

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

COMARCO WIRELESS TECHNOLOGIES, INC.,
Patent Owner.

Case No. IPR2015-01879
U.S. Patent No. 8,492,933

RESPONSE OF PATENT OWNER,
COMARCO WIRELESS TECHNOLOGIES, INC.

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COMARCO'S EXHIBITS

- Comarco 2001 ----- Declaration of Massoud Pedram, Ph. D.
- Comarco 2002 ----- Deposition of Dr. Nathaniel J. Davis, IV

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INTRODUCTION

For many years, patentee Comarco Wireless Technologies, Inc. ("Comarco") designed and sold power supply equipment to consumers under its own Charge Source brand and to companies for use or resale under their private label brands (e.g., Dell). Comarco pioneered the development of power converters, cables, and connectors or "tips." It has obtained 49 patents covering inventions in the field, including the patent in issue, U.S. Patent No. 8,492,933 (the "'933 patent") (Apple 1001).

Apple sought *inter partes* review of claims 1 and 2 of the '933 patent (the "challenged claims") on three grounds. The Board has allowed only one to proceed to trial, namely: whether the challenged claims are obvious in light of U.S. Patent No. 7,243,246 to Allen, *et al.* (Ex. 1003, "Allen"), in combination with U.S. Patent No. 7,296,164 to Breen, *et al.* (Ex. 1004, "Breen") and U.S. Patent No. 6,054,846 to Castleman, *et al.* (Ex. 1005, "Castleman").

Comarco demonstrates below, with the assistance of the expert Declaration of Dr. Massoud Pedram (Comarco Ex. 2001) and the deposition testimony of Apple's expert, Dr. Nathaniel J. Davis (Comarco Ex. 2002), that the trial should be resolved in its favor because Allen, Breen, and Castleman do not foreshadow the unique combination of two features that distinguish the challenged claims from the prior art.

The first feature is recited in limitation 1(b). It requires that an adapter that converts power drawn from an AC or a DC source into regulated DC power for an electronic device, such as a laptop or a cellphone, "includ[e] circuitry for producing an analog data signal for use by the electronic device to control an amount of power drawn by the electronic device." Apple 1001 at 10:38-40. This is an important feature of the claimed invention because an adapter may have different power output capabilities depending on its structure or the AC or DC source from which it draws and converts power. The analog data signal of limitation 1(b) notifies an electronic device of the amount of power available from the adapter. That information enables the electronic device to control its power consumption from the adapter and/or charge or disable charging of its battery to ensure safe operation and avoid overheating and other malfunctions.

In section II, Comarco refutes Apple's contention that each of Allen and Breen disclose an adapter that produces an analog data signal that enables an electronic device to control an amount of power drawn by the electronic device, as required by limitation 1(b). The specifications of Allen and Breen establish that they do no such thing. The absence of any such disclosure in Allen or Breen, standing alone, compels resolution of the trial in Comarco's favor. *Par Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1194 (Fed. Cir. 2014) (Obviousness, like

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