UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIVECOR, INC.,

Petitioner,

v.

APPLE INC.,

Patent Owner

Case IPR2023-00948
Patent 10,866,619 B2

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I. INTRODUCTION 1

II. ALIVECOR FAILS TO DEMONSTRATE THE NEED FOR PARALLEL PETITIONS 3

A. AliveCor Fails To Properly Address The Trial Practice Guide's Criteria for Multiple Petitions 3

B. AliveCor's Claim Allocations Create Substantial and Unnecessary Burden 4

III. ALIVECOR'S PURPORTED JUSTIFICATIONS DO NOT EXPLAIN WHY THIS IS A "RARE" CASE REQUIRING MULTIPLE PETITIONS .5

A. The Petitions Do Not Specifically Address Alternative Configurations AliveCor Purports Are Recited In The '619 Patent Claims 6

B. The Petitions Are Not Materially Different 6

IV. CONCLUSION 8

LIST OF EXHIBITS

APPLE-2001	Memorandum: Interim Procedure for Discretionary Denials in AIA Post - Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
APPLE-2002	Plaintiff Apple Inc.'s Disclosure of Asserted Claims and Infringement Contentions, *Apple Inc. v. AliveCor, Inc.*, 22-CV-07608-HSG (N.D.Cal Jul. 25, 2023)

I. INTRODUCTION

Patent Owner, Apple Inc. ("Apple"), submits this preliminary response to Petitioner, AliveCor Inc.'s ("AliveCor"), Petition for *inter partes* review of U.S. Pat. No. 10,866,619 ("the '619 patent") in IPR2023-00948. In parallel, AliveCor also filed a separate petition against the '619 patent in IPR2023-00949.

AliveCor's petitioning strategy against the '619 patent is the exact type of parallel petitioning that the Consolidated Trial Practice Guide ("CTPG") was developed to prevent. CTPG (November 2019) at 59. The petitions largely address the same core claim features recited in each of the independent claims (claims 1, 11, and 16)—for example, a "button assembly" with a "seal" and "flexible conduit," where "a portion of the flexible conduit is sandwiched" between two surfaces. The petitions also apply the same prior art references (Kim, Jung, Meyers, Chang) in a substantially similar manner against these core claim features. Worse, even the grounds within each individual petition are redundant.[1]

---

[1] AliveCor's grounds also are confusing as they appear to challenge the same claims, using the same prior art references and statutory basis, but in separate grounds. For example, AliveCor appears to advance obviousness contentions based on Kim in Grounds 1 and 2 in addressing claims 1, 5, 9, and 10. *See* Pet. at 1.

To illustrate, AliveCor has advanced at least ***six*** distinct invalidity theories against claim 1 in this proceeding:

AliveCor's Invalidity Theory	**Ground**
Anticipation over Kim	1
Obviousness over Kim	1
Obviousness over Kim	2
Obviousness over Jung-Meyers	3
Anticipation over Chang	4
Obviousness over Chang	4

Pet., 1. With these theories including alternative anticipation and obviousness theories over Kim and Chang, any need urged by AliveCor for multiple petitions is revealed as being driven by AliveCor's decision to use IPR as a means to advance multiple redundant grounds against the '619 patent. This strategy is both unnecessary and improper, and it represents a blatant attempt to circumvent the Board's word count limits on petitioners, which leads to imposition of undue burdens on each of Apple and this Board. *See* §II.B, *infra* (table summarizing AliveCor's grounds in IPR2023-00948 and IPR2023-00949); *see also* APPLE-2001. Discretionary denial of one petition under 35 U.S.C. § 314 is therefore appropriate.

Institution denial here also is consistent with §314(a) denials by other panels under similar circumstances. *See, e.g.*, IPR2023-00543, Pap. 8 (PTAB Aug. 8, 2023), at 10 (denying institution of a second-filed petition given "a high degree of overlap between the grounds in each petition"); IPR2021-00070, Pap. 21 (PTAB

May 20, 2021), at 13 (denying institution of a parallel petition). Here, AliveCor's petitioning strategy invites discretionary denial since, as discussed in §III, *infra*, AliveCor's purported justifications do not demonstrate existence of a rare circumstance where multiple petitions are necessary to address patentability of the '619 patent.

II. ALIVECOR FAILS TO DEMONSTRATE THE NEED FOR PARALLEL PETITIONS

As explained in the CTPG, "one petition should be sufficient to challenge the claims of a patent in most situations" as "multiple petitions by a petitioner are not necessary in the vast majority of cases." CTPG at 59. Indeed, "a substantial majority of patents have been challenged with a single petition." *Id*.

