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Paper No. 28
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

COMARCO WIRELESS TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2015-01879
Patent 8,492,933 B2

Before BRIAN J. MCNAMARA, PATRICK M. BOUCHER, and GARTH D. BAER, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 1 and 2 of U.S. Patent No. 8,492,933 B2 (Ex. 1001, "the '933 patent"). Comarco Wireless Technologies, Inc. ("Patent Owner") filed a Preliminary Response. Paper 13. Pursuant to 35 U.S.C. § 314(a), we determined the Petition showed a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1 and 2 and instituted an *inter partes* review of those claims. Paper 15, 16. Patent Owner filed a Patent Owner Response (Paper 17, "PO Resp.") and Petitioner filed a Reply to Patent Owner's Response (Paper 18, "Reply"). An oral hearing was held before the Board. Paper 26.

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. Having considered the record before us, we determine Petitioner has shown by a preponderance of the evidence that claims 1 and 2 of the '933 patent are unpatentable. *See* 35 U.S.C. § 316(e).

II. BACKGROUND

A. RELATED PROCEEDINGS

The parties assert the '933 patent is involved in *Comarco Wireless Technologies, Inc. v. Apple Inc.*, Case No. 8:15-cv-00145-AG, currently pending in the United States District Court for the Central District of California. Pet. 2; Paper 5, 1.

B. THE '933 PATENT

The '933 patent is directed to power supply equipment for electronic devices. Ex. 1001, Abstract. Figure 3 of the '933 patent is reproduced below:

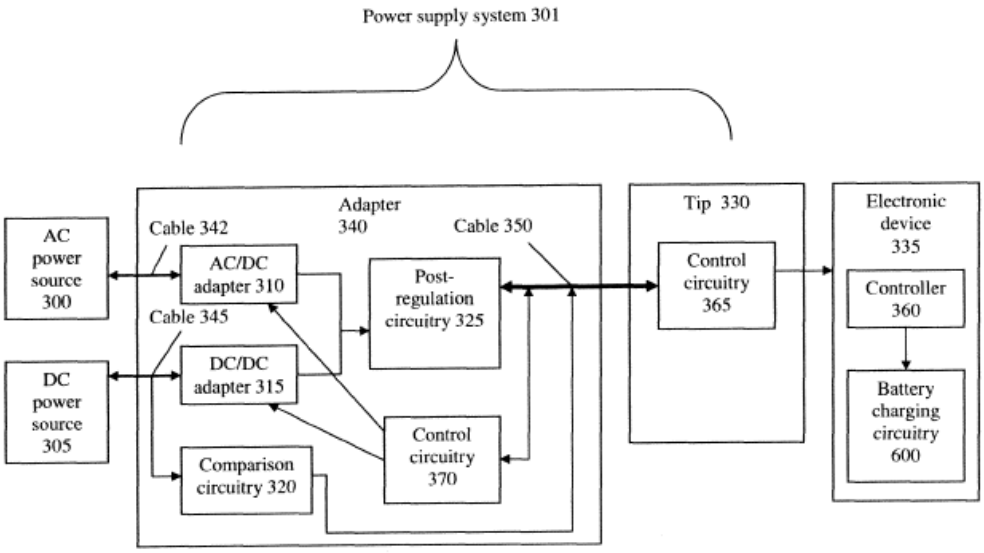

FIG. 3

Figure 3 depicts a power supply system for use with either AC or DC power source 300 or 305, which is connected to adapter 340, which is then connected via cable 350 to tip 330, which provides power to electronic device 335. *Id*. at 3:37–57, 4:19–54. According to the '933 patent, circuitry in adapter 340 may output a signal based on information about the power source, and that signal may be sent via cable 350 to tip 330 and then on to electronic device 335. *Id*. at 4:43–54. Based on the signal, the electronic device 335 may control the amount of power drawn to prevent overheating. *Id*. at 3:26–28, 4:54–63. The '933 patent explains also that tips "may be removable from the cable 350" and "may have different shapes and sizes, depending [on] the shape and sizes of the power input openings of the respective electronic devices 335 being powered." *Id*. at 3:55–60.

C. CHALLENGED CLAIMS

Challenged claims 1 and 2 of the '933 patent recite as follows:

> 1. Power supply equipment comprising:
>
> an adapter to convert power from a power source, external to the adapter, to DC power for powering an electronic device, the adapter including circuitry for producing an analog data signal for use by the electronic device to control an amount of power drawn by the electronic device; and
>
> a cable having proximal and distal ends, the proximal end being electrically coupled to the adapter and the distal end terminating in an output connector, the output connector including:
>
> a plurality of conductors to transfer the DC power and the analog data signal to the electronic device; and
>
> circuitry to receive a data request from the electronic device and in response transmit a data output to the electronic device to identify the power supply equipment to the electronic device.
>
> 2. The power supply equipment of claim 1 wherein the output connector can be detached from the cable.

Ex. 1001, 10:34–52.

D. INSTITUTED GROUNDS OF UNPATENTABILITY

We instituted *inter partes* review of claims 1 and 2 to determine whether they are unpatentable under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 7,243,246 B2 (issued July 10, 2007) (Ex. 1003, "Allen"), U.S. Patent No. 7,296,164 B2 (issued Nov. 13, 2007) (Ex. 1004, "Breen"), and U.S. Patent No. 6,054,846 (issued Apr. 25, 2000) (Ex. 1005, "Castleman"). Inst. Dec. 16.

III. ANALYSIS

A. PRINCIPLES OF LAW

Petitioner bears the burden of proving unpatentability of the challenged claims, and that burden never shifts to Patent Owner. *Dynamic*

Drinkware, LLC v. Nat'l Graphics, Inc., 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must establish the facts supporting its challenge by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person of ordinary skill in the art at the time of the invention. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). Obviousness is resolved based on underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Claim Construction

We conclude that no express claim construction is necessary to resolve whether Petitioner has demonstrated claims 1 and 2 of the '933 patent are unpatentable. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.").

C. Asserted Prior Art

1. *Allen (Ex. 1003)*

Allen discloses power supply equipment for managing power to an electronic device. Ex. 1003, Abstract, 1:10–18. Allen's Figure 4 is reproduced below:

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