

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
CONTINGENT MOTION TO AMEND**

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TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	LEGAL STANDARDS	2
III.	MERIDIAN’S MTA DOES NOT COMPLY WITH THE BOARD’S PROCEDURAL REQUIREMENTS.....	3
A.	Meridian fails to show the amendments have support in the original disclosure.	3
1.	Meridian does not cite to support in the original disclosure for the claims as a whole.	4
2.	Claims 22, 24, and 34 lack support and introduce new matter.....	5
3.	Proposed claim 38 improperly enlarges claim scope.	6
4.	Proposed substitute claims 21, 22, and 24 do not respond to a ground of unpatentability.	7
IV.	CLAIMS 22, 24, & 34 LACK WRITTEN DESCRIPTION SUPPORT.....	8
V.	THE PROPOSED CLAIMS ARE UNPATENTABLE UNDER § 103.	8
A.	Claim 21 was obvious over Duvigneau and Baker.	9
1.	Unamended Claim Elements.....	9
2.	Newly Added Slot Limitation.....	9
B.	Claim 34 was obvious over Duvigneau, Frydenberg, and Dane.....	14
1.	Unamended Claim Elements.....	14
2.	Newly Added Slider and Locking Groove Limitations.....	14
C.	Claim 34 was obvious over Duvigneau, Frydenberg, and Peniche.	17
D.	Proposed claims 22-24 were obvious over Duvigneau-Baker- Dane and Duvigneau-Baker-Peniche.	20
1.	Claim 22	20
2.	Claim 23	21
3.	Claim 24.....	21

E.	Claims 25-33 are obvious over the same combinations identified in the Petition in view of Baker-Dane and Baker-Peniche.	22
F.	Claim 35 was obvious over Duvigneau-Frydenberg-Dane-Baker and Duvigneau-Frydenberg-Peniche-Baker.....	22
G.	Proposed Substitute Claims 36-40	23
VI.	MERIDIAN HAS NOT PRODUCED POTENTIAL PRIOR ART.	23
VII.	CONCLUSION.....	25

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)
1035	Declaration of Dr. J. Michael McCarthy in Support of Petitioner's Opposition to Patent Owner's Contingent Motion to Amend
1036	U.S. Patent Publication No. 2011/0000916 to Dane et al. ("Dane")
1037	U.S. Patent Publication No. 2016/0236592 to Peniche et al. ("Peniche")
1038	Deposition Transcript of Dr. Glenn Vallee (July 14, 2026)
1039	U.S. Patent Publication No. 2006/0273084 to Baker et al. ("Baker084")
1040	U.S. Patent Publication No. 2017/0250501 A1 to Endo et al. ("Endo")
1041	U.S. Patent No. 9,097,038 B1 to Cohen ("Cohen")
1042	Meridian Response Letter to Toughbuilt Request (July 21, 2026)
1043	Declaration of William H. Milliken in Support of Admission <i>Pro Hac Vice</i>

I. INTRODUCTION

The Board should deny Meridian’s motion to amend (the “MTA” or “Motion”). Petitioner ToughBuilt, a small U.S. company, turned to the PTAB to defend itself from Meridian—a larger Chinese rival that is trying to drive ToughBuilt out of business. The Petition establishes that all claims of the ’689 patent are anticipated or were obvious. Notably, two of the grounds (Grounds 2A and 2B) are based on a reference (Brocket) that Meridian did not disclose to the USPTO even though it was cited and applied in an EPO rejection in the related European patent application and Meridian made substantial amendments to overcome those rejections. *See* Paper 11 at 2.

Recognizing deficiencies in the ’689 claims, Meridian now seeks to amend them. But the proposed amendments add only conventional latching components—a support arm that extends across a width of a slot and a slider with two insertion portions—that, like the claim limitations of the ’689 patent, were well known long before the issuance of the ’689 patent.

Meridian’s proposed amendments cannot salvage the ’689 patent for multiple reasons. *First*, Meridian fails to meet its burden to show it complies with the Board’s procedural requirements because: (1) the Motion fails to meet the procedural requirement to identify written description support *in the originally filed disclosure* of the subject matter and to set forth written description support for

each proposed substitute claim *as a whole*; (2) the amendments introduces new subject matter; (3) certain amendments enlarge claim scope; and (4) the amendments fail to respond to a ground of unpatentability. *Second*, the proposed claims are unpatentable under § 112(a) for lack of written description support. *Third*, the proposed claims are unpatentable as obvious over the grounds in the Petition in view of a single additional reference for each substantive amendment.

Moreover, Meridian’s technical expert provided testimony on a potential prior art stackable transportation system for tool storage containers that appears to be material to the patentability of the substitute claims. ToughBuilt requested information and documentation regarding the system, yet Meridian has failed to provide any substantive information. Consistent with original prosecution, Meridian appears to have failed to provide all relevant prior art.

