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
Patent 11,192,689

PATENT OWNER'S STATEMENT ON THE "IRWIN COMPANY" MATTER AND DOCUMENT SEARCH

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II. PATENT OWNER'S SEARCH FOR RELEVANT DOCUMENTS 14

Patent Owner provides the following statement pursuant to the Board's August 24, 2026 Preliminary Guidance (Paper 35), which ordered Patent Owner to: "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 by its search, as required by its duty of disclosure under 37 C.F.R. §§ 42.11; 42.51(b)(1)(iii), (b)(2)(ii)." This statement is timely filed within seven days of the date of the Preliminary Guidance.

Petitioner omitted several critical facts regarding the "Irwin company" matter in its Opposition to Petitioner's Contingent Motion to Amend (Paper 31). Accordingly, the following statement also will include relevant facts regarding the "Irwin company" matter, including the timing of Petitioner's request for information regarding the "Irwin company" matter and the lack of relevance of the "Irwin company" matter. The facts establish that Meridian did not "fail[] to provide all relevant prior art to Petitioner" as claimed. (Paper 31, p. 25.) To the contrary, there is no relevant prior art to provide. In fact:

(1) Dr. Vallee's testimony did not "strongly indicate" that the "Irwin company" product was "potentially relevant prior art that might be

material to the patentability of the substitute claims" (Paper 31, at p. 24) because Petitioner was aware from its deposition of Dr. Vallee that the "Irwin company" prototype was very different from the product taught by U.S. Patent No. 11,192,689 ("the '689 patent) and it is therefore not relevant prior art to the '689 patent (**Exhibit 2020**, ¶¶ 13-15);

(2) The "Irwin company" project did not result in a "new product" as represented by Petitioner; indeed, Dr. Vallee's testimony indicated that it was unlikely to have become a commercial product, and his own research supports that understanding (**Exhibit 2020**, ¶¶ 16, 28);

(3) Petitioner failed to request the "Irwin company" materials until two weeks before the close of its discovery period and failed to identify any discovery rule permitting such discovery[1] (**Exhibit 1042**);

(4) Petitioner was on notice that Dr. Vallee did not believe he had any documents in his possession that discussed, described or otherwise disclosed the design resulting from the Irwin company project (**Exhibit 1045**, at 36:2-11; **Exhibit 2020**, ¶¶ 17-18);

[1] Indeed, there is no discovery rule that would necessitate disclosure of the "Irwin company" materials if such materials existed.

(5) Petitioner was on notice that Dr. Vallee was traveling following Petitioner's first request for documents concerning the Irwin company project and would not have an opportunity to perform a significant search until two weeks after his depositions in this and IPR 2025-01461 were completed (**Exhibit 1038**, at 72:7-73:14; **Exhibit 2020**, ¶ 20);

(6) Petitioner nevertheless requested production of such documents within three business days of its request for production of such documents (**Exhibit 2021**);

(7) Despite the lack of notice and time, Dr. Vallee performed a search for relevant materials, and, consistent with his testimony, found none, a fact which was reported to Petitioner within the three business days (**Exhibit 1042**).

I. BACKGROUND

A. <u>The "Irwin company" Matter is Not Relevant Prior Art.</u>

Any materials that discuss, describe or disclose the "Irwin company" matter – to the extent that any existed – would not be relevant prior art because they are not relevant and they are not prior art.

1. The "Irwin company" prototype is not relevant to the invention of the '689 patent.

During Dr. Vallee's deposition, he testified that the latches he previously designed or worked with – including the "Irwin company" design – were not relevant prior art. (**Exhibit 2020,** Vallee Decl., at ¶ 13; **Exhibit 1038** at 217:5-218:7.) As he has further explained, "[t]hat is because, as was expressed in **Exhibit 1042**, "the described system connected containers to each other via a nesting system, but the only latching mechanism disclosed was a strap that wrapped around and connected multiple containers at once to a wheel system, not one that individually connected container to container." (**Exhibit 2020,** Vallee Decl., at ¶ 14.) Dr. Vallee then stated: "Indeed, the '689 patent does not claim a nesting system and does not claim a strap that wraps around multiple containers, which is why the 'Irwin company' design is not relevant prior art to the '689 patent." (*Id.*, at ¶ 15.)

2. There are no known "Irwin company" materials.

Dr. Vallee's testimony made clear that he was not aware of any existing materials in his possession discussing, describing or disclosing the "Irwin company" project:

Q Do you have documentation or a website that describes that?

