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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FELLOWES, INC.,

Petitioner,

v.

TREEFROG DEVELOPMENTS, INC.,
Patent Owner.

Case IPR2020-01543
U.S. Patent No. 8,564,950

PATENT OWNER'S PRELIMINARY RESPONSE

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I. INTRODUCTION

Pursuant to 37 C.F.R. §42.107, Patent Owner TreeFrog Developments, Inc. submits its Preliminary Response asking that each of Petitioner's asserted Grounds against U.S. Patent No. 8,564,950 ("the '950 Patent") be denied in their entirety. The Petition should be denied for at least three reasons:

1. Under §314(a), the Board should deny the Petition because Fellowes is barred from challenging the validity of the '950 Patent in this proceeding. Fellowes previously challenged the validity of the '950 Patent in a district court and voluntarily dismissed its claims with prejudice, a judgment on the merits resulting in claim preclusion.
2. Fellowes fails to meet its burden to show the claims are unpatentable because the Petition fails to establish that the references, even in combination, teach all the claim elements.
3. Fellowes fails to meet its burden to show the claims are unpatentable because the Petition fails to establish a motivation to combine any of its references in Grounds 1-6.

Even if Petitioner is successful in showing one of its grounds has a reasonable likelihood of success, the Board should exercise its discretion and deny institution because of the substantial number of unsuccessful combinations the

Board would have to consider in the Final Written Decision under *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

II. RELATED PROCEEDINGS

The '950 Patent is the subject of the litigation between the parties pending in the U.S. District Court for the Northern District of Illinois, filed September 16, 2019. On December 4, 2019, Fellowes filed a counterclaim of invalidity against the '950 Patent. EX1011 (Counterclaim). Fellowes voluntarily dismissed its invalidity counterclaim against the '950 Patent with prejudice, pursuant to Fed. R. Civ. P. 41(a)(1)(ii). EX1012 (Stipulation of Dismissal).

Fellowes has now filed eight IPRs challenging patents being asserted in the Northern District of Illinois litigation. To date, the Board has denied institution for the IPRs that have reached an institution decision. *Fellowes, Inc. v. Otter Products, LLC*, IPR2020-00852 (P.T.A.B. Oct. 29, 2020); *Fellowes, Inc. v. Treefrog Developments, Inc.*, IPR2020-00869 (P.T.A.B. Oct. 29, 2020).

III. OVERVIEW OF UNITED STATES PATENT NO. 8,564,950

1. The '950 Patent's Technology

The '950 Patent discloses and claims a housing for encasing a device having a switch. EX1001, Title. The apparatus includes an encasement that enables operation of the touch screen display and covers at least part of the mobile computing device that includes the switch. *Id.*, Abstract. The switch mechanism includes a switch interface provided proximate the inner surface of the encasement to contact

the switch and is coupled with the switch actuator such that a movement of the switch actuator controls a movement of the switch interface to actuate the switch. *Id.*; see also *id.* 59:16-24, 60:18-61:43; Fig. 11. The protective encasing is designed to protect the mobile computing device in “adverse environmental conditions.” *Id.* 2:14-18.

2. Relevant Prosecution History of the ’950 Patent

The ’950 Patent issued from U.S. Patent Application No. 13/681,342 filed on November 19, 2012. EX1001 at 1. The application is a continuation claiming priority to provisional applications with the earliest priority date of October 12, 2010. *Id.*

February 26, 2013 Non-Final Rejection

The Examiner rejected claims 1-4, 8, 11-14, 18, 21-24, 29 and 30 in a February 26, 2013 non-final rejection. EX1002 at 599-607. Claims 21 and 23 were rejected under 35 U.S.C. §102(a or e) as anticipated by Wilson (U.S.P.N. 8,286,789). *Id.* at 604. Claims 1-3, 8, 11-13, 18, 21-24, and 29-30 were rejected under 35 U.S.C. §102(b or e) as anticipated by Orr (U.S.P.N. 7,772,507). *Id.* at 604. Claims 4 and 14 were rejected under 35 U.S.C. §103(a) as obvious over Orr. *Id.* at 605-606. Claims 5-7, 9-10, 15-17, 19-20, and 25-26 were objected to as depending from a rejected independent claim but were patentable if rewritten in independent form. *Id.* at 606. The Examiner identified additional relevant but un-

relied upon references. *Id.* at 606.

May 2, 2013 Response to Non-Final Rejection

On May 2, 2013, Applicant traversed the Examiner's rejection. *Id.* at 242-266. Applicant amended independent claims 1 and 11 to include "the switch mechanism further including an axle coupled with the encasement to convert substantially linear movement of the switch actuator to substantially opposite linear movement of the switch interface. *Id.* at 245, 248. Applicant further amended claim 21 (which issued as Claim 17) to add limitations related to the encasement:

. . . 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, the perimeter portion of the bottom member having a channel formed by an interior perimeter portion and an exterior perimeter portion, the channel including a compressible gasket positioned therein; and

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 portion of the bottom member, the rigid frame extending to a ridge that is adapted to clasp within the channel of the bottom member and seal against the gasket, the top member further including a membrane that overlays the rigid frame opposite the ridge, the membrane having a transparent area, the top member further including a switch mechanism...

Id. at 251-252. Applicant further introduced new claims 31-38. *Id.* at 253-261.

Notice of Allowance

On July 17, 2013, the Examiner withdrew the rejection and issued a Notice of Allowance. *Id.* at 211-215. The Examiner did not provide Reasons for Allowance. *Id.*

IV. PERSON HAVING ORDINARY SKILL IN THE ART

Petitioner asserts that a person of ordinary skill in the art (“POSITA”) at the time of the invention would have “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.” Pet. at 24.

Petitioner’s proposed qualifications of a POSITA are inadequate. An individual with only experience designing cases for electronic devices without more specificity would not have developed the protective enclosure of the ’950 Patent. *See* EX2002, ¶30. Patent Owner proposes that a POSITA would possess at least a bachelor’s degree in mechanical engineering (or an equivalent degree/experience) with at least two years of experience in ruggedizing cases for electronic devices. *See* EX2002, ¶26. However, for the purposes of this Preliminary Response, Patent Owner does not dispute Petitioner’s definition of a POSITA, because institution of this *inter partes* review should be denied regardless of which level of skill is adopted. Furthermore, Petitioner fails to establish the alleged POSITA would have found it obvious to combine the technologies as asserted in the Petition.

V. CLAIM CONSTRUCTION

Claims subject to *inter partes* review are construed under the *Phillips* plain and ordinary meaning standard. 37 C.F.R. §42.100(b); *see also* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,341 (October 11, 2018) (“The rule adopts the same claim construction standard used by Article III federal courts and the ITC, both of which follow *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny.”).

1. **Petitioner Reads “a mobile computing device having a touch screen display” and “an encasement that enables operation” out of the Claims.**

Claim 17 of the '950 Patent begins: “An apparatus for covering at least part of a mobile computing device having a touch screen display...” EX1001, Claim 17. Petitioner would ignore that the claimed invention is an apparatus for covering at least part of a mobile computing device having a touch screen display. Petitioner improperly attempts to read limitations out of the claim.

Petitioner argues that the phrases “a mobile computing device having a

touch screen display”¹ and “an encasement that enables operation” are meaningless within the preamble and limitations of Claim 17. Pet. at 13-14. Petitioner argues that the claim is directed to an apparatus and “mobile computing device” is merely an “intended use”. *Id.* Petitioner’s argument ignores the plain language of the preamble that the claim covers “[a]n apparatus for covering at least part of a mobile computing device having a touch screen display...” EX1001, Claim 17.

Language in a claim’s preamble is generally not limiting. *Pacing Techs., LLC v. Garmin Int’l, Inc.*, 778 F.3d 1021, 1023 (Fed. Cir. 2015). However, where such language “recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). The phrase “a mobile computing device having a touch screen display” in Claim 17’s preamble

¹ Petitioner identifies the claim term for construction as “a mobile computing device” but then argues the device need not have “a touch screen display.” Pet. at 13-14. The proper term for construction is the term as found in the preamble of Claim 17—“[a]n apparatus for covering at least part of a mobile computing device having a touch screen display.”

is such a limitation, including because it defines certain of the claimed invention's limitations and orients a person of skill as to the structure of the following limitations (i.e. for an apparatus for covering a specific type of device). The description of "[a]n apparatus for covering at least part of a mobile computing device having a touch screen display" requires that the apparatus be designed for a "a mobile computing device having a touch screen display". This does not merely describe a potential "use" for the claimed protective encasement. Instead, it describes the foundational design, structure of, and purpose for the claimed protective encasement.

Moreover, the preamble's description of "a mobile computing device *having a touch screen display*" provides context and grounding for later limitations, and introduces the antecedent basis for the later limitation requiring that the encasement "enables operation of the touch screen display". EX1001, Claim 17; *see also Pacing Techs.*, 778 F.3d at 1024 ("[w]hen limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.") (quoting *Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003)); *Pitney*, 182 F.3d at 1305. As such, that the protective encasement (i.e. the apparatus for covering) is to be used with "a mobile computing device having a touch screen display" should be considered limiting as to Claim 17 and subsequent dependent claims.

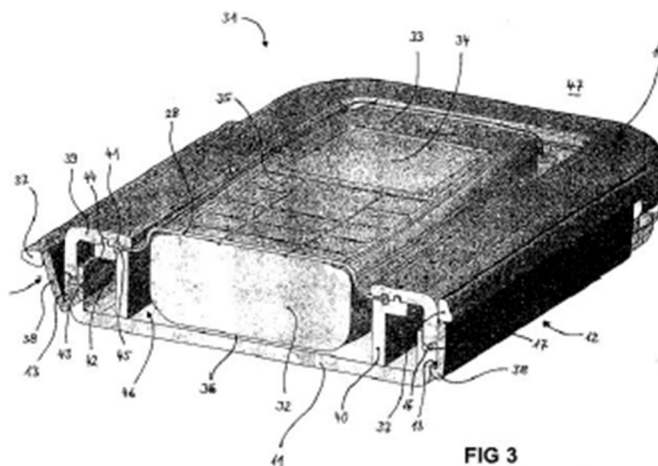
2. “[A]n encasement that enables operation” provides structural limitations to the claimed invention.

The claim limitation “an encasement that enables operation” provides structural limitations to the claimed invention. As with the limitation “a mobile computing device having a touch screen display”, Petitioner tries to read the limitation out of the claim. Pet. at 14. Petitioner, however, is wrong. The limitation “an encasement that enables operation” provides structural requirements that define the claimed invention. By way of example, an encasement that completely (i.e. fully or 100%) encloses the mobile computing device having a touch screen would not “enable operation”. EX2002, ¶55. Rather, it would prevent or impede operation, contrary to the plain and ordinary meaning of the claim language. A POSITA would readily envision other structures that might frustrate if not preclude operation of a device, such as use of a membrane incompatible with the touch screen of an enclosed device, or that certain configurations and designs for an enclosure would occlude or impede use of various buttons, switches, or other features of the enclosed device. *Id.* Accordingly, the structure of the encasement, as claimed in the ’950 Patent, requires the structure to enable operation. The limitation must not be read out of the claim, as it would frustrate the purpose of the claimed invention.

VI. OVERVIEW OF THE ASSERTED REFERENCES

1. Kuhn (EP 1,583,251)

European Patent Application No. EP 1,583,251 A1 to Kuhn (EX1004) discloses a waterproof housing for a mobile phone equipped with camera. EX1004, Abstract.



