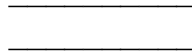


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE PATENT TRIAL AND APPEAL BOARD



Shenzhen Torras Technology Co., Ltd.

Shenzhen Lechuang Tiancheng Technology Co., Ltd.

Shenzhen Ruixin Digital Technology Co, Ltd.

and

Shanghai Kuke Network Technology Co., Ltd.

Petitioners

v.

Rokform IP, LLC

Patent Owner.



IPR2027-00012



PETITION FOR INTER PARTES REVIEW OF

U.S. Patent 12,656,835

Table of Contents

Exhibit List	v
LISTING OF CHALLENGED CLAIMS	vii
Table Of Abbreviations	xv
I. INTRODUCTION.....	1
II. MANDATORY NOTICES	1
A. Real Parties in Interest.	1
B. Related Matters.	1
C. Lead and Backup Counsel and Service Information.	2
III. REQUIREMENTS FOR INTER PARTES REVIEW.....	2
A. Grounds For Standing.	2
B. Identification Of Challenged Claims, The Prior Art And Statutory Grounds On Which The Challenge Is Based.....	3
C. Priority Date and Prior Art.....	4
IV. OVERVIEW OF THE '835 PATENT AND ITS PROSECUTION HISTORY.....	4
A. Specification.....	4
B. The Prosecution History.....	6
C. Level Of Ordinary Skill In The Art.....	6
D. Claim Construction For The '835 Patent.....	7
V. OVERVIEW OF THE GROUNDS OF REJECTION.	8
VI. CLAIMS 1–39 OF THE '835 PATENT ARE UNPATENTABLE.	11
A. Ground 1: Claims 1–39 are unpatentable as obvious under 35 U.S.C. § 103 over Rothbaum857.	11
1. Overview Of Rothbaum857.	11
2. Independent Claim 1	14
3. Claim 2	48
4. Claim 3	49
5. Claim 4	53
6. Claim 5	54
7. Claim 6	56
8. Independent Claim 7	58
9. Claim 8	60
10. Claim 9	60

11.	Claim 10	60
12.	Claim 11	60
13.	Claim 12	60
14.	Claim 13	61
15.	Claim 14	62
16.	Claim 15	62
17.	Claim 16	63
18.	Independent Claim 17	63
19.	Claim 18	64
20.	Claim 19	65
21.	Claim 20	65
22.	Claim 21	65
23.	Claim 22	65
24.	Claim 23	65
25.	Claim 24	66
26.	Independent Claim 25	66
27.	Claim 26	75
28.	Claim 27	75
29.	Claim 28	75
30.	Claim 29	76
31.	Claim 30	77
32.	Claim 31	77
33.	Claim 32	77
34.	Claim 33	77
35.	Claim 34	78
36.	Claim 35	78
37.	Claim 36	78
38.	Claim 37	78
39.	Claim 38	78
40.	Claim 39	79
B.	Ground 2: Claims 1, 7, 19, 20, 22, and 31 Are Obvious under § 103 in view of Rothbaum857 (EX1004) in combination with Byun (EX1006)	81

1.	Overview Of Byun.	81
2.	Independent Claim 1.	82
3.	Independent Claim 7.	86
4.	Claim 19	86
5.	Claim 20	86
6.	Claim 22	87
7.	Claim 31.....	87
C.	Ground 3: Claims 6, 12, and 36 are obvious under 35 U.S.C. § 103 in view Rothbaum857 in combination with Rothbaum609.	87
1.	Overview Of Rothbaum609.	87
2.	Claim 6	89
3.	Claim 12	94
4.	Claim 36	94
VII.	THE BOARD SHOULD NOT EXERCISE ITS DISCRETION AND DENY INSTITUTION.....	95
VIII.	CONCLUSION.....	96

Exhibit List

EX1001: U.S. Patent No. 12,656,835 to Whitten, Jeff et al. (“the ’835 patent)”

EX1002: Patent Prosecution History of U.S. Patent 12,656,835.

EX1003: Expert Declaration of Dr. Randall King.

EX1004: U.S. Pub. No. 2011/0192857 to Rothbaum et al. (“Rothbaum857”), which was published on August 11, 2011, and is the publication of an application filed on January 13, 2011.

EX1005: U.S. Pub. No. 2011/0252609 to Rothbaum et al. (“Rothbaum609”), which was published on October 20, 2011, and is the publication of an application filed on October 20, 2010.

EX1006: English translation of Korea Pub. No. KR101020434B1 to Byun et al. (“Byun”), which was published on March 9, 2011.

EX1007: Korea Pub. No. KR101020434B1 to Byun et al. (“Byun”), which was published on March 9, 2011.

EX1008: Curriculum Vitae of Dr. Randall King

EX1009: U.S. Non-provisional patent application no. 13/593,220 (filed Aug. 23, 2012).

EX1010: U.S. Patent Publication No. 2013/0181584, published July 18, 2013 (corresponding to non-provisional patent application no. 13/593,220).

EX1011: District Court Judge Gilstrap Trial Docket Calendar for March, 2028, Eastern District of Texas.

EX1012: Amended Docket Control Order, *Rokform, LLC and Rokform IP LLC, Plaintiffs v. Shenzhen Torras Technology Co., LTD. and Shenzhen Ruixin Digital Technology Co., LTD*, Defendants, *Shenzhen Torras Technology Co., LTD. and Shenzhen Ruixin Digital Technology Co., LTD*, Counterclaim Plaintiffs,

v. *Rokform, LLC and Rokform IP LLC*, Counterclaim Defendants, Civil Action Nos. 2:26-cv-00052-JRG (lead case), 2:26-cv-0050-JRG, filed June 18, 2026.

EX1013: Ex. A, Consolidated Amended Complaint For Patent Infringement and Jury Demand, *Rokform, LLC and Rokform IP LLC*, Plaintiffs v. *Shenzhen Torras Technology Co., LTD. and Shenzhen Ruixin Digital Technology Co., LTD*, Defendants, *Shenzhen Torras Technology Co., LTD. and Shenzhen Ruixin Digital Technology Co., LTD*, Counterclaim Plaintiffs, v. *Rokform, LLC and Rokform IP LLC*, Counterclaim Defendants, Civil Action Nos. 2:26-cv-00052-JRG (lead case), 2:26-cv-0050-JRG, filed June 18, 2026.

EX1014: Certification of the English translation of Korea Pub. No. KR101020434B1 (Byun).

EX1016: Patent Prosecution History of U.S. Patent Application No. 15/838,933.

EX1017: Provisional Application No. 61/653,618

EX1018: Provisional Application No. 61/585,933

EX1019: Declaration of Dr. Gregory J. Gonsalves

LISTING OF CHALLENGED CLAIMS

Claim 1:	
[1pre]	1. A mountable case for a handheld electronic device, comprising:
[1b]	a body portion configured to retain the handheld electronic device within an interior space of the body portion,
[1c]	the body portion comprising: a rear wall; a perimeter wall;
[1d]	a beveled surface that defines a transition between an exterior surface of the perimeter wall and an exterior surface of the rear wall;
[1e]	wherein the rear wall is configured to be aligned with at least a portion of a rear surface of the handheld electronic device, and wherein the perimeter wall extends from an outer perimeter of the rear wall and is positioned proximate to at least portions of side surfaces of the handheld electronic device, and
[1f]	wherein the rear wall comprises an interior surface configured to face towards the rear surface of the handheld electronic device,
[1g]	wherein the exterior surface of the rear wall comprises a first exterior surface portion and a second exterior surface portion offset from one another in a thickness direction of the rear wall;
[1h]	an exterior-facing component having at least a portion thereof removably received in a receiving space defined by the rear wall of the body portion,
[1i]	the exterior-facing component having a cavity;
[1j]	wherein an exterior surface of the exterior-facing component is offset from at least one of the first exterior surface portion and the second exterior surface portion;
[1k]	wherein the receiving space is defined at least in part by a recessed surface of the rear wall, and wherein the recessed surface faces away from the interior space of the body portion;
[1L]	at least one magnet retained within the cavity, the at least one magnet having a first face and a second face, wherein, with the exterior-facing component received in the receiving space, the first face of the at least one magnet faces the interior space of the body portion and the second face of the at least one magnet faces the exterior-facing component,
[1m]	wherein the at least one magnet defines an outer periphery that extends in a thickness direction of the at least one magnet between the first face and the second face;
[1n]	wherein the cavity of the exterior-facing component is formed at least in part by a curved outer wall, and wherein the outer periphery

	of the at least one magnet is adjacent to at least a portion of the curved outer wall;
[1o]	wherein with the exterior-facing component received in the receiving space, the cavity faces the interior space of the body portion,
[1p]	wherein the exterior-facing component covers the second face of the at least one magnet;
[1q]	wherein the at least one magnet is configured to attach the mountable case to a magnetic structure.
Claim 2:	
[2]	2. The mountable case for a handheld electronic device of claim 1, wherein the outer periphery of the at least one magnet defines a shape that is different than a shape defined by an outer periphery of the exterior-facing component.
Claim 3:	
[3]	3. The mountable case for a handheld electronic device of claim 1, wherein the exterior-facing component and the receiving space have complementary shapes.
Claim 4:	
[4]	4. The mountable case for a handheld electronic device of claim 1, wherein at least one intervening layer is disposed between the first face of the at least one magnet and the interior space of the body portion.
Claim 5:	
[5]	5. The mountable case for a handheld electronic device of claim 1, wherein the rear wall and the perimeter wall are integrally formed as a unitary structure.
Claim 6:	
[6]	6. The mountable case for a handheld electronic device of claim 1, wherein the exterior-facing component directly contacts the second face of the at least one magnet without an intervening layer.
Claim 7:	
[7pre]	7. A mountable case for a handheld electronic device, comprising:
[7b]	a body portion configured to retain the handheld electronic device within an interior space of the body portion,
[7c]	the body portion comprising: a rear wall; a perimeter wall;
[7d]	wherein the rear wall is configured to be aligned with at least a portion of a rear surface of the handheld electronic device, wherein the perimeter wall extends from a perimeter of the rear wall and is positioned proximate to at least portions of side surfaces of the handheld electronic device, and

[7e]	wherein the rear wall comprises an interior surface configured to face towards the rear surface of the handheld electronic device;
[7f]	an exterior-facing component having at least a portion thereof removably received in a receiving space defined by the rear wall of the body portion,
[7g]	the exterior-facing component having a cavity;
[7h]	wherein the receiving space is defined at least in part by a recessed surface of the rear wall, and wherein the recessed surface faces away from the interior space of the body portion;
[7i]	at least one magnet retained within the cavity, the at least one magnet having a first face and a second face, wherein, with the exterior-facing component received in the receiving space, the first face of the at least one magnet faces the interior space of the body portion, wherein the second face of the at least one magnet faces the exterior-facing component,
[7j]	wherein the at least one magnet defines an outer periphery that extends in a thickness direction of the at least one magnet between the first face and the second face;
[7k]	wherein the cavity of the exterior-facing component is formed at least in part by a curved outer wall, and wherein the outer periphery of the at least one magnet is adjacent to at least a portion of the curved outer wall;
[7L]	wherein with the exterior-facing component received in the receiving space, the cavity faces the interior space of the body portion,
[7m]	wherein the exterior-facing component extends along the second face of the at least one magnet;
[7n]	wherein the at least one magnet is configured to attach the mountable case to a magnetic structure.
Claim 8:	
[8]	8. The mountable case for a handheld electronic device of claim 7, wherein the outer periphery of the at least one magnet defines a shape that is different than a shape defined by an outer periphery of the exterior-facing component.
Claim 9:	
[9]	9. The mountable case for a handheld electronic device of claim 7, wherein the exterior-facing component and the receiving space have complementary shapes.
Claim 10:	
[10]	10. The mountable case for a handheld electronic device of claim 7, wherein at least one intervening layer is disposed between the first

	face of the at least one magnet and the interior space of the body portion.
Claim 11:	
[11]	11. The mountable case for a handheld electronic device of claim 7, wherein the rear wall and the perimeter wall are integrally formed as a unitary structure.
Claim 12:	
[12]	12. The mountable case for a handheld electronic device of claim 7, wherein the exterior-facing component directly contacts the second face of the at least one magnet without an intervening layer.
Claim 13:	
[13]	13. The mountable case for a handheld electronic device of claim 7, wherein an exterior surface of the exterior-facing component and at least a portion of an exterior surface of the rear wall are offset from one another in a thickness direction of the rear wall.
Claim 14:	
[14]	14. The mountable case for a handheld electronic device of claim 7, wherein the exterior-facing component covers an entirety of the second face of the at least one magnet.
Claim 15:	
[15]	15. The mountable case for a handheld electronic device of claim 7, wherein an exterior surface of the rear wall comprises a first exterior surface portion and a second exterior surface portion offset from one another in a thickness direction of the rear wall.
Claim 16:	
[16]	16. The mountable case for a handheld electronic device of claim 7, further comprising a beveled surface that defines a transition between an exterior surface of the perimeter wall and an exterior surface of the rear wall.
Claim 17:	
[17pre]	17. A mountable case for a handheld electronic device, comprising:
[17b]	a body portion configured to retain the handheld electronic device within an interior space of the body portion,
[17c]	the body portion comprising: a rear wall; a perimeter wall;
[17d]	wherein the rear wall is configured to be aligned with at least a portion of a rear surface of the handheld electronic device, wherein the perimeter wall extends from a perimeter of the rear wall and is positioned proximate to at least portions of side surfaces of the handheld electronic device, and

[17e]	wherein the rear wall comprises an interior surface configured to face towards the rear surface of the handheld electronic device;
[17f]	an exterior-facing component having at least a portion thereof removably received in a receiving space defined by the rear wall of the body portion,
[17g]	the exterior-facing component having a recess;
[17h]	at least one magnet retained within the recess, the at least one magnet having a first face and a second face, wherein, with the exterior-facing component received in the receiving space, the first face of the at least one magnet faces the interior space of the body portion and the second face of the at least one magnet faces the exterior-facing component,
[17i]	wherein the at least one magnet defines an outer periphery that extends in a thickness direction of the at least one magnet between the first face and the second face;
[17j]	wherein with the exterior-facing component received in the receiving space, the recess faces the interior space of the body portion,
[17k]	wherein the exterior-facing component extends along the second face of the at least one magnet.
Claim 18:	
[18]	18. The mountable case for a handheld electronic device of claim 17, wherein an exterior surface of the exterior-facing component and at least a portion of an exterior surface of the rear wall are offset from one another in a thickness direction of the rear wall.
Claim 19:	
[19]	19. The mountable case for a handheld electronic device of claim 17, wherein the recess of the exterior-facing component is formed at least in part by a curved outer wall.
Claim 20:	
[20]	20. The mountable case for a handheld electronic device of claim 19, wherein the outer periphery of the at least one magnet is adjacent to at least a portion of the curved outer wall.
Claim 21:	
[21]	21. The mountable case for a handheld electronic device of claim 17, wherein the outer periphery of the at least one magnet defines a shape that is different than a shape defined by an outer periphery of the exterior-facing component.
Claim 22:	

[22]	22. The mountable case for a handheld electronic device of claim 17, wherein the at least one magnet is configured to attach the mountable case to a magnetic structure.
Claim 23:	
[23]	23. The mountable case for a handheld electronic device of claim 17, wherein the rear wall and the perimeter wall are integrally formed as a unitary structure.
Claim 24:	
[24]	24. The mountable case for a handheld electronic device of claim 17, wherein an exterior surface of the rear wall comprises a first exterior surface portion and a second exterior surface portion offset from one another in a thickness direction of the rear wall.
Claim 25:	
[25pre]	25. A mountable case for a handheld electronic device, comprising:
[25b]	a body portion configured to retain the handheld electronic device within an interior space of the body portion,
[25c]	the body portion comprising: a rear wall defining an interior surface, an exterior surface, an interior plane at an interior-most surface portion of the interior surface of the rear wall, and an exterior plane at an exterior-most surface portion of the exterior surface of the rear wall; a perimeter wall;
[25d]	wherein the rear wall is configured to be aligned with at least a portion of a rear surface of the handheld electronic device, wherein the perimeter wall extends from a perimeter of the rear wall and is positioned proximate to at least portions of side surfaces of the handheld electronic device, and
[25e]	wherein the rear wall comprises an interior surface configured to face towards the rear surface of the handheld electronic device;
[25f]	at least one magnet having a first face and a second face, wherein the at least one magnet defines an outer periphery that extends in a thickness direction of the at least one magnet between the first face and the second face;
[25g]	an exterior-facing component having at least a portion thereof removably received in a receiving space defined by the rear wall of the body portion;
[25h]	wherein, with the exterior-facing component received in the receiving space, the at least one magnet is positioned between the interior plane and the exterior plane,

[25i]	the first face of the at least one magnet faces the interior space of the body portion, and the second face of the at least one magnet faces the exterior-facing component;
[25j]	wherein with the exterior-facing component received in the receiving space, the exterior-facing component extends along the second face of the at least one magnet.
Claim 26:	
[26]	26. The mountable case for a handheld electronic device of claim 25, wherein the receiving space is defined at least in part by a recessed surface of the rear wall.
Claim 27:	
[27]	27. The mountable case for a handheld electronic device of claim 26, wherein at least a portion of the recessed surface faces away from the interior space of the body portion.
Claim 28:	
[28]	28. The mountable case for a handheld electronic device of claim 25, wherein an exterior surface of the exterior-facing component is offset outwardly from an exterior surface of the rear wall, such that the exterior-facing component extends beyond the exterior surface of the rear wall.
Claim 29:	
[29]	29. The mountable case for a handheld electronic device of claim 25, wherein an exterior surface of the exterior-facing component and at least a portion of an exterior surface of the rear wall are offset from one another in a thickness direction of the rear wall.
Claim 30:	
[30]	30. The mountable case for a handheld electronic device of claim 25, wherein the outer periphery of the at least one magnet defines a shape that is different than a shape defined by an outer periphery of the exterior-facing component.
Claim 31:	
[31]	31. The mountable case for a handheld electronic device of claim 25, wherein the at least one magnet is configured to attach the mountable case to a magnetic structure.
Claim 32:	
[32]	32. The mountable case for a handheld electronic device of claim 25, wherein the exterior-facing component and the receiving space have complementary shapes.
Claim 33:	

[33]	33. The mountable case for a handheld electronic device of claim 25, wherein the exterior-facing component covers an entirety of the second face of the at least one magnet.
Claim 34:	
[34]	34. The mountable case for a handheld electronic device of claim 25, wherein at least one intervening layer is disposed between the first face of the at least one magnet and the interior space of the body portion.
Claim 35:	
[35]	35. The mountable case for a handheld electronic device of claim 25, wherein the rear wall and the perimeter wall are integrally formed as a unitary structure.
Claim 36:	
[36]	36. The mountable case for a handheld electronic device of claim 25, wherein the exterior-facing component directly contacts the second face of the at least one magnet without an intervening layer.
Claim 37:	
[37]	37. The mountable case for a handheld electronic device of claim 25, wherein an exterior surface of the rear wall comprises a first exterior surface portion and a second exterior surface portion offset from one another in a thickness direction of the rear wall.
Claim 38:	
[38]	38. The mountable case for a handheld electronic device of claim 25, further comprising a beveled surface that defines a transition between an exterior surface of the perimeter wall and an exterior surface of the rear wall.
Claim 39:	
[39]	39. The mountable case for a handheld electronic device of claim 25, wherein the exterior-facing component comprises a groove.

Table Of Abbreviations

Parties

Petitioners	Shenzhen Torras Technology Co., Ltd.; Shenzhen Lechuang Tiancheng Technology Co., Ltd.; Shenzhen Ruixin Digital Technology Co, Ltd.; and Shanghai Kuke Network Technology Co., Ltd.
Patent Owner, Rokform	Rokform IP LLC
US PTO	United States Patent & Trademark Office

Citations

MPEP	Manual of Patent Examining Procedure
------	--------------------------------------

Terms

'835 Patent	United States Patent No. 12,656,835
Rothbaum857	U.S. Pub. No. 2011/0192857 to Rothbaum et al.
Rothbaum609	U.S. Pub. No. 2011/0252609 to Rothbaum et al.
Byun	Korea Pub. No. KR101020434B1 to Byun et al.
Board, PTAB	Patent Trial and Appeal Board
POSITA	person of ordinary skill in the art

I. INTRODUCTION

Petitioners submit this Petition for Inter Partes Review of claims 1–39 (“the Challenged Claims”) of U.S. Patent No. 12,656,835 (“the ’835 Patent”).

Petitioners respectfully submit that the Challenged Claims of the ’835 Patent are unpatentable under 35 U.S.C. §103 in view of the prior art discussed herein and respectfully requests that the Board institute an inter partes review (IPR) of the ’835 Patent.

II. MANDATORY NOTICES

A. Real Parties in Interest.

The real parties in interest for this Petition are: Shenzhen Lanhe Technologies Co., Ltd., Shenzhen Torras Technology Co., Ltd., Shenzhen Lechuang Tiancheng Technology Co., Ltd., Shenzhen Ruixin Digital Technology Co, Ltd., Shanghai Kuke Network Technology Co., Ltd, Casekoo Inc., Torras Inc., Shenzhen Explore with Curiosity Technology Co., Ltd., Shenzhen Lanhe Investment Co., Ltd., Shenzhen Lantian Management Consulting Partnership (Limited Partnership), Lechuang Tiancheng Inc., Shenzhen Lechuang Future Technology Co., Ltd., Shenzhen Ansi Small Household Appliances Co., Ltd., and Shenzhen Chengyue Technology Co., Ltd.

B. Related Matters.

Both the ’835 Patent and another patent in the same family (*i.e.*, U.S. Patent No. 11,775,019 (“the 019 patent”)) are currently involved in the following

actions:

Rokform LLC, et al v. Shenzhen Torras Technology Co., Ltd. et al, Civil Action Nos. 2:26-cv-00052-JRG (lead case), 2:26-cv-00050-JRG, filed January 22, 2026.

An IPR was filed against the '019 patent on October 2, 2026. A Petition for Post Grant Review against the '835 patent will be filed concurrently on the same day as this IPR against the '835 patent.

C. Lead and Backup Counsel and Service Information.

Lead Counsel	Backup Counsel
Dr. Gregory J. Gonsalves Reg. No. 43,639 Law Office of Dr. Gregory J. Gonsalves 2216 Beacon Lane Falls Church, VA 22043 (571) 419-7252 gregoryjosephgonsalves@gmail.com	Dr. Yue Matthew Ma Reg. No. 60,925 Princeton IP Law LLC 100 Overlook Center, 2nd Floor Princeton, NJ 08540 matthew.ma@princetoniplaw.com

Petitioners consent to electronic service at the email addresses shown above.

III. REQUIREMENTS FOR INTER PARTES REVIEW.

A. Grounds For Standing.

Petitioners certify that the '835 Patent is available for inter partes review even though it recently issued because it is a transition patent, claiming priority to a chain of patent applications including U.S. Non-provisional patent application no. 13/593,220 (filed Aug. 23, 2012), Provisional application No. 61/653,618,

filed on May 31, 2012, and Provisional application No. 61/585,933, filed on Jan. 12, 2012.¹ EX1001, cover.

Petitioners are not barred or estopped from requesting an inter partes review challenging the claims on the identified grounds herein. Petitioners have not filed a civil action challenging the validity of a claim of the '835 Patent. This petition is being filed no more than one year after the date on which Petitioners were served with a complaint alleging infringement of the '835 Patent.

B. Identification Of Challenged Claims, The Prior Art And Statutory Grounds On Which The Challenge Is Based

Petitioners contend that claims 1–39 of '835 Patent are unpatentable over the following publications that are prior art to the '835 patent:

EX1004: U.S. Pub. No. 2011/0192857 to Rothbaum et al. (“Rothbaum857”), which was published on August 11, 2011, and is the publication of an application filed on January 13, 2011.

