

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

K/S HIMPP
Petitioner

v.

BRAGI GmbH
Patent Owner

Case IPR2023-00901

**PETITIONER'S REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

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Petitioner's Reply to Patent Owner's Preliminary Response

Petitioner submits this Reply to address Patent Owner's Preliminary Response's ("POPR") earlier inventor disclosure allegations under 35 U.S.C. § 102(b)(2)(B), pursuant to the Board's Sep. 5 and 6, 2023 emails. *See* Ex-1026.

I. No *earlier* disclosure because effective filing date of USP9781514 ("Hensen-Patent") predates PO's evidence of alleged earlier disclosure

PO repeatedly asserts that Hensen-Patent's effective filing date is Oct. 8, 2015." POPR at 17, 20, 22, 24, 25, 27, 28, 30, 31, 34, 37. But Oct. 8, 2015 is its filing date, not its *effective* filing date.¹ Hensen-Patent claims priority to App. Nos. 12/731,397 ("Hensen-Parent-App") (Ex-1027) and 62/061,497 ("Hensen-Prov") (Ex-1009). Because both applications support an effective filing date for Hensen-Patent, its effective filing date is Mar. 25, 2010 (Hensen-Parent-App filing date), or at least no later than Oct. 8, 2014 (Hensen-Prov filing date). Because these dates

¹ Because Hensen-Patent's Oct. 8, 2015 filing date predates the '385 patent's earliest possible priority date of Nov. 13, 2015, Petitioner met its initial burden of showing that Hensen-Patent qualifies as prior art. *See* Petition at fn. 2; *see also Pfizer, Inc. v. Genentech, Inc.*, IPR2017-01488, Paper 27, at 13 (PTAB Dec. 1, 2017) (initial burden met where prior-art patents "predate the earliest possible priority date shown on the face of the" challenged patent); IPR2021-00886, Paper 55, at 24-25 (PTAB Oct. 25, 2022).

predate the alleged inventor disclosure, ranging from Jan. 2015 to Nov. 2015 (Exs. 2005-2010), PO fails to establish *earlier* disclosure as required under § 102(b)(2)(B).

For a priority application to support an effective filing date, it “must ‘describe[] the subject matter’ relied upon in the reference patent document as prior art.” *Penumbra, Inc. v. RapidPulse, Inc.*, No. IPR2021-01466, Paper 34, 32 (PTAB Mar. 10, 2023) (citing MPEP § 2154.01(b)); *see also Apple Inc. v. Telefonaktiebolaget LM Ericsson*, No. IPR2022-00341, Paper 10, 14-22 (PTAB Sept. 14, 2022). Hensen-Parent-App describes the subject matter that Petitioner relies upon in Hensen-Patent as prior art for each of the challenged claims, as the table below shows. Therefore, the subject matter relied upon in Hensen-Patent as prior art was effectively filed on Hensen-Parent-App's filing date (Mar. 25, 2010).

Claim	Hensen-Patent	Hensen-Parent-App
1, 12-14	FIGS. 1 and 2; 2:24-31, 2:36-41, 4:55-64, 4:66-67, 5:9-24, 5:41-44, 5:63-67, 6:1-6, 8:14-34, 12:42-46, 12:52-55, 12:65-13:8, 13:34-45; Claim 1	FIGS. 1 and 2; ¶¶10, 11, 38, 39, 41, 43, 46, 47, 60, 61, 89, 90, 92, 93, 96; Claims 1-4
2-4, 15-16	Claim 1, 8:24-34, 13:6-16	Claims 1-4; ¶¶61, 93
5-7	Refers to [1E] and [1F]; 8:14-31, Claim 14	¶¶60, 61; Claim 13
8	5:37-47; 8:14-34	¶¶43, 60, 61
9	FIGS. 1 and 2; 4:66-5:8	FIGS. 1 and 2; ¶¶39, 40
10	5:41-44, 8:17-20	¶¶43, 60
11	5:9-24, 7:65-8:7, Claim 14	¶¶41, 58; Claim 13

Even if applying the *Dynamic Drinkware* standard for determining a reference's effective filing date, namely whether the priority application supports a

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claim of the reference, Hensen-Patent's effective filing date still predates PO's evidence of alleged inventor disclosure.² *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015). Under *Dynamic Drinkware*, the effective filing date is Mar. 25, 2010 because Hensen-Patent's claims are entitled to claim the benefit of the filing date of Hensen-Parent-App. For example, the disclosure of Hensen-Parent-App provides support to at least claim 1:³

