

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FELLOWES, INC.

Petitioner

v.

TREEFROG DEVELOPMENTS, INC.

Patent Owner

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**IPR2020-01543**

**PETITION FOR *INTER PARTES***  
**REVIEW OF U.S. PATENT NO. 8,564,950 B2**

Mail Stop Patent Board  
Patent Trial and Appeal Board  
P.O. Box 1450  
Alexandria, VA 22313-1450

IPR2020-01543

U.S. Patent No. 8,564,950B2

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**List of Exhibits**

<b>Exh. No.</b>	<b>Description of Exhibit</b>
<b>1001</b>	U.S. Patent No. 8,564,950
<b>1002</b>	Prosecution File History of U.S. Patent No. 8,564,950
<b>1003</b>	District Court Complaint
<b>1004</b>	European Patent No. 1,583,251 (Kuhn)
<b>1005</b>	U.S. Patent Application Publication No. 2008/0316687 (Richardson '687)
<b>1006</b>	U.S. Patent No. 7,050,712 (the '712 Patent)
<b>1007</b>	Japanese Patent Publication 2002-82384 (JP384)
<b>1008</b>	French Patent Publication 2,705,857 (FR857)
<b>1009</b>	U.S. Patent No. 7,090,088 (the '088 Patent)
<b>1010</b>	Declaration of Dr. Charles Garris, Regarding Invalidity of the Challenged Claims of U.S. Patent No. 8,564,950
<b>1011</b>	Answer and Counterclaims from related litigation
<b>1012</b>	Stipulation of Dismissal of counterclaims in related litigation
<b>1013</b>	Petitioner's Invalidity Contentions from related litigation
<b>1014</b>	Patent Owner's Notice of Motion and Motion for Judgment from related litigation
<b>1015</b>	Hearing Transcript dated 2/27/20, relating to the Motion in <b>Exh. 1014</b>
<b>1016</b>	Patent Owner's Notice of Withdrawal, relating to the Motion in <b>Exh. 1014</b>
<b>1017</b>	U.S. Patent Publication 2003/0095374
<b>1018</b>	Dictionary definition for "clasp"

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*Inter partes* review is respectfully requested for claims 17, 19, and 21 of

U.S. Patent No. 8,564,950 (hereinafter the “’950 Patent” - **Exh. 1001**).

**I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(a)(1)**

The following mandatory notices are provided as part of this Petition.

**A. Real Party In Interest Under 37 C.F.R. § 42.8(b)(1)**

Fellowes, Inc. (“Fellowes”) is the real party-in-interest for Petitioner.

**B. Related Matters Under 37 C.F.R. § 42.8(b)(2)**

The ’950 Patent is presently the subject of a District Court Infringement Action brought by the assignee, TreeFrog Developments, Inc. (“TreeFrog” and/or “PO”), and Otter Products, LLC naming Fellowes, Inc. (“Fellowes” and/or “Petitioner”) as a defendant, the Action captioned *Otter Products, LLC., et al., v. Fellowes, Inc.*, Case No.: 1:19-cv-06195 (ND Ill.), hereinafter (the “litigation” – **Exh. 1003**). A Petition for *Inter Partes* Review was filed (IPR2020-00869) against U.S. Patent No. 8,531,834 involved in that litigation with a recorded assignment to the same alleged owner, Treefrog Developments, Inc. A Petition for *Inter Partes* Review (IPR2020-00852) was also filed against U.S. Patent No. 9,498,033 involved in that litigation, which ’033 Patent has a recorded assignment naming Otter Products, LLC as the assignee. A Petition for *Inter Partes* Review (IPR2020-01435) was also filed against U.S. Patent No. 9,660,684 involved in that litigation with a recorded assignment to the same alleged owner, Treefrog

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Developments, Inc. A Petition for *Inter Partes* Review (IPR2020-01469) was also filed against U.S. Patent No. 9,549,598 involved in that litigation with a recorded assignment to the same alleged owner, Treefrog Developments, Inc. That '598 Patent is related to the present '950 Patent by priority. A Petition for *Inter Partes* Review (IPR2020-01509) was also filed against U.S. Patent No. 8,526,180 involved in that litigation with a recorded assignment to the same alleged owner, Treefrog Developments, Inc. That '180 Patent is related to the present '950 Patent by priority.

The Board should note that the issue preclusion issue addressed in Section VII below is relevant to those pending proceedings. The patents in those proceedings and the '950 Patent are all involved in the same litigation. The Patent Owner argued at pages 25-30 of its Preliminary Response in IPR2020-00852, and pages 32-36 of its Preliminary Response in IPR2020-00869 that issue preclusion arises from the related litigation to bar *inter partes* review of the involved patents. Hence, anticipating the same issue will be raised here with respect to this proceeding, Petitioner presented arguments and evidence responsive to that issue herein at Section VII, which are also common to all proceedings for patents involved in that litigation. *See also* Petition in IPR2020-01435, Petition in IPR2020-01469, and Petition in IPR2020-01509, each at Section VII (same arguments and evidence).

**C. Lead and Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)**

Petitioner provides the following designation of counsel:

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**D. Service Information Under 37 C.F.R. § 42.8(b)(4)**

Service of any documents via hand-delivery may be made at the postal mailing address of the respective lead or back-up counsel designated above with courtesy email copies to the email addresses and [docket\\_ip@pillsburylaw.com](mailto:docket_ip@pillsburylaw.com).



## **II. PAYMENT OF FEES UNDER 37 C.F.R. § 42.103**

The undersigned authorizes the Office to charge \$30,500 to Deposit Account No. 033975 for the fee set forth in 37 C.F.R. § 42.15(a) for this Petition. The undersigned further authorizes payment for any additional fees that might be due in connection with this Petition to be charged to the above-referenced Deposit Account.

## **III. SUMMARY OF THE '950 PATENT**

### **A. Description of the Alleged Invention of the '950 Patent**

The '950 Patent is directed to an apparatus for covering a mobile computing device. **Exh. 1001** at claim 17. The patent is not limited to any particular type of mobile computing device, and it states that such devices may be any “electronic device with a touch screen interface, including but not limited to: a computer, a digital tablet computer, a mobile telephone, a personal digital assistant, video recorder, camera, and the like, or as indicated, one or more of the components thereof.” *Id.* at 1:28-34. Indeed, the patent also relates to a housing for protecting a “non-electronic object.” *Id.* at 1:35-36.

Specifically, the '950 Patent claims an apparatus having a bottom member with a channel formed in the perimeter portion, and a gasket positioned within the channel. The '950 Patent also claims a top member comprising a frame that corresponds to an outer perimeter of the electronic device and the perimeter portion of the bottom member, the frame further having a ridge adapted to clasp

within the channel of the bottom member and seal against the gasket. *Id.* at claim 17.

The alleged invention of the '950 Patent further relates to a “switch mechanism” that enables a switch on the device inside the housing to be operated from outside the housing. This is shown in FIGS. 11B and 11E below, where switch mechanism 90 has a part on the outside of the case that can be operated by the user (FIG. 11B), which in turn operates a part on the inside of the case that engages a switch on the device (FIG. 11E). *Id.* at 59:16-24, 60:18-61:43.

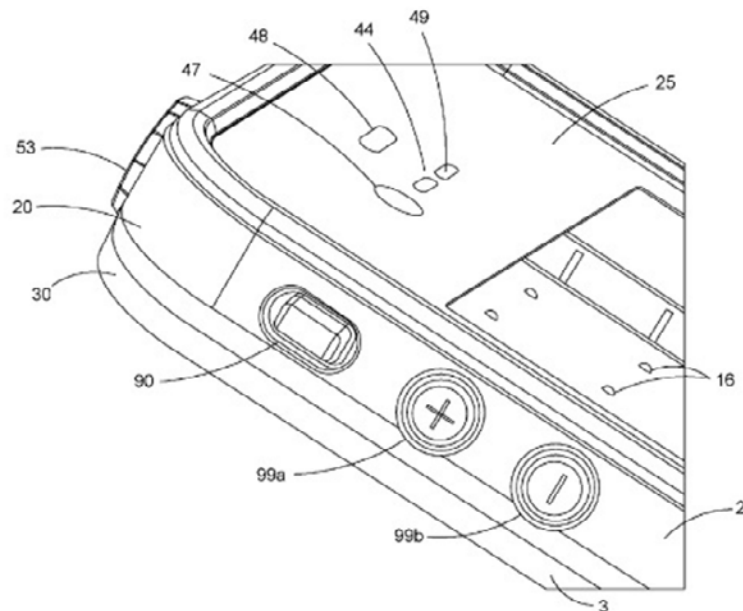
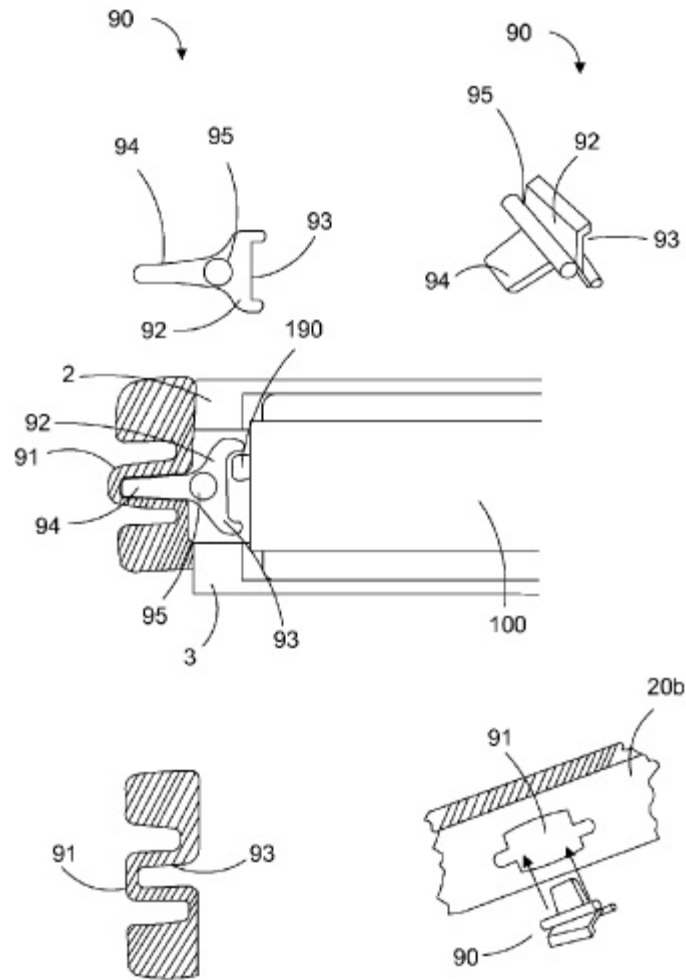


FIG. 11B



### B. Prosecution History of the '950 Patent

The '950 Patent was filed on November 19, 2012 as application Serial No. 13/681,342 (the "'342 Application") and issued October 22, 2013. The '342 Application claims priority to a series of applications with an earliest potential priority date of October 12, 2010.<sup>1</sup> **Exh. 1001** at 1.

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<sup>1</sup> Petitioners do not concede entitlement to this priority date.

During prosecution, the claims were rejected as being indefinite. **Exh. 1002** at 603-04. The claims were also rejected as being anticipated by Wilson et al. (U.S. Patent No. 8,286,789), Stiehl (U.S. Patent No. 8,167,126), and Orr et al. (U.S. Patent No. 7,772,507). *Id.* at 604-05. The claims were further rejected as being obvious over Orr et al. *Id.* at 605-06. The applicant filed a response on May 2, 2013. *Id.* at 242. The Examiner allowed the application on July 17, 2013. *Id.* at 211.

In that May 2013 response, application claim 21 (which issued as claim 17) was amended to add the limitations requiring the encasement to have the “bottom member,” the “top member,” the “channel,” the “gasket,” the “clasp[ing] within the channel” and the “membrane.” *Id.* at 251. In the context of the claim elements defined in the grounds below, those are claim elements 17[d]-[i]. This was done to accept the allegedly allowable subject matter of dependent claim 25. *Id.* at 264 (“claim 25 has been incorporated into claim 21” in section addressing “Allowable Subject Matter”).

The Examiner did not have Kuhn (**Exh. 1004**) of record during the original prosecution, which as discussed *infra* at Section VI.B. teaches every one of those limitations that were the basis for allowing patent claim 17 (application claim 21). Thus, the Examiner did not have the opportunity to consider the teachings of Kuhn. Nor did the Examiner have the opportunity to consider the combination of Kuhn

with the other references cited herein that teach the claimed “switch mechanism” and its related features. Even though the ’712 Patent cited herein (**Exh. 1006**) was of record, the grounds asserted herein are more relevant and thus not cumulative because Kuhn teaches all the elements 17[d]-17[i] allegedly missing from the prior art and thus the reason for allowance of issued claim 17. Further, the Examiner did not deem the “switch mechanism” alone to be patentable by rejecting original application claim 21. **Exh. 1002** at 793-94 (original claim 21) and 604-05 (rejection). Hence the fact that the ’712 Patent teaches that feature cannot be cumulative of the grounds presented herein.

Moreover, the applicants inundated the Examiner with over 275 prior art references, so it is unsurprising the Examiner may have overlooked any such relevant references like the ’712 Patent. *See, e.g., Microsoft Corp. v. Parallel Networks Licensing, LLC*, IPR2015-00483, Paper 10 at 14–15 (July 15, 2015)(instituting IPR despite SWEB95 reference having been considered in a “lengthy Information Disclosure Statement initialed by the Examiner” because “the reference was not applied against the claims and there is no evidence that the Examiner considered the particular disclosures cited by Microsoft in the Petition”).

Further, the Board’s factors for evaluating whether a proceeding should be instituted under §325(d) favor institution. *See, e.g., Becton, Dickinson and Company v. B. Braun Melsungen AB*, IPR2017-01586, Paper No. 8 at 17–18

(December 15, 2017) (designated precedential with regard to Section III.C.5, first paragraph). These include “(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.” *Id.* (footnote omitted).

The following unpatentability analysis below also makes a strong case against the challenged claims, including based on obviousness over Kuhn and the ’712 Patent, as well as other obviousness grounds based on JP384 (**Exh. 1007**) and FR857 (**Exh. 1008**), which were also not cited to the Examiner. Kuhn’s teachings of the claim elements that were the alleged reason for allowance clearly renders that allowance questionable. Petitioner also provides expert testimony (**Exh. 1010**) that the Examiner did not have either. All these facts weigh in favor of institution under the *Becton* factors. *See, e.g., Becton, Dickinson and Company v. B. Braun*

(designated precedential with regard to Section III.C.5, first paragraph).

This Petition is also not duplicative of the District Court litigation because claim 19 is the only claim asserted in that litigation, and this Petition challenges more claims. **Exh. 1013** at 0030.

#### **IV. REQUIREMENTS FOR *INTER PARTES* REVIEW UNDER 37 C.F.R. §§ 42.104**

As set forth below and pursuant to 37 C.F.R. § 42.104, each requirement for *inter partes* review of the '950 Patent is satisfied.

