

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOUGHBUILT INDUSTRIES, INC.,

Petitioner,

v.

MERIDIAN INTERNATIONAL CO., LTD.,

Patent Owner.

IPR2025-01462

Patent 11,192,689 B2

Before ANNETTE R. REIMERS, BARRY L. GROSSMAN,
and ROBERT L. KINDER, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE

Patent Owner's Motion To Amend

37 C.F.R. § 42.121(e)

I. INTRODUCTION

On February 10, 2026, we instituted trial as to claims 1–20 of U.S. Patent No. 11,192,689 B2 (“the patent”). Paper 14. After institution, Patent Owner filed a Motion to Amend that is contingent on the patentability of claims 1–20. Paper 27 (“Motion” or “Mot.”). Petitioner filed an opposition on July 28, 2026. Paper 31 (“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 21–40 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).

For the reasons discussed below, Patent Owner has shown by a reasonable likelihood that substitute claims 21–40 meet the statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. However, Petitioner has shown by a preponderance of the evidence that the amended limitations of substitute claims 21–40 are unpatentable.

II. PRELIMINARY GUIDANCE

A. The Substitute Claims

Substitute claims 21–40 respectively replace the patent's claims 1–20. A copy of the substitute claims 21–40 is provided by the Motion's Claims Appendix.

Substitute claims 21, 22, 34, 35, and 38, reproduced below, amend recitations of the patent's respective claims 1, 2, 14, 15, and 18 (i.e., beyond their dependencies). Underlining indicates added language. Strikethrough indicates deleted language.

21. (substitute for claim 1, if found unpatentable) A stackable storage system comprising:

a first storage container configured and arranged to be selectively connected to a second storage container,

wherein the first storage container comprises of at least one locking groove and the second container comprises a sliding

mechanism for selectively engaging the locking groove to connect and hold the first storage container to the second storage container, ~~and~~

wherein a portion of the sliding mechanism extends laterally away from a side surface of the second container when the sliding mechanism is disengaged from the locking groove and wherein the portion of the sliding mechanism is coplanar with the side surface of the second container when the sliding mechanism is engaged with the locking groove, and

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.

22. (substitute for claim 2, if found unpatentable) The stackable storage system of claim ~~4~~ 21, wherein the sliding mechanism further comprises of a slider comprising two insertion portions configured to engage with the locking groove, wherein the slider is configured to move that moves between the engaged and disengaged position with respect to the locking groove.

24. (substitute for claim 4, if found unpatentable) The stackable storage system of claim ~~3~~ 23, wherein the ~~second storage container further comprises of a slot in~~ slot is formed within the side surface of the ~~second storage~~ container ~~with a support arm extending across the slot, and~~ wherein the slider is engaged with the support arm to move between a locked position that corresponds to the engaged position of the locking groove and an unlocked position that corresponds to the disengaged position of the locking groove.

34. (substitute for claim 14, if found unpatentable) A stackable storage container comprising:

a second storage container configured and arranged to be selectively connected to a locking groove of a first storage container,

wherein the second container comprises a sliding mechanism for selectively engaging the locking groove of the first storage container to connect and hold the first storage container to the second storage container, and

wherein a portion of the sliding mechanism extends laterally away from a side surface of the second container when the sliding

mechanism is disengaged from the locking groove and wherein the portion of the sliding mechanism is coplanar with the side surface of the second container when the sliding mechanism is engaged with the locking groove,

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

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.

35. (substitute for claim 15, if found unpatentable) The storage container of claim 14 ~~34~~, ~~wherein the sliding mechanism further comprises of a slider that moves between the engaged and disengaged position with respect to the locking groove,~~ wherein the slider has a side surface that is perpendicular to the direction of travel of the slider between the engaged and disengaged position with respect to the locking groove and the side surface of the slider is coplanar with the side surface of the second storage container when the slider is engaged with the locking groove, and wherein the second storage container further comprises of a slot in the side surface of the container with a support arm extending across the slot perpendicular to the direction of travel of the slider, wherein the slider is engaged with the support arm to move between a locked position that corresponds to the engaged position of the locking groove and an unlocked position that corresponds to the disengaged position of the locking groove.

38. (substitute for claim 18, if found unpatentable) The storage system of claim 17 ~~37~~, ~~wherein the support arm and the slider further comprise a cooperating guide to constrain lateral movement of the slider with respect to the support arm, wherein the cooperating guide is a~~ guiding rib is provided on the support arm that cooperates with a guiding slot on the slider which to constrain lateral movement of the slider with respect to the support arm.

