

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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Fellowes, Inc.

v.

TREEFROG DEVELOPMENTS, INC.

Patent Owner

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**IPR2020-01543**

U.S Patent No. 8,564,950

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**REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE**

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

**List of Exhibits**

<b>Exh. No.</b>	<b>Description of Exhibit</b>
<b>1001</b>	U.S. Patent No. 8,564,950
<b>1002</b>	Prosecution File History of U.S. Patent No. 8,564,950
<b>1003</b>	District Court Complaint
<b>1004</b>	European Patent No. 1,583,251 (Kuhn)
<b>1005</b>	U.S. Patent Application Publication No. 2008/0316687 (Richardson '687)
<b>1006</b>	U.S. Patent No. 7,050,712 (the '712 Patent)
<b>1007</b>	Japanese Patent Publication 2002-82384 (JP384)
<b>1008</b>	French Patent Publication 2,705,857 (FR857)
<b>1009</b>	U.S. Patent No. 7,090,088 (the '088 Patent)
<b>1010</b>	Declaration of Dr. Charles Garris, Regarding Invalidity of the Challenged Claims of U.S. Patent No. 8,564,950
<b>1011</b>	Answer and Counterclaims from related litigation
<b>1012</b>	Stipulation of Dismissal of counterclaims in related litigation
<b>1013</b>	Petitioner's Invalidity Contentions from related litigation
<b>1014</b>	Patent Owner's Notice of Motion and Motion for Judgment from related litigation
<b>1015</b>	Hearing Transcript dated 2/27/20, relating to the Motion in Exh. <b>1014</b>
<b>1016</b>	Patent Owner's Notice of Withdrawal, relating to the Motion in <b>Exh. 1014</b>
<b>1017</b>	U.S. Patent Publication 2003/0095374
<b>1018</b>	Dictionary definition for "clasp"
<b>1019</b>	Board e-mail authorizing filing of Sur-Reply, dated January 25, 2021

Per the Board's e-mail dated Jan. 25, 2021 (**Exh. 1016**), Petitioner responds to the argument in the Patent Owner's Preliminary Response ("POPR") at 33 and 39-41 based on the term "corresponds."

**I. Patent Owner's Construction of "Corresponds" is Incorrect**

Patent Owner implicitly construes "corresponds" in the limitation "a rigid frame that corresponds to the outer perimeter of the electronic device" as follows:

... The '950 Patent, on the other hand, discloses an enclosure that is adapted for housing a specific device. EX1001, 3:1-13.

Consistent with these teachings, independent claim 17 affirmatively requires a "frame that *corresponds* to the outer perimeter of the electronic device." *The frame closely parallels and/or immediately surrounds the outer perimeter of the enclosed device.*

POPR at 33 (emphasis added). The '950 Patent does not provide such a definition for "corresponds," nor does the prosecution history. Patent Owner's contention that "corresponds" means the "frame closely parallel[s] and/or immediately surround[s] the outer perimeter of the enclosed device" is also inconsistent with the specification.

The '950 Patent specification does not use the term "corresponds" to describe the relationship between the frame, the electronic device, and the bottom member. What the specification does make clear, however, is that the frame need not "closely parallel[] and/or immediately surround[]" the enclosed device, even going so far as to say the frame can be significantly larger than the enclosed

device. “It is to be noted that in certain instances, *the housing may be larger, e.g., substantially larger, than the object the housing is configured to house*, such as where there is little or no utility for having the size of the housing tied to the object it is configured to house.” **Exh. 1001** at 12:24-41 (emphasis added); *see also id.* at 2:27-30, 10:14-17, 76:34-36. That description is plainly inconsistent with Patent Owner’s construction that attempts to differentiate from Kuhn because its enclosure can also house devices of different sizes.

The POPR relies on col. 3, ll. 1-13 for the contention that the ’950 Patent “discloses an enclosure that is adapted for housing a specific device,” which forms the basis for its construction of “corresponds.” POPR at 33. That paragraph in column 3, however, expressly states that the shape and size of the housing and the device contained therein may vary: “It is to be understood that although the following description is set forth with respect to describing the shape and size of a particular container for housing a particular device, i.e., a mobile telephone device, *the shape and size of the container and/or the object, e.g., device, to be contained can vary*, for instance, as described above.” **Exh. 1001** at 3:6-13 (emphasis added); *see also id.* at 12:54-61. Further, the language “as described above” refers to the immediately preceding paragraphs, each of which discloses enclosures designed to house many different objects, not any specific device, and that the “housing may be of any appropriate size and dimension so long as it is capable of housing the

object and protecting it....” *Id.* at 2:27-30; *see also id.* at 2:14-59, 10:14-17. That

contradicts Patent Owner’s overly narrow construction seeking to avoid Kuhn.

