

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 IPR2025-01462
U.S. Patent No. 11,192,689

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

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	DISCRETIONARY CONSIDERATIONS FAVOR INSTITUTION	1
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.	1
B.	Meridian has no settled expectations in the '689 patent.	3
C.	Review is necessary to correct material errors.....	6
1.	Meridian failed to disclose references cited against the counterpart European patent over a year before the issuance of the '689 patent and highly material to the patentability of the claims of the '689 patent.	6
2.	The Examiner overlooked key disclosures of Duvigneau that were disclosed in an alternative embodiment.....	8
D.	The <i>Fintiv</i> factors favor institution.	9
1.	Factor 1 favors institution because the parties <i>jointly</i> requested a stay, which the court <i>granted</i>	9
2.	Factor 2 favors institution because there is no trial date.	10
3.	Factor 3 favors institution because there will be little invested in CDCA by the DI deadline.	10
4.	Factor 4 favors institution because ToughBuilt's challenges between fora do not overlap and Toughbuilt has made a <i>Sotera</i> stipulation.	10
5.	Factor 5 favors institution because it would be efficient to review a patent involved in litigation between the parties.	11
6.	Factor 6 favors institution because the merits are strong.	11
E.	Meridian's other arguments for discretionary denial are frivolous.....	11
1.	The Petition complies with the statutory requirement to identify with particularity all evidence relied upon in the challenges.....	11

2.	The Petition clearly demonstrates that all claims of the '689 patent are unpatentable.	12
3.	The Petition properly specifies where each element of the claim is found in the prior art and does not rely on expert testimony to fill any “gap.”	15
4.	All grounds presented in the Petition meet both the standard for institution and the higher standard to show the claims are unpatentable after trial.	16
III.	CONCLUSION.....	17

PETITIONER’S UPDATED EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,192,689 B2 to Cai, issued December 7, 2021 (“the ’689 patent”)
1002	File History of U.S. Patent No. 11,192,689 (“Prosecution History”)
1003	Declaration of Dr. J. Michael McCarthy in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 11,192,689
1004	<i>Curriculum Vitae</i> of Dr. J. Michael McCarthy
1005	EP 3492226 A1 to Brocket (“Brocket”)
1006	U.S. Publication No. 2007/0215015 to Heinrichs et al. (“Heinrichs”)
1007	U.S. Publication No. 2007/0012694 to Duvigneau (“Duvigneau”)
1008	U.S. Publication No. 2015/0151661 to Morel et al. (“Morel”)
1009	U.S. Patent No. 6,238,031 B1 to Weng, issued May 29, 2001 (“Weng”)
1010	U.S. Publication No. 2019/0002004 to Brunner et al. (“Brunner”)
1011	U.S. Patent No. 4,576,307 to Frydenberg (“Frydenberg”)
1012	U.S. Patent No. 4974740 to Niles et al. (“Niles”)
1013	Plaintiff Meridian Int’l Co. Ltd.’s Infringement Contentions
1014	EP Search report EP20170368.3 (Oct. 30, 2020)
1015	Meridian EP Amendment and Response in EP20170368.3 (Oct. 5, 2021)
1016	U.S. Publication No. 2015/0274362 to Christopher et al. (“Christopher”)

Exhibit No.	Description
1017	U.S. Publication No. 5,461,731 to Shida (“Shida”)
1018	U.S. Publication No. 2020/0298392 to Baruch et al. (“Baruch”)
1019	U.S. Publication No. 2003/0094392 to Meier et al. (“Meier”)
1020	Chinese Utility Model No. 206841966 U to Wang (“Wang”)
1021	U.S. Publication No. 2008/0000899 to Baker et al. (“Baker”)
1022	U.S. Patent No. 5,934,466 to Loeffler (“Loeffler”)
1023	U.S. Publication No. 2019/0291922 to Gonitiner et al., (“Gonitiner922”)
1024	U.S. Patent No. 9,725,209 B1 to Ben-Gigi (“Ben-Gigi”)
1025	U.S. Publication No. 2019/0315515 to Gonitiner et al. (“Gonitiner515”)
1026	U.S. Patent No. 9,962,826 to Surridge (“Surridge”)
1027	U.S. Publication No. 2008/0121547 to Dur et al. (“Dur”)
1028	U.S. Patent No. 6,592,000 to Owens et al. (“Owens”)
1029	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.)
1030	Defendant’s Notice of <i>Inter Partes</i> 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
1031	<i>Intentionally Left Blank</i>
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).

