

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC. & MICROSOFT CORPORATION
Petitioners

v.

Neodron, Ltd.
Patent Owner

Case Nos. IPR2020-00998; IPR2020-01000
U.S. Patent No. 8,749,251

**PETITIONERS' REASONS FOR AND RANKINGS OF PARALLEL
PETITIONS**

Petitioners Apple Inc. and Microsoft Corporation (“Petitioners”) have requested *Inter Partes* Review (“IPR”) of claims 1-20 (the “Challenged Claims”) of U.S. Patent No. 8,749,251 (“the ’251 Patent”). Petitioners have addressed the unpatentability of the Challenged Claims in two materially distinct, non-cumulative petitions uniquely positioned to address a priority dispute regarding the effective filing date of the Challenged Claims. *See* IPR2020-00998 (the “102(b) Petition”); IPR2020-01000 (the “Priority Petition”). Accordingly, Petitioners respectfully request institution of all grounds of invalidity asserted against the ’251 Patent.

I. REASONS TO INSTITUTE BOTH PETITIONS

A. The unique priority dispute justifies two petitions

The Patent Trial and Appeal Board’s Consolidated Trial Practice Guide expressly acknowledges situations at which it is appropriate to file multiple petitions against the same patent, including, as in the case here, “when there is a dispute about priority date requiring arguments under multiple prior art references.” *Office Consolidated Trial Practice Guide*, 84 Fed. Reg. 64280 (Nov. 20, 2019)¹ (“TPG”). While the TPG notes that such circumstances may be rare, the egregious facts at issue here justify institution of two petitions challenging the ’251 Patent.

As thoroughly discussed in the Priority Petition, during prosecution of the application that resulted as the ’251 Patent, applicant introduced new matter in 2011

¹ Available at <http://www.uspto.gov/TrialPracticeGuideConsolidated>.

that severed the priority chain back to its July 26, 2007 provisional or to its July 25, 2008 utility application in an attempt to circumvent its own prior art. More specifically, applicant added the concept of triggering a time duration from a “key touch on the touch screen.” With this new matter, applicant sought to distinguish its own prior art—used to reject all proposed claims in the parent patent’s prosecution—that taught time durations triggered from touching a standard on/off capacitive sensor. Because the pre-2011 intrinsic record disclosed only standard on/off capacitive sensors, inserting the concept of “touch screens” is “new matter” and the Challenged Claims are not entitled to claim priority to any pre-2011 applications. The Priority Petition demonstrates the Challenged Claims’ earliest effective filing date is May 26, 2011 and presents a proposed ground of invalidity on this basis.

B. The petitions present materially distinct, non-cumulative grounds

The 102(b) and Priority Petitions rely on completely distinct prior art combinations asserted to address different effective filing dates for the Challenged Claims. The 102(b) Petition relies on five different prior art references—all of which pre-date the ’251 Patent’s provisional filing date by more than one-year—to support five separate proposed grounds of invalidity. All five grounds are viable regardless of whether the Challenged Claims are entitled a pre-2011 effective filing date. The Priority Petition, on the other hand, presents only one ground of obviousness based on the ’251 Patent’s own parent patent publication and assumes an effective filing

date of May 26, 2011. While one common reference, QT60161, is used in both petitions, the Priority Petition relies on QT60161 solely for its touch screen teaching—a materially different reliance than the 102(b) Petition, which demonstrates QT60161 renders obvious all limitations in 15 claims. These material differences justify institution of both the 102(b) and the Priority Petitions. *10X Genomics, Inc. v. Bio-Rad Laboratories, Inc.*, IPR2020-00088, Paper 8, at *46-47 (PTAB April 27, 2020) (granting institution of two parallel petitions, explaining that a priority fight concerning swear-behind dates for prior art references justifies concurrent filings with no stipulation by Patent Owner).

II. RANKINGS OF THE PETITIONS

<u>Rank</u>	<u>Petition</u>	<u>Prior Art Grounds</u>	<u>Challenged Claims</u>
1	IPR2020-00998	Obviousness based on: (1) Koziuk; (2) Koziuk in view of Kalendra; (3) Koziuk in view of QT110; (4) Koziuk in view of Bruwer; (5) QT60161	1-20
2	IPR2020-01000	Obviousness based on: (1) The '068 Publication in view of QT60161	1-20

Petitioners rank the 102(b) Petition higher than the Priority Petition because it is unclear what arguments and evidence Patent Owner may rely upon to dispute the Priority Petition's premise that new matter was added in 2011. Instituting at least the 102(b) Petition ensures the validity of the Challenged Claims is assessed

regardless of the outcome of this priority issue. Were the Priority Petition alone instituted, the Challenged Claims may avoid a prior art review entirely if Patent Owner were to successfully rebut the “new matter” argument.

Petitioners do insist, however, that instituting both petitions is the fairest outcome. Petitioners have intentionally streamlined the Priority Petition—far below the permitted length—in order to limit the additional effort required of the parties and the Board to resolve the priority issue. Petitioners have also relied entirely on prior art in the Priority Petition that is attributable to the Patent Owner, removing the burden that might otherwise be imposed to analyze unfamiliar prior art. Accordingly, Patent Owner should not be permitted to avoid reckoning with its improper addition of “new matter” in 2011 on the basis of an undue burden imposed by a second petition.

Respectfully submitted,

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