##### **A. Grounds for Standing under 37 C.F.R. § 42.104(a)**

Petitioner hereby certifies that the '950 Patent is available for *inter partes* review and that the Petitioner is not barred or estopped from requesting *inter partes* review challenging the claims of the '950 Patent on the grounds identified herein. More particularly, Petitioner certifies that: (1) Petitioner is not the owner of the '950 Patent; (2) Petitioner has not filed a civil action challenging the validity of a claim of the '950 Patent; (3) this Petition is filed less than one year after the date on which the Petitioner, the Petitioner's real party-in-interest, or a privy of the Petitioner was served with a complaint alleging infringement of the '950 Patent; (4) the estoppel provisions of 35 U.S.C. § 315(e)(1) do not prohibit this *inter partes* review; and (5) this Petition is filed later than nine months after the date of

grant of the '950 Patent, or the date of termination of any post-grant review thereof and/or the '950 Patent is ineligible for post-grant review.

**B. Identification of Challenge Under 37 C.F.R. §42.104(b) and Relief Requested**

The precise relief requested by the Petitioners is that claims 17, 19, and 21 of the '950 Patent be found unpatentable.

1. Claim for Which *Inter Partes* Review Is Requested (37 C.F.R. § 42.104(b)(1))

*Inter partes* review of claims 17, 19, and 21 of the '950 Patent is requested.

2. The Specific Art and Statutory Ground(s) on Which the Challenge Is Based Under 37 C.F.R. § 42.104(b)(2)

*Inter partes* review is requested in view of the following references:

Country of Origin	Patent/Publication Number	Date of issuance or publication	Exhibit
EP	1,583,251 (Kuhn)	2005-05-10	1004
US	2008/0316687 (Richardson '687)	2008-12-25	1005
US	7,050,712 (the '712 Patent)	2006-05-23	1006
JP	2002-82384 (JP384)	2002-03-22	1007
FR	2,705,857 (FR857)	1994-12-02	1008

The earliest alleged priority date for the '950 Patent is October 12, 2010 (Exh. 1001 at 1 – “Related U.S. Application Data”).<sup>2</sup> Each of these above

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<sup>2</sup> Petitioner does not concede entitlement to this priority date.



references was published more than one year prior to that date, qualifying them as prior art under Section 102(b)(pre-AIA).

The following specific grounds of rejection are asserted under Section 103:

Ground	Claims and references
1	Claims 17, 19, and 21 are obvious over Kuhn in view of the '712 Patent.
2	Claims 17, 19, and 21 are obvious over Kuhn and the '712 Patent in view of Richardson '687
3	Claims 17, 19, and 21 are obvious over Kuhn in view of JP384.
4	Claims 17, 19, and 21 are obvious over Kuhn and JP384 in view of Richardson '687.
5	Claims 17, 19, and 21 are obvious over Kuhn and the '712 Patent in view of Richardson '687 and FR857.
6	Claims 17, 19, and 21 are obvious over Kuhn and JP384 in view of Richardson '687 and FR857.

3. How the Challenged Claim(s) Are to Be Construed (37 C.F.R. §42.104(b)(3))

Claim 17 is directed to an apparatus “for a *mobile computing device*” and the claim recites that “apparatus” comprises a number of features that are all elements of the apparatus itself, and not the “mobile computing device.” **Exh. 1001** at claim 17. That indicates the “mobile computing device” is not part of the claim, and instead is an intended use for the claimed “apparatus.” *See, e.g., Ecko Brands, LLC v. Adrian Rivera Maynez Enters*, Appeal No. 2018-2215, 2018-2254, slip op. at 14 (Fed. Cir. Jan. 13, 2020) (“To the extent that claim 8 mentions a beverage brewer, it is only as a ‘reference point’ to define the purpose and structure of the

brewing device. *See C.R. Bard, Inc. v. M3 Sys.*, 157 F.3d 1340, 1350 (Fed. Cir.

1998)"); **Exh. 1010** ¶ 25. More particularly, whether or not the “mobile computing device” has a “touch screen display” is not part of the claim.

The same applies to the reference to the touch screen display in the language “an encasement that enables operation.” That again merely states that the intended use for the encasement or apparatus, and does not define any specific structural features. **Exh. 1010** ¶ 26.

Regardless, even if the claim were interpreted to require the “mobile computing device” to actually have a “touch screen display,” and that “enables operation” imparts some structural limitation that requires the ability to use that touch screen display through the encasement, the challenged claims would still be unpatentable for the reasons discussed below. Thus, while Petitioner believes its interpretation is correct, it does not change the ultimate outcome. **Exh. 1010** ¶ 26.

Petitioner does not believe any other terms warrant specific construction, and all terms should be understood as having their plain and ordinary meaning.

4. How the Construed Claim(s) Are Unpatentable and the Supporting Evidence (37 C.F.R. § 42.104(b)(4) and (5))

Section VI provides an explanation of how the challenged claims of the '950 Patent are unpatentable and the supporting evidence. A list of Exhibits is included above.

**V. BRIEF DESCRIPTION OF PRIOR ART RELIED UPON****A. Kuhn (Exh. 1004)**

Kuhn discloses a waterproof protective encasement for a mobile device, e.g., a phone.<sup>3</sup> Specifically, Kuhn discloses a waterproof top member 10 and a bottom member 11 that couple together to form a waterproof, protective housing for a mobile phone 32. **Exh. 1004** at Abstract, ¶¶ [0051]-[0053]. Kuhn's top member has a frame with an inner perimeter to surround the mobile device 32. **Exh. 1004** ¶¶ [0070]-[0072], [0079], FIGS. 3, 4. The housing has a membrane for operating the device: "The transparent and/or elastic material has the advantage that it allows the use of keys and/or the display of the mobile phone [to be] used." *Id.* ¶ [0019], Fig. 3.

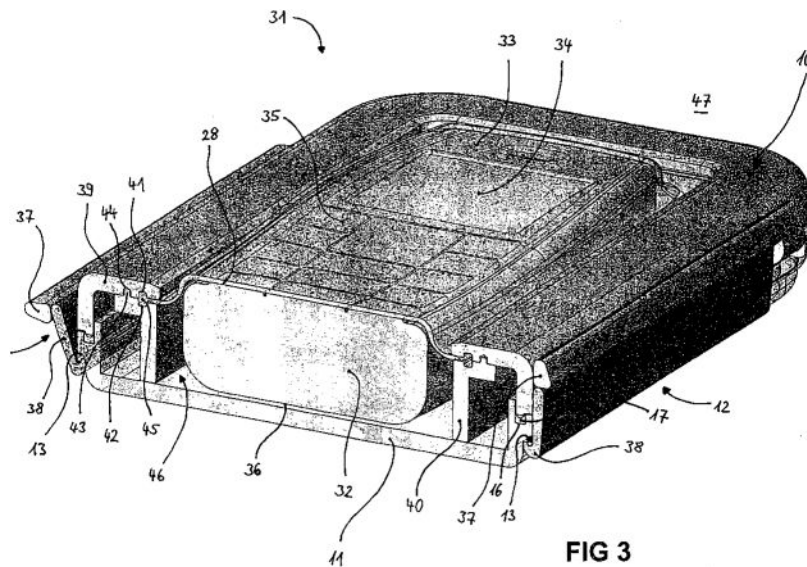
The top member and the bottom member each have clasps or latching mechanisms that fasten the members together. To keep the enclosure waterproof, a seal 17 is positioned in a channel 16, also called a locking groove 16, between the two members. In some embodiments, the "first housing part and the second housing part can engage at least partially form-locking in the connected state." *Id.* ¶ [0034]; *see also id.* ¶¶ [0051], [0056], [0069], [0083] (each describing connecting

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<sup>3</sup> Reference is made to Kuhn's certified translation in **Exh. 1004**.

the top and bottom housing in a “form-fitting” or “form-locking” manner). **Exh.**

**1010 ¶ 31.**



**FIG 3**

Kuhn also teaches the use of the bottom member 11 to enclose the mobile device. **Exh. 1004** at Abstract, ¶¶ [0051]-[0053], FIGS. 3, 5. The bottom member 11 has a lateral side wall 19 around the perimeter with the channel 16 at its upper edge. *Id.* ¶ [0076]. The rubber seal 17 is placed within the channel 16. The protrusion extending from the top member will compress the seal 17 to ensure that the enclosure is waterproofed. *Id.* ¶¶ [0051]-[0053], [0063], [0070]; **Exh. 1010 ¶ 32.**

### **B. Richardson '687 (Exh. 1005)**

Richardson '687 discloses a protective enclosure that provides resistance to water, dust, dirt, and bump protection. **Exh. 1005** at Abstract. For example, Richardson '687 discloses an embodiment that has a “top member” as a front shell 1204 and a “bottom member” as back shell 1324. *Id.* at Figs. 12, 13 and ¶¶ [0046]-

[0047]. The top member 1204 has a touch screen opening 1340. *Id.*; **Exh. 1010 ¶**

33.

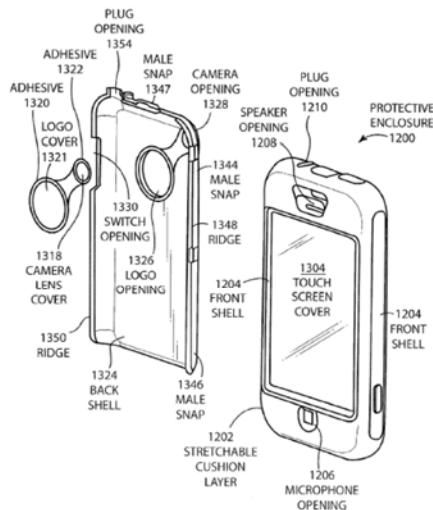


FIG. 12

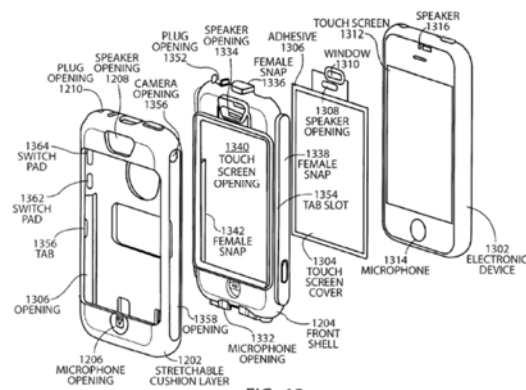


FIG. 13

In addition, Richardson '687 further discloses that its front shell “top member” 1204 and back shell “bottom member” 1324 may be connected by a snap-fit features, including a “tight snap fit” provided by ridges that fit into a groove. **Exh. 1005 ¶** [0047]; **Exh. 1010 ¶** 34.

### C. The '712 Patent (Exh. 1006)

The '712 Patent is directed to a waterproof housing for an electronic device such as a camera, phone, or PDA. **Exh. 1006** at Figs. 2A and 3 (below) and 1:7-10, 3:55-62, 9:1-9; **Exh. 1010 ¶** 35.

FIG. 2A

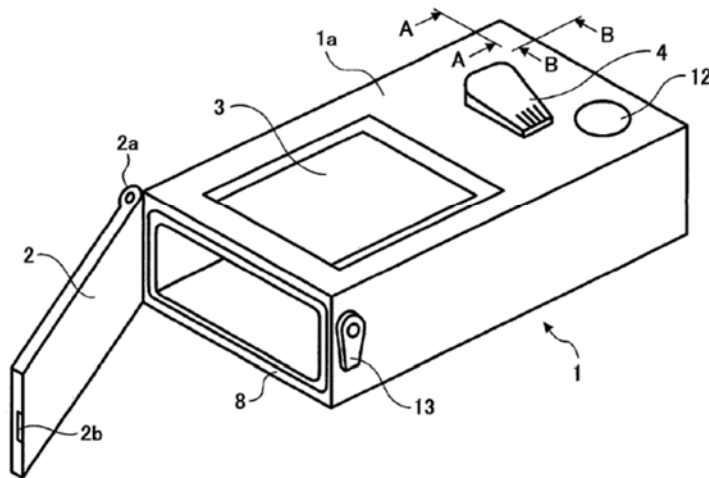
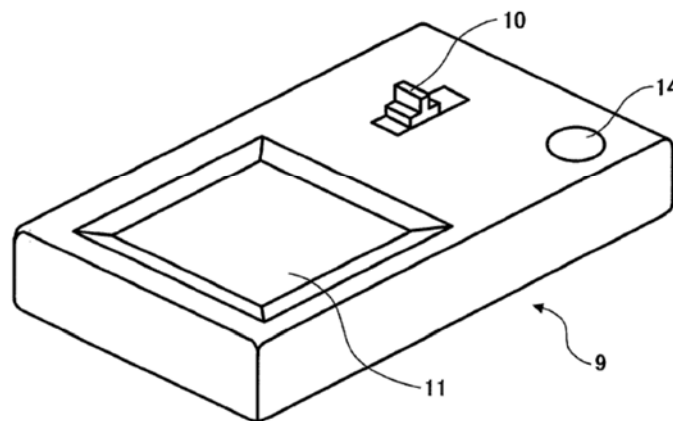
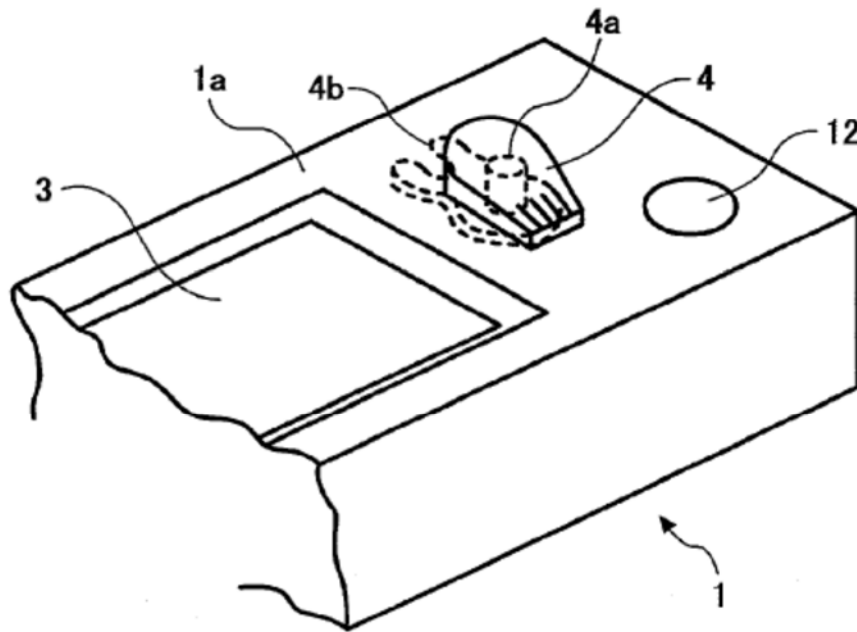


FIG. 3



The '712 Patent also discloses a “switch mechanism.” It includes a user-actuable knob or handle 4 on the case exterior that connects to an interface 4b that engages a control switch 10 on the device, as shown above in Fig. 3 and below in Fig. 2B. **Exh. 1006** at 4:6-20, 5:6-27, 9:1-9; **Exh. 1010** ¶ 36.

