

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOUGHBUILT INDUSTRIES, INC.,
Petitioner

v.

MERIDIAN INTERNATIONAL CO., LTD.,
Patent Owner

Case IPR2025-01461
U.S. Patent No. 11,986,946

**PETITIONER’S OPPOSITION TO PATENT OWNER’S
REQUEST FOR DISCRETIONARY DENIAL**

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PETITIONER'S EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,986,946 B2 to Zhang et al., issued May 21, 2024 (“the ’946 patent”)
1002	File History of U.S. Patent No. 11,986,946
1003	Declaration of J. Michael McCarthy, Ph.D. in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 11,986,946
1004	<i>Curriculum Vitae</i> of J. Michael McCarthy, Ph.D.
1005	Chinese Patent Application No. 202210212862.5, filed March 4, 2022
1006	Chinese Patent Application No. 202320135456.3, filed January 13, 2023
1007	U.S. Patent Application Publication No. 2022/0396985 A1 to Li et al., published December 15, 2022 (“Li”)
1008	U.S. Patent Application Publication No. 2020/0329837 A1 to Burchia, published October 22, 2020 (“Burchia”)
1009	U.S. Patent Application Publication No. 2023/0340804 A1 to Hammond et al., published October 26, 2023 (“Hammond”)
1010	PCT Publication No. WO 2021/150410 A1 to Hammond et al., published July 29, 2021 (“Hammond PCT”)
1011	U.S. Patent Application Publication No. 2021/0221561 A1 to Davidian et al., published July 22, 2021 (“Davidian”)
1012	U.S. Patent Application Publication No. 2020/0298392 A1 to Baruch et al., published September 24, 2020 (“Baruch”)
1013	“Standard Handbook of Machine Design” by Shigley – 2 nd Edition
1014	“University Physics Volume 1” Ling et al. (OpenStax)
1015	Declaration of Timothy L. Tang

Exhibit No.	Description
1016	U.S. Patent No. 5,934,466 to Loeffler, issued August 10, 1999 (“Loeffler”)
1017	U.S. Patent Application Publication No. 2003/0094392 A1 to Meier et al., published May 22, 2003 (“Meier”)
1018	U.S. Patent Application Publication No. 2019/0291922 A1 to Gonitiner et al., published September 26, 2019 (“Gonitiner922”)
1019	U.S. Patent Application Publication No. 2019/0002004 to Brunner, published January 3, 2019 (“Brunner”)
1020	U.S. Patent No. 9,725,209 B1 to Ben-Gigi, issued August 8, 2017 (“Ben-Gigi”)
1021	U.S. Patent Application Publication No. 2023/0238755 A1 to Shabtai et al., published July 27, 2023 (“Shabtai”)
1022	U.S. Patent Application Publication No. 2020/0165036 to Squiers et al., published May 28, 2020 (“Squiers”)
1023	U.S. Patent Application Publication No. 2019/0315515 A1 to Gonitiner et al., published September 26, 2019 (“Gonitiner515”)
1024	Non-Infringement and Invalidity Report of J. Michael McCarthy, Ph.D., <i>Meridian Int’l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal.)
1025	ToughBuilt – Opening Claim Construction Brief [91], <i>Meridian Int’l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal.) (Jun. 9, 2025)
1026	Meridian – Opening Claim Construction Brief [92], <i>Meridian Int’l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal.) (Jun. 9, 2025)
1027	ToughBuilt – Responsive Claim Construction Brief [94], <i>Meridian Int’l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal.) (Jun. 23, 2025)

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1028	Meridian – Responsive Claim Construction Brief [95], <i>Meridian Int'l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal.) (Jun. 23, 2025)
1029	ToughBuilt – Post-Hearing Claim Construction Brief [102], <i>Meridian Int'l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal.) (Jul. 15, 2025)
1030	Meridian – Post-Hearing Claim Construction Brief [103], <i>Meridian Int'l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal.) (Jul. 15, 2025)
1031	Defendant's Notice of Inter Partes Reviews and Stipulation Regarding Invalidity Contentions as to U.S. Patent Nos. 11,986,946 and 11,192,689 [116], <i>Meridian Int'l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal.) with Notice of Electronic Filing Dated Sept. 5, 2025
1032	Order on Motion to Stay Case Pending <i>Inter Partes</i> Reviews, <i>Meridian Int'l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Case No. 8:24-cv-01840-JWH-JDE (C.D. Cal. September 25, 2025).
1033	File History of U.S. Appl. No. 18/176,907
1034	USPTO - Multi-Step U.S. Patent Search Strategy <i>available at</i> https://www.uspto.gov/patents/search/patent-search-strategy
1035	Complaint for Patent Infringement, <i>Meridian Int'l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal. August 21, 2024)
1036	<i>Intentionally Left Blank</i>
1037	Declaration of Tony Kriz, <i>Meridian Int'l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal. August 26, 2024)

