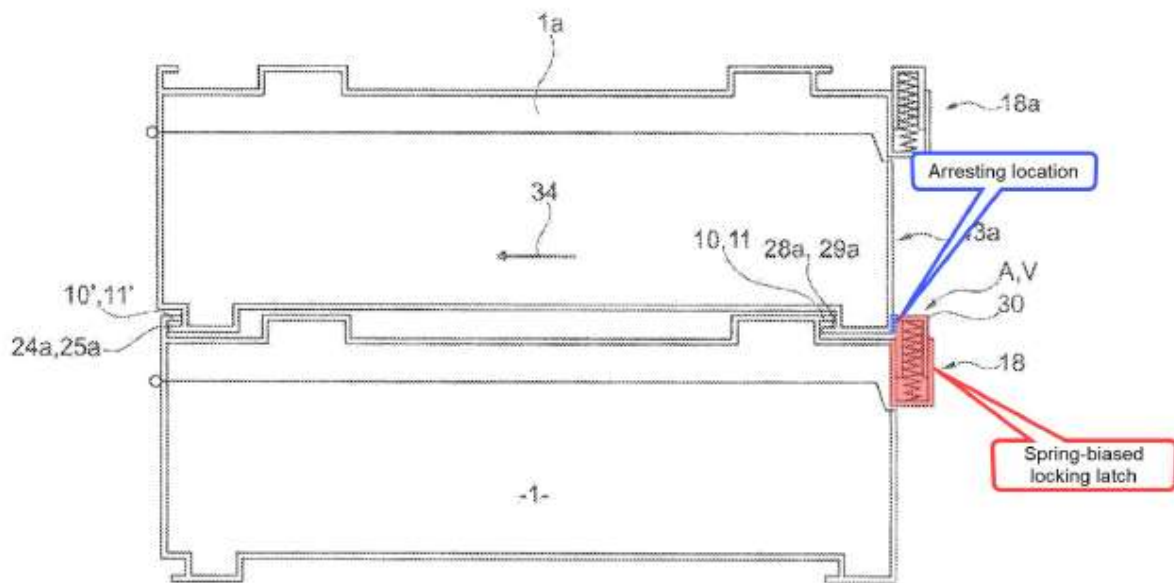


Fig. 5

Ex. 1004, FIG. 5, as modified in the Petition at 60

Realizing this deficiency, Petitioner next argues that because the specification teaches a potential “setback surface” that such a surface would also disclose a “locking latch arresting location.” Pet. at 61. But Burchia fails to provide any details regarding what it means by a setback surface, where the setback surface is located, how it functions with respect to any latch, and, most importantly, whether it defines a location that arrests the locking latch (i.e., a locking latch arresting location).

As such, the Petition fails to demonstrate that Burchia in view of Metabowerke discloses or otherwise renders obvious “a locking latch arresting location defined by one of the first container or the second container.”

vi. *The Petition Has Not Articulated a Sufficient Rationale Explaining Why or How One of Skill in the Art Would Combine Burchia and Metabowerke.*

Petitioner's argument as to why it would purportedly have been obvious to combine Burchia and Metabowerke is reproduced below:

POSITA would have been motivated to combine Burchia with Metabowerke as they both describe releasably stackable containers, such as toolboxes, with connectors on the lid of one connecting with the base of another. ... By using a smaller depressed surface instead of the larger depressed surface, Metabowerke **reduces the possibility of a protruding coupler being damaged**. It also **creates more contiguous space within the container to hold items....** A POSITA would have had a reasonable expectation of success in **substituting Metabowerke's coupler in the Burchia container**, because both container assemblies use the same type of coupling mechanism in that their ribs are engaged by a tongue protruding from the bottom of a top container. Accordingly, a POSITA could **take the face of Burchia's container and rather than extend the depressed surface across the entire length of the lid, simply include small, depressed surface like Metabowerke.**

Pet. at 26-27 (citations omitted) (colorized).

It is unclear from the above how Petitioners are even proposing to modify Burchia. First, Petitioner argues (in blue) that a POSITA would “substitut[e] Metabowerke’s coupler in the Burchia container.” *Id.* at 27. In other words, Burchia would remain the same, but its coupler replaced with that of Metabowerke. Second, Petitioner appears to argue (in green) that Burchia would remain the same, except that the rear portion of Burchia’s top face would be completely removed, the raised rib extended backwards, and Metabowerke’s depressions added, but the rest of Burchia’s coupler would remain the same. *Id.*

Addressing the first option, of replacing Burchia’s coupling mechanism with Metabowerke’s couplers, *writ large*, the proposed combination would suffer from the same deficiency as Metabowerke, namely that there is insufficient evidence that Metabowerke discloses a “first coupler comprising two sidewalls...projecting above a depressed surface of the top face.” Addressing the second option, i.e., removing the rear portion of Burchia’s top face, extending its raised rib backwards, adding Metabowerke’s depressions, and then leaving Burchia’s coupler, it is unclear how this would even work, as Burchia’s coupler extends from the top face of the container, not from a depression, like in Metabowerke, and it is unclear where Burchia’s couplers would be placed or why they would even be placed in a depression. Alternatively, if Petitioner is arguing that Burchia’s entire lid would be replaced by Metabowerke’s lid, the proposed combination lacks the features of

Burchia that Petitioner maps (incorrectly) to the claimed locking latch. While it is wholly unclear what this modification would be, in all possible cases, the proposed combination would not lead to the claimed invention.

Finally, courts have denied obviousness challenges—like the one presented in the Petition—that are based solely on ex post facto reasoning supported only by conclusory expert testimony. In *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327-28 (Fed. Cir. 2012), the Federal Circuit stated:

Although Verizon's expert testified that '[t]hese are all components that are modular, and when I add one, it doesn't change the way the other one works,' he never provided any factual basis for his assertions. The expert failed to explain how specific references could be combined, which combination(s) of elements in specific references would yield a predictable result, or how any specific combination would operate or read on the asserted claims. Rather, **the expert's testimony on obviousness was essentially a conclusory statement that a person of ordinary skill in the art would have known, based on the 'modular' nature of the claimed components, how to combine any of a number of references to achieve the claimed inventions. This is not sufficient and is fraught with hindsight bias.**

The benefits of the proposed combination that the Petition touts are not identified in the cited references, nor are the problems that the proposed combination purports to solve. Petitioner's conclusory and unsupported statements amount to ex post facto reasoning that falls well short of the level of detail and specificity required, and the Board should deny institution. *See Shopkick, Inc. v. Novitaz, Inc.*, IPR2015-00279, Paper 7 at 29-30 (PTAB May 29, 2015) (denying institution and explaining that "conclusory labels do not substitute for a fact-based analysis...establishing what is being modified and why, based on the differences between the prior art and the claimed invention, it would have been obvious to a person of ordinary skill to make the modification").

