

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

OTTER PRODUCTS, LLC AND	)	
TREEFROG DEVELOPMENTS, INC.,	)	
	)	CASE NO.: 1:19-cv-06195
Plaintiffs,	)	
	)	
v.	)	JUDGE ROWLAND
	)	
FELLOWES, INC.,	)	MAGISTRATE JUDGE HARJANI
	)	
Defendant.	)	

**DEFENDANT’S FINAL UNENFORCEABILITY AND INVALIDITY
CONTENTIONS PURSUANT TO LPR 3.1(b)**

Pursuant to the General Order Extending Deadlines (Dkt. 66) and the Revised Scheduling Order entered in this case on June 23, 2020 (Dkt. 70), Defendant Fellowes, Inc. (“Fellowes”) hereby submits its Final Unenforceability and Invalidity Contentions regarding the claims asserted by Plaintiffs Otter Products, LLC (“OtterBox”) and TreeFrog Developments, Inc. (“TreeFrog,” and collectively with OtterBox, “Plaintiffs”), as to U.S. Patent Nos. 8,342,325 (the “’325 Patent”); 8,393,466 (the “’466 Patent”); 8,526,180 (the “’180 Patent”); 8,531,834 (the “’834 Patent”); 8,564,950 (the “’950 Patent”); 9,549,598 (the “’598 Patent”); 9,660,684 (the “’684 Patent”); and 9,498,033 (the “’033 Patent,” and collectively, “OBX Asserted Patents” or “patents-in-suit”).

Fellowes has prepared these contentions based on discovery produced to date by Plaintiffs and publicly available information it has had to obtain independently. For example, at the outset of this case, Plaintiffs produced thousands of pages of patent prosecution files and yet the Plaintiffs were unable to authenticate them, much less recognize them. Fellowes requested the internal patent prosecution files of the asserted patents and Plaintiffs were unable to

and does not constitute a waiver of any such privilege or immunity. The information set forth in these contentions is provided without waiving: (1) the right to object to the use of any statement for any purpose, in this action or any other, on the grounds of privilege, relevance, materiality, or any other appropriate grounds; (2) the right to object to any request involving or relating to the subject matter of the statements herein; or (3) the right to revise, correct, supplement, or clarify any of the statements provided below at any time.

These contentions should not be taken as an indication of Fellowes' position with regard to the proper construction or interpretation of any claim term. Rather, Fellowes has made reasonable assumptions, to the extent necessary and appropriate, as to the meaning of claim terms for the purpose of these contentions only and has used those meanings to prepare these contentions. Additionally, Fellowes' Invalidity Contentions (including the charts attached hereto and which are incorporated herein) take into account alternative and potentially inconsistent positions as to claim construction and scope. By including prior art that would anticipate or render obvious claims based on Plaintiffs' application of the claims or any other particular claim construction, Fellowes is not adopting Plaintiffs' application nor admitting the accuracy of any particular application. Fellowes reserves all rights to amend these invalidity contentions if Plaintiffs amend their infringement contentions.

In the claim charts in the attached Exhibits, a citation to description in a patent/application specification or a publication that references a drawing or an element numbered in the drawing should be understood as including that drawing as well; and conversely a citation to a drawing or an element in the drawing should be understood as including any description that references that drawing or element.

I. FINAL INVALIDITY CONTENTIONS

A. General State of the Art

1. Electronic Devices

In the 2000's, cell phones, smartphones, and portable electronics became mainstream for the first time and numerous companies began development of smartphone accessories, including protective enclosures, to accommodate widespread use of these devices. The features and configurations of the accessories were, and continue to be, dictated by the features of the electronic device to be housed within the protective enclosure. More specifically, a person of ordinary skill in the art would understand that it is advantageous to the smartphone user to be able to use the smartphone while it is housed within a protective enclosure, thereby minimizing any potential damage to the phone. Therefore, it is helpful to look at the state of the art regarding mobile computing devices or other electronic devices prior to the earliest claimed priority date of the Patents-in-Suit. The features of encasements are dictated by the features on electronic devices in the marketplace and provide a reason common to some or all of the obviousness grounds identified below.

Smartphones and portable electronic devices in the mid-to-late-2000's came in many forms and designs but shared various common features. Namely, many smartphones and portable electronics included touch screen capabilities, buttons (e.g., for volume control) on the side of the device, and/or an electrical connection port on the device (e.g., for charging the device). The following is a non-exhaustive list of popular smartphones from the mid-to-late-2000's, prior to the earliest claimed priority date of the Patents-in-Suit.

The LG Prada was released in May 2007 and included a touch screen, buttons on the side of the device, and a charging port.



The first iPhone was released in June 2007 and included a touch screen, volume buttons on the side of the device, and a charging port. Notably, TreeFrog's first provisional application for the family including the '325 Patent labels the phone therein as the iPhone 3, iPhone 3G, iPhone 4 and iPhone 4G. *See, e.g.,* OTTER007737-746, OTTER007771, OTTER007776.



The LG Voyager was released in November 2007 and included a touch screen, volume buttons on the side of the device, and a charging port.



2. Protective Enclosures and Containers

Developments in portable electronics, and particularly smartphones, resulted in the need for rugged supplemental cases to protect the device from hazards, including impact (drops) and the environment (water/dust), for example. The need for rugged protective enclosures that would protect an electronic device from hazards would lead a person of ordinary skill in the art to examine other protective enclosures for electronic devices and protective encasements in general.

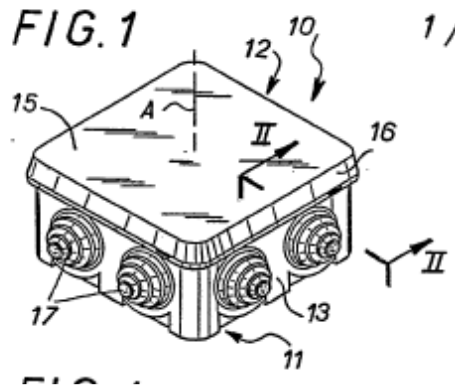
Each patent-in-suit recites known elements, combined in their known and expected manner, to achieve their known and expected results. Waterproof enclosures for electronic devices, including mobile phones and cameras, were well known in the art long before the earliest effective date of each patent. For example, numerous prior art references teach the use of two members (e.g., a “top member” and a “bottom member” or a “first shell member” and a “second shell member”) to encase an electronic, or non-electronic, device, as set forth in the

claim charts in the accompanying Exhibits. *See e.g.*, EP251¹ ¶¶ [0001], [0013], *passim*, FIGS. 3, 6, 7, 9-14; JP116 ¶¶ [0004], [0008], [0022], Fig 4; Richardson '707 at Figs. 1-7, 10-18, ¶¶ [0045], [0085], [0095], [0096], [0101], [0105]; Richardson '493 at FIGS. 2, 3, 6, 13A, 14, 17, 18, ¶¶ [0087]-[0096], [0105]-[0107]; JP796 ¶¶ [0010]-[0015], Figs. 3 and 4; Motion Computing case; H2O Audio Waterproof Housing; '712 Patent at 3:42-54, 3:63-66, FIGS. 2A and 10; the Ikelite housing; and JP384 (described in further detail below).

Numerous prior art documents also disclose openable enclosures having “latching mechanisms” (also called “clasping mechanisms” or other names in different patents) by which respective members of a waterproof enclosure are secured together, and likewise separated. Nearly all of the encasements identified above have some form of latching mechanism, as cited in the claim charts in the accompanying Exhibits. Further, EP251 discloses using internal or external latching mechanisms, either together or individually, thus showing either type may be used. And EP251 teaches the use of a gasket in a channel to provide sealing. Latching mechanisms, including ones internal to a channel where a gasket or other type of seal is present, are commonly used in containers for electrical equipment and other types of containers in general (e.g., buckets). Containers for electrical equipment or any other object are relevant art a person of ordinary skill in the art would consider as in the same or an analogous field. *See, e.g.*, '325 Patent at 1:27-28, 2:23-38-59 (and same language in related '180, '598, '950 and '466 Patents), '684 Patent at 22:50-58 (and same language in related '834 Patent).

¹ These are shorthand references for the prior art identified in the list *infra* at Section I.B.

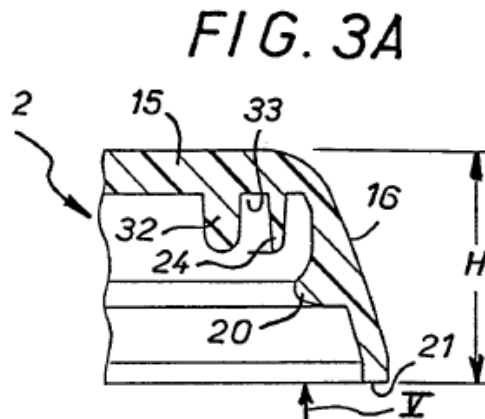
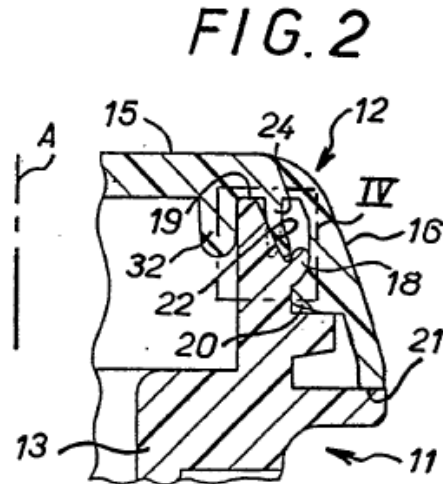
For example, French Patent Application FR2705857 (“FR857”) is titled “Box with a snap-on lid, in particular for electrical equipment.” FR857 teaches latching mechanisms for fastening two protective encasement members, or housing members, together.



FR857 discloses lip 18 protruding from the side wall 13 of box 11, on the outside surface thereof, for cooperating with a groove (identified by element 20) in the side wall of a channel in the lid 12. FR857 at Abstract. More specifically, FR857 discloses a channel formed between strip 32 and turned-out edge 16 (and containing element 24) in a top surface of the perimeter portion of the one member to receive a ridge of the rigid frame, having element 18, of the other member. FR857 at FIGS. 2-4, 6, 8:19-24, 10:4-5.

FR857 discloses clasp mechanisms on each of the top and bottom members that extend along respective perimeter portions of its respective top and bottom members. FR857 at 1:11-13, 2:3-6, 3:7-13, 5:22-6:3, 9:15-16. FR857 discloses the clasp mechanism of one member having a groove in a side of the channel that receives element 18 (see Figs. 3A, 6), and the clasp mechanism of the other member having lip 18 extending from the ridge of the rigid frame thereof. The lip engages the groove when the top member and bottom member are coupled together, as shown in those Figures. FR857 at FIGS. 2, 4, 6, 1:11-13, 2:3-6, 3:7-13,

5:22-24, 6:4-9, 9:15-16. Fig. 6 specifically shows a narrow slot that receives 18, which is a groove in the side of the channel.



