

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

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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I. INTRODUCTION

Petitioner Apple Inc. (“Apple”) submits this reply under 37 C.F.R. § 42.23 in response to Comarco Wireless Technologies, Inc.’s (“Comarco”) Response to Petition filed on May 31, 2016. Paper No. 17 (“Resp.”). Comarco did not submit a motion to amend. The Board instituted *inter partes* review of U.S. Patent No. 8,492,933 (the “’933 Patent”) based on a reasonable likelihood that Apple would prevail in showing that all claims are obvious over the combination of U.S. Patent No. 7,243,246 to Allen, *et al.* (Apple 1003, “Allen”) U.S. Patent No. 7,296,164 to Breen *et al.* (Apple 1004, “Breen”), and U.S. Patent No. 6,054,846 to Castleman (Apple 1005, “Castleman”). Paper No. 15 (“Inst. Dec.”) at 15.

In its preliminary response, Comarco contested only whether this combination of references disclosed the final element of the ’933 Patent’s Claim 1, element 1(e), and whether one of ordinary skill in the art would have combined the references. Paper No. 13 at 10. In its Patent Owner Response, however, Comarco concedes the combination of Allen, Breen, and Castleman disclose element 1(e), and thus as to that element Comarco only continues to argue a lack of motivation to combine. In addition, Comarco now argues that the instituted grounds do not disclose Claim 1’s element 1(b), an “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.” Resp. at 15.

As shown by the evidence and argument in the petition and further discussed below, both Allen and Breen disclose element 1(b). Comarco's arguments to the contrary are based on mischaracterizations of the references and an attempt to limit the references' disclosures by improperly focusing only on certain disclosed embodiments. Furthermore, as set forth in detail in the Petition (and as recognized in the Board's Institution Decision), a person of ordinary skill in the art reviewing the teachings of Allen, Breen, and Castleman would have several reasons to combine them into the '933 Patent's claimed invention, including element 1(e). Comarco fails to rebut these reasons in any legally relevant or factually supported way, instead asserting various alleged physical incompatibilities associated with "redesigning" the references. Resp. at 24-33. But "[i]t is well established that a determination of obviousness based on teachings from multiple references does not require an actual physical substitution of elements." *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012). For these reasons and those stated in the petition and its supporting evidence, the challenged claims should be canceled as unpatentable.

II. THE COMBINATION OF ALLEN, BREEN, AND CASTLEMAN RENDERS THE CLAIMS OF THE '933 PATENT OBVIOUS

A. The Instituted Combination Teaches Limitation 1(b).

Both Allen and Breen individually (and *a fortiori* in combination) teach an "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."

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