In particular, Petitioner's ex post facto reasoning that a protruding coupler may possibly be damaged is completely speculative and even nonsensical, as Metabowerke includes numerous other protruding features and sharp edges that it never once mentions as protrusions that can lead to damage. *See, e.g.*, Ex. 1020 at ¶ 6 (disclosing "at least one standing foot for placing the container on a surface or on a cover of another similar container"); Ex. 1020 at ¶ 41 (disclosing "a lateral carrying handle"). Petitioners other ex-post facto reason that the modification creates more contiguous space within the container to hold items, is also unreasonable, as Metabowerke has multiple depressed surfaces, including a large area for the handle that also reduces the contiguous space in the container, and

Metabowerke does not express any concern about losing interior space due to these elements, and this purported problem can just as easily be addressed by creating a slightly larger container. *See id.* (disclosing “a cover carrying handle 5 which is pivotably arranged in the cover 2).

vii. *Dr. Collins's Testimony Should Be Given Little, If Any, Weight.*

The Board should afford the testimony of Petitioner's expert, Dr. John M. Collins, little (if any) weight because Dr. Collins's declaration parrots the Petition, does not identify any additional facts or information supporting the Petition's assertions, and provides only conclusory testimony. The Director recently designated as precedential the Board's *Xerox v. Bytemark* decision finding that conclusory and unsupported testimony should be afforded little or no weight. *XEROX Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2023) (precedential) (“[T]he cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.”) (collecting cases).⁴ Dr. Collins's

⁴See also <https://www.uspto.gov/subscription-center/2023/director-vidal-designates-precedential-decision-regarding-declaration> (“In this decision denying institution of *inter partes* review, the Board determined that the testimony of a declarant that merely repeats, verbatim, conclusory assertions from a petition,

declaration mostly recites *verbatim*⁵ the language in the Petition and falls squarely within this precedential *Xerox* decision.

Therefore, Dr. Collins's testimony cannot save the Petition's deficiencies, described herein, and, for this independent reason, the Board should deny institution. *See, e.g., Markforged Inc. v. Continuous Composites, Inc.*, IPR2022-01431, Paper 7 at 14 (PTAB Jan. 18, 2023).

B. Claims 2-8

Claims 2-8 depend from and include each limitation of claim 1. Thus, the Board should deny institution of Ground 1 with respect to claims 2-8 for at least the same reasons as described above with respect to claim 1.

without citing additional supporting evidence or providing technical reasoning to support the testimony, is entitled to little weight.”).

⁵The only notable differences are ones in exhibit labeling nomenclature and some small typographical changes.

C. Claim 9

Claim 9 mirrors the limitations of claim 1 discussed in sections A.ii-A.iii and section A.v.⁶ Thus, the Board should deny institution of Ground 1 with respect to claim 9 for at least the same reasons as described above with respect to claim 1.

D. Claim 10-16

Claims 10-16 depend from and include each limitation of claim 9. Thus, the Board should deny institution of Ground 1 with respect to claims 10-16 for at least the same reasons as described above with respect to claim 9.

E. Claim 17

Claim 17 mirrors the limitations of claim 1 discussed in sections A.ii-A.iii and section A.v.⁷ Thus, the Board should deny institution of Ground 1 with respect to claim 17 for at least the same reasons as described above with respect to claim 1.

⁶Claim 9 does not include the “first corner bumper...and...a second corner bumper” limitation discussed in section iv, and thus the arguments in section iv do not apply to Claim 9.

⁷Claim 17 does not include the “first corner bumper...and...a second corner bumper” limitation discussed in section iv, and thus the arguments in section iv do not apply to Claim 17.

F. Claim 18-23

Claims 18-23 depend from and include each limitation of claim 17. Thus, the Board should deny institution of Ground 1 with respect to claims 18-23 for at least the same reasons as described above with respect to claim 17.

**VIII. GROUND 2: BURCHIA, METABOWERKE, AND LAFRAGETTE
FAIL TO RENDER OBVIOUS CLAIMS 1-23**

A. Claim 1

In asserting Ground 2, the Petition, correctly intuiting Patent Owners's position that Burchia lacks an "arresting location," argues that it would have been obvious to modify Burchia according to Lafragette's teaching to include a recess as an arresting location. Pet. at 89. Lafragette, however, does not cure the deficiencies of Ground 1.

i. The Petition Fails to Establish the Graham Factors By Not Identifying the Differences Between the Claimed Subject Matter and the Prior Art

Petitioner has once again failed to comply with at least the second *Graham* factor by failing to identify the differences between the claimed subject matter and the prior art.

As was previously discussed, Petitioner asserts that Burchia discloses each and every element of the independent claims. Pet. at 25. Just as with the combination of Burchia and Metabowerke in Ground 1, Petitioner fails to identify

with the required specificity what claim element(s) are purportedly missing from one reference and disclosed by another reference. Petitioner, therefore, fails to comply with at least the second *Graham* factor because Petitioner has not identified the differences between the '952 Patent and Burchia and/or Lafragette.

The Board should thus again deny institution for Petitioner's failure to establish the *Graham* factors by failing to identify what claim elements are missing from the prior art.

ii. *One of Skill in the Art Would Not Have Combined Burchia with Lafragette Because Lafragette is Non-Analogous Art.*

For a *prima facie* case of obviousness, the gating requirement is that the prior art applied must be "either in the field of applicant's endeavor or be reasonably pertinent to the particular problem with which the applicant was concerned." MPEP § 2141; *see also In re Klein*, 642 F.3d 1343 (Fed. Cir. 2011).

a. *Lafragette Is Not in the Same Field of Endeavor.*

When determining whether the "relevant field of endeavor" test is met, the Board should consider "explanations of the invention's subject matter in the patent application, including the embodiments, function, and structure of the claimed invention." *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1380 (Fed. Cir. 2019) (quoting *Bigio*, 381 F.3d at 1325). When determining whether a prior art reference meets the "same field of endeavor" test for the analogous art, the primary focus is

on what the reference discloses. *Id.* The examiner must consider the disclosure of each reference “in view of ‘the **reality of the circumstances.**’” *Id.* These circumstances are to be weighed “from the vantage point of the **common sense** likely to be exerted by one of ordinary skill in the art in assessing the scope of the endeavor.” *Id.*; *see also Donner Technology, LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 2020 (Fed. Cir. 2020).