Hensen-Patent, Claim 1	Hensen-Parent-App
A stereo audio headphone apparatus comprising:	<i>See, e.g.</i> , ¶24, FIG. 1
a master headphone unit comprising:	<i>See, e.g.</i> , ¶38
a master housing to be independently carried behind an ear of	<i>See, e.g.</i> , ¶38

² Note that regardless of the standard applied, Hensen-Prov's disclosure also supports an effective filing date for Hensen-Patent because their disclosures are effectively identical. Because Hensen-Prov incorporates by reference Hensen-Parent-App (*see* Ex-1009, ¶36), its disclosure is the combination of Hensen-Prov and Hensen-Parent-App. Because Hensen-Patent incorporates by reference Hensen-Prov, and otherwise has the same specification as Hensen-Parent-App, its disclosure likewise is the same combination of Hensen-Prov and Hensen-Parent-App.

³ Because Hensen-Prov incorporates Hensen-Parent-App by reference, Hensen-Patent claim 1 is also entitled to claim the benefit of the filing date of Hensen-Prov.

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the user,	
master circuitry carried by said master housing and comprising a stereo audio source and a wireless transmitter coupled thereto,	<i>See, e.g.</i> , ¶39, FIG. 2
a master audio output device carried by said master housing and coupled to said master circuitry for playing a first stereo audio channel from said stereo audio source,	<i>See, e.g.</i> , ¶42
a master audio input device carried by said master housing and coupled to said master circuitry, and	<i>See, e.g.</i> , ¶73, FIG. 9
a first independently settable frequency equalizer for the first stereo audio channel carried by said master housing; and	<i>See, e.g.</i> , ¶49
a slave headphone unit comprising	<i>See, e.g.</i> , ¶46
a slave housing to be independently carried behind another ear of the user,	<i>See, e.g.</i> , ¶46
slave circuitry carried by said slave housing and comprising a wireless receiver cooperating with said wireless transmitter,	<i>See, e.g.</i> , ¶47, FIG. 2
a slave audio output device carried by said slave housing and coupled to said slave circuitry for playing a second stereo audio channel from said stereo audio source,	<i>See, e.g.</i> , ¶¶45, 48
a slave audio input device carried by said slave housing and coupled to said slave circuitry, and	<i>See, e.g.</i> , ¶78, FIG. 9
a second independently settable frequency equalizer for the second stereo audio channel carried by said slave housing;	<i>See, e.g.</i> , ¶¶49, 78
wherein said master circuitry is operable in a pass-through mode with audio sensed by said master audio input device being delivered to said master audio output device via said first independently settable frequency equalizer; and	<i>See, e.g.</i> , ¶73
wherein said slave circuitry is operable in a pass-through mode with audio sensed by said slave audio input device being delivered to said slave audio output device via said second independently settable frequency equalizer.	<i>See, e.g.</i> , ¶78

II. PO's evidence fails to meet requirements of § 102(b)(2)(B) exception

This exception only applies if the earlier disclosure is *by or obtained from the inventor*, in this case Martin Steiner. Of Exs. 2005-2010, only a portion of Ex. 2006 (a video of Martin Steiner) is, on its face, connected to the inventor. *See, e.g.*, POPR,

30 (citing Ex. 2006 disclosing a comment from “BRAGI LLC”). PO fails to submit any evidence showing that the remaining disclosures originated from the inventor. Even assuming they originated from within Bragi, they could have come from others besides the inventor, such as Nikolaj Hviid, Eric Hirsch, Darko Dragicevic, or Peter Boesen. *See, e.g.*, USP9,755,704 (Ex-1028), claims 5 and 6 (reciting a mobile device in communication with an earpiece); USP10,165,350 (Ex-1029), FIG. 5 (illustrating a mobile device in communication with earpieces).

