

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

ALIVECOR, INC.,
Patent Owner.

Case IPR2021-00972
Patent 10,638,941

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. THE ‘941 PATENT	4
A. Overview	4
B. Background	4
C. Specification	6
D. Prosecution History	7
III. LEVEL OF ORDINARY SKILL IN THE ART	8
IV. THE ASSERTED PRIOR ART	12
A. Shmueli.....	12
B. Osorio	13
C. Lee-2013.....	15
D. Chan.....	15
V. THE BOARD SHOULD EXERCISE ITS DISCRETION AND DENY INSTITUTION UNDER 35 U.S.C. § 314(a).....	15
A. The ITC Will Not Stay The Investigation If IPR Is Instituted.....	16
B. The ITC’s Investigation Will Conclude Before The Board’s Final Written Decision	18
C. Significant Resources Will Be Invested In The ITC Investigation Before The Board Issues An Institution Decision	19
D. The Invalidity Issues Raised In The Petition Substantially Overlap With The ITC Investigation	22
E. The Parties Are Identical In The Parallel ITC Proceedings.....	26

F.	Other Considerations Also Weigh In Favor Of The Board Exercising Its Discretion To Deny Institution	27
VI.	APPLE FAILS TO SHOW A REASONABLE LIKELIHOOD THAT IT WILL PREVAIL WITH RESPECT TO AT LEAST ONE OF THE CHALLENGED CLAIMS	30
A.	The Asserted Motivation To Combine Shmueli and Osorio Is Conclusory, Unsupported, and Based On Impermissible Hindsight	31
B.	The Shmueli-Osorio Combination Does Not Disclose Key Elements Of The Independent Claims	40
C.	Lee-2013 and Chan Do Not Cure The Deficiencies Of Shmueli And Osorio	41
VII.	CONCLUSION.....	42

Table of Authorities

Page(s)

Cases

<i>3Shape A/S et al. v. Align Technology, Inc.</i> , IPR2020-00223, Paper 12 (May 26, 2020)	19
<i>ActiveVideo Networks, Inc. v. Verizon Commc'n, Inc.</i> , 694 F.3d. 1312 (Fed. Cir. 2012)	36
<i>Alivecor, Inc. v. Apple, Inc.</i> , Case No. 4:21-cv-03958-JSW (N.D. Cal.)	27
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (March 20, 2020)	2, 16-22, 26, 27, 29, 30
<i>Arctic Cat Inc. v. Polaris Industries, Inc.</i> , 795 Fed. Appx. 827 (Fed. Cir. 2019)	35
<i>Avant Tech, Inc. v. Anza Tech., Inc.</i> , IPR2018-00828, Paper 7 (Oct. 16, 2018)	37, 38
<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	36
<i>Canadian Solar Inc. v. The Solaria Corporation</i> , IPR2021-00095, Paper 12 (May 26, 2021)	18
<i>Certain Automated Storage and Retrieval Systems, Robots, and Components Thereof</i> , Order No. 6 (337-TA-1228)	16, 17
<i>Certain Wearable Electronic Devices with ECG Functionality and Components Thereof</i> , Inv. No. 337-TA-1266, Order No. 6 Setting Procedural Schedule (June 25, 2021)	19, 20, 21
<i>Cisco v. Ramot at Tel Aviv University</i> , IPR2020-00122, Paper 15 (May 15, 2020)	26
<i>DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.</i> , 567 F.3d 1314 (Fed. Cir. 2009)	34

<i>Eli Lilly and Company v. Zenith Goldline Pharmaceuticals, Inc.</i> , 471 F.3d 1369 (Fed. Cir. 2006)	31
<i>Facebook v. USC IP Partnership</i> , IPR2021-00033, Paper, 13 (April 30, 2021)	24, 25
<i>Free-Flow Packaging Int'l v. Automated Packaging Systems, Inc.</i> , IPR2016-00350, Paper 7 at 14 (Jun. 27, 2016)	35
<i>Honda Motor Co., Ltd. v. Blitzsafe Texas, LLC</i> , IPR2016-01473, Paper 9 at 16 (Jan.24, 2017)	36
<i>HVLPO2, LLC v. Oxygen Frog, LLC</i> , 949 F.3d 685 (Fed. Cir. 2020)	11
<i>In re Deters</i> , 515 F.2d 1152 (CCPA 1975).....	11
<i>In re Fritch</i> , 972 F.2d 1260 (Fed. Cir. 1992)	39
<i>In re Giannelli</i> , 739 F.3d 1375 (Fed. Cir. 2014)	24, 36
<i>In re Kahn</i> , 441 F.3d 977 (Fed. Cir. 2006)	35
<i>Kiosoft Techs., LLC v. Payrange, Inc.</i> , No. IPR2021-00086, Paper 12 (Mar. 22, 2021)	29
<i>In re Nuvasive, Inc.</i> , 842 F.3d 1376 (Fed. Cir. 2016)	36
<i>Intel Corp. v. Hera Wireless S.A.</i> , IPR2018-01686, Paper No. 10 (Nov. 8, 2019).....	11, 17
<i>InTouch Techs., Inc. v. VGO Commc'ns, Inc.</i> , 751 F.3d 1327 (Fed. Cir. 2014)	36, 39
<i>Nautilus Hyosung Inc. v. Diebold, Inc.</i> , IPR2016-00633, Paper 9 (Aug. 22, 2016).....	38

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.