

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Seung Jin Kim
U.S. Patent No.: 10,455,066 Attorney Docket Nos.: 39521-0092IP2
Issue Date: Oct. 22, 2019 39521-0092IP3
Appl. Serial No.: 15/563,937
Filing Date: Oct. 2, 2017
Title: MOBILE SYSTEM WITH WIRELESS EARBUD

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PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 10,455,066

Apple previously filed a petition in PGR2020-00066 (“Petition 1”) challenging claims of U.S. Patent No. 10,455,066 (“the ’066 Patent”) on June 11, 2020. Apple now files two additional petitions in IPR2021-00220 (“Petition 2”) and IPR2021-00221 (“Petition 3”), each also challenging claims of the ’066 Patent. 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

All three petitions are meritorious and institution of each is justified, in isolation and together. Petition 1 advances references establishing that features recited by the ’066 Patent claims would have been obvious as early as 2007, almost eight years before the ’066 Patent’s purported priority date. Petition 2 advances several distinct references that each independently establish prior art disclosure of every limitation recited by the challenged claims, and these disclosures are acknowledged by Pinn itself. Petition 2, Section II. Petition 3 demonstrates that Apple possessed a system that discloses every limitation of the challenged claims before the ’066 Patent’s purported priority date. Still, if the Board decides that

discretion should be exercised to deny one or more of these worthy petitions, Petitioner requests that the Board institute at least two petitions and prioritize institution among them as follows: Petition 1, Petition 2, and Petition 3.

II. Material Differences and Additional Factors that Compel Permitting Multiple Petitions

Priority Date—Petition 2 exposes a defect in the priority claim of the '066 patent, and thus, applicability of prior art advanced within the petition.

Specifically, the '066 Patent is not entitled to the filing date of U.S. Provisional Application No. 62/142,978 (“the '978 Provisional”) and, as Petition 2 points out, the earliest effective filing date of the '066 patent is therefore July 31, 2015.

Petition 2, Section III.B. Petition 2 relies on primary references that pre-date this earliest effective filing date, but which do not predate the '978 Provisional filing date. In fact, a further priority analysis is required under *Dynamic Drinkware* to apply Petition 2 primary references to this earliest effective filing date. Petition 2, Sections V.A.1, V.D.1. Thus, with respect to Petition 2, two opportunities for dispute on priority exist. While each is addressed thoroughly within Petition 2, absent concession by Pinn, a full resolution of priority-related issues will not be known until well after institution of either Petition 1 or 2. Notably, Pinn acknowledges that each Watson reference provides disclosure of essentially all of the accused features in the litigation. Petition 2, Section II. This issue distinguishes

Petition 2 from Petitions 1 and 3, as Petition 1 and Petition 3 prior art do not require any priority date analysis.

Institution of Petition 2 with either of Petition 1 or Petition 3 is fully consistent with the guidance offered by the CTPG. CTPG, 59. Notably, page 59 of the CTPG indicates that “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, in Petition 2, Petitioner notes the existence of two disputes involving priority date, and the unresolved nature of these priority date issues creates uncertainty, which leads Petitioner to rank Petition 2 lower than Petition 1, despite the clear case of unpatentability demonstrated through Petition 2 prior art, endorsed by Pinn’s acknowledgement that each of the Watson references discloses essentially all of the accused features in the litigation. Petition 2, Section II.

Substantive Differences Between the Petitions—At bottom, the Petitions are non-redundant, and this is evident when considering their respective reliance on different combinations of references that address the claim elements in materially different ways. To this point, Petition 1 highlights disclosure within Hankey Group of a docking/charging device with a user-selectable button (APPLE-1005, 6:17-19) and of soliciting user input prior to performing wireless pairing via a user prompt that requires a user response (APPLE-1005, 15:65-16:3).

Petition 1 explains how Lydon complements wireless pairing functionality of the type found in, e.g., Hankey Group, by promoting input using an existing charging device button to solicit user input as a condition precedent to pairing. APPLE-1007, 23:23-33. As such, the Hankey Group and Lydon combination promotes convenience, particularly when user access to a smartphone may be limited and where the earbud case may be readily available for physical manipulation in response an inbound call whose ring creates an exigent circumstance.

By contrast, Petition 2 applies Watson-350 and Watson-510 as primary references, and each reveals to a POSITA access to a button on a charging case configured to initiate a process, when pressed, whereby an ear bud is placed into discovery mode for pairing via Bluetooth with a smartphone. APPLE-1053, [0038]-[0040]; APPLE-1054, [0037]-[0039]; APPLE-1051, [0047]; APPLE-1052, [0046]. In particular, Watson-350's "wireless ear bud case determines whether a user has performed an action, (e.g., pushed a button on the wireless ear bud case), the action indicating that the user wants the wireless ear buds to be discoverable for connections to other communication devices" and "as the button 360 has been pressed, the wireless ear bud case 300 causes the wireless ear buds 305, 310 to become discoverable to new connections with other communication devices." APPLE-1053, [0050], [0039]-[0040]; APPLE-1054, [0049], [0038]-[0039]; *see* Petition 2, Ground 1A, 1[d]. Similarly, Watson-510's "wireless ear bud case 400

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