(*Id.*, Fig. 3.) Kuhn discloses a housing (31) comprising a first housing part (10) and a second housing part (11), which is intended for use for “a variety of different device types.” (*Id.* ¶¶[0011], [0067].) The first housing part (10) forms a top part, which covers the top (33) of an inserted mobile phone, which has a display and a keypad. (*Id.* ¶[0068].) The second housing part (11) forms a lower part, which covers the underside (36) of the mobile phone. (*Id.*) The first housing part (10) and second housing part (11) are designed in such a way that when they are connected they, with the help of a housing seal (17), form a watertight connection. (*Id.* ¶[0069].) Kuhn teaches two methods by which that connection is secured, both utilizing external

elements. (*Id.* ¶¶[0070], [0084].) The first uses two external locking clamps (12) mounted on the outside of the first housing part (10) and interacting with hook (13) on the second housing part (11). Engagement of the clamps and hooks results in the first housing part (10) and the second housing part (11) being pressed tightly together through the housing seal (17). (*Id.* ¶[0070].) The alternative mechanism for securing the first (10) and second (11) housing parts together uses external closure elements (50) and (51), wherein closure element (51), formed on the outside of the second housing part (11), is a locking catch engaging with a recess of closure element (50) located on the outer wall of the first housing part (10). (*Id.* ¶[0084].)

2. Richardson (U.S. 2008/0316687)

United States Patent Application Publication No. 2008/0316687 to Richardson *et al.* (EX1005) discloses a protective enclosure for an electronic device. EX1005, Title.

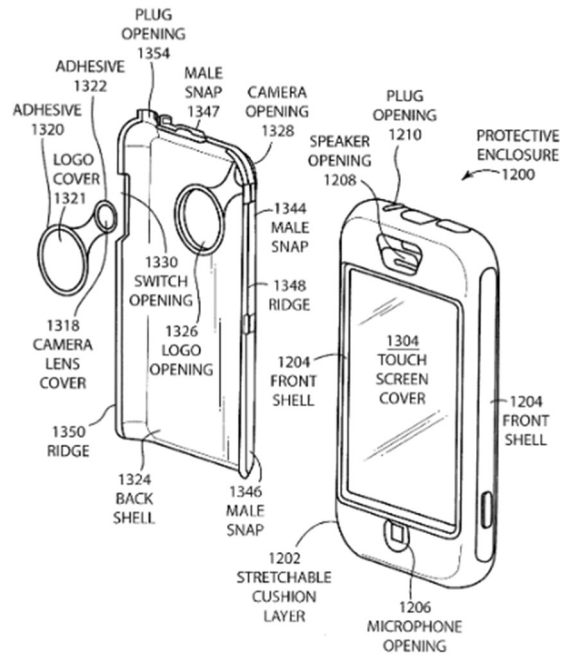


FIG. 12

(*Id.*, Fig. 12.)

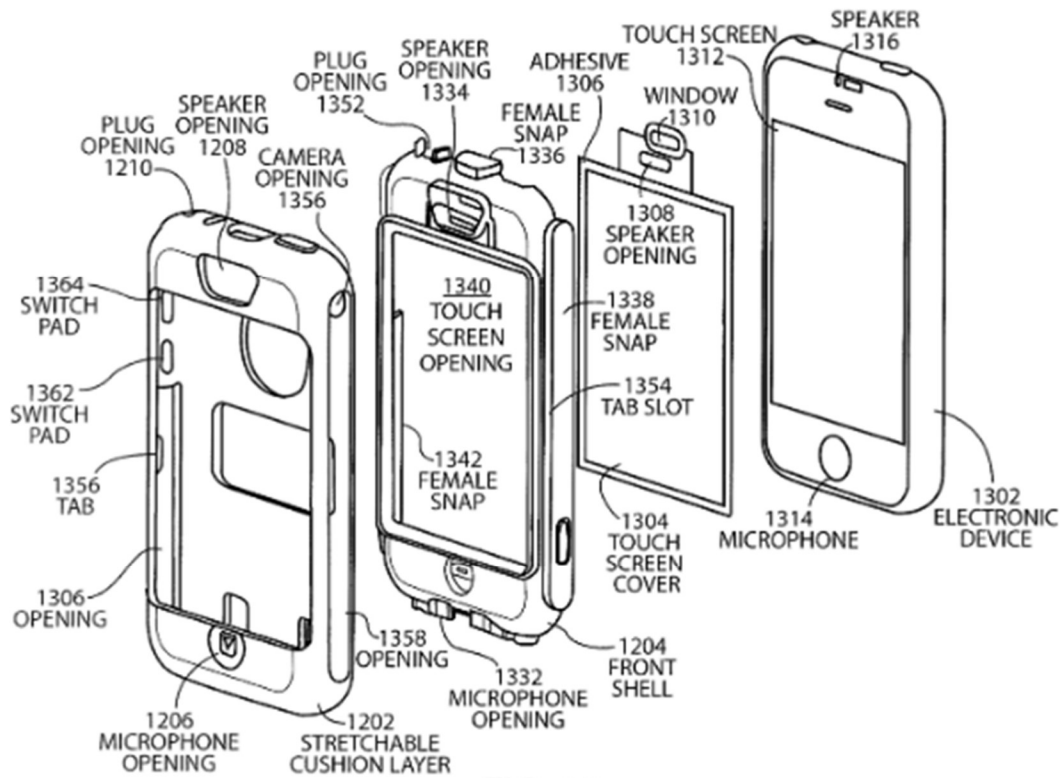
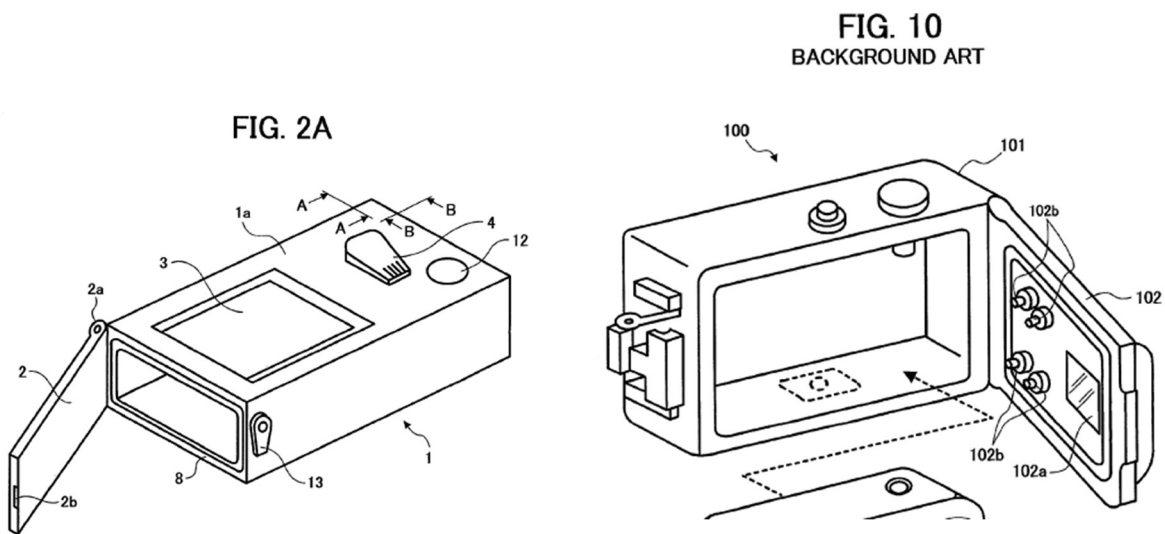


FIG. 13

(*Id.*, Fig. 13.) Richardson '687's protective enclosure teaches a front shell (1204) and a back shell (1324). (*Id.* ¶[0047].) Richardson '687 teaches that the back shell has ridges (1348) and (1350) that fit within an unshown groove in the front shell. (*Id.*) Richardson '687 does not teach that the ridges (1348) and (1350) or the unshown groove have first and second latching mechanisms as arranged in Claim 28. Instead, Richardson '687 teaches that the front shell (1204) and back shell (1324) latch together using male and female snaps, including external female snaps (1338), (1342), and (1336) on the front shell (1204) and external male snaps (1344), (1346), and (1347) on the back shell (1324). (*Id.*)

3. The '712 Patent (U.S. 7,050,712)

The '712 Patent is directed to a waterproof case for a portable device, preferably a camera. EX1006 at 1. The '712 Patent teaches use of a side cover (2, Fig. 2A) because use of a rear cover (102, Fig. 10) “may tend to be deformed due to water pressure” resulting in water leakage (1:22-67).



The '712 Patent teaches a knob and fork which engages a switch on the device.

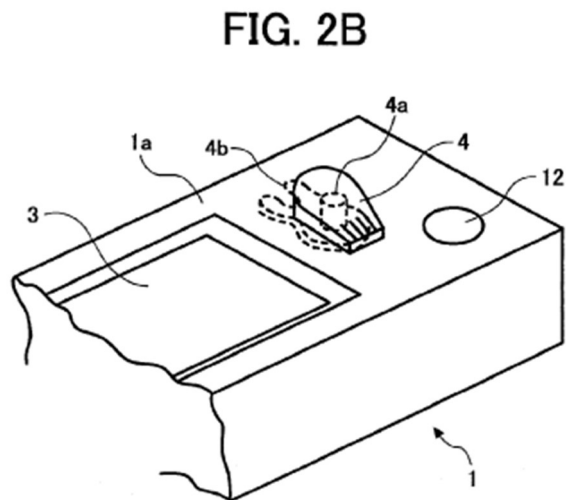


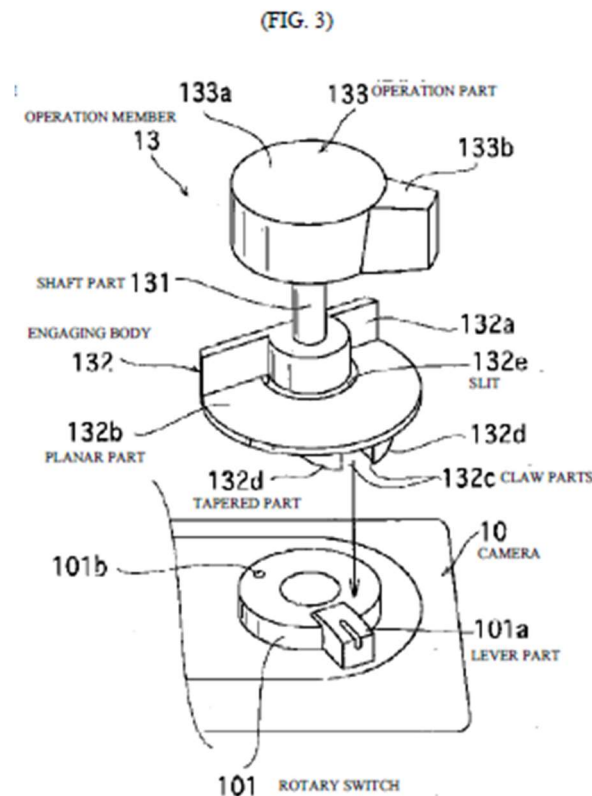
Fig. 2B, 5:46-27. The '712 Patent was expressly considered by the Examiner.

EX1002 at 606, 608.

4. JP384 (JP 2002 823384)

JP384 is directed to a waterproof case for an electronic device, particularly a camera. EX1007 at 1. JP384 teaches an engaging body (132) to engage a rotary

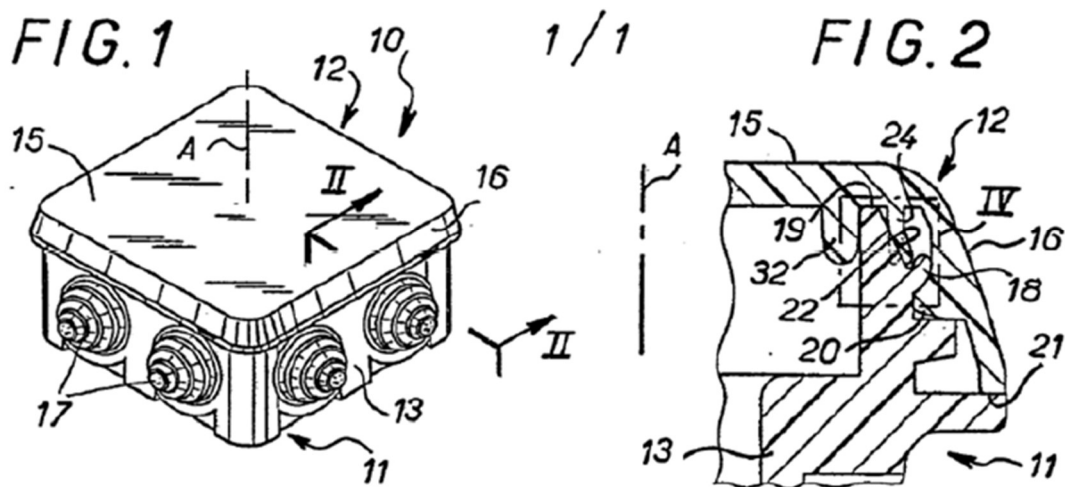
switch of the camera device:



Id. Fig. 3, Abstract.