Exhibit No.	Description
1038	Memorandum of Points and Authorities in Support of Plaintiff's Motion for Preliminary Injunction, <i>Meridian Int'l Co., Ltd. v. ToughBuilt Industries, Inc.</i> , Civil Action No. 8:24-cv-01840 (C.D. Cal. August 26, 2024)
1039	Plaintiff Meridian Int'l Co. Ltd.'s Infringement Contentions
1040	<i>ToughBuilt Industries, Inc. v. Meridian Int'l Co., Ltd.</i> , IPR2025-01462, Petition, Paper 2 (PTAB August 28, 2025)
1041	<i>ToughBuilt Industries, Inc. v. Meridian Int'l Co., Ltd.</i> , IPR2025-01462, Petitioner's Opposition to Patent Owner's Request for Discretionary Denial, Paper 11 (PTAB December 9, 2025)
1042	Thesaurus.com – “part” <i>available at</i> https://www.thesaurus.com/browse/part

I. INTRODUCTION

ToughBuilt is a small U.S. company that needs review in this forum to defend itself from Meridian—a larger, foreign competitor who is trying to use the U.S. patent system to drive ToughBuilt out of business. Meridian has not developed settled expectations in the '946 patent, which has only been in force for about 1.5 years. And, as the parties *jointly* requested, the co-pending litigation was stayed before significant investment in that case. Discretionary considerations thus strongly favor consideration of the merits, which, in turn, prove that the patent is invalid. The PTAB was created for review under these circumstances.

II. DISCRETIONARY CONSIDERATIONS FAVOR INSTITUTION

The Director should institute review because the Petition's merits are strong, and the discretionary considerations favor institution.

A. **ToughBuilt is a small U.S. company seeking review to combat aggression from a larger, foreign competitor who is weaponizing the U.S. patent system to try to drive ToughBuilt out of business.**

Petitioner ToughBuilt Industries, Inc., is a small company (an SME) based in Irvine, CA. Patent Owner Meridian International Co., Ltd., is a larger, privately held Chinese company based in Shanghai, China. EX1035, 1 (¶1); EX1037, ¶3. On June 5, 2024, Meridian sent ToughBuilt a cease-and-desist letter alleging that ToughBuilt's StackTech products infringe the '946 patent and threatening to seek a preliminary injunction if ToughBuilt did not stop selling these products. EX1037, ¶11; EX1038, 5. Meridian's letter did not mention U.S. Patent No. 11,192,689 (the

subject of IPR2025-01462). *See* EX1037, ¶11; EX1038, 5; EX1035, ¶63 (alleging Complaint provided notice of '689 patent); EX1039, 8.

On August 21, 2024, Meridian sued ToughBuilt in the Central District of California ("CDCA litigation"), alleging infringement of the '946 and '689 patents. EX1035. As threatened, Meridian moved (albeit unsuccessfully) for a preliminary injunction. EX1038. Tony Kriz, President of Meridian's U.S. affiliate (who Meridian *did not* list as a real party in interest ("RPI") here), provided a declaration to support Meridian's positions. EX1037. Consistent with Meridian's goal to put ToughBuilt out of business, Mr. Kriz testified that "Meridian is unwilling to license the '946 patent or the '689 patent to anyone, *much less so for a direct competitor like ToughBuilt.*" EX1037, ¶13. Meridian also took aim at ToughBuilt's financial challenges as an SME to try to accomplish its draconian goal. EX1038, 4.

ToughBuilt thus turned to the PTAB to defend itself against Meridian's aggression, petitioning for review of both patents in August 2025. *See* IPR2025-01462. As a U.S. SME, ToughBuilt is the quintessential stakeholder who needs access to the low-cost alternative to district court litigation that the PTAB was created to provide. And there is no impediment to review here or risk of inconsistent conclusions between fora because the parties *jointly* moved to stay the CDCA litigation. That stay is now in place "until the exhaustion of all rights of appeal." EX1032, 2.

Moreover, Meridian's lack of candor before the Office justifies careful review of its patents. During prosecution of Meridian's other asserted patent (the '689 patent), Meridian knew of but failed to disclose material prior art that forced Meridian to amend identical claims in a European counterpart. EX1040, 1, 5-6; EX1041, 1-3. The PTAB was created to review exactly this type of suspect patent. To make matters worse, Meridian fails to acknowledge that it *jointly* requested stay of the CDCA litigation, fails to list its U.S. affiliate as an RPI, and advances a series of meritless arguments. *See* Section II.E. These circumstances reinforce the case for review here.