Buckets, and containers in general, are part of the relevant art a person of ordinary skill in the art would consider because they are extremely well-known devices for containing and protecting materials inside, including from water or ingress of other particles. Buckets are well-known storage items that benefit from sealing, and a person seeking to enclose a phone or other electronic device between two container parts in a securely sealed manner would be familiar with buckets having latching mechanisms. It is also notoriously well-known to use a seal or gasket in a waterproof enclosure, and many bucket and general enclosure prior art references teach as

such. The '088, '419, '447 and '833 Patents² are all examples of such latching or clasping mechanisms, as identified in the claim charts in the Exhibits.

The latching mechanisms in the prior art for containers would be considered by a person of ordinary skill in the art because they effectively secure and seal the members of a container together in a liquid tight manner. Moreover, the features in the container latches are integrally formed with their respective housing members (e.g., a lid and bucket) that correspond to the housing members in the aforementioned electronic device enclosures, and would be recognized as likewise being readily integrally formed into plastic housing members of the electronic device enclosures. That is to say, including these elements into a device enclosure or encasement is an obvious design choice and well within the skill level of a person of ordinary skill in the art, as had been shown by their use in buckets and other types of containers in general.

The other features of many of the asserted patents, such as button features, feature for controlling switches, the alleged ability to operate a touch screen display or the like, and sealing of ports/apertures, are all obvious features that are not inventive, are dictated by the features of the electronic device themselves, and are known structures used in the expected, predictable manner.

Similarly, the use of features to enhance cushioning or protection of an encased device or enhance waterproofing use well-known, commonplace features in accordance with their known, predictable functions. Providing gaskets, seals, or other features to prevent the entry of water or dust into an enclosure for an electronic device or other object has been around for years before the asserted patents were filed, and is known technology the use of which is obvious, predictable,

² These are shorthand references for the prior art identified in the list *infra* at Section I.B.

and simply performs functions already well-known in the art. Similarly, providing cushioning to enhance protection of an enclosure of an electronic device or other object is similarly well-known, the use of which is obvious, predictable, and simply performs functions already well-known in the art.

B. Prior Art

Pursuant to LPR 3.1(b) and 2.3(b)(1), Fellowes identifies the references listed below as the prior art that anticipate and/or renders obvious each of the Asserted Claims.

PRIOR ART LIST

<u>Bates Number</u>	<u>Prior Art</u>	<u>Shorthand Reference</u>
F00001586; F0001684 – 1689	H2O Audio Waterproof Case for iPod Nano Physical Sample, offered for sale and publicly used and known as early as May 4, 2006³ Date Offered for Sale: at least as early as May 4, 2006 Entity Selling: X-1 Powered by H2O Audio Entity or Person Receiving Offer: The H2O case was sold to the general public. Date Publicly Used and Known: at least as early as May 4, 2006 Entity Which Made the Reference Known: iLounge³ (now operated by Netly PTY Ltd.) To Whom Reference was Made Known: the online review of the H2O case was directed to the general public.	H2O Case

³ An online review, dated May 4, 2006, of the H2O Audio Waterproof Housing can be found at F0001684 and: <https://www.ilounge.com/index.php/reviews/entry/h2o-audio-waterproof-housing-for-ipod-nano>.

F00001593 – F00001608 F00028799-28825	Ikelite Instruction Manual for Model 6140.54 dated Jan. 7, 2006 (published by Ikelite). The Ikelite Instruction Manual for Models 6148.10 dated Jan. 11, 2008, the Ikelite Instruction Manual for Models 6182.50 dated Feb. 6, 2007, and an Ikelite Physical Sample (Item No. 13546) are also referred to as including the same features and additional proof of their presence in the prior art.	Ikelite
F00001683; 27406 – 27411	Motion LE-Series Protective Case Physical Sample Date: The website image for purchasing the Motion Case at F00027406-409 was captured on November 15, 2006, and thus it was on sale at least as of that date. Entity Selling: Motion Computing, Inc. <i>Id.</i> Entity or Person Receiving Offer: The website image for purchasing the Motion case was available on the internet to the general public. <i>Id.</i> F00027406-409 (See “Add to Cart” link and stated price of \$349.99).	Motion Case
F00003055 – 3069	Japanese Patent Publication 11192116A and Certified English Translation (Nishiyama), “Cover for Portable equipment,” published Jul. 21, 1999	JP116
F00003076 – 3107	U.S. Patent Publication 2005/0030707A1 (Richardson), “Protective Enclosure for an Interactive Flat-Panel Controlled Device,” published Feb. 10, 2005	Richardson '707
F00003108 – 3114	U.S. Patent No. 6,980,777 B2 (Shepherd), “Smart Pouch Cover for Mobile Device,” issued Dec. 27, 2005	The '777 Patent
F00003115 – 3130	EP 1,301,011 A2 (Pirila), “User Changeable Electronic Device/Mobile Phone Covers and Method,” published April 9, 2003	Pirila

F00003131 – 3143	WO1981000654A1 (Krumin), “Housing for Electronic Apparatus with Elastomer Outer Layer,” published Mar. 5, 1981	Krumin
F00004694 – 4744	European Patent Publication 1583251A1 and Certified English Translation (Kuhn), “Waterproof housing, in particular underwater housing, for a mobile phone equipped with a camera,” published Oct. 5, 2005	EP251
F00004745 – 4787	U.S. Patent Publication 2006/0274493 A1 (Richardson), “Protective Enclosure for Electronic Device,” published Dec. 7, 2006	Richardson ’493
F00004788 – 4828	Japanese Patent Publication 2006/064796A and Certified English Translation (Takashi), “Waterproof Case for Camera,” published Mar. 9, 2006	JP796
F00004829 – 4838	U.S. Patent No. 7,963,419 B2 (Burney), “Lid and Container,” issued Jun. 21, 2011	The ’419 Patent
F00004839 – 4845	U.S. Patent No. 4,457,447 (Kirkis), “Plastic Pail and Lid, issued Jul. 3, 1984	The ’447 Patent
F00004846 – 4851	U.S. Patent No. 4,418,833 (Landis), “Large Volume Container with Gasketless Seal,” issued Dec. 6, 1983	The ’833 Patent
F00004943 – 4966	U.S. Patent Publication 2008/0316687A1 (Richardson), “Protective Enclosure for an Electronic Device,” published December 25, 2008	Richardson ’687
F00027260 – 27278	U.S. Patent No. 7,090,088 B2 (Holdt), “Plastic Container and Lid Construction,” issued Aug. 15, 2006	The ’088 Patent

F00027279 – 27285	U.S. Patent Publication 2007/0158220 A1 (Cleereman), “Impact-resistant case with Sealable Opening,” published Jul. 12, 2007	The ’220 Publication
F00027286 – 27300	U.S. Patent No. 7,050,712 (Shimamura), “Waterproof Case for Portable Device,” issued May 23, 2006	The ’712 Patent
F00027301 – 27315	U.S. Patent No. 7,495,895 B2 (Carnevali), “Protective Cover for Device Having a Touch Screen,” issued Feb. 24, 2009	The ’895 Patent
F00027316 – 27325	U.S. Patent No. 5,812,188A (Adair), “Sterile encapsulated Endoscopic Video Monitor,” issued Sep. 22, 1998	The ’188 Patent
F00027326-27366	U.S. Patent Publication 2006/0169689 A1 (Carnevali), “Sealed Window for Dry Box,” published Aug. 3, 2006	Carnevali
F00027367 – 27383	Japanese Patent Publication 2002/082384A and Certified English Translation (Fukumoto), “Waterproof Case for Electronic Apparatus,” published Mar. 22, 2002	JP384
F00027384-27387	U.S. Patent Publication 2011/0228192 A1 (Hollaway), “Waterproof Touch Screen Panel with Protective Film,” published Sep. 22, 2011	The ’192 Publication
F00027412-27424	U.S. Patent No. 5,583,742 (Noda), “Computer with Protective Cover Having Outwardly Projecting Cushioning Portions,” issued Dec. 10, 1996	The ’742 Patent/Noda
F00028764-28798	French Patent Publication 2705857 (Jean-Paul), “Box with a Snap-on Lid, in Particular for Electrical Equipment,” published Dec. 2, 1994	FR857

C. Detailed Statement of Invalidity for Each Asserted Patent

Pursuant to LPR 3.1(b) and 2.3(b)(2), Fellowes provides detailed statements of the prior art that invalidate each of the Asserted Claims.

1. U.S. Patent No. 8,342,325

Plaintiffs only assert infringement of claims 1 and 2 of U.S. Patent No. 8,342,325.

Fellowes' invalidity contentions for those claims are identified below.

1. Claims 1 and 2 are obvious over EP251 in view of FR857.
2. Claims 1 and 2 are obvious over EP251 in view of Richardson '493 and FR857.
3. Claims 1 and 2 are obvious over JP796 in view of Richardson '687, in further view of FR857, the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent.
4. Claims 1 and 2 are obvious over the Motion case in view of EP251 in further view of FR857, the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent.

See the claim charts in **Exhibit A** for the identification of each claim element in the cited prior art (some under Plaintiffs' perceived interpretation).

Reason to combine: It would be obvious to use the secondary references FR857, the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent in the combinations identified above to add a well-known clasp mechanism commonly used in buckets and other types of containers, including FR857 that is for electrical equipment, to each base reference. Specifically, a groove in the side of a channel on one member and a lip on the other member received in that groove is a familiar clasp mechanism used for sealing two-member protective housings. The prior art clasp mechanisms in the field of electronic devices (FR857) and for containers in general (the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent)

would be considered by a person of ordinary skill in the art because they effectively secure and seal the members of a container together in a liquid tight manner.

Such features would be obvious to use in a protective housing for an electronic device, such as those in the base references, because it is desirable to secure the housing members together in a manner to limit or prevent the ingress of liquids, which was already a well-known reason to do the same in prior containers. Including elements in the manner claimed is an obvious design choice and well within the skill level of a person of ordinary skill in the art, as had been shown by their use in containers for electronic devices and containers in general. They are well-established features known in the container art for many years and would have, at the very least, been obvious to try. Indeed, such clasping mechanisms are suggested by EP251's teaching of using "form-fitting" or locking connection and Richardson '687's teaching of using a "snap-fit" connection. A person of ordinary skill in the art would readily understand what a form-fitting or snap-fit connection is, as they are well known in the art, including as disclosed in FR857, the '419 Patent, '447 Patent, '833 Patent, and the '088 Patent.