5. FR857 (FR 2,705,857)

FR857 is directed to a box with a snap-on lid, in particular for electrical equipment. EX1008, Title. The invention comprises a box body (11) and a lid (12) designed to cap the side wall (13) of said box body (11) on the outside by a turned-out edge (16), having snap-fastening means and sealing means engaging annularly between said lid (12) and the box body (11), said sealing means comprising a lip (24) protruding from the lid (12) for cooperating with a support surface (22) provided for it on the side wall (13) of the box body (11). *Id.*, Abstract.



See, e.g., Figs. 1, 2.

VII. STANDARD FOR GRANTING *INTER PARTES* REVIEW

Institution of an *inter partes* review is discretionary. 35 U.S.C. §314(a), 325(d); 37 C.F.R. §42.108(b); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, IPR2013-00324, Paper 19 at 4 (P.T.A.B. Nov. 21, 2013) (“Congress made institution discretionary.”). The Board may consider numerous factors, including the finite resources of the Board and petitioner’s delay in bringing the petition after learning of the prior art. See *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, Paper 19, at 9 (Sept. 6, 2017) (precedential).

Under 35 U.S.C. §314(a), the Board can institute an *inter partes* review only in those circumstances where “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” See also 37 C.F.R. §42.108(c). Petitioners have the burden to show that this statutory

threshold has been met. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756 (Aug. 14, 2012). In particular, the “petition ‘must specify where each element of the claim is found in the prior art patents or printed publications relied upon;’ and it ‘must include . . . a detailed explanation of the significance of the evidence including material facts.’” *Norman Noble, Inc. v. NuTech Ventures*, IPR2013-00101, Paper No. 14 at 10, 2013 WL 5970193, at *6 (June 20, 2013) (citing 37 C.F.R. §42.104(b)(4); 37 C.F.R. §42.22(a)).

VIII. THE BOARD SHOULD DENY INSTITUTION BASED ON CLAIM PRECLUSION RESULTING FROM PETITIONER’S DISMISSAL WITH PREJUDICE OF ITS COUNTERCLAIM OF INVALIDITY OF THE ’950 PATENT.

1. Claim Preclusion Bars Petitioner’s Challenge

Fellowes’ *inter partes* challenge to the validity of claims of the ’950 Patent is barred by claim preclusion (*res judicata*). In the parallel district court litigation, Fellowes asserted a counterclaim of invalidity against the ’950 Patent:

COUNT III

Non-Infringement and Invalidity of U.S. Patent Nos. 8,342,325; 8,393,466; 8,526,180; 8,531,834; 8,564,950; 9,549,598; 9,660,684; and 9,498,033;

EX1011 p. 93. Fellowes voluntarily dismissed with prejudice its counterclaims by stipulation, including its counterclaim of invalidity of the ’950 Patent:

STIPULATION OF DISMISSAL UNDER FRCP 41(A)

Counter-plaintiff Fellowes, Inc. and counter-defendants Otter Products, LLC and Treefrog Developments, Inc. hereby stipulate that the causes of action pled in the counterclaim of Docket Entry 30 (filed Dec. 4, 2019) be dismissed with prejudice in accordance with Federal Rule of Civil Procedure 41(a)(1)(ii). For the sake of clarity, the answer portion of that filing is not dismissed.

EX1012 (Stipulation of Dismissal).

A dismissal with prejudice, including by stipulation, operates as an adjudication on the merits for claim preclusion purposes. *In re PersonalWeb Techs. LLC*, 961 F.3d 1365, 1379 (Fed. Cir. 2020) (“PersonalWeb’s stipulated dismissal with prejudice in the Texas case operated as an adjudication on the merits for claim preclusion purposes.”); *see also Highway Equip. Co. v. FECO, Ltd.*, 469 F.3d 1027, 1035-36 (Fed. Cir. 2006); *Pactiv Corp. v. Dow Chem. Co.*, 449 F.3d 1227, 1230 (Fed. Cir. 2006) (regarding dismissal with prejudice pursuant to a joint stipulation, “[a] dismissal with prejudice is a judgment on the merits for purposes of claim preclusion.”)

“Under the doctrine of claim preclusion, ‘a judgment on the merits in a prior suit bars a second suit involving the same parties or their privies based on the same cause of action.’” *PersonalWeb Techs.*, 961 F.3d at 1374. Here, Patent Owner and Petitioner engaged in district court litigation (i.e., a prior suit), where Petitioner’s

counterclaims of invalidity of the '950 Patent were disposed of by its dismissal of its countercomplaint with prejudice. EX1003 (Stipulation of Dismissal).

Notwithstanding, months after Petitioners' dismissal of its invalidity counterclaim with prejudice, Petitioner filed its petition seeking to institute an *inter partes* review (i.e., a second suit)² involving the same parties (Otter Products, LLC and Fellowes Inc.) based on the same cause of action (i.e., a claim of invalidity of the '950 Patent). *PersonalWeb Techs.*, 961 F.3d at 1374. Petitioner's dismissal with prejudice operates as an adjudication on the merits to bar Fellowes from challenging the validity of the '950 Patent in this IPR petition. *Id.* at 1379.

The Board has previously considered whether judgments in the district court bar America Invents Act post grant proceedings. *Smith & Nephew, Inc. v. Arthrocare Corp.*, No. IPR2017-00275, Paper 36 (P.T.A.B. May 2, 2018), *vacated*

² *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 1328-29 (Fed. Cir. 2008) (affirming finding of claim preclusion where first action was district court litigation and second action was administrative proceeding before the Trademark Trial and Appeal Board); *Young Eng'rs, Inc. v. ITC*, 721 F.2d 1305, 1316 (Fed. Cir. 1983) (finding claim preclusion from district court action could bar administrative action before the ITC).

on other grounds *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019) (considering whether settlement resulting in dismissal with prejudice barred IPR but finding settlement explicitly reserved right to maintain IPR proceeding); *SAP Am., Inc. v. Versata Development Grp.*, No. CBM2012-00001, Paper 36, at 18-19 (P.T.A.B. Jan. 9, 2013) (considering whether district court verdict barred CBMR but finding claim preclusion did not apply because district court decision was not immune from reversal or amendment because it was on appeal). Neither exception to *res judicata* previously considered by the Board serves to resurrect Petitioner's claim.

In *Smith & Nephew* and *SAP America*, the Board would have applied claim preclusion to bar the AIA proceeding if the necessary factual predicates had been met. In *Smith & Nephew*, the Board relied on Federal Circuit authority providing that “the parties can, in a separate agreement, reserve the right to litigate a claim that would otherwise be barred by *res judicata*.” IPR2017-00275, Paper 36 (citing *Pactiv*, 449 F.3d at 1230–31). Noting the parties' confirmation at oral arguments that the settlement agreement provided that the petition was not barred by *res judicata*, the Board was satisfied the dismissal with prejudice did not bar the proceeding. *Id.* Here, the necessary factual predicates are met. Fellowes did not reserve the right to challenge the validity of the '950 patent through *inter partes* review when it voluntarily dismissed its claims with prejudice.

In *SAP America, Inc.*, the Board relied on a pending appeal of the final judgment to the Federal Circuit to hold the “judgment [was] not sufficiently firm to be accorded conclusive effect for purposes of 37 C.F.R. 42.302[.]” CBM2012-00001, Paper 36, at 19. Here, Petitioner’s stipulation of dismissal with prejudice was voluntary and not subject to appeal, and is sufficiently firm to result in preclusion.

Consistent with *Smith & Nephew* and *SAP*, *res judicata* applies to bar relitigation of the validity of the ’950 Patent and is not subject to an exception. Claim preclusion bars Fellowes’ repeated challenge to the validity of claims of the ’950 Patent. The Board should deny institution of the petition under §314(a).

2. Response to Petitioner’s Argument

Petitioner admits it challenged the validity of the ’950 Patent in its counterclaims against Patent Owner. Pet. at 67-68. Petitioner admits it stipulated to a dismissal with prejudice (i.e., an adjudication on the merits). *Id.* And Petitioner admits that it reserved only its affirmative defenses, not any affirmative claims. *Id.* The legal requirements are met and claim preclusion applies.

A. Claim Preclusion—Not Issue Preclusion—Bars Institution of the IPRs.

Claim preclusion—not issue preclusion—bars institution of the IPR.³ Claim preclusion is not issue preclusion. Claim preclusion requires 1) a prior adjudication on the merits, 2) same parties or their privities, and 3) same cause of action. *In re PersonalWeb Techs.*, 961 F.3d at 1374. Issue preclusion requires 1) final adjudication, 2) issue or fact actually litigated, and 3) same parties. *B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 148 (2015). Petitioner’s arguments on issue preclusion miss the mark.

Patent Owner has not asserted issue preclusion as facts relating to validity were not resolved by a finder of fact. Claim preclusion has no such requirement; and unlike issue preclusion, applies even where different standards of proof applied:

The purpose of claim preclusion, *unlike issue preclusion*, is to prevent the waste of resources and the harassment to the defendant that stem from the piecemeal litigation of claims.... And applying claim preclusion when there are varying burdens of proof does not raise any

³ Petitioner conflates issue preclusion and claim preclusion. *See* Pet. at 67-71, *passim*; *id.* at 67 (Section VII, “Patent Owner’s Anticipated *Issue Preclusion* Argument Does Not Apply” (emphasis added).)

problem analogous to the problem of applying issue preclusion....
O'Shea v. Amoco Oil. Co., 886 F.2d 584, 594 (3d Cir. 1989)⁴; *see also Exxon Mobil Corp. v. Schneiderman*, 316 F. Supp. 3d 679, 702 (S.D.N.Y. 2018).

Petitioner's issue preclusion arguments, Pet. at 69-71, are of no moment. *Novartis AG v. Noven Pharm., Inc.*, held that the Board was not bound by the factual findings of a district court case (i.e., issue preclusion) because the burdens were different and the records were different. 853 F.3d 1289, 1293-94 (Fed. Cir. 2017). Novartis failed to raise the defense of claim preclusion to the Board. IPR2014-00549, Papers 68 and 72; Fed. R. Civ. P. 8(c)(1). *Novartis* is inapposite. Petitioner argues that Patent Owner's cases—*SAP America* and *Smith & Nephew*—do not support application of *issue preclusion*. Pet. at 70. Patent Owner asserts *claim* preclusion. *Smith & Nephew* raised claim preclusion *sua sponte*. IPR2017-00275, Paper 36, at 4. *SAP America* considered both claim preclusion and issue preclusion. CBM2012-00001, Paper 36, at 18-19. Both matters demonstrate the applicability of claim preclusion.

B. Patent Owner's Motion for Entry of Partial Judgment is Irrelevant

Patent Owner's motion for partial judgment has no relevance to this

⁴ All emphases added.

proceeding. Patent Owner filed the motion to perfect judgment so it could seek attorneys' fees incurred responding to Petitioner's infringement counterclaims.⁵ That the district court indicated it understood Fellowes' reservation of its "Answer" was sufficient to preserve a right to *defend* against the claims and Patent Owner's resulting withdrawal of the motion is of no moment. *And see* EX1015, at 4:9-11 (Petitioner: "And that last line there preserves *all our defenses* that we put in our [response]."); EX1012. Petitioner elected to dismiss its challenge to the '950 Patent with prejudice. EX1012. The adjudication was final for claim preclusion, and Petitioner reserved no more than a right to *defend*. *Id.*; *see PersonalWeb*, 961 F.3d at 1379; *Pactiv*, 449 F.3d at 1231 (under res judicata, reservation of any right to continue litigating "must be express.").