EX1005: U.S. Pub. No. 2011/0252609 to Rothbaum et al. (“Rothbaum609”), which was published on October 20, 2011, and is the publication of an application filed on October 20, 2010.

EX1007: Korea Pub. No. KR101020434B1 to Byun et al. (“Byun”), which was published on March 9, 2011. English translation:

EX1006.

¹ The priority date of many claims are at issue in Petitioners’ invalidity challenges to the '835 patent. See Petitioners’ Ranking Paper. IPR eligibility hinges on the validity of this priority claim. If all claims of the '835 Patent are entitled to this priority claim, the '835 Patent is available for IPR.

In particular, Petitioners contend that claims 1–39 of the '835 patent are unpatentable on the following grounds.

No.	Grounds
1	Claims 1–39 are obvious under 35 U.S.C. § 103 over Rothbaum857
2	Claims 1, 7, 19, 20, 22, and 31 are obvious under 35 U.S.C. § 103 over Rothbaum857 in view of Byun.
3	Claims 6, 12, and 36 are obvious under U.S.C. § 103 over Rothbaum857 in view of Rothbaum609

C. Priority Date and Prior Art

The earliest priority claim of the '835 Patent is January 12, 2013. EX1001, cover. Each of the applied references was published prior to that date and therefore, is prior art regardless of whether the '835 Patent is entitled to its earliest claimed priority. Each of Rothbaum857, Rothbaum609, and Byun is prior art under Pre-AIA 102, or AIA 102(a).

IV. OVERVIEW OF THE '835 PATENT AND ITS PROSECUTION HISTORY.

A. Specification.

The '835 patent is directed at a protective case for a handheld electronic device. Figure 1 of the '835 patent shows an exemplary embodiment.

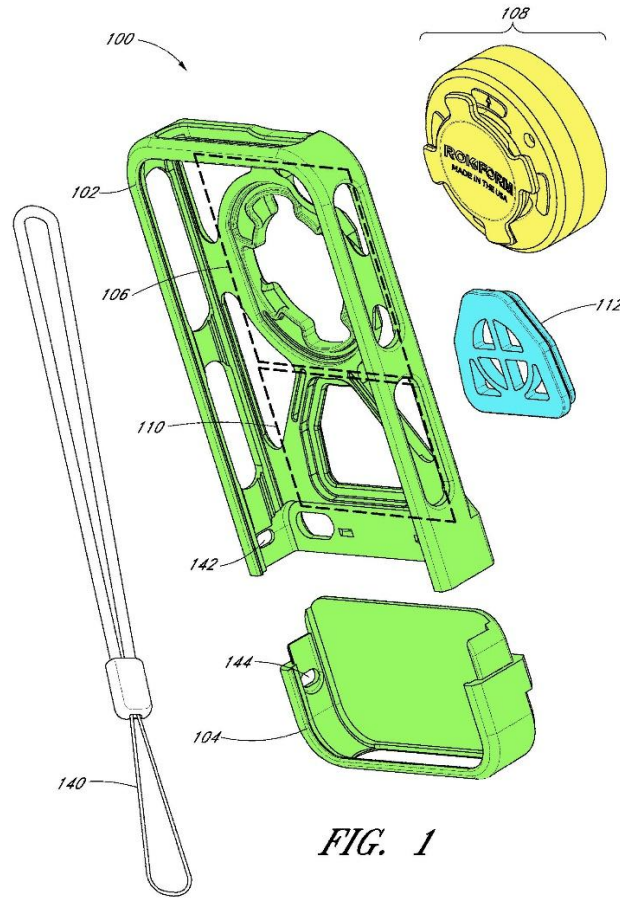


FIG. 1

EX1001, Fig. 1.²

As shown in Figure 1, a protection system 100 includes a body (green) composed of an upper shell piece 102 and a lower shell piece 104. EX1001, 5:1-4. Upper shell piece 102 includes an attachment region 106 that allows for the engagement of mounting member 108 (yellow). *Id.*, 5:20-25. Protection system 100 also includes a non-slip region 110, into which non-slip member 112 (blue) may be inserted. *Id.*, 5:31-39.

² All coloring and annotations added in the figures unless otherwise noted. The figures are meant to depict and identify particular components of structures in the prior art references corresponding to certain claim limitations, and therefore, may not include all possible components in those structures.

B. The Prosecution History.

None of the prior art forming the basis for Petitioners' proposed grounds of unpatentability were considered during the prosecution of the application that ultimately issued as the '835 patent. *See* EX1001, cover.

Rokform presented claims 39–82 in a preliminary amendment prior to examination. EX1002, 97-107, 143-151. In the first non-final Office Action dated March 5, 2026, the Examiner rejected claims 63–67 under 35 U.S.C. § 112, and allowed claims 39–62 and 68–82. *Id.*, 58-62. In response, Rokform canceled claims 63–67. *Id.*, 43-54. Subsequently, the Examiner issued a Notice of Allowance, and claims 39–62 and 68–82 proceeded to issue as claims 1–39. *Id.*, 10-14.

C. Level Of Ordinary Skill In The Art.

“[A] person of ordinary skill in the art (“POSITA”) at the time of the alleged invention of the '835 patent would have had a bachelor's level degree in Mechanical Engineering, Industrial Design, or a similar field. Additional work or research experience can substitute for less or different education, and vice-versa.” EX1003, ¶38. Petitioners' expert, Dr. Randall King, concludes that this is the appropriate level of ordinary skill in the art after considering the '835 patent, its prosecution history, and the cited references. *Id.* Dr. King bases this conclusion

upon his knowledge of the field and after properly setting forth the factors that inform this inquiry. *Id.*, ¶¶38-40.

D. Claim Construction For The '835 Patent.

Pursuant to 37 C.F.R. § 42.104(b)(3), Petitioners propose a single claim construction issue: Each of the preambles of claims 1, 7, 17, and 25 is not limiting.

Each of these preambles is not limiting; each instead merely sets forth an intended use for the apparatus that is fully recited in the body of the claim. A claim preamble is limiting only if it is necessary to “give life, meaning, and vitality” to the claim. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999); *see Georgetown Rail Equip. Co. v. Holland L.P.*, 867 F.3d 1229, 1236 (Fed. Cir. 2017) (identifying characteristics that make a preamble limiting).

Here, each preamble does not recite any characteristics that would make it limiting. Each does not recite essential structure; the only antecedent basis provided by each preamble is a “handheld electronic device,” that is not part of the claimed invention; each preamble is not essential to understand any limitations in the body of the claim; and each preamble was not relied upon during prosecution.

Rather, each of the bodies of claims 1, 7, 17, and 25 is structurally complete and each preamble states only a purpose or intended use of the

invention. In such circumstances, the preamble is not limiting. *Arctic Cat Inc. v. GEP Power Products, Inc.*, 919 F.3d 1320, 1328 (Fed. Cir. 2019).

For all terms in the bodies of the Challenged Claims, Petitioners propose that the terms be afforded their “ordinary and customary meaning” under the claim construction standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2015) (en banc).

V. OVERVIEW OF THE GROUNDS OF REJECTION.

Claims 1–39 of the ‘835 patent are unpatentable in view of one or more of the grounds identified above in Section III. Individually and/or combined, the references cited in these grounds disclose “a mountable case for a handheld electronic device” having an “exterior-facing component” that is attachable to the “rear wall” of the case and has a “magnet” for “mounting the case to a magnetic structure.” EX1003, §§IX-XI.

Rothbaum857 discloses a mountable case for a handheld electronic device having an exterior-facing component attachable to the rear wall of the case and configured to mount the case to a structure. EX1003, §IX.

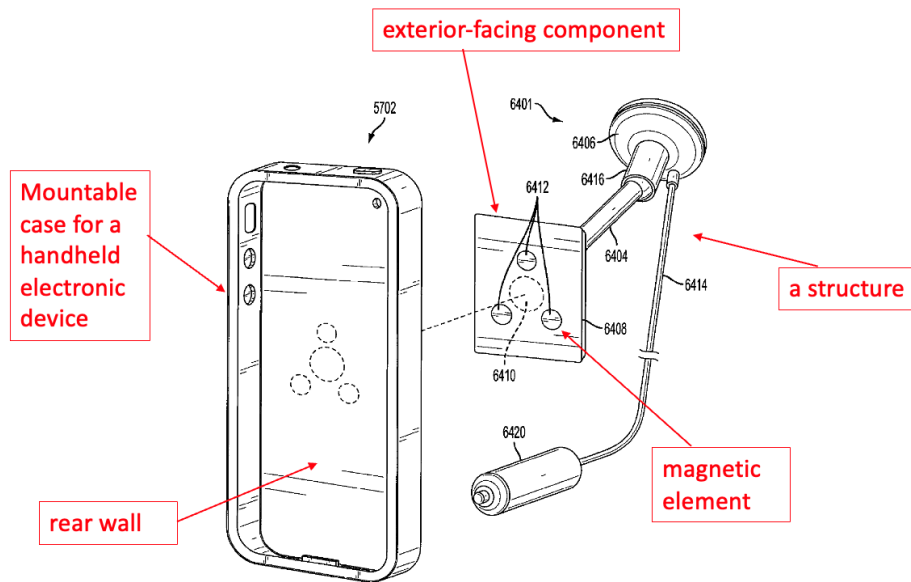


FIG. 64A

EX1004, Fig. 64A.

Likewise, Rothbaum609 discloses a mountable case for a handheld electronic device having an exterior-facing component attachable to the rear wall of the case. EX1003, §XI.

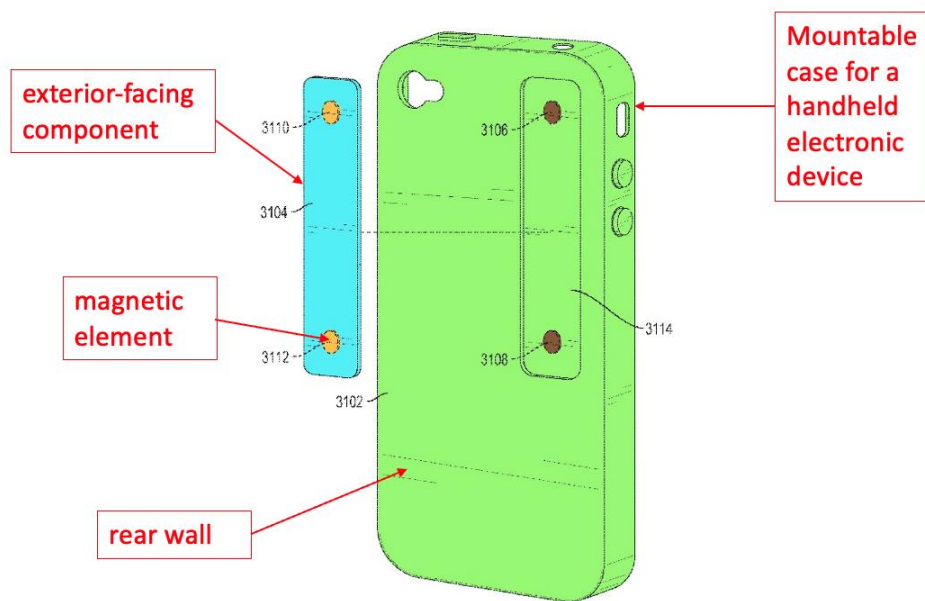
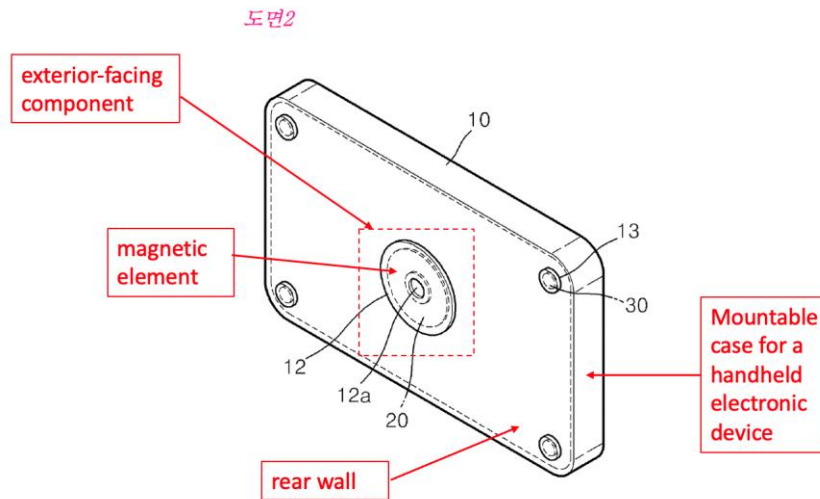


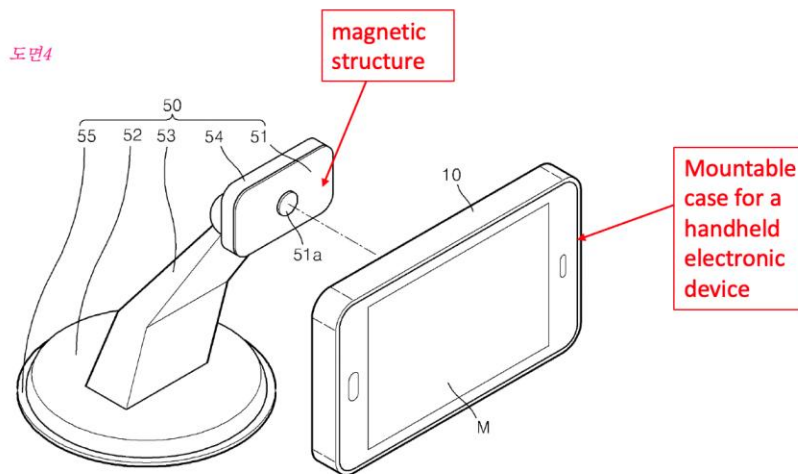
FIG. 31A

EX1006, Fig. 31A.

Byun discloses a mountable case for a handheld electronic device having an exterior-facing component attached to the rear wall of the case, where the exterior-facing component has a magnetic element configured to mount the case to a magnetic structure. EX1003, §X.



EX1005, Fig. 2.



Byun Figures. 2 and 4

EX1005, Fig. 4.

VI. CLAIMS 1–39 OF THE '835 PATENT ARE UNPATENTABLE.

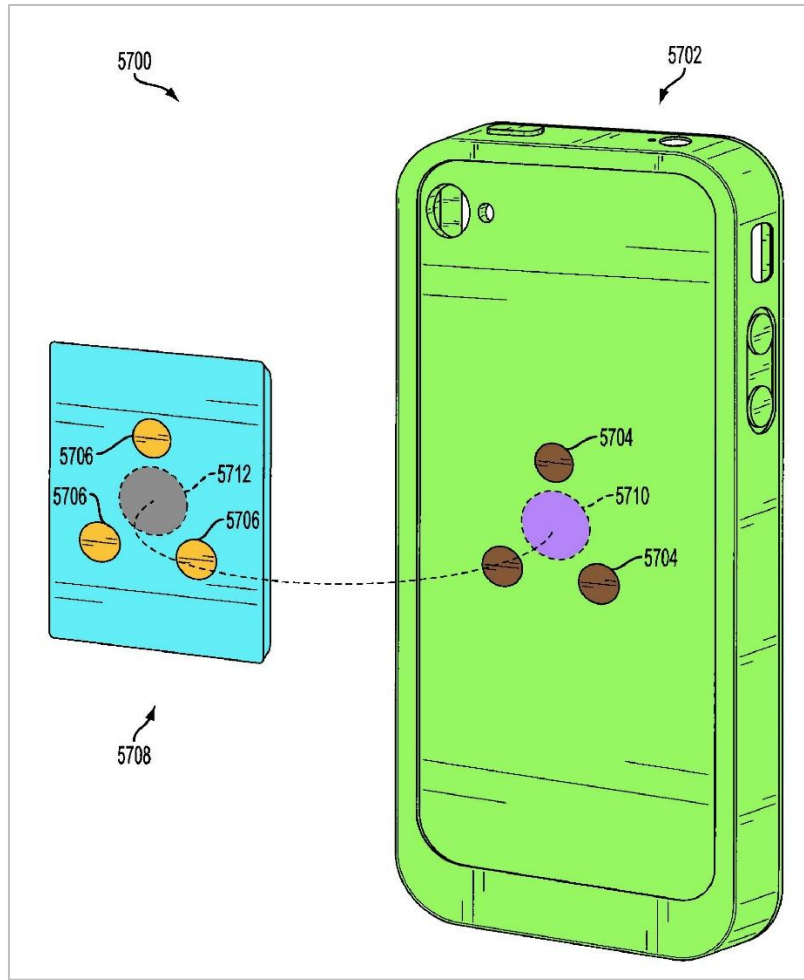
A. Ground 1: Claims 1–39 are unpatentable as obvious under 35 U.S.C. § 103 over Rothbaum857.

1. Overview Of Rothbaum857.

Rothbaum857 is directed at a “mobile electronic device accessory system.”

EX1004, Abstract. Rothbaum857 observed that many people use handheld electronic devices and carry them frequently. EX1004, ¶[0004]. Further, Rothbaum857 observed that people also carry accessories such as wallets, flashlights, and notepads. *Id.* According to Rothbaum857, “[a]s the number of accessories that a person carries increases, the more difficult it becomes to find a convenient carrying place for each item” and “when a user carries multiple individual accessories, there is a greater likelihood that they will lose or misplace one of the items.” *Id.* Rothbaum857 proposed a solution of a system whereby a user of handheld electronic devices could removably attach accessories to a case for that electronic device. *Id.*

One such embodiment is shown in Figure 57 of Rothbaum857.



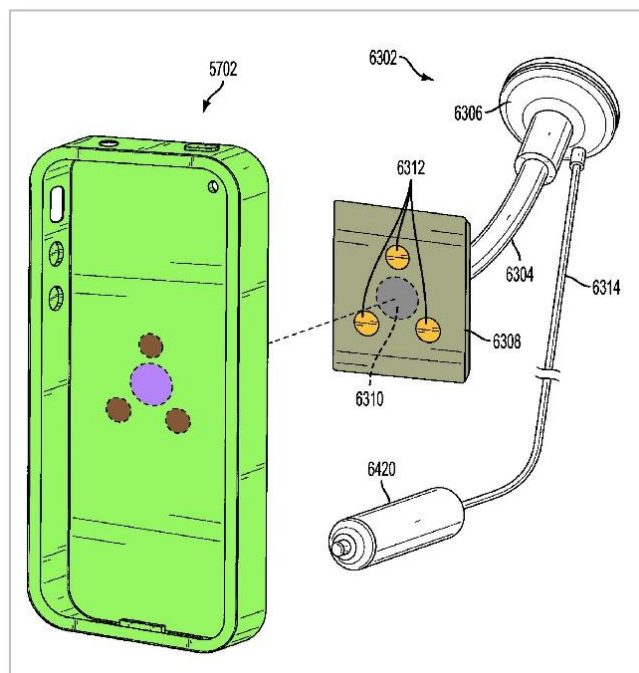
EX1004, Fig. 57.

As shown above, case 5702 (green) includes a set of magnetic attachment elements 5704 (brown). EX1004, ¶[0248]. These aspects permit an accessory to be removably attached to the case 5702 (green). For example, object 5708 (blue)—which may be, for example, a charger, spare battery, or speaker—includes magnetic attachment elements 5706 (orange) and electrical interface 5712 (gray). *Id.* Through the connection of the corresponding magnetic

attachment elements, object 5708 (blue) may be removably attached to case 5702 (green).

Separately, Rothbaum857 observed that many interactive features are being included on mobile electronic devices such as GPS navigation programs. *Id.*, ¶[0006]. Rothbaum857 saw an opportunity to address this issue in conjunction with providing a means of securing accessories to a case: “[t]he same systems and methods that allow a user to removably attach an accessory (such as a notebook or a flashlight) to a mobile electronic device case could be adapted to create accessories that mount or support mobile electronic device cases in convenient positions, locations, and orientations.” *Id.*

An example of such mount is depicted in Figure 63 of Rothbaum857.



EX1004, Fig. 63.

As shown above, a vehicle mount 6302 may include a case mounting head 6308 (olive) with magnetic attachment elements 6312 and electrical interface 6310 (gray). This arrangement is similar to that disclosed in connection with object 5708. Thus, the case 5702 (green) can both receive accessories such as object 5708 (blue) or be mounted to a vehicle mount by way of the magnetic attachment elements 5704 (brown) of the case.

2. Independent Claim 1

[1pre]: “[a] mountable case for a handheld electronic device.”

As discussed in Section IV.D, the preamble is not limiting and therefore should not be given any patentable weight.

Alternatively, Rothbaum⁸⁵⁷ discloses a handheld electronic device case, such as the one illustrated in Fig. 1A (reproduced below). EX1004, ¶[0138] (“The components of the system may include a case 102 for a mobile electronic device, where the case 102 has a surface 104 and a first attachment mechanism 106. The system may also include an accessory 108 with a second attachment mechanism 110. The accessory 108 can be removably connected with the surface 104 of the case 102.”). The case is configured to “fit over a mobile electronic device.” EX1004, ¶[0140].

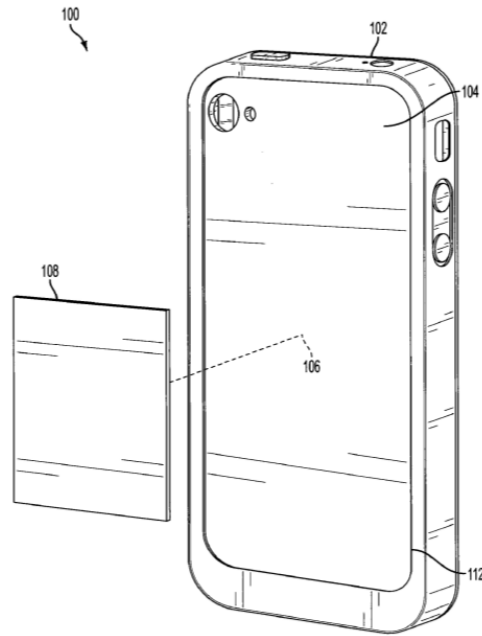
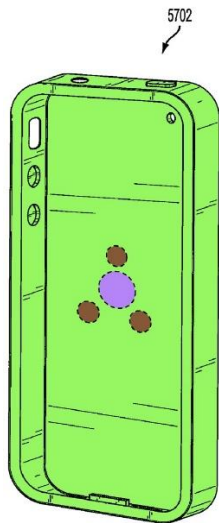


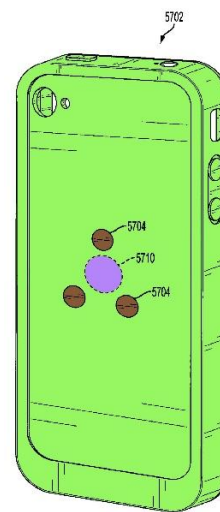
FIG. 1A

EX1004, FIG. 1A.

Another such handheld electronic device case 5702 is depicted in Figs. 64A and 57 reproduced below.



EX1004, Fig. 64A (partial)

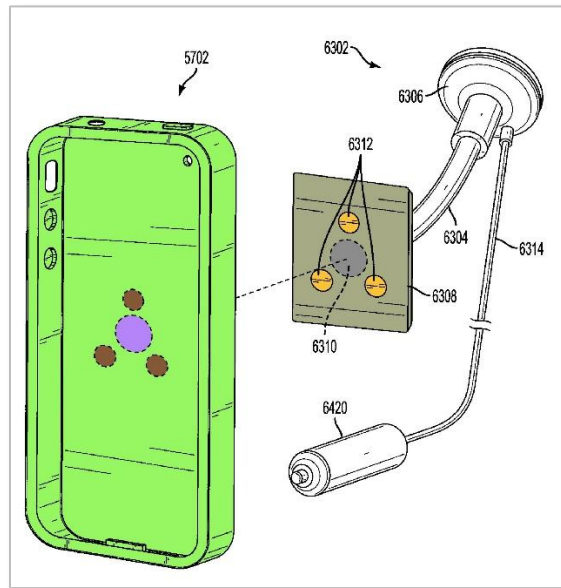


EX1004, Fig. 57 (partial)

Shown above left is a front view of case 5702 (green). Shown above right is a back view of case 5702. The back of case 5702 includes a first set of

magnetic attachment elements 5704 (brown). EX1004, ¶[0248]. Case 5702 also includes a first electrical interface 5710 (purple). *Id.*

Case 5702 is “mountable.” As shown below, case 5702 (green) is configured to be mounted to vehicle mount 6302.



