

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

K/S HIMPP,
Petitioner

v.

BRAGI GmbH,
Patent Owner

Case: IPR2023-01150
U.S. Patent No. 9,843,853

PATENT OWNER'S REVISED CONTINGENT MOTION TO AMEND

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2001	Declaration of Dr. Darrin Young, PhD	X
2002	CV of Dr. Darrin Young, PhD	X
2003	Declaration of Bradley Jarrett in Support of Motion for <i>Pro Hac Vice</i> Admission	X
2004	Biography of Bradley Jarrett	X
2005	Second Declaration of Dr. Darrin Young, PhD in Support of Patent Owner's Revised Contingent Motion to Amend	

I. INTRODUCTION

Bragi GmbH (“Patent Owner” or “PO”) submits this Revised Motion to Amend U.S. Patent No. 9,843,853 (“the ’853 Patent”). This Revised Motion to Amend (“Motion”) is contingent upon a finding by the Board in a final written decision that the Challenged Claims¹ are unpatentable. Should the Board make such a finding, PO respectfully requests that the Board grant this Revised Motion to Amend and issue the corresponding substitute claims presented herein.

II. STATEMENT OF REQUESTED RELIEF

Should the Board issue a final written decision that the Challenged Claims are not patentable over Petitioner’s cited prior art, PO respectfully requests that the Board grant this Motion with respect to each corresponding substitute claim, proposed Claims 22-42 to replace original Claims 1-21, respectively.

III. THE SUBSTITUTE CLAIMS MEET ALL STATUTORY AND REGULATORY REQUIREMENTS OF 35 U.S.C. § 316 and 37 C.F.R. § 42.121

A motion to amend must (1) propose a reasonable number of substitute claims, (2) that respond to a ground of unpatentability involved in the trial, (3) that do not enlarge the scope of the claims or introduce new matter, and (4) are not shown by a preponderance of the evidence to be unpatentable. *See* Memorandum re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) at 2;

¹ Petitioner challenges the patentability of claims 1-21 of the ’853 Patent (“Challenged Claims”).

35 U.S.C. § 316(d); 37 C.F.R. § 42.121. It is Petitioner’s burden to show that the substitute claims are unpatentable. *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 4 (PTAB Feb. 25, 2019) (precedential) (“*Lectrosonics*”).

A. Listing of Proposed Substitute Claims.

PO submits substitute claims as shown in Appendix A (the “Substitute Claims”) as required by 37 C.F.R. § 42.121(b).

B. The Number of Substitute Claims is Reasonable.

“There is a rebuttable presumption that a reasonable number of substitute claims per challenged claim is one (1) substitute claim.” *Lectrosonics* at 4. Here, PO proposes substitute claims 22-42 for original claims 1-21, respectively, which constitute a one-for-one substitution. This is reasonable and thus satisfies 35 U.S.C. § 316(d)(1)(B) and 37 C.F.R. § 42.121(a)(3). *See Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-00933, Paper 31 at 9 (PTAB Dec. 3, 2019); *see also Lectrosonics* at 45-46. The Board in its Preliminary Guidance found that PO’s proposal of no more than one substitute claim for each Challenged Claim was reasonable, and Petitioner has not argued otherwise. *See* Paper 24 at 4.

C. The Substitute Claims Respond to Patentability Grounds Involved in this Trial.

Proposed substitute claims 22-42 respond to the grounds asserted in the Petition (Paper 1) and Petitioner’s Opposition to Patent Owner’s Motion to Amend

(Petitioner’s Opposition) (Paper 23). For example, this Motion proposes adding certain limitations (discussed in detail below in Section VII) to those claims to distinguish them from Brown (Ex. 1007) (regarding claims 10 and 14 in Ground 1 of the Petition); Hain (Ex. 1004) (regarding claims 1-3 and 5 in Ground 2); Steinbrecher (Ex. 1006) (regarding claims 10 and 21 in Ground 3); Shaffer (Ex. 1003) and Hain (regarding claims 1-7 and 9 in Ground 4); Shaffer, Hain, and Sorensen (Ex. 1005) (regarding claims 4 and 6-8 in Ground 5); Shaffer and Steinbrecher (regarding claims 10-12, 14 and 16-21 in Ground 6); and Shaffer, Steinbrecher and Sorensen (regarding claims 11-13, 15 and 17-21 in Ground 7).² This Motion seeks to amend those claims to address Petitioner’s arguments raised in the Petition and Petitioner’s Opposition. *Compare* Petition, Ex. 1001, Petitioner’s Opposition (Paper 23), and Ex. 1017 *with* Appx. A (Proposed Substitute Claims). Further, as explained below in Section VII, these amendments directly overcome the grounds of unpatentability involved in this trial.