The '952 patent's Technological Field is described as “a container assembly and more specifically to a **utility assembly** comprising **two or more detachably attachable utility modules**...such as, **storage containers, travel luggage, tool boxes, organizers, compacted work benches, cable storage, tools** (e.g. hand tools, power generators and power sources), **communication modules, carrying platforms, locomotion platforms** [i.e., not stationary],...wherein any utility module can be detachably attached to any other utility module.” Ex. 1001 at 1:27-1:40. The claims of the '952 patent relate to a “container assembly.” *Id.* at cl. 1. In particular, the claims are directed to embodiments exemplified in, for example, FIGS. 1A to 6F of the '952 patent, which show multiple containers, each having a lid, that are independently attachable and detachable. In some embodiments, these containers include, e.g., “a handle coupled to a front face of the first container.” *Id.* at cl. 5.

Lafragette, on the other hand, concerns “a connection device for an electronic box.” Ex. 1005 (Lafragette) at ¶ 1. Lafragette’s electronic box has two parts that electrically connect to one another, and are configured to be permanently mounted in an electrical cabinet. *Id.* This is wholly unrelated to the field of the ’952 patent.

In particular, Lafragette notes that “The object of the invention is to provide **a connection device for an electronic box**, comprising **a connection module that can be wired before it is fitted onto the box** and which can be disconnected from the box simply and quickly, without any deterioration and without requiring to disconnect the conducting cables.” *Id.* at ¶ 5. Lafragette’s goal is to provide “an **electrical connection** with, on the one hand, pins (7) projecting from this longitudinal assembling face and, on the other hand, with conducting cables.” *Id.* at ¶ 38. “This **connection** is reversible as all that is required is to rock the resilient tab 18, for example **using a Screwdriver**, in order to disengage it from the recess 10, before moving the module 12 longitudinally in order to allow the returns 16 to escape from the lugs 9 on the box and to pull the module transversely in order to allow access to the box.” *Id.* at ¶ 33.

The Petition states “Bensman, Burchia, Metabowerke, Lafragette and the ’952 patent are in the analogous field of connectable containers.” Pet. at 101. But Lafragette is clearly not in the same field as the ’952 patent, and to define the

field so broad as to include any “connectable containers” would include, inter alia, shipping containers loaded onto cargo ships, modular (e.g., staged) rockets, modular mobile homes, trucks and trailers, railway cars, nesting shopping carts, or the like. The “reality of the circumstances” and “common sense,” however, dictate that Lafragette’s electrical boxes are not within the same field of endeavor as the ’952 patent, and that these boxes are not, for example, storage containers, travel luggage, tool boxes, organizers, etc. Lafragette’s electronic box is mounted in a cabinet or to a wall and are not utility containers for carrying things around. Ex. 1005 at ¶ 1. Lafragette’s problem of a “connection module that can be wired before it is fitted onto the box and which can be [electrically] disconnected from the box simply and quickly, without any deterioration and without requiring to disconnect the conducting cables,” is wholly unrelated to how to couple storage containers to one another so that they can be rolled around a job site without detaching. *Id.* at ¶ 5. Moreover, Lafragette’s electronic box is designed with electrical safety in mind, and requires some effort, e.g., using a screwdriver, to be detached. *Id.* at ¶ 33. In designing the containers of the ’952 patent, one of skill in the art at the time the invention was made would be concerned with the ability to quickly, repeatedly, and securely attach and detach containers from one another at a job site.

Because electronic boxes mounted within a cabinet are completely different than the utility assembly recited in the claims, a POSITA would never consider

Lafragette to be within the same field of endeavor as the ’952 patent, and, as such, would never have looked to Lafragette to modify Burchia and/or Metabowerke.

- b. *Lafragette is not reasonably pertinent to the particular problem with which the applicant was concerned.*

As for the “reasonably pertinent” test, the Board should consider the problem faced by the inventor, as reflected—either explicitly or implicitly—in the specification. In order for a reference to be “reasonably pertinent” to the problem, it must “logically...have commended itself to an inventor’s attention in considering his problem.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379-80 (Fed. Cir. 2007) (quoting *In re Clay*, 966 F.2d 656,658, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992)). See also *In re Klein*, 647 F.3d 1343, 1348, 98 USPQ2d 1991, 1993 (Fed. Cir. 2011). An inventor is not expected to have been aware of all prior art outside of the field of endeavor. *Airbus*, 941 F.3d at 1380-82. A reference outside of the field of endeavor is reasonably pertinent if a person of ordinary skill would have consulted it and applied its teachings when faced with the problem that the inventor was trying to solve. *Id.*

The problem faced by the inventors of the ’952 patent, either explicitly or implicitly, was to provide storage containers having lids and handles, and in some cases wheels, that were easily attachable and detachable from one another. Lafragette’s stationary electrical connection box that required “for example using a

Screwdriver, in order to disengage it” would not have logically commended itself to the inventors’ attention because it does not address the problems and needs faced by the inventors of the ‘952 patent, as it would be highly inconvenient to require a screwdriver or other similar implement to disengage the types of container assemblies described in the ‘952 patent. As such, one of skill in the art would not have looked to the teachings of Lafragette to address the problems faced by the inventors of the ‘952 patent, and thus Lafragette is not reasonably pertinent to the particular problem with which the applicant was concerned.

As such, Petitioner has failed to demonstrate that a POSITA would have been motivated to modify Burchia or Metabowerke in view of Lafragette, since Lafragette is non-analogous art. Thus, this ground must fail as it relies entirely on the combination of Burchia and Metabowerke with the non-analogous Lafragette reference.

iii. *The Petition Has Not Articulated a Sufficient Rationale Explaining Why One of Skill in the Art Would Combine Burchia, Metabowerke, and Lafragette.*

Petitioner has failed to adequately explain why a POSITA would have been motivated to modify Burchia or Metabowerke in view of Lafragette in such a way that would render obvious this limitation. The Petition states:

And it would have been obvious to POSITA to include a recess, as taught in Lafragette, in the bottom face of Burchia’s top container as an arresting location for

Burchia's locking latch, **because a recess would provide additional protection for the latch** itself (e.g., to prevent inadvertent disassembly) **and provide additional lateral force opposing lateral movement of the containers.**

Pet. at 89-90.

