

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOUGHBUILT INDUSTRIES, INC.,

Petitioner,

v.

MERIDIAN INTERNATIONAL CO., LTD.,

Patent Owner.

IPR2025-01461

Patent 11,986,946 B2

Before BARRY L. GROSSMAN, ROBERT L. KINDER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

Opinion for the Board filed by GROSSMAN, *Administrative Patent Judge*.

Opinion Concurring filed by HOWARD, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
Patent Owner's Motion To Amend
37 C.F.R. § 42.121(e)

I. INTRODUCTION

On February 18, 2026, we instituted trial as to claims 1–16 of U.S. Patent No. 11,986,946 B2. Paper 14. After institution, Patent Owner filed a Motion to Amend that is contingent on the patentability of claims 1–16. Paper 26 (“Motion” or “Mot.”). Petitioner filed an opposition on August 5, 2026. Paper 29 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requested preliminary guidance in accordance with 37 C.F.R. § 42.121(a)(1)(ii). Mot. 1; *see also* 37 C.F.R. § 42.121(e)(1); *Rules Governing Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 89 Fed. Reg. 76,421 (Sept. 18, 2024) (“Final Rule”). We provide this Preliminary Guidance in view of the Motion and Opposition.

More particularly, we provide our initial, preliminary, non-binding views on whether Patent Owner has shown by a reasonable likelihood that the Motion’s proposed substitute claims 17–32 satisfy the statutory and regulatory requirements associated with a motion to amend and whether Petitioner has shown by a preponderance of evidence that the substitute claims are unpatentable. *See* 37 C.F.R. § 42.121(a)(2), (a)(3), (b), (d)(2), (e)(1), (e)(2); 35 U.S.C. § 316(d); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend). The preliminary guidance is not a “decision” (e.g., for purposes of rehearing under 37 C.F.R. § 42.71(d)) nor binding on the Board. *See* 37 C.F.R. § 42.121(e)(2); *Medytox, Inc. v. Galderma S.A.*, 71 F.4th 990, 1000 (Fed. Cir. 2023). The preliminary guidance is subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner.

The preliminary guidance focuses on the Motion's proposed substitute claims and only on their proposed amendments to the patent's claims. *See* 37 C.F.R. § 42.121(e)(1); Final Rule, 89 Fed. Reg. at 76,425. The preliminary guidance does not address the patentability of other claim limitations. *See id.* The preliminary guidance does not address contentions of the Motion and Opposition if merely incorporating-by-reference arguments of other papers as to the merits of claim limitations (e.g., Petition and Preliminary Response). *See* 37 C.F.R. § 42.6(a)(3) ("Arguments must not be incorporated by reference from one document into another document.").

For the reasons discussed below, Patent Owner has not shown by a reasonable likelihood that substitute claims 17–32 meet the statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. Petitioner has shown by a preponderance of the evidence that the amended limitations of substitute claims 17–32 are unpatentable.

II. PRELIMINARY GUIDANCE

A. The Substitute Claims

Substitute claims 17–32 respectively replace the patent's claims 1–16. A copy of the substitute claims 17–32 is provided by the Motion's Claims Appendix.

Substitute independent claims 17, 27, and 31, reproduced below, amend recitations of the patent's respective claims 1, 11, and 15 (i.e., beyond their dependencies). Underlining indicates added language. Strikethrough indicates deleted language.

17. (substitute for claim 1, if found unpatentable) A storage box comprising:

a first connection part disposed on one area of said storage box connectable to a second connection part of another storage box;

wherein, said first connection part comprises a mounting body, a locking part comprising a locking buckle ~~movable with respect to said mounting body~~, and a first resilient member located between said mounting body and said locking ~~buckle~~ part, wherein the locking part is at least partially received within and movable with respect to the mounting body, and wherein said first resilient member keeping said locking buckle automatically in a locked state;

wherein, said second connection part of the other storage box comprises a mating part interlockable with the locking buckle,

wherein the locking ~~buckle~~ part is configured to slide inward with respect to the mounting ~~part~~ body so that the locking buckle is automatically lockable with the mating part of the other storage box by action of said first resilient member when the locking buckle is aligned with the mating part of the other storage box;

~~a locking part cooperating with the locking buckle~~, wherein manual movement of the locking part causes the locking buckle to move to an unlocked state; and

a stop part, wherein when the stop part projects outward with respect to a locking path of the locking part, said locking part is not automatically lockable and said first connection part is in a state of remaining unlocked from said second connection part, wherein the stop part is retractable, said stop part being extended when said first connection part is in a holding unlocked state with said second connection part of the other storage box, and said stop part being compressed when said first connection part is in a locked state with said second connection part.

27. (substitute for claim 11, if found unpatentable) A storage box comprising:

a first connection part disposed on one area of said storage box connectable to a second connection part of another storage box;

wherein, said first connection part comprises a mounting body, a locking part comprising a locking buckle ~~movable with respect to~~

~~said mounting body~~, and a first resilient member located between said mounting body and said locking ~~buckle part~~, wherein the mounting body is configured to receive at least a portion of the locking part therein and wherein the locking part is movable with respect to the mounting body, and wherein said first resilient member keeping said locking buckle automatically in a locked state;

wherein, said second connection part of the other storage box comprises a mating part interlockable with the locking buckle,

wherein the locking ~~buckle part~~ is configured to slide inward with respect to the mounting ~~part~~ body so that the locking buckle is automatically lockable with the mating part of the other storage box by action of said first resilient member when the locking buckle is aligned with the mating part of the other storage box;

~~a locking part cooperating with the locking buckle~~, wherein manual movement of the locking part causes the locking buckle to move to an unlocked state; and

a stop part, wherein when the stop part projects outward with respect to a locking path of the locking part, said locking part is not automatically lockable and said first connection part is in a state of remaining unlocked from said second connection part;

a second resilient member, and wherein the locking part comprises of a slot, and wherein the stop part is biased outward from the slot by the second resilient member, wherein the stop part moves perpendicular with respect to a sliding path of the locking part.

31. (substitute for claim 15, if found unpatentable) A storage box comprising:

a first connection part disposed on one area of said storage box,

wherein the first connection part comprises a mounting body, a locking part comprising a locking buckle, movable with respect to the mounting body, and a first resilient member located between the mounting body and the locking ~~buckle part~~ to bias the locking buckle automatically outward in a locked state, wherein the locking part is configured to slide within the mounting body;

~~[[a]]~~wherein the locking part configured to move along a horizontal locking path relative to the mounting body and to cooperate with the locking buckle, wherein manual movement of the locking

part along the horizontal locking path causes the locking buckle to move between an unlocked state retracted with respect to the mounting body and a locked state extended with respect to the mounting body;

a stop part combined to the locking part comprising an unlocked state corresponding to the unlocked state of the locking buckle with the stop part extended from the locking part and the locking buckle held retracted with respect to the mounting body, and a locked state corresponding to the locked state of the locking buckle with the stop part retracted with respect to the locking part and the locking buckle held extended with respect to the mounting body; and

a second connection part disposed on another area of said storage box, wherein the second connection part comprises a mating part that corresponds to the locking buckle, wherein said locking part further comprises a holding slot opened on the locking part, and further comprising a second resilient member combined between the holding slot and the stop part, wherein the stop part is extended from the slot in the locking part when the stop part is in the unlocked state, and wherein the stop part is retracted in the slot in the locking part when the stop part is in the locked state.

Mot., Claims App.