D. The Substitute Claims Do Not Broaden the Claim Scope or Introduce New Subject Matter.

“A motion to amend may not present substitute claims that enlarge the scope of the claims of the challenged patent or introduce new subject matter.”

² Petitioner’s Opposition cites an additional reference U.S. Patent Application Publication No. 2015/0200554 (“Marks”) for Grounds 1, 3, 6, and 7. PO’s substitute claims presented in this Motion no longer include limitations related to inductive charging, so Marks is no longer relevant to any of Petitioner’s Grounds.

Lectrosonics at 6-8 (citing 35 U.S.C. § 316(d)(3); 37 C.F.R. § 41.121(a)(2)(ii)). PO's proposed claims comply with both of these requirements.

1. The Substitute Claims Do Not Broaden Claim Scope

First, the proposed substitute claims retain all of their original features and only add narrowing elements. The proposed amendments rewrite each of claims 1-21, limiting the method and/or system by clarifying that a portion of the claimed wireless earpiece(s) fits within the user's ear canal opening, and the wireless earpieces are configured to read user biometrics.

These additions are made for the purpose of further distinguishing the claims over the prior art raised in the Petition and Petitioner's Opposition and therefore narrow the claim scope in compliance with 37 C.F.R. § 42.12(a)(2)(ii). *See Lectrosonics* at 7 (noting that "a proposed substitute claim adding a novel and nonobvious feature or combination to avoid the prior art in an instituted ground of unpatentability will not enlarge the scope of the claims.").

2. The Substitute Claims Do Not Introduce New Matter.

As required by 37 C.F.R. § 42.121(b), the proposed substitute claims are supported by the original non-provisional application and thus do not introduce new subject matter as required by 37 C.F.R. § 42.121(a)(2)(ii). The '853 Patent issued from U.S. Patent Application No. 15/245,031 ("the '031 Application"), which is found at pages 1-36 of Exhibit 1008. For the purposes of this Motion, PO

identifies below the portions of the '031 Application as providing support for the proposed amendments. In addition, PO submits the Second Declaration of Dr. Young (Ex. 2003). Dr. Young's Second Declaration and the cited portions of the '031 Application show that a person of ordinary skill in the art ("POSITA") would have understood, based on the disclosures of the '031 Application, that the inventor possessed the Substitute Claims as of August 29, 2015. Ex. 2003 at ¶ 21. Lastly, the written description of the '031 Application is sufficient to inform a POSITA how to both make and use the invention as recited in the proposed Substitute Claims. *Id.*

Exemplary citations for each limitation of the Substitute Claims are summarized below (and detailed in the Second Declaration of Dr. Young, *see id.*).

a) Support Regarding Added Limitations Common to Each Substitute Claim

The following features are additions to each substitute claim, and Dr. Young's testimony confirms that the inventor was in possession of these features (and each claim as a whole) at the time of filing the '031 Application. *See id.*

The '031 Application discloses a wireless earpiece(s), wherein a portion of the wireless earpiece(s) fit within the ear canal opening and the wireless earpiece(s) is configured to read user biometrics and wherein the smart case comprises a rechargeable battery configured to charge the wireless earpieces. *See* Ex. 1008 at [4:19-4:22], Fig. 1, 2, 4, [5:3-5:15], [6:6-6:20], [7:5-7:13], [7:27-8:8].

IV. THE LEVEL OF ORDINARY SKILL IN THE ART

In this motion, PO and its expert adopt Petitioner's description of the level of skill of a POSITA: at least a bachelor's degree in Electrical Engineering, or equivalent experience, and one to two years of experience in the field of wireless electronic devices and battery systems, particularly wireless earpieces such as wireless headphones and hearing aids. Petition, 17. *See also* Ex. 2001 at ¶¶ 39-40.