B. Meridian has no settled expectations in the '946 patent.

"Early challenges to patents favor robust, predictable patent rights and weigh against discretionary denial." *Straumann USA, LLC v. Smart Denture Conversions, LLC*, IPR2025-00956, Paper 11 at 2 (PTAB Sept. 19, 2025). Challenges to patents that have been in force for less than six years are considered "early challenges" because patent owners typically have not developed settled expectations within this timeframe. *OnePlus Tech. (Shenzhen) Co. v. Pantech Corp.*, IPR2025-00756, Paper 11 at 2 (PTAB Oct. 3, 2025) (patent issued in 2020); *Berkshire Hathaway Energy Co. v. Birchtech Corp*, IPR2025-00274 et al., Paper 23 at 3 (PTAB July 2, 2025) (patents issued in 2019 and 2020).

ToughBuilt's Petition presents an early challenge that favors review.

Meridian has not developed settled expectations because the '946 patent issued in May 2024 and thus has only been in force for about 1.5 years. *See Suzhou Mojawa Intelligent Elec. Co., Ltd., v. Shenzhen Shokz*, IPR2025-00842, Paper 14 at 2 (PTAB Sept. 19, 2025) (patents “issued in 2021 and 2022” did not establish settled expectations). ToughBuilt’s challenge is also the first and only post-grant challenge of the '946 patent, which strengthens the case for review. In view of these facts, Meridian does not even claim to have developed settled expectations.

Mr. Kriz—President of Meridian International Co., Ltd. USA—confirmed that Meridian has not developed settled expectations via licensing, marking, commercialization, or other activities. *See Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2-3 (PTAB June 26, 2025). He explained that “Meridian has never licensed either the '946 patent or the '689 patent.” EX1037, ¶13. Nor will it, particularly to ToughBuilt: “Meridian is unwilling to license the '946 or the '689 patent to anyone, much less so for a direct competitor like ToughBuilt.” *Id.*

Neither Meridian nor Mr. Kriz alleges that Meridian has developed settled expectations via marking. As to commercialization, Mr. Kriz testified in his Declaration—dated August 26, 2024—that Meridian was “actively working to develop well-planned products that incorporate technology patented in the '946 patent.” EX1037, ¶13. In other words, Meridian had not commercialized any product covered by the '946 patent by August 26, 2024. Nor does Meridian allege

that it has done so since that time.

In sum, Meridian has no settled expectations and review is appropriate.

C. Review is necessary to correct material errors.

The examiner committed three material errors during prosecution of the '946 patent that justify instituting ToughBuilt's Petition: (A) The examiner failed to search for the allegedly allowable feature: the "stop part." Proper text searching for "stop part" and its synonyms would have uncovered Li, which is an anticipatory reference that uses the synonym "stop piece." (B) The examiner overlooked critical teachings in Baruch, including Baruch's disclosure of a "stopper," which teaches the claimed "stop part." As Meridian acknowledges, the examiner considered but did not apply Baruch to reject the claims. (C) Prosecution of the '946 patent's parent application—which was examined by a different examiner—confirms that the examiner of the '946 patent overlooked Baruch. Examiner Weinerth examined the '946 patent's parent application, and substantially similar claims as anticipated by Baruch. Examiner Pal examined the '946 patent but did not apply Baruch. This discrepancy shows that the examiner of the '946 patent clearly erred in failing to reject the claims using Baruch.