II. LEGAL STANDARDS

A patent owner may file one original MTA to cancel challenged claims or propose a reasonable number of substitute claims. 35 U.S.C. § 316(d)(1); 37 C.F.R. § 42.121(a). An MTA “shall comply with the rules pertaining to motions to amend (37 C.F.R. § 42.121) and the practices and procedures described in *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential).” Paper 17, 5. Patent Owner “bears the burden of persuasion to show, by a preponderance of the evidence, that the motion to amend complies with

the requirements of paragraphs (1) and (3) of 35 U.S.C. 316(d), as well as paragraphs (a)(2) and (3) and (b)(1) and [(b)](2) of this section.” 37 C.F.R. § 42.121(d)(1); *see also Lectrosonics*, 4-8 (enumerating requirements for an MTA). These requirements include identifying “support in the original disclosure ... for each proposed substitute claim” and “support in an earlier-filed disclosure for each claim for which the benefit of the filing date of the earlier-filed disclosure is sought.” 37 C.F.R. § 42.121(b)(1)-(2). Any MTA may be denied if the amendment does not respond to a ground of unpatentability or the amendment seeks to enlarge the scope of the patent or introduces new subject matter. 37 C.F.R. § 42.121(a)(2)(i)-(ii).

III. MERIDIAN’S MTA DOES NOT COMPLY WITH THE BOARD’S PROCEDURAL REQUIREMENTS.

Meridian’s MTA should be denied because Meridian has not meet its “burden of persuasion” to show that the MTA complies with statutory and regulatory requirements. The MTA does not identify support in *the original disclosure of the patent* for each proposed substitute claim, and the amendments improperly introduce new subject matter and enlarge the scope of the claims.

A. Meridian fails to show the amendments have support in the original disclosure.

Meridian fails to carry its burden to show the proposed amendments have support in the original disclosure as required by Rule 42.121(b)(1).

1. Meridian does not cite to support in the original disclosure for the claims as a whole.

The MTA does not meet the threshold requirement to identify support in the original disclosure for each proposed substitute claim. Meridian is required to provide citation “to the original disclosure of the application, as filed, rather than to the patent as issued.” *Lectrosonics*, 8. Further, “the motion must set forth written description support for each proposed substitute claim as a whole, and not just the features added by the amendment,” and this applies “equally to independent claims and dependent claims, even if the only amendment to a dependent claim is in the identification of the claim from which it depends.” *Lectrosonics*, 8.

Meridian’s MTA violates every one of these clear requirements. First, it cites only to the issued patent (Exhibit 1001) for purported written description support, and does not identify support in the original disclosure of the application as filed. Meridian’s citations to the related CN application, MTA, 6-8, do not cure the defect because those citations are provided only in an attempt to satisfy the separate priority requirement of Rule 42.121(b)(2) and cannot substitute for the required showing of support in the original disclosure under Rule 42.121(b)(1). Second, the MTA provides citations only for the newly added limitations and fails to identify support for the proposed substitute claims as a whole. *See* MTA, 6-8. Finally, the MTA does not identify any support for the substitute dependent claims. *See id.* Meridian’s failure to comply with these threshold procedural requirements

is reason alone to deny the Motion.

2. Claims 22, 24, and 34 lack support and introduce new matter.

Meridian's alleged support for proposed claims 22, 24, and 34 falls far short and demonstrates that the amendments introduce new subject matter.

Proposed claim 22 recites that the slider comprises "two insertion portions configured to engage with the locking groove." Meridian's cited disclosure does not provide written description support for two insertion portions configured to engage with a single locking groove, which is within the scope of proposed claim 22 because proposed claim 21 recites "at least one locking groove." *Contra* MTA, 7 (citing EX1001, 3:26-30, 4:3-14). But the alleged support describes only that "there are two spaced locking grooves ... to each receive an insertion portion." EX1001, 3:26-30, FIG. 7 (illustrating two locking grooves). Thus, the '689 patent describes two insertion portions engaging two separate locking grooves, not two insertion portions engaging a single "locking groove." Dr. Vallee confirmed each insertion point "would go into respective locking grooves." EX1038, 186:6-186:16. Proposed claim 22 is not supported and thus adds new matter. EX1035, ¶7.

Proposed claim 24 also introduces new matter. It recites "the slot is formed within the side surface of the second storage container." Meridian cites only to column 3, lines 26-30 of the '689 patent for alleged written description support. MTA, 7. But this passage merely states that the locking grooves are "at the lower

end of the outer side of the first storage container.” It does not disclose, or even discuss, a slot “formed within the side surface” of the second storage container. EX1035, ¶8.

Proposed claim 34 suffers from the same defect as proposed claim 22. It recites “the slider having two insertion portions receivable within two reciprocal slots of the locking groove.” Again, the ’689 patent describes only two insertion portions of a slider that are received within two separate locking grooves. EX1001, 3:26-30, FIG. 7. Dr. Vallee agrees. EX1038, 186:6-16. The newly added configuration is found nowhere in the ’689 patent, let alone in the passages cited by Meridian. EX1035, ¶9.