B. Statutory and Regulatory Requirements

We first address whether the Motion meets the statutory and regulatory requirements. *See* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121; *Lectrosonics*, Paper 15 at 4. Patent Owner bears the burden to show a reasonable likelihood that: (1) the amendments propose a reasonable number of substitute claims; (2) the amendments respond to a ground of unpatentability involved in the trial; (3) the amendments do not seek to enlarge the scope of the claims of the patent or introduce new subject matter; and (4) the original disclosure sets forth written description support for each proposed substitute claim. 35 U.S.C. § 316(d)(1), (3); *id.* § 42.121(a)(2), (a)(3), (b)(1), (b)(2), (d)(1). For the reasons below, at this stage of the proceeding, and based on the current record, Patent Owner has not shown by

a reasonable likelihood that substitute claims 17–32 satisfy all statutory and regulatory requirements.

1. Reasonable Number of Substitute Claims

A motion to amend must propose a reasonable number of substitute claims. 35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3). Petitioner does not argue that Patent Owner fails to propose a reasonable number of substitute claims. *See Opp.* Patent Owner has shown it proposes a reasonable number of substitute claims by proposing to substitute claims 17–32 respectively for claims 1–16. Mot. 4.

2. Respond to Ground of Unpatentability

A motion to amend must respond to a ground of unpatentability involved in the proceeding. 37 C.F.R. § 42.121(a)(2)(i). The requirement is for a patent owner’s amendment to be responsive to “a ground of unpatentability.” 37 C.F.R. § 42.121(a)(2)(i). There is no requirement to address every element of prior art asserted by the Petition against the claimed subject matter. Patent Owner must rather, and has in the Motion before us, present arguments that the added limitations of the proposed substitute claims respond to a ground of unpatentability. Mot. 9–24. Petitioner does not contend the Motion fails to respond to a ground of unpatentability. *See Opp.*

3. Scope of Amended Claims

A motion to amend may not enlarge the scope of the claims of the patent. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). We conclude the Motion enlarges the scope of the claims of the patent.

i. Independent Claims 17 and 27

Substitute independent claims 17 and 27 identically amend the patent’s respective claims 1 and 11, which are two of the patent’s only three independent

claims. Mot., Claims App.; Ex. 1001, claims 1–16. Specifically, claims 17 and 27 respectively amend claims 1 and 11 to: (i) change “locking buckle movable with respect to said mounting body” (claims 1 and 11) to “locking part comprising a locking buckle . . . [and] at least partially received within and movable with respect to the mounting body” (claim 17 and 27); (ii) change “locking buckle is configured to slide inward with respect to the mounting part” (claims 1 and 11) to “locking part is configured to slide inward with respect to the mounting body” (claims 17 and 27); and (iii) delete “locking part cooperating with the locking buckle” (claims 1 and 11). Mot., Claims App.

Petitioner contends the first (i) amendment broadens each of claims 17 and 27 by removing the requirement for the “locking buckle” to move¹ with respect to the mounting body. Opp. 4–5. We agree. Though each of claims 17 and 27 instead requires the “locking part” to move with respect to the mounting body, the locking part comprises the locking buckle and thus the respective movement of the locking part need not be (but rather can be) a movement of the locking buckle. Claims 1 and 11, however, require such movement of the locking buckle.

We add that the second (ii) amendment similarly broadens each of claims 17 and 27 by removing the requirement for the “locking buckle” to slide inward with respect to the mounting part. Though each of claims 17 and 27 instead requires the “locking part” to slide inward with respect to the mounting body, the locking part comprises the locking buckle and thus the sliding of the locking part need not be (but rather can be) a sliding of the locking buckle. Claims 1 and 11, however, require such sliding of the locking buckle.

¹ For convenience, we will reference claimed capabilities (e.g., “movable” and “configured to slide”) with action verbs (e.g., moves, slides, etc.). We do not, however, construe the claimed capabilities as requiring such action.

We also add that the third (iii) amendment deleting “locking part cooperating with the locking buckle” (claims 1 and 11) may be broadening. Though each of claims 17 and 27 instead requires the “locking part comprising a locking buckle,” we are not apprised by Patent Owner that the added “comprising a locking buckle” (claims 17 and 27) and deleted “cooperating with the locking buckle” (claims 1 and 11) have same scopes.²

We further add that the amendments of claims 17 and 27 may narrow claims 1 and 11 in two respects. First, the amendments of claims 17 and 27 recite—whereas claims 1 and 11 do not recite—a locking element (locking part) “at least partially received within” a mounting element (mounting body). Second, if the mounting part of claims 17 and 27 includes the mounting body (assuming *arguendo*), similar to disclosed invention’s mounting portion 11 including the mounting body 112, then the amendments of claims 17 and 27 narrow the sliding inward from being “with respect to the mounting part” (claims 1 and 11) to being “with respect to the mounting body” (claims 17 and 27). *See* Ex. 1001, 6:55–56 (“mounting portion 11 includes . . . a mounting body 112). Nonetheless, regardless of any narrowing of claims 17 and 27 as above, the amendments of claims 17 and 27 broaden the scope of the patent’s claims by broadening claims 1 and 11 in some respects (as described above). *See Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2 (Fed. Cir. 1987) (“[A] claim that is broader in any respect is considered to be broader than the original claims even though it may be narrower

² We understand such a construction may be forthcoming. The recently filed Reply (Paper 30) of Petitioner states the parties agreed in the district court that the deleted locking part “cooperating” with the locking buckle should be construed as merely a locking part “including” a locking buckle.” Paper 30 at 3 (citing Ex. 1027 at 3; Ex. 1028 at 10).

in other respects.”); 37 C.F.R. § 1.175(b) (“A claim is broadened if the claim is broadened in any respect.”).

ii. Independent Claim 31

Substitute independent claim 31 amends the patent’s respective claim 15, which is the last of the patent’s only three independent claims. Mot., Claims App.; Ex. 1001, claims 1–16. Specifically, claim 31 amends claim 15 to: (iv) change “locking buckle[] movable with respect to said mounting body” (claim 15) to “locking part comprising a locking buckle . . . [and] configured to slide within the mounting body” (claim 31); (v) change the location of the first resilient member located from between the mounting body “and the locking buckle” (claim 15) to between the mounting body “and the locking part” (claim 31); and (vi) specify the configuration of the locking part “to move along a horizontal locking path” (claim 15) as a configuration to move so “relative to the mounting body” (claim 31). Mot., Claims App.

Petitioner contends each of the fourth (iv) amendment and fifth (v) amendment broadens the patent’s claim 15 similarly to how the first (i) amendment of claims 17 and 27 broadens the patent’s respective claims 1 and 11 by changing “locking buckle” to “locking part.” Opp. 4–5. We agree for the reasons expressed above as to the first (i) amendment.

We add that the fourth (iv) amendment narrows claim 15 by changing “movable with respect” (claim 15) to “slide within” (claim 31). Nonetheless, the scope of the patent’s claims is broadened by the above change to “locking part.” *See, as parenthetically cited above, Tillotson*, 831 F.2d at 1037 n.2; 37 C.F.R. § 1.175(b).

We also add that the sixth (vi) amendment adds language describing the locking part’s “horizontal locking path” (claim 15) as being “relative to the

mounting body” (claim 31). Mot., Claims App. We are not apprised of whether “relative to the mounting body” (claim 31) modifies “horizontal” (e.g., as being horizontal to a surface of the mounting body), “locking” (e.g., as affixing the locking part to the mounting body), or “path” (e.g., as being directed toward the mounting body). *See* Mot; *HTC Corp. v. IPCom GmbH & Co.*, 667 F.3d 1270, 1274–75 (Fed. Cir. 2012) (“Modifiers should be placed next to the words they modify. William Strunk, Jr. & E.B. White, *The Elements of Style* 30 (4th ed. 2000).”). Therefore, lacking an asserted meaning of “relative to the mounting body” (claim 31), we conclude Patent Owner fails to show the sixth (vi) amendment is not broadening.