EX1004, Fig. 63.

This is accomplished by a second set of magnetic attachment elements 6312 (orange) and a second electrical interface 6310 (gray). EX1004, ¶[0267]. “These connect with the corresponding components of case 5702 (green), specifically first set of magnetic components 5704 (brown) and first electrical interface 5710 (purple), respectively.” EX1003, ¶56.

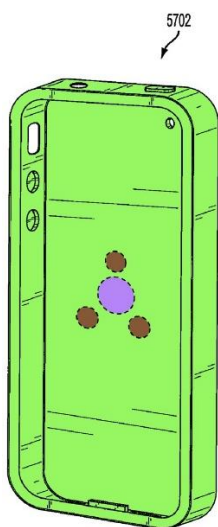
Case 5702 is also “for a handheld electronic device.” Rothbaum⁸⁵⁷ identifies case 5702 as a “mobile electronic device case.” EX1004, ¶[0259]. “Further, a POSITA would have understood that case 5702 is structurally similar

to case 102 of Rothbaum857, which is described to ‘fit over a mobile electronic device.’” EX1003, ¶57, *quoting* EX1004, ¶[0140]. “A POSITA would have understood that the ‘mobile electronic device’ referenced in Rothbaum857 is able to be held by a user’s hand, i.e., is ‘handheld.’” *Id.*

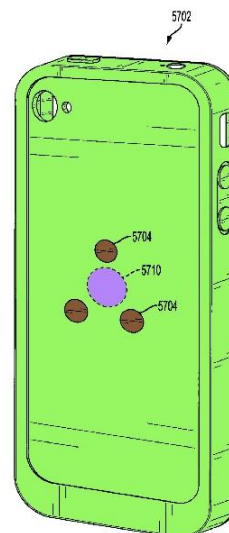
Accordingly, Rothbaum857 would have taught “[a] mountable case [mobile electronic device case 5702] for a handheld electronic device.” *Id.*, ¶58.

[1b]: “a body portion configured to retain the handheld electronic device within an interior space of the body portion”

As shown in FIGS. 64 and 57 of Rothbaum857 below, case 5702 includes a shell as the body portion of the case.

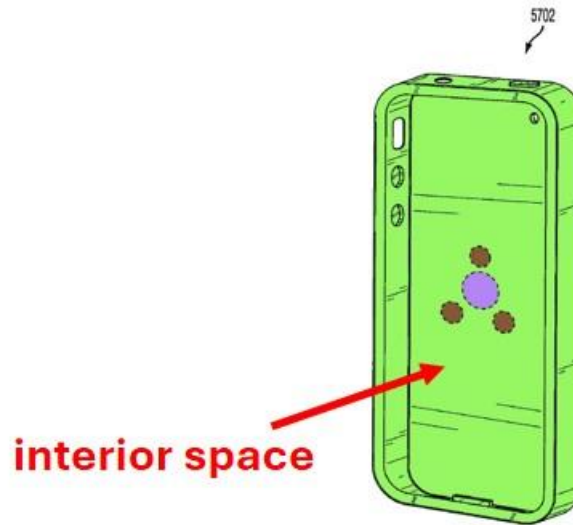


EX1004, Fig. 64A (partial)



EX1004, Fig. 57 (partial)

Case 5702 includes an interior space in the body portion that retains the handheld electronic device. This is illustrated below.

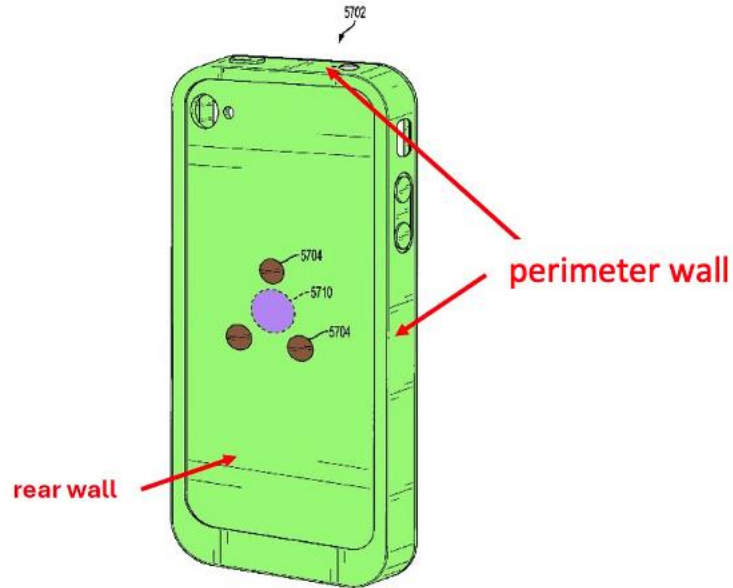


EX1004, Fig. 63 (partial).

“[A] POSITA would have understood that what is labeled ‘interior space’ in the annotated figure above is the location where the mobile electronic device is retained.” EX1003, ¶60. “Further, the discussion in Rothbaum857 regarding the case being configured to ‘fit over’ a mobile electronic device, EX1004, ¶[0140] means that the electronic device is retained within an interior space of the case.”

Id.

[1c]: “the body portion comprising: a rear wall; a perimeter wall”

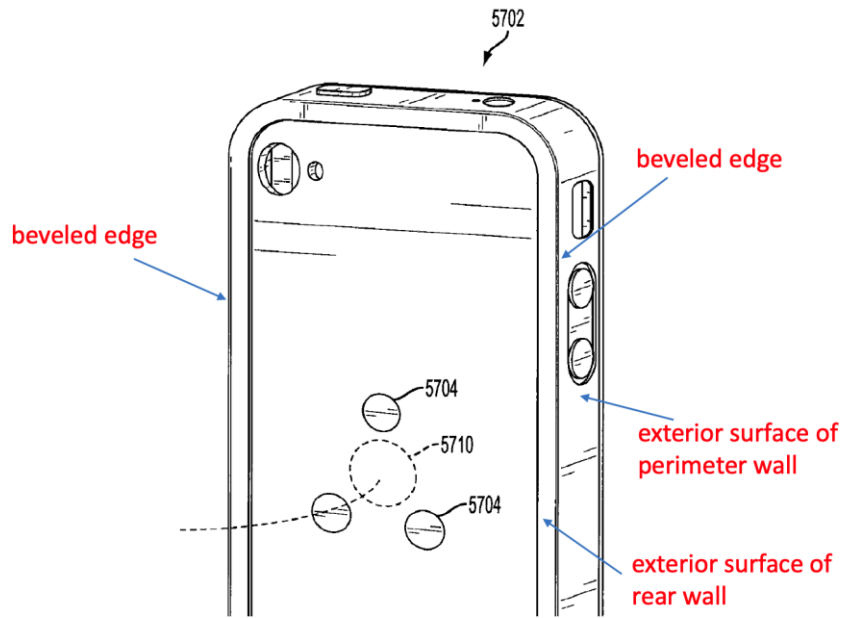


EX1004, Fig. 57 (partial).

“As depicted in the annotated figure above, Rothbaum857 discloses that case 5702 includes a ‘back,’ which corresponds to the ‘rear wall’ of the claim.” EX1003, ¶62, *citing* EX1004, ¶[0248]. “Further, Rothbaum857 discloses that all surfaces of a mobile electronic device except for the front are covered by the case.” *Id.* Specifically, Rothbaum857 discloses that “[i]n some embodiments, the case at least partially surrounds 5 sides of a mobile electronic device. In some embodiments, only a front screen surface of a mobile electronic device is substantially un-covered by the case.” EX1004, ¶[0151]. “By disclosing that only the front screen surface is uncovered, Rothbaum857 discloses that the ‘5 sides’ of the device that are covered by the case are (1) the rear wall, (2) the perimeter wall including four sides.” EX1003, ¶62.

[1d]: “a beveled surface that defines a transition between an exterior surface of the perimeter wall and an exterior surface of the rear wall”

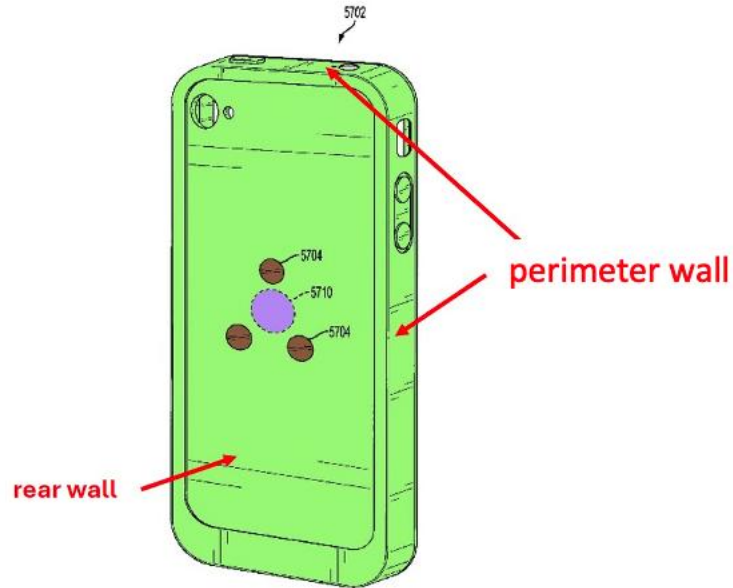
“FIG. 57 of Rothbaum857 discloses a beveled surface. A POSITA, viewing FIG. 57 (reproduced below) in the context of the associated text in the specification, would have understood that the top surface of the case 5702 is in a first horizontal plane and an upper boundary of the rear wall is in a second horizontal plane substantially parallel to and below the first horizontal plane. Because the top surface of the case 5702 is shown as being above the upper boundary of the rear wall in FIG. 57, a POSITA would have understood that the surface extending from the top surface of the perimeter wall of the case 5702 to the upper boundary of the rear wall is beveled.” EX1003, ¶63. Moreover, even if Rothbaum857 were found not to expressly show a beveled edge, employing a beveled edge at the transition between the perimeter wall and the rear wall of a case for a handheld electronic device would be an obvious modification. A POSITA would have understood that creating beveled rather than rigid edges is a matter of design choice, and is common in the industry as it can help prevent injury that a consumer may experience from handling a mobile phone case with sharp, straight edges.” *Id.*



EX1004, Fig. 57 (partial).

[1e]: “wherein the rear wall is configured to be aligned with at least a portion of a rear surface of the handheld electronic device, and wherein the perimeter wall extends from an outer perimeter of the rear wall and is positioned proximate to at least portions of side surfaces of the handheld electronic device”

As shown in the annotated FIG. 57 (below), Rothbaum857 discloses the
“the perimeter wall [of the case 5702] extends from an outer perimeter of the rear wall.”



EX1004, Fig. 57 (partial).

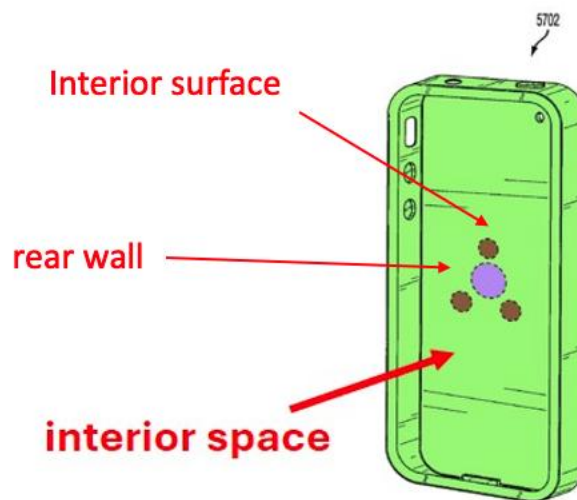
Rothbaum857 further discloses that “[a] case as used and described herein can be configured to hold a mobile electronic device in many different configurations. In some embodiments, the case at least partially surrounds 5 sides of a mobile electronic device. In some embodiments, only a front screen surface of a mobile electronic device is substantially un-covered by the case.” EX1004, ¶[0151].

“In the configuration described in Rothbaum857, a POSITA would have understood that, when the handheld electronic device is held in the case with only the front screen un-covered by the case, both the sides and rear surface of the handheld electronic device are enclosed by the case, resulting in ‘*the rear wall is ... aligned with a rear surface of the handheld electronic device*’ and ‘*the*

perimeter wall ... is positioned proximate to at least portions of side surfaces of the handheld electronic device.” EX1003, ¶67 (*emphasis in original*).

[1f]: “wherein the rear wall comprises an interior surface configured to face towards the rear surface of the handheld electronic device”

“As shown in the annotated Fig. 63 (reproduced below), Rothbaum857 discloses that the rear wall of the case includes an interior surface to receive the handheld electronic device.” EX1003, ¶68.

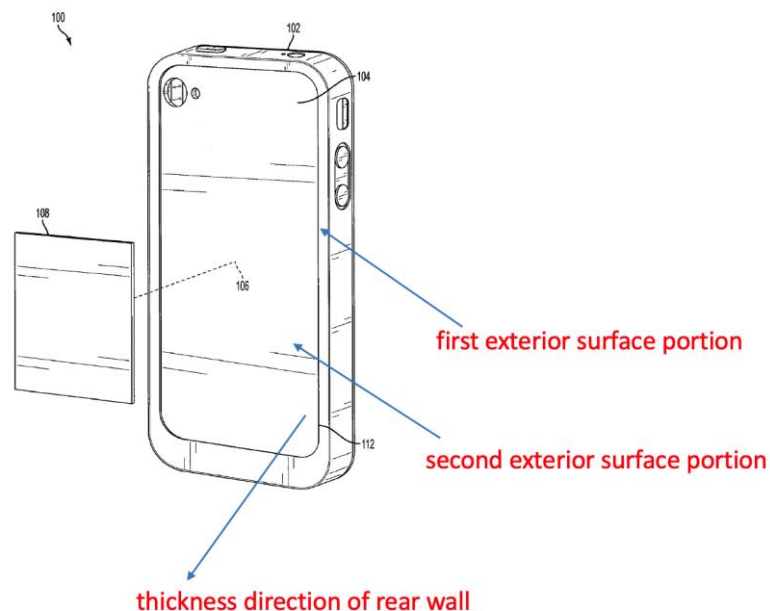


EX1004, Fig. 63 (partial).

“A POSITA would have understood that when the handheld electronic device is enclosed in the case, the ‘*interior surfaces face[s] [to the opening of the case] towards the rear surface of the handheld electronic device.*’” EX1003, ¶69 (*emphasis in original*).

[1g]: “wherein the exterior surface of the rear wall comprises a first exterior surface portion and a second exterior surface portion offset from one another in a thickness direction of the rear wall”

Rothbaum857 discloses a raised edge that forms a recess in the rear wall of the case, where the rear wall is divided into two surface portions. For example, Rothbaum857 discloses “[i]n some embodiments, the accessory 108 is used with a mobile electronic device case where the back surface 104 of the case has a **recessed** portion defined by a shoulder or raised edge 112. As shown in FIG. 1, the main portion of the back surface 104 of the case 102 is recessed with respect to the raised edge 112.” EX1004, ¶[0141]; *see* Fig. 1A reproduced below.



EX1004, Fig. 1A.

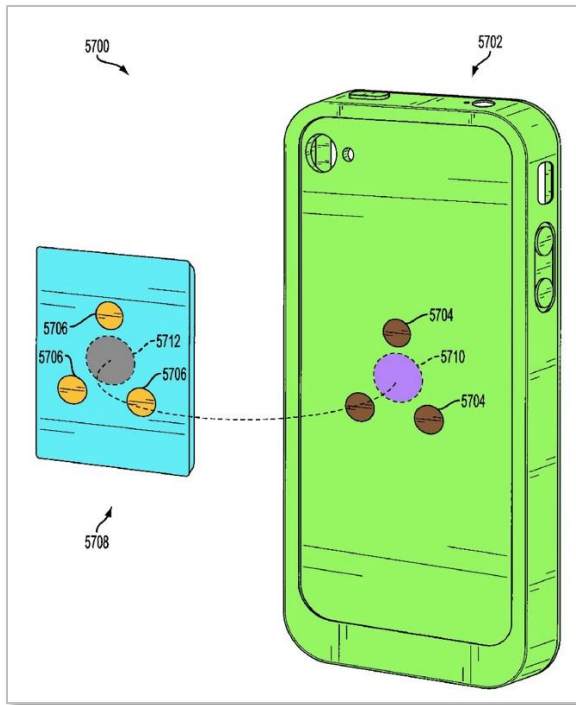
It is clear from the disclosure of Rothbaum857 that “the raised edge 112 divides the exterior surface into the first exterior surface portion and the second exterior surface portion and forms a recess in the back surface 104 of the case

102. A POSITA would also have understood that the raised edge is raised in the thickness direction of the rear wall. In other words, the back surface 104 and the raised edge ‘*offset from one another in the thickness direction of the rear wall.*’” EX1003, ¶71 (*emphasis in original*).

“Although the raised edge 112 and the recess in the back of the case are described with specific reference to Figures 1 and 2 of Rothbaum857, a POSTA would have understood that it was generally applicable to the other embodiments of Rothbaum857, including the embodiment depicted in Figure 57.” *Id.*, ¶72.

[1h]: “an exterior-facing component having at least a portion thereof removably received in a receiving space defined by the rear wall of the body portion”

Rothbaum857 includes multiple embodiments with components that qualify as an “exterior-facing member.” One such embodiment is that depicted in Figure 57 (reproduced below).



EX1004, Fig. 57.

“As shown above, object 5708 (blue) is configured to be attached to the exterior of case 5702 (green). This is accomplished through correspondence between the first set of magnetic attachment elements 5704 (brown) and a second set of magnetic attachment elements 5706 (orange).” EX1003, ¶74 (citing EX1004, ¶[0248].

“Object 5708 (blue) may be attached to the exterior of case 5702 and is thus ‘exterior-facing.’” EX1003, ¶75.

“Further, object 5708 (blue) is ‘removably received in a receiving space defined by the rear wall’ of case 5702 (green).” EX1003, ¶76. Rothbaum857 discloses that “[t]he magnetic attachment elements 5704 are configured to *removably* attach the case 5702 to a corresponding set of second magnetic

attachment elements 5706 attached to an object 5708 external to the case.”

EX1004, ¶[0248]. “Further, object 5708 (blue) may be a charger, spare battery, or speaker, for example.” EX1003, ¶77. See also EX1004, ¶¶[0250], [0259], [0262]. “A POSITA would have understood that such objects are not intended to be permanently affixed to case 5702 but instead to be removable and attached only as needed.” EX1003, ¶78.

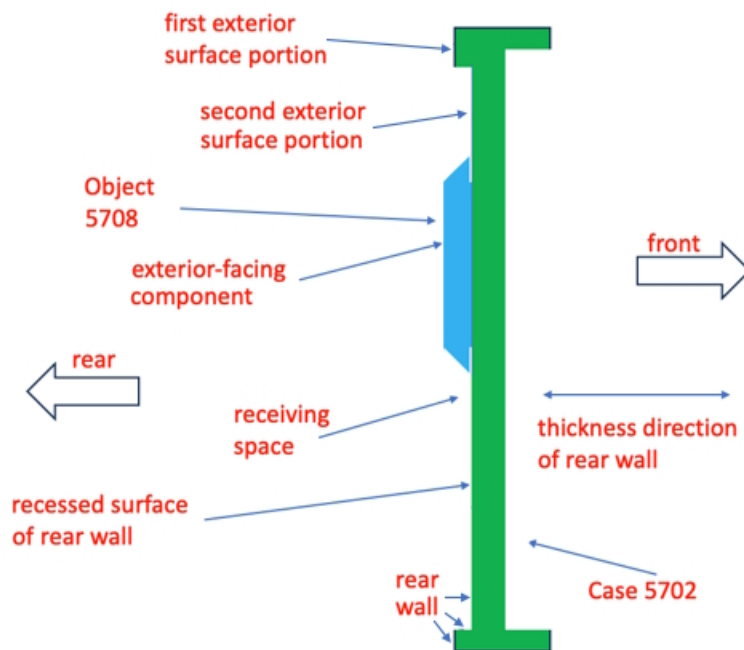
Rothbaum857 also states:

“In some embodiments, the accessory 108 is used with a mobile electronic device case where the back surface 104 of the case has a recessed portion defined by a shoulder or raised edge 112. As shown in FIG. 1, the main portion of the back surface 104 of the case 102 is recessed with respect to the raised edge 112. *In some embodiments, the accessory 108 is thinner than, or the same thickness as, the recess between the back surface 104 and the raised edge 112. Thus, when the accessory 108 is attached to the back surface 104 of the case 102, the accessory 108 does not protrude any further than the outer surfaces of the case 102.*

EX1004, ¶[0141].

“Although the foregoing discussions were provided with specific reference to Figures 1 and 2 of Rothbaum857, a POSITA would have understood that it was generally applicable to the other embodiments of Rothbaum857, including the embodiment depicted in Figure 57.” EX1003, ¶80.

To better illustrate the features disclosed in Fig. 57 of Rothbaum857, Dr. King provides a cross-section side view of the case 5702 for the handheld electronic device, as shown below. “It shows the rear wall of the case having a recessed surface created by the second exterior surface portion being offset from the first exterior surface portion in the thickness direction (that is, being recessed), as discussed above. The rear wall of the case thus consists of the first exterior surface portion, the second exterior surface portion (recessed surface) and the surface connecting these two portions, as shown.” EX1003, ¶81.



Cross-section side view of case 5702
(based on Rothbaum857, Fig. 57)

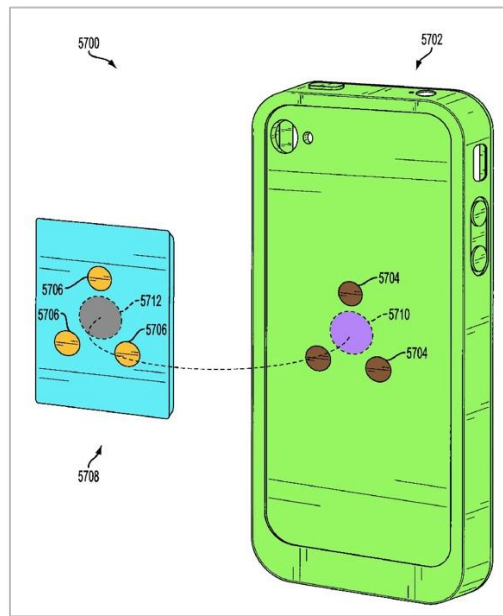
EX1003, ¶81.

Notably, while the above illustration depicts the exterior-facing component as being slightly thicker than the thickness of the recess, Rothbaum⁸⁵⁷ teaches that that exterior-facing component can be thinner, thicker or the same thickness as the recess between the back surface and the raised edge. EX1004, ¶[0141] (“[i]n some embodiments, the accessory 108 is thinner than, or the same thickness as, the recess between the back surface 104 and the raised edge 112. Thus, when the accessory 108 is attached to the back surface 104 of the case 102, the accessory 108 does not protrude any further than the outer surfaces of the case 102. In some embodiments, the accessory 108 is thicker than the recess. In some embodiments, the accessory 108 protrudes further than the outer surfaces of the case 102 by only half as much as the recess.”). In any of these instances, the exterior-facing component would have at least a portion thereof removably received in the recess.