FIG. 2B



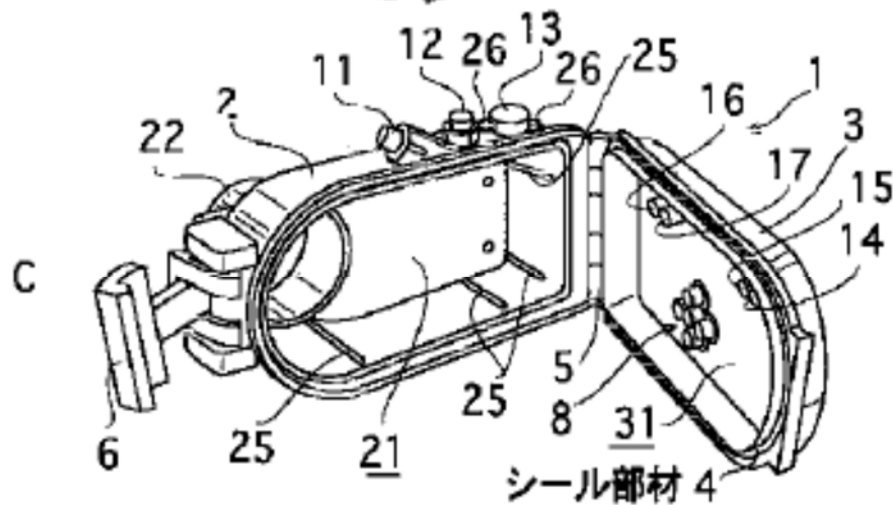
This construction enables the user to operate the switch 10 while encased in the '712 Patent housing by operation of the exterior control 4. **Exh. 1006** at 4:6-20, 5:6-27, 9:1-9; **Exh. 1010** ¶ 37.

**D. JP384 (Exh. 1007)**

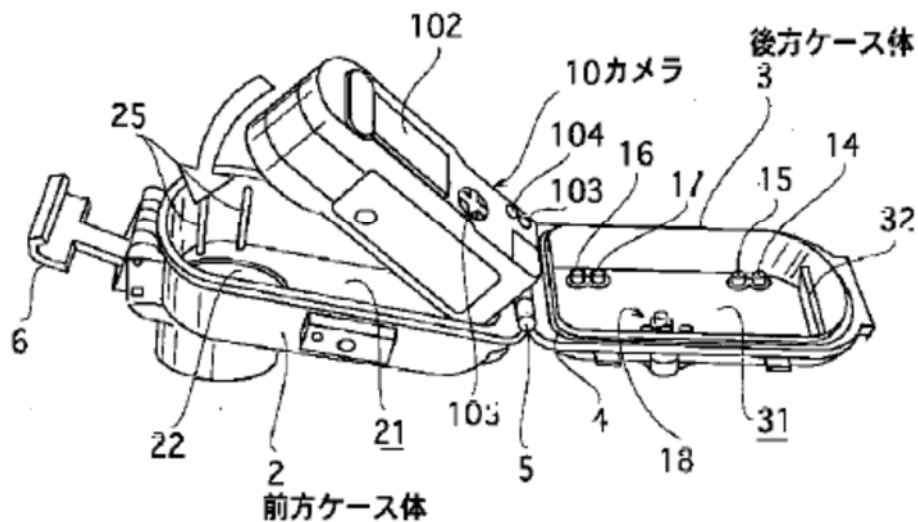
JP384<sup>4</sup> is directed to a housing for an electronic device, such as a camera, which the '950 Patent states may be encased in its housing. **Exh. 1001** at 1:28-34; **Exh. 1007** at Figs. 1 and 2 (below), [0001], [0011], [0013]–[0017], [0035]–[0036]; **Exh. 1010** ¶ 38.

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<sup>4</sup> Reference is made to the certified translation in **Exh. 1007**.

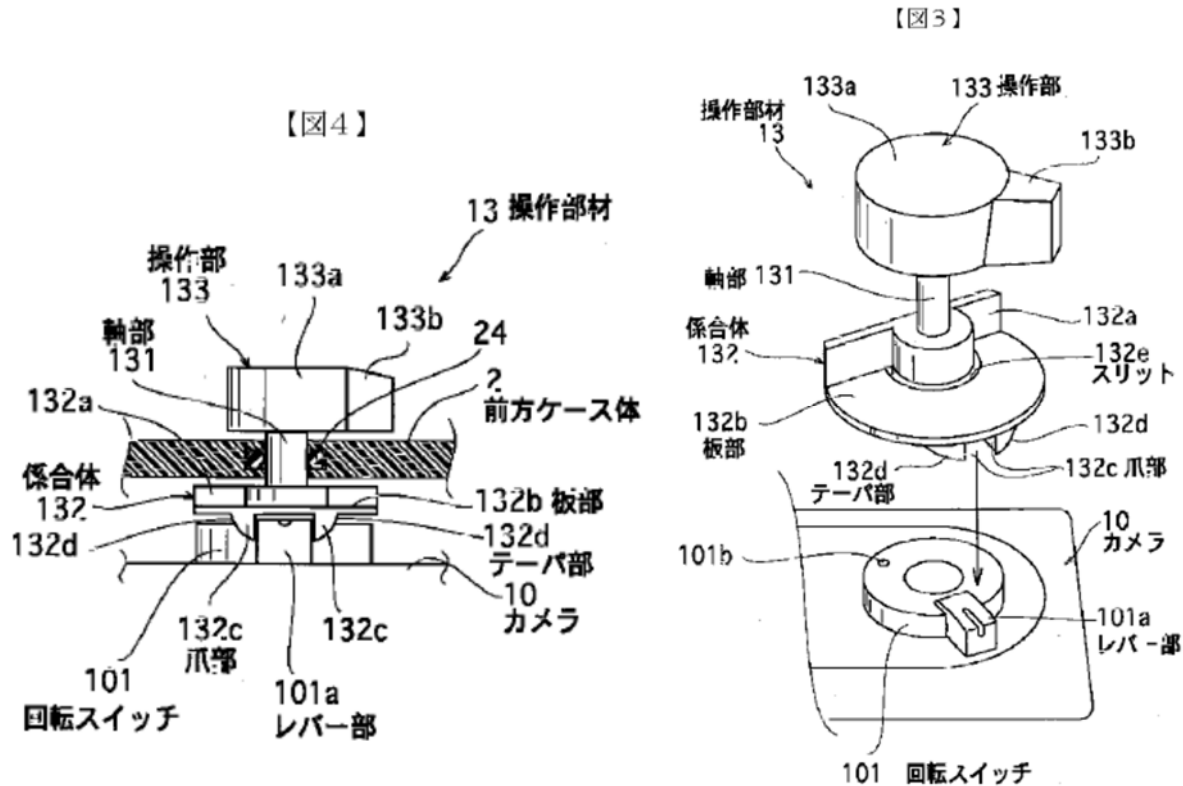


【図2】



JP384 also discloses a “switch mechanism” as recited by challenged independent claim 17. It includes a user-actuable knob or handle 133 on the case exterior that connects to an “engagement body” 132 that engages a control switch 101 on the camera, as shown below in Figs. 3 and 4. **Exh. 1007** ¶¶ [0019]–[0024], [0030]; **Exh. 1010** ¶ 39.





This construction enables the user to operate the camera switch 101 while encased in the JP384 housing by operation of the exterior control 133 to move the switch 101 via a switch engagement body 132 and shaft 131. **Exh. 1007** ¶¶ [0019]–[0024], [0030]; **Exh. 1010** ¶ 40.

#### E. FR857 (Exh. 1008)

FR857 discloses a protective housing for an electronic device that includes a top member attached to a bottom member by a snap-fit connection.<sup>5</sup> **Exh. 1008** at Abstract. The clasp mechanism, or snap, of FR857 includes a lip projecting from the top member that cooperates with a bearing surface on a side wall of the

<sup>5</sup> Reference is made to the certified translation in **Exh. 1008**.

bottom member. *Id.* at FIGS. 2, 4, 6, 1:11-13, 2:3-6, 3:7-13, 5:22-24, 6:4-9, 9:15-

16. To facilitate an adequate seal between the top and bottom members, FR857 discloses the use of clasping means and sealing means within a channel on one member. *Id.*

FR857 discloses a channel containing element 24, which channel is formed between “interior perimeter portion” strip 32 and “exterior perimeter portion” turned-out edge 16 in a perimeter portion of one member. *Id.* at FIGS. 2-4, 6, 8:19-24, 10:4-5. Figure 2 shows the clasping within the channel between element 18 on a ridge on one housing member frame 13 and element 20 on the other member, with the seal element 24 engaged. **Exh. 1010 ¶ 42.**

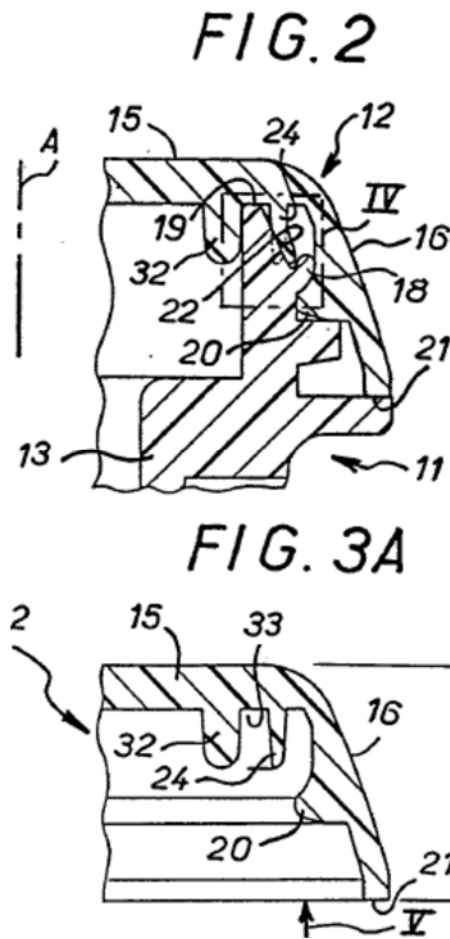
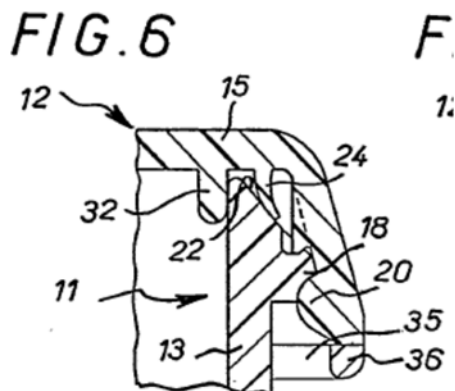


Figure 6 of FR857 illustrates an embodiment in which a ridge of a top member is received in the channel and includes lip and groove clasp mechanisms. Specifically, the rigid frame of one member, i.e., side wall 13, extends to a ridge (the unnumbered part of side wall 13 having support surface 22 and rim 19 that extends into a channel). *See id.* at FIGS. 2, 3B, 4, 6. The ridge has a lip 18 adapted to clasp in groove 20 within the channel of the other member and seal against element 24. *Id.*; *id.* at 5:22-6:3, 6:8-19, 7:12-15, 9:15-16; **Exh. 1010 ¶ 43.**



**VI. DETAILED EXPLANATION OF PERTINENCE AND MANNER OF APPLYING CITED PRIOR ART TO EVERY CLAIM FOR WHICH REVIEW IS REQUESTED UNDER 37 C.F.R. § 42.104(b)**

**A. Field of the Art and the Level of Ordinary Skill**

The field of the claimed invention is directed to a protective apparatus for an object, which objects may include an electronic or a non-electronic object. **Exh.**

**1001** at 1:25-36 and independent claim 17, preamble; **Exh. 1010** ¶ 24. A person of ordinary skill in the art (“POSITA”) as of October 12, 2010 (the earliest potential priority date) would have typically possessed at least a bachelor’s degree in mechanical engineering (or an equivalent degree/experience) with at least two years of experience in designing cases for electronic devices. **Exh. 1010** ¶ 24.

More experience may offset for less education and vice versa. *Id.* The same would be true if the actual filing date of ’950 Patent were used. *Id.* The prior art references discussed herein also reflect the appropriate level of skill in the art at the relevant time. *Chore-Time Equipment Inc. v. Cumberland Corp.*, 713 F.2d 774, 779 n.2 (Fed. Cir. 1983).

The preambles of the challenged claims are drawn to “[a]n apparatus for covering at least part of a mobile computing device.” **Exh. 1001** at claim 17. The analysis below does not change even if the field were determined to be more narrowly tailored to housings for receiving electronic devices. **Exh. 1010** ¶ 24, fn.

1. That is because the prior art cited herein is either a housing for receiving an electronic device, or for a housing that is well-known with features that a person designing a housing for receiving an electronic device would consider as being relevant analogous art. *Id.*; **Exh. 1001** at 1:25-36, 2:14-67. Kuhn, Richardson ‘687, the ‘712 Patent and JP384 are all clearly housings for phones, cameras and other electronic/mobile computing devices, and FR857 is a housing for electrical equipment designed to be secure and waterproof. **Exh. 1010** ¶ 24, fn. 1. Thus, all these references would be subject to consideration by a person designing an electronic device housing because they are in the same or analogous fields. *Id.*

**B. Ground 1: Claims 17, 19, and 21 are Obvious Over Kuhn in view of the ‘712 Patent**

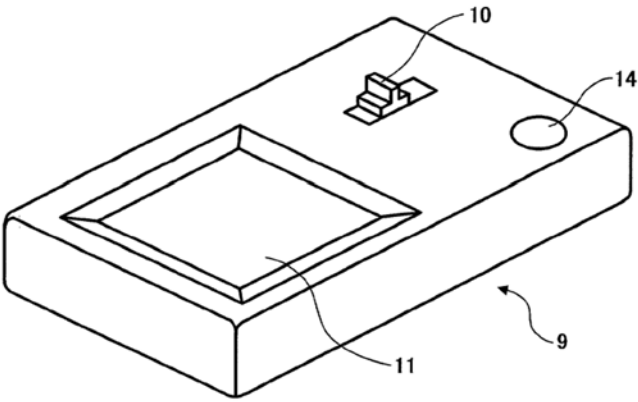
Set forth below is a claim chart comparing the elements of independent claims 17, 19, and 21 to Kuhn and the ‘712 Patent. More detailed arguments on specific limitations follow thereafter.

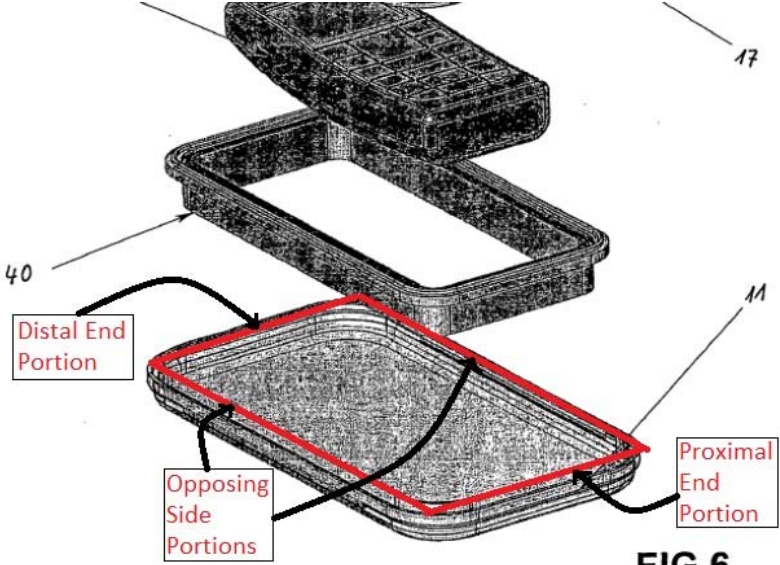
	<u><b>Claim 17</b></u>	<u><b>Prior Art</b></u>
17[a]	17. An apparatus for covering at least part of a	Kuhn discloses an apparatus for covering at least part of a mobile computing device. <i>See</i> <b>Exh. 1004</b> Abstract, ¶¶ [0001], [0013]-[0015], <i>passim</i> ; <b>Exh. 1010</b>

¶ 46. The preamble is not a limitation, and thus a device with a touch screen display is an intended use and not a claim requirement. Even if it is a claim requirement, Kuhn teaches it by disclosing “[a]n apparatus for covering at least part of a mobile computing device [mobile phone 32] having a touch screen display.” **Exh. 1004** at Abstract, [0019] (“The transparent and/or elastic material has the advantage that it allows the use of keys and/or the display of the mobile phone used.”)(emphasis added), Figs. 1-14 (membrane 28); **Exh. 1010** ¶ 46. Kuhn also cites as background art a patent publication that is designed for use with a PDA having a membrane for a touch screen display, namely U.S. Patent Publication No. 2003/0095374 (**Exh. 1017**), and Kuhn identified its alleged invention as improving on that design. **Exh. 1004** ¶¶ [0009]-[0011]. A POSITA would thus understand Kuhn’s housing is disclosed for use with that type of touch screen display device. **Exh. 1010** ¶ 47.

