UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CPC PATENT TECHNOLOGIES PTY, LTD.,
Patent Owner.

Case IPR2022-00602
U.S. Patent No. 9,665,705

PRELIMINARY PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

EXHIBIT LISTING

Exhibit	Description
2001	Scheduling Order, *CPC Patent Technologies Pty Ltd. v. HMD Global Oy*, 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	Apple Inc.'s Final Invalidity Contentions, dated March 16, 2022
2004	Scheduling Order, *CPC Patent Technologies Pty Ltd. v. Apple Inc.*, 6:21-cv-00165 (Dkt. 37) (Sept. 23, 2021)
2005	March 19, 2020 Letter from George Summerfield to Brian Ankenbrandt
2006	Defendant Apple Inc.'s Notice of Motion and Motion to Stay Pending *Inter Partes* Review, 5:22-cv-02553 (Dkt. 119) (June 14, 2022)
2007	HMD Global Oy's Final Invalidity Contentions, dated March 16, 2022

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, 4, 6, 10-12, and 14-17 ("Challenged Claims") of U.S. Patent No. 9,665,705 ("the '705 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 '705 Patent was also the subject of a pending district court action between the parties ("the Apple Litigation").[1] *See* Paper No. 1 at 62.

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"),[2]

[1] 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.).

[2] Apple identifies the HMD Litigation as a Related Matter. Paper No. 1 at 62.

defendant HMD Global Oy ("HMD"), as part of its invalidity defenses, cites the same prior art combination as allegedly teaching the limitation "at least one of the number of said [biometric signal] entries and a duration of each said entry" ("the Duration Limitation") in the challenged claims of 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.

Apple recognizes the problems it faces in light of the Board's decisions regarding discretionary denial in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019 ("*Fintiv*"). In fact, after presenting a lukewarm analysis of the six *Fintiv* factors, Apple ultimately resorts to arguing that the analytical framework under *Fintiv*, as explained in informational (Paper 15) and precedential (Paper 11) opinions of this Board, should be overruled. *See* Paper No. 1 at 59-60. Of course, Apple is wrong and not a single *Fintiv* factor weighs in favor of institution, as explained herein. The case for discretionary denial of the instant Petition is so clear that Patent Owner has determined not to burden the Board with a full discussion of the merits of the Petition

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