

Filed on behalf of: InductEV, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INDUCTEV, INC.,
Petitioner,

v.

WITRICITY CORPORATION,
Patent Owner.

Case IPR2023-01208
Patent 8,912,687

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

TABLE OF AUTHORITIES**Page(s)****CASES**

<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (Feb. 13, 2020)	1, 3, 5
<i>Apple Inc. v. Telefonaktiebolaget LM Ericsson,</i> IPR2022-00458, Paper 7 (Aug. 18, 2022)	5
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8 (Dec. 15, 2017)	5
<i>Code200, UAB v. Bright Data Ltd.,</i> IPR2022-00353, Paper 8 (July 1, 2022)	1
<i>Eyenovia, Inc. v. Sydnexis, Inc.,</i> IPR2022-00963, Paper 7 (Nov. 8, 2022)	4
<i>Google LLC v. Valtrus Innovations Ltd.,</i> IPR2022-01197, Paper 9 (Jan. 3, 2023)	4
<i>Ivantis, Inc. v. Sight Sciences, Inc.,</i> IPR2022-01533, Paper 14 (Mar. 27, 2023)	4
<i>Liquidia Techs., Inc. v. United Therapeutics Corp.,</i> IPR2021-00406, Paper 18 (Aug. 11, 2021)	1
<i>Lyft, Inc. v. RideShare Displays, Inc.,</i> IPR2021-01600, Paper 7 (Apr. 11, 2022)	5
<i>Microsoft Corp. v. ThroughPuter, Inc.,</i> IPR2022-00757, Paper 10 (Nov. 1, 2022)	4
<i>Parse Bioscis., Inc. v. 10X Genomics, Inc.,</i> IPR2023-00876, Paper 7 (Oct. 13, 2023)	3
<i>Shenzhen Chic Elecs. Co. v. Pilot, Inc.,</i> IPR2023-00810, Paper 12 (Nov. 8, 2023)	1
<i>Yita LLC v. MacNeil IP LLC,</i> IPR2023-00172, Paper 12 (June 13, 2023)	3

STATUTES

35 U.S.C. § 325(d)	1, 4, 5
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Exhibit List

Ex.	Description
1001	U.S. Patent No. 8,912,687 B2 (“’687 patent”)
1002	U.S. Patent No. 8,912,687 B2 File History (“’687 FH”)
1003	Declaration of Mark Allen in Support of Petition for <i>Inter Partes</i> Review (“Allen Decl.”)
1004	Curriculum Vitae of Mark Allen
1005	U.S. Patent Publication No. 2010/0036773 A1 (“Bennett”)
1006	U.S. Provisional Application No. 61/086,380 (“Bennett Provisional” or “BProv”)
1007	U.S. Patent Application Publication No. 2009/0299918 A1 (“Cook”)
1008	U.S. Patent Application Publication No. 2003/0115467 A1 (“Aull”)
1009	U.S. Patent No. 8,266,075 B2 (“Ambrosio”)
1010	U.S. Patent No. 7,602,143 B2 (“Capizzo”)
1011	U.S. Patent No. 8,547,069 B2 (“Jang”)
1012	U.S. Patent No. 5,462,439 (“Keith”)
1013	U.S. Patent No. 5,821,731 (“Kuki”)
1014	U.S. Patent No. 7,804,272 B2 (“Morita”)
1015	U.S. Patent No. 8,030,888 B2 (“Pandya”)
1016	H. Sakamota et al., <i>Large Air-Gap Coupler for Inductive Charger</i> , 35 IEEE Transactions on Magnetics 3526 (1999) (“Sakamoto”)
1017	Estill I. Green, <i>The Story of Q</i> , in 43 Am. Scientist 584 (1955) (“Story of Q”)
1018	Chwei-Sen Wang, <i>Design Considerations for Inductively Coupled Power Transfer Systems</i> (2004) (Ph.D. thesis, Univ. of Auckland) (“Wang”)