As PO admits, this exception only applies if the subject matter of Hensen-Patent is ***the same*** as that of any earlier disclosure. POPR, 18. In many instances, PO compares the alleged earlier disclosure to the claim language, rather than to Hensen-Patent as required. *See, e.g.*, POPR, 25-27 (limitations [1B], [1D]), 34 (limitation [13E]); MPEP § 717.01(b)(1) (this exception does not compare claimed invention to inventor-originated disclosure). In other instances, the alleged earlier disclosure is not the same as that of Hensen-Patent. For example, the software application and user interface of Hensen-Patent are not the same as that of Ex. 2006. *Compare* Ex-1003, Fig. 1, 8:14-34 (describing remote control unit 51) *with* POPR, 25-27 (citing Ex-2006); *see* MPEP § 717.01(b)(2) (alternative species not the same).

Respectfully submitted, /Haixia Lin/

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Table of Exhibits

Exhibit	Description
1001	U.S. Patent No. 10,635,385 (“’385 patent”)
1002	Declaration of Brian W. Anthony, Ph.D.
1003	U.S. Patent No. 9,781,514 (“Hensen-Patent”)
1004	YouTube.com, <i>September 2015 – FreeWavz Demo</i> [https://www.youtube.com/watch?v=zHNZ7p5GnH4] (“Hensen-Video”)
1005	<i>User Manual: LG Heart Rate Earphones</i> (“LG-Manual”)
1006	U.S. Patent Appl. No. 2014/0189600 (“Lee”)
1007	Kickstarter.com, November 22 Progress Report (“Hensen-Kickstarter”) [https://web.archive.org/web/20150924011438/https://www.kickstarter.com/projects/freewavz/freewavzsmart-earphones-with-built-in-fitness-mon/posts/1057132]
1008	U.S. Patent No. 9,161,131 (“Hensen-Parent”)
1009	U.S. Provisional Application No. 62/061,497 (“Hensen-Provisional”)
1010	Screenshots from Hensen-Video
1011	File History for U.S. Patent No. 10,635,385 (“’385 FH”)
1012	Twitter.com – Posts by FreeWavz [https://twitter.com/Freewavz]
1013	Twitter.com - October 2014 Snapshot of Posts by FreeWavz [https://web.archive.org/web/20141026181307/twitter.com/Freewavz]
1014	Kickstarter.com, <i>Pulse Oximetry Success + FreeWavz Testing + Factory Preparation</i> [https://www.kickstarter.com/projects/freewavz/freewavz-smart-earphones-with-built-in-fitness-mon/posts/1349732]

Exhibit	Description
1015	FreeWavz.com – Home Page [https://web.archive.org/web/20151004055203/http://www.freewavz.com/]
1016	FreeWavz.com – News Page [https://web.archive.org/web/20151006111823/http://www.freewavz.com/news/]
1017	FreeWavz.com – About Page [https://web.archive.org/web/20151008013534/http://freewavz.com/about/]
1018	Olympics.com – History of Triathlon [https://olympics.com/en/sports/triathlon/#discipline-history-of]
1019	LG.com – FR74 Product Page [https://web.archive.org/web/20150507002217/http://www.lg.com/us/support-mobile/lg-FR74#]
1020	FCC.gov – FR74 FCC Application [https://apps.fcc.gov/oetcf/eas/reports/ViewExhibitReport.cfm?mode=Exhibits&RequestTimeout=500&calledFromFrame=N&application_id=5sSYi3UFjhWeKosDZgHTHQ%3D%3D&fcc_id=BEJ9QK-DMFR74]
1021	FCC.gov – FR74 User Manual (Attachment to FCC Application) [https://apps.fcc.gov/eas/GetApplicationAttachment.html?id=2186303]
1022	Kickstarter.com – FreeWavz Creator Bio [https://web.archive.org/web/20150912193027/https://www.kickstarter.com/projects/freewavz/freewavz-smart-earphones-with-built-in-fitness-mon/creator_bio]
1023	Internet Archive Declaration of Nathaniel E Frank-White
1024	U.S. Patent No. 9,392,946
1025	U.S. Patent No. 8,818,476
1026	Email exchange with the Board from September 1–6, 2023

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Exhibit	Description
1027	U.S. Patent Application No. 12/731,397 (“Hensen-Parent-App”)
1028	U.S. Patent No. 9,755,704
1029	U.S. Patent No. 10,165,350

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CERTIFICATE OF SERVICE

I hereby certify that on September 15, 2023, I caused a true and correct copy of the foregoing materials:

- Petitioner's Reply to Patent Owner's Preliminary Response
- Table of Exhibits
- Exhibits 1026–1029

to be served via electronic mail by consent on counsel of record at:

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Respectfully Submitted,

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