Exhibit No.	Description
1033	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)
1034	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)

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 '689 patent, which has only been in force for about four 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. EX1034, 1 (¶1); EX2007, ¶3. On June 5, 2024, Meridian sent ToughBuilt a cease-and-desist letter alleging that ToughBuilt's StackTech products infringe U.S. Patent No. 11,986,946 and threatening to seek a preliminary injunction if ToughBuilt did not stop selling these products. EX2007, ¶11; EX1033, 5. Meridian's letter did not mention the '689

patent. *See* EX2007, ¶11; EX1033, 5; EX1034, ¶63 (alleging that Meridian’s Complaint provided notice of the ’689 patent); EX1013, 8.

On August 21, 2024, Meridian sued ToughBuilt in the Central District of California (“CDCA litigation”), alleging infringement of both ’946 and ’689 patents. EX1034. As threatened, Meridian moved (albeit unsuccessfully) for a preliminary injunction. EX1033. 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. EX2007. 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.*” EX2007, ¶13 (emphasis added). Meridian also took aim at ToughBuilt’s financial challenges as an SME to try to accomplish its draconian goal. EX1033, 4.

ToughBuilt thus turned to the PTAB to defend itself against Meridian’s aggression, petitioning for review of both patents in August 2025. *See* IPR2025-01461. 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, Meridian knew of but failed to disclose material prior art that forced Meridian to amend identical claims in a European counterpart.¹ Pet., 1, 5-6; Section II.C.1. 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 ’689 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,

¹ Despite ToughBuilt raising this issue in its Petition, Meridian makes no attempt to defend its failure to disclose this prior art. The Director should issue an order requiring Meridian to explain this failure and why review is not warranted.

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 '689 patent issued in December 2021 and thus has only been in force for just over four 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 '689 patent, which strengthens the case for review.

Mr. Kriz 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." EX2007, ¶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. And, despite alleging that the '689 patent "commercialized in early 2022" (i.e., less than four years ago), the only evidence Meridian proffers appears to be a printout of a webpage that in

no way shows that any Meridian product practices the claims of the '689 patent.

DD Br., 9; EX2006.

Nor has Meridian shown it has “*an extraordinary amount* of investment, time, and resources dedicated to research [and] development ... [that] correlates to settled expectations.” *See Amgen Inc. v. Bristol Myers Squibb Co.*, IPR2025-00603, Paper 8 at 2 (PTAB July 24, 2025) (emphasis added). Rather, Meridian merely asserts it engaged in activities associated with general commercialization of products (e.g., identifying a marketplace need and devising a solution)—without tying those activities or products to the patent at issue here. *Contra* DD. Br., 10 (citing EX2007, ¶13). Such activity does not give rise to settled expectations.

Meridian also makes baseless allegations that ToughBuilt should have known about the '689 patent. DD Br., 10-11. But the mere fact that ToughBuilt sold modular systems to “Company B” does not remotely constitute proof of knowledge of the '689 patent, particularly because, as shown by the Petition, such modular storage systems were well-known. And Meridian does not (and cannot) allege that it provided notice of the '689 patent to ToughBuilt before it filed suit. In fact, the district court complaint specifically states that the complaint itself “constitutes actual notice” of the '689 patent. EX1034, 20.

Meridian’s citations to two cases that “actual notice” is not required to support settled expectations are inapposite. Both cases held that actual notice was

not required to support settled expectations *when the patent was in force for more than six years*—circumstances that are inapplicable here because the '689 patent issued only four years ago. *See Dabico Airport Sols. Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 2 (PTAB June 18, 2025) (finding settled expectations because patent was in force for almost eight years); *Belden Inc. v. Commscope, Inc.*, IPR2025-00833, Paper 13 at 2 (PTAB Sept. 12, 2025) (finding settled expectations because patent was in force for 9 years).

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

C. Review is necessary to correct material errors.

Two material errors demonstrate that review is appropriate. The first—which is Meridian's fault, not the Office's—stems from Meridian's failure to satisfy its duty of disclosure during prosecution. The second is that the examiner plainly overlooked alternative embodiments of Duvigneau, an anticipatory reference.

1. Meridian failed to disclose references cited against the counterpart European patent over a year before the issuance of the '689 patent and highly material to the patentability of the claims of the '689 patent.

In the related European Application (Application No. 20170368.3, claiming priority to the 16/846,878 application that issued as the '689 patent), Meridian made significant amendments to the claims to overcome art used by the European Examiner. *See* EX1014; EX1015, 26-29. Despite its duty of disclosure, Meridian

failed to disclose the search report or references to the USPTO. 37 C.F.R. § 1.56.