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 shown by a reasonable likelihood that substitute claims 21–40 satisfy the 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); *see also* 37 C.F.R. § 42.121(a)(3). “There is a rebuttable presumption that a reasonable number of substitute claims per challenged claim is one (1) substitute claim.” *Lectrosonics*, Paper 15 at 4; *see also* 37 C.F.R. § 42.121(a)(3). Patent Owner proposes a reasonable number of substitute claims by proposing to substitute claims 21–40 respectively for the patent’s claims 1–20. Mot. 4–5.

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 contends the Motion fails to respond to a ground of unpatentability as to substitute independent claim 21 and depending substitute claims 22 and 24 because:

[T]hese 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.

Opp. 7–8.

We are unpersuaded that the limitations added by substitute claims 21, 22, and 24 (added respectively to the patent’s claims 1, 2, and 4) are not entitled to patentable weight. Although we agree with Petitioner that the added limitations of substitute claims 21, 22, and 24 recite relationships between the claimed first container and an *unclaimed* second container, we do not interpret those relationships as failing to limit the patent’s respective claims 1, 2, and 4. Rather, we interpret those relationships as requiring the claimed first container to be capable of cooperating with a second container in the manner recited. *See In re Chudik*, 851 F.3d 1365, 1373 (Fed. Cir. 2017) (“[The claim’s] ‘arranged to engage’ language could imply that the protruding surface . . . need not always actually

engage However, it must be at least capable of doing so.”); *In re Schreiber*, 128 F.3d 1473, 1478–79 (Fed. Cir. 1997).

3. Scope of Amended Claims

A motion to amend may not enlarge the scope of the claims of the patent. *See* 35 U.S.C. § 316(d)(3) (“An amendment . . . may not enlarge the scope of the claims of the patent or introduce new matter.”); 37 C.F.R. § 42.121(a)(2)(ii) (“A motion to amend may be denied where . . . [t]he amendment seeks to enlarge the scope of the claims of the patent[.]”); *Lectrosonics*, Paper 15 at 6 (“A patent owner may not seek to broaden a challenged claim in any respect that enlarges the scope of the claims of the patent.”).

Substitute independent claims 21 and 34 respectively amend the patent’s claims 1 and 14, which are the patent’s only two independent claims. Mot., Claims App.; Ex. 1001, claims 1–20. The added recitations of claim 21, quoted below, incorporate the following emphasized recitations from the patent’s dependent claim 4: “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.” Mot., Claims App. The added recitations of claim 34, quoted below, incorporate the following emphasized recitations from respectively the patent’s dependent claims 15 and 18: “***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” (*cf.*, Ex. 1001, claim 15); and “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” (*cf.*, Ex. 1001, claim 18). Mot., Claims App. The above un-emphasized recitations of claims 21 and 34 are not incorporated from the patent’s dependent claims. Mot., Claims App. Accordingly, for the foregoing reasons, we conclude the substitute claims do not enlarge—and rather narrow—the scope of the patent’s claims.

Petitioner contends substitute dependent claim 38 broadens the patent’s respective dependent claim 18 by deleting, but not incorporating into substitute base claim 34, the following recitation: “support arm and the slider further comprise a cooperating guide to constrain lateral movement of the slider with respect to the support arm.” Opp. 6–7. Petitioner further contends claim 38 broadens claim 18 by changing the guide’s constraining of lateral movement “with respect to the support arm” (Ex. 1001, claim 18) to constraining of lateral movement “with respect to the second storage container” (claim 38). Opp. 7. We are unpersuaded because, as discussed above, the substitute independent claims 21 and 34 narrow the patent’s only independent claims. Therefore, even assuming the language of claim 38 is broader than the language of claim 18, the change does not enlarge the scope of the patent’s claims. *Cf.*, *Manual of Patent Examining Procedure* § 1412.03(II) (explaining, in the context of a reissue application, that an amendment that broadens a dependent claim does not broaden the scope of the claims of the patent where the independent claim is not broadened).

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 added limitations of the substitute claims against the patent’s originally-filed disclosure. Ex. 1002 at 43–65. We determined that each of the added limitations is plainly conveyed in the figures¹ and corresponding Specification descriptions thereof, which name disclosed elements identically to the claimed elements (e.g., a “sliding mechanism” comprising a “slider” (Ex. 1002 at 44)). Indeed, the figures (Ex. 1002 at 59–65) 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 (Figure 7) and their cited Specification descriptions (3:13–40, 3:63–4:23)². Mot. 6–8.

Petitioner contends the Motion does not cite support in the original disclosure for the claims as a whole. Opp. 4–5. For substitute independent

¹ The figures of the patent, patent’s originally-filed disclosure, and Chinese priority application are identical. *Compare* Ex. 1001, Figs. 1–11 *with* Ex. 1002 at 59–65 *and with* Ex. 2017 at 15–21.