Accordingly, the amendments to proposed claims 22, 24, and 34 introduce new matter and should be denied under 37 C.F.R. § 42.121(a)(2)(i).

3. Proposed claim 38 improperly enlarges claim scope.

The proposed amendment to claim 38 (replacement for claim 18) should be denied because it impermissibly enlarges the scope of claim 18. Meridian seeks to amend claim 18 by deleting the limitation that the “support arm and the slider further comprise a cooperating guide to constrain lateral movement of the slider with respect to the support arm.”

Meridian wrongly asserts that the removed limitation is “otherwise incorporated” in the claim from which claim 38 depends. It is not. The limitation

added to proposed claim 34, from which claim 38 depends, does not require that *the support arm* comprises a cooperating guide. Instead, it recites at least one guiding rib “*of the second storage container.*” Thus, the amendment broadens the claim by removing the requirement that the support arm has a cooperating guide.

The amendment further broadens claim 18 by changing the claimed relationship between the guide structure and the slider. Original claim 18 requires a guide that constrains lateral movement “*with respect to the support arm.*” In contrast, proposed claim 38 recites constraining lateral movement *with respect to the second storage container.*

“[A] proposed substitute claim may not remove a feature of the claim in a manner that broadens the scope of the claims” *Lectrosonics*, 6. That is precisely what Meridian has done here by removing structural features of the guiding rib from original claim 18. Thus, this amendment should be denied for failure to comply with 37 C.F.R. § 42.121(a)(2)(ii).

4. Proposed substitute claims 21, 22, and 24 do not respond to a ground of unpatentability.

The proposed amendments to claims 21, 22, and 24 do not respond to a ground of unpatentability and therefore should be denied. See 37 C.F.R. § 42.121(a)(2)(i). Specifically, these substitute claims add amendments directed solely to the second storage container, yet do not expressly recite the second storage container as a required claim element. “[O]ptional elements do not narrow

the claim because they can always be omitted.” *In re Johnston*, 435 F.3d 1381, 1384 (Fed. Cir. 2006). Should the Board determine that the newly added second storage container limitations are not entitled to patentable weight, the amendments do not narrow the claims and, therefore, do not respond to a ground of unpatentability. Accordingly, the amendments should be denied.

IV. CLAIMS 22, 24, & 34 LACK WRITTEN DESCRIPTION SUPPORT.

For the reasons stated in Section III.A.2 regarding new matter, claims 22, 24, and 34 fail to reasonably convey to a POSA that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Again, the ’689 patent describes two insertion portions of a slider received within two separate locking grooves, not two insertion portions configure to engage a single locking groove (claim 22) or a locking groove with two reciprocal slots (claim 34). The specification does not reasonably convey possession of the newly claims subject matter. EX1035, ¶¶6-10.

V. THE PROPOSED CLAIMS ARE UNPATENTABLE UNDER § 103.

Meridian’s proposed substitute claims boil down to the addition of just two limitations to the original claims: (1) a limitation that the support arm extends across the slot “*perpendicular to the direction of travel of the slider*” (proposed independent claims 21 and dependent claim 35); and (2) a limitation that the slider comprises “*two insertion portions receivable within two reciprocal slots of the*

locking groove” (proposed independent claim 34, and similar limitation recited in proposed claim 22). Both features were well known and obvious modifications to the Duvigneau grounds set forth in the Petition. EX1035, ¶¶11-34.

A. Claim 21 was obvious over Duvigneau and Baker.

The Duvigneau-Baker combination renders obvious proposed independent claim 21 (substitute for claim 1). EX1035, ¶35. Baker (Exhibit 1021) was published on January 3, 2008, and is prior art at least under 35 U.S.C. § 102(a)(1). Baker describes a plurality of stackable storage containers (tray for receiving articles for storage) and latches that secure the containers together, which are analogous art in the same field and reasonably pertinent to the problems of the ’689 patent. EX1021, Abstract; EX1035, ¶36.

1. Unamended Claim Elements

The Petition demonstrates that Duvigneau discloses or renders obvious the unamended limitations of proposed claim 21. Pet., 24-31, 38-46; EX1035, ¶37.

2. Newly Added Slot Limitation

Proposed independent claim 21 amends claim 1 to add the limitation “*wherein the second storage container comprises a slot with a support arm extending across a width of the slot perpendicular to the direction of travel of the slider, wherein the sliding mechanism is engaged with the support arm.*”

Duvigneau combined with Baker renders obvious this limitation. EX1035, ¶38.