4. New Matter

An amendment may not introduce new matter. 35 U.S.C. § 316(d)(3); 37 C.F.R. §§ 42.121(b)(1), (b)(2). New subject matter is any addition to the claims that lacks sufficient support in the subject patent’s originally-filed disclosure. *See TurboCare Div. of Demag Delaval Turbomach. v. Gen. Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001) (“When [an] applicant adds a claim . . . , the new claim[] must find support in the original specification.”).

Patent Owner is required to show written description support in “the original disclosure of the patent for each claim that is . . . amended,” and in “an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.” 37 C.F.R. § 42.121(b). Thus, for each substitute claim, a motion to amend must identify written description support in the originally-filed disclosure of the patent and in an earlier-filed disclosure if a respective benefit of priority is sought. *See* 37 C.F.R. §§ 42.121(b)(1), 42.121(b)(2).

We compared the amendments of the substitute claims against the patent’s originally-filed disclosure. Ex. 1002 at 1–37, 231–246. We determined that each of

the amendments is plainly conveyed by the figures³ and corresponding Specification descriptions thereof, which name disclosed elements identically to the claimed elements (e.g., a “locking part 12” comprising a “locking buckle 122” (Ex. 1002 at 14)). Indeed, the figures (Ex. 1002 at 231–246) are alone sufficient. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 2002) (drawings alone may be sufficient); *In re Wolfensperger*, 302 F.2d 950, 955 (CCPA 1962) (disclosure may be found in drawings). And, the Motion indicates the figures via direct citation (Figures 6–7) and their cited Specification descriptions (6:53–7:20). Mot. 6–8.

Petitioner contends the Motion does not cite support in the original disclosure for the claims as a whole. Opp. 3–4. We are unpersuaded because Petitioner does not address the aforesaid figures; e.g., Figure 7 illustrates a locking part 12 including a locking buckle 122 and movable with respect to a mounting body 112. Ex. 1001, Fig. 7.

5. Conclusion as to Statutory Requirements

Based on our review of the current record, Patent Owner’s Motion establishes, by a reasonable likelihood, that the number of substitute claims is reasonable, the amendments of the substitute claims are responsive to a ground of unpatentability, and the patent’s original disclosure supports the amendments of the substitute claims (i.e., the amendments do not introduce new subject matter).

³ Figures 1–14 of the patent, patent’s originally-filed disclosure, and Chinese priority application 202210212862.5 are identical. *Compare* Ex. 1001, Figs. 1–14 *with* Ex. 1002 at 231–239 *and with* Ex. 2019 at 16–24. Figures 15–26 of the patent, patent’s originally-filed disclosure, and Chinese priority application 202320135456.3 are identical. *Compare* Ex. 1002, Figs. 15–26 *with* Ex. 1002 at 240–246 *and with* Ex. 2020 at 15–22.

However, the Motion fails to establish that the amendments of the substitute claims do not enlarge the scope of the patent's claims.

C. Unpatentability Arguments by Petitioner

As discussed above, Petitioner bears the ultimate burden to show that any proposed substitute claims are unpatentable. 37 C.F.R. § 42.121(d)(2). And, our Preliminary Guidance focuses on the limitations amended by the Motion's proposed substitute claims into the patent's claims. *See* 37 C.F.R. § 42.121(e)(1); Final Rule, 89 Fed. Reg. at 76,425. For the reasons discussed below, at this stage of the proceeding, and based on the current record, Petitioner has shown by a preponderance of evidence that proposed substitute claims 17–32 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).

1. Independent Claim 17

The preamble and added limitations of substitute independent claim 21, reproduced below, are as follows:

17. (substitute for claim 1, if found unpatentable) A storage box comprising:

. . . ;

wherein, said first connection part comprises a mounting body, a locking part comprising a locking buckle ~~movable with respect to said mounting body~~, and a first resilient member located between said mounting body and said locking ~~buckle~~ part, wherein the locking part is at least partially received within and movable with respect to the mounting body, and wherein said first resilient member keeping said locking buckle automatically in a locked state;

wherein the locking ~~buckle~~ part is configured to slide inward with respect to the mounting ~~part~~ body . . . ;

Mot., Claims App. Generally speaking, we agree with Petitioner's following characterization of the amendments:

Meridian's proposed substitute claims boil down to just four modifications to the original independent claims: (1) deleting the requirement that the locking buckle is movable with respect to a mounting body; (2) deleting the requirement that "first resilient member" is located between the "mounting body" and the "locking buckle"; (3) adding that the "first resilient member" is located between the "mounting body" and the "locking part"; and (4) adding that the "locking part is at least partially received within and movable with respect to the mounting body." MTA, Appendix A.

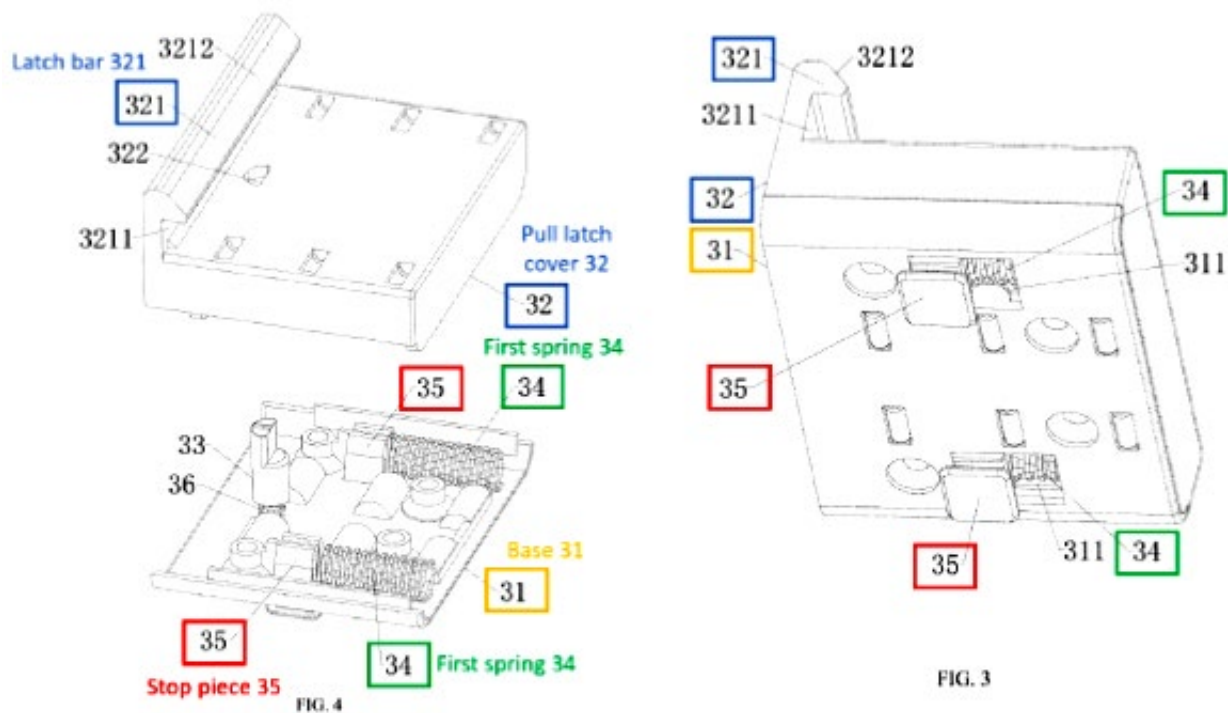
Opp. 5–6. We also agree with Petitioner that the prior art of record teaches the new limitations. *Id.* at 6–23.

i. Li

Petitioner challenges claim 17 as being disclosed by and obvious over Li. Opp. 6. We decline to address herein whether, as Petitioner contends, Li teaches or suggests the unamended limitations for reasons presented by the Petition. Opp. 6 (citing Pet. at 12–56).⁴ We thus address only whether, as Petitioner also contends, the amended limitations are disclosed by or obvious over Li. Opp. 6 (citing Ex. 1044 ¶¶ 8–9). As discussed below, we agree with Petitioner that the amended limitations do not patentably distinguish claim 17 over Li's Figures 3–5. *Id.*

Li's Figures 3–5 are respectively "a schematic diagram of an overall structure of an elastic pull latch" (Fig. 3), "a schematic diagram of an internal structure of [the] pull latch" (Fig. 4), and "a schematic diagram of a carrier cover configured with [the] pull latch" (Fig. 5). Ex. 1007 ¶¶ 20–22. Li's Figures 3–5 are reproduced below (respectively top-left, top-right, and bottom) as presented in the Opposition with annotations. Opp. 6–9.