² These cited portions of the Specification describe pertinent elements of Figures 1–5, 7, 10, and 11.

claim 22, Petitioner further contends the Motion's citations to Specification support show "the '689 patent describes two insertion portions engaging two separate locking grooves" but do not show the patent describes the claimed "two insertion portions engaging a *single* locking groove." Opp. 5 (emphasis added; internal quotation marks omitted); *id.* at 8; Ex. 1035 ¶ 7. Similar contentions are presented against the Motion's cited support for substitute claim 34's "the slider having two insertion portions receivable within two reciprocal slots of the locking groove." Opp. 5–6; Ex. 1035 ¶ 9.

We are unpersuaded because Petitioner does not address the aforesaid figures. The added limitations of claims 22 and 34 are supported by the patent's figures; *e.g.*, Figures 3–7 illustrate a slider 30 mounted on a container's lid and having two insertion portions 32 that engage two respective portions 12 of a groove located on another container's bottom side portion. Ex. 1001, Figs. 1–7. Though the Specification names these portions 12 as "locking grooves," not as portions of a singular locking groove, these portions 12 are plainly illustrated as bisections of one groove (bisected by a thin structure for, apparently, stiffening a wall of the groove).

For substitute claim 24, Petitioner also contends the Motion's citations to Specification may show "locking grooves . . . 'at the lower end of the outer side of the first storage container'" but the citations do not show how the patent describes "a slot 'formed within the side surface' of the second storage container." Opp. 5–6 (citing Ex. 1001, 3:26–30); Ex. 1035 ¶ 8. We are unpersuaded because, again, Petitioner does not address the aforesaid figures. The added limitation of claim 24 is supported by the figures; *e.g.*, Figures 1–4, 6, and 7 illustrate a slot 21 within a side surface of a container 20.

Based on our review of the current record, Patent Owner's Motion does not introduce new subject matter. Patent Owner has established by a reasonable likelihood on this record that the cited portions of the patent's original disclosure show support for the newly added limitations of the substitute 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 21–40 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).

Generally speaking, we agree with Petitioner's following characterization of the amendments:

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.

Opp. 8–9 (emphases omitted). And, we agree with Petitioner that the prior art of record shows the newly added slot limitation (1) would have been obvious and the newly added slider and locking groove limitations (2) would have been obvious. *Id.* at 9–20.

1. Independent Claim 21

Substitute independent claim 21 recites (emphases added):

21. (substitute for claim 1, if found unpatentable) A stackable storage system comprising:

a first storage container configured and arranged to be selectively connected to a second storage container,

wherein the first storage container comprises of at least one locking groove and the second container comprises a sliding mechanism for selectively engaging the locking groove to connect and hold the first storage container to the second storage container, ~~and~~

wherein a portion of the sliding mechanism extends laterally away from a side surface of the second container when the sliding mechanism is disengaged from the locking groove and wherein the portion of the sliding mechanism is coplanar with the side surface of the second container when the sliding mechanism is engaged with the locking groove, and

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.

Petitioner contends all but the above-emphasized portions of substitute claim 21's added limitations are incorporated from the patent's dependent claim 4. Opp. 9–10; Ex. 1035 ¶¶ 38–39. We agree claim 21's added “wherein the second storage container comprises a slot with a support arm extending across . . . the slot” is incorporated from claim 4 and, particularly, incorporates the following limitations deleted from claim 4 by substitute dependent claim 24:

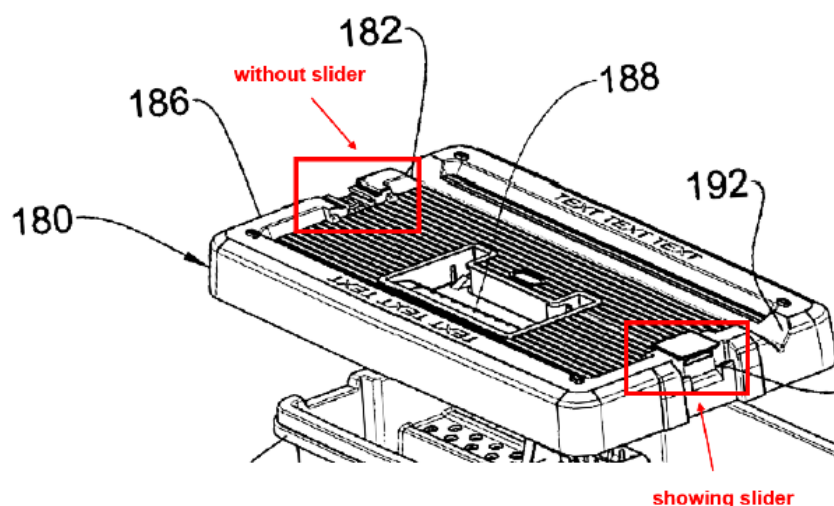
24. (substitute for claim 4, if found unpatentable) The stackable storage system of claim 3 23, wherein the ~~second storage container further comprises of a slot in~~ slot is formed within the side surface of the second storage container ~~with a support arm extending across the slot, and~~ wherein the slider is engaged with the support arm to move between a locked position that corresponds to the engaged position of

the locking groove and an unlocked position that corresponds to the disengaged position of the locking groove.