> A I personally don't. It generally was kept. There was a university website that we keep these things but I'm not sure it is even still there. They changed systems and generally they don't keep things over a certain number of years. I don't have it. I don't even know if the university still has it.

(**Exhibit 1045**, at 36:2-11; **Exhibit 2020**, Vallee Decl., at ¶¶ 17-18.) He affirmed this in his declaration, stating "I am not aware of any written materials that were saved by myself or the university that describe the 'Irwin company'" design, and believe that if any such materials existed, they would likely be subject to confidentiality provisions, which I recall applying to these types of products." (**Exhibit 2020**, at ¶ 17.) His search for relevant materials, as reported in Meridian's letter of July 21, 2026 (**Exhibit 1042**), and again reported in his declaration attached hereto (**Exhibit 2020**, at ¶ 28), confirmed this.

3. Any "Irwin company" matter materials would not comprise prior art because Petitioner has not shown that they were accessible to the public.

It is Petitioner's burden to show that the alleged prior art was publicly accessible, and it has not done so. Nor can they do so, as the only evidence on accessibility of these materials – should any exist – indicates that such materials would not comprise appropriate prior art for submission in an IPR

or in any USPTO proceeding because there is no known printed publication regarding the "Irwin company" matter:

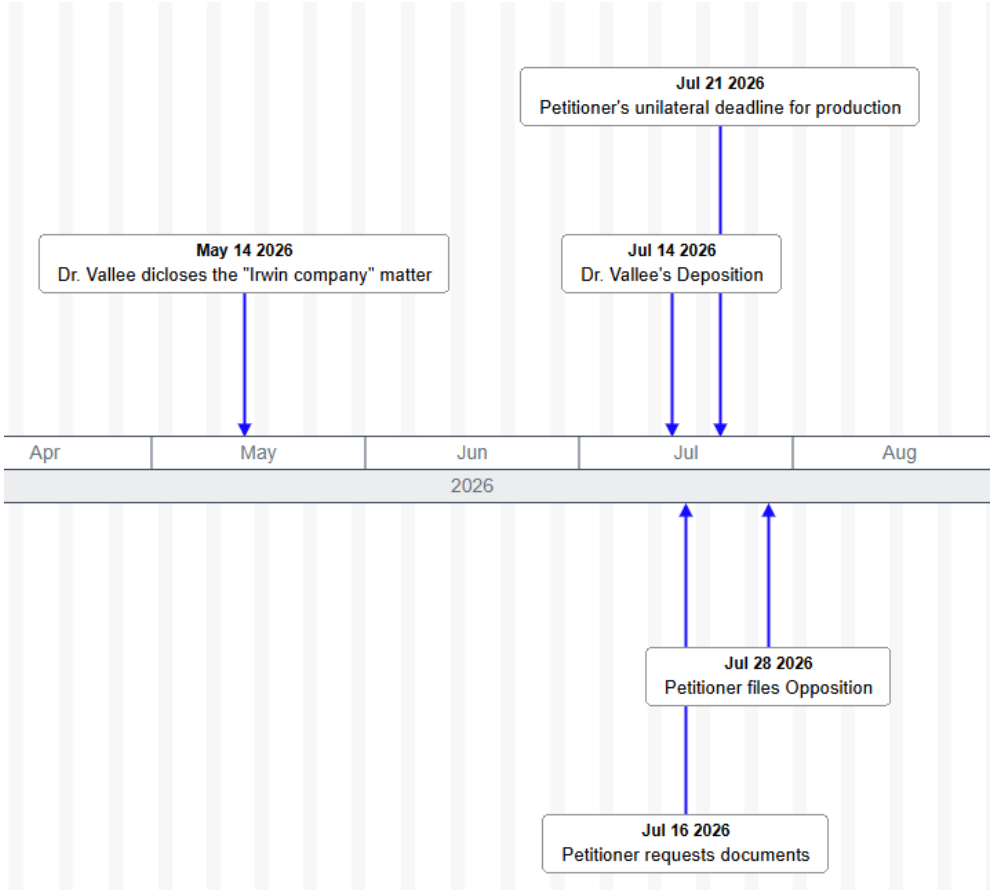
> An IPR may only assert prior art in the form of patents and printed publications. There are no known patents or printed publications disclosing the stackable tool transportation project. And, if there were any written materials related to this project, there is no evidence that they would be accessible to the public. (MPEP 2128.) Indeed, Dr. Vallee testified that there may be confidentiality requirements attached to the stackable tool transportation project. To the extent documentation related to the project existed, therefore, it would still not be a "printed publication" because internal documents intended to be confidential are not "printed publications." (MPEP 2801.01(III).)