“Rothbaum⁸⁵⁷ uses the space created by recessing the second exterior surface portion as a ‘receiving space defined by the rear wall of the body portion’ to ‘removably receive’ the exterior-facing component.” EX1003, ¶81. Thus, Rothbaum⁸⁵⁷ discloses “***an exterior-facing component [object 5708] having at least a portion thereof removably received in a receiving space defined by [the first exterior surface portion and the second exterior surface portion of] the rear wall of the body portion.***” *Id.*

[1i]: “the exterior-facing component having a cavity”

Object 5708 of Rothbaum857, which corresponds to the claimed “exterior-facing member,” is depicted below.



EX1004, Fig. 57.

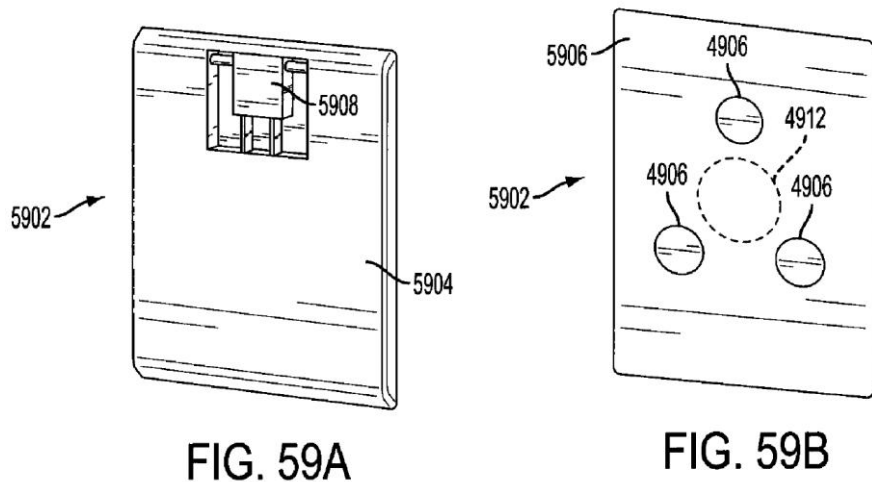
Rothbaum857 discloses that object 5708 includes “second *magnetic attachment elements 5706* attached to an object 5708 external to the case.”

EX1004, ¶[0248]. “A POSITA would have understood that ‘magnetic attachment elements 5706,’ are magnets having a thickness.” EX1003, ¶83. This is because Rothbaum857 discusses that “magnetic attachment elements” may be, for example, “cylindrical magnets,” “disc-shaped magnets,” “cuboid-shaped magnets, and the like.” EX1004, ¶[0144]; *see also id.*, ¶¶[0257]-[0258]

(discussing “magnets” as examples of “magnetic attachment elements” discussed in prior paragraphs).

“It is evident from the figures and detailed description of Rothbaum857 that object 5708 has cavities, each receiving a magnetic attachment elements 5706. As shown in Figure 57 (reproduced above), the top surfaces of the magnetic attachment elements 5706 are flush with the surface of the object 5708. Because the magnetic attachment elements have a thickness, a POSITA would have understood that object 5708 must include a cavity to receive the magnetic attachment elements 5706.” EX1003, ¶84. Also, Rothbaum857 discloses that “[t]he second set of magnetic attachment elements 5706 and the second electrical interface 5710 (described in detail above) are adjacent to the mounting surface 5906. In some embodiments, they are **inside the housing 5904**, and reside behind the mounting surface 5906.”

Rothbaum857, ¶[0251] and Figs. 59A–59B, reproduced below.



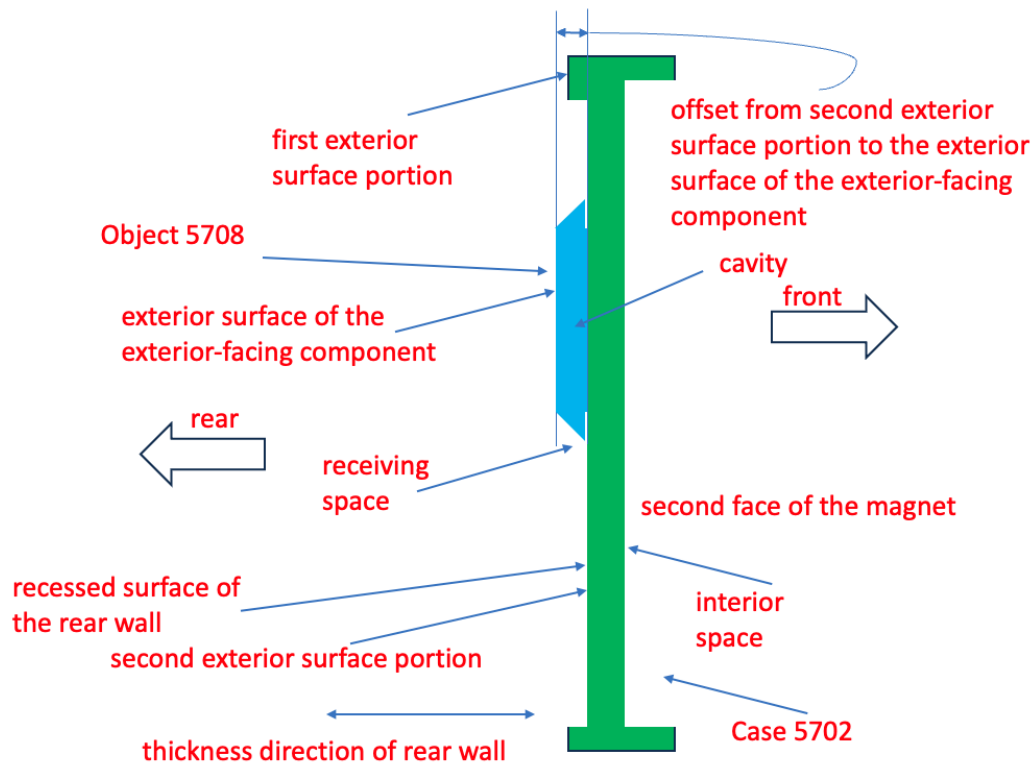
EX1004, Figs. 59A and 59B.

“A POSITA would have understood from this disclosure, especially when coupled with Figure 57 of Rothbaum857, that the magnetic attachment elements residing ‘behind the mounting surface’ means that they are disposed within the object 5708.” EX1003, ¶85.

Accordingly, Rothbaum857 discloses “*the exterior facing component [object 5708 in Fig. 57, object 5902 in Figs. 59A and 59B] having a cavity.*” Id., ¶86 (*emphasis in original*).

[1j]: “wherein an exterior surface of the exterior-facing component is offset from at least one of the first exterior surface portion and the second exterior surface portion”

As discussed above in Section [1h], “Rothbaum857 discloses a recess (cavity) in the rear wall of the case that results in the first exterior surface portion and the second exterior surface portion.” EX1003, ¶87. They are illustrated by Dr. King in a cross-section side view of the case 5702 based on Fig. 57 on Rothbaum857 (reproduced below).



Cross-section side view of case 5702
(based on Rothbaum857, Fig. 57)

EX1003, ¶87.

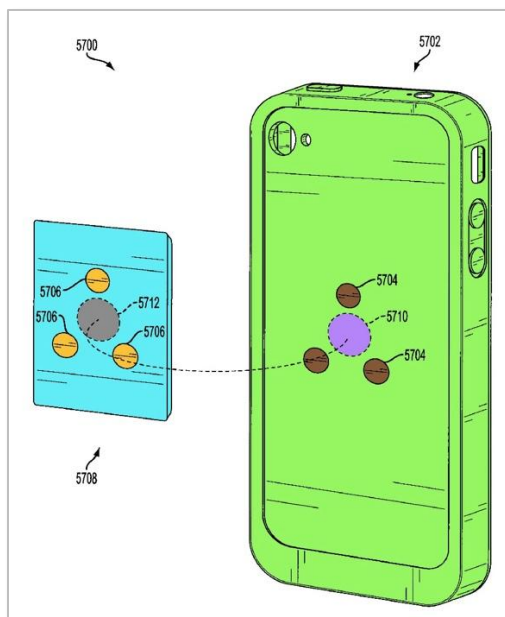
“As shown, because the object 5708 itself has a thickness, and when object 5708 attached to the recessed surface of the rear wall of the case, there is at least an ‘offset from the second exterior surface portion [recessed surface of the rear wall] to the exterior surface of the exterior-facing component [rear-most surface of the object 5708].” EX1003, ¶88.

[1k]: “wherein the receiving space is defined at least in part by a recessed surface of the rear wall, and wherein the recessed surface faces away from the interior space of the body portion”

As shown above in the preceding section in the cross-section side view of the case 5702 produced by Dr. King based on Fig. 57 of Rothbaum857 (EX1003, ¶87), “a recessed surface of the rear wall is coplanar with the second exterior surface portion that defines **the recess** (the *receiving space*). The interior space of the shell of the case is facing the front of the case, and the recessed surface of the rear wall is **facing** the rear of the case, **facing away** from the interior space of the body portion.” EX1013, ¶89.

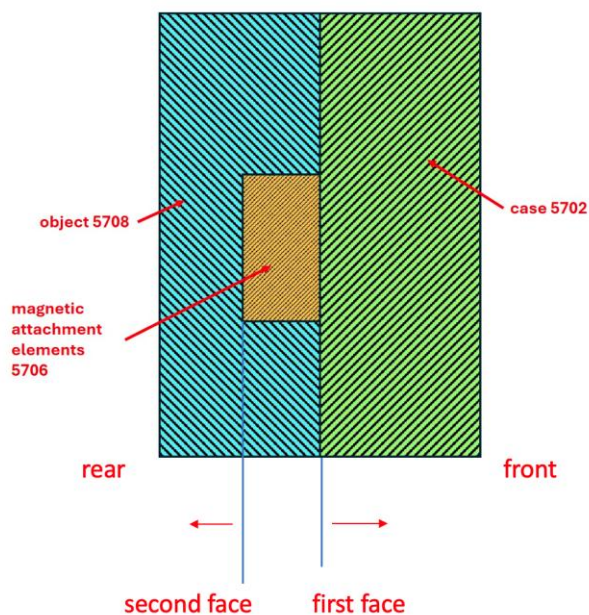
[1L]: “at least one magnet retained within the cavity, the at least one magnet having a first face and a second face, wherein, with the exterior-facing component received in the receiving space, the first face of the at least one magnet faces the interior space of the body portion and the second face of the at least one magnet faces the exterior-facing component”

In view of the discussion in Section [1i] above, “Rothbaum857 discloses an exterior-facing component (e.g., object 5708 shown in Fig. 57, reproduced below) having a cavity to retain a magnet (e.g., 5706). In other words, ‘*at least one magnet (magnet 5706) [is] retained within the cavity.*’” EX1003, ¶90.



EX1004, Fig. 57.

Dr. King provides an enlarged cross-section view of the case 5702 based on Fig. 57 of Rothbaum857 (shown below).



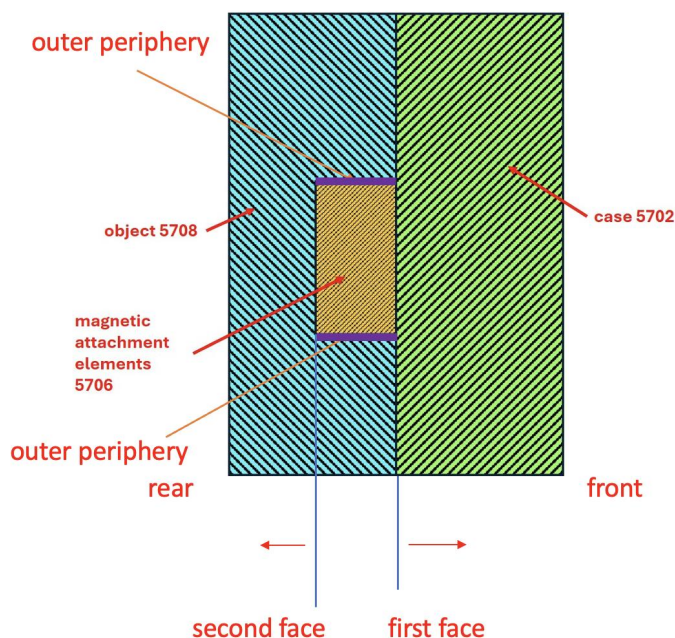
EX1003, ¶91.

When concurrently viewed in combination of the cross-section view of the case 5702 shown above in Section VI.A.2.j, “the presence of the claim limitations is clearly revealed. As shown, when object 5708 is received in the rear wall of case 5702, the first face of the magnet 5706 faces the front (interior space) of the case, and the second face of the magnet faces at least a portion of object 5708 in the rear. Accordingly, Rothbaum857 discloses ‘*the first face of the at least one magnet [5706] faces the interior space of the body portion and the second face of the at least one magnet faces the exterior-facing component.*’” EX1013, ¶92.

[1m]: “wherein the at least one magnet defines an outer periphery that extends in a thickness direction of the at least one magnet between the first face and the second face”

Rothbaum857 discloses that the magnet may include various shapes: “[i]n some embodiments, the magnets are solid magnets. In some embodiments, the magnets are selected from the group consisting of donut (ring) magnets, horseshoe-shaped (U-shaped) magnets, cylindrical magnets, disc-shaped magnets, cuboid-shaped magnets, and the like.” EX1004, ¶[0144]. “Thus, the magnetic attachment elements 5706 in Rothbaum857 would have a 3D shape (e.g., cylindrical magnets, disc-shaped magnets, cuboid-shaped magnets) that has a thickness between the first face and the second face, which accommodates an outer periphery extending in the thickness direction.” EX1003, ¶93.

Dr. King provided a further annotated cross-section view of the case 5702, based on Fig. 57 of Rothbaum857, as shown below.



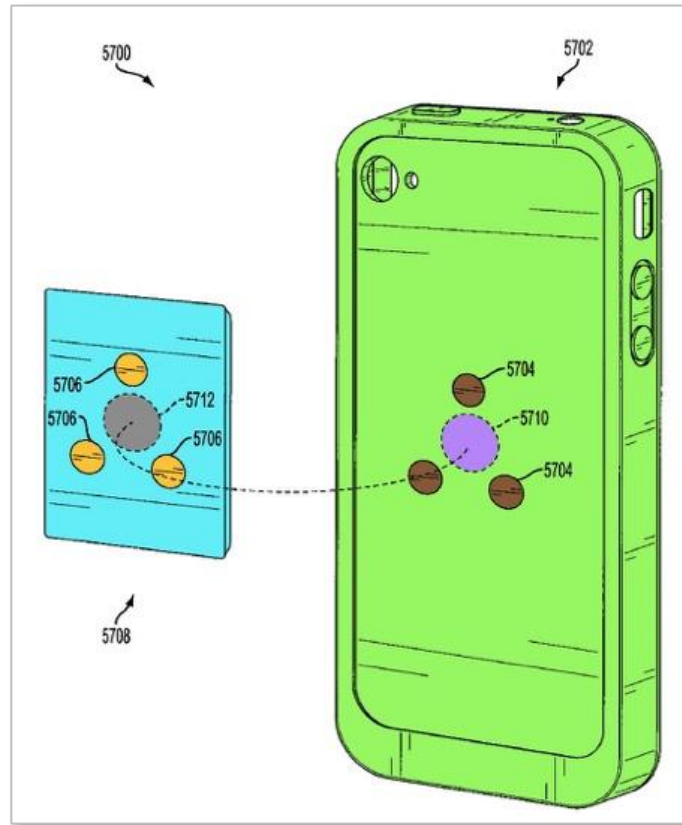
EX1003, ¶94.

Thus, a POSITA would have understood Rothbaum857 as disclosing a magnet having “an outer periphery (purple) that ‘*extends in a thickness direction of the at least one magnet between the first face and the second face.*’” EX1003, ¶95.

[1n]: “wherein the cavity of the exterior-facing component is formed at least in part by a curved outer wall, and wherein the outer periphery of the at least one magnet is adjacent to at least a portion of the curved outer wall”

As discussed in Section VI.A.2.m, “Rothbaum857 discloses that the magnet may include various shapes. Specifically, Figure 57 of Rothbaum857

(reproduced below) shows that at least one magnet (e.g., 5706) has a circular shape. In other words, the outer periphery defined by the magnet would have a curved shape.” EX1003, ¶96.



EX1004, Fig. 57.

Rothbaum857 consistently discloses, with the combination of Figures. 59A and 59B (reproduced below), that “[t]he second set of magnetic attachment elements 5706 and the second electrical interface 5710 (described in detail above) ... are **embedded** in the material of the mounting surface 5906.” EX1004, ¶[0251].

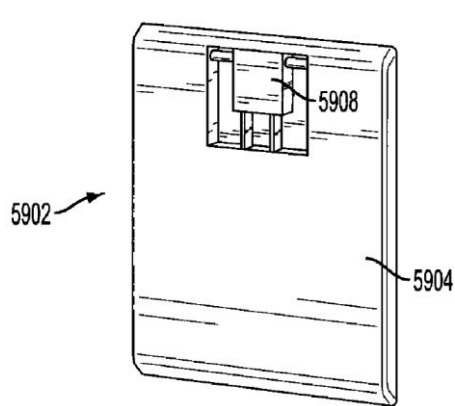


FIG. 59A

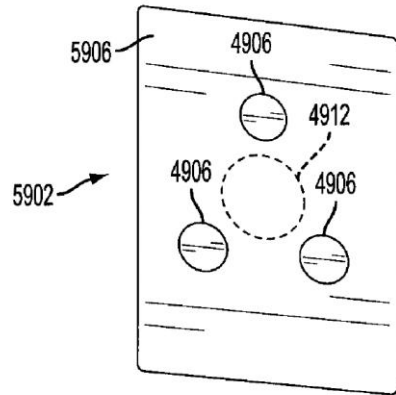


FIG. 59B

EX1004, Figs. 59A and 59B.

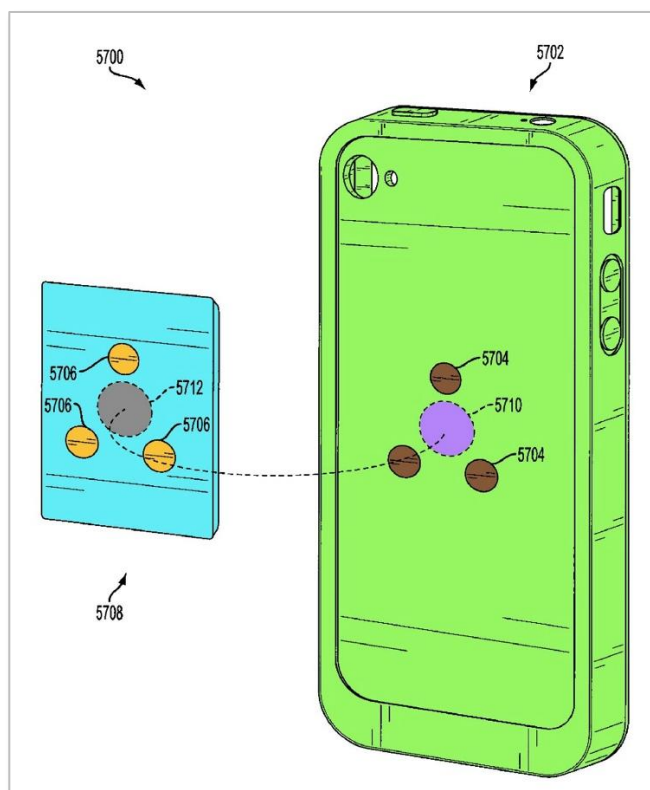
“A POSITA would have understood that a magnet being ‘embedded in the materials’ means that the materials forming the mounting surface 5906 (and thus the exterior-facing object 5902, as similar to object 5702 in Fig. 57) would form around the magnet, resulting in: (i) *the cavity of the exterior-facing component (object 5902) is formed at least in part by a curved outer wall*; and (2) *the outer periphery of magnet is adjacent to at least a portion of the curved outer wall*, thereby the magnet is embedded in the material of the surface 5906.” EX1003, ¶98.

[10]: “wherein with the exterior-facing component received in the receiving space, the cavity faces the interior space of the body portion”

“A POSITA would have aligned the direction of facing to the opening of the cavity.” EX1003, ¶99.

“Rothbaum857 discloses an open cavity with the direction of the opening facing the interior space of the body portion. As shown in FIG. 57 (reproduced below), Rothbaum857 discloses that the magnets 5706 are exposed from the back view of the object 5708.” EX1003, ¶100; *see also* EX1004, ¶[0255] (“[i]n some embodiments, the sets of magnetic attachment elements 5704, 5706 are configured to correspond to each other, so that when the first set of magnetic attachment elements 5704 is **magnetically attached** to the second set of magnetic attachment elements 5706, the first and second electrical interfaces 5710, 5712 are brought into electrical and/or inductive communication.”).

“Because the magnetic attachment elements 5706 are to correspond with magnetic attachment elements 5704 on the rear wall of the case, a POSITA would have understood that there is no intervening layers between magnetic elements 5706 and magnetic elements 5704, leaving the cavity open.” EX1003, ¶101.

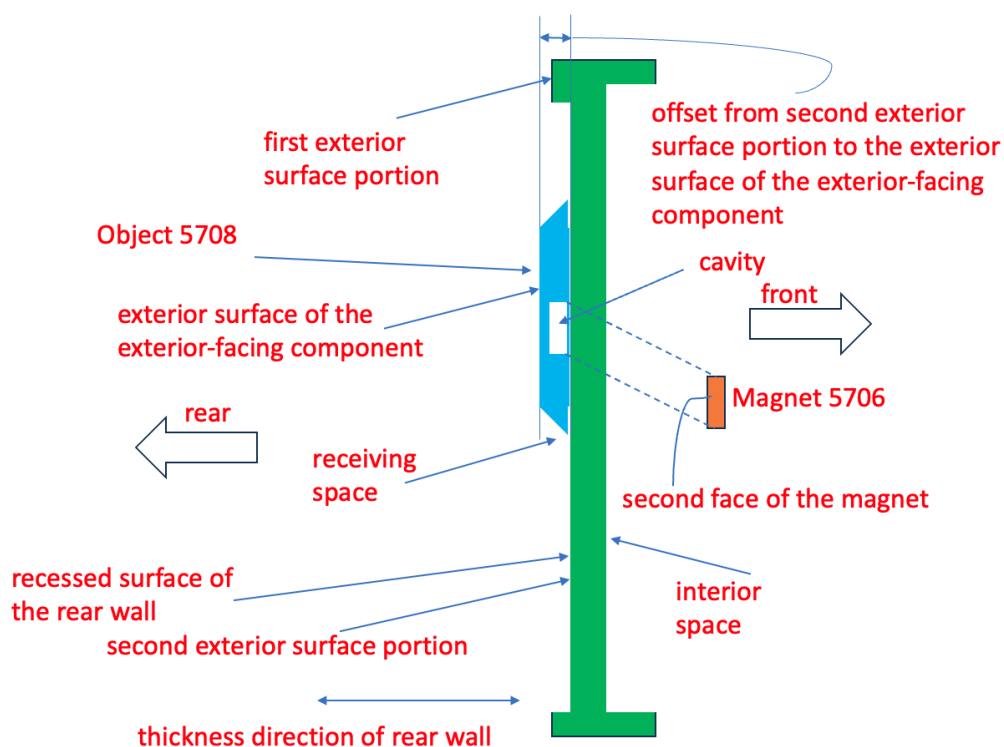


EX1004, Fig. 57.