Mot., Claims App. We also agree claim 21's added "wherein the sliding mechanism is engaged with the support arm" is incorporated from claim 4 and, particularly, incorporates a broader variation of claim 4's "wherein the slider is engaged with the support arm" (which remains within respective claim 24). That is, claim 21's added "wherein the sliding mechanism is engaged with the support arm" is incorporated from claim 4 but replaces claim 4's "slider" ("mov[ing] between a locked position that corresponds to the engaged position of the locking groove and an unlocked position that corresponds to the disengaged position of the locking groove") with claim 21's broader "sliding mechanism." *See* Ex. 1001, Fig. 2 (sliding mechanism 100 including slider 30).

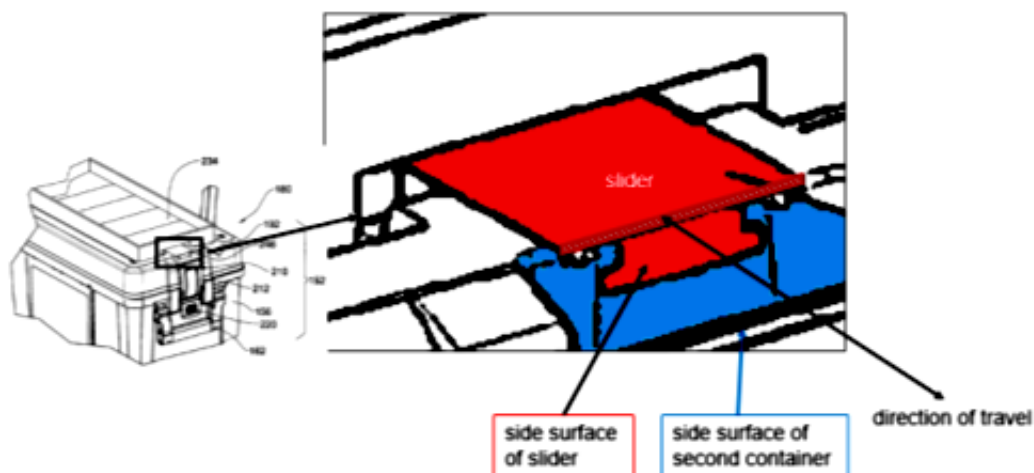
Petitioner also contends substitute claim 21's added configuring of the support arm—extending across "a width" of the slot and "perpendicular to the direction of travel of the slider"—would have been obvious over Duvigneau in view of Baker. Opp. 10–14; Ex. 1035 ¶¶ 40–51. We agree in view of Duvigneau's Figures 5–6 and Baker's Figure 28 as reproduced and annotated within the Petition and Opposition.

Duvigneau's Figure 5 "is a front exploded isometric view of . . . [a] cabinet assembly." Ex. 1007 ¶ 33. Reproduced below is Duvigneau's Figure 5 as presented in the Petition with annotations. Pet. 35.



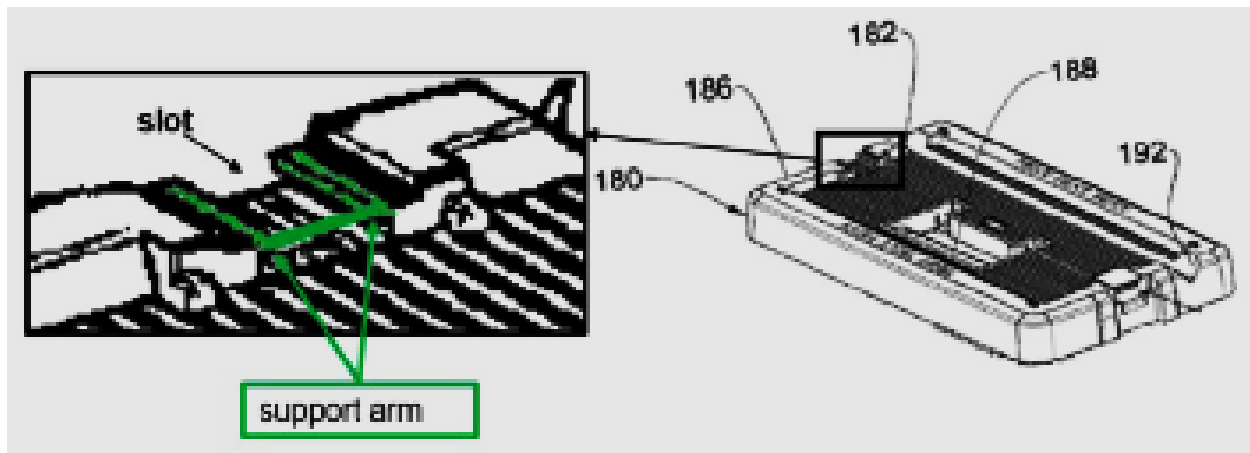
As shown above, the Petition presents Duvigneau's Figure 5 with red annotations to show a container lid 180 having two slots for two respective sliders. Pet. 35. A first slot is illustrated without its slider to reveal the configuring of the slots. A second slot and slider combination is illustrated with the slider covering and tracking within the slot. As further discussed below, these slots and sliders are a basis of the Duvigneau-Baker combination; they are the structures of Duvigneau as modified in view of Baker. *See, e.g.*, Opp. 12, 21; Ex. 1035 ¶¶ 40–51, 74.