1. The examiner failed to search for the allegedly allowable feature—the "stop part"—which would have uncovered Li.

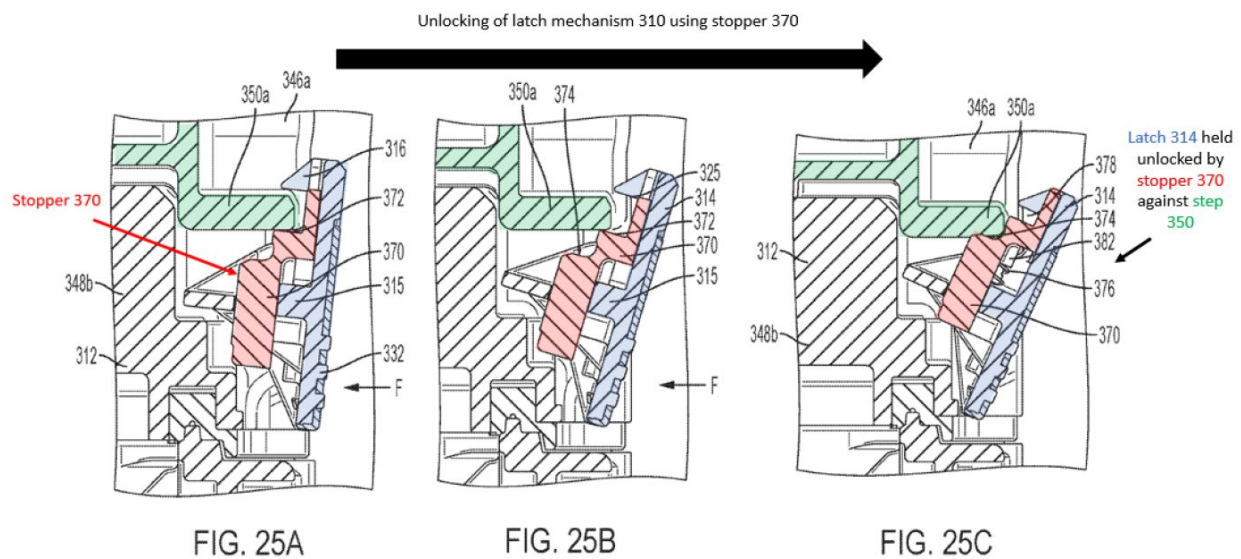
During prosecution, the examiner alleged that the claimed "stop part" and certain functionality associated with this element was allowable. EX1002, 520-

529, 644. But the examiner’s search history indicates that the examiner failed to search for this element and its functionality.” EX1002, 597, 606, 608, 672, 681, 683. That is, the examiner did not search the term “stop part” or its synonyms, such “stop piece” (a term used by Li), or the claimed functionality associated with the “stop part.” Instead, the examiner merely searched using general terms such as “storage,” “box,” “stack,” “lock,” and “container.” *Id.* The examiner’s failure to search for the allegedly inventive feature was a material error. *See* M.P.E.P. § 904 (requiring an examiner to search for all “inventive concepts toward which the claims appear to be directed.”); EX1034 (USPTO providing keyword search guidance and searching for “alternative words”).

Li uses the term “stop piece.” EX1007, ¶¶11, 34. The term “piece” is a common synonym of “part.” EX1042 (“part” is a “noun, as in *piece*, portion of something” (emphasis added)). Had the examiner searched for a “stop part” or used a similar keyword—especially in the context of stackable boxes or containers—the examiner should have located Li. The examiner’s inability to locate Li, which is an *anticipatory* reference, demonstrates a failure in the examiner’s search strategy and material error during prosecution. Proper key word searching would have also brought Baruch (which uses the term “stopper”) to the forefront for the examiner’s consideration. *See* Pet., 112-121 (citing EX1012, ¶¶52, 56, 62-63).

2. The examiner of the '946 patent overlooked critical teachings in Baruch, including Baruch's teaching of the allegedly allowable "stop part."

All agree that the examiner considered Baruch's teachings but did not apply them to reject the claims of the '946 patent. That was a material error because Baruch's "stopper" plainly teaches the claimed "stop part." Pet., 112-121. Further, as seen below, Baruch's stopper is also (1) "retractable," extended while holding an unlocked state, and compressed in a locked state and (2) movable perpendicular to the sliding path of the locking part, which also teaches the allegedly allowable functionality of the claimed "stop part." Pet., 112-121.



EX1012, FIGs. 25A-25C (annotated).