“When the object 5708 (blue) is attached to the case 5702, the cavity would ‘face’, i.e., be open to the rear wall of the case 5702 (green). This is made clear by the dashed line that extends between electrical interfaces 5710 (purple) and 5712 (gray). That line depicts the orientation in which object 5708 (blue) attaches to case 5702 (green).” EX1003, ¶102; *see also* EX1004, ¶[0248] (“[the] magnetic attachment elements 5704 are configured to removably attach the case 5702 to a corresponding set of second magnetic attachment elements 5706 attached to an object 5708 external to the case.”). “Thus, object 5708 (blue) is received by case 5702 (green) when it is rotated 180° along the vertical axis of Figure 57. In such an orientation, the cavity of object 5708 (blue)

for retaining the magnetic elements 5706 (orange) faces the back (or rear wall) of case 5702 (green).” EX1003, ¶102.

The cavity is further illustrated in the cross-section side view of the case 5702 based on Fig. 57 of Rothbaum857 provided by Dr. King, as annotated below.

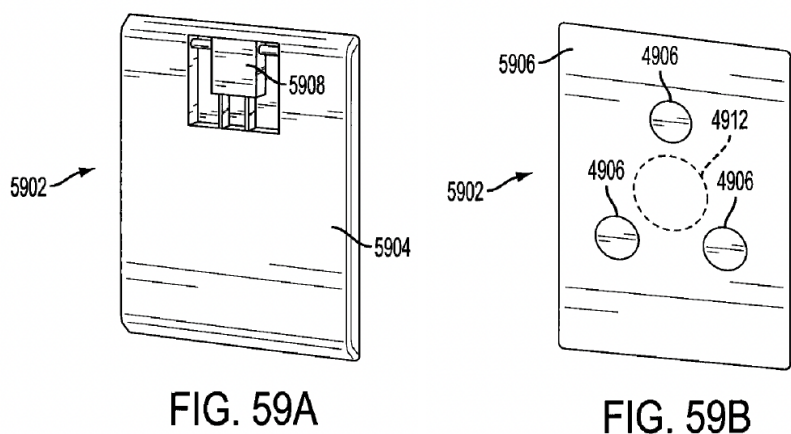


EX1003, ¶103.

“As clearly shown, when ‘the exterior-facing component [object 5708] received in the receiving space, the cavity faces the interior space of the body portion (shell of the case 5702).’” *Id.*, ¶104.

[1p]: “wherein the exterior-facing component covers the second face of the at least one magnet”

Rothbaum857 discloses: “[t]he second set of magnetic attachment elements 5706 and the second electrical interface 5710 (described in detail above) are adjacent to the mounting surface 5906. In some embodiments, they are inside the housing 5904, and reside behind the mounting surface 5906.” EX1004, ¶[0251]. “FIGS. 59A–59B of Rothbaum857 (reproduced below) further show a back and front side of the object 5902. Comparing FIG. 59B (in which the magnet 4906 is shown) to FIG. 59A (in which the magnet 4906³ is not shown), a POSITA would have understood that the magnet 4906 is covered by object 5902 at least partially.” EX1003, ¶105.

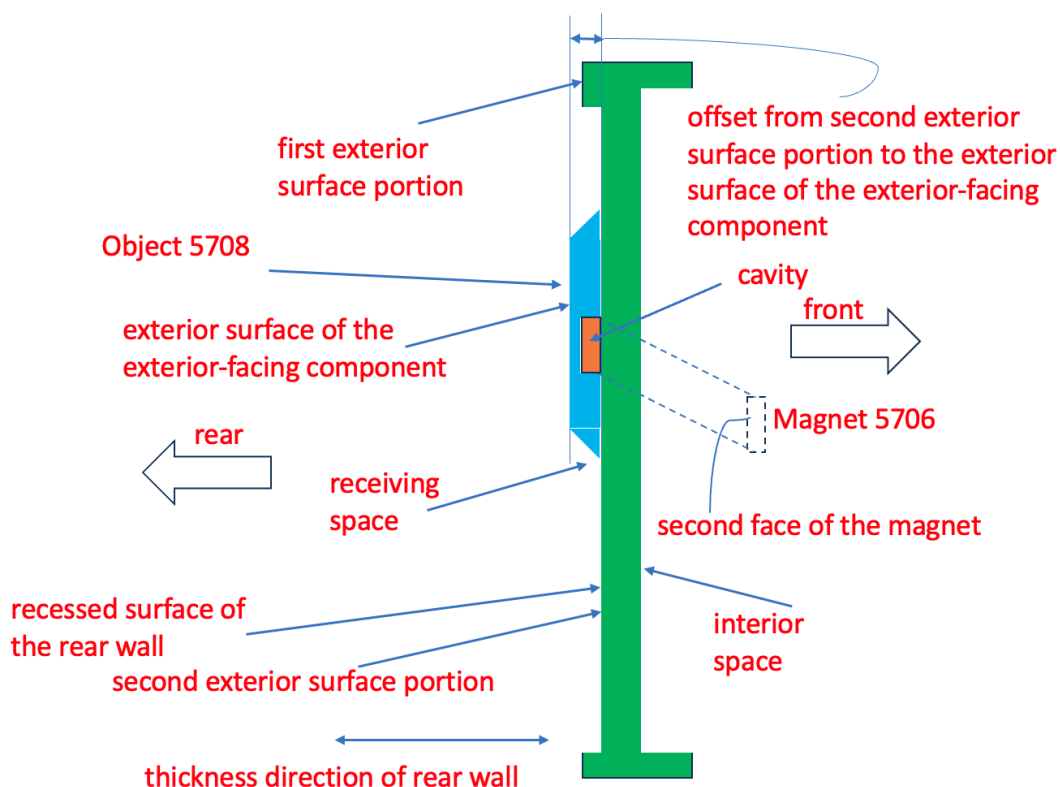


EX1004, Figs. 59A and 59B.

“The cross-section side view of the case 5702 based on Fig. 57 (shown below) of Rothbaum857 shows the magnet (brown) retained in the cavity, and

³ There is no description of 4906 in the specification of Rothbaum857. However, reference numeral 4906 is intended to be 5706. See paragraphs [0251]–[0252] making references to FIGS. 59.

thus, ‘the exterior-facing component [object 5708] covers the second face of the at least one magnet [5706].’” EX1003, ¶106.



Id.

[1q]: “wherein the at least one magnet is configured to attach the mountable case to a magnetic structure”

Rothbaum857 discloses attaching the case to a variety of structures, such as a vehicle accessory shown in FIGS. 62A–62B (reproduced below). In FIGS. 62A–62B, Rothbaum857 discloses an accessory that is a charger, where “[s]imilar to the charger discussed in relation to FIG. 59, the charger 6202 can be designed for use in conjunction with the case 5702.” EX1004, ¶[0263].

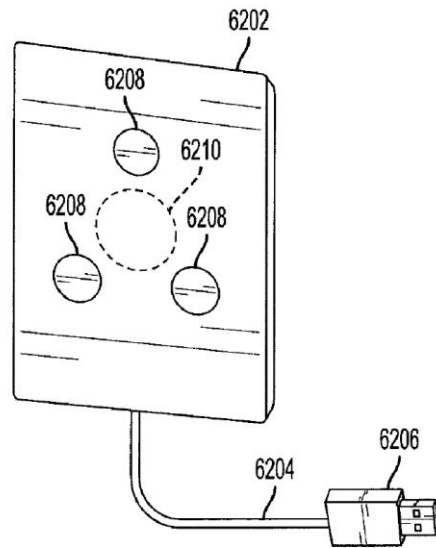


FIG. 62A

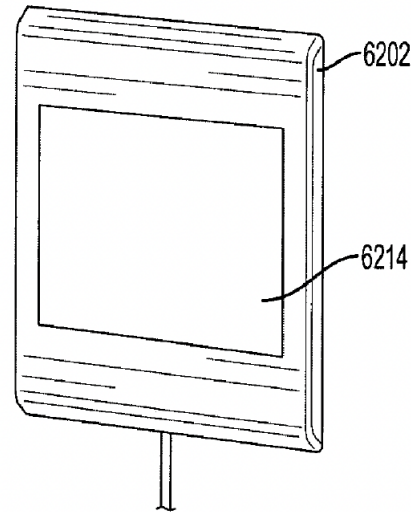


FIG. 62B

EX1004, Figs. 62A and 62B.

As shown, the charger 6202 is attached to the case using the magnetic elements 6208, where “a mobile electronic device case that has a magnetic material component (such as a metal back) can be attached to the charger 6202 by means of a magnetic attraction between the second set of magnetic attachment elements 6208 (or an alternative magnetic attachment mechanism) and the magnetic material component.” EX1004, ¶[0265], ¶[0264] (“the charger 6202 includes an additional attachment mechanism 6214 for connecting the charger 6202 to another surface. For instance, attachment mechanism 6214 can attach the charger 6202 to the side of a computer monitor. The attachment mechanism 6214 can be any of a variety of attachment mechanisms, including snaps, hook and loop mechanisms, Velcro, adhesives, magnets and/or magnetic materials, suction

devices, van der Waals force attachment mechanisms, buckles, sleeves that insert into slots, pegs that are inserted into holes, hinges, and/or snaps.”).

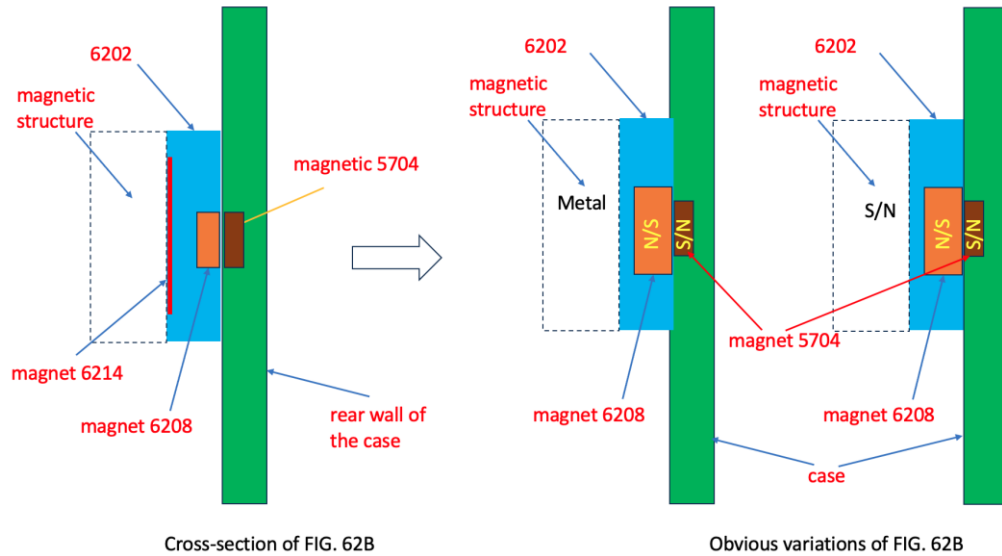
In the example above, attachment 6214 can be a magnet (which is itself a magnetic structure) configured to attach to another surface. A POSITA would have also understood that when the attachment 6214 is a magnet, the other surface can be a magnetic structure, such as a metal rack. Rothbaum⁸⁵⁷ thus discloses element 1[q] in at least two ways: (i) attaching handheld electronic device to magnetic structure 6214 via attachment 6208 and (ii) attaching a handheld electronic device case to an additional magnetic structure via both attachments 6214 and 6208. EX1003, ¶110.

In FIGs. 62A and 62B of Rothbaum⁸⁵⁷ reproduced above, magnets 6208 of the exterior facing member 6202 function to attach one side of the exterior facing member to the case of the mobile device and the attachment mechanism 6214 (*e.g.*, another magnet, and also a “magnetic structure”) “functions to attach the other side of the exterior facing member to an external magnetic surface. Thus, magnets 6208 function to, at least in part, ‘*attach the case to a magnetic structure.*’” EX1003, ¶111.

Alternatively, although attachment 6214 is shown separate from attachment 6208, because attachments 6214 and 6208 can both be a magnet, it would have been obvious to remove attachment 6214 and replace attachments 6208 with

stronger and/or larger magnets that can “function to both attach one side of the exterior facing member to the rear wall of the case (using the attachment method shown in FIG. 57) and also attach the other side of the exterior facing member to an external magnetic surface (using the attachment method shown in FIG. 62B). A POSITA would have been motivated to make this modification to form a simpler structure, requiring less magnetic material.” *Id.*, ¶111. A POSITA would have reasonably expected success because the magnets in such a modification would be arranged according to known methods with no change in their function to yield predictable results. *Id.*, ¶¶111-112; *KSR*, 550 U.S. at 416.

Dr. King presents at least one obvious way of making the modification to the magnets as shown in the figure below. For example, a POSITA would have modified the attachments 6214 and 6208 by using a larger magnet 6208 (in the exterior-facing component) in conjunction with magnet 5704 (in the rear wall) that are of opposite polarity with each other (e.g., N or S). An external magnetic structure would then be attachable to magnet 6208 through the magnetic attraction between the magnetic element 6208 and the magnetic structure. As shown below, the magnetic structure could be metal, or it can have an opposite polarity of that of 6208 to further increase the magnetic attraction. EX1003, ¶112.



Modification of FIG. 62B

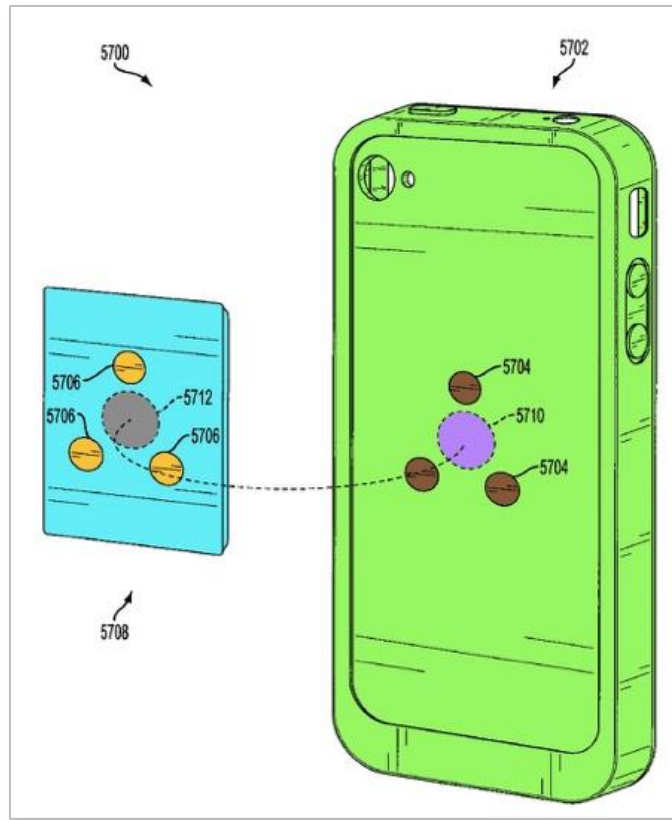
Id.

In the above modification, “the magnet 6208 can attach the mountable case to a magnetic structure, and therefore, the claim limitations “wherein the at least one magnet is configured to attach the mountable case to a magnetic structure” would have been obvious in view of Rothbaum857.” *Id.*, ¶113.

3. Claim 2

[2]: “wherein the outer periphery of the at least one magnet defines a shape that is different than a shape defined by an outer periphery of the exterior-facing component.”

To the extent the term “outer periphery” of the at least one magnet defines a circular shape as discussed above (see Section VI.A.2.[1n] with respect to claim 1, from which claim 2 depends), Rothbaum857 discloses this limitation.



EX1004, FIG. 57.

“FIG. 57 of Rothbaum857 above discloses that the outer periphery of the at least one magnet (e.g., 5706) is a circular shape, and it is different from a shape defined by the outer periphery of the exterior-facing component (e.g., attachment 5708), which is a rectangular shape.” EX1003, ¶115.

4. Claim 3

[3]: “wherein the exterior-facing component and the receiving space have complementary shapes.”

Rothbaum857 continues to disclose that: “[f]or instance, in some embodiments, the multi-tool 3702 can be held in the recess 3804 by the attachment mechanisms described above with reference to FIG. 1. For example, in some embodiments, the multi-tool 3702 and the case 3802 include a magnetic attachment mechanism as described above with reference to FIG. 1. Thus, when the multi-tool 3702 is inserted into the recess 3804 of the case, the multi-tool is held in place by the magnetic attachment mechanisms.” EX1004, ¶[0215].

Thus, it is clear from Rothbaum857 that the multi-tool 3702 (the exterior-facing component) and the recess 3804 have complementary shapes in order for the multi-tool 3702 to be inserted into the recess 3804 of the case. A POSITA would have known of different ways to attach an exterior facing member to the mobile phone case (e.g., attaching multi-tool component 3702 to a recess having a complementary shape in a case as shown in FIG. 38A, magnetically attaching component 5708 to a case as shown in FIG. 57, etc.). Thus, although the discussions with respect to claim 1, from which claim 3 depends, are made with examples in embodiments of Fig. 57 in Rothbaum857, a POSITA would have understood that the features in Fig. 38A in Rothbaum857 can also be applied to the embodiments in Fig. 57. For instance, a POSITA would have understood that, like the embodiment of Fig. 38A, the exterior-facing member of FIG. 57 could be used in conjunction with a recess that is substantially the same size and shape as

the periphery of the component 5708. Using a recess that is of substantially the same size and shape as the attachable member would aid the user in attaching the member at the desired location on the rear wall. It would also help prevent the attachable member from potentially slipping from the connection, especially when mounted onto another structure. Thus, a POSITA would have understood that the features disclosed in Figs. 38A and 57 of Rothbaum857 could be combined in this manner. At a minimum, it would have been obvious to do so. EX1003, ¶121.

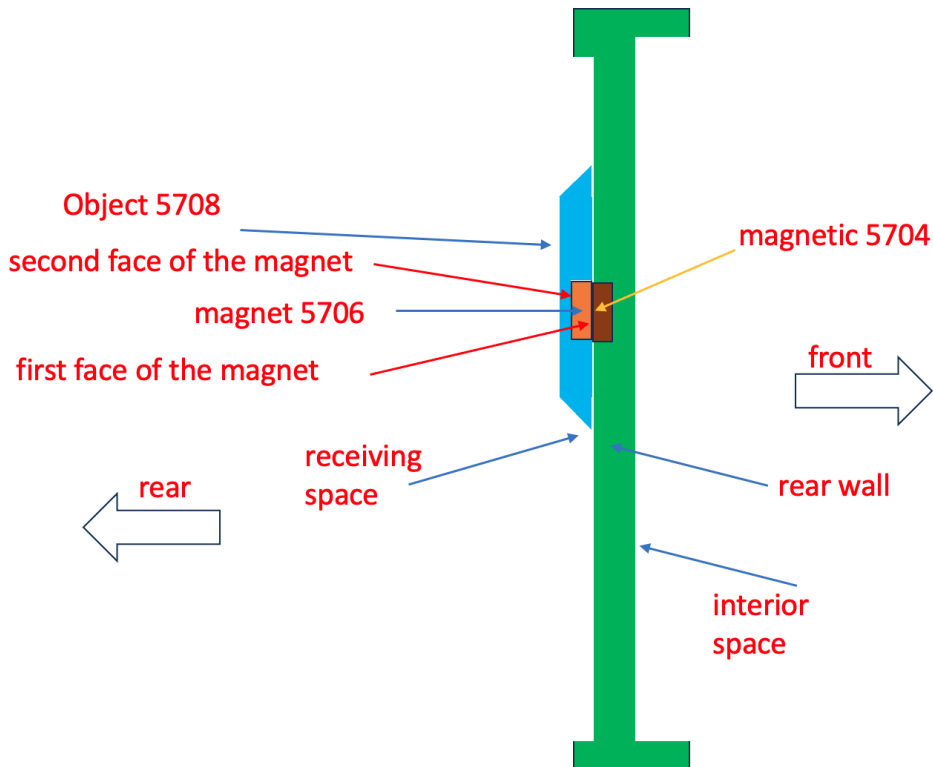
Indeed, following the descriptions of Fig. 38A, Rothbaum857 describes embodiments of a case 5702 and further describes that: “[d]epending on certain specific design choices, it is possible to use different arrangements of magnets to ensure that the first and second electrical interfaces are correctly aligned with respect to one another when the mobile electronic device case is attached to the external object. ... Also, some embodiments use other alignment mechanisms in addition to or instead of specific orientations of magnetic attachment elements. These could include combinations of recesses and protrusions on the case and the accessory, or a recess in the back of the case, both of which are described in more detail above,” (EX1004, ¶[0253]), thereby suggesting that the features in Fig. 38A can also be applied to embodiments in Fig. 57.

Accordingly, Rothbaum857 discloses and/or renders obvious “*wherein the exterior-facing component and the receiving space have complementary shapes.*” EX1003, ¶123.

5. Claim 4

[5]: “wherein at least one intervening layer is disposed between the first face of the at least one magnet and the interior space of the body portion.”

See [1p] (Section VI.A.2.[1p], incorporated herein). As shown in the annotated cross-section view (below) of the case based on Fig. 57 of Rothbaum857, the structure between the magnet 5706 and the interior space includes at least one intervening layer. Indeed, there are two intervening layers. A first intervening layer is magnet 5704, as it is positioned between magnet 5706 and the interior space. In addition, at least a portion of the rear wall of the case is also positioned between the magnet 5706 and the interior space of the body portion of the case, and thus, is also an intervening layer. EX1003, ¶124. *Applied Medical Resources Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324 (Fed. Cir. 2006) (A single prior-art structure may satisfy multiple claim limitations unless the claim language requires the limitations to be met by distinct structures.)



EX1003, ¶124.

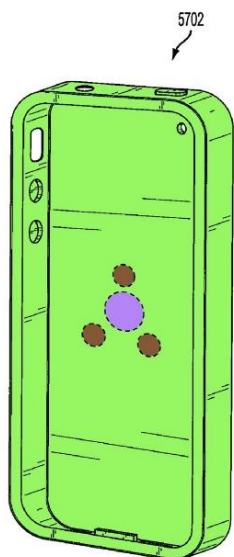
Accordingly, Rothbaum857 discloses “*at least one intervening layer [magnet 5704 or rear wall] is disposed between the first face of the at least one magnet [5706] and the interior space [space for retaining the handheld electronic device] of the body portion.*” *Id.*, ¶125.

6. Claim 5

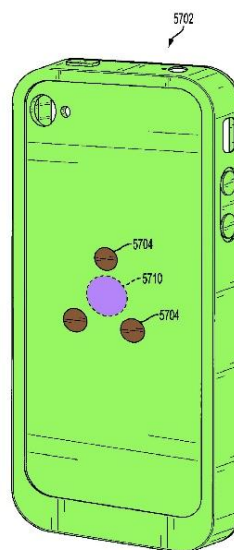
[5]: “wherein the rear wall and the perimeter wall are integrally formed as a unitary structure.”

This limitation is disclosed by Rothbaum857. Alternatively, it would have been obvious.

Rothbaum857 depicts case 5702 as being a single entity with a back (or rear wall) and sidewall.



EX1004, Fig. 64A(partial)



EX1004, Fig. 57(partial)

“As shown above, Rothbaum857 uses the single reference number ‘5702’ to refer to the structure in its entirety. In view of this disclosure, a POSITA would have understood that case 5702 is a single (i.e., ‘unitary’) structure.” EX1003, ¶127.