Duvigneau's Figure 6 "is an isometric view of a latching portion of the cabinet assembly." Ex. 1007 ¶ 34. Reproduced below is Duvigneau's Figure 6 as presented in the Petition with annotations. Pet. 31.



As shown above, the Petition presents Duvigneau's Figure 6 with blue and red annotations to show an exploded view of the above slot and slider combination, emphasize the slider (red), and emphasize the slot (blue). Pet. 31. The slider is illustrated as sliding within the slot along a labeled direction of travel. *Id.*

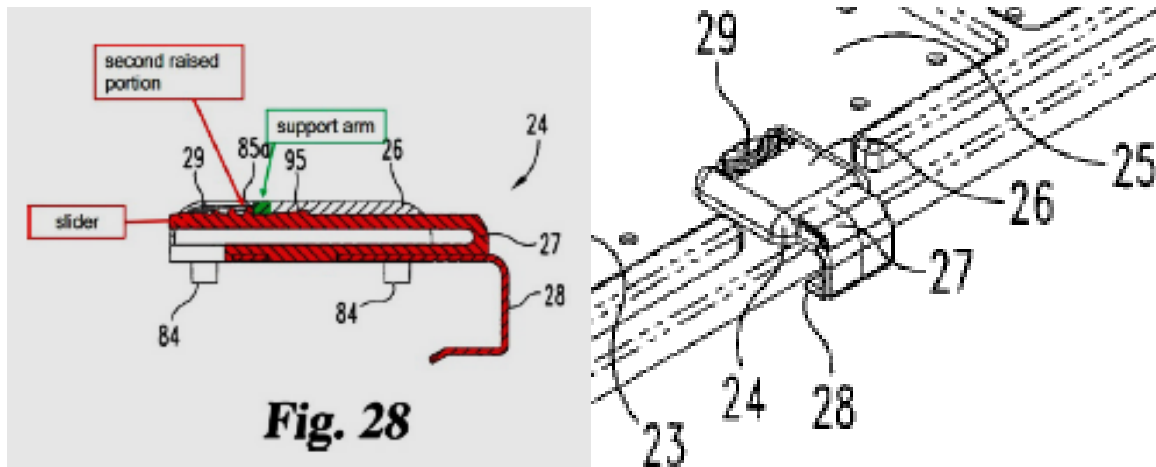
Reproduced below is Duvigneau's Figure 5 as presented in the Opposition with annotations. Opp. 12.



As shown above, the Opposition presents Duvigneau's Figure 5 with green annotations to show an exploded view of the slot without a slider, emphasize the slot's rails that guide/track the slider along its direction of travel,³ and propose a structure extending between/from the rails and entirely across the slot to form the claimed "support arm" in view of Baker. Opp. 12–14; Ex. 1035 ¶¶ 40–51.

Baker's Figure 28 is "a side elevational view . . . of [a] slide latch." Ex. 1021 ¶ 35. Baker's Figure 12 "is a perspective view of [a] containment tray" including the slide latch. Ex. 1021 ¶ 19. Reproduced below (left) is Baker's Figure 28, as presented in the Opposition with annotations, and an exploded view of Baker's Figure 12 (right), which we provide for a close perspective view of the slide latch.

³ Petitioner refers to the rails as "support arm(s)." *See, e.g.*, Pet. 35–36; Ex. 1035 ¶ 45.



As shown above (left), the Opposition presents Baker's Figure 28 with red and green annotations to respectively show a slider (red) and abutting structure (green) that Petitioner asserts as suggesting the above support arm proposed for Duvigneau. Opp. 10–12; Ex. 1035 ¶¶ 40–46.