⁴ We are not apprised of the amended subject matter being incorporated from any dependent claims. *See* Opp.; Mot.; Mot, Claims App.



EX1007, FIGs. 3-4 (annotated).

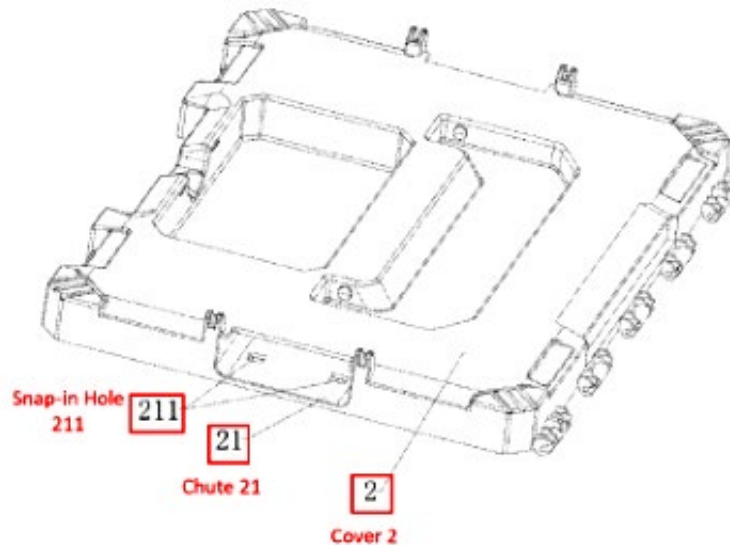


FIG. 5
 EX1007, FIG. 5 (annotated).

As shown above, the Opposition presents Li's Figures 3–5 with blue, yellow, red, and green annotations demarking features of Li throughout the figures (i.e., to ease identification) and mapping the features to claim elements (discussed

below). Opp. 6–9. Petitioner maps the principal claim elements to Li’s pull latch 3 (Figures 3–4) and chute 21 (Figure 5) as follows: (a) claimed locking part to Li’s pull latch cover 32 (blue), latch bar 321 (blue), and base 31 (yellow); (b) claimed locking buckle to Li’s latch bar 321 (blue); (c) claimed mounting body to Li’s chute 21 (red), included snap-in hole 211 (red), and inserted stop piece 35 (red) when received by the snap-in hole 211 (red); and (d) claimed first resilient member to Li’s first spring 34 (green). Opp. 6–9 (citing Ex. 1007, ¶¶ 27, 32–34, 37); Ex. 1044 ¶¶ 8–14. Because Li’s pull latch cover 32 includes the latch bar 321 (and base 31), we agree these features achieve the claimed “locking part comprising a locking buckle.” Opp. 7; Ex. 1044 ¶ 9. Because Li’s first spring 34 is located between the stop-piece 35 and pull latch cover 32, we agree these features achieve the claimed “first resilient member located between said mounting body and said locking part.” Opp. 9; Ex. 1044 ¶ 12. Because Li’s pull latch 3 (pull-latch cover 32 and base 31) is mounted to the cover 2 by the chute 21, snap-in hole 211, and stop piece 35, and because the mounted pull latch 3 is thereby received within and slides with respect to the chute 21, we agree these features achieve the claimed “locking part is at least partially received within and movable with respect to the mounting body.” Opp. 8; Ex. 1044 ¶¶ 10–11. Because Li’s pull latch 3 slides towards the center of the cover 2, and particularly along a direction defined by (including) the chute 21 and the center of the cover 2, we agree these features achieve the claimed “locking part is configured to slide inward with respect to the mounting body.” Opp. 9; Ex. 1044 ¶¶ 13.

Patent Owner contends, in the Motion,⁵ Li's chute 21, snap-in hole 211, and stop piece 35 should not be collectively construed as a "mounting body" because:

This interpretation of the "mounting body" is unduly narrow and contradicts the plain and ordinary meaning of the term "mounting body." Petitioner's expert contends that, based on the specification of the '946 Patent, "mounting body" includes "whatever parts are required [] to create the structure that holds the latch to the storage box." (Exhibit 2014, 30:20–32:7.) However, a POSA would understand that, contrary to the assertions of Petitioner's expert, "mounting body" has a plain and ordinary meaning, which is the portion of the first connection part attached to the body of the storage container relative to which the locking buckle slides. (Exhibit 2012, ¶72.)

Mot. 11. As reflected above, Petitioner reasonably contends (albeit implicitly) that a plain and ordinary meaning of "mounting body" is an interconnected aggregate of elements ("body" (n.)) that mounts something ("mounting" (adj.)). Opp. 7–8; Ex. 1044 ¶¶ 10; *see also In re Hyatt*, 708 F.2d 712, 714 (Fed. Cir. 1983) ("A claim must be read in accordance with the precepts of English grammar."). Patent Owner does not meaningfully respond; e.g., the cited paragraph 72 of Patent Owner's expert declaration (Ex. 2012) merely identifies the disclosed invention's element termed a "mounting body 112" by the Specification. *See Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1337 (Fed. Cir. 2005) ("[A]bsent a clear disclaimer in the specification, the embodiments in the specification do not limit broader claim language."). We accordingly accept Petitioner's construction as an unrebutted, ordinary usage of "mounting" and "body."

We add that the disclosed invention's "mounting body 112" mounts the "locking part 12" to the "mounting slot 111." Ex. 1001, Fig. 7. Similarly,

⁵ Patent Owner asserts the Motion's arguments are discussed further in other papers. *See, e.g.,* Mot. 10 ("discussed more fully in the Response"). We reiterate that merely incorporated arguments are not considered herein. *See supra* 3.

Li's stop-piece 35 mounts the pull latch 3 to the chute 21 (by insertion to the included snap-in hole 211). Thus, the patent's verbiage indicates Li's stop piece 35 and chute 21 would have been understood as "mounting" elements, which supports finding the stop piece 35 and chute 21 are parts of a "mounting" body.

Patent Owner also contends, in the Motion, Li's pull latch 3 does not achieve the claimed locking part as recited within the "locking part is at least partially received within . . . the mounting body." Mot. 12–13. Patent Owner specifically contends Li's stop-piece 35, though received within the snap-in holes 211, is not part of the pull latch 3. *Id.* We are unpersuaded because, as explained above, the claimed locking part is mapped to Li's pull latch 3 sans the stop-piece 35, the claimed mounting body is mapped to Li's chute 21, included snap-in holes 211, and inserted stop-piece 35 (received in the snap-in holes 211), and the pull latch 3 is received/sits within the chute 21. By this configuration, Li's pull latch 3 (mapped to the claimed locking part) is received within the chute 21 (mapped to the claimed mounting body).