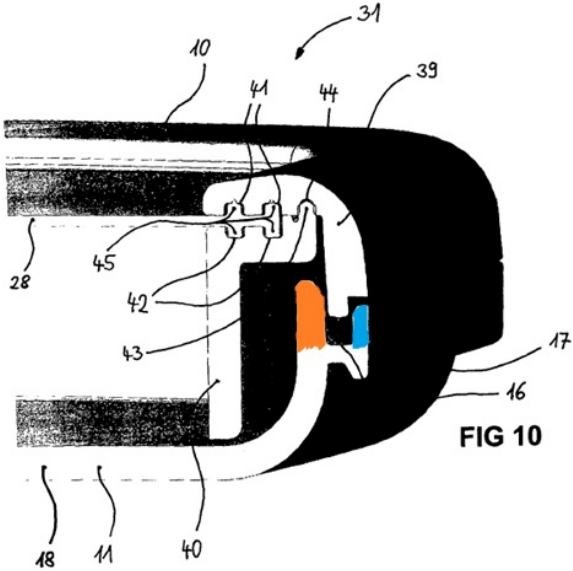


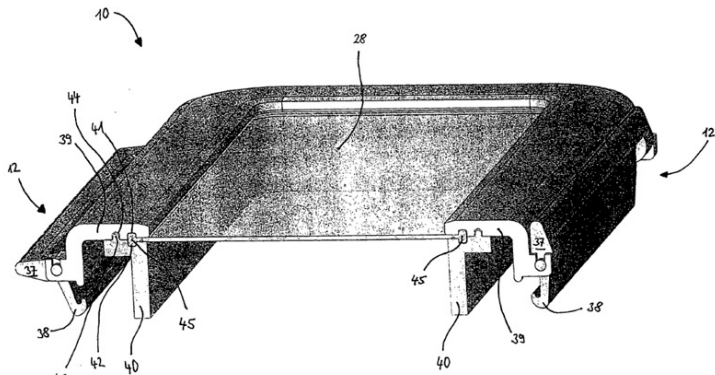
The '712 Patent is a housing 1 for encasing a portable device, such as a camera 9 (Fig. 3), in a waterproof manner, and the camera 9 is a “mobile computing device having a touch screen display [11].” **Exh. 1010** ¶ 48. The '712 Patent discloses that the housing may

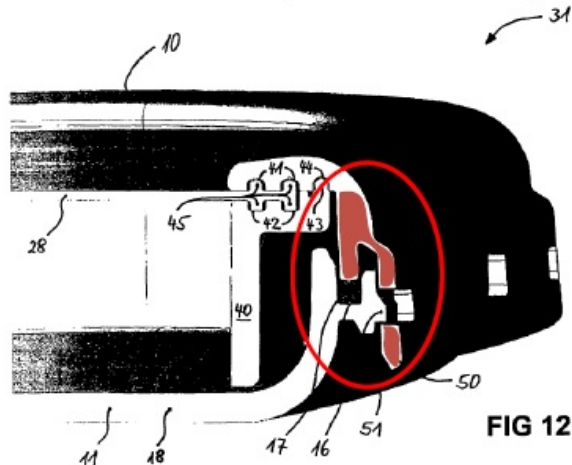
		<p>also be for a PDA, game device or mobile phone, which are also “mobile computing devices.” <b>Exh. 1006</b> at 1:7-10, 9:1-9. That illustrated camera/“mobile computing device” also has “at least one switch [10] that is actuated by a motion that is at least in part lateral to a surface of a housing that houses the mobile computing device.” <i>Id.</i> at 3:55-62; <b>Exh. 1010</b> ¶ 48.</p>  <p>The housing 1 of the '712 Patent “enables operation of the touch screen display [11] and covers at least part of the mobile computing device [9] that includes the at least one switch [10].” <b>Exh. 1006</b> at 5:34-40; <b>Exh. 1010</b> ¶ 50.</p>
17[b]	an encasement that enables operation of the touch screen display and covers at least part of the mobile computing device that includes the at least one switch,	<p>Kuhn discloses embodiments of an encasement to form the housing 31 to enclose a computing device, i.e., mobile phone 32. <i>See</i> <b>Exh. 1004</b> ¶¶ [0001], [0013], <i>passim</i>; FIGS. 3, 6, 7, 9-14. As mentioned above, the membrane 28 on Kuhn allows the device screen to be used, and thus “enables operation of the touch screen display.” <i>Id.</i> ¶¶ [0009]-[0011] (citing <b>Exh. 1017</b> touch screen device case noted above) and [0019]; <b>Exh. 1010</b> ¶ 49.</p> <p>The housing 1 of the '712 Patent is “an encasement that enables operation of the touch screen display [11] and covers at least part of the mobile computing</p>

		device [9] that includes the at least one switch [10].” <b>Exh. 1006</b> at 5:34-40; <b>Exh. 1010 ¶ 50</b> .
17[c]	the encasement having an outer surface and an inner surface,	Kuhn discloses an encasement that has an outer surface and an inner surface. <i>See</i> <b>Exh. 1004</b> FIG. 6 (exploded view showing surfaces); <b>Exh. 1010 ¶ 53</b> .  The housing (encasement) of the ’712 Patent has an outer surface on the outside and an inner surface of the inside; <b>Exh. 1010 ¶ 53</b> .
17[d]	the encasement is comprised of: a bottom member comprising a front surface and a back surface, and surrounded by a perimeter portion defined by a proximal end portion, a distal end portion, and opposing side portions,	Kuhn discloses an encasement that includes using both a “top member” and a “bottom member” for being coupled together to form the housing 31. <i>See</i> <b>Exh. 1004 ¶¶ [0001], [0013], passim</b> ; FIGS. 3, 6, 7, 9-14. Each of the top member 10 and the bottom member 11 disclosed in Kuhn have a front surface and a back surface, further defined by a perimeter portion having a proximal end portion, a distal end portion, and opposing side portions. <i>See id.</i> at FIGS. 1, 3, 6.   <p style="text-align: right;"><b>FIG 6</b></p> <p><b>Exh. 1010 ¶ 54.</b></p>
17[e]	the perimeter portion of the bottom member	Kuhn discloses a channel 16 formed in the connection area between the exterior perimeter portion, i.e., outer wall and interior perimeter portion, i.e., inner wall on

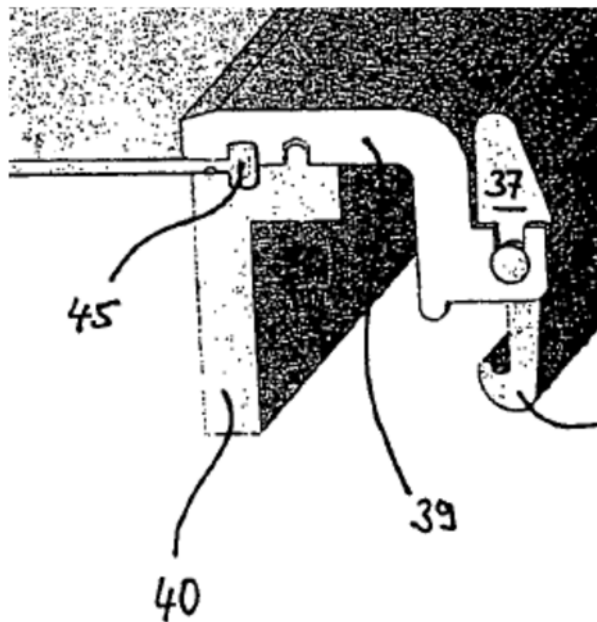


	having a channel formed by an interior perimeter portion and an exterior perimeter portion,	<p>the bottom member. <i>See</i> <b>Exh. 1004 ¶¶</b> [0055], [0063], [0076], [0078], [0091], FIGS. 3, 5 and 10 (the bottom member disclosed in Kuhn includes an inner wall, highlighted in orange, spaced apart from the outer wall, highlighted in blue).</p>  <p><b>Exh. 1010 ¶¶</b> 55-57.</p>
17[f]	the channel including a compressible gasket positioned therein; and	<p>Kuhn discloses a seal 17, i.e., a “compressible gasket,” disposed in the channel 16 and between the first member 10 and the second member 11 when they are mated together. <i>See</i> <b>Exh. 1004 ¶¶</b> [0055], [0063], [0069], [0070], [0076], [0078], [0091], FIGS. 3, 9-14; <b>Exh. 1010 ¶</b> 58.</p>
17[g]	a top member having an inner perimeter defined by a rigid frame that corresponds to an outer perimeter of the electronic device and the perimeter	<p>The top member 10 disclosed in Kuhn has an inner perimeter defined by a rigid frame, i.e., sealing frame 40/frame element 39, that corresponds to an outer perimeter of the electronic device. <i>See</i> <b>Exh. 1004 ¶¶</b> [0013], [0014] (phone prevented from sliding “back and forth inside the housing”), [0033], [0040], [0050], [0071], [0072], [0085], FIGS. 3, 4 (fitted within the sealing frame 40), 6, 11, 12. The rigid frame also corresponds to the perimeter of the bottom member. <i>Id.</i> ¶¶ [0050]-[0052], [0067], [0068], [0074]; <i>id.</i> FIGS.</p>

	portion of the bottom member,	<p>3, 4 6, 7-14. They are each generally rectangular and correspond to one another in shape.</p>  <p><b>FIG 4</b></p> <p><b>Exh. 1010 ¶ 59.</b></p>
17[h]	the rigid frame extending to a ridge that is adapted to clasp within the channel of the bottom member and seal against the gasket,	<p>Kuhn discloses a channel 16 that has the gasket 17 to “seal against” the bottom ridge of the top member’s rigid frame when the top member and bottom member are coupled together to seal the housing 31. <i>See Exh. 1004 ¶¶ [0055], [0063], [0069], [0070]. Exh. 1010 ¶ 60.</i></p> <p>Kuhn’s “ridge” extends down from the rigid frame on part 39 for receipt in the channel, as shown in the red highlight below. <i>See Exh. 1004 at FIG. 4.</i> Closure element 50 latches or clasps when mated with closure element 51 on the bottom member, such that the members may be fastened together. <i>Id.</i> ¶¶ [0084], [0085]. That results in the ridge clasping within the channel on the bottom member to seal against the gasket. <b>Exh. 1010 ¶ 61.</b> The ridge is part of the clasping provided by closure elements 50/51, as it hooks into the channel 16 to cooperate as part of the securement. <i>Id.</i></p>

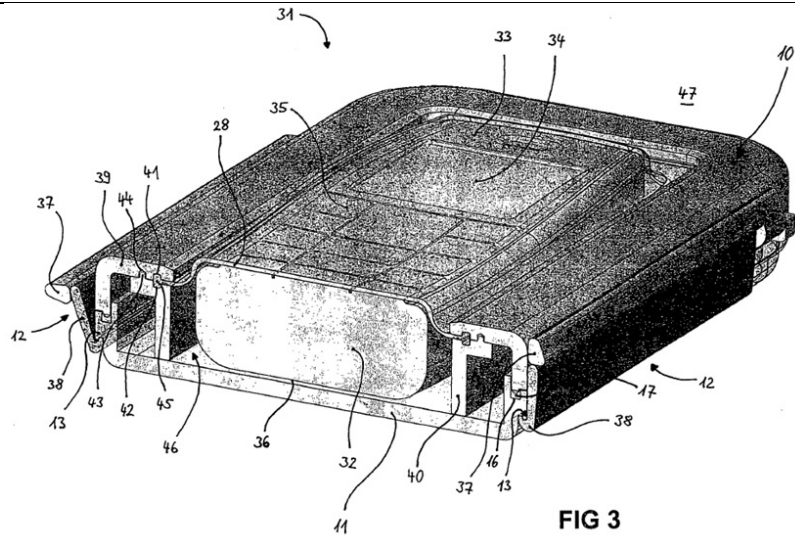


An excerpt from Fig. 4 below shows another example of a ridge at the end of wall 39 that clasps within the channel 16. **Exh. 1010 ¶ 62.**

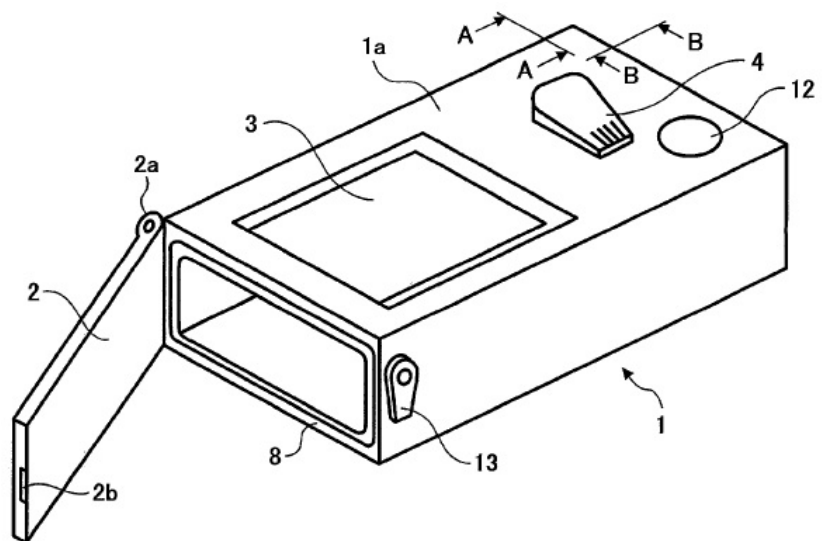


In addition to teaching the positive “catch” type clasping mechanisms like 50/51, Kuhn also discloses that the “first housing part and the second housing part can engage at least partially form-locking in the connected state.” **Exh. 1004 ¶ [0034]; see also id. ¶¶ [0051], [0056], [0069], [0083]** (each describing connecting the top and bottom housing in a “form-