⁵ Petitioner's filing included counterclaims of infringement of Petitioner's patents. Patent Owner's accused products were on sale years before Petitioner's priority date, a fact noticed in the original Complaint (EX1003, ¶18) and invalidating the patents under Petitioner's own contention. Consequently, Patent Owner answered and asserted counterclaims of invalidity. Petitioner defaulted on its Answer, and then agreed to dismiss *all* of its counterclaims with prejudice, reserving only its Answer and focusing the Parties' dispute to the district court matter. EX1012.

C. Petitioner’s preservation of “defenses” failed to reserve the right to affirmatively challenge validity in an IPR.

Petitioner contends issue preclusion cannot attach because it reserved its Answer in its stipulated dismissal. Pet. at 67-68; EX1012. Even if Petitioner’s argument was re-directed to the claim preclusion at issue here, Petitioner’s argument fails. A dismissal with prejudice serves as an adjudication on the merits *unless* the parties agree to “reserve the right to litigate a claim that would otherwise be barred by *res judicata*.” *Pactiv*, 449 F.3d at 1230–31. “But th[e] reservation must be express.” *Id.* Petitioner contends it reserved its defenses, but uncontestably did not reserve a right to file any new challenges, including the present petition. EX1012; *and see* 2 Freeman on Judgments (1925) (“*res judicata* [rests]... on the broad ground of public policy that requires a limit to litigation.”).

D. Petitioner’s statutory estoppel arguments fail.

Claim preclusion is a foundation of Federal common-law. But as such, Congress may add to (e.g. §315(e)) or modify (e.g. §311(a) (assignor estoppel) or former §317(b)) its estoppel effects. Petitioner cites to no controlling statutes or cases, and presents no arguments, to clearly show that Congress intended to block the application of ordinary *claim* preclusion in AIA proceedings, especially following express action (e.g., a stipulation) by the petitioner. *United States v. Texas*, 507 U.S. 529, 534 (1993) (“In order to abrogate a common-law principle, the statute must ‘speak directly’ to the question addressed by the common law.”).

Petitioner argues that issue preclusion cannot apply because pre-AIA 35 U.S.C. §317(b) had an estoppel provision that, in part, barred *inter partes* reexams after district court proceedings. Pet. at 93. Assuming again these arguments concerned the *claim* preclusion at issue here, the specialized estoppel provision of §317(b) did not negate the applicability of preclusion and provided a specific exception to its scope by permitting subsequent petitions based on newly available prior art. 35 U.S.C. §317(b) (pre-AIA). In any event, its omission in the *current* statute does not inform any Congressional intent to limit the ordinary operation of claim preclusion in this AIA proceeding. *See Texas*, 507 U.S. at 534.

Petitioner next argues that issue preclusion cannot apply as it is not codified in 35 U.S.C. §315(e). Pet. at 71. To the extent these arguments apply to claim preclusion, they also fail. Section 315(e) controls the estoppel resulting from IPR final written decisions, not adjudications in district court, and does not inform claim preclusion. *And see Texas*, 507 U.S. at 534 (statute must speak directly to issue in order to abrogate common-law). Failing to estop a petitioner who has substantively exercised any right to affirmatively assert claims in district court is contrary to the efficiencies intended and established by Congress. *See Texas*, 507 U.S. at 534 (statutes presumed to retain “long-established and familiar principles, except when a statutory purpose to the contrary is evident”); *e.g.*, 35 U.S.C. §315(a)(1), (b).

By its stipulation, Petitioner elected to focus its resources in defense of the district court matter, and here concedes the requirements of claim preclusion. The Board should apply it here and exercise its discretion to deny institution of the IPR. The Board previously considered claim preclusion in AIA proceedings, indicating its applicability barring an exception. *See* Section VIII(1). The Board need not expend resources when Petitioner took express action to dismiss its affirmative claim as an adjudication on the merits, the hallmark of claim preclusion.

IX. PETITIONER FAILED TO SHOW A REASONABLE LIKELIHOOD THAT IT WILL PREVAIL WITH RESPECT TO OBVIOUSNESS OF ANY CLAIM OF THE '950 PATENT.

Every Ground in the Petition fails to establish that each claimed element is present in the cited reference combinations and further fails to establish a proper motivation to combine or modify the references to arrive at the claimed invention. The Petition must contain a reasoned analysis supported by evidence to sustain an obviousness ground. Hindsight is not enough. Here, the Petition fails because it provides only conclusory allegations of obviousness. For this reason alone, the Petition should be denied in its entirety.

1. Petitioner fails to perform a particularized showing of a motivation to combine its myriad of prior art references.

Petitioner fails to establish any motivation to combine any of the prior art references in Grounds 1-6. This alone is grounds to deny institution of the *inter partes* review. *See Johns Manville Corp. v. Knauf Insulation, Inc.*, Case IPR2018-

00827, Paper 9 (Oct. 16, 2018) (informative) (denying institution for insufficient reason to combine references).

As an initial burden, the Petition must establish that the references used in each Ground are analogous art. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). A reference is analogous art to the claimed invention if: (1) the reference is from the same field of endeavor as the claimed invention (even if it addresses a different problem); or (2) the reference is reasonably pertinent to the problem faced by the inventor (even if it is not in the same field of endeavor as the claimed invention). *See id.*

Separate from, and in addition to, the requirement that the art be analogous, the Petition must also establish that there was a motivation to combine or modify the references to arrive at the claimed invention. Establishing a case of obviousness requires an analysis of “whether a [person of ordinary skill in the art] would have been motivated to combine the prior art to achieve the claimed invention and whether there would have been a reasonable expectation of success in doing so.” *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016); *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016). To establish a motivation to combine, the rejection cannot employ mere conclusory statements; rather there must be some “specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools*

Int'l, Ltd., 829 F.3d 1364, 1380 (Fed. Cir. 2016). For instance, “a finding that a combination of prior art would have been ‘common sense’ or ‘intuitive’ is no different than merely stating the combination ‘would have been obvious,’” and “[s]uch a conclusory assertion with no explanation is inadequate to support a finding that there would have been a motivation to combine.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). The Federal Circuit has reiterated that the “[t]he factual inquiry whether to combine references must be thorough and searching” and “[t]he need for specificity pervades [the Federal Circuit’s] authority” on the PTAB’s findings on motivation to combine. *In re NuVasive, Inc.*, 842 F.3d 1376, 1381-82 (Fed. Cir. 2016). The present Petition has failed to provide even cursory reasoning or evidence to establish any motivations to combine or modify the references used in each of the Grounds, much less the “thorough and searching” inquiry required. *Id.*

At best, Petitioner’s motivations to combine are based on each prior art reference being directed to a protective case or enclosure of a mobile or electronic device. This is insufficient. *Johns Manville Corp.*, IPR2018-00827, Paper 9, at 10-11. “Demonstrating that a reference is analogous art or relevant to the field of endeavor of the challenged patent is not sufficient to establish that one of ordinary skill would have had reason to combine its teachings with other prior art in the manner set forth in the claim.” *Id.* “Mere compatibility of the references is likewise

not sufficient.” *Id.*; see also *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993 (Fed. Cir. 2017) (it is not enough to show that “a skilled artisan, once presented with the two references, would have understood that they could be combined”).

Petitioner’s conclusory statements regarding motivation to combine mirror the conclusory statements Petitioner made in IPR2020-00852. The Board expressly found the Petitioner’s conclusory statements were insufficient to meet the required threshold showing:

Petitioner asserts eight grounds based on obviousness. We decline to institute review based on any of them, because we agree with Patent Owner that, for each ground, Petitioner fails to identify an adequate reason why an ordinarily skilled artisan would have combined the references in a manner that achieves the claimed invention. The reasons to combine, stated in the Petition, are insufficient to meet the threshold showing necessary to support trial institution.

Fellowes, Inc. v. Otter Products, Inc., IPR2020-00852, Paper 16, at 8-9 (P.T.A.B. Oct. 29, 2020) (internal citations omitted). Dr. Garriss’s opinions here also suffer from the same conclusory issues that the Board rejected. *Id.* (“For each of the remaining obviousness grounds, Petitioner identifies one or more reasons for a proposed combination of prior art features, but none is tethered adequately, if at all, to objective proof, and each rests instead on bare opinion testimony. ... Our reviewing court has ‘repeatedly recognized that conclusory expert testimony is

inadequate to support an obviousness determination on substantial evidence review.””) (internal citations omitted). The Board can and should reject Petitioner’s obviousness grounds in the instant petition for the same reason.

Because Fellowes has failed to demonstrate a rationale or justification to combine any of its references in Grounds 1-6, Fellowes cannot meet its burden to show the claims of the ’950 Patent were obvious to one of ordinary skill in the art. The Board should deny institution.

2. Ground 1: Kuhn in view of the ’712 Patent fails to teach claims of the ’950 Patent.

Petitioner contends Claims 17, 19, and 21 of the ’950 Patent are obvious over Kuhn in view of the ’712 Patent.

The switch mechanism of the ’712 Patent was before the Examiner and expressly considered by the Examiner during prosecution. *See* EX1002 at 606 (identifying considered and relevant but not relied on prior art), 608 (identifying the ’712 Patent as a considered reference). The Examiner was fully aware of the switch mechanism and the potential ability to combine it with additional references. The Examiner allowed the ’950 Patent to issue over the ’712 Patent. The Board need not reconsider work expressly considered by the Examiner. EX1002 at 606, 608.

A. No Motivation to Combine References

Petitioner cherry picks elements of contrasting embodiments of Kuhn without providing any motivation to combine. This is improper. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005); *Fellowes, Inc. v. Otter Products, LLC*, IPR2020-00852 (P.T.A.B. Oct. 29, 2020), Paper 16, at 9 (“the proposed reason to [combine] is not tethered to any identified disclosure in the prior art, but appears instead as no more than reconstruction of the claimed invention based on advantages disclosed in the [patent].”) A motivation to combine, even between embodiments of the same reference, is required. *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (“Whether a rejection is based on combining disclosures from multiple references, **combining multiple embodiments from a single reference**, or selecting from large lists of elements in a single reference, there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.”) (emphasis added). Here, Petitioner relies on multiple discrete embodiments of Kuhn but offers no motivation to combine such embodiments. *See* Pet. at 27 (“Kuhn discloses **embodiments** of an encasement to form the housing 31 to enclose a computing device, i.e., mobile phone 32. *See* Exh. 1004 ¶¶ [0001], [0013], *passim*; FIGS. 3, 6, 7, 9-14.”) (emphasis added); *see also* Pet. at 29-32 (discussing elements 17[g] and

17[h]). Without a motivation to combine the embodiments of Kuhn, Petitioner cannot meet its burden to prove claims of the '950 Patent are unpatentable.

Moreover, the express teachings of Kuhn would discourage a POSITA from combining it with any of secondary reference to achieve the claimed invention of the '950 Patent, and in particular any teachings of the '712 Patent. Kuhn criticizes protective cases that are specially adapted to specific models or device types.

EX1004, ¶¶[0009]-[0010] (“[A] serious disadvantage of the [prior art] is that a special enclosure must be provided for each model of a handheld computer....The number of different models of handheld computers (Personal Digital Assistant) or mobile phones known today requires having on hand an unmanageable number of different designs of enclosures...”). Indeed, the invention of Kuhn is expressly directed “to overcom[ing] the aforementioned disadvantages, i.e. to specify an enclosure for a mobile phone equipped with a camera, which is designed waterproof *and that can be used for a variety of different device types.*” (*Id.*, ¶[0011] (emphasis added).) The '950 Patent, on the other hand, discloses an enclosure that is adapted for housing a specific device. EX1001, 3:1-13.