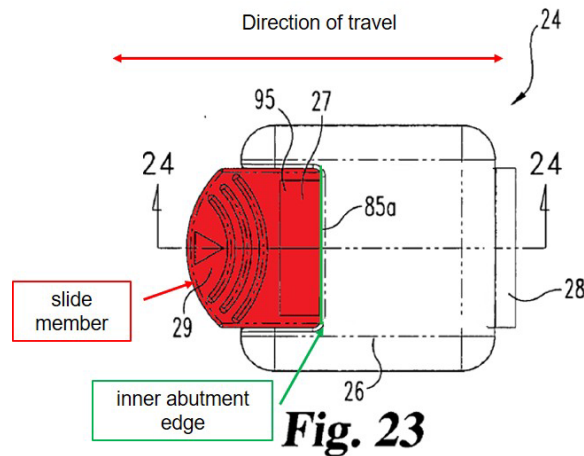
First, the Petition demonstrates Duvigneau discloses or renders obvious “*the*

second storage container comprises a slot with a support arm extending across ... the slot ... wherein the sliding mechanism is engaged with the support arm.” Pet., 24-31, 43-46. This limitation is substantially similar to elements set forth in original claim 4 and is disclosed or obvious for the same reasons. Duvigneau discloses its slider (a component of the sliding mechanism) is engaged with the support arm. Pet., 44-45; EX1035, ¶39.

Second, Duvigneau-Baker renders obvious a support arm “*extending across a width of the slot perpendicular to the direction of travel of the slider.*” Duvigneau discloses that latch 246 “arrests” in depression 240 to attach carrying bag 230 over base cabinet 250. EX1007, ¶57. But Duvigneau does not disclose a mechanism to prevent a user from overextending its sliding mechanism into the slot when carrying bag 230 is not fitted over base cabinet 250. A POSA would have recognized this problem and been motivated to find a solution. EX1035, ¶40.

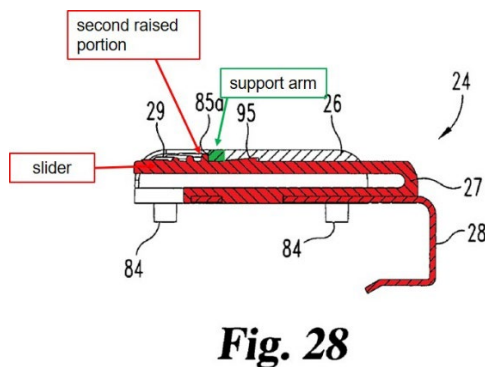
Baker discloses a solution. Baker describes “slide latch 24 [that] includes a body 26” attached to a lid 21 and “slide member 27 that moves through the body 26.” EX1021, ¶42. A mating tray 20 includes corresponding openings that are “arranged to receive the lip 28 of the mating slide latch 24” to securely attach lid 21 to tray 20 to create a containment case. EX1021, ¶42. The slide body 26 includes a “recessed opening 85” (slot) with “a generally straight, inner abutment edge 85a” that extends across a width of opening 85 perpendicular to the direction

of travel of slide member 27. EX1021, ¶58, FIG. 23; EX1035, ¶41.



EX1021, FIG. 23 (annotated).

Baker further describes that a “higher end of raised portion 95 is in abutment against inner edge 85a” when slide member 27 is in its retracted position with respect to body 26. EX1021, ¶¶60, 62. Slide member 27 also has a second raised portion that contacts abutment edge 85a when slide member 27 is in its extended position with respect to body 26, as illustrated in annotated Figure 28 below.

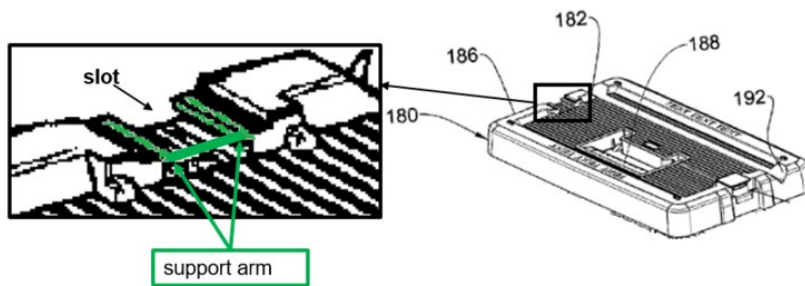


EX1021, FIG. 28 (annotated).

Accordingly, the engagement of the second raised portion with abutment edge 85a (support arm) provides greater security of slide member 27 in its extended position. For example, contacting the inner abutment edge 85a as shown

in annotated Figure 28 prevents additional extension (complete removal) of slide member 28 past its extended position with respect to body 26. EX1035, ¶¶42-43.

A POSA would have recognized Baker suggests a solution to Duvigneau's lack of disclosure of a mechanism that would prevent a user from overextending the sliding latch into the slot when carrying bag 230 is detached, which could otherwise result in inadvertent removal of the latch in the direction of the slot. A POSA would have found it obvious to modify Duvigneau to include a similar arrangement, as taught by Baker by extending Duvigneau's support arm(s) across a width of the slot to create an abutment edge or backstop to engage with the slider and prevent overextension, as shown in annotated Figure 5 below. EX1035, ¶¶44-45.