(**Exhibit 1042**.)Similarly, Petitioner has not shown that any such materials – should they exist – would constitute a public use. Nor is it likely that they could do so, for the same reasons. Manual of Patent Examining Procedure § 2152.02(c) (Ninth ed. Rev. 01.2024, Nov. 2024) ("As discussed previously, public use under AIA 35 U.S.C. 102(a)(1) is limited to those uses that are available to the public."). (*See* **Exhibit 2020**, Vallee Decl. at ¶ 17 ("I am not aware of any written materials that were saved by myself or the university that describe the 'Irwin company'" design, and believe that if any such materials existed, they would likely be subject to confidentiality provisions, which I recall applying to these types of products.")

B. **Petitioner's Request for Information Regarding the "Irwin company" Matter was Improper.**

1. Petitioner's request was belated and did not provide adequate time to respond.

Dr. Vallee's declaration, in which he disclosed the "Irwin company" matter, was filed with the PTAB and served on Petitioner on May 14, 2026. (**Exhibit 2012**, ¶ 2; **Exhibit 2020**, ¶ 7.) Petitioner did not request materials related to the "Irwin company" matter until during Dr. Vallee's July 14, 2026 deposition, two months later. Petitioner then sent a letter on July 16, 2026, requesting the provision of said materials within three business days. (**Exhibit 2021**, Email from Haapala.) Prior to this request, Dr. Vallee notified Petitioner that he would not have time to search for materials related to the "Irwin company" matter until the following week, due to pre-existing travel and work commitments. (**Exhibit 1038**, at 72:7-73:14; **Exhibit 2020,** Vallee Decl., at ¶ 20.) Petitioner's request was therefore unreasonable, and did not provide Patent Owner with a reasonable opportunity to "timely search for and produce relevant documents."



2. Petitioner's request does not fall within the scope of permitted limited discovery.

"[D]iscovery beyond depositions of witnesses who provide declarations or affidavits in the IPR or PGR is rarely granted [and requires prior authorization by the PTAB in any case]." Megan Raymond, *Post-Grant Proceedings Before the Patent Trial and Appeal Board* § 6.1 (2d ed., Nov. 2025 Supp.). Here, Petitioner's request is outside the scope of routine discovery, and prior authorization has not been sought.

a. Petitioners refused to agree to initial disclosures.

Subject to 37 C.F.R. § 42.51(a), Patent Owner inquired as to whether Petitioner would agree to the exchange of initial disclosures on December 3, 2025. (**Exhibit 2022**). Counsel for Petitioner declined. As a result, there was no agreement to an exchange of discovery in this matter.

b. Petitioner's request is outside the scope of routine discovery.

Petitioner asserted that the request for the "Irwin company" materials was "routine discovery" under 37 C.F.R. § 42.51(b)(1)(iii), which relates to inconsistent statements. (**Exhibit 2021**.) But the "Irwin company" matter is not inconsistent with a position advanced by the party during the proceeding. Indeed, in response to Petitioner's July 16, 2026 letter Patent Owner asked that Petitioner identify any such inconsistency:

> The existence of the stackable tool transportation project is not "inconsistent with a position advanced by Meridian during the proceeding." The stackable tool transportation project is not, as discussed above, relevant prior art. To the extent that you disagree, please identify any such inconsistency, as we genuinely have no idea what you are referring to. Indeed, Mr. Tang appeared to indicate that the only reason that the materials were being requested was to confirm Dr. Vallee's testimony, not because there was any inconsistency.

(**Exhibit 1042**.) Petitioner did not respond.

Petitioner's request was outside the scope of routine discovery and therefore required prior authorization by the Board. 37 C.F.R. § 42.51. Petitioner neither sought not received such prior authorization.

c. Petitioner's request was also outside of the scope of permissible additional discovery.

Only under extremely limited circumstances, where such discovery is in the "interests of justice," may additional discovery be permitted. 37 C.F.R. § 42.51(b)(2). Here, there was no agreement to additional discovery, and no motion to the Board seeking such discovery. Nor has Petitioner made any effort to meet the burden of showing that such discovery is needed. "[U]nlike in litigation, the burden for justifying additional discovery is on the party requesting the discovery." Megan Raymond, *Post-Grant Proceedings Before the Patent Trial and Appeal Board* § 6.5.1 (2d ed., Nov. 2025 Supp.). Petitioner has not met its burden. Indeed, it is unlikely that such additional discovery would be 'in the interests of justice, because, as explained in Patent Owner's letter:

> Moreover, it is also not within the scope of additional discovery allowed by the Board because it is not "necessary in the interest of justice" as Petitioner's request rests on "speculation that in fact something useful2

[2] "'Useful' in that context does not mean merely 'relevant' and/or 'admissible.' In the context of Factor (1), 'useful' means favorable in substantive value to a contention of the party moving for discovery." *Garmin Int'l,* IPR2012-00001, Paper 26.

