

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**PATENT TRIAL AND APPEAL BOARD**

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APPLE INC.,  
Petitioner,

v.

CPC PATENT TECHNOLOGIES PTY, LTD.,  
Patent Owner.

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Case IPR2022-00601  
U.S. Patent No. 9,269,208

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**PRELIMINARY PATENT OWNER'S RESPONSE**

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**EXHIBIT LISTING**

<b>Exhibit</b>	<b>Description</b>
2001	Scheduling Order, <i>CPC Patent Technologies Pty Ltd. v. HMD Global Oy</i> , 6:21-cv-00166 (Dkt. 27) (Sept. 23, 2021)
2002	HMD Global Oy's Final Invalidity Contentions, Chart B15 - Mathiassen, dated March 16, 2022
2003	Defendant Apple Inc.'s Notice of Motion and Motion to Stay Pending <i>Inter Partes</i> Review, 5:22-cv-02553 (Dkt. 119) (June 14, 2022)
2004	Scheduling Order, <i>CPC Patent Technologies Pty Ltd. v. Apple Inc.</i> , 6:21-cv-00165 (Dkt. 37) (Sept. 23, 2021)
2005	March 19, 2020 Letter from George Summerfield to Brian Ankenbrandt

## I. INTRODUCTION

Patent Owner, CPC Patent Technologies (“CPC” or “Patent Owner”), submits this Patent Owner Preliminary Response (“POPR”) pursuant to 37 C.F.R. § 42.107(a) to the *Inter Partes* Review (“IPR”) petition (“Petition”) filed by Petitioner Apple Inc. (“Apple” or “Petitioner”) for Claims 1, 3-7, 9-11, and 13 (“Challenged Claims”) of U.S. Patent No. 9,269,208 (“the ’208 Patent,” Ex. 1001).

The instant Petition presents a novel, but nonetheless compelling, set of circumstances as it concerns the *Fintiv* factors for discretionary denial of institution. Apple filed its Petition while the ’208 Patent was also the subject of a pending district court action between the parties (“the Apple Litigation”).<sup>1</sup> *See* Paper No. 1 at 72. In the *interim*, Patent Owner, CPC Patent Technologies Pty, Ltd. (“CPC”), dismissed its infringement claim for the ’208 Patent in the district court action. However, CPC maintains its infringement claim for U.S. Patent No. 9,665,705 (“the ’705 Patent”)

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<sup>1</sup> Apple succeeded in having the Apple Litigation, originally filed in the Western District of Texas (*CPC Patent Technologies Pty Ltd. v. Apple Inc.*, No. 6:21-cv-00165 (W.D. Tex.)), transferred to the Northern District of California. *In re Apple Inc.*, No. 2022-128, 2022 WL 1196768 (Fed. Cir. Apr. 22, 2022). The case is now styled *CPC Patent Technologies Pty Ltd. v. Apple Inc.*, No. 5:22-cv-02553 (N.D. Cal.).

– a patent that is separately the subject of IPR2022-00602, and which is related to the '208 Patent. *See id.*

Specifically, as explained herein, the challenged claim of both the '208 and '705 Patents all contain the limitation “at least one of the number of said [biometric signal] entries and a duration of each said entry” (“the Duration Limitation”), and Apple relies upon the same prior art combination in the same way as purportedly satisfying that limitation as to both challenged patents. *Compare* Paper No. 1 at 3 and *Apple Inc. v. CPC Patent Technologies Pty, Ltd.*, IPR2022-00602, Paper 1 at 3 (PTAB Feb. 23, 2022).

Furthermore, in a co-pending matter styled *CPC Patent Technologies Pty Ltd. v. HMD Global Oy*, No. 6:21-cv-00166 (W.D. Tex.) (“the HMD Litigation”),<sup>2</sup> defendant HMD Global Oy (“HMD”), as part of its invalidity defenses, cites the same prior art combination as allegedly teaching the Duration Limitation in the '705 Patent. Ex. 2002 at 63-64. That case is scheduled for trial in January 2023. Ex. 2001 at 5. Thus, whether that same prior art combination in fact teaches that limitation will be litigated in district court nine months *before* the Final Written Decision would be scheduled to issue in this proceeding in the event of institution. These circumstances warrant discretionary denial of institution.

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<sup>2</sup> Apple identifies the HMD Litigation as a Related Matter. Paper No. 1 at 72.

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