But Burchia already describes a locking element 18 disposed in a recess 17⁸ on the front side 43 of the suitcase. Ex. 1004 at 11:52-11:54. Thus, Burchia already achieves the purported motivation of providing additional protection for the latch that Petitioner claims Lafragette would purportedly add. Moreover, making such a modification, as discussed above, would make it more difficult to access the sliding part 30 needed to be depressed to release the containers. *Id.* at 13:9-13:16.

Further, this modification would render Burchia unsuitable for its intended purpose of easily connecting and disconnecting the containers by requiring Lafragette's use of "a Screwdriver, in order to disengage [resilient tab 18] from the recess 10." Ex. 1005 at ¶ 33. This, again, reflects the fact that Lafragette concerns a very different type of box (an "electronics box") as compared to Burchia's "suitcase." Ex. 1004 at 1:15; Ex. 1005 at ¶ 1. Given the differences in design considerations for these different types of boxes and containers, not the least of

⁸ Burchia's recess 17 is not "a locking latch arresting location," because it does arrest the locking latch.

which is the inconvenience of requiring a screwdriver to uncouple storage containers from one another, one of skill in the art would not have been motivated to modify Burchia by replacing its locking mechanisms with Lafragette's electronic box locking mechanism because doing so would render Burchia unsuitable for its intended purpose.

iv. Dr. Collins's Testimony Should Be Given Little, If Any, Weight

The arguments made in Section VII.A.vii, above, apply with equal weight to Ground 2. Thus, the Board should afford the testimony of Petitioner's expert, Dr. John M. Collins, little (if any) weight for the same reasons as set forth with respect Ground 1.

B. Claims 2-8

Claims 2-8 depend from and include each limitation of claim 1. Thus, the Board should deny institution of Ground 2 with respect to claims 2-8 for at least the same reasons as described above with respect to claim 1.

C. Claim 9

Claim 9 mirrors many of the limitations of claim 1. Thus, the Board should deny institution of Ground 2 with respect to claim 9 for at least the same reasons as described above with respect to claim 1.

D. Claim 10-16

Claims 10-16 depend from and include each limitation of claim 9. Thus, the Board should deny institution of Ground 2 with respect to claims 10-16 for at least the same reasons as described above with respect to claim 9.

E. Claim 17

Claim 17 mirrors many of the limitations of claim 1. Thus, the Board should deny institution of Ground 2 with respect to claim 17 for at least the same reasons as described above with respect to claim 1.

F. Claim 18-23

Claims 18-23 depend from and include each limitation of claim 17. Thus, the Board should deny institution of Ground 2 with respect to claims 18-23 for at least the same reasons as described above with respect to claim 17.

IX. GROUND 3: BURCHIA, METABOWERKE, AND CHEN FAIL TO RENDER OBVIOUS CLAIMS 1, 10, AND 18

A. Claim 1

- i. The Petition Fails Explain How Burchia, Metabowerke, and Lafragette, Would be Combined With Chen to Disclose "...first corner bumper...and...a second corner bumper"*

With respect to Ground 3, after repeating the assertion that it would have been obvious "to include corner bumpers, such as those disclosed in Welsh,"

(which fails for the same reasons as previously described in section VII.A.iv), the Petition states, “[f]urther, it would have been obvious to a POSITA to combine Burchia (or Metabowerke) with Chen.” Pet. at 96. The Petition’s only evidence for this assertion is the “Chen discloses the use of corner bumpers in a modular container assembly” and that “[a] POSITA would have had a reasonable expectation of success because of the straightforward mechanical technology, and the corner bumpers would have predictably protected the corners of the modular toolboxes from damage.” *Id.* at 96-98.

Petitioner, however, fails to articulate *how* the proposed combination of Burchia and Metabowerke would be modified. For example, Burchia’s figures make it entirely unclear how such corner bumpers would be applied. Consider Figure 1 of Burchia, as annotated in the Petition, reproduced below:

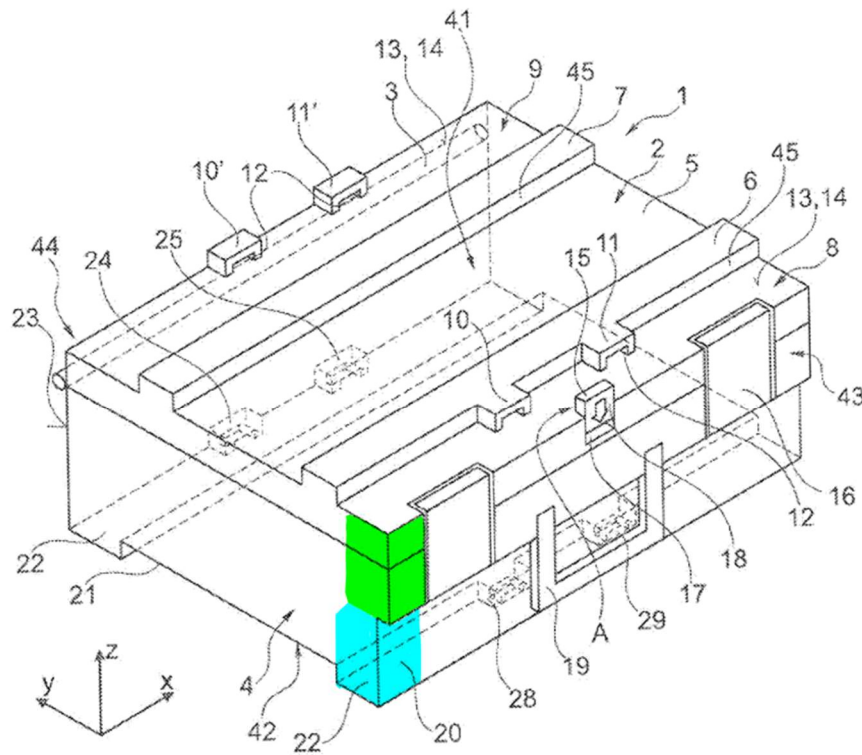


Fig. 1

Ex. 1004, Fig. 1 (colorized)

Given that Burchia’s “stop surface 20” is “offset toward the rear in the Y direction,” it is not clear how Chen’s corner bumper’s would be applied such that Burchia’s “locking element” would still be able to “lie against the stop surface 20a ... secur[ing] the coupling connection between the suitcases 1 and 1a to prevent unintentional disengagement.” Ex. 1004 at 12:62-13:8. The Petition does not explain how this modification would work, only saying that the modification would provide “additional protection to the corner of the container and was an obvious design option.” Pet. at 54.