EX1007, FIG. 5
(cropped and
annotated).

A POSA would have found it obvious to also incorporate a raised portion on the upper surface of the slider to engage with the support arm (as taught by Baker). Alternatively, a POSA would have also understood the raised portion could be placed on a lower surface so that the slider slides over the extended portion of the support arm (rather than underneath) until the raised portion abuts the support arm.

Placement of the raised portion on a lower or upper surface (with corresponding placement of the extended portion of the support arm such that the slider slides over or under the support arm until the raised portion abuts the support arm) would be an obvious design choice because it would not result in a difference in function of the slider to connect two storage containers or give unexpected results. EX1035, ¶46; *see Ex parte Spangler*, Appeal 2018-003800 at 6 (PTAB Feb. 20, 2019) (informative).

A POSA would have been able to readily implement the modifications and would have been motivated to make the modifications to prevent a user from overextending the slider (and potentially inadvertently removing it) into the slot when carrying bag 230 is not attached. Indeed, a POSA would have understood that the concept of sliding mechanisms engaged with a support arm extending across a width of a slot to prevent over-extension of sliding latches was well known. A POSA would have been further motivated to make the proposed modifications, and had a reasonable expectation of success, because the modifications would have been merely combining known elements (extending the support arm(s) across the width of the slot to provide a backstop and adding a raised portion to the upper (or lower) surface of the slider to engage with the support arm) according to known methods to yield predictable results (a mechanism that prevents a user from inadvertently removing the slider by

overextending it into the slot when the carrying bag is not present). EX1035, ¶¶47-50.

Therefore, the Duvigneau-Baker combination renders obvious proposed claim 21. EX1035, ¶51.

B. Claim 34 was obvious over Duvigneau, Frydenberg, and Dane.

The Duvigneau-Frydenberg-Dane combination renders obvious proposed independent claim 34. EX1035, ¶52. Dane (Exhibit 1036) published on January 6, 2011, and is prior art at least under 35 U.S.C. § 102(a)(1). Dane describes a latch mechanism to attach a first storage container portion and a second storage container portion, and is analogous art in the same field and reasonably pertinent to the problems of the '689 patent. EX1036, Abstract; EX1035, ¶53.

1. Unamended Claim Elements

The Petition demonstrates Duvigneau that discloses or renders obvious the unamended limitations of proposed claim 34. Pet., 24-31, 38-46; EX1035, ¶54.

2. Newly Added Slider and Locking Groove Limitations

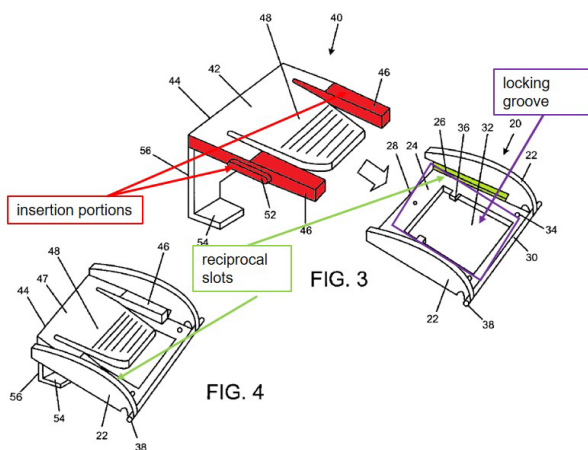
Proposed independent claim 34 amends claim 14 to add two limitations: (i) “*wherein the sliding mechanism comprises a slider configured to move between the engaged and disengaged positions with respect to the locking groove, the slider having two insertion portions receivable within two reciprocal slots of the locking groove*”; and (ii) “*wherein the slider comprises at least one guiding slot positioned on a bottom side of the slider configured to cooperate with at least one guiding rib*”

of the second storage container for constraining lateral movement of the slider with respect to the second storage container.”

First, limitation (ii) is substantially the same as limitations in original claim 10, differing only in that it recites the guiding slot is “*positioned on a bottom side of the slider*” and that the guiding rib is “*of the second storage container,*” rather than the support arm, and constrains lateral movement with respect to the “*second storage container,*” again, rather than the support arm. Duvigneau-Frydenberg teaches this limitation for the reasons set forth in the Petition. Pet., 65-68. As explained, Duvigneau discloses, or renders obvious, a second storage container comprising support arm(s). Pet., 34-37, 43-46. Further, a POSA would have understood that, in the Duvigneau-Frydenberg combination, the guiding slot of the slider would be positioned “*on a bottom side of the slider*” to engage with the guiding rib. Pet., 67-68. Meridian repeats its incorrect allegations from its POR that Duvigneau-Frydenberg does not teach a slot with a guiding rib that constrains lateral movement. MTA, 18-21. Meridian’s argument is unpersuasive for the same reasons as its arguments made for original claims 9-10. *See generally* Pet. Reply. Thus, in the Duvigneau-Frydenberg combination, the “*guiding rib on the support arm*” is “*of the second storage container*” and the constraint of the lateral movement with respect to the support arm also constrains lateral movement “*with respect to the second storage container.*” EX1035, ¶¶55-56.