Ex.	Description
1019	U.S. Patent No. 8,880,889 B1 (“Ward”)
1020	Frederick Emmons Terman, <i>Electronic and Radio Engineering</i> (4th ed. 1955) (“Terman”)
1021	U.S. Patent No. 9,774,086 B2 (“Cook-086”)
1022	U.S. Patent No. 8,749,334 B2 (“Boys”)
1023	David H. Staelin et al., <i>Resonators</i> , in <i>Electromagnetic Waves</i> 336 (1994) (“Staelin”)
1024	U.S. Patent No. 5,745,574 (“Muftic”)
1025	U.S. Patent No. 5,815,573 (“Johnson”)
1026	U.S. Patent No. 6,240,187 B1 (“Lewis”)
1027	U.S. Patent No. 6,442,688 B1 (“Moses”)
1028	U.S. Patent No. 6,718,470 B1 (“Adams”)
1029	U.S. Patent No. 7,741,734 B2 (“Joannopoulos”)
1030	<i>InductEV Inc. v. Witricity Corp.</i> , No. IPR2021-01165, Paper 41 (Mar. 6, 2023)
1031	File History for Patent Application No. 13/789,860 (“13/789860 FH”)

Discretionary denial is not warranted here. The Petition sets forth that Claims 1-18 of the '687 patent are unpatentable over Cook (Ex. 1007) in view of Bennett (Ex. 1005). Pet. 21-67. Patent Owner does not dispute any of the Petition's patentability arguments on the merits at this stage, arguing for denial only under 35 U.S.C. § 325(d). But while the '687 patent lists Cook and Bennett on its face, neither the Examiner nor Patent Owner discussed them—or any other prior art reference—during prosecution. '687 FH 798 (Notice of Allowance). Thus, “the record of the Office's previous consideration of the art is not well developed or silent,” and the Petition's undisputed analysis shows that the Examiner erred by “misapprehending or overlooking specific teachings of the relevant prior art.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 10, 8 nn.9-10 (Feb. 13, 2020) (precedential); *Shenzen Chic Elecs. Co. v. Pilot, Inc.*, IPR2023-00810, Paper 12 at 21 (Nov. 8, 2023) (Petitioner “has adequately shown that the Office erred” where “the record does not reflect any substantive evaluation of [the art] in an Office action”); *Liquidia Techs., Inc. v. United Therapeutics Corp.*, IPR2021-00406, Paper 18 at 19 (Aug. 11, 2021) (similar); *Code200, UAB v. Bright Data Ltd.*, IPR2022-00353, Paper 8 at 10 (July 1, 2022) (similar).

A comparison of the Notice of Allowance for the '687 patent to the Petition's patentability arguments demonstrates how the Examiner materially erred.

First, Claims 1-6 were allowed because “none of the prior art of record”

purportedly disclosed “a vehicle powering wireless receiver for use with a first electromagnetic resonator coupled to a power supply as recited in claim 1, in combination with the remaining claimed features.” ’687 FH 798. But Cook disclosed an “electrically powered automobile” including “at least one magnetic resonant antenna” that receives power wirelessly from a “charger 150”—which includes a “coil 152” and “capacitor 154” forming a first electromagnetic resonator—coupled to a “charging circuit 156” (power supply). Cook Fig. 1, [0009]-[0013], cls. 6, 13; Pet. 50-52; *see also* Pet. 30-33, 41-43. And the Cook/Bennett combination rendered obvious the remaining claimed features. *See generally* Pet. 30-67.

Second, Claims 7-12 were allowed because “none of the prior art of record” purportedly disclosed “a power source for wirelessly providing power to a wireless receiver of an at least partially electrically powered vehicle as recited in claim 7, in combination with the remaining claimed features.” ’687 FH 798. That was error because Cook disclosed a “charging circuit” that “produces signal of appropriate frequency for magnetic transmission” so an electrically powered vehicle “may receive power from that magnetic field, and hence be charged thereby.” Cook [0013], [0009]-[0011]; Pet. 54-56. And the Petition establishes the Cook/Bennett combination taught the remaining features of Claims 7-12. Pet. 55-67.

Finally, the Examiner allowed Claims 13-18 because “none of the prior art of record” purportedly disclosed “a vehicle wireless power system as recited in claim

13, in combination with the remaining claimed features.” ’687 FH 798. But as the foregoing discussion illustrates, the Cook/Bennett combination taught the claimed vehicle wireless power system, and the Petition confirms it. Pet. 30-50, 56-67.