As such, with respect to Ground 3, the Petition's allegations in relation to "...first corner bumper...and...a second corner bumper" amount to nothing more than an assertion that corner bumpers were well-known, but fall short of "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977 at 988.

B. Claim 10

Claim 10 mirrors the limitation of claim 1 discussed in section A.i. Thus, the Board should deny institution of Ground 1 with respect to claim 10 for at least the same reasons as described above with respect to claim 1.

C. Claim 18

Claim 18 mirrors the limitation of claim 1 discussed in section A.i. Thus, the Board should deny institution of Ground 1 with respect to claim 18 for at least the same reasons as described above with respect to claim 1.

X. GROUND 4: BURCHIA, METABOWERKE, AND LIN FAIL TO RENDER OBVIOUS CLAIMS 4 AND 13

Claims 4 and 13 depend from and include each limitation of claim 1 and claim 9, respectively. The Petition does not allege that Lin addresses the shortcomings of Burchia and Metabowerke. Thus, the Board should deny institution of Ground 4 for at least the same reasons as described above with respect to Ground 1.

XI. GROUND 5: BURCHIA, METABOWERKE, AND BENSMAN FAIL TO RENDER OBVIOUS CLAIMS 8, 16, AND 23

Claims 8, 16, and 23 depend from and include each limitation of claim 1, claim 9, and claim 17 respectively. The Petition does not allege that Bensman addresses the shortcomings of Burchia and Metabowerke. Thus, the Board should deny institution of Ground 5 for at least the same reasons as described above with respect to Ground 1.

XII. GROUND 6: METABOWERKE, BURCHIA, AND LAFRAGETTE FAIL TO RENDER OBVIOUS CLAIMS 1 TO 23

A. Claim 1

- i. The Petition Fails to Establish the Graham Factors By Not Identifying the Differences Between the Claimed Subject Matter and the Prior Art*

Petitioner has once again failed to comply with at least the second *Graham* factor by failing to show the differences between the claimed subject matter and the prior art.

As was previously discussed, Petitioner alleges that Metabowerke discloses **all claim limitations except a spring-biased locking latch**. Pet. at 102. (“Ground 6 relies primarily on Metabowerke as disclosing all claim limitations. However, Metabowerke does not expressly disclose a spring-biased locking latch.”) Petitioner also asserts that Burchia **discloses all claim limitations**. Pet. at 25. Just as with the combination of Burchia and Metabowerke in Ground 1, the Petitioner

also fails to identify with the required specificity what claim element(s) are purportedly missing from one reference and disclosed by another reference (*i.e.* what is purportedly missing from Metabowerke that would need to be disclosed by Burchia and/or Lafragette, and what is missing from Burchia that would need to be disclosed by Lafragette). Petitioner, therefore, fails to comply with at least the second *Graham* factor because Petitioner has not identified the differences between the '952 Patent and Metabowerke, Burchia, and/or Lafragette.

The Board should deny institution on Ground 6 for Petitioner's failure to establish the *Graham* factors by failing to identify the differences between the claimed invention and the prior art.

ii. *The Petition Has Not Articulated a Sufficient Rationale Explaining Why One of Skill in the Art Would Combine Metabowerke, Burchia, and Lafragette.*

Petitioner does not explain why a POSITA would have been motivated to modify Metabowerke in view of Burchia or Lafragette in such a way that would render obvious the claim limitations. Petitioner instead states:

A POSITA, however, would have readily modified Metabowerke according to the teachings of Lafragette (or Burchia) to include a spring-biased locking latch. A spring-biased locking latch would **facilitate quicker locking** when the top container is placed on the bottom container, rather than requiring a user to manually lock the latch in place. A POSITA could have readily modified Metabowerke to include the spring-biased locking latch of Lafragette, which is a resilient tab

protruding from a second container that **engages a recess** on the top of the first container **when** the containers are brought together and **slid backwards**.

Pet. at 102-103 (citations omitted).

Petitioner therefore asserts that Metabowerke could be combined with Lafragette for “quicker locking.” It is not clear, however, that Lafragette’s spring-biased locking latch **could operate**, let alone facilitate quicker locking when combined with Metabowerke’s system. Rather, this assertion relies on conclusory testimony from Petitioner’s expert. Petitioner and its expert fail to provide any explanation of how the new proposed combination of Metabowerke, Burchia, and Lafragette would be combined, let alone how it would allow for “quicker locking” than Metabowerke alone or how it would even operate given Metabowerke’s container design. And, especially in the case of Lafragette’s locking mechanism, the process of detaching is far more cumbersome and requires the use of a screwdriver, thus undermining Petitioner’s rationale.

Further, as shown in Ground 2, Lafragette is non-analogous art and thus a POSITA would never have looked to Lafragette, let alone tried to combine the reference with Metabowerke and Burchia.

