

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IRON DOME LLC
Petitioner

v.

E-WATCH, INC.
Patent Owner

Case: IPR2014-00439

Patent No. 7,365,871

**Title: Apparatus For Capturing, Converting And Transmitting A Visual
Image Signal Via A Digital Transmission System**

**REVISED PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 37 C.F.R. §42.107**

Apple Inc.

EXHIBIT 1012

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EXHIBIT LIST

- [EXH. 2001] As-filed 1.131 Affidavit from U.S. patent application serial no. 10/336,470 (“Swear Behind Affidavit”) (part 1)
- [EXH. 2002] As-filed 1.131 Affidavit from U.S. patent application serial no. 10/336,470 (“Swear Behind Affidavit”) (part 2)
- [EXH. 2003] Office Action indicating sufficiency of the Swear Behind Affidavit.
- [EXH. 2004] U.S. patent no. 5,666,159 (“Parulski ‘159 Patent”)
- [EXH. 2005] U.S. patent no. 5,943,603 (“Parulski ‘603 Patent”)
- [EXH. 2006] Artifact sheet from U.S. patent application serial no. 10/336,470 (“Artifact Sheet”)
- [EXH. 2007] Unscanned artifacts from Swear Behind Affidavit (“Unscanned Artifacts”)

I. SUMMARY OF PATENT OWNER'S PRELIMINARY RESPONSE TO PETITIONER'S *INTER PARTES* REVIEW PETITION

Pursuant to 37 C.F.R. §42.107, E-Watch Inc. (“E-Watch”) respectfully submits this Preliminary Response to the petition for *inter partes* review (“Petition”) filed by Iron Dome LLC (“Petitioner”). On February 28, 2014, the Petition was filed with the United States (U.S.) Patent and Trademark Appeals Board (“PTAB”) of the U.S. Patent and Trademark Office (“USPTO”) pursuant to 35 U.S.C §314, requesting institution of *inter partes* review of U.S. patent no. 7,365,871 (“E-Watch ‘871 Patent”), owned by E-Watch and having been issued from U.S. patent application serial no. 10/336,470 (“E-Watch ‘470 Application”). In response to the filing of the Petition, the PTAB has opened *inter partes* review case no. IPR2014-00439 (“subject IPR case”). The PTAB issued its Notice of Filing Date (“Filing Date Notice”) on March 4, 2014 and, thus, the preliminary response is due on June 4, 2014. For the reasons set forth below, institution of *inter partes* review as requested in the Petition should not be granted, and the Petition should be dismissed in its entirety.

Pursuant to 37 C.F.R. §42.108(c), *inter partes* review shall not be instituted for a ground of unpatentability unless the Board (i.e., the PTAB) decides that the petition supporting the ground would demonstrate that there is a reasonable likelihood that at least one of the claims challenged in the Petition is unpatentable. Petitioner based its request for *inter partes* review on one or more U.S. patents that have been previously antedated with respect to the claimed invention of the E-

Watch '871 Patent through the filing of an affidavit in accordance with 37 C.F.R. §1.131 (i.e., the Swear Behind Affidavit) during prosecution of the E-Watch '470 Application. Moreover, Petitioner relied on an incomplete version of the Swear Behind Affidavit and consequently failed to consider or provide critical evidence included in the complete version of the Swear Behind Affidavit. The evidence not considered by Petitioner supported the Patent Examiner's decision that the Swear Behind Affidavit was sufficient for specifically overcoming certain patents disclosed therein. Because this evidence presented in the complete version of the Swear Behind Affidavit was fully considered by the Patent Examiner, the patents cited and relied upon by Petitioner are clearly and properly antedated and cannot be considered as a basis for rejection of the claims of the E-Watch '871 Patent. As required by 37 C.F.R. §42.108(c), Petitioner has failed to demonstrate a reasonable likelihood that it will prevail in showing that any challenged claim of the E-Watch '871 Patent is unpatentable under 35 U.S.C. §102 or §103 based on the cited prior art. Specifically, Petitioner is relying on art that cannot be considered as prior art because the Swear Behind Affidavit accepted by the Patent Examiner has confirmed that the invention predates this art.

II. REASONS WHY *INTER PARTES* REVIEW SHOULD NOT BE INSTITUTED

A. Failure To Present Facts Supporting Insufficiency Of Swear Behind Affidavit

As required by 37 C.F.R. §42.108(c), *inter partes* review shall not be instituted for a ground of unpatentability unless the Board decides that the petition supporting the ground would demonstrate that there is a reasonable likelihood that at least one of

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