We agree with Petitioner that, when the slider is at the open position (as shown), first and second raised portions of the slider 27 catch/snag edges at respectively a first edge 95 and second edge 85a of the abutting latch body 26 to prevent the slider 27 from sliding past the open position (and out of the slide latch 24). Opp. 10–12; Ex. 1021, ¶¶ 62–64; Ex. 1035 ¶¶ 12–16, 19–20, 41–44.⁴ And, when the slider is at the closed position (not shown), the first raised portion of the slider catches/snags the edge of the abutting structure 26 at the second position 85a to prevent the slider from sliding out of the closed position to the open position (until a person presses a slide button 29 to manipulate the first raised portion under and past the edge at the second position 85a). *Id.*; see also Ex. 1021, Fig. 24 (slider 27 in closed position).

⁴ Baker's reference numerals 85a and 95 respectively label an edge of the latch body 26 and raised portion of the slider 27. Ex. 1021 ¶¶ 60–62. For convenience, we use reference numeral 95 to label the other edge of the latch body 26.

We also agree with Petitioner that the above teachings show it would have been obvious to incorporate the claimed support arm into Duvigneau's slot and slider configuration of Figures 5 and 6. Opp. 10–14; Ex. 1035 ¶¶ 12–16, 19–20, 41–44. Petitioner particularly contends, and we agree, Baker shows it would have been obvious to incorporate a structure spanned across Duvigneau's slot and between the support rails so as to catch/snag a raised portion of the slider and thereby prevent movement of the slider past the open position. Ex. 1035 ¶¶ 45–46.

We note, lastly, Petitioner's expert states “[p]lacement 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.” Ex. 1035 ¶ 46. We agree because, so long as the Duvigneau-Baker combination's catching/snagging elements of the slider (i.e., raised portion) and support arm (i.e., edge) are placed on opposing surfaces that slide against each other (i.e., will catch/snag each other), the support arm may be placed above or below the slider without distinction. *See, e.g., ACCO Brands Corp. v. Fellowes, Inc.*, 813 F.3d 1361, 1367 (Fed. Cir. 2016) (“The prior art consistently locates the two sensors at issue in the shredder's feed The ordinary artisan would then be left with two design choices: he could place the thickness sensor either above the presence sensor . . . or below Each of these two design choices is an obvious combination[.]”). We add the support arm's surface abutting the slider would expectedly be aligned with the top surfaces of Duvigneau's rails abutting the slider; and thus the incorporated support arm would expectedly be, as Petitioner proposes, spanned between the rails so as to likewise abut against the same flat underside of the slider (Opp. 12; Ex. 1035 ¶ 45).

2. Independent Claim 34

Substitute independent claim 34 recites (bracketed numbers added):

34. (substitute for claim 14, if found unpatentable) A stackable storage container comprising:

a second storage container configured and arranged to be selectively connected to a locking groove of a first storage container,

wherein the second container comprises a sliding mechanism for selectively engaging the locking groove of the first storage container to connect and hold the first storage container to the second storage container, and

wherein a portion of the sliding mechanism extends laterally away from a side surface of the second container when the sliding mechanism is disengaged from the locking groove and wherein the portion of the sliding mechanism is coplanar with the side surface of the second container when the sliding mechanism is engaged with the locking groove,

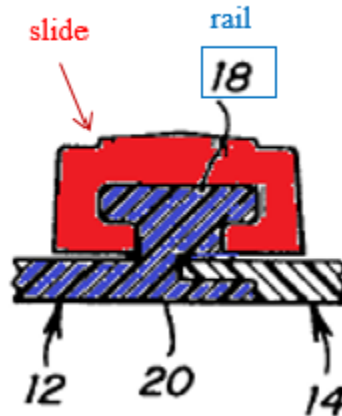
[1] wherein the sliding mechanism comprises a slider configured to move between the engaged and disengaged positions with respect to the locking groove, the slider having two insertion portions receivable within two reciprocal slots of the locking groove, and

[2] 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.

i. Duvigneau and Frydenberg

Petitioner contends the added second limitation “[2]” of substitute claim 34 is substantially similar to limitations of the patent’s claim 10 and thus would have been obvious over the Petition’s asserted combination of Duvigneau and Frydenberg. Opp. 16 (citing Pet. 65–68); Ex. 1035 ¶ 56. The combination modifies Duvigneau’s above rails and slider in view of Frydenberg’s Figure 3. Pet. 67.

Frydenberg's Figure 3 "is a cross-sectional view of [a] longitudinal rail." Ex. 1011 at 2:15–16. Reproduced below is Frydenberg's Figure 3 as presented in the Petition with annotations. Pet. 67.