		<p>fitting” or “form-locking” manner); <b>Exh. 1010 ¶ 63</b>. As an example, Kuhn discloses an embodiment in which the ridge itself cooperates with surfaces of the channel 16 on the bottom member (i.e., the ridge is “form-fitting” or “form-locking” with the groove), and thus is adapted to clasp within the channel. <i>See Exh. 1004</i> at FIG. 3. Paragraphs [0055] and [0056] refer to the groove/channel 16 as a “locking groove” and “fastening groove,” and discuss how a web of the top housing part 10 is “fixed between” the channel side walls to be “form-fitting connected with each other.” <i>See id.</i> ¶¶ [0063], [0076], [0078], [0091] (“closing groove,” “closure groove” and “locking groove”). That also meets “a ridge that is adapted to clasp within the channel of the bottom member and seal against the gasket.” <b>Exh. 1010 ¶ 65</b>.</p>
17[i]	the top member further including a membrane that overlays the rigid frame opposite the ridge, the membrane having a transparent area,	<p>Kuhn discloses a “membrane,” i.e., film 28, that overlays the top member. <i>See Exh. 1004 ¶¶</i> [0071], [0074], [0085]. The film 28 is mated with the rigid frame 39 and extends from the proximal end portion to the distal end portion and across the opposing side portions of the top member. <i>Id.</i>; FIG. 3. Kuhn discloses a housing for an electronic device that has a transparent membrane. <i>See id.</i> ¶¶ [0005], [0013], [0014], [0017], [0019]; <b>Exh. 1010 ¶ 69</b>. That membrane is also “opposite the ridge” because it is on top, whereas the “ridge” is on the frame bottom for receipt in channel 16. <b>Exh. 1010 ¶ 69</b>.</p>



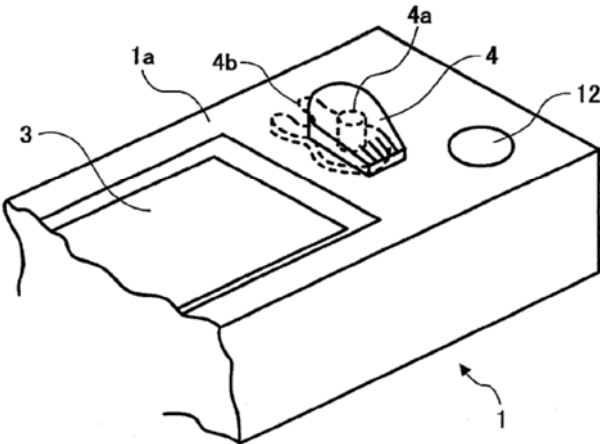
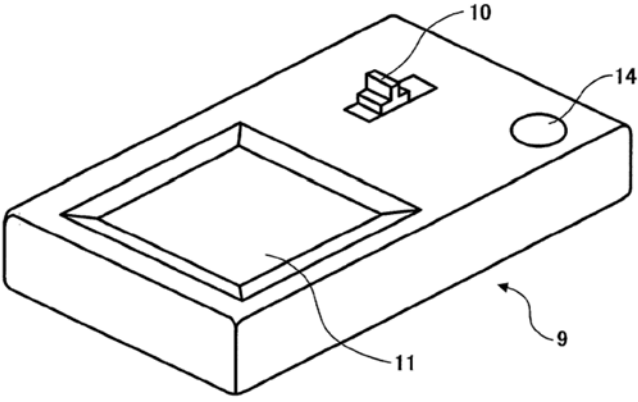
The '712 Patent teaches that element 3 for the touchscreen is a “transparent and flexible material such as plastic” that enables the user to see and operate the touchscreen 11 on the camera 9. **Exh. 1006** at 5:34-40, FIG. 2A. That teaches the use of a “membrane having a transparent area” limitation. **Exh. 1010 ¶ 70.**



17[j]

the top member further including a switch mechanism; and the switch

The '712 Patent has a switch mechanism as shown in Fig. 2B. The switch mechanism “include[es] a switch actuator [4] at the outer surface of the encasement.”

	<p>mechanism including a switch actuator at the outer surface of the encasement, and</p>	<p style="text-align: center;"><b>FIG. 2B</b></p>  <p><b>Exh. 1006</b> at 4:5-20, 5:6-27, 9:1-9; <b>Exh. 1010</b> ¶ 72.</p>
<p>17[k]</p>	<p>a switch interface being provided proximate the inner surface of the encasement to contact the at least one switch of the mobile computing device and being coupled with the switch actuator such that a movement of the switch actuator controls a movement of the switch interface to actuate the at least one switch of the mobile computing device.</p>	<p>The switch mechanism of the '712 Patent also includes the claimed “switch interface” at 4b.</p> <p>That “switch interface” 4b is “provided proximate the inner surface of the encasement,” as shown in Fig. 2B above. The “switch interface 4b” has a forked shape that “contact[s] the at least one switch of the mobile computing device [i.e., a camera].” As can be seen in Fig. 3, the camera has a switch 10. <b>Exh. 1010</b> ¶ 73.</p>  <p>The “switch interface 4b” is coupled with the switch actuator” 4 by a shaft 4a, as shown in Fig. 2B. As a</p>

		<p>result, “a movement of the switch actuator [4] controls a movement of the switch interface [4a] to actuate the at least one switch [10] of the mobile computing device.”</p> <p><b>Exh. 1006</b> at 4:5-20, 5:6-27, 9:1-9; <b>Exh. 1010</b> ¶ 74.</p>
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	<u><b>Claim 19</b></u>	<u><b>Prior Art</b></u>
19[a]	19. The apparatus in accordance with claim 17,	See the analysis above for claim 17.
19[b]	wherein the encasement includes an aperture, and the switch actuator protrudes through the aperture.	The '712 Patent shows an aperture with shaft 4b extending therethrough from “switch actuator” 4. <b>Exh. 1006</b> at 4:5-20, 5:6-27, 9:1-9; <b>Exh. 1010</b> ¶ 78.

	<u><b>Claim 21</b></u>	<u><b>Prior Art</b></u>
21[a]	21. The apparatus in accordance with claim 17,	See the analysis above for claim 17.
21[b]	wherein the bottom member includes at least one lens formed between the front surface and the back surface of the bottom member.	<p>Kuhn discloses its bottom member 11 may have a partial area 23, which forms a lens through which the lens of a camera of the mobile phone can see through. <b>Exh. 1004</b> at ¶¶ [0002],[0011], [0013], [0018], [0020], [0024], [0025], [0058]-[0060], [0064], [0077], [0080], claims 1, 3, 16, 18, 19. Because that lens is part of the bottom member 11, it is formed between the front surface and back surface of the bottom member. <b>Exh. 1010</b> ¶ 83.</p> <p>Although not shown, a lens is included in the “bottom member” of the '712 Patent housing because that is the</p>

		front wall of the housing that the camera lens/aperture faces. <b>Exh. 1010 ¶ 84.</b>
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1. Claim 17

As can be seen from the above claim chart, Kuhn satisfies claim element 17[a] by disclosing an apparatus for covering at least part of a mobile computing device. *See* **Exh. 1004** Abstract, Fig. 3; **Exh. 1010 ¶ 46**. The mobile computing device and the “touch screen display” thereof recited by the preamble is not a limitation of the claim for the reasons stated in Section IV.B.3. above. Even if the mobile computing device were an element of the claims, Kuhn discloses such a device, and states that the transparent and/or elastic material spanning the top of the phone (Fig. 3, numeral 28), allows the use of keys and/or the display, thereby indicating the display can be a touch screen display. **Exh. 1004 ¶ [0019]** (“The transparent and/or elastic material has the advantage that it allows the use of keys and/or the display of the mobile phone used [sic].”)(emphasis added), Figs. 1-14 (membrane 28); **Exh. 1010 ¶ 46**.

Further, Kuhn cites as background art a patent publication that is designed for use with a PDA having a membrane for a touch screen display, namely U.S. Patent Publication No. 2003/0095374 (**Exh. 1017**), and Kuhn identified its alleged invention as improving on that design. **Exh. 1004 ¶¶ [0009]-[0011]; Exh. 1017 e.g., ¶¶ [0011], [0014], Figs. 1, 6, 7, 12** (touch screen membrane 110, 1214),



Abstract, Title. That discloses to a POSITA that a device housing like Kuhn's may be used for already known electronic devices with touch screens, confirming it meets the preamble "touch screen display" language (to the extent it is a limitation). **Exh. 1010** ¶ 47.

Likewise, as mentioned above in the chart, the membrane 28 on the housing ("encasement") disclosed by Kuhn allows the device screen to be used while encased in the apparatus, and thus "enables operation of the touch screen display." That also satisfies claim element 17[b] to the extent the touch screen display language relating to the device is a limitation. **Exh. 1004** ¶¶ [0009]-[0011] (citing **Exh. 1017** touch screen device case noted above) and [0019]; **Exh. 1010** ¶ 49.

Moreover, to the extent it is alleged that Kuhn does not teach a device with a touch screen display or an encasement that enables operation of the same (and to the extent those requirements are limitations rather than intended use language), the '712 Patent has one and its housing enables the operation of a touch screen display. **Exh. 1006** at 5:34-40; **Exh. 1010** ¶ 50. A POSITA would have been motivated to use Kuhn's membrane 28 for operation of a "touch screen display" in view of the '712 Patent because both disclose waterproof encasements for mobile phones, and the '712 patent teaches that a touch screen display can be operated through a "transparent and flexible material" at 3, i.e., a membrane. **Exh. 1004** at Title; **Exh. 1006** at 1:7-10, 5:34-40; **Exh. 1010** ¶ 51. Thus, a POSITA would have

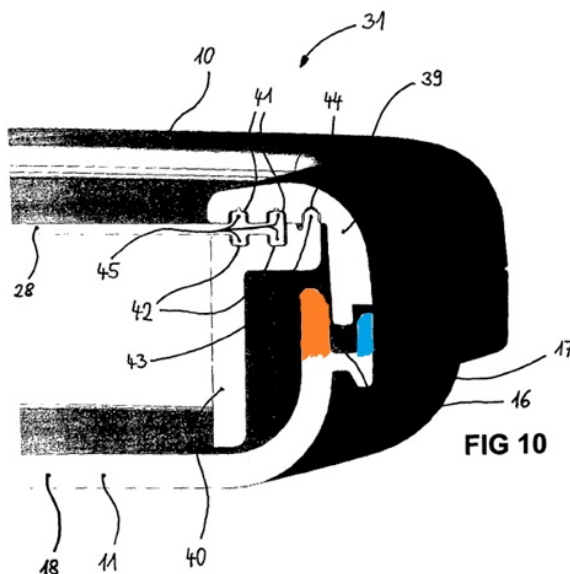
found it obvious to configure Kuhn, to the extent not already configured to do so, to enable use of a mobile phone having a touch screen display while it is encased in the waterproof encasement. **Exh. 1010 ¶ 52.** A key consideration in designing a protective encasement for a device is that the features of the device dictates the features of the encasement, such as its dimensions, access to control features, etc. **Exh. 1010 ¶ 52.** The '712 Patent teaches that such cases can be used with devices having a touch screen display, and thus it would be obvious when designing a case with the features of Kuhn to frame that touch screen display so it can be seen and used through the membrane 28 while still inside the case. *Id.* A POSITA would also be motivated by Kuhn's reference in its background to already-existing housings for computing devices with touch screen displays operated through a membrane, as that teaches such devices were known, predictable technology and that housings like Kuhn's can be used with such devices. **Exh. 1004 ¶¶ [0009]-[0011]** (citing **Exh. 1017** touch screen device case noted above) and [0019]; **Exh. 1010 ¶ 52.**

FIG. 6 of Kuhn illustrates an exploded view of the mobile computing device encasement, showing an outer surface and an inner surface, satisfying claim element 17[c]. **Exh. 1010 ¶ 53.**

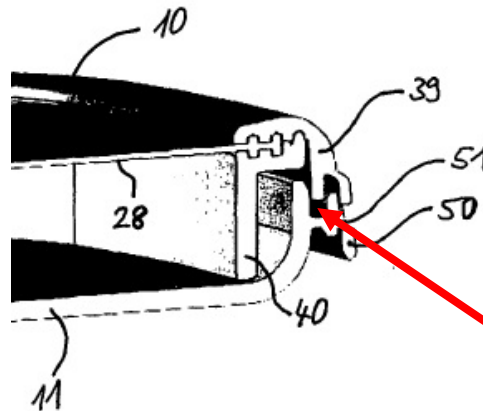
Kuhn fully discloses claim element 17[d] by disclosing an encasement that has both a "top member" and a "bottom member" for being coupled together to

form a housing. **Exh. 1004** ¶¶ [0001], [0013], FIGS. 3, 6, 7, 9-14. Both the top member and the bottom member disclosed by Kuhn have a front and a back surface and are further defined by a perimeter portion defined by a proximal end portion, a distal end portion, and opposing side portions. *Id.* at FIGS. 1, 3, 6; **Exh. 1010** ¶ 54.

Kuhn also discloses a channel 16 formed between an “interior perimeter portion” and an “exterior perimeter portion” of the bottom member, satisfying claim element 17[e]. *Id.* at FIG. 10 (reproduced below; the interior perimeter portion is highlighted in orange and the exterior perimeter portion is highlighted in blue); **Exh. 1010** ¶ 55.



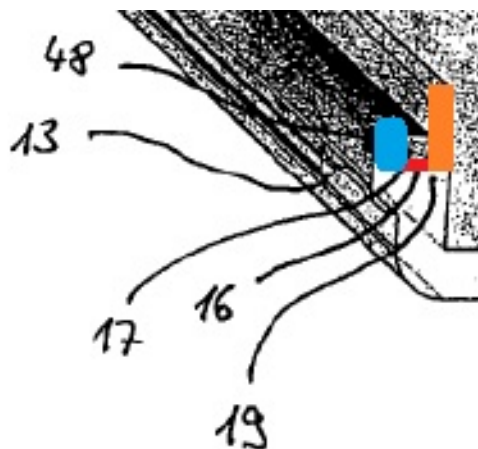
Interior and exterior perimeter portions forming a channel in the bottom member are also illustrated in annotated FIG. 11 below:



**FIG 11**

Interior perimeter portion, highlighted in orange, spaced apart from the exterior perimeter portion, highlighted in blue, forming a channel (underlined in red) in the bottom member are also illustrated by the embodiment of FIGS. 3-5.

*See id.* ¶¶ [0055], [0063], [0075], [0078] (“closing groove 16”), [0091]; **Exh. 1010** at 57; annotated FIG. 5:



The seal 17 disclosed in Kuhn and shown, for example, in FIG. 10 (above) is a “compressible gasket” positioned within the channel, satisfying claim element 17[f]. **Exh. 1010** ¶ 58.

Kuhn also satisfies claim element 17[g]. The top member 10 disclosed in Kuhn has an inner perimeter defined by a rigid frame, i.e., sealing frame 40/frame element 39, that corresponds to an outer perimeter of the electronic device. *See Exh. 1004* ¶¶ [0067], [0068], [0074]; FIG. 4 (fitted within sealing frame 40). The rigid frame also corresponds to the perimeter portion of the bottom member because they both have matching rectangular shapes. *Id.*; **Exh. 1010** ¶ 59.

Kuhn also discloses that the rigid frame extends to a “ridge that is adapted to clasp within the channel of the bottom member and seal against the gasket,” thereby satisfying claim element 17[h]. The “ridge” or protrusion extends down from the top member. *See Exh. 1004* at FIG. 4. The ridge clasps within the channel to mate the top and bottom members. More specifically, Kuhn discloses that the “first housing part and the second housing part can engage at least partially form-locking in the connected state.” **Exh. 1004** ¶ [0034]; *see also id.* ¶¶ [0051], [0056], [0069], [0083]; **Exh. 1010** ¶ 63 (each describing connecting the top and bottom housing in a “form-fitting” or “form-locking” manner). As an example, Kuhn discloses an embodiment in which the protrusion or ridge itself clasps with surfaces of the channel 16 on the bottom member (i.e., the protrusion is “form-fitting” or “form-locking” with the groove), as shown in FIG. 3. **Exh. 1010** ¶ 63.