Moreover, “[i]t would have been obvious to a POSITA to manufacture case 5702 as or into a unitary structure. By forming case 5702 as a unitary structure, molding and assembly costs may be reduced and structural reliability are improved, relative to the alternative of providing a case comprising multiple, discrete pieces. Indeed, mobile electronic device cases having a unitary structure were well-known to persons of ordinary skill in the art at the time of the invention

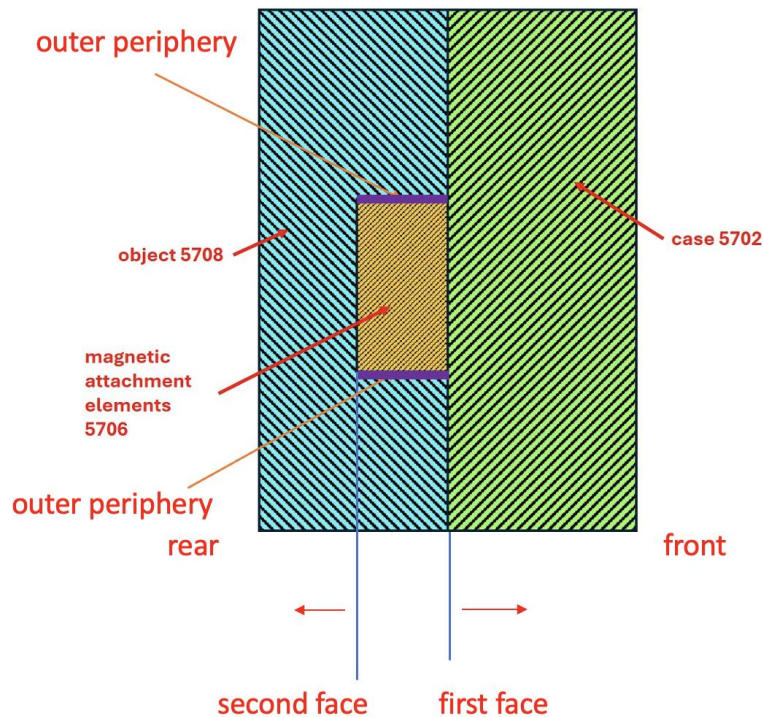
of the '835 patent.” EX1003, ¶128; *KSR*, 550 U.S. at 401, 427 (obvious to use known techniques to improve similar devices in the same way).

Accordingly, Rothbaum857 discloses or renders obvious “*wherein the rear wall and the perimeter wall are integrally formed as a unitary structure.*”

7. Claim 6

[6]: “wherein the exterior-facing component directly contacts the second face of the at least one magnet without an intervening layer.”

This limitation would have been obvious in view of Rothbaum857. As discussed in Section VI.A.2.p with respect to claim 1, and illustrated by Dr. King (reproduced below), “the magnet is enclosed by the exterior-facing component, where the second face of the magnet is in contact with the exterior-facing component.” EX1003, ¶130.



Id.

A POSITA would have understood that it would be obvious to make the magnet be in direct contact with the surface of the exterior-facing component without an intervening layer, as Rothbaum857 does not suggest that an intervening layer is needed, and no portion of Rothbaum857 requires an intervening layer between the second face of the magnet (e.g., 5706) and the exterior-facing component (e.g., object 5708). A POSITA would thus understand that “magnet 5706 may be embedded to be in direct contact with the surface of the object 5708, e.g., via glue on the perimeter wall of the magnet 5706; or interlocking the perimeter wall of the magnet 5706 with the side wall of the cavity, as commonly practiced in the industry.” EX1003, ¶131.

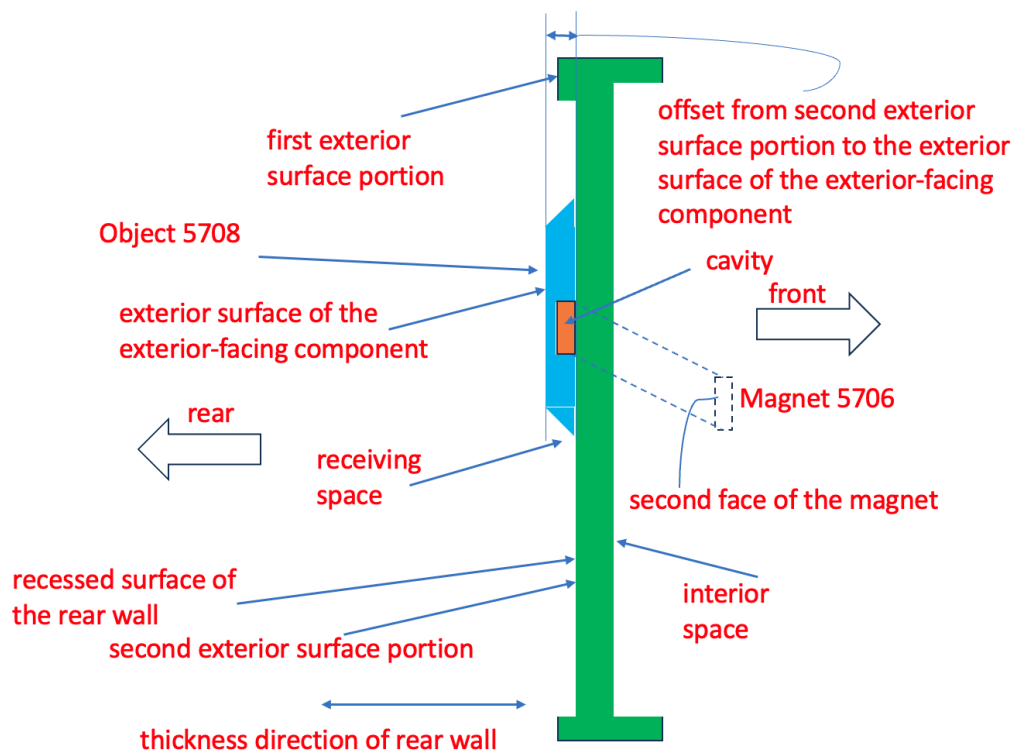
8. Independent Claim 7

All of the limitations in claim 7 substantially correspond to limitations in claim 1, as shown in the table below listing only the differences.

Claim 7	Corresponding limitations in claim 1
[7pre]	[1pre]
[7b]	[1b]
[7c]	[1c]
[7d]	[1e]
[7e]	[1f]
[7f]	[1h]
[7g]	[1i]
[7h]	[1k]
[7i]	[1L]
[7j]	[1m]
[7k]	[1n]
[7L]	[1o]
[7m]: “wherein the exterior-facing component extends along the second face of the at least one magnet;”	[1p]: “wherein the exterior-facing component covers the second face of the at least one magnet;”
[7n]	[1q]

As such, for the reasons set forth in Section VI.A.2 regarding the unpatentability of claim 1 (incorporated herein), claim 7 is likewise unpatentable.

To the extent that patent owner argues that “extends along” in [7m] does not correspond to “covers” in [1p], the arguments with respect to [1p] (incorporated herein) can nevertheless be applied here. In [1p], Dr. King illustrates the cross-section side view of case 5702 based on Rothbaum857, Fig. 57 (reproduced below).



EX1003, ¶133.

“As shown, because the object 5708 covers the second face of the magnet 5706, it **extends along** the entire second face of the magnet 5706.” *Id.*, ¶134.

9. Claim 8

[8]: “wherein the outer periphery of the at least one magnet defines a shape that is different than a shape defined by an outer periphery of the exterior-facing component.”

See [2] (Section VI.A.3 incorporated herein).

10. Claim 9

[9]: “wherein the exterior-facing component and the receiving space have complementary shapes.”

See [3] (Section VI.A.4 incorporated herein).

11. Claim 10

[10]: “wherein at least one intervening layer is disposed between the first face of the at least one magnet and the interior space of the body portion.”

See [4] (Section VI.A.5 incorporated herein).

12. Claim 11

[11]: “wherein the rear wall and the perimeter wall are integrally formed as a unitary structure.”

See [5] (Section VI.A.6 incorporated herein).

13. Claim 12

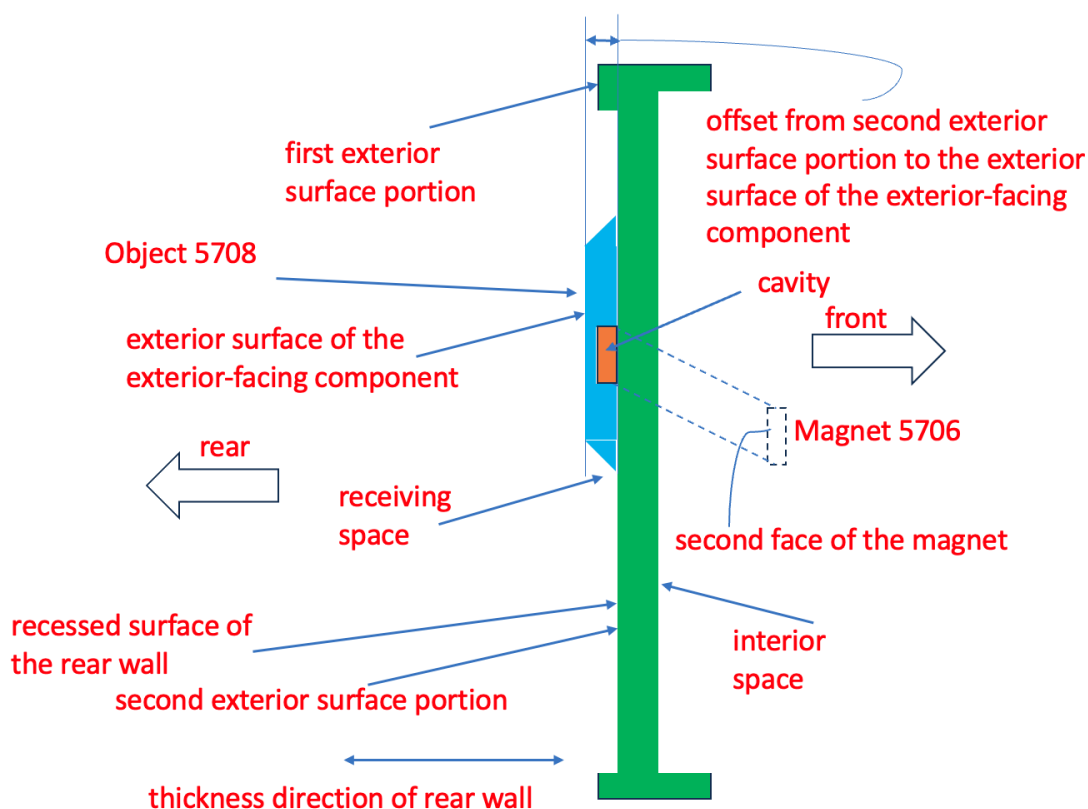
[12]: “wherein the exterior-facing component directly contacts the second face of the at least one magnet without an intervening layer.”

See [6] (Section VI.A.7 incorporated herein).

14. Claim 13

[13]: “wherein an exterior surface of the exterior-facing component and at least a portion of an exterior surface of the rear wall are offset from one another in a thickness direction of the rear wall.”

See arguments with respect to [1p] (Section VI.A.2.[1p], incorporated herein). Dr. King shows a cross-section side view of case 5702 based on Rothbaum857, Fig. 57 (reproduced below).



EX1003, ¶140.

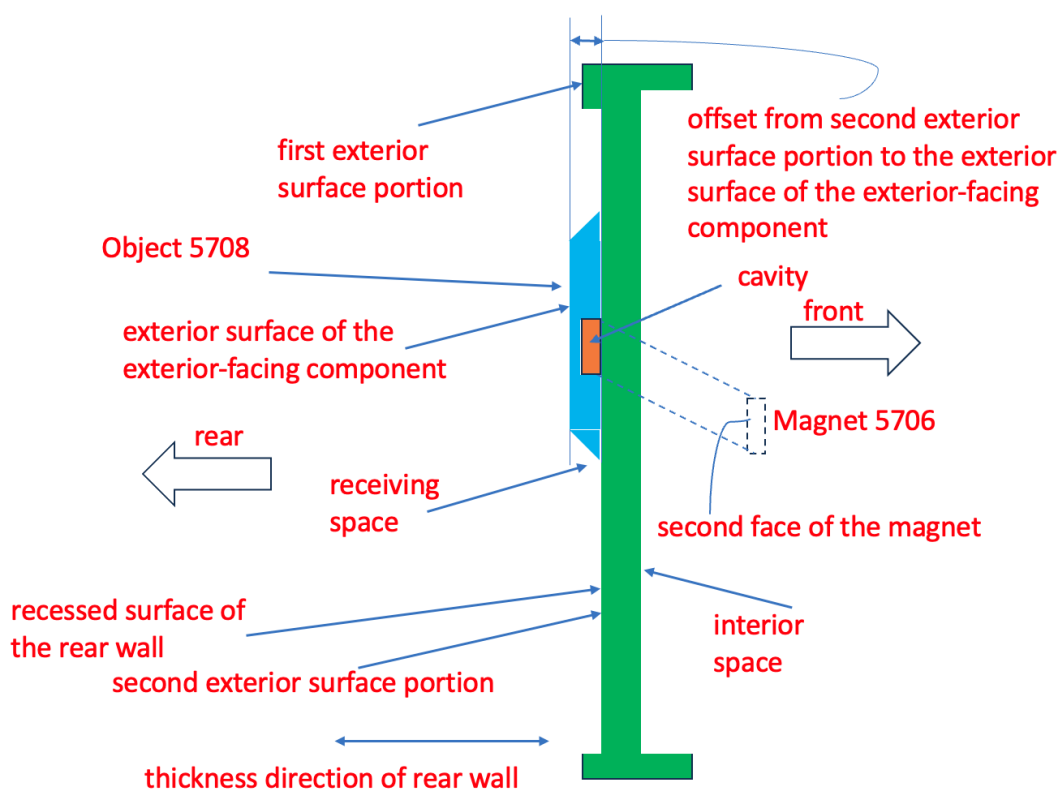
As shown, “Rothbaum857 discloses ‘an exterior surface [the face that is furthest away from the rear wall of the case] of the exterior-facing component [object 5708] and at least a portion of an exterior surface [recessed surface] of

the rear wall are **offset** from one another in a thickness direction of the rear wall.’ This offset is shown as the thickness of object 5708.” *Id.*, ¶141.

15. Claim 14

[14]: “wherein the exterior-facing component covers an entirety of the second face of the at least one magnet.”

See [1p] (Section VI.A.2.[1p], incorporated herein). As shown in Dr. King’s illustration (reproduced below), the object 5708 “covers an **entirety** of the second face of the [magnet 5706].”



EX1003, ¶142.

16. Claim 15

[15]: “wherein an exterior surface of the rear wall comprises a first exterior surface portion and a second exterior surface portion offset from one another in a thickness direction of the rear wall.”

See [1g] (Section VI.A.2.[1g], incorporated herein).

17. Claim 16

[16]: “a beveled surface that defines a transition between an exterior surface of the perimeter wall and an exterior surface of the rear wall.”

See [1d] (Section VI.A.2.[1d], incorporated herein).

18. Independent Claim 17

All of the limitations in claim 17 substantially correspond to limitations in independent claim 7, as shown in the table below listing only the differences.

Claim 17	Corresponding limitations in claim 7
[17pre]	[7pre]
[17b]	[7b]
[17c]	[7c]
[17d]	[7d]
[17e]	[7e]
[17f]	[7f]
[17g]: “the exterior-facing component having a recess”	[7g]: “the exterior-facing component having a cavity;”
[17h]	[7i]

[17i]	[7j]
[17j]	[7L]
[17k]	[7m]

“As such, for the reasons set forth in Section VI.A.8 regarding the unpatentability of claim 7, claim 17 is likewise unpatentable.” EX1003, ¶145.

To the extent that patent owner argues that “recess” in [17g] does not correspond to “cavity” in [7g], the arguments with respect to [7g] (incorporated herein) can nevertheless be applied here. Particularly, as shown in [7g] (incorporating [1i]), Rothbaum857 discloses “*the exterior facing component having a recess.*” See Section VI.A.8 and VI.A.2.[1i].

“A POSITA would have understood that the term ‘recess’ can be interpreted as ‘cavity’ in its ordinary and customary meaning. Indeed, the ’835 patent does not distinguish between a recess and a cavity.” EX1003, ¶145; *see* EX1001, Fig. 8A (reference numeral 192), and 10:23–30 (using only the term “indentation” for the relevant feature being disclosed, not the terms “cavity” or “recess.”).

19. Claim 18

[18]: “wherein an exterior surface of the exterior-facing component and at least a portion of an exterior surface of the rear wall are offset from one another in a thickness direction of the rear wall.”

See [13] (Section VI.A.14, incorporated herein).

20. Claim 19

[19]: “wherein the recess of the exterior-facing component is formed at least in part by a curved outer wall.”

See [1n] (Section VI.A.2.[1n], incorporated herein).

21. Claim 20

[20]: “The mountable case for a handheld electronic device of claim 19, wherein the outer periphery of the at least one magnet is adjacent to at least a portion of the curved outer wall.”

See [1n] (Section VI.A.2.[1n], incorporated herein).

22. Claim 21

[21]: “wherein the outer periphery of the at least one magnet defines a shape that is different than a shape defined by an outer periphery of the exterior-facing component.”

See [2] (Section VI.A.3, incorporated herein).

23. Claim 22

[22]: “wherein the at least one magnet is configured to attach the mountable case to a magnetic structure.”

See [1q] (Section VI.A.2.[1q], incorporated herein).

24. Claim 23

[23]: “wherein the rear wall and the perimeter wall are integrally formed as a unitary structure.”

See [5] (Section VI.A.6, incorporated herein).

25. Claim 24

[24]: “wherein an exterior surface of the rear wall comprises a first exterior surface portion and a second exterior surface portion offset from one another in a thickness direction of the rear wall.”

See [1g] (Section VI.A.2.[1g], incorporated herein).

26. Independent Claim 25

Limitations in independent claim 25 substantially correspond to limitations in independent claim 1, as shown in the table below listing only the differences.

Claim 25	Corresponding limitations in claim 1
[25pre]	[1pre]
[25b]	[1b]
[25c]: “the body portion comprising: a rear wall defining an interior surface, an exterior surface, an interior plane at an interior-most surface portion of the interior surface of the rear wall, and an exterior plane at an exterior-most surface portion of the exterior surface of the rear wall ; a perimeter wall”	[1c]: the body portion comprising: a rear wall; a perimeter wall;
[25d]: “wherein the rear wall is configured to be aligned with at least a portion of a rear surface of the handheld electronic device, wherein the perimeter wall extends from a perimeter of the rear wall and is	[1e]: “wherein the rear wall is configured to be aligned with at least a portion of a rear surface of the handheld electronic device, and wherein the perimeter wall extends from an outer perimeter of the rear

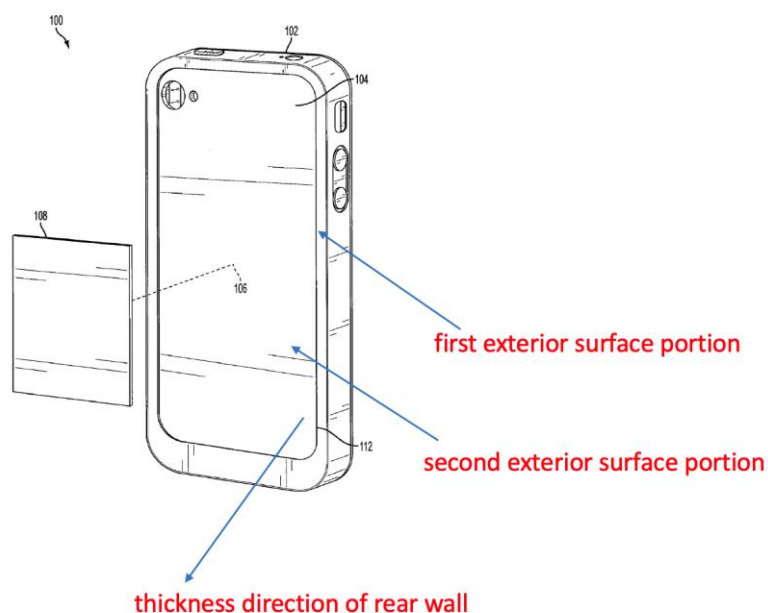
positioned proximate to at least portions of side surfaces of the handheld electronic device”	wall and is positioned proximate to at least portions of side surfaces of the handheld electronic device, and”
[25e]	[1f]
[25f]	[1L]+[1m]
[25g]	[1h]
[25h]: “wherein, with the exterior-facing component received in the receiving space, the at least one magnet is positioned between the interior plane and the exterior plane”	See discussion below
[25i]	[1L]
[25j]: “ wherein with the exterior-facing component received in the receiving space , the exterior-facing component extends along the second face of the at least one magnet”	[1p]: “wherein the exterior-facing component covers the second face of the at least one magnet;”

Because the limitations in claim 25 substantially correspond to the limitations in claim 1, arguments in Section VI.A.2 with respect to the unpatentability of claim 1 are incorporated herein. Additionally, each of the differences from claim 1 as listed above is discussed here.

[25c]

[25c] recites additional limitations of the rear wall: “*a rear wall defining an interior surface, an exterior surface, an interior plane at an interior-most surface portion of the interior surface of the rear wall, and an exterior plane at an exterior-most surface portion of the exterior surface of the rear wall.*”

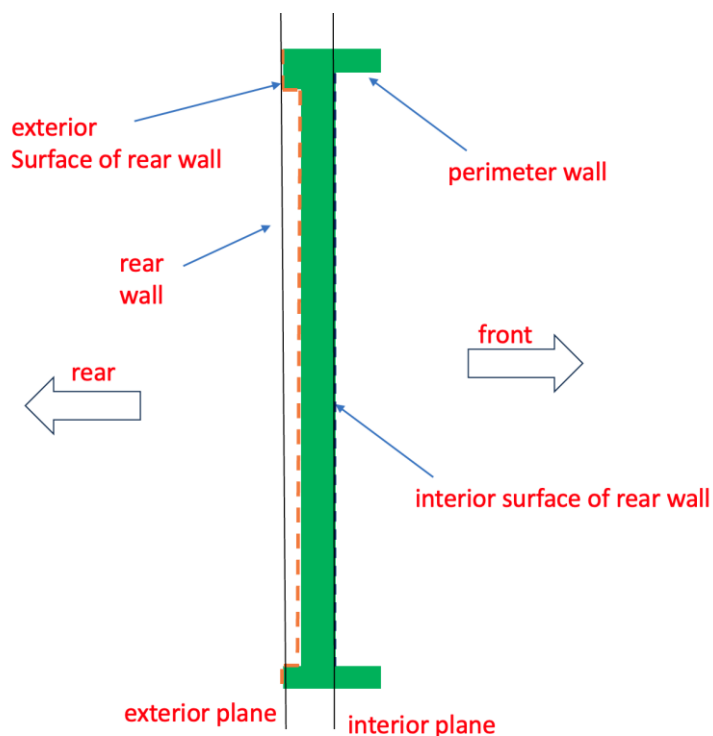
Fig. 1A of Rothbaum857 discloses a raised edge that forms a recess in the rear wall of the case, dividing into two surface portions. For example, Rothbaum857 discloses “[i]n some embodiments, the accessory 108 is used with a mobile electronic device case where the back surface 104 of the case has a recessed portion defined by a shoulder or raised edge 112. As shown in FIG. 1, the main portion of the back surface 104 of the case 102 is recessed with respect to the raised edge 112.” EX1004, ¶[0141].



EX1004, Fig. 1A.

“Although the raised edge 112 and the recess in the back of the case are described with specific reference to Figures 1–2 of Rothbaum857, a POSITA would have understood that it was generally applicable to the other embodiments of Rothbaum857, including the embodiment depicted in Figure 57.” EX1003, ¶156.

Dr. King illustrates the various surfaces of the rear wall in the claim in a cross-section view of the case disclosed in Rothbaum857, Fig. 57, as shown below.



EX1003, ¶157.

As shown, “Rothbaum857 discloses that the ‘*rear wall defin[es] an interior surface [facing front]...an exterior surface [facing rear]...an interior plane...and an exterior plane.*’” *Id.*, ¶158.

[25d]

[25d] recites “perimeter” whereas [1e] recites “outer perimeter.” Since “outer perimeter” is also a “perimeter,” Rothbaum857 discloses [25d] for the

same reasons that Rothbaum857 discloses [1e] (Section VI.A.2.[1e], incorporated herein).