> will be uncovered" and is "overly burdensome to answer." Garmin Int'l, Inc. v. Cuozzo Speed Tech. LLC, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) (precedential). Petitioner is seeking materials that cannot be readily located, if they exist at all, and which are only related to something that does not comprise relevant or admissible prior art. Indeed, Dr. Vallee's testimony in his second deposition made clear that it was unlikely that any relevant materials existed or could be located:
>
> Q Do you have documentation or a website that describes that?
>
> A I personally don't. It generally was kept. There was a university website3 that we keep these things but I'm not sure it is even still there. They changed systems and generally they don't keep things over a certain number of years. I don't have it. I don't even know if the university still has it.
>
> (July 15, 2026 Vallee Dep. Rough Transcript at 32:18-33:4 (cleaned up).). As such, any search for such materials beyond what Dr. Vallee has already done (as discussed below) would be overly burdensome.

(**Exhibit 1042**.) In fact, contrary to the impression given by Petitioner, to the best of Dr. Vallee's knowledge, there is no "apparent new product" as referenced in the Preliminary Guidance (Paper 35) for which there would be documentation or a

[3] We have clarified this description with Dr. Vallee and understand him to be referencing a private electronic university document storage system, and not a publicly accessible website.

public product. Rather, Dr. Vallee's testimony, which appears to have been truncated in order to mislead the Board on this point, was as follows:

> ***Again, after we presented it to the company, I don't know if they ever took the idea and ran with it***. Because I think the company may have been sold again afterwards. I'm not sure, but I do know they were very impressed with the design and they informed us that they were going to move forward with it.
>
> ***So I don't know if they ever did or not***.

(**Exhibit 1038**, at 42:20-43:6 (emphasis added).)

The Board denied a request for additional discovery where "Petitioner's request is particularly burdensome given that Petitioner waited nearly a full month after Patent Owner filed its Motion to Amend to first approach the Board for authorization to file this motion, leaving mere weeks for Patent Owner . . . to search for and produce the requested documents before Petitioner's deadline to oppose the Motion to amend." *Neuroderm Ltd. v. AbbVie Inc.*, No. PGR2022-00040, Paper 35, at 10 (P.T.A.B. Apr. 10, 2023). Here, not only did Petitioner fail to file *any* motion seeking this discovery, but Petitioner waited two months after Patent Owner filed Dr. Vallee's declaration to even seek this discovery, rending the request "particularly burdensome." In addition, the materials – to the extent that they exist – date back to ***2012***, and fourteen years later, these materials have

likely been expunged as a result of document retention policies, changes in document storage systems, and the passage of time. Any further searches, beyond those detailed below, would be onerous, expensive, and unlikely to yield results, relevant or otherwise.

C. Patent Owner Timely Responded to Petitioner's Request Despite the Shortcomings of the Request.

Because the Petitioner did not provide the Board with all of the facts related to its request for materials related to the "Irwin company" matter, the Board's Decision stated that "Patent Owner's response is not fully compliant with its obligation to timely search for and produce relevant documents." This conclusion is based on the fiction presented in Petitioner's Opposition, wherein Petitioner claimed that:

> 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.

(Paper 31, at p. 25.) But that is not accurate; to the contrary, (1) Petitioner failed to even request these materials until two weeks before its deadline to file the opposition (**Exhibit 1042**); (2) Petitioner only gave Meridian three business days to perform a search and respond, despite its knowledge that Dr. Vallee was travelling and had limited availability – if any – to search during that time period (*id.*; **Exhibit 1038**, at 72:7-73:14; **Exhibit 2020**, ¶ 20); (3) Petitioner knew from Dr. Vallee's deposition testimony that he did not believe that any documentation existed, or that the "Irwin company" prototype comprised relevant prior art, so there was no "relevant prior art to produce" (**Exhibit 1045**, at 36:2-11; **Exhibit 2020**, ¶¶ 13-15 and 17-18); and (4) Patent Owner responded within Petitioner's unilateral three-day deadline and notified Petitioner that "Dr. Vallee has confirmed that the stackable tool transportation project referenced during his deposition took place in 2012, and that he is unaware of any documents pertaining to the stackable tool transportation project that still exist in his or University records." (**Exhibit 1042**.) A search was completed at that time, before the Patent Owner provided this response to Petitioner.