V. THE SCOPE AND CONTENT OF THE PRIOR ART

PO presumes Petitioner has set forth what it believed to be the closest prior art in its Petition and in its Opposition to PO's Motion to Amend. As no prior art of record from the original prosecution of the '031 Application is cited by Petitioner as a basis for unpatentability in this IPR proceeding other than Shaffer, it is undisputed that such prosecution-related prior art of record does not disclose or suggest the elements of the originally issued claims (as confirmed by the USPTO's issuance of the '853 Patent over that prior art). Similarly, no prior art of record describes or suggests the additional elements recited in the Substitute Claims, as described below.

VI. CLAIM CONSTRUCTION

Under 37 C.F.R. § 42.100, claim terms should be given "their ordinary and customary meaning" as would be understood by a POSITA in question at the time of the invention, in light of the claim language, the specification, and the prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005).

The Board only construes the claims when necessary to resolve the underlying controversy. *Toyota Motor Corp. v. Cellport Systems, Inc.*, IPR2015-00633, Paper No. 11 at 16 (Aug. 14, 2015). At this stage, there is not currently a construction-related dispute. Paper 12 at 6; Ex. 2001 at ¶ 48; Ex. 2003 at ¶ 16; Petition at 13.

VII. THE SUBSTITUTE CLAIMS ARE PATENTABLE OVER THE ART

Although PO does not bear the burden of persuasion or production regarding the patentability of the substitute claims, PO nevertheless sets forth reasons why the art does not teach or suggest the amended subject matter. *Aqua Products, Inc. v. Matal*, 872 F.3d 1290, 1296 (Fed. Cir. 2017). This motion and Dr. Young’s Second Declaration (Ex. 2003 at ¶¶ 21-31) provide support.

A. Ground 1 – Brown

The Petition states that Brown discloses claims 10 and 14 (Petition at 18), which corresponds to proposed substitute claims 31 and 35, respectively. However, Brown does not disclose a wireless earpiece(s) “configured to read user biometrics.”³ Brown does not state the claimed hearing aids are configured to read

³ The substitute claims include the limitation “wherein a portion of the wireless earpiece fits within the ear canal opening.” *See, e.g.*, Appx A, substitute claim 22. Specifying the positioning of the earpiece in this way, clarifies what portion of the ear is relevant (ear canal) and how much of the wireless earpiece should be within the ear, thus undermining Petitioner’s previous contentions that limitations relating to the earpiece being “in-ear” are indefinite. *See* Petitioner’s Opposition at 6; Preliminary Guidance at 7.

user biometrics. In fact, Brown does not mention biometrics at all. *See* Ex. 2003 ¶¶ 21, 24-25.

Proposed substitute claim 35 depends from proposed substitute claim 30, and because Brown fails to disclose the elements of Claim 30 it similarly fails to disclose the elements of its dependent claims. *Id.* 25.

For these reasons, based on the proposed substitute claims, Ground 1 relying solely on Brown fails in its entirety.

B. Ground 2 – Hain

The Petition states that Hain discloses claims 1-3 and 5 (substitute claims 22-24 and 26). But Hain does not disclose a wireless earpiece(s) “configured to read user biometrics.” Hain does not state the claimed hearing aids are configured to read user biometrics. Hain does not mention biometrics at all. *See* Ex. 2003 ¶¶ 26-28. Therefore, Hain does not disclose substitute claims 22-24 and 26.

C. Ground 3 – Steinbrecher

8. The Petition states that Steinbrecher discloses claims 10 and 21 (Petition, 30), which corresponds to proposed substitute claims 31 and 42, respectively. Steinbrecher does not disclose a wireless earpiece(s) “configured to read user biometrics,” as required by the substitute claims. The ’031 Application for the ’853 Patent teaches “[t]he wireless earpieces 142, 144 may be configured to play music or audio, receive and make phone calls or other communications, read

user biometrics and actions (e.g., heart rate, motion, sleeping, etc.).” Ex-1008 at [4:20-4:22], [7:27-8:8]. Steinbrecher does not disclose reading a user’s biometrics, nor does it even mention biometrics. *See* Ex. 2003 ¶ 29. Therefore, Steinbrecher does not anticipate proposed substitute claims 31 and 42. *See id.*