Second, Duvigneau-Dane teaches limitation (i). As explained in the Petition, Duvigneau teaches “*the sliding mechanism comprises a slider configured to move between the engaged and disengaged positions with respect to the locking groove.*” Pet., 31-34. Although Duvigneau does not disclose its slider has “*two insertion portions receivable within two reciprocal slots of the locking groove,*” such sliders were well known, as evidenced by Dane. EX1035, ¶57.

Dane discloses a latch mechanism 16 for a container 10, which “includes a guide part 20 and a slide part 40.” EX1036, ¶19. Slide part 40 includes a frame 42 with “two slide rail support structures 46 positioned at opposing sides of the frame,” each having “a sliding rail 52 [] positioned to be received” within a reciprocal guiding rail 26. EX1036, ¶22. Thus, as shown in annotated Figures 3 and 4, depicted below, Dane teaches a slider with “*two insertion portions receivable within two reciprocal slots*” of a locking groove (the cavity formed between the two rail support structures 22). EX1036, FIGs. 3, 4; EX1035, ¶58.



EX1036, FIGs. 3, 4 (annotated).

A POSA would have found it obvious and been readily able to modify Duvigneau's slider to have *two insertion portions receivable within two reciprocal slots of the locking groove*, as taught by Dane. A POSA would have understood the choice of using a slider with one or two insertion portions, with corresponding slot(s), to be a mere design choice because it would not result in a difference in function of the slider to connect two storage containers or give unexpected results. *See Ex parte Spangler* at 6. A POSA also would have been motivated to make the modification because it amounts to nothing more than a simple substitution of one known element (a unitary groove-engaging portion of a slider) for another (a pronged groove-engaging portion of a slider) to obtain predictable results (a slider with two insertion portions receivable within two reciprocal slots). Additionally, a POSA would have been further motivated to make the modification because the use of two insertion portions receivable within two reciprocal slots assists with alignment of the slider relative to the locking groove. A POSA would have had a reasonable expectation of success in making the modification because both configurations perform the same latching function of securing components together. EX1035, ¶¶59-61. Therefore, the Duvigneau-Frydenberg-Dane combination renders obvious proposed claim 34. EX1035, ¶62.

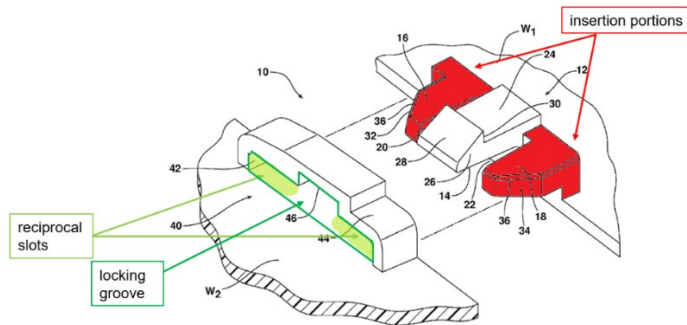
C. Claim 34 was obvious over Duvigneau, Frydenberg, and Peniche.

The Duvigneau-Frydenberg-Peniche combination also renders obvious

proposed independent claim 34. EX1035, ¶63. Peniche (Exhibit 1037) was published on August 18, 2016, and is prior art at least under 35 U.S.C. § 102(a)(1). Peniche describes an attachment device 10 (latch mechanism) to attach two components (workpieces), and is analogous art in the same field and reasonably pertinent to the problems of the '689 patent. EX1036, Abstract; EX1035, ¶64.

The Petition and Section V.B above demonstrate that Duvigneau renders obvious the unamended limitations of proposed claim 34; Duvigneau-Frydenberg teaches limitation (ii) of claim 34; and Duvigneau teaches the sliding mechanism comprises a slider configured to move between engaged/disengaged positions. *See* Pet., 31-37, 43-46; EX1035, ¶65.

Duvigneau-Peniche renders obvious “*two insertion portions receivable within two reciprocal slots of the locking groove.*” EX1035, ¶66. Peniche discloses an attachment device 10 for securing a first workpiece to a second workpiece. EX1037, ¶15. Attachment device “includes an attachment head 12” and “a receiver 40.” EX1037, ¶¶15, 18. Receiver 40 “includes an opening 42 for receiving” attachment head 12, “a first outboard locator tab 16[,] and a second outboard locator tab 18.” EX1037, ¶¶15, 18. As shown in Figure 1 below, tabs 16 and 18 (*insertion portions*) of attachment device 10 (slider) are receivable within two reciprocal slots of opening 42 (*locking groove*). EX1037, FIG. 1.



EX1037, FIG. 1 (annotated).