II. PATENT OWNER'S SEARCH FOR RELEVANT DOCUMENTS

As an initial matter, and as discussed above, Dr. Vallee testified, and Patent Owner's letter reiterated, that it was unlikely that any relevant documents existed

related to the "Irwin company" matter. (**Exhibit 1045**, at 36:2-11; **Exhibit 2020**, ¶¶ 17-18.)

In addition, were the materials requested by Petitioner to exist, such materials would not belong to Patent Owner, nor would they be in the custody or control of the Patent Owner. Rather, any such materials would be in the possession, custody, or control of Dr. Vallee, the institutions for which Dr. Vallee taught and their predecessors in interest, and/or the Irwin company and its predecessors in interest. Patent Owner does not have any relationship with the institutions for which Dr. Vallee taught and their predecessors in interest, and/or the Irwin company and its predecessors in interest, that would permit Meridian to require those entities to search for such materials. Indeed, as was posited by the Board and as was confirmed by Dr. Vallee, Dr. Vallee has not worked for Patent Owner prior to this present engagement (**Exhibit 2020**, Vallee Decl., at ¶¶ 21-23) and did not perform the work discussed in the "Irwin company" matter for Patent Owner (*id.*). As a result, the only source for such materials that is accessible to the Patent Owner is Dr. Vallee.

Nevertheless, Dr. Vallee performed an exhaustive search for these materials:

(1) He has searched for relevant materials on the university course website where such materials were stored but learned that it was no longer available.

(2) He also searched the USPTO database for any patents related to the invention but found none, indicating that the company never sought patent protection which would have been sought prior to commercialization of the invention.

(3) He also searched for the device on the Irwin, Lenox, and Newell Rubbermaid websites,[4] but did not locate the device in any of those locations.

(4) He also performed a Wayback Machine database search to see if the device appeared on older versions of the company websites, but was unable to locate it there.

(5) Finally, he performed a comprehensive search of his own private hard copy and digital records and found nothing related to this invention.

(**Exhibit 2020**, at ¶¶ 27, 28.) Based on Dr. Vallee's thorough searches and his representations that he does not believe any relevant materials exist or have been maintained and that he has not been able to identify any such materials (**Exhibit 2020**, ¶¶ 29, 30), Patent Owner believes that Dr. Vallee and, by extension, Patent

[4] As discussed in **Exhibit 2020**, at ¶ 10. is not clear whether Irwin or Lenox requested the development of such a device. Both companies were later acquired by Newell Rubbermaid, so it was also included in the search. (*Id.*, at ¶ 27.)

Owner, has exhausted all reasonable efforts to locate any such "Irwin company" materials.

Dated: August 31, 2026

Respectfully Submitted,

Eversheds Sutherland (US) LLP

By: /*Anna C. Halsey*/

Anna C. Halsey (Reg. No. 73,960)
Ann G. Fort (admitted *pro hac vice*)
Lindsay M. Kriz (Reg. No. 79,726)
Jeremy D. Spier (Reg. No. 64,544)
EVERSHEDS SUTHERLAND (US) LLP
600 Peachtree St. NE, Suite 5200
Atlanta, GA 30308
(404) 853-8000
(404) 853-8806
Email: AnnaHalsey@eversheds-sutherland.us
Email: AnnFort@eversheds-sutherland.us
Email: LindsayKriz@eversheds-sutherland.us
Email: JeremySpier@eversheds-sutherland.us

Attorneys for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing ***Patent Owner's Statement On The "Irwin Company" Matter and Document Search*** was served via electronic mail, per agreement of the parties, in its entirety, on Petitioner's attorneys of record in IPR2025-01462 on the date indicated below.

Lead Counsel:

Richard M. Bemben (Reg. No. 68,658)
Sterne, Kessler, Goldstein & Fox PLLC
1101 K Street, NW, 10th Floor
Washington, DC 20005
rbemben-PTAB@sternekessler.com
PTAB@sternekessler.com

Backup Counsel:

Timothy L. Tang (Reg. No. 75,187)
Melissa A. Haapala (Reg. No. 47,622)
William H. Milliken (admitted *pro hac vice*)
Sterne, Kessler, Goldstein & Fox PLLC
1101 K Street, NW, 10th Floor
Washington, DC 20005
ttang-PTAB@sternekessler.com
mhaapala-PTAB@sternekessler.com
wmilliken-PTAB@sternekessler.com

Dated: August 31, 2026

By: */Anna C. Halsey/*
Anna C. Halsey