Here, a POSITA would understand “form” fitting or locking to refer to secure clasping by the form of the engaged components, which is also commonly

understood as an interference fit or snap-fit. *Id.* Although the illustrated embodiments of Kuhn include external catch type latches 50/51, Kuhn discloses those as optional and not the only means for clasping. Specifically, Kuhn discloses in paragraph [0034] that the first and second housing parts “can engage at least partially form-locking in the connected state,” and then discloses in paragraph [0036] that “[i]t is also possible” to use locking clamps, thus confirming the housing parts can be secured together by their own “form-locking” without the locking clamps. *Id.* Likewise, paragraphs [0055] and [0056] refer to the groove 16 with the seal on the bottom housing part 11 as a “locking groove” and “fastening groove,” and discuss how a “web” of the top housing part 10 is “fixed between” its side walls to be “form-fitting connected with each other.” **Exh. 1010** ¶ 65; *see also* **Exh. 1004** ¶¶ [0063], [0076], [0078], [0091] (“closing groove,” “closure groove” and “locking groove”). That language “locking,” “fastening,” “fixed between” and “connected” confirms that a clasping action is present between the channel and the protrusion/ridge received in it. **Exh. 1010** ¶ 65. That is also consistent with claim 13 of Kuhn teaching that the housing parts “engage in a connected state, at least in part form-fit,” whereas claim 14 adds the clasps as an additional, alternative feature. *Id.* That is, those claims confirm Kuhn teaches the use of the external locking features as an option, and the clasping (i.e., a “connected state”) may be

achieved using the “form” locking/fitting engagement described in Kuhn between the walls/bounding members. *Id.*

This analysis of claim element 17[h] is also consistent with the plain and ordinary meaning of “clasp,” which broadly includes “a device (such as a hook)<sup>6</sup> for holding objects or parts together” (noun) or “to fasten with or as if with a clasp” (verb), and is not limited to any particular structure. **Exh. 1018** (<https://www.merriam-webster.com/dictionary/clasp>); **Exh. 1010** ¶ 66. Kuhn’s “form” fitting or locking between the channel 16 and the end of wall 39 includes devices that hold the top and bottom members together.

Thus, even though Kuhn discloses one approach with external clasps, Kuhn also discloses the additional or alternative approach where clasping (also called locking or fastening in Kuhn) is present between the ridge and channel 16 “within the channel,” as claimed. *Id.* ¶ 67.

Moreover, the external clasping mechanisms 50/51 also independently meet the claim language, even if the “form” fitting or locking engagement is not used. That is because those structures clasp the ridge on the bottom of wall 39 within the channel 16 to seal it against the gasket 17. **Exh. 1010** ¶ 68. As can be seen from the figures, the ridge received in the channel assists in keeping the clasped

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<sup>6</sup> The “such as” language indicates a hook is an example, and the plain and ordinary meaning is not limited to that example.

connection together and cooperates with the part on the external clasp that hooks or catches underneath the wall 19 in which the channel is formed. *Id.* Thus, claim element 17[h] is met by either type of clasping approach taught by Kuhn. *Id.*

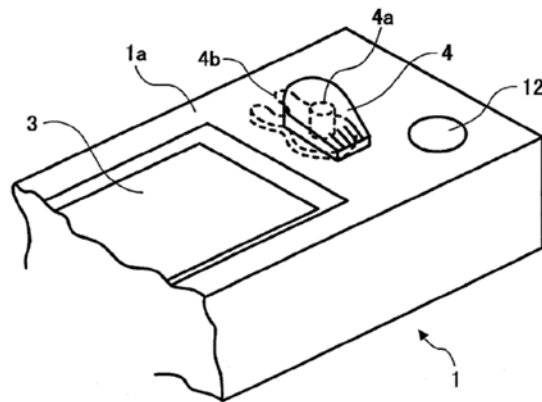
As to claim element 17[i], Kuhn further discloses a “membrane,” i.e., a film 28 that overlays the top member 10 opposite the “ridge.” *See Exh. 1004* ¶¶ [0071], [0074], [0085]; **Exh. 1010** ¶ 69. The film 28 is mated with the rigid frame 39 and extends from the proximal end portion to the distal end portion and across the opposing side portions of the top member, and its location on top is “opposite” the ridge on the bottom. **Exh. 1004** at, *e.g.*, FIGS. 3, 4, 10, 12. The membrane is transparent to allow use of the mobile computing device within the case. *See id.* ¶¶ [0005], [0013], [0014], [0017], [0019]; **Exh. 1010** ¶ 69.

The ’712 Patent also discloses a “membrane... having a transparent area.” The ’712 Patent teaches that element 3 for the touchscreen is a “transparent and flexible material such as plastic” that enables the user to see and operate the touchscreen 11 on the camera 9. **Exh. 1006** at 5:34-40, FIG. 2A; **Exh. 1010** ¶ 70.

Kuhn does not disclose the claimed switch mechanism on the top member. However, the ’712 Patent satisfies elements 17[j] and [k]. **Exh. 1010** ¶ 71. The ’712 Patent has a switch mechanism as shown in FIG. 2B (below).

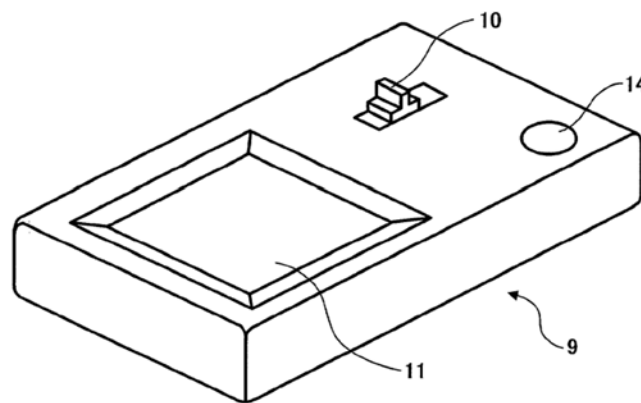


FIG. 2B



The switch mechanism includes a switch actuator 4 at an outer surface of the encasement, as recited in claim element 17[j]. **Exh. 1006** at 4:5-20, 5:6-27, 9:1-9. The switch mechanism as disclosed by the '712 Patent is also on the “top member” of the encasement because it is on the same member as the “membrane.” **Exh. 1010** ¶ 72. Indeed, Kuhn only has two members, so the choice of including it on the top member is one of two limited options. *Id.* Moreover, the choice of location is dictated by the location of the switch on the encased device itself, and thus its particular location is an obvious choice dictated by the necessity of interfacing with the switch on the encased device. *Id.* The '712 Patent reinforces the fact that the top member would be an obvious location, showing that the switch mechanism is on the same side as the membrane and the encased devices display screen, which makes sense so the user can see the image on the screen while the camera is facing away from him/her. *Id.*

The switch mechanism of the '712 Patent also includes the claimed “switch interface” at 4b, as recited in claim element 17[k]. Switch interface 4b is “provided proximate the inner surface of the encasement,” as shown in FIG. 2B above. The switch interface 4b has a forked shape that “contact[s] the at least one switch of the mobile computing device [e.g., a camera].” As can be seen in FIG. 3, the camera has a switch 10 that is actuated by a motion that is at least in part lateral to a surface of the camera’s housing, as stated in the preamble. **Exh. 1010 ¶ 73.**



The switch interface 4b is coupled with the switch actuator 4 by a shaft 4a, as shown above in FIG. 2B. As a result, “a movement of the switch actuator [4] controls a movement of the switch interface [4a] to actuate the at least one switch [10] of the mobile computing device.” **Exh. 1009** at 4:5-20, 5:6-27, 9:1-9; **Exh. 1010 ¶ 74.**

It would be obvious to a POSITA to use the switch feature of the '712 Patent to control a switch on the encased device in a housing like Kuhn’s while

maintaining the water-resistant integrity of the casing. **Exh. 1010 ¶ 75.** Indeed, Kuhn itself provides express motivation for the user to “have use of the entire control of the mobile phone,” which suggests to a POSITA to consider and use a “switch mechanism” like the ’712 Patent that allows for a control element to be actuated on the enclosed device without removal from the case. **Exh. 1004 ¶ [0047]; Exh. 1010 ¶ 75.**

Further, it would be obvious for a person of ordinary skill in the art to use the switch feature of the ’712 Patent to control a switch on the encased device while maintaining the water-resistant integrity of the casing because this is a well-known technique used in the art known to a POSITA. **Exh. 1010 ¶ 76.** The switch included on the electronic device dictates the use of a control, and a POSITA would be aware from the ’712 Patent of the ability to control that switch from the exterior as taught by that reference, without having to open a port, door, or flap to access the switch and risk ingress of water or dust. **Exh. 1010 ¶ 76.** This is consistent with Kuhn’s stated teaching of enabling the user to use “the entire control of the mobile phone,” and the ’712 Patent is an obvious example of such a feature. *Id.*

Accordingly, claim 17 is obvious over Kuhn and the ’712 Patent.

2. Claim 19

With respect to claim 19, the '712 Patent discloses an aperture with shaft 4b extending therethrough from “switch actuator” 4, satisfying claim element 19[b].

**Exh. 1006** at 4:5-20, 5:6-27, 9:1-9; **Exh. 1010** ¶ 78. Thus, the “encasement includes an aperture, and the switch actuator protrudes through the aperture,” and the elements of claim 19 are satisfied. The case disclosed by Kuhn already has an aperture for a cable connection, and thus already discloses the ability to create an aperture for access to a functional element of the encased device. **Exh. 1004** ¶ [0047]; **Exh. 1010** ¶ 78. Further, the '712 Patent discloses an aperture for its “switch actuator,” as discussed above. **Exh. 1010** ¶ 78. Therefore, it would be obvious to have the switch actuator protrude through an aperture in Kuhn in order to operate the switch on the encased device. *Id.* This is simple, predictable use of the structure and design taught by the '712 Patent, and would be predictable to use based on the fact that an aperture is already present in Kuhn. *Id.*

Claim 19 recites obvious subject matter already well within the ordinary skill level in the art with elements performing in accordance with their known functions and achieving predictable, expected results, and would also be obvious to try. **Exh. 1010** ¶ 79.

## 3. Claim 21

The elements of claim 21 are also satisfied by Kuhn and the '712 Patent, rendering the claim obvious. Specifically, Kuhn mentions at least two different ways of enabling the camera to see through its bottom/second member 11.

In one approach, Kuhn makes the entire bottom wall 18 transparent, which enables the camera to take a picture therethrough. **Exh. 1004** ¶ [0077]; **Exh. 1010** ¶ 81. That teaching alone is sufficient to be considered a “lens,” as the claim does not require that the lens be any particular size or that it only constitute a portion of the bottom/second member. **Exh. 1010** ¶ 81.

But even if the claim language were interpreted in such a narrow manner to only be a portion of the bottom/second member (which Petitioner believes would be incorrect), Kuhn also discloses that “one part of the first and/or second housing part can form a transparent area.” **Exh. 1004** ¶ [0017] (emphasis added); *see also id.* ¶ [0013] (“at least one transparent area” for the camera to capture images). That discloses that a smaller region can constitute the “transparent area,” i.e., the claimed “lens,” and thus would meet claim 21 under such a narrower interpretation. **Exh. 1010** ¶ 82.

Moreover, the '950 Patent makes clear that a lens can be “an optically transparent region.” **Exh. 1001** at 41:5; *see also id.* at 41:4-6 (“In this embodiment the lens feature is simply an optically clear region.”). Thus, the transparent area on

Kuhn's bottom member (whether it is the entire bottom wall or a portion thereof as disclosed) is a "lens" per the '950 Patent. **Exh. 1010 ¶ 83.** Because that lens is part of the bottom member 11, it is formed between the front surface and back surface of the bottom member. *Id.*

The '712 Patent also independently satisfies claim element 21[b]. Although not shown in the Figures, a lens is included in the "bottom member" of the '712 Patent encasement because camera lens/aperture faces towards the bottom member, and as such, there is a lens formed between the front surface and the back surface of the bottom member. **Exh. 1010 ¶ 84.** It would be obvious to a POSITA to use a lens on any housing that encases a device with a camera function to enable the camera to still be used while in the housing without having to remove it. **Exh. 1010 ¶ 84.**

For the reasons state above, Kuhn and the '712 Patent disclose every element recited by claim 17, 19, and 21 and therefore render those claims obvious.

**C. Ground 2: Claims 17, 19, and 21 are Obvious Over Kuhn and the '712 Patent in view of Richardson '687**

The argument in this sub-section adds teachings of Richardson '687 to Kuhn and the '712 Patent to make up for any alleged deficiencies of Kuhn and the '712 Patent the patentee may argue with respect to claims 17 and 21. Dependent claim 19 is included in this sub-section because it is dependent and thus includes all the

features of claim 17. The disclosures of Kuhn and the '712 Patent as discussed above still apply and are not repeated.

Richardson '687 discloses a protective apparatus that enables touch screen operation of a mobile computing device encased in the apparatus, satisfying claim elements 17[a] and 17[b] to the extent the language therein relating to the “touch screen display” is considered a limitation rather than merely an intended use (and to the extent not already taught by Kuhn or the '712 Patent). **Exh. 1005** at Abstract, ¶¶ [0002], [0005], [0008], [0027], [0034], [0039], [0046], [0050], [0051], [0055]; **Exh. 1010** ¶ 87. The ability of the membrane to enable operation of the touch screen is discussed in Richardson '687 throughout. **Exh. 1005** at Abstract, ¶¶ [0002], [0005], [0008], [0027], [0034], [0039], [0046], [0050], [0051], [0055]. A POSITA would have found it obvious to configure Kuhn, to the extent not already configured to do so, to enable use of its waterproof encasement with a mobile phone having a touch screen display. **Exh. 1010** ¶ 87. In particular, as mentioned above, a POSITA would be well aware of the desire for the user to be able to use the various controls of the encased device while still in the housing, and would readily recognize that Kuhn's membrane 28 can be used, or modified for use, to permit contact operation of a touch screen display. **Exh. 1010** ¶ 87. Indeed, Kuhn itself teaches the desire to have “have use of the entire control of the mobile phone,” which suggest to a POSITA to enable operation of a touch screen display

as a control through the membrane 28. **Exh. 1004 ¶** [0047]; **Exh. 1010 ¶** 87. And Kuhn already recognizes the existence of devices with touch screen displays and housing for them as well. **Exh. 1004 ¶** [0009]; **Exh. 1010 ¶** 87. Accordingly, to the extent a mobile phone with a touch screen display were used with the waterproof case of Kuhn, a POSITA would have found it obvious to form the transparent and/or elastic covering film 28 in Kuhn to permit a user to use the touch screen display as is also taught in Richardson '687. **Exh. 1010 ¶** 87.

Also, as discussed above, the '712 Patent similarly discloses its encased device may include a touch screen display, and its encasement may enable operation of that touch screen display. **Exh. 1006** at 5:34-40. This teaching reinforces that a POSITA would consider Richardson '687 and the '712 Patent when designing Kuhn's membrane to be used with or modifying it to be used with an encased device with a touch screen display. **Exh. 1010 ¶** 88.