Consistent with these teachings, independent claim 17 affirmatively requires a “frame that corresponds to the outer perimeter of the electronic device.” The frame closely parallels and/or immediately surrounds the outer perimeter of the enclosed device. Petitioner’s application of Kuhn reads this limitation out of the

claim. The claims that depend thereon add additional features that must be specifically placed so as to enable engagement with the underlying features of a particular model of electronic device. (*Id.*, Claim 17.) Claim 17 requires numerous structures related to its switch mechanism (*e.g.* Limitations 17[j] and 17[k]) that would require precise placement on an enclosure in order to “contact” and “actuate” a “switch of the mobile computing device” as expressly required. Making such precise modifications by combining Kuhn with any secondary reference to achieve the invention of the ’950 Patent would make it incompatible with other mobile computing devices and vitiate the purpose for which Kuhn was invented, a result that weighs against finding a POSITA would have had a motivation make such a combination. EX2002, ¶¶64-65. “If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP §2143.01(V) (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)); *Plas-Pak Industries, Inc. v. Sulzer Mixpac AG*, 600 Fed. Appx. 755, 759-60 (Fed. Cir. 2015) (affirming Board finding of nonobviousness because adding an element from one prior art reference to a second prior art reference would have rendered the second reference “inoperable for its intended purpose”).

Petitioner further offers no rationale or motivation, besides hindsight, to combine the switch of the ’712 Patent with the protective enclosure of Kuhn.

Petitioner argues that Kuhn provides an express motivation to combine because Kuhn makes the unqualified statement that the Kuhn invention “allows the user to have use of the entire control of the mobile phone.” Pet. at 46-47.⁶ But Kuhn’s generic statement suggests nothing of applying a switch or affixing any structure to the outside of the Kuhn encasement. *See* EX1004, ¶[0048]. Indeed, Kuhn’s instruction that “use of the entire control of the mobile phone” teaches away from any customization of the enclosure, as a modification (e.g., a switch mechanism) for one device would leave the enclosure incompatible with any device with a different form factor. EX2002, ¶65.

Petitioner further argues that applying the switch mechanism of the ’712 Patent would be obvious to a POSITA “because this is a well-known technique used in the art known to a POSITA.” Pet. at 47. Such conclusory statements fail to satisfy Petitioner’s burden to show the claimed invention would have been known in the prior art. *In re Van Os*, 844 F.3d at 1361 (“Such a conclusory assertion with no explanation is inadequate to support a finding that there would have been a

⁶ Petitioner fails to properly identify the support for its claim of express motivation to combine. *Compare* Pet. at 46-47 (citing EX1004, ¶[0047]) *with* EX1004, ¶[0047].

motivation to combine.’’). Petitioner’s asserted motivation is merely hindsight recognition: adding a camera case switch to a mobile device case.

Moreover, a POSITA would have been further discouraged from combining the teachings of Kuhn and the ’712 Patent because the ’712 Patent teaches away from such a combination. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference....”). The ’712 Patent criticizes the use of a rear cover (i.e. large, full-back), as used in Kuhn, because it may deform due to water pressure. EX1006, 1:22-67. Such design hindrances would be unsatisfactory to a POSITA. EX2002, ¶66. The Petition offers no explanation for why a POSITA would have been satisfied with the combination of Kuhn and the ’712 Patent, given the ’712 Patent’s explicit disavowal of rear covers.

A POSITA would further have been discouraged from combining Kuhn and the ’712 Patent because the combination would not have yielded the invention of the ’950 Patent. Specifically, the switch mechanism of the ’712 Patent would not have physically worked with the perimeter walls of Kuhn. EX2002, ¶67. Furthermore, absent from Petitioner’s argument is any suggestion, much less showing, that such a modification would even have been possible without undue modification. Pet. at 33-34, 44-47. Indeed, given Kuhn’s separated dual-walled structure, including a wide

cavity between the walls, the switch mechanism of the '712 Patent would have required substantial experimentation to adapt to the separated, dual-walled structure of Kuhn and properly engage a switch on the enclosed device. EX2002, ¶67. Nor would the modification have been feasible on the front of the housing, as the membrane of Kuhn could not include a switch because it is not thick/strong enough and because it would obscure part of the screen. *Id.*; e.g., EX1004, ¶[0071] (describing Kuhn's "rubber-like and *stretchable* film 28 (membrane seal)").

B. Ground 1 Fails to Teach All Limitations

An apparatus for covering at least part of a mobile computing device having a touch screen display

As discussed in Section V(2), Claim 17's preamble's recitation of "[a]n apparatus for covering at least part of a mobile computing device having a touch screen display" is limiting because it provides antecedent basis and gives meaning to further limitations. Kuhn does not teach "[a]n apparatus for covering at least part of a mobile computing device having a touch screen display."⁷ Pet. at 26, 36. Kuhn does not teach covering a device with a touch screen. Petitioner argues that Kuhn teaches a touch screen because paragraph [0019] states that the display of the

⁷ Kuhn also fails to teach "an encasement that enables operation of the touch screen display" as described in limitation 17[b].

mobile phone can be used under the transparent and/or elastic material. Pet. at 36. Paragraph [0019] says nothing about a touch screen or touch sensitivity. Paragraph [0019] only means that a user can see the display through transparent/elastic material.

Petitioner concedes this point by arguing that Kuhn further teaches a touch screen by referencing U.S. Patent Publication No. 2003/0095374 (EX1017, “the ’374 Publication”). But the invention of Kuhn does not incorporate the teachings of the ’374 Publication.⁸ Instead, Kuhn expressly criticizes the ’374 Publication, referencing it in the section detailing the disadvantages of the prior art that must be overcome. EX1004, ¶¶[0006]-[0011]. Petitioner identifies Ground 1 as the combination of Kuhn and the ’712 Patent, not the combination of Kuhn, the ’374 Publication, and the ’712 Patent. Moreover, Kuhn’s express criticism of the ’374 Publication bars any motivation to combine Kuhn with the ’374 Publication. EX2002, ¶69.

Petitioner points out that an embodiment of the ’712 Patent works with a touch screen device. Pet. at 37-38. Petitioner, however, offers no explanation of how the

⁸ Kuhn does not incorporate by reference any of the teachings of the ’374 Publication. Kuhn expressly criticizes the ’374 Publication. EX1004, ¶[0009].

structure of Kuhn could be modified by the teachings of the '712 Patent to teach the limitations of the Claim 17 of the '950 Patent with respect to the touch screen device. Instead, Petitioner merely concludes that because the '712 Patent was a protective enclosure for a touch screen device, Kuhn could and should be modified to work with a touch screen device. Pet. at 37-38. This is classic impermissible hindsight. Petitioner has failed to show that Ground 1 teaches “An apparatus for covering at least part of a mobile computing device having a touch screen display” as required by limitation 17[a]. Petitioner’s Ground 1 fails for this reason alone.

[A] rigid frame that corresponds to ... the perimeter portion of the bottom member

Kuhn further fails to teach limitation 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 portion of the bottom member*” (emphasis added)). Petitioner contends that Kuhn element 40 satisfies this limitation. Pet. at 29. It does not. EX2002, ¶¶72-74.

First, Kuhn does not teach that element 40 “correspond[s]” to the outer perimeter of an electronic device, nor would it given the stated purpose of designing a housing for “use for “a variety of different device types.” EX1004, ¶[0011]. Indeed, use of any such “variet[ies] of different device types” contemplated by Kuhn, each having different dimensions and configurations, would necessarily leave different gaps between the sides of the device and element

40. EX2002, ¶73. Petitioner implicitly concedes Kuhn’s failure to teach this limitation by offering Figure 4 to support its contention, which does not depict any device, instead of Figure 3, which demonstrates significant gaps and a lack of correspondence between the “outer perimeter of the electronic device” and element 40. *And see* EX1004, Fig. 3 (annotated below). Element 40 of Kuhn cannot “correspond” to the “outer perimeter of [an] electronic device” because Kuhn requires it create a space large enough for *any* of a “variety of different device types.” EX1004, ¶[0011]. Petitioner’s contention reads out this express requirement of Claim 17 and must be rejected.

Second, and as shown in Figure 3, even to the extent that element 40 of the top member corresponds to the “outer perimeter of the electronic device,” it does not correspond to “the perimeter portion of the bottom member.” Instead, there is a gap between element 40 (yellow) and the perimeter of the bottom portion (red).

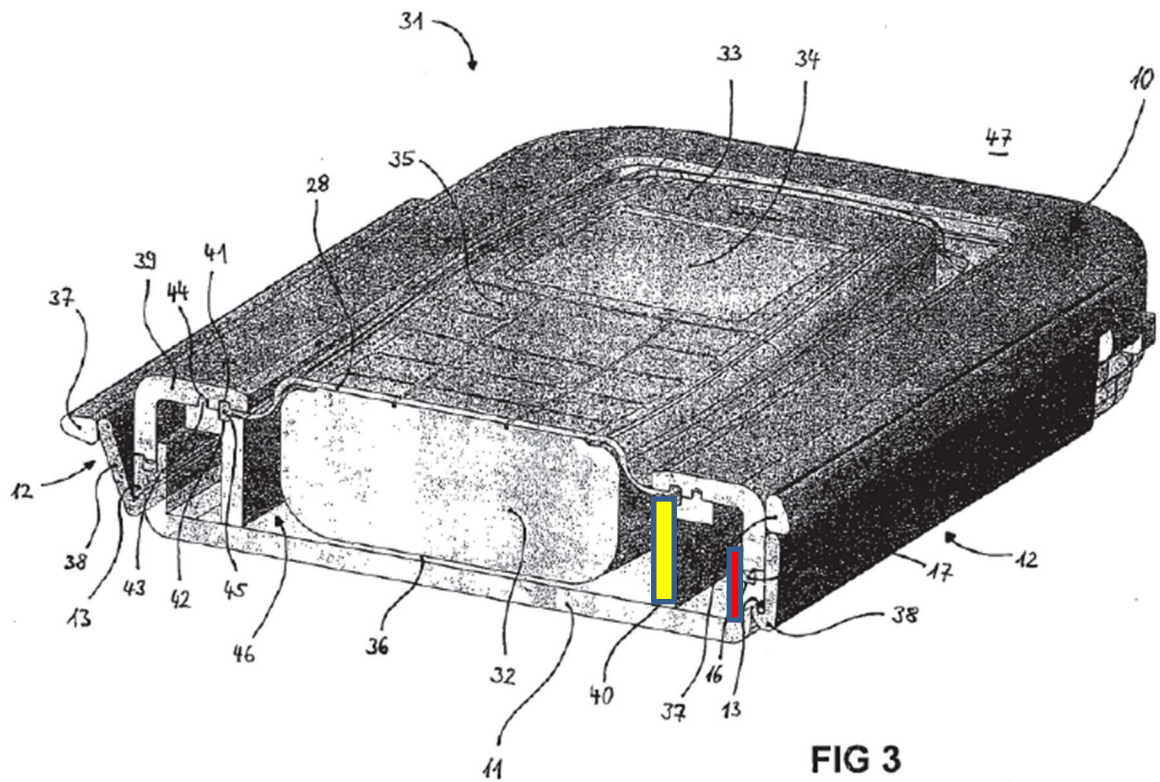


FIG 3

Petitioner ignores the same and again reads out the express limitations of limitation 17[g].

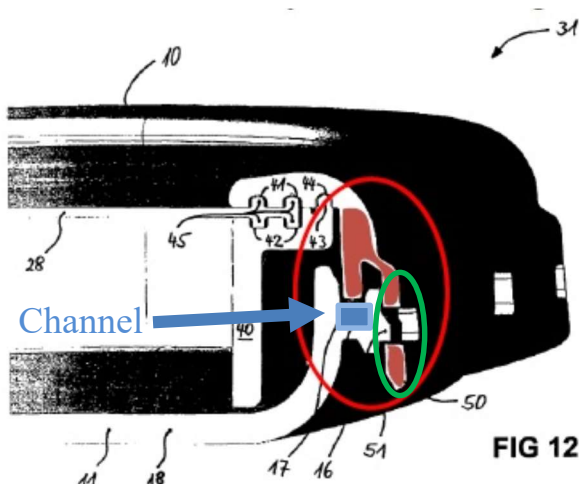
Petitioner’s argument that “[t]he rigid frame also corresponds to the perimeter portion of the bottom member because they both have matching rectangular shapes” (Pet. at 41) is without merit; the limitation does not require analogy between the “shapes” of the rigid frame and perimeter portion, but rather “correspond[ence] ... to the *perimeter portion*” (EX1001, Claim 17). Element 40 and the perimeter of the bottom portion are discrete structures. They do not correspond to each other. EX2002, ¶74. Moreover, element 40 and the perimeter portion of the bottom member do not have “matching rectangular shapes”. As seen in Figure 3, element

40 is taller and wider than the perimeter portion of the bottom member. Kuhn does not teach “a top member having an inner perimeter defined by a rigid frame that corresponds ...the perimeter portion of the bottom member”. Petitioner makes no argument that the ’712 Patent corrects this deficiency. Petitioner’s Ground 1 fails for this additional reason alone.