D. Grounds 4-5

Grounds 4-5 rely on a combination of references, which include Shaffer, Hain, and Sorenson. However, none of these references discloses a wireless earpiece(s) “configured to read user biometrics,” as claimed by the proposed substitute claim 22 (the substitute for original claim 1). Claims 2-9 (proposed substitute claims 23-30) each depend from claim 1 (proposed substitute claim 22), and fail for the same reasons as discussed with respect to claim 1—none of Petitioner’s references discloses a wireless earpiece(s) “configured to read user biometrics.” Ex. 2003 at ¶ 30.

Therefore, Grounds 4 and 5 fail because Shaffer, Hain, and Sorenson do not disclose a wireless earpiece(s) “configured to read user biometrics.” *See id.*

E. Grounds 6-7

Grounds 6-7 rely on a combination of references, including some combination of Shaffer, Steinbrecher and Sorensen. *See* Petition, 42-92. Grounds 6-7 challenge claims 10-21 (corresponding to proposed substitute claims 31-42). However, none of these references disclose a wireless earpiece(s) “configured to

read user biometrics,” as required by proposed substitute claims 31 and 42 (the independent claims challenged by Grounds 6-7). Ex. 2003 at ¶ 31.

These claim limitations are required by independent claims 31 and 42, and therefore, dependent claims 32-41 fail for the same reason and the claims from which they depend. *See id.*

Therefore, Grounds 6 and 7 fail because none of the cited references disclose a wireless earpiece(s) “configured to read user biometrics.”

VIII. CONCLUSION

PO requests the Board grant this motion to amend as to the corresponding substitute claims for each of original claims 1-21.

Date: August 30, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REVISED CONTINGENT MOTION TO AMEND** and supporting materials has been served on Petitioner via email on the following counsel of record for Petitioner:

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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S REVISED CONTINGENT MOTION TO AMEND** complies with the page limits of § 42.24(a) because it does not contain more than 25 pages. This paper also complies with the typeface requirements of 37 C.F.R.42.6(a)(2)(ii) and the type style requirements of 37 C.F.R.42.6(a)(2)(iii) and (iv).

APPENDIX A – SUBSTITUTE CLAIMS

Claim 22. [Proposed substitute for claim 1] A method for managing wireless earpieces, comprising:

powering circuitry of the wireless earpieces utilizing a high ~~power~~ power mode in response to detecting a magnetic field is not applied to one or more of the wireless earpieces;

wherein a portion of the wireless earpieces fits within the ear canal opening and the wireless earpieces are configured to read user biometrics, and

altering the power sent to the circuitry of the wireless earpieces to a low power mode in response to detecting a magnetic field is applied to one or more of the wireless earpieces.

Claim 23. [Proposed substitute for claim 2] The method of claim ~~1~~22, further comprising:

operating the wireless earpieces utilizing an onboard battery in response to detecting the magnetic field is not applied to one or more of the wireless earpieces.

Claim 24. [Proposed substitute for claim 3] The method of claim ~~1~~22, further comprising:

charging an onboard battery of the wireless earpieces in response to detecting a magnetic field is applied to the wireless earpieces.

Claim 25. [Proposed substitute for claim 4] The method of claim ~~4~~22, wherein the magnetic field is applied by a magnet of a smart case configured to receive the wireless earpieces.

Claim 26. [Proposed substitute for claim 5] The method of claim ~~4~~22, wherein the magnetic field is detected by a reed switch of the wireless earpieces.

Claim 27. [Proposed substitute for claim 6] The method of claim ~~4~~22, further comprising:

coupling the wireless earpieces to interfaces of a smart case, wherein the smart case comprises a rechargeable battery configured to charge the wireless earpieces and applies a magnetic field to one or more of the wireless earpieces.

Claim 28. [Proposed substitute for claim 7] The method of claim ~~4~~22, wherein the magnetic field is detected by a reed switch integrated in magnetic contacts that interface with a smart case, the smart case comprising a rechargeable battery configured to charge the wireless earpieces, for securing the wireless earpieces.