Further, that passage in column 3 even says one “or” the other “can vary,” which also confirms that passage does not require a specific housing/device match.

Patent Owner’s construction of “corresponds” thus injects an unnecessary restriction into the claims. There simply is no disclosure in the ‘950 Patent specification limiting the claims to only “an enclosure that is adapted for housing a specific device.” POPR at 33. The specification instead makes it clear that the alleged invention described therein can include an enclosure for different devices, just like Kuhn. **Exh. 1001** at 2:27-30, 3:6-13, 10:14-17, 12:24-41, 76:34-36.

Petitioner thus reasonably applied “corresponds” to the electronic device’s outer perimeter, citing Kuhn’s Figures that show different housing frames with essentially the same shape as the encased phones (i.e., they “correspond”). Pet. at 29-30 (citing, e.g., **Exh. 1004**, Figs. 3 and 6). Indeed, even under Patent Owner’s narrow construction, those cited Figures 3 and 6 show a closely parallel or immediately surrounding relation between the housing and the phone. Whether some other undisclosed phone may have a different shape does nothing to change the fact that Kuhn shows its housings used with correspondingly shaped phones.

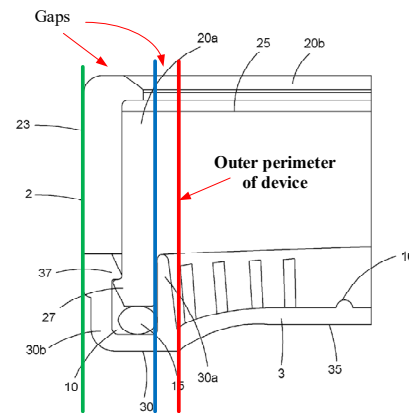
## **II. Patent Owner improperly attempts to impose the “corresponds” requirement for both recited perimeters on the exact same part**

Pages 39-41 of the POPR further contend that the “rigid frame” of Kuhn’s top member also does not “correspond[]” to the perimeter portion of the bottom member, focusing only on part 40 of Kuhn’s frame. POPR at 40, 41 (annotated FIG. 3). Patent Owner either overlooks Petitioner’s identification of Kuhn’s “rigid frame” as including part 39, or improperly attempts to limit the claims by requiring the exact same part of the “rigid frame” to “correspond” to *both* the electronic device’s outer perimeter and bottom member’s perimeter portion.

Petitioner did not contend that the “rigid frame” which “corresponds” to the perimeters of the electronic device and the bottom member is met *only* by part 40, as Patent Owner suggests. Rather, Petitioner identified Kuhn’s “rigid frame” as “sealing frame 40/frame element 39.” Pet. at 29, 41; **Exh. 1010** ¶ 59. Patent Owner even acknowledges part 39 as part of the frame. POPR at 43 (arguing closure element 50 “extends from the *outer perimeter* of the frame,” citing element 39) (emphasis original), 44 (“frame (39)”). Thus, the issue is not whether part 40 *alone* “corresponds” to both perimeters to satisfy the “rigid frame” limitation, but whether both cited parts “sealing frame 40/frame element 39” together do. As discussed above, part 40 of the “rigid frame” “corresponds” to the electronic device’s “outer perimeter,” and it cannot reasonably be disputed that part 39 of that frame also “corresponds” to the bottom member’s “perimeter portion” because it has the same matching shape. Pet. at 29-30. Indeed, the cited Figures even show

the engaging projection/channel and aligned outer surfaces. *Id.* (citing, e.g., **Exh. 1004**, Figs. 3, 9, 10)

The '950 Patent also does not support Patent Owner's requirement that the exact same part of the "rigid frame" must "correspond" to *both* the electronic device's outer perimeter and the bottom member's perimeter portion. As seen in the annotated figure, part 20a that faces the device's outer perimeter and the outer part 23 matching the outside of the bottom member's "perimeter



portion" at the green line are different parts. That use of two different frame parts is inconsistent with the notion that the exact same part of the "rigid frame" must "correspond[]" to both the device and the bottom member's perimeters. *See also Exh. 1001* at, e.g., Fig. 3B-3D, 6B, 6D, 8B, 12D, 13C (same arrangement).

Moreover, that annotated drawing (and the others cited *id.*) shows that the frame portion 20a facing the encased device's outer perimeter (like Kuhn's part 40) is set back from the inner wall 30a of the bottom member where the device sits, as shown by the red and blue lines. That also supports Petitioner' argument above in Section I and belies Patent Owner's argument that "corresponds" should be read to exclude a gap between "the sides of the device and the element 40" in Kuhn. POPR at 39.

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U.S Patent No. 8,564,950

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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the **REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was served by electronic mail this 29th day of January 2021 on the following attorneys of record:

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