Patent Owner also contends, in the Motion, Li's pull latch 3 does not achieve the claimed locking part within the "first resilient member located between said mounting body and said locking part." Mot. 13. Patent Owner specifically contends Li's first spring 34 (mapped to claimed first resilient member) is part of the pull latch 3 (mapped to claimed locking part) and thus cannot be located between the pull latch 3 and another element. Mot. 13. We are unpersuaded because, as explained above, the claimed locking part is mapped to Li's pull latch 3 sans first spring 34 (as well as sans the stop-piece 35). Opp. 9; Ex. 1044 ¶ 12. Because Li's first spring 34 is located between the stop-piece 35 and pull latch cover 32, these features achieve the claimed "first resilient member located between said mounting body and said locking part." *Id.*

ii. Baruch

Petitioner challenges claim 17 as being disclosed by and obvious over Baruch. Opp. 10. We decline to address herein whether, as Petitioner contends, Baruch teaches or suggests the unamended limitations for reasons presented by the Petition. Opp. 10 (citing Pet. at 96–134).⁶ We thus address only whether, as Petitioner also contends, the amended limitations are disclosed by or obvious over Baruch. Opp. 10–11 (citing Ex. 1044 ¶¶ 20–23). As discussed below, we agree with Petitioner that the amended limitations do not patentably distinguish claim 17 over Baruch’s Figures 21, 22, 23B, and 24A–C. *Id.*

Baruch’s Figures 21, 22, 23B, and 24A–C are respectively “a rear perspective view of a latch mechanism” (Fig. 21), “an exploded view of the latch mechanism” (Fig. 22), “a detailed view of [a] carveout wherein the latch of the fourth embodiment is positioned” (Fig. 23B), and “[schematic views] depict[ing] the progression of [the] latch . . . engaging a second container” (Figs. 24A–C). Ex. 1012 ¶¶ 31–32, 34, 36. Figures 21, 22, 23B, and 24A–C are reproduced below (seriatim) as presented in the Opposition with annotations. Opp. 10–15.

⁶ We are not apprised of the amended subject matter being incorporated from any dependent claims. *See* Opp.; Mot.; Mot, Claims App.

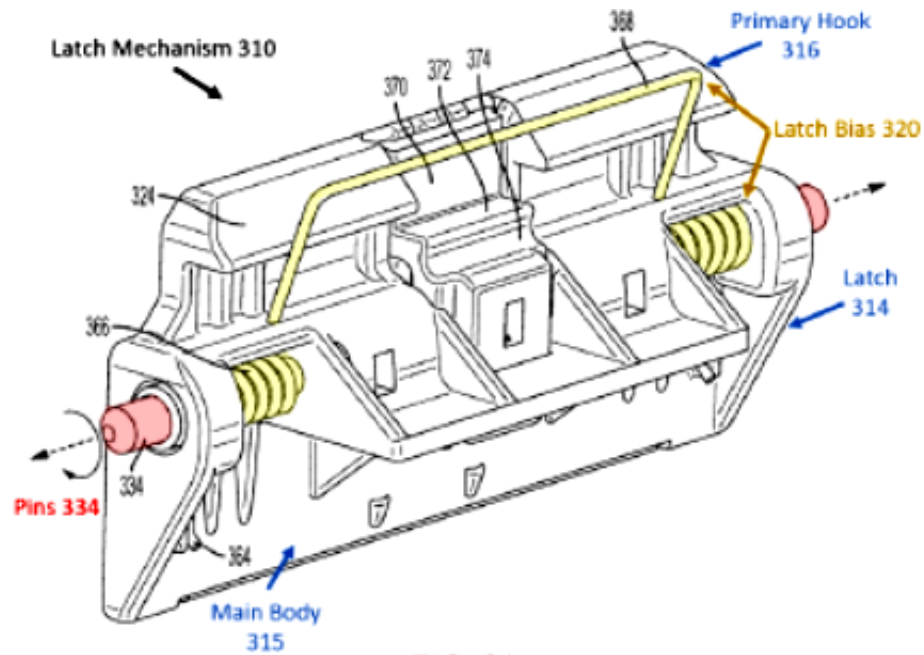


FIG. 21

EX1012, FIG. 21 (annotated).

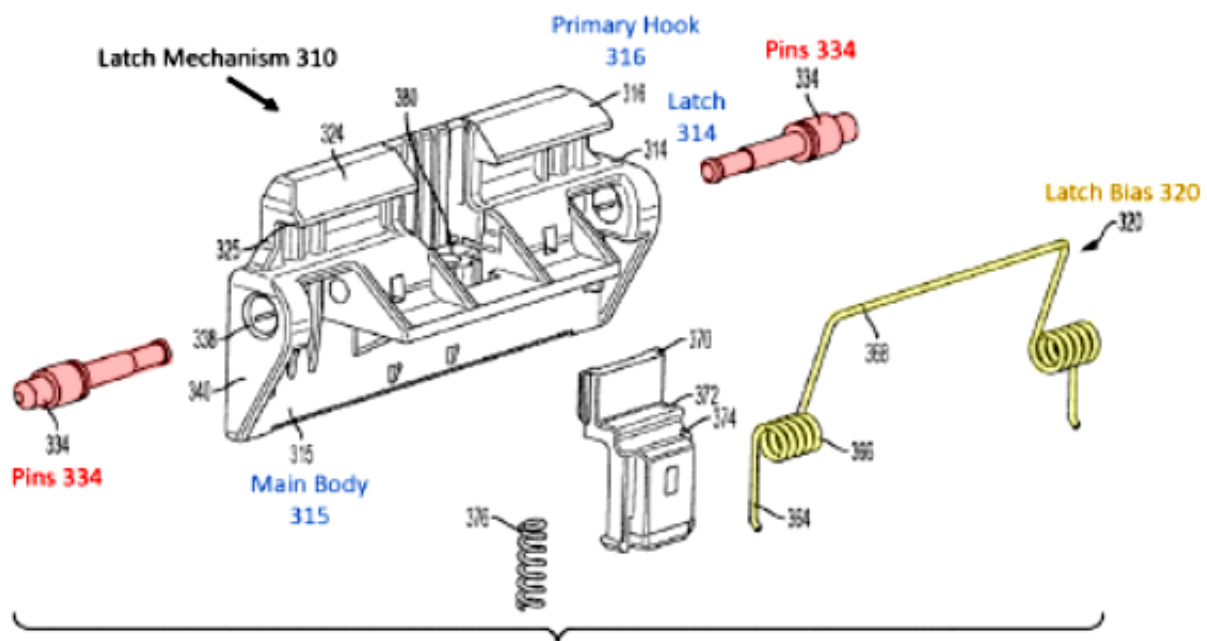


FIG. 22

EX1012, FIG. 22 (annotated).

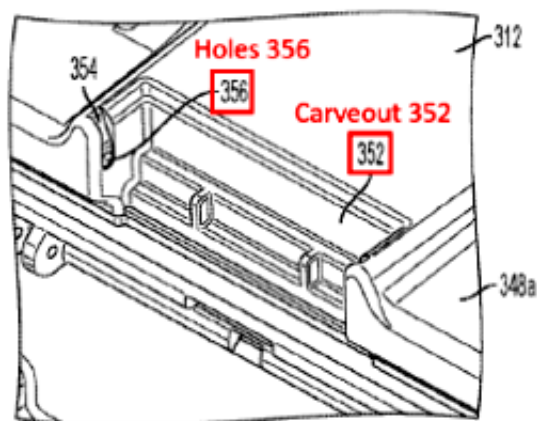


FIG. 23B

EX1012, FIG. 23B (annotated).