[T]he rigid frame extending to a ridge that is adapted to clasp within the channel of the bottom member

Kuhn additionally fails to teach limitation 17[h] (“the rigid frame extending to a ridge that is adapted to clasp within the channel of the bottom member...”). Petitioner posits two interactions that purportedly meet the limitation. Pet. at 30-32, 41-44. Both fail. EX2002, ¶¶75-78.

Petitioner first argues that the interaction of elements 50 and 51 satisfies the limitation. Pet. at 30-31 (citing Fig. 12). The clasping of elements 50/51 does not, however, occur “*within the channel* of the bottom member” as required. As evident in Figure 12, the clasp of 50/51 (green annotation, below) is external to the channel (blue annotation, below) and thus not within the channel:



EX1004, Figure 12 (red modifications made by Petitioner (Pet. at 31); blue and green alterations by Patent Owner); EX2002, ¶76. Moreover, Kuhn’s closure element (50) does not have a ridge extending down from the ridged frame, which is part of the *inner* perimeter of the top member (*see* 17[g]). Instead, closure element (50, red annotation) extends from the *outer perimeter* of the frame of the first housing part (10). EX1004, ¶¶[0084], [0085] (“A frame element 39, to which the closure element 50 is attached”), Fig. 12. Petitioner further concedes that the 50/51 clasp is not within the channel by arguing that the structure extending from the frame into the channel forms a “form-fitting” or “form-locking” connection within the channel, separate and distinct from the operation of elements 50/51. Pet. at 31-32, 41-42.

As to Petitioner’s reliance on the purported use of “form-fitting” or “form-locking,” any such teachings are not the same as clasping. Petitioner’s own dictionary citation makes clear that the plain and ordinary meaning of clasping

requires a structure—“a device (such as a hook)”—to hold the objects together. Pet. at 43. Petitioner points to no structure that functions as a clasp or clasp mechanism. Nowhere in the specification of Kuhn, nor in the application’s figures, is the extension from frame (39) described or illustrated as having a structural component clasping with a corresponding structural component within the channel.

Nor does Kuhn disclose how any such “form-fitting” or “form-locking” is achieved; nowhere in the Kuhn reference is there a teaching or other disclosure of a “ridge adapted to clasp within the channel of the bottom member”. Nor does Petitioner make an argument that the existence of such structures in the combination and arrangement required by Claim 17 is inherently necessary in order for there to be “engage[ment]” or a “partial[] form-lock[]”. A POSITA would understand such structures are not required or even suggested by Kuhn’s silence, including at least because Kuhn instead expressly teaches the use of external latching mechanisms. EX2002, ¶¶76-77. Although Kuhn refers to the groove on the bottom member as a “locking groove,” the “locking” is only achieved through the use of one of the external securement mechanisms. Kuhn states: “The connection between the first housing part 10 and the second housing part 11 *is secured by two locking clamps 12.*” EX1004, ¶[0052]. Indeed, it is the force created by these locking clamps that directs the first housing part into the groove and applies the pressure against the rubber seal therein. EX1004, ¶[0053]

(“The water tightness of the closure . . . is made by means of the rubber seal 17 *and two locking clasps 12.*”) (emphasis added). Likewise, in an alternate embodiment closure elements 50/51 are used to seal the housing parts. EX1004, ¶[0084] (“The connection between the first housing part 10 and a second housing part 11 *is held or rather secured by means of closure elements 50, 51 . . .*”) (emphasis added). From these teachings, a POSITA would understand “form-fitting” or “form-locking” to indicate, at most, that the bottom of wall 39 and the channel serve to align the top and bottom members such that the required external closure mechanisms can be engaged. EX2002, ¶76. Petitioner has failed to show how Kuhn discloses, either literally or inherently, the first and second latching mechanisms arranged as in Claim 17.

The claim language is exacting. The rigid frame and bottom member must be “adapted to clasp”, not align in a form-fitting or form-locking manner. Even to the extent Kuhn’s references to “form-fitting” or “form-lock” inform a structure that secures the top and bottom members, Petitioner tries to read out the requirement that these structures “clasp” together by calling all retention mechanisms clasps. This is improper and is not consistent with the teachings of the ’950 Patent. The express language of Claim 17 requires that a clasp structure is needed. Kuhn teaches no such structure within the channel, and thereby does not disclose the elements of the claim arranged as in the claim. Petitioner makes no

argument that the '712 Patent corrects this deficiency. Petitioner's Ground 1 fails for this reason alone.

Kuhn in view of the '712 Patent fails to teach at least elements 17[a], 17[b], 17[g], and 17[h] of Claims 17 of the '950 Patent. Therefore, Kuhn in view of the '712 Patent does not render Claim 17 obvious and *ipso facto* does not render Claims 19 and 21 obvious. The Board should decline to institute Ground 1.

3. Ground 2: Kuhn in view of the '712 Patent in view of Richardson fails to teach claims of the '950 Patent.

Petitioner contends Claims 17, 19, and 21 of the '950 Patent are obvious over Kuhn in view of the '712 Patent in view of Richardson. Petitioner relies on Richardson to fill deficiencies present in Claims 17 and 21 (and by dependency 19). Pet. at 50-51. The deficiencies and lack of motivations to combine from Ground 1 are equally applicable to Ground 2.

A POSITA would not have been motivated to combine the teachings of Kuhn and Richardson. Petitioner contends that “a key consideration in designing a protective encasement for a device is that the features of the device dictate the features of the encasement.” Pet. at 52. Kuhn, however, expressly criticizes such design motivations. EX1004, ¶¶[0009]-[0010]. Kuhn presents itself as a waterproof case that can be used for a variety of different device types, and thereby informs a POSITA that the features of Kuhn's housing are in fact *agnostic* as to the features of the device. *Id.*, ¶[0011]. See Section IX(2) (Ground 1). Kuhn criticizes teachings like

Richardson where a separate designed enclosure is required for each individual device model. EX1004, ¶¶[0009]-[0010]. A POSITA would not have looked to Richardson to modify Kuhn. EX2002, ¶83.

Petitioner argues it would be obvious to combine the teachings of Richardson, which teaches use with a touch screen, with Kuhn. Pet. at 51-52. Petitioner, however, provides no motivation, besides hindsight, to combine the Kuhn and Richardson references. *In re Van Os*, 844 F.3d at 1361 (“Such a conclusory assertion with no explanation is inadequate to support a finding that there would have been a motivation to combine.”). Petitioner offers no explanation of how the structure of Kuhn could be modified by the teachings of Richardson to teach the limitations of the Claim 17 of the ’950 Patent. Instead, Petitioner merely concludes that because Richardson (like an embodiment of the ’712 Patent) was a protective enclosure for a touch screen device, Kuhn could and should be modified to work with a touch screen device. This is classic hindsight and is improper. *See* EX2002, ¶85.

Petitioner argues that Richardson cures Kuhn’s deficiencies with respect to 17[h] because Richardson’s front and back shells “latch together using precisely manufactured male and female snaps.” Pet. at 53. But Petitioner fails to explain how these female and male snaps teach limitation 17[h], nor could it do so, as the

structures shown are all on the *outside* of the claimed protective enclosure, rather than within a channel as required. EX2002, ¶¶87-88.

Petitioner additionally references Richardson’s description of a “snap fit,” but this similarly fails to teach limitation 17[h]. Specifically, Richardson does not teach “the rigid frame extending to a ridge that is *adapted to clasp within the channel* of the bottom member and seal against the gasket.” (Emphasis added.) Petitioner removes the context from Richardson’s description of a “snap fit” between the front shell and back shell. Richardson describes that the use of “precisely manufactured male and female snaps” with the addition of ridges that fit tightly within a groove” creates the “snap fit” relied upon by Petitioner. The Petition contends this “snap fit” meets limitation 17[h]. Petitioner is incorrect. A POSITA would understand the “snap fit” as created by the explicitly described *external snaps*, with alignment provided by the ridges and groove. EX2002, ¶¶87-88. Richardson’s reference to “ridges ... [that] fit tightly within a groove” (EX1005, ¶[0047]; Pet. at 53), suffers from the same deficiencies as the form-fitting and form-locking connections of Kuhn (i.e. there is no clasping structure). Nor would a POSITA be motivated to add a clasp *within the channel* as required, because Richardson already discloses the external “precisely manufactured male and female snaps.” EX2002, ¶¶87-88. In short, there is no teaching, literally or inherently, that Richardson’s “ridge” is adapted to clasp within the channel, as required by limitation 17[h].

Even to the extent Richardson’s “snap fit” describes a clasp, Richardson still fails to teach limitation 17[h]. Limitation 17[h] requires the clasping to occur “within the channel of the bottom member.” Richardson does not teach any engagement within the channel *of the bottom member*. Richardson teaches a groove in the top member, not the bottom member. EX1005, ¶[0047]; Pet. at 53. But Petitioner again fails to provide any motivation to combine the teachings of Richardson to Kuhn. Instead, Petitioner merely argues that a POSITA would have been aware of connection structures. Pet. at 54. This is an improper basis to combine prior art references.

Moreover, the structures of the claim are not interchangeable. The channel must be in the bottom member, not the top member. In IPR2020-00869, the Board explicitly rejected Petitioner’s attempt to place a “channel” in the “top member” when the claim required the “channel” be in the “bottom member” of a TreeFrog patent for related technology. *Fellowes, Inc. v. TreeFrog Developments, Inc.*, IPR2020-00869, Paper 16, at 4-5 (P.T.A.B. Oct. 29, 2020) (“On this record, we agree with Patent Owner that Petitioner seeks ‘to redraft the express limitations of’ Claim 28 (Prelim. Resp. 17) by redefining the ‘top member’ and ‘bottom member’ as interchangeable, even though the words of the claim define those members as having different orientations and distinctly different features. Ex. 1001, 116:18–44.”).

Ground 2 fails to disclose the elements of Claim 17 as arranged and should be denied.

Kuhn in view of the '712 Patent in view of Richardson fails to teach at least elements 17[h] of Claims 17 of the '950 Patent. Therefore, Kuhn in view of the '712 Patent in view of Richardson does not render Claim 17 obvious and *ipso facto* does not render Claims 19 and 21 obvious. The Board should decline to institute Ground 2.

4. Ground 3: Kuhn in view of JP384 fails to teach claims of the '950 Patent.

Petitioner contends Claims 17, 19, and 21 of the '950 Patent are obvious over Kuhn in view of JP384. Petitioner relies on JP384 to teach the switch elements of 17[j] and 17[k]. Pet. at 56. Petitioner does not argue, indeed Petitioner cannot, that JP384 cures any of Kuhn's deficiencies with respect to elements 17[a], 17[b], 17[g], and 17[h] as described in Ground 1. For this reason alone, Ground 3 must fail.

As to the asserted combination to teach elements 17[j] and 17[k], Petitioner fails to provide any motivation, besides hindsight, to combine the teachings of JP384 with Kuhn. Petitioner argues that applying the switch mechanism of JP384 would be obvious to a POSITA "because this is a well-known technique used in the art known to a" POSITA. Pet. at 60. Such conclusory statements fail to satisfy Petitioner's burden to show the claimed invention would have been known in the

prior art. *In re Van Os*, 844 F.3d at 1361 (“Such a conclusory assertion with no explanation is inadequate to support a finding that there would have been a motivation to combine.”). Petitioner’s asserted motivation is merely hindsight recognition: adding a camera case switch to a mobile device case.