Claim 29. [Proposed substitute for claim 8] The method of claim ~~4~~22, further comprising:

synchronizing data between the wireless earpieces and a smart case, the smart case comprising a rechargeable battery configured to charge the wireless earpieces, in response to detecting the magnetic field.

Claim 30. [Proposed substitute for claim 9] The method of claim ~~4~~22, wherein the low power mode is a power saver mode.

Claim 31. [Proposed substitute for claim 10] A wireless earpiece, comprising:

circuitry operating the wireless earpiece, wherein a portion of the wireless earpiece fits within the ear canal opening and the wireless earpiece is configured to read user biometrics, and

a battery powering the circuitry of the wireless earpiece; and

a reed switch connecting the battery to the circuitry, wherein:

the reed switch connects the circuitry to the battery when a magnetic field is not detected; ~~and wherein~~

the reed switch disconnects the circuitry from the battery when a magnetic field is detected.

Claim 32. [Proposed substitute for claim 11] The wireless earpiece of claim ~~10~~31, ~~wherein the magnetic field is applied by a smart case;~~

wherein the smart case is configured to receive the wireless earpiece,

and powers the wireless earpiece when received in the smart case.

Claim 33. [Proposed substitute for claim 12] The wireless earpiece of claim ~~10~~31, further comprising:

magnetic contacts in connection with the circuitry and the battery that interface with a smart case to charge the battery.

Claim 34. [Proposed substitute for claim 13] The wireless earpiece of claim ~~40~~33, wherein the wireless earpiece synchronizes data with the smart case.

Claim 35. [Proposed substitute for claim 14] The wireless earpiece of claim ~~40~~31, wherein the wireless earpiece alters a power level of the wireless earpiece in response to the reed switch detecting the magnetic field.

Claim 36. [Proposed substitute for claim 15] The wireless earpiece of claim ~~40~~31, wherein the wireless earpiece updates software of the wireless earpiece in response to detecting the magnetic field.

Claim 37. [Proposed substitute for claim 16] The wireless earpiece of claim ~~40~~31, wherein the circuitry includes logic that alters a power state of the wireless earpiece in response to detecting the magnetic field and a startup process in response to not detecting the magnetic field after having detected the magnetic field.

Claim 38. [Proposed substitute for claim 17] A system comprising the wireless earpiece of claim ~~40~~31, wherein the wireless earpiece is a left earpiece and a smart case for charging the left earpiece, the smart case comprising:

a smart case housing;

a first receptacle for receiving the left earpiece disposed within the smart case housing;

a second receptacle for receiving a right earpiece disposed within the smart case housing;

a first interface associated with the first receptacle for electrically connecting the smart case to the left earpiece;

a second interface associated with the second receptacle for electrically connecting the smart case to the right earpiece;

an intelligent control disposed within the smart case housing and operatively connected to the first interface and the second interface.

Claim 39. [Proposed substitute for claim 18] The system of claim ~~17~~38 wherein the smart case further comprises a display.

Claim 40. [Proposed substitute for claim 19] The system of claim ~~18~~39 wherein the display is moveably connected to the smart case to transition from a first position to a second position.

Claim 41. [Proposed substitute for claim 20] The system of claim ~~19~~40 wherein the smart case further comprises at least one manual input for receiving user input to provide additional functionality.

Claim 42. [Proposed substitute for claim 21] A system comprising:

a first wireless earpiece, comprising:

circuitry operating the first wireless earpiece;

wherein a portion of the wireless earpiece fits within the ear canal opening and the wireless earpiece is configured to read user biometrics, and

a battery powering the circuitry of the first wireless earpiece; and

a switch connecting the battery to the circuitry, wherein the switch connects the circuitry to the battery when a magnetic field is not detected, and wherein the switch disconnects the circuitry from the battery when a magnetic field is detected;

a smart case for charging the first wireless earpiece and a second wireless earpiece, the smart case comprising:

a smart case housing;

a first receptacle for receiving the first wireless earpiece disposed within the smart case housing;

a second receptacle for receiving the second wireless earpiece disposed within the smart case housing;

a first interface associated with the first receptacle for electrically connecting the smart case to the first wireless earpiece;

a second interface associated with the second receptacle for electrically connecting the smart case to the second wireless earpiece;

an intelligent control disposed within the smart case housing and operatively connected to the first interface and the second interface.