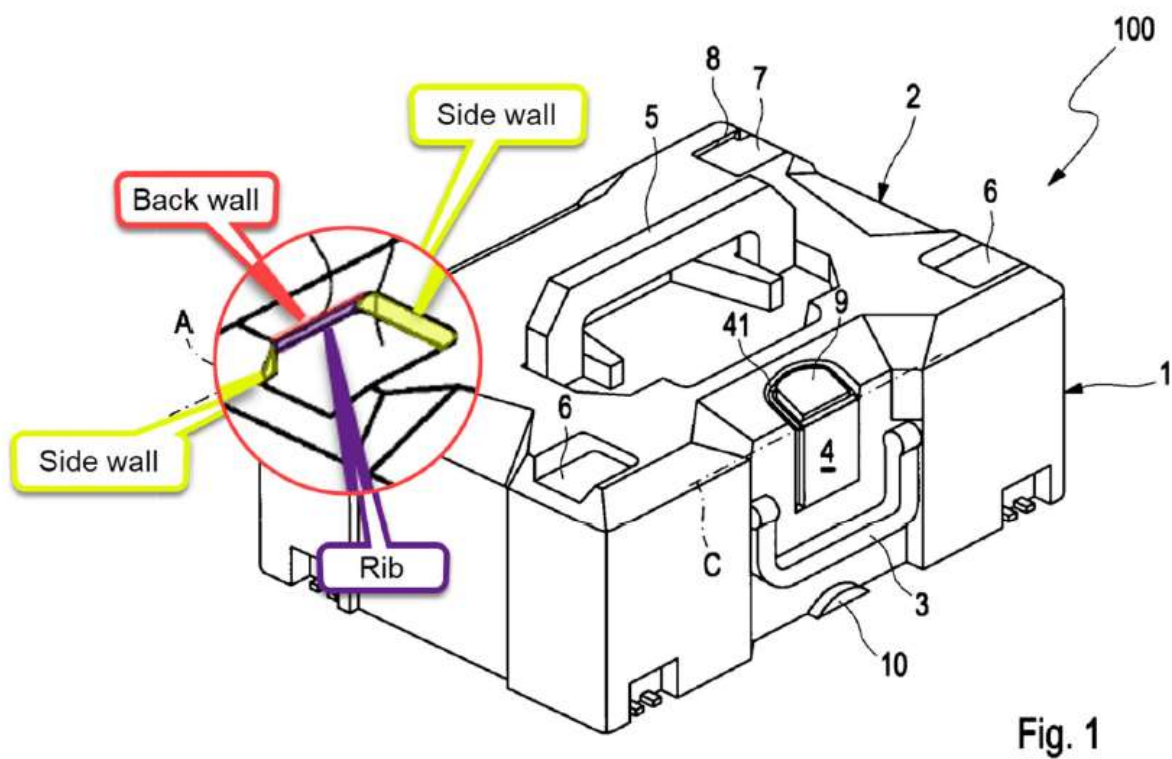
Again, the Board should deny institution because the Petitioner’s conclusory and unsupported statements on **why** a POSITA would look to other container

assembly implementations fall well short of the level of detail and specificity required. *See Shopkick*, IPR2015-00279, Paper 7 at 29-30.

iii. *The Petition Fails to Show that Burchia in View of Metabowerke Renders Obvious the Claimed “two sidewalls... projecting above a depressed surface of the top face.”*

With respect to Ground 6, Petitioner relies solely on Metabowerke as teaching this limitation of claim 1. Pet. at 106-113. As discussed previously in Ground 1, ***Petitioner Fails to Prove that Metabowerke Discloses This Limitation.*** From Metabowerke's labeled figures and the specification, there is insufficient evidence that Metabowerke discloses “two sidewalls.”

In stating Ground 6, unlike in Ground 1, Petitioner also reproduces, *inter alia*, Figure 5 (in addition to Figure 1) of the Metabowerke reference. Once again, the highlighted yellow portions of Petitioner's annotated version of Metabowerke, Figure 5, do not show “two sidewalls.” The two annotated figures from Metabowerke relied upon by the Petition are reproduced below.



Ex. 1006, Fig 1, as modified in the Petition at page 108.

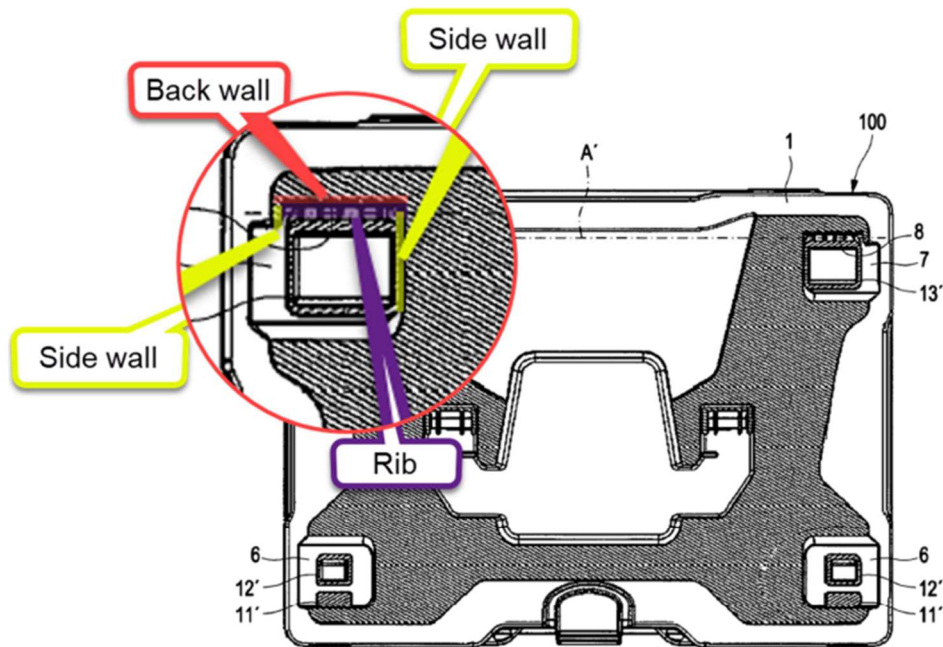


Fig. 5

Ex. 1006, Fig. 5, as modified in the Petition at page 109.

First, it is worth noting that the two smaller highlighted portions in annotated Figures 1 and 5, respectively, correspond to completely different features, as the smaller yellow highlighted region shown in Figure 5 would not be visible in the perspective view provided in Figure 1.

Second, given the top-down perspective of Figure 5, it is not possible to ascertain whether the smaller highlighted yellow region constitutes a second side wall projecting above a depressed surface of the top face. The Petition simply speculates and assumes that Figure 5 of Metabowerke implies this feature. For

example, a top down view of the canopy tent shown below would also illustrate four *edges*, but the canopy tent has no walls whatsoever, much less walls that project from the ground.



Image of a canopy tent, in the public domain, available at

https://upload.wikimedia.org/wikipedia/commons/b/bb/High_peak_frame_tent.JPG.

In an analogous manner, it is not possible to tell from Figure 5 of Metabowerke whether the alleged second side wall is a sidewall at all, much less a sidewall “projecting above a depressed surface of the top face.” The region could

simply overhang, a cavity, or something else. The reference provides no description whatsoever for this region.