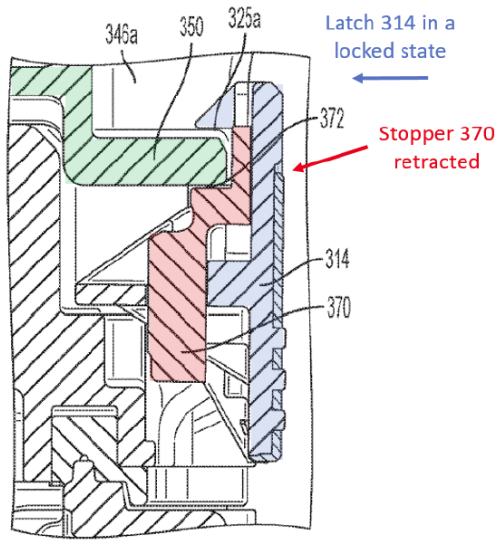


FIG. 24C

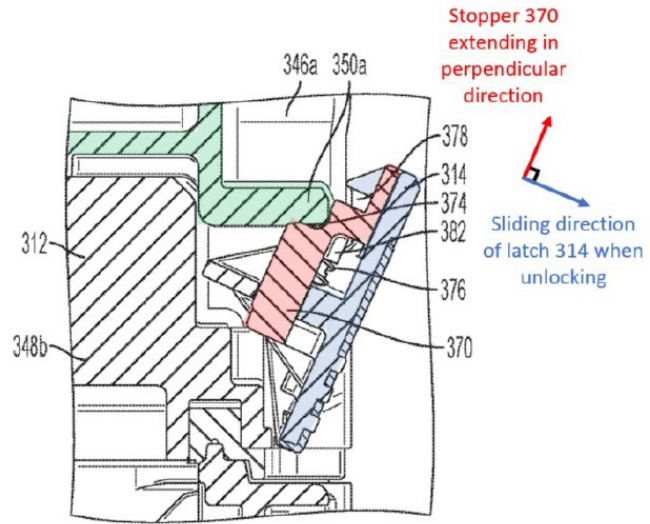


FIG. 25C

EX1012, FIG. 24C, FIG. 25C (annotated).

While a version of Baruch is listed on the face of the '946 patent, there is no indication that the examiner carefully analyzed Baruch or the specific portions of Baruch relied upon in the Petition. *See* Pet., 96-121 (relying primarily on Figures 20-22, 23A-23C, 24A-24C, and 25A-25D and the corresponding description). Rather, during prosecution, the Examiner issued only a single Office Action, which included only one art-based §102 rejection in view of Ben-Gigi (US9,725,209). EX1002, 637-645. Failing to analyze or cite Baruch's "stopper" functionality in any rejection demonstrates that the examiner overlooked Baruch's teachings. EX1002, 640-645 (lone office action applying only Ben-Gigi). The Office should institute review to address this material error. *Accord, e.g., Alliance Laundry Sys. LLC v. PayRange LLC*, IPR2025-00573, Paper 9 (PTAB July 17, 2025).

This material error is confirmed by the fact that a different examiner rejected the '946 patent's *parent* application using Baruch.

3. Prosecution of the '946 patent's *parent* application—which is being examined by a different examiner—confirms that the examiner of the '946 patent overlooked Baruch's critical teachings.

The Office has failed to evaluate and apply the prior art consistently across the '946 patent's family. The Director should institute review to correct this error.

Specifically, the '946 patent is a continuation of U.S. Appl. No. 18/176,907 ("'907 application"). EX1001, (63). To date, the '907 application remains rejected by the Office with a non-final office action being issued most recently on August 29, 2025. EX1033, 778-798. Notably, the examiner of the '907 application (Gideon Weinerth) is different than the examiner of the '946 patent (Prince Pal), despite the original claims being the same. EX1033, 41-45 (original claims), 778 (Examiner Weinerth); EX1002, 34-36 (original claims), 704-710 (Examiner Pal). Having different examiners has led to different and inconsistent conclusions, especially when the examiner of the '946 patent has seemingly failed to adopt the analysis and rejections—especially the ones based on Baruch—applied against the '907 application. The '946 patent examiner's inconsistent analysis and allowance of claim features that were deemed anticipated and obvious by the examiner of the '907 application is clear error.

To illustrate this error, the original claims of the '907 application recited the

same features that were allegedly allowable from the '946 patent. EX1033, 41-45.

For example, claim 1 of the '907 application recited a “stop part”; claim 2 recited the “stop part” being “retractable,” extended while holding an unlocked state and compressed in a locked state; and claim 14 recited a card block portion of the stop part moving “perpendicular with respect to a sliding path of the locking path.” *Id.*

These are the same features that were deemed allowable in the '946 patent.

EX1002, 520-529, 644.

When analyzing these claim features, the examiner of the '907 application found that they were all previously recited in the art *in three separate Office Actions*. EX1033, 550-557, 667-674, 796-797. Further, the examiner found that *Baruch* anticipated and rendered obvious these features. *Id.*, 550-557 (rejecting claims 1-2 and 14 in view of *Baruch*), 667-674 (same rejections). Specifically, *Baruch* anticipated all features of claim 1, including the claimed “stop part.” *Baruch* also anticipated claim 2 and rendered obvious claim 14. In view of these rejections, Meridian was forced to amend the claims to first recite a “stop part pivotably attached to the first connection part” and then further amend the claims to recite a “stopper rotatably attached to the first connection part.” EX1033, 564, 751. In response to these amendments, the examiner of the '907 application changed references but has still maintained rejections against all claims. EX1033, 796-797. As of December 9, 2025, the '907 application remains rejected.

In view of the '907 application's prosecution history and the rejection of nearly identical claims and claim features in view of Baruch, the examiner of the '946 patent committed clear error when identifying allowable subject matter. Rather, the examiner should have reviewed the prosecution history of the parent '907 application, recognized that Baruch anticipates and/or renders obvious the allegedly allowable features, and issued appropriate rejections against the '946 patent's claims.

