

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MPH TECHNOLOGIES OY,
Patent Owner.

Case IPR2019-00819
Patent 7,620,810

PETITIONER'S RESPONSIVE BRIEF POST-REMAND

TABLE OF CONTENTS

I. Introduction.....1

II. Discussion.....1

 1. Patent Owner’s disclaimer of claims 1-3 does not remove the issue of obviousness of claim 3 under the ground of Ishiyama and Murakawa *without* Ahonen from this proceeding.....2

 2. Claim 3 is obvious under Petitioner’s Ishiyama and Murakawa-based grounds (without Ahonen) in view of Petitioner’s undisputed argument and evidence and Patent Owner’s concession of its interest in claims 1-3 by disclaimer.3

III. Conclusion4

CERTIFICATE OF SERVICE.....5

I. INTRODUCTION

Patent Owner disclaimed claims 1-3 in an attempt to subvert the Board's consideration on remand of whether claims 1 and 3 are obvious over Ishiyama in view of Murakawa *without* Ahonen. However, Patent Owner's disclaimer of claims 1-3 does not remove the issue of obviousness of claims 1 and 3 under the ground of Ishiyama and Murakawa *without* Ahonen from this proceeding, because the remaining claims 4-6 depend from claim 3, which depend from claim 1.

Further, Patent Owner argued that it did not concede the unpatentability of claims 1-3 by its disclaimer, stating that “[a] statutory disclaimer **in and of itself** is not a concession of unpatentability.” PO Opening Brief, 3-4 (emphasis added). However, claims 1 and 3 are unpatentable not just **solely** based on Patent Owner's disclaimer “in and of itself,” but because they are obvious under Petitioner's Ishiyama and Murakawa-based grounds (without Ahonen), considering Petitioner's undisputed argument and evidence **and** the strong clue of unpatentability of claims 1 and 3 based on the disclaimer.

Accordingly, claims 1, 3 and, in turn, claims 4-6, are unpatentable because they are obvious under Petitioner's Ishiyama and Murakawa-based grounds (without Ahonen), supported by the strong clue of the unpatentability of claims 1-3 based on the disclaimer.

II. DISCUSSION

1. Patent Owner's disclaimer of claims 1-3 does not remove the issue of obviousness of claim 3 under the ground of Ishiyama and Murakawa *without* Ahonen from this proceeding.

Patent Owner incorrectly asserted that Petitioner's grounds of claims 4-6 are deficient due to the omission of Ahonen, and as such, its disclaimer of claims 1-3 had the effect of "leaving only the issue of Apple's deficient Petition grounds against claims 4-6" in this proceeding. PO Opening Brief, 2-3.

However, Patent Owner's disclaimer of claims 1-3 does not remove from this proceeding the issue of obviousness of claims 1 and 3 under Petitioner's ground of Ishiyama and Murakawa *without* Ahonen. On remand, the grounds before the Board are obviousness of claims 4-6 in view of Ishiyama and Murakawa *without* Ahonen, which involve the obviousness issue of claim 3 under Petitioner's ground of Ishiyama and Murakawa *without* Ahonen because each of claims 4-6 depends on claim 3, which depends from claim 1. Petitioner's grounds against claims 4-6 are not deficient due to the omission of Ahonen, because Ahonen is *neither* part of Petitioner's grounds for the claims that remain in trial, claims 4-6, *nor* is it essential thereto. As explained in detail in Petitioner's Opening Brief, Petitioner's grounds describe two theories of obviousness for claim 3—with and *without* Ahonen, and Patent Owner fails to dispute the theory that is based on the combination of Ishiyama and Murakawa without Ahonen. Petitioner's Opening

Brief, 2-3 (*citing* Reply, 19, Pet., 60, 64-66, EX1011, 6, EX1012, RFC793, 4, EX1020, ¶¶63-65, POR, 70-73).

Accordingly, because each of claims 4-6 depends on claim 3, Patent Owner's disclaimer of claims 1-3 does not remove the issue of obviousness of claims 1 and 3 under the ground of Ishiyama and Murakawa *without* Ahonen from this proceeding.

2. Claim 3 is obvious under Petitioner's Ishiyama and Murakawa-based grounds (without Ahonen) in view of Petitioner's undisputed argument and evidence and Patent Owner's concession of its interest in claims 1-3 by disclaimer.

Patent Owner argued that it did not concede the unpatentability of claims 1-3 by its disclaimer, stating that “[a] statutory disclaimer **in and of itself** is not a concession of unpatentability.” PO Opening Brief, 3-4 (emphasis added).

However, claims 1 and 3 are unpatentable not just **solely** based on Patent Owner's disclaimer “in and of itself.” In fact, claims 1 and 3 are unpatentable because they are obvious under Petitioner's Ishiyama and Murakawa-based grounds (without Ahonen), considering Petitioner's undisputed argument and evidence **and** the strong clue of unpatentability of claims 1 and 3 based on the disclaimer. While Patent Owner argued that it did not concede the unpatentability of claims 1-3 by its disclaimer, it did concede its interest in claims 1-3 by “dedicate[ing] to the public the entirety of claims 1-3 of the '810 Patent.”

EX3003, Disclaimer, 1. Such a disclaimer is a strong clue of the unpatentability of

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