Again, a POSA would have found it obvious and been readily able to modify Duvigneau's slider to have *two insertion portions receivable within two reciprocal slots of the locking groove* as taught by Peniche. A POSA would have understood the choice of using a slider with one or two insertion portions, with corresponding slot(s), to be a mere design choice because it would not result in a difference in function of the slider to connect two storage containers or give unexpected results. *See Ex parte Spangler* at 6. A POSA also would have been motivated to make the modification because it amounts to nothing more than a simple substitution of one known element (a unitary groove-engaging portion of a slider) for another (a pronged groove-engaging portion of a slider) to obtain predictable results (a slider with two insertion portions receivable within two reciprocal slots). A POSA would have been further motivated to make the modification because using two insertion portions receivable within two reciprocal slots assists with aligning the slider relative to the locking groove. A POSA would have had a reasonable expectation of success in making the modification because both configurations perform the same latching function of securing components together. EX1035, ¶¶67-69.

Therefore, the Duvigneau-Frydenberg-Peniche combination renders obvious proposed claim 34. EX1035, ¶70.

D. Proposed claims 22-24 were obvious over Duvigneau-Baker-Dane and Duvigneau-Baker-Peniche.

The Duvigneau-Baker-Dane and Duvigneau-Baker-Peniche combinations render obvious proposed claims 22-24. EX1035, ¶71.

1. Claim 22

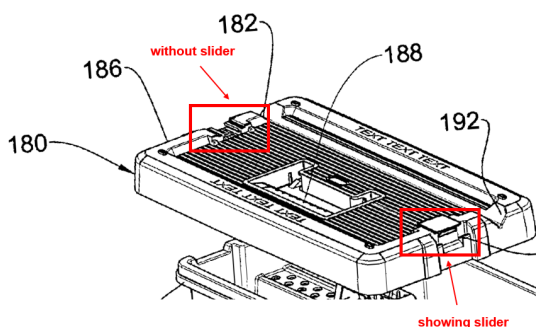
Proposed claim 22 (substitute for claim 2) depends from proposed claim 21 and amends claim 2 to add that the slider comprises “*two insertion portions configured to engage with the locking groove.*” For the reasons described for proposed claim 34 in Section V.B and Section V.C, Duvigneau-Dane and Duvigneau-Peniche render obvious a slider with “*two insertion portions*” that is “*receivable within two reciprocal slots of the locking groove,*” and is, therefore, “*configured to engage with the locking groove.*” A POSA would have found it obvious and been motivated to modify the Duvigneau-Baker combination, with a reasonable expectation of success, for the same reasons discussed for claim 21. Duvigneau teaches the remaining limitations that are present in original claim 2 for the reasons discussed in the Petition. Pet., 31-32. Accordingly, Duvigneau-Baker-Dane and Duvigneau-Baker-Peniche render obvious proposed claim 22. EX1035, ¶72.

2. Claim 23

Proposed claim 23 depends from proposed claim 22 and adds no new features over what was already addressed in the Petition with respect to claim 3. Duvigneau discloses or teaches these limitations for the reasons discussed in the Petition. Pet., 42-43. Accordingly, Duvigneau-Baker-Dane and Duvigneau-Baker-Peniche render obvious proposed claim 23. EX1035, ¶73.

3. Claim 24

Proposed claim 24 depends from proposed claim 23 and amends claim 4 to from “a slot is in the side surface” of the second storage container to the slot “*is formed within*” the side surface. Duvigneau discloses or teaches the limitations of claim 4 for the reasons discussed in the Petition. Pet., 34-38, 43-46. Duvigneau also teaches a slot “*formed within the side surface.*” Pet., 34-37, 43-46. As explained in the Petition, and shown in the Figure below, Duvigneau discloses a slot in (and, as depicted, formed within) a side surface of the container “where there is a break in the upper surface 186 of base cabinet’s cover 180 defining a slot at the cavity where its latch mechanism 146 is located.” Pet., 35; EX1035, ¶74.



EX1007, FIG. 5 (cropped to show cover 180 and annotated).

Meridian's arguments that sliding latch 246 is not present on a second storage container and that its lid is not a part of the second storage container, MTA, 16-17, repeat arguments from its POR that are without merit for the same reasons as its arguments made for original claims 1 and 14. *See generally* Pet. Reply. Accordingly, Duvigneau-Baker-Dane and Duvigneau-Baker-Peniche render obvious proposed claim 24. EX1035, ¶75.

E. Claims 25-33 are obvious over the same combinations identified in the Petition in view of Baker-Dane and Baker-Peniche.

Proposed claims 25-33 depend from claim 24 and add no new features over what was already addressed in the Petition with respect to claims 5-13. These claims would have been obvious over the same combinations identified in the Petition, in view of Baker-Dane or Baker-Peniche. EX1035, ¶¶76-79.