A. AliveCor Fails To Properly Address The Trial Practice Guide's Criteria for Multiple Petitions

Institution of multiple petitions may be warranted "when patent owner has asserted a large number of claims in litigation or when there is a dispute about the priority date." CTPG at 59. Since a challenge to the priority date of the '619 patent is not presented in either petition, AliveCor's basis for multiple petitions appears primarily based on the number of claims asserted in the litigation.

However, AliveCor fails to demonstrate that the claims asserted in the litigation necessitate multiple petitions. While AliveCor states "a large number of claims" have been asserted in litigation, it grossly misstates without substantiation.

See Pap. 3, 1-2. The '619 patent only includes 20 claims (including three independent claims)—the number covered by the USPTO's standard filing fee. Thus, application of AliveCor's argument would open the door to multiple petitions from any petitioner facing an asserted patent with the standard number of claims. In essence, with AliveCor's approach, multiple petitions would return from exceptional to commonplace, which is directly contrary to the CTPG.

Regardless, AliveCor's assertion is belied by the fact that Apple has only asserted two claims in the litigation. *See* APPLE-2002 (asserting claims 1 and 4).

B. AliveCor's Claim Allocations Create Substantial and Unnecessary Burden

In filing multiple petitions, AliveCor allocated challenges to claims 1-10 of the '619 patent in this proceeding, and challenges to claims 11-20 in IPR2023-00949. These allocations (summarized below) are based on grounds that include what AliveCor acknowledges as "essentially the same art against all claims." Pap. 3 at 1.

Invalidity Ground	IPR2023-00948	IPR2023-00949
Anticipation over Kim	Claims 1, 5, 9, 10 (Ground 1)	Claims 11, 14, 16, 19 (Ground 1)
Obviousness over Kim	Claims 1, 5, 9, 10 (Ground 1)	Ground 11, 14, 16, 19 (Ground 1)
Obviousness over Kim	Claims 1-10 (Ground 2)	Claims 11-14, 16-20 (Ground 2)
Obviousness over Jung-Meyers	Claims 1, 3-10 (Ground 3)	Claims 11-14, 16, 17, 19-20 (Ground 3)

Anticipation over Chang	Claims 1-2, 6, 9 (Ground 4)	Claims 11-17, 19 (Ground 4)
Obviousness over Chang	Claims 1-2, 6, 9 (Ground 4)	Claims 11-17, 19 (Ground 4)

By splitting up the claims across petitions, AliveCor offers the illusion that it did not have enough space to address each set of challenged claims in a single petition. But that contention ignores the overlap of claimed subject matter and prior art mappings across the two petitions. AliveCor's allocation of claims is designed to provide room for additional prior art grounds, making it more difficult for the Board to address all challenged claims in one proceeding, thereby placing "a substantial and unnecessary burden on the Board." CTPG at 59 (citing 35 U.S.C. § 316(b)). It also contradicts the "fairness, timing, and efficiency" concerns underlying the CTPG's guidance since it forces Apple to defend against the same multiple redundant grounds in two separate proceedings. *Id*.

III. ALIVECOR'S PURPORTED JUSTIFICATIONS DO NOT EXPLAIN WHY THIS IS A "RARE" CASE REQUIRING MULTIPLE PETITIONS

AliveCor identifies two primary justifications for multiple petitions challenging the '619 patent—(1) the number and specificity of the claims, and (2) the petitions are materially different from each other. Pap. 3. But circumstances where more than one petition are necessary are "rare," and neither of AliveCor's justifications address why this case is one of those rare circumstances.

A. The Petitions Do Not Specifically Address Alternative Configurations AliveCor Purports Are Recited In The '619 Patent Claims

Despite its contention that the claims "recite potential ***alternative*** configurations of the flexible conduit and seal[,]" the grounds advanced by AliveCor in its Petitions lack any meaningful discussion of how the prior art differently addresses each "alternative" configuration. Pet. at 3 (emphasis in original). Also, notably absent is contention of alternative claim constructions, but instead the proposition without citation to legal support that the existence of alternative configurations within claim scope is sufficient to justify multiple petition filings.

Regardless, in acknowledging that each of the two petitions apply nearly-identical grounds with the same prior art references, AliveCor recognizes that the "potential alternative configurations" do not require multiple petition filings. Indeed, if the claims were not closely-related, then AliveCor would not have been able to rely on the disclosures of the same references in advancing essentially the same conclusory arguments against all claims.