[25h]

[25h] recites “wherein, with the exterior-facing component received in the receiving space, the at least one magnet is positioned between the interior plane and the exterior plane”

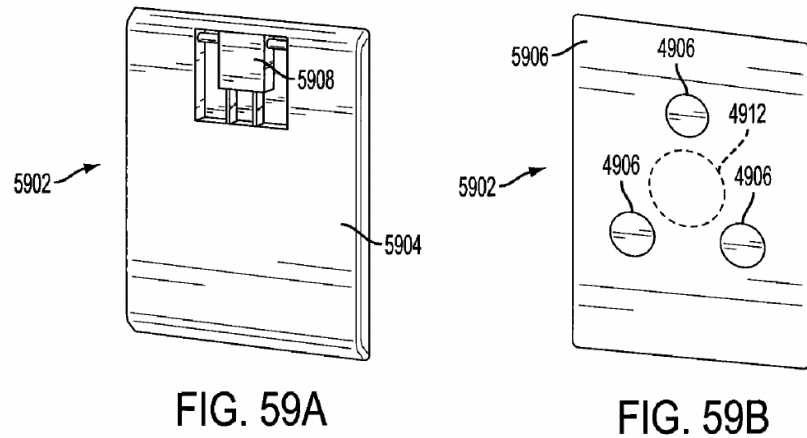
Rothbaum857 discloses “[i]n some embodiments, the accessory 108 is configured to fit substantially within an area defined by the surface 104. In some embodiments, the accessory 108 can be configured to fit completely within the surface 104.” EX1004, ¶[0138]. For example, “[i]n some embodiments, the accessory 108 is thinner than, or the same thickness as, the recess between the back surface 104 and the raised edge 112. Thus, when the accessory 108 is attached to the back surface 104 of the case 102, **the accessory 108 does not protrude any further than the outer surfaces of the case 102.** In some embodiments, the accessory 108 is thicker than the recess. In some embodiments, the accessory 108 protrudes further than the outer surfaces of the case 102 by only half as much as the recess.” EX1004, ¶[0141].

“A POSITA would have understood that the foregoing discussions with specific reference to Figures 1–2 are generally applicable to the other embodiments of Rothbaum857, including the embodiment depicted in Fig. 57.

For example, the embodiments of accessory 108 (in Figs. 1–2) can be applied to the object 5708 in Fig. 57, in that the accessory [5708] does not protrude any further than the outer surfaces of the case [5702] as is the case for accessory 108 and case 102 shown in Figs. 1A–1B.” EX1003, ¶162.

Rothbaum857 further discloses that a magnet is enclosed by the accessory 5702. EX1004, ¶[0251] (“[t]he second set of magnetic attachment elements 5706 and the second electrical interface 5710 (described in detail above) are adjacent to the mounting surface 5906. In some embodiments, they are **inside** the housing 5904, and **reside behind** the mounting surface 5906.”) FIGS. 59A–59B of Rothbaum857 (reproduced below) further show a back and front side of the object 5902. “Comparing FIG. 59B (in which the magnet 4906⁴ is shown) to FIG. 59A (in which the magnet 4906 is not shown), a POSITA would have understood that the magnet 4906 is enclosed by object 5902.” EX1003, ¶163.

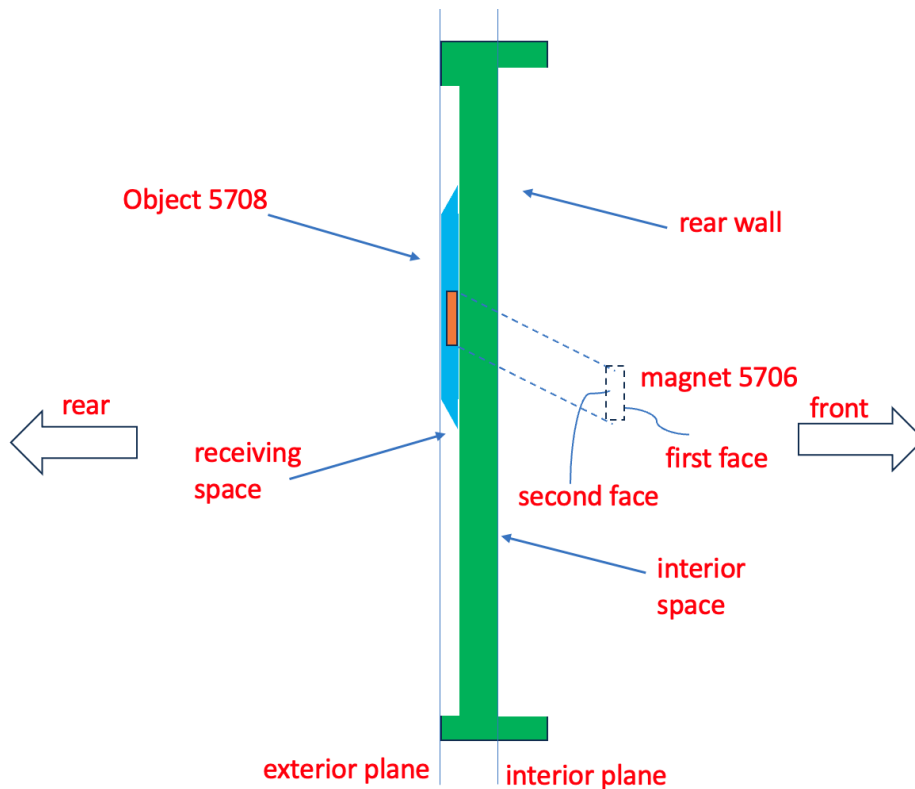
⁴ There is no description of 4906 in the specification of Rothbaum857. However, reference numeral 4906 is intended to be 5706. See paragraphs [0251]–[0252] making references to FIGS. 59.



EX1004, Figs. 59A and 59B

“Although the magnet is described as being enclosed by the accessory with reference to Figs. 59A–59B, a POSTA would have understood that it was generally applicable to the other embodiments of Rothbaum857, including the embodiment depicted in Figure 57. For example, a POSITA would have understood that magnet 5706 in Fig. 57 of Rothbaum857 could be enclosed by object 5708.” EX1003, ¶164.

In the case where “the accessory [5708] does not protrude any further than the outer surfaces of the case [5702],” Dr. King modifies the cross-section illustration of Fig. 57 to show the placement of the magnet 5706 with the first face and the second face (see below).



EX1003, ¶165.

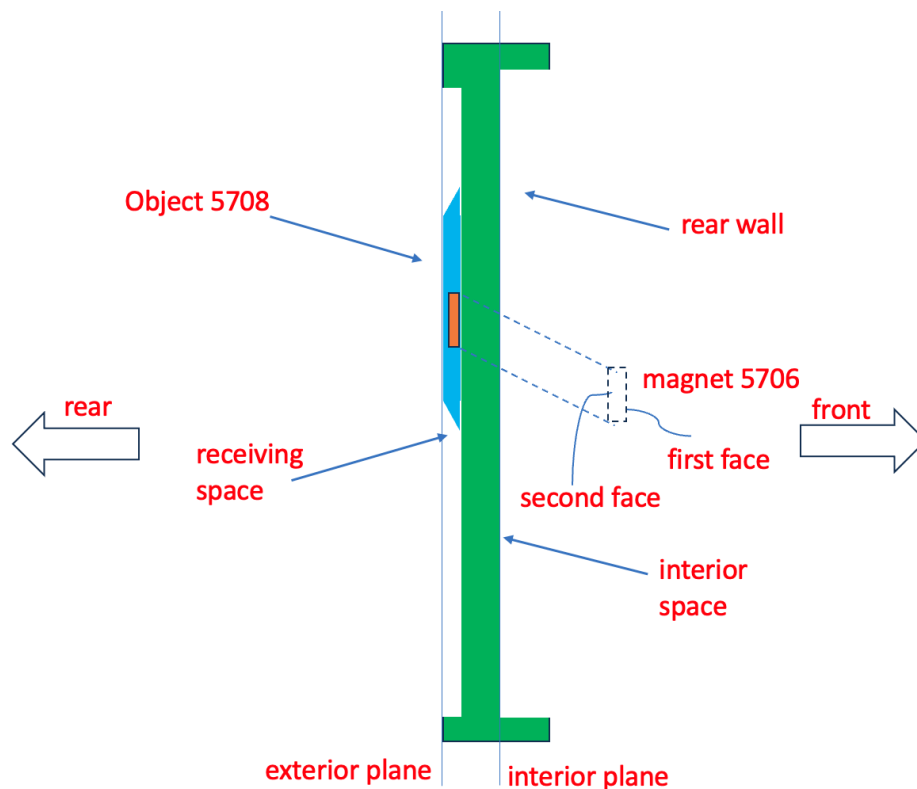
“As the object 5708 fits completely within the depth of the receiving space, the exterior-facing component 5708 is positioned between the exterior plane and the interior plane. Because the magnet 5706 could be enclosed by object 5708, it [necessarily] follows that the magnet 5706 is also positioned entirely in the receiving space—at least between the exterior plane and the interior plane.” *Id.*, ¶166.

Accordingly, “Rothbaum857 discloses ‘*the exterior-facing component [5708] received in the receiving space, the at least one magnet [5706] is positioned between the interior plane and the exterior plane.*’” *Id.*, ¶167.

[25j]

[25j] recites limitation [1p] additionally on the condition of: “**wherein with the exterior-facing component received in the receiving space.**”

Arguments for [1p] (Section VI.A.2.[1p]) are incorporated herein. As shown in Dr. King’s illustration in [1p] (reproduced below), object 5708 is indeed shown to be positioned as “received in the receiving space.” As such, arguments for [1p] are also applicable here.



EX1003, ¶168.

Additionally, as discussed in [7m] (incorporating [1p]), Rothbaum857 discloses “*the exterior-facing component **extends along** the second face of the at least one magnet.*” See Section VI.A.8 and VI.A.2.[1p].

27. Claim 26

[26]: “wherein the receiving space is defined at least in part by a recessed surface of the rear wall.”

See [1k] (Section VI.A.2.[1k] incorporated herein).

28. Claim 27

[27]: “The mountable case for a handheld electronic device of claim 26, wherein at least a portion of the recessed surface faces away from the interior space of the body portion.”

See [1k] (Section VI.A.2.[1k] incorporated herein).

29. Claim 28

[28]: “wherein an exterior surface of the exterior-facing component is offset outwardly from an exterior surface of the rear wall, such that the exterior-facing component extends beyond the exterior surface of the rear wall.”

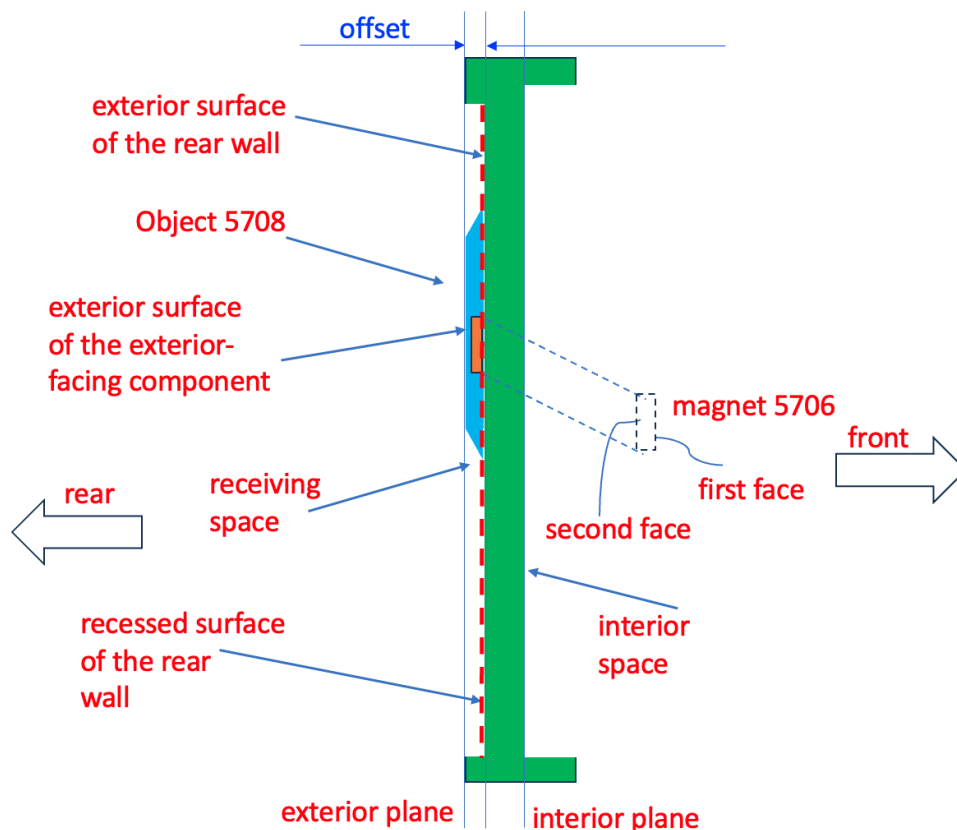
Rothbaum857 discloses: “In some embodiments, the accessory 108 is used with a mobile electronic device case where the back surface 104 of the case has a recessed portion defined by a shoulder or raised edge 112. As shown in FIG. 1, the main portion of the back surface 104 of the case 102 is recessed with respect to the raised edge 112. ... In some embodiments, **the accessory 108 is thicker than the recess**. In some embodiments, the accessory 108 **protrudes further than the outer surfaces of the case 102** by only half as much as the recess.”

EX1004, ¶[0141]. A POSITA would thus understand that, when object 5708 is thicker than the recess, or protrudes further than outer surface of the case, the

exterior surface of object 5708 (the exterior-facing component) is offset outwardly from the exterior surface of the rear wall and extends beyond the exterior surface of the rear wall. *Id.*

30. Claim 29

[29]: “an exterior surface of the exterior-facing component and at least a portion of an exterior surface of the rear wall are offset from one another in a thickness direction of the rear wall.”



EX1003, ¶172.

Dr. King’s illustration in [25h], which depicts the disclosure of Rothbaum857, is reproduced above with added labels for exterior surface of the object 5708 and exterior surface of the rear wall. “As shown in the annotated

figure above, the offset between the exterior surface of object 5708 and the recessed surface of the rear wall (shown in blue) is in the direction of the thickness of the rear wall.” EX1003, ¶172.

31. Claim 30

[30]: “wherein the outer periphery of the at least one magnet defines a shape that is different than a shape defined by an outer periphery of the exterior-facing component.”

See [2] (Section VI.A.3, incorporated herein).

32. Claim 31

[31]: “wherein the at least one magnet is configured to attach the mountable case to a magnetic structure.”

See [1q] (incorporated herein).

33. Claim 32

[32]: “wherein the exterior-facing component and the receiving space have complementary shapes.”

See [3] (Section VI.A.4, incorporated herein).

34. Claim 33

[33]: “wherein the exterior-facing component covers an entirety of the second face of the at least one magnet.”

See [1p] and [14] (Sections VI.A.2.[1p] and VI.A.15, incorporated herein).

35. Claim 34

[34]: “wherein at least one intervening layer is disposed between the first face of the at least one magnet and the interior space of the body portion.”

See [4] (Section VI.A.5, incorporated herein).

36. Claim 35

[35]: “wherein the rear wall and the perimeter wall are integrally formed as a unitary structure.”

See [5] (Section VI.A.6, incorporated herein).

37. Claim 36

[36]: “wherein the exterior-facing component directly contacts the second face of the at least one magnet without an intervening layer.”

See [6] (Section VI.A.7, incorporated herein).

38. Claim 37

[37]: “wherein an exterior surface of the rear wall comprises a first exterior surface portion and a second exterior surface portion offset from one another in a thickness direction of the rear wall.”

See [1g] (Section VI.A.2.[1g], incorporated herein).

39. Claim 38

[38]: “further comprising a beveled surface that defines a transition between an exterior surface of the perimeter wall and an exterior surface of the rear wall.”

See [1d] (Section VI.A.2.[1d], incorporated herein).

40. Claim 39

[39]: “wherein the exterior-facing component comprises a groove.”

Rothbaum857 discloses various examples of accessory 108, one of which is a key holder shown in FIGs. 8B and 8C (reproduced below).

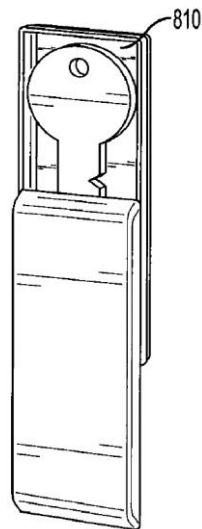


FIG. 8B

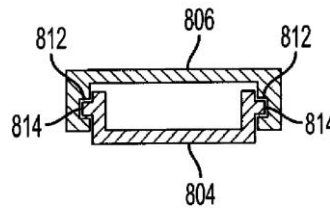


FIG. 8C

EX1004, FIGS. 8B–8C.

Rothbaum857 further describes: “the key holder 802 includes a base 804, a lid 806, and an attachment mechanism 808. The lid 806 is configured to move with respect to the base 804 in order to expose an internal chamber 810 for receiving a key. In some embodiments, as shown in FIG. 8C the lid has two channels 812 that are positioned to receive two guide tracks 814 on the base 804.”

EX1004, ¶[0161].

Although the discussions with respect to claim 25 [see Section VI.D.2], from which claim 39 depends, are made with examples in embodiments of Fig.

57 in Rothbaum857, a POSITA would have understood that the key holder 802 as disclosed in FIGS. 8B–8C can also be applied to the embodiments in Fig. 57. A POSITA would have understood that the features disclosed in Figs. 8B–8C and 57 of Rothbaum857 could be combined to render claim 39 obvious. For example, a POSITA would understand the attachment 5708 in FIG. 57 could be replaced by the key holder, as shown in FIGS. 8B–8C, while still utilizing the attachment mechanism of attachment 5708. Or put another way, a POSITA would understand that the attachment mechanism of the key holder shown in FIGS. 8B–8C could be implemented using magnets that are inside the housing or reside behind the mounting surface, as explained in the specification with respect to attachment 5708. EX1003, ¶184.

“Indeed, as discussed above [in Section VI.D.2.g] with respect to claim 25, from which claim 39 depends, object 5708 in Fig. 57 of Rothbaum857 is ‘removably received’ in the rear wall of case 5702, and meant to include a variety of objects, such as a charger, spare battery, or speaker, for example.” EX1003, ¶184, *citing* EX1004, ¶¶[0250], [0259], [0262].

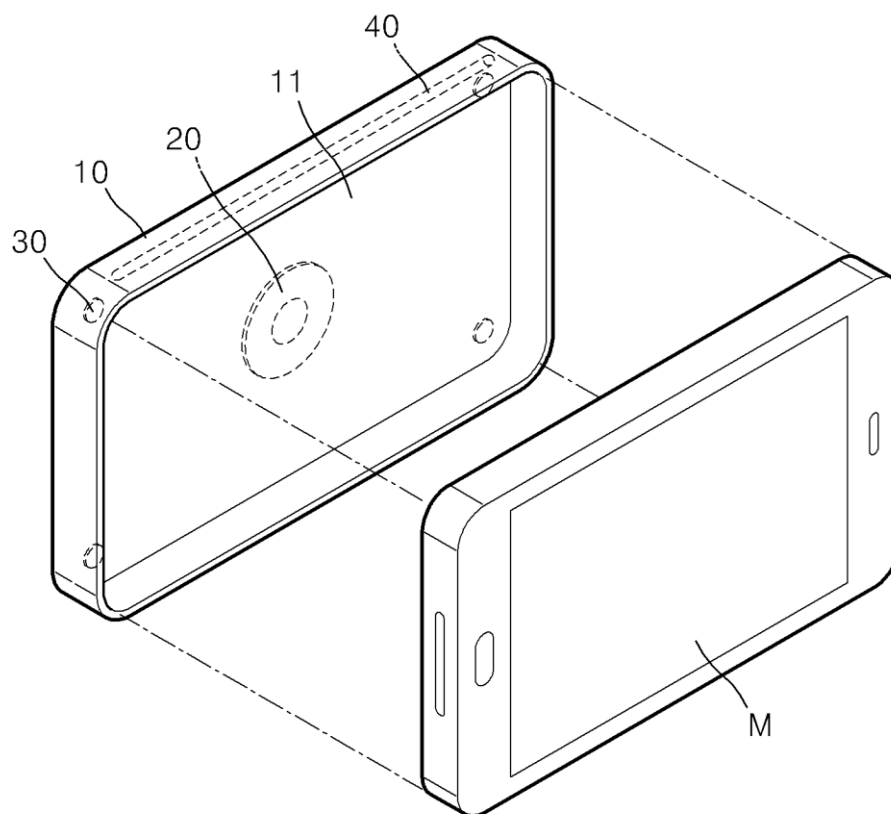
When the object 5708 is implemented as “a key holder such as shown in FIGS. 8B–8C, the object 5708 would have two grooves like guide tracks 814 to be received in two channels 812. As such, ... Rothbaum857 discloses ‘*wherein*

the exterior-facing component [object 5708] comprises a groove [guide tracks 814].” EX1003, ¶185.

B. Ground 2: Claims 1, 7, 19, 20, 22, and 31 Are Obvious under § 103 in view of Rothbaum857 (EX1004) in combination with Byun (EX1006).

1. Overview Of Byun.

Byun is directed “to a mounting unit for a mobile communication terminal.” EX1006, ¶[0001]. One embodiment is depicted in FIG. 1, which is reproduced below.



EX1006, FIG. 1.

As shown above, Byun discloses that the device “comprises: a cover part (10) formed with a coupling groove (11) into which a mobile communication terminal (M), for example, a mobile phone, a smartphone, or a tablet PC” may be held. EX1006, ¶[0017]. The device further includes a “a cover attachment part (20) embedded in a center of a rear surface of the cover part (10); and a plurality of sub magnets (30) installed at corner portions of the rear surface of the cover part (10). At this time, the cover attachment part (20) is implemented as a magnet” and “the sub magnets (30) are illustrated as being installed in four pieces at the corner portions of the rear surface of the cover part (10).” *Ibid.*

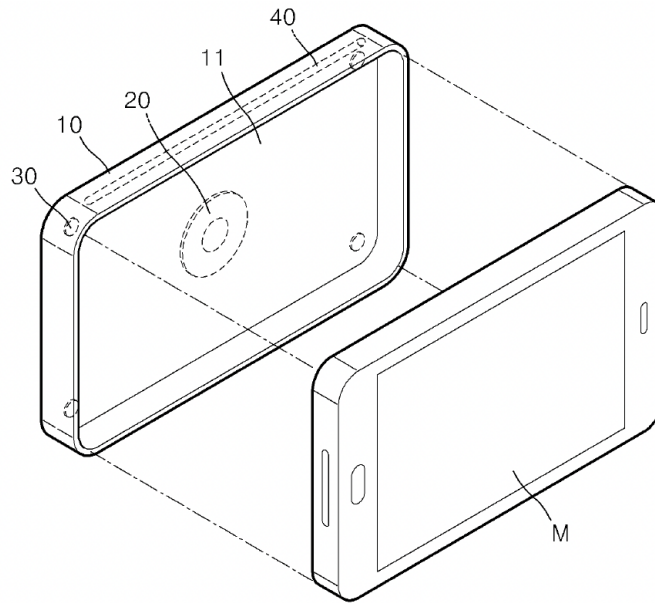
2. Independent Claim 1.