The features in the container clasps of the secondary references are integrally formed with their respective housing members (e.g., a lid and container) that correspond to the housing members in the base references, and would be recognized as likewise being readily integrally formed into the plastic housing members of each base reference. The person of ordinary skill in the art would include the channel with a seal/gasket on one member and the part that enters the channel on the other member, selection of which is an obvious design choice given the limited (2) possibilities. Additionally, EP251 and JP796 each already include a compressible gasket within the channel in its bottom member and a ridge on the top member received therein, so adding the clasping mechanisms of the other references 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 would be beneficial to provide securement between the members, as was already known in the art.

Also, to the extent JP796 or EP251 as a base reference does not disclose an encasement with a membrane mated on a top ridge, Richardson '493 and the Motion case each teach an encasement that frames an electronic device touchscreen and has a membrane on a top ridge of the housing member for enabling operation of the same. It would be obvious to include such a feature in an enclosure with the features of JP796 or EP251 so it can be used with a device with a touchscreen. In particular, a person of ordinary skill in the art would have been well aware that such devices can include touchscreens, and that the specific enclosure configuration is generally dictated by the features of the electronic device, and therefore would dictate inclusion of the claimed features for operating the touchscreen.

Also, as to claim 2, the subject matter of claim 2 including an aperture in a top member side wall is well-known from EP251, JP796, Richardson '493, and the Motion case. The location of a specific aperture is dictated by the design of the electronic device itself, such as the location of a button, port, connector, or speaker. Providing an aperture at any given location involves no inventive activity, and the prior art in general and in the specific references teaches that it is obvious to a person of ordinary skill in the art to locate an aperture as dictated by the underlying device itself. When including a top wall with a portion that extends down into a channel, that will necessarily require a side wall to have an aperture to accommodate any such feature on the electronic device. Indeed, a person of ordinary skill in the art would be aware that jack ports, interfaces, control buttons, and the like are on typically on the side, top or bottom of

an electronic device, such that any aperture therefor will be through a housing or encasement side wall to the exterior for access.

Claim 1 is thus obvious over EP251 in view of FR857. EP251 teaches every limitation of claim 1 as set forth in the chart in Exhibit A. To the extent Plaintiffs contend it does not expressly teach the groove in the side of the channel and the lip received in that groove in claim element 1[k], that type of connection is extremely well-known, as shown for example in FR857 in the same field. A person of ordinary skill in the art would have good reason to use such well-known connections in EP251's channel to provide a secure and efficient means for sealing, and indeed it is suggested by EP251's own teaching of using a "form fitting" or locking connection. Moreover, FR857 meets many of the other limitations as shown in the chart, showing its suitability and interchangeability with EP251 also meeting those limitations. The state of the art reinforces this, as the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent further show that the type of connection in FR857 (some under Plaintiffs' perceived interpretation) is well known and commonplace in containers in general. EP251 also includes the features of claim 2, and thus it is likewise obvious to include to provide access to a functional element through an opening.

Claims 1 and 2 are obvious over EP251 in view of Richardson '493 and FR857. The discussion for the EP251/FR857 combination applies equally here. To the extent Plaintiffs would contend any EP251 does not teach all the features of those claims for which it is cited, Richardson '493 does. For example, to the extent patentee alleges EP251 does not have a top ridge to which the membrane is mated, Richardson '493 teaches that, thus suggesting use of the same on EP251. Further, a person of ordinary skill in the art would readily understand what a snap-fit connection is, as they are well known in the art, including in FR857. The state of the art

reinforces this, as the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent (some under Plaintiff's perceived interpretation) further show that the type of connection in FR857 is well known and commonplace in containers in general. Both EP251 and Richardson '493 include the features of claim 2, and thus it is likewise obvious to include to provide access to a functional element through an opening.

Claim 1 is obvious over JP796, in view of Richardson '687, in further view of FR857, the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent. JP796 and Richardson '687 each have features of claim 1, and JP796 shows the use of a channel receiving a ridge, which channel has a gasket. Richardson '687 teaches the use of a snap-fit connection between a ridge and groove, suggesting use of the same on JP796 where the channel wall and received ridge interface or contact. A person of ordinary skill in the art would readily understand what a snap-fit connection is, as they are well known in the art, including in FR857, the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent, all of which meet claim element 1[k] (some under Plaintiff's perceived interpretation), as well as many other limitations as shown in the chart, showing their suitability and interchangeability in JP796's channel. Both JP796 and Richardson '687 include the features of claim 2, and thus it is likewise obvious to include to provide access to a functional element through an opening.

Claim 1 is obvious over the Motion case in view of EP251, in further view of FR857, the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent. The Motion case has most elements of claim 1, as shown in the chart, and EP251 shows the use of a channel receiving a ridge, which channel has a gasket, as well as other features overlapping with the Motion case showing interchangeability. A person of ordinary skill in the art would have good reason to use well known connections like those in FR857 (in the field of electronic devices), the '419 Patent,

the '447 Patent, the '833 Patent, and the '088 Patent (in the field of containers in general), all of which meet claim element 1[k] (some under Plaintiff's perceived interpretation), to provide a secure and efficient means for sealing, and indeed it is suggested by EP251's own teaching of using a "form fitting" or locking connection. Moreover, those additional references meet many of the other limitations as shown in the chart, showing their suitability and interchangeability with Motion and EP251 also meeting those limitations. The Motion case also includes the features of claim 2, and thus it is likewise obvious to include to provide access to a functional element through an opening.

Claims 1 and 2 recites obvious subject matter already well within the ordinary skill level in the art with elements performing in accordance with their functions known in the art and achieving predictable, expected results, and also would be obvious to try.

2. U.S. Patent No. 8,393,466

Plaintiffs only assert infringement of claims 2, 5, and 11 of U.S. Patent No. 8,393,466.

Fellowes' invalidity contentions for those claims are identified below.

1. Claim 2 is obvious over EP251 in view of US 2006/0169689 ("Carnevali").
2. Claim 2 is obvious over EP251 in view of Richardson '493.
3. Claim 2 is obvious over EP251 in view of the '188 Patent and the '192 Publication.
4. Claim 2 is obvious over the Motion case in view of EP251 in further view of the '188 Patent and the '192 Publication.
5. Claims 5 and 11 are obvious over EP251 in view of Carnevali, in further view of FR857.

6. Claims 5 and 11 are obvious over EP251 in view of Richardson '493, in further view of FR857, the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent.
7. Claims 5 and 11 are obvious over EP251 in view of the '188 Patent and the '192 Publication, in further view of FR857.
8. Claims 5 and 11 are obvious over the Motion case in view of EP251, in further view of '188 Patent and the '192 Publication, in further view of FR857, the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent.

See the claim charts in **Exhibit B** for the identification of each claim element in the cited prior art (some under Plaintiffs' perceived interpretation).

Reason to combine: EP251 discloses all elements of claims 1 and 7 (from which the asserted claims depend) as cited in the claim chart in Exhibit B, except for an express teaching of "a flexible portion overlaid on at least part of an exterior portion of the rigid frame and at least part of a perimeter portion of the membrane." A "flexible portion overlaid" on part of a frame and a perimeter portion of a membrane or window is simple common sense that has been done for years in other contexts, including window pane sealing/caulking, seals on vehicle windows, etc., which are everyday examples of flexible portions applied between frames and window members. *See, e.g.*, U.S. Patent No. 4,730,429 at element 36 in Figs. 2-5 and 2:46-51, 2:67-3:36, 5:20-39 (state of the art showing common knowledge of sealing). A person of ordinary skill in the art would already be familiar with such basic techniques and would consider their use when sealing the location where a membrane and frame part of the case interface. A person of ordinary skill in the art would readily understand that location to be a potential leak point to be addressed when designing a case for an electronic device, and know that basic steps to seal interfaces are already extremely well known. This feature is disclosed by Carnevali, Richardson

'493, the '188 Patent, and the '192 Publication, each of which teach that feature in protective enclosures for electronic devices.

More particularly, Carnevali, Richardson '493, the '188 Patent, and the '192 Publication each teach “a flexible portion overlaid on at least part of an exterior portion of the rigid frame and at least part of a perimeter portion of the membrane” and the application of that feature’s sealing/waterproofing benefit. A person of ordinary skill in the art would understand the interface between the membrane and the frame/top member is a potential leak point that would benefit from a flexible member to provide enhanced sealing. As noted above, this is nothing more than the same principle used in basic window caulking, seals on vehicle windows, etc., which are everyday examples of flexible portions applied between frames and perimeter portions of window members. Applying the approach as disclosed by Richardson '493, the '188 Patent, and the '192 Publication, and particularly the molding technique of Carnevali, is simple, commonplace technology that achieves nothing more than predictable results.

Moreover, to the extent that EP251 does not explicitly teach that the disclosed membrane is used for a touchscreen display, Carnevali, Richardson '493, the '188 Patent, and the '192 Publication each teach and disclose that it is well-known that such a membrane can be used for operation of a touchscreen display.

The subject matter of claims 1 and 7 is also obvious over the Motion case in view of EP251, in further view of the '188 Patent, and the '192 Publication. The Motion case has most elements of claim 1, as shown in the claim chart in Exhibit B. As discussed above, EP251 also teaches most elements of claims 1 and 7, and further teaches a channel receiving a ridge, the channel having clasp mechanisms, a gasket positioned within the channel, as well as other features overlapping with the Motion case. The significant overlap between the Motion case and

EP251 demonstrates the interchangeability of the two prior art protective enclosures. Further, as discussed above, a person of ordinary skill in the art would understand the interface between the membrane of the Motion case or EP251 and the frame/top member is a potential leak point that would benefit from a flexible member to provide enhanced sealing. Both the '188 Patent, and the '192 Publication teach this feature, and would be obvious to combine with the Motion case and EP251 to prevent the ingress of water to the protective disclosure.

EP251 also discloses an aperture/bushing for a cable connection as cited in the claim chart in Exhibit B. It would be obvious to include that aperture in a side wall for making such cable connections as taught by EP251. Richardson '493 and the Motion case also disclose such apertures in a side wall of the rigid frame of the top member, making this an obvious feature to include by a person of ordinary skill in the art for use of controls or cable connections on an enclosed electronic device. Indeed, a person of ordinary skill in the art would be aware that jack ports, interfaces, control buttons, and the like are typically on the side, top or bottom of an electronic device, such that any aperture therefor will be through a housing or encasement side wall to the exterior for access.

