

Filed: February 21, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

CHIAN CHIU LI,

Patent Owner.

Case No. IPR2023-00560

Patent No. 11,016,564 B2

PATENT OWNER'S SUR-REPLY

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I. INTRODUCTION

Petitioner's Reply (Paper 9, "Reply") fails to provide any convincing evidence that shows the cited art discloses the limitation of the Challenged Claims, i.e., the "only after" limitation. The "only after" limitation is recited in independent claims 1, 8, and 14 of the '564 Patent. (Paper 8, Patent Owner's Response, "POR", p. 4.)

Petitioner misstates the POR argument throughout the Reply. Further, Petitioner presents untimely and improper new arguments and a new declaration, which should be disregarded and given no weight. Even if considered, the newly added contents are irrelevant to the "only after" limitation and validity of the '564 Patent. In addition, like the Petition, the Reply fails to demonstrate that the "only after" limitation is disclosed in the cited art.

II. THE NEW ARGUMENT IS IRRELEVANT TO THE LIMITATIONS OF THE CHALLENGED CLAIMS

Petitioner uses Section II of the Reply to advance new arguments about the "only after" limitation, asserting purported capability issues that are nonexistent and immaterial. (Reply, p. 1-8.) To support the new arguments, Petitioner submits a new declaration (Ex. 1010) made by Dr. Bederson. The newly added materials should be disregarded. The new arguments and declaration are improper because they are untimely and present entirely new theories of unpatentability. Further,

even if considered, the new arguments pivot to device capability issues, which are irrelevant to the “only after” limitation. Moreover, even if considered, the Reply and new declaration do not show the new arguments are supported by any evidence. For example, Dr. Bederson misstates the POR argument by asserting “Patent Owner contends the electronic device must be incapable of either performing gaze detection continuously without a trigger act or performing gaze detection after [...]” (Ex. 1010, at ¶ 3.) The Reply misstates the POR argument by contending “[the “only after” limitation] precludes the device from having the capability to perform gaze detection continuously or after a user approaches [.]” (Reply, p. 2.)

A. The Three Scenarios are Supported by the ’564 Patent

As another misstatement about the POR argument, Petitioner contends the POR has an “assertion that the invention claimed in the Challenged Claims must be incapable of performing gaze detection after detecting any act except [...]” (Reply, p. 2.) The contention is made without any evidence or explanation.

Further, Petitioner makes yet another misstatement of the POR, “Li then claims that because the Challenged Claims are directed to Scenario #3 only, the Challenged Claims are also limited to a method/device that only is capable of Scenario #3 detections.” (Reply, p. 2-3.) In fact, the POR recites “In Scenario #3, gaze detection is performed only after the Given Act is detected.” (POR, p. 3.)

There is no capability issue. It is misleading and merely an attempt to prejudice Patent Owner to raise the capability issue.

The Reply then asserts ““Scenario #2” and “Scenario #3” [recited in the POR] are not supported by the ’564 Patent[.]” and states there are four scenarios. (Reply, p. 3.) The support for Scenarios #1, #2, and #3 recited in the POR is already explained. (POR, p. 2-4.) The four scenarios recited in the Reply include Scenarios #1 and #2, but do not have Scenario #3. As Scenarios #2 and #3 recited in the POR are different and distinct, another new assertion of the Reply is also wrong. This new, untimely, and improper assertion recites “the ’564 Patent does not distinguish between a scenario that performs gaze detection after either a proximity event or shaking the device and a scenario that performs gaze detection only after shaking the device.” (Reply, p. 3.)

Then, the Reply makes yet another untimely new assertion “[i]n sum, because Li’s unsupported narrow interpretation of the Challenged Claims, if adopted, “would omit a disclosed embodiment[.]”” and the reason is “because Li has no “clear evidence to the contrary[.]”” (Reply, p. 5-6.) Such an assertion improperly advances another new theory and should be rejected. Furthermore, the Reply does not show explicitly what the omitted “disclosed embodiment” is and does not explain why the Challenged Claims must include the omitted “disclosed

embodiment”. Thus, this assertion is not only improper, but also wrong and has no supporting evidence.

B. The New Argument “[T]he Challenged Claims do not Preclude the Capability to Detect Proximity Events” is Irrelevant to the Limitations of the Challenged Claims

The title of Section II (B) of the Reply, “[T]he Challenged Claims do not preclude the capability to detect proximity events”, continues to advance the new improper argument. The Challenged Claims illustrate a method to present information, and have nothing to do with precluding a capability of a device. Even if considered, the new argument is immaterial to the Challenged Claims and thus irrelevant to the validity of the ‘564 patent.

Besides new arguments, Petitioner also advances new issues in the Reply, such as using the word “comprising” to assert “Li cannot rebut the presumption that the Challenged Claims are open-ended”, which is a nonexistent issue and immaterial. (Reply, p. 6.) The Reply then indicates besides using a claimed method, a device can use other methods, which is a nonissue to the validity of the ‘564 patent.

Further, as claims 1, 8, and 14 include the word “comprising”, the claimed methods may contain additional content or steps, such as the content provided in the dependent claims of the ‘564 Patent. However, the additional content or steps

are limited by the independent claims, respectively. That is, the additional content or steps cannot contradict or have a conflict with a corresponding independent claim.

