

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Pepin et al.
U.S. Patent No.: 8,093,767
Issue Date: January 10, 2012
Appl. Serial No.: 12/782,697
Filing Date: May 18, 2010
Title: LINEAR-RESONANT VIBRATION MODULE

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PETITIONER'S NOTICE RANKING AND EXPLAINING
MATERIAL DIFFERENCES BETWEEN PETITIONS FOR *INTER*
***PARTES* REVIEW OF U.S. PATENT**
NO. 8,093,767

Petitioner is filing two concurrent Petitions challenging the validity of all claims of U.S. Patent No. 8,093,767 (“the ’767 patent”). Pursuant to the Board’s July 2019 Trial Practice Guide Update, Petitioner 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 Petitioner believes that both Petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions in the following order:

| Rank | Petition | Primary Reference | Claims |
|-------------|----------------------|--------------------------|---------------|
| 1 | IPR2024-00697 | Shahoian | 1-5 |
| 2 | IPR2024-00698 | Izumi | 1-5 |

II. Factors Supporting Institution, Including Material Differences

Material differences exist between the petitions, which are non-redundant at least in their reliance on different combinations of references that demonstrate the obviousness of the Challenged Claims in materially different ways.

For example, **IPR2024-00697** relies on Shahoian as a primary reference, and asserts grounds presenting Shahoian in combinations with each of Cosper, Rossi, Ramsay, and Aldrich. Shahoian describes a haptic “force feedback interface

device” having a “linear actuator” that includes a moving magnet. APPLE-1004, Abstract; 2:1-3:2; 3:9-10; 3:21-5:39; 6:3-7:63. Notably, the Examiner failed to apply prior art references describing linear actuator modules in “haptic” feedback applications, introducing material error by overlooking this body of art. Shahoian describes features of independent claim 1, and combines with other references that describe conventional feedback control techniques and conventional circuit components in similar systems.

In contrast, **IPR2024-00698** relies on Izumi as a primary reference, and asserts grounds presenting Izumi in combinations with each of Cosper, Rossi, Ibuki, and Aldrich. Izumi describes a driving unit that drives a linear actuator resonance system that can be used in a handheld (shaver) device. APPLE-1005, Abstract, [0007]. Ibuki likewise describes a handheld (shaver) device, including user input switches to select between modes having different oscillating output.

While both the Shahoian and Izumi grounds disclose each element of the challenged claims, these distinct primary references disclose the claimed features, and combine with secondary references, in materially different ways. Compare APPLE-1004, 3:21-5:39, *with* APPLE-1005, [0007]-[0009]. The motivations to combine the distinct sets of references presented in the two petitions materially differ, with the Shahoian combinations focused on considerations related to Shahoian’s “haptic” application, and the Izumi combinations focused on

considerations related to Izumi’s shaver application. The petitions are not redundant, duplicative, or substantially similar. Rather, each petition compellingly demonstrates the unpatentability of the Challenged Claims, without repeating the same theory. The ability to completely address the Challenged Claims with meaningfully different references highlights the overbreadth of the Challenged Claims and the appropriateness of two petitions.

In view of the material differences shown 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.

To be clear, this is not a situation in which all challenges should reasonably be included in a single petition. Both petitions challenge five claims which include means-plus-function limitations that involve numerous features in the specification. The Board has found means-plus-function issues to be a compelling justification for two petitions, including in scenarios where considerably fewer than 20 claims are challenged. *E.g., DJI Europe BV v. Daedulus Blue LLC.*, IPR2020-01474, Paper 14 (PTAB Feb. 12, 2021) (involving 12 challenged claims and many means-plus-function terms). Here, the means-plus-function terms (particularly “control component”) involve detailed limitations according to the corresponding structure in the specification. Appropriately addressing these terms necessitates additional analysis amounting to roughly 5000 words.

Additionally, given the overlap in the analysis of the '767 petition and the construction of the Challenged Claims, consideration of a second petition does not present undue burden on the Board or Patent Owner, and two petitions facilitates clarity in the presentation of the issues. Moreover, Petitioner has purposefully used Rossi and Aldrich secondary references for common elements in the two petitions, streamlining review by the Board and Patent Owner.

Finally, each Petition provides a strong showing of unpatentability. 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. Indeed, the overbreadth of the claims is highlighted by the compelling showing of unpatentability based on different types of device applications (e.g., Shahoian's module described in the context of a "haptic" system vs. Izumi's module described in the context of a shaver device). Institution of both IPR petitions would prevent the unjust result of otherwise strong invalidity grounds being dismissed for procedural reasons. Any burden is a product of Patent Owner's decisions and not something that should benefit them, which would amount to discretionary denial. In addition, Petitioner requests consolidation of the two proceedings, as permitted by 35 U.S.C. §§ 315(d) and 325(d) to simplify the complexity of the proceedings.

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