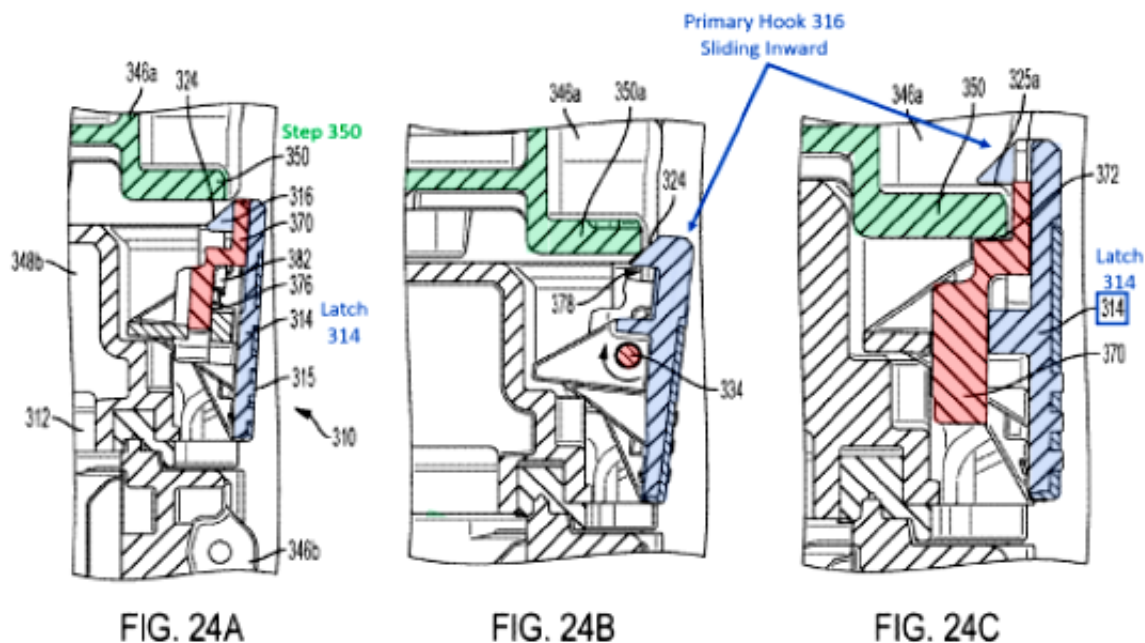


FIG. 24A

FIG. 24B

FIG. 24C

EX1012, FIGs. 24A-24C (annotated).

As shown above, the Opposition presents Baruch's Figures 21, 22, 23B, and 24A–C with blue, yellow, red, and green annotations demarking respective features of Baruch throughout the figures (i.e., to ease identification) and as mapped to claim elements (discussed below). Opp. 10–15. Petitioner maps the principal claim elements to Baruch's latch mechanism as follows: (a) claimed locking part to

Baruch's latch 314 (blue) including the main body 315 (blue) and primary hook 316 (blue); (b) claimed locking buckle to Baruch's primary hook 316 (blue); (c) claimed mounting body to Baruch's carveout 352 (red) with pins 334 (red) inserted into holes 356 (red); and (d) claimed first resilient member to Baruch's latch bias 320 (yellow). Opp. 11 (citing Ex. 1007, ¶¶ 27, 32–34, 37); Ex. 1044 ¶¶ 20–26. Because Baruch's latch 314 includes the primary hook 316, we agree these features achieve the claimed "locking part comprising a locking buckle." Opp. 11; Ex. 1044 ¶ 21. Because Baruch's latch bias 320 is located between the pins 334 and main body 315 (of the latch 314), we agree these features achieve the claimed "first resilient member located between said mounting body and said locking part." Opp. 14; Ex. 1044 ¶ 25. Because Baruch's latch 314 (main body 315 and primary hook 316) is mounted to the lid 348 by the carveout 352, pins 334, and holes 356, and because the primary hook 316 of the latch 314 slides onto and along the bottom surface of the carveout 352 to secure the lid 348, we agree these features achieve the claimed "locking part is at least partially received within and movable with respect to the mounting body." Opp. 12–14; Ex. 1044 ¶¶ 22–24. Because Baruch's primary hook 316 (of the latch 314) slides towards the center of the lid 348, and particularly along a direction defined by (including) the carveout 352 and the center of the lid 348, we agree these features achieve the claimed "locking part is configured to slide inward with respect to the mounting body." Opp. 14–15; Ex. 1044 ¶ 26.

Patent Owner contends, in the Motion, Petitioner unreasonably maps Baruch's carveout 352, included holes 356, and inserted pins 334 collectively to the claimed "mounting body." Mot. 15–16. The argument is substantially the same as Patent Owner's above-addressed argument that Li's chute 21, snap-in hole 211, and stop piece 35 should not be collectively construed as a "mounting body."

Supra at 17–18. For the reasoning already presented with respect to Li, we again disagree with this argument as presented with respect to Baruch; i.e., we accept Petitioner’s construction of “mounting body” as an unrebutted, ordinary usage of “mounting” and “body.” *Id.*

Patent Owner also contends, in the Motion, Baruch’s latch 310 does not achieve the claimed locking part as recited within the “locking part is at least partially received within . . . the mounting body.” Mot. 16. Patent Owner specifically contends Baruch’s pins 334, though received within the holes 356 of the carveout 352 (claimed mounting body), are not part of the latch 310 (claimed locking part). *Id.* We are unpersuaded because, as explained above, the claimed locking part is mapped to Baruch’s latch 310 (mapped to claimed locking part) as received/sitting within the carveout 352 (mapped to claimed mounting body). *See supra* 21–22. Further, Baruch’s pins 334 are not mapped to the claimed locking part, but rather mapped to the claimed mounting body. *Id.* at 21.

Patent Owner also contends, in the Motion, Baruch’s latch 310 does not achieve the claimed locking part within the “first resilient member located between said mounting body and said locking part.” Mot. 13. Patent Owner specifically contends Baruch’s latch bias 320 (first resilient member) is part of the latch 310 (claimed locking part) and thus cannot be located between the latch 310 and another element. Mot. 17. We are unpersuaded because, as explained above, the claimed locking part is mapped to Baruch’s latch 310 sans the latch bias 320 (as well as sans the pins 334). *See supra* 22.

Patent Owner also contends, in the Motion, Baruch’s latch 310 does not achieve the claimed locking part within the claimed “locking part is configured to slide inward with respect to the mounting body.” Mot. 17. Patent Owner specifically contends Baruch’s latch 310 rotates about the pins 334 whereas