In the European search report—dated over one year before the issue date of the '689 patent—the EP Examiner found the application did not meet the requirements for patentability and cited relevant references, including reference D2 (EP3492226 to Brocket). EX1014, 5. The EP Examiner found Brocket was “the prior art closest to the subject-matter of the present claim” and mapped Brocket onto EP claim 1—a claim *identical* to issued claim 1 of the '689 patent. *See* EX1014, 6. Although the Office’s rules specifically ask applicants to carefully examine “[p]rior art cited in search reports of a foreign patent office in a counterpart application,” 37 C.F.R. § 1.56(a), Meridian withheld the search report and cited references from the USPTO. This failure to comply with its duty of candor became even more egregious when Meridian made significant amendments to the EP claims two months before the issuance of the '689 patent and still did not disclose the existence of the EP search report or references to the USPTO. *See* EX1015, 26-29. And, tellingly, even though the Petition points out the omission, Pet., 1, 5-6, Meridian says *nothing* in its Discretionary Denial brief about its clear failure to comply with its duty of candor and good faith.

This lack of candor on the part of Meridian resulted in material error in the issuance of the '689 patent. The Petition presents grounds (Grounds 2A and 2B) based on the Brocket reference used in the EP application to reject claims identical

to the '689 patent. The Director should consider the Petition on the merits and institute review of this IPR for the Office to correct the error caused by Meridian's abuse of the patent process.

2. The Examiner overlooked key disclosures of Duvigneau that were disclosed in an alternative embodiment.

Separately, the Office made a material error in issuing the '689 patent because the Examiner overlooked key teachings of Duvigneau—the primary reference used in Grounds 1A-1H of the Petition. Duvigneau alone anticipates or renders obvious both independent claims and many dependent claim limitations. *See* Pet., 24-46.

The Examiner appears to have been unduly focused on finding a single prior art reference that anticipates all elements of claim 1, including the claimed sliding mechanism for holding the storage containers together, even though the choice of latching mechanism is not novel or patentable. *See* EX1002, 115-121 (rejecting the claims only under § 112 and a single § 102 ground); EX1014 (European Examiner noting there is no particular technical effect derived from the difference in latching mechanism). The Examiner located Duvigneau but apparently failed to appreciate that it was exactly the anticipatory reference she was looking for; the Examiner did not use it in a rejection or even cite it in a Notice of References Cited. *See generally* EX1002; *also* EX1002, 173 (search string S16 using Duvigneau in a search query). Importantly, although Duvigneau discloses a pivoting latch in its

first embodiment, its later embodiment shown in Figure 6 and described in paragraph 57, discloses a sliding latch 246 for “detachably articulating” two storage containers.

Had the Examiner appreciated the teachings of Duvigneau’s alternative embodiment, it would have been apparent the ’689 patent should not have been allowed. 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).

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 (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. And ToughBuilt no longer maintains its contention in the CDCA litigation that the claims are indefinite. *See* EX2005,

22-23. 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 ’689 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., 9-20. All are unfounded.

1. 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., 24-92. Meridian advances meritless allegation that the Petition fails to comply with its statutory obligation but fails to identify even one single example to support its allegations. DD Br., 13. The assertion is patently false and falls far short of a reason for discretionary denial.

2. The Petition clearly demonstrates that all claims of the '689 patent are unpatentable.

Meridian falsely asserts that the prior art used in the Petition does not invalidate the claims of the '689 patent. DD Br., 14-17. Notably, all of the examples Meridian provides are dependent claims; it does not identify a *single deficiency* in the challenges to independent claims 1 and 14. *See* DD. Br. 14-17. Indeed, Meridian asserted claims 1-6 in the CDCA litigation but does not even attempt to defend claims 1-4 here. Regardless, each of Meridian's examples are easily dispensed with because the Petition provides clear support for each challenge showing why the claims of the '689 patent are unpatentable.

The first purported example Meridian provides is the Petition's challenge to claim 5 over Duvigneau and Niles. Meridian mischaracterizes the challenge as based on Niles alone and alleges the engaging grooves cannot be taught by Niles because it is directed to a closure latch for a shipping case and discloses a U-shaped slide. DD Br., 14-15. In fact, the Petition relies on *the combination* of Duvigneau and Niles to teach the claimed engaging grooves for holding Duvigneau's slider in the unlocked and locked positions and provides detailed

support and reason a POSA would have combined the references in the proposed manner. Pet., 46-50. Meridian's attempt to demonstrate a deficiency in the Petition's obviousness challenge fails because it attacks a reference individually, when the challenge is based on a combination of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Next, Meridian attacks the challenge to claim 5 based on Duvigneau and Morel. DD. Br., 15. Yet again, Meridian incorrectly asserts the challenge is based on Morel alone (it is not). The Petition provides a detailed explanation of how *the combination* of Duvigneau and Morel teach claim 5. Pet., 53-57. Indeed, Meridian acknowledges Morel discloses the use of locking notches to hold a sliding element in place. DD. Br., 15.