This flaw in the Petition's reasoning is fatal to its argument, as a rationale for obviousness may not "resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Warner*, 379 F.2d 1011 at 1017. Thus, the Petition has not met its burden with respect to this element.

iv. The Petition Fails to Show that Metabowerke in View of Burchia and Lafragette Teaches or Suggests "a locking latch"

Claim 1 requires a locking latch. Petitioner fails to show that Metabowerke, or Metabowerke in view of Burchia and/or Lafragette, discloses or otherwise renders obvious "a locking latch."

Petitioner Fails to Prove that Metabowerke Discloses This Limitation. The Petition reproduces Figures 1 and annotates in red what it believes serves as the locking latch in Metabowerke, i.e. "buckle 4." Pet. at 127.

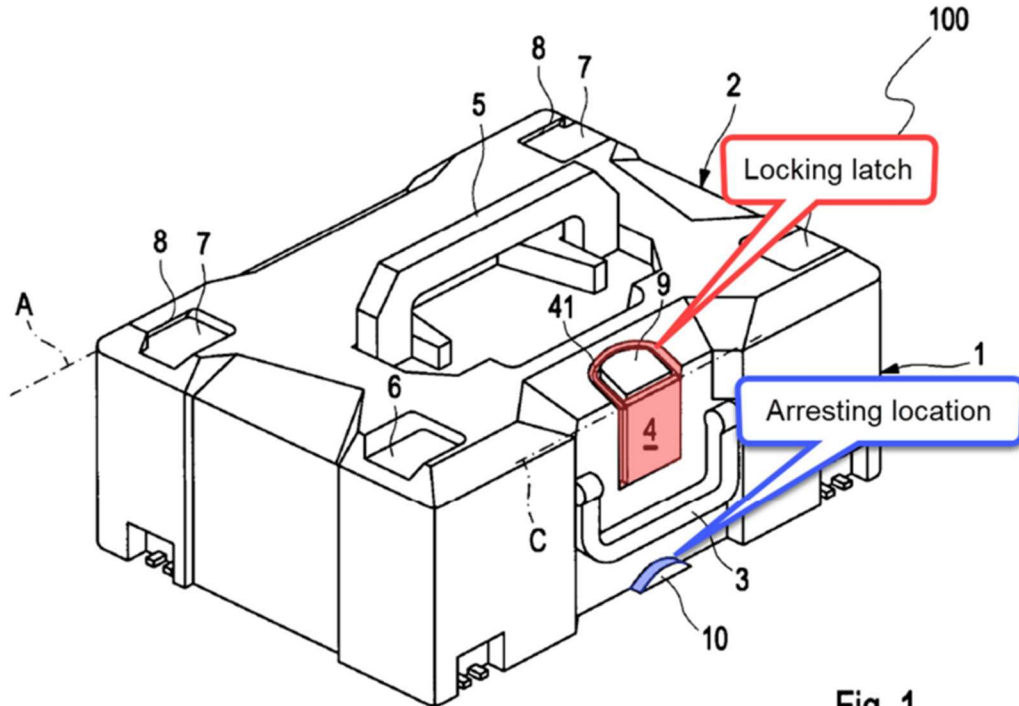


Fig. 1

Ex. 1006, Fig. 5, as modified in the Petition at page 127.

However, the Petition relies on the exact same “buckle 4” within the exact same figure as the separately claimed “toggle locking latch.” Pet. at 117.

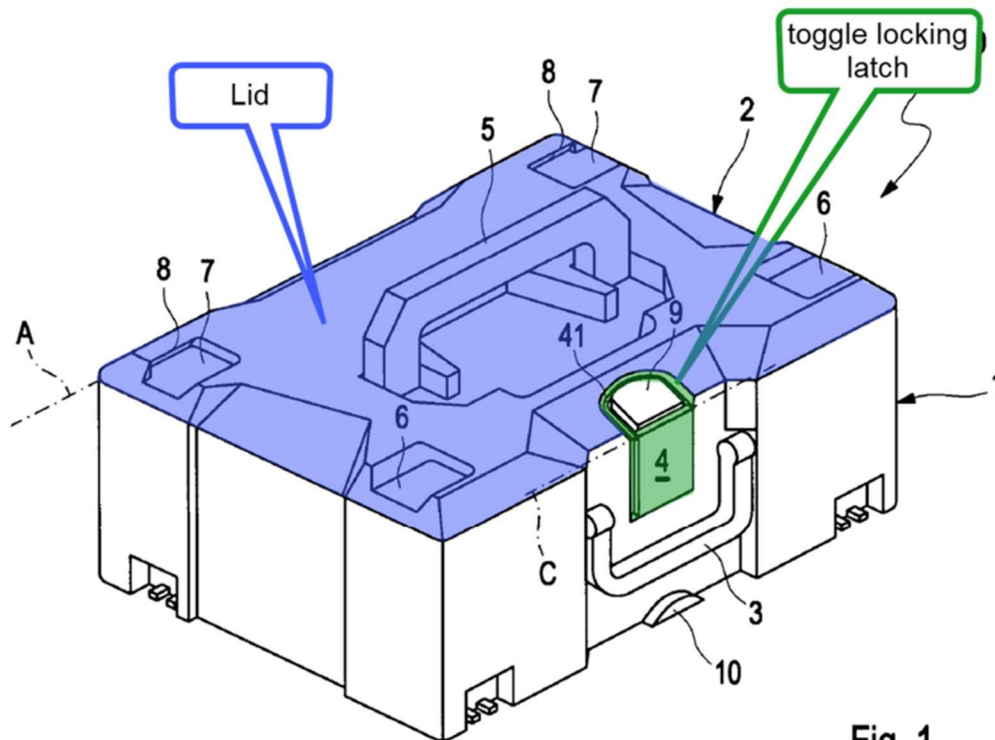


Fig. 1

Ex. 1006, Fig. 1, as modified in the Petition at page 117.

This same “buckle 4” cannot be both the claimed toggle locking latch required by each container to lock the container’s lid, and simultaneously be the claimed locking latch for locking containers together. Even if this mechanism in Metabowerke met the limitations of the claim, which it does not, it can only perform one of these functions at any one time, and as such, cannot simply disclose both of the claim elements. *See Lantech, Inc. v. Keip Machine Co.*, 32 F.3d 542, 547 (Fed. Cir. 1994) (holding that a single conveyor could not fulfill the separate claim elements of two conveyors). Thus, the Petition simply fails to show that

Metabowerke discloses both a “locking latch,” and a “toggle locking latch” for each container.

