IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	BOSHERNITZAN et al.
U.S. Patent No.:	9,996,738
Issue Date:	June 12, 2018
Appl. Serial No.:	15/043,283
Filing Date:	February 12, 2016
Title:	SYSTEM AND METHOD FOR CONTROLLING A TERMINAL DEVICE

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PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 9,996,738

Per the Consolidated Trial Practice Guide ("Guide"), Petitioner Apple submits this Notice including (1) a ranking of the petitions in the order in which Apple wishes the Board to consider the merits, and (2) a succinct explanation of the differences between the petitions, why issues addressed by the differences are material, and why the Board should use its discretion to institute both petitions if it identifies one petition that satisfies Apple's burden under 35 U.S.C. § 314(a). Apple offers the two petitions with efficiencies of the Board in mind and requests consolidation of the proceedings if both petitions are instituted to further simplify the proceedings.

I. Ranking of Petitions

Apple presents two petitions, which address mutually exclusive groups of '738 patent claims. Multiple petitions are justified by (1) the need to address all claims of the '738 patent to protect against suit due to Haptic's refusal to stipulate to non-assertion of any claims, (2) non-overlapping subject matter in the dependent claims, (3) the length and complexity of the claims in the '738 patent, (4) the presence of multiple means-plus-function claim terms, and (5) the number of terms for which multiple constructions have arisen in co-pending litigation due to Haptic's vastly different interpretation of numerous claim terms in the co-pending litigation.

Although both of Apple's petitions are meritorious and justified, Apple requests the Board to consider the Petitions according to the following ranking:

Rank	Petition	Claims	Prior Art
1	IPR2024-01475 (Petition 1)	1-2, 4-5, 8-11	Murakoshi, Li, Stewart, Sachs, Orr, iFixit
2	IPR2024-01476 (Petition 2)	3, 6-7, 12-13	Murakoshi, Stewart, Sachs, Orr

II. Material Differences Compelling Permitting Multiple Petitions

First, Apple is forced to address all claims of the '738 patent because Haptic refuses to provide assurances that non-asserted claims will not be added to the co-pending district court litigation. Haptic has asserted claims 1-2, 4-5, and 9 of the '738 patent in the co-pending litigation. Despite Apple's attempts to streamline these proceedings by requesting that Haptic stipulate to not assert other claims of the '738 patent against Apple, Haptic has refused, further supporting the necessity of two petitions. APPLE-1109; *see Intex Recreation Corp. v. Bestway Inflatables & Materials Corp.*, IPR2023-00488, Paper 12 at 14 (PTAB Oct. 2, 2023) ("Patent Owner's failure to stipulate that the claims challenged in the present petition will not be asserted in the parallel District Court litigation supports our decision to decline to exercise our discretion to deny institution"); *Square, Inc. v. 4361423 Canada, Inc.*, IPR2019-01653, Paper 9 at 51 (May 12, 2020) (instituting a second petition where "Patent Owner did not … stipulate that certain claims challenged in these Petitions would not be asserted in the parallel litigation"). Accordingly, Apple is forced to challenge all claims of the '738 patent to protect itself from further suit.

Second, the petitions address mutually exclusive groups of non-overlapping claim sets. Petition 1 challenges claims 1-2, 4-5, and 8-11. Petition 2 challenges claims 3, 6-7, and 12-13, which recite non-overlapping features such as "a spring loaded portion" (claim 3) and "an additional sensor" with related additional components (claims 6-7 and 12). *See Samsung Elecs. C., Ltd. v. Mojo Mobility, Inc.*, IPR2023-01089, Paper 11, 26 ("[W]e find persuasive Petitioner's reasons for filing two parallel petitions, particularly because the petitions challenge different claims of the '349 patent. In effect, the two petitions were filed instead of one merely because our Rules have page limit restrictions"). Accordingly, the petitions present materially different challenges, each to a unique non-overlapping subset of the '738 patent's claims that necessitate additional analyses and explanations.

Third, the '738 patent's claims are long: 1,296 words across 13 claims, with independent claims 1 and 10 having 309 and 335 words, respectively, and dependent claims 6 and 12 having 113 and 116 words, respectively. *See Visa Inc. v. Cortex MCP, Inc.*, IPR2024-00486, Paper 8 at 42 (PTAB Aug. 2, 2024) (instituting two petitions where the Board agreed "the claims are relatively lengthy"—1,691 words total and claim 1 having 257 words).

Fourth, claim 1, which is necessarily addressed in both petitions, includes multiple means-plus-function limitations, including "engagement means" and "means for initiating activity," and other terms that include nonce words that should

be subject to § 112(f). *See Cisco Sys., Inc. v. Lionra Techs., Ltd.*, IPR2023-00670, Paper 10, 21 (PTAB Oct. 23, 2023) (instituting two petitions where "Petitioner 'devote[d] a substantial portion' of the 14,000 word-count limit to the potential constructions of claims … under § 112, sixth paragraph").

Fifth, Haptic's interpretations of claim terms are vastly different from Apple's—and the plain language of the '738 patent and claims, as evidenced by its infringement contentions and the parties' joint claim construction statement, further necessitating different invalidity grounds that fully address the constructions. For instance, Haptic's infringement contentions map a "server" to various components on the iPhone's logic board resulting in the claimed housing and server being located within the same device—a position unsupported by the '738 patent. APPLE-1101, 20-28, 54-60; APPLE-1001, 5:22-28, 7:24-25, 9:35-43, Fig. 1. Similarly, Haptic's infringement contentions treat the term "said contact interaction being comprised of an impact ***on said mounting surface***" as broad enough to encompass tapping on a back cover of an iPhone when the sensor is mounted inside the iPhone—directly in opposition to Applicant's position during prosecution. APPLE-1101, 12, 46; APPLE-1002, 103-104, 133, 142-145.

Accordingly, two petitions are necessary to address each of the challenged claims—including the asserted claims and those that Haptic refuses to stipulate will not be later asserted—in sufficient detail. Guide, 59 ("[T]here may be circumstances

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