

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Ren et al.
U.S. Patent No.: 7,749,641
Issue Date: July 6, 2010
Appl. Serial No.: 10/491,134
Filing Date: May 6, 2004
Title: SECONDARY LITHIUM ION CELL OR BATTERY, AND
PROTECTING CIRCUIT, ELECTRONIC DEVICE, AND
CHARGING DEVICE OF THE SAME

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**PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 7,749,641**

Apple previously filed a petition in IPR2023-01350 (“Apple’s Petition”) challenging claims of U.S. Patent No. 7,749,641 (“the ’641 Patent”). The Board has yet to render an institution decision based on Apple’s Petition. Apple now files an additional petition in IPR2024-00597 (“Joinder Petition”) challenging claims of the ’641 Patent with a motion for joinder to Samsung’s IPR2023-01183 proceeding (“the Samsung Proceeding”), which was instituted on January 22, 2024. Pursuant to the November 2019 Consolidated Trial Practice Guide (“CTPG”), this paper provides: “(1) a ranking of the petitions in the order in which [Petitioner] wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, 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.” CTPG, 59-61.

I. Ranking of Petitions

The merits of both Apple’s Petition and the Joinder Petition are particularly strong. Specifically, as demonstrated in Apple’s Petition with reference to Mr. Hruska’s testimony and additional evidence, institution would result in invalidation of claims 5-14 of the ’641 Patent. Moreover, as demonstrated in the Joinder Petition with reference to Mr. Juzkow’s testimony and additional evidence, institution would result in invalidation of all claims 1-18 of the ’641 Patent.

Indeed, the Joinder Petition is substantially the same as the petition filed in the already-instituted Samsung Proceeding.

As explained below, Apple believes that both petitions are meritorious and justified, and respectfully requests institution of both Apple's Petition and the Joinder Petition. Nevertheless, to the extent required by the Trial Practice Guide, Apple requests that the Board prioritize institution of Apple's Petition over consideration of the Joinder Petition.

II. Material Differences Between the Petitions Compel Institution of Multiple Petitions

Apple submits that institution of both Apple's Petition and the Joinder Petition also is warranted due to the different grounds and different sets of claims challenged in the two petitions.

Apple's Petition and the Joinder Petition each demonstrate the obviousness of claims of the '641 Patent, but they do so on the basis of different combinations of references that address the respectively challenged claims in materially different ways. At bottom, the petitions are non-redundant in their reliance on these different combinations of references.

The grounds of rejection set forth in Apple's Petition feature two distinct combinations of references: Yamaki-Sakamoto and Yasunami-Koyama. Each of these primary references (*i.e.*, Yamaki and Yasunami) describes a battery having a charge cut-off voltage that is above 4.2 V. Moreover, as explained at length in the

petition, a POSITA would have found it obvious to modify a battery such as that of either primary reference to incorporate positive and negative electrode materials within the claimed range of ratios, as taught by the secondary references, Sakamoto and Koyama.

In contrast, the grounds of rejection set forth in the Joinder Petition raise different issues and rely on different prior art. For instance, the Joinder Petition asserts unpatentability of the claims over each of two single references, Uemura and Abe, each of which discloses, or otherwise renders obvious, all of the features of at least the independent claims of the '641 Patent, including both the recited charge cut-off voltage range and the claimed range of positive and negative electrode material ratios.

Moreover, Apple's Petition and the Joinder Petition challenge different sets of claims. Apple's Petition challenges claims 5-14 of the '641 Patent while the Joinder Petition challenges claims 1-18.

III. Institution of Both Petitions Would Not Impose Extraordinary Burden

The Joinder Petition is substantively the same as the petition filed in the Samsung Proceeding ("the Samsung Petition"): it challenges the same claims, on the same grounds, and relies on the same prior art as the Samsung Petition. The Samsung Petition has been instituted. Institution of the Joinder Petition (along with grant of Apple's Motion for Joinder) would create no additional burden for

the Board, the Samsung Proceeding Petitioner, or Patent Owner if joined.

Specifically, the present Joinder Petition introduces no new substantive issues relative to the Samsung Proceeding, and institution of the Joinder Petition (along with grant of Apple's Motion for Joinder) would not impact the trial schedule of the Samsung Proceeding.

IV. CONCLUSION

For at least these reasons, Apple respectfully submits that efficiency and integrity of the system as whole would be best served by instituting Apple's Petition, and requests that the Board prioritize institution of Apple's Petition. However, if the Board were to deny institution of Apple's Petition, Apple alternatively requests that the Board institute review of IPR2024-00597 and grant Apple's motion to join Samsung's already-instituted IPR2023-01183 proceeding.

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