UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google LLC
Petitioner

v.

Cywee Group Ltd.
(record) Patent Owner

IPR2018-01257
IPR2018-01258

Patent No. 8,552,978
Patent No. 8,441,438

REBUTTAL DECLARATION OF PROF. MAJID SARRAFZADEH

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I. INTRODUCTION

1. I, Majid Sarrafzadeh, declare as follows.

2. The terms of my engagement and my qualifications are as-stated in my prior declarations, which are Exhibits 1002 in the *inter partes* review proceedings with trial numbers IPR2018-01257 and IPR2018-01258.

II. OVERVIEW

3. I understand that CyWee has filed contingent motions to amend U.S. Pats. Nos. 8,552,978 ("the '978 patent") and 8,441,438 ("the '438 patent"). The motions to amend seek to add claims 19 and 20 to the '978 patent, and to add claims 20 and 21 to the '438 patent ("the Proposed Amended Claims"). I understand that CyWee seeks to add these claims to the respective patents, and if they are added, to cancel original claims 10 and 12 of the '978 patent and claims 1 and 3 of the '438 patent. The text of the claims is reproduced below, in ¶¶26-25.

4. I understand that CyWee contends that its Proposed Amended Claims are supported by the respective specifications of the '978 and '438 patents, and also by the provisional patent application, U.S. Provisional Patent Application 61/292,558, ("the '558 Provisional").

5. I am of the opinion that the Proposed Amended Claims are not supported by the '558 Provisional. I understand that this would have as a consequence that the Proposed Amended Claims are not entitled to rely on the

January 6, 2010 filing date of the '558 Provisional.

6. I am also of the opinion that proposed claim 21 for the '438 and proposed claim 20 for the '978 patent (adding the limitation to a "smartphone") are not supported by the specification of the '438 patent, including as originally filed (U.S. Application Serial Number 12/943,934) in Ex. 1009. I understand that this should mean that proposed amended claim 21 for the '438 patent would not be patentable, while proposed amended claim 20 for the '978 patent would not enjoy the benefit of the filing date of that application, but only (possibly) of later applications.

7. I am also of the opinion that proposed amended claims 19 and 20 for the '978 patent and proposed amended claim 20 for the '438 patent would be unpatentable as obvious over U.S. Patent Publication US 2010/0312468 A1 ("Withanawasam")(Ex. 1017) in view of U.S. Pat. No. 7,089,148 ("Bachmann")(Ex. 1003). Bachmann is the same reference I examined in my first declarations, Exhibits 1002 in the *inter partes* review proceedings with trial numbers IPR2018-01257 and IPR2018-01258.

III. UNDERSTANDING OF THE RELEVANT LAW

8. I have the following understanding of the applicable law:

A. Written Description

I understand that in order to satisfy the "written description" requirement, a

patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Possession of the claimed invention can be shown by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. An adequate written description of a claimed genus requires more than a generic statement of an invention's boundaries. A sufficient description of a genus instead requires the disclosure of either a representative number of species falling within the scope of the genus or structural features common to the members of the genus so that one of skill in the art can visualize or recognize the members of the genus.

B. Anticipation

9. I understand that a claim in an issued patent can be unpatentable if it is anticipated. In this case, "anticipation" means that there is a single prior art reference that discloses every element of the claim, arranged in the way required by the claim.

10. I understand that an anticipating prior art reference must disclose each of the claim elements expressly or inherently. I understand that "inherent" disclosure means that the claim element, although not expressly described by the prior art reference, must necessarily be present based on the disclosure. I understand that a mere probability that the element is present is not sufficient to qualify as

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