As mentioned above, a key consideration in designing a protective encasement for a device is that the features of the device dictate the features of the encasement, such as its dimensions, access to control features, etc. **Exh. 1010 ¶** 89. Both the '712 Patent and Richardson '687 teach that such protective encasements can be used with devices having a touch screen display, and thus it would be obvious to frame that touch screen display so it can be seen and used when designing a case with the features of Kuhn. *Id.* Thus, to the extent the



language relating to the “touch screen display” in claim elements 17[a] and [b] are considered limitations and not just an intended use, they are disclosed and obvious in view of Richardson ’687, to the extent not already disclosed by Kuhn and the ’712 Patent.

Moreover, to the extent the Patentee contends that a “ridge adapted to clasp within the channel” as claimed in element 17[h] is not disclosed by Kuhn, it is disclosed by Richardson ’687. **Exh. 1010 ¶ 90.** Richardson ’687 discloses that its front shell 1204 and back shell 1324 “latch together using precisely manufactured male and female snaps,” and that the shells may also (“[i]n addition”) include “ridges 1348, 1350 in the back shell 1324 fit tightly within a groove (not shown) in the front shell 1204 to create a tight snap fit between the front shell 1204 (FIG. 12) and back shell 1324.” **Exh. 1005** at Figs. 12 and 13, ¶ [0047]; **Exh. 1010 ¶ 90.** Thus, Richardson ’687 teaches two snap-fit connections, the male and female ones, and “[i]n addition,” the snap fit created between the ridge and groove. **Exh. 1010 ¶ 90.**

A POSITA would readily recognize that such a “snap fit” could be applied to Kuhn, which also has a ridge and groove/channel. **Exh. 1010 ¶ 91.** In particular a snap-fit between the end/ridge of the “rigid frame” on the top member and the inner surfaces of the channel of the bottom member (i.e., a “ridge adapted to clasp within the channel”). **Exh. 1005 ¶ [0047]; Exh. 1010 ¶ 91.** Kuhn already has the

claimed “rigid frame” and “channel” present, and the only modification would be the inclusion of mating snap-fit features on each to interface (“clasp within the channel”) and connect the two members together (to the extent Kuhn does not already have those). **Exh. 1010 ¶ 91.**

For the same reasons discussed above in regard to Kuhn, those mating snap-fit features in Richardson “clasp within the channel,” as claimed, i.e., the snap-fit feature included on the ridge that extends into the channel. **Exh. 1010 ¶ 92.**

Moreover, those snap-fit features “clasp within the channel” as recited in claim 17, and as taught by Richardson ’687’s reference to creating a “tight snap fit.” **Exh.**

**1010 ¶ 92.** A POSITA would have been familiar with such a connection, and readily understand that this ridge and groove snap-fitting in Richardson ’687 could be used to provide the “form locking” type of connection referenced in Kuhn between its ridge and channel to couple the housing members together. **Exh. 1010 ¶ 92.** Further, a POSITA would have good reason to use that snap-fit connection within the channel because (a) it is consistent with Kuhn’s disclosure that the channel 16 may provide the locking (**Exh. 1004 ¶¶ [0034], [0051], [0055], [0056], [0069], [0083]**) and (b) it is a well-known means for connecting structures that is simple, efficient and easily implemented. **Exh. 1010 ¶ 92.** This type of connection is very simple to form because it can be molded integrally into plastic material of a

housing, and takes advantage of its resiliency to easily snap together and apart as needed. *Id.*

Thus, those features of claim 17 are obvious in view of the added teachings of Richardson '687 to the extent not already taught by Kuhn. This applies to dependent claim 19 as well, which is already met by the '712 Patent for the reasons discussed above.

Further, with respect to claim 21, Richardson '687 discloses a camera opening 1328 on its bottom member that includes “at least one lens [camera lens cover 1318] formed between the front surface and the back surfaces of the bottom member.” It would be obvious to a POSITA to design a camera lens in Kuhn’s bottom member, as taught by Kuhn itself, in view of Richardson '687 showing the inclusion of such a feature in order for an electronic device’s camera to capture images. **Exh. 1010 ¶ 94.** This again is another instance of a common desire known to a POSITA, namely the desire for the user to be able to use the functions of the electronic device while still in the case without needing to remove it. *Id.* Here, that function is the ability to take pictures or videos with the camera, and thus it is obvious to include the claimed lens in the bottom member as taught by Richardson '687 for that purpose. *Id.*

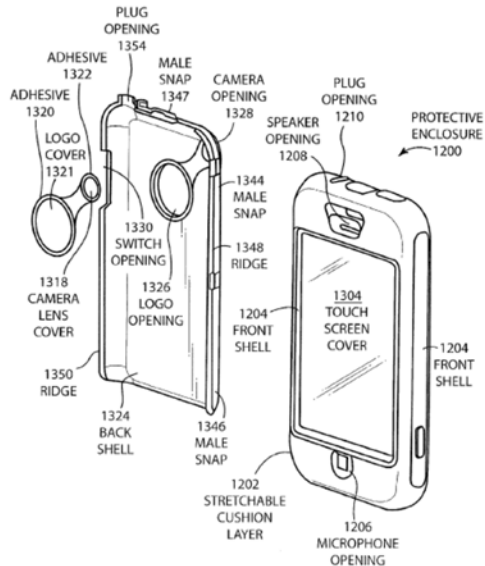


FIG. 12

Accordingly, the combination of Kuhn, the '712 Patent, and Richardson '687 renders obvious claims 17, 19, and 21 of the '950 Patent.

**D. Ground 3: Claims 17, 19, and 21 are Obvious Over Kuhn in view of JP384**

The scope and content of Kuhn and JP384 are discussed above in Sections V.A. and D., and the level of ordinary skill in the art is discussed above in Section VI.A. The application of Kuhn to claims 17, 19, and 21 is discussed above in Ground 1 and need not be repeated herein.

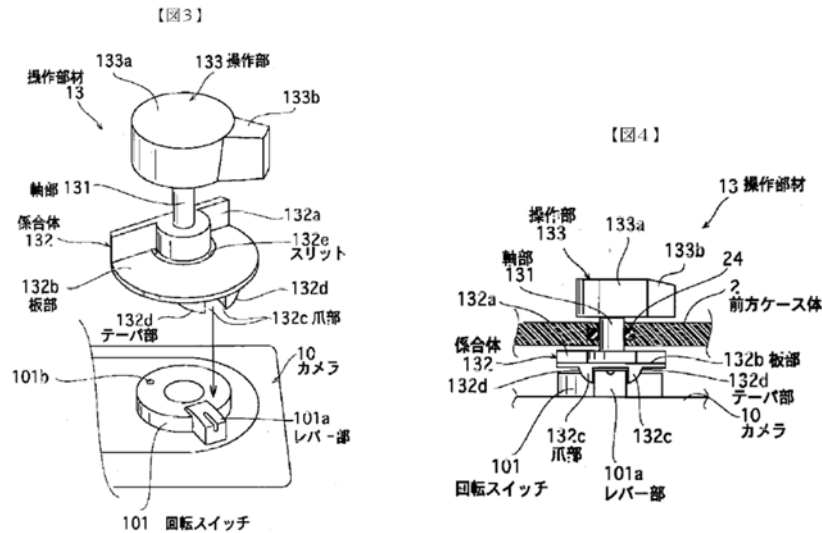
As noted above, Kuhn does not disclose a switch mechanism on the top member. However, JP384 does and satisfies elements 17[j] and [k]. JP384 discloses a housing 1 for encasing a camera 10 (Fig. 2, below) in a waterproof manner, and the camera 10 is a “mobile computing device further having at least one switch [101] that is actuated by a motion that is at least in part lateral to a

surface of a housing that houses the mobile computing device.” **Exh. 1010 ¶ 97.** A camera is in the same field, as evidenced by the ’950 Patent listing that as examples of devices its housing can encase. **Exh. 1001** at 1:60, 2:56. Moreover, JP384 also discloses the encased device may of other types as well, confirming them to be in the same field. **Exh. 1007 ¶ [0035]-[0036]; Exh. 1010 ¶ 97.** In particular, JP384 has a “switch mechanism” (i.e., operation member 13, generally) as shown in Figs. 3-6. **Exh. 1010 ¶ 97.**

The claimed “switch actuator” corresponds to element 133 on the exterior surface of housing member 2. *Id.* That is the part operated by the user. *See Exh. 1007* at FIGS. 3-6 and ¶¶ [0019], [0023]. Moreover, JP384 discloses that the switch can be on any surface as well, which would include the other member as cover 3, thereby satisfying claim element 17[j]. **Exh. 1007 ¶ [0038]; Exh. 1010 ¶ 98.** Indeed, Kuhn only has two members, so the choice of including it on the top member is one of two limited options, and JP384 discloses that any surface or member is appropriate. **Exh. 1010 ¶ 98.** Moreover, the choice of location is dictated by the location of the switch on the encased device itself, and thus its particular location is an obvious choice dictated by the necessity of interfacing with the switch on the encased device. *Id.*

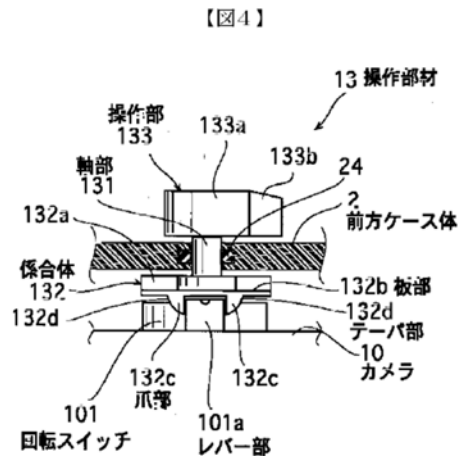
In JP384, the claimed “switch interface” corresponds to the element 132. **Exh. 1010 ¶ 99.** That “switch interface” 132 is disposed on the interior surface of

computing device.” See **Exh. 1007 ¶¶** [0020]-[0022], [0030].

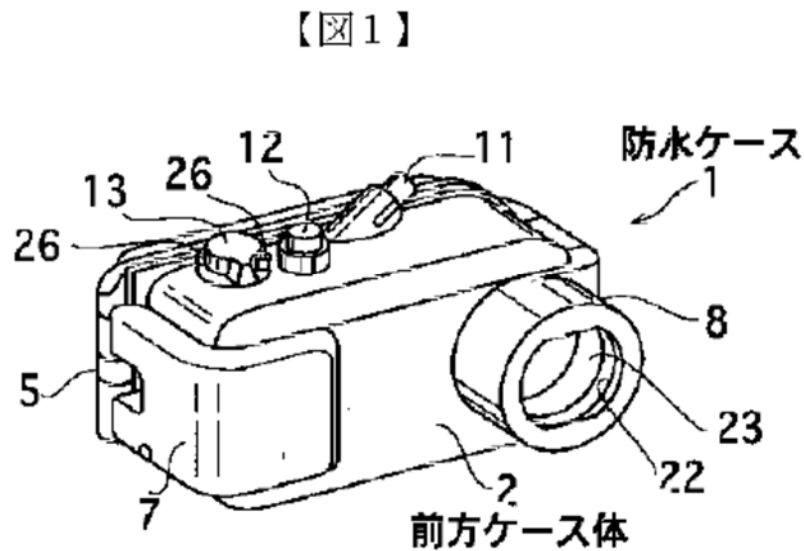


through with the post 131 of the “switch mechanism’s” actuator 133 protrudes.

**Exh. 1007** at Fig. 4 and ¶¶ [0019]-[0021].



With respect to claim 21, in addition to the teachings of Kuhn as discussed above, the bottom member 2 of JP384 also has a lens formed between its front and back surfaces. *See Exh. 1007* at Fig. 1 (below).



It would be obvious for a POSITA to use the switch feature of JP384 to control a switch on the encased device while maintaining the water-resistant integrity of the casing. **Exh. 1010** ¶ 102. For the same reasons as discussed above

with respect to the '712 Patent, this is a well-known technique used in the art known to a person of ordinary skill in the art. *Id.* The switch included on the electronic device dictates the use of a control, and a person of ordinary skill in the art would be aware from JP384 of the ability to control that switch from the exterior as taught by JP384, without having to open a port, door, or flap to access the switch and risk ingress of water or dust. Kuhn provides additional motivation itself, stating the desire for the user to “have use of the entire control of the mobile phone,” which suggests to a POSITA to consider a “switch mechanism” like JP384 that allows for a control element to be actuated on the enclosed device without removal from the case. **Exh. 1004 ¶ [0047]; Exh. 1010 ¶ 102.**

The combination of Kuhn and JP384 therefore renders obvious claims 17, 19, and 21 of the '950 Patent.

**E. Ground 4: Claims 17, 19, and 21 are Obvious Over Kuhn and JP384 in view of Richardson '687**

This ground is the same as Ground 3, except that, instead of combining Kuhn and JP384 alone, Richardson '687 is being added to the combination of Kuhn and JP384 as set forth in Ground 3 to meet claims 17, 19, and 21. The same cited disclosure and rationale discussed above in Ground 2 as applying here for adding the features of Richardson '687 to meet those claims to a housing for an electronic device and need not be repeated. **Exh. 1010 ¶ 105.** Specifically, as discussed above, Richardson '687 teaches the “touch screen display” related



language (to the extent treated as a limitation and not an intended use) and the “clasp within the channel” limitation in claim 17, as well as the “lens” on the bottom member in claim 21, to the extent not already taught by Kuhn. Those are not functionally related to the inclusion of a “switch mechanism,” and the inclusion of JP384’s “switch mechanism” on Kuhn’s housing does not change that it would still be obvious to use the features relating to the touch screen, clasping and/or lens in Richardson ’687 on Kuhn’s housing. *Id.*

Accordingly, claims 17, 19, and 21 are obvious over Kuhn and JP384 in view of Richardson ’687.

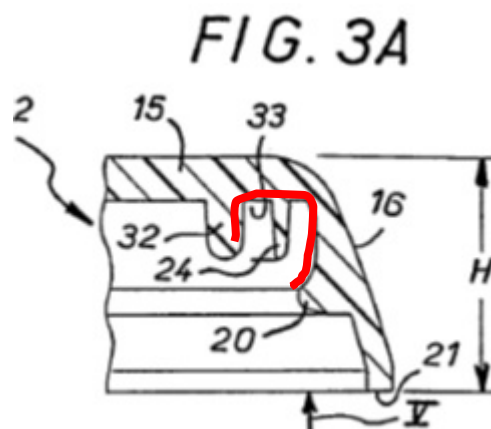
**F. Ground 5: Claims 17, 19, and 21 are Obvious Over Kuhn and the ’712 Patent in view of Richardson ’687 and FR857**

This ground is the same as Ground 2 (and the rationale for combining those references need not be repeated herein), except that FR857 has been added to further demonstrate the obvious nature of the claimed “rigid frame extending to a ridge that is adapted to clasp within the channel.” FR857 discloses that well-known clasping mechanism commonly used in sealing two-member protective enclosures, and specifically, protective enclosures for electronic equipment and devices. **Exh. 1008** at Title (“Box with a snap-on lid, in particular for electrical equipment”), Abstract; **Exh. 1010** ¶ 108. FR857 is in the same field of the art as the ’950 Patent because it is a housing for an electronic object, **Exh. 1001** at 1:25-

36, and it directly teaches how to secure two members together in a secure and waterproof manner. **Exh. 1010** ¶ 108.