Moreover, without a consistent mapping of what is the locking latch and what is the toggle locking latch, it cannot be said that Metabowerke teaches “**a locking latch.**”

- v. *A POSITA Would Not Have Been Motivated to Modify Metabowerke to Use a Recess as a Locking Latch Arresting Location*

Petitioner identifies locking tab 10 in Metabowerke as the claimed locking latch arresting location and then inexplicably argues that a POSITA would have been motivated to modify Metabowerke to include Burchia's setback recess or Lafragette's locking latch arresting location as the claimed locking latch arresting location “because a recess would provide additional protection for the latch itself.” Pet. at 128.

Petitioner Fails to Prove That One of Skill in The Art Would Have Combined Metabowerke with Lafragette. Again, as discussed in section VIII.A.ii, Lafragette is non-analogous art and thus it would ***not*** have been obvious for a POSITA to combine the reference with Metabowerke and Burchia.

As such, Petitioner has failed to demonstrate that there is a reasonable likelihood that Metabowerke alone or in combination with Burchia and/or

Lafragette discloses or otherwise renders obvious “a locking latch arresting location defined by one of the first container or the second container.”

Moreover, making a substitution in Metabowerke to replace the tab 10 with a recess would render the containers of Metabowerke inoperable as they are designed to be used. As Metabowerke explains, a “coupling tab 10 in the lower region of the base part 1” of the container “serves to lock two stacked containers 100, 100’ against each other, as shown in Fig. 2” because, as seen in Figure 2, “clip 41 grips around the coupling tab 10.” Ex. 1020 at ¶ 42 (emphasis added). Thus, Metabowerke relies on the tab 10 to enable clip 41 to clip around it and keep the containers engaged. Replacing tab 10, as Petitioner suggests, with a recess would not provide the means for the clip to engage the containers and keep them together. A POSITA would thus not have been motivated to make this change or had a reasonable expectation of success in such a modification.

B. Claims 2-8

Claims 2-8 depend from and include each limitation of claim 1. Thus, the Board should deny institution of Ground 6 with respect to claims 2-8 for at least the same reasons as described above with respect to claim 1.

C. Claim 9

Claim 9 mirrors the limitations of claim 1 discussed in sections A.iii-A.v. Thus, the Board should deny institution of Ground 6 with respect to claim 9 for at least the same reasons as described above with respect to claim 1.

D. Claim 10-16

Claims 10-16 depend from and include each limitation of claim 9. Thus, the Board should deny institution of Ground 6 with respect to claims 10-16 for at least the same reasons as described above with respect to claim 9.

E. Claim 17

Claim 17 mirrors the limitations of claim 1 discussed in sections A.iii-A.v. Thus, the Board should deny institution of Ground 6 with respect to claim 17 for at least the same reasons as described above with respect to claim 1.

F. Claim 18-23

Claims 18-23 depend from and include each limitation of claim 17. Thus, the Board should deny institution of Ground 6 with respect to claims 18-23 for at least the same reasons as described above with respect to claim 17.

XIII. GROUND 7: METABOWERKE, BURCHIA AND CHEN FAIL TO RENDER OBVIOUS CLAIMS 1, 10, AND 18

A. Claim 1

- i. *The Petition Fails Explain How Metabowerke and Burchia and Would be Combined with Chen to Disclose "...first corner bumper...and...a second corner bumper"*

With respect to Ground 7, the Petition states that "Metabowerke discloses corner bumpers, or in the alternative a POSITA would have been motivated to add the corner bumpers of Chen to the containers of Burchia and Metabowerke to protect the corners from damage." Pet. at 146.

First, the Petition provides no evidentiary support for the assertion that Metabowerke discloses corner bumpers. Second, as explained in Section IX.A.i above, the Petition does not explain how any alleged corner bumpers would be combined with the proposed combination of references asserted in the Ground.

For these reasons, Petition fails to explain how Metabowerke and Burchia would be combined with Chen to disclose "...first corner bumper...and...a second corner bumper."

B. Claim 10

Claim 10 mirrors the limitations of claim 1 discussed in section A.i. Thus, the Board should deny institution of Ground 1 with respect to claim 10 for at least the same reasons as described above with respect to claim 1.

C. Claim 18

Claim 18 mirrors the limitations of claim 1 discussed in section A.i. Thus, the Board should deny institution of Ground 1 with respect to claim 18 for at least the same reasons as described above with respect to claim 1.

XIV. GROUND 8: METABOWERKE, BURCHIA AND LIN FAIL TO RENDER OBVIOUS CLAIMS 4 AND 13

Claims 4 and 13 depend from and include each limitation of claim 1, and claim 9 respectively. The Petition does not allege that Lin addresses the shortcomings of Metabowerke and Burchia. Thus, the Board should deny institution of Ground 8 for at least the same reasons as described above with respect to Ground 6.

XV. GROUND 9: METABOWERKE, BURCHIA AND BENSMAN FAIL TO RENDER OBVIOUS CLAIMS 8, 16 AND 23

Claims 8, 16 and 23 depend from and include each limitation of claim 1, claim 9, and claim 17 respectively. The Petition does not allege that Bensman addresses the shortcomings of Metabowerke and Burchia. Thus, the Board should deny institution of Ground 9 for at least the same reasons as described above with respect to Ground 6.

XVI. CONCLUSION

For the foregoing reasons, Patent Owners respectfully requests that the Board deny the Petition in full.

Dated: January 13, 2025

Respectfully Submitted,

/ Dion M. Bregman /
Dion M. Bregman, Reg. No. 45,645

CERTIFICATION OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This PATENT OWNERS PRELIMINARY RESPONSE TO PETITION includes 13,970 words, as counted by Microsoft Word, and is therefore in compliance with the 14,000-word limit established by 37 C.F.R. § 42.24(b)(1). Accordingly, pursuant to 37 C.F.R. § 42.24(d), lead counsel for Patent Owners hereby certifies that this paper complies with the applicable type-volume limits.

Dated: January 13, 2025

Respectfully Submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), lead counsel for Patent Owners hereby certifies that on January 13, 2025 a copy of this PATENT OWNERS PRELIMINARY RESPONSE TO PETITION and the exhibits thereto were served to the email correspondence address of record for Petitioner's counsel of record:

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