Claims	Obvious over
25-27	Duvigneau-Baker-Dane and Duvigneau-Baker-Paniche, in view of either Niles or Morel. <i>See</i> Pet., 46-60.
28	Duvigneau-Baker-Dane-Morel-Weng and Duvigneau-Baker-Peniche-Morel-Weng. <i>See</i> Pet., 60-65.
29-31	Duvigneau-Baker-Dane-Frydenberg and Duvigneau-Baker-Peniche-Frydenberg. <i>See</i> Pet., 65-69.
32-33	Duvigneau-Baker-Dane-Brunner and Duvigneau-Baker-Peniche-Brunner. <i>See</i> Pet., 70-75.

F. Claim 35 was obvious over Duvigneau-Frydenberg-Dane-Baker and Duvigneau-Frydenberg-Peniche-Baker.

Proposed claim 35 (substitute for claim 15) depends from claim 34 and amends claim 15 to add the support arm extends across the slot “*perpendicular to*

the direction of travel of the slider.” For the reasons described for proposed claim 21 in Section V.A, Duvigneau-Baker teaches this limitation. A POSA would have found it obvious and been motivated to modify the Duvigneau-Frydenberg-Dane and Duvigneau-Frydenberg-Peniche combinations to add Baker, with a reasonable expectation of success, for the same reasons discussed for claim 21. EX1035, ¶80. Duvigneau teaches the remaining limitations of claim 35, which are present in original claim 15, for the reasons discussed in the Petition. Pet., 46. Accordingly, Duvigneau-Frydenberg-Dane-Baker and Duvigneau-Frydenberg-Peniche-Baker renders obvious proposed claim 35. EX1035, ¶80.

G. Proposed Substitute Claims 36-40

Proposed claims 36-40 depend from claim 35 and add no new features over what was addressed in the Petition with respect to claims 16-20. These limitations would have been obvious. Pet., 60, 65, 70-76. Accordingly, Duvigneau-Frydenberg-Dane-Baker and Duvigneau-Frydenberg-Peniche-Baker render obvious claim 40; combined with Niles or Morel, render obvious claim 36, combined with Morel-Weng, render obvious claims 37-38; and combined with Brunner renders obvious claim 39. EX1035, ¶81.

VI. MERIDIAN HAS NOT PRODUCED POTENTIAL PRIOR ART.

Patent owners have a duty of candor under 37 CFR § 42.11 “to disclose to the Board information of which the patent owner is aware that is material to the

patentability of substitute claims, if such information is not already of record in the case.” *Lectrosonics*, 9-10.

Dr. Vallee testified about a “stackable transportation system for tool storage containers” product developed during one of his courses prior to the ’689 priority date. EX2012, ¶2; EX1038, 38:11-39:7, 40:3-8. According to Dr. Vallee, the Irwin company “came to us” and asked for “a system that will help us to transport multiple storage containers on a worksite.” EX1038, 38:2-10. Dr. Vallee explained that the containers “had features on the top and bottom of the container so they could be interlocked so they don’t move”: the containers were latched together with “female and male detents” to interlock the containers. EX1038, 38:11-15, 40:16-41:14. He testified that Irwin was “very impressed with the design and they informed us that they were going to move forward with it.” EX1038, 42:19-43:4.

Dr. Vallee’s testimony strongly indicates that the stacked storage container system is potentially relevant prior art that may be material to the patentability of the substitute claims. At a minimum, the system appears to include stackable storage containers with male and female detent structures (e.g., a sliding mechanism that connects to a groove or slot) used to interlock containers. Those features are directly relevant to the substitute claims. Under *Lectrosonics*, information concerning such features is material even if the system does not disclose every limitation of a substitute claim. *Lectrosonics*, 10.

ToughBuilt requested additional information and documentation about the system, but Meridian has yet to provide it. Instead, Meridian asserted the system is not admissible prior art in an IPR. EX1042, 2. Not true—product art is relevant to determine the patentability of the substitute claims. *See Uniloc 2017 LLC v. Hulu, LLC*, 966 F.3d 1295, 1304-1305 (Fed. Cir. 2020) (holding that § 311 does not constrain the Board’s consideration of substitute claims and that substitute claims may be evaluated for overall patentability). ToughBuilt requested that the information be provided a week before this Opposition was due, but neither Meridian, nor Dr. Vallee, appear to have conducted any meaningful investigation regarding the existence of documents relating to the system. Instead, Meridian represented only that Dr. Vallee “is unaware of any documents” that still exist in his or University records, and that they will supplement “should any relevant requested materials be discovered during the pendency of these IPRs.” EX1042, 4. Thus, Meridian appears to have failed to provide all relevant prior art.

VII. CONCLUSION

The Motion to Amend is procedurally defective and the proposed substitute claims are unpatentable under §§ 112 and 103. The Board should deny the Motion.

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 CONTINGENT MOTION TO AMEND** and associated
Exhibits 1035-1042 were served in their entireties upon the Patent Owner on July
28, 2026, via electronic mail:

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