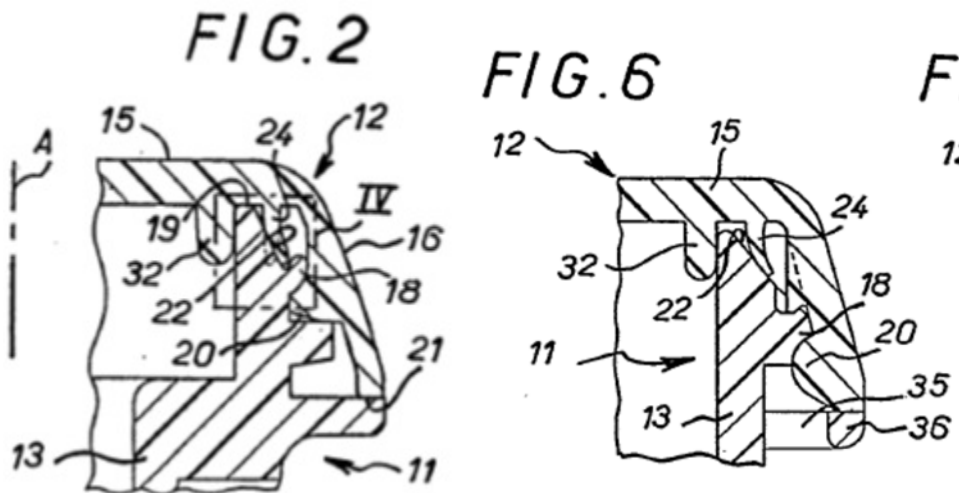
FR857 discloses a clasp mechanism within the channel on one member (e.g., a groove in the side wall of the channel) and a clasp mechanism adapted to clasp within the channel on the other (e.g., a lip received in that groove). *Id.*

FR857 discloses an apparatus for housing an electronic device having a top member and a bottom member. **Exh. 1008** at Title, Abstract, 1:5-7, 1:21-22, 3:7-13, Claim 1. On one member, FR857 discloses a channel (annotated in red below) formed between “interior perimeter portion” strip 32 and “exterior perimeter portion” turned-out edge 16 (and containing element 24 and groove 33) in a perimeter portion. *Id.* at FIGS. 2-4, 6, 8:19-24, 10:4-5. Element 24 is positioned within the channel. *Id.* at 6:10-19, 7:12-15, FIGS. 2, 4, 6.



FR857 further discloses a rigid frame, i.e., side wall 13, extending to a ridge (the unnumbered part of side wall 13 having support surface 22 and rim 19 that

extends into a channel). *See id.* at FIGS. 2, 3B, 4, 6. The ridge has a clasp mechanism 18 that clasps within the channel with element 20 and seals against element 24. *Id.*; *id.* at 5:22-6:3, 6:8-9, 9:15-16.



Therefore, FR857 teaches a clasp mechanism within the channel on one member (e.g., a groove or ledge above 20 on the side wall of the channel) and a clasp mechanism adapted to clasp within the channel on the other member (e.g., a lip 18 received in that groove or catching the ledge). **Exh. 1010** ¶ 112.

A POSITA would use the clasp mechanism disclosed by FR857 because it effectively secures and seals the members of a container together in a liquid tight manner. **Exh. 1010** ¶ 113. Containers and buckets,<sup>7</sup> and especially containers in

<sup>7</sup> The clasp mechanism of FR857 is a familiar clasp mechanism used for sealing two-member protective housings and is not unique to securing and sealing protective housings for electronic devices. For example, the '088 Patent teaches the same clasp mechanism in the field of general protective containers (e.g., buckets). **Exh. 1009** at Abstract, 1:23-25, 4:32-38, 4:42-45 (alternative

the field of electronic devices like FR857, are part of the relevant art a POSITA would consider because they are extremely well-known devices for containing and protecting materials inside, including from water or ingress of other particles. *Id.* FR857 is squarely within the field of the '950 Patent because it is a housing for an electronic object, **Exh. 1001** at 1:25-36, and it directly teaches how to secure two members together in a secure waterproof manner. **Exh. 1010** ¶ 113.

Such features would be obvious to use in a protective housing for an electronic device, such as Kuhn (to the extent it is not already disclosed), because it is desirable to secure the housing members together in a manner to limit or prevent the ingress of liquids. *Id.* Including elements in the manner claimed is an obvious design choice and well within the skill level of a POSITA. *Id.* They are well-established features known in the container art for many years and would have, at the very least, been obvious to try. *Id.* Indeed, such clasping mechanisms are suggested by Kuhn's teaching of using "form-fitting" or locking connection and Richardson '687's teaching of using a "snap-fit" connection. **Exh. 1004** ¶ [0034]; *see also id.* ¶¶ [0051], [0056], [0069], [0083] (each describing connecting the top and bottom housing in a "form-fitting" or "form-locking" manner); **Exh. 1005** ¶ [0047] (front shell "top member" 1204 and back shell "bottom member"

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embodiment), 4:55-60, 5:24-36, FIGS. 2, 3, 5; *see id.* 1:58-2:6, 3:45-65, FIG. 1 (prior art clasping mechanisms); **Exh. 1010** ¶ 113, fn. 6.

1324 may be connected by snap-fit features, including a “tight snap fit” provided by ridges 1348/1350 that fits into a groove (not shown) (i.e., a channel defined by interior perimeter and exterior perimeter portions)). **Exh. 1010** ¶ 114. A POSITA would readily understand what a form-locking or snap-fit connection is, as they are well known in the art, including as disclosed in FR857 (and its commonplace nature is further confirmed in the state of the art by the ’088 Patent). **Exh. 1010** ¶ 114. Indeed, FR857 refers to that connection as “snap-on” and “snap-fastening” consistently with Kuhn’s disclosure of a locking or fastening connection in the channel 16 and Richardson ’687’s description of its ridge and groove connection as snap-fit, and states numerous advantages of using such an approach. **Exh. 1008** at Title, 3:7-22; **Exh. 1010** ¶ 114.

Moreover, the features in FR857 are integrally formed with their respective housing members (e.g., a lid and container) that correspond to the housing members in Kuhn and Richardson ’687, and would be recognized as likewise being readily integrally formed into the plastic housing members of those references.

**Exh. 1010** ¶ 115. A POSITA would also include the channel with a seal on one member and the part that enters the channel on the other, selection of which is an obvious design choice, given the limited (2) possibilities. *Id.* Additionally, Kuhn already includes a compressible seal within the channel in its bottom member and a ridge on the top member received therein, so adding the clasping mechanisms of

FR857 would be obvious for the same reasons. Adding the clasping mechanisms would be obvious for the further reason that the ridge and channel are already present, and addition of clasping features within the channel would be beneficial to provide securement between the members, as was already known in the art. **Exh. 1010 ¶ 115.**

Accordingly, claims 17, 19, and 21 are also obvious over Kuhn and the '712 Patent in view of Richardson '687 and FR857.

**G. Ground 6: Claims 17, 19, and 21 are Obvious Over Kuhn and JP384 in view of Richardson '687 and FR857**

This ground is the same as Ground 5, except that, instead of using the “switch feature” disclosed by the '712 Patent in combination with Kuhn, Richardson '687, and FR857, the switch feature of JP384 is combined with the disclosures of Kuhn, Richardson '687, and FR857. The cited disclosure and rationale advanced in Grounds 3 and 4 for combining JP384 to Kuhn and Richardson '687 to meet the switch mechanism related limitations claims 17, 19, and 21 applies equally here. **Exh. 1010 ¶ 117.** Likewise, the cited disclosure and rationale in Ground 5 for adding FR857 to Kuhn and Richardson '687 to provide a connection with clasping “within” the channel applies here as well. *Id.* ¶ 118.

Accordingly, claims 17, 19, and 21 are obvious over Kuhn and JP384 in view of Richardson '687 and FR857.

## **VII. Patent Owner’s Anticipated Issue Preclusion Argument Does Not Apply**

Based on the issue preclusion argument presented on pages 25-30 of its Preliminary Response in IPR2020-00852 (relating to U.S. Patent No. 9,498,033), it is anticipated Patent Owner may raise the same issue in this proceeding because the ’950 Patent is also involved in that litigation. *See also* Preliminary Response (Paper 10) in IPR2020-00869 at 32-36.

### **1. There is No Final Adjudication of Validity**

In the related litigation, Petitioner challenged the validity of the ’950 Patent via two different means: (1) asserting affirmative defenses of invalidity in its answer, and (2) asserting invalidity in counterclaims. **Exh. 1011** at 78-81, 93-94. As noted in its ’852 and ’869 Preliminary Responses, Petitioner dismissed its counterclaims (which also included two counterclaims for patent infringement) with prejudice, but the stipulation stated that “the answer portion of that filing is not dismissed.” **Exh. 1012**. That answer included the affirmative defenses of invalidity. **Exh. 1011** at 78-81; Federal Rule Civ. Pro. Rule 12(b) (defenses are included in the “responsive pleading”). Thus, the affirmative invalidity defenses are still being litigated in the District Court. Indeed, Petitioner served its invalidity

contentions served on July 31, 2020. **Exh. 1013**.<sup>8</sup> Accordingly, there is no final adjudication on the patent invalidity issues.

Patent Owner also did not tell the entire story in its '852 and '869 Preliminary Responses. It omitted its unsuccessful attempt to move for judgment (including on validity) on the basis of issue preclusion. **Exh. 1014**. The District Judge expressed concern with the merits of the issue and gave Patent Owner's counsel two choices: (a) withdraw that motion by the next day, or (2) risk paying Petitioner's attorneys' fees if the caselaw Petitioner offered was not square on point. **Exh. 1015** at 008, line 20-009, line 25. Patent Owner immediately withdrew its motion, thus abandoning its position on this issue. **Exh. 1016**. Withdrawal of that motion ensured the continued litigation of the patent invalidity issues. That also defeats any notion that those issues are final.

Patent Owner's citations to Federal Circuit caselaw as allegedly supporting its point on this issue are inapposite. At best, they stand for the unremarkable boilerplate proposition that a stipulated dismissal with prejudice can be a final judgment on the merits. But in each of those cases the with-prejudice dismissal actually ended the litigation entirely. That is not so here, where the parties continue to litigate both infringement and invalidity and there is no final decision. Patent

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<sup>8</sup> **Exh. 1013**'s accompanying claim charts are omitted as unnecessary. Also, although this Petition challenges numerous claims, claim 19 is the only currently asserted claim in the litigation. **Exh. 1013** at 030.



Owner cites *In re PersonalWeb Techs, LLC*, but that case supports Petitioner's position because it held the with-prejudice dismissal in a prior litigation barred the later-filed litigation because the dismissal was "without reservation, explicit or implicit." 961 F.3d 1365, 1378 (Fed. Cir. 2020). In contrast, Petitioner here clearly reserved its right to continue litigating invalidity in its affirmative defense and Patent Owner stipulated to that. **Exh. 1011** at 78-81; **Exh. 1012**. Thus, Patent Owner's case citations do not support its position and there is no final adjudication that the challenged patent claims are valid.

2. A District Court Adjudication of No Invalidity Would Not Bind This Board Anyways

Further, any attempt by Patent Owner to raise its issue preclusion argument must fail not just for the lack of a final adjudication, but also because it is contrary to controlling precedent. The Federal Circuit has held that an adjudication of patent validity before a District Court does not bind this Board. *Novartis v. Noven Pharma, Inc.*, 853 F.3d 1289, 1293-94 (Fed. Cir. 2017). This is true even if the records are exactly the same. *Id.* at 1294. The reason is clear: the District Court applies the higher clear and convincing evidence standard, so a District Court judgment of no invalidity does not mean unpatentability cannot be proven under this Board's lower preponderance of the evidence standard. *Novartis*, 853 F.3d at 1294 (citing *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2146 (2016)); cf. *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1304 (2015) (holding

TTAB decision may be used for issue preclusion in district court litigation, but also noting that issues are not identical for preclusion purposes if different legal standards are applied, even on same “factual setting”)(quoting a treatise); 35 U.S.C. § 316(e). Thus, even assuming *arguendo* that the Patent Owner had an unequivocal final judgment of no invalidity (which it does not), Patent Owner’s argument for issue preclusion would still be contrary to *Novartis*. Patent Owner overlooked this square on point caselaw in its ’852 and ’869 Preliminary Responses.

The appellate cases cited by Patent Owner in those Preliminary Responses are inapposite because they do not overrule or limit *Novartis*, or even directly address the question of whether a District Court judgment binds this Board.

Further, Patent Owner’s citation to this Board’s *SAP America* is inapposite because the Board did not apply issue preclusion, and it is a 2013 decision pre-dating *Novartis*. *SAP America* also noted the lack of finality of the issue in the court proceedings, which is clearly not the case here because invalidity continues to be litigated. **Exh. 1013, Exh. 1016.** Patent Owner also cited *Smith & Nephew, Inc. v. Arthrocare Corp.*, IPR2017-00275, Paper 36 (PTAB 2018) for the proposition that this Board applies issue preclusion on this fact pattern. However, all that case said was that neither party had raised that argument. Thus, the Board did not decide the issue at all in that case.

Even the statutory scheme itself reveals Patent Owner's position is incorrect. 35 U.S.C. §315(e) (post-AIA) includes two "raised or could have raised" estoppels against a Petitioner that has lost an IPR in a final written decision: (e)(1) estops the losing Petitioner from requesting or maintaining another proceeding against the same claims before the Office, and (e)(2) estops the losing Petitioner from challenging the validity of the same claims in District Court or ITC litigation. Neither provision applies here.

In contrast, the previous *inter partes* reexamination had broader estoppel provisions, including estopping a party that lost an invalidity challenge in district court litigation from challenging that claim in reexamination. 35 U.S.C. §317 (pre-AIA). Congress chose not to carry that provision over to post-AIA trials. Thus, expanding estoppel principles in the manner Patent Owner proposes would essentially result in adopting the pre-AIA litigation estoppel against reexaminations that Congress clearly did not adopt for post-AIA trials. *Accord Arista Networks, Inc. v. Cisco Systems, Inc.*, 908 F.3d 792, 803-804 (Fed. Cir. 2018) (declining to allow assignor estoppel to preclude IPR and noting inclusion of estoppel language in other statutes as evidence Congress did not intend its inclusion in the AIA); *Athena Automation Ltd. v. Husky Injection Molding Systems, Ltd.*, IPR2013-00290, Paper 18 at 12-13 (PTAB 2013) (precedential) (declining to apply assignor estoppel for similar reasons).

Thus, the Petition is not precluded.

### **VIII. CONCLUSION**

Based on the foregoing, it is clear that claims 17, 19, and 21 of the '950 Patent define subject matter that is obvious. Thus, the Petitioner requests institution of an *inter partes* review to cancel these claims.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the PETITION FOR *INTER PARTES* REVIEW UNDER 37 C.F.R. § 42.100 and all exhibits/attachments thereto (Exhs. 1001-1018) were served in their entirety by FEDERAL EXPRESS OVERNIGHT DELIVERY this 28th day of August 2020 on the attorney of record of Otter Products IP, Mr. Todd Adelman, as indicated below:

Mr. Todd Adelman  
Otter Products, LLC  
209 S. Meldrum Street  
Fort Collins CO 80521

A courtesy copy was also served on patent owner's counsel in the litigation identified in the Petition to the emails on the same day.

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IPR2020-01543

U.S. Patent No. 8,564,950B2

**CERTIFICATE OF WORD COUNT**

I hereby certify that this PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 8,564,950B2 contains 13,571 words, excluding the table of contents, table of authorities, mandatory notices, the certificates of service and word count, and the appendix of exhibits, according to the word count tool in Microsoft® Word.

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