

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INDUCTEV, INC.
Petitioner,

v.

WITRICITY CORPORATION,
Patent Owner.

Case IPR2023-01182
Patent 8,461,719

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY

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I. Petitioner waived *Advanced Bionics* Part 2 arguments for Grounds 3 and 4.

As noted in PO's Preliminary Response, for grounds 3 and 4, Petitioner failed to address *Advanced Bionics Part 2*. Accordingly, regarding grounds 3 and 4, Petitioner waived any argument that it met its burden for *Advanced Bionics* Part 2 (that the Examiner made a material error evaluating the references). *Intelligent Bio-Systems v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1366 (Fed. Cir. 2016).

II. For Claim 16 (Grounds 1 and 3), Petitioner admits that Pohjonen is cumulative of Cook-554 and the General Knowledge of a POSA.

Petitioner's Reply does not change the fact that the Petition includes only art that the Examiner expressly applied or considered, or that is substantially similar to and cumulative of that art that Petitioner itself asserts was understood by a person of skill in the art ("POSA"). Petitioner only seeks to invalidate two claims of the '719 Patent – Claims 16 and 17. For both of those claims, Petitioner asserts that one reference alone – Cook-554 – makes those claims invalid as obvious. *See* Petitioner's grounds 1 and 2. But the pre-grant publication of Cook-554 was considered by the Examiner. More importantly, Cook-554 shares inventors and similar disclosures with a reference not only considered but also specifically addressed by the Office – Cook-492.

By not addressing elements 16[a] to 16[d], Petitioner concedes that Cook-554 is cumulative of the art the Examiner not only considered but also discussed.

But Petitioner also relies on Cook-554 alone for the last element of independent claim 16, namely the low loss tangent enclosure [16e]. Petitioner cites Cook-554 for teaching integration of a receiving resonant antenna within a *portable device*, and argues that a POSA would have found element [16e] obvious in light of Cook-554, or Cook-554 with the knowledge of a POSA. Pet. at 32-35 (and citing Allen Decl. 149-150). But Cook-492 (discussed by the Examiner) also discloses integration of a receiving resonant antenna within a portable device. Cook-492 at [0025] (explaining that the load of its receiver “can be any type of load, for example a resistive load such as a light bulb, or an electronic device load such as an electrical appliance, a computer, a rechargeable battery, a music player ...”). Further, like Cook-554, Joannopoulos (also discussed by the Examiner), describes applications of its wireless receiver *inside portable devices* such as computers that are necessarily enclosed. Joannopoulos, 4:21-29. Therefore, the single reference that Petitioner relies upon to argue that both challenged Claims 16 and 17 are obvious – Cook-554 and its relevant disclosures – are the same or substantially the same as the art (Cook-492 (with same inventors) and Joannopoulos) and disclosures previously considered and discussed by the Examiner. *Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01533, Paper 14 at 12-13 (PTAB Mar. 27, 2023) (denying institution where, among other things, shared inventors and disclosures largely overlapped).

Petitioner also asserts that – even without Cook-554 – the knowledge of a POSA would have found it obvious to enclose a second resonator in a low loss tangent material (element [16e]). Petition at 36-37 (and citing Allen Decl. 154); Petition at 63 (and citing Allen Decl. 217-218). By this argument, and because an Examiner is considered a POSA, Petitioner admits that element [16e] (using a low loss tangent material) was presumptively known to, and therefore considered by, the Examiner. *See* PO Prelim. Response at 11 (citing cases).

As explained in PO’s Preliminary Response, Petitioner asserts that Pohjonen is an “optional” reference for ground 1 because both Cook-554 *alone* or the knowledge of a POSA *alone* made the low loss tangent material element obvious. Thus, regarding Claim 16 in both grounds 1 and 3, by Petitioner’s own *admissions* and arguments, Pohjonen is cumulative of both (1) Cook-554 (which is cumulative of Cook-492 and Joannopoulos, both discussed by the Examiner); or (2) the knowledge of a POSA.¹

III. For Claim 17 (Grounds 2 and 4), Petitioner relies on references disclosing flat panels that are cumulative of Cook-492 and at least 8 additional references considered by the Examiner.

Petitioner argues that Claim 17 is obvious in view of Cook-554 alone, and/or Lee with Cook-523 for teaching each of the six elements. During prosecution of

¹ *See* cases cited in Patent Owner’s Preliminary Response at 11.

the application that became the ‘719 Patent, the Examiner found Cook- 492 discloses the same or substantially the same elements as [17-pre]-[17d], and including the network of capacitors of element [17e]. Office Action of Jun. 28, 2012, pp. 3-4 (Ex. 2002) and PO Prelim. Response at 13-14. Element [17e] also requires that at least one of the resonators includes a coil of a plurality of turns of a conducting material that are in a common plane.

In ground 2, Petitioner asserts that Cook-554 *alone* discloses these elements in the Wireless Power Bridge embodiment that includes a transmit antenna unit (source resonator) having a “multi-turn loop (coil)” that is a flat panel with three turns in the same plane Petition at 44 (citing Cook-554 13:12-16 and 4:39- 42, CProv 26, 42, and Allen Decl. 174-175). But Cook-554 is the same as or substantially similar to Cook-492 (considered and discussed by the Examiner), which also discloses a flat panel antenna that includes a multi-turn loop. Compare, for example, Fig. 14 of Cook-554 with Fig. 7 of Cook-492 (included in PO Prelim. Response at 15). As shown in Fig. 7, Cook-492 discloses a receiver antenna including a plurality of turns of a material 700 mounted on a substrate 705, and including a capacitor 710 attached to the coil material. Cook-492, ¶ [0047].

Moreover, Cook-554 is the same as or substantially similar to *no less than eight other pre-grant publications that share two common inventors* (i.e., Nigel Cook and Hanspeter Widmer) *with Cook-554*, that also disclose a flat antenna that

includes a multi-turn loop. Further, the Examiner considered each reference. In addition, Widmer -937 discloses flat panels (Fig. 6) that are substantially similar (if not identical) to Fig. 14 of Cook-554.

Petitioner asserts that the flat panels in Cook-554 *alone* discloses the size limitation (characteristic thickness would be much less than characteristic size), or it would have been obvious to a POSA even though Petitioner admits that Cook-554 does not provide or state any size dimensions. Instead, Petitioner argues that a POSA would have understood the flat panel's characteristic thickness would have been much less than their characteristic size. Petition at 48 (and citing Allen Decl. 182). In ground 4, Petitioner asserts that a “substantially flat” coil disclosed in Lee (again, without stating any size dimensions and admitting that it is unclear whether the drawings are to scale) also taught to a POSA this size limitation element [17f]. Pet. at 79-80 (and citing Allen Decl. 263-264). As explained above, Cook-492 (evaluated by the Examiner), Cook-224 (an earlier pre-grant publication of Cook-492), and **at least eight other pre-grant publications considered by the Examiner also disclose a flat antenna that includes a multi-turn loop and in figures that are *nearly identical to Fig. 14 of Cook-554* and substantially similar to Lee Fig. 12 relied on by Petitioner.** Thus, those references are cumulative of the art discussed and considered by the Examiner.

Dated: January 5, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is certified that a copy of the *Patent Owner's Sur-reply to Petitioner's Reply* has been served on Petitioner as provided in 37 C.F.R. § 42.6(e) via electronic mail transmission addressed to the persons at the addresses of record as follows:

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