A POSITA would further not be motivated to combine the teachings of JP384 and Kuhn. Petitioner acknowledges that the position of the switch on the device “dictates” the positioning of the switch on the protective encasement (Pet. at 57 (“[T]he choice of location is dictated by the location of the switch on the encased device itself”), requiring separate case designs for every device. Kuhn, however, expressly criticizes such design motivations, teaching instead a waterproof device that “can be used for a variety of different device types” and informing a POSITA that the features of Kuhn’s housing are in fact *agnostic* as to the features of the device. EX1004, ¶¶[0009]-[0010]; *and see* Section IX(2) (Ground 1). Kuhn pointedly criticizes teachings like JP384 where a separate designed enclosure is required for each individual device model, and thus directly teaches away from any designs or modifications “dictated” by the features of a particular device. EX1004, ¶¶[0009]-[0010]; Pet. at 57. A POSITA would not have looked to JP384 to modify Kuhn. EX2002, ¶¶95-99.

Kuhn in view of JP384 fails to teach at least elements 17[a], 17[b], and

17[h]⁹ of Claims 17 of the '950 Patent. EX2002, ¶¶101-107. Therefore, Kuhn in view of JP384 does not render Claim 17 obvious and *ipso facto* does not render Claims 19 and 21 obvious. The Board should decline to institute Ground 3.

5. Ground 4: Kuhn in view of JP384 in view of Richardson fails to teach claims of the '950 Patent.

Petitioner contends Claims 17, 19, and 21 of the '950 Patent are obvious over Kuhn in view of JP384 in view of Richardson. Petitioner relies on Richardson to teach the “touch screen display” (limitations 17[a] and [17[b]]) and clasp within the channel (limitations 17[h]), as described in Ground 2. Pet. at 60-61. Petitioner does not allege that Richardson cures Kuhn’s deficiency with respect to limitation 17[g]. On this basis alone, Ground 4 should be denied. Petitioner additionally offers no new argument with respect to the combination of Kuhn and Richardson. *Id.* Richardson, however, does not cure the deficiencies of Kuhn or the combination of Kuhn and JP384 (Ground 3).

A POSITA would not have been motivated to combine the teachings of Kuhn and Richardson. Petitioner contends that “a key consideration in designing a protective encasement for a device is that the features of the device dictate the features of the encasement.” Pet. at 52. Kuhn, however, expressly criticizes such

⁹ Petitioner makes no argument that JP384 teaches element 17[g]. Pet. at 56-60.

design motivations. EX1004, ¶¶[0009]-[0010]. Kuhn presents itself as a waterproof case intended for use for a variety of different device types, and thereby informs a POSITA that the features of Kuhn’s housing are in fact *agnostic* as to the features of the device. *Id.*, [0011]. *See* Section IX(2) (Ground 1). Kuhn criticizes teachings like Richardson where a separate designed enclosure is required for each individual device model. EX1004, ¶¶[0009]-[0010]; EX2002, ¶¶111-113. A POSITA would not have looked to Richardson to modify Kuhn. *And see* Ground 3, at 51 above.

Notwithstanding, Petitioner argues it would be obvious to combine the teachings of Richardson, which teaches use with a touch screen, with Kuhn. Pet. at 51-52. Petitioner, however, provides no motivation, besides hindsight, to combine the Kuhn and Richardson references. *In re Van Os*, 844 F.3d at 1361 (“Such a conclusory assertion with no explanation is inadequate to support a finding that there would have been a motivation to combine.”). Petitioner offers no explanation of how the structure of Kuhn could be modified by the teachings of Richardson to teach the limitations of the Claim 17 of the ’950 Patent. Instead, Petitioner merely concludes that because Richardson was a protective enclosure for a touch screen device, that Kuhn could and should be modified to work with a touch screen device. This is classic hindsight.

Petitioner argues that Richardson cures Kuhn’s deficiencies with respect to 17[h] because Richardson’s front and back shells “latch together using precisely

manufactured male and female snaps.” Pet. at 53. But Petitioner fails to explain how these female and male snaps teach limitation 17[h], nor could it do so, as the structures shown are all on the *outside* of the claimed protective enclosure, rather than within a channel as required. EX2002, ¶¶118-119.

Petitioner additionally references Richardson’s description of a “snap fit,” but this similarly fails to teach limitation 17[h]. Specifically, Richardson does not teach “the rigid frame extending to a ridge that is adapted to clasp within the channel of the bottom member and seal against the gasket.” Petitioner removes the context from Richardson’s description of a “snap fit” between the front shell and back shell. Richardson describes that the use of “precisely manufactured male and female snaps” with the addition of ridges that fit tightly within a groove” creates the “snap fit” relied upon by Petitioner. The Petition contends this “snap fit” meets limitation 17[h]. Petitioner is incorrect. A POSITA would understand the “snap fit” as created by the explicitly described *external snaps*, with alignment provided by the ridges and groove. EX2002, ¶119; *see also* EX2002, ¶87 (discussing Richardson). Richardson’s reference to “ridges ... [that] fit tightly within a groove” (EX1005, ¶[0047]; Pet. at 53) suffers from the same deficiencies as the form-fitting form-locking connections of Kuhn (i.e. there is no clasping structure). Nor would a POSITA be motivated to add a clasp *within the channel* as required, because Richardson already discloses the external “precisely manufactured male

and female snaps.” EX2002, ¶119; *see also* EX2002, ¶87 (discussing Richardson). In short, there is no teaching, literally or inherently, that Richardson’s “ridge” is adapted to clasp within the channel, as required by limitation 17[h].

Even to the extent Richardson’s “snap fit” describes a clasp, Richardson still fails to teach limitation 17[h]. Limitation 17[h] requires the clasping to occur “within the channel of the bottom member.” Richardson does not teach any engagement within a channel *of the bottom member*. Richardson teaches a groove in the top member, not the bottom member. EX1005, ¶[0047]; Pet. at 53. But Petitioner again fails to provide any motivation to combine the teachings of Richardson to Kuhn. Instead, Petitioner merely argues that a POSITA would have been aware of connection structures. Pet. at 54. This is an improper basis to combine prior art references.

Moreover, the structures of the claim are not interchangeable. The channel must be in the bottom member, not the top member. In IPR2020-00869, the Board explicitly rejected Petitioner’s attempt to place a “channel” in the “top member” when the claim required the “channel” be in the “bottom member” of a TreeFrog patent for related technology. *Fellowes, Inc. v. TreeFrog Developments, Inc.*, IPR2020-00869, Paper 16, at 4-5 (P.T.A.B. Oct. 29, 2020) (“On this record, we agree with Patent Owner that Petitioner seeks ‘to redraft the express limitations of’ Claim 28 (Prelim. Resp. 17) by redefining the ‘top member’ and ‘bottom member’

as interchangeable, even though the words of the claim define those members as having different orientations and distinctly different features. Ex. 1001, 116:18–44.”). Ground 4 fails to disclose the elements of Claim 17 as arranged and should be denied.

Kuhn in view of JP384 in view of Richardson fails to teach at least element 17[h]¹⁰ of Claims 17 of the ’950 Patent. Therefore, Kuhn in view of the JP384 in view of Richardson does not render Claim 17 obvious and *ipso facto* does not render Claims 19 and 21 obvious. The Board should decline to institute Ground 4.

6. Ground 5: Kuhn in view of the ’712 Patent in view of Richardson and FR857 fails to teach claims of the ’950 Patent.

Petitioner contends Claims 17, 19, and 21 of the ’950 Patent are obvious over Kuhn in view of the ’712 Patent in view of Richardson and FR857. Petitioner acknowledges Ground 5 is “the same as Ground 2” except that FR857 has been added to cure Kuhn’s deficiency with respect to 17[h] (“rigid frame extending to a ridge that is adapted to clasp within the channel.”) Pet. at 61.

No motivation to combine FR857 reference

FR857 discloses a box with a snap-on lid, in particular for electrical equipment. EX1008, Title. Petitioner argues that “FR857 is in the same field of the

¹⁰ Petitioner makes no argument that JP384 teaches element 17[g]. Pet. at 60-61.

art as the '950 Patent because it is a housing for an electronic object.” Pet. at 61. Petitioner is wrong. FR857 is not reasonably pertinent to the problem of the '950 Patent. FR857 is not analogous art. EX2002, ¶126.

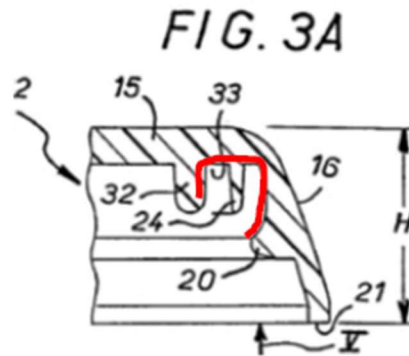
The '950 Patent is directed to a waterproof protective case that enables operation of the touch screen display and switch mechanism. EX1001, Abstract, 2:14-18. At best, Petitioner’s motivation to use Kuhn, the '712 Patent, and Richardson in combinations is based on these references being directed to protective encasements that enable operation of the device while in the encasement. Not so with FR857. Because FR857 teaches an enclosed box, operation of the device while in the box is not possible.

Petitioner’s alleged motivation to combine any of the references with FR857 is even more attenuated. *Johns Manville Corp.*, IPR2018-00827, Paper 9, at 10-11. “Demonstrating that a reference is analogous art or relevant to the field of endeavor of the challenged patent is not sufficient to establish that one of ordinary skill would have had reason to combine its teachings with other prior art in the manner set forth in the claim.” *Id.* “Mere compatibility of the references is likewise not sufficient.” *Id.*; see also *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993 (Fed. Cir. 2017) (it is not enough to show that “a skilled artisan, once presented with the two references, would have understood that they could be combined”). Petitioner asserts that a POSITA would use the clasping mechanism of FR857 “because it effectively

secures and seals the members of a container together in a liquid tight manner.” Pet. at 63; *and id.* at 64 (“it is desirable to ... prevent the ingress of liquids”). While this may describe the putative teaching of the FR857, it informs nothing of a motivation to modify Kuhn in view of the ’712 Patent based upon same, particularly where Kuhn and the ’712 Patent already purport to teach waterproof enclosures. *See* EX1004, Title; EX1006, Title. Petitioner’s remaining motivations to combine amount to no more than boilerplate assertions, and similarly fail to inform why a POSITA would have modified the waterproof enclosures of Kuhn or the ’712 Patent with any teachings from FR857. *See* Pet. at 61-66.

FR857 does not teach element 17[h]

Setting aside a failure of any motivation to combine, FR857 does not teach limitation 17[h]. EX2002, ¶129. Limitation 17[h] states: “the rigid frame extending to a ridge that is adapted to clasp *within the channel of the bottom member* and seal against the gasket.” (emphasis added). FR857 does not teach a “channel of the bottom member.” FR857 is clear. The channel (i.e. groove) is in the top, not bottom, member. EX2002, ¶130. Petitioner cites Figure 3A and annotates the channel in the top member.



