IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Elenga et al.	
U.S. Patent No.:	9,941,830	Attorney Docket No. 50095-0179IP1
Issue Date:	April 10, 2018	
Appl. Serial No.:	15/181,249	
Filing Date:	June 13, 2016	
Title:	LINEAR VIBRATION MODULES AND LINEAR-RESONANT VIBRATION MODULES	

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PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,941,830

Petitioner is filing two petitions challenging U.S. Patent No. 9,941,830 ("the '830 patent"), one relying on Gregorio as the primary reference (IPR2024-00806; 50095-0179IP1) and one relying on Wakuda as the primary reference (IPR2024-00808; 50095-0179IP2).

I. Ranking of Petitions

Although both Petitions are meritorious and justified as required, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Petition	Primary Reference	Claims
1	IPR2024-00806	Gregorio	1-8, 14-17, 19, 20
2	IPR2024-00808	Wakuda	1-8, 14-17, 19, 20

II. Material Differences that Compel Permitting Multiple Petitions

The Board has recognized "that there may be circumstances in which more than one petition may be necessary." Consolidated Trial Practice Guide November 2019 (TPG), 59. One of the examples provided by the Board for justifying the institution of multiple petitions is a "dispute about priority date." *Id.* In these proceedings, the priority date accorded to the '083 patent is potentially in dispute. As background, the '830 patent includes a priority claim to a provisional application filed on May 18, 2009, and no other claim had been made during prosecution. *See generally* APPLE-1002. Therefore, the Petition has applied references that predate this alleged priority date. Pet., 2.

Despite the clear prosecution history of no priority date dispute, Patent Owner alleges that the prior date of the '830 patent is "***at least as early as*** May 18, 2009" in co-pending litigation. APPLE-1044, 2 (Resonant Systems Preliminary Infringement Contentions) (emphasis added). While failing to identify the earliest priority date, Patent Owner has reserved the right to change its claim, and nothing prevents Patent Owner from alleging its baseless contention of a priority date earlier than May 18, 2009 in this forum. For these reasons, the priority date is in sufficient dispute to justify institution of two petitions against the '830 patent.

Here, two Petitions challenging the '830 patent are based on materially different primary references—Gregorio and Wakuda—with different dates. Specifically, Petition 1 applies Gregorio as a base reference that qualifies as prior art under Pre-AIA §102(e). Gregorio was filed December 16, 2008, less than five (5) months before the May 18, 2009 priority date of the '830 patent, and therefore can be subject to different legal standards and potential defenses including swear-behind. Petition 2 applies Wakuda as a base reference that qualifies as prior art under Pre-AIA §102(b) and thus cannot be sworn behind. Therefore, in the event that Patent Owner attempts to rely on an earlier date (particularly before Gregorio's filing date of December 16, 2008, as discussed below), Petition 2 provides arguments based on prior art references that predate such an earlier date.

In light of these important legal differences and attendant options for Patent Owner defenses (which do not need to be employed until after institution), and, as a matter of policy, Petitioner should not be denied an opportunity to have considered by the PTAB the best available prior art on various applicable legal standards, when applicable, as here. Indeed, both the Gregorio-based grounds and the Wakuda-based grounds fully provide all elements of the challenged claims with different strengths. In particular, Gregorio offers additional details that may be helpful to inform an inquiry on patentability. For example, Gregorio provides a detailed disclosure of closed-loop control based on sensor signals, which read squarely on features in claims 2-6 of the '830 patent. *E.g.,* APPLE-1004, 3:65-6:4. In contrast, Wakuda provides details of a physical structure of the vibration module that are similar to the '830 patent's disclosure. *E.g.*, APPLE-1005, 4:27-6:62.

Petitioner should not be forced to forego Gregorio's detailed disclosure due to the above described concerns of a swear-behind defense possibility. Imposing such a requirement on petitioners would be contrary to Congressional intent, as it would prevent strong prior art from being raised before the Patent Office for fear of petitions being denied due to non-merit issues, severely limiting the ability of the public to ensure that deficient patents are not allowed to remain enforceable.

In view of the above material differences between two petitions, the Board should exercise its discretion to institute both Petitions. The Petitions are not

redundant, duplicative, or substantially similar, and this is not a situation in which it would be reasonable to include all challenges in a single petition, as both Petitions challenges fourteen claims under two different claim interpretations (plain-and-ordinary meaning and means-plus-function interpretations). Moreover, each Petition provides a strong showing of unpatentability with a different primary reference—Gregorio or Wakuda. 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.

III. Institution of Both Petitions Would Not Be an Undue Burden on the Board

In an effort to minimize the burden of institution of two petitions, Petitioner has purposefully used the same secondary references in the same manner with respect to the same claims in the two petitions, except that Amaya is used as an additional secondary reference to address certain dependent claims in the Wakuda Petition. This similarity includes substantially similar motivations to combine these secondary references with the respective primary references. This overlap in secondary references and analysis greatly reduces the burden of instituting both petitions in that both proceedings are likely to focus on the same arguments with respect to the secondary references.

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