

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOMENTUM DYNAMICS CORPORATION,
Petitioner

v.

WITRICITY CORPORATION,
Patent Owner

Case No. IPR2021-01166
Patent No. 8,304,935

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I. INTRODUCTION1

II. CLAIM CONSTRUCTION1

III. STANDARD FOR GRANTING *INTER PARTES* REVIEW2

IV. THE PETITION FAILS TO DEMONSTRATE A REASONABLE
LIKELIHOOD THAT ANY CLAIM OF THE '935 PATENT IS
UNPATENTABLE.....3

 A. Ground 1 fails to show that O'Brien discloses a source resonator and a
 second resonator coupled to provide near-field wireless energy transfer 3

 B. Ground 2 incorporates the flawed reasoning of Ground 1 by reference,
 and thus fails for the same reasons7

V. CONCLUSION.....7

I. INTRODUCTION

WiTricity Corporation (“Patent Owner”) submits this Preliminary Response to the Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 8,304,935 (the “’935 patent”) filed by Momentum Dynamics Corporation (“Petitioner”). For at least the reasons described herein, the Petition fails to demonstrate a reasonable likelihood that any claim of the ’935 patent is unpatentable, and thus should be denied.

II. CLAIM CONSTRUCTION

All claim terms in this proceeding are to be construed according to the *Phillips* standard. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); 37 C.F.R. §42.100. No claim construction is necessary to deny institution. Patent Owner’s arguments for denial do not hinge on the outcome of an actual controversy about any claim construction expressed in the Petition. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed to the extent necessary to resolve the controversy.”). As detailed below, the defects in the Petition are readily identifiable without defining any specific claim term.¹

¹ Patent Owner reserves the right to make claim construction arguments in other proceedings.

III. STANDARD FOR GRANTING *INTER PARTES* REVIEW

The Board may grant a petition for *inter partes* review only where “the information presented in the petition ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. §314(a); 37 C.F.R. §42.108(c). Petitioners bear the burden of showing that this statutory threshold has been met. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,756 (Aug. 14, 2012). Critically, Petitioners must fulfill this burden based on “information presented in the petition” (35 U.S.C. §314(a)), and the law forbids Petitioners from subsequently adding theories/arguments that should have been part of their initial Petition. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (citing to 35 U.S.C. § 312) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’”); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2154 (2016) (Alito, J. concurring in part and dissenting in part) (“Thus, if a petition fails to state its challenge with particularity—or if the Patent Office institutes review on claims or grounds not raised in the petition—the patent owner is forced to shoot into the dark. The potential for unfairness is obvious.”).

**IV. THE PETITION FAILS TO DEMONSTRATE A REASONABLE
LIKELIHOOD THAT ANY CLAIM OF THE '935 PATENT IS
UNPATENTABLE**

**A. Ground 1 fails to show that O'Brien discloses a source resonator
and a second resonator coupled to provide near-field wireless
energy transfer**

Ground 1 of the Petition alleges that claims 1, 5-8, 15, and 19-22 are anticipated by O'Brien. As explained below, the Ground fails because Petitioner points to disclosure of multiple separate components in O'Brien to address each of the source resonator and second resonator recited in the independent claims. This is clearly improper in an anticipation context, and thus, as explained below, Ground 1 must fail.

Independent claims 1 and 15 of the '935 patent recite “a source resonator” and “a second resonator located a distance from the source resonator.” '935 patent, claims 1, 15. In Ground 1 (anticipation over O'Brien), the Petition argues that “O'Brien's system includes a '*Tunable Resonant Circuit*' on the 'Source Side'” (or “source side resonant circuit”) that corresponds to the claimed '*source resonator.*'” Petition, 17.² The Petition further argues that O'Brien's system “includes a '*Resonant Circuit*' on the '*Receiver Side*'” (or “receiver side resonant circuit”) “that...corresponds to the claimed '*second resonator.*'” Petition, 20. The

² All emphasis added unless otherwise indicated.

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.