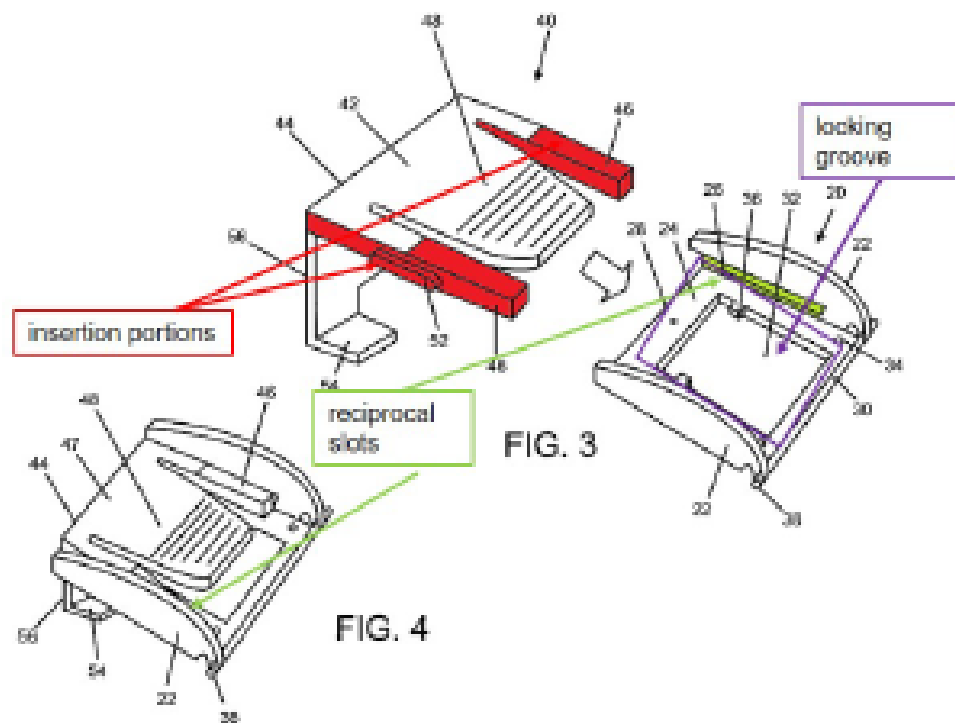


As shown above, Frydenberg's rail 18 is T-shaped (blue) and fit to a slot that is likewise T-shaped (blue). Duvigneau's rails are both modified to be T-shaped (blue) and the slider is modified to include likewise T-shaped slots (red) tracking on the rails. Pet. 67. We agree, with Petitioner, the modification would achieve the added second limitation of claim 34. Opp. 15. Because the underside of Duvigneu's slider faces the two rails, the modification results in the claimed "guiding slot[s] positioned on a bottom side of the slider" (T-shaped slots) that mate two respective "guiding rib[s] of the second storage container" (the modified rails). *Id.* And plainly, the T-shaped interlocking of the rails and slots "constrain[s] lateral movement of the slider with respect to the second storage container," as is claimed. *Id.*

ii. Adding Dane⁵ or Peniche⁶

Petitioner contends the added first limitation “[1]” of substitute claim 34 would have been obvious over the Petition’s Duvigneau-Frydenberg combination as modified in view of Dane. Opp. 16–17. Petitioner newly proposes to modify Duvigneau’s slider in view of Dane’s Figures 3 and 4. Opp. 16–17; Ex. 1035 ¶¶ 58–59.

Dane’s Figures 3 and 4 are respectively “an illustration of an exploded view of [a] latch mechanism” when open (Fig. 3) and “an illustration of the latch mechanism” when closed (Fig. 4). Ex. 1036 ¶¶ 12–13, 19. Reproduced below are Dane’s Figures 3 and 4 as presented in the Opposition with annotations. Opp. 16; Ex. 1035 ¶¶ 58–59.



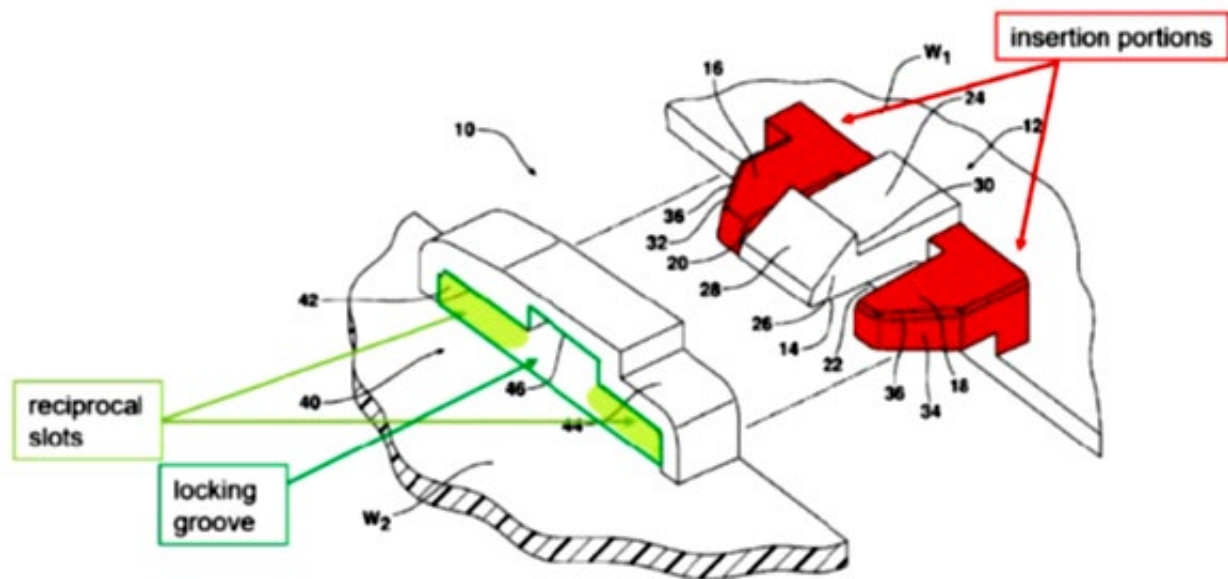
⁵ U.S. Patent Publication No. 2011/0000916 to Dane et al. (Ex. 1036).

