

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

RJ TECHNOLOGY LLC,
Patent Owner.

Case IPR2023-01350
Patent No. 7,749,641

PATENT OWNER'S SUR-REPLY

As authorized by the Board on January 8, 2024, Patent Owner RJ Technology LLC (“Patent Owner”) responds to Petitioner Apple Inc.’s (“Apple”) January 12, 2024 Reply to Patent Owner’s Preliminary Response. Paper 8.

Apple’s Reply confirms that in its opinion, the four references it relies upon for its Petition (Yamaki, Sakamoto, Yasunami, and Koyama) contain the same disclosure as the three references (Idota, Tanaka, and Kobayashi) the Examiner considered during prosecution. Despite this fact, Apple now asks the Board to reopen the Examiner’s previous determination simply because the order which Apple is asking those teachings to be considered is different, i.e., because the prosecution allegedly only considered “whether it would have been obvious to modify [a] battery [having] a particular ratio of positive and negative electrode materials[] to operate with an increased charge cut-off voltage,” whereas the Petition presents the two teachings in the reverse order. Paper 8, 2-3. Petitioner’s assertion fails as a matter of fact and law.

The Federal Circuit has long held that rejection “stated to be on A in view of B” does not constitute a different ground from one based “on B in view of A,” as an examiner of course must consider the two references as a whole. *See In re Bush*, 296 F.2d 491, 496 (CCPA 1961) (citing *In re Cowles*, 156 F.2d 551, 554 (CCPA 1946)); *see also Schwendimann v. Neenah, Inc.*, 82 F.4th 1371, 1384 (Fed. Cir. 2023) (citing a series of cases, which all hold that “characterizing references as

‘primary’ and ‘secondary’ is merely a matter of presentation with no legal significance.”). The MPEP concludes similarly: “If the examiner’s answer changes the order of references ... and relies on the same teachings of those references to support the 35 U.S.C. 103 rejection, then the rejection does not constitute a new ground of rejection.” MPEP §1207.03(a). In some narrow areas where courts have held that designating a reference as “primary” may have legal significance—for example, cases involving modifying a chemical compound based on a lead compound—courts require the challenger to demonstrate by clear and convincing evidence that a POSA “would have had a reason to select a proposed lead compound ... over other compounds in the prior art.” See *Daiichi Sankyo Co., Ltd. v. Matrix Lab’ys, Ltd.*, 619 F.3d 1346, 1354 (Fed. Cir. 2010) (emphasis added). The Petition provides no such basis here, let alone a clear and convincing one.

As an initial matter, the Examiner’s Reasons for Allowance are clear that he considered all three prior art references together and found that “there is nothing taught by the prior art of record to reasonably arrive at the claimed configuration.” Ex. 1002, 23; see also *id.* (“The closest prior art of record ([Idota], [Tanaka], [Kobayashi]) do not anticipate or suggest or render obvious the invention as recited in the independent claims”). The Examiner did not state that the order of the presentation was at all relevant to his allowance of the application, but instead addressed the prior art as a whole. Accordingly, there is no basis for Apple’s

assertion that the Examiner used any particular order to allow the '641 Patent over the prior art. *See In re Bush*, 296 F.2d at 496 (finding the order of presentation is “of no significance,” and recommending an examiner to state reasons for rejection “without formal alinement of the references”). Apple’s authority, *In re Mouttet*, 686 F.3d 1322, 1333 (Fed. Cir. 2012), is fully in accord as it holds—relying upon *Bush*—that the order has “no legal significance.” Although *Mouttet* speculated that “there may be some cases” where “factual determinations inhere in such characterization of prior art references,” the court was clear that “this is not one.” As explained above, this case is not one either.

Indeed, Apple concedes that its Petition is premised upon the same teachings as those considered by the Examiner during prosecution, albeit from new references. The Reply concedes that the Examiner considered that a battery could allegedly have the specific ratio of positive electrode material to negative electrode material: “The Examiner cited to Idota as teaching a battery having a ‘ratio of the equivalent amount of the anode (negative electrode) active material to that of the cathode (positive electrode) active material [of] larger than 1...’” Paper 8, 2. The Petition cites Sakamoto and Koyama for this exact teaching. Paper 2, 10 (“The amounts of positive and negative electrode active material in the combination battery are set based on Sakamoto such that ‘the reversible capacities of the positive electrode and the negative electrode’ are in ‘the range’...”), 42 (“The combination battery includes

positive and negative electrode active material in amounts such that the capacity ratio (B/A) between the capacity of the positive electrode active material and the capacity of the negative electrode active material is in the [claimed range] based on Koyama...”).

The Reply also concedes that the Examiner was aware that a battery could allegedly have the specific charge cut-off voltage: “[The Examiner relied on] Tanaka for disclosure of a battery with ‘a charging cut-off voltage of 3.5 to 5 V’ [or] Kobayashi for a battery with a 4.5 V charge cut-off voltage...” (*i.e.*, Tanaka and Kobayashi allegedly disclose charge cut-off voltages greater than 4.2 V and less than 5.8 V). Paper 8, 2. The Petition cites Yamaki and Yasunami for this exact teaching. Paper 2, 10 (“As taught by Yamaki, the combination battery operates with ‘a maximum potential of the positive electrode during charging...from 4.4 V to 4.8 V.’”), 42 (“In operation, the end-of-charge voltage of the combination battery is 3.5V-4.7V, as taught by Yasunami.”). Accordingly, there can be no dispute that the teachings that form Petitioner’s invalidity grounds are entirely duplicative of those previously considered by the Examiner, as the Reply candidly admits: “The grounds presented in the Petition each also relies on one reference for the teaching of a battery having a particular ratio of positive to negative electrode material and another reference for disclosure of a battery with a particular charge cut-off voltage.” Paper 8, 2.

Finally, to the extent that the order in which the Examiner considered the prior art had any legal significance (there is none), Apple does not even explain why modifying a battery having a particular ratio to an increased charge cutoff voltage is inherently different from modifying a battery at the charge cutoff voltage to incorporate the claimed ratio. In lead compound cases, a challenger must prove that a POSA would have started with the lead compound over other prior art compounds. *See Daiichi Sankyo*, 619 F.3d at 1354. For the same reason, Apple bears the burden to prove that a POSA would have started with a battery with an increased charge cutoff voltage, instead of a battery with the particular ratio of positive electrode material to negative electrode material, or any other lithium-ion battery in the prior art. The Reply's silence on these issues shows that Apple has not met its burden to overcome the Examiner's express finding that the combination of ratio and charge cut-off voltages as claimed was unpredictable. Ex. 1002, 23-24; 35 U.S.C. §316(e); *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1296 (Fed. Cir. 2017) ("§316(e) unambiguously requires the petitioner to prove all propositions of unpatentability.").

Petitioner's arguments were fully rejected during prosecution, and neither the Petition nor the Reply makes any attempt to allege any material error in that examination. Accordingly, the Petition unambiguously meets both prongs of *Advanced Bionics*, and Patent Owner respectfully requests that the Board deny the Petition under §325(d).

Date: January 19, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document was served by electronic service, by agreement between the parties, on the date below:

PATENT OWNER'S SUR-REPLY

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Respectfully submitted,

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Date: January 19, 2024