See [1] (Ground 1, Section VI.A.2, incorporated herein). Additionally:

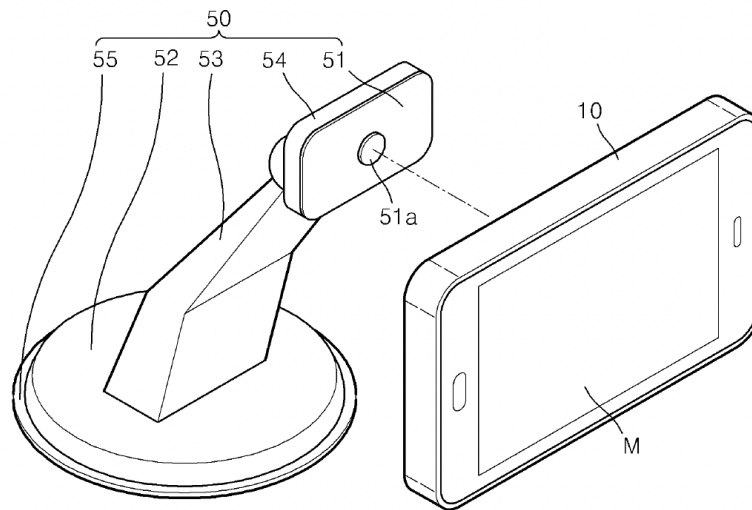
[1q]: “wherein the at least one magnet is configured to attach the mountable case to a magnetic structure”

Claim 1 would have been obvious in view of Rothbaum857 combined with Byun because Byun discloses these limitations. EX1003, ¶186-187.

Figs. 1 and 4 of Byun (reproduced below) show that the magnet in a cover attachment part (20) of a case (10) is configured to attach the case (10) to a magnetic structure (51).



EX1006, Fig. 1



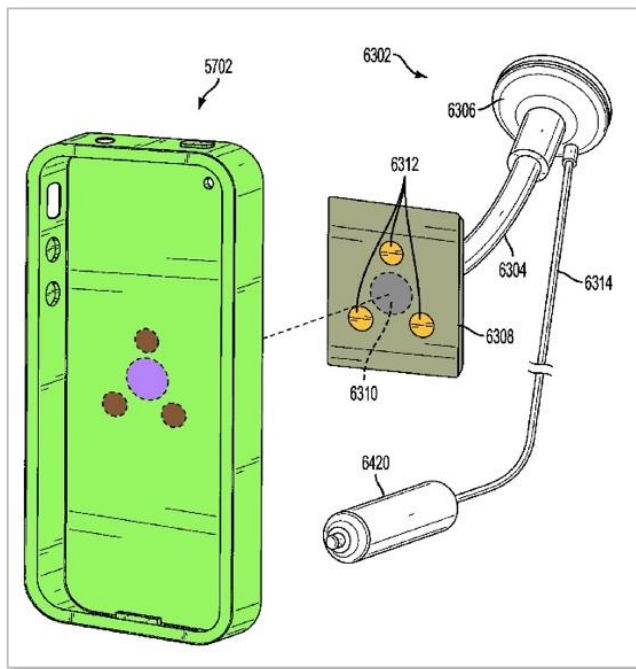
EX1006, Fig. 4

Specifically, Byun discloses: “the mounting unit further comprises a cradle (50) provided with a cradle attachment part (51) to which the cover attachment part (20) is attached” (EX1006, ¶[0010]), and “[w]hen the cover attachment part (20) is implemented as a magnet, the cradle attachment part (51) is made of a

steel piece, and when the cover attachment part (20) is made of a steel piece, the cradle attachment part is made of a magnet. Accordingly, the cover part (10) can be attached to and detached from the cradle attachment part (51) by means of the cover attachment part (20).” EX1006, ¶[0027].

“As disclosed, the mountable case 10 is attached to the magnetic structure (51) via the magnet (20) in the rear wall of the case.” EX1003, ¶189.

Rothbaum857 and Byun both disclose mounting a case to an accessory, as illustrated by a comparison of Fig. 63 of Rothbaum857, reproduced below, in which attachment 6306 is attached to a structure 6302, with Fig. 4 of Byun, shown above, in which magnet 20 is attached to a magnetic structure (cradle attachment 51).



EX1004, Fig. 63

“As such, it would have been obvious to modify the exterior-facing component 6308 in Rothbaum857 with the cover attachment part (20) in Byun. The structure of the cover attachment 20 in Byun is similar to magnetic attachment 6312 of attachment 6308 in Rothbaum857, which would allow the cover attachment part 20 in Byun to be attached to the back of the case, for example, using the attachment method for attaching the attachment 6308 to the back of the case as disclosed in Rothbaum857. For example, cover attachment part (20) in Byun, which can be implemented as a magnet, can also be magnetically (removably) attached to the rear wall of the case as magnet 6312 is. In this modified configuration to Rothbaum857, the magnet 20 (from Byun) will attach the mountable case 5702 to the magnetic structure, such as the cradle attachment part (51) in Byun. A POSITA would have been motivated to so modify the mountable case 5702 of Rothbaum857 to more readily facilitate connection to components such as the cradle attachment part (51) and cradle (50) of Byun.” EX1003, ¶191. The exterior facing member of Rothbaum857 so modified would be able to connect to these additional cradle components while retaining its other features (*supra*, § VI.A.2). *Id.*

Accordingly, the claim limitations “*wherein the at least one magnet is configured to attach the mountable case to a magnetic structure*” would have been obvious over Rothbaum857 in view of Byun.

3. Independent Claim 7.

See Ground 1, Section VI.A.8 (incorporated herein). Additionally:

[7k]: “wherein the cavity of the exterior-facing component is formed at least in part by a curved outer wall, and wherein the outer periphery of the at least one magnet is adjacent to at least a portion of the curved outer wall”

Claim 7 would have been obvious in view of Rothbaum857 combined with Byun. See [1n] Ground 2 (Section VI.B.2.[1n], incorporated herein).

[7n]: “wherein the at least one magnet is configured to attach the mountable case to a magnetic structure”

Claim 7 would have been obvious in view of Rothbaum857 combined with Byun. See [1q] Ground 2 (Section VI.B.2.[1q], incorporated herein).

4. Claim 19

[19]: “wherein the recess of the exterior-facing component is formed at least in part by a curved outer wall.”

These limitations would have been obvious in view of Rothbaum857 combined with Byun for the reasons in [1n] (Ground 2, Sections VI.B.2.[1n] incorporated herein).

5. Claim 20

[20]: “wherein the outer periphery of the at least one magnet is adjacent to at least a portion of the curved outer wall.”

These limitations would have been obvious in view of Rothbaum857 combined with Byun for the reasons in [1n] (Ground 2, Sections VI.B.2.[1n] incorporated herein).

6. Claim 22

[22]: “wherein the at least one magnet is configured to attach the mountable case to a magnetic structure.”

These limitations would have been obvious in view of Rothbaum857 combined with Byun for the reasons in [1q] (Ground 2, Sections VI.B.2.[1q] incorporated herein).

7. Claim 31.

[31]: “wherein the at least one magnet is configured to attach the mountable case to a magnetic structure.”

These limitations would have been obvious in view of Rothbaum857 combined with Byun for the reasons in [1q] (Ground 2, Sections VI.B.2.[1q] incorporated herein).

C. Ground 3: Claims 6, 12, and 36 are obvious under 35 U.S.C. § 103 in view Rothbaum857 in combination with Rothbaum609.

1. Overview Of Rothbaum609.

Rothbaum609 is directed at a cord management system. EX1005, Abstract. Rothbaum609 observed that many users of portable electronic devices

use wired headphones to listen to audio output from such devices. EX1005, ¶[0004]. According to Rothbaum609, wired headphones “can become easily tangled when the portable electronic device is not being used. Rothbaum609 proposed a cord management system that includes a strap to address the issue. EX1005, ¶[0008]. One embodiment is depicted in Figures 31A–31B.

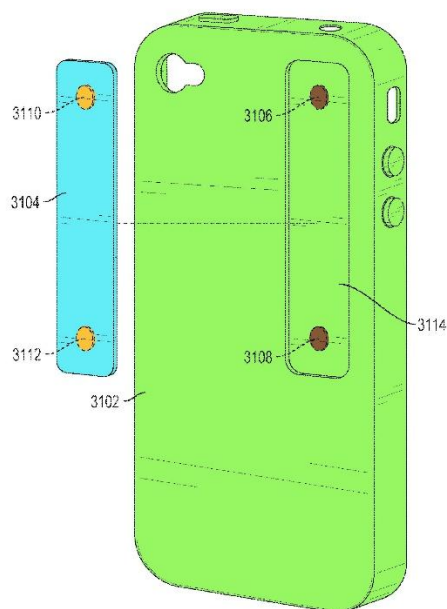


FIG. 31A

EX1005, Fig. 31A

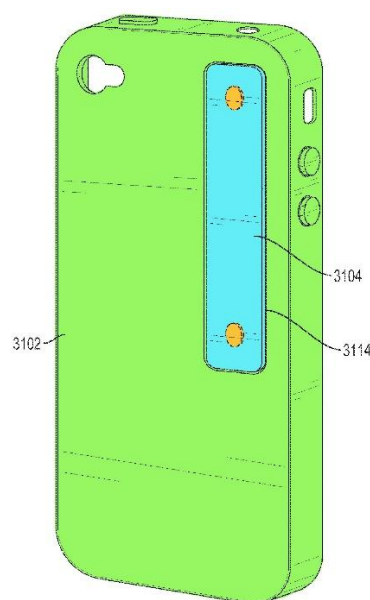


FIG. 31B

EX1005, Fig. 31B

As shown above, a case 3102 (green) includes a magnet 3106 and a magnet or magnetic material 3108. EX1005, ¶¶[0399]–[0400]. A strap 3104 (blue) includes a magnet/magnetic material 3110 and magnet/magnetic material 3112. *Id.* Strap 3104 (blue) attaches to case 3102 (green) through the magnetic forces exerted between magnets 3106 and 3108 (brown) and magnets/magnetic materials 3110 and 3112 (orange), respectively. *Id.* In this configuration, a user is able to wrap a cord, for example of wired headphones, around case 3102

(green) and strap 3104 (blue) and then fold strap 3104 (blue) such that magnet 3112 (orange) connects with magnet 3110 (orange) thereby securing the cord.

FIG. 31A does not illustrate this configuration, but Figure 33F (reproduced below) illustrates a similar configuration of a similar embodiment.

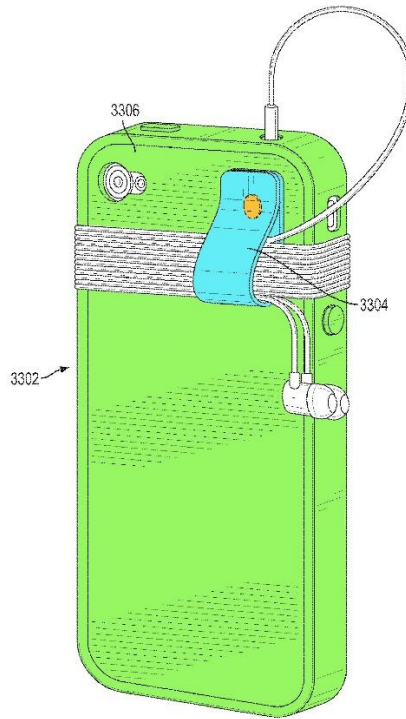


FIG. 33F

EX1005, Fig 33F.

2. Claim 6

[6]: “wherein the exterior-facing component directly contacts the second face of the at least one magnet without an intervening layer.”

See [6] (Ground 1, Section VI.A.7, incorporated herein).

Claim 6 would have been obvious in view of Rothbaum857 combined with Rothbaum609 because Rothbaum609 discloses these limitations. EX1003, ¶¶201-207.

Rothbaum609 discloses attachment of an accessory to the back of a case magnetically. See FIG. 31A of Rothbaum609 (reproduced below), in which a strap 3104 is removably attached to the back of a phone case 3102 via magnetic materials 3110 on the strap and 3106 on the case.

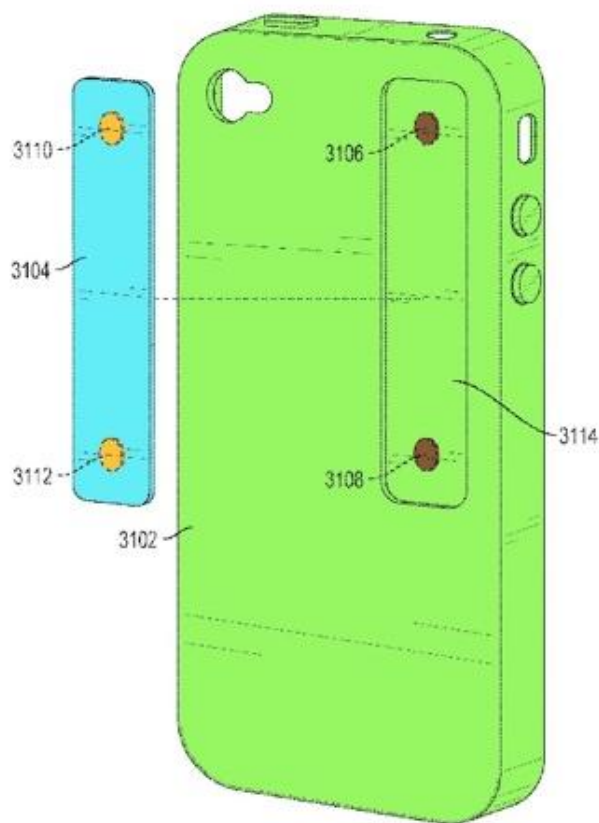
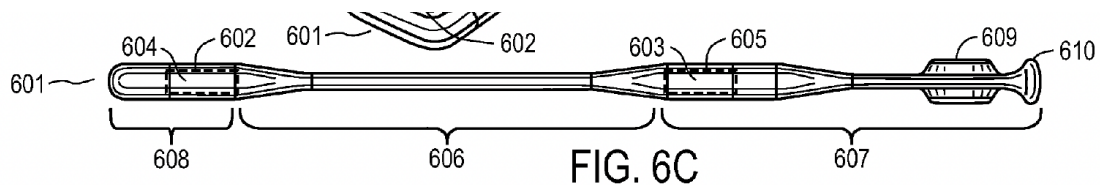


FIG. 31A

EX1005, FIG. 31A

Rothbaum609 discloses that “[i]n some embodiments, case magnet 3106 can comprise multiple magnets or any other configuration, material, or combination of materials that provides a greater magnetic force between case magnet 3106 and strap magnet/magnetic material 3110.” EX1005, ¶[0363].

Rothbaum609 further discloses an attachment method in FIGS. 6A-6C (FIG. 6C of which is reproduced below).



EX1005, FIG. 6C.

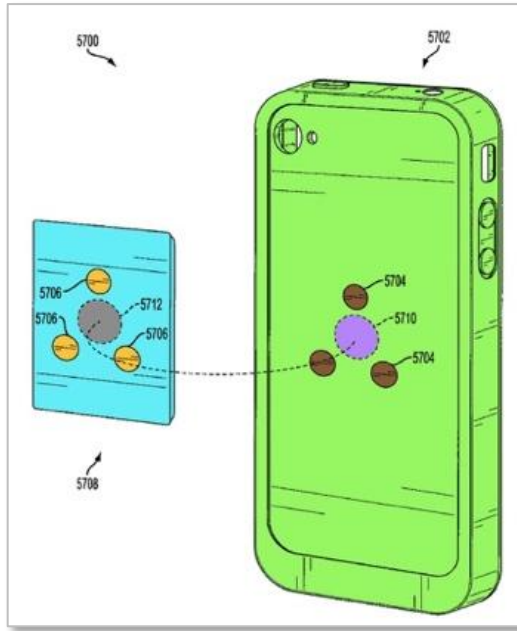
“The attachment method includes encapsulating the magnets 602, 603 into the strap 601.” EX1003, ¶205. For example, Rothbaum609 discloses: “[i]n some embodiments, the magnets 602 and 603 are embedded in the magnetic strap 601. In these embodiments, the magnets 602 and 603 are either enclosed or partially enclosed by the material that forms the magnetic strap 601. As illustrated in FIG. 6C, the material that forms the magnetic strap 601 **forms a gradual contour around the magnets 602 and 603.**” EX1005, ¶[0216]. “As such, a POSITA would have understood that the materials of the strap 601 directly contact the face of magnets 602, 603 by forming around the magnets.” EX1003, ¶205.

“A POSITA would have understood that the attachment methods in FIGS. 6A-6C can be applied to various embodiments in Rothbaum609.” *Id.*, ¶206.

Indeed, the embodiments in FIGS. 31 are related to the embodiments in FIGS. 29. EX1005, ¶[0362] ("FIGS. 31A-31J illustrate an embodiment of a case similar to FIGS. 29A-29I above except that in these embodiments the strap is semi-permanently"); *id.*, ¶[0353] ("[t]he elastic polymers embodiments of the case and strap may be manufactured by processes such as injection molding, casting, compression molding, and die cutting (as discussed above with respect to FIGS. 6A-6C)... the strap magnets/magnetic materials 2906 and 2908 are to be encapsulated in the material of the strap.").

“Thus, the methods in FIGS. 6A-6C can be applied to FIGS. 31 for encapsulating the magnet in a similar manner as FIGS. 6A-6C are applied to FIG. 29.” EX1003, ¶207.

Rothbaum857 and Rothbaum609 both disclose embedding a magnet in an accessory that is removably attached to a case of a mobile phone, as shown by a comparison of attachment 5708 in FIG. 57 of Rothbaum857 with strap 3104 in FIG. 31A of Rothbaum609 (both figures reproduced below).



EX1004, FIG. 57

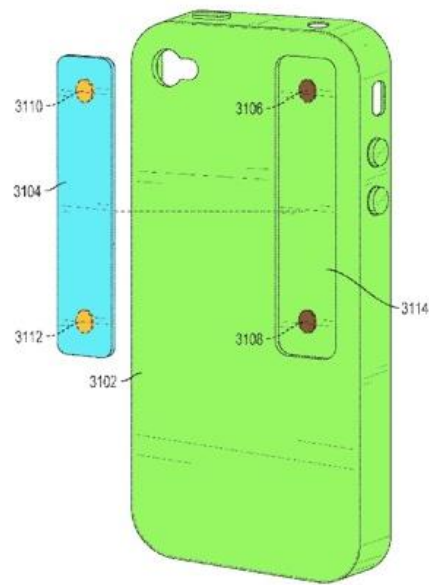


FIG. 31A

EX1005, FIG. 31A

“As shown, attachment 5708 in Rothbaum857 (EX1004) has an embedded magnet 5706, whereas strap 3104 in Rothbaum609 (EX1005) has an embedded magnet 3110. As such, it would have been obvious to use the known technique of FIG. 6C (reproduced below) of Rothbaum609 for enclosing magnet 3110 to strap 3104 for the attachment 5708 in Rothbaum857 to embed magnet 5706 therein.”

EX1003, ¶209.

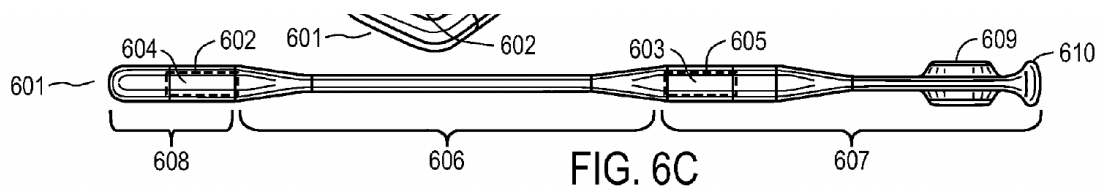


FIG. 6C

EX1010, FIG. 6C

“When applied to attachment 5708, this method will encapsulate the magnet 5706 by forming the materials of 5706 around the magnet, resulting in

directly contacting the magnet without using any adhesive or introducing any intervening layer between the attachment 5708 and the face of the magnet 5706. A POSITA would have been motivated to so modify the attachment 5708 to securely embed the magnet 5706 in the attachment 5708, and to better protect the magnet from contamination, debris, moisture, etc. in the environment.” EX1003, ¶210.

Accordingly, the limitations “*wherein the exterior-facing component directly contacts the second face of the at least one magnet without an intervening layer*” would have been obvious in view of Rothbaum857 in combination with Rothbaum609.

3. Claim 12

[12]: “wherein the exterior-facing component directly contacts the second face of the at least one magnet without an intervening layer.”

These limitations would have been obvious in view of Rothbaum857 in combination with Rothbaum609 for the reasons set forth in the preceding Section VI.C.2 with respect to claim 6.

4. Claim 36

[36]: “wherein the exterior-facing component directly contacts the second face of the at least one magnet without an intervening layer.”

These limitations would have been obvious in view of Rothbaum857 in combination with Rothbaum609 for the reasons set forth in the preceding Section VI.C.2 with respect to claim 6.

VII. THE BOARD SHOULD NOT EXERCISE ITS DISCRETION AND DENY INSTITUTION.

Denial under § 325(d) is not warranted because the challenges presented in this Petition are neither cumulative nor redundant to the prosecution of the '835 Patent (or related patents), as none of Rothbaum857, Rothbaum609, nor Byun were cited or considered by the Examiner during prosecution of the '835 Patent. *See* EX1001, cover. Discretionary denial under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 12 (May 13, 2020) (informative) (“Fintiv”) is not warranted because, *inter alia*, the investment by the parties to date in the related litigation has been relatively minimal, there will not be any overlapping issues because Petitioners will offer a Sotera stipulation that if the Board institutes a trial, they will not raise in district court litigation any grounds that it raised in this IPR petition or reasonably could have raised in the petition, all the defendants in the related litigation are Petitioners in this IPR petition, and the obviousness grounds are very strong.

Petitioners will provide a full explanation of why denial under 325(d) or discretionary denial is not warranted if Patent Owner were to file a request for

such a denial.

VIII. CONCLUSION.

For the reasons set forth above, claims 1-39 of the '835 patent are unpatentable.

Respectfully submitted,

Dated: October 10, 2026

/Gregory J. Gonsalves/
Dr. Gregory J. Gonsalves
Reg. No. 43,639
Law Office of Dr. Gregory J. Gonsalves
2216 Beacon Lane
Falls Church, VA 22043
(571) 419-7252
gregoryjosephgonsalves@gmail.com

Dr. Yue Matthew Ma
Reg. No. 60,925
Princeton IP Law LLC
100 Overlook Center, 2nd Floor
Princeton, NJ 08540
matthew.ma@princetoniplaw.com

CERTIFICATE OF COMPLIANCE

I hereby certify that this brief complies with the type-volume limitations of 37 C.F.R. § 42.24, because it contains 13,538 words (as determined by the Microsoft Word word-processing system used to prepare the brief and including annotated figures), excluding the parts of the brief exempted by 37 C.F.R. § 42.24.

Dated: October 10, 2026

Respectfully Submitted,

/Gregory J. Gonsalves/
Dr. Gregory J. Gonsalves
Reg. No. 43,639
Law Office of Dr. Gregory J. Gonsalves
2216 Beacon Lane
Falls Church, VA 22043
(571) 419-7252
gregoryjosephgonsalves@gmail.com

Dr. Yue Matthew Ma
Reg. No. 60,925
Princeton IP Law LLC
100 Overlook Center, 2nd Floor
Princeton, NJ 08540
matthew.ma@princetoniplaw.com

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 10th day of October, 2026, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by Federal Express Priority Overnight on the following:

Via LLP
373 Summer View
Mission Viejo CA 92692

A courtesy copy of this Petition and supporting material was also served on litigation counsel for Patent Owner via email:

David Kim
Friedland Cianfrani LLP
17901 Von Karman Ave.
Ste 925
Irvine, CA 92614
949-734-7451
Email: david.kim@fciplaw.com

Dated: October 10, 2026

Respectfully Submitted,
/ Gregory J. Gonsalves/
Dr, Gregory J. Gonsalves
Reg. No. 43,639
Law Office of Dr. Gregory J. Gonsalves
2216 Beacon Lane
Falls Church, VA 22043
(571) 419-7252