UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIVECOR, INC.,

Petitioner

v.

APPLE INC.,

Patent Owner

Case Nos. IPR2023-00948, IPR2023-00949

U.S. Patent No. 10,866,619 B2

PETITIONER'S REASONS FOR PARALLEL PETITIONS AND PETITION RANKING

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US Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

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LIST OF EXHIBITS

Exhibit	Short Name	Description
Ex. 1001	’619 Patent	U.S. Patent No. 10,866,619 B2 (“the ’619 Patent”)
Ex. 1002	’619 File History	Prosecution History of U.S. Patent No. 10,866,619 B2
Ex. 1003	Berger Declaration	Declaration of Dr. Ronald D. Berger
Ex. 1004	Kim	U.S. Patent No. 10,620,828
Ex. 1005	Jung	U.S. Patent Pub. No. 2016/0100499
Ex. 1006	Dunlap	U.S. Patent No. 9,651,513
Ex. 1007	Meyers	U.S. Patent Pub. No. 2015/0071509
Ex. 1008	Evans	U.S. Patent No. 8,694,793
Ex. 1009	Pare	U.S. Patent No. 6,131,464
Ex. 1010	Chaudhri	U.S. Patent No. 9,740,381
Ex. 1011	Choung	U.S. Patent Pub. No. 2015/0245514
Ex. 1012	Hwang	U.S. Patent No. 8,750,919
Ex. 1013	Polany	U.S. Patent No. 7,535,799
Ex. 1014	Choi	U.S. Patent Pub. No. 2017/0099742
Ex. 1015	Chang	U.S. Patent No. 10,133,910
Ex. 1016	Mittleman	U.S. Patent No. 8,367,958
Ex. 1017	Aapro	U.S. Patent No. 7,486,517
Ex. 1018	Vittu	U.S. Patent No. 9,973,669

Exhibit	Short Name	Description
Ex. 1019	Wagman	U.S. Patent No. 9,973,840
Ex. 1020	Dave	U.S. Patent Pub. No. 2013/0108082
Ex. 1021	Berger CV	Curriculum vitae of Dr. Ronald Berger
Ex. 1022	Kim-KR	KR 10-2016-0162565 and certified translation thereof
Ex. 1023	Kim-KR-Pub.	KR 10-2018-0062654 and certified translation thereof
Ex. 1024	National Judicial Caseload Profile	U.S. District Courts – National Judicial Caseload Profile (accessed via https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0331.2022.pdf)
Ex. 1025	Complaint	Complaint for Patent Infringement, *Apple Inc., v. AliveCor, Inc.*, Case No. 4:22-cv-07608-HSG (N.D. Cal. 2022)

AliveCor, Inc. ("Petitioner") requests IPR of all 20 claims of U.S. Patent No. U.S. Patent No. 10,866,619 B2 ("the '619 Patent") (Ex. 1001).[1] Petitioner is filing parallel petitions separately challenging claims 1-10 of the '619 Patent (IPR2023-00948) and claims 11-20 of the '619 Patent (IPR2023-00949).

The Board should institute both petitions for three basic reasons. First, the claims cannot be addressed in one petition because of the number and length of the claims (which alone include 922 words toward the 14,000 word limit for a single petition) and because of the nature of the claims themselves. Second, the petitions are not duplicative and efficiently address the validity of the '619 Patent. Each petition challenges different claims. Moreover, the petitions cite essentially the same art against all claims, thus minimizing the burden on the Board from instituting both petitions.

I. REASONS WARRANTING ADDITIONAL PETITIONS

A. The Number and Specificity of the Claims Require Multiple Petitions to Sufficiently Address the Claims.

The '619 Patent has been asserted against Petitioner in co-pending litigation in the United States District Court for the Northern District of California (the "Litigation"). As discussed in in the petitions, a scheduling conference has not yet

[1] For simplicity, exhibits in parallel proceedings IPR2023-00948 and IPR2023-00949 are identical.

occurred in the Litigation, and Patent Owner has not yet served its initial infringement contentions. Given that the complaint alleges infringement of "at least" independent claim 1, Petitioner has filed for IPR of all claims of the '619 Patent.

A single petition addressing only independent claim 1 (and the claims that depend therefrom) would not be sufficient. The Litigation is relatively early in its proceedings, and Patent Owner has not yet identified even a preliminary list of asserted claims, or committed that it will not assert any of claims 11-20 later in the Litigation. Absent such a commitment, Petitioner has filed a second petition in parallel, to protect itself against the large number of claims of the '619 Patent.