⁶ U.S. Patent Publication No. 2016/0236592 to Peniche et al. (Ex. 1037).

As shown above, red annotations emphasize two slide-rail support structures 46 of a slide part 40 that slides into a guide part 20 to latch therein. Opp. 16–17; Ex. 1035 ¶¶ 22–24, 58–59.

Petitioner also contends the added first limitation would have been obvious over the Petition’s Duvigneau-Frydenberg combination as modified in view of Peniche. Opp. 16–17. Petitioner newly proposes to modify Duvigneau’s slider in view of Peniche’s Figure 1. Opp. 19; Ex. 1035 ¶¶ 60–61.

Peniche’s Figure 1 “is an exploded perspective view illustrating [an] attachment device including an attachment head on a first workpiece and a receiver on a second workpiece.” Ex. 1035 ¶ 9. Reproduced below is Peniche’s Figure 1 as presented in the Opposition with annotations. Opp. 19; Ex. 1035 ¶¶ 60–61.



As shown above, red annotations emphasize two locator tabs 16, 18 and green annotations emphasize two openings 42 for receiving the tabs 16, 18 to latch therein. Opp. 19; Ex. 1035 ¶¶ 60–61.

We agree, with Petitioner, that each of Dane and Peniche shows, for a slider taking engaged and disengaged positions with respect to a locking groove, the inclusion of two insertion portions was a known alternative to one insertion portion (e.g., Duvigneau’s one insertion portion). Opp. 17; Ex. 1035 ¶ 67. We add that mere repeating of such simple structure constitutes an obvious duplication of parts. *See In re Schuelke*, 201 F.2d 937, 941 (CCPA 1953) (“Claim 11 . . . call[s] for two clips instead of one This is an obvious duplication of parts. It is clearly within the province of the skilled worker to use as many clips as may be found necessary or desirable.”).

3. Dependent Claim 22

Petitioner contends the added limitations of substitute claim 22 are substantially similar to the added first limitation “[1]” of substitute claim 34 and accordingly obvious over the above Duvigneau-Baker combination asserted against substitute base claim 21 and as modified to incorporate multiple insertion portions in view of Dane and/or Peniche. Opp. 20. We agree.

4. Dependent Claim 24

Petitioner contends substitute claim 24 amends the patent’s claim 4 to merely change a “slot . . . in the side surface” (claim 4) to a “slot is formed within the side surface” (claim 24). Opp. 21. Petitioner also contends the change is immaterial. *Id.* at 22. We agree.

5. Dependent Claims 23 and 25–33

Petitioner contends substitute claims 23 and 25–33 add no limitations to the patent’s respective claims 3 and 5–13. Opp. 21–22. Petitioner also contends the change is immaterial. *Id.* We agree.

6. Dependent Claim 35

Petitioner contends the added limitations of substitute claim 35 are substantially similar to the added limitation of substitute claim 21 and accordingly obvious over the above DuVigneau-Baker combination asserted against claim 21. Opp. 23. Petitioner also contends the change is immaterial. *Id.* We agree.

7. Dependent Claims 36–40

Petitioner contends substitute claims 36–40 add no limitations to the patent’s respective claims 16–20. Opp. 23. Petitioner also contends the change is immaterial. *Id.* We agree.

8. 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. 23–25. 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. 2014 ¶¶ 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 motion to amend by DUE DATE 3 of the Scheduling Order (September 8, 2026). 37 C.F.R. § 42.121(e)(3), (f); Paper 17. Patent Owner’s reply or revised motion to amend 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 motion to amend 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 if Patent Owner does not file a reply or revised motion to amend. 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.8 of this Preliminary Guidance.

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Patent 11,192,689

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