Based on the nearly identical claim language and claim features that remain rejected in the '907 application, the examiner of the '946 patent has clearly failed to consider the prosecution of other applications in the family and has deviated from another examiner who appropriately maintains a rejection. The examiner of the '946 patent has therefore failed to analyze the '946 patent consistently with respect to other applications in the family. This inconsistency amounts to clear error requiring correction.

D. The *Fintiv* factors favor institution.

The *Fintiv* factors favor institution because, upon the parties' *joint* request, the court stayed the CDCA litigation "until the exhaustion of all rights of appeal." EX1032, 2. The parties and the court have not invested much into this litigation, and ToughBuilt's *Sotera* stipulation helps mitigate concerns of duplication of effort or risk of inconsistent decisions. Indeed, Meridian's *Fintiv* arguments lack

merit because the court granted the stay that Meridian itself requested, a critical fact Meridian fails to mention in its brief.

1. Factor 1 favors institution because the parties *jointly* requested a stay, which the court *granted*.

Factor 1 favors institution because the CDCA litigation is stayed “until the exhaustion of all rights of appeal.” EX1032, 2. Notably, Meridian does not even acknowledge its role in jointly seeking the stay.

2. Factor 2 favors institution because there is no trial date.

Factor 2 favors institution because there is no trial date. Indeed, because the CDCA litigation is stayed pending this IPR (including any appeals), there will indisputably be no trial before a FWD is due in this IPR. EX1032.

3. Factor 3 favors institution because there will be little invested in CDCA by the DI deadline.

Factor 3 favors institution because the parties and the court have not made significant investment in the CDCA litigation, and no further investment will be made by the March 9, 2026 DI deadline. Meridian concedes that the case was stayed before the court issued a *Markman* order. DD Br., 5-6 (stating that the *Markman* order “is expected once the litigation resumes”); *cf. Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9-10 (March 20, 2020) (precedential) (explaining that the issuance of “district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial”).

4. Factor 4 favors institution because ToughBuilt’s challenges between fora do not overlap and ToughBuilt has made a *Sotera* stipulation.

Factor 4 favors institution. As Meridian concedes, ToughBuilt timely submitted a *Sotera* stipulation, which mitigates concerns of duplication of efforts and inconsistent results. Paper 6; DD Br., 8-9. And ToughBuilt no longer maintains its contention in the CDCA litigation that the claims are indefinite. *See* EX2006, 20-22. ToughBuilt will not pursue any invalidity theory based on indefiniteness if the CDCA litigation is resumed. So there is no risk of duplication of effort or inconsistency on that front.

5. Factor 5 favors institution because it would be efficient to review a patent involved in litigation between the parties.

Factor 5 favors institution. Because “it is an inefficient use of Board resources to review a challenged patent” that is not in litigation, *see Ericsson Inc. v. Procomm Int’l Pte. Ltd.*, IPR2024-01453, Paper 15 at 3 (PTAB June 25, 2025), that the ’946 patent *is* involved in litigation between the parties favors institution.

6. Factor 6 favors institution because the merits are strong.

Factor 6 favors institution. ToughBuilt respectfully requests that the Director review the strong merits challenges presented in the Petition. Below, ToughBuilt addresses a handful of superficial merits arguments Meridian raised in its briefing.

E. Meridian’s other arguments for discretionary denial are frivolous.

Meridian attempts to set forth additional arguments that purportedly impact

the exercise of discretion in its favor. DD Br., 9-18. All are unfounded.

1. Li is not cumulative with Baruch even though both references teach the claimed “stop part.”

Meridian’s argument that Li is cumulative with Baruch walks headlong into the Petition’s invalidity Grounds. Meridian argues that the references are cumulative because both teach the claimed “stop part.”¹ DD Br., 13. But the fact that two separate references teach the allegedly allowable feature confirms (1) that the Office erred by overlooking Baruch and failing to identify Li, (2) that review is warranted, and (3) that the claims are invalid.

