

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREASURE GARDEN, INC.,
Petitioner,

v.

ATLEISURE, LLC,
Patent Owner.

Case No. IPR2025-01005
Patent No. 8,104,492

**PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR INTER PARTES REVIEW
OF U.S. PATENT NO. 8,104,492**

Petitioner Treasure Garden, Inc. filed two concurrent inter partes review (“IPR”) petitions against U.S. Patent No. 8,104,492 (“the ’492 Patent”). The following chart identifies the grounds asserted in both petitions.

Petition 1: Based on Wang ’109, Wang ’439, and Glatz ’980
Ground 1: Claims 1 and 5-7 anticipated by Wang ’109
Ground 2: Claims 1 and 5-7 anticipated by Wang ’439
Ground 3: Claims 1-7 obvious based on Glatz ’980 in view of Bertola ’895, Wang ’460, Tung ’037, and/or Liu ’171
Petition 2: Based on Wang ’460 and Ma ’763
Ground 1: Claims 1-7 obvious based on Wang ’460 in view of Tung ’037, Liu ’171 and/or Bertola ’895
Ground 2: Claims 1-7 obvious based on Ma ’763 in view of Ma ’297, Bertola ’895, Tung ’037, and/or Liu ’171

I. Two Petitions are Necessary Because of a Priority Date Issue

The Board’s Trial Practice Guide states that more than one petition may be necessary where “there is a dispute about priority date requirement arguments under multiple prior art references.” Board’s Consolidated Trial Practice Guide (November 2019) at 59. Petitioner submits that applies here. Grounds 1 and 2 of Petition 1 are based on Wang CN 201076109Y (“Wang ’109”) and Wang CN 201197439Y (“Wang ’439”). The status of these references as prior art turns on whether each of

the claims of the '492 Patent is entitled to the priority date of a provisional application to which the '492 Patent claims priority.

As explained in Petition 1, Claims 1 and 5-7 of the '492 Patent are not entitled to the priority date of the provisional application because the provisional application does not provide written description support for those claims as required by 35 U.S.C. § 112 ¶ 1. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015). Specifically, Claims 1 and 5-7 of the '492 Patent are not entitled to the priority date of the provisional because these claims include a limitation governed by 35 U.S.C. § 112 ¶ 6, and one of the structures that corresponds to that § 112 ¶ 6 limitation in the issued patent differs significantly from what was described in the provisional. “[F]or means-plus-function claims of a continuation-in-part to claim the priority date of its parent, the claims will satisfy the written description and enablement requirements of § 112 only if the construed corresponding structures are present in the parent's specification.” *See Auto. Techs. Int'l, Inc. v. Delphi Corp.*, 776 F. Supp. 2d 469, 490 (E.D. Mich. 2011). Similarly, for means-plus-function claims to be accorded the priority date of a provisional, the construed corresponding structures must be present in the provisional because the provisional application must provide written description support under 35 U.S.C. § 112 ¶ 1. *See Dynamic Drinkware*, 800 F.3d at 1380.

In the pending district court litigation, however, Patent Owner has argued that all claims of the '492 Patent are fully supported by the provisional. Therefore, Petitioner has expended substantial extra words in Petition 1 explaining why Claims 1 and 5-7 of the '492 Patent claims are not entitled to the filing date of the provisional. Additionally, because dependent Claims 2-4 arguably recite enough structure to avoid § 112 ¶ 6 and the dispute over the priority date, Petitioner has had to rely on different prior art for those claims. Accordingly, Petitioner has only been able to include one grounds that does not rely on Petitioner's prevailing on the issue of priority.

Petition 2 presents materially different grounds that are based on references that are prior art even if Patent Owner succeeds in showing that Claims 1 and 5-7 of the '492 Patent are entitled to the earlier filing date of the provisional. Given the presence of these other prior art references that present materially different issues of unpatentability in the event that Patent Owner successfully proves an earlier effective filing date, Petitioner respectfully submits that it would be manifestly unfair and prejudicial to Petitioner if the Board exercises its discretion to deny Petition 2. Accordingly, the Board should consider and institute Petition 1 and Petition 2.

II. Each of the Primary References in the Two Petitions Presents Materially Different Issues of Patentability

The priority dispute is the primary issue for Grounds 1 and 2 in Petition 1. Although each asserts a single reference that anticipates Claims 1 and 5-7 of the '492 Patent, Grounds 1 and 2 present materially different issues. Ground 1 is based on Wang '109, and Ground 2 is based on Wang '439. Wang '109 and Wang '439 each discloses a different one of the structures described in the '492 Patent corresponding to the “locking means” limitation that is subject to § 112 ¶ 6. Thus, while each includes every limitation of Claims 1 and 5-7, they present different issues as to the “locking means” limitation.

Ground 3 of Petition 1 presents a materially different issue in that priority is not an issue for Glatz '980, the primary reference in Ground 3. Ground 3 asserts that Claims 1-7 of the '492 Patent are invalid for obviousness over Glatz '980 in view of Bertola '895, Wang '460, Tung '037, and/or Liu '171. The only element of Claim 1, the only independent claim, not explicitly in Glatz '980 is the winder hub used to fasten the line that opens and closes the canopy. Glatz '980 uses a “securing device” to fasten the line, but winder hubs were well-known in the prior art.

Petition 2 raises two other materially different issues of patentability based on obviousness where the priority date dispute is not an issue. Ground 1 of Petition 2 relies on Wang '460 as a primary reference. Wang '460 discloses all of the elements of Claim 1 except the specific structures described in the '492 Patent as

corresponding to the § 112 ¶ 6 limitation “locking means.” However, those structures were well-known in the prior art.

Ground 2 of Petition 2 relies on Ma ’763 as a primary reference. Ma ’763 has a different design but still discloses the majority of the ’492 Patent’s claims thus presenting a materially different issue of patentability. The elements not disclosed in Ma ’763 were all well-known in the prior art.

Given the other considerations identified in the previous two sections, as well as the fact that Petitioner faces estoppel in the district court litigation if claims are upheld in a final written decision, Petitioner respectfully requests consideration and institution of both Petition 1 and Petition 2.

III. Ranking of Petitions

Petitioner requests that the Board institute both petitions and consider the petitions in the following order:

<u>Rank</u>	<u>Petition</u>	<u>Primary References</u>	<u>Claims</u>
1	IPR2025-01005	Wang ’109, Wang ’439, and Glatz ’980.	1-7
2	IPR2025-01006	Wang ’460, Ma ’763.	1-7

Dated: May 22, 2025

By: /Lauren Keller Katzenellenbogen/

Lauren Keller Katzenellenbogen (Reg. No. 56,553)

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on May 22, 2025 a complete and entire copy of this Notice Ranking Petitions was provided via FedEx to the Patent Owner at the correspondence address of record for the subject patent as follows:

104839 - Jack G Abid
1135 East State Road 434, Suite 3001
Winter Springs, FL 32708
UNITED STATES

A courtesy copy has been sent by email on this day to Patent Owner's counsel of record in the matter identified in Section VIII.B of the Petition as follows:

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Dated: May 22, 2025

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