

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
U.S. Patent No. 10,635,385

**PATENT OWNER'S SUR-REPLY IN RESPONSE TO PETITIONER'S
REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE**

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TABLE OF EXHIBITS

Exhibit	Description
2001	Declaration of Kaylee Hoffner in Support of Motion for <i>Pro Hac Vice</i>
2002	Kaylee Hoffner Bio in Support of Motion for <i>Pro Hac Vice</i>
2003	Declaration of Kaylee Hoffner in Support of Revised Motion for <i>Pro Hac Vice</i>
2004	Kaylee Hoffner Bio in Support of Revised Motion for <i>Pro Hac Vice</i>
2005	Bloomberg Article, Fitness Tracker or Bionic Ear? The Dash Wireless Earbuds Might Be Both: https://www.bloomberg.com/news/articles/2015-01-06/fitness-tracker-or-bionic-ear-the-dash-wireless-ear-buds-might-be-both#xj4y7vzkg , dated January 6, 2015
2006	Bragi Kickstarter with video published, available at: https://www.kickstarter.com/projects/hellobragi/the-dash-wireless-smart-in-ear-headphones/posts/1273891 , dated June 24, 2015
2007	Kickstarter post with video of complete unboxing: https://www.kickstarter.com/projects/hellobragi/the-dash-wireless-smart-in-ear-headphones/posts/1340666 , dated September 10, 2015
2008	Kickstarter with video post touring office: https://www.kickstarter.com/projects/hellobragi/the-dash-wireless-smart-in-ear-headphones/posts/1159785 , dated April 1, 2015
2009	Kickstarter update post with video of technical updates: https://www.kickstarter.com/projects/hellobragi/the-dash-wireless-smart-in-ear-headphones/posts/1254265 , dated June 5, 2015

Exhibit	Description
2010	YouTube Field Test Video: https://www.youtube.com/watch?v=lXuFDv2p1w0 , dated September 22, 2015
2011	Engadget Article, An exclusive look at Bragi's ambitious smart headphones: https://www.engadget.com/2015-01-05-bragi-dash-exclusive.html , dated January 5, 2015
2012	The Verge Article, The First Truly Wireless Earbuds are Here, and They're Awesome: https://www.theverge.com/2015/1/9/7512829/wireless-earbuds-ces-2015-bragi-dash , dated January 9, 2015
2013	Engadget Article, Presenting the Best of CES 2015 winners!: https://www.engadget.com/2015-01-08-best-of-ces-2015-winners.html , dated January 8, 2015
2014	Wired Article, Bragi's in-ear assistant wants to make you healthier and happier: https://www.wired.co.uk/article/bragi-in-ear-assistant , dated October 29, 2015
2015	Engadget Article, Bragi's Dash headphones are finally here, The multi-sport smart earbuds have a lot of hype to live up to: https://www.engadget.com/2016-01-05-bragi-dash-headphones-are-here.html , dated January 5, 2016
2016	The Verge Article, Bragi's truly wireless earbuds are finally here, and they're actually good, The wireless earbuds of my dreams: https://www.theverge.com/2016/1/7/10730300/bragi-dash-real-wireless-earbuds-ces-2016 , dated Januray 7, 2016

Patent Owner submits this Sur-Reply to address Petitioner's Reply ("Reply") to Patent Owner's Preliminary Response ("POPR"), pursuant to the Board's September 5 and 6, 2023 emails. *See* Ex-1026.

**I. THE PETITION'S FAILURE TO ESTABLISH A REASONABLE
LIKELIHOOD OF UNPATENTABILITY CANNOT BE CURED**

A. Petitioners Attempt to Improperly Introduce New Arguments

Petitioner's Reply is an attempt to improperly submit new evidence not previously presented in the Petition which itself contradicts arguments made in the Petition. For example, the Petition expressly states that "Petitioner does not rely on the filing dates of Hensen-Parent or Hensen-Provisional to establish that Hensen-Patent is prior art to the '385 Patent." Petition, 6 (emphasis added). But their Reply seeks to do just that. Reply, 1. Petitioners admit they were aware of Hensen-Parent (App. No. 12/731,397, Ex-1027) and Hensen-Provisional (App. No. 62/061,497, Ex-1009) at the time of filing the Petition (Petition, 6), but chose not to rely on either reference for any of the grounds put forth in the Petition. Petitioner cannot now rely on these new and renounced filing dates for the first time in their Reply.

"[T]he expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute." *Intelligent Bio-Systems v. Illumina Cambridge*, 821 F.3d 1359, 1369 Fed. Cir. 2016). As such, "[i]t is of the utmost important that petitioners in...IPR proceedings adhere to the requirement that the

initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Id.* (Citing 35 U.S.C. § 312(a)(3)). For these reasons, the Board does not permit Petitioners to introduce new arguments or evidence not included in the Petition. Office Trial Practice Guide Update (August 2018), pp. 14-15.