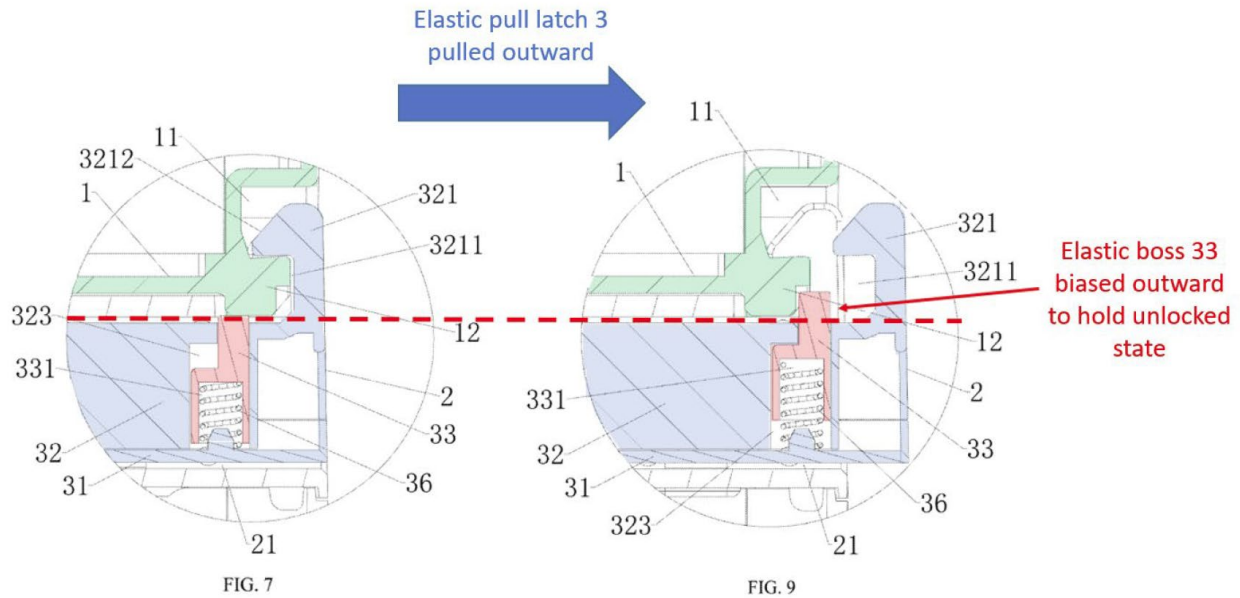
Moreover, Meridian is wrong that Li and Baruch are cumulative. Meridian provides no other analysis of Li’s or Baruch’s teachings aside from admitting that both Li and Baruch teach the claimed “stop part.” DD Br., 13. Simply identifying a claim term that is taught by a reference, however, does not make the reference cumulative. *PLR Worldwide Sales Ltd. v. Flip Phone Games, Inc.*, IPR2024-00209, Paper 9 at 16 (PTAB May 10, 2024) (faulting the patent owner for relying on a “high-level comparison of the references”; “Patent Owner must demonstrate that

¹ Notably, Meridian does not allege that Li is cumulative with *Ben-Gigi*—the only reference actually applied in a rejection during prosecution. This further demonstrates the weakness of Meridian’s argument. Regardless, Li is not cumulative with Ben-Gigi either.

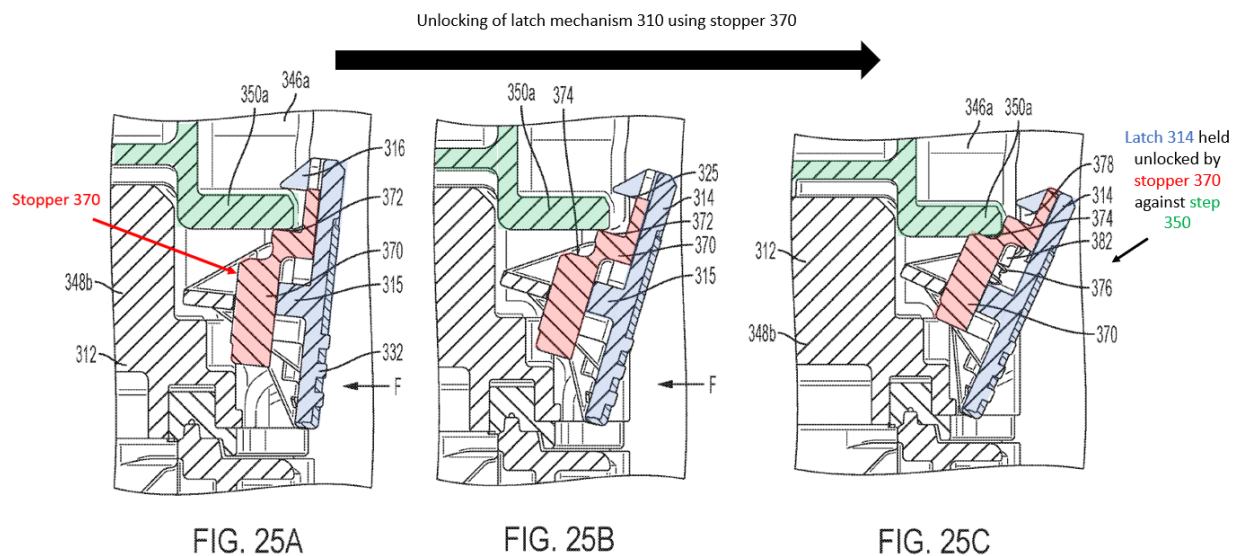
the references relied on in the Petition are substantially the same *in all material respects to the prior art the Examiner actually relied on*” (emphasis added)). Thus, Meridian’s comparison—which is void of any actual technical comparison—should be rejected.

