IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Burnett
U.S. Patent No.:	8,280,072
Issue Date:	October 2, 2012
Appl. Serial No.:	12/163,617
Filing Date:	June 27, 2008
Title:	MICROPHONE ARRAY WITH REAR VENTING

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,280,072

Petitioner Apple Inc. ("Apple") is filing two petitions (IPR2022-01243 and IPR2022-01244) challenging U.S. Patent No. 8,280,072 (the "'072 Patent"). Pursuant to the Board's July 2019 Trial Practice Guide Update, Apple submits this paper to "identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits…, and (2) a succinct explanation of the differences between the Petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions."

I. Ranking of Petitions

Although Apple believes that both Petitions are meritorious and justified, Apple requests that the Board consider the Petitions in the following order:

Rank	Petition	Primary References
1	IPR2022-01243	Zhang, Arndt
2	IPR2022-01244	Ikeda, Sasaki

II. Differences that Compel Permitting Multiple Petitions

A. *Priority Date and Distinct Prior Art*

Petition 1 (IPR2022-01243) challenges the priority date of the '072 Patent. Although the '072 Patent was filed as a continuation-in-part application, the '072 Patent should not be eligible to claim priority to the earlier-filed U.S. App. Nos. 11/805,987 (filed May 25, 2007), 10/667,207 (filed Sep. 18, 2003), and 10/400,282 (filed Mar. 27, 2003) in its family because the claims that ultimately issued in the '072 Patent do not have written description support in any of these earlier

applications. Instead, as explained in Petition 1, the '072 Patent is entitled only to the later filing date (Jun. 27, 2007) of U.S. Provisional App. No. 60/937,603, and, as such, the earliest effective filing date of the '072 Patent is Jun. 27, 2007. Accordingly, Petition 1 relies on primary references that post-date the earlier US application filing dates, but pre-date the earliest effective filing date. In contrast, Petition 2 (IPR2022-01244) does not challenge the priority date of the '072 Patent and relies on references that pre-date the earlier US application filing dates.

Specifically, Petition 1 relies on (i) U.S. Patent App. Pub. 2008/0170716 ("Zhang") under §§ 102 (Grounds 1A, 2A) and 103 (Grounds 1B, 2B); and (ii) U.S. Patent App. Pub. 2005/0041824 ("Arndt") under §§ 102 (Grounds 3A, 4A) and 103 (Grounds 3B, 4B). Zhang was filed on Jan. 11, 2007, and published on Jul. 17, 2008, while Arndt was filed on Jul. 16, 2004, and published on Feb. 24, 2005. Accordingly, based on the Jun. 27, 2007, filing date of the priority provisional application, Zhang qualifies as prior art under pre-AIA 35 U.S.C. § 102(e) while Arndt qualifies as prior art under pre-AIA 35 U.S.C. § 102(b). However, each of Zhang and Arndt post-dates the filing dates of at least the earlier-filed US Applications 10/667,207 (Sep. 18, 2003) and 10/400,282 (Mar. 27, 2003).

In contrast, Petition 2 relies on (i) Japanese Patent App. Pub. No. H11-18186A ("Ikeda") under §§ 102 and 103 (Grounds 1, 2) and (ii) U.S. Patent 5,471,538 ("Sasaki") and U.S. Patent 5,526,430 ("Ono") in combination under §

103. Ikeda published on Jan. 22, 1999, while Sasaki and Ono issued respectively on Nov. 28, 1995, and Jun. 11, 1996. Accordingly, each of Ikeda, Sasaki, and Ono qualifies as prior art under pre-AIA 35 U.S.C. § 102(b) based on the Jun. 27, 2007, filing date of the priority provisional application, as well as the earlier-filed applications in the '072 Patent family.

Although Patent Owner did not dispute the priority arguments raised in Petition 1 prior to institution, Patent Owner could raise priority arguments post-institution and the assessment of priority is necessary for the Zhang and Arndt references to be considered prior art. Because the decision on whether the '072 Patent is eligible to claim priority to the earlier-filed US Applications in its family will necessarily continue through final written decision, institution of both petitions is necessary to ensure Apple's prior art grounds are properly considered through final written decision.

Thus, the present circumstance is consistent with the example in the July 2019 Trial Practice Guide Update (pg. 26), where "the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, … when there is a dispute about priority date requiring arguments under multiple prior art references." Here, Apple disputes the priority date of the '072 Patent in Petition 1. But in the event that the Board finds that the '072 Patent is entitled to its earliest claimed priority date and the references in

Petition 1 are found deficient as a consequence, Petition 2 provides arguments under prior art references that pre-date that priority date.

For the reasons above, the Board should exercise its discretion to institute both Petitions. Both Petitions are necessary to show the breadth of prior art that reads on the overly broad claims of the '072 Patent. The Petitions are not redundant, duplicative, or substantially similar. Moreover, each Petition provides a strong showing of unpatentability (s*ee Samsung Electronics Co., Ltd. v. Seven Networks, LLC,* IPR2018-01106, Paper 21, 30-41 (PTAB Nov. 28, 2018); *Samsung Electronics Co., Ltd. v. Seven Networks, LLC,* IPR2018-01108, Paper 22, 36-49 (PTAB Nov. 28, 2018)), relying on entirely different references without repeating the same theory or points. Instituting on only one Petition would give Patent Owner an unfair advantage, allowing Patent Owner to strategically attempt to distinguish its claims over the instituted prior art even if those same arguments would effectively show invalidity over the non-instituted prior art.

Moreover, this is not a situation where Apple has filed many IPR petitions against one patent or is asserting dozens of independent grounds. Rather, Apple has filed only two petitions, each based on a limited number of references for the challenged claims and each as a copycat of a prior-filed petition. With these facts, granting of Apple's two petitions would not increase the complexity of the proceedings already before the Board and, instead, would lead to efficient

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