Moreover, the nature of the claims themselves (in light of Patent Owner's vague infringement allegations) support the Petition's multiple unique grounds. Specifically, each of the challenged independent claims include limitations regarding the configuration of claimed flexible conduit and the seal:

Claim	**Limitation**
1	a portion of the flexible conduit is sandwiched between the seal and the sealing surface **or between** the seal and the enclosure.
11	a portion of the flexible conduit is sandwiched between the seal and the sealing surface of the retainer **or between** the seal and the surface of the opening.

16	wherein a portion of the flexible conduit is sandwiched between the seal and the button housing **<u>or between</u>** the seal and the surface of the opening.

Of particular relevance here, the limitations above each recite potential ***alternative*** configurations of the flexible conduit and seal. Moreover, challenged certain dependent claims flow from one alternative configuration or the other (*see, e.g.,* Claim 3, which explicitly requires the flexible conduit be located between the seal the claimed sealing surface ("the portion of the flexible conduit is positioned between the gasket [i.e., the seal] and the sealing surface of the button assembly")).

However, Patent Owner's Complaint does not explain which alternative configuration is asserted, nor preclude Patent Owner from changing its mind (Ex. 1025, ¶66). Instead, it merely recites claim language and includes an annotated figure which does not even attempt to identify which components are "sandwiched:"

66. AliveCor, at least when using the Accused Products, practices "a portion of the flexible conduit is sandwiched between the seal and the sealing surface or between the seal and the enclosure" as required by Claim 1 of the '619 Patent. These components are depicted in the KardiaMobile Card images below.

(*id*.). Patent Owner's Complaint is replete with similarly vague allegations, which require Petitioner to address all possible interpretations of the Challenged Claims (*see, e.g.,* Ex. 1025, ¶¶61-66) For example, Patent Owner appears to allege that an opening on the face of the accused products constitutes the "opening formed in a sidewall" of Challenged Claims 1 and 16. However, given that Patent Owner has not limited its allegations to only that interpretation, Petitioner is forced expend words addressing both this interpretation and the more traditional concept of a "sidewall."

B. The Petitions are Materially Different from Each Other and Efficiently Address the Validity of the '619 Patent.

The petitions are materially different. IPR2023-00948 addresses independent claim 1 and dependent claims 2-10 of the '619 Patent. IPR2023-00949 addresses (1) independent claim 11 and dependent claims 12-15, and (2) independent claim 16 and dependent claims 17-20. As such, each petition challenges different claims.

Furthermore, it would be efficient to institute both petitions, because both petitions rely on essentially the same art, which will significantly lower the burden associated with consideration of IPR2023-00949. As shown below, all grounds for all claims rely on four references: (1) Kim, (2) Jung, (3) Meyers, and (4) Chang.

C. The Petitions Do Not Constitute an Abuse of Process.

Other than Petitioner's two petitions discussed herein, there have been no petitions previously filed by any petitioner challenging the claims of the '619 Patent. As noted above, mapping the lengthy and numerous claims based on prior art

requires extensive discussion, and instituting review on both petitions will allow the efficient consideration of the same art against all of the challenged claims.

II. ORDERING OF THE PETITIONS

Petitioner requests the Board consider the petitions in the following order and not exercise its discretion to deny either. IPR2023-00948 includes Petitioner's best estimation of the claims Patent Owner will assert in the district court litigation.

Rank	Petition	Prior Art Ground	Claims
1	IPR2023-00948	Kim (Anticipation)	1, 5, 9-10
		Kim (Obviousness)	1-10
		Jung in view of Meyers	1, 3-10
		Chang	1-2, 6, 9
2	IPR2023-00949	Kim (Anticipation)	11, 14, 16, 19
		Kim (Obviousness)	11-14, 16-20
		Jung in view of Meyers	11-14, 16-17, 19-20
		Chang	11-17, 19

Date: June 7, 2023

By: /Christopher Douglas /
Christopher Douglas

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e), 42.105, the undersigned hereby certifies that true and correct copies of the above-captioned PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 10,866,619, all associated exhibits, and Petitioner's Power of Attorney were served in their entireties on June 7, 2023, upon the following parties via UPS Next Day Air®:

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