Li is an anticipatory reference that was never identified or considered during prosecution. Li explicitly discloses the claimed “stop part,” which is a key feature of the claims. Meridian, however, effectively argues that no reference that teaches a “stop part” may be used in a Petition because any reference teaching a “stop part” is cumulative. DD Br., 13. That is, arguing that Li is cumulative amounts to arguing that no art that teaches a “stop part” may be used in a Petition challenging the ’946 patent. The Director should reject such a baseless argument. *See PLR Worldwide Sales*, IPR2024-00209, Paper 9 at 16-17 (“high-levels of similarity are to be expected” and are not sufficient for denial).

Moreover, Li and Baruch are not cumulative based on clear differences between how their mechanisms operate. *See* Pet., 12-16, 96-99. As seen from the Figures presented below and in the Petition, Li teaches an “elastic pull latch 3” that slides horizontally to unlock boxes while Baruch teaches a “latch 314” that rotates. *Id.* Meridian does not address these differences at all.



EX1007, FIGs. 7, 9 (annotated).



EX1012, FIGs. 25A-25C (annotated).

Because Meridian asserts that Li and Baruch are cumulative based only on a superficial assertion that both teach the claimed “stop part,” the Director should reject Meridian’s argument.

2. The examiner's failure to apply the art of record was material error.

Meridian alleges that Baruch was already considered by the Office. DD Br., 12-13. But as explained in Sections II.C.2- II.C.3, the examiner's failure to apply Baruch consistently with how the Office applied Baruch against the '946 patent's *parent* application was material error.

This error further extends to Burchia and Davidian (DD Br., 14), which were also not applied in any rejection but are used in the Petition to demonstrate how dependent claims directed to a "torsion spring" and "projections" were obvious. Again, the examiner's failure to consider the Li-Burchia-Hammond, Li-Davidian, Baruch-Burchia-Hammond, and Baruch-Davidian combinations is also material error. Sections II.C, II.E.1. Indeed, Meridian fails to even acknowledge Hammond or argue that Hammond is cumulative with any reference—it is not. The examiner's failure to consider Hammond or any of the other secondary references applied in combination with Li and Baruch against the dependent claims also amounts to material error.

3. The Petition complies with the statutory requirement to identify with particularity all evidence relied upon in the challenges.

For each element of the claims, the Petition identifies "in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each

claim.” 35 U.S.C. § 312(a)(3); *see* Pet., 10-158. Meridian advances meritless allegations that the Petition fails to comply with its statutory obligation but fails to identify even one single example to support its allegations. DD Br., 9-10. The assertion is patently false and falls far short of a reason for discretionary denial.

4. The Petition properly specifies where each element of the claim is found in the prior art and is not overly reliant on expert testimony.

The Petition complies with the Board’s rules and “specif[ies] where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4); *see* Pet., 12-158. The Petition further properly provides supporting testimony from Dr. McCarthy to provide the perspective of a POSA. Tellingly, although Meridian complains that the Petition improperly relies on expert testimony, DD. Br., 17-18, Meridian does not identify even *one example* of a limitation that relies on expert testimony to fill a gap in the cited art. It cannot because there is no such gap.

Meridian’s objection to the length of Dr. McCarthy’s testimony also fails to show any impropriety with the Petition. Far from being unduly lengthy, the declaration “disclose[s] the underlying facts or data on which the opinion is based,” as required by regulation. *See* 37 C.F.R. § 42.65(a). And notably, 45 pages of the declaration is Dr. McCarthy’s detailed explanation of the background of the technology that “modular storage boxes, automatic locking mechanisms, and

stopping parts to regulate latch motion,” EX1003, ¶36, were all well known before the alleged priority date of the ’946 patent. *See* EX1003, ¶¶36-99.

III. CONCLUSION

The Director should deny Meridian’s request to discretionarily deny this IPR and should institute review of the challenged claims.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. §§ 42.6(e), 42.105(a))

I certify that the above-captioned **PETITIONER’S OPPOSITION TO
PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL** and
associated Exhibits 1033-1035 and 1037-1042 were served in their entireties upon
the Patent Owner on December 9, 2025, via electronic mail:

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