III. RYU IN VIEW OF HODGE DOES NOT RENDER CLAIMS 1, 8, AND 14 OBVIOUS

The Reply fails to provide any reasonable evidence that shows the cited references render the Challenged Claims obvious.

Like the Petition, the Reply fails to show Ryu discloses the “only after” limitation. Moreover, Petitioner and its expert do not even attempt to rebut the POR’s showing that Ryu does not anticipate the “only after” limitation. (POR, p. 8-10.)

A. Ryu does not Disclose the “only after” Limitation

In Section III (A) of the Reply, Petitioner tries three steps to show Ryu discloses the “only after” limitation, but fails again. (Reply, p. 8-11.) In the first step, Petitioner indicates the term “after” may mean “only after”, because “prior art references need not parrot precisely the same words”. (Reply, p. 8-9.) Then, Petitioner goes on to use the term “unless and until” (that leads to “only after”) and misstates the POR argument by asserting Patent Owner acknowledges such a wrong practice. (Reply, p. 9.) Further, Dr. Bederson’s declaration does not give

any evidence about Ryu's disclosure of the "only after" limitation, but a conclusory assertion. (Ex. 1003, at ¶ 59.)

In the second step, Petitioner contends "Li again attempts to rely on a distinct embodiment in Ryu that includes a proximity sensor to suggest ..." (Reply, p. 9.) Such a contention is merely a distraction, as the POR already concludes whether or not a proximity sensor is included in Ryu's device does not matter. (POR, p. 10.) Petitioner then makes some capability arguments that are untimely, improper, and irrelevant. (Reply, p. 11.)

In the third step, Petitioner just makes a conclusory assertion, contending Ryu discloses the "only after" limitation without any supportive evidence.

B. Petition's Obviousness Grounds Fail

In Section III (B) of the Reply, Petitioner again misstates the POR argument and like the Petition, does not provide any evidence or explanation to support its obviousness grounds. (Reply, p. 11-12.) Ryu, Hodge, and Stallings fail to disclose the "only after" limitation, either alone or in combination. (POR, p. 6-17.) Without demonstrating the cited art discloses the "only after" limitation in the Reply and Petition, Petitioner's arguments and its obviousness grounds fail.

C. Petition's Obviousness Grounds are not Supported by Ryu

In Section III (C) of the Reply, Petitioner tries again to assert that its obviousness grounds are supported by Ryu, again without showing any supportive evidence.

In the first step, Petitioner again does not show reasonable support from Ryu's specification and drawings to justify its statement including "to obtain an image of the user (i.e., performs gaze detection after detecting the act), and then determines whether the user is looking at the device 100[.]" Further, "regardless of whether the statement is appropriate or not, the statement does not support the "only after" limitation with any word or as a whole." (POR, p. 15.)

In the second step, Petitioner does not show adequate support for making the sentence part "to determine if a user is looking at the device prior to performing a function" in an environment it configures. Further, regardless of whether the created sentence part is proper or not, it "does not support the "only after" limitation with any word or as a whole." (POR, p. 15.)

In the third and final step, Petitioner once again does not show any evidence to support its assertion Ryu discloses the "only after" limitation. As aforementioned, Dr. Bederson's declaration just provides a conclusory assertion about Ryu's disclosure of the "only after" limitation, without any supporting material. (Ex. 1003, at ¶ 59.)

In addition, “Ryu not only fails to disclose the “only after” limitation, but also fails to anticipate the limitation.” (POR, p. 10.) Ryu’s failure to anticipate the limitation remains unrebutted by Petitioner.

Therefore, the Petition’s obviousness grounds fail, because Petitioner does not demonstrate Ryu discloses the “only after” limitation.

D. The Combination of Ryu, Hodge, and Stallings does not Disclose the “only after” Limitation

The Reply claims the Petition does not rely on either Hodge or Stallings for the “only after” limitation. (Reply, p. 14.) Actually, neither Hodge nor Stallings discloses the “only after” limitation. (POR, p. 11-13.) Ryu, Hodge, and Stallings do not disclose the “only after” limitation either alone or in combination. Hence, regardless of whether Ryu, Hodge, and Stallings are combined or not, these references do not disclose the “only after” limitation.

IV. CONCLUSION

For the foregoing reasons, Petitioner has failed to demonstrate that any of the Challenged Claims are unpatentable.

Date: February 21, 2024

Respectfully submitted,

/ Chian Chiu Li /

Chian Chiu Li

Patent Owner

CERTIFICATE OF COMPLIANCE

Pursuant to §42.24(d), the undersigned certifies that this paper contains no more than 14,000 words. According to the word-processing system used to prepare this paper, the paper contains 1,953 words.

Date: February 21, 2024

Respectfully submitted,

/ Chian Chiu Li /

Chian Chiu Li

Patent Owner

CERTIFICATE OF SERVICE

A true and correct copy of Patent Owner's Sur-Reply has been served on
Petitioner's attorneys of record at the electronic correspondence of Petitioner as
follows:

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Date: February 21, 2024

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