Patent Owner does not dispute any of the Petition's merits, arguing only that the Examiner must have considered the combined Cook/Bennett teachings because they were submitted in an IDS. *See* POPR 1, 4-6; ’687 FH 573. That does not explain the Examiner's material error in overlooking those teachings when issuing the claims, which the Petition shows by explaining for each claim how the Cook/Bennett combination renders that claim obvious. *Advanced Bionics* at 8-9. Indeed, while Cook and Bennett were “cited in an IDS,” they were not the “basis of a rejection,” nor did the Examiner “comment on any of these references in the Notice of Allowance,” both of which “weigh in favor of a finding that an error material to patentability occurred during prosecution.” *Yita LLC v. MacNeil IP LLC*, IPR2023-00172, Paper 12 at 45-46 (June 13, 2023). And because the prosecution history contains no discussion of Cook, Bennett, or any other reference, no “issue [was] raised, argued, or overcome regarding the specific [prior art] teachings relied upon[.]” *Parse Biosci., Inc. v. 10X Genomics, Inc.*, IPR2023-00876, Paper 7 at 13 (Oct. 13, 2023).

The lack of substantive evaluation of any specific prior art reference during the ’687 patent's prosecution also expressly distinguishes Patent Owner's cited

cases. For example, in *Microsoft Corp. v. ThroughPuter, Inc.*, the Board stated that prior art relied on in a petition need not appear in “a rejection” for § 325(d) only to highlight the fact that the examiner had cited and expressly discussed the content of the petition's primary reference, Nollet, in the Notice of Allowance. IPR2022-00757, Paper 10 at 21 (Nov. 1, 2022); POPR 3, 5. That is inapplicable here because, for the '687 patent, the Examiner did not comment on Cook or Bennett (or any other reference) at all—neither in a rejection nor in the Notice of Allowance. '687 FH 798.

Patent Owner's reliance on *Ivantis, Inc. v. Sight Sciences, Inc.* (POPR 6 n.5), *Google LLC v. Valtrus Innovations Ltd.* (POPR 6), and *Eyenovia, Inc. v. Sydnexis, Inc.* (POPR 4, 6) are similarly misplaced. In *Ivantis*, the petition relied on art that overlapped with those “previously discussed by and presented to the Office.” IPR2022-01533, Paper 14 at 11-14 (Mar. 27, 2023). In *Google*, the petition relied on a reference that was substantially the same as one the Examiner discussed. *See* IPR2022-01197, Paper 9 at 23 (Jan. 3, 2023). And in *Eyenovia*, the petition's references were cumulative of what the Examiner specifically addressed. *See* IPR2022-00963, Paper 7 at 18-19 (Nov. 8, 2022). In contrast with all of these cases, the prosecution history for the '687 patent shows *no* substantive evaluation of *any* prior art, let alone Cook and Bennett, and the Petition demonstrates how the Examiner overlooked their pertinent teachings. *Supra* 1-3.

In addition to overlooking Cook and Bennett, the Petition also demonstrates

how the Examiner erred by presenting new evidence in a declaration from an expert, Dr. Allen. *See generally* Ex. 1003. Patent Owner does not address Dr. Allen's testimony specifically, instead categorically asserting an "Examiner is considered a POSA" and so *any* expert's declaration "does not add anything to what the Examiner presumptively knew." POPR 3, 5-6. That argument directly contradicts step 2 of *Advanced Bionics*, which considers "the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments." *Advanced Bionics* at 9 n.10 (quoting *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential in relevant part)). Here, Dr. Allen's testimony was not previously before the Office and provides helpful insight from a POSA regarding the state of the art, the scope and content of Cook and Bennett, and how and why a POSA would have combined them. *See, e.g., Apple Inc. v. Telefonaktiebolaget LM Ericsson*, IPR2022-00458, Paper 7 at 12-13 (Aug. 18, 2022) (declining to deny institution under § 325(d) because Petitioner's expert declaration was "new evidence"); *Lyft, Inc. v. RideShare Displays, Inc.*, IPR2021-01600, Paper 7 at 15-16 (Apr. 11, 2022) (same).

For the above reasons, the Board should not exercise its discretion to deny institution under § 325(d). And because the Petition's merits on patentability are un rebutted, trial should be instituted.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 29th day of December, 2023, a true and correct copy of the foregoing **Petitioner's Reply to Patent Owner's Preliminary Response** was served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

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