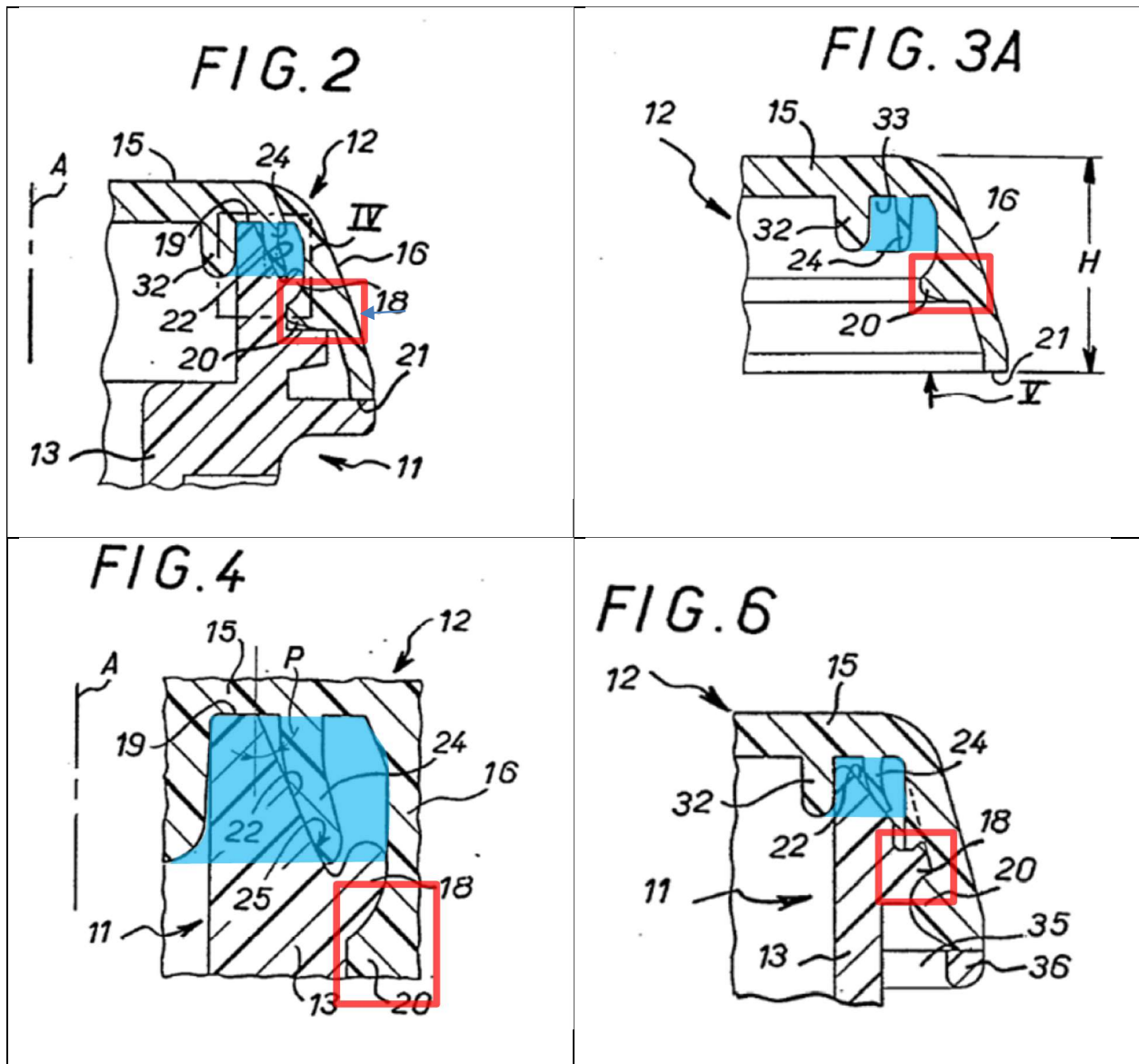
Pet. at 62 (annotation in the petition). Figure 3A portrays a cross-sectional view of the lid (i.e. top member) of the box. EX1008, 4:13. Petitioner further cites Figures 2 and 6, which show the same structure as Figure 3A. Pet. at 62-63. The groove or channel is on the top member. Petitioner’s own description of FR857 shows that FR857 does not teach element 17[h]. Petitioner states:

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.

Pet. at 62 (emphasis added). Petitioner identifies the channel on “one member”, not the “bottom member” as required by 17[h]. Petitioner cannot state that the channel is on the bottom member because it is indeed on the top cover of the box (i.e. the top member). In IPR2020-00869, the Board explicitly rejected Petitioner’s attempt to place a “channel” in the “top member” when the claim required the “channel” be in the “bottom member” of a TreeFrog patent for related technology. *Fellowes, Inc. v. TreeFrog Developments, Inc.*, IPR2020-00869, Paper

16, at 4-5 (P.T.A.B. Oct. 29, 2020) (“On this record, we agree with Patent Owner that Petitioner seeks ‘to redraft the express limitations of’ Claim 28 (Prelim. Resp. 17) by redefining the ‘top member’ and ‘bottom member’ as interchangeable, even though the words of the claim define those members as having different orientations and distinctly different features. Ex. 1001, 116:18–44.”). This is improper.

Moreover, FR857 suffers from the same deficiencies as Kuhn and Richardson—there is no clasping structure in the channel or on the ridge *within* the channel, as required by limitation 17[h]. *See* EX1008, Figs. 2 and 6. Petitioner’s annotation of Fig. 3A extends the boundary of the channel to arbitrarily include the purported clasp. Pet. at 62. But the purported “snap fastening” is made as a result of structures (red annotation, below) located *outside* the channel (blue annotation, below). EX2002, ¶129; EX1008, Figs. 2, 3A, 4, and 6 (annotated below), 5:22-6:3, 6:8-9, 9:14-15.



Kuhn in view of the '712 Patent in view of Richardson and FR857 fails to teach at least element 17[h] of the '950 Patent. EX2002, ¶129-130 and 131.

Therefore, Kuhn in view of the '712 Patent in view of Richardson and FR857 does not render Claim 17 obvious and *ipso facto* does not render Claims 19 and 21 obvious. The Board should decline to institute Ground 5.

7. Ground 6: Kuhn in view of JP384 in view of Richardson and FR857 fails to teach claims of the '950 Patent.

Petitioner contends Claims 17, 19, and 21 of the '950 Patent are obvious over Kuhn in view of JP384 in view of Richardson and FR857. Petitioner admits that Ground 6 is the “same as Ground 5” except that the Kuhn, Richardson, and FR857 references are combined with JP384 instead of the '712 Patent. Pet. at 66. Petitioner also concedes that Ground 6 is based off the same arguments as Grounds 3 and 4. *Id.* The same failures of motivation to combine and deficient teachings of Kuhn, Richardson, and FR857 apply as in Ground 5.

Ground 6 is flawed for the same reasons that Grounds 3, 4, and 5 fail. Notably, Kuhn does not teach elements 17[a], 17[b], 17[g], and 17[h]. *See* Ground 1. Kuhn's combination with JP384 does not cure these deficiencies. *See* Ground 3. Kuhn's further combination with Richardson does not teach at least 17[g] and 17[h]. *See* Grounds 4 and 5. A further combination with FR857 leaves at least limitation 17[h] deficient, as discussed in detail in Ground 5. *And see supra*, at 60; *id.* at Figs. 2, 3A, 4, and 6 (annotated).

Furthermore, while a POSITA would be strained to come up with a motivation to combine any of Kuhn, JP384, or Richardson (*and see* Grounds 3 and 4), a POSITA would also not be motivated to combine any of those references with FR857 because FR857 is not analogous art (*See* Ground 5). EX2002, ¶136. And critically, Petitioner makes no attempt to present a motivation to combine Kuhn,

JP384, Richardson, and FR857, and only references its previous contentions for motivations to combine (1) “JP384 to Kuhn and Richardson”, and (2) “FR857 to Kuhn and Richardson.” This is insufficient to explain why a POSITA would be motivated to further add FR857 to Ground 3 and 4’s use of JP384, Kuhn, and Richardson or to add JP384 to Ground 5’s combination of Kuhn, FR857, and Richardson. *See In re NuVasive, Inc.*, 842 F.3d 1376, 1381-82 (Fed. Cir. 2016) (“The factual inquiry whether to combine references must be thorough and searching...”).

Furthermore, the combination of Ground 6 fails to teach Claim 17. *See* Section IX(6). As detailed above, Kuhn in view of JP384 in view of Richardson and FR857 fails to teach at least element 17[h] of Claim 17 of the ’950 Patent. *See supra*, at 60; EX2002, ¶¶139-140 and 141. Therefore, Kuhn in view of the JP384 in view of Richardson and FR857 does not render Claim 17 obvious and *ipso facto* does not render Claims 19 and 21 obvious. The Board should decline to institute Ground 6.

X. THE BOARD SHOULD EXERCISE ITS DISCRETION AND DENY INSTITUTION TO CONSERVE THE FINITE RESOURCES OF THE BOARD.

Fellowes duplicative challenge to Claims 17, 19, and 21 of the ’950 Patent over six grounds should be denied under the discretion of the Board to preserve the finite resources of the Board. *See Gen. Plastic*, IPR2016-01357, Paper 19, at 9.

In *SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348 (2018), the Supreme Court held that a Board decision on institution of an *inter partes* review petition must institute on all challenged claims or deny on all challenged claims. The USPTO and Federal Circuit both interpreted *SAS* to further require that all grounds be either instituted or denied. See Guidance on the impact of SAS on AIA trial proceedings (April 26, 2018); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018). Applying these standards, the Board has exercised its discretion to deny institution where petitioner has failed to establish a reasonable likelihood of success on all of the challenged claims and defenses. *Deeper, UAB v. Vexilar, Inc.*, Case IPR2018-01310, Paper 7 (Jan. 24, 2019) (informative) (discretionary non-institution due to insufficient number of proposed grounds/challenges to claims that met reasonable likelihood standard); *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 (P.T.A.B. March 6, 2019) (informative); *Biofrontera Inc. v. DUSA Pharms., Inc.*, IPR2018-01585, Paper 10 (P.T.A.B. Feb. 26, 2019) (discretionary non-institution where petitioner established a reasonable likelihood of success on only 1 of 8 grounds); *Chevron Oronite Co. LLC v. Infineum USA L.P.*, Case IPR2018-00923, Paper 9 (Nov. 7, 2018) (discretionary non-institution due to insufficient number of proposed grounds/challenges to claims that met reasonable likelihood standard).

Here, Fellowes has asserted six grounds against the claims of the '950

Patent. Specifically, Fellowes has challenged the validity of Claims 17, 19, and 21 in each of the grounds. As detailed above, Fellowes has failed to prove a likelihood of success that the references teach the claim limitations or that the references would be modified and combined so as to teach the claim limitations. Under controlling precedent and trial practice, if the Board institutes on less than all of the challenged grounds and claims, the Board must still analyze each through trial and the Final Written Decision. Instituting Fellowes' petition where it has failed to prove a likelihood of success on a substantial portion of its challenged claims and defenses warrants the Boards' discretionary denial of the petition to preserve the Board's finite resources. *See, e.g., Deeper, UAB*, IPR2018-01310, Paper 7.

XI. CONCLUSION

For at least the foregoing reasons, the Petition for *inter partes* review should be denied. Petitioner has had an adjudication on the merits of the '950 Patent; it is not entitled to a second bite at the apple. Even excising extensions attributable to COVID-19 and the global health and economic impacts thereof, Petitioner delayed bringing this Petition allowing substantial expenditures in the co-pending district court litigation. The Petitioner fails to establish that the references teach all the elements of the claims or would have been modified or combined to teach all the elements of the claims. The Board should deny institution on the merits or according to its discretion.

Date: December 30, 2020

Respectfully submitted,

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CERTIFICATION OF COMPLIANCE WITH 37 CFR § 42.24(b)

Patent Owner certifies that Patent Owner's Preliminary Response contains 13,609 words exclusive of a table of contents, a table of authorities, mandatory notices under § 42.8, a certificate of service or word count, or appendix of exhibits or claim listing, according to Microsoft Word.

Date: December 30, 2020

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing Patent Owner's Preliminary Response To Petition for *Inter Partes Review* for U.S. Patent No. 8,564,950 under 37 C.F.R. § 42.107 and accompanying exhibits were served electronically via e-mail on December 30, 2020, upon the following parties via e-mail at the below email address:

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EXHIBIT LIST

Exhibit	Description	Filed
Ex. 2001	Declaration of James W. Beard in Support of Patent Owner's Motion for Admission <i>Pro Hac Vice</i>	☒
Ex. 2002	Declaration of T. Kim Parnell in Support of Patent Owner's Preliminary Response for <i>Inter Partes</i> Review of U.S. Patent No. 8,564,950	☒