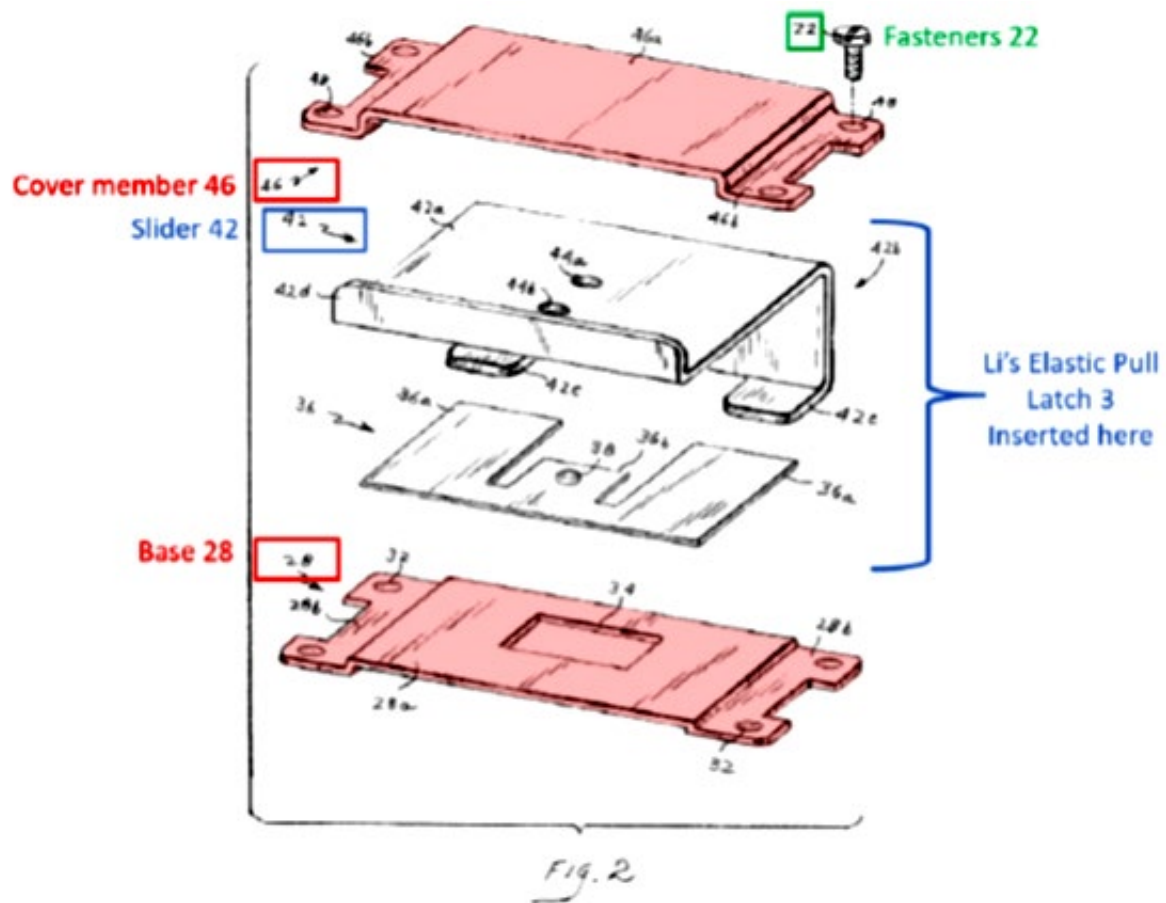
“[s]liding implies linear motion.” Mot. 17. We are unpersuaded because, as explained above, Baruch’s primary hook 316 of the latch 314 slides onto and along the bottom surface of the carveout 352 to secure the lid 348. *See supra* 22. Patent Owner does not address this sliding of the primary hook 316 caused by rotation of the latch 310 about the pins 334. *See* Mot.

iii. Riley⁷

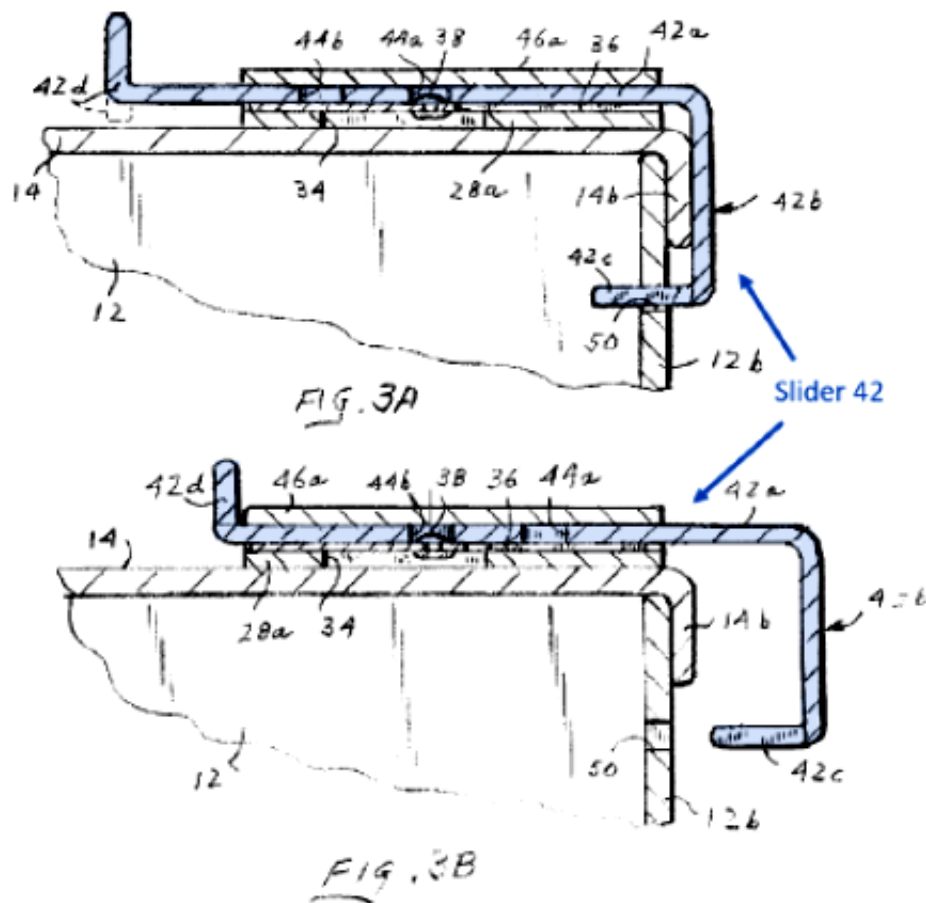
As an alternative to mapping the claimed mounting body to only Li’s chute 21, included snap-in hole 211, and inserted stop piece 35 (*see supra* § II.C.1.iii), Patent Owner additionally maps the claimed mounting body to a modification of Li’s above embodiment in view of newly submitted Riley. Opp. 16–23. As discussed below, we agree with Petitioner that the amended limitations do not patentably distinguish claim 17 over Li’s above teachings as modified in view of Riley’s Baruch’s Figures 2 and 3A–B. *Id.*

Riley’s Figures 2 and 3A–B are respectively “an exploded perspective view . . . of [a] latch assembly” (Fig. 2), “[a] sectional view . . . showing the latch assembly in its latched condition” (Fig. 3A), and “a [sectional] view showing the latch assembly in its unlatched condition” (Fig. 3B). Ex. 1045 at 2:55–62. Riley’s Figures 2 and 3A–B are reproduced below (seriatim), from the Opposition, with Petitioner’s blue and red annotations emphasizing a sliding element 42 (blue) sandwiched between a cover plate 46a (red) and base plate 28 (red). Opp. 17–19.

⁷ U.S. Patent No. 6,508,495 B1 to Riley (Ex. 1045).



EX1045, FIG. 2 (annotated).



EX1045, FIGs. 3A-3B (annotated).

As shown above, the Opposition presents Riley's Figures 2 and 3A–B with blue and red annotations emphasizing a sliding element 42 (blue) sandwiched between a cover plate 46a (red) and base plate 28 (red). Opp. 17–19. The proposed modification sandwiches Li's sliding member between a cover plate 46a and base plate 28, in view of Riley, to hold Li's pull latch 3 more securely to the chute 21. Opp. 20; Ex. 1044 ¶¶ 33–36. The base plate 28 is modified to include holes aligned with Li's snap-in holes 211, such that the stoppieces 35 can still be received by the snap-in holes 211. Opp. 20; Ex. 1044 ¶ 37. Petitioner contends, and we agree, the modification would have been a predictable means of reinforcing the affixation of Li's pull latch 3 to the chute 21. Opp. 21–22; Ex. 1044 ¶ 40; *see also Tokai Corp.*

v. Easton Enters., Inc., 632 F.3d 1358, 1371 (Fed. Cir. 2011) (“We have consistently stated that courts may find a motivation to [modify] in the nature of the problem to be solved[. T]his form of motivation . . . is particularly relevant with simpler mechanical technologies[.]”) (internal quotation marks and brackets omitted)); *Sanofi-Aventis Deutschland GmbH v. Glenmark Pharms. Inc., USA*, 748 F.3d 1354, 1360 (Fed. Cir. 2014) (“[I]n the medical arts . . . solutions are less likely to be genuinely predictable . . . as compared with other arts such as the mechanical devices in KSR.”).