B. Hensen-Patent’s Claims are Not Entitled to Claim the Benefit of the Filing Date of Hensen-Parent-App

Petitioners incorrectly assert that Hensen-Patent incorporates by reference Hensen-Provisional and otherwise has the same specification as Hensen-Parent. Reply, 3. This is not accurate, Hensen-Patent is a continuation-in-part of Hensen-Parent and does not have the same specification. Petitioners also incorrectly claim that Hensen-Provisional’s disclosure is *effectively identical* to Hensen-Patent. Reply, 3 (emphasis added). This is once again a mischaracterization, and Petitioners have advanced no argument or evidence in support of their claims.

First, Petitioners argue that the disclosure of Hensen-Parent provides support to at least Claim 1. Reply, 3-4. However, this is not the case. For example, Hensen-Parent does not provide support for “a second independently settable frequency equalizer for the second stereo audio channel carried by said slave housing.” Petitioners cite to paragraphs 49 and 78 of Hensen-Parent for this disclosure. *Id.* However, Hensen-Parent actually discloses that “the master circuitry also includes

first and second independently settable frequency equalizers.” Petitioner’s citations further support the fact that the second impudently settable frequency equalizer is carried by the master housing, not the slave housing as the Hensen-Patent Claim 1 requires. Petitioners mischaracterize the disclosure of Hensen-Parent, and it does not provide support for at least Claim 1 of Hensen-Patent.

C. § 102(b)(2)(B) Exception

35 U.S.C. § 102(b)(2)(B) provides that a disclosure shall not be prior art to a claimed invention under 35 U.S.C. 102(a)(2) if the subject matter disclosed had, before such subject matter was effectively filed under 35 U.S.C. 102(a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. 35 U.S.C. § 102; *see also* MPEP 717.01(b). Petitioners argue in the POPR that Hensen-Patent teaches the claims of the ’385 Patent. Petitioners now concede that the Patent Owner’s own disclosure predating Hensen-Patent, which as shown in the POPR teaches the ’385 Patent, is “not the same as that of Hensen-Patent.” Reply, 5.¹

¹ Petitioners also misquote the MPEP, citing to MPEP § 717.01(b)(1) which is directed to the Evaluation of Declarations or Affidavits under 37 CFR 1.130(b). Reply, 5. Patent Owner did not submit any declarations or affidavits in support of the POPR.

Petitioners cannot have their cake and eat it too: either (a) Hensen-Patent does not disclose the claimed inventions of the '385 Patent—and therefore it is not prior art—or (b) Hensen-Patent contains at least the same subject matter as the '385 Patent and Bragi's prior disclosure. Either way, Petitioners lose. Petitioners concession further supports that instituting review would be a waste of Board resources, as Petitioners recognize the failure of their relied upon references to teach the claimed invention.

D. The Relied Upon Disclosure was Obtained from the Inventor

Petitioners argue that the § 102(b)(2)(B) exception only applies if the earlier disclosure is by or obtained from the inventor, Martin Steiner. Reply, 4. Petitioners however, incorrectly claim – without any support - that only Ex-2006 (the video of Martin Steiner explaining his invention) satisfies the requirements of § 102(b)(2)(B). *Id.* The parties agree that the video submitted as Exhibit 2006 portrays Inventor Steiner describing the claimed invention. Reply, 4. The parties also agree that Inventor Steiner was employed by Bragi GmbH at the time of the cited disclosures. The parties further agree that the disclosures submitted from The Dash Kickstarter Campaign were made by Patent Owner, Bragi, by whom Inventor Steiner was employed. The other Kickstarter disclosures were made by Bragi contemporaneously with Inventor Steiner's video explaining his technology. *See* Ex-2006-2010. They are based on the same technology, for the development of the same

product, the Dash wireless earbuds. *Id.* There is no evidence, much less preponderance of evidence, to counter that these disclosures were made by or derived from Inventor Steiner while he was employed at Bragi.

E. Hensen-Patent Does Not Disclose The Same Invention as the '385 Patent

Petitioners admit in their Reply that Hensen-Patent does not disclose the same invention as the '385 Patent. *See* Reply, 5. (“[T]he alleged earlier disclosure is not the same as that of Hensen-Patent.”) Petitioners admit that the software application and user interface of Hensen-Patent are not the same as that of Exhibit 2006. As presented in the POPR, Ex-2006 discloses the teaching of the '385 Patent. As a result, Petitioners concede that Hensen-Patent does not disclose the same invention as the '385 Patent, contrary to what they presented in the Petition.

II. CONCLUSION

Here, it was the Petitioner’s burden to provide in the Petition the evidence and arguments necessary to establish a *prima facie* case of unpatentability. Petitioner failed to do so. The Petition should be denied.

Dated: September 25, 2023

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** has been served on Petitioner via email on the following counsel of record for Petitioner:

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