B. The Petitions Are Not Materially Different

AliveCor argues its parallel petitions are "materially different" because "each petition challenges different claims." Pap. 2 at 4. But this distinction exalts form over substance. As discussed in §§II.A-B, AliveCor advances the same prior

art grounds in each petition to address the same core claim features. Not surprisingly, in doing so, AliveCor offers largely the same annotations in each petition. For instance, citations to Kim in addressing claim 1 in this proceeding are mimicked when addressing claim 11 in IPR2023-00949. *Compare* Pet. at 10-27; IPR2023-00949, Pap. 2, at 8-30. The same is true for AliveCor's grounds based on Jung (Pet. at 47-69; IPR2023-00949, Pap. 2, at 43-67) and Chang (Pet., 81-101; IPR2023-00949, Pap. 2, at 77-97). Thus, AliveCor not only presents the same prior art in each petition, but applies it in substantially the same way.

Regardless, Board jurisprudence establishes that a challenge to different claims across petitions for the same patent alone is not a sufficient reason for multiple petition filings. IPR2020-00326, Pap. 12, at 12 (PTAB June 26, 2020) ("although Petitioner correctly argues that the petitions in the two proceedings challenge different claims, Petitioner chose that claim allocation without persuasively explaining the 'need' to do so.").

AliveCor also has not "explained why all of its challenges are necessary." *Id.* AliveCor further "does not address why it could not have, in one petition, presented one ground of unpatentability for each challenged claim." *Id.* To this point, AliveCor has failed to explain why three independent bases (based on Kim, Jung, and Chang) are necessary. Nowhere in the petition or ranking paper does AliveCor explain why its first Kim-based ground is insufficient or otherwise why

two distinct grounds (based on Jung and Chang) are necessary. Nor does AliveCor provide similar explanation of why two distinct grounds are needed in addition to either of the Jung-based grounds, or the Chang-based grounds. Rather, with no justification for the need for all three, AliveCor advances two petitions, seeking extra word count to address a tactical decision to apply three distinct grounds under the guise of excess claims.

AliveCor also does not address its odd claim allocation between the two petitions. Instead of separating grounds based on Kim, Jung, and Chang into separate petitions (each covering the corresponding set of challenged claims), AliveCor's allocation seems designed to make it difficult for the Board to address all of the issues in a single proceeding. For example, the first petition challenges one independent claim (claim 1) and its dependent claims, whereas the second Petition challenges the two other independent claims (claims 11 and 16) and their corresponding dependent claims. Had AliveCor divided the primary references across petitions, there would have been sufficient space to address each set of challenged claims within each respective petition, although in this case, AliveCor would have needed to justify filing multiple petitions with different grounds.

IV. CONCLUSION

For the reasons set forth above, AliveCor fails to sufficiently justify a need for multiple petitions and uses its multiple petitions to advance an unreasonably

large number of repetitive and redundant grounds against the ’619 patent. Accordingly, Apple respectfully asks that the Board exercise discretion under §314(a) to deny institution of *inter partes* review of at least one of AliveCor’s petitions against the ’619 patent.

Respectfully submitted,

Date: October 12, 2023

/W. Karl Renner/

W. Karl Renner, Reg. No. 41,265
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F:877-769-7945

CERTIFICATION UNDER 37 CFR § 42.24(d)

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Preliminary Response totals 1,780, which is less than the 14,000 allowed under 37 CFR § 42.24(b)(1).

Respectfully submitted,

Date: October 12, 2023

/W. Karl Renner/

W. Karl Renner, Reg. No. 41,265
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F:877-769-7945

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on October 12, 2023, a complete and entire copy of this Patent Owner's Preliminary Response and its supporting exhibits were provided via email, to the Petitioner by serving the email correspondence addresses of record as follows:

Christopher TL Douglas, Reg. No. 56,950
Scott M. Stevens, Reg. No. 54,762
Philip Ducker, *Pro Hac Vice*
J. Ravindra Fernando, Reg. No. 73,762
Thomas F. Finch, *Pro Hac Vice*
Erin Beaton, Reg. No. 79,218

ALSTON & BIRD LLP
Vantage South End
1120 South Tryon Street, Suite 300
Charlotte, NC 28203-6818
Phone: 704.444.1000
Fax: 704.444.1111

E-mail: apple-alivecor-ndcal@alston.com

/Crena Pacheco/

Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street
Minneapolis, MN 55402
pacheco@fr.com