The claimed mounting body is mapped to Li’s chute 21, snap-in hole 211, stop piece 35 (as discussed for Li alone) plus the added cover plate 46a and base plate 28 (in view of Riley). Opp. 16, 19. Petitioner contends, and we agree, the modification achieves the claimed locking part “at least partially received within and movable with respect to the mounting body” and “configured to slide inward with respect to the mounting body” because Li’s pull latch 3 slides between the cover plate 46a and base plate 28. *Id.* at 20. Petitioner also contends, and we agree, the modification achieves the claimed “first resilient member located between said mounting body and said locking buckle part” because Li’s first spring 34 remains (i.e., regardless of the modification) situated between the stop piece 35 and pull latch cover 32. *Id.* at 20–21.

2. Independent Claims 27 and 31

The amendments of substitute independent claim 27 are identical to the amendments of substitute independent claim 21. Mot., Claims App. Further, Petitioner advances substantially the same contentions for claims 21 and 27.

See Opp. 6–15. Accordingly, our above analysis for claim 21 applies equally to claim 27. *See* Opp. 6–15.

The amendments of substitute independent claim 31 are substantially the same as the amendments of substitute independent claim 21. Mot., Claims App. The only notable difference is that the amendments of claim 31 additionally recite that the locking part “is configured to move along a horizontal locking path relative to the mounting body,” whereas the amendments of claim 21 similarly but more broadly recite that the locking part “is movable with respect to the mounting body” (i.e., omitting the horizontal requirement). Further, Petitioner advances substantially the same contentions for claims 21 and 31. *See* Opp. 6–15. Accordingly, our above analysis for claim 21 applies equally to claim 31.

3. Dependent Claims 18–26, 28–30, and 32

Petitioner repeatedly contends none of the substitute dependent claims 18–26, 28–30, and 32 add limitations to their respective independent base claims 17, 27, and 31. *See* Opp. We agree. Accordingly, because the amendments of claims 17, 27, and 31 (incorporated by claims 18–26, 28–30, and 32) are unpatentable over the prior art of record, substitute claims 18–26, 28–30, and 32 are unpatentable over the prior art of record if the patent’s respective dependent claims 2–10, 12–14, and 16 are unpatentable over the prior art of record (as will be addressed in a separate paper).

4. Production of Potential Prior Art.

Petitioner also asserts that Patent Owner has not produced information that is material to the patentability of substitute claims. Opp. 24–25. We recognize that

Patent Owner has a duty of disclosure under 37 C.F.R. §§ 42.11; 42.51(b)(1)(iii), (b)(2)(ii).

Petitioner asserts that information referred to in deposition testimony of Dr. Vallee, Patent Owner's declarant, relates to an apparent new product for the "Irwin company." We have not been directed to any evidence that Dr. Vallee worked for Patent Owner. His career has been as an academic, working for various companies, and as an independent consultant. Ex. 2012 ¶¶ 2–6. We have not been directed to any evidence of a relationship between the "Irwin company" and Patent Owner. We have not been directed to any evidence that Patent Owner was involved in, or aware of, Dr. Vallee's project for "Irwin company."

In response to a request for information, Petitioner was advised that "Dr. Vallee 'is unaware of any documents' that still exist in his or University records, and that they [Patent Owner, on behalf of itself and Dr. Vallee] will supplement 'should any relevant requested materials be discovered during the pendency of these IPRs.'" Opp. 25.

On this record, we are not persuaded that Patent Owner, or Dr. Vallee, has withheld any documents from Petitioner relating to the "Irwin company." However, we also determine that Patent Owner's response is not fully compliant with its obligation to timely search for and produce relevant documents. The response that Patent Owner and Dr. Vallee will "supplement" its obligation to identify and produce relevant documents "should any relevant requested materials be discovered during the pendency of these IPRs" is not sufficient. Patent Owner cannot set its own undefined schedule for meeting its obligation to search for and produce relevant documents. Production sometime "during the pendency of these IPRs" does not meet Patent Owner's obligation in this proceeding. Accordingly, Patent Owner is required within seven (7) days of the date of this Decision to

provide Petitioner and the Board with a statement of the scope of its search for relevant documents concerning the “Irwin company” matter identified in Dr. Vallee’s deposition testimony and to produce to Petitioner any relevant documents found in its search, as required by its duty of disclosure under 37 C.F.R. §§ 42.11; 42.51(b)(1)(iii), (b)(2)(ii).

III.CONCLUSION

This concludes our Preliminary Guidance. Patent Owner has the option to reply to this Preliminary Guidance *or* to file a revised MTA by DUE DATE 3 of the Scheduling Order (September 16, 2026). 37 C.F.R. § 42.121(e)(3), (f); Paper 16. Patent Owner’s reply or revised MTA may only respond to this Preliminary Guidance or Petitioner’s Opposition and may be accompanied by new evidence (including declarations). 37 C.F.R. § 42.121(e)(3). Petitioner has the option to file a sur-reply responsive to this Preliminary Guidance, Patent Owner’s reply, or Patent Owner’s revised MTA but may not present new evidence in any case. 37 C.F.R. § 42.121(e)(3). Petitioner may also file a reply to the preliminary guidance in the case Patent Owner does not file a reply or revised MTA. 37 C.F.R. § 42.121(e)(4).

We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision.

In addition, Patent Owner is reminded that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an AIA trial proceeding, including subsequent to the issuance of the Final Written Decision. We draw Patent Owner’s attention to the

April 2019 Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See 37 C.F.R. § 42.8(a)(3), (b)(2).*

Additionally, Patent Owner is required to comply with the schedule for the search for, and production of, relevant documents, as stated in Section II.C.4 of this Decision.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOUGHBUILT INDUSTRIES, INC.,

Petitioner,

v.

MERIDIAN INTERNATIONAL CO., LTD.,

Patent Owner.

IPR2025-01461

Patent 11,986,946 B2

Before BARRY L. GROSSMAN, ROBERT L. KINDER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*, Concurring

I join with the Majority for all of this Decision except for Section II.B.4. Contrary to the Majority’s guidance, Patent Owner has not sufficiently shown that the amended claims do not “introduce new matter” as required by 35 U.S.C. § 316(d)(3).

We require that a party filing a motion to amend show there is no new matter being added to the claims by “set[ting] forth written description support in the originally filed disclosure of the subject patent for each proposed substitute claim,

and also set forth support in an earlier filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.” *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 7 (PTAB Feb. 25, 2019)

(precedential). That support must be shown “in the originally filed disclosure of the subject patent for each proposed substitute claim, and also set forth support in an earlier filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.” *Id.* Accordingly, “to meet this requirement, citation should be made to the original disclosure of the application, as filed, rather than to the patent as issued.” *Id.* at 8. Importantly, that “written description support must be set forth in the motion to amend itself.” *Id.*

As Petitioner points out (*see* Paper 29, 3–4), Patent Owner does not state in its Motion to Amend where written description support is found for all of the limitations of the claims. *See* Paper 26, 4–8. Although Patent Owner identifies where written description support can be found for the new limitations, Patent Owner does not address the original limitations of the claims. *See id.* Moreover, Patent Owner improperly cites the issued patent and not to the original disclosure of the application. *See id.* Accordingly, Patent Owner has not satisfied its burden to show that no new matter has been added.

The Majority focuses on whether support can be found in the figures submitted with the original application. *See* Decision at 11–14. But the fact that there may be written description support does not remove the obligation of Patent Owner to identify that written description support in the motion to amend with citation to the original disclosure. *See Lectrosonics*, IPR2018-01129, Paper 15 at 7–8. Patent Owner has not done so. Accordingly, this is an additional reason as to how Patent Owner has not shown by a reasonable likelihood that substitute claims 17–32 satisfy all statutory and regulatory requirements.

IPR2025-01461

Patent 11,986,946 B2

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