Meridian's third purported example concerns claims 9-11. Meridian alleges that the Petition does not explain how Frydenberg constrains lateral movement of the slider with respect to the support arm. DD Br., 15-16. Not true. The Petition explains that a POSA would recognize components are needed to prevent the slider from being laterally displaced from the support arm and acknowledges that Duvigneau does not disclose the mechanism used to restrict such lateral movement. Pet., 65-66. The Petition provides a detailed explanation of Frydenberg's disclosure of a rail and slider to constrain lateral movement of the

slider, explains the proposed modification to Duvigneau's support arm and slider to add Frydenberg's arrangement, and provides detailed reasoning for making the modification. Pet., 66-69. Thus, contrary to Meridian's allegation, the Petition demonstrates that Duvigneau and Frydenberg teach claims 9-11.

Meridian's next argument plainly misrepresents the Petition. To support its allegation that Duvigneau's Figure 5 does not have a slider, as required by claim 4 (from which claims 12-13 and 19-20 depend), Meridian depicts an annotated version of Figure 5, circling a component of Figure 5 that is *not* relied on for the sliding mechanism. DD. Br., 16. The Petition clearly points to the specific disclosure of Duvigneau that its *cover 180* has a *sliding latch 246* for "detachably articulating the carrying bag 230 over the base cabinet 152." Pet., 28-29; EX1007, FIGS. 4-6, ¶57. Although not labeled, the sliding mechanism is depicted on cover 180 in Figure 5 and more specifically labeled in Figure 6. Critically, Meridian deliberately attempts to obscure the fact that Duvigneau's FIGS 4A-6 all disclose different views of *the same embodiment*. EX1007, ¶50. Once Meridian's grossly misleading allegation is set aside, there is no deficiency in the challenges to the claims.

Last, Meridian makes a conclusory allegation that Brunner "suffers from the same problem" and does not teach the claims 12-13 and 19-20. But again, Meridian attacks a reference individually, rather than the combination explicitly set

forth in the Petition, with detailed reasoning, showing that Duvigneau-Brunner renders obvious claims 12-13 and 19-20. Pet., 70-75.

3. The Petition properly specifies where each element of the claim is found in the prior art and does not rely on expert testimony to fill any “gap.”

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., 24-92. The Petition further properly provides supporting testimony from Dr. McCarthy to provide the perspective of a POSA. Tellingly, although Meridian complains that the Petition fails to cite directly to prior art that invalidates the ’689 patent and improperly relies on expert testimony (DD. Br., 18-19), Meridian does not identify even *one example* of a limitation that relies on expert testimony to fill an alleged gap in the cited art. It cannot—because there is no such gap. Indeed, the one paragraph of the expert declaration that Meridian cites—by Meridian’s own admission—cites specifically to Duvigneau. DD. Br., 18; *see* Pet. 26 (citing EX1007, ¶57). And Meridian neglects to mention that this paragraph is an introductory paragraph, which is followed immediately by paragraphs that provide more detailed explanation of how Duvigneau discloses the limitation in question (1B), with explicit cites to multiple figures and quotes from multiple paragraphs of Duvigneau. *See* Pet., 26-29.

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 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 "stackable storage containers, sliding latch mechanisms to secure stacked storage containers to one another, components that regulate sliding latch motion, and coplanar portions," EX1003, ¶¶34, were all well known before the alleged priority date of the '689 patent. *See* EX1003, ¶¶34-106.

4. All grounds presented in the Petition meet both the standard for institution and the higher standard to show the claims are unpatentable after trial.

Meridian's allegation that the Petition fails to raise a sufficient case against the patentability of the claims, DD Br., 17-18, is premised on its faulty assertions addressed above. In point of fact, the Petition not only meets the "reasonable likelihood" standard to institute for all grounds and claims but also meets the higher "preponderance of evidence" standard" to show all claims are unpatentable. Accordingly, there is no basis to deny this Petition for presenting a deficient number of challenges.

III. CONCLUSION

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

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Richard M. Bemben/

Richard M. Bemben
Registration No. 68,658
Lead Attorney for Petitioner

Date: December 9, 2025

1101 K Street, NW
10th Floor
Washington, DC 20005
(202) 371-2600

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 1033-1034 were served in their entireties upon the Patent
Owner on December 9, 2025, via electronic mail:

Anna C. Halsey (Lead Counsel)
Ann G. Fort (Back-up Counsel)
Lindsay M. Kriz (Back-up Counsel)
Jeremy D. Spier (Back-up Counsel)
EVERSHEDS SUTHERLAND (US) LLP
AnnaHalsey@eversheds-sutherland.us
AnnFort@eversheds-sutherland.us
LindsayKriz@eversheds-sutherland.us
JeremySpier@eversheds-sutherland.us

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Richard M. Bemben/

Richard M. Bemben
Registration No. 68,658
Lead Attorney for Petitioner

Date: December 9, 2025

1101 K Street, NW
10th Floor
Washington, DC 20005
(202) 371-2600