As to the subject matter of claims 5 and 11, the clasping mechanism that includes a lip received in a groove is extremely well-known in the art. It would be obvious to use the secondary references FR857, the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent in the combinations identified above to add a well-known clasping mechanism commonly used in containers for electronic devices, buckets, and other types of containers. Specifically, a groove in the side of a channel on one member and a lip on the other member received in that groove is a familiar clasping mechanism used for sealing two-member protective housings. The prior art clasping mechanisms in the field of electronic devices (*e.g.*, FR857) and for containers

in general (*e.g.*, the '419 Patent, the '447 Patent, the '833 Patent, and the '088 Patent) (some under Plaintiff's perceived interpretation) would be considered by a person of ordinary skill in the art because they effectively secure and seal the members of a container together in a liquid tight manner. Such features would be obvious to use in a housing an electronic device, such as those disclosed by EP251 and the Motion case, because it is desirable to secure the housing members together in a manner to limit or prevent the ingress of liquids, which was already a well-known reason to do the same in prior containers. In doing so, including elements in the manner claimed is an obvious design choice and well within the skill level of a person of ordinary skill in the art, as had been shown by their use in other types of containers in general.

They are well-established features known in the relevant art for many years and would have, at the very least, been obvious to try. Indeed, such clasping mechanisms are suggested by EP251's teaching of using "form-fitting" or "form-locking" connection. Moreover, FR857 meets many of the other limitations of the asserted claims, as shown in the claim charts in Exhibit B, demonstrating its suitability and interchangeability with EP251. A person of ordinary skill in the art would readily understand what a form-fitting or locking connection is, as they are well known in the art, including as disclosed in FR857, the '419 Patent, '447 Patent, '833 Patent, and the '088 Patent.

Moreover, the clasping mechanisms of the secondary references and the state of the art are integrally formed with their respective housing members (*e.g.*, a lid and container) that correspond to the housing members in EP251 and the Motion case, and would be recognized as likewise being readily integrally formed into the plastic housing members of each reference. A person of ordinary skill in the art would also include the channel having the seal/gasket on one member and the part/bottom ridge that enters it on the other member, selection of which is an

obvious design choice given the limited (2) possibilities. Additionally, EP251 already includes a channel having a compressible gasket in its bottom member and a ridge on its top member received therein, so adding the clasping mechanisms of the other references would be obvious for the same reasons, and for the further reason that the ridge and channel are already present in EP251 and addition of clasping features would be beneficial to provide securement between the members as was already known in the art.

Claims 2, 5, and 11 recite obvious subject matter already well within the ordinary skill level in the art with elements performing in accordance with their functions known in the art and achieving predictable, expected results, and also would be obvious to try.

3. U.S. Patent No. 8,526,180

Plaintiffs only assert infringement of claim 26 of U.S. Patent No. 8,526,180. Fellowes' invalidity contentions for that claim are identified below.

1. Claim 26 is anticipated by the '220 Publication.
2. Claim 26 is obvious over Richardson '493 in view of the '220 Publication.
3. Claim 26 is obvious over EP251, in view of the '895 Patent, in further view of the '742 Patent and the '220 Publication.
4. Claim 26 is anticipated by the Motion case.

See the claim charts in **Exhibit C** for the identification of each claim element in the cited prior art (some under Plaintiffs' perceived interpretation).

Reason to combine: Claim 26 is anticipated by both the '220 Publication and the Motion case, as shown in the chart in Exhibit C. Claim 26 is also obvious over Richardson '493 in view of the '220 Publication. Richardson '493 teaches all limitations of claim 26, except the tether in

claim element 20[e]. The '220 Publication anticipates claim 26, but to the extent it does not, it remedies the deficiency of Richardson '493 by teaching a tether connecting a cover/gasket and bung of similar structure. A person of ordinary skill in the art would have good reason to connect the cover/gasket to the encasement, as it eliminates the risk of losing the cover/gasket with a bung, which would defeat the waterproof nature of the case disclosed by Richardson '493.

Likewise, to the extent any other feature of claim 26 is alleged to be missing from Richardson '493, the '220 Publication provides it, including each and every feature identified in the chart at Exhibit C. It would be obvious to include a tethered plug, as taught by the '220 Publication, to the features provided by Richardson '493, thereby meeting the various elements cited in that chart and providing a watertight seal to prevent damage to the encased device, which is connected by a tether and would not be lost by the user. That is an obvious variation already well within the ordinary skill level in the art and achieves predictable, expected results.

Claim 26 is further obvious over EP251 in view of the '895 Patent in further view of the '742 Patent and the '220 Publication. EP251 teaches all elements of claim 26, except the tether of claim element 20[e]. The '895 Patent teaches every element of claim 26 and makes up for any deficiency in EP251 by teaching a tether for connecting a cover/gasket and bung of similar structure. A person of ordinary skill in the art would have good reason to do this, as it eliminates the risk of losing the cover/gasket with a bung, which would defeat the waterproof nature of the case disclosed by EP251. Moreover, to the extent that EP251 is not considered to have any other feature of claim 26, the '895 Patent discloses it, including each and every feature identified in the chart at Exhibit C. It would be obvious to include those features to provide a tethered plug as taught by the '895 Patent that meets the various elements cited in that chart and provides a

watertight seal to prevent damage to the encased device, which is connected by a tether and would not be lost by the user.

Fellowes understands from Plaintiffs' response to its Initial Invalidity Contentions that Plaintiffs deny that the '895 Patent teaches the claimed "gasket" because the stem portion 140 allegedly does not seal. To the extent that interpretation is correct (which Fellowes does not concede), EP251 itself teaches that an inserted plug can seal an aperture, and the '220 Publication and the '742 Patent also teach examples of tethered plugs connected to an encasement which seal an aperture. It would be obvious to seal the aperture with the inserted portion to ensure water does not enter the aperture, and some form of frictional engagement is present on the '895 Patent's stem portion 140 to retain it in its aperture. Therefore, sizing a stem portion to provide sealing, which Plaintiffs allege is missing, is an obvious variation already well within the ordinary skill level in the art and achieves predictable, expected results.

Claim 26 recites obvious subject matter already well within the ordinary skill level in the art with elements performing in accordance with their functions known in the art and achieving predictable, expected results, and also would be obvious to try.

4. U.S. Patent No. 8,531,834

Plaintiffs only assert infringement of 28 of U.S. Patent No. 8,531,834. Fellowes' invalidity contentions for claim 28 are identified below.

1. Claim 28 is anticipated by EP251.
2. Claim 28 is obvious over EP251 in view of Richardson '687 in further view of FR857.

3. Claim 28 is obvious over JP796 in view of Richardson '687 in further view of the '088 Patent, the '419 Patent, the '447 Patent, and the '833 Patent.
4. Claim 28 is obvious over the Motion case in view of JP796 and EP251, in further view of FR857, the '088 Patent, the '419 Patent, the '447 Patent, and the '833 Patent.

See the claim chart in **Exhibit D** for the identification of each claim element in the cited prior art (some under Plaintiffs' perceived interpretation).

Reason to combine: It would be obvious to use the secondary references Richardson '687, FR857, the '088 Patent, the '419 Patent, the '447 Patent, and the '833 Patent in the combinations identified above to add a well-known latching mechanism commonly used in buckets and other types of containers to each base reference. The prior art latching mechanisms in the field of electronic devices (Richardson '687 and FR857) and for containers in general (e.g., buckets – the '088 Patent, the '419 Patent, the '447 Patent, and the '833 Patent) would be considered by a person of ordinary skill in the art because they effectively secure and seal the members of a container together in a liquid tight manner. Containers and buckets, and especially containers in the field of electronic devices, are part of the relevant art a person of ordinary skill in the art would consider because they are extremely well-known devices for containing and protecting materials inside, including from water or ingress of other particles. Buckets are well-known storage items that benefit from sealing, and a person seeking to enclose a phone or other electronic device between two container parts in a securely sealed manner would be familiar with buckets having sealing protrusion/channel features that latch as part of the relevant art.

Such features would be obvious to use in a protective housing for an electronic device, such as those in the base references, because it is desirable to secure the housing members together in a manner to limit or prevent the ingress of liquids, which was already a well-known

reason to do the same in prior containers. Including elements in the manner claimed is an obvious design choice and well within the skill level of a person of ordinary skill in the art, as had been shown by their use in containers for electronic devices and containers in general. They are well-established features known in the container art for many years and would have, at the very least, been obvious to try. Indeed, such latching mechanisms are suggested by EP251's teaching of using "form-fitting" or locking connection and Richardson '687's teaching of using a "snap-fit" connection. A person of ordinary skill in the art 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, the '419 Patent, '447 Patent, '833 Patent, and the '088 Patent.

Moreover, the features in the container and bucket latches of the secondary references are integrally formed with their respective housing members (e.g., a lid and container) that correspond to the housing members in the base references, and would be recognized as likewise being readily integrally formed into the plastic housing members of each base reference. A person of ordinary skill in the art would also include the channel with a seal on one member and the part that enters the channel on the other member, selection of which is an obvious design choice given the limited (2) possibilities. Additionally, EP251 and JP796 each already include a compressible seal within the channel in its bottom member and a ridge on the top member received therein, so adding the latching mechanisms of the other references would be obvious for the same reasons. Adding the latching mechanisms would be obvious for the further reason that the ridge and channel are already present, and addition of latching features to those structures would be beneficial to provide securement between the members, as was already known in the art.

As to the subject matter of the preamble, the preamble is not a limitation, and thus a device with a multi-touch display is an intended use and not a claim requirement. Even if it is a claim requirement, EP251 teaches it. EP251 also discloses PDAs with touchscreens in citing U.S. Patent Publication 2003/0095374 as prior art (which is owned by Otter, and discloses touch screen display at e.g., ¶¶ [0010] and [0014]), confirming that a multi-touch display is contemplated. Moreover, such direct reference to that prior art would lead a person of ordinary skill to it and make it obvious to consider and use.

It would be obvious to include a multi-touch operability feature in an enclosure with the features of JP796 or EP251 so those cases could be used with a device with a touchscreen. In particular, a person of ordinary skill in the art would have been well aware that mobile computing devices can include touchscreens, and, in fact, that devices having multi-touch displays were well known prior to the '834 Patent filing date. *See* General State of the Art section. EP251 expressly states that the covering film allows the user to use the display of the mobile phone, thereby rendering obvious the use of a mobile phone with a multi-touch display. *See also* U.S. Patent Publication 2003/0095374 (cited in EP251). Accordingly, to the extent a mobile phone with a multi-touch display were used with the waterproof cases disclosed in EP251, a person having ordinary skill in the art would have found it obvious to include the multi-touch display accessibility feature of Richardson '687, or simply form the transparent and/or elastic covering film to permit a user to use the multi-touch display.

Additionally, to the extent Plaintiffs allege JP796 does not disclose an encasement that enables operation of a multi-touch display, it discloses an electronic device with a screen, and EP251, Richardson '687, and the Motion case each teach an encasement that frames an electronic device touchscreen and enables operation of the same. It would be obvious to use

Richardson '687 as a secondary reference in the combinations identified above because it discloses a waterproof encasement for electronic devices having a camera and uses similar designs and similar materials to EP251 and JP796.

Claim 28 recites obvious subject matter already well within the ordinary skill level in the art with elements performing in accordance with their functions known in the art and achieving predictable, expected results, and also would be obvious to try.

Arguments presented in the *Inter Partes* Review IPR2020-00869 against claim 28, which is pending at the USPTO, are incorporated herein by reference. See Petition at 38-51, 68-75.

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

Plaintiffs only assert infringement of claim 19 of U.S. Patent No. 8,564,950. Fellowes invalidity contentions for that claim are identified below.

1. Claim 19 is obvious over EP251 in view of the '712 Patent.
2. Claim 19 is obvious over EP251 in view of Richardson '687 in further view of JP384.
3. Claim 19 is obvious over EP251 in view of Richardson '687 in further view of FR857, the '712 Patent, Ikelite, and JP384.
4. Claim 19 is obvious over the Motion case in view of the '419 Patent, the '447 Patent, the '833 Patent, the '088 Patent, and Ikelite.

See the claim charts in **Exhibit E** for the identification of each claim element in the cited prior art (some under Plaintiffs' perceived interpretation).

Reason to combine: As to the subject matter of the preamble, 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, EP251 teaches it. EP251 ¶ [0019] ("use" of the

display). EP251 also discloses PDAs with touchscreens in citing U.S. Patent Publication 2003/0095374 as prior art (which is owned by Otter, and discloses touch screen display at e.g., ¶¶ [0010] and [0014]), confirming that a touchscreen display is contemplated. In particular, a person of ordinary skill in the art would have been well aware that mobile electronic devices can include touchscreens, and, in fact, that devices having touch screen displays were well known prior to the '950 Patent filing date. *See* General State of the Art section. EP251 further expressly states that the covering film allows the user to use the display of the mobile phone, thereby disclosing or rendering obvious the use of a mobile phone with a touch screen display.

Richardson '687 discloses a protective apparatus that enables touch screen operation of a mobile computing device encased in the apparatus. The ability of the membrane to enable operation of the touch screen is discussed in Richardson '687 throughout. A person having ordinary skill in the art would have found it obvious to configure EP251, 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. Accordingly, to the extent a mobile phone with a touch screen display were used with the waterproof cases of EP251, a person having ordinary skill in the art would have found it obvious to include the touch screen display accessibility feature of Richardson '687, or simply form the transparent and/or elastic covering film to permit a user to use the multi-touch display. The '712 Patent also discloses its encased device may include a touch screen display, and its encasement may enable operation of that touch screen display. That also teaches that EP251's membrane could be used with or modified to be used with an encased device with a touch screen display.

Further, EP251 discloses all elements of claim 17 (from which the asserted claim depends) as cited in the claim chart in Exhibit E, except for an express teaching of "a switch

mechanism.” The ’712 Patent, Ikelite, and JP384 are each directed to a waterproof housing for an electronic device, such as a camera, the housing including a “switch feature” for operation of a control knob/button on the exterior surface of the electronic device. It would be obvious to use the switch features of the ’712 Patent, Ikelite or JP384 to control a switch on the encased device while maintaining the water-resistant integrity of the casing. The encasements of these references include an aperture through which a “switch actuator” of a “switch feature” protrudes, such that a switch of the encased mobile device may be actuated. This is a well-known technique used in the art known to a person of ordinary skill in the art in water-resistant cases for electronic devices. 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 these references of the ability to control that switch from the exterior as taught by those references without having to open a port, door or flap to access the switch and risk ingress of water or dust.

Likewise, the Motion case is also a protective apparatus that enables touch screen operation of a mobile computing device encased in the apparatus. The combination of the Motion case and Ikelite is similarly obvious because it would be obvious to use the switch feature of the Ikelite to control a switch on a device encased within the Motion case while maintaining the water-resistant integrity of the casing. As discussed above, the Ikelite includes an aperture through which a “switch actuator” of a “switch feature” protrudes, such that a switch of the encased mobile device may be actuated. This is a well-known technique used in the art known to a person of ordinary skill in the art in water-resistant cases for electronic devices.

It would also be obvious to use FR857, the ’419 Patent, the ’447 Patent, the ’833 Patent, the ’088 Patent in the combinations identified above to add a well-known clasp mechanism commonly used in buckets and other types of containers to each base reference. Specifically,

each reference discloses a clasping mechanism within the channel on one member (e.g., a groove in the side of a channel) and a clasping mechanism adapted to clasp within the channel on the other (e.g. a lip received in that groove) is a familiar clasping mechanism used for sealing two-member protective housings.

The prior art clasping mechanisms in the field of electronic devices (FR857) and for containers in general (the '419 Patent, the '447 Patent, the '833 Patent, the '088 Patent) would be considered by a person of ordinary skill in the art because they effectively secure and seal the members of a container together in a liquid tight manner. Containers and buckets, and especially containers in the field of electronic devices, are part of the relevant art a person of ordinary skill in the art would consider because they are extremely well-known devices for containing and protecting materials inside, including from water or ingress of other particles. Buckets are well-known storage items that benefit from sealing, and a person seeking to enclose a phone or other electronic device between two container parts in a securely sealed manner would be familiar with buckets having sealing protrusion/channel features that clasp as part of the relevant art.

Such features would be obvious to use in a protective housing for an electronic device, such as those in EP251 or the Motion case (to the extent they do not already disclose them), because it is desirable to secure the housing members together in a manner to limit or prevent the ingress of liquids, which was already a well-known reason to do the same in prior containers. Including elements in the manner claimed is an obvious design choice and well within the skill level of a person of ordinary skill in the art, as had been shown by their use in containers for electronic devices and containers in general. They are well-established features known in the container art for many years and would have, at the very least, been obvious to try. Indeed, such clasping mechanisms are suggested by EP251's teaching of using "form-fitting" or locking

connection and Richardson '687's teaching of using a "snap-fit" connection. A person of ordinary skill in the art 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, the '419 Patent, '447 Patent, '833 Patent, and the '088 Patent.

Moreover, the features in the container and bucket clasps of the secondary references are integrally formed with their respective housing members (e.g., a lid and container) that correspond to the housing members in the base references, and would be recognized as likewise being readily integrally formed into the plastic housing members of each base reference. A person of ordinary skill in the art would also include the channel with a seal on one member and the part that enters the channel on the other member, selection of which is an obvious design choice given the limited (2) possibilities. Additionally, EP251 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.

Claim 19 simply adds the feature of an "aperture" through which the "switch actuator protrudes." EP251 and the Motion case already have apertures. The '712 Patent, Ikelite and JP384 also have apertures for their respective "switch actuators." Therefore, it would be obvious to have those switch actuators protrude through an aperture in EP251 or the Motion case in order to operate the switch on the encased device. This is simple, predictable use of the structure and design already present in those references.

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

6. U.S. Patent No. 9,549,598

Plaintiffs only assert infringement of claim 19 of U.S. Patent No. 9,549,598. Fellowes' invalidity contentions for that claim are identified below.

1. Claim 19 is obvious over EP251 in view of Richardson '687.
2. Claim 19 is obvious over EP251 in view of Richardson '687, in further view of Noda and Krumin.
3. Claim 19 is obvious over EP251 in view of Richardson '687, in further view of Pirila.
4. Claim 19 is obvious over the Motion case in view of JP796, in further view of FR857, the '088 Patent, Pirila, the '419 Patent, the '447 Patent, and the '833 Patent.

See the claim charts in **Exhibit F** for the identification of each claim element in the cited prior art (some under Plaintiffs' perceived interpretation).

Reason to combine: EP251 teaches every element of claim 17, and thus anticipates it as shown in the chart at Exhibit F. To the extent any features of claim 17 are alleged to be missing from EP251, Richardson '687, disclosing a protective enclosure for a touch screen electronic device, teaches them also. For example, Richardson '687 teaches the claimed "lens" as shown in the chart at, e.g., camera lens cover 1318. It would be obvious to a person of ordinary skill in the art to design a camera lens in EP251's bottom/first member, as taught by EP251 itself, in view of Richardson '687 showing the inclusion of such a feature in order for an electronic device's camera to capture images. Richardson '687 also discloses claim element 17[g] reciting that

bounding members “mate.” Specifically, Richardson ’687 discloses the mating feature with reference to Figs. 12 and 13, that its front shell and back shell “latch together using precisely manufactured male and female snaps,” and that the shells may also 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.” A person of ordinary skill in the art would readily recognize that such a “snap fit” could be applied to EP251. In particular, a person of ordinary skill in the art would have good reason to use Richardson ’687’s snap-fit between the end/ridge of the “extended wall”/“first bounding member” on the top/first member and the inner surfaces of the channel 16 on the “wall”/“second bounding member” 19 on the bottom member to “mate” such walls/bounding members (to the extent that term were interpreted narrowly to have such requirements). That makes for a simple and efficient connection and is well-known in the art for coupling two housing members together. EP251 already has the claimed “bounding members” present, and the only modification would be the inclusion of snap-fit features on each to interface and connect the two members together (to the extent Kuhn does not already have those). A person of ordinary skill in the art 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 type of “form fitting” or locking connection referenced in EP251.

Further, Richardson ’687 teaches that the well-known features of claim 19 reciting the “button feature” with its related limitations. The inclusion of the “button feature” as recited in claim 19 and disclosed in Richardson ’687 is an obvious choice to a person of ordinary skill in the art for enabling the user to contact and actuate the control buttons on a device inside the housing through the wall thereof while maintaining the opening for the button sealed or closed,

and thus enabling the user to use the respective functional elements of the encased electronic device without having to remove the same from its protective housing. EP251 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 person of ordinary skill in the art to consider a sealed button feature like that in Richardson ’687, allowing for a control element to be actuated on the enclosed device without removal from the case. EP251 ¶ [0047]. EP251 also teaches that it has opening for accessing a functional element of the encased device, which opening is sealed. *Id.* Thus, modifying that opening for accessing a button is an obvious feature, known from Richardson ’687 and the other cited art.

It would also be obvious to use the secondary references Noda and Krumin, or Pirila, in combination with EP251 and Richardson ’687 to further teach and/or reinforce the common use of the “button feature” of claim 19 in the prior art. Noda and Krumin both show such button features are known and commonplace, to the extent not already known from Richardson ’687. A person of ordinary skill in the art would have good reason to use the same type of sealed button approach in Noda and Krumin that meets claim 19 in a case designed to receive an electronic device, as shown in EP251 and Richardson ’687. The principles are the same, and the button features in Noda and Krumin are designed to allow access and operability of a button on an electronic device from outside a housing. Thus, a person of ordinary skill in the art would readily consider this type of approach when designing a case that is removable from the electronic device, like EP251’s and Richardson ’687’s, in order to access and operate the buttons of the device to be encased. Moreover, it would be obvious to choose a sealed button like these, as EP251 is directed to a waterproof case. Thus, it would be obvious and predictable that a person of ordinary skill in the art would consider the use of a sealed button, as taught in these

additional references. And it would likewise be obvious to use such a sealed button with an “extended engagement portion” to reach through the outer wall to a button on the encased device so that it can be actuated. These are commonsense features the prior art makes well known, that function in the known manner to achieve predictable results.

Furthermore, the ’598 Patent includes housings that are “the actual housing of” the electronic device in its invention summary section, further confirming Noda and Krumin are in the same or, at the very least, an analogous field and would be considered by a person of ordinary skill in the art. ’598 Patent at 3:8-13. Accordingly, a person of ordinary skill in the art would include the button feature in Noda and Krumin, including the “opening,” the “flexible member,” and the “extended button engagement portion,” on one of the top and bottom members of EP251 and Richardson ’687.

Likewise, the inclusion of the button features of Pirila, in combination with EP251 and Richardson ’687, is an obvious choice to a person of ordinary skill in the art for enabling the user to contact and actuate the control buttons on the device inside the housing through the wall thereof while maintaining the opening for the button sealed or closed, thus enabling the user to use the respective functional elements of the encased electronic device without having to remove the same from its protective housing.

EP251 at ¶ [0047] itself also provides motivation to use the button features of Noda and Krumin, or Pirila, stating the desire for the user to “have use of the entire control of the mobile phone,” which suggests to a person of ordinary skill in the art to consider a sealed button feature like that disclosed by Noda, Krumin, and Pirila that allows for a control element to be actuated on the enclosed device without removal from the case.

Moreover, Richardson '687 provides additional teachings that would have made it obvious to a person of ordinary skill in the art to include the sealed button feature of Noda, Krumin, and Pirila that meet claim 19 in a housing for an electronic device. As discussed above, Richardson '687 discloses various embodiments that meet claim 19, i.e. openings for switches on the device covered by what Richardson '687 calls “switch pads.” That teaches the use of such button features on a housing that receives an electronic device like EP251, and would give a person of ordinary skill in the art good reason to consider additional designs for actuating switches, like in Noda, Krumin, and Pirila, that also have an extended design to facilitate actuation of a switch or control on the device without having to remove the same from its protective housing.

Claim 19 is also rendered obvious over the Motion case, JP796, FR857, the '419 Patent, the '447 Patent, the '833 Patent, the '088 Patent, and Pirila. The Motion case and JP796 identifies the elements of claim 19 as set forth in Exhibit F, including the basic structure of an apparatus for housing an electronic device, including such features as the claimed “first member,” “second member,” “bounding members,” “membrane,” “channel,” “lens,” and “compressible gasket,” etc. These are all well-known features for encasing an electronic device within a housing for waterproof with a simple and efficient connection and enabling use of a camera on the device from within the housing. To the extent “mate” in claim element 17[g] requires an interlocking engagement between the bounding members beyond that shown in JP796, mating engagement is well-known from FR857, which discloses an apparatus for housing an electronic device, as well as the '419 Patent, the '447 Patent, the '833 Patent, the '088 Patent, which further show such features are well-known and commonplace in containers in general.

The mating engagements in the prior art for containers would be considered by a person of ordinary skill in the art because they effectively secure and seal the members of a container together in a liquid tight manner. Such features would be obvious to use in a device housing an electronic device, such as those in the base references, because it is desirable to secure the housing members together in a manner to limit or prevent the ingress of liquids, which was already a well-known reason to do the same in prior containers. In doing so, including elements in the manner claimed is an obvious design choice and well within the skill level of a person of ordinary skill in the art, as is shown by their use in containers for electronic devices and other types of containers in general. They are well-established features known in the container art in general for many years and would have been, at the very least, obvious to try. Moreover, the '477 Patent discloses a compressible gasket in its channel, and FR857, the '419 Patent, the '833 Patent, and the '088 Patent also do so, to the extent the term “compressible gasket” (claim elements 17(f) and 17(g)) includes a lip or flange, as appears to be Plaintiffs’ perceived construction.

Pirila is combined with the above references to teach and/or reinforce the commonplace use of the “button feature” of claim 19 with a flexible member and extended portions, reinforcing the inclusion of the same in the Motion case. The inclusion of such a feature is an obvious choice to a person of ordinary skill in the art for enabling the user to contact and actuate the control buttons on the device inside the housing through the wall thereof while maintaining the opening for the button sealed or closed, and thus enabling the user to use the respective functional elements of the encased electronic device without having to remove the same from its protective housing. Pirila itself is designed to be “waterproof/dustproof,” thus providing good reason to consider its sealed, extended buttons that reach through case/housing openings. Pirila

at Abstract. The additional motivation identified above from EP251 and Richardson '687 also evidences the knowledge a person of ordinary skill in the art would have, motivating that person to consider a sealed button feature like that disclosed by Pirila allowing for a control element to be actuated on the enclosed device without removal from the case.

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

7. U.S. Patent No. 9,660,684

Plaintiffs only assert infringement of claim 8 of U.S. Patent No. 9,660,684. Fellowes' invalidity contentions for claim 8 are identified below.

1. Claim 8 is anticipated by JP384.
2. Claim 8 is obvious over Richardson '493 in view of JP384 in further view of the '712 Patent.
3. Claim 8 is anticipated by Ikelite.
4. Claim 8 is anticipated by the '712 Patent.

See the claim chart in **Exhibit G** for the identification of each claim element in the cited prior art (some under Plaintiffs' perceived interpretation).

Reason to Combine: Claim 8 is anticipated by JP384, Ikelite, and the '712 Patent. However, claim 8 is also obvious over Richardson '493 in view of JP384 in further view of the '712 Patent. The use of housing members and a coupling mechanism is a well-known design choice for a waterproof housing that is obvious to use and well within the level of the person of ordinary skill in the art. As shown in Exhibit G, Richardson '493 discloses a protective

encasement having a case construction with a “top member” and a “bottom member” that mate and have a coupling mechanism for an mobile computing device as being well known, it includes control switches of various types, and is designed to be waterproof. JP384 has similar teachings of a waterproof housing for a mobile computing device, and also includes the claimed “aperture,” “switch feature,” “switch interface” and related features, showing it is known to include such features on a waterproof housing with top and bottom members.

To the extent the claim is read to require the control switch on the encased mobile computing device to be a linearly moveable control switch, and it is argued that JP384 discloses a rotary switch that is not linear, the ’712 Patent teaches a linear switch with the claimed “aperture,” “switch feature,” “switch interface,” and related features. The ’712 Patent also teaches that a housing for a mobile electronic device may have top/bottom member design, as shown in Fig. 10, like JP384 and the Richardson ’493. It would be obvious to use the switch interface 132 of JP384 to control a linear switch on a camera or other device as shown in the ’712 Patent, and/or modify the switch interface 132 of JP384 to control such a linear switch as shown in the ’712 Patent. Indeed, both are directed to cameras as an example of a mobile computing device.

The specific type of switch to be controlled is determined by the encased electronic device itself and it would be obvious to design the “switch interface” to move a linear switch in the manner it was designed to operate. The switch included on the encased device dictates the use of a control operable from the exterior and the specific type of switch dictates the configuration of that control’s interface with the switch. A person of ordinary skill in the art would be aware from JP384 and the ’712 Patent of the ability to control a linear switch from the case exterior as taught by those references without having to open a port, door or flap to access

the switch and risk the ingress of water or dust. The “switch interface” 132 in JP384 would also be able to move a linear switch, as its rotational movement would cam the switch in a linear direction just as the “switch interface” 4b in the ’712 Patent moves the linear switch 10 on its camera or other device. Both prior art references are structurally very similar and function in the same manner. Thus, to the extent Plaintiffs contend that JP384 does not meet claim element 8[i] because it discloses an encased device with a rotatable switch rather than a linear switch, the ’712 Patent provides that teaching and JP384 additionally teaches that such a “switch feature” can be used on commonplace devices with two-member housings like itself and Richardson ’493. As discussed, the use of coupled top and bottom members is a well-known design choice for a housing that is obvious to use and well within the level of the person of ordinary skill in the art, and allows easy installation of the electronic device.

Claim 8 recites obvious subject matter already well within the ordinary skill level in the art with elements performing in accordance with their functions known in the art and achieving predictable, expected results, and also would be obvious to try.

8. U.S. Patent No. 9,498,033

Plaintiffs only assert infringement of claims 1, 3, 5, 6, 7, 8, 11, 13, 16, and 17 of U.S. Patent No. 9,498,033. Fellowes’ invalidity contentions for those claims are identified below.

1. Claims 1, 3, 5, 7, and 8 are anticipated by JP116.
2. Claims 1, 3, 5, 7, 8, 11, 13, and 17 are obvious over JP116 in view of Richardson ’707.
3. Claims 1, 3, 5, 7, and 8 are obvious over the H2O Audio Waterproof Housing in view of JP116.

4. Claims 1, 3, 5, 7, and 8 are obvious over JP116 in view of US Richardson '707 in further view of Pirila and the '777 Patent.
5. Claims 6, 11, 13, 16 and 17 are obvious over JP116 in view of Richardson '707 in further view of Pirila.
6. Claims 11, 13, and 17 are obvious over JP116 in view of Richardson '707 in further view of the '777 Patent.
7. Claims 6 and 16 are obvious over JP116 in view of US Richardson '707 in further view of Pirila and the '777 Patent.
8. Claims 6 and 16 are obvious over JP116 in view of Richardson '707 in further view of the Motion case.
9. Claim 11 is anticipated by the H2O Audio Waterproof Housing.
10. Claim 6 is obvious over the H2O Audio Waterproof Housing in view of JP116 in further view of Pirila, the '777 Patent, and Krumin.
11. Claim 16 is obvious over the H2O Audio Waterproof Housing in view of Pirila, the '777 Patent, and Krumin.
12. Claims 13 and 17 are obvious over the H2O Audio Waterproof Housing in view of Richardson '707.

See the claim charts in **Exhibit H** for the identification of each claim element in the cited prior art (some under Plaintiffs' perceived interpretation).

Reason to combine: JP116 anticipates claims 1, 3, 5, 6 and 8 and the H2O Audio Waterproof Housing anticipates claim 11 as set forth in the claim chart. To the extent it is alleged JP116 does not have a hard shell cover, Richardson '707 teaches the use of a hard shell cover that corresponds to the shape of the electronic device's rear and side. It would be obvious to use a hard shell material for the shell cover in JP116 to provide rigid protection to the electronic device encased therein for protection against drops and other forces in addition to the protection afforded by its cushion layer.

To the extent it is alleged that JP116 or any other reference does not teach a display screen that is considered an “interactive control,” that is taught by Richardson ’707. It would be obvious to use the case of JP116 or any other reference with, or modify it for use with, an electronic device having a touchscreen because the features of the device dictate the features to be included in a case designed for the device. Moreover, JP116 teaches its case can be used for a wide variety of electronic devices, suggesting its teachings can be applied to cases for devices with touchscreens. A person of ordinary skill in the art would have good reason to combine the features of such structurally similar devices despite any differences because those differences are generally dictated by the configuration of the electronic device to be encased, and a person of ordinary skill in the art knows how to modify the general teachings of these references to accommodate any particular electronic device, including one with a touch screen.

Further, to the extent it is alleged JP116 does not teach a “raised portion . . . extending beyond a plane of the display screen of the electronic device when the protective enclosure is disposed over the electronic device” or that is “integrally formed in the front shell at a perimeter of the display screen opening,” those features are also taught by Richardson ’707. The use of such a feature would have been an obvious choice to a person of ordinary skill in the art to keep the screen recessed or set back so that the raised portion can help protect it from drops or scratches. Similarly, Pirila teaches that feature as well, reinforcing that it is well-known and obvious.

Further, Richardson ’707 teaches the use of an outer cushion layer, or higher friction overmolds, suggesting the desirability of an outer higher layer, higher friction material for providing enhanced shock absorption and gripping and JP116’s stretchable cushion layer serves the same purpose. Therefore, a person of ordinary skill in the art would have reason to combine

those for the same reasons. Also, the removability of JP116's cushion layer allows for changeability, such as if it is damaged or worn, which provides an additional reason to consider its use instead of an overmold. Pirila's use of an elastomer material is also of a higher friction, and likewise teaches the use of such materials is well known.

Richardson '707 also discloses the use of a hole with a "watertight plug" for operating mechanical buttons or switches of the electronic device, which would be a control pad with a raised portion to engage a corresponding interactive control. Similarly, Richardson '707 discloses the use of a dimpled surface on the membrane as a pliable mechanism, but also discloses such pliable feature may be on the side of the case for side buttons of the device. A dimpled pliable feature is a control pad and the recess of the dimple provides a "raised portion" on the inside surface for engaging the interactive control button of the electronic device. When using a stretchable cushion layer like that in JP116, it would be obvious to incorporate those structures into the cushion layer so that they can act through openings in the inner shell.

JP116 teaches that the corresponding openings in both the inner hard shell 2b and the outer stretchable cushion layer 2a are aligned with functional elements of the electronic device, like the speaker, buttons, microphone, antenna, etc. That teaches when a functional element is included, as taught in Richardson '707, corresponding openings would likewise be included. That would be obvious to a person of ordinary skill in the art to enable the user to access the full functionality of the buttons or other control features in the encased device, while limiting presence of apertures in the outer layer that could permit ingress of water or dust. Therefore, the use of such "one or more control pads" would be obvious.

Richardson '707 also discloses a variety of clasping mechanisms on the disclosed first and second members to join the shell members. The clasping mechanisms disclosed by

Richardson '707 are well-known in the art, and it would have been obvious to a person having ordinary skill in the art to modify JP116 by using the hard protective case of Richardson as the spacer 2b, including the various clasping mechanisms disclosed therein.

It also would have been obvious to a person of ordinary skill in the art to combine Pirila and/or the '777 Patent to the combination of JP116 and Richardson '707. To the extent that it is required that the “opening” providing access to the interactive controls of the electronic device does not have a membrane or other structure, the '777 Patent discloses a smart pouch for a mobile device having a display window 122 to permit viewing of the device display 124. The display window may be a cut-out portal on the interface wall, or it may include a transparent covering that provides the display 124 protection against scratching and foreign particles. The “cut-out portal” is an opening in the sense there is no structure present in it. A person of ordinary skill in the art would have been motivated to modify JP116 and Richardson '707 such that the user had direct access to the touch screen of the phone as opposed to touching the screen through a membrane.

A person having ordinary skill in the art would have also been motivated to modify JP116 and Richardson '707 to use mating “retention structures” such as those disclosed by the '777 Patent to ensure the outer flexible cushion layer stayed in place. A person of ordinary skill in the art would have reason to combine the retention structure and open display with JP116 and Richardson '707 such that a soft cushion layer remains securely disposed over the electronic device.

Additionally, to the extent it is argued JP116 and Richardson '707 do not teach the features reciting that the cushion layer has “one or more control pads disposed to correspond to respective one or more of the openings of the hard shell cover, each control pad having a raised

portion to engage a corresponding one of [the interactive controls/the at least one control areas] of the electronic device on a side of the electronic device when the protective enclosure is disposed over the electronic device,” that is also taught by the ’777 Patent. Specifically, the ’777 Patent discloses that its flexible outer cover (i.e., a claimed “stretchable cushion layer”) includes button pushkeys, including a set on the side that are “control pads.” These include an inwardly raised portion for engaging a control button on the side of the phone. It would be obvious when including a stretchable cushion layer like that in the ’777 Patent and JP116 on a hard shell case like Richardson ’707 to provide such control pads with raised portions to reach and engage control buttons on the encased electronic device. This is an obvious feature that a person of ordinary skill in the art would readily understand to include in a case design, as those control pads with raised portions contact the control buttons on the device through the hard case, and enable the user to use all the functional elements of the encased electronic device without having to remove the same from its protective housing.

Pirila discloses a case for an electronic device, e.g., a phone, formed of a hard inner material and a flexible/elastomeric outer material. It is made of a two-shot molding process instead of stretching the outer elastomeric material over the hard inner case. That teaches the desirability of a hard inner shell as recited in claim 1, and that JP116’s construction would benefit from the use of a hard inner shell to the extent its shell is not literally considered “hard.” This also reinforces the applicability of hard inner shell of Richardson ’707.

Pirila also teaches the inclusion of aligned features in both layers for the functional elements of the device that provide for operation of controls on the side of the electronic device, including buttons that extend through openings for actuation of a volume control or the like. It also teaches an opening for its screen in both layers. Similarly, Pirila teaches the use of inward

protrusions in general to access functional buttons, including inward protrusions that have raised portions for depressing keys. The inclusion of such features is an obvious choice for reasons similar to those discussed above with respect to the '777 Patent (which also discloses control pads with raised portions for engaging buttons), namely, for contacting the control buttons on the device through the hard case, and thus enabling the user to use all the functional elements of the encased electronic device without having to remove the same from its protective housing. The '777 Patent confirms that such extended/raised portions are well known. Pirila also teaches numerous other features of the claims as shown in the chart, showing they are well known and obvious to use. For example, it shows a raised portion around and extending beyond a screen, which protects it from direct contact with surfaces. It also teaches gaps or opening that expose part of the hard shell, again confirming that is a known choice. Pirila generally teaches every limitation of all the claims, except being overmolded rather than stretched on as taught by JP116. That reinforces the unpatentability of all those features, and JP116 teaches it is already known to have a removable cushion layer, which is desirable if it becomes in need of replacement.

With regard to claims 6 and 16, it also would have been obvious to a person of ordinary skill in the art to use Krumin. Krumin teaches a protective enclosure with a hard, rigid inner shell with an opening and an outer elastomer layer. The elastomer layer provides a control pad/button feature that extends through an opening in a hard shell for an electronic device, such as a push-to-talk button on a radio. That provides an additional reason why claims 6 and 16 are obvious, as it is well-known to provide an elastomer outer part with a corresponding control pad with a raised portion to engage a control of an electronic device through a hard shell member. It would be obvious to also do the same to provide for operation of a control button on a device

removable from that housing, while keeping that control button area sealed against the ingress of water or particles.

Further as to claims 6 and 16, each of Richardson '707, the Motion case and Krumin teach a control pad with a raised portion for engaging a control of the electronic device. Krumin specifically teaches it on an outer cushion layer, and the Motion case includes that feature on a stretchable resilient component, each to protect against water or dust entry with a raised portion extending to engage a device control. It would be obvious to include such a feature on a stretchable cushion layer to cover the opening in the hard shell over a device control to protect against liquids or dust, and to use the raised portion to reach and engage the electronic device control through the hard shell cover.

Richardson '707, Pirila, Krumin, and the Motion case further establish that it was the general state of the art and common knowledge to use button features like those claimed in claims 6 and 16 to extend through housing walls to contact a control feature on an electronic device.

It would have also been obvious to a person of ordinary skill in the art to combine the features of the H2O Audio Waterproof Housing with the features of JP116. The H2O case has a stretchable cushion layer that provides cushioning to the hard shell cover and the iPod Nano when the cushion layer is over the hard shell cover and includes one or more openings that correspond to respective openings in the hard shell. To the extent that the stretchable cushion layer of the H2O case does not have a “retention structure” that engages with a “corresponding retention structure of the hard shell cover,” a person of ordinary skill in the art would be motivated to adopt its features, including the benefits of using a hard shell and a cushion layer,

and combine with the retention structures of JP116. The '777 patent contains similar retention teachings, further evidencing its obviousness.

Further as to claims 6 and 16, the addition of the '777 Patent, Pirila, and Krumin to the H2O case or the combination of the H2O case and JP116 renders those claims obvious. The application of the '777 Patent, Pirila, and Krumin, to JP116 are discussed above in detail, and apply similarly to the H2O case and JP116. For example, the '777 Patent discloses that its flexible outer cover (i.e., a claimed “stretchable cushion layer”) includes button pushkeys, including a set on the side of the electronic device that are “control pads.” These include an inwardly raised portion for engaging a control button on the side of the phone. Pirila also teaches the inclusion of aligned features in both layers for the functional elements of the device that provide for operation of controls on the side of the electronic device, including buttons that extend through openings for actuation of a volume control or the like. Krumin further provides an elastomer layer having a control pad/button feature that extends through an opening in a hard shell for an electronic device, such as a push-to-talk button on a radio. It would be obvious when including a stretchable cushion layer like that in the '777 Patent and JP116 on a hard shell case like the H2O case to provide such control pads with raised portions to reach and engage control buttons on the encased electronic device. This is an obvious feature that a person of ordinary skill in the art would readily understand to include in a case design, as those control pads with raised portions contact the control buttons on the device through the hard case, and enable the user to use all the functional elements of the encased electronic device without having to remove the same from its protective housing.

To the extent that the H2O case does not have a “touch screen accessible via the at least one of the one or more openings,” it would be obvious to combine the features of Richardson

'707 with the H2O case. It would be obvious to use the H2O case with an electronic device having a touchscreen because the features of the device dictate the features to be included in a case designed for the device. A person of ordinary skill in the art would have good reason to combine the features of such structurally similar devices despite any differences because those differences are generally dictated by the configuration of the electronic device to be encased, and a person of ordinary skill in the art knows how to modify the general teachings of these references to accommodate any particular electronic device, including one with a touch screen.

To the extent that the H2O case does not have a “raised portion around the touch screen of the electronic device,” it would be obvious to combine the features of Richardson '707 with the H2O case. The use of such a feature would have been an obvious choice to a person of ordinary skill in the art to keep the screen recessed or set back so that the raised portion can help protect it from drops or scratches.

Claims 1, 3, 5, 6, 7, 8, 11, 13, 16, and 17 recite obvious subject matter already well within the ordinary skill level in the art with elements performing in accordance with their functions known in the art and achieving predictable, expected results, and also would be obvious to try.

Arguments presented in the *Inter Partes* Review IPR2020-00852 against claim 1, 3, 5, 6, 7, 8, 11, 13, 16, and 17, which is pending at the USPTO, are incorporated herein by reference. See Petition at 29-60, 66-77.

D. Charts Identifying Where Each Element of Each Asserted Claim is Found in the Prior Art

The claim charts attached as **Exhibits A-H** identify where in each element of each Asserted Claim is found within the prior art, as required under LPR 3.1(b) and 2.3(b)(3):

Patent	Exhibit
'325 Patent	Exhibit A
'466 Patent	Exhibit B
'180 Patent	Exhibit C
'834 Patent	Exhibit D
'950 Patent	Exhibit E
'598 Patent	Exhibit F
'684 Patent	Exhibit G
'033 Patent	Exhibit H

E. Final Invalidity Contentions under 35 U.S.C. §112 and §101

Pursuant to LPR 3.1(b) and 2.3(b)(4), Fellowes provides detailed statements of the grounds of invalidity based on indefiniteness under 35 U.S.C. § 112(2) or enablement or written description under 35 U.S.C. § 112(1).

1. U.S. Patent No. 8,526,180

Plaintiffs only assert infringement of claim 26 of U.S. Patent No. 8,526,180. Fellowes' invalidity contentions under §112 for that claim are identified below.

1. Claim 26 is not described in the patent specification in sufficient detail such that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention and does not satisfy the written description requirement of 35 U.S.C. § 112, first paragraph.⁴

Claim 20 (from which claim 26 depends) requires a “gasket.” On its face, the claim, as issued, reads in an internally consistent manner if the term “gasket” as used in 20 is interpreted differently from its ordinary meaning, which is usually a sealing part like an o-ring (like o-ring 55) placed between two interfacing surfaces. The internal inconsistency within the claims arises because a “gasket” recited in the independent claim cannot “include[] a bung that is sized for entry into the aperture” per dependent 26, as shown below with regard to gasket 55 mounted to bung 53.

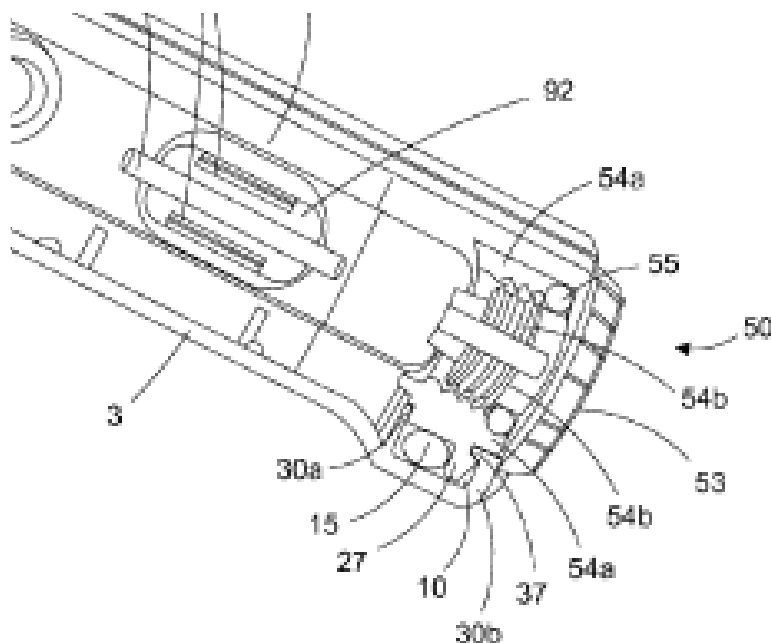


FIG. 11C

⁴ This patent pre-dates the America Invents Act, and thus the prior version of 35 U.S.C. §112 applies.

Indeed, in every instance the specification states that the bung 53 includes or has the gasket 55 added to it. '180 Patent at 60:2-3 ("The port sealing bung 53 further includes a gasket 55 circumscribing the port sealing bung 53."), 64:29-32 ("... a gasket 55 positioned on the earphone port bung 53."), 64:34-39 ("... closure device such as port sealing bung 53 will include a corresponding thread feature 54b and may additionally include a gasket 55."), 65:67-66:5 ("The port sealing bung 53 may also include a gasket region containing a gasket 55. . ."), 66:27-29 ("The port sealing bung 53 includes a gasket region with gasket 55 and a bayonet cam feature this time with an expanded region 54c."), 67:43-45 ("The port sealing bung 53 additionally includes a gasket 55 which enhances the liquid-tight seal.") (emphasis added to all). But the claims as a whole say the opposite by reciting the "gasket" in the independent claim and then stating in the dependent claim 26 that the "gasket includes a bung[.]"

Therefore, claim 26 is not described in the patent specification in sufficient detail such that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention and does not satisfy the written description requirement of 35 U.S.C. § 112, first paragraph.

2. The specification does not describe how to make and how to use the invention of claim 26, and therefore claim 26 fails to satisfy the enablement requirement of 35 U.S.C. § 112, first paragraph.

For the same reasons identified in the section above, claim 26 is also invalid for lack of enablement. Specifically, there is an internal inconsistency within the claims because a "gasket" recited in independent claim 20 cannot "include[] a bung that is sized for entry into the aperture" per dependent 26. Because of the internal inconsistency, the specification does not describe how to make and how to use the invention of claim 26, and therefore claim 26 fails to satisfy the

enablement requirement of 35 U.S.C. § 112, first paragraph. As discussed above, the specification at best enables the opposite – bung 53 with an o-ring gasket 55 included on it.

3. Claim 26 is indefinite because its scope cannot be ascertained

Claim 26 is also indefinite because a person of ordinary skill in the art cannot ascertain how a “gasket” can “include” a bung. A person of ordinary skill in the art, reading the claims in light of the specification, would understand that a “bung” can include a “gasket” as disclosed in the ’180 patent specification. But the specification uses the term gasket in accordance with its plain and ordinary meaning as a seal member interposed between two surfaces to enhance sealing, which is the case for the situation where the bung 53 is fit into a housing aperture with the gasket 55 interposed between the bung and the housing outer surface. The specification provides no guidance as to how the term “gasket” can be understood with any definiteness to also include the bung itself. A person of ordinary skill in the art is left to guess as to whether the claim is intended to cover a bung that has a gasket on it, or some special undefined, and undisclosed gasket that is designed to include that bung.

Except as noted above, Fellowes is not currently aware of facts that would support invalidity contentions in accordance with 35 U.S.C. §112 and §101. Fellowes reserves the right to supplement these contentions, as permitted by applicable rules, as new information becomes available during discovery.

II. FINAL UNENFORCEABILITY CONTENTIONS

Attached hereto is **Exhibit I** identifying the acts supporting and all bases for the assertion of unenforceability with respect to the patents asserted by TreeFrog. As is noted in Exhibit I, discovery on this is incomplete due to TreeFrog. Accordingly, Fellowes reserves the right to

supplement these unenforceability contentions, as permitted by applicable rules, as new information becomes available during discovery.

III. CONCLUSION

Based on the foregoing, it is clear that each asserted claim of each asserted patent defines subject matter that is anticipated or obvious. Plaintiffs have yet to produce information responsive to Fellowes' discovery requests, and thus, Fellowes reserves the right to supplement these contentions, as permitted by applicable rules, as new information becomes available.

Dated: July 31, 2020

Respectfully submitted,

/s/ William P. Atkins
William P. Atkins (*admitted pro hac*)
Bryan P. Collins (*admitted pro hac*)
PILLSBURY WINTHROP
SHAW PITTMAN LLP
1650 Tysons Boulevard
McLean, Virginia 22102
Tel: 703.770.7900
Fax: 703.770.7901
william.atkins@pillsburylaw.com
bryan.collins@pillsburylaw.com

Peter J. Shakula (#6204370)
pjshakula@woodphillips.com
WOOD PHILLIPS
500 West Madison Street, Suite 1130
Chicago, Illinois 60661-2562
Tel: 312.876.1800
Fax: 312.876.2020

Attorneys for Defendant Fellowes, Inc.

CERTIFICATE OF SERVICE

I certify that on July 31, 2020 a true and correct copy of **FELLOWES, INC.'S FINAL UNENFORCEABILITY AND INVALIDITY CONTENTIONS PURSUANT TO LPR 3.1** was served upon counsel of record for Plaintiffs via email as addressed below:

Reid P. Huefner
Margaret Anne Herrmann
Irwin IP LLC
222 South Riverside Plaza
Suite 2350
Chicago, IL 60606
Email: rhuefner@irwinip.com
Email: mherrmann@irwinip.com

James W. Beard
Merchant & Gould P.C.
1801 California Street
Suite 3300
Denver, CO 80202
Email: JBeard@MerchantGould.com

Heather J. Kliebenstein
Merchant & Gould, P.C.
3200 IDS Center
80 South 8th Street
Minneapolis, MN 55402
(612) 371-5213
Email: hkliebenstein